

No. 21-_____

IN THE
SUPREME COURT OF THE UNITED STATES

JANICE DICKINSON,
Petitioner,

v.

RYAN SEACREST PRODUCTIONS, INC., ET AL.,
Respondents.

On Petition for a Writ of Certiorari to the United
States Court of Appeals for the Ninth Circuit

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

Defamatory speech – or in the case of public figures, defamatory speech made with actual malice – has long been established as speech that is outside the protections of the First Amendment, under *New York Times Co. v. Sullivan*, 376 U.S. 254 (1964) and its progeny.

The question presented here is:

Whether a defendant who willfully creates a false narrative about a public figure that is marketed to the public as a true story, for the intentional purpose of misappropriating the public figure's famous mark and goodwill to market and promote a reality television program, is entitled to the benefits of the First Amendment-based defense of *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989) and other First Amendment-based defenses to the public figure plaintiff's Lanham Act claims, where the defendant's speech about the plaintiff was defamatory speech made with actual malice?

PARTIES TO THE PROCEEDING

Janice Dickinson is Petitioner here and was Plaintiff-Appellant below.

Ryan Seacrest Productions, LLC; Truly Original, LLC; Suns Productions, LLC; NBCUniversal Media, LLC; Tess Cannon; and Erik Rosette aka Erik Rosete aka Mister Triple X are Respondents here and were Defendants-Appellees below.

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PETITION FOR A WRIT OF CERTIORARI

Petitioner Janice Dickinson petitions for a writ of certiorari to review the judgment of the U.S. Court of Appeals for the Ninth Circuit in No. 19-55415.

OPINIONS BELOW

The opinion of the Ninth Circuit (Pet. App. 1a) is unpublished. The relevant order of the district court (Pet. App. 2a) is unpublished.

JURISDICTION

The Ninth Circuit issued its opinion on December 21, 2020. Pet. App. 1a. This Court has jurisdiction under 28 U.S.C. § 1254(1).

RELEVANT CONSTITUTIONAL AND STATUTORY PROVISIONS

United States Constitution, amendment I provides: “Congress shall make no law . . . abridging the freedom of speech, or of the press . . .”

15 U.S.C. § 1125(a) provides, in relevant part: “(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."

15 U.S.C. § 1125(c) provides, in relevant part: "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."

INTRODUCTION

Should defendants who intentionally create a false narrative about a public figure and who then market it to the public as a true story, for the premeditated purpose of misappropriating the public figure's famous mark and goodwill to promote a reality television program, be entitled to claim the benefits of the First Amendment-based defense of *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989) and other First Amendment-based defenses to the public

figure plaintiff's Lanham Act claims, where the defendants' speech about the plaintiff was defamatory speech made with actual malice?

The answer should be "no." Defamatory speech – or at least false, defamatory speech made with actual malice, with respect to public figures – has long been established as speech that is outside the protections of the First Amendment, under *New York Times Co. v. Sullivan*, 376 U.S. 254 (1964) ("*New York Times v. Sullivan*") and its progeny. Accordingly, such defamatory speech made with actual malice should not and would not be constitutionally protected by the First Amendment against Lanham Act claims, and it is not when either the First Amendment law or Lanham Act law are examined independently.

However, the result is inexplicably different when the First Amendment and the Lanham are balanced against each other. When defamatory speech made with actual malice is made in the context of a work of artistic expression such that a court applies the balancing test first set forth in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989) ("*Rogers*", and the test, "*Rogers* test"), it somehow paradoxically becomes protected by the First Amendment, as the District Court and the Ninth Circuit Court of Appeals both found in the present action. This can only be true if the actual malice doctrine is completely ignored in the context of marketing and promotion of a work of artistic expression – an idea not taught by a single case at any level, as far as Petitioner is aware.

In 2017, Defendants, who include the producers of the reality television series *Shahs of Sunset* manipulated actual footage they took of Petitioner, legendary supermodel Janice Dickinson participating, at a charity fashion show. Defendants' surreptitious footage made it appear as if Dickinson sabotaged that the runway appearance of another model – one of the actors on *Shahs of Sunset* – by stealing the outfit intended for her. Defendants also caused the series' actors to make intentionally false statements that Dickinson had stolen the outfit and was in a heated dispute with a series lead actor about the incident to the disruption of the charity event. None of the foregoing narrative actually occurred; in fact, Dickinson had virtually no interaction with or even awareness of the series' actors. Defendants accomplished the false narrative by strategic editing and re-contextualizing – filming scripted scenes with other actors, and then interspersing real footage of Dickinson within those fictional scenes. In other words, the producers created a “cheap fake.”¹ Using these techniques, Defendants crafted a false, defamatory narrative of Dickinson purportedly stealing from another model at a charity event,

¹ As opposed to a “deep fake,” in which artificial intelligence (AI) technology is used to generate digitally created human faces, bodies, or voices. See Britt Paris and Joan Donovan, *DeepFakes and Cheap Fakes*, Data & Society (Sept. 18, 2019), https://datasociety.net/wp-content/uploads/2019/09/DS_Deepfakes_Cheap_FakesFinal-1-1.pdf (discussing history of manipulation of audio and visual evidence and difference between “deepfakes” and “cheap fakes”).

leading to a dispute with the other model and disruption of the event. Defendants then distributed this false narrative on cable television and other platforms, and also used the false narrative in advertising. Some or all of the Defendants intentionally marketed the narrative as a true story in the nature of news, and a substantial segment of the public in fact believed the narrative and shunned Dickinson as a result. Some of Defendants' specific advertising and promotions of the series consisted virtually entirely of defamatory speech about Dickinson made with actual malice.

In 2018, Dickinson brought suit, alleging that Defendants' conduct violated her rights in her celebrity, which is protected under the Lanham Act. Dickinson further alleged, and Defendants did not dispute, that they intentionally manipulated the footage of her to promote and sell the episode in a series that they represent as a "reality" show, meaning a true story. Instead, Defendants argued that their speech was part of an expressive work protected under *Rogers*, regardless of the falsity of their speech, and that *New York Times v. Sullivan* had no place at all in the *Rogers* test. The district court agreed with the Defendants, dismissing Dickinson's Lanham Act claims with prejudice. Dickinson appealed, including on the issue of whether Defendants needed to establish, as an initial matter, that their speech was protected speech under the First Amendment where it was undisputedly defamatory speech about Dickinson made with actual malice. In

affirming the district court ruling, the Ninth Circuit failed to address actual malice expressly, but necessarily implicitly held that actual malice plays no part in *Rogers* analysis. The Ninth Circuit wrote that “[d]espite Dickinson’s contrary arguments, the only requirement for application of *Rogers* is that ‘the [Appellees] . . . make a threshold legal showing that [their] allegedly infringing use [was] part of an expressive work protected by the First Amendment.’ *Dickinson v. Ryan Seacrest Enters. Inc.*, 839 F.App’x 110 (9th Cir. 2020) (emphasis in original, citations omitted). The Ninth Circuit then held that, because the episode itself was an “expressive work,” “Appellees made the threshold legal showing.” *Id.*

The Ninth Circuit’s analysis is erroneous. That a work is “expressive” does not end the inquiry as to whether it is entitled to First Amendment protections, because it is legally possible for an expressive work to contain speech not protected by the First Amendment, such as when the speech is defamatory and made with actual malice. Indeed, many or even most of the seminal cases regarding defamation and the actual malice doctrine involved speech that was part of an expressive work. If the Ninth Circuit’s reasoning is correct, the *Rogers* test has effectively overwritten the actual malice doctrine in the Lanham Act context where an underlying work being marketed otherwise in violation of the Lanham Act is an “expressive work.” This does not appear to be true in any other context. To the contrary, it has long been recognized that speech falling into “well-defined and narrowly

limited” exceptions to the First Amendment is not entitled to constitutional protection, *see, e.g.*, *Chaplinsky v. New Hampshire*, 315 U.S. 568, 571 (1942), and defamatory speech made with actual malice is undoubtedly one of them.

Abandoning long-established and fundamental First Amendment jurisprudence in favor of the facile analysis of the *Rogers* test leads to absurd results. For instance, in her last operative complaint, Dickinson had also asserted a defamation claim under California law against Defendants. Her Lanham Act claims were dismissed on the basis that Defendants’ First Amendment rights overrode her trademark interests; however, it would be possible at the same time for Dickinson to continue pursuing her state law defamation claim and prevail under the undisputed facts as pled, establishing that Defendants have no First Amendment rights in that same speech.

The problematic application of *Rogers* test also extends beyond the circumstances of Dickinson’s case. Defamation law protects individuals from having their lives or livelihoods injured because of untrue statements made against them. The Lanham Act provides similar protections for companies and brands – and in the case of celebrities, their identities – as a property right. Moreover, the Lanham Act also strongly protects the public’s right not to be deceived by false advertising and confusing marketing – the consuming public has a right not to be told that something is a true story in the nature of news when in fact it isn’t, when it comes to how the public makes

its consumption decisions about media. In our modern media landscape where the line between news and entertainment has become increasingly blurred, where deepfake technology enables the manipulation of individuals' likenesses to the point where it can be impossible to tell real from altered; and where "fake news" threatens the integrity and reputation of not only individuals and businesses but also fundamental institutions of society, it is critical that any First Amendment balancing test not entirely throw out defamation jurisprudence, especially not in the Lanham Act context. Our entire society fundamentally relies on the public being able to discern accurately what media stories are being held out as depictions of true events and which are fictional narratives. If Defendants can create and market an intentionally false and defamatory narrative as a truthful news story to advance the marketing of fictional programming without any risk of any Lanham Act liability, then a fundamental purpose of the Lanham Act will be eroded and the ability of the public to rely on the information they receive in the media and the decisions that they make about that information will be threatened, with no corresponding social gain.

The Ninth Circuit's erroneous use of the *Rogers* test as a balancing test for First Amendment rights and Lanham Act rights therefore warrants review. The Ninth Circuit's decision creates a nearly insurmountable First Amendment defense for willful creators of fake news as a marketing tool for the

intentional misappropriation of the goodwill of a party with no meaningful connection with the media product in question, as occurred case. The decision thus demonstrates the limitations of the *Rogers* test and how its application can contravene longstanding First Amendment law. Moreover, given that the various approaches among the circuits regarding how to balance of First Amendment rights against trademark rights – with some circuits expressly rejecting the *Rogers* test – there is a need for this Court to reconcile the inconsistent circuit approaches by articulating the extent to which trademark rights should yield to free expression. This is especially true where that expression involves defamatory speech made with actual malice, and that was intentionally marketed by the defendants to the public as a true story.

The petition for certiorari should therefore be granted.

STATEMENT

I. The First Amendment and *New York Times Co. v. Sullivan*

The First Amendment provides: “Congress shall make no law ... abridging the freedom of speech, or of the press.” U.S. CONST. amend. I. “The First Amendment, however, does *not* encourage or protect *all creative expression in all situations.*” Michael Laundau, 1A LINDEY ON ENTERTAINMENT, PUBL. & THE ARTS § 4:1 (3d ed.) (April 2021 Update) (“LINDEY”) (emphasis added). “Defamatory material . . . may, within certain constitutional limitations, lead to liability for damages suffered by individuals.” *Id.* For public figures like Dickinson, the line between First Amendment-protected defamatory speech, and defamatory speech *not* protected by the First Amendment, is *actual malice*.

Over 50 years ago, this Court in *New York Times Co. v. Sullivan*, 376 U.S. 254 (1964) (“*New York Times v. Sullivan*”) fundamentally changed much of the common law on defamation, by applying constitutional principles to it. 1A LINDEY § 4:5. *New York Times v. Sullivan* held that the First Amendment extended to some types of false speech, at least where public figures are concerned. *New York Times v. Sullivan* specifically required a heightened standard before First Amendment protection dissolved for false speech about a public figure – but that at some point the First Protection still nonetheless *does* dissolve: “a federal rule that

prohibits a public official from recovering damages for a defamatory falsehood relating to his official conduct *unless* he proves that the statement was made with ‘actual malice.’” *New York Times v. Sullivan*, 376 U.S. at 279-80 (emphasis added).

New York Times v. Sullivan thus draws a line between 1) defamatory speech about a public figure that *is* nonetheless still protected by the First Amendment (even though it is defamatory speech and thus otherwise would not be protected), and 2) defamatory speech about a public figure that is not protected by the First Amendment.

II. The Lanham Act

In 1946, Congress enacted the Lanham Act, which “creates a comprehensive framework for regulating the use of trademarks and protecting them against infringement, dilution, and unfair competition.” *Fortune Dynamic, Inc. v. Victoria’s Secret Stores Brand Mgmt., Inc.*, 618 F.3d 1025, 1030 (9th Cir. 2010); J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 5:4 (5th ed.) (Mar. 2021 Update) (“MCCARTHY”). The Act’s two underlying purposes are to ensure that (1) “owners of trademarks can benefit from the goodwill associated with their marks” (*i.e.*, protecting the mark owner’s property interest from misappropriation) and (2) “consumers can distinguish among competing producers.” (*i.e.*, protecting consumers from confusion). *Fortune Dynamic*, 618 F.3d at 1030.

The Lanham Act's § 43(a), codified at 15 U.S.C. § 1125(a), is the federal source for two major and distinct types of "unfair competition" claims: (1) infringement of registered and also unregistered marks, names, and trade dress ("false endorsement"); and (2) "false advertising." 5 MCCARTHY § 27:12. These two "prongs" of § 43(a) developed separately and have achieved their own subset of substantive rules. *Lexmark Intern., Inc. v. Static Control Components, Inc.*, 134 S. Ct. 1377, 1384 (2014).

The trademark infringement or "false endorsement" prong at § 43(a)(1)(A) protects the public's interest in being free from consumer confusion about affiliations and endorsements. 15 U.S.C. § 1125(a)(1)(A). A false endorsement claim is available to a celebrity where defendants' conduct has allegedly created "a likelihood of confusion as to whether plaintiffs were endorsing [defendants'] product." *Wendt v. Host Int'l, Inc.*, 125 F.3d 806, 812 (9th Cir. 1997). In such cases, the mark at issue is "the celebrity's persona and the strength of the mark refers to the level of recognition the celebrity enjoys." *Id.* at 812 n. 1.

The false advertising prong at § 43(a)(1)(B) protects consumers from the effects of false advertising in "commercial" speech. It makes it actionable for one to use descriptions or representations of fact, which "in commercial advertising or promotion, misrepresents the nature, characteristics, qualities or geographic origin of his or

her ... goods, services, or commercial activities” 15 U.S.C. § 1125(a)(1)(B).

In general, the Ninth Circuit and other circuits apply a “likelihood-of-confusion test” to determine whether a plaintiff prevails on its Lanham Act claims. *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1196 (9th Cir. 2017) (“*Empire*”); *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 806-07 (9th Cir. 2003).

III. The *Rogers* Test

However, where the product being advertised and marketed is an expressive work, the Ninth Circuit, as well as other circuits, have adopted a two-part test first set forth in the Second Circuit case, *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), to balance the public’s First Amendment interest in free expression against the public’s interest in being free from consumer confusion about affiliation and endorsement from the use of the trademark.²

² The Ninth Circuit first adopted the *Rogers* test in *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894 (9th Cir. 2002) (“*MCA Recs.*”), in which it held that Lanham Act claims directed against advertising of “expressive works protected by the First Amendment” were limited to only those claims “where the public interest in avoiding consumer confusion *outweighs* the public interest in free expression.” (Citing *Rogers*, 875 F.2d at 999) (emphasis added).)

Under *Rogers*, after a defendant makes an initial threshold showing that its use of the mark is “part of an expressive work protected by the First Amendment,” the burden shifts to the plaintiff claiming trademark infringement to show “(1) that [plaintiff] has a valid, protectable trademark, and (2) that the mark is either not artistically relevant to the underlying work *or* explicitly misleading as to the source or content of the work.” *Gordon v. Drape Creative, Inc.*, 909 F.3d 247, 264-65 (9th Cir. 2018) (emphasis added).³ There does not appear to be any case in any jurisdiction at any level that discusses the role that constitutional actual malice plays or does not play in a *Rogers* analysis.

Notably, prior to the *Rogers* decision, to weigh whether the First Amendment provides a defense to claims brought under the Lanham Act, as an initial matter, courts in the Ninth Circuit and beyond had analyzed whether the speech at issue was made in bad faith or defamatory, as part of analyzing whether the

³ A plaintiff who makes this showing still must go on to prove that its trademark has been infringed (by showing that the defendant’s use of the mark is likely to cause confusion under the likelihood-of-confusion test). *Gordon*, 909 F.3d at 265; *see also MCA Recs.*, 296 F.3d at 900 (discussing the likelihood-of-confusion test used in the Ninth Circuit before adopting the *Rogers* test specifically for expressive works: “Our likelihood-of-confusion test, *see AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir.1979), generally strikes a comfortable balance between the trademark owner’s property rights and the public’s expressive interests.”).

speech was protected by the First Amendment. *See, e.g.*, *Eastwood v. Nat'l Enquirer, Inc.*, 123 F.3d 1249, 1252 (9th Cir. 1997) (affirming jury verdict and fee award in favor of actor Clint Eastwood on his Lanham Act claims, due to finding that defendant tabloid newspaper deliberately misrepresented that it had conducted an “exclusive” interview with Eastwood); *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir. 2001) (Ninth Circuit reversing verdict in favor of actor Dustin Hoffman, where Hoffman failed to prove that the magazine publisher of an altered photograph of Hoffman had done so with actual malice under *New York Times Co. v. Sullivan*); *see also* 5 MCCARTHY § 27:70 (actual malice is the relevant test for whether celebrity false endorsement claims are viable in connection with a media story or content). Only if the speech at issue was *not* defamatory speech made with actual malice would the courts then go on to analyze whether the First Amendment interests outweighed the property interests of the trademark owner.

Following the Second Circuit’s issuance of *Rogers*, and following the adoption of the *Rogers* test (or a modified version thereof) by the Fourth, Fifth, Sixth, Ninth, and Eleventh Circuits,⁴ however, courts

⁴ *See, e.g.*, *Radiance Found., Inc. v. N.A.A.C.P.*, 786 F.3d 316, 329 (4th Cir. 2015); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664-66 (5th Cir. 2000); *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 937 (6th Cir. 2003); *Univ. of Ala. Bd. of Trustees v. New Life Art, Inc.*, 683 F.3d 1266, 1279 (11th Cir. 2012).

within these circuits have seemingly, or even expressly, abandoned actual malice defamation jurisprudence, instead merely relying on whether a work is “creative expression” to satisfy all relevant First Amendment inquiries.

That is the legal backdrop in which this case arises.

IV. Factual Background

Dickinson is a legendary supermodel and reality television star with a famous mark. Eric Rosette aka Erik Rosete (“Rosete”) owns a fashion label. Ryan Seacrest Productions, LLC; Truly Original, LLC; Suns Productions, LLC; and Tess Cannon produce the “reality” television series *Shahs of Sunset* (“*Shahs*” or the “Series”), which is distributed by NBCUniversal, LLC (Ryan Seacrest Productions, LLC; Truly Original, LLC; Suns Productions, LLC; Tess Cannon; and NBCUniversal, LLC (“NBCUniversal”).

In late 2016, Rosete invited Dickinson to participate in a charity fashion show event, where she would be a runway model for Rosete’s latest clothing line under his label, “Mister Triple X.” Unbeknownst to Dickinson, Rosete and the other Defendants also schemed to capture video footage of Dickinson’s participation in the event for use in a *Shahs* episode. Specifically, the Defendants schemed to create a fictional narrative where, at the event, Dickinson engaged in a catfight or “feud” with one of the *Shahs*

actors. At the event, the Defendants did in fact capture footage of Dickinson, which they strategically filmed so as to make it appear as if she were interacting with the *Shahs* actors. They also filmed additional fictional scenes using *Shahs* actors to be featured alongside the footage they took of Dickinson, to further support their made-up narrative.

NBCUniversal aired the episode containing this manipulated footage of Dickinson and the associated *Shahs* actor interviews containing intentionally false statements about Dickinson (the “Episode”) on its cable channel, “Bravo,” in July 2017. The Episode falsely portrays Dickinson as having stolen the runway outfit of one of the *Shahs* actresses on the show and then having a dispute with the actress about it. It also generally falsely portrays Dickinson as an unprofessional, past-her-prime runway model who deliberately sabotaged another model’s runway walk for purposes of seeking attention.

None of it actually happened. Nonetheless, the Defendants marketed and advertised the Episode’s narrative about Dickinson as a “true story,” including through press releases, cable television advertisements, interstitial ads within the Episode, on Bravo’s website, and on third party video download platforms. A substantial segment of consumers believed that Dickinson actually engaged in the behavior that the Defendants depicted, and shunned Dickinson as a result, with some of them writing on social media that they “hated” her for the conduct. As

a result, Dickinson suffered harm to the goodwill in her mark.

Key to the plan's success was Defendants' ongoing false advertising to consumers about the nature of the Series. The Series is a scripted, largely or even entirely fictional program. However, Defendants intentionally falsely marketed the Series to consumers as an unscripted, documentary "true story" series, because they believe that sells better.

Defendants engaged in this conduct intentionally and in bad faith, for the express purpose of misappropriating Dickinson's goodwill for the benefit of *Shahs*.

After the Episode aired, Dickinson confronted Defendants, who then presented her with a release that she had allegedly signed, which Dickinson contends is forged.

V. Proceedings Below

On March 29, 2018, Dickinson filed suit against Defendants, alleging false endorsement in violation of 15 U.S.C. § 1125(a)(1)(A); false advertising in violation of 15 U.S.C. § 1125(a)(1)(B), trademark dilution in violation of 15 U.S.C. § 1125(c), and violation of California's unfair competition statute, *Cal. Bus. & Prof. Code* § 17200 (in connection with the forged release). Defendants moved to dismiss, arguing, *inter alia*, that the First Amendment provided a complete defense to Dickinson's claims,

asserting the doctrine of *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989) as their primary defense.

The district court granted Defendants' motion to dismiss Dickinson's operative complaint, but with leave to amend. Ultimately, however, following pleading amendments and additional motion practice,⁵ the district court dismissed Dickinson's Lanham Act claims with prejudice.⁶ The district court issued its final ruling dismissing Dickinson's case on March 26, 2019.

Dickinson appealed the district court's ruling to the Ninth Circuit Court of Appeals, in which Dickinson argued, *inter alia*, that defamatory speech about a public figure made with actual malice has no First Amendment protection at all, regardless of whether the speech is "creative" or "expressive," and thus, *inter alia*, the *Rogers* test, which is predicated on balancing First Amendment concerns against

⁵ Dickinson filed her initial Complaint on March 29, 2018. Dickinson filed a First Amended Complaint ("FAC") on June 29, 2018. On July 30, 2019, Defendants moved to dismiss the FAC. Following motion practice and oral argument, the district court granted Defendant's motion but with leave to amend.

On October 31, 2018, Dickinson filed her Second Amended Complaint ("SAC") but also filed a motion for leave to amend to add defamation and other state law claims in a Third Amended Complaint ("TAC"). Defendants filed a motion to dismiss the SAC. After the district court granted Dickinson's motion for leave to amend and file the TAC, the parties stipulated that the pending motion could be asserted against the TAC with respect to the original four claims.

⁶ The district court also declined to exercise supplemental jurisdiction over Dickinson's state law claims.

Lanham Act concerns, either could not be applied at all or had to take into account the presence of constitutional actual malice by the Defendants.

On December 21, 2020, the Ninth Circuit issued a five-page memorandum opinion affirming the district court ruling. The Ninth Circuit stated that, “contrary to Dickinson’s arguments, the only requirement for application of *Rogers* is that “the [Appellees] . . . make a threshold legal showing that [their] allegedly infringing use [was] part of an expressive work protected by the First Amendment.” *Dickinson v. Ryan Seacrest Enters. Inc.*, 839 F.App’x 110, 111 (9th Cir. 2020). The appellate court then conducted the *Rogers* analysis without regard to whether the content Dickinson complained of – specifically, the false narrative that Defendants deliberately concocted to exploit her mark – constituted defamatory speech. The Ninth Circuit then held that the entirety of the Episode was protected under the First Amendment. Thus, the Ninth Circuit implicitly determined, without any discussion, that the fact that the speech at issue by defendants about the plaintiff was undisputedly defamatory speech made with actual malice, and for the premeditated purpose of willfully misappropriating the plaintiff’s goodwill, was of no moment whatsoever under the *Rogers* test.

This petition follows.

REASONS FOR GRANTING THE PETITION

I. The Question Presented is Exceptionally Important

As briefly discussed above, the question will have profound ramifications on the intentional dissemination by the media of false information to consumers held out by that same media as true – the intentional use of “fake news” to influence consumer choice, and to misappropriate the brand and goodwill of another. While necessarily broad, the First Amendment was never intended to facilitate the unauthorized and actively malicious exploitation of an individual’s name, likeness, and other aspects of their identity. Nor was the First Amendment ever intended to protect the intentional dissemination of false information.

Today’s digital landscape allows fake news, which can make use of deepfakes and cheapfakes alike, to spread rapidly, with little that the exploited individual can do to reclaim his or her rights. Moreover, such damage is not necessarily limited to that of any one plaintiff, but rather affects the public and our society as a whole. Defendants’ exploitation of Dickinson’s celebrity certainly impacted her individually – through the loss of creative control over her celebrity and the resulting reputational damage. However, it also damaged consumers by undermining the integrity of the information signaling the consumers use to make decisions. It is no exaggeration to say that the very foundations of our

democratic society are put at risk the more that the accuracy and integrity of the information put out into the mediasphere becomes uncertain. For instance, false information has the potential to manipulate civil discourse, interfere with elections, undermine legitimate news sources, erode trust in public institutions; indeed, such false information was arguably the cause of civil unrest rising to the level of physical violence within the halls of Congress itself.⁷

II. The Ninth Circuit Erred in Holding that Courts Do Not Need to Consider the Presence of Defamatory Speech Made with Constitutional Actual Malice in Considering the *Rogers* Test

Review is also warranted to correct the Ninth Circuit’s erroneous decision.

As addressed above, under *Rogers*, Lanham Act claims directed against the marketing and advertising of “expressive works protected by the First Amendment” are limited to only those claims “where

⁷ See, e.g., *Initiatives to Counter Fake News in Selected Countries*, The Law Library of Congress, Global Legal Research Directorate (April 2019), <https://www.loc.gov/law/help/fake-news/counter-fake-news.pdf>. See also Eriq Gardner, *Deepfakes Pose Increasing Legal and Ethical Issues for Hollywood*, The Hollywood Reporter (July 12, 2019), <https://www.hollywoodreporter.com/business/business-news/deepfakes-pose-increasing-legal-ethical-issues-hollywood-1222978/>; Edvinas Meskys, Julija Kalpokiene, Paulius Jurcys, and Aidas Liaudanskas, Aidas, *Regulating Deep Fakes: Legal and Ethical Considerations* (December 2, 2019), available at <https://ssrn.com/abstract=3497144>.

the public interest in avoiding consumer confusion *outweighs* the public interest in free expression.” *MCA Recs.*, 296 F.3d at 894 (citing *Rogers*, 875 F.2d at 999) (emphasis added).) However, the Ninth Circuit entirely failed to reconcile its holding with long-established First Amendment jurisprudence, under which there is no public interest weight given to defamatory speech about a public figure made with actual malice – actual malice is the established line where the public interest becomes weightless.

It is true that case law holds that, where *Rogers* is applicable, a plaintiff must show “(1) that [plaintiff] has a valid, protectable trademark, and (2) that the mark is either not artistically relevant to the underlying work *or* explicitly misleading as to the source or content of the work.” *Gordon*, 909 F.3d at 265 (emphasis added). But before a court gets to those prongs, the defendant first must make a threshold showing that the underlying work was “an expressive work protected by the First Amendment.” The Ninth Circuit recently reaffirmed this rule in *Gordon*: “The *Rogers* test requires the defendant to *make a threshold legal showing that its allegedly infringing use is part of an expressive work protected by the First Amendment*.” *Gordon*, 909 F.3d at 264 (emphases added). There was no dispute that Dickinson alleged detailed and plausible allegations that Defendants’ speech was defamatory toward her and made with actual malice, and those allegations governed at the pleadings stage at which the case was decided.

Thus, for the *Rogers* test to apply, Defendants should have been required to demonstrate that their *speech about Dickinson was protected by the First Amendment*. It makes no sense to allow Defendants to enjoy First Amendment protection against Plaintiff's claims where the actionable content – Defendants' speech about the Plaintiff – has no First Amendment protection at all. The Ninth Circuit thus should have held that Defendants failed to meet their threshold burden that the relevant content constituted “expressive work *protected by the First Amendment*.” *Gordon*, 909 F.3d at 264 (emphasis added); *see also MCA Recs.*, 296 F.3d at 900 (Ninth Circuit first analyzed in detail whether Aqua's *Barbie Girl* was a work entitled to First Amendment protections, as a pre-condition to applying the *Rogers* test).

Instead, the Ninth Circuit determined that the Episode *was* First Amendment-protected just because it was a “reality” television program, without considering whether the speech *about Dickinson* was entitled to First Amendment protection. That was error. While a “reality” television episode is an “expressive work,” that does *not* mean that everything in it is protected by the First Amendment. Indeed, actually malicious defamatory speech about public figures in the case law is frequently highly expressive – yet also not protected by the First Amendment.

The Ninth Circuit therefore appears to hold that *Rogers* overrides the actual malice test of *New York Times v. Sullivan* for expressive works in the

Lanham Act context. But there is no case that says any such thing: no case has ever stated that *Rogers* eliminates actual malice analysis if it might be applicable. In fact, it appears that the only reason the *New York Times v. Sullivan* standard has not yet been addressed in a case under *Rogers* thus far is that no defendant has yet been so brazen as to undeniably create defamatory speech about a public figure with actual malice, and with express intent to deceive consumers, and then assert *Rogers* as a defense. *Rogers* was never intended to apply to such situations.

Rather, it has always been the implicit premise in *Rogers* cases that the underlying work being analyzed *isn't* one created with actual malice or intentional bad faith toward the plaintiff or consumers. *See, e.g., Parks v. LaFace Recs.*, 329 F.3d 437, 451-452 (6th Cir. 2003) (finding no actual malice by defendants due to lack of false statements in connection with song that used the plaintiff's name in title). Indeed, to Dickinson's knowledge, no *Rogers* case at any level has ever gone against this premise, until the instant case. This Court therefore should clarify that intentionally false speech made with actual malice like Defendants engaged in here must be analyzed outside of the *Rogers* doctrine.

III. This Case is a Particularly Suitable Vehicle for Resolving the Question Presented

This case also presents an excellent vehicle for addressing the pitfalls of adopting and applying the

Rogers test in balancing First Amendment protections against the Lanham Act's dual policy concerns of protecting mark holders' property rights and of protecting the public against false, misleading and confusing speech.

The procedural posture and the extreme factual circumstances alleged in this case puts into stark view how the *Rogers* test applies where defamatory speech undisputedly made with actual malice is involved. This case therefore provides this Court with an opportunity to address whether defamatory speech made with actual malice about a famous public figure, is protected against Lanham Act claims under the First Amendment even though it otherwise would not have First Amendment protection outside the Lanham Act context, or in the alternative, to make clear that constitutional actual malice is of no moment in assessing Lanham Act claims where the underlying product is any form of expressive work.

Moreover, the case also highlights the inconsistent approaches taken by the circuit courts in balancing interests under the First Amendment and the Lanham Act.⁸

The Third, Seventh, Eighth, and Tenth Circuits have either expressly rejected the *Rogers* test or have

⁸ See also Anthony Zangrillo, *The Split on the Rogers v. Grimaldi Gridiron: An Analysis of Unauthorized Trademark Use in Artistic Mediums*, 27 Fordham Intell. Prop. Media & Ent. L.J. 385 (2017), available at <https://ir.lawnet.fordham.edu/iplj/vol27/iss2/5>.

not yet decided whether to do so. *See, e.g., Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007 (3d Cir. 2008) (declining to decide whether to adopt the *Rogers* test); *Eastland Music Grp., LLC v. Lionsgate Entm't, Inc.*, 707 F.3d 869, 871 (7th Cir. 2013) (same); *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987) (following an alternative avenues approach, holding that a trademark owner's rights need not "yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist."); *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 970 (10th Cir. 1996) (holding that the trademark law has "built-in mechanisms that serve to avoid First Amendment concerns").

The Second, Fourth, Fifth, Sixth, Ninth, and Eleventh Circuits have all adopted the *Rogers* test but differ in how they apply it. For instance, the Second and Fifth circuits have incorporated the eight-factor balancing test from *Polaroid Corp. v. Polarad Elec. Corp.*, 287 F.2d 492, 495 (2d Cir.), *cert. denied*, 368 U.S. 820 (1961) into the "explicitly misleading" prong of the *Rogers* test. *See, e.g., Twin Peaks Prods., Inc. v. Publications Int'l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993) (determining whether title of book was explicitly misleading "by application of the venerable *Polaroid* factors"); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 665 (5th Cir. 2000) (adopting Second Circuit approach). In contrast, the Fourth, Sixth, Ninth and Eleventh circuits treat the "explicitly misleading" prong as a distinct inquiry

from the likelihood of confusion analysis — requiring a finding that there be “an ‘explicit indication,’ ‘overt claim,’ or ‘explicit misstatement’ that caused such consumer confusion.” *Empire*, 875 F.3d at 1199 (citing *MCA Recs., Inc.*, 296 F.3d at 902); *see also Radiance Found., Inc. v. N.A.A.C.P.*, 786 F.3d 316, 329 (4th Cir. 2015) (reversing judgment in favor of defendant’s counterclaims of trademark infringement and dilution on basis that there was no consumer confusion as to “source, sponsorship or affiliation”); *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 937 (6th Cir. 2003) (finding use of celebrity’s image did not explicitly mislead as to source of work); *Univ. of Ala. Bd. of Trustees v. New Life Art, Inc.*, 683 F.3d 1266, 1279 (11th Cir. 2012) (artist’s use of university’s trademarks on products did not explicitly mislead as to source of content). In Dickinson’s case specifically, the Ninth Circuit held that Dickinson failed the *Rogers* test because there was no “explicitly misleading” statement as to the “source or content” of the Episode — given that Dickinson actually attended the charity event, and given that Defendants’ false statements about Dickinson nevertheless truthfully described the (false) content of Episode (with the Ninth Circuit declining to wrestle expressly with the Defendants’ intentionally false labelling of the Series and thus the Episode as telling true stories, in the nature of news). Dickinson submits that this reasoning under the Ninth Circuit, too, contravenes both fundamental principles of the First Amendment of the Lanham Act.

Accordingly, this case also provides this Court with an opportunity to provide guidance to the circuit courts on a consistent approach as to when a trademark owner's property interest must yield to First Amendment rights.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be granted.

Respectfully submitted,

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May 19, 2021

APPENDIX

APPENDIX A

NOT FOR PUBLICATION

**UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT**

—
No. 19-55415

D.C. No. 2:18-cv-02544-GW-JPR

—
JANICE DICKINSON,
Plaintiff-Appellant,
v.

RYAN SEACREST ENTERPRISES INC.; ET AL.;
Defendants-Appellees.

—
Appeal from the United States District Court
For the Central District of California
George H. Wu, District Judge, Presiding
Submitted June 2, 2020*
Pasadena, California

—
Filed December 21, 2020

* The panel unanimously concludes this case is suitable for decision without oral argument. *See Fed. R. App. P. 34(a)(2).*

Before: LIPEZ, ** RAWLINSON, and N.R. SMITH,
Circuit Judges.

MEMORANDUM***

Appellant Janice Dickinson (Dickinson) appeals the district court's dismissal of her Lanham Act and state law claims against Appellees Ryan Seacrest Enterprises Inc., Truly Original, LLC, Sun Productions, LLC, Tess Cannon, NBCUniversal Media, LLC, Erik Rosette, Ryan Seacrest Productions, LLC, and Suns Productions, LLC based on her portrayal in the reality television series, *Shahs of Sunset* (*Shahs*). We have jurisdiction under 28 U.S.C. § 1291 and review *de novo* the district court's order of dismissal under Rule 12(b)(6) of the Federal Rules of Civil Procedure. *See Curtis v. Irwin Indus., Inc.*, 913 F.3d 1146, 1151 (9th Cir. 2019).

When an allegedly infringing use of a mark is an expressive work, we apply the test from *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), to determine whether the Lanham Act applies. *See Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1196 (9th Cir. 2017). Despite Dickinson's contrary arguments, the only requirement for application of *Rogers* is that "the [Appellees] ... make a threshold legal showing that [their] allegedly infringing use [was] part of an expressive work protected by the First Amendment." *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 264 (9th Cir.

** The Honorable Kermit V. Lipez, United States Circuit Judge for the First Circuit, sitting by designation.

*** This disposition is not appropriate for publication and is not precedent except as provided by Ninth Circuit Rule 36-3.

2018) (emphasis added). Dickinson concedes that “a ‘reality’ television episode is an ‘expressive work.’ ” Thus, Appellees made the threshold legal showing that the allegedly infringing use of the mark in the *Shahs* episode was “part of an expressive work protected by the First Amendment.” *Id.* Accordingly, we apply the *Rogers* test to ascertain the viability of Dickinson’s Lanham Act claims arising out of the episode of *Shahs* and the related advertisements. *See Empire*, 875 F.3d at 1196-97.

To succeed under the *Rogers* test, the “creator’s use of the mark [must be] explicitly misleading as to source or content.” *Gordon*, 909 F.3d at 269 (citation and internal quotation marks omitted) (emphases added). Dickinson argues that the Appellees’ use of her mark was explicitly misleading as to source *and* content. We disagree. First, under *Rogers*, we ask whether Dickinson’s appearance on an episode of the series would “explicitly mislead consumers” into thinking that Dickinson endorsed or sponsored *Shahs*—*i.e.*, we consider whether use of the mark “explicitly [misled] consumers” as to the source of the work. *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1245-46 (9th Cir. 2013) (citation, alterations, and internal quotation marks omitted). There must be “an explicit indication, overt claim, or explicit misstatement” that causes consumer confusion. *Id.* at 1245 (citation and internal quotation marks omitted).

Dickinson maintains that Appellees exploited her mark to promote the *Shahs* series by taking advantage of the accumulated goodwill from her career as a supermodel. Dickinson did not allege that

the *Shahs* episode or the promotional materials for that episode contained an explicit representation that Dickinson was an endorser or sponsor of the series. Rather, Dickinson alleged only that she made an appearance on the show. *See id.* (stating that “the mere use of a trademark alone cannot suffice to make such use explicitly misleading”) (citation omitted). Thus, Dickinson failed to allege that Appellees’ use of the mark is explicitly misleading as to source or sponsorship.

Second, Dickinson argues that Appellees’ use of the mark explicitly misleads consumers as to the content of the episode. Dickinson contends the following two alleged false representations act together to deceive consumers into believing the romper controversy actually occurred: (1) that *Shahs* is unscripted and portrays real-life events; and (2) in the episode, Dickinson stole the romper and had a confrontation with a *Shahs* cast member related to the romper. Under *Rogers*, the relevant inquiry is not simply whether the content or advertisements are misleading, but whether the Appellees’ use of the mark explicitly misleads consumers as to the content of the work. *See id.* at 1239.

Considered individually or collectively, the alleged misrepresentations do not *explicitly* mislead consumers as to the content of the episode. Indeed, as the district court recognized with respect to the first alleged misrepresentation, Dickinson’s “mark has no bearing on whether or not Bravo advertises [its] show as a scripted series or reality television.” With respect to the second category of misrepresentations, the identified clips and equivocal statements containing

the mark accurately portray the content of the episode. Even considered collectively, the alleged misrepresentations do not explicitly mislead consumers but, only *implicitly* suggest that the romper controversy actually occurred. Therefore, because Dickinson's allegation did not state a plausible Lanham Act claim, the district court correctly dismissed the claims predicated on the Lanham Act and the remaining state law claims. *See Lima v. United States Dep't of Educ.*, 947 F.3d 1122, 1128 (9th Cir. 2020) (explaining that the district court may decline to exercise supplemental jurisdiction over state law claims, when no federal claims remain).

AFFIRMED.¹

¹ Because our resolution of the Lanham Act claims is dispositive, we need not and do not address any other issues raised by the parties. *See Marder v. Lopez*, 450 F.3d 445, 454 (9th Cir. 2006).

APPENDIX B

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

—
D.C. No. 2:18-cv-02544-GW-JPR
—

JANICE DICKINSON,
Plaintiff,
v.

RYAN SEACREST ENTERPRISES INC.; ET AL.;
Defendants.

—
PROCEEDINGS: IN CHAMBERS - FINAL RULING
ON DEFENDANTS' MOTION TO DISMISS
PLAINTIFF'S SECOND AMENDED COMPLAINT

—
The Honorable George H. Wu

—
Filed March 26, 2019

Attached hereto is the Court's Final Ruling. The first three federal causes of action contained in the Third Amended Complaint under 15 U.S.C. §§ 1125(a)(1)(A), 1125(a)(1)(B) and 1125(c) are dismissed without leave to amend; and the Court declines to exercise supplemental jurisdiction over the remaining state claims (causes of action four through ten) and dismisses them without prejudice.

Dickinson v. Ryan Seacrest Enterprises, Inc.; Case No. 2:18-cv-02544-GW-(JPRx) Final Ruling on Defendants' Notice of Motion and Motion to Dismiss Plaintiff's Second/Third Amended Complaint

I. Background

A. Factual Background

Plaintiff Janice Dickinson ("Dickinson" or "Plaintiff") sues Ryan Seacrest Enterprises Inc.; Truly Original, LLC; Sun Productions, LLC; Tess Cannon; NBC Universal Media, LLC; Erik Rosette ("Rosette") aka Erik Rosete aka Mister Triple X; Ryan Seacrest Productions, LLC; Suns Productions LLC; and Does 3-20 (collectively, "Defendants")¹ for: (1) false endorsement in violation of 15 U.S.C. § 1125(a)(1)(A); (2) false advertising in violation of 15 U.S.C. §

¹ On July 9, 2018, Plaintiff filed a notice of voluntary dismissal without prejudice as to Ryan Seacrest Enterprises, Inc. and Sun Productions, LLC. See Plaintiff Janice Dickinson's Notice of Voluntary Dismissal Without Prejudice of Defendants Ryan Seacrest Enterprises, Inc. and Sun Productions, LLC, Docket No. 33.

1125(a)(1)(B); (3) dilution in violation of 15 U.S.C. § 1125(c); (4) violation of California Business & Professions Code §§ 17200 (the “UCL”), *et seq.*; (5) Defamation; (6) False Light (7) Invasion of Privacy; (8) Fraud; (9) Unjust Enrichment; and (10) Reasonable Value of Services. *See generally* Third Amended Complaint (“TAC”), Docket No. 70. The first three causes of action are brought pursuant to federal trademark/Lanham Act law and the remaining claims under state law.

The TAC alleges the following:

1. Plaintiff’s Background

Plaintiff is a “famous” and “indeed legendary [] supermodel,” a “fashion and popular culture icon” and a “well-recognized television and media personality.” *See TAC ¶ 13.* In the past, Plaintiff has designated representatives to enter into agreements to authorize the use of her “appearance and celebrity,” including in television. *See id. ¶ 23.* Plaintiff has been a producer, judge, contestant, and/or guest star in the following reality television series: *America’s Next Top Model*, *The Janice Dickinson Agency*, *I’m a Celebrity ... Get Me Out of Here!*, *Celebrity Rehab with Dr. Drew*, and *Celebrity Big Brother*. *See id. ¶ 24.* Plaintiff attends charity runway shows and photoshoots without a fee for the dual purpose of serving charity and “maintaining and building goodwill in her mark and brand.” *See id. ¶ 25.* Plaintiff does not appear on reality television shows pro bono. *See id.*

2. Plaintiff's Work for Rosette at Los Angeles Fashion Week

Plaintiff has known Rosette for many years. *See id.* ¶ 26. Rosette is a designer and the founder of Art Hearts Fashion, a “charitable organization that produces runway shows during New York Fashion Week, Los Angeles Fashion Week, and other fashion events. *See id.* Plaintiff appeared as a runway model pro bono during Los Angeles Fashion Week for Rosette each year between 2010 and 2016. *See id.* ¶ 27. Rosette knew that Plaintiff would not appear pro bono as a runway model if Rosette were planning to exploit Plaintiff’s “celebrity” without her consent to facilitate a reality television show. *See id.*

In Fall 2016, Plaintiff agreed to appear in Rosette’s runway show under his “Mister Triple X” label,” with the show scheduled for October 2016 during Los Angeles Fashion Week. *See id.* ¶ 28. Plaintiff understood that her appearance would go toward supporting the Mister Triple X label and young emerging artists and designers within the Art Hearts Fashion organization, not to promoting, marketing, or advertising a reality television series. *See id.* ¶ 29. Plaintiff did not and would not have agreed to appear in the show in a way that would be harmful to her celebrity and her brand. *See id.* Plaintiff is informed and believes that Rosette, without her knowledge, contracted with or otherwise agreed and arranged with one or more Defendants to exploit Plaintiff’s appearance on an episode of the *Shahs of Sunset* Series (“Series”). *See id.* ¶ 30. If Plaintiff had known

about these arrangements she would not have appeared pro bono, or necessarily at all. *See id.* ¶ 31. Plaintiff would not have agreed to participate in a narrative in the Series that would have a negative impact on her celebrity brand. *See id.* ¶ 33.

Plaintiff alleges that Rosette, along with one or more agents for Seacrest Productions, Truly Cannon, and/or Suns Productions agreed and conspired to script an episode of the Series (“the Episode”) to include a false controversy in which they would make it appear that Plaintiff intentionally stole or bullied her way into wearing an outfit that had supposedly been previously selected for Golnesa Gharachedaghi (“Gharachedaghi”), a lead character on the Series. *See id.* ¶ 34. This group scripted the episode so that: (1) Plaintiff’s conduct in “stealing” the outfit would upset Gharachedaghi; (2) Gharacedaghi would falsely act as though she was experiencing “trauma and consternation,” and; (3) Gharachedaghi would “intentionally, maliciously and falsely disparage Plaintiff on camera.” *See id.* This group conspired and scripted the Episode with the intent of keeping the plan and script secret from Plaintiff, which they ultimately did. *See id.* ¶ 35. Defendants have and continue to falsely represent that the Series is a documentary program rather than a scripted or fictional series, when in fact the Series is largely or entirely scripted. *See id.* ¶ 36. The group did so to market, advertise, and promote the Series by improperly trading off the goodwill, celebrity, and fame of Plaintiff, without paying any fee. *See id.*

Defendants knew that if Plaintiff was aware that the series was scripted to include her, she would have expected a “substantial fee” to participate. *See id.* ¶ 37. Defendants intentionally engaged in conduct to improperly usurp Plaintiff’s good will for their own business purposes with the knowledge that their actions would “effectively destroy or at least seriously damage” Plaintiff’s “own true affirmative goodwill-building narrative achieved by performing services at the event” in a positive and professional manner.” *See id.* By doing so Defendants destroyed Plaintiff’s own marketing and promotion effort. *See id.*

3. The Fall 2016 Mister Triple X Show at Los Angeles Fashion Week

On or around October 11, 2016, Plaintiff participated in the Mister Triple X runway show at the Beverly Hilton during Los Angeles Fashion Week. *See id.* ¶ 41. In the backstage dressing area, a member of the Arts Hearts Fashion staff, with Rosette’s knowledge and approval, directed Plaintiff to a rack of Mister Triple X label clothing. *See id.* ¶ 42. The staff member then offered Plaintiff two choices of outfits from the rack, one of which was a shiny silver romper that the staff member strongly encouraged Plaintiff to choose to effectuate the pre-scripted conspiracy. *See id.* Rosette and the staff member intentionally manipulated Plaintiff into choosing the romper. *See id.*

Prior to the runway show, Rosette arranged and directed Plaintiff to participate in a photoshoot wearing the romper in the backstage area, which was

part of the pre-scripted conspiracy kept from Plaintiff. *See id.* ¶ 43. Plaintiff then opened and closed the runway show wearing the romper. *See id.* At no time did Plaintiff sign any contract or release for her appearance on the Series or in the Mister Triple X runway show. *See id.* ¶ 44. Prior to the airing of the Episode, Plaintiff was unaware that Defendants were producing the Episode during Los Angeles Fashion Week and she was similarly unaware of the pre-scripted conspiracy. *See id.* Defendants contend that they obtained a signature from Plaintiff; and Plaintiff avers that, if they did so, it was by deception such that Plaintiff was unaware that she was signing anything at all, or believed she was signing something other than a release. *See id.* ¶ 45. In the alternative, Defendants or persons acting on their behalf falsely affixed a signature that was not Plaintiff's and was not authorized by her, around the date of the fashion show. *See id.* Under this version, Defendants falsified Plaintiff's signature to represent within the corporate hierarchy they had followed the legal requirements, and requirements of insurers, and corporate policies in obtaining a release from Plaintiff. *See id.* ¶ 47.

4. Plaintiff's Learning of Her Appearance on the Episode

On or around August 2017, Plaintiff learned that her appearance in Fall 2016 at the Mister Triple X runway show was exploited in the Episode, first aired on July 30, 2017 on Bravo TV. *See id.* ¶ 51. The Episode shows Plaintiff walking the runway during the Mister Triple X show, Plaintiff preparing backstage, and Plaintiff

posing at the backstage photoshoot wearing the romper. *See id.* ¶ 52. Those scenes were filmed without Plaintiff's knowledge or consent and were intentionally manipulated to feature Plaintiff prominently in the Episode and accompanying promotion, marketing, and advertising to trade off of Plaintiff's fame and good will. *See id.* Those scenes were used to intentionally create a false narrative that Plaintiff "stole" or "jacked" the romper Rosette promised for Gharachedaghi, one of the lead characters in the Series. *See id.* ¶ 53.

In the Episode, Plaintiff wears the romper and Gharachedaghi looks at Plaintiff and tells Rosette "[w] hat's going on with that outfit," to which Rosette replies "[y]ou got jacked." *See id.* ¶ 54. Gharachedaghi then exhibits purported outrage at how Plaintiff stole the romper, when in fact Gharachedaghi was not "supposed to wear" the outfit and Plaintiff did not "take" it. *See id.* The Episode then shows Gharachedaghi reacting to Plaintiff's seemingly selfish conduct that was engineered by Rosette and his staff. *See id.* The intent of the exchange was to portray Plaintiff as an "arrogant, unprofessional and purportedly past-her-prime" celebrity attempting to interfere with Gharchedaghi's fashion show experience. *See id.* ¶ 55.

Defendants' actions "seriously damaged" Plaintiff's reputation with consumers and caused her to lose the "goodwill value of her charity work" for the event. *See id.* Plaintiff's name, image, likeness and reputation were "blatantly" used to promote the Episode and the

Series in television and online advertising, as well as in print media leading up to the Episode's release without Plaintiff's approval. All of the promotional materials portrayed her as a "fashion runway 'thief'" who stole Gharachedaghi's outfit, and alleged a false narrative that the storyline was "reality." *See id.* ¶ 61. Defendants' also caused the press to repeat their false narrative about the Episode. *See id.* Members of the public understood and believed the episode to portray the true story of how Plaintiff conducted herself at the charity event. *See id.* ¶ 62. Members of the public decided that they "did not like" or "hated" Plaintiff as a result of viewing the Episode and advertising. *See id.* Public commenters on a Youtube clip of the episode made disparaging comments about Plaintiff based upon the content of the episode. *See id.*

5. Plaintiff's Confrontation with Defendants and the Forging of the Release

After becoming aware of the Episode, Plaintiff and/or her representatives communicated with producers of the Series about how the Episode came to pass. *See id.* ¶ 63. The producers claimed Plaintiff had authorized the above in a written signed release. *See id.* Plaintiff did not sign such a release, and it took weeks for the producers to produce the release. *See id.* ¶¶ 63.

On or around September 6, 2017, Plaintiff received an email from Cannon ("Cannon Email") attaching a document that purports to be a printout of an electronic release signed by Plaintiff on a mobile

device (“Purported Release”). *See id.* ¶ 64-65; TAC Ex. A (copy of the Cannon Email and the Purported Release), Docket No. 70-1 at CM/ECF pgs. 2-5. The Purported Release reflects a release between Janice “Dickenson” (spelling incorrect in Purported Release) and Suns Productions, LLC, in which Plaintiff released Suns Productions, NBC Universal, and all their affiliates from a broad range of liability for Plaintiff’s appearance in the Series. *See id.*

Subject to the alternative versions regarding Plaintiff’s signature on the release, Plaintiff never signed the Purported Release and the signature does not match Plaintiff’s signature. *See TAC ¶ 51.* The signature on the Purported Release is different from a sample of Plaintiff’s signatures. *See id.*; TAC Ex. B (sample of Plaintiff’s signature), Docket No. 70-2 at CM/ECF pg. 2. As such, upon information and belief at least some of Defendants forged Plaintiff’s signature on the Purported Release. *See TAC ¶ 66.* Cannon presented the forged release to Plaintiff to defraud her and did so at the direction of or with the encouragement of each of the Defendants. *See id. ¶ 67.* Plaintiff requested the electronic original of the Purported Release to conduct a forensic examination, but Defendants have refused. *See id. ¶ 68.* Defendants have made no denial as to forging the Purported Release. *See id. ¶ 69.*

The Episode at issue continues to be distributed on BravoTV’s cable broadcast, through BravoTV.com, through BravoTV’s mobile application, and through download or streaming on Amazon Prime Video,

Google Play, Hulu, and other platforms. *See id.* at ¶ 70. Plaintiff's appearance in the Episode continues to be used in advertising and promotion as of the writing of the TAC. *See id.*

6. Defendants' False Statements About the Content of the Series, the Episode and Plaintiff

Defendants' succeeded in their "fraudulent and unethical scheme" by making false statements to consumers, including explicitly false and/or explicitly misleading statements about the source, and the content of the Series and the Episode. *See id.* ¶ 71. Defendants have perpetrated a fraud on consumers with their messaging promoting the Series as a true story. *See id.* ¶ 72-73. Defendants do not deny that the series is largely scripted. *See id.* ¶ 72. Large segments of consumers believe that the Series and its episodes are unscripted, true stories. *See id.* ¶ 74. Defendants have put out explicit statements indicating that the show is unscripted for the purpose of giving consumers this false impression. *See id.*

The Series and its episodes are produced by a combination of activities carried out by Cannon, Truly, Suns Productions and Seacrest Productions, as programming for Bravo. *See id.* ¶ 76. Bravo is a television station owned and operated by NBCUniversal, and carried on basic cable. *See id.* NBCUniversal licenses Bravo as a channel to cable television providers, who include it in their packages. *See id.* ¶ 77. NBCUniversal also licenses Bravo video content to online retailers with the right

to “sell” episodes to consumers for a fee. *See id.* ¶ 78. Defendants profit from consumers viewing the series through cable programming license fees, advertising revenue and download revenue. *See id.* ¶ 79. All of the monetization models depend, at least in part, on the popularity of the series and its episodes among consumers. *See id.* ¶ 80. Defendants (other than Rosette) have inserted false statements into the stream of commerce claiming that the Series episodes are “true stories” in order to attract viewers. *See id.* ¶ 81.

Defendants have used the following Misstatements about content to perpetuate the fraud that the television series is unscripted, true content:

1. **“Docuseries” and “Unscripted” Labels.** On or about January 23, 2012 NBCUniversal issued a press release describing the series as a “docu-series.” *See id.* ¶ 83. This is an explicitly false statement. *See id.* ¶ 84. The “docu-series” description influences consumers purchasing decisions. *See id.* ¶ 84. At the point of sale for the series and its episodes, including the Episode at issue in this litigation, the series is touted as “unscripted” because Defendants and NBCUniversal approved and/or encouraged such a description. *See id.* ¶ 89.
2. **“True Entertainment” Label.** Many episodes of the Series available for download from online video retailers include a credit to a production entity associated with the series, called “True Entertainment.” *See id.* ¶ 90. Featuring this credit on the screen at the end of the programming is intended to make viewers believe that the Series

tells “true stories.” This label induces consumers to purchase other episodes of the show and reinforces the false belief that the Series tells “true stories.” *See id.* at 91.

NBCUniversal actively markets and advertises the Series and its episodes on Bravo TV’s website. *See id.* ¶ 98; TAC Exhibit G (“Exhibit G”), Docket No. 70-7, CM/ECF pgs. 2-8. The website invites consumers to engage in commercial behavior by encouraging viewers to watch episodes through links on the page that direct them to log into a cable television subscription, or to download the episode for a fee. *See TAC* ¶ 99-100. To encourage viewers to watch episodes of the Series, Bravo TV’s website includes “preview” clips for each episode with a written “teaser” about each clip for the purpose of enticing consumers to watch or buy an episode. *See id.* ¶ 101. Two of the marketing clips for the Episode shown on Bravo TV’s website use Plaintiff’s mark to make false statements about the content of the episode to encourage consumers to commercially engage with the episode. *See id.* ¶ 102; Exhibit G. One of the Bravo TV Website clips advertising the Episode (“Clip 1”) includes this statement: “Did Janice Dickinson Just Steal GG’s Look?! Evidently she took the outfit GG was supposed to wear on the runway, and GG is pissed” *See id.* at 1,3; TAC ¶ 103. This is an explicit statement that the episode shows Plaintiff “stealing” Gharachedaghi’s “look” by taking the outfit Gharachedaghi was supposed to wear at the fashion show. *See id.* ¶ 103. The episode’s content does not show Plaintiff “stealing” the outfit or having any confrontation with Gharachedaghi. *See id.* Combined

with the “pre-established false status of the Series as a docu-series, these statements explicitly mislead viewers to falsely believe that Plaintiff actually “stole” Gharachedaghi’s outfit. *See id.* When Clip 1 is played, it shows Plaintiff walk by Gharachedaghi, and a dialogue between Gharachedaghi and other cast members implying that Plaintiff stole the outfit. *See id.* ¶ 104. In a July 20, 2017 YouTube Piece, the same clip (Clip 1) was featured with an identical “teaser” statement. *See id.* ¶ 113-114. Closed captioning is included so that viewers can read the false statements included in the exchange. *See id.* ¶ 104. Another teaser clip on the Bravo TV website promoting the Episode (“Clip 2”) includes the following text: “Did we mention Janice Dickinson makes an appearance?” *See id.* ¶ 105. Given Plaintiff’s star power, consumers would assume that Plaintiff would only “appear” on the series voluntarily, and that as such, she endorsed the show. *See id.*

During telecasts of the Episode on the Bravo channel, NBCUniversal ran interstitial advertisements during the Episode to tease viewers about upcoming content. *See id.* ¶ 109. The interstitials suggest Plaintiff bullyed Gharachedaghi out of her outfit. *See id.* These interstitials explicitly convey false statements to consumers about the content by implying that if consumers continue to tune in they will be shown documentary footage of a controversy between Plaintiff and Gharachedaghi. *See id.* One of the interstitials includes a clip where a cast member says “It’s about to go disown” meaning that there is about to be an on screen fight between Gharachedaghi and Plaintiff. *See id.* The episode never shows any

confrontation between Plaintiff and Gharchedaghi, because no confrontation ever occurred. *See id.*

Two days before the Episode release on July 20, 2017, Natalie Stone published an article on PeopleTVWatch headlined “Call the Fashion Police: Janice Dickinson just stole Golnesa ‘GG’ Gharachedaghi’s romper!” *See id.* ¶ 106. Discovery will show that Defendants provided a copy of the episode, and/or relevant clips to Stone as well as false statements about the content of the Episode for the purpose of generating “unpaid” media to increase commercial engagement with the episode. *See id.* ¶ 107-108.

B. Procedural Background

Defendants initially filed a motion to dismiss the FAC which only alleged the three federal causes of action under 15 U.S.C. subsections 1125(a)(1)(A), 1125(a)(1)(B) and 1125(c) plus a state unfair competition claim under California Business and Professions Code §§ 17200 et seq. *See Memorandum of Points and Authorities in Support of Defendants’ Motion to Dismiss Plaintiff’s First Amended Complaint (“First MTD”), Docket No. 38.*² In response,

² Defendants also submitted a request for judicial notice. *See Request for Judicial Notice in Support of Defendants’ Motion to Dismiss Plaintiff’s First Amended Complaint (“Defs.’ RJN”), Docket No. 40.* Defendants request that the Court take judicial notice of the Episode, the three articles referenced in the FAC, the YouTube page referenced in the FAC, and the press release referenced in the FAC. *See id.*; Declaration of Wook

Plaintiff filed an opposition to the MTD. *See* Plaintiff's Memorandum of Points and Authorities in Opposition to Defendants' Motion to Dismiss First Amended Complaint ("First Opp'n"), Docket No. 41. Defendants filed a reply. *See* Reply Memorandum of Points and Authorities in Support of Defendants' Motion to Dismiss Plaintiff's First Amended Complaint ("First Reply"), Docket No. 45. The Court entered a Tentative Ruling on the First MTD on October 1, 2018,

Hwang in Support of Defendants' Motion to Dismiss ("Hwang Decl.") Exs. 1-6, Docket No. 39. The Court would find those materials suitable for judicial notice because they are incorporated by reference in the FAC. *See Tellabs, Inc. v. Makor Issues & Rights, Ltd.*, 551 U.S. 308, 323 (2007) (noting that "courts must consider the complaint in its entirety, as well as other sources courts ordinarily examine when ruling on Rule 12(b)(6) motions to dismiss, in particular, documents incorporated into the complaint by reference"); *see also Coto Settlement v. Eisenberg*, 593 F.3d 1031, 1038 (9th Cir. 2010) (noting that the Ninth Circuit has "extended the doctrine of incorporation by reference to consider documents in situations where the complaint necessarily relies upon a document or the contents of the document are alleged in a complaint, the document's authenticity is not in question and there are no disputed issues as to the document's relevance.").

On a separate note, Plaintiff lodged objections to evidence submitted along with Defendants' First MTD. *See generally* Plaintiff's Evidentiary Objections to Evidence Submitted in Connection with Defendants' Motion to Dismiss Plaintiff's First Amended Complaint ("Pl.'s Objections"), Docket No. 42. Plaintiff objects to the inclusion of examples of her signature on page 3 footnote 1 of the MTD and other examples of Plaintiff's signature including Defendants' link to search results on eBay. *See id.* These samples do not come into play in the below analysis, and thus the Court need not rule on that objection.

dismissing all four causes of action without prejudice. *See Civil Minutes; Defendants Motion to Dismiss Plaintiff's First Amended Complain*, Docket No. 46. The court adopted the Tentative Ruling as its Final Decision on October 3, 2018. *See In Chambers – Ruling on Defendants' Motion to Dismiss Plaintiff's First Amended Complaint ("First MTD Ruling")*, Docket No. 47.

Plaintiff subsequently filed a second amended complaint. *See Second Amended Complaint ("SAC")*, Docket No. 53. Defendants filed a motion to Dismiss the SAC. *See Defendants' Notice of Motion and Motion to Dismiss Plaintiff's Second Amended Complaint ("MTD")*, Docket No. 59. Plaintiff filed an opposition to the MTD. *See Memorandum in Opposition to Notice of Motion and Motion to Dismiss Case ("Opp'n")*, Docket No. 62. Defendant filed a reply in support of the MTD. *See Reply in Support of Notice of Motion and Motion to Dismiss Case ("Reply")*, Docket No. 64. Prior to the hearing on the MTD as to the SAC, the parties stipulated to Plaintiff's filing a third amended complaint with the present ten causes of action. *See Third Amended Complaint ("TAC")*, Docket No. 70. Defendants filed a stipulation for an order approving a procedure to consider the current MTD as a motion to dismiss the first four claims for relief set forth in the TAC (*i.e.* the three federal § 1125 causes of action plus the state unfair competition claim). *See Stipulation for Order Approving Procedure Proposed by Parties in Stipulation Re: Defendants' Motion to Dismiss Plaintiff's Third Amended Complaint*, Docket No. 71. The Court issued an order on March 12, 2019 approving the procedure

proposed by stipulation. *See Order Approving Procedure Proposed by Parties in Stipulation Re: Defendants' Motion to Dismiss Plaintiff's Third Amended Complaint, Docket No. 72.*

II. Legal Standard

Typically, plaintiffs in federal court need only give “a short and plain statement of the claim showing [entitlement] to relief.” Fed. R. Civ. P. 8(a)(2). Under Rule 12(b)(6), a defendant may move to dismiss for failure to state a claim upon which relief can be granted. Fed. R. Civ. P. 12(b)(6). A complaint may be dismissed for failure to state a claim for one of two reasons: (1) lack of a cognizable legal theory; or (2) insufficient facts under a cognizable legal theory. *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555 (2007); *see also Mendiondo v. Centinela Hosp. Med. Ctr.*, 521 F.3d 1097, 1104 (9th Cir. 2008) (“Dismissal under Rule 12(b)(6) is appropriate only where the complaint lacks a cognizable legal theory or sufficient facts to support a cognizable legal theory.”).

In deciding a 12(b)(6) motion, a court “may generally consider only allegations contained in the pleadings, exhibits attached to the complaint, and matters properly subject to judicial notice.” *Swartz v. KPMG LLP*, 476 F.3d 756, 763 (9th Cir. 2007); *see also Marder v. Lopez*, 450 F.3d 445, 448 (9th Cir. 2006) (indicating that a court may consider a document “on which the complaint ‘necessarily relies’ if: (1) the complaint refers to the document; (2) the document is central to the plaintiff’s claim; and (3) no

party questions the authenticity of the copy attached to the 12(b)(6) motion"). The court must construe the complaint in the light most favorable to the plaintiff, accept all allegations of material fact as true, and draw all reasonable inferences from well-pleaded factual allegations. *Gompper v. VISX, Inc.*, 298 F.3d 893, 896 (9th Cir. 2002); *Sprewell v. Golden State Warriors*, 266 F.3d 979, 988 (9th Cir. 2001), *amended on denial of reh'g*, 275 F.3d 1187 (9th Cir. 2001); *Cahill v. Liberty Mutual Ins. Co.*, 80 F.3d 336, 337-38 (9th Cir. 1996). The court is not required to accept as true legal conclusions couched as factual allegations. *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). Where a plaintiff facing a 12(b)(6) motion has pled "factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged," the motion should be denied. *Id.*; *Sylvia Landfield Trust v. City of Los Angeles*, 729 F.3d 1189, 1191 (9th Cir. 2013). But if "the well-pleaded facts do not permit the court to infer more than the mere possibility of misconduct, the complaint has alleged – but it has not show[n] ... the pleader is entitled to relief." *Iqbal*, 556 U.S. at 679 (citations omitted).

III. Analysis

A. First Claim for Relief - False Endorsement in Violation of 15 U.S.C. § 1125(a)(1)(A)

Plaintiff's first cause of action alleges a claim for false endorsement in violation of 15 U.S.C. § 1125(a)(1)(A) against all Defendants. *See* TAC ¶ 115-130. Defendants move to dismiss that claim. *See* MTD

at 2. Plaintiff admits that this claim is precluded but has included it as part of the TAC to preserve the claim for appeal. Opp'n at 13. The Court, therefore, would dismiss this claim with prejudice.

B. Second Claim for Relief - False Advertising in Violation of 15 U.S.C. § 1125(a)(1)(B)

Plaintiff's second cause of action alleges a claim for false advertising in violation of 15 U.S.C. § 1125(a)(1)(B) against all Defendants. *See* TAC ¶ 142-171. Defendants move to dismiss this claim. *See* MTD at 2. Defendants argue that Plaintiff's claim fails for several reasons. Defendants assert that the Episode and related promotional materials are "expressive works" and do not constitute "commercial speech." *See id.* at 12. Relatedly, Defendants argue that Plaintiff has failed to plead facts sufficient to overcome the two-prong test of *Rogers v. Grimaldi*, 875 F.2d 994 (2nd Cir. 1989), as adopted by the Ninth Circuit in *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1239 (9th Cir. 2013). *See id.* at 1. Therefore, Defendants claim that the Episode and related advertising are protected First Amendment speech not subject to Lanham Act claims. *See id.* at 7. Finally, Defendants argue that Plaintiff has not alleged facts which would establish statutory standing to assert a false advertising claim under the Lanham Act. *See id.* at 16. Plaintiff responds by raising several assertions. First, she contends that the series' advertisements are commercial speech. *See* TAC ¶ 149; Opp'n at 17-20. Second,

Plaintiff argues that the content and advertisements for the Episode explicitly mislead consumers as to content, and therefore are not protected under the *Rogers* test. *See id.* at 14; TAC ¶ 164. As to standing Plaintiff asserts that she falls within the “zone of interest” of the Lanham Act and that her reputational injury was proximately caused by Defendants’ actions, as required by *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118 (2014). *See Opp'n at 20-24.*

1. Standing

The Court will begin its analysis with the primary consideration of whether Plaintiff has standing to assert a claim for false advertising under the Lanham Act. There is no question that Plaintiff has Article III standing, nor does any party make that argument. *See Lexmark*, 572 U.S. at 125 (Constitutional minimum standing requires a plaintiff to have suffered or be imminently threatened with a concrete and particularized “injury in fact” fairly traceable to the challenged action and redressable by a favorable judicial decision.). Defendants assert that Plaintiff has not alleged facts to sufficiently plead statutory standing under the Lanham Act. To assert statutory standing for a false advertising claim, a plaintiff must come within the “zone of interest” protected by the Lanham Act and must allege an injury proximately caused by Defendants’ alleged illegal conduct. *See id.* at 129-32.

To come within the zone of interest for a false advertising suit under the Lanham Act a plaintiff “must allege an injury to a commercial interest in reputation or sales.” Assessing the facts alleged in the light most favorable to Plaintiff, this requirement has been met. Plaintiff alleges that Defendants’ “false statements” contained in advertising for the Episode have harmed her reputation, thereby diminishing the “desirability of Dickinson’s appearance on other media projects, and her \$75,000 appearance fee value.” *See* Opp’n at 21; TAC ¶ 152.

A plaintiff suing under § 1125(a) typically must show “economic or reputational injury flowing directly from the deception wrought by the Defendants’ advertising.” Plaintiff’s alleges that the “false narrative” perpetuated by Defendants in the Episode deceived consumers into believing that Plaintiff is unprofessional, and thus diminished the value of her celebrity brand. *See* TAC ¶ 152(c)-(f). Whether Plaintiff’s allegations meet this standard is a closer call. Plaintiff seems to argue that the advertising for the Episode and Series perpetuated the “false narrative” that the Series portrays a “true story,” and thus consumers to believe that the allegedly scripted scenes portraying her in an unprofessional light were in fact representative of Plaintiff’s true character. *Id.* ¶ 148. But Plaintiff fails to allege facts showing that any of the alleged false advertisements, rather than the content of the episode itself, were *themselves* the cause of her reputational injury. *Id.* ¶ 152 (a)-(f). In the TAC Plaintiff alleges that she “has been or is likely to be injured as a result of the false advertising.” *Id.* ¶ 152. However, all of the

facts Plaintiff alleges to support this legal conclusion relate to the content of the Episode itself, not the advertising for the episode. Therefore, the Court finds that Plaintiff has not alleged that false advertising by Defendants was the proximate cause of her injury. *See Lexmark*, 522 U.S. at 132-34. As such, the Court would find that Plaintiff has not alleged facts to allow statutory standing for a false advertising claim under the Lanham Act. However, it is possible that Plaintiff could assert factual allegations to remedy this deficiency, so the Court will consider the other arguments Defendants' assert in their MTD related to Plaintiff's second claim for relief.

2. Commercial Speech

False advertising is only actionable under the Lanham Act's False Advertising provisions where plaintiffs allege false or misleading representations in "commercial advertising or promotion."³ 15 U.S.C. § 1125(a)(1)(B). Speech is generally considered "commercial" when it "does no more than propose a commercial transaction." *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1184 (9th Cir. 2001) (quoting *Bolger v. Youngs Drug Prod's Corp.*, 463 U.S. 60, 66 (1983)). Plaintiff argues that advertisements for the Episode constitute commercial speech based on the Supreme Court's guidance in *Bolger* because the alleged speech: (1) is an advertisement; (2) makes reference to a specific product, and (3) Bravo TV has

³ As noted in *Lexmark*, 522 U.S. at 122: "Section 1125(a) thus creates two distinct bases of liability: false association, § 1125(a)(1)(A), and false advertising, § 1125(a)(1)(B)."

an economic motivation for the communication. *See Opp'n at 18.*

In *Bolger*, the court was considering pamphlets advertising contraceptives, which also contained information of public interest, such as discussions of family planning. *See Bolger*, 463 U.S. at 68. The facts of this case are distinguishable. Here, the issue is not that the advertisements contain both promotional and non-promotional speech, it is that the advertisements are promoting expressive works. Plaintiff depends heavily on *Charles v. City of Los Angeles*, 697 F.3d 1146 (9th Cir. 2012) to support her argument that the *Bolger* factors should be dispositive. *See Opp'n at 18-19.* In *Charles*, the Ninth Circuit held that a billboard for E! News containing only images of the hosts and the name of the program, with no other message was commercial speech. *Charles*, 697 F.3d at 1152. The court in *Charles*, however, made clear that its holding, related to regulatory restrictions on billboard advertising and did not extend to private suits over advertisements for expressive works. *See id.* at 1155 ("The principle unifying the exceptions to the commercial speech doctrine for advertisements for protected works is the need to protect advertisers from tort actions that would otherwise threaten the ability of publishers to truthfully promote particular works."). For private actions, such as tort suits, advertisements that are "adjunct" to a protected work are entitled to the same immunity from as the underlying work. *See id.* This exception clearly applies to the alleged false advertisements in this litigation. All of the advertisements that Plaintiff cites to in her complaint

are clips from the Episode itself, a few with very short textual descriptions. *See* TAC at 145(c)-(g). These are clearly adjunct to the protected work, and therefore would be considered non-commercial speech for the purposes of an action under the Lanham Act.

3. Rogers v. Grimaldi Two-Factor Test

Because the Court would find that both the Episode and alleged promotional content are non-commercial expressive works, it will apply the *Rogers* test to determine whether the First Amendment bars Plaintiff's false advertising claim under the Lanham Act. *See generally Rogers*, 875 F.2d 994. As stated in *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 260-61 (9th Cir. 2019):

We use the *Rogers* test to balance the competing interests at stake when a trademark owner claims that an expressive work infringes on its trademark rights. The test construes the Lanham Act to apply to expressive works "only where the public interest in avoiding consumer confusion outweighs the public interest in free expression." [875 F.2d] at 999. "[T]hat balance will normally not support application of the Act, unless the [use of the mark] has no artistic relevance to the underlying work whatsoever, or ... explicitly misleads [consumers] as to the source or the content of the work." *Id.*

Under the *Rogers* test, "[a]n artistic work's use of a trademark that otherwise would violate the Lanham Act is not actionable unless [1] the [use of the mark]

has no artistic relevance to the underlying work whatsoever, or, [2] if it has some artistic relevance, unless [it] explicitly misleads as to the source or the content of the work.” E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc., 547 F.3d 1095, 1099 (9th Cir. 2008) (citation and internal quotation marks omitted). Courts have applied this test to expressive works in cases alleging trademark infringement, false endorsement, and false advertising claims arising under the Lanham Act. *See e.g. Gordon* 909 F.3d 257 (alleging infringement based on the unauthorized use of trademarked catchphrases on greeting cards)⁴; *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1241 (9th Cir. 2013) (applying *Rogers* test to false endorsement claim).

⁴ At the hearing, Plaintiff’s counsel noted that the Circuit in *Gordon* remanded the case back to the district court for a determination on the *Rogers* factors. If that observation was raised to suggest that this Court should conduct further proceedings as to that issue, it is rejected. The present case is very different from *Gordon*. Indeed, as held in *Gordon*:

The *Rogers* test is not an automatic safe harbor for any minimally expressive work that copies someone else’s mark. Although on every prior occasion in which we have applied the test, we have found that it barred an infringement claim as a matter of law, this case presents a triable issue of fact. Defendants have not used Gordon’s mark in the creation of a song, photograph, video game, or television show, but have largely just pasted Gordon’s mark into their greeting cards. A jury could determine that this use of Gordon’s mark is explicitly misleading as to the source or content of the cards.

909 F.3d at 261.

Under the first prong of the *Rogers* test, “only the use of a trademark with ‘no artistic relevance to the underlying work whatsoever’ does not merit First Amendment protection. In other words, the level of relevance merely must be above zero.” *E.S.S.*, 547 F.3d at 1100. “A mark that has no meaning beyond its source-identifying function is more likely to be used in a way that has ‘no artistic relevance to the underlying work whatsoever,’ [citation] because the work may be ‘merely borrow[ing] another’s property to get attention,’ [citation].” *Id.* at 1198 (quoting *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002) and citing *Dr. Seuss Ents., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1401 (9th Cir. 1997)). Courts have held that the use of a celebrity’s name and/or likeness was artistically relevant to expressive works that included that celebrity’s name, image, and/or likeness. *See Brown*, 724 F.3d at 1243-45, 1248 (holding that “the likeness of a great NFL player is artistically relevant to a video game that aims to recreate NFL games.”); *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 937 (6th Cir. 2003) (holding that “the presence of [Tiger] Woods’s image in [a golf painting] does have artistic relevance to the underlying work.”).

The Court would find that the inclusion of Plaintiff’s likeness, image, and name in the Episode, and concomitant promotional materials, even if included without her consent, bore artistic relevance above zero. From the Court’s review of the Episode, part of the Episode focused on the Los Angeles Fashion Show, and a significant sub-plot included the narrative that Plaintiff stole the romper earmarked for

Gharachedaghi. *See generally* Hwang Decl. Ex. 1 (the Episode). Because of Plaintiff's role in that narrative, false or not, the use of Plaintiff's name and likeness are artistically relevant to the Episode. In addition, the Opposition does not seem to meaningfully dispute artistic relevance. *See generally* Opp'n. Therefore, the Court would find that Plaintiff does not overcome the first prong of the *Rogers* test.

Plaintiff's complaint appears to focus on the second prong of the *Rogers* test, alleging in particular, that the advertising for the Series and the Episode mislead as to content. *See generally id.* Plaintiff's accusations rest upon two basic assertions. First, Plaintiff alleges that advertising for the series in general is misleading in that it markets the show as a "docuseries" rather than scripted television. *See* TAC ¶ 73-91. A title or advertisement for an expressive work will be misleading as to content when it explicitly deceives consumers as to the content of the underlying work. *See Parks v. LaFace Records*, 329 F.3d 437, 458-459 (6th Cir. 2003) ("Where a title with at least some artistic relevance to the work is not explicitly misleading as to the content of the work, it is not false advertising under the Lanham Act."). Taking Plaintiff's complaint at face value, it is possible that Plaintiff could prove that the advertisements promoting the Series as a "true story" are misleading as to content. Those allegations, however, are not enough to overcome the second prong of the *Rogers* test. The test is not whether any advertisement is misleading, it is whether Defendants' use of Plaintiff's mark misleads consumers as to the source or content of the

work. *Brown*, 724 F.3d at 1239. Plaintiff's mark has no bearing on whether or not Bravo advertises their show as a scripted series or reality television. Therefore, Plaintiff's contention fails.

Plaintiff also alleges that the advertisements for the Episode explicitly mislead as to the content of the Episode itself. Even viewing the facts alleged in the light most favorable to Plaintiff, this argument fails. The advertisements that Plaintiff points to in the TAC are all clips of the Episode itself. A clip of a television episode could not possibly mislead as to the content of the episode, as it is itself a portion of the content. Only two of the alleged advertisements contain any speech other than the actual audio of the Episode (or closed captioning).⁵ The Clip 1 teaser includes the following descriptive statement: "Did Janice Dickinson Just Steal GG's Look?! Evidently she took the outfit GG was supposed to wear on the runway and GG is pissed" TAC ¶103. These are not explicitly misleading statements. First, neither is an equivocal statement. The first is a question, and the second begins with "evidently." Furthermore, both accurately preview the controversy portrayed on the Episode, whether the controversy itself was contrived by Defendants or not. *See generally* Episode. The Clip 2 teaser also contains a short description, saying: "See GG's Carrie Bradshaw Moment on the Runway S6/EP3: Luckily she recovered from nearly tripping. (Did we mention Janice Dickinson makes an appearance?)." TAC ¶105.

⁵ The Court does not consider YouTube videos or new publications related to the Episode to be actionable advertising on the part of Defendants who did not post such materials.

This is also not a misleading statement. Plaintiff does not deny that she appeared in the Episode. *See generally id.* Therefore, the Court would find that Plaintiff has not alleged any facts which could overcome prong two of the *Rogers* test.

Based upon the above analysis, the Court would dismiss Plaintiff's federal trademark/ Lanham Act causes of action with prejudice. Plaintiff has alleged the facts related to the Series, the Episode, and its promotional materials in great detail in the TAC, and accepting those allegations as true, they establish that the Episode and concomitant advertisements come within the scope of First Amendment protection. At the hearing, Plaintiff was allowed to address if she could overcome that protection to state a viable federal claim under 15 U.S.C. § 1125(a)(1)(B) but failed to do so.

C. Third Claim for Relief - Dilution in Violation of 15 U.S.C. § 1125(c) Against All Defendants

In the third cause of action Plaintiff alleges a claim for dilution in violation of 15 U.S.C. § 1125(c) against all Defendants. *See* TAC ¶ 172-194. Defendants move to dismiss this claim. *See* MTD at 2. Defendants argue that Plaintiff's claim fails for three reasons. To start, Defendants allege that Plaintiff's third claim fails because it involves non-commercial speech and is barred by *Rogers* two-factor test. The Federal Trademark Dilution Act does not provide a remedy for "noncommercial use of a mark." 15 U.S.C. §

1125(c)(3)(C). As discussed at length in the Court's analysis of Plaintiff's second claim for relief, the Court would find that the Episode and adjunct advertisements are not commercial speech. Furthermore, the Court's *Rogers* test analysis related to Plaintiff's 15 U.S.C. § 1125(a)(1) claims is equally applicable here. Therefore, the Court would also find that Plaintiff has not stated facts to overcome the *Rogers* test in relation to their third claim for relief.

Defendants also argue that Plaintiff's claims for trademark dilution are barred by the nominative fair use doctrine. *See id.* at 14-16. Plaintiff responds that a determination as to nominative fair use is fact intensive and cannot be resolved at this stage. The Court would decline to rule on Defendants' nominative fair use defense, given that Plaintiff's dilution claim fails to sufficiently plead the cause of action on other grounds.

At the hearing, Plaintiff was allowed to argue on the issue and the Court is not persuaded that its ruling should be changed.

D. Fourth Claim for Relief - Violation of Cal. Business & Professions Code §§ 17200, et. seq., Against All Defendants

Because the Court dismisses all of Plaintiff's federal claims with prejudice, it would decline to exercise supplemental jurisdiction over Plaintiff's fourth claim for relief under California's unfair competition

law.⁶ See *United Mine Workers of Am. v. Gibbs*, 383 U.S. 715, 726 (1996) (“Certainly, if the federal claims are dismissed before trial, even though not insubstantial in a jurisdictional sense, the state claims should be dismissed as well.). As such, the Court would dismiss claims four through nine without prejudice.

IV. Conclusion

For the foregoing reasons, the Court would **DISMISS** the first three federal causes of action contained in the TAC without leave to amend; and it would decline to exercise supplemental jurisdiction over the remaining state claims and dismiss them without prejudice.

⁶ The court would also decline to exercise supplemental jurisdiction over the state law claims alleged as the fifth, sixth, seventh, eighth and ninth causes of action in the TAC, but not addressed in the MTD.