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U.S. COURT OF APPEALS

NOT FOR PUBLICATION

UNITED STATES COURT OF APPEALS

FOR THE NINTH CIRCUIT

RAUL CAIZ, individually, Plaintiff-Appellant, v. WILLIAM LEONARD ROBERTS II, an individual, AKA Mastermind, AKA Rick Ross; UNIVERSAL MUSIC GROUP, INC., a California Corporation; DEF JAM RECORDS, INC., Delaware Corporation; MAYBACH MUSIC GROUP, LLC, a Florida Limited Liability Company, DOES 1 through 10, inclusive, Defendants-Appellees.	No. 17-55051 D.C. No. 2:15-cv-09044-RSWL-AGR MEMORANDUM*

Appeal from the United States District Court
for the Central District of California
Ronald S.W. Lew, District Judge, Presiding

Argued and Submitted June 5, 2018
Pasadena, California

*This disposition is not appropriate for publication and is not precedent except as provided by 9th Cir. R. 36-3.

Before: FERNANDEZ and CHRISTEN, Circuit Judges, and BENNETT,** District Judge.

Raul Caiz appeals the district court's grant of summary judgment[1] in favor of William Leonard Roberts II (also known as Mastermind and Rick Ross), Def Jam Recordings, Inc., Maybach Music Group, LLC, and Universal Music Group, Inc. (collectively "Alleged Infringers"), in Caiz's action for infringement of his registered trademark, MASTERMIND, Registration Number 4,366,332 (hereafter "the Trademark"). We reverse and remand.

Caiz asserts that the district court erred when it determined that Caiz could not prevail on his trademark infringement claim[2] because the Trademark was not a "'valid, protectable trademark,'"[3] and also directed cancellation of the registration of the Trademark.[4] We agree.

We recognize that "[a] plaintiff bears the ultimate burden of proof in a

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**The Honorable Mark W. Bennett, United States District Judge for the Northern District of Iowa, sitting by designation.

[1]*Caiz v. Roberts*, 224 F. Supp. 3d 944, 947 (C.D. Cal. 2016).

[2]*See* 15 U.S.C. § 1114(1)(a).

[3]*See Zobmondo Entm't, LLC v. Falls Media, LLC*, 602 F.3d 1108, 1113 (9th Cir. 2010).

[4]*See* 15 U.S.C. § 1119.

trademark-infringement action that the trademark is valid and protectable." *Zobmondo*, 602 F.3d at 1113. Moreover, only a distinctive mark is "valid and protectable." *Id.*; *see also KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 408 F.3d 596, 602 (9th Cir. 2005). However, the Trademark was registered, which gave rise "to a 'strong presumption' that the mark is a protectable mark,"[5] and, while that presumption can be overcome,[6] "the burden on the defendant necessary to overcome that presumption at summary judgment is heavy."[7] Here the presumption is that the Trademark is valid and suggestive. *See Zobmondo*, 602 F.3d at 1114; *Lahoti v. VeriCheck, Inc.*, 586 F.3d 1190, 1199 & n.5 (9th Cir. 2009).

The Alleged Infringers presented some evidence that the Trademark was not valid, but that evidence by itself was not weighty enough to overcome the presumption of validity at summary judgment. The evidence tendered by the Alleged Infringers did not demonstrate that there was no factual dispute that, even in the context of the music genre and business involved here,[8] no mental leap or

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[5]*Zobmondo*, 602 F.3d at 1113; *see also* 15 U.S.C. §§ 1057(b), 1115(a); *KP Permanent*, 408 F.3d at 604; *Tie Tech, Inc. v. Kinedyne Corp.*, 296 F.3d 778, 783 (9th Cir. 2002).

[6]*Zobmondo*, 602 F.3d at 1115.

[7]*Id.*

[8]*See Lahoti*, 586 F.3d at 1201.

imagination[9] would be needed to connect the Trademark to the products covered by the Trademark. For example, while the Alleged Infringers point to a dictionary definition that uses the word "mastermind" with reference to a musician,[10] that is far from establishing that musicians (or hip hop musicians in particular) necessarily come to mind when the word is used. Moreover, evidence that other musicians have called themselves masterminds does not establish that the word is necessarily descriptive in this instance. Similarly, while the widespread use of the word itself by others might weaken the Trademark's strength,[11] it does not conclusively demonstrate that competitors need to use the word to fairly describe their products.[12]

Overall, we cannot say that the evidence presented in the motion for summary judgment demonstrates that no rational juror could find in favor of Caiz. That is, we need not and do not decide that the Alleged Infringers' evidence has no weight; we decide that it is not weighty enough to counterbalance the heavy burden

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[9]*See Zobmondo*, 602 F.3d at 1116; *Lahoti*, 586 F.3d at 1198; *see also Japan Telecom, Inc. v. Japan Telecom Am. Inc.*, 287 F.3d 866, 873 (9th Cir. 2002).

[10]Oxford University Press, *Concise Oxford Am. Dictionary* 546 (2006).

[11]*See Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1143–44 (9th Cir. 2002).

[12]*See Zobmondo*, 602 F.3d at 1117; *Entrepreneur Media*, 279 F.3d at 1143.

imposed by the presumption at summary judgment.

We note that because of its decision that the Trademark was not at all distinctive as a matter of law, the district court found the Trademark to be invalid and ordered its registration cancelled.[13] We reverse those determinations. The district court, however, saw no reason to consider the Alleged Infringers' other arguments.[14] Similarly, in light of its decision regarding invalidity, the district court saw no reason to consider the Alleged Infringers' fair use defense.[15] We decline to rule on those issues; we leave them to the district court to consider in the first instance. *Cf. Golden Nugget, Inc. v. Am. Stock Exch., Inc.*, 828 F.2d 586, 590 (9th Cir. 1987) (per curiam). Finally, we note that Caiz has not challenged the district court's grant of summary judgment as to his other claims. We, therefore, deem any argument regarding these claims waived. *See Smith v. Marsh*, 194 F.3d 1045, 1052 (9th Cir. 1999).

Costs are to be taxed against the Appellees.

REVERSED and REMANDED.

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[13] *See Gracie v. Gracie*, 217 F.3d 1060, 1065–66 (9th Cir. 2000).

[14] *See Caiz*, 224 F. Supp. 3d at 953.

[15] *See id.* at 956; *see also Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1150–51 (9th Cir. 2002).

United States Court of Appeals for the Ninth Circuit

Office of the Clerk
95 Seventh Street
San Francisco, CA 94103

Information Regarding Judgment and Post-Judgment Proceedings

Judgment

- This Court has filed and entered the attached judgment in your case. Fed. R. App. P. 36. Please note the filed date on the attached decision because all of the dates described below run from that date, not from the date you receive this notice.

Mandate (Fed. R. App. P. 41; 9th Cir. R. 41-1 & -2)

- The mandate will issue 7 days after the expiration of the time for filing a petition for rehearing or 7 days from the denial of a petition for rehearing, unless the Court directs otherwise. To file a motion to stay the mandate, file it electronically via the appellate ECF system or, if you are a pro se litigant or an attorney with an exemption from using appellate ECF, file one original motion on paper.

Petition for Panel Rehearing (Fed. R. App. P. 40; 9th Cir. R. 40-1)
Petition for Rehearing En Banc (Fed. R. App. P. 35; 9th Cir. R. 35-1 to -3)

(1) A. Purpose (Panel Rehearing):

- A party should seek panel rehearing only if one or more of the following grounds exist:
  - ► A material point of fact or law was overlooked in the decision;
  - ► A change in the law occurred after the case was submitted which appears to have been overlooked by the panel; or
  - ► An apparent conflict with another decision of the Court was not addressed in the opinion.
- Do not file a petition for panel rehearing merely to reargue the case.

B. Purpose (Rehearing En Banc)

- A party should seek en banc rehearing only if one or more of the following grounds exist:

- ► Consideration by the full Court is necessary to secure or maintain uniformity of the Court's decisions; or
- ► The proceeding involves a question of exceptional importance; or
- ► The opinion directly conflicts with an existing opinion by another court of appeals or the Supreme Court and substantially affects a rule of national application in which there is an overriding need for national uniformity.

(2) Deadlines for Filing:

- A petition for rehearing may be filed within 14 days after entry of judgment. Fed. R. App. P. 40(a)(1).
- If the United States or an agency or officer thereof is a party in a civil case, the time for filing a petition for rehearing is 45 days after entry of judgment. Fed. R. App. P. 40(a)(1).
- If the mandate has issued, the petition for rehearing should be accompanied by a motion to recall the mandate.
- *See* Advisory Note to 9th Cir. R. 40-1 (petitions must be received on the due date).
- An order to publish a previously unpublished memorandum disposition extends the time to file a petition for rehearing to 14 days after the date of the order of publication or, in all civil cases in which the United States or an agency or officer thereof is a party, 45 days after the date of the order of publication. 9th Cir. R. 40-2.

(3) Statement of Counsel

- A petition should contain an introduction stating that, in counsel's judgment, one or more of the situations described in the "purpose" section above exist. The points to be raised must be stated clearly.

(4) Form & Number of Copies (9th Cir. R. 40-1; Fed. R. App. P. 32(c)(2))

- The petition shall not exceed 15 pages unless it complies with the alternative length limitations of 4,200 words or 390 lines of text.
- The petition must be accompanied by a copy of the panel's decision being challenged.
- An answer, when ordered by the Court, shall comply with the same length limitations as the petition.
- If a pro se litigant elects to file a form brief pursuant to Circuit Rule 28-1, a petition for panel rehearing or for rehearing en banc need not comply with Fed. R. App. P. 32.

- The petition or answer must be accompanied by a Certificate of Compliance found at Form 11, available on our website at www.ca9.uscourts.gov under *Forms.*
- You may file a petition electronically via the appellate ECF system. No paper copies are required unless the Court orders otherwise. If you are a pro se litigant or an attorney exempted from using the appellate ECF system, file one original petition on paper. No additional paper copies are required unless the Court orders otherwise.

Bill of Costs (Fed. R. App. P. 39, 9th Cir. R. 39-1)

- The Bill of Costs must be filed within 14 days after entry of judgment.
- See Form 10 for additional information, available on our website at www.ca9.uscourts.gov under *Forms.*

Attorneys Fees

- Ninth Circuit Rule 39-1 describes the content and due dates for attorneys fees applications.
- All relevant forms are available on our website at www.ca9.uscourts.gov under *Forms* or by telephoning (415) 355-7806.

Petition for a Writ of Certiorari

- Please refer to the Rules of the United States Supreme Court at www.supremecourt.gov

Counsel Listing in Published Opinions

- Please check counsel listing on the attached decision.
- If there are any errors in a published opinion, please send a letter **in writing within 10 days** to:
  - ► Thomson Reuters; 610 Opperman Drive; PO Box 64526; Eagan, MN 55123 (Attn: Jean Green, Senior Publications Coordinator);
  - ► and electronically file a copy of the letter via the appellate ECF system by using "File Correspondence to Court," or if you are an attorney exempted from using the appellate ECF system, mail the Court one copy of the letter.

Form 10. Bill of Costs .....***(Rev. 12-1-09)***

United States Court of Appeals for the Ninth Circuit

BILL OF COSTS

This form is available as a fillable version at:
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Note: If you wish to file a bill of costs, it MUST be submitted on this form and filed, with the clerk, with proof of service, within 14 days of the date of entry of judgment, and in accordance with 9th Circuit Rule 39-1. A late bill of costs must be accompanied by a motion showing good cause. Please refer to FRAP 39, 28 U.S.C. § 1920, and 9th Circuit Rule 39-1 when preparing your bill of costs.

_____ v. _____ 9th Cir. No. _____

The Clerk is requested to tax the following costs against: _____

Cost Taxable under FRAP 39, 28 U.S.C. § 1920, 9th Cir. R. 39-1	**REQUESTED** *(Each Column Must Be Completed)*				**ALLOWED** *(To Be Completed by the Clerk)*			
	No. of Docs.	Pages per Doc.	Cost per Page*	TOTAL COST	No. of Docs.	Pages per Doc.	Cost per Page*	TOTAL COST
Excerpt of Record			$	$			$	$
Opening Brief			$	$			$	$
Answering Brief			$	$			$	$
Reply Brief			$	$			$	$
Other**			$	$			$	$
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* *Costs per page*: May not exceed .10 or actual cost, whichever is less. 9th Circuit Rule 39-1.

** *Other*: Any other requests must be accompanied by a statement explaining why the item(s) should be taxed pursuant to 9th Circuit Rule 39-1. Additional items without such supporting statements will not be considered.

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Form 10. Bill of Costs - *Continued*

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Signature _____

("s/" plus attorney's name if submitted electronically)

Date _____

Name of Counsel: _____

Attorney for: _____

(To Be Completed by the Clerk)

Date _____ Costs are taxed in the amount of $ _____

Clerk of Court

By: _____ , Deputy Clerk