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UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

JACK CANFIELD, an individual; )  
MARK VICTOR HANSEN, an )  
individual; HANSEN & HANSEN )  
LLC, a California limited )  
liability company; CHICKEN SOUP )  
FOR THE SOUL ENTERPRISES, INC., )  
a California Corporation )  
Plaintiffs, )  
v. )  
HEALTH COMMUNICATIONS, INC., a )  
Florida Corporation; and DOES )  
1-10, inclusive, )  
Defendants.

Case No: CV 08-890 SVW (JTLx)  
ORDER GRANTING-IN-PART  
PLAINTIFFS' MOTION FOR  
PRELIMINARY INJUNCTION [5]

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1 **I. INTRODUCTION**

2 Plaintiffs Jack Canfield ("Canfield"), Mark Victor Hansen  
3 ("Hansen"), Hansen & Hansen, and Chicken Soup for the Soul  
4 Enterprises., Inc. (collectively "Plaintiffs") bring this motion for  
5 preliminary injunction against Defendants Health Communications, Inc.  
6 ("HCI"), and Does 1-10 ("Defendant") to enjoin the use of Plaintiffs'  
7 trademark in "Chicken Soup for the Soul" on the cover of Defendants'  
8 future publications. For the reasons set forth below, the Court  
9 GRANTS-IN-PART and DENIES-IN-PART Plaintiffs' motion.

10  
11 **II. FACTUAL BACKGROUND**

12 Plaintiffs Canfield and Hansen were co-authors of the first  
13 "Chicken Soup for the Soul" book in the early 1990s, a popular book of  
14 inspirational short stories that has branched out into a series of  
15 successful similarly-titled books. (Mot., 4; P. Hansen Decl., ¶ 3.)  
16 In 1997, the two obtained trademark registration on the phrase and  
17 letting of "Chicken Soup for the Soul." (Mot., at 4; P. Hansen Decl.,  
18 ¶ 7.) Since that time, Plaintiffs have obtained trademarks in many  
19 other similar titles, such as "Chicken Soup for the Woman's Soul."  
20 (P. Hansen Decl., Ex. 2.)<sup>1</sup> In 1998, Plaintiffs Canfield and Hansen  
21 licensed the exploitation of the trademarks to Chicken Soup for the  
22 Soul Enterprises ("CSSE"). (Id., at ¶ 9.) Defendant HCI is a  
23 Florida-based company that served as the exclusive publisher of  
24 Chicken Soup for the Soul books beginning in 1993. Since that time,

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27 <sup>1</sup> Since this time it appears that in 2004 Plaintiff Mark Victor  
28 Hansen has assigned all of his interest relating to "Chicken Soup  
for the Soul" to Hansen & Hansen. (P. Hansen Decl., ¶ 8.)

1 the series has been a successful seller for HCI, comprising of 170  
2 unique titles with more than 112 million copies sold. (Opp., at 5.)

3 The current publishing agreement between the parties was signed  
4 on July 1, 2000 and expires on July 1, 2008. (P. Hansen Decl., Ex.  
5 15.) The agreement stipulates that until its expiration, HCI is the  
6 exclusive publisher of the Chicken Soup for the Soul series of books,  
7 and after that deadline HCI may distribute and print books from the  
8 Chicken Soup for the Soul backlist, but does not have the right to  
9 publish any new Chicken Soup for the Soul titles. (Id.) Plaintiffs  
10 have determined that they will not renew their publishing agreement  
11 with HCI. (Mot., at 5.) The agreement contains a provision, which  
12 reads:

13 HCI acknowledges that H-C [Plaintiffs Hansen and Canfield] owns  
14 the trademark (defined as all CSSE registered trademarks,  
15 including the design of the words "Chicken Soup for the Soul" and  
16 the "little man holding the heart").

17 (P. Hansen Decl., Ex. 15, at § 12.) The dispute in this action  
18 centers on the publication of books for which Defendant has created  
19 mock-up covers, but has not yet published. These books include two  
20 new compilations of inspirational political stories, entitled  
21 "Democrat's Soul," and "Republican's Soul." (Vesgo Decl., ¶ 6.) In  
22 addition, HCI will release a series of books entitled the "Ultimate  
23 Series" - including "The Ultimate Horse Lover," "The Ultimate Dog  
24 Lover," and "The Ultimate Cat Lover." (Id.) HCI has created a  
25 website in order to garner submissions for these books that also  
26 contain mock covers. (Peluso Decl., ¶ 4.) It is these mock covers  
27 that are at the center of the instant dispute.

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1 The iterations of the mock-ups of these future publications have  
2 changed since preliminary stages of this litigation. Initially, a  
3 number of the mock-ups contained prominent displays of the trademarked  
4 phrase "Chicken Soup for the Soul," in the trademarked cursive  
5 lettering, surrounded only by much smaller font stating that the book  
6 was presented by the publisher of the Chicken Soup series. (See Moore  
7 Decl., Ex. 6.) Since the time suit was filed, however, Defendant has  
8 removed any reference to "Chicken Soup for the Soul" from the mock  
9 covers of its "Ultimate Series" publications. (Peluso Decl., Ex G.)  
10 Additionally, the mock-up covers of "Democrat's Soul" and  
11 "Republican's Soul" now contain one consistent font in stating that it  
12 was the publisher of the Chicken Soup for the Soul series. (Id.)  
13 Plaintiffs contest the current use of the Chicken Soup for the Soul  
14 trademark by Defendant in unlicensed books for which HCI seek  
15 submissions.

### 17 **III. ANALYSIS**

#### 19 **A. Standard of Review**

20 Plaintiffs seek a preliminary injunction prohibiting Defendant  
21 from printing the new HCI books with their currently proposed mock-  
22 ups. Under Ninth Circuit law, "[a] plaintiff is entitled to a  
23 preliminary injunction in a trademark case when it demonstrates  
24 "either (1) a combination of 'probable success on the merits' and 'the  
25 possibility of irreparable injury' or (2) the existence of 'serious  
26 questions going to the merits' and 'that the balance of hardships tips  
27 sharply in his favor.'" GoTo.com, Inc. v. Walt Disney Co., 202 F.3d  
28 1199, 1205 (9th Cir.2000) (quoting Sardi's Restaurant Corp. v. Sardie,

1 755 F.2d 719, 723 (9th Cir.1985)); see also Abercrombie & Fitch Co. v.  
2 Moose Creek, Inc., 486 F.3d 629, 633 (9th Cir. 2007); Nautilus Group,  
3 Inc. v. ICON Health and Fitness, Inc., 372 F.3d 1330, 1334 (Fed. Cir.  
4 2004). "Irreparable injury is ordinarily presumed upon a showing of a  
5 likelihood of success." Abercrombie, 486 F.3d at 633; see also  
6 GoTo.com, Inc. v. Walt Disney Co., 202 F.3d 1199, 1209 (9th Cir.  
7 2000). Defendant relies on the Supreme Court's decision in eBay Inc.  
8 v. MercExchange, L.L.C., 547 U.S. 388 (2006), to argue that the Court  
9 should apply the traditional equitable principles in granting  
10 injunctive relief. (Def. Opp., at 21-22.) However, that decision  
11 discussed infringement under only in the patent and copyright context.  
12 Id. at 392-93. The Ninth Circuit's rulings on injunction relief in  
13 the trademark infringement context were undisturbed and have been  
14 reaffirmed subsequent to eBay. Abercrombie, 486 F.3d at 633. As  
15 such, the central inquiry for the Court in determining the  
16 appropriateness of a preliminary injunction is whether Plaintiffs'  
17 claim of trademark infringement against Defendant is likely to  
18 succeed. If the claim is likely to succeed then irreparable injury may  
19 be presumed. Defendant has no offered evidence to rebut the  
20 presumption that Defendant's alleged infringement, if proven, would  
21 injuriously dilute Plaintiffs' mark.

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1 **B. Use of the Trademark**

2 Neither party contests that there is use of the Chicken Soup for  
3 the Soul trademark, and that use of that mark for future publications  
4 will end when the licensing agreement terminates. Instead, the  
5 parties dispute the use of the mark in relation to the mock-ups that  
6 will be published in the coming year, after the expiration of the  
7 licensing agreement. (Opp., at 9.)  
8

9 **C. Fair Use**

10 Defendant HCI asserts that its use of Plaintiffs' "Chicken Soup  
11 for the Soul" trademark falls under the protections of the fair use  
12 defense to trademark infringement. Under Ninth Circuit analysis,  
13 there are two distinct forms of the fair use defense - the "classic"  
14 or statutory fair use, and the "nominative" fair use. Brother  
15 Records, Inc. v. Jardine, 318 F.3d 900, 903 (9th Cir. 2003). See also  
16 New Kids on the Block v. News America Publ., Inc., 971 F.2d 302, 308-  
17 309 (9th Cir. 1992). Defendant claims that under either test, its use  
18 of Plaintiffs' mark constitutes fair use and therefore does not  
19 violate the Lanham Act. For the reasons outlined below, the Court  
20 finds that classic or statutory fair use protection is not applicable  
21 to Defendant's use of the mark, and that certain elements of its use  
22 do not fall under the protections of nominative fair use.  
23

24 1. Statutory Fair Use

25 Defendant HCI contends that it does not use "Chicken Soup for the  
26 Soul" as a trademark, but rather uses it merely to describe the series  
27 of books it once published. (Opp., at 9.) In essence, Defendant  
28 argues that since its reference to the book series is simply a fact

1 that it previously published the Chicken Soup for the Soul series it  
2 is not using the term as its mark, but rather as a factual statement.  
3 (Opp., at 10-11.)

4 Statutory fair use is codified at 15 U.S.C. § 1115(b)(4), which  
5 provides: "the use of the name, term or device charged to be an  
6 infringement is a use, otherwise than as a mark . . . of a term or  
7 device which is descriptive of and used fairly and in good faith only  
8 to describe the goods or services of such party, or their geographic  
9 origin." The Ninth Circuit distinguishes statutory fair use from  
10 nominative fair use based on the nature of the reference to the mark.

11 In Brother Records, the Ninth Circuit stated:

12 The nominative fair use analysis is appropriate where a defendant  
13 has used the plaintiff's mark to describe the plaintiff's  
14 product, even if the defendant's ultimate goal is to describe his  
15 own product. Conversely, the classic fair use analysis is  
16 appropriate where a defendant has used the plaintiff's mark only  
17 to describe his own product, and not at all to describe the  
18 plaintiff's product.

19 318 F.3d at 903-904 (quoting Cairns v. Franklin Mint Co., 292 F.3d  
20 1139, 1152 (9th Cir. 2002)). When discussing its own precedent, the  
21 Ninth Circuit stated that "the nominative fair use defense, as opposed  
22 to the classic fair use defense, clearly [applies] because the  
23 defendant used the plaintiff's mark undeniably to refer to the  
24 plaintiff's product, even though the defendant's ultimate goal was to  
25 describe his own product." Id. at 904. The Ninth Circuit further  
26 elaborated this distinction by stating that protection under Section  
27 1115(b)(4) applies only when the underlying mark "is used in its  
28 primary descriptive sense rather than its secondary trademark sense."

1 Id. at 905 (citing Cairns, 292 F.3d at 1150-51 ("Under the common law  
2 classic fair use defense . . . '[a] junior user is always entitled to  
3 use a descriptive term in good faith in its primary, descriptive sense  
4 other than as a trademark.'" (quoting 2 J. Thomas McCarthy, McCarthy  
5 on Trademark and Unfair Competition § 11:45 (4th ed. 2001))). In  
6 Brother Records, the Ninth Circuit navigated through its prior and  
7 noted that it has "consistently . . . applied the classic fair use  
8 analysis to infringement cases involving descriptive marks used in  
9 their primary, descriptive sense." 318 F.3d at 906.

10 Defendant's own citations bear out such a distinction. In  
11 Brothers Records, the Ninth Circuit was confronted with an assertion  
12 by Al Jardine, a former member of The Beach Boys, that he was  
13 protected by statutory fair use when naming his new rock group, which  
14 went under such names as "Al Jardine of the Beach Boys and Family &  
15 Friends; The Beach Boys 'Family and Friends'; Beach Boys Family &  
16 Friends; The Beach Boys, Family & Friends; Beach Boys and Family; as  
17 well as, simply, The Beach Boys." Brothers Records, 318 F.3d at 902.  
18 After discussing the distinction between statutory and nominative fair  
19 use, the court found that Jardine's use of the Beach Boys mark did not  
20 qualify for protection under statutory fair use. Id. at 907.

21 Specifically, the court stated that:

22 Jardine does not use "The Beach Boys" trademark to denote its  
23 primary, descriptive meaning of "boys who frequent a stretch of  
24 sand beside the sea." Instead, Jardine uses "The Beach Boys"  
25 trademark in its secondary, trademark sense, which denotes the  
26 music band-and its members-that popularized California surfing  
27 culture. This is true regardless of whether Jardine's use of the  
28 mark refers to Jardine himself or to the band. Because Jardine



1 does not use the mark in its primary, descriptive sense, the  
2 classic fair use defense does not apply.

3 Id. The court additionally cites to its decisions in New Kids, 971  
4 F.2d 302; Cairns, 292 F.3d 1139; and Playboy Enters., Inc. v. Welles,  
5 279 F.3d 776 (9th Cir. 2002) as examples of uses that did not fall  
6 under statutory fair use. In New Kids, the court noted that the  
7 "defendant newspapers in New Kids did not use the trademark 'New Kids  
8 on the Block' to denote its primary, descriptive meaning of 'children  
9 who recently moved to this area bounded by streets on four sides.'" Brother Records, 318 F.3d at 907, n. 3 (quoting New Kids, 971 F.3d at  
10 308.) Instead, the use was a reference to the popular music group  
11 from the early 1990s. Similarly, in Playboy, a case involving former  
12 Playboy Playmate of the Year's use of the Playboy trademark on her  
13 website, the Ninth Circuit did not find statutory fair use applicable  
14 because the defendant Playmate was not using the mark to denote "a  
15 companion in games and recreation to a man of means who is given to  
16 pleasure-seeking." Playboy, 279 F.3d at 802.<sup>2</sup> Accordingly, the Ninth  
17 Circuit has found statutory fair use applicable in situations where  
18 the reference to the trademarked slogan or language is made in a  
19 descriptive sense. See, e.g., In re Dual-Deck Video Cassette Recorder  
20 Antitrust Litig., 11 F.3d 1460, 1467 (9th Cir. 1993) (defendant's use  
21 of plaintiff trademark "VCR-2" qualifies as statutory fair use where  
22 defendant's mark is used as a description of a second terminal in  
23 plaintiff's video cassette recorder); Entrepreneur Media, Inc. v.

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<sup>2</sup> Defendant cites to Playboy to support its proposition that statutory fair use applies in the instant litigation. The Ninth Circuit in Playboy, however, determined fair use on the basis of nominative fair use, not statutory fair use. The Ninth Circuit's example of the descriptive meaning of "Playboy Playmate" illustrates the distinction that Brothers Records sets forth.

1 Smith, 279 F.3d 1135 (9th Cir. 2002) (finding statutory fair use and  
2 concluding that plaintiff's trademark in the word "entrepreneur"  
3 applied to printed publications pertaining to business opportunities  
4 but could not have exclusive mark in the descriptive term  
5 "entrepreneur"). Such an interpretation is in line with the  
6 overarching policy goal of balancing the protection of property rights  
7 with the cost in removing the use of words from our language. See New  
8 Kids, 971 F.2d at 306. See also Restatement (Third) of Unfair  
9 Competition § 28 cmt. a ("Trademark rights ... extend only to the  
10 source significance that has been acquired by such terms, not to their  
11 original descriptive meanings.").

12 In the instant action, statutory fair use does not apply to the  
13 Defendant's incorporation of Plaintiffs' mark. Defendant asserts that  
14 it is attempting simply to state a fact - that it did publish the  
15 relevant Chicken Soup for the Soul series - and it is not using the  
16 Plaintiffs' trademark as a mark. That Defendant was the publisher of  
17 the Chicken Soup series does not change the use of the mark on the  
18 relevant covers. The reference to Chicken Soup for the Soul is a  
19 reference to the Plaintiffs' mark, independent of the Defendant's  
20 publication of that series. Such a reference is not descriptive of  
21 the actual language used - i.e., Defendant is not alluding to a warm  
22 concoction of chicken and broth soothing to one's spiritual self, nor  
23 figuratively to a group of heart-warming stories - instead, Defendant  
24 is referring specifically to Plaintiffs' mark and the series of books  
25 it published. Such use is not analogous to the descriptive meaning  
26 applied by the Ninth Circuit in Dual Deck and Entrepreneur Media.  
27 Rather, the meaning is directly related to the mark, just as in  
28

1 Brother Records or Playboy. Accordingly, the Court finds that  
2 statutory fair use does not apply in this action.<sup>3</sup>

3  
4 2. Nominative Fair Use

5 As set forth in the analysis, the Ninth Circuit distinguishes  
6 between statutory fair use and nominative fair use. Nominative fair  
7 use is appropriate "where a defendant has used the plaintiff's mark to  
8 describe the plaintiff's product, even if the defendant's ultimate  
9 goal is to describe his own product." Brother Records, 918 F.3d at  
10 903-904. The Ninth Circuit first presented this form of defense in  
11 New Kids, where it found that a defendant may claim nominative fair  
12 use where three requirements are met: "First, the product or service  
13 in question must be one not readily identifiable without use of the  
14 trademark; second, only so much of the mark or marks may be used as is  
15 reasonably necessary to identify the product or service; and third,  
16 the user must do nothing that would, in conjunction with the mark,  
17 suggest sponsorship or endorsement by the trademark holder." 971 F.2d  
18 at 308. In adopting this test, the Ninth Circuit noted that "it is  
19 often virtually impossible to refer to a particular product for  
20 purposes of comparison, criticism, point of reference or any other  
21 such purpose without using the mark." Id. at 306. When asserted as a  
22 nominative fair use defense, the above three-part test replaces the  
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24  
25 <sup>3</sup> This finding is also relevant to the three-step analysis that  
26 Defendant's propose the Court undertake. In this instance, our  
27 finding applies two step one of the three elements - that  
28 defendant's use of the term is not as a trademark or service  
mark. See Cairns, 292 F.3d at 1151. In this instance, as  
described above, Defendant is using the term as reference to  
Plaintiff's mark.

1 likelihood of confusion analysis under Sleekcraft.<sup>4</sup> See Cairns, 292  
2 F.3d at 1151. See also Playboy, 279 F.3d at 801.<sup>5</sup> The Court will  
3 analyze Defendant's nominative fair use claim under each of the  
4 relevant factors.

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9 <sup>4</sup> Defendant argues that the existence of consumer confusion is  
10 not relevant to the fair use analysis in light of the Supreme  
11 Court's holding in KP Permanent Make-Up, Inc. v. Lasting  
12 Impression I, Inc., 543 U.S. 111 (2004). In KP Permanent, the  
13 Supreme Court, when analyzing classic or statutory fair use,  
14 found that consumer confusion was not necessary for a finding of  
15 statutory fair use. 543 U.S. at 118. This analysis, however,  
16 was predicated on the statutory interaction between 15 U.S.C. §  
17 1114 - setting forth the elements of trademark infringement and  
18 requiring a showing of consumer confusion - and 15 U.S.C. §  
19 1115(b)(4) - defining statutory fair use and not including  
20 consumer confusion. See id. This holding, as stated, relied on  
21 the statutory framework and does not apply to nominative fair  
22 use. Indeed, the case demonstrates another example of the  
23 distinction between statutory fair use and nominative fair use.  
24 In KP Permanent, the Plaintiff both parties used the term "micro  
25 color" in describing their respective products and the defendant  
26 asserted fair use based on the terms *descriptive* nature. The  
27 courts accordingly engaged in a statutory fair use analysis.

19 <sup>5</sup> Specifically, the Ninth Circuit stated as the rationale for  
such a rule:

20 The three-factor test better evaluates the likelihood of  
21 confusion in nominative use cases. When a defendant uses a  
22 trademark nominally, the trademark will be identical to the  
23 plaintiff's mark, at least in terms of the words in  
24 question. Thus, application of the Sleekcraft test, which  
25 focuses on the similarity of the mark used by the plaintiff  
26 and the defendant, would lead to the incorrect conclusion  
27 that virtually all nominative uses are confusing. The three-  
factor test-with its requirements that the defendant use  
marks only when no descriptive substitute exists, use no  
more of the mark than necessary, and do nothing to suggest  
sponsorship or endorsement by the mark holder-better  
addresses concerns regarding the likelihood of confusion in  
nominative use cases.

28 Playboy, 279 F.3d at 801.

1           a. Identifiability

2           In the Ninth Circuit, the first requirement for nominative fair  
3 use is that the "product or service in question must be one not  
4 readily identifiable without use of the trademark . . . ." New Kids,  
5 971 F.2d at 308. There appears to be some confusion in the Ninth  
6 Circuit regarding the meaning of "readily identifiable" - whether the  
7 phrase refers to the identifiability of the plaintiff trademark  
8 holder, or the ability of the defendant to identify itself. The Ninth  
9 Circuit's opinion in Playboy was ambiguous in its discussion of this  
10 element when it stated:

11           "[T]here is no other way that Ms. Welles can identify or describe  
12 herself and her services without venturing into absurd  
13 descriptive phrases. To describe herself as the "nude model  
14 selected by Mr. Hefner's magazine as its number-one prototypical  
15 woman for the year 1981" would be impractical as well as  
16 ineffectual in identifying Terri Welles to the public."

17           We agree. Just as the newspapers in New Kids could only identify  
18 the band clearly by using its trademarked name, so can Welles  
19 only identify herself clearly by using PEI's trademarked title.  
20 Playboy, 279 F.3d at 802 (quoting PEI v. Welles, 78 F. Supp. 2d 1066,  
21 1079 (S.D. Cal. 1999)). In this language, the Ninth Circuit appears  
22 to support the theory that this factor is about the ability to  
23 identify oneself through use of the mark - such as Ms. Welles's  
24 ability to describe her position - and the ability to identify the  
25 product, service, or object protected by trademark - the newspapers  
26 using the phrase "New Kids on the Block" to describe the popular music  
27 group from the early 1990s. The language of Playboy, indicates,  
28 whatever the corollary propositions may suggest, that the concern is

1 the ability to identify the mark without use of the mark. Hence, in  
2 Playboy, the Ninth Circuit analyzed whether Ms. Welles could identify  
3 the mark without use of the actual mark. Such an interpretation of  
4 this factor is in line with the examples that the Ninth Circuit often  
5 presents. In New Kids, the court discussed how "sometimes there is no  
6 descriptive substitute, and a problem closely related to genericity  
7 and descriptiveness is presented when many goods and services are  
8 effectively identifiable only by their trademarks." 971 F.2d at 306.  
9 The court used the example of the Chicago Bulls professional  
10 basketball team, which could be stated as "'the professional  
11 basketball team from Chicago,' but it's far simpler (and more likely  
12 to be understood) to refer to the Chicago Bulls.'" Id. A similar  
13 example is the use of the Volkswagen mark to describe the cars  
14 repaired by an automobile repair shop. See Volkswagenwerk  
15 Aktiengesellschaft v. Church, 411 F.2d 350, 352 (9th Cir. 1969). Such  
16 use of the mark to refer to the product in these instances is  
17 appropriate.

18 In this case, Defendant's use satisfies the first prong. It  
19 would be infeasible to state that it was the publisher of a "series of  
20 heart-warming books containing short stories about the perseverance of  
21 individuals in difficult times." Instead, the publisher of the  
22 Chicken Soup for the Soul series, HCI, makes reference to the  
23 Plaintiffs' mark for purposes of identifying it. Such use is  
24 appropriate as the product that Plaintiffs' placed into the  
25 marketplace - in association with the Defendant - is "not readily  
26 identifiable without the use of the trademark." New Kids, 971 F.2d at  
27 308. Accordingly, the first prong of the nominative use analysis is  
28 satisfied.

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2           b. Reasonable use of the trademark

3           The second factor in nominative fair use requires that only so  
4 much of the mark is used as is reasonably necessary to identify the  
5 product or service. New Kids, 971 F.2d at 308. This factor examines  
6 the way in which the mark is used as an identifying feature by the  
7 Plaintiffs; specifically whether there are any distinct elements that  
8 are embodied in the mark, but not necessary to identify the mark. In  
9 Cairns, the Ninth Circuit discussed this issue with reference to its  
10 own precedent and modern examples. The court explained that a "soft  
11 drink competitor would be entitled to compare its product to Coca-Cola  
12 or Coke, but would not be entitled to use Coca-Cola's distinctive  
13 lettering." Cairns, 292 F.3d at 1153-54 (quoting New Kids, 971 F.2d  
14 at 308 n. 7.) See also Toho Co. v. William Morrow & Co., 33 F. Supp.  
15 2d 1206, 1209, 1211 (C.D. Cal. 1998) (finding that a publisher using  
16 "Godzilla" used more of the mark than "reasonably necessary" when "the  
17 title [was] written in the distinctive lettering style used by [the  
18 trademark holder] and its licensees in their merchandising  
19 activities"). The Ninth Circuit has found that this is an  
20 individualized analysis, and that what is reasonably necessary to  
21 identify the product or service will differ on a case by case basis.  
22 Cairns, 292 F.3d at 1154. The Ninth Circuit has also stated "[w]here  
23 the description of the defendant's product depends on the description  
24 of the plaintiff's product, more use of the plaintiff's trademark is  
25 'reasonably necessary to identify the plaintiff's product' than in  
26 cases where the description of the defendant's product does not depend  
27 on the description of the plaintiff's product."

28           In the instant action, Plaintiffs object to the use of the mark



1 "Chicken Soup for the Soul" on the cover of future prints of  
2 Defendant's unassociated books. (Reply, at 7.) Defendant contends  
3 that it is a fact that it was the publisher of the Chicken Soup for  
4 the Soul books and it is simply using the mark to identify that fact.  
5 (Opp. at 19.) When Plaintiffs applied for this preliminary  
6 injunction, it appeared that the future publications by Defendant  
7 contained a rather prominent display of the Chicken Soup mark, while  
8 minimizing the font surrounding that mark, which indicated that it was  
9 the publisher of the series. The use of the mark also included the  
10 stylized form of writing that was used as part of the mark registered  
11 by Plaintiffs. Such use of the mark, by including the stylized  
12 writing, was likely more than was necessary to identify the product.  
13 The Defendant, however, submitted with its opposition the new covers  
14 that it will use in the publication of the books. For the books  
15 "Ultimate Dog Lover," "Ultimate Cat Lover," and "Ultimate Horse  
16 Lover," the Defendant has removed Plaintiffs' mark entirely from the  
17 cover. (Peluso Decl., Ex. G.) As to the books entitled "Republican's  
18 Soul" and "Democrat's Soul," however, Defendant does use the  
19 Plaintiffs' mark. Defendant, however, uses only the text, without any  
20 of the stylized writing that the Ninth Circuit has stated would be  
21 objectionable. In addition, the use of the mark is surrounded by  
22 similarly sized text. (Peluso Decl., Ex. H.) Accordingly,  
23 Defendant's use is reasonable in this case to identify itself as the  
24 publisher of the series and it does not use more than is reasonably  
25 necessary to identify the mark.

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1           c. Suggestion of Sponsorship

2           The third element of the nominative fair use analysis is whether  
3 Defendant has done anything "that would, in conjunction with the mark,  
4 suggest sponsorship or endorsement by the trademark holder." Playboy  
5 Enterprises, 279 F.3d at 796 at 803. The Ninth Circuit has noted that  
6 this element is merely "the other side of the likelihood-of-confusion  
7 coin." By this assertion, the court meant that "whereas plaintiff  
8 carries the burden of persuasion in a trademark infringement claim to  
9 show likelihood of confusion . . . the nominative fair use defense  
10 shifts to the defendant the burden of proving no likelihood of  
11 confusion." Brother Records, 318 F.3d at 909. It does not appear  
12 likely that Defendant will meet this burden based on the exhibits  
13 presented. Multiple elements of the mock-ups as currently projected  
14 by Defendant when taken together create a clear suggestion of  
15 sponsorship by Plaintiffs. As an initial matter, Plaintiffs' mark is  
16 exhibited prominently at the top of the mock-ups still at issue, while  
17 there is no display of the actual writers or editors anywhere on the  
18 mock-up. The space where it appears a reference to the creators of the  
19 book might go is no larger than that devoted to Plaintiff's mark.  
20 (Peluso Dec., Ex. G, at 8.) This prominence and placement creates a  
21 potential suggestion of sponsorship. See Brother Records, 318 F.3d at  
22 908 ("Jardine's promotional materials display 'The Beach Boys' more  
23 prominently and boldly than "Family and Friends," suggesting  
24 sponsorship by the Beach Boys.) However, this potential is mitigated  
25 by the fact that Plaintiff's mark appears in a sentence clearly  
26 referencing its limited association with the new books and without  
27 trade dress. (Peluso Dec., Ex. G, at 8.) Hence the prominence of the

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1 mark as it appears in the mock-ups would not alone create an  
2 impermissible suggestion of sponsorship.

3         Nonetheless, the Court finds that in conjunction with the  
4 specific nature and titles of the new books and the mock-ups, the  
5 prominence of the mark does create a suggestion of sponsorship. The  
6 "Republican's Soul" and "Democrat's Soul" are books nearly identical  
7 in format to the Chicken Soup for the Soul books, apparently featuring  
8 a compilation of writings relevant to people of a particular  
9 persuasion. Indeed, as both parties acknowledge, these books were at a  
10 prior time slated to be Chicken Soup for the Soul books. (Plaintiff  
11 Mot., at 2; Def. Mot., at 6.) This similarity greatly heightens the  
12 possibility that consumers will mistakenly believe in light of the  
13 prominence of Plaintiff's mark that the "Democrat's Soul" and  
14 "Republican's Soul" are not merely from the same publisher as the  
15 Chicken Soup for the Soul books, but are in fact sponsored by the  
16 Plaintiffs. KP Permanent Make-Up, 408 F.3d at 608 (noting that  
17 "proximity or relatedness of the goods" is a factor in the standard  
18 likelihood of confusion analysis). Such confusion is made considerably  
19 more probable by Defendant's selection of titles for these books  
20 utilizing the word "soul" and so unmistakably echoing the titles of  
21 the Chicken Soup for the Soul books. (Peluso Dec., Ex. G, at 8.) This  
22 close proximity of format and title of the new HCI books to the  
23 Chicken Soup for the Soul books hence ultimately renders Defendant's  
24 prominent display of Plaintiff's impermissibly suggestive of  
25 sponsorship.<sup>6</sup> If Defendant wishes to avoid this appearance of

26 \_\_\_\_\_  
27 <sup>6</sup> Plaintiff also seeks to submit evidence of actual confusion by  
28 electronic booksellers, newspapers, and freelance writers as to  
level of their association with the new HCI books. (Plaintiff  
Mot., 11-13.) However, the provenance of some of this evidence is

1 sponsorship, it must display Plaintiff's mark in a less prominent  
2 fashion or avoid titles so strongly reminiscent of the Chicken Soup  
3 for the Soul books. Until such changes are made, Defendant's use of  
4 Plaintiff's trademark cannot be regarded as nominative fair use.

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somewhat contested and all of the evidence predates the newest versions of the mock-ups at issue. (Def. Opp., at 6-9.) Therefore the Court does not rely on this evidence. In any case, Plaintiff is under no burden to show actual confusion and it is clear based on the mock-ups themselves that confusion is likely. Hence the evidence is unnecessary to the Court's determination.

1 **IV. CONCLUSION**

2 The Court GRANTS Plaintiffs a preliminary injunction prohibiting  
3 Defendant from utilizing Plaintiffs' mark in mock-ups of the covers of  
4 and future covers of "Democrat's Soul" and "Republican's Soul" in its  
5 prominent location.<sup>7</sup> The Court finds that, as to these uses of the  
6 mark, there would be a likelihood of success on the merits. In  
7 addition, in light of Defendant's frequent changes to the mock-ups,  
8 the Court requires Defendant to inform Plaintiffs of any changes in  
9 its use of Plaintiffs' mark in any of the mock-ups for five new HCI  
10 books originally at issue prior to making the changes so that  
11 Plaintiffs' may have an opportunity to bring further challenge if  
12 necessary. Bond pursuant to Fed. R. Civ. P. 65(c) is set at \$10,000.

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14 IT IS SO ORDERED.

15 DATED: April 1, 2008

16   
17 **STEPHEN V. WILSON**  
18 **UNITED STATES DISTRICT JUDGE**

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24 <sup>7</sup>In their original Motion, Plaintiffs appear to take issue with  
25 the publication of a book entitled "Chicken Soup for the  
26 Basketball Soul," claiming that this is an unauthorized  
27 exploitation of the mark. (Mot., at 2.) In opposition,  
28 Defendant noted that this was done with knowledge and permission,  
it is a Chicken Soup book and was cited as such. (Opp., at 9  
(citing Vegso Decl., ¶ 7.) There was no reply to this argument  
presented in the moving papers, therefore the Court cannot find a  
likelihood of success on this point.