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UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

EXPERIENCE HENDRIX, L.L.C., a
Washington Limited Liability Company, and
AUTHENTIC HENDRIX, LLC, a
Washington Limited Liability Company,

Plaintiffs,

v.

HENDRIXLICENSING.COM, LTD, dba
HENDRIX ARTWORK and
HENDRIXARTWORK.COM, a Nevada
Corporation, and ANDREW PITSICALIS
and CHRISTINE RUTH FLAHERTY,
husband and wife,

Defendants.

No. C09-285Z

ORDER

THIS MATTER comes before the Court on Plaintiffs’ Motion for Partial Summary Judgment of Federal Trademark Infringement Claim, docket no. 43. For the reasons stated in this Order, the Court GRANTS the Motion.

BACKGROUND

A. Previous Litigation and Defendants’ Marks

Plaintiffs Experience Hendrix, LLC (“Experience Hendrix”) and Authentic Hendrix, LLC (“Authentic Hendrix”) (collectively, “Plaintiffs”) previously sued Electric Hendrix, LLC in this Court for infringing Plaintiffs trademarks in the sale and advertising of vodka and other merchandise. Experience Hendrix, LLC et al. v. Electric Hendrix, LLC et al.,

1 C07-338Z. In that case, this Court granted partial summary judgment in favor of Plaintiffs,
2 holding that Electric Hendrix's use of JIMI HENDRIX ELECTRIC, JIMI HENDRIX
3 ELECTRIC VODKA, HENDRIX ELECTRIC, and HENDRIX ELECTRIC VODKA, as
4 well as the Hendrix Electric "bust" design (collectively, the "Hendrix Electric Marks")
5 infringed Plaintiffs' incontestable trademarks. Order (C07-338Z, docket no. 104). As a
6 result, the Court entered a permanent injunction against Craig Dieffenbach, Electric Hendrix,
7 LLC, and related entities. See Judgment and Permanent Injunction (C07-338Z, docket no.
8 127).

9 Hendrix Licensing.com, Ltd., dba Hendrix Artwork and HendrixArtwork.com,
10 ("Hendrix Licensing"); Andrew Pitsicalis; and Christine Ruth Flaherty (collectively,
11 "Defendants") do not deny that Mr. Pitsicalis was formerly associated with Craig
12 Dieffenbach and Electric Hendrix, LLC, as National Licensing Director for House of
13 Hendrix. See John D. Wilson Decl., docket no. 46, ¶ 2, Ex. 1 (Pitsicalis Business Card). In
14 2008, Mr. Pitsicalis formed an entity known as HendrixLicensing.com LTD, which markets
15 posters, fine art prints, apparel (including T-shirts), dart boards, pool cues, "pub" glasses,
16 lamps, and other novelty items bearing the name and/or signature of, the likeness of, and/or
17 art created by Jimi Hendrix. Wilson Decl., Ex. 8 (Pitsicalis Depo. (C09-285Z)); Willie Jinka
18 Decl., docket no. 9, Ex. 2 (Fig. 1, 2), Ex. 3 (Fig. 1, 2), Ex. 4 (Fig. 1), Ex. 7 (Fig. 1).
19 Mr. Pitsicalis obtained the rights to Mr. Dieffenbach's non-spirits intellectual property.
20 Wilson Decl., Ex. 3, at HEN 001201 (Agreement for Sale of Dieffenbach Non-Spirits
21 Intellectual Property). Mr. Pitsicalis was aware of the previous suit involving the Hendrix
22 Electric Marks, and he knew about the Permanent Injunctions issued in October 2008 and
23 February 2009. Id., Ex. 13 (Lagomarsino Letter), at TANAKA 0039. Mr. Pitsicalis talked
24 with Mr. Dieffenbach about the Electric Hendrix lawsuit, and Mr. Pitsicalis was deposed in
25 the Electric Hendrix lawsuit. Id., Ex. 4 (Pitsicalis Depo. (C07-338Z)), at 53.

26

1 **B. Plaintiffs' Marks**

2 Plaintiffs offer a variety of goods and services both directly and through licensees
3 under the marks JIMI HENDRIX, HENDRIX, the JIMI HENDRIX Signature Mark, the Bust
4 Logo, EXPERIENCE HENDRIX, AUTHENTIC HENDRIX, and variations and
5 combinations thereof (collectively, "Plaintiffs' Marks"). Janie Hendrix Decl., docket no. 8,
6 ¶ 7. A certificate of registration of a mark upon the principal register is prima facie evidence
7 of the validity of the registered mark and of the registration of the mark, of the registrant's
8 ownership of the mark, and of the registrant's exclusive right to use the registered mark in
9 commerce or in connection with the goods or services specified in the certificate, subject to
10 any conditions or limitations stated in the certificate. 15 U.S.C. § 1057(b). Because
11 Plaintiffs have registered their marks with the U.S. Patent and Trademark Office, Plaintiffs
12 marks are presumed valid and enforceable. See Wilson Decl., Ex. 6 (Certificates of
13 Registration).

14 Plaintiffs' registered trademarks include the following marks that have become
15 incontestable (collectively, the "Incontestable Marks"):

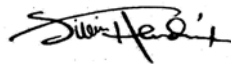
- 16 (1) AUTHENTIC HENDRIX, registration no. 2,245,408, for online
17 ordering services of music, apparel, and memorabilia related to the
18 music industry;
19 (2) EXPERIENCE HENDRIX, registration no. 2,245,409, for print
20 materials, such as magazines and posters regarding the music industry;
21 (3) The EXPERIENCE HENDRIX AND BUST LOGO (design)
22 ("Plaintiffs' Bust Logo"), registration no. 2,250,912, for use on musical
23 sound recordings;
24 (4) JIMI HENDRIX, registration no. 2,322,761, for use on clothing such as
25 T-shirts, jackets, and caps; and
26 (5) JIMI HENDRIX, registration no. 2,383,500, for use in entertainment
services.¹

¹ Plaintiffs also claim that they have the following incontestable trademarks: (1) JIMI HENDRIX, registration no. 2,876,475, for compact discs, and (2) JIMI HENDRIX EXPERIENCE, registration no. 2,876,479, for digital video discs, phonograph records, and compact discs. However, Plaintiffs did not provide evidence of registration for these marks with Plaintiffs' motion for partial summary judgment. See Wilson Decl., Ex. 6 (Certificates of Registration).

1 Wilson Decl., Ex. 6 (Certificates of Registration), 9 (Trademark Application/Registration
2 Status Report).

3 Plaintiffs' contestable marks, which have been registered for less than 5 years,
4 include:

- 5 (1) variations of Plaintiffs' "Bust Logo" for use on a number of products,
6 including ceramic tiles, key chains, afghans, printed matter, etc., see,
7 e.g., registration no. 3,302,367;
8 (2) HENDRIX and JIMI HENDRIX on compact discs, stickers, key chains,
9 T-shirts, buttons, watches, wall clocks, to advertise entertainment
10 services, etc., see, e.g., registration no. 3,302,110; and

- 11 (3) the JIMI HENDRIX signature mark,  , registration
12 no. 3,001,465, for use on printed matter, key chains, clothing, sports
13 bottles, and for entertainment services.

14 Id., Ex. 6 (Certificates of Registration), 9 (Trademark Application/Registration Status
15 Report).

16 This Court previously held that Plaintiffs' Incontestable Marks are strong marks.
17 Order (C07-338Z, docket no. 104), at 17. The Court stated:

18 The Court holds that the name Jimi Hendrix is a famous name and that it has
19 acquired a secondary meaning. Accordingly, the Court holds that the
20 Plaintiffs' incontestable Hendrix-related marks are strong marks

21 Additionally, the AUTHENTIC HENDRIX BUST [Plaintiffs' Bust Logo] is a
22 high-contrast black and white silhouette image with the word EXPERIENCE
23 arched above the bust and the word HENDRIX below the bust. The arbitrary
24 nature of this mark's features, such as text placement, artistic choices in image
25 style, and overall feel also make this a strong mark even apart from the strength
26 of the secondary meaning associated with HENDRIX.

Id.

C. Plaintiffs' Motion for Partial Summary Judgment

27 This Court entered an Order for Preliminary Injunction, docket no. 31, against
28 Defendants on July 30, 2009. Plaintiffs now move for partial summary judgment and argue
29 that Defendants are infringing Plaintiffs' HENDRIX "family" of trademarks by:

- 30 (1) using the preliminarily enjoined business names "Hendrix Licensing,"
31 "HendrixLicensing.com," "Hendrix Artwork," and
32 "HendrixArtwork.com";

- 1 (2) using the preliminarily enjoined domain name
www.hendrixlicensing.com;
2 (3) using the preliminarily enjoined domain name
www.hendrixartwork.com;
3 (4) using Defendants' preliminarily enjoined guitar and "headshot/bust"
4 logo ("Defendants' Headshot Logo"); and



7
8 *Defendants' Headshot Logo*

- 9 (5) using Defendants' preliminarily enjoined signature of Jimi Hendrix
10 ("Defendant's Signature Mark").



13
14 *Defendants' Signature Mark*

15 Plaintiffs seek to have Defendants permanently enjoined from using these marks. Plaintiffs
16 reserve for trial their trademark claims regarding Defendants' uses of the marks JIMI
17 HENDRIX and HENDRIX and Defendants' defenses of nominative or fair use,² and their
18 claims on damages.

19 Defendants argue that they have ceased using the domain names, as well as
20 Defendants' Headshot Logo, but Defendants do contest the infringing nature of all of
21 Defendants' marks, including the domain names, Defendants' Headshot Logo, and
22 Defendants' Signature mark.³ Defendants contend that they are making "fair use" of

23 _____
24 ²In response to this partial motion for summary judgment Defendants have raised their defense of
nominative or fair use and this Order has addressed these issues.

25 ³ Plaintiffs argue that Defendants continue to use the HendrixLicensing.com and
26 HendrixArtwork.com domain names for email communication, Wilson Decl., Ex. 5, and that
Defendants' distributors and licensees continue to offer for sale products with Defendants' Signature
mark and Defendants' Headshot Logo mark, id., Ex. 7.

1 HENDRIX in the domain names. In addition, Defendants contend that Defendants' marks
2 are not likely to cause confusion with Plaintiffs' marks under AMF Inc. v. Sleekcraft Boats,
3 599 F.2d 341 (9th Cir. 1979).

4 **DISCUSSION**

5 **A. Summary Judgment Standard**

6 The Court must grant summary judgment if no genuine issue of material fact exists
7 and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). The
8 moving party bears the initial burden of demonstrating the absence of a genuine issue of
9 material fact. Celotex Corp. v. Catrett, 477 U.S. 317, 323 (1986). A fact is material if it
10 might affect the outcome of the suit under the governing law. Anderson v. Liberty Lobby,
11 Inc., 477 U.S. 242, 248 (1986). In support of its motion for summary judgment, the moving
12 party need not negate the opponent's claim, Celotex, 477 U.S. at 323; rather, the moving
13 party will be entitled to judgment if the evidence is not sufficient for a jury to return a verdict
14 in favor of the opponent, Anderson, 477 U.S. at 249.

15 When a properly supported motion for summary judgment has been presented, the
16 adverse party "may not rest upon the mere allegations or denials" of its pleadings. Fed. R.
17 Civ. P. 56(e). The non-moving party must set forth "specific facts" demonstrating the
18 existence of a genuine issue for trial. Id.; Anderson, 477 U.S. at 256. A party cannot create a
19 genuine issue of fact by asserting "some metaphysical doubt" as to the material facts.
20 Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 586 (1986). Likewise,
21 discrediting the testimony proffered by the moving party will not usually constitute a
22 sufficient response to a motion for summary judgment. Anderson, 477 U.S. at 256-57.

23 To survive a motion for summary judgment, the adverse party must present
24 affirmative evidence, which "is to be believed" and from which all "justifiable inferences"
25 are to be favorably drawn. Id. at 255, 257. When the record, however, taken as a whole,
26 could not lead a rational trier of fact to find for the non-moving party, summary judgment is

1 warranted. See Miller v. Glenn Miller Prod., Inc., 454 F.3d 975, 932 (9th Cir. 2006); see
2 also Beard v. Banks, 126 S. Ct. 2572, 2578 (2006) (quoting Celotex, 477 U.S. at 322 (“Rule
3 56(c) mandates the entry of summary judgment, after adequate time for discovery and upon
4 motion, against a party who fails to make a showing sufficient to establish the existence of an
5 element essential to that party’s case, and on which that party will bear the burden of proof at
6 trial.”)).

7 To prevail on a trademark infringement claim, a trademark owner must prove that the
8 alleged infringer used the mark at issue in commerce and in connection with the sale,
9 distribution, or advertising of goods or services in connection with which such use “is likely
10 to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1114. Injunctive relief
11 is the remedy of choice for trademark infringement cases and is the remedy provided by 15
12 U.S.C. § 1116(a). Century 21 Real Estate Corp. v. Sandlin, 846 F.2d 1175, 1180 (9th Cir.
13 1988). Broad injunctions are especially appropriate in cases where the infringing use is for a
14 similar service. Id. at 1181. “Because of the intensely factual nature of trademark disputes,
15 summary judgment is generally disfavored in the trademark arena.” Brother Records, Inc. v.
16 Jardine, 318 F.3d 900, 903 (9th Cir. 2003).

17 **B. Nominative Fair Use**

18 **1. Standard**

19 This Court entered a preliminary injunction on July 30, 2009, enjoining Defendants
20 from maintaining any domain name incorporating the names HENDRIX or JIMI
21 HENDRIX.⁴ Prior to the Court’s issuance of the preliminary injunction, Defendants
22 maintained a website at the URL address www.hendrixartwork.com, Jinka Decl. ¶ 2, Ex. 1
23 (HendrixArtwork.com News and Events Timeline), and the URL address

24
25 ⁴ Defendants allege that Defendants have abandoned any use of the Hendrix based domain names.
26 Response, docket no. 47, at 1. Plaintiffs have, however, produced an email showing that Mr.
Pitsicalis used his email address at hendrixartwork.com as recently as December 29, 2009, after the
Court issued the preliminary injunction in this matter. Wilson Decl., Ex. 5.

1 www.hendrixlicensing.com, Alfred E. Donohue Decl., docket no. 18. Defendants operate
2 under the entity formed by Mr. Pitsicalis as HendrixLicensing.com, Ltd., dba Hendrix
3 Artwork and HendrixArtwork.com. Wilson Decl., Ex. 8 (Pitsicalis Dep. (C09-285Z)), at
4 0041; Pitsicalis Decl., docket no. 13, at 1.

5 Defendants argue that their use of the name HENDRIX in their URL addresses and
6 business names constitutes a “nominative fair use.” Fair use falls into two categories:
7 “classic fair use” and “nominative fair use.” Cairns v. Franklin Mint Co., 292 F.3d 1139,
8 1150 (9th Cir. 2002). Classic fair use occurs when a defendant uses a plaintiff’s mark to
9 describe the defendant’s own product. Id. In contrast, nominative fair use entails a
10 defendant’s use of a plaintiff’s mark to describe the plaintiff’s product. Id. The type of fair
11 use at issue dictates which standard the Court should apply in assessing the likelihood of
12 confusion. Id. The nominative fair use test found in Cairns “replaces” the Sleekcraft
13 analysis.⁵ Id. at 1150 (emphasis in original); see also Mattel Inc. v. Walking Mountal Prods.,
14 353 F.3d 792, 810 n.19 (9th Cir. 2003) (“The nominative fair use test replaces the traditional
15 AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341, 348-49 (9th Cir. 1979), analysis.” (citing
16 Cairns)). To prevail on a nominative fair use defense, a defendant must show (i) the
17 plaintiff’s product or service is not readily identifiable without using the mark, (ii) the
18 defendant has used only so much of the mark as is reasonably necessary to identify the
19 plaintiff’s product or service, and (iii) the defendant has done nothing, in conjunction with its
20 use of the mark, that would suggest endorsement by the plaintiff. Cairns, 292 F.3d at 1151
21 (citing New Kids on the Block v. News Am. Publ’g, Inc., 971 F.2d 302, 308 (9th Cir. 1992)).
22 Nominative fair use analysis is appropriate whenever a defendant uses a plaintiff’s mark to
23 describe the plaintiff’s product, even if the defendant’s ultimate goal is to describe its own
24 product. Id.

25
26 _____
⁵ The Sleekcraft analysis will be discussed in Part C.

1 The Ninth Circuit case most directly on point with regard to Defendants' use of
2 HENDRIX in Defendants' domain and business names is Playboy Enterprises, Inc. v.
3 Welles, 279 F.3d 796 (9th Cir. 2002). In Welles, Terri Welles' use of the title "Playboy
4 Playmate of the Year 1981," and her use of other trademarked terms on her website were at
5 issue. Id. at 799. Welles had been on the cover of Playboy magazine in 1981 and was
6 Playboy Playmate of the Year for 1981. Id. Welles' website contained a biographical
7 section that described Welles' selection as Playmate of the Year in 1981 and her years
8 modeling for Playboy Enterprises, Inc. ("PEI"). Id. After PEI's suit against Welles began,
9 Welles included discussions of the suit against her and criticism of PEI on her website; she
10 also include a note disclaiming any association with PEI. Id.

11 PEI complained of four uses of its trademarked terms on Welles' website: "(1) the
12 terms 'Playboy' and 'Playmate' in the metatags of the website; (2) the phrase 'Playmate of
13 the Year 1981' on the masthead of the website; (3) the phrases 'Playboy Playmate of the Year
14 1981' and 'Playmate of the Year 1981' on various banner ads, which may be transferred to
15 other websites; and (4) the repeated use of the abbreviation 'PMOY '81' as the watermark on
16 the pages of the website." Id. at 800. Applying the three part nominative fair use test, the
17 court concluded that, except for Welles' use of PEI's protected terms in the wallpaper of
18 Welles' website, Welles' uses of PEI's trademarks were permissible, nominative fair uses.
19 Id.

20 The Welles Court reasoned that PEI's product was PEI's trademarked title, "Playboy
21 Playmate of the Year." Id. at 802. The Ninth Circuit agreed with the district court that it
22 would be impractical and ineffectual in identifying Welles to the public if she were described
23 as the "nude model selected by Mr. Hefner's magazine as its number-one prototypical
24 woman for the year 1981." Id. Thus, the Welles Court concluded that no descriptive
25 substitute existed for PEI's trademarks in the context of Welles' headlines and banner
26 advertisements on her website. Id.

1 Turning to the second prong of the nominative fair use analysis, the Welles Court held
2 that because Welles' banner advertisements and headlines used only the trademarked words,
3 and not the font or symbols associated with the trademarks, Welles used "only so much of
4 the mark or marks . . . as is reasonably necessary to identify the product or service." Id.
5 (citing New Kids, 971 F.2d at 308).

6 Finally, as to the third element of the nominative fair use standard, the Welles Court
7 was persuaded that Welles did nothing in connection with her use of PEI's marks in the
8 headlines and banners on her website to suggest sponsorship or endorsement by PEI. Id. at
9 803. The court noted that the marks were clearly used to describe the title Welles received
10 from PEI in 1981 and that the title helps to describe who Welles is. Id. The court noted that
11 "[i]t would be unreasonable to assume that the Chicago Bulls sponsored a website of Michael
12 Jordan's simply because his name appeared with the appellation 'former Chicago Bull.'" Id.
13 Similarly, it would be unreasonable to assume that PEI sponsors or endorses someone who
14 describes herself as a "Playboy Playmate of the Year in 1981." Id. The Court also noted that
15 Welles affirmatively disavowed any sponsorship or endorsement by PEI on her website. Id.
16 Thus, the Welles Court concluded that Welles' use of PEI's trademarked terms in the banner
17 ads and headlines of her website satisfied the nominative fair use test.⁶

18 The Welles Court held, however, that Welles' repeated use of the abbreviation
19 "PMOY '81," which stands for "Playmate of the Year 1981," on the background or
20

21 ⁶ The Welles Court also concluded that Welles' use of the PEI trademarks in the metatags of her
22 website (which enabled Welles' site to be included in the search results for the terms "playboy" or
23 "playmate" in a search engine that uses metatags) constituted nominative fair use. Id. at 803. The
24 Court noted again that Welles had no practical way of describing herself without using trademarked
25 terms, and that she had no practical way of describing the content of her website without referring to
26 PEI's trademarks. Id. Thus, the court concluded that Welles' use of the trademarked terms in the
metatags of her website satisfied the first prong of the nominative fair use test. Id. The Court
concluded that Welles' use of the metatags satisfied the second and third prongs of the nominative
fair use test as well. Id. at 804. Because Welles used only the trademarked names and because the
metatags did not list the trademarked terms so repeatedly that Welles' site regularly appeared above
PEI's in searches for one of the trademarked terms, the metatags did not use more of PEI's marks as
was reasonably necessary and the metatags did not suggest sponsorship or endorsement by PEI. Id.

1 wallpaper of her website failed the nominative fair use test. Id. The court noted that Welles’
2 picture did not appear before or after “PMOY ‘81.” Id. In addition, the court concluded that
3 the depiction of “PMOY ‘81” is not necessary to describe Welles, but rather “Playboy
4 Playmate of the Year 1981” is adequate. Id. Because the term “PMOY ‘81” did not appear
5 to describe Welles when her picture did not appear before or after each “PMOY ‘81,” the use
6 of the abbreviation failed the first prong of the nominative fair use test. Id. Thus, the court
7 remanded to the district court the question whether “PMOY” was a protected trademark of
8 PEI. Id. at 805.

9 **2. Defendants’ URL Addresses and Business Names**

10 Defendants argue that Defendants’ use of HENDRIX in their URL addresses and in
11 their business names is similar to Welles’ use of “Playboy Playmate of the Year 1981” in the
12 headline and banner advertisements of her website and of “playboy” and “playmate” in the
13 metatags of her website. See id at 800. However, the Court concludes that Defendants’ use
14 of Plaintiffs’ mark⁷ HENDRIX in Defendants’ URL addresses and business names does not
15 constitute a nominative fair use.

16 The Court finds that Defendants’ use of Plaintiffs’ trademarked HENDRIX in
17 Defendants’ URL addresses and business names does not describe Plaintiffs’ product but
18 rather Defendants’ own product—the marketing and licensing of Jimi Hendrix related goods.
19 See Cairns, 292 F.3d at 1150. Thus, the Court concludes that the nominative fair use test
20 does not apply to Defendants’ use of Plaintiffs’ marks in Defendants’ URL addresses and
21 business names.⁸

22
23 ⁷ Plaintiffs have multiple registered trademarks for the marks “HENDRIX,” see, e.g., registration
24 nos. 3,409,133 and 3,302,093, and “JIMI HENDRIX,” see, e.g., registration nos. 2,989,576 and
2,902,769. Wilson Decl., Ex. 6 (Certificates of Registration), 9 (Trademark
Application/Registration Status Report).

25 ⁸Even if the Court were to conclude that the nominative fair use test should be applied to
26 Defendants’ use of HENDRIX in Defendants’ URL addresses and business names, the Defendants
have not satisfied the nominative fair use test. As to the first part of the test, Defendants’ use of
Plaintiffs’ trademarked HENDRIX is not necessary to describe Defendants’ products. See Welles,

1 **C. Likelihood of Confusion**

2 In order for a defendant's use of a plaintiff's trademark to qualify as "classic fair use,"
3 a defendant must prove that (i) it does not use the term or phrase at issue as a trademark or
4 service mark, (ii) it uses the term or phrase "fairly and in good faith," and (iii) it uses the
5 term or phrase only to describe its goods or services. Cairns, 292 F.3d at 1151. Defendants
6 do not claim that they have made a classic fair use of the marks at issue in Plaintiffs' motion
7 for partial summary judgment. Rather, Defendants respond point by point to Plaintiffs'
8 discussion of the eight Sleekcraft factors. Thus, the remaining inquiry is whether
9 Defendants' use of Plaintiffs' marks is likely to cause confusion. For purposes of the
10 Lanham Act, the Ninth Circuit recognizes several different multi-factor tests for assessing
11 whether a likelihood of confusion exists. White v. Samsung Elecs. Am., Inc., 971 F.2d 1395,
12 1400 (9th Cir. 1992). None of these standards has been held "correct to the exclusion of the
13 others," id.; however, the Sleekcraft factors appear to be the most frequently used by the
14 courts in the Ninth Circuit. In applying the Sleekcraft analysis, the "factors should not be
15 rigidly weighed" and the Court should "not count beans." Dreamwerks Prod. Group, Inc. v.
16 SKG Studio dba DreamWorks SKG, 142 F.3d 1127, 1129 (9th Cir. 1998). "The test is a
17 fluid one and the plaintiff need not satisfy every factor, provided that strong showings are
18 made with respect to some of them." Surfvivor Media, Inc. v. Survivor Prods., 406 F.3d 625,
19 631 (9th Cir. 2005). The relevant, non-exhaustive factors include: (i) the strength of the
20 mark; (ii) the proximity of the goods; (iii) the similarity of the marks; (iv) evidence of actual
21 confusion; (v) the marketing channels used; (vi) the type of goods and the degree of care
22 likely to be exercised by the purchaser; (vii) the defendant's intent in selecting the mark; and

23 _____
24 279 F.3d at 804. Like Welles' use of "PMOY '81" in the wallpaper of her website, Defendants' use
25 of Plaintiffs' HENDRIX mark in Defendants' URL addresses and business names does not appear to
26 describe Jimi Hendrix. See Response, at 3. Defendants' use does not accompany any image of or
created by Jimi Hendrix. See id. Thus, the Defendants' use of Plaintiffs' HENDRIX mark in
Defendants' URL addresses and business names fails the first prong of the nominative fair use test.

1 (viii) the likelihood of expansion of the product lines. AMF Inc. v. Sleekcraft Boats, 599
2 F.2d 341, 348-49 (9th Cir. 1979).

3 **1. First Sleekcraft Factor: Strength of Plaintiffs' Marks**

4 The scope of trademark protection given to a mark depends on the strength of the
5 mark; strong marks, which are inherently distinctive, receive greater protection than weak
6 marks, such as a descriptor. Sleekcraft, 599 F.2d at 349. In the Court's August 7, 2008
7 Order in the Electric Hendrix litigation (C07-338Z, docket no. 104) (citing Pirone v.
8 MacMillian, Inc., 894 F.2d 579, 583 (2d Cir. 1990)), the Court noted that a person's name is
9 a descriptive trademark and requires secondary meaning in order to be afforded trademark
10 protection. When analyzing the strength of a name used as a trademark, the particular facts
11 of the name and the goods must be analyzed. See Scarves by Vera, Inc. v. Todo Imports
12 Ltd., 544 F.2d 1167, 1173 (2d Cir. 1976). A famous person's name may have secondary
13 meaning if it is likely to be recognized by prospective purchasers.

14 **a. *HENDRIX***

15 The Court has previously held that the name Jimi Hendrix is a famous name and that it
16 has acquired a secondary meaning. Order (C07-338Z, docket no. 104), at 17. Defendants do
17 not argue that the name HENDRIX alone would not be recognized by prospective
18 purchasers. Thus, the Court holds that HENDRIX is a famous name and has acquired a
19 secondary meaning. Accordingly, the Court holds that Plaintiffs' HENDRIX trademarks are
20 strong marks and this factor can only support infringement.

21 **b. *Plaintiffs' Bust Logo***

22 Plaintiffs have registered and used a variety of trademarks which incorporate a black
23 and white silhouette image depicting Jimi Hendrix. See Wilson Decl., Ex. 6 (Certificates of
24 Registration), 9 (Trademark Application/Registration Status Report) (see, e.g., registration
25 nos. 2,250,912 and 3,297,741). Plaintiffs' incontestable Bust Logo is a high-contrast black
26 and white silhouette image with the word EXPERIENCE arched above the bust and the word

1 HENDRIX below the bust. Wilson Decl., Ex. 6 (Certificates of Registration), 9 (Trademark
2 Application/Registration Status Report) (registration no. 2,250,912 (Plaintiffs' Incontestable
3 Bust Logo)). The Court has previously held that the arbitrary nature of this mark's features,
4 such as text placement, artistic choices in image style, and overall feel, make this mark a
5 strong one even apart from the strength of the secondary meaning associated with
6 HENDRIX. Order (C07-338Z, docket no. 104), at 17.

7 *c. Plaintiffs' Signature Mark*

8 The Court also holds that Plaintiffs' signature mark is a strong mark. As the Court has
9 previously held, the Jimi Hendrix name has a secondary meaning. Order (C07-338Z, docket
10 no. 104), at 17. Plaintiffs' Jimi Hendrix signature mark consists of the Jimi Hendrix name
11 written in script on one line with a more prominent uppercase J and uppercase H to begin
12 each name. Janie Hendrix Decl. ¶ 9; Wilson Decl. Ex. 6 (Certificates of Registration), 9
13 (Trademark Application/Registration Status Report) (*see, e.g.*, registration no. 3,001,465).
14 The Court holds that the arbitrary nature of this mark's features, such as text placement and
15 the use of script lettering make this mark a strong mark even apart from the strength of the
16 secondary meaning associated with JIMI HENDRIX as well. *See* Order (C07-338Z, docket
17 no. 104), at 17.

18 *d. Conclusion Regarding the First Sleekcraft Factor*

19 Thus, the Court concludes that the first Sleekcraft factor, the strength of Plaintiffs'
20 marks, weighs in favor of finding that Defendants have infringed upon Plaintiffs' registered
21 HENDRIX, Bust Logo, and JIMI HENDRIX Signature marks.

22 **2. Second Sleekcraft Factor: Proximity or Relatedness of Goods**

23 The second Sleekcraft factor looks at the proximity or relatedness of Plaintiffs' and
24 Defendants' goods. 599 F.2d at 350. Goods are related if consumers are likely to associate
25 the two product lines. Survivor Media, 406 F.3d at 633. It is undisputed that Defendants
26 and Plaintiffs each sell or license goods such as T-shirts, posters, household goods, and

1 jewelry. Response, at 5; Jinka Decl., Ex. 2-4, 6-7. Although Defendants argue that
 2 Defendants deal in fine art while Plaintiffs do not, Defendants do not cite to any evidence to
 3 support this claim. Response, at 6. Thus, the second Sleekcraft factor favors Plaintiffs.

4 **3. Third Sleekcraft Factor: Similarity of the Marks**

5 When considering the similarity of marks, the marks should be evaluated as they
 6 appear in the market place as a whole and the appearance, sound, and meaning of the marks
 7 should be analyzed individually. Mattel, Inc. v. MCA Records, Inc., 28 F.Supp.2d 1120,
 8 1147 (C.D. Cal. 1998). Defendants argue that sight is the most significant factor in
 9 determining similarity when purchases are more likely to occur when browsing in a store or
 10 online. Response, at 6 (citing One Indus., LLC v. Jim O’Neal Distrib., Inc., 578 F.3d 1154
 11 (9th Cir. 2009), cert. denied, 2010 WL 757711). In O’Neal, the court considered the
 12 similarity between marks that appeared on motorcycle helmets.⁹ 578 F.3d at 1162. The
 13 Court stated that “[b]ecause any consumer confusion in this case would occur as motocross
 14 enthusiasts select helmets inside a store or during online browsing, *sight* is significantly more
 15 important when comparing these marks than sound or meaning.” Id. The court noted that
 16 “[v]erbally articulating the rounded O’ mark [of O’Neal] or the One Icon [of One Industries],
 17 or mentally pondering the meaning of the marks, is not part of buying a motorcycle helmet.”
 18 Id. at 1163.

19 **a. *URL Addresses and Business Names***

20 The Court finds that Defendants’ URL addresses and business names are similar in
 21 sight, sound, and meaning to Plaintiffs’ incontestable text marks.¹⁰ Plaintiffs’ incontestable

22
 23 ⁹ O’Neal’s mark at issue consisted of a boxy ‘O’ with rounded corners followed by an apostrophe.
O’Neal, 578 F.3d at 1156-57. One Industries’ “One Icon” consisted of two interlacing number ones.
 24 Id. at 1157.

25 ¹⁰ The Court should consider whether Defendants’ marks used in Defendants’ URL addresses and
 26 business names are similar to Plaintiffs’ marks in sight, sound, and meaning because neither
 Defendants’ marks used in the URL addresses and business names nor Plaintiff’s incontestable text
 marks are a symbol that one would fail to verbally articulate and ponder the meaning of. See
O’Neal, 578 F.3d at 1163 (an O’ mark and a One Icon were not marks that a consumer would

1 text marks include AUTHENTIC HENDRIX,¹¹ EXPERIENCE HENDRIX,¹² and JIMI
2 HENDRIX.¹³ Wilson Decl., Ex. 6 (Certificates of Registration), 9 (Trademark
3 Application/Registration Status Report). Defendants' business is incorporated as
4 HendrixLicensing.com, Ltd. Pitsicalis Decl., at 1. Defendants' merchandise is sold at the
5 URL address www.hendrixartwork.com. Jinka Decl. ¶ 3 (Fig. 1, 2). All of Defendants'
6 URL addresses and business names share the word HENDRIX in common with Plaintiffs'
7 incontestable text marks. This similarity is not surprising as both Plaintiffs and Defendants
8 market goods related to Jimi Hendrix. See Jinka Decl. ¶¶ 3-7. The primary distinguishing
9 characteristics of Defendants' marks are the use of the words ARTWORK or LICENSING
10 and the placement of ARTWORK or LICENSING after HENDRIX. Considering the sound
11 of Defendants' and Plaintiffs' marks, the Court concludes that Hendrix Artwork and
12 Authentic Hendrix sound similar in that they share the same root of HENDRIX. In addition,
13 ARTWORK and AUTHENTIC both begin with a soft 'a' sound and end with a hard 'c'
14 sound. However, the Court concludes that the similarity between the sound of Hendrix
15 Artwork and Experience Hendrix, and between Hendrix Licensing and Authentic Hendrix
16 and Experience Hendrix, is not as strong. Although these marks likewise share the root of
17 HENDRIX, ARTWORK does not share any notable sound with EXPERIENCE, and
18 LICENSING does not share any notable sound with either AUTHENTIC or EXPERIENCE.
19 Thus, the Court concludes that the sound of the marks are somewhat similar.

20 The Court also concludes that the appearance of the marks is similar. Each of
21 Plaintiffs' incontestable text marks and Defendants' text marks include the root HENDRIX
22 paired with one other substantive word. As the Ninth Circuit noted in Dreamwerks, 142 F.3d

23 _____
24 verbally articulate or ponder the meaning of).

25 ¹¹ Registration no. 2,245,408.

26 ¹² Registration no. 2,245,409.

¹³ Registration no. 2,902,769.

1 at 1131, when considering the similarity of “Dreamwerks” and “DreamWorks,” “a perceptive
2 consumer who does notice the ‘e’ and lower-case ‘w’ in Dreamwerks might shrug off the
3 difference as an intentional modification identifying an ancillary division of the same
4 company.” Similarly, while a consumer might notice that Defendants follow HENDRIX
5 with either LICENSING or ARTWORK, while Plaintiffs precede HENDRIX with
6 AUTHENTIC or EXPERIENCE, a consumer might also “shrug off the difference as an
7 intentional modification identifying an ancillary division of the same company.” *Id.*

8 The overall meaning of the marks is more difficult to determine; however, the Court
9 concludes that there is similarity between the words AUTHENTIC and LICENSING in that
10 they both call to mind authority and ownership on the part of the mark holder. AUTHENTIC
11 implies validity of the product, and LICENSING implies a legal right to the product. In
12 addition, the Court should conclude that there is similarity in meaning between
13 AUTHENTIC and ARTWORK. Although AUTHENTIC and ARTWORK both have
14 distinct meanings, when paired with HENDRIX, both imply something created by Jimi
15 Hendrix.

16 Therefore, the Court concludes that Defendants’ URL addresses and business names
17 are similar to Plaintiffs’ incontestable text marks in sight, sound, and meaning. This factor
18 weighs in favor of infringement with relation to Defendants’ URL addresses and business
19 names.

20 ***b. Defendants’ Headshot Logo***

21 Plaintiffs’ incontestable design mark depicts a high contrast black and white silhouette
22 Jimi Hendrix bust with the word EXPERIENCE in capital letters arched over Jimi Hendrix’s
23 head and the word HENDRIX in capital letters below the bust. Wilson Decl., Ex. 6
24 (Certificates of Registration), 9 (Trademark Application/Registration Status Report)
25 (registration no. 2,250,912). Defendants’ Headshot Logo depicts an image of Jimi Hendrix’s
26 head from the mouth up as part of the head of an electric guitar. *See* Jinka Decl., Ex. 1, 2

1 (Fig. 1, 2), 3 (Fig. 3), 4 (Fig. 1), 5 (Fig. 2), 7. The neck of the guitar extends to the left from
2 the head, and the word HENDRIX is printed in capital letters over the neck. Id.
3 ARTWORK.COM is printed in capital letters on the neck of the guitar. Id., Ex. 2 (Fig. 1, 2),
4 4 (Fig. 1).

5 Two notable similarities are immediately apparent in the appearance of the design
6 marks: the use of the word HENDRIX in all capital letters and the rendering of the image of
7 Jimi Hendrix in a silhouette-like picture.¹⁴ Both images also feature Jimi Hendrix's
8 distinctive Afro. There are differences in the design marks as well. Defendants place their
9 text to the left of Jimi Hendrix where Plaintiffs chose to surround the image. Defendants'
10 stylized text is different than Plaintiffs' block font, although both use all capitals. In
11 addition, Defendants incorporate a guitar design and Jimi's signature into their design.
12 Overall, however, the Court concludes that the marks convey the same dominant impression
13 when the focal point of both marks is an image of Jimi Hendrix, both refer to Jimi Hendrix
14 by incorporating his name into the design, and both use all capital letters for HENDRIX. For
15 these reasons, the Court finds that the design marks have an overall similarity and this factor
16 weighs in favor of Plaintiffs.

17 *c. Defendants' Signature Mark*

18 Finally, Defendants argue that Defendants' signature mark differs from Plaintiffs'
19 signature mark when using the test of sight. Although Defendants have highlighted certain
20 differences, including the relative position of the first and last name, as either one atop the
21 other or side by side, and the divergent shapes of the capital "J" and the capital "H," see
22 Response at 6, the Court finds that the two scripts, especially everything following the "H" in
23 the last name, look virtually identical to "an untrained eye" (the standard presented by
24 Plaintiffs and not contested by Defendants). The signature mark used by Defendants was

25 _____
26 ¹⁴ Defendants' image of Jimi Hendrix in Defendants' design mark is also very similar to the image of
Jimi Hendrix used by Electric Hendrix. Compare Wilson Decl., Ex. 1 (Pitsicalis Business Card)
with Jinka Decl., Ex. 2 (Fig. 1, 2) (Defendants' Headshot Logo).

1 previously used by Electric Hendrix. Wilson Decl., Ex. 4 (Pitsicalis Depo. (C07-338Z)), at
2 51. Parties related to Electric Hendrix had sought to modify that Jimi Hendrix signature to
3 make it look more similar to Plaintiffs' version of the Jimi Hendrix signature mark. Wilson
4 Decl., Ex. 11, at RA0004903 (Email from Craig Dieffenbach) (“[W]e need to replace the ‘H’
5 in Hendrix to look more like Janie’s version.”). Thus, the Court concludes that the signature
6 marks appear to be similar to each other.

7 In addition, the Court concludes that the signature marks convey the same meaning.
8 More than a plain text version of a person’s name, a signature generally conveys a special
9 authorization or approval of a product. Because both Plaintiffs and Defendants use a
10 signature mark on some of their products, both signature marks convey the same meaning.
11 See, e.g., Jinka Decl., Ex. 3 (showing posters sold by both Plaintiffs and Defendants that
12 incorporate their respective signature marks).

13 The Court finds that the signature marks are similar, and this factor weighs in favor of
14 infringement.

15 **4. Fourth Sleekcraft Factor: Evidence of Actual Confusion**

16 Evidence of actual confusion is persuasive evidence that future confusion is likely.
17 O’Neal, 578 F.3d at 1163. However, because evidence of actual confusion is often difficult
18 to obtain, its absence is often given little weight. Cohn v. Petsmart, Inc., 281 F.3d 837, 842-
19 43 (9th Cir. 2002). Plaintiffs have not presented any evidence of actual confusion caused by
20 Defendants’ marks. Thus, the Court finds that this factor weighs slightly in favor of
21 Defendants.

22 **5. Fifth Sleekcraft Factor: Convergence of Marketing Channels**

23 Defendants concede that Plaintiffs and Defendants sell products through similar
24 marketing channels of online and retail stores for apparel and posters. Response, at 7.
25 Defendants argue, however, that Plaintiffs and Defendants do not have converging marketing
26 channels as to fine art of images and likenesses of Jimi Hendrix as well as original visual

1 artwork authored by Jimi Hendrix. Id. Defendants do not provide any evidence to support
2 this contention. Thus, because Defendants concede that Defendants use similar marketing
3 channels to Plaintiffs, the Court finds that this factor weighs in favor of infringement.

4 **6. Sixth Sleekcraft Factor: Degree of Customer Care**

5 Defendants concede a general lack of searching discernment of consumers of the
6 apparel and posters marketed by Defendants and Plaintiffs. Response, at 7. However,
7 Defendants argue that consumers of fine art images and likenesses of Jimi Hendrix and of
8 original visual artwork by Jimi Hendrix will not lack searching discernment. Id. In addition,
9 Defendants argue that any lack of discernment by consumers favors Defendants because
10 consumers of Plaintiffs' and Defendants' products will have "little to no concern about origin
11 at all, and make their purchases based on the image, likeness, or authentic visual artwork by
12 or of Jimi Hendrix adorning the product." Id. at 7-8. Defendants, however, do not provide
13 any support for their contentions that consumers of fine art images and likenesses of Jimi
14 Hendrix and artwork by Jimi Hendrix will not lack searching discernment (or even that
15 Defendants market fine art images and likenesses of Jimi Hendrix and visual artwork by Jimi
16 Hendrix). See id.

17 Because Defendants concede that consumers of their products and of Plaintiffs'
18 products will lack any searching discernment as to origin when purchasing, the Court finds
19 that this factor weighs in favor of infringement.

20 **7. Seventh Sleekcraft Factor: Intent of Defendant**

21 A defendant who knowingly crafts his mark to emulate a plaintiff's mark is presumed
22 to have accomplished his purpose and this intent weighs heavily in favor of a plaintiff.
23 Sleekcraft, 599 F.2d at 354. Mr. Pitsicalis had knowledge of Plaintiffs' trademark
24 infringement claims against Electric Hendrix in the Electric Hendrix litigation. Mr. Pitsicalis
25 was deposed in the Electric Hendrix lawsuit. Wilson Decl., Ex. 4 (Pitsicalis Depo. (C07-
26 338Z)); see also Karen Davis Decl., docket no. 10, Ex. 8 (Letter from Plaintiffs' Counsel), 9

1 (Letter from Defendants' Counsel), 10 (Letter from Plaintiffs' Counsel), 11 (Letter from
2 Defendants' Counsel). In addition, Defendants represented through an attorney that Mr.
3 Pitsicalis had, individually and through his attorneys, scrutinized the Court's decision in the
4 Electric Hendrix litigation involving the Hendrix trademarks, likeness, and image. Wilson
5 Decl., Ex. 13, at TANAKA 0039. Defendants also used the same signature mark that was
6 used by Electric Hendrix. Id., Ex. 4 (Pitsicalis Depo. (C07-338Z)), at 51.¹⁵

7 Defendants allege that Plaintiffs have provided no evidence to show that Defendants
8 intentionally crafted their marks to emulate Plaintiffs' marks. Defendants argue that
9 Defendants "made a strong, good faith effort to *avoid* infringing [Plaintiffs'] marks."
10 Response, at 8 (emphasis in original). However, Defendants provide no evidence indicating
11 what effort Defendants made to avoid infringing Plaintiffs marks.

12 Because Defendants knew of the litigation in the Electric Hendrix lawsuit, and
13 because Defendants represented through their attorney that Defendants had "scrutinized the
14 [C]ourt's decision involving the Hendrix trademarks, likeness, and image," before using
15 Defendants' marks, the Court finds that this factor favors Plaintiffs. See Wilson Decl., Ex.
16 13, at TANAKA 0039.

17 **8. Eighth Sleekcraft Factor: Likelihood of Expansion**

18 Defendants concede that they will likely expand into other areas that may overlap with
19 Plaintiffs. Thus, the Court finds that this factor weighs in favor of infringement.

20
21 ¹⁵ In John D. Wilson's declaration, Plaintiffs also allege that Defendants advertised T-shirts with
22 images which are copyrighted by Plaintiffs. Wilson Decl. ¶ 16, Ex. 15 (Defendants' T-shirts with
23 images Plaintiffs allege are copyrighted by Plaintiffs have a red checkmark on them). Plaintiffs
24 provide a copyright registration for images taken by photographer Chuck Boyd; however, Plaintiffs
25 do not indicate which of the images provided were allegedly used by Defendants on Defendants'
26 T-shirt designs. Id. ¶ 15, Ex. 14. In addition, these images are dark, which makes it difficult to
compare the images to the allegedly infringing T-shirt designs. See id. Defendants provide
evidence that the T-shirt designs match specific photographs which Defendants claim to have legal
license to. Michael Biggs Decl., docket no. 48. Because Plaintiffs do not indicate which images are
allegedly infringed upon, and because Defendants provide some evidence that the T-shirt designs are
not infringing upon Plaintiffs' copyright, the Court does not find Plaintiffs' allegations of copyright
infringement to be evidence that Defendants intentionally crafted their marks to emulate Plaintiffs'
marks.

