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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

ROMO DIMAS, et al.,)	Case No. CV 13-08840 DDP (ASx)
)	
Plaintiff,)	ORDER GRANTING IN PART
)	PLAINTIFFS' MOTION FOR SUMMARY
v.)	JUDGMENT
)	
TAPIA MATILDE, et al.,)	[Dkt. No. 22]
)	
Defendants.)	
)	

Presently before the Court is Plaintiffs Alfredo Romo Dimas, Ignacio Romo Dimas, Juan Luis Romo Dimas, Rogelio Romo Dimas, Guillermo Romo Dimas, and Gilberto Romo Dimas (collectively, "Plaintiffs")'s Motion for Summary Judgment ("MSJ"). (Docket No. 22.) Defendants Favian Tapia Matilde ("Matilde") and Delia Tapia (collectively, "Defendants") have not filed an opposition. Having reviewed Plaintiffs' submissions and heard oral argument, the Court GRANTS Plaintiffs' motion as to the federal trademark infringement claim and the cancellation of Defendants' trademark, and adopts the following order.

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1 **I. BACKGROUND**

2 Plaintiffs are brothers and members of the musical group
3 Samuray, which Plaintiffs founded in Mexico in 1990. (Declaration
4 of Alfredo Romo Dimas ("Dimas Decl."), Docket No. 22-2, ¶ 2. As
5 director of the group Samuray, Plaintiff Alfredo Romo Dimas
6 ("Alfredo") registered the service mark "SAMURAY" in International
7 Class 41 with the United States Patent and Trademark Office
8 ("USPTO") on October 23, 2012.¹ (Plaintiffs' Separate Statement of
9 Uncontroverted Facts and Conclusions of Law ("SUF"), Docket No. 22-
10 28, ¶¶ 1, 5; Dimas Decl. Ex. 1.) Plaintiffs have used the SAMURAY
11 mark in connection with their musical group and the performances of
12 their musical group continuously since 1990. (SUF ¶¶ 2-4.)
13 Plaintiffs have used the SAMURAY mark in commerce in the United
14 States as early as 1991. (Id. ¶ 3.) Plaintiffs first use the
15 SAMURAY mark in commerce in connection with goods (namely, records
16 and CDs) as early as 1992, and have done so continuously since
17 1992. (Id. ¶¶ 8-9.) Plaintiffs have released at least 15
18 different albums of recordings from 1992 through 2014. (Id. ¶ 10;
19 Dimas Decl. ¶ 7, Ex. 4-18.)

20 The packaging of Samuray's albums and promotional materials
21 typically displays the name "SAMURAY" in distinctive font with a
22 round symbol behind the word. (SUF ¶¶ 16-17.) Samuray performs a
23 genre of Mexican music that is known as "romantico" or a "romantic"
24 style. (Id. ¶ 18.) Oftentimes the group is promoted with the
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27 ¹ This order uses "Samuray" to refer to the musical group,
28 while it uses "SAMURAY" in capital letters to refer to Plaintiffs'
registered service mark.

1 nickname "los guerreros del amor," or "the warriors of love." (Id.
2 ¶¶ 20-21.)

3 In 2009, Defendant Matilde filed an "intent to use"
4 application to register the trademark "EL ROMANTICO SAMURAY" in
5 international class 9, in connection with goods, including records
6 and CDs. (Id. ¶ 24.) In response to requests from the USPTO,
7 Matilde created three exhibits demonstrating the EL ROMANTICO
8 SAMURAY mark. (Id. ¶ 28.) These exhibits were created solely to
9 present to the USPTO and were never produced or used commercially.
10 (Id.) In 2012, Matilde filed a trademark application for "EL
11 ROMANTICO SAMURAY" as a service mark in international class 41.
12 (Id. ¶ 37.)

13 Matilde first learned of the existence of the Samuray musical
14 group in 1990. (Id. ¶ 22.) Matilde has a musical group that plays
15 songs by Samuray (otherwise known as "covers"). (Id. ¶ 23.)
16 Matilde began using the EL ROMANTICO SAMURAY mark in January 2010.
17 (Id. ¶ 39.) Matilde's El Romantico Samuray group plays live music
18 and distributes recordings. (Id. ¶¶ 49-50.) On multiple
19 occasions, performances by Matilde's El Romantico Samuray group
20 have been advertised as Plaintiffs' Samuray group, including using
21 visual ads that depict the members of the Samuray group accompanied
22 by a Samuray logo. (Id. ¶¶ 51-53.)

23 On November 27, 2013, Plaintiffs filed the present action
24 against Defendants, alleging claims for (1) federal trademark
25 infringement and unfair competition, (2) trademark infringement
26 under California common law, (3) unfair competition under Cal. Bus.
27 and Prof. Code §§ 17200 et seq., (4) false advertising under Cal.
28 Bus and Prof. Code §§ 17500 et seq., (5) interference with

1 prospective business advantage, (6) cancellation of registration of
2 trademark, (7) accounting, and (8) injunctive relief. (Docket No.
3 1.) Defendants filed an Answer. (Docket No. 10.) Plaintiffs have
4 now moved for summary judgment. (Docket No. 22.) Defendants have
5 not filed an opposition.

6 **II. LEGAL STANDARD**

7 Summary judgment is appropriate where the pleadings,
8 depositions, answers to interrogatories, and admissions on file,
9 together with the affidavits, if any, show "that there is no
10 genuine dispute as to any material fact and the movant is entitled
11 to judgment as a matter of law." Fed. R. Civ. P. 56(a). A party
12 seeking summary judgment bears the initial burden of informing the
13 court of the basis for its motion and of identifying those portions
14 of the pleadings and discovery responses that demonstrate the
15 absence of a genuine issue of material fact. See Celotex Corp. v.
16 Catrett, 477 U.S. 317, 323 (1986). All reasonable inferences from
17 the evidence must be drawn in favor of the nonmoving party. See
18 Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 242 (1986). If the
19 moving party does not bear the burden of proof at trial, it is
20 entitled to summary judgment if it can demonstrate that "there is
21 an absence of evidence to support the nonmoving party's case."
22 Celotex, 477 U.S. at 323.

23 Once the moving party meets its burden, the burden shifts to
24 the nonmoving party opposing the motion, who must "set forth
25 specific facts showing that there is a genuine issue for trial."
26 Anderson, 477 U.S. at 256. Summary judgment is warranted if a
27 party "fails to make a showing sufficient to establish the
28 existence of an element essential to that party's case, and on

1 which that party will bear the burden of proof at trial." Celotex,
2 477 U.S. at 322. A genuine issue exists if "the evidence is such
3 that a reasonable jury could return a verdict for the nonmoving
4 party," and material facts are those "that might affect the outcome
5 of the suit under the governing law." Anderson, 477 U.S. at 248.
6 There is no genuine issue of fact "[w]here the record taken as a
7 whole could not lead a rational trier of fact to find for the
8 nonmoving party." Matsushita Elec. Indus. Co. v. Zenith Radio
9 Corp., 475 U.S. 574, 587 (1986).

10 It is not the court's task "to scour the record in search of a
11 genuine issue of triable fact." Keenan v. Allan, 91 F.3d 1275,
12 1278 (9th Cir.1996). Counsel has an obligation to lay out their
13 support clearly. Carmen v. San Francisco Sch. Dist., 237 F.3d
14 1026, 1031 (9th Cir.2001). The court "need not examine the entire
15 file for evidence establishing a genuine issue of fact, where the
16 evidence is not set forth in the opposition papers with adequate
17 references so that it could conveniently be found." Id.

18 **III. DISCUSSION**

19 **A. Trademark Infringement under the Lanham Act**

20 Plaintiffs assert a trademark infringement claim under Section
21 43(a) of the Lanham Act. 15 U.S.C. § 1125(a)(1)(A). "To establish
22 a trademark infringement claim," a plaintiff must show (1) it has
23 valid, protectable trademarks, and (2) that defendant's use of the
24 marks is likely to cause confusion. Applied Info. Sciences Corp.
25 v. eBay, Inc., 511 F.3d 966, 969 (9th Cir. 2007).

26 1. Ownership of the Mark

27 "It is axiomatic in trademark law that the standard test of
28 ownership is priority of use. To acquire ownership of a trademark

1 it is not enough to have invented the mark first or even to have
2 registered it first; the party claiming ownership must have been
3 the first to actually use the mark in the sale of goods or
4 services." Sengoku Works Ltd. v. RMC Int'l, Ltd., 96 F.3d 1217,
5 1219 (9th Cir. 1996). "The first to use a mark is deemed the
6 'senior' user and has the right to enjoin 'junior' users from using
7 confusingly similar marks in the same industry and market or within
8 the senior user's natural zone of expansion." Brookfield Commc'ns.
9 Inc. V. West Coast Entm't Corp., 174 F.3d 1036, 1047 (9th Cir.
10 1999).

11 Plaintiffs have presented evidence that they are the senior
12 user of the SAMURAY mark. They have used the SAMURAY name and mark
13 continuously since 1990 for the purposes of their musical
14 recordings and performances. Matilde first filed a trademark
15 application for EL ROMANTICO SAMURAY in 2009. At deposition,
16 Matilde testified that he did not begin using his EL ROMANTICO
17 SAMURAY mark in conjunction with his performances until 2010.
18 Therefore, although Matilde first registered a trademark using the
19 "SAMURAY" name, Plaintiffs were the first to use the SAMURAY mark
20 in commerce. See Brookfield, 174 F.3d at 1047 (stating that,
21 although a registration of a mark with the USPTO constitutes prima
22 facie evidence of a mark's validity, the presumption can be
23 rebutted by a party showing that he first used the mark in
24 commerce).

25 2. Likelihood of Confusion

26 Beyond ownership, the "core element" of a trademark
27 infringement claim is the likelihood that the similarity of the
28 marks will confuse consumers as to the source of goods or services.

1 Freecycle Network, Inc. v. Oey, 505 F.3d 898, 902 (9th Cir. 2007).
2 Relevant factors include the strength of the mark, proximity of the
3 goods, similarity of the marks, evidence of actual confusion,
4 marketing channels used, degree of care likely to be exercised by
5 consumers, defendant's intent, and likelihood of expansion of
6 product lines. AMF Inc. v. Sleekcraft Boats, 599 F.2d 941, 348-49
7 (9th Cir. 1979). It is unnecessary to meet every factor, because
8 the likelihood of confusion test is "fluid". Surfvivor Media, Inc.
9 v. Survivor Prods., 406 F.3d 625, 631 (9th Cir. 2005).

10 The strength of a trademark depends, in part, on its position
11 on a spectrum ranging from generic to arbitrary. Rearden LLC v.
12 Rearden Commerce, Inc., 683 F.3d 1190, 1211 (9th Cir. 2012).

13 Arbitrary marks consist of words that have no connection with the
14 product. Id. Here, "SAMURAY," a Spanish word meaning "samurai,"
15 has nothing to do with a musical group that performs traditional
16 Mexican romantic music. Accordingly, Plaintiffs' mark is strong.

17 On balance, the Court finds that there is a high likelihood of
18 confusion. Although the alleged infringing mark is different from
19 Plaintiffs' mark -- Matilde's mark adds the modifier "EL ROMANTICO"
20 to the word "SAMURAY" -- the strength of the mark, the proximity of
21 the use of the marks, their similarity, and evidence of actual
22 confusion all weigh in favor of finding likelihood of confusion.
23 Both marks use the distinctive word "SAMURAY." Both musical groups
24 perform similar music -- in fact, Matilde stated that his EL
25 ROMANTICO SAMURAY group would play covers of Samuray songs. Both
26 musical groups perform in similar venues. In fact, Alfredo
27 discovered Matilde's group because his Samuray group was losing
28 booking venues to the El Romantico Samuray group. (Dimas Decl. ¶¶

1 17, 20.) Alfredo spoke with one promoter who thought he had booked
2 the Samuray group, but only upon investigation discovered he had
3 booked the El Romantico Samuray group. (Id. ¶ 20.) Finally,
4 because Plaintiffs' mark is arbitrary because it is non-
5 descriptive, it is awarded "maximum protection." E. & J. Gallo
6 Winery v. Gallo Cattle Co., 967 F.2d 1280, 1291 (9th Cir. 1992)
7 (holding that an "arbitrary" mark is "awarded maximum protection").
8 See also Official Airline Guides, Inc. v. Goss, 6 F.3d 1385, 1390
9 (9th Cir. 1993) ("An arbitrary mark consists of common words
10 arranged in an arbitrary way that is non-descriptive of any quality
11 of the goods or services.").

12 For the reasons stated above, the Court finds that there is a
13 substantial likelihood of confusion.

14 3. Conclusion

15 The Ninth Circuit has recognized that "[b]ecause of the
16 intensely factual nature of trademark disputes, summary judgment is
17 generally disfavored in the trademark arena." Rearden LLC v.
18 Rearden Commerce, Inc., 683 F.3d 1190, 1209 (9th Cir. 2012). "We
19 have cautioned that district court should grant summary judgment
20 motions regarding the likelihood of confusion sparingly, as careful
21 assessment of the pertinent factors that go into determining
22 likelihood of confusion usually requires a full record." Id.
23 Given the evidence Plaintiffs have presented in this case, however,
24 paired with the fact that Defendants have failed to file an
25 opposition brief, the Court concludes that Plaintiffs are entitled
26 to summary judgment on their trademark infringement claim.

27 Plaintiffs have requested that the Court grant a permanent
28 injunction granting relief against future infringement by

1 Defendants. When summary judgment has been granted on a trademark
2 infringement claim, court may grant a permanent injunction without
3 a specific hearing on the issue. Phillip Morris USA Inc. v.
4 Shalabi, 352 F. Supp. 2d 1067, 1074 (C.D. Cal. 2004). Given the
5 irreparable harm Plaintiffs may suffer if injunctive relief is not
6 granted, combined with the interest in protecting consumers from
7 confusion, the Court will grant Plaintiff's request for injunctive
8 relief. See Metro Pub., Ltd. v. San Jose Mercury News, 987 F.2d
9 637, 640 (9th Cir. 1993) ("Once the plaintiff has demonstrated a
10 likelihood of confusion, it is ordinarily presumed that the
11 plaintiff will suffer irreparable harm if injunctive relief is not
12 granted.").

13 **B. Trademark Cancellation**

14 Plaintiffs also move the Court to cancel Defendants' EL
15 ROMANTICO SAMURAY trademark, arguing that Defendants obtained the
16 registration by fraud. To obtain cancellation of a trademark, a
17 party must show: "(1) a false representation regarding a material
18 fact; (2) the registrant's knowledge or belief that the
19 representation is false; (3) the registrant's intent to induce
20 reliance upon the misrepresentation; (4) actual, reasonable
21 reliance on the misrepresentation; and (5) damages proximately
22 caused by that reliance." Hokto Kinoko Co. v. Concord Farms, Inc.,
23 738 F.3d 1085, 1097 (9th Cir. 2013).

24 Here, Plaintiffs contend that Matilde made a false
25 representation to the USPTO when he created and submitted specimens
26 with his trademark application that "were fakes that he created for
27 the sole purpose of inducing the USPTO to issue him" the EL
28 ROMANTICO SAMURAY mark. (MSJ at 16.) Plaintiffs have also

1 produced evidence that shows Matilde not only was aware of the
2 Samuray group, but also played covers of Samuray songs. (SUF ¶¶
3 22-23.) Matilde has not filed an opposition. Based on the
4 evidence on the record, the Court finds that Plaintiffs are
5 entitled to summary judgment on their cancellation claim.

6 **C. Plaintiffs' Other Claims**

7 Although Plaintiffs seemingly move for summary judgment on all
8 of their claims, their MSJ only addresses the claims for federal
9 trademark infringement, cancellation, and injunctive relief.
10 Plaintiffs' MSJ does not address their other claims, including
11 their state law claims. Plaintiffs clarified at the hearing on
12 this motion that they would not pursue the other claims.
13 Accordingly, the Court will consider those claims abandoned.

14 **IV. CONCLUSION**

15 The Court GRANTS summary judgment in favor of Plaintiffs on
16 their claims for federal trademark infringement and cancellation of
17 Defendants' trademark. The Court further GRANTS Plaintiffs'
18 request for injunctive relief. The Court permanently enjoins and
19 restrains Defendants Favian Tapia Matilde, Delia Tapia and their
20 respective officers, agents, servants, employees, and attorneys,
21 and other persons who are in active concert or participation with
22 any of the aforementioned persons from using the SAMURAY service
23 mark, or any confusingly similar or colorable imitation of the
24 mark, in any manner in connection with the sale, advertising,
25 offering, announcing or promotion of musical services, such as live

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1 performances of a musical group, or products, such as phonograph
2 records, CDs, DVDs or their digital counterparts.

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4 IT IS SO ORDERED.

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7 Dated: September 30, 2015



DEAN D. PREGERSON
United States District Judge

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