

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

AM GENERAL LLC,

Plaintiff,

v.

ACTIVISION BLIZZARD, INC.,
ACTIVISION PUBLISHING, INC., and
MAJOR LEAGUE GAMING CORP.,

Defendants.

CASE NO. 1:17-cv-08644-GBD

**MEMORANDUM OF LAW IN SUPPORT OF MOTION OF DEFENDANTS
ACTIVISION BLIZZARD, INC., ACTIVISION PUBLISHING, INC.,
AND MAJOR LEAGUE GAMING CORP. FOR SUMMARY JUDGMENT**

TABLE OF CONTENTS

	<u>Page</u>
INTRODUCTION	1
FACTUAL BACKGROUND.....	3
ARGUMENT	12
I. THE FIRST AMENDMENT BARS AMG’S CLAIMS.	13
A. The Second Circuit Long Has Given First Amendment Protection To The Use Of Trademarks In Expressive Works.	14
B. Activision’s Contextual Depiction Of Humvees And Descriptive Use Of The Words “Humvee” and “HMMWV” Easily Meet The <i>Rogers</i> Test.	16
C. There Is No Serious Likelihood Of Consumer Confusion, Far Less The Type of “Compelling” Case Required To Overcome The First Amendment.	24
II. AMG DOES NOT HAVE A PROTECTABLE TRADE DRESS.....	32
A. AMG Humvees Do Not Have A Consistent Overall Look.....	32
B. AMG Cannot Prove That Its Claimed Trade Dress Has Secondary Meaning.....	34
C. AMG Cannot Prove That Its Alleged Trade Dress Is Non-Functional.....	36
III. AMG’S DILUTION CLAIMS FAIL AS A MATTER OF LAW.....	37
IV. AMG’S REMAINING STATE LAW CLAIMS FAIL FOR THE SAME REASONS THAT ITS FEDERAL CLAIMS FAIL.....	38
V. AMG CANNOT RECOVER MONETARY DAMAGES OR PROFITS.....	39
CONCLUSION.....	40

TABLE OF AUTHORITIES

	<u>Page(s)</u>
CASES	
<i>Astra Pharmaceutical Prod. v. Beckman Instruments</i> , 718 F. 2d 1201 (1st Cir. 1983).....	29
<i>Atlantis Silverworks, Inc. v. 7th Sense, Inc.</i> , 1997 WL 128403 (S.D.N.Y. Mar. 20, 1997).....	26
<i>Bleistein v. Donaldson Lithographing Co.</i> , 188 U.S. 239 (1903).....	17
<i>Brown v. Elec. Arts, Inc.</i> , 724 F.3d 1235 (9th Cir. 2013)	<i>passim</i>
<i>Brown v. Entertainment Merchants Ass’n</i> , 564 U.S. 786 (2011).....	16
<i>Capcom Co. v. MKR Group, Inc.</i> , 2008 WL 4661479 (N.D. Cal. Oct. 20, 2008).....	16
<i>Caterpillar Inc. v. Walt Disney Co.</i> , 287 F. Supp. 2d 913 (C.D. Ill. 2003)	24, 26, 40
<i>Centaur Comm., Ltd. v. A/S/M Comm., Inc.</i> , 830 F.2d 1217 (2d Cir. 1987).....	34
<i>Charles Atlas, Ltd. v. DC Comics, Inc.</i> , 112 F. Supp. 2d 330 (S.D.N.Y. 2000).....	32, 39
<i>Church & Dwight Co. v. SPD Swiss Precision Diagnostics GmbH</i> , 2018 WL 4253181 (S.D.N.Y. Sept. 5, 2018).....	40
<i>Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub’g Group</i> , 886 F.2d 490 (2d Cir. 1989).....	<i>passim</i>
<i>Coca-Cola Co. v. Koke Co.</i> , 254 U.S. 143 (1920).....	35
<i>Converse, Inc. v. Int’l Trade Comm’n Skechers U.S.A., Inc.</i> , 909 F.3d 1110 (Fed. Cir. 2018).....	32
<i>Coty Inc. v. Excell Brands, LLC</i> , 277 F. Supp. 3d 425 (S.D.N.Y. 2017).....	19

TABLE OF AUTHORITIES
(continued)

	<u>Page(s)</u>
<i>Cummings v. Soul Train Holdings LLC</i> , 67 F. Supp. 3d 599 (S.D.N.Y. 2014).....	15, 19, 21, 24
<i>Desly Int’l Corp. v. Otkrytoe Aktsionernoe Obshchestvo</i> , 2017 WL 5157614 (E.D.N.Y. Nov. 6, 2017).....	40
<i>Dillinger, LLC v. Elec. Arts Inc.</i> , 2011 WL 2457678 (S.D. Ind. June 16, 2011).....	16, 17, 18, 22
<i>Disney Enters., Inc. v. Nick Sarelli</i> , 322 F. Supp. 3d 413 (S.D.N.Y. 2018).....	23, 30, 38
<i>Dr. Seuss Enterprises, L.P. v. ComicMix LLC</i> , 2018 WL 2306733 (S.D. Cal. May 21, 2018).....	20
<i>E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.</i> , 547 F.3d 1095 (9th Cir. 2008)	15, 17, 20, 39
<i>Elements/Jill Schwartz, Inc. v. Gloriosa Co.</i> , 2002 WL 1492197 (S.D.N.Y. July 15, 2002).....	34
<i>Estee Lauder Inc. v. The Gap, Inc.</i> , 108 F.3d 1503 (2d Cir. 1997).....	25
<i>ETW Corp. v. Jireh Publishing, Inc.</i> , 332 F.3d 915 (6th Cir. 2003)	15, 20, 24
<i>FC Online Mktg., Inc. v. Burke’s Martial Arts, LLC</i> , 2015 WL 4162757 (E.D.N.Y. July 8, 2015).....	25
<i>George Basch Co. v. Blue Coral, Inc.</i> , 968 F.2d 1532 (2d Cir. 1992).....	39
<i>Girl Scouts v. Bantam Doubleday Dell Pub. Group</i> , 808 F. Supp. 1112 (S.D.N.Y. 1992), <i>aff’d</i> , 996 F.2d 1477 (2d Cir. 1993).....	25, 27, 28, 29, 30
<i>Gordon v. Drape Creative, Inc.</i> , 909 F.3d 257 (9th Cir. 2018)	16
<i>Gottlieb Development LLC v. Paramount Pictures Corp.</i> , 590 F. Supp. 2d 625 (S.D.N.Y. 2008).....	19, 26, 39

TABLE OF AUTHORITIES
(continued)

	<u>Page(s)</u>
<i>Hormel Foods Corp. v. Jim Henson Productions, Inc.</i> , 73 F. 3d 497 (2d Cir. 1996).....	28, 29, 31
<i>Inc. Pub. Corp. v. Manhattan Magazine, Inc.</i> , 616 F. Supp. 370 (S.D.N.Y. 1985)	31
<i>Industrial Rayon Corp. v. Dutchess Underwear Corp.</i> , 92 F.2d 33 (2d Cir. 1937).....	12
<i>Kaufman & Fisher Wish Co., Ltd. v. F.A.O. Schwarz</i> , 184 F. Supp. 2d 311 (S.D.N.Y. 2001), <i>aff'd</i> , 51 F. App'x 335 (2d Cir. 2002).....	34
<i>Kregos v. Assoc. Press</i> , 795 F. Supp. 1325 (S.D.N.Y. 1992), <i>aff'd</i> , 3 F.3d 656 (2d Cir. 1993).....	38
<i>Landscape Forms, Inc. v. Columbia Cascade Co.</i> , 113 F.3d 373 (2d Cir.1997).....	33
<i>Lombardo v. Dr. Seuss Enterprises, L.P.</i> , 279 F. Supp. 3d 497 (S.D.N.Y. 2017).....	24, 25, 39
<i>Lopez v. Gap, Inc.</i> , 883 F. Supp. 2d 400 (S.D.N.Y. 2012).....	35
<i>Louis Vuitton Malletier S.A. v. Warner Bros. Entertainment, Inc.</i> , 868 F. Supp. 2d 172 (S.D.N.Y. 2012).....	<i>passim</i>
<i>LVL XIII Brands, Inc. v. Louis Vuitton Malletier S.A.</i> , 209 F. Supp. 3d 612 (S.D.N.Y. 2016), <i>aff'd</i> 720 F. App'x 24 (2d Cir. 2017).....	35
<i>Maharishi Hardy Blechman Ltd. v. Abercrombie & Fitch Co.</i> , 292 F. Supp. 2d 535 (S.D.N.Y. 2003).....	34
<i>Major League Baseball Properties, Inc. v. Opening Day Prods., Inc.</i> , 385 F. Supp. 2d 256 (S.D.N.Y. 2005).....	34
<i>Malaco Leaf, AB v. Promotion In Motion, Inc.</i> , 287 F. Supp. 2d 355 (S.D.N.Y. 2003).....	27
<i>MasterCard Intern. Inc. v. Nader 2000 Primary Committee, Inc.</i> , 2004 WL 434404 (S.D.N.Y. Mar. 8, 2004) (Daniels, J.).....	30, 31
<i>Mattel v. MCA Records, Inc.</i> , 296 F.3d 894 (9th Cir. 2002)	<i>passim</i>

TABLE OF AUTHORITIES
(continued)

	<u>Page(s)</u>
<i>Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.</i> , 875 F.2d 1026 (2d Cir. 1989).....	37
<i>Medina v. Dash Films, Inc.</i> , 2016 WL 3906714 (S.D.N.Y. July 14, 2016).....	15, 21, 39
<i>Mil-Spec Monkey, Inc. v. Activision Blizzard, Inc.</i> , 74 F. Supp. 3d 1134 (2014)	4, 5, 16, 21
<i>Morningside Group Ltd. v. Morningside Capital Group, L.L.C.</i> , 182 F.3d 133 (2d Cir. 1999).....	26
<i>MZ Wallace Inc. v. Fuller</i> , 2018 WL 6715489 (S.D.N.Y. Dec. 20, 2018)	27
<i>New York Racing Ass’n, Inc. v. Perlmutter Pub., Inc.</i> , 959 F. Supp. 578 (N.D.N.Y. 1997).....	17
<i>Nissan Motor Co. v. Nissa Computer Corp.</i> , 2007 WL 9374946 (C.D. Cal. Sept. 21, 2007)	38
<i>NovaLogic, Inc. v. Activision Blizzard</i> , 41 F. Supp. 3d 885 (C.D. Cal. 2013)	<i>passim</i>
<i>Perfect Fit Industries, Inc. v. Acme Quilting Co.</i> , 618 F.2d 950 (2d Cir. 1980).....	39
<i>Philip Morris Inc. v. R. J. Reynolds Tobacco Co.</i> , 1975 WL 21170 (S.D.N.Y. Oct. 24, 1975).....	36
<i>Pirone v. MacMillan, Inc.</i> , 894 F.2d 579 (2d Cir. 1990).....	12
<i>Polaroid Corp. v. Polarad Elecs. Corp.</i> , 287 F.2d 492 (2d Cir. 1961).....	24, 25, 31, 32
<i>Radiance Found. v. NAACP</i> , 786 F.3d 316 (4th Cir. 2015)	37
<i>Rin Tin Tin, Inc. v. First Look Studios, Inc.</i> , 671 F. Supp. 2d 893 (S.D. Tex. 2009).....	21
<i>Rock and Roll Hall of Fame v. Gentile Productions</i> , 134 F.3d 749 (6th Cir. 1998)	26, 34

TABLE OF AUTHORITIES
(continued)

	<u>Page(s)</u>
<i>Rogers v. Grimaldi</i> , 875 F.2d 994 (2d Cir. 1989).....	<i>passim</i>
<i>Sage Realty Corp. v. Sage Grp., Inc.</i> , 711 F. Supp. 134 (S.D.N.Y. 1989)	35
<i>Schutte Bagclosures Inc. v. Kwik Lok Corp.</i> , 193 F. Supp. 3d 245 (S.D.N.Y. 2016), <i>aff'd</i> , 699 F. App'x 93 (2d Cir. 2017).....	36
<i>Sherwood 48 Assoc. v. Sony Corp. of Am.</i> , 213 F. Supp. 2d 376 (S.D.N.Y. 2002) <i>aff'd</i> in part, vacated in part, 76 F. App'x 389 (2d Cir. 2003).....	17, 26
<i>Silverman v. BCS, Inc.</i> , 870 F.2d 40 (2d Cir. 1989).....	13
<i>Star Indus., Inc. v. Bacardi & Co., Ltd.</i> , 412 F.3d 373 (2d Cir. 2005).....	31
<i>Starbucks Corp. v. Wolfe's Borough Coffee, Inc.</i> , 588 F.3d 97 (2d Cir. 2009).....	30
<i>Stewart Surfboards, Inc. v. Disney Book Grp., LLC</i> , 2011 WL 12877019 (C.D. Cal. May 11, 2011)	20, 21
<i>Sunenblick v. Harrell</i> , 895 F. Supp. 616 (S.D.N.Y. 1995) <i>aff'd</i> , 101 F.3d 684 (2d Cir. 1996).....	30
<i>Thompson Medical Co., Inc. v. Pfizer Inc.</i> , 753 F. 2d 208 (2d Cir. 1985).....	34
<i>Tommy Hilfiger Licensing v. Nature Labs, LLC</i> , 221 F. Supp. 2d 410 (S.D.N.Y. 2002).....	29
<i>Toni & Guy (USA) Ltd. v. Nature's Therapy, Inc.</i> , 2006 WL 1153354 (S.D.N.Y. May 1, 2006)	39
<i>TrafFix Devices, Inc. v. Marketing Displays, Inc.</i> , 532 U.S. 23 (2001).....	36
<i>Twentieth Century Fox Film Corp. v. Empire Distribution, Inc.</i> , 875 F.3d 1192 (9th Cir. 2017)	22, 24

TABLE OF AUTHORITIES
(continued)

	<u>Page(s)</u>
<i>Twin Peaks Prods., Inc. v. Pub. Intern’l, Ltd.</i> , 996 F.2d 1366 (2d Cir. 1993).....	15, 25
<i>Union Carbide Corp. v. Ever-ready Inc.</i> , 531 F.2d 366 (7th Cir. 1976)	30
<i>University of Alabama Bd. of Trustees v. New Life Art, Inc.</i> , 683 F.3d 1266 (11th Cir. 2012)	15, 17
<i>VIRAG S.R.L. v. Sony Computer Enter’t Am. LLC</i> , 2015 WL 5000102 (N.D. Cal. Aug. 21, 2015), <i>aff’d</i> 699 Fed. Appx. 667 (9th Cir. 2017)	15, 17
<i>Volkswagen AG v. Dorling Kindersley Pub’g, Inc.</i> , 614 F. Supp. 2d 793 (E.D. Mich. 2009).....	22, 29
<i>Wal-Mart Stores v. Samara Bros.</i> , 529 U.S. 205 (2000).....	13
<i>Walt Disney Co. v. Goodtimes Home Video Corp.</i> , 830 F. Supp. 762 (S.D.N.Y. 1993)	33
<i>Wham-O, Inc. v. Paramount Pictures Corp.</i> , 286 F. Supp. 2d 1254 (N.D. Cal. 2003)	22, 26, 28
<i>Winchester Mystery House, LLC v. Global Asylum, Inc.</i> , 210 Cal. App. 4th 579 (2012)	21
<i>Yankee Pub. Inc. v. News America Pub. Inc.</i> , 809 F. Supp. 267 (S.D.N.Y. 1992)	18, 37, 40
<i>Yurman Design, Inc. v. PAJ, Inc.</i> , 262 F.3d 101 (2d Cir. 2001).....	13, 33

STATUTES

15 U.S.C.	
§1125(a)(3)	36
§1125(c)	37
§1125(c)(2)(B)(iii)	38
§1125(c)(3)(C)	37
N.Y. Gen. Bus. Law §360-1	37

TABLE OF AUTHORITIES
(continued)

Page(s)

OTHER AUTHORITIES

4 McCarthy on Trademarks and Unfair Competition	
§ 23:111 (5th ed.).....	31
§ 24:87 (5th ed.).....	38
Mark A. Lemley, <i>The Modern Lanham Act and the Death of Common Sense</i> , 108 Yale L.J. 1687 (1999)	12
U.S. Constitution, First Amendment.....	<i>passim</i>

INTRODUCTION

This case is nothing less than a direct attack on the First Amendment right to produce creative works that realistically depict contemporary warfare. AM General LLC (“AMG”), a government contractor that manufactured military “HMMWV” (or “Humvee”) vehicles for the U.S. military, seeks to use trademark law to control the mere depiction of those vehicles in Defendants’ fictional *Call of Duty* video games. The use of purported trademark rights to restrict the content of expressive works is dangerous under any circumstance. But the claims in this case are particularly egregious because they involve a U.S. military vehicle paid for by American taxpayers and deployed in every significant military conflict for the past three decades. As such, Humvees are a fixture of the modern U.S. military and are a logical part of any attempt to tell an authentic story about modern war. Humvees also have cultural and historical significance that has absolutely nothing to do with AMG or its manufacturing process. To allow AMG to pursue its claims would run directly contrary to the First Amendment and give AMG a stranglehold on virtually any expressive depiction of 21st Century U.S. military history.

This case is ripe for summary judgment. The material facts are not susceptible to dispute and the works at issue speak for themselves. The law also is clear. Both District and Appellate Courts repeatedly have rejected variants of the very same claims AMG asserts here, including claims involving some of the very same video games. Under the Second Circuit’s seminal decision in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989) and the dozens of cases that apply *Rogers* to video games, movies, books, and other popular media, a putative trademark owner may not assert claims arising from the use of a trademark in connection with an expressive work unless the plaintiff can prove that the use (1) has no (*i.e.* zero) artistic relevance to the work, or (2) explicitly misleads, or “dupes,” consumers into believing that the expressive work originates from, is affiliated with, or is sponsored or approved by the trademark owner. AMG admits that

the *Call of Duty* games are expressive works and that the limited depictions of Humvees in the games (less than ten minutes out of more than 35 hours of gameplay) are artistically relevant to these games. The undisputed facts also confirm that far from “explicitly misleading” customers, Activision made clear to the public that *Activision*, and not AMG, was the source of the games and never once even suggested that AMG sponsored, endorsed, or approved of them. These basic facts dispose of *all* of AMG’s claims, under both state and federal law.

Nor is there even a reasonable likelihood of consumer confusion. AMG cannot identify even a single bona fide purchaser that was confused about AMG’s involvement with the *Call of Duty* games over the nearly *ten years* since Activision first released *Modern Warfare* to the public. That fact alone is dispositive. It also is not surprising. The *Call of Duty* games are just a miniscule part of the overall body of expressive works (including movies, television shows, video games, and books) depicting military Humvees – all of which have co-existed with AMG for decades, without any consumer confusion and without complaint from AMG. There also is no dispute that Activision does not directly compete with AMG, does not use the “Humvee” name or appearance to market or sell trucks, and did not deliberately intend to confuse consumers as to AMG’s association with its games.

AMG’s claims are fatally flawed for an additional reason: the undisputed facts confirm that AMG does not own, and cannot own, any enforceable trade dress rights in its line of Humvee vehicles. This is because, among other reasons, AMG admits that its purported “trade dress” is inconsistently used. Still more, AMG cannot prove that the appearance of its purported trade dress has acquired “secondary meaning” as an indicator of source, or that any supposedly distinctive features of AMG’s trade dress are non-functional.

This lawsuit is a shameless overreach of AMG’s purported trademark rights (to the extent

any exist). The material facts are not in dispute and the law is clear. Summary judgment should be granted, and AMG's claims should be dismissed in their entirety.

FACTUAL BACKGROUND

Activision and the *Call of Duty* Franchise. Defendant Activision Publishing, Inc. (“Activision”) is a leading worldwide developer, publisher, and distributor of interactive entertainment, including the *Call of Duty* series of video games.¹ Defendants’ Rule 56.1 Statement of Undisputed Facts (“SUF”), ¶ 1. *Call of Duty* is among the most popular and well-known video game franchises in the world, and millions of people have played *Call of Duty* games. *Id.*, ¶ 2. The *Call of Duty* games are military action games “in which a player assumes control of a military soldier and fights against a computer-controlled or human-controlled opponent across a variety of computer-generated battlefields.” *NovaLogic, Inc. v. Activision Blizzard*, 41 F. Supp. 3d 885, 889 (C.D. Cal. 2013); SUF, ¶ 3. Activision released its first *Call of Duty* game in 2003 and subsequently released fifteen “core” *Call of Duty* titles for video game consoles and PCs. SUF, ¶ 4. Each *Call of Duty* game depicts military combat in a particular time period, such as World War II, the Vietnam War, the 1980s, the present day, the near future, and the far future. *Id.* This lawsuit primarily concerns six separate *Call of Duty* PC and console games and three mobile “tie-in” games released between 2007 and 2014 that depict contemporary or near-future warfare (collectively the “Accused Games”). *Id.*, ¶ 5. (AMG does not allege that the other 10 *Call of Duty* console titles or any other mobile games infringe its purported trademarks or trade dress.)²

¹ Activision is a subsidiary of Defendant Activision Blizzard, Inc. (“AB”). SUF, ¶ 1. Defendant Major League Gaming Corp. (“MLG”) was a company that organized and ran competitive video game (“e-sports”) events and tournaments. *Id.*, ¶ 89. MLG’s competitive tournaments encompassed a variety of games, such as *Halo*, *Gears of War*, *Mortal Kombat*, *Starcraft* and *Call of Duty*. *Id.*, ¶ 90. MLG had no involvement with the development, creation or distribution of any of the COD Games. *Id.*, ¶ 91. AB acquired MLG’s assets in 2016. *Id.*, ¶ 89.

² The accused PC/console games are: *Call of Duty 4: Modern Warfare* (2007 and 2014 (remastered)); *Call of Duty:*

In all of the Accused Games, players engage in high-stakes military combat missions from a “first person” perspective in a variety of real-world settings such as the former Soviet Union, Afghanistan, London and Paris. SUF, ¶ 7. The Accused Games feature both a single-player campaign mode and a competitive multiplayer mode. *Id.*, ¶ 8. Each of the campaigns is “a fully cinematic experience featuring story, dialog, music, effects and all of the other elements found in a big budget entertainment franchise.” *NovaLogic*, 41 F. Supp. 3d at 890.³ In the multiplayer mode, players compete against each other in individual or team-based combat on a variety of simulated virtual battlefields, ranging from battle-torn cityscapes to high-tech indoor environments. SUF, ¶ 9. These multiplayer “maps” give players the feeling of being in a real-life combat zone, and feature an array of buildings, vehicles, obstacles, hiding places, streets and/or passageways, tailored to the topography of the map and its location. *Id.*, ¶ 10. Combat in the multiplayer maps takes place on foot.⁴ *Id.*, ¶ 11.

One of the tenets of the *Call of Duty* franchise is to provide players with “a very realistic and convincing ... portrayal of modern combat operations[.]” *NovaLogic*, 41 F. Supp. 3d at 890; *see also Mil-Spec Monkey, Inc. v. Activision Blizzard, Inc.*, 74 F. Supp. 3d 1134, 1137 (2014) (*Call of Duty* games depict “highly realistic combat in a ... war-torn setting, featuring numerous

Modern Warfare 2 (2009); *Call of Duty: Modern Warfare 3* (2011); *Call of Duty: Black Ops II* (2012) and *Call of Duty: Ghosts* (2013). The mobile games are *Call of Duty: Modern Warfare* and *Call of Duty: Modern Warfare Mobilized* (for the Nintendo DS console) (2007 and 2009) and *Call of Duty: Heroes* (for smartphones). SUF, ¶ 5. Among the PC/console games that are not accused are: *Call of Duty* (2003), *Call of Duty 2* (2005), *Call of Duty 3* (2006), *Call of Duty: World at War* (2008), *Call of Duty: Black Ops* (2010), *Call of Duty: Advanced Warfare* (2014), *Call of Duty: Black Ops III* (2015), *Call of Duty: Infinite Warfare* (2016), *Call of Duty: WWII* (2017) and *Call of Duty: Black Ops 4* (2018).

³ For example, in *Modern Warfare 3*, the player fights alongside “a group of elite international soldiers tasked with a variety of high-risk missions to save the world” in a “hypothetical near-future” where “the United States is at war with Russia, and World War III is imminent.” *NovaLogic*, 41 F. Supp. 3d at 890.

⁴ *Call of Duty: Modern Warfare (DS)* and *Call of Duty: Mobilized (DS)* are simplified, low-resolution games that attempt to re-create some of the core gameplay of *Modern Warfare* and *MW2*, subject to the inherent limitations of the Nintendo DS mobile device. SUF, ¶ 12. *Heroes* has a very different style of gameplay than the other Accused Games; it is a base-building game in which players upgrade and protect a military base, viewed from a top-down perspective. *Id.*, ¶ 13.

characters, complex narratives, and advanced graphics[.]”); SUF, ¶ 14. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] *Id.*, ¶ 15.

To fully realize their artistic vision, Activision and its development studios work hard to convincingly depict real-life military combat. *Id.*, ¶ 16. Many events in the Accused Games unfold in real-world locations that are identifiable by famous landmarks such as the Eiffel Tower or the New York Stock Exchange. *Id.*, ¶ 17. Military units in the Games include real-life military organizations, such as the Army Rangers. *Id.*, ¶ 18. Uniforms reflect what a soldier actually would wear. *Id.*; see *NovaLogic*, 41 F. Supp. 3d at 890. Military weapons and equipment reflect their real-life counterparts in appearance, sound and function. SUF, ¶ 18; *Mil-Spec*, 74 F. Supp. 3d at 1137 (*Call of Duty: Ghosts* “incorporates dozens of contemporary weapons and vehicles ... and a variety of military equipment based on real-life counterparts.”). Vehicles present in the Accused Games also are representative of those that a real-life soldier would expect to see in the time and place depicted. SUF, ¶ 19. Among dozens of vehicles depicted in the Accused Games are aircraft such as the C-130 Hercules aircraft; tanks such as the M1A2 Abrams; ships such as the USS Chicago; and a variety of other land, air and sea vehicles such as snowmobiles, submarines, motorcycles, drones and troop transports. *Id.* Through these efforts, Activision developers and artists strive to create a compelling action adventure where the player experiences firsthand the sights, sounds and emotions experienced by real-life elite soldiers on the front lines of war.

HMMWVs or “Humvees.” Among the many vehicles depicted in the Accused Games are “High Mobility Multipurpose Wheeled Vehicles” (“HMMWVs”), originally nicknamed

“Humvees” by soldiers. SUF, ¶ 21. In the early 1980s, the Department of Defense awarded a contract to AMG (and/or its predecessors-in-interest) to manufacture HMMWVs (an acronym coined by the Defense Department) for the U.S. armed forces. *Id.*, ¶¶ 20, 22. AMG has manufactured more than 200,000 Humvees pursuant to government contracts. *Id.*, ¶ 23. In AMG’s own words, Humvees are “the backbone of U.S. defense tactical vehicle fleets around the world” and “an essential part of U.S. military operations[.]” *Id.* The U.S. military deployed Humvees in high-profile military engagements such as the 1989 U.S. invasion of Panama, the 1993 Battle of Mogadishu, the first and second Gulf Wars, and the ongoing war in Afghanistan. *Id.*, ¶ 24. There are at least 15 different Humvee variants, used in roles such as troop transports, ambulances, automatic weapons platforms and missile carriers. *Id.*, ¶ 25. ***AMG does not sell Humvees to consumers or civilians.***⁵ *Id.*, ¶ 26. [REDACTED]

[REDACTED] *Id.* Neither the words “Humvee” nor “AM General” appear visibly anywhere on a Humvee vehicle, including on the hood or grille. *Id.*, ¶ 27. Thus, a member of the public seeing a Humvee on the news, in photographs, or even in person would have no reason to know that AMG (or, for that matter, any one company) manufactured the vehicle. *Id.*, ¶ 28

Humvees and Popular Culture. As a result of their extensive use by the U.S. military, Humvees have assumed historical and cultural significance as symbols of the modern U.S. military. SUF, ¶ 37. AMG admits that Humvees are a “symbol of American military might,” and the United States government has described them as an “ubiquitous symbol of American

⁵ In the early 1990s, AMG began manufacturing and selling a civilian version of the Humvee, which it called the “Hummer.” SUF, ¶ 30. In 1999, AMG sold the “Hummer” brand and all rights in the Hummer vehicle to *General Motors* (“GM”), including all trade dress rights in the Hummer vehicle’s design. *Id.*, ¶ 31. Since 1999, AMG has manufactured and sold Humvees pursuant to a license from GM. *Id.* GM is not a party to this lawsuit and has not asserted any claims against any of the Defendants.

ground forces.” *Id.*, ¶ 38. The U.S. Army has held the vehicle out to the public (including on its website, in promotional materials, in books and in public events) as an integral part of its fleet of ground vehicles, regularly features Humvees in recruiting materials and advertisements, and even included them in its own video game franchise. *Id.*, ¶ 39. [REDACTED]

[REDACTED] *Id.*, ¶ 37. [REDACTED]

[REDACTED] *Id.*, ¶ 39.

Over the last two decades, virtually every type of popular media depicting or discussing U.S. military operations has depicted Humvees. Humvees are especially common in fictional movies and television shows in a variety of genres. *SUF*, ¶ 40. As noted in materials attached to AMG’s own Complaint: “you see Jeeps in old war movies and Humvees in current war movies.” *Compl.* at Ex. 5. Hundreds of motion pictures and television programs prominently feature Humvees, including war movies such as the award-winning film *The Hurt Locker* (and on the packaging of the DVD of that film), Hollywood blockbusters such as *Jurassic Park* and *The Avengers*, television dramas such as *The Walking Dead*, *24*, and the *Long Road Home* (whose celebrity premiere included a Humvee with the National Geographic logo), and even animated comedies such as *Cars* and *The Simpsons*. *SUF*, ¶ 40. In the last year alone, Humvees prominently appeared in major films such as *Sicario: Day of the Soldado*. *Id.* Humvees regularly are depicted in video and film trailers, posters, and product packaging for commercial DVDs. *Id.*, ¶ 41. Humvees also are depicted or described in many music videos and in dozens (if not hundreds) of novels, nonfiction books, comic books and children’s books, including on the cover of many of those books. *Id.*, ¶¶ 40, 42.

[REDACTED]

[REDACTED]. *SUF*, ¶ 43. [REDACTED]

[REDACTED]

[REDACTED]. *Id.*, ¶ 44.

[REDACTED]

[REDACTED]. *Id.*, ¶ 45. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]. *Id.*, ¶ 46.

At least **200** video games have featured or depicted Humvees [REDACTED]
[REDACTED], including depictions of Humvees on the *packaging* of some of those
games and in dozens of trailer advertisements. *Id.*, ¶¶ 47-48. These include some of the most
popular military-based games ever released, such as the *Battlefield* and *SOCOM* series of games.
SUF 48. In many of these games, players can drive Humvees or do battle with other players in
Humvees. SUF, ¶ 49. [REDACTED]

[REDACTED]

[REDACTED] *Id.*, ¶ 50 [REDACTED]

[REDACTED]

[REDACTED] *Id.*, ¶ 52. [REDACTED]

[REDACTED]

[REDACTED] *Id.*, ¶ 53. Until this lawsuit, AMG never filed a single lawsuit against
any video game developer for the unauthorized use of its trademarks or trade dress in a video
game. *Id.*, ¶ 54. AMG has not produced any evidence that *anyone* (including its sole U.S.
customer for Humvees, the U.S. military) ever erroneously believed that AMG produced,
sponsored, endorsed, or authorized any third-party video game containing a Humvee (or, for that

matter, any movie, television show or book). *Id.*, ¶ 55.

Humvees and the Accused Games. Ten of the sixteen *Call of Duty* PC and console titles released to the public do not include any depictions of Humvees. With respect to the Accused Games, Humvees do not appear on the packaging of any of these games and never appeared on any billboards, murals, posters or in-store displays. SUF, ¶ 65.

The only way to fairly evaluate the depiction of Humvees in the Accused Games is to review or play them (all of the Accused Games and the necessary game consoles are being provided to the Court.) Such a review will confirm that when Humvees are depicted in the Accused Games, they appear only occasionally, among dozens of other military vehicles, and in only a small fraction of the each Games' content. For example, in the single player campaign mode of some of the Accused Games (Humvees do not appear at all in the campaign mode for *Ghosts*), a typical player might encounter Humvees in just a few discrete scenes, in a few game levels, for just seconds (or, at most, a few minutes) as part of an experience that lasts for six to ten hours per game.⁶ SUF, ¶ 56. In these few moments, a player might see (among hundreds of other vehicles and objects) military Humvees parked at military bases, extracting soldiers in the midst of combat, driving through the streets of Afghanistan or Panama, or abandoned after having been damaged by gunfire or explosives in a war zone. *Id.*, ¶ 57. Additionally, in a few of the Accused Games' "multiplayer" maps (16 out of more than **200** maps across the five games), stationary, abandoned Humvees are among many "prop" vehicles and other objects on the battlefield.⁷ *Id.*, ¶ 60. When Humvees appear in the Accused Games, they always are depicted

⁶ The lengthiest depiction of Humvees is one four-minute scene (during the 15-minute campaign level "Team Player") in which the player controls a minigun mounted to the roof of a Humvee and defends a convoy moving through a village in Afghanistan. SUF, ¶ 58. "Team Player" was inspired by real-life military training exercises and is consistent with similar scenes depicted in works such as National Geographic's *The Long Road Home*. *Id.*, ¶ 59.

⁷ In *Call of Duty: Heroes*, tiny vehicles occasionally can be seen driving around the perimeter of the military base (along with airplanes) in one game mode, but they play no role in the gameplay and are barely visible. SUF, ¶ 61.

as a working part of the U.S. fleet of military vehicles, exactly as they have appeared in news footage, stock photos or Army recruitment materials. *Id.*, ¶ 63. Humvees in the Accused Games are never branded with company logos (including any “Humvee” or “AM General” logos); nor are they given any special ornamentation. *Id.* Players of the Accused Games can never drive, control, customize, acquire, purchase, build, modify, decorate or manipulate in-game Humvees, such as by opening and closing doors, looking under the hood, placing baggage in the trunk, or using any interior components or instruments. *Id.*, ¶ 62.

Activision released dozens of trailers and gameplay videos for the Accused Games, including pre-release “reveal” trailers, day-of-release “launch” trailers, and a variety of Internet teasers and gameplay videos. *SUF*, ¶ 67. The vast majority of these videos do not contain any images or depictions of Humvees. *Id.*, ¶ 68. When Humvees do appear in trailers or videos their appearance almost always is fleeting, inconsequential, and representative of actual gameplay. *Id.* The only non-fleeting appearance of a Humvee in a game trailer is in two trailers for *Modern Warfare 2* (the “Infamy” and “Launch” trailers). *Id.*, ¶ 69. These trailers include brief images from the game’s “Team Player” level as part of a much larger montage of in-game footage. *Id.*

Strategy Guides and Construction Sets. Activision licenses the *Call of Duty* brand for various merchandise and consumer products, such as clothing, keychains, toys, computer peripherals, books, posters and game consoles. *SUF*, ¶ 77. One of Activision’s licensees is BradyGames (and its predecessors and successors), which Activision licensed to create and publish video game strategy guidebooks. *Id.*, ¶ 78. BradyGames produced guides for dozens of Activision games, including some of the Accused Games (the “Strategy Guides”). *Id.* Each Strategy Guide is over 300 pages and contains detailed game information, including walkthroughs, story summaries, map layouts, and statistics, all illustrated with hundreds of

screen captures. *Id.*, ¶ 79. AMG claims that among the thousands of screen captures in the Strategy Guides for *MW2*, *MW3*, *Black Ops 2* and *Ghosts* are a few that include Humvees as they appear in the Game. *Id.*, ¶ 80. There are no images of Humvees (or reference to them by name or otherwise) on the front or back covers of the Strategy Guides. *Id.*, ¶ 81.

Another of Activision’s licensees is MEGA Brands, Inc. (“Mega”) (later acquired by Mattel, Inc.). Pursuant to a 2012 agreement, Activision licensed its *Call of Duty* intellectual property to Mega for [REDACTED]

[REDACTED] SUF, ¶ 82.⁸ From 2013 to 2017, Mega designed, manufactured, and released at least 98 *Call of Duty*-branded construction sets. *Id.*, ¶ 84. AMG claims that two of these 98 sets – “Light Armor Firebase” (released in 2013) and “Armored Vehicle Charge” (released in 2016) (the “Construction Sets”) – include buildable vehicles that allegedly resemble Humvees.

Compl., ¶¶ 54-58. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

This Lawsuit. AMG claims to possess a trademark in the words “Humvee” and “HMMWV” (its “word marks”) and to possess trade dress rights in the exterior appearances of its entire line of Humvees (its “trade dress”). Compl., ¶¶ 17-21. AMG claims that its trade dress encompasses many elements of the external appearance of its Humvees, [REDACTED]

[REDACTED]. SUF, ¶ 94.

[REDACTED] many of the Humvee’s “trade dress” features are owned by General Motors

⁸ [REDACTED]

(“GM”) (not AMG) and are shared between Humvees and GM’s “Hummers,” such as the overall shape of the vehicle, a “seven oval grille,” a split windshield, rectangular doors, and top-mounted windshield wipers. *Id.*, ¶ 32. AMG claims it owns certain other features present in just some models of its Humvees, such as Xs on the doors or a slanted back. *Id.*, ¶ 93.

Based on these purported trademark and trade dress rights, AMG has alleged eight claims against Defendants: (1) federal claims for infringement of AMG’s registered word marks and trade dress, (2) federal claims for false designation of origin, (3) a federal claim for false advertising, (4) a federal dilution claim, and (5) three analogous New York state law claims. All of these claims are based on the exact same alleged conduct – namely, Activision’s depiction of Humvees (and limited use of the “Humvee” and “HMMWV” words to describe them) in connection with the Accused Games, the Strategy Guides and the Construction Sets.

ARGUMENT

A trademark is “not property in the ordinary sense,” but only a word or symbol indicating the origin or source of a product. *Industrial Rayon Corp. v. Dutchess Underwear Corp.*, 92 F.2d 33, 35 (2d Cir. 1937). “The owner of the mark acquires the right to prevent his goods from being confused with those of others and to prevent his own trade from being diverted to competitors through their use of misleading marks. ‘There are no rights in a trade-mark beyond these.’” *Pirone v. MacMillan, Inc.*, 894 F.2d 579, 581 (2d Cir. 1990) (quoting *Industrial Rayon*, at 35). *See also* Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 Yale L.J. 1687, 1695 (1999) (“We give protection to trademarks for one basic reason: to enable the public to identify easily a particular product from a particular source.”). Courts “exercise particular caution” with respect to trade dress claims in “product designs” because “granting trade dress protection to an ordinary product would create a monopoly in the goods themselves.” *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 114-15 (2d Cir. 2001). Moreover, product

design is *never* “inherently distinctive” and “almost invariably serves purposes *other than source identification.*” *Wal-Mart Stores v. Samara Bros.*, 529 U.S. 205, 213-14 (2000) (emphasis added).

To dismiss this case, the Court need not determine whether AMG possesses enforceable trademark and trade dress rights. Even if AMG does have such rights – and even if the Humvee name or design is “iconic” – the First Amendment bars *all* of AMG’s claims. But should the Court reach the issue, the undisputed evidence also confirms that AMG does not possess any trade dress rights in its Humvee vehicles, let alone the exclusive “trade dress” right to prevent others from depicting Humvees in their video games and other expressive works.

I. THE FIRST AMENDMENT BARS AMG’S CLAIMS.

When a trademark or trade dress is included in or on an artistic or expressive work, the narrow source-identification protections afforded to companies under trademark laws give way to broader First Amendment concerns. *Silverman v. BCS, Inc.*, 870 F.2d 40, 48 (2d Cir. 1989) (“In the area of artistic speech...enforcement of trademark rights carries a risk of inhibiting free expression.”). *See also Mattel v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002) (“Trademark rights do not entitle the owner to quash an unauthorized use of the mark by another who is communicating ideas or expressing points of view.”). This is especially true when the purported trademark has historical and cultural relevance. “Were [courts] to ignore the expressive value that some marks assume, trademark rights would grow to encroach upon the zone protected by the First Amendment.... Simply put, the trademark owner does not have the right to control public discourse whenever the public imbues his mark with a meaning beyond its source-identifying function.” *Mattel*, 296 F.3d at 900. There can be little dispute that Activision’s First Amendment rights to create expressive works about contemporary military conflict far outweigh any countervailing interests AMG might have in protecting against some

purely hypothetical possibility of consumer confusion.

A. **The Second Circuit Long Has Given First Amendment Protection To The Use Of Trademarks In Expressive Works.**

In *Rogers v. Grimaldi*, the Second Circuit resolved the conflict between trademark and the First Amendment in the context of claims asserted by Ginger Rogers against the producers and distributors of a film titled *Ginger and Fred*, about the reunion of two fictional Italian cabaret performers. 875 F.2d at 998. The Court affirmed the dismissal of Rogers’ claims in their entirety, holding that “the [Lanham] Act should be construed to apply to artistic works *only* where the public interest in avoiding consumer confusion outweighs the public interest in free expression.” *Id.* at 999 (emphasis added). The Court held that the “balance [between trademark rights and the First Amendment] will normally not support application of the [Lanham] Act unless [1] the title has *no artistic relevance* to the underlying work whatsoever, or, [2] if it has some artistic relevance, unless the title *explicitly misleads* as to the source or the content of the work.” *Id.* (emphasis added).

In articulating its two-part test (the “*Rogers Test*”), the Second Circuit confirmed that when First Amendment rights are implicated by the use of a trademark, the relevant inquiry is *not* whether some consumers might be confused, or even *were* confused, by the defendant’s use. Rather, even if “some members of the public would draw the incorrect inference” that the plaintiff sponsored or was affiliated with the work, “that risk of misunderstanding, not engendered by any overt claim ... is so outweighed by the interests in artistic expression as to preclude application of the Lanham Act.” *Id.* at 1001.

Subsequent cases in this Circuit consistently have reaffirmed the *Rogers Test* and held that it is “generally applicable to Lanham Act claims against works of artistic expression...”

Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub'g Group, 886 F.2d 490, 495 (2d Cir. 1989).⁹ See also *Twin Peaks Prods., Inc. v. Pub. Intern'l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993) (same). Courts in the Southern District of New York repeatedly follow *Rogers*, including in connection with the contextual use of trademarks in audiovisual or literary works and their marketing. See, e.g., *Louis Vuitton Mallatier S.A. v. Warner Bros. Entertainment, Inc.*, 868 F. Supp. 2d 172, 184 (S.D.N.Y. 2012) (use of Louis Vuitton trademark in the motion picture “The Hangover” was protected by the First Amendment); *Cummings v. Soul Train Holdings LLC*, 67 F. Supp. 3d 599, 606 (S.D.N.Y. 2014) (use of plaintiff’s image in television show and its packaging); *Medina v. Dash Films, Inc.*, 2016 WL 3906714, at *4-6 (S.D.N.Y. July 14, 2016) (use of trademark LOISAIDAS in television show). Many other courts also have adopted the *Rogers* Test, including the Courts of Appeals for the Sixth, Ninth and Eleventh Circuits. See, e.g., *ETW Corp. v. Jireh Publishing, Inc.*, 332 F.3d 915, 938 (6th Cir. 2003) (use of Tiger Woods’ image in a painting); *Mattel*, 296 F.3d at 902 (use of BARBIE in the title of a song and in its lyrics); *University of Alabama Bd. of Trustees v. New Life Art, Inc.*, 683 F.3d 1266, 1278-79 (11th Cir. 2012) (use of University of Alabama uniforms in paintings).

In 2008, the Ninth Circuit applied *Rogers* to dismiss Lanham Act and related claims arising from the alleged use of a trademarked name and logo in a major video game and its strategy guide. *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095 (9th Cir. 2008). Since then, courts routinely have applied the *Rogers* Test to dismiss similar claims relating to video games. See, e.g., *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235 (9th Cir. 2013) (depiction of football player in *Madden Football*); *VIRAG S.R.L. v. Sony Computer Enter't Am.*

⁹ *Cliffs Notes* also confirmed that the *Rogers* Test presupposes some potential consumer confusion: “[Though] it is conceivable... that some purchaser may mistakenly think that Cliffs Notes itself produced the [defendant’s work] ... somewhat more risk of confusion is to be tolerated when a trademark holder seeks to enjoin artistic expression...” 886 F.2d 495-96.

LLC, 2015 WL 5000102 (N.D. Cal. Aug. 21, 2015), *aff'd* 699 Fed. Appx. 667 (9th Cir. 2017) (use of the plaintiff's trademark as signage on a virtual race track); *Capcom Co. v. MKR Group, Inc.*, 2008 WL 4661479 (N.D. Cal. Oct. 20, 2008) (use of alleged trademark as a video game title); *Dillinger, LLC v. Elec. Arts Inc.*, 2011 WL 2457678, at *7 (S.D. Ind. June 16, 2011) (use of "Dillinger" name for a video game weapon). Among these are cases involving two of the Accused Games. *Mil-Spec*, 74 F. Supp. 3d at 1140 (use of military patch in *Ghosts*); *Novalogic*, 41 F. Supp. 3d at 904 (use of "Delta Force" name and logo in *MW3*). The facts here are virtually identical to those in the above cases; the result should be the same.

B. Activision's Contextual Depiction Of Humvees And Descriptive Use Of The Words "Humvee" and "HMMWV" Easily Meet The Rogers Test.

The *Rogers* Test "requires the defendant to come forward and make a threshold legal showing that its allegedly infringing use is part of an expressive work." *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 264 (9th Cir. 2018). If the defendant successfully makes that threshold showing, then for the case to proceed, the *plaintiff* must satisfy "at least one of *Rogers's* two prongs." *Id.* There can be no dispute that the Accused Games are highly expressive works, entitled to the full and complete protection of the First Amendment. *See Brown v. Entertainment Merchants Ass'n*, 564 U.S. 786, 790 (2011) ("Like the protected books, plays, and movies that preceded them, video games communicate ideas – and even social messages – through many familiar literary devices (such as characters, dialogue, plot and music) and through features distinctive to the medium (such as the player's interaction with the virtual world)."). Thus, for AMG's claims to survive summary judgment, AMG bears the burden of proving that Activision's depictions of Humvees and use of the words "Humvee" or "HMMWV" (1) have *no artistic relevance* or (2) are *explicitly misleading*. It cannot do so.

1. Artistic Relevance. Only the use of a trademark with "*no artistic relevance to*

the underlying work whatsoever” would not merit First Amendment protection. *Rogers*, 875 F.2d at 999. In other words, “[t]he level of relevance merely must be *above zero*.” *E.S.S.*, 547 F.3d at 1100. This is an objective standard; the motivation of the defendant is irrelevant. *See, e.g., Dillinger*, 2011 WL 2457678, at *6 (“[T]hat no one can remember how the weapons were named has little-to-no bearing on any ‘actual nexus’ between [plaintiff] and the content of the... games.”). *Rogers* also makes clear that the First Amendment **does not require** that the defendant have “no alternative avenues” to express an idea, as such a standard would provide “insufficient leeway for literary expression.” 875 F.2d at 999. There is sound basis for this “appropriately low” standard: it is not the province of the Court to second-guess the decisions made by artists, authors or game designers. *Id.*; *see Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) (“It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations....”).

Activision’s use far exceeds the “above zero” artistic relevance standard. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] *See Brown*, 724 F.3d at 1243 (use was artistically relevant “[g]iven the acknowledged centrality of realism to [the defendant’s] expressive goal”); *University of Alabama*, 683 F.3d at 1278-79 (“uniforms’ colors and designs are needed for a realistic portrayal of famous scenes from Alabama football history”).¹⁰ Indeed, almost every time Humvees appear

¹⁰ *See also Sherwood 48 Assoc. v. Sony Corp. of Am.*, 213 F. Supp. 2d 376, 377 (S.D.N.Y. 2002) (Times Square buildings served “the theatrically relevant purpose of orienting the viewer to the location.”), *aff’d* in part, vacated in part, 76 F. App’x 389 (2d Cir. 2003); *Virag*, 2015 WL 5000102, at *11 (“[G]iven the central role of realism to [the games], the defendants’ use of the VIRAG mark has at least some (*i.e.*, more than zero) artistic relevance to the games.”); *Novalogic*, 41 F. Supp. 3d at 900 (military patches gave players “a sense of a particularized reality of being part of an actual elite special forces operation and serve as a means to increase specific realism of the game”); *New York Racing Ass’n, Inc. v. Perlmutter Pub., Inc.*, 959 F. Supp. 578, 582 (N.D.N.Y. 1997) (“use of Plaintiff’s

in the Accused Games they are seen in the same places (Panama, Iraq, Afghanistan), carrying the same people (Army Rangers, Marines), and in the same circumstances (carrying soldiers to and from army bases to combat zones) as they have been seen in the real world.

2. Not “Explicitly Misleading.” *Rogers* is absolutely clear that for an expressive use of a trademark to be “explicitly misleading,” the allegedly infringing use must make an “explicit indication,” “overt claim” or “affirmative statement” of association or sponsorship. *Rogers*, 875 F.2d at 1000-01. The mere *use* of a trademark in or on a product (regardless of how slight or prominent) unequivocally is not enough. The use must “dupe[] consumers into thinking buying a product they mistakenly believe is sponsored by the trademark owner.” *See Louis Vuitton*, 868 F. Supp. 2d at 180.¹¹ *See also Yankee Pub. Inc. v. News America Pub. Inc.*, 809 F. Supp. 267, 274 (S.D.N.Y. 1992) (no trademark claim where the use “was neither intended to mislead nor, in the court’s view, did it mislead”). *Rogers* provided some illustrative examples: *i.e.*, “Nimmer on Copyright,” “Jane Fonda’s Workout Book,” and “an authorized biography” when these titles are untrue. 875 F.2d at 1007. *See also Brown*, 724 F.3d at 1244 (falsely using “*Jim Brown Presents Pinball*” as an example). Review of the Accused Games and their marketing (none of which are in dispute) confirms that Activision did not make any “explicit indication,” “overt claim” or “affirmative statement” – or, for that matter, any *implicit* indication or claim – as to AMG’s affiliation, sponsorship or endorsement of its products.

Nothing in or on any of the Accused Games themselves states (or, for that matter, even

marks in Defendants’ paintings where the mark actually appears in the scene serves the artistically relevant purpose of accurately depicting the scene (realism”).

¹¹ *Dillinger*, 2011 WL 2457678, at *6 (“To be ‘explicitly misleading,’ the defendant’s work must make some *affirmative statement* of the plaintiff’s sponsorship or endorsement, beyond the mere use of plaintiff’s name or other characteristic.” (emphasis added and citing *Rogers*, 875 F.2d at 1001)); *NovaLogic*, 41 F. Supp. 3d at 901 (“Activision does not explicitly misrepresent or in any manner affirmatively state to the public that Plaintiff is associated with, sponsored, endorsed, or otherwise is the source of [‘Call of Duty: Modern Warfare 3’].”).

suggests) that there is any sponsorship or endorsement by AMG. Humvees do not appear on either the front or back cover of any of the Accused Games, including in the screen captures on the back of the Games. SUF, ¶ 65. Nor do the words “Humvee” or “HMMWV.” *Id.* During gameplay, in the limited circumstances where Humvees are depicted, they are generic, incidental, and just one category of vehicles among many other historically accurate military vehicles. SUF, ¶¶ 19, 60, 62, 63. *See Soul Train*, 67 F. Supp. 3d at 606 (no explicit misrepresentation “where Plaintiff is depicted along with many other artists.”). In all of the Accused Games, Humvees comprise a very small portion of the overall game. In many instances, they are easily overlooked or obscured by other objects. The depiction of Humvees in the Accused Games do not even allow for meaningful interaction, since they either are stationary props among hundreds of other real-world objects or computer-controlled objects whose movement is pre-defined. SUF, ¶ 62. As for the words “Humvee” and “HMMWV,” they do not appear at all in five of the seven games at issue. *Id.*, ¶ 64. In the other two (*MW2* and *MW3*), these terms are used only to describe the vehicle (for example, in an interstitial “briefing” alongside many other vehicles) or in dialog spoken by non-player characters (*e.g.*, “Allen, get in your humvee”; “We’re leaving on Hunter Three’s Humvee”).¹² *Id.* *See Coty Inc. v. Excell Brands, LLC*, 277 F. Supp. 3d 425, 457 (S.D.N.Y. 2017) (“the public’s right to use language and imagery for descriptive purposes is not defeated by the claims of a trademark owner to exclusivity”).¹³

¹² In *Heroes*, the occasional appearance of tiny low-resolution military vehicles not only is artistically relevant and not explicitly misleading; it is *de minimis*. *See Gottlieb Development LLC v. Paramount Pictures Corp.*, 590 F. Supp. 2d 625, 635 (S.D.N.Y. 2008) (“Courts are not concerned with ‘mere theoretical possibilities of confusion’ or ‘de minimis situations’ in trademark cases.”).

¹³ The only depiction of Humvees in the Strategy Guides (which also are expressive works) is *inside* the 300-plus-page books, in a handful of screen captures amongst thousands. In most of those screen captures, the Humvee is barely visible, and in all instances it appears exactly as in the Game. *See* ¶¶ SUF 79-81. *See Novalogic*, 41 F. Supp. 2d at 893 (describing strategy guide and concluding that it did not infringe the plaintiff’s trademark).

Even if it were factually correct (and it is not), any contention that Humvees are “pervasive” or play “a significant role in the gameplay” (Compl., ¶ 34) is irrelevant. No case holds that application of the First Amendment turns on the quantity or “significance” of the use. Indeed, in *Brown*, the allegedly infringing avatar (a football player) was highly interactive, could be controlled by the player, and was central to the game (a football simulation). 724 F.3d at 1243. In *Rogers*, the trademark was used as the title of the work and on posters and placards. 875 F.2d at 996. In *Cliffs Notes*, the covers of defendant’s books were made to look like the plaintiff’s books. 886 F.2d at 492. In *Louis Vuitton*, the mark had become part of “an oft-repeated and hallmark quote from the movie.” 868 F. Supp. 2d at 175. In *Mattel*, the mark (“Barbie”) was not just the title of the song, but also was part of in the song’s chorus and featured in music videos. 296 F.3d at 900. In *ETW*, the trademark (Tiger Woods’ image) was the centerpiece of the defendant’s painting. *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 918 (6th Cir. 2003). The list goes on. Humvees unquestionably are less “central” or “prominent” to the Accused Games than the marks used by the defendants in those cases, the uses of which were all held to be protected by the First Amendment.¹⁴

Activision also never “explicitly misled” consumers in any marketing, advertising or promotion for any of the Accused Games. Humvees are not part of any of the Games’ promotional artwork and they do not appear on *any* posters, billboards, in-store displays or banner ads for the Games. SUF, ¶ 65.¹⁵ Rather, the “CALL OF DUTY” brand name, the

¹⁴ While, theoretically, it is possible for a player to spend all of his or her time running around a parked Humvee, it also is possible for fans to “spend all nine innings of a baseball game at the hot dog stand; that hardly makes Dodger Stadium a butcher’s shop.” *E.S.S.*, 547 F.3d at 1101.

¹⁵ See also *Dr. Seuss Enterprises, L.P. v. ComicMix LLC*, 2018 WL 2306733, at *5 (S.D. Cal. May 21, 2018) (“what cannot be disputed is that there is no statement... that the work *is* associated with or endorsed by Plaintiff”); *Stewart Surfboards, Inc. v. Disney Book Grp., LLC*, 2011 WL 12877019, at *7 (C.D. Cal. May 11, 2011) (“The Hannah Montana book contains no such explicit misstatement that it is sponsored by or about Stewart Surfboards. It does not say anything like ‘Brought To You By Stewart Surfboards’ or ‘Presented By Stewart Surfboards.’”).

ACTIVISION name, and the name of the relevant development studios (e.g., “INFINITY WARD,” “TREYARCH”) appear prominently on all posters, packaging, in-store displays and other promotions. *Id.*, ¶ 66; *see Cummings*, 67 F. Supp. 3d at 606 (“Soul Train” and “Time Life” “are prominently displayed on the DVD sets’ packaging and contents.”). *NovaLogic*, 41 F. Supp. 3d at 901 (“[*Modern Warfare 3*]’s packaging ... prominently displays the title ‘CALL OF DUTY – MW3,’ and identifies its makers as ‘Activision,’ and its affiliated studios, ‘Infinity Ward’ and ‘Sledgehammer Games.’”); *Mil-Spec*, 74 F. Supp. 3d at 1144 (“Activision’s ... packaging is very clear as to its origin and source...”). “[G]iven the huge success of its ‘Call of Duty’ franchise, Activision understandably has made every effort to affirmatively negate any possible confusion regarding the source of [its games].” *NovaLogic*, 41 F. Supp. 3d at 901; *Medina*, 2016 WL 3906714, at *5 (absence of explicitly misleading conduct is “particularly true where ‘defendants employed their own source designations elsewhere on the product’”) (quoting *Rin Tin Tin, Inc. v. First Look Studios, Inc.*, 671 F. Supp. 2d 893, 901 (S.D. Tex. 2009)).¹⁶

The only time that Humvees appear in any marketing for the Accused Games is in trailers and marketing videos that simply show actual *footage from the Games*. SUF, ¶ 70. These accurate, non-misleading trailers or video demonstrations are precisely the type of in-context promotional or ancillary uses that are protected by the First Amendment. *See Rogers*, 695 F. Supp. at 114 (alleged trademark was used in “[a]ll the advertising and posters for the Film”); *Louis Vuitton*, 868 F. Supp. 2d at 175 (handbag was included in “commercials and advertisements for the film”); *Mil-Spec*, 74 F. Supp. 3d at 1143 n.5 (“Yet even if Activision has included the [trademark] in its trailer and other videos for promotional purposes, this would not

¹⁶ *See also Winchester Mystery House, LLC v. Global Asylum, Inc.*, 210 Cal. App. 4th 579, 592 (2012) (film not explicitly misleading where back cover of film displayed defendant’s name and identified the film as a “MARK ATKINS” film); *Stewart Surfboards*, 2011 WL 12877019, at *7 (“the book jacket and spine include the Disney logo, the ‘Disney Press’ logo, and the Disney channel logo”).

strip [the game] of its ‘artistic relevance’ and First Amendment protection.”); *Dillinger*, 2011 WL 2457678, at *7 (“press releases posted to EA’s website listed the Modern Dillinger first among all the weapons”). There is never any statement (or even suggestion) made in any trailer that AMG sponsored the Game, approved it, made it, or participated in its development. SUF, ¶ 71. Indeed, not one video or trailer (including those that AMG claims to be infringing) includes the words “AM General,” “Humvee” or “HMMWV.” SUF 64. In fact, in most of the trailers, Humvees are barely visible (if they are visible at all). SUF, ¶ 71; see *Volkswagen AG v. Dorling Kindersley Pub’g, Inc.*, 614 F. Supp. 2d 793, 800 (E.D. Mich. 2009) (no confusion where the mark is “very difficult to discern with the naked eye”).¹⁷ And even when they are visible, Humvees appear as just one vehicle among many other authentic military vehicles and are never the sole (or even primary) focus. SUF, ¶ 71.

Finally, the analysis is unchanged by AMG’s claim that Mega, Activision’s licensee of Activision’s *own* brands (not any third-party brands), made and distributed the Construction Sets. In *Twentieth Century Fox Film Corp. v. Empire Distribution, Inc.*, the Ninth Circuit dismissed trademark claims arising from the defendant’s use of the “Empire” title for its television series, even though it also used that name for “consumer goods such as shirts and champagne glasses.” 875 F.3d 1192, 1195 (9th Cir. 2017). “Although it is true that these promotional efforts technically fall outside the ... body of an expressive work, it requires only a minor logical extension of the reasoning of *Rogers* to hold that works protected under its test may be advertised and marketed by name.” *Empire*, 875 F.3d at 1196. Likewise, in *NovaLogic*

¹⁷ Even if Activision’s use of Humvees in the trailers was far more prominent than it was, that still would not make the use “explicitly misleading.” In *Wham-O, Inc. v. Paramount Pictures Corp.*, 286 F. Supp. 2d 1254, 1264 (N.D. Cal. 2003), the plaintiff’s product (Slip N’ Slide) played a huge part in the movie’s marketing campaign and even inspired a tie-in video game. The Court correctly concluded that this fact did not support the plaintiff’s trademark claims because “As any moviegoer can attest, it is not unusual for movie producers to use a signature scene – and the products and props therein – to cultivate interest in a film.” *Id.*

the plaintiff alleged that Activision used the plaintiff's trademark on an Xbox console, on gaming headphones, and in a Brady Guide (the exact same one at issue here). 41 F. Supp. 3d at 889. The court held that "courts have consistently held that First Amendment protection for expressive use does not rise or fall because of other, non-expressive uses, even promotional or outright commercial ones." *Id.* at 901.

Regardless, the Construction Sets do not "explicitly mislead" as to AM General's association or affiliation with any of the Accused Games. The two Construction Sets (representing a tiny fraction of an extensive product line) do not purport to be "Humvees," do not use the "Humvee" or "HMMWV" names, and nowhere purport to have been sponsored or endorsed by AMG. SUF ¶ 84, 86; *see Disney Enters., Inc. v. Nick Sarelli*, 322 F. Supp. 3d 413, 434 (S.D.N.Y. 2018) (no confusion where "many of the costumed characters Defendants offer are identified...using facetious names that are clearly distinct from Plaintiffs' marks"). There also are significant, readily observable design differences between AMG's real-life Humvees and the generic transport vehicles included in the Construction Sets. SUF, ¶¶ 87, 88. For example: the vehicles in the Construction Sets do not have seven-oval grilles, rectangular doors with an X pattern, side mirror mounts, blackout headlights, top-down windshield wipers or vents on the hood. *See, e.g.*, SUF ¶ 114. The vehicle in "Light Armor Firebase" also does not have a slanted back, does not have doors, and has a completely different shape from a Humvee. SUF, ¶¶ 87-88. If the Humvee name and appearance are as recognizable and important as AM General claims, then a consumer seeing a Construction Set containing a generic military vehicle without the Humvee name or features would more likely conclude that AMG *did not* sponsor or endorse that product, much less sponsored the video game franchise whose name appears on the package. *See Cliffs Notes*, 886 F.2d at 492 (defendant's book was not explicitly misleading because of

“important differences” between the covers of the parties’ books). Indeed, AMG has not produced a shred of evidence that even a single consumer or member of the public was confused as to its sponsorship or endorsement of the Construction Sets.

C. **There Is No Serious Likelihood Of Consumer Confusion, Far Less The Type of “Compelling” Case Required To Overcome The First Amendment.**

Recent court decisions almost uniformly have held that the *Rogers* Test (and, particularly, the “explicitly misleading” prong) is different from and replaces (rather than supplements) the multi-factor “likelihood of confusion” test set forth in *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961). This is logical, because if all that was required to overcome the *Rogers* Test was proof of a likelihood of confusion, such a rule would “render *Rogers* a nullity,” *Mattel*, 296 F.3d at 902, and “conflate[] the second prong of the *Rogers* test with the general ... likelihood-of-confusion test, which applies outside the *Rogers* context of expressive works.” *Empire*, 875 F.3d at 1199.¹⁸ See also *ETW*, 332 F.3d at 926 (when expressive works are involved, “the likelihood of confusion test is not appropriate because it fails to adequately consider the interests protected by the First Amendment”); *Novalogic*, 41 F.3d at 901 n.20 (rejecting the “intermingling” of *Rogers* and the likelihood of confusion test). As noted, *Rogers* assumes that some consumers might be confused, and accepts that risk as a necessary corollary to free speech rights. 875 F.2d at 1001. See also *Brown*, 724 F.3d 1246 (the “impact of the use” is not relevant to whether the use is “explicitly misleading”).

The Second Circuit in *Rogers* expressly eschewed the *Polaroid* test, and *Cliffs Notes* acknowledged that it was “at best awkward” as applied to artistic expression. 886 F.2d at 495

¹⁸ See also *Louis Vuitton.*, 868 F. Supp. 2d at 184 (“[E]ven assuming, *arguendo*, that Louis Vuitton could state a cognizable claim of confusion, [the use] is protected under *Rogers* because it has some artistic relevance to the Film and is not explicitly misleading.”); *Soul Train*, 67 F. Supp. 3d at 606 (“None of the [confusion] allegations in the Complaint here suffice to plead that Defendants’ inclusion of Plaintiff ‘explicitly misleads as to the source or content of the work.’”).

n.3.¹⁹ Nevertheless, to the extent that the Second Circuit has suggested (in a different context) that the *Rogers* analysis should also include some consideration of the *Polaroid* factors, it also recognized that the likelihood of confusion must be “*particularly compelling* to outweigh the First Amendment interest recognized in *Rogers*” and that it is the *plaintiff’s* burden to overcome the “*presumption* of *Rogers*.” *Twin Peaks Prods, Inc. v. Pub. Int’l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993) (emphasis added). *See also Cliffs Notes*, 886 F.2d at 494 (*Rogers* emphasized “construing the Lanham Act narrowly when First Amendment values are involved.”).²⁰

Even assuming that the *Polaroid* factors are relevant, application of those factors to the undisputed facts conclusively establishes that there is no legitimate probability of consumer confusion – far less a particularly compelling risk – among “numerous ordinary prudent purchasers” as to AM General’s endorsement, sponsorship, or approval of the Accused Games. *Estee Lauder Inc. v. The Gap, Inc.*, 108 F.3d 1503, 1510 (2d Cir. 1997).²¹ Judge McKenna’s detailed analysis in *Girl Scouts v. Bantam Doubleday Dell Pub. Group*, 808 F. Supp. 1112 (S.D.N.Y. 1992), *aff’d*, 996 F.2d 1477 (2d Cir. 1993), is instructive. In *Girl Scouts*, the court concluded that it was “possibly not required to [apply the *Polaroid* factors] in light of *Cliffs Notes* and *Rogers*.” Nevertheless, after assessing those factors the court easily concluded that the

¹⁹ *See also Lombardo v. Dr. Seuss Enterprises, L.P.*, 279 F. Supp. 3d 497, 514 n.1 (S.D.N.Y. 2017) (declining to “work through” the *Polaroid* factors); *Caterpillar Inc. v. Walt Disney Co.*, 287 F. Supp. 2d 913, 919 (C.D. Ill. 2003) (“This is not a case where the Court can apply the traditional likelihood of confusion factors with any degree of comfort.”).

²⁰ Since expressive uses often seek to deliberately reference a well-known mark and “*Rogers* teaches us that mark owners must accept ‘some’ confusion when outweighed by free speech interests,” *Louis Vuitton*, 868 F. Supp. 2d at 184 n.19, factors such as the strength of the mark, the defendant’s intent, and actual confusion must be viewed in a different light. *Id.* (“factors (1) [the strength of the mark] and (6) [the defendant’s good faith (or bad faith) in adopting its own mark] do not really apply”); *Lombardo*, 279 F. Supp. 3d at 514 n.1 (S.D.N.Y. Sept. 15, 2017) (in a parody case the allegedly infringing work “must evoke the original and constitutes artistic expression”).

²¹ Even *without* weighing First Amendment concerns, this Circuit requires not just a possibility of confusion, but a “*probability*” of confusion. *FC Online Mktg., Inc. v. Burke’s Martial Arts, LLC*, 2015 WL 4162757, at *29–30 (E.D.N.Y. July 8, 2015).

use of plaintiff's trademarks in connection with a children's book was not so likely to confuse consumers so as to outweigh the defendant's First Amendment rights. 808 F. Supp. at 1122.

Many other courts have come to the same conclusion, uniformly holding that when products or vehicles are depicted in expressive works (and their trailers), consumers are not likely to be confused because "the appearance of products bearing well known trademarks in cinema and television is a common phenomenon" and "action movies frequently feature automobiles in a variety of situations." *Caterpillar*, 287 F. Supp. 2d at 919; *see also Gottlieb*, 590 F. Supp. 2d at 635 (S.D.N.Y. 2008) (no plausible confusion where the plaintiff's product appeared in a movie); *Sherwood*, 213 F. Supp. 2d at 377 (depiction of plaintiff's buildings in movie was unlikely to confuse); *Wham-O*, 286 F. Supp. 2d at 1262 (depiction of plaintiff's product in movie and promotional campaign was not likely to confuse). The same is true here.

Strength of the Mark. The strength of a mark is "examined principally in the market in which the mark is used" (i.e. video games). *Morningside Group Ltd. v. Morningside Capital Group, L.L.C.*, 182 F.3d 133, 139 (2d Cir.1999). Additionally, because a mark's "strength" refers to its "secondary meaning," it is irrelevant whether members of the public might recognize a Humvee as a Humvee. The test for secondary meaning is not whether the consumer recognizes the product, but whether the design of the product serves a *source-identifying* function. *See Atlantis Silverworks, Inc. v. 7th Sense, Inc.*, 1997 WL 128403, at *4 (S.D.N.Y. Mar. 20, 1997) ("Plaintiff's evidence does not establish secondary meaning; it establishes merely that plaintiff's product ... was popular."); *Rock and Roll Hall of Fame v. Gentile Productions*, 134 F.3d 749, 755 (6th Cir. 1998) ("Even if we accept that consumers recognize the various drawings and pictures of the Museum's building design as being drawings and pictures of the Museum... such recognition is not the equivalent of the recognition that these various drawings or photographs

indicate a single source of the goods on which they appear.”). That is a test that AMG cannot meet, especially with respect to video games and other audiovisual works.

[REDACTED]

[REDACTED]

[REDACTED] *See e.g., MZ Wallace Inc. v. Fuller*, 2018 WL 6715489, at *10 (S.D.N.Y. Dec. 20, 2018) (“The evidence of the ubiquity of this third-party use in the market significantly undercuts the plaintiff’s efforts to show that its Trade Dress has achieved secondary meaning.”); *Malaco Leaf, AB v. Promotion In Motion, Inc.*, 287 F. Supp. 2d 355, 364 (S.D.N.Y. 2003) (failure to police trade dress was evidence that alleged trade dress was weak). *See* *SUF*, ¶¶ 47-50. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] *See Girl Scouts*, 808 F. Supp. at 1123-24 (because plaintiffs “never produced significant quantities of children’s fictional books using [its] marks,” consumers would not “conclude that a children’s book with ‘scouts’ in the title and whose content deals with ‘scouting’ is associated with their organizations”).

[REDACTED]

[REDACTED]

[REDACTED] *Mattel*, 296 F.3d at 900-01 (“[T]he trademark owner does not have the right to control public discourse whenever the public imbues his mark with a meaning beyond its source-identifying function.”). That makes the First Amendment interests especially strong. “Prominence invites creative comment. Surely, the range of free expression would be

meaningfully reduced if prominent persons in the present and recent past were forbidden topics for the imaginations of authors of fiction.” *Girl Scouts*, 808 F. Supp. at 1120, quoting *Guglielmi v. Spelling-Goldberg Prod.*, 603 P.2d 454, 460 (1979) (Bird, C.J., concurring).

Similarity of the Marks. “[W]hen comparing two marks, consideration must be given to the “contexts in which the public is exposed to them.” *See Girl Scouts*, 808 F. Supp. at 1124. The context of the parties’ respective uses is completely different. AMG uses its purported trade dress almost exclusively to market military trucks, and it uses the “HMMWV” and “Humvee” names (which AMG did not invent) to identify those trucks to its potential purchasers. By contrast, as AMG admits, Activision modeled its virtual Humvees with a degree of accuracy to authentically depict its virtual world, and uses the Humvee name to describe its depiction of the real military vehicle. *See Cliffs Notes*, 886 F.2d at 494 (“It is hard to imagine, for example, a successful parody of Time magazine that did not reproduce Time’s trademarked red border.”). Moreover, all of the Activision products at issue prominently bear Activision’s own trademarks and logos, thereby “ensur[ing] that the goods at issue would be associated with the defendant and not the plaintiff.” *Girl Scouts*, 808 F. Supp. at 1125. *See also Hormel Foods Corp. v. Jim Henson Productions, Inc.*, 73 F. 3d 497, 503-04 (2d Cir. 1996) (“[P]lacement of the marks next to other identifying but dissimilar symbols is clearly relevant.... The words ‘Muppet Treasure Island’ always will be prominently displayed wherever the name ‘Spa’am’ appears.”).

Proximity of Goods and “Bridging the Gap.” As the Ninth Circuit explained: “[i]f we see a painting titled ‘Campbell’s Chicken Noodle Soup,’ we’re unlikely to believe that Campbell’s has branched into the art business. Nor, upon hearing Janis Joplin croon ‘Oh Lord, won’t you buy me a Mercedes Benz?’ would we suspect that she and the carmaker had entered into a joint venture.” *Mattel*, 296 F.3d. at 902. *See also Wham-O*, 286 F. Supp. 2d at 1262

(“Consumers and viewers will not mistake plaintiff for a movie production house, and consumers and viewers will not mistake defendants for a purveyor of toys.”). The same is true here.²²

Military trucks and video games are “entirely dissimilar.” *See Louis Vuitton*, 868 F. Supp. 2d at 184; *see also Volkswagen AG v. Dorling Kindersley Publishing, Inc.*, 614 F. Supp. 2d 793, 802 (E.D. Mich. 2009) (book shaped like a Volkswagen Beetle was not “related” to the vehicle.). In fact, “[t]here is no product of [AMG] that is directly analogous to [Activision’s products].” *See Girl Scouts*, 808 F. Supp. at 1126. [REDACTED]

[REDACTED]. SUF, ¶ 51. *See Tommy Hilfiger Licensing v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 419 (S.D.N.Y. 2002) (“Plaintiff has presented no evidence that it is likely to bridge the gap and offer a [product] like defendant’s.”). Activision has never made a military truck and does not intend to. SUF, ¶ 72.

Marketing Channels and Sophistication of Purchasers. [REDACTED]

[REDACTED] SUF, ¶ 26; *Astra Pharmaceutical Prod. v. Beckman Instruments*, 718 F. 2d 1201, 1206 (1st Cir. 1983) (“The decision to buy a machine worth thousands of dollars is obviously not done on an impulse, and involves a careful consideration of the reliability and dependability of the manufacturer and seller of the product.”). Activision sells the Accused Games to retail customers, via online platforms, video game specialty stores, or electronics retailers – none of which sells Humvees. SUF, ¶ 73. Though more affordable than a Humvee, the Accused Games sell for \$60 upon their release, are not “impulse purchases,” and are not

²² Even if Humvees were occasionally licensed for use in a video game, that still would not make the parties’ goods “related,” because this factor focuses on the “central purpose” of the company; not “sporadic and marginal” activities. *Girl Scouts*, 808 F. Supp. at 1127. *See also Hormel*, at *6 (only “primary products” are relevant to the analysis, not licensed merchandise). [REDACTED]

[REDACTED] UF, ¶ 50.

going to be mistakenly purchased instead of a Humvee. *Id.*; *Cliffs Notes*, 886 F.2d at 496.

Rather, video game purchasers, like purchasers of records or movie tickets, generally make their decisions based on their knowledge of the product, reviews and word of mouth. *See Sunenblick v. Harrell*, 895 F. Supp. 616, 634 (S.D.N.Y. 1995) (“[B]uyers of musical recordings are relatively sophisticated consumers whose purchasing decisions are driven by a recognition of and search for a particular artist or composition.”) *aff’d*, 101 F.3d 684 (2d Cir. 1996).

Actual Confusion. The existence of actual confusion (or lack thereof) is “perhaps the most significant factor when considering the overall likelihood of confusion by the public.” *MasterCard Intern. Inc. v. Nader 2000 Primary Committee, Inc.*, 2004 WL 434404, at *3 (S.D.N.Y. Mar. 8, 2004) (Daniels, J.). Even though the Accused Games have been in wide circulation for as long as 12 years and played by millions of people around the world, there is no evidence that any bona fide purchaser actually was confused as to AMG’s sponsorship, affiliation or endorsement of the Accused Games – far less that any confusion resulted in a purchase. *SUF*, ¶¶ 74-75.²³ *Louis Vuitton*, 868 F. Supp. 2d at 183 n.17 (“core concern” of the Lanham Act is “confusion related to purchasing decisions.”). That fact is “significant,” if not dispositive. *See Girl Scouts*, 808 F. Supp. at 1128. *See also Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 117 (2d Cir. 2009) (co-existence “for eleven years with no report of a single customer being confused is a ‘powerful indication’ that there is no confusion or likelihood of confusion”); *Sarelli*, 322 F. Supp. 3d at 436 (“That Plaintiffs and Defendants have used

²³ *Rogers* makes clear that survey evidence is not relevant to whether a use is “explicitly misleading.” Even if some consumers might draw an incorrect inference, “that risk of misunderstanding, not engendered by any overt claim...is so outweighed by the interests in artistic expression as to preclude application of the Lanham Act.” Nevertheless, the lack of consumer confusion was confirmed in a survey. *SUF*, ¶ 76. Dr. Deborah Jay asked potential purchasers to view two trailers for *MW2* and answer a series of questions in the format endorsed in *Union Carbide Corp. v. Ever-ready Inc.*, 531 F.2d 366 (7th Cir. 1976). *Not a single one* of the surveyed consumers expressed a belief that AMG was the source of *MW2*, or sponsored, endorsed or authorized that game. *SUF*, ¶ 76.

similar marks over a substantial period of time without ever producing a single recorded instance of consumer confusion shows that there is no likelihood of consumer confusion.”).

Intent To Confuse. It is not enough for AMG to demonstrate Activision intended to *use* the Humvee in its Games. “[T]he only relevant intent is the intent to *confuse*.” 4 McCarthy on Trademarks § 23:111 (5th ed.). *See also Star Indus., Inc. v. Bacardi & Co., Ltd.*, 412 F.3d 373, 388 (2d Cir. 2005) (“Bad faith generally refers to an attempt by a junior user of a mark to exploit the goodwill and reputation of a senior user *with the intent to sow confusion* between the two companies’ products.”); *MasterCard*, 2004 WL 434404, at *4 (Daniels, J.) (“The relevant intent in this inquiry is whether the alleged infringer intended “to palm off his products as those of another.”). Activision never intended to appropriate Plaintiff’s goodwill for the purpose of *confusing* or misleading customers, but rather to create a realistic, convincing virtual world, which included depicting the vehicles the U.S. military used during the relevant time period. SUF ¶ 113. The mere intent to copy or reference a mark is not equivalent to an intent to confuse, especially when, as here, such use or copying is relevant to the defendant’s artistic purpose. *See Hormel*, 73 F.3d at 505 (no bad faith despite intent to copy “Spam” trademark, because the defendant’s artistic purpose “depends on consumer recognition”).

AMG’s Delay. The *Polaroid* factors, while instructive, do not “exhaust the possibilities” and “the court may have to take still other variables into account.” *Polaroid*, 287 F.2d at 495. Among “other variables” are “the senior user’s delay in asserting its claim, and the harm to the junior user as compared to the benefit to the senior user . . .” *Inc. Pub. Corp. v. Manhattan Magazine, Inc.*, 616 F. Supp. 370, 378 (S.D.N.Y. 1985). AMG’s lengthy delay in asserting its claims against Activision is unexplained and inexplicable. The *Modern Warfare* games were among the most publicized in history and received extensive coverage on major news networks,

late-night talk shows, mainstream magazines and newspapers, and social media. SUF, ¶ 6; *see, e.g.*, Complaint at 24 & Ex. 13; *Charles Atlas, Ltd. v. DC Comics, Inc.*, 112 F. Supp. 2d 330, 334 (S.D.N.Y. 2000) (comic books were “open and notoriously published”). Either AMG was aware of the Accused Games and deliberately elected not to pursue claims (as has been its longtime policy concerning movies), or any purported confusion was so minor and isolated that AMG never even became aware that it might have a claim. *See Atlas*, 112 F. Supp. 2d at 340 (purported failure to notice the alleged infringement for seven years was a “strong indicator” of no significant likelihood of confusion). The delay also is highly prejudicial; had AMG asserted its claims in 2007, Activision could have sought judicial intervention or guidance long ago, well before it began development of the later games in the franchise.²⁴

II. **AMG DOES NOT HAVE A PROTECTABLE TRADE DRESS.**

Although the Court need not reach the issue to decide this Motion, the undisputed facts confirm that AMG cannot meet its burden of proving a protectable trade dress, for at least three reasons.²⁵ These are independent bases for dismissing AMG’s trade dress claims, and also reinforce the overwhelming balance in Defendants’ favor under *Rogers* and *Polaroid*.

A. **AMG Humvees Do Not Have A Consistent Overall Look**

AMG’s trade dress claims are premised upon the so-called “AM General Trade Dress,” which AMG contends is comprised of numerous “distinctive features” of its line of “HUMVEE-branded vehicles.” SUF, ¶¶ 94, 114. Because AMG is claiming trade dress in a line of vehicles

²⁴ Activision’s affirmative defense of laches is yet another basis for summary judgment. Because AMG intends to separately address Activision’s laches defense, Activision will address that defense in response to AMG’s Motion.

²⁵ AMG’s registration of just three elements of its purported trade dress is of no assistance, because the registration was not issued until **2016** (after the events that give rise to this lawsuit) and AMG’s trade dress claims go far beyond its registration. SUF, ¶ 92, *Converse, Inc. v. Int’l Trade Comm’n Skechers U.S.A., Inc.*, 909 F.3d 1110, 1118 (Fed. Cir. 2018) (“registration confers a presumption of secondary meaning beginning only as of the date of registration and confers no presumption of secondary meaning before the date of registration”).

rather than a single product, it “has a burden which most plaintiffs alleging trade dress infringement do not need to carry. ... [It] must establish that its [vehicles] have a consistent overall look.” *Walt Disney Co. v. Goodtimes Home Video Corp.*, 830 F. Supp. 762, 765 (S.D.N.Y. 1993); *see also Yurman Design, Inc.*, 262 F.3d at 116 (“a plaintiff seeking trade dress protection for an entire product line must establish that the ‘overall look’ in each separate product is ‘consistent’”). The Second Circuit has recognized this as a “particularly difficult challenge” for a plaintiff such as AMG, because “when protection is sought for an entire line of products, our concern for protecting competition is acute.” *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 380 (2d Cir.1997).

The undisputed facts establish that AMG’s various Humvees do not have a “consistent overall look.” [REDACTED]

[REDACTED] SUF, ¶ 93 (emphasis added). [REDACTED]

[REDACTED] and that many supposed trade dress features are present only in “certain configurations.” Compl., ¶ 20; SUF, ¶ 93. The extreme degree of variation among models of Humvees is readily apparent from AMG’s own documents— [REDACTED]

[REDACTED]. SUF, ¶ 95. The “overall shape” of those vehicles, however, is quite different, and many of the claimed elements of the AM General Trade Dress are missing from the majority of the models of Humvees. For example, the slanted rear is apparent on only a handful of the Humvees; others have open backs, and still others have a squared-off rear. *Id.*, ¶ 96. Similarly, while AMG claims that an x-pattern on the doors is a feature of both its common law and registered trade dress, hardly any of the

vehicles reflected in AMG’s own materials have that feature (and some lack doors entirely). *Id.*, ¶ 97.²⁶ AMG’s undisputable “failure consistently to use ... its generally described trade dress means that its trade dress claims must fail.” *Elements/Jill Schwartz, Inc. v. Gloriosa Co.*, 2002 WL 1492197, at *5 (S.D.N.Y. July 15, 2002); *see also Maharishi Hardy Blechman Ltd. v. Abercrombie & Fitch*, 292 F. Supp. 2d 535, 550 (S.D.N.Y. 2003) (no trade dress rights where “a number of [the plaintiff’s products] do not bear some features of the asserted trade dress”).

B. AMG Cannot Prove That Its Claimed Trade Dress Has Secondary Meaning.

AMG also cannot meet its burden of proving that the Humvee’s inconsistent design has “secondary meaning” – that is, that “the primary significance” of the alleged trade dress of Humvee vehicles in the minds of the public “is not the product [Humvees] but the producer [AMG].” *Centaur Comm., Ltd. v. A/S/M Comm., Inc.*, 830 F.2d 1217, 1221 (2d Cir. 1987). *See also Major League Baseball Properties, Inc. v. Opening Day Prods., Inc.*, 385 F. Supp. 2d 256, 274 (S.D.N.Y. 2005) (Daniels, J.) (“The crux of the doctrine of secondary meaning is that the mark comes to identify not only the goods but the source of those goods.”).

“[P]roof of secondary meaning entails rigorous evidentiary requirements.” *Thompson Medical Co., Inc. v. Pfizer Inc.*, 753 F. 2d 208 (2d Cir. 1985). But AMG has not produced *any* evidence that any aspects of the claimed trade dress serve as a “brand” that identifies products sourced by AMG to members of the consuming public. For example, AMG has not produced any survey evidence, customer testimony, or market research to establish that a significant portion of the public associates Humvees with AMG. SUF, ¶ 98; *see Kaufman & Fisher Wish Co., Ltd. v. F.A.O. Schwarz*, 184 F. Supp. 2d 311, 318 (S.D.N.Y. 2001) (“No survey evidence or

²⁶

SUF, ¶ 97, 103.

direct consumer testimony supports the conclusion that the public identifies the design of [the product] with a particular source.”), *aff'd*, 51 F. App'x 335 (2d Cir. 2002). AMG has not even purported to claim (far less prove) that members of the public associate visual depictions of Humvees in popular media with AMG. *Rock and Roll Hall of Fame*, 134 F.3d at 754.

AMG also cannot prove secondary meaning through media attention, such as depictions of Humvees in use by the Army by newspapers or cable news outlets. Documents produced by AMG demonstrates that media attention does not refer to or call attention to AMG's trade dress “as an indicator of source or otherwise.” *SUF LVL XIII Brands, Inc. v. Louis Vuitton Malletier S.A.*, 209 F. Supp. 3d 612, 658–59 (S.D.N.Y. 2016), *aff'd* 720 F. App'x 24 (2d Cir. 2017); *see* *SUF* ¶ 99. Since Humvees do not bear any corporate branding (e.g. hood ornaments, emblems, or logos), cannot be purchased by civilians, and are nearly always depicted without any mention of AMG (or, at most, referring to AMG only as the “manufacturer” of the vehicle for the military) none of that media would cause a consumer to associate the Humvee with AMG. *See Lopez v. Gap, Inc.*, 883 F. Supp. 2d 400, 427 (S.D.N.Y. 2012) (media coverage unhelpful where there was no evidence that “consumers connected the [item] depicted in the [media] to him or his company”). If anything, media attention has caused its vehicle to be most often associated with the *Army* and the U.S. military. *See* *SUF*, ¶¶ 23, 26, 37-39. This is not surprising, since the Army has made extensive use of the Humvee as part of its *own* marketing (e.g. in its recruiting advertisements, public displays, television, and even its own video game franchise). *SUF*, ¶ 39.²⁷

²⁷ To the extent AMG engaged in advertising for Humvees, its advertising was extremely limited. [REDACTED]. *See* *SUF*, ¶ 29. Advertising alone is “insufficient to sustain a finding of secondary meaning.” *Sage Realty Corp. v. Sage Grp., Inc.*, 711 F. Supp. 134, 144 (S.D.N.Y. 1989). Even if it were, AMG's trademarks would be limited to the discrete group AMG advertised to, and not to the public. *See Lopez*, 883 F. Supp. 2d at 426 (no secondary meaning; plaintiff failed to “come forward with any evidence that [its] marketing activities succeeded in reaching a relevant segment of the population such that consumers associate” the marks with defendant).

Also fatal to AMG’s claim of secondary meaning is its admission that it is not the exclusive seller or “single source” of vehicles with the claimed trade dress. *Coca-Cola Co. v. Koke Co.*, 254 U.S. 143, 146 (1920) (consuming public must view the mark as denoting “a single thing coming from a *single source*”) (emphasis added). Instead, AMG shares with GM’s *Hummer* vehicles almost all of its claimed trade dress, such as its shape, windshield design, and grille. SUF, ¶ 32. [REDACTED] . *Id.*, ¶ 34. See, e.g., *Philip Morris Inc. v. R. J. Reynolds Tobacco Co.*, 1975 WL 21170, at *4 (S.D.N.Y. Oct. 24, 1975) (no secondary meaning where “the number of consumers who associated [trademark] with one brand or the other ... was approximately equal”). In fact, there is so much confusion about who owns what elements of Humvee vehicles that between 2005 and 2013, **GM** maintained and renewed trade dress registrations for the *Humvee*, separate from its “Hummer” registrations. SUF, ¶ 35. At no point during that seven-year period did the USPTO (or for that matter, AMG) object that the “source” of Humvees should be AMG, not GM. *Id.*, ¶ 36.

C. AMG Cannot Prove That Its Alleged Trade Dress Is Non-Functional.

Finally, AMG cannot meet its burden of establishing that its purported trade dress is non-functional. This is separately dispositive. 15 U. S. C. § 1125(a)(3); see *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 29-30 (2001) (noting “well-established rule that trade dress protection may not be claimed for product features that are functional,” and presumption that “features are deemed functional until proved otherwise by the party seeking trade dress protection”). All of the elements claimed by AMG as part of its trade dress have a very obvious functional purpose, including because the design of the Humvee was born from functional specifications required by the U.S. military. SUF, ¶¶ 101-112; see *TrafFix Devices, Inc.*, 532 U.S. at 33 (“a feature is ... functional when it is essential to the use or purpose of the device or

when it affects the cost or quality of the device”). AM General even has touted in its marketing materials that Humvees are “a *pure example of form following function*,” and that the “looks” of the vehicles are “a result of [their] requirements.” SUF, ¶ 100 (emphasis added). Such statements constitute “strong evidence of functionality.” *Schutte Bagclosures Inc. v. Kwik Lok Corp.*, 193 F. Supp. 3d 245, 271 (S.D.N.Y. 2016), *aff’d*, 699 F. App’x 93 (2d Cir. 2017).

III. AMG’S DILUTION CLAIMS FAIL AS A MATTER OF LAW.

AMG purports to state federal and state claims under the Federal Anti-Dilution Act, 15 U.S.C. §1125(c) (its Eighth Cause of Action) and New York’s anti-dilution statute, N.Y. Gen. Bus. Law §360-1 (its Twelfth Cause of Action). Both claims arise from the assertion that the “distinctiveness” of AMG’s trademarks and trade dress have been “blurred” by Activision’s depiction of Humvees in the Accused Games.

The Court need not determine whether “blurring” actually occurred in order to dismiss AMG’s claims. With respect to AMG’s New York state law claims, “the same First Amendment considerations that limit a cause of action under the Lanham Act apply also to a cause of action [for dilution] under New York law.” *Yankee Pub.*, 809 F. Supp. at 282; *Louis Vuitton*, 868 F. Supp. 2d at 184 (“Louis Vuitton’s pendant state law claim... [is] likewise dismissed because [it is] based on the same permissible conduct as its Lanham Act claim.”). As for AMG’s federal dilution claims, these are completely barred by 15 U.S.C. §1125(c)(3)(C), which exempts any “noncommercial” uses of a trademark. As explained by the Ninth Circuit (and confirmed by the legislative history) “the ‘core notion of commercial speech is that it does no more than propose a commercial transaction.’ If speech is not ‘purely commercial’ – that is, if it does more than propose a commercial transaction – then it is entitled to full First Amendment protection.” *Mattel*, 296 F.3d at 906. *See also Radianc Found. v. NAACP*, 786 F.3d 316, 331 (4th Cir. 2015) (same). The Accused Games do far more than “propose a commercial transaction.” They are

highly expressive works of authorship that tell a story and communicate ideas to the player.

Even if the Court were to further consider the issue, AMG still cannot succeed as a matter of law. As set forth above, AMG cannot prove that its “brand” is “extremely strong” (as required by the state statute), *Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1033 (2d Cir. 1989) – far less that it is “famous” (as required by the federal statute). It also cannot prove that its brand (to the extent it exists) has been “blurred” by Activision’s use. Blurring occurs only “where the defendant uses or modifies the plaintiff’s trademark to identify the *defendant’s* goods and services.” *Sarelli*, 322 F. Supp. at 439 (emphasis added). Humvees never appear in the Accused Games to identify *Activision’s* goods.

Perhaps more critically, at the time the Accused Games were released, any source-identifying power that AMG’s purported marks ever might have had in the field of video games *already* had been blurred or diluted [REDACTED]. 15 U.S.C. §1125(c)(2)(B)(iii); *see* 4 McCarthy on Trademarks and Unfair Competition § 24:87 (5th ed.) (“Many marks alleged to have been ‘diluted’ have been held to be already so ‘diluted,’ weak and commonplace that there was no distinctive quality left to dilute by another.”); *Nissan Motor Co. v. Nissa Computer Corp.*, 2007 WL 9374946, at *17 (C.D. Cal. Sept. 21, 2007) (“[A] failure to [police] must be considered as part of the dilution analysis.”). *See* *SUF*, ¶¶ 41-50, 52-55. [REDACTED].

IV. AMG’S REMAINING STATE LAW CLAIMS FAIL FOR THE SAME REASONS THAT ITS FEDERAL CLAIMS FAIL.

AMG also asserts a series of tag-along claims under New York state law for trademark infringement, trade-dress infringement, unfair competition, and trademark dilution. All of these claims are premised on the exact same facts as Plaintiff’s analogous Lanham Act claims. *See*,

e.g., Compl. ¶¶ 139, 148, 157, 167, 174 (“replead[ing] and incorporat[ing] by reference” earlier allegations for state-law claims). *See also Kregos v. Assoc. Press*, 795 F. Supp. 1325, 1336 (S.D.N.Y. 1992) (“The standards for §43(a) claims under the Lanham Act and unfair competition claims under New York law are virtually the same.”), *aff’d*, 3 F.3d 656 (2d Cir. 1993). “Since the First Amendment defense applies equally to [plaintiff’s] state law claims as to its Lanham Act claim,” the Court must “dismiss[] the entire case,” including the state law claims. *E.S.S.*, 547 F.3d at 1101. *See also Medina*, 2016 WL 3906714, at *6 (dismissing state law claims); *Lombardo*, 279 F. Supp. 3d at 515 (same); *Atlas.*, 112 F. Supp. 2d at 341 (same).²⁸

V. AMG CANNOT RECOVER MONETARY DAMAGES OR PROFITS.

“It is well-settled law that in order for a Lanham Act plaintiff to receive an award of damages, the plaintiff must prove either actual consumer confusion or deception resulting from the violation, or that the defendant's actions were intentionally deceptive...” *George Basch Co. v. Blue Coral, Inc.*, 968 F.2d 1532, 1540 (2d Cir. 1992). The same is true under New York law. *See Perfect Fit Industries, Inc. v. Acme Quilting Co.*, 618 F.2d 950, 955 (2d Cir. 1980). Additionally, even where actual confusion has been established, “a plaintiff must prove that an infringer acted with willful deception before the infringer's profits are recoverable by way of an accounting.” *Blue Coral*, 968 F.2d at 1540.

AMG cannot prove that any consumer was actually confused as to its affiliation, sponsorship or endorsement of the Accused Games, the Strategy Guides, or the Construction Sets – far less that such confusion impacted a purchasing decision. Additionally, as set forth

²⁸ AMG also asserted claims for “false advertising” under the Lanham Act and New York law, based on the allegations that (1) “Defendants have stated to third party manufacturers that they have authority to approve the use of the AM General Trade Dress in connection with the advertising, promotion, and sale of goods and services when in fact Defendants never had such authority,” and (2) “user guides” included *inside* the COD Games “misrepresent” the existence of a license. Compl., ¶ 133-34, 168-69. Activision never made any false or misleading statement to *anyone* with respect to its purported “authority” to use AMG’s trade dress.

above, AMG cannot prove that Activision “sought to *confuse consumers* about the source of their product[s].” *Toni & Guy (USA) Ltd. v. Nature’s Therapy, Inc.*, 2006 WL 1153354, at *10 (S.D.N.Y. May 1, 2006) (emphasis added). *See also Gottlieb*, 590 F. Supp. 2d at 635 (“There is no indication that Paramount deliberately placed the [product] into the scene to capitalize on the good will associated with [plaintiff’s] mark.”); *Caterpillar*, 287 F. Supp. 2d at 919 (use of trademarks in a movie is not bad faith). Rather, because Activision had “absolutely nothing to gain” from any consumer confusion, *Yankee Pub.*, 809 F. Supp. at 275, it sought to eliminate confusion by placing its own name and logo prominently on the products. SUF, ¶ 66; *Desly Int’l Corp. v. Otkrytoe Aktsionernoe Obshchestvo*, 2017 WL 5157614, at *7 (E.D.N.Y. Nov. 6, 2017) (use of own logo “strongly suggests that it was trading on its own name and not any willful infringement of Spartak’s mark”). Any claim of willfulness is particularly frivolous as to the Construction Sets, which do not use the “Humvee” name or AMG’s claimed trade dress. SUF, ¶ 86. As a result, neither actual damages *nor* disgorgement of profits is available to AMG.²⁹

CONCLUSION

For the foregoing reasons, summary judgment should be granted in Activision’s favor.

DATED: New York, New York
May 31, 2019

Mitchell Silberberg & Knupp LLP

By: Karin G. Pagnanelli
Karin G. Pagnanelli (kgp@msk.com)
Marc E. Mayer (mem@msk.com)
Bradley J. Mullins (hjm@msk.com)
2049 Century Park East, 18th Floor
Los Angeles, CA 90067-3120
Telephone: (310) 312-2000
Facsimile: (310) 312-3100
Attorneys for Defendants

²⁹ “[A]warding the disgorgement of the defendant’s profits and plaintiff’s own lost profits based on the same sales would constitute an impermissible double recovery.” *Church & Dwight Co. v. SPD Swiss Precision Diagnostics GmbH*, 2018 WL 4253181, at *16 (S.D.N.Y. Sept. 5, 2018).