UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF MISSISSIPPI
JACKSON DIVISION

STEPHEN MONTALTO PLAINTIFF

VS. CIVIL ACTION NO. 3:06CV444TSL-JCS

VIACOM INTERNATIONAL, INC. DEFENDANT

MEMORANDUM OPINION AND ORDER

This cause is before the court on the motion of defendant Viacom International, Inc. (Viacom) for summary judgment pursuant to Rule 56 of the Federal Rules of Civil Procedure. Plaintiff has not responded to this motion, and the time for doing so has now passed. Having considered the memorandum of authorities, together with attachments, submitted by defendant, the court concludes that the motion is well taken and should be granted.

In his complaint, plaintiff alleges that he is engaged in the music industry as a musical artist, disc jockey and general entertainer; that he has used the name "Joe Shmo" as his entertainment name and has used the "Joe Shmo" mark since 2001 on compact disc covers and party flyers; that he applied to the United States Trademark Office for registration of the "Joe Shmo" mark and that the mark was registered to him on March 8, 2005 for "music compact discs"; and that in and before 2003, defendant unlawfully, willfully and maliciously used the "Joe Schmo" mark in broadcasting on its cable network SpikeTV of a television show

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called "The Joe Schmo Show," and thereby infringed plaintiff's mark and caused economic detriment to plaintiff. On these allegations, plaintiff has asserted federal claims for trademark infringement and unfair competition, and state law claims for unfair competition, tortious interference with business advantage and negligent misrepresentation.

In its motion for summary judgment, Viacom argues that plaintiff's federal claim for trademark infringement and for unfair competition should be dismissed because plaintiff cannot show a likelihood of confusion between his use of the "Joe Shmo" mark for music compact discs and Viacom's airing of "the Joe Schmo Show," which it describes as a reality television program with a storyline as a parody of reality television game shows.[1] "To prove trademark infringement and unfair competition under federal law, [plaintiff] must show that the use of the ["Joe Schmo"] mark by [defendant] is likely to cause confusion among consumers as to the source, affiliation, or sponsorship of [defendant's] products or services." Scott Fetzer Co. v. House of Vacuums Inc., 381 F.3d

[1] As explained in the affidavit of Chris Linn, Viacom's Senior Vice President of Series Development and Programming,

> The program's concept was that the central character, referred to as "Joe Schmo," believed he was one of nine contestants on a reality television show called "Lap of Luxury." Unbeknownst to the main character, everyone else on the program was an actor and the program itself was all an elaborate hoax designed to elicit comedic reactions."

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477, 483 (5th Cir. 2004). "A 'likelihood of confusion' means that confusion is not just possible, but probable." Id.

> In assessing whether use of a mark creates a likelihood of confusion as to affiliation or endorsement, we consider the "digits of confusion," a list of factors that tend to prove or to disprove that consumer confusion is likely. Those factors are: (1) the type of mark allegedly infringed; (2) the similarity between the two marks; (3) the similarity of the products or services; (4) the identity of retail outlets and purchasers; (5) the identity of the advertising media used; (6) the defendant's intent; and (7) any evidence of actual confusion.

Id.at 484-85 (quoting Westchester Media v. PRL USA Holdings, Inc., 214 F.3d 658, 664 (5th Cir. 2000)).

"The first digit, that is, the type of trademark allegedly infringed, questions whether the trademark is so distinctive that a consumer encountering the defendant's mark would be likely to assume that the source of a product or service is the owner of the trademark." Lyons Partnership v. Giannoulas, 179 F.3d 384, 389 (5th Cir. 1999). Thus, the "type" of trademark refers to the strength of the senior user's mark; "[t]he stronger the mark, the greater the protection it receives because the greater the likelihood that consumers will confuse the junior user's use with that of the senior user." Elvis Presley Enterprises, Inc. v. Capece, 141 F.3d 188, 201 (5th Cir. 1998) (citations omitted) see also Amstar Corp. v. Domino's Pizza, Inc., 615 F.2d 252, 259 (5th Cir. 1980) ("strong marks are widely protected, as contrasted to weak marks") (quoting Lunsford, Julius R., Jr., "Trademark

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Basics," 59 Trademark Rep. 873, 878 (1969)); Lyons P'ship, 179 F.3d at 389 ("the stronger the trademark, the more likely that this factor would weigh in favor of the plaintiff").

Here, there is no evidence that plaintiff's mark is distinctive or well known, even in plaintiff's own field of music performance. As defendant notes, plaintiff has offered no evidence that the public has been educated to recognize and accept his "Joe Shmo" mark as a hallmark of the source of his product, which lends support to a conclusion that the mark is weak. Cf. Louisiana World Exposition, Inc. v. Logue, 746 F.2d 1033, 1040 (5th Cir. 1984) (extensive promotion supports finding of strong mark). Moreover, defendant has presented evidence of numerous third-party uses of similar marks by musicians and music groups, including "Joe Schmoe," "Joe and the Schmos," and "Joe Schmo: Music for the Living." Third-party usage weakens a mark and limits the protection to be accorded plaintiff's mark. See Amstar Corp., 615 F.2d at 260. This is particularly true where the mark is used outside the field in which it is used by the plaintiff. See id.; see also Scott Paper Co. v. Scott's Liquid Gold, Inc., 598 F.2d 1225, 1331 (3d Cir. 1978) (plaintiff's ownership of the mark "Scott" as applied to paper products did not preclude defendant's use of "Scott" on furniture polish) (cited in Amstar Corp.).

The second factor, the similarity between the two marks, takes into account the similarity of appearance, sound and

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meaning, that is, their "overall impression," not in a vacuum, but rather in the "the context that a customer perceives them in the marketplace. . . ." Scott Fetzer Co., 381 F.3d at 485. See also CICCorp., Inc. v. AIMTech Corp., 32 F. Supp. 2d 425, 436 (S.D. Tex. 1998) ("The court must consider the overall commercial impression of the marks, as well as the setting in which they appear."); Restatement (Third) of Unfair Competition § 21(a)(i) (1995) (stating that "the overall impression created by the [marks] as they are used in marketing the respective goods and services" is relevant to how similar two marks are) (cited in Elvis Presley Enterprises, Inc., 141 F.3d at 197). "In the final analysis this digit turns on whether, under the circumstances in which they are used, the marks are similar enough that customers are likely to conclude that [plaintiff] and [defendant] are associated." CICCorp., Inc., 32 F. Supp. 2d at 436. Defendant submits that even though "Joe Shmo" and "The Joe Schmoe Show" may be phonetically similar (though certainly not identical), they are easy for the public to distinguish in context and as used in connection with totally different goods and services, i.e., in their presentation. This is clearly the case.

The third factor does not support plaintiff's claim of infringement inasmuch as there is no similarity in his and defendant's products; "The Joe Schmo Show" was a television series

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