

**IN THE UNITED STATES COURT OF APPEALS
FOR THE FOURTEENTH CIRCUIT**

No. 08-999

JASON MALONE d/b/a MALONE BAR AND GRILL,

Plaintiff-Appellee

v.

QUENTIN MALONE, d/b/a QUENTIN'S PUB

Defendant-Appellant.

Appeal from the District Court
for the District of Euphoria

BRIEF OF APPELLEE

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ISSUES PRESENTED FOR REVIEW

Did the District Court err in determining that Appellant's use of QUENTIN MALONE'S in connection with Quentin's Pub in Springfield infringed upon Appellee's MALONE mark?

1. Is Appellee's MALONE mark protectable as a mark that acquired secondary meaning?
2. Is there a likelihood of confusion between Appellant's use of QUENTIN MALONE's and Appellee's use of MALONE?

STATEMENT OF THE CASE

On March 14, 2008, Plaintiff-Appellee Jason Malone brought this action against Quentin Malone in the District of Euphoria under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), for infringement of a trademark, service mark or trade name, and sought a permanent injunction against Quentin's infringing use of the QUENTIN MALONE'S mark. R2-7. Jason also stated claims of unfair competition and trademark dilution. *Id.* On March 17, 2008, Jason filed a motion for a preliminary injunction. R8-10.

The District Court of the District Euphoria (Hoyle, D.J.) consolidated the hearing on the motion for a preliminary injunction with a trial, both of which were conducted on July 1, 2008. R15-52. The court determined that Jason's MALONE mark had acquired a secondary meaning through its close association with Jason's restaurant and thus was protectable. The court also analyzed the *Polaroid* factors

and concluded that Quentin's use of his own mark created a likelihood of confusion. In particular, the court relied on the similarity of the marks, the striking similarity of the two restaurants, and a scientifically-based survey demonstrating actual confusion among the public. Consequently, the court issued an injunction prohibiting Quentin from using the names "Malone," "Malone's," or "Quentin Malone's" in conjunction with any bar or restaurant within an 80-mile radius of Jason's restaurant. R53-55.

This appeal followed, R56, and is confined to the issues whether the MALONE mark is protectable and whether Quentin's use of QUENTIN MALONE'S created a likelihood of confusion. R57-58.

STATEMENT OF FACTS

Jason Malone is a renowned film actor who, for over ten years, has starred in blockbuster movies, including *Death Blow*; *Cry, Cry Again*; *Chunnel*; and *Sack Lunch*. R17. In November 2006, Jason parlayed his celebrity status into a successful business in his hometown of Springfield, Euphoria, opening the Malone Bar and Grill. R17-18. The restaurant celebrates Jason's Hollywood career, featuring pictures of Jason and other movie stars, memorabilia from several of Jason's films, and a prominent display of a signed photograph of Jason. R18-19. At the Malone Bar and Grill, patrons can enjoy a variety of drinks, appetizers, and entrees in a Hollywood ambience. R19.

Since the opening of the Malone Bar and Grill, Jason has extensively advertised the restaurant and successfully drawn on his celebrity status to link the Malone Bar and Grill with his storied career. For instance, Jason has frequently advertised in the *Springfield Times* with an ad that prominently features the interior of the restaurant and one of Jason's Hollywood friends, the actor Aaron Echolls. Superimposed on the ad is the name "Malone Bar and Grill." R20. The public has recognized Jason as the proprietor of the restaurant that bears his name and celebrates his movies, as evidenced by popular reviews linking Jason to the Malone Bar and Grill. R20, 22.

A little more than a year after Jason opened the Malone Bar and Grill in Springfield, Jason's brother, Quentin, opened a strikingly similar establishment in Springfield. Quentin was already the owner of a bar in Durham, North Carolina, an establishment that did not compete with the Malone Bar and Grill in any way. They were in different states and, by all appearances, different geographic and advertising markets. See R38, 42. When Quentin decided to open his establishment in Springfield, he knew that his brother was both a famous movie star and the proprietor of a Springfield restaurant with a Hollywood theme. R44. The evidence established that Quentin, who has been estranged from his brother Jason for more than ten years, R23, largely replicated Jason's restaurant and exploited the close association that Jason had cultivated between his Hollywood career and the Malone Bar and Grill. Quentin prominently featured a slogan—

“Quentin Malone’s, the bar where everyone is famous”—in his establishment as well as in print and radio ads that evoke the celebrity-studded nature of Jason’s restaurant. R44. Quentin’s bar has an acting theme, just like Jason’s. *See* R41-42. Quentin advertised in the same publication, the *Springfield Times*. R42, 44. And both restaurants featured similar drinks and appetizers, including artichoke dip and chicken fingers. *See* R20, 24.

Quentin’s actions created substantial confusion among the restaurant-going public in Springfield, where Jason had labored to make the Malone Bar and Grill synonymous with Jason’s name and Hollywood career. Dr. Trott, a marketing expert at Acadia University who has broad experience in designing and conducting such surveys, conducted an authoritative survey that revealed actual consumer confusion about the two establishments. R34.

SUMMARY OF ARGUMENT

The evidence amply supports the district court’s finding of trademark infringement and its imposition of an injunction against Quentin’s use of certain variations on the MALONE mark. A plaintiff in a Lanham Act suit must prove, first, that the plaintiff’s mark is protectable and, second, that the defendant’s use of his or her own mark is likely to cause confusion with the plaintiff’s. *See Star Indus., Inc. v. Bacardi & Co. Ltd.*, 412 F.3d 373, 381 (2d Cir. 2005). To establish a mark’s protectability, a plaintiff can demonstrate either that the mark is inherently distinctive or has become distinctive by acquiring a secondary meaning.

See id. If a mark is protectable, a court must then decide whether there is a likelihood of confusion between the plaintiff's and defendant's marks. *See id.* at 383-84.

In this case, the District Court properly concluded that Jason's MALONE mark, as used in conjunction with his Springfield restaurant, the Malone Bar and Grill, has acquired a secondary meaning. Although Malone is a personal name, it has acquired a secondary meaning through Jason's successful efforts to make his name and celebrity status synonymous with his restaurant. Jason has advertised the restaurant and, through his relationships with other Hollywood stars, has actively promoted the close connection between his name, his movies, and the restaurant. Residents of Springfield have in fact come to identify MALONE with the themed restaurant that celebrates Jason's movie career.

Quentin's use of the QUENTIN MALONE'S mark creates a likelihood of confusion with the MALONE mark that Jason has cultivated. Assessing the likelihood of confusion requires courts to weigh multiple factors, including the strength of the mark, whether the businesses actually compete, the similarity of the advertising channels, actual confusion, and bad faith. Most of the factors tip heavily in Jason's favor because of the similarity of the marks, the striking similarity of the two acting-themed restaurants, the fact that both establishments advertise in the *Springfield Times*, and actual consumer confusion, as demonstrated

by an authoritative and expert marketing survey. The other factors are neutral, and none favors Quentin.

In light of the protectability of the MALONE mark and the high likelihood of confusion, the District Court properly crafted a narrow injunction prohibiting Quentin from using certain variations on MALONE in conjunction with a restaurant in the Springfield area. This Court should affirm.

ARGUMENT

I. THE MALONE MARK HAS ACQUIRED SECONDARY MEANING IN THE RELEVANT MARKET AND THUS IS PROTECTABLE

The first step in stating a claim for trademark infringement is establishing the protectability of a mark. A mark can be distinctive either because of its inherent uniqueness or because it has “acquired a ‘secondary meaning’ in the minds of consumers.” *Star Indus.*, 412 F.3d at 381. In this case, as the District Court correctly found, the MALONE mark acquired strong secondary meaning because consumers in Springfield came to view the mark as synonymous with the restaurant that celebrates Jason Malone’s movies.

A finding of secondary meaning is a question of fact and, as such, is reviewed for clear error. *See Conagra, Inc. v. Singleton*, 743 F.2d 1508, 1513 (11th Cir. 1984). The District Court’s determination that the MALONE mark had acquired secondary meaning is supported by the facts in the record and thus is not clearly erroneous.

Personal names can acquire secondary meaning “when the name and the business become synonymous in the public mind.” *Flynn v. AK Peters, Ltd.*, 377 F.3d 13, 20 (1st Cir. 2004). This happens when the public associates the name with a specific source. See *Paul Frank Indus., Inc. v. Sunich*, 502 F. Supp. 2d 1094, 1098 (C.D. Cal. 2007). While courts are often reluctant to prevent someone from using his or her own name, *John Allan Co. v. Craig Allen Co. L.L.C.*, 540 F.3d 1133, 1140 (10th Cir. 2008), the paramount concern is avoiding public confusion, *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1288 (9th Cir. 1992). Thus, an injunction may be appropriate even when the defendant unintentionally confuses the public. See *Gallo*, 967 F.2d at 1288; *Paul Frank Indus.*, 502 F. Supp. 2d at 1098.

Courts consider a number of factors in assessing whether a mark has acquired secondary meaning that renders the mark distinctive and thus protectable. These factors include: “(1) the length and manner of its use; (2) the nature and extent of advertising and promotion; (3) the efforts made by the plaintiff to promote a conscious connection in the public’s mind between the name and the plaintiff’s product or business; and (4) the extent to which the public actually identifies the name with the plaintiff’s product or venture.” *Conagra*, 743 F.2d at 1513. Furthermore, registering a mark is unnecessary; it becomes protectable based on its use and the meaning that it attains in the public mind. See *Gilbert/Robinson, Inc. v. Carrie Beverage-Missouri, Inc.*, 758 F. Supp. 512, 522

(E.D. Mo. 1991), *aff'd*, 989 F.2d 985 (8th Cir. 1993). “There is sufficient secondary meaning as long as a significant quantity of the consuming public understand[s] a name as referring exclusively to the appropriate party.” *Flynn*, 377 F.3d at 19 (internal quotation marks omitted).

While simply asserting that one has become well-known in a particular field is not sufficient to establish that a name has acquired secondary meaning, *see Flynn*, 377 F.3d at 21-22, it is an entirely different matter when someone has actively promoted a mark and its association with a business. For instance, in *Conagra*, Henry Singleton assiduously promoted the link between the Singleton name and his seafood business. He prominently displayed the name on all of his products and advertised the business on a continuous basis. The Singleton name achieved the notoriety and association with quality seafood that its proprietor sought. *See Conagra*, 743 F.2d at 1513.

The District Court correctly applied those settled principles. The court’s findings are fully supported by record facts and thus are not clearly erroneous. *See* R54. With respect to the use of the mark and the extent of advertising, Jason’s undisputed testimony reflects that he has advertised the Malone Bar and Grill continuously since opening the restaurant. R20, 22. Furthermore, Jason always included the MALONE mark in his advertising. Regarding the third factor—promoting a connection between the name and the business—Jason has brought in other Hollywood celebrities to cement in the public’s mind the notion that Jason,

his career, and his restaurant are inextricably linked. R22. Sound circumstantial evidence indicates that the public in fact associates Jason and his Hollywood career with the Malone Bar and Grill. An unsolicited review of the restaurant, highlighting the connection between Jason and the restaurant, shows that Jason has successfully promoted that linkage. R48. Furthermore, the financial success of the Malone Bar and Grill indicates that the public has received the message and embraced Jason's business venture. R22. Persuasive evidence therefore supports the District Court's conclusion that the MALONE mark has acquired secondary meaning.

II. THERE IS A LIKELIHOOD OF CONFUSION BETWEEN THE MALONE AND QUENTIN MALONE'S MARKS

The second step in establishing trademark infringement is demonstrating a likelihood of confusion between the plaintiff's and defendant's uses of their respective marks. Based on the many factors that courts have articulated, Jason has established such a likelihood of confusion, thus warranting the narrowly tailored injunction granted by the District Court.

A. Standard of Review

Determining whether there is a likelihood of confusion requires analysis of numerous factors, which are usually fact-intensive. Therefore, a "district court's resolution of each separate factor is treated as a finding of fact which [an appeals court] review[s] for clear error, while [a district court's] balancing of the factors is treated as a matter of law subject to de novo review." *Star Indus.*, 412 F.3d at 384.

The District Court identified three of the most significant factors—the similarity of the litigants’ marks, the similarity (i.e., competitive proximity) of the two businesses, and the existence of actual confusion—all of which weighed in Jason’s favor. R55. Each of those findings is fully supported by the facts in the record and thus is not clearly erroneous. As discussed below, the District Court properly found that *all* of the other factors also favored Jason, R55, such that a balancing of the relevant factors necessarily means that confusion is likely.

B. All Relevant Likelihood-of-Confusion Factors Weigh in Jason’s Favor

Whether the use of two marks creates a likelihood of confusion is an intensely factual question, and various courts have developed multi-factor tests to determine whether such a likelihood exists. The seminal case on this issue is *Polaroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492, 495 (2d Cir. 1961), which identified eight factors: (1) the strength of the plaintiff’s mark; (2) the similarity of the two marks; (3) the proximity of the products; (4) the likelihood of bridging the gap between the products; (5) actual confusion; (6) whether the defendant used his or her own mark in good faith; (7) the quality of the defendant’s product; and (8) buyer sophistication. *See also Caesar’s World, Inc. v. Caesar’s Palace*, 490 F. Supp. 818, 823-24 (D.N.J. 1980) (identifying similar list of factors and requiring courts to inquire whether the goods are marketed through the same channels).

Certain factors weigh heavily in Jason's favor, including the similarity of the marks, the competitive proximity of the two businesses, actual confusion, bad faith by Quentin, and the use of the same marketing channels. And as for the products' quality, Quentin's brief in this Court—with its disparagement of Quentin's establishment as a "beer-and-nachos" "joint," Appellant Br. 13-14—functionally concedes that Jason's product is superior to Quentin's.

1. *The MALONE Mark is Strong.* The MALONE mark is strong because it has acquired a distinct secondary meaning, as discussed above.

2. *The Marks Are Similar.* Determining whether two marks are similar requires courts to assess "the overall impression created by the logos and the context in which they are found." *Star Indus.*, 412 F.3d at 386. The two marks need not be identical, and "similarities weigh more heavily than the differences." *Gilbert/Robinson*, 758 F. Supp. at 523.

Here, Jason uses the MALONE mark in the name of his restaurant, the Malone Bar and Grill. As noted above, Jason has gone to great lengths to create an association between his mark and his Hollywood-themed restaurant that celebrates his career in the movies. Quentin's Pub in Springfield has an interior that also features an acting theme, and, most importantly, Quentin prominently displays his slogan—"Quentin Malone's, the bar where everyone is famous." R44.

Admittedly, Quentin's slogan features his first name, rather than Jason's, but that is not enough to avoid the conclusion that the marks are strikingly similar. In

Gilbert/Robinson, a proprietor opened a restaurant and bar named MIKE HOULIHAN'S, and the court had no trouble concluding that this mark was very similar to HOULIHAN'S, the mark of the famous chain restaurant. In particular, the court noted that "the use of a modifying word is not sufficient to dispel the likelihood of confusion." *Gilbert/Robinson*, 758 F. Supp. at 523.

Furthermore, Quentin's slogan is clearly evocative of Jason's Hollywood-themed restaurant, with its overt references to popularity and celebrity. The overall impression of Quentin's slogan thus creates a likelihood of confusion because of the strong similarity of the marks and the context in which they are clearly visible. The District Court found correctly that the two marks were "highly similar." R55. Such a finding is not clearly erroneous and weighs strongly in Jason's favor.

3. *The Businesses Are in Competitive Proximity.* Although two products need not compete directly for a likelihood of confusion to arise, the extent of competition is still an important factor. *See Gilbert/Robinson*, 758 F. Supp. at 524. Simply because one product might be cheaper than another does not mean that the two do not compete. *See Star Indus.*, 412 F.3d at 386-87. Quentin's self-disparaging references to his "beer-and-nachos" bar thus amplify the harm of infringement of Jason's mark; they do not quell the likelihood of confusion to consumers.

Quentin argues strenuously that the Malone Bar and Grill is more expensive than Quentin's Pub in Springfield, *see* Appellant Br. 4-5, such that the two restaurants do not compete. That argument "misses the point of an affiliation confusion claim," *Star Indus.*, 412 F.3d at 384, which is predicated on the idea that consumers might "infer a relationship" between two distinct products, *id.*

Here, both restaurants serve drinks and appetizers, which are similar, even down to the artichoke dip and chicken fingers. Both feature an acting theme. And, critically, both are located in Springfield, Euphoria. Quentin's insistence that the two restaurants appeal to different clienteles is belied by the fact that some appetizers in his own restaurant can cost as much as \$20. R43. In other words, the two restaurants clearly compete.

The similarities between the Malone Bar and Grill and Quentin's Pub in Springfield are far more obvious than the similarities between the products at issue in *Star Industries*. One was a cheap vodka that cost half as much as Bacardi rum. Despite the fact that the beverages were different types of alcohol, and that one was twice the price of the other, the court concluded that both products were in competitive proximity. *Id.* at 387.

The District Court in this case concluded that "the parties' businesses . . . are quite similar, *if not identical*." R55 (emphasis added). Because the record fully supports that conclusion, the court's finding is not clearly erroneous.

4. *There Was No Gap to Bridge*. Because the two restaurants actually competed, there was no “gap to bridge” between the two product markets. *See Star Indus.*, 412 F.3d at 387.

5. *There Was Actual Consumer Confusion*. Evidence of actual consumer confusion “can be very persuasive on the question of whether a likelihood of confusion exists.” *Caesar’s World*, 490 F. Supp. at 827. Furthermore, properly designed and administered surveys are the most important way to demonstrate such confusion, and courts often accord great weight to such surveys. *See Gilbert/Robinson*, 758 F. Supp. at 524. A proper survey must be fair and scientific, conducted by qualified experts and impartial interviewers, based on the relevant cross-section of the public, and include questions that are neither misleading nor biased. *See id.*

Jason presented such a survey by Dr. Maura Trott, a respected academic and an expert who has conducted numerous marketing surveys. Dr. Trott carefully designed a survey to test whether the restaurant-going public in Springfield was actually confused by Quentin’s use of the QUENTIN MALONE’S mark in his slogan. R30-31. The survey featured several non-leading questions. First, it asked whether the respondent had frequented a bar or restaurant in Springfield in the previous year. If the respondent answered in the affirmative, the interviewer showed the respondent a picture of the outside of Quentin’s pub and asked whether he or she believed that Quentin’s Pub was affiliated with any other establishment

and, if yes, which one. Finally, the interviewer recorded the respondent's contact information for verification purposes. R32-33, 49. Dr. Trott concluded that there was a 9% incidence of consumer confusion and that, in her extensive experience, that constituted actual consumer confusion. R34.

The survey fulfilled all indicia of a proper marketing survey. An expert designed the study, and it was administered by Dr. Trott's students, whom she deemed to be impartial and unbiased. R31. The survey is particularly noteworthy for its lack of bias. Although Quentin argues that the survey is flawed because it did not show the interior of Quentin's Pub, which features the infringing logo, *see* Appellant Br. 8, such methodology indicates that the survey was not leading. By showing only the outside of the pub, the survey tested whether consumers had actually visited the restaurant and were familiar with the logo and theme inside.

Most importantly, because the survey was properly designed and administered, it is critical evidence of scientifically-significant actual confusion. *See James Burrough Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 279 (7th Cir. 1976) (finding 15% confusion to be significant). Even if Quentin's criticisms of the study had any merit, the case law makes clear that Quentin's failure to present his own contrary scientific survey weighs heavily in Jason's favor. *See Star Indus.*, 412 F.3d at 388. The evidence thus unambiguously favors Jason and the District Court's finding is not clearly erroneous.

6. *Quentin Acted in Bad Faith.* Quentin acted in bad faith when he adopted the QUENTIN MALONE'S mark in Springfield, knowing that Jason was already using the MALONE mark. Under the *Tea Rose-Rectanus* doctrine, bad faith can be presumed when a defendant knows of the plaintiff's use of a mark in the relevant market. *See C.P. Interests, Inc. v. California Pools, Inc.*, 238 F.3d 690, 700 (5th Cir. 2001). Although some courts have not adopted that presumption, knowledge of someone else's prior use of a mark is still indicative of bad faith. *See id.*

Quentin asserts that he is the senior user because he has used the QUENTIN MALONE'S mark in his Durham pub since 2004, *see* Appellant Br. 18-19, but that argument impermissibly conflates two different markets. The *Tea Rose-Rectanus* doctrine is market-specific. *See National Ass'n for Healthcare Commc'ns, Inc. v. Central Ark. Area Agency on Aging, Inc.*, 257 F.3d 732, 735 (8th Cir. 2001). Because Durham and Springfield are separate markets in different states, Quentin's use of a mark in Durham is irrelevant to this analysis.

In fact, Jason is the senior user of the MALONE mark in Springfield. Quentin knew about the Malone Bar and Grill when he opened Quentin's Pub in Springfield, and he knew about the Hollywood theme of Jason's restaurant. R44. Quentin must have known that his slogan—"Quentin Malone's, the bar where everyone is famous"—would likely sow confusion among the Springfield restaurant-going public. The evidence, therefore, supports a finding that Quentin

was a junior user of the QUENTIN MALONE'S mark in Springfield and acted in bad faith.

7. *Jason and Quentin Used the Same Marketing Channels.* Courts have also noted that “[c]onvergent marketing channels increase the likelihood of confusion.” *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 353 (9th Cir. 1979). This factor relates to the competitive proximity of the products at issue, *see id.*, and focuses on whether the same segment of the public is reached through product advertising.

Here, both Jason and Quentin advertised their respective restaurants in the *Springfield Times*. Jason's ad featured the MALONE mark, and Quentin's ad featured the QUENTIN MALONE'S mark. R20, 44. This factor increases the likelihood that the public would confuse the two marks in Springfield, the relevant market.

C. The District Court Properly Issued a Narrowly Tailored Injunction

Jason has established that his MALONE mark is protectable and that there is a likelihood of confusion because all relevant factors weigh in Jason's favor. The District Court permanently enjoined Quentin from using “Malone,” “Malone's,” or “Quentin Malone's” in association with a bar or restaurant within an 80-mile radius of the Malone Bar and Grill in Springfield. R55.

Consistent with Federal Rule of Civil Procedure 65 and the Lanham Act, 15 U.S.C. § 1125(a)(1)(A), a federal court may enjoin an infringing use of another's trademark that is likely to cause confusion among the public. *See Healthcare*

Comme 'ns, 257 F.3d at 737. A decision to grant an injunction is reviewed for abuse of discretion. *See id.*

The District Court's authority to grant an injunction is clear under the circumstances, and the injunction's scope is properly limited. First, an injunction against the use of a particular mark must be confined to the relevant market. *See id.* at 737-38. Here, Springfield is the relevant market. The 80-mile radius to which the injunction applies is consistent with evidence that Jason's advertising reached a 100-mile radius around his restaurant. R20. Second, an injunction may extend only to the products that are the subject of confusion. *See Gallo*, 967 F.2d at 1288-89. Here, the injunction prohibits Quentin's use of certain marks only in conjunction with a bar or restaurant and thus is consistent with the case law.

CONCLUSION

This Court should affirm the District Court's findings that the MALONE mark had acquired secondary meaning and that Quentin's use of QUENTIN MALONE'S created a likelihood of confusion. This Court should also rule that the District Court did not abuse its discretion in issuing a permanent injunction against Quentin's use of certain variations on MALONE in the Springfield area.

Respectfully submitted,

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CERTIFICATE OF LENGTH

In accordance with Rule 6, I certify that the foregoing brief, exclusive of the caption, table of contents, table of citations, and the certificate of service, complies with Rule 4, is in 14-point type, and contains 4,199 words, according to the word-counting feature on Microsoft Word.

David C. Frederick

CERTIFICATE OF SERVICE

I, David Frederick, counsel for the appellee, certify that on January 24, 2009,
I filed and served the original and four copies of the Brief for Appellee by
depositing same in the United States Mail, first class postage prepaid, addressed to:

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