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

WEBCELEB, INC.,

Plaintiff,

vs.

THE PROCTER & GAMBLE COMPANY,  
et al.,

Defendants.

CASE NO. 10cv2318 DMS (BLM)

**ORDER GRANTING  
DEFENDANTS' MOTION FOR  
SUMMARY JUDGMENT**

**[Docket No. 68]**

This case comes before the Court on Defendants' motion for summary judgment.<sup>1</sup> Plaintiff filed an opposition to the motion, and Defendants filed a reply. For the reasons set out below, the Court grants the motion.

**I.**

**BACKGROUND**

Plaintiff Webceleb, Inc.:

is the owner of U.S. Trademark Registration No. 3756711 for the mark WEBCELEB in international class 042 for "Providing temporary use of on-line non-downloadable software to enable uploading, posting, showing, displaying, tagging, blogging, sharing, or otherwise providing electronic media or information in the field of general interest over the Internet or other communications network."

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<sup>1</sup> Defendants BermanBraun Interactive, LLC and Microsoft Corporation filed the motion, and Defendant The Procter & Gamble Company filed a Notice of Joinder in the motion.

1 (First Am. Compl. ¶ 7.) Plaintiff “operates an online social marketplace for independent music that  
2 brings independent musicians and music fans together.” (*Id.* ¶ 9.) The musicians use Plaintiff’s  
3 platform to distribute their music directly to fans, and fans use the platform to browse for and purchase  
4 music. (*Id.*) Plaintiff also produces concerts featuring artists on Plaintiff’s website. (*Id.* ¶ 11.)

5 In October 2010, Plaintiff experienced an unexpected number of visitors to its website. (*Id.* ¶  
6 17.) Plaintiff discovered this spike in virtual traffic was caused by Defendants’ advertising and  
7 promotion of a category of the People’s Choice Awards, namely the “Web Celeb” category. (*Id.* ¶ 18.)

8 On November 9, 2010, Plaintiff filed the present case against Defendant Procter & Gamble  
9 (“P&G”) alleging claims for trademark infringement under the Lanham Act and unfair competition  
10 pursuant to California Business and Professions Code § 17200. P&G sponsors and produces the live  
11 telecast of the People’s Choice Awards show. (Defs.’ Separate Statement in Supp. of Mot., Undisputed  
12 Material Fact No. 9.)

13 Plaintiff filed a First Amended Complaint on October 11, 2011, alleging the same claims but  
14 adding Defendants BermanBraun and Microsoft. In Spring 2009, Defendant BermanBraun partnered  
15 with P&G to co-present an award for the People’s Choice Awards honoring a category of celebrities  
16 using the internet in an interesting way, or celebrities with a strong internet presence. (*Id.*, Fact No. 18.)  
17 Defendants decided to name the award “Favorite Web Celeb.” (*Id.*, Fact No. 20.)

18 Thereafter, Defendants used that name on the website [www.wonderwall.com](http://www.wonderwall.com), which is an online  
19 magazine that provides entertainment and celebrity content. (*Id.*, Fact Nos. 16, 21.) Defendants’ use  
20 of that name on the website “appeared in conjunction with images of and/or editorial content about  
21 prominent celebrities being considered for the ‘Favorite Web Celeb’ award.” (*Id.*, Fact No. 22.) When  
22 Defendants used the name on the website, their own trademarks were also displayed. (*Id.*, Fact No. 24.)  
23 Defendants also used the name of the award in videos about, including exclusive interviews with, the  
24 nominees for the award. (*Id.*, Fact No. 26.)

## 25 II.

### 26 DISCUSSION

27 Defendants move for summary judgment on Plaintiff’s First Amended Complaint. They raise  
28 several arguments. First, they assert their use of the term “web celeb” is not commercial speech,

1 therefore it is not covered by the Lanham Act. Second, Defendants argue their use of the term “web  
2 celeb” is protected by the First Amendment. Third, Defendants contend they are entitled to judgment  
3 pursuant to the classic fair use doctrine.

4 **A. Standard of Review**

5 Summary judgment is appropriate if there is no genuine issue as to any material fact, and the  
6 moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). The moving party has  
7 the initial burden of demonstrating that summary judgment is proper. *Adickes v. S.H. Kress & Co.*, 398  
8 U.S. 144, 157 (1970). The moving party must identify the pleadings, depositions, affidavits, or other  
9 evidence that it “believes demonstrates the absence of a genuine issue of material fact.” *Celotex Corp.*  
10 *v. Catrett*, 477 U.S. 317, 323 (1986). “A material issue of fact is one that affects the outcome of the  
11 litigation and requires a trial to resolve the parties’ differing versions of the truth.” *S.E.C. v. Seaboard*  
12 *Corp.*, 677 F.2d 1301, 1306 (9th Cir. 1982).

13 The burden then shifts to the opposing party to show that summary judgment is not appropriate.  
14 *Celotex*, 477 U.S. at 324. The opposing party’s evidence is to be believed, and all justifiable inferences  
15 are to be drawn in its favor. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255 (1986). However, to  
16 avoid summary judgment, the opposing party cannot rest solely on conclusory allegations. *Berg v.*  
17 *Kincheloe*, 794 F.2d 457, 459 (9th Cir. 1986). Instead, it must designate specific facts showing there  
18 is a genuine issue for trial. *Id.* More than a “metaphysical doubt” is required to establish a genuine  
19 issue of material fact.” *Matsushita Elec. Indus. Co., Ltd. v. Zenith Radio Corp.*, 475 U.S. 574, 586  
20 (1986). **B. Legal Background**

21 The primary issue in this case is whether Defendants’ use of “web celeb” infringes Plaintiff’s  
22 trademark. “A trademark is a word, phrase or symbol that is used to identify a manufacturer or sponsor  
23 of a good or the provider of a service.” *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9<sup>th</sup> Cir.  
24 2002). Federal registration of a trademark is “the owner’s way of preventing others from duping  
25 consumers into buying a product they mistakenly believe is sponsored by the trademark owner.” *Id.*  
26 *See also Mattel Inc. v. Walking Mountain Productions*, 353 F.3d 792, 806 (9<sup>th</sup> Cir. 2003) (“Trademark  
27 law aims to protect trademark owners from a false perception that they are associated with or endorse

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2 product.”) The core purpose of a trademark is “avoiding confusion in the marketplace[.]” *MCA*, 296  
3 F.3d at 900.

4 In the Ninth Circuit, the traditional test for trademark infringement is the “likelihood of  
5 confusion” test.<sup>2</sup> This test requires consideration of eight factors: “1) strength of the mark; 2) proximity  
6 or relatedness of the goods; 3) similarity of the marks; 4) evidence of actual confusion; 5) marketing  
7 channels; 6) type of goods and degree of purchaser care; 7) intent in selecting mark; and 8) likelihood  
8 of expansion.” *Walter*, 210 F.3d at 1111 (citing *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-39 (9<sup>th</sup>  
9 Cir. 1979)). Consideration of all these factors, however, may not be appropriate or necessary in all cases  
10 of alleged trademark infringement. For instance, in this case Defendants assert they are entitled to  
11 judgment under the “artistic relevance” test and the fair use doctrine, neither of which, according to  
12 Defendants, requires consideration of the likelihood of confusion factors. Plaintiff disputes these  
13 arguments, and urges the Court to consider all of the factors under a traditional infringement analysis.

#### 14 **C. Commercial Speech**

15 Defendants’ first argument in support of their request for summary judgment is that their use of  
16 “web celeb” was not commercial speech, therefore the Lanham Act does not apply. Defendants do not  
17 present any evidence to support their argument, choosing instead to rely on legal argument. However,  
18 none of the cases cited supports a finding that the speech at issue here is non-commercial. Indeed, the  
19 evidence Defendants submitted, at a minimum, raises a genuine issue of material fact about the nature  
20 of their speech. That evidence reflects advertising on the Wonderwall website, (*See Weetman Decl.*,  
21 ¶ 12), which would render the speech commercial. *See American Univ. of Antigua College of Medicine*  
22 *v. Woodward*, 837 F.Supp.2d 686, 692 (E.D. Mich. 2011) (stating use of mark on website that does not  
23 sell, distribute or advertise any goods or services is not commercial use); *Savannah College of Art and*  
24 *Design, Inc. v. Houeix*, 369 F.Supp.2d 929, 942-48 (S.D. Ohio 2004) (same). Accordingly, this  
25 argument does not warrant summary judgment in Defendants’ favor.

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27 <sup>2</sup> Plaintiff’s other claim also turns on the likelihood of confusion test. *See Walter v. Mattel,*  
28 *Inc.*, 210 F.3d 1108, 1110 n.1 (9<sup>th</sup> Cir. 2000) (stating unfair competition claims under California law  
were “coextensive . . . because all of the claims turn on the sufficiency of proof of likelihood of  
confusion.”).

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3 **D. Artistic Relevance Test**

4 Defendants' next argument is their use of "web celeb" is protected by the artistic relevance test.  
5 The artistic relevance test was first set out by the Second Circuit in *Rogers v. Grimaldi*, 875 F.2d 994  
6 (2d Cir. 1989). That case concerned an Italian film created and directed by Federico Fellini entitled  
7 "Ginger and Fred." *Id.* at 996. "The film tells the story of two fictional Italian cabaret performers,  
8 Pippo and Amelia, who, in their heyday, imitated Rogers and Astaire and became known in Italy as  
9 'Ginger and Fred.' The film focuses on a televised reunion of Pippo and Amelia, many years after their  
10 retirement." *Id.* at 996-97. After distribution of the film, Ginger Rogers filed suit against the film's  
11 producers and distributors for violation of the Lanham Act, violation of Rogers' right of publicity and  
12 right to privacy, and for defamation. On summary judgment, the district court dismissed the plaintiff's  
13 claims. In dismissing the Lanham Act claim, the district court effectively created "a nearly absolute  
14 privilege for movie titles, insulating them from Lanham Act claims as long as the film itself is an artistic  
15 work, and the title is relevant to the film's content." *Id.* at 997.

16 The Second Circuit affirmed the district court's dismissal of the plaintiff's Lanham Act claim,  
17 but applied a slightly different approach. The court recognized the First Amendment concerns involved,  
18 and stated: "Movies, plays, books, and songs are all indisputably works of artistic expression and  
19 deserve protection." *Id.* However, the court recognized that these art forms "are also sold in the  
20 commercial marketplace like other more utilitarian products, making the danger of consumer deception  
21 a legitimate concern that warrants some government regulation." *Id.* Nevertheless, the court found "the  
22 expressive element of titles requires more protection than the labeling of ordinary commercial products"  
23 because:

24 Titles, like the artistic works they identify, are of a hybrid nature, combining artistic  
25 expression and commercial promotion. The title of a movie may be both an integral  
26 element of the film-maker's expression as well as a significant means of marketing the  
27 film to the public. The artistic and commercial elements of titles are inextricably  
28 intertwined. Film-makers and authors frequently rely on word-play, ambiguity, irony,  
and allusion in titling their works. Furthermore, their interest in freedom of artistic  
expression is shared by their audience. The subtleties of a title can enrich a reader's  
or a viewer's understanding of a work. Consumers of artistic works thus have a dual  
interest: They have an interest in not being misled and they also have an interest in  
enjoying the results of the author's freedom of expression.

1 *Id.* at 998.

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4 In an effort to balance those interests, the court created the artistic relevance test, which  
5 precludes liability under the Lanham Act for artistic titles “unless the title has no artistic relevance to  
6 the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads  
7 as to the source or the content of the work.” *Id.* at 999. The court stated this test “insulates from  
8 restriction titles with at least minimal artistic relevance that are ambiguous or only implicitly misleading  
9 but leaves vulnerable to claims of deception titles that are explicitly misleading as to source or content,  
10 or that have no artistic relevance at all.” *Id.* at 1000.

11 In *MCA*, the Ninth Circuit adopted the artistic relevance test in a case addressing whether the  
12 title of the song “Barbie Girl” infringed Mattel’s Barbie trademark. The court rejected application of  
13 its traditional “likelihood of confusion” test to the facts of that case because it failed “to account for the  
14 full weight of the public’s interest in free expression.” 296 F.3d at 900. The court noted the public’s  
15 interest in free expression was particularly important in that case because the Barbie trademark had  
16 transcended its “identifying purpose” and entered the “public discourse and become an integral part of  
17 our vocabulary.” *Id.* As the court explained:

18 How else do you say that something’s “the Rolls Royce of its class”? What else is a  
19 quick fix, but a Band-Aid? Does the average consumer know to ask for aspirin as  
20 “acetyl salicylic acid”? Trademarks often fill in gaps in our vocabulary and add a  
contemporary flavor to our expressions. Once imbued with such expressive value, the  
trademark becomes a word in our language and assumes a role outside the bounds of  
trademark law.

21 *Id.* (internal citation omitted).

22 The court also appeared to be influenced by the defendant’s use of the Barbie trademark as a  
23 song title. Unlike other potential uses, the court stated: “A title is designed to catch the eye and to  
24 promote the value of the underlying work. Consumers expect a title to communicate a message about  
25 the book or movie, but they do not expect it to identify the publisher or producer.” *Id.* at 902. Applying  
26 the artistic relevance test to the facts of the case, the court ultimately concluded “that MCA’s use of  
27 Barbie is not an infringement of Mattel’s trademark.” *Id.*  
28

1 In another case involving a song title, the Sixth Circuit adopted and applied the artistic relevance  
2 test rather than the traditional “likelihood of confusion” test to the plaintiff’s trademark infringement  
3 claim. *See Parks v. LaFace Records*, 329 F.3d 437 (6<sup>th</sup> Cir. 2003). Like the Ninth Circuit, the Sixth  
4 Circuit found the “likelihood of confusion” test “ignores the fact that the artistic work is *not* simply a  
5 commercial product but also a means of communication.” *Id.* at 449. The court stated: “we do not find  
6 the unmodified likelihood of confusion test applied to commercial products adequate to differentiate  
7 between those artists who choose titles for the purpose of legitimate artistic relevancy and those artists  
8 who choose misleading titles for the purpose of commercial gain.” *Id.*

9 Unlike the Ninth Circuit, however, the Sixth Circuit reversed the district court’s grant of  
10 summary judgment in favor of the alleged infringer. The Sixth Circuit refused to see its task as simply  
11 “accept[ing] without question whatever purpose Defendants may now claim they had in using Rosa  
12 Parks’ name” in a song entitled “Rosa Parks” and recorded by the musical group Outkast. *Id.* at 454.  
13 Instead, it described its task as determining “whether, applying the law of *Rogers*, there is a genuine  
14 issue of material fact regarding the question of whether the title is artistically relevant to the content of  
15 the song.” *Id.* In making this determination, the court considered the lyrics of the song in their entirety.  
16 Although the phrase “move to the back of the bus” was repeated throughout the song, the court found  
17 the phrase had nothing to do with Rosa Parks when considered in the context of the lyrics as whole. *Id.*  
18 Ultimately, the court determined “the artistic relationship between the title and the content of the song  
19 is certainly not obvious and, indeed, is ‘open to reasonable debate[.]’” *Id.* at 452. Assuming, however,  
20 the jury found some artistic relevance between the title and the lyrics, the  
21 court stated judgment should be entered in favor of the defendants “because the title ‘is not explicitly  
22 misleading as to the content of the work.’” *Id.* at 459.

23 Here, Defendants assert the artistic relevance test applies to Plaintiff’s claims. Plaintiff disputes  
24 that the test applies to the facts of this case because “[t]he WEBCELEB mark has not obtained the  
25 cultural significance necessary for such blanket First Amendment protection.” (Mem. of P. & A. in  
26 Opp’n to Mot. at 10.) Plaintiff cites district court cases that have taken this approach to the artistic  
27 relevance test, (*id.*), but the Ninth Circuit has not done so. Indeed, it has specifically rejected this  
28 argument. *See E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9<sup>th</sup> Cir.



1 2008) (applying artistic relevance test even though mark had “little cultural significance”). Therefore,  
2 the Court will apply the artistic relevance test to the facts of this case.

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4 Turning to the first element of that test, Defendants argue their use of “web celeb” is artistically  
5 relevant to the underlying work, *i.e.*, the awards show category. Specifically, Defendants assert their  
6 use of “web celeb” describes the category, which satisfies the element of artistic relevance. Plaintiff  
7 disputes that Defendants have met the first element of the test because “Defendants’ use of WEBCELEB  
8 does not make artistic reference to Plaintiff’s product.” (Mem. of P. & A. in Opp’n to Mot. at 12.)  
9 However, Defendants need not refer to Plaintiff’s product to meet the element of artistic relevance.  
10 Indeed, Defendants’ use of the term has to be artistically relevant to their own product, not Plaintiff’s  
11 product. Here, Defendants’ use of “web celeb” has some artistic relevance to the underlying awards  
12 show category. Therefore, the first element of the artistic relevance test is met.

13 The second element of the artistic relevance test asks whether the title of the work is explicitly  
14 misleading as to source or content. Defendants argue their use of “web celeb” is neither because it is  
15 plainly linked to the awards show and branded with Defendants’ own trademarks. Plaintiff does not  
16 dispute these facts, but disputes the ultimate conclusion that those facts render Defendants’ use of the  
17 mark misleading. In support of that position, Plaintiff cites to the Declaration of Scott Fetters. (*Id.*)  
18 However, that evidence does not demonstrate that Defendants’ use of “web celeb” was explicitly  
19 misleading as to source or content. Rather, the evidence presently before the Court demonstrates  
20 Defendants’ use of the term was not explicitly misleading. Accordingly, Defendants have met the  
21 requirements of the artistic relevance test, and are entitled to summary judgment on Plaintiff’s claims.<sup>3</sup>

### 22 III.

### 23 CONCLUSION AND ORDER

24 For these reasons, the Court grants Defendants’ Motion for Summary Judgment based on the

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25 <sup>3</sup> Because Defendants are entitled to judgment under this test, the Court does not consider  
26 Defendants’ alternative defense of fair use.

27 The Court also declines to deny or defer ruling on the present motion in light of Mr.  
28 Hangartner’s Declaration. Mr. Hangartner declares he is waiting for outstanding discovery that will  
be relevant to the issues in this motion. However, nowhere does he state that any of this information  
is essential to his opposition. *See* Fed. R. Civ. P. 56(d). Absent such a showing, the Court declines  
to deny or defer ruling on the motion.



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4 artistic relevance test. Defendants have not shown that this case is exceptional under 15 U.S.C. §  
5 1117(a), therefore their request for attorneys fees is denied. The Clerk of Court shall enter judgment  
6 accordingly.

7 **IT IS SO ORDERED.**

8 DATED: September 25, 2012

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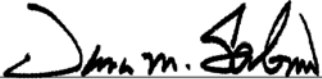
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HON. DANA M. SABRAW  
United States District Judge