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22 DANIEL FARR, and BRYAN BRANDENBURG

23 **UNITED STATES DISTRICT COURT**
24 **SOUTHERN DISTRICT OF CALIFORNIA**

25 SAN DIEGO COMIC CONVENTION, a
26 California nonprofit corporation,

27 Plaintiff,

28 v.

DAN FARR PRODUCTIONS, a Utah limited
liability company; and DANIEL FARR and
BRYAN BRANDENBURG, individuals,

Defendants.

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

**MEMORANDUM OF POINTS
AND AUTHORITIES IN
SUPPORT OF DEFENDANTS'
MOTION FOR SUMMARY
JUDGMENT BASED ON
ABANDONMENT AND
ESTOPPEL**

Date: September 21, 2017
Time: 2:00 p.m.
Courtroom: 4A (4th Floor Schwartz)
Judge: Hon. Anthony Battaglia

AND RELATED COUNTERCLAIMS

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8	<i>FirstHealth of Carolinas, Inc. v. CareFirst of Maryland, Inc.</i> ,	
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Declaration of Bryan Brandenburg in Support of Defendants' Motions for Summary Judgment	Brandenburg decl.	Filed herewith
Declaration of Daniel Farr in Support of Defendants' Motions for Summary Judgment	Farr decl.	Filed herewith
Declaration of Daniel R. Barber in Support of Defendants' Motions for Summary Judgment	Barber decl.	Filed herewith
Declaration of Jessica D. Garcia in Support of Defendants' Motions for Summary Judgment	Garcia decl.	Filed herewith
Request for Judicial Notice in Support of Defendants' Motions for Summary Judgment	RFN	Filed herewith
Complaint For (1) Federal Trademark Infringement (15 U.S.C. § 1114); and (2) False Designation of Origin (15 U.S.C. § 1125(A)); Demand for Jury Trial	Complaint	ECF Doc. 1
Plaintiff's First Supplemental Responses to Defendants' First Set of Interrogatories to Plaintiff San Diego Comic Convention, dated April 21, 2017	Answers to 1st Rogs	Barber decl. Ex. 2
Plaintiff's Supplemental Responses to Defendants' Second Set of Interrogatories to Plaintiff San Diego Comic Convention, dated April 21, 2017	Answers to 2d Rogs	Barber decl. Ex. 3
Videotaped Deposition of Fae Desmond: 30(b)(6) Witness for SDCC and Individually, May 17, 2017	Desmond dep.	Barber decl. Ex. 4
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Title or other description	Short citation form	Location
Supplemental Expert Report of Jeffrey P. Kaplan, Ph.D. Pursuant to Fed. R. Civ. P. 26(a)(2)	Supplemental Kaplan report	Barber decl. Ex. 8
Videotaped Deposition of Daniel Farr, June 13, 2017	Farr dep.	Barber Decl. Ex. 9

1 Defendants and counterclaimants Dan Farr Productions, LLC, Daniel Farr, and
2 Bryan Brandenburg (collectively, “DFP”) offer the following points and authorities in
3 support of their motion for summary judgment based on abandonment and estoppel.

4 I. INTRODUCTION

5 As DFP shows in its companion motion for summary judgment based on
6 genericness, “comic con” is generic cultural terminology, part of the linguistic commons.
7 But in the 1990s plaintiff and counterdefendant San Diego Comic Convention (“SDCC”)
8 decided it should try to own that merely descriptive phrase. So SDCC began prosecuting
9 a series of applications to register marks with the United States Patent and Trademark
10 Office (“PTO”).

11 In 1995, SDCC applied to register COMIC CON (no hyphen). To resolve an
12 opposition filed by Chicago Comicon, Inc., SDCC abandoned that application. SDCC
13 waited a decade, and then applied to register COMIC-CON (with hyphen). When the
14 PTO’s examiner sensibly rejected the application, because “comic” and “con” simply
15 describe SDCC’s services, SDCC overcame the rejection by submitting a false
16 declaration attesting to exclusive use and on March 30, 2007, the PTO issued U.S.
17 Registration No. 3,219,568 (“’568 registration”). The hyphen is all that distinguishes the
18 ’568 registration from the failed 1995 application. SDCC uses the hyphenated form it
19 registered; DFP uses the unhyphenated form that SDCC abandoned, as part of the name
20 “Salt Lake Comic Con.”

21 Summary judgment should be granted based on genericness, as DFP shows in its
22 companion motion. Alternatively, as shown below, the Court should summarily
23 adjudicate SDCC’s infringement claims on two other grounds, each independently
24 dispositive. First, under controlling Ninth Circuit precedent, SDCC abandoned any rights
25 it may have had by granting a naked license (i.e., a license with insufficient oversight or
26 controls) for the [REDACTED] Second, because DFP relied on SDCC’s prior
27 indications that it *only* claims rights to the hyphenated form “comic-con,” SDCC is
28 estopped from asserting that DFP’s use of the *unhyphenated* form “comic con” infringes.

1 The Court should also summarily adjudicate DFP’s counterclaims for cancelation of at
2 least SDCC’s ’568 registration, based on abandonment.

3 **II. UNDISPUTED FACTS**

4 **A. SDCC’s Trademark Prosecution and Registrations**

5 SDCC asserts at least one and maybe as many as four trademark registrations in
6 this action,¹ viz.:

- 7 • U.S. Registration No. 2,218,236, for the word mark COMIC CON
- 8 INTERNATIONAL;
- 9 • The ’568 registration for the hyphenated word mark COMIC-CON;
- 10 • U.S. Registration No. 3,221,808, for the word-plus-design mark
- 11 shown to the left (“SDCC logo”); and
- 12 • U.S. Registration No. 4,425,806, for the word mark ANAHEIM
- 13 COMIC-COM.²



14 **1. SDCC’s Abandonment of the Unhyphenated form COMIC CON in**
15 **Favor of COMIC CON INTERNATIONAL**

16 Before obtaining the asserted registration(s), in 1995 SDCC filed an application to
17 register the unhyphenated form COMIC CON for “[e]ducation and entertainment
18 services, namely organizing and conducting conventions in the fields of animation, comic
19 books and popular art.”³ When that application was published, Chicago Comicon, Inc.
20 (“CCC”) filed an opposition on May 21, 1996. As grounds for its opposition, CCC
21 argued, *inter alia*, that “comic con” is merely descriptive and used by numerous third
22 parties to identify the services of organizing and conducting conventions in the field of
23 comic books and animation. As proof of the common and extensive use of “comic con”
24 by numerous third parties in 1996, CCC provided to the PTO (and SDCC) evidence of 23

25 _____
26 ¹ As DFP points out in its companion motion, SDCC’s pleading mentions four
registrations but could be read as asserting only one.

27 ² See generally Complaint.

28 ³ Desmond dep. 42:12–22; RFN Ex. 1, at DANFARR032422–24.

1 separate comic cons using comic con, comicon, comic-con, or other variations to identify
2 their services of organizing and conducting conventions in the field of comic books and
3 animation.⁴

4 [REDACTED]
5 [REDACTED]
6 [REDACTED]
7 [REDACTED]
8 [REDACTED]
9 [REDACTED]
10 [REDACTED]
11 [REDACTED]
12 [REDACTED]
13 [REDACTED]

14 [REDACTED]
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18 [REDACTED]
19 [REDACTED]
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21 [REDACTED]
22 [REDACTED]

23 [REDACTED]
24 [REDACTED]

26 _____
27 ⁴ Garcia decl. Ex. 5, at CC322423–56; RFN Ex. 6, at DANFARR033168–91.

28 [REDACTED]

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[REDACTED]

SDCC applied to register COMIC CON INTERNATIONAL on May 7, 1997, for “[e]ducation and entertainment services, namely, organizing and conducting conventions in the fields of animation, comic books and popular art.” COMIC CON INTERNATIONAL was registered on January 19, 1999. SDCC filed an “Express Withdrawal of Trademark Application” on March 19, 1999, expressly withdrawing its application to register COMIC CON. In view of SDCC’s “Express Withdrawal of Trademark Application” the Trademark Trial and Appeal Board found that SDCC had abandoned its application to register the unhyphenated form COMIC CON and dismissed the Opposition.⁷

2. SDCC’s Fraudulent Registration of the Hyphenated Form COMIC-CON, Alone and as the “Core Element” of other Marks

On September 15, 2005, SDCC applied to register COMIC-CON for “[e]ducation and entertainment services, namely, organizing and conducting conventions in the fields of animation, comic books and popular art.” On October 25, 2005, SDCC applied to register the SDCC logo for “[e]ducation and entertainment services, namely, organizing and conducting conventions in the fields of animation, comic books and popular art.” On April 5, 2006, the PTO’s examiner issued an office action rejecting SDCC’s application to register COMIC-CON on descriptiveness grounds because:

[REDACTED]

⁷ RFN Ex. 2, at DANFARR032425–27; DANFARR033217–20.

1 The term “comic,” as used in applicant’s proposed mark, is descriptive of
2 applicant’s services in that it merely describes the subject matter of applicant’s
3 conventions, namely, comic books. Please see attached definition of “comic.”
4 The term “con” is merely an abbreviation for the term “convention” which
5 describes applicant’s services, namely, comic conventions.⁸

6 Also on April 5, 2006, the PTO’s examiner issued an office action rejecting
7 SDCC’s application to register the SDCC logo on the ground that “SAN DIEGO COMIC
8 CON INTERNATIONAL” is merely descriptive and thus must be disclaimed. On
9 October 4, 2006, SDCC filed responses to the April 5, 2006 office actions. In both
10 responses, SDCC argued that: “even if the mark is descriptive, the mark has acquired
11 distinctiveness through Applicant’s use and is thus registerable [sic] under Section 2(f)”
12 of the Lanham Act, 15 U.S.C. § 1052(f).⁹

13 To show acquired distinctiveness, SDCC submitted declarations from its Executive
14 Director, Fae Desmond. In the declaration filed in the COMIC-CON case, Ms. Desmond
15 swore under penalty of perjury that “[t]he Mark has been used continuously and
16 exclusively in interstate commerce in connection with the service listed in the within
17 application by the Applicant for over 36 years” and that “[i]t is my belief that the Mark in
18 the comic industry has become exclusively associated with comic and popular art
19 conventions produced by Applicant.” In the declaration filed in the SDCC logo case, Ms.
20 Desmond swore that “[t]he Mark COMIC-CON (which is the core portion of the Mark)
21 has been used continuously since 1970.”¹⁰

22 By the time Ms. Desmond made her declarations attesting to SDCC’s allegedly
23 continuous and exclusive use, she and SDCC’s trademark prosecution counsel, who filed
24 and presumably drafted her declaration (and also serves as one of SDCC’s litigation
25 attorneys in this Action), knew that many third parties had long been using “comic con”

26 ⁸ RFN Ex. 4, at DANFARR032979; DANFARR033038–43; RFN Ex. 5, at
27 DANFARR033144–53.

28 ⁹ RFN Ex. 4, at DANFARR033028–37; RFN Ex. 5, at DANFARR033134–43.

¹⁰ RFN Ex. 4, at DANFARR033032–34 ¶¶ 5, 11; RFN Ex. 5, at DANFARR033129–30
¶ 5.

1 and “comic-con” in connection with comic book and animation conventions. Based upon
2 Ms. Desmond’s declarations attesting to continuous and exclusive use, on March 20,
3 2007 the PTO granted SDCC the ’568 registration for the hyphenated form COMIC-
4 CON, and on March 27, 2007 the PTO registered the SDCC logo.¹¹

5 SDCC applied to register ANAHEIM COMIC-CON on August 11, 2009 for
6 “[e]ducation and entertainment services, namely, organizing and conducting conventions
7 in the fields of animation, comic books and popular art.” On November 23, 2009, the
8 PTO’s examiner issued an office action rejecting SDCC’s application to register
9 ANAHEIM COMIC-CON on the ground that it is primarily geographically descriptive.
10 On May 21, 2010, SDCC filed a response (1) disclaiming “Anaheim,” thereby mooting
11 the geographically descriptive rejection, and (2) citing SDCC’s other registrations as
12 evidence that the rest of the claimed mark (i.e., COMIC-CON) had become distinctive.¹²

13 Based on SDCC’s representations in its May 21, 2010 response, the PTO required
14 SDCC to adopt the following statement in order for the application to issue: “The
15 COMIC-CON portion of the mark has become distinctive of the services as evidenced by
16 ownership of U.S. Registration Nos. 2,218,236 [COMIC CON INTERNATIONAL],
17 3,219,568 [COMIC-CON], and 3,221,808 [SDCC logo] on the Principal Register for the
18
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20

21 ¹¹ RFN Ex. 4, at DANFARR033023–27; DANFARR033032–34 ¶ 5; [REDACTED]
22 [REDACTED] RFN Ex. 5, at
23 DANFARR033116–22; RFN Ex. 6, at DANFARR033161–62, DANFARR033167–91
24 (citing to 23 different comic con or comic-con conventions existing in 1996); [REDACTED]
25 [REDACTED]

26 [REDACTED] SDCC’s fraud in
27 procuring its registrations is a recent discovery, in view of which Farr is trying to amend
28 its pleadings to add a further defense and counterclaim for inequitable conduct.

¹² RFN Ex. 3, at DANFARR032973–78; DANFARR032932–70; DANFARR032924–26.

1 same mark for related services.” On October 19, 2013, the PTO added ANAHEIM
2 COMIC-CON to its register.¹³

3 **B. SDCC’s Knowledge and Toleration of Third-Party Marks and Users**

4 [REDACTED]
5 Prior to initiating the instant lawsuit on August 7, 2014, SDCC had never initiated a
6 lawsuit to enforce its rights in any of its marks. Prior to initiating the instant lawsuit on
7 August 7, 2014, SDCC had never filed an administrative proceeding (*e.g.* opposition or
8 cancellation) with the PTO’s Trademark Trial and Appeal Board to enforce its rights in
9 any of its marks. [REDACTED]

10 [REDACTED]
11 [REDACTED]
12 [REDACTED]
13 [REDACTED]
14 [REDACTED]
15 [REDACTED]

16 [REDACTED]
17 [REDACTED]
18 [REDACTED]
19 [REDACTED]
20 [REDACTED]
21 [REDACTED]

23 ¹³ RFN Ex. 3, at DANFARR032918–22; DANFARR032832.

24 ¹⁴ Answers to 2d Rogs at 26; [REDACTED]
25 [REDACTED]
26 [REDACTED]
27 [REDACTED]
28 [REDACTED] RFN Ex. 7, at DANFARR033584; DANFARR033641–44.

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6 [REDACTED]

7 **3. SDCC’s Knowing Tolerance of Other Users**

8 [REDACTED]
9 Indeed SDCC has allowed other comic cons to exhibit and advertise at SDCC’s own
10 event, including Amazing Comic Con (producers of Amazing Houston Comic Con,
11 Amazing Las Vegas Comic Con, and Amazing Phoenix Comic Con) and Phoenix Comic
12 Con. SDCC also has actual knowledge of the widespread use of “comic con” and its
13 variants by numerous other third party conventions, [REDACTED]

14 [REDACTED]
15 [REDACTED]

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

28 [REDACTED]

1 [REDACTED]
2 [REDACTED]

3 **C. History of Salt Lake Comic Con and Adoption of its Mark**

4 Defendants Bryan Brandenburg and Daniel Farr are co-founders of defendant Dan
5 Farr Productions, which organizes and produces Salt Lake Comic Con. Before adopting
6 the mark SALT LAKE COMIC CON, DFP:

- 7 • Reviewed the publicly available summary of SDCC’s abandoned application
8 for the unhyphenated form COMIC CON and its successful application for
9 the hyphenated form COMIC-CON;
- 10 • Learned that Wizard World Inc. had acquired Chicago Comicon, Inc., whose
11 opposition forced SDCC’s abandonment of its application to register the
12 unhyphenated form COMIC CON;²²

13 _____
14 ²¹ Answers to 1st Rogs at 7–8 (admitting knowledge of 35 separate comic cons with
15 names that include “comic con” or “comic-con” as of the filing of this lawsuit on August
16 7, 2014); Brandenburg decl. ¶ 17; [REDACTED]

17 [REDACTED]
18 [REDACTED]
19 [REDACTED]

20 [REDACTED] Garcia decl. Ex. 3, at CC067438–39 (Baltimore Comic Con in 2010); CC071941–
21 42 (“Yeah the convention calendar is getting amazingly crowded.”); CC068717–18
22 (Phoenix Comic Con, Tucson Comic Con and Amazing Arizona Comic Con in 2011);
23 CC076671–85 (New Orleans Comic Con in 2012); CC086310 (Denver Comic Con and
24 Albuquerque Comic Con in 2012); [REDACTED]

25 [REDACTED]
26 [REDACTED] Garcia decl. Ex. 5, at CC322431 (Pittsburg Comicon in 1996); Garcia decl.
27 Ex. 7, at CC415475; CC415055; Glanzer dep. 40:2–17; [REDACTED]
28 [REDACTED] Complaint ¶ 12.

²² Brandenburg decl. ¶¶ 11–15; Farr Dep. 57:18–58:4.

- 1 • Recognized that SDCC always or almost always uses the hyphenated form
2 COMIC-CON in reference to itself, and that many third-parties use the
3 unhyphenated form COMIC CON (or other forms) for their conventions,
4 including the various Wizard World events, New York Comic Con, Emerald
5 City Comic Con, Denver Comic Con, Phoenix Comicon, The Amazing Las
6 Vegas Comic Con, Florida Supercon, Alamo City Comic Con, Rhode Island
7 Comic Con, and Lexington Comic Con;²³ and
- 8 • Was aware that SDCC allows other comic cons, including comic cons who
9 use “comic con,” to advertise and exhibit at their events.

10 Based on its review of prosecution histories for COMIC CON and COMIC-CON, and
11 based also on its awareness that SDCC favors the hyphenated form COMIC-CON and
12 tolerates third-party use of the other forms (such as the unhyphenated form COMIC
13 CON), DFP rightly concluded that SDCC claimed no rights in the unhyphenated form
14 COMIC CON—and also that SDCC would not object to DFP’s use of COMIC CON in
15 the name of its event, especially if DFP used COMIC CON with the geographic indicator
16 “Salt Lake” and avoided use of the hyphenated form COMIC-CON. DFP relied on all
17 that when it selected the mark SALT LAKE COMIC CON.²⁴

18 The inaugural Salt Lake Comic Con was held in Salt Lake City, Utah on
19 September 5–7, 2013. SDCC Executive David Glanzer attended the 2013 Salt Lake
20 Comic Con and reported on it to SDCC Executive Director Fae Desmond. The 2013 Salt
21 Lake Comic Con was a great success, the third largest comic con in the U.S. that year.

22 DFP’s first organization-to-organization, executive-level contact with SDCC came
23 in November 2013, when DFP emailed SDCC Executive Director Fae Desmond:

25 ²³ Farr decl. Ex. F, at DANFARR031806; Brandenburg decl. Ex. 2, at
26 DANFARR033592; Farr decl. Ex. A, at DANFARR016544–45; Farr decl. Ex. C, at
27 DANFARR016578; Farr decl. Ex. D, at DANFARR020457–61; Brandenburg decl. ¶ 16;
28 Farr Dep. 60:5–12.

²⁴ Brandenburg decl. ¶¶ 18-19.

1 Jason Palmer suggested that it would be a good idea for us to open the
2 communication channels between our two organizations. *I am the producer*
3 *of the Salt Lake Comic Con/FanXperience* events. We had our first year show
4 of over 70,000 people and we expect it will continue to grow significantly due
5 to the market reception. I don't necessarily have any specific agenda but felt
6 that it would be nice to open the channels of communication and get to know
7 each other a bit.

8 Even though that email disclosed DFP's use of the unhyphenated form COMIC CON to
9 name a very successful convention, the email drew no response from SDCC. In April
10 2014, DFP produced the Salt Lake Comic Con FanX. In 2014, DFP "skinned" a vehicle
11 with advertising for the second Salt Lake Comic Con; and in July 2014, DFP displayed
12 that vehicle near the venue of SDCC's 2014 convention.²⁵

13 SDCC waited until July 25, 2014, after DFP had already produced the 2013 Salt
14 Lake Comic Con and the 2014 Salt Lake Comic Con FanX and invested in advertising
15 for the 2014 Salt Lake Comic Con, before complaining of DFP's use of COMIC CON in
16 the name of its event. By that time, DFP's SALT LAKE COMIC CON brand had already
17 developed significant goodwill, due to the success of the 2013 and April 2014 shows and
18 advertising already undertaken for the September 2014 show.²⁶

19 III. ARGUMENT

20 This motion presents two grounds for summary judgment. The choice between
21 them depends on how SDCC's trademark prosecution and (non-)enforcement are
22 understood. One understanding is that SDCC disclaimed the unhyphenated form COMIC
23 CON by (1) abandoning its application to register the unhyphenated form, (2) registering
24 the hyphenated form instead, (3) using only the hyphenated form, and (4) tolerating third-
25 party uses of the unhyphenated form. So construed, the history estops SDCC from now
26 asserting that DFP's use of the unhyphenated form infringes SDCC's registration of the

27 ²⁵ Brandenburg decl. ¶¶ 24; Farr Decl. ¶ 10; See Complaint ¶ 20; see also Desmond dep.
28 120:8–11; ██████████ CC145977.

²⁶ See Complaint ¶ 30; Brandenburg decl. ¶¶ 26–29, 35; See, e.g., Garcia decl. Ex. 4, at
CC145873.

1 hyphenated form and summary judgment should be granted on that ground. If, on the
 2 other hand, SDCC insists that the unhyphenated form is confusingly similar to the
 3 hyphenated form then SDCC's naked licensure [REDACTED]
 4 constitutes abandonment and summary judgment should be granted on that ground.²⁷
 5 DFP begins with naked licensing.

6 **A. SDCC Abandoned any Trademark Rights by Engaging in Naked Licensing**

7 "[N]aked licensing, without any control over the quality of goods produced by the
 8 licensee, ... constitutes abandonment of any rights to the trademark by the licensor."²⁸
 9 Ordinarily, "[a]bandonment is a question of fact",²⁹ but here the basis for abandonment,
 10 naked licensure, is an issue of law.³⁰ Here, SDCC "engaged in naked licensing and
 11
 12
 13

14 ²⁷ Two of SDCC's four registrations (for COMIC-CON and ANAHEIM COMIC-CON)
 15 include the hyphenated form COMIC-CON, the other two (for COMIC CON
 16 INTERNATIONAL and the SDCC logo) do not. But because Farr does not use any
 17 elements of those unhyphenated marks other than COMIC CON, both grounds presented
 18 by this motion foreclose any finding of actionable infringement of all four registrations
 19 by foreclosing any claim that SDCC either has (abandonment) or can assert (estoppel) a
 20 protectable interest in the unhyphenated form COMIC CON.

21 ²⁸ *Barcamerica Int'l v. Tyfield Importers, Inc.*, 289 F.3d 589, 598 (9th Cir. 2002) (quoting
 22 *First Interstate Bancorp v. Stenquist*, 16 U.S.P.Q.2d 1704, 1706 (N.D. Cal. 1990))
 23 (affirming summary judgment of noninfringement and cancelation of registration, based
 24 on abandonment). If this case were to go to trial, the sheer extent of third-party use SDCC
 25 tolerated would furnish an additional ground for a jury or directed verdict in Farr's favor;
 26 [REDACTED]
 27 [REDACTED]

28 ²⁹ *FirstHealth of Carolinas, Inc. v. CareFirst of Md., Inc.*, 479 F.3d 825, 830 (Fed. Cir. 2007).

³⁰ *See Glass Equip. Devel., Inc. v. Besten, Inc.*, 174 F.3d 1337, 1341 (Fed. Cir. 1999)
 ("The existence of an implied license is a question of law ..."); *see also Local Motion, Inc. v. Niescher*, 105 F.3d 1278, 1280 (9th Cir. 1997) (because the existence of "a valid enforceable contract is a matter of law, ... it was proper for the court to determine this issue on summary judgment").

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 [REDACTED]
14 [REDACTED]
15 [REDACTED]
16 [REDACTED]
17 [REDACTED]
18 [REDACTED]
19 [REDACTED]
20 [REDACTED]
21 [REDACTED]

22 [REDACTED] The next questions are: What kind of agreement did SDCC make? And is it

- 23 _____
24 [REDACTED]
25 [REDACTED]
26 [REDACTED]
27 [REDACTED]
28 [REDACTED]

1 a consent agreement or a license? That matters because granting a naked license works
2 abandonment but entering into a consent agreement might not.

3 In a license, the licensee is engaging in acts which would infringe the
4 licensor’s mark but for the permission granted in the license. ... But in a
5 consent, the consentee is permitted to engage in defined actions which do not
6 infringe the consenter’s mark, and the agreement implicitly or explicitly
7 recognizes that.⁴⁰

8 Thus “the very essence of [a consent] agreement,” as opposed to a license, is “that
9 concurrent usage does not lead customers to link the goods or services of the parties.”⁴¹

10 Conversely, where concurrent usage *does* create confusion (or a “link”), the agreement is
11 not mere consent but licensure. Accordingly, “[a]n agreement consenting to a clearly
12 confusing use may also be interpreted as an unsupervised license ... thus endangering the
13 continued validity of the trademark.”⁴²

14 Here, SDCC alleges that “Salt Lake Comic Con” is confusingly similar to COMIC-
15 CON.⁴³ That is, according to SDCC: the unhyphenated term “Comic Con,” appended to a
16 location, is confusingly similar to the hyphenated term “Comic-Con,” standing alone.
17 SDCC cannot retreat from that position unless it also thereby surrenders its claims against
18 DFP. [REDACTED]

19 [REDACTED]

20 _____
21 ⁴⁰ *Oreck Corp. v. Thomson Consumer Elecs., Inc.*, 796 F. Supp. 1152, 1157 n. 8 (S.D.
22 Ind. 1992) (quoting J. Thomas McCarthy, *Trademarks and Unfair Competition* § 18:25,
p. 866 (2d ed. 1984)).

23 ⁴¹ *Oreck*, 796 F. Supp. at 1157 n. 8 (quoting McCarthy).

24 ⁴² *Restatement (Third) of Unfair Competition* § 29 cmt. b.

25 ⁴³ See Complaint, ECF Doc. 1, ¶ 18.

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

3. SDCC Licensed ██████ Without any Adequate Controls

“‘Naked licensing’ occurs when the licensor ‘fails to exercise adequate quality control over the licensee.’”⁴⁵ “When deciding summary judgment on claims of naked licensing, we first determine whether the license contained an *express* contractual right to inspect and supervise the licensee’s operations.”⁴⁶ ██████

“[W]here courts have excused the lack of a contractual right to control quality, they have still required that the licensor demonstrate *actual* control through inspection or supervision.”⁴⁸ ██████

Finally, “reliance on a licensee’s own quality control efforts” may be “*relevant*” to whether a license is naked.⁵⁰ But “such reliance is *not alone sufficient* to show that a naked license has not been granted”: “reliance on a licensee’s own control quality efforts is not enough ... without other indicia of control.”⁵¹ Moreover the Ninth Circuit “require[s] that the licensor and licensee be involved in a ‘close working relationship’ to establish adequate quality control in the absence of a formal agreement.”⁵² ██████

⁴⁵ *FreecycleSunnyvale*, 626 F.3d at 515 (quoting *Barcamerica*, 289 F.3d at 596).

⁴⁶ *FreecycleSunnyvale*, 626 F.3d at 516 (italics added).

⁴⁸ *FreecycleSunnyvale*, 626 F.3d at 516–17.

⁵⁰ See *FreecycleSunnyvale*, 626 F.3d at 519 (italics added).

⁵¹ *FreecycleSunnyvale*, 626 F.3d at 519.

⁵² *FreecycleSunnyvale*, 626 F.3d at 518.

⁵³ See *FreecycleSunnyvale*, 626 F.3d at 519.

1 Because a mark should “function as a symbol of quality,” “trademark owners have
2 a duty to control ... quality” and “naked licensing is ‘*inherently deceptive*.’”⁵⁴ ■

3 ■
4 ■, SDCC has deceived the public and
5 abandoned any rights it has in its so-called “‘COMIC-CON’ family of service marks.”⁵⁵

6 **B. SDCC Is Estopped by its Own Conduct from Asserting that DFP’s Use of**
7 **“Comic Con” Infringes**

8 In 1995, SDCC applied to register COMIC CON, without a hyphen; when that
9 application was opposed, SDCC abandoned it. Then, several years later, SDCC applied to
10 register COMIC-CON, with a hyphen; that application was granted, and SDCC has
11 consistently used the hyphenated form ever since (and even before, according to its own
12 witness). As shown below that conduct, together with SDCC’s longstanding and
13 widespread tolerance for the use of the unhyphenated form by ■ others, estops
14 SDCC from now contending that DFP’s use of the unhyphenated form “comic con,”
15 together with a geographic identifier, infringes SDCC’s COMIC-CON registration.⁵⁶

16 **1. SDCC Communicated to DFP and the Public at Large that the Space in**
17 **COMIC CON Distinguishes it from COMIC-CON**

18 On July 26, 1995, SDCC applied to register COMIC CON, but CCC opposed on
19 the ground that the putative mark “when applied to ... organizing and conducting
20 conventions in the fields of comic books and animation, is merely descriptive in that said
21

22 ⁵⁴ *FreecycleSunnyvale*, 626 F.3d at 515–16 (quoting *Barcamerica*, 289 F.3d at 598).

23 ⁵⁵ See Complaint, ¶ 13; *Barcamerica*, 289 F.3d at 598 (“where a trademark owner
24 engages in naked licensing, without any control over the quality of goods produced by
25 the licensee, such a practice is *inherently deceptive* and constitutes abandonment of any
26 rights to the trademark by the licensor” (quoting *First Interstate*, 16 U.S.P.Q.2d at
1706)).

27 ⁵⁶ “The existence of an estoppel is generally a question of fact” but “[w]hen the evidence
28 is not in conflict and is susceptible of only one reasonable inference, the existence of an
estoppel is a question of law.” *Driscoll v. City of L.A.*, 431 P.2d 245, 250 (Cal. 1967).

1 mark is an apt and common term used to describe services of that nature.”⁵⁷ [REDACTED]
2 [REDACTED]
3 [REDACTED]
4 [REDACTED]
5 [REDACTED]
6 [REDACTED]
7 [REDACTED]
8 [REDACTED]
9 [REDACTED]
10 [REDACTED]
11 [REDACTED]
12 [REDACTED]
13 [REDACTED]
14 [REDACTED]
15 [REDACTED]
16 [REDACTED]
17 [REDACTED]
18 [REDACTED]
19 [REDACTED]
20 [REDACTED]
21 [REDACTED]
22 [REDACTED]
23 [REDACTED]
24 [REDACTED]
25 [REDACTED]
26 [REDACTED]
27 [REDACTED]
28 [REDACTED]

1 [REDACTED]
 2 [REDACTED]
 3 [REDACTED]
 4 [REDACTED]
 5 [REDACTED]
 6 [REDACTED]
 7 [REDACTED]
 8 [REDACTED]
 9 [REDACTED] SDCC
 10 withdrew its application to register COMIC CON, [REDACTED]

11 But then on September 15, 2005, SDCC applied to register the hyphenated form
 12 COMIC-CON.⁶⁴ SDCC’s abandonment of COMIC CON and subsequent registration of
 13 COMIC-CON put the public on notice that SDCC sees a distinction between them.⁶⁵

14 **2. DFP Prejudicially Relied on SDCC’s Assurances**

15 [REDACTED], it must have perceived
 16 some meaningful difference between the hyphenated form, COMIC-CON, and the
 17 unhyphenated form [REDACTED], COMIC CON. [REDACTED]

18 _____
 19 [REDACTED]

20 [REDACTED]

21 ⁶³ See RFN Ex. 6, at DANFARR033217.

22 ⁶⁴ See Complaint Ex. A.

23 ⁶⁵ Fortifying the reasonable inference that SDCC distinguishes the hyphenated and
 24 unhyphenated forms—in order to obtain registration of the hyphenated form COMIC-
 25 CON, SDCC submitted a declaration attesting that SDCC had used “[t]he hyphenated
 26 form “continuously *and exclusively*.” See RFN Ex. 4, at DANFARR033032–34, ¶ 5
 27 (italics added). Because third-party use of the unhyphenated form COMIC CON has an
 28 even better documented history than third-party use of the hyphenated form COMIC-
 CON, the one interpretation of that declaration is that SDCC claimed to have used the
hyphenated form exclusively. Another interpretation is that SDCC intentionally mislead
 the Trademark office.

1 [REDACTED]
2 [REDACTED]
3 [REDACTED]
4 [REDACTED]
5 [REDACTED]

6 [REDACTED] But DFP,
7 when deciding how to brand its event, was aware of and relied upon (1) SDCC’s
8 abandonment of COMIC CON and subsequent registration of COMIC-CON, (2) [REDACTED]
9 [REDACTED] and (3) unmolested uses by others of
10 “comic con” as part of their compound marks.⁶⁶ DFP also observed that SDCC’s website
11 and other materials consistently used COMIC-CON, not “comic con.”⁶⁷

12 DFP would be prejudiced if now burdened with liability or forced to abandon the
13 goodwill it has already built up around “Salt Lake Comic Con.”⁶⁸ DFP’s prejudicial
14 reliance on SDCC’s assurances estops SDCC from now asserting infringement of
15 COMIC-CON by DFP’s use of the unhyphenated and geographically qualified phrase
16 “Salt Lake Comic Con.”

17 **3. SDCC Is Estopped from Asserting that DFP’s Use of the Unhyphenated**
18 **Phrase “Comic Con” Infringes SDCC’s Registration of COMIC-CON**

19 Equitable estoppel has four elements:
20 (1) the party to be estopped must be apprised of the facts; (2) he must intend
21 that his conduct shall be acted upon, or must so act that the party asserting the
22 estoppel had a right to believe it was so intended; (3) the other party must be
23 ignorant of the true state of facts; and (4) he must rely upon the conduct to his
injury.⁶⁹

24 _____
25 ⁶⁶ See Brandenburg decl. ¶¶ 11–19; Farr dep. 57:18–58:4, 107:19–108:11.
26 [REDACTED]
27 [REDACTED]

28 ⁶⁸ See Brandenburg decl. ¶¶ 35; Farr dep. 57:18–58:4.W

⁶⁹ *Driscoll v. City of L.A.*, 431 P.2d 245, 250 (Cal. 1967).

1 Generally, estoppel arises “when representations have been made to [the] legal person,
 2 who has relied upon them”; but estoppel also may “arise in favor of the general public ...
 3 the general public can avail itself of an estoppel in favor of a legal person.”⁷⁰ What
 4 matters is that “the party to be estopped ... should have ... expected, that his or her
 5 conduct ... will be acted upon ... by other persons.”⁷¹

6 Here, only SDCC could know whether it considered marks using “comic con” with
 7 a geographic descriptor to be confusingly similar to its own putative mark(s)—
 8 notwithstanding all its public manifestations to the contrary. Thus “the party to be
 9 estopped [was] apprised of the facts.”⁷²

10 Second, SDCC should have foreseen that DFP or others, faced with the
 11 conjunction of (1) SDCC’s abandonment of its application to register the unhyphenated
 12 form COMIC CON, (2) SDCC’s registration of the hyphenated form COMIC-CON, (3)
 13 SDCC’s consistent use of the hyphenated form COMIC-CON, and (4) SDCC’s wide-
 14 ranging acquiescence in others’ use of the unhyphenated form COMIC CON would
 15 conclude that SDCC does not consider the use of “comic con,” especially in conjunction
 16 with a distinct geographic identifier, to be an infringement of COMIC-CON. At a
 17 minimum, SDCC’s conduct gave DFP “a right to believe it was so intended.”⁷³

18
 19
 20 ⁷⁰ *St. Louis v. Clegg*, 233 S.W. 1, 3 (Mo. 1921) (*Clegg* is a property-rights case, involving
 21 a public easement, but “the application of the doctrine of equitable estoppel to
 22 controversies centered upon title to land involves the same basic factors of the doctrine as
 23 are brought into play in other areas of the law.”); *Long Beach v. Mansell*, 476 P.2d 423,
 442 (Cal. 1970).

24 ⁷¹ See 28 Am. Jur. 2d *Estoppel and Waiver* § 45 (May 2017 update) (More fully:
 25 “Generally, one of the essential elements of equitable estoppel, as far as the party to be
 26 estopped is concerned, is that he or she should have intended, or at least have expected,
 27 that his or her conduct on which it is sought to predicate the estoppel will be acted upon
 28 by the other party or by other persons.”).

⁷² *Cf. Driscoll*, 431 P.2d at 250.

⁷³ *Cf. Driscoll*, 431 P.2d at 250.

1 Coming now to the third element, DFP did not know that SDCC would consider
 2 DFP's use of "comic con" with "Salt Lake," to form "Salt Lake Comic Con," an
 3 infringement.⁷⁴ And finally, as explained above, DFP relied on SDCC's conduct, to what
 4 would now be DFP's injury if SDCC were allowed to maintain its infringement claims.⁷⁵

5 DFP's detrimental reliance on SDCC's conduct estops SDCC from now asserting
 6 that DFP's use of the common form, "[Location] Comic Con," infringes COMIC-CON.

7 **C. SDCC's Registrations Should Be Canceled**

8 If the Court finds abandonment then it should not only rule against SDCC on its
 9 infringement and false designation of origin claims: it should also cancel SDCC's
 10 registrations. The Court is authorized by statute to "order the cancelation of
 11 registrations,"⁷⁶ and cancelation is proper "if the registered mark ... has been
 12 abandoned."⁷⁷

13 **IV. CONCLUSION**

14 SDCC abandoned its rights by engaging in naked licensing [REDACTED]
 15 [REDACTED] Alternatively,
 16 SDCC is estopped by its prior conduct from claiming that DFP infringes SDCC's
 17 COMIC-CON registration by employing the standard naming practice "[Location] Comic
 18 Con." Either way, the Court should grant DFP summary judgment on SDCC's claims;
 19 and if the Court finds naked licensure then it should also cancel SDCC's registrations.
 20
 21
 22

23 ⁷⁴ See Brandenburg decl. ¶ 20; Farr dep. 60:1–12; Cf. *Driscoll*, 431 P.2d at 250 (“(3) the
 24 other party must be ignorant of the true state of facts”).

25 ⁷⁵ See Brandenburg decl. ¶ 35; Cf. *Driscoll*, 431 P.2d at 250 (“(4) he must rely upon the
 26 conduct to his injury”).

27 ⁷⁶ 15 U.S.C. § 1119 (“In any action involving a registered mark the court may ... order
 the cancelation of registrations ... and otherwise rectify the register ...”).

28 ⁷⁷ 15 U.S.C. § 1064(3).

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