

BAJA INTERNATIONAL, LTD., Plaintiff, v. JOHN KIA; BAJA-V, INC.; ASSODALLAH PARANGI; YODI PARANGI; JOHN NAIMI; and SHANGRI-LA, INC.; Defendants.

No. 5:96-CV-149-BO

UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF NORTH CAROLINA, WESTERN DIVISION

1996 U.S. Dist. LEXIS 3279 (EDNC 1996)

**March 5, 1996, Decided
March 7, 1996, FILED**

DISPOSITION: [*1] GRANTED.

OVERVIEW: The court granted the preliminary injunction in the trademark dispute, and held that 1) the fact that the word "Baja" is used as a geographic term for an area in the United States would probably not prevent it from being registered as a trade or service mark in connection with a particular type of goods or services, 2) using the word "Baja" in connection with the protected goods and services would probably constitute an infringement of operator's marks, regardless of the whole name the infringers gave to such goods or services, 3) the use of a different lettering style in displaying the word was irrelevant, 4) the fact that several other businesses in the country used the word "Baja" in their names was irrelevant based on the operator's representation that none of those businesses operate protected nightclubs that might be deemed infringing, and 5) the infringer's could not name a single room in their nightclub in an infringing fashion.

OUTCOME: The court granted the operator's motion for a preliminary injunction and ordered the infringers not to use the words "Baja" or "Baha" in connection with restaurant, nightclub, or other similar entertainment ventures and to refrain from infringing upon the operator's registered trademarks in any other manner.

COUNSEL:

For BAJA INTERNATIONAL, LTD., plaintiff: David Dreifus, [COR LD NTC], Poyner & Spruill, Raleigh, NC.

For JOHN KIA, BAJA-FIVE, INC., defendants: William Hollister Potter, Jr., [COR LD NTC], Parker, Sink, Powers, Sink & Potter, Raleigh, NC.

JUDGES: TERRENCE W. BOYLE, UNITED STATES DISTRICT JUDGE

OPINIONBY: TERRENCE W. BOYLE

OPINION:

ORDER

This matter comes before the Court on plaintiff's motion for preliminary injunction.

The facts of this case and the legal analysis thereof are fully set forth in this Court's previous order of February 22, 1996, granting plaintiff's request for a temporary restraining order. On February 28, 1996, plaintiff filed an amended complaint, naming additional parties allegedly responsible for and in control of activity which infringes upon plaintiff's registered service marks. Defendants have apparently opened their business to the public since the granting of the temporary restraining order without using the word "Baja."

A hearing was held before the undersigned on March 4, 1996, at Elizabeth City, North Carolina. Defendant John Naimi, appearing pro se, contested the preliminary injunction on four grounds. First, it was asserted that the word "Baja" is in the public domain and may therefore not be granted trademark protection. Second, defendants' use of the word "Baja" in their nightclub was distinguished from plaintiff's registration of "Baja Beach Club" for nightclub and restaurant services, [*2] as defendants do not use the entire phrase, "Baja Beach Club," but rather wish to name their nightclub "Baja-Five." Third, Mr. Naimi asserted that defendants' display of the word "Baja" is in a font or type-set different from the cursive script employed by plaintiff in the display of its service mark. Finally, Mr. Naimi attacked the registered trade and service marks on the grounds that several businesses throughout the United States employ the word "Baja" in their names.

None of these arguments influence the Court's analysis of this case described in the February 22 order. That "Baja"'s use in the English language refers to a geographical feature, namely the large south-west North American peninsula between the Gulf of California and the Pacific Ocean, would probably not prevent it from being registered as a trade or service mark in connection with a particular type of goods or services. Any use of the word "Baja" in connection with the protected goods and services would probably be sufficient to constitute an infringement of the "Baja Beach Club" marks, regardless of the whole name defendants wish to ascribe to such goods or services. The lettering style of the word's display is [*3] irrelevant so long as the infringing word is used. With regard to other usages of the word "Baja," plaintiff has represented to the Court that unlike the defendants, none of those businesses operate protected nightclub-restaurants that might be deemed infringing.

Finally, the Court must address the suggestion raised at the hearing that defendants be allowed to operate a room within their nightclub known as the "Baja Room." Such conduct is encompassed by the terms of the temporary restraining order and the terms of the preliminary injunction issued below. The marks owned by plaintiff do not permit any unlicensed use of the word "Baja" upon the premises of an enterprise offering the protected goods or services. Just as the word "Baja" cannot appear in defendants' advertising for their nightclub, or upon their nightclub's marquee, so too are defendants prohibited from naming a portion of their nightclub in an infringing fashion.

* * *

For the reasons given in this Court's order of February 22, 1996, granting a temporary restraining order, the Court now GRANTS plaintiff's motion for a preliminary injunction. Pending final disposition of this case, defendants are hereby ORDERED [*4] to refrain from operating a nightclub known as "Baha-Five, the Button South of North Carolina," or employing

the words "Baja" or "Baha" in its name. Defendants are further ORDERED to refrain from any public use or display of the words "Baja" or "Baha" in connection with restaurant, nightclub, or other similar entertainment ventures, and are further ORDERED to refrain from infringing upon plaintiff's registered trademarks in any other manner.

SO ORDERED.

This 5th day of March, 1996.

TERRENCE W. BOYLE

UNITED STATES DISTRICT JUDGE