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UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF CALIFORNIA

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

Plaintiff,

v.

CALIFORNIA STATE GRANGE, a
California corporation,

Defendant.

CIV. NO. 2:14-00676 WBS DAD

MEMORANDUM AND ORDER RE: ENTRY
OF FINAL JUDGMENT AND PERMANENT
INJUNCTION

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In an Order dated July 14, 2015, the court granted plaintiff National Grange of the Order of Patrons of Husbandry's motion for summary judgment and held that, "upon entry of final judgment in this action defendant and its agents, affiliates, and assigns, or any party acting in concert with defendant and its agents, affiliates, and assigns, shall be permanently enjoined from using marks containing the word 'Grange.'" (July 14, 2015 Order at 19:28-20:4 (Docket No. 60).) The parties now stipulate

1 to plaintiff's voluntary dismissal with prejudice of its claims
2 for damages and plaintiff seeks entry of final judgment and
3 issuance of the permanent injunction.

4 Plaintiff specifically requests that the court issue
5 the following injunction:

6 Plaintiff National Grange is granted final judgment
7 permanently enjoining Defendant and its agents,
8 affiliates, and assigns, or any party acting in
9 concert with defendant and its agents, affiliates, and
10 assigns, from using any name or mark containing the
11 word "Grange," including without limitation "Grange,"
12 "Granger," "California Grange," "California State
13 Grange," or any word, acronym, abbreviation or
14 initialism confusingly similar thereto, including
15 without limitation "CG" and "CSG."

16 Within 14 days of the date of this Order, Defendant
17 shall transfer to Plaintiff National Grange the
18 registration for the domain name
19 www.CaliforniaGrange.org and the registrations for any
20 domain names containing the word "Grange," including
21 without limitation the words "Grange," "Granger,"
22 "California Grange," "California State Grange," or any
23 word, acronym, abbreviation or initialism confusingly
24 similar thereto, including without limitation "CG" and
25 "CSG."

26 It is hereby further ordered that immediately upon the
27 entry of this order, Defendant and its agents,
28 affiliates, and assigns, or any party acting in
concert with defendant and its agents, affiliates, and
assigns, are permanently enjoined from representing or
asserting, by words or actions, that they are
affiliated or connected in any way with the Grange
organization, including Plaintiff National Grange or
any State, Pomona, or local community Grange.

(Docket No. 75 at 3-4.) Defendant opposes the request. The
scope of this proposed injunction exceeds the allegations in
plaintiff's Complaint and the court's finding on summary judgment

1 that defendant "shall be permanently enjoined from using marks
2 containing the word 'Grange.'"

3 Plaintiff's proposed injunction extends to defendant's
4 use of the word "Granger" and the acronyms "CSG" and "CG." In
5 the Complaint, however, plaintiff alleges only that defendant's
6 use of its "GRANGE Marks" infringes plaintiff's trademarks.

7 (E.g., Compl. ¶¶ 3, 10, 53, 69, 81, 97 (Docket No. 1).)

8 Plaintiff alleges that defendant infringed on ten registered
9 trademarks, which were limited to "NATIONAL GRANGE," "THE GRANGE
10 FOUNDATION," "NATIONAL GRANGE OF THE ORDER OF PATRONS OF
11 HUSBANDRY," two trademarks for "P OF H GRANGE," and five
12 trademarks for "GRANGE." (Id. ¶ 20.) All of the allegations in
13 the Complaint are limited to those "GRANGE Marks."

14 In its prayer for relief, plaintiff sought to enjoin
15 defendant "from using the GRANGE Marks or any other mark,
16 corporate name or trade name that contains the word GRANGE, or
17 any other trademarks confusingly similar to the GRANGE Marks . .
18 . ." (Id. at 21-22 (emphasis added).) While it could have been
19 alleged that "Granger" and the acronyms "CSG" and "CG" are
20 "trademarks confusingly similar to the GRANGE Marks," plaintiff
21 made no such allegations in its Complaint nor did plaintiff seek
22 summary judgment as to defendant's use of "Granger" or the
23 acronyms. In fact, the Complaint does not even allege that
24 defendant uses "Granger," "CSG," or any other offending acronym.¹

25 ¹ Although plaintiff cites two cases in which acronyms
26 were protected, whether the acronyms were in fact trademarks was
27 litigated in those cases. See U.S. Jaycees v. San Francisco Jr.
28 Chamber of Commerce, 354 F. Supp. 61, 66 (N.D. Cal. 1972)
(finding that plaintiff "owns the trademark[] . . . 'J.C.'");
Planned Parenthood Fed'n of Am., Inc. v. Problem Pregnancy of

1 That plaintiff is especially concerned about
2 defendant's use of "CSG" is of no surprise in light of
3 defendant's conduct since the court issued its July 14, 2015
4 Order. In what appears to be a game of "gotcha," defendant
5 registered itself as doing business as the "California State
6 Guild" only eight days after learning it would be enjoined from
7 using "Grange." (McFarland Decl. Ex. C (Docket No. 78-3).)
8 According to defendant, "CSG" is simply its acronym for the new
9 "California State Guild." (Id. ¶¶ 8-10.) It is merely a
10 convenient coincidence that this "new" acronym happens to be the
11 same acronym defendant used when it went by "California State
12 Grange." (See Komski Decl. Ex. 4 (Docket No. 83-5) (numerous
13 publications showing defendant's use of "CSG" prior to 2015).)

14 While plaintiff's concerns may be real, the Complaint
15 defines the scope of this litigation and it neither sought
16 trademark protection of nor requested the court enjoin defendant
17 from using "Granger," "CSG," or "CG." Because summary judgment
18 was limited to the use of "Grange," whether "Granger" or the
19 acronyms are protected trademarks was never litigated or before
20 the court. The court must therefore limit the permanent
21 injunction to the relief requested in the Complaint and the
22 trademark upon which it granted summary judgment. See Crawford

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24 Worcester, Inc., 498 N.E.2d 1044, 1049 (Mass. 1986) (affirming
25 the lower court's finding "of secondary meaning as it was clearly
26 established that the initials 'PP' were strongly associated with
27 the organization Planned Parenthood in the public eye").
28 Similarly, in Wolfard Glassblowing Co. v. Vanbragt, the permanent
injunction issued pursuant to the consent judgment had prohibited
defendant from making "colorable imitations" of plaintiff's
product and the Ninth Circuit was applying the terms of that
injunction. See 118 F.3d 1320, 1321-23 (9th Cir. 1997).

1 v. Gould, 56 F.3d 1162, 1168 (9th Cir. 1995) (“[A] court may not,
2 without the consent of all persons affected, enter a judgment
3 which goes beyond the claim asserted in the pleadings.” (quoting
4 Brawner v. Pearl Assurance Co., 267 F.2d 45, 47 n.2 (9th Cir.
5 1958))); see also Fed. R. Civ. P. 15(b)(2) (“When an issue not
6 raised by the pleadings is tried by the parties’ express or
7 implied consent, it must be treated in all respects as if raised
8 in the pleadings.”) (emphasis added).

9 For the first time in this case, plaintiff also
10 requests that the court require defendant to transfer to
11 plaintiff “the registration for the domain name[s]” that include
12 the word “Grange.” Although the permanent injunction would
13 preclude defendant from using a domain name with “Grange” in it,
14 plaintiff neither sought in the Complaint nor articulated in its
15 current motion why the court should require defendant to transfer
16 that property to plaintiff. See Office Depot Inc. v. Zuccarini,
17 596 F.3d 696, 701 (9th Cir. 2010) (“[D]omain names are intangible
18 property under California law.”). The court therefore will not
19 require defendant to transfer any property, including a domain
20 name or Grange regalia, to plaintiff.

21 Lastly, plaintiff requests that the court enjoin
22 defendant “from representing or asserting, by words or actions,
23 that they are affiliated or connected in any way with the Grange
24 organization, including Plaintiff National Grange or any State,
25 Pomona, or local community Grange.” While defendant’s
26 disaffiliation from plaintiff is undisputed, (see July 14, 2015
27 Order at 2:16-20), its representation of or affiliations with any
28 local Grange was not at issue in this case and is currently being

1 litigated in state court. Again, the court will not enjoin
2 conduct that was not raised in the Complaint or litigated in the
3 case.²

4 IT IS THEREFORE ORDERED that plaintiff's claims for
5 damages, including but necessarily limited to recovery of profits
6 under 25 U.S.C. § 1117, are dismissed with prejudice and the
7 trial date of October 14, 2015 is VACATED.

8 IT IS FURTHER ORDERED that final judgment be entered
9 permanently enjoining defendant and its agents, affiliates, and
10 assigns, or any party acting in concert with defendant and its
11 agents, affiliates, and assigns from using marks containing the
12 word "Grange."

13 Dated: September 29, 2015

14 
15 **WILLIAM B. SHUBB**
16 **UNITED STATES DISTRICT JUDGE**

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² To the extent defendant suggests the injunction should
23 not extend to "any party acting in concert with defendant and its
24 agents, affiliates, and assigns," defendant is mistaken. This is
25 the precise language the court used in its Order granting summary
26 judgment. (July 14, 2015 Order at 19:28-20:4); see also Fed. R.
27 Civ. P. 65(d)(2) (proving that an injunction binds "(A) the
28 parties; (B) the parties' officers, agents, servants, employees,
and attorneys; and (C) other persons who are in active concert or
participation with anyone described in . . . (A) or (B).");
(accord Compl. at 21-22 (requesting the court enjoin "all person
in active concert or participation with Defendant").)