

1 **I. FACTUAL BACKGROUND AND PROCEDURAL HISTORY**

2 This case arises out of a video game company’s alleged unauthorized use
3 of a celebrity’s likeness in a series of video games. Plaintiff James “Jim” Brown
4 (“Brown”) is a retired professional football player and a member of the collegiate
5 and NFL football Halls of Fame. He is also an actor and activist. Amended
6 Complaint (“AC”) ¶¶ 9-14. Defendant Electronic Arts, Inc. (“EA”) develops and
7 publishes video games, including the popular *Madden NFL* series. Brown alleges
8 that EA has been publishing *Madden NFL* games since 1989, with great
9 commercial success. *Id.* at ¶ 24.

10 Each *Madden NFL* game contains up to 170 virtual teams and
11 approximately 1,500 virtual players.¹ *See, e.g.*, Strauser Decl. ¶ 7 (citing Exhibits
12 A-H). EA has a licencing agreement with the NFL (*Id.* at ¶ 11), but does not have
13 one with Brown. AC ¶ 18.

14 In the games, virtual players on current NFL teams wear the names and
15 numbers of real-life players, whereas players on historical teams are anonymous,
16 represented by numbers and roster positions. Strauser Decl. ¶ 7. The players
17 compete in virtual stadiums, where they are cheered by virtual fans and coached
18 by virtual coaches; all these are designed by the games’ graphic artists. *Id.* at ¶ 5.
19 A soundtrack, voice commentary, and sound effects accompany the action. *Id.*

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21 ¹ Brown’s Amended Complaint did not include the games as exhibits. In ruling
22 on a 12(b)(6) motion, a court generally cannot consider material outside of the
23 complaint (e.g., facts presented in briefs, affidavits, or discovery materials). *See, e.g.*,
24 *Knievel v. ESPN*, 393 F.3d 1068, 1076 (9th Cir. 2005). However, under the
25 “incorporation by reference” doctrine, a court may consider additional material if: the
26 plaintiff’s claims depend on the contents of a document; the defendant attaches the
27 documents to its motion to dismiss; and the parties do not dispute the documents’
28 authenticity. *Id.* Here, Brown alleges that the *Madden NFL* games used his likeness.
Brown’s claims depend on the games’ content. EA has attached the games to its
motion, and Brown has not challenged the games’ authenticity. Thus, the Court will
consider the games’ content under the “incorporation by reference” doctrine.

1 On July 22, 2009, Brown filed his First Amended Complaint. Therein,
2 Brown asserts an unfair competition claim under Section 43(a) of the Lanham
3 Act, 15 U.S.C. §1125(a), under a theory of false endorsement. He also sues for
4 invasion of privacy under California common law and Cal. Civ. Code §3344, and
5 for unlawful business practices in violation of Cal. Bus. & Prof. Code 17200 *et*
6 *seq.* Brown alleges that EA misappropriated his name, identity, and likeness by
7 including him in the games as a player on two “historic” teams: the 1965
8 Cleveland Browns team and the All Browns team. The character who
9 purportedly represents Brown in the game is anonymous, and wears jersey
10 number 37; Brown wore number 32. Brown alleges that EA altered the jersey
11 numbers and made other superficial changes to the character intentionally, to
12 avoid liability. AC ¶ 22. Brown and his doppelgänger have “nearly identical”
13 statistics. *Id.*

14 On August 7, 2009, EA filed a Motion to Dismiss all counts of the
15 Amended Complaint (docket no. 28) and a concurrent Motion to Strike the three
16 non-federal causes of action (docket no. 29). Brown filed oppositions to both
17 motions on August 31, 2009, and EA replied on September 14, 2009. Here, the
18 Court will address EA’s Motion to Dismiss only as to Brown’s Lanham Act
19 count.

20 II. STANDARD OF LAW

21 Rule 12(b)(6) permits a defendant to seek dismissal of a complaint that
22 “fail[s] to state a claim upon which relief can be granted.” Fed. R. Civ. P.
23 12(b)(6). Dismissal is proper where a complaint lacks a cognizable legal theory.
24 *Balistreri v. Pacifica Police Dep’t*, 901 F.2d 696, 699 (9th Cir. 1990). All
25 material factual allegations in the complaint are assumed to be true and construed
26 in the light most favorable to the plaintiff. *Nursing Home Pension Fund, Local*
27 *144 v. Oracle Corp.*, 380 F.3d 1226, 1229 (9th Cir. 2004) (“The general rule for
28 12(b)(6) motions is that allegations of material fact made in the complaint should

1 be taken as true and construed in the light most favorable to the plaintiff.”) (citing
2 *Burgert v. Lokelani Bernice Pauahi Bishop Trust*, 200 F.3d 661, 663 (9th Cir.
3 2000)).

4 However, the Court “is not required to accept legal conclusions cast in the
5 form of factual allegations if those conclusions cannot be reasonably drawn from
6 the facts alleged.” *Clegg v. Cult Awareness Network*, 18 F.3d 752, 755 (9th Cir.
7 1994) (internal citations omitted); see also *Bell Atl. Corp. v. Twombly*, 550 U.S.
8 544, 555, 127 S. Ct. 1955, 1964-65, 167 L. Ed. 2d 929 (2007) (“While a
9 complaint attacked by a Rule 12(b)(6) motion to dismiss does not need detailed
10 factual allegations, a plaintiff’s obligation to provide the ‘grounds’ of his
11 ‘entitle[ment] to relief’ requires more than labels and conclusions, and a
12 formulaic recitation of the elements of a cause of action will not do.”)

13 If the Court dismisses the complaint, it must decide whether to grant leave
14 to amend. Denial of leave to amend is “improper unless it is clear that the
15 complaint could not be saved by any amendment.” *Livid Holdings Ltd. v.*
16 *Salomon Smith Barney, Inc.*, 416 F.3d 940, 946 (9th Cir. 2005) (citation omitted).
17 However, the district court’s discretion to deny leave to amend is decidedly
18 broader where the plaintiff has previously filed an amended complaint. *Miller v.*
19 *Yokohama Tire Corp.*, 358 F.3d 616, 622 (9th Cir. 2004) (“Where the plaintiff
20 has previously filed an amended complaint, as Miller has done here, the district
21 court’s discretion to deny leave to amend is ‘particularly broad.’”).

22 III. DISCUSSION

23 The first issue before the Court is Brown’s sole federal cause of action: the
24 alleged violation of Lanham Act Section 43(a), as codified in 15 U.S.C. 1125(a).

25 When, as here, a celebrity brings a false endorsement suit under Section
26 43(a), his “celebrity persona” functions as the “mark.” See *White v. Samsung*
27 *Electronics America, Inc.*, 971 F.2d 1395, 1399-1400 (9th Cir. 1992) (“In cases
28 involving confusion over endorsement by a celebrity plaintiff, ‘mark’ means the

1 celebrity's persona.”). “A false endorsement claim based on the unauthorized use
2 of a celebrity’s identity is a type of false association claim, for it alleges the
3 misuse of a trademark, i.e., a symbol or device such as a visual likeness, vocal
4 imitation, or other uniquely distinguishing characteristic, which is likely to
5 confuse consumers as to the plaintiff’s sponsorship or approval of the product.”
6 *Waits v. Frito Lay, Inc.*, 978 F. 2d 1093, 1110 (9th Cir. 1992).

7 While maintaining that it did not use Brown’s celebrity persona or likeness
8 in the *Madden NFL* games, EA also argues that the First Amendment provides a
9 complete defense to the alleged Lanham Act violation.² The First Amendment
10 can indeed provide a complete defense to a Lanham Act false endorsement claim.
11 *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1101 (9th Cir.
12 2008) .

13 As a preliminary matter, it is important to establish the type of speech at
14 issue; the type of speech determines the appropriate First Amendment test. For
15 example, non-commercial speech receives more robust constitutional protection.
16 *See Hoffman v. Capital Cities/ABC Inc.*, 255 F. 3d 1180, 1184 (9th Cir. 2000).

17 It is well established that “video games are a form of expression protected
18 by the First Amendment.” *Video Software Dealers Ass’n v. Schwarzenegger*, 556
19 F.3d 950, 958 (9th Cir. 2009); accord, *Kirby v. Sega of America*, 144 Cal. App.
20 4th 47, 58 (Ct. App. Cal. 2006) (“Video games are expressive works entitled to as
21 much First Amendment protection as the most profound literature”); *Interactive*
22 *Digital Software Ass’n v. St. Louis*, 329 F.3d 954, 956-58 (8th Cir. 2003) (holding
23 that “violent” video games are a protected form of speech).

24
25 ² To proceed on his Lanham Act claim, Brown would have to demonstrate that
26 EA used his likeness. However, even if Brown can meet that burden at a later point,
27 the operative complaint fails to state a remediable Lanham Act claim because, as
28 described below, it fails on First Amendment grounds. Thus, the Court will proceed
with its inquiry assuming, *arguendo*, that EA used Brown’s likeness.

1 The Ninth Circuit’s decision in *E.S.S.* is especially instructive on the
2 interplay of Lanham Act claims and the First Amendment in the context of video
3 games. *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095 (9th Cir.
4 2008). The game at issue was *Grand Theft Auto: San Andreas*, which contains
5 parodies of existing urban environments. Players interact with these virtual
6 environments as they complete a series of storyline-based missions. *Id.* at 1097.
7 The parties agreed that the video game was expressive speech. *Id.* at 1099. To
8 evaluate the plaintiff’s Lanham Act claim in *E.S.S.*, the court applied the *Rogers*
9 *v. Grimaldi* test,³ which this Circuit has adopted from the Second Circuit. Under
10 *Rogers*, a Lanham Act claim asserted against the creator of an expressive work
11 can succeed only if the “public interest in avoiding consumer confusion
12 *outweighs* the public interest in free expression.” *Id.* at 1099 (quotations and
13 citations omitted, emphasis in original).

14 The *Rogers* test has two prongs. The first prong requires that the
15 defendant’s use of plaintiff’s trademark be relevant to the underlying work: “the
16 level of relevance must merely be above zero.” *Id.* at 1100.

17 If the first prong is satisfied, the Lanham Act claim is still precluded unless
18 the use explicitly misleads consumers about the source or content of the work.
19 *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002) (quoting
20 *Rogers*, 875 F.2d at 999). Even where there is a risk that consumers will wrongly
21 presume that the celebrity endorsed the work, the risk may be outweighed by
22 public interest in artistic expression. *Rogers*, 875 F.2d at 1001.

23 The Ninth Circuit has confirmed that the *Rogers* analysis is appropriate
24 where the trademark (or, in the case of a celebrity, likeness) appears in the body
25 of the work. *E.S.S.*, 547 F.3d at 1099 (“Although this test traditionally applies to
26 uses of a trademark in the title of an artistic work, there is no principled reason
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28 ³*Rogers v. Grimaldi*, 875 F.2d 994 (2nd Cir. 1989).

1 why it ought not also apply to the use of a trademark in the body of the work.”)

2 Here, the *Madden NFL* series of sports-based games is creative in different
3 ways than some of the other video games that courts have held to be artistic
4 speech. For example, in *E.S.S.*, the game contained creative elements such as a
5 story line and satires of real cities. However, that difference is not dispositive.
6 Video games do not have to be stories to qualify as expressive works. See
7 *Romantics v. Activision Publ’g, Inc.*, 574 F. Supp. 2d 758, 765-66 (E.D. Mich.
8 2008).

9 The *Madden* games contain numerous creative elements. Although the
10 games seek to realistically replicate NFL football, they use creative means to
11 achieve that goal. The games contain virtual stadiums, athletes, coaches, fans,
12 sound effects, music, and commentary, all of which are created or compiled by
13 the games’ designers. By manipulating virtual athletes and franchises as they
14 wish, video game players interact with the designers’ creative interpretation of
15 real-world NFL game play. The football season can itself become a storyline in
16 *Madden NFL*, as game players navigate their chosen athletes and franchises
17 towards victory.

18 That the designers used a realistic sports theme to express their creativity,
19 as opposed to urban adventure (*E.S.S.*) or music (*Romantics*), does not change the
20 fact that the *Madden NFL* games manifest their designers’ creative vision. The
21 *Madden NFL* video games are expressive works, akin to an expressive painting
22 that depicts celebrity athletes of past and present in a realistic sporting
23 environment. See *ETW Corp. v. Jireh Publ’g*, 332 F.3d 915 (6th Cir. 2003) (First
24 Amendment provided complete defense to Section 43(a) claim where expressive
25 painting depicted Tiger Woods surrounded by golf legends at Augusta).

26 As expressive works, the *Madden NFL* games’ use of Brown’s likeness is
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1 subject to the *Rogers* two-prong test.⁴ The first prong requires that the
2 defendant's use of plaintiff's trademark be relevant to the underlying work.
3 "[T]he level of relevance must merely be above zero." *E.S.S.*, 547 F.3d at 1100.

4 The *Madden NFL* games are about NFL football. Brown is a legendary
5 NFL player: the best ever, according to some journalists. AC ¶ 3. Use of a
6 legendary NFL player's likeness in a game about NFL football is clearly relevant.
7 Thus, even assuming that all material factual allegations in Brown's complaint are
8 true, and viewing them in the light most favorable to Brown, EA's use of
9 Brown's likeness in the *Madden NFL* games was not completely irrelevant to the
10 games' content.

11 The second prong of *Rogers* requires the Court to evaluate whether EA's
12 use of Brown's likeness explicitly misleads consumers as to the source or content
13 of the work. Mere use of the likeness, without more, is insufficient to make the
14 use explicitly misleading. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902
15 (9th Cir. 2002). The relevant inquiry is whether people playing *Madden NFL*
16 would be misled into thinking that Brown is somehow behind the game or
17 sponsors the product. *See E.S.S.*, 547 F.3d at 1100.

18 The *Madden NFL* character that Brown alleges bears his likeness is one of
19 thousands of virtual athletes in the games. Unlike most of the other characters,
20 this virtual athlete is anonymous: he is identified only by a jersey number and his
21 roster position as a running back. The character, and Brown's name, are not
22 depicted on the games' packaging or in their advertising. Strauser Decl. ¶ 9. In
23 his papers, Brown has not pointed to any *Madden NFL* promotional materials that
24 feature his name or likeness.⁵

25
26 ⁴ Again, the Court's assumption that EA used Brown's likeness is *arguendo*.

27 ⁵ Brown submitted exhibits that purport to show that EA used Brown's name
28 to promote *Madden NFL*. EA has objected to these exhibits. Without reaching the

1 Although a *Madden NFL* consumer could assume from the circumstances
2 that player number 37 represents Brown, it would require a leap of logic to
3 conclude that the anonymous, mis-numbered player's presence in the games
4 equates to Brown's endorsement of the games. Moreover, the virtual player's
5 mere presence in *Madden NFL* does not constitute an *explicit* attempt to convince
6 consumers the Brown endorsed the games.⁶

7 Assuming that all material factual allegations in the Amended Complaint
8 are true, and viewing them in the light most favorable to Brown, EA's use of
9 Brown's likeness could not constitute an explicit attempt to signify that Brown
10 endorsed the games. Thus, even if the games do use Brown's likeness, that use is
11 protected by the First Amendment. This outcome is consistent with the Lanham
12 Act's purposes. Section 43(a) provides a remedy against consumer confusion as
13 to celebrities' endorsements of a product, and allows celebrities to protect
14 property interests in their personas. *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1110
15 (9th Cir. 1992). Here, where there are no explicit representations of endorsement
16 to cause consumer confusion, and where important First Amendment interests are
17 implicated, there lies no remedy under Section 43(a) of the Lanham Act.

18 The court has not considered the merits of Brown's non-Lanham Act
19 claims. Because the Lanham Act claim does not survive the dismissal motion, the
20 Court declines to exercise supplemental jurisdiction over Brown's remaining state
21 and common law claims. *See Herman Family Revocable Trust v. Teddy Bear* ,
22 254 F.3d 802, 805 (9th Cir. 2001) (explaining that the supplemental jurisdiction
23 statute, 28 U.S.C. § 1367(a), "makes clear that supplemental jurisdiction may

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25 merit of these objections the Court finds that, even if admissible and interpreted in the
26 light most favorable to Brown, the exhibits simply do not stand for the proposition
27 that EA used Brown's name or likeness to promote *Madden NFL*.

28 ⁶Mere inclusion of a celebrity's likeness in the work is insufficient to satisfy the
second prong of *Rogers*. *E.S.S.*, 547 F.3d at 1100.

1 only be invoked when the district court has a hook of original jurisdiction on
2 which to hang it”).

3 **IV. CONCLUSION**

4 For the reasons set forth above, Defendant’s Motion to Dismiss (docket no.
5 28) is GRANTED WITH PREJUDICE as to the Lanham Act claim in Plaintiff’s
6 First Amended Complaint (docket no. 27). Additionally, the Court declines to
7 exercise supplemental jurisdiction over Plaintiff’s remaining state and common
8 law claims and DISMISSES THOSE CLAIMS WITHOUT PREJUDICE to the
9 Plaintiff’s right to pursue those claims in another venue. Finally, Defendant’s
10 Motion to Strike (docket no. 29) is DENIED AS MOOT.

11 **IT IS SO ORDERED.**

12 Dated: September 23, 2009.



15 FLORENCE-MARIE COOPER, JUDGE
16 UNITED STATES DISTRICT COURT
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