

Court agrees with the Plaintiff that the issue of tacking involves a comparison of the Defendant's two marks MOGULS OF NASHVILLE CITY CLUB and MOGULS BARBER AND LOUNGE. That is the comparison the Court used in analyzing the tacking issue on summary judgment. The Plaintiff is incorrect, however, in its assertion that "the Court erred when it examine[ed] MOGULS by itself, outside its use in the mark MOGULS OF NASHVILLE CITY CLUB." Clarified herein is that summary judgment was denied based on a comparison of MOGULS OF NASHVILLE CITY CLUB and MOGULS BARBER AND LOUNGE, and at the upcoming bench trial the tacking issue shall be decided based on a comparison of the MOGULS OF NASHVILLE CITY CLUB and MOGULS BARBER AND LOUNGE marks.

The flaw in the Plaintiff's motion to reconsider is that the Plaintiff's concept of the standard for tacking of "exceedingly strict, permitted 'only in rare instances,' and only in 'exceptionally narrow instances'", requires the Defendant to demonstrate that the two successive marks are not virtually identical but are identical. The Plaintiff's legal position is not the United States Supreme Court's instruction on the legal standard to be applied to a tacking defense. The test for tacking is not whether the two marks at issue – MOGULS OF NASHVILLE CITY CLUB and MOGULS BARBER AND LOUNGE – are identical but whether they create the same, continuing commercial impression so that consumers consider both as the same mark. As quoted below, the key differences between the United

summary judgment, and the Court's analysis of the tacking issue took into account the context of a bench trial, not a jury trial, with the Court serving as the fact finder.

States Supreme Court’s instruction and Plaintiff’s position are sameness, commercial impression, and a consumer’s point of view.

As discussed above, the general rule adopted by lower courts has been that two marks may be tacked when the original and revised marks are “legal equivalents.” This term refers to two marks that “create the same, continuing commercial impression” so that consumers “consider both as the same mark.”¹ *Van Dyne–Crotty, Inc.*, 926 F.2d, at 1159 (internal quotation marks omitted); see, e.g., *George & Co., LLC v. Imagination Entertainment Ltd.*, 575 F.3d 383, 402 (C.A.4 2009); *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1047–1048 (C.A.9 1999); *Data Concepts, Inc.*, 150 F.3d, at 623. “The commercial impression that a mark conveys must be viewed through the eyes of a consumer.” *911 DuoProSS Meditech Corp. v. Inviro Medical Devices, Ltd., 695 F.3d 1247, 1253 (C.A.Fed.2012); see 3 J. McCarthy, *Trademarks and Unfair Competition* § 17:26, p. 17–71 (4th ed. 2014) (“ ‘Commercial impression,’ like most issues in trademark law, should be determined from the perspective of the ordinary purchaser of these kinds of goods or services”).

Application of a test that relies upon an ordinary consumer's understanding of the impression that a mark conveys falls comfortably within the ken of a jury.

This is certainly not to say that a judge may never determine whether two marks may be tacked. If the facts warrant it, a judge may decide a tacking question on a motion for summary judgment or for judgment as a matter of law. See Fed. Rules Civ. Proc. 50, 56(a). And if the parties have opted to try their case before a judge, the judge may of course decide a tacking question in his or her factfinding capacity. We hold only that, when a jury trial has been requested and when the facts do not warrant entry of summary judgment or judgment as a matter of law, the question whether tacking is warranted must be decided by a jury.

Hana Fin., Inc. v. Hana Bank, 135 S. Ct. 907, 909; 910–11 (2015).

The Court, therefore, continues to maintain its determination in the August 23, 2018 *Memorandum And Order* denying summary judgment on tacking that the summary judgment record does not enable the Court to reach but one conclusion. The summary judgment record establishes that a trial is necessary to determine whether the two marks used by the Defendant are sufficiently the same, continuing commercial impression so that consumers consider both as the same mark. The summary judgment record does not establish and the marks themselves on their face are not so dissimilar that no ordinary purchaser or consumer could conclude that MOGULS BARBER AND LOUNGE creates the same commercial impression as MOGULS NASHVILLE CITY CLUB. Thus, even though this case shall be tried as a bench trial with the Court sitting as the fact finder, the filter to be applied in determining whether the two marks create the same, continuing commercial impression is “ through the eyes of a consumer.” Testimony from consumers at trial will assist this determination.

Another standard the Plaintiff has misapplied pertains to the evidence. In seeking reconsideration on the tacking issue, the Plaintiff argues that the Court “committed reversible error” by being “persuaded by the declarations of two witnesses...despite Defendant’s failure to produce consumer survey evidence.” The Plaintiff’s argument that the “proper standard” of evidence to support a tacking defense is through survey evidence is not an accurate characterization of the case law as pointed out by the Defendant.

Finally, Plaintiff would want this Court to believe that Mr. Southall has to present a “consumer survey” to demonstrate “commercial impression”; however, the Court in *Paleteria* stated that commercial impression ... **should be resolved by considering a range of evidence**, ideally including

consumer survey evidence.” See *Plaintiff’s Reply In Support of Her Motion for Summary Judgment*, p.4; Citing *Paeteria*, 188 F. Supp. 3d at 59 (emphasis added) (quoting *Hana Fin., Inc. v. Hana Bank*, 735 F.3d 1158, 1164 (9th Cir. 2013), *aff’d Hana Fin.*, 135 S. Ct. 907)). Although a consumer survey might be ideal in some circumstances, the Court can consider a range of evidence presented at trial in making its determination and not just an emphasis on visual similarities which may or may not be conclusive. In haircare industry operating in the local geographic area, the haircare businesses primarily utilize word of mouth and social media to local customers. Use of consumer surveys are more consistent with larger markets and when proving the likelihood of confusion.

Defendant Southall’s Response To Plaintiff’s Motion To Reconsider Denial Of Summary Judgment, p. 11 (Sept. 10, 2018) (emphasis added).

Additionally, the Plaintiff states that “[i]f this motion is denied, Plaintiff anticipates filing motions *in limine* to exclude such testimony.” While the Court has now provided a deadline for motions *in limine* prior to trial, at the time of the filing of the summary judgment motion, the Plaintiff did not file any such motion to strike the Declarations and therefore the Court considered the Declarations pursuant to the summary judgment standard under Tennessee law.

As to denying summary judgment on the “likelihood of confusion” test, in the interest of time the Court adopts the Defendant’s reasoning and analysis on pages 11 through 14 of its brief which states accurately why the Court’s analysis in denying summary judgment on the “likelihood of confusion” issue was not the reversible error the Plaintiff claims.

The Court did not commit reversible error by concluding that “there is still a genuine issue of material fact on whether the Defendant’s use of the ‘Moguls’ mark is likely to cause confusion. In making this decision, the Court concludes that the issue of ‘likelihood of confusion’ is not purely a

legal conclusion to be made by the Court but is a mixed question of law and fact.” See *Mem. Op.* pp.25-26. Plaintiff uses an example describing the sale of cars with the mark VOLVO out of context to the current case in attempting to argue that the Court’s determination is illogical. However, Mr. Southall has been consistently clear that his business model included the operation of entities under his umbrella in which one performed haircare services (Supreme Choppers) for primarily men as evidenced in his responses to paragraphs 15 and 19 of the Statements of Undisputed Material Fact. This is clearly distinguishable from the VOLVO example provided by Plaintiff.

As stated above, the Court found that genuine issues of material fact were presented by Mr. Southall warranting a denial of summary judgment on this issue. Plaintiff takes issue with the fact that the Court did not go into a detailed analysis of each of the Frisch’s factors separately and argues that this was in error. Plaintiff is wrong. The Court analyzed three of the factors and once the Court found that genuine issues of material facts were presented on those three sub-issues of (relatedness of goods, similarity of the marks and intent), no further analysis was necessary given that genuine issues of material fact were identified which justified the summary judgment denial. As Mr. Southall pointed out in his response to plaintiff’s motion for summary judgment, “[t]he services offered by Plaintiff and Defendant do not significantly overlap and are only related because they both involve hair services. They are not in direct competition but do have one related service which involves hair cutting. Defendant is distinctively and solely a barber, he does not operate a beauty salon as does Plaintiff. Defendant offers tailoring, shoeshines, haircuts, and event rental space.” *Defendant/Counter-Plaintiff Southall’s Response to Plaintiff’s Motion for Summary Judgment and Memorandum of Law*, p. 9. A denial of summary judgment in this regard was correct and it is consistent with case law which states the following in regards to relatedness of the goods: “This factor admits of three possible scenarios: (1) cases in which the services of the parties are in direct competition, "in which case confusion is likely if the marks are sufficiently similar"; (2) cases in which the "services are somewhat related but not competitive, so that likelihood of confusion may or may not result depending on other factors"; and (3) cases in which the "services are totally unrelated, in which case confusion is unlikely.”” *Champions Golf Club, Inc. v. Champions Golf Club, Inc.*, 78 F.3d 1111, 1996 U.S. App. LEXIS 4934, 1996 FED App. 0094P (6th Cir.), 38 U.S.P.Q.2D (BNA) 1161.

The Plaintiff would have the Court limit its analysis to hair services but that narrow view of the services would be inaccurate. The fact remains that Mr. Southall offers hair cutting/barbering services among a host of other services. His clientele knows that and expects that. He does not operate a beauty salon as does the Plaintiff. So, while hair services are a part of his offerings, his business is much more than that and is not in direct competition with Plaintiff's business and never has been. To use the Plaintiff's example, Plaintiff sells cars in connection with the mark VOLVO, but changes it to VOLBO, and Mr. Southall uses VOLVO as the name of the business model he operates with Supreme Choppers providing cars and other business entities providing other offerings to his customers. In this scenario, the Court could very well find that no likelihood of confusion exists, especially considering the distinct nature and visual spelling of the marks. Consequently, the Court can easily determine that there are sufficient genuine issues of material fact to warrant denial of Plaintiff's Motion for Summary Judgment.

The *Progressive Distribution* case cited by the Court and Plaintiff show that the Court's analysis of likelihood of confusion was correct and summary judgment properly denied. The *Progressive Distribution* court stated that "[i]n applying these [Frisch] factors, we recognize that they 'imply no mathematical precision, but are simply a guide to help determine whether confusion is likely.'" (citations omitted). *Progressive Distribution Servs. v. UPS, Inc.*, 856 F.3d 416, 424-25 (6th Cir. 2017). For summary judgment purposes, the law does not require the Court to make a mathematical determination and compare the number of factors weighing one way or the other. For purposes of summary judgment, the Court is to decide whether disputed facts exist warranting a denial of summary judgment and having those issues tried. The Court did just that. The Court determined during its sampling of the Frisch factors that genuine issues of material fact existed on three of the factors therefore no additional analysis was required because as the *Progressive* court pointed out the factors "are simply a guide to help determine whether confusion is likely." *Id.*

Defendant Southall's Response To Plaintiff's Motion To Reconsider Denial Of Summary Judgment, pp. 11-14 (Sept. 10, 2018).

Finally, as to the Plaintiff's point "that judicial economy would be better achieved through summary judgment, especially since this is a bench trial", the Court, respectfully,

rejects this as inconsistent with Tennessee law. Judicial economy, while aspirational in the business court, can not dictate or alter the requirements of Tennessee law. While summary judgment is a useful tool in promoting judicial economy, it is not a substitute for trial when there are disputed factual issues, even when the case is to be tried as a bench trial.

Summary judgments provide an efficient means to conclude cases that can be disposed of on legal issues alone. *Bellamy v. Federal Express Corp.*, 749 S.W.2d 31, 33 (Tenn.1988); *Brookins v. The Round Table, Inc.*, 624 S.W.2d 547, 550 (Tenn.1981). However, they are not substitutes for a trial of disputed factual issues. *Jones v. Home Indem. Ins. Co.*, 651 S.W.2d 213, 214 (Tenn.1983). Nor should they be used to resolve disputes concerning inferences to be drawn from the facts or to weigh the evidence. *Hamrick v. Spring City Motor Co.*, 708 S.W.2d 383, 389 (Tenn.1986); *Executone of Memphis, Inc. v. Garner*, 650 S.W.2d 734, 736 (Tenn.1983).

Blair v. Allied Maint. Corp., 756 S.W.2d 267, 269 (Tenn. Ct. App. 1988).

For all these reasons, the *Plaintiff's Motion To Reconsider Denial Of Summary Judgment* is denied. A trial with witness testimony concerning the issues of the same, continuing commercial impression and likelihood of confusion are necessary to decide the issues of this case.

s/ Ellen Hobbs Lyle
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