

NOT FOR PUBLICATION

FILED

UNITED STATES COURT OF APPEALS

MAY 13 2022

FOR THE NINTH CIRCUIT

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U.S. COURT OF APPEALS

ARIZONA BOARD OF REGENTS, a body  
corporate, for and on behalf of: on behalf of  
Arizona State University,

Plaintiff-Appellant,

v.

JOHN DOE, AKA asu\_covid.parties, an  
individual,

Defendant-Appellee,

and

FACEBOOK, INC., a Delaware corporation,

Defendant.

No. 21-16525

D.C. No. 2:20-cv-01638-DWL

MEMORANDUM\*

Appeal from the United States District Court  
for the District of Arizona  
Dominic Lanza, District Judge, Presiding

Argued and Submitted April 15, 2022  
Pasadena, California

Before: CALLAHAN and VANDYKE, Circuit Judges, and Y. GONZALEZ  
ROGERS,\*\* District Judge.

\* This disposition is not appropriate for publication and is not precedent  
except as provided by Ninth Circuit Rule 36-3.

\*\* The Honorable Yvonne Gonzalez Rogers, United States District Judge

Plaintiff-Appellant Arizona Board of Regents (“ABR”) appeals the district court’s order denying ABR’s motion for default judgment and dismissal of its complaint. ABR’s appeal raises six issues, namely whether the district court erred by: (1) dismissing sua sponte its complaint without leave to amend and without providing prior notice; (2) dismissing its Lanham Act and state law unfair competition claims under Rule 12(b)(6); (3) refusing to apply the doctrine of initial interest confusion; (4) dismissing its false advertising claim; (5) refusing to rule on its state law dilution claim; and (6) denying its motion for default judgment. We have jurisdiction over this appeal pursuant to 28 U.S.C. § 1291. After a review of the record, oral argument, and relevant case law, we affirm the district court’s order on all grounds.

“We review de novo a district court’s dismissal of [a complaint] for failure to state a claim under Rule 12(b)(6).” *Prodanova v. H.C. Wainwright & Co., LLC*, 993 F.3d 1097, 1105 (9th Cir. 2021). Questions involving the application of legal principles to established facts are also reviewed de novo. *Flores v. City of San Gabriel*, 824 F.3d 890, 905 (9th Cir. 2016).

However, a district court’s determination of likelihood of confusion is reviewed for clear error. *Pom Wonderful LLC v. Hubbard*, 775 F.3d 1118, 1123 (9th Cir. 2014). The denial of a motion for default judgment as well as the

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for the Northern District of California, sitting by designation.

decision whether to retain jurisdiction over supplemental claims when the original federal claims are dismissed are reviewed for abuse of discretion. *Aldabe v. Aldabe*, 616 F.2d 1089, 1092–93 (9th Cir. 1980); *Lima v. United States Dep’t of Educ.*, 947 F.3d 1122, 1125, 1128 (9th Cir. 2020).

1. The district court did not err by dismissing ABR’s complaint sua sponte without leave to amend and without providing notice because amendment would have been futile. *See Wong v. Bell*, 642 F.2d 359, 361–62 (9th Cir. 1981). With respect to all of ABR’s claims, amendment would have been futile given the implausibility of the allegations and of a finding of likelihood of confusion. Of Doe’s eighteen posts included on the Instagram page, only one post included the use of ABR’s mark and trade dress. That one post contained profanity and a reasonable consumer would not think that a university would use such language when addressing the public. Reviewing the posts in their totality does not change the result, but rather reaffirms it.

Additionally, amendment would have also been futile given the non-commercial nature of Doe’s activities. The Lanham Act was enacted to be applied in the commercial context, thus “infringement claims are subject to a commercial use requirement.” *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 676 (9th Cir. 2005). Here, the record does not support the conclusion that Doe used ABR’s marks for the sale of goods or services. Rather, the record shows that Doe used the

marks to criticize and mock ABR and ABR's policies and administration. While some of the initial posts did refer to a future party, none of those posts contained references to a particular party nor did they mention a specific date, time, cost, or any other details about any party. The mere reference that Doe was a "party planner" is only one factor for consideration. Because ABR's claims require a showing of likelihood of confusion and/or commercial use, the district court did not err in dismissing ABR's complaint sua sponte.<sup>1</sup>

2. The district court did not err in dismissing ABR's trademark infringement, false designation of origin, and unfair competition claims after finding that there was no likelihood of confusion. Given the flexibility in application of the *Sleekcraft* factors, application of certain factors over others does not constitute clear error. *Rearden LLC v. Rearden Com., Inc.*, 683 F.3d 1190, 1209 (9th Cir. 2012). The district court conducted its likelihood of confusion

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<sup>1</sup> ABR's appeal also implicates several First Amendment considerations worth noting. Even assuming Doe's posts were commercial in nature, this Court has recognized and adopted the *Rogers* test, which protects expressive uses of trademarks from Lanham Act liability. *See Mattel v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002). Doe's Instagram posts appear to constitute expressive work under *Rogers* as the posts communicated messages that mocked ABR's policies and administration. To the extent ABR's appeal attempts to improperly use trademark laws to block the expression of negative views about the university and its administration, such efforts fail.

analysis by looking at the full context of Doe’s Instagram posts and by expressly evaluating some of the *Sleekcraft* factors. The court’s analysis included a review of the surrounding posts, comments, and the context in which the posts were made. Only after conducting this review, and analyzing some of the *Sleekcraft* factors, did the district court find that there was no likelihood of confusion. We find that the district court properly applied the factors and did not abuse its discretion.

3. Similarly, the district court did not err by refusing to apply the initial interest confusion doctrine, which also requires a finding of likelihood of confusion. *Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137, 1149 (9th Cir. 2011).

4. The district court did not err in its analysis of ABR’s false advertising claim. Contrary to ABR’s assertion, the district court analyzed the claim, finding that a prudent consumer would not be confused or deceived by the posts included on Doe’s Instagram. This necessarily includes the post regarding the alleged collaboration with Teva Pharmaceuticals. The district court’s failure to quote the factual allegations verbatim does not constitute error. Thus, we affirm the district court’s order dismissing ABR’s false advertising claim since the claim also requires a showing of deceit or likelihood of deceit. *Wells Fargo & Co. v. ABD Ins. & Fin. Servs. Inc.*, 758 F.3d 1069, 1071 (9th Cir. 2014), *as amended* (Mar. 11, 2014).

5. The district court did not err in declining to decide ABR's Arizona state law dilution claim once the court dismissed all of the claims over which it had original jurisdiction. Contrary to ABR's contention, 28 U.S.C. § 1338(b) does not confer district courts with original jurisdiction over state law dilution claims. Rather, the statute provides "original jurisdiction of any civil action asserting a claim of unfair competition . . . ." 28 U.S.C. § 1338(b). The statute provides supplemental jurisdiction over state law dilution claims. *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1362 (9th Cir. 1985). Accordingly, the district court properly exercised its discretion in deciding not to exercise supplemental jurisdiction over the state law dilution claim after dismissing all federal claims. *Id.*; *see also* 28 U.S.C. § 1367(c)(3).

That the district court decided ABR's state law unfair competition claim but did not decide its state law dilution claim was not an abuse of discretion. As explained above, under 28 U.S.C. § 1338(b), the court had original jurisdiction over ABR's unfair competition claim and properly resolved that claim. An unfair competition claim and a state dilution claim are distinct. Given that the dilution claim required additional analysis, the district court did not err in declining to exercise supplemental jurisdiction over ABR's dilution claim.

6. The district court did not err in denying ABR's motion for default judgment as the complaint lacked merit as to the substantive claims and was

insufficient. *See Eitel v. McCool*, 782 F.2d 1470, 1471–72 (9th Cir. 1986); *Aldabe*, 616 F.2d at 1092–93.

**AFFIRMED.**

## United States Court of Appeals for the Ninth Circuit

Office of the Clerk  
95 Seventh Street  
San Francisco, CA 94103

### Information Regarding Judgment and Post-Judgment Proceedings

#### Judgment

- This Court has filed and entered the attached judgment in your case. Fed. R. App. P. 36. Please note the filed date on the attached decision because all of the dates described below run from that date, not from the date you receive this notice.

#### Mandate (Fed. R. App. P. 41; 9th Cir. R. 41-1 & -2)

- The mandate will issue 7 days after the expiration of the time for filing a petition for rehearing or 7 days from the denial of a petition for rehearing, unless the Court directs otherwise. To file a motion to stay the mandate, file it electronically via the appellate ECF system or, if you are a pro se litigant or an attorney with an exemption from using appellate ECF, file one original motion on paper.

#### Petition for Panel Rehearing (Fed. R. App. P. 40; 9th Cir. R. 40-1)

#### Petition for Rehearing En Banc (Fed. R. App. P. 35; 9th Cir. R. 35-1 to -3)

#### (1) A. Purpose (Panel Rehearing):

- A party should seek panel rehearing only if one or more of the following grounds exist:
  - ▶ A material point of fact or law was overlooked in the decision;
  - ▶ A change in the law occurred after the case was submitted which appears to have been overlooked by the panel; or
  - ▶ An apparent conflict with another decision of the Court was not addressed in the opinion.
- Do not file a petition for panel rehearing merely to reargue the case.

#### B. Purpose (Rehearing En Banc)

- A party should seek en banc rehearing only if one or more of the following grounds exist:



- ▶ Consideration by the full Court is necessary to secure or maintain uniformity of the Court's decisions; or
- ▶ The proceeding involves a question of exceptional importance; or
- ▶ The opinion directly conflicts with an existing opinion by another court of appeals or the Supreme Court and substantially affects a rule of national application in which there is an overriding need for national uniformity.

**(2) Deadlines for Filing:**

- A petition for rehearing may be filed within 14 days after entry of judgment. Fed. R. App. P. 40(a)(1).
- If the United States or an agency or officer thereof is a party in a civil case, the time for filing a petition for rehearing is 45 days after entry of judgment. Fed. R. App. P. 40(a)(1).
- If the mandate has issued, the petition for rehearing should be accompanied by a motion to recall the mandate.
- See Advisory Note to 9th Cir. R. 40-1 (petitions must be received on the due date).
- An order to publish a previously unpublished memorandum disposition extends the time to file a petition for rehearing to 14 days after the date of the order of publication or, in all civil cases in which the United States or an agency or officer thereof is a party, 45 days after the date of the order of publication. 9th Cir. R. 40-2.

**(3) Statement of Counsel**

- A petition should contain an introduction stating that, in counsel's judgment, one or more of the situations described in the "purpose" section above exist. The points to be raised must be stated clearly.

**(4) Form & Number of Copies (9th Cir. R. 40-1; Fed. R. App. P. 32(c)(2))**

- The petition shall not exceed 15 pages unless it complies with the alternative length limitations of 4,200 words or 390 lines of text.
- The petition must be accompanied by a copy of the panel's decision being challenged.
- A response, when ordered by the Court, shall comply with the same length limitations as the petition.
- If a pro se litigant elects to file a form brief pursuant to Circuit Rule 28-1, a petition for panel rehearing or for rehearing en banc need not comply with Fed. R. App. P. 32.

- The petition or response must be accompanied by a Certificate of Compliance found at Form 11, available on our website at [www.ca9.uscourts.gov](http://www.ca9.uscourts.gov) under *Forms*.
- You may file a petition electronically via the appellate ECF system. No paper copies are required unless the Court orders otherwise. If you are a pro se litigant or an attorney exempted from using the appellate ECF system, file one original petition on paper. No additional paper copies are required unless the Court orders otherwise.

### **Bill of Costs (Fed. R. App. P. 39, 9th Cir. R. 39-1)**

- The Bill of Costs must be filed within 14 days after entry of judgment.
- See Form 10 for additional information, available on our website at [www.ca9.uscourts.gov](http://www.ca9.uscourts.gov) under *Forms*.

### **Attorneys Fees**

- Ninth Circuit Rule 39-1 describes the content and due dates for attorneys fees applications.
- All relevant forms are available on our website at [www.ca9.uscourts.gov](http://www.ca9.uscourts.gov) under *Forms* or by telephoning (415) 355-7806.

### **Petition for a Writ of Certiorari**

- Please refer to the Rules of the United States Supreme Court at [www.supremecourt.gov](http://www.supremecourt.gov)

### **Counsel Listing in Published Opinions**

- Please check counsel listing on the attached decision.
- If there are any errors in a published opinion, please send an email or letter **in writing within 10 days** to:
  - ▶ Thomson Reuters; 610 Opperman Drive; PO Box 64526; Eagan, MN 55123 (Attn: Maria Evangelista ([maria.b.evangelista@tr.com](mailto:maria.b.evangelista@tr.com)));
  - ▶ and electronically file a copy of the letter via the appellate ECF system by using “File Correspondence to Court,” or if you are an attorney exempted from using the appellate ECF system, mail the Court one copy of the letter.

**UNITED STATES COURT OF APPEALS  
FOR THE NINTH CIRCUIT  
Form 10. Bill of Costs**

*Instructions for this form: <http://www.ca9.uscourts.gov/forms/form10instructions.pdf>*

**9th Cir. Case Number(s)**

**Case Name**

The Clerk is requested to award costs to *(party name(s))*:

I swear under penalty of perjury that the copies for which costs are requested were actually and necessarily produced, and that the requested costs were actually expended.

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