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8 UNITED STATES DISTRICT COURT  
9 CENTRAL DISTRICT OF CALIFORNIA  
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11 ACTIVISION PUBLISHING, INC.,  
12 Plaintiff,  
13 v.  
14 WARZONE.COM, LLC,  
15 Defendant.  
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Case No. 2:21-cv-03073-FLA (JCx)

**ORDER GRANTING ACTIVISION  
PUBLISHING, INC.'S MOTION TO  
DISMISS COUNTERCLAIMS, AND  
JUDGMENT ON THE PLEADINGS  
[DKT. 24]**

1 **RULING**

2 Before the court is Plaintiff and Counterclaim-Defendant Activision Publishing,  
3 Inc.’s (“Activision” or “Plaintiff”) Motion to Dismiss Counterclaims And/or for  
4 Judgment on the Pleadings (“Motion”). Dkt. 24 (“Mot.”). Defendant and  
5 Counterclaimant, Warzone.com LLC (“Warzone.com” or “Defendant”), opposes the  
6 Motion. Dkt. 29 (“Opp’n”). On December 6, 2021, the court found this matter  
7 appropriate for resolution without oral argument and vacated the hearing set for  
8 December 10, 2021. Dkt. 37; *see* Fed. R. Civ. P. 78(b); Local Rule 7-15.

9 For the reasons stated herein, the court GRANTS Plaintiff’s Motion,  
10 DISMISSES Defendant’s counterclaims without leave to amend, and ENTERS  
11 Judgment in Plaintiff’s favor on the Complaint.

12 **BACKGROUND**

13 The following allegations are taken from Plaintiff’s Complaint. Dkt. 1  
14 (“Compl.”). Activision is a publisher of video games and interactive entertainment  
15 products, including the *Call of Duty* video game series. *Id.* ¶ 2. Activision released  
16 the first *Call of Duty* game in 2003 and has since released 16 major installments to the  
17 *Call of Duty* franchise. *Id.* ¶¶ 2, 13. Activision has sold more than 300 million *Call of*  
18 *Duty* games, which Plaintiff contends is considered the most successful first-person  
19 shooter game franchise ever made. *Id.* ¶ 14. On March 10, 2020, Activision released  
20 a stand-alone, “free to play,” online multiplayer game titled *Call of Duty: Warzone*  
21 (“CODWZ”). *Id.* ¶ 15. CODWZ is a first-person shooter game that features a large  
22 computer-generated battlefield, or warzone, that accommodates up to 150 payers, and  
23 sometimes 200 players, at one time. *Id.* ¶ 16.

24 Warzone.com develops and makes available to the public a browser-based  
25 game titled *Warzone*. *Id.* ¶ 19. *Warzone* is a free-to-play, turn-based strategy game.  
26 *Id.* Players shift numbers, which represent armies, across a map of the world to take  
27 control of countries or territories. *Id.* ¶ 22. Warzone.com markets that game as  
28 “Better than Hasbro’s RISK game.” *Id.* Warzone.com released *Warzone* in

1 November 2017, and it is available on Warzone.com’s internet website and mobile  
2 devices. *Id.* ¶ 20. *Warzone* is not available on video game consoles. *Id.*

3 On or about June 25, 2020, Activision filed applications for registration of the  
4 trademarks WARZONE and CALL OF DUTY WARZONE. *Id.* ¶ 26. On October  
5 30, 2020, Warzone.com filed applications for registration of the trademark  
6 WARZONE. *Id.* ¶ 27. Warzone.com filed a Notice of Opposition to the registration  
7 of the Activision marks and the opposition proceeding is currently pending before the  
8 USPTO. *Id.* ¶ 29. On November 20, 2020, Warzone.com’s counsel sent a cease-and-  
9 desist letter to Activision’s counsel, demanding that Activision “change the name of  
10 its games, stop using Warzone’s WARZONE mark, and abandon the trademark  
11 applications.” *Id.* ¶ 30. Activision and Warzone.com were unable to resolve the  
12 dispute, and Warzone.com indicated it intended to seek injunctive relief and damages  
13 against Activision. *Id.* ¶¶ 3, 32.

14 In this action, Activision seeks a declaration of non-infringement under the  
15 Lanham Act, 15 U.S.C. § 1125, that its use and registration of the word marks  
16 WARZONE and CALL OF DUTY WARZONE do not infringe Warzone.com’s  
17 purported trademark rights in the title of its game titled *Warzone*. *Id.* ¶¶ 1, 32. On  
18 June 8, 2021, Defendant filed counterclaims for unfair competition and trademark  
19 infringement under the Lanham Act, 15 U.S.C. § 1125 (“Counterclaim I”), unfair  
20 competition and false advertising under California law, Cal. Bus. & Prof. Code §§  
21 17200 and 17500 *et seq.* (“Counterclaim II”), and trademark infringement under  
22 California common law (“Counterclaim III”). Dkt. 14 (“Answer and Counterclaims”)  
23 at 16-19. According to Defendant, it has been using the WARZONE mark in  
24 commerce since at least November 13, 2017, and it has pending applications before  
25 the USPTO for the mark WARZONE. *Id.* at 8, ¶¶ 3, 5-6. Defendant contends that  
26 given the popularity of the *Call of Duty* franchise, Activision’s use of WARZONE has  
27 saturated the market in a manner that has overwhelmed Warzone.com. *Id.* at 14, ¶ 23.

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**DISCUSSION**

**I. Legal Standard**

“After the pleadings are closed—but early enough not to delay trial—a party may move for judgment on the pleadings.” Fed. R. Civ. P. 12(c) (“Rule 12(c)”). The legal standard for a motion for judgment on the pleadings under Rule 12(c) is “functionally identical” to a motion to dismiss under Fed. R. Civ. P. 12(b)(6) (“Rule 12(b)(6)”). *Dworkin v. Hustler Magazine, Inc.*, 867 F.2d 1188, 1192 (9th Cir. 1989). The same legal standard applies to motions brought under either rule. *Id.* Thus, the issue presented by a Rule 12(c) motion is whether the factual allegations of the complaint, together with all reasonable inferences, state a plausible claim for relief. *Cafasso v. Gen. Dynamics C4 Sys.*, 637 F.3d 1047, 1054 & n. 4 (9th Cir. 2011). “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*, 556 U.S. 662, 678 (2009) (citing *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 556 (2007)).

In evaluating a motion for judgment on the pleadings, the court “must accept all factual allegations in the complaint as true and construe them in the light most favorable to the non-moving party.” *Fleming*, 581 F.3d at 925; *see also Hal Roach Studios, Inc. v. Richard Feiner & Co., Inc.*, 896 F.2d 1542, 1550 (9th Cir. 1989) (“For purposes of the motion, the allegations of the non-moving party must be accepted as true, while the allegations of the moving party which have been denied are assumed to be false.”). “Judgment on the pleadings is proper when the moving party clearly establishes on the face of the pleadings that no material issue of fact remains to be resolved and that it is entitled to judgment as a matter of law.” *Hal Roach*, 896 F.2d at 1550.

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## 1 II. Analysis

### 2 A. Lanham Act Claim

3 Generally, courts within the Ninth Circuit apply an eight-factor “likelihood-of-  
4 confusion test” to claims brought under the Lanham Act. *Twentieth Century Fox*  
5 *Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1196 (9th Cir. 2017). But when a  
6 trademark is included in an expressive work, the protections afforded under trademark  
7 laws must also be balanced against broader First Amendment concerns. *Id.*; *see also*  
8 *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002) (noting “when a  
9 trademark owner asserts a right to control how we express ourselves ... applying the  
10 traditional [likelihood-of-confusion] test fails to account for the full weight of the  
11 public’s interest in free expression”). In circumstances involving an expressive work,  
12 a plaintiff with Lanham Act claims must instead overcome the test articulated in  
13 *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), which was adopted by the Ninth  
14 Circuit in *Mattel*, 296 F.3d at 902. *See also Twentieth Century Fox*, 875 F.3d at 1196;  
15 *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008).

#### 16 1. *The Rogers Test*

17 The “threshold for applying the *Rogers* test is whether the allegedly infringing  
18 use is contained in an expressive work.” *Twentieth Century Fox Television v. Empire*  
19 *Distrib. Inc.*, 161 F. Supp. 3d 902, 907 (C.D. Cal. 2016), *aff’d* 875 F.3d 1192 (9th Cir.  
20 2017). If the threshold requirement is met, the court applies the two-prong *Rogers*  
21 test, which provides First Amendment protection to “the use of a trademark in an  
22 expressive work if the use of the mark has [1] artistic relevance to the underlying  
23 work and [2] does not explicitly mislead as to the source or content of the work.” *Id.*  
24 at 909; *see also Rogers*, 875 F.2d at 999 (noting that the Lanham Act “should be  
25 construed to apply to artistic works only where the public interest in avoiding  
26 consumer confusion outweighs the public interest in free expression”).

27 The *Rogers* test squarely applies here. To begin, Defendant admits that  
28 *CODWZ* is an expressive work and thus, the *Rogers* test applies. *See Opp’n* 15

1 (“Warzone does not dispute that video games may qualify as ‘artistic works’ subject  
 2 to application of the *Rogers* balancing test.”). The Supreme Court has clearly  
 3 recognized that video games are subject to First Amendment protection. *Brown v.*  
 4 *Ent. Merchs. Ass’n*, 564 U.S. 786, 790 (2011); *see also Novalogic, Inc. v. Activision*  
 5 *Blizzard*, 41 F. Supp. 3d 885, 898 (C.D. Cal. 2013) (finding *Call of Duty—Modern*  
 6 *Warfare 3* was “an expressive work entitled to as much First Amendment protection  
 7 as ... any other expressive work”).<sup>1</sup>

8 Having found *CODWZ* an expressive work, the court applies the *Rogers* test.  
 9 *See Twentieth Century Fox*, 875 F.3d at 1196-97.

10 *a. Artistic Relevance Prong*

11 “The first prong of the *Rogers* test requires a showing that the use of a mark has  
 12 artistic relevance to the underlying work.” *Id.* “[T]he level of relevance merely must  
 13 be above zero.” *E.S.S.*, 547 F.3d at 1100.

14 In *CODWZ*, game play takes place in a large computer-generated battlefield  
 15 that accommodates over one hundred players at a given time. Compl. ¶ 16.  
 16 Activision argues this virtual battlefield has all the hallmarks of the definition of a  
 17 real-life warzone, and thus the title “Warzone” is logically and artistically relevant to  
 18 the content of its video game.<sup>2</sup> Mot. 14. Defendant counters that Activision could  
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20 <sup>1</sup> Defendant cites *Masters Software, Inc. v. Discovery Communications, Inc.*, 725 F.  
 21 Supp. 2d 1294 (W.D. Wash. 2010), to argue that the *Rogers* test does not apply in  
 22 reverse confusion cases. Opp’n 19-21. Defendant’s cited cases, however, are older  
 23 district court cases that do not constitute binding authority, and which predate the  
 24 Ninth Circuit’s ruling in *Twentieth Century Fox*, 875 F.3d 1192. The Ninth Circuit  
 25 has expressly rejected the argument that *Rogers* has a referential requirement, *see Caiz*  
 26 *v. Roberts*, 382 F. Supp. 3d 942, 948-49 (C.D. Cal. 2019), as Defendant recognizes in  
 its Opposition. *See* Opp’n 20-21. Accordingly, the court will not find the *Rogers* test  
 does not apply in this action, simply because it involves reverse confusion.

27 <sup>2</sup> Merriam-Webster defines “war zone” as “a zone in which belligerents are waging  
 28 war” and “an area marked by extreme violence.” *War zone*, MERRIAM-WEBSTER

1 have selected from among many common English words, such as “warfare, combat  
2 zone, frontline, battle, [or] battle zone, but instead chose to appropriate the goodwill  
3 inherent in Warzone.com’s mark. Opp’n 23.

4 Warzone.com cites *Gordon v. Drape Creative, Inc.*, 897 F.3d 1184, 1194 (9th  
5 Cir. 2018), *opinion withdrawn and superseded on reh’g*, 909 F.3d 257 (9th Cir. 2018),  
6 to argue that “the use of a mark is not artistically relevant if the defendant uses it  
7 merely to appropriate the goodwill inhering in the mark ....” Opp’n 22.

8 Warzone.com’s reliance on the withdrawn opinion in *Gordon* is misplaced. In the  
9 superseding opinion, the Ninth Circuit recognized that the use of a mark in a title has  
10 artistic value when it is relevant to the underlying work and omitted the quoted  
11 language from the withdrawn opinion on which Warzone.com relies. *Gordon*, 909  
12 F.3d at 265-67.

13 Activision’s use of the term “Warzone” is clearly relevant to the content in  
14 *CODWZ*. That Activision could have chosen other relevant names does not negate the  
15 artistic value of the name it ultimately selected. The court, therefore, finds Plaintiff’s  
16 use of the term “Warzone” in the title of *CODWZ* has artistic relevance to the  
17 underlying work, as a matter of law.

18 *b. Explicitly Misleads Prong*

19 “The second prong of the Rogers test requires a junior user to show that their  
20 work does not explicitly mislead as to the source or content of the work.” *Twentieth*  
21 *Century Fox*, 161 F. Supp. 3d at 908; *see also E.S.S.*, 547 F.3d at 1100; *Brown v. Elec.*  
22 *Arts, Inc.*, 724 F.3d 1235, 1245 (9th Cir. 2013) (“It is key here that the creator must  
23 *explicitly* mislead consumers.”) (italics in original). Ordinarily, “the mere use of a  
24 trademark alone cannot suffice to make such use explicitly misleading.” *E.S.S.*, 547  
25 F.3d at 1100. However, this “does not extend to instances in which consumers *would*  
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27 DICTONARY, <https://www.merriam-webster.com/dictionary/war%20zone> (last  
28 visited August 15, 2022).

1 expect the use of a mark alone to identify the source.” *Gordon*, 909 F.3d at 270.  
2 Further, “identical usage could reflect the type of ‘explicitly misleading description’  
3 of source that *Rogers* condemns.” *Id.* Concern about misleading consumers is  
4 “generally allayed when the mark is used as only one component of a junior user’s  
5 larger expressive creation.” *Id.* at 270-71.

6 Activision argues that its use of the word “Warzone” cannot be explicitly  
7 misleading because it is a common English word with general meaning independent of  
8 Warzone.com’s game. Mot. 16. Further, Activision argues its marketing makes clear  
9 that *CODWZ* is part of the broader *Call of Duty* franchise and that “any suggestion  
10 that Activision intended to mislead explicitly its customers into believing that it was  
11 associated with [Warzone.com] and its browser-based strategy game defies common  
12 sense or credibility.” *Id.* at 17-18. Defendant counters that Activision’s use of  
13 “Warzone” is explicitly misleading because consumers searching for its video game  
14 are diverted to Activision’s game. Opp’n 23-24. Defendant further argues its  
15 allegations of consumer confusion are sufficient to negate the second prong of the  
16 *Rogers* test. *Id.* at 25.

17 Here, Defendant fails to allege plausibly that Activision explicitly mislead  
18 consumers by using the term “Warzone” in the title of *CODWZ* as part of the broader  
19 *Call of Duty* franchise. In its attempt to satisfy the second prong of the *Rogers* test,  
20 Defendant relies on allegations that Activision’s use of “Warzone” has caused  
21 consumer confusion. But “[t]o fail the second prong of the *Rogers* test, it is key that  
22 the creator must *explicitly* mislead consumers,” and the court “must ask not only about  
23 the likelihood of consumer confusion but also whether there was an explicit  
24 indication, overt claim, or explicit misstatement that caused such consumer  
25 confusion.” *Twentieth Century Fox*, 875 F.3d at 1199. Warzone.com alleges  
26 Activision uses an identical mark to offer similar goods and services, saturating the  
27 market and overwhelming Warzone.com, resulting in actual consumer confusion.  
28 Answer and Counterclaims 11, 14-15, ¶¶ 20, 23-28. However, nothing in the

1 allegations plausibly suggest that Activision’s use of the term “Warzone” is explicitly  
2 misleading.

3 Finally, Warzone.com argues it is not appropriate to apply the *Rogers* test on a  
4 motion to dismiss, citing a number of cases where courts applied the *Rogers* test to  
5 motions for summary judgment. Opp’n 26. However, there are numerous other  
6 instances where courts appropriately applied the *Rogers* test to motions to dismiss.  
7 See Dkt. 32 (“Reply”) 3, collecting cases. Where “[t]here is simply no allegation that  
8 [Activision] explicitly misled consumers” there is “no problem with the district court  
9 deciding this issue in response to a motion to dismiss.” *Brown*, 724 F.3d at 1248. In  
10 sum, the court finds Activision’s use of the term “Warzone” in *CODWZ* is entitled to  
11 First Amendment protection and does not violate the Lanham Act.

12 **B. False Advertising and California Trademark Infringement**

13 The First Amendment protection articulated in *Rogers* applies equally to state  
14 law claims and the Lanham Act claim. See *E.S.S.*, 547 F.3d at 1101 (finding “the First  
15 Amendment defense applie[d] equally to [plaintiff’s] state law [trademark  
16 infringement and unfair competition] claims as to its Lanham Act claim”); see also  
17 *Novalogic*, 41 F. Supp. 3d at 904 (“Because Plaintiff’s federal claims fail, its claim for  
18 common law trademark infringement also fails.”). Having found that Activision’s use  
19 of the term “Warzone” is entitled to First Amendment protection under *Rogers*, the  
20 court finds that Warzone.com’s Counterclaims II and III for unfair competition and  
21 false advertising under California law, Cal. Bus. & Prof. Code §§ 17200 and 17500 *et*  
22 *seq.*, and trademark infringement under California common law also fail.

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**CONCLUSION**

For the foregoing reasons, the court GRANTS Plaintiff’s Motion to Dismiss Counterclaims and Motion for Judgment on the Pleadings, Dkt. 24, and orders as follows:

1. The court declares that Activision’s use of the WARZONE and CALL OF DUTY WARZONE Marks does not infringe, and at all times has not infringed, any existing and valid common law trademark rights of Defendant under the Lanham Act, 15 U.S.C. § 1125(a);
2. Judgment is entered in favor of Plaintiff on the Complaint; and
3. Defendant’s counterclaims are dismissed without leave to amend.<sup>3</sup>

IT IS SO ORDERED.

Dated: August 15, 2022

FERNANDO L. AENLLE-ROCHA  
United States District Judge

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<sup>3</sup> In its prayer for relief, Plaintiff seeks declarations that Activision’s pending applications for registration of the marks WARZONE and CALL OF DUTY WARZONE may proceed to registration and that Warzone’s pending applications for registration of the mark WARZONE should not proceed to registration. Compl. at 12-13. Activision previously conceded that that this court would not have the authority to decide trademark registration issues if the court were to dismiss Warzone.com’s counterclaims and issue a declaration of non-infringement under the Lanham Act (15 U.S.C. § 1125(a)). See Dkt. 52 at 4. The court, therefore, does not address issues related to trademark registration.