

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26

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 a preliminary injunction, docket no. 7. Having reviewed all papers filed in support of and in opposition to the motion, and having heard the arguments of counsel, the Court GRANTS the motion IN PART and DENIES the motion IN PART. The Court will, until further order, enjoin defendants from using (i) domain names containing the names “HENDRIX” or “JIMI HENDRIX,” (ii) the Hendrix Artwork guitar and “headshot/bust” logo, and (iii) Jimi Hendrix’s signature. The Court declines at this time to enjoin defendants from using the names “HENDRIX” or “JIMI HENDRIX” as mere descriptions of images depicted in their products.

1 **Background**

2 This case constitutes the latest battle in the war over all things Jimi Hendrix. In
3 *Experience Hendrix, L.L.C. v. The James Marshall Hendrix Foundation*, Case
4 No. C03-3462Z, the Court concluded that, pursuant to the law of New York, where Jimi
5 Hendrix was domiciled at the time he died intestate, no right of publicity passed to his sole
6 heir or, as a consequence, to plaintiffs. Order (C03-3462Z, docket no. 47), *aff'd* 240 Fed.
7 Appx. 739 (9th Cir. 2007). In *Experience Hendrix, L.L.C. v. Electric Hendrix, LLC*, Case
8 No. C07-338Z, the Court granted partial summary judgment in favor of plaintiffs, holding
9 that use of the phrases JIMI HENDRIX ELECTRIC, JIMI HENDRIX ELECTRIC VODKA,
10 HENDRIX ELECTRIC, and HENDRIX ELECTRIC VODKA, as well as the Hendrix
11 Electric “bust” design (collectively, the “Hendrix Electric Marks”), infringed plaintiffs’
12 incontestable trademarks. Order (C07-338, docket no. 104). Accordingly, the Court entered
13 a permanent injunction against Craig Dieffenbach, Electric Hendrix, LLC, and related
14 entities. *See* Judgment and Permanent Injunction (C07-338Z, docket no. 117); Supplemental
15 Judgment and Permanent Injunction (C07-338Z, docket no. 127).

16 Plaintiffs assert, and defendants do not deny, that Andrew Pitsicalis was formerly
17 associated with Craig Dieffenbach and Electric Hendrix, LLC. In 2008, Mr. Pitsicalis
18 formed an entity known as HendrixLicensing.com LTD, which markets posters, fine art
19 prints, apparel including T-shirts, dart boards, pool cues, “pub” glasses, lamps, and other
20 novelty items bearing the name and/or signature of, the likeness of, and/or art created by Jimi
21 Hendrix. Mr. Pitsicalis was undisputedly 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. Plaintiffs, however, have not instituted contempt proceedings against
24 Mr. Pitsicalis, and they are not now seeking to enforce the Permanent Injunctions entered in
25 Case No. C07-338Z. *See* Reply at 2 n.2.

26

1 In this action, plaintiffs allege that defendants are infringing plaintiffs' incontestable
2 trademarks by:

- 3 (1) maintaining the domain name www.hendrixlicensing.com;
- 4 (2) maintaining the domain name www.hendrixartwork.com;
- 5 (3) using a guitar and "headshot/bust" logo;



- 10 (4) incorporating the names "HENDRIX" or "JIMI HENDRIX" in various
11 products; and
- 12 (5) placing Jimi Hendrix's signature on various products.

13 Defendants indicate that they have ceased using the domain names, as well as the guitar and
14 "headshot/bust" logo, and in response to plaintiffs' motion for preliminary injunction,
15 defendants have not disputed the infringing nature of the domain names or the guitar and
16 "headshot/bust" logo. Defendants, however, contend that they are making "fair use" of
17 Jimi Hendrix's name and signature. Thus, the Court focuses only on defendants' conduct in
18 relation to Jimi Hendrix's name and signature.

19 **Discussion**

20 To obtain a preliminary injunction, plaintiffs, as the moving party, must show either
21 (1) a likelihood of success on the merits and the possibility of irreparable injury, or (2) the
22 existence of serious questions going to the merits and the balance of hardships tipping in its
23 favor. *Apple Computer, Inc. v. Formula Int'l Inc.*, 725 F.2d 521, 523 (9th Cir. 1984).

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

25 To prevail on an infringement claim, a trademark owner must prove that the alleged
26 infringer used the mark at issue in commerce and in connection with the sale, distribution, or

1 advertising of goods or services in connection with which such use “is likely to cause
2 confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1114. In contending that
3 defendants’ uses of Jimi Hendrix’s signature and name are likely to cause confusion,
4 plaintiffs have engaged in a lengthy discussion of the *Sleekcraft* factors.¹ Defendants have
5 not responded point by point, but have instead asserted “classic fair use” and “nominative
6 fair use” as defenses to plaintiffs’ claim of infringement.

7 The Ninth Circuit case most directly on point is *Cairns v. Franklin Mint Co.*, 292 F.3d
8 1139 (9th Cir. 2002). In *Cairns*, the trustees of the Diana Princess of Wales Memorial Fund
9 and the executors of the Estate of Diana, Princess of Wales (collectively, the “Fund”), sued
10 Franklin Mint, which had for several years before and subsequent to Princess Diana’s death
11 produced dolls in Princess Diana’s image. *Id.* at 1144. The dolls were outfitted in clothes
12 and accessories that mimicked those Princess Diana had worn, and they were accompanied
13 by photographs showing Princess Diana in the specific attire. *Id.* at 1153-54. Moreover, in
14 advertisements, Franklin Mint described its products with titles such as “Diana, The People’s
15 Princess Doll” and “Diana, Princess of Wales Porcelain Portrait Doll.” *Id.* The Ninth Circuit
16 concluded that Franklin Mint had made valid nominative fair use of Princess Diana’s image
17 and name and had not infringed the trademarks belonging to the Fund.² *Id.* at 1152-55.

18
19 ¹ For purposes of the Lanham Act, the Ninth Circuit recognizes several different multi-factor tests for
20 assessing whether a likelihood of confusion exists. *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1400
21 (9th Cir. 1992). None of these standards has been held “correct to the exclusion of the others,” *id.*; however,
22 the *Sleekcraft* factors appear to be the most frequently used by courts in the Ninth Circuit. In applying the
23 *Sleekcraft* analysis, the “factors should not be rigidly weighed” and the Court is not to “count beans.”
24 *Dreamwerks Prod. Group, Inc. v. SKG Studio dba DreamWorks SKG*, 142 F.3d 1127, 1129 (9th Cir. 1998).
25 “The test is a fluid one and the plaintiff need not satisfy every factor, provided that strong showings are made
with respect to some of them.” *Survivor Media, Inc. v. Survivor Prods.*, 406 F.3d 625, 631 (9th Cir. 2005).
The relevant, non-exhaustive factors include: (i) the strength of the mark; (ii) the proximity of the goods;
(iii) the similarity of the marks; (iv) evidence of actual confusion; (v) the marketing channels used; (vi) the
type of goods and the degree of care likely to be exercised by the purchaser; (vii) the defendant’s intent in
selecting the mark; and (viii) the likelihood of expansion of the product lines. *AMF Inc. v. Sleekcraft Boats*,
599 F.2d 341, 348-49 (9th Cir. 1979).

26 ² The Fund did not possess any post-mortem rights of publicity because, under the law of Great Britain, such
rights did not survive Princess Diana’s death. 292 F.3d at 1145, 1149. During oral argument in this case,
counsel for plaintiffs suggested that the Fund also did not possess any trademarks. He is mistaken. The

1 The Ninth Circuit explained that fair use falls into two categories: “classic fair use”
2 and “nominative fair use.” *Id.* at 1150. Classic fair use occurs when a defendant uses a
3 plaintiff’s mark to describe the defendant’s own product. *Id.* In contrast, nominative fair use
4 entails a defendant’s use of a plaintiff’s mark to describe the plaintiff’s product. *Id.* The
5 type of fair use at issue dictates which standard the Court should apply in assessing the
6 likelihood of confusion. *Id.* To establish a classic fair use defense, a defendant must prove
7 that (i) it does not use the term or phrase at issue as a trademark or service mark, (ii) it uses
8 the term or phrase “fairly and in good faith,” and (iii) it uses the term or phrase only to
9 describe its goods or services. *Id.* at 1151. The classic fair use analysis “*complements*,” but
10 not supplant the *Sleekcraft* factors. *Id.* at 1150-51 (emphasis in original).

11 The nominative fair use test, however, “*replaces*” the *Sleekcraft* analysis. *Id.* at 1150
12 (emphasis in original); *see also* *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792,
13 810 n.19 (9th Cir. 2003) (“The nominative fair use test replaces the traditional *AMF, Inc. v.*
14 *Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979), analysis.” (citing *Cairns*)). *But see*
15 *Century 21 Real Estate Corp. v. LendingTree, Inc.*, 425 F.3d 211 (3d Cir. 2005) (expressing
16 disagreement with the Ninth Circuit’s approach). To prevail on a nominative fair use
17 defense, a defendant must show (i) the plaintiff’s product or service is not readily identifiable
18 without using the mark, (ii) the defendant has used only so much of the mark as is reasonably
19 necessary to identify the plaintiff’s product or service, and (iii) the defendant has done
20 nothing, in conjunction with its use of the mark, that would suggest sponsorship or
21 endorsement by the plaintiff.³ *Cairns*, 292 F.3d at 1151 (citing *New Kids on the Block v.*

22
23 _____
24 marks “DIANA, PRINCESS OF WALES MEMORIAL FUND” and “DIANA, PRINCESS OF WALES” are
the subject of multiple registrations listing the executors of the Estate as owner and having priority dates as
far back as 1997. *See* Trademark Electronic Search System (<http://www.uspto.gov>).

25 ³ At oral argument, plaintiffs’ counsel appeared to suggest that the Ninth Circuit had in some manner altered
26 the standard articulated in *Cairns*, citing *Brother Records, Inc. v. Jardine*, 318 F.3d 900 (9th Cir. 2003).
Jardine, however, supports the opposite conclusion. The *Jardine* Court reiterated the irrelevance of the
Sleekcraft factors in the nominative fair use analysis, and it observed that the third prong of the nominative

1 News Am. Publ'g, Inc., 971 F.2d 302, 308 (9th Cir. 1992)). Nominative fair use analysis is
2 appropriate whenever a defendant uses a plaintiff's mark to describe the plaintiff's product,
3 even if the defendant's ultimate goal is to describe its own product. *Id.*

4 In Cairns, the Ninth Circuit held that Franklin Mint's use of Princess Diana's name
5 and likeness fit within the nominative fair use framework, reasoning that the Fund's
6 "product" was Princess Diana and its "marks" were Princess Diana's name and image;
7 Franklin Mint therefore used the Fund's marks to describe the Fund's product, although
8 Franklin Mint's ultimate goal was to describe its own Princess Diana-related products. *Id.* at
9 1151-53. Applying the three-part nominative fair use standard, the Ninth Circuit first
10 concluded that Princess Diana cannot be readily identified without using her name. *Id.* at
11 1153. Although one might refer to "the English princess who died in a car crash in 1997,"
12 the simpler and more reliably understood method of describing her is by name. *Id.* In this
13 regard, people and places are quite different from things, which can usually be easily
14 identified with one or two descriptive or generic words, for example, gelatin, cellophane
15 tape, facial tissue, or salicylic acid, and without resort to a brand name such as Jell-O, Scotch
16 tape, Kleenex, or Bayer aspirin. See New Kids, 971 F.2d at 306. An often substantially
17 greater number of words are necessary to precisely distinguish between people and the
18 organizations they form. For example, the five-word phrase "automobile manufacturer based
19 in Michigan" is actually insufficient to convey an exact meaning, and referring to the
20 "Chicago Bulls" without using the words in the mark is a challenge. See id. at 306-07 (as to
21 the latter, providing as examples the phrases "the two-time world champions" and "the
22 professional basketball team from Chicago," but not attempting to describe the city by other
23 than its name). In this case, the Court holds, as a matter of law, that the person Jimi Hendrix,
24 likewise, cannot be readily identified without resort to his name.

25
26 fair use standard, as to which the defendant bears the burden of proof, is simply the flip side of "the
likelihood-of-confusion coin." *Id.* at 908 n.5.

1 Turning to the second prong of the nominative fair use analysis, the Cairns Court held
2 that Franklin Mint had made use of only so much of Princess Diana's name and likeness as
3 was reasonably necessary. 292 F.3d at 1153-54. In reaching this conclusion, the Ninth
4 Circuit reiterated that "[w]hat is 'reasonably necessary to identify the plaintiff's product'
5 differs from case to case." Id. at 1154. "Where . . . the description of the defendant's
6 product depends on the description of the plaintiff's product, more use of the plaintiff's
7 trademark is 'reasonably necessary to identify the plaintiff's product' than in cases where the
8 description of the defendant's product does *not* depend on the description of the plaintiff's
9 product." Id. (emphasis in original). In Cairns, Franklin Mint was permitted to make
10 prominent reference to Princess Diana because customers could not be expected to recognize
11 her features on the doll or to recall, for example, the "tiara and bolero jacket" she once wore.
12 Id. The caption for the doll, namely "Diana," and the associated photograph of Princess
13 Diana wearing such tiara and bolero jacket were "reasonably necessary" to identify the
14 Fund's product, to which Franklin Mint's product was an homage. See id.

15 Finally, as to the third element of the nominative fair use standard, the Ninth Circuit
16 was persuaded that Franklin Mint had not implied sponsorship or endorsement by the Fund.
17 Id. at 1154-55. Notably, Franklin Mint did not include any disclaimers in its advertisements
18 for the Princess Diana-related products, but it did state in conjunction with certain other
19 celebrity-related products that they were "authorized." Id. The Cairns Court found that this
20 contrast indicated the absence of any sponsorship or endorsement by the Fund. Id. at 1155.
21 Moreover, although discussed by the Ninth Circuit for another purpose, Franklin Mint's
22 avoidance of any "distinctive lettering" or particular image of Princess Diana associated with
23 the Fund, see id. at 1154, likely played a role in the conclusion that Franklin Mint had done
24 nothing to suggest a relationship with the Fund.

25
26

1 **1. Use of Names “HENDRIX” or “JIMI HENDRIX”**

2 In light of the guidance provided by *Cairns*, the question before the Court is whether
3 the current case involves nominative fair use, classic fair use, or infringing use. The Court
4 concludes that defendants make two different nominative fair uses of the names
5 “HENDRIX” and “JIMI HENDRIX.” Defendants include the name or names within, or as a
6 title to, a likeness of Jimi Hendrix, which is printed on a poster, T-shirt, or other surface.
7 Defendants also sell reproductions of artwork made by Jimi Hendrix, in connection with
8 which they use his name as a means of identifying the artist.⁴

9 To the extent the names “HENDRIX” or “JIMI HENDRIX” serve merely to describe
10 the associated image, *i.e.*, to identify plaintiffs’ “product” Jimi Hendrix, who is depicted
11 within, or whose artwork is shown in, defendants’ posters or other products, the use is
12 analogous to that in *Cairns*. As in *Cairns*, plaintiffs have no post-mortem rights of publicity,
13 and they cannot preclude anyone from creating and then selling sketches, portraits,
14 caricatures, dolls, bobbleheads, or other likenesses of Jimi Hendrix. In addition, plaintiffs
15 offer no evidence that they have trademarks or service marks incorporating fonts similar to
16 the stylized lettering used by defendants, except for Jimi Hendrix’s signature, which will be
17 discussed in the next section. Other than the signature, plaintiffs’ registrations for
18 “HENDRIX” and “JIMI HENDRIX” are in plain typeface. Exh. 1 to Davis Decl. (docket
19 no. 10-2). Thus, defendants’ use of distinctive lettering does not itself inappropriately imply
20 a relationship with plaintiffs.

21 Indeed, plaintiffs’ counsel conceded during oral argument that defendants would not
22 be infringing plaintiffs’ trademarks if they placed the names “HENDRIX” or “JIMI
23 HENDRIX” in plain text on or adjacent to an image of the musician. Plaintiffs’ quarrel is
24 simply with the use of stylized letters, to which they have no connection and in which they

25 _____
26 ⁴ Plaintiffs have made no assertion that defendants have violated any copyrights in such artwork, or that
defendants’ representations concerning Jimi Hendrix’s authorship of such works are false or otherwise
misleading.

1 have no trademark rights. Plaintiffs essentially assert that, because a font other than Courier,
2 Times New Roman, or the like is employed, the words have taken on the status of a
3 trademark. Plaintiffs' contention lacks merit. Distinctive lettering alone does not a
4 trademark make. No amount of fancy text or extraneous flourish will bestow upon a generic
5 or merely descriptive term or phrase the protections accorded a trademark or service mark.
6 See Rudolph Int'l, Inc. v. Realys, Inc., 482 F.3d 1195 (9th Cir. 2007).

7 In making their "distinctively written therefore a trademark" argument, plaintiffs
8 attempt to analogize defendants' use of block print, *i.e.*, , to the marketing
9 practices held impermissible in Jardine. The situations are not comparable. In Jardine,
10 Al Jardine, one of the five members of the musical band known as "THE BEACH BOYS,"
11 went on tour, promoting his appearances under various versions of the phrase "The Beach
12 Boys Family and Friends." 318 F.3d at 901-02. The Ninth Circuit concluded that
13 Mr. Jardine's use of the mark "THE BEACH BOYS" satisfied the first two prongs of the
14 nominative fair use test, but not the third requirement. See id. at 908.

15 In the Jardine Court's view, the advertising materials displaying "'The Beach Boys'
16 more prominently and boldly than 'Family and Friends' suggest[ed] sponsorship by the
17 Beach Boys." Id. Contrary to plaintiffs' suggestion, this language does not focus at all on
18 the typeface or graphics associated with the mark. Instead, it is aimed at the context in which
19 the mark was used. Mr. Jardine was not using the mark to describe the band or his
20 association with it, as might have been the case had he used the slogan "Al Jardine, of The
21 Beach Boys, in concert." Rather, Mr. Jardine's announcements fostered a misimpression that
22 The Beach Boys were either performing or sponsoring the performances of Mr. Jardine. In
23 contrast, defendants' use of the names "HENDRIX" or "JIMI HENDRIX" in connection
24 with images of the musician, whether in plain or elaborate text, merely identifies the person
25 being portrayed and does not suggest any connection with or endorsement by plaintiffs.

26

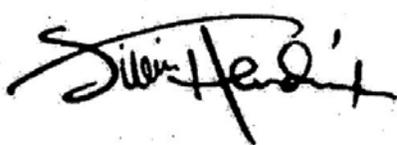
1 In asking that defendants be precluded from using the names “HENDRIX” and “JIMI
2 HENDRIX” as titles for, or as part of the image on, their posters, plaintiffs comment that
3 defendants’ posters “are marketed to fans of Hendrix, who already would recognize his
4 image.” Reply at 7 (docket no. 17). Plaintiffs offer no support for the assertion that
5 purchasers of defendants’ posters are necessarily Jimi Hendrix fans, as opposed to non-fans
6 who might buy the posters as gifts or for some other purpose. More importantly, though,
7 plaintiffs’ focus on the potential customer’s knowledge instead of the product’s nature or
8 qualities is misguided. Although a fan might readily recognize Jimi Hendrix in a realistic
9 portrait, even a Jimi Hendrix aficionado might not be able to identify the musician in an
10 abstract painting. *Compare Cairns*, 292 F.3d at 1154 (“Not every Franklin Mint customer
11 can be expected to recognize Princess Diana’s features on the doll. . . . Accordingly, a
12 caption reading ‘Diana’ is ‘reasonably necessary’ to identify Princess Diana.”). Although
13 defendants’ renditions of Jimi Hendrix’s face, profile, and/or full figure are far from the
14 abstract end of the spectrum, they are also not precise portrayals, and use of the names
15 “HENDRIX” or “JIMI HENDRIX” to identify the subject of these images constitutes a
16 minimal intrusion on plaintiffs’ various marks that the Court concludes is protected by the
17 nominative fair use doctrine. Likewise, use of the name “JIMI HENDRIX” to identify the
18 author of certain artwork, particularly when the artwork itself is not well known, is
19 “reasonably necessary” and falls within the category of nominative fair use.

20 **2. Jimi Hendrix’s Signature**

21 In contrast, defendants’ use of Jimi Hendrix’s signature is not nominative fair use.
22 Defendants have represented to the Court that the signature is authentic, was purchased on
23 “eBay” by Craig Dieffenbach, and was conveyed in electronic form to Mr. Pitsicalis.
24 Defendants use the signature on products, for example, dart game accouterments such as
25 targets, score boards, and dart flights, containing no likeness of Jimi Hendrix. During oral
26 argument, counsel for defendants indicated that defendants are now confining their use of the

1 signature to posters, fine art prints, and apparel. The Court interprets counsel's remark as a
 2 concession that defendants' use of Jimi Hendrix's signature on items that have no illustration
 3 of or by the musician is improper. Such use of the signature constitutes branding, and it is
 4 not exempted from infringement liability by either the nominative or the classic fair use
 5 doctrine.

6 The Court reaches the same result with regard to defendants' inclusion of the
 7 signature on products, *i.e.*, posters, prints, and apparel, depicting Jimi Hendrix or his art.
 8 Unlike in *Cairns*, in which Franklin Mint avoided using any "distinctive lettering" associated
 9 with the Fund, defendants in this case incorporate writing very similar to the script of
 10 plaintiffs' marks, and they thereby fall outside the realm of nominative fair use.



11
12
13
14 Plaintiffs' Registered Mark



15 Signature Used By Defendants

16 Exhs. 1 & 4 to Davis Decl. (docket nos. 10-2 & 10-5). Although superimposing the
 17 signature on an image of Jimi Hendrix might serve the purpose of identifying the figure
 18 therein, it goes beyond what is "reasonably necessary" and incorrectly conveys the
 19 impression that either plaintiffs or Jimi Hendrix himself authorized the product at issue.⁵

20 ⁵ Defendants rely heavily on *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095 (9th Cir.
 21 2008), which involved a video game set in the fictitious city Los Santos. The video game featured a strip club
 22 named the "Pig Pen." *Id.* at 1097. The owner of an actual strip club in Los Angeles, known as "Play Pen
 23 Gentlemen's Club," claimed both trademark and trade dress infringement. *Id.* Because the video game did
 24 not incorporate the plaintiff's mark "PLAY PEN," nominative fair use analysis did not apply. *Id.* at 1098-99.
 25 Instead, the Ninth Circuit addressed "the intersection of trademark law and the First Amendment," employing
 26 a two-pronged test: (i) the artistic work's use of the trademark must bear "artistic relevance" to the
 underlying work; and (ii) it must not explicitly mislead as to the source or the content of the work. *Id.* at
 1099. In *Rock Star*, the only similarity between the video game and the actual strip club were the "form of
 low-brow entertainment" they offered. *Id.* at 1100. Because they otherwise had "nothing in common," the
 Ninth Circuit concluded that the buying public would not be misled or confused into believing that the
 plaintiff was "somehow behind the Pig Pen or that it sponsors Rockstar's product." *Id.* Contrary to
 defendants' contention, First Amendment analysis is not required in this case. Defendants do not claim that
 Jimi Hendrix's signature is their artistic work. Indeed, defendants represent to the Court that they have done

1 Defendants attempt to avoid liability by relying on disclaimers made on their websites
2 and in connection with apparel and merchandise other than posters or artwork, indicating that
3 their products “were not from Authentic Hendrix LLC or Experience Hendrix LLC.”
4 Pitsicalis Decl. at 2 (docket no. 13). These disclaimers constitute, at best, equivocal
5 evidence, on the one hand manifesting an attempt by defendants to distance themselves from
6 plaintiffs, at least in the minds of web browsers and actual purchasers, but on the other hand
7 demonstrating an awareness by defendants of the potential confusion associated with their
8 use of *inter alia* Jimi Hendrix’s signature. The disclaimers, however, unreasonably assume
9 that consumers have a sophisticated understanding of the saga surrounding plaintiffs’ marks,
10 and the disclaimers do nothing to rectify any mistaken beliefs about Jimi Hendrix’s
11 endorsement of, or actual pre-mortem involvement with, defendants’ business.

12 In addition to being beyond the scope of nominative fair use, defendants’ reproduction
13 of Jimi Hendrix’s signature also fails to qualify as classic fair use. In Cairns, the Ninth
14 Circuit summarized a good illustration of the classic fair use doctrine as follows: “[T]he
15 plaintiff sold a videocassette recorder, which had two decks in one machine, under the
16 trademark ‘VCR-2.’ The defendant sold receivers and other machines to which two
17 videocassette recorders could be attached and labeled the relevant terminals on the backs of
18 its machines ‘VCR-1’ and ‘VCR-2.’ Thus, the defendant used the mark ‘VCR-2’ only to
19 describe its own products, to which any second VCR could be attached, and not at all to
20 describe the plaintiff’s product or any other particular VCR. Accordingly, the classic fair use
21 analysis was appropriate.” Cairns, 292 F.3d at 1151 n.9 (citing In re Dual-Deck Video
22 Cassette Recording Antitrust Litig., 11 F.3d 1460 (9th Cir. 1993)). In contrast, in this case,
23 the signature is being used as a trademark, to distinguish defendants’ posters, apparel, and

24
25
26

nothing to alter what was originally penned by Jimi Hendrix, which does not qualify as an artistic expression
any more than does, for example, an attorney’s signing of a brief. Moreover, defendants’ use of the signature
does not satisfy the First Amendment standard for the same reason it does not meet the nominative fair use
test; it misleads as to the origin of the product on which the signature is stamped.

1 novelty items from any other company's similar products, and not solely to describe
2 defendants' products. To be clear, for purposes of this analysis and consistent with the
3 relevant Ninth Circuit authorities, Jimi Hendrix is plaintiffs', and not defendants', "product";
4 defendants' products are posters, fine art prints, T-shirts and other apparel, dart boards, pub
5 glasses, and other novelty items. Defendants' reliance on a classic fair use defense is
6 misplaced.

7 Given the inapplicability of the nominative fair use and classic fair use doctrines, the
8 remaining inquiry is simply whether defendants' use of Jimi Hendrix's signature is likely to
9 cause confusion. Defendants opted not to respond to plaintiffs' discussion of each of the
10 eight *Sleekcraft* factors, instead concentrating on only two factors, namely the similarity of
11 the marks and defendants' intent in selecting the mark. *See* Response at 12 (docket no. 12).
12 Defendants contend that their version of Jimi Hendrix's signature and plaintiff's mark are not
13 sufficiently similar to warrant a finding of likely confusion. Although defendants have
14 highlighted certain differences, including the relative positions of the first and last name, as
15 either one atop the other or side by side, and the divergent shapes of "all but the vowels," *see*
16 Response at 11, the two scripts, especially everything following the "H" in the last name,
17 look virtually identical to "an untrained eye," the standard that plaintiffs advocate, *see*
18 Motion at 14 (docket no. 7), and that defendants do not dispute, *see* Response at 11.

19 In addition, however, even if the distinctions defendants identify were nontrivial, the
20 nature of plaintiffs' mark, as connoting the signature of a particular, now deceased, person,
21 does not leave much room for a different version of the same person's signature to be
22 associated with another company. The underlying assumption of a signature is that it
23 remains somewhat constant over time and that it is unique to the individual, similar to a
24 fingerprint. To permit two different versions of Jimi Hendrix's actual signature to pervade
25 the marketplace, with each one linked to a separate business, invites the type of confusion the
26 trademark laws were designed to prevent. In reaching this conclusion, the Court makes no

1 ruling concerning whether use of hand-written text or script form, which in context does not
2 purport to be the signature of Jimi Hendrix, would infringe plaintiffs' marks.

3 In light of the foregoing analysis, defendants' contention that their subjective intent
4 wins the day is particularly weak. Defendants assert that their "only intent here is to use a
5 signature, and an authentic one at that, to describe the image that is the dominant part of the
6 product, not as to the source of the product." Response at 12 (docket no. 12). This argument
7 fails for the same reason that the signature does not constitute a nominative fair use; the
8 signature goes beyond what is "reasonably necessary" to identify the image, instead
9 inappropriately implying endorsement by, or a relationship with, either plaintiffs or Jimi
10 Hendrix himself. Thus, plaintiffs have established a likelihood of prevailing on the merits of
11 their infringement claim with regard to defendants' use of Jimi Hendrix's signature.

12 **B. Possibility of Irreparable Injury**

13 In a trademark infringement case, irreparable injury may be presumed from a showing
14 of likely success on the merits. *El Pollo Loco, Inc. v. Hashim*, 316 F.3d 1032, 1038 (9th Cir.
15 2003); *see also Apple*, 725 F.2d at 525. Plaintiffs assert that the balance of hardships tips in
16 their favor because Mr. Pitsicalis knew before launching his business that use of domain
17 names, trademarks, brands, logos, and the like relating to Jimi Hendrix was a precarious
18 pursuit. In response, defendants argue that plaintiffs acquiesced in his activities between
19 August 2008, when his deposition was taken in connection with Case No. C07-338Z, *see*
20 Exh. 1 to Osinski Decl. (docket no. 14-2), and February 2009, when plaintiffs sent
21 defendants' prior counsel a "cease and desist" letter, *see* Exh. 3 to Osinski Decl. (docket
22 no. 14-4). Defendants' characterization of events, however, is not supported by the "cease
23 and desist" letter to which they refer. The letter indicates plaintiffs had anticipated that
24 Mr. Pitsicalis would be bound by the Judgment and Preliminary Injunction issued in October
25 2008 in Case No. C07-338Z. *See id.* Plaintiffs apparently did not learn of Mr. Pitsicalis's
26 intentions otherwise until they received a letter from his attorney in November 2008. *Id.*

1 Plaintiffs began researching the activities of Mr. Pitsicalis and his newly formed company,
2 meanwhile entering into a settlement agreement with Craig Dieffenbach in late December
3 2008, and then sent the “cease and desist” letter. *Id.* This sequence of events does not
4 evidence a lack of diligence on plaintiffs’ part or contradict plaintiffs’ claims of irreparable
5 injury in the absence of a preliminary injunction.

6 Defendants’ argument concerning its perilous financial position is likewise
7 unpersuasive. Defendants contend that a preliminary injunction would require major
8 changes to their product lines and would deal “a deathblow at this critical early stage” of the
9 company’s life. Response at 13 (docket no. 12). Defendants’ position, however, would not
10 be improved by allowing it to continue infringing plaintiffs’ marks, only to disgorge at some
11 later date, every cent of profit, plus any actual damages plaintiffs might suffer, along with,
12 potentially, substantial attorney fees and costs. Moreover, to the extent that defendants
13 simply trade on the equity of plaintiffs’ marks, they fail to justify why they should remain in
14 business, particularly in light of Mr. Pitsicalis’s former position with Electric Hendrix, LLC
15 and his assumption of the risks associated with a venture of this nature.

16 **C. Imposition of Bond**

17 Plaintiffs request that the Court enter a preliminary injunction without requiring them
18 to post security. Defendants advance the position that Fed. R. Civ. P. 65(c) mandates the
19 movant provide “security in an amount that the court considers proper to pay the costs and
20 damages sustained by any party found to have been wrongfully enjoined or restrained.”
21 Defendants, however, cite no authority for this assertion, and it runs contrary to Ninth Circuit
22 case law. *See, e.g., Jorgensen v. Cassidy*, 320 F.3d 906, 919 (9th Cir. 2003). The Ninth
23 Circuit recognizes that Rule 65(c) invests a district court “with discretion as to the amount of
24 security required, *if any*,” and that the district court may dispense with the filing of a bond
25 when it perceives “no realistic likelihood of harm to the defendant from enjoining his or her
26 conduct.” *Id.* (emphasis in original) (citing *Barahona-Gomez v. Reno*, 167 F.3d 1228, 1237

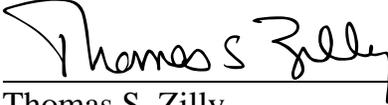
1 (9th Cir. 1999)). In this case, because defendants have voluntarily ceased some of the
2 infringing activities, and because the preliminary injunction will touch only conduct as to
3 which defendants have no realistic chance of securing judgment in their favor, the Court will
4 forego the requirement of security.

5 The Court's proposed form of preliminary injunction is attached as Exhibit A. Any
6 objections to the form shall not exceed ten (10) pages in length, shall be filed by July 17,
7 2009, and shall be noted for July 24, 2009. Any responses to objections shall not exceed five
8 (5) pages in length and shall be filed by July 24, 2009. No reply shall be filed unless
9 requested by the Court.

10 IT IS SO ORDERED.

11 The Clerk is directed to send a copy of this Order to all counsel of record.

12 DATED this 1st day of July, 2009.

13
14 
15 Thomas S. Zilly
16 United States District Judge
17
18
19
20
21
22
23
24
25
26

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26

EXHIBIT A

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26

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

PROPOSED PRELIMINARY
INJUNCTION

By Order dated _____, docket no. _____, the Court granted plaintiffs’
motion for preliminary injunction, docket no. 7, and distributed to the parties the Court’s
proposed form of preliminary injunction. The parties having had full opportunity to
comment as to form, the Court now enters this Preliminary Injunction, and hereby ORDERS:

1. Defendants, their affiliates, officers, agents, servants, employees, attorneys,
distributors, and licensees, and all other persons in active concert or participation with any of

1 them who received actual notice of this Preliminary Injunction, are hereby enjoined until
2 further Order of this Court from: (i) maintaining any domain name incorporating the names
3 “HENDRIX” or “JIMI HENDRIX”; (ii) using the following guitar and “headshot” logo or
4 any similar mark, brand, or logo, in connection with the advertising and/or sale of posters,
5 artwork, fine art prints, apparel, merchandise, memorabilia, and novelty items:
6



11 (iii) using the following Jimi Hendrix signature or any similar signature, mark, brand, or logo
12 in connection with the advertising and/or sale of posters, artwork, fine art prints, apparel,
13 merchandise, memorabilia, and novelty items:
14



19 (iv) registering or applying to register as trademarks or service marks the domain names
20 described above, the guitar and “headshot” logo described above, the Jimi Hendrix signature
21 described above, and/or any similar mark, brand, or logo; and (v) using the domain names
22 described above, the guitar and “headshot” logo described above, the Jimi Hendrix signature
23 described above, and/or any similar mark, brand, or logo in connection with the provision of
24 any online services.
25
26

1 2. Defendants shall make reasonable efforts to withdraw from the stream of
2 commerce all advertising materials and products containing the guitar and “headshot” logo
3 and/or the Jimi Hendrix signature. Defendants are directed to file with this Court and serve
4 on plaintiffs within thirty (30) days after entry of this Preliminary Injunction a report in
5 writing, under oath, setting forth in detail the manner and form in which defendants and their
6 affiliates, officers, agents, servants, employees, attorneys, distributors, licensees, and all
7 other persons in active concert or participation with any of them have complied with this
8 Preliminary Injunction.
9

10 3. Within ten (10) days after entry of this Preliminary Injunction, defendants shall
11 transmit a copy of this Preliminary Injunction to their affiliates, officers, agents, servants,
12 employees, attorneys, distributors, and licensees, and to any individuals or entities who are in
13 possession of advertising materials and/or products intended to be sold either wholesale or
14 retail that contain the domain names described above, the guitar and “headshot” logo
15 described above, and/or the Jimi Hendrix signature described above, and defendants shall
16 direct all such persons to comply with the terms of this Preliminary Injunction. Defendants
17 shall make the financial arrangements necessary to secure the return to them or destruction of
18 such advertising materials and/or products.
19

20 4. Plaintiffs are not required to post security. This Preliminary Injunction will
21 take effect immediately upon entry by the Court.

22 IT IS SO ORDERED.

23 DATED this ____ day of _____, 2009.
24
25

26 _____
THOMAS S. ZILLY
United States District Judge