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United States District Court
For the Northern District of California

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

Maxim Integrated Products, Inc.,
Plaintiff,
v.
Richard Quintana, et al.,
Defendants.

NO. C 09-00514 JW

**ORDER GRANTING PLAINTIFF’S
MOTION FOR PRELIMINARY
INJUNCTION**

I. INTRODUCTION

Maxim Integrated Products, Inc. (“Plaintiff”) brings this action against Richard Quintana (“Quintana”) and My-iButton, LLC (“My-iButton”) (collectively, “Defendants”), alleging, *inter alia*, trademark infringement and false advertising under the Lanham Act, 15 U.S.C. §§ 1114 and 1125(a). Plaintiff alleges that Defendants deliberately advertise, market and use a product with a confusingly similar trademark to that of Plaintiff’s incontestable iButton marks.

Presently before the Court is Plaintiff’s Motion for Preliminary Injunction.¹ The Court conducted a hearing on July 6, 2009. Based on the papers submitted to date and oral argument, the Court GRANTS Plaintiff’s Motion for Preliminary Injunction.

¹ (Plaintiff Maxim Integrated Products, Inc.’s Notice of Motion and Motion for Preliminary Injunction, hereafter, “Motion,” Docket Item No. 19.)

1 **II. BACKGROUND**

2 In a Complaint filed on February 4, 2009, Plaintiff alleges as follows:

3 Plaintiff is a Delaware corporation with headquarters in Sunnyvale, California.²
4 Defendant Quintana purports to be the chief executive officer and founder of My-iButton,
5 LLC, and resides in Westminster, California.³ (Id. ¶ 5.)

6 Plaintiff is the owner and developer of the iButton product line (“iButton”), a
7 computer chip enclosed in a 16mm-thick stainless steel can that delivers and records data.
8 (Complaint ¶ 7.) Plaintiff is also the owner of four United States trademark registrations for
9 the iButton mark, all of which have achieved incontestable status. (Id. ¶ 12.)

10 Defendants’ My-iButton product is a portable MP4 promotional device that has a 2-
11 inch LCD screen on which it displays videos or pictures. (Complaint ¶ 16.) It is worn by
12 users on their bodies for advertising/display purposes. (Id.) Defendants, with at least
13 constructive knowledge of Plaintiff’s federal registration rights, adopted and used the
14 trademark “My-iButton” in California and in interstate commerce for a portable electronic
15 device. (Id. ¶ 15.) Most or all of the advertising and sales of the My-iButton product are
16 conducted on the Internet, through Defendants’ website, other Internet sites, and by and
17 through product reviews in magazines. (Id. ¶ 16.) Defendants’ first use of this mark did not
18 occur until June 19, 2007. (Id.)

19 On April 24, 2008, Plaintiff became aware of Defendants’ use of the My-iButton
20 mark. (Complaint ¶ 20.) Plaintiff subsequently learned that Defendants had applied for a
21 federal trademark registration for the mark “My-iButton.” (Id. ¶ 21.) On April 30, 2008,
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23 ² (Complaint for Federal Trademark Infringement, False Advertising and Dilution and
24 California Unfair Competition, Trademark Dilution and Declaratory Relief ¶ 3, hereafter
“Complaint,” Docket Item No. 1.)

25 ³ Although My-iButton, LLC has represented itself to be a California Limited Liability
26 Company, the company is not registered with the California Secretary of State. (Declaration of
27 Michael J. Ioannou in Support of Plaintiff Maxim Integrated Products, Inc.’s Motion for Preliminary
Injunction ¶ 3, hereafter, “Ioannou Decl.,” Docket Item No. 20.)

1 Plaintiff sent Defendants a “cease and desist” letter advising Defendants that the application
2 for trademark registration and use of the My-iButton mark infringed on Plaintiff’s
3 incontestable marks for iButton. (Id. ¶ 23.) After no response, a further cease and desist
4 letter was sent. (Id. ¶ 24.) On November 26, 2008, Plaintiff filed an Opposition with the
5 Trademark Trial and Appeal Board with regard to Defendants’ application for federal
6 registration of the My-iButton mark. (Id. ¶ 25.) Defendants continue to pursue registration
7 of the My-iButton mark with the U.S. Patent and Trademark Office (“PTO”) and continue to
8 sell and distribute the My-iButton product. (Id. ¶ 26.)

9 On the basis of the allegations outlined above, Plaintiff alleges seven causes of action: (1)
10 Federal Trademark Infringement, 15 U.S.C. § 1114; (2) Federal Unfair Competition, 15 U.S.C. §
11 1125(a); (3) Federal Trademark Dilution, 15 U.S.C. § 1125(c); (4) Unfair Competition, Cal. Bus. &
12 Prof. Code §§ 17200, *et seq.*; (5) Dilution, Cal. Bus. & Prof. Code §§ 14330, *et seq.*; (6) False
13 Advertising, Cal. Bus. & Prof. Code §§ 17500, *et seq.*; and (7) Declaratory Relief.

14 Presently before the Court is Plaintiff’s Motion for Preliminary Injunction.

15 **III. DISCUSSION**

16 Plaintiff moves for a preliminary injunction on the grounds that it owns valid, protectable
17 and incontestable trademarks, and that Defendants are marketing and using a similar trademark that
18 has already caused confusion and threatens to dilute Plaintiff’s intellectual property. (Motion at 1.)

19 To obtain injunctive relief, a plaintiff must establish (1) a likelihood of success on the merits,
20 (2) a likelihood of irreparable harm absent a preliminary injunction, (3) that the balance of equities
21 tips in favor of issuing an injunction and (4) that an injunction is in the public interest. Winter v.
22 Natural Resources Defense Council, — U.S. —, 129 S. Ct. 365, 374 (2008). Previously in
23 trademark cases, a plaintiff was entitled to a presumption of irreparable harm upon showing a
24 probable success on the merits. See GoTo.com, Inc. v. Walt Disney Co., 202 F.3d 1199, 1204-05
25 (9th Cir. 2000). However, in Winter, the Supreme Court held that “[i]ssuing a preliminary
26 injunction based only on a possibility of irreparable harm is inconsistent with our characterization of
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1 injunctive relief as an extraordinary remedy that may only be awarded upon a clear showing that the
2 plaintiff is entitled to such relief.” Winter, at 375-76. Thus, a plaintiff is no longer entitled to a
3 presumption of irreparable harm on the ground that it has shown a likelihood of success on the
4 merits. Volkswagen AG v. Verdirer Microbus and Camper, Inc., No. C 09-00231, 2009 WL 928130,
5 at *2 (N.D. Cal. Apr. 3, 2009); Cytosport, Inc. v. Vital Pharm., Inc., — F. Supp. 2d —, 2009 WL
6 1444535, at *6 (E.D. Cal. May 6, 2009).

7 The Court proceeds to consider whether a preliminary injunction is appropriate in this case
8 using the factors articulated in Winter.

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

10 The parties do not dispute the validity of Plaintiff’s trademarks.⁴ (Motion at 5.) The parties’
11 dispute turns on whether Plaintiff has sufficiently shown that Defendants’ mark creates a likelihood
12 of consumer confusion.

13 To prevail on its trademark infringement action, a plaintiff must demonstrate (1) ownership
14 of an enforceable right in a trademark and (2) that defendant’s use of the mark creates a likelihood
15 of consumer confusion. See Levi Strauss & Co. v. Blue Bell, Inc., 778 F.2d 1352, 1354 (9th Cir.
16 1985) (*en banc*). “The core element of trademark infringement is the likelihood of confusion, i.e.,
17 whether the similarity of the marks is likely to confuse customers about the source of the products.”
18 Abercrombie & Fitch Co. v. Moose Creek, Inc., 486 F.3d 629, 633 (9th Cir. 2007). In determining
19 whether or not there is a likelihood of confusion, a court is to weigh the following factors: (1) the
20 strength of the mark; (2) proximity of the goods; (3) similarity of the marks; (4) evidence of actual
21 confusion; (5) marketing channels used; (6) type of goods and the degree of care likely to be
22 exercised by the purchaser; (7) defendant’s intent in selecting the mark; and (8) likelihood of
23 expansion of the product lines. See AMF Inc. v. Sleekcraft Boats, 599 F.2d 341, 348-49 (9th Cir.
24 1979).

26 ⁴ Plaintiff owns the following Trademarks on the PTO’s Principal Register: Trademark
27 Registration Nos. 2388023, 2388024, 2482685, 2478289. (Ioannou Decl., Ex. Q.)

1 The similarity of the marks, proximity of the goods and marketing channels used, constitute
2 “the controlling troika in the Sleekcraft analysis.” GoTo.com, 202 F.3d at 1205. These three factors
3 are the most important. See Brookfield Commc’ns, Inc. v. West Coast Entm’t Corp., 174 F.3d 1036,
4 1055 n.16 (9th Cir. 1999).

5 **1. Similarity of the Marks**

6 Plaintiff contends that this factor weighs in its favor because the marks are similar in sight,
7 sound and meaning. (Motion at 13.)

8 The greater the similarity between the two marks at issue, the greater the likelihood of
9 confusion. Entrepreneur Media, Inc. v. Smith, 279 F.3d 1135, 1144 (9th Cir. 2002). The Ninth
10 Circuit has developed three principles that should be considered when assessing similarity: (1)
11 marks should be considered in their entirety and as they appear in the marketplace; (2) similarity is
12 best adjudged by appearance, sound and meaning; and (3) similarities weigh more heavily than
13 differences. Id.

14 Here, with respect to appearance and sound, “My-iButton” incorporates “iButton” in its
15 entirety. The trademarks utilize the same spelling. My-iButton appears, almost invariably, with a
16 lower case “i” and an uppercase “B” in the spelling of “iButton.”⁵ Thus, the only visual distinctions
17 between the two marks as they are used in the commerce is that Plaintiff’s “iButton” contains an
18 underlined “i” and the term “My-“ precedes Defendants’ “iButton.” However, Defendants’
19 trademark application does contain some versions of its mark that are more distinguishable from
20 Plaintiff’s—“MYIBUTTON” and “My-ibutton.” (Complaint, Ex. C.)

21 The Court finds that the two marks, as they appear in commerce are strikingly similar. See
22 Perfumebay.com, Inc. v. EBAY, Inc., 506 F.3d 1165, 1174 (9th Cir. 2007) (holding that “eBay” and
23 PerfumeBay” are similar). To the extent that there are differences, these are outweighed by the
24 similarities between the marks as they are actually used. In addition, Plaintiff provides the transcript
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26 ⁵ (See, e.g., Ioannou Decl., Exs. A, C-L; Declaration of Hal Kurkowski in Support of
27 Plaintiff Maxim Integrated Products, Inc.’s Motion for Preliminary Injunction, hereafter “Kurkowski
28 Decl.,” Ex. A at 5, Docket Item No. 25.)

1 of a video entitled “Richard Quintana - CEO & Inventor of My-iButton,” in which Defendant
2 Quintana refers to his product as “the i-button.” (Ioannou Decl., Ex. B.) In that context, the marks
3 are indistinguishable. Thus, the Court finds that the similarity of the marks weighs strongly in favor
4 of Plaintiff.

5 **2. Relatedness of the Goods**

6 Plaintiff contends that this factor weighs in favor of Plaintiff since the products provided by
7 the parties are very similar types of products. (Motion at 17.)

8 Related goods are generally more likely than unrelated goods to confuse the public as to the
9 producers of the goods. Brookfield, 174 F.3d at 1055-56 “[T]he relatedness of each company’s
10 prime directive [is not] relevant.” Dreamwerks Prod. Group, Inc. v. SKG Studio, 142 F.3d 1127,
11 1131 (9th Cir. 1998). Instead, a court must focus on consumers and ask whether they are likely to
12 associate two products. Id. Companies that offer products and services relating to the same general
13 field can be sufficiently related for purposes of granting a preliminary injunction. See Brookfield,
14 174 F.3d at 1056; American Intern. Group, Inc. v. American Intern. Bank, 926 F.2d 829, 832 (9th
15 Cir. 1991).

16 Here, there are some differences in the product markets for the iButton and My-iButton. The
17 iButton has a broader range of functionality than the My-iButton, and their marketed uses do not
18 appear to overlap. (Kurkowski Decl. ¶ 3; Ioannou Decl., Exs. A-C.) However, both parties sell
19 goods in the general field of small portable electronics. For example, online product reviews of
20 Defendants’ My-iButton contain advertisements, linked to websites, for related products. (Ioannou
21 Decl. Ex. C at 1.) For at least one product review, the first linked advertisement is for Plaintiff’s
22 iButton. (Id.) Based on this evidence, the Court finds that the relatedness of the products in the
23 field of small portable electronics weighs in favor of Plaintiff.

24 **3. Marketing Channels Used**

25 Plaintiff contends that the use of a common marketing channels weighs in favor of Plaintiff
26 since both parties advertise and sell their products primarily through the Internet. (Motion at 18.)
27

1 The use of “convergent marketing channels” increases the likelihood of consumer confusion.
2 Sleekcraft, 599 F.2d at 353. “[T]he [internet], as a marketing channel, is particularly susceptible to a
3 likelihood of confusion since . . . it allows for competing marks to be encountered at the same time,
4 on the same screen.” GoTo.com, 202 F.3d at 1207.

5 In this case, Plaintiff’s evidence shows that Plaintiff and Defendants use the Internet as a
6 significant marketing channel for their products. Defendants promote the My-iButton product
7 online. (Ioannou Decl., Ex. B; Kurkowski Decl. ¶¶ 11-12, Ex. A.) Thus, this factor weighs in favor
8 of Plaintiff.

9 **4. Strength of the Mark**

10 Plaintiff contends that this factor weighs in Plaintiff’s favor because the iButton mark is both
11 conceptually arbitrary and commercially strong.⁶ (Complaint at 18-19.)

12 The stronger a mark, the greater protection it is accorded by trademark laws. Brookfield, 174
13 F.3d at 1058. The strength of the trademark is evaluated in terms of its conceptual strength and
14 commercial strength. GoTo.com, 202 F.3d at 1207. More specifically, “[t]he strength of a mark is
15 determined by its placement on a continuum of marks from generic, afforded no protection; through
16 descriptive or suggestive, given moderate protection; to arbitrary or fanciful awarded maximum
17 protection.” E. & J. Gallo Winery v. Gallo Cattle, 967 F.2d 1280, 1291 (9th Cir. 1992). If a mark
18 requires a consumer to use more than a small amount of imagination to form an association between
19 the mark and the product, then the mark is suggestive and not descriptive. Rodeo Collection, Ltd. v.
20 West Seventh, 812 F.2d 1215, 1218 (9th Cir. 1987). However, an otherwise inherently weak mark
21 “may be strengthened by such factors as extensive advertising, length of exclusive use, [and] public
22 recognition.” Entrepreneur, 279 F.3d at 1144 (internal citations and quotation marks omitted).

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26 ⁶ The Court notes that “in situations in which the appearance of the conflicting marks and
27 the services provided are almost identical, ‘the strength of the mark is of diminished importance in
28 the likelihood of confusion analysis.’” GoTo.com, 202 F.3d at 1208 (citing Brookfield, 174 F.3d at 1059).

1 Here, the iButton marks have been in use for nearly ten years. (Ioannou Decl, Ex. Q.)
2 Further, the marks only marginally describe the products in that they are small and resemble a
3 button-like shape. (See Kurkowski Decl., Ex. A.) However, the marks do not describe the
4 functionality of the products, and the addition of the term “i-“ preceding “Button” requires an
5 ordinary consumer to use some imagination in connecting the marks with the products. Thus, the
6 Court finds Plaintiff’s marks are conceptually strong.

7 In addition, the commercial strength of Plaintiff’s marks bolsters their overall strength.
8 Plaintiff has spent more than two million dollars advertising the iButton products. (Kurkowski Decl.
9 ¶ 8.) Plaintiff has also had exclusive use of the iButton marks for nearly ten years. (Ioannou Decl.,
10 Ex. Q.) There are more than 175 million iButton products currently in circulation. (Kurkowski
11 Decl. ¶ 7.) Thus, the Court finds the strength of the iButton marks weighs in favor Plaintiff.

12 **5. Defendants’ Intent in Selecting a Mark**

13 Plaintiff contends that Defendants intentionally chose the name “My-iButton” to benefit from
14 Plaintiff’s goodwill and experience in the industry. (Motion at 19-20.)

15 A defendant’s intent is only relevant to the extent that it weighs upon the likelihood that
16 consumers will be confused by the defendant’s mark and that it informs a court’s view of the
17 equities. Brookfield, 174 F.3d at 1059. To prove wrongful intent, evidence must show or allow for
18 an inference that a defendant’s mark was adopted to deliberately benefit from another’s good will,
19 good name, and good trade. Fleischmann Distilling Corp. v. Maier Brewing Co., 314 F.2d 149, 158
20 (9th Cir. 1963). Where a defendant knowingly adopts a mark similar to another’s, the court may
21 presume an intent to deceive consumers. Official Airline Guides, Inc. v. Goss, 6 F.3d 1385, 1394
22 (9th Cir. 1993).

23 Here, Defendants describe the My-iButton as a light-weight audio/video media device.
24 (Ioannou Decl., Exs. A-C.) However, Defendants applied for an International Class 26, “fancy
25 good,” trademark instead of an International Class 9, portable computer electronic device,
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1 trademark.⁷ (Request for Judicial Notice, Ex. B, Docket Item No. 27; Ioannou Decl., Ex. P.)
2 Defendants’ decision to classify their product under Class 26 suggests that they intentionally
3 avoided applying for a trademark that would be compared to Plaintiff’s products. However,
4 Defendants submit the declaration of Defendant Quintana, in which he explains that he “sought
5 advice of counsel regarding the availability of [their] proposed MY-iBUTTON mark. [His] then-
6 counsel conducted a trademark search and advised [him] that [they] could properly proceed with
7 registration. . . .”⁸ Based on this evidence, the Court finds that it cannot determine Defendants’
8 intent at this time. Thus, this factor is neutral with respect to whether Plaintiff has shown a
9 likelihood of success on the merits.

10 **6. Likelihood of Expansion in Other Markets**

11 Plaintiff contends that Defendants’ trademark is likely to expand into other markets,
12 increasing the likeliness of confusion. (Motion at 20.)

13 To determine the likeliness of expansion into other markets, “[t]he question is whether the
14 parties are likely to compete with a similar product in the same market.” Official Airline Guides,
15 Inc., 6 F.3d at 1394. “A strong likelihood that either party may expand his business to compete with
16 the other favors a finding of [likely] infringement.” Id.; Survivor Media, Inc. v. Survivor
17 Productions, 406 F.3d 625, 633 (9th Cir. 2005). However, where two companies already compete
18 in the same product line to a significant degree, the expansion factor becomes relatively
19 unimportant. Brookfield, 174 F.3d at 1060; GoTo.com, 202 F.3d at 1209.

20 As discussed above, for the purposes of determining likelihood of confusion, Plaintiff’s
21 iButton and Defendants’ My-iButton are related products. In addition, Plaintiff represents that it

23 ⁷ An International Class 9 trademark covers “data processing equipment and computers.”
24 U.S. Patent and Trademark Office, Trademark Manual of Examining Procedure § 1401.02(a) (5th
25 ed. 2007). An International Class 26 trademark covers “lace and embroidery, ribbons and braid;
buttons, hooks and eyes, pins and needles; [and] artificial flowers.” Id.

26 ⁸ (Declaration of Richard Quintana in Support of Defendants’ Memorandum of Points and
27 Authorities in Opposition to Plaintiff Maxim Integrated Products, Inc.’s Motion for Preliminary
Injunction ¶ 5, hereafter, “Quintana Decl.,” Docket Item No. 32.)

1 plans to continue to expand the applications of its iButtons. (Kurkowski Decl. ¶ 15.) Plaintiff also
2 submits evidence that it is expanding its sales internationally, and that Defendants have advertised
3 that there are many languages available for their product. (Kurkowski Decl. ¶¶ 10-13; Ioannou
4 Decl., Ex. M.) Thus, the Court finds that the likelihood of expansion of the parties' products tips in
5 Plaintiff's favor.

6 **7. Degree of Care Likely to be Exercised by Purchasers**

7 Plaintiff contends that consumers do not exercise a significant care for Plaintiff's type of
8 good. (Motion at 20-21.)

9 Courts look to what the reasonably prudent purchaser, using ordinary caution, would do to
10 distinguish between the two product lines. Surfvivor, 406 F.3d at 634. When goods are more
11 expensive, the court assumes purchasers will exercise greater care. E. & J. Gallo Winery, 967 F.2d
12 at 1293; Official Airline Guides, 6 F.3d at 1393. For example, consumers exercise very little care
13 with respect to inexpensive items, such as sun screen. Surfvivor, 406 F.3d at 634. However, there is
14 no clear standard for moderately priced goods, such as non-designer clothing. Id.

15 Here, the parties' products both cost close to \$50. (See Kurkowski Decl. ¶ 6.) In addition,
16 the only other evidence addressing this factor shows that reviewers of computer-related products
17 have exhibited a low-level of care by referencing Defendants' product as an "iButton." (Ioannou
18 Decl., Exs. B, N.) Based on this evidence, the Court finds that an ordinary consumer is likely to
19 exercise a low degree of care in distinguishing iButton and My-iButton products. Thus, the Court
20 finds that this factor weighs in favor of Plaintiff.

21 **8. Evidence of Actual Confusion**

22 Plaintiff contends that actual confusion of consumers is likely, and may be inferred from the
23 confusion exhibited by online reviews and advertisements. (Motion at 21.)

24 Evidence of past actual confusion is persuasive proof that future confusion is likely in a
25 trademark infringement lawsuit. GoTo.com, 202 F.3d at 1208; Official Airline Guides, 6 F.3d at
26 1394. Courts often rely on three types of evidence: (1) evidence of actual instances of confusion; (2)

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1 survey evidence; and (3) inferences arising from judicial comparison of the conflicting marks and
2 the context of their use in the marketplace.” Cytosport, 2009 WL 1444535 at *14. Since actual
3 confusion is difficult to prove, it is not necessary to do a survey before obtaining a preliminary
4 injunction. Sleekcraft, 599 F.2d at 353.

5 Here, as discussed above, the actual instances of confusion, are not actual consumers, but
6 product reviewers. Although Plaintiff has submitted evidence that internet advertisements for
7 Plaintiff’s products have been shown along with a product review of Defendants’ product, there is
8 no evidence in the record of actual consumer confusion. Thus, the Court finds the lack of evidence
9 of actual confusion weighs in favor of Defendants.

10 In sum, the Court finds that each of the Sleekcraft factors, except Defendants’ intent in
11 selecting the mark and the evidence of actual confusion, weigh in favor of Plaintiff’s contention that
12 there is a likelihood of confusion. Accordingly, since the parties do not dispute Plaintiff’s
13 ownership of valid and protectable trademarks, the Court finds that Plaintiff has established a
14 likelihood of success on the merits.

15 **B. Likelihood of Irreparable Harm**

16 Plaintiff contends that irreparable harm has already occurred, and that further irreparable
17 harm is imminent absent an injunction.⁹ Defendants contend that they have ceased selling the My-
18 iButton product and disabled their website, making irreparable harm unlikely. (Opposition at 5-6.)

19 A plaintiff seeking a preliminary injunction must demonstrate more than a likelihood of
20 success on the merits of its claims. Winter, 129 S. Ct. at 375-76. A plaintiff must also demonstrate
21 a likelihood that absent the injunction, it will be irreparably harmed by defendant’s alleged
22 infringing conduct. Id.; Volkswagen AG, 2009 WL 928130 at *6. In trademark cases, irreparable
23 harm is typically found in a plaintiff’s loss of control over their business reputation, loss of trade and
24 loss of goodwill. Opticians Ass’n of Am. v. Indep. Opticians of Am., 920 F.2d 187, 195 (3d Cir.

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26 ⁹ (Plaintiff Maxim Integrated Products, Inc.’s Reply in Support of its Motion for Preliminary
27 Injunction at 5, Docket Item No. 36.)

1 1990). Irreparable injury exists where a court reasonably concludes that continuing infringement
2 will result in loss of control over the plaintiff's reputation and good will. Apple Computer, Inc. v.
3 Formula Int'l Inc., 725 F.2d 521, 526 (9th Cir. 1984); see also Volkswagen AG, 2009 WL 928130 at
4 *21.

5 Here, Plaintiff has submitted evidence showing that Defendants' My-iButton has been
6 consistently referred to as the "iButton," including in a negative product review of the My-iButton
7 and in an internet interview with Defendant Quintana. (Ioannou Decl., Exs. B, N ¶ 15.) In response,
8 Defendants represent that they have ceased selling the My-iButton and have taken down their
9 website.¹⁰ However, Defendants do not indicate whether they have ceased manufacturing or using
10 My-iButton products.¹¹ In light of Plaintiff's evidence showing that it has already lost some control
11 over its business reputation and goodwill, and Defendants' lack of evidence with regard to whether
12 their manufacture and use of My-iButton products will continue in the future, the Court finds that
13 Plaintiff has adequately shown that irreparable harm is likely absent a preliminary injunction.

14 **C. Balance of the Equities**

15 A plaintiff seeking a preliminary injunction must establish that the balance of equities tips in
16 his favor. Winter, 129 S. Ct. at 374. A court balancing the equities will look to the possible harm
17 that could befall the various parties. See Cytosport, 2009 WL 1444535 at *22.

18 As discussed above, denying a preliminary injunction is likely to result in irreparable harm to
19 Plaintiff's business reputation and good will. In contrast, Defendants are likely to suffer only minor
20 harm since, as they concede, they have not sold the My-iButton product since September 2008, and
21 they no longer offer their My-iButton product for sale. (Quintana Decl. ¶ 4.) Additionally, Plaintiff
22 represented at oral argument that it is willing to post a bond to protect Defendants' interest pending
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25 ¹⁰ (Opposition at 6; Morales Decl. ¶ 2.)

26 ¹¹ Defendants represent that they will cease any allegedly infringing conduct identified by
27 Plaintiff pending the resolution of this action. (Opposition at 5.)

1 the outcome of this litigation. Accordingly, the Court finds that the balance of equities favors the
2 issuance of a preliminary injunction.

3 **D. Public Policy**

4 Finally, a court must consider whether an injunction is in the public interest. See Winter,
5 129 S. Ct. at 374. In the trademark context, courts often define the public interest as the right of the
6 public not to be deceived or confused. Moroccanoil, Inc. v. Moroccan Gold, LLC., 590 F. Supp. 2d
7 1271, 1282 (C.D. Cal. 2008) (quoting Opticians Ass'n, 920 F.2d at 198). In light of the Court's
8 finding of a likelihood of confusion between the marks, the Court finds that the public interest
9 weighs in favor of granting an injunction.

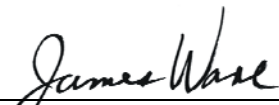
10 Accordingly, the Court GRANTS Plaintiff's Motion for Preliminary Injunction.

11 **IV. CONCLUSION**

12 The Court GRANTS Plaintiff's Motion for Preliminary Injunction. A separate Order will be
13 issued with the language of the preliminary injunction. Plaintiff shall post a \$40,000 bond within
14 ten (10) days from the date of this Order.

15 The parties shall appear for a Case Management Conference on **August 31, 2009 at 10 a.m.**
16 On or before **August 21, 2009**, the parties shall file a Joint Case Management Statement. The
17 Statement shall include, among other things, a proposed expedited schedule for proceeding with the
18 remainder of this case, a good faith discovery plan with a proposed date for the close of all
19 discovery, and an update on any settlement efforts.

20
21 Dated: July 16, 2009



JAMES WARE
United States District Judge

1 **THIS IS TO CERTIFY THAT COPIES OF THIS ORDER HAVE BEEN DELIVERED TO:**

2 David P. Morales moraleslaw@sbcglobal.net
3 Lita Monique Verrier lverrier@rmkb.com
4 Michael J. Ioannou mioannou@rmkb.com

5 **Dated: July 16, 2009**

Richard W. Wieking, Clerk

6
7 **By: /s/ JW Chambers**
8 **Elizabeth Garcia**
9 **Courtroom Deputy**

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