

No. \_\_\_\_\_

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**In The  
Supreme Court of the United States**

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HERB REED ENTERPRISES, LLC,

*Petitioner,*

v.

FLORIDA ENTERTAINMENT MANAGEMENT, INC.,  
AND LARRY MARSHAK,

*Respondents.*

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**On Petition For A Writ Of Certiorari  
To The Ninth Circuit Court Of Appeals**

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**PETITION FOR A WRIT OF CERTIORARI**

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## QUESTION PRESENTED

In *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 392-94 (2006), this Court reversed the “general rule” in patent disputes “that a permanent injunction will issue once infringement and validity have been adjudged.” The meaning of *eBay* in patent injunction cases is clear. All of the requirements for an injunction must be established, including irreparable harm, without reliance on categorical pronouncements. Circuit courts are split and lower courts are in disarray, however, about whether and how to apply *eBay* in trademark infringement cases, and the state of the law is such that a trademark plaintiff’s ability to obtain an injunction currently turns on the happenstance of the Circuit in which the case is pending.

There are significant differences between patent and trademark cases. In patent cases, irreparability of harm does not necessarily flow from the evidence showing infringement. But in a trademark case, the plaintiff must show, *inter alia*, customer confusion impairing control over the mark or goodwill. As a result, the same evidence that establishes infringement will often show irreparable harm. The Ninth Circuit below, however, and some other lower courts, have interpreted *eBay* and *Winter v. Natural Resources Defense Council, Inc.*, 555 U.S. 7, 21-22 (2008) to require a trademark infringement plaintiff to come forward with something more, although the required added showing is vague.

**QUESTION PRESENTED** – Continued

The question presented is whether the Ninth Circuit erred in concluding *eBay* means that a district court may not base a finding of irreparable injury on the same evidence used to show likely infringement, such as customer confusion and impairment of control or goodwill.

**LIST OF PARTIES**

Herb Reed Enterprises, LLC is the petitioner. Florida Entertainment Management, Inc. and Larry Marshak are the respondents.

**RULE 14.1 AND 29.6 STATEMENT**

Petitioner Herb Reed Enterprises, LLC is not publicly traded and has no parent corporation.

## TABLE OF CONTENTS

	Page
QUESTION PRESENTED.....	i
LIST OF PARTIES.....	iii
RULE 14.1 AND 29.6 STATEMENT .....	iii
TABLE OF AUTHORITIES .....	vi
PETITION FOR A WRIT OF CERTIORARI .....	1
OPINIONS BELOW.....	1
JURISDICTION.....	1
STATUTES AND CONSTITUTIONAL PROVI- SIONS INVOLVED .....	2
STATEMENT OF THE CASE.....	2
REASONS FOR GRANTING THE PETITION ...	6
1. Significant Differences Between Patent and Trademark Cases Necessitate Guid- ance From the Court.....	6
2. The Circuits Are Divided on the Evidence Necessary for Preliminary Injunctive Re- lief in Trademark Infringement Cases.....	12
3. District Court Litigation, Often on Hur- ried Records, Illustrates the Extent of the Need for This Court’s Guidance .....	15
4. Likely Irreparable Injury May Be Estab- lished From the Same Evidence as Likely Success on the Merits.....	17
5. The Ninth Circuit Erred in This Case .....	21
CONCLUSION.....	23

## TABLE OF CONTENTS – Continued

Page

## APPENDIX

Ninth Circuit Court of Appeals Opinion: <i>Herb Reed Enterprises, LLC v. Florida Entertainment Management, Inc.</i> , 736 F.3d 1239 (9th Cir. 2013).....	App. 1
United States District Court, District of Nevada Order Granting Plaintiff’s (HRE) Motion for Preliminary Injunction (July 24, 2012).....	App. 26
15 U.S.C. § 1125(a), (c) .....	App. 73
15 U.S.C. § 1116.....	App. 79
Table of Reported Post- <i>eBay</i> District Court Trademark Preliminary Injunction Cases ....	App. 80

## TABLE OF AUTHORITIES

Page

## CASES

<i>A. Bourjois &amp; Co. v. Katzel</i> , 260 U.S. 689 (1923).....	20
<i>Abbott Labs. v. Mead Johnson &amp; Co.</i> , 971 F.2d 6 (7th Cir. 1992) .....	9
<i>Abraham v. Alpha Chi Omega</i> , 708 F.3d 614 (5th Cir. 2013) .....	12, 13
<i>Am. Steel Foundries v. Robertson</i> , 269 U.S. 372 (1925).....	21
<i>Audi AG v. D’Amato</i> , 469 F.3d 534 (6th Cir. 2006) .....	13
<i>Campbell v. Acuff-Rose Music, Inc.</i> , 510 U.S. 569 (1994).....	7
<i>Champion Spark Plug Co. v. Sanders</i> , 331 U.S. 125 (1947).....	20
<i>Dastar Corp. v. Twentieth Century Fox Film Corp.</i> , 539 U.S. 23 (2003).....	7
<i>Dun v. Lumbermen’s Credit Ass’n</i> , 209 U.S. 20 (1908).....	7
<i>eBay Inc. v. MercExchange, L.L.C.</i> , 547 U.S. 388 (2006).....	<i>passim</i>
<i>Elgin Nat’l Watch Co. v. Illinois Watch Case Co.</i> , 179 U.S. 665 (1901).....	19
<i>Hanover Star Milling Co. v. Metcalf</i> , 240 U.S. 403 (1916).....	9, 20
<i>Inwood Labs. Inc. v. Ives Labs., Inc.</i> , 456 U.S. 844 (1982).....	9

## TABLE OF AUTHORITIES – Continued

	Page
<i>Lexmark Int’l, Inc. v. Static Control Components, Inc.</i> , Case No. 12-873, 2014 WL 1168967, 134 S. Ct. 1377 (Mar. 25, 2014) .....	14
<i>Merrill Lynch, Pierce, Fenner &amp; Smith, Inc. v. McCollum</i> , 469 U.S. 1127 (1985) .....	5
<i>Mishawaka Rubber &amp; Woolen Mfg. Co. v. S.S. Kresge Co.</i> , 316 U.S. 203 (1942) .....	18
<i>N. Am. Med. Corp. v. Axiom Worldwide, Inc.</i> , 522 F.3d 1211 (11th Cir. 2008) .....	13
<i>New York Times Co. v. Tasini</i> , 533 U.S. 483 (2001) .....	7
<i>Newark Morning Ledger Co. v. United States</i> , 507 U.S. 546 (1993) .....	18
<i>Park ’N Fly v. Dollar Park &amp; Fly, Inc.</i> , 469 U.S. 189 (1985) .....	9, 16
<i>Powertest Petroleum Distribs., Inc. v. Calcu Gas, Inc.</i> , 754 F.2d 91 (2d Cir. 1985) .....	18
<i>Rondeau v. Mosinee Paper Corp.</i> , 422 U.S. 49 (1975) .....	5
<i>Times Mirror Magazines, Inc. v. Las Vegas Sports News L.L.C.</i> , 212 F.3d 157 (3d Cir. 2000) .....	18
<i>TrafFix Devices v. Mktg. Displays</i> , 532 U.S. 23 (2001) .....	14

## TABLE OF AUTHORITIES – Continued

	Page
<i>Two Pesos, Inc. v. Taco Cabana, Inc.</i> , 505 U.S. 763 (1992).....	8
<i>United Drug Co. v. Theodore Rectanus Co.</i> , 248 U.S. 90 (1918).....	8
<i>United States v. W.T. Grant Co.</i> , 345 U.S. 629 (1953).....	5
<i>Univ. of Texas v. Camenisch</i> , 451 U.S. 390 (1981).....	16
<i>William R. Warner &amp; Co. v. Eli Lilly &amp; Co.</i> , 265 U.S. 526 (1924).....	20
<i>Winter v. Natural Res. Def. Council, Inc.</i> , 555 U.S. 7 (2008).....	<i>passim</i>

## DOCKETED CASES

<i>Ferring Pharm. Inc. v. Watson Pharm., Inc.</i> , Case No. 13-2290 (3d Cir.) (argued Feb. 12, 2014) .....	14
---	----

## RULES, REGULATIONS AND STATUTES

## United States Code:

15 U.S.C. § 1051 .....	<i>passim</i>
15 U.S.C. § 1116 .....	2
15 U.S.C. § 1125(a).....	2
15 U.S.C. § 1125(c) .....	2
28 U.S.C. § 1254(1) .....	1
28 U.S.C. § 1291(a)(1) .....	1

## TABLE OF AUTHORITIES – Continued

	Page
28 U.S.C. § 1331 .....	1
28 U.S.C. § 1338(a) .....	1

## OTHER AUTHORITIES

3 Jerome Gilson, <i>et al.</i> , TRADEMARK PROTECTION AND PRACTICE § 8.07[1] (Matthew Bender) (2002) .....	17, 18
3 Anne Gilson LaLonde, GILSON ON TRADEMARKS § 14.02[3][b] (Matthew Bender) (2013) .....	10, 19
S. Rep. No. 1333, 79th Cong., 2d Sess. (1946) .....	8, 17
11A Charles Alan Wright, Arthur R. Miller & Mary Kay Kane, FEDERAL PRACTICE AND PRO- CEDURE (3d ed. 2013)	
§ 1948.1 .....	18
§ 2948.1 .....	17

## PETITION FOR A WRIT OF CERTIORARI

Herb Reed Enterprises, LLC hereby petitions for a writ of certiorari to review the published opinion of the United States Court of Appeals for the Ninth Circuit in *Herb Reed Enterprises, LLC v. Florida Entertainment Management, Inc. and Larry Marshak*, Case No. 12-16868.



### OPINIONS BELOW

The opinion of the United States Court of Appeals for the Ninth Circuit is reported at 736 F.3d 1239 (9th Cir. 2013) and attached in the Petition Appendix (“Pet. App.”) 1. The July 24, 2012 order of the United States District Court for the District of Nevada in this case is reported at 2012 WL 3020039 (D. Nev.), and set forth at Pet. App. 26.



### JURISDICTION

The opinion of the Ninth Circuit was filed on December 6, 2013. Pet. App. 1. Justice Kennedy approved an extension of time to file this petition to April 17, 2014 on February 26, 2014. This Court’s jurisdiction is invoked under 28 U.S.C. § 1254(1). The jurisdiction of the Ninth Circuit was invoked under 28 U.S.C. § 1291(a)(1) and of the district court under the trademark laws of the United States as set forth in the Lanham Act, 15 U.S.C. § 1051, *et seq.*, 28

U.S.C. § 1331 (federal question), and 28 U.S.C. § 1338(a) (trademarks).

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## STATUTES AND CONSTITUTIONAL PROVISIONS INVOLVED

This case involves Lanham Act §§ 34, 43(a), (c), 15 U.S.C. §§ 1116, 1125(a), (c), which are set forth in full in Pet. App. 73-79.

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## STATEMENT OF THE CASE

The preliminary injunction at issue in this trademark infringement case was entered in a dispute about a famous 1950s musical group, The Platters. The group was founded by Herb Reed, recorded at least 12 gold records including such classic hits as “Only You,” “The Great Pretender,” and “Smoke Gets in Your Eyes,” and was inducted into the Rock and Roll and Grammy Halls of Fame. The original group members separated in the 1960s. As members left, litigation over the right to capitalize on The Platters name and reputation began and continues to this day. Pet. App. 3-11.

Herb Reed died shortly before the preliminary injunction below was entered; Herb Reed Enterprises, LLC (“HRE”) holds his personal rights. Pet. App. 27, 40-41, 64. Years of litigation culminated in the rulings at issue here. The district court preliminarily enjoined Respondents from holding themselves out

as The Platters while allowing them to present “Marshak’s Tribute to The Platters.” Pet. App. 71. It analyzed the evidence and found that HRE was likely to succeed in proving (a) ownership of a valid, protectable mark in The Platters, and (b) that Respondents were using a confusingly similar mark, *i.e.*, The Platters. Pet. App. 46-62.

Because of the identical names and both groups singing original Platters hits, the district court found that consumers are likely to believe the two are related or that Respondents’ group is the original, authentic version. Pet. App. 54-62. Recognizing the difficulty of producing evidence of actual confusion at a preliminary hearing, the district court discounted the absence of such evidence while focusing on the typical buyer of music show tickets exercising ordinary caution. Pet. App. 56-58. With identical names, clothing styles, music, advertising as The Platters, purporting to be the modern iteration of the original Platters, and using nearly identical marketing channels, a reasonable consumer would not know whether he was purchasing tickets to Respondents’ group or HRE’s group. Pet. App. 56-58, 60-62.

The district court did not give HRE a presumption of irreparable harm. Pet. App. 62-63. It rejected Respondents’ argument that their years of performances meant harm pending litigation would be negligible because that would condone and could encourage infringement by persons “hoping to tread on the goodwill and fame of vintage music groups.” Pet. App. 64-65. It “found merit” in HRE’s claims that

Reed's legacy would suffer reputational harm and his heirs and assigns would be denied the right to benefit from the fame Reed brought to The Platters mark. Pet. App. 65. The district court quoted another court's preliminary injunction ruling when Reed had been forced to contend with another unauthorized Platters group. It had found that continued use of the mark in a confusingly similar manner (i) would likely damage Reed's reputation as a performer, and (ii) Reed likely would lose goodwill among consumers if The Platters name continued to be diluted, and (iii) if continued confusion over rights to the mark were permitted by the court, additional groups could form and further harm Reed's reputation and goodwill. Pet. App. 65-66.

Discussing the balance of hardships, the district court said that the goodwill associated with the original The Platters mark would continue to be diluted if Respondents were allowed to promote their imitation group in Las Vegas and nationwide, and this was a significant harm. Pet. App. 66-67. It found Respondents' harm to be less significant, and the public interest served by preventing customer confusion and clarifying that Respondents' is a tribute band and not the authentic version. Pet. App. 67-68.

The Ninth Circuit affirmed various procedural rulings and HRE's likelihood of success on the merits of the trademark dispute. Pet. App. 11-19. With respect to irreparable injury, however, it held that HRE's evidence was unsupported and conclusory, while recognizing that evidence of loss of control over business reputation and damage to goodwill can

constitute irreparable harm. Pet. App. 22. Relying on *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006) and *Winter v. Natural Resources Defense Council, Inc.*, 555 U.S. 7 (2008), the Ninth Circuit rejected the principle that evidence of customer confusion is also evidence of irreparable harm. It stated that without additional evidence, the district court effectively and improperly applied a presumption of irreparable harm based solely on a strong case of trademark infringement. Pet. App. 22-24.

After entry of the preliminary injunction, the parties continued to litigate the merits, and on March 31, 2014, the district court ruled for HRE on cross-motions for summary judgment. Remedies issues remain to be decided. Even if the underlying suit concludes pending the Court’s review, trademark preliminary injunction standards still constitute a live controversy to HRE. As the owner of a trademark, HRE must enforce it to keep it, and the history of multiple pretenders to The Platters name forecasts other preliminary injunction proceedings to come.<sup>1</sup>



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<sup>1</sup> See *Rondeau v. Mosinee Paper Corp.*, 422 U.S. 49, 59 (1975) (injunctive relief available when “there exists some cognizable danger of recurrent violation.”), citing *United States v. W.T. Grant Co.*, 345 U.S. 629, 633 (1953) (“the court’s power to grant injunctive relief survives discontinuance of the illegal conduct”); *Merrill Lynch, Pierce, Fenner & Smith, Inc. v. McCollum*, 469 U.S. 1127, 1131 (1985) (availability of injunctive relief pending resolution of a case on the merits is an issue “capable of repetition, yet evading review.” (White and Brennan, JJ., dissenting from denial of cert.)).

## REASONS FOR GRANTING THE PETITION

### 1. Significant Differences Between Patent and Trademark Cases Necessitate Guidance From the Court

This Court's opinions in *eBay* and *Winter* refocused the standards for injunctive relief in federal cases, including patent and copyright infringement actions, to emphasize the need for proof of all four traditional elements:

A plaintiff seeking a preliminary injunction must establish that he is likely to succeed on the merits, that he is likely to suffer irreparable harm in the absence of preliminary relief, that the balance of equities tips in his favor, and that an injunction is in the public interest.

*Winter*, 555 U.S. at 20; *eBay*, 547 U.S. at 391 (citing four-factor test for permanent injunctions).

In *eBay*, the Court rejected the Federal Circuit's categorical rule for patent cases that permanent injunctive relief should automatically issue once patent infringement has been shown. The Court instead required that a plaintiff show that injunctive relief is appropriate based on the four traditional injunction factors, including the existence of irreparable harm. 547 U.S. at 392-93. It also reiterated that "this Court has consistently rejected invitations to replace traditional equitable considerations with a rule that an injunction automatically follows a determination that a copyright has been infringed." 547

U.S. at 393, citing, *e.g.*, *New York Times Co. v. Tasini*, 533 U.S. 483, 505 (2001) (citing *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578, n.10 (1994)); *Dun v. Lumbermen's Credit Ass'n*, 209 U.S. 20, 23-24 (1908)).

These decisions only involved two types of intellectual property, patents and copyrights. A third type of intellectual property, trademarks, is different from patents and copyrights in critical respects directly relevant to injunctions. Most notably, the evidence supporting a finding of likelihood of success on the merits in trademark cases – the plaintiff's entitlement to control over the mark and the goodwill that comes with it, plus consumer confusion arising from the defendant's infringement – may also establish the likelihood of irreparable harm because that harm inheres in the usurpation of such control. Confusing consumers itself misappropriates the owner's goodwill, and is exacerbated by a risk of reputational damage because the infringer is likely providing a different product that also may be of an inferior quality.

Copyright and patent infringement is fundamentally different than Lanham Act trademark infringement. Copyrights and patents reward inventors and authors with monopolies and rights to profit for specified periods, after which the work may be used at will and without attribution. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 33-34 (2003). Accordingly, legal damages may be sufficient to compensate for infringing use, and injunctions may

not serve the public interest in some cases, especially where a patented invention is a small component of a product and the threat of an injunction is employed for undue leverage in negotiations. *eBay*, 547 U.S. at 396-97 (Kennedy, J., concurrence).

Trademarks have a different purpose, as Justice Stevens observed, quoting a Senate Report accompanying the Lanham Act in 1946:

The purpose underlying any trade-mark statute is twofold. One is to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get. Secondly, where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats. This is the well-established rule of law protecting both the public and the trade-mark owner.

*Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 782 n.15 (1992) (Stevens, J., concurring), quoting S. Rep. No. 1333, 79th Cong., 2d Sess., 3 (1946). That fundamental difference means that analogies to patent and copyright law must be carefully considered. See *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918) (“fundamental error [to] suppose[e] that a trade-mark right is a right in gross or at large, like a statutory copyright or a patent for an

invention, to either of which, in truth, it has little or no analogy.”).

Trademark infringement actions involve protecting the trademark owner from injury to intangible goodwill and protecting customers from deception as to the source of that goodwill. *Park 'N Fly v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985); *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 412 (1916) (“applying the same mark to goods of the same description [is debarred], because to do so would in effect represent their goods to be of his production and would tend to deprive him of the profit he might make through the sale of the goods which the purchaser intended to buy”). *See also Inwood Labs. Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 855 n.14 (1982) (“[T]he infringer deprives the owner of the goodwill which he spent energy, time, and money to obtain. At the same time, the infringer deprives consumers of their ability to distinguish among the goods of competing manufacturers.” (internal citation omitted.)).

Courts have recognized that the injury to goodwill resulting from trademark infringement and false advertising is inherently unquantifiable and cannot be measured by lost sales or unjust enrichment. As such, the harm is not capable of measurement with any level of certainty and is inherently irreparable. For those reasons, the evidence of likely success on the merits has served as evidence to establish likely irreparable injury, which some courts have called a rebuttable presumption of irreparable harm in trademark infringement cases. *See Abbott Labs. v.*

*Mead Johnson & Co.*, 971 F.2d 6, 16, 18 (7th Cir. 1992) and lengthy citation list in 3 Anne Gilson LaLonde, GILSON ON TRADEMARKS § 14.02[3][b] at 14-17 n.73 (Matthew Bender) (2013).

This approach to establishing likely irreparable harm is particularly important at the preliminary injunction stage, where plaintiffs are trying to prevent the injury-causing violations from continuing to occur. From an evidentiary perspective, prior to discovery it is difficult to identify and submit concrete evidence of harm that has yet to occur. At the same time, defendants can be protected by their ability to “rebut the presumption” with evidence that any harm is in fact compensable (evidence they are likely to control) or otherwise is not irreparable. Failure to recognize likely irreparable harm flowing from the same evidence that proves a likelihood of success on the merits is thus against the public interest and would unfairly force false advertising and trademark plaintiffs to bear a greater – and in some instances insurmountable – burden of proof at the preliminary injunction stage.

In *eBay* and *Winter*, this Court did not consider, let alone abolish, the concept that irreparable harm may be established in this manner in the context of trademark infringement. Nor did the Court’s reasoning mandate rejection of the traditional evidentiary rebuttable presumption of irreparable harm in such cases. Notably, in two concurrences in *eBay*, a total of seven Justices agreed that district courts may continue to allow such evidentiary rules – implemented

as “lesson[s] of . . . historical practice” – to inform their equitable discretion “when the circumstances of a case bear substantial parallels to litigation the courts have confronted before.” 547 U.S. at 395-97 (Kennedy, J., concurring, joined by Stevens, Souter, and Breyer, JJ.), and *id.* at 394-95 (Roberts, C.J., concurring, joined by Scalia and Ginsburg, JJ.).

*Winter* likewise did not address whether evidence showing a sufficient likelihood of a confusing presentation to the public to prove infringement would also suffice to show sufficient irreparable harm for preliminary relief. *Winter* concerned the environmental impact of the Navy’s use of sonar. The Ninth Circuit had held that, if a plaintiff made a strong showing of likelihood of success on the merits, then the plaintiff had only to prove a “*possibility*” of irreparable harm to be entitled to a preliminary injunction. 555 U.S. at 8 (emphasis added). This Court held that a likelihood, rather than a mere possibility, of irreparable injury must be shown. 555 U.S. at 22. But, like *eBay*, *Winter* said nothing about whether a likelihood of irreparable injury could be found from the same evidence establishing a likelihood of success on the merits. That is the essence of the rebuttable presumption of irreparable injury to a party’s intangible goodwill that has long applied in Lanham Act cases, as an evidentiary matter, when plaintiffs have shown a likelihood of success on the merits.

The Court’s direction on application of *eBay* and *Winter* to trademark law is sorely needed now, because circuit courts and district courts are struggling

over how to apply *eBay* and *Winter* in the trademark context. Some courts, including the Ninth Circuit in its decision below, are out of line with fundamental principles of trademark law and historic decisions of the Court.

## **2. The Circuits Are Divided on the Evidence Necessary for Preliminary Injunctive Relief in Trademark Infringement Cases**

The Ninth Circuit below held that the evidence establishing likelihood of success on the merits was insufficient to establish likelihood of irreparable harm, and that more hard evidence is needed. It deemed the reliance on evidence of plaintiff's trademark rights and consumer confusion to be tantamount to a rebuttable presumption of likely injury that it said the Court rejected in *eBay* and *Winter*. Pet. App. 22-24.

The Ninth Circuit's published decision is directly in conflict with *Abraham v. Alpha Chi Omega*, 708 F.3d 614, 627 (5th Cir. 2013), which cited *eBay* then held there is no impediment to finding that irreparable harm flows from a finding of likelihood of confusion:

The district court's test did not erroneously place the burden on Abraham; rather, it correctly considered the relevant factors. As to the first factor, a leading treatise states, "All that must be proven to establish liability and the need for an injunction against infringement is the likelihood of confusion – injury

is presumed.” 5 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 30:2 (4th ed. 2001). As to the second, the same treatise states, “[T]here seems little doubt that money damages are ‘inadequate’ to compensate [owner] for continuing acts of [infringer].” *Id.*

The Ninth Circuit believed its opinion below was in accord with the Sixth Circuit’s decision in *Audi AG v. D’Amato*, 469 F.3d 534, 550 (6th Cir. 2006). Pet. App. 21. To the contrary, while each invoked *eBay*, their analyses are at odds. In *D’Amato*, the Sixth Circuit found irreparable harm from the consequences of the facts that established success on the merits. *Id.* (“D’Amato’s website used Audi’s trademarks in its domain name and in the goods and services sold on it. If the district court did not grant an injunction, Audi would be irreparably harmed by consumers on D’Amato’s site purchasing counterfeit items, instead of those that were lawfully sold by Audi. So long as *www.audisport.com* stayed online, there was potential for future harm, and therefore, there was no adequate remedy at law.”).

The Eleventh Circuit appears poised to align itself with the Ninth Circuit. It has noted, in *dicta*, that “a strong case can be made” that *eBay*’s holding “necessarily extends to the grant of preliminary injunctions under the Lanham Act.” *N. Am. Med. Corp. v. Axiom Worldwide, Inc.*, 522 F.3d 1211, 1228 (11th Cir. 2008). The court, however, has declined to decide the issue. *Id.* (“[W]e decline to decide whether

the district court was correct in its holding that the nature of the trademark infringement gives rise to a presumption of irreparable injury. In other words, we decline to address whether such a presumption is the equivalent of the categorical rules rejected by the Court in *eBay*.”).

In sum, the Ninth Circuit has created a Circuit split, and it is deepening. The next court to decide the issue likely will be the Third Circuit, where it has been briefed and argued. *See Ferring Pharm. Inc. v. Watson Pharm., Inc.*, Case No. 13-2290 (3d Cir.) (argued Feb. 12, 2014).

The split results in inconsistency in the administration of federal trademark law. HRE should be able to protect The Platters the same way in circuits throughout the country. *See Lexmark Int’l, Inc. v. Static Control Components, Inc.*, Case No. 12-873, 2014 WL 1168967, 134 S. Ct. 1377 (Mar. 25, 2014) (granting certiorari to resolve standing to bring a false advertising claim under the Lanham Act); *TrafFix Devices v. Mktg. Displays*, 532 U.S. 23 (2001) (granting certiorari to resolve a circuit split concerning Lanham Act trade dress protection). The division among circuits is irreconcilable and can only be resolved by this Court. Without a prompt resolution imposing a uniform standard, trademark holders cannot receive fair and equal treatment across the country, and litigation abounds as district courts and appellate courts around the country guess which interpretation this Court will adopt.

### **3. District Court Litigation, Often on Hurried Records, Illustrates the Extent of the Need for This Court's Guidance**

The tension among the courts of appeals is reflected in the lower courts, where it arises frequently. Petitioner has surveyed reported district court preliminary injunction trademark cases after *eBay*. The results – 157 cases – are summarized at Pet. App. 80-95. They show that district courts are divided on how to apply *eBay* and *Winter*. At least 15 agree with the Ninth Circuit's approach below, that additional evidence of actual harm is required even after a showing of likelihood of success on the merits. Another 102 have concluded that the evidence that establishes likelihood of success can also be used to establish irreparable injury. And 40 hold *eBay* does not preclude courts from applying a presumption in trademark cases that likelihood of success on the merits establishes irreparable injury.

Application of different standards depending solely on the happenstance of where the court happens to sit is untenable, but there are additional reasons compelling this Court's involvement. Preliminary injunction proceedings in trademark cases often must be brought quickly – well before there is time for customer surveys or other opportunity to develop evidence of actual harm. These proceedings involve discovery of counterfeit goods at trade shows, learning of concerts at conventions or casinos, and uncovering misleading internet advertising. The trademark owners need to bring the issues quickly to district

court to consider whether the sales by alleged infringers should be stopped on a preliminary basis, pending a hearing on the merits after discovery, to protect goodwill and further the public policy against customer confusion. *See Univ. of Texas v. Camenisch*, 451 U.S. 390, 395 (1981) (“The purpose of a preliminary injunction is merely to preserve the relative positions of the parties until a trial on the merits can be held. Given this limited purpose, and given the haste that is often necessary if those positions are to be preserved, a preliminary injunction is customarily granted on the basis of procedures that are less formal and evidence that is less complete than in a trial on the merits. A party thus is not required to prove his case in full at a preliminary-injunction hearing.”).

This is not to say that preliminary injunction standards should be relaxed in trademark cases. But if Petitioner is correct that the Ninth Circuit and other district courts are improperly reading *eBay* to impose an unnecessary standard of irreparable harm in trademark cases – since the evidence to establish likelihood of success does double duty and also can establish irreparable harm – the cost is high.

Indeed, this is an area of law with significant importance to American commerce, as Congress and this Court have recognized. “National protection of trademarks is desirable, Congress concluded, because trademarks foster competition and the maintenance of quality by securing to the producer the benefits of good reputation.” *Park ’N Fly*, 469 U.S. at 198, citing

S. Rep. No. 1333, 79th Cong., 2d Sess., 3-5 (1946) (citations omitted). The Court should step in to provide a definitive resolution to this important legal issue, and enable holders of trademarks to receive fair and uniform treatment by federal courts throughout the country.

#### **4. Likely Irreparable Injury May Be Established From the Same Evidence as Likely Success on the Merits**

In trademark infringement cases, the criteria for determining likelihood of success on the merits and likely irreparable harm are generally the same. For both, the plaintiff must establish its likely right to control the mark and the goodwill that flows from it, and the defendant's use of a mark sufficiently similar that it is likely to confuse the public into believing the defendant's product is the plaintiff's. As explained by a leading treatise,

. . . where there is a substantial probability of confusion because of defendant's use of the same or a confusingly similar trademark, irreparable injury ordinarily follows.

3 Jerome Gilson, *et al.*, TRADEMARK PROTECTION AND PRACTICE § 8.07[1] at 8-150 (Matthew Bender) (2002); 11A Charles Alan Wright, Arthur R. Miller & Mary Kay Kane, FEDERAL PRACTICE AND PROCEDURE § 2948.1 at 166 (3d ed. 2013) ("In trademark-infringement cases, a showing of 'likelihood of confusion' between trademarks suffices to establish both

irreparable injury and likelihood of success on the merits.”).

By itself, “a lack of control over the use of one’s own mark amounts to irreparable harm.” *Times Mirror Magazines, Inc. v. Las Vegas Sports News L.L.C.*, 212 F.3d 157, 160-61 (3d Cir. 2000); *Powertest Petroleum Distribs., Inc. v. Calcu Gas, Inc.*, 754 F.2d 91 (2d Cir. 1985) (irreparable injury stems from plaintiff’s loss of control over reputation of trademark). Profits and sales are lost when customers buy the infringing product instead of the legitimate one when confused into believing it is authentic. But the extent of such lost sales and profits because of infringement is ordinarily quite difficult to prove, especially when the defendant enjoyed no profits or may not be financially able to satisfy a damage award. Indeed, recognizing that such proof “as often as not [is] impossible to sustain,” Congress and this Court have placed the burden on “the infringer to prove that his infringement had no cash value in sales made by him” in the damages phase of a trademark infringement case. *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 206-07 (1942).

On the other hand, “[d]amage to intangible values such as reputation and goodwill can never be accurately ascertained.” 3 TRADEMARK PROTECTION AND PRACTICE § 8.07[1] at 8-151; 11A FEDERAL PRACTICE AND PROCEDURE § 1948.1 at 152 (“Injury to reputation or goodwill is not easily measurable in monetary terms, and so often is viewed as irreparable.”). *See Newark*

*Morning Ledger Co. v. United States*, 507 U.S. 546, 556 (1993) (“[T]he shorthand description of goodwill as ‘the expectancy of continued patronage,’ *Boe v. Commissioner*, 307 F.2d 339, 343 (CA9 1962), provides a useful label with which to identify the total of all the imponderable qualities that attract customers to the business.”).

For years, courts analyzed this overlap of proof by employing a rebuttable presumption that a showing of likelihood of success on the merits meant that the plaintiff was likely to suffer irreparable injury without injunctive relief. 3 GILSON ON TRADEMARKS § 14.02[3][b] at 14-16-17. The presumption may have derived from an old case from this Court, where it stated:

If a plaintiff has the absolute right to the use of a particular word or words as a trademark, then, if an infringement is shown, the wrongful or fraudulent intent is presumed, and although allowed to be rebutted in exemption of damages, the further violation of the right of property will nevertheless be restrained.

*Elgin Nat'l Watch Co. v. Illinois Watch Case Co.*, 179 U.S. 665, 674 (1901). Today, the presumption is reflective of the sliding scale of proof discussed by Justice Ginsberg in *Winter*:

Consistent with equity's character, courts do not insist that litigants uniformly show a particular, predetermined quantum of probable success or injury before awarding equitable relief. Instead, courts have evaluated

claims for equitable relief on a “sliding scale,” sometimes awarding relief based on a lower likelihood of harm when the likelihood of success is very high. 11A C. Wright, A. Miller, & M. Kane, *Federal Practice and Procedure* § 2948.3, p. 195 (2d ed. 1995). This Court has never rejected that formulation, and I do not believe it does so today.

*Winter*, 555 U.S. at 51 (Ginsberg, J., dissenting). It is also consistent with the Court’s recognition that “[w]here unfair competition is established, any doubts as to the adequacy of the relief are generally resolved against the transgressor. *Champion Spark Plug Co. v. Sanders*, 331 U.S. 125, 130 (1947) citing *William R. Warner & Co. v. Eli Lilly & Co.*, 265 U.S. 526, 531-32 (1924) (“The charge of unfair competition being established, it follows that equity will afford relief by injunction to prevent such unfair competition for the future.”).

The Court’s historic trademark infringement opinions addressing preliminary injunctions demonstrate concern to protect the owner’s reputation and goodwill whenever an infringer markets confusingly similar products. *See, e.g., A. Bourjois & Co. v. Katzel*, 260 U.S. 689, 692 (1923) (“the monopoly of a trade mark . . . deals with a delicate matter that may be of great value but that easily is destroyed, and therefore should be protected with corresponding care.”); *Hanover Star Milling Co.*, 240 U.S. at 423 (competitor’s packaging so closely resembled plaintiff’s that it manifested a purpose to take advantage of plaintiff’s

reputation and to in fact deceive the ordinary and casual purchaser); *see also Am. Steel Foundries v. Robertson*, 269 U.S. 372, 381 (1925) (“The general doctrine is that equity not only will enjoin the appropriation and use of a trade-mark or trade-name where it is completely identical with the name of the corporation, but will enjoin such appropriation and use where the resemblance is so close as to be likely to produce confusion as to such identity, to the injury of the corporation to which the name belongs.”).

The import of these decisions is that evidence showing that two marks are identical or confusingly similar is evidence that continued use by one will irreparably harm the other by impairing the authentic owner’s goodwill. That principle has been lost by the Ninth Circuit by extending legal standards developed in copyright and patent cases to trademarks simply because they all are categorized as “intellectual property.” The Ninth Circuit, and other circuits and district courts, are in need of guidance.

## **5. The Ninth Circuit Erred in This Case**

In this case, HRE presented evidence that proved:

- HRE’s ownership of a valid, protectable mark in The Platters, and Respondents’ use of a confusingly similar mark – The Platters. Pet. App. 47-62. Respondents contested neither finding on appeal except by asserting the defenses of abandonment and laches, which they failed to prove. Pet. App. 16-19.

- The Platters is a famous mark with associated goodwill. Pet. App. 3-5, 26-29, 55-56.

- Both HRE and Respondents “purport to be the modern iteration of the original Platters,” and both “advertise themselves as the authentic Platters group” through “nearly identical” marketing channels. Pet. App. 61.

- A typical patron at a live performance of either party’s group would not know whether he was purchasing tickets to HRE’s group or Respondents’ group when buying tickets to a Platters show. Pet. App. 58.

From this evidence, the district court found that “[t]he goodwill associated with the original ‘The Platters’ mark will continue to be diluted if [Respondents are] allowed to promote [their] imitation group in Las Vegas and around the nation . . . As this Court and other courts have found, ‘The Platters’ mark is a strong mark imbued with a significant amount of goodwill due to the band’s fame and continuing popularity and ubiquity of many Platters hits. Unauthorized use by copycat groups dilutes the goodwill surrounding the original Platters band.” Pet. App. 66-67.

This evidence was not “cursory and conclusory,” in the words of the Ninth Circuit. Pet. App. 22. Holding that more evidence is necessary to establish that irreparable injury is likely sets the wrong precedent for the multitude of trademark infringement preliminary injunction hearings that district courts regularly

conduct. In many instances, it may create a bar that cannot be reached, resulting in the continued harm to a trademark owner and the public for years while infringing activity continues pending final resolution. The Ninth Circuit's decision also conflicts with the precedent in other circuits, and is a matter of serious importance to the business community.



## CONCLUSION

For the reasons set forth above, the petition for a writ of certiorari should be granted.

Respectfully submitted,

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**FOR PUBLICATION**  
**UNITED STATES COURT OF APPEALS**  
**FOR THE NINTH CIRCUIT**

HERB REED ENTERPRISES, LLC,  
a Massachusetts company,  
*Plaintiff-counter-defendant-*  
*Appellee,*

v.

FLORIDA ENTERTAINMENT  
MANAGEMENT, INC., a Nevada  
company; LARRY MARSHAK,  
*Defendants-counter-claimants-*  
*Appellants.*

No. 12-16868

D.C. No.  
2:12-cv-00560-  
MMD-GWF

OPINION

Appeal from the United States District Court  
for the District of Nevada  
Miranda Du, District Judge, Presiding

Argued and Submitted  
March 12, 2013 – San Francisco, California

Filed December 2, 2013

Before: J. Clifford Wallace, M. Margaret McKeown,  
and Sandra S. Ikuta, Circuit Judges.

Opinion by Judge McKeown;  
Concurrence by Judge Wallace

**SUMMARY\***

**Trademark/Preliminary Injunction**

Reversing the district court’s grant of a preliminary injunction against defendants’ use of the mark “The Platters” in connection with a vocal group, the panel held that the likelihood of irreparable harm must be established, rather than presumed, by a plaintiff seeking injunctive relief in the trademark context.

The panel affirmed the district court’s holding that earlier New York actions did not have res judicata effect. The panel also held that the plaintiff was not barred by laches from challenging defendants’ use of the mark.

As to the plaintiff’s likelihood of success on the trademark infringement claim, the panel held that the district court did not err in concluding that the defendants failed to meet their burden of strictly proving the affirmative defense of trademark abandonment.

The panel held that in light of *eBay v. MercExchange, LLC*, 547 U.S. 388 (2006), and *Winter v. Natural Res. Def. Council, Inc.*, 555 U.S. 7 (2008), a plaintiff seeking a preliminary injunction in a trademark infringement case must establish irreparable

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\* This summary constitutes no part of the opinion of the court. It has been prepared by court staff for the convenience of the reader.

harm. The panel concluded that even though the district court identified the correct legal principle, the record did not support a determination of the likelihood of irreparable harm.

Concurring, Judge Wallace agreed that the district court's preliminary injunction should be reversed. He wrote separately to emphasize that the panel was solely reviewing a preliminary injunction and thus could express no views on issues arising after a trial dealing with a permanent injunction.

### **COUNSEL**

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### **OPINION**

McKEOWN, Circuit Judge:

“The Platters” – the legendary name of one of the most successful vocal performing groups of the 1950s – lives on. With 40 singles on the Billboard Hot 100 List, the names of The Platters' hits ironically foreshadowed decades of litigation – “Great Pretender,”

“Smoke Gets In Your Eyes,” “Only You,” and “To Each His Own.” Larry Marshak and his company Florida Entertainment Management, Inc. (collectively “Marshak”) challenge the district court’s preliminary injunction in favor of Herb Reed Enterprises (“HRE”), enjoining Marshak from using the “The Platters” mark in connection with any vocal group with narrow exceptions. We consider an issue of first impression in our circuit: whether the likelihood of irreparable harm must be established – rather than presumed, as under prior Ninth Circuit precedent – by a plaintiff seeking injunctive relief in the trademark context. In light of Supreme Court precedent, the answer is yes, and we reverse the district court’s order granting the preliminary injunction.

#### **BACKGROUND**

The Platters vocal group was formed in 1953, with Herb Reed as one of its founders. Paul Robi, David Lynch, Zola Taylor, and Tony Williams, though not founders, have come to be recognized as the other “original” band members. The group became a “global sensation” during the latter half of the 1950s,<sup>1</sup> then broke up in the 1960s as the original members left one by one. After the break up, each member continued to perform under some derivation of the name

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<sup>1</sup> *The Platters Biography*, ROCK & ROLL HALL OF FAME, <http://rockhall.com/inductees/the-platters/bio/> (last visited June 27, 2013).

“The Platters.” *Marshak v. Reed*, No. 96 CV 2292(NG)(MLO), 2001 WL 92225, at \*4 (E.D.N.Y. and S.D.N.Y. Feb. 1, 2001) (“*Marshak I*”).

Litigation has been the byproduct of the band’s dissolution; there have been multiple legal disputes among the original members and their current and former managers over ownership of “The Platters” mark. Much of the litigation stemmed from employment contracts executed in 1956 between the original members and Five Platters, Inc. (“FPI”), the company belonging to Buck Ram, who became the group’s manager in 1954. As part of the contracts, each member assigned to FPI any rights in the name “The Platters” in exchange for shares of FPI stock. *Marshak I*, 2001 WL 92225, at \*3. According to *Marshak*, FPI later transferred its rights to the mark to Live Gold, Inc., which in turn transferred the rights to *Marshak* in 2009. Litigation over the validity of the contracts and ownership of the mark left a trail of conflicting decisions in various jurisdictions, which provide the backdrop for the present controversy. What follows is a brief summary of the tangled web of multi jurisdictional litigation that spans more than four decades.

In 1972, FPI sued Robi and Taylor for trademark infringement in California, resulting in a 1974 judgment in Robi’s favor, which held that FPI “was a sham used by Mr. Ram to obtain ownership of the name ‘Platters.’” *Robi v. Five Platters, Inc.*, 838 F.2d 318, 320 (9th Cir. 1988) (“*Robi I*”) (quoting the 1974 decision). By contrast, an analogous dispute between

FPI and Williams in New York resulted in a 1982 decision holding that FPI had lawfully acquired exclusive ownership of the name. *Marshak I*, 2001 WL 92225, at \*7 (citing the 1982 decision). Williams attempted to circumvent the New York decision by seeking declaratory judgment in the Central District of California based on the 1974 judgment in favor of Robi. He was ultimately unsuccessful; on appeal, we reasoned that Williams could not avoid the claim preclusive effect of the New York judgment by relying on issue preclusion from another case in which he was not a party. *Robi I*, 838 F.2d at 328. We upheld the judgment in favor of Robi, *id.* at 330, and later affirmed the district court's award of compensatory and punitive damages to Robi as well as its cancellation of FPI's three registered trademarks using the words "The Platters." *Robi v. Five Platters, Inc.*, 918 F.2d 1439, 1441 (9th Cir. 1990) ("*Robi II*").

In 1984, FPI sued Reed for trademark infringement in the Southern District of Florida. *Marshak I*, 2001 WL 92225, at \*9. The court denied Reed's motion for summary judgment based on the preclusive effect of the 1974 California judgment against FPI. *Id.* Preferring to avoid trial, Reed signed a court-approved stipulation of settlement in 1987, under which he assigned to FPI all rights he had in FPI stock, retained the right to perform as "Herb Reed and the Platters," and agreed not to perform under the name "The Platters." However, the settlement included an "escape clause":

In the event that a court of competent jurisdiction enters a final order with all appeals being exhausted that provides that The Five Platters, Inc. has no right in the name “The Platters,” then nothing contained herein shall be construed to limit Herbert Reed’s rights in the name “The Platters” and this agreement shall not inure to any party other than The Five Platters, Inc., and its successors and assigns or Herbert Reed.

A key question is whether the escape clause has now been triggered.

In 2001, Marshak, FPI, and other plaintiffs sued Reed and others for trademark infringement in the Eastern District of New York; Reed counterclaimed, also alleging trademark infringement. *Marshak I*, 2001 WL 92225, at \*1. The court interpreted the 1987 settlement as “barr[ing] Reed from asserting that he has any right to the name ‘The Platters’ as against FPI or those claiming through FPI except as specifically allowed in that agreement, or from otherwise interfering with plaintiffs’ rights to the use of ‘The Platters.’” *Id.* at \*15. The court determined that the settlement’s escape clause had not been triggered either by Robi I, because the Ninth Circuit reversed the judgment in favor of Williams indicating that FPI still had some rights to “The Platters” mark, or by Robi II, because cancellation of FPI’s federal mark registration did not resolve the question whether FPI was entitled to use the name “The Platters.” *Id.* at \*19-20. The district court enjoined Reed from, among other things, interfering with FPI and Marshak’s use

of the name “The Platters” except as permitted in the 1987 settlement (“the 2001 injunction”). *Id.* at \*21. The Second Circuit affirmed. *Marshak v. Reed*, 13 F. App’x 19 (2d Cir. 2001).

Reed appealed *Marshak I* a second time on the basis that an unpublished Ninth Circuit memorandum issued around the same time triggered the 1987 settlement’s escape clause.<sup>2</sup> The Second Circuit vacated and remanded *Marshak I*, *Marshak v. Reed*, 34 F. App’x 8 (2d Cir. 2002), but later affirmed the district court’s decision to adhere to its earlier decisions because the Ninth Circuit memorandum left “open the possibility, however remote, that FPI can establish a common law trademark right to the name ‘The Platters.’” *Marshak II*, 329 F. Supp. 2d at 185, *aff’d*, *Marshak v. Reed*, 87 F. App’x 208 (2d Cir. 2004).

HRE, which manages Reed’s business affairs and holds his rights, sued FPI and other defendants for trademark infringement in the District of Nevada in 2010. To get around the restrictions in the 1987

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<sup>2</sup> The memorandum held that FPI and other plaintiffs “cannot assert a common law trademark in ‘The Platters’” unless they “present evidence that they used the trademark in a way that was not false and misleading.” *Five Platters, Inc. v. Powell*, 7 F. App’x 794, 795 (9th Cir. 2001). The case was remanded for an evidentiary hearing, although the disposition noted that FPI was “unlikely” to be able to make the required showing. *Id.* & n.6. On remand FPI abandoned the trademark claim and the evidentiary hearing never occurred. *Marshak v. Reed*, 229 F. Supp. 2d 179, 182 n.2, 184-85 (E.D.N.Y. 2002) (“*Marshak II*”) (describing the remand).

settlement, HRE creatively alleged that it owned the “Herb Reed and the Platters” mark and that defendants used a confusingly similar mark, namely “The Platters.” *Herb Reed Enters., Inc. v. Bennett*, No. 2:10-CV-1981 JCM (RJJ), 2011 WL 220221, at \*1 (D. Nev. Jan. 21, 2011). FPI was not represented – according to Marshak, FPI was by this time a defunct corporation that had already transferred and no longer owned any rights to “The Platters” mark. The action resulted in a 2011 default judgment and permanent injunction declaring that (1) FPI “never used the mark ‘The Platters’ in a manner that [was] not false and misleading and thus never acquired common law rights to the mark,” and (2) “Reed, having first used the mark ‘The Platters’ in commerce in 1953, and having continuously used the mark in commerce since then has superior rights to the mark to all others,” including FPI and “anyone claiming rights from or through” FPI. *Herb Reed Enters., Inc. v. Monroe Powell’s Platters, LLC*, 842 F. Supp. 2d 1282, 1287 (D. Nev. 2012) (quoting the 2011 judgment).

In 2012, HRE successfully obtained a preliminary injunction against Monroe Powell, FPI’s former performer employee, and his company in a trademark infringement action in the District of Nevada. *Id.* at 1284. Because Powell claimed to have acquired rights to “The Platters” mark through FPI, there was a question as to whether the 1987 settlement limited Reed’s ability to pursue a remedy. The district court held that, “even assuming that the 1987 stipulation applies, the escape clause has been triggered and no

longer bars Reed from suing FPI or those claiming through FPI for trademark infringement.” *Id.* at 1288. The court reasoned that the 2011 Nevada default judgment, which “determined that FPI ‘has no right in the name “The Platters’” as required by the 1987 stipulation,” was “a final order with all appeals being exhausted” because the judgment was never appealed. *Id.* at 1288-89 (quoting the 2011 judgment).

In the period between the filing of the two Nevada actions, Marshak sued Reed for civil contempt in the Eastern District of New York, alleging that Reed’s first Nevada lawsuit violated the 2001 injunction. *Marshak v. Reed*, Nos. 96-CV-2292 (NG)(RML), 11-CV-2582 (NG)(RML), 2012 WL 832269 (E.D.N.Y. Mar. 12, 2012). The court denied Marshak’s motion, holding that neither Reed’s use of the mark “Herb Reed and the Platters” nor Reed’s suit in Nevada protecting that mark constituted a violation of the injunction. *Id.* at \*3-5.

Last year brought yet another lawsuit. HRE commenced the present litigation in 2012 against Marshak in the District of Nevada, alleging trademark infringement and seeking a preliminary injunction against Marshak’s continued use of “The Platters” mark. The district court held that HRE was not precluded from asserting a right in “The Platters” mark either by the 1987 settlement – the escape clause of which had been triggered by the 2011 Nevada default judgment – or by the equitable doctrine of laches. *Herb Reed Enters., LLC v. Fla. Entm’t Mgmt., Inc.*, No. 2:12-cv-00560-MMD-GWF, 2012 WL

3020039, at \*8 (D. Nev. Jul. 24, 2012). The district court found that HRE had established a likelihood of success on the merits, a likelihood of irreparable harm, a balance of hardships in its favor, and that a preliminary injunction would serve public interest. *Id.* at \*8-17. Accordingly, the district court granted the preliminary injunction and set the bond at \$10,000. *Id.* at \*19. Marshak now appeals from the preliminary injunction.

## ANALYSIS

### I. RES JUDICATA

As an initial matter, we address whether HRE is foreclosed from bringing the underlying suit by the New York actions, *Marshak I* and *Marshak II*, which resulted in the 2001 injunction barring Reed from interfering with Marshak's use of "The Platters" mark except as permitted by the 1987 settlement. The district court correctly held that the New York actions do not have res judicata effect.

This action is neither barred by claim preclusion, which prohibits "the parties or their privies from relitigating issues that were or could have been raised" in an action resulting in "[a] final judgment on the merits," *Federated Department Stores, Inc. v. Moitie*, 452 U.S. 394, 398 (1981), nor by issue preclusion, which prohibits "successive litigation of an issue of fact or law actually litigated and resolved in a valid court determination essential to the prior judgment," *New Hampshire v. Maine*, 532 U.S. 742, 748-49

(2001). HRE is not “relitigating issues that were or could have been raised” in the New York actions because HRE could not assert its right in “The Platters” name at that time. As the 2001 injunction confirmed, Herb Reed was then bound by the 1987 settlement, and the escape clause had not yet been triggered. Additionally, the New York actions did not come to a final judgment on the merits of the trademark dispute. Instead, the Eastern District of New York enjoined Reed from pursuing that litigation on the merits because of the 1987 settlement. The New York cases thus do not have res judicata effect on either the issue of whether the much later Nevada actions triggered the escape clause, or the issue of trademark ownership, both of which relate to this appeal.

Marshak quibbles with the district court’s reliance on the res judicata effect of the Nevada actions – the 2011 default judgment against FPI and the 2012 preliminary injunction against Powell. But the district court explicitly declined to use the 2011 default judgment as offensive collateral estoppel against Marshak on the issue of trademark ownership. *HRE*, 2012 WL 3020039, at \*7-8. While the district court referenced the “last in time rule” to resolve any contradiction between the New York actions and the Nevada actions as to whether the 1987 settlement’s escape clause has been triggered, *HRE*, 2012 WL 3020039, at \*7, such reliance was unnecessary. The language of the escape clause itself is sufficient and does not limit the type of action or who may bring an

action that ultimately results in “a final order with all appeals being exhausted that provides that [FPI] has no right in the name ‘The Platters.’” Thus, Marshak’s complaint that he was not a party to the 2011 default judgment has no traction. Given that there is now a valid judgment with all appeals exhausted declaring that FPI never acquired common law rights to “The Platters” mark, the escape clause has been triggered on its own terms, and HRE is no longer bound by the settlement’s restrictions or the 2001 injunction enforcing the settlement.

## II. LACHES

Next, we consider whether HRE is barred from challenging Marshak’s use of “The Platters” mark by laches – “an equitable time limitation on a party’s right to bring suit, resting on the maxim that one who seeks the help of a court of equity must not sleep on his rights.” *Jarrow Formulas, Inc. v. Nutrition Now, Inc.*, 304 F.3d 829, 835 (9th Cir. 2002) (internal quotation marks and citations omitted). The district court properly determined that laches does not foreclose this suit.

The time gap from when HRE “knew or should have known about its potential cause of action” to when it filed its action was not long enough to be unreasonable. *Id.* at 838. HRE could not bring the trademark infringement suit until there was a final ruling with all appeals exhausted that triggered the escape clause. That ruling came in the Nevada

default judgment in May 2011.<sup>3</sup> HRE brought this action in April 2012, less than a year after the escape clause was triggered, and less than one month after the Eastern District of New York determined that HRE had not violated that court's 2001 injunction. *HRE*, 2012 WL 3020039, at \*8. This delay of under one year is shorter than the most analogous state statute of limitations period, giving rise to a strong presumption against laches. *Jarrow Formulas*, 304 F.3d at 837 (“[W]e hold that if a [Lanham Act] § 43(a) claim is filed within the analogous state limitations period, the strong presumption is that laches is inapplicable. . . .”). Marshak agrees that the limitations period from the most analogous action under state law is three years under Nevada's fraud and “catchall” statute of limitations. Nev. Rev. Stat. § 11.190(3). Because HRE brought its trademark infringement claim well within three years, we presume that laches is inapplicable. HRE simply did not dally or unconscionably sit on its claim. Thus, laches does not preclude consideration of HRE's trademark infringement claim and request for preliminary injunction.

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<sup>3</sup> Marshak's argument that HRE should have acted sooner to trigger the escape clause instead of waiting years until after FPI had become a defunct entity is inapposite. Marshak essentially seeks a roundabout way to raise a laches defense in a separate action – HRE's 2010 suit against FPI and others in the District of Nevada – that has already been decided and is not before this court. That argument should have been raised in a timely appeal of the 2011 default judgment.

### III. PRELIMINARY INJUNCTION

To obtain a preliminary injunction, HRE “must establish that [it] is likely to succeed on the merits, that [it] is likely to suffer irreparable harm in the absence of preliminary relief, that the balance of equities tips in [its] favor, and that an injunction is in the public interest.” *Winter v. Natural Res. Def. Council, Inc.*, 555 U.S. 7, 20 (2008). We review a district court’s preliminary injunction for abuse of discretion, a standard of review that is “limited and deferential.” *Johnson v. Couturier*, 572 F.3d 1067, 1078 (9th Cir. 2009). If the district court “identified and applied the correct legal rule to the relief requested,” we will reverse only if the court’s decision “resulted from a factual finding that was illogical, implausible, or without support in inferences that may be drawn from the facts in the record.” *United States v. Hinkson*, 585 F.3d 1247, 1263 (9th Cir. 2009) (en banc).

Marshak’s key arguments are that the district court erred in concluding that HRE had established a likelihood of success on the merits because Reed abandoned “The Platters” mark and that the district court erred in finding a likelihood of irreparable harm.

#### A. LIKELIHOOD OF SUCCESS ON THE UNDERLYING TRADEMARK DISPUTE

As to its trademark infringement claim, to establish a likelihood of success on the merits HRE must

show that it is “(1) the owner of a valid, protectable mark, and (2) that the alleged infringer is using a confusingly similar mark.” *Grocery Outlet, Inc. v. Albertson’s, Inc.*, 497 F.3d 949, 951 (9th Cir. 2007) (per curiam). Tellingly, Marshak does not challenge the district court’s conclusions on these two points,<sup>4</sup> except by asserting the affirmative defense of abandonment on the alleged basis that Reed abandoned “The Platters” mark by signing the 1987 Florida settlement. But “[a]bandonment of a trademark, being in the nature of a forfeiture, must be strictly proved.” *Prudential Ins. Co. of Am. v. Gibraltar Fin. Corp. of Cal.*, 694 F.2d 1150, 1156 (9th Cir. 1982). The district court did not err in concluding that Marshak failed to meet that burden.

Marshak has not established either of the two requirements of abandonment under 15 U.S.C. § 1127: (1) discontinuance of trademark use, and (2) intent not to resume use. Although non-use for three consecutive years constitutes prima facie evidence of

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<sup>4</sup> Marshak does not dispute the district court’s finding that HRE is the senior user, or the district court’s reasoning invalidating Marshak’s claims of ownership. Nor does Marshak contest the district court’s determination that Marshak’s use of “The Platters” mark is confusingly similar to HRE’s use of both “The Platters” and “Herb Reed and the Platters” marks according to the Ninth Circuit’s test. See *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 & n.11 (9th Cir. 1979) (describing the factors relevant to determining whether the alleged infringer is using a confusingly similar mark), *abrogated in part on other grounds by Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 810 (9th Cir. 2003).

abandonment, the standard for non-use is high. *Id.* Non-use requires “*complete* cessation or discontinuance of trademark use,” where “use” signifies any use in commerce and “includes the placement of a mark on goods sold or transported.” *Electro Source, LLC v. Brandess-Kalt-Aetna Grp., Inc.*, 458 F.3d 931, 936, 938 (9th Cir. 2006) (emphasis in original). “Even a single instance of use is sufficient against a claim of abandonment of a mark if such use is made in good faith.” *Carter-Wallace, Inc. v. Procter & Gamble Co.*, 434 F.2d 794, 804 (9th Cir. 1970).

HRE presented evidence that, despite the 1987 settlement, it continued to receive royalties from the sale of The Platters’ previously recorded material. The district court permissibly relied on the declaration of HRE’s general manager that “[s]ince . . . approximately 1953, Reed continuously received royalties from Platters recordings, including during the time period after the 1987 Stipulation was signed and after the 2001 Injunction.” The declaration further indicates that HRE received and continues to receive royalties from domestic and international sales and names a range of companies that pay royalties for the use of The Platters’ original recordings in other compilations, television ads, movies, or other media. The receipt of royalties is a genuine but limited usage of the mark that satisfies the “use” requirement, especially when viewed within the totality of the circumstances – namely, that Reed was constrained by the settlement. *See Electro Source*, 458 F.3d at 940 (“Because the abandonment inquiry

is tied to the unique circumstances of each case, it is appropriate to look at the totality of the circumstances to determine if genuine, albeit limited, usage of the mark qualifies a trademark use ‘in the ordinary course of trade’ under § 1127.”); *see also Carter-Wallace*, 434 F.2d at 803-04 (holding that a mark had not been abandoned when the trademark holder offered a legitimate reason for making only nominal sales, namely waiting for trademark ownership issues to be fully litigated and resolved). Receipt of royalties certainly qualifies as placement of “The Platters” mark on goods sold, and supports the finding that there was no abandonment. *See Marshak v. Treadwell*, 240 F.3d 184, 199 (3d Cir. 2001) (“A successful musical group does not abandon its mark unless there is proof that the owner ceased to commercially exploit the mark’s secondary meaning in the music industry.”) (internal quotation marks and citation omitted).

We are not persuaded by Marshak’s view that HRE’s receipt of royalties violated the 1987 settlement and thus is not a “bona fide use” under 15 U.S.C. § 1127, capable of obviating abandonment. It is far from clear that the 1987 settlement, which focused on “the right to perform or entertain” and explicitly excluded “commercial recordings,” forbade HRE from collecting royalties on previously recorded material. Additionally, when Marshak sued Reed for civil contempt alleging that Reed had violated the 2001 injunction enforcing the 1987 settlement, Marshak “[d]id not contest that Reed was entitled to

such royalties,” and the Eastern District of New York held that there was not sufficient evidence “that Reed used ‘The Platters’ mark in a manner inconsistent with the 2001 Injunction.” *Marshak*, 2012 WL 832269, at \*3.

We conclude that the record supports the district court’s determination that HRE did not abandon “The Platters” mark.

### **B. LIKELIHOOD OF IRREPARABLE HARM**

We next address the likelihood of irreparable harm. As the district court acknowledged, two recent Supreme Court cases have cast doubt on the validity of this court’s previous rule that the likelihood of “irreparable injury may be *presumed* from a showing of likelihood of success on the merits of a trademark infringement claim.” *Brookfield Commc’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1066 (9th Cir. 1999) (emphasis added). Since *Brookfield*, the landscape for benchmarking irreparable harm has changed with the Supreme Court’s decisions in *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, in 2006, and *Winter* in 2008.

In *eBay*, the Court held that the traditional four-factor test employed by courts of equity, including the requirement that the plaintiff must establish irreparable injury in seeking a permanent injunction, applies in the patent context. 547 U.S. at 391. Likening injunctions in patent cases to injunctions under the Copyright Act, the Court explained that it

“has consistently rejected . . . a rule that an injunction automatically follows a determination that a copyright has been infringed,” and emphasized that a departure from the traditional principles of equity “should not be lightly implied.” *Id.* at 391-93 (citations omitted). The same principle applies to trademark infringement under the Lanham Act. Just as “[n]othing in the Patent Act indicates that Congress intended such a departure,” so too nothing in the Lanham Act indicates that Congress intended a departure for trademark infringement cases. *Id.* at 391-92. Both statutes provide that injunctions may be granted in accordance with “the principles of equity.” 35 U.S.C. § 283; 15 U.S.C. § 1116(a).

In *Winter*, the Court underscored the requirement that the plaintiff seeking a preliminary injunction “demonstrate that irreparable injury is *likely* in the absence of an injunction.” 555 U.S. at 22 (emphasis in original) (citations omitted). The Court reversed a preliminary injunction because it was based only on a “possibility” of irreparable harm, a standard that is “too lenient.” *Id.* *Winter*’s admonition that irreparable harm must be shown to be likely in the absence of a preliminary injunction also forecloses the presumption of irreparable harm here.

Following *eBay* and *Winter*, we held that likely irreparable harm must be demonstrated to obtain a preliminary injunction in a copyright infringement case and that actual irreparable harm must be demonstrated to obtain a permanent injunction in a trademark infringement action. *Flexible Lifeline Sys.*

*v. Precision Lift, Inc.*, 654 F.3d 989, 998 (9th Cir. 2011); *Reno Air Racing Ass’n, Inc., v. McCord*, 452 F.3d 1126, 1137-38 (9th Cir. 2006). Our imposition of the irreparable harm requirement for a permanent injunction in a trademark case applies with equal force in the preliminary injunction context. *Amoco Prod. Co. v. Village of Gambell, AK*, 480 U.S. 531, 546 n.12 (1987) (explaining that the standard for a preliminary injunction is essentially the same as for a permanent injunction except that “likelihood of” is replaced with “actual”). We now join other circuits in holding that the *eBay* principle – that a plaintiff must establish irreparable harm – applies to a preliminary injunction in a trademark infringement case. See *N. Am. Med. Corp. v. Axiom Worldwide, Inc.*, 522 F.3d 1211, 1228-29 (11th Cir. 2008); *Audi AG v. D’Amato*, 469 F.3d 534, 550 (6th Cir. 2006) (applying the requirement to a permanent injunction in a trademark infringement action).

Having anticipated that the Supreme Court’s decisions in *eBay* and *Winter* signaled a shift away from the presumption of irreparable harm, the district court examined irreparable harm in its own right, explaining that HRE must “establish that remedies available at law, such as monetary damages, are inadequate to compensate” for the injury arising from Marshak’s continuing allegedly infringing use of the mark. *HRE*, 2012 WL 3020039, at \*15. Although the district court identified the correct legal principle, we conclude that the record does not

support a determination of the likelihood of irreparable harm.

Marshak asserts that the district court abused its discretion by relying on “unsupported and conclusory statements regarding harm [HRE] *might* suffer.” We agree.

The district court’s analysis of irreparable harm is cursory and conclusory, rather than being grounded in any evidence or showing offered by HRE. To begin, the court noted that it “cannot condone trademark infringement simply because it has been occurring for a long time and may continue to occur.” The court went on to note that to do so “could encourage wide-scale infringement on the part of persons hoping to tread on the goodwill and fame of vintage music groups.” Fair enough. Evidence of loss of control over business reputation and damage to goodwill could constitute irreparable harm. *See, e.g., Stuhlbarg Int’l Sales Co., Inc. v. John D. Brush and Co., Inc.*, 240 F.3d 832, 841 (9th Cir. 2001) (holding that evidence of loss of customer goodwill supports finding of irreparable harm). Here, however, the court’s pronouncements are grounded in platitudes rather than evidence, and relate neither to whether “irreparable injury is *likely* in the absence of an injunction,” *Winter*, 555 U.S. at 22, nor to whether legal remedies, such as money damages, are inadequate in this case. It may be that HRE could establish the likelihood of irreparable harm. But missing from this record is any such evidence.

In concluding its analysis, the district court simply cited to another district court case in Nevada “with a substantially similar claim” in which the court found that “the harm to Reed’s reputation caused by a different unauthorized Platters group warranted a preliminary injunction.” *HRE*, 2012 WL 3020039, at \*15-16. As with its speculation on future harm, citation to a different case with a different record does not meet the standard of showing “likely” irreparable harm.

Even if we comb the record for support or inferences of irreparable harm, the strongest evidence, albeit evidence not cited by the district court, is an email from a potential customer complaining to Marshak’s booking agent that the customer wanted Herb Reed’s band rather than another tribute band. This evidence, however, simply underscores customer confusion, not irreparable harm.<sup>5</sup>

The practical effect of the district court’s conclusions, which included no factual findings, is to reinsert

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<sup>5</sup> In assessing the evidence with respect to irreparable harm, we reject Marshak’s assertion that the district court may rely only on admissible evidence to support its finding of irreparable harm. Not so. Due to the urgency of obtaining a preliminary injunction at a point when there has been limited factual development, the rules of evidence do not apply strictly to preliminary injunction proceedings. *See Republic of the Philippines v. Marcos*, 862 F.2d 1355, 1363 (9th Cir. 1988) (“It was within the discretion of the district court to accept . . . hearsay for purposes of deciding whether to issue the preliminary injunction.”).

the now-rejected presumption of irreparable harm based solely on a strong case of trademark infringement. Gone are the days when “[o]nce the plaintiff in an infringement action has established a likelihood of confusion, it is ordinarily presumed that the plaintiff will suffer irreparable harm if injunctive relief does not issue.” *Rodeo Collection, Ltd. v. W. Seventh*, 812 F.2d 1215, 1220 (9th Cir. 1987) (citing *Apple Computer, Inc. v. Formula International Inc.*, 725 F.2d 521, 526 (9th Cir. 1984)). This approach collapses the likelihood of success and the irreparable harm factors. Those seeking injunctive relief must proffer evidence sufficient to establish a likelihood of irreparable harm. As in *Flexible Lifeline*, 654 F.3d at 1000, the fact that the “district court made no factual findings that would support a likelihood of irreparable harm,” while not necessarily establishing a lack of irreparable harm, leads us to reverse the preliminary injunction and remand to the district court.

In light of our determination that the record fails to support a finding of likely irreparable harm, we need not address the balance of equities and public interest factors.

**REVERSED and REMANDED.**

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WALLACE, Senior Circuit Judge, concurring:

I agree that the district court’s preliminary injunction should be reversed. However, I write separately to emphasize that we are solely reviewing

a *preliminary* injunction, and that we thus can express no view on issues arising after a trial dealing with a permanent injunction. *See, e.g., Barahona-Gomez v. Reno*, 167 F.3d 1228, 1234-35, 1238 (9th Cir. 1999) (stating that the court, in reviewing a preliminary injunction, “express[ed] no opinion on the ultimate merits of [the] action”).

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UNITED STATES DISTRICT COURT  
DISTRICT OF NEVADA

\* \* \*

HERB REED  
ENTERPRISES, LLC,  
A Massachusetts Company,  
Plaintiff,

v.

FLORIDA ENTERTAIN-  
MENT MANAGEMENT,  
INC., a Nevada Company,  
and LARRY MARSHAK  
an individual,  
Defendants.

Case No. 2:12-cv-  
00560-MMD-GWF

ORDER

(Filed Jul. 24, 2012)

(Plf 's Motion  
for Preliminary  
Injunction – dkt. no. 2)

(Defs' Objection to  
Plaintiff 's Supplement  
to Its Motion  
for a Preliminary  
Injunction – dkt. no. 35)

**I. INTRODUCTION**

The Platters “were one of the top vocal groups of the Fifties, delivering smooth, stylized renditions of pop standards.”<sup>1</sup> “During the latter half of the Fifties, the Platters were a global sensation, touring the world as international ambassadors of musical goodwill.”<sup>2</sup> Yet along with great fame often comes great hardship, and The Platters were no exception. For as long as The Platters have been famous, the right to

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<sup>1</sup> *The Platters Biography, Rock and Roll Hall of Fame*, <http://rockhall.com/inductees/the-platters/bio/>

<sup>2</sup> *Id.* (citations omitted).

the ownership and use of the band's legendary name has been litigated among band members, their manager and various parties. The last surviving member of The Platters passed away shortly after this lawsuit was filed, but the fight continues. In this case, the assignee of founding band member Herb Reed ask [sic] the Court to tell Defendants – who promote an unlicensed show featuring a group called The Platters – that “It Isn’t Right.”<sup>3</sup> Plaintiff asks that the Court answer Reed’s “Prayer,”<sup>4</sup> and hold that Defendants are a merely “Great Pretender”<sup>5</sup> while “Only You [Reed]” (“and [Reed] Alone”)<sup>6</sup> owns “The Platters” mark.

Before the Court are Plaintiff Herb Reed Enterprises, LLC’s (“HRE”) Motion for Preliminary Injunction (dkt. no. 2) and Defendants’ Objection to Plaintiff’s Supplement to Its Motion for a Preliminary Injunction (dkt. no. 35). The Court has also considered the relevant Oppositions and Replies to these Motions, as well as arguments presented by counsel at the hearing held on July 13, 2012.

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<sup>3</sup> The Platters, “It Isn’t Right” (1956).

<sup>4</sup> The Platters, “My Prayer” (1956).

<sup>5</sup> The Platters, “The Great Pretender.” (1955).

<sup>6</sup> The Platters, “Only You (and You Alone).” (1955).

## II. BACKGROUND

### A. Parties

Larry Marshak and his company Florida Entertainment Management, Inc. (“EnMan”) organize and promote live musical performances. (Dkt. no. 17 at ¶ 14.) One of his groups is called The Platters. In addition to The Platters, EnMan promotes groups performing as The Marvelettes and Cornell Gunter Coasters. (*Id.*) Since 2001, Marshak and his company have promoted and produced a show at the Rio Hotel in Las Vegas, Nevada using “The Platters” mark. (*Id.* at ¶ 16-17.) EnMan also books groups performing under “The Platters” mark in performances across the nation. (*Id.* at ¶ 23.)

Herbert “Herb” Reed founded the vocal performing group The Platters in 1953. At the time it achieved national recognition and success, the five members of the band (though not the five founding members of the group) were Reed, Paul Robi, David Lynch, Zola Taylor, and Tony Williams. These are the five members recognized in other related decisions as the “original members” of The Platters, and this Order also refers to them as the “original members” of the group. *See, e.g., Marshak v. Reed*, No. 96 CV 2292, 2001 WL 92225, at \*3, fn. 2 (E.D.N.Y. Feb. 1, 2001) *aff’d*, 13 F. App’x 19 (2d Cir. 2001) *and vacated in part*, 34 F. App’x 8 (2d Cir. 2002) (“*Marshak I*”). The Platters enjoyed great success during the 1950s and 1960s, with hit singles including, “Only You,” “The Great Pretender,” and “Smoke Gets in Your

Eyes.” *Id.* at \*3. The Platters were inducted into the Rock and Roll Hall of Fame in 1990 and received similar accolades throughout the 1990’s and early 2000’s. (Dkt. no. 3-9 at ¶ 8.) Their music remains popular today. The group continues to sell video recordings of old Platters’ performances. (Dkt. no. 3-9 at ¶22.) The Platters’ songs continue to be sold, played on the radio, and used in national television commercials. (*Id.* at ¶ 23.) Platters hits are also featured on over 80 movie sound-tracks, including *The Curious Case of Benjamin Button* and *Ocean’s Twelve*. (*Id.*)

The Platters broke up in the 1960s, and since then, as another court noted, the former band members have “spent more time in judicial venues than in musical ones.” *Marshak I*, 2001 WL 92225, at \*1. That was in 2001. This conclusion continues to ring true today as the litigation among those claiming ownership of “The Platters” trademark has persisted throughout the past decade.

Much of the litigation regarding ownership of “The Platters” trademark stems from a 1956 agreement between the original members of the group and their manager Buck Ram’s company, Five Platters, Inc. (“FPI”). Ram began managing The Platters in 1954. In 1956, all original members of the group executed employment contracts with FPI. “As part of those contracts, each of the performers assigned to FPI their rights in the name ‘The Platters,’ in exchange for the issuance of shares of stock in FPI.” *Marshak I*, 2001 WL 92225 at \*3.

Between 1962 and 1969, all of the original members of the band left The Platters, beginning with Tony Williams in 1962 and ending with Herb Reed in 1969. *Marshak I*, 2001 WL 92225, at \*4. However, “each of the original members, after leaving the group, also continued to perform under some derivation of the name ‘The Platters,’” and “[t]he legal battles began.” *Id.* Since the late 1960s, the questions of who can perform under the name “The Platters” and who owns “The Platters” trademark have been litigated multiple times in every decade, and resulted in what a 1987 New York court described as “a tangled web of litigation resulting in a number of inconsistent federal and state court decisions.” *FPI v. Williams*, 4 U.S.P.Q.2d 1296, 1297 (N.Y. Sup. 1987). District Judge Nina Gershon of the Eastern District of New York provided an exhaustive history of the litigation involving the former band members and FPI between 1967 and 2000 in a 2001 case involving Marshak and Reed. *See Marshak I*, 2001 WL 92225. This Order summarizes only some of that litigation and the litigation since then, highlighting the cases most relevant to the present action.

### **B. Litigation History Surrounding “The Platters” Trademark**

In 1972, FPI sued Paul Robi and Zola Taylor “for trademark infringement in the California Superior Court, Case No. C43926, claiming exclusive rights to ‘The Platters’ mark based on the 1956 assignments.” *Herb Reed Enterprises, Inc. v. Monroe Powell’s Platters*,

*LLC*, \_\_\_ F. Supp. 2d at \_\_\_, No. 2:11-CV-02010, 2012 WL 288705, at \*1 (D. Nev. Feb. 1, 2012). “In 1974, the court granted judgment in favor of Robi.” *Id.* (citing *Robi v. Five Platters, Inc.*, 838 F.2d 318, 320, 324 (9th Cir. 1988)). The court held that FPI “‘was a sham used by Mr. Ram to obtain ownership in the name Platters,’” and FPI’s issuance of stock to the group members was ‘illegal and void’ because it violated California corporate securities law.” *Id.* at \*1 (quoting the 1974 California decision).

### **1. Litigation between FPI and Robi**

In 1985, Robi sued FPI seeking a declaratory judgment regarding the parties’ rights to “The Platters” trademark and a permanent injunction against FPI interfering with Robi’s right to perform under “The Platters” name. *Marshak I*, 2010 WL 92225, at \*8. FPI counterclaimed against Robi for trademark infringement. *Id.* “The district court dismissed FPI’s complaint against Robi based on the claim preclusive effect of the 1974 California judgment.” *Monroe Powell’s Platters*, 2012 WL 288705, at \*2. The Ninth Circuit affirmed in 1988. *Id.* It held that “[t]he claim preclusive effect of the 1974 California judgment precludes [FPI] from challenging Robi’s use of the name THE PLATTERS.” *Id.* (citing *Robi v. Five Platters, Inc.*, 838 F.2d at 324). On remand, the court “cancelled FPI’s registration of the mark and permanently enjoined FPI from challenging Robi’s use of the mark.” *Id.* (citing *Robi v. Five Platters, Inc.*, 918 F.2d

1439, 1441 (9th Cir. 1990)). On appeal again, the Ninth Circuit affirmed. *Id.*

## **2. 1984-87 Litigation between FPI and Reed**

In 1984, FPI sued Reed for trademark infringement in the United States District Court for the Southern District of Florida. *The Five Platters, Inc. v. Herbert Reed, et al.*, No. 84-8324-CIV-SMA. The parties settled in 1987, and as part of the settlement Reed assigned FPI all rights he had in FPI stock and agreed not to perform under the name “The Platters.” *Marshak I*, 2001 WL 92225, at \*10. However, the stipulation included the following provision:

In the event that a court of competent jurisdiction enters a final order with all appeals being exhausted that the Five Platters, Inc. has no right in the name “The Platters,” then nothing contained herein shall be construed to limit Herbert Reed’s rights in the name “The Platters” and this agreement shall not inure to any party other than The Five Platters, Inc., and its successors and assigns or Herbert Reed.

(Dkt. no. 16-1 at 4.) This Order refers to this provision as the “escape clause.”

### 3. 2001 Litigation between FPI and Reed

In 2001, FPI and Tony Williams' heirs sued Reed for trademark infringement, this time in a New York district court (the "New York action"). *Marshak I*, 2001 WL 92225, at \*1. At the time, Larry Marshak managed The Tony Williams Platters, the performing group owned by Williams' heirs, and Marshak was also a plaintiff in the New York action. *Id.* FPI and Marshak sought a "determination of their rights to the name 'The Platters,' and an injunction prohibiting [Reed] from using that name or interfering with [FPI or Marshak's] use of it." *Id.* Reed counterclaimed alleging trademark infringement on the part of the defendants. *Id.* There,

[t]he district court interpreted the 1987 stipulation – specifically Reed's consent to dismissal with prejudice and the escape clause – as barring Reed from asserting that he has any right to the name 'The Platters' as against FPI or those claiming through FPI except as specifically allowed in the agreement, or from otherwise interfering with [FPI's] rights to the use of 'The Platters.' The district court reasoned that a stipulation of dismissal with prejudice dismis[s]e[d] claims, counterclaims, and claims that could have been brought by the parties. Therefore, the 1987 stipulation dismissed FPI's claims against Reed, Reed's counterclaims against FPI, and Reed's claim to exclusive rights to the mark because Reed could have brought such claim in the Florida action.

The district court further concluded that there [had] been no adjudication that FPI has no right to the name ‘The Platters’ as required by the escape clause of the stipulation for settlement. Accordingly, the district court granted FPI’s motion for summary judgment and declared FPI’s rights, and the rights of the other plaintiffs derived from FPI[,] as superior to Reed’s rights. The district court also issued an injunction barring Reed from interfering with FPI’s use of the mark and from performing or using “The Platters” mark. [Reed was not enjoined from using the mark in connection with the band names “Herb Reed and the Platters” or “Herb Reed’s Platters”].

Reed appealed to the Second Circuit. Meanwhile the Ninth Circuit in *Five Platters, Inc. v. Powell* held that FPI used “The Platters” with intent to mislead the public and remanded to determine if any of FPI’s use was not false or misleading. The Second Circuit remanded *Marshak v. Reed* and directed the district court to consider the impact of the Ninth Circuit decision on the district court’s grant of FPI’s motion for summary judgment and FPI’s motion to cancel Reed’s registration of the mark. The district court adhered to its earlier decisions because the Ninth Circuit’s holding did not determine that FPI has no right in the name “The Platters,” and thus, the holding did not trigger the escape clause. Reed again appealed and the Second Circuit affirmed the district court.

*Monroe Powell's Platters*, 2012 WL 288705, at \*3 (citations and quotation marks omitted; brackets added).

Notably, although in 2001 the New York court held that FPI had a superior right to Reed in “The Platters” trademark, the Ninth Circuit decision, *FPI v. Powell*, contradicted that holding. *Five Platters, Inc. v. Monroe Powell*, 7 F. App’x 794, 795 (9th Cir. 2001). That decision held that:

[a]ny use identifying [FPI] as “The Platters,” “The Five Platters,” “The Buck Ram Platters,” or “The Original Platters” is false and misleading under those prior decisions. Thus, *unless the [FPI] can present evidence that they used the trademark in a way that was not false and misleading (e.g., by identifying the group as “The Platters Since 1970” or some similarly distinguishing label), they cannot assert a common law trademark in “The Platters.”* We reverse the district court’s grant of summary judgment on the trademark claim and remand for an evidentiary hearing as to whether any of the plaintiffs’ use of the mark was not false and misleading. If the plaintiffs cannot present evidence of non-misleading use as defined by this order and the earlier decisions, the defendants are entitled to summary judgment on the plaintiffs’ common law trademark claim. At that time, the district court will no longer possess federal question subject matter jurisdiction. . . .

*FPI v. Monroe Powell*, 7 F. App'x at 795-96 (emphasis added).<sup>7</sup> “On remand the district court dismissed for lack of federal jurisdiction, Case No. 98-3712 R (BQRX).” *Monroe Powell’s Platters*, 2012 WL 288705, at \*2. According to a footnote in a 2002 Eastern District of New York decision discussing the Ninth Circuit decision, on remand the parties agreed that “the action was dismissed because FPI in the pretrial order abandoned the trademark claim, leaving only state law claims.” *Marshak v. Reed*, 229 F. Supp. 2d 179, 182 fn. 2 (E.D.N.Y. 2002) (“*Marshak II*”). Despite this, the 2002 New York court held that the Ninth Circuit decision did not trigger the 1987 escape clause because the decision could be read as “leaving open the possibility, however remote, that FPI can establish a common law trademark right to the name ‘The Platters.’” *Id.* at 185.

Therefore, the result of the 2000-2002 litigation between Reed, FPI, and Marshak was (1) that FPI did not own “The Platters” trademark; (2) but it had not been conclusively established by an appellate court that FPI could not some day establish common law ownership over “The Platters” mark; (3) because of this, the “escape clause” in Reed’s 1987 stipulation

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<sup>7</sup> As a point of clarification, *FPI v. Monroe Powell* concerned FPI’s common law rights in “The Platters” mark; the 1988 *Robi v. Reed* decision held that FPI had no contractual ownership over the mark due to prior decisions holding that the 1956 contract was a sham. See *Robi v. Five Platters, Inc.*, 838 F.2d at 324.

had not been triggered; and (4) Reed was enjoined from performing under the mark. However, Reed was not enjoined from performing under certain names including “Herb Reed and the Platters” or “Herb Reed’s Platters.” See *Marshak v. Reed*, No. 96-CV-2292, 11-CV-2582, 2012 U.S. Dist. LEXIS 32951, at \*2 (E.D.N.Y. March 12, 2012) (“*Marshak III*”).

#### 4. 2011-2012 Litigation Involving Reed

In 2010, Reed sued FPI, Personality Productions, Inc. (“PPI”), and Jean Bennett for trademark infringement. *HRE v. Bennett*, No. 2:10-CV-01981, 2011 WL 220221, at \*3 (the “2011 Nevada action”).<sup>8</sup> On April 22, 2011, Reed filed a Motion for Default Judgment against FPI and PPI. The Court subsequently entered a default judgment and a permanent injunction against the defendants declaring: (1) FPI and PPI “never used the mark ‘The Platters’ in a manner that [was] not false and misleading and thus never acquired common law rights to the mark”; and (2) “Reed, having first used the mark ‘The Platters’ in commerce in 1953, and having continuously used the mark in commerce since then has superior rights to

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<sup>8</sup> “Although Bennett filed an Answer on behalf of herself, FPI, and PPI, the Court ordered Bennett to find counsel for FPI and PPI. The [c]ourt also ordered FPI and PPI to file answers or responses to the Complaint by March 31, 2011. On March 30, 2011, Bennett informed the Court that no one would be representing FPI and PPI.” *Monroe Powell’s Platters*, 2012 WL 288705, at \*3.

the mark to all others,” including FPI, PPI, and “anyone claiming rights from or through them.”<sup>9</sup> *Monroe Powell’s Platters*, 2012 WL 288705, at \*4.

In February 2012, Reed sought a preliminary injunction in Nevada district court against Monroe Powell and Monroe Powell’s Platters, Inc. (“MPI”), a corporation using “The Platters” mark to promote a singing group called The Platters (though sometimes called Monroe Powell’s Platters) (“the 2012 Nevada action”). *Monroe Powell’s Platters*, 2012 WL 288705, at \*1. FPI originally hired Powell to perform with “The Platters” in 1970, after Reed had discontinued his relationship with the corporation. *Id.* at \*1. The Court in the 2012 Nevada action held that the 2011 Nevada action triggered the 1987 escape clause:

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<sup>9</sup> EnMan argues that the default judgment should not be considered binding upon this Court. It asserts that FPI and PPI no longer claimed ownership in “The Platters” mark in 2011, and that because whatever rights those corporations had in the mark had been signed over to Marshak and his company, Defendants should have been joined in that action. As such, Defendants claim that enforcing the judgment against EnMan and Marshak would deprive them due process. (Dkt. no. 16 at 18.) During oral argument, Defendants argued that Plaintiff knew FPI was not a valid entity and should have joined Marshak. Plaintiff argued that Marshak knew about the lawsuit but failed to intervene. Whether the parties had compelling reasons for their action or inaction with respect to the 2011 Nevada lawsuit is of no import. The Court construes the 2011 Nevada decision as a final judgment on the merits on only the issues litigated therein – namely, Reed’s rights to “The Platters” mark vis-à-vis FPI.

[a]ccording to this Court's default judgment in the [2011] Nevada action, FPI never acquired common law rights to 'The Platters' mark and Reed has superior rights to the mark to all others. Thus this Court determined that FPI has no right in the name 'The Platters' as required by the 1987 stipulation. This Court was a court of competent jurisdiction because it exercised jurisdiction pursuant to 28 U.S.C. § 1331. The default judgment was entered on May 16, 2011, and FPI and PPI failed to appeal the judgment within thirty days as required by Federal Rule of Appellate Procedure 4(a)(1)(A). As such, the default judgment qualifies as a final order with all appeals being exhausted and triggered the escape clause.

*Id.* at \*5 (brackets added; quotation marks omitted). The court granted Reed's motion and enjoined Powell from further use of the mark. *Id.* at \*8.

In between the two Nevada actions, Marshak sued Reed for civil contempt in the Eastern District of New York, alleging that Reed's 2011 Nevada lawsuit violated the 2001 injunction issued by that court. *Marshak III*, 2012 U.S. Dist. LEXIS 32951, at \*2. In a separate but related action, Marshak also sought damages resulting from Reed's alleged contempt. *Id.* at \*3. The court held that Reed "did not use 'The Platters' mark in violation of the 2001 Injunction and did not make any misrepresentations to the Nevada District Court as to the nature of his rights in 'The Platters' mark." *Id.* at \*15. The court denied

Marshak's motion and granted Reed's motion for summary judgment concerning Marshak's damages claim. *Id.* at \*15-16.

In April 2012, Reed's company HRE filed suit in this Court against Marshak and EnMan for trademark infringement, unfair competition, false designations of origin and false representations, and trademark dilution. (Dkt. no. 1.)<sup>10</sup> Defendants counterclaimed, alleging unfair competition on HRE's part. HRE filed this Motion on April 4. It asks that the Court enjoin Marshak and EnMan from using "The Platters" mark in connection with a vocal group in any advertisements, promotional marketing, or other materials without Plaintiffs' written permission, except when performing as "Larry Marshak's tribute to The Platters" or "Larry Marshak's salute to The Platters." (Dkt. no. 2.)

### **III. DEFENDANT'S OBJECTION TO PLAINTIFF'S SUPPLEMENTING ITS REPLY BRIEF**

On June 1, 2012, Plaintiff filed supplemental evidence in support of its Reply Brief. The filing contains exhibits of newly-discovered evidence Plaintiff believes is relevant to its Motion. (Dkt. no. 28.) Plaintiff did not seek leave from this Court before filing its supplemental evidence. Defendant objected

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<sup>10</sup> Before his June 4, 2012, death, Reed assigned all rights in the mark "The Platters" to HRE. (Dkt. no. 19 at ¶ 19).

to the filing, claiming that the filing is procedurally improper and contains inadmissible hearsay. (Dkt. no. 35 at 2-3.) In its Objection, Defendants also request that the Court allow supplemental briefing on Plaintiff's Motion for Preliminary Injunction to present argument regarding the impact of Herb Reed's death on Plaintiff's pending Motion. (*Id.* at 8.) Reed died on June 4, 2012, after this Motion had been briefed by both parties. (*Id.*)

The Court has reviewed the evidence in Plaintiff's supplemental filing and finds it largely tangential to Plaintiff's Motion. The Court does not consider the evidence in this Order. Further, the Court takes judicial notice of the fact that Herb Reed passed away on June 4, 2012. The parties argued their respective positions about the impact of Reed's death on this Motion at oral argument. Supplemental briefing is unnecessary. Reed's death was considered by the Court in reaching its conclusions and the Order discusses Reed's death where relevant.<sup>11</sup>

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<sup>11</sup> Further, Defendants' conclusory assertion that because the "estate of Herb Reed and its assigns have no greater claim to THE PLATTERS mark than the estates of the other original Platters members . . . the Court should deny [Plaintiff's] motion for preliminary relief" in light of Reed's death is unavailing for reasons discussed herein.

#### IV. CLAIM PRECLUSION AND LACHES

##### A. Preclusive Effect of the New York Action

“Res judicata bars all grounds for recovery which could have been asserted, whether they were or not, in a prior suit between the same parties in the same cause of action.” *Clark v. Bear Stearns & Co., Inc.*, 966 F.2d 1318, 1319 (9th Cir. 1992). Further, under “the Full Faith and Credit Act, federal courts must give state judicial proceedings ‘the same full faith and credit . . . as they have by law or usage in the courts of [the] State . . . from which they are taken.’” *Robi v. Five Platters, Inc.*, 838 F.2d 318, 322 (9th Cir. 1988) (quoting 28 U.S.C. § 1738) (other citations omitted). The “Act requires federal courts to apply the res judicata rules of a particular state to judgments issued by courts of that state.” *Id.*

EnMan argues that the 1987 stipulation and the New York action preclude Reed from arguing he owns “The Platters” mark. (Dkt. no. 16 at 19.) However, the court in the New York action held that the 1987 stipulation “bar[red] Reed from assert[ing] that he has any right to the name ‘The Platters’ as against FPI or those claiming through FPI *except as specifically allowed in that agreement. . . .*” *Marshak I*, 2001 WL 92225, at \*15 (emphasis and brackets added). Reed now challenges EnMan’s right to “The Platters” trademark as allowed under the escape clause, because as the *Monroe Powell’s Platters* court held, after the 2011 Nevada action, Reed is “no longer limit[ed]”

from “assert[ing] rights in the name ‘The Platters.’” 2012 WL 288705, at \*5. To the extent the 2011 and 2012 Nevada actions contradict any part of the prior litigation involving the relevant parties to this Motion, the Court applies the last in time rule – that is, when there are several conflicting judgments on the same claim or issue, the Court gives “res judicata effect to the *last* previous judgment entered.” *Robi v. Five Platters, Inc.*, 838 F.2d at 328 (quoting *Americana Fabrics, Inc. v. L & L Textiles, Inc.*, 754 F.2d 1524,1530 (9th Cir. 1985) (emphasis in original)).

### **B. Preclusive Effect of the 2011 Nevada Action**

To the extent that HRE attempts to use the 2011 Nevada action as offensive collateral estoppel on the issue of ownership, the Court declines to apply that doctrine here. Federal district courts are granted “broad discretion” in determining when to apply offensive collateral estoppel. *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 331 (1979). However, the “general rule should be that in cases where a plaintiff could easily have joined [the defendant] in the earlier action or where . . . the application of offensive estoppel would be unfair to a defendant, a trial judge should not allow the use of offensive collateral estoppel.” *Id.* HRE could have joined EnMan and Marshak in the 2011 Nevada action, but chose not to despite knowing that Marshak and EnMan have used “The Platters” mark in connection with live musical performances since at least 2008. (Dkt. no. 3 at 5.)

Moreover, “[a]llowing offensive collateral estoppel may . . . be unfair to a defendant if the judgment relied upon as a basis for the estoppel is itself inconsistent with one or more previous judgments in favor of the defendant.” *Id.* at 330. In fact, the Ninth Circuit previously chose not to apply the doctrine in a 1988 dispute involving FPI and Tony Williams, in part because of this concern. *Robi v. Five Platters, Inc.*, 838 F.2d at 329-330.

### **C. Laches**

Defendants assert that the equitable doctrine of laches precludes HRE from arguing that Defendants are liable for trademark infringement. “Laches is an equitable time limitation on a party’s right to bring suit resting on the maxim that one who seeks the help of a court of equity must not sleep on his rights.” *Jarrow Formulas, Inc. v. Nutrition Now, Inc.*, 304 F.3d 829, 835 (9th Cir. 2002) (citations omitted). The limitations period for laches commences when the plaintiff knew or should have known about his potential cause of action. *Id.* at 838.

Defendants argue that Reed knew that Marshak has used “The Platters” mark since 1996, or at latest 2001 when Marshak was a co-plaintiff in the 2001 New York action against Reed. However, as Defendants themselves acknowledge, the 1987 stipulation precluded Reed from asserting any rights in “The Platters” mark until a final judgment with appeals exhausted determined that FPI had no ownership

rights in “The Platters” mark. As stated, the final resolution of the 2001-2002 litigation in the Second and Ninth Circuits provided Reed with strong language that FPI could not claim ownership in “The Platters” mark. But there was not yet a final ruling with all appeals exhausted as required to trigger the 1987 escape clause. *Marshak v. Reed*, 87 F. App’x 208, 209 (2d Cir. 2004), *affirming Marshak II*, 229 F. Supp. 2d at 185. The escape clause was not triggered until the 2011 Nevada decision. Thereafter, Marshak sued Reed in the Eastern District of New York for contempt. *Marshak III*, 2012 U.S. Dist. LEXIS 32951, at \*1. Reed brought this action on April 4, 2012 – less than one month after the Eastern District of New York held that Reed had not violated that court’s 2001 injunction against him. Under any standard, twenty days does not constitute sleeping on one’s rights. Reed’s trademark infringement claim is not barred by laches.<sup>12</sup>

In sum, the Court holds that (1) the 2011 Nevada action triggered the 1987 escape clause; (2) the 2001-2002 New York action does not preclude HRE from asserting ownership over “The Platters” mark; (3) the 2011 Nevada action does not collaterally estop

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<sup>12</sup> Defendants may be confused, because at times they appear to argue that Reed should have attempted to re-establish ownership rights in “The Platters” generally, rather than against Marshak and EnMan specifically, before 2011. Whether or not Reed’s waiting until 2010 to assert ownership in “The Platters” is a wholly separate matter, and has no bearing on the resolution of this case.

Marshak from arguing that he is the senior user and owner of “The Platters”; and (4) Reed’s claim is not barred by laches.

## **V. PRELIMINARY INJUNCTION**

To qualify for a preliminary injunction, a plaintiff must demonstrate: (1) a likelihood of success on the merits; (2) a likelihood of irreparable harm; (3) that the balance of hardships favors the plaintiff; and (4) that the injunction is in the public interest. *Winter v. Nat.Res. Def. Council, Inc.*, 555 U.S. 7, 20 (2008).

### **A. Likelihood of Success on the Merits**

To establish a likelihood of success on the merits of a trademark infringement claim, the plaintiff must establish that he is “(1) the owner of a valid, protectable mark, and (2) that the alleged infringer is using a confusingly similar mark.” *Grocery Outlet, Inc. v. Albertson’s, Inc.*, 497 F.3d 949, 951 (9th Cir. 2007).

#### **1. Ownership**

“It is axiomatic in trademark law that the standard test of ownership is priority of use. To acquire ownership of a trademark it is not enough to have invented the mark first or even to have registered it first; the party claiming ownership must have been the first to actually use the mark in the sale of goods or services.” *Sengoku Works Ltd. v. RMC Int’l, Ltd.*,

96 F.3d 1217, 1219 as *modified*, 97 F.3d 1460 (9th Cir. 1996).

**a. Reed**

Reed argues that he is the senior user because he was the founding member of The Platters and has used the mark in commerce through performances and/or receiving royalties since 1953.<sup>13</sup> (Dkt. no. 41 at ¶ 3.) A “successful music group does not abandon its mark unless there is proof that the owner ceased to commercially exploit the mark’s secondary meaning in the music industry.” *Marshak v. Schaffner*, No. 11 CIV 1104, 2012 U.S. Dist. LEXIS 66536, at \*13 (S.D.N.Y., May 11, 2012) (citing *Marshak v. Treadwell*, 240 F.3d 184, 199 (3d Cir. 2001)). Further, “[r]ights in a mark signifying a singing group are not abandoned by the owner upon the group’s disbandment, so long as the owner continues to receive

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<sup>13</sup> Defendants argue that Plaintiff has not presented evidence credible to support HRE’s contention that Reed continuously received royalties from 1953 to his death. (Dkt. no. 42 at ¶ 31.) However, in his declaration, Frederick Balboni, Reed’s manager since 2005, stated that Reed and his estate have continuously received royalties from his Platters recordings. (Dkt. no. 41 at ¶ 3.) Defendants object that the Balboni declaration is insufficient and that HRE must provide “documentary evidence of a longstanding and continuous [sic] royalty stream” to establish Reed’s continuous use of the mark in commerce. Defendants are incorrect; the Balboni declaration suffices because “a preliminary injunction may be granted upon affidavits.” *Ross-Whitney Corp. v. Smith Kline & French Labs.*, 207 F.2d 190, 198 (9th Cir. 1953).

royalties from the sale of the group’s previously recorded material.” *Id.* Therefore, although Reed and his assigns could not perform under “The Platters” mark from 1987 through January 2011, Reed continuously used the mark in commerce and never abandoned the mark. (See dkt. no. 41 at ¶ 3.) This holding is in accord with the *Monroe Powell’s Platters* court, which determined that Reed had used “The Platters” mark continuously in commerce since 1953. 2012 WL 288705, at \*5; see also *Robi v. Reed*, 173 F.3d 736, 740 (9th Cir. 1999) (“[W]hen Paul Robi left the group, he took no right to the service mark with him . . . “the mark remain[s] with the original group. . . . Reed, who founded the group and is the only person who has remained and performed with it from its inception, retains” the superior right “to use the service mark. . . .”); Gregory M. Krakau and John A. Mizhir Jr., *Trademark Rights of Musical Groups*, Loy. L.A. L. Rev., May 2007, at 11, 12 (rights in a band name remain with the original members who continuously exploit the mark).

### **b. Marshak**

Defendants claim that Marshak acquired superior ownership of “The Platters” mark in three ways. First, Marshak claims he acquired any rights belonging to original Platters member Tony Williams’ estate in 2003. Second, Marshak claims his company acquired all rights to “The Platters” belonging to FPI and PPI in 2009. That is, in 2006, LiveGold, Inc. acquired ownership of “The Platters” mark from FPI

and PPI, and in 2009, Marshak acquired all rights and titles that LiveGold possessed in the mark. Third, Marshak argues that he has independently established ownership through his use of the mark in commerce by promoting live performances of his Platters group in Las Vegas and around the nation since 1996 or at least 2001.<sup>14</sup>

### **i. Tony Williams Transfer**

EnMan cannot assert ownership of “The Platters” through the 2003 Tony Williams transfer. In 1982, the New York County Supreme Court held that “a 1967 agreement . . . nullified any claim” Williams might have against FPI. *Marshak I*, 2001 WL 92225, at \*7. Marshak acknowledges this decision, but states that the injunction was later vacated. (Dkt. no. 17 at ¶ 13.) This is an incorrect assessment of the 1982 decision. It is true that the New York Supreme Court determined that, in light of Robi’s victory against FPI in 1984,<sup>15</sup> enforcement of FPI’s claim of ownership in the trademark was inappropriate. *FPI v. Williams* 1296, 1297 (N.Y. Sup. 1987). But the court declined to vacate its 1982 order. *Id.* The court held that Williams had a “full and fair opportunity to raise the key

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<sup>14</sup> Marshak licensed the rights to “The Platters” from FPI in 1996; he began promoting his Las Vegas show in 2001. (Dkt. no. 17 at ¶¶ 37, 34.)

<sup>15</sup> This decision affirmed a 1974 action involving Robi and FPI which held that the transfer of rights in “The Platters” mark from the original members to FPI was fraudulent.

issues involved on his present application [in 1982], and he had the right to appeal the challenged determination and neglected to do so.” *Id.* And in 1988, in a Ninth Circuit decision regarding another case between FPI and Williams over ownership of “The Platters,” the court determined that the 1982 New York Supreme Court judgment had preclusive effect; Williams could not assert ownership in “The Platters.”<sup>16</sup>

Further, guidance from a 1997 District of Nevada action between Robi and Reed, *Robi v. Reed*, No. 95-1029, is instructive here. The court held that as between Robi and Reed, Reed had the superior right in the mark. *Id.* First, the court determined that because the 1974 California decision voided the 1956 assignment of rights to FPI, the right to use “The Platters” mark in commerce remained with the group. *Marshak I*, 2001 WL 92225, at \*13 (discussing *Robi v. Reed*, No. CV-S-95-1029) (citations omitted)). Second, to determine whether Robi or Reed had

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<sup>16</sup> The 2001 New York decision also recounted the litigation concerning Williams’ right to “The Platters” mark and reached the same conclusion as this Order. *See Marshak I*, 2001 WL 92225, at \*8-12. That decision, which was later altered by the Ninth Circuit determination in *FPI v. Powell*, did state that Williams’ heirs’ rights to use “The Platters” mark were superior to Reed’s, *Marshak I*, 2001 WL 92225, at \*20, but in a footnote, the New York court noted that any rights the Williams plaintiffs had to “The Platters” were derivative of FPI’s rights. *Id.* at fn. 8. Therefore, this holding is in accord with the previous cases holding that Williams cannot assert independent common law ownership over “The Platters” mark.

superior rights to the name “The Platters,” the court reasoned that:

the group (as opposed to FPI) owned and had the exclusive right to use the name prior to [Robi’s] departure and continued to own and have the exclusive right to the name subsequent to his departure. Since Reed was the original member who remained with The Platters as the others left, it is Reed who [was deemed to own] the exclusive right to the mark The Platters.

*Marshak I*, 2001 WL 92225, at \*13 (discussing *Robi v. Reed*, No. CV-S-95-1029) (citations omitted). The Ninth Circuit affirmed. *Robi v. Reed*, 173 F.3d at 736.

Similarly, because Reed stayed with the group longer than Williams, his rights in the mark are superior to Williams’ rights. Any ownership stake Williams transferred to Marshak, if he had the right in the mark at all, is inferior to Reed’s.

## **ii. FPI Transfer**

EnMan also cannot assert ownership in the mark through transfer from FPI. As stated above, in 2001, the Ninth Circuit held that:

[U]nless the [FPI] can present evidence that they used the trademark in a way that was not false and misleading (e.g., by identifying the group as “The Platters Since 1970” or some similarly distinguishing label), they

cannot assert a common law trademark in “The Platters.”

*FPI v. Monroe Powell*, 7 F. App’x at 795-96. Although the 2002 New York decision held that this was not sufficient to trigger the 1987 escape clause, *Marshak II*, 229 F. Supp. 2d at 185, it did not determine what rights FPI had in “The Platters.” Rather, the New York court merely held that the 2001 Ninth Circuit decision left open “the possibility, however remote, that FPI can establish a common law trademark right to the name ‘The Platters.’” *Id.* Defendants present no evidence demonstrating that FPI or PPI had acquired any rights by 2006.

### **iii. Independent Ownership**

Finally, Marshak asserts that he has independent rights in the trademark dating back to 1996 or at least 2001 in “The Platters.” (Dkt. no. 17 at ¶¶ 37, 34.)

Marshak presented a similar argument in a trademark dispute concerning his use of another famous 1950s musical group’s mark, “The Marvelettes.” *Schaffner*, 2012 U.S. Dist. LEXIS 66536, at \*15-16. There, Marshak acknowledged that defendant Motown owned the right to “The Marvelettes” mark “in connection with the sale of recorded performances,” but argued that Motown “abandoned its use of the mark in connection with live musical performances” because the group no longer performed. *Id.* at \*16. Since Marshak promoted a group performing as “The

Marvelettes,” he argued that he was the senior user and owner of the mark in connection with live performances. *Id.* at \*16. The court rejected this argument, holding that “a stranger to the creation of goodwill associated with a mark” could not “develop common law rights in the mark for live performances where the original owner maintains rights in the mark to market musical recordings.” *Id.* at 19. The court stated that “a name or mark is merely a symbol of goodwill; it has no independent significance apart from the goodwill it symbolizes.” *Id.* at \*16 (citing *Marshak v. Green*, 746 F.2d 927, 929 (2d Cir. 1984) (brackets omitted)). Therefore, “use of the mark . . . in connection with a different goodwill and different product would result in a fraud on the purchasing public who reasonably assume that the mark signifies the same thing, whether used by one person or another.” *Id.* (brackets omitted; ellipses in original).

The principles underlying trademark law do not support Defendants’ attempted transmogrification. Marshak cannot create independent goodwill in a new Platters band simply by finding five vocalists, calling them The Platters, and having them sing Platters hits on stage. Marshak’s infringing use of a famous and beloved band name cannot acquire its own goodwill that supersedes and replaces the goodwill of the original band.

Therefore, between Defendants and Reed (and their respective corporations), Reed is the senior user and HRE owns the mark. Reed began using the mark in 1953, long before Marshak. He never abandoned

the mark because he either performed as a member of The Platters and/or received royalties from The Platters sound recordings since 1953. (Dkt. no. 41 at ¶ 3.) Importantly, nothing in the 1987 stipulation contradicts this conclusion. Rather, the 1987 stipulation held that Reed could not perform under “The Platters” mark until a final judgment with all appeals exhausted held conclusively that FPI did not own the mark. (Dkt. no. 16-1.) The stipulation foresaw the possibility that Reed might attempt to reclaim ownership of “The Platters” mark down the line, and he did so in the 2011 Nevada action.

## 2. Confusingly Similar

The Ninth Circuit uses a non-exhaustive eight factor test for determining likelihood of consumer confusion: (1) strength of the mark; (2) proximity or relatedness of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used; (6) type of goods and the degree of care likely to be exercised by the purchaser; (7) the defendant’s intent in selecting the mark; and (8) the likelihood of expansion of the product lines. *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 & fn. 11 (9th Cir. 1979), *abrogated in part on other grounds by Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 810 (9th Cir. 2003). “Some *Sleekcraft* factors are much more important than others, and the relative importance of each individual factor will be case specific.” *M2 Software, Inc., v. Madacy Entm’t*, 421 F.3d 1073, 1080 (9th Cir. 2005) (quotation marks and

citation omitted). “In essence, the test for likelihood of confusion is whether a reasonably ‘prudent consumer’ in the marketplace is likely to be confused as to the origin of the good or service bearing one of the marks.” *Id.* (citations and brackets omitted).

Plaintiff claims that there is a likelihood of confusion because: (1) consumers will confuse Marshak’s group with the original Platters; and (2) consumers will confuse Marshak’s group with HRE’s performing group, which goes by “Herb Reed and the Platters” or “Herb Reed’s Platters.” (Dkt. no. 3 at 13.) For reasons stated below, the Court agrees with Plaintiff on both counts.

**a. Confusion between the Parties’  
Use of “The Platters” Mark**

**i. Factor 1: Strength of the  
Mark**

“The Platters” is an inherently distinct, arbitrary mark because it uses common words that have no relevance to the musical performances and recordings to which the words are applied. *See In re MBNA Am. Bank, N.A.*, 340 F.3d 1328, 1332 (Fed. Cir. 2003) (noting that arbitrary marks are inherently distinctive). Further, the 2012 Nevada action held that “The Platters” is a strong mark because “The Platters was inducted into the Rock & Roll Hall of Fame in 1990, the Vocal Group Hall of Fame in 1998, and the Grammy Hall of Fame in 1999 and 2002. Therefore, The Platters remains a famous musical group today

and the first factor, strength of the mark, weighs in favor of finding a likelihood of success.” *Monroe Powell’s Platters*, 2012 WL 288705, at \*6.

**ii. Factors 2 and 3: Proximity or Relatedness of the Goods and Similarity of the Marks**

Factors two and three, the relatedness of goods and similarity of the marks both weigh in Plaintiff’s favor. The marks are identical. Further, EnMan advertises its group as “The Platters,” the group sings original Platters hits, and EnMan does not promote its group as a tribute band. (See dkt. no. 3-12 at 1.) Because of this, consumers are likely to believe the two goods are related, or that EnMan’s “The Platters” is actually the original, authentic version. See *Sleekcraft*, 599 F.2d at 350 (goods are related when there is a likelihood that the consumer will “assume there is an association between the producers of the related goods, though no such association exists.”).

**iii. Factor 4: Evidence of Actual Confusion**

The parties do not present evidence of actual confusion. However, “[b]ecause of the difficulty in garnering such evidence, the failure to prove instances of actual confusion is not dispositive.” *Sleekcraft*, 599 F.2d at 353. This factor therefore favors neither party.

**iv. Factor 5: Marketing Channels Used**

Factor five slightly favors Defendants. Reed and his company no longer organize performances under “The Platters” mark, but rather perform as “Herb Reed and The Platters” or “Herb Reed’s Platters.” HRE uses “The Platters” mark in connection with sales of vintage sound and video recordings of the band.

The type of marketing channels used for sales of sound recordings and videotapes of old live performances are different than the channels used for sales of live performances. *However*, HRE was enjoined from calling its group “The Platters” until 2011. The company may now use “The Platters” mark in connection with its live musical performances. Were it to do so, the marketing channels used by the two parties would be largely the same. So factor five only slightly favors Defendants and were HRE to begin promoting its group as The Platters, this factor would favor Plaintiff.

**v. Factor 6: the Type of Good and Degree of Care Likely to be Exercised by the Consumer**

Although Plaintiff does not present evidence regarding the degree of care likely to be exercised by the purchaser of music show tickets, factor six favors HRE. “In assessing the likelihood of confusion to the

public, the standard used by the courts is the typical buyer exercising ordinary caution.” *Sleekcraft*, 599 F.2d at 353. “[V]irtually no amount of consumer care can prevent confusion where two entities have the same name.” *Exctropix v. Liberty Livewire Corp.*, 178 F.Supp.2d 1125, 1134 (C.D.Cal.2001). “It is irrational to expect that even the most sophisticated consumer will exercise the kind of scrupulous examination that would enable him or her to discern the difference between nearly identical marks.” *Id.*

A typical buyer in this case is a patron at a live performance of either party’s group. As mentioned, EnMan bills its group as The Platters and its group performs in the musical style of the original band. Because of this, a reasonable consumer would not know whether he was purchasing tickets to EnMan’s group or HRE’s group when buying tickets to a Platters show.

**vi. Factor 7: Defendants’ Intent in Selecting the Mark**

“This factor favors the plaintiff where the alleged infringer adopted his mark with knowledge, actual or constructive, that it was another’s trademark.” *Brookfield Commc’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1059 (9th Cir. 1999) (citing *Off. Airline Guides, Inc. v. Goss*, 6 F.3d 1385, 1394 (9th Cir. 1993)).

It is not clear that when Marshak acquired the mark from FPI he knew that it did not own the mark.

Marshak originally licensed the right to use The Platters mark from FPI in 1996, at which time FPI was still battling ownership over the mark. Though many courts had held that FPI did not own “The Platters” mark, the litigation was still ongoing, and there had been certain decisions in FPI’s favor.<sup>17</sup> And due to the prior inconsistent judgments and the 2001 New York decision in FPI and Marshak’s favor, Marshak may have believed the transfer of ownership rights from FPI to LiveGold and LiveGold to EnMan was legitimate. Thus, due to the inconsistent prior judgments and ongoing litigation, without further evidence it is not obvious that EnMan knew “The Platters” mark was not rightfully owned by FPI when it purchased the mark from the corporation.<sup>18</sup>

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<sup>17</sup> For example, the 1986 Ninth Circuit decision involving FPI and Williams and the 1987 settlement between Reed and FPI.

<sup>18</sup> As mentioned in the section discussing ownership (*supra*), Marshak should have known that the other two means in which Defendants claim Marshak acquired the mark – from Marshak’s independent use in commerce and from Tony Williams’ estate – were not legitimate. However, it is possible that because of the muddy and mercurial holdings regarding ownership of the mark, Marshak simply attempted to acquire ownership from any person or entity claiming ownership in the mark in an effort to acquire the rightful title.

**vii. Factor 8: Likelihood of Expansion**

When the goods or services of the parties are related, this factor is irrelevant. *See Playboy Enters., Inc. v. Netscape Commc'ns Corp.*, 354 F.3d 1020, 1029 (9th Cir. 2004).

In sum, factors 1-3 and 6 strongly favor HRE. Factor 5 slightly favors Defendants. Factors 4, 7, and 8 favor neither party. The marks are identical. HRE uses its mark to promote and sell its band's hits. Defendants use the mark to promote and sell tickets to live performances of a band that dresses like the original Platters, sings the Platters' hits, and advertises itself as The Platters. For these reasons, it is likely that consumers will confuse EnMan's Platters group for HRE's.

**b. Confusion between the Marshak's Use of "The Platters" and "Herb Reed's Platters"**

For many of the same reasons described above, there is a likelihood of confusion between Marshak's use of "The Platters" and "Herb Reed's Platters." The Court discusses only those factors for which the analysis on this point differs from above analysis.

Factor one favors HRE. Though "The Platters" mark is inherently arbitrary, "Herb Reed's Platters" is a descriptive mark – describing Reed's modern version of his famous group, The Platters. At oral argument, Plaintiff stated that when Reed performed with

the group, HRE's group was billed as "Herb Reed and the Platters." The group is billed as "Herb Reed's Platters" at all other times. Because of Reed's recent passing, the Court refers to HRE's performing group as "Herb Reed's Platters." Notably, "Herb Reed and the Platters" and "Herb Reed's Platters" are used interchangeably by HRE in its brief. "Herb Reed and the Platters" is a registered trademark and has achieved incontestable status. (Dkt. no. 3-10 at 3-4.) "Herb Reed's Platters" is not registered. But because the marks are used interchangeably by HRE, the Court treats the two names identically for the purposes of this Order. Thus, because incontestability serves as conclusive proof that the mark has secondary meaning, factor one favors Reed. *See Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1142 fn. 3 (9th Cir. 2002).

Factor three also favors HRE. Though the marks are not identical, both groups purport to be the modern iteration of the original Platters. As mentioned, EnMan does not inform consumers that its band is a tribute band. Because both groups advertise themselves as the authentic Platters group, the marks are similar. *See also Monroe Powell's Platters*, 2012 WL 288705, at \*6 (holding that factor three favored HRE where defendant copycat band's website did not distinguish between Powell's group and the original Platters).

Factor 5 favors HRE. The marketing channels for EnMan's Platters group and Herb Reed and the Platters are nearly identical. Both promote national

live performances of a group claiming to be the current version of the 1960's Platters.

For these reasons, there is a likelihood of consumer confusion between Marshak's "The Platters" mark and "Herb Reed's Platters."

### **B. Likelihood of Irreparable Harm**

"Previously, the rule for preliminary injunctions in the trademark context was that courts presumed irreparable injury if the moving party showed likelihood of success on the merits." *BoomerangIt, Inc. v. ID Armor, Inc.*, No. 5:12-CV-0920, 2012 WL 2368466, at \*3 (N.D. Cal. June 21, 2012) (citing *Brookfield Commc'n s., Inc. v. West Coast Entm't Corp.*, 174 F.3d 1036, 1066 (9th Cir. 1999)). "Recent precedent, however, has cast doubt on that presumption. Specifically, *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 393(2006) and *Flexible Lifeline Systems, Inc. v. Precision Lift, Inc.*, 654 F.3d 989, 1000 (9th Cir. 2011) rejected similar presumptions in the patent and copyright contexts." *Id.* "In light of these cases and the Supreme Court's restatement of the standard for issuing a preliminary injunction in [*Winter*, 555 U.S. at 20], the viability of the presumption of irreparable harm in the trademark context is in question." *Id.*

As the *BoomerangIt* court explained:

The Ninth Circuit has not yet addressed whether irreparable harm can be presumed upon a showing of likelihood of success on a trademark infringement claim. . . . District

courts in this Circuit that have addressed this issue have found that the governing law has changed, and a plaintiff is not granted the presumption of irreparable harm upon a showing of likelihood of success on the merits.

2012 WL 2368466, at \*3-4 (citing, among other cases, *Seed Services, Inc. v. Winsor Grain, Inc.*, No. 1:10-CV-2185, 2012 WL 1232320, at \*4 (E.D.Cal. Apr.12, 2012) (“[T]he court will not assume the existence of irreparable injury due to a showing of success on the merits.”); *AFL Telecommunications LLC v. SurplusEQ.com, Inc.*, No. CV 11-01086, 2011 WL 4102214, at \*3 (D.Ariz. Sept.14, 2011) (“Irreparable harm is no longer presumed in a trademark or copyright case upon a showing of a likelihood of success on the merits.”) (other citations omitted)). The Court therefore does not give HRE a presumption of irreparable harm in this case.

To prevail on this Motion, HRE must also establish that “remedies available at law, such as monetary damages, are inadequate to compensate for that injury.” *eBay*, 547 U.S. at 391. That is, Plaintiff must establish that the harm done to HRE by Marshak’s infringing use cannot be remedied except through injunctive relief. *See MGM Studios, Inc. v. Grokster, Ltd.*, 518 F. Supp. 2d 1197, 1210 (C.D.Cal. 2007).

HRE claims that without injunctive relief, Reed’s legacy will suffer irreparable reputational harm as an entertainer and he and his heirs and assigns will be

denied “the right to benefit from the fame [Reed] brought to” “The Platters” mark. (Dkt. no. 3 at 15.)

Defendants characterize HRE’s argument as “near laughable.” (Dkt. no. 16 at 23.) They claim that immediate relief is not warranted because EnMan’s group has been performing for over a decade, so any additional harm the group causes to Reed’s reputation experienced through the pendency of this litigation will be negligible and is certainly not irreparable. EnMan cites language in the 2001 New York action to support this argument. There, the court held that:

where competing groups of Platters have appeared for many years, there can be no claim of injury to the public interest by allowing FPI to continue what it has been doing since 1969 in presenting groups as “The Platters” that do not include any members of the original Platters.<sup>19</sup>

Yet trademark infringement is no laughing matter. Reed could not assert his rights in “The Platters” mark until recently – until the 1987 escape

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<sup>19</sup> At oral argument Defendants argued that this statement rings even more true now in light of Reed’s recent death, because HRE’s group can no longer claim superior authenticity to copycat groups based on the fact that its membership consists of an original member of The Platters. Though Plaintiff may no longer argue that its version is more authentic than others because Reed is a member, Reed assigned his rights to “The Platters” to his company before his death. With it, he transferred the goodwill associated with the mark. This goodwill survives Reed’s death.

clause was triggered. Once he did, other courts enjoined copycat groups from further infringement.<sup>20</sup> This Court follows their lead. While unauthorized Platters groups have illegitimately performed under the mark for decades, and no doubt Marshak's group is not the last remaining copycat, this Court cannot condone trademark infringement simply because it has been occurring for a long time and may continue to occur. Doing so would not only sanction trademark infringement, but could encourage wide-scale infringement on the part of persons hoping to tread on the goodwill and fame of vintage music groups.

Moreover, although EnMan's use may have already done much damage to Reed's legacy, the Court finds more merit to Plaintiff's claims than Defendants do. In fact, the *Monroe Powell's Platters* court, dealing with a substantially similar claim, found that the harm to Reed's reputation caused by a different unauthorized Platters group warranted a preliminary injunction. 2012 WL 288705, at \*7. As mentioned earlier, Powell, like Marshak, organized an unauthorized Platters group that performed using the same performance style and same songs as the original Platters. *Id.* The court noted that:

[c]ontinued use of the mark in a confusingly similar manner will likely damage Reed's reputation as a performer. Reed's reputation

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<sup>20</sup> As mentioned, the 2012 Nevada action enjoined the imitation group organized by Monroe Powell's Platters, LLC.

and rights to the mark will remain valuable to Reed after he stops performing. For example, Reed could license the mark to Powell for a fee. Moreover, Reed likely will lose goodwill among consumers if The Platters name continues to be diluted. . . . Further, if the Court permits continued confusion over Reed's rights to the mark, additional groups similar to Powell's group could form and further harm Reed's reputation and goodwill.

*Monroe Powell's Platters*, 2012 WL 288705, at \*7.

### **C. Balance of Hardships and Public Interest**

“In each case, a court must balance the competing claims of injury and must consider the effect on each party of the granting or withholding of the requested relief.” *Amoco Prod. Co. v. Village of Gambell, Alaska*, 480 U.S. 531, 542 (1987); *see also International Jensen v. MetroSound U.S.A., Inc.*, 4 F.3d 819, 827 (9th Cir. 1993) (“In evaluating the balance of hardships a court must consider the impact granting or denying a motion for a preliminary injunction will have on the respective enterprises”). In addition, courts “must consider the public interest as a factor in balancing the hardships when the public interest may be affected.” *Caribbean Marine Services Co. v. Baldrige*, 844 F.2d 668, 674 (9th Cir. 1988).

The balance of the hardships favors HRE. The goodwill associated with the original “The Platters”

mark will continue to be diluted if EnMan is allowed to promote its imitation group in Las Vegas and around the nation. The harm may not be as significant as it once was, in prior decades when Reed was alive and there were not numerous iterations of phony Platters groups. But it is still a significant harm. As this Court and other courts have found, “The Platters” mark is a strong mark imbued with a significant amount of goodwill due to the band’s fame and the continuing popularity and ubiquity of many Platters hits. Unauthorized use by copycat groups dilutes the goodwill surrounding the original Platters band.

The harm to Defendants is less significant. EnMan may still organize and promote its unauthorized version of The Platters; it must simply signify that its band is a tribute band. In his Declaration, Marshak claims that, even so, he would lose much of his business were the Court to grant this Motion because he has contracts with vendors and advertisers to promote his group as The Platters. (Dkt. no. 17 at 5-6.) Marshak asserts that if the Court grants this Motion, EnMan would be forced to close its Las Vegas show and cease its business, and that the business could not be revived at a later date. (*Id.* at 21-22.) However, in EnMan’s Response Brief, it claims that “consumers and Marshak’s business partners have come to associate THE PLATTERS mark with Marshak.” (Dkt. no. 16 at 24.) If this is the case, then designating EnMan’s group as “Larry Marshak’s Tribute to the Platters” or “Larry Marshak’s Salute to

the Platters” is unlikely to harm Defendants because “The Platters” trademark is already associated with Marshak’s name. Rather than harm Defendants, this injunction will only better inform consumers about when they are purchasing a performance of Defendants’ version of The Platters. Any harm EnMan encounters because consumers will now realize that its version is a tribute band and not the authentic Platters group is not cognizable here. This is only the harm Defendants will experience from no longer being permitted to infringe on HRE’s trademark. Because this use was not proper in the first place, it cannot harm Defendants to enjoin them from doing what they were never authorized to do. In fact, Defendants assumed the risk that they might be enjoined from infringing on the mark.

Finally, because trademark law seeks to prevent consumer confusion in the marketplace, *see* 15 U.S.C. § 1125(a)(1), a preliminary injunction in this case serves the public interest. Enjoining EnMan from using “The Platters” except when designated as a tribute band will lend some clarity to the market for Platters performances. EnMan’s group will no longer be one of the multiple imitation Platters groups cluttering the marketplace for old and new fans seeking tickets to a performance of a current version of the original band.

## VI. BOND

It would be an understatement to say that the parties disagree as to the bond amount. EnMan requests a bond of \$1.4 million for every year during which this case is ongoing. HRE argues that if the Court is to require a bond, the bond should be no more than \$10,000, which was the bond required in the 2012 Nevada action.

The court has “wide discretion in setting the amount of the bond, and the bond amount may be zero if there is no evidence the party will suffer damages from the injunction.” *Connecticut Gen. Life Ins. Co. v. New Images of Beverly Hills*, 321 F.3d 878, 882 (9th Cir. 2003). In setting bond, the court must consider evidence of the “potential financial ramifications of entering a preliminary injunction.” *Walczak v. EPL Prolong, Inc.*, 198 F.3d 725, 733 (9th Cir. 1999). In *Cybermedia, Inc. v. Symantec Corp.*, 19 F. Supp. 2d 1070, 1079-80 (N.D. Cal. 1998), a computer software copyright infringement action, the court considered four factors in determining the bond amount: (1) profits which the defendants would have earned on sales during the period of the injunction; (2) out-of-pocket expenses related to promotion of the defendant’s infringing product; (3) damage to the infringing company’s reputation; and (4) expenses associated with the recall of the infringing product, which in this case is equivalent to expenses associated with EnMan’s changing its advertisements to denote that its group is a tribute band.

Defendants do not produce evidence for which the Court can analyze the *Cybermedia* factors. The only evidence they provide are the lost profits figures which EnMan calculates on the basis of its 2012 quarterly revenues from the Las Vegas show, amounting to \$619,182.23, and revenues from national bookings for its Platters group, amounting to \$191,451.76. (Dkt. no. 17 at ¶¶ 19, 23.) These figures are insufficient for two reasons. First, many of EnMan's shows, including its lucrative Las Vegas show, present its Platters group singing alongside other vintage music groups. It is therefore impossible, without more evidence, to establish how much of the above-referenced revenues are linked to consumers purchasing tickets to see EnMan's Platters group as opposed to the other vintage performing groups. Second, although Marshak states in his declaration that EnMan would incur significant costs and lose a great deal of business were it enjoined from promoting its group as "The Platters," Defendants make no effort to quantify that loss. Both parties agree that EnMan may continue to promote its group as "Larry Marshak's Tribute/Salute to the Platters." For both of these reasons, it is clear that EnMan will continue to receive revenues from performances involving its Platters tribute band. Defendants argue that there would be expenses associated with changing the promotion materials to any of the alternative names proposed by HRE, but did not offer evidence to demonstrate the specific costs involved. Accordingly, the specific lost revenues associated with this preliminary injunction are unclear.

In light of the absence of evidence of injury to Defendants resulting from the issuance of the injunction, the Court finds that a bond in the amount of \$10,000.00 is sufficient security. This was the amount provided to defendants in the substantially similar 2012 Nevada action. *Monroe Powell's Platters*, 2012 WL 288705, at \*8.

## **VII. ORDER AND PRELIMINARY INJUNCTION**

IT IS THEREFORE ORDERED that Plaintiff Herb Reed Enterprises, LLC's Motion for Preliminary Injunction (dkt. no. 2) is GRANTED to the following extent:

Defendants and their agents are preliminary [sic] enjoined from use of the mark "The Platters," and any equivalent or phonetically similar names or marks, in connection with any vocal group in any advertisements, promotional marketing, or other materials, with two narrow exceptions.

First, Defendants may use the mark "The Platters" in connection with the names "Larry Marshak's Tribute to The Platters" or "Larry Marshak's Salute to The Platters." The words "tribute" or "salute" must be at least one half the font size of the words "The Platters" in any of Defendants' advertising.

Second, Defendants may use the mark "The Platters" in any other manner with Plaintiff's permission.

IT IS FURTHER ORDERED that Plaintiff shall secure this Preliminary Injunction by posting a bond in the amount of \$10,000 with the Clerk of the Court within five (5) calendar days from the filing of this Order.

ENTERED THIS 24th day of July 2012.

/s/ Miranda M. Du  
UNITED STATES  
DISTRICT JUDGE

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15 U.S.C. § 1125. False designations of origin,  
false descriptions, and dilution forbidden

(a) Civil action

**(1)** Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which –

**(A)** is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, 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, or

**(B)** in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

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.

**(2)** As used in this subsection, the term “any person” includes any State, instrumentality of a State or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

**(3)** In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.

\* \* \*

(c) Dilution by blurring; dilution by tarnishment

(1) Injunctive relief

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.

(2) Definitions

**(A)** For purposes of paragraph (1), a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following:

**(i)** The duration, extent, and geographic reach of advertising and publicity of the

mark, whether advertised or publicized by the owner or third parties.

(ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.

(iii) The extent of actual recognition of the mark.

(iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

**(B)** For purposes of paragraph (1), “dilution by blurring” is 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.

(C) For purposes of paragraph (1), “dilution by tarnishment” is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.

(3) Exclusions

The following shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection:

(A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person’s own goods or services, including use in connection with –

(i) advertising or promotion that permits consumers to compare goods or services; or

(ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.

(B) All forms of news reporting and news commentary.

(C) Any noncommercial use of a mark.

(4) Burden of proof

In a civil action for trade dress dilution under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that –

(A) the claimed trade dress, taken as a whole, is not functional and is famous; and

(B) if the claimed trade dress includes any mark or marks registered on the principal register, the unregistered matter, taken as a whole, is famous separate and apart from any fame of such registered marks.

(5) Additional remedies

In an action brought under this subsection, the owner of the famous mark shall be entitled to injunctive relief as set forth in section 1116 of this title. The owner of the famous mark shall also be entitled to the remedies set forth in sections 1117(a) and 1118 of this title, subject to the discretion of the court and the principles of equity if –

(A) the mark or trade name that is likely to cause dilution by blurring or dilution by tarnishment was first used in commerce by the person against whom the injunction is sought after October 6, 2006; and

(B) in a claim arising under this subsection –

(i) by reason of dilution by blurring, the person against whom the injunction is sought willfully intended to trade on the recognition of the famous mark; or

(ii) by reason of dilution by tarnishment, the person against whom the injunction is sought willfully intended to harm the reputation of the famous mark.

(6) Ownership of valid registration a complete bar to action

The ownership by a person of a valid registration under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register under this chapter shall be a complete bar to an action against that person, with respect to that mark, that –

(A) is brought by another person under the common law or a statute of a State; and

(B)(i) seeks to prevent dilution by blurring or dilution by tarnishment; or

(ii) asserts any claim of actual or likely damage or harm to the distinctiveness or reputation of a mark, label, or form of advertisement.

(7) Savings clause

Nothing in this subsection shall be construed to impair, modify, or supersede the applicability of the patent laws of the United States.

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15 U.S.C. § 1116. Injunctive relief

(a) Jurisdiction; service

The several courts vested with jurisdiction of civil actions arising under this chapter shall have power to grant injunctions, according to the principles of equity and upon such terms as the court may deem reasonable, to prevent the violation of any right of the registrant of a mark registered in the Patent and Trademark Office or to prevent a violation under subsection (a), (c), or (d) of section 1125 of this title. Any such injunction may include a provision directing the defendant to file with the court and serve on the plaintiff within thirty days after the service on the defendant of such injunction, or such extended period as the court may direct, a report in writing under oath setting forth in detail the manner and form in which the defendant has complied with the injunction. Any such injunction granted upon hearing, after notice to the defendant, by any district court of the United States, may be served on the parties against whom such injunction is granted anywhere in the United States where they may be found, and shall be operative and may be enforced by proceedings to punish for contempt, or otherwise, by the court by which such injunction was granted, or by any other United States district court in whose jurisdiction the defendant may be found.

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**Presumption Allowed/Likely Merits Success  
Establishes Likely Irreparable Injury**

1. 1-800 Radiator Franchise, Inc. v. Blincoe Diversified Alts., LLC, 2011 WL 1843302 (vacated by 2011 WL 3269316) (D. Idaho May 15, 2011)
2. Alliance Bank v. New Century Bank, 742 F. Supp. 2d 532 (E.D. Pa. July 27, 2010)
3. Auburn Univ. v. Moody, 2008 WL 4877542 (M.D. Ala. Nov. 4, 2008)
4. Basis Int'l Ltd. v. Research in Motion Ltd., 827 F. Supp. 2d 1302 (D.N.M. Dec. 6, 2011)
5. Beckman Coulter, Inc. v. Beckcoulter.com, 2010 WL 2985560 (N.D. Cal. July 26, 2010)
6. Bel Canto Design, Ltd. v. MSS Hifi, Inc., 837 F. Supp. 2d 208 (S.D.N.Y. Dec. 16, 2011)
7. Cybergun, S.A. v. Jag Precision, 2012 WL 4868104 (D. Nev. Oct. 11, 2012)
8. Dahl v. Swift Distribution, Inc., 2010 WL 1458957 (C.D. Cal. Apr. 1, 2010)
9. Dental USA, Inc. v. McClellan, 2013 WL 4451257 (N.D. Ill. Aug. 16, 2013)
10. Diamonds Direct USA, Inc. v. BFJ Holdings, Inc., 895 F. Supp. 2d 752 (E.D. Va. Oct. 2, 2012)

11. E. Gluck Corp. v. Rothenhaus, 585 F. Supp. 2d 505 (S.D.N.Y. Nov. 3, 2008)
12. Egg Works, Inc. v. Egg World, LLC, 2010 WL 3724206 (D. Nev. Sept. 14, 2010)
13. Fuhu, Inc. v. Toys “R” Us, Inc., 2012 WL 5197556 (S.D. Cal. Oct. 19, 2012)
14. Garcoa, Inc. v. PH Beauty Labs, Inc., 2009 WL 2489223 (C.D. Cal. Aug. 10, 2009)
15. Gold’s Gym Licensing, LLC v. K-Pro Mktg. Grp. 2009 WL 2253247 (D. Minn. July 28, 2009)
16. Hansen Beverage Co. v. Cytosport, Inc., 2009 WL 5104260 (C.D. Cal. Nov. 4, 2009)
17. Innersvingen AS v. Sports Hoop, Inc., 2012 WL 3048363 (C.D. Cal. July 26, 2012)
18. Interplay Entm’t Corp. v. TopWare Interactive, Inc., 751 F. Supp. 2d 1132 (C.D. Cal. Nov. 2, 2010)
19. Karoun Dairies, Inc. v. Karoun Dairies, Inc., 2010 WL 3633109 (S.D. Cal. Sept. 13, 2010)
20. Masters Software, Inc. v. Discovery Commc’ns, Inc., 725 F. Supp. 2d 1294 (W.D. Wash. July 16, 2010)
21. Mercado-Salinas v. Bart Enters. Int’l, Ltd., 2010 WL 3372575 (D.P.R. Aug. 23, 2010)

22. *Moroccanoil, Inc. v. Moroccan Gold, LLC*, 590 F. Supp. 2d 1271 (C.D. Cal. Dec. 9, 2008)
23. *Nationwide Payment Solutions, LLC v. Plunkett*, 697 F. Supp. 2d 165 (D. Me. Mar. 24, 2010)
24. *Neighborhood Assistance Corp. of Am. v. First One Lending Corp.*, 2012 WL 1698368 (C.D. Cal. May 15, 2012)
25. *New York City Triathlon, LLC v. NYC Triathlon Club, Inc.*, 704 F. Supp. 2d 305 (S.D.N.Y. Mar. 9, 2010)
26. *Nordstrom, Inc. v. NoMoreRack Retail Grp.*, 2013 WL 1196948 (W.D. Wash. Mar. 25, 2013)
27. *Novus Franchising, Inc. v. AZ Glassworks, LLC*, 2012 WL 5057095 (D. Minn. Sept. 27, 2012)
28. *Operation Able of Greater Boston, Inc. v. Nat'l Able Network, Inc.*, 646 F. Supp. 2d 166 (D. Mass. Aug. 3, 2009)
29. *Pacific Coast Trailers, LLC v. Cozad Trailer Sales, LLC*, 2010 WL 3489710 (E.D. Wash. Sept. 1, 2010)
30. *Prosperity Sys., Inc. v. Ali*, 2010 WL 5174939 (D. Md. Dec. 15, 2010)
31. *Rebel Debutante LLC v. Forsythe Cosmetic Grp.*, 799 F. Supp. 2d 558 (M.D.N.C. July 1, 2011)

32. Summit Entm't, LLC v. Beckett Media, LLC, 2010 WL 147958 (C.D. Cal. Jan. 12, 2010)
33. Super-Krete Int'l, Inc. v. Sadleir, 712 F. Supp. 2d 1023 (C.D. Cal. Apr. 22, 2010)
34. TM Computer Consulting, Inc. v. Apothacare, LLC, 2008 WL 4238913 (D. Or. Sept. 11, 2008)
35. TMC Franchise Corp. v. Millennium Vision, LLC, 2011 WL 65616 (D. Ariz. Jan. 7, 2011)
36. Tropical Nut & Fruit Co. v. Forward Foods, LLC, 2013 WL 2481521 (W.D.N.C. June 10, 2013)
37. Vertos Med., Inc. v. Globus Med., Inc., 2009 WL 3740709 (N.D. Cal. Nov. 6, 2009)
38. W. Coast Corvettes, Inc. v. MV Mktg., Inc., 2012 WL 1401433 (C.D. Cal. Apr. 23, 2012)
39. Wetzel's Pretzels, LLC v. Johnson, 797 F. Supp. 2d 1020 (C.D. Cal. June 27, 2011)
40. Weyerhaeuser NR Co. v. Louisiana-Pacific Corp., 2013 WL 5331246 (M.D. Tenn. Sept. 23, 2013)

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**Likely Irreparable Injury Established  
Without Additional Evidence**

1. 7-Eleven, Inc. v. Dhaliwal, 2012 WL 5880462 (E.D. Cal. Nov. 21, 2012)
2. 7-Eleven, Inc. v. Khan, 2013 WL 5585007 (E.D.N.Y. Oct. 10, 2013)
3. Active Network, Inc. v. Electronic Arts Inc., 2010 WL 3463378 (S.D. Cal. Aug. 31, 2010)
4. Adidas AG v. Adidas2013online.com, 2013 WL 6667043 (S.D. Fla. Dec. 17, 2013)
5. Adidas AG v. adidasrazylight2.com, 2013 WL 1651731 (S.D. Fla. Apr. 16, 2013)
6. American Casino & Entm't Props., LLC v. Marchex Sales, Inc., 2012 WL 2674611 (D. Nev. July 5, 2012)
7. AWGI, LLC v. Team Smart Move, LLC, 2013 WL 1181450 (M.D. Fla. Mar. 14, 2013)
8. Bentley Motors Ltd. Corp. v. McEntegart, 899 F. Supp. 2d 1291 (M.D. Fla. Oct. 9, 2012)
9. Buffalo Wild Wings Int'l, Inc. v. Grand Canyon Equity Partners, LLC, 829 F. Supp. 2d 836 (D. Minn. Dec. 9, 2011)
10. Bulman v. 2BKCO, Inc., 882 F. Supp. 2d 551 (S.D.N.Y. July 23, 2012)

11. Burger King Corp. v. Cabrera, 2010 WL 5834869 (S.D. Fla. Dec. 29, 2010)
12. Caesars World, Inc. v. July, 2011 WL 5117572 (D. Nev. Oct. 24, 2011)
13. Caliente Cab Rest. Co. v. Caliente Café Rest. & Bar, Inc., 2011 WL 3290385 (E.D.N.Y. July 29, 2011)
14. Century 21 Real Estate LLC v. All Prof'l Realty, Inc., 2011 WL 221651 (E.D. Cal. Jan. 24, 2011)
15. Chanel, Inc. v. chanel255.org, 2012 WL 1941598 (S.D. Fla. May 29, 2012)
16. Chrysler Grp. LLC v. Moda Grp. LLC, 796 F. Supp. 2d 866 (E.D. Mich. June 28, 2011)
17. CJ Prods. LLC v. Snuggly Plushez LLC, 809 F. Supp. 2d 127 (E.D. N.Y. Aug. 22, 2011)
18. CLT Logistics v. River West Brands, 777 F. Supp. 2d 1052 (E.D. Mich. Mar. 4, 2011)
19. Collins v. Gourdine, 2012 WL 4194555 (D. Nev. Sept. 18, 2012)
20. Color Me House, Inc. v. Discovery Commc'ns, Inc., 2013 WL 1283806 (W.D. Wash. Mar. 27, 2013)
21. ComPsych Corp. v. Health Champion LLC, 2012 WL 6212653 (D. Conn. Dec. 13, 2012)

22. *Corr. Officers' Benevolent Ass'n, Inc. v. Palmieri*, 2012 WL 279484 (S.D.N.Y. Jan. 30, 2012)
23. *Country Fare LLC v. Lucerne Farms*, 2011 WL 2222315 (D. Conn. June 7, 2011)
24. *Credit One Corp. v. Credit One Fin., Inc.*, 661 F. Supp. 2d 1134 (C.D. Cal. Sept. 23, 2009)
25. *CrossFit, Inc. v. Maximum Human Performance, LLC*, 2013 WL 1627953 (S.D. Cal. Apr. 12, 2013)
26. *CytoSport, Inc. v. Vital Pharm., Inc.*, 617 F. Supp. 2d 1051 (E.D. Cal. May 6, 2009)
27. *Diller v. Barry Driller, Inc.*, 2012 WL 4044732 (C.D. Cal. Sept. 10, 2012)
28. *Dunkin' Donuts Franchised Rests. LLC v. ABM Donuts, Inc.*, 2011 WL 6026129 (D.R.I. Oct. 4, 2011)
29. *Edge Games, Inc. v. Elec. Arts, Inc.*, 745 F. Supp. 2d 1101 (N.D. Cal. Oct. 1, 2010)
30. *Englert, Inc. v. LeafGuard USA, Inc.*, 2009 WL 5031309 (D.S.C. Dec. 14, 2009)
31. *Gold Club-SF, LLC v. Platinum SJ Enter.*, 2013 WL 5273070 (N.D. Cal. Sept. 18, 2013)
32. *Greene v. Ablon*, 2012 WL 6597779 (D. Mass. Dec. 17, 2012)

33. Greenway Univ., Inc. v. Greenway of Arizona, L.L.C., 2011 WL 2669174 (D. Colo. July 7, 2011)
34. Hakkasan LV, LLC v. Tsang Hang Wang, 2013 WL 3944175 (D. Nev. July 30, 2013)
35. Harris Research, Inc. v. Lydon, 505 F. Supp. 2d 1161 (D. Utah Apr. 5, 2007)
36. Idylwilde, Inc. v. Umpqua Feather Merchs., LLC, 2014 WL 199201 (D. Or. Jan. 16, 2014)
37. JL Beverage Co., LLC v. Beam, Inc., 899 F. Supp. 2d 991 (D. Nev. Sept. 25, 2012)
38. Juicy Couture, Inc. v. Bella Int'l Ltd., 930 F. Supp. 2d 489 (S.D.N.Y. Mar. 12, 2013)
39. Just Tacos, Inc. v. Zezulak, 2011 WL 6140866 (D. Haw. Dec. 9, 2011)
40. Kalologie Franchising LLC v. Kalologie Skincare Med. Grp. of California, 2014 WL 953442 (C.D. Cal. Mar. 11, 2014)
41. Keep a Breast Found. v. Seven Grp., 2011 WL 2940290 (S.D. Cal. July 19, 2011)
42. Kerr Corp. v. N. Am. Dental Wholesalers, Inc., 2011 WL 2269991 (C.D. Cal. June 9, 2011)
43. Korum Auto. Grp., Inc. v. Salstrom Motors Inc., 2012 WL 135414 (W.D. Wash. Jan. 17, 2012)

44. KTM N. Am., Inc. v. Cycle Hutt, Inc., 2013 WL 1932797 (D.S.D. May 8, 2013)
45. Ledo Pizza Sys., Inc. v. Singh, 2013 WL 5781580 (D. Md. Oct. 24, 2013)
46. Lincoln Fin. Advisors Corp. v. Sagepoint Fin. Inc., 2009 WL 928993 (N.D. Ind. Apr. 2, 2009)
47. Marks Org., Inc. v. Joles, 784 F. Supp. 2d 322 (S.D.N.Y. Mar. 18, 2011)
48. Martha Elizabeth, Inc. v. Scripps Networks Interactive, LLC, 2011 WL 1750711 (W.D. Mich. May 9, 2011)
49. Maxim Integrated Prods., Inc. v. Quintana, 654 F. Supp. 2d 1024 (N.D. Cal. July 16, 2009)
50. Maya Swimwear, Corp. v. Maya Swimwear, LLC, 789 F. Supp. 2d 506 (D. Del. June 8, 2011)
51. Medtronic, Inc. v. Brasseler USA, Inc., 2011 WL 4899980 (D. Minn. Oct. 14, 2011)
52. Meineke Car Care Ctrs., Inc. v. Bica, 2011 WL 4829420 (W.D.N.C. Oct. 12, 2011)
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54. Miranda v. Guerrero, 2009 WL 1381250 (S.D. Fla. May 14, 2009)

55. *Mirina Corp. v. Marina Biotech*, 770 F. Supp. 2d 1153 (W.D. Wash. Mar. 7, 2011)
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57. *Mrs. U.S. Nat'l Pageant, Inc. v. Miss U.S. Org., LLC*, 875 F. Supp. 2d 211 (W.D.N.Y. July 13, 2012)
58. *MyGym, LLC v. Engle*, 2006 WL 3524474 (D. Utah Dec. 6, 2006)
59. *Mytee Prods., Inc. v. Shop Vac Corp.*, 2013 WL 5945060 (S.D. Cal. Nov. 4, 2013)
60. *Nat'l League of Junior Cotillions, Inc. v. Porter*, 2007 WL 2316823 (W.D.N.C. Aug. 9, 2007)
61. *N. Atl. Operating Co. v. Evergreen Distribs., LLC*, 2013 WL 5603602 (E.D.N.Y. Sept. 27, 2013)
62. *N. Atl. Operating Co. v. Evergreen Distribs., LLC*, 2013 WL 5603810 (E.D.N.Y. Sept. 30, 2013)
63. *Novus Optimum Labs v. Tamayo*, 2013 WL 3354566 (N.D. Cal. July 2, 2013)
64. *Paleteria La Michoacana, Inc. v. Productos Lacteos Tocumbo S.A. de C.V.*, 901 F. Supp. 2d 54 (D.D.C. Nov. 1, 2012)

65. People's United Bank v. Peoplesbank, 2010 WL 2521069 (D. Conn. June 17, 2010)
66. Petro Franchise Sys., LLC v. All Am. Props., Inc., 607 F. Supp. 2d 781 (W.D. Tex. Mar. 19, 2009)
67. PIU Mgmt., LLC v. Inflatable Zone Inc., 2010 WL 681914 (S.D. Tex. Feb. 25, 2010)
68. Potomac Conference Corp. of Seventh-Day Adventists v. Takoma Acad. Alumni Ass'n, 2014 WL 857947 (D. Md. Mar. 4, 2014)
69. Power Balance LLC v. Power Force LLC, 2010 WL 5174957 (C.D. Cal. Dec. 14, 2010)
70. Pretty Girl, Inc. v. Pretty Girl Fashions, Inc., 778 F. Supp. 2d 261 (E.D.N.Y. Mar. 14, 2011)
71. ProFoot, Inc. v. MSD Consumer Care, Inc., 2012 WL 2262904 (D.N.J. June 14, 2012)
72. Quigley v. Guvera IP Pty Ltd., 2010 WL 5300867 (N.D. Cal. Dec. 20, 2010)
73. Real-Time Reporters, P.C. v. Sonntag Reporting Servs., Ltd., 2013 WL 5818460 (N.D. Ill. Oct. 29, 2013)
74. Robinson v. Delicious Vinyl Records Inc., 2013 WL 3983014 (C.D. Cal. Aug. 1, 2013)

75. Rovio Entm't Ltd. v. Royal Plush Toys, Inc., 2012 WL 5936214 (N.D. Cal. Nov. 27, 2012)
76. Russell Rd. Food and Beverage, LLC v. Spencer, 2013 WL 321666 (D. Nev. Jan. 28, 2013)
77. Sara Lee Corp. v. Sycamore Family Bakery Inc., 2009 WL 3617564 (D. Utah Oct. 27, 2009)
78. Scarsdale Cent. Serv. Inc. v. Cumberland Farms, Inc., 2014 WL 930092 (S.D.N.Y. Mar. 7, 2014)
79. Scentsy, Inc. v. deDisse, 2010 WL 1579688 (D. Idaho Apr. 19, 2010)
80. Seed Servs., Inc. v. Winsor Grain, Inc., 868 F. Supp. 2d 998 (E.D. Cal. Apr. 12, 2012)
81. Sound Surgical Techs., LLC v. Leonard A. Rubinstein, M.D., P.A., 734 F. Supp. 2d 1262 (M.D. Fla. Aug. 12, 2010)
82. Stark v. Diageo Chateau & Estate Wines Co., 907 F. Supp. 2d 1042 (N.D. Cal. Nov. 1, 2012)
83. State Farm Mut. Auto. Ins. Co. v. Sharon Woods Collision Ctr., Inc., 2007 WL 4207158 (S.D. Ohio Nov. 26, 2007)
84. Steak n Shake Enters., Inc. v. Globex Co., 2013 WL 4718757 (D. Colo. Sept. 3, 2013)

85. Stuart J. Kaufman, M.D. & Assocs. v. Bausch & Lomb Inc., 2013 WL 6154166 (M.D. Fla. July 25, 2013)
86. SunEarth, Inc. v. Sun Earth Solar Power Co., 846 F. Supp. 2d 1063 (N.D. Cal. Feb. 3, 2012)
87. Sweet People Apparel, Inc. v. Fame of NY, Inc., 2011 WL 2937360 (D.N.J. July 19, 2011)
88. Sylvan Learning Inc. v. Learning Solutions, Inc., 795 F. Supp. 2d 1284 (S.D. Ala. June 17, 2011)
89. Team Gordon, Inc. v. Specialized Bicycle Components, Inc., 2010 WL 5058624 (C.D. Cal. Nov. 18, 2010)
90. Tecnimed SRL v. Kidz-Med, Inc., 763 F. Supp. 2d 395 (S.D.N.Y. Jan. 18, 2011)
91. Tile Outlet Always In Stock, Inc. v. Big Leaps, Inc., 2010 WL 5239229 (D. Nev. Dec. 16, 2010)
92. Tillery v. Leonard & Sciolla, LLP, 437 F. Supp. 2d 312 (E.D. Pa. June 9, 2006)
93. Titaness Light Shop v. Sunlight Supply, Inc., 2013 WL 4650413 (D. Nev. Aug. 29, 2013)
94. True Fit Corp. v. True & Co., 2013 WL 789213 (D. Mass. Mar. 4, 2013)
95. Ubiquiti Networks, Inc. v. Kozumi USA Corp., 2012 WL 2598997 (N.D. Cal. July 5, 2012)

96. Unitek Solvent Servs., Inc. v. Chrysler Grp. LLC, 2013 WL 5503087 (D. Haw. Sept. 30, 2013)
97. Volkswagen AG v. Verdier Microbus and Camper, Inc., 2009 WL 928130 (N.D. Cal. Apr. 3, 2009)
98. Vox Amplification Ltd. v. Meussdorffer, 2014 WL 558866 (E.D.N.Y. Feb. 11, 2014)
99. Warden v. Falk, 2011 WL 3204815 (E.D. Pa. July 27, 2011)
100. Well Care Pharmacy II, LLC v. W' Care, LLC, 2013 WL 3200111 (D. Nev. June 24, 2013)
101. Winmark Corp. v. Schneeberger, 2013 WL 1154506 (D. Colo. Mar. 19, 2013)
102. Women, Action & the Media Corp. v. Women in the Arts & Media Coal., Inc., 2013 WL 3728414 (D. Mass. July 12, 2013)

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**Additional Evidence of Actual Harm Required**

1. Adobe Sys. Inc. v. Kornrumpf, 2011 WL 6303358 (N.D. Cal. Dec. 16, 2011)
2. AFL Telecomms. LLC v. SurplusEZ.com, Inc., 2011 WL 5547855 (D. Ariz. Nov. 15, 2011)

3. Athleta, Inc. v. Pitbull Clothing Co., Inc., 2013 WL 142877 (C.D. Cal. Jan. 7, 2013)
4. BBK Tobacco & Foods, LLP v. Rocky Patel Premium Cigars, Inc., 2012 WL 3062677 (D. Ariz. July 26, 2012)
5. Boldface Licensing + Branding v. By Lee Tillett, Inc., 940 F. Supp. 2d 1178 (C.D. Cal. Mar. 11, 2013)
6. BoomerangIt, Inc. v. ID Armor, Inc., 2012 WL 2368466 (N.D. Cal. June 21, 2012)
7. Groupion, LLC v. Groupon, Inc., 826 F. Supp. 2d 1156 (N.D. Cal. Nov. 28, 2011)
8. iCall, Inc. v. Tribair, Inc., 2012 WL 5878389 (N.D. Cal. Nov. 21, 2012)
9. Innospan Corp. v. Intuit, Inc., 2010 WL 5157157 (N.D. Cal. Dec. 3, 2010)
10. Jumbo Bright Trading Ltd. v. GAP, Inc., 2012 WL 6721082 (C.D. Cal. Dec. 27, 2012)
11. Planet Coffee Roasters, Inc. v. Hung Dam, 2010 WL 625343 (C.D. Cal. Feb. 18, 2010)
12. Pro-Concepts, LLC v. Resh, 2013 WL 5741542 (E.D. Va. Oct. 22, 2013)
13. Purdum v. Wolfe, 2014 WL 171546 (N.D. Cal. Jan. 15, 2014)

14. Signeo USA, LLC v. SOL Republic, Inc.,  
2012 WL 2050412 (N.D. Cal. June 6,  
2012)
  15. Spiraledge, Inc. v. SeaWorld Entm't,  
Inc., 2013 WL 3467435 (S.D. Cal. July  
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