

**UNITED STATES DISTRICT COURT
DISTRICT OF MAINE**

CECIL McBEE,)	
)	
Plaintiff)	
)	
v.)	Docket No. 02-198-P-C
)	
DELICA CO., LTD.,)	
)	
Defendant)	

**MEMORANDUM DECISION ON MOTIONS IN LIMINE AND TO STRIKE AND
RECOMMENDED DECISION ON MOTIONS TO DISMISS AND FOR SUMMARY
JUDGMENT**

Presently before the court are a motion *in limine* filed by the defendant to exclude the testimony of George Hughes;¹ three motions to strike filed by the plaintiff; the defendant’s motion to dismiss; and the defendant’s two motions for summary judgment. I will deal with the motion *in limine* and the motions to strike as they become relevant to the substantive motions under consideration. I recommend that the court grant the motion to dismiss in part and grant one of the motions for summary judgment in part.

I. Motion to Dismiss

The defendant seeks dismissal of all claims asserted against it on the basis of an asserted lack of subject-matter jurisdiction. Defendant’s Motion to Dismiss for Lack of Subject-Matter Jurisdiction (“Motion to Dismiss”) (Docket No. 73) at 1. Dismissal is required, it contends, because the jurisdictional

¹ The defendant has filed motions *in limine* to exclude the testimony of seven individuals. Docket Nos. 60, 74-77,92-93.I address only those that concern testimony on which I rely in reaching my recommended decision with respect to the motions for summary judgment.

prerequisites for a claim under the Lanham Act are not present, *id.*; the Lanham Act controls all of the claims asserted by the plaintiff, *id.* at 12-13; and any claims not controlled by the Lanham Act are “made solely for the purpose of obtaining jurisdiction” and are “insubstantial and frivolous,” *id.* at 13-14. The plaintiff responds that only Count I of his complaint can reasonably be construed to assert claims covered by the Lanham Act, and that to the extent that the Lanham Act applies, his claims meet the jurisdictional prerequisites. Opposition to Motion to Dismiss for Lack of Subject Matter Jurisdiction (“Dismissal Opposition”) (Docket No. 110) at 1, 9-15.²

The parties rely on submissions outside the complaint in addressing this issue. Accordingly, while governed by Fed. R. Civ. P. 12(b)(1) as a motion addressing merely the sufficiency of the allegations of the complaint would be, this motion, which controverts some of the facts proffered by the plaintiff in support of his jurisdictional allegations, “permits . . . differential factfinding. Thus, the plaintiff’s jurisdictional averments are entitled to no presumptive weight; the court must address the merits of the jurisdictional claim by resolving the factual disputes between the parties.” *Valentin v. Hospital Bella Vista*, 254 F.3d 358, 363 (1st Cir. 2001). No evidentiary hearing has been requested, and none is required. *Id.* at 364.

The complaint alleges, in Count I, that the defendant has engaged in unfair competition in violation of 15 U.S.C. § 1125(a). Complaint, etc. (Docket No. 1) ¶¶ 20-23. In Count II, he alleges that the defendant’s use of his name constitutes a false designation in violation of the same statute. *Id.* ¶¶ 24-27. Subsection *c* of this statute is invoked in Count VIII, which alleges dilution “of the distinctive quality of

² The plaintiff also asserts, in conclusory fashion, that the “jurisdictional facts” concerning his Lanham Act claims are so “intertwined” with the merits of those claims that the jurisdictional question may only be decided after trial. Dismissal Opposition at 15-16. Specifically, the plaintiff contends that the “jurisdictional facts involving the scope of injunctive relief” are those that are so intertwined. *Id.* at 15. However, the defendant seeks dismissal of the entire action, not merely the plaintiff’s claims for injunctive relief. In any event, the facts relevant to the defendant’s jurisdictional argument may be readily discerned from the submissions of the parties; there is no need to delay resolution of this issue until the
(continued on next page)

Plaintiff's name." *Id.* ¶¶ 39-43. These are the only references to the Lanham Act, 15 U.S.C. § 1051 *et seq.*, *Beacon Mut. Ins. Co. v. Onebeacon Ins. Group*, ___ F.3d ___, 2004 WL 1562558 (1st Cir. July 12, 2004), at *1, in the nine-count complaint.

In *Steele v. Bulova Watch Co.*, 344 U.S. 280 (1952), the Supreme Court held that a federal district court had jurisdiction to award relief to an American citizen against acts of trademark infringement and unfair competition "consummated" in a foreign country by another American citizen. 344 U.S. at 281, 285. The Court noted that the question whether a valid foreign registration of the trademark in question "would affect either the power to enjoin or the propriety of its exercise is not before us." *Id.* at 289. In *dicta* which the defendant finds significant, the Court also observed that it had "often stated that the legislation of Congress will not extend beyond the boundaries of the United States unless a contrary legislative intent appears." *Id.* at 285. The Court also recited the "expressed intent" of the Lanham Act "to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce [and] to protect persons engaged in such commerce against unfair competition." *Id.* at 283.

The defendant also relies on the opinion in *Vanity Fair Mills, Inc. v. T. Eaton Co.*, 234 F.2d 633 (2d Cir. 1956), in which the Second Circuit observed that the Supreme Court in *Bulova*

stressed three factors: (1) the defendant's conduct had a substantial effect on United States commerce; (2) the defendant was a United States citizen and the United States has a broad power to regulate the conduct of its citizens in foreign countries; and (3) there was no conflict with trademark rights established under the foreign law, since the defendant's Mexican registration had been canceled by proceedings in Mexico.

expense of trial has been incurred.

234 F.2d at 642. The *Vanity Fair* plaintiff sought an injunction from an American court against the defendant's use of a trademark in Canada that was identical to the trademark registered in the United States by the plaintiff. *Id.* at 638. The defendant had registered the trademark in Canada and was a Canadian corporation. *Id.* at 637. The Second Circuit concluded "that the remedies provided by the Lanham Act . . . should not be given an extraterritorial application against foreign citizens acting under presumably valid trade-marks in a foreign country." *Id.* at 643. The defendant correctly points out, Motion to Dismiss at 8-9, that other federal district and circuit courts have adopted the Second Circuit's interpretation of *Bulova*, but the treatment of *Vanity Fair* by other federal courts has not been so uniform as the defendant suggests.³ In addition, the plaintiff contends that the fact that it is his own name and "persona" that is at issue, rather than a trademark registered in the United States, distinguishes this case from most of the reported case law, which deals with sales of branded goods. Dismissal Opposition at 5-9.

For purposes of analysis, I assume the First Circuit would adopt the *Vanity Fair* court's interpretation of *Bulova*. That said, it is undisputed that the defendant is not an American citizen. However, the plaintiff does contend that he satisfies the remaining two factors. The status of the defendant's registration of "Cecil McBee" as a trademark in Japan apparently remains undetermined, although as of the moment it seems the matter has been decided against the plaintiff by the Tokyo High Court. Declaration of Akihiko Hara (attached to Plaintiff's Motion . . . to Strike the Fourth Declaration of Akio Otsuka (Docket No. 103)) ¶ 15-16. Remaining for resolution is the plaintiff's appeal of an order issued by the Japanese Patent Office. *Id.* ¶¶ 7, 18-20. The plaintiff contends that his claims under the Lanham Act do not conflict with the proceeding in Japan in any event because that proceeding is limited to registration of his name as a

³ There are no published decisions of the First Circuit dealing with extraterritorial application of the Lanham Act.

trademark while what he claims in this action is trademark dilution, misappropriation and invasion of his right to privacy. Dismissal Opposition at 11. He provides no authority for his assertion that the Lanham Act protects his right to privacy, and none is apparent from the language of the statute. I will accordingly not consider this portion of his argument further. Finally, the plaintiff contends that only “some” effect on domestic commerce is required, rather than a “substantial” effect and that, in any event, injury to his reputation constitutes a substantial effect as a matter of law. *Id.* at 12-15.

To the extent that the plaintiff seeks injunctive relief under the Lanham Act, “enjoining and restraining Defendant . . . from directly or indirectly using the name CECIL McBEE or any other word similar to Plaintiff’s name which is likely to cause confusion, mistake or to deceive;” to “order that all labels, signs, prints, packages, wrappers, receptacles and advertisements . . . bearing the mark CECIL McBEE and all plates, molds, matrices and other means of making the same, shall be delivered up and destroyed;” and “enjoining and restraining Defendant . . . from . . . directly or indirectly using the name CECIL McBEE or any other word similar to Plaintiff’s name which is likely to cause confusion,” Complaint at 10, the relief sought would be in conflict with the defendant’s trademark rights under Japanese law, as it currently stands.

This action cannot be held in abeyance until the Japanese Patent Office rules on the plaintiff’s pending appeal, even assuming that such a ruling would be the end of the legal proceedings available to the plaintiff under Japanese law. While some courts have suggested that all three of the *Vanity Fair* factors need not be satisfied in order for a plaintiff to proceed under the Lanham Act, *see, e.g., Libbey Glass, Inc. v. Oneida Ltd.*, 61 F.Supp.2d 720, 723 (N.D. Ohio 1999) (court must weigh each *Vanity Fair* factor against the others; presence or absence of any one factor not dispositive), failure to satisfy two of the three is sufficient to deprive the United States courts of subject-matter jurisdiction. It is not necessary to consider the third *Vanity Fair* factor (lack of conflict with foreign law) with respect to the claims for injunctive relief. With

one exception, the plaintiff's only argument that *Vanity Fair*'s factors do not apply is limited to relief that he seeks other than injunctive relief. Dismissal Opposition at 5-9. With respect to the requests for injunctive relief quoted above, therefore, the defendant's motion should be granted.

The one exception is the plaintiff's argument that his claim for "violation of his right of publicity" under the Lanham Act entitles him to injunctive relief because Japanese law also recognizes such a right. *Id.* at 8-9. The defendant does not respond to this argument. "[T]he right of publicity flows from the right to privacy, which is a creature of state law," not the Lanham Act. *Alvarez Guedes v. Marcano Martinez*, 131 F.Supp.2d 272, 278 (D. P.R. 2001). *Accord, American Econ. Ins. Co. v. Reboans, Inc.*, 852 F. Supp. 875, 880 (N.D. Cal. 1994). The Lanham Act does not protect the "right of publicity," but its protection of individuals against "false endorsement" claims has been analogized to such claims. *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 924 (6th Cir. 2003). "False endorsement occurs when a celebrity's identity is connected with a product or service in such a way that consumers are likely to be misled about the celebrity's sponsorship or approval of the product or service." *Id.* at 925-26. *See also White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1515 n.17 (9th Cir. 1993) (Kozinski, J., dissenting from denial of rehearing en banc) ("The right of publicity isn't aimed at or limited to false endorsements . . . ; that's what the Lanham Act is for."). None of the authority cited by the plaintiff differentiates a false endorsement claim from other claims under the Lanham Act for purposes of the availability of injunctive relief against a foreign defendant that holds the right to the trademark at issue under that nation's law. The defendant is entitled to dismissal of any claims for injunctive relief under the Lanham Act that are based on alleged false endorsement as well.

The potential for conflict with Japanese law is not present as to the plaintiff's claims for damages, making it necessary to consider the element of effect on commerce in the United States. I find persuasive the

case law that holds that the effect on commerce sufficient to support subject-matter jurisdiction need not be substantial. *American Rice, Inc. v. Arkansas Rice Growers Coop. Ass'n*, 701 F.2d 408, 414 n.8 (5th Cir. 1983); *Star-Kist Foods, Inc. v. P.J. Rhodes & Co.*, 769 F.2d 1393, 1395 (9th Cir. 1985).⁴ The case law also supports the plaintiff's assertion that an injury to reputation may constitute a sufficient effect on domestic commerce. *Steele*, 344 U.S. at 286; *Libbey Glass*, 61 F.Supp.2d at 723; *Warnaco Inc. v. VF Corp.*, 844 F. Supp. 940, 951 (S.D.N.Y. 1994). The defendant scoffs at the plaintiff's claim that his reputation has been injured, asserting that "proof of [impact on United States commerce] is entirely lacking." Reply in Support of Defendant's Motion to Dismiss for Lack of Subject-Matter Jurisdiction ("Dismissal Reply") (Docket No. 119) at 3, an argument perhaps better suited to the summary judgment context, and that the plaintiff "can point to no actual (as opposed to speculative) impact on his reputation, anywhere," *id.* at 4. However, the plaintiff has provided some evidence of such an impact. Dismissal Opposition at 13. Whether that evidence will be sufficient to result in an award of damages is not relevant to consideration of a motion to dismiss. False representations involving a person's name by their nature can be damaging to that person's reputation and under the circumstances of this case the potential injury to the plaintiff's reputation establishes sufficient effect on domestic commerce to sustain subject-matter jurisdiction over those of the plaintiff's claims for damages that do not seek injunctive relief of the kind that would interfere with Japanese sovereignty. See *King v. Allied Vision, Ltd.*, 807 F. Supp. 300, 306-07 (S.D.N.Y.), *rev'd in part on other grounds sub nom. King v. Innovation Books*, 976 F.2d 824, 833 (2d Cir. 1992). The plaintiff has also provided evidence that the defendant's allegedly infringing products are making their way into domestic

⁴ The defendant's contention that the First Circuit has in effect adopted the "substantial impact" test for purposes of the Lanham Act by its decision in *United States v. Nippon Paper Indus. Co.*, 109 F.3d 1, 9 (1st Cir.1997), a criminal case arising under federal antitrust statutes, is not persuasive. The test for exercise of extraterritorial subject-matter jurisdiction in civil actions under the antitrust laws differs significantly from the *Vanity Fair* test. See, e.g., *Winterland Concessions* (continued on next page)

commerce and that the defendant offers the products for sale on an Internet website available throughout the world. Dismissal Opposition at 12-14. An impact on domestic American commerce must reasonably be expected under these circumstances in today's global economy.

The overall question nonetheless remains a close one because the defendant is a Japanese corporation. However, given the fact that the other two *Vanity Fair* factors favor the exercise of this court's jurisdiction over the defendant insofar as the Lanham Act claims seek other than injunctive relief that would conflict with Japanese law, I conclude on balance that that portion of Counts I-III should not be dismissed.

II. Motions for Summary Judgment

A. Summary Judgment Standard

Summary judgment is appropriate only if the record shows “that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law.” Fed. R. Civ. P. 56(c). “In this regard, ‘material’ means that a contested fact has the potential to change the outcome of the suit under the governing law if the dispute over it is resolved favorably to the nonmovant. By like token, ‘genuine’ means that ‘the evidence about the fact is such that a reasonable jury could resolve the point in favor of the nonmoving party.’” *Navarro v. Pfizer Corp.*, 261 F.3d 90, 93-94 (1st Cir. 2001) (quoting *McCarthy v. Northwest Airlines, Inc.*, 56 F.3d 313, 315 (1st Cir. 1995)). The party moving for summary judgment must demonstrate an absence of evidence to support the nonmoving party's case. *Celotex Corp. v. Catrett*, 477 U.S. 317, 325 (1986). In determining whether this burden is met, the court must view the record in the light most favorable to the nonmoving party and give that party the benefit of all

Co. v. Fenton, 835 F. Supp. 529, 531 (N.D. Cal. 1993).

reasonable inferences in its favor. *Nicolo v. Philip Morris, Inc.*, 201 F.3d 29, 33 (1st Cir. 2000). Once the moving party has made a preliminary showing that no genuine issue of material fact exists, the nonmovant must “produce specific facts, in suitable evidentiary form, to establish the presence of a trialworthy issue.” *Triangle Trading Co. v. Robroy Indus., Inc.*, 200 F.3d 1, 2 (1st Cir. 1999) (citation and internal punctuation omitted); Fed. R. Civ. P. 56(e). “As to any essential factual element of its claim on which the nonmovant would bear the burden of proof at trial, its failure to come forward with sufficient evidence to generate a trialworthy issue warrants summary judgment to the moving party.” *In re Spiegel*, 260 F.3d 27, 31 (1st Cir. 2001) (citation and internal punctuation omitted).

B. Factual Background

The defendant has filed motions for summary judgment on the grounds of *res judicata* and collateral estoppel and on the merits. Defendant’s Motion for Summary Judgment on Res Judicata and Collateral Estoppel (“First Summary Judgment Motion”) (Docket No. 78); Defendant’s Motion for Summary Judgment on the Merits (“Second Summary Judgment Motion”) (Docket No. 80). The undisputed material facts relevant to both of these motions are presented here. With its first summary judgment motion the defendant filed a document entitled Local Rule 56 Statement of Material Facts in Support of Defendant’s Motion for Summary Judgment Based on Lack of Subject-Matter Jurisdiction. Docket No. 79. The defendant filed its motion to dismiss for lack of subject-matter jurisdiction (Docket No. 73), discussed above, on the same day as the two motions for summary judgment. The title of the statement of material facts was in error; no such statement was required or considered in connection with the motion to dismiss. On the following day, counsel for the defendant filed a document entitled Amended Local Rule 56 Statement of Material Facts in Support of Defendant’s Motion for Summary Judgment on Res Judicata and/or Collateral Estoppel (“Defendant’s First SMF”) (Docket No. 94), which is identical to

Docket Number 79 except for its title. I will refer to the second document throughout this recommended decision. The plaintiff has filed a motion to strike the first document “[i]n order that the record not be confused.” Motion to Strike Defendant’s Local Rule 56 Statement of Material Facts in Support of Defendant’s Motion for Summary Judgment on Subject Matter Jurisdiction (Docket No. 104). That motion is granted.

The plaintiff, a jazz bassist, lives in Maine and New York. Defendant’s First SMF ¶ 1; Plaintiff’s Opposition to Defendant’s Amended Local Rule 56 Statement of Material Facts, etc. (“Plaintiff’s First Responsive SMF”) (Docket No. 108) ¶ 1. The defendant is a Japanese corporation a portion of whose business involves selling women’s clothing and accessories. *Id.* ¶ 2. The defendant has used the name Cecil McBee to market a line of clothing to young women since 1984. *Id.* ¶ 3. The defendant operates approximately 35 Cecil McBee retail stores throughout Japan. *Id.* ¶ 4. The plaintiff first learned of the defendant’s Cecil McBee line when he saw a Cecil McBee store in Japan. *Id.* ¶ 5.

The plaintiff’s attorney sent a letter to the defendant in January 1996 demanding that it stop using his name. *Id.* ¶ 7. The defendant registered trademark #1948509, consisting of the Katakana letters for “Seshiru Makubii,” on October 23, 1984 for clothing and related products. *Id.* ¶ 9. On October 1, 1996 the defendant applied to the Japan Patent Office (“JPO”) for registration of a mark consisting of the roman typeface letters “CECIL McBEE” and the katakana letters “seshiru makubii” written horizontally underneath the roman letters. *Id.* ¶ 10. On April 17, 1998 the JPO issued trademark #4136718 for this Cecil McBee trademark for clothing and related accessories. *Id.* ¶ 11.

Under Japanese trademark law, there are two ways in which an individual may protect his or her name from unauthorized use by another: (i) a person may protect his full name, regardless of whether or not he is famous, and (ii) a person may protect an abbreviated name if the person has achieved widespread

fame in Japan under the abbreviated name. *Id.* ¶ 12. Any person related to a registered trademark may demand a procedure with the JPO to invalidate or nullify a trademark registration. *Id.* ¶ 13. In early 2002, the plaintiff sought nullification of the defendant’s trademark #4136718 through such proceedings. *Id.* In support of his claim before the JPO, the plaintiff alleged that because he was an “internationally famous jazz musician,” the defendant intentionally and maliciously registered a mark that is identical to his name. *Id.* ¶ 17. On February 19, 2002 the JPO nullified the defendant’s trademark #4136718, finding that the plaintiff’s full name was Cecil McBee and therefore granted protection of that name. *Id.* ¶ 18. The defendant appealed the decision of the JPO to the Tokyo High Court. *Id.* ¶ 20. On December 26, 2002 the Tokyo High Court vacated the JPO’s nullification of the defendant’s trademark #4136718, holding that the JPO had found incorrectly that the plaintiff’s full name was “Cecil McBee.” *Id.* ¶¶ 22-23. The plaintiff’s full name is “Cecil LeRoy McBee.” *Id.* ¶ 25. The plaintiff filed an appeal to the Japan Supreme Court of the Tokyo High Court decision. *Id.* ¶ 27. The Japan Supreme Court dismissed the appeal without oral argument on July 11, 2003. *Id.* ¶ 29.

On October 8, 2003 the JPO issued a final ruling invalidating its February 19, 2002 ruling which nullified the defendant’s trademark registration #4136718. Supplemental Statement of Material Facts in Support of Defendant’s motion for Summary Judgment Based on Res Judicata and Collateral Estoppel (“Supplemental Statement”) (Docket No. 96) ¶ 1; Plaintiff’s Opposition to Defendant’s Supplemental Statement of Material Facts, etc. (“Plaintiff’s Responsive Supplemental SMF”) (Docket No. 109) ¶ 1.⁵

⁵ The plaintiff filed a motion to strike the Fourth Declaration of Akio Otsuka (attached to the Supplemental Statement) on the grounds that it includes factual misstatements. Plaintiff’s Motion . . . to Strike the Fourth Declaration of Akio Otsuka (Docket No. 103) at 1-3. The defendant has adequately explained the circumstances giving rise to the misstatements in Otsuka’s affidavit, Defendant’s Objection to Plaintiffs [sic] Motion to Strike the Fourth Declaration of Akio Otsuka (Docket No. 129) at 3-4, and with the corrected record properly before the court, Plaintiff’s Additional Statement of Material Fact (“Plaintiff’s Supplemental SMF”) (included in Plaintiff’s Responsive Supplemental SMF beginning at p. 2) (*continued on next page*)

The second ruling by the JPO was appealed by the plaintiff to the Tokyo High Court on February 12, 2004. Plaintiff's Supplemental SMF ¶ 8; Defendant's Supplemental Reply SMF ¶ 8. The first hearing for the appeal before the Tokyo High Court was held on March 22, 2004 and a second hearing was scheduled for April 21, 2004. *Id.* ¶ 11.

The action filed by the plaintiff in Japan seeks only to invalidate the defendant's trademark registration #4136718. Plaintiff's Additional Statement of Material Fact in Opposition to Defendant's Amended Local Rule 56 Statement of Material Facts in Support of Defendant's Motion for Summary Judgment on Res Judicata and/or Collateral Estoppel ("Plaintiff's First SMF") (included in Plaintiff's First Responsive SMF, beginning at p. 5) ¶ 32; Defendant's Reply Statement of Material Facts in Support of Its Motion for Summary Judgment on Res Judicata and Collateral Estoppel (Docket No. 121) ¶ 32. It does not seek damages or other remedies from the defendant. *Id.*

The defendant does not use the plaintiff's likeness in its advertising or on its website, cecilmcbee.com, which it opened in April 2000. Local Rule 56 Statement of Material Facts in Support of Defendant's Motion for Summary Judgment on the Merits ("Defendant's Second SMF") (Docket No. 81) ¶¶ 5, 10; Plaintiff's Opposition to Defendant's Local Rule 56 Statement of Material Facts in Support of Motion for Summary Judgment on the Merits ("Plaintiff's Second Responsive SMF") (Docket No. 106) ¶¶ 5, 10. It aims its goods at young women. *Id.* ¶ 8. The plaintiff has toured Japan on numerous occasions. *Id.* ¶ 22. The plaintiff, whose use of his name in advertising is always connected with his jazz music, is not in competition with the defendant. *Id.* ¶¶ 18, 20. The plaintiff had no relationship whatsoever with the defendant prior to or at the time of the defendant's adoption of the trade name "Cecil McBee." *Id.* ¶ 29.

¶¶ 8-9; Defendant's Reply to Plaintiff's Opposition to Defendant's Supplemental Statement of Material Facts, etc. (continued on next page)

He did not authorize the defendant to use his name for any purpose. Plaintiff’s Additional Statement of Material Facts in Opposition to Defendant’s Motion for Summary Judgment on the Merits (“Plaintiff’s Second SMF”) (included in Plaintiff’s Second Responsive SMF, beginning at p. 7) ¶43; Local Rule 56(d) Reply Statement of Material Facts in Support of Defendant’s Motion for Summary Judgment on the Merits (“Defendant’s Second Responsive SMF”) (Docket No. 124) ¶ 43.

The cecilmcbee.com website uses both Japanese and English. *Id.* ¶44. The words “romantic” and “bohemian” appear in the web magazine on the web site. *Id.* ¶45. People whom the plaintiff knows have believed that he had some type of business relationship to the defendant’s stores. *Id.* ¶ 55. The defendant maintains as its logo the name Cecil McBee in a type face which is virtually identical to the type face from the plaintiff’s “Alternate Spaces” album published in 1979. *Id.* ¶ 100.

The plaintiff began touring as a jazz musician in Japan with Chico Freeman and later with Joanne Brackeen in 1983 to 1984. *Id.* ¶ 62. He has performed in the cities of Tokyo, Yokohama, Osaka, Sapporo, Kyoto, Kushrio, Ishikawajima and Okinawa, at the Mount Fuji Jazz Festivals and with noted Japanese pianist Yosuke Yamashita. *Id.*

Stanley Crouch, a noted jazz critic and author, is of the opinion that the plaintiff is regarded as probably one of the five best bass players in New York and New York means the world. *Id.* ¶ 73.

C. Discussion

1. First Summary Judgment Motion. The defendant contends that all of the plaintiff’s claims are barred by the doctrines of *res judicata* and collateral estoppel. First Summary Judgment Motion at 1. In the alternative, it seeks summary judgment “as to all sales of Cecil McBee goods made outside of the United

(“Defendant’s Supplemental Reply SMF”) (Docket No. 122) ¶¶ 8-9, there is no need to strike Otsuka’s Fourth Declaration (*continued on next page*)

States.” *Id.* The defendant’s argument is based on the litigation in Japan in which the plaintiff challenged the defendant’s registration of the Cecil McBee trademark. *Id.* at 4.

Under the federal law of res judicata, a final judgment on the merits of an action precludes the parties or their privies from relitigating claims that were raised or could have been raised in that action. . . .

This Court has articulated a three-part test to determine whether res judicata precludes litigation of a party’s claims. For a claim to be precluded, the following elements must be present: 1) a final judgment on the merits in an earlier suit; 2) sufficient identity between the causes of action asserted in the earlier and later suits; and 3) sufficient identity between the parties in the two suits.

Apparel Art Int’l, Inc. v. Amertex Enters. Ltd., 48 F.3d 576, 583 (1st Cir. 1995) (citations omitted).

There is no question here that the parties are the same in this litigation and in the litigation in Japan. The dispute focuses on the first two elements of the test.

With respect to the first element, the plaintiff contends that the litigation in Japan has not reached a final judgment, because his appeal of the second decision of the JPO is still pending. Plaintiff Cecil McBee’s Opposition to Defendant’s Motion for Summary Judgment on Res Judicata and Collateral Estoppel (“First Opposition”) (Docket No. 107) at 6-7. A judgment of the Japanese courts may provide the basis for issue or claim preclusion in this country’s federal courts. *E.g., Pony Express Records, Inc. v. Springsteen*, 163 F.Supp.2d 465, 471-73 (D.N.J. 2001). “[A] federal court judgment has res judicata effect as soon as it is issued notwithstanding the possibility or even pendency of an appeal.” *Washington v. State Street Bank & Trust Co.*, 14 Fed.Appx.12, 2001 WL 812315 (1st Cir. July 19, 2001), at *16, **2. No reason to treat a foreign judgment differently is apparent, or even suggested by the plaintiff, who chose to bring this action while the litigation in Japan was still pending. The first element is established.

and no reason to award the sanctions requested by the plaintiff. The motion to strike is denied.

With respect to the second element, a “cause of action . . . is a transaction that is identified by a common nucleus of operative facts.” *Apparel Art*, 48 F.3d at 583. “Only if the actions’ factual bases are the same will [the] claims be barred by res judicata.” *Id.* at 584. A trademark registration proceeding and a trademark infringement proceeding are not the same for purposes of claim preclusion. *Tonka Corp. v. Rose Art Indus., Inc.*, 836 F. Supp. 200, 213 (D.N.J. 1993). There does not seem to be any dispute in this case about the fact that the Japanese litigation concerns only the registration of the trademark. The defendant does not attempt to show that the plaintiff could have brought his claims for unfair competition, false endorsement or designation, invasion of privacy, violation of common-law right of publicity, trademark dilution, unjust enrichment and violation of Maine statutes, Complaint ¶¶ 20-45, in the proceeding before the JPO and the courts of Japan. The defendant’s assertion, unsupported by citation to authority, that “[s]uch claims . . . have no basis if the plaintiff has no right to exclusive use of the name ‘Cecil McBee’ in Japan,” Defendant’s Reply to Plaintiff’s Opposition to Defendant’s Motion for Summary Judgment on Res Judicata and Collateral Estoppel (Docket No. 120) at 2, is untenable under *Tonka*. *See also Jet, Inc. v. Sewage Aeration Sys.*, 223 F.3d 1360, 1363 (Fed. Cir. 2000). The plaintiff’s claims are more distinct from a dispute over registration of a trademark than is a claim for infringement of that trademark. This conclusion means that the defendant’s alternate argument, that the plaintiff’s claims must be limited to sales of the defendant’s products in the United States, must also fail.

To the extent that the defendant’s invocation of the doctrine of collateral estoppel, First Summary Judgment Motion at 9-13, may be differentiated from the preceding discussion of *res judicata*, it fares no better. It may well be, as the defendant asserts, *id.* at 10, that some of the facts found by the Japanese courts will also be at issue in this proceeding. However, it does not follow from that assertion that any one of the plaintiff’s claims in this action has been resolved in the litigation in Japan. “Collateral estoppel . . .

prevents relitigation of an issue which already has been litigated and decided in a previous case.” *Robinson v. Globe Newspaper Co.*, 26 F.Supp.2d 195, 199 (D. Me. 1998).

The federal doctrine of collateral estoppel precludes a party from relitigating an issue if:

- 1) the party had a “full and fair opportunity to litigate” the issue in an earlier action, and
- 2) the issue was finally decided in that action, and
- 3) the issue was decided against that party, and
- 4) determination of the issue was essential to the earlier judgment.

Id. (citation omitted). Here, none of the plaintiff’s claims, enumerated above, required determination in a proceeding concerning the defendant’s entitlement to register the plaintiff’s name as its trademark. The defendant, who bears the burden of proof on this question, has made no showing that the issues presented by the plaintiff’s claims, as opposed to some of the basic underlying facts, were actually decided, let alone litigated, in the proceedings in Japan. *See also Computer Assocs. Int’l, Inc. v. Altai, Inc.*, 126 F.3d 365, 371 (2d Cir. 1997) (issues in foreign litigation and domestic litigation not identical for purposes of collateral estoppel when legal standards governing their resolution are significantly different).

The defendant is not entitled to summary judgment on the basis of *res judicata* or collateral estoppel.

2. *Second Summary Judgment Motion.* The defendant brings its second summary judgment motion “on the merits,” raising arguments specific to each count in the plaintiff’s complaint. Evaluation of its contentions is made more difficult by the failure of its memorandum of law to identify the count or counts to which each of its arguments pertains.

a. Counts I, II and V

The defendant first argues that the plaintiff cannot demonstrate the likelihood of confusion necessary to support his claims of unfair competition, false designation and unfair business practices, an apparent

reference to Counts I, II and V.⁶ Second Summary Judgment Motion at 5-10. It begins, *id.* at 5, with the proposition that under section 43(a) of the Lanham Act (15 U.S.C. § 1125(a)), the section invoked in Counts I and II, Complaint ¶¶ 22, 27, “a plaintiff need only show that a likelihood of confusion is in prospect; a showing of actual confusion is not required,” *Société des Produits Nestlé, S.A. v. Casa Helvetia, Inc.*, 982 F.2d 633, 640 (1st Cir. 1992). That case, however, and all of the First Circuit case law cited by the defendant, involved two competing products. That is not the situation here. The defendant criticizes the plaintiff for “not even attempt[ing] to address the eight-prong test for likelihood of confusion used by the First Circuit,” Reply in Support of Defendant’s Motion for Summary Judgment on the Merits (“Summary Judgment Reply”) (Docket No. 123) at 3, set forth in *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 43 (1st Cir. 1998). That trademark infringement case involved two competing water faucets. *Id.* at 32. “[T]he scope of § 43(a) extends beyond disputes between producers of commercial products and their competitors. It also permits celebrities to vindicate property rights in their identities against allegedly misleading commercial use by others.” *Parks v. LaFace Records*, 329 F.3d 437, 445 (6th Cir. 2003). That is the nature of the plaintiff’s claims in this case. Complaint ¶¶ 1, 8-27, 36. He has cited case law involving similar claims, rather than accepting the defendant’s attempt to force his claims into the mold of

⁶ With respect to Count V of the complaint, which invokes only Maine law, Complaint ¶¶ 35-36, the defendant’s memorandum makes only a glancing reference to the relevant Maine statute, Second Summary Judgment Motion at 5-6. The only authority cited by the defendant in support of its mention of the state-law claim, *Town & Country Motors, Inc. v. Bill Dodge Auto. Group, Inc.*, 115 F.Supp.2d 31, 33 (D. Me. 2000), makes clear that claims under the state statute and the Lanham Act are subject to different legal standards. The defendant makes no attempt to show that case law discussing “confusion” under the Lanham Act is necessarily applicable as well to “confusion” under the state statute. The court will not make that leap of logic without some suggestion of a basis for doing so. The defendant accordingly is not entitled to summary judgment on Count V on the showing made. Even if the defendant’s necessarily-implied premise — that the proof of confusion required on the plaintiff’s Lanham Act claims is also required on his state-law claim set forth in Count V — were shown to be valid, my analysis of that issue with respect to the Lanham Act claims would mean that the defendant’s motion for summary judgment on Count V on that basis would fail as well.

competing-products case law. The fact that the First Circuit apparently has not addressed claims like those asserted by the plaintiff makes resort to case law from other circuits necessary.

In order to prevail on a false advertising claim under § 43(a), a celebrity must show that use of his or her name is likely to cause confusion among consumers as to the affiliation, connection, or association between the celebrity and the defendant's goods or services or as to the celebrity's participation in the origin, sponsorship, or approval of the defendant's goods or services. Consumer confusion occurs when consumers believe that the products or services offered by the parties are affiliated in some way.

Parks, 329 F.3d at 445-46 (citations and internal punctuation omitted). Thus, contrary to the defendant's assertion, Second Summary Judgment Motion at 10, the critical question in this case is not whether there is sufficient similarity between the defendant's products and the plaintiff's records to cause consumer confusion, as was the case in *Hasbro, Inc. v. Clue Computing, Inc.*, 232 F.3d 1, 2 (1st Cir. 2000). The appropriate test for likelihood of confusion when an avowed celebrity⁷ brings an action under section 43(a) is more likely to be that set forth by the Sixth Circuit in *Parks* or that applied by the Ninth Circuit in *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1007-08 (9th Cir. 2001). Because the *Parks* court's analysis is closely intertwined with an asserted First Amendment defense, 329 F.3d at 447-59, a factor not present in the instant case, I find the approach of the *Downing* court to be more helpful here.

The factors in the Ninth Circuit test are:

1. the level of recognition that the plaintiff has among the segment of the society for whom the defendant's product is intended;
2. the relatedness of the fame or success of the plaintiff to the defendant's product;
3. the similarity of the likeness used by the defendant to the actual plaintiff;
4. evidence of actual confusion;
5. marketing channels used;

⁷ The defendant does not appear to contend that the plaintiff is not a celebrity for purposes of his claims under the Lanham Act. Summary Judgment Reply at 3 n.2.

6. likely degree of purchaser care;
7. defendant's intent on selecting the plaintiff; and
8. likelihood of expansion of the product lines.⁸

Downing, 265 F.3d at 1007-08. The Ninth Circuit also notes that the factors are not necessarily all of equal importance and that all of the factors do not necessarily apply to every case. *Id.* at 1008. “[S]ummary judgment is inappropriate when a jury could reasonably conclude that there is a likelihood of confusion.” *Id.*

The plaintiff focuses on the seventh and eight factors. Opposition to Defendant's Motion for Summary Judgment on the Merits (“Second Opposition”) (Docket No. 105) at 12-13. The only evidence in the summary judgment record on the eighth factor favors the plaintiff. Plaintiff's Second SMF ¶¶ 38-39; Defendant's Second Responsive SMF ¶¶ 38-39. The evidence on the seventh factor is disputed. The plaintiff contends that the mere fact that the defendant chose his name is sufficient evidence of intent. Second Opposition at 12. The case law that he cites does not support so sweeping a proposition. However, he has also submitted evidence that would allow a reasonable factfinder to conclude that the defendant intentionally adopted his name, *e.g.*, Plaintiff's Second SMF ¶¶ 46-47, 101;⁹ Defendant's Second Responsive SMF ¶¶ 46-47, 101, Defendant's First SMF ¶¶ 9-10; Plaintiff's First Responsive SMF ¶¶ 6, 9-10, if the defendant's contrary evidence, Defendant's First SMF ¶¶ 6-7; Plaintiff's First Responsive SMF

⁸ Contrary to the defendant's assumption, Summary Judgment Reply at 3 n.2, it is the likelihood of expansion of the defendant's product line, not of the plaintiff's “product line,” that is the subject of this factor, *Downing*, 265 F.3d at 1008-09. The defendant also misunderstands the reference to marketing channels in the *Downing* test. The question is not whether the marketing channels used by the plaintiff and the defendant are different, Summary Judgment Reply at 3 n.2, but rather in what marketing channel or channels the likelihood of confusion arises, 265 F.3d at 1008. In this case, the relevant marketing channels include the internet. Plaintiff's Second SMF ¶ 41; Defendant's Second Responsive SMF ¶ 41.

⁹ The defendant objects to this paragraph of the plaintiff's statement of material facts claiming that the statement is based on testimony that is “mere speculation, so inadmissible.” Defendant's Second Responsive SMF ¶ 101. However, the plaintiff's deposition testimony that is cited in support of this paragraph of his statement of material facts does provide sufficient basis for his conclusion to take it out of the realm of speculation. Deposition of Cecil L. McBee (Exh. 1 to *continued on next page*)

¶¶ 6-7, Defendant’s Second SMF ¶¶ 9, 13-14; Plaintiff’s Second SMF ¶¶ 9, 13-14, were rejected. *See also Stern’s Miracle-Gro Prods., Inc. v. Shark Prods., Inc.*, 823 F. Supp. 1077, 1088 (S.D.N.Y. 1993) (fact that defendant continued to use name after plaintiff objected evidence of intent); *see* Defendant’s First SMF ¶¶ 7, 10; Plaintiff’s First Responsive SMF ¶¶ 7, 10; Plaintiff’s Second SMF ¶ 106; Defendant’s Second Responsive SMF ¶ 106.

With respect to the third factor, the defendant asserts that “there is no reference to jazz music and no picture of plaintiff used by Delica in any way” and that “the only similarity between plaintiff and defendant’s mark is the identity of the name (which plaintiff shares with many others).” Summary Judgment Reply at 3 n.2. The first assertion attempts to put too fine a point on the third factor. Similarity of likeness is to be considered; identity (or a photograph) is not required. *Downing*, 265 F.3d at 1008. The second assertion misstates the evidence. There is evidence, albeit disputed, that the roman typeface used for the name “Cecil McBee” by the defendant is very similar to the typeface in which that name appears on the cover of a 1984 record album released by the plaintiff. Defendant’s Second SMF ¶ 21; Plaintiff’s Second Responsive SMF ¶ 21, Plaintiff’s Second SMF ¶¶ 50, 54, 101;¹⁰ Defendant’s Second Responsive SMF ¶¶ 50, 54, 101. Accordingly, the third factor may not be used to support summary judgment for the defendant.

Defendant’s First SMF) at 18-20. The objection is overruled. The weight to be given to such testimony is, of course, not a matter to be resolved in the context of a motion for summary judgment.

¹⁰ My reliance on this material from the plaintiff’s statement of material facts requires that I rule on the defendant’s motion to exclude the testimony of George Hughes, which provides the record support for these paragraphs. The defendant contends that Hughes’ proposed testimony is irrelevant and lacks sufficient foundation. Defendant’s Motion in Limine to Exclude Expert Testimony of George Hughes (Docket No. 93) at 5-6. The testimony cited above which provides the basis for the cited paragraphs of the plaintiff’s statement of material facts is clearly relevant to the is sued before the court. Determination of the question whether other opinions to be offered by Hughes are relevant must await trial. Similarly, the assertion that Hughes “simply lacks any relevant information about marketing in Japan,” *id.* at 6, the only reason proffered by the defendant to support its contention that Hughes’ testimony lacks sufficient foundation, has no bearing on the opinions expressed in the cited paragraphs of the plaintiff’s statement of material facts. The motion to exclude (*continued on next page*)

With respect to the fourth factor, the defendant contends that there is no evidence of “actual confusion.” Summary Judgment Reply at 2-3. In this regard, it bears repeating that the factors are used to assess evidence of the likelihood of confusion; actual confusion is not required. In any event, the plaintiff has provided some evidence of actual confusion. Plaintiff’s Second SMF ¶¶ 86, 88, 97-99. The defendant contends that these paragraphs are not evidence of actual confusion because the people involved only “had questions in [their] mind[s]” or were only asking the plaintiff about any connection between him and the defendant’s products. Defendant’s Second Responsive SMF ¶¶ 86, 88, 97-99. However, merely to ask about such a connection demonstrates the possibility of confusion. The defendant’s argument goes to the weight of such evidence, which has been accepted as sufficient in other cases. *E.g., Wendt v. Host Int’l, Inc.*, 125 F.3d 806, 813 (9th Cir. 1997) (plaintiffs approached by individuals who commented on similarity between plaintiffs and products at issue); *Boston Athletic Ass’n v. Sullivan*, 867 F.2d 22, 31 (1st Cir. 1989) (shopper expressed surprise that shirt was not plaintiff’s “official” shirt); *Fleischmann Distilling Corp. v. Maier Brewing Co.*, 314 F.2d 149,158 (9th Cir. 1963) (plaintiff’s vice-president asked twice “When did you people start making beer?”). It is sufficient for purposes of summary judgment here.

In discussing the sixth factor, the defendant asserts that “[t]here is a high degree of purchaser care” because the plaintiff’s Japanese fans are “very sophisticated and very aware of his career.” Summary Judgment Reply at 3 n.2. However, this does not necessarily mean that the potential purchasers of the defendant’s Cecil McBee merchandise, who are the purchasers at issue with respect to this factor, are likely to know that he is not associated with those products. “A jury could reasonably find that young consumers

Hughes’ testimony is denied. Of course, this does not mean that the defendant may not object to specific portions of Hughes’ testimony when and if it is offered at trial.

are not likely to be particularly careful [about potential endorsements] when purchasing . . . clothing.” *Downing*, 265 F.3d at 1008. This factor thus weighs in the plaintiff’s favor.¹¹

Remaining for consideration are the first and second factors. There is little evidence in the summary judgment record concerning the level of recognition of the plaintiff among the young women for whom the defendant’s Cecil McBee products are intended, Defendant’s Second SMF ¶ 8; Plaintiff’s Second Responsive SMF ¶ 8. I doubt that a level of such recognition may fairly be inferred from evidence concerning the general level of public recognition of the plaintiff in Japan, particularly given the fact that the evidence of his touring in Japan is limited to the 1980s and 1990s. The evidence of the “relatedness” of the plaintiff’s fame or success to the defendant’s products is quite slim; the plaintiff does not mention any evidence on this point in its memorandum but includes one paragraph in his second statement of material facts that might reasonably be construed to relate to this factor. Plaintiff’s Second SMF ¶ 45. The connection between the plaintiff and the use of the words “romantic” and “bohemian” in the defendant’s advertising seems tenuous at best. I conclude that the first and second factors favor the defendant’s position, on the showing made.

When the majority of the *Downing* factors weigh in the plaintiff’s favor, as they do here, summary judgment is not appropriate. *Wendt*, 125 F.3d at 812.

b. Counts VIII and IX.

Count VIII alleges violation of 15 U.S.C. § 1125(c). Complaint ¶ 40. Count IX alleges violation of 10 M.R.S.A. § 1510. *Id.* ¶ 45. The complaint refers to both statutes as anti-dilution statutes. The defendant first contends that it is entitled to summary judgment on Count IX because the state statute it

¹¹ Because I do not rely on any of the evidence presented by the defendant based on the affidavit of Todd Holbrook, (continued on next page)

invokes was repealed “more than 20 years” ago. Second Summary Judgment Motion at 11. However, anyone looking for 10 M.R.S.A. § 1510 in the Maine Revised Statutes Annotated would immediately learn that it was repealed and replaced by 10 M.R.S.A. § 1532. 10 M.R.S.A. Chapter 301; Disposition Table. This in turn would lead the reader to 10 M.R.S.A. § 1530, which clearly provides the basis for the plaintiff’s claim. This oversight by plaintiff’s counsel, while certainly not to be condoned, does not provide a reason for the entry of summary judgment.

A more serious problem with both counts, not raised by the defendant, is that each statute provides only for injunctive relief. 15 U.S.C. § 1125(c); 10 M.R.S.A. § 1530. I have already recommended that the court grant the defendant’s motion to dismiss with respect to any demands for injunctive relief under the Lanham Act; that conclusion means that Count VIII is no longer before the court. The court must address this question with respect to the state statute *sua sponte* because it concerns the court’s subject-matter jurisdiction. *In re Recticel Foam Corp.*, 859 F.2d 1000, 1002 (1st Cir. 1988). A federal court lacks jurisdiction to impose injunctive relief concerning activities in a foreign country under a state statute. *See Cotto Waxo Co. v. Williams*, 46 F.3d 790, 793 (8th Cir. 1995) (Commerce Clause of Constitution precludes application of state statute to commerce that takes place wholly outside of state’s borders).

To the extent that Count IX may reasonably be interpreted to seek injunctive relief barring the defendant’s diluting actions within the state of Maine, the defendant does not respond to the plaintiff’s argument. Second Opposition at 16-18. This court has interpreted the state statute to include forms of trademark dilution based on confusion, “which is controlled by the federal trademark infringement analysis,” effect on goodwill and reputation and diminution in the uniqueness and individuality of the plaintiff’s

which evidence relates to the third, fourth and sixth *Downing* factors, Affidavit of Todd Holbrook (Docket No. 82), the
(continued on next page)

trademark. *Best Flavors, Inc. v. Mystic River Brewing Co.*, 886 F. Supp. 908, 918 (D. Me. 1995). My consideration of the evidence of confusion with respect to Counts I and II therefore applies to this count as well. The defendant is not entitled to summary judgment on that portion of Count IX that addresses dilution of his “trademark” within the state of Maine.

c. Counts III and IV

Count III alleges invasion of privacy and Count IV alleges violation of the right of publicity, Complaint ¶¶ 28-34, both common-law claims. The defendant contends that it is entitled to summary judgment on these counts because the plaintiff cannot show that the defendant’s use of his name is perceived as referring to him. Second Summary Judgment Motion at 14-15.¹²

Under Maine law, a claim of invasion of privacy based on commercial appropriation requires proof that a name or likeness has been used for purposes of taking advantage of that individual’s reputation, prestige or other value for purposes of publicity. *Dempsey v. National Enquirer*, 702 F. Supp. 927, 934 (D. Me. 1988). This definition does not require that anyone perceived the use of the plaintiff’s name as referring to him; it does require proof that the use of his name was for the purpose of taking advantage of his reputation or prestige. The plaintiff has submitted evidence, albeit disputed, that would allow a reasonable factfinder to conclude that the defendant adopted the name Cecil McBee to take advantage of the plaintiff’s reputation or prestige in Japan — primarily concerning the plaintiff’s tours and record sales in Japan around

plaintiff’s motion to strike that affidavit (Docket No. 102) is moot.

¹² The defendant begins, Second Summary Judgment Motion at 14, with the Fourth Circuit’s definition of a claim for false light invasion of privacy under Maryland law, *Campbell v. Lyon*, 26 Fed.Appx. 183, 188 (4th Cir. 2001). The complaint cannot reasonably be read to allege this type of invasion of privacy claim. As the plaintiff points out, Second Opposition at 6, he has alleged invasion of privacy based on commercial appropriation under Maine law, a tort which is defined in a decision of this court.

the time when the defendant began using the name. The defendant's arguments address the weight to be given this evidence, Summary Judgment Reply at 6-7, which does not enter into the summary judgment analysis.

With respect to the claim based on the right of publicity, the parties apparently assume that such a claim would be recognized in Maine. My research has located no reported reference to such a claim in the opinions of the Maine Law Court.

A right of publicity claim is similar to a false advertising claim in that it grants a celebrity the right to protect an economic interest in his or her name. However, a right of publicity claim does differ from a false advertising claim in one crucial respect; a right of publicity claim does not require any evidence that a consumer is likely to be confused. All that a plaintiff must prove in a right of publicity action is that she has a pecuniary interest in her identity, and that her identity has been commercially exploited by a defendant.

Parks, 329 F.3d at 460 (citations omitted). Again, the claim as so defined does not require proof that anyone perceived the defendant's use of the name to refer to the plaintiff; it does require proof that the plaintiff's identity has been commercially exploited by the defendant. When the test is correctly framed, it is apparent that the plaintiff has submitted enough evidence to reach a jury on this claim, for the reasons already stated in connection with the invasion-of-privacy claim. The defendant is not entitled to summary judgment on Counts III and IV on the showing made.

d. Count VII

The remaining count of the complaint alleges unjust enrichment, a state common-law claim.

Complaint ¶¶ 37-38. Under Maine law,

[t]o sustain a claim for unjust enrichment, a claimant must establish that it conferred a benefit on the other party[,] that the other party had appreciation or knowledge of the benefit and that the acceptance or retention of the benefit was under such circumstances as to make it inequitable for it to retain the benefit without payment of its value.

Forrest Assocs. v. Passamaquoddy Tribe, 760 A.2d 1041, 1045-46 (Me. 2000) (citation and internal punctuation omitted). The defendant contends that the plaintiff undertook no action that conferred a benefit on the defendant, Summary Judgment Reply at 7, and that it is therefore entitled to summary judgment. The plaintiff's response misses the import of this argument, asserting merely that the defendant "ha[d] knowledge of Plaintiff and his name, but intentionally appropriated it," thereby deriving value. Second Opposition at 18. I agree that this tort requires some action by the plaintiff that confers a benefit on the defendant. The defendant's appropriation of property of the plaintiff for purposes of financial gain does not fit within the definition of the tort. The tort is discussed by the Maine Law Court as providing a means of recovery in the absence of a contract. *Forrest Assocs.*, 760 A.2d at 1046. That concern suggests the existence of some relationship or contact between the parties, although there has been no explicit or implied meeting of the minds. In this case, there was no relationship or contact between the parties before the defendant began using the plaintiff's name. Defendant's Second SMF ¶ 29; Plaintiff's Second Responsive SMF ¶ 29. The defendant is entitled to summary judgment on Count VII.

III. Conclusion

For the foregoing reasons, (i) the Motion to Strike Defendant's Local Rule 56 Statement of Material Facts in Support of Defendant's Motion for Summary Judgment on Subject Matter Jurisdiction (Docket No. 104) is **GRANTED**; (ii) the Plaintiff's Motion . . . to Strike the Fourth Declaration of Akio Otsuka (Docket No. 103) is **DENIED**; (iii) the Defendant's Motion in Limine to Exclude Expert Testimony of George Hughes (Docket No. 93) is **DENIED** for purposes of the motions for summary judgment only; and (iv) the Motion . . . to Strike Affidavit of Todd Holbrook (Docket No. 102) is determined to be **MOOT**. In addition, I recommend that (i) the Defendant's Motion to Dismiss for Lack of Subject-Matter

Jurisdiction (Docket No. 73) be **GRANTED** as to all claims for injunctive relief under the Lanham Act, and otherwise **DENIED**; (ii) the Defendant's Motion for Summary Judgment on Res Judicata and Collateral Estoppel (Docket No. 78) be **DENIED**; and (iii) the Defendant's Motion for Summary Judgment on the Merits be **GRANTED** as to Count VII and that portion of Count IX that seeks relief for trademark dilution outside the state of Maine and otherwise **DENIED**.

NOTICE

A party may file objections to those specified portions of a magistrate judge's report or proposed findings or recommended decisions entered pursuant to 28 U.S.C. § 636(b)(1)(B) for which de novo review by the district court is sought, together with a supporting memorandum, within ten (10) days after being served with a copy thereof. A responsive memorandum shall be filed within ten (10) days after the filing of the objection.

Failure to file a timely objection shall constitute a waiver of the right to de novo review by the district court and to appeal the district court's order.

Dated this 19th day of August, 2004.

David M. Cohen
United States Magistrate Judge

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