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**UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEW JERSEY**

ROBERT KIRKMAN, LLC,

Plaintiff,

v.

PHILLIP THEODOROU, STEVEN
THEODOROU, ANNA THEODOROU, and
MOHAMED ELKADY

Defendants.

Case No. 3:15-cv-08474-MAS-DEA

**PLAINTIFF'S MEMORANDUM OF LAW IN SUPPORT
OF ITS MOTION FOR SUMMARY JUDGMENT AS TO LIABILITY**

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Plaintiff Robert Kirkman, LLC (“Kirkman”) commenced this action to stop Defendants’ attempt to hijack for themselves a wide range of merchandising rights for Kirkman’s groundbreaking THE WALKING DEAD entertainment property. Kirkman moves for summary judgment in its favor on the issue of liability on its trademark claims against Defendants Phillip Theodorou, Steven Theodorou, Anna Theodorou and Mohamed Elkady.¹

PRELIMINARY STATEMENT

Trademark law protects the consuming public from being misled about the source, affiliation, or approval of goods and services and protects brand owners from having their intangible goodwill appropriated by others. This case presents a classic example of trademark infringement and dilution that the law was designed to prohibit—and the kind of unabashed, continuing piratical activity that should be stopped.

Kirkman is the owner of all trademark rights arising from use of the mark THE WALKING DEAD in connection with the seminal comic book series created by its founder, Robert Kirkman, and with AMC’s ground-breaking television series based on the comics—the highest rated program in the history of cable television, with more viewers than *The Sopranos*, *Mad Men*, *Game of Thrones*, *Sex and the City*, or *Breaking Bad*. Kirkman and its licensees have also created successful merchandising programs under THE WALKING DEAD mark for both the comic series and television series, offering a wide range of goods and services that the consuming public has come to associate with these well-known entertainment properties. As a result, THE WALKING DEAD trademark has become a household name, a famous trademark with a broad reach throughout the United States. Kirkman also owns federal registrations for

¹ This motion is made pursuant to Magistrate Judge Arpert’s order dated March 2, 2016. As referenced in the order, the parties have agreed that no discovery is necessary in connection with this motion. (ECF No. 31.)

THE WALKING DEAD mark for comics, the television series, and other goods and services.

Defendants, on the other hand, are interlopers who developed a business plan to usurp the renown built up by Kirkman and adopt THE WALKING DEAD as a trademark for goods and services of their own. Under false pretenses, Defendants over two years have filed eleven (11) separate trademark applications with the United States Patent and Trademark Office to register THE WALKING DEAD and have taken concrete steps to use the mark in commerce by raising money and preparing to open a restaurant in New Jersey under the mark. Defendants' applications have also caused Kirkman's own, legitimate applications for THE WALKING DEAD to be blocked in the U.S. Patent and Trademark Office, creating commercial hurdles for its own licensing business. Defendants are acting *pro se*.

Kirkman brought this suit and brings this motion to put Defendants' illicit activities to a stop under the U.S. Trademark (Lanham) Act of 1946, which prohibits the use and registration of any mark that (i) is likely to cause confusion as to source, affiliation or connection with a pre-existing mark of another party (trademark infringement or unfair competition), or (ii) is likely to dilute the ability of a famous mark to uniquely identify the trademark owner or its goods and services (dilution by blurring). As set forth herein, Kirkman is entitled to relief under both theories, and there are no facts in dispute which could lead to any other result. Accordingly, summary judgment should be granted in Kirkman's favor.

STATEMENT OF FACTS

A. Kirkman's THE WALKING DEAD Comic Book Series

In 2003, Robert Kirkman created a comic book series called THE WALKING DEAD, which chronicles the lives of survivors of a zombie apocalypse. (Declaration of Robert Kirkman ("Kirkman Dec."), ¶¶ 3-4.) Since its creation, Kirkman has continuously used THE WALKING

DEAD trademark (“THE WALKING DEAD Mark”) to identify the award-winning comic series. (*Id.* ¶¶ 5-6 & Ex. A thereto.) THE WALKING DEAD comic series is now in its 13th year of publication, and has been frequently republished in trade paperbacks, hardcovers, including collectors’ editions, and limited omnibus editions. (*Id.* ¶ 9.) The series has been critically acclaimed and is among the top selling comic series in the United States. (*Id.* ¶¶ 7-8.)

In addition, Kirkman, on its own and through its direct licensees, markets an array of merchandise based on THE WALKING DEAD comic book series, including but not limited to collected comic editions, novels, lunch boxes, figurines, vinyl toys, vinyl replica props, foam dart blasters, card games, board games, statues, adhesive bandages, collector tins, coin banks, ice trays, gelatin molds, handbags, tote bags, wallets, key chains, belt buckles, phone cases, bottle openers, bobble heads, puzzles, knives, swords, gold balls, coffee, beer, dog tags, wrapping paper, lamps, book ends, stickers, pins/buttons, blankets, towels, cardboard standees, mousepads, Halloween costumes, makeup kits, lanyards, beer koozys, magnets, patches and fabric bolts. (Kirkman Dec. ¶ 10.)

B. AMC’s THE WALKING DEAD Television Series

In 2009, Kirkman entered into a license with AMC Network Entertainment LLC (“AMC”) to create and produce a television series based on THE WALKING DEAD comics (hereinafter the “TV Series”).² (Kirkman Dec. ¶ 12; Declaration of Charlie Collier (“Collier

² The agreement between Kirkman and AMC gives AMC an exclusive right to use THE WALKING DEAD Mark in connection with TV Series-related uses, including merchandise. (Kirkman Dec. ¶ 13; Collier Dec. ¶ 12.) As a result, at one time certain trademark applications for THE WALKING DEAD Mark were filed by Kirkman, while others were filed by AMC. In August 2014, based in part on the realization of both Kirkman and AMC that, despite this delineation in the 2009 agreement, there were opportunities to sell and license certain types of merchandise for both *The Walking Dead* comic series and the TV Series, the parties clarified their respective rights as trademark licensor (Kirkman) and licensee (AMC) in an agreement

Dec.”) ¶ 3.) The TV Series premiered on the AMC network in October 2010. (Collier Dec. ¶ 4.) The TV Series is based on THE WALKING DEAD comic series and, like the comic books, tracks the lives of survivors living in a world overrun by zombies and the struggles of those survivors to adapt to a violent and dangerous environment. (*Id.* ¶ 5.) Since the premiere of the TV Series, THE WALKING DEAD Mark has been extensively used and promoted by AMC, under license from Kirkman, in connection with the TV Series and a wide array of TV Series-related goods, services and events. (*Id.* ¶¶ 6, 11.)

The TV Series has achieved immense popularity among the viewing public, and has the highest total viewership of any series in cable television history. (Collier Dec. ¶ 7.) The October 2014 premiere of Season 5 of the TV Series was viewed by 17.3 million viewers, making it the most-watched television series episode in cable history. (*Id.*) Season 6 of the TV Series recently premiered as the top-rated program in its time slot, ahead of many over-the-air network programs including NBC’s *Sunday Night Football*. (*Id.*) The popularity of the TV Series has spawned a companion series, titled FEAR THE WALKING DEAD, and a talk show, titled TALKING DEAD, both of which air on the AMC network and are successful programs in their own right. (*Id.* ¶ 9.)

The TV Series has also garnered significant critical acclaim and awards. (Collier Dec. ¶ 8.) Among other awards, the TV Series was named one of the top 10 television programs of 2010 and 2012 by the American Film Institute and has received multiple Emmy and People’s Choice awards. (*Id.*) The TV Series has also been nominated for a number of additional awards, including the Writers Guild of America Award for Television (Best New Series) and the Golden Globe Award for Best Television Series (Drama). (*Id.*)

confirming Kirkman’s sole ownership of any trademark applications and registrations for THE WALKING DEAD Mark. (Kirkman Dec. ¶ 13; Collier Dec. ¶ 12.)

In addition, through AMC, its corporate affiliates and sublicensees, Kirkman has marketed an array of TV Series-related goods and services under THE WALKING DEAD Mark, including, but not limited to, t-shirts, sweatshirts, shorts, onesies, flip-flops, and other apparel; mugs and glassware; pens; household furnishings; jewelry; bags and luggage tags; action figures; food; construction sets; trivia games; dart boards; video games; guitars; and dog collars. (Collier Dec. ¶ 11 & Ex. B thereto.)

C. Kirkman's Registrations and Application for THE WALKING DEAD Mark

As a result of Kirkman's use, sales, marketplace success, and significant investment in advertising and promotion, THE WALKING DEAD Mark has developed tremendous renown and significance in the minds of the United States consuming public and has become a strong and famous trademark identifying Kirkman's goods and services exclusively. As such, THE WALKING DEAD Mark represents enormous goodwill and is an extremely valuable asset of Kirkman.

In addition to the common law rights built up in THE WALKING DEAD Mark through this more than a decade of use, Kirkman also owns numerous U.S. trademark registrations for THE WALKING DEAD Mark that cover a wide variety of products and services, including the following:

- U.S. Registration No. 4,007,681, registered on August 2, 2011, for "DVDs featuring an on-going fictional dramatic television program" in International Class 9 and "Entertainment services in the nature of an on-going fictional dramatic television series; providing information about a television series via an on-line global computer network; providing online computer games" in International Class 41, based on first use in interstate commerce in March 2011 and October 2010, respectively;
- U.S. Registration No. 4,314,918, registered on April 2, 2013, for "Video recordings featuring fictional dramatic television programming and music; sound recordings featuring fictional dramatic television programming and music; downloadable computer games; interactive video game programs; computer game cartridges and discs; downloadable computer game software for use with mobile telephones and

personal computers; downloadable multimedia file containing artwork, text, audio, video, games, and internet web links relating to music and television; electronic game programs; electronic game software for cellular telephones; electronic game software for handheld electronic devices; electronic game software for wireless devices; slot machines; video game cartridges and discs; video game software” in International Class 9, based on first use in interstate commerce in August 2012;

- U.S. Registration No. 4,429,084, registered on November 5, 2013, for “Fan club services” in International Class 41 based on first use in interstate commerce in September 2010; and
- U.S. Registration No. 4,443,715, registered on December 3, 2013, for “Comic books; Graphic novels” in International Class 16 based on first use in interstate commerce in October 2003.

(Kirkman Dec. ¶ 14 & Ex. C.)

Kirkman also owns a pending use-based trademark application, U.S. trademark Application Serial No. 86/145,914 (the “Kirkman Application”), covering the following goods for THE WALKING DEAD Mark, all based on first use dates going back to 2011 or 2012:

- “Books relating to a dramatic television series, poster books, bookends, posters, art prints, photographs, trading cards, calendars, stickers, bumper stickers, pens, greeting cards, paper party favors, paperweights” in International Class 16;
- “Busts made of resins, plastics, polyresin, gypsum, polyurethane, wax, wood, fabric and mixed media consisting of the foregoing materials; statues made of resins, plastics, polyresin, gypsum, polyurethane, wax, wood, fabric and mixed media consisting of the foregoing materials; sculptures of resins, plastics, polyresin, gypsum, polyurethane, wax, wood, fabric and mixed media consisting of the foregoing materials; figurines made of resins, plastics, polyresin, gypsum, polyurethane, wax, wood, fabric and mixed media consisting of the foregoing materials; picture frames; plastic key chains; non-metal and non-leather key chains” in International Class 20;
- “Clothing, shirts, t-shirts, sweatshirts, jackets, sleepwear, loungewear, bathrobes, beachwear, underwear, socks, infantwear, headwear, footwear, belts, head wraps, Halloween costumes, masquerade costumes, costume accessories, namely, novelty wigs” in International Class 25; and
- “Parlour games, party games, tabletop games, board games, card games, action skill games, target games, dart games, puzzles, action figures, toy figures, bobblehead dolls, amusement game machines, pinball and pinball-type games, costume masks,

lottery tickets, toy vehicles, toy weapons, toy model and replica weapons, costume accessories, namely, weapon props, fake scars” in International Class 28.

(Kirkman Dec. ¶ 15 & Ex. D.)

Finally, the United States Patent and Trademark Office (“USPTO”) has found Kirkman’s THE WALKING DEAD Mark to be a famous trademark. Specifically, just last month in rejecting registration of an unrelated third party’s attempt to register the mark FEAR THE WALKING DEAD for clothing and bags, the USPTO proclaimed:

[THE WALKING DEAD] *is quite famous*. In this regard . . . Internet excerpts establish[] that that “THE WALKING DEAD” is 1) a television show about zombies that is based on a graphic novel, and 2) *the show is quite famous in the U.S.* with each episode viewed by millions. Moreover, information from the www.fortune.com website says, “The resulting zombie fever has spawned two successful TV spinoffs, several best-selling books, webisodes, games, merchandise, tourism and more—each success fueling the other.”

. . . . Famous marks are afforded a broad scope of legal protection because they are more likely to be remembered and associated in the public mind than a weaker mark. Moreover, when present, the fame of a mark is a dominant factor in the likelihood of confusion analysis

Because it is common for providers of entertainment goods/services to also provide related goods and memorabilia and because [THE WALKING DEAD] mark in the cited [Kirkman] registrations in this case *is, in fact, famous*, it is likely that consumers would be confused as to the source of applicant’s goods.

(Declaration of James D. Weinberger, Esq. (“Weinberger Dec.”) ¶ 2 & Ex. A at 6-7) (all internal citations and quotation marks omitted and all emphases added).

D. Defendants’ Infringing Conduct

1. Defendants’ Applications to Register THE WALKING DEAD

Defendants have embarked on a comprehensive effort to (i) usurp THE WALKING DEAD Mark and associated goodwill for their own benefit for use in connection with a large number of goods and services without any authorization from Kirkman, and (ii) interfere with Kirkman’s ability to use and protect its THE WALKING DEAD Mark in connection with its legitimate goods and services. Defendants have never been associated or affiliated with Kirkman

in any way and Kirkman has never authorized or otherwise licensed Defendants' use of the Infringing Mark in connection with any products or services in the United States or elsewhere. (Kirkman Dec. ¶ 16.)

Specifically, on December 2, 2013, Defendants Anna Theodorou and Phillip Theodorou filed U.S. trademark Application Serial No. 86/133,235 with the USPTO to register THE WALKING DEAD (the "Infringing Mark") based on an intent to use that mark in connection with a wide array of clothing items in International Class 25. (Weinberger Dec. ¶ 3 & Ex. B.) In its filing of this application, Defendants Anna and Phillip Theodorou attested, under oath, that they had "a bona fide intention to use . . . the mark in commerce on or in connection with the identified goods and/or services." (*Id.*, Ex. B at 4.) In response to an Office Action from the USPTO, Defendants Anna and Phillip Theodorou amended this application to cover only "t-shirts." (*Id.* ¶ 3.)

Following that initial filing, Defendants proceeded to pursue a broad-based filing program, filing numerous additional unauthorized trademark applications for the Infringing Mark in the USPTO for a wide range of additional goods and services, as set forth below:

- On January 16, 2014, Defendants Anna Theodorou and Phillip Theodorou filed U.S. Application Serial No. 86/166,802 to register the Infringing Mark based on an intent to use that mark in connection with "Restaurant services and themed restaurant services, namely, providing of food and beverages for consumption on and off the premises" in International Class 44. (Weinberger Dec. ¶ 4 & Ex. C.)
- On February 1, 2014, Defendants Anna Theodorou and Phillip Theodorou filed U.S. Application Serial No. 86/181,789 to register the Infringing Mark based on an intent to use that mark in connection with hundreds of food and beverage items in International Class 30. (*Id.* ¶ 5 & Ex. D.) In response to an Office Action from the USPTO, Defendants Anna and Phillip Theodorou amended this application to cover only "coffee." (*Id.* ¶ 5.)
- On February 4, 2014, Defendants Anna Theodorou and Phillip Theodorou filed U.S. Application Serial No. 86/183,334 to register the Infringing Mark based on an intent to use that mark in connection with hundreds of beverage products in International Class 32. (*Id.* ¶ 6 & Ex. E.) In response to an Office Action from the USPTO,

Defendants Anna and Phillip Theodorou amended this application to cover only “bottled water.” (*Id.* ¶ 6.)

- On March 30, 2014, Defendants Phillip Theodorou and Mohamed Elkady filed U.S. Application Serial No. 86/236,569 to register the Infringing Mark based on an intent to use that mark in connection with “Beverage glassware, cups, mugs, drinking glasses” in International Class 21. (*Id.* ¶ 7 & Ex. F.)

In connection with each of these applications, the Defendants named in the application swore under oath to their bona fide intent to use the Infringing Mark in connection with the recited goods. (Weinberger Dec., Exs. C-F at 4.)

On April 7, 2014, Kirkman’s counsel sent a letter to Defendants Anna Theodorou, Phillip Theodorou, and Mohamed Elkady advising them of Kirkman’s rights in THE WALKING DEAD Mark and demanding that they immediately cease their unauthorized attempts to register the Infringing Mark and halt their plans to use the Infringing Mark for the goods and services recited in their pending trademark applications. (Weinberger Dec. ¶ 8 & Ex. G.) Notwithstanding the fact that Defendants were, as of April 7, 2014, on actual notice of Kirkman’s rights in THE WALKING DEAD Mark, Defendants proceeded to file still more applications with the USPTO to register the Infringing Mark for a vast variety of additional goods, again, each time, swearing under oath to a bona fide intention to use the mark in connection with the recited goods. Specifically:

- On May 2, 2014, Defendants Steven Theodorou and Jeffrey Heller filed U.S. Application Serial No. 86/270,745 to register the Infringing Mark based on an intent to use that mark in connection with “Cosmetic products, namely, lipsticks, lip gloss, lip liners, lip balms, eye shadows, eye lining pencils, liquid eye liners, eye makeup, mascara, eyebrow pencils, artificial eyelashes, blushers, bronzers, multi-use cosmetic sticks, foundation makeup, pressed powder, loose powder, makeup remover, concealers, eye make-up palettes, lip gloss palettes, make-up sets, multi-use colored creams, powders and gels for use on face; nail polish, nail enamel, nail polish remover; non-medicated skin care products, namely, cleansers, exfoliators, toners, eye creams, cleansing wipes, moisturizing spritzers, tinted moisturizers; fragrances

for personal use” in International Class 3. (Weinberger Dec. ¶ 9 & Ex. H.)³

- On October 9, 2014, Defendants Steven Theodorou and Phillip Theodorou filed U.S. Application Serial No. 86/418,856 to register the Infringing Mark based on an intent to use that mark in connection with “cigarillos, cigars, ashtrays, match boxes, matches, lighters for smokers” in International Class 34. (*Id.* ¶ 10 & Ex. I.)
- On March 15, 2015, Defendants Steven Theodorou and Phillip Theodorou filed U.S. Application Serial No. 86/564,355 to register the Infringing Mark based on an intent to use that mark in connection with “Candles for lighting; Candles for night lights; Perfumed candles; Scented candles” in International Class 4. (*Id.* ¶ 11 & Ex. J.)
- On July 24, 2015, Defendants Steven Theodorou and Phillip Theodorou filed U.S. Application Serial No. 86/703,323 to register the Infringing Mark based on an intent to use that mark in connection with “Textile shopping bags” in International Class 18. (*Id.* ¶ 12 & Ex. K.)
- On July 24, 2015, Defendants Steven Theodorou and Phillip Theodorou filed U.S. Application Serial No. 86/703,328 to register the Infringing Mark based on an intent to use that mark in connection with “carpets” in International Class 27. (*Id.* ¶ 13 & Ex. L.)

Even the filing of this lawsuit in December 2015 has not deterred Defendants’ efforts to encroach on Kirkman’s trademark rights. Since that time, Defendants have filed two more trademark applications for the Infringing Mark, namely:

- On January 20, 2016, Defendants Steven Theodorou and Phillip Theodorou filed U.S. Application Serial No. 86/880,242 to register the Infringing Mark based on an intent to use that mark in connection with “Eye-shadow; Lipstick” in International Class 3. (Weinberger Dec. ¶ 14 & Ex. M.)
- On January 26, 2016, Defendant Steven Theodorou U.S. Application Serial No. 86/886,161 to register SAVE THE WALKING DEAD based on an intent to use that mark in connection with “shirts” in International Class 25. (*Id.* ¶ 15 & Ex. N.)

Defendants’ unauthorized, blunderbuss trademark filings have directly threatened Kirkman’s ability to fully protect its THE WALKING DEAD Mark. Specifically, various applications by Defendants for the Infringing Mark discussed above have been cited against the Kirkman Application by the USPTO and have thus blocked the Kirkman Application from

³ This application has now been abandoned as part of a settlement between Kirkman and Defendant Heller. (Weinberger Dec. ¶ 25 & Ex. W at ¶¶ 6-8.)

proceeding to registration, thereby interfering with Kirkman's ability to secure the full protection afforded by registration of THE WALKING DEAD Mark for all of the goods set forth in the Kirkman Application. (Weinberger Dec. ¶ 16 & Ex. O; Kirkman Dec. ¶ 15.)

2. *Kirkman's Notices of Opposition in the Trademark Trial and Appeal Board*

Kirkman first responded to Defendants' trademark application filings by filing Notices of Opposition in the Trademark Trial and Appeal Board of the USPTO ("TTAB") against these applications, at significant expense to Kirkman.

On August 20, 2014, Kirkman filed a Notice of Opposition in the TTAB against Application Serial No. 86/166,802, and the proceeding was assigned Opposition No. 91217941. (Weinberger Dec. ¶ 17 & Ex. P.) On August 25, 2014, Kirkman filed a Notice of Opposition against Application Serial Nos. 86/181,789 and 86/183,334, and the proceeding was assigned Opposition No. 91217992. (*Id.* ¶ 18 & Ex. Q.) On September 10, 2014, Kirkman filed a Notice of Opposition against Application Serial No. 86/133,235, and the proceeding was assigned Opposition No. 91218267. (*Id.* ¶ 19 & Ex. R.) On October 3, 2014, Kirkman filed a Notice of Opposition against Application Serial No. 86/270,745, and the proceeding was assigned Opposition No. 91218669. (*Id.* ¶ 20 & Ex. S.) On May 19, 2015, Kirkman filed a Notice of Opposition against Application Serial No. 86/418,856, and the proceeding was assigned Opposition No. 91222005. (*Id.* ¶ 21 & Ex. T.) On July 8, 2015, Kirkman filed a Notice of Opposition against Application Serial No. 86/564,355, and the proceeding was assigned Opposition No. 91222719. (*Id.* ¶ 22 & Ex. U.)

In each of these Notices of Opposition (collectively, the "Notices of Opposition"), Kirkman alleged that THE WALKING DEAD Mark was used and became famous in the United States long before Defendants filed their applications for the Infringing Mark, and that

Defendants' use and registration of the Infringing Mark for the goods and services set forth in Defendants' applications was likely to cause confusion with and to dilute THE WALKING DEAD Mark. These opposition proceedings are suspended by the TTAB pending disposition of this action. (Weinberger Dec. ¶ 23.)

3. Defendants' Impending Use of the Infringing Mark

Despite their clear knowledge of Kirkman's prior rights in THE WALKING DEAD Mark and the knowledge that their use of the Infringing Mark violates such rights, Defendants have taken concrete steps to use the Infringing Mark in connection with a variety of goods and services (and have undertaken extensive planning and development efforts in connection with this intended use).

Specifically, an investigation by Kirkman undertaken before it sent the April 2014 demand letter to Defendants (*supra* at 9), revealed that Defendants are preparing to open a health food restaurant in New Jersey under the Infringing Mark, to be located in either Princeton, New Jersey on or around U.S. Route 206. (Weinberger Dec. ¶ 24 & Ex. V at 1.) Defendants' restaurant will sell custom food items under the Infringing Mark and will sell merchandise under the Infringing Mark. (*Id.*) Defendants have raised money to fund their efforts as well, for example, by obtaining a loan from now-dismissed Defendant Jeffrey Heller in return for a stake in Defendants' business. (*Id.* Ex. W at ¶¶ 3-4, 9.)

Moreover, Defendant Phillip Theodorou owns a screen-printing company called We Print the World, and is capable of commencing the manufacture of products featuring the Infringing Mark—including t-shirts, shopping bags, and other goods for which Defendants have attempted to register the Infringing Mark—on a moment's notice. (Weinberger Dec. Ex. V at 1-2.) Defendants' manufacture and sale of products under the Infringing Mark could be

accomplished—and may already have been accomplished—without Kirkman’s immediate knowledge.

Finally, it must be noted that Defendants Phillip, Anna and Steven Theodorou are not strangers to trademark infringement and disputes—their *modus operandi* appears to be the unlawful appropriation of well-known trademarks and slogans. Specifically, combinations of the Theodorou defendants have filed several applications with the USPTO to register trademarks owned by or associated with well-known individuals and companies, including the hip hop artists the Beastie Boys (NO SLEEP TILL BROOKLYN, the name of their popular song), Donald Trump (MAKE AMERICA GREAT AGAIN), United Trademark Holdings (ZOMBIE CINDERELLA), and the National Hockey League (BROOKLYN ISLANDERS). (Weinberger Dec. ¶ 26 & Ex. X.) Many of these applications have resulted in administrative litigation proceedings in the TTAB by the rightful owners of these trademarks. (*Id.* ¶ 27 & Ex. Y.)

E. Kirkman’s Complaint and Relevant Procedural History

After it became clear Defendants had taken concrete steps to use the Infringing Mark, Kirkman filed its complaint in this action on December 3, 2015 against Defendants Phillip Theodorou, Steven Theodorou, Anna Theodorou, Jeffrey Heller, and Mohamed Elkady. (ECF No. 1 (“Compl.”).)

The Complaint asserts seven causes of action against all Defendants: (1) Federal Trademark Infringement in violation of Section 32(1) of the U.S. Trademark (Lanham) Act, 15 U.S.C. § 1114(1); (2) Federal Unfair Competition in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a); (3) Federal Trademark Dilution in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c); (4) Deceptive and Unfair Trade Practices in violation of New Jersey law, N.J. Stat. §§ 56:8-1 *et seq.*; (5) Trademark Infringement/False Designation of Origin

in violation of New Jersey law, N.J. Stat. §§ 56:3-13.16; (6) Unfair Competition in violation of New Jersey statutory and common law, N.J. Stat. §§ 56:4-1; and (7) a Declaratory Judgment that any use by Defendants of THE WALKING DEAD Mark constitutes a violation of Kirkman's rights pursuant to the Declaratory Judgment Act, 28 U.S.C. § 2201. (Compl. ¶¶ 51-90.)

Defendants Phillip, Steven and Anna Theodorou answered the Complaint on February 11, 2016. (ECF No. 19.) Defendant Elkady answered the Complaint on March 28, 2016. (ECF No. 35.) Kirkman voluntarily dismissed all claims against Defendant Heller on March 7, 2016, (ECF No. 33), after the application on which Heller was listed as a co-owner was abandoned (*see supra* at fn. 3) and after Heller signed an agreement and affidavit affirming that he would not assist any of the remaining Defendants with their planned use of the Infringing Mark or file any new applications to register THE WALKING DEAD. (Weinberger Dec., Ex. W at ¶ 7.)

On March 1, 2016, the Court held an Initial Scheduling Conference, which was attended by counsel for Kirkman and Defendants Steven and Phillip Theodorou and Defendant Elkady. (ECF No. 29). During the conference, "all parties agreed that no discovery is required prior to the filing of dispositive motions" and, thus, Magistrate Judge Arpert set a briefing schedule for the instant motion for summary judgment. (ECF No. 31.)

ARGUMENT

"The court shall grant summary judgment if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law." FED. R. CIV. P. 56(a); *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986). At the summary judgment stage, the role of the court is to determine whether there is a genuine dispute concerning a material fact that requires a trial and, if there is not, to enter summary judgment as the law dictates. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248-49 (1986). "When the moving

party has carried its burden under Rule 56(c), its opponent must do more than simply show that there is some metaphysical doubt as to the material facts.” *Matsushita Electric Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586 (1986). Rather, the opposing party must set forth specific facts showing a genuine dispute of material fact requiring a trial and may not rest upon the mere allegations or denials of its pleadings. *Sound Ship Bldg. Corp. v. Bethlehem Steel Co.*, 533 F.2d 96, 99 (3d Cir. 1976).

“In trademark infringement and unfair competition cases, courts in the [Third] Circuit have not been hesitant to grant summary judgment” where there is no genuine dispute of material fact and the plaintiff has established a likelihood of confusion as a matter of law. *Trade Media Holdings, Ltd. v. Huang & Assocs.*, 123 F. Supp. 2d 233, 237 (D.N.J. 2000) (granting summary judgment for plaintiff as to liability for trademark infringement and unfair competition); *see also Microsoft Corp. v. CMOS Techs., Inc.*, 872 F. Supp. 1329, 1333 (D.N.J. 1994) (same). This is in keeping with the Supreme Court’s admonition that summary judgment is “an integral part of the Federal Rules as a whole, which are designed ‘to secure the just, speedy and inexpensive determination of every action.’” *Celotex*, 477 U.S. at 327 (quoting FED. R. CIV. P. 1).

Here, there are no facts in dispute, let alone any genuine disputes as to a material fact.

I. DEFENDANTS ARE LIABLE FOR FEDERAL TRADEMARK INFRINGEMENT

“The law of trademark protects trademark owners in the exclusive use of their marks when use by another would be likely to cause confusion.” *Interpace Corp. v. Lapp, Inc.*, 721 F.2d 460, 462 (3d Cir. 1983). To prevail on a federal trademark infringement claim under Section 32 of the Lanham Act, a plaintiff must establish that (1) its trademark is valid and legally protectable; (2) it owns its trademark and; (3) the defendants’ use of an identical or confusingly similar mark to identify their goods or services is likely to create confusion about the origin of

the defendants' goods or services or about the sponsorship, affiliation, or approval of defendants' goods and services. *Ford Motor Co. v. Summit Motor Prods.*, 930 F.2d 277, 291 (3d Cir. 1991). Kirkman has established all three elements of this claim as a matter of law.

A. THE WALKING DEAD is a Valid and Protectable Trademark

A "certificate of registration issued by the United States Patent and Trademark Office constitutes prima facie evidence of the validity and ownership of a disputed mark and is therefore sufficient to establish the first and second elements" of a federal trademark infringement claim. *E.A. Sween Co. v. Deli Express of Tenafly, L.L.C.*, 19 F. Supp. 3d 560, 568 (D.N.J. 2014) (citing 15 U.S.C. §§ 1057(b), 1115(a)). Here, Kirkman has submitted its USPTO registrations for THE WALKING DEAD Mark, showing that this mark is registered and owned by Kirkman. (Kirkman Dec. ¶ 14 & Ex. C.) This satisfies the first two elements of its trademark infringement and unfair competition claims. Thus, the only inquiry is whether there is a likelihood of confusion.

B. There is a Likelihood of Confusion

In deciding whether similar marks create a likelihood of confusion, Courts in the Third Circuit examine the following ten non-exhaustive factors, known as the "*Lapp* factors":

- (1) the degree of similarity between the plaintiff's mark and the defendants' allegedly infringing mark;
- (2) the strength of the plaintiff's mark;
- (3) the price of the goods and services offered by the parties, and other factors indicative of the care and attention expected of consumers when making a purchase;
- (4) the length of time the defendants have used their mark without evidence of actual confusion;
- (5) the intent of the defendants in adopting their allegedly infringing mark;
- (6) the evidence of actual confusion;

- (7) whether the goods and services, though not competing, are marketed through the same channels of trade and advertised through the same media;
- (8) the extent to which the targets of the parties' sales efforts are the same;
- (9) the relationship of the goods in the minds of consumers because of the similarity of functions; and
- (10) other facts suggesting that the consuming public might expect the prior owner to manufacture a product in the defendants' market or that they are likely to expand into that market.

A & H Sportswear, Inc. v. Victoria's Secret Stores, Inc., 237 F.3d 198, 211 (3d Cir. 2000) (citing *Lapp*, 721 F.2d at 463). Importantly, the Third Circuit has explained that “[n]ot all factors will be relevant in all cases” and that “the different factors may properly be accorded different weights depending on the particular factual setting.” *Id.* at 215. “Proof of actual confusion is not necessary; likelihood is all that need be shown.” *Opticians Ass’n of Am. v. Indep. Opticians of Am.*, 920 F.2d 187, 195 (3d Cir. 1990)

Here, realistically, the Court need examine only three *Lapp* factors—similarity of the marks (Factor One), the strength of Kirkman’s THE WALKING DEAD Mark (Factor Two), and similarity of the parties’ goods and services (Factor Nine)—to determine there is a likelihood of confusion as a matter of law, since this examination reveals that Defendants are using an *identical* mark to Kirkman’s *famous* THE WALKING DEAD Mark on goods that are *identical or competitive* to the goods offered by Kirkman and on goods that consumers would expected to be licensed by Kirkman. (*Infra* at 20-24.) That is a textbook example of when confusion is likely.

As the Third Circuit has noted, in words equally apt here:

Cases where a defendant uses an identical mark on competitive goods hardly ever find their way into the appellate reports. *Such cases are ‘open and shut’* and do not involve protracted litigation to determine liability for trademark infringement.

Opticians Ass’n, 920 F.2d at 195 (quoting 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:3 (2d ed. 1984)) (emphasis added). This being said, the other *Lapp* factors either also weigh in Kirkman’s favor or, at worst, are neutral.

1. The Parties’ Marks are Identical

“The single most important factor in determining likelihood of confusion is mark similarity.” *A & H Sportswear*, 237 F.3d at 216. This factor weighs in favor of a plaintiff when the parties’ marks “create the same overall impression.” *Id.* (citation omitted). Overall impression is created by the sight, sound, and meaning of the marks. *Id.*

Here, the parties’ marks are *identical*—both parties use THE WALKING DEAD. Thus, the marks create an *identical* overall commercial impression—*i.e.*, the marks look identical, they sound identical, and they mean the same thing. This is enough in and of itself to find a likelihood of confusion as a matter of law. As the Third Circuit has held: “Likelihood of confusion *is inevitable*, when, as is the case here, the identical mark is used concurrently by unrelated entities.” *Opticians Ass’n*, 920 F.2d at 195 (emphasis added).

Accordingly, there can be no question that this critical first *Lapp* factor weighs heavily (if not dispositively) in favor of Kirkman and a likelihood of confusion.

2. Kirkman’s THE WALKING DEAD Mark is a Strong Mark

The second factor looks to “the strength of the [plaintiff’s] mark.” *Lapp*, 721 F.2d at 463. “Under the Lanham Act, stronger marks receive greater protection” because they “carry greater recognition, [so that] a similar mark is more likely to cause confusion.” *A & H Sportswear*, 237 F.3d at 222. The strength of a mark has two aspects: “(1) the distinctiveness or conceptual strength of the mark and (2) the commercial strength or marketplace recognition of the mark.” *Id.* at 221 (citations omitted).

The first inquiry—conceptual strength—is determined by the plaintiff’s mark’s placement into one of four categories of distinctiveness: (1) generic; (2) descriptive; (3) suggestive; or (4) arbitrary or fanciful. *Sabinsa Corp. v. Creative Compounds, L.L.C.*, 609 F.3d 175, 184-85 (3d Cir. 2010). Arbitrary or fanciful marks use terms that neither describe nor suggest anything about the product (*e.g.*, KODAK for cameras). *Id.* Suggestive marks require consumer imagination, thought, or perception to determine what the product is (*e.g.*, COPPERTONE for suntan lotion). *Id.* Descriptive marks convey an immediate idea of the ingredients, qualities or characteristics of the goods (*e.g.*, SECURITY CENTER for security or safety services). *Id.* Generic marks function as the common descriptive name of a product class (*e.g.*, DIET CHOCOLATE SODA). *Id.*

Arbitrary and suggestive marks “are deemed ‘inherently distinctive’, and thus, are entitled to the highest level of protection” and are considered conceptually strong. *MNI Mgmt., Inc. v. Wine King, L.L.C.*, 542 F. Supp. 2d 389, 405 (D.N.J. 2008). THE WALKING DEAD Mark is suggestive, since it requires consumer imagination, thought, or perception to determine that the mark refers to zombies. This is confirmed by Kirkman’s federal trademark registrations, which establish this level of protection presumptively. 15 U.S.C. §§ 1057(b), 1115(a).

The second inquiry—commercial strength—“looks to factual evidence of ‘marketplace recognition.’” *A & H Sportswear*, 237 F.3d at 221. Here, there is ample evidence of the commercial strength of Kirkman’s THE WALKING DEAD Mark in the marketplace. The comic book series bearing THE WALKING DEAD Mark has been offered for more than a decade with sales in the millions of dollars and critical acclaim. (Kirkman Dec. ¶¶ 5-8.) The similarly-acclaimed TV Series is the most popular program in the history of cable television, watched by millions of people weekly. (Collier Dec. ¶¶ 6-8.) Both Kirkman and AMC have successful

merchandising programs for THE WALKING DEAD Mark. (Kirkman Dec. ¶¶ 10-11; Collier Dec. ¶ 11.) And the USPTO agrees, finding THE WALKING DEAD mark to be “quite famous.” (Weinberger Dec. ¶ 2, Ex. A at 6.)

Accordingly, Kirkman’s THE WALKING DEAD Mark is conceptually and commercially strong and, thus, this critical *Lapp* factor also weighs in favor of a finding of likelihood of confusion, since Defendants have copied a famous trademark. *Checkpoint Sys., Inc. v. Check Point Software Techs., Inc.*, 269 F.3d 270, 282 (3d Cir. 2001) (“If a second comer adopts a mark substantially identical to a strong mark, there is a correspondingly high likelihood that consumers will mistakenly associate the newcomer’s product with the owner of the strong mark.”) (citation omitted). This also means that the mark is given a broad scope of protection, extending well beyond the particular goods and services for which it has been used to date. *See, e.g., Caesars World, Inc. v. Caesar’s Palace*, 490 F. Supp. 818, 827 (D.N.J. 1980) (“[E]xtended protection is given to a mark which has become very strong, usually due to a substantial economic investment.”)

3. The Parties’ Goods and Services are Identical or Sufficiently Related

When examining the ninth *Lapp* factor, courts determine “how similar, or closely related, the [parties’] products are.” *Sabinsa*, 609 F.3d at 189 (citation omitted). “The closer the relationship between the products, the greater the likelihood of confusion.” *Lapp*, 721 F.2d at 462. In the end, the “question is whether the consumer might . . . reasonably conclude that one company would offer both of these related products.” *Sabinsa*, 609 F.3d at 189.

Here, many of the goods Defendants have used or intend to use the Infringing Mark on are identical or competitive with goods Kirkman offers under its THE WALKING DEAD Mark. For example:

- Kirkman, through licensee AMC, offers clothing and t-shirts bearing THE WALKING DEAD Mark, (Collier Dec. ¶ 11 & Ex. B), and owns a pending application to register THE WALKING DEAD in International Class 25 for clothing, including-shirts. (Kirkman Dec. ¶ 15 & Ex. D.) Defendants have applied to register THE WALKING DEAD for t-shirts. (Weinberger Dec. ¶ 3 & Ex. B.)
- Kirkman offers coffee and coffee-related merchandise bearing THE WALKING DEAD Mark. (Kirkman Dec. ¶ 10.) Defendants have applied to register THE WALKING DEAD for coffee. (Weinberger Dec. ¶ 6 & Ex. C.)
- Kirkman offers make-up kits bearing THE WALKING DEAD Mark. (Kirkman Dec. ¶ 10.) Defendants have applied to register THE WALKING DEAD for cosmetics (Weinberger Dec. ¶ 9 & Ex. H.)
- Kirkman, through licensee AMC, offers mugs and glassware bearing THE WALKING DEAD Mark. (Collier Dec. ¶ 11 & Ex. B.) Defendants have applied to register THE WALKING DEAD for beverage glassware and mugs. (Weinberger Dec. ¶ 7 & Ex. F.)

Defendants' use of the identical THE WALKING DEAD mark on goods identical and/or competitive to goods offered by Kirkman, without question creates a likelihood of confusion and is an "open and shut" case. *Opticians Ass'n*, 920 F.2d at 195.

Moreover, even if any of the remaining goods and services Defendants have applied for are not considered "competitive" to those goods or services for which Kirkman or its licensees have used THE WALKING DEAD Mark to date—*e.g.*, bottled water, cigars and ashtrays, candles, restaurants, and carpets (*supra* at 8-10)—use of the Infringing Mark for such goods and services can and does create a likelihood of confusion because consumers expect *entertainment property marks* like THE WALKING DEAD Mark to be licensed for a broad range of so-called collateral items. *See, e.g., Estate of Presley v. Russen*, 513 F. Supp. 1339, 1369 (D.N.J. 1981) ("[D]irect competition or identity of services or products is not required to prove likelihood of confusion.") Thus, consumers will believe (erroneously) that Kirkman has approved of, sponsored, or licensed the use of its famous THE WALKING DEAD Mark in connection with collateral merchandise and services like the ones offered or intended to be offered by

Defendants. As the leading trademark treatise explains:

Just as an entertainment or literary title can be strong enough to prevent use of the title in another type of literary medium, *so also can it prevent confusing use of the title on articles of merchandise.* There is clearly no competition between such things as books and movies on the one hand and wearing apparel and toys on the other. However, competition is not the touchstone. Rather than pure confusion of source of the goods being the ground, *confusion as to sponsorship, connection or affiliation is at issue.* Probable confusion as to sponsorship, connection or affiliation is sufficient for infringement.

2 *McCarthy on Trademarks and Unfair Competition* § 10:18 (4th ed. 2016) (emphases added).

As the treatise goes on to explain: “With the advent of mass-marketing of licensed merchandise marked with the titles and characters of motion pictures and television programs, consumers young and old are accustomed to assuming a licensing link between all such products and the associated movie or television program.” *Id.*

Indeed, as the USPTO noted in rejecting a third-party’s attempt to register the FEAR THE WALKING DEAD mark: “[I]t is common for providers of television shows and movies to also provide a variety of related goods and memorabilia.” (Weinberger Dec. ¶ 2 & Ex. A at 7); *see also Gen. Mills Fun Grp., Inc. v. Tuxedo Monopoly, Inc.*, 204 U.S.P.Q. 396, 400 & n.5 (T.T.A.B. 1979) *aff’d*, 648 F.2d 1335, 1336 (C.C.P.A. 1981)⁴ (“[I]t is a matter of common knowledge that famous marks are frequently used on certain types of items, such as clothing, glassware, trash cans, pillows, etc., which are unrelated in nature to those goods on which the marks are normally used; such use has become a part of everyday life which we cannot ignore.”).

Courts have consistently applied the above legal principles to prevent a defendant from using a trademarked title of a television program or film or a character name on a variety of seemingly unrelated merchandise and services. For example, in *Conan Properties, Inc. v.*

⁴ The U.S. Court of Customs and Patent Appeals is the predecessor to the U.S. Court of Appeals for the Federal Circuit.

Conans Pizza, Inc., 752 F.2d 145 (5th Cir. 1985), the Court affirmed a verdict of trademark infringement where a defendant was operating a pizza restaurant under the name CONANS, holding this was an infringement of the trademarked character name CONAN THE BARBARIAN. In rejecting the defendant’s assertion “that no reasonable person could have believed that restaurants were related to [plaintiff’s] CONAN THE BARBARIAN” mark, the Court stated, in words equally applicable here:

Although [plaintiff] never licensed any entity to use its mark in connection with restaurant services, ordinary consumers may well believe that [defendant’s] CONANS restaurant was in fact licensed by [plaintiff]. [N]umerous cartoon and other characters have been used in extensive licensing programs to promote everything from children’s toys to fast-food restaurants.

Id. at 150; *see also Universal City Studios, Inc. v. Mueller Chem. Co.*, 223 U.S.P.Q. 798, 799 (N.D. Ill. 1983) (plaintiff owner of JAWS movie title granted summary judgment to stop infringing use of JAWS on a tape cutter tool).

Likewise, the Trademark Trial and Appeal Board refused to register an applicant’s mark GILLIGAN’S ISLAND for suntan lotion on the basis of likely confusion with the trademarked television series title GILLIGAN’S ISLAND. *Turner Entm’t Co. v. Nelson*, 38 U.S.P.Q.2d 1942, 1943 (T.T.A.B. 1996). In so holding, the TTAB explained: “The licensing of commercial trademarks for use on ‘collateral’ products (such as clothing, glassware, linens, etc.), which are unrelated in nature to those goods or services on which the marks are normally used, has become a common practice in recent years.” *Id.* at 1944.

This same rationale applies here. Both Kirkman and its licensee AMC have licensed the use of THE WALKING DEAD Mark on a wide variety of seemingly unrelated merchandise—from flip-flops to pens, jewelry to dart boards, guitars to dog collars, adhesive bandages to gelatin molds, key chains to coffee, and mouse pads to beer koozys. (*Supra* at 3, 5.) Given the

fame of THE WALKING DEAD Mark and the wide variety of collateral merchandise Kirkman and AMC have already licensed under this entertainment mark, consumers will naturally (but incorrectly) believe that all of the goods and service offered or intended to be offered by Defendants under the identical mark are authorized by Kirkman. *See Conan Props.*, 752 F.2d at 150. This *Lapp* factor clearly weighs in favor of finding a likelihood of confusion.

4. The Other *Lapp* Factors Favor Kirkman or Are Neutral

The remaining *Lapp* factors also weigh in Kirkman's favor or have no bearing on this case. As to the fourth *Lapp* factor—length of time the Defendants' have used the mark without evidence of actual confusion—this factor is neutral since Defendants' use of the Infringing Mark has been minimal and largely preparatory and, thus, there has not been an appreciable opportunity for actual confusion to occur. *See, e.g., Hasbro, Inc. v. Braintrust Games, Inc.*, 2009 WL 4085621, at *10 (T.T.A.B. Aug. 24, 2009) (finding defendant's use of its mark to be "minimal" when less than 1,000 potential consumers had seen the mark and, thus, the absence of any actual confusion was entitled to no weight in the likelihood of confusion analysis). Similarly, as to the sixth *Lapp* factor—evidence of actual confusion—it is well-established that "[p]roof of actual confusion is not necessary," so this factor is also neutral. *Opticians Ass'n*, 920 F.2d at 195.

As to the fifth *Lapp* factor—Defendants' intent in adopting the Infringing Mark—the Third Circuit has explained that "[e]vidence of a defendant's intent is not a prerequisite for finding a Lanham Act violation." *Sabinsa*, 609 F.3d at 187. However, if there is evidence of bad faith—that is, evidence that Defendants adopted the mark with the intention of causing confusion and capitalize on the goodwill of the trademark owner—"such evidence weighs . . . heavily in favor of finding a likelihood of confusion." *Id.* Here, it strains credulity for Defendants to claim they did not choose the Infringing Mark in order to capitalize on the fame and goodwill associated with THE WALKING DEAD Mark and to confuse consumers. Moreover,

Defendants’ bad faith intent can be inferred from their pattern of filing other applications to register, for themselves, other parties’ well-known political slogans (MAKE AMERICA GREAT AGAIN), film titles (ZOMBIE CINDERELLA), song titles (NO SLEEP TILL BROOKLYN), and sports teams (BROOKLYN ISLANDERS)—most of which have led to litigation before the TTAB by the rightful owner of these marks. (Weinberger Dec. ¶¶ 26-27.) This is clearly Defendants’ *modus operandi* and supports a finding of bad faith intent. *See, e.g., Universal City Studios*, 223 U.S.P.Q. at 799 (bad faith intent found where Defendant’s “past business practices” showed that Defendant had made a habit of “exploit[ing] famous or recognizable name[s] or mark[s]”); *L’Oreal S.A. v. Marcon*, 102 U.S.P.Q.2d 1434, 1441-42 (T.T.A.B. 2012) (“[Defendant’s] demonstrated pattern of filing applications to register various well-known marks convinces us that [his] adoption of the L’OREAL PARIS mark was in bad faith, with the intention to trade off of [plaintiff’s] famous L’OREAL and L’OREAL PARIS marks.”)

As to the seventh *Lapp* factor—whether the parties’ goods, though not competing, are marketed through the same channels of trade and advertised in the same media—this factor weighs in Kirkman’s favor. First, as discussed above, the parties’ goods *do* compete and, given the fame of THE WALKING DEAD Mark and the expectation of consumers that they will see famous entertainment marks like THE WALKING DEAD on a wide variety of collateral merchandise, *all* of the goods and services Defendants propose to use the Infringing Mark for will compete with Kirkman. Second, Kirkman and its licensees advertise and promote THE WALKING DEAD Mark, comic series, and TV Series across every media possible—internet, television, print, signage, etc. (Collier Dec. ¶ 6 & Ex. A; Kirkman Dec. ¶ 11.) Thus, any media used by Defendants to promote their Infringing Mark will overlap with the media used by Kirkman.

Finally, as to the eighth *Lapp* factor—whether the parties target the same consumers—this clearly weighs in favor of a likelihood of confusion. The parties’ target consumers are the exact same, namely, fans of THE WALKING DEAD comic series or TV Series.

In sum, Defendants are using an identical mark to Kirkman’s strong and famous THE WALKING DEAD mark on goods that are identical to and/or competitive or related to the goods upon which Kirkman uses its THE WALKING DEAD Mark. This is the type of “open and shut” trademark infringement case that should not lead to “protracted litigation.” *Opticians Ass’n*, 920 F.2d at 195 (citation and internal quotation marks omitted). Accordingly, summary judgment should be granted to Kirkman on its federal trademark infringement claim.⁵

II. DEFENDANTS ARE LIABLE FOR FEDERAL DILUTION

The federal cause of action for trademark dilution under Section 43(c) of the Lanham Act “grants extra protection to strong, well-recognized marks even in the absence of a likelihood of consumer confusion . . . if the defendant’s use diminishes or dilutes the strong identification value associated with the plaintiff’s famous mark.” *Times Mirror Magazines, Inc. v. Las Vegas Sports News, L.L.C.*, 212 F.3d 157, 163 (3d Cir. 2000). To prevail on a claim for dilution, a plaintiff must prove that: (1) the plaintiff is the owner of a famous trademark; (2) the defendants are making use of a trademark; (3) the defendants’ use of their mark began after the plaintiff’s mark became famous; and (4) the defendants’ use “causes dilution by lessening the capacity of

⁵ Because Defendants are liable for federal trademark infringement under Section 32(1) of the Lanham Act, they are also liable for federal unfair competition under Section 43(a) of the Lanham Act. *A & H Sportswear*, 237 F.3d at 210 (“We measure federal trademark infringement, 15 U.S.C. § 1114, and federal unfair competition, 15 U.S.C. § 1125(a)(1)(A), by identical standards”). And because they are liable for infringement and unfair competition under the Lanham Act, they are also liable for infringement and unfair competition under the statutory and common law of New Jersey. *J & J Snack Foods, Corp. v. Earthgrains Co.*, 220 F. Supp. 2d 358, 374 (D.N.J. 2002) (“[T]he elements for a claim for trademark infringement under the Lanham Act are the same as the elements for . . . claims of trademark infringement and unfair competition under New Jersey statutory and common law”)

the plaintiff's mark to identify and distinguish goods or services." *Id.* Kirkman has proven each of these elements as a matter of law.

A. THE WALKING DEAD Mark is a Famous Trademark

The Lanham Act defines a "famous" mark as that which is "widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner." 15 U.S.C. § 1125(c)(2)(A). Factors to consider in determining whether a mark has achieved fame include: (1) the duration, extent, and geographic reach of advertising and publicity of the mark; (2) the amount, volume, and geographic extent of sales of goods or services offered under the mark; (3) the extent of actual recognition of the mark by the public; and (4) whether the mark is registered with the USPTO. 15 U.S.C. § 1125(c)(2)(A)(i)-(iv).

As discussed above, Kirkman's THE WALKING DEAD Mark is registered with the USPTO and has achieved substantial and widespread commercial recognition. (*Supra* at 3-6.) The TV Series is the most watched cable television show of all time—seen weekly by millions of consumers. (*Supra* at 4.) It has been nominated for and won many major awards. (*Supra* at 4.) Kirkman and its licensees have devoted substantial resources to advertise and promote services and goods sold under the mark. (*Supra* at 19-20.) These efforts, and the use of the mark, are nationwide.

In light of these undisputed facts, THE WALKING DEAD Mark is famous. Indeed, the USPTO has already found THE WALKING DEAD Mark is "quite famous." (Weinberger Dec. ¶ 2 & Ex. A at 6.)

B. THE WALKING DEAD Mark Became Famous Long Before Defendants Made Use of the Infringing Mark

As to the second and third elements of a dilution claim, it cannot be disputed that Defendants are using or intending to use a trademark in commerce—they have applied to register

THE WALKING DEAD with the USPTO *eleven (11) separate times*, each application supported by a sworn declaration of their “bona fide” intent to use the Infringing Mark in commerce, and they have taken clear steps to open their business. (*Supra* at 8-10.) And Kirkman’s THE WALKING DEAD Mark was certainly famous well before Defendants filed their first application to register THE WALKING DEAD in December 2013. (*Supra* at 8.)

C. Defendants’ Mark Dilutes Kirkman’s Famous THE WALKING DEAD Mark

“‘[D]ilution by blurring’ is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.” 15 U.S.C. § 1125(c)(2)(B). In determining whether a mark is likely to cause dilution by blurring, the Court considers (i) the degree of similarity between the parties’ marks, (ii) the degree of inherent or acquired distinctiveness of Kirkman’s THE WALKING DEAD mark, (iii) the extent to which Kirkman is engaging in substantially exclusive use of THE WALKING DEAD Mark, and (iv) the degree of public recognition of THE WALKING DEAD Mark. *Id.*

Here, the marks are *identical*. As discussed above, Kirkman’s THE WALKING DEAD Mark is inherently distinctive and has acquired massive amounts of public recognition. (*Supra* at 19-20.) And Kirman’s use THE WALKING DEAD Mark has been substantially exclusive.

Accordingly, this is a clear-cut case of dilution by blurring. Indeed, as one Court in this District recently observed in entering judgment in favor of plaintiff on a dilution claim, dilution by blurring “may be inferred from the fact that Defendant has used [plaintiff’s] exact mark to promote and sell the same sort of products promoted and sold under [plaintiff’s] marks.” *E.A. Sween*, 19 F. Supp. 3d at 574. That is the case here, too. Summary judgment should be entered for Kirkman on its federal dilution claim.

III. IN THE ALTERNATIVE TO FINDINGS OF INFRINGEMENT AND DILUTION, KIRKMAN IS ENTITLED TO A DECLARATORY SUMMARY JUDGMENT

Based in part on the lack of clarity in their pleading, it is conceivable that Defendants will respond to this motion by arguing that they have not actually made use the Infringing Mark on all the goods identified in their applications and, thus, cannot be liable for infringement or the other related causes of action discussed above. While Kirkman disagrees with this position, even assuming no such actual use has been made, it is clear Defendants have taken preparatory steps that evidence a concrete intention to use the Infringing Mark on the applied-for goods, which entitles Kirkman to a declaratory judgment notwithstanding the purported lack of use.

Under *MedImmune, Inc. v. Genentech, Inc.*, a declaratory judgment is appropriate where the parties have a dispute that is “definite and concrete, touching the legal relations of parties having adverse legal interests,” which calls for “specific relief through a decree of a conclusive character, as distinguished from an opinion advising what the law would be upon a hypothetical state of facts.” 549 U.S. 118, 126-27 (2007). In short, where the alleged infringer has taken “specific” steps that “evidence a concrete intention to use” the mark in question, not simply stated “a vague or general desire” to use the mark at issue, a Court can render a declaratory judgment. *Starter Corp. v. Converse, Inc.*, 84 F.3d 592, 596-97 (2d Cir. 1996), *abrogated on other grounds by MedImmune*, 549 U.S. 118 (2007). That is the case here.

Defendants have taken specific steps that evidence a concrete intention to use the Infringing Mark. Among other things, they have filed numerous trademark applications, and they have taken out loans for their planned business under the Infringing Mark. (*Supra* at 8-13.) Moreover, Defendants have specific, concrete plans to open a restaurant under THE WALKING DEAD mark, and defendant Phillip Theodorou owns a printing company specializing in t-shirts and other promotional items called We Print The World, meaning that he has a platform to

immediately launch the sales of infringing products. *Gelmart Indus., Inc. v. Eveready Battery Co.*, 120 F. Supp. 3d 327, 332-33 (S.D.N.Y. 2014) (capability of manufacturing products is a factor in establishing declaratory judgment jurisdiction).

Accordingly, there is an actual case or controversy between the parties such that Kirkman is entitled a declaratory judgment that Defendants' intended use of THE WALKING DEAD constitutes infringement, unfair competition, and dilution (for all of the reasons cited above in Sections I and II, above, which demonstrate that Defendants are liable for infringement, unfair competition and dilution).

CONCLUSION

For the foregoing reasons, judgment should be entered in favor of Plaintiff as to liability on its claims.

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