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UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF CALIFORNIA

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THE NATIONAL GRANGE OF THE
ORDER OF PATRONS OF
HUSBANDRY, a District of
Columbia nonprofit
corporation,

 Plaintiff,

 v.

CALIFORNIA STATE GRANGE d/b/a
"CSG," a California
corporation,

 Defendant.

CIV. NO. 2:14-676 WBS AC
MEMORANDUM AND ORDER RE: MOTION
FOR INJUNCTION

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 Plaintiff National Grange of the Order of Patrons of
Husbandry brought this action against defendant California State
Grange for trademark infringement and unfair competition under
the Lanham Act. Presently before the court is plaintiff's motion
for an injunction pursuant to the Lanham Act, 15 U.S.C.
§ 1116(a). (Docket No. 126.) For the reasons explained below,

1 plaintiff's motion is GRANTED in part.

2 I. Factual and Procedural Background

3 Plaintiff is a national fraternal organization founded
4 in 1867 to promote the interests of farming and agriculture.
5 (July 14, 2015 Order at 1-2 (Docket No. 60).) Plaintiff has
6 grown to a network of approximately 2,000 local chapters across
7 the country, through which it provides a variety of goods and
8 services to agricultural communities. (Id. at 2.) Plaintiff
9 owns numerous registered numerous trademarks featuring the word
10 "Grange," which it uses for associational, educational, and
11 advocacy activities. (Id.)

12 Plaintiff chartered defendant as its affiliate
13 California state chapter in 1873. (Id.) As a chartered
14 affiliate, defendant collected dues from local subordinate
15 granges and turned over a portion of those dues to plaintiff.
16 (Id.) In 1946, defendant registered as a non-profit corporation
17 with the California Secretary of State. (Huber Decl. ¶ 8, Mar.
18 22, 2016 (Docket No. 126-3).)

19 In 2012, a dispute arose between plaintiff and
20 defendant. (Compl. ¶ 5 (Docket No. 1).) As a result, plaintiff
21 revoked defendant's charter and the parties disaffiliated. (Id.
22 ¶ 7.) Plaintiff's California-based members subsequently voted to
23 reorganize a California state chapter under the name Grange of
24 the State of California's Order of Patrons of Husbandry,
25 Chartered. (Id. ¶ 38.)

26 Despite the parties' disaffiliation, defendant
27 continued to use its registered corporate name, California State
28 Grange, and represent itself publically as California State

1 Grange on its website, at events, and in its newsletters. (July
2 14, 2015 Order at 2.) In March 2014, plaintiff filed this
3 action, bringing claims for (1) federal trademark infringement
4 under Section 32 of the Lanham Act, 15 U.S.C. § 1114; (2) unfair
5 competition and false designation of origin under Section 43(a)
6 of the Lanham Act, 15 U.S.C. § 1125(a); (3) federal trademark
7 dilution under § 43(c) of the Lanham Act, 15 U.S.C. § 1125(c);
8 and (4) federal trademark counterfeiting under § 32(1) of the
9 Lanham Act, 15 U.S.C. § 1114(1). (Compl. ¶¶ 48-101.)¹

10 On July 14, 2015, the court granted plaintiff's motion
11 for partial summary judgment on its claims for trademark
12 infringement and unfair competition and false designation of
13 origin. (July 14, 2015 Order at 12, 19.)² The court then denied
14 plaintiff's motion to enjoin defendant from using the words
15 "Granger," "CSG," and "CG" because summary judgment was limited
16 to the use of "Grange." (Sept. 29, 2015 Order at 4.) On
17 September 29, 2015, the court entered final judgment permanently
18 enjoining "defendant and its agents, affiliates, and assigns, or
19 any party acting in concert with defendant and its agents,
20 affiliates, and assigns from using marks containing the word
21 'Grange.'" (Docket No. 86.)

23 ¹ This case is related to another action presently
24 pending before this court, National Grange of the Order of
25 Patrons of Husbandry v. California State Grange, Civ. No. 2:16-
26 201 WBS AC. (Docket No. 112.) Plaintiff also filed an action in
27 California state court seeking a declaration of the parties'
rights and duties following the revocation of defendant's
charter. National Grange v. California State Grange, Civ. No.
34-2012-130434 (Cal. Sup. Ct. filed Oct. 1, 2013).

28 ² Plaintiff voluntarily dismissed its remaining claims
with prejudice. (Docket No. 64.)

1 On October 28, 2015, defendant filed a notice of appeal
2 from the court's judgment and its July 14 and September 29
3 Orders. (Docket No. 87.) Plaintiff cross-appealed the portion
4 of the court's September 29, 2015 Order limiting injunctive
5 relief to the word "Grange." (Docket No. 90.) The appeals are
6 currently pending before the United States Court of Appeals for
7 the Ninth Circuit. In January 2016, the court denied defendant's
8 motion to stay the injunction pending appeal, holding that
9 plaintiff "would be substantially injured by defendant's
10 continued infringement of its trademark were the court to grant a
11 stay of the injunction." (Jan. 12, 2016 Order at 4 (Docket No.
12 108).)

13 Defendant additionally registered with Sacramento
14 County to do business as "California State Guild" and "CSG."
15 (Sept. 29, 2015 Order at 4.) To date, however, defendant
16 continues to use "California State Grange" as its corporate name
17 on file with the California Secretary of State. (McFarland Decl.
18 ¶¶ 12-13, Feb. 22, 2016 ("McFarland I Decl.") (Docket No. 114-
19 1).) Based on defendant's continued use of "California State
20 Grange," among other things, plaintiff brought a motion for an
21 order to show cause why defendant should not be held in contempt
22 for violating the court's injunction. (Docket No. 109.) The
23 court denied that motion without prejudice to plaintiff filing
24 the pending motion and requesting to enjoin defendant's specific
25 conduct based on the issues litigated and evidence presented to
26 the court at the time of the injunction. (Docket Nos. 117, 120,
27 125.)

28 Plaintiff now moves to enjoin defendant, its agents,

1 affiliates, and any party acting in concert with defendant, from:
2 (1) using "Grange," "Granger," or "CSG" in conducting business
3 activities or as part of a business, trade, or domain name; (2)
4 using "Grange" in corporate registrations or other filings with
5 any federal, state, or local government; and (3) representing
6 themselves to be the successor to "California State Grange."
7 (Docket No. 126-4.) Plaintiff further requests that defendant
8 (4) remove the name "Grange" from all telephone and business
9 directory listings; (5) include a prominent disclaimer on its
10 website and in all future communications that it is "not
11 affiliated with the California State Grange"; (6) include a
12 hyperlink on its website that redirects users to plaintiff's
13 California-based grange website; and (7) pay plaintiff reasonable
14 attorney's fees in bringing the pending motion and its previous
15 motion for an order to show cause why defendant should not be
16 held in contempt. (Id.)

17 II. Legal Standards

18 A. Injunctive Relief Under the Lanham Act

19 Plaintiff here succeeded on its claims for trademark
20 infringement, 15 U.S.C. § 1114, and unfair competition, 15 U.S.C.
21 § 1125(a), under the Lanham Act. (See July 14, 2015 Order.)
22 Defendant has conceded that its services are identical to those
23 offered by plaintiff and that the use of "Grange" by two
24 California organizations had caused actual confusion among
25 consumers and "great confusion" among local granges. (Id. at 10-
26 11; see also Compl. ¶ 44 ("Defendant's continued use of GRANGE
27 Marks will likely lead to actual confusion among members of the
28 public, since there are two organizations--one legitimately

1 affiliated with the National Grange and one that is not--using
2 the same or substantially similar Grange name and GRANGE Marks to
3 offer the same goods and services to the same members of the
4 public.".) The court thus found that "only one inference can be
5 drawn: defendant's use of 'Grange' is likely to cause, and
6 apparently has caused, a reasonably prudent consumer in the
7 marketplace to be confused about the origin of defendant's
8 services." (July 14, 2015 Order at 12.)

9 "Injunctive relief is the remedy of choice for
10 trademark and unfair competition cases, since there is no
11 adequate remedy at law for the injury caused by a defendant's
12 continuing infringement." Century 21 Real Estate Corp. v.
13 Sandlin, 846 F.2d 1175, 1180 (9th Cir. 1988). The Lanham Act
14 authorizes the court "to grant injunctions, according to the
15 principles of equity and upon such terms as the court may deem
16 reasonable, to prevent the violation" of trademark rights and to
17 prevent unfair competition. 15 U.S.C. § 1116(a).

18 "[I]f a district court finds infringement, it retains
19 the discretion to fashion any remedy which alleviates that
20 confusion." Interstellar Starship Servs., Ltd. v. Epix, Inc.,
21 304 F.3d 936, 948 (9th Cir. 2002). Broad injunctions are
22 especially appropriate where the infringing use is for a similar
23 service. Sandlin, 846 F.2d at 1181. This court thus found that
24 injunctive relief was appropriate to prevent defendant's
25 continued trademark violations and unfair competition. See 15
26 U.S.C. § 1116(a).

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1 B. Injunctive Relief During a Pending Appeal

2 "[A]n injunction often requires continuing supervision
3 by the issuing court and always a continuing willingness to apply
4 its powers and processes on behalf of the party who obtained that
5 equitable relief." Sys. Fed'n No. 91, Ry. Emp. Dep't, AFL-CIO v.
6 Wright, 364 U.S. 642, 647-48 (1961). The court thus has
7 continuing jurisdiction here to "supervise the injunctive relief
8 [it had] granted." Transgo, Inc. v. Ajac Transm'n Parts Corp.,
9 768 F.2d 1001, 1030 (9th Cir. 1985).

10 Defendant appealed the court's judgment on October 28,
11 2015. (Docket No. 87.) Although an appeal ordinarily divests
12 the district court of jurisdiction over the matters on appeal,
13 Federal Rule of Civil Procedure 62(c) creates an exception to
14 that rule: "While an appeal is pending from an interlocutory
15 order or final judgment that grants, dissolves, or denies an
16 injunction, the court may suspend, modify, restore, or grant an
17 injunction on terms for bond or other terms that secure the
18 opposing party's rights." Fed. R. Civ. P. 62(c); see Nat. Res.
19 Def. Council, Inc. v. Sw. Marine, Inc., 242 F.3d 1163, 1166 (9th
20 Cir. 2001).

21 Rule 62(c) confers upon the district court the power
22 "it has always inherently possessed to preserve the status quo
23 during the pendency of an appeal." Nat. Res. Def. Council, 242
24 F.3d at 1166. However, the Rule "does not restore jurisdiction
25 to the district court to adjudicate anew the merits of the case."
26 Id. (citation omitted). Thus, any action taken pursuant to Rule
27 62(c) "may not materially alter the status of the case on
28 appeal." Id. (citation omitted); see In re TFT-LCD (Flat Panel)

1 Antitrust Litig., Civ. No. C-07-01827 SI, 2013 WL 6055079, at *1
2 (N.D. Cal. Nov. 13, 2013) (“[W]hile an appeal is pending, the
3 district court . . . may not take any action that would change
4 the core issues before the appellate court.”).

5 Defendant makes much of the fact that in its Reply
6 Brief (Docket No. 133) plaintiff stated that it “is not asking
7 the Court to maintain the *status quo* . . .” (Id., p. 3). The
8 court remains befuddled by that statement in the Reply Brief,
9 since preserving the status quo is exactly what plaintiff appears
10 to be asking for elsewhere in its moving papers, and it is all
11 the court intends to do by this Order.

12 Where the court supervises a continuing course of
13 conduct pursuant to an injunction, and new facts develop that
14 require additional action by the court to ensure compliance with
15 its order, an appeal from the original order “does not divest the
16 district court of jurisdiction to continue its supervision, even
17 though in the course of that supervision the court acts upon or
18 modifies the order from which the appeal is taken.” Hoffman v.
19 Beer Drivers & Salesmen’s Local Union No. 888, 536 F.2d 1268,
20 1276 (9th Cir. 1976). The court thus retains jurisdiction to
21 preserve the status quo and ensure the effectiveness of its
22 judgment, despite the pending appeal in this action. McClatchy
23 Newspapers v. Cent. Valley Typographical Union No. 46, 686 F.2d
24 731, 734-35 (9th Cir. 1982); Tribal Vill. of Akutan v. Hodel, 859
25 F.2d 662, 663 (9th Cir. 1988).

26 The status quo is measured at the time the appeal is
27 filed. In re Delta Smelt Consol. Cases, Civ. No. 1:09-407 OWW,
28 2011 WL 2559021, at *4 (E.D. Cal. June 24, 2011); see Nat. Res.

1 Def. Council, 242 F.3d at 1166); see also TFT-LCD, 2013 WL
2 6055079, at *1 (“[W]hile an appeal is pending, the district court
3 may act to preserve the status quo at the time the appeal was
4 filed.”). The permanent injunction here was entered on September
5 29, 2015, and defendant filed its appeal on October 28, 2015.
6 Accordingly, the status quo at the time the appeal was filed
7 prohibited “defendant and its agents, affiliates, and assigns, or
8 any party acting in concert with them, from using marks
9 containing the word “Grange.”

10 III. Analysis

11 Plaintiff seeks an order enjoining defendant and its
12 agents, affiliates, and assigns, or any party acting in concert
13 with them, from using the word “Grange,” including “California
14 State Grange” and “California Grange Foundation,” in any business
15 activities or as part of any trademark, service mark, trade name,
16 corporate name, domain name, or e-mail address.

17 A. Subject Matter Jurisdiction

18 Defendant argues that enjoining it from using “Grange”
19 as part of its corporate name is impermissible under Rule 62(c)
20 because the requested relief “goes well beyond preserving the
21 status quo” and “seeks to change the status quo” by granting “new
22 relief that plaintiff chose not to pursue during the litigation
23 of this action.” (Opp’n at 2 (Docket No. 132).) On that basis,
24 defendant argues plaintiff’s motion “must be denied for lack of
25 jurisdiction.” (Id.)

26 Defendant’s contention that the requested relief
27 constitutes “new relief that plaintiff chose not to pursue during
28 the litigation of this action” is not accurate. Plaintiff’s

1 Complaint sought to “[p]ermanently enjoin Defendant, as well as
2 its agents, successors, assigns, and all persons in active
3 concert or participation with Defendant, from using the GRANGE
4 Marks or any other mark, corporate name or trade name that
5 contains the word GRANGE.” (Compl. at 21-22 (emphasis added).)
6 The Complaint also requested that the court “direct that
7 Defendant’s registration of the corporate entity name ‘California
8 State Grange’ be revoked.” (Id. at 22 (emphasis added).)

9 The Ninth Circuit has repeatedly rejected the argument
10 that a district court lacks subject matter jurisdiction to grant
11 additional injunctive relief or modify its existing injunction
12 while an appeal is pending. See McClatchy, 686 F.2d at 735
13 (“[A]n appeal from an order granting an injunction does not
14 deprive the district court of jurisdiction to alter the
15 injunction for purposes of maintaining the status quo.”);
16 Hoffman, 536 F.2d at 1276 (“[I]n the case of an appeal from an
17 order granting an injunction, the district court does not lose
18 jurisdiction to alter the injunction.”). As discussed above,
19 supra Part II.B, Rule 62(c) authorizes the court to grant or
20 modify injunctive relief to preserve the status quo or ensure
21 compliance with its earlier orders. E.g., In re Icenhower, 755
22 F.3d 1130, 1138 (9th Cir. 2014); A&M Records, Inc. v. Napster,
23 Inc., 284 F.3d 1091, 1099 (9th Cir. 2002) (“The district court
24 properly exercised its power under Rule 62(c) to continue
25 supervision of [defendant’s] compliance with the injunction.”);
26 Armstrong v. Brown, 732 F.3d 955, 959 n.6 (9th Cir. 2013) (“The
27 district court acted to preserve the status quo and protect
28 plaintiffs’ rights in direct response to defendants’ repeated and

1 willful non-compliance with its earlier orders.").

2 The court may modify or broaden the scope of its
3 injunction under its continuing duty to supervise the relief
4 granted if it is informed of new facts that require additional
5 supervisory action. Hoffman, 536 F.2d at 1276 (holding that the
6 general rule that an appeal to the circuit court deprives the
7 district court of jurisdiction "should not be applied in those
8 cases where the district court, as here, has a continuing duty to
9 maintain a status quo"); see Sys. Fed'n No. 91 v. Wright, 364
10 U.S. 642, 647-48 (1961) (holding that a district court has "wide
11 discretion" to modify an injunction based on changed
12 circumstances or new facts); A&M Records, 284 F.3d at 1098-99
13 (modification of injunction during pendency of appeal was proper
14 to clarify the injunction and supervise compliance in light of
15 new facts); Meinhold v. U.S. Dep't of Def., 34 F.3d 1469, 1480
16 n.14 (9th Cir. 1994) ("DOD also contends that the district court
17 lacked jurisdiction to issue its amended order, which broadened
18 the scope of injunctive relief, because an appeal had already
19 been taken from the original order. As the district court issued
20 the amended order to clarify its original injunction and to
21 supervise compliance in the wake of [plaintiff's] motion for
22 contempt, it did not lack jurisdiction."). The court may
23 therefore grant the relief requested here.

24 The court also has the authority to enforce its orders
25 while an appeal is pending. Sekaquaptewa v. MacDonald, 544 F.2d
26 396, 406 (9th Cir. 1976). "Absent a stay, all orders and
27 judgments of courts must be complied with promptly." In re
28 Crystal Palace Gambling Hall, Inc., 817 F.2d 1361, 1364 (9th Cir

1 1987) (citation omitted). The court here denied defendant's
2 motion to stay the injunction pending appeal. (See Jan. 12, 2016
3 Order.) Defendant is therefore obliged to comply with the
4 court's previous injunction and, absent a stay, with any
5 injunctive relief granted here.

6 Granting the requested relief would also not change the
7 status quo or materially alter the status of this case on appeal.
8 In granting the requested relief, the court would not be
9 adjudicating new issues that were "not decided in its original
10 disposition of the case." McClatchy, 686 F.2d at 735 (holding
11 that the district court's post-judgment adjudication of an issue
12 not decided in its original disposition of the case materially
13 affected the substantial rights of the parties and thus did not
14 fall within the authority of Rule 62(c)). In Britton v. Co-op
15 Banking Group, 916 F.2d 1405 (9th Cir. 1990), the Ninth Circuit
16 explained that a district court's post-judgment order may not
17 "change . . . the result of the very issue on appeal." Id. at
18 1412. If such an order were allowed to stand, the appellate
19 court's decision on the original order would be moot. Id.
20 Alternatively, the appellate court would be dealing with a
21 "moving target" if it were to rule on the post-judgment order
22 instead. Id.

23 Here, by contrast, granting the requested relief would
24 not change the result of the issues on appeal. The issues on
25 appeal involve whether the court properly (1) granted plaintiff's
26 motion for partial summary judgment on its trademark infringement
27 and unfair competition claims, and (2) entered its September 29,
28 2015 permanent injunction. (Docket Nos. 87, 90.) Enjoining

1 defendant and its agents and affiliates from using the word
2 "Grange" in conducting any business activities or as part of any
3 corporate name, trademark, service mark, trade name, domain name,
4 or email address would not change the status quo because the
5 questions presented to the Ninth Circuit would remain unaffected.
6 See Nat. Res. Def. Council, 242 F.3d at 1166-67 (upholding
7 district court's post-judgment order because it "left unchanged"
8 the core questions before the appellate court); Armstrong, 732
9 F.3d at 959 n.6 ("[T]he status of this case on appeal remains
10 unaltered by the [post-judgment order] because the question
11 before us remains unchanged.").

12 Nor would the court be adjudicating any new issues that
13 were not decided in its original disposition of the case. See
14 McClatchy, 686 F.2d at 735. Plaintiff bases its requests for
15 injunctive relief in the pending motion on the court's
16 disposition that (1) plaintiff has a protectable interest in its
17 valid and federally-registered "Grange" mark, and (2) there is
18 substantial evidence that defendant's conduct created a strong
19 likelihood that a reasonably prudent consumer would be confused
20 as to the origin of defendant's services and believe that
21 defendant was affiliated with plaintiff. (July 14, 2015 Order at
22 5-10.) The court may grant plaintiff's requested injunctive
23 relief based upon these previously-adjudicated findings. See
24 Delta Smelt, 2011 WL 2559021, at *6 ("This is not a case where
25 the requested actions will change the judgment in any way.").

26 Requiring defendant and its affiliates to remove the
27 word "Grange" from their corporate names would in fact preserve
28 the status quo by ensuring compliance with the court's summary

1 judgment Order and permanent injunction. See 15 U.S.C. § 1116(a)
2 (district courts may enforce their injunctions granted under the
3 Lanham Act); Nat. Res. Def. Council, 242 F.3d at 1166 (“We
4 conclude that the district court possessed jurisdiction to modify
5 the injunction while the consolidated appeal was pending, because
6 the changes preserved the status quo and did not materially alter
7 the status of the case on appeal.”). Accordingly, the court
8 rejects defendant’s argument that it lacks jurisdiction to grant
9 the requested relief.

10 B. Defendant’s Corporate Name

11 Defendant continues to use “Grange” as part of its
12 corporate name. The California Secretary of State website
13 publically displays defendant’s name as “California State Grange”
14 and Robert McFarland as its president. See Business Entity
15 Detail for “CALIFORNIA STATE GRANGE,” <http://kepler.sos.ca.gov>
16 (last visited Apr. 14, 2016).³ Defendant’s lobbying registration
17 filed with the California Secretary of State also lists its name
18 as “California State Grange.” (McFarland Decl. Ex. C, Apr. 1,
19 2016 (“McFarland II. Decl.”) (Docket No. 132-8).)

20 Defendant has also filed its fictitious name statements
21 for “California Guild Foundation” and “CSG” with Sacramento
22

23 ³ The court takes judicial notice of filings with the
24 California Secretary of State and County of Sacramento because
25 they are matters of public record whose accuracy is not subject
26 to reasonable dispute. See Fed. R. Evid. 201; Lee v. City of Los
27 Angeles, 250 F.3d 668, 689 (9th Cir.2001); see also Grant v.
28 Aurora Loan Servs., Inc., 736 F. Supp. 2d 1257, 1265 (C.D. Cal.
2010) (judicial notice of incorporation filings with Delaware
secretary of state); Helmer v. Bank of Am., N.A., Civ. No. 2:12-
733 TLN, 2013 WL 4546285, at *2 (E.D. Cal. Aug. 27, 2013)
(judicial notice of records filed with county).

1 County under its corporate name. (McFarland I Decl. Ex. A.) As
2 a result, the Sacramento County website displays "CALIFORNIA
3 STATE GRANGE" as the entity that owns every one of defendant's
4 business names. (Komski Decl. Ex. 2, Feb. 1, 2016 ("Komski II
5 Decl.") (Docket No. 109-1); see McFarland II Decl. ¶¶ 4-5.) By
6 continuing to use the word "Grange" in this manner, defendant
7 continues to infringe plaintiff's registered mark and engage in
8 unfair competition against plaintiff. (See July 14, 2015 Order;
9 Allen Decl. ¶ 20 (Docket No. 126-3) ("[M]any local Grange members
10 are relying on the official records of the California Secretary
11 of State, among other governmental authorities, to ascertain the
12 'true' California State Grange.".)

13 The court's injunction in this case enjoined the
14 defendant and those acting in concert with it from using "marks
15 containing the word 'Grange.'" Defendant now argues that by
16 using the word "marks" in its order the court intended only to
17 preclude the use of *trademarks*, not *names*, containing the word
18 "Grange." (Opp'n at 6.) That certainly was not the court's
19 intention. It was never some design, symbol, or logo which
20 plaintiff sought to prevent defendant from using. Nor was it the
21 way the word "Grange" was written. It was always the use of the
22 word "Grange" in defendant's name which plaintiff sought to
23 enjoin, and that is what the court intended to do in its Order.
24 If the court erred in employing the term "marks" instead of
25 "names" in its order, it was a big mistake, but plaintiff should
26 not have to pay for that mistake by being required to wait while
27 a long appeal is processed before the court can correct it.

28 Upon more than just a cursory analysis, however,

1 defendant's interpretation of the injunction fails because, under
2 the Lanham Act, the term "mark" includes "words." See 15 U.S.C.
3 § 1127. The Lanham Act defines a "mark" as any trademark,
4 service mark, collective mark, or certification mark. Id. Each
5 of these is defined as "any word, name, symbol, or device, or any
6 combination thereof." See id. Trademarks and service marks are
7 any words or names used to identify and distinguish goods or
8 services and to indicate the source of those goods or services.
9 Id.⁴ Trademarks apply to goods; service marks apply to services.

10 Defendant's argument therefore amounts to no more than
11 a game of "gottcha" because the court's September 29, 2015
12 injunction prohibiting defendant from using marks containing

13 _____
14 ⁴ Section 1127 of the Lanham Act provides in relevant
15 part:

16 The term "trademark" includes any word, name, symbol, or
17 device, or any combination thereof--

18 (1) used by a person, or

19 (2) which a person has a bona fide intention to use
20 in commerce and applies to register on the principal
21 register established by this chapter,
22 to identify and distinguish his or her goods, including a
23 unique product, from those manufactured or sold by others
24 and to indicate the source of the goods, even if that
25 source is unknown.

26 The term "service mark" means any word, name, symbol, or
27 device, or any combination thereof--

28 (1) used by a person, or

(2) which a person has a bona fide intention to use
in commerce and applies to register on the principal
register established by this chapter,
to identify and distinguish the services of one person,
including a unique service, from the services of others
and to indicate the source of the services, even if that
source is unknown.

Id. § 1127 (emphases added).

1 "Grange" did indeed prohibit defendant from using the word
2 "Grange" or any name containing "Grange" in connection with its
3 goods or services. This includes using a corporate name
4 containing the word "Grange." It also includes using the word
5 "Grange" or a name containing "Grange" in any articles of
6 incorporation, fictitious business name registrations, lobbying
7 licenses, and public filings.

8 Numerous courts have held that the unauthorized use of
9 a registered mark in a corporate name constitutes trademark
10 infringement. See Accuride Int'l, Inc. v. Accuride Corp., 871
11 F.2d 1531, 1534-35 (9th Cir. 1989) (emphasizing that trademark
12 and corporate trade name protection are intertwined and governed
13 by the same test of infringement); Nat'l Customer Eng'g Inc. v.
14 Lockheed Martin Corp., Civ. No. 96-8938 DDP ANX, 1997 WL 363970,
15 at *6 (C.D. Cal. Feb. 14, 1997) (enjoining defendants' use of
16 "MountainGate" in their corporate name because it was
17 substantially similar to plaintiff's "Mountain" trademark);
18 accord Atlas Supply Co. v. Atlas Brake Shops, Inc., 360 F.2d 16,
19 19 (6th Cir. 1966) (enjoining use of the word "Atlas" in
20 defendant's corporate name); Safeway Stores, Inc. v. Safeway
21 Props., Inc., 307 F.2d 495, 499 (2d Cir. 1962) (defendant's use
22 of the word "Safeway" in its corporate name, "Safeway Properties,
23 Inc.," was trademark infringement); Alfred Dunhill of London,
24 Inc. v. Dunhill Shirt Co., 213 F. Supp. 179, 184 (S.D.N.Y. 1963)
25 (defendant's use of "Dunhill" in its corporate name infringed
26 plaintiff's "Dunhill" trademark); see also Hulburt Oil & Grease
27 Co. v. Hulburt Oil & Grease Co., 371 F.2d 251, 254 (7th Cir.
28 1966) ("[A] state does not pass upon the legality of a corporate

1 name by merely permitting incorporation under that name.”).

2 In addition, the Lanham Act also protects trade names.
3 A trade name is “any name used by a person [or entity] to
4 identify [its] business or vocation.” 15 U.S.C. § 1127.
5 Trademarks and service marks distinguish goods and services,
6 while trade names distinguish companies and their goodwill. Am.
7 Steel Foundries v. Robertson, 269 U.S. 372, 380 (1926). Trade
8 names commonly function as trademarks or service marks, and
9 actions brought under the Lanham Act typically challenge the use
10 of a mark as a trademark, service mark, and trade name. See
11 Accuride, 871 F.2d at 1534 (15 U.S.C. § 1114 governs trademark or
12 service mark infringement; 15 U.S.C. § 1125(a) governs trade name
13 infringement); Stork Rest. v. Sahati, 166 F.2d 348, 353 (9th Cir.
14 1948) (“A corporate name or trade name identifies a corporation;
15 it also identifies its business and the goods or services which
16 it sells or renders.” (citation omitted)).

17 Trade names are accorded the same protection as
18 trademarks and service marks because they serve the same
19 fundamental purpose: “to identify a business and its products or
20 services, to create demand for those products or services, and to
21 protect the company’s good will.” Accuride, 871 F.2d at 1536;
22 see also Sahati, 166 F.2d at 360 (“A trade name is . . . no less
23 effective than a trade-mark as a means of identification.”); W.
24 Des Moines State Bank v. Hawkeye Bancorp., 722 F.2d 411, 413 (8th
25 Cir. 1983) (“Trade names (business names) are under modern law
26 accorded the same protection as trademarks.”). All three also
27 work to “preclude one from using another’s distinctive mark or
28 name if it will cause a likelihood of confusion or deception as

1 to the origin of the goods [or services]." New W. Corp. v. NYM
2 Co. of Cal., 595 F.2d 1194, 1201 (9th Cir. 1979).

3 The Supreme Court has emphasized that the distinction
4 between trademarks, service marks, and trade names is often
5 immaterial because "the law affords protection against [their]
6 appropriation in either view, upon the same fundamental
7 principles." Robertson, 269 U.S. at 380; accord Accuride, 871
8 F.2d at 1534 ("As a practical matter, courts are rarely called
9 upon to distinguish between trade names, trademarks and service
10 marks."). "As in general trademark law, the test for
11 infringement of the names of corporate, professional[,] and
12 business organizations is likelihood of confusion [and the key
13 question is] whether the public is likely to be deceived or
14 confused by the similarity of the marks." Accuride, 871 F.2d at
15 1533 (citation omitted).

16 Accordingly, defendant's use of a corporate name
17 containing the word "Grange" is a use of a mark containing the
18 word "Grange" within the definition of the Lanham Act.
19 Defendant's use of "California State Grange" as its corporate
20 name therefore infringes plaintiff's registered mark and
21 constitutes unfair competition against plaintiff. See Sahati,
22 166 F.2d at 357 ("[T]he use of the advertising or trade name or
23 distinguishing mark of another, is in its [n]ature, fraudulent
24 and will be enjoined." (citation omitted)).

25 Pursuant to section 1116(a) of the Lanham Act,
26 defendant is ordered to remove the word "Grange" from all
27 corporate registrations and other documents filed with any
28 federal, state, or local government. These include defendant's

1 articles of incorporation and lobbying licenses on file with the
2 California Secretary of State and all fictitious business names
3 on file with Sacramento County under the corporate name
4 "California State Grange."

5 C. "California Grange Foundation"

6 California Grange Foundation (the "Foundation") is a
7 corporation that was created by defendant in 1992 and is
8 currently operated by defendant's president, Robert McFarland.
9 (See Komski Decl. ¶ 33, Ex. 22, Dec. 28, 2015 ("Komski I Decl.")
10 (Docket Nos. 99-2 to 99-43); McFarland Decl. Ex. C; Keel Decl.
11 ¶¶ 3, 6, Apr. 1, 2016 (Docket No. 132-2).) The California
12 Secretary of State lists the same corporate address for both
13 defendant and the Foundation, and both entities list McFarland as
14 their agent for service of process. Compare Business Entity
15 Detail for "CALIFORNIA GRANGE FOUNDATION," with Business Entity
16 Detail for "CALIFORNIA STATE GRANGE," <http://kepler.sos.ca.gov>
17 (last visited Apr. 14, 2016).

18 McFarland exercises control over both entities,
19 including the contents of the Foundation's website. (Komski I
20 Decl. ¶ 33; Keel Decl. ¶¶ 3, 6.) The Foundation's board of
21 directors is also composed of members who sit on defendant's
22 executive committee. (McFarland I Decl. ¶ 22; Komski I Decl. Ex.
23 24 at 1.)

24 The court thus finds that the Foundation is defendant's
25 agent, affiliate, assign, or an entity acting in concert with
26 defendant. Cf. In re Gottheiner, 703 F.2d 1136, 1140 (9th Cir.
27 1983) ("When a person owns most or all of the shares in a
28 corporation and controls the affairs of the corporation, it is

1 presumed that in any litigation involving that corporation the
2 individual has sufficient commonality of interest." (citation
3 omitted)). The Foundation is therefore bound by the court's
4 September 29, 2015 injunction prohibiting it from using the word
5 "Grange." See Fed. R. Civ. P. 65(d)(2) (providing that an
6 injunction is binding upon the parties to an action and their
7 officers, agents, servants, employees, and attorneys and those
8 who are in active concert or participation with them, provided
9 that such non-parties received actual notice of the injunction).

10 The Foundation has registered fictitious business names
11 with Sacramento County to do business as "California Guild
12 Foundation." See Fictitious Business Name Search for "CALIFORNIA
13 GRANGE FOUNDATION," Sacramento County On-Line Servs., [https://
14 actonline.saccounty.net/CitizenAccess/SACCO_FBNSearch.aspx](https://actonline.saccounty.net/CitizenAccess/SACCO_FBNSearch.aspx) (last
15 visited Apr. 14, 2016). The Sacramento County website lists
16 "California Grange Foundation" as the owner of that fictitious
17 business name, however, and the Foundation continues to retain
18 "California Grange Foundation" as its corporate name registered
19 with the California Secretary of State.

20 Accordingly, for the reasons discussed above, supra
21 Part III.B, California Grange Foundation is ordered to remove the
22 word "Grange" from all corporate registrations and other
23 documents filed with any federal, state, or local government.
24 These include articles of incorporation and lobbying licenses on
25 file with the California Secretary of State and all fictitious
26 business names on file with Sacramento County under its corporate
27 name "California Grange Foundation." The Foundation is advised
28 that non-parties may be held liable in contempt for violating the

1 court's injunction. Peterson v. Highland Music, Inc., 140 F.3d
2 1313, 1323-24 (9th Cir. 1998); see also Reebok v. McLaughlin, 49
3 F.3d 1387, 1392 (9th Cir. 1995) (the court has personal
4 jurisdiction over domestic non-parties who act in concert with a
5 party in violating an injunction).

6 D. Use of "Granger" and "CSG"

7 Plaintiff also requests the court to enjoin defendant's
8 use of the words "Granger" and "CSG." As discussed in detail in
9 the court's Order of September 29, 2015, plaintiff's Complaint
10 did not seek trademark protection for "Granger" or "CSG." (Sept.
11 29, 2015 Order at 3-4.) All of the allegations in plaintiff's
12 Complaint were limited to ten registered trademarks: "NATIONAL
13 GRANGE," "THE GRANGE FOUNDATION," "NATIONAL GRANGE OF THE ORDER
14 OF PATRONS OF HUSBANDRY," two trademarks for "P OF H GRANGE," and
15 five trademarks for "GRANGE." (Compl. ¶ 20.) Plaintiff neither
16 alleged that defendant used "Granger" or "CSG" nor requested the
17 court to enjoin defendant from using "Granger" or "CSG." Because
18 summary judgment was limited to the use of "Grange," whether
19 "Granger" or "CSG" are protected trademarks was never litigated
20 or before the court.

21 Enjoining defendant's use of "Granger" or "CSG" would
22 be improper because it would require the court to adjudicate new
23 issues that were "not decided in its original disposition of the
24 case." McClatchy, 686 F.2d at 735. Such an injunction would
25 also change the status quo and materially alter the status of the
26 case on appeal. See id.; Nat. Res. Def. Council, 242 F.3d at
27 1166. The court must therefore limit its grant of injunctive
28 relief to the relief plaintiff had requested in its Complaint and

1 the marks upon which the court granted summary judgment. See
2 Skydive Arizona, Inc. v. Quattrocchi, 673 F.3d 1105, 1116 (9th
3 Cir. 2012) (“Injunctive relief under the Lanham Act must be
4 narrowly tailored to the scope of the issues tried in the
5 case.”); Crawford v. Gould, 56 F.3d 1162, 1168 (9th Cir. 1995)
6 (holding that a court may not enter a judgment that goes beyond
7 the claims asserted in the pleadings). Accordingly, the court
8 will deny plaintiff’s request to enjoin defendant’s use of
9 “Granger” and “CSG.”

10 E. Use of “Grange” in Business Activities

11 Plaintiff requests the court to enjoin defendant and
12 its agents and affiliates from conducting any business activities
13 using the name “Grange.” Defendant acknowledges that it
14 currently uses two bank accounts opened under the name
15 “California State Grange.” (McFarland I Decl. ¶ 19.) Defendant
16 states it has removed the word “Grange” from its checks.
17 (McFarland II Decl. ¶ 21.) But there is no indication that
18 defendant has removed the word “Grange” from the actual names of
19 its bank accounts. (See Docket No. 114 at 12 (“Defendant’s bank
20 accounts remain in its corporate name.”).)

21 Defendant further contends that, at least since the
22 court’s judgment of September 29, 2015, it has not solicited any
23 membership dues using the name “Grange.” (Opp’n at 6; McFarland
24 II Decl. ¶ 22.) These statements do not appear to be true.
25 Until at least February 4, 2016, defendant issued billing
26 statements titled “Grange Dues.” (Hoag Decl. ¶¶ 1, 4 (Docket No.
27 132-1); e.g., Docket No. 99-29.) During that time, defendant
28 collected membership dues paid by checks that were addressed to

1 "California State Grange," and it endorsed those checks under the
2 name "California State Grange" and deposited them into its bank
3 accounts. (Hoag Decl. ¶ 5; McFarland I Decl. ¶ 19; Wallis Decl.
4 ¶ 8 (Docket No. 114-12).)

5 These actions amount to a blatant disregard for and
6 violation of the court's September 29, 2015 injunction. As
7 described above, supra Part III.B, the permanent injunction
8 restricted defendant from using the word "Grange" or any name
9 containing "Grange" in connection with its goods or services.
10 This included mailing billing statements titled "Grange dues,"
11 endorsing checks using any name containing the word "Grange," and
12 using bank accounts under any name containing the word "Grange."

13 Accordingly, the court will enjoin defendant and its
14 agents, affiliates, and assigns, and any party acting in concert
15 with them, from conducting any business activities using the name
16 "Grange," including, but not limited to, soliciting dues using
17 the name "Grange," collecting checks addressed to any entity that
18 contains the word "Grange" in its name, endorsing checks using
19 any name that contains the word "Grange," using bank accounts or
20 other financial accounts under any name containing the word
21 "Grange," and endorsing, signing, or executing any document,
22 lease, instruction, or financial instrument using any name
23 containing the word "Grange."

24 F. Use of "Grange" in Domain Names and Email Addresses

25 The court has previously expressed that the permanent
26 injunction prohibits defendant from using "Grange" in any domain
27 name or email address. (See Sept. 29, 2015 Order at 5.)
28 Defendant and McFarland currently list their email address on the

1 California Secretary of State website as "president@california
2 grange.org." See Lobbying Activity for "C.S.G.," [http://](http://cal-access.ss.ca.gov/Lobbying/Employers/Detail.aspx?id=1146807&session=2015)
3 [cal-access.ss.ca.gov/Lobbying/Employers/Detail.aspx?id=1146807&se](http://cal-access.ss.ca.gov/Lobbying/Employers/Detail.aspx?id=1146807&session=2015)
4 [ssion=2015](http://cal-access.ss.ca.gov/Lobbying/Employers/Detail.aspx?id=1146807&session=2015) (last visited Apr. 14, 2016); Lobbying Activity for
5 "MC FARLAND, BOB E.," <http://cal-access.ss.ca.gov/Lobbying>
6 [/Lobbyists/Detail.aspx?id=1326773&session=2015](http://cal-access.ss.ca.gov/Lobbying/Lobbyists/Detail.aspx?id=1326773&session=2015) (last visited Apr.
7 14, 2016). Accordingly, the court will grant plaintiff's request
8 to enjoin defendant and its agents and affiliates from using the
9 word "Grange" in any domain name or email address.

10 G. Reference to Past Affiliation

11 Plaintiff seeks to enjoin defendant from making certain
12 references, discussed below, pertaining to defendant's past
13 affiliation with plaintiff. After the parties disaffiliated in
14 2013, plaintiff's California-based members reorganized a state
15 chapter under the name "Grange of the State of California's Order
16 of Patrons of Husbandry, Chartered." (July 14, 2015 Order at
17 11.) The court previously found it "foreseeable that a
18 prospective or current member [of plaintiff] would be uncertain
19 as to which California Grange originates from [plaintiff's]
20 organization." (Id.)

21 Defendant conceded that the use of "Grange" by two
22 separate California organizations had caused actual confusion
23 among consumers regarding the origin of defendant's services.
24 (Id. at 11-12; see also id. at 9 (finding the record "replete
25 with evidence that a reasonably prudent Grange member,
26 prospective member, or other person contemplating doing business
27 with [plaintiff] is likely to be confused as to the origin of
28 defendant's services due to its use of 'Grange'").) In enjoining

1 defendant from using the word "Grange" or any name containing
2 "Grange," the court's September 29, 2015 injunction aimed to
3 protect consumers from being misled or confused about the source
4 of defendant's services or its association with plaintiff.

5 This is not to say that defendant can never make
6 reference to the history of its organization. But that is not
7 what defendant is doing here. Since the court's injunction,
8 defendant has referred to itself as the legal successor to the
9 former California State Grange. (Allen Decl. ¶¶ 10-11.)
10 Defendant also identifies itself publically as CSG, formerly
11 known as California State Grange; formerly trading as California
12 State Grange; and formerly doing business as California State
13 Grange. Every page on defendant's website currently contains a
14 prominent header at the top that says: "CSG Formerly the
15 California State Grange." E.g., Welcome to the CSG,
16 www.csgunited.org (last visited Apr. 14, 2016).

17 It appears that these references to defendant's past
18 affiliation with plaintiff are an attempt to do an "end-run"
19 around the court's permanent injunction prohibiting defendant
20 from using the word "Grange" in connection with its goods or
21 services. Cf. TrafficSchool.com, Inc. v. Edriver, Inc., 653 F.3d
22 820, 830 (9th Cir. 2011) (evidence of actual confusion strongly
23 supports a finding of willfulness); Earthquake Sound Corp. v.
24 Bumper Indus., 352 F.3d 1210, 1218 (9th Cir. 2003) (same).
25 Defendant's references have caused a number of plaintiff's
26 members to believe that defendant is currently plaintiff's
27 authorized representative. (Allen Decl. ¶¶ 10-11; Huber Decl.
28 ¶¶ 20, 29 (Docket No. 126-3).)

1 These references, including representations that
2 defendant is the "former California State Grange," have also
3 caused actual confusion among at least fifty of plaintiff's
4 members since September 2015 regarding the origin of defendant's
5 services and defendant's association with plaintiff. (Allen
6 Decl. ¶¶ 3, 10.) In addition, the first sentence of defendant's
7 homepage states: "The CSG (formerly California State Grange) is
8 the oldest agricultural organization in California, started in
9 1870." Id.

10 The court previously held that similar references to
11 defendant's historical affiliation with plaintiff strongly
12 suggested to consumers that defendant was presently affiliated
13 with plaintiff. (July 14, 2015 Order at 9-10 (finding that
14 "defendant recounts plaintiff's history, and not its own" and
15 that this is likely to cause plaintiff's members or prospective
16 members to believe that defendant is affiliated with
17 plaintiff).); cf. FTC v. Algoma Lumber Co., 291 U.S. 67, 81
18 (1934) ("[T]here is a kind of fraud, as courts of equity have
19 long perceived, in clinging to a benefit which is the product of
20 misrepresentation, however innocently made. That is the
21 respondents' plight today, no matter what their motives may have
22 been when they began. They must extricate themselves from it by
23 purging their business methods of a capacity to deceive.").

24 Most importantly, by identifying itself as "formerly
25 the California State Grange," defendant is effectively using a
26 name containing the word "Grange" in violation of the court's
27 permanent injunction. Precluding defendant from referencing its
28 past affiliation with plaintiff in a manner that causes consumers

1 to be misled or confused about the origin of defendant's services
2 or its association with plaintiff serves the key objective of the
3 Lanham Act. See Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.,
4 469 U.S. 189, 198 (1985). Doing so also accords with the court's
5 previous rulings and permanent injunction in this case.

6 Accordingly, the court will grant plaintiff's request and enjoin
7 defendant from referencing its past affiliation with plaintiff,
8 including representing that it is the former California State
9 Grange; successor to the California State Grange; or formerly
10 known as, trading as, or doing business as the California State
11 Grange.

12 H. Business Directory Listings

13 Plaintiff requests that the court order defendant to
14 "cancel and discontinue use of all telephone number[] listings
15 containing the name 'Grange' and delete all appearances of the
16 name 'Grange' from Defendant's business directory listings with
17 Google and those appearing at ZoomInfo and similar internet
18 websites." Defendant argues that it does not have control over
19 the contents of Google or ZoomInfo, has never requested any
20 information to be posted on those sites, and has not encouraged
21 any third-party website to refer to defendant using the word
22 "Grange." (McFarland II Decl. ¶ 12; Keel Decl. ¶ 8.)

23 Defendant's address and telephone number appear in
24 response to a Google search for "California State Grange."
25 (Konski I Decl. ¶ 10.) The Google result is a business listing
26 for "California State Grange" in the Google Maps database. See
27 "California State Grange," Google Search, [https://www.google.com](https://www.google.com/search?q=California+State+Grange)
28 [/search?q=California+State+Grange](https://www.google.com/search?q=California+State+Grange) (last visited Apr. 14, 2016).

1 Immediately under the listed information, there is a link titled
2 "Suggest an edit." That link allows users who "see something
3 wrong with a business [they] don't own or manage" to report wrong
4 business information or remove their own information from an
5 unrelated business that appears on a Google search result. Add
6 or Edit Business Information on Maps, Google.com, [https://](https://support.google.com/business/answer/6174435)
7 support.google.com/business/answer/6174435 (last visited Apr. 14,
8 2016).⁵ Users can also remove data from Google's directory for
9 legal reasons by submitting a "legal request." Report a Data
10 Problem in Google Maps, Google.com, [https://support.google.com](https://support.google.com/maps/answer/3094088)
11 [/maps/answer/3094088](https://support.google.com/maps/answer/3094088) (last visited Apr. 14, 2016).

12 Defendant's company profile on ZoomInfo.com lists its
13 name as "CSG" and its website as www.californiagrango.org. See
14 "CSG" Company Profile, [www.zoominfo.com/c/California-State-](http://www.zoominfo.com/c/California-State-Grange/353967545)
15 [Grange/353967545](http://www.zoominfo.com/c/California-State-Grange/353967545) (last visited Apr. 14, 2016). Its company
16 description states:

17 The CSG (formerly California State Grange) is the oldest
18 agricultural organization in California, started in 1870.
19 Cities and townships have grown up around our rural halls
20 and the CSG has evolved into a community service
organization with 10,000 members and 206 chapters across

21 ⁵ To the extent some of the descriptions about Google and
22 ZoomInfo's websites are not in the record, the court takes
23 judicial notice of www.Google.com and www.ZoomInfo.com and the
24 information contained therein pursuant to Federal Rule of
25 Evidence 201. See Knievel v. ESPN, 393 F.3d 1068, 1076 (9th Cir.
26 2005) (finding judicial notice of webpages appropriate because
27 "[j]ust as a reader must absorb a printed statement in the
28 context of the media in which it appears, a computer user
necessarily views web pages in the context of the links through
which the user accessed those pages"); Hendrickson v. eBay, Inc.,
165 F. Supp. 2d 1082, 1084 n.2 (C.D. Cal. 2001) (taking "judicial
notice of www.eBay.com and the information contained therein
pursuant to Federal Rule of Evidence 201").

1 California. CSG community halls are often the center of
2 their community, providing opportunities, culture and
3 education, entertainment, emergency shelter, and a
4 meeting place where new friends are made and old friends
5 are cherished. Everyone is welcome to apply for
6 membership in the CSG. Each member contributes at their
7 own pace and level of participation. Each chapter decides
8 how to best serve the community.

9 Id. The court has previously found that similar language posted
10 on defendant's website strongly suggested that defendant was
11 affiliated with plaintiff. (July 14, 2015 Order at 9-10.)

12 Like Google, ZoomInfo also allows users to notify it if
13 a company profile in their name is inaccurate or out-of-date and
14 to correct that information. See Contact Us, ZoomInfo, <http://www.zoominfo.com/business/contact> (last visited Apr. 14, 2016).
15 Users may also remove their business profile completely from the
16 directory. See FAQ, ZoomInfo, <http://subscriber.zoominfo.com/usercenter/index.php/pro-faq#removal> (last visited Apr. 14,
17 2016).

18 Defendant's assertions that it has no control over the
19 contents of its listings on Google or ZoomInfo are therefore not
20 entirely true. Defendant concedes that it has not "attempted to
21 influence[] Google or ZoomInfo search results" and has not sent
22 any communications to those websites "since the injunction was
23 entered." (McFarland I Decl. ¶ 18; Docket No. 114 at 14.).
24 Accordingly, since defendant is able to utilize easily-accessible
25 features on Google and ZoomInfo to remove or correct its public
26 business information, the court will order defendant to remove
27 the word "Grange" from all public telephone and business
28 directory listings, on the internet and otherwise, to the extent
it can do so.

1 I. Disclaimer on Defendant's Website

2 Plaintiff requests an injunction ordering defendant to
3 include a prominent disclaimer on its website that it is "not
4 affiliated with the California State Grange." Plaintiff also
5 requests that defendant include a hyperlink on its website that
6 redirects users to plaintiff's website. That is something more
7 than what the court enjoined or intended to compel in its
8 original injunction, and would go beyond merely preserving the
9 status quo. Accordingly, the court will deny plaintiff's request
10 to expand the injunction to require defendant to provide a
11 disclaimer on its website or include a hyperlink that redirects
12 users to plaintiff's website.

13 J. Attorney's Fees

14 Plaintiff requests that the court order defendant to
15 pay its reasonable attorney's fees in bringing this motion and
16 its previous motion for an order to show cause why defendant
17 should not be held in contempt for violating the court's original
18 injunction, including the declarations of Ed Komski. Defendant
19 argues that plaintiff voluntarily abandoned its claim for fees
20 when it moved to voluntarily dismiss its monetary claims on
21 September 4, 2015. (Opp'n at 9 (citing Docket No. 75).) In that
22 motion, however, plaintiff sought to dismiss its claims for
23 damages or fees without prejudice "to any claims that it may make
24 in the future." (Docket No. 75 at 1.)

25 The parties later filed a stipulated motion to dismiss
26 plaintiff's claims for damages with prejudice. (Docket No. 80.)
27 The parties stipulated "that nothing in the Order sought by this
28 [stipulated] Motion shall be understood to preclude Plaintiff for

1 making a claim for damages in the event of a future violation of
2 any permanent injunction that is ultimately issued in this case.”
3 (Id. ¶ 3; Docket No. 80-1 at 2.) The court granted the parties’
4 stipulated motion on September 29, 2015. (Sept. 29, 2015 Order
5 at 1-2, 6.)

6 As discussed in this Order, defendant violated the
7 court’s permanent injunction by continuing to use “Grange” in its
8 corporate name, business activities, email address on the
9 California Secretary of State website, and business directory
10 listings that it had the opportunity to correct or remove.
11 Plaintiff’s fee request here is thus for “a future violation of
12 any permanent injunction” as contemplated by the parties and
13 stipulated in their motion. (Docket No. 80 ¶ 3.) Accordingly,
14 plaintiff did not abandon its claim for attorney’s fees here.

15 Under 15 U.S.C. § 1117(a), the court may award
16 reasonable attorney’s fees to the prevailing party in an
17 exceptional case, “which includes cases in which the act is
18 fraudulent, deliberate, or willful.” Horphag Research Ltd. v.
19 Garcia, 475 F.3d 1029, 1039 (9th Cir. 2007).

20 1. Prevailing Party

21 “A party is a prevailing party for purposes of an
22 attorneys’ fee award if it ‘achieved a material alteration in the
23 legal relationship of the parties that is judicially
24 sanctioned.’” Fifty-Six Hope Rd. Music, Ltd. v. A.V.E.L.A.,
25 Inc., 778 F.3d 1059, 1078 (9th Cir. 2015) (citation omitted).
26 “The material alteration in the legal relationship of the parties
27 must be relief that the would-be prevailing party sought.”
28 Klamath Siskiyou Wildlands Ctr. v. U.S. Bureau of Land Mgmt., 589

1 F.3d 1027, 1030 (9th Cir. 2009). A party need not succeed on all
2 of its claims to be the prevailing party. A.V.E.L.A., 778 F.3d
3 at 1078.

4 As for the pending motion, the court has granted a
5 large part of plaintiff's requested relief. Plaintiff has thus
6 obtained a material alteration in the legal relationship of the
7 parties that is judicially sanctioned. See id. at 1078; Klamath,
8 589 F.3d at 1035. As for plaintiff's contempt motion, the court
9 denied that motion without prejudice to plaintiff bringing its
10 pending motion. (Docket Nos. 117, 125.) The pending motion is
11 based on exhibits and evidence that plaintiff had submitted with
12 its contempt motion. (Mot. at 5.)

13 Plaintiff's contempt motion also sought much of the
14 relief the court has granted here. (See Docket Nos. 109, 109-2
15 (seeking to enjoin defendant and California Grange Foundation
16 from using "Grange" in their corporate names; seeking to enjoin
17 defendant from conducting business using the name "Grange" or
18 representing its email address using the word "Grange"; and
19 requesting the court to order defendant to remove the word
20 "Grange" from its business directory listings on Google and
21 ZoomInfo).) Plaintiff has therefore obtained the relief it
22 sought in its motion for an order to show cause why defendant
23 should not be held in contempt. Because plaintiff has obtained
24 the relief it sought in both of its motions, it is the prevailing
25 party on both motions for purposes of a fee award.

26 2. Exceptional Case

27 A case is considered exceptional "when the infringement
28 is malicious, fraudulent, deliberate, or willful." A.V.E.L.A.,

1 778 F.3d at 1078 (citation omitted). “Egregious conduct is not
2 required.” Id. “Nor is bad faith.” Id. The court is hard
3 pressed to find that defendant’s acts were anything other than
4 deliberate and willful. There is significant evidence that
5 defendant was aware that its conduct infringed plaintiff’s
6 trademark rights and constituted unfair competition against
7 plaintiff.

8 In its Order of July 14, 2015, the court found
9 significant evidence of representations made by defendant on its
10 website, in its newsletters, and in public media strongly
11 suggesting it was still affiliated with plaintiff. (July 14,
12 2015 Order at 9-10; e.g., Turrill Decl. Exs. 7, 23-24 (Docket
13 Nos. 43-4 to 43-11).) Based on that evidence, the court
14 concluded that a reasonable current or prospective member of
15 plaintiff’s national organization, or any other person
16 contemplating doing business with plaintiff, would likely believe
17 defendant is affiliated with plaintiff and be confused as to the
18 origin of its services. (July 14, 2015 Order at 9-10.)

19 Defendant’s membership brochures and its current
20 website’s format, layout, and content are almost identical to
21 those it used when it was affiliated with plaintiff. (Konski I
22 Decl. ¶¶ 7-8, 28-29, Exs. 1-2, 16-17.) After its disaffiliation,
23 defendant listed the names of plaintiff’s members on its new
24 website, and it displayed links to historical publications made
25 by plaintiff’s organization in its website’s “News Archive”
26 section. (Id. ¶¶ 19, 30, Exs. 9-10, 18.)

27 Despite this court’s permanent injunction barring
28 defendant from using “Grange,” defendant uses the name “Grange”

1 in public filings and registrations with the California Secretary
2 of State and the County of Sacramento. See Stover v. Farmers'
3 Educ. & Co-op. Union of Am., 250 F.2d 809, 812-13 (8th Cir. 1958)
4 ("It is immaterial that the injunction did not include a general
5 prohibition of any use of the corporate names of the defendants.
6 It plainly and unambiguously forbade the appellant to use the
7 registered words [and his violations were thus] properly held to
8 be wilful and in contempt of court."). Defendant's use of the
9 name "Grange" is visible to the public on the Secretary of State
10 and County websites. (E.g., Komski II Decl. Ex. 2.) Defendant
11 and McFarland both represent their email addresses as
12 "president@californiagrangegrange.org" on lobbying licenses with the
13 Secretary of State that are visible to the public.

14 Until at least February 4, 2016, defendant issued
15 billing statements titled "Grange Dues" and endorsed and
16 deposited checks addressed to "California State Grange." Its
17 public business profiles on Google.com and ZoomInfo listed it as
18 "California State Grange" and its website as [www.californiagrangegrange](http://www.californiagrangegrange.org)
19 [.org](http://www.californiagrangegrange.org), even though defendant was free to correct or remove that
20 information any time it wished. Defendant's agents have
21 continued to represent that defendant is the "California State
22 Grange." In December 2015, one of plaintiff's members called
23 defendant's business number and asked if he had reached the
24 "California State Grange"; the receptionist answered, "Yes."
25 (Komski I Decl. ¶ 11.)

26 There is also evidence that defendant's conduct has
27 caused actual confusion among at least fifty of plaintiff's
28 members regarding defendant's affiliation with plaintiff and the

1 origin of its services. (E.g., Allen Decl. ¶¶ 3, 10-11.) Ample
2 evidence of actual confusion is the most important support for a
3 finding of willfulness. TrafficSchool.com, 653 F.3d at 833;
4 Earthquake Sound, 352 F.3d at 1218. The court therefore
5 concludes that defendant has willfully and deliberately continued
6 to deceive the public by infringing plaintiff's trademark and
7 engaging in unfair competition against plaintiff. See
8 TrafficSchool.com, 653 F.3d at 833 ("There was overwhelming proof
9 that defendants knew their statements confused consumers and did
10 little or nothing to remedy it. The district court could
11 reasonably infer that they willfully deceived the public.");
12 Earthquake Sound, 352 F.3d at 1219 ("The total picture in this
13 case is one of deliberate, willful infringement We thus
14 hold that this is an exceptional case within the meaning of 15
15 U.S.C. § 1117(a) such that the district court did not abuse its
16 discretion in awarding Earthquake its attorney's fees.").

17 Accordingly, the court grants plaintiff's request for
18 attorney's fees incurred in bringing this motion and its motion
19 for an order to show cause why defendant should not be held in
20 contempt. Within twenty-one (21) days from the date of this
21 Order, plaintiff shall file a declaration detailing its
22 attorney's fees for bringing these two motions. The court will
23 review the accounting and will thereafter issue an Order
24 directing defendant to pay such of it as the court approves.

25 IT IS THEREFORE ORDERED that plaintiff National Grange
26 of the Order of Patrons of Husbandry's motion for an injunction
27 (Docket No. 126) be, and the same hereby is, GRANTED IN PART as
28 follows:

1 (1) defendant California State Grange and its agents,
2 affiliates, and assigns, and any party acting in concert with
3 defendant or its agents, affiliates, and assigns, including the
4 California Grange Foundation, shall remove the word "Grange" from
5 all corporate registrations and other documents filed with any
6 federal, state, or local government, including, but not limited
7 to, articles of incorporation and lobbying licenses on file with
8 the California Secretary of State and all fictitious business
9 name registrations with the County of Sacramento;

10 (2) within five (5) days from the date of this Order,
11 defendant shall serve upon California Grange Foundation a copy of
12 this Order and shall file with the clerk a certificate reflecting
13 such service;

14 (3) defendant and its agents, affiliates, and assigns,
15 and any party acting in concert with defendant or its agents,
16 affiliates, and assigns shall remove the word "Grange" from all
17 public telephone and business directory listings, on the internet
18 or otherwise, including, but not limited to, online business
19 directory listings on www.Google.com and www.ZoomInfo.com, to the
20 extent they can do so;

21 (4) defendant and its agents, affiliates, and assigns,
22 and any party acting in concert with defendant or its agents,
23 affiliates, and assigns are permanently enjoined from:

24 (a) conducting business using the name "Grange,"
25 including, but not limited to, soliciting dues using the name
26 "Grange," collecting checks addressed to any entity whose name
27 contains the word "Grange," endorsing checks using any name
28 containing the word "Grange," using bank accounts or other

1 financial accounts under any name containing the word "Grange,"
2 and endorsing, signing, or executing any document, lease,
3 instruction, or financial instrument using any name containing
4 the word "Grange";

5 (b) using "Grange" in any domain name or email
6 address or otherwise representing their domain name or email
7 address as containing the word "Grange"; and

8 (c) referencing their past affiliation with
9 plaintiff or any other entity whose name contains the word
10 "Grange," including representing themselves to be the former
11 California State Grange; successor to the California State
12 Grange; or formerly known as, trading as, or doing business as
13 the California State Grange;

14 (5) within fifteen (15) days from the date of this
15 Order, defendant shall file with the court and serve on plaintiff
16 a report in writing under oath setting forth in detail the manner
17 and form in which defendant, its officers, agents, servants,
18 employees, representatives, partners, and all parties acting in
19 concert with defendant have complied with the terms of this
20 Order;

21 (6) within twenty-one (21) days from the date of this
22 Order, plaintiff shall file an accounting of its attorney's fees
23 associated with its motion for an injunction (Docket No. 126),
24 its motion for an order to show cause why defendant should not be
25 held in contempt (Docket No. 109), and the declarations of Ed
26 Komski dated December 28, 2015 (Docket Nos. 99-2 to 99-43) and
27 February 1, 2016 (Docket No. 109-1). Defendant may file an
28 opposition to plaintiff's fee motion within fourteen (14) days

1 from the date plaintiff's fee motion is filed. The court will
2 review the accounting and will thereafter issue an Order
3 directing defendant to pay some or all of it; and

4 (7) defendant shall pay plaintiff these attorney's fees
5 and file an affidavit with the court confirming payment within
6 five (5) business days after the court issues its Order regarding
7 the attorney's fees.

8 IT IS SO ORDERED.

9 Dated: April 20, 2016



10 **WILLIAM B. SHUBB**
11 **UNITED STATES DISTRICT JUDGE**

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