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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

SUPERNOVA FROM CYNOT3, LLC,
Plaintiff,
v.
MARK BURNETT PRODUCTIONS,
INC., et al.
Defendants.

Civil No. 06CV1334 JAH (RBB)
**ORDER GRANTING PLAINTIFF’S
PRELIMINARY INJUNCTION
MOTION**
[Doc. No. 14]

INTRODUCTION

Now before this Court is Plaintiff Supernova from CyNot3 (“Plaintiff”) motion for preliminary injunction hearing. Doc. No. 14. Plaintiff seeks to enjoin Defendants Mark Burnett Productions, Inc., JMBP, Inc. and Rockstar Entertainment, Inc. (collectively “Defendants”) from using the mark SUPERNOVA in conjunction with performing, recording or selling rock and roll music recordings under the trade name, service and/or trademark SUPERNOVA. Oral argument was heard on September 11, 2006, with Anthony Fletcher and John Mizhir appearing for Plaintiff, and Gary Hecker and Jim Slominski appearing for Defendants.¹ After a careful consideration of the pleadings, relevant exhibits, the oral argument of counsel at the hearing, and for the reasons set forth below, this Court GRANTED Plaintiff’s motion for preliminary injunction.

¹ Mr. Lee Brenner appeared for Defendant CBS Broadcasting, Inc., who by stipulation with Plaintiff, is explicitly excluded from the instant motion. Doc. No. 34.

BACKGROUND

1
2 On June 27, 2006, Plaintiff filed a complaint claiming Defendants Mark Burnett
3 Productions, Inc., JMBP, Inc., Rockstar Entertainment, Inc., CBS Broadcasting, Inc., Thomas
4 Lee Bass a/k/a Tommy Lee, Gilby Clarke and Jason Curtis Newsted infringed its common law
5 trademark SUPERNOVA. Plaintiff alleged false designations of origin and false descriptions
6 in violation of the Lanham Act, intentional interference with prospective economic advantage,
7 as well as a declaratory judgment that Defendants are not entitled to the registration of the
8 marks. On August 10, 2006, Plaintiff filed a first amended complaint adding claims for untrue
9 and misleading advertising and unfair competition in violation of California law, common law
10 trademark infringement, common law unfair competition and common law unjust enrichment.
11 Doc. No. 8.

12 On August 10, 2006, Plaintiff moved this Court ex parte for an order shortening time
13 for the hearing on the preliminary injunction motion. Doc. No. 6. Defendant JMBP, Inc. filed
14 an opposition to Plaintiff's ex parte application on August 14, 2006. Doc. No. 10. On August
15 16, 2006, Plaintiff filed its motion for preliminary injunction, which was scheduled for oral
16 argument on October 19, 2006. Doc. No. 14. This Court subsequently issued an Order on
17 August 16, 2006, granting Plaintiff's ex parte application to shorten time on the preliminary
18 injunction hearing, and re-scheduled the preliminary injunction hearing for September 11,
19 2006. Doc. No. 20. On August 30, 2006, Defendants filed an opposition to Plaintiff's motion
20 for preliminary injunction. Doc. No. 37. Plaintiff filed a reply on September 1, 2006. Doc.
21 No. 47.

22 On August 21, 2006, Defendants filed their motion to dismiss and simultaneously filed
23 an ex parte application to shorten time for a hearing on their motion to dismiss. Doc. Nos. 21
24 and 22. Defendant JMBP, Inc. also filed an ex parte application on August 21, 2006 to
25 continue Plaintiff's preliminary injunction hearing and for expedited discovery. Doc. No. 26.
26 On August 23, 2006, this Court granted Defendants' ex parte application to shorten time, and
27 advanced the motion to dismiss hearing to August 31, 2006. Doc. No. 25. Plaintiff filed an
28 opposition on August 25, 2006. Doc. No. 29. This Court took the matter under submission

1 on August 29, 2006 pursuant to Civ.LR 7.1(d.1). Doc. No. 36. On September 5, 2006, this
 2 Court issued an Order denying Defendants' motion to dismiss. Doc. No. 46.

3 DISCUSSION

4 I. Legal Standard

5 A. Preliminary Injunction

6 To prevail on a motion for preliminary injunction on a trademark infringement claim,
 7 Plaintiffs must demonstrate that either: 1) a combination of probable success on the merits”
 8 and “the possibility of irreparable injury” or 2) the existence of “serious questions going to the
 9 merits” and that “the balance of hardships tips sharply in his favor.”² GoTo.com, Inc. v. Walt
 10 Disney Co., 202 F.3d 1199, 1204-1205 (9th Cir. 2000), citing Sardi's Restaurant Corp. v.
 11 Sardie, 755 F.2d 719, 723 (9th Cir. 1985). These formulations represent two points on a
 12 sliding scale in which the required degree of irreparable harm increases as the probability of
 13 success decreases. Roe v. Anderson, 134 F.3d 1400, 1402 (9th Cir. 1998). A showing of
 14 likelihood of success on the merits gives rise to a presumption of irreparable harm in trademark
 15 cases. International Jenson, Inc. v. Metrosound, U.S.A., Inc., 4 F.3d 819, 827 (9th Cir. 1993).

16 The basic function of a mandatory injunction is to “preserve status quo pending
 17 determination of an action on the merits.” Chalk v. U.S. District Court Central District of
 18 California, 840 F.2d 701, 704 (9th Cir. 1988). “It is so well settled as not to require citation
 19 of authority that the usual function of a preliminary injunction is to preserve the status quo
 20 ante litem pending a determination of the action on the merits.” Larry P. v. Riles, 502 F.2d
 21 963, 965 (9th Cir. 1974).

22
 23
 24 ² Plaintiff also cites to the “traditional” test for preliminary injunction, which includes a showing of: “1)
 25 likelihood of success on the merits, 2) the possibility of irreparable injury to plaintiff if preliminary relief is not
 26 granted, 3) a balance of hardships favoring the plaintiff, and 4) advancement of the public interest.” Doc. No.
 27 15 at 9, citing to Save Our Sonoran, Inc. v. Flowers, 408 F.3d 1113, 1120 (9th Cir. 2005). Research on the
 28 preliminary injunction cases cited by Save Our Sonoran, Inc., however, all conclude that the Ninth Circuit uses
 the alternative tests as set forth in GoTo.com, and not the traditional test as asserted by Plaintiff. See Baby
Tam & Co. v. City of Las Vegas, 154 F.3d 1097, 1100 (9th Cir. 1998); Topanga Press, Inc. v. City of Los
Angeles, 989 F.2d 1524, 1528 (9th Cir. 1993); United States v. Nutri-cology, Inc., 982 F.2d 394, 397 (9th
 Cir. 1992); Los Angeles Memorial Coliseum Comm'n v. National Football League, 634 F.2d 1197, 1201 (9th
 Cir. 1980). Accordingly, this Court will use the alternative tests for a finding of preliminary injunction as set
 forth by the Ninth Circuit in GoTo.com and its progeny.

1 **B. Trademark Infringement**

2 To prevail on a trademark infringement claim under the Lanham Act, Plaintiff must
3 establish that Defendant is using its mark in a confusingly similar manner.³ *Id.* at 1205. To
4 show that there is a likelihood of a consumer confusing Plaintiff's mark with Defendant, a
5 district court considers eight factors (known as the "Sleekcraft" factors) in its determination:

- 6 • The strength of Plaintiff's mark
7 • The similarity of the marks
8 • The relatedness of the companies' services
9 • The marketing channels used by the companies
10 • Defendant's intent in selecting its mark
11 • Evidence of actual confusion
12 • The likelihood of expansion into other markets, and
13 • The degree of care likely to be exercised by purchasers of the goods

14 Goto.com, 202 F.3d at 1205. As discussed, once the plaintiff has established a likelihood of
15 confusion, it is presumed that the plaintiff will suffer irreparable harm. *See Goto.com*, 202 F.3d
16 at 1209; Brookfield Communications, Inc. v. West Coast Entertainment Corp., 174 F.3d 1036,
17 1066 (9th Cir. 1999).

18 **II. Analysis**

19 Plaintiff asserts Defendants' intent to perform and record as a rock and roll group under
20 the SUPERNOVA mark infringes Plaintiff's common law trademark. Doc. No. 15 at 1.
21 Defendants dispute Plaintiff's contentions that it can likely succeed on its common law
22 trademark infringement claim. Doc. No. 37. Defendants also request a bond hearing and the

23 ³ Section 43(a)(1) of the Lanham Act provides in relevant part that:

24 Any person who, on or in connection with any goods or services, . . . uses in commerce any word, term,
25 name, symbol, or device, or any combination thereof, or any false designation of origin, false or
26 misleading description of fact, or false or misleading representation of fact, which—

27 (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation,
28 connection, or association of such person with another person, or as to the origin, sponsorship, or
approval of his or her goods, services or commercial activities by another person, . . . shall be liable in a
civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125(a)(1).

1 imposition of a substantial bond should this Court grant a preliminary injunction to Plaintiff.
2 Id. at 24.

3 **A. Valid Trademark**

4 In order to succeed in a common law trademark infringement case, Plaintiff must first
5 show that it has a valid trademark. Tie Tech, Inc. v. Kinedyne Corp., 296 F.3d 778, 783 (9th
6 Cir. 2002) (“Validity [of a trademark] is a threshold issue.”). In order to show a valid
7 trademark exists, the mark holder must demonstrate that the “symbol is protectible as a
8 trademark - *i.e.* whether it is recognized by the public as identifying and distinguishing
9 plaintiff’s goods or services.” Echo Travel, Inc. v. Travel Associates, Inc., 870 F.2d 1264, 1266
10 (7th Cir. 1989). A plaintiff may demonstrate that a mark is protectible in either of two ways:
11 a) that the “symbol was inherently distinctive; or b) that even if not inherently distinctive, the
12 symbol has become distinctive through the acquisition of ‘secondary meaning.’” Id., quoting
13 McCarthy § 15.1, at 657.

14 Plaintiff argues that the SUPERNOVA mark is “arbitrary as applied to goods and services
15 associated with a rock and roll band.” Doc. No. 15 at 11. Plaintiff points out the dictionary
16 meaning of supernova is “[a] rare celestial phenomenon involving the explosion of most of the
17 material in a star, resulting in an extremely bright, short-lived object that emits vast amounts
18 of energy.” Id., citing to Mizhir Decl. at Exh. 1. Defendants do not present arguments
19 regarding the designation of the mark.

20 Plaintiff’s arguments are persuasive. The mark SUPERNOVA requires imagination by
21 the consumer in order to associate it with a rock and roll group, rendering the mark inherently
22 distinctive or arbitrary. As such, the mark “is presumed to achieve ‘customer recognition and
23 association immediately upon adoption and use.’” Echo Travel, 870 F.2d at 1266 n.6, quoting
24 McCarthy § 15.2 at 660.

25 Defendants argue that even if the mark is inherently distinctive, Plaintiff fails to show
26 that it has a protectible mark because they fail to show secondary meaning for each geographical
27 area that Plaintiff claims. Doc. No. 37 at 8. Defendants cite to Grupo Gigante v. Dallo & Co.,
28 Inc., 391 F.3d 1088, 1096-97 (9th Cir. 2002); Adray v. Adray-Mart, Inc., 76 F.3d 984, 989

1 (9th Cir. 1996) and Glow Industries, Inc. v. Lopez, 252 F.Supp.2d 962, 983-86 (C.D. Cal.
2 2002) as support for their contention that Plaintiff must prove secondary meaning for each
3 geographical area it claims. Id. Grupo Gigante and Adray are inapposite to the facts in this
4 matter. Grupo Gigante stands for the holding that a foreign trademark holder can assert
5 trademark rights if it demonstrates secondary meaning in a market and that a “*substantial*
6 percentage of consumers in the relevant American market is familiar with the foreign mark.”
7 391 F.3d at 1097 (emphasis in original). In Adray, the Ninth Circuit looked at the
8 establishment of secondary meaning in a descriptive mark in order to assess if proper damages
9 and equitable relief was given. *See* 76 F.3d at 988.

10 Defendants’ argument, however, has merit in regards to their use of Glow Industries. In
11 Glow Industries, the district court, citing only to a treatise, required a common law trademark
12 owner to demonstrate “the territorial scope of its trademark use in order to establish a
13 likelihood of success on the merits.” 252 F.Supp.2d at 983. Thus, Glow Industries, as well as
14 other district court cases, stand for the proposition that senior trademark users can “assert its
15 trademark rights in all areas in which is has legally sufficient market penetration and a zone of
16 natural expansion.” *See, e.g., Echo Drain v. Newsted*, 307 F.Supp.2d 1116, 1127 (C.D. Cal.
17 2003). Although these cases are non-precedential, the Court finds that Plaintiff, unlike the
18 facts present in the cited district court cases, demonstrate substantial evidence of nationwide
19 use of their mark in commerce. For example, Plaintiff presents evidence through declarations,
20 that Defendants do not dispute, outlining its nationwide and Canadian tours in 1994, 1995,
21 1996 and 1999, and that its records are sold on amazon.com, bestbuy.com, walmart.com,
22 barnesandnoble.com, and cduniverse.com, as well as amphetaminereptile.com, and
23 sympathyrecords.com. Accordingly, because the mark is inherently distinctive and because
24 Plaintiff has shown that it has performed in concert, as well as marketed its products
25 nationwide, Plaintiff has met its burden of showing that it has a valid trademark.

26 1. Defendant’s Additional Arguments Against Validity

27 Defendants also contend that Plaintiff does not hold a valid trademark because: 1)
28 Plaintiff abandoned its mark in 1999; 2) Plaintiff cannot show proper chain of transfer from

1 the original group members to the current Supernova group; and 3) Defendants licensed the
2 mark “Supernova”, and therefore have superior rights to Plaintiff. *See* Doc. No. 37.

3 *a. Alleged Abandonment of Mark*

4 Defendants argue that Plaintiff abandoned the SUPERNOVA mark because Plaintiff
5 from 1999 to March 2006: 1) played no concerts; 2) failed to promote the SUPERNOVA band;
6 3) failed to record as SUPERNOVA; 4) received no royalties as SUPERNOVA; 5) allowed its
7 business registration to lapse; 6) dissolved its fan club; and 7) abandoned its website. Doc. No.
8 37 at 4. In reply, Plaintiff asserts that Defendants cannot show it intended to abandon the
9 SUPERNOVA mark, citing to Kingsmen v. K-Tel International Ltd., 557 F.Supp. 178, 183
10 (S.D.N.Y. 1983) and Robi v. Reed, 173 F.3d 736, 740 (9th Cir. 1999).

11 “The Lanham Act defines abandonment as (1) discontinuance of trademark use *and* (2)
12 intent not to resume such use.” Electro Source, LLC v. Brandess-Kalt-Aetna Group, Inc., __
13 F.3d __ (9th Cir. 2006) (emphasis in original). Abandonment of a mark “requires *complete*
14 cessation or discontinuance of trademark use.” Id. (emphasis in original). The Ninth Circuit
15 in Electro Source recognized a bright line rule in determining trademark abandonment: “Even
16 a single instance of use is sufficient against a[n abandonment] claim of a mark if such use is
17 made in good faith.” Id., quoting Carter-Wallace, Inc. v. Procter & Gamble Co., 434 F.2d 794,
18 804 (9th Cir. 1970). “Good faith nominal or limited commercial sales of trademarked goods
19 are sufficient ... to avoid abandonment, where the circumstances legitimately explained the
20 paucity of the sales.” Id. The Ninth Circuit found in Electro-Source that nominal commercial
21 transport or sales of remaining inventory from a failed business was sufficient to defeat an
22 abandonment claim even where the mark holder intended to abandon his business after his
23 inventory was depleted. Id. Similarly, in Carter-Wallace, the Ninth Circuit rejected plaintiff’s
24 argument that the mark was abandoned because the mark holder failed to market or promote
25 the product, and only listed the product in trade directories. 434 F.2d at 803. The court
26 concluded that the mark holder had legitimate business reasons for making nominal sales “with
27 the sole intent of sustaining the mark.” Id.

28 Here, Plaintiff presents sufficient evidence of nominal use to defeat Defendants’

1 abandonment claim. Although Defendants dispute that Plaintiff released an album in 2001,
2 that Plaintiff appeared on a “Sympathy for the Record Industry compilation, *Their Sympathetic*
3 *Majesties Request: Volume 2*,” that Plaintiff released a DVD video compilation in 2004, and that
4 Plaintiff’s songs appeared on an album called *Punk Rock Sampler* in 2006, that Plaintiff’s records
5 and CDs “have been available for consumers to purchase in retail outlets and online under the
6 SUPERNOVAQ name and mark at such mainstream consumer websites continuously since at
7 least as early as 2000,” and that Plaintiff’s records were “available for sale at independent record
8 label websites like *amphetaminereplite.com* and *sympathyrecords.com*,” they only dispute Plaintiff’s
9 assertions to the extent that they cannot “locate evidence of such activities.” *Id.* Such
10 contentions lack merit since the Ninth Circuit recognizes in preliminary injunction matters a
11 reduced evidentiary standard. *Flynt Distib. Co., Inc. v. Harvey*, 734 F.2d 1389, 1394 (9th Cir.
12 1984) (“The urgency of obtaining a preliminary injunction necessitates a prompt determination
13 and makes it difficult to obtain affidavits from persons who would be competent to testify at
14 trial. The trial court may given even inadmissible evidence some weight, when to do so serves
15 the purpose of preventing irreparable harm before trial”); *see also Asseo v. Pan American Grain*
16 *Co., Inc.*, 805 F.2d 23, 26 (1st Cir. 1986) (“[A]ffidavits and other hearsay materials are often
17 received in preliminary injunction proceedings.”). Accordingly, without evidence rebutting
18 Plaintiff’s contentions regarding continuous use and non-abandonment of its mark, Defendants’
19 argument is unpersuasive.

20 Moreover, Defendants do not dispute Plaintiff’s good faith explanation for making
21 nominal sales, where Plaintiff states that the SUPERNOVA band members “took a break from
22 the rigors of touring to start families, finish educations, and catch up on other things they had
23 missed during their years on the road.” *See* Doc. No. 15 at 5, citing to Collins Decl. at ¶ 6.
24 Plaintiff, therefore, in this Court’s opinion meets the good faith basis necessary for showing
25 minimal commercial activity to maintain its trademark status.

26 Defendants also argue that the band SUPERNOVA never received royalties from its CD
27 and record sales because the royalties were paid as “songwriter’s royalties” and were paid not
28 to the band SUPERNOVA, but to “Cynot Three Industries.” Doc. No. 37 at 4 n. 8; 12-14.

1 Plaintiff responds that they made a business decision to form a separate entity to collect
2 songwriter royalties, and that the royalties ultimately derived from the activities of the
3 SUPERNOVA band. Doc. No. 46 at 6; Collins Decl. at 3. Moreover, Plaintiff points out that
4 the publishing company for “many Beatles songs [are] ‘Northern Songs’ and for Metallica it is
5 ‘Creeping Death Music.’” *Id.* Plaintiff’s arguments are persuasive. The CD liners for the
6 various CDs lists SUPERNOVA as songwriters and performers to songs that received royalties.
7 Defendants present no case law or argument that a separate business entity otherwise directly
8 connected to the mark holder in collecting royalties for the mark holder severs the connection
9 between the mark holder and its mark. Accordingly, the Court finds Defendants’ arguments
10 regarding abandonment by Plaintiff of the SUPERNOVA mark lacks merit.

11 *b. Chain of Title Transfer*

12 Defendants further argue that proper chain of title transfer did not occur because
13 Hayden Thais, a former member of the group, did not formally transfer title to Plaintiff. Doc.
14 No. 37 at 15-16. Defendants argue that in order for Plaintiff to assert an action against
15 Defendants, Thais must have assigned his rights in the mark to Plaintiff. *Id.* Defendants add
16 that the royalty documents, which show that Cynot Three Industries received only 66.66% of
17 the royalties related to the song “Chewbacca” is evidence that Plaintiff does not hold all rights
18 to the mark SUPERNOVA. In response, Plaintiff asserts that a band member that leaves a
19 band retains no rights in the trademark. Doc. No. 46, citing to Robi, 173 F.3d at 740.

20 In Robi, a decedent’s wife, who was assigned her husband’s rights in the singing group
21 “The Platters”, asserted trademark rights against defendant, who was the only member of the
22 Platters to continue to assert and promote the name of the group. 173 F.3d at 739. The Ninth
23 Circuit, in recognizing that decedent left the group and never returned to it, adopted the
24 findings of other courts “that members of a group do not retain rights to use the group’s name
25 when they leave the group.” *Id.*, citing to HEC Enters., Ltd. v. Deep Purple, Inc., 213 U.S.P.Q.
26 991 (C.D. Cal. 1980); Kingsmen v. K-Tel Int’l Ltd., 557 F.Supp. 178 (S.D.N.Y. 1983). The
27 Court also recognized that “there is no inalienable interest at stake that would attach to the
28 departing member.” *Id.* at 740, citing to Giammarese v. Delfino, 197 U.S.P.Q. 162, 163 (N.D.

1 Ill. 1977). The court ultimately found that decedent's wife had no interest in the group, even
2 if alleged trademark rights were assigned to her, because decedent gave up any rights to the
3 disputed trademark when he left the group.

4 Likewise, Thais has no rights to the SUPERNOVA mark because "there is no inalienable
5 interest at stake" that would attach to him as a departed member of the SUPERNOVA group.
6 See Robi, 173 F.3d at 740. Accordingly, the Court therefore disregards Defendants' argument
7 regarding the lack of proper transfer of title to Plaintiff.

8 *c. License to '491 Mark*

9 Defendants finally assert that it is the senior user of the SUPERNOVA mark by virtue
10 of its exclusive license to the mark SUPERNOVA from Nasar Abadey, owner of U.S. Trademark
11 Reg. No. 1,699,491 (the "'491 Mark"). See Defs. Exh. 30. Plaintiff argues that: 1) the '491
12 Mark is limited to a "multi-directional musical ensemble" group and does not extend to the rock
13 and roll genre; 2) Defendants' license of the '491 Mark is "not a transfer of ownership of
14 rights"; 3) the '491 Mark cannot be asserted against Plaintiff for trademark infringement; 4)
15 Defendants' uncontrolled use of the '491 Mark without control by the mark holder renders the
16 '491 Mark abandoned; and 5) the license is invalid. Doc. No. 46 at 2-4.

17 *i. The '491 Mark*

18 The '491 Mark is shown here:



27 The registration form for the '491 Mark states that the trademark is a word mark for the phrase
28 "Supernova Multi-Directional Music Ensemble Nasar Abadey". Id. The mark was registered

1 in conjunction with International Class 041, which includes “entertainment services in the
2 nature of a multi-directional musical ensemble.” *Id.* The registration lists the first use in
3 commerce date as April 1979. *Id.* Plaintiff argues that Defendants have not established any
4 rights outside of the “multi-directional musical ensemble” field, which Plaintiff understands as
5 avant-garde jazz. Doc. No. 46 at 3. Defendants argue that the ‘491 Mark is not limited to
6 “multi-directional musical ensemble”, but extends to rock and roll groups as well. Doc. No. 37
7 at 9.

8 *ii Earlier Use in Commerce*

9 Defendants first asserts that ‘491 Mark was used earlier in commerce than Plaintiff’s
10 SUPERNOVA mark, as evidenced from the registration stating that the mark was used as early
11 as April 1979. Doc. No. 37 at 9. Plaintiff does not dispute the statement in the registration,
12 but disputes that Mr. Abadey’s use of the SUPERNOVA mark precedes Plaintiff in the relevant
13 field.

14 Defendants appear here to argue that Plaintiff is not the senior user of the SUPERNOVA
15 mark, and as such cannot assert a valid trademark. However, to determine priority in use of
16 the mark, Defendants must show that: 1) they actually adopted and used the marks in
17 commerce prior to the junior user; and 2) that the use of the mark was continuous and not
18 interrupted. Department of Parks and Recreation for State of California v. Bazaar del Mundo,
19 Inc., 448 F.2d 1118, 1125-26 (9th Cir. 2006). It is unclear from the evidence presented by
20 Defendants that Mr. Abadey, and therefore Defendants in their capacity as licensees, used the
21 SUPERNOVA mark prior to Plaintiff. In the ‘491 registration, Mr. Abadey states that he has
22 used the “SUPERNOVA Multi-directional Music Ensemble Nasar Abadey” mark since 1979.
23 *See* ‘491 Registration. However, Mr. Abadey does not state, and Defendants do not dispute,
24 that the registration statement does not support any use of the SUPERNOVA mark alone since
25 1979. Although Defendants state that the SUPERNOVA mark is equivalent to the
26 “SUPERNOVA Multi-directional Music Ensemble Nasar Abadey” mark because the mark
27 predominantly contains the name SUPERNOVA, it presents no case law in support of its
28 contention that this Court should ignore the phrase “multi-directional music ensemble Nasar

1 Abadey". On the contrary, in comparing the '491 mark as registered in the U.S. Patent and
2 Trademark Office and Plaintiff's mark SUPERNOVA, the similarities between the two marks
3 are minimized, at best, precisely because of the presence of "Multi-directional Music Ensemble
4 Nasar Abadey," which importantly denotes the source of the '491 Mark as Mr. Nasar Abadey.

5 Defendants also fail to present a likelihood of confusion analysis regarding the similarities
6 between the different marks, as well as the remaining Sleekcraft factors necessary for this Court
7 order to establish priority in use of the SUPERNOVA mark. *See Brookfield Communications*,
8 174 F.3d at 1051. Although Defendants conclusorily state that the SUPERNOVA mark is
9 similar enough to preclude priority to Plaintiff because the term SUPERNOVA is predominant
10 in the mark, as discussed Defendants present no evidence or case law to support their
11 contentions. Accordingly, the Court finds Defendants' argument unpersuasive.

12 *iii. Use in Different Genre*

13 Plaintiff also argues that the '491 Mark cannot precede its use of the SUPERNOVA
14 mark because the mark was used in a different genre. Doc. No. 46 at 3. Plaintiff contends that
15 Mr. Abadey has used the '491 Mark exclusively within the avant-garde jazz field. *Id.*
16 Defendants do not respond to this argument.

17 The parties do not present case law to support their respective positions. However,
18 numerous Ninth Circuit cases have found no likelihood of confusion where the music genres
19 differ between the mark holders. *See M2 Software, Inc. v. Madacy Entertainment*, 421 F.3d
20 1073 (9th Cir. 2005) (no likelihood of confusion between sports music and interactive music
21 distributors); *M2 Software, Inc. v. M2 Communications, L.L.C.*, 149 Fed.Appx. 612 (9th Cir.
22 2005) (no likelihood of confusion between interactive music and Christian music distributors);
23 *see also Echo Drain*, 307 F. Supp.2d at 1116 (no likelihood of confusion, in part, because of
24 difference between "funk and groove" and pop music genres); *Glow Industries*, 252 F.Supp.2d
25 at 982 (defendants acquisition of licensing rights only limited to field of use of licensed
26 trademark). Accordingly, Plaintiff's argument is persuasive that the differences in genres
27 between the '491 Mark and Plaintiff's SUPERNOVA mark would not result in a likelihood of
28 confusion.

1 *iv. Transfer of '491 Mark Rights to Defendants*

2 Plaintiff argues that Defendants can only receive trademark rights consistent with Mr.
3 Abadey's ownership of the '491 Mark. Doc. No. 46 at 3. "A license is a permission, not a
4 transfer of ownership of rights." *Id.* Thus, Plaintiff appears to argue that Defendants, as
5 licensees of the mark "cannot have received rights their licensor doesn't have." *Id.*

6 Plaintiff's argument is related to the ability of Mr. Abadey to exert his '491 Mark against
7 Plaintiff's SUPERNOVA mark in order to establish priority. As discussed, Defendants fail to
8 show the use by Mr. Abadey of a similar mark in a similar genre in order to establish a
9 likelihood of confusion between the two marks. *See Glow Industries*, 252 F.Supp.2d at 982
10 (defendants acquisition of licensing rights only limited to field of use of licensed trademark).
11 Accordingly, Plaintiff's argument is persuasive that Defendants are limited to exerting rights
12 that the licensor possesses in the contested mark.

13 *v. Abandonment of '491 Mark by Mr. Abadey/Lack of Quality*
14 *Control*

15 Plaintiff next argues that the '491 Mark was abandoned by Mr. Abadey because the
16 license allows Defendants to register the SUPERNOVA mark in other classes. Doc. No. 46 at
17 3. Plaintiff asserts that a trademark represents "a designator of a single source." *Id.* Plaintiff
18 asserts, however, that Defendants as licensees "are permitted by the terms of the license to
19 control the use of the mark, *e.g.* to register the '491 Mark in other fields." *Id.* "Since a mark
20 becomes abandoned when 'any course of conduct by the owner ... causes the mark ... to lose its
21 significance as a mark,'" Plaintiff concludes that Mr. Abadey abandoned his '491 Mark. *Id.*
22 Plaintiff also argues that because the license fails to provide quality control of the mark, the
23 license should be found invalid. *Id.* at 4. During oral argument, Defendants point out that the
24 license explicitly contains a "quality control" clause that gives the licensor control over their use
25 of the '491 Mark. Defendants also represented that the unredacted version of the license
26 contains a clause that allows the licensor to rescind the license at any time should the licensor
27 deem Defendants' use of the mark as unacceptable.

28 "It is well-established that '[a] trademark owner may grant a license and remain protected

1 provided quality control of the goods and services sold under the trademark by the licensee is
2 maintained.” Barcamerica International USA Trust v. Tyfield Importers, Inc., 289 F.3d 589,
3 595 (9th Cir. 2002). However, “[u]ncontrolled or ‘naked’ licensing may result in the
4 trademark ceasing to function as a symbol of quality and controlled source.” Id. at 596, citing
5 to McCarthy § 18:48, at 18-79. Thus, the naked licensing of a trademark can render a
6 trademark abandoned, even in the absence of subjective intent by the trademark owner to
7 abandon its mark. Id.

8 In Barcamerica, the Ninth Circuit recognized that no formal agreements are necessary
9 to establish quality control of the mark, but that the licensing arrangement must be such that
10 the public will not be deceived as to the source of the mark. 289 F.3d at 597. The court found
11 naked licensing where the mark holder did not have “knowledge of the quality control
12 procedures utilized” by the licensee, and had no involvement in maintaining quality control of
13 the licensee’s products. Id. The facts in Barcamerica are inapposite to the instant matter. A
14 review of the redacted license provided by Defendants shows that the parties have agreed to
15 quality control of the licensee’s actions. The relevant portion of the license reads:

16 4. Quality Control

17 LICENSEE represents ... and agrees that it will conduct its business in a manner
18 designed to protect and enhance the reputation and integrity of the Mark and the
19 goodwill associated therewith. The LICENSEE, not more than once per year, shall
provide LICENSOR with an example of the goods and services employing the Mark by
LICENSEE.

20 *See* Doc. No. 37, at Exh. 4, p. 37 (emphasis in original). The licensing agreement states that
21 quality control will be undertaken by the licensee, and that the licensor will have direct review
22 of the licensee’s products at regular intervals, obligating Defendants as licensee to undergo
23 quality control analysis that was not present in Barcamerica. Accordingly, Plaintiff’s argument
24 regarding the invalidity of Defendants’ license and the ‘491 Mark is not persuasive.

25 Similarly, Plaintiff’s argument regarding Defendants’ actions of applying for marks in
26 other fields is unavailing. Although the license explicitly allows for Defendants to apply for a
27 trademark outside of the designated class of goods of the ‘491 Mark (*e.g.* “entertainment
28 services in the nature of a multi-directional musical ensemble”), such an allowance does not

1 necessarily lead to the conclusion that the '491 Mark would be abandoned as Plaintiff contends.
2 As discussed, the license allows the licensor quality control over Defendants' actions, including
3 the use of the '491 Mark in other fields outside of the current registration. In addition, that
4 Defendants have applied for the SUPERNOVA mark with the U.S. Patent and Trademark
5 Office may not necessarily be related to any activities under the license. As this Court notes,
6 Defendants' trademark application for the mark does not claim priority to the '491 Mark. *See*
7 *Defs. Exh. 15.*

8 Accordingly, the Court finds Plaintiff's arguments unpersuasive regarding the
9 abandonment of the '491 Mark and the alleged invalidity of Defendants' license.

10 *vi. Conclusion*

11 For the reasons discussed, the Court finds that Plaintiff has a valid trademark
12 registration, and Defendants' arguments regarding the invalidity of Plaintiff's SUPERNOVA
13 mark are unpersuasive.

14 **B. Likelihood of Success on the Merits**

15 To prevail on a trademark infringement claim, a plaintiff must establish that the
16 defendant "is using a mark confusingly similar to its own." *Sleekcraft*, 599 F.2d at 348. As
17 such, a plaintiff seeking a preliminary injunction "must establish that it is likely to be able to
18 show ... a likelihood of confusion." *Brookfield Communications, Inc. v. West Coast*
19 *Entertainment Corp.*, 174 F.3d 1036, 1053 n.15 (9th Cir. 1999). As discussed, the Ninth
20 Circuit balances the eight factors set forth in *Sleekcraft* to determine if a likelihood of confusion
21 between the parties' marks exists. *See Brookfield*, 174 F.3d at 1054. Although the analysis
22 requires a balancing of these eight factors, the Ninth Circuit considers the similarity of marks
23 "together with the relatedness of the services and the use of a common marketing channel" as
24 the "controlling troika" in a *Sleekcraft* likelihood of confusion analysis. *See GoTo.com*, 202
25 F.3d at 1205.

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1 I. Sleekcraft Factors

2 a. Similarity of the Marks

3 Plaintiff argues that the parties' marks are identical. Doc. No. 15 at 12. Plaintiff further
4 contends that "[c]onsumers will have no basis for distinguishing the identical marks, especially
5 where, as here, Defendants' mark will be used in connection with identical goods and services,
6 namely, sound recordings and live performances by a rock and roll musical group." Id., citing
7 to Robi v. Reed, 173 F.3d 736, 740 (9th Cir. 1999); HEC Enters. Ltd. v. Deep Purple, Inc., 213
8 U.S.P.Q. 991, 993 (C.D. Cal. 1980).

9 In response, Defendants assert that the marks are "distinctly different" because the band
10 "Supernova from Cynot 3 uses the 'Supernova' name exclusively in connection with a band that
11 is from outer space that performs dressed in silver space suits." Doc. No. 37 at 19 (emphasis
12 in original). In contrast, Defendants' SUPERNOVA mark is used "exclusively in connection
13 with the *Rock Star: Supernova* TV series and famous rock musicians Tommy Lee, Jason Newsted,
14 and Gilby Clark." Id.

15 Whether a mark is similar is assessed "in terms of their sight, sound and meaning."
16 Official Airline Guides, Inc. v. Goss, 6 F.3d 1385, 1392 (9th Cir. 1993). The trademark cannot
17 be judged by its individual parts, but rather how the mark, as a whole, appears in the market
18 place. Id. The degree of similarity of the marks is considered to be a critical question in the
19 analysis of confusion. GoTo.com, 202 F.3d at 1205. "The proper test for likelihood of
20 confusion is not whether consumers would be confused in a side-by-side comparison of the
21 products, but whether confusion is likely when a consumer, familiar with the one party's mark,
22 is presented with the other party's goods alone." E. & J. Gallo Winery v. Consorzio del Gallo
23 Nero, 782 F.Supp. 457, 466 (N.D. Cal. 1991).

24 Here, the parties' marks are identical in sight and sound. Both parties use the word mark
25 SUPERNOVA to represent their respective rock and roll groups. Defendants appear to argue
26 that Plaintiff uses the mark SUPERNOVA only in conjunction with the phrase "from CyNot3".
27 Plaintiff rebuts, stating that the phrase "from CyNot3" is not used in conjunction with the mark
28 SUPERNOVA, and points to Defendants' exhibits of Plaintiff's posters and CD recordings as

1 support. Doc. No. 46 at 1, citing to Defs. Exhs. 9, 10, 11, 22, 24-27, 29 and 32. Plaintiff's
2 assertions are persuasive. In viewing the evidence submitted by Defendants, Plaintiff use of the
3 SUPERNOVA mark predominates over any use, if present, of "from CyNot3". In Defendants'
4 Exhibits 9, 10, 11, 22, 24, 26-27, 29 and 32, for example, the phrase "from CyNot3" is wholly
5 absent from the promotional materials cited.

6 Defendants also argue that there is no similarity in the marks because Plaintiff "uses the
7 'Supernova' name exclusively in connection with a band that is from outerspace and that
8 performs dressed in silver space suits." Doc. No. 37 at 19 (emphasis in original). The mark's
9 use in conjunction with Plaintiff's appearance at concerts or performances should not be the
10 basis of comparison; rather, the parties' marks should be compared as to how "they appear in
11 the marketplace." GoTo.com, 202 F.3d at 1206. Here, Plaintiff uses the mark SUPERNOVA
12 standing alone, and not together with pictures of the band members in silver space suits.
13 Defendants' argument, therefore, is unpersuasive.

14 Accordingly, the parties' marks are identical, making this factor weigh heavily in support
15 of Plaintiff.

16 *b. Relatedness of Services*

17 Plaintiff contends that the parties' goods and services are "identical or closely related."
18 Plaintiff points out that it "uses its mark in connection with sound recordings and live
19 performances by a rock and roll band, and related merchandise." Doc. No. 15 at 13. Plaintiff
20 further contends that Defendants "intend to use the SUPERNOVA mark in connection with
21 a rock and roll band, sound recordings and live performances by a rock and roll band, and
22 related merchandise." *Id.*, citing to Mizhir Decl., Exh. B, Defendants' U.S. Trademark Appl.
23 No. 78,840,053.

24 In response, Defendants assert that the goods and services are "distinctly different."
25 Doc. No. 37 at 20. Defendants point out that Plaintiff's style of music and appearance on stage
26 is space punk, versus the "old school rock and roll" of Defendants' Supernova rock group. *Id.*
27 Defendants also point out the differences in performance venues, with Plaintiff playing in small
28 pubs and bars, and Defendants playing in large stadiums. Defendants conclude that the are

1 significant differences in music style, genre, image and concert venues precludes any likelihood
2 of confusion. Id.

3 If the parties' products or services are "sufficiently 'complementary' or 'related,'" then
4 "the public is likely to be confused as to the source of the services." American Intern. Group
5 Inc. v. American Intern. Bank, 926 F.2d 829, 832 (9th Cir. 1991). In M2 Software, Inc., both
6 parties produced and distributed compact disc recordings in different genres, one in interactive
7 music and the other in a sports-related music field. 421 F.3d 1082. The Ninth Circuit agreed
8 with the district court that because the "genres of the music CDs are very significantly
9 different", this factor weighed only slightly in favor of the mark holder. Id. at 1082.

10 Here, the genres of the music CDS are not "very significantly different." Although
11 Plaintiff may play "space punk" music, it is within the realm of the same type of music to a
12 reasonable music consumer. Importantly, Defendants do not assert that the customer base of
13 the parties do not overlap, which is the operative question here. Although Defendants may
14 appear in larger venues and perform at a more "polished" level than Plaintiff, Defendants will
15 likely derive their customer base from the same pool of consumers. Accordingly, this factor
16 weighs in favor of Plaintiff.

17 *c. Marketing Channels Used*

18 Plaintiff asserts that the parties' marketing channels are identical. Doc. No. 15 at 14.
19 Plaintiff asserts that its "music is marketed through the channels in which popular rock band
20 music is typically marketed." Id. Plaintiff points out that it also markets its products via the
21 internet, as will Defendants, and its live performances will be marketed to "the same rock and
22 roll fans who make up Plaintiff's audience." Id. Defendants rebut this contention, stating
23 instead that since Defendants use the television network show "Rock Star: Supernova" series
24 as well as its www.rockstar.msn.com website, and Plaintiff relies on "word of mouth" and its
25 MySpace page and www.supernovaarumy.com website, "[t]here is not relevant overlap." Doc.
26 No. 37 at 21. Defendants conclude that "[f]ans of the *Supernova from Cynot3* site and fans of
27 *Rock Star: Supernova* will not expect to find *Rock Star: Supernova* services at *Supernova from*
28 *Cynot3's* myspace page." Id.

1 Defendants' arguments are not persuasive. First, Defendants only speak to its current
2 promotion of the "Rock Star: Supernova" series, and not to the promotion of the SUPERNOVA
3 rock group after the reality television series ends. It is reasonable, as Plaintiff asserts, that
4 Defendants will market the rock group SUPERNOVA through the internet, commercial venues,
5 such as music stores, as well as through performances at live venues that will advertise its
6 concerts. In addition, Defendants' conclusory statements that there will be no confusion on
7 the parties' respective websites of the different rock groups fails to take into account that most
8 consumers will not know the specific web address of the respective SUPERNOVA groups.
9 Instead, the reasonable consumer will likely use internet search engines to search for "a"
10 SUPERNOVA group, and thus turn up both groups in its search. That the markets do not
11 converge on the internet, therefore, seems unlikely in view of the information known to a
12 reasonable consumer.

13 Accordingly, this factor also tips in favor of Plaintiff.

14 *d. Strength of the Mark*

15 A mark is considered to be stronger, and therefore accorded greater protection, when it
16 is more likely that the mark will "be remembered and associated in the public mind with the
17 mark's owner." GoTo.com, 202 F.3d at 1207. In Sleekcraft, the court distinguished between
18 arbitrary or fanciful marks, which are "afforded the widest ambit of protection from infringing
19 uses," and descriptive marks, which are accorded protection only when secondary meaning is
20 shown. Sleekcraft, 599 F.2d at 349. Suggestive marks, which lie between arbitrary and
21 descriptive marks, can be accorded protection without any secondary meaning. The Ninth
22 Circuit defined suggestive marks as "subtly connot[ing] something about the products." Id.
23 The court used, as a primary criterion to distinguish between descriptive and suggestive marks,
24 how "immediate and direct is the thought process from the mark to the particular product."
25 Id.

26 As discussed, Plaintiff argues that the SUPERNOVA is strong because the mark is
27 "arbitrary as applied to goods and services associated with a rock and roll band." Doc. No. 15
28 at 11. Plaintiff points out the dictionary meaning of supernova is "[a] rare celestial

1 phenomenon involving the explosion of most of the material in a star, resulting in an extremely
2 bright, short-lived object that emits vast amounts of energy.” *Id.*, citing to Dictionary.com
3 entry (<http://dictionary.reference.com/browse/supernova>), Mizhir Decl. at Exh. 1.

4 The mark SUPERNOVA appears to be arbitrary or fanciful. The mark SUPERNOVA,
5 especially in light of its dictionary meaning, requires a significant degree of imagination to
6 associate it with a rock group. *See Sleekcraft*, 599 F.2d at 349. Accordingly, this Court finds
7 that the mark is arbitrary or inherently distinctive.

8 Defendants assert that SUPERNOVA is a weak mark, presenting as evidence results of
9 a query on “www.musicstack.com”, where allegedly 178 records and CD’s were found that were
10 recorded by “Supernova from Cynot3, as well as dozens of others.” Doc. No. 37 at 18, citing
11 to Exhs. 2, 8 and 34. Defendants contend that as a result of the crowded SUPERNOVA music
12 field, the mark SUPERNOVA is “a weak indicator of source, weighing against any likelihood
13 of confusion.” Although a mark may be weakened by the availability of third-party marks that
14 are similar to the senior user’s mark, this factor does not have a strong bearing on whether a
15 likelihood of confusion exists. First, Defendants use of *Moose Creek v. Abercrombie & Fitch*
16 *Co.*, 331 F.Supp.2d 1214 (C.D. Cal. 2004) weakens its case, since the Ninth Circuit case that
17 *Moose Creek* relies on, *Miss World (UK), Ltd. v. Mrs. America Pageants, Inc.*, 856 F.2d 1445,
18 1449 (9th Cir. 1988), was abrogated *en banc* in *Eclipse Associates Ltd. v. Data General Corp.*,
19 894 F.2d 1114 (9th Cir. 1990). In addition, although some district courts have used *Miss*
20 *World* for its “crowded field” doctrine holding, most courts recognize that the crowded field
21 doctrine only works to weaken the senior user’s mark, and by no means does it establish the
22 unenforceability of the mark. *See Halo Management, LLC v. Interland, Inc.*, 308 F.Supp.2d
23 1019, 1034 (N.D. Cal. 2003).

24 Second, Defendants have not established that there are many third-party parties that use
25 the SUPERNOVA mark *in the relevant field*. Here, Defendants have only generally stated that
26 there is a listing of “178 records and CD’s, including some by *Supernova from Cynot3*, as well as
27 dozens of others,” but have not proffered information regarding the individual groups allegedly
28 using the name “Supernova”. As an example, a visit to the site “MusicStack” that Defendants

1 refer to in their papers and exhibits reveals that at least one of the entries for an artist
2 SUPERNOVA with the title “James Spader” is in the science fiction genre, and is a video entry.
3 See www.musicstack.com/item/2700048/supernova/james+spader. Moreover, under the
4 “Quantity” column of Defendants’ exhibit, there is a “23 listed” entry for Plaintiff
5 SUPERNOVA for the CD title “Ages 3 and Up.” See Defs. Exh. 2 at 1. Presumably all of these
6 entries represent 23 separate records or CDs for Plaintiff’s SUPERNOVA group out of the 178
7 hits Defendants received on the musicstack.com site, but it is not entirely clear to this Court.
8 Without knowing the specifics regarding the identification of these alleged third-party music
9 groups, the genre of each alleged group identified in Defendants’ alleged search, as well as the
10 origin or market channels of each group in regards to concert performances, recordings, sales
11 and promotion of these alleged third-party musical groups, Defendants’ evidence does not
12 sufficiently show that the SUPERNOVA field is crowded.

13 Accordingly, this factor appears to weigh in favor of Plaintiff. This Court, however, notes
14 that the Ninth Circuit recognizes a mark’s strength is not a significant factor in a likelihood of
15 confusion analysis. See GoTo.com, 202 F.3d at 1208; Brookfield, 174 F.3d at 1059 (“[T]he
16 strength of the mark is of diminished importance in the likelihood of confusion analysis.”).

17 *e. Evidence of Actual Confusion*

18 Plaintiff also points to evidence of actual “reverse confusion” among consumers. Plaintiff
19 cites to nine instances of actual confusion, including a declaration from the owner of a bar in
20 Long Beach, California, Mr. Alex Hernandez, stating that he received “at least six telephone
21 calls” at the bar asking if the Supernova band performing at his bar included the performer
22 Tommy Lee. Doc. No. 15 at 13, citing to Hernandez Decl. at ¶ 8-10. In addition, Mr.
23 Hernandez submitted an e-mail from a Mr. Kimm Gardener inquiring whether the Supernova
24 band appearing at his bar included the band members “Tommy Lee, Gilby and Jason from
25 Metallica.” Id. Plaintiff also submitted a declaration from Mr. Chris Fahey, who states that
26 he received an e-mail and telephone call inquiring whether the band Supernova appearing at
27 his Costa Mesa bar included the band members Tommy Lee, Gilby Clarke and Jason Newsted.
28 Id., citing to Fahey Decl. at ¶ 9-11.

1 In response, Defendants state that any evidence of reverse confusion is not evidence that
2 consumers are confused, but rather evidence that consumers are actually *not* confused because
3 the inquiries “indicates that the inquirer is aware that there are different trademark users, and
4 is interested in a particular one of those users.” Doc. No. 37 at 20, citing to Fisher Stoves, Inc.
5 v. All Nighter Stove Works, Inc., 626 F.2d 193, 194-195 (1st Cir. 1980); Medi-Flex, Inc. v.
6 Nice-Pak Products, Inc., 422 F.Supp.2d 1242, 1251-1252 (D.Kan 2006); McCarthy,
7 Trademarks and Unfair Competition, § 23:16 (4th ed. 2004).

8 “Evidence that use of the two marks has already led to confusion is persuasive proof that
9 future confusion is likely.” Sleekcraft, 599 F.2d at 352. Thus, a substantial showing of actual
10 confusion is strong evidence that indicates any continued use by the junior user would result
11 in further confusion. Id., citing to Continente v. Continente, 378 F.2d 279, 281-82 (9th Cir.
12 1967). Here, Plaintiff presents substantial evidence of confusion between the bands
13 SUPERNOVA. Plaintiff’s declarants state that consumers were confused as to the source of the
14 mark SUPERNOVA, *i.e.* who the members of the band SUPERNOVA were that were
15 performing in their establishments. Thus, it appears that actual confusion exists to consumers
16 in the general public.

17 Defendants’ citation of Fisher Stoves et al. is unpersuasive. Aside from the non-
18 precedential nature of these cases, the cases do not stand for the proposition that Defendants
19 contend. In Fisher Stoves, for example, the First Circuit distinguished consumers who “accused
20 one manufacturer of copying the other and wanted to know which stove was made first, or
21 inquired as to the differences between the two stoves, or asked if the two companies were
22 affiliated,” from consumers that are confused as to the source of the product. 626 F.2d at 195.
23 The court recognized that the prominent display of the mark holder’s and competitor’s
24 trademarks on their respective products allowed consumers to clearly identify the origin of the
25 goods, and therefore not be confused as to its source. Id. “Confusion, in the legal sense means
26 confusion of source.” Id. The consumers in the instant case do not ask the declarants details
27 regarding the two bands by distinguishing differences between the two groups. The evidence,
28 instead, only reflects that the consumers are confused as to the source of the band members

1 performing in Supernova. Similarly, in Medi-Flex, the Kansas district court dismissed plaintiff's
2 claim of actual confusion where the nurse drew a distinction between the two competing
3 products. Again, the consumers in the instant matter are not drawing a distinction between two
4 rock groups, but instead are confused as to the source of who was performing at the concert,
5 *i.e.* who the source of the SUPERNOVA band was. Accordingly, Defendants' arguments are
6 unpersuasive. This factor weighs heavily in favor of Plaintiff in finding a likelihood of confusion
7 in this matter.

8 *f. Degree of Purchaser Care*

9 Plaintiff asserts that the degree of purchaser care is relatively low, in part because the
10 parties' goods and services are relatively inexpensive, but also because the target market are
11 "teenagers and thus inexperienced consumers." Doc. No. 15 at 16. Defendants rebut this
12 contention, stating instead that "teenagers are extraordinary knowledgeable about their music
13 and their bands."

14 In E. & J. Gallo Winery v. Gallo Cattle Co., 967 F.2d 1280 (9th Cir. 1992), the Ninth
15 Circuit reasoned that consumers do not exercise a great deal of care in selecting products when
16 the products are inexpensive, thus finding that the degree of purchaser care is minimum when
17 the costs of the items are correspondingly low. *Id.* at 1293. In the instant matter, the parties
18 do not dispute the relative impact of the costs of the relevant goods, but dispute the actual
19 degree of care placed by the alleged consumer target group, teenagers. Thus, the analysis by this
20 Court must balance out the undisputed fact that compact discs, which are priced at between
21 \$10 - 20, are purchased by a possibly inexperienced consumer that may be nonetheless highly
22 knowledgeable about different bands. This Court, however, is not convinced that the target
23 group would consist exclusively of teenagers, but instead would likely also incorporate adults
24 and older or seasoned fans that may follow Plaintiff's group because of their long-history in the
25 music field. These older fans may not, however, have the ability or desire to distinguish
26 between different music groups with the same name, especially where the cost of the relevant
27 goods are comparatively low. Accordingly, this factor weighs only slightly in favor of Plaintiff
28 in this analysis.

1 g. Defendant's Intent in Selecting Mark

2 Plaintiff contends that Defendants adopted the SUPERNOVA mark with the bad faith
3 of misappropriating the mark from Plaintiff. Doc. No. 15 at 14. Plaintiff points to Defendants'
4 prior knowledge of Plaintiff's SUPERNOVA band, the cease and desist letter sent to
5 Defendants on March 21, 2006, as well as the evidence sent to Defendants of Plaintiff's
6 commercial use of the SUPERNOVA mark. Id. Plaintiff also presents an e-mail from one of
7 Defendants' alleged business acquaintance as evidence of bad faith to procure Plaintiff's mark.⁴
8 Defendants, in response, point to their research into the trademark arena, as well as their
9 licensing of a "Supernova" mark from Mr. Nasar Abadey before adopting the SUPERNOVA
10 mark. Doc. No. 37 at 22. Defendants also contend that they "confirmed through objective
11 evidence that the *Supernova from Cynot3* band had long ago abandoned any trademark rights it
12 once might have had." Id.

13 A court presumes "that the public will be deceived" if "the alleged infringer knowingly
14 adopts a mark similar to another's." Sleekcraft, 599 F.2d at 354. Thus, bad faith evidence of
15 an alleged infringer's attempt to knowingly adopt a similar mark will result in the strong
16 presumption that the public will be deceived. M2 Software, Inc., 421 F.3d at 1085. It is
17 unclear here whether Defendants willfully adopted the SUPERNOVA mark by infringing
18 Plaintiff's mark. Defendants performed a search of the registered U.S. trademarks, and
19 identified and licensed a registered mark for licensing. Moreover, Defendants contend that they
20 performed an independent analysis of the strength of Plaintiff's mark, and believed the mark
21 to be abandoned. Accordingly, this factor weighs in favor of Defendants. However, it is well
22 settled "that '[a] party claiming trademark infringement need not demonstrate that the alleged
23 infringer intended to deceive consumers.'" Id., quoting E & J Gallo Winery, 967 F.2d at 1293;
24 *see also* Brookfield, 174 F.3d at 1059 ("Absence of malice is not defense to trademark
25 infringement"). Thus, as the Ninth Circuit in GoTo.com recognized, this factor "is not
26

27 ⁴ The e-mail reads: "I can't believe those dudes chose your name...for the record, I tried to talk them
28 out of it. I told them I had a cd by a band from back in the day called supernova and they were retarded for
doing it. They didn't listen. Good on ya for making a stink about it." Doc. No. 46 at 2, citing to Collins Decl.
at Exh. 40.

1 necessary to demonstrate a likelihood of confusion.”

2 *h. Likelihood of Expansion of Product Lines*

3 “A strong likelihood that either party may expand his business to compete with the other
4 favors a finding of infringement.” Official Airline Guides, 6 F.3d at 1394. However, when
5 parties “already sell directly competing products,” this factor does not weigh in either party’s
6 favor. Sutter Home Winery, Inc. v. Madrona Vineyards, L.P., 2005 WL 701599, * 13 (N.D.
7 Cal. March 23, 2005). Because there has already been a finding that the proximity of the goods
8 are similar, this factor is not relevant to this Court’s analysis.

9 *i. Conclusion*

10 Based on the analysis, and weighing the Sleekcraft factors as discussed, it is likely that
11 Plaintiff will prevail on the merits at trial. The marks are identical, the parties operate in very
12 similar or identical markets, the SUPERNOVA is distinctive and therefore strong, and there is
13 evidence of actual confusion in the market. Accordingly, the Court should find that Plaintiff
14 is likely to succeed on the merits of its trademark infringement case.

15 2. Irreparable Harm

16 Plaintiff contends that it succeeds on the second prong of the preliminary injunction test
17 because irreparable harm is presumed if a party has established a likelihood of success on the
18 merits in a trademark infringement context. Doc. No. 15 at 16. Plaintiff also points out that
19 if no preliminary injunction is imposed, Defendants’ access to large promotional budgets will
20 drown out Plaintiff’s SUPERNOVA group. Id. Plaintiff adds that it “has no desire to risk
21 association with Defendants in the minds of rock and roll music listeners.” Id. In response,
22 Defendants contend that Plaintiff have failed to meet its burden of providing evidence of
23 irreparable harm. Doc. No. 37 at 23. Defendants assert Plaintiff “intentionally hyped this
24 dispute in order to garner publicity, and make more money than it ever did in the past.” Id.

25 Once a senior user has demonstrated a likelihood of success on the merits on a trademark
26 infringement claim, irreparable injury is presumed. El Pollo Loco, Inc. v. Hashim, 316 F.3d
27 1032, 1038 (9th Cir. 2003); citing to GoTo.com, 202 F.3d at 1205 n.4. Because Plaintiff is
28 likely to succeed on the merits of its trademark infringement claim against Defendants,

1 irreparable harm is presumed here. Accordingly, Plaintiff need not proffer evidence of
2 irreparable injury to show the requisite harm necessary for issuing a preliminary injunction.

3 The Court also finds, however, that significant evidence supports Plaintiff's claims of
4 irreparable harm should Defendants not be enjoined from using the SUPERNOVA mark.
5 Because of the comparatively large amount of resources available to Defendants in terms of
6 advertising, promotion, marketing and funding of its SUPERNOVA band, any attempt of
7 Plaintiff to promote its band in the future will likely be futile. In short, Defendants access to
8 large amount of monetary and promotional resources will effectively diminish, if not eliminate,
9 Plaintiff's commercial presence in the relevant marketplace. Accordingly, Plaintiff is likely to
10 suffer irreparable harm if Defendants are not enjoined.

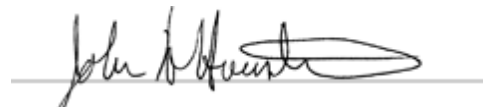
11 **CONCLUSION AND ORDER**

12 For the reasons stated above, **IT IS HEREBY ORDERED** that:

- 13 1. Plaintiff's motion for preliminary injunction is **GRANTED**. Defendants are
14 enjoined from using the mark SUPERNOVA in conjunction with performing rock
15 and roll music, or recording or selling rock and roll music recordings under the
16 same pending a trial of this action on its merits, or until otherwise ordered by the
17 Court.
- 18 2. This Order shall be effective upon the posting of a bond by Plaintiff pursuant to
19 Fed. R. Civ. P. 65(c). The bond amount will be determined by this Court in a
20 separate Order.

21 **IT IS SO ORDERED.**

22
23 DATED: September 12, 2006

24 
25 HON. JOHN A. HOUSTON
26 United States District Judge

27 cc: Magistrate Judge Brooks
28 All Counsel of Record