

APPENDIX A
United States Court of Appeals
For the Eighth Circuit

No. 16-4483

Bruce Munro; Bruce Munro Studio

Plaintiffs – Appellants

v.

Lucy Activewear, Inc.; Lucy Apparel, LLC;
VF Outdoor, Inc.; VF Corporation

Defendants – Appellees

Appeal from United States District Court
for the District of Minnesota – Minneapolis

Submitted: May 16, 2018

Filed: August 9, 2018

Before SHEPHERD, MELLOY, and GRASZ, Circuit
Judges.

SHEPHERD, Circuit Judge.

Bruce Munro and Bruce Munro Studio (collectively “**Munro**”) appeal the district court’s dismissal of his complaint against Lucy Activewear, Inc., Lucy

Apparel, LLC, VF Outdoor, Inc., and VF Corporation (collectively “**Lucy**”) and the denial of his motion to amend his complaint based on a finding of futility. Munro argues that the district court erred when it found that his tortious interference claim was preempted by the Copyright Act¹ and that his proposed amended trade dress, trademark, and fraud claims were futile. We disagree with Munro except as to his trademark claim. Thus, we affirm in part and reverse and remand in part.

I. Background

Munro is an artist best known for his works “Field of Light” and “Forest of Light”—“large-scale, immersive, light-based installations, and exhibitions.” Proposed Amend. Compl. ¶ 1. Munro alleges that Lucy contacted him and proposed a Lucy advertising and promotional campaign featuring Munro’s work. He further claims that, relying on a promise of confidentiality, he shared additional information with Lucy about his prior work, including “attendance figures, achieved online/multimedia traffic, and promotional methods used for the exhibitions.” He further disclosed that he was in talks with public officials in Boston, Massachusetts about creating a public exhibition in the city. Following these disclosures, Munro says that Lucy stopped contacting him and that communications with Boston officials ceased soon thereafter as well.

¹ 17 U.S.C. § 101 et seq.

In October 2013, Lucy launched a light exhibition and advertising campaign for Lucy in Boston. The exhibition, titled “Light Forest,” was an interactive light installation that responded to the participants’ movements. An advertising campaign associated with the exhibit crossed several media platforms, including television, print, internet, and in-store displays.

In 2015, Munro filed a complaint against Lucy in Texas state court alleging that, by presenting the “Light Forest” exhibition and advertising campaign in Boston, Lucy infringed on Munro’s trademark and trade dress and usurped a prospective business opportunity. In September 2015, Lucy removed the case to federal court and then filed a motion to dismiss for lack of personal jurisdiction, or, in the alternative, to transfer venue. Lucy also filed a separate Fed. R. Civ. P. Rule 12(b)(6) motion to dismiss for failure to state a claim. In January 2016, the case was transferred to the federal district court in Minnesota. The following month, Lucy renewed its Rule 12(b)(6) motion. Munro responded, but in March 2016, he also moved to amend his complaint. In his proposed amended complaint, Munro alleged: trademark and trade dress infringement, trademark and trade dress dilution, false designation of origin and unfair competition, misappropriation, fraud, tortious interference with prospective business opportunities, and unfair competition. The district court found that Munro’s proposed amended complaint was futile and denied his motion to amend. It also granted Lucy’s motion to dismiss Munro’s complaint for failure to state a claim. The

court dismissed without prejudice Munro’s fraud claim as well as his trademark claim—to the extent it is based on the similarity of the names of the two exhibitions—but it dismissed all remaining claims with prejudice. Munro appeals.

II. Discussion

We usually review the district court’s “denial of leave to amend a complaint under an abuse of discretion standard; however, when the district court bases its denial on the futility of the proposed amendments, we review the underlying legal conclusions *de novo*.” *Jackson v. Riebold*, 815 F.3d 1114, 1122 (8th Cir. 2016) (internal quotation marks omitted). Federal Rule of Civil Procedure 15(a)(2) states “a party may amend its pleading only with the opposing party’s written consent or the court’s leave[,] [and] [t]he court should freely give leave when justice so requires.”

However, “[f]utility is a valid basis for denying leave to amend.” *Jackson*, 815 F.3d at 1122. “[W]hen the court denies leave on the basis of futility, it means the district court has reached the legal conclusion that the amended complaint could not withstand a motion to dismiss under Rule 12(b)(6) of the Federal Rules of Civil Procedure.” *Cornelia I. Crowell GST Tr. v. Possis Med., Inc.*, 519 F.3d 778, 782 (8th Cir. 2008). When reviewing “a motion to dismiss an action for failure to state a claim under Rule 12(b)(6), [we] tak[e] the factual allegations in the complaint as true and afford[] the non-moving party all reasonable inferences from

those allegations.” *Butler v. Bank of Am., N.A.*, 690 F.3d 959, 961 (8th Cir. 2012). A plaintiff’s motion to amend the complaint will be granted if he “show[s] that such an amendment would be able to save an otherwise meritless claim.” *Jackson*, 815 F.3d at 1122.

Munro argues that the district court erred when it denied his motion for leave to amend four of his claims: (1) trade dress infringement; (2) fraud; (3) tortious interference; and (4) trademark infringement. We address each claim in turn.

1. Trade Dress

In *Dastar Corp. v. Twentieth Century Fox Film Corp.*, the Supreme Court held that “[t]he Lanham Act was intended to make ‘actionable the deceptive and misleading use of marks,’ and ‘to protect persons engaged in . . . commerce against unfair competition.’” *Dastar*, 539 U.S. 23, 28 (2003) (quoting 15 U.S.C. § 1127). The Court found, however, that the Lanham Act was not designed to protect originality or creativity and it does not create a cause of action for plagiarism. *Id.* at 36-37. “Trade dress is the total image of a product, the overall impression created, not the individual features.” *Aromatiqe, Inc. v. Gold Seal, Inc.*, 28 F.3d 863, 868 (8th Cir. 1994) (internal quotation marks omitted). The Lanham Act creates a civil cause of action for trade dress infringement, stating:

Any person who, on or in connection with any goods or services . . . , uses in commerce any word, term, name, symbol, or device, or any

combination thereof, or any false designation of origin . . . which—is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person’s goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125(a)(1). To successfully allege a claim under the Lanham Act, a plaintiff must prove that his trade dress is: (1) distinctive; (2) nonfunctional; and (3) likely to “be confused with the accused product.” *Aromatique, Inc.*, 28 F.3d at 868. In *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, the Supreme Court held that a plaintiff could not succeed in a trade dress claim against another company for producing a “knockoff” of its design without showing that the designs had acquired “secondary meaning” so that they “identify the source of the product rather than the product itself.” *Samara Brothers*, 529 U.S. 205, 208, 211, 214 (2000) (internal quotation marks omitted). “[T]he origin of goods—the source of wares—is the producer of the tangible product sold in the marketplace . . . not the producer of the (potentially) copyrightable or patentable designs that the clothes embodied.” *Dastar*, 539 U.S. at 31, 37.

Here, Munro presents essentially the same claim presented in *Dastar* and *Wal-Mart*. Munro asserts that Lucy created a “knockoff” light installation that basically plagiarized his creative designs. Copyright law, not trademark law, protects Munro’s creative works. As the district court found, Munro’s installation is not a “mark” that the Lanham Act was attempting to protect. Rather, the installation is the product itself. Because the light installation is a product, not a mark, and because copyright, not trademark, protects artistic and creative ideas and concepts, *see Dastar*, 539 U.S. at 37, Munro’s claim does not properly fall under the Lanham Act. Furthermore, because Munro’s proposed amended complaint continues to style his claim as trade dress infringement under the Lanham Act, he has not shown that amending the complaint would save his claim. Thus we find the district court properly dismissed his motion to amend his trade dress claim as futile.

2. Fraud

Next, Munro argues that Lucy perpetrated fraud by making promises to Munro that it never intended to keep. He argues that Lucy stated it would keep the information he provided regarding his light exhibitions and prospective business opportunity with the city of Boston confidential. But, he asserts, Lucy knowingly made those false promises so that it could exploit the information for its own gain, as evidenced by the fact that Lucy did not maintain confidences.

The circumstances of fraud must be pled with particularity. Fed. R. Civ. P. 9(b); *Parnes v. Gateway 2000, Inc.*, 122 F.3d 539, 549 (8th Cir. 1997). The circumstances that a plaintiff must allege “include such matters as the time, place and contents of false representations, as well as the identity of the person making the misrepresentation and what was obtained or given up thereby.” *Id.* (internal quotation marks omitted). “[C]onclusory allegations that a defendant’s conduct was fraudulent and deceptive are not sufficient to satisfy the rule.” *Id.* (internal quotation marks omitted). If the plaintiff’s “allegations of fraud are explicitly . . . based only on information and belief, the complaint must set forth the source of the information and the reasons for the belief.” *Id.* at 550 (internal quotation marks omitted). The Minnesota Supreme Court has held:

It is a well-settled rule that a representation or expectation as to future acts is not a sufficient basis to support an action for fraud merely because the represented act or event did not take place. It is true that a misrepresentation of a present intention could amount to fraud. However, it must be made affirmatively to appear that the promisor had no intention to perform at the time the promise was made.

Valspar Refinish, Inc. v. Gaylord's, Inc., 764 N.W.2d 359, 368-69 (Minn. 2009).

In his proposed amended complaint, Munro merely alleged who made the false promise, when the

promise was made, and the general content of the promise. This is insufficient to show fraud. *See Parnes*, 122 F.3d at 549; *Stumm v. BAC Home Loans Servicing, LP*, 914 F. Supp. 2d 1009, 1014 (D. Minn. 2012). Munro relies on the phrase “on information and belief” to allege that Lucy intentionally provided false promises. He argues the fact that Lucy broke its promises is proof that Lucy never intended to keep those promises in the first place. We disagree. Munro’s complaint does not set forth any supporting facts showing that Lucy intended to defraud him when the promises were made. Thus, he has not adequately alleged fraud under Minnesota law, and the district court did not err in dismissing his claim. *See Valspar*, 764 N.W.2d at 368-69; *cf. Parnes*, 122 F.3d at 549. Additionally, in his proposed amended complaint, Munro still failed to allege sufficient facts to support his fraud claim. Therefore, the proposed amendment is futile, so we find the district court did not err in denying Munro’s motion to amend.

3. Tortious Interference

In his third claim for tortious interference under state law, Munro asserts that he had a reasonable probability of staging an exhibition of his “Field of Light” and/or “Forest of Light” works in the city of Boston, but Lucy usurped his prospective business opportunity. Munro claims that using the information he provided Lucy in confidence, Lucy wrongfully and intentionally interfered with his business dealings with the city of Boston by soliciting and presenting Boston

city officials an alternative knock-off light exhibition and advertising campaign.

To succeed on a claim for tortious interference with prospective economic advantage, a plaintiff must establish:

- 1) The existence of a reasonable expectation of economic advantage;
- 2) Defendant's knowledge of that expectation of economic advantage;
- 3) That defendant intentionally interfered with plaintiff's reasonable expectation of economic advantage, and the intentional interference is either independently tortious or in violation of a state or federal statute or regulation;
- 4) That in the absence of the wrongful act of defendant, it is reasonably probable that plaintiff would have realized his economic advantage or benefit; and
- 5) That plaintiff sustained damages.

Gieseke ex rel. Diversified Water Diversion, Inc. v. IDCA, Inc., 844 N.W.2d 210, 219 (Minn. 2014).

The Copyright Act will preempt a state-law claim if: "(1) the work at issue is within the subject matter of copyright as defined in § 102 and 103 of the Copyright Act, and (2) the state law created right is equivalent to any of the exclusive rights within the general scope of copyright as specified in § 106 [of the Copyright Act]."
Ray v. ESPN, Inc., 783 F.3d 1140, 1142 (8th Cir. 2015)

(per curiam) (alteration in original) (internal quotation marks omitted). “[P]ictorial, graphic, and sculptural works” are subject matter falling under the umbrella of copyright protection. 17 U.S.C. §102(a)(5). Munro’s light-based artwork and installations are sculptures and, as such, are copyrightable. *See id.* Munro does not contest that his works fall within the subject matter of copyright. Accordingly, we find that Munro’s claim meets the first element of preemption.

We also find the second element of preemption is present. “[E]xclusive rights within the general scope of copyright,” *Ray*, 783 F.3d at 1142, include “reproduc[ing] the copyrighted works in copies or . . . prepar[ing] derivative works based upon the copyrighted work,” 17 U.S.C. § 106. “A ‘derivative work’ is a work based upon one or more preexisting works, such as a[n] . . . art reproduction . . . or any other form in which a work may be recast, transformed, or adapted.” *Id.* § 101. In *Ray v. ESPN, Inc.*, we held that the plaintiff’s state-law rights had been “infringed by the mere act of reproduction,” so “his state-law rights are equivalent to the exclusive rights within the general scope of copyright.” *Ray*, 783 at 1144 (internal quotation marks omitted). Similarly, Munro alleges his state-law rights were infringed by Lucy’s reproduction of his light-installations. Thus, Munro’s “state-law rights are equivalent to the exclusive rights within the general scope of copyright.” *Id.* (internal quotation marks omitted). As a result, Munro’s tortious interference claim is preempted by the Copyright Act. Because the claim is preempted, allowing an amendment to the complaint

would be futile. *See* 17 U.S.C. § 301(a) (stating that when “legal or equitable rights . . . are equivalent to any of the exclusive rights within the general scope of copyright . . . no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State”). Therefore, we find the district court properly denied Munro’s motion to amend his tortious interference claim.

4. Trademark Infringement

Finally, Munro argues that Lucy’s use of the name “Light Forest” was a confusingly similar and colorable imitation of his “Forest of Light” and “Field of Light” trademarks. He asserts that Lucy’s unauthorized use of his marks likely caused the public to erroneously believe that Lucy’s exhibition was the same or affiliated with Munro’s exhibitions and that Lucy unfairly benefitted and profited from Munro’s reputation and the reputation of his trademarks.

A “trademark” can be “any word, name, symbol, or device, or any combination thereof . . . [used] to identify and distinguish [a producer’s] goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” 15 U.S.C. § 1127. Federal trademark law is intended to “prevent[] competitors from copying a source identifying mark.” *Dastar*, 539 U.S. at 33; *see also* 15 U.S.C. § 1125(a). The terms “origin of goods” and the “source” of goods under the Lanham Act refer to the producer of the actual product

or good, not the producer of the creative idea for the product or good. *Id.* at 36. However, in some situations, the producer of the creative idea for the product and the producer of the actual product are the same. *See Shepard v. European Pressphoto Agency*, 291 F. Supp. 3d 465, 470 (S.D.N.Y. 2017). For example, an artist is considered the producer of the creative ideas of his work, but if the artist also makes and sells his artwork himself, then he is considered the producer of that good or service as well and is “able to assert a Lanham Act claim for false designation of origin.” *Id.*

Here, the district court held that Munro did not properly assert a trademark claim because he failed to provide facts suggesting that the names of his installations—“Field of Light” and “Forest of Light”—served a source-identifying function for a product or service. Instead, the court found, the names merely identified Munro as the artist or source of the creative idea. We disagree. Munro has alleged that he and his studio together create, design, develop, produce, promote, and market these large-scale immersive light installations. Like the artists in *Shepard v. European Pressphoto Agency*, Munro actually produces and sells these installations, making him the producer of the good. *Id.*; *see also Dastar*, 539 U.S. at 36. Thus, the names “Field of Light” and “Forest of Light” are serving a source-identifying function for the installations, distinguishing them as unique products made by Munro and his studio. *See* 15 U.S.C. § 1127; *Dastar*, 539 U.S. at 36. Because Munro produces these installations, he is the “origin of goods” or “source” that the names identify,

which entitles him to bring an action under the Lanham Act. *See Shepard*, 291 F. Supp. 3d at 470. Munro pled these facts in his amended complaint and his proposed second amended complaint. Because “[we] tak[e] the factual allegations in the complaint as true and afford[] the non-moving party all reasonable inferences from those allegations,” *Butler*, 690 F.3d at 961, we find that the district court erred in dismissing Munro’s trademark claim regarding the names of the installations.

III. Conclusion

For the foregoing reasons, we affirm the district court’s decision to dismiss Munro’s trade dress, fraud, and tortious interference claims as well as its denial of Munro’s motion to amend these claims because the proposed amendments are futile. However, we find that Munro has sufficiently pled a trademark claim so as to survive a motion to dismiss for failure to state a claim. Accordingly, we reverse the district court’s dismissal of Munro’s trademark claim. Furthermore, we reverse the denial of Munro’s motion to amend his complaint with respect to this claim. Finally, we remand the trademark claim under 15 U.S.C. 1125(a) to the district court for further proceedings consistent with this opinion.

APPENDIX B
UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA

BRUCE MUNRO and BRUCE MUNRO STUDIO, Plaintiffs, v. LUCY ACTIVEWEAR, INC., LUCY APPAREL, LLC, VF OUTDOOR, INC., and VF CORPORATION, Defendants.	Civil No. 16-79 (JRT/KMM) MEMORANDUM OPINION AND ORDER GRANTING MOTION TO DISMISS (Filed Sep. 29, 2016)
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Carl F. Schwenker, **LAW OFFICES OF CARL F. SCHWENKER**, 1101 East Eleventh Street, Austin, TX 78702; Steven L. Theesfeld, **YOST & BAILL, LLP**, 220 South Sixth Street, Suite 2050, Minneapolis, MN 55402, for plaintiffs.

Lora Mitchell Friedemann and Nikola L. Datzov, **FREDRIKSON & BYRON, PA**, 200 South Sixth Street, Suite 4000, Minneapolis, MN 55402, for defendants.

Plaintiffs Bruce Munro and Bruce Munro Studio (collectively “Munro”) bring this action alleging trademark, trade dress, and various state law claims against Defendants Lucy Activewear, Inc., Lucy Apparel, LLC, VF Outdoor, Inc., and VF Corporation. Munro’s claims stem from a light display Defendants

created in Boston and used in Lucy Activewear marketing campaigns nationally, and which Munro alleges copied his work. Defendants move to dismiss all claims, and Munro moves to amend his complaint. Because the Court finds that, even considering Munro's amended complaint, each of Munro's claims is either preempted by the Copyright Act or not sufficiently pleaded, the Court will grant Defendants' motion to dismiss and deny Munro's motion to amend his complaint as futile. However, the Court will dismiss Munro's fraud claim and his trademark claim, to the extent it is based on the similarity in name between the light displays, without prejudice because he could theoretically state a claim on those bases.

BACKGROUND¹

Munro alleges that he is "a globally acclaimed and internationally recognized artist" and that he is "best known for large-scale, immersive, light-based works, sculptures, installations, and exhibitions." (Notice of Removal, Ex. D ("Compl.") ¶ 31, Sept. 2, 2015, Docket No. 1; *see also* Pls.' Ex. Index, Ex. 1 ("Am. Compl.") ¶¶ 1, 13, Mar. 10, 2016, Docket No. 51.) He has sold and exhibited his works in the United States and Europe, and

¹ For the purposes of reciting the factual allegations, the Court cites both the complaint, (Notice of Removal, Ex. D ("Compl."), Sept. 2, 2015, Docket No. 1), and the proposed amended complaint, (Pls.' Ex. Index, Ex. 1 ("Am. Compl."), Mar. 10, 2016, Docket No. 51), because, as discussed further below, the Court will consider whether Munro has stated a claim under either complaint.

Field of Light and Forest of Light are his best-known works. (Compl. ¶¶ 34, 38-39; Am. Compl. ¶¶ 14, 16, 18.) Based on those works, Munro claims trade dress in “large-scale, immersive, light-based design utilizing arrays of thousands of short, end-lighted stems with variably lit bulbs traversably laid out upon a predominantly green space.” (Compl. ¶ 82.)²

Defendants Lucy Activewear, Inc., Lucy Apparel, LLC, VF Outdoor Inc., and VF Corp., are all involved in the Lucy brand and Lucy Activewear products. (Compl. ¶¶ 14-18.) Munro’s amended complaint would keep as a defendant VF Outdoor Inc., the subsidiary of VF Corporation allegedly responsible for Lucy’s day-to-day operations, but would replace the rest of the current defendants with Mono Advertising, LLC (“Mono”), the company that managed the advertising campaign at issue. (Am. Compl. ¶¶ 49-52.)

Munro alleges that Mono contacted him through its employee Melissa Rothman and proposed a Lucy advertising and promotional campaign involving Munro’s work. (Compl. ¶¶ 62-63; Am. Compl. ¶¶ 54-55.) Munro alleges that Rothman requested additional information about Munro’s prior work, including the Field of Light and Forest of Light exhibitions, such as

² Munro’s amended complaint is somewhat reworded, but substantially similar, claiming trade dress for works including the following elements: “(1) an outdoor exhibit; (2) of large scale; (3) a light-based design; (4) thousands of short, end-lighted stems or ‘stalks’; (5) in an array; (6) arranged upon a predominantly green space; (7) positioned off-kilter or splayed from the perpendicular; and (8) topped with variably lit bulbs.” (Am. Compl. ¶ 22.)

“attendance figures, achieved online/multi-media traffic, and promotional methods used for the exhibitions,” which she agreed to keep confidential. (Compl. ¶ 64; Am. Compl. ¶ 56.) Munro allegedly disclosed illustrations of his Field of Light and Forest of Light works and marketing and business techniques to promote his works. (Compl. ¶ 65; Am. Compl. ¶ 57.) Munro also disclosed to Mono that “public officials in Boston’s Mayor’s Office of Arts, Tourism & Special Events were also courting and had contacted Munro” about creating a public exhibition in Boston. (Compl. ¶ 66; *see also* Am. Compl. ¶¶ 57-58.) According to Munro, Rothman and Mono then stopped contacting him, and communications from Boston officials ceased soon thereafter. (Compl. ¶¶ 67-68; Am. Compl. ¶¶ 59-60.) Munro assumed that the project was abandoned. (Compl. ¶ 67; Am. Compl. ¶¶ 62.)

Defendants and Mono in fact launched a Lucy light exhibition and advertising campaign in Boston in October 2013, titled Light Forest. (Compl. ¶ 75; Am. Compl. ¶¶ 63-64.) Munro alleges that in making Light Forest, Defendants relied on the confidential information Munro provided about his works, including his marketing methods for an exhibit of that style. (Compl. ¶¶ 70-71; Am. Compl. ¶ 111.) Munro contends that Light Forest copied elements of his prior works, “including but not limited to the large-scale, immersive, light-based design utilizing arrays of thousands of short, end-lighted stems with variably lit bulbs traversably laid out upon a predominantly green space.” (Compl. ¶ 82; *see also* Am. Compl. ¶ 65.) Mono’s

webpage discussing the exhibit states that the Light Forest was “a unique, interactive light and sound installation that responds to participants’ movement,” was “larger than a football field[,] and consist[ed] of more than 10,000 movement-activated, solar-powered LED lights.” *lucy light forest*, <http://mono-1.com/work/lucy-activewear-light-forest> (last visited Sept. 21, 2016); (*see also* Am. Compl. ¶ 73 (citing the website).)

The advertising campaign included “national TV and web spots, print, in-store mock-up displays, and extensive experiential, online, and social media promotion and engagement, [and was] an immense success.” (Compl. ¶ 77; *see also* Am. Compl. ¶ 70.) According to Munro, Mono has reported the campaign led to more than 100,000 in-person visitors, more than 307 million “PR media impressions,” and increased interest and web traffic for Lucy’s brand. (Compl. ¶ 77; Am. Compl. 70.) The exhibit remains visible online both to promote the Lucy brand and as an example of Mono’s advertising work, and Defendants have suggested they intend to set up another Light Forest in the future. (Compl. ¶ 78; Am. Compl. ¶¶ 72-73.)

Munro alleges that the similar name and elements of the exhibit will confuse attendees and venues seeking exhibits, and they will be led to believe Munro is connected to the exhibit. (Compl. ¶ 132-34; Am. Compl. ¶ 77.) Munro also alleges that Defendants usurped his prospective business opportunity in the Boston area. (Compl. ¶ 111; Am. Compl. ¶ 80.)

Munro filed this action in Texas state court, and Defendants removed on September 2, 2015. (Notice of Removal.) On September 18, 2015, Defendants filed a motion to dismiss for lack of personal jurisdiction, or in the alternative to transfer venue, and a motion to dismiss for failure to state a claim. After a hearing, the court transferred the case to Minnesota on January 14, 2016, so that Mono could be added as a party and because Mono's conduct occurred in Minnesota.

On February 1, 2016, Defendants renewed their motion to dismiss for failure to state a claim, which the prior court dismissed as moot. Munro's 3-page response to this motion primarily requests to amend his complaint, which he argues would avoid many of the issues raised in Defendants' motion to dismiss.³ (Pls.' Mem. in Opp'n to Mot. to Dismiss ("Pls.' Mem. in Opp'n") at 1-2, Feb. 22, 2016, Docket No. 44.) He also adopts the arguments made in his brief before the Western District of Texas. (*Id.* at 3; Pls.' Combined Resp. to Defs.' Mot. to Dismiss, Oct. 20, 2015, Docket No. 17.)

³ Munro also argues that the motion fails because Defendants failed to meet and confer under Local Rule 7.1 and the "renewed" motion to dismiss is not identical to Defendants' prior motion. (Pls.' Mem. in Opp'n to Mot. to Dismiss ("Pls.' Mem. in Opp'n") at 1-2, Feb. 22, 2016, Docket No. 44.) Because Defendants merely renew their prior motion to dismiss, which was fully briefed before the prior court and only restyled to include Eighth Circuit law, the Court finds no prejudice and will consider the motion to dismiss here. *See Issaenko v. Univ. of Minn.*, No. 13-3605, 2016 WL 1271470, at *5 (D. Minn. Mar. 31, 2016).

On March 10, 2016, Munro filed a motion to amend his complaint, stating that doing so would render Defendants' motion to dismiss moot. (Pls.' Mot. for Leave to Amend, Mar. 10, 2016, Docket No. 49.) Both Munro's original complaint and his proposed amended complaint allege the following claims: trademark and trade dress infringement, trademark and trade dress dilution under the Lanham Act, false designation of origin and unfair competition under the Lanham Act, misappropriation, fraud, tortious interference with prospective business opportunities, and unfair competition. Munro's initial complaint also alleged claims titled conspiracy, unjust enrichment, constructive trust, and accounting, but he has abandoned those claims by not including them in his proposed amended complaint, and therefore, the Court will not consider them here.

ANALYSIS

I. MOTION TO AMEND

Faced with Defendants' renewed motion to dismiss, Munro has moved to amend his complaint. Defendants argue that the Court should deny Munro's motion to amend the complaint because it is futile and demonstrates bad faith. Under Federal Rule of Civil Procedure 15(a), courts "should freely give leave" to amend "when justice so requires." "A district court may appropriately deny leave to amend 'where there are compelling reasons such as undue delay, bad faith, or dilatory motive, repeated failure to cure deficiencies by

amendments previously allowed, undue prejudice to the non-moving party, or futility of the amendment.’” *Moses.com Sec., Inc. v. Comprehensive Software Sys., Inc.*, 406 F.3d 1052, 1065 (8th Cir. 2005) (quoting *Hammer v. City of Osage Beach*, 318 F.3d 832, 844 (8th Cir. 2003)). The court does not err in denying a motion to amend due to futility where the amended complaint would not survive a motion to dismiss for failure to state a claim. *Briscoe v. Cty. of St. Louis*, 690 F.3d 1004, 1015 (8th Cir. 2012); *Zutz v. Nelson*, 601 F.3d 842, 850-51 (8th Cir. 2010). Because the Court finds that Munro has failed to state a claim even considering his proposed amended complaint, as discussed below, the Court will deny his motion to amend as futile.⁴

⁴ Defendants also argue that the motion to amend should be denied because it is a bad-faith attempt to prolong the litigation. Defendants point to Munro’s failure to provide a useful redline version of his amended complaint – making it more difficult for Defendants and the Court to compare his two complaints – particularly because Defendants warned Munro of the requirement before he filed. (See Decl. of Lora M. Friedemann, Ex. A, Mar. 17, 2016, Docket No. 53.) Defendants contend that Munro chose to avoid the redline requirement in order to obfuscate, and that the Court should deny the motion on that basis alone. *See O’Neil v. Simplicity, Inc.*, 574 F.3d 501, 505 (8th Cir. 2009) (“A district court does not abuse its discretion in denying leave to amend where a plaintiff has not followed applicable procedural rules.”) Defendants also argue that by failing to address Defendants’ already-briefed substantive arguments in favor of dismissal, but repleading many of the same claims without meaningful additional detail, Munro is further delaying litigation and essentially requesting to proceed to a third round of briefing on the same arguments. *See Brinkman v. Bank of Am., N.A.*, 914 F. Supp. 2d 984, 993 (D. Minn. 2012) (denying motion to amend in part because it demonstrated an attempt to prolong the litigation as long as

II. MOTION TO DISMISS

A. Standard of Review

In reviewing a motion to dismiss brought under Federal Rule of Civil Procedure 12(b)(6), the Court considers all facts alleged in the complaint as true to determine if the complaint states a “claim to relief that is plausible on its face.” *Gomez v. Wells Fargo Bank, N.A.*, 676 F.3d 655, 660 (8th Cir. 2012) (quoting *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009)). To survive a motion to dismiss, a complaint must provide more than “‘labels and conclusions’ or ‘a formulaic recitation of the elements of a cause of action.’” *Ashcroft*, 556 U.S. at 678 (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555 (2007)). “A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.” *Id.* “Where a complaint pleads facts that are merely consistent with a defendant’s liability, it stops short of the line between possibility and plausibility,” and therefore must be dismissed. *Id.* (internal quotation marks omitted). Finally, Rule 12(b)(6) “authorizes a court to dismiss a claim on the basis of a dispositive issue of law.” *Neitzke v. Williams*, 490 U.S. 319, 326 (1989).

possible); *Ikeri v. Sallie Mae, Inc.*, No. 13-1943, 2014 WL 4071953, at *2 (D. Minn. Aug. 18, 2014) (denying motion to amend in part because “the claims are nearly identical to those that the magistrate judge previously considered and rejected”). While these actions are potentially troubling, the Court will deny Munro’s motion to amend as futile and thus, it need not consider Defendants’ arguments regarding bad faith.

B. Trademark and Trade Dress Claims

First, Munro alleges various trademark and trade dress claims against Defendants. Munro brings three types of Lanham Act claims: trademark and trade dress infringement under 15 U.S.C. § 1125(a), trademark and trade dress dilution under 15 U.S.C. § 1125(c), and false designation of origin under 15 U.S.C. § 1125(a), but they are all based on Defendants' use of Munro's style of light display and a similar name both on the exhibit and in later advertising and promotional materials. (*See, e.g.*, Am. Compl. ¶ 84 ("Defendants have used the term 'Light Forest' and the overall look and feel of the Munro Trade Dress'....").) Section 1125(a) provides a remedy against:

- (1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which –
 - (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association of such person with another person, or as to origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or
 - (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or

another person's goods, services, or commercial activities. . . .

15 U.S.C. § 1125(a). Essentially, the provision prohibits “passing off,” where “a producer misrepresents his own goods or services as someone else’s,” and “reverse passing off,” where “[t]he producer misrepresents someone else’s goods or services as his own.” *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 27 n.1 (2003). Section 1125(c) allows for an injunction against anyone using a famous “mark or trade name in commerce that is likely to cause dilution by blurring or dilution by garnishment of the famous mark.” 15 U.S.C. § 1125(c).

Here, however, Munro is not alleging a typical trademark or trade dress claim – Defendants are not taking Munro’s goods and passing them off as their own, or copying Munro’s packaging so that customers will buy their goods thinking they are Munro’s goods. Instead, Munro essentially argues that copying the look and feel of his light displays and using a similar name would cause confusion – causing the public to think that they were Munro’s works or associated with Munro – or give unfair benefits to Defendants based on Munro’s work. (Am. Compl. ¶ 87; Compl. ¶¶ 150, 152.) He describes his trade dress broadly, including: “(1) an outdoor exhibit; (2) of large scale; (3) a light-based design; (4) thousands of short, end-lighted stems or ‘stalks’; (5) in an array; (6) arranged upon a predominantly green space; (7) positioned off-kilter or splayed from the perpendicular; and (8) topped with variably lit bulbs.” (Am. Compl. ¶ 22.)

Courts, however, are “‘careful to caution against misuse or over-extension’ of trademark and related protections into areas traditionally occupied by patent or copyright.” *Dastar Corp.*, 539 U.S. at 34 (quoting *TraffFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29 (2001)). Copyright and patent laws are meant to protect against copying the originality and creativity of another, for a certain time and under certain guidelines, while the Lanham Act and trademark law serve a distinct purpose. *See id.* at 37. The Lanham Act “prevent[s] competitors from copying ‘a source-identifying mark,’ [thereby] ‘reduc[ing] the customer’s costs of shopping and making purchasing decisions,’ and ‘help[ing] assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product.’” *Id.* at 34 (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163-64 (1995)). “The Lanham Act – which, unlike the patent and copyright regimes, creates exclusive rights that have no automatic expiration – does not create ‘a species of perpetual patent and copyright,’ nor does it create ‘a cause of action for, in effect, plagiarism – the use of otherwise unprotected works and inventions without attribution.’” *Kehoe Component Sales Inc. v. Best Lighting Prods., Inc.*, 796 F.3d 576, 588 (6th Cir. 2015) (quoting *Dastar*, 539 U.S. at 33-34, 36, 37). Rather, the Lanham Act aims to “protect[] consumers from confusion as to source,” which does not justify reading the Act “so broadly that it provides a way for inventors to stifle indefinitely the mimicry of items that have been neither patented nor copyrighted.” *Id.* at 589. “The right question [under the

Lanham Act] is whether the consumer knows who has produced the finished product’ even if ‘most of the product’s economic value came from elsewhere.’” *Id.* at 589 (quoting *Bretford Mfg., Inc. v. Smith Sys. Mfg. Corp.*, 419 F.3d 576, 581 (7th Cir. 2005)).

Based on these principles, to the extent Munro bases his claim on the similar style of exhibit, including the trade dress described above, his claim fails. The Lanham Act “‘does not protect the content of a creative work of artistic expression’ because an ‘artist’s right in an abstract design or other creative work’ is protected by copyright law.” *Ward v. Andrews McMeel Publ’g, LLC*, 963 F. Supp. 2d 222, 235 (S.D.N.Y. 2013) (quoting *EMI Catalogue P’ship v. Hill, Holliday, Connors, Cosmopolos Inc.*, 228 F.3d 56, 63 (2d Cir. 2000)). For example, in *Galerie Furstenberg v. Coffaro*, the plaintiff who owned exclusive rights to some of Salvador Dali’s drawings and etchings brought trademark claims against individuals that recreated similar works themselves. 697 F. Supp. 1282, 1289-90 (S.D.N.Y. 1988). The plaintiffs argued that the defendants invoked Dali’s distinct style and violated their trademark. *Id.* The court interpreted their claim as one for false designation of origin, but found no trademark because the claim would have been “properly brought under the federal copyright, not trademark, statute.” *Id.* at 1290. The court also dismissed the plaintiff’s trademark dilution claim because it found no trademark in specific works of visual art by Dali. *Id.* at 1291; *see also Milstein, Inc. v. Greger, Lawlor, Roth, Inc.*, 58 F.3d 27, 33 (2d Cir. 1995) (noting trade dress law does not “protect

an idea, a concept, or a generalized type of appearance,” and denying the plaintiff’s claim as “effectively seeking protection for an idea or concept – die-cut photographic greeting cards”).

Additionally, when dealing with artistic works, courts have been wary to extend trademark protections over works properly the subject of copyright law. In *Leigh v. Warner Bros.*, the court found that a photographer’s famous photograph used on his gallery’s promotion materials was not covered under trade dress law, reasoning that the image “strikes us not as a separate and distinct mark **on the good**, but, rather, as the good itself.” 212 F.3d 1210, 1218 (11th Cir. 2000) (quoting *Rock & Roll Hall of Fame & Musuem, Inc. v. Gentile Prods.*, 134 F.3d 749, 754 (6th Cir. 1998)).

Similarly, in *RDF Media Ltd. v. Fox Broad. Co.*, the court rejected the plaintiff’s attempts to bring trade dress claims based on the similarities between two reality television shows because the plaintiff sought to establish trade dress in the show itself. 372 F. Supp. 2d 556, 563 (C.D. Cal. 2005) (“Because this would be tantamount to saying that the product itself – in this case, the [reality show] – can serve as its own trademark, we decline to do so.” (quoting *EMI Catalogue*, 228 F.3d at 63)). The court distinguished trademark and copyright claims, stating that while “[t]rademark law is concerned with protection of the symbols, elements or devices used to identify a product in the marketplace and to prevent confusion as to its source[, i]t does not protect the content of a creative work of artistic expression

as a trademark for itself.” *Id.* (quoting *EMI Catalogue*, 228 F.3d at 63).

In response, Munro cites *RMS Titanic, Inc. v. Zal-ler*, 978 F. Supp. 2d 1275 (N.D. Ga. 2013). In that case the Northern District of Georgia considered a trade dress infringement claim based on the copying of a large-scale Titanic exhibit. *Id.* at 1293-94. At the motion-to-dismiss stage, the court allowed the trade dress infringement claim, but it did not discuss why trade dress protections applied or the overlap between the Lanham Act and Copyright Act. *Id.* Thus, the RMS Titanic case does not respond to the serious questions raised in the other cases cited regarding how to balance copyright and trademark protections in accordance with the purposes of both doctrines.

Here, Munro’s claims fail to the extent he claims trademark or trade dress protection for his style of light display because the light display is the good itself, rather than a mark on the good. *See Leigh*, 212 F.3d at 1218. Moreover, extending trademark protection to a particular style of artistic expression would improperly extend trademark law into the area of copyright protection. *See Galerie Furstenberg*, 697 F. Supp. at 1289-90. Thus, the Court will dismiss with prejudice the trademark and trade dress claims to the extent they are based on Munro’s style and the elements of Munro’s artistic works.

To the extent Munro’s claim is based on the similarity in name between Light Forest and Forest of Light, it presents a closer question. The parties do not

address this issue precisely, but in theory, the title of an artistic work could be a trademark if it identifies the source of goods or services. The Lanham Act defines a trademark as “any word, name, symbol, or device . . . used by a person . . . to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods.” 15 U.S.C. § 1127.

Defendants argue that Munro has not pleaded that any trademark is tied to goods or services, arguing that Munro’s works “merely identif[y] the artist rather than any products or services.” *Leigh v. Warner Bros.*, 10 F. Supp. 2d 1371, 1380 (S.D. Ga. 1998), *aff’d in part and rev’d in part on other grounds*, 212 F.3d 1210 (11th Cir. 2000). Munro has not provided facts suggesting that the name Forest of Light served a source-identifying function for a product or service. *See Leigh*, 212 F.3d at 1218 (finding that a photographer’s “web sites and printed advertisements or announcements largely use [the artwork] descriptively, as an example of [the photographer’s] work, rather than as a trademark”). Munro does state that his endeavors related to the Field of Light and Forest of Light exhibitions “have grown to include an online presence, books, publications, apparel, videos, and documentaries,” but he does not state whether the name Forest of Light is a mark on those items or whether it identifies the source of those items. (Am. Compl. ¶ 43.) Indeed, in discussing the likelihood of confusion based on the similar name, Munro states that visitors and venue purveyors may be confused and assume that the exhibit is associated

with Munro, (*id.* ¶ 77); he does not link it to any goods or services, only to himself. Thus, Munro has failed to state a trademark claim based on the name Forest of Light. However, because Munro could theoretically state a claim based on the similarities in name, if they are tied to goods and services, the Court will dismiss this claim without prejudice.

C. State Law Claims⁵

1. Preemption

Defendants contend that Munro's tortious interference, misappropriation, and unfair competition claims are based on the alleged copying of Munro's light displays, and therefore, they are preempted by the Copyright Act. "The Copyright Act preempts state laws that attempt to protect rights exclusively protected by federal law." *Davidson & Assocs. v. Jung*, 422 F.3d 630, 638 (8th Cir. 2005) (interpreting 17 U.S.C. § 301(a)).⁶ Under the Copyright Act, a state law claim is preempted if

⁵ The Court notes that Minnesota law applies to Munro's state law claims because this case was transferred due to improper venue under 28 U.S.C. § 1406(a). *See Eggleton v. Plasser & Theurer Exp. Von Bahnbaumaschinen Gesellschaft, MBH*, 495 F.3d 582, 590 (8th Cir. 2007) (stating that generally "[a] § 1406 transfer calls for application of the law of the transferee court").

⁶ Specifically, the Copyright Act states:

On and after January 1, 1978, **all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright** as specified by section 106 in works of authorship that are

(1) the work at issue is within the subject matter of copyright as defined in § 102 and 103 of the Copyright Act, and (2) the state law created right is equivalent to any of the exclusive rights within the general scope of copyright as specified in § 106 [of the Copyright Act].

Ray v. ESPN, Inc., 783 F.3d 1140, 1142 (8th Cir. 2015) (quoting *Nat'l Car Rental Sys., Inc. v. Comput. Assocs. Int'l, Inc.*, 991 F.2d 426, 428 (8th Cir. 1993)).

The subject matter of copyright extends to “original works of authorship fixed in any tangible medium of expression,” and includes “pictorial, graphic, sculptural works,” “motion pictures and other audiovisual works,” and “architectural works.” 17 U.S.C. § 102(a). Munro’s claims relate to his prior light displays Forest of Light and Field of Light, which are artistic works under the Copyright Act. Munro refers to himself as an artist, and refers to his prior displays at his “works,” “light-based artwork and installations.” (Compl. ¶¶ 31-38; Am. Compl. ¶¶ 13-15.) Thus, his works are within the subject matter of copyright.

fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after the date and whether published or unpublished, **are governed exclusively by this title**. Thereafter, no person is entitled to **any such right or equivalent right** in any such work under the common law or statutes of any State.

17 U.S.C. § 301(a) (emphasis added).

If the work at issue is within the subject matter of copyright, the claims based on those works are preempted to the extent that “the state law created right is equivalent to any of the exclusive rights within the general scope of copyright as specified in § 106 [of the Copyright Act].” *Ray*, 783 F.3d at 1142. The Copyright Act “preempts only those state law rights that ‘may be abridged by an act which, in and of itself, would infringe one of the exclusive rights provided by federal copyright law.’” *Nat'l Car Rental Sys.*, 991 F.2d at 431 (quoting *Comput. Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 716 (2d Cir. 1992)). The exclusive rights granted in § 106 include the right to reproduce the copyrighted work, to distribute copies of the work, and to display the work publicly. 17 U.S.C. § 106. “If an extra element is ‘required, instead of or in addition to the acts of reproduction, performance, distribution or display, in order to constitute a state-created cause of action, then the right does not lie within the general scope of copyright and there is no preemption.’” *Nat'l Car Rental Sys.*, 991 F.2d at 431 (quoting 1 Nimmer on Copyright § 1.01[B], at 1-14-15). However, to prevent preemption, “the extra element [must] change[] the nature of the action so that it is qualitatively different from a copyright infringement claim.” *Stromback v. New Line Cinema*, 384 F.3d 283, 301 (6th Cir. 2004) (quoting *Wrench LLC v. Taco Bell Corp.*, 256 F.3d 446, 456 (6th Cir. 2001)). “The existence of an extra element precludes preemption only where the element changes the nature, rather than the scope, of the action.” *Id.*; see also *Summit Mach. Tool Mfg. Corp. v. Victor CNC Sys., Inc.*, 7 F.3d 1434, 1441-42 (9th Cir. 1993)

(requiring that an extra element change the nature of the claim to avoid preemption).

Defendants contend that Munro's state law claims are based on the alleged use, display, or reproduction of Munro's light displays, and therefore, are preempted. Each claim will be discussed individually below along with Defendants' arguments that Munro failed to state a claim even if the claims are not preempted.

Before this Court, Munro's only substantive argument against dismissal of his state law claims is that Defendants' preemption arguments are premature. (Pls.' Mem. in Supp. of Mot. to Amend at 5 n.3, Mar. 10, 2016, Docket No. 50.) Munro cites only one case for support, and he does so incorrectly, attributing the quote "factual development is necessary . . . [and] defendant's 12(b)(6) motion to dismiss is not the appropriate vehicle through which the Court should address the overlap between the Lanham Act and Copyright Act" to *Johnson Controls, Inc. v. Phoenix Control Systems, Inc.*, 886 F.2d 1173, 1175 (9th Cir. 1989).⁷ (*Id.*) This quote in fact comes from *Blue Nile, Inc. v. Ice.com, Inc.*, 478 F. Supp. 2d 1240, 1243 (W.D. Wash. 2007). In that case, the court found that it needed more factual development to consider "the overlap between the Lanham Act and Copyright Act in the context of a claim attempting to protect a website's 'look and feel.'" *Id.* at

⁷ *Johnson Controls* itself appears not to be relevant. In that case, the court upheld the district court's issuance of a preliminary injunction in a copyright claim involving a website, and it did not involve preemption or trademark claims. 886 F.2d at 1177.

1245. Thus, the quotation Munro relies on does not suggest that courts categorically avoid Copyright Act preemption arguments at the motion-to-dismiss stage; rather, the court in *Blue Nile* found that it needed additional factual development when facing a particular question about the overlap of the Copyright Act and the Lanham Act in website design. Rule 12 motions test the viability of a cause of action, and other courts have found this to be a proper stage to hear Copyright Act preemption arguments. *See, e.g., Ray*, 783 F.3d at 1142, 1144-45 (affirming a Rule 12(b)(6) dismissal of state law claims as preempted by the Copyright Act). Thus, the Court will consider whether each of Munro's claims are preempted by the Copyright Act, along with Defendants' other challenges.

2. Tortious Interference with Prospective Business Opportunities

Munro alleges that Defendants tortiously interfered with his prospective business opportunity for a light display exhibit in Boston. In support, Munro alleges that Defendants knew that he was talking with Boston officials about a public exhibit, and that they usurped his opportunity by contacting Boston officials with their proposed light exhibit plan. (Compl. ¶¶ 110-114; Am. Compl. ¶¶ 116-122.) Defendants contend that Munro's tortious interference claim is preempted by the Copyright Act, and that even if it is not preempted, he failed to state a claim.

A state right is equivalent for the purposes of Copyright Act preemption if “the mere act of reproduction, performance, distribution, or display” infringes the state right. *Nat'l Car Rental Sys.*, 991 F.2d at 431. For a claim of tortious interference with prospective business relations under Minnesota law, a plaintiff must show: (1) the existence of a reasonable expectation of economic advantage or benefit belonging to plaintiff; (2) that the defendants knew of that expectation; (3) that defendants wrongfully and without justification interfered with plaintiff’s reasonable expectation; (4) that in the absence of the defendants’ wrongful act, it is reasonably probable that plaintiff would have realized the economic advantage or benefit; and (5) that plaintiff sustained damages. *Cenveo Corp. v. S. Graphic Sys., Inc.*, 784 F. Supp. 2d 1130, 1137-38 (D. Minn. 2011); *Harbor Broad., Inc. v. Boundary Waters Broads., Inc.*, 636 N.W. 2d 560, 569 (Minn. Ct. App. 2001). Based on those elements and Munro’s allegations, his tortious interference claim is based on somewhat more than just reproduction of his works: he alleges that Defendants knew of his opportunity with Boston officials and intentionally interfered with that opportunity by taking it themselves.

Even if an additional act is required, however, the state law claim is still preempted unless “the extra element changes the nature of the action so that it is qualitatively different from a copyright infringement claim.” *Stromback*, 384 F.3d at 301 (quoting *Wrench LLC*, 256 F.3d at 456). In *Stromback*, the Sixth Circuit found that a tortious interference claim was not

qualitatively different than a copyright claim because the “foundation” of the claim was the violation of rights based in the Copyright Act. *Id.* at 306-07. The court noted that the additional requirements of knowledge of and intentional interference with a contract make the claim narrower than copyright, but not qualitatively different, because copyright protection anticipates the loss of opportunities and benefits based on unauthorized copying. *Id.* at 306.⁸ The additional act Munro presents – knowing solicitation of a particular customer for a similar exhibit – narrows the scope of the claim, but does not qualitatively alter the nature of the claim. The foundation of his tortious interference claim is still Defendants’ alleged improper copying of his exhibit, and therefore, the claim is preempted by the Copyright Act.

Even if Munro’s tortious interference claim were not preempted, it should still be dismissed because he failed to state a claim. Munro alleges that he had “reasonable probabilities of prospective business opportunities to stage a large-scale, public exhibition” in Boston, and “reasonable probabilities of prospective

⁸ See also *Papa Berg, Inc. v. World Wrestling Entm’t, Inc.*, No. 12-2406, 2013 WL 2090547, at *12 (N.D. Tex. May 15, 2013) (finding a tortious interference claim preempted to the extent it was based on reproduction and distribution of protected works, but not preempted to the extent it was based on re-registration and diversion of royalties); *Warren Sign Co. v. Piros Signs, Inc.*, No. 9-1984, 2010 WL 2802023, at *3-4 (E.D. Mo. July 15, 2010) (finding additional elements of awareness and intentional interference did not change the nature of the action and dismissing tortious interference claim as preempted by the Copyright Act).

business relationships with the City of Boston, the Boston Mayor’s office, other local public officials, and affiliated entities and arts organizations.” (Compl. ¶ 111; Am. Compl. ¶ 117.) When describing his talks with Boston at that time, he alleges only that he was contacted by “officials in Boston’s Mayor’s Office of Arts, Tourism & Special Events,” and that they “expressed intense interest in bringing a public exhibition of Munro’s installations to Boston” the next year. (Am. Compl. ¶ 58; *see also* Compl. ¶ 66.) He alleges that after he stopped hearing from Defendants, “communications with Boston public officials on the opportunity for a Munro Boston exhibition tapered off, too.” (Compl. ¶¶ 67-68; Am. Compl. ¶¶ 59-60.) He also described the Boston officials’ interest in his work as “courting.” (Compl. ¶ 66; Am. Compl. ¶ 116.) These allegations do not suggest a reasonable probability of a contractual relationship with Boston officials or that Defendants communicated with them or had the intent to interfere with Munro’s relationship with the officials. This “courting” by Boston officials suggests the early stages of an agreement, not a reasonable probability that Munro would have realized an economic advantage or benefit. *See Cenveo Corp.*, 784 F. Supp. 2d at 1137-38.

Thus, the Court finds that Munro’s tortious interference claim in this context is preempted by the Copyright Act, and that even if it were not, he has failed to state a claim for tortious interference.

3. Misappropriation

Munro brings a common law misappropriation claim based on Defendants' copying of his prior works and his "exhibition processes and promotional models and methods." (Compl. ¶¶ 122-25; *see also* Am. Compl. ¶ 100-04.) To the extent he bases his misappropriation claim on the copying of his style of light displays, it is preempted by the Copyright Act. *See Belmore v. City Pages, Inc.*, 880 F. Supp. 673, 676 n.1 (D. Minn. 1995) (finding the Copyright Act provides the exclusive remedy for unauthorized copying and that misappropriation claims for unauthorized copying of protected works were preempted).

To the extent Munro's misappropriation claim is not preempted, it fails to state a claim. Munro's misappropriation claim before the Texas court relied on Texas cases providing a tort of misappropriation. *See U.S. Sporting Prods., Inc. v. Johnny Stewart Game Calls, Inc.*, 865 S.W.2d 214, 218 (Tex. Ct. App. 1993). In his motion to amend, Munro now cites only a 1918 Supreme Court case, *International News Service v. Associated Press*, 248 U.S. 215 (1918). (Am. Compl. ¶ 104.) However, that case was decided before *Erie* and created federal common law in a case arising under state law, and thus it is no longer authoritative. *McKevitt v. Pal-lasch*, 339 F.3d 530, 534 (7th Cir. 2003). Some states have recognized common law claims of the same type, *see Sioux Biochemical, Inc. v. Cargill, Inc.*, 410 F. Supp. 2d 785, 805 (N.D. Iowa 2005) (collecting cases), but there is no indication that Minnesota is one of them.

Even in those states that have recognized such a claim, it is generally limited to the “hot news” doctrine established by *International News Service*. See *Fred Wehrenberg Circuit of Theatres, Inc. v. Moviefone, Inc.*, 73 F. Supp. 2d 1044, 1049-50 (E.D. Mo. 1999) (finding a “hot news” exception to preemption of Missouri misappropriation law). However, even if the “hot news” doctrine existed in Minnesota, Munro has not pleaded any facts meeting such a limited exception. See *id.* (describing the elements of a “hot news” misappropriation claim and finding the plaintiff’s claim failed because it did not meet the final element – allowing copying in the context would not “so reduce the incentive to produce the product or service that its existence or quality would be substantially threatened”). Thus, Munro’s common law misappropriation claim fails as preempted by the Copyright Act and due to the lack of a cause of action in Minnesota law.⁹

⁹ While Minnesota law recognizes claims based on the misappropriation of trade secrets, see, e.g., *Reliastar Life Ins. Co. v. KMG Am. Corp.*, No. 05-2079, 2006 WL 2529760, at *3 (Minn. Ct. App. Sept. 5, 2006) (interpreting a tort of breach of confidentiality claim as “the common-law version of misappropriation of trade secrets”), Munro has not attempted to allege the elements of such a claim, see *id.* at *4 (“To qualify as a trade secret under [Minnesota law], information (1) must not be generally known or readily ascertainable, (2) must derive independent economic value from secrecy; and (3) must be the subject of reasonable efforts to maintain its secrecy.”).

4. Unfair Competition

Munro's unfair competition claim essentially restates all of his other claims:

Defendants have used, infringed, and diluted the Munro Marks and Munro Trade Dress without authorization; misappropriated Munro's time, labor, skills, and efforts and the fruits thereof for self-serving competitive purposes and advantages; interfered with and usurped Munro's business opportunities and relationships; and acted dishonestly, unethically, and fraudulently towards Munro.

(Am. Compl. ¶ 138; *see also* Compl. ¶ 182 (stating the same).) Defendants argue that the claim is preempted in the same manner as the other claims that it restates and that it also fails because it is not an independent tort.

“Unfair competition is not a tort with specific elements; it describes a general category of torts which courts recognize for the protection of commercial interests,” including product disparagement, tortious interference with contract, and improper use of trade secrets. *Zimmerman Grp., Inc. v. Fairmont Foods of Minn., Inc.*, 882 F. Supp. 892, 895 (D. Minn. 1994) (quoting *Rehab. Specialists, Inc. v. Koering*, 404 N.W.2d 301, 305-06 (Minn. Ct. App. 1987))). “[T]o remain viable, a common law unfair competition claim ‘must identify the underlying tort which is the basis for [the claim].’” *LensCrafters, Inc. v. Vision World, Inc.*, 943 F. Supp. 1481, 1490 (D. Minn. 1996) (quoting *Zimmerman*, 882 F. Supp. at 895). Where an unfair

competition claim is duplicative of another claim in the complaint, the unfair competition claim should be dismissed. *See Zimmerman*, 882 F. Supp. at 895 (dismissing an unfair competition claim duplicative of an interference with contract claim).

To the extent that Munro's unfair competition claim is based on the copying of his light displays, it is preempted by the Copyright Act. To the extent the claim reaches other conduct, Munro has failed to identify any underlying tort or it is duplicative of his other claims. Therefore, the Court will dismiss his general unfair competition claim with prejudice.

5. Fraud

Munro brings a common law fraud claim, alleging that Defendants made false or fraudulent statements that they would keep the information and materials Munro provided confidential. (Compl. ¶ 103; Am. Compl. ¶ 108.) Munro alleges that those statements were "knowingly false . . . or were made with reckless disregard of their falsity," that Defendants never intended to keep the information confidential, and that "on information and belief, [Defendants] shared them and their contents with others and used the materials and the information contained therein to facilitate the creation, design, production, and promotion" of the Light Forest exhibit and campaign. (Compl. ¶ 105-06; *see also* Am. Compl. ¶¶110-11.) Munro also alleges that he relied on those representations and was harmed by the fraud. (Compl. ¶¶ 104, 108; Am. Compl. ¶¶ 109,

113.) In his amended complaint, Munro adds that the conversations involved Rothman and Munro and occurred between October 18 and 22, 2012. (Am. Compl. ¶ 108.)

Allegations of fraud “must be pled with particularity.” *Cox v. Mortg. Elec. Registration Sys., Inc.*, 685 F.3d 663, 672-73 (8th Cir. 2012) (quoting *Trooien v. Mansour*, 608 F.3d 1020, 1028 (8th Cir. 2010)); *see also* Fed. R. Civ. P. 9(b) (requiring that circumstances constituting fraud or mistake be pled with particularity). Rule 9(b) “requires that a pleading include ‘such matters as the time, place and contents of false representations.’” *Trooien*, 608 F.3d at 1028 (quoting *Bennet v. Berg*, 685 F.2d 1053, 1062 (8th Cir. 1982)).

Defendants contend that Munro has not alleged facts of a particular statement, who made the statement, when the statement was made, or any facts supporting an inference that the statement was false; rather, he has only pleaded “[o]n information and belief” that a confidentiality promise was broken. (Compl. ¶¶ 103-06.) Munro’s proposed amended complaint adds the “who” and “when” – Rothman and between October 18 and 22, 2012. (Am. Compl. ¶ 108.) But, Munro still makes only bare assertions that Rothman’s promise of confidentiality was false and that Defendants used and shared the confidential information in making the Light Forest exhibit; both were pled only “on information and belief.” In *Florida State Board of Administration v. Green Tree Financial Corp.*, the court suggested that Rule 9(b) “requir[es] disclosure of facts relied on for pleadings based on information and

belief.” 270 F.3d 645, 668 (8th Cir. 2001). Accordingly, Munro must plead some facts supporting his “on information and belief” allegations. The only fact Munro provides supporting his belief that Defendants never intended to maintain confidentiality, and in fact breached his confidences, is that Defendants made their own light display in Boston. The Court finds this single fact insufficient to support the inference that Defendants intended to and did in fact breach a confidentiality promise; however, because Munro could potentially state a claim for common law fraud with additional allegations, the Court will dismiss this claim without prejudice.

ORDER

Based on the foregoing, and all the files, records, and proceedings herein, **IT IS HEREBY ORDERED that:**

1. Defendants’ Motion to Dismiss [Docket No. 35] is **GRANTED**.
2. Munro’s trademark claim to the extent it is based on the similarity in name and Munro’s fraud claim are **DISMISSED without prejudice**.
3. All other claims are **DISMISSED with prejudice**.
4. Munro’s Motion for Leave to Amend the Amended Complaint [Docket No. 49] is **DENIED**.

**LET JUDGMENT BE ENTERED ACCORD-
INGLY.**

DATED: September 29, 2016 s/ John R. Tunheim
at Minneapolis, Minnesota. JOHN R. TUNHEIM
Chief Judge
United States
District Court

APPENDIX C
UNITED STATES CODE
Title 15 – COMMERCE AND TRADE
CHAPTER 22 – TRADEMARKS
SUBCHAPTER III – GENERAL PROVISIONS

Sec. 1117 – Recovery for violation of rights

15 U.S.C. § 1117. Recovery for violation of rights

(a) Profits; damages and costs; attorney fees

When a violation of any right of the registrant of a mark registered in the Patent and Trademark Office, a violation under section 1125(a) or (d) of this title, or a willful violation under section 1125(c) of this title, shall have been established in any civil action arising under this chapter, the plaintiff shall be entitled, subject to the provisions of sections 1111 and 1114 of this title, and subject to the principles of equity, to recover (1) defendant's profits, (2) any damages sustained by the plaintiff, and (3) the costs of the action. The court shall assess such profits and damages or cause the same to be assessed under its direction. In assessing profits the plaintiff shall be required to prove defendant's sales only; defendant must prove all elements of cost or deduction claimed. In assessing damages the court may enter judgment, according to the circumstances of the case, for any sum above the amount found as actual damages, not exceeding three times such amount. If the court shall find that the amount of the recovery based on profits is either inadequate or excessive the

court may in its discretion enter judgment for such sum as the court shall find to be just, according to the circumstances of the case. Such sum in either of the above circumstances shall constitute compensation and not a penalty. The court in exceptional cases may award reasonable attorney fees to the prevailing party.

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UNITED STATES CODE
Title 15 – COMMERCE AND TRADE
CHAPTER 22 – TRADEMARKS
SUBCHAPTER III – GENERAL PROVISIONS

Sec. 1125 – False designations of origin,
false descriptions, and dilution forbidden

**15 U.S.C. § 1125. False designations of origin,
false descriptions, and dilution forbidden**

(a) Civil action

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin,

sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

(2) As used in this subsection, the term "any person" includes any State, instrumentality of a State or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

(3) In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.

* * *

(c) Dilution by blurring; dilution by tarnishment

(1) Injunctive relief

Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled

to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

(2) Definitions

(A) For purposes of paragraph (1), a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following:

- (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
- (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.
- (iii) The extent of actual recognition of the mark.
- (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

(B) For purposes of paragraph (1), “dilution by blurring” is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark. In determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

- (i) The degree of similarity between the mark or trade name and the famous mark.
- (ii) The degree of inherent or acquired distinctiveness of the famous mark.
- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
- (iv) The degree of recognition of the famous mark.
- (v) Whether the user of the mark or trade name intended to create an association with the famous mark.
- (vi) Any actual association between the mark or trade name and the famous mark.

(C) For purposes of paragraph (1), “dilution by tarnishment” is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.

(3) Exclusions

The following shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection:

(A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person's own goods or services, including use in connection with—

(i) advertising or promotion that permits consumers to compare goods or services; or

(ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.

(B) All forms of news reporting and news commentary.

(C) Any noncommercial use of a mark.

(4) Burden of proof

In a civil action for trade dress dilution under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that—

(A) the claimed trade dress, taken as a whole, is not functional and is famous; and

(B) if the claimed trade dress includes any mark or marks registered on the principal

register, the unregistered matter, taken as a whole, is famous separate and apart from any fame of such registered marks.

(5) Additional remedies

In an action brought under this subsection, the owner of the famous mark shall be entitled to injunctive relief as set forth in section 1116 of this title. The owner of the famous mark shall also be entitled to the remedies set forth in sections 1117(a) and 1118 of this title, subject to the discretion of the court and the principles of equity if—

- (A) the mark or trade name that is likely to cause dilution by blurring or dilution by tarnishment was first used in commerce by the person against whom the injunction is sought after October 6, 2006; and
- (B) in a claim arising under this subsection—

- (i) by reason of dilution by blurring, the person against whom the injunction is sought willfully intended to trade on the recognition of the famous mark; or

- (ii) by reason of dilution by tarnishment, the person against whom the injunction is sought willfully intended to harm the reputation of the famous mark.

* * *

UNITED STATES CODE

Title 17 – COPYRIGHTS

CHAPTER 3 – DURATION OF COPYRIGHT

Sec. 301 – Preemption with respect to other laws

17 U.S.C. § 301. Preemption with respect to other laws

(a) On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.

(b) Nothing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to-

(1) subject matter that does not come within the subject matter of copyright as specified by sections 102 and 103, including works of authorship not fixed in any tangible medium of expression; or

(2) any cause of action arising from undertakings commenced before January 1, 1978;

(3) activities violating legal or equitable rights that are not equivalent to any of the

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exclusive rights within the general scope of copyright as specified by section 106; or

(4) State and local landmarks, historic preservation, zoning, or building codes, relating to architectural works protected under section 102(a)(8).

* * *

(d) Nothing in this title annuls or limits any rights or remedies under any other Federal statute.

(e) The scope of Federal preemption under this section is not affected by the adherence of the United States to the Berne Convention or the satisfaction of obligations of the United States thereunder.

* * *

APPENDIX D
UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA

Bruce Munro and Bruce Munro Studio, Plaintiff(s), vs. Lucy Activewear, Inc., Lucy Apparel, LLC, VF Outdoor, Inc., and VF Corporation, Defendant(s).	Case No. 16-cv-79 (JRT/SER) <u>AMENDED</u> <u>COMPLAINT</u> (Filed Mar. 10, 2016) JURY TRIAL DEMANDED
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Plaintiffs Bruce Munro and Bruce Munro Ltd. d/b/a Bruce Munro Studio (collectively, “Munro” or “Plaintiffs”) allege as follows against Defendants VF Outdoor, Inc. and Mono Advertising, LLC (collectively, “Defendants”):

THE PARTIES

1. Bruce Munro is an internationally acclaimed artist residing in England who focuses on the medium of light and is best known for large-scale, immersive, light-based installations and exhibitions produced through his eponymously named studio.
2. Bruce Munro Ltd. d/b/a Bruce Munro Studio is a United Kingdom entity.

3. VF Outdoor, Inc. (“Outdoor”) is a California-based Delaware corporation that has already appeared in this action and that does business in this District.

4. Mono Advertising, LLC (“Mono”) is a Delaware limited liability company headquartered in Minneapolis, Minnesota that does business in this District and that may be served via its registered agent The Corporation Trust Company, Corporation Trust Center, 1209 Orange Street, Wilmington, Delaware 19801.

JURISDICTION AND VENUE

5. This Court has subject matter jurisdiction under 28 U.S.C. § 1331, 1332, 1338(a) and (b), and 1367. The state and common law claims in this action are so related to the federal claims that they form part of the same case or controversy.

6. The Court has diversity jurisdiction under 28 U.S.C. § 1332, in that this is a civil action wherein the amount in controversy exceeds the sum of \$75,000.00, exclusive of interest and costs, and is between citizens of a state and citizens or subjects of a foreign state.

7. The Court also has subject matter jurisdiction under 28 U.S.C. § 1331 (federal question), as this action also arises under 15 U.S.C. § 1114, et. seq. (the Lanham Act).

8. The Court has personal jurisdiction over these Defendants because they reside, transact business, or have purposefully availed themselves of the privilege of doing business in Minnesota and because the claims

arise out of Defendants' conduct in Minnesota. The Court has established that jurisdiction is proper for all Defendants in this District. Order [ECF # 28].

9. Venue is proper because Defendants reside and conduct business in this District within the contemplation of 28 U.S.C. § 1391. The Court has established that venue of this action is proper in this District for all Defendants. Order [ECF # 28].

NATURE OF THE ACTION

10. This action is for trademark infringement, trade dress infringement, dilution, false designation of origin, and unfair competition under the Lanham Act, 15 U.S.C. § 1114, et seq., and common law; for fraud, common law misappropriation, and tortious interference with business opportunities under state and common law; and for unfair competition under the Paris Convention pursuant to 15 U.S.C. § 1126. Munro is entitled to injunctive, monetary, declaratory, exemplary, and equitable relief, including an accounting and a constructive trust over all benefits unjustly received by Defendants.

11. All claims arise out of a common nucleus of operative facts, Defendants' blatant, continuing, and knowingly unauthorized misappropriation and use in their own businesses, promotions, exhibitions, and marketing of Munro's distinctive and famous trademarks and trade dress associated with Munro's well-known iterative series of site-specific, large-scale, immersive light-based installations and exhibitions

known as *Forest of Light*™ and *Field of Light*® and with Munro's related goods and services. In disregard of confidentiality representations to Munro, Defendants exploited Munro's marks, trade dress, goodwill and efforts associated with Munro's creation, production, and promotion of Munro's acclaimed, signature *Field of Light*® and *Forest of Light*™ installations and exhibitions for their own benefit and to Munro's detriment.

12. The discovery rule, the doctrine of equitable tolling and estoppel, and the continuing tort doctrine apply to Munro's claims. Defendants' activities were concealed from Munro and inherently undiscoverable, even through the exercise of reasonable care.

FACTS

The Bruce Munro Story

13. Bruce Munro is an acclaimed international artist known for light-based works, sculptures, and large-scale immersive installations and exhibitions produced through his studio, Bruce Munro Ltd. d/b/a Bruce Munro Studio.

14. Mr. Munro is beloved throughout the world and his unique, light-based artwork and installations have been sold and exhibited at hundreds of top-tier galleries, museums, and public spaces across the globe for decades.

15. Together, he and his studio create, design, develop, produce, promote and market Munro's creations

and offerings, including Munro's highly successful and internationally lauded *Forest of Light*™ and *Field of Light*® iterative series of site-specific, large-scale, immersive light-based installations and exhibitions that Munro is best known for and that incorporate a consistent and distinctive signature trade dress associated with Munro. Munro authorizes use of *Forest of Light*™ and *Field of Light*® marks, images, illustrations, and indicia for projects, exhibitions, and merchandise, including apparel, giftware, books, calendars, videos and television programming.

16. Munro's professional honors include the Guggenheim Museum's 2010 invitation in celebration of its 50th anniversary to display in the inspirational rotunda of the Frank Lloyd Wright–designed Guggenheim building in Manhattan, a 2011 Artist of the Year Award from *Wiltshire Life Magazine*, and the 2013 American Alliance of Museums Excellence in Exhibition Award. Mr. Munro and Munro's exhibitions are also frequent subjects of articles, media interviews, stories, and reports, including a broadcast PBS documentary.

17. Mr. Munro's life has been spent learning, practicing, and refining his craft, which is his livelihood. As a result, he has developed and is known for a unique and signature style that is valued and widely appreciated and desired by the public, by exhibitors and curators, and by other consumers of his services.

18. Preeminent galleries, facilities, and public spaces around the world contract for Munro's in-demand exhibitions, installations, and associated services and products. Places like Houston's Discovery Green Park, the United Kingdom's Salisbury Cathedral, the Atlanta Botanical Gardens, and Pennsylvania's Longwood Gardens—one of the most famous display gardens in all of North America—have all held highly successful exhibitions of Munro's unique, large-scale light-based installations drawing millions of aggregate attendees. Munro's exhibitions, particularly the exhibitions of his famous signature *Field of Light*® and *Forest of Light*™ iterative series of installations, routinely generate substantial media, public, and online interest and underwriter sponsor support, driven in part by attendant authorized events and multimedia and social media promotions.

19. Private collectors and investors also retain and commission Munro to produce specially-commissioned, high-value works of art. These commission opportunities and sales are spurred by Munro's exhibitions and installations and their attendant publicity and interest.

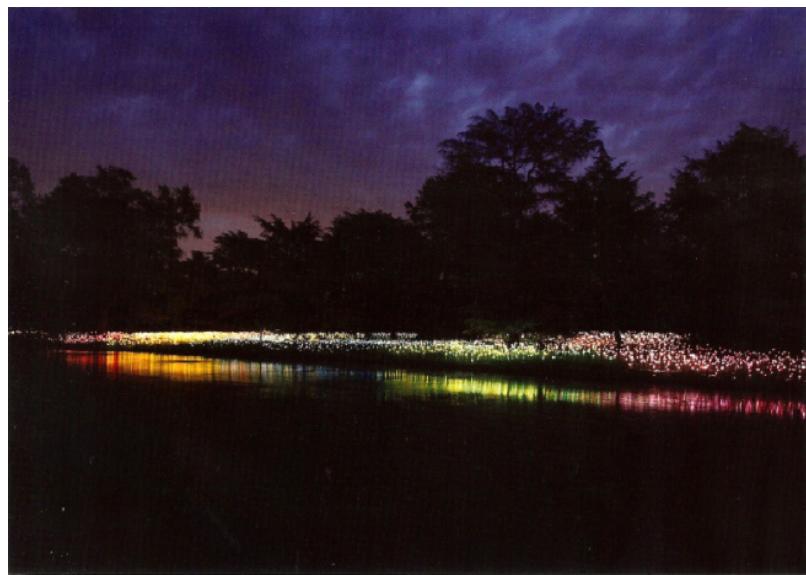
Munro's Trademark And Trade Dress Rights

20. Munro developed and owns the inherently distinctive trade dress for the famous iterative series of light-based installations and exhibitions known as *Forest of Light*™ and *Field of Light*®. The non-functional trade dress consists of a combination of

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features that combine to create the unique look and feel of Munro's *Forest of Light*™ and *Field of Light*® series of installations and exhibitions.

21. Figures 1 and 2 provide illustrative examples of the unique look and feel consistent throughout Munro's *Forest of Light*™ and *Field of Light*® series of installations and exhibitions.





Figs. 1 and 2. Munro's FIELD OF LIGHT® and FOREST OF LIGHT™ (Longwood Gardens, PA).

22. The trade dress for the *Forest of Light*™ and *Field of Light*® series of installations includes, but is not limited to, the following elements (hereafter "Trade Dress"): (1) an outdoor exhibit; (2) of large scale; (3) a light-based design; (4) thousands of short, end-lighted stems or "stalks"; (5) in an array; (6) arranged upon a predominantly green space; (7) positioned off-kilter or splayed from the perpendicular; and (8) topped with variably lit bulbs.

23. Munro began using the Trade Dress in 2004.

24. The Trade Dress is inherently distinctive and consumers and others rely upon it to differentiate the source of services. The nature of the Trade Dress – with its grand scale motif of lights on splayed stalks – supports Munro's marketing and business strategy

because, even from a picture, an illustration, or from far away, a *Field of Light*® or *Forest of Light*™ installation or exhibition can be recognized by its distinctive Trade Dress.

25. Munro also owns and uses the registered and common law marks *Field of Light*® and *Forest of Light*™ (collectively, the “Munro Marks”) in connection with Munro’s famous iterative series of light-based installations and exhibitions that incorporate the Trade Dress and associated goods and services.

26. Munro owns UK Registration No. UK00002559786 (registered Dec. 31, 2010) for the *Field of Light*® word mark for use with sculptures and sculptures made primarily of glass in International Class 21. Munro began using the *Field of Light*® mark no later [sic] 2004. Since then, Munro has used the *Field of Light*® mark in connection with Munro’s series of light-based installations and exhibitions.

27. In addition to registered trademarks, Munro has common law trademark rights in the word mark and term *Forest of Light*™.

28. Munro began using the *Forest of Light*™ mark no later than June 2012. Since then, Munro has used the *Forest of Light*™ mark in connection with Munro’s series of light-based installations and exhibitions.

29. Munro owns all rights associated with the highly acclaimed *Field of Light*® and *Forest of Light*™ series of installations.

**Development, Promotion, and Reception
of Munro's Acclaimed *Field of Light*®
and *Forest of Light*™ Installations**

30. Having tinkered with plans and designs for a number of years, Munro produced the first in the series of iterative light-based installations and exhibitions using the *Field of Light*® mark and incorporating the Trade Dress in 2004.

31. It quickly gained notoriety, leading to ever increasing demand for installations and exhibitions of additional site-specific, iterative versions of Munro's *Field of Light*® and, more recently, *Forest of Light*™ installations at notable galleries, museums, and public spaces around the world, including in the United States.

32. As a result, Munro is now best known for *Field of Light*® and *Forest of Light*™ and their "recurring motif of lights on stalks," as described in a 2012 *Washington Post* review. These installations are also the primary revenue driver for Munro's business and, as a result, hold inestimable value to Munro's business and livelihood.

33. In the past decade, Munro has presented and exhibited various versions of *Field of Light*® and *Forest of Light*™ at preeminent facilities, venues, and public spaces worldwide. The installations and exhibitions were seen and visited by millions of people; lauded in myriad media and online reports in widely circulated publications; consistently drove media and public interest, attendance, revenues, and publicity; and for

exhibitors regularly resulted in hundreds of thousands of attendees, millions in underwriting, ticketing, gift shop, and food court revenues and valuable PR media impressions and online and social media engagement.

34. Munro has expended substantial time, effort, labor, money, and resources promoting, producing and exhibiting the *Field of Light*® and *Forest of Light*™ installations and developing their associated business, production and promotional models, which include pre-exhibition collaboration with exhibitors to generate positive regional, national, and international publicity and coverage for and interest in Munro's exhibitions of *Field of Light*® and *Forest of Light*™. Those efforts include traditional PR and online and social media campaigns built around the *Field of Light*® and *Forest of Light*™ Trade Dress and Marks.

35. As a result, exhibitors see significant attendance, sponsorship and revenue increases and more than double their typical number of unique website visitors during a *Field of Light*® or *Forest of Light*™ exhibition, as well as substantial increases in web traffic and traditional and social media mentions.

36. As an illustrative example, from mid summer to early fall of 2012, Munro exhibited versions of *Field of Light*® and *Forest of Light*™ at Pennsylvania's Longwood Gardens to regional and national publicity that included feature reports on Munro, the exhibit, and *Field of Light*® and *Forest of Light*™ in national publications such as the *Washington Post*. Munro's Longwood exhibition, which Tennessee's Cheekwood

Botanical Gardens & Museum of Art later described as “wildly popular” in announcements for its own subsequent Munro exhibition, drew over 300,000 attendees, many from more than three hours away. How popular was Munro’s Longwood exhibition of *Field of Light*® and *Forest of Light*™ installations? By comparison, the *Rolling Stones*’ 2014 concert tour, one of the top tours of 2014, drew 651,816 attendees. In just one exhibition at Longwood, Munro and Munro’s *Field of Light*® and *Forest of Light*™ installations drew roughly half that many attendees. As Longwood’s director Paul Redman noted to the *Washington Post*, “‘When that exhibit opened, [Munro] was a rock star. He was a rock star.’”

37. Due to their consistent Trade Dress and attendant public interest, Munro’s exhibition of *Field of Light*® and *Forest of Light*™ installations consistently provide tangible, bottom-line attendance, publicity, and financial benefits for Munro’s exhibiting customers, which has created strong desire, demand for and recognition of Munro’s *Field of Light*® and *Forest of Light*™ and their associated Trade Dress.

38. The Munro Marks, the Trade Dress and their goodwill are valuable intellectual property assets of Munro.

39. Munro adopted, used in commerce, and publicized the Munro Marks and the Trade Dress in the United States, the United Kingdom, and elsewhere in connection with the *Field of Light*® and *Forest of Light*™ exhibitions and associated Munro business endeavors.

40. Munro has continuously used the Munro Marks and Trade Dress in the United States, the United Kingdom, and elsewhere. Munro is entitled to protections for the Munro Marks and Trade Dress under 15 U.S.C. § 1126 and associated international conventions and treaties, including the Paris Convention [sic].

41. As a result of Munro's use of the Trade Dress and Munro Marks, and through Munro's efforts to promote the look and feel and marks associated with the *Field of Light*® and *Forest of Light*™ installations and exhibitions, the Trade Dress and Marks have achieved outstanding critical success and widespread public recognition, including with the public, the media, the arts community, and exhibitors, and have become highly valuable assets representing substantial good will.

42. Munro's *Field of Light*® and *Forest of Light*™ installations have a reputation as high-quality, well-attended, highly-appreciated, revenue-enhancing exhibitions. Gallery, venue, and public and civic event space owners and curators and their underwriters are eager to affiliate and associate with Munro for exhibitions and opportunities involving *Field of Light*® and *Forest of Light*™ installations and associated sanctioned events, activities, and promotions under or connected with the Munro Marks and Trade Dress.

43. As a result of the immense goodwill and interest engendered by *Field of Light*® and *Forest of Light*™ exhibitions and the associated Munro Marks and Trade Dress, Munro's endeavors have grown to

include an online presence, books, publications, apparel, videos, and documentaries based on Munro's *Field of Light*® and *Forest of Light*™ exhibitions and the associated Munro Marks and Trade Dress.

44. The goodwill Munro developed in the Munro Marks and Trade Dress are assets of inestimable value to Munro. It is critically important to Munro's livelihood, to Munro's reputation, and to Munro's marketing and promotion of his products and services, including exhibitions of *Field of Light*® and *Forest of Light*™ installations, sponsored underwriting, and sales of specially commissioned works.

45. Munro has invested substantially in promoting the *Field of Light*® and *Forest of Light*™ installations and exhibitions. Munro spent years of time, labor, money, and effort establishing the Munro Marks and Trade Dress in the minds of consumers—including gallery, venue, and public event space curators, underwriters, collectors, art enthusiasts, and the public—as representative of high-quality, distinctive, quality exhibitions and installations. As a result, consumers associate the Munro Marks and the Munro Trade Dress with not only Munro's *Field of Light*® and *Forest of Light*™ installations and exhibitions but also with Munro as an acclaimed artist and provider and producer of successful, high-quality, critically-acclaimed exhibitions and related officially-sanctioned services and merchandise.

46. Munro's *Field of Light*® and *Forest of Light*™ installations and exhibitions have received substantial

media attention in publications with widespread circulation, including the *Washington Post*, *Wall Street Journal* and *Houston Chronicle*. Munro has also promoted the *Field of Light*® and *Forest of Light*™ installations and exhibitions on social media and via other web and online outlets. As a result of the extensive publicity, advertising, promotion, and acclaim of and for Munro, Munro's *Field of Light*® and *Forest of Light*™ series of iterative installations, and Munro's associated exhibitions and endeavors under the Munro Marks and Trade Dress, the Munro Marks and the Trade Dress are famous within the meaning of the Lanham Act and state law and have acquired secondary meaning so that they have come to identify Munro as the source of any *Field of Light*® and *Forest of Light*™ installations and associated goods, services, exhibitions, events, and activities and so that any product, service, installation, event, exhibition, promotion, or advertising bearing, incorporating, or marketed under the Marks or Trade Dress or any confusingly-similar imitation thereof is associated by consumers, the public, and the trade as being affiliated with Munro.

47. As a result, the Trade Dress and the Munro Marks associated with the *Field of Light*® and *Forest of Light*™ iterative series of installations are distinctive by virtue of having acquired secondary meaning.

48. The Munro Marks and the Trade Dress are also inherently distinctive and are associated in the minds of consumers, the public and the trade with Munro, Munro's *Field of Light*® and *Forest of Light*™

iterative series of installations and exhibitions, and associated goods and services. The Munro Trade Dress is arbitrary and fanciful and is entitled to the highest protection afforded by law.

The Defendants

49. Outdoor is a subsidiary of VF Corporation (“VF”), the \$12 billion Fortune 500 retail conglomerate and apparel and footwear manufacturer behind the *lucy*®, Wrangler®, Vans®, Lee®, Nautica®, Timberland®, North Face®, and other national apparel brands and retail stores.

50. Outdoor is responsible for day-to-day business operations and sales activities associated with the *lucy*® apparel brand and its national chain of *lucy*® retail stores and online outlets, which Outdoor operates as a business unit within the VF conglomerate. Outdoor promotes and sells *lucy*® apparel throughout the United States and in Minnesota, including through its local retail stores and over its online outlets, websites, and social media platforms. Outdoor is directly, vicariously, and jointly responsible and liable for all *lucy*® brand-related activities described herein.

51. Outdoor retained and hired Mono as its advertising agency in 2012. Outdoor authorized and contracted for Mono to develop a national campaign to promote and publicize the *lucy*® apparel brand, retail stores, and online outlets.

52. Mono served as Outdoor's authorized agent and representative and acted with actual and apparent authority. Outdoor ratified, adopted, and benefited from Mono's acts and statements described herein, which were within the scope of and in furtherance of its agency and authority. All statements, acts, and knowledge of Mono are therefore attributable to Outdoor and Outdoor is vicariously and directly responsible and liable for Mono's acts, statements, conduct, decisions, and omissions described herein.

53. Mono pitched and sold Outdoor on the concept of an advertising and promotional campaign for *lucy*® oriented around a branded deployment of Munro's popular and highly successful *Forest of Light*™ and *Field of Light*® installations.

54. In October 2012, Mono solicited Munro to develop and produce for it and Outdoor a version of Munro's famous *Forest of Light*™ and *Field of Light*® installations to be the focus of a public promotional event and a national advertising, branding and marketing campaign for the *lucy*® brand and the *lucy*® retail stores and online outlets.

55. In a series of calls and emails from October 18th through 22nd, Mono producer and employee Melissa Rothman indicated to Munro personnel her awareness of previous Munro exhibitions, stated Mono's (and Outdoor's) desire to secure and stage a public exhibition of Munro's famous *Forest of Light*™ and *Field of Light*® installations to promote the *lucy*® athleticwear brand and serve as the focal point for a

lucy® advertising and brand awareness campaign, and inquired about what it might take to put on such an exhibition and the publicity, attendance, and results that might be expected.

56. During the discussions, Ms. Rothman requested additional information and materials about Munro's *Field of Light*® and *Forest of Light*™ installations and exhibitions, related attendance figures, achieved online/multi-media traffic, and promotional methods used for the exhibitions. Ms. Rothman agreed and s [sic] promised both verbally and in confirmatory emails to keep any provided materials and information confidential.

57. Relying on these representations, Munro provided Ms. Rothman and Mono with a private impact report from Munro's Longwood Gardens exhibition, which displayed multiple examples and illustrations of the Munro Marks and Trade Dress associated with Munro's famous *Forest of Light*™ and *Field of Light*® installations, highlighted effective marketing and promotional techniques and business methods used to effectively promote Munro's exhibitions and drive attendance and online engagement, and discussed the attendance, sales figures and public feedback for the Longwood Gardens exhibition. Munro also discussed with Ms. Rothman that report, underwriting, sponsorship opportunities, and upcoming exhibition opportunities that might be available for *lucy*® to underwrite, and disclosed that Munro had been approached about an opportunity in Boston for Munro's *Forest of Light*™ and *Field of Light*® installations.

58. At the time, officials in Boston's Mayor's Office of Arts, Tourism & Special Events had contacted Munro. They had seen and experienced Munro's Longwood Gardens exhibition and expressed intense interest in bringing a public exhibition of Munro's installations to Boston in 2013. During discussions between Munro's representative and Mono's Ms. Rothman, this opportunity was mentioned as an upcoming chance for *lucy*® to underwrite a major metropolitan public exhibition of a *Field of Light*® or *Forest of Light*™ installation.

59. Shortly thereafter, however, Mono and Ms. Rothman ceased communications with Munro's representatives about the *lucy*® proposal. Subsequent to October 22nd, Munro and [sic] did not hear from Ms. Rothman or Mono again.

60. Not long after, communications with Boston public officials on the opportunity for a Munro Boston exhibition tapered off, too.

Defendants' Wrongful Conduct

61. Mono and Outdoor did not adhere to their confidentiality promises to Munro.

62. Unbeknownst to Munro, Mono and Outdoor had not shelved the *lucy*® project or their desire to model a *lucy*® advertising campaign and installation on the well-known Trade Dress and Marks associated with Munro's successful *Forest of Light*™ and *Field of Light*® series of installations.

63. Instead, without informing Munro or securing Munro's participation or approval, and relying on Munro's confidentially-provided materials and information, Mono and Outdoor nevertheless staged, launched and promoted in support of Outdoor's *lucy*® brand an unauthorized Boston-area exhibition and associated national advertising campaign incorporating and based on Munro's Trade Dress and *Forest of Light*™ mark (or colorable imitations thereof).

64. Figures 3 – 5 show illustrative examples of Defendants' advertising and marketing photos of Defendants' knock-off installation and exhibition, which Defendants extensively promoted for *lucy*® under the *Light Forest* moniker, a confusingly similar and facially blatant transposition of Munro's well-known *Forest of Light*™ mark.





Figs. 3 – 5. *lucy® Light Forest* and branded headstone plaque (Charles River Esplanade, Boston, MA).

65. Defendants' multi-million dollar light-based *Light Forest* installation and exhibition, the length of a football field and made up of an array of thousands of stem-mounted lights, shared at least the following non-functional design elements with Munro's *Forest of Light™* and *Field of Light®* series of installations: (1) an outdoor exhibit; (2) of large scale; (3) a light-based design; (4) thousands of short, end-lighted stems or "stalks"; (5) in an array; (6) arranged upon a predominantly green space; (7) positioned off-kilter or splayed from the perpendicular; and (8) topped with variably lit bulbs. *Compare, e.g., Figs. 3 – 5 with Figs. 1 – 2.*

66. Defendants' knock-off *Light Forest* installation and exhibition substantively incorporated and wholly appropriated Munro's Trade Dress and the unique look and feel that is the hallmark of and

consistent throughout Munro's *Forest of Light*™ and *Field of Light*® series of iterative installations.

67. Defendants' *Light Forest* installation and exhibition was publicly staged in Boston during the month of October 2013. Mono has publicly boasted that the installation and exhibition drew over 100,000 in-person attendees and visitors.

68. Mono and Outdoor extensively promoted and publicized the knock-off *Light Forest* installation and exhibition and the *lucy*® apparel brand, retail stores, and online outlets with an affiliated advertising, publicity, social media, multimedia and online campaign. The campaign included, among other things, national TV and web spots, print media, press releases, in-store mock-up displays, and extensive experiential, online, interactive and social media promotions and engagements.

69. The campaign – which is still ongoing – repeatedly utilizes the confusingly similar *Light Forest* moniker transposed from Munro's well-known *Forest of Light*™ mark and was (and still is) based primarily on images incorporating the appropriated Munro Trade Dress and the unique look and feel that is the hallmark of and consistent throughout Munro's *Forest of Light*™ and *Field of Light*® series of iterative installations.

70. Mono has publicly boasted that the knock-off campaign fueled over 307,000,000 related PR media impressions and successfully drove web-traffic, interest, engagement, and sales for Outdoor's *lucy*® apparel

brand and *lucy*® retail and online stores. In industry presentations, Mono founder and senior executive Jim Scott bragged that the *Light Forest* exhibition and Multimedia Campaign “ha[d] brought incredible results.”

71. The campaign appeared nationwide and remains readily available online.

72. Outdoor continues to run the campaign and display campaign images on its social media sites and on its o [sic] www.lucylightforest.com and www.lucylightforest.com/about websites, which announce that, “We are looking for the next location for our Lucy Light Forest.”

73. To promote Outdoor’s *lucy*® brand business and Mono’s own business, Mono also continues to run the campaign and display campaign images (including Figs. 3 and 5) and videos (Fig. 6, below) on Mono’s <https://mono-1.com/work/lucy-activewear-light-forest> website.



Fig. 6. *Light Forest* campaign image and video from Mono's website.

74. Mono worked on all aspects of the knock-off *Light Forest* installation, exhibition and campaign. With the exception of the on-site Boston installation, most of Mono's work was performed in Minnesota.

75. Outdoor worked with Mono and approved all aspects of the knock-off *Light Forest* installation, exhibition and campaign.

76. Munro has repeatedly asked Defendants to discontinue their wrongful conduct, pull the campaign and all associated images, and forgo any future exhibitions, but to date they have refused.

Likelihood of Confusion

77. Given the striking similarities between the names and the trade dress of Munro's *Forest of Light*™ and *Field of Light*® series of iterative installations and

Defendants' *Light Forest* installation, exhibition and promotional campaign materials, there is a likelihood that consumers will attend (or venues will provide exhibition opportunities) for Defendants' *Light Forest* installations and exhibitions, visit Outdoor's *lucy*® stores and online outlets, purchase Outdoor's *lucy*® brand apparel, and secure Mono's services under the mistaken belief that they come from, are sponsored or licensed by, or are associated or affiliated with Munro, the purveyor of Munro's popular *Forest of Light*™ and *Field of Light*® installations and exhibitions.

78. The likelihood of confusion is f [sic] exacerbated by the fact Defendants subsidize and allow free access to their *Light Forest* exhibitions, and consumers are therefore unlikely to exercise a great deal of care.

79. Confusion is also likely because Defendants are using the same marketing channels employed to market Munro's *Forest of Light*™ and *Field of Light*® installations and exhibitions and market in the same geographic areas.

80. As a result of Defendants' described activities, Munro's efforts and Munro's famous Trade Dress and Marks were appropriated, imitated, diluted, blurred, and tarnished by Defendants and Munro was deprived and usurped of significant opportunities, including for lucrative exhibition and promotion of his installations (including in Boston).

81. Defendants unjustly benefited and continue to benefit from their unauthorized exploitation and appropriation of Munro's marks, trade dress, efforts, and

business methods, which enabled them to more rapidly and at significantly less cost and commercial risk design, develop, prototype, pitch, secure prime civic exhibition space for, plan, launch, and publicize their *Light Forest* exhibition and associated campaign without the attendant creative skills, efforts, and trial and error of starting that endeavor from scratch or the accompanying uncertainty over how a dissimilar offering might be received by potential exhibitors or the public.

COUNT I
Trademark & Trade Dress Infringement in
Violation of Section 43 of the Lanham Act
(15 U.S.C. § 1125(a))

82. Munro re-alleges the above paragraphs.

83. Defendants' described conduct constitutes unauthorized use in commerce, in connection with goods or services, of words, terms, names, symbols, or devices, or combinations thereof, or false designation of origin, false or misleading representation of fact which is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of Defendants with Munro, or as to the origin, sponsorship, or approval of Defendants' exhibitions, installations, products and services by Munro in violation of 15 U.S.C. § 1125(a).

84. Defendants have used the term "Light Forest" and the overall look and feel of the Munro Trade Dress on advertising, promotional, and publicity materials and efforts connected with their business in

manners identical or confusingly similar to Munro's use of the Munro Marks and Munro Trade Dress. The "Light Forest" moniker and trade dress used for the *Light Forest* exhibition and campaign are identical to or are confusingly similar, colorable variations of the Munro Marks and Trade Dress.

85. On information and belief, the Defendants' offerings under their imitations of the Munro Marks and Munro Trade Dress are of dissimilar quality from offerings available from Munro and Munro's legitimate authorized exhibitors, licensees, and sponsors.

86. Without authorization, the Defendants (and Mono) have used in interstate commerce a reproduction, counterfeit, copy or confusingly similar or colorable imitation of the Munro Marks and Munro Trade Dress in connection with the sale, offer for sale, distribution, advertising and promotion of goods, merchandise, services and events, with such uses being likely to cause confusion or to cause mistake or to deceive. Defendants' prominent and extensive use and display of confusingly similar, colorable imitations of Munro's famous *Forest of Light*™ Mark and Trade Dress in advertising and on promotional materials for the Defendants' offerings has caused and is likely to cause confusion and mistake among the purchasing and consuming public, or will deceive the purchasing and consuming public as to the origin, sponsorship, or approval of the goods, merchandise, services, events, and activities of the Defendants and/or otherwise cause confusion or mistake among the purchasing and

consuming public or deceive the purchasing and consuming public.

87. On information and belief, the Defendants' and Mono's unauthorized use of the Munro Trade Dress, the *Forest of Light*™ mark, and confusingly similar imitations thereof is likely to and did: (a) cause confusion, mistake and deception; (b) cause the public to erroneously believe that Defendants' offerings are the same as Munro's offerings or that Defendants or their offerings are authorized, sponsored, or approved by Munro or are affiliated, connected or associated with or in some way related to Munro; and (c) result in the Defendants unfairly benefiting and profiting from the reputation of Munro, the Munro Marks, and the Munro Trade Dress all to the substantial and irreparable injury of the public, Munro, the Munro Trade Dress, the *Forest of Light*™ mark, and the substantial goodwill represented by such trade dress and mark.

88. This confusion causes irreparable harm to Munro and weakens the distinctive qualities of the Munro Trade Dress and the *Forest of Light*™ mark.

89. Defendants' actions were not authorized by Munro.

90. Defendants acted deliberately and willfully in attempt to trade upon the goodwill associated with the *Forest of Light*™ and *Field of Light*® Trade Dress and the *Forest of Light*™ mark.

91. Defendants' conduct is causing, and will continue to cause, irreparable harm to Munro unless it is enjoined by this Court.

92. Defendants have unjustly benefited and Munro has suffered damages as a result of Defendants' actions in an amount to be proven at trial.

COUNT II
Trademark & Trade Dress Dilution in
Violation of Section 43 of the Lanham Act
(15 U.S.C. § 1125(c))

93. Munro re-alleges the above paragraphs.

94. To Munro's detriment, Defendants' unauthorized use of Munro's famous Trade Dress and *Forest of Light™* Mark and colorable imitations thereof has resulted in the dilution of the exclusive rights that Munro is entitled to enjoy in connection with Munro's Marks and Trade Dress and their use in connection with the promotion of Munro's and authorized exhibitors' or licensees' installations, exhibitions, event, goods, services and other offerings.

95. Defendants' conduct has caused and is continuing to cause dilution by blurring as it impairs the distinctiveness of Munro's famous Trade Dress and *Forest of Light™* Mark, which Defendants willfully intended to trade upon.

96. Defendants' conduct has also caused and is continuing to cause dilution by tarnishment as it creates an association that harms the reputation of

Munro's famous Trade Dress and *Forest of Light*™ Mark, which Defendants willfully intended to harm the reputation of.

97. Defendants' conduct is causing, and will continue to cause, irreparable harm to Munro unless it is enjoined by this Court.

98. Defendants have unjustly benefited and Munro has suffered damages as a result of Defendants' actions in an amount to be proven at trial.

COUNT III Misappropriation

99. Munro re-alleges the above paragraphs.

100. By modeling their *Light Forest* installation and campaign on Munro's successful *Field of Light*® and *Forest of Light*™ installations, Munro's Trade Dress and *Forest of Light*™ Marks, and Munro's production, promotion and business methods, Defendants avoided significant costs, delays, creative insights, trial and error, labor, planning, and resources ordinarily needed to conceive of, design, refine, and successfully implement an endeavor of the scope and scale of Munro's *Field of Light*® and *Forest of Light*™ installations.

101. To circumvent similar costs, impediments, delays, and potential risks and uncertainties associated with attempts to conceive and develop a publicly-desired exhibition from scratch, Defendants appropriated in whole or in part significant aspects

and features of Munro's *Field of Light*® and *Forest of Light*™ series of installations and related exhibition processes, promotional models and methods for their competitive, knock-off *Light Forest* exhibition and associated campaign.

102. Defendants have inequitably and unjustly obtained a free ride on and benefited from Munro's prior work and efforts.

103. Defendants directly compete with Munro for limited opportunities, spaces, and venues for the public exhibition of large-scale, light-based installations.

104. Defendants' and Mono's conduct and activities violate the misappropriation doctrine announced by the U.S. Supreme Court in *Int'l News Service v. Associated Press*, 248 U.S. 215 (1918).

105. Munro suffered injury and harm as a direct and proximate result of these misappropriations.

106. Munro seeks to recover all damages and other relief to which Munro is entitled for Defendants' misappropriation in an amount to be proven at trial.

COUNT IV **Fraud**

107. Munro re-alleges the above paragraphs.

108. Mono made false and fraudulent statements and promises to Munro. Specifically, Mono represented to Munro between October 18 – 22, 2012 via

its employee Melisa [sic] Rothman that it would maintain the confidentiality of materials and information Munro provided and disclosed to it concerning Munro's *Field of Light*[®] and *Forest of Light*[™] installations and exhibition.

109. Mono intended and expected Munro to rely on those representations, which it did.

110. The statements and promises were false when made or were made with reckless disregard of their falsity. On information and belief, Mono did not intend to maintain the confidentiality of the materials and information that Munro provided.

111. Contrary to these promises, Mono did not maintain the confidentiality of materials and information that Munro provided and instead shared and used the materials and the information contained therein to facilitate the creation, design, production, and promotion of the competitive *Light Forest* exhibition and associated campaign.

112. The fraud was inherently undiscoverable.

113. Munro suffered injury and harm as a direct and proximate result of this fraud.

114. Mono and Outdoors have unjustly benefited and Munro has suffered damages as a result of Defendants' actions in an amount to be proven at trial.

COUNT V
Tortious Interference with and
Usurpation of Prospective Business
Opportunities and Relationships

115. Munro re-alleges the above paragraphs.

116. Mono and Outdoors not coincidentally selected Boston—the city courting Munro—for their *Light Forest* installation and exhibition. They and their agents also contacted local and regional public officials, secured a prominent Boston public space for their competitive, exhibition, and planned out associated logistics.

117. Until then, Munro had reasonable probabilities of prospective business opportunities to stage a large-scale, public exhibition of Munro's *Field of Light*® and/or *Forest of Light*™ installations in the Boson [sic] vicinity and reasonable probabilities of prospective business relationships with the City of Boston, the Boston Mayor's office, other local public officials, and affiliated entities and arts organizations.

118. Mono was aware of Munro's prospective Boston relationships and opportunities, which Mono was informed of during discussions with Munro.

119. As result of Defendants' actions, Boston officials on information and belief ceased discussions with Munro for a Boston-area exhibition. Consequently, Munro lost a premier exhibition opportunity as well as the commensurate publicity, engagement, specialty commissions, private sales, revenues, and

momentum for follow-on exhibitions that a Boston exhibition would bring.

120. On information and belief, Defendants wrongfully, intentionally, willfully, and without justification interfered with and usurped Munro's prospective business opportunities and relationships. It was reasonably foreseeable that Defendants' activities would induce and cause co-parties to discontinue discussions with Munro regarding a prospective exhibition.

121. On information and belief, Defendants usurped Munro's Boston exhibition opportunity to launch their competitive, knock-off *Light Forest* exhibition in Munro's place.

122. The interferences and usurpations directly and proximately caused Munro injuries and damages and unjustly and inequitably benefited Defendants.

123. On information and belief, as a direct, proximate, and reasonably foreseeable result, Munro lost the prospective opportunity for a large-scale exhibition of his works in a major metropolitan area and the valuable commensurate publicity, engagement, specialty commissions, private sales, revenues, and momentum for follow-on exhibitions regularly generated from public exhibitions of Munro's large-scale, immersive, light-based installations.

124. Munro suffered actual damage or loss as a result of these wrongful interferences.

125. Mono and Outdoors have unjustly benefited and Munro has suffered damages as a result of Defendants' actions in an amount to be proven at trial.

COUNT VI
False Designation of Origin and Unfair
Competition under 15 U.S.C. § 1125(a)

126. Munro re-alleges the above paragraphs.

127. Defendants' use of the term "Light Forest" and combination of distinctive features and elements of the Munro Trade Dress into their *Light Forest* exhibition and associated campaign and related promotional materials constitutes a false designation of origin which is likely to deceive and, upon information and belief, has deceived the public, customers, and prospective customers into believing that the Defendants' offerings are associated with, authorized by, or those of Munro, and as a consequence, are likely to divert and have diverted customers (including but not limited to curators, exhibitors, and attendees) away from Munro.

128. On information and belief, the Defendants continue to attempt to capitalize on the good name, reputation, and goodwill of Munro.

129. Defendants' described acts constitute use of a word, term, name, symbol, and a false designation of origin which is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of the Defendants' offerings with Munro, or as to the origin, sponsorship, or approval of the

Defendants' goods, services, and commercial activities by Munro, in violation of the Lanham Act, 15 U.S.C. § 1125(a)(1)(A).

130. The Defendants' acts misrepresent the nature, characteristics, qualities, or origin of the Defendants' goods, services, or commercial activities in violation of the Lanham Act, 15 U.S.C. § 1125(a)(1)(B).

131. The Defendants' conduct has caused and if not enjoined will continue to cause irreparable damage to Munro, the Munro Trade Dress, the Munro Marks (including the *Forest of Light*™ mark), and Munro's trademark and trade dress rights, good name, reputation and goodwill in a manner that cannot be fully compensated by monetary damages.

132. Munro is entitled to recover Defendants' gross profits, treble Munro's damages and detriment, and the cost of the action under 15 U.S.C. § 1117(a) and to have all offending articles and their means of manufacture turned over and destroyed under 15 U.S.C. § 1118.

133. Because this is an exceptional case, Munro is entitled to an award of reasonable attorneys fees.

134. The Defendants' false designation of origin and unfair competition will continue unless enjoined by this Court.

135. Munro has no adequate remedy at law.

COUNT VII
Unfair Competition in Violation of Paris
Convention, the Lanham Act, and Common Law

136. Munro re-alleges the above paragraphs.

137. Defendants' conduct described in the foregoing paragraphs constitutes unfair competition, including under the Lanham Act (15 U.S.C. § 1125(a)) and the Paris Convention (as incorporated into U.S. law under 15 U.S.C. § 1126).

138. Defendants have used, infringed, and diluted the Munro Marks and Munro Trade Dress without authorization; misappropriated Munro's time, labor, skills, and efforts and the fruits thereof for self-serving competitive purposes and advantages; interfered with and usurped Munro's business opportunities and relationships; and acted dishonestly, unethically, and fraudulently towards Munro.

139. Defendants [sic] actions maliciously interfered with Munro's ability to properly and fully conduct Munro's affairs and business endeavors in an unimpeded fashion.

140. Defendants are guilty of unfair competition and other unfair trade practices in violation of the Paris Convention, the Lanham Act and common law.

141. Munro has been damaged as a direct and proximate result of Defendants' actions in an amount to be proven at trial.

PRAYER

Accordingly, Munro asks to be awarded judgment against Defendants for the following:

- a. all damages, statutory damages, exemplary damages, enhanced damages, and other legally permissible damages or recoveries allowed by law, statute, or equity;
- b. an accounting and recovery of Defendants' gross profits on *lucy*® apparel sales and all amounts by which Defendants have been unjustly enriched or benefited;
- c. specific performance, declaratory relief, and temporary, preliminary and permanent injunctive relief as alleged and as otherwise allowed;
- d. seizure and destruction of any offending articles, advertising, and the equipment used to make them;
- e. imposition of a constructive trust and other equitable remedies;
- f. pre-judgment and post-judgment interest at the maximum legal rate;
- g. costs and attorneys' fees; and,
- h. all other relief to which Munro may be entitled or as the court may deem just, equitable, necessary, proper or appropriate under the circumstances.

JURY DEMAND

Munro demands a jury trial for all issues so triable in this action.

Dated: March 10, 2016

Respectfully submitted,

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CERTIFICATE OF SERVICE

I certify that the foregoing was served on all counsel of record via the Court's ECF system on March 10, 2016.

By: */s/ Steven L. Theesfeld*
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