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**UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA**

BYRON BELIN, an individual,

Plaintiff,

v.

STARZ ENTERTAINMENT, LLC, a  
Colorado limited liability company;  
LIONS GATE ENTERTAINMENT  
INC., a Delaware corporation; CURTIS  
J. JACKSON III a/k/a 50 CENT, an  
individual; G-UNIT BRANDS, INC., a  
New York corporation; and G-UNIT  
FILM & TELEVISION, INC., a New  
York corporation,

Defendants.

Case No.: CV 21-09586-FWS-PLA

**ORDER GRANTING DEFENDANTS'  
MOTION TO DISMISS PLAINTIFF'S  
COMPLAINT [30]**

1 Before the court is Defendants Starz Entertainment, LLC (“Starz”), Lions Gate  
2 Entertainment, Inc. (“Lions Gate”), Curtis J. Jackson III, a/k/a 50 Cent (“Mr.  
3 Jackson”), G-Unit Brands, Inc. (“G-Unit Brands”), and G-Unit Film & Television,  
4 Inc.’s (“G-Unit Film”) (collectively, “Defendants”) Motion to Dismiss Plaintiff Byron  
5 Belin’s (“Plaintiff” or “Mr. Belin”) Complaint (Dkt. 30) (“Motion” or “Mot.”).  
6 Plaintiff’s Complaint (Dkt. 1) (“Complaint” or “Compl.”) asserts common state and  
7 federal law trademark claims, in addition to claims under the Lanham Act, against  
8 Defendants based on allegations that Defendants are using Plaintiff’s registered  
9 trademark “BMF” (“BMF Mark”) in the title of Defendants’ television series, “BMF:  
10 Black Mafia Family” (“Series”) without Plaintiff’s authorization or consent.

11 The court finds this matter appropriate for resolution without oral argument.  
12 *See* Fed. R. Civ. P. 78(b) (“By rule or order, the court may provide for submitting and  
13 determining motions on briefs, without oral hearings.”); L.R. 7-15 (authorizing courts  
14 to “dispense with oral argument on any motion except where an oral hearing is  
15 required by statute”). Based on the state of the record, as applied to the applicable  
16 law, the court **GRANTS** the Motion and **DISMISSES WITHOUT PREJUDICE**  
17 **AND WITH LEAVE TO AMEND** the Complaint.

## 18 **I. Background**

### 19 **A. Summary of Allegations**

20 Plaintiff and his business partner are “engaged in a variety of entertainment  
21 media services including, but not limited to, the production of fiction and non-fiction  
22 television programming.” (Compl. ¶ 9.) Plaintiff is the registered owner of the BMF  
23 Mark and “has marketed and sold services using” the BMF Mark “continuously since  
24 at least 2017, using platforms such as Facebook and YouTube, as well as other forms  
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1 of media.”<sup>1</sup> (*Id.* ¶¶ 10, 12 & Exh. A.) Plaintiff alleges he “has expended considerable  
2 effort promoting and establishing name recognition” for the BMF Mark. (*Id.* ¶ 11.)

3 Plaintiff first “became aware” that Defendants intended to produce the Series, a  
4 television show “based on the story of [the] drug-trafficking organization, Black  
5 Mafia Family,” in or around April 2020. (*Id.* ¶ 14; Mot. at 1 & Exh. A.) After  
6 Plaintiff sent Defendant Starz a letter in April 2020 offering to negotiate a license for  
7 the use of the BMF Mark, (*id.* ¶¶ 14-15,) Plaintiff alleges Defendant Starz “ceased  
8 using” the BMF Mark “when promoting the Series on social media,” (*id.* ¶ 17).  
9 However, Plaintiff alleges he “became aware” around in or around April 2021 that  
10 Defendant Starz had “resumed” promoting the Series using the BMF Mark “on social  
11 media.” (*Id.*)

12 The Series premiered on September 9, 2021, on Defendants Starz’s and Lion  
13 Gate’s media platforms. (*Id.* ¶ 19.) Plaintiff alleges that Defendants Lions Gate,  
14 Starz, G-Unit Films, and Mr. Jackson use the BMF Mark “in connection with the  
15 marketing and distribution of the Series,” (*id.* ¶ 19,) and Defendant G-Unit Brands  
16 “has sold and is selling merchandise featuring” the BMF Mark, (*id.* ¶ 20). Plaintiff  
17 has not “authoriz[ed] or consent[ed]” to Defendants’ use of the BMF Mark, (*id.* ¶ 14,)  
18 and alleges that Defendants’ actions were “intentional” and “willful,” (*id.* ¶¶ 30, 42,  
19 49, 57, 66).

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23 <sup>1</sup> The BMF Mark covers, among other categories of use, “[e]ntertainment media  
24 production services for motion pictures, television and Internet . . . ; entertainment  
25 services in the nature of organizing social entertainment events . . . ; entertainment  
26 services in the nature of presenting live musical performances . . . ; [and]  
27 entertainment services in the nature of fiction and non-fiction television programming  
28 series on topics relating to family stories, drug empires, gangs, organizing social  
entertainment, multimedia content, and day to day activities of self, friends, and  
family . . . .” (Compl., Exh. A.)

1           **B.           Procedural History**

2           Plaintiff filed the Complaint on December 10, 2021, bringing claims against  
3 Defendants under the Lanham Act for (1) trademark infringement; and (2) unfair  
4 competition and false designation of origin. (*See generally* Compl. ¶¶ 24-45.) The  
5 Complaint also includes claims against Defendants under federal and California state  
6 common law for: (1) contributory trademark infringement; (2) vicarious trademark  
7 infringement; and (3) trademark counterfeiting and false advertising. (*See generally*  
8 *id.* ¶¶ 46-68.) Defendants filed the Motion pursuant to Federal Rule of Civil  
9 Procedure 12(b)(6) (“Rule 12(b)(6)”) on February 17, 2022, arguing that each of  
10 Plaintiff’s claims is barred by the First Amendment under the test first articulated by  
11 the Second Circuit in *Rogers v. Grimaldi*, 875 F.2d 994 (2d. Cir. 1989) and adopted  
12 by the Ninth Circuit in *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir.  
13 2002) (“*Rogers test*”). (Dkt. 30.) Defendants also request the court consider several  
14 exhibits attached to the Motion under the incorporation by reference doctrine and/or  
15 judicial notice. (*Id.*) Plaintiff filed an Opposition to the Motion (Dkt. 34)  
16 (“Opposition” or “Opp.”) and attached Objections to Defendants’ requests for judicial  
17 notice (Dkt. 34-1) on March 12, 2022.<sup>2</sup> Defendants filed a Reply (Dkt. 35) on March  
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19           <sup>2</sup> Plaintiff objected to Defendants’ requests for judicial notice in a filing attached to  
20 the Opposition (Dkt. 34-1.) Plaintiff also filed a similar set of “Objections” after  
21 briefing in this matter had concluded and the Motion was first taken under  
22 submission, asserting that Defendants incorrectly submitted evidence attached to their  
23 Reply. (*See* Dkt. 37.) Though Plaintiff is theoretically correct that the court need not  
24 consider arguments raised for the first time in a Reply, *Zamani v. Carnes*, 491 F.3d  
25 990, 997 (9th Cir. 2007), Defendants did not submit new evidence or raise novel  
26 arguments as to judicial notice or incorporation by reference in the Reply, see  
27 *Markson v. CRST Int’l, Inc.*, 2022 WL 790960, at \*1 n.1 (C.D. Cal. Feb. 24, 2022)  
28 (noting evidence “submitted with a reply brief is not new evidence when it is  
submitted to rebut arguments raised in the opposition brief”) (citation and internal  
quotation marks omitted). Additionally, the court need not consider arguments raised  
in sur-replies filed without first seeking leave of court. *See Baxter Bailey & Assocs. v.*

1 18, 2022. Plaintiff has not previously filed an amended complaint in this action nor  
2 sought leave from the court to do so.

## 3 **II. Legal Standard**

### 4 **A. Motion to Dismiss Pursuant to Rule 12(b)(6)**

5 Rule 12(b)(6) permits a defendant to move to dismiss a complaint for “failure to  
6 state a claim upon which relief can be granted.” Fed. R. Civ. P. 12(b)(6). To  
7 withstand a motion to dismiss brought under Rule 12(b)(6), a complaint must allege  
8 “enough facts to state a claim to relief that is plausible on its face.” *Bell Atl. Corp. v.*  
9 *Twombly*, 550 U.S. 544, 570 (2007). While “a complaint attacked by a Rule 12(b)(6)  
10 motion to dismiss does not need detailed factual allegations,” a plaintiff must provide  
11 “more than labels and conclusions” and “a formulaic recitation of the elements of a  
12 cause of action” such that the factual allegations “raise a right to relief above the  
13 speculative level.” *Id.* at 555 (citations and internal quotation marks omitted); *see*  
14 *also Aschroft v. Iqbal*, 556 U.S. 662, 679 (2009) (reiterating that “recitals of the  
15 elements of a cause of action, supported by mere conclusory statements, do not  
16 suffice”).

17 “Establishing the plausibility of a complaint’s allegations is a two-step process  
18 that is ‘context-specific’ and ‘requires the reviewing court to draw on its judicial  
19 experience and common sense.’” *Eclectic Props. E., LLC v. Marcus & Millichap Co.*,  
20 751 F.3d 990, 995-96 (9th Cir. 2014) (quoting *Iqbal*, 556 U.S. at 679). “First, to be  
21 entitled to the presumption of truth, allegations in a complaint . . . must contain  
22 sufficient allegations of underlying facts to give fair notice and to enable the opposing  
23 party to defend itself effectively.” *Id.* at 996 (quoting *Starr v. Baca*, 652 F.3d 1202,

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*Ready Pac Foods, Inc.*, 2020 WL 3107889, at \*1 (C.D. Cal. Feb. 14, 2020) (“When a  
reply does not present new arguments nor new evidence, a surreply is improper and a  
court should not grant leave to file one.”) (citation and internal quotation marks  
omitted); *see also* L.R. 7-10 (“Absent prior written order of the Court, the opposing  
party shall not file a response to the reply.”).

1 1216 (9th Cir. 2011)). “Second, the factual allegations that are taken as true must  
2 plausibly suggest an entitlement to relief, such that it is not unfair to require the  
3 opposing party to be subjected to the expense of discovery and continued litigation.”  
4 *Id.* (quoting *Baca*, 652 F.3d at 1216); *see also Iqbal*, 556 U.S. at 681. But “[w]here a  
5 complaint pleads facts that are merely consistent with a defendant’s liability, it stops  
6 short of the line between possibility and plausibility of entitlement to relief.” *Id.*  
7 (quoting *Iqbal*, 556 at U.S. 678).

### 8 **III. DISCUSSION**

#### 9 **A. Judicial Notice and Incorporation by Reference**

##### 10 1. Legal Standards

11 The court may take judicial notice of facts that are either “generally known  
12 within the trial court’s territorial jurisdiction” or “can be accurately and readily  
13 determined from sources whose accuracy cannot reasonably be questioned.” Fed. R.  
14 Civ. P. 201(b). Courts cannot take judicial notice of facts subject to reasonable  
15 dispute. *Lee v. City of Los Angeles*, 250 F.3d 668, 689 (9th Cir. 2001), *overruled on*  
16 *other grounds by Galbraith v. Cty. of Santa Clara*, 307 F.3d 1119 (9th Cir. 2002); *see*  
17 *also Twombly*, 550 U.S. at 555 n.11 (“Under Federal Rule of Evidence 201(b), a  
18 judicially noticed fact must be one not subject to reasonable dispute in that it is either  
19 (1) generally known within the territorial jurisdiction of the trial court or (2) capable  
20 of accurate and ready determination by resort to sources whose accuracy cannot  
21 reasonably be questioned.”) (internal quotation marks omitted).

22 For example, “courts routinely take judicial notice of letters published by the  
23 government . . . as well as records and reports of administrative bodies.” *Smith v. Los*  
24 *Angeles Unified Sch. Dist.*, 830 F.3d 843, 851 n.10 (9th Cir. 2016) (citations and  
25 internal quotation marks omitted). Additionally, courts “may consider material which  
26 is properly submitted as part of the complaint on a motion to dismiss without  
27 converting the motion to dismiss into a motion for summary judgment,” if the material  
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1 is “physically attached to the complaint.” *Lee*, 250 F.3d at 688 (citations and internal  
2 quotation marks omitted).

3 The “incorporation by reference” doctrine permits courts to “take into account  
4 documents ‘whose contents are alleged in a complaint and whose authenticity no party  
5 questions, but which are not physically attached to the [plaintiff’s] pleading.’”  
6 *Knievel v. ESPN*, 393 F.3d 1068, 1076 (9th Cir. 2005) (citation omitted) (alteration in  
7 original); *see also Lee*, 250 F.3d at 688. Application of the incorporation by reference  
8 doctrine may be appropriate in “situations in which the plaintiff’s claim depends on  
9 the contents of a document, the defendant attaches the document to its motion to  
10 dismiss, and the parties do not dispute the authenticity of the document, even though  
11 the plaintiff does not explicitly allege the contents of that document in the complaint.”  
12 *Knievel*, 393 F.3d at 1076.

## 13 2. Application

14 Defendants request the court incorporate by reference and/or take judicial  
15 notice of several exhibits attached to the Motion: (1) two promotional photographs  
16 from the Series (Dkt. 30-1, Declaration of Kevin M. Bell (“Bell Decl.”), Exh. A); (2) a  
17 photograph from the Wikipedia article, “Black Mafia Family” and an article from The  
18 Detroit News, “Black Mafia Family leader ‘Big Meech’ gets prison break in Detroit  
19 drug case” (Bell Decl., Exh. B); (3) a Petition for Cancellation of the BMF Mark filed  
20 before the U.S. Patent and Trademark Office’s Trademark Trial and Appeal Board by  
21 a nonparty to this litigation (Bell Decl., Exh. C.); and (4) five pieces of  
22 correspondence between Plaintiff and Defendants (Bell Decl., Exhs. D-H). Plaintiff  
23 objects to the court considering each of these materials. (Opp. 19-21; Dkt. 34-1.)<sup>3</sup>

24 Defendants contend Exhibit A should be incorporated by reference because the  
25 Complaint omits “Defendants’ actual alleged use, and the context for” the Series, as  
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27 <sup>3</sup> Page numbers for the Opposition correspond to the pagination of the PDF document  
28 as filed with the court.

1 well as “evidence of Defendants’ actual promotion of the [S]eries and the context for  
2 the logo depicted.” (Mot. at 8.) The crux of Plaintiff’s claims concern Defendants’  
3 allegedly infringing use of the BMF Mark; Exhibit A is promotional artwork for the  
4 Series and offered as an example of Defendants’ use of the BMF Mark. Accordingly,  
5 the court will consider Exhibit A under the incorporation by reference doctrine  
6 because Plaintiff’s claims depend on Defendants’ use of the BMF Mark. *See Knieval*,  
7 1076-77 (9th Cir. 2005) (incorporating by reference the web pages “surrounding” the  
8 “photograph and caption that [plaintiffs] argue[d] was defamatory”); *accord Khoja v.*  
9 *Orexigen Therapeutics, Inc.*, 899 F.3d 988, 1002 (9th Cir. 2018).

10 Defendants request the court consider Exhibit B, an “article discussing the  
11 history of the Black Mafia Family and the Wikipedia photo for the real-life family  
12 showing historical use of ‘BMF’ as a logo,” (Mot. at 8,) for “the same reason,” e.g.,  
13 incorporation by reference, (Reply at 12). Though the subject matter of the Series  
14 may potentially be related to Exhibit B, the arguments presented by the parties are  
15 limited to Defendants’ use of the BMF Mark and whether that use is misleading as to  
16 Plaintiff under the *Rogers* test. The Complaint only briefly mentions the Series is  
17 “based on the story of drug-trafficking organization,” which is not enough for the  
18 court to consider Exhibit B under the incorporation by reference doctrine. *See Khoja*,  
19 899 F.3d at 1002 (noting incorporation by reference is appropriate where “the  
20 plaintiff refers extensively to the document or the document forms the basis of the  
21 plaintiff’s claim.”) (quoting *U.S. v. Ritchie*, 342 F.3d 903, 907 (9th Cir. 2003)); *Coto*  
22 *Settlement v. Eisenberg*, 593 F.3d 1031, 1038 (9th Cir. 2010) (citation omitted)  
23 (“[T]he mere mention of the existence of a document is insufficient to incorporate the  
24 contents of a document.”).

25 It is not clear to the court the permissible purpose for which Defendants seek  
26 judicial notice of Exhibit C, the Petition for Cancellation. A court may take judicial  
27 notice of administrative records, including petitions filed in the U.S. Patent and  
28 Trademark Office. *See Caiz v. Roberts*, 382 F. Supp. 3d 942, 947 (C.D. Cal. 2019)



1 (taking judicial notice of “file history” filed in the U.S. Patent and Trademark Office).  
2 However, Exhibit C is not sufficiently relevant to the arguments at issue in the  
3 Motion, which focus only on the application of the *Rogers* test. Accordingly, the  
4 court declines to take judicial notice of Exhibit C. *See Gerritsen v. Warner Bros. Ent.*  
5 *Inc.*, 112 F. Supp. 3d 1011, 1026, 1029-30 (C.D. Cal. 2015) (declining to take judicial  
6 notice of documents irrelevant to motion to dismiss).

7 Exhibits D-H are printouts of pre-suit correspondence, which Defendants argue  
8 should be considered by the court because “the Complaint includes specific reference  
9 to the parties’ pre-suit correspondence.” (Mot. at 8.) The correspondence does not  
10 relate to the basis of Plaintiff’s claims—that Defendants’ use of the BMF Mark  
11 violates Plaintiff’s trademark rights—and thus the Complaint does not “depend” on  
12 the correspondence sufficiently to warrant their incorporation by reference. *See*  
13 *Khoja*, 899 F.3d at 1002; *Coto Settlement*, 593 F.3d at 1038.

#### 14 **B. First Amendment (*Rogers* Test)**

15 Defendants argue that each of Plaintiff’s claims are barred by the First  
16 Amendment, under the *Rogers* test set forth in *Rogers*, 875 F.2d 994 and first  
17 employed by the Ninth Circuit in *MCA Records*, 296 F.3d 894. While claims of  
18 trademark infringement under the Lanham Act are generally governed by a likelihood-  
19 of-confusion test, courts in the Ninth Circuit apply the *Rogers* test when the alleged  
20 infringement concerns an expressive work to accommodate First Amendment  
21 interests. *See MCA Records*, 296 F.3d at 900, 902. To balance the public’s interest in  
22 avoiding consumer confusion with First Amendment protections of free expression,  
23 courts “apply the [Lanham] Act to an expressive work only if the defendant’s use of  
24 the mark (1) is not artistically relevant to the work or (2) explicitly misleads  
25 consumers as to the source or the content of the work.” *Gordon v. Drape Creative,*  
26 *Inc.*, 909 F.3d 257, 264 (9th Cir. 2018) (citing *MCA Records*, 296 F.3d at 902).

27 “The *Rogers* test requires the defendant to make a threshold legal showing that  
28 its allegedly infringing use is part of an expressive work protected by the First

1 Amendment.” *Id.* The burden then shifts to the plaintiff to show “(1) that it has a  
2 valid, protectable trademark, and (2) that the mark is either not artistically relevant to  
3 the underlying work or explicitly misleading as to the source or content of the work.”  
4 *Id.* at 265. “If the plaintiff satisfies both elements,” the plaintiff “must still prove that  
5 [their] trademark has been infringed by showing that the defendant’s use of the mark  
6 is likely to cause confusion.” *Id.* at 265. The Ninth Circuit has affirmed the  
7 application of the *Rogers* test’s burden-shifting framework at the motion to dismiss  
8 stage. See *Betty’s Found. for Elimination of Alzheimers Disease v. Trinity Christian*  
9 *Ctr. of Santa Ana, Inc.*, 2022 WL 807391, at \*1 (9th Cir. Mar. 16, 2022).

10 For the purposes of this motion, the parties do not meaningfully dispute the  
11 validity of Plaintiff’s BMF Mark.<sup>4</sup> Plaintiff has also attached a copy of the  
12 registration for the BMF Mark to the Complaint, (Compl., Exh. A,) which  
13 “constitutes “prima facie evidence”” of the BMF Mark’s validity. *Lodestar Anstalt*  
14 *v. Bacardi & Co. Ltd.*, 31 F.4th 1228, 1236 (9th Cir. 2022) (first quoting *Iancu v.*  
15 *Brunetti*, 139 S.Ct. 2294, 2297 (2019) (quoting 15 U.S.C. § 1115(a))). Plaintiff also  
16 brings several common federal and state law claims, which Defendants argue are  
17 subject to the *Rogers* test; Plaintiff does not dispute this.<sup>5</sup>

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19 <sup>4</sup> Defendants note they “dispute the legitimacy of any alleged rights that Plaintiff  
20 claims in ‘BMF’ as a trademark,” (Mot. at 1,) but do not set forth substantive legal  
21 argument in the Motion to support this contention.

22 <sup>5</sup> As was the case in *Twentieth Century Fox Television v. Empire Distribution, Inc.*,  
23 the court “ha[s] no occasion to address whether the *Rogers* test applies to any state  
24 laws.” 875 F.3d 1192, 1196 n.1 (9th Cir. 2017). As Defendants note, the Ninth  
25 Circuit in *MCA Records* held the district court properly granted summary judgment  
26 where the “likelihood-of-confusion test also govern[ed] [defendant’s] state law claims  
27 of unfair competition.” 296 F.3d 894, 902 n.2. In *E.S.S. Ent. 2000, Inc. v. Rock Star*  
28 *Videos, Inc.*, the Ninth Circuit similarly held that “the First Amendment defense  
applies equally to ESS’s [California] state law claims [of unfair competition and  
trademark infringement] as to its Lanham Act claim.” 547 F.3d 1095, 1100 (9th Cir.  
2008). Finally, the Ninth Circuit in *Dr. Seuss Enters., L.P. v. ComicMix LLC* held

1                   1.     Expressive Work

2                   The parties do not dispute the Series is an expressive work, and the court  
3 agrees. *See Twentieth Century Fox Television v. Empire Distribution, Inc.*, 875 F.3d  
4 1192, 1196 (9th Cir. 2017) (determining a “television show itself is clearly an  
5 expressive work”). Plaintiff argues, however, “the sale of consumer products bearing”  
6 the BMF Mark is a “separate category of infringement” that Defendants have not  
7 adequately shown “should be afforded free speech protection.” (Opp. at 14.) This  
8 argument was rejected by the Ninth Circuit in *Twentieth Century Fox*.<sup>6</sup> *See* 875 F.3d  
9 1196-97 (“Although it is true that these promotional efforts technically fall outside the  
10 title or body of an expressive work, it requires only a minor logical extension of the  
11 reasoning of *Rogers* to hold that works protected under its test may be advertised and  
12 marketed by name.”). As the Ninth Circuit noted, “the *Rogers* case itself concerned  
13 both a movie with an allegedly infringing title and its advertising and promotion” and  
14 “[t]he balance of First Amendment interests struck in *Rogers* and *Mattel [v. MCA*  
15 *Records]* could be destabilized if the titles of expressive works were protected but  
16 could not be used to promote those works.” *Id.* at 1197. Accordingly, the court finds  
17 Defendants have shown the Series and the promotional and marketing materials  
18 related to it, including consumer merchandise, are “expressive works” under the  
19 *Rogers* test. The court now considers whether Defendants’ use of the BMF Mark “is  
20 either not artistically relevant to the underlying work or explicitly misleading as to the  
21 source or content of the work.” *Gordon*, 909 F.3d at 265.

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25 plaintiff’s common law trademark infringement claims failed as a matter of law under  
26 the *Rogers* test. 983 F.3d 443, 461 (9th Cir. 2020), *cert. denied*, 141 S. Ct. 2803  
27 (2021). Considering this authority and because the parties do not separately address  
28 Plaintiff’s common law claims, the court considers all of Plaintiff’s claims together in  
its analysis.

<sup>6</sup> Both parties cite *Twentieth Century Fox* as binding precedent on the court’s determination of what constitutes an expressive work. (Mot. at 10-11; Opp. at 14.)

1                   2.     Artistic Relevance

2                   “As to the first prong, any artistic relevance ‘above zero’ means the Lanham  
3 Act does not apply unless the use of the trademark is explicitly misleading.” *Dr.*  
4 *Seuss Enters., L.P. v. ComicMix LLC*, 983 F.3d 443, 462 (9th Cir. 2020), *cert. denied*,  
5 141 S. Ct. 2803 (2021). “Trademarks that ‘transcend their identifying purpose,’ are  
6 more likely to be used in artistically relevant ways.” *Twentieth Century Fox*, 875 F.3d  
7 at 1198 (quoting *MCA Records*, 296 F.3d at 900). Conversely, “[a] mark that has no  
8 meaning beyond its source-identifying function is more likely to be used in a way that  
9 has ‘no artistic relevance to the underlying work whatsoever’ because the work may  
10 be ‘merely borrow[ing] another’s property to get attention.’” *Id.* (first quoting *MCA*  
11 *Records*, 296 F.3d at 901-02 (quoting *Rogers*, 875 F.2d at 999)).

12                  The Complaint alleges Defendants use the BMF Mark to abbreviate the term  
13 “Black Mafia Family” in the title of the Series, which concerns a drug-trafficking  
14 organization. Although the court refrains from determining the artistic relevance of  
15 the BMF Mark in the Series at this stage, nothing “in [P]laintiff’s allegations []  
16 suggest that the mark, itself, is the centerpiece of the [Series] or that, like the  
17 unadorned use of the ‘Honey Badger’ marks in *Gordon*, [D]efendants used the mark  
18 without adding any artistic expression of their own.” *See Deus ex Machina*  
19 *Motorcycles Pty. Ltd. v. Metro-Goldwyn-Mayer Inc.*, 2020 WL 6875178, at \*7 (C.D.  
20 Cal. Oct. 23, 2020) (citing *Gordon*, 909 F.3d at 270-71). And the Ninth Circuit has  
21 held use similar to the Complaint’s allegations of Defendants’ use is artistically  
22 relevant. *Twentieth Century Fox*, 875 F.3d at 1198 (using word “Empire” in  
23 television show’s title where its “subject matter” was a “conglomerate, ‘Empire  
24 Enterprises’” was “artistically relevant”). Therefore, Defendants’ use of the BMF  
25 Mark must “explicitly mislead[] consumers as to the source or the content” of the  
26 Series for Plaintiff’s claims to remain viable at this stage. *See Gordon*, 909 F.3d at  
27 264.

1                   3.     Explicitly Misleading

2             Even where the use of a trademark is artistically relevant to an expressive work,  
3 the creator of the expressive work can be still be liable for infringement under the  
4 Lanham Act if the creator uses the mark or material to ‘explicitly mislead[]  
5 [consumers] as to the source or the content of the work.’” *Brown v. Elec. Arts, Inc.*,  
6 724 F.3d 1235, 1245 (9th Cir. 2013) (quoting *Rogers*, 875 F.2d at 999) (alteration in  
7 original). “The relevant question, therefore, is whether the [Series] would confuse its  
8 [viewers] into thinking that [Plaintiff] is somehow behind the [Series] or that  
9 [Plaintiff] sponsors [the Series].” *See E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*,  
10 547 F.3d 1095, 1100 (9th Cir. 2008). This prong “is a high bar that requires the use to  
11 be an explicit indication, overt claim, or explicit misstatement about the source of the  
12 work.” *Dr. Seuss Enters.*, 983 F.3d at 462 (citation and internal quotation marks  
13 omitted). And “the mere use of a trademark alone cannot suffice to make such use  
14 explicitly misleading.” *Id.* (citing *MCA Records*, 296 F.3d at 302).

15             Defendants argue that the Series includes no explicit statements or claims  
16 suggesting Plaintiff’s involvement, but notes Defendants use “BMF” as the Series’  
17 “shortened-title.” (See Mot. at 1, 8, 13.) Plaintiff’s allegations are limited to  
18 Defendants’ use of the BMF Mark in the Series and in connection with related  
19 marketing and promotional merchandise. (Compl. ¶¶ 14, 19, 20.) As such, the  
20 Complaint insufficiently alleges an “explicit indication, overt claim, or explicit  
21 misstatement” linking Plaintiff to the Series. *See Davis v. Amazon.com, Inc.*, 2022  
22 WL 2062373, at \*5 (C.D. Cal. Jan. 3, 2022) (finding allegations that defendants’ film  
23 (1) “had the ‘same title’” and “‘thematic elements’” as plaintiff’s book; (2) used font  
24 “‘very similar’” to plaintiff’s book; and (3) was available to watch on the same  
25 website selling plaintiff’s book insufficient to “amount to an ‘explicit indication, overt  
26 claim, or explicit misstatement’ that the source of [defendant’s] [f]ilm was [p]laintiffs’  
27 book”).

1           Where “consumers would expect the use of a mark alone to identify the  
2 source,” *Gordon*, 909 F.3d at 270 (emphasis removed), courts weigh “two ‘more  
3 relevant consideration[s]’ . . . in evaluating whether the mark is explicitly misleading:  
4 (1) ‘the degree to which the junior user uses the mark in the same way as the senior  
5 user’ and (2) ‘the extent to which the junior user has added his or her own expressive  
6 content to the work beyond the mark itself.’” *Dr. Seuss Enters.*, 983 F.3d at 462  
7 (quoting *Gordon*, 909 F.3d at 270-71) (first alteration in original). Even assuming the  
8 factors set forth in *Gordon* apply to this case as Plaintiff argues, (see Opp. at 14-18,)  
9 the Complaint’s allegations do not sufficiently demonstrate that the factors weigh in  
10 favor of Plaintiff. *See Gordon* 909 F.3d at 268 (noting *Gordon* “demonstrate[ed]  
11 *Roger’s* outer limits.”).

12   *i. Degree to Which Defendants Use the BMF Mark in the*  
13   *Same Way as Plaintiff*

14           Where “the senior user and junior user use[] the mark in different ways,” this  
15 “disparate use of the mark [i]s at most ‘only suggestive’ of the product’s source and  
16 therefore d[oes] not outweigh the junior user’s First Amendment interests.” *Gordon*,  
17 909 F.3d at 270. But “identical usage could reflect the type of ‘explicitly misleading  
18 description’ of source that *Rogers* condemns.” *Id.* (quoting *Rogers*, 875 F.2d at 999-  
19 1000).

20           Plaintiff argues that “Plaintiff’s protectible BMF [M]ark is not only similar, but  
21 identical, to the ‘BMF’ acronym used by Defendants as the shortened title of their []  
22 Series” and “the Complaint plainly alleges a highly similar use of ‘BMF’ to that  
23 claimed by Defendants.” (Opp. at 16.) The allegations in the Complaint that concern  
24 Plaintiff’s use of the BMF Mark in commerce are that Plaintiff has “marketed and sold  
25 services using the trademark ‘BMF’” and “expended considerable effort promoting  
26 and establishing name recognition for his ‘BMF’ trademark.” (*See Compl.* ¶¶ 10-11.)  
27 Even if Defendants’ use of the BMF Mark is similar to the uses for which Plaintiff’s  
28 trademark is registered, as alleged in the Complaint, Plaintiff does not plausibly allege

1 that Defendants are *using* the BMF Mark in an explicitly misleading manner. *See Dr.*  
2 *Seuss Enters.*, 983 F.3d at 463 (holding “alleged use of Seuss’s trademarks [wa]s not  
3 explicitly misleading” even though defendant “ha[d] used the marks in an illustrated  
4 book just as Seuss did” where there was no indication of Seuss’s association with  
5 defendant’s work and defendant added its own expressive content to the work beyond  
6 the mark itself); *see also Caiz*, 382 F. Supp. 3d at 950-51 (rejecting the “legal  
7 argument” that defendants’ use of plaintiff’s mark registered for “the exact same  
8 goods and services for which [d]efendants use the mark” was explicitly misleading  
9 because “even where the mark [wa]s used, it [wa]s through [defendant’s] own artistic  
10 expression” and the associated “marketing” of the product using plaintiff’s mark  
11 “attache[d]” to defendant’s “persona and history”).

12 Plaintiff argues a footnote from *Rogers*,<sup>7</sup> which stated the test’s “limiting  
13 construction would not apply to ‘misleading titles that are confusingly similar to other  
14 titles’” supports finding Defendants’ use is explicitly misleading. (Opp. at 15-18  
15 (citing *Gordon*, 909 F.3d at 270 (quoting *Rogers*, 875 F.2d at 999 n.5)).) But the  
16 Complaint does not allege Plaintiff uses the BMF Mark as a title in any of his works,  
17 and the court cannot infer the Series uses the mark in an “explicitly misleading”  
18 manner based on the Complaint’s conclusory allegations that Plaintiff is “engaged in a  
19  
20

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21 <sup>7</sup> Though this footnote is referenced in *Gordon*, the Ninth Circuit has questioned its  
22 application. *See Twentieth Century Fox*, 875 F.3d at 1197 (“The exception the  
23 footnote suggests may be ill-advised or unnecessary: identifying ‘misleading titles that  
24 are confusingly similar to other titles’ has the potential to duplicate either the  
25 likelihood-of-confusion test or the second prong of *Rogers*, which asks whether a title  
26 ‘explicitly misleads as to the source or the content of the work.’”) (citation omitted).  
27 Indeed, the Ninth Circuit in *Gordon* described this footnote as “noting that  
28 ‘misleading titles that are confusingly similar to *other titles*’ can be explicitly  
misleading, regardless of artistic relevance,” not that such instances *will be* by default.  
*Gordon*, 909 F.3d at 270 (quoting *Rogers*, 875 F.2d at 999 n.5) (second emphasis  
added).

1 variety of entertainment media services” and has “marketed” and “sold services  
2 using” the BMF Mark.

3 For the same reason, *Rebellion, LLC v. Perez*, in which the court held the title  
4 of singer Pitbull’s record, “Pitbull Starring in Rebellion” was misleading as to the  
5 band Rebellion’s trademarked name, is inapposite. 732 F. Supp. 2d 883, 888 (N.D.  
6 Cal. 2010). In *Perez*, the court held the *Rogers* test was “inapplicable” where “neither  
7 the word [‘rebellion’] nor the mark” had “taken on an expressive meaning apart from  
8 its source-identifying function,” *id.* (citing *MCA Records*, 296 F.3d at 900), and  
9 alternatively held defendants failed to show “they used plaintiff’s mark to refer to the  
10 meaning associated with plaintiff’s mark,” *id.* at 889.<sup>8</sup> By contrast, the BMF Mark in  
11 the Series is used in the title of the Series as an acronym for the “Black Mafia  
12 Family,” its subject. Regardless of the similarities between Defendants’ use of the  
13 BMF Mark and Plaintiff’s registration of it, the court finds the Complaint does not  
14 sufficiently and plausibly allege the ways in which Plaintiff uses the BMF Mark to  
15 demonstrate Defendants’ use is explicitly misleading.

16 *ii. Extent to Which Defendants have Added Their own*  
17 *Expressive Content to the Series Beyond the BMF Mark*  
18 *Itself*

19 In considering whether a junior user has added their own expressive content  
20 beyond a trademark itself, “the concern that consumers will not be ‘misled as to the  
21 source of [a] product’ is generally allayed when the mark is used as only one  
22

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23 <sup>8</sup> Even if *Perez* were applicable here, courts in the Ninth Circuit have expressed doubt  
24 as to its soundness. *See, e.g., VIRAG, S.R.L. v. Sony Computer Ent. Am. LLC*, 2015  
25 WL 5000102, at \*9 (N.D. Cal. Aug. 21, 2015) (“[T]he *Rogers* test applies to cultural  
26 icons—such as the Barbie doll at issue in *MCA Records*—but is not limited to  
27 them.”), *aff’d*, 699 F. App’x 667 (9th Cir. 2017); *Twentieth Century Fox Television v.*  
28 *Empire Dist. Inc.*, 161 F. Supp. 3d 902, 907 (C.D. Cal. 2016) (“[T]he [*Perez*] court  
has been criticized for misapplying the *Rogers* test.”), *aff’d sub nom. Twentieth*  
*Century Fox Television v. Empire Dist., Inc.*, 875 F.3d 1192 (9th Cir. 2017).



1 component of a junior user’s larger expressive creation, such that the use of the mark  
2 at most ‘implicitly suggest[s]’ that the product is associated with the mark’s owner.”  
3 *Gordon*, 909 F.3d at 270-71 (alteration in original). “But using a mark as the  
4 centerpiece of an expressive work itself, unadorned with any artistic contribution by  
5 the junior user, may reflect nothing more than an effort to ‘induce the sale of goods or  
6 services’ by confusion or ‘lessen[] the distinctiveness and thus the commercial value  
7 of’ a competitor’s mark.” *Id.* at 271 (quoting *S.F. Arts & Athletics, Inc. v. U.S.*  
8 *Olympic Comm.*, 483 U.S. 522, 539 (1987)) (alteration in original).

9 Plaintiff argues that “Defendants fail to articulate how their glossy production  
10 of the [] Series using” the BMF Mark “as the title has added expressive content  
11 beyond the BMF [M]ark itself.” (Opp. at 17 (emphasis removed).) The court  
12 disagrees. Plaintiff does not contest that Defendants’ use of the BMF Mark as part of  
13 the title of the Series, which is more broadly about “the dramatiz[ation] and  
14 recount[ing] [of] the story of the Black Mafia Family and those involved.” (Mot. at  
15 15; *See* Opp. at 17.) Based on this and considering the court’s analysis above,  
16 Defendants have added their own expressive content to the Series beyond using the  
17 BMF Mark in its title. *See Betty’s Found. for Elimination of Alzheimer’s Disease v.*  
18 *Trinity Christian Ctr. of Santa Ana, Inc.*, 2021 WL 3046889, at \*4 (C.D. Cal. Apr. 7,  
19 2021), *aff’d*, 2022 WL 807391 (9th Cir. Mar. 16, 2022) (“The Ninth Circuit stated in  
20 *Gordon* that when a mark is used as “the title of an expressive work—such as the title  
21 of a movie, a song, a photograph, or a television show—the mark obviously serve[s]  
22 as only one element of the [work] and the [junior user’s] artistic expressions.”)  
23 (quoting *Gordon*, 909 F.3d at 271) (alterations in original); *Deus ex Machina*, 2020  
24 WL 6875178, at \*6 (finding “defendants have added their own expressive content to  
25 the [movie] beyond the mark itself” where the “mark play[ed] only a part in [the]  
26 movie”).

27 Based on the plausibly pleaded allegations in the Complaint, Plaintiff  
28 essentially asks the court to find Defendants use the BMF Mark in the Series’ title

1 defeats the application of the *Rogers* test. That conception seems to defeat the  
2 purpose of the *Rogers* test itself. See *Dickinson v. Ryan Seacrest Enters. Inc.*, 839 F.  
3 App’x 110, 111 (9th Cir. 2020), cert. denied sub nom. *Dickinson v. Ryan Seacrest*  
4 *Prods., Inc.*, 141 S. Ct. 2861 (2021) (“To succeed under the *Rogers* test, the ‘creator’s  
5 use of the mark [must be] explicitly misleading as to *source or content.*”) (quoting  
6 *Gordon*, 909 F.3d at 269) (alteration in original).

7 **C. Leave to Amend**

8 “A party may amend its pleading once as a matter of course within: [(1)] 21  
9 days after serving it, or [(2)] if the pleading is one to which a responsive pleading is  
10 required, 21 days after service of a responsive pleading or 21 days after service of a  
11 motion under Rule 12(b), (e), or (f), whichever is earlier.” Fed. R. Civ. P. 15(a)(1).  
12 “In all other cases,” pleadings may only be amended with the opposing party’s written  
13 consent or the court’s leave, the latter of which is “freely give[n] when justice so  
14 requires.” Fed. R. Civ. P. 15(a)(2). “In assessing whether leave to amend is proper,  
15 courts consider the presence or absence of undue delay, bad faith, dilatory motive,  
16 repeated failure to cure deficiencies by previous amendments, undue prejudice to the  
17 opposing party and futility of the proposed amendment.” *Kroessler v. CVS Health*  
18 *Corp.*, 977 F.3d 803, 814-15 (9th Cir. 2020) (citation and internal quotation marks  
19 omitted). Courts may find amendment futile where “no amendment would allow the  
20 complaint to withstand dismissal as a matter of law,” and “[f]utility of amendment  
21 can, by itself, justify the denial of a motion for leave to amend.” *Id.* at 815 (citation  
22 and internal quotation marks omitted). But “[i]f a complaint does not state a plausible  
23 claim for relief, a district court should grant leave to amend even if no request to  
24 amend the pleading was made, unless it determines that the pleading could not  
25 possibly be cured by the allegation of other facts.” *Perez v. Mortg. Elec. Registration*  
26 *Sys., Inc.*, 959 F.3d 334, 340 (9th Cir. 2020) (citation and internal quotation marks  
27 omitted).

1 The court finds the record does not support a finding of any instances of “undue  
2 delay, bad faith, dilatory motive, repeated failure to cure deficiencies by previous  
3 amendments, [or] undue prejudice to the opposing party.” See *Kroessler*, 977 F.3d at  
4 814-15 (9th Cir. 2020) (citation and internal quotation marks omitted). Plaintiff has  
5 not previously amended the Complaint, and the court freely gives leave to amend  
6 consistent with Rule 15. Thus, the court does not find the Compliant allegations  
7 dismissed by this Order are futile. Accordingly, the court affords Plaintiff leave to  
8 amend Plaintiff’s claims dismissed without prejudice by this Order.

9 **IV. DISPOSITION**

10 The Complaint’s plausibly pleaded allegations do not provide a sufficient basis  
11 for the court to conclude that Defendants’ use is “explicitly misleading” within the  
12 meaning of the *Rogers* test. For that reason, the court **GRANTS** Defendants’ Motion  
13 and **DISMISSES WITHOUT PREJUDICE AND WITH LEAVE TO AMEND** the  
14 Complaint. Should Plaintiff desire to file an amended complaint that addresses the  
15 issues in this ruling, Plaintiff must file and serve it within thirty (30) days of service of  
16 notice of this ruling.

17  
18  
19 **IT IS SO ORDERED.**

20  
21  
22 DATED: June 17, 2022



23 HONORABLE FRED W. SLAUGHTER  
24 UNITED STATES DISTRICT JUDGE