

NOT FOR PUBLICATION

FILED

UNITED STATES COURT OF APPEALS

FEB 18 2022

FOR THE NINTH CIRCUIT

MOLLY C. DWYER, CLERK
U.S. COURT OF APPEALS

NEO4J, INC.; NEO4J SWEDEN AB,

No. 21-16029

Plaintiffs-counter-
defendants-Appellees,

D.C. No. 5:18-cv-07182-EJD

v.

MEMORANDUM*

PURETHINK, LLC; IGOV, INC.; JOHN
MARK SUHY,

Defendants-counter-
claimants-Appellants.

Appeal from the United States District Court
for the Northern District of California
Edward J. Davila, District Judge, Presiding

Argued and Submitted February 7, 2022
San Francisco, California

Before: HURWITZ and VANDYKE, Circuit Judges, and ERICKSEN,** District
Judge.

Neo4j, Inc. (“Neo4j USA”) sued John Mark Suhy and three corporations,
PureThink, LLC, iGov, Inc., and Graph Foundation, Inc. (collectively,

* This disposition is not appropriate for publication and is not precedent
except as provided by Ninth Circuit Rule 36-3.

** The Honorable Joan N. Ericksen, United States District Judge for the
District of Minnesota, sitting by designation.

“Defendants”), asserting claims under the Lanham Act, 15 U.S.C. §§ 1114, 1125(a), and California law. The district court entered a preliminary injunction enjoining Defendants from infringing the registered NEO4J mark¹ and from making misrepresentations to consumers about their products. Reviewing for abuse of discretion, *see Dev’l Servs. Network v. Douglas*, 666 F.3d 540, 544 (9th Cir. 2011), we affirm.

1. Because Neo4j USA registered the NEO4J mark, U.S. Trademark Registration No. 4,784,280, the district court correctly held it has standing to sue for infringement. *See* 15 U.S.C. § 1114(1) (infringers “shall be liable in a civil action by the registrant”); *Halicki Films, LLC v. Sanderson Sales & Mktg.*, 547 F.3d 1214, 1226–28 (9th Cir. 2008).

2. The court did not abuse its discretion by enjoining Defendants from infringing the NEO4J mark in the names of their own products. Defendants’ use of the NEO4J mark was not nominative fair use, as it referred to their competing products, “Neo4j Enterprise” and “Government Package for Neo4j,” not Neo4j® Enterprise Edition. *See Toyota Motor Sales, USA, Inc. v. Tabari*, 610 F.3d 1171, 1183 (9th Cir. 2010) (holding that nominative use of a trademark requires that the mark “refer to the trademarked good” not the defendant’s good); *New Kids on the*

¹ We use the term “NEO4J” to refer to the word mark registered by Neo4j USA. We use the term “Neo4j®” to denote the Neo4j USA-licensed platforms, Neo4j® Community Edition and Neo4j® Enterprise Edition.

Block v. News Am. Publ'g, Inc., 971 F.2d 302, 308 (9th Cir. 1992).

3. Nor did the court abuse its discretion by enjoining Defendants from “[a]dvertising, promoting, representing or referring to ONgDB as a free and open source drop-in replacement of Neo4j Enterprise Edition,” and making other false representations about ONgDB to consumers. Lanham Act falsity is established either if a “statement was literally false, either on its face or by necessary implication,” or if a “statement was literally true but likely to mislead or confuse consumers.” *Southland Sod Farms v. Stover Seed Co.*, 108 F.3d 1134, 1139 (9th Cir. 1997). Defendants’ representation that ONgDB is a “free and open-source” version of Neo4j® EE was literally false, because Section 7 of the Sweden Software License only permits a downstream licensee to remove “further restrictions” added by an upstream licensee to the original work. Defendants’ advertisements of ONgDB as a “drop-in replacement” for Neo4j® EE were also false, even taking Defendants’ own definition of the term—“compatibility.” And, even if the “drop-in replacement” representations were not literally false, substantial evidence showed that consumers were confused by Defendants’ use of the term.

4. The district court did not abuse its discretion by enjoining Defendants from suggesting Neo4j USA endorsement of their products. Defendants argue that two of the eight factors identified in *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979)—the “type of goods and the degree of care likely to be

exercised by the purchaser” and “evidence of actual confusion”—weigh in their favor. But the “presence or absence of a particular factor does not necessarily drive the determination of a likelihood of confusion.” *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1290–91 (9th Cir. 1992). A particularly strong showing of some factors will suffice to demonstrate confusion. *See Pom Wonderful LLC v. Hubbard*, 775 F.3d 1118, 1125 (9th Cir. 2014). It was not an abuse of discretion for the district court to rely on the other six *Sleekcraft* factors in entering the preliminary injunction.

AFFIRMED.