

Docket No. 252
USDC, S.D. of California
Case No. 14-cv-01865-AJB-JMA

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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

SAN DIEGO COMIC CONVENTION, a
California non-profit corporation,
Plaintiff,

v.

DAN FARR PRODUCTIONS, a Utah
limited liability company; DANIEL
FARR, an individual; and BRYAN
BRANDENBURG, an individual,
Defendants.

Case No.: 14-cv-1865 AJB (JMA)

ORDER:

- (1) DENYING DEFENDANTS’
MOTION FOR SUMMARY
JUDGMENT;**
- (2) GRANTING IN PART AND
DENYING IN PART PLAINTIFF’S
MOTION FOR SUMMARY
JUDGMENT;**
- (3) DENYING DEFENDANTS’
MOTION TO EXCLUDE;**
- (4) GRANTING PLAINTIFF’S
MOTION TO EXCLUDE; AND**
- (5) GRANTING DEFENDANTS AND
PLAINTIFF’S REQUESTS FOR
JUDICIAL NOTICE**

(Doc. Nos. 91, 95, 97, 106, 216, 218.)

1 Pending before the Court are both Plaintiff San Diego Comic Convention
2 (“Plaintiff”) and Defendants Dan Farr Productions, Daniel Farr, and Bryan Brandenburg’s
3 (collectively referred to as “Defendants”) motions for summary judgment, motions to
4 exclude expert testimony, and requests for judicial notice. Pursuant to Civil Local Rule
5 7.1.d.1, the Court finds the matters suitable for decision on the papers and without oral
6 argument. As explained more fully below, the Court **DENIES** Defendants’ motion to
7 exclude, (Doc. No. 106), **GRANTS** Plaintiff’s motions to exclude, (Doc. No. 91),
8 **GRANTS** Defendants and Plaintiff’s requests for judicial notice, (Doc. Nos. 95-1, 216-1),
9 **DENIES** Defendants’ motions for summary judgment, (Doc. Nos. 216, 218), and
10 **GRANTS IN PART AND DENIES IN PART** Plaintiff’s motion for summary judgment,
11 (Doc. Nos. 95, 97).

12 **BACKGROUND**

13 The contours of this case revolve around Defendants’ use of the unhyphenated form
14 of Plaintiff’s trademark “Comic-Con.” (Doc. No. 97 at 10.)¹ Since 1970, Plaintiff, a non-
15 profit organization, has held the Comic-Con Convention in San Diego, California
16 celebrating comic art, books, and other aspects of the popular arts. (*Id.* at 9.) Since this
17 initial event, the San Diego Comic-Con event has grown in popularity with attendance
18 exceeding over 135,000 attendees in July of 2016. (*Id.*) However, though Plaintiff may be
19 the largest gathering of comic fans, it was not the first. (Doc. No. 95-10 at 41.)
20 Nevertheless, Plaintiff contends that it is due to the extraordinary amount of time, effort,
21 and expense invested by it that the San Diego Comic Convention and its brand have
22 become the premier comic book and popular arts convention in the world. (Doc. No. 97 at
23 9; Doc. No. 234-2 at 12–13.)

24 To protect its brand, Plaintiff applied and now holds four trademark registrations
25 with the United States Patent and Trademark Office (“USPTO”): (1) COMIC-CON; (2)
26

27 ¹ All pinpoint cites are in reference to the CM/ECF page number and not the number on
28 the document.

1 COMIC CON INTERNATIONAL; (3) for the word-plus-design mark² that Plaintiff uses
 2 to advertise its products; and (4) for the word mark ANAHEIM COMIC-CON.³ (Doc. No.
 3 1 ¶ 13; Doc. No. 244 at 11.)

4 Defendants Bryan Brandenburg and Daniel Farr are co-founders of Defendant Dan
 5 Farr Productions (“DFP”), a limited liability company. (Doc. No. 234-2 at 7; Doc. No. 244
 6 at 12.) In September of 2013, through DFP, Defendants held the inaugural Salt Lake Comic
 7 Con (“SLCC”). (Herrera Decl. Ex. 5 (“Farr Depo.”) 11:4–9, Doc. No. 95-7.) SLCC is a
 8 three-day fan event featuring the best in movies, television shows, gaming, sci-fi, fantasy,
 9 and comic books. (Doc. No. 244 at 12.) Since 2013, SLCC has held their convention every
 10 year. (Farr Depo. at 11:7–9.) Additionally, beginning in 2014, SLCC also holds the Salt
 11 Lake Comic Con FanXperience in March or April of every year. (*Id.* at 11:10–15; Doc.
 12 No. 97 at 11.) As evidenced below, the logo Defendants employ to advertise their event
 13 uses the unhyphenated form of Plaintiff’s trademark “Comic-Con,” with a geographic
 14 identifier preceding it.



19 (Doc. No. 97 at 11.)

20 In sum, Plaintiff asserts that beginning in early 2013, Defendants made the decision
 21 to capitalize on the goodwill of Plaintiff’s brand by advertising and holding SLCC. (Doc.
 22 No. 1 ¶ 16.) As a result, Defendants’ use of Plaintiff’s marks was intended to suggest,



27 ²
 28 ³ The marks are registered with the USPTO as U.S. Service Mark Registration Numbers
 3,221,808; 3,219,568; 2,218,236; and 4,425,806. (Doc. No. 97 at 10.)

1 mislead, and confuse consumers into believing that SLCC was associated with, authorized
2 by, or endorsed by Plaintiff. (*Id.* ¶ 18.) Further, Plaintiff asserts that Defendants’
3 advertising methods provide additional support for their claims, including Defendants’
4 campaign that stated “Comic-Con is coming to Utah.” (*Id.* ¶ 27.)

5 On August 7, 2014, Plaintiff filed its complaint against Defendants asserting causes
6 of action for (1) federal trademark infringement; and (2) false designation of origin. (Doc.
7 No. 1.) On September 22, 2014, Defendants filed their answer to the complaint with a
8 counterclaim against Plaintiff. (Doc. No. 16.) On June 23, 2017, the last day for dispositive
9 motions to be filed, both parties filed the present matters, their motions for summary
10 judgment, motions to exclude, and requests for judicial notice.⁴ (Doc. Nos. 91, 95, 97, 106,
11 216, 218.)

12 LEGAL STANDARD

13 Summary judgment is appropriate under Federal Rule of Civil Procedure 56 if the
14 moving party demonstrates the absence of a genuine issue of material fact and entitlement
15 to judgment as a matter of law. *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986). A fact
16 is material when, under the governing substantive law, it could affect the outcome of the
17 case. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A dispute is genuine if a
18 reasonable jury could return a verdict for the nonmoving party. *Id.*

19 A party seeking summary judgment bears the initial burden of establishing the
20 absence of a genuine issue of material fact. *Celotex Corp.*, 477 U.S. at 323. The moving
21 party can satisfy this burden in two ways: (1) by presenting evidence that negates an
22 essential element of the nonmoving party’s case; or (2) by demonstrating the nonmoving
23 party failed to establish an essential element of the nonmoving party’s case on which the
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25
26 ⁴ The Court notes that Defendants filed two separate motions for summary judgment that
27 totaled forty-four pages in length in violation of Civil Local Rule 7.1.h. However, the Court
28 permitted this violation and granted Plaintiff’s request to file an opposition that also
exceeded the page lengths designated by the local rules so that they could properly respond.
(Doc. No. 119 at 3.)

1 nonmoving party bears the burden of proving at trial. *Id.* at 322–23. “Disputes over
2 irrelevant or unnecessary facts will not preclude a grant of summary judgment.” *T.W. Elec.*
3 *Serv., Inc. v. Pac. Elec. Contractors Ass’n*, 809 F.2d 626, 630 (9th Cir. 1987).

4 Once the moving party establishes the absence of a genuine issue of material fact,
5 the burden shifts to the nonmoving party to set forth facts showing a genuine issue of a
6 disputed fact remains. *Celotex Corp.*, 477 U.S. at 330. When ruling on a summary
7 judgment motion, the court must view all inferences drawn from the underlying facts in
8 the light most favorable to the nonmoving party. *Matsushita Elec. Indus. Co. v. Zenith*
9 *Radio Corp.*, 475 U.S. 574, 587 (1986).

10 DISCUSSION

11 **A. Defendants and Plaintiff’s Requests for Judicial Notice**

12 Defendants request the Court judicially notice dictionary definitions and USPTO
13 records. (Doc. No. 216-1 at 2–3.) Similarly, Plaintiff requests the Court take judicial notice
14 of its four USPTO trademark registrations. (Doc. No. 95-1.)

15 Under Federal Rule of Evidence 201, a court may judicially notice a fact that “is not
16 subject to reasonable dispute” as it is “generally known within the trial court’s territorial
17 jurisdiction” or because it can be “accurately and readily determined from sources whose
18 accuracy cannot be reasonably questioned.” Fed. R. Evid. 201(b)(1)–(2).

19 Here, the Court finds judicial notice of the requested documents appropriate. First,
20 it is well-established that a court can consider dictionary definitions when determining the
21 “plain, unambiguous, and common meanings of terms.” *United States v. Wealth and Tax*
22 *Advisory Servs., Inc.*, 526 F.3d 528, 530 (9th Cir. 2008); *see also Best Buy Stores, L.P. v.*
23 *Manteca Lifestyle Ctr., LLC*, 859 F. Supp. 2d 1138, 1145 (E.D. Cal. 2012) (same). Thus,
24 the definitions produced by Defendants are suitable for judicial notice.

25 As to the USPTO records, undisputed matters of public record are generally
26 judicially noticeable. *See Lee v. City of Los Angeles*, 250 F.3d 668, 689–90 (9th Cir. 2001).
27 Thus, for the purpose of demonstrating that the filings, applications, and actions occurred
28 on certain dates and that Plaintiff’s four marks are indeed registered with the USPTO, all

1 of which are undisputed facts, the Court finds the USPTO records listed judicially
2 noticeable. However, to the extent that Defendants seek to claim that their trademark
3 applications for Salt Lake Comic Con illustrate that Plaintiff's marks are generic, these
4 contested questions cannot be answered solely in reference to the information within these
5 judicially noticeable documents. *See Caveman Foods, LLC v. Lester*, No. C 12-1587 RS,
6 2013 WL 12172626, at *2 (N.D. Cal. Feb. 14, 2013) ("The strength of the [] mark is the
7 central disputed question of this litigation and an inappropriate subject for judicial
8 notice.").

9 Accordingly, for the purposes described above, the Court **GRANTS** Defendants and
10 Plaintiff's requests for judicial notice. *See Pollution Denim & Co. v. Pollution Clothing*
11 *Co.*, 547 F. Supp. 2d 1132, 1135 n.11 (C.D. Cal. 2007) (taking judicial notice of the facts
12 from online records maintained by the USPTO).

13 **B. Motions to Exclude**

14 Both Plaintiff and Defendants filed motions to exclude specific experts. (Doc. Nos.
15 91, 106.) Plaintiff seeks to exclude the reports and testimony of Jeffrey P. Kaplan and
16 Clarke B. Nelson, (Doc. No. 91), and Defendants seek to exclude the expert report and
17 survey of Matthew G. Ezell, (Doc. No. 106-1).

18 Federal Rule of Evidence 702 governs the admissibility of expert testimony.
19 Pursuant to Rule 702:

20 A witness who is qualified as an expert by knowledge, skill,
21 experience, training, or education may testify in the form of an
22 opinion or otherwise if: (a) the expert's scientific, technical, or
23 other specialized knowledge will help the trier of fact to
24 understand the evidence or to determine a fact in issue; (b) the
25 testimony is based on sufficient facts or data; (c) the testimony is
26 the product of reliable principles and methods; and (d) the expert
has reliably applied the principles and methods to the facts of the
case.

27 Fed. R. Evid. 702. "The party offering the expert bears the burden of establishing that Rule
28 702 is satisfied." *Sundance Image Tech., Inc. v. Cone Editions Press, Ltd.*, No. 02 CV 2258

1 JM (AJB), 2007 WL 935703, at *4 (S.D. Cal. Mar. 7, 2007).

2 Moreover, prior to admitting expert testimony, the trial court must make a
3 “preliminary assessment of whether the reasoning or methodology underlying the
4 testimony is scientifically valid and of whether that reasoning or methodology properly can
5 be applied to the facts in issue.” *Daubert v. Merrell Dow Pharm., Inc.*, 509 U.S. 579, 592–
6 93 (1993). Thus, the trial court acts as the “gatekeeper to exclude speculative or irrelevant
7 expert opinion.” *Sargon Enter., Inc. v. Univ. of S. Cal.*, 55 Cal. 4th 747, 770 (2012). In sum
8 a Rule 702 analysis is a two-step assessment that requires consideration of whether (1) the
9 reasoning or methodology underlying the testimony is scientifically valid (the reliability
10 prong); and (2) whether the reasoning or methodology properly can be applied to the facts
11 in issue (the relevancy prong). *Daubert*, 509 U.S. at 592–93.

12 i. Defendants’ Motion to Exclude Plaintiff’s Expert Matthew G. Ezell

13 Matthew Ezell was retained by Plaintiff to conduct a “Teflon” survey⁵ to address the
14 issue of the primary significance of Comic-Con to the relevant public. (Doc. No. 106-1 at
15 5–6; Doc. No. 169 at 2.) Mr. Ezell’s Teflon survey revealed that 82% of the participants
16 understood Comic-Con as a brand name, and not as a common generic name. (Doc. No.
17 106-3 at 11; Doc. No. 169 at 2.)

18 Defendants seek to exclude Mr. Ezell’s testimony and survey as irrelevant. (Doc.
19 No. 106-1 at 5–8.) More specifically, Defendants argue that surveys measuring consumer
20 perception only matter in genericide cases. (*Id.* at 6.) Thus, as Defendants contend that this
21 is not a genericide case, but is instead a case where the trademark was allegedly generic
22 prior to Plaintiff’s first use, i.e., genericness *ab initio*, consumer surveys are not necessary.⁶
23 (*Id.* at 7–8.) To support this argument, Defendants point the Court to *Horizon Mills Corp.*
24

25 ⁵ A Teflon survey asks respondents to classify a series of words as either brand names or
26 common names after a brief lesson explaining the difference between the two. (Doc. No.
27 106-1 at 5–6.)

28 ⁶ As discussed *infra* p. 16–17, the Court declines to analyze Defendants’ generic *ab initio*
arguments as they are unsubstantiated and unsupported by dispositive case law.

1 v. *QVC, Inc.*, 161 F. Supp. 2d 208 (S.D.N.Y. 2001), *Schwan's IP, LLC v. Kraft Pizza Co.*,
2 460 F.3d 971 (8th Cir. 2006), *Hunt Masters, Inc. v. Landry's Seafood Rest., Inc.*, 240 F.3d
3 251 (4th Cir. 2001), and *Miller Brewing Co. v. Jos. Schlitz Brewing Co.*, 605 F.2d 990 (7th
4 Cir. 1979). (*Id.* at 7.)

5 For clarity, the Court first expounds that a mark is the victim of genericide when the
6 “majority of the relevant public appropriates a trademark term as the name of a product (or
7 service)” *Freecycle Network, Inc. v. Oey*, 505 F.3d 898, 905 (9th Cir. 2007) (citation
8 omitted). For example, formerly trademarked terms such as “aspirin,” “escalator,” or
9 “cellophane” only identified the brand or producer during the period of its initial use,
10 however after the passage of time, they were appropriated by the public and soon became
11 the generic name of the product. *Id.* On the other hand, non-genericness or generic *ab initio*
12 is when a mark is generic before a producer began using it as a trademark to advertise their
13 products or services. *See Schwan's IP, LLC v. Kraft Pizza Co.*, 460 F.3d 971, 974 (8th Cir.
14 2006).

15 In its opposition, Plaintiff argues that it provided the consumer survey in direct
16 response to Defendants’ own admissions that this is indeed a genericide case. (Doc. No.
17 169 at 2.) In fact, Defendants pled as an affirmative defense that Plaintiff’s claims are
18 barred because the trademarks at issue are generic. (*Id.*; Doc. No. 16 at 8.) Thus, as
19 Defendants’ own pleadings as well as the majority of the evidence proffered relate to a
20 defense of genericide, Plaintiff’s assert that Mr. Ezell’s survey is relevant. (Doc. No. 169
21 at 4–6.) After a careful review of the moving papers, the applicable law, and Mr. Ezell’s
22 opinion and survey, the Court agrees with Plaintiff.

23 The Ninth Circuit focuses on the who-are-you/what-are-you test when determining
24 genericness (“the primary significance test”). *Official Airline Guides, Inc. v. Goss*, 6 F.3d
25 1385, 1391 (9th Cir. 1993) (quoting 1 J. McCarthy, *Trademarks and Unfair Competition* §
26 12.01 (3d ed. 1992)). Thus, a non-generic mark answers the buyer’s questions “‘Who are
27 you? Where do you come from?’ ‘Who vouches for you?’ But the [generic] name of a
28 product answers the question ‘What are you?’” *Id.*

1 Most importantly, the Court notes that case law makes clear that courts in this district
2 rely heavily upon consumer surveys in determining genericness. *See Elliott v. Google*, 860
3 F.3d 1151, 1160 (9th Cir. 2017) (finding that the court appropriately considered consumer
4 surveys in determining the genericness of the mark “Google”); *see also Premier Nutrition,*
5 *Inc. v. Organic Food Bar, Inc.*, 327 F. App’x 723, 724 (9th Cir. 2009) (using a survey
6 provided by defendant as well as other direct and circumstantial evidence to conclude that
7 “Organic Food Bar” is a generic term); *Stuhlberg Int’l. Sales Co., Inc. v. John D. Brush*
8 *and Co., Inc.*, 240 F.3d 832, 840 (9th Cir. 2001) (“To counter this evidence, [defendant]
9 submitted excerpts from a consumer survey purportedly showing forty-four percent
10 consumer awareness to the term ‘Fire-Safe.’”). Specifically, the Teflon survey design has
11 been “accepted and given weight by the courts and is frequently cited.” *Premier Nutrition,*
12 *Inc. v. Organic Food Bar, Inc.*, No. SACV 06-0827 AG (RNBx), 2008 WL 1913163, at *9
13 (C.D. Cal. Mar. 27, 2008) (“Premier Nutrition II”).

14 Here, it is clear that Plaintiff’s consumer survey is pertinent in deciphering how
15 consumers understand the trademark “Comic-Con.” The Court notes that despite
16 Defendants’ attempt to focus the Court’s attention solely on their generic *ab initio*
17 contentions, the Court cannot ignore the fact that (1) the majority of the evidence proffered
18 by Defendants in support of their motion for summary judgment revolves around proving
19 that Plaintiff’s mark is presently generic, (Doc. No. 244 at 9, 13, 15); (2) that Defendants’
20 own expert was hired to offer the opinion that Plaintiff’s trademark is currently generic,
21 (Doc. No. 91-2 at 3); (3) that Defendants’ counterclaim pleads that one of its defenses is
22 genericide, (Doc. No. 16 at 8); and (4) that Defendants clearly state in their own moving
23 papers and briefs that they are arguing a theory of defense based on genericide, (Doc. No.
24 200 at 2). Consequently, as Defendants argue genericide, and the Ninth Circuit primarily
25 employs the primary significance test to determine the genericness of a mark, it is readily
26 apparent that Mr. Ezell’s survey is highly relevant to the present matter. *See In re Silicone*
27 *Gel Breast Implants Prods. Liab. Litig.*, 318 F. Supp. 2d 879, 893–94 (C.D. Cal. 2004)
28 (holding that a court under Rule 702 must make an inquiry into whether an expert’s opinion

1 would be useful or helpful to the trier of fact).

2 The Court recognizes that in an effort to combat Plaintiff's opposition, Defendants
3 in their reply brief fleetingly argue that even in terms of genericide, Mr. Ezell's report
4 should be excluded as it tries to measure the primary significance of Comic-Con now
5 instead of when Plaintiff started using it in 1970 or when the lawsuit was initiated nearly
6 three years ago. (Doc. No. 200 at 6.) However, not only do Defendants fail to provide case
7 law to support this argument, but its reasoning is obtuse.

8 A Teflon survey, like the one used here, asks consumers to categorize different
9 words as either brand names or common names. This is then used to prove that "the primary
10 significance of the term in the minds of the consuming public is not the product but the
11 producer." *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 118 (1938). Thus, in contrast to
12 Defendants' assertions, Teflon surveys analyze the mindset of the consumer at the time
13 they take the survey. *See Elliott*, 860 F.3d at 1160 n.7 (using a Teflon survey to ask
14 consumers whether they believed "Google" was at that time a brand name); *see also Intel*
15 *Corp. v. Adv. Micro Devices, Inc.*, 756 F. Supp. 1292, 1297 (N.D. Cal. 1991) (holding that
16 the Teflon Survey was properly conducted as it showed that 72% of the public regard at
17 that point in time found that the phrase was generic). As Defendants offer no case law to
18 refute this conclusion and only devote a single sentence to arguing this point, this argument
19 is meritless.

20 Accordingly, it is unquestionable that Mr. Ezell's testimony is extremely pertinent
21 to helping the trier of fact determine whether Plaintiff's trademark is allegedly generic.
22 Thus, the Court **DENIES** Defendants' motion to exclude Mr. Ezell. *Daubert v. Merrell*
23 *Dow Pharm., Inc.*, 43 F.3d 1311, 1315 (9th Cir. 1995) (Daubert II) (holding that a court
24 must ensure that "the proposed expert testimony is 'relevant to the task at hand'")
25 (quotation omitted).

26 Finally, though the Court need not reach this issue, the Court notes that it finds the
27 case law Defendants employ to argue the irrelevance of the Teflon survey under a non-
28 genericide theory unpersuasive. First, the Court notes that in *Horizon Mills*, the court never

1 definitively concluded that consumer surveys were irrelevant to genericide cases. 161 F.
2 Supp. 2d at 220. Instead, the court only highlighted that the defendants in that case argued
3 this point. *Id.* at 220 n.16. Moreover, Defendants use of *Schwan's IP* is baseless. The court
4 in *Schwan's* found that as "Brick Oven" was commonly used before either party began
5 labeling their frozen pizzas, a survey measuring consumer perceptions would be
6 inconsequential. 460 F.3d at 976. This is not the case here. Defendants have not produced
7 documents that demonstrate that "Comic-Con" was frequently or ordinarily used pre 1970s
8 to refer to the specific type of event at issue in the present matter, nor that the majority of
9 consumers used the phrase to generally refer to comic book conventions.

10 Most importantly, the fundamental issue with all of Defendants' cases is that they
11 are holdings from other circuits and are thus not dispositive. Accordingly, Defendants' case
12 law as a whole fails to persuade the Court of the irrelevance of the Teflon survey in a non-
13 genericide case.

14 ii. Plaintiff's Motion to Exclude the Reports of Jeffrey P. Kaplan and Clarke B.
15 Nelson

16 *a. Jeffrey Kaplan*

17 Plaintiff attacks Mr. Kaplan's opinion as irrelevant. (Doc. No. 234.) Specifically,
18 Plaintiff contends that he fails to address the primary significance test, that his reports are
19 based on insufficient data, and that his opinion fails to assist the trier of fact as he offers
20 nothing beyond common knowledge. (*See generally id.*)

21 Defendants offer the expert testimony of Jeffrey Kaplan to provide linguistic
22 evidence to support the opinion that the phrase "comic con" is generic. (Doc. No. 91-2 at
23 3.) In sum, Mr. Kaplan's report is broken down into several sections: (1) an analysis on the
24 naturally occurring discourses of "comic con" on websites, news stories, magazines, and
25 blogs, (*Id.* at 5); (2) arguing that as the phrase comic con can be used in a plural form this
26 highlights that it is a common noun, (*Id.* at 8); (3) asserting that as comic con is not
27 capitalized in all instances, this provides further proof that it is a common noun, (*Id.* at 19
28 –20); and (4) the ubiquitous use of "comic con" by more than 102 comic cons as the name

1 of independent comic cons demonstrates genericness, (*Id.* at 23). Based upon all of his
2 research, Mr. Kaplan then concludes that “comic con” has the characteristics of a common
3 noun and is thus generic. (*Id.* at 25.)

4 The Court first briefly highlights that from the face of Mr. Kaplan’s report, it does
5 not appear that his testimony is relevant to the crux of Defendants’ arguments. Defendants’
6 entire motion for summary judgment and its motion to exclude Plaintiff’s expert argue that
7 “Comic-Con” was generic before Plaintiff’s first use in 1970. (Doc. No. 106-1 at 5; Doc.
8 No. 244 at 18 (emphasis added).) In contrast, Mr. Kaplan was employed to offer linguistic
9 evidence supporting his opinion that the expression “‘comic con’ was generic at the time
10 the above-captioned law suit was filed, and is currently generic” (Doc. No. 91-2 at 3
11 (emphasis added).) Thus, it is unclear how Mr. Kaplan’s report would assist the trier of fact
12 in determining that the mark was generic before 1970. *See Kennedy v. Collagen Corp.*, 161
13 F.3d 1226, 1230 (9th Cir. 1998) (finding that relevancy requires opinions that would assist
14 the trier of fact in reaching a conclusion necessary to the case).

15 Next, and most importantly, the Court finds that Defendants have failed to establish
16 that Mr. Kaplan’s opinions are sufficiently reliable so as to be admissible. *See Kumho Tire*
17 *Co. Ltd. v. Carmichael*, 526 U.S. 137, 137 (1999) (“Rule 702 imposes a special obligation
18 upon a trial judge to ensure that scientific testimony is not only relevant, but reliable.”).
19 Here, within a footnote, Mr. Kaplan states that some of the materials he bases his opinions
20 on were provided to him by counsel for Defendants. (Doc. No. 91-2 at 5.) However, this is
21 a gross misrepresentation. Based on the page spans provided by Mr. Kaplan, of the 2,300
22 documents he reviewed, only around 400 pages were materials he found through his own
23 independent research whilst over 1,800 pages of documents were given to him by counsel
24 for Defendants. (*Id.*)

25 The Court is unable to ignore the fact that the foundation of Mr. Kaplan’s
26 conclusions was generated from a narrow field of documents, most of which were provided
27 to him by Defendants. Thus, his opinions are not based on “sufficient facts or data,” nor do
28 his opinions accurately depict how consumers presently understand the phrase “Comic-

1 Con.” For example, within his report, Mr. Kaplan states that “[i]n the materials reviewed,
2 there is only one occurrence of ‘comic con’ capitalized . . . with a lower case initial ‘c’ on
3 ‘comic’ and an upper case initial ‘c’ on ‘Con’” (*Id.* at 20.) However, the Court is
4 unpersuaded that this conclusion could be reliably drawn from the constricted and
5 somewhat biased world view that Mr. Kaplan basis his opinion on. Fed. R. Evid. 702(b);
6 *Kumho Tire Co.*, 526 U.S. at 142 (holding that a district court has broad latitude in deciding
7 how to measure reliability and in making the ultimate reliability determination); *see also*
8 *In re Canvas Specialty, Inc.*, 261 B.R. 12, 20 (C.D. Cal. 2001) (“[The expert must obtain
9 the right kind of data to support the conclusions drawn.”).

10 Further evidence of unreliability is the fact that Mr. Kaplan’s report fails to explain
11 the reasoning or methodology behind his opinions. In *Daubert*, the Supreme Court outlined
12 factors relevant to the reliability prong, including (1) whether the theory can be and has
13 been tested; (2) whether it has been subjected to peer review; (3) the known or potential
14 rate of error; and (4) whether the theory or methodology employed is generally accepted
15 in the relevant scientific community. 509 U.S. at 593–94. Here, Mr. Kaplan’s opinion lacks
16 an explanation as to what methodology he uses, why he chose to employ the factors he did,
17 or whether the linguistic tests and principles he employed have been used by others to
18 determine genericness. Thus, the Court has no way to judge Mr. Kaplan’s reasoning or
19 determine the dependability of his opinions. *See Diviero v. Uniroyal Goodrich Tire Co.*,
20 114 F.3d 851, 853 (9th Cir. 1997) (holding that expert testimony is “unreliable and
21 inadmissible” when an expert fails to “satisfactorily [] explain the reasoning behind his
22 opinions,” rendering his opinions “unsubstantiated and subjective”).⁷

23 Accordingly, the Court **GRANTS** Plaintiff’s motion to exclude the expert report of
24 Mr. Kaplan.

25 ///

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27
28 ⁷ For these same reasons, the Court also finds Mr. Kaplan’s supplemental report similarly
unreliable and thus inadmissible. (*See generally* Doc. No. 91-3.)

1 **b. Clarke Nelson**

2 Defendants retained [REDACTED] to rebut the damages opinions proffered by
3 Plaintiff’s expert [REDACTED]. (Doc. No. 234 at 16–23.) Plaintiff moves to
4 exclude Mr. Nelson arguing that his testimony is based on insufficient facts, an unreliable
5 methodology, and is not tied to the facts of the case. (*Id.* at 18.)

6 The Lanham Act provides that an owner of a registered mark may recover from an
7 infringer (1) profits; (2) any damages sustained by the plaintiff; and (3) costs of the action.
8 *Southland Sod Farms v. Stover Seed Co.*, 108 F.3d 1134, 1145 (9th Cir. 1997). Specifically,
9 a plaintiff need only prove the defendant’s sales only, “leaving to the defendant to prove
10 all elements of cost or deduction claimed.” *Maier Brewing Co. v. Fleischmann Distilling*
11 *Corp.*, 390 F.2d 117, 123 (9th Cir. 1968) (internal quotation marks omitted).

12 Plaintiff’s expert Dr. Kennedy argues that [REDACTED]

13 [REDACTED]
14 [REDACTED]
15 [REDACTED]
16 [REDACTED]
17 [REDACTED]

18 [REDACTED] To refute Dr. Kennedy’s
19 testimony, based upon 15 U.S.C. § 1117(a), Defendants employed Clarke Nelson to prove
20 deductible expenses [REDACTED] (See generally Doc. No. 234-
21 2.)

22 After a review of Mr. Nelson’s report and submissions, the Court finds that
23 Defendants have failed to establish that Mr. Nelson is a reliable expert. [REDACTED]

24 [REDACTED]
25 [REDACTED]
26 [REDACTED]
27 [REDACTED]
28 [REDACTED]

1 [REDACTED]
2 [REDACTED]
3 [REDACTED] In total, [REDACTED]
4 considerations, Mr. Nelson summarily states that in his opinion that [REDACTED]
5 [REDACTED] (Id. at 58.)

6 This leap from Mr. Nelson’s analysis of a variety of qualitative considerations to a
7 specific percentage is fundamentally lacking in any explanation as to what methodology,
8 principles, or calculation he used to come to this number and is thus inherently unreliable.
9 See *Kennedy*, 161 F.3d at 1230 (holding that a district court may properly exclude expert
10 testimony if the court concludes too great an “analytical gap exists between the existing
11 data and the expert’s conclusion”). For instance, the Court does not know why Mr. Nelson
12 chose to focus on the considerations he did, why the factors he chose were important, nor
13 how much each of these factors were weighted in coming to his conclusion. Without this
14 information, the Court is unable to determine how Mr. Nelson formed his opinions nor has
15 Mr. Nelson demonstrated that he has a proven methodology that he can give to the jury so
16 that they can “make a rational decision.” See *Sargon Enter.*, 55 Cal. 4th at 763.

17 Compare the present matter with *Ralston v. Mortg. Investors Grp., Inc.*, No. 08-536-
18 JF (PSG), 2011 WL 6002640, at *9 (N.D. Cal. Nov. 30, 2011). In *Ralston*, the defendant
19 moved to exclude testimony of plaintiff’s damages expert on the grounds that his report
20 offered “nothing more than a simplistic spreadsheet amortization table that lacks
21 justification for its assumptions, and furthermore offers only conclusory assurances that
22 missing functionality can be added with ease.” *Id.* However, after a review of the
23 methodology, the court disagreed with defendants and found that the two tables provided
24 a structure or framework that could be used to analyze the actual loan data eventually
25 provided to plaintiffs. *Id.*

26 Unlike the expert in *Ralston*, Mr. Nelson does not provide a damages model that
27 lacks certain variables or calculations. Rather, Mr. Nelson provides no damages model at
28 all. Thus, though the methodologies Mr. Nelson describes “may very well be capable of

1 calculating damages in this action, [Mr. Nelson] has made no showing that this is the case.”
2 *In re ConAgra Foods, Inc.*, 302 F.R.D. 537, 552 (C.D. Cal. 2014). Thus, Plaintiff’s motion
3 to exclude the expert testimony of Clarke Nelson is **GRANTED**. *See DSU Med. Corp. v.*
4 *JMS Co., Ltd.*, 296 F. Supp. 2d 1140, 1148 (N.D. Cal 2003) (holding that in the damages
5 context, an expert’s methodology is reliable if the grounds used by that expert to calculate
6 damages were legally acceptable).

7 **C. Plaintiff and Defendants’ Motions for Summary Judgment**

8 As Plaintiff and Defendants’ requests for summary judgment both involve
9 Defendants’ counterclaim defenses of genericness and abandonment, the Court will
10 analyze these motions together.

11 First, the Court turns to Plaintiff’s motion for summary judgment on Defendants’
12 counterclaim of genericness. (Doc. Nos. 95, 97.) Plaintiff’s main assertion is that
13 Defendants cannot meet their burden to establish genericness as a matter of law, especially
14 in light of the fact that Plaintiff’s marks are presumed valid and non-generic. (Doc. No. 97
15 at 15.) In opposition, Defendants assert that (1) Plaintiff’s genericide arguments and
16 evidence have no bearing on genericness *ab initio*; (2) Plaintiff’s attempt to discredit
17 Defendants’ evidence of genericide fails; and (3) Plaintiff’s own evidence relating to
18 genericide is insufficient to warrant summary judgment. (Doc. No. 246 at 11–18.)

19 i. Generic *Ab Initio*

20 As a threshold matter, the Court highlights that it takes issue with Defendants’
21 genericness *ab initio* arguments. Currently, Defendants’ motion for summary judgment,
22 motion to exclude, and the evidence proffered fluctuates between two different defense
23 theories: genericness *ab initio* and genericide. (*Compare* Doc. No. 244 at 15, 18 *with id.* at
24 23–25.)

25 Unfortunately for Defendants, the Ninth Circuit has not recognized a genericness *ab*
26 *initio* theory of defense. Instead, the Ninth Circuit very clearly states that there are only
27 five categories of trademarks: (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; and
28 (5) fanciful. *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 408 F.3d 596, 602

1 (9th Cir. 2005). No case law from this circuit separates genericness into two different types
2 nor have Defendants provided the Court with Ninth Circuit precedent that adopts their
3 arguments. Accordingly, as there is no dispositive basis or Ninth Circuit jurisprudence to
4 accept an argument revolving around a generic *ab initio* defense, the Court **GRANTS**
5 Plaintiff's motion for summary judgment on this contention.

6 For Defendants' benefit, the Court highlights that even if it were to entertain a
7 generic *ab initio* argument, the evidence produced by Defendants would fail to satisfy their
8 burden. Here, to support the theory that Plaintiff's mark was generic prior to its first use in
9 1970, Defendants set forth evidence that suggests that "Comic-Con" was used regularly
10 pre-1970. For example, Defendants present a book titled "The 1964 New York Comicon:
11 The True Story Behind the World's First Comic Convention," (Doc. No. 246 at 13), as well
12 as articles about the "COMICON" that was held in 1969 at the Waverley Hotel in London,
13 (Doc. No. 222-48 at 5; Doc. No. 244 at 8), and articles on the 1964 "New York
14 COMICON," and 1966 New York "Benson" Con, (Doc. No. 222-29 at 5; Doc. No. 222-
15 43 at 2). Furthermore, Defendants also assert that semantic evidence including the Oxford
16 English Dictionary ("OED") demonstrate that the term Comic-Con is generic. (Doc. No.
17 244 at 19.)

18 As a whole, Defendants' foregoing evidence is insubstantial in carrying their burden.
19 First, the Court notes that the OED states that the definition of "con" is a "new entry" from
20 the OED's third edition from September of 2002. (Doc. No. 218-10 at 2.) Thus, it has no
21 relevance to establishing an understanding of the term Comic-Con pre-1970. Moreover,
22 courts have held that dictionary definitions are "weak evidence that [a plaintiff's] term [is]
23 generic." *Premier Nutrition*, 475 F. Supp. 2d at 1001–03. Furthermore, courts have
24 routinely rejected the breaking down of phrases into their individual and often generic
25 parts. *See Comm. for Idaho's High Desert, Inc. v. Yost*, 92 F.3d 814, 821 (9th Cir. 1996)
26 ("The district court was clearly correct in evaluating the genericness of the name as a
27 whole, rather than looking to its constituent parts individually . . . The relevant question
28 therefore is whether the entire name [] is generic."); *see also Cal. Cooler, Inc. v. Loretto*

1 *Winery, Ltd.*, 774 F.2d 1451, 1455 (9th Cir. 1985) (“[Plaintiff’s] mark is a composite term,
2 and its validity is not judged by an examination of its parts. Rather, the validity of a
3 trademark is to be determined by viewing the trademark as a whole.”).

4 Most importantly, to defeat Plaintiff’s motion for summary judgment, Defendants
5 must demonstrate that the primary significance behind the term “Comic-Con,” before
6 Plaintiff’s first use, was to refer to comic conventions in general, and not to Plaintiff’s
7 comic convention. *Krav Maga Ass’n of Am. v. Yanilov*, 464 F. Supp. 2d 981, 988–89 (C.D.
8 Cal. 2006); *see also KP Permanent Make-Up, Inc.*, 408 F.3d at 604 (holding that to
9 determine whether a term has become generic, a court looks to whether “consumers
10 understand the word to refer only to a particular producer’s goods or whether the consumer
11 understands the word to refer to the goods themselves”). Unfortunately, Defendants’
12 evidence fails to do so.

13 Based on the foregoing, even if the Court were to allow Defendants to argue a
14 genericness *ab initio* theory, their evidence would have failed to establish the absence of a
15 genuine issue of material fact as to whether Plaintiff’s trademark was generic *ab initio*.
16 Accordingly, their motion for summary judgment as to this defense is **DENIED**.

17 ii. Genericide

18 Plaintiff contends that as its marks are presumed valid, the burden of proving
19 genericness shifts to Defendants and Defendants cannot satisfy their burden of proof as a
20 matter of law. (Doc. No. 97 at 15.) Defendants contend that they have “riches” of evidence
21 that demonstrates that Plaintiff’s trademark is the victim of genericide, including that
22 Plaintiff’s own employees, competitors, and the media use the phrase “comic con” in a
23 generic sense. (Doc. No. 165 at 22; Doc. No. 244 at 13, 15; Doc. No. 244-3 at 22–23; Doc.
24 No. 246 at 14.)

25 It is undisputed that Plaintiff’s trademark is registered with the USPTO. (Doc. Nos.
26 95-3–6.) Thus, there exists a “strong presumption of validity.” *Coca-Cola Co. v. Overland*
27 *Inc.*, 692 F.2d 1250, 1254 (9th Cir. 1982). Specifically, “[t]he general presumption of
28 validity resulting from federal registration includes the specific presumption that the

1 trademark is not generic.” *Id.* Consequently, as a registered trademark is “given the prima
2 facie or presumptive advantage on the issue of validity,” the burden of production then
3 shifts to the defendant to prove otherwise. *Tie Tech, Inc. v. Kinedyne Corp.*, 296 F.3d 778,
4 783 (9th Cir. 2002).

5 To overcome this presumption, all inferences from the facts must be drawn most
6 favorably to the non-moving party. *KP Permanent Make-Up*, 408 F.3d at 604. Most
7 importantly, on a motion for summary judgment, the issue is generally viewed as “an
8 intensely factual issue,” whereas if the challenger “can demonstrate through law,
9 undisputed facts, or a combination thereof that the mark is invalid, the evidentiary bubble
10 bursts and the [trademark holder] cannot survive summary judgment.” *Tie Tech*, 296 F.3d
11 at 783.

12 After a careful review of the parties’ moving papers, the applicable law, and the
13 evidence on the record, the Court finds that Defendants have satisfied their burden of
14 demonstrating a genuine issue of material fact as to genericide.

15 “Federal courts [] view usage of [a] term by competitors in the industry as strong
16 evidence of how the public perceives them.” *Classic Foods Int’l Corp. v. Kettle Foods,*
17 *Inc.*, 468 F. Supp. 2d 1181, 1190 (C.D. Cal. 2007). “The more members of the public see
18 a term used by competitors in the field, the less likely they will be to identify the term with
19 one particular producer.” *Id.* Here, Defendants produce evidence that demonstrates that
20 “comic cons” are held in nearly every state of the United States including New York Comic
21 Con, Amazing Arizona Comic Con, Emerald City Comic Con, and Tampa Bay Comic Con.
22 (Doc. No. 223-1 at 39, 101, 129, 160.) This evidence of over 100 competitors using the
23 unhyphenated form of Plaintiff’s trademark strongly suggests that the mark is generic.
24 Consequently, this is persuasive evidence of genericide. *See CG Roxane LLC v. Fiji Water*
25 *Co. LLC*, 569 F. Supp. 2d 1019, 1027 (N.D. Cal. 2008) (holding that a competitors use of
26 a mark is compelling evidence of genericness as it reflects how the public identifies the
27 term).

28 Next, Defendants provide copious amounts of news articles that they argue use

1 “comic con” in a generic sense. (Doc. No. 244 at 15.) These include news article titles that
2 state (1) “New Yorkers get their nerd on at Comic Con,” (Doc. No. 222-48 at 43); (2) “5
3 ways Comicon benefits Phoenix,” (*Id.* at 36); (3) “Jam-Packed Comic Con Takes Over
4 New York City,” (*Id.* at 40); (4) “Comic Cons business update[,]” (*Id.* at 48); and (5) a
5 magazine article that stated, “San Diego and New York City have long been home to the
6 nation’s biggest comic conventions, known as “Comic-Con,” (*Id.* at 68).⁸

7 Media usage of a particular term in the popular press is strong evidence of how the
8 public perceives the term as the media “is often considered to have its finger on the pulse
9 of the general public” *Classic Foods*, 468 F. Supp. 2d at 1189. In the Ninth Circuit in
10 *Surgicenters*, the court relied on extensive media evidence to hold that the term
11 “Surgicenter” was generic. *Surgicenters of Am., Inc. v. Med. Dental Surgeries*, 601 F.2d
12 1011, 1013, 1017 (9th Cir. 1979). In considering usage by the media, the evidence weighs
13 in favor of Defendants. Here, Defendants have provided several examples of the media
14 using Plaintiff’s mark to describe comic fan conventions in general, and not to describe
15 Plaintiff’s convention in particular. *CG Roxane LLC*, 569 F. Supp. 2d at 1028–29 (“If
16 consumers repeatedly encounter a term used generically in the media, they will be much
17 more likely to use the term generically themselves.”) (citation omitted). Thus, this is further
18 evidence in favor of genericide.

19 Based on the foregoing, the Court finds that Defendants have satisfied their burden
20 in demonstrating a dispute of material fact as to whether Plaintiff’s mark is the victim of
21 genericide. Accordingly, Plaintiff’s motion for summary judgment on this defense is
22 **DENIED.**

23 Defendants also move for summary judgment on the same grounds. However, even
24 though the Court finds that Defendants satisfied their burden of demonstrating a dispute of
25 _____

26 ⁸ The Court notes that of the 4,000 documents produced by Defendants, many of the
27 documents are repetitive, or the same articles are produced twice. (*See generally* Doc. No.
28 222-48.) Moreover, a wide range of the documents are nondescript empty pages. (*Id.*)
Defendants are cautioned that this type of document dumping is prohibited at trial.

1 material fact as to genericide, their evidence as a whole does not demonstrate that they are
2 entitled to judgment as a matter of law on this issue. This conclusion is reinforced by
3 Plaintiff's submission of its consumer survey that demonstrates that over 80% of
4 consumers believed "Comic-Con" to be a brand name and not a generic name. (Doc. No.
5 106-3 at 11; Doc. No. 169 at 2.) Accordingly, the Court also **DENIES** Defendants' motion
6 for summary judgment based on a theory of genericide.

7 iii. Abandonment

8 Plaintiff asserts that Defendants have come forward with no evidence that it has
9 abandoned its rights to the Comic-Con marks.⁹ (Doc. No. 97 at 20.) In opposition,
10 Defendants retort that it basis its abandonment defense on Plaintiff's failure to police its
11 mark, which has resulted in its widespread use by competitors for identical services. (Doc.
12 No. 246 at 19.)

13 The Court agrees with Plaintiff that so far as Defendants seek to argue abandonment
14 based on third party use, summary judgment in Plaintiff's favor is warranted. The Court
15 highlights that in their reply brief, Defendants state that they do "base[] [their]
16 abandonment defense, in part, on [Plaintiff's] decades-long tolerance of third-party uses,"
17 or in other words, Plaintiff's "failure to police" its mark. (*Id.*) However, the Lanham Act
18 only provides two ways for a trademark to be abandoned, namely, through (1) nonuse, or
19 (2) the mark becoming generic. *See* 15 U.S.C. § 1127. Specifically, in a case where a
20 defendant is not claiming non-use of the trademark, "a mark shall be deemed 'abandoned'
21 . . . when any course of conduct of the owner, including acts of omission as well as
22 commission causes the mark to become . . . generic . . . or otherwise to lose its significance
23

24
25 ⁹ The Court notes that Defendants' opposition states that it basis its motion for summary
26 judgment on two abandonment theories: (1) naked licensing; and (2) failure to police. (Doc.
27 No. 246 at 18.) Plaintiff in its motion only requests summary judgment based on
28 Defendants' contentions of abandonment through third party use and abandonment through
withdrawal of Plaintiff's application to register the mark "comic con." (Doc. No. 97 at 20–
23.)

1 as a mark.” *Adidas-Am., Inc. v. Payless Shoesource, Inc.*, 546 F. Supp. 2d 1029, 1076 (D.
2 Ore. 2008) (citing 15 U.S.C. § 1127).

3 Thus, despite Defendants’ attempt to argue abandonment through third party use or
4 failure to police, these arguments are unquestionably meritless as Defendants have not
5 proven that Plaintiff’s mark is generic. *See Prudential Ins. Co. of Am. v. Gibraltar Fin.*
6 *Corp.*, 694 F.2d 1150, 1156 (9th Cir. 1982) (“Abandonment of a trademark, being in the
7 nature of forfeiture, must be strictly proved.”). Accordingly, Plaintiff’s motion for
8 summary judgment on this factor is **GRANTED**. *See Century 21 Real Estate Corp. v.*
9 *Sandlin*, 846 F.2d 1175, 1181 (9th Cir. 1988) (holding that evidence of other potential
10 infringers is “irrelevant” to a suit against a particular infringer); *see also McCarthy* § 17:17
11 (holding that a plaintiff’s failure to sue potentially infringing third parties is a relevant
12 factor as to the *strength of the mark*, but “[a]bandonment . . . requires proof that the mark
13 has lost all significance as an indication of origin. That is, the mark is completely without
14 signs of life”).

15 iv. Under the Lanham Act, Triable Issues of Fact Remain

16 The remainder of Plaintiff’s motion is devoted to arguing that the Court should grant
17 Plaintiff’s summary judgment motion as to Defendants’ liability under the Lanham Act.
18 (Doc. No. 97 at 23–31.)

19 To establish trademark infringement under the Lanham Act, the plaintiff must show
20 the defendant is “using a mark confusingly similar to [the plaintiff’s] valid, protectable
21 trademark” *Brookfield Commc’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1046
22 (9th Cir. 1999). To determine the likelihood of confusion, courts in the Ninth Circuit refer
23 to the eight-factor “Sleekcraft Test.” *GoTo.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199,
24 1205 (9th Cir. 2000). These factors include (1) similarity of the marks; (2) the relatedness
25 of the two companies’ goods or services; (3) the marketing channels used; (4) the strength
26 of the mark; (5) defendant’s intent in selecting its mark; (6) evidence of actual confusion;
27 (7) the likelihood of expansion into other markets; and (8) the degree of care likely to be
28 exercised by purchasers. *Id.* In cases such as this one that involve the internet, the three

1 most important *Sleekcraft* factors are the similarity of the marks, relatedness of the goods
 2 or services, and the simultaneous use of the same marketing channels. *Id.*; *Network*
 3 *Automation, Inc. v. Adv. Sys. Concepts, Inc.*, 638 F.3d 1137, 1141 (9th Cir. 2011). Thus,
 4 the Court will devote its time to analyzing these three factors.

5 *a. Similarity of the Marks*



10 “In considering the degree of similarity between the two marks, courts should
 11 analyze each mark within the context of other identifying features.” *Survivor Media, Inc.*
 12 *v. Survivor Prod.*, 406 F.3d 625, 633 (9th Cir. 2005). Plaintiff asserts that Defendants’ mark
 13 is virtually identical to the “Comic-Con” mark. (Doc. No. 97 at 24.) In response,
 14 Defendants assert that Plaintiff’s mark is so weak and diluted that the presence of a
 15 distinguishing geographic descriptor “Salt Lake” eliminates any potential for confusion.
 16 (Doc. No. 246 at 26.)

17 Here, in viewing Plaintiff and Defendants’ marks in their entirety, the Court finds
 18 that there are a variety of similarities: both use the marks within a square shape, both marks
 19 use the phrase “Comic Con,” which is identical in sound, sight, and meaning, and the
 20 phrase “Comic Con” is the prominent slogan within both marks. *See Entrepreneur Media,*
 21 *Inc. v. Smith*, 279 F.3d 1135, 1144 (9th Cir. 2002) (suggesting the examination of marks in
 22 their entirety including asking whether the marks are similar in sight, sound, and meaning).

23 While a fact-finder may conclude that the blatant use of the phrase “Comic Con”
 24 renders the marks nearly identical, the Court notes that this does not alleviate the existence
 25 of the fact that both marks use varying fonts and colors, and that Defendants utilize “Salt
 26 Lake” before the phrase “Comic Con.” Accordingly, there still exists a dispute of material
 27 fact concerning the two marks and whether they are so similar that they cause confusion
 28 amongst consumers. Thus, this factor weighs against Plaintiff.

1 **b. *Relatedness of the Goods***

2 The standard for deciding whether the parties' goods or services are "related" is
3 whether customers are "likely to associate" the two product lines. *Survivor Media*, 406
4 F.3d at 633 (citation omitted). Additionally, "the more closely related the goods are, the
5 more likely consumers will be confused by similar marks." *Entrepreneur Media*, 279 F.3d
6 at 1147; *see also E & J Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1291 (9th Cir.
7 1992) ("Where goods are related or complementary, the danger of consumer confusion is
8 heightened."). In addressing this factor, the Court's focus is "on whether the consuming
9 public is likely to somehow associate [Defendants' SLCC] with [Plaintiff's SDCC event]."
10 *Brookfield Commc'ns*, 174 F.3d at 1056.

11 Plaintiff argues that Defendants and it offer, promote, produce, and provide the very
12 same goods and services. (Doc. No. 97 at 25.) Defendants retort that using the sliding scale
13 approach, given the descriptive and highly diluted nature of Comic-Con, relatedness of
14 services does not favor confusion. (Doc. No. 246 at 29–30.)

15 Here, both of the services at issue are indeed complementary of each other. The
16 Court notes that Plaintiff's convention is a three day fan event that showcases and
17 celebrates comic art and comic books, and various other aspects of the popular arts such as
18 graphic arts, science fiction, films, television, fantasy films, and literature. (Doc. No. 1 ¶
19 11; Doc. No. 97 at 9.) Similarly, Defendants' event is also a three day fan convention
20 featuring the best in movies, television shows, gaming, sci fi, fantasy, and comic books.
21 (Doc. No. 244 at 12.) Based on the foregoing, it is clear that both events, though taking
22 place in different cities, are basically interchangeable. Accordingly, a jury could reasonably
23 conclude that the "proximity of the goods" factor favors Plaintiff. *AMF Inc. v. Sleekcraft*
24 *Boats*, 299 F.2d 341, 348 n.10 (9th Cir. 1979) ("Related goods are those products which
25 would be reasonably thought by the buying public to come from the same source if sold
26 under the same mark.") (internal quotation marks and citation omitted), *abrogated on other*
27 *grounds by Mattel Inc. v. Walking Mountain Prod.*, 353 F.3d 792 (9th Cir. 2003).

28 ///

1 *c. The Marketing Channels Used*

2 We must determine whether the parties distribute their goods in the same marketing
3 channels. *See Entrepreneur Media*, 279 F.3d at 1151. Here, both parties use the internet
4 and social media to reach potential customers. (Doc. No. 97 at 25–26; Farr Depo. at 48:2–
5 7; Herrera Decl. Ex. 6 (“Brandenburg Depo.”) 29:2–30, Doc. No. 95-8.) However, it is
6 well established that it “would be the rare commercial retailer that did not advertise online
7” *Network Automation*, 638 F.3d at 1151; *Playboy Enter., Inc. v. Netscape Comm.*
8 *Corp.*, 354 F.3d 1020, 1028 (9th Cir. 2004) (“Given the broad use of the Internet today, the
9 same could be said for countless companies. Thus, this factor merits little weight.”).
10 Accordingly, as a shared marketing channel does not shed much light on the likelihood of
11 consumer confusion, this factor weighs neutrally. *Network Automation, Inc.*, 638 F.3d at
12 1151.

13 Here, based upon the foregoing analysis, a reasonable jury could not find that there
14 is an absence of material fact as to the likelihood of confusion between Plaintiff’s mark
15 and Defendants’ use of “Comic Con” to advertise their event. Accordingly, Plaintiff’s
16 motion for summary judgment is **DENIED**.

17 v. Joint and Several Liability

18 Plaintiff asserts that as Defendants Dan Farr and Bryan Brandenburg made the
19 decision together to name their event “Salt Lake Comic Con,” they are jointly and severally
20 liable for any trademark infringement and false designation liability. (Doc. No. 97 at 32.)

21 “A corporate officer or director is, in general, personally liable for all torts which he
22 authorizes or directs or in which he participates, notwithstanding that he acted as an agent
23 of the corporation and not on his own behalf.” *Comm. for Idaho’s High Desert, Inc.*, 92
24 F.3d at 823 (citation omitted). This principle has been applied to trademark infringement
25 generally. *Id.* at 824. At this point, as Plaintiff has not established that as a matter of law
26 infringement has occurred, the Court refrains from making a finding as to this argument.
27 Accordingly, the Court **DENIES** Plaintiff’s motion for summary judgment as to joint and
28 several liability.

1 **D. Defendants’ Motion for Summary Judgment**

2 In addition to Defendants’ requests for summary judgment based on their
3 counterclaim of genericide, Defendants also seek a motion for summary judgment based
4 on theories of abandonment and estoppel. (Doc. No. 218.) Specifically, Defendants assert
5 that Plaintiff has abandoned any trademark rights by engaging in naked licensing and that
6 Plaintiff is estopped by its own conduct from asserting that Defendants’ use of Comic Con
7 infringes on their trademark. (*See generally* Doc. No. 245.)

8 i. Genuine Issues of Disputed Fact as to Abandonment Remain

9 Defendants contend that Plaintiff had a license agreement with Reed Exhibitions
10 (“Reed”), which allowed Reed to produce New York Comic-Con (“NYCC”). (Doc. No.
11 245 at 21.) However, according to Defendants, Plaintiff’s granted Reed this license, but
12 then failed to adequately control the quality of NYCC to Plaintiff’s detriment. (*Id.* at 24.)
13 Plaintiff vehemently denies that any license agreement exists between it and Reed. (Doc.
14 No. 173 at 12.)

15 “It is well-established that a trademark owner may grant a license and remain
16 protected provided quality control of the goods and services sold under the trademark by
17 the licensee is maintained.” *Barcamerica Int’l. USA Trust v. Tyfield Importers, Inc.*, 289
18 F.3d 589, 595 (9th Cir. 2002) (citing *Moore Bus. Forms, Inc. v. Ryu*, 960 F.2d 486, 489
19 (5th Cir. 1992) (internal quotation marks omitted)). But “[u]ncontrolled or ‘naked’
20 licensing may result in the trademark ceasing to function as a symbol of quality and
21 controlled source.” *McCarthy on Trademarks and Unfair Competition* § 18:48, at 18–79
22 (4th ed. 2001). Such abandonment “is purely an ‘involuntary’ forfeiture of trademark
23 rights,” for it need not be shown that the trademark owner had any subjective intent to
24 abandon the mark. *Id.* § 18:48, at 18–79. Accordingly, the proponent of a naked license
25 theory “faces a stringent standard” of proof. *Moore*, 960 F.2d at 489.

26 Here, the allegations that lead Defendants to believe that a license agreement exists
27 between Plaintiff and Reed are as follows. [REDACTED]

28 [REDACTED]

1 [REDACTED]
2 [REDACTED]
3 [REDACTED]
4 [REDACTED]
5 [REDACTED]
6 [REDACTED]
7 [REDACTED]
8 [REDACTED]
9 [REDACTED]
10 [REDACTED]
11 [REDACTED]
12 [REDACTED]

13 Based on the foregoing, Defendants wish to fashion a license agreement between
14 Reed and Plaintiff. However, after a careful review of the record and an analysis of both
15 parties' moving papers, the Court finds that Defendants have failed to meet the "stringent"
16 standard required to prove abandonment of trademark rights. *Monster, Inc. v. Dolby*
17 *Laboratories Licensing Corp.*, 920 F. Supp. 2d 1066, 1076 (N.D. Cal. 2013) (citing
18 *FreecycleSunnyvale v. Freecycle Network*, 626 F.3d 509, 514 (9th Cir. 2010)).

19 Here, all the Court is presented with is various communications between Plaintiff
20 and Reed. Though the letters go to discussions revolving around a settlement, Defendants
21 do not provide evidence that an agreement was ever made. The Court notes that Defendants
22 point to several internal communications between SDCC employees to demonstrate that
23 Plaintiff and NYCC had a license agreement. However, the Court finds that Defendants
24 have mischaracterized the evidence. For example, Defendants state that Ms. Fae Desmond
25 wrote to Public Relations Director David Glanzer stating:

26 [REDACTED]
27 [REDACTED]
28 [REDACTED]

1 [REDACTED]
 2 [REDACTED] Unlike, Defendants’ interpretation, taking this email in context, the
 3 Court notes that the foregoing statement was sent in an email to Mr. Glanzer with the
 4 subject line [REDACTED]
 5 included [REDACTED]
 6 [REDACTED] (Doc. No. 238-3 at 2; Doc. No. 238-4 at 3.) Thus, this does not
 7 establish the existence of an agreement, [REDACTED]
 8 [REDACTED]

9 Furthermore, Defendants have not provided any case law to support the idea that
 10 Plaintiff’s silence can be construed as acceptance. “Whether express or implied, a license
 11 is a contract governed by ordinary principles of state contract law.” *Foad Consulting Grp.,*
 12 *Inc. v. Azzalino*, 270 F.3d 821, 828 n.11 (9th Cir. 2001). Most relevant for the Court’s
 13 purposes is that “[s]ilence in the face of an offer is not an acceptance, unless there is a
 14 relationship between the parties or a previous course of dealing pursuant to which silence
 15 would be understood as acceptance.” *S. Cal. Acoustics Co. v. C.V. Holder, Inc.*, 79 Cal. 2d
 16 719, 722 (1969). Defendants argue that acceptance may be inferred from inaction in the
 17 face of a duty to act and from retention of a benefit offered. (Doc. No. 247 at 23.) However,
 18 neither situation is present here as Plaintiff had no “duty” to act and retained no benefit
 19 from the offer as most of the terms were never agreed to. Thus, as the record fails to provide
 20 any evidence that Reed and Plaintiff ever agreed to other contracts through silence,
 21 Defendants have not satisfied their burden in demonstrating that they are entitled to
 22 judgment as a matter of law on their theory of abandonment.

23 Moreover, [REDACTED]

24 [REDACTED]
 25 [REDACTED]
 26 [REDACTED]
 27 [REDACTED]
 28 [REDACTED]

1 Without more, it is clear that Defendants have failed to satisfy their burden on
2 summary judgment by providing evidence of a naked license that satisfies the “stringent”
3 standard established in this circuit. Accordingly, Defendants’ motion for summary
4 judgment based on its defense of abandonment through a naked license is **DENIED**.

5 ii. Plaintiff is Not Estopped from Arguing Infringement

6 Defendants contend that Plaintiff’s longstanding tolerance of other companies using
7 the unhyphenated form of their trademark “Comic-Con” estops it from now contending
8 that Defendants’ use of the unhyphenated form “comic con” infringes on their federally
9 registered trademark. (Doc. No. 245 at 25–30.) Plaintiff denies that they are estopped from
10 asserting trademark infringement claims against Defendants. (Doc. No. 173 at 19.)

11 Equitable estoppel “[r]ests firmly upon a foundation of conscience and fair dealing.”
12 *City of Long Beach v. Mansell*, 3 Cal. 3d 462, 488 (1970). The elements of equitable
13 estoppel are “(1) the party to be estopped must be apprised of the facts; (2) he must intend
14 that his conduct shall be acted upon, or must so act that the party asserting the estoppel has
15 a right to believe it was so intended; (3) the other party must be ignorant of the true state
16 of facts; and (4) he must rely upon the conduct to his injury.” *Schafer v. City of Los Angeles*,
17 237 Cal. App. 4th 1250, 1261 (2015) (citing *Strong v. Cty. of Santa Cruz*, 15 Cal. 3d 720,
18 725 (1975)). The Court reviews the factual findings regarding the existence of equitable
19 estoppel “under the substantial evidence test.” *Schafer*, 237 Cal. App. 4th at 1263.

20 [REDACTED]
21 [REDACTED]
22 [REDACTED]
23 [REDACTED]
24 [REDACTED]
25 [REDACTED]
26 [REDACTED]
27 [REDACTED]
28 [REDACTED]

1 [REDACTED]
2 [REDACTED]
3 Applying these facts to the elements of equitable estoppel, the Court finds that where
4 Defendants' arguments fail is that they have not proven that they relied upon Plaintiff's
5 actions to their injury. The Court notes that the settlement negotiations with CCC were
6 never matters of public record. (Doc. No. 173 at 22.) In fact, Defendants admit that they
7 were not privy to any of Plaintiff's communications with CCC. (Doc. No. 245 at 28.) Thus,
8 the Court is at a loss as to how Defendants can claim that they reasonably relied on these
9 negotiations when it came time to choose the name of their event. *See Waller v. Truck Ins.*
10 *Exch., Inc.*, 11 Cal. 4th 1, 35 (1995) (holding that the detrimental reliance must be
11 reasonable).

12 The Court notes that Defendants attempt to argue that Plaintiff's public actions
13 including (1) Plaintiff's withdrawal of their application for the trademark COMIC CON
14 and the subsequent registration of COMIC-CON; (2) Reed's longstanding use of "New
15 York Comic Con," and (3) the use of "comic con" by others caused Defendants to believe
16 that their use of Comic Con would be acceptable. (Doc. No. 245 at 28.) The Court
17 disagrees. The very nature of settlement agreements is their confidential character. Thus,
18 it is far-fetched for Defendants to have reasonably believed that Plaintiff was not in
19 settlement agreements with various other comic conventions, that they were not policing
20 their mark, or that its withdrawal of its application for "Comic Con" was aimed at
21 informing other companies that they could use the mark "comic con" without the threat of
22 litigation. Consequently, the Court finds that there are disputed facts that support more than
23 one reasonable conclusion in regards to equitable estoppel. *See Schafer*, 237 Cal. App. 4th
24 at 1263 ("The existence of equitable estoppel generally is a factual question for the trier of
25 fact to decide, unless the facts are undisputed and can support only one reasonable
26 conclusion as a matter of law.").

27 Accordingly, as Defendants have not satisfied their burden and cannot prove each
28 element of equitable estoppel, this defense must fail. *Am. Casualty Co. v. Baker*, 22 F.3d

1 880, 892 (9th Cir. 1994) (“Where any one of the elements of equitable estoppel is absent,
2 the claim must fail.”) (citation omitted). Thus, Defendants’ motion for summary judgment
3 as to this defense is **DENIED**.

4 **E. Motion to Strike Under Federal Rule of Civil Procedure 12(f)**

5 On a final note, the Court articulates that it takes issue with the alleged “undisputed
6 facts” section of Defendants’ motion for summary judgment based on abandonment.
7 Within this section, Defendants list Plaintiff’s trademarks and then delve into allegations
8 surrounding [REDACTED] and Plaintiff’s purportedly
9 “fraudulent registration of the hyphenated form Comic-Con.” (Doc. No. 245 8–13.) It is
10 unquestionably clear that these arguments are anything but “undisputed facts,” but are
11 actually highly contested allegations.

12 Moreover, the Court is unsure as to how the fraud allegations within the “undisputed
13 facts” section is relevant to Defendants’ motion for summary judgment. Defendants clearly
14 state that the Court should summarily adjudicate Plaintiff’s infringement claims on two
15 grounds: (1) based on Plaintiff’s alleged naked license with New York Comic Con; and (2)
16 based on theories of judicial estoppel. (Doc. No. 245 at 7.) Nowhere do Defendants argue
17 a defense sounding in fraud.

18 Consequently, the Court finds the three pages devoted to Ms. Fae Desmond and her
19 testimony before the USPTO not only immaterial but also impertinent. *See Fantasy, Inc.*
20 *v. Fogerty*, 984 F.2d 1524, 1527 (9th Cir. 1993) (“Immaterial matter is that which has no
21 essential or important relationship to the claim for relief or the defenses being pleaded.”)
22 (internal quotation marks omitted), *reversed on other grounds by* 510 U.S. 517 (1994); *see*
23 *also Whittlestone, Inc. v. Handi-Craft Co.*, 618 F.3d 970, 974 (9th Cir. 2010) (“Impertinent
24 matter consists of statements that do not pertain, and are not necessary, to the issues in
25 question”) (citation omitted). Furthermore, the fraud allegations are not only a baseless
26 attack on Plaintiff unsupported by the record, but they are also in complete disregard of the
27 Court’s previous order. The Court reminds Defendants that the Court denied their motion
28 to amend their pleadings to assert the allegations that Plaintiff’s trademarks were procured

1 in fraud. (*See generally* Doc. No. 202.)


2 Consequently, finding that Defendants have used their motion to improperly inject
3 irrelevant and scandalous allegations into their motion, the Court finds a motion to strike
4 warranted. For these reasons, the Court **STRIKES** page 7 lines 13–16, page 10 lines 17–
5 26, page 11–12 in their entirety, and lines 1–2 on page 13 of CM/ECF document number
6 245. *See* Fed. R. Civ. P. 12(f)(1) (a court may act on a motion to strike “on its own”); *see*
7 *also Sliger v. Prospect Mortg., LLC*, 789 F. Supp. 2d 1212, 1216 (E.D. Cal. 2011) (“The
8 court, however, may make appropriate orders to strike under the rule at any time on its own
9 initiative.”).

10 **CONCLUSION**

11 As explained more fully above, the Court **DENIES** Defendants’ motion to exclude,
12 (Doc. No. 106), **GRANTS** Plaintiff’s motion to exclude, (Doc. No. 91), **DENIES**
13 Defendants’ motions for summary judgment, (Doc. Nos. 216, 218), **GRANTS IN PART**
14 **AND DENIES IN PART** Plaintiff’s motion for summary judgment, (Doc. Nos. 95, 97),
15 and **GRANTS** both parties’ requests for judicial notice, (Doc. Nos. 95-1, 216-1).

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17 **IT IS SO ORDERED.**

18 Dated: September 12, 2017

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20 Hon. Anthony J. Battaglia
21 United States District Judge
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Docket No. 598
USDC, S.D. of California
Case No. 14-cv-01865-AJB-JMA

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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

SAN DIEGO COMIC CONVENTION, a
California non-profit corporation,

Plaintiff,

v.

DAN FARR PRODUCTIONS, a Utah
limited liability company, DANIEL
FARR, an individual, BRYAN
BRANDENBURG, an individual,

Defendants.

Case No.: 14-cv-1865-AJB-JMA

**AMENDED ORDER GRANTING IN
PART AND DENYING IN PART
PLAINTIFF’S MOTION FOR
ATTORNEYS’ FEES AND COSTS
PURSUANT TO 15 U.S.C. § 1117(a)**

(Doc. No. 425)

Pursuant to 15 U.S.C. § 1117(a), a court may in “exceptional cases” award reasonable attorneys’ fees and costs to the prevailing party in a trademark infringement lawsuit. Plaintiff San Diego Comic Convention (“SDCC”) moves this Court to find that the instant case is “exceptional.” (Doc. No. 425.) Defendants Dan Farr Productions, Daniel Farr, and Bryan Brandenburg (collectively referred to as “DFP”) oppose SDCC’s request. (Doc. No. 512.) On May 31, 2018, the Court held a hearing on the motion and then submitted the matter. (Doc. No. 504.) Finding that this case is in fact “exceptional,” the Court awards SDCC reasonable attorneys’ fees and costs subject to certain deductions.

1 Accordingly, the Court **GRANTS IN PART AND DENIES IN PART** SDCC’s motion.
2 (Doc. No. 425.)

3 **BACKGROUND**

4 The Court is already well-versed as to the events leading up to the institution of this
5 action. Thus, for the purposes of this Order, the Court will only provide a narrow review
6 of this lawsuit’s factual and procedural background.

7 On August 7, 2014, SDCC filed a lawsuit against DFP alleging two causes of action:
8 (1) Federal Trademark Infringement, 15 U.S.C. § 1114; and (2) False Designation of
9 Origin, 15 U.S.C. § 1125(a). (*See generally* Doc. No. 1.) SDCC is a non-profit corporation,
10 formed in 1975, that is dedicated to the awareness and appreciation of comics and related
11 popular art forms. (Doc. No. 1 ¶ 10.) Every year since 1970, SDCC has produced and held
12 its convention known as the “Comic-Con convention” in San Diego, California. (*Id.* ¶ 11;
13 Doc. No. 97 at 9.)¹ The convention spans several days in length and showcases several
14 hundred events, workshops, educational and academic programs, games, award shows,
15 costume contests, as well as hosts panels of special guests that include science fiction and
16 fantasy authors, film and television actors, directors, producers, and writers. (Doc. No. 1 ¶
17 12; Doc. No. 97 at 9.) In 2016, attendance to San Diego Comic-Con exceeded over 135,000
18 attendees. (Doc. No. 97 at 9.)

19 SDCC’s family of trademarks at issue in this case are:

- 20 1. Comic-Con;
 - 21 2. Comic Con International;
 - 22 3. Anaheim Comic-Con; and
- 23
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27 ¹ Page numbers refer to the CM/ECF number and not the number listed on the original
28 document.



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4 4.

5 (Doc. No. 1 ¶ 13; Doc. No. 244 at 11.) Each of these registered trademarks is incontestable.
6 (Doc. No. 381 at 25:15–25.) Additionally, SDCC states that it has used these marks
7 extensively and continuously in interstate commerce and thus the marks have become
8 valuable assets as well as symbols of its goodwill and positive industry reputation. (Doc.
9 No. 1 ¶ 15.)

10 In early 2013, Defendant Dan Farr Productions, a limited liability company, began
11 to advertise and promote its own popular arts convention named “Salt Lake Comic Con”
12 (“SLCC”). (Doc. No. 234-2 at 7; Herrera Decl. Ex. 5 (“Farr Depo.” 11:4–9, Doc. No. 95-
13 7).) Similar to SDCC’s convention, SLCC is a three-day fan event featuring the best in
14 movies, television shows, gaming, sci-fi, fantasy, and comic books. (Doc. No. 244 at 12.)
15 Since 2013, SLCC has been held every year and in the beginning of 2014, Dan Farr
16 Productions created its Salt Lake Comic Con FanXperience event, which has also been
17 held every year since its inception. (Farr Depo. at 11:10–15; Doc. No. 97 at 11.)

18 Thus, the marrow of this case is whether DFP’s comic arts and popular fiction
19 event named “Salt Lake Comic Con” infringed on SDCC’s three incontestable trademarks.²
20 On December 8, 2017, after an eight-day jury trial, the jury found that DFP had indeed
21 infringed on SDCC’s family of trademarks. (Doc. No. 395 at 2–5.) As to unfair competition
22 and false designation of origin however, the jury found in favor of DFP. (*Id.* at 6.) In total,
23 the jury awarded corrective advertising damages to SDCC in the amount of \$20,000.00.
24 (*Id.* at 8.)

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28 ² The Court notes that after the trial, DFP changed the name of their event to “FanX Salt Lake Comic Convention.” (Doc. No. 513 at 7–8.)

1 Post-trial, SDCC filed three motions: (1) its motion for permanent injunction, (Doc.
2 No. 419); (2) the instant motion, its motion for attorneys’ fees and costs, (Doc. No. 425);
3 and (3) its motion for judgment as a matter of law or in the alternative motion for new trial,
4 (Doc. No. 433). Thereafter, on August 8, 2018, the Court ordered SDCC to file a
5 supplemental brief breaking down the total amount of fees it requested. (Doc. No. 523.)
6 DFP then asked for the opportunity to respond to SDCC’s supplemental brief. (Doc. No.
7 531.) The Court granted this request, and DFP’s response was filed on August 22, 2018.
8 (*Id.*; Doc. No. 532.)

9 DISCUSSION

10 A. This Case is Exceptional Pursuant to 15 U.S.C. § 1117(a)

11 SDCC’s motion provides an exhaustive and detailed account of the actions it
12 believes makes this case exceptional. (*See generally* Doc. No. 425-1.) In opposition, DFP
13 asserts that SDCC’s motion is based on distortions, is unpersuasive, and relies on critiques
14 that are hyperbolic and hypocritical. (*See generally* Doc. No. 512.)

15 The Lanham Act permits an award of reasonable attorneys’ fees to the prevailing
16 party in “exceptional cases.” 15 U.S.C. § 1117(a). Originally, “[w]hile the term
17 ‘exceptional’ [was] not defined in the statute, generally a trademark case [was] exceptional
18 for purposes of an award of attorneys’ fees when the infringement [was] malicious,
19 fraudulent, deliberate or willful.” *Lindy Pen Co., Inc. v. Bic Pen Corp.*, 982 F.2d 1400,
20 1409 (9th Cir. 1993).

21 In 2016, the Ninth Circuit in *SunEarth, Inc. v. Sun Earth Solar Power Co., Ltd.*, 839
22 F.3d 1179 (9th Cir. 2016), relied on the Supreme Court’s decision in *Octane Fitness, LLC*
23 *v. ICON Health & Fitness, Inc.*, 134 S. Ct. 1749, 1756 (2014), to abrogate *Lindy Pen Co.*
24 and modify the standard definition of “exceptional” in attorney fee recovery Lanham Act
25 cases. *SunEarth, Inc.*, 839 F.3d at 1180. Ultimately, the Ninth Circuit held that “district
26 courts analyzing a request for fees under the Lanham Act should examine the ‘totality of
27 the circumstances’ to determine if the case [is] exceptional, exercising equitable discretion
28

1 in light of the nonexclusive factors identified in *Octane Fitness* and *Fogerty*, and using a
2 preponderance of the evidence standard.” *Id.* at 1181 (internal citation omitted).

3 The Ninth Circuit also defined an exceptional case as one that simply “stands out
4 from others with respect to the substantive strength of a party’s litigating position
5 (considering both the governing law and the facts of the case) or the unreasonable manner
6 in which the case was litigated.” *Id.* at 1180 (citation omitted). The nonexclusive factors in
7 determining if a case is “exceptional” include: “frivolousness, motivation, objective
8 unreasonableness (both in the factual and legal components of the case) and the need in
9 particular circumstances to advance considerations of compensation and deterrence.” *Id.* at
10 1181 (citation omitted).³ Additionally, despite the Ninth Circuit’s decision to alter the
11 definition of “exceptional,” the Federal Circuit held that *Octane Fitness* “gave no
12 indication that [the Federal Circuit] should rethink [its] litigation misconduct line of § 285
13 cases” and stated that “district courts can turn to [] pre-*Octane Fitness* case law for
14 guidance” regarding such arguments. *SFA Sys., LLC v. Newegg Inc.*, 793 F.3d 1344, 1349
15 (Fed. Cir. 2015).

16 In sum, litigation brought in bad faith or with objectively baseless claims may be
17 considered exceptional, as may litigation demonstrating inequitable conduct or willful
18 infringement. *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 525 n.12 (1994); *see also Octane*
19 *Fitness*, 134 S. Ct. at 1757 (“[A] case presenting either subjective bad faith or exceptionally
20 meritless claims may sufficiently set itself apart from mine-run cases to warrant a fee
21 award.”). Similarly, courts “have awarded attorneys’ fees . . . where a party advances
22 arguments that are particularly weak and lack support in the record or seek only to re-
23 litigate issues the court has already decided.” *Intex Recreation Corp. v. Team Worldwide*
24 *Corp.*, 77 F. Supp. 3d 212, 217 (D.C. Cir. 2015). Thus, the determination of “exceptional”
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27 ³ “*Octane Fitness* lowered the bar for an exceptional case finding[.]” *Veracode, Inc. v.*
28 *Appthority, Inc.*, 137 F. Supp. 3d 17, 102 (D. Mass. 2015).

1 falls squarely within the discretion of the trial court. *Highmark Inc. v. Allcare Health Mgmt.*
2 *Sys., Inc.*, 134 S. Ct. 1744, 1748 (2014).

3 Here, the jury found that DFP infringed on all three of SDCC’s trademarks, yet also
4 found that DFP did not willfully infringe the marks. (*See generally* Doc. No. 395.) Thus,
5 under the original definition of “exceptional,” SDCC’s request for attorneys’ fees would
6 have been difficult to advance successfully. *See Gracie v. Gracie*, 217 F.3d 1060, 1068
7 (9th Cir. 2000) (“Here the jury explicitly found that [the defendant] engaged in ‘willful’
8 infringement . . . The district court’s decision to make a fee award to [the plaintiff] thus
9 flows quite naturally from the jury’s finding of willful infringement . . .”). However, after
10 *SunEarth*, examining the totality of the circumstances, the Court finds that this case is not
11 a dime a dozen. Instead, it is a trademark infringement lawsuit that stands out from others
12 based on the unreasonable manner it was litigated and thus an award of attorneys’ fees and
13 costs to SDCC is justified.

14 ***i. SDCC is the Prevailing Party***

15 As an initial matter, the Court addresses DFP’s assertion that the “split verdict” in
16 this case illustrates that there is no clear winner. (Doc. No. 512 at 8–9.) Accordingly, as
17 the Lanham Act only authorizes an award of fees “to the prevailing party,” DFP contends
18 that SDCC’s motion is flawed. (*Id.*) DFP’s argument is both unpersuasive and legally
19 unsound.

20 Had DFP researched this issue thoroughly, DFP would have discovered that the jury
21 verdict in favor of SDCC for trademark infringement renders SDCC the prevailing party.
22 *See Farrar v. Hobby*, 506 U.S. 103, 111–12 (1992) (illustrating that a party prevails “when
23 actual relief on the merits of [the plaintiff’s] claim materially alters the legal relationship
24 between the parties by modifying the defendant’s behavior in a way that directly benefits
25 the plaintiff.”); *see also Hensley v. Eckerhart*, 461 U.S. 424, 433 (1983) (holding that a
26 prevailing party is one that “succeed[s] on any significant issue in litigation which achieves
27 some of the benefit the parties sought in bringing suit.”) (citation omitted); *Orantes-*
28 *Hernandez v. Holder*, 713 F. Supp. 2d 929, 942 (C.D. Cal. 2010) (“A plaintiff is deemed

1 the ‘prevailing party’ if, as a result of a judgment or consent decree entered in the legal
2 action he or she brought, there is a ‘material alteration of the legal relationship of the
3 parties.’”) (citation omitted). Based on the foregoing, in the instant matter, SDCC is the
4 prevailing party for § 1117(a) purposes.

5 Next, the Court identifies the various circumstances of this case that warrant an
6 award of attorneys’ fees and costs under § 1117(a).

7 *ii. DFP’s Failure to Comply with Court Rules*

8 The Court highlights three incidents that occurred prior to trial. First, in
9 contravention to this Court’s Local Rules, DFP filed two summary judgment motions that
10 totaled over forty pages in length. (Doc. Nos. 216, 218, 244, 245.) The local rules clearly
11 explicate that when filing a motion, all the arguments should be contained in one brief, not
12 exceeding a total of twenty-five (25) pages. CivLR 7.1.h.

13 DFP advances two arguments to explain their actions, both of which are nonsensical
14 and only further support this Order’s final conclusion. DFP asserts that they had leave to
15 make their filings because the Clerk gave out a single hearing date for all dispositive
16 motions and that SDCC also broke the rules as it filed both a motion for summary judgment
17 and a motion to exclude on the same day, which totaled over forty-three pages. (Doc. No.
18 512 at 20–21.) DFP’s reasoning is disconcerting. Logically, all arguments relating to a
19 specific motion need to be contained in a single motion. Under DFP’s theory of motion
20 practice, a party could file a separate brief for every cause of action it sought to dismiss
21 under Federal Rule of Civil Procedure 12(b)(6), thereby violating the page limits set by
22 this Court. This is erroneous. Thus, in contrast to DFP’s belief that SDCC broke the rules,
23 it did not.

24 The Court also highlights that DFP did not file a timely Daubert challenge to
25 SDCC’s expert Patrick Kennedy. The Court then denied DFP’s motion to file a late
26 challenge, however despite this, DFP utilized a motion in limine to revisit the issue. (Doc.
27 Nos. 321, 345, 340; Transcript of Motion in Limine Hearing at 169:14–16, November 14,
28 2017.) In the same vein, after DFP lost a Daubert challenge to SDCC’s expert Mr. Ezell,

1 (Doc. No. 263 at 10), DFP attempted to re-introduce their argument that Mr. Ezell and his
2 Teflon Survey were irrelevant both during motion in limine, (Doc. No. 314-1 at 7), and in
3 their motion for judgment as a matter of law, (Doc. No. 429-1 at 14).

4 Finally, the most prominent example of DFP's disregard for this Court's rules and
5 procedures occurred on June 23, 2017, when DFP filed a motion for leave to amend their
6 pleading that expressly referenced testimony that had been designated "Confidential—
7 Attorneys' Eyes Only" by SDCC and the Protective Order in this case. (Doc. No. 129-1 at
8 3.) In spite of the highly confidential information contained in the document, Defendant
9 Bryan Brandenburg also disseminated the information on the Internet through his social
10 media accounts and SLCC's Twitter Page. (*Id.*)

11 In sum, DFP's indifference to this Court's rulings and the Local Rules are actions
12 that should be deterred by compensation furnished to SDCC.

13 ***iii. DFP's Unreasonable Manner of Litigation***

14 **a. DFP's Persistent Desire to Re-Litigate Issues Already Decided**

15 At every opportunity, DFP has repeated, re-argued, and recycled arguments already
16 briefed by both parties and analyzed and ruled on by the Court. This type of wasteful
17 litigation tactic forced SDCC to expend extra, unnecessary legal fees and drove this Court
18 to squander already limited judicial resources.

19 The Court first focuses on DFP's naked licensing defense. This defense was first
20 produced at summary judgment. (Doc. No. 263-1 at 20–25.) However, finding insufficient
21 evidence to support the theory, the Court denied DFP's motion on the matter. (Doc. No.
22 263 at 26–29.) Thereafter, during the pre-trial conference, after the Court expressed its
23 concern that there was not enough evidence to bring this defense to trial, DFP offered to
24 prepare a formal proffer document on the issue and submit that in advance of the motion
25 in limine hearing. (Doc. No. 265 at 9:11–11:19.)

26 DFP's formal proffer document provided the Court relatively the same evidence
27 supplied at summary judgment. (Doc. Nos. 315, 344.) Accordingly, still finding the
28 evidence inadequate, the Court denied the motion. (Doc. No. 340.) Post-trial, DFP's motion

1 for new trial inexplicably argues that they are “entitled to a proper adjudication of its naked
2 licensing defense.” (Doc. No. 436-1 at 7.) Thus, in total, DFP has attempted to re-argue
3 this defense three times, blatantly ignoring the record and this Court’s previous rulings.

4 DFP’s repetitive motion practice also manifested itself in their “generic ab initio”
5 defense. Initially, when this theory was first presented to the Court during summary
6 judgment, DFP argued that this case “is not a genericide case.” (Doc. No. 244 at 23.)
7 Instead, DFP argued that “Comic-Con” was generic “before it was applied as a trademark
8 to the products in question.” (*Id.* at 24 (citing *Horizon Mills Corp. v. QVC, Inc.*, 161 F.
9 Supp. 2d 208, 220 n.16 (S.D.N.Y. 2001)).)

10 After carefully considering the evidence outlined by DFP, the Court denied DFP’s
11 summary judgment motion arguing that SDCC’s trademarks are generic ab initio. (Doc. No.
12 263 at 18.) Notwithstanding this fact, DFP brought a motion in limine “regarding
13 genericness evidence.” (Doc. No. 314-1.) Finding the in limine motion improper, the Court
14 stated during the hearing:

15 **The Court:** Well, it could be that I ruled out generic ab initio, already. And
16 re-arguing it again is questionable to whether it’s in conformity to what
17 motion in limine is about.

18 . . .

19 This is a motion in limine. We’re talking about a time line and you’ve tried to
20 reargue the summary judgment.

(Doc. No. 425-7 at 4:21–10:12.) This motion was then denied. (Doc. No. 340.)

21 In spite of the summary judgment order and the in limine ruling, DFP’s motion for
22 new trial devotes several pages to arguing that they should have been “allowed to show
23 *Genericness Ab Initio.*” (Doc. No. 436-1 at 17–27.) DFP supported this argument with
24 more or less the same evidence produced at summary judgment. Altogether, “Generic ab
25 initio” has been discussed, analyzed, and denied by this Court three times.⁴

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28 ⁴ Generic ab initio was not only repeatedly discussed, but it is also a defense that DFP
strategically used and then disposed of depending on the evidence they sought to exclude.

1 Though not referenced by SDCC, DFP’s use of the Oxford Dictionary definition of
2 “Con” is another blatant example of DFP’s “head in the sand” litigation strategies that has
3 resulted in this Court repeatedly re-analyzing the same arguments. At summary judgment,
4 to support their “generic ab intio” theory of defense, DFP argued that one may look to the
5 individual parts of a mark. (Doc. No. 244 at 16, 19.) DFP then referenced the Oxford
6 Dictionary definition of “con.” (*Id.*) In its order denying DFP’s summary judgment motion
7 on “generic ab intio,” the Court clearly explained that courts have not only held that
8 dictionary definitions are weak evidence of genericness, but that courts have routinely
9 rejected the breaking down of phrases into their individual and often generic parts. (Doc.
10 No. 263 at 17.)

11 Astonishingly, ignoring the case law provided to them, DFP’s motion for new trial
12 again points to the same Oxford dictionary definition. (Doc. No. 436-1 at 25.) As a result,
13 this argument has been recycled by DFP twice in complete disregard of this Court’s
14 previous rulings and Ninth Circuit precedent. *See Advertise.com, Inc. v. AOL Advertising,*
15 *Inc.*, 616 F.3d 974, 978 (9th Cir. 2010) (concluding that in determining similarity of marks
16 “we look to the mark as a whole and that the combination of generic terms may, in some
17 instances, result in a distinctive mark.”).

18 DFP also repeatedly sought to compel this Court to revisit their fraud defense. First,
19 DFP unsuccessfully requested leave to add fraud as an affirmative defense. (Doc. No. 202
20 at 6–10.) Thereafter, at the pretrial conference, DFP again referenced this defense. (Doc.
21 No. 265 at 12:8–20.) DFP then filed a motion in limine to be able to put forward evidence
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24 The Court notes that at the outset DFP plainly asserted that this was not a genericide case.
25 (Doc. No. 244 at 23.) DFP’s summary judgment motion then asserted that as SDCC’s
26 trademarks were “generic ab initio,” SDCC’s Teflon survey was irrelevant. (*Id.* at 23–24.)
27 In contrast to the above, DFP’s expert Jeffrey Kaplan stated in his report that he was hired
28 to “offer linguistic evidence supporting [his] opinion that the expression ‘comic con’ was
generic at the time the above-captioned law suit was filed, and is currently generic[.]” (Doc.
No. 91-2 at 3 (emphasis added).) This discrepancy was noted by the Court in its summary
judgment order. (Doc. No. 263 at 12.)

1 of SDCC’s alleged fraud on the USPTO to the jury. (Doc. No. 319.) The Court ultimately
2 denied the motion after reminding DFP that it had already gotten rid of the fraud claim.
3 (Transcript of Motion in Limine hearing at 141:20–22, November 14, 2017.) In sum, fraud
4 was re-argued two times.

5 Ultimately, resembling a broken record, DFP has repetitively restated and rehashed
6 several contentions that they were unable to advance successfully prior to trial. This type
7 of cyclical motion practice is objectively unreasonable and has justified attorneys’ fees
8 under the Lanham Act. *See Parks, LLC v. Tyson Foods, Inc.*, No. 5:15-cv-00946, 2017 WL
9 3534993, at *1 (E.D. Pa. Aug. 17, 2017) (holding that the hallmark of a case that has been
10 litigated in an unreasonable manner is one that involves “wasteful procedural maneuvers
11 or dilatory tactics”) (citation and internal quotation marks omitted); *see also Cognex Corp.*
12 *v. Microscan Sys., Inc.*, No. 13- CV-2027 JSR, 2014 WL 2989975, at *4 (S.D.N.Y. June
13 30, 2014) (criticizing the plaintiff for post-trial motions that simply sought to relitigate
14 issues decided during trial and awarding fees at least as to those motions); *Precision Links*
15 *Inc. v. USA Prods. Grp., Inc.*, No. 3:08-cv-00576-MR, 2014 WL 2861759, at *3 (W.D.N.C.
16 June 24, 2014) (criticizing the plaintiff for seeking a preliminary injunction based in large
17 part on a previously rejected theory of liability and for filing frivolous post dismissal
18 motions).

19 b. DFP’s Objectively Unreasonable Legal Arguments

20 DFP’s efforts to formulate legal arguments based on factually and legally irrelevant
21 case law also help bolster this Court’s conclusion that the instant matter is not a middle-of
22 the-road trademark case. The Court notes that at certain points, DFP’s zealous advocacy
23 has turned into gamesmanship.

24 To begin with, the Court focuses on DFP’s motion to amend their pleading. DFP
25 sought to amend so that they could allege that SDCC committed fraud on the USPTO. (*See*
26 *generally* Doc. No. 204-1.) However, DFP’s motion failed to cite to the correct legal
27 standard to support such a claim. Instead, DFP pointed the Court to a list of inapplicable
28 patent cases. (*Id.* at 5.)

1 Further, DFP requested amendment so as to add a defense of inequitable conduct.
2 (*Id.* at 16.) However, as the Court pointed out in its order, inequitable conduct is a defense
3 raised in patent infringement cases. (Doc. No. 202 at 11 (*see Mag Instrument, Inc. v. JS*
4 *Prods., Inc.*, 595 F. Supp. 2d 1102, 1109 (C.D. Cal. 2008) (holding that inequitable conduct
5 consists of several elements including “the failure to disclose known material information
6 during the prosecution of a patent, coupled with the intent to deceive the PTO.”).)

7 DFP’s motion in limine proffering evidence of a naked license is yet another
8 example of DFP’s faulty, hodgepodge legal reasoning. (Doc. No. 344.) DFP states:

9 Second, “where circumstances or the previous course of dealing between the
10 parties places the offeree under a duty to act or be bound, his silence or
11 inactivity will constitute his assent”: SDCC’s silence, on the heels of its
12 “threatened immediate or vigorous enforcement,” was “intentionally
13 misleading”—and gave SDCC “a duty to speak,” especially when coupled
14 with Reed’s communicated reliance on its remedial measures’ sufficiency and
15 years of friendly intercourse. Third, “implied license may arise by ...
16 acquiescence”; “permission or lack of objection is ... equivalent to ...
17 license [REDACTED]”

18 (*Id.* at 6 (internal footnotes omitted).) The Court illustrates that in total, DFP selectively
19 chose and blended together specific phrases from five different cases. Specifically, DFP
20 quotes from: *Beatty Safway Scaffold, Inc. v. Skrable*, 180 Cal. App. 2d 650, 655 (1960);
21 *Hottel Corp. v. Seaman Corp.*, 833 F.2d 1570, 1574 (Fed. Cir. 1987); *Scholle Corp. v.*
22 *Blackhawk Molding Co.*, 133 F.3d 1469, 1472 (Fed. Cir. 1998); *I.A.E., Inc. v. Shaver*, 74
23 F.3d 768, 775 (7th Cir. 1996); and *Winbond Elec. Corp. v. ITC*, 262 F.3d 1363, 1374 (Fed.
24 Cir. 2001). (*Id.*) However, DFP’s reliance on the foregoing cases is misplaced—both *Hottel*
25 *Corp.* and *Scholle Corp.*, analyze equitable estoppel defenses in the patent infringement
26 context, 833 F.2d at 1574; 133 F.3d at 1472, *Shaver*, examined how a copyright owner
27 could transfer to another person any exclusive rights an owner has in a copyright, 74 F.3d
28 at 774–75, and *Winbond* examined an implied license/waiver in a patent infringement case,
262 F.3d 1374.

1 A final example of DFP’s groundless legal reasoning comes from their opposition
2 brief to SDCC’s instant motion. DFP’s brief cites to *Kellogg Co.*, to demonstrate that Mr.
3 Brandenburg did not admit that Comic Con is a brand. (Doc. No. 512 at 10–11.) Instead,
4 DFP claims that what Mr. Brandenburg meant when he said “brand” was the “goodwill”
5 of SDCC’s events, not that he meant “brand” in a legal trademark sense. (*Id.* at 11.) The
6 portion of *Kellogg* DFP employs is:

7 Kellogg Company is undoubtedly sharing in the goodwill of the article known
8 as “Shredded Wheat”; and thus is sharing in a market which was created by
9 the skill and judgment of plaintiff’s predecessor and has been widely extended
10 by vast expenditures in advertising persistently made. But that is not unfair.
11 Sharing in the goodwill of an article unprotected by patent or trade-mark is
the exercise of a right possessed by all—and in the free exercise of which the
consuming public is deeply interested.

12 *Id.* (citing *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 122 (1938)).

13 It is plainly clear to the Court and should be evidently unmistakable to DFP that
14 *Kellogg* is factually immaterial. In *Kellogg*, the plaintiff did not have an exclusive right to
15 the use of the term “Shredded Wheat” as a trade name as it was determined that the term
16 was generic of the article it described. *Id.* at 116 (emphasis added). In fact, “Shredded
17 Wheat” was never used as a trademark. *Id.* at 117. Additionally, the patent for the product
18 and the process of making the item was “dedicated to the public” as the patent had expired
19 on October 15, 1912. *Id.* The present matter involves three incontestable trademarks—
20 trademarks DFP knew were registered with the USPTO—and there is no patent in play.⁵
21 (Doc. No. 394 at 21.)

22 The above-mentioned examples are simply a small collection of DFP’s unreasonable
23 manner of litigation and do not encompass every instance they misrepresented a case for
24 their own benefit. This type of frivolous motion practice should be deterred. *See Monolithic*
25

26 ⁵ The Court notes that *Kellogg* is also a recycled argument, having already determined its
27 inapplicability during motion in limine. (*See generally* Doc. No. 314; Transcript of Motion
28 in Limine Hearing at 29:5–19, November 14, 2017.)

1 *Power Sys., Inc. v. O2 Micro Int'l Ltd.*, 726 F.3d 1359, 1366 (Fed. Cir. 2013) (“[L]itigation
2 misconduct and unprofessional behavior may suffice, by themselves, to make a case
3 exceptional . . .”).

4 Beyond gamesmanship, there has been inappropriate citation to as well as
5 incomplete or inaccurate references to purported case authority throughout this litigation
6 by DFP. In each order on every post-trial matter, DFP has been called out in this regard.

7 c. DFP’s Objectively Unreasonable Responses to this Litigation

8 More convincing evidence of this case’s exceptional nature materializes itself in
9 DFP’s unreasonable responses to this litigation. DFP admits to receiving SDCC’s cease
10 and desist letter. (Doc. No. 383 at 92:9–20; Tr. Ex. 127.) However, instead of consulting
11 an attorney or trying to reach out to SDCC’s legal team, DFP continued to use “Comic
12 Con” in their event name. (*Id.* at 92:13–23.) Moreover, within a week of receiving the cease
13 and desist letter and with full knowledge of SDCC’s trademark registrations, DFP sought
14 and successfully registered their Salt Lake Comic Con mark with the USPTO. (Doc. No.
15 304-1 at 2.) The Court finds DFP’s foregoing reactions to be both factually and legally
16 unreasonable.

17 DFP asserts that since the jury sided with them on willfulness, the Court may not
18 reach a different result by applying the same stipulated definition of willfulness to the same
19 body of evidence and return a different result. (Doc. No. 512 at 13.) DFP then asserts that
20 willfulness in the trademark infringement context is the same as “motivation” under §
21 1117(a). (*Id.* at 12–13.) The Court disagrees.

22 First, DFP’s assertion that the definition of “willfulness” mirrors “motivation” is
23 completely unsupported. This is simply a legal theory conjured up by DFP. Second, a
24 finding of exceptionality pursuant to § 1117(a) includes examining the totality of the
25 circumstances, which includes factors such as objective unreasonableness, frivolousness,
26 compensation, deterrence, and motivation. *SunEarth, Inc.*, 839 F.3d at 1181. Thus, the
27 Court is not altering the jury’s willfulness verdict as DFP suggests. Instead, the Court is
28

1 reviewing the circumstances of this case under the lens of § 1117(a), a review process that
2 is distinct from a willfulness analysis.

3 Accordingly, the Court finds DFP’s various reactions listed above objectively
4 unreasonable pursuant to § 1117(a). *See Decus, Inc. v. Heenan*, No. 16-5849, 2018 WL
5 1082842, at *3 (E.D. Pa. Feb. 27, 2018) (“Cases finding exceptionality based on litigation
6 in an ‘unreasonable manner’ include a defendant’s continued trademark infringement after
7 it knew, through the [USPTO] and plaintiff’s cease and desist letters, its mark ‘was
8 confusingly similar’ to plaintiff’s mark[.]”); *see also Mountz, Inc. v. Northeast Indus.*
9 *Bolting and Torque, LLC*, No. 15-cv-04538-JD (MEJ), 2017 WL 780585, at *2 (N.D. Cal.
10 Jan. 27, 2017) (“Defendant’s response to the litigation, including the threats to Plaintiff’s
11 business, the attempt to register the offending mark with the PTO, and the failure to respond
12 to the Complaint, was objectively unreasonable.”).

13 d. Objectively Unreasonable Litigation Conduct

14 An additional component to the Court’s analysis is DFP’s misconduct during trial.
15 SDCC places a great emphasis on this conduct, (Doc. No. 425-1 at 22–26), while DFP’s
16 opposition brief focuses the Court’s attention on SDCC’s misconduct during trial, (Doc.
17 No. 512 at 27–30). The Court finds SDCC’s assertions more persuasive.

18 At the outset, DFP’s opening statement included the following comment:

19 The fact is Comic Con is thriving. Okay. They made more money each year
20 since Salt Lake Comic Con came on the scene. They haven’t lost a single
21 customer to us . . . We’re small potatoes. They also have \$15 million in cash
22 sitting in their bank. They own a downtown office building they paid \$5 million
cash for. They’re not for-profit, but they’re the deep pocket.

23 . . .

24 So Defendants, if they have to pay even a fraction of what CCI asks would be
25 put out of business and the people of Utah would be paying for it. But they’re
also suing them individually. So they would be pushing them to bankruptcy.

26 (Doc. No. 381 at 52:12–53:24.) Referencing a party’s wealth to play off the bias of the jury
27 is clear misconduct. *See Hoffman v. Brandt*, 65 Cal. 2d 549, 552–53 (1966) (“The argument
28 was clearly error . . . a deliberate attempt by counsel to appeal to social or economic

1 prejudices of the jury, including the wealth or poverty of the litigants, is misconduct where
2 the asserted wealth or poverty is not relevant to the issues of the case.”); *see also* *Martinez*
3 *v. Dep’t of Transp.*, 238 Cal. App. 4th 559, 566 (2015) (“The law, like boxing, prohibits
4 hitting below the belt. The basic rule forbids an attorney to pander to the prejudice, passion
5 or sympathy of the jury. In more concrete terms, attorneys cannot make appeals based on
6 irrelevant financial aspects of the case such as the hardship that would be visited on a
7 defendant from a plaintiff’s verdict.”) (internal citation omitted).

8 During trial, DFP also introduced different concepts that played off of their “generic
9 ab initio” theory of defense—a defense that this Order clearly delineates was excluded at
10 summary judgment, the pre-trial conference, and motion in limine. For instance, DFP made
11 references to a “generic brand.” (Doc. No. 381 at 35:19–20.) SDCC objected to such
12 classification and the Court sustained the objection stating that it was a
13 “mischaracterization” and asked the jury to disregard the comment. (*Id.* at 35:24–36:5.)

14 DFP however did not stop in their quest to put this legally flawed notion before the
15 jury. After being admonished, DFP began referring to Comic-Con as a “national brand.”
16 (*Id.* at 39:18.) For example, during Mr. Brandenburg’s testimony, the Court had to censure
17 DFP.

18 Q. And when you said, but we are hijacking the brand, were you referring to
19 San Diego’s brand?

20 A. No, I was not.

21 Q. Whose brand were you referring to?

22 A. As you can see in the next sentence, I clarify what I was referring to was
23 the national Comic Con brand.

24 Ms. Bjurstrom: Objection, your honor.

25 The Court: Sustained. Jury will disregard the last comment.

26 Mr. Katz: I’m not sure why.

27 The Court: There is no evidence of a national comic brand, sir.

28 (Doc. No. 383 at 123:23–124:9.) Then during closing arguments, despite the Court’s
previous rulings, DFP continued to use the phrases “Comic Con circuit” and “Comic Con
Brand.” (Doc. No. 403 at 40:9–43:5.)

1 Further, DFP misstated the law. For instance, DFP argued a “substantial confusion”
2 standard instead of the likelihood of confusion test utilized by the Ninth Circuit. (*Id.* at
3 46:9–14.) Moreover, DFP constantly and repeatedly referred to SDCC’s trademark as
4 “Comic dash Con.” (Doc. No. 381 at 37:2–4 (“And you saw on the screen that Plaintiff’s
5 showed you, Comic-Dash-Con as she described each era of Comic Con.”); *Id.* at 39:11–16
6 (“In fact, in 1998, there were 30 events that called themselves Comic Con, and that’s ten
7 years before San Diego Comic Convention, or SDCC, ever applied for their mark in
8 Comic-Dash-Con alone.”).)

9 The Ninth Circuit has repeatedly emphasized that similarity of two marks is first
10 “considered in their entirety[.]” *GoTo.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 1206
11 (9th Cir. 2000). Second, “similarity is adjudged in terms of appearance, sound, and
12 meaning, and third, similarities are weighed more heavily than differences.” *Id.* (internal
13 citations omitted). Under this standard, cases from this district as well as others have held
14 that a dash or hyphen is inconsequential in determining the similarity of two marks. *See*
15 *Maxim Integrated Prods., Inc. v. Quintana*, 654 F. Supp. 2d 1024, 1031–32 (N.D. Cal.
16 2009) (placing little emphasis on the hyphen in the mark “My-iButton” when comparing
17 its similarity to “i Button”); *see also Therma-Scan, Inc., v. Thermoscan, Inc.*, 295 F.3d 623,
18 633–34 (6th Cir. 2002) (finding the dash insignificant in the mark Therma-Scan when
19 comparing its similarity to the mark Thermoscan).

20 Despite the foregoing, at trial, DFP proceeded under the belief that the dash was
21 significant in determining the similarity of their mark and SDCC’s “Comic-Con”
22 trademark. For example, DFP stated:

23 Mr. Katz: It’s Comic-Dash-Con, and their position is it’s enforceable as
24 Comic Con with nothing in between, a space, a dash. You know, they use the
25 dash when they use it alone, and they use the space when they use it with
something else.

26 . . .

27 Ms. Bjurstrom: We have Comic Con International without a dash, and we
have San Diego Comic Con International without a dash.

28 . . .

1 The Court: But as to Comic Con with the dash, does the mark cover Comic
2 Con without the dash in its plain and literal meaning?

3 Ms. Bjurstrom: Absolutely.

4 The Court: How?

5 Ms. Bjurstrom: It is. It's likely to be confusing. You don't say Comic-Hyphen-
6 con.

7 Mr. Katz: That's what we're trying to establish, that it is not likely to be
8 confusing.

9 Ms. Bjurstrom: It's the same mark.

10 The Court: So if - -

11 Ms. Bjurstrom: You look at how it looks, how it sounds, how it's perceived.
12 You don't say Comic - -

13 Mr. Katz: We disagree.

14 Ms. Bjurstrom: Please. You don't say Comic-Hyphen-Con. You don't say
15 Coca-Hyphen-Cola. You say Coca-Cola.

16 (Doc. No. 382 at 58:10–59:13.)

17 In light of the case law from this district, DFP's forceful attempts to draw the jury's
18 attention to the dash in "Comic-Con" in analyzing the similarity of the two trademarks at
19 issue is legally groundless. *See Super-Krete Int'l, Inc. v. Sadleir*, 712 F. Supp. 2d 1023,
20 1032 (C.D. Cal. 2010) ("While Defendants argue that the hyphen is significant in
21 modifying the term, this argument is contrary to the case law—and common sense.").

22 Finally, during closing argument, DFP doubled down and broke the "Golden Rule."
23 DFP's counsel stated:

24 Even if you accept the dismissive "they're just infringers, we'll get to them."
25 Okay. They've caused harm, too. What share of the harm did they cause to
26 this brand erosion that we haven't seen any measure of? So we are just asking
27 you to think critically about the evidence. Think about what it means. And
28 what it would mean to you if you were personally involved in this.

The Court: Golden Rule. Jury is not--you are not to put the jury in the place
of either party. The jury will disregard the last comment.

Mr. Katz: I apologize for that. I will state it differently.

(Doc. No. 403 at 71:2–13.) The "Golden Rule" argument, "asking the jury to put itself in
the position of the party, is improper." *Reynolds v. Gerstel*, No. 1:09-cv-00680-SAB, 2013
WL 4815788, at *5 (E.D. Cal. Sept. 9, 2013); *see also Lovett v. Union Pac. R.R. Co.*, 201

1 F.3d 1074, 1083 (8th Cir. 2000) (explaining that the Golden Rule “argument is universally
2 condemned because it encourages the jury to depart from neutrality and to decide the case
3 on the basis of personal interest and bias rather than on the evidence.”) (citation omitted).

4 In sum, DFP’s trial misconduct further supports the Court’s conclusion that this case
5 is “exceptional” pursuant to § 1117(a).

6 *iv. Remaining Issues*

7 One additional factor in determining the exceptionality of a case under the Lanham
8 Act is the substantive strength of a party’s litigating position. *See Veracode*, 137 F. Supp.
9 3d at 101. SDCC points to the following pieces of evidence to demonstrate the strength of
10 its case: (1) the incontestable status of its trademarks; (2) its trademark survey that
11 demonstrated that 83% of consumers recognize it as a brand; (3) Mr. Brandenburg’s
12 admission that Comic-Con is a brand; and (4) the commercial strength of its marks. (Doc.
13 No. 425-1 at 11–12.) In opposition, DFP argues that their case is equally strong. (Doc. No.
14 512 at 9–10.)

15 The Court finds that this case is not so “deeply lopsided” in regards to strength to
16 warrant finding it exceptional under this specific factor. *See Veracode, Inc.*, 137 F. Supp.
17 3d at 101 (holding that a case must present the “indicia of a deeply lopsided case” for the
18 moving party to satisfy this element). The Court explicates that though SDCC’s case is
19 compelling and heavily supported by persuasive evidence, DFP’s case, including the
20 evidence of over one hundred comic events using “comic con” in their event name, is not
21 objectively frivolous.

22 Thus, this factor weighs neutrally. *See Gametek LLC v. Zynga, Inc.*, No. CV 13-2546
23 RS, 2014 WL 4351414, at *3 (N.D. Cal. Sept. 2, 2014) (explaining that although the
24 opposing party’s briefing “consisted of granular parsing of the claimed steps rather than
25 any substantive explanation of how this differed from the underlying abstract idea[,] [i]t
26 did not . . . descend to the level of frivolous argument or objective unreasonableness.”).

27 Next, the Court turns to SDCC’s argument that DFP’s abuse of the media makes this
28 case “exceptional.” (Doc. No. 425-1 at 7, 8, 14–15.) Specifically, SDCC takes issue with

1 the press releases and interviews DFP gave after they received SDCC’s cease and desist
2 letter, their articles published through social media that attacked SDCC and its executives,
3 and DFP’s alleged “public bullying strategy” that persisted over three years all aimed at
4 denigrating SDCC before the public. (*Id.*) DFP asserts that they cannot be punished for
5 exercising their First Amendment rights. (Doc. No. 512 at 15–16.)

6 The Court’s analysis under this factor is best explained by quoting to Defendant
7 Brandenburg himself. In a news article, Mr. Brandenburg explained his reaction to
8 receiving SDCC’s cease and desist letter:

9 “Our knee jerk reaction was that [SDCC was] trying to intimidate us” . . . “We
10 were not going to cease and desist using the name. We decided to go public
11 about it.” After consulting with their lawyers, the team behind the Salt Lake
12 Comic Con knew they had strong legal ground to stand on, but they didn’t
13 want to go to court, they wanted to win in the court of public opinion . . .
14 “Everyone said that San Diego had no leg to stand on, but the only way to win
15 this would be to outspend them on legal fees” . . . “Our strategy was, if we
16 are going to spend legal fees vs. legal fees, we wanted to be creative. We put
17 it out to the public, challenging the cease and desist letter publically.”

18 (Doc. No. 126-3 at 2–3.)

19 Refusing to cease and desist and turning to the media to litigate a trademark
20 infringement case in the court of “public opinion” is objectively irrational. The Court
21 clarifies that it is not maintaining that Mr. Brandenburg was not entitled to his First
22 Amendment rights. Instead, looking to the standard proscribed by the Ninth Circuit,
23 objectively, DFP’s reaction and actions in response to SDCC’s cease and desist letter force
24 this case to stand out from others. Nevertheless, the Court notes that this argument is but
25 one small factor in this Order’s analysis. In fact, even without this element, the
26 circumstances discussed *supra* pp. 7–18 adequately and reasonably justify SDCC’s request
27 for attorneys’ fees pursuant to § 1117(a).

28 Finally, DFP’s opposition brief is littered with statements such as: “The jury
disagreed; but in finding no willfulness, the jury accepted DFP’s explanation that when the
defendants used the term ‘brand,’ they were referring to *that* goodwill, the goodwill of the

1 events.” (Doc. No. 512 at 11.) These blatant, unsupported statements are plainly specious—
2 DFP has no idea what the jury believed or how they understood the evidence. Thus, the
3 Court ignored such statements in coming to its conclusion.

4 **v. Conclusion**

5 SDCC’s motion is bursting at the seams with incidents that it believes demonstrates
6 the exceptional nature of this case. After careful consideration of the totality of the
7 circumstances, the Court agrees with SDCC and finds that it has satisfied its burden.
8 Accordingly, the Court **GRANTS** SDCC’s motion for attorneys’ fees and costs, subject to
9 the deductions delineated below. *See Kilopass Tech. Inc. v. Sidense Corp.*, No. C 10-02066
10 SI, 2014 WL 3956703, at *10–14 (N.D. Cal. Aug. 12, 2014) (concluding that the case was
11 exceptional based on the defendant’s “exceptionally meritless” claims, the unreasonable
12 manner in which the case was litigated, the defendant’s shifting theories of infringement,
13 and conduct that amounted to gamesmanship).

14 **B. SDCC’s Requested Fees are Subject to Deductions**

15 SDCC argues that its fees and the allocated time spent are reasonable. (Doc. No.
16 425-1 at 27–29.) DFP’s opposition brief devotes the last two pages to arguing that
17 bifurcation is proper in the instant matter as they could not “fully respond to both liability
18 *and* the proper amount of any award” in their opposition brief. (Doc. No. 512 at 30.) DFP
19 then requests that an additional proceeding be had on the amount. (*Id.*)

20 The Court declines DFP’s request for bifurcation and for a further proceeding. DFP
21 was provided the opportunity to oppose SDCC’s motion. Their decision to forego the
22 chance to rebut the rates of SDCC’s attorneys and the reasonableness of their time sheets,
23 not only fails to satisfy their burden at this stage of the litigation, but also acts as a waiver
24 to any arguments not presented in their opposition brief. *See Stichting Pensioenfonds ABP*
25 *v. Countrywide Fin. Corp.*, 802 F. Supp. 2d 1125, 1132 (C.D. Cal. 2011) (“In most
26 circumstances, failure to respond in an opposition brief to an argument put forward in an
27 opening brief constitutes waiver or abandonment in regard to the uncontested issue.”)
28 (citation omitted).

1 Moreover, as DFP has failed to challenge or dispute SDCC’s hourly rate or provide
2 substantial assertions opposing SDCC’s hours logged, the Court’s inquiry ends after it
3 determines whether the fee request is reasonable. *See United States v. \$28,000.00 in U.S.*
4 *Currency*, 802 F.3d 1100, 1105 (9th Cir. 2015) (“When ... a fee target has failed to offer
5 either countervailing evidence or persuasive argumentation in support of its position, we
6 do not think it is the court’s job either to do the target’s homework or to take heroic
7 measures aimed at salvaging the target from the predictable consequences of self-indulgent
8 lassitude.”) (citation omitted).

9 The Court now turns to an evaluation of the reasonableness of SDCC’s fees. Courts
10 typically determine reasonableness by conducting a lodestar analysis of the hours expended
11 and the hourly rate charged. *See McGrath v. Cty. of Nevada*, 67 F.3d 248, 252 (9th Cir.
12 1995); *see also Camacho v. Bridgeport Fin., Inc.*, 523 F.3d 973, 978 (9th Cir. 2008)
13 (explaining that in the Ninth Circuit, courts calculate an award of attorneys’ fees using the
14 lodestar method, multiplying “the number of hours the prevailing party reasonably
15 expended on the litigation by a reasonable hourly rate.”) (citation omitted). The burden is
16 on the fee applicant to demonstrate that the number of hours spent were “reasonably
17 expended” and that counsel made a “good faith effort to exclude from [the] fee request
18 hours that are excessive, redundant, or otherwise unnecessary[.]” *Hensley*, 461 U.S. at 434.
19 The district court has broad discretion in determining the reasonableness of attorney’s fees.
20 *See Gates v. Deukmejian*, 987 F.2d 1392, 1398 (9th Cir. 1992).

21 Additionally, “[a]lthough in most cases, the lodestar figure is presumptively a
22 reasonable fee award, the district court may, if circumstances warrant, adjust the lodestar
23 to account for other factors which are not subsumed within it.” *Ferland v. Conrad Credit*
24 *Corp.*, 244 F.3d 1145, 1149 n.4 (9th Cir. 2001). The factors are:

- 25 (1) the time and labor required, (2) the novelty and difficulty of the questions
26 involved, (3) the skill requisite to perform the legal service properly, (4) the
27 preclusion of other employment by the attorney due to acceptance of the case,
28 (5) the customary fee, (6) whether the fee is fixed or contingent, (7) time
limitations imposed by the client or the circumstances, (8) the amount

1 involved and the results obtained, (9) the experience, reputation, and ability
2 of the attorneys, (10) the “undesirability” of the case, (11) the nature and
3 length of the professional relationship with the client, and (12) awards in
4 similar cases.

5 *Ballen v. City of Redmond*, 466 F.3d 736, 746 (9th Cir. 2006) (citation omitted).

6 In total, SDCC requests \$4,994,245.20 in attorneys’ fees and costs incurred by it
7 from the inception of this case through August 10, 2018. (Doc. No. 527 ¶ 5.) In addition,
8 SDCC also requests certain non-taxable costs, including \$243,833.06 that SDCC paid to
9 its two expert witnesses: Matthew G. Ezell and Patrick Kennedy, along with their
10 assistants. (Doc. No. 425-3 ¶ 24.)

11 *i. Reasonable Hourly Rate*

12 The determination of reasonable hourly rates is made by examining the prevailing
13 market rates in the relevant community charged for similar services by “lawyers of
14 reasonably comparable skill, experience, and reputation.” *Davis v. City and Cty. of San*
15 *Francisco*, 976 F.2d 1536, 1546 (9th Cir. 1992) (citation omitted), *opinion vacated on*
16 *other grounds by* 984 F.2d 345 (9th Cir. 1993). The “relevant community” for these
17 purposes is the district in which the lawsuit proceeds. *Barjon v. Dalton*, 132 F.3d 496, 500
18 (9th Cir. 1997).

19 The moving party has the burden to produce “satisfactory evidence, in addition to
20 the affidavits of its counsel, that the requested rates are in line with those prevailing in the
21 community for similar services of lawyers of reasonably comparable skill and reputation.”
22 *Jordan v. Multnomah Cty.*, 815 F.2d 1258, 1263 (9th Cir. 1987). Once the fee applicant
23 has met its burden, the opposing party “has a burden of rebuttal that requires submission
24 of evidence to the district court challenging the accuracy and reasonableness of the hours
25 charged or the facts asserted by the prevailing party in its submitted affidavits.” *Gates*, 987
26 F.2d at 1397–98.

27 SDCC cites to several Southern District of California cases as well as employs the
28 declarations of Callie A. Bjurstrom and Peter K. Hahn to illustrate that its attorney rates

1 are reasonable. The following are the rates for the SDCC attorneys, paralegals, and
2 litigation support team members who worked on the present matter.

- 3 1. Callie A. Bjurstrom, lead trial attorney with over twenty-nine years of experience—
4 \$675.00 to \$760.00 an hour.
- 5 2. Peter K. Hahn, a partner and member of Pillsbury’s Intellectual Property (“IP”)
6 Section with over twenty-eight years of experience—\$675.00 to \$760.00 an hour.
- 7 3. Michelle A. Herrera, an attorney with over sixteen years of litigation experience—
8 \$525.00 to \$585.00 an hour.
- 9 4. Conor Civins, a partner with over fourteen years of experience—\$550.00 to \$685.00
10 an hour.
- 11 5. Kirsten Gallacher, an associate in Pillsbury’s IP section—\$385.00 to \$545.00 an
12 hour.
- 13 6. Nathaniel Smith, a University of San Diego School of Law 2007 graduate—\$550.00
14 to \$730.00 an hour.
- 15 7. Matthew Stephens, an associate in Pillsbury’s IP Section—\$545.00 an hour.
- 16 8. Tim Rawson, a 2014 Pepperdine University School of Law graduate—\$545.00 an
17 hour.
- 18 9. Lauren Wardle, an associate in Pillsbury’s IP Section—\$560.00 an hour.
- 19 10. David Stanton, a partner and member of Pillsbury’s Litigation section—\$765.00 an
20 hour.
- 21 11. Andrew Chevalier, William Collier, Carl DiCarlo, Benton McDonough, Wilton
22 McNair, Allison Porter, Candes Prewitt, Jennifer Romeo, Kelly Sims, Jenny
23 Villalobos, Eboni Wooden, and Calumn Yeaman, contract attorneys who work out
24 of Pillsbury’s office in Nashville, Tennessee who assisted with eDiscovery,
25 document review, and legal research—\$110.00 an hour.
- 26 12. Sandra Edge, a senior legal analyst in Pillsbury’s IP Section with over thirty years
27 of experience—\$285.00 to \$315.00.
- 28 13. Cody Gartman, a trial paralegal with over seven years of experience—\$245.00 an

1 hour.

2 14. Louie Perez, a senior legal analyst in Pillsbury’s IP section with over five years of
3 experience—\$295.00.

4 15. Colin Drake, a Litigation Support Project Management Coordinator with over ten
5 years of experience—\$275.00 to \$305.00 an hour.

6 16. Val Trinidad, a Senior Litigation Support Analyst with over nine years of
7 experience—\$295.00 to \$305.00 an hour.

8 17. John Monarrez, a Research Specialist—\$150.00 an hour.

9 18. Stacey Barnes, a paralegal in Pillsbury’s IP section—335.00 an hour.

10 19. Martin Bridges, a consulting manager in Pillsbury’s Corporate Securities Group
11 whose testimony was read into the record at trial—\$425.00 an hour.

12 20. Thomas Brooks, the Discovery Project Manager—\$305.00 an hour.

13 21. Stacey Campbell, a paralegal in Pillsbury’s IP section who provided trial
14 preparation support—\$285.00 an hour.

15 22. John Farahjood, a Litigation Support Specialist who assisted with review of
16 electronically stored information—\$305.00 an hour.

17 23. Gordon Moffat, Director of Litigation Support Services—\$390.00 an hour.

18 24. Patrick Ng, a Litigation Support Project Manager—\$305.00 an hour.

19 25. Anthony Vugrinecz, a Senior Litigation Support Analyst—\$299.42 an hour.

20 (Doc. No. 425-3 ¶¶ 2–16; Doc. Nos. 527-2, 530.)

21 Ultimately, the Court finds that SDCC has satisfied its initial burden and guided the
22 Court as to the reasonable hourly rate prevailing in the community for similar work
23 performed by attorneys of comparable skill and reputation. *See Chalmers v. City of Los*
24 *Angeles*, 796 F.2d 1205, 1210 (9th Cir. 1986). First, as to the two cases provided by SDCC,
25 the hourly rates determined to be reasonable were \$607.50 for Ms. Bjurstrom, \$472.50 for
26 Ms. Herrera, (Doc. No. 425-4 at 17), and \$630 an hour for a partner and \$495 an hour for
27 an associate, (*Id.* at 24). The remainder of the cases cited to by SDCC demonstrate that
28 rates for attorneys in the intellectual property division have earned upwards of \$800.00 an

1 hour. *See Zest IP Holdings, LLC v. Implant Direct Mfg., LLC*, No. 10-CV-0541-GPC
2 (WVG), 2014 WL 6851612, at *5–6 (S.D. Cal. Dec. 3, 2014) (finding rates reasonable
3 where plaintiffs sought “an hourly rate of between \$170 per hour and \$895 per hour
4 depending on the particular attorney or paralegal” for work by a “multi-state/national law
5 firm”). Thus, based off the cases delineated above, the Court finds SDCC’s unopposed
6 attorneys’ rates listed *supra* pp. 23–24 reasonable.

7 The Court notes that DFP’s response to SDCC’s supplemental fee brief argues that
8 SDCC has not justified its lawyers’ hefty year-over-year rate increases. (Doc. No. 532 at
9 6.) DFP then requests that the Court should substantially lower rates in calculating the
10 lodestar. (*Id.* at 7.) This argument is nonsensical. DFP produces no rational justification for
11 why SDCC’s lawyers should not receive raises each year they progress within their firm.
12 Moreover, DFP’s conclusory arguments, unsupported by evidence or case law, do not
13 satisfy their burden of rebuttal.

14 Next as to the paralegal rates, SDCC fails to provide any case law to support the
15 rates of its paralegals and litigation support team members.⁶ *See Blum v. Stenson*, 465 U.S.
16 886, 895 n.11 (1984) (“To inform and assist the court in the exercise of its discretion, the
17 burden is on the fee applicant to produce satisfactory evidence—in addition to the
18 attorney’s own affidavits—that the requested rates are in line with those prevailing in the
19 community for similar services”). Nevertheless, the Court may consider SDCC’s
20 declaration in addition to similar cases and its own knowledge and familiarity with the
21 Southern District of California legal market in setting a reasonable hourly rate. *See Ingram*
22 *v. Oroudjian*, 647 F.3d 925, 928 (9th Cir. 2011).

23 Reasonable rates for paralegals in this district have ranged from \$125 to \$225. *See*
24 *In re Maxwell Techs., Inc., Derivative Litig.*, No. 13CV966 BEN (RBB), 2015 WL
25 12791166, at *5 (S.D. Cal. July 13, 2015) (awarding \$225 paralegal rate to paralegals with
26

27 ⁶ For purposes of this Order, the Court will group SDCC’s paralegals, legal analysts,
28 litigation support team members, and research specialists into one group.

1 “significant experience”); *see also Flowrider Surf, Ltd. v. Pac Surf Designs, Inc.*, No.
2 15cv1879-BEN (BLM), 2017 WL 2212029, at *2–3 (S.D. Cal. May 18, 2017) (awarding
3 paralegal fees of \$150 per hour in a patent infringement case); *LG Corp. v. Huang Xiaowen*,
4 No. 16-CV-1162-JLS (NLS), 2017 WL 3877741, at *3 (S.D. Cal. Sept. 5, 2017) (finding
5 reasonable a rate of \$225 per hour for a paralegal with over twenty years of experience).
6 At its highest, this district has approved a paralegal rate of \$290.00. *See In re Maxwell*
7 *Techs., Inc.*, 2015 WL 12791166, at *5.

8 Pillsbury is an American Lawyer Top 100 law firm with its IP litigation practice
9 named in the Best Lawyers in America for 2017. (Doc. No. 425-3 ¶ 17.) Thus, the Court
10 does not dispute the quality of the work Pillsbury’s paralegals provided. However, SDCC
11 has failed to produce evidence to demonstrate that its paralegal rates of over \$300.00 an
12 hour are reasonable. Accordingly, taking into consideration Pillsbury’s national and global
13 presence, the Court will cap SDCC’s paralegal, legal analysts, and litigation support team
14 members’ hourly rates at \$290.00—the high end of paralegal rates provided by this district.
15 *See Carr v. Tadin, Inc.*, 51 F. Supp. 3d 970, 981 (S.D. Cal. 2014) (listing paralegal rates
16 that ranged from \$110.00 to \$295.00, but concluding that as rates of \$125–\$150
17 predominated, a \$150.00 per hour rate for paralegals was reasonable). The final award will
18 be adjusted in light of the above mentioned modification.

19 In sum, the Court finds SDCC’s attorneys’ rates in this case reasonable—these rates
20 were largely unopposed by DFP. The paralegals and litigation support team members with
21 rates over \$290.00 an hour will be capped at \$290.00. The remainder of the paralegal rates
22 that do not exceed \$290.00 are considered reasonable.

23 ***ii. Hours Reasonably Spent***

24 “The moving party bears the burden of documenting the appropriate hours spent in
25 the litigation and submitting evidence in support of the hours worked.” *Zest IP Holdings*,
26 2014 WL 6851612, at *6. After the moving party provides evidence of the hours billed, the
27 opposing party has the burden of submitting evidence “challenging the accuracy and
28 reasonableness of the hours charged or the facts asserted by the prevailing party in its

1 submitted affidavits.” *Gates*, 987 F.2d at 1398. “Even if the opposing party has not objected
2 to the time billed, the district court ‘may not uncritically accept a fee request,’ but is
3 obligated to review the time billed and assess whether it is reasonable in light of the work
4 performed and the context of the case.” *Rodriguez v. Barrita, Inc.*, 53 F. Supp. 3d 1268,
5 1280 (N.D. Cal. 2014).

6 District courts have discretion to reduce the number of hours that were not
7 reasonably expended. *Hensley*, 461 U.S. at 434. When determining whether the number of
8 hours expended is reasonable, the following criterion may be taken into account, but each
9 factor cannot be an independent basis to reduce hours: “(1) the novelty and complexity of
10 the issues, (2) the special skill and experience of counsel, (3) the quality of representation,
11 and (4) the results obtained.” *Cabrales v. Cty. of Los Angeles*, 864 F.2d 1454, 1464 (9th
12 Cir. 1988) (citation omitted), *judgment vacated on other grounds by* 490 U.S. 1087 (1989).

13 SDCC requests all hours billed from the inception of this case to August 10, 2018.
14 (Doc. No. 527 ¶¶ 3, 4.) In analyzing reasonableness, the Court first notes that DFP requests
15 a deduction for quarter-hour billing. (Doc. No. 512 at 30.) Courts have recognized that
16 billing by the quarter-hour, not by the tenth is a “deficient” practice “because it does not
17 reasonably reflect the number of hours actually worked.” *See Zucker v. Occidental*
18 *Petroleum Corp.*, 968 F. Supp. 1396, 1403 n.11 (C.D. Cal. 1997) (demonstrating that an
19 attorney with a \$300 hourly rate who works six minutes on a matter would charge \$30 if
20 he bills by the tenth of an hour and \$75 if he bills by the quarter hour). Due to this, courts
21 have reduced the fee award by a percentage to account for the unearned increment based
22 on quarter-hour billing. *See Preseault v. United States*, 52 Fed. Cl. 667, 680–81 (Fed. Cl.
23 2002). In the present case, the Court in its discretion reduces SDCC’s attorneys’ fee award
24 by twenty percent to account for the practice of billing by the quarter-hour. *See Zest IP*
25 *Holdings*, 2014 WL 6851612, at *10 n.2 (taking a 20% overall reduction in fees based on
26 quarter-hour billing).

27 DFP also briefly asserts that a reduction is appropriate as SDCC failed to delegate
28 tasks to staff or colleagues with lower billing rates. (Doc. No. 512 at 30–31.) The Court

1 disagrees. As SDCC's time sheet demonstrates, the senior attorneys such as Ms. Herrera,
2 Ms. Bjurstrom, and Mr. Hahn were mainly in charge of researching and drafting the
3 dispositive motions in this case as well as settlement and discovery matters. (Doc. No. 507
4 at 23, 29.) It is only logical to have the more senior attorneys personally involved in these
5 major parts of the litigation process. Moreover, the timesheet demonstrates that SDCC did
6 in fact delegate other more basic legal tasks to associate attorneys with lower billing rates
7 such as Lauren Wardle and Tim Rawson. (Doc. No. 507 at 102, 103, 105, 159, 163.)

8 The Court notes however that it finds that some tasks were not properly delegated
9 amongst SDCC's paralegal and litigation support team members. For example, on June 7,
10 2017, John Farahjood was given the task of printing redacted PDF files. Printing files is
11 not a reasonable use of a litigation support specialist who has a rate of \$305.00 an hour.
12 (Doc. No. 507 at 122 (*see Banas v. Volcano Corp.*, 47 F. Supp. 3d 957, 970 (N.D. Cal.
13 Dec. 12, 2014).) Thus, a reduction in the final lodestar amount is warranted.

14 Finally, DFP spends a sentence broadly concluding that SDCC's task descriptions
15 are highly general and frequently redacted and therefore warrant closer scrutiny. (Doc. No.
16 512 at 30.) First, as to the redactions, "[a] party seeking fees may redact certain portions of
17 the relevant time entries when doing so is necessary to protect the attorney client privilege,
18 so long as the unredacted portions still afford[] the Court sufficient detail to determine the
19 reasonableness of the hours requested." *Shame on You Productions, Inc. v. Banks*, CV 14-
20 03512-MMM (JCx), 2016 WL 5929245, at *16 (C.D. Cal. Aug. 15, 2016) (citation and
21 internal quotation marks omitted).

22 The Court notes that there are certain time entries that have been so heavily redacted
23 that the Court cannot assess the reasonableness of the time expended. For example on
24 August 6, 2017, Michelle Herrera stated "Research regarding [REDACTED]." (Doc. No.
25 507 at 150.) This type of redaction has resulted in courts declining to award fees as to those
26 heavily redacted billing entries. *See Shame on You Productions*, 2016 WL 5929245, at *16.
27 However, in the instant matter, SDCC redacted time entries, but also made the entries
28 available to the Court for in-camera review. (Doc. No. 425-3 ¶ 23.) Thus, DFP's attack on

1 SDCC’s redacted time entries fails. *See Vogel v. Tulaphorn*, CV 13-464 PSG (PLAx), 2014
2 WL 12629679, at *10 (C.D. Cal. Jan. 30, 2014) (refusing to reject the defendant’s request
3 for fees as it willingly stated that it could provide the redacted entries for in-camera
4 review); *see also R.M. v. Encinitas Union Sch. Dist.*, No. 08cv412-L (JMA), 2013 WL
5 3873069, at *3 (S.D. Cal. July 25, 2013) (conducting an in-camera review of the
6 defendant’s invoice to determine reasonableness).

7 Next, as to DFP’s assertion that the time entries are too general, the Court agrees in
8 part. Though, SDCC’s counsel “is not required to record in great detail how each minute
9 of his [or her] time was expended,” *Lytle v. Carl*, 382 F.3d 978, 989 (9th Cir. 2004), a
10 certain amount of specificity is required. Presently, some entries are incredibly vague. For
11 instance, there are several entries that simply state in some form: “Assist with review
12 project.” (Doc. No. 507 at 121, 122, 124, 136.) Additionally, on October 28, 2016, the time
13 entry states: “Call with S. Edge regarding additional documents for review and review
14 plan,” (*Id.* at 61), and on November 29, 2016, the narrative described states: “Document
15 review,” (*Id.* at 67). This is a billing deficiency that justifies a reduction.

16 In that same vein the Court also reduces the amount of hours SDCC requests for
17 duplicative attorney effort. Although it has been recognized that “the participation of more
18 than one attorney does not necessarily constitute an unnecessary duplication of effort[,] *see*
19 *McGrath*, 67 F.3d at 255, the Court believes that certain hours were not reasonably
20 expended. For example in July of 2017, Mr. Hahn, Ms. Herrera, and Mr. Smith all took
21 turns revising a sanctions motion. (Doc. No. 507 at 136.) Similarly, in that same month,
22 Mr. Hahn, Mr. Smith, Mr. Stephens, Ms. Bjurstrom, and Ms. Herrera all billed for
23 reviewing the opposition brief to DFP’s motion for leave to amend the pleading. (*Id.* at
24 140.) Thus, another reduction in the lodestar figure is appropriate. *See Mogck v. Unum Life*
25 *Ins. Co. of Am.*, 289 F. Supp. 2d 1181, 1195 (S.D. Cal. 2003) (finding a reduction of fees
26 reasonable as both attorneys billed for reviewing the defendant’s objection and two
27 attorneys billed for reviewing the Ninth Circuit opinion in the case); *see also Hensley*, 461
28 U.S. at 432–34 (holding that counsel submitting fee applications must exclude hours that

1 are “excessive, redundant, or otherwise unnecessary[.]”); *AT&T Mobility LLC v. Yeager*,
 2 No. 2:13-cv-00007 KJM DB, 2018 WL 1567819, at *2 (E.D. Cal. Mar. 30, 2018)
 3 (highlighting that the court has broad discretion to adjust the lodestar fee downward if it
 4 concludes the attorneys performed work that was excessive or duplicative).

5 Finally, the Court addresses the arguments present in DFP’s response to SDCC’s
 6 supplemental brief. (Doc. No. 532.) Finding that most of DFP’s qualms have already been
 7 addressed above, the Court focuses solely on the assertion that a reduction is justified based
 8 on overstaffing. (*Id.* at 4.) Here, the Court agrees with DFP that SDCC’s decision to send
 9 three lawyers to the post-trial motion hearing is an unreasonable use of time. As Mr. Hahn
 10 did not actively participate at the hearing, the Court will not award Mr. Hahn’s fees totaling
 11 \$3,532.50 in relation to this matter. (Doc. No. 527-1 at 15.)

12 In sum, the Court reduces SDCC’s fee request by 20% for quarter-hour billing.
 13 Additionally, based on the other billing deficiencies delineated above, an additional 5%
 14 reduction is warranted as well as a reduction of \$3,532.50 for overstaffing. As to the
 15 remainder of the hours, after an in-camera review, the Court finds the billed hours are well
 16 within the bounds of reason and include sufficient descriptions reflecting the date, amount,
 17 and nature of the work SDCC’s attorney’s performed. *See LG Corp.*, 2017 WL 3877741,
 18 at *4. Thus, the Court finds no further deduction necessary based on the nature and context
 19 of the case, quality of the representation, and result obtained.

20 *iii. Lodestar Calculation*

21 **Table 1: Hourly**
 22 **Rates**
 23 **2014**

24 Timekeeper	Hourly Rate Billed	Hourly Rate Awarded	Time Billed
25 Bjurstrom, Callie A.	\$675.00	\$675.00	24.05 hours
26 Hahn, Peter K.	\$675.00	\$675.00	89 hours
27 Herrera, Michelle A.	\$525.00	\$525.00	41.20 hours

28

Drake, Colin B.	\$275.00	\$275.00	0.50 hours
Edge, Sandra V.	\$285.00	\$285.00	19.25 hours

Table 2: Hourly Rates 2015			
Timekeeper	Hourly Rate Billed	Hourly Rate Awarded	Time Billed
Bjurstrom, Callie A.	\$705.00	\$705.00	24 hours
Gallacher, Kirsten F.	\$385.00	\$385.00	10.25 hours
Hahn, Peter K.	\$705.00	\$705.00	174 hours
Herrera, Michelle A.	\$550.00	\$550.00	72 hours
Drake, Colin B.	\$290.00	\$290.00	5.25 hours
Edge, Sandra V.	\$295.00	\$290.00	21.50 hours

Table 3- Hourly Rates 2016			
Timekeeper	Hourly Rate Billed	Hourly Rate Awarded	Time Billed
Bjurstrom, Callie A.	\$735.00	\$735.00	93.25 hours
Gallacher, Kirsten F.	\$480.00	\$480.00	98.75 hours
Hahn, Peter K.	\$735.00	\$735.00	480.75 hours
Herrera, Michelle A.	\$565.00	\$565.00	229.50 hours
Stanton, David	\$765.00	\$765.00	0.25 hours
Drake, Colin B.	\$295.00	\$290.00	16.50 hours
Edge, Sandra V.	\$305.00	\$290.00	172.50 hours
Trinidad, Val	\$295.00	\$290.00	6.25 hours

Table 4-Hourly Rates 2017			
Timekeeper	Hourly Rate Billed	Hourly Rate Awarded	Time Billed
Bjurstrom, Callie A.	\$760.00	\$760.00	1085 hours
Chevalier, Andrew	\$110.00	\$110.00	85.25
Civins, Conor M.	\$608.16	\$608.16	283.75 hours
Collier, William E.	\$110.00	\$110.0	167.50 hours
DiCarlo, Carl	\$110.00	\$110.00	205.50 hours
Gallacher, Kirsten F.	\$545.00	\$545.00	119 hours
Hahn, Peter K.	\$760.00	\$760.00	1422.75 hours
Herrera, Michelle A.	\$585.00	\$585.00	967.55 hours
McDonough, Benton	\$110.00	\$110.00	88.25 hours
McNair, Wilton A.	\$110.00	\$110.00	85.75 hours
Porter, Allison	\$110.00	\$110.00	69 hours
Prewitt, Candes V.	\$110.00	\$110.00	81.75 hours
Rawson, P.E., Tim	\$485.35	\$485.35	50.25 hours
Romeo, Jennifer R.	\$110.00	\$110.00	123.25 hours
Sims, Kelly J.	\$110.00	\$110.00	184.75 hours
Smith, Nathaniel R.	\$578.42	\$578.42	45.00 hours
Stanton, David	\$790.00	\$790.00	12.75 hours
Stephens, Matthew R.	\$545.00	\$545.00	200.75 hours
Villalobos, Jenny R.	\$110.00	\$110.00	167.25 hours
Wardle, Lauren E.	\$560.00	\$560.00	145.45 hours

1	Wooden, Eboni T.	\$110.00	\$110.00	141.75 hours
2	Yeaman, Calumn J.	\$110.00	\$110.00	98.75 hours
3	Barnes, Stacey	\$335.00	\$290.00	5 hours
4	Bridges, Martin	\$425.00	\$290.00	1 hour
5	Brooks, Thomas	\$305.00	\$290.00	1 hour
6	Campbell, Stacey	\$285.00	\$285.00	7.25 hours
7	Drake, Colin B.	\$305.00	\$290.00	89 hours
8	Edge, Sandra V.	\$315.00	\$290.00	1,195.75 hours
9	Farahjood, John	\$305.00	\$290.00	17 hours
10	Gartman, Cody A.	\$245.00	\$245.00	224.80 hours
11	Moffat, Gordon	\$390.00	\$290.00	15.75 hours
12	Monarrez, John D.	\$150.00	\$150.00	12.75 hours
13	Ng, Patrick	\$305.00	\$290.00	0.50 hours
14	Perez, Louie	\$295.00	\$290.00	120.25 hours
15	Trinidad, Val	\$300.63	\$290.00	151 hours
16	Vugrinecz, J.	\$299.42	\$290.00	18.75 hours
17	Anthony			
18				

19	Table 5-Hourly			
20	Rates			
21	2018			
22	Timekeeper	Hourly Rate Billed	Hourly Rate Awarded	Time Billed
23	Bjurstrom, Callie A.	\$795.00	\$795.00	221.70 hours
24	Civins, Conor M.	\$675.00	\$675.00	14.25 hours
25	Hahn, Peter K.	\$785.00	\$785.00	221 hours
26	Herrera, Michelle A.	\$605.00	\$605.00	330.30 hours
27	Wardle, Lauren E.	\$615.00	\$615.00	120.75 hours
28				

1	Edge, Sandra V.	\$325.00	\$290.00	143.95 hours
2	Monarrez, John D.	\$300.00	\$290.00	0.25 hours

3
4 SDCC requests **\$4,994,245.20** in attorneys' fees and costs. (Doc. No. 527 ¶ 5.) The
5 Court notes however, that the lodestar number based off of the declarations provided by
6 SDCC is **\$5,278,438.88**. This discrepancy is due to the fact that the lodestar number does
7 not include courtesy discounts that occurred in March 2017 (\$11,000), April 2017
8 (\$30,000), May 2017 (\$30,000), June 2017 (\$50,000), July 2017 (\$20,000), August 2017
9 (\$25,000), September 2017 (\$25,000), October 2017 (\$30,000), November 2017
10 (\$55,000), December 2017 (\$20,000), January 2018 (\$10,000), and February 2018
11 (\$10,000). In total, SDCC provided **\$316,000** in courtesy discounts. Subtracting the
12 courtesy discounts, the new lodestar number is **4,962,438.88**. After the 20% reduction for
13 quarter-hour billing, the 5% reduction for other billing deficiencies, and the **\$3,532.50** for
14 overstaffing, the final lodestar number is **\$3,767,921.06**.

15 *iv. Expert Costs*

16 The Lanham Act provides that “[w]hen a violation of any right of the registrant of a
17 mark registered in the Patent and Trademark Office . . . have been established in any civil
18 action . . . the plaintiff shall be entitled to . . . (3) the costs of the action.” 15 U.S.C. §
19 1117(a). Under Federal Rule of Civil Procedure 54, costs other than attorney’s fees may
20 be allowed to the prevailing party unless a federal statute or a court order provides
21 otherwise. Fed. R. Civ. P. 54(d)(1).

22 SDCC seeks to recover certain non-taxable costs. Specifically, SDCC requests
23 **\$243,833.06** that SDCC paid to its two experts: Matthew G. Ezell and Patrick Kennedy,
24 along with their assistants. (Doc. No. 425-3 ¶ 24.) DFP does not oppose this request. (*See*
25 *generally* Doc. No. 512.)

26 Ms. Bjurstrom’s declaration delineates the various benefits and advantages provided
27 by both experts. For instance, Mr. Ezell conducted the Teflon Survey that addressed the
28 primary significance of “Comic-Con” to the public. (Doc. No. 425-3 ¶ 25.) Additionally,

1 Mr. Ezell performed substantive research and helped analyze and develop a response to the
2 report prepared by DFP’s expert Jeffrey Kaplan. (*Id.*) As to Mr. Kennedy, he was hired to
3 assess SDCC’s damage remedies and also prepared and submitted a detailed expert report
4 and supplemental report. (*Id.* ¶ 26.) Both experts’ invoices were provided to the Court.
5 (Doc. No. 425-6.)

6 It is clear from the record that Mr. Ezell’s work was critical to SDCC’s ultimate
7 success in the action—specifically to its trademark infringement claim. Thus, given the
8 reliance on Mr. Ezell and his survey, his fee of **\$92,323.56** for his work in connection with
9 this matter was reasonably necessary for the prosecution of SDCC’s case. *See SAS v.*
10 *Sawabeh Info. Servs. Co.*, No. CV 11-04147 MMM (MANx), 2015 WL 12763541, at *35
11 (C.D. Cal. June 22, 2015.) The Court will thus award **\$92,323.56** in costs.

12 In comparison, Mr. Kennedy’s necessity is less clear. Though he testified to various
13 important financial matters, his corrective advertising report stating that a brand repair
14 program would cost \$9.62 million was not well-received by the jury as evidenced by the
15 jury award of only \$20,000. (Doc. No. 234-1 at 22; Doc. No. 395 at 8.) Based on the
16 foregoing, the Court in its discretion, advances only **\$120,000.00** instead of \$151,509.50
17 as costs to cover Mr. Kennedy’s expenses. (Doc. No. 423-3 ¶ 26 (*see Brighton Collectibles,*
18 *LLC v. Believe Production, Inc.*, No. 2:15-cv-00579-CAS (ASx), 2018 WL 1381894, at *5
19 (C.D. Cal. Mar. 15, 2018)).)

20 Accordingly, the Court awards SDCC **\$212,323.56** to cover the costs of its two
21 experts. *See Lanyard Toys Ltd. v. Novelty, Inc.*, No. CV 05-8406-GW (JWJx), 2008 WL
22 11333941, at *21 (C.D. Cal. Mar. 18, 2008) (explaining that the district courts “may award
23 otherwise non-taxable costs . . .”) (citation omitted).

24 **CONCLUSION**


25 The Court has exhaustively and carefully considered the totality of the
26 circumstances in this case. Having done so, the Court finds that this case stands out when
27 compared to run of the mill trademark infringement cases. Accordingly, in its discretion,
28

1 finding this case “exceptional” pursuant to 15 U.S.C. § 1117(a), SDCC as the prevailing
2 party is awarded attorneys’ fees and costs subject to the deductions listed above.

3 It is accordingly **ORDERED** that SDCC is awarded attorneys’ fees and costs
4 totaling \$3,962,486.84.⁷ This award includes \$3,767,921.06 in attorneys’ fees and
5 \$212,323.56 in expert costs. The Clerk of Court must enter judgment for SDCC and against
6 DFP, Dan Farr an individual, and Bryan Brandenburg an individual, and each of them, in
7 this amount, as well as the \$20,000 awarded by the jury, in this case. The Clerk of Court is
8 also directed to issue the permanent injunction. As no issues remain, the Clerk is instructed
9 to **CLOSE** the docket of this case. Accordingly, SDCC’s motion for attorneys’ fees and
10 costs is **GRANTED IN PART AND DENIED IN PART**.

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12 **IT IS SO ORDERED.**

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14 Dated: April 15, 2019


15 Hon. Anthony J. Battaglia
16 United States District Judge
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26 ⁷ The Court notes that the final award was adjusted by deducting \$17,757.78 in attorneys’
27 fees that were awarded to SDCC and paid by DFP in relation to DFP’s unsuccessful motion
28 for sanctions. (Doc. Nos. 484, 522; Doc. No. 532 at 3.) The Court disagrees with DFP that
the award should be reduced by \$23,238, which is the amount SDCC initially requested.
(Doc. No. 532 at 3.)

Docket No. 599
USDC, S.D. of California
Case No. 14-cv-01865-AJB-JMA



United States District Court
SOUTHERN DISTRICT OF CALIFORNIA

San Diego Comic Convention, a
California non-profit corporation,

Plaintiff,

v.

Dan Farr Productions, a Utah limited
liability company; Daniel Farr, an
individual; (See attachment for additional
parties)

Defendant.

Civil Action No. 14-cv-01865-AJB-JMA

AMENDED

JUDGMENT IN A CIVIL CASE

Decision by Court. This action came to trial or hearing before the Court. The issues have been tried or heard and a decision has been rendered.

IT IS HEREBY ORDERED AND ADJUDGED:

The Court has exhaustively and carefully considered the totality of the circumstances in this case. Having done so, the Court finds that this case stands out when compared to run of the mill trademark infringement cases. Accordingly, in its discretion, finding this case “exceptional” pursuant to 15 U.S.C. § 1117(a), SDCC as the prevailing party is awarded attorneys’ fees and costs subject to the deductions listed above. It is accordingly ORDERED that SDCC is awarded attorneys’ fees and costs totaling \$3,962,486.84. This award includes \$3,767,921.06 in attorneys’ fees and \$212,323.56 in expert costs. Judgment is entered for SDCC and against DFP, Dan Farr an individual, and Bryan Brandenburg an individual, and each of them, in this amount, as well as the \$20,000 awarded by the jury, in this case. Permanent injunction is issued. Accordingly, SDCC’s motion for attorneys’ fees and costs is GRANTED IN PART AND DENIED IN PART.

Date: 4/15/19

CLERK OF COURT
JOHN MORRILL, Clerk of Court

By: s/ T. Ferris

T. Ferris, Deputy

United States District Court

SOUTHERN DISTRICT OF CALIFORNIA

(ATTACHMENT)

Civil Action No. 14-cv-01865-AJB-JMA

Within the structure of the present matter, the Court ISSUES the following narrowly tailored INJUNCTION in its considerable discretion. See *Church of Holy Light of Queen v. Holder*, 443 F. App'x 302, 303 (9th Cir. 2011) (emphasizing that courts enjoy “considerable discretion in fashioning suitable relief and defining the terms of an injunction[.]”) (citation omitted); see also *Orantes-Hernandez v. Thornburgh*, 919 F.2d 549, 558 (9th Cir. 1990) (holding that “[t]here are limitations on this discretion; an injunction must be narrowly tailored to give only the relief to which plaintiffs are entitled.”).

- 1) DFP is enjoined from use of SDCC’s three trademarks asserted in this case, any confusingly similar marks (i.e. Comicon or Comiccon), or any phonetic equivalents, (i.e. ComiKon or ComicKon), in the name of any comic or popular arts convention or event or in connection with the promotion, advertising, products or marketing of any comic or popular arts convention or event. This does not include referencing San Diego Comic Con or other comic conventions that use “Comic Con” in their name in advertising or marketing materials.
- 2) DFP is enjoined from the use or operation of any social media site (i.e. Facebook, Twitter, Instagram, Pinterest, or Snapchat) that incorporates into the name of any comic arts, popular fiction, or subject related event, any of SDCC’s three trademarks asserted in this case, any confusingly similar marks (i.e. Comicon or Comiccon), or any phonetic equivalents, (i.e. ComiKon or ComicKon).
- 3) DFP is enjoined from using a “formerly known as Salt Lake Comic Con” reference on any website, social media site, publicity documents, and/or advertising or marketing materials that are connected to any comic arts or popular fiction events or subject related conventions they produce.
- 4) DFP is enjoined from registering or using a domain name that incorporates any of SDCC’s three trademarks asserted in this case, any confusingly similar mark (i.e. Comicon or Comiccon) or any phonetic equivalents (i.e. ComiKon or ComicKon) in relation to any comic arts or popular fiction conventions or subject related events or in such a way that would lead consumers to believe that DFP is sponsored by or related to SDCC.
- 5) Finally, DFP is prohibited from utilizing www.saltlakecomiccon.com as a forwarding address to their www.fanxsaltlake.com website or to any subject related website.
- 6) DFP is not required to destroy all of their merchandise and all marketing materials bearing the specific word combinations “Comic Con,” “Comic- Con,” or any phonetic equivalents, so long as DFP simply wishes to maintain their “historical archive,” but not sell, distribute, donate, give away, reproduce, republish, display, depict or make any commercial use of any of these “archival materials.” If, on the other hand, there is any plan or potential future sale, distribution, donation, reproduction, republication, display, depiction or commercial use, of said materials exceeding the archival needs of DFP, then they must be destroyed consistent with this Order.

The Court retains jurisdiction to enforce the terms of this Order, injunction, and its compliance. Within thirty (30) days from the date of this Order, DFP must be in compliance with this injunction Order and file with the Court and serve on SDCC a report in writing under oath, setting forth the manner and form in which DFP has complied with the injunction order.

Thus, in sum, the Court GRANTS IN PART AND DENIES IN PART SDCC’s motion for permanent injunction. The Clerk is ordered to state the injunction terms in the judgment in this case, verbatim.

United States District Court
SOUTHERN DISTRICT OF CALIFORNIA

(ATTACHMENT)

Civil Action No. 14-cv-1865-AJB-JMA

Bryan Brandenburg, an individual,

Defendants.

Bryan Brandenburg, an individual;
Dan Farr Productions, a Utah limited liability company;
Daniel Farr, an individual,

Counter Claimant

vs.

San Diego Comic Convention, a California non-profit corporation,

Counter Defendant.