

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF GEORGIA
ATLANTA DIVISION

THOROUGHbred LEGENDS, LLC;
JACINTO VASQUEZ; and FRANK
WHITELEY, JR.,

Plaintiffs,

v.

THE WALT DISNEY COMPANY;
AMERICAN BROADCASTING
COMPANIES, INC.; and ESPN
PRODUCTIONS, INC;

Defendants.

CIVIL ACTION FILE

NO. 1:07-CV-1275-BBM

ORDER

This trademark case is before the court on the Motion for Summary Judgment, formerly a Motion to Dismiss Plaintiffs' Amended Complaint [Doc. Nos. 34, 46] (collectively, the "Converted Motion"), filed by Defendants The Walt Disney Company ("Disney"), American Broadcasting Companies, Inc. ("ABC"), and ESPN Productions, Inc. ("ESPN") (collectively, "Defendants"), and a Motion for Discovery pursuant to Rule 56(f) [Doc. No. 55] (the "Rule 56(f) Motion"), filed by Plaintiffs.

I. Factual and Procedural Background

Except with respect to the trademark infringement claims, the court derives the facts from the Plaintiffs' Second Amended Complaint, and accepts them as true.

See Lotierzo v. Woman's World Med. Ctr., Inc., 278 F.3d 1180, 1182 (11th Cir. 2002).

For the trademark infringement claims, the court sets forth relevant facts obtained through supplemental filings submitted in connection with the Converted Motion, and makes justifiable factual inferences in favor of Plaintiffs. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 255 (1986). This court's Order of December 4, 2007 (the "December 4, 2007 Order") contains a full recitation of the facts based on Plaintiffs' First Amended Complaint.

This case involves the story of the famous filly racehorse Ruffian. Plaintiff Jacinto Vasquez ("Mr. Vasquez") is a retired professional jockey who rode Ruffian in nine of her eleven career races, including her final race. Plaintiff Frank Whiteley, Jr. ("Mr. Whiteley") was Ruffian's trainer. Ruffian won her first ten races by significant margins, breaking records previously held by colts. Recognizing her achievements, the New York Racing Association offered a large sum of money for Ruffian to race one-on-one against the 1975 Kentucky Derby winner, a colt named Foolish Pleasure, in a nationally televised match on July 6, 1975 at Belmont Park. A quarter of a mile into the race, Ruffian broke her right foreleg. She underwent surgery to correct the injury. Ruffian awoke from the procedure earlier than anticipated and upon regaining consciousness, thrashed around, further damaging her injured leg. After consultation with trainers and veterinarians, Ruffian's owners ultimately decided to euthanize her.

In 2004, Defendants ESPN and ABC (both owned by Defendant Disney) decided to make a movie about Ruffian. Defendants hired Orly Adelson Productions (“OAP”) to produce the film. Defendants asked Mr. Whiteley and Mr. Vasquez to participate in the project. They each declined around May 12, 2004, and advised OAP or ESPN that they would not permit the use of their names or likenesses in the film.

On May 10, 2004, Plaintiff Thoroughbred Legends, LLC (“Legends”), a Georgia limited liability corporation, applied to the United States Patent and Trademark Office (“PTO”) to register “RUFFIAN” as a service mark.¹ The application, submitted May 10, 2004, was for a mark in “[e]ntertainment services, namely, production of theatrical plays, motion picture films, television shows, and documentaries.” (Defs.’ Statement of Undisputed Material Facts in Support of its Mot. for Summ. J. (“SOF”) ¶ 7 (citation and internal quotations omitted)). On October 31, 2006, Legends’ owner Peter Blum (“Mr. Blum”) offered to license the “RUFFIAN” mark to ESPN, an invitation that ESPN declined.

Defendants proceeded to make a film entitled “Ruffian,” about Ruffian. When Legends heard of the production, it notified Defendants by letter that any

¹The court will use “RUFFIAN” to refer to the registered trademark for clarity.

use of the "RUFFIAN" mark in the film would violate Legends' rights. ESPN's counsel responded that Legends' claims were without merit and that it intended to proceed with production of the film. On June 9, 2007, the film aired on ABC and is currently available for purchase in DVD format.

Meanwhile on May 23, 2007, Legends provided a statement of use in support of registration of "RUFFIAN" to the PTO. Legends declared in the statement of use that it used the "RUFFIAN" mark in commerce beginning October 31, 2006, the date it attempted to license the "RUFFIAN" mark to Defendants. A specimen accompanying the statement of use depicts a horse underneath the enlarged word "RUFFIANTM" and offers for purchase rights to the life stories of Mr. Whiteley and Mr. Vasquez for the creation of a film, television program, documentary, or video production about Ruffian.² On August 14, 2007, the PTO accepted Legends' statement of use and granted it a registration for the service mark "RUFFIAN." On September 5, 2007, Defendants filed a petition for cancellation of the "RUFFIAN"

²After summarizing Ruffian's racing career, the specimen concludes:

This unique opportunity to create a dramatic film, television program, documentary and video productions based on the accounts of Racing Hall of Fame horse trainer Frank Whiteley who trained and raced Ruffian, and Jacinto Vasquez, the Racing Hall of Fame jockey who rode Ruffian in nine of her eleven races, is offered exclusively from Thoroughbred Legends, LLC.

(Ex. 1 to Decl. of Tamar Y. Duvdevani, Dec. 27, 2007.)

registration.³

Plaintiffs filed their original Complaint in this action on June 4, 2007. On July 20, 2007, Plaintiffs filed a First Amended Complaint pursuant to Federal Rule of Civil Procedure 15(a), because no responsive pleading had been filed. On August 6, 2007, Defendants filed a Motion to Dismiss the Amended Complaint [Doc. No. 34]. On August 23, 2007 Plaintiffs filed a Motion for Leave to File a Second Amended Complaint [Doc. No. 36], which the court granted in its December 4, 2007 Order. The Second Amended Complaint seeks damages and injunctive relief based on allegations of trademark infringement, deceptive trade practices, defamation, and invasion of privacy.

In Counts One through Three of the Second Amended Complaint, Plaintiffs assert that the film “Ruffian” infringes their trademark “RUFFIAN.” They point out that the mark and movie’s title are identical, which they contend will confuse viewers as to the movie’s source. Plaintiffs also argue that the film deceives viewers into thinking Mr. Whiteley and Mr. Vasquez participated in it or sponsored it. Specifically, Count One alleges that Defendants infringed Plaintiffs’ registered mark⁴ in violation of the Lanham Act, 15 U.S.C. § 1114. Count Two alleges that

³As far as the court knows, the PTO has not yet ruled on the petition for cancellation.

⁴Individual Plaintiffs Mr. Vasquez and Mr. Whiteley claim an interest in the “RUFFIAN” mark through part ownership of Legends. (Pls.’ First Am. Compl. ¶¶ 4, 6.)

Defendants have infringed Plaintiffs' mark in violation of another section of the Lanham Act, 15 U.S.C. § 1125(a). Count Three states that Defendants violated Georgia's Uniform Deceptive Trade Practices Act ("UDTPA"), O.C.G.A. § 10-1-372.

Count Four alleges that certain statements in the film "Ruffian" defamed Mr. Whiteley and Mr. Vasquez. The film is told from the perspective of journalist Bill Nack, which Plaintiffs find troubling because the film shows Mr. Nack in close contact with Mr. Whiteley, Mr. Vasquez, and Ruffian. In the movie, Mr. Whiteley discloses private information about Ruffian's condition to Mr. Nack and allows Mr. Nack to observe Ruffian's medical treatment. Plaintiffs also point to a scene that portrays Mr. Whiteley blackmailing Mr. Vasquez, the regular jockey for both Ruffian and Foolish Pleasure in 1975, into riding Ruffian in the match race between the two horses. Plaintiffs argue that these conversations, falsely attributed to Mr. Whiteley and Mr. Vasquez, made them appear unethical and unprofessional.

Count Five alleges that the film "Ruffian" portrayed Mr. Whiteley and Mr. Vasquez in a false light. Plaintiffs describe dialogue between Mr. Whiteley and Mr. Vasquez in which Mr. Whiteley calls Mr. Vasquez a "Puerto Rican," though he is actually Panamanian. Plaintiffs contend that the film mischaracterizes this nickname, in reality an affectionate joke.

Finally, Count Six states that Defendants appropriated the names and likenesses of Mr. Whiteley and Mr. Vasquez without authorization. Plaintiffs contend that the film prominently features characters based on Mr. Whiteley and Mr. Vasquez, and that the actors playing these characters emulated Mr. Whiteley's and Mr. Vasquez's dress, speech, and manner.

The court converted Defendants' Motion to Dismiss the Amended Complaint into a Motion for Summary Judgment in the December 4, 2007 Order to address concerns it had with the Plaintiffs' trademark infringement claims. The court requested certain supplemental briefing and filings from the parties. The court noted that in ruling on the Converted Motion, it would also consider the briefs that had been filed on the Motion to Dismiss Defendants' [First] Amended Complaint. In response to the December 4, 2007 Order, Plaintiffs moved for discovery under Federal Rule of Civil Procedure 56(f).

The court now considers the Converted Motion, including all claims addressed in Defendants' Motion to Dismiss the [First] Amended Complaint, as well as the Rule 56(f) Motion.

II. Legal Standard

The court applies the summary judgment standard to Plaintiffs' trademark infringement claims. Summary judgment is appropriate only when the pleadings and affidavits submitted by the parties show that no genuine issue of material fact exists and that the movant is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). A dispute over a fact will preclude summary judgment if the dispute "might affect the outcome of the suit under the governing law." Anderson, 477 U.S. at 248. A court must deny summary judgment "if the evidence is such that a reasonable jury could return a verdict for the nonmoving party." Id. Although in considering a motion for summary judgment, "[t]he evidence of the non-movant is to be believed, and all justifiable inferences are to be drawn in his favor," id. at 255, the nonmovant must do more than "simply show that there is some metaphysical doubt as to the material facts." Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 586 (1986). Indeed, he must present affirmative evidence beyond mere allegations to show that a genuine issue of material fact exists. Anderson, 477 U.S. at 256-57.

When a motion for summary judgment is pending before the conclusion of discovery, a party may move under Federal Rule of Civil Procedure 56(f) for a continuance to conduct additional discovery. However,

[t]he party seeking to use rule 56(f) may not simply rely on vague assertions that additional discovery will produce needed, but unspecified, facts, but rather he must specifically demonstrate how postponement of a ruling on the motion will enable him, by discovery or other means, to rebut the movant's showing of the absence of a genuine issue of fact.

Reflectone, Inc. v. Farrand Optical Co., 862 F.2d 841, 843-44 (11th Cir. 1989) (citations and internal quotations omitted). In particular, "[a] Rule 56(f) motion must be supported by an affidavit which sets forth with particularity the facts the moving party expects to discover and how those facts would create a genuine issue of material fact precluding summary judgment." Harbert Int'l, Inc. v. James, 157 F.3d 1271, 1280 (11th Cir. 1998).

Courts grant summary judgment in favor of defendants on claims of trademark infringement when there is insufficient evidence to create a genuine issue of material fact for trial. *E.g.*, Welding Servs., Inc. v. Forman, 509 F.3d 1351, 1356 (11th Cir. 2007) (affirming summary judgment on eligibility of service mark, secondary meaning, and likelihood of confusion); Int'l Stamp Art, Inc. v. U.S. Postal Serv., 456 F.3d 1270, 1277 (11th Cir. 2006) (affirming summary judgment in favor of defendants on fair use defense); Leigh v. Warner Bros., Inc., 212 F.3d 1210, 1217 (11th Cir. 2000) (affirming summary judgment on the issue of ownership of trademark rights).

Because Defendants' supplemental filings on the Converted Motion dealt solely with the trademark issues, the court considers their arguments in favor of dismissal of the remaining claims according to Federal Rule of Civil Procedure 12(b)(6) ("Rule 12(b)(6)"). Under Rule 12(b)(6), a court may grant a motion to dismiss when a complaint fails to state a claim upon which relief can be granted. To withstand a motion to dismiss, a complaint need not contain "detailed factual allegations," but must "'give the defendant fair notice of what the . . . claim is and the grounds upon which it rests.'" Bell Atl. Corp. v. Twombly, --- U.S. ----, 127 S. Ct. 1955, 1964 (2007) (quoting Conley v. Gibson, 355 U.S. 41, 47 (1957)). Here, the court must determine whether Plaintiffs have "alleged enough facts to suggest, raise a reasonable expectation of, and render plausible" their claims. Watts v. Fla. Int'l Univ., 495 F.3d 1289, 1296 (11th Cir. 2007). The court construes the complaint in Plaintiffs' favor, and accepts the facts they allege as true. M.T.V. v. DeKalb County Sch. Dist., 446 F.3d 1153, 1156 (11th Cir. 2006).

III. Analysis

A. Trademark Infringement Claims

To survive summary judgment on a claim of trademark infringement, a plaintiff must present evidence that (i) the plaintiff has a valid trademark, and (ii) the defendant adopted a similar mark such that consumers would be likely to

confuse the two. Leigh, 212 F.3d at 1216; see Welding Servs., 509 F.3d at 1356. Plaintiffs have neither pointed to evidence showing a genuine issue of material fact as to whether Defendants infringed on rights validly claimed in the mark “RUFFIAN,” nor established that they are entitled to discovery on that matter. Therefore, the court grants summary judgment in favor of Defendants on Counts I-III of the Second Amended Complaint as to the claims of trademark infringement, and denies the Rule 56(f) Motion as to those claims.

1. Plaintiffs have not shown that “RUFFIAN” is entitled to protection

- a. Plaintiffs have shown no trademark use of “RUFFIAN”

A plaintiff in a trademark infringement lawsuit must not only show that it used its mark in commerce, but also that it used the mark as a *trademark*, whether the mark is registered or not. Rock & Roll Hall of Fame & Museum, Inc. v. Gentile Prods., 134 F.3d 749, 753 (6th Cir. 1998) (“[I]n order to be protected as a valid trademark, a designation must create a separate and distinct commercial impression, which . . . performs the trademark function of identifying the source of the merchandise to the customers.”) (citation and internal quotations omitted); Aini v. Sun Taiyang Co., Ltd., 964 F. Supp. 762, 773 (S.D.N.Y. 1997) (“One . . . may not ‘own’ a trademark unless one uses the mark as a designation of origin on or in connection with goods or services made or furnished by or under one’s control.”);

1 McCarthy on Trademarks and Unfair Competition § 3:3 (4th ed. 2007) (“[T]o create trademark . . . rights, a designation must be proven to perform the job of identification: to identify one source and distinguish it from other sources. If it does not do this, then it is not protectable as a trademark, service mark, trade dress or any similar exclusive right.”); see Leigh, 212 F.3d at 1217-18 (photographer had no trademark when he used photograph as example of art and not as a mark to identify his photographic services). A trademark’s primary function is to signify origin to potential customers and competitors. Leigh, 212 F.3d at 1216-17 (“Trademarks . . . answer the question ‘Who made it?’ rather than ‘What is it?’”). A valid service mark must be used to identify or distinguish the services being offered. Lone Star Steakhouse & Saloon, Inc. v. Longhorn Steaks, Inc., 106 F.3d 355, 361 (11th Cir. 2007) (upholding the district court’s decision that a sign displayed on the interior wall of the plaintiff’s restaurant was not a valid service mark as a matter of law, citing 15 U.S.C. § 1127).

Plaintiffs fail to show trademark use of “RUFFIAN.” Plaintiffs desired to make a movie about Ruffian, and took steps toward that goal by attempting to license what they called a service mark, among other things. But Plaintiffs fail to show that the alleged “RUFFIAN” mark was in fact ever *used to signify origin to customers and competitors*. See Leigh, 212 F.3d at 1216-17. As Plaintiffs note, the

requirement of use does not necessarily require Plaintiffs to show any sales. See Planetary Motion, Inc. v. Techsplosion, Inc., 261 F.3d 1188, 1194, 1195-96 (11th Cir. 2001). However, none of the “uses” Plaintiffs list qualify as a bona fide use in commerce to signify the source of a product or service.

In Mr. Blum’s affidavit, he states that he took many actions in furtherance of the goal of producing a film about Ruffian. In addition to attempting to license “RUFFIAN” to ESPN, he held discussions with various television networks, television producers, and other individuals. He states that these conversations were aimed toward the goal of creating a movie about Ruffian “to be produced and marketed under the RUFFIAN mark.” (Aff. of Peter E. Blum, Jan. 25, 2008 (“Blum Aff.”) ¶ 18.) He directed a well-known horse racing broadcaster to film interviews of Mr. Whiteley, Mr. Vasquez, and Ruffian’s assistant trainer, Mike Bell. He obtained commitments from most relevant individuals involved in Ruffian’s racing career. He gathered information from a large number of sources. He acquired historic memorabilia like the saddle Ruffian wore during her final match. Generally speaking, these actions fall in one of two categories: engaging parties to participate in the production of a Ruffian film, or soliciting parties interested in making a Ruffian film to purchase the stories of Mr. Vasquez and Mr. Whiteley.

In taking these actions, Legends did not use the “RUFFIAN” mark to identify the source of any service, but merely described it and claimed rights to the mark. For example, Mr. Blum’s October 31, 2006 e-mail attempting to license “RUFFIAN” to ESPN claims ownership of “RUFFIAN.” The message, which appears to be from Mr. Blum’s personal e-mail address and displays no logo or corporate header, states: “I own Thoroughbred Legends, LLC, an entity that has obtained the trademarks for a number of famous thoroughbred racehorses - among them Ruffian, Alydar, Man O’War, Citation, and Whirlaway.” (Ex. G to Pls.’ First Am. Compl.) The word “Ruffian” is not distinguishable or set apart in any way from the rest of the message. Put simply, one cannot acquire rights in a trademark by asserting he owns it. See Sengoku Works Ltd. v. RMC Int’l, Ltd., 96 F.3d 1217, 1219 (9th Cir. 1996) (“To acquire ownership of a trademark it is not enough to have invented the mark first or even to have registered it first; the party claiming ownership must have been the first to actually use the mark in the sale of goods or services.”); AB Electrolux v. Bermil Indus. Corp., 481 F. Supp. 2d 325, 330 (S.D.N.Y. 2007) (“In determining ownership of a trademark . . . creation or invention of the mark is irrelevant. The critical question is which party first used the mark in the sale of goods or services.”). Therefore, the attempts to license and similar actions Mr. Blum

took in order to produce a film about Ruffian cannot save Plaintiffs' infringement claims.

Mr. Blum also states that "Legends has tried to further its RUFFIAN project by generating and distributing advertising materials through Paradies Shops." (Blum Aff. ¶ 27.) He attaches those materials, including a letter dated August 22, 2007 from an executive assistant at The Paradies Shops to an attorney named Michael Hobbs. The letter encloses a copy of a license agreement between Legends and The Paradies Shops, in which Legends grants The Paradies Shops a license to use several alleged marks in the names of famous racehorses, including "RUFFIAN." The license agreement permitted The Paradies Shops to use those marks "for clothing and printed matter and paper goods for marketing, distribution and sale in [The Paradies Shops]." (Ex. B. to Blum Aff. at 2.) Without more, this does not create a genuine issue of material fact as to whether Plaintiffs used "RUFFIAN" as a trademark. Though one may acquire protection in a service mark through its *use* by licensees, see Turner v. HMH Publ'g Co., 380 F.2d 224, 229 (5th Cir. 1967),⁵ the proffered documents do not show that The Paradies Shops ever used the mark. Indeed, the version of the license agreement provided to the court has

⁵In Bonner v. City of Prichard, 661 F.2d 1206 (11th Cir. 1981) (en banc), the Eleventh Circuit adopted as binding precedent all decisions of the former Fifth Circuit rendered prior to October 1, 1981.

not been executed by Legends. Additionally, the use specified in the agreement pertained to clothing, printed matter, and paper goods, with no discernible connection to film production.

Mr. Blum also discusses a charity he founded called the Ruffian Foundation, but fails to allege commercial trademark use of “RUFFIAN” in connection with that organization. Furthermore, the Ruffian Foundation’s mission is not to produce movies or television shows but “to further equine medical research, and the preservation of thoroughbred racing history.” (Blum Aff. ¶ 17.) As such, plaintiffs have failed to establish that any materials related to the Ruffian Foundation amount to trademark use of the film-production-related mark Plaintiffs claim to own.

In converting the Motion to Dismiss to a Motion for Summary Judgment, the court requested that Plaintiffs submit evidence that they used “RUFFIAN” in commerce *as a trademark*. Defendants’ Converted Motion argues at length that Ruffian was not used as a trademark. Plaintiffs fail to point to any evidence to the contrary. Evidence of Plaintiffs’ trademark use of “RUFFIAN” is entirely within Plaintiffs’ control.⁶ See Mason Tenders Dist. Council Pension Fund v. Messera, 958

⁶Plaintiffs argue that they are entitled to discovery of Defendants’ use of the word “production” in connection with trademarks Defendants registered or applied for. However, the court fails to see how discovery on Defendants’ trademarks would assist Plaintiffs in showing that they themselves used “RUFFIAN” *as a trademark* in commerce when they have adduced no other evidence to that effect. Defendants are not judicially estopped from asserting that Plaintiffs have not used “RUFFIAN” as a trademark because

F. Supp. 869, 894 (S.D.N.Y. 1997) (“Relief under Rule 56(f) is not appropriate where the discovery allegedly desired pertains to information already available to the non-moving party.”) (citation and internal quotations omitted). Therefore, there is no need for discovery, and Defendants are entitled to summary judgment on the infringement claims.

b. Even if “RUFFIAN” is a Trademark, it is Descriptive

Assuming *arguendo* that Plaintiffs have used “RUFFIAN” as a trademark, “RUFFIAN” is a descriptive designation. “A mark is merely descriptive if it immediately conveys information concerning a quality or characteristic of the product or service.” In re MBNA Am. Bank, N.A., 340 F.3d 1328, 1332 (Fed. Cir. 2003); see Welding Servs., 509 F.3d at 1358. For example, if the mark signifies the nature of the goods or services, that mark is considered descriptive. Investacorp, Inc. v. Arabian Inv. Banking Corp. (Investcorp) E.C., 931 F.2d 1519, 1524 (11th Cir. 1991) (upholding summary judgment on district court’s characterization of “Investacorp” as descriptive of a business that invests in corporations); 24 Hour Fitness USA, Inc. v. 24/7 Tribeca Fitness, LLC, 277 F. Supp. 2d 356, 362 (S.D.N.Y. 2003) (finding “24 Hour Fitness” descriptive in nature in the context of a health club); J&J Snack Foods Corp. v. Nestle USA, Inc., 149 F. Supp. 2d 136, 147, 151

Defendants have their own trademarks registered in the same category.

(D.N.J. 2001) (classifying “Break & Bake” for refrigerated cookie dough as descriptive). The PTO has held that the name of a historical figure used in connection with a product that “intend[s] to represent” that historical figure is a descriptive mark. In re Carlson Dolls Co., 31 U.S.P.Q.2d 1319, 1320 (T.T.A.B. 1994) (declining to register the mark “MARTHA WASHINGTON” for a historical doll portraying the historical figure Martha Washington).

A mark that is descriptive of the product or service associated with it must have attained some secondary meaning to be eligible for trademark protection. Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 769 (1992). A plaintiff “has the burden of sustaining a high degree of proof in establishing a secondary meaning for a descriptive term,” which a court must consider in ruling on a motion for summary judgment. Investacorp, 931 F.2d at 1525. “A name has acquired secondary meaning when the primary significance of the term in the minds of the consuming public is not the product but the producer.” Welding Servs., 509 F.3d at 1358 (citations and internal quotations omitted). In determining whether a plaintiff has established secondary meaning, relevant factors include

the length and nature of the name’s use, the nature and extent of advertising and promotion of the name, the efforts of the proprietor to promote a conscious connection between the name and the business,

and the degree of actual recognition by the public that the name designates the proprietor's product or service.

Id.

In this case, Mr. Blum's own affidavit establishes that the mark is descriptive. He states that Legends "obtained the registration for its RUFFIAN mark to use the mark for production services *in connection with telling the true story of Ruffian in various formats.*" (Blum Aff. ¶ 17 (emphasis added).) He further insists that "[t]his has been Legends' primary intended use for its RUFFIAN mark at all times." (Id.) Plaintiffs fail to adduce any evidence of secondary meaning, and it is clear from the record that even assuming that "RUFFIAN" was ever used in a trademark sense, it has not developed secondary meaning in the eyes of the consuming public. Plaintiffs should have access to some evidence of secondary meaning if it exists.⁷ No genuine issue of material fact exists as to whether Plaintiffs could meet their burden to show secondary meaning at trial. Therefore, Plaintiffs' infringement claims fail, and they are not entitled to discovery on the issue of secondary meaning.

c. Effect of Registration of "RUFFIAN"

⁷Plaintiffs seek discovery as to whether Defendants intentionally copied the "RUFFIAN" mark, as this would constitute evidence of secondary meaning. As the case Plaintiffs cite indicates, such evidence alone is insufficient to establish secondary meaning. Brooks Shoe Mfg. Co. v. Suave Shoe Corp., 716 F.2d 854, 859-60 (11th Cir. 1983). Especially given the weak to nonexistent evidence that "RUFFIAN" was ever used, proof of intentional copying would not create a genuine issue of material fact as to secondary meaning.

The PTO's eventual registration of "RUFFIAN" does not change this result. Registration without actual use does not confer rights to a trademark. E.g., Miller v. Glenn Miller Prods., Inc., 454 F.3d 975, 979 (9th Cir. 2006) ("Registration does not create a mark or confer ownership; only use in the marketplace can establish a mark."); Sengoku Works, 96 F.3d at 1219; Basile, S.p.A. v. Basile, 899 F.2d 35, 37 n.1 (D.C. Cir. 1990) ("Although [a senior user's] registration is a predicate to its protection under the Lanham Act, the underlying right depends not on registration but rather on use."); Harod v. Sage Prods., Inc., 188 F. Supp. 2d 1369, 1375 (S.D. Ga. 2002) ("Registration does not actually confer ownership rights in the mark. Instead, trademark ownership accrues with use."); Aini, 964 F. Supp. at 773 ("Ownership . . . is a product of use, not of registration."); In re Wrubleski, 380 B.R. 635, 639 (Bankr. S.D. Fla. 2008) ("[A] party that registers or owns the rights to a mark, without use, develops no trademark rights under the U.S. trademark laws.").

Though the PTO's acceptance of the statement of use and its subsequent registration of "RUFFIAN" creates a presumption of validity, Scientific Applications, Inc. v. Energy Conservation Corp., 436 F. Supp. 354, 357 (N.D. Ga. 1977) (Freeman, J.); Harod, 188 F. Supp. 2d at 1375, that presumption "is easily rebuttable, since it merely shifts the burden of production to the alleged infringer." Custom Vehicles, Inc. v. Forest River, Inc. 476 F.3d 481, 486 (7th Cir. 2007); see also

Persha v. Armour & Co., 239 F.2d 628, 630 (5th Cir. 1957) (“[R]egistration of a trade-mark in accordance with federal or state law creates a prima facie, rebuttable presumption that the one registering the mark is its owner, and that the trade-mark is valid.”). Defendants have rebutted the presumption of validity in this case. The court asked Plaintiffs to present evidence and argument that the trademark was valid, and identified several of Plaintiffs’ trademark allegations that appeared vulnerable, even in a motion to dismiss setting. In support of the Converted Motion, Defendants cited evidence that “RUFFIAN” is not a valid trademark, and pointed to the lack of allegations or evidence to support valid trademark use of “RUFFIAN” or secondary meaning. Defendants argued “persuasively . . . that the . . . mark . . . is . . . ineligible for protection.” Scientific Applications, 436 F. Supp. at 360-61. Plaintiffs’ response and accompanying affidavits failed to present contrary evidence sufficient to survive summary judgment. A preponderance of the evidence thus shows that “RUFFIAN” is not entitled to protection.⁸ See, e.g., Aini,

⁸Plaintiffs misstate the applicable burden to rebut the presumption of validity. They cite Thomas Pride Mills, Inc. v. Monsanto Co., 155 U.S.P.Q. 205, 208 (N.D. Ga. 1967) (Smith, J.), for the proposition that “the registered mark should be protected unless there is *conclusive* evidence” of invalidity. That case, and another Plaintiffs cite, Aluminum Fabricating Co. of Pittsburgh v. Season-All Window Corp., 259 F.2d 314, 316 (2d Cir. 1958), present the entirely different case in which a plaintiff sought a cancellation of the defendant’s registered mark. Likewise, in Aloe Creme Labs., Inc. v. Tex. Pharmacal Co., 335 F.2d 72, 74 (5th Cir. 1964) the PTO rejected the registration of the plaintiff’s mark because it determined that the plaintiff’s mark was confusingly similar to the defendant’s already registered mark. In that context the court described the evidence required to

964 F. Supp. at 774.

In conclusion, Plaintiffs have not shown a genuine issue of material fact as to whether they have acquired rights in the trademark “RUFFIAN.” Plaintiffs classify their mark as a “service mark” when the “services” they seek to provide are actually *facts*, specifically the story of Ruffian from the perspectives of her trainer and jockey. As the United States Supreme Court noted in a case involving copyrights, “all facts-scientific, historical, biographical, and news of the day . . . are part of the public domain available to every person.” Feist Pubs., Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 348 (1991) (citation and internal quotations omitted). Facts are not entitled to intellectual property protection. Plaintiffs cannot evade this fundamental principle articulated in many copyright cases through the back door of trademarks. The court dismisses Plaintiffs’ trademark infringement claims because Plaintiffs have not shown valid trademark rights.⁹

2. Defendants’ Use of “Ruffian” Was a Fair Use

Finally, Defendants are entitled to a fair-use defense as a matter of law. “A fair-use defense is established if a defendant proves that its use is (1) other than as

disturb the PTO’s finding as “evidence which, in character and amount carries thorough conviction.” Id. (citation and internal quotations omitted).

⁹Defendants have not requested that the court cancel the “RUFFIAN” registration, and they still have a petition remaining before the PTO to this effect.

a mark, (2) in a descriptive sense, and (3) in good faith.” Int’l Stamp Art, 456 F.3d at 1274 (citations and internal quotations omitted). It is permitted for a defendant to use a term in its descriptive sense. See, e.g., Soweco, Inc. v. Shell Oil Co., 617 F.2d 1178, 1186-87 (5th Cir. 1980), cert. denied, 450 U.S. 981 (1981); Warner Publ’n, Inc. v. Popular Publ’ns, Inc., 87 F.2d 913, 915 (2d Cir. 1937) (“The defendant has as good a right to a descriptive title as has the plaintiff.”); Restatement (Third) of Unfair Competition § 28 & cmt c (1995) (“Fair use is a reasonable and good faith use of a descriptive term that is another’s trademark to describe rather than to identify the user’s goods, services, or business.”). As for good faith, “the standard for good faith for fair use . . . asks whether the alleged infringer intended to trade on the good will of the trademark owner by creating confusion as to the source of the goods or services.” Int’l Stamp Art, 456 F.3d at 1274. Defendants’ use of “Ruffian” as a title to a film about Ruffian conveys no information about the origin of the film. Indeed, the film’s origin is apparent from the conspicuous logo “ESPN Home Entertainment” above the film’s title on the DVD cover, and a smaller logo that reads “espnoriginalentertainment,” in the bottom right hand corner of the DVD cover. No reasonable juror would confuse the title of the film “Ruffian” with the source of the film. There is therefore no serious question that Defendants’ use was

descriptive, a non-trademark use, and in good faith. Because this is apparent from the face of the DVD cover, discovery would be of no assistance.

Defendants are entitled to summary judgment on the federal infringement claims based on the fair use defense in addition to the grounds the court has already discussed. Even if the court were to assume Plaintiffs had a valid mark in “RUFFIAN,” and even if Defendants used “Ruffian” as a trademark, Plaintiffs have not shown a genuine issue of material fact as to whether they used “RUFFIAN” in commerce *prior to* Defendants. “[T]he plaintiff’s use of the mark must predate the defendant’s potentially confusing mark.” Leigh, 212 F.3d at 1217. If preparations for making a movie about Ruffian constitute actual trademark use as Plaintiffs argue, then Defendants used “Ruffian” in commerce when they hired OAP to produce the film. According to Plaintiffs’ timeline, this occurred in 2004. Plaintiffs alleged they first began to use “RUFFIAN” on October 31, 2006.¹⁰ As the court has already discussed, it considers these uses to be non-trademark uses, but if Plaintiffs urge the court to adopt their innovative theory of trademark use, surely they recognize that it applies equally to Defendants.

¹⁰In fact, Plaintiffs’ intent-to-use application for trademark registration was not filed with the PTO until May 10, 2004, after OAP had sent a contract to Mr. Whiteley and Mr. Vasquez in connection with Defendants’ movie about Ruffian on April 30, 2004.

3. Infringement Under UDTPA

Because Defendants are entitled to summary judgment on the federal trademark infringement claims, they are likewise entitled to summary judgment on the analogous claim under Georgia's Deceptive Trade Practices Act, O.C.G.A. § 10-1-372. *E.g., Optimum Techs., Inc. v. Henkel Consumer Adhesives, Inc.*, 496 F.3d 1231, 1239 (11th Cir. 2007) (“[T]he same analysis that governs a trademark infringement also applies to claims brought under 15 U.S.C. § 1125(a) and O.C.G.A. § 10-1-372(a)”); *Kason Indus., Inc. v. Component Hardware Group, Inc.*, 120 F.3d 1199, 1203 (11th Cir. 1997) (“It should be apparent that § 43(a) of the Lanham Act and § 10-1-372(a)(2) of the UDTPA provide analogous causes of action governed by the same standard.”). The court dismisses Count Three of the Second Amended Complaint to the extent it claims trademark infringement.

B. Invasion of Privacy Claims¹¹

Counts Five and Six of the Second Amended Complaint allege that Defendants committed invasion of privacy as to Plaintiffs Whiteley and Vasquez. Plaintiffs' invasion of privacy claims fail even employing the lenient Rule 12(b)(6) standard, so the court must dismiss them, and discovery is inappropriate.

¹¹As stated above, because the December 4, 2007 Order was not clear about whether Defendants' Motion to Dismiss was being converted to a summary judgment motion on all claims, the court will evaluate all remaining claims on the motion to dismiss standard.

Publication about a matter of public interest fails to state an invasion of privacy claim. In Torrance v. Morris Publ'g Group LLC, 281 Ga. App. 563, 572-73, 636 S.E.2d 740, 747 (2006) (involving false light invasion of privacy), the Georgia Court of Appeals stated:

The right to recover under an invasion of privacy theory is restricted where matters of public interest are involved. Where an incident is a matter of public interest, or the subject matter of a public investigation, a publication in connection therewith can be a violation of no one's legal right of privacy.

281 Ga.App. at 572-73, 636 S.E.2d at 747 (citations and internal quotations omitted). In Lucas v. Fox News Network, LLC, 248 F.3d 1180, 2001 WL 100181, at *2 (11th Cir. 2001) (table case), the Eleventh Circuit upheld the dismissal of claims based on all four branches of Georgia's invasion of privacy tort on this ground, including the false light and appropriation of likeness branches at issue in this case. The Lucas court agreed with the district court that "plaintiffs' invasion of privacy claims must be dismissed because defendants' actions all dealt with [one of the plaintiff's] public activities." Id. Many other courts have dismissed cases on this principle. E.g., Macon Telegraph Publ'g Co. v. Tatum, 263 Ga. 678, 679, 436 S.E.2d 655, 658 (1993); Tucker v. News Publ'g Co., 197 Ga. App. 85, 86, 397 S.E.2d 499, 500 (1990); Cox Commc'ns, Inc. v. Lowe, 173 Ga. App. 812, 813, 328 S.E.2d 384, 385 (1985); Alexander v. New Corp., No. Civ.A. CV203-158, 2004 WL 3591340, at *3 (S.D. Ga.

Mar. 19, 2004) (dismissing invasion of privacy claim where defendant wrote nonfiction book about his past experience as an informant for the Drug Enforcement Administration, containing references to plaintiff). But see Maples v. Nat'l Enquirer, 763 F. Supp. 1137, 1143 (N.D. Ga. 1990) (Murphy, J.).¹²

Although the bulk of the cases dismissed for this reason involve contemporaneous news stories, the court finds the principle applicable to Defendants' later production of a dramatization about past newsworthy events. The Lucas court noted that dismissal was warranted regardless of whether defendant's purpose in publication was to inform or to entertain. Lucas, 2001 WL 100181, at *2. Plaintiffs would obviously agree to the characterization of the story of Ruffian as an important event in horse racing history; indeed, many of their accusations against Defendants are premised on that point. The conversations and conduct of Mr. Whiteley and Mr. Vasquez that took place in connection with their involvement with Ruffian's career cannot be the subject of a cause of action for

¹²The Maples court declined to grant a motion to dismiss invasion of privacy claims on the ground that the subject matter was one of public interest. It reasoned that because the plaintiff had alleged that the defendant had fabricated the tabloid news story at issue, the story was not entitled to First Amendment protection. Maples, 763 F. Supp. at 1143. Since that case was decided, however, the Eleventh Circuit Court of Appeals, the Georgia Supreme Court, and the Georgia Court of Appeals have all dismissed false light and appropriation invasion of privacy claims involving the public interest. The court finds that the clear weight of authority favors dismissal of the invasion of privacy claims in this case.

invasion of privacy. Therefore, the invasion of privacy claims in Counts Five and Six must be dismissed.

The court dismisses Count Six, called “Invasion of Privacy (Appropriation of Plaintiffs’ Likeness for Defendants’ Advantage),” for another, related reason. In Georgia, “one who makes an unsanctioned appropriation of another’s name or likeness for his own benefit may be liable to that person in tort.” Alonso v. Parfet, 253 Ga. 749, 749, 325 S.E.2d 152, 153 (1985). The tort amounts to the violation of a “proprietary [interest], in the exclusive use of the plaintiff’s name and likeness as an aspect of his identity.” Cabaniss v. Hipsley, 114 Ga. App. 367, 377, 151 S.E.2d 496, 504 (1966) (citation and internal quotations omitted). The underlying interest is commonly referred to as a “right of publicity.”¹³ Id. at 378, 151 S.E.2d at 504.

Plaintiffs claim that Defendants unlawfully appropriated their likenesses through their characters in the film “Ruffian.” The First Amendment protection of

¹³There is no substantive difference between the interests protected by the common law “right of publicity” and the interests protected by the appropriation prong of the invasion of privacy tort. The Georgia Supreme Court has noted that the appropriate cause of action depends on whether the plaintiff is a private figure or a public figure. Martin Luther King Jr., Ctr. for Social Change, Inc. v. Am. Heritage Prods., Inc., 250 Ga. 135, 143, 296 S.E.2d 697, 703 (1982) (“[W]hile private citizens have the right of privacy, public figures have a similar right of publicity”). Plaintiffs’ allegations related to their appropriation claim suggest that they are public figures, though they deny that for purposes of their defamation claim. In any event, to determine the scope of protection of that interest, the court looks to cases discussing either misappropriation or violation of the right to publicity. See Montgomery v. Montgomery, 60 S.W.3d 524, 528 (Ky. 2001) (discussing the evolution of the common law right to publicity from the appropriation prong of the right to privacy).

freedom of expression restricts such a claim. Nichols v. Moore, 334 F. Supp. 2d 944, 955-56 (E.D. Mich. 2004) (noting that the First Amendment limits the right of publicity to the context of speech that proposes a commercial transaction, which excludes “works of artistic expression such as movies, plays, books, and songs”); Daly v. Viacom, Inc., 238 F. Supp. 2d 1118, 1123 (N.D. Cal. 2002) (“Under the First Amendment, a cause of action for appropriation of another’s name and likeness may not be maintained against expressive works, whether factual or fictional.” (citation and internal quotations omitted)); Montgomery v. Montgomery, 60 S.W.3d 524, 529 (Ky. 2001) (holding that First Amendment protected barred claim of violation of right of publicity for use of plaintiff’s name, image and voice in music video); Lane v. Random House, Inc., 985 F. Supp. 141, 146 (D.D.C. 1995) (dismissing misappropriation claim, noting that First Amendment’s “newsworthiness privilege applies to advertisements for books, films, and other publications concerning matters of public interest.”). But see Maples, 763 F. Supp. at 1143. The Third Restatement of Unfair Competition elaborates:

The use of a person’s identity primarily for the purpose of communicating information or expressing ideas is not generally actionable as a violation of the person's right of publicity. . . . The interest in freedom of expression also extends to use in entertainment and other creative works, including both fiction and nonfiction. . . . Similarly, the right of publicity is not infringed by the dissemination of an unauthorized print or broadcast biography. *Use of another's identity in a novel, play, or motion picture is also not ordinarily an infringement.* The

fact that the publisher or other user seeks or is successful in obtaining a commercial advantage from an otherwise permitted use of another's identity does not render the appropriation actionable.

Restatement (Third) of Unfair Competition § 47 cmt c (emphasis added). The court is therefore persuaded that Plaintiffs may not bring an appropriation claim because the First Amendment protects Defendants' use of the characters based on Mr. Whiteley and Mr. Vasquez in their film about Ruffian. The use of Plaintiffs' likenesses in advertising the film is protected because the film itself is protected. See, e.g., Daly, 238 F. Supp. 2d at 1123.

For each of these reasons, the court dismisses Counts Five and Six of Plaintiffs' Second Amended Complaint under Rule 12(b)(6) for failure to state a claim upon which relief can be granted.

C. Remaining Claims

The court will allow a four-month period for discovery on the remaining claims for false endorsement (Counts Two and Three) and defamation (Count Four). Either party may move for summary judgment at any point it appears that there is no genuine issue of material fact on these claims.

1. False Endorsement

The court will allow Plaintiffs' claim for false endorsement to proceed. Plaintiffs claim that Defendants "make the false and misleading suggestion that

there is a sponsorship approved by Plaintiffs of the film and its content.” (Pls.’ Second Am. Compl. ¶ 71.)

[F]alse endorsement occurs when a defendant uses the name or likeness of a celebrity in a manner that is likely to cause confusion among consumers as to the affiliation, connection, or association between the celebrity and the defendant’s goods or as to the celebrity’s sponsorship or approval of defendant’s goods.

Unique Sports Prods., Inc. v. Wilson Sporting Goods Co., 512 F. Supp. 2d 1318, 1324 (N.D. Ga. 2007) (Carnes, J.) (citation and internal quotations omitted). The court must analyze this claim separately from the trademark-based claims. See id. at 1325 (noting that proof of valid trademark is not required to prevail on false endorsement claim). Though the court has doubts as to whether Plaintiffs will prevail on a claim of false endorsement, it will allow discovery on the claim of false endorsement under 15 U.S.C. § 1125(a)(1)(A) and the corresponding claim under UDTPA, O.C.G.A. § 10-1-372.

However, to the extent Plaintiffs’ response to the Converted Motion and accompanying affidavit imply a claim for false advertising separate from false endorsement, that claim was not properly pleaded. In response to the Converted Motion, Plaintiffs request discovery on “numerous issues relevant to their false advertising and deceptive trade practices claims.” (Pls.’ Br. in Opp. to Defs.’ Converted Mot. for Summ. J., etc. 21.) Their brief further alludes to a claim of false

advertising based on Defendants' description of the film as "an extraordinary true story." (Ruffian DVD, Ex. A to Defs.' Mot. to Dismiss [original Compl.].) However, the Second Amended Complaint fails to put Defendants on notice of a distinct claim of false advertising. Plaintiffs' factual allegations pertaining to deceptive trade practices other than trademark infringement deal exclusively with false endorsement. (Pls.' Second Am. Compl. ¶ 35.) The allegations do not put Defendants on notice of a false advertising claim, which is analytically distinct from a trademark infringement claim or a false endorsement claim.¹⁴ Thus, the false advertising claim is not properly before this court. Hofheinz v. AMC Prods., Inc., No. CV-00-5827 (CPS), 2003 WL 25293919, at *6 (E.D.N.Y. Apr. 23, 2003) (disallowing an untimely raised false endorsement claim); Gilmour v. Gates, McDonald & Co., 382 F.3d 1312, 1315 (11th Cir. 2004) ("A plaintiff may not amend

¹⁴False advertising is its own cause of action with its own elements. That is, a plaintiff suing for false advertising must show that

(1) the advertisements of the opposing party were false or misleading; (2) the advertisements deceived, or had the capacity to deceive, consumers; (3) the deception had a material effect on purchasing decisions; (4) the misrepresented product or service affects interstate commerce; and (5) the movant has been-or is likely to be-injured as a result of the false advertising.

Hickson Corp. v. N. Crossarm Co., 357 F.3d 1256, 1260 (11th Cir. 2004). Furthermore, false advertising claims arise under a different subsection of the Lanham Act, 15 U.S.C. § 1125(a)(1)(B), than infringement or false endorsement claims, which arise under 15 U.S.C. § 1125(a)(1)(A).

her complaint through argument in a brief opposing summary judgment.”); MCI Telecomms. Corp. v. Ameri-Tel, Inc., 852 F. Supp. 659, 666 (N.D. Ill. 1994) (“We will not consider claims and defenses raised for the first time in a brief in response to a summary judgment motion.”). Plaintiffs have already amended their Complaint twice – once as a matter of course and once by court permission. Should Plaintiffs seek to amend their Complaint again to add a claim of false advertising, they must do so by filing a separate motion.

2. Defamation

The court will also allow discovery on Plaintiffs’ defamation claim. A cause of action for defamation is established by a showing of “(1) a false and defamatory statement concerning the plaintiff; (2) an unprivileged communication to a third party; (3) fault by the defendant amounting at least to negligence; and (4) special harm or the ‘actionability of the statement irrespective of special harm.’” Mathis v. Cannon, 276 Ga. 16, 20-21, 573 S.E.2d 376, 380 (2002) (citing Restatement (Second) of Torts § 558 (1977)).

Defendants argue that Plaintiffs have not satisfied the first element of a defamation claim. Defendants point to the disclaimer at the end of the film and argue that the statements were not held out as fact, but as a dramatized story *based on* actual events, often termed a “docudrama.” The court’s own review

demonstrates that this disclaimer passes over the screen very quickly. Furthermore, the disclaimer appears not only at the end of the film, but at the end of the credits. The synopsis on the back of the DVD cover describes the film as “the extraordinary true story of the greatest filly racehorse of all time,” without using qualifying terms such as “based on” or “adapted from.” In this context, the court is not now willing to hold that no one could reasonably understand the scenes as “describing actual facts about [Mr. Vasquez and Mr. Whiteley] or actual events in which [they] participated.” Pring v. Penthouse Int’l, Ltd., 695 F.2d 438, 442 (10th Cir. 1982); see Fox Sports Net N., L.L.C. v. Minn. Twins P’ship, 319 F.3d 329, 336-37 (8th Cir. 2003) (“[S]tatements that reasonably cannot be interpreted as stating facts are protected from defamation actions by the First Amendment”). However, the statements attributed to the Plaintiffs in the “Ruffian” film may not be actionable if discovery shows that the challenged scenes contain the essence of truth, and that any falsity was incident to “author’s license” in creating a dramatization of the story. See Davis v. Costa-Gavras, 654 F. Supp. 653, 658 (S.D.N.Y. 1987).

Defendants also argue that the dialogue Plaintiffs described as portraying “blackmail” is not susceptible of defamatory meaning as a matter of law. The Second Amended Complaint contains allegations that the statements attributed to Mr. Whiteley and Mr. Vasquez portrayed them as unethical within their

professions. Plaintiffs have submitted affidavits to this effect. At this stage, that is sufficient to warrant discovery.

The court notes that if a defamation plaintiff is classified as a public figure in general or for a limited purpose, the plaintiff is also required to prove that the defendant made the statement with actual malice, that is, with knowledge that the statement was false or with reckless disregard of whether it was true or false. Mathis, 276 Ga. 16, 21-23, 573 S.E.2d 376, 380-81 (2002). Whether the plaintiff is a public figure is a question of law for the court to decide. Riddle v. Golden Isle Broad., 275 Ga. App. 701, 703, 621 S.E.2d 822, 825 (2005). Plaintiffs did not dispute that Mr. Vasquez and Mr. Whiteley “are famous figures in the horse-racing industry . . . ‘enshrined as legends with the horse racing world.’” (Resp. to SOF ¶ 5.) Thus, based on the record before it, the court concludes that Mr. Whiteley and Mr. Vasquez are public figures. See Chuy v. Philadelphia Eagles Football Club, 595 F.2d 1265, 1280 (3d Cir. 1979) (“Professional athletes, at least as to their playing careers, generally assume a position of public prominence.”); Gomez v. Murdoch, 475 A.2d 622, 625 (N.J. Super. Ct. 1984) (“We likewise find to be a public figure a professional jockey who chooses to perform publicly in a sport which commands widespread public interest, and regarding which the communications media regularly report.”). Even if they are not, the story of “Ruffian” is a matter of public concern such that

Plaintiffs must prove some fault on the part of Defendants in publishing the allegedly defamatory statements. Lake Park Post, Inc. v. Farmer, 264 Ga. App. 299, 300, 590 S.E.2d 254, 257 (2003). The parties may wish to conduct discovery on this element of the defamation claim.

D. Standing of Plaintiff Thoroughbred Legends, LLC

Now that the court has dismissed the claims of trademark infringement, the remaining claims of false endorsement and defamation pertain only to individual Plaintiffs Mr. Whiteley and Mr. Vasquez. The court is inclined to dismiss Thoroughbred Legends, LLC as a plaintiff in this lawsuit. However, in the event Plaintiffs disagree with that assessment, the court will give Plaintiffs an opportunity to show cause as to why Thoroughbred Legends, LLC should remain a part of this action.

IV. Summary

For the foregoing reasons, the Motion for Summary Judgment [Doc. No. 46] is GRANTED as to all claims of trademark infringement. The former Motion to Dismiss Plaintiffs' Amended Complaint [Doc. No. 34] is GRANTED IN PART AND DENIED IN PART. Specifically, the court GRANTS the Motion as to Counts Five and Six of Plaintiffs' Second Amended Complaint, and DENIES it as to the false

endorsement claims contained within Counts Two and Three and the defamation claim in Count Four.

The Motion for Discovery [Doc. No. 55] is likewise GRANTED IN PART AND DENIED IN PART. The court DENIES the Motion for Discovery as to the claims it has dismissed, and GRANTS it as to the remaining claims. A four-month discovery period on the claims remaining in this action will begin as of the date of this Order and is will conclude on June 11, 2008.

The court further ORDERS Plaintiffs to show cause within ten days of the date of this Order as to why Thoroughbred Legends, LLC, should remain a part of this action, if Plaintiffs are so inclined. If Plaintiffs do not respond within ten days, the court will DISMISS Thoroughbred Legends, LLC, as a plaintiff in this action.

IT IS SO ORDERED, this 12th day of February, 2008.

s/Beverly B. Martin
BEVERLY B. MARTIN
UNITED STATES DISTRICT JUDGE