

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF INDIANA
INDIANAPOLIS DIVISION

DILLINGER, LLC,)	
<i>Plaintiff,</i>)	
)	
vs.)	1:09-cv-1236-JMS-DKL
)	
ELECTRONIC ARTS INC.,)	
<i>Defendant.</i>)	
)	

ORDER

Plaintiff brings this action against Electronic Arts, Inc. (“EA”) for allegedly using its trademarked name “Dillinger” to name weapons featured in EA’s *The Godfather* video games in violation of federal and state law. [Dkt. 1.] Plaintiff’s Complaint lists six counts, three of which (Counts I, II, and VI) have recently been dismissed. [Dkt. 222.] The three remaining claims (Counts III-V) arise under the Lanham Act and a common-law claim for unfair competition that is grounded in a prohibition against trademark misappropriation, which Plaintiff argues bars EA from using the Dillinger name in its games. [Dkt. 1 at 10-11.] Presently before the Court are the parties’ cross-motions for summary judgment on EA’s First Amendment defense to its use of the Dillinger name. [Dkt. 85; dkt. 144.]

I.
STANDARD OF REVIEW

A motion for summary judgment asks that the Court find that a trial based on the uncontroverted and admissible evidence would, as a matter of law, conclude in the moving party’s favor and is thus unnecessary. *See* Fed. R. Civ. Pro. 56(c). When evaluating a motion for summary judgment, the Court must give the non-moving party the benefit of all reasonable inferences from the evidence submitted and resolve “any doubt as to the existence of a genuine issue

for trial . . . against the moving party.” *Celotex Corp. v. Catrett*, 477 U.S. 317, 330 n.2 (1986). Nevertheless, “the Court’s favor toward the non-moving party does not extend to drawing inferences that are supported by only speculation or conjecture.” *Singer v. Raemisch*, 593 F.3d 529, 533 (7th Cir. 2010). The non-moving party must set forth specific facts showing that there is a material issue for trial and cannot rely upon the mere allegations or denials in the pleadings. Fed. R. Civ. Pro. 56(e); *Celotex*, 477 U.S. at 330. The key inquiry is the existence of evidence to support a plaintiff’s claims or a defendant’s defenses, not the weight or credibility of that evidence, both of which are assessments reserved to the trier of fact. *See Schacht v. Wis. Dep’t of Corrections*, 175 F.3d 497, 504 (7th Cir. 1999). In accordance with Rule 56(e), if a party fails to address the adverse party’s assertion of fact, the Court will consider it undisputed for the purposes of the motion.

Cross-motions for summary judgment do not automatically mean that all questions of material fact have been resolved. *Franklin v. City of Evanston*, 384 F.3d 838, 842 (7th Cir. 2004). The Court must evaluate each motion independently, making all reasonable inferences in favor of the nonmoving party with respect to each motion. *Id.* at 483.

After having assessed the claims of the parties in accordance with the standards outlined above, the Court concludes that EA is entitled to summary judgment on its First Amendment defense. Therefore, in what follows, the Court makes all reasonable factual inferences in favor of Plaintiff.

II. BACKGROUND

A) John Dillinger and his Connection with the Tommy Gun

Plaintiff claims to own the publicity rights of the “late depression-era bandit” John Dillinger, as well as the trademark rights in the words “John Dillinger.” [Dkt. 1 at ¶ 6.]

John Dillinger was a legendary gentleman-bandit, [dkt. 1 at ¶ 1]; according to the FBI, Dillinger was a “notorious and vicious thief”—a “lurid desperado” who “came to evoke the gangster era.” [Dkt. 88-2 at 39.] Indeed, during the mid-1930’s, he and his violent gang terrorized the Midwest, robbing, killing and staging jail-breaks. [*Id.*]

In addition to his glamorous life of crime, John Dillinger is commonly associated with Thompson submachine guns, also known as “Tommy Guns,” which were seized *en masse* from his hideouts by the police. [*Id.* at 40.] Plaintiff’s website thus features an iconic photograph of John Dillinger holding a Tommy Gun, [*id.* at 47], and the Tommy Gun manufacturer’s website itself calls the gun “Dillinger’s Choice.” [Dkt. 88-3 at 5; *see also* dkt. 88-3 at 10 (“Thompsons . . . were a favorite item for Public Enemy No. 1, John Dillinger.”).]

Depictions of John Dillinger in popular culture have reinforced his connection with the Tommy Gun over the years. In the 1995 movie *Dillinger and Capone*, Dillinger is featured alongside notorious mafioso Al Capone, and the former uses a Tommy gun throughout the film. [Dkt. 88-4 at 2; dkt. 88-5 at 18.] Dillinger is also depicted using Tommy guns in films including *Dillinger* (1973) and *Public Enemies* (2009). [Dkt. 88-10 at 2; dkt. 88-7 at 29.]

As EA Executive Producer Joel Wade put it, “the popular persona of John Dillinger . . . [became] this flashy gangster who dressed well, womanized, drove around in fast cars, and sprayed Tommy Guns.” [Dkt. 175 at 4.]

B) The Godfather Video Games

EA is the developer and publisher of video games, including “*The Godfather*” and “*The Godfather II*” (collectively, “Godfather games”), which were released in 2006 and 2009 respectively.

The *Godfather* games are based on Francis Ford Coppola's film adaptations of the 1969 novel, *The Godfather* ("Godfather novel"), written by Mario Puzo. [Dkt. 87 at ¶¶ 9; dkt. 1 at ¶ 1.] The novel and films portray a fictional New York mafia family, the Corleones, and in particular, the rise of Michael Corleone, who returns from World War II and ultimately replaces his father, Vito Corleone, as the leader of the Corleone family—the "Godfather." [Dkt. 87 at ¶ 9.] Among other things, the novel describes a fictional rivalry between Al Capone's Chicago-based syndicate and the Corleone family's New York-based operation. [Dkt. 88-7 at 7-9.] Both *Godfather* films include widespread use of Tommy Guns. [Dkt. 87 at ¶ 20.]

The *Godfather* games combine technically advanced software and creative audio-visual elements, which are constructed from thousands of video graphics, audio features, and data. [*Id.* at ¶ 10-11.] Both games feature an extensive musical soundtrack, sound effects, and include new dialogue, written specifically for the game. [*Id.*]

The first *Godfather* game, like the film, simulates the mafia world in New York during the mid-1900s. [*Id.* at ¶ 9.] The player acts as a member of the Corleone family, guiding this so-called "in-game character" through a variety of missions predicated on the plot of the original *Godfather* film. [*Id.* at ¶ 10.] To complete the missions, the player "intimidates, bribes, and fights his way to the top"—robbing banks, evading law enforcement, and "utilizing period-appropriate vehicles and weapons" to do so. [*Id.* at ¶ 11.]

In the first *Godfather* game, the player may choose and use a Tommy Gun identified as the Level Three "Dillinger Tommy Gun." [*Id.* at ¶ 12.] The "Dillinger Tommy Gun" is one of fifteen firearms in this game. [*Id.* at ¶ 17.] It is distinguishable from other weapons based on characteristics such as a seventy-five round clip and a rapid rate of fire. [Dkt. 1 at ¶ 20.] The gun's label appears as a single piece of text to identify the weapon, and the words "Dillinger

Tommy Gun” are not spoken by any character in the game, [dkt. 87 at ¶ 12]. The “Dillinger Tommy Gun” itself does not appear in any of the *Godfather* game’s advertising or promotion materials. [*Id.*]

In *The Godfather II*, the player manipulates the in-game character along the same plot-line as the movies but, “having risen to the top of the organized-crime underworld,” further aims to control criminal networks in New York, Miami, and Cuba during the 1960s. [*Id.* at ¶ 16.] In this version, the player may control a single in-game character or play in “The Don View,” which allows the player to direct other members of the Corleone family. [*Id.*] To seize control of the various territories, players select and use period-appropriate vehicles and weapons. [*Id.*]

In addition to the fifteen firearms included in *The Godfather II*, players may choose to purchase additional period-appropriate weapons as part of the “Level 4 Weapons Bundle.” [*Id.* at ¶ 7.] This downloadable bundle of weapons includes the “Modern Dillinger,” as well as four other weapons. [*Id.*] The “Modern Dillinger Tommy Gun” is distinguishable from other weapons based on characteristics such as a seventy-five round clip and a rapid rate of fire. [*Id.* at ¶ 23.] The “Modern Dillinger” does not appear in any of this game’s advertising or promotion materials, [dkt. 146-1 at ¶ 14]; however, “Modern Dillinger” appears in press releases concerning downloadable content and is listed first among all weapons, [dkt. 146-2 at 7].

John Dillinger does not appear and is not referenced in the *Godfather* movies or novel; he lived before the time period within which the games are set; and he committed crimes primarily in the Midwest, not on the East Coast. [Dkt. 144 at 4-7; dkt. 182 at 3.] Plaintiff thus claims EA’s use of the Dillinger name violates trademark law.

III. DISCUSSION

Although the Seventh Circuit protects video games as “literary works” under the First Amendment, *see Am. Amusement Mach. Ass’n v. Kendrick*, 244 F.3d 572, 577 (7th Cir. 2001), Plaintiff argues that EA is not entitled to First Amendment protection of its use of the Dillinger trademark because the use of the mark has no artistic relevance to the *Godfather* games; even if it does, Plaintiff argues, the use of the name should not be protected because it “explicitly misleads players regarding the content of the games and Dillinger’s approval of the mark’s usage.” [Dkt. 144 at 7.]

The parties agree that EA’s First Amendment defense to Plaintiffs trademark claim is controlled by *Rogers v. Grimaldi*, 875 F.2d 994 (2nd. Cir. 1989).¹ [Dkt. 86 at 2; dkt. 144 at 17-18; dkt. 182 at 2 (“To qualify for First Amendment Protection under *Rogers v. Grimaldi* on summary judgment, EA must establish as a matter of law that its use of Dillinger was “related” in some way to the “content of the expressive work.” (citation omitted).] The *Rogers* “relatedness” test bars trademark claims unless the use of the plaintiff’s likeness is “wholly unrelated to the [work] or [is] simply a disguised commercial advertisement for the sale of goods or services.” *Id.* at 1004. To properly analyze this issue, the Court must therefore consider a two-part test: First, the Court must determine whether the use of the mark has any artistic relevance to the underlying work whatsoever; second, if the use of the trademark has some relevance, the Court

¹ Although the parties agree that the Court should adopt the test set forth by the Second Circuit in *Rogers*, the Seventh Circuit has not yet spoken on the propriety of this test. Consistent with the longstanding principle of party presentation, *see Greenlaw v. United States*, 554 U.S. 237, 243-244 (2008), the Court will accept the parties’ position as to *Rogers* application, and assume that *Rogers* controls without definitely deciding the question. Furthermore, if this Court had not already dismissed Plaintiff’s right of publicity claim (Count I), [*see* dkt. 222], the Court notes that it would have analyzed that claim under *Rogers* also since Plaintiff argues, and EA does not dispute, that the *Rogers* test would have been the most appropriate test there as well. [Dkt. 144 at 17 (“The *Rogers* test is best suited to analyze the First Amendment issues in this case because it addresses important public policy concerns about permitting intentional use of another’s intellectual property for commercial profit.”).]

must determine whether it explicitly misleads the public as to the source or content of the work. *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos*, 547 F.3d 1095, 1099 (9th Cir. 2008) (citing *Rogers*, 875 F.2d at 999, 1004 (2d Cir. 1989)).

A) Does the Dillinger Name Have Any Relevance to *The Godfather Games*?

Plaintiff argues that the name “Dillinger” has no artistic relevance to the *Godfather* games because the use of the Dillinger name is not a reasonably necessary component of the games and because “[EA] does not know why it chose to use ‘Dillinger’ in the first place.” [Dkt. 144 at 8, 12.]

1. Relationship between Dillinger and the *Godfather Games*

Plaintiff argues that the use of the Dillinger name has no artistic relevance because it is “not a reasonably necessary aspect of the game[s].”² [Dkt. 144 at 12.] More precisely, it argues, the name’s use bears no relationship to the game because the mark appears nowhere in the games other than to identify the Level Three Dillinger Tommy Gun and the Modern Dillinger; because John Dillinger himself appears nowhere in the *Godfather* novel, movies, or video game story-line; and because John Dillinger was not alive during the period which any of those works was set. [Dkt. 144 at 12-13.] Because Tommy Guns are “but isolated elements in the work” with no relation to the story-line, Plaintiff maintains that EA relies on a mere “logical connection be-

² In its reply, Plaintiff clarifies that it is not making an “alternative means” argument—i.e., that the use of the mark must be the only way, or a reasonable way, to express the content of the work. [Dkt. 182 at 16.] For good reason: Courts adopting the *Rogers* test have rejected the alternative means argument. *See, e.g., E.S.S. Entm’t 2000, Inc., v. Rock Star Videos, Inc.*, 547 F.3d 1095 (9th Cir. 2008) (“The court’s inquiry is limited to determining whether the title has *some* relevance to the underlying work; it does not extend to assessing whether the use of the trade dress or mark is absolutely necessary to the goals of the artist.”) Plaintiff rightly concedes that it must make a showing that “zero relationship [exists] between John Dillinger and the premise for the *Godfather* video games.” [Dkt. 182 at 1, 16.]

tween John Dillinger and Tommy Guns,” which “cannot serve as the basis for establishing a relationship under the *Rogers* test.” [Dkt. 182 at 7, citing 164 at 8-9, 19.]

In support of this argument, Plaintiff attempts to distinguish this case from *E.S.S. v. Rock Star Videos*, wherein the Ninth Circuit found that the use of the name of a Los Angeles strip club had at least some artistic relevance to a video game whose goal was to “mimic the look and feel of actual Los Angeles neighborhoods.” 547 F.3d at 1097. There, the game was decidedly not “about” the strip club, but since the strip club had some relation to the city of Los Angeles, the court found the use of the mark was entitled to First Amendment protection. *Id.* at 1100 (“[Only] the use of a trademark with no artistic relevance to the underlying work whatsoever does not merit First Amendment protection. In other words, the level of relevance merely must be above zero. It is true that the game is not ‘about’ the [strip club] . . . but given the low threshold the game must surmount, that fact is hardly dispositive.”).

Despite Plaintiff’s contention to the contrary, this case is analogous to *E.S.S.* Here, it is undisputed that the *Godfather* games are not “about” Tommy Guns; the games are about a fictional world, based on the *Godfather* novel and movies, [dkt. 87 at ¶ 3], wherein players act like criminals and mobsters who use a wide array of weapons—including Tommy Guns. Plaintiff does not dispute the relevance, or even the primacy, of Tommy Guns to the virtual world depicted in the *Godfather* games. Nor does Plaintiff dispute that the Dillinger name is closely associated with the Tommy Gun. Indeed, Plaintiff admits that there a “superficial and attenuated” link between John Dillinger and the *Godfather* video games. [Dkt. 144 at 12.]

As was the case in *E.S.S.*, even if the Court accepts the characterization as attenuated, such connection is enough to satisfy the *Rogers* test: The gentleman-bandit, commonly known for his public persona as a “flashy gangster who dressed well, womanized, drove around in fast

cars, and sprayed Tommy Guns,” [dkt. 175 at 4], has above-zero relevance to a game whose premise enables players to act like members of the mafia and spray Tommy Guns. *See Roxbury Entmn’t v. Penthouse Media Group, Inc.*, 669 F. Supp 2d 1170, 1176 (C.D. Cal. 2009) (“Defendants have introduced evidence demonstrating at least some relationship between the mental imagery associated with the term ‘Route 66,’ e.g., road trips [and] cross-country travel, and the content of Defendants’ movie . . . Plaintiff’s argument that the association is tenuous does not controvert Defendants’ showing.”).

Plaintiff attempts to undermine this relationship by arguing that, “except for the name ‘Dillinger,’ [EA] chose not to include elements in its games which fell before 1940, such as John Dillinger’s contemporaries (e.g., Bonnie & Clyde, Ma Barker, Machine Gun Kelly, pre-1940 *Godfather* movie characters and 1930s-era cars).” [Dkt. 182 at 4.] Neglecting to include certain elements of an era, however, quite obviously does not mean that those which are included are irrelevant.

No suggestion has been made that the *Godfather* games aim to exactly replicate the *Godfather* movies or the time-period they depict—neither the fact that Dillinger lived before the pertinent time period nor the fact that EA did not include any of Dillinger’s contemporaries undermines the relevance of Dillinger’s public persona to the content of the games.

It bears repeating that it is not the role of the Court to determine how meaningful the relationship between a trademark and the content of a literary work must be; consistent with *Rogers*, any connection whatsoever is enough for the Court to determine that the mark’s use meets “the appropriately low threshold of minimal artistic relevance.” 875 F.2d at 999. EA has certainly shown that the “mental imagery” associated with the Dillinger name has more than zero relevance to the content of the *Godfather* games.

2. EA's Institutional Memory of Its Subjective Intent

Plaintiff also argues that the Dillinger name is not relevant to the video games because neither Mr. Wade nor anyone he could locate at EA could remember why “Dillinger” was chosen to describe the Level Three Tommy Gun.³ [Dkt. 146-1 at 4, 5, 10-11.] Plaintiff effectively asks the Court to infer that the apparent inability of EA representatives to recall why it chose to identify two of the weapons as Dillinger Tommy Guns means that there was no basis for identifying the weapons as such. [Dkt. 144 at 8-12.]

But the Court's analysis of the relationship between Dillinger and the *Godfather* video games is not limited to the company's institutional memory of its original intent, or even to the intent itself. As a legal matter, the relevant fact is that the company *did* choose to identify the Tommy Gun with the Dillinger name. As Plaintiff admits, “fundamentally, the inquiry [regarding relevance] looks to whether there is an *actual* nexus between the use and the intellectual property,” not just to memory of past intent. [Dkt. 182 at 1 (emphasis added).] As a practical matter, the mere fact that no EA representative can now recall why the guns were named “Dillinger Tommy Guns” may actually be more probative of the fact that there are countless artistic elements in the video games than it is of the relationship between Dillinger and the content of the games. [See dkt. 87 at ¶ 10.] In short, that no one can remember how the weapons were named has little-to-no bearing on any “actual nexus” between Dillinger and the content of the *Godfather* games.

³ Plaintiff moves to strike the testimony of Mr. Wade regarding how the Dillinger name was selected for use in the games—namely, that a team of people at EA determined it would “make the game cool” and would not “feel out of place in the context of the game,” [dkt. 87 at ¶ 20]—on the grounds that it is speculative and lacks proper foundation. [Dkt. 144 at 9; dkt. 146-1 at 5 (Depo. pg. 73 at ¶ 8-14).] Because Mr. Wade admits that his statements about the naming of the Tommy Gun is speculative, the Court **GRANTS** Plaintiff's motion to strike and will not consider this part of Mr. Wade's testimony.

The Court therefore finds that EA's inability to recall why it used the Dillinger name does not itself create a genuine issue of material fact regarding the name's relevance to the games. The Dillinger name has some relevance to the *Godfather* games and thus satisfies the first element of the *Rogers* test.

B) Is the Dillinger Label Explicitly Misleading as to the Source and Content of the Games?

The second element of the *Rogers* test asks the Court to determine whether the defendant's use of the plaintiff's trademark "explicitly misleads as to the source and content of the work. 875 F.2d at 999. To be "explicitly misleading," the defendant's work must make some affirmative statement of the plaintiff's sponsorship or endorsement, beyond the mere use of plaintiff's name or other characteristic. *See Rogers*, 875 F.2d at 1001; *E.S.S.*, 547 F.3d at 1101. For example, the use of "the phrase in a subtitle of 'an authorized biography' would be sufficiently explicit to be actionable, if false"; but evidence that the trademark use "might implicitly suggest that the named celebrity had endorsed the work or had a role in producing it" is "outweighed by the danger of restricting artistic expression." *Rogers*, 875 F.2d at 999-1000.

Plaintiff argues that "by using Dillinger's name in the games, EA gives the false impression that the Dillinger brand approves the association of John Dillinger's likeness with these games; "[t]he fact that the games are based on literary and motion picture works that do not contain any reference to John Dillinger only heightens the probability of deception." [Dkt. 182 at 17; dkt. 164 at 15.] In support of its claim, Plaintiff points to the fact that the "Modern Dillinger" is one of only a select few guns available through the upgrade pack for *The Godfather II*, implicitly indicating it is "arguably the most powerful gun available," [dkt. 146-1 at 14], and that

press releases posted to EA's website list the Modern Dillinger first among all the weapons, [dkt. 146-2 at 7].⁴ [Dkt. 164 at 15.]

In the same breath, however, Plaintiff urges the Court to believe that the games can be played "many times without interfacing with the Dillinger guns themselves." [Dkt. 182 at 7 (citing dkt. 187 at ¶ 17).] Furthermore, Plaintiff has presented no evidence that any consumer bought the *Godfather* Games because of the Dillinger name, or was otherwise confused. As was the case in *E.S.S.*, the use of the Dillinger name is "quite incidental to the overall story of the game" and "not the main selling point of the [g]ame." 547 F.3d at 1100-1101.

Even if the Dillinger name is not a selling point of the games, Plaintiff argues, "studies show that increasing numbers of consumers believe that all marks appearing in entertainment are placed or licensed."⁵ [Dkt. 164 at 15, citing to Elizabeth Rosenblatt, *Rethinking the Parameter of Trademark Use in Entertainment*, 61 FLORIDA L. REV. 1011, 1032 (2009).] As an initial matter, this statement is not admissible evidence under Rule 801; but even if it were, it would not be probative as to whether the use of this particular trademark confused consumers. As to production of admissible evidence, Plaintiff futilely claims that "at trial, [it] will present numerous pieces of evidence as to post-sale confusion." [Dkt. 144 at 15.] Absent a Rule 56(d) motion, however, summary judgment is the time in the litigation for the parties to marshal and present the Court with all the evidence that they intend will prove their respective cases. See, e.g., *Everroad v. Scott Truck Sys., Inc.*, 604 F.3d 471, 476 (7th Cir. 2010). And despite Plaintiff's sweeping allegation, it has presented no evidence that a single consumer was misled in this case.

⁴ Plaintiff also argues that the Dillinger Tommy Gun is advertised on internet pages where the downloadable content can be purchased, such as Xbox and Playstation screen shots. [See dkt. 151-4; dkt. 151-5.] As EA points out, however, Plaintiff has made no showing that EA exercises control over these products or their advertising materials. [Dkt. 164.] The Court therefore disregards this evidence.

Instead, in support of its position, Plaintiff attempts to analogize this case to *Parks v. La-Face Records*, 329 F.3d 437 (6th Cir. 2003), where the Sixth Circuit determined that under the *Rogers* test, the title of Outkast's hip-hop song *Rosa Parks* was not protected by the First Amendment because it had no artistic relevance whatsoever to the content of the song and because it was likely to confuse the public about the content of the work. In striking contrast to *Rosa Parks*, whom the court noted was an "international symbol of freedom, humanity, dignity and strength," *id.* at 454, the court deemed the Outkast song "nothing more and nothing less than a paean announcing the triumph of superior people in the entertainment business over inferior people in that business." *Id.* at 435. Moreover, the court noted, "some people looking at the title *Rosa Parks* might think the song is about Rosa Parks, and for those with that false impression (as twenty-one consumer affidavits filed in this case indicate happened), the title is misleading." *Id.* at 455.

In determining that the Outkast song's title was not protected by the First Amendment, the *Parks* court focused on the objective evidence of relatedness and potential for consumer confusion. 329 F.3d at 455. And unlike *Parks*, where the plaintiff presented affidavits documenting circumstances in which the song's title led listeners to believe the song was about Rosa Parks, 329 F.3d at 455 n.4, here Plaintiff has presented no evidence that any consumers are confused by the use of "Dillinger" in the *Godfather* games. The Court cannot simply infer that the Dillinger name confuses the public, let alone that such confusion outweighs First Amendment concerns.

In any event, Plaintiff points to no *explicit* misrepresentation—that fact alone is dispositive of this issue. *Rogers*, 875 F.2d at 999; *E.S.S.* 547 F.3d at 1100-1101. All that is challenged here a single text-line used to identify one of many weapons within a visually complex video game comprised of countless artistic elements. [Dkt. 87 at ¶¶ 10-11.] In the face of no docu-

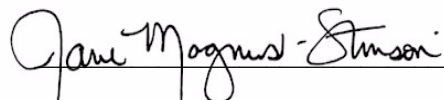
mented harm—or even risk of harm—whatsoever, the Court finds that there is no genuine issue of material fact regarding public confusion from the use of the Dillinger name.

Because no issue of fact exists as to whether the Dillinger name is relevant to the content of *The Godfather Games*, or as to whether the use of the name explicitly misleads consumers, the Court finds that EA is entitled to summary judgment on its First Amendment defense.

**IV.
CONCLUSION**

For the foregoing reasons, the Court **GRANTS** EA's Motion for Summary Judgment on its First Amendment Defense with respect to all remaining claims, [dkt. 85], and further **DE- NIES** Plaintiff's Cross-Motion regarding the same, [dkt. 144]. Judgment shall enter accordingly.

06/16/2011



Hon. Jane Magnus-Stinson, Judge
United States District Court
Southern District of Indiana

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ELECTRONIC ARTS INC.,)	
<i>Defendant.</i>)	

ORDER

Presently before the Court is Defendant Electronic Arts, Inc.’s (“EA”), motion for judgment on the pleadings. [Dkt. 89.]

**I.
STANDARD OF REVIEW**

“After the pleadings are closed...a party may move for judgment on the pleadings.” Fed. R. Civ. Pro. 12(c). Where, as here, a motion for judgment on the pleadings attacks the sufficiency of the complaint, the motion “is subject to the same standard as a motion for dismissal for failure to state a claim [under Rule 12(b)(6)].” *Thomason v. Nachtrieb*, 888 F.2d 1202, 1204 (7th Cir. 1989). Under that standard, “a complaint must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face. A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.” *Ashcroft v. Iqbal*, 129 S. Ct. 1937, 1949 (2009) (quotation and citation omitted).

When evaluating the plausibility of the plaintiff’s claim, the plaintiff “receives the benefit of reasonable inferences” that arise from the well-pleaded allegations. *Pirelli Armstrong Tire Corp. Retiree Med. Benefits Trust v. Walgreen Co.*, 631 F.3d 436, 447 (7th Cir. 2011) (citation omitted). Denials in the answer don’t count, nor does an assertion of an affirmative defense, un-

less the plaintiff's own allegations establishes it, *see Cancer Found., Inc. v. Cerberus Capital Mgmt., LP*, 559 F.3d 671, 674-675 (7th Cir. 2009) ("Dismissing a complaint as untimely at the pleading stage is an unusual step, since a complaint need not anticipate and overcome affirmative defenses, such as the statute of limitations. But dismissal is appropriate when the plaintiff pleads himself out of court by alleging facts sufficient to establish the complaint's tardiness." (citation omitted)).

II. ALLEGATIONS IN THE COMPLAINT

As many people know, John Dillinger was a notorious Indiana gangster who terrorized the Midwest for several years, until he was gunned down by the F.B.I. in a Chicago firefight, in 1934. [*See* dkt. 63 at 1.]

Through the Complaint, Plaintiff Dillinger, L.L.C., alleges that it has registered two U.S. trademarks for "John Dillinger." [Dkt. 1 ¶15.] And thanks to a relatively recent Indiana statute, which recognized a descendible right of publicity, the Plaintiff also claims the right to control Mr. Dillinger's "personality" rights for commercial purposes—that is, his "name, voice, signature, photograph, image, likeness, distinctive appearance, gestures, [and] mannerisms." [*Id.* ¶12.] It claims to have acquired those publicity rights by assignment from the heirs of Mr. Dillinger, who died intestate. [*See id.* ¶14; dkt. 99 at 6 n.4.]

The Plaintiff has sued EA for including unauthorized references to John Dillinger in its series of videogames based upon *The Godfather* novel and subsequent film series. [Dkt. 1 ¶¶17-18.] The references occur in the form of the names of two types of weapons that players can use to facilitate their own virtual crime spree as a mob boss. One is the "Dillinger Level Three Tommy Gun", which players can earn at no extra cost through game play. [*Id.* ¶19.]

Additionally, players of one particular iteration of the videogame series, “The Godfather II,” can purchase upgraded weapons over the internet to enhance their effectiveness as virtual mob bosses. [See *id.* ¶22.] The Complaint includes a screenshot of an online store operated by either of two third parties, where users could buy various weapons upgrades for the game. One upgrade was the “Level 4 Firearms” pack, which retailed for \$4.00. [*Id.*] It was described on the third-party websites in part as follows: “These five firearms are exactly what a Don needs to put his family on top! Each weapon can be equipped by you and your family. This collection includes the Modern Dillinger [Tommy Gun]....” [*Id.*]

The Plaintiff alleges that by continuing to include the Dillinger Level Three and Modern Dillinger in its “The Godfather” games, EA has continued to knowingly and willingly violate the Plaintiff’s trademark in John Dillinger and its control over Mr. Dillinger’s personality rights, despite being put on notice of the Plaintiff’s objections. [*Id.* ¶¶ 26-27.]

III. DISCUSSION

The Plaintiff has raised six causes of action against EA, each of which stems from the references to the “Dillinger” weapons in EA’s videogames. Count I accuses EA of violating Indiana’s right-of-publicity statute, Ind. Code §§ 32-36-1-1 *et seq.* Count II says that EA has committed unjust enrichment. Counts III and V, which the parties treat together and so will the Court, accuse EA of trademark infringement. Count IV alleges unfair competition. Finally, Count VI raises a claim under Indiana’s Crime Victim Act (the “ICVA”), Ind. Code § 34-24-3-1.

A. Count I: Right-of-Publicity Statute

In 1994, about sixty years after John Dillinger died, the Indiana General Assembly enacted the right-of-publicity statute. As is relevant here, it partially changed the common-law rule that “[w]hat a man does while alive becomes a part of history which survives his death” and

is subject to “[c]omment, fictionalization and even distortion” after his death, *Maritote v. Desilu Productions, Inc.*, 345 F.2d 418, 420 (7th Cir. 1965). The Indiana General Assembly decreed that “[a] person may not use an aspect of a personality’s right of publicity [including the person’s name] for a commercial purpose during the personality’s lifetime or for one hundred (100) years after the date of the personality’s death without having obtained previous written consent from a person” vested with control of the personality’s right to publicity. Ind. Code § 32-36-1-8(a).

Of the bases on which EA relies to challenge the right-of-publicity claim, its statute-of-limitations argument is the easiest to resolve here. Relying only on a statement in the Plaintiff’s response brief—rather than the allegations of the Complaint itself—EA argues that the Plaintiff has conceded missing the two-year statute of limitations governing the claim, [dkt. 101 at 11 (arguing that the Plaintiff claimed misappropriation first accrued in 2006 but did not file suit until 2009)]. By surreply, the Plaintiff argues (among other things) that the continued sales of the games makes its right-of-publicity claim a “continuing wrong,” such that the statute of limitations is tolled until the sales stop, *see Yoost v. Zalberg*, 925 N.E.2d 763, 771 (Ind. Ct. App. 2010) (“The doctrine of continuing wrong applies where an entire course of conduct combines to produce an injury. When the doctrine attaches, the statute of limitations begins to run at the end of the continuing wrongful act.” (citations omitted)). Because of the briefing posture, however, EA hasn’t had a chance yet to respond to the Plaintiff’s legal authority presented via surreply, thus depriving the Court of the benefit of adversarial presentation. Rather than permit additional briefing, the Court will apply the general rule that a statute-of-limitations argument should be raised via a motion for summary judgment, especially because EA’s argument doesn’t actually depend on the allegations in any of the Plaintiff’s pleadings, *see Fed. R. Civ. Pro. 7(a)* (not including briefs in the list of recognized pleadings). Accordingly, to the extent that EA seeks a

dismissal on statute-of-limitations grounds on this first count of the Complaint (or any other), the Court denies the motion without prejudice.

EA makes two other arguments against the right-of-publicity claim, which are both properly raised through a motion for judgment on the pleadings: that the statute doesn't apply to personalities who died before the statute was enacted and, even if it did, that the "literary works" exception included in the statute covers videogames, Ind. Code § 32-36-1-1(c)(1)(A) (exempting "[l]iterary works, theatrical works, musical compositions, film, radio, or television programs"). As this Court possesses only supplemental jurisdiction over Count I,¹ the Court must predict how the Indiana Supreme Court "would decide the case, and decide it the same way." *Mindgames, Inc. v. W. Publ'g Co.*, 218 F.3d 652, 655 (7th Cir. 2000) (citations omitted). The Indiana Supreme Court, however, hasn't ever had occasion to consider either issue, nor has the Indiana Court of Appeals, whose decisions are good indicators of what the state supreme court would decide, *Pisciotta v. Old Nat'l Bancorp*, 499 F.3d 629, 635 (7th Cir. 2007).² The Court must, therefore, base its decisions on whatever authority is available. *See id.*

1. Whether the Statute Applies to Personalities Who Died Before 1994

In support of its claim that the right-of-publicity statute doesn't apply to personalities like John Dillinger who died before the statute's enactment, EA directs the Court to *Shaw Family Archives, Ltd. v. CMG Worldwide, Inc.*, 486 F. Supp. 2d 309 (S.D.N.Y. 2007). In that case, the

¹ The Plaintiff's Complaint pleads federal subject-matter jurisdiction and supplemental jurisdiction. Because it hasn't properly set forth the Plaintiff's citizenship or the amount in controversy, the Complaint doesn't invoke diversity jurisdiction. [See dkt. 1 ¶¶6, 9.]

² Neither party has argued that the Court could or should certify either issue to the Indiana Supreme Court. *See* Ind. App. R. 64(A) ("[A]ny federal district court may certify a question of Indiana law to the Supreme Court when it appears to the federal court that a proceeding presents an issue of state law that is determinative of the case and on which there is no clear controlling Indiana precedent."). Given the delay and extra expense to the parties associated with a certification, the Court will respect their implicit preference.

court rejected an attempt by an entity claiming to have obtained, via will, Marilyn Monroe's right of publicity. The court reasoned that because publicity rights terminated at death at common law, Ms. Monroe's death before the Indiana statute was enacted meant that she lacked any publicity right to devise in her will. *Id.* at 314 ("Thus, at the time of her death in 1962 Ms. Monroe did not have any postmortem right of publicity under the law of any relevant state [including Indiana]. As a result, any publicity rights she enjoyed during her lifetime were extinguished at her death by operation of law.>").

The Plaintiff counters EA's authority with non-precedential authority of its own: a decision of an Indiana trial court that found liability where the Lake County Convention Center referred to "Dillinger" in its tourism advertisements and ran a "Dillinger" museum. The trial court there held that "[t]he Indiana Right of Publicity Statute should...be read retroactively" so as to also protect the publicity rights of the individuals who died before its enactment, including John Dillinger. *Scalf v. Lake County Convention & Visitors Bureau, Inc.*, 45D10-0406-PL-00093 (Lake Super. Ct. Jan. 9, 2006) *available at* [dkt. 100-2]. In reaching its holding, the court relied upon several statutory provisions, which it concluded made clear the General Assembly's intent. The statute defines a "personality" as "a living or deceased natural person" who has attributes with "commercial value, whether or not the person uses or authorizes the use of the person's right of publicity for a commercial purpose during the person's lifetime," Ind. Code § 32-36-1-6. The publicity rights endure for 100 years following the personality's death. Ind. Code § 32-36-1-8. And publicity rights now constitute property, "freely transferable and descendible," including by will and intestate succession. Ind. Code § 32-36-1-16.

After reviewing the pair of decisions that the parties have cited, the Court finds that the Indiana Supreme Court would agree with *Shaw*: Indiana's right-of-publicity statute doesn't ap-

ply to personalities who died before its enactment. The statutory provisions, individually and collectively, that *Scalf* cited are ambiguous; they can be read equally to protect personalities who live and die after the statute's 1994 enactment, as they can be read to protect those who have ever lived. Providing causes of action for the heirs of the millions of people who died between 1894 and 1994—*i.e.* during the 100 year post-death period of protection—would greatly expand the potential liabilities that the statute creates.³ At present, given the existence of a reasonable alternative reading of the statute, the Court must presume that the Indiana Supreme Court would not endorse such a result but would instead adopt the narrower reading. *See Todd v. Societe BIC, S.A.*, 21 F.3d 1402, 1412 (7th Cir. 1994) (en banc) (“When given a choice between an interpretation of [state] law which reasonably restricts liability, and one which greatly expands liability, we should choose the narrower and more reasonable path (at least until the [state supreme court] tells us differently”).⁴

The Court also rejects *Scalf* for another reason insofar as it recognizes publicity rights of individuals who died before 1994: The decision permits inheritances outside of probate, despite the important functions that probate serves. First, Indiana levies an inheritance tax on the property that is transferred (among other ways) “under a deceased transferor’s will or under the laws of intestate succession, as a result of the transferor’s death.” Ind. Code § 6-4.1-2-4(a)(1). Recognizing new property after probate has concluded would frustrate Indiana’s ability to collect the tax, unless claimants of that property submit to probate. *See* Ind. Code § 6-4.1-4-1 (requiring

³ The statute “applies to an act or event that occurs within Indiana, regardless of a personality’s domicile, residence, or citizenship.” Ind. Code § 32-36-1-1(a). Given the potential worldwide class of potential plaintiffs, billions may be a better measure.

⁴ Given the presumption, the Court needn’t consider whether interpreting the statute to protect the rights of individuals whose deaths pre-deceased the statute would actually make the statute truly “retroactive” lawmaking and, if so, whether “strong and compelling reasons” justify it, *Bourbon Mini-Mart v. Gast Fuel & Servs.*, 783 N.E.2d 253, 260 (Ind. 2003) (citations omitted).

personal representative to file an inheritance tax return in the probate court within nine months of the decedent's death). Second, probate also ensures that creditors who have claims against the decedent are paid—which in Mr. Dillinger's case might include the victims of his numerous crimes and possible unpaid criminal fines. *See* Ind. Code § 29-1-7-7.5 (requiring personal representatives to notify creditors of probate); § 29-1-17-2(a) (requiring taxes and claims to be paid before distributions to heirs or beneficiaries). Finally, probate conclusively determines the heirs (or, in the case of a will, the beneficiaries) who receive the decedent's remaining property, once all claims have been paid.

With respect to the last reason, the Court notes that the parties here disagree about the chain of intestate succession for Mr. Dillinger. [*Compare* dkt. 154 ¶6, *with* dkt. 168 at 10.] Which version of the Probate Code governs intestate succession: the one in force when Mr. Dillinger died or the one when the General Assembly created the right-of-publicity? *Compare* Ind. Code § 6-2303 (1933) (repealed),⁵ *with* Ind. Code § 29-1-2-1(d)(3).⁶ The answer could bear on whether Plaintiff's claimed ownership interest is sufficient to otherwise control the publicity rights. But a probate court—not a federal one—is the appropriate forum to resolve those questions. *Cf. Marshall v. Marshall*, 547 U.S. 293 (2006) (narrowing the “probate exception” to federal jurisdiction while reaffirming the principle that probate is normally a matter for state courts).

⁵ “If any intestate shall die without lawful issue or their descendants alive, one-half of the estate shall go to the father and mother of such intestate, as joint-tenants, or, if either be dead, to the survivor, and the other half to the brothers and sisters and to the descendants of such as are dead, as tenants-in-common.”

⁶ “If there is no surviving spouse or issue of the intestate, then to the surviving parents, brothers, and sisters, and the issue of deceased brothers and sisters of the intestate. Each living parent of the intestate shall be treated as of the same degree as a brother or sister and shall be entitled to the same share as a brother or sister. However, the share of each parent shall be not less than one-fourth (1/4) of the decedent's net estate. Issue of deceased brothers and sisters shall take by representation.”

So whether or not the statute applies retroactively, absent an allegation that probate has been re-opened to permit the just administration of the new property recognized by the General Assembly through the right-of-publicity statute, the Complaint fails to state a claim. *See* Ind. Code § 29-1-17-14 (permitting closed estates to be reopened to supervise the distribution of after discovered property). *Cf. also Estate of Ellington v. Gibson Piano Ventures, Inc.*, 2005 U.S. Dist. LEXIS 21003, *34 (S.D. Ind. 2005) (finding issues of fact existed regarding a right-of-publicity claim by the Estate of Duke Ellington, who died in 1974, although not specifically addressing the “retroactivity” issue).⁷ No such allegation appears here.

Because the Plaintiff seeks to enforce publicity rights of John Dillinger, who died in 1934, well before the enactment of the right-of-publicity statute, the Plaintiff has failed to state a claim under that statute. Even if the statute could protect other personalities who died before its enactment, the Complaint nonetheless impermissibly fails to allege that the purported heirs of Mr. Dillinger’s right of publicity have ever submitted that property right to probate.

2. Whether the Exception for Literary Works Includes Videogames

EA has an alternative argument to defeat Count I; it argues that its videogame qualifies a “literary work[.]” and thus cannot form the basis for a lawsuit brought under the right-of-publicity statute. Ind. Code § 32-36-1-1(c)(1)(A).

Citing various dictionary definitions of “literary” and “literature,” the Plaintiff responds that videogames don’t normally qualify for such labels, which are at the heart of “literary works.” [*See* dkt. 99 at 7.] If the General Assembly had wanted to include them, it argues, the General Assembly would have done so with much more straightforward language.

⁷ An affidavit filed in that case indicates that Mr. Ellington died intestate. 1:03-cv-00804-WTL-DFH [dkt. 84-1 ¶2].

But, as EA correctly notes, it's not unheard of to call videogames literary works. Indeed, Congress has referred to them that way. *qad, Inc. v. ALN Assoc., Inc.*, 974 F.2d 834, 835 (7th Cir. 1992) (citation omitted) ("Congress extended copyright protection to 'literary works' in 17 U.S.C. § 102(a)(1), a category which includes computer programs.").

Deciding whether to adopt the broader definition of literary works that EA proposes or the narrower one that the Plaintiff offers has significant constitutional implications. Any holding that "literary works" in the statute don't encompass videogames would set the right-of-publicity statute up for a constitutional challenge because videogames have just as much protection under the First Amendment as does "highbrow literature," *Am. Amusement Mach. Ass'n v. Kendrick*, 244 F.3d 572, 577 (7th Cir. 2001). While the Plaintiff argues that true First Amendment problems can be cured through case-by-case invocations of a constitutional affirmative defense, [dkt. 99 at 7-8], as EA has done here (in a pending motion for summary judgment), it is unlikely that the Indiana Supreme Court would adopt the Plaintiff's approach. When faced with ambiguous statutory language, the Indiana Supreme Court follows the "familiar canon of statutory interpretation that statutes should be interpreted so as to avoid constitutional issues." *City of Vincennes v. Emmons*, 841 N.E.2d 155, 162 (Ind. 2006) (citations omitted). Additionally, interpreting "literary works" broadly would effectuate the General Assembly's obvious attempt to avoid potential constitutional infirmities with the statute. The other exceptions in the same subsection all involve materials that are also protected under the First Amendment: "theatrical works, musical compositions, film, radio, or television programs[;]...[m]aterial that has political or newsworthy value[;]...original works of fine art[; and]...[p]romotional material or an advertisement for a news reporting or an entertainment medium[; or] [a]n advertisement or commercial announcement for a use described in this subdivision." Ind. Code § 32-36-1-1(c)(1). *See, e.g., Ward v.*

Rock against Racism, 491 U.S. 781, 790 (1989) (music); *Bd. of Trs. v. Fox*, 492 U.S. 469, 477 (1989) (commercial speech); *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 578 (1977) (news and broadcast entertainment); *Southeastern Promotions, Ltd. v. Conrad*, 420 U.S. 546, 557 (1975) (theatrical works); *Jenkins v. Georgia*, 418 U.S. 153, 156 (1974) (film); *Miller v. California*, 413 U.S. 15, 24 (1973) (material with “literary, artistic, political, or scientific value”).

Given that “literary works” can easily be read to encompass videogames, the Court finds that the Indiana Supreme Court would adopt such a reading of the exception, to avoid constitutional issues with the narrower definition. That exception, therefore, defeats the Plaintiff’s right-of-publicity claim, which is lodged exclusively against EA’s videogames.

B. Count II: Unjust Enrichment

As a tag along to its right-of-publicity claim, the Plaintiff also asserts a cause of action for unjust enrichment, in Count II. That cause of action is premised upon what the Plaintiff contends was EA’s wrongful “use of the Dillinger Personality...in violation of Indiana’s Right of Publicity Statute.” [Dkt. 1 ¶¶34-35.] EA has argued—and the Plaintiff hasn’t disputed—that if Count I fails, then Count II must also fail. [*Compare* dkt. 90 at 11, *with* dkt. 99 at 12-14.] Because the Court has dismissed Count I, it will accordingly dismiss Count II as well.

C. Counts III & V: Federal Trademark Claims⁸

⁸ Although Count III also references the Indiana Trademark Act, Ind. Code § 24-2-1-0.5 *et seq.*, and common-law trademark protections, the Plaintiff hasn’t attempted to develop any argument about either. Accordingly, to whatever extent that they might confer greater benefits than federal trademark law, the Court deems the Plaintiff’s lack of cogent argument an abandonment of any claim to recovery under those theories for purposes of the Court’s ruling on this motion. *See Trentadue v. Redmon*, 619 F.3d 648, 654 (7th Cir. 2010) (“[U]nderdeveloped arguments are considered waived.” (citation omitted)).

As is relevant here, federal trademark law prohibits the use of another’s trademark “in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1114(1)(a). It also prohibits a person from using in commerce of “any word, term, name, symbol, or device..., which...is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person.” *Id.* § 1125(a)(1)(A). The Plaintiff claims that EA’s references to “Dillinger” weapons violated those statutes, in Counts III and V, respectively. [*See* dkt. 1 at 9, 11.]

Although the two statutes at issue in these Counts are worded slightly differently, they both ultimately require the trademark plaintiff to “establish that (1) [its] mark is protectable, and (2) the defendant’s use of the mark is likely to cause confusion among consumers,” *Packman v. Chicago Tribune Co.*, 267 F.3d 628, 638 (7th Cir. 2001), whether before or after the sale of the offending product, *CAE, Inc. v. Clean Air Eng’g, Inc.*, 267 F.3d 660, 683 (7th Cir. 2001) (citations omitted). The likelihood-of-confusion analysis “is an equitable balancing test,” which considers seven factors:

- (1) similarity between the marks in appearance and suggestion;
- (2) similarity of the products;
- (3) the area and manner of concurrent use;
- (4) the degree of care likely to be exercised by consumers;
- (5) the strength of the plaintiff’s mark;
- (6) whether actual confusion exists; and
- (7) whether the defendant intended to ‘palm off’ [its] product as that of the plaintiff.

Id. at 677-78. Although none of the factors is dispositive, “the similarity of the marks, the defendant’s intent, and actual confusion” are the most important when deciding, *Barbecue Marx, Inc. v. 551 Ogden, Inc.*, 235 F.3d 1041, 1044 (7th Cir. 2000)—as a matter of fact—that likelih-

ood of confusion exists, *Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1428 (7th Cir. 1985) (“[T]he question of likelihood of confusion is all fact and no law.”).

Even if the plaintiff can establish those elements, however, federal law recognizes several affirmative defenses to trademark liability. Among them is fair use, which EA has asserted. [See dkt. 67 at 9].⁹ That defense provides a shield to liability if EA can prove that it used the Plaintiff’s trademark (1) “in a non-trademark use; (2) the phrase is descriptive of their goods or services; and (3) [it] used the phrase fairly and in good faith only to describe their goods or services.” *Packman*, 267 F.3d at 639 (citations and quotation omitted).

EA here makes a narrow challenge to the Plaintiff’s trademark claims. It doesn’t challenge the first element of the Plaintiff’s prima facie case, the Plaintiff’s trademark in “John Dillinger.” Instead it challenges the second, the likelihood-of-confusion element. And as to that element, EA argues only that the Plaintiff cannot—as a matter of law—establish likelihood of confusion because the Complaint has no allegation that EA itself used John Dillinger as a trademark, in other words, that EA used John Dillinger as a way “to identify and distinguish [its] goods...from those manufactured or sold by others....,” 15 U.S.C. § 1127. [See dkt. 101 at 8 (“Without trademark use [as a trademark]...there can be no finding of infringement.”).]¹⁰

The Court rejects EA’s argument. First, whether or not EA has correctly interpreted the various out-of-Circuit district-court decisions that EA has cited in support of its argument, the Seventh Circuit apparently views the law otherwise. A defendant’s “non-trademark use” is an

⁹ In a separate motion for summary judgment, EA has also asserted an affirmative defense under the First Amendment. The applicability of the fair-use affirmative defense itself isn’t currently before the Court. See *Cancer Found., Inc.* 559 F.3d at 674-675 (explaining that complaints need not anticipate and plead around affirmative defenses to survive a motion to dismiss).

¹⁰ EA doesn’t dispute that the Complaint properly alleges that it has used “in commerce” the Plaintiff’s trademark “in connection with any goods or services.” 15 U.S.C. § 1114(1)(a). See also *id.* at § 1125(a)(1). The argument is only that EA’s use of “John Dillinger” wasn’t “as” EA’s trademark.

element of the fair-use affirmative defense, the lack of which doesn't necessarily preclude establishing the plaintiff's prima facie case. *Packman*, 267 F.3d at 639; *see also Sunmark, Inc. v. Ocean Spray Cranberries*, 64 F.3d 1055, 1058 (7th Cir. 1995) (stating that if a defendant used the words of the trademark "simply as descriptions, and otherwise than as a mark,...there can be no violation of the Lanham Act under what is known as the fair use defense"). If a Plaintiff always had to prove "trademark use" as part of its prima facie case, the "non-trademark use" element in the affirmative defense would be redundant. Indeed, it could also preclude a trademark infringement action against printers and publishers—who may reprint a registered trademark without any intention of using it to designate their own goods—even though they too can be liable for trademark infringement. *See* 15 U.S.C. § 1114(2)(A)-(B) (limiting liability to injunctive relief upon proof that printer or publisher is an "innocent" infringer).

Second, given the required benefit of the inferences from the Complaint applicable to the present motion, the Complaint actually alleges at least some potential "trademark use" by EA: Users can connect to the internet and select weapons to buy as upgrades for the "The Godfather II," weapons that explicitly use the "Dillinger" name. [Dkt. 1 ¶22.] Contrary to EA's assertions, therefore, the Complaint does contain allegations of the Plaintiff's mark "in marketing, advertising, or other means of selling its product" and could, under even EA's view, state a claim. [*Id.* at 90 (quoting *Felix the Cat Prods. Inc. v. New Line Cinema Corp.*, 54 U.S.P.Q. 2d 1856, 2000 WL 770481 (C.D. Cal. 2000)).]¹¹

Because Counts III and V are not subject to dismissal on the grounds that they fail to allege that EA used the Plaintiff's mark "as" a trademark, and because EA argues no other basis

¹¹ There is no allegation that EA actually controls the marketing or runs any advertisements for the game upgrades. But, on the present record, the Court will find EA's alleged authorization of game content on the third-party websites constitutes an "other means of selling" its product.

here that might justify their dismissal, the Court denies EA's motion with respect to Counts III and V.

D. Count IV: Unfair Competition

EA's only argument regarding Count IV, which alleges unfair competition, is that Count IV must fail if Counts III and V fail. [See dkt. 90 at 10.] Because the latter two claims survive, so does the former. EA's motion is denied with respect to Count IV.

E. Count VI: ICVA

Civil plaintiffs who can prove, by a preponderance of the evidence, that they have been the victims of certain property crimes committed by defendants—whether or not the crimes were ever criminally charged—can recover up to three times the amount of any pecuniary losses. *See White v. Indiana Realty Assoc. II*, 555 N.E.2d 454, 456 (Ind. 1990) (citations omitted); Ind. Code § 34-24-3-1. Through its Count VI, the Plaintiff here claims EA committed three such property crimes with respect to its publicity rights and trademarks: conversion, Ind. Code § 35-43-4-3; theft, Ind. Code § 35-43-4-2;¹² and deception, Ind. Code § 35-43-5-3. [Dkt. 99 at 14-16.] Given that the Court has already found that the Plaintiff has no publicity rights with respect to John Dillinger, the Court will only address the Plaintiff's claims insofar as they relate to alleged trademark infringement.

Criminal conversion occurs when “[a] person...knowingly or intentionally exerts unauthorized control over property of another person.” Ind. Code § 35-43-4-3(a). While EA offers other additional arguments about why the Complaint fails to plead conversion, the Court will on-

¹² The Complaint erroneously referred to criminal mischief. The Plaintiff has explicitly disclaimed any potential claim for criminal mischief. [Dkt. 99 at 14 n.13.] Although EA objects that the Plaintiff shouldn't be permitted to “amend” its Complaint in response to the motion for judgment on the pleadings, the objection is moot inasmuch as the Plaintiff has failed to state a claim for theft, for reasons that will be explained.

ly address one, which is clearly dispositive. EA has argued, [*see* dkt. 101 at 11 n.5], that the Plaintiff has included no allegations that EA ever “exerted control” over the Plaintiff’s trademark. That element requires a defendant “to obtain, take, carry, drive, lead away, conceal, abandon, sell, convey, encumber, or possess property, or to secure, transfer, or extend a right to property.” Ind. Code § 35-43-4-1. Merely using another’s trademark without permission, which is what the Plaintiff has alleged EA did here, doesn’t constitute any of those activities. *Heckler & Koch, Inc. v. German Sport Guns GmbH*, 2009 U.S. Dist. LEXIS 88695, *4 (S.D. Ind. 2009) (Lawrence, J.) (granting motion to dismiss ICVA claim regarding conversion of trademark and trade dress). *See also Heckler & Koch, Inc. v. Coharie Arms, Inc.*, 2010 U.S. Dist. LEXIS 23460, *5-7 (S.D. Ind. 2010) (Young, C.J.) (dismissing ICVA claim for conversion of trade dress because the defendant’s infringing use was in no way “in exclusion and defiance of the owner’s rights” and was thus not unauthorized control).¹³ The Plaintiff has, therefore, failed to state a claim for conversion of its trademark.

Conversion is a lesser-included-offense to theft. *See Moser v. State*, 433 N.E.2d 68, 69 (Ind. Ct. App. 1982) (“Absence of the element of ‘intent to deprive’ distinguishes criminal conversion from theft.”). Because, as discussed above, the Plaintiff can’t establish conversion, it necessarily can’t establish theft either.

The remaining alleged criminal act is deception, a crime which can occur in eleven statutorily defined ways. *See* Ind. Code § 35-43-5-3(a). The Plaintiff argues that only two are at issue in this action: “(6) with intent to defraud, misrepresent[ing] the identity or quality of property...;[or] (9) disseminat[ing] to the public an advertisement that the person knows is false, mis-

¹³ At oral argument, Plaintiff’s counsel conceded that “[t]here’s always questions as to whether you can convert a trademark.” [Dkt. 210 at 63.] Although counsel believed that the issue was not the subject of the motion, [*see id.*], the Court finds otherwise.

leading, or deceptive, with intent to promote the purchase or sale of property....” *Id.* § 35-43-5-3(a)(6), (9).

EA correctly argues that the Complaint lacks any allegation that it used the Plaintiff’s trademark “with the intent to defraud.” [Dkt. 90 at 12.] Indeed, the Plaintiff makes no claim to the contrary; it only claims that the use was likely to cause confusion. [See dkt. 99 at 16 (not claiming any fraudulent intent).] The Complaint is, therefore, missing a required statutory element and cannot state a claim for deception under § 35-43-5-3(a)(6).

With respect to the “false, misleading, or deceptive” advertising branch of deception, EA objects that the Complaint has no allegations of EA “advertising” using the John Dillinger name. [Dkt. 90 at 13.] Again, the Plaintiff makes no claim to the contrary. The Plaintiff’s collection of the “necessary facts to establish a claim of deception” that it contends are present in the Complaint omits any reference to any advertisement on EA’s part.¹⁴ This claim under § 35-43-5-3(a)(9) thus omits a statutory element and fails as a matter of law.

Accordingly, the Court will dismiss Count VI.

IV. CONCLUSION

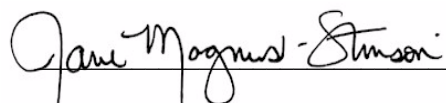
The Court now **GRANTS IN PART AND DENIES IN PART** EA’s motion for judgment on the pleadings. [Dkt. 89.] The motion is granted with respect to Counts I, II, and VI. It is also granted with respect to Count III only to the extent that Count III alleges violations of state law. In all other respects, the motion is denied.

Given that the Court has ruled in EA’s favor with respect to Count I, several other motions can now be summarily resolved. Plaintiff’s Motion for Partial Summary Judgment on Lia-

¹⁴ EA has asserted, and the Plaintiff doesn’t dispute, that its Complaint must satisfy the specificity requirements of Fed. R. 9(b) with respect to the deception claim. [See dkt. 99 at 16.]

bility Under Count I, [dkt. 152], is **DENIED**. EA's motion for a continuance to respond to Plaintiff's motion for partial summary judgment, [dkt. 171], is **DENIED AS MOOT**. EA's motion to enjoin certain state court proceedings that might interfere with the Court's ability to resolve Count I, styled as its Motion to Enjoin State Court Action *Dillinger, LLC v. Thompson*, [dkt. 186], is **DENIED AS MOOT**, and the Plaintiff's motion for leave to file a surreply to that motion, [dkt. 213], is likewise **DENIED AS MOOT** .

06/15/2011



Hon. Jane Magnus-Stinson, Judge
United States District Court
Southern District of Indiana

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