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UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF CALIFORNIA

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GENERAL CHARLES E. "CHUCK"
YEAGER (RET.),

Plaintiff,

v.

CINGULAR WIRELESS LLC;
BELLSOUTH; SBC COMMUNICATIONS;
AMERICAN TELEPHONE &
TELEGRAPH; and DOES 1 to 200,
inclusive,

Defendants.

NO. CIV. S-07-2517 FCD GGH

MEMORANDUM AND ORDER

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This matter is before the court on defendant AT&T Mobility
LLC's¹ ("defendant" or "AT&T") motion to dismiss plaintiff
General Charles E. Yeager's ("plaintiff" or "Yeager") complaint
pursuant to Rule 12(b)(6) of the Federal Rules of Civil

¹ On March 27, 2008, pursuant to the parties'
stipulation, the court ordered that AT&T Mobility, LLC be
substituted as defendant and that all other named defendants were
dismissed without prejudice. (Stip. & Order [Docket #12], filed
Mar. 27, 2008.)

1 Procedure. Plaintiff opposes the motions. For the reasons set
2 forth below,² defendant's motion is DENIED.

3 **BACKGROUND**

4 Plaintiff Yeager is a retired General Officer of the United
5 States Air Force. (Compl., filed Nov. 21, 2007, ¶ 5.) He served
6 in the Air Force during World War II as a fighter pilot, flying
7 P-51 Mustangs. (Id.) During one mission, Yeager was shot down,
8 evaded capture, and aided local resistance forces. (Id.) He
9 escaped from behind enemy lines to American control and resumed
10 his duties. (Id.) He is one of the few American fighter pilots
11 to become an "ace in a day," by downing five enemy fighters in
12 one mission. (Id.)

13 After World War II, Yeager became a test pilot. (Id. ¶ 6.)
14 In that capacity, he became the first person to break the speed
15 of sound, known as Mach 1. (Id.) Shortly thereafter, he became
16 the first person to exceed 2.4 times the speed of sound, known as
17 Mach 2. (Id.) He subsequently set and/or broke additional
18 aviation and speed records. (Id.) He has been featured,
19 recognized, and honored for his accomplishments by persons and
20 entities such as Marshall University, the State of West Virginia,
21 President Ford, the National Aviation Hall of Fame, President
22 Reagan, and the Aerospace Walk of Honor. (Id.)

23 Yeager has utilized his name, identity, and image. (Id. ¶
24 8.) He served as a spokesman for AC Delco Corp., which saw its
25 sales increase as a result of the use of his name, likeness,
26

27 ² Because oral argument will not be of material
28 assistance, the court orders this matter submitted on the briefs.
See E.D. Cal. L.R. 78-230(h).

1 identity, and endorsement. (Id.) He has spoken to various
2 groups, organizations, and committees. (Id.) He has been
3 featured on the cover of numerous magazines as a result of his
4 actions, status, and historical activities. (Id.) Yeager
5 charges and receives a fee for the commercial use of his name,
6 image, and/or identity, and charges for any endorsements of
7 products or companies. (Id.)

8 On approximately May 17, 2006, defendant³ issued an
9 advertising/promotional article (the "publication") styled as a
10 "Press Release." (Id. ¶ 14.) The publication was intended to
11 highlight the reliability, durability, and security of
12 defendant's cellular communications network. (Id.) It focused
13 upon defendant's launching of a new service designed to respond
14 to disaster or emergencies to ensure the continued provision of
15 cellular service. (Id.) Specifically, the publication provides,
16 in relevant part:

17 Nearly 60 years ago, the legendary test pilot Chuck
18 Yeager broke the sound barrier and achieved Mach 1.
19 Today, Cingular is breaking another kind of barrier
20 with our MACH 1 and MACH 2 mobile command centers,
which will enable us to respond rapidly to hurricanes
and minimize their impact on our customers.

21 (Id. ¶ 15; Ex. 1 to Compl.) Plaintiff alleges that by utilizing
22 his name and identity in the article, defendant impaired his
23 ability to negotiate representation agreements with other
24 cellular and wireless service providers. (Id. ¶ 18.)

25
26 ³ The complaint alleges that defendant Cingular Wireless
27 LLC issued the material, but the Stipulation and Order was based
28 upon plaintiff's reliance upon express representations that
defendant AT&T was responsible for the publication of the
material that is the subject of this action. (Stip & Order
[Docket #12].)

1 Plaintiff brings claims for (1) violation of the Lanham Act,
2 15 U.S.C. § 1125(a); (2) violation of California common law right
3 to privacy/right to control publicity and likeness; (3) violation
4 of California Civil Code § 3344; (4) unjust enrichment; (5)
5 violation of California Business and Professions Code § 17200;
6 and (6) violation of California False Advertising Act. Defendant
7 moves to dismiss all of plaintiff's claims.

8 STANDARD

9 On a motion to dismiss, the allegations of the complaint
10 must be accepted as true. Cruz v. Beto, 405 U.S. 319, 322
11 (1972). The court is bound to give plaintiff the benefit of
12 every reasonable inference to be drawn from the "well-pleaded"
13 allegations of the complaint. Retail Clerks Int'l Ass'n v.
14 Schermerhorn, 373 U.S. 746, 753 n.6 (1963). Thus, the plaintiff
15 need not necessarily plead a particular fact if that fact is a
16 reasonable inference from facts properly alleged. See id.

17 Nevertheless, it is inappropriate to assume that the
18 plaintiff "can prove facts which it has not alleged or that the
19 defendants have violated the . . . laws in ways that have not
20 been alleged." Associated Gen. Contractors of Calif., Inc. v.
21 Calif. State Council of Carpenters, 459 U.S. 519, 526 (1983).
22 Moreover, the court "need not assume the truth of legal
23 conclusions cast in the form of factual allegations." United
24 States ex rel. Chunie v. Ringrose, 788 F.2d 638, 643 n.2 (9th
25 Cir. 1986).

26 Ultimately, the court may not dismiss a complaint in which
27 the plaintiff has alleged "enough facts to state a claim for
28 relief that is plausible on its face." Bell Atlantic Corp. v.

1 Twombly, 127 S. Ct. 1955, 1974 (2007). Only where a plaintiff
2 has not “nudged [his or her] claims across the line from
3 conceivable to plausible,” is the complaint properly dismissed.
4 Id. “[A] court may dismiss a complaint only if it is clear that
5 no relief could be granted under any set of facts that could be
6 proved consistent with the allegations.” Swierkiewicz v. Sorema
7 N.A., 534 U.S. 506, 514 (2002) (quoting Hudson v. King &
8 Spalding, 467 U.S. 69, 73 (1984)).

9 ANALYSIS

10 Defendant moves to dismiss plaintiff’s claims on the basis
11 that (1) the reference to plaintiff’s name is protected by the
12 First Amendment; (2) plaintiff’s trademark claims fail as a
13 matter of law; (3) the reference to plaintiff’s name was
14 incidental and constituted permissible fair use; and (4) all his
15 remaining claims are substantially congruent and thus, also fail
16 as a matter of law.

17 A. First Amendment

18 Defendant first contends that the use of plaintiff’s name in
19 the publication is protected by the First Amendment because the
20 material was a “news release” and addresses a matter of public
21 interest. Plaintiff contends that the publication was not news,
22 but commercial speech that sought to capitalize upon plaintiff’s
23 popularity, recognition, and appeal.

24 The use of a plaintiff’s identity is not actionable where
25 the publication relates to matters of the public interest, “which
26 rests on the right of the public to know and the freedom of the
27 press to tell it.” Downing v. Abercrombie & Fitch, 265 F.3d 994,
28 1001 (9th Cir. 2001) (quoting Montana v. San Jose Mercury News,

1 Inc., 34 Cal. App. 4th 790, 793 (1995)). "The First Amendment
2 defense extends 'to almost all reporting of recent events,' as
3 well as to publications about 'people who, by their
4 accomplishments, mode of living, professional standing, or
5 calling, create a legitimate and widespread attention to their
6 activities.'" Id. (quoting Eastwood v. Superior Court, 149 Cal.
7 App. 3d 409, 422 (1983)). However, under both Ninth Circuit and
8 California law, commercial speech is actionable when a
9 "plaintiff's identity is used, without consent, to promote an
10 *unrelated* product" of a defendant. Gionfriddo v. Major League
11 Baseball, 94 Cal. App. 4th 400, 413 (2001) (citing Newcombe v.
12 Adolf Coors Co., 157 F.3d 686, 691-94 (9th Cir. 1998); Abdul-
13 Jabbar v. Gen. Motors Corp., 85 F.3d 407, 416 (9th Cir. 1996);
14 Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1097-98 (9th Cir. 1992);
15 White v. Samsung Electronic Am., Inc., 971 F.2d 1395, 1396 (9th
16 Cir. 1992); Midler v. Ford Motor Co., 849 F.2d 460, 461 (9th Cir.
17 1988)). Where the use of a plaintiff's identity in an
18 advertisement is merely illustrative of a commercial theme or
19 product and does not contribute significantly to a matter of
20 public interest, a defendant cannot avail itself of the First
21 Amendment defense. Downing, 265 F.3d at 1002-03 (holding that
22 the First Amendment defense was inapplicable where the use of
23 plaintiff's photograph was used "essentially as window-dressing
24 to advance the catalog's" theme).

25 In this case, plaintiff alleges that defendant's publication
26 was an "advertising/promotional article styled as a 'Press
27 Release" and was intended to highlight the reliability,
28 durability, and security of defendant's cellular communications

1 network. (Compl. ¶ 14.) On a motion to dismiss, the court must
2 take as true plaintiff's allegation that the article, although
3 titled as a "news release," was really an advertisement. Viewing
4 the allegations in the light most favorable to the plaintiff and
5 drawing all reasonable inferences therefrom, the complaint
6 sufficiently alleges that defendant used plaintiff's name and
7 reputation for its own advantage to promote an unrelated product
8 or theme. These allegations are not contradicted on their face
9 by the text of the publication attached to the complaint.⁴

10 Defendant argues in both its moving papers and reply brief
11 that the publication is a news release on emergency preparedness
12 and thus, asks the court to make a determination that it is
13 entitled to First Amendment protection as a matter of law. At
14 this stage of the litigation, where the court may only look at
15 the allegations in the complaint and must view those allegations
16 in the light most favorable to the plaintiff, the court cannot
17 make such a determination. Nor has defendant cited the court any
18 case where a court has made such a determination on a motion to
19 dismiss. Therefore, in light of the procedural posture of this
20 motion and the allegations set forth in the complaint, the court
21 cannot find that defendant may avail itself of the First
22 Amendment defense as a matter of law.⁵

23
24 ⁴ The court notes that it is not making a finding, as a
25 matter of law, regarding the nature or interpretation of the
26 publication. Rather, the court merely notes that, on a motion to
dismiss, the publication could be read consistently with
plaintiff's allegations.

27 ⁵ The court also notes that defendant is not precluded
28 from raising these arguments at a later stage in the litigation
where the court would apply a different standard of review and
may properly consider evidence.

1 **B. Trademark**

2 Defendant also contends that plaintiff's trademark claims
3 fail as a matter of law because his achievements in breaking the
4 sound barrier are within the public domain. Plaintiff contends
5 that he has sufficiently alleged a claim under the Lanham Act, 15
6 U.S.C. § 1525(a), through defendant's unauthorized use of his
7 name and identity in connection with the alleged advertisement.

8 A false endorsement claim is actionable under the Lanham Act
9 where a party can show that the use of any false or misleading
10 representation of fact is "likely to deceive consumers as to the
11 association, sponsorship, or approval of goods or services by
12 another person." Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1107
13 n.7 (9th Cir. 1992); 15 U.S.C. § 1525(a). In order to prevail on
14 a false endorsement claim, a plaintiff must demonstrate that the
15 alleged advertisement created a likelihood of confusion over
16 whether the plaintiff was endorsing defendant's product. White
17 v. Samsung Electronics Am., Inc., 971 F.2d 1395, 1399-1400 (9th
18 Cir. 1992) (internal citations omitted).

19 In this case, plaintiff alleges that the use of plaintiff's
20 name and identity was both unauthorized and likely to cause
21 confusion by consumers as to the affiliation, connection, and/or
22 association of plaintiff with defendants. Viewing the
23 publication in light of plaintiff's allegations, which the court
24 must accept as true, plaintiff has sufficiently stated a claim
25 for false endorsement in violation of the Lanham Act.

26 Defendant argues that plaintiff's achievement in breaking
27 the sound barrier is a matter common to all and thus, plaintiff
28 does not have an actionable interest in the publication.

1 Defendant relies primarily on the Ninth Circuit's decision in
2 Nancy Ann Storybook Dolls, Inc. v. Dollcraft, Co., 197 F.2d 293
3 (9th Cir. 1952). However, the facts of Nancy Ann are clearly
4 distinguishable from the facts alleged in plaintiff's complaint.
5 In Nancy Ann, the plaintiff, a marketer of dolls, brought suit
6 against a competing manufacturer, asserting that it was
7 infringing its trademarks in the names Storybook, Goldilocks,
8 Little Bo-Peep, June Girl, Mistress Mary, Little Miss Donnett,
9 Red Riding Hood, Little Miss Muffett, and Story. 197 F.2d at
10 295. The Ninth Circuit noted that the names for which the
11 plaintiff sought protection identified "characters well-known in
12 the literature of childhood for scores of years" and that those
13 names were descriptive of those characters, not the output of the
14 plaintiff. Id. The court further noted that manufacturers
15 cannot reach into the public domain and appropriate portions for
16 their exclusive use. Id. Therefore, the court held that the
17 plaintiff did not have an actionable trademark claim.

18 Conversely, in this case, plaintiff's interest in his name
19 and identity was created by his own actions. None of the
20 allegations in the complaint support defendant's analogy that
21 plaintiff is attempting to take a name or identity that has
22 already passed into the public domain and appropriate it for his
23 own use. As such, at this stage in the litigation, defendant's
24 argument that plaintiff does not have an actionable interest in
25 his name and identity under the Lanham Act is unavailing.

26 **C. Defenses**

27 Defendant next contends that the use of plaintiff's name in
28 the publication is not actionable because the use was merely

1 incidental, and because it constituted permissible fair use.
2 Plaintiff argues that defendant's alleged defenses are premature
3 and should not be considered on a motion to dismiss.

4 On a motion to dismiss, the court's analysis is limited to
5 facts alleged in the pleadings, and all reasonable inferences
6 must be construed in the light most favorable to the plaintiff.
7 See Cruz, 405 U.S. at 322; Schermerhorn, 373 U.S. at 753 n.6. In
8 this context, the court generally agrees that it would be highly
9 unusual for a court to dismiss a complaint on the basis that a
10 defendant has proven an affirmative defense. Designer Skin, LLC
11 v. S&L Vitamins, Inc., CV 05-3699, 2007 WL 841471 (D. Ariz. Mar.
12 19, 2007). However, where the court can discern from the face of
13 the pleadings that an affirmative defense applies as a matter of
14 law, dismissal pursuant to Rule 12(b)(6) may be appropriate. See
15 Weisbach v. County of Los Angeles, 119 F.3d 778, 783 n.1 (9th
16 Cir. 1997) ("A plaintiff may plead herself out of court.")
17 (quotations and citation omitted).

18 **1. Incidental Use**

19 Defendant contends that plaintiff's claims fail because
20 defendant's reference to plaintiff in the publication constituted
21 incidental use.⁶ "Whether the incidental use doctrine is

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23 ⁶ It is not clear from defendant's motion and the cases
24 cited in support of this argument whether it is asserting
25 incidental use as a defense to only plaintiff's Lanham Act and
26 California False Advertising Act claims or to all of plaintiff's
27 claims. Incidental use is generally raised as a defense to
28 claims based on right of publicity or misappropriation of name or
likeness. See Pooley v. National Hole-In-One Ass'n, 89 F. Supp.
2d 1108 (D. Ariz. 2000); Henley v. Dillard Dept. Stores; 46 F.
Supp. 2d 587 (N.D. Tex. 1999); see also Restatement (Second) of
Torts § 652C, comment d. However, because as set forth, *infra*,
the court cannot determine that this defense applies at this
stage in the litigation, the court will assume that defendant is

1 applicable is determined by the role that the use plays with
2 respect to the entire publication." Id. The rationale for the
3 incidental use defense is that an incidental use has no
4 commercial value. Pooley v. National Hole-In-One Ass'n, 89 F.
5 Supp. 2d 1108, 1112 (D. Ariz. 2000). Generally, "a plaintiff's
6 name is not appropriated by mere mention of it." Restatement
7 (Second) of Torts § 652C, comment *d*. Moreover, a claim may not
8 be actionable when the value of a plaintiff's likeness is not
9 appropriated because "it is published for purposes other than
10 taking advantage of his reputation, prestige, or other value
11 associated with him." Id.

12 Plaintiff has alleged that the reference to plaintiff was
13 made for defendant's "pecuniary gain and profit," was done to
14 support defendant's "business activities," and is "directly
15 related to the goods and services" defendant provides. (Compl.
16 ¶¶ 24, 40.) When plaintiff's allegations are given the benefit
17 of every reasonable inference, and these allegations are read in
18 conjunction with the publication, plaintiff has sufficiently pled
19 that defendant's reference to plaintiff in the publication was
20 made to take advantage of his reputation, prestige, and value
21 associated with him, and thus, not incidental.⁷ Moreover,
22 defendant has failed to cite any case where, on a motion to
23 _____
24 asserting incidental use as a defense to all of plaintiff's
25 claims.

26 ⁷ The court again notes that it is not making a finding,
27 as a matter of law, regarding the interpretation of the
28 publication. The court also notes that defendant is not
precluded from raising these arguments at a later stage in the
litigation where the court would apply a different standard of
review and may properly consider evidence.

1 dismiss, a court has dismissed a claim based upon the
2 applicability of the incidental use defense. See Seale v.
3 Gramercy Pictures, 964 F. Supp. 918 (E.D. Pa. 1997) (summary
4 judgment); Vinci v. American Can Co., 591 N.E.2d 793 (Ohio 1990)
5 (same). Therefore, the court cannot determine as a matter of law
6 that defendant's reference to plaintiff in the publication was
7 merely incidental and thus, not actionable.

8 **2. Permissible Fair Use**

9 Defendant also contends that its reference to plaintiff in
10 the publication constitutes nominative fair use. The Ninth
11 Circuit has distinguished between two types of fair use:
12 "'classic fair use,' in which 'the defendant has used the
13 plaintiff's mark to describe the defendant's own product,' and
14 'nominative fair use,' in which the defendant has used the
15 plaintiff's mark 'to describe the plaintiff's product' for the
16 purpose of, for example, comparison to the defendant's product."
17 Cairns v. Franklin Mint Co., 292 F.3d 1139, 1150 (9th Cir. 2002)
18 (citing New Kids on the Block v. New Am. Publ'g, Inc., 971 F.2d
19 302, 308 (9th Cir. 1992)). The nominative fair use defense is
20 applicable "where the use of a trademark does not attempt to
21 capitalize on consumer confusion or to appropriate the cachet of
22 one product for a different one." New Kids on the Block, 971
23 F.2d at 307-08.⁸ As such, nominative fair use "does not
24 implicate the source-identification function that is the purpose
25 of the trademark." Id. at 308. Accordingly, "it does not

26
27 ⁸ Unlike incidental use, nominative fair use has often
28 been applied as a specific defense to claims under the Lanham
Act. See New Kids, 971 F.2d at 306; Abdul Jabbar, 85 F.3d at 412.

1 constitute unfair competition; such use is fair because it does
2 not imply sponsorship or endorsement by the trademark holder."

3 Id.

4 To establish whether the use of a mark constitutes
5 nominative fair use, a defendant must meet three requirements:

6 First, the product or service in question must be one
7 not readily identifiable without use of the trademark;
8 second, only so much of the mark or marks may be used
9 as is reasonably necessary to identify the product or
10 service; and third, the user must do nothing that
11 would, in conjunction with the mark, suggest
12 sponsorship or endorsement by the trademark holder.

10 Id.

11 Defendant contends that, with respect to the third element,
12 nothing in the publication suggests that plaintiff sponsors,
13 endorses or has ever benefitted from any of defendant's products
14 or services. To support this contention, defendant argues that
15 only one reference to plaintiff was made in the publication, that
16 the reference was not made in connection with any product or
17 service that was for sale, and that the publication was not an
18 advertisement.

19 In his complaint, however, plaintiff has alleged that the
20 publication is an "advertising/promotional article." (Id. at ¶
21 14.) Moreover, plaintiff has also alleged that the reference to
22 him in the publication:

23 constituted a false or misleading description of fact
24 or misrepresentation of fact that is likely to cause
25 confusion to consumers, and deceives consumers as to
the affiliation, connection and/or association of
Plaintiff with Defendants.

26 (Compl. ¶ 41.) These allegations are not contradicted by other
27 allegations in the complaint or the publication itself.

28 Therefore, the court cannot find as a matter of law that

1 defendant's reference to plaintiff in the publication makes no
2 suggestion of sponsorship or endorsement by plaintiff. Thus,
3 defendant's assertion that the nominative fair use defense
4 applies is premature.⁹

5 **D. Plaintiff's Remaining Claims**

6 Finally, defendant contends that plaintiff's claims for
7 violation of California Business and Professions Code § 17200,
8 violation of California False Advertising Act, and unjust
9 enrichment must be dismissed because they are substantially
10 congruent to plaintiff's other claims. Because, as set forth
11 above, the court finds defendant's prior arguments unpersuasive,
12 defendant's motion to dismiss the remaining state law claims is
13 also DENIED.

14 **CONCLUSION**

15 Therefore, for the foregoing reasons, defendant's motion to
16 dismiss is DENIED.

17 IT IS SO ORDERED.

18 DATED: June 12, 2008



19
20 FRANK C. DAMRELL, Jr.
UNITED STATES DISTRICT JUDGE

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22
23 ⁹ Since the test for nominative fair use is conjunctive,
24 all elements must be met for the defense to apply. See New Kids,
25 971 F.2d at 308. Therefore, it is not necessary at this time for
the court to discuss the other elements.

26 Further, defendant has again failed to cite any case where,
27 on a motion to dismiss, a court has dismissed a claim based upon
the nominative fair use. See New Kids, 971 F.2d 302 (summary
28 judgment); Abdul-Jabbar, 85 F.3d 407 (same); Cairns, 292 F.3d
1139 (same); Wham-O, Inc. v. Paramount Pictures, Corp., 286 F.
Supp. 2d 1254 (N.D. Cal. 2003) (temporary restraining order).