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UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

RAUL CAIZ,  
Plaintiff,  
v.  
WILLIAM LEONARD ROBERTS II,  
aka MASTERMIND aka RICK  
ROSS, UNIVERSAL MUSIC  
GROUP, INC., DEF JAM  
RECORDS, INC., MAYBACH  
MUSIC GROUP, LLC,  
Defendants.

CV No. 15-09044-RSWL-  
AGRx  
**ORDER Re: DEFENDANTS'  
MOTION FOR SUMMARY  
JUDGMENT [44]**

**I. INTRODUCTION**

Currently before the Court is Defendants William Leonard Roberts II aka Mastermind aka Rick Ross ("Roberts"), Universal Music Group, Inc. ("Universal"), Def Jam Records, Inc., ("Def Jam"), and Maybach Music Group, LLC's ("Maybach") (collectively, "Defendants") Motion for Summary Judgment [44]. The Court, having reviewed all papers and arguments submitted pertaining

1 to this Motion, **NOW FINDS AND RULES AS FOLLOWS:**  
2 Defendants' Motion for Summary Judgment [44] is  
3 **GRANTED.**

## 4 **II. BACKGROUND**

### 5 **A. Factual Background**

6 Plaintiff's claims against Defendants include  
7 Federal Trademark Infringement pursuant to 15 U.S.C. §  
8 1114, a violation of the Lanham Act, 15 U.S.C. §  
9 1125(a), Federal Trademark Dilution, Unfair Enrichment,  
10 Unfair Competition, and Misappropriation. Compl. ¶¶  
11 39-65. Plaintiff is a hip-hop music artist. Id. at ¶  
12 2. Plaintiff owns the trademark rights to  
13 "Mastermind." Id. Roberts is also a hip-hop artist.  
14 Id. at ¶ 3. Plaintiff alleges Defendants have wilfully  
15 infringed on Plaintiff's trademark rights by releasing  
16 an album entitled "Mastermind," titling Roberts' tour  
17 "Mastermind," and Roberts taking on the persona of  
18 "Mastermind," causing confusion in the marketplace.  
19 Id. Defendants filed a Counterclaim of cancellation of  
20 the federal trademark registration under 28 U.S.C. §  
21 2201(a) and 15 U.S.C. §§ 1119, 1064. Counterclaim ¶ 5.  
22 Defendants allege the "Mastermind" mark is invalid  
23 because it is a generic and/or merely descriptive term  
24 that has not acquired a secondary meaning and Plaintiff  
25 has abandoned the mark. Id. at ¶ 12.

### 26 **B. Procedural Background**

27 On November 20, 2015, Plaintiff filed a Complaint  
28 in this Court [1]. On February 16, 2016, Defendants

1 filed an Answer [18]. On February 18, 2016, Defendants  
2 filed a Counterclaim against Plaintiff [22]. On March  
3 8, 2016, Plaintiff filed an Answer to the Counterclaim  
4 [23]. On October 7, 2016, Defendants filed the instant  
5 Motion for Summary Judgment along with a Statement of  
6 Undisputed Facts and Conclusions of Law [44][45]. On  
7 October 7, 2016, Defendants also filed a Request for  
8 Judicial Notice [46]. On October 18, 2016, Plaintiff  
9 filed an Opposition to the Motion for Summary Judgment  
10 along with a Statement of Disputed Facts and an  
11 Opposition to Defendants' Statement of Undisputed Facts  
12 [52]. On October 25, 2016, Defendants filed a Reply  
13 [53].

### 14 III. DISCUSSION

#### 15 A. Legal Standard

##### 16 1. Motion for Summary Judgment

17 Federal Rule of Civil Procedure 56 states that a  
18 "court shall grant summary judgment" when the movant  
19 "shows that there is no genuine dispute as to any  
20 material fact and the movant is entitled to judgment as  
21 a matter of law." Fed. R. Civ. P. 56(a). A fact is  
22 "material" for purposes of summary judgment if it might  
23 affect the outcome of the suit, and a "genuine issue"  
24 exists if the evidence is such that a reasonable fact-  
25 finder could return a verdict for the non-moving party.  
26 Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248  
27 (1986). The evidence, and any inferences based on  
28 underlying facts, must be viewed in the light most

1 favorable to the opposing party. Twentieth Century-Fox  
2 Film Corp. v. MCA, Inc., 715 F.2d 1327, 1329 (9th Cir.  
3 1983). In ruling on a motion for summary judgment, the  
4 court's function is not to weigh the evidence, but only  
5 to determine if a genuine issue of material fact  
6 exists. Anderson, 477 U.S. at 255.

7 Under Rule 56, the party moving for summary  
8 judgment has the initial burden to show "no genuine  
9 dispute as to any material fact." Fed. R. Civ. P.  
10 56(a); see Nissan Fire & Marine Ins. Co. v. Fritz Cos.,  
11 210 F.3d 1099, 1102-03 (9th Cir. 2000). The burden  
12 then shifts to the non-moving party to produce  
13 admissible evidence showing a triable issue of fact.  
14 Nissan Fire & Marine Ins., 210 F.3d at 1102-03; see  
15 Fed. R. Civ. P. 56(a). When a defendant moves for  
16 summary judgment, summary judgment "is appropriate when  
17 the plaintiff fails to make a showing sufficient to  
18 establish the existence of an element essential to  
19 [their] case, and on which [they] will bear the burden  
20 of proof at trial." Cleveland v. Policy Mgmt. Sys.  
21 Corp., 526 U.S. 795, 805-06 (1999); Celotex Corp. v.  
22 Catrett, 477 U.S. 317, 322 (1986).

23 The standard for a motion for summary judgment  
24 "provides that the mere existence of *some* alleged  
25 factual dispute between the parties will not defeat an  
26 otherwise properly supported motion for summary  
27 judgement; the requirement is that there be no *genuine*  
28 issues of *material* fact." Anderson, 477 U.S. at 247-

1 48.

2 **B. Findings of Fact**

3 1. Plaintiff owns a federal registration in the  
4 trademark "Mastermind." Plaintiff applied for  
5 registration on December 24, 2005 and the  
6 registration was approved on July 16, 2013 in  
7 Classes 009 and 41, Registration No. 4,366,332.  
8 Defs.' Statement of Undisputed Facts ¶ 1; Compl. ¶  
9 25.

10 2. Class 009 consists of: audio recordings featuring  
11 music; downloadable musical sound recordings;  
12 downloadable video recordings featuring music;  
13 musical sound recordings; musical video recordings;  
14 pre-recorded CD's, video tapes, laser disks and  
15 DVD's featuring music; video recordings featuring  
16 music; visual recordings and audio visual  
17 recordings featuring music and animation, excluding  
18 content consisting of general knowledge questions,  
19 quizzes and games. Defs.' Ex. 1. Class 41  
20 consists of: Entertainment in the nature of live  
21 performances by a performer or group;  
22 [entertainment in the nature of visual and audio  
23 performances, and musical, variety, news and comedy  
24 shows; entertainment in the nature of visual and  
25 audio performances, namely, musical band, rock  
26 group, gymnastics, dance and ballet performances;  
27 entertainment, namely, live performances by a  
28 musical band;] entertainment services, namely,

1 providing a web site featuring musical  
2 performances, musical performances, musical videos,  
3 related film clips, photographs, and other  
4 multimedia materials; entertainment services,  
5 namely, providing prerecorded music, information in  
6 the field of music, and commentary and articles  
7 about music, all on-line via a global computer  
8 network, entertainment, namely, live music  
9 concerts; entertainment, namely, live performances  
10 by musical bands, excluding general knowledge  
11 questions, quizzes, and games. Id.

12 3. On February 24, 2012, Plaintiff amended the  
13 Statement of Use and deleted "video tapes, laser  
14 disks and DVD's featuring music." Defs.' Statement  
15 of Undisputed Facts ¶ 3.

### 16 **C. Analysis**

#### 17 1. Defendants' Request for Judicial Notice is 18 Granted

19 As an initial matter, Defendants request the Court  
20 take judicial notice of the United States Patent and  
21 Trademark Office ("USPTO") "File History" for  
22 Registration No. 4,366,332 for the "Mastermind" mark  
23 which was downloaded from the USPTO web site on  
24 September 14, 2016. Defs.' Req. for Judicial Notice  
25 1:2-12.

26 A court may take judicial notice of a fact that is  
27 not subject to reasonable dispute because it "can be  
28 accurately and readily determined from sources whose

1 accuracy cannot reasonably be questioned." Fed. R.  
2 Evid. 201(b)(2). Plaintiff did not object to the Court  
3 taking judicial notice of the "File History." VMR  
4 Products, LLC v. V2H ApS, No. 2:13-CV-7719-CBM-JEMX,  
5 2016 WL 1177834, at \*1 (C.D. Cal. Mar. 18, 2016).  
6 Courts may also take judicial notice of "'records and  
7 reports of administrative bodies,' file histories, and  
8 application materials." Balance Studio, Inc. v.  
9 Cybernet Entm't, LLC, No. 15-CV-04038-DMR, 2016 WL  
10 1559745, at \*1 (N.D. Cal. Apr. 18, 2016)(quoting Mack  
11 v. South Bay Beer Distributors, Inc., 798 F.2d 1279,  
12 1282 (9th Cir. 1986)); see Oroamerica Inc. v. D&W  
13 Jewelry Co., Inc., 10 F. App'x 516, 517 n.4 (9th Cir.  
14 2001).

15 Because the document is not subject to reasonable  
16 dispute, is capable of accurate and ready determination  
17 by resort to sources whose accuracy cannot reasonably  
18 be questioned, and is a matter of public record, see  
19 Lee v. City of L.A., 250 F.3d 668, 689 (9th Cir. 2001),  
20 the Court **GRANTS** Defendants' Request for Judicial  
21 Notice of the "File History" for Registration No.  
22 4,366,332 for the "Mastermind" mark.

23 2. The Trademark for "Mastermind" Should be  
24 Cancelled because it is a Descriptive Term and  
25 has not Acquired Secondary Meaning

26 Courts have the power to order the cancellation of  
27 registrations in whole or in part. 15 U.S.C. § 1119.  
28 Defendants contend the registration for "Mastermind"

1 should be cancelled because it is a descriptive term  
2 that has failed to acquire secondary meaning. Mot.  
3 5:4-10. Plaintiff argues that the mark is not  
4 descriptive but suggestive entitling the mark to  
5 trademark protection. Opp'n 8:20. Even if it is  
6 descriptive, it has acquired secondary meaning. Id. at  
7 12:10-12.

8 "When a plaintiff pursues a trademark action  
9 involving a properly registered mark, that mark is  
10 presumed valid, and the burden of proving that the mark  
11 is generic rests upon the defendant." Solid 21, Inc.  
12 v. Hublot of America, 109 F. Supp. 3d 1313, 1322 (C.D.  
13 Cal. 2015)(citing Yellow Cab Co. of Sacramento v.  
14 Yellow Cab of Elk Grove, Inc., 419 F.3d 925, 927 (9th  
15 Cir. 2005)). While 15 U.S.C. § 1115(a) does state that  
16 a registration is admissible and is "prima facie  
17 evidence of the validity of the registered mark and of  
18 the registration of the mark," the section goes on to  
19 say that it "shall not preclude another person from  
20 proving any legal or equitable defense or defect."  
21 Therefore, while there is a presumption of validity,  
22 Defendants can attack that presumption on a motion for  
23 summary judgment.

24 Courts have classified trademarks in one of five  
25 categories of increasing distinctiveness: (1) generic,  
26 (2) descriptive, (3) suggestive, (4) arbitrary, or (5)  
27 fanciful. Solid 21, 109 F. Supp. 3d at 1323 (citing  
28 Zobmondo Entm't, LLC, v. Falls Media, LLC, 602 F.3d



1 1108, 1113 (9th Cir. 2010)). The last three  
2 classifications are automatically protected "because  
3 they identify a product's source." Id. (citing Yellow  
4 Cab, 419 F.3d at 927). "[D]escriptive marks, which  
5 describe the qualities or characteristics of a product,  
6 may be registered only if the holder of the mark shows  
7 that the mark has acquired distinctiveness through  
8 secondary meaning.'" Id. (quoting KP Permanent  
9 Make-Up, Inc. v. Lasting Impression I, Inc., 408 F.3d  
10 596, 602 (9th Cir. 2005)); see also Zobmondo Entm't,  
11 602 F.3d at 1113 (finding descriptive marks must have  
12 secondary meaning to be protected).

13 Courts look to the thought process from the mark to  
14 the actual product finding that "[i]f the mental leap  
15 between the word and the product's attribute is not  
16 almost instantaneous, this strongly indicates  
17 suggestiveness, not direct descriptiveness."  
18 Self-Realization Fellowship Church v. Ananda Church of  
19 Self-Realization, 59 F.3d 902, 911 (9th Cir.  
20 1995)(citations omitted). "A trademark is descriptive  
21 if it describes the product to which it refers or its  
22 purpose." Self-Realization Fellowship, 59 F.3d at 910  
23 (citations omitted). A trademark is suggestive "if  
24 'imagination' or a 'mental leap' is required in order  
25 to reach a conclusion as to the nature of the product  
26 being referenced." Lahoti v. VeriCheck, Inc., 586 F.3d  
27 1190, 1198 (9th Cir. 2009)(quoting Filipino Yellow  
28 Pages, Inc. v. Asian Journal Publ'ns, Inc., 198 F.3d

1 1143, 1147 n.3 (9th Cir. 1999)).

2 A court's determination of whether a mark is  
3 suggestive or descriptive is not as clear as one would  
4 hope and is not as objective as one would think.  
5 Zobmondo Entm't, 602 F.3d at 1114; Lahoti, 586 F.3d at  
6 1197. The dictionary definition may be relevant in the  
7 analysis of whether a mark is descriptive because it  
8 shows how the public may view the mark and what, if  
9 any, mental step is needed. Zobmondo Entm't, 602 F.3d  
10 at 1116; see Surgicenters of Am., Inc. v. Med. Dental  
11 Surgeries, Co., 601 F.2d 1011, 1015 n.11 (9th Cir.  
12 1979)("While not determinative, dictionary definitions  
13 are relevant and often persuasive in determining how a  
14 term is understood by the consuming public . . ."); cf.  
15 Entrepreneur Media, Inc. v. Smith, 279 F.3d 1135, 1142  
16 (9th Cir. 2002)(holding that "Entrepreneur" is merely  
17 descriptive as the name of a magazine because an  
18 "entirely unimaginative, literal-minded person" would  
19 understand its meaning).

20 The issue for the Court to determine is whether  
21 "Mastermind" is descriptive with respect to Plaintiff's  
22 audio and visual recordings, live performances, and the  
23 other goods and services in Classes 009 and 41. It is  
24 difficult for the Court to conclude, as Plaintiff  
25 suggests, that a consumer would need to make a mental  
26 leap to conclude that "Mastermind" is attributed to  
27 Plaintiff's goods and services. "Descriptive terms  
28 'describe[ ] a person, a place or an attribute of a

1 product.'" Japan Telecom, Inc. v. Japan Telecom  
2 America Inc., 287 F.3d 866, 872 (9th Cir. 2002)  
3 (quoting New Kids on the Block v. New Am. Publ'g, Inc.,  
4 971 F.2d 302, 306 (9th Cir. 1992)). Defendants assert  
5 that "Mastermind" is descriptive as it applies to  
6 "creative artists," based on Oxford Dictionary's  
7 definition of "Mastermind" as "a person with an  
8 outstanding intellect" and the first usage example  
9 references "an eminent musical mastermind." Reply 6:5-  
10 15. Plaintiff utilizes Merriam-Webster's definition of  
11 "Mastermind" which means "to plan and organize  
12 something" as a noun and as a verb "a person who plans  
13 and organized something." Opp'n 7:16-20. Of interest,  
14 Merriam-Webster also includes a definition of  
15 "Mastermind" as "a person who supplies the directing or  
16 creative intelligence for a project."

17 <https://www.merriam-webster.com/dictionary/mastermind>.

18 Moreover, the overwhelming evidence provided by  
19 Defendants—that so many others in the rap industry have  
20 utilized the mark "Mastermind" in album titles, web  
21 sites, and song lyrics—refutes Plaintiff's assertion  
22 that such a mental leap or imagination is required to  
23 attribute "Mastermind" to audio and visual recordings,  
24 audio recordings featuring music, musical video  
25 recordings, live performances, and other goods and  
26 services noted in Classes 009 and 41. Therefore, the  
27 Court finds that the "Mastermind" mark is descriptive.

28 The question of whether a trademark has acquired

1 secondary meaning is one of fact. Levi Strauss & Co.  
2 v. Blue Bell, Inc., 778 F.2d 1352, 1355 (9th Cir. 1985)  
3 (en banc). However, that does not preclude the Court,  
4 on a motion for summary judgment, from determining  
5 whether Plaintiff has provided a genuine issue of  
6 material fact as to whether a mark has obtained  
7 secondary meaning. Yellow Cab, 419 F.3d at 930.  
8 Plaintiff needs to provide enough evidence showing  
9 secondary meaning to establish a genuine dispute of  
10 fact. Japan Telecom, 287 F.3d at 873; see Fed. R. Civ.  
11 P. 56(e).

12 If a trademark that is descriptive lacks secondary  
13 meaning, it is invalid. Bada Co. v. Montgomery Ward &  
14 Co., 426 F.2d 8, 11 (9th Cir. 1970). To acquire  
15 secondary meaning, section 1052(f) requires that the  
16 mark must have become "distinctive of the applicant's  
17 goods." 15 U.S.C. § 1052(f); Filipino Yellow Pages,  
18 198 F.3d at 1147. "The basic element of secondary  
19 meaning is a mental recognition in buyers' and  
20 potential buyers' minds that products connected with  
21 the [mark] are associated with the same source." Levi  
22 Strauss & Co. v. Blue Bell, Inc., 632 F.2d 817, 820  
23 (9th Cir. 1980). A mark has acquired secondary meaning  
24 if buyers and potential buyers automatically associate  
25 the mark with Plaintiff. Self-Realization Fellowship,  
26 59 F.3d at 911-12 (holding Plaintiff failed to  
27 establish "Self-Realization" acquired secondary meaning  
28 because members of the American Hindu-Yoga community

1 believed the mark was a spiritual state of mind and did  
2 not automatically associate a "Self-Realization"  
3 product with Plaintiff).

4 There are many ways to establish if a trademark has  
5 acquired secondary meaning. These include: direct  
6 consumer testimony; survey evidence; amount of sales  
7 and number of customers; established place in the  
8 market; and proof of intentional copying by the  
9 defendant. Filipino Yellow Pages, 198 F.3d at 1151. A  
10 plaintiff "must show that the primary significance of  
11 the term in the minds of the consuming public is not  
12 the product but the producer.'" Transgo, Inc. v. Ajac  
13 Transmission Parts Corp., 768 F.2d 1001, 1015 (9th Cir.  
14 1985)(quoting Kellogg Co. v. National Biscuit Co., 305  
15 U.S. 111, 118 (1938)). Other factors to consider  
16 include: "(1) whether actual purchases of the product  
17 bearing the claimed trademark associate the trademark  
18 with the producer, (2) the degree and manner of  
19 advertising under the claimed trademark, (3) the length  
20 and manner of use of the claimed trademark, and (4)  
21 whether use of the claimed trademark has been  
22 exclusive." Id. (citing 1 Gilson, Trademark Protection  
23 & Practice, § 2.09[1]). Expert surveys can be  
24 extremely persuasive as evidence of secondary meaning.  
25 Levi Strauss, 778 F.2d at 1358.

26 Plaintiff argues that there is confusion in the  
27 marketplace between Plaintiff and Roberts. Opp'n 6:23-  
28 26. However, Plaintiff has not provided any evidence

1 to show this actual confusion. His personal and  
2 conclusory statements and assertions are not enough.  
3 Japan Telecom, 287 F.3d at 873-75 (finding that two  
4 incorrectly addressed pieces of mail was not sufficient  
5 to show actual confusion that buyers had come to  
6 associate "Japan Telecom" with just one company). The  
7 court in Japan Telecom held that Plaintiff's  
8 advertising from 1984 was not sufficient to establish  
9 secondary meaning because when looking to the amount,  
10 nature, and geographical scope of the advertisement,  
11 there was not sufficient evidence that the mark was  
12 used in a way "that any more than a small set of buyers  
13 had gained any familiarity with it" since the  
14 advertisement was geared to the Japanese community in  
15 Southern California. Id. at 873-75.

16 Plaintiff has failed to show a genuine issue of  
17 material fact that disproves Defendants assertion that  
18 there are numerous artists, web sites, album titles,  
19 and song lyrics that all utilize "Mastermind" in one  
20 form or another. Mot. 3:16-27; 4; Defs.' Statement of  
21 Undisputed Facts ¶¶ 22-24. Plaintiff's argument that  
22 the fact the social media platform Myspace currently  
23 has dozens of musicians utilizing "Mastermind" is  
24 irrelevant because the website is not a relevant,  
25 active, or popular website is unavailing. Pl.'s Opp'n  
26 to Disputed Facts 11:20-13:12. The fact that a website  
27 is not as popular as it once was does not change the  
28 fact that it does exist and there are other artists

1 utilizing "Mastermind" in one form or another.

2        Additionally, Plaintiff fails to create a genuine  
3 dispute of fact that "Mastermind" is widely used as a  
4 descriptive term by other rappers, in album titles, and  
5 song lyrics by his statement that he is the only hip-  
6 hop artist who owns the trademark for "Mastermind."  
7 The fact that he is the only registered trademark owner  
8 of "Mastermind" does not change the very fact that it  
9 is being used by others. And Plaintiff's conclusory  
10 statement that he is the only person in the hip-hop  
11 industry on the West Coast to use it does not create an  
12 issue of fact. Without actual evidence, Plaintiff  
13 fails to show that buyers or potential buyers would  
14 only connect "Mastermind" to Plaintiff. Defendants  
15 have shown the numerous other uses of "Mastermind" by  
16 other individuals making it clear that use of the  
17 trademark has not been exclusive. Defs.' Exs. F, G, H,  
18 I. These include: a Myspace search of "Mastermind"  
19 with numerous results of other individuals using  
20 "Mastermind" (not only Plaintiff) and several articles  
21 and web sites depicting artists using "Mastermind" in  
22 song titles, album names, as an artist name, or in  
23 reference to a characteristic of an artist. Id.

24        While Plaintiff did provide flyers purportedly  
25 showing him using "Mastermind" for performances at  
26 various venues, the advertisements did not include the  
27 years of the performances. Pl.'s Ex. D. However,  
28 assuming they are for performances throughout numerous

1 years, this alone is not sufficient to conclude the  
2 mark has acquired a secondary meaning. Moreover, while  
3 Plaintiff provides a screenshot of some of his songs  
4 for sale on the website iTunes as "Mastermind,"  
5 Plaintiff has failed to create a genuine issue of  
6 material fact that the mark has become "distinctive of  
7 the applicant's goods" and that buyers automatically  
8 associate the "Mastermind" mark with Plaintiff's goods  
9 or services, in light of Defendants' overwhelming  
10 evidence of the mark's use by other individuals and  
11 entities. Pl.'s Ex. L; Defs.' Exs. F, G, H, I;  
12 Filipino Yellow Pages, 198 F.3d at 1147;  
13 Self-Realization Fellowship, 59 F.3d at 911-12.

14 For the reasons set forth above, Plaintiff does not  
15 have a protectable trademark in the "Mastermind" mark  
16 because it is descriptive and has not acquired  
17 secondary meaning. Summary judgment is granted in  
18 favor of Defendants as to its counterclaim.

19 The Court notes that Defendants also argued the  
20 trademark should be cancelled for several other reasons  
21 including: 1) Plaintiff used the mark as a signature  
22 and not a source identifier, Mot. 5:11-16, 2) Plaintiff  
23 failed to use the mark in commerce in connection with  
24 all of the goods listed in Class 009, id. at 9:15-17,  
25 3) Plaintiff committed fraud upon the USPTO in  
26 obtaining the trademark, id. at 11:4-6, and 4)  
27 Plaintiff abandoned the mark. Mot. 12:6-9. As the  
28 Court has determined the mark should be cancelled



1 because it is a descriptive term and it has not  
2 acquired secondary meaning, the Court declines to go  
3 through the unnecessary analysis of the additional  
4 arguments Defendants assert to support cancellation of  
5 the trademark.

6 3. There is no Genuine Issue of Material Fact  
7 as to Plaintiff's Federal Dilution Claim  
8 and Summary Judgment Should be Granted in Favor  
9 of Defendants as to this Claim

10 Defendants also request summary judgment as to  
11 Plaintiff's federal dilution claim because Plaintiff's  
12 use of "Mastermind" is not famous. Mot. 14:1-4. To be  
13 successful on a claim for dilution, a party must show  
14 "that (1) the mark is famous and distinctive; (2) the  
15 defendant is making use of the mark in commerce; (3)  
16 the defendant's use began after the mark became famous;  
17 and (4) the defendant's use of the mark is likely to  
18 cause dilution by blurring or dilution by tarnishment."<sup>1</sup>

---

19  
20 <sup>1</sup> A mark is famous "if it is widely recognized by the  
21 general consuming public of the United States as a designation of  
22 source of the goods or services of the mark's owner." 15 U.S.C.  
23 § 1125(c)(2)(A). Courts may consider the following factors in  
24 determining if a mark is sufficiently recognizable including:  
25 "(i) the duration, extent, and geographic reach of advertising  
26 and publicity of the mark, whether advertised or publicized by  
27 the owner or third parties; (ii) the amount, volume, and  
28 geographic extent of sales of goods or services offered under the  
mark; (iii) the extent of actual recognition of the mark; (iv)  
whether the mark was registered under the Act of March 3, 1881,  
or the Act of February 20, 1905, or the principal register." Id.  
at § 1125(c)(2)(A). Dilution by blurring is an "association  
arising from the similarity between a mark or trade name and a  
famous mark that impairs the distinctiveness of the famous mark."  
Id. at § 1125(c)(2)(B). Courts may consider the following

1 Jada Toys, Inc. v. Mattel, Inc., 518 F.3d 628, 634 (9th  
2 Cir. 2007); 15 U.S.C. § 1125(c)(1). The finding of a  
3 mark as famous is "a rigorous standard, as it extends  
4 protection only to highly distinctive marks that are  
5 well-known throughout the country." Green v. Fornario,  
6 486 F.3d 100, 105 (3d Cir. 2007).

7 Plaintiff's "Mastermind" mark is not famous because  
8 as the Court discussed above, it is merely descriptive  
9 without secondary meaning. Plaintiff has failed to  
10 show that "Mastermind" is "widely recognized by the  
11 general consuming public of the United States as a  
12 designation of source of the goods or services" of the  
13 mark Plaintiff owns. 15 U.S.C. § 1125(c)(1). While  
14 Plaintiff alleges he has used the mark for nearly  
15 eighteen years, Plaintiff fails to show the extent and  
16 geographic reach of advertising and publicity of the  
17 mark. See Jada Toys, Inc., 518 F.3d at 635 (holding  
18 that 350 million dollars expended in advertising the  
19 mark, three billion units bearing the mark having been

20 \_\_\_\_\_  
21 factors to determine if a mark is likely to cause dilution by  
22 blurring: (i) the degree of similarity between the mark or trade  
23 name and the famous mark; (ii) the degree of inherent or acquired  
24 distinctiveness of the famous mark; (iii) the extent to which the  
25 owner of the famous mark is engaging in substantially exclusive  
26 use of the mark; (iv) the degree of recognition of the famous  
27 mark; (v) whether the user of the mark or trade name intended to  
28 create an association with the famous mark; (vi) any actual  
association between the mark or trade name and the famous mark."  
Id. Dilution by tarnishment is an "association arising from the  
similarity between a mark or trade name and a famous mark that  
harms the reputation of the famous mark." Id. at §  
1125(c)(2)(C).

1 sold, and the units bearing the mark having been sold  
2 in all fifty states and throughout the work supported a  
3 finding that HOT WHEELS was famous). Additionally,  
4 Plaintiff provided the Court with no evidence of the  
5 amount, volume, and geographic extent of the total  
6 sales of his goods under the "Mastermind" mark. In his  
7 declaration and disputed material facts, Plaintiff  
8 states that as early as 1999, he sold pre-recorded CD's  
9 and his audio recordings were available for purchase as  
10 early as 2006 via SNOCAP download, which is a digital  
11 rights company and downloading software. Opp'n 5:10-  
12 16. However, Plaintiff provides absolutely no  
13 documentation to support those contentions that creates  
14 a genuine issue of fact that the mark is famous.

15 Moreover, there is no evidence of actual  
16 recognition of the mark, as Plaintiff failed to even  
17 address Defendants' request for summary judgment as to  
18 Plaintiff's dilution claim.<sup>2</sup> Such things as surveys or

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19  
20 <sup>2</sup> Defendants request sanctions against Plaintiff for  
21 Plaintiff's failure to meet and confer in good faith pursuant to  
22 Local Rule 7-3 as to Plaintiff's federal dilution claim because  
23 Plaintiff did not reconsider its position in dismissing this  
24 claim after Defendants advised Plaintiff of the lack of merit of  
25 the claim and Plaintiff did not even mention the claim in its  
26 Opposition. Reply 2:5-22. While the Court encourages parties to  
27 attempt resolution of disputes during the meet and confer  
28 process, the fact that Plaintiff did not dismiss this claim after  
what Defendants believe was compelling evidence of a lack of  
merit of the claim or Plaintiff's failure to address the claim in  
its Opposition is not grounds for sanctions. The Court will not  
assume why Plaintiff failed to dismiss the claim after conferring  
with Defendants or why Plaintiff failed to specifically address  
the federal dilution claim in its Opposition. The Court denies  
Defendants request for sanctions against Plaintiff.

1 expert opinion, or the lack thereof, weigh heavily in  
2 finding whether there is actual recognition of a mark  
3 and that it is famous. Network Automation, Inc. v.  
4 Hewlett-Packard Co., No. CV 08-4675-JFW-RZX, 2009 WL  
5 5908719 at \*10-11 (C.D. Cal. Sept. 14, 2009); see Visa  
6 International Service Association v. JSL Corp., 590 F.  
7 Supp. 2d 1306, 1315 (D. Nev. 2008) (holding "that a  
8 survey by plaintiff's expert demonstrating that 99  
9 percent of respondents were aware of the VISA brand  
10 weighed heavily in favor of a finding of fame.")

11 The Ninth Circuit has held that "[d]ilution is a  
12 cause of action invented and reserved for a select  
13 class of marks—those marks with such powerful consumer  
14 association that even non-competing uses can impinge on  
15 their value." Avery Dennison Corp. v. Sumpton, 189  
16 F.3d 868, 875 (9th Cir. 1999). Courts have held that  
17 for a mark to be famous, it must be "truly prominent  
18 and renowned." Id. at 875; (quoting I.P. Lund Trading  
19 ApS v. Kohler Co., 163 F.3d 27, 46 (1st Cir. 1998)).

20 While Plaintiff has had a lengthy professional  
21 career in the hip-hop industry, there is no evidence  
22 that the "Mastermind" mark is so "widely recognized by  
23 the general consuming public of the United States" as  
24 it relates to identifying Plaintiff and his goods and  
25 services. 15 U.S.C. § 1125(c)(2)(A). At the very  
26 least, Plaintiff has failed to provide any supported  
27 factual disputes that would call this conclusion into  
28 question.

1 As the mark is not famous, there is no issue of  
2 fact as to whether Defendants' use began after the mark  
3 became famous. Since Plaintiff failed to provide the  
4 Court with any genuine issue of material fact as to  
5 whether the "Mastermind" mark is famous, the Court need  
6 not analyze whether Defendants are making use of the  
7 mark in commerce or whether Defendants' use of the mark  
8 is likely to cause dilution by blurring or dilution by  
9 tarnishment. As such, summary judgment is granted in  
10 favor of Defendants on Plaintiff's federal dilution  
11 claim.

12 4. There May be a Genuine Issue of Material Fact  
13 as to Defendants' Fair Use Defense

14 Defendants also request summary judgment as to  
15 Plaintiff's claims because its use of "Mastermind" is  
16 subject to the fair use defense. Mot. 17:13.  
17 Plaintiff counters this argument in citing a Third  
18 Circuit case and states that fair use is not a defense  
19 for a registered trademark, only for copyright  
20 infringement. Opp'n 18:24-19:4. Defendants are  
21 correct that Plaintiff has misread the holding of  
22 Century 21 Real Estate Corp. v. Lendingtree, Inc., 425  
23 F.3d 211, 233 (3d Cir. 2005). It was in the dissent  
24 that Judge Fisher articulated his opinion that  
25 nominative fair use is not a valid affirmative defense  
26 to trademark infringement.

27 Fair use is a valid affirmative defense to  
28 trademark infringement. Bauer Bros., LLC v. Nike,

1 Inc., 159 F. Supp. 3d 1202, 1212-13 (S.D. Cal. 2016).  
2 There are two types of fair use that can be asserted as  
3 an affirmative defense, classic and nominative. 15  
4 U.S.C. § 1115(b); Cairns v. Franklin Mint Co., 292 F.3d  
5 1139, 1150 (9th Cir. 2002). Classic fair use is  
6 employed when a defendant has used a plaintiff's mark  
7 to describe his own product while nominative fair use  
8 is employed when a defendant has used a plaintiff's  
9 mark to describe the plaintiff's product. Cairns, 292  
10 F.3d at 1150. Classic fair use involves a defendant's  
11 use of a descriptive term in its "primary, descriptive  
12 sense." Id. at 1151; Fortune Dynamic, Inc. v.  
13 Victoria's Secret Stores Brand Management, Inc., 618  
14 F.3d 1025, 1031 (9th Cir. 2010). The purpose of the  
15 fair use defense is to prevent any one individual from  
16 obtaining a monopoly of a descriptive term simply by  
17 trademarking it first. Fortune Dynamic, 618 F.3d at  
18 1039. Here, Defendants are asserting a classic fair  
19 use defense to trademark infringement. Reply 4:12-14.

20 To successfully assert a classic fair use defense a  
21 defendant must show: "1) [d]efendant's use of the term  
22 is not as a trademark or service mark; 2) [d]efendant  
23 uses the term 'fairly and in good faith;' and 3)  
24 [d]efendant uses the term 'only to describe its goods  
25 or services.'" Cairns, 292 F.3d at 1151; 15 U.S.C. §  
26 1115(b)). Classic fair use is not available as a  
27 defense if there is a likelihood of confusion as to the  
28 ///

1 origin of the product.<sup>3</sup> Bauer Bros., 159 F. Supp. 3d  
2 at 1212-13.

3 Defendants fail to go through each factor relevant  
4 in determining whether its use of "Mastermind" is  
5 entitled to the fair use defense. The only argument  
6 Defendants raise to assert this defense is that  
7 "Mastermind" has been so widely used as a descriptive  
8 term and Defendants did not intend that consumers  
9 recognize its works by that identifier. Mot. 17:21-28.  
10 Plaintiff fares no better in showing there is a genuine  
11 issue of material fact as to this defense because its  
12 contention is that fair use is not even a valid defense  
13 to trademark infringement (which it is) and that  
14 "Mastermind" is not merely a descriptive term. Opp'n  
15 18:24-19:12. As summary judgment is granted as to the  
16 cancellation of the trademark and Plaintiff's federal  
17 dilution claim, the Court declines to parse through the  
18 parties' lackluster arguments to go through an  
19 unnecessary analysis. Summary judgment as to  
20

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21 <sup>3</sup> Courts have used the factors utilized in determining  
22 whether there is a likelihood of confusion in determining  
23 trademark infringement from AMF Inc. v. Sleekcraft Boats, 599  
24 F.2d 341, 348-49 (9th Cir. 1979) abrogated on other grounds by  
25 Mattel, Inc. v. Walking Mountain Productions, 353 F.3d 792 (9th  
26 Cir. 2003) in determining if there is a likelihood of confusion  
27 when a fair use defense is asserted. Those factors include: 1)  
28 the strength of the mark; 2) proximity of the goods; 3)  
similarity of the marks; 4) evidence of actual confusion; 5)  
marketing channels used; 6) type of goods and the degree of care  
likely to be exercised by the purchaser; 7) defendant's intent in  
selecting the mark; and 8) the likelihood of expansion of the  
product lines.

1 Defendants' fair use defense is denied.

2 Defendants also raise an argument as to the  
3 limitations on Plaintiff's damages for any alleged  
4 infringement because of Plaintiff's failure to provide  
5 actual notice by failing to use the ® symbol pursuant  
6 to 15 U.S.C. § 1111. Mot. 18:5-22. For the same  
7 reasons stated above, this analysis is moot and the  
8 Court declines to address this argument.

9 Each of Plaintiff's claims is dependent on its  
10 ownership of a protectable trademark and Defendants'  
11 alleged infringement of the trademark "Mastermind."<sup>4</sup>  
12 Because the Court concludes that "Mastermind" is  
13 descriptive and has not acquired secondary meaning  
14 thereby not entitling the mark to trademark protection  
15 and the Court's granting of summary judgment as to  
16 Plaintiff's Federal Dilution Claim, summary judgment as  
17 to Plaintiff's remaining claims of unfair competition,  
18 unjust enrichment, and misappropriation is also

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19  
20 <sup>4</sup> Solid 21, 109 F. Supp. 3d at 1322; see 15 U.S.C. §  
21 1114(1); Lahoti, 586 F.3d at 1197 ("to state a claim under 15  
22 U.S.C. § 1114(1), plaintiff must prove ownership of a valid  
23 mark"); 15 U.S.C. § 1125(a); Int'l Order of Job's Daughters v.  
24 Lindeburg & Co., 633 F.2d 912, 917 (9th Cir. 1980) ("test for  
25 claims under 15 U.S.C. §§ 1114 and 1125(a) are the same");  
26 Entrepreneur Media, Inc. v. Smith, 279 F.3d 1135, 1153 (9th  
27 Cir.2002)("dismissing claims under California's [Unfair  
28 Competition Law] as 'substantially congruent' to claims under the  
Lanham Act")(internal quotation marks and citations omitted);  
Glow Indus., Inc. v. Lopez, 252 F. Supp. 2d 962, 975 n.90 (C.D.  
Cal. 2002)("standard under Lanham Act for trademark infringement  
and unfair competition is the same, and actions under  
California's [Unfair Competition Law] for state claims . . . for  
unfair competition are 'substantially similar to' comparable  
federal claims.")



1 granted.<sup>5</sup>

2 **IV. CONCLUSION**

3 Accordingly, the Court **GRANTS** Defendants' Request  
4 for Judicial Notice and the Court **GRANTS** Defendants'  
5 Motion for Summary Judgment.

6 **IT IS SO ORDERED.**

7 DATED: December 15, 2016 s/RONALD S.W. LEW

8 **HONORABLE RONALD S.W. LEW**  
9 Senior U.S. District Judge

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11  
12 <sup>5</sup> In Toho Co., Ltd. v. Sears, Roebuck & Co., 645 F.2d 788,  
13 794 (9th Cir. 1981), the Ninth Circuit stated that Plaintiff  
14 failed to cite to any cases extending a misappropriation theory  
15 to trademark infringement and that California courts would also  
16 not extend such theory to a claim for trademark infringement.  
17 Bell v. Harley Davidson Motor Co., 539 F. Supp. 2d 1249, 1256  
18 (S.D. Cal. 2008) ("Black-letter law holds that California's  
19 common-law doctrine of misappropriation does not extend to  
20 trademark infringement claims.") Courts have also held that  
21 unjust enrichment is not a separate cause of action but a form of  
22 relief. Klein Electronics, Inc. v. Boxwave Corp., No. 10-CV-  
23 2197- WQH-(POR), 2011 WL 2560238, at \*5 (S.D. Cal. June 27,  
24 2011)(citing Johns v. Bayer Corp., No. 09-cv-1935-DMS, 2010 WL  
25 476688, at \*6 n.3 (S.D. Cal. Feb. 9, 2010) ("While a split of  
26 authority appears to exist on this issue, this Court agrees with  
27 those courts that conclude unjust enrichment is not a separate  
28 claim."); McBride v. Boughton, 123 Cal. App. 4th 379, 387 (2004)  
("Unjust enrichment is not a cause of action . . . or even a  
remedy, but rather a general principle, underlying various legal  
doctrines and remedies. It is synonymous with restitution.")  
(internal citations omitted); see also McKell v. Wash. Mut.,  
Inc., 142 Cal. App. 4th 1457, 1490 (2006) ("There is no cause of  
action for unjust enrichment. Rather, unjust enrichment is a  
basis for obtaining restitution based on quasi-contract or  
imposition of a constructive trust.") (citation omitted)