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18 UNITED STATES DISTRICT COURT
19 CENTRAL DISTRICT OF CALIFORNIA

20 ACTIVISION PUBLISHING, INC., a
21 Delaware corporation

22 Plaintiff,

23 v.

24 WARZONE.COM, LLC

25 Defendant.
26
27
28

CASE NO. 2:21-cv-3073-FLA

**COUNTERCLAIMANT'S
OPPOSITION TO
COUNTERCLAIM
DEFENDANT'S MOTION TO
DISMISS COUNTERCLAIMS
AND/OR FOR JUDGMENT ON
THE PLEADINGS**

Hearing Date: October 1, 2021
Time: 1:30 pm

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WARZONE.COM, LLC

Counterclaimant,

v.

ACTIVISION PUBLISHING, INC.

Counterclaim Defendant.

TO THE COURT, ALL PARTIES AND THEIR ATTORNEYS OF RECORD HEREIN:

Counterclaimant, Warzone.com LLC (“Warzone”) opposes Counterclaim Defendant, Activision Publishing, Inc.’s (“Activision”) motion to dismiss Counterclaimant’s counterclaims and/or for judgment on the pleadings (the “Motion”) filed on July 29, 2021.

Dated: August 19, 2021

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By: /s/ Brett E. Lewis
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I. INTRODUCTION

1
2 In 2014, Randy Ficker, a solo indie video game developer and
3 Counterclaimant’s founder, began working on a sequel to his popular video game,
4 WARLIGHT. After three years of work developing the game, he acquired the
5 <warzone.com> domain name, and in November 2017 Warzone launched a video
6 game under the title WARZONE™ (the “WARZONE™ Mark”). The game grew
7 its customer base every year and at one point had over 80,000 active members.
8 WARZONE™ is available to consumers online at <warzone.com> and in the
9 Apple (iOS) and Google (Android) app stores, where it has over 750,000
10 downloads.

11 On June 25, 2020, nearly three years *after* Warzone first used the
12 WARZONE™ Mark in U.S. commerce, Activision filed to register an identical
13 trademark “Warzone,” as well as “Call of Duty Warzone,” for downloadable and
14 online video games, with the U.S. Patent & Trademark Office (USPTO), alleging a
15 date of first use of March 10, 2020. Activision failed to disclose this key fact in its
16 Motion. Warzone opposed the trademark applications at the USPTO based on prior
17 common law rights. Activision then initiated this action seeking a declaration that
18 would allow it to take what it does not own – the WARZONE™ Mark.

19 Activision would like the Court to view this case as a “textbook example of
20 trademark overreach.” Motion at 1. However, a review of the full factual record
21 reveals that it simply is not. Activision, a company with a market cap over \$60
22 billion dollars, is the largest video game publisher in the U.S. By its own count, it
23 has sold over 400 million copies of its “Call of Duty” series, making it one of the
24 best-selling franchises in the history of video games¹. More accurately, Activision
25 is the party overreaching in its bold attempt to usurp and trample over Warzone’s
26 superior and senior trademark rights under the guise of free expression, *while*

27
28 ¹ See <https://www.callofduty.com/blog/2021/04/Incredible-Warzone-and-Game-Sales-Milestones>

1 *simultaneously* seeking exclusive trademark rights for the very same word
2 (Warzone) and goods and services (downloadable and online video games) that
3 Warzone is seeking to enforce. The hypocrisy and abuse of process is undeniable.

4 If we are going to reduce this dispute down to textbook examples, then what
5 we have here is a classic case of **reverse trademark confusion**. Reverse confusion
6 occurs when the junior user's advertising and promotion swamps the senior user's
7 reputation in the marketplace such that customers are likely to be confused into
8 thinking that the senior user's goods are those of the junior user. *See Survivor*
9 *Media, Inc. v. Survivor Prods.*, 406 F.3d 625, 630 (9th Cir. 2005) (“reverse
10 confusion occurs when consumers dealing with the senior mark holder believe that
11 they are doing business with the junior one”).

12 Activision argues that its use of the WARZONE™ Mark as the title for a
13 competing video game is protected under the First Amendment. However,
14 Activision’s Motion raises legitimate concerns about the balancing test used to
15 evaluate trademark and First Amendment rights. When an identical trademark
16 appears in the title of a competing expressive work, and where the senior user
17 asserts a claim of reverse confusion, the balance advocated for by Activision tilts
18 too far in favor of the junior user’s First Amendment interests.

19 If this case is prematurely dismissed at the pleading stage it would
20 effectively mean that a senior user’s trademark is worthless and unenforceable. It
21 would signal that a corporate giant can claim the mark of a *direct competitor*
22 without the claimant even being afforded an opportunity via discovery to explore
23 the issues presented, merely because the defendant is using the claimant’s mark in
24 the title of an expressive work. It would mean that a large corporation can engage
25 in reverse trademark confusion with impunity – even filing for the *same trademark*
26 for the *identical* description of goods. Such an outcome would place a fist – not a
27 thumb – firmly on the First Amendment side of the scale balancing the
28 constitutional interests between Lanham Act protection and free expression. No

1 court has ever faced this set of facts, or granted such an unwarranted intrusion on
2 trademark rights, as is called for by Activision in this case.

3 Accordingly, the Motion should be denied.
4

5 **II. STATEMENT OF FACTS²**

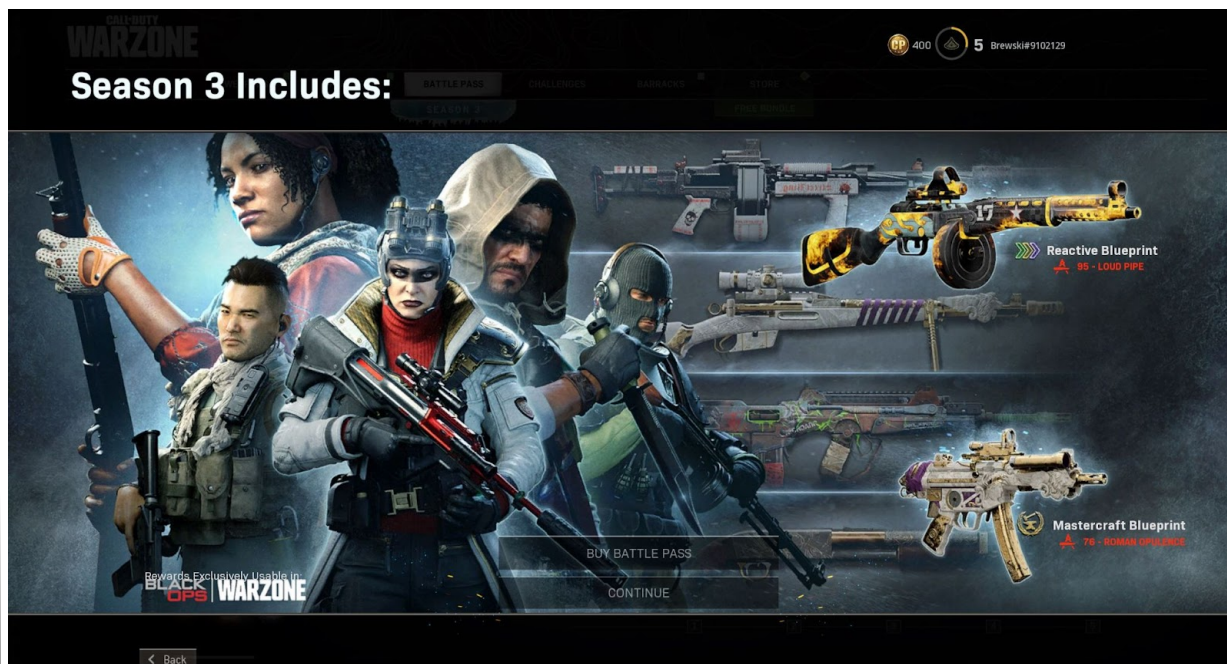
6 On June 25, 2020, Activision filed USPTO trademark applications to
7 register the marks WARZONE and CALL OF DUTY WARZONE for use in
8 connection with “downloadable video game software, downloadable video and
9 computer game programs” in Class 9 and for “providing online video games; and
10 providing information on-line relating to computer games and computer
11 enhancements for games,” in Class 41. *Id.* ¶12-13. Warzone opposed the
12 applications when they published for opposition. *Id.* ¶14. The USPTO opposition
13 proceeding is in suspension pending disposition of the instant civil action. *Id.* ¶15.

14 Activision claims March 10, 2020 as the date of first use in commerce for its
15 alleged WARZONE and the CALL OF DUTY WARZONE marks. *Id.* The
16 USPTO cited the Activision applications as preliminary bars to approval of
17 Warzone’s WARZONE applications by virtue of their earlier filing date and the
18 likelihood of consumer confusion. *Id.* ¶16. The USPTO did not find the term
19 WARZONE to be descriptive in the Activision applications or in Warzone’s
20 WARZONE applications. *Id.* ¶17. The USPTO determined the term WARZONE is
21 inherently distinctive of the parties’ goods and services. *Id.* ¶18.

22 Furthermore, the USPTO found the parties’ respective “Warzone”
23 trademarks are confusingly similar. *Id.* Indeed, despite claiming that WARZONE
24 cannot function as a trademark, Activision seeks relief from this Court that would
25 bar the registration of Warzone’s pending WARZONE applications, and allow its
26 own WARZONE applications to register. Compl. ¶1.

27
28 ² Warzone refers to its Counterclaims for the salient facts concerning its use of the
WARZONEtm Mark. *See, e.g.*, Countercl. ¶¶ 3-11.

1 Activision has been using “Call of Duty Warzone” interchangeably with the word
2 “Warzone,” which is identical to the WARZONE™ Mark. See, e.g., the following
3 screenshot in Countercl. ¶19:
4



16 Activision is using an identical mark, WARZONE, *by itself and apart from*
17 *the title of its game*, to market and offer similar goods and services as those offered
18 by Counterclaimant. Activision repeatedly refers to its video game simply as
19 “Warzone” in its press release announcing its launch³. Activision’s site for the
20 game greets potential customers with “Welcome to Warzone.”⁴ See screenshots in
21 Countercl. ¶21.

22 There is significant actual consumer confusion from consumers as to the
23 source, origin, or sponsorship of “Call of Duty Warzone.” Consumers have been
24 sending a flood of communications to Warzone about “Call of Duty Warzone,”
25 including bug reports and feature suggestions. *Id.* ¶24. Warzone continues to
26

27 ³ See <https://investor.activision.com/news-releases/news-release-details/call-duty-delivers-game-changing-free-play-experience-call-duty>

28 ⁴ See <https://www.activision.com/games/call-of-duty/call-of-duty-warzone>

1 receive these communications from “Call of Duty Warzone” consumers despite
2 placing the below disclaimer on its feature suggestion page: (NOTE: “Call of Duty
3 Warzone” and “Warzone” are DIFFERENT GAMES. Do not submit COD stuff
4 here)⁵. *Id.* Further, although Warzone has its own “Warzone” channel on Twitch,
5 which features WARZONE™, players of “Call of Duty Warzone” have flocked to
6 this channel to livestream play “Call of Duty Warzone,” which shows only “Call of
7 Duty Warzone” games streaming on Warzone’s Twitch channel.⁶ *Id.* ¶25.

8 Once Activision adopted a WARZONE mark, it buried search results to
9 <warzone.com>, leading to consumer confusion, diverted customers, lost sales and
10 weakened trademark rights. *Id.* ¶26. This consumer confusion is exacerbated by the
11 parties convergent marketing channels. *Id.* ¶27. On November 18, 2020, Warzone
12 placed Activision on notice of its infringement. On April 8, 2021, Activision
13 initiated the instant declaratory judgment action. *Id.* ¶32.

14 15 **III. THE LEGAL STANDARD**

16 Motions for judgment on the pleadings are governed by the same standard as
17 a motion to dismiss for failure to state a claim under Rule 12(b)(6). On a motion to
18 dismiss, the complaint’s allegations must be accepted as true. *Yeager v. Cingular*
19 *Wireless LLC*, 627 F. Supp. 2d 1170, 1174 (E.D. Cal. 2008). Because the court is
20 “bound to give plaintiff the benefit of every reasonable inference to be drawn from
21 the ‘well-pleaded’ allegations of the complaint” the plaintiff “need not necessarily
22 plead a particular fact if that fact is a reasonable inference from facts properly
23 alleged.” *Id.* at 1174 (citation omitted).

24 A complaint must meet a standard of “plausibility” (*Bell Atl. Corp. v*
25 *Twombly*, 550 U.S. 544, 564 (2007)) which is satisfied when “the plaintiff pleads
26

27 ⁵ See: <https://warlight.uservoice.com/forums/77051-warzone-features/filters/new?page=1>

28 ⁶ See: <https://www.twitch.tv/directory/game/Warzone>.

1 factual content that allows the court to draw the reasonable inference that the
2 defendant is liable for the misconduct alleged.” *Ashcroft v. Iqbal*, 556 U.S. 662,
3 678(2009). The plausibility standard is met here.

4 5 **IV. LEGAL ARGUMENT**

6 To succeed on a “trademark infringement claim under the Lanham Act, 15
7 U.S.C. § 1051 et seq., requires a showing that the claimant holds a protectable
8 mark, and that the alleged infringer’s imitating mark is similar enough to ‘cause
9 confusion, or to cause mistake, or to deceive.’” *Survivor*, 406 F.3d at 630 (*quoting*
10 *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 117
11 (2004)).

12 The Ninth Circuit has recognized two distinct claims in the trademark
13 infringement context: forward confusion and reverse confusion. “Forward
14 confusion occurs when consumers believe that goods bearing the junior mark came
15 from, or were sponsored by, the senior mark holder.” *Id.* (citations omitted). “By
16 contrast, reverse confusion occurs when consumers dealing with the senior mark
17 holder believe that they are doing business with the junior one.” *Id.* The Ninth
18 Circuit explained: “reverse confusion occurs when a person who knows only of the
19 well-known junior user comes into contact with the lesser-known senior user, and
20 because of the similarity of the marks, mistakenly thinks that the senior user is the
21 same as or is affiliated with the junior user.” *Ironhawk Technologies, Inc. v.*
22 *Dropbox, Inc.*, 994 F.3d 1107 (9th Cir. Apr. 20, 2021) *citing* *Dreamwerks Prod.*
23 *Grp., Inc. v. SKG Studio*, 142 F.3d 1127, 1130 (9th Cir. 1998). This occurs when
24 “the junior user’s advertising and promotion so swamps the senior user’s
25 reputation in the market that customers are likely to be confused into thinking that
26 the senior user’s goods are those of the junior user[.]” 4 McCarthy on Trademarks
27 and Unfair Competition § 23:10 (5th ed. 2020) (citations and footnotes omitted);
28 *see* *Dreamwerks*, 142 F.3d at 1130 n.5.

1 Courts have recognized a number of adverse consequences in reverse
2 confusion cases. For example, the senior user may be foreclosed “from expanding
3 into related fields” and misconduct or problems with the junior user and/or its
4 product could negatively impact the goodwill of the senior user if it was unfairly
5 associated with the junior mark. *Ironhawk* at 7. Courts recognize the reverse
6 confusion theory “to prevent the calamitous situation [where] a larger, more
7 powerful company thus usurp[s] the business identity of a smaller senior user.” *Id.*

8 Here, it is undisputed that Warzone is the senior user of a WARZONE
9 trademark and Activision is the larger, better known junior user. Activision’s
10 marketing and promotion of its own WARZONE video game in connection with
11 one of the best-selling video game series of all time, CALL OF DUTY, has
12 swamped Warzone’s superior rights and reputation in the marketplace. Activision
13 has buried Warzone’s ranking in online search results, making it difficult for
14 consumers to locate Warzone’s game online. It is creating not only a likelihood of
15 consumer confusion but an actual mistaken belief that WARZONE™ is affiliated
16 with Activision. The result is a negative association with a company currently
17 facing multiple lawsuits receiving extensive media exposure, with one accusing the
18 company of sexual harassment and gender discrimination⁷ and a second suit
19 alleging the company purposefully misled investors with false statements⁸.

20
21 **A. Activision’s Infringement Is Not Protected By The First**
22 **Amendment**

23 Activision is attempting to shield its infringing activities from liability under
24 the guise of free expression. It argues that First Amendment concerns require
25 application of the balancing test developed in *Rogers v. Grimaldi*, 875 F.2d 994

26 ⁷ See <https://www.cnn.com/2021/08/03/tech/activision-blizzard-employee-backlash-kotick/index.html>

27
28 ⁸ See <https://kotaku.com/activision-blizzard-faces-second-lawsuit-over-first-la-1847415904>

1 (2d Cir. 1989) and its progeny. In *Rogers*, the Second Circuit found the Lanham
2 Act “[s]hould be construed to apply to artistic works only where the public interest
3 in avoiding consumer confusion outweighs the public interest in free expression.”
4 *Id.* at 999. Under the two prong *Rogers* test, which has been adopted by the Ninth
5 Circuit in certain limited circumstances, an expressive use of a trademark in the
6 title of a work is not actionable unless (1) the use of the mark has no artistic
7 relevance to the underlying work, or (2) it has some artistic relevance, but
8 explicitly misleads as to the source or the content of the work. *E.S.S. Entm’t 2000,*
9 *Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008).

10 Where, as here, free expression concerns do not outweigh the public interest
11 promoted by the Lanham Act, the First Amendment is no defense. *Rogers* 875 F.2d
12 at 999. Indeed, “the First Amendment cannot permit anyone who cries ‘artist’ to
13 have carte blanche when it comes to naming and advertising his or her works, art
14 though it may be.” *Parks v. LaFace Records*, 329 F.3d 437, 447 (6th Cir. 2003)
15 (citing *Rogers’* adoption in *Mattel, Inc. v. MCA Records*, 296 F.3d 894 (9th Cir.
16 2002)).

17 This Court has held that the First Amendment does not automatically
18 insulate all artistic works from liability under the Lanham Act. *Dita, Inc. v.*
19 *Mendez*, CV 10-06277, 2010 WL 5140855 (C.D. Cal., Dec. 14, 2010) (Defendant
20 cannot prevail on a motion to dismiss in light of the specific allegations of
21 consumer confusion in the Complaint). Further, the Ninth Circuit noted that the
22 First Amendment offers little protection for a competitor who uses a confusingly
23 similar mark on its commercial goods. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d
24 894, 900 (9th Cir. 2002)(rights in expression are strongest where the expression
25 refers to a trademark). Activision is therefore “not entitled to absolute protection
26 from liability under the Lanham Act... simply because [it] created an ‘artistic’
27 work.” *Kiedis v. Showtime Networks, Inc.*, No. CV 07-8185 DSF, 2008 WL
28 11173143, *17-18 (C.D. Cal. Feb. 19, 2008). The First Amendment does not give

1 Activision “license to infringe” Warzone’s trademark rights. *Mutual of Omaha Ins.*
2 *Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987).

3 A title can function as a trademark and source identifier, which removes it
4 from blanket First Amendment protection. Restatement (Third) of Unfair
5 Competition §25 (Am. Law Inst. 1995) (distinguishing protected use “as an
6 incident of speech directed at the trademark owner” from use “as a means of
7 identifying the user’s own goods or services”). Although “[t]he title of a single
8 book cannot be a trademark because it does not ‘serve as a source identifier’ that
9 creates ‘an association between the book's title (the alleged mark) and the source of
10 the book (the publisher),’ . . . [t]he name of a book series, however, may serve a
11 trademark function. . . ***because the name ‘indicat[es] that each book of the series***
12 ***comes from the same source as the others.’*” *Spin Master, Ltd. v. Zobmondo*
13 *Entm't, LLC*, 944 F. Supp. 2d 830, 854 (C.D. Cal. 2012) (*emphasis added*) (*citing*
14 *In re Cooper*, 254 F.2d 611 at 615 (U.S. Cust. & Pat. App, Apr. 14, 1958).**

15 Unlike the movie title in *Rogers*, which served merely as the name of a
16 single movie, Activision uses “Warzone” as a source-identifying trademark for a
17 video game series that competes directly with the trademark owner. Although
18 Activision also uses “Warzone” in the title, “Call of Duty Warzone,” it promotes
19 its game under the word WARZONE in a manner that emphasizes and claims
20 trademark rights to WARZONE, *on its own*, separate and apart from CALL OF
21 DUTY. Its marketing displays the ™ symbol next to the word WARZONE and
22 Activision has filed to register WARZONE on its own as a trademark for goods
23 and services with an identical description to those previously offered by Warzone.

24 Warzone does not dispute that video games may qualify as “artistic works”
25 subject to application of the *Rogers* balancing test. However, Warzone submits that
26 the *title* of Activision’s game is CALL OF DUTY WARZONE, not merely
27 WARZONE™. Activision’s motive in choosing **also** to refer to its game by
28 WARZONE as the **trademark** for its billion dollar video game franchise was

1 gratuitous, willful, and not part of an artistic title. In essence, Activision is
2 claiming the entitlement to two titles – both of which it has applied to register as a
3 federal trademark, and one of which is identical to Warzone’s mark. Discovery of
4 information exclusively in the control of Activision is needed to fully understand
5 whether its video game is both an artistic work and a commercial work, and the
6 circumstances surrounding how and why it chose WARZONE as a trademark
7 given Warzone’s superior rights.

8 9 **1. This Case Is Beyond Rogers’s Outer Limits**

10 In its most recent decision addressing the *Rogers* test, the Ninth Circuit
11 noted that a case involving identical marks for competing products “demonstrates
12 *Rogers’s* outer limits.” *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 268 (9th Cir.
13 2018). “[T]he potential for explicitly misleading usage is especially strong when
14 the senior user and the junior user both use the mark in similar artistic
15 expressions.” *Id.* The Ninth Circuit has held that “mere use of a trademark alone
16 cannot suffice to make such use explicitly misleading,” *E.S.S.*, 547 F.3d at 1095.
17 However, in each case it made that observation, the junior user had employed the
18 mark in a different context than the senior user⁹. *See Gordon*, 909 F.3d at 270.

19
20 ⁹ *See Twentieth Century Fox*, 875 F.3d at 1195 (Empire Distribution recording
21 studio versus “Empire” television series’ fictional use of EMPIRE mark); *Brown*,
22 724 F.3d at 1245 (Jim Brown versus video game that used his likeness); *E.S.S.*
23 *Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir.
24 2008) (“Play Pen” strip club in East Los Angeles versus fictional video game
25 depicting real life “Pig Pen” strip club in “East Los Santos”); *Mattel, Inc. v. MCA*
26 *Records, Inc.*, 296 F.3d 894, 901–02 (9th Cir. 2002) (Barbie versus the parody
27 song “Barbie Girl,” by Aqua); *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d
28 792 (9th Cir. 2003)(Barbie used in series of parody photographs); *see also Parks*,
329 F.3d at 442–43 (Rosa Parks versus the song “Rosa Parks,” by Outkast);
Westchester Media v. PRL USA Holdings, Inc., 214 F.3d 658, 664–65 (5th Cir.
2000) (“Polo” clothing versus a wealthy lifestyle magazine named “Polo”); *ETW*
Corp. v. Jireh Pub., Inc., 332 F.3d 915, 920 (6th Cir. 2003) (Tiger Woods versus a

1 For example, in *MCA Records*, Mattel's Barbie was used in a parody song;
2 in *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003) Barbie
3 was used in a series of parody photographs; in *E.S.S.* a fictional video game
4 landscape depicted a real life gentleman's club within a video game, not the title;
5 *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235 (9th Cir. 2013) was a right of publicity
6 dispute involving use of legendary football player Jim Brown's likeness in a video
7 game, not a title; and in *Twentieth Cent. Fox Tel. v. Empire Dist.*, 875 F.3d 1192
8 (9th Cir. 2017) a real life record label's mark EMPIRE was used as the title of an
9 unrelated fictional television series. Importantly, ***none of these cases involved***
10 ***directly competitive uses of the same trademark***. Instead, they involve (1)
11 parodies, (2) uses of a famous person's likeness, (3) a depiction of a business
12 within the content of a video game, and (4) non-competing uses. The Ninth Circuit
13 decisions cited above are distinguishable on their facts. In *Gordon*, the Ninth
14 Circuit recognized the limitations in these cases. It explained that had the junior
15 user in the above cases used the mark in the same way as the senior user, "such
16 identical usage could reflect the type of 'explicitly misleading description.'" *Gordon*,
17 909 F.3d at 257.

18 In *Gordon*, the owner of the "Honey Badger Don't Care" trademark for
19 greeting cards, among other products, filed a trademark infringement claim against
20 a greeting card maker that, without permission, published cards with slight
21 variations on the Honey Badger mark, such as "Honey Badger and Me Just Don't
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23 painter who made a painting depicting various scenes from Woods's record-setting
24 1997 win at The Masters); *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d
25 1266, 1278 (11th Cir. 2012) (famous college football team's uniforms versus a
26 painter who painted that football team in various settings); *Cliffs Notes, Inc. v.*
27 *Bantam Doubleday Dell Pub. Grp., Inc.*, 886 F.2d 490, 492 (2d Cir. 1989) ("Cliffs
28 Notes" study guides versus "Spy Notes," a parody that used a yellow and black
layout on its cover); *Rogers*, 875 F.2d at 996 (Ginger Rogers versus Federico
Fellini's film, *Ginger and Fred*).

1 Care.” 909 F.3d at 262. Not only was the defendant producing the same type of
2 product as the plaintiff (greeting cards), the defendant was using the Honey Badger
3 mark precisely as the plaintiff did: “to convey a humorous message through . . . the
4 honey badger’s aggressive assertion of apathy.” *Id.* at 268–69. The Ninth Circuit in
5 *Gordon* recognized that the *Rogers* test, taken at face value, essentially destroyed
6 the value of the Honey Badger mark, and perhaps many other marks, if parties are
7 willing to be sued and defend themselves under *Rogers*. *Id.* at 268–71. A lawsuit is
8 no deterrent for a \$60 billion-dollar company like Activision. In fact, since the
9 outset of this dispute, Activision has eagerly sought to use *Rogers* as a shield while
10 simultaneously seeking federal trademark rights to wield as a sword, fully aware
11 that smaller competitor Warzone would have to put up significant resources if it
12 wanted to keep its trademark.

13 With the exception of *Twentieth Century Fox*, the line of Ninth Circuit cases
14 applying *Rogers* are also distinguishable in that each case involved a defendant
15 referring to a particular identifiable trademark or one that has attained cultural
16 significance. In *Twentieth Century Fox*, the Ninth Circuit rejected the argument
17 that *Rogers* has a referential requirement or that “the *Rogers* test includes a
18 threshold requirement that a mark have attained a meaning beyond its source-
19 identifying function.” *Id.* at 1197. Nevertheless, it went on to find that whether a
20 mark conveys a meaning beyond identifying a product’s source is still a **relevant**
21 **consideration**: “trademarks that transcend their identifying purpose are more likely
22 to be used in artistically relevant ways.” *Id.* at 1198 (quotation marks and citation
23 omitted).

24 Here, Activision’s choice of title is not an artistic one. There is no indication
25 that the WARZONE™ Mark is of “such cultural significance that it has become an
26 integral part of the public’s vocabulary” – still a relevant consideration in
27 evaluating whether the *Rogers* test applies. *Id.*; *Rebellion, LLC v. Perez*, 732 F.
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1 Supp. 2d 12 883, 887 (N.D. Cal. 2010)¹⁰. Simply put, Activision is not using the
2 WARZONE™ Mark to describe or comment upon Warzone’s mark or games or to
3 express anything. Instead, it is using the mark in the *exact same way* Warzone has
4 used it for years. Indeed, Activision goes one large leap further – the title of its
5 game is “Call of Duty Warzone,” but it separately claims exclusive trademark
6 rights to WARZONE™, alone, and insinuates that the title of its game is also
7 WARZONE. This purely gratuitous, obviously commercial, second use of
8 WARZONE *as a trademark* is not shielded by *Rogers*.

9 Furthermore, the factual circumstances of a reverse confusion case do not fit
10 neatly in the *Rogers* balancing test. Under the second prong of the test, the
11 claimant must show that use of a trademark in the title is *explicitly misleading* as to
12 the source or content of the work. However, in the reverse confusion context,
13 consumers are confused into mistakenly believing that the larger junior user is the
14 source of goods. The Ninth Circuit has never ruled on how to apply the second
15 *Rogers* prong in the reverse confusion context, and this Court has never dismissed
16 a case *at the pleading stage* in this context.¹¹

17 In *Masters Software, Inc. v. Discovery Communs., Inc.*, 725 F. Supp. 2d
18 1294 (W.D. Wash. 2010) the defendant asserted a *Rogers* defense in a reverse
19 confusion case and it was denied. *Masters* involved a small company with prior
20 rights to CAKEBOSS for bakery related goods and services. The Discovery
21

22 ¹⁰ See also *MCA Records, Inc.*, 296 F.3d at 900 (First Amendment issue arises
23 when trademarks “transcend their identifying purpose” and “enter our public
24 discourse and become an integral part of our vocabulary”); *Mattel Inc. v. Walking*
25 *Mountain Prod.*, 353 F.3d 792, 807 (9th Cir. 2003) (“As we recently recognized in
26 MCA, however, when marks ‘transcend their identifying purpose’ and ‘enter
27 public discourse and become an integral part of our vocabulary,’ they ‘assume a
28 role outside the bounds of trademark law.’ Where a mark assumes such cultural
significance, First Amendment protections come into play.”)

¹¹ As explained further below, *Caiz v. Roberts*, 382 F. Supp. 3d 942 (C.D. Cal.
Apr. 17, 2019) was decided on a motion for summary judgment.

1 Channel subsequently released a popular TV show called CAKE BOSS and
2 trampled the smaller senior user's rights through reverse confusion. The Discovery
3 Channel attempted to assert a First Amendment defense as the title of an
4 expressive work and cited the Ninth Circuit's *Mattel* and *Rogers* line of cases as
5 authority. The court noted, "the common thread in *Rogers*, *Mattel*, and similar
6 cases is a well-known senior user seeking to prevent harm associated with the use
7 of its trademark in the title of an expressive work authored by a junior user who
8 intends an association with the senior user." That common thread is not present in
9 a reverse confusion case. The court reasoned that the defendant did not choose the
10 name Cake Boss as an allusion to plaintiff's mark, but chose a suggestive
11 trademark to brand their product, as Activision did here. The court further found
12 that the Lanham Act's limitations on such "expressions" do not violate the First
13 Amendment. *Masters* at 1305, citing *Mattel*, 296 F.3d at 900 (noting that when
14 "limited to [their] core purpose — avoiding confusion in the marketplace — a
15 trademark owner's property rights play well with the First Amendment"). The
16 court in *Masters* went on to say that otherwise, use of a trademark in the title of an
17 expressive work would never violate the Lanham Act, and *Rogers* and *Mattel* did
18 not intend to create such an extreme rule but rather created a balance between
19 expressive interests and trademark interests. *Masters* at 1306.

20 Similarly, here, Activision's use of WARZONE in the title of its video game
21 was not alluding to Warzone's mark, which has no cultural significance (still a
22 *relevant consideration post-Twentieth Century Fox*) and has clearly infringed
23 Warzone's mark. The public interest in allowing Warzone to avoid the consumer
24 confusion that Activision has created outweighs the expressive interests (if any)
25 inherent in the choice of title.

26 In *Caiz v. Roberts*, 382 F. Supp. 3d 942 (C.D. Cal. 2019), a court in this
27 district found that the *Rogers* test is not barred simply because a case involves
28 reverse confusion. *Caiz* was a ruling on a motion for summary judgment and the

1 plaintiff had been afforded the opportunity to develop an evidentiary record to
2 support his position that *Rogers* should not apply. Ultimately, the court found the
3 plaintiff failed to provide any evidence creating a triable issue of material fact as to
4 either *Rogers* prong. *See Caiz* at 19 (*citing Wild v. HarperCollins Publr.*, LLC,
5 SACV 12-1191-JST (ANx), 2012 WL 12887690 (C.D. Cal., Nov. 29, 2012) as
6 “persuasive authority” on a motion to dismiss).

7 In *Wild*, this Court refused to find the *Rogers* defense precluded the plaintiff
8 from a finding of infringement given the defendant's book title of the same name as
9 plaintiff's trademark. The Court in *Wild* highlighted that *Rogers* added the express
10 qualification that “[t]his limiting construction would not apply to misleading titles
11 that are confusingly similar to other titles. The public interest in sparing consumers
12 this type of confusion outweighs the slight public interest in permitting authors to
13 use such titles.” *Rogers*, 875 F.2d at 999. The Court noted that “Movies, plays,
14 books, and songs are all indisputably works of artistic expression and deserve
15 protection. Nonetheless, they are also sold in the commercial marketplace like
16 other more utilitarian products, making the danger of consumer deception a
17 legitimate concern that warrants some government regulation.” *Wild* at 9, *citing*
18 *Rogers* at 997. The Court denied a motion to dismiss since a factual question
19 existed “as to whether Defendants' book is likely to confuse consumers as to the
20 origin of its source, they could not determine, as a matter of law, that it does not.”
21 *Wild* at 12-13.

22 Here too, like in *Wild*, we have misleading titles used for the same
23 underlying work. As there is a factual question here whether consumers are likely
24 to suffer reverse confusion as to the origin of the source of Warzone's game due to
25 Activision's usage of the same WARZONE mark for the same class of goods and
26 services as Warzone's superior rights, this court cannot determine, at the pleading
27 stage on a motion to dismiss, that it does not. For the above reasons, neither the
28 First Amendment nor the *Rogers* test bar Warzone's claims.

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B. Activision’s Use of WARZONE Has No Artistic Relevance

Activision opens its Motion by claiming “when Counterclaimant chose a common English word for its game title, it ran the risk that others might also use that word to describe their game, movie, book, or other creative endeavor...” Motion at 2. However, Activision is not using the word “warzone” as a descriptor—it uses the word as a source identifier. Activision’s Motion conveniently fails to disclose that it filed to federally register the word WARZONE, along with a separate filing for CALL OF DUTY WARZONE, for downloadable and online video games. In approving the trademark applications, the USPTO made a determination that the word “warzone” is *not* merely descriptive for video games. As such, the word “warzone” has been found to be inherently distinctive. This fact, alone, undercuts the entire premise of Activision’s Motion.

Nevertheless, while the word “warzone” may be suggestive of the content of Activision’s game, the question is whether it is *artistically* relevant. As stated in *Gordon*, “the use of a mark is not artistically relevant if the defendant uses it merely to appropriate the goodwill inhering in the mark ...” *Gordon, citing Parks*, 329 F.3d at 453 (finding genuine issue of material fact on artistic relevance prong). For artistic relevance to “be above zero,” the defendant must *add its own artistic expression beyond that represented by the mark*. *Gordon* at 270-271. As the Ninth Circuit warned in *Gordon*: “*Rogers* protects our First Amendment interests in artistic works, and defendants’ greeting cards are among the artistic works the Amendment protects. But it cannot be that defendants can simply copy a trademark into their greeting cards without adding their own artistic expression or elements and claim the same First Amendment protection as the original artist ... [t]hat would turn trademark law on its head.” *Gordon v. Drape Creative, Inc.*, 897 F.3d 1184 (9th Cir. 2018).

1 Activision refers to and promotes its video game using the identical word
2 WARZONE. It has taken the significant step to federally register a trademark for
3 WARZONE on its own. Activision is merely appropriating the goodwill inherent
4 in Warzone's superior WARZONE™ Mark without adding any creativity of its
5 own. Put another way, Activision is just copying Warzone's artistic expression.
6 Under *Gordon*, this is not an *artistically* relevant use.

7 Activision could have chosen any number of common English words in
8 place of "warzone" in its game title, e.g. warfare, combat zone, frontline, battle,
9 battle zone, etc. Instead, it chose a word that it had to know was already taken.
10 Discovery is needed to show whether Activision chose a trademark that it *knew*
11 was unavailable in the hope that the smaller, senior trademark owner would not
12 object, or if it did, would not have the resources to go to battle with a multi-billion
13 dollar competitor.

14 Under Activision's interpretation of *Rogers*, anyone can use a trademark,
15 even to sell the same good or service for which prior trademark rights existed, if
16 the good or service can be deemed "art." To avoid taking the drastic step of
17 destroying the value of trademarks in the name of the First Amendment, *Gordon*
18 clarified Ninth Circuit precedent such that use of a mark in its entirety to compete
19 with the senior user at the very least raises a triable issue for a jury as to whether it
20 is free expression or trademark infringement. As such, dismissal is improper.

21
22 **C. Activision's Use Of Warzone Is Explicitly Misleading**

23 "Poetic license is not without limits. The purchaser of a book, like the
24 purchaser of a can of peas, has a right not to be misled as to the source of the
25 product." *Rogers* at 997. Activision's use of Warzone's mark is explicitly
26 misleading because it appropriates the mark in its entirety to compete unfairly
27 against Warzone and damage its reputation. WARZONE™ is not an Activision
28 video game. Given Activision's size and power in the video game market, every

1 consumer searching for the WARZONE™ video game is now diverted to
2 Activision's game. In *Gordon*, the Ninth Circuit explained that “in some instances,
3 the use of a mark alone may explicitly mislead consumers about a product's source
4 if consumers would ordinarily identify the source by the mark itself.” *Gordon* at
5 270. Further, “the potential for explicitly misleading usage is especially strong
6 when the senior user and the junior user both use the mark in similar artistic
7 expressions.” *Id.*

8 Activision's Motion disingenuously frames its use of “warzone” as merely a
9 “subtitle.” Motion at 1. Any suggestion that the word is used as a descriptor rather
10 than an indication of source, sponsorship, or affiliation is contradicted by
11 Activision's use of the ™ symbol and its filing for a federal trademark registration
12 for WARZONE on its own. It is explicitly misleading to title a video game
13 WARZONE because this use explicitly and implicitly associates the video game
14 with Warzone's prior mark and thus falsely creates the impression that it was used
15 with Warzone's permission, or in the reverse confusion context, that Warzone is
16 the junior user and infringer. Taking the additional step to register the trademark is
17 an indication of an overt action to explicitly mislead consumers.

18 *Rogers*-type analyses are highly fact dependent. The cases relied on by
19 Activision are distinguishable based on their facts because in each example the
20 defendant did not use the claimant's trademark *in its entirety to compete against it*.
21 Here, the trademark is used for a video game that can be played on a personal
22 computer or gaming device, both of which are squarely within Warzone's domain.
23 Furthermore, this is not a case where Activision's products and Warzone's
24 products are so different that no one could possibly confuse the two – especially in
25 the reverse confusion context. *Cf. E.S.S.* at 1100-01 (“A reasonable consumer
26 would not think a company that owns one strip club in East Los Angeles, which is
27 not well known to the public at large, also produces a technologically sophisticated
28

1 video game like San Andreas.”). Both Activision and Warzone inhabit the same
2 gaming space, and Activision’s customers have experienced actual confusion.

3 The second prong of the *Rogers* test is negated because Warzone alleges that
4 Activision’s use of its mark is likely to cause consumer confusion, that Activision
5 actually intended to mislead the public as to the source of the video games, and
6 actual reverse confusion occurred as consumers were misled by Activision into
7 believing that Activision was the source of or affiliated with, Warzone’s game.
8 Countercl. ¶33-44. The fact that the parties are competitors in the video game
9 market indicates Activision’s use was explicitly misleading. *Cf. E.S.S.* at 1100-01
10 (use not explicitly misleading where parties’ businesses were completely
11 unrelated).

12 Throughout its Motion, Activision argues that Warzone failed to allege
13 Activision’s use of WARZONE was explicitly misleading. However, a complaint
14 need not anticipate and negate a defendant’s affirmative defense. Rather, in order
15 to state a viable claim and to withstand a Rule 12(b)(6) motion, a plaintiff must
16 only avoid establishing on the face of the complaint the applicability of some such
17 defense. FED. R. CIV. P. 12(b)(6); see 5B CHARLES ALAN WRIGHT &
18 ARTHUR R. MILLER, FEDERAL PRACTICE & PROCEDURE § 1357, at 708–
19 10 (3d ed. 2004).

20 Warzone’s allegations are sufficient to negate the second prong of the
21 *Rogers* test on a motion to dismiss. *See Dita, Inc.* at *3 (denying motion to dismiss,
22 holding second prong of *Rogers* negated by plaintiff’s allegations that defendant’s
23 use of the mark was likely to cause consumer confusion and defendant intended to
24 mislead public as to source of the work); *Electronic Arts, Inc. v. Textron Inc.*, 2012
25 WL 3042668 (N.D. Cal. 2012) at *35 (second prong of *Rogers* negated on motion
26 to dismiss because likelihood of confusion was alleged and consumers could
27 “plausibly think” plaintiff sponsored defendant’s video game). Accordingly, the
28 *Rogers* test is not satisfied and the Motion should be denied.

1
2 **D. The Rogers Test Should Not Be Applied On A Motion to Dismiss**

3 At this early stage in litigation, Warzone does not yet have any evidence of
4 Activision's advertising practices, which may be relevant to show their use of the
5 mark was explicitly misleading. *See Novalogic, Inc.*, 41 F.Supp.3d at 901.
6 Additionally, in determining whether Activision's use was explicitly misleading,
7 the Court should look beyond the face of the work itself. *See E.S.S.* at 1100—01
8 (considering several *Sleekcraft* factors such as relatedness of goods and likelihood
9 of actual confusion). In light of the procedural posture of this Motion and
10 Warzone's allegations, the First Amendment cannot be said to bar liability *as a*
11 *matter of law*. *Yeager*, 627 F.Supp.2d at 1175.

12 Authority from courts and circuit courts across the country supports that the
13 *Rogers* test only has value after a full record is developed, with a party seeking
14 determination of the First Amendment issue on summary judgment or at trial.¹²
15 Accordingly, Activision's Motion is premature and should be denied.

16
17 ¹² *See University of Alabama Board of Trustees v. New Life Art, Inc.*, 683 F.3d
18 1266 (11th Cir. 2012) (reviewing trial court's **summary judgment** ruling on
19 Lanham Act claims and *Rogers* test First Amendment defense); *E.S.S. Entm't*
20 *2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095 (9th Cir. 2008) (reviewing trial
21 court's **summary judgment** ruling on Lanham Act claims and *Rogers* test First
22 Amendment defense); *Seale v. Gramercy Pictures*, 949 F.Supp. 331 (E.D. Pa.
23 1996) (district court determining Lanham Act/First Amendment defense under
24 *Rogers* test at **summary judgment**); *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915
25 (6th Cir. 2003) (reviewing trial court's **summary judgment** ruling on Lanham Act
26 claims and *Rogers* test First Amendment defense); *Novalogic, Inc. v. Activision*
27 *Blizzard, et al* 41 F.Supp.3d 885 (C.D. Cal. 2013) (district court determining
28 Lanham Act/First Amendment defense under *Rogers* test at **summary judgment**);
Roxbury Entm't v. Penthouse Media Group, Inc., 669 F. Supp. 2d 1170 (C.D. Cal.
2009) (district court determining Lanham Act/First Amendment defense under
Rogers test at **summary judgment**); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d
894 (9th Cir. 2002) (reviewing trial court's **summary judgment** ruling on Lanham
Act claims and *Rogers* test First Amendment defense); *Dillinger, LLC v. Elec.*
Arts, Inc., 795 F. Supp. 2d 829 (S.D. Ind. June 15, 2011)) (district court

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V. CONCLUSION

For the foregoing reasons, Activision’s motion to dismiss and/or for judgment on the pleadings should be denied.

Dated: August 19, 2021

Respectfully Submitted,
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determining Lanham Act/First Amendment defense under *Rogers* test at ***summary judgment***).