

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MINNESOTA**

PRAIRIE ISLAND INDIAN
COMMUNITY,

Plaintiff,

v.

RADISSON HOTELS
INTERNATIONAL, INC., and
TREASURE ISLAND, LLC,

Defendants.

Civil Action No. 20-CV-01234-NEB-TNL

**DEFENDANT TREASURE ISLAND, LLC'S AND DEFENDANT
RADISSON HOTELS INTERNATIONAL, INC.'S MEMORANDUM OF LAW IN
SUPPORT OF THEIR PARTIAL MOTION TO DISMISS AND
TO STAY DEADLINE FOR ANSWERING THE COMPLAINT**

**[PUBLIC REDACTED VERSION OF CONFIDENTIAL DOCUMENT
FILED CONDITIONALLY UNDER SEAL]**

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Defendant Treasure Island, LLC (“TIL”) and Defendant Radisson Hotels International, Inc. (“RHI”) and (RHI and TIL collectively, “Defendants”) respectfully submit this Memorandum of Law in Support of their Partial Motion to Dismiss Plaintiff Prairie Island Indian Community’s (“Plaintiff”) Complaint. (Dkt 1.) For the reasons set forth below, Defendants move this Court, pursuant to FED. R. CIV. P. 12(b)(6), to dismiss Counts Three, Four, Ten, and Eleven asserting claims for trademark dilution under the Lanham Act and Minn. Stat. Ann. § 333.285, and, with Plaintiff’s consent, to stay the deadline for Defendants’ Answer to the Complaint pending resolution of this Partial Motion to Dismiss.

I. INTRODUCTION

In this action, Plaintiff alleges Defendant TIL (operator of the Treasure Island – TI Hotel & Casino in Las Vegas, Nevada) and Defendant RHI (who has a booking partnership with TIL’s Las Vegas hotel) have infringed and diluted Plaintiff’s TREASURE ISLAND trademarks. Plaintiff asserts these claims even though [REDACTED] any right to control TIL’s use of the TREASURE ISLAND name in connection with its hotel. In the 2008 Settlement Agreement Term Sheet, which Plaintiff references in the Complaint but does not attach to its pleading, Plaintiff expressly agreed to allow TIL to use the term “Treasure Island” *in any manner or form* in the hotel, casino, and/or resort industry. Plaintiff’s instant action is a U-turn from that express agreement.

In fishing for claims to justify its U-turn, some of Plaintiff’s claims are so contrived and threadbare that they cannot survive even at the pleading stage. Defendants

file this partial motion to dismiss because Plaintiff has needlessly complicated this case by characterizing Defendants' conduct as "dilution" of its TREASURE ISLAND marks and asserting federal and state trademark dilution claims (Counts Three, Four, Ten, and Eleven). (Dkt. 1 at ¶¶ 94-100, 101-07, 145-51, 152-58.)¹

This is not a "dilution" case. Trademark infringement and trademark dilution are distinct claims with distinct elements, and Plaintiff has failed to state plausible claims for dilution under the Lanham Act and Minnesota law. Dilution by blurring—which occurs when consumers associate a famous mark that has traditionally identified the mark holder's goods or services with a new and different source—typically applies in cases where a defendant is using a plaintiff's mark on dissimilar goods. But that is not the case here. TIL uses TREASURE ISLAND in connection with operating its hotel and casino in Las Vegas, *i.e.*, providing the same services that Plaintiff provides: hotel, casino and resort operation. RHI, in turn, simply references the name of TIL's hotel in Las Vegas which is now part of the Radisson network. These facts do not support a plausible claim that Defendants' conduct causes consumers to connect the TREASURE ISLAND marks with different services.

Dilution by tarnishment—which occurs when defendant's conduct causes reputational harm to the plaintiff's famous mark—typically applies in cases where a plaintiff's mark is linked to products of shoddy quality, or is portrayed in an

¹ Future pleadings will address Plaintiff's impermissible interference with TIL's use of the TREASURE ISLAND name as well as the meritless trademark infringement and breach of contract claims that Plaintiff uses to target truthful references to RHI and TIL's booking partnership.

unwholesome or unsavory context. Again, this is not the case here. Plaintiff has not alleged—nor could it—that Defendants’ services are of shoddy quality or portray TREASURE ISLAND in an unwholesome or unsavory context. Plaintiff’s conclusory allegations of “harm to reputation” are not supported with any specific facts about how Defendants’ conduct would result in negative associations or cause reputational harm to the TREASURE ISLAND marks.

Accordingly, Plaintiff’s dilution claims fail as a matter of law and should be dismissed with prejudice.

II. RELEVANT FACTUAL BACKGROUND

As alleged, Plaintiff is a federally recognized Indian tribe that owns and operates the Treasure Island Resort & Casino in Red Wing, Minnesota. (Dkt. 1 ¶¶ 4, 10.) Plaintiff asserts ownership of five federal trademark registrations and one Minnesota state service mark registration that incorporate the words TREASURE ISLAND (together hereinafter the “TREASURE ISLAND Marks”). (*Id.* ¶¶ 11-16.)

TIL is the owner and operator of the Treasure Island – TI Hotel & Casino in Las Vegas, Nevada. (*Id.* ¶¶ 5, 6.) The Treasure Island – TI Hotel & Casino in Las Vegas, Nevada has been operating under the TREASURE ISLAND name since the hotel and casino opened in 1993. (Dkt. 1, Ex. 6 at 16, n.10.) RHI is the owner of the RADISSON mark, which RHI has used in connection with its hotel services since at least as early as 1909. (Dkt. 1 ¶ 9; RADISSON, U.S. Trademark Registration No. 0920862.²)

² So long as the authenticity of the materials are unquestioned, courts in this District may take judicial notice of matters of public record, such as, federal trademark registrations,

On December 2, 2008, Plaintiff and TIL's predecessor, Treasure Island Corporation,³ entered into a confidential Settlement Agreement Term Sheet ("Settlement Agreement") to resolve the parties' dispute over the TREASURE ISLAND mark then-pending before the Trademark Trial and Appeal Board of the U.S. Patent and Trademark Office. (Dkt. 1 ¶¶ 20, 24.) Under the Settlement Agreement ¶ 4, TIL acquired a "perpetual, non-cancellable, and exclusive license to use marks including and comprising the term 'Treasure Island' in any manner or form for the use in the hotel, casino and/or resort industry." (*Id.* ¶ 29.)

In July 2019, Defendants publicly announced that TIL and RHI had reached an agreement that the Treasure Island – TI Hotel & Casino in Las Vegas "will officially join the Radisson system later this year as Treasure Island – TI Hotel and Casino, a Radisson Hotel." (*Id.* at ¶ 49.⁴) Plaintiff conspicuously omits from its Complaint that Defendants further publicly announced that, "[a]s part of the agreement," Treasure Island – TI Hotel & Casino in Las Vegas, "will retain its current branding and exterior signage." *Id.*

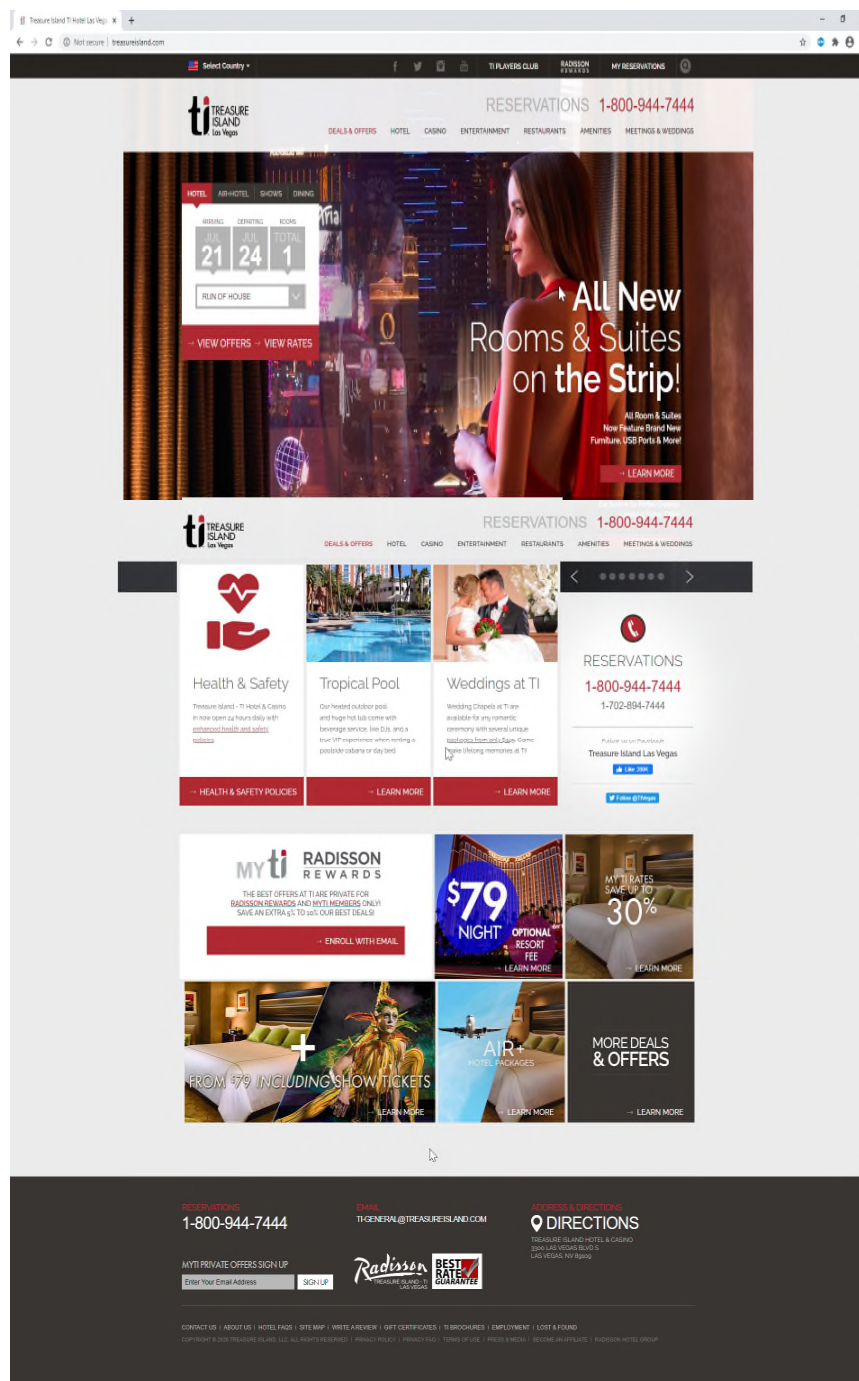
As alleged, TIL is "using the TREASURE ISLAND Marks on its website in a manner showing an affiliation with Defendant Radisson, including 'Radisson Treasure

as well as a party's public statements, such as those expressed through press releases. *See Shoemaker v. Cardiovascular Sys., Inc.*, No. 16-568 (DWF/KMM), 2017 WL 1180444, at *7 (D. Minn. Mar. 29, 2017) (taking judicial notice of SEC filings and press releases) (citing *Dittmer Props., L.P. v. F.D.I.C.*, 708 F.3d 1011, 1021 (8th Cir. 2013)).

³ On or about March 19, 2009, TI's predecessor entity, Treasure Island Corp., converted its entity status from a Nevada corporation to Treasure Island, LLC, a Nevada limited liability company. (Dkt. 1 ¶¶ 7, 26, 28.)

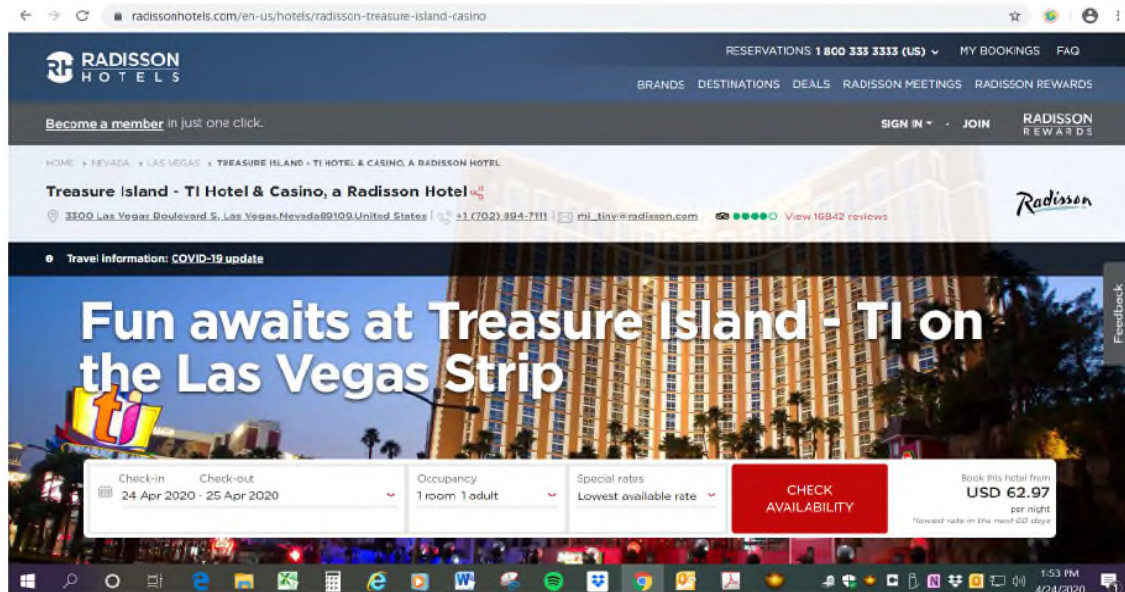
⁴ The Court may also take judicial notice of the complete July 25, 2019 press release that Plaintiff incorporates by reference into its Complaint, *see Shoemaker*, 2017 WL 1180444, at *7, which is available at https://www.radissonhotelgroup.com/media_press-releases&article=treasure-island---ti-hotel-casino-in-las-vegas-joins-radisson.

Island – TI Hotel & Casino,’ in the advertising, promotion, offering for sale, and sale of casino, hotel and resort services in interstate commerce.” (Dkt. 1 at ¶ 61, Ex. 8.) Plaintiff includes in its Complaint a tiny snippet from TIL’s website, conspicuously omitting the full page, which is reproduced below:



(*Id.*⁵)

According to Plaintiff, RHI is also “using the TREASURE ISLAND Marks on its website, including ‘Treasure Island – TI Hotel & Casino, a Radisson Hotel’, in the advertising, promotion, offering for sale, and sale of casino, hotel and resort services in interstate commerce.” (Dkt. 1 at ¶ 62, Ex. 9.)



Plaintiff further alleges that TIL lacked authority to approve or authorize RHI’s alleged use of the RADISSON Mark in association with the TREASURE ISLAND Marks and that TIL’s conduct constitutes a willful breach of the Settlement Agreement, but Plaintiff omits from its Complaint key details of the Settlement Agreement governing TIL’s use of TREASURE ISLAND.⁶ (Dkt. 1 at ¶¶ 70-71, 78.) The Settlement

⁵ The Court may also take judicial notice of TIL’s website that Plaintiff incorporated by reference into its Complaint, *see Shoemaker*, 2017 WL 1180444, at *7, which is available at <https://treasureisland.com/>.

⁶ Although Plaintiff did not attach a copy of the Settlement Agreement to the Complaint, the Court may consider other terms from the Settlement Agreement in deciding this Motion because Plaintiff expressly incorporated the Settlement Agreement by reference

Agreement ¶ 4, for example, provides that “[Plaintiff] shall grant [TIL] a perpetual, non-cancellable, and exclusive license to use marks including and comprising the term ‘Treasure Island’ in any manner or form for the use in the hotel, casino and/or resort industry.” (*Id.* ¶ 29; Durham Decl. Ex. 1.) Plaintiff does not have rights under the Settlement Agreement to exercise quality control over TIL’s use of TREASURE ISLAND in the hotel, casino, and/or resort industry. (*See* Durham Decl. Ex. 1.) Instead, the Settlement Agreement ¶ 5 merely states: [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] (*Id.*)

In support of its federal and state dilution claims, Plaintiff alleges only in conclusory fashion that Defendants’ conduct has “diluted and, unless enjoined, are likely to continue to dilute the distinctive quality of Plaintiff’s famous TREASURE ISLAND Marks,” (Dkt. 1 ¶¶ 97, 104, 148, 155), and has “tarnished and, unless enjoined, are likely to continue to tarnish Plaintiff’s famous TREASURE ISLAND Marks by undermining and damaging the valuable goodwill associated therewith.” (*Id.* ¶¶ 98, 105, 149, 156.)

III. LEGAL STANDARD

Dismissal is appropriate under Federal Rule of Civil Procedure 12(b)(6) when a plaintiff’s allegations fail “to state a claim upon which relief can be granted.” FED. R. CIV. P. 12(b)(6). To survive dismissal, “a complaint must provide more than ‘labels and

into its Complaint by expressly mentioning it and quoting from it therein. *See Dittmer*, 708 F.3d at 1021. A copy of the Settlement Agreement is attached as Exhibit 1 to the Declaration of Gina L. Durham (“Durham Decl.”) filed herewith.

conclusions’ or a ‘formulaic recitation of the elements of a cause of action.’” *Marquardt v. City of Blaine*, 136 F. Supp. 3d 1049, 1054 (D. Minn. 2015) (quoting *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009)). Although the Court construes the pleading in the non-movant’s favor and accepts the allegations of facts therein as true in considering a Rule 12(b)(6) motion, “it is not bound to accept as true legal conclusions couched as factual allegation.” *Marquardt*, 136 F. Supp. 3d at 1054 (citing *Braden v. Wal-Mart Stores, Inc.*, 588 F.3d 585, 594 (8th Cir. 2009)). The pleading must still “contain sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Iqbal*, 556 U.S. at 678 (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)).

“The Court need not resolve all questions of law in a manner which favors the complainant; rather, the Court may dismiss a claim founded upon a legal theory which is ‘close but ultimately unavailing.’” *Davis v. Walt Disney Co.*, No. CIV.04-1729 DWF/SRN, 2004 WL 1895234, at *2 (D. Minn. Aug. 23, 2004) (citing *Neitzke v. Williams*, 490 U.S. 319, 327 (1989)). The allegations must be sufficient to “raise a right to relief above the speculative level” and “state a claim to relief that is plausible on its face.” *Aquilar v. Ocwen Loan Servicing, LLC*, 289 F. Supp. 3d 1000, 1004 (D. Minn. 2018) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555 (2007)). “A plaintiff must do more than offer ‘labels and conclusions’ or a ‘formulaic recitation of the elements of a cause of action.’” *Id.*

IV. ARGUMENT

A. Plaintiff’s Federal and State Dilution Claims Fail as a Matter of Law

For the reasons discussed below, Plaintiff has failed to allege specific facts

supporting its dilution claims, relying instead on wholly conclusory recitations of the elements necessary to support these claims. Accordingly, Plaintiff's Counts Three, Four, Ten, and Eleven, which are premised on Plaintiff's fundamental misunderstanding of dilution, should be dismissed with prejudice.

1. Plaintiff did not—and cannot—state a claim for trademark dilution under the Lanham Act.

The Lanham Act provides injunctive relief for trademark dilution:

Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

15 U.S.C. § 1125(c)(1). Although the Complaint is somewhat vague, Plaintiff appears to assert dilution by blurring and tarnishment. (*See* Dkt. 1 ¶¶ 97-98, 104-05, 148-49, 155-56.) The Lanham Act defines “dilution by blurring” as an:

association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark. In determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

- (i) The degree of similarity between the mark or trade name and the famous mark.
- (ii) The degree of inherent or acquired distinctiveness of the famous mark.
- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.

(iv) The degree of recognition of the famous mark.

(v) Whether the user of the mark or trade name intended to create an association with the famous mark.

(vi) Any actual association between the mark or trade name and the famous mark.

15 U.S.C. § 1125(c)(2)(B). “Dilution by tarnishment,” on the other hand, is defined as an “association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.” *Id.* at § 1125(c)(2)(C).

a. Plaintiff’s Allegations Do Not Support a Plausible Claim for Dilution by Blurring

“Dilution is separate and distinct from trademark infringement. Infringement depends on a likelihood of consumer confusion over the source of a product, while dilution by blurring concerns ‘the lessening of the capacity of a famous mark to identify and distinguish goods or services.’” *Luigino’s, Inc. v. Stouffer Corp.*, 170 F.3d 827, 832 (8th Cir. 1999) (quoting 15 U.S.C. § 1127). The 8th Circuit articulated dilution by blurring as follows:

Dilution occurs when consumers associate a famous mark that has traditionally identified the mark holder's goods with a new and different source. For example, the doctrine would protect the owner of a mark for automobiles and airplanes from the use by another of a very similar mark for radio tubes. By causing consumers to connect the famous mark with different products, the subsequent mark weakens, or dilutes, the famous mark’s unique and distinctive link to a particular product.

Id.

As such, to establish a claim for trademark dilution by blurring, a plaintiff must show that: (1) its mark is famous; (2) defendant began using a similar or identical mark

after the plaintiff's mark became famous; and (3) defendant's mark dilutes the distinctive quality of the plaintiff's mark by causing consumers to connect the plaintiff's mark with different products. *Id.* If the Court assumes, solely for the purposes of this Motion, that Plaintiff has alleged facts sufficient to support the first two elements,⁷ Plaintiff's dilution by blurring claim here fails on the third element, and therefore, it should be dismissed with prejudice. *Id.*; *see also Brain Pharma, LLC v. Scalini*, 858 F. Supp. 2d 1349, 1358–59 (S.D. Fla. 2012) (dismissing dilution by blurring claim partly on basis that plaintiff failed to allege that defendants used plaintiff's famous mark in their sale of unrelated goods or services).

Dilution by blurring—when consumers associate a famous mark with a new product—typically applies in cases where “similar marks are used on dissimilar goods.” *Luigino's*, 170 F.3d at 833. That is not the case here. Both Plaintiff and TIL use the Treasure Island name in connection with the provision of same services: hotel, casino and resort operation. Indeed, TIL is exercising the perpetual and exclusive rights it acquired in the Settlement Agreement ¶ 4 to use TREASURE ISLAND “in any manner or form for the use in the hotel, casino, and/or resort industry.” (Dkt. 1 ¶ 29; Durham Decl. Ex. 1.) Just as it has done since 2008, and since the hotel opened in 1993. In addition, any use by RHI of TREASURE ISLAND is simply an accurate reference to the “Treasure Island – TI Hotel & Casino,” the hotel and casino in Las Vegas which is now part of the Radisson network of hotels. Plaintiff has not—and cannot—allege any facts that would

⁷ Defendants do not admit or concede the first two elements and expressly reserve the right to deny or contest these elements if the Court denies their Motion.

support a plausible claim that Defendants’ conduct has impaired the distinctiveness of the asserted TREASURE ISLAND Marks to identify Plaintiff’s services. Accordingly, Plaintiff’s dilution by blurring claim thus fails as a matter of law and should be dismissed.

b. Plaintiff’s Allegations Do Not Support a Plausible Claim for Dilution by Tarnishment

The hallmark of a “dilution by tarnishment” claim is reputational harm to the plaintiff’s famous mark caused by defendant’s use of a similar mark. *See* 15 U.S.C. § 1125(c)(2)(C). To properly support a dilution by tarnishment claim, a plaintiff must establish that the famous mark will suffer negative associations as a result of the use of the similar mark. *See Minnesota Mining & Mfg. Co. v. Rauh Rubber, Inc.*, 943 F. Supp. 1117, 1131–32 (D. Minn. 1996), *aff’d sub nom. Minnesota Min. & Mfg. Co. v. Rauh Rubber, Inc.*, 130 F.3d 1305 (8th Cir. 1997) (“Tarnishment results from unauthorized use which tarnishes, degrades or dilutes the mark’s distinctive quality.”). “The threat of tarnishment arises when the goodwill and reputation of a plaintiff’s trademark is linked to products which are of shoddy quality or which conjure associations that clash with the associations generated by the owner’s lawful use of the mark.” *Id.*; *see also Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 110 (2d Cir. 2009) (“[a] trademark may be tarnished when it is linked to products of shoddy quality, or is portrayed in an unwholesome or unsavory context, with the result that the public will associate the lack of quality or lack of prestige in the defendant’s goods with plaintiff’s unrelated goods.”).

Here, Plaintiff alleges nothing more than a conclusory allegation of “harm to

reputation” in its Counts Three, Four, Ten, and Eleven. (Dkt. 1 at ¶¶ 98, 105, 149, 156) (“Defendant [TI/Radisson]’s acts as alleged herein have tarnished and, unless enjoined, are likely to continue to tarnish Plaintiff’s famous TREASURE ISLAND Marks by undermining and damaging the valuable goodwill associated therewith.”). Plaintiff does not allege *any* facts demonstrating how Defendants’ use of TREASURE ISLAND will result in negative associations or cause reputational harm to the TREASURE ISLAND Marks. Indeed, the facts here simply cannot give rise to a claim for dilution by tarnishment. In 2008, TIL acquired perpetual and exclusive rights to use TREASURE ISLAND “in any manner or form for the use in the hotel, casino, and/or resort industry.” (Dkt. 1 ¶ 29; Durham Decl. Ex. 1.) That is exactly what TIL is doing now—using TREASURE ISLAND in any manner or form for the use in the hotel, casino, and/or resort industry—just as it has since 2008, and since the Treasure Island – TI Hotel & Casino in Las Vegas, Nevada opened in 1993. And RHI is simply referring to the very same Treasure Island – TI Hotel & Casino in Las Vegas, Nevada that TIL has been operating since 1993 and, since 2008, under the perpetual and exclusive rights it acquired from Plaintiff.

Moreover, Plaintiff does not allege that Defendants’ services are of shoddy quality or portray the TREASURE ISLAND marks in an unwholesome or unsavory context. Plaintiff could not allege that the Defendants’ services are “shoddy” or below its quality standards because the Settlement Agreement does not impose any quality standards on TIL’s use of TREASURE ISLAND in connection with its hotel, casino, and/or resort services. The Settlement Agreement also does not include any provisions that would

permit Plaintiff to: (1) exercise any actual control over the quality of TIL's use of TREASURE ISLAND in connection with its hotel, casino, and/or resort services; (2) inspect TIL's premises; or (3) review any of TIL's marketing materials. In sum, Plaintiff's Complaint is devoid of any factual content that would even support a plausible claim for dilution by tarnishment.

Plaintiff's conclusory allegations and textbook recitations of the elements of a tarnishment claim mandate dismissal of Plaintiff's dilution claim as a matter of law. *See Arrow Prods., LTD. v. Weinstein Co. LLC*, 44 F. Supp. 3d 359, 374 (S.D.N.Y. 2014) (finding, on a motion for judgment on the pleadings, plaintiff's dilution claims must fail as a matter of law because plaintiff had "only set forth bare-bones, conclusory allegations in support of [dilution] claims that merely recite the elements of the cause of action.").

2. Plaintiff did not—and cannot—state a claim for trademark dilution under Minn. Stat. Ann. § 333.285.

Plaintiff's Minnesota state law claims for dilution (Counts 10 and 11) are coextensive with its dilution claims under the Lanham Act (Counts 3 and 4). As such, courts in this Circuit analyze these claims together. *See DaimlerChrysler AG v. Bloom*, 315 F.3d 932, 936 n.3 (8th Cir. 2003); *Edina Realty, Inc. v. TheMLSonline.com*, No. CIV. 04-4371JRTFLN, 2006 WL 737064, at *3, n.2 (D. Minn. Mar. 20, 2006) (citations omitted) (analyzing together and granting summary judgment in favor of defendants on both federal and Minnesota state dilution claims); *DeRosier v. 5931 Bus. Tr.*, 870 F. Supp. 941, 948 n.8 (D. Minn. 1994) ("Despite their different origins, the elements of proof for each of these actions mirror each other and, in practical effect, tend to coalesce.

. . . Therefore, in addressing the merits of one such claim, we address them all.”).

For the same reasons discussed above regarding Plaintiff’s dilution claims under the Lanham Act, Plaintiff has not plausibly alleged any trademark dilution claims under Minnesota state law. Plaintiff’s dilution claims under Minn. Stat. Ann. § 333.285 (Counts Ten and Eleven) fail as a matter of law and should be dismissed with prejudice.

B. Defendants’ Deadline to Answer the Remaining Allegations in the Complaint Should Be Stayed Pending Disposition of this Motion.

Because Defendants move to dismiss only a subset of the counts alleged in the Complaint, this Court should stay Defendants’ obligation to answer the remaining allegations in the Complaint pending disposition of this Motion. Plaintiff consents to Defendants’ motion to stay Defendants’ obligation to answer the remaining allegations in the Complaint pending disposition of this Motion.

The Federal Rules of Civil Procedure do not discuss the effect of a pending partial motion to dismiss on a party’s deadline to answer the allegations not addressed by the partial motion to dismiss. *See* FED. R. CIV. P. 12(a)(4). Nor has the Eighth Circuit ruled on this issue. *See, e.g.*, Order at 1, *Steady State Imaging, LLC v. General Electric Co.*, No. 0:17-cv-01048-JRT-KMM, (D. Minn. Aug. 29, 2017) (ECF 55). However, courts in this District advised that the Rules do not permit a party to file a partial answer. *See, e.g.*, *Carlson v. U.S. Dep’t. of Educ.*, No. 12-645, 2012 WL 4475300, at *12 n.3 (D. Minn. Aug. 9, 2012) (explaining that a partial answer is not permitted under the Federal Rules of Civil Procedure and citing with approval cases from the District Court for the Northern District of Illinois where partial answers were deemed procedurally improper), Report

and Recommendation *adopted by* 2012 WL 4328936 (D. Minn. Sept. 20, 2012).

As such, courts in this District routinely order that a party shall have fourteen days to file a responsive pleading after the court rules on its partial motion to dismiss. *See, e.g., Agropur, Inc. v. Scoular Co.*, No. 17-cv-1247 (JNE/SER), 2017 WL 3411944, at *4 (D. Minn. Aug. 8, 2017) (without deciding the question of whether Rule 12(a)(4) compels such a result, granting a fourteen-day extension of defendant's time to answer allegations unaddressed by its partial motion to dismiss); *Steady State* at 1 (ordering fourteen-day extension of defendant's time to answer allegations unaddressed by its partial motion to dismiss "[b]ecause Rule 12(a)(4) extends the time for filing an answer under these circumstances"). Indeed, as one court in this District observed, "the vast majority of courts to have considered the issue hold that this extension occurs by operation of the rule regardless of whether a motion to dismiss seeks all of the claims in a pleading or some subset of claims." *Steady State* at 1 (citing as an example *Maass v. Lee*, 189 F. Supp. 3d 581, 587–88 & n.7 (E.D. Va. 2016)). As another court further observed, "[i]f the opposite rule controlled and partial motions to dismiss did not suspend a party's obligation to reply to additional claims, the result would be 'a procedural thicket' of piecemeal answers that would poorly serve judicial economy." *Gortat v. Capala Bros.*, 257 F.R.D. 353, 366 (E.D.N.Y. 2009).

The majority rule should apply here. Extending Defendants' time to answer the allegations unaddressed by their Partial Motion to Dismiss will conserve court and party resources, as well as avoid unnecessary confusion. Accordingly, Defendants submit that they should be permitted to file a single answer that addresses those allegations and

claim(s) that remain following the disposition of their Partial Motion to Dismiss.

V. CONCLUSION

Plaintiff has not plausibly alleged any trademark dilution claims under the Lanham Act or Minnesota state law. Defendants respectfully request that this Court grant its motion to partially dismiss with prejudice Counts Three, Four, Ten, and Eleven asserting claims for trademark dilution under the Lanham Act and Minn. Stat. Ann. § 333.285. Defendants also respectfully request, with Plaintiff's consent, that this Court stay Defendants' obligation to answer the remaining allegations in the Complaint pending disposition of this Motion and that such answer will be filed within 10 days following the disposition of this Partial Motion to Dismiss.

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