**UNITED STATES DISTRICT COURT**

**WESTERN DISTRICT OF WISCONSIN**

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| LUCIANNE M. WALKOWICZ,<br><br>Plaintiff,<br><br>v.<br><br>AMERICAN GIRL, LLC, AMERICAN GIRL BRANDS, LLC, and MATTEL, INC.<br><br>Defendants. | ) | Case No. 3:20-cv-00374-jdp |

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**PLAINTIFF LUCIANNE WALKOWICZ'S**
**RESPONSE IN OPPOSITION TO DEFENDANTS' 12(B)(6) MOTION TO DISMISS**

## TABLE OF CONTENTS

**Page**

INTRODUCTION .....1
FACTUAL BACKGROUND .....2
ARGUMENT .....13
Section 12(B)(6) Dismissal Standard .....13
Plaintiff Sufficiently Pleads Violation of Right to Privacy Wis. Stat. § 995.50 .....14
Defendants Use the Plaintiff's "Name" .....15
The Defendants Use the Plaintiff's "Portrait or Picture" .....16
The Defendants Use the Plaintiff for Advertising and Trade Purposes .....20
Plaintiff Sufficiently Pleads a Claim for False Endorsement under the Lanham Act .....21
The Amended Complaint Sufficiently Pleads Facts Which Give Lucianne Standing to Bring a False Endorsement Claim .....22
The Amended Complaint Sets Forth Sufficient Facts to Show that American Girl Used Lucianne's Likeness and Identity .....24
The Amended Complaint Sufficiently Alleges Consumer Confusion as to Endorsement 27
Count III and Count IV Sufficiently Negligence and Negligent Supervision .....29
Negligence .....29
Negligent Supervision .....33
CONCLUSION .....37

## TABLE OF AUTHORITIES

**Page**

Allen v. Nat'l Video, Inc.,
610 F.Supp. 612 (S.D.N.Y. 1985) .....23, 24

Ames Publ'g Co. v. Walker-Davis Publ'n, Inc.,
372 F. Supp. 1 (E.D. Penn. 1974) .....21

Ashcroft v. Iqbal,
556 U.S. 662, 129 S. Ct. 1937, 173 L. Ed. 2d 868 (2009) .....13

Bell v. City of Chicago,
835 F.3d 736 (7th Cir. 2016) .....13

Bell Atl. Corp. v. Twombly,
550 U.S. 544, 127 S. Ct. 1955, 167 L. Ed. 2d 929 (2007) .....13

Binns v. Vitagraph Co. of America,
210 N.Y. 51 (N.Y. Ct. App. 1913) .....17

Bogie v. Rosenberg,
705 F.3d 576 (7th Cir. 2005) .....15, 18, 19, 20

Champion v. Take Two Interactive Software, Inc.,
100 N.Y.S.3d 838 (N.Y. App. Div. 2019) .....18, 19

Conrad v. Madison Festivals, Inc.,
No. 09-cv-499-bbc,
2009 U.S. Dist. LEXIS 85170 (W.D. Wis. Sept. 15, 2009) .....15, 21, 22

Erickson v. Pardus,
551 U.S. 89 (2007) .....13

Geisel v. Poynter Prods.,
283 F. Supp. 261 (S.D.N.Y. 1968) .....23

Gravano v. Take-Two Interactive Software, Inc.,
37 N.Y.S.3d 20 (N.Y. App. Div. 2016) .....18, 19

Gomilla v. Libertas,
240 Wis. 2d 325 (Wis. App. 2000) .....33, 34

Gulfstream Media Group, Inc. v. PD Strategic Media, Inc.,
No. 12-62056 CIV, 2013 WL 1891281 (S.D. Fla. May 6, 2013) .....13

Hart v. Amazon.com, Inc.,
191 F. Supp. 3d 809 (N.D. Ill. 2016) .....21

Hinton v. Vonch, LLC,
No. 18 CV 7221, 2019 U.S. Dist. LEXIS 129934 (N.D. Ill. Aug. 2, 2019) .....30, 33

Hirsch v. S.C. Johnson & Son, Inc.,
90 Wis. 2d 379 (1979) .....14, 15, 16

Horst v. Deere & Co.,
2009 WI 75, 319 Wis. 2d 147, 769 N.W.2d 536 .....33

Johnson v. Misericordia Cmty. Hosp.,
99 Wis. 2d 708, 301 N.W.2d 156 (1981).....34, 36

Kinney ex rel NLRB v. Dominick's Finer Foods, Inc.,
780 F. Supp. 1178 (N.D. Ill. 1991) .....14

Loftus v. Greenwich Litho. Co.,
182 N.Y.S. 428 (N.Y. App. 1st 1920).....17

Lohan v. Take-Two Interactive Software, Inc.,
31 N.Y.3d 111 (N.Y. 2018) .....18, 19

Maypark v. Securitas Sec. Servs. USA,
2009 WI App 145, 321 Wis. 2d 479, 775 N.W.2d 270 .....34, 35

McFarland v. Miller,
14 F.3d 912 (3rd Cir. 1994) .....16

McGowan v. Hulick,
612 F.3d 636 (7th Cir. 2010) .....13

Morgan v. Pennsylvania General Ins. Co.,
87 Wis. 2d 723 (Wis. 1979).....32

Netzer v. Continuity Graphic Associates Inc.,
963 F. Supp. 1308 (S.D.N.Y. 1997).....19

N. Ins. Co. v. Travelers Ins. Co.,
No. 1:15-cv-01810-LJM-DML,
2016 U.S. Dist. LEXIS 172671 (S.D. Ind. Dec. 14, 2016).....14

Onassis v. Christian Dior-New York, Inc.,
472 N.Y.S.2d 254 (S.D.N.Y. 1984).....17, 19, 20

Palsgraf v. Long Island R.R. Co.,
248 N.Y. 339 (N.Y. 1928) .....30

Rottier v. Cannon,
2013 Wis. App. 34, ¶ 9 (2013).....15

Sigler v. Kobinsky,
2008 WI App 183, 314 Wis. 2d 784, 762 N.W.2d 706 .....34, 35

Stayart v. Yahoo! Inc.,
651 F. Supp. 2d 873 (E.D. Wis. 2009).....21, 27, 28, 29

Stayart v. Yahoo! Inc.,
623 F.3d 436 (7th Cir. 2010) .....23, 24, 27

Souza v. Algoo Realty, LLC,
No. 3:19-cv-00863 (MPS),
2020 U.S. Dist. LEXIS 162004 (D. Conn. Sep. 4, 2020) .....30

Tesar v. Anderson,
329 Wis. 2d 240 (Wis. App. 2010) .....29, 30

Thomas v. Kells,
53 Wis. 2d 141 (1971) .....29

Toth-Gray v. Lamp Liter, Inc.,
2019 U.S. Dist. LEXIS 127957 (N.D. Ill. 2019) .....21, 27

Victory Records, Inc. v. Kalnoky,
No. 15 C 9180, 2016 U.S. Dist. LEXIS 74855 (N.D. Ill. June 8, 2016) .....14

Web Printing Controls Co. v. Oxy-Dry Corp.,
906 F.2d 1202, 1204-05 (7th Cir. 1990).....22

W. Bend Mut. Ins. Co. v. Schumacher,
844 F.3d 670 (7th Cir. 2016) .....13, 24, 26, 29

White v. Samsung Elecs. Am., Inc.,
971 F.2d 1395 (9th Cir. 1992) .....25, 28, 29

NOW COMES the PLAINTIFF LUCIANNE M. WALKOWICZ ("Plaintiff" or "Dr. Walkowicz" or "Lucianne"), by and through their attorneys, Mudd Law Offices, and submits this Response in Opposition to Defendants' AMERICAN GIRL, LLC and AMERICAN GIRL BRANDS, LLC (collectively, "American Girl") as well as MATTEL, INC. ("Mattel") ("American Girl" and "Mattel" collectively, "Defendants"), Fed. R. Civ. P. 12(b)(6) Motion to Dismiss the Plaintiff's Amended Complaint, stating as follows:

## INTRODUCTION

The Defendants' 12(b)(6) Motion to Dismiss asks this Court to disregard the extensive and well pled facts related to the Plaintiff's career, life, recognition, and public persona, and ignores the unlawful actions taken by the Defendants when they appropriated Lucianne to develop and market the 2018 LUCIANA VEGA doll ("LUCIANA VEGA"). Furthermore, the Defendants' Motion to Dismiss purposefully misconstrues the facts of this case in a failed attempt to imply that the idea for a LUCIANA VEGA doll was in the works for 20 years. As the facts below will show, this is untrue.

## FACTUAL BACKGROUND

The timeline of the Defendants' LUCIANA and PRINCESS LUCIANA trademark applications prove that the LUCIANA VEGA doll was not created independent of their knowledge of Lucianne Walkowicz.

In July 2006, Defendant Mattel first filed a 1b application (also known as an "intent to use" application) for the name LUCIANA as a mark in conjunction with "dolls, doll clothing and doll accessories". Am. Compl. ¶ 49. Just one month later in August 2006, Defendant Mattel then filed for PRINCESS LUCIANA in conjunction with "dolls, doll clothing and doll accessories" as an "intent to use" status. Am. Compl. ¶ 52. By filing with an "intent to use" status, the Defendants represent that it had not yet begun to use the mark in commerce in conjunction with the class of goods for which it sought a registered trademark. Am. Compl. ¶ 50. Not only that, but Defendants filed many of these marks, including LUCIANA and PRINCESS LUCIANA without any design specimen or concept attached. Am. Compl. ¶¶ 49, 50, 52, 70. Ostensibly, by locking down over 100 unique personal names over the last 30 years with only an "intent to use" trademark application, the Defendants have the ability to pick from a variety of names whenever inspiration strikes to actually manufacture a new doll. Am. Compl. ¶ 66.

On November 26, 2007, a little over a year after initially filing the names LUCIANA and PRINCESS LUCIANA, Mattel filed a Statement of Use and specimen in conjunction with PRINCESS LUCIANA:


I Sing!
Barbie
The Island Princess
Princess Lucianna
WARNING:
3+
Barbie

Am. Compl. ¶¶ 53, 54. However, as there was clearly no real concept for LUCIANA, by August 2010, LUCIANA was abandoned after never having been registered, despite Defendant Mattel's several requests for an extension of time to file a Statement of Use. Am. Compl. ¶ 51. Nevertheless, On June 10, 2010, Mattel again filed for "Luciana" as a mark in conjunction with "dolls, doll clothing and doll accessories" as an "intent to use" status. Am. Compl. ¶ 56. And, again, Mattel filed for five (5) extensions of time in which to file a Statement of Use. Id. Eventually, the USPTO marked the application as abandoned February 3, 2014. Id. It is evident that from the time the LUCIANA application was submitted until it was abandoned for the second time in 2014, no independent ideas existed for the creation of a space-themed doll. However, in only two short years that would all change.

Dr. Lucianne Walkowicz is a prominent, internationally-recognized astronomer and TED Senior Fellow at the Adler Planetarium. Am. Compl. ¶¶ 17, 26. Lucianne is known for being an integral part of several space missions, including the Hubble Space Telescope and NASA's Kepler Mission. Am. Compl. ¶ 26. Lucianne's work on NASA's Kepler Mission significantly consists of studying the constellation Lyra at its center. Am. Compl. ¶¶ 18, 19. At the center of Lyra sits Vega, the brightest star in its constellation. Am. Compl. ¶ 20. In Lucianne's 2011 TED talk on the Kepler Mission, "Finding Planets Around Other Stars," Lucianne discusses Vega at length. Am. Compl. ¶¶ 21-22. To date, "Finding Planets Around Other Stars" received over a million views on the TED website. Am. Compl. ¶¶ 22-23.

On September 29, 2014, an advertisement appeared in the Wisconsin State Journal announcing Lucianne's upcoming visit to Monona Terrace as a TED speaker in relation to the Kepler mission. Am. Compl. ¶ 24. On September 30, 2014, Lucianne presented a lecture at Monona Terrace, a convention center approximately 8 miles away from American Girl headquarters in Madison, Wisconsin. Am. Compl. ¶¶ 25, 71. At the time of Lucianne's heavily

marketed presentation at Monona Terrace, Rebecca DeKuiper ("DeKuiper"), a Lead Designer of the "Girl of the Year" brand for American Girl, owned a residential property less than three miles from Monona Terrace. Am. Compl. ¶¶ 73-75. If not DeKuiper herself, at least one American Girl employee or consultant attended Lucianne's well-publicized TED talk at the Monona Terrace. Am. Compl. ¶¶ 76, 77.

As Lucianne's status continued to rise, in March 2015, Lucianne delivered a presentation about the ethics of Mars exploration, which racked up over 2 million views on the TED website. Am. Compl. ¶¶ 28, 36. Furthermore, on April 12, 2016, Lucianne served as a panelist for the TED article entitled "4 Big Questions About the Race to Mars." Am. Compl. ¶ 37. Lucianne has been involved in and appeared on the National Geographic television series "Mars" about colonization of Mars and the implementation of Mars habitats. Am. Compl. ¶ 41. In addition to Lucianne's scientific studies and advocacy closely associated with Mars, Lyra, and Vega, Lucianne is recognizable for wearing space themed clothing, the purple streak in their hair, and holographic shoes for many of the highly publicized speaking events. Am. Compl. ¶¶ 26, 46-48.

Am. Compl. ¶ 28.

In early October 2016, two major space related events in Wisconsin had engaged Lucianne as a presenter. Am. Compl. ¶¶ 30, 32. Both events were promoted throughout Madison, Wisconsin. Am. Compl. ¶ 24. On October 7, 2016, American Girl Brands, LLC, executed a contract with NASA to consult on the accuracy of its dolls. Am. Compl. ¶ 81.

On October 10, 2016, Lucianne participated as an expert in a well-publicized day of space activities at the University of Wisconsin Space Place in Madison, Wisconsin. Am. Compl. ¶ 30. During Lucianne's time at the University of Wisconsin Space Place, many parents and teachers participated in astronomy activities led by Lucianne. Am. Compl. ¶ 31. At least one American Girl employee or consultant attended the day of space activities at the University of Wisconsin Space Place in Madison, Wisconsin on October 10, 2016 in which Lucianne participated. Am. Compl. ¶ 78.

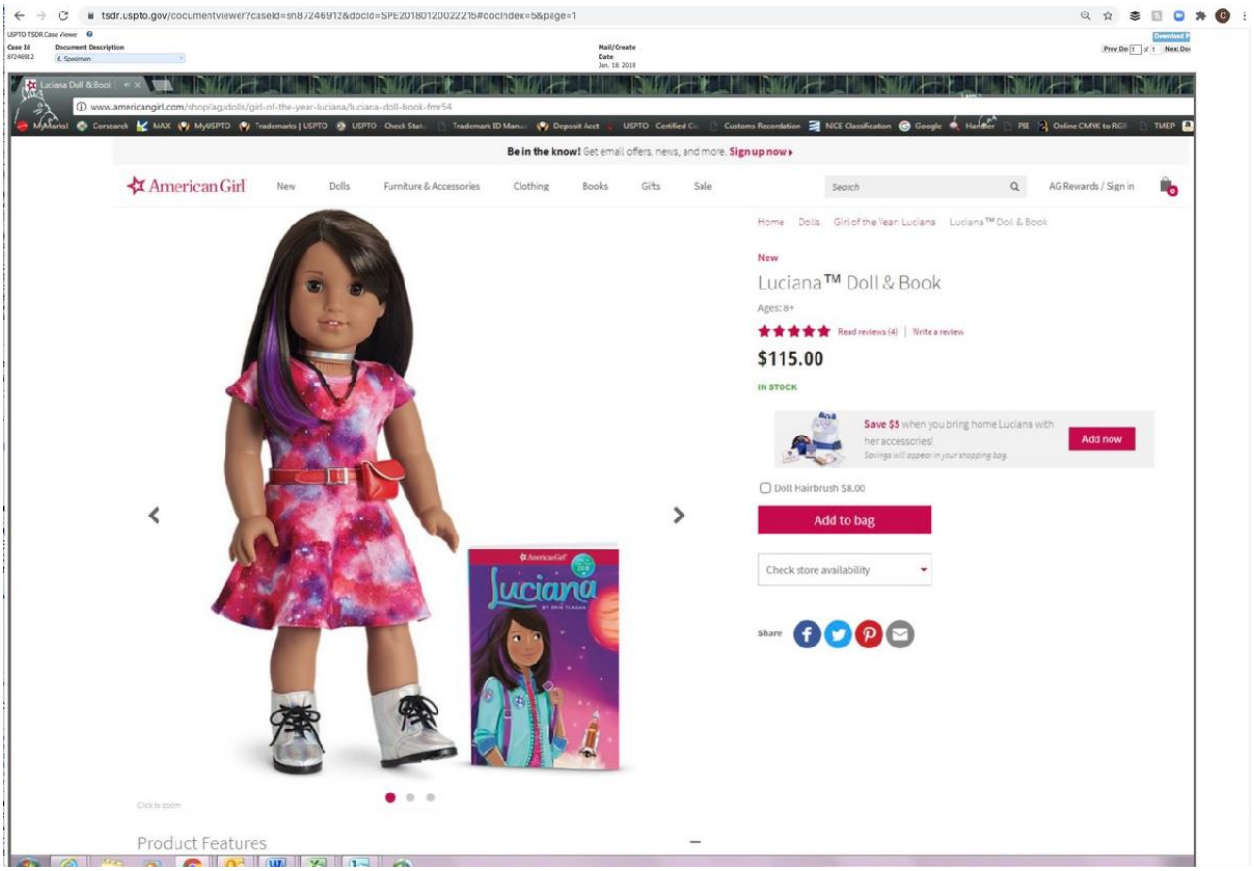
On October 11, 2016, Lucianne, as a representative of the Adler planetarium, presented at public science outreach events in Trempleau, Wisconsin as well as LaCrosse, Wisconsin. Am. Compl. ¶ 32. At least one American Girl employee or consultant attended the public science outreach events in Trempleau, Wisconsin as well as LaCrosse, Wisconsin at which Lucianne presented on October 11, 2016. Am. Compl. ¶ 79.

On October 13, 2016, Lucianne, together with other leading innovators in the world, participated in the White House Frontiers Conference in Pittsburgh, Pennsylvania. Am. Compl. ¶ 33. Just days following the creation of their contract, Dr. Ellen Stofan, the NASA doll consultant for American Girl, attended the White House Frontiers Conference in Pittsburgh, Pennsylvania where Lucianne presented. Am. Compl. ¶ 82.

Armed with their newfound concept for their next American Girl "Girl of the Year" doll to be modeled after Lucianne, the Defendants began moving with incredible speed into

development. On November 23, 2016, the American Girl Defendants filed an application for the mark "LUCIANA" in conjunction with "dolls and doll accessories" pursuant to Trademark Act Section 1(b) indicating a bona fide intention to use the mark with the described goods. Am. Compl. ¶ 83. Shortly thereafter on December 15, 2016, American Girl filed an application for the mark "LUCIANA VEGA" in conjunction with "dolls, doll clothing and doll accessories" also pursuant to 1(b). Am. Compl. ¶ 84. Throughout 2017, the Defendants continued to collect information on Lucianne and data from their NASA doll consultant in order to comprehensively develop the back story for the LUCIANA VEGA doll based on Lucianne's name, likeness, image, and persona. On April 11, 2017, the United States Patent and Trademark Office published the "LUCIANA" mark for opposition. Am. Compl. ¶ 85.

On January 18, 2018, American Girl filed its Statement of Use and specimen for the November 23, 2016 application for "LUCIANA" along with the following image:



Am. Compl. ¶¶ 87-88. On March 13, 2018, the USPTO registered the "LUCIANA" mark with registration number 5424449. Am. Compl. ¶ 89. On March 28, 2018, American Girl filed its Statement of Use and specimen for the "LUCIANA VEGA" trademark application containing the following image:


American Girl
Luciana
Vega
GIRL OF THE YEAR
2018
WARNING:
ADVERTENCIA:
ATTENTION:
8+

Am. Compl. ¶¶ 91-92. The USPTO granted the registration on June 12, 2018 as registration number 5493072. Am. Compl. ¶ 93.

American Girl dolls are distinct due to each doll's highly personalized individual story arc and carefully curated appearance. Am. Compl. ¶¶ 64, 96, 98-99. So, while the concept of a space-themed doll is not an original idea, Mattel's Astronaut Barbie doll, for example, is highly distinguishable from LUCIANA VEGA. Am. Compl. ¶ 125; Defs.' Mem. p. 9; Defs.' Exs. 9-10. In developing the American Girl "Girl of the Year" dolls, the Defendants conduct an extensive amount of research to ensure the thematic accuracy of the character each doll depicts. Regarding the doll at issue, Defendant American Girl Brands, LLC executed a contract with NASA to consult on the accuracy of the doll, and even had a designated NASA doll consultant in Dr. Ellen Stofan. Am. Compl. ¶¶ 81, 82.

Beginning in January 2018 and throughout the rest of that year, LUCIANA VEGA was heavily promoted by the Defendants as their 2018 "Girl of the Year" doll. Am. Compl. ¶¶ 94-95. To lend to the legitimacy of the Defendants' attention to astronomical and space related detail in creating the doll, the LUCIANA VEGA advertisements use a quote from Dr. Ellen Stofan. Am. Compl. ¶ 99.

Upon the public release of LUCIANA VEGA, the Plaintiff was immediately inundated with emails, phone calls, and messages on social media regarding the clear similarities between the Plaintiff and the LUCIANA VEGA doll. Am. Compl. ¶ 129. Every identifying trait of Lucianne's - name, purple streaked hair, dress, holographic shoes, mannerisms, profession, and even specific aspects of Lucianne's lifelong research – were now embodied by LUCIANA VEGA. Am. Compl. ¶¶ 103-127, 130. In fact, Lucianne's achievements regarding the ethics of Mars exploration and work on the Kepler Field are so distinctive to Lucianne's career, that the LUCIANA VEGA doll created confusion as to Lucianne's endorsement of the brand and

product. Am. Compl. ¶ 131. Indeed, Lucianne received numerous inquiries as to Lucianne's endorsement of the brand and product from friends and colleagues alike. Am. Compl. ¶ 132.

As the Defendants' marketing campaign of LUCIANA VEGA persisted, the confusion between the Plaintiff and the doll led to interference with Lucianne's professional public persona. Am. Compl. ¶ 136. While some people that noticed the doll's similarities to Lucianne believe the Plaintiff should see the doll as a compliment, the fact of the matter is that the Defendants modeled the LUCIANA VEGA doll on the Plaintiff's life, appearance, and professional achievements, and did so without permission. Am. Compl. ¶¶ 134, 138. While Lucianne supports and encourages efforts to involve young girls in STEM, the Defendants' actions in literally selling Lucianne's name, likeness, image, and persona without Lucianne's permission in the form of an expensive doll outside the economic reach of many young girls and families is highly objectionable. Am. Compl. ¶¶ 137 and 139.

In developing LUCIANA VEGA, the Defendants exploited Dr. Lucianne Walkowicz's name, likeness, image, and persona, without permission. Am. Compl. ¶ 94. As detailed in the Plaintiff's Amended Complaint, the facts quite simply show that Defendants had absolutely zero concept for developing LUCIANA, then, once Defendants are exposed to Lucianne in 2016, a flurry of activity ensued, resulting in the 2018 LUCIANA VEGA "Girl of the Year" doll. See generally, Am. Compl.

However, the Defendants make efforts to persuade this Court that the LUCIANA VEGA doll had been conceptualized well before Lucianne became famous. Defs.' Mem. p. 8-10. The facts as alleged and as they exist clearly demonstrate the false nature of the Defendants' narrative. To begin with, the Defendants did develop the face mold of the doll some time ago. Am. Compl. ¶¶ 49-59, 125; Defs.' Mem. p. 8-9; Defs.' Exs. 3 and 4. Likewise, the Defendants had trademarked LUCIANA along with PRINCESS LUCIANA in relation to dolls. Id. And,

Defendant Mattel may have separately created a Barbie doll – apart from LUCIANA VEGA - related to space. Defs.' Mem. p. 9; Defs.' Exs. 9-10. The Plaintiff has acknowledged this. Am. Compl. ¶¶ 49-59, 62, 63, 104, 107, 125. However, these activities occurred long before the Defendants' knowledge of Lucianne Walkowicz. The Defendants only combined these items in a doll with features reflective of Lucianne Walkowicz after being exposed to Lucianne. Am. Compl. ¶¶ 71-102. The Defendants did not create LUCIANA VEGA independent from their knowledge of the Plaintiff. Am. Compl. ¶¶ 71-83, 103, 126-127. Specifically, the Plaintiff's Amended Complaint does not allege that any of abandoned LUCIANA trademark applications or the PRINCESS LUCIANA trademark application have any relation to this case. Am. Compl. ¶¶ 49-59. Additionally, the Plaintiff does not make any inference whatsoever that the face mold used for LUCIANA VEGA was in any way molded after Lucianne.

That being said, the Defendants' argument on these factual points only reinforces the claims presented in the Plaintiff's Amended Complaint. The Defendants' red herring attempt to discredit the Plaintiff's claims only substantively shows that the Defendants' had absolutely zero concept in mind to create LUCIANA VEGA prior to learning of Lucianne.

## ARGUMENT

For the reasons articulated below, the Defendants' motion to dismiss should be denied in its entirety.

### I. Section 12(B)(6) Dismissal Standard

In evaluating a Rule 12(b)(6) motion to dismiss, a Court must accept the complaint's factual allegations as true and draw all permissible inferences in Plaintiffs' favor. W. Bend Mut. Ins. Co. v. Schumacher, 844 F.3d 670, 675 (7th Cir. 2016) (quoting Ashcroft v. Iqbal, 556 U.S. 662, 678, 129 S. Ct. 1937, 173 L. Ed. 2d 868 (2009)). Accordingly, to survive a motion to dismiss under 12(b)(6), a complaint need only "contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" Ashcroft v. Iqbal, 556 U. S. at 678 (quoting Bell Atl. Corp. v. Twombly, 550 U.S. 544, 570, 127 S. Ct. 1955, 167 L. Ed. 2d 929 (2007)). 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." W. Bend Mut. Ins. Co., 844 F.3d at 675 (quoting Ashcroft, 556 U.S. at 678). Therefore, a motion to dismiss should be denied "where the pleading asserts non- conclusory, factual allegations that, if true, would push the claim 'across the line from conceivable to plausible.'" Ashcroft, 556 U. S. at 678 (quoting Twombly, 550 U.S. at 570). As such, a court can only consider what is contained within the four corners of the complaint—it must "limit its consideration to the pleadings and exhibits attached to the pleadings and, . . . accept the plaintiff's allegations as true and evaluate all plausible inferences from those facts in favor of the plaintiff." Gulfstream Media Group, Inc. v. PD Strategic Media, Inc., No. 12-62056 CIV, 2013 WL 1891281, at *3 (S.D. Fla. May 6, 2013). See also Erickson v. Pardus, 551 U.S. 89, 94 (2007); McGowan v. Hulick, 612 F.3d 636, 637 (7th Cir. 2010).

To decide a Rule 12(b)(6) motion to dismiss, the courts may not look beyond the pleadings. N. Ins. Co. v. Travelers Ins. Co., No. 1:15-cv-01810-LJM-DML, 2016 U.S. Dist. LEXIS 172671, at *13 (S.D. Ind. Dec. 14, 2016). In their Motion to Dismiss, the Defendants improperly rely on the Second Declaration of Mark S. Lee, which seeks to introduce facts outside of the Plaintiff's Amended Complaint. As such, this Court should strike said Declaration and the contents therein should not be considered in ruling on Defendants' Motion to Dismiss. See Victory Records, Inc. v. Kalnoky, No. 15 C 9180, 2016 U.S. Dist. LEXIS 74855, at *11 (N.D. Ill. June 8, 2016) (where court refused to consider defendant's assertions as they were facts outside of the pleadings in a 12(6)(b) motion to dismiss); Kinney ex rel NLRB v. Dominick's Finer Foods, Inc., 780 F. Supp. 1178, 1182 (N.D. Ill. 1991) (court disregarded relevant facts that were improper when considering a Rule 12(b) motion as they were not contained in the plaintiff's complaint).

## II. Plaintiff Sufficiently Pleads Violation of Right to Privacy Wis. Stat. § 995.50.

The Plaintiff sufficiently pleads a violation of Wisconsin's Right to Privacy statute § 995.50. Like many states, Wisconsin codified the common law privacy tort of misappropriation or "right to publicity." Wis. Stat. § 995.50. Under this statute, Wisconsin recognizes the right of a person to be protected from an unreasonable invasion of one's privacy occurring through "the use, for advertising purposes or for purposes of trade, of the name, portrait or picture of any living person, without having first obtained the written consent of the person [. . . .]" Wis. Stat. § 995.50(2)(b). This statute differs from other privacy torts[1] in that it seeks to protect the property interest one has in their name or likeness from commercial exploitation by others. Hirsch v. S.C.

[1] Of course, this lawsuit does not involve the remaining privacy "right to be let alone" torts of intrusion upon seclusion, public disclosure of private facts, or false light. As such, any discussion of violating Lucianne's right to privacy refers to § 995.50(2)(b).

Johnson & Son, Inc., 90 Wis. 2d 379, 387-89 (1979); Judith Endejan, *The Tort of Misappropriation of Name or Likeness Under Wisconsin's New Privacy Law*, 1978 Wisconsin Law Review 1029, 1030; see also, Conrad v. Madison Festivals, Inc., No. 09-cv-499-bbc, 2009 U.S. Dist. LEXIS 85170 *11 (W.D. Wis. Sept. 15, 2009) (holding that Wisconsin recognizes a right of publicity under both Wis. Stat. § 995.50(2)(b) and common law).

To establish a claim under Wis. Stat. § 995.50(2)(b), a plaintiff must show use: 1) of their name, portrait or picture; 2) for advertising purposes or purposes of trade; and 3) without written consent. Rottier v. Cannon, 2013 WI App 34, ¶ 9 (2013). While there exists limited Wisconsin case law directly on point with the case at bar, § 995.50(3) provides that "the right of privacy recognized in this section shall be interpreted in accordance with the developing common law of privacy [. . .]". Wis. Stat. § 995.50(3). Indeed, since codifying the appropriation tort into law in 1977, Wisconsin courts continue to interpret Wis. Stat. § 995.50(2)(b) under this state's common law privacy analyses, as well as by considering persuasive authority from other jurisdictions. Hirsch, at 387-388; Bogie v. Rosenberg, 705 F.3d 576 (7th Cir. 2005) ("[s]ound analysis of Wisconsin privacy law as codified in section 995.50 therefore includes consideration of the developing common law of privacy in Wisconsin, as well as in other jurisdictions"). Here, the Plaintiff can satisfy each element for purposes of surviving the Defendants' 12(b)(6) motion.[2]

**A. Defendants' Use the Plaintiff's "Name"**

The Defendants use the Plaintiff's name for their LUCIANA VEGA doll. In determining whether a plaintiff's name was improperly used to establish a claim, the court in Hirsch held "**all that is required** is that the name clearly identify the wronged person." Hirsch, at 398 (finding that "Crazylegs Shaving Gel" infringes on the right of publicity of football player, Elroy Hirsch,

[2] For obvious reasons, the Defendants do not contest the "consent" element. As they contend they did not use Lucianne's name, likeness, or persona, they implicitly acknowledge not obtaining Lucianne's consent to do so.

despite "Crazylegs" only being the plaintiff's nickname); McFarland v. Miller, 14 F.3d 912 (3rd Cir. 1994) (holding that the George McFarland, who played a character named "Spanky" on a television show as a child, retained a commercial interest in the name "Spanky McFarland" when the defendant opened a restaurant by that name). The court in McFarland explained their holding, stating that "[i]t is unfair that one should be permitted to commercialize or exploit or capitalize upon another's name, reputation or accomplishments merely because the owner's accomplishments have become highly publicized." McFarland, at 922 (internal quotations omitted).

The Defendants used the Plaintiff's name for the LUCIANA VEGA doll by implementing a variation of Lucianne's first name in conjunction with a star for which Lucianne has studied for many years, and long been widely affiliated. In applying the reasoning of Hirsch to the present litigation, the variation of the name is enough. Hirsch, at 398. Then, on top of using a variation of "Lucianne" for their doll, Defendants add in "Vega" a star closely affiliated with Lucianne. Am. Compl. ¶¶ 42, 45, 126. Moreover, the timeline of the Defendants' trademark application for LUCIANA VEGA shows that the Defendants only created the full name upon learning of Lucianne and Lucianne's professional endeavors. Am. Compl. ¶ 147. In fact, there is no doubt that the doll "clearly identifies the wronged person" as required by Hirsch. Am. Compl. ¶ 152. The public has in fact identified Lucianne from the attributes of the LUCIANA VEGA doll. Am. Compl. ¶¶ 132 and 136. Based on the foregoing, Plaintiff's Complaint meets the 12(b)(6) burden with respect to this element. Id.

**B. The Defendants Use the Plaintiff's "Portrait or Picture**."

In addition to sufficiently using her name for purposes of § 990.50(2)(b), the Defendants used Lucianne's "picture or portrait" for the LUCIANA VEGA doll. Wis. Stat. § 990.50(2)(b). To qualify as a "picture or portrait" of the plaintiff, the actual depiction need not be a literal

photograph of a plaintiff.[3] Onassis v. Christian Dior-New York, Inc., 472 N.Y.S.2d 254, 261 (S.D.N.Y. 1984) ("A photograph may be a depiction only of the person before the lens, but a 'portrait or picture' gives wider scope, to encompass a **representation which conveys the essence and likeness** of an individual, not only actuality, but the close and purposeful resemblance to reality."); see also Binns v. Vitagraph Co. of America, 210 N.Y. 51, 55 (N.Y. Ct. App. 1913).

Here, the Defendants obviously misappropriated the Plaintiff's "essence or likeness" to create LUCIANA VEGA. Throughout the course of Lucianne's career, the Plaintiff' has made countless high-profile public appearances. Am. Compl. ¶¶ 22, 23, 37, 39-41. Lucianne is recognized by a stand-out appearance which consists of a purple streak in dark brown hair[4], sporting holographic shoes, and space patterned dress[5]. Am. Compl. ¶¶ 46-48, 114. Furthermore, as a prominent scientist, Lucianne's unique style undeniably sets Lucianne apart from the sea of business casual peers. The Plaintiff alone hones this unique style and is widely recognized for it. Am. Compl. ¶¶ 26-34, 42, 46-48. Moreover, when one considers the Plaintiff's recognizable appearance in conjunction with the Plaintiff's expertise in the ethics of Mars exploration[6], it is clear that the Plaintiff's entire public persona was appropriated by the Defendants for their LUCIANA VEGA doll. Am Compl. ¶¶ 46-48, 103-127. In fact, as noted above, Lucianne's peers and members of the public have noted the close and personal resemblance of the doll to Lucianne's reality. Am. Compl. ¶¶ 128-136; Onassis, 472 N.Y.S.2d at 261.

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[3] The Defendants may very well have used one or more photographs of the Plaintiff in their conduct. Given the Plaintiff has sufficiently alleged the claim, the Plaintiff should be permitted to explore this through discovery.

[4] Although not worth more than a footnote, the Plaintiff does not complain solely of the use of brown hair despite the Defendants exaggerated effort to suggest otherwise.

[5] See Loftus v. Greenwich Litho. Co., 182 N.Y.S. 428 (N.Y. App. 1st 1920) (holding that the plaintiff's distinctive rose-patterned dress and hat, an element appropriated by the defendants, evidenced the use of her "portrait or picture")

[6] To be sure, Lucianne does not object to the exploration of Mars or a woman being the first astronaut to visit Mars. In their Motion to Dismiss, the Defendants clearly misstate Lucianne's Mars studies to their perceived benefit.

In White v. Samsung Elecs. Am., Inc., the court agreed with the plaintiff, Vanna White, of the television game show, Wheel of Fortune, when she asserted that Samsung Electronics violated her right to publicity when they created an advertisement without her consent that depicted a robot which incorporated recognizable elements of White's role on Wheel of Fortune. White v. Samsung Elecs. Am., Inc., 971 F.2d 1395 (9th Cir. 1992). The Ninth Circuit agreed with the plaintiff, holding:

> Viewed separately, the individual aspects of the advertisement in the present case say little. Viewed together, they leave little doubt about the celebrity the ad is meant to depict. The female-shaped robot is wearing a long gown, blond wig, and large jewelry. Vanna White dresses exactly like this at times, but so do many other women. The robot is in the process of turning a block letter on a game-board. Vanna White dresses like this while turning letters on a game-board but perhaps similarly attired Scrabble-playing women do this as well. The robot is standing on what looks to be the Wheel of Fortune game show set. Vanna White dresses like this, turns letters, and does this on the Wheel of Fortune game show. She is the only one.

White, at 1399.

In an effort to overcome the obviousness of their conduct, the Defendants extensively use four distinguishable cases in their Motion to Dismiss to support their flawed position. Defs.' Mem. pp. 11-14 (citing Bogie v. Rosenberg, 705 F.3d 603 (7th Cir. 2013); Champion v. Take Two Interactive Software, Inc., 100 N.Y.S.3d 838 (N.Y. App. Div. 2019); Lohan v. Take-Two Interactive Software, Inc., 31 N.Y.3d 111 (N.Y. 2018) and Gravano v. Take-Two Interactive Software, Inc., 37 N.Y.S.3d 20 (N.Y. App. Div. 2016)). Of those four cases, only Bogie constitutes controlling law. However, the facts between that case and the present litigation differ significantly. Like the authority from outside this jurisdiction cited by the Plaintiff, Champion, Lohan, and Gravano merely constitute, at best, persuasive authority and not precedent. Yet unlike the authority cited by the Plaintiff, these cases can also be distinguished from the instant circumstances. Indeed, the ruling in all four cases rely on the incidental use exception. Under the incidental use exception, a creator of a work will not be liable for misappropriation of an

individual's name or likeness where the use of the individual's name or likeness for defendant's commercial purpose constitutes only a minor piece of a much broader entire work. Bogie at 615 (citing Netzer v. Continuity Graphic Associates Inc., 963 F. Supp. 1308, 1326 (S.D.N.Y. 1997)). In Bogie, the defendant used the plaintiff's likeness for 16 seconds of an 80-minute film. Bogie at 607. Similarly, in both Lohan and Gravano, the misappropriation about which the plaintiffs complained comprised two minor characters in a game containing close to 200 hundred hours of content. Lohan, 31 N.Y.3d at 117. In Champion, the "persona" at issue constituted one minor, **non-playable**, character in a game with thousands of hours of content. Champion, 100 N.Y.S.3d at 847.

By contrast, the appropriation of Lucianne's "name, portrait or picture" by Defendants is not merely a shallow satirical appearance of a celebrity perception or a "mob wife" as was the case in both Lohan and Gravano. Clearly, these cases can be distinguished from the Defendants' deliberate misappropriation of Lucianne's likeness in a singular American Girl doll that uses the Plaintiff's image as their product. Am. Compl. ¶¶ 148-152, 158-162.

As in White, the Defendants' actions must be viewed as a whole. White, at 1399. Considered in their entirety, the name, appearance, and career focus all unmistakably indicate that the Defendants appropriated Lucianne's "name, portrait or picture" to create and market their product, LUCIANA VEGA. Am. Compl. ¶¶ 147-164. Moreover, the Defendants' entire purpose of using Lucianne's "likeness and essence" was to produce, market, and sell the LUCIANA VEGA doll. Am. Compl. ¶ 127. See Onassis, 472 N.Y.S.2d at 261. In fact, the connection between Lucianne and LUCIANA VEGA is so substantial that LUCIANA VEGA does not exist independent of Lucianne. Am. Compl. ¶¶ 147-152. For those reasons, Lucianne's claim cannot be dismissed pursuant to Wisconsin's "incidental use" exception because nothing about LUCIANA VEGA is incidental – Lucianne's "likeness and essence" **is the product**. Am.

Compl. ¶¶ 127, 151; See also, Onassis, 472 N.Y.S.2d at 261. At the very least, Plaintiff's well-plead Complaint sufficiently meets this element with the specificity necessary to overcome a Rule 12(b)(6) motion.

**C. The Defendants Use the Plaintiff for Advertising and Trade Purposes**

The Defendants use the Plaintiff's "name, portrait or picture" (as detailed above) for purposes of trade and advertising LUCIANA VEGA. Under Wis. Stat. § 995.50(2)(b), "for purposes of trade" is tantamount to "for profit." Bogie, at 613. Lucianne's distinct individual style was lifted entirely for the Defendants' profit in selling and marketing the LUCIANA VEGA doll. Am. Compl. ¶¶ 153-163. The facts show that Lucianne has incredible marketing potential. Am. Compl. ¶¶ 23, 28, 41, 42. The Plaintiff is an extremely engaging speaker on topics of space exploration and astronomy. Am. Compl. ¶¶ 22, 24, 26, 27, 29-31. Lucianne's professional speaking engagements via the TED network garnered millions of views on the TED website. Am. Compl. ¶¶ 23, 28. In the Defendants' intensive research devoted to developing LUCIANA VEGA, they undoubtedly took notice of Lucianne's unique persona. Am. Compl. ¶¶ 71-82. In order to capitalize on Lucianne's distinct attributes, they appropriated the Plaintiff's image and likeness to develop their own doll version of the Plaintiff. Am. Compl. ¶¶ 89, 92, 103-127. Any trade and advertising profit attained by the Defendants from LUCIANA VEGA is entirely the result of the Defendants exploiting Lucianne's publicity for their own profit. Am. Compl. ¶¶ 158, 159. At the very least, Plaintiff's well-plead Complaint sufficiently meets this element with the specificity necessary to overcome a Rule 12(b)(6) motion.

Having shown that the Complaint meets each element of a § 995.50(2)(b) claim, Plaintiff respectfully requests that the Court deny Defendants' motion with respect to this claim.

## II. Plaintiff Sufficiently Pleads a Claim for False Endorsement under the Lanham Act

The Plaintiff sufficiently pleads a claim for false endorsement under the Lanham Act. "False endorsement occurs when a person's identity is connected with a product or service in such a way that consumers are likely to be misled about that person's sponsorship or approval of the product or service." Hart v. Amazon.com, Inc., 191 F. Supp. 3d 809, 819 (N.D. Ill. 2016), aff'd at 191 F. Supp. 3d 809 (7th Cir. 2016), (quoting Stayart v. Yahoo! Inc., 651 F. Supp. 2d 873, 880 (E.D. Wis. 2009)); see, generally, Toth-Gray v. Lamp Liter, Inc., 2019 U.S. Dist. LEXIS 127957, *5-6 (N.D. Ill. 2019). "The key issue in a false endorsement case is whether defendant's use of the [plaintiff's identity] to identify its goods or services is likely to create confusion concerning the plaintiff's sponsorship or approval of those goods or services." Hart, 191 F. Supp. 3d at 819 (citation and internal quotation marks omitted). "Plaintiff must be able to show that the public believe[s] that the [plaintiff] sponsored or otherwise approved of the use of the trademark." Id. at 819. (citation and internal quotation marks omitted).

Although American Girl relies heavily on the winding history of their own trademark registrations, these have no bearing on whether a claim for false endorsement exists. Lucianne's claim is not based solely on the use of a similar name. Rather, it relies on the striking similarity between Lucianne's own name, identity, appearance, wardrobe, and studies made famous through their own public outreach, and that of the American Girl doll. Am. Compl. ¶¶ 168-170, 173. "Although this provision is contained in the Lanham Act, which primarily relates to federally registered trademarks, it is clear that liability under Section 43(a) may arise for a false description or representation even though no trademark is involved." Ames Publ'g Co. v. Walker-Davis Publ'n, Inc., 372 F. Supp. 1, 11 (E.D. Penn. 1974); See also Conrad, at ¶ 8 (affirming that in bringing a claim for false endorsement under the Lanham Act, "federal

registration is not a prerequisite to a suit to prevent someone else from using the mark or a confusingly similar one").

The Defendants do not dispute that the American Girl's doll is used "in commerce," nor could they. Likewise, given that the Defendants argue that the doll does not constitute Lucianne's likeness, they implicitly acknowledge that Lucianne does not endorse the doll, nor do they suggest otherwise. Defs.' Mem. p. 29. Therefore, any perception or representation that Lucianne endorsed the doll would be "false." As a result, the elements in dispute for 12(b)(6) purposes are limited to whether the Complaint contains sufficient facts to show that American Girl has used Lucianne's likeness and whether such use would be likely to create confusion concerning Lucianne's sponsorship or approval of the doll. Web Printing Controls Co. v. Oxy-Dry Corp., 906 F.2d 1202, 1204-05 (7th Cir. 1990) (holding that a plaintiff must only show only likelihood of consumer confusion in order to withstand a motion to dismiss). As delineated below, Lucianne's Amended Complaint meets each disputed element of their Section 43(a) claim and thereby meets the 12(b)(6) pleading standard. Defendants add a separate argument that Lucianne somehow lacks a commercial interest in their likeness and, as a result they somehow lack standing to bring a false endorsement claim under the Lanham Act. Defs.' Mem. pp. 28-29. This argument is likewise addressed below.

**A. The Amended Complaint Sufficiently Pleads Facts Which Give Lucianne Standing to Bring a False Endorsement Claim.**

The Defendants' Motion to Dismiss misconstrues the law applicable to false endorsement under the Lanham Act. A plaintiff has standing to assert a claim for false endorsement under the Lanham Act when they can demonstrate that they have a protectable commercial interest and that a defendant's actions and/or representations lead consumers to believe that the plaintiff endorsed defendant's products. 15 U.S.C. § 1125(a)(1)(A). As a world-renowned, widely recognized

scientist, Lucianne has a protectable commercial interest in the "drawing power" of their name and image in endorsing products and in marketing their career. Allen v. Nat'l Video, Inc., 610 F.Supp. 612, 625 (S.D.N.Y. 1985); See Am. Compl. ¶¶ 22-34. Further, infringement of this commercial interest "also implicates the public's interest in being free from deception when it relies on a public figure's endorsement in an advertisement." Id. at 626. Therefore, the underlying purpose of the Lanham Act is implicated in cases of misrepresentation regarding the endorsement of goods. Id.

In addition, the Defendants' standing argument here fails because they inappropriately ask that this Court make factual determinations in deciding a Motion to Dismiss. A "plaintiff is not required to prove actual palming off" of their name, likeness or image to assert false endorsement. Allen, at 626 (citing Geisel v. Poynter Prods., 283 F. Supp. 261, 267 (S.D.N.Y. 1968)). A showing of the likelihood of consumer confusion is sufficient. Id. To that end, the Geisel court held that "a showing of actual consumer deception was not required, so long as a "tendency to deceive" was demonstrated. Id. Moreover, there is no requirement under the Lanham Act "that plaintiff and defendant actually be in competition." Id. at 628 (internal citations omitted). And certainly, such a conclusive showing is not required to overcome a Rule 12(b)(6) inquiry. As such, the Defendants' argument that a claim under the Lanham Act cannot be supported because Lucianne is not "actively engaged in commercial activity associated with dolls or doll accessories" is simply not true. Defs.' Mem. p. 29. Lucianne makes frequent public appearances and is engaged in various activities which constitute "commerce" based on her persona. See, generally, Am. Compl.

While the Defendants' here relied heavily on Stayart v. Yahoo!, the distinguishing characteristics between the Stayart and the present case are alarmingly dissimilar. Stayart v. Yahoo! Inc., 623 F.3d 436 (7th Cir. 2010). In Stayart, the plaintiff, Beverly Stayart, was a

woman involved in niche charity work who has two poems published on a Danish website. Stayart, 623 F.3d at 437. After searching 'Beverly Stayart' in a Yahoo.com search engine, the results showed a mix of links to pharmaceutical companies and various other innocuous websites which Stayart found "shameful". Stayart, 623 F.3d at 437. Stayart then filed a claim against Yahoo! for trademark infringement under the Lanham Act when Yahoo! refused to censor its search engine results to favor results for Stayart's charitable activity. Id. at 438. The court dismissed Stayart's claims against Yahoo!, on the basis that her activities did not allow her standing to dictate what search results appear when her name is typed into a Yahoo! search engine Id. at 439.

Unlike in Stayart, Lucianne is not only asserting that her name was used, but also her image and career. See, generally, Am. Compl. More importantly in the present litigation, the "commercial activities" at issue are the Defendants' misappropriation of Lucianne's name and likeness for the sale and advertising of their LUCIANA VEGA doll. Am. Compl. ¶ 168. It is clear that the Defendants' overt actions in reproducing Lucianne's name and likeness for LUCIANA VEGA is a far cry from the facts in Stayart. As it follows, the striking similarities that the use of Lucianne's likeness can only be deliberate. Am. Compl. ¶ 168-180. It is likewise clear that, contrary to Defendants' assertions, based on the facts plead in the Amended Complaint, Lucianne has standing to bring her claims. Allen, 610 F.Supp. at 625.

Plaintiff's Amended Complaint recites sufficient facts to meet Plaintiff's 12(b)(6) burden with respect to each disputed element of her false endorsement claim. Based on this and the foregoing, and Defendants' motion with respect to Lucianne's claim for false endorsement under Section 43(a) of the Lanham Act should be denied. W. Bend Mut. Ins. Co., 844 F.3d at 675.

**B. The Amended Complaint Sets Forth Sufficient Facts to Show that American Girl Used Lucianne's Likeness and Identity.**

Here, the Defendants used the name and likeness of Lucianne, a well-known figure in astronomy, space, and STEM, who particularly has studied the star Vega, in conjunction with the LUCIANA VEGA doll, without obtaining Plaintiff's authorization. Am. Compl. ¶¶ 103 and 171. While all American Girl "Girl of the Year" dolls are, at the core, identical in physical dimensions[7], the American Girl Defendants take extraordinary steps to make each "Girl of the Year" doll unique. Am. Compl. ¶¶ 64, 81-82, 104-105. Defendants do this by changing the hair, clothes, and skin tone, and further, by curating a niche "personality" by publishing an accompanying book. Am. Compl. ¶¶ 96-99.

The physical representations of the Plaintiff are clearly mirrored in the Defendants' doll. Just like Lucianne sported for years, LUCIANA VEGA has a distinct purple highlighted streak on the right side of her dark brown hair. Am. Compl. ¶¶ 47 and 109. In fact, the purple hair color has long been a distinct feature publicly associated with Lucianne. Am. Compl. ¶¶ 111. As Lucianne has regularly dressed in distinctive holographic shoes, so too does LUCIANA VEGA wear holographic shoes. Am. Compl. ¶ 112. As Lucianne has regularly worn space themed clothing, including space patterned dresses, so too does LUCIANA VEGA also wear a space themed patterned dress. Am. Compl. ¶ 114. Of course, there may be photos of Lucianne wearing different clothes or without a purple streak in her hair, as there may be photos of Vanna White wearing a different hair style or dress. This does not detract from the fact that, taken together, there is little doubt that these attributes are identified with Lucianne and Defendants' doll mirrors them precisely. See, e.g., White, 971 F.2d at 1399 ("Viewed separately, the individual aspects of the advertisement in the present case say little. Viewed together, they leave little doubt about the celebrity the ad is meant to depict.").

[7] In fact, as set out more fully above, they use the identical face mold.

LUCIANA VEGA likewise mirrors the factors that distinguish Lucianne's professional achievements. Am. Compl. ¶¶ 115, 120-122. Similar to Lucianne's professional background in astronomy, space, and STEM, LUCIANA VEGA's entire backstory and career aspirations focus on space. Am. Compl. ¶ 98. Lucianne is an astronomer, and the accessories for LUCIANA VEGA include a telescope, Telescope Projector Set, and star chart, all tools attributed to an astronomer. Am. Compl. 100-101. The accessories also include a space themed blanket for stargazing. Lucianne has been involved in diverse matters related specifically to Mars. Likewise, a central focus of LUCIANA VEGA relates to travelling to Mars. Am. Compl. ¶¶ 118-119. Lucianne has been involved in and appeared on the National Geographic television series "Mars" about colonization of Mars and Mars habitats. Am Compl. ¶ 120. LUCIANA VEGA's accessories include a Mars Habitat. Additionally, in the book "Luciana: Out of This World," Luciana Vega visits NASA scientists in a simulated Mars habitat. Am. Compl. ¶ 121.

Finally, the name itself, LUCIANA VEGA, is derivative of the Plaintiff's own name. Though Defendant Mattel had sought trademarks for LUCIANA to develop a princess doll in 2006, the specimen in that application bears no similarity to the LUCIANA VEGA doll and Defendants abandoned the application years ago. Am. Compl. ¶¶ 49-59. The timing of the second round of a trademark application for use of LUCIANA in conjunction with a doll interested in space exploration and profession in space-centered sciences is not a coincidence. Am. Compl. ¶¶ 83-90. The application for and use of the name LUCIANA VEGA in 2018 as a trademark becomes more striking and directly mirrors Lucianne given Vega's significant focus of Lucianne's studies. Am. Compl. 91-92.

It is clear that LUCIANA VEGA mirrors Lucianne's likeness and identity. At the very least, the Amended Complaint pleads "factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged." W. Bend Mut. Ins.

Co., 844 F.3d at 675. Plaintiff's Amended Complaint recites sufficient facts to meet Plaintiff's 12(b)(6) with respect to this element.

**C. The Amended Complaint Sufficiently Alleges Consumer Confusion as to Endorsement.**

In false endorsement cases like this one, courts in the Seventh Circuit analyze a variety of factors to determine whether the use of a mark creates the likelihood of confusion, including the level of plaintiff's recognition among the segment of the society for whom defendant's product is intended, the relatedness of plaintiff's fame or success to defendant's product, and defendant's intent in selecting the plaintiff. Toth-Gray v. Lamp Liter, Inc., 2019 U.S. Dist. LEXIS 127957, *5-6 (N.D. Ill. 2019) (citing Stayart v. Yahoo! Inc., 651 F. Supp. 2d 873, 883 (E.D. Wis. 2009), aff'd, 623 F.3d 436 (7th Cir. 2010)) (quotations omitted).

Lucianne's fame and success are directly related to the use of Lucianne's likeness by the Defendants for the LUCIANA VEGA doll. Given the appropriation of Lucianne's likeness in so many ways, and her notoriety given her widespread work in astronomy, confusion relating to Lucianne's endorsement of LUCIANA VEGA occurred immediately after the product's release. Lucianne's lifelong achievements regarding the ethics of Mars exploration and work on the Kepler Field are so distinctive to Lucianne's career that the LUCIANA VEGA doll has created actual confusion as to Lucianne's endorsement of the brand and product. Not only that, but upon the public release of the LUCIANA VEGA doll, Lucianne began receiving electronic mail and social media messages relating to the uncanny similarities between the LUCIANA VEGA doll and Lucianne. Am. Compl. ¶ 129. Each person who contacted Lucianne regarding the similarities did so based on the totality of the similarity to Lucianne's name, hair, dress, mannerisms, profession, and even specific aspects of Lucianne's research. Am. Compl. ¶ 130.

Such facts as pled in Plaintiff's Amended Complaint weigh in favor of likely confusion. See Stayart v. Yahoo! Inc., 651 F. Supp. 2d at 883.

Because the Plaintiff has been featured on television programs for scientific research, has engaged in countless public presentations regarding space and STEM, and is a longtime advocate for programs encouraging STEM among young girls, public advertising campaign of the LUCIANA VEGA doll caused **actual public confusion** as to Lucianne's endorsement of LUCIANA VEGA. Am. Compl. ¶¶ 131-133. However, Lucianne objects to the use of Lucianne's name, likeness, image, and persona without permission. Am. Compl. ¶ 138. Further, Lucianne does not appreciate and, in fact, objects to the use of Lucianne's name, likeness, image, and persona without permission in an expensive doll outside the economic reach of many young girls and families. Am. Compl. ¶ 139. Clearly, these facts pled in the Amended Complaint are sufficient to show that "the level of plaintiff's recognition among the segment of the society for whom defendant's product is intended," and weigh in favor of likely confusion. Stayart, 651 F. Supp. 2d at 883.

The clear appropriation of Lucianne's likeness, coupled with the timing of the LUCIANA VEGA doll's product development is strongly indicative of Defendants' "intent in selecting the plaintiff." Id. at 883. Defendant American Girl Brands, LLC executed a contract with NASA to consult on the accuracy of the doll on October 7, 2016. Am. Compl. ¶ 81. Just a few days later, on October 13, 2016, the Defendants' NASA doll consultant, Dr. Ellen Stofan, attended the White House Frontiers Conference in Pittsburgh, Pennsylvania where Plaintiff Lucianne delivered a presentation. Am. Compl. ¶ 82.

The American Girl Defendants filed an application for the mark "LUCIANA" in conjunction with "dolls and doll accessories" pursuant to Trademark Act Section 1(b) indicating a bona fide intention to use the mark with the described goods. Am. Compl. ¶ 83. Shortly

thereafter on December 15, 2016, American Girl filed an application for the mark "LUCIANA VEGA" in conjunction with "dolls, doll clothing and doll accessories" which ultimately issued in a registration Am. Compl. ¶¶ 84-85, 91-92. The "LUCIANA" registration was obtained along a similar timeline. Am. Compl. ¶¶ 87-89, 93. Beginning in January 2018 and throughout the rest of that year, LUCIANA VEGA was heavily promoted by the Defendants as their 2018 "Girl of the Year" doll. Am. Compl. ¶¶ 94-95. To lend to the legitimacy of the Defendants' attention to astronomical and space related detail in creating the doll, the advertisements for the LUCIANA VEGA doll use a quote from Dr. Ellen Stofan, the NASA doll consultant who attended the White House Frontiers Conference at which Lucianne spoke. Am. Compl. ¶ 99. Taken together, these well pled facts show that Defendants did intend to appropriate Lucianne's name and likeness for their doll, indicating a likelihood of confusion. Stayart, 651 F. Supp. 2d at 883.

At the very least, the Amended Complaint pleads "factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged." W. Bend Mut. Ins. Co., 844 F.3d at 675. Plaintiff's Amended Complaint recites sufficient facts to meet Plaintiff's 12(b)(6) with respect to this element. Id.

## III. Count III and Count IV Sufficiently Plead Negligence and Negligent Supervision

The Plaintiff sufficiently pleads both negligence and negligent supervision for purposes of surviving a 12(b)(6) motion to dismiss.

### A. Negligence

First, the Plaintiff sufficiently pleads negligence. "To constitute a cause of action for negligence there must be: (1) A duty to conform to a certain standard of conduct to protect others against unreasonable risks; (2) a failure to conform to the required standard; (3) a causal connection between the conduct and the injury; and (4) actual loss or damage as a result of the injury." Tesar v. Anderson, 329 Wis. 2d 240, 247 (Wis. App. 2010) (citing Thomas v. Kells, 53

Wis. 2d 141, 144 (1971)).

While two different concepts of "duty" were outlined in Palsgraf v. Long Island R.R. Co., Wisconsin has long followed the dissent of Judge Andrews in that opinion. Tesar, at 247. Judge Andrews explained that "everyone owes to the world at large the duty of refraining from those acts that may unreasonably threaten the safety of others." Id. (referencing Palsgraf v. Long Island R.R. Co., 248 N.Y. 339 (N.Y. 1928). In the present case, the Defendant companies had a duty to refrain from using another person's name and likeness for commercial products, as the harm to the Plaintiff in doing so was foreseeable. By appropriating Lucianne's name and likeness for their own commercial gain, and allowing the doll to enter the stream of commerce without first evaluating whether it misappropriated the name and likeness of a person resulting in harm to that person, the Defendants breached their duty of care. As it follows, the Defendants' breach was the sole proximate cause of harm to the Plaintiff, resulting in damages related to the false endorsement of LUCIANA VEGA. See Souza v. Algoo Realty, LLC, No. 3:19-cv-00863 (MPS), 2020 U.S. Dist. LEXIS 162004, at *30-31 (D. Conn. Sep. 4, 2020) (where the court held defendants "owed a duty to the [p]laintiffs and to consumers to refrain from publishing misappropriated and altered images for the financial benefit of the defendants" and that it was reasonably foreseeable to anticipate the harm that would result from such misappropriation for commercial purposes). See also Hinton v. Vonch, LLC, No. 18 CV 7221, 2019 U.S. Dist. LEXIS 129934, at *8 (N.D. Ill. Aug. 2, 2019) (in negligence claim where defendant used images of models in unauthorized Facebook advertisements, court found defendant owed plaintiffs a duty to exercise ordinary care for injuries that naturally flow as a reasonably probable and foreseeable consequence of defendant's actions).

In their Motion to Dismiss, the Defendants argue that, "After a diligent search, American Girl has found no authority that supports the existence of the duty that Walkowicz asserts." Defs.

Mem. p. 32. In the next sentence, Defendants misapply a quote from Section 92 of the infamous Prosser and Keeton On the Law of Torts, that "'there is no general duty to exercise reasonable care to avoid intangible economic loss or losses to others that do not arise from tangible physical harm to persons or tangible things.'" Id. quoting W. Page Keeton et al., Prosser and Keeton on the Law of Torts § 92, at 657 (5th ed. 1984). Section 92 is entitled "Tort and Contract Obligations as Between Parties to a Contract," and the cited quote is from subsection 4, "Recovery of intangible economic losses is normally determined by contract law." Prosser and Keeton on the Law of Torts § 92, at 657. Nowhere in the Amended Complaint does Plaintiff claim to be in a contractual relationship with Defendants, nor does Plaintiff's claim of negligence argue a duty arising from a contractual relationship. Similarly, Defendants reference The Law of Torts by Fowler V. Harper, et al., and again misapply the "general rule that economic damages alone are not compensable in negligence." Defs. Mem. p. 32 citing Fowler V. Harper et al., The Law of Torts §§ 25.18A to 25.18D (2d ed. 1986). The general rule to which the book is referring in Section 25.18 is the "economic loss rule," which simply does not apply in the instant case, but is instead reserved for unforeseeable third parties.[8] See generally Law of Torts §§ 25.18A to 25.18D. Here, the Defendants actions directly resulted in injury to the Plaintiff beyond purely economic losses.

Despite the rather straight-forward claim for negligence, the Defendants raise public policy considerations in their Motion to Dismiss which they incorrectly argue precludes the Plaintiff's claim. Defs. Mem. p. 33. Wisconsin courts tend to consider the following six public

[8] Two classic examples: (1) A carrier delivering chemicals negligently spills them on a factory's property, which shuts down the facility for days. Employees who go unpaid during the shutdown have no tort claim against the carrier. (2) An insurance company's inability to directly recover from an at-fault third-party for monies the insurance company paid to its no-fault insured as a result of the third party's negligence (rather it must pursue claim as subrogee of the rights of its insured).

policy reasons for not imposing liability, despite a finding of negligence: (1) The injury is too remote from the negligence; or (2) the injury is too wholly out of proportion to the culpability of the negligent tort-feasor; or (3) in retrospect it appears too highly extraordinary that the negligence should have brought about the harm; or (4) because allowance of recovery would place too unreasonable a burden on the negligent tort-feasor; or (5) because allowance of recovery would be too likely to open the way for fraudulent claims; or (6) allowance of recovery would enter a field that has no sensible or just stopping point. Morgan v. Pennsylvania General Ins. Co., 87 Wis. 2d 723, 737 (Wis. 1979). None of the public policy reasons listed above apply to the Defendants here. First, the Plaintiff alleges injuries that were a direct and proximate result of the Defendants' negligent actions. Am. Compl. ¶¶ 129, 133-134, 136, 138, and 196. Second, the Defendants are wholly and singularly culpable for the injuries claimed in Plaintiff's negligence claim. See generally Am. Compl. Third, the Plaintiff's injuries in retrospect were perfectly foreseeable by the Defendants' negligence. Fourth, it is in no way unreasonable to deter the Defendants' from misappropriating people's likenesses for their own commercial gain. Fifth, it is difficult to imagine an underlying action less likely to open the way for fraud than claims based on a defendant's unauthorized use of a plaintiff's likeness. Sixth, and lastly, allowing recovery in this case would not open a floodgate of litigation that has no sensible or just stopping point. Indeed, liability would be well defined and limited to the improper use of another's likeness, especially for commercial gain.

In fact, as far as public policy considerations go, the notion that a defendant corporation would have a duty to refrain from allowing a product to go through the development process and enter the stream of commerce which misappropriates a person's name and likeness for the sale and advertisement of their products is a duty of care that reasonable minds can agree upon. In fact, this line of thinking largely mirrors products/strict products liability and fundamental

fairness, whereby manufacturers are responsible for damages to an injured person when the manufacturer can reasonably design a product that does not injure consumers. See Horst v. Deere & Co., 2009 WI 75, ¶25, 319 Wis. 2d 147, 769 N.W.2d 536 (describing rationales behind products liability legislation). Here, the Defendants chose not to engage in any discussions with the Plaintiff before it sent a product to market using her likeness. At any point in production, the Defendants could have modified the LUCIANA VEGA doll, so as to distinguish it from the Plaintiff and remove the possibility of injury to the Plaintiff. Additionally, while the Defendants argue that the Plaintiff's negligence claim "does nothing more than restate [a] Right of Privacy claim," the Plaintiff's negligence theory is not duplicative and each claim requires proof of different elements. Defs. Mem. p. 33; see Hinton v. Vonch, LLC, No. 18 CV 7221, 2019 U.S. Dist. LEXIS 129934 at 8 (held that negligence theory distinct from Lanham Act theory).

For the forgoing reasons, Plaintiff's well-pled Complaint meets each necessary element of this cause of action and the Defendants' Motion to Dismiss with respect to the Plaintiff's negligence claim must be denied.

**B. Negligent Supervision**

The Plaintiff's claim for Negligent Supervision pleads sufficient facts to withstand the Defendants' Motion to Dismiss. See generally Am. Compl. The elements required to find an employer liable under a theory of negligent supervision are: (1) a wrongful act by the employee; (2) the wrongful act by the employee was a cause of injuries to the plaintiff; (3) the employer was negligent in hiring, training or supervising the employee; and (4) the employer's negligence was a cause of the employee's wrongful act. Gomilla v. Libertas, 240 Wis. 2d 325, ¶ 15 (Wis. App. 2000).

First, as plead in the Amended Complaint and argued elsewhere in this Response, the Defendants' employees, through a series of actions, wrongfully used the Plaintiff's name and likeness in the production of a commercial product. Again, the Defendants' employees violated the Plaintiff's privacy and other rights by using the Plaintiff's name, image, likeness, and persona without authorization. Am. Compl. ¶¶ 200-201. The Defendants had a duty to supervise their employees to ensure the employees refrained from using another person's name and likeness in their commercial products and allowing them to proceed through the product development process and enter the stream of commerce. See Johnson v. Misericordia Cmty. Hosp., 99 Wis. 2d 708, 722, 301 N.W.2d 156, 164 (1981) (discussing duty as the obligation of due care to refrain from any act which will cause foreseeable harm in a negligent supervision action). Additionally, the Defendants had a duty of care to supervise their employees to ensure the employees did not violate the Plaintiff's privacy and other rights. See Id. (holding the defendant hospital had a duty to exercise due care in the selection of its medical staff as "failure to properly investigate medical staff applicant's qualifications for the privileges requested gives rise to a foreseeable risk of unreasonable harm"). The Defendants went so far as to hire a consultant to aid in creating the LUCIANA VEGA story and product. The Defendants have a duty to supervise how that story and product are developed, to understand the source material for that story and product, and to supervise their employees to ensure that the story and product do not misappropriate the name and likeness of another in violation of Federal law.

The Defendants' seemingly attempt to draw similarities between the instant action and the distinguishable cases of Sigler v. Kobinsky and Maypark v. Securitas Sec. Serv's USA, Inc., both of which involve employees using company property while committing torts for largely personal reasons. Defs. Mem. p. 35; Sigler v. Kobinsky, 2008 WI App 183, ¶11, 314 Wis. 2d

784, 762 N.W.2d 706; Maypark v. Securitas Sec. Servs. USA, 2009 WI App 145, ¶¶14-15, 321 Wis. 2d 479, 775 N.W.2d 270. Sigler involved an employee that launched a campaign of online harassment, using his employer's computer, against another individual in what appeared to be a personal vendetta. Sigler v. Kobinsky, 2008 WI App 183, ¶¶1-4. Similarly, Maypark involved an employee security guard that utilized his access to company files to download employee photographs and post them on an adult website. Maypark v. Securitas Sec. Servs. USA, 2009 WI App 145, ¶¶3-5.

Unlike the instant case, in both Sigler and Maypark the employee's behavior was not foreseeable. Moreover, in Maypark, the defendant business actually provided sexual harassment training that instructed against its employee's actions. Id. ¶ 15. Here, the Plaintiff alleges that the actions of the Defendants' employees is and was foreseeable, and that such actions could cause injury to another. Am. Compl. ¶¶ 200-203. Indeed, these brand-aware Defendants understand the need to protect against seeming endorsement of a product by another person and are therefore aware of the foreseeable harm that arises from unauthorized use and false endorsements. In fact, at least one or more Defendants have, in the past, filed suit against third parties because of alleged false endorsement perceptions. Am. Compl. ¶¶ 205-206. Nevertheless, by using Lucianne's name and likeness in commercial products and allowing them to proceed through the product development process and enter the stream of commerce, the Defendants breached these duties. Am. Compl. ¶¶ 71-82, 207.

Second, the Amended Complaint correctly argues the employees' operational role of developing and bringing the LUCIANA VEGA doll to market proximately caused the Plaintiff's injuries. Am. Compl. ¶¶ 129, 133-134, 136, 138, 200, 202, and 207; see *supra.*

Third, the Amended Complaint adequately alleges that the Defendants' were negligent in hiring, training, or supervising their employees. Am. Compl. ¶¶ 140-144, 201, 209. At this stage, prior to discovery and with all well pled allegations accepted as true, it is certainly logical to conclude that but for a lack of training or adequate supervision on the part of Defendants, the subject doll would not have made it to market. As the Defendants point out, "launching a new product…necessarily involve many employees," thus it is perfectly plausible that executives and other senior staff in decision making roles rely on junior staff to research and develop the concept for the Defendants' dolls. Defs. Mem. p. 36. As such, either the Defendants' employees are not adequately trained and/or supervised, or the Defendants' executives are making a conscious choice to misappropriate the likenesses of well-known individuals in the creation of their products.

Finally, their employees' acts were the result of the Defendants' negligence in inadequate supervision or training. The Defendants did not adequately train their employees on relevant laws surrounding the manufacturing of commercially available dolls, such as laws involving individual privacy rights and commercial interest in one's likeness. Nor did the Defendants properly supervise their employees, such that they could have intervened to stop the development of the LUCIANA VEGA doll. As a result of this negligent supervision, the LUCIANA VEGA doll made it through development, into production, and eventually into the marketplace. See Johnson v. Misericordia Cmty. Hosp., 99 Wis. 2d 708 at 743-44 (negligence verdict upheld where a hospital's failure to exercise ordinary care in properly vetting and selecting its medical staff led to a poor hire that resulted in a failed surgery and injuries to patient). For the forgoing reasons, Plaintiff's well-pled Complaint meets each necessary element of this cause of action and the Defendants' Motion to Dismiss with respect to the Plaintiff's negligent supervision claim must be denied.

**CONCLUSION**

Based upon the foregoing as well as the arguments raised in the Plaintiff's Complaint, the Defendants' Motion to Dismiss, Plaintiff respectfully requests that the Court deny the motion in its entirety, with prejudice, and award any such relief as the Court deems just and proper.

Dated: October 6, 2020

Chicago, Illinois

Respectfully submitted,

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## CERTIFICATE OF SERVICE

This is to certify that service of **PLAINTIFF LUCIANNE M. WALKOWICZ'S RESPONSE IN OPPOSITION TO DEFENDANTS' MOTION TO DISMISS** was accomplished pursuant to Electronic Case Filing as to ECF Users and shall be served upon other parties having filed appearances, identified below, via postage pre-paid U.S. mail on the 6th day of October 2020.

**/s/** Charles Lee Mudd Jr.

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## SERVICE LIST

All parties in this matter are represented by counsel who are ECF users.