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NORTHERN DISTRICT OF CALIFORNIA

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11 UNITED STATES DISTRICT COURT
12 NORTHERN DISTRICT OF CALIFORNIA

13 PHISH, INC., a Delaware corporation, and)
14 WHO IS SHE? MUSIC, INC., a Delaware)
15 corporation,)

16 Plaintiffs,

17 v.

18 SEAN KNIGHT, aka WALDO, an)
19 individual and doing business as B-SHARP)
20 CLOTHING, GLIDE CLOTHING,)
21 KNIGHTHOOD CLOTHING,)
22 KNIGHTHOOD MERCHANDISE,)
23 PORCUPINE GRAPHIX, SURFIN')
24 SAFARI, INC., and TRUE VIBES;)
25 KNIGHT-MACKIN, INC., a Delaware)
26 corporation doing business as B-SHARP)
CLOTHING, GLIDE CLOTHING,)
KNIGHTHOOD CLOTHING,)
KNIGHTHOOD MERCHANDISE,)
PORCUPINE GRAPHIX, SURFIN')
SAFARI, INC., and TRUE VIBES; AXIS)
ENTERPRISES; and JOANNE READER,)
an individual,)

Defendants.)

CASE NO. C 01 1147 PJH

**DEFENDANTS' MEMORANDUM OF
POINTS AND AUTHORITIES IN SUPPORT
OF OPPOSITION TO PLAINTIFFS'
APPLICATION FOR A PRELIMINARY
INJUNCTION**

Date: May 16, 2001
Time: 9:00 a.m.
Courtroom: D

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1 Defendants Sean Knight ("Knight"), Joanne Reader ("Reader"), and Axis Enterprises
2 (collectively hereinafter, "defendants"), by and through their attorneys, hereby submit this
3 memorandum of points and authorities opposing plaintiffs' application for a preliminary
4 injunction, and state as follows:

5 INTRODUCTION

6 On March 21, 2001, plaintiffs in this matter, Phish, Inc. ("Phish") and Who Is She?
7 Music ("WISM") (collectively hereinafter "plaintiffs") filed their complaint and *ex parte*
8 application for a temporary restraining order against defendants alleging that defendants have,
9 *inter alia*, infringed on plaintiffs' copyrights and trademarks through sales of tee-shirts and
10 other merchandise which incorporate song titles and song lyrics of the band Phish. Plaintiffs
11 simultaneously applied to the Court for a preliminary injunction enjoining the sale of the
12 allegedly infringing merchandise.

13 Plaintiffs' application for a preliminary injunction – although rife with unsupported
14 allegations of misconduct by the defendants – utterly fails to demonstrate that defendants have
15 infringed on plaintiffs' trademarks or copyrighted material. Plaintiffs' attempts to paint an
16 unflattering portrait of the defendants by casting aspersions on their character is simply a
17 barefaced attempt to prejudice the Court against defendants and turn the focus of this case away
18 from the actual facts of the long and somewhat convoluted history of the parties' relationship
19 with each other. As shown in greater detail below, plaintiffs were not only aware of defendants'
20 (now allegedly infringing) conduct for at least eight years, but at various times over that period
21 expressly gave the defendants permission to sell certain tee-shirt designs (which plaintiffs now
22 allege infringe on their copyrights and trademarks), and acquiesced in the sale of other tee-shirts
23 and merchandise. Now, some eight years after the defendants began operating their small
24 business in Vermont, plaintiffs – who are headquartered in Vermont – have opted to file suit in
25 California without a scintilla of evidence that jurisdiction is proper here, knowing full well that

1 defendants have limited financial resources, and will face extraordinary hardship and expense in
2 litigating this matter here.¹ Plaintiffs' application for a preliminary injunction is unfounded, and
3 should be denied.

4 **STATEMENT OF ISSUES**

5 1. Whether the Court lacks jurisdiction to enter a preliminary injunction against
6 defendants.

7 2. Whether plaintiffs have demonstrated that a likelihood of confusion exists under
8 the Lanham Act, 15 U.S.C. §1114 *et seq.*, sufficient to justify the entry of a preliminary
9 injunction on plaintiffs' trademark infringement claims.

10 3. Whether plaintiffs have have demonstrated a likelihood of success under the
11 Copyright Act, 17 U.S.C. §101 *et seq.*, sufficient to justify the entry of a preliminary injunction
12 on plaintiffs' copyright infringement claims.

13 **STATEMENT OF FACTS**

14 Plaintiffs in this matter are Delaware corporations whose principal places of business are
15 located in Burlington, Vermont. (Complaint, ¶¶ 1, 2). Plaintiffs promote the musical group
16 Phish, and promote, produce, and sell merchandise bearing trademarks and copyrights owned
17 by plaintiffs. (Complaint, ¶ 23). On March 21, 2001, plaintiffs filed a 9-count complaint against
18 defendants alleging trademark infringement, dilution, and false designation of origin under the
19 Lanham Act; copyright infringement; common law trademark and trade name infringement;
20 unfair competition; trademark dilution under California law; commercial misappropriation of
21 name and likeness; and conspiracy. (*See* Complaint).

22 Defendants, who are registered under the trade name Surfin Safari in Vermont, and do
23 business as Knighthood Merchandise (Knight Decl., ¶3), are residents and domiciliaries of the

24 _____
25 ¹ Plaintiffs also must acknowledge that virtually all the witnesses who have testimony relevant to this
26 dispute – including plaintiffs' own employees – are located either in Vermont or on the East Coast.

1 State of Vermont. (Knight Decl., ¶2). Knighthood Merchandise is a small business that sells
2 tee-shirts and other clothing items over the internet via its website – www.knighthoodtees.com
3 – as well as at trade shows and various retail outlets. (Knight Decl., ¶3). The tee-shirts and other
4 items sold primarily parody song titles and lyrics of various bands, including Phish, by placing
5 them in humorous contexts and conflating the song titles and lyrics with other commercial
6 products. (Knight Decl., ¶4, and Exhibits A and B thereto). Thus, by way of example,
7 defendants sell a tee-shirt with the word "Glide" on it (which is the title of a Phish song) that
8 parodies an advertisement for Tide laundry detergent; defendants sell another tee-shirt with the
9 word "Bouncin'" on it (which is a portion of a Phish song title) that parodies an advertisement
10 for Bounce fabric softener. (Knight Decl., ¶4, and Exhibits A and B thereto). Other tee-shirts
11 and items sold by the defendants similarly parody other commercially available products.
12 (Knight Decl., ¶4, and Exhibits A and B thereto). With the exception of one tee-shirt design
13 which spells out the word "Phish" by creatively arranging images of antelope in various poses,
14 (See Knight Decl. ¶5, and Exhibit C thereto), defendants' tee-shirt designs bear no resemblance
15 whatsoever to the tee-shirts sold by plaintiffs. (Knight Decl., ¶5, and Exhibit A thereto).

16 Though plaintiffs – in their effort to paint defendants' conduct as iniquitous – make
17 unfounded allegations that "defendants have a history of disappearing when threatened with
18 legal action," (Plaintiff's Memo., p. 6:7-9), and that "despite plaintiffs' best efforts, defendants
19 could not...be located," (Id., p. 6:10-11), the unvarnished truth is that defendants never
20 "disappeared," and that plaintiffs either knew where defendants were, (Knight Decl., ¶¶7, 8), or
21 could easily have located them by contacting defendants' former attorney, with whom plaintiffs
22 were in contact at the time of defendants' alleged "disappearance." (Knight Decl., ¶7). Plaintiffs'
23 "best efforts" apparently did not extend to picking up the telephone or conducting even the most
24 rudimentary online search, either of which would have enabled plaintiffs to locate defendants
25 during the last five years. (Lawrence Decl., ¶3). Given that various of plaintiffs' employees

1 actually know the primary defendant in this matter, Sean Knight, and not only have seen him
2 frequently over the last eight years but also had occasion to speak with him, (Knight Decl., ¶7,
3 8), plaintiffs' allegations that they have vigorously attempted to pursue their claims against
4 defendants are facially ridiculous. During this period, plaintiffs had actual knowledge that
5 defendants were openly selling the merchandise now complained of, and on several occasions
6 plaintiffs' employees not only expressly indicated to defendants that they could sell this (now
7 allegedly infringing) merchandise, but actually requested various tee-shirts for members of the
8 band Phish. (Knight Decl., ¶¶8, 9, and Exhibit D thereto).

9 Although plaintiffs and their employees reside in Vermont, and are aware that
10 defendants all reside in Vermont, plaintiffs have nonetheless attempted to invoke this Court's
11 jurisdiction by means of unsupported allegations that "on information and belief" defendants
12 are "transacting business in this district," (Complaint, ¶¶3-6), and by blatantly attempting to
13 manufacture evidence of such transactions through the auspices of their private investigator,
14 who at plaintiffs' request purchased merchandise from defendants' website from his home in
15 California. (Donnelly Decl., ¶¶1, 2). Plaintiffs have produced no evidence that jurisdiction in
16 California is proper, however, nor shown that defendants' sales of tee-shirts and related
17 merchandise infringe on plaintiffs' copyrighted lyrics or unregistered song titles. Plaintiff's
18 request for injunctive relief therefore must be denied.

19 ARGUMENT

20 **I. PLAINTIFFS ARE NOT ENTITLED TO INJUNCTIVE RELIEF**

21 **A. Legal Standard For A Preliminary Injunction**

22 To obtain a preliminary injunction, the moving party must show either (1) a combination
23 of probable success on the merits and the possibility of irreparable injury, or (2) that serious
24 questions are raised and the balance of hardships tips sharply in the moving party's favor. *See*
25 *Dr. Seuss Enter., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997). These

1 formulations are not different tests, "but represent two points on a sliding scale in which the
2 degree of irreparable harm increases as the probability of success on the merits decreases." *Id.*
3 at 1397. Under either formulation, "the moving party must demonstrate a significant threat of
4 irreparable injury." *Big Country Foods, Inc. v. Board of Educ.*, 868 F.2d 1085, 1088 (9th Cir.
5 1989). Defendants submit that plaintiffs have not established that they are substantially likely to
6 prevail on the merits in this matter, nor that they are likely to suffer irreparable injury absent the
7 entry of an injunction; neither have they shown that serious questions are raised or that the
8 balance of hardships weighs in their favor.

9 **B. This Court Lacks Jurisdiction To Enjoin Defendants' Conduct**

10 This Court may not enter a preliminary injunction in the absence of personal jurisdiction
11 over defendants. *See Ruhrgas AG v. Marathon Oil Co.*, 526 U.S. 574 (1999)(without personal
12 jurisdiction court "is powerless to proceed to an adjudication"). As stated in greater detail in
13 defendants' motion to dismiss for lack of jurisdiction, this Court has neither general nor specific
14 jurisdiction over defendants, and therefore may not enter an injunction against them.²

15 **C. Plaintiffs Have Failed To Prove That Their Unregistered Song Titles**
16 **Have Secondary Meaning**

17 To determine the degree of protection a trademark deserves, courts typically categorize
18 marks as "fanciful, arbitrary, suggestive, descriptive, or generic, in descending order of
19 strength." *Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 464 (4th Cir. 1996). Fanciful,
20 arbitrary, and suggestive marks are inherently distinctive and receive the highest degree of
21 trademark protection; descriptive marks are not inherently distinctive, and receive trademark
22 protection only upon a showing that the mark possesses secondary meaning; and generic marks
23 receive no protection. *Id.*

24 _____
25 ² In lieu of repeating arguments before the Court in defendants' motion to dismiss, defendants incorporate
26 these arguments herein by reference as though fully set forth above.

1 Typically, courts have not applied this analytical analysis to titles of single expressive
2 works; instead, they have assumed that the title of a single work is entitled to trademark
3 protection *only* upon a showing of secondary meaning, without classifying that title as a
4 descriptive mark. *See, e.g., Sugar Busters LLC v. Brennan*, 177 F.3d 258, 269 (5th Cir.
5 1999)(holding that title of a single literary work may be subject to trademark protection on a
6 showing of secondary meaning); *Morgan Creek Productions Inc. v. Capital Cities/ABC Inc.*,
7 1991 U.S. Dist. LEXIS 20564 (C.D. Cal. 1991)(holding that movie title must have acquired
8 secondary meaning to be subject to trademark protection).

9 A mark has secondary meaning when, "in the mind of the public, the primary
10 significance of a product feature or term is to identify the source of the product rather than the
11 product itself." *Sara Lee Corp., supra*, 81 F.3d at 464. It follows from this general principle that
12 the title of a song has secondary meaning when "the title is sufficiently well known that
13 consumers associate it with a particular author's work." *Rogers v. Grimaldi*, 875 F.2d 994, 998
14 (2d Cir. 1989). In determining secondary meaning, courts consider a non-exclusive list of
15 factors which include the following: the extent of sales and advertising leading to buyer
16 association, length of use, exclusivity of use, the fact of copying, customer surveys, customer
17 testimony, the use of the mark in trade journals, the size of the company, the number of sales,
18 the number of customers, and actual confusion. *See Ford Motor Co. v. Summit Motor Products,*
19 *Inc.*, 930 F.2d 277, 292 (3d Cir. 1991).

20 In the case at bar, plaintiffs have failed to provide any evidence of secondary meaning in
21 Phish's song titles. They have produced no consumer surveys, no customer testimony, no
22 records of album sales, nor virtually any evidence other than the statement that Phish has played
23 over 1,400 concerts. (Shapiro Decl., ¶8). This statement does not establish secondary meaning
24 in Phish's song titles by any stretch of the imagination. *See Apple Corps. Limited v. Button*
25 *Master, P.C.P., Inc.*, 1998 U.S. Dist. LEXIS 3366 (E.D. Pa. 1998)(holding that the sale of 8

1 million copies of the Beatles' 3-album "Anthology" in a year was insufficient to prove
2 secondary meaning in their song titles, as this constituted "a mere scintilla of evidence").

3 The only other evidence that plaintiffs offer in support of their claim that Phish's song
4 titles have secondary meaning are self-serving declarations by their own employees that "each
5 of these song titles immediately evokes Phish in the minds of the members of the Phish Fan
6 Base and accordingly has acquired secondary meaning." (Skelton Decl., ¶5; Shapiro Decl.,
7 ¶7(j)). Plaintiffs' own employees' opinions about the existence of secondary meaning does not
8 serve to resolve this issue in plaintiffs' favor, however, as "evidence of secondary meaning from
9 a partial source possesses very limited probative value." *Filipino Yellow Pages, Inc. v. Asian*
10 *Journal Publications, Inc.*, 198 F.3d 1143 (9th Cir. 1999); *see also Norm Thompson Outfitters,*
11 *Inc. v. GM Corp.*, 448 F.2d 1293, 1297 (9th Cir. 1971)(finding that the testimony of plaintiff's
12 friend possessed "little value in establishing secondary meaning," insofar as testimony from
13 persons closely associated with the plaintiff does not adequately reflect the view of the buying
14 public).

15 Plaintiffs' argument that their song titles have secondary meaning is frustrated not only
16 by their lack of supporting evidence, but also by the generic nature of the song titles themselves.
17 Plaintiffs would have this Court rule that everyday words and phrases such as "Ghost", "Glide",
18 "Gumbo", "Llama", "Simple", "Stash", "Piper", "Free", "Mound", "Rift", "Sand", "Sanity",
19 "Possum", "Buried Alive", and "Heavy Things" should be taken out of the common lexicon,
20 and that no one should be permitted to sell a tee-shirt bearing any of these words and phrases
21 unless plaintiffs have given them express permission to do so. Contrary to plaintiffs' contention,
22 these words do not automatically identify the source from which they sprang as Phish song
23 titles.³ *See Apple Corps., supra*, at pp. 30-32 (ruling that buttons bearing the words and phrases

24
25 ³ The court should take note that none of the words or phrases identified above appear on any products
26 sold by the plaintiffs.

1 "Help!", "Let It Be", "Yesterday", "All You Need Is Love", "A Hard Days' Night", and "I Get
2 By With A Little Help From My Friends" do not automatically conjure up or identify
3 themselves as Beatles' song titles). Plaintiffs' argument further strains credulity when one
4 considers their assertion that defendants are barred from selling hats or tee-shirts with an
5 antelope insignia on it simply because plaintiffs have a song entitled "Run Like An Antelope,"
6 or from selling tee-shirts bearing the word "pooH" because plaintiffs have a song entitled
7 "Harry Hood."⁴ Because plaintiffs have utterly failed to show that these song titles have
8 secondary meaning, these titles are not entitled to trademark protection. *See* McCarthy,
9 *Trademarks and Unfair Competition* §10.02 (3d ed. 1996)("Courts have given trademark
10 protection to literary titles of one-shot, single works only upon a showing of secondary
11 meaning").

12 **D. Plaintiffs Have Shown No Likelihood of Confusion**

13 The Ninth Circuit evaluates likelihood of confusion by reference to (1) the strength of
14 the mark, (2) the relationship between the services identified by the competing marks, (3) the
15 similarity between the competing marks, (4) evidence of actual confusion, and (5) the junior
16 user's intent in selecting the mark. *Rodeo Collection, Ltd. v. West Seventh*, 812 F.2d 1215, 1217
17 (9th Cir. 1987). To justify the entry of an injunction, consumer confusion "must be probable,
18 not merely possible." *Id.* Reviewing all of the above-listed factors, it is apparent that plaintiffs
19 have failed to show that any consumer is likely to be confused as to the origin of defendants'
20 merchandise.

21 **1. Plaintiffs' Marks Are Not Strong, But Unprotected**

22 Plaintiffs argue that their marks are "arbitrary" and thus entitled to the highest degree of
23 trademark protection. (Plaintiffs' Memo., p. 13:11-14). Focusing in on plaintiffs' argument,

24 ⁴ Apparently, plaintiffs' argument is that since "pooH" read upside down is "Hood" (i.e., if one spins a
25 piece of paper with the word "pooH" on it 180 degrees it reads "Hood"), use of the word "pooH" calls to mind and
26 thus infringes on the song title "Harry Hood."

1 however, it is apparent that the "marks" plaintiff is referring to are limited to (1) the word
2 "Phish" and (2) the related design mark (a fish comprised of the word "Phish"), both of which
3 appear on the Principle Register. For the purposes of this motion, defendants do not dispute that
4 these marks are entitled to trademark protection, nor that they are relatively strong.

5 However, defendants *do* dispute any argument that plaintiffs' unregistered song titles are
6 entitled to any degree of protection absent a showing of secondary meaning. *See Sugar Busters,*
7 *supra*, at p. 269. As discussed above, plaintiffs have failed to produce any evidence of
8 secondary meaning in their song titles. The declarations of plaintiffs' own employees that
9 Phish's song titles "would immediately invoke Phish in the minds of members of the Phish Fan
10 Base," (Skelton Decl., ¶3), combined with their counsel's conclusory assertion that the band has
11 attained a certain "notoriety," (Plaintiffs' Memo., p. 14:22), do nothing to establish secondary
12 meaning. Plaintiffs' bald assertions that their song titles have secondary meaning simply do not
13 make it so.

14 **2. The Services Identified By The Marks Are Different**

15 To the extent plaintiffs' song titles identify anything, they merely identify a particular
16 song sung by Phish. *See, e.g., Estate of William F. Jenkins v. Paramount Pictures*, 90 F.Supp.2d
17 706, 715 (E.D.Va. 2000)("the title of a single expressive work is descriptive of that work, no
18 matter how that work is packaged or from what source it is derived"). Although plaintiffs are in
19 the business of selling Phish's songs and music, they do not sell tee-shirts bearing Phish song
20 titles, nor any other form of merchandise bearing such titles.

21 Defendants, on the other hand, do not market or sell music in any fashion. Their
22 business is strictly limited to the sale of clothing and related merchandise that, in large part,
23 spoofs or parodies songs (and the song's creators) by incorporating song titles into the logos or
24 advertisements of unrelated commercial products. (See Knight Decl., ¶4, and Exhibits A and B
25 thereto). The services identified by the parties' respective uses of plaintiffs' song titles are thus

1 entirely distinct.

2 **3. The Marks Are Not Similar**

3 Plaintiffs' mantra, liberally sprinkled throughout their brief, is that "not only do
4 defendants use marks identical to plaintiffs marks, but defendants use the marks on the exact
5 same type of goods" that plaintiffs sell. (Plaintiffs' Memo., p. 12:5-7). This refrain is repeated in
6 various forms on pages 11, 15, 17, 18, 19, and 20 of plaintiffs' brief, and the inference that one
7 is intended to draw from this repetition is that defendants are selling goods that are "identical"
8 to those being sold by plaintiffs. Indeed, on the opening page of their brief plaintiffs go so far as
9 to define the goods sold by defendants as "Counterfeit Merchandise," (Plaintiff's Memo., p. 1),
10 which then enables them to argue at length that they are merely seeking to halt the
11 dissemination of "counterfeit" goods. (Plaintiffs' Memo., pp. 2, 3, 4, 5, 6).

12 A close examination of the declarations offered in support of plaintiffs' allegations,
13 however, reveals that the only tee-shirt that plaintiffs and defendants both sell that even
14 arguably could be called "identical" is a tee-shirt bearing the word "Phish." (See Skelton Decl.,
15 ¶11, ln. 27; Shapiro Decl., ¶20, ln. 28). Even a cursory comparison of the tee-shirt sold by
16 defendants bearing this word reveals that it looks nothing like any of the tee-shirts sold by
17 plaintiffs,⁵ and does not meet the standard dictionary definition of a "counterfeit," as a "copy" or
18 "imitation" that is intended to deceive. *See Black's Law Dictionary* (6th ed. 1990). The fact that
19 the word "Phish" appears on this tee-shirt does not make it a counterfeit of plaintiffs'
20 merchandise any more than a caricature of the Mona Lisa could reasonably be considered a
21 "counterfeit" of Da Vinci's painting. Certainly, it is not a counterfeit as commonly understood
22 under the Lanham Act. *See, e.g., Rolex Watch, U.S.A., Inc. v. Michel Co.*, 179 F.3d 704 (9th Cir.
23 1999)(defendant selling fake Rolex watches); *United States v. Petrosian*, 126 F.3d 1232 (9th

24 _____
25 ⁵ For purposes of comparison, the relevant tee-shirt designs are found in Exhibit A to the Skelton
26 Declaration, and Exhibit C to the Knight Declaration.

1 Cir. 1998)(defendant filled empty Coca Cola bottles with its own product and attempted to sell
2 them as genuine Coca Cola); *Levi Strauss & Co. v. Shilon*, 121 F.3d 1309 (9th Cir.
3 1997)(defendant planned to affix Levi's labels to jeans and sell them as genuine Levi's).

4 Plaintiffs' attempts to reinforce their argument by repeated reference to the "fact" that
5 defendants are selling identical goods is not only disingenuous and misleading, but simply
6 untrue. Plaintiffs' protestations of "counterfeiting" ring hollow when one considers that – apart
7 from the tee-shirt bearing the word "Phish" – plaintiffs have identified no other tee-shirt or
8 product that is sold both by plaintiffs and defendants. While that particular tee-shirt sold by
9 defendants may indeed be similar to tee-shirts sold by plaintiffs (although it is certainly not
10 identical), plaintiffs here seek to enjoin defendants from selling all of defendants' other,
11 *dissimilar* tee-shirts and merchandise based on a broad overstatement of the facts in this case.
12 Simply put, defendants' tee-shirts bear no similarity to those sold by plaintiffs.

13 4. There Is No Evidence Of Actual Confusion

14 Plaintiffs have known about defendants' sales of tee-shirts for the last eight years.
15 (Knight Decl., ¶¶8, 9). According to plaintiffs, during this period "there have been numerous
16 documented instances where consumers confuse the source of defendants' products and attribute
17 them to plaintiffs." (Plaintiffs' Memo., p. 15:20-21). In support of this assertion, plaintiffs have
18 produced evidence of a total of *two* instances of actual confusion by consumers – a misdirected
19 order for defendants' merchandise, and a misdirected request for a product catalogue. (Plaintiffs'
20 Memo., p. 16). By any definition, proof of two confused consumers over an eight year period
21 does not equate to "numerous" instances of confusion. *See, e.g., Pignons S.A. de Macanique de*
22 *Precision v. Polaroid Corp.*, 657 F.2d 482, 490 (1st Cir. 1981)("a single misdirected
23 communication is very weak evidence of consumer confusion"); *Hasbro, Inc. v. Clue*
24 *Computing, Inc.*, 66 F.Supp.2d 117, 124 (D.Mass. 1999)("The fact that one, two or three people
25 over four years may have expressed confusion...does not constitute the level of actual confusion

1 necessary to support a general finding of likelihood of confusion"); *Black Dog Tavern Co., Inc.*
2 *v. Hall*, 823 F.Supp. 48 (D. Mass. 1993)(an "isolated comment is not persuasive evidence of
3 actual confusion").

4 Plaintiffs attempt to bolster their argument that actual confusion exists by – again –
5 relying on the declarations of their own employees. The declaration of Phish's Director of Tour
6 Merchandising that she has "regularly spoken with various wholesalers and retailers at trade
7 shows" who approached plaintiffs exhibit booth seeking defendants' merchandise, (Skelton
8 Decl., ¶14), and that "over the years, [plaintiffs'] sales staff has regularly taken calls from retail
9 stores and fans looking for [defendants'] merchandise" is obviously not documented evidence of
10 customer confusion, but simply a self-serving attempt to raise the issue of confusion. Had the
11 plaintiffs wanted to raise the issue, they should have provided the Court with evidence
12 (including survey evidence) indicating that consumer confusion actually occurred. Although it
13 is true that the plaintiffs need only demonstrate a likelihood of confusion and not actual
14 confusion to warrant equitable relief, *see Warner Bros., Inc. v. Gay Toys, Inc.*, 658 F.2d 76, 79
15 (2d Cir. 1981), the Court may properly infer that there is no likelihood of confusion from
16 plaintiffs' failure to come forward with evidence of actual confusion. *Tetley, Inc. v. Topps*
17 *Chewing Gum, Inc.*, 556 F.Supp. 785, 791 (E.D.N.Y. 1983); *see also Universal City Studios,*
18 *Inc. v. T-Shirt Galley, Ltd.*, 634 F.Supp. 1468, 1478 (S.D.N.Y. 1986)(finding no likelihood of
19 confusion in the absence of survey evidence indicating actual consumer confusion).
20 The plaintiffs have not produced meaningful evidence of actual confusion here. "Absent
21 evidence of actual confusion, when the marks have been in the same market, side by side, for a
22 substantial period of time, there is a strong presumption that there is little likelihood of
23 confusion." *Pignons, supra*, at p. 490.

24 5. The Intent To Spoof or Parody

25 Based on a patently ridiculous reading of two letters from one of the defendants,

1 plaintiffs' assert that defendants hold themselves out as "bootleggers," and argue that the sale of
2 defendants' merchandise is thus, *ipso facto*, "illegal bootlegging." (Plaintiffs' Memo., p. 17).

3 Nothing could be further from the truth. Defendants' intent in adopting its tee-shirt
4 designs was to parody the plaintiffs' songs and spoof the commercial advertisements in which
5 the song titles appear. (Knight Decl., ¶4). Although the plaintiffs apparently do not see the
6 humor in defendants' parodies, plaintiffs cannot use the federal trademark laws to enjoin a joke
7 at their expense. *See Hormel Foods Corp. v. Henson*, 73 F.3d 497, 506 (2d Cir. 1996)(refusing
8 to enjoin sale of the Muppet character Spa'am as a protected parody of Spam potted meat);
9 *Jordache Enter. v. Hogg Wyld, Ltd.*, 828 F.2d 1482 (10th Cir. 1987)(rejecting Jordache's
10 Lanham Act claim against maker of "Lardashe" blue jeans for larger women); *Tetley, Inc. v.*
11 *Topps Chewing Gum, Inc.*, 556 F.Supp. 785 (E.D.N.Y. 1983)(refusing to issue preliminary
12 injunction against maker of "Petley Flea Bags" stickers that were designed to be a replica of the
13 Tetley Tea Bags box); *Girl Scouts v. Personality Posters Manufacturing Co.*, 304 F.Supp. 1228
14 (S.D.N.Y. 1969)(refusing to issue preliminary injunction against maker of poster showing an
15 obviously pregnant girl dressed in a Girl Scout uniform and bearing the motto "Be Prepared").
16 As the Tenth Circuit noted not long ago, "No one likes to be the butt of a joke, not even a
17 trademark. But the requirement of trademark law is that a likely confusion of source,
18 sponsorship or affiliation must be proven, which is not the same thing as a 'right' not to be made
19 fun of." *Jordache, supra*, at p. 1486.

20 Plaintiffs seem to have forgotten that "when businesses seek the national spotlight, part
21 of the territory includes accepting a certain amount of ridicule." *Nike, Inc. v. "Just Did It"*
22 *Enterprises*, 6 F.3d 1225 (7th Cir. 1993). The First Amendment, which protects individuals
23 from laws infringing free expression, allows such ridicule in the form of parody. *Hustler*
24 *Magazine, Inc. v. Falwell*, 485 U.S. 46 (1988). Parody, which dates back to Greek antiquity, has
25 been defined as a "literary or artistic work that imitates the characteristic style of an author or a
26

1 work for comic effect or ridicule," *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580
2 (1994), and as an "imitation of a work more or less closely modeled on the original, but turned
3 so as to produce a ridiculous effect." *Charles Atlas, Ltd. v. DC Comics, Inc.*, 112 F.Supp.2d
4 330, 338 (S.D.N.Y. 2000). In the instant case, the trick upon the perception of the viewer – who
5 from across the room may very well believe that someone wearing defendants' "High Geere"
6 tee-shirt is wearing a "John Deere" tee-shirt (both shirts have almost identical antelope logos),
7 or that defendants' "LLAma" tee-shirt is actually an "LLBean" tee-shirt (as the background
8 design is nearly identical) – is part of the joke defendants are perpetrating. This sort of word
9 play has been upheld as fair use of trademarks by courts. *See Nike, supra*, at p. 1227 (sale of
10 tee-shirts with a "swoosh" design identical to Nike's but with the word "MIKE" instead of
11 "NIKE" held to be fair use).

12 Plaintiffs' chief complaint is that defendants' use of plaintiffs' song titles on their tee-
13 shirts improperly trades on plaintiffs' goodwill in those songs. (Plaintiffs' Memo., p. 17).
14 Plaintiffs' argument misses the point, however, that "when a parody takes aim at a particular
15 original work, the parody must be able to 'conjure up' at least enough of the original to make the
16 object of its critical wit recognizable." *Campbell, supra*, at p. 588. The keystone of parody is
17 imitation, as "a parody must convey two simultaneous – and contradictory – messages: that it is
18 the original, but also that it is not the original and is instead a parody." *Cliff Notes, Inc. v.*
19 *Bantam Doubleday Dell Publishing Group, Inc.*, 886 F.2d 490, 494 (2d Cir. 1989). The parody
20 is only effective, of course, to the extent that people understand that a joke that is intended to be
21 conveyed. Though plaintiffs clearly do not appreciate the jokes that defendants are making,
22 their distaste does not change the fact that defendants' parodies are a form of expression
23 protected by the First Amendment, and deserve "substantial freedom -- both as entertainment
24 and as a form of social and literary criticism." *Berlin v. E.C. Publications, Inc.*, 329 F.2d 541,
25 545 (2d Cir. 1964).

1 **E. Plaintiffs Have Shown No Likelihood Of Success On Their Copyright**
2 **Infringement Claim**

3 Plaintiffs assert that defendants have infringed on their copyrights by copying short
4 portions of plaintiffs' song lyrics onto tee-shirts and stickers. (Plaintiffs' Memo., p. 21-22). To
5 the extent that these song lyrics duplicate plaintiffs' song titles, plaintiffs are not entitled to any
6 relief under the Copyright Act. *See, e.g., Shaw v. Lindheim*, 919 F.2d 1353 (9th Cir. 1990)("a
7 title cannot be copyrighted").⁶

8 Plaintiffs similarly are not entitled to relief under the Copyright Act for the use of
9 phrases that are that are unoriginal or cliched. Section 102 of the Copyright Act provides
10 copyright protection only for "original works of authorship." 17 U.S.C. §102. Originality is the
11 "one pervading element" essential for copyright protection. *L.Batlin & Son, Inc. v. Snyder*, 536
12 F.2d 486, 489 (2d Cir. 1976). While the test for originality has a low threshold, the author "must
13 contribute more than a trivial variation to a previous work." *Id.* However, there is a class of
14 cases where even admittedly independent efforts may be deemed too trivial or insignificant to
15 support copyright protection. *See Nimmer on Copyright §2.01 (1985)*. Under regulations
16 promulgated pursuant to the Copyright Act, "words and short phrases such as names, titles, and
17 slogans" are not subject to copyright protection. 37 C.F.R. §202.1(a) (1992). In addition, "even
18 if a work as a whole is copyrightable, copyright protection does not extend to its component
19 parts that are not." *Apple Computer, Inc. v. Microsoft Corp.*, 799 F.Supp. 1006, 1020 (N.D.Cal.
20 1992).

21 In the case at bar, plaintiffs have alleged that the following portions of their song lyrics
22 are entitled to copyright protection: (1) "lingering slowly, melting away"; (2) "I hope this
23 happens once again"; (3) "I knew my time had come"; (4) "in a minute I'll be free"; (5) "high
24

25 ⁶ Plaintiffs' claim that defendants use of the lyric "Bouncin Around the Room" (from the song "Bouncing
26 Around The Room") constitutes copyright infringement is thus facially invalid.

1 geere"; (6) "sharing in the groove." (Plaintiffs' Memo., pp. 21-22). However, these are precisely
2 the sort of fragmentary words and phrases that have been denied copyright protection. *See*
3 *Jeffrey v. Cannon Films, Inc.*, 1987 U.S. Dist. LEXIS 14949 (C.D. Cal. 1987) (phrase "Over the
4 top" not entitled to copyright protection); *see also Perma Greetings, Inc. v. Russ Berrie & Co.,*
5 *Inc.*, 598 F. Supp. 445 (E.D. Mo. 1984) (phrases "Hang in there", "Along the way take time to
6 smell the flowers", "A friend is someone special", "I love my mug", and "good friends are hard
7 to find" all unprotected by copyright); *Alberto-Culver Co., v. Dumon*, 466 F.2d 705 (7th Cir.
8 1972) (the phrase "most personal sort of deodorant" not subject to copyright protection).

9 The fact that plaintiffs have a copyright in their song lyrics does not grant it an
10 expansive monopoly over "isolated words and phrases" from those songs, particularly when
11 they are such stock phrases as "I knew my time had come." Even an abbreviated search for
12 other users of this cliché demonstrates its ubiquitous nature. (Lawrence Decl., ¶4, and Exhibit F
13 thereto). A database search incorporating the other phrases plaintiffs seek copyright protection
14 for similarly demonstrates that these phrases are in widespread use, and not "original" to the
15 plaintiffs in any meaningful way. (Lawrence Decl., ¶4, and Exhibits B-E and G thereto).
16 Lacking originality, these common phrases are not protected under the Copyright Act. Plaintiffs
17 thus cannot show a likelihood of prevailing on their copyright infringement claim.

18 **F. No Presumption Of Irreparable Harm Exists**

19 Plaintiffs have failed to demonstrate that any trademark or copyright infringement has
20 taken place in this matter, and thus are not entitled to a presumption of irreparable injury.
21 Moreover, plaintiffs have failed to come forth with any evidence that defendants' conduct has
22 caused them to suffer even minimal harm. Having failed to show that they have been damaged
23 in any way, plaintiffs' application for a preliminary injunction must be denied.

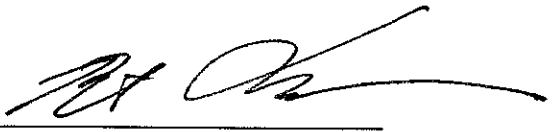
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CONCLUSION

For the foregoing reasons, defendants respectfully request that this Honorable Court deny plaintiffs' application for a preliminary injunction.

Dated: April 25, 2001

COLLETTE & ERICKSON LLP

By: 

Robert S. Lawrence
Attorneys for Defendants
SEAN KNIGHT, JOANNE READER,
and AXIS ENTERPRISES

1 PROOF OF SERVICE

2
3 I, MARCIA L. ZWICK, declare:

4 I am employed in the City and County of San Francisco, State of California. My business
5 address is 555 California Street, Suite 4350, San Francisco, California 94104. I am over the age of
6 18 years and not a party to the foregoing action.

7 On April 25, 2001, I served a copy of the attached documents on the interested parties
8 involved in said action as follows:

- 9 1. DECLARATION OF ROBERT S. LAWRENCE IN SUPPORT OF OPPOSITION
10 TO PLAINTIFFS' APPLICATION FOR A PRELIMINARY INJUNCTION;
11 2. DECLARATION OF SEAN KNIGHT IN SUPPORT OF OPPOSITION TO
12 PLAINTIFFS' APPLICATION FOR A PRELIMINARY INJUNCTION;
13 ; and
14 3. DEFENDANTS' MEMORANDUM OF POINTS AND AUTHORITIES IN
15 SUPPORT OF OPPOSITION TO PLAINTIFFS' APPLICATION FOR A
16 PRELIMINARY INJUNCTION,

17 — (by mail) by placing a true copy thereof enclosed in a sealed envelope in a designated area for outgoing mail,
18 addressed as set forth below. At Collette & Erickson LLP, mail placed in that designated area is given the
19 correct amount of postage and is deposited that same day, in the ordinary course of business, in a United States
20 mailbox in the City of San Francisco, California.

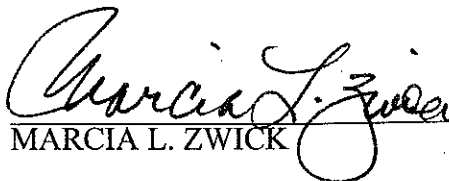
21 X (by personal delivery) by having KING COURIER, a local San Francisco messenger service, personally
22 delivering a true copy thereof to the address listed below.

23 — (by Federal Express) by depositing a true copy thereof in a sealed packet for overnight delivery, with charges
24 thereon fully prepaid, in a Federal Express collection box, at San Francisco, California, and addressed as set
25 forth below.

26 — (by facsimile transmission) by transmitting said document(s) from our office facsimile machine (415) 788-
27 6929, to facsimile machine number(s) shown below. Following transmission, I received a "Transmission
28 Report" from our fax machine indicating that the transmission had been transmitted without error.

Lawrence K. Rockwell, Esq.
Andrew MacKay, Esq.
Donahue, Gallagher, Woods & Wood, LLP
300 Lakeside Drive, Suite 1900
Oakland, California 94612

I declare under penalty of perjury and the laws of the State of California that the
foregoing is true and correct and that this declaration was executed on April 25, 2001, at San
Francisco, California.


MARCIA L. ZWICK