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8 UNITED STATES DISTRICT COURT  
9 SOUTHERN DISTRICT OF CALIFORNIA  
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11 VLAD ZAMFIR,

12 Plaintiff,

13 v.

14 CASPERLABS, LLC,

15 Defendant.

Case No.: 21cv474-GPC(AHG)

**ORDER DENYING PLAINTIFF'S  
MOTION FOR TEMPORARY  
RESTRAINING ORDER**

**[ECF No. 2]**

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17 Before the Court is Plaintiff Vlad Zamfir's Motion for Preliminary Injunction and  
18 Temporary Restraining Order. ECF No. 2. Defendant CasperLabs, LLC opposes. ECF  
19 No. 15. On March 22, 2021, the Court held a hearing on this matter. ECF No. 26. For  
20 the reasons that follow, the Court DENIES Plaintiff's Motion for a Temporary  
21 Restraining Order.

22 **I. Procedural History**

23 On March 17, 2021, Plaintiff Vlad Zamfir ("Plaintiff") filed the complaint and  
24 instant Motion. ECF Nos. 1, 2. In his complaint, Plaintiff brings a claim for false  
25 designation of origin under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), and  
26 for unfair competition under California common law, arising from Defendant  
27 CasperLabs, LLC ("Defendant")'s use of the name "Casper." ECF No. 1 ¶ 2. Plaintiff  
28 seeks monetary and injunctive relief as well as cancellation of Defendant's trademark

1 registration for the name Casper and abandonment of a pending trademark application for  
2 the same name. *Id.* ¶ 4. In the instant Motion, Plaintiff seeks a TRO or preliminary  
3 injunction preventing Defendant from further use of the name “Casper” in connection  
4 with their goods and services. ECF No. 2-1 at 5.

5 On March 19, 2021, Defendant filed a response in opposition to the Motion. ECF  
6 No. 15. On March 22, 2021, Plaintiff filed a supplemental declaration. ECF No. 23. On  
7 March 22, 2021, the Court held a hearing on the Motion. ECF No. 26.

## 8 **II. Factual Background**

9 This Motion revolves around the use of the name “Casper” in connection with  
10 blockchain technologies. A blockchain is a distributed protocol that stores transactional  
11 records as a chain of “blocks,” and each block cannot be retroactively altered without  
12 leaving evidence of the alteration. ECF No. 2-3 (“Zamfir Decl.”) ¶ 2. Blockchain  
13 technology is therefore used for cryptocurrency exchanges, like Bitcoin, to enable peer-  
14 to-peer networks without relying on any single legal entity to own or administer the  
15 network. *Id.* ¶ 3. Blockchain-based cryptocurrencies have historically relied on a “proof  
16 of work” (“PoW”) consensus mechanism to secure the network, but PoW protocols have  
17 been criticized due to their significant consumption of computational and electrical  
18 energy. *Id.* at 4. In recent years, researchers have begun developing an alternative to  
19 PoW protocols known as “proof-of-stake” (“PoS”) protocols, which use digital resources  
20 to protect the blockchain network and thus would “eliminate the computational waste  
21 inherent to PoW” protocols. *Id.* ¶ 5.

22 Plaintiff is a researcher in the field of cryptoeconomics and distributed systems.  
23 *Id.* ¶ 6. Plaintiff and Vitalik Buterin are the two lead researchers of the PoS blockchain  
24 protocols known as Casper. *Id.* Around 2014, Plaintiff and Buterin began developing  
25 their PoS blockchain protocol design, and around 2015 Plaintiff adopted the name  
26 “Casper.” *Id.* ¶¶ 7–8. Plaintiff and Buterin thereafter began research in two different  
27 directions, with Plaintiff’s branch of this research becoming known as “CBC Casper.”  
28 *Id.* ¶ 10. According to Plaintiff, CBC Casper is currently known and referred throughout

1 the industry as “Casper.” *Id.* Plaintiff has been conducting research and development  
2 under the name Casper in the United States since at least as early as March 2015. *Id.* ¶  
3 11, Exs. A, B, C.

4 Defendant is a company founded in October 2018 organized under the laws of the  
5 State of Wyoming, and has used the name “CasperLabs” since its inception. ECF No.  
6 15-1 (“Manohar Decl.”) ¶¶ 5, 9; ECF No. 15-3 (“Sarkin Decl.”) ¶ 4. In December 2018,  
7 Plaintiff and Defendant discussed collaborating on the research and development of a  
8 new blockchain adopting a version of Plaintiff’s CBC Casper PoS protocol. Zamfir Decl.  
9 ¶ 17. On February 14, 2019, Plaintiff, on behalf of himself and his company  
10 Coordination Technology, Ltd. (“CoorTech”), and Defendant’s overseas affiliate  
11 CasperLabs, Ltd. entered into a Research Agreement. *Id.* ¶ 19; Manohar Decl. ¶ 10. On  
12 the same day, Plaintiff, again on behalf of himself and CoorTech, and Defendant entered  
13 into a License Agreement with CasperLabs, Ltd. granting Defendant limited rights to use  
14 Plaintiff’s name and image. *Id.*; Zamfir Decl. ¶ 20. Plaintiff asserts that soon after he  
15 began working with Defendant, he became concerned that Defendant was  
16 misappropriating his name and leveraging his reputation to mislead investors. *Id.* ¶¶ 23–  
17 24. Defendant asserts that Plaintiff’s work fell short of Defendant’s expectations.  
18 Manohar Decl. ¶ 11. On September 11, 2019, Plaintiff notified Defendant that CoorTech  
19 was terminating both the Research Agreement and License Agreement. *Id.* ¶ 13; Zamfir  
20 Decl. ¶ 26. The License Agreement was terminated in October 2019. *Id.* After an  
21 extension, the Research Agreement was ultimately terminated on November 2, 2019. *Id.*  
22 Aside from maintaining some beneficial ownership in CasperLabs, Plaintiff states he has  
23 not had any relationship with Defendant since terminating the agreements. *Id.* ¶¶ 27–28.

24 On October 31, 2019, Defendant released a protocol specification. *Id.* ¶ 32.  
25 According to Plaintiff, the product had been known as “Highway Protocol,” but later  
26 Defendant started calling the product “CasperLabs Highway Protocol” and later “Casper  
27 Highway Protocol.” *Id.* By August 2020, Defendant had begun referring to its  
28 blockchain protocol and token as “Casper.” *Id.* ¶ 33. Defendant asserts that it had been

1 using the name “Casper” before August 2020. Manohar Decl. at 5. On August 31, 2020,  
2 Defendant announced its network launch and token sale planned for the first quarter of  
3 2021 as “[t]he Casper public network and token sale” and referred to its blockchain  
4 network as “Casper.” Zamfir Decl. ¶ 34. Defendant has thereafter continued to market  
5 its products<sup>1</sup> using the name “Casper.” *Id.* ¶¶ 35–36, 38 Plaintiff states that he never  
6 consented to Defendant’s use of the name “Casper” for Defendant’s PoS protocol, token,  
7 or other products, and in fact was adamant that Defendant not use the Casper name. *Id.*  
8 ¶¶ 30–31, 37. Defendant asserts that Plaintiff was well-aware of Defendant’s intent to  
9 use the Casper name, and that its Chief Technology Officer informed Plaintiff as early as  
10 June 2019 that Defendant was “leaning towards Casper” for the name of its “token and  
11 chain.” Manohar Decl. at 5; ECF No. 15-2 (“Parlikar Decl.”) ¶¶ 3–4, Ex. 1.

12 On September 4, 2019, Defendant filed an application with the U.S. Patent and  
13 Trademark Office (“PTO”) in its own name for the mark CASPER in connection with  
14 blockchain technology. Zamfir Decl. ¶ 43, 44.<sup>2</sup> On November 17, 2020, the mark was  
15 registered. *Id.*, Ex. M. According to Plaintiff, Defendant had agreed to register the  
16 marks on Plaintiff’s behalf and to transfer the marks to Plaintiff, but Defendant has not  
17 assigned the registration to Plaintiff. *Id.* ¶¶ 42, 45. Defendant denies that it ever made an  
18 agreement with Plaintiff to transfer the rights or registration of the CASPER mark. ECF  
19 No. 15-4 (“Walker Decl.”) ¶ 3; Manohar Decl. at 5–6. Defendant’s CEO states that he  
20 “understand[s] that Mr. Zamfir did ask others if CasperLabs, LLC would be willing to  
21 transfer to him any registrations we secured, and was told no.” *Id.* at 5. According to  
22 Defendant, Plaintiff never objected to applications for trademark registration. *Id.*

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27 <sup>1</sup> Defendant states that an affiliated overseas entity not named in this lawsuit, Casper Association, is the  
28 entity that will conduct in the public sale commencing on March 23, 2021 of CSPR tokens to non-U.S.  
persons. Sarkin Decl. ¶¶ 9–10.

<sup>2</sup> Another “Intent to Use” application for the mark CASPER remains pending. Zamfir Decl, Ex. N.

1 Plaintiff vigorously disputes this account. *See generally* ECF No. 23 (“Suppl. Zamfir  
2 Decl.”).<sup>3</sup>

3 Plaintiff alleges that as a result of Defendant’s use of the Casper name, customers  
4 mistakenly associate Plaintiff and CoorTech with Defendant. Zamfir Decl. ¶¶ 46–47.  
5 Plaintiff asserts that this confusion harms his reputation, makes it more difficult to market  
6 the genuine products of his research, and gives the false impression that his research is  
7 being financed by a relationship with Defendant, which makes it harder for Plaintiff to  
8 secure sponsorship. *Id.*

9 Defendant alleges that the names “CASPER” and “CASPERLABS” have become  
10 widely recognized on social media to refer to Defendant’s network. Sarkin Decl. ¶ 11.  
11 Defendant states that there has been \$21 million in “contractual private token presales”  
12 and that according to CoinList, the platform where the public sale of its tokens will take  
13 place, over 180,000 individuals and entities have preregistered for the CSPR token sale.  
14 *Id.* ¶¶ 8–9. Defendant states that it stands to suffer substantial financial harm if it is  
15 restrained from using the Casper name for its network. *Id.* ¶ 12.

### 16 **III. Legal Standard**

17 Federal Rule of Civil Procedure 65 authorizes a court to enter a temporary  
18 restraining order (“TRO”) or preliminary injunction. Fed. R. Civ. P. 65. The purpose of  
19 a TRO is to preserve the status quo before a preliminary injunction hearing may be held;  
20 its provisional remedial nature is designed merely to prevent irreparable loss of rights  
21 prior to judgment. *Granny Goose Foods, Inc. v. Brotherhood of Teamsters & Auto Truck*  
22 *Drivers*, 415 U.S. 423, 439 (1974).

23 The legal standard that applies to a motion for a TRO is the same as a motion for a  
24 preliminary injunction. *See Stuhlberg Int’l Sales Co. v. John D. Brush & Co.*, 240 F.3d  
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27 <sup>3</sup> Defendants filed a motion to strike the supplemental declaration filed by Plaintiff before the hearing  
28 without leave of court. ECF No. 25. Because the Court would find Plaintiff has failed to meet his  
burden even if it considers the supplemental declaration, the Court does not resolve Defendant’s  
objections at this time.

1 832, 839 n.7 (9th Cir. 2001). To obtain a TRO or preliminary injunction, the moving  
2 party must show: (1) a likelihood of success on the merits; (2) a likelihood of irreparable  
3 harm to the moving party in the absence of preliminary relief; (3) that the balance of  
4 equities tips in the moving party’s favor; and (4) that an injunction is in the public  
5 interest. *Winter v. Natural Res. Def. Council, Inc.*, 555 U.S. 7, 20 (2008).

6 Under the Ninth Circuit’s “sliding scale” approach, the first and third elements are  
7 to be balanced such that “serious questions” going to the merits and a balance of  
8 hardships that “tips sharply” in favor of the movant are sufficient for relief so long as the  
9 other two elements are also met. *Alliance for the Wild Rockies v. Cottrell*, 632 F.3d  
10 1127, 1134–35 (9th Cir. 2011). A TRO or preliminary injunction is “an extraordinary  
11 remedy that may only be awarded upon a clear showing that the plaintiff is entitled to  
12 such relief,” *Winter*, 555 U.S. at 22, and the moving party bears the burden of meeting all  
13 four *Winter* prongs. See *Cottrell*, 632 F.3d at 1135; *DISH Network Corp. v. FCC*, 653  
14 F.3d 771, 776-77 (9th Cir. 2011).

#### 15 **IV. Discussion**

16 Plaintiff seeks a TRO or preliminary injunction enjoining Defendant “from further  
17 unauthorized use of the mark ‘CASPER’ (and related terms ‘Casper network,’ ‘Casper  
18 protocol,’ ‘Casper blockchain,’ and ‘CSPR’) in connection with the marketing,  
19 advertising, promotion, offering for sale, and/or sale of Defendant’s proof-of-stake  
20 blockchain network.” ECF No. 2-1 at 4. Defendant argues that Plaintiff is not likely to  
21 succeed on the merits and has otherwise not met the requirements for a TRO.

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

23 Plaintiff contends that he is likely to succeed on his claim for false designation of  
24 origin under Section 43(a) of the Lanham Act because Defendant’s use of the name  
25 “Casper” falsely associates their products with Plaintiff and his research. Defendant  
26 opposes, arguing that Defendant is the registered trademark owner and that Plaintiff has  
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1 failed to demonstrate that he has rights to the “Casper” mark, and that Plaintiff cannot  
2 show a likelihood of confusion.<sup>4</sup>

3         The protections of the Lanham Act seek to guard against deceptive practices in the  
4 marketplace and prohibit conduct that will create a likelihood of confusion. *See New*  
5 *West Corp. v. N.Y.M. Co. of California*, 595 F.2d 1194, 1201 (9th Cir. 1979); 15 U.S.C. §  
6 1127. “Section 1125(a) creates two distinct bases of liability: false association, §  
7 1125(a)(1)(A), and false advertising, § 1125(a)(1)(B).” *Lexmark Intl, Inc. v. Static*  
8 *Control Components, Inc.*, 572 U.S. 118, 122. To prevail on a claim of false association  
9 or false designation of origin,<sup>5</sup> a plaintiff must show that “(1) defendant uses a  
10 designation (any word, term, name, device, or any combination thereof) or false  
11 designation of origin; (2) the use was in interstate commerce; (3) the use was in  
12 connection with goods or services; (4) the designation or false designation is likely to  
13 cause confusion, mistake, or deception as to (a) the affiliation, connection, or association  
14 of defendant with another person, or (b) as to the origin, sponsorship, or approval of  
15 defendant’s goods, services, or commercial activities by another person; and (5) the  
16 plaintiff has been or is likely to be damaged by these acts.” *United Tactical Sys., LLC v.*  
17 *Real Action Paintball, Inc.*, 143 F. Supp. 3d 982, 1015 (N.D. Cal. 2015) (citing *Summit*  
18 *Tech., Inc. v. High-Line Med. Instruments, Co.*, 933 F. Supp. 918, 928 (C.D. Cal. 1996));  
19 *see also Freecycle Network, Inc. v. Oey*, 505 F.3d 898, 902 (9th Cir. 2007) (citing 15  
20 U.S.C. § 1125); *Phillip Morris USA Inc. v. Shalabi*, 352 F. Supp. 2d 1067, 1072 n. 6  
21 (C.D. Cal. 2004) (citing *Brookfield Comm’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d  
22 1036, 1046 n.6 (9th Cir. 1999)). The Court will consider Plaintiff’s likelihood of success  
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26 <sup>4</sup> Defendant also raises arguments regarding nominative fair use, which the Court declines to reach at  
27 this stage.

28 <sup>5</sup> Courts have recognized that a false designation and false association claim are essentially synonymous.  
*See, e.g., Belmora LLC v. Bayer Consumer Care AG*, 819 F.3d 697, 705 n.4 (4th Cir. 2016); *Choon’s*  
*Design, LLC v. ContextLogic Inc.*, No. 19-CV-05300-HSG, 2020 WL 6891824, at \*2 (N.D. Cal. Nov.  
24, 2020).

1 on these elements before considering Defendant’s arguments regarding its ownership of  
2 the registered trademark.

3 1. Designation, Use in Interstate Commerce, and Connection with Goods or  
4 Services

5 The first three factors—whether Defendant used a designation in interstate  
6 commerce in connection with goods or services—appear easily met based on facts  
7 undisputed by the parties. The statute provides that the use of “any word, term, name,  
8 symbol, or device” can form the basis of a claim under Section 43(a), and the alleged  
9 violation here is the use of the word or name “Casper.” 15 U.S.C. § 1125. There can  
10 also be no question that Defendant’s use of the designation, namely through promoting to  
11 consumers their network and token under the name “Casper,” at the very least affects  
12 interstate commerce. *See Thompson Tank & Mfg. Co. v. Thompson*, 693 F.2d 991, 993  
13 (9th Cir. 1982); *cf. Telegram Messenger, Inc. v. Lantah, LLC*, 782 F. App’x 528, 530 (9th  
14 Cir. 2019) (finding entry into contracts for sale of cryptocurrency qualified as “use in  
15 commerce”). Defendant’s use of the term Casper is in connection with “goods or  
16 services” because it used the name to describe its product offerings.

17 2. Likelihood of Confusion

18 The Ninth Circuit has stated the following factors, first articulated in *AMF Inc. v.*  
19 *Sleekcraft*, are relevant to determining the likelihood of confusion in a false designation  
20 of origin claim: (1) “strength of the plaintiff’s mark; (2) “relatedness of the goods;” (3)  
21 “similarity of the marks;” (4) “evidence of actual confusion;” (5) “marketing channels  
22 used;” (6) “likely degree of purchaser care;” (7) “defendant’s intent in selecting the  
23 mark;” and (8) “likelihood of expansion of the product lines.” *Toho Co. v. Sears,*  
24 *Roebuck & Co.*, 645 F.2d 788, 790 (9th Cir. 1981) (citing *AMF Inc. v. Sleekcraft Boats,*  
25 *599 F.2d 341, 348–49* (9th Cir. 1979), *abrogated on other grounds by Mattel, Inc. v.*  
26 *Walking Mountain Prod.*, 353 F.3d 792, 810 n. 19 (9th Cir. 2003)). “The factors are non-  
27 exhaustive and applied flexibly; the *Sleekcraft* factors are not intended to be a ‘rote  
28 checklist.’” *JL Beverage Co., LLC v. Jim Beam Brands Co.*, 828 F.3d 1098, 1106 (9th



1 Cir. 2016) (quoting *Rearden LLC v. Rearden Com., Inc.*, 683 F.3d 1190, 1209 (9th Cir.  
2 2012)).

3 Several of the *Sleekcraft* factors weigh in favor of Plaintiff. The marks are  
4 identical and used in connection with blockchain technology. Plaintiff need not be a  
5 market competitor with Defendant to demonstrate a likelihood of confusion; the fact that  
6 Defendant’s product purportedly built on the CBC Casper protocol confirms that  
7 consumers may see the “products”—Plaintiff’s research and Defendant’s token and  
8 network—as related. *Cf. Stone Brewing Co., LLC v. MillerCoors LLC*, 445 F. Supp. 3d  
9 1113, 1132 (S.D. Cal. 2020) (citing *American Int’l Group, Inc. v. Am. Int’l Bank*, 926  
10 F.2d 829, 832 (9th Cir. 1991)) (noting that direct competition is not necessary to show  
11 relatedness of the goods). As to the fourth factor, evidence of actual confusion, Plaintiff  
12 provides evidence from an online forum and a newspaper article suggesting that some in  
13 the blockchain community mistakenly believe he is associated with Defendant’s network  
14 and token launch. Zamfir Decl., Exs. O, P; *see Rearden*, 683 F.3d at 1218 (noting that  
15 trade publications and news articles can support a showing of likelihood of confusion).  
16 But on the other hand, at least some of the confusion may stem from Plaintiff’s past  
17 affiliation with Defendant that was known to the public, not solely because of  
18 Defendant’s use of the Casper mark. *See* Zamfir Decl. ¶ 22 (noting that Plaintiff was  
19 previously listed on Defendant’s “CasperLabs Team” landing page).

20 As to the strength of the mark, a strong showing on this prong requires both  
21 conceptual strength and commercial strength. *Stone Creek, Inc. v. Omnia Italian Design,*  
22 *Inc.*, 875 F.3d 426, 432 (9th Cir. 2017). Casper is conceptually strong because it is likely  
23 arbitrary, rather than descriptive, of any research or product.<sup>6</sup> *See Entrepreneur Media,*  
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26 <sup>6</sup> Although more likely arbitrary, the Court notes the possibility that “Casper” may be suggestive, as it is  
27 a reference to another protocol known as GHOST, Zamfir Decl. ¶ 9, and thus consumers must use a  
28 “type of multistage reasoning to understand the mark’s significance.” *See Entrepreneur Media, Inc. v.*  
*Smith*, 279 F.3d 1135, 1142 (9th Cir. 2002) (citing *Kendall–Jackson Winery, Ltd. v. E. & J. Gallo*  
*Winery*, 150 F.3d 1042, 1047 n.8 (9th Cir. 1998)).

1 *Inc. v. Smith*, 279 F.3d 1135, 1141–42 (9th Cir. 2002). It is also “inherently distinctive”  
2 because it is a federally registered trademark. *Network Automation Inc. v. Advanced*  
3 *Systems Concepts, Inc.*, 638 F.3d 1137, 1150 (9th Cir. 2011). The commercial strength  
4 of a mark depends on “actual market place recognition.” *Id.* at 1149. This factor weighs  
5 less clearly towards Plaintiff, because while Plaintiff has shown that he is associated with  
6 the Casper mark in the community of blockchain enthusiasts, he has not clearly  
7 established either that he has used the mark in a commercial manner, or that the mark is  
8 strongly associated with him among potential cryptocurrency consumers, which may be  
9 broader than those who are familiar with the underlying technology.<sup>7</sup>

10       Regarding Defendant’s intent, the Ninth Circuit has stated that “[f]actor seven  
11 favors the plaintiff ‘where the alleged infringer adopted his mark with knowledge, actual  
12 or constructive, that it was another’s trademark.’” *JL Beverage*, 828 F.3d at 1111. This  
13 factor could go both ways. Although Defendant appears to have chosen the name Casper  
14 to suggest an association with the CBC Casper protocol, Defendant also used the name  
15 “CasperLabs” throughout its working relationship with Plaintiff without objection and  
16 obtained the trademark registration for the name “Casper” allegedly pursuant to an  
17 agreement with Plaintiff. Plaintiff maintains that Defendant agreed to transfer the rights  
18 to Plaintiff after obtaining trademark registration, Zamfir Decl. ¶ 42, but it is difficult for  
19 the Court to conclude, based on the sparse record regarding the purported agreement, that  
20 Defendant agreed to transfer the trademark to Plaintiff without any expectation that it  
21 would retain any right to use the Casper name at all. These unresolved factual questions  
22 complicate the issue of Defendant’s intent in choosing the mark.

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28 <sup>7</sup> As explored further below, the fact that Defendant is the one that actually registered and used the mark  
commercially also undermines Plaintiff’s showing on this factor.

1           Accordingly, although Plaintiff has shown some possibility that he would succeed  
2 on the likelihood of confusion element of his Lanham Act claim, the evidence not  
3 decisive.<sup>8</sup>

4           3. Existence of a Registered Mark

5           Defendant’s primary argument in response to Plaintiff’s Motion is that Plaintiff has  
6 not established that he is the owner of the mark “Casper” by showing a priority of use in  
7 commerce, a prerequisite to his success on his Lanham Act claim. ECF No. 15 at 17. At  
8 the hearing, Plaintiff argued that ownership of a mark is not a requirement to bring a false  
9 designation of origin claim.

10           The Court finds Defendant’s arguments relevant, but misplaced. Plaintiff does not  
11 bring a claim for trademark infringement. Although previous case law may have  
12 suggested that ownership of a mark, through use of the mark in commerce in the United  
13 States, or a similar cognizable interest in the mark is necessary to bring a claim under  
14 Section 43(a), *see, e.g., Brookfield*, 174 F.3d at 1046 n.6, the Supreme Court has since  
15 clarified in the context of a Section 43(a) false advertising claim that the Lanham Act’s  
16 protections extend to plaintiffs “whose interests fall within the zone of interests protected  
17 by the law invoked” and whose injuries are proximately caused by the violation.

18 *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 129, 132 (2014)  
19 (citation omitted). The Court then concluded that any plaintiff that alleges “injury to a  
20 commercial interest in reputation or sales” falls within the zone of interests for a Section  
21 43(a) false advertising claim. *Id* at 131–132. This decision casts doubt on previous cases  
22 that conflate false designation with trademark infringement and require a showing of  
23 prior use in commerce of the mark. *Cf. Choon’s Design, LLC v. ContextLogic Inc.*, No.  
24 19-CV-05300-HSG, 2020 WL 6891824, at \*3 (N.D. Cal. Nov. 24, 2020) (citing *Jack*  
25 *Russell Terrier Network of N. Ca. v. Am. Kennel Club, Inc.*, 407 F.3d 1027, 1037 (9th  
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28 <sup>8</sup> Given that the Court addresses Plaintiff’s likelihood of damage at length in the section below on  
irreparable harm, the Court does not reach this factor here.

1 Cir. 2005)) (noting that the Ninth Circuit has suggested that existence of a protectable  
2 mark is necessary for a false designation claim, but has not spoken directly to the issue).  
3 As Plaintiff noted at the hearing, the Fourth Circuit has applied *Lexmark* to a false  
4 association claim and concluded that a plaintiff that had not established use of the mark  
5 in commerce in the United States could survive a motion to dismiss brought by the  
6 defendant, a registered trademark holder. *Belmora LLC v. Bayer Consumer Care AG*,  
7 819 F.3d 697, 708–09 (4th Cir. 2016). Therefore, Plaintiff’s failure to establish  
8 ownership of the mark is not necessarily fatal to his claim for false designation of origin.<sup>9</sup>  
9 *See* 5 McCarthy on Trademarks and Unfair Competition §§ 27:13, 27:30 (5th ed.)  
10 (summarizing legal developments on this issue).

11 While Plaintiff may be correct that a plaintiff’s ownership of the disputed mark is  
12 not a prerequisite for a Section 43(a) claim, it does not follow that a defendant’s  
13 un rebutted ownership of a registered trademark mark is irrelevant to the plaintiff’s  
14 likelihood of success. As even the Fourth Circuit in *Belmora* recognized, in reversing the  
15 district court’s dismissal, even a plaintiff that meets the standing requirements laid out in  
16 that case may have difficulty proving a cognizable injury under Section 43(a). *Belmora*,  
17 819 F.3d at 710 n.8. Although a registered trademark does not necessarily shield a  
18 defendant from liability for false designation of origin, it does provide a defendant with  
19 prima facie evidence of its ownership of the mark and its exclusive right to use the mark  
20 in commerce. *See* 15 U.S.C. § 1057(b). Admittedly, the effect of a defendant’s  
21 registered trademark, and its evidentiary significance, in a false designation case is  
22 unclear from existing case law. The Court identified few cases in which courts were  
23 confronted with a claim styled as false designation under 43(a), rather than a claim for  
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26 <sup>9</sup> The Court notes that even in false designation cases, courts have suggested that a plaintiff will satisfy  
27 the “zone of interests” inquiry necessary to bring a claim under the Lanham Act when they make a  
28 showing of harm to commercial interests. *See Obesity Rsch. Inst., LLC v. Fiber Rsch. Int’l, LLC*, 165 F.  
Supp. 3d 937, 946–47 (S.D. Cal. 2016); *Belmora*, 819 F.3d at 711 (referencing Bayer’s commercial  
losses).

1 unregistered trademark infringement, brought against a registered trademark holder.  
2 However, those that did reference this issue appear to have presumed that the defendant's  
3 unchallenged ownership of a valid registered trademark would preclude the plaintiff's  
4 false designation of origin claim.

5 In one case out of the Eastern District of California, the plaintiff and defendant  
6 were formerly associated entities that appeared to have transferred, whether properly or  
7 fraudulently, the disputed registered trademarks between one another prior to the  
8 initiation of the suit and filing of the motion for a preliminary injunction. *Dahon N. Am.*  
9 *Inc. v. Hon*, No. 2:11-CV-5835-ODW-JCGx, 2012 WL 13012476, at \*2 (C.D. Cal. Mar.  
10 19, 2012). The court recognized that although a plaintiff need not prove its own  
11 trademark ownership to prevail on a false designation of origin claim, it must prove that  
12 the defendant's use of the designation constitutes a false designation of origin. *See id.* at  
13 \*4. That court found the plaintiff had not done so, as it was possible that defendants had  
14 rights in the mark by virtue of the previous trademark assignment which plaintiff had not  
15 challenged with evidence, and thus found the plaintiff had not shown a likelihood of  
16 success on its false designation of origin claim. *Id.* ("If Defendants are the rightful  
17 owner, then there cannot be a false designation of origin.").

18 In *United Tactical Systems*, the parties likewise disputed the validity (or existence)  
19 of an assignment of the trademark at issue. *United Tactical Sys.*, 143 F. Supp. 3d at  
20 1015–16. On a motion to dismiss, the counter-defendants argued that the counterclaim  
21 for false designation of origin failed to state a claim because they were the registered and  
22 true owner of the mark by virtue of the assignment. *Id.* at 1015. The Northern District of  
23 California rejected this argument because the counter-claimant *alleged* that counter-  
24 defendants had not lawfully acquired the trademark, pointing to the lack of registration of  
25 the purported assignment with the PTO. *Id.* at 1015–16. This suggests that in order to  
26 ultimately succeed on the merits of the counterclaim, the counter-plaintiff would have  
27 had to demonstrate that the counter-defendants had not been lawfully assigned the mark.  
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1 Another California district court confronted a somewhat similar issue in  
2 considering the effect of a defendant’s valid license to use a mark. *See City-Core Hosp.,*  
3 *LLC v. Palmer*, No. 17-CV-05544-CRB, 2018 WL 398257, at \*3 (N.D. Cal. Jan. 12,  
4 2018). That court, in finding that an exclusive licensee of a mark may not sue another  
5 valid licensee of the same mark for false designation of origin, reasoned that “[p]arties  
6 that have a valid license to use a mark and that use the mark in accordance with the  
7 license are merely exercising rights that have been granted by the licensor[,] [s]o they do  
8 not falsely designate the source of the mark’s goodwill in using the mark.” *Id.*; *cf.*  
9 *Varsity News Network, Inc. v. Carty Web Strategies, Inc.*, No. CV 17-2574 PSG (EX),  
10 2017 WL 7156278, at \*3 (C.D. Cal. Nov. 21, 2017) (noting that if agreement had granted  
11 counter-defendant the right to use the mark, counter-plaintiff’s claim for false designation  
12 of origin would be precluded). The Court recognizes that unlike a license, the  
13 registration of a trademark itself does not grant the registrant the right to use the mark,  
14 but rather confers “prima facie evidence . . . of the owner’s exclusive right to use the  
15 registered mark.” 15 U.S.C. § 1057; *see Matal v. Tam*, 137 S. Ct. 1744, 1751–53 (2017)  
16 (recognizing that although federal law does not create trademarks, federal registration  
17 “confers important legal rights and benefits on trademark owners who register their  
18 marks,” including prima facie evidence of the right to use in commerce in connection  
19 with specific goods or services) (citation omitted). However, if one accepts the prima  
20 facie evidence of a trademark registrant’s right to use the mark, *City-Core’s*  
21 observation—that a party using a mark that they are lawfully permitted to use cannot  
22 make a false designation by using that mark in a permitted manner—appears equally  
23 applicable.

24 These cases lead the Court to conclude, for the purposes of this Motion, that in the  
25 absence of evidence tending to rebut a registered trademark holder’s right to use the  
26 mark, the registrant’s use of the mark in connection with the goods or services referenced  
27 in the registration is unlikely to be found a false designation of origin. This is not to say  
28 that a plaintiff would not be able to overcome the prima facie evidence conferred by the

1 registration. *See Sengoku Works Ltd. v. RMC Int'l, Ltd.*, 96 F.3d 1217, 1220 (9th Cir.), *as*  
2 *modified*, 97 F.3d 1460 (9th Cir. 1996). However, in this case, Plaintiff has not presented  
3 any legal argument or evidence in connection with his Motion to challenge Defendant's  
4 registration, ownership, or right to use the mark.<sup>10</sup>

5 The Court recognizes that this scenario does not track easily with the elements of a  
6 false designation cause of action. As the other district courts cited above suggested, the  
7 existence of a valid registered trademark or other unchallenged right to use the mark  
8 undermines a plaintiff's claim that the defendant has used a "false designation" at all.  
9 *See Dahon N. Am. Inc. v. Hon*, 2012 WL 13012476, at \*4; *City-Core*, 2018 WL 398257  
10 at \*3. This may seem somewhat inconsistent with the Lanham Act's language, which  
11 suggests either "a false designation of origin" or "*any* word, term, name, symbol, or  
12 device" is actionable. 11 U.S.C. § 1125(a) (emphasis added). However, the subsection  
13 as a whole suggests that the use must be deceptive or misleading; that is, the use must be  
14 wrongful in some way. Otherwise, a person with an unchallenged lawful right to use a  
15 mark could be subject to suit, merely because of potential confusion. *Cf. Paleteria La*  
16 *Michoacana, Inc. v. Productos Lacteos Tocumbo S.A. DE C.V.*, 188 F. Supp. 3d 22, 110  
17 (D.D.C. 2016), *aff'd*, 743 F. App'x 457 (D.C. Cir. 2018) ("The Court does not read the  
18 Fourth Circuit's analysis [in *Belmora*] to suggest that an infringing junior user of a mark  
19 in the United States can pursue a false association claim against a mark's senior user  
20 based on consumer confusion resulting from the infringing use."); *Rescue v. Walters*, No.  
21 C20-5700JLR, 2021 WL 22591, at \*8 (W.D. Wash. Jan. 4, 2021) (citing *Waits v. Frito-*

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<sup>10</sup> The Ninth Circuit has not been wholly consistent as to whether the prima facie evidence of ownership  
bestowed by a registered trademark shifts the burden of persuasion, requiring a challenger to overcome  
the presumption of ownership by a preponderance of the evidence, or the burden of production,  
requiring a challenger only to put forth evidence to rebut the validity of the registration. *Compare*  
*Sengoku*, 96 F.3d at 1219 (describing standard as requiring challenger to show ownership by  
preponderance of the evidence) *with Tie Tech, Inc. v. Kinedyne Corp.*, 296 F.3d 778, 783 (9th Cir. 2002)  
("[A]ssuming the [challenger] can demonstrate through law, undisputed facts, or a combination thereof  
that the mark is invalid, the [registration's] evidentiary bubble bursts."). The Court need not decide this  
issue at this juncture because Plaintiff has not put forth evidence on this issue.

1 *Lay, Inc.*, 978 F.2d 1093, 1109 n.9 (9th Cir. 1992)) (noting that false association requires  
2 *misuse* of a trademark or other distinguishing device).

3 Even if the defendant’s unchallenged ownership of a registered trademark was not  
4 an absolute obstacle to proving a false designation, the existence of the registration at  
5 least would factor into the likelihood of confusion. The prima facie evidence of  
6 ownership weakens the commercial strength of the mark in connection to Plaintiff and,  
7 given the agreement (albeit allegedly violated) that Defendant seek federal registration of  
8 the trademark, it also complicates the question of Defendant’s intent in choosing the  
9 mark. Further, as the Ninth Circuit stated when noting the flexibility and non-exhaustive  
10 nature of the *Sleekcraft* factors, “other variables besides the enumerated factors should  
11 also be taken into account based on the particular circumstances.” *Rearden*, 683 F.3d at  
12 1209. The absence of evidence that anyone other Defendant, as the registered owner of  
13 the mark, has the right to use the Casper mark in commerce in connection with the  
14 specified goods and services in the United States, could serve as an independent reason to  
15 find Plaintiff has not shown a likelihood of confusion in this case.

16 Ultimately, given the Lanham Act’s intent to provide some modest protections to  
17 holders of registered trademarks, *see Matal*, 137 S. Ct. at 1753; 15 U.S.C.A. § 1127, the  
18 Court finds that Plaintiff would only be likely to succeed on his false designation of  
19 origin claim were he to overcome Defendant’s prima facie evidence that it has the right to  
20 use the mark, whether by showing that the mark was fraudulently registered, that Plaintiff  
21 is the owner of the mark, or otherwise demonstrating the trademark registration is invalid  
22 or that Defendant lacks the right to use the trademark. In his Motion, Plaintiff has not  
23 done so. In Plaintiff’s own telling, he and Defendant agreed that Defendant should seek  
24 trademark protection for the name “Casper.” Although Plaintiff also asserts that  
25 Defendant had agreed to transfer the registration to Plaintiff, he provides only minimal  
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1 evidence of such an agreement and no indication of what the precise terms were.<sup>11</sup>  
2 Because the Motion does not provide argument or evidence sufficient to challenge the  
3 prima facie evidence of ownership of, and right to use, the Casper designation conferred  
4 by Defendant’s trademark registration, the Court concludes that Plaintiff has not met his  
5 burden of showing he is likely to succeed on his false designation of origin claim.

6 However, the Court presumes for the sake of argument that Plaintiff has presented  
7 “serious questions” as to the merits potentially sufficient for application of the “sliding  
8 scale” approach. *See Alliance for the Wild Rockies*, 632 F.3d at 1134–35.

### 9 **Likelihood of Irreparable Harm**

10 A party seeking a TRO must present evidence that irreparable harm is likely in the  
11 absence of an injunction. In the case *Herb Reed Enterprises, LLC v. Fla. Ent. Mgmt.,*  
12 *Inc.*, 736 F.3d 1239 (9th Cir. 2013), the Ninth Circuit had previously held that a plaintiff  
13 must put forth actual evidence of irreparable harm in a Lanham Act case, noting that  
14 “[g]one are the days when ‘[o]nce the plaintiff in an infringement action has established a  
15 likelihood of confusion, it is ordinarily presumed that the plaintiff will suffer irreparable  
16 harm if injunctive relief does not issue.’” *Herb Reed*, 736 F.3d at 1250 (quoting *Rodeo*  
17 *Collection, Ltd. v. W. Seventh*, 812 F.2d 1215, 1220 (9th Cir. 1987)). Raised for the first  
18 time at the hearing was the potential effect of 15 U.S.C. § 1116(a), which was amended  
19 by the Consolidated Appropriations Act of 2021. See Pub. L. 116-260, § 226, 134 Stat.  
20 1182, 2208 (2020). The amendment provides that “[a] plaintiff seeking any injunction  
21 shall be entitled to a rebuttable presumption of irreparable harm . . . upon a finding of  
22 likelihood of success on the merits for a violation” of specific portions of the Lanham  
23 Act. 15 U.S.C. § 1116(a). At the hearing, Plaintiff contended that this amendment

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26 <sup>11</sup> For instance, Plaintiff does not specify what Defendant was to receive in consideration for registering  
27 the mark on Plaintiff’s behalf. From Plaintiff’s telling, Defendant essentially agreed to register the mark  
28 for Plaintiff without requiring, in exchange, that Plaintiff allow Defendant to retain any right to use the  
name Casper. While this may be accurate, without more information as to the details of this agreement,  
it is difficult for the Court to ascertain how the agreement affects the validity of Defendant’s registration  
or continued use of the mark.

1 entitles him to a presumption of irreparable harm. Defendant countered that Plaintiff  
2 cannot take advantage of this subsection because he has not shown a likelihood of  
3 success on the merits, and alternatively that the effective date of the provision has not yet  
4 passed.

5 At least one district court in the Ninth Circuit has found that 15 U.S.C. § 1116(a)'s  
6 amendment, which added a presumption of irreparable harm upon demonstrating a  
7 likelihood of success on the merits, is already in effect. *Suzie's Brewery Co. v. Anheuser-*  
8 *Busch Companies, LLC*, No. 3:21-CV-178-SI, 2021 WL 472915, at \*12 n.12 (D. Or. Feb.  
9 9, 2021). However, the Court need not delve into the question of the effective date  
10 because the Court concludes that Plaintiff has not established a likelihood of success on  
11 the merits. By its terms, the presumption only applies “upon a finding of likelihood of  
12 success,” and thus would not seem to apply to a situation in which a plaintiff raises  
13 merely “serious questions” as to the merits under the Ninth Circuit’s sliding scale  
14 approach. The Court therefore presumes that *Herb Reed* still applies to a case in which  
15 the plaintiff fails to show a likelihood of success on the merits.

16 “A plaintiff must present case-specific evidence of irreparable harm, rather than  
17 relying on generic factors that are present whenever a trademark is infringed.” *Clark*  
18 *Material Handling Co. v. Zoomlion Heavy Indus. Sci. & Tech. Co.*, No. 18-CV-5853-  
19 CBM-E, 2018 WL 6252463, at \*1–2 (C.D. Cal. Oct. 11, 2018) (noting that plaintiff had  
20 only made “general platitudes” regarding loss of control over business reputation and  
21 thus denying motion for preliminary injunction).

22 Here, Plaintiff points to several people commenting about their confusion online,  
23 an article that mistakenly suggests Plaintiff is associated with Defendant, and a page from  
24 Defendant’s website that arguably suggests his research is somehow financed by  
25 Defendant. Zamfir Decl. ¶¶ 46–48 (citing Exs. O, P, & Q). This evidence supports  
26 Plaintiff’s argument regarding the likelihood of confusion, but does little to demonstrate  
27 any actual or threatened damage to his business reputation, difficulty marketing the  
28 products of his research, or difficulty securing sponsoring for his research. *Cf. Herb*

1 *Reed*, 736 F.3d at 1250 (noting that evidence of customer confusion is insufficient).  
2 Some district courts have found that following *Herb Reed*, a plaintiff’s declaration that  
3 association with the defendant would be harmful to plaintiff’s reputation, without any  
4 corroborating evidence to that effect, is insufficient to show a likelihood of irreparable  
5 harm. *See, e.g., TPW Mgmt., LLC v. Yelp Inc.*, No. 16-CV-03063-YGR, 2016 WL  
6 6216879, at \*12 (N.D. Cal. Oct. 25, 2016) (finding declaration of loss of control over  
7 mark not sufficient to show irreparable harm under *Herb Reed*); *Cafe Found., Inc. v.*  
8 *Seeley*, No. 16-CV-00628-JST, 2016 WL 1258624, at \*7 (N.D. Cal. Mar. 31, 2016)  
9 (declaration anticipating loss of goodwill not sufficient); *Wells Fargo & Co. v. ABD Ins.*  
10 *& Fin. Servs., Inc.*, No. C 12-3856 PJH, 2014 WL 4312021, at \*10 (N.D. Cal. Aug. 28,  
11 2014) (“*Herb Reed* requires evidence that the loss of control is likely to cause *harm* to the  
12 trademark holder.”); *Puma SE v. Forever 21, Inc.*, No. CV17-2523 PSG E, 2017 WL  
13 4771003, at \*4 (C.D. Cal. June 2, 2017) (“[B]ecause Puma has adduced no evidence that  
14 its brand value has been diminished or that monetary damages are insufficient, and  
15 because it relies solely on [its brand director’s] unsupported and largely speculative  
16 assertions of harm, Puma has failed to meet its burden of showing that it will likely suffer  
17 irreparable harm if a preliminary injunction is not issued.”).

18 Plaintiff’s lack of extrinsic evidence would be more understandable had  
19 Defendant’s alleged wrongful use of the Casper mark not been occurring for months or  
20 even years. Plaintiff points to no specific instance in which he had difficulty seeking  
21 funding as a result of the purported affiliation with Defendant, nor does he identify any  
22 present impact on the credibility of his research in anything other than generalized terms.  
23 *See Zamfir Decl.* ¶¶ 46–48. Although the “potential loss of goodwill or loss of control  
24 over one’s reputation cannot be measured precisely,” *TPW Mgmt.*, 2016 WL 6216879 at  
25 \*11, demonstrating a likelihood—rather than a mere possibility—of irreparable harm  
26 requires more than a bare allegation that reputational harm is likely because a plaintiff’s  
27 inability to control defendant’s use of the mark. In any case alleging trademark  
28 infringement, the owner of the mark necessarily will lack the ability to control the

1 infringer’s use of the mark absent an injunction, but *Herb Reed* made clear that more is  
2 needed to show irreparable harm. *See Herb Reed*, 736 F.3d at 1250 (warning against  
3 “collaps[ing] the likelihood of success and the irreparable harm factors”); *Wells Fargo*,  
4 2014 WL 4312021, at \*10 (declarant’s assertions of reputational harm “would apply in  
5 any case where a trademark holder had established a likelihood of success on a claim of  
6 infringement, and thus, do not constitute the type of evidence required by *Herb Reed*”).

7       The Court recognizes that other district courts have found that a plaintiff’s  
8 declaration that she is likely to lose control over her reputation, standing alone, is  
9 sufficient to establish a likelihood of reputational harm. *E.g.*, *Brooklyn Brewery Corp. v.*  
10 *Black Ops Brewing, Inc.*, 156 F. Supp. 3d 1173, 1185 (E.D. Cal. 2016) (finding  
11 declaration regarding potential for loss of control of reputation sufficient to establish  
12 likelihood of irreparable harm); *Traeger Pellet Grills, LLC v. Dansons US, LLC*, 421 F.  
13 Supp. 3d 876, 889 (D. Ariz. 2019), *appeal dismissed*, No. 19-17211, 2020 WL 470307  
14 (9th Cir. Jan. 8, 2020) (finding loss of control of reputation sufficient to show irreparable  
15 harm). However, the Court finds that these decisions, as well as the pre-*Herb Reed*  
16 decisions cited by Plaintiff, appear inconsistent with *Herb Reed*’s rejection of conclusory  
17 statements and platitudes, or mere evidence of consumer confusion, as bases for finding  
18 irreparable harm. *See Herb Reed*, 736 F.3d at 1250; *cf. adidas Am., Inc. v. Skechers USA,*  
19 *Inc.*, 890 F.3d 747, 759–61 (9th Cir. 2018) (reiterating need for “concrete evidence”  
20 beyond testimony of plaintiff’s employees to establish that confusion will cause  
21 irreparable harm). Although the question is close, the Court is doubtful that Plaintiff’s  
22 declaration alone, generally alluding to potential reputational effects, suffices to establish  
23 that he will experience irreparable harm absent an injunction.

24       Further, an unjustified delay in seeking an injunction may undermine a movant’s  
25 argument that she will suffer irreparable harm in the absence of a TRO. *E.g.*, *Garcia v.*  
26 *Google, Inc.*, 786 F.3d 733, 746 (9th Cir. 2015) (“Garcia waited months to seek an  
27 injunction after [the film] was uploaded . . .; she did not seek emergency relief when the  
28 film first surfaced on the Internet. The district court did not abuse its discretion by finding

1 this delay undercut Garcia’s claim of irreparable harm.”); *Oakland Tribune, Inc. v.*  
2 *Chronicle Publ’g Co.*, 762 F.2d 1374, 1377 (9th Cir. 1985) (“Plaintiff’s long delay before  
3 seeking a preliminary injunction implies a lack of urgency and irreparable harm.”). But  
4 “delay is but a single factor to consider in evaluating irreparable injury; [and] courts are  
5 ‘loath to withhold relief solely on that ground.’” *Arc of California v. Douglas*, 757 F.3d  
6 975, 990 (9th Cir. 2014) (quoting *Lydo Enters., Inc. v. City of Las Vegas*, 745 F.2d 1211,  
7 1214 (9th Cir. 1984)); *Cuviello v. City of Vallejo*, 944 F.3d 816, 833 (9th Cir. 2019)  
8 (quoting *Aguayo ex rel. N.L.R.B. v. Tomco Carburetor Co.*, 853 F.2d 744, 750 (9th Cir.  
9 1988) (“[D]elay by itself is not a determinative factor in whether the grant of interim  
10 relief is just and proper.”).

11 Although not decisive, Plaintiff’s delay in bringing this motion—waiting until less  
12 than a week before Defendant’s network launch and its affiliate’s token sale are set to  
13 begin—bolsters the Court’s conclusion that Plaintiff has not shown he is likely to suffer  
14 irreparable harm. “[U]nreasonable delay in a trademark infringement case is measured  
15 from when the plaintiff knew or should have known about its potential cause of action.”  
16 *SunEarth, Inc. v. Sun Earth Solar Power Co.*, 846 F. Supp. 2d 1063, 1083 (N.D. Cal.  
17 2012). Unlike in cases where “the magnitude of the potential harm becomes apparent  
18 gradually, undermining any inference that the plaintiff was sleeping on its rights,” *Arc of*  
19 *California*, 757 F.3d at 990–91 (citation and internal quotation marks omitted), Plaintiff  
20 has been on notice of Defendant’s intent to use the Casper name in connection with the  
21 network and token launch planned for “Q1 2021” for at least seven months, Zamfir Decl.  
22 ¶¶ 33, 34. Plaintiff has also known about Defendant’s intent to trademark the name  
23 Casper, even if the parties dispute what agreement was or was not made, since the time of  
24 their collaboration. At the hearing, Plaintiff’s counsel represented that although he would  
25 have been aware of Defendant’s intent to use the name Casper at least as early as  
26 Defendant’s August 2020 announcements, Plaintiff had hoped that Defendant would not  
27 ultimately use the name. This explanation does little to ease the Court’s concerns about  
28 Plaintiff’s delay in bringing suit. *Cf. Boldface Licensing %8F Branding v. By Lee Tillett*,

1 *Inc.*, 940 F. Supp. 2d 1178, 1197 (C.D. Cal. 2013) (finding delay not unreasonable  
2 because parties were engaged in settlement negotiations, movant needed time to find  
3 local counsel, and then reasonably waited until preliminary injunction motion in related  
4 case was resolved).

5 The Court therefore finds that Plaintiff has failed to show he is likely to suffer  
6 irreparable harm in the absence of the TRO.

### 7 **B. Balance of Equities and the Public Interest**

8 Plaintiff has not shown that he is likely to succeed on the merits of his Lanham Act  
9 claim, but even if he raises “serious questions” regarding the merits, the balance of the  
10 equities does not tip so sharply in his favor to justify the issuance of a TRO. *See Alliance*  
11 *for the Wild Rockies*, 632 F.3d at 1134–35. The Court recognizes that, assuming Plaintiff  
12 were to ultimately succeed on his Lanham Act claim, the absence of an injunction would  
13 permit Defendant to continue capitalizing on the Casper name and its association with  
14 Plaintiff as it continues its rollout of the tokens and network. At that point, some of the  
15 Casper branding may be difficult to reverse, potentially depriving Plaintiff of the ability  
16 to control use of the Casper name and affecting his reputation. However, Defendant also  
17 faces the prospect of significant harm were it to be enjoined from using the Casper name  
18 just days before<sup>12</sup> or after its network and its affiliate’s token launch, given that it has  
19 publicly used the name for months. Had Plaintiff brought this action months ago, this  
20 hardship would have been greatly reduced.<sup>13</sup> Accordingly, in large part because Plaintiff  
21 unreasonably delayed bringing this motion despite being on notice of Defendant’s  
22 activities, the equities do not tip sharply in favor of Plaintiff. *Cf. Khan v. Addy’s BBQ*

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25 <sup>12</sup> As noted at the hearing, the launch of the token may have already occurred at the time of the hearing,  
26 as the March 23, 2021 launch date was apparently based on a different time zone. The time zone issue  
was not raised in the briefing.

27 <sup>13</sup> To the extent Plaintiff argues employees of Defendant have disclaimed any hardship from having to  
28 change the name by telling users of a messaging app that the case is a “nothingburger,” Suppl. Zamfir  
Decl. ¶ 13, the Court does not find that this glib statement significantly minimizes Defendant’s credible  
claim that they would suffer harm from changing the name of their products at the last minute.

1 LLC, 419 F. Supp. 3d 538, 563 (E.D.N.Y. 2019) (citing *Benisek v. Lamone*, 138 S. Ct.  
2 1942, 1944 (2018)) (“[I]n considering the balance of equities, an unreasonable delay in  
3 seeking injunctive relief may weigh against the party seeking such relief.”).

4 As for the public interest, “[t]he usual public concern in trademark cases [is]  
5 avoiding confusion to consumers.” *Internet Specialties West, Inc. v. Milion–DiGiorgio*  
6 *Enterprises, Inc.*, 559 F.3d 985, 991 (9th Cir. 2009). In this case, this factor is closely  
7 tied to who is likely to succeed on the merits. Thus, because Plaintiff has not  
8 demonstrated that Defendant lacks the right to use the mark, the Court need not  
9 determine where the public interest ultimately lies. *See Dep’t of Parks & Recreation for*  
10 *State of California v. Bazaar Del Mundo Inc.*, 448 F.3d 1118, 1124 (9th Cir. 2006).  
11 Regardless, it is not clear that restraining Defendant from using the Casper name at this  
12 stage would lessen consumer confusion by clarifying that Defendant is no longer  
13 associated with Plaintiff, or heighten consumer confusion by preventing Defendant from  
14 using a mark which it is entitled to use and has, in fact, used for months to market, and  
15 begin selling, its products.

16 Thus, the Court finds that the remaining factors do not weigh in favor of  
17 emergency injunctive relief, even if Plaintiff raises “serious questions” on the merits.

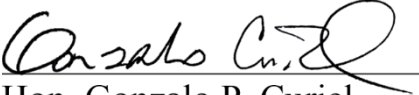
## 18 V. Conclusion

19 For the reasons set forth above, the Court **DENIES** Plaintiff’s motion for a  
20 temporary restraining order.

21 The Court further **DENIES** as moot Defendant’s Motion to Strike (ECF No. 25).

22 **IT IS SO ORDERED.**

23 Dated: March 26, 2021

24   
25 Hon. Gonzalo P. Curiel  
26 United States District Judge  
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