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A REVIEW OF RECENT TRADEMARK AND UNFAIR COMPETITION CASES IN THE U.S. *

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I. Creation and Maintenance of Trademark Rights

A. Adoption and Use

In *T.A.B. Systems v. PacTel Teletrac*,¹ the court addressed the issue of use analogous to service mark use as a basis for opposition. PacTel opposed T.A.B.'s application to register TELETRAK, alleging prior use analogous to service mark use of the mark TELETRAK. As evidence, PacTel offered press releases (only one of which was on a national wire service), press kits (which had only been distributed to a small number of potential consumers), and brochures and news articles (none of which were broadly distributed). The Trademark Trial and Appeal Board ("TTAB") concluded that even though it had not made its services commercially available yet, PacTel had used the TELETRAC mark in a manner analogous to service mark use prior to T.A.B.'s use.²

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On appeal, the court reversed, holding that PacTel's advertising, media and sales efforts were insufficient to infer public perception and, therefore, analogous use. n3 "The user's intent, no matter how clearly established, cannot suffice in lieu of proof of the necessary 'prior public identification.'" n4

B. Distinctive, Suggestive and Descriptive Terms

Trademarks are generally classified according to four categories: (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary and fanciful. n5 While a generic term enjoys no trademark protection, a descriptive term may become protectable if the plaintiff can establish that the term has acquired "secondary meaning" in the relevant market. n6 In contrast, suggestive, arbitrary and fanciful trademarks are afforded protection without a showing of secondary meaning. n7 In *Gazette Newspapers, Inc. v. New Paper, Inc.*, the plaintiff alleged that the defendant's new name, "The Frederick Gazette," infringed on its trademark "Gazette," which the plaintiff used for a chain of newspapers distributed throughout several communities in Maryland.

Although the court found that "Gazette" did not fit neatly into the definition of a descriptive term, it concluded that policy considerations supported the finding that "Gazette" was descriptive. n8 Nothing prevented the defendant from calling its product a "newspaper." n9 Thus, "Gazette" was not properly classified as a generic term. In addition, the plaintiff established the requisite secondary meaning by showing that the word "Gazette" coupled with the name of a community identified the paper as being part of the plaintiff's Gazette Newspaper chain. n10 Accordingly, "Gazette" was entitled to trademark protection under the Lanham Act.

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Courts consider a term merely descriptive if it "immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services." n11 In *In re Intelligent Instrumentation, Inc.*, the petitioner appealed from the denial of an application to register "VISUAL DESIGNER" for "computer programs for controlling the acquisition of data from measurement devices for the purposes of analysis, display, testing and automatic control." n12 The Board affirmed the denial of the application, ruling that "VISUAL DESIGNER" immediately conveyed to consumers information regarding the most vital feature or function of the petitioner's programs, namely the use of "visual design tools" in creating custom applications for computer programs. n13

In *Door Systems, Inc. v. Pro-Line Door Systems, Inc.*, the Seventh Circuit affirmed the district court's summary judgment for the defendant in a trademark infringement and false designation of origin case. n14 The plaintiff alleged that the defendant infringed the plaintiff's DOOR SYSTEMS mark for garage doors. The Seventh Circuit chose not to decide the issue of whether the generic status of "door systems" was properly resolved on summary judgment because there was no likelihood of confusion. n15 The Seventh Circuit further stated that even though the district court did not decide the likelihood of confusion, the defendant still could defend on those grounds on appeal. n16

C. Colors

In *Mana Products, Inc. v. Columbia Cosmetics Manufacturing, Inc.*, the Second Circuit suggested that a plaintiff must show its exclusive use of a unique color in the marketplace in order to avail itself of the

[*60] protections of the Lanham Act. n17 Mana, a manufacturer and seller at wholesale of a line of "private label" cosmetic products, brought an action against a competitor claiming that the black color of its make-up compacts was protectable. The court disagreed, noting that Mana and the defendant purchased the same compact cases from independent manufacturers. n18 Where other manufacturers and retailers have used identical packaging, the court stated that it "defies simple logic" to suggest that the packaging was inherently distinctive. n19 Moreover, Mana did not demonstrate that the color of its products had achieved secondary meaning since the color black did not act as a symbol to distinguish Mana's products from those of its competitors. n20

In *McNeil-PPC, Inc. v. Granutec, Inc.*, n21 the maker of *TYLENOL* gelcaps brought suit against the manufacturer of a generic acetaminophen gelcap with the same yellow and red color combination as the plaintiff's gelcap, who had breached an agreement that it would not use those colors. Having spent considerable money in advertising, the plaintiff had established a strong and protectable interest in the red and yellow color combination. n22 The court noted that consumers had a right to buy the more expensive *TYLENOL* brand gelcap or the less expensive generic, but they also had a right to distinguish between the two products when they were not in their packaging. n23

In *Sazerac Co. v. Skyy Spirits, Inc.*, the plaintiff's motion for preliminary injunction for infringement of its blue vodka bottle was denied because the plaintiff's trade dress was not distinctive. n24 Moreover, the plaintiff failed to demonstrate likelihood of confusion. Not only was the shape of the bottle not distinctive, but the court also found that the blue color of the bottles had not come to signify the plaintiff's product in

[*61] the mind of consumers. n25 In addition, the same color blue was widely used not only for other alcohol products, but for other brands of vodka.

II. Trademark Registration and Administrative Proceedings

A. Immoral or Scandalous Terms

The Patent and Trademark Office (PTO) may refuse an application for registration on the grounds that the mark consists of immoral or scandalous matter. However, in declining registration for this ground, the PTO has the burden of demonstrating that the mark is "shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; . . . giving offense to the conscience of moral feelings; . . . [or] calling out for condemnation" n26 In making this determination, the court must examine the mark in the context of the relevant marketplace and ascertain whether it is scandalous or immoral from the standpoint of a substantial composite of the general public, not just a majority of the population. n27

In *In re Wilcher Corp.*, the PTO refused to register the petitioner's application of "Dick Heads" for a bar and restaurant on the grounds that the mark was immoral or scandalous. n28 The petitioner appealed, making two arguments. First, the petitioner claimed that "Dick Heads" refers to a person in the possessive form; the mark was used as a nickname for "Richard Head's Bar & Restaurant," which was acceptable to the public. Next, the petitioner contended that the design portion of the mark recognizes, in a humorous manner, the anatomical interpretation of "Dick Heads."

The Board rejected the petitioner's arguments and affirmed the decision of the PTO. n29 The Board found that the mark expressed a blatantly vulgar connotation. n30 Furthermore, the Board stated that the

[*62] amount of proof required to support the rejection of a trademark based on immoral or scandalous grounds depends on the nature of the mark; thus, the Board held that less evidence was required to support the rejection of more egregious marks. n31 Here, the Board noted that the mark was particularly egregious and that there was ample evidence in the record to support the PTO's refusal of the petitioner's application. n32

B. Federal Administrative Proceedings

In *Levy v. Kasher Overseers Ass'n. of America, Inc.*, n33 both parties used kosher certification marks. Earlier, the plaintiff had successfully opposed registration of the defendant's mark in the TTAB because it was confusingly similar to the plaintiff's earlier-registered mark. In this suit, the plaintiff sued the defendant for trademark infringement, and the trial court granted the plaintiff's motion for summary judgment on the grounds of collateral estoppel from the TTAB decision. n34 The Second Circuit reversed, holding that likelihood of confusion in the marketplace was a different issue than whether the marks were confusingly similar. n35 The TTAB decision did not address the entire marketplace context of the trademarks in dispute, and thus it was not a proper basis for collateral estoppel. n36

III. Loss of Rights

A. Generic Terms

A generic name for a product or service is generally not entitled to trademark protection. The Illinois High School Association (IHSA) faced this obstacle when it brought a trademark infringement action against a computer software company for its use of the term "March Madness" in a CD-ROM game. In *Illinois High School Ass'n. v. GTE*

[*63] Vantage, Inc., n37 the plaintiff, IHSA, had been using the trademark "March Madness" to describe their high school basketball tournament since the 1940s. In the early 1980s a broadcaster for CBS used the term "March Madness" to designate the National Collegiate Athletic Association's (NCAA) basketball tournament that also took place in March. Subsequently, the NCAA began licensing this term to producers of goods and services, including the defendant. In bringing a trademark infringement action against the defendant, IHSA argued that "March Madness" had not become generic. Rather, IHSA claimed that the name only described two basketball tournaments that took place in March. The Seventh Circuit rejected this position and found that the public, due to the extensive media coverage of the NCAA's tournament, had affixed a meaning other than the Illinois high school basketball tournament to the term "March Madness." n38 The court concluded that this dual or multiple use of the term "March Madness" should be resolved against trademark protection, n39 making dual-use terms similar to generic terms. The court stated that "a trademark owner is not allowed to withdraw from the public domain a name that the public is using to denote someone else's good or service, leaving that someone and his customers speechless." n40 The Seventh Circuit not only affirmed the denial of a preliminary injunction, but added "since the suit appears to lack any merit, the district court on remand should enter judgment for the defendant, [citations omitted] unless, as we greatly doubt, IHSA is able to find another arrow in its quiver." n41

B. Abandonment

In *Nabisco Inc. v. Wm. Wrigley Jr. Co.*, n42 Nabisco filed a cancellation action against two of Wrigley's registrations for the mark "WINTERMINTS." Wrigley defended on the basis that from 1981 to 1989 it used the mark by maintaining a limited distribution program consisting of limited quantity shipments to nine states four times

[*64] per year. However, Wrigley admitted that the shipments were made for the sole purpose of trademark protection and that from 1981-1989 it took no definitive steps to convert the limited distribution into legitimate commercial trade. Wrigley also claimed that it intended to resume use, as evidenced by the fact that the name WINTERMINTS was considered for a product in 1983; that Wrigley monitored U.S. trademark applications for conflicting marks; and that Wrigley engaged in foreign licensing and registration programs involving the WINTERMINTS mark. Finally, Wrigley contended that it had considered using the WINTERMINTS mark in connection with a new confectionery product under development since 1990.

The Board granted Nabisco's motion for summary judgment on the basis of abandonment. n43 Nabisco established that Wrigley abandoned the WINTERMINTS mark between 1979 and 1989, and Wrigley's quarterly shipments of WINTERMINTS chewing gum, made solely for trademark protection, were insufficient to rebut Nabisco's prima facie showing of abandonment. n44 In addition, Wrigley abandoned the WINTERMINTS mark for at least two consecutive years thereafter. n45

Wrigley's attempt to defeat Nabisco's petition to cancel by presenting evidence of an intent to resume use of the WINTERMINTS mark was unsuccessful. The Board concluded that none of the following showed a genuine intent to resume use: "consideration" of using the mark, without more; monitoring of related trademark applications; foreign licensing and registration efforts; or research and consumer tests on a new product, unrelated to the mark allegedly abandoned. n46 Wrigley's arguments that periodic use or intent to resume use after the period of abandonment did not rescue the WINTERMINTS mark from abandonment. n47 Post-abandonment readoption of a mark or subsequent intent to resume use represent a new and separate use, incapable of curing prior abandonment. n48

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C. Assignments

Under Section 10 of the Trademark Act, an owner of an intent-to-use (ITU) application may not assign his interest before filing a statement of use. n49 In *Clorox Co. v. Chemical Bank*, n50 the respondent's predecessor in interest, USA Detergents, filed an ITU application and assigned it to the respondent as collateral for a loan agreement before filing a statement of use. Subsequently, the application matured to registration and the petitioner brought an action for cancellation. Clorox argued that since the application was improperly assigned prior to the filing of a statement of use, the registration was invalid and should be canceled. In contrast, the respondent first contended that the assignment was merely created as security for a loan agreement and was not intended to profit off the sale of ITU applications in contravention of the statute. Next, the respondent posited that although the assignment was invalid under the statute, the invalid assignment had no effect on the eventual registration of the mark.

The TTAB rejected the respondent's arguments and granted Clorox partial summary judgment. n51 In arriving at this decision, the Board first found that the assignment of the ITU application before filing a statement of use violated the Trademark Act. n52 Second, the Board stated that the remedy intended by Congress for the improper assignment of an ITU application was to void the application or any resulting registration. n53

IV. Infringement of Trademark Rights

A. Likelihood of Confusion, Mistake or Deception

An essential element of a claim for trademark infringement and unfair competition under the Lanham Act is the likelihood of confusion. In *Sable Communications Co. of GA v. Fulton*, n54 the court confronted the issue of whether the defendant's conduct in presenting itself as

[*66] "Saable Communications of Louisiana" created a likelihood of confusion with the plaintiff's name "Sable Communications." The court found a likelihood of confusion as a matter of law. n55 The name "Sable" was arbitrary and unrelated to the business that the plaintiff provided. Confusion would inevitably result, since the name "Saable" is virtually identical to "Sable" and the parties were involved in the same type of business. n56 The defendant had acted intentionally because it was fully aware of the plaintiff's name "Sable" when it applied to do business under the name "Saable." Based on these factors, the court concluded that there was no factual dispute concerning the issue of likelihood of confusion and granted the plaintiff's motion for judgment on the pleadings. n57

In *Malarkey-Taylor Associates, Inc. v. Cellular Telecommunications Industry Ass'n.*, n58 the plaintiff claimed the use of "Go Wireless Now!" infringed the mark "WirelessNOW." In addressing the issue of likelihood of confusion, the court applied the factors set forth in *Polaroid Corp. v. Polarad Electric Corp.* n59 The marks in question were similar, since both marks contained the words "wireless" and "now." There was close proximity of the products because both parties targeted their services to the same industry. The plaintiff presented evidence of actual consumer confusion based on inquiries from customers concerning the relationship between the parties. The plaintiff made a showing that the defendant intended to derive benefit from the

[*67] plaintiff's reputation because the defendant did not apply for the trademark "Go Wireless Now!" until after the plaintiff had informed the defendant that "Wireless Now" was a registered trademark. As a result of weighing these factors, the court held that the plaintiff demonstrated a sufficient probability of proving likelihood of confusion and granted a preliminary injunction. n60

In *First Savings Bank, F.S.B. v. First Bank System, Inc.*, n61 the Tenth Circuit addressed the issue of whether the defendant's expired registration constituted a valid defense to the plaintiff's trademark infringement claim. The plaintiff adopted the trademark "FirstBank" in 1983 and used it within a five-county territory in Kansas without seeking federal registration. The defendant obtained a registration for "First Bank System" in 1971; however, the defendant let this registration expire in 1991 after losing interest in this mark. In 1990, the defendant registered a composite mark consisting of an octagonal first mark and the words "MEMBER FIRST BANK SYSTEM." Subsequently, the defendant merged with a bank in Kansas and changed the name of the bank to "FIRST BANK KANSAS." The plaintiff then sued the defendant to enjoin it from using the term "FIRST BANK" for the name of the Kansas Bank. In response, the defendant argued that the 1971 registration prevented the plaintiff from acquiring superior rights in "FirstBank."

The court held that the defendant, as the proponent of the constructive use defense, had the burden of proving likelihood of confusion. n62 In finding that the defendant did not meet this burden, the court first held that the marks were not substantially similar. n63 There were differences in typeface, word position, number of words and pronunciation. Second, the court determined that the defendant's mark was weak due to the fact that there were a great number of identical or similar marks already in use on different types of goods. n64 Third, although the court found that there was similarity in services, this was not enough to indicate a likelihood of confusion. n65 Accordingly, the court concluded that the defendant was not entitled to prevail on a constructive

[*68] notice defense and reversed the district court's grant of summary judgment in the defendant's favor. n66

The leading seller of car polish in 1990 lost at both the district and appellate court levels in a suit against its arch rival for trademark, trade dress, and copyright infringement in *Reed-Union Corp. v. Turtle Wax, Inc.* n67 The Seventh Circuit affirmed the lower court's finding that consumers would not likely be confused by the similarity of the plaintiff's and the defendant's trademarks for car polish (NU FINISH and FINISH 2001, respectively) nor by the similarity of the products' florescent packaging. n68 The Seventh Circuit noted its disbelief of the plaintiff's anecdotal evidence of actual confusion as well as its expert's estimate of possible confusion. n69 The court skeptically examined the plaintiff's confusion study because it used a control product that could easily bias the study due to its fame and packaging style. n70

In *International Ass'n of Machinists & Aerospace Workers, AFL-CIO v. Winship Green Nursing Center*, n71 the court considered a dispute between a union and an employer. The employer made an unauthorized use of the union's mark in company propaganda distributed during a union organizing campaign. The company included in its anti-union materials mock letters on union stationary that purported to serve as examples of how the union would act in the future. The union sued the employer under the Lanham Act, but the trial court granted summary judgment in favor of the employer.

The First Circuit affirmed, holding that no confusion as to source was likely. n72 Employees would understand that the letters were prepared by the company, as they were included in a package of company propaganda distributed during a heated organizing battle. The letters were obviously speculative fiction that attempted to show what would happen if the union won the battle then being fought. Furthermore, a concurring opinion contended that the mark was not used in commerce, and thus, did not come under the Lanham Act. n73

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B. Antitrust

In *Clorox Co. v. Sterling Winthrop, Inc.*,⁷⁴ Clorox argued that three agreements executed between the prior owners of the PINE-SOL trademark and the prior owners of the LYSOL trademark unduly restricted Clorox's ability to use PINE-SOL in violation of the Sherman Act. Clorox claimed this resulted in a restraint on competition in the household cleaning market. The Eastern District of New York held that the agreements did not violate the Sherman Act.⁷⁵ The limitation on the use of PINE-SOL as a "disinfectant" only related to how the mark may be presented to the public, and it did not prevent Clorox from competing in the household products market. Furthermore, the agreements were executed between two large companies at arm's length. Consequently, the court granted the defendant's motion for summary judgment.⁷⁶

C. Contributory Infringement

In *Fonovisa, Inc. v. Cherry Auction, Inc.*, the Ninth Circuit held that the plaintiff's claim for contributory trademark infringement was improperly dismissed by the district court.⁷⁷ Fonovisa, Inc. owned trademarks to Latin/Hispanic music recordings. Cherry Auction ran a swap meet in Fresno, CA, similar to other swap meets in the country, where customers come to purchase various types of merchandise from individual vendors. Cherry was aware that vendors were selling counterfeit recordings in violation of Fonovisa's trademarks. However, Fonovisa's claims were dismissed by the district court. On appeal, the Ninth Circuit reversed, explaining that contributory trademark liability is applicable if a defendant: "(1) intentionally induces another to infringe on a trademark or (2) continues to supply a product knowing that the recipient is using the product to engage in trademark infringement."⁷⁸ The plaintiffs correctly pointed out that while the defendant was not alleged to be supplying the recordings itself, it was supplying the

[*70] necessary marketplace for their sale in substantial quantities. n79 A swap meet cannot disregard its vendors' blatant trademark infringements with impunity. n80 Thus, the court held that Fonovisa had stated a claim. n81

D. Counterfeiting

Based on a finding that the counterfeiting of trademarked and copyrighted material has been linked to organized crime, has deprived owners of trademarks and copyrights of substantial revenues and consumer goodwill, has eliminated jobs in the U.S., and poses health risks, Congress enacted the Anticounterfeiting Consumer Protection Act of 1996. n82 This Act amends portions of the Racketeer Influenced and Corrupt Organizations laws (RICO) and the Lanham Act to include anticounterfeiting provisions.

Under the amendments, the following crimes are now subject to RICO: (1) "trafficking in counterfeit labels for phonorecords, computer programs or computer program documentation or packaging and copies of motion pictures or other audiovisual works"; (2) "criminal infringement of a copyright"; (3) "unauthorized fixation of and trafficking in sound recordings and music videos of live musical performances"; and (4) interstate transportation of stolen property. n83

The amendments to Section 35 of the Lanham Act provide an award for statutory damages in cases involving the use of a counterfeit mark "in connection with the sale, offering for sale, or distribution of goods or services" n84 This statutory damage award is in lieu of actual damages and profits, and it must be requested before the trial court renders a final judgment. n85 The amendments to Section 34(d)(9) authorize any federal, state or local law enforcement officer authority to execute civil seizure orders under the Lanham Act. n86

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V. Proof of Infringement

A. Surveys and Reaction Tests

The plaintiff's failure to offer a survey of consumer confusion or evidence of actual confusion resulted in the reversal of an injunction and a \$ 1.2 million profits award in *Libman Co. v. Vining Industries, Inc.* n87 The plaintiff had a federal registration for its multicolor-band broom bristles and the defendant was marketing brooms with multicolor-band bristles. Only post-sale confusion was seriously at issue since the defendant's broom bristles were hidden by a wrapper at sale, and Judge Posner stated that the plaintiff's theory on this confusion was a "plausible narrative." n88 However, Posner rejected the plaintiff's argument as an untested hypothesis, stating "[i]t should not have been very hard for Libman to find some satisfied owners of its brooms and confront them with the Vining broom and see whether they thought it was the same brand of broom." n89

VI. Special Defenses and Limitations

A. Laches and Acquiescence

Even though the Lanham Act does not impose limitations on claims for false advertising and unfair competition, courts apply the equitable doctrine of laches by looking to "the most appropriate" or "the most analogous" state statute of limitations for guidance. n90 In *Conopco*,

[*72] Inc. v. Campbell Soup Co., the plaintiff pasta sauce manufacturer brought an action for false advertising and misrepresentation. The defendant contended that the doctrine of laches barred the cause of action since the plaintiff filed the action five years after discovering the defendant's activity.

Affirming the district court's grant of summary judgment, the Second Circuit held that the plaintiff's action was barred by laches. n91 The "most analogous" state statute of limitations was a six-year statute of limitations for fraud. n92 Because the plaintiff brought his action within the six-year period, there was no presumption of laches. Nevertheless, the defendant established its burden of showing that circumstances existed which required the application of laches. Specifically, the defendant proved that it was prejudiced by the plaintiff's delay in bringing the action based on its substantial commitment to the advertising campaign at issue. n93 Furthermore, the court concluded that since the public interest does not prevent the doctrine of laches from applying to claims for trademark infringement, the public interest also does not prevent the doctrine of laches from applying to claims for false advertising. n94

B. Concurrent Use

In All Video, Inc. v. Hollywood Entertainment Corp., n95 the plaintiff, who operated video stores in the Detroit area, sought a preliminary injunction to prevent the defendant from using the trademark "Hollywood Video" for video stores throughout the state of Michigan. The Eastern District of Michigan enjoined the defendant only from using "Hollywood Video" for stores within a four mile radius of the plaintiff's stores. n96 The court found that the plaintiff would likely show it was unaware of the defendant's use when it adopted the name "Hollywood Video" for its stores. n97 The plaintiff continuously used the mark for video stores in existence before the defendant filed an application to register "Hollywood Video." The plaintiff could only exclude the defendant from

[*73] using "Hollywood Video" for video stores in the areas where the plaintiff used the mark prior to the filing of the application. n98

C. Permitted Use

In *Holiday Inns, Inc. v. 800 Reservation, Inc.*, the court reversed the summary judgment of the district court that found the defendants liable for both trademark infringement and unfair competition. n99 Seeing an opportunity, the defendants had acquired unassigned telephone numbers that it thought had a high likelihood of being misdialed by consumers. Specifically, the defendants acquired a phone number that was similar to the plaintiff's "1-800-HOLIDAY" number, the only difference being that the letter "O" was replaced with a zero in the defendants' number. They hoped to profit from answering these numbers by earning a standard travel agent's commission if they succeeded in booking a reservation at a Holiday Inns property. The district court found that the defendants had committed trademark infringement by profiting from use of a variant of the trademark HOLIDAY.

The court of appeals agreed with defendants' argument that they did not commit a Lanham Act violation because they never used the plaintiff's trademark or any facsimile of it. n100 They used only the telephone number 1-800-405-4329, a number that the appellate court noted is "neither phonetically nor visually similar to Holiday Inn's trademark, 1-800-HOLIDAY." n101 In addition, the court stated that the defendant "did not create any confusion; the confusion already existed among the misdialing public." n102 The court criticized Holiday Inns for having "neglected to take the simple precaution of reserving its complementary number -- a practice which many of its competitors have chosen to take." n103 Thus, the assignee of a telephone number has the right to answer his or her telephone and profit from the call so long as he or she does not do anything in the process that involves a misrepresentation or use of another trademark.

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In *CNA Finance Corp. v. Brown*, n104 the plaintiff argued that the defendant used the plaintiff's marks in connection with services when the defendant offered to sell or license the use of the plaintiff's name to third parties. The court found, however, that the defendant never offered or discussed any specific offers to license the use of the plaintiff's name. n105 Instead, the defendant was merely aware that third parties were willing to pay for the use of the plaintiff's marks. Therefore, the court held that the defendant's alleged use did not amount to a "service" within the meaning of the Lanham Act. n106

D. First Amendment Defense

In *Page v. Something Weird Video*, n107 the plaintiff film star brought an action against the defendants for allegedly misappropriating the plaintiff's "likeness" in the defendants' advertising of home video cassettes for two films in which the plaintiff starred in during the 1950s. Both parties moved for summary judgment, but the Central District of California ignored the merits of the case and held that the plaintiff's claims were barred by the First Amendment. n108 The court agreed with the defendants that the advertisements were incidental to the distribution of the films, and since the films themselves were constitutionally protected the advertising was also constitutionally protected. n109 The court rejected the plaintiff's argument that the advertisements featured in a catalog were purely commercial speech not deserving of constitutional protection. n110 The plaintiff did not intend to make a profit from sales of the catalog; rather, the catalog was only a form of advertising the videos, which were constitutionally protected. n111 Therefore, the defendant was immune from liability under California's right of publicity law. n112

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VII. Trade Identity Law

A. Dilution

On January 16, 1997, President Clinton signed the Federal Trademark Dilution Act of 1995 n113 into law. This legislation attempts to provide uniform dilution protection for famous marks, which were previously protected only by a "patchwork system" of state dilution laws. n114 Under the new law, owners of "famous marks" can now bring a federal cause of action for trademark dilution, even in situations where there is no likelihood of confusion. Specifically, the Act provides that:

[t]he owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark. . . n115

To determine whether a mark is "distinctive and famous," the Act lists the following factors for courts to consider:

(A) the degree of inherent or acquired distinctiveness of the mark; (B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used; (C) the duration and extent of advertising and publicity of the mark; (D) the geographical extent of the trading area in which the mark is used; (E) the channels of trade for the goods or services with which the mark is used; (F) the degree of recognition of the mark in the trading areas and channels of trade used by the marks'owner and the person against whom the injunction is sought; (G) the nature and extent of use of the same or similar marks by third parties; and (H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principle register. n116

The Lanham Act defines trademark dilution as "the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of (1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake or deception." n117 Notably, the Act expressly addresses

[*76] only one type of dilution: "blurring." n118 The Act does not make reference to "tarnishment," n119 the other type of trademark dilution. However, the legislative history indicates that Congress intended to "protect famous trademarks from subsequent uses that blur the distinctiveness of the mark or tarnish or disparage it ." n120

In addition, the Act provides three exceptions to trademark dilution: 1) fair use in competitive advertising and in promotions to identify competing goods or services, 2) non-commercial use, and 3) "[a]ll forms of news reporting and news commentary." n121 Furthermore, the legislative history of the Act suggests that Congress did not design the Act to preempt state dilution laws; rather, Congress intended the federal dilution law to coexist with state dilution laws. n122

In *Toys "R" Us, Inc. v. Akkaoui*, n123 the plaintiff toy company alleged that the defendant's use of "Adults 'R' Us" as an Internet site and shopping service for sexual products tarnished the plaintiff's mark. The court held that the plaintiff had established a likelihood of succeeding on its claim for trademark dilution. n124 The defendant's use of "Adults 'R' Us" tarnished the plaintiff's trademarks by associating them with a line of sexual products. n125 Consequently, the court granted the plaintiff's motion for a preliminary injunction. n126

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To fall within the ambit of the new Federal Dilution Act, the diluting mark need not be identical to the famous (senior) mark. n127 Rather, the anti-dilution provision protects famous marks from being diluted by similar, as well as identical marks. n128 In *Ringling Bros.-Barnum & Bailey, Combined Shows, Inc. v. Utah Division Travel Development*, the plaintiff argued that the defendant's use of the slogan "THE GREATEST SNOW ON EARTH" diluted the strength of its mark "THE GREATEST SHOW ON EARTH." The defendant argued that the new anti-dilution provision only applied to a diluting mark that was identical to the famous mark. The court disagreed, stating that the plain meaning of the statute evinced a clear intent on the part of Congress to prevent trademark dilution by the use of similar or identical marks. n129

In *Wawa, Inc. v. Haaf*, n130 the plaintiff, the owner of the trademark "WAWA" used for 24 hour convenience stores throughout the Mid-Atlantic states, brought an action for trademark dilution against the use of "HAHA" for a convenience store. The Eastern District of Pennsylvania held that the defendant's mark diluted the strength of the plaintiff's mark. n131 The court examined: 1) the similarity of the marks; 2) the similarity of the products covered by the marks; 3) the sophistication of customers; 4) the predatory intent of the defendant; 5) how renowned the senior mark is; and 6) how renowned the junior mark is. n132 The court concluded that the defendant's mark diluted the strength of the plaintiff's mark even though the defendant's use of the mark was not renowned. n133 Furthermore, the court noted that the name HAHA is distinctive and not merely descriptive; thus, the court stated that there was a greater risk that HAHA would dilute the WAWA mark. n134

As the Internet continues to grow as a medium for business transactions, courts are confronting various trademark issues within the realm of this new avenue of communication. In *Intermatic Inc. v.*

[*78] Toeppen, n135 the plaintiff electronics manufacturer brought federal and state trademark dilution claims against the defendant for its use of the plaintiff's trademark "INTERMATIC" as a domain name on the Internet. The court held that the defendant's use of "intermatic.com" was likely to cause dilution of the plaintiff's trademark. n136 The defendant's registration of this domain name lessened the capacity of the plaintiff to identify and distinguish its goods and prevented the plaintiff from using its trademark. n137 Furthermore, if the defendant was permitted to use the plaintiff's trademark, the distinctiveness and favorable association that the plaintiff built through its commercial success would be undermined. n138

In another dilution case involving an Internet domain name, the plaintiff, Panavision International, brought an action against the defendant for registering two of Panavision's trademarks as domain names on the Internet. Under the Federal Dilution Act, the court in *Panavision International, L.P. v. Toeppen* held that a plaintiff is entitled to an injunction against another's use of the plaintiff's trademark if: 1) the plaintiff's mark is famous; 2) the defendant's use of the plaintiff's mark is commercial; and 3) the defendant's use of the plaintiff's mark dilutes the mark. n139 Panavision's marks were clearly distinctive and famous. Panavision owned a federal registration for the marks, and the marks acquired secondary meaning through a long period of Panavision's exclusive use. By registering Panavision's trademarks as domain names and then attempting to sell them back to Panavision for a "fee," the defendant used Panavision's marks commercially. n140 The court determined that the defendant diluted Panavision's marks by preventing Panavision from using its marks in a new and important business medium and enjoined the defendant. n141

In *Sunbeam Products, Inc. v. West Bend Co.*, n142 the plaintiff sued a competitor for trademark infringement and dilution under the Lanham

[*79] Act, regarding trade dress for a stand mixer. On the plaintiff's motion for a preliminary injunction, the court held that the plaintiff's stand mixer has a non-functional design and that this same design had acquired secondary meaning. n143 Applying the Fifth Circuit's eight-factor test for likelihood of confusion, n144 the court found a likelihood of success on the plaintiff's trademark infringement claim. n145 The court also noted that its findings supported the conclusion that the trade dress of the plaintiff's stand mixer qualified as a famous mark under the Lanham Act, so the plaintiff was therefore entitled to a preliminary injunction on this count. n146

In *Ringling Bros.-Barnum & Bailey, Combined Shows, Inc. v. B.E. Windows Corp.*, n147 the plaintiff brought a trademark dilution action against the defendant for its use of the name "THE GREATEST BAR ON EARTH." The Southern District of New York first found that the defendant's use did not tarnish the plaintiff's mark simply because it was used for the name of an establishment that served alcoholic beverages. n148 The defendant's use did not blur the plaintiff's mark because the marks were not substantially similar: the word "show" was the most important word in the plaintiff's trademark, and the defendant's use of the word "bar" was an inherent difference in the marks. n149 The products covered by the trademarks also were significantly different. There was no evidence that the defendant acted with predatory intent. The defendant engaged in minimal advertising and its mark was not well renowned. As a result, the court denied the plaintiff's motion for a preliminary injunction. n150

[*80]

In *Dr. Seuss Enterprises, L.P. v. Penguin Book USA, Inc.*,¹⁵¹ the plaintiff, owner of the copyright and trademark rights to the works of Theodore Geisel, a/k/a Dr. Seuss, sought to preliminarily enjoin the defendants from distribution of a book that mimicked Dr. Seuss' writing style and illustrations. The defendants claimed that their work was a parody of the plaintiff's work and provided a "new look" at the O.J. Simpson murder trial. On the plaintiff's federal dilution claim, the court found that the defendants' use of the plaintiff's famous marks was a parody and thus fell within the "noncommercial use" exception to the federal dilution law.¹⁵²

In *Babson Bros. v. Surge Power Corp.*, the Board held that the federal dilution law does not create a new statutory ground for opposition or cancellation.¹⁵³

B. False Advertising

Generally, courts consider advertisements that contain "outrageous generalized statements . . . that are so exaggerated as to preclude reliance by consumers" as "puffery" and not actionable under the Lanham Act.¹⁵⁴ In *Coastal Communications Corp. v. Adams/Laux Co.*, the plaintiff trade magazine publisher challenged several of the defendant's ads, one of which said that the defendant was the only magazine publisher devoted to planners and organizers of corporate meetings and conferences. The Southern District of New York held that this advertisement was puffery and not actionable.¹⁵⁵

Failure by a manufacturer to designate the country or origin where a particular product was produced is a violation of 43(a) of the Lanham Act.¹⁵⁶ In *Alto Products Corp. v. Ratek Industries Ltd.*, the plaintiff, a U.S. manufacturer of clutch plates used in automobiles, brought a Lanham Act suit against the defendant, an Israeli corporation that shipped clutch

[*81] plates to the United States without marking the country of origin. The Southern District of New York held that the defendant's failure to mark the country of origin on its product violated the Tariff Act and the Lanham Act. n157

In *Seven-Up Co. v. Coca-Cola Co.*, n158 the plaintiff claimed that Coke's Sprite presentations to distributors were false and misleading and caused at least two distributors to switch from Seven-Up to Sprite. The Fifth Circuit affirmed the court's decision to set aside the jury verdict for the plaintiff, finding that there was not enough information to make such a causal connection. n159 The Fifth Circuit reviewed whether Seven-Up had properly stated a claim for false advertising and found that presentations by Coke to bottlers and distributors did indeed constitute advertisements under the Lanham Act. n160 Although the Lanham Act does not define false advertising, even a plain reading of "advertisement" includes more than the typical ad campaign. n161 The Coke presentations (1) were of a commercial nature; (2) were made by a defendant in competition with the plaintiff; (3) were intended to influence consumers (and the distributors were indeed consumers); and (4) were sufficiently disseminated to the distributors to constitute "ads." n162

C. Misappropriation

In a misappropriation of work product case, the California Superior Court of Contra Costa County confronted the issue of whether the defendant's use of the plaintiff's golf handicapping formulae in a computer software program violated California law. In *United States Golf Ass'n v. Arroyo Software Corp.*, the court stated that the elements of a valid claim for misappropriation of work product under California law include: (1) the plaintiff invested significant time, skill or money in developing its property; (2) the defendant appropriated the plaintiff's property at little or no expense to the defendant; (3) the defendant's appropriation was without the plaintiff's consent; and (4) the plaintiff

[*82] was injured. n163 In this case, the court found that the United States Golf Association ("USGA") invested a substantial amount of time, money, and skill in developing its handicap formulae. n164 The defendant used the formulae without much cost and without the USGA's consent. The defendant's use damaged the integrity of the USGA's handicap system and threatened its reputation, standing, and viability. Consequently, the court permanently enjoined the defendant from any commercial use of the USGA's handicap formulae. n165

D. Right of Publicity

In *Abdul-Jabbar v. General Motors Corp.*, n166 the court considered a GMC television commercial that referenced the name "Lew Alcindor," the birthname of former basketball star Kareem Abdul-Jabbar. Abdul-Jabbar sued GMC and its ad agency, Leo Burnett, under the Lanham Act and California's statutory and common law right of publicity, arguing that the defendants violated his trademark and publicity rights by using his former name without consent. The district court found that Abdul-Jabbar had abandoned the name "Lew Alcindor," and GMC's use of the name could not be construed as a product endorsement by Abdul-Jabbar. n167 The Ninth Circuit reversed the district court's judgment and remanded for trial on the alleged violations of California's common and statutory law right of publicity and of the Lanham Act. n168

E. Configuration and Trade Dress

To maintain an action for trade dress infringement, a plaintiff must show: (1) that its trade dress is distinctive, either because (a) it is inherently distinctive, or (b) it has acquired secondary meaning; and (2) that there is a likelihood of confusion between the plaintiff's product and

[*83] the defendant's product. n169 The defendant may avoid liability for trade dress infringement if he can establish that the trade dress is functional. n170

In *Banff Ltd. v. Express, Inc.*, the defendant sold sweaters whose design was virtually identical to those manufactured and sold by the plaintiff. n171 Although it affirmed the jury's conclusion that the plaintiff was entitled to recover damages against the defendant under the Copyright Act, the court reversed the jury's finding that the plaintiff was entitled to recover damages for trade dress infringement under 43(a) of the Lanham Act. n172 To prevail on a claim for trade dress infringement, the plaintiff cannot merely demonstrate that the appearance of a product serves some source identifying function; rather, the plaintiff must show that the primary purpose behind the design was to identify its product's source. n173 Here, *Banff* failed to make such a showing. Similarly, the court found that there was no basis for the jury's conclusion that the defendant violated the Lanham Act by falsely designating the origin of its sweaters. n174 By placing its label in the sweaters, the court reasoned that the defendant did not represent that it designed the sweaters, only that it had the right to sell the sweaters. n175

In *EFS Marketing, Inc. v. Russ Berrie & Co.*, n176 two toy makers squared off over trade dress rights in troll dolls. The Second Circuit affirmed the district court's rejection of the plaintiff's claim for trade dress infringement and false designation of origin in violation of 43(a) of the Lanham Act. n177 The court reasoned that "product-configuration trade dresses are less likely than packaging-configuration dresses to serve the source-identification function that is a prerequisite to Lanham Act protection . . . [c]onsumers do not associate the design of a product with a particular manufacturer as readily as they do a trademark or a product-packaging

["*84] trade dress." n178 Finding that the plaintiff's troll dolls were similar to others on the market, the court concluded that the design of the doll was unlikely to serve primarily as a designator of origin of the product. n179

In *Herbko International, Inc. v. Gemmy Industries Corp.*, n180 the court followed the *Banff* analysis. The plaintiff, the manufacturer of "CROSSWORD COMPANION" brought an action against the defendant, the manufacturer of "CROSSWORD CADDY," alleging trade dress infringement of its game board in violation of 43(a) of the Lanham Act. The court analyzed whether the primary purpose behind the plaintiff's design was to identify its source by examining the standards of other designs in the industry. n181 In this way, the court could determine whether the combination of elements comprising the plaintiff's design was so unique and novel in the market that one could assume it would automatically be perceived by customers as an indicium of origin. n182 Undertaking such an analysis, the court concluded that the plaintiff failed to show that its design was unique or unexpected; it was merely aesthetically pleasing. n183 Noting the lack of survey evidence as well as the game's brief time on the market, the court further found that the plaintiff failed to show that its design had acquired secondary meaning. n184

In *Krueger International, Inc. v. Nightingale Inc.*, n185 the plaintiff chair manufacturer alleged infringement of its stacking chair design. The defendant argued that the design was functional and not protectable under the Lanham Act. The Southern District of New York applied the test articulated in *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.* n186 to determine whether the plaintiff's trade dress was inherently distinctive. n187 Under this test, the court determines "whether the design, shape or combination of elements is so unique, unusual or unexpected in this market that one can assume without proof that it will automatically be perceived by

[*85] customers as an indicium of origin." n188 In the Krueger International case, the court found that the plaintiff's "Z-shaped" connecting rods gave the plaintiff's chairs a distinctive appearance and that the shape of the design was highly unique in the context of the stacking chair market. n189 Next, the court determined the features of the plaintiff's design were largely ornamental and not functional. n190 Moreover, the court noted that there were several design alternatives available to the defendant and that those design alternatives function equally as well as the plaintiff's design. n191 Consequently, the court held that the plaintiff's overall design was entitled to trade dress protection under the Lanham Act. n192

If the product is displayed as an integral part of the packaging, the two may be considered together in evaluating distinctiveness. n193 In *Fun-Damental Too, Ltd. v. Gemmy Industries Corp.*, the plaintiff sold a bank shaped like a toilet, aptly named "Toilet Bank." The bank emitted a flushing sound when the handle was depressed, and when a coin was placed in the bowl the bottom of the bowl opened to receive it. The packaging displayed the bank, trumpeted its "REAL FLUSHING SOUND" and invited consumers to "PRESS HANDLE" and "TRY ME." The defendant "heard about" the plaintiff's bank and developed its product, the "Currency Can," based on the plaintiff's design. The defendant marketed the bank in a box identical in configuration and dimensions to the "Toilet Bank's" box. The trade dress of the defendant's bank also included lettering that stated "A BANK WITH A REAL FLUSHING SOUND!", "PRESS HANDLE" and "TRY ME!" The court determined that the plaintiff's bank design was inherently distinctive based on both the packaging of the bank and the design of the bank itself. n194 The defendant's design and packaging created the same general impression, which would likely confuse consumers. n195 Based on the confusing

[*86] similarity of appearance and likelihood of confusion, the court upheld a preliminary injunction. n196

In *Sunburst Products v. Cyrk International*, the Federal Circuit held that the plaintiff's design of a waist pack was not inherently distinctive, n197 and distinctiveness acquired through secondary meaning was not decided by the jury or raised on appeal. n198 Although the court stated that the plaintiff's "REAR GEAR" waist pack was an attractive, user friendly design, the plaintiff failed to establish that its design would "inherently identify it as the source of the goods." n199 The plaintiff only presented the testimony of two salesmen to support its claim that the design was a source of identification. As a result, the court reversed the district court's judgment in favor of the plaintiff. n200

Epic Metals Corp. v. Souliere n201 involved the design of steel deck components used in the construction industry for reinforcing concrete. The plaintiff contended that the similarities in the dovetail configurations of the products would confuse purchasers. Conversely, the defendant argued that the similarity was functional, and thus not deserving of trade dress protection. The Eleventh Circuit reversed the lower court, finding that the dovetail configuration was primarily functional. n202 The court based its determination primarily on the testimony of the plaintiff's president and on the plaintiff's advertising materials that indicated the dovetail configuration was essential to the enhanced performance of the product and the reduced cost of production. n203

In another trade dress case, the United States Bankruptcy Court, District of New Jersey held that the plaintiff model train manufacturer had failed to establish a cause of action for trade dress infringement. n204 In *In re Polk's Model Craft Hobbies Inc.*, the plaintiff alleged that the defendant's large scale model train track looked similar to the plaintiff's

[*87] track. The court found that the plaintiff's track was functional. n205 The brass material used in both parties' tracks was commonly used in model train tracks, and there was a limited number of design alternatives available to the defendant. In addition, the track design was not inherently distinctive because it was not an unusual or memorable design, was not conceptually separable from the product, and was not likely to identify the product in the consumer's mind. n206 Lastly, the court determined that the plaintiff's track had not acquired secondary meaning. n207

In *Nelson/Weather-Rite, Inc. v. Leatherman Tool Group, Inc.*, n208 the court addressed the issue of whether a defendant's multi-purpose tool was entitled to trade dress protection as a matter of law. Both parties were manufacturers of various compact multi-purpose tools. The court held that neither side was entitled to summary judgment in their favor. n209 First, Leatherman failed to prove as a matter of law that its product was distinctive since the only evidence it presented in support of its distinctiveness claim was two wrongly returned Nelson tools. n210 Furthermore, although Leatherman argued that it sold over three million tools, it was unclear whether Leatherman spent money marketing the tool. n211 Finally, the court concluded that it was unable to determine, as a matter of law, that Nelson did not infringe on Leatherman's trade dress. n212

In *Windmill Corp. v. Kelly Foods Corp.*, the Sixth Circuit affirmed the district court's holding that the defendant, who packaged the plaintiff's popular "Bonkers" cat treats pursuant to a packaging agreement, infringed the plaintiff's trade dress by selling its own "Catty Shack" cat treats in containers with graphic design features very similar to plaintiff's containers after the agreement expired. n213 The Sixth Circuit upheld the lower court's finding that a milk carton container for cat

[*88] treats was functional. n214 It also agreed that the whole of the plaintiff's containers, including background colors, display of wording, and titles of flavors, had acquired secondary meaning. n215 This was supported by the fact that the defendant intentionally copied the plaintiff's trade dress. In addition, the Sixth Circuit affirmed the lower court's finding of confusing similarity because a side-by-side comparison clearly showed that the containers were confusingly similar. n216 Thus, the defendant was permanently enjoined from marketing its "Catty Shack" cat treats in any trade dress not substantially different from the trade dress of "Bonkers" cat treats. n217

In *Bath & Body Works, Inc. v. Luzier Personalized Cosmetics, Inc.*, the Sixth Circuit affirmed a jury verdict for the defendant in a trade dress infringement action involving two sellers of personal care products. n218 The parties packaged their products in similar bottles that included the words BATH & BODY. The lower court granted the defendant's motion for a directed verdict after finding that the words "Bath & Body," which constituted much of the similarity of the two parties' trade dress, were generic or descriptive without secondary meaning. n219 Although the Sixth Circuit disagreed with the lower court's ruling that the term BATH & BODY was generic, it upheld the lower court's ruling for the defendant because the plaintiff said that it did not object to the defendant's use of the words BATH & BODY. n220 In addition, the jury instructions to which the plaintiff objected simply explained that the jury could consider the manner in which the defendant used those words in determining likelihood of confusion between the parties' trade dress. n221

In *Dorr-Oliver, Inc. v. Fluid-Quip, Inc.*, the court reversed the grant of an injunction and damages, finding no likelihood of confusion between the trade dress of the plaintiff's \$ 40,000 corn starch washing machine and the defendant's "practically identical" copy. n222 The court

[*89] stated that the Lanham Act only protects potential purchasers in the relevant market from confusion. n223 Here, the evidence demonstrated that: (1) there were only 12 domestic companies that had ever purchased the machines; (2) they were sophisticated purchasers who made careful and deliberate decisions; and (3) the defendant had begun producing its machine at the request of some of these purchasers. In dicta, the court countered the plaintiff's post-sale confusion argument by stating there was no evidence that observers of the two manufacturers' names on operating machines would think the companies are related, as opposed to competitors. n224

The Seventh Circuit also addressed the intersection of trade dress law and patent law with respect to product configurations and concluded:

In the current case Dorr-Oliver reaped the rewards of its patents on the clamshell for seventeen years, after which time the product passed into the public domain. Fluid-Quip then entered the clamshell market with a product virtually identical in appearance and represented itself to potential customers as a competitor of Dorr-Oliver. This is certainly competition, but the similarity of the two clamshells, standing alone, does not make it unfair. Indeed, the "mere inability of the public to tell two identical articles apart is not enough to support an injunction against copying or an award of damages for copying that which the federal patent laws permit to be copied." n225

Two bubble gum vending machine sellers battled over trade dress rights in *Northwestern Corp. v. Gabriel Manufacturing Co.* n226 The plaintiff, the owner of a federal trademark registration for the shape and configuration of its bubble gum machine, brought suit against the defendant after the defendant began selling bubble gum machines that closely resembled those of the plaintiff. The defendant responded with a nine-count counterclaim. Only one count, a claim of fraud on the PTO, survived the plaintiff's motion to dismiss because "[a] trademark applicant has a duty to disclose the fact that a design is generic at the time of application." n227

In dismissing some of the defendants' other eight counts, the court found that: (1) product configurations are eligible for trademark status; n228 (2) trademarks may not be canceled on functionality grounds

[*90] once they become incontestable; n229 (3) it is not unlawful to obtain trademark protection for a product configuration which is the subject of an expired design patent; n230 (4) a trademark applicant does not commit fraud on the PTO when she declares that she knows no other person with rights to use the mark as long as she reasonably believes no other party has superior rights to that mark. n231

In *Ark Plas Products, Inc. v. Value Plastics, Inc.*, n232 the plaintiff copied the defendant's single-barb plastic pipe fittings, but the plaintiff won in its declaratory judgment action and defeated the defendant's trademark and trade dress claims anyway. With regard to the trade dress claim, the court found the defendant's trade dress "functional" because its basic underlying design could not be changed. n233 The defendant's fittings were not inherently distinctive because they were "dictated by the nature of the product." n234 Similarly, the defendant's trade dress had not acquired secondary meaning with consumers because: major customers could not say what made the defendant's mark distinctive; various catalog resellers sold the defendant's fittings under their own names; customer testimony showed that customers could not make small distinctions among barb designs; and there was no proof of actual confusion. n235 Even though the plaintiff copied the defendant's trade dress, copying per se did not show that the defendant's trade dress had achieved secondary meaning. n236 Competitors are allowed to capitalize on a demand for a particular type of product. On the trademark claim, the court found the defendant's "INSTRUMENT QUALITY" slogan descriptive without secondary meaning, in part because the technical community used the phrase descriptively and because the defendant itself used the phrase descriptively in its catalogs. n237

In *L. & J.G. Stickley, Inc. v. Canal Dover Furniture Co.*, the court held that the trade dress of reproductions cannot gain secondary meaning

[*91] that identifies and protects the reproducer. n238 In the early twentieth century, Gustav Stickley, a furniture maker and proponent of the Arts and Crafts Movement, designed what became known as Mission Furniture. Gustav joined his brothers to form L. & J.G. Stickley, Inc. In the 1920's, L. & J.G. Stickley ceased production of Mission Furniture but continued to manufacture other types of furniture. Sixty years later, Mission Furniture regained its popularity. In 1989, L. & J.G. Stickley commenced the sale of reproductions of Gustav Stickley Mission Furniture designs. In 1993, Canal Dover began manufacturing Mission style furniture based on designs in history books. L. & J.G. Stickley sought a preliminary injunction, claiming trade dress infringement in violation of 43(a) of the Lanham Act. In declining the plaintiff's request, the court determined that the plaintiff's reproductions were not inherently distinctive because the original designer of the furniture was Gustav Stickley, not the plaintiff. n239 Moreover, the plaintiff could not establish that its trade dress had acquired secondary meaning. The plaintiff's sixty year non-use of the Mission furniture trade dress extinguished any rights it had in the Gustav Stickley design. n240 In essence, the historical Mission Furniture designs had entered the public realm, and the plaintiff could not make an exclusive claim to them under the Lanham Act.

A defendant cannot rely on a plaintiff's sale of private label goods with a trade dress similar to the plaintiff's ordinary goods as grounds for weakening the trade dress as a source identifier. n241 If the private label packaging leads consumers to believe that the same manufacturer has made both goods, this is not misleading because it is the actual situation. n242 In *Benjamin Moore & Co. v. Talon Paints Products, Inc.*, the court found in 1994 that the defendant's AQUAFLOW trade dress was confusingly similar to the plaintiff's AQUAGLO trade dress for paint products and ordered that the defendant submit new labels for court approval. n243 In 1995, the court ruled the defendant had intentionally infringed and found for the plaintiff in its motion for summary judgment. n244 The court then dismissed the defendant's appeal from the

[*92] 1995 summary judgment, rejecting defendant's argument that the recent decision of *Versa Products Co. v. Bifold Co.* n245 meant that the court should find that its source disclosure on its packaging was enough to halt any confusion. n246 The court found that the defendant had misread *Versa*, which was distinguishable because of the extreme sophistication of the consumers in that situation. n247 The court also rejected the defendant's argument that the plaintiff deserved less protection on its AQUAGLO trade dress because it was engaged in the sale of paint under private labels with a trade dress similar to the plaintiff's AQUAGLO trade dress. n248 The court held that if consumers associated the private labels with the plaintiff, then they were correct; the plaintiff did make the private label paints, and thus the plaintiff had not confused the public. n249

In a suit for trademark infringement and unfair competition, a fair use defense may be applicable even when likelihood of confusion has been established. n250 In *Shakespeare Co. v. Silstar Corp. of America*, the court found that Shakespeare, a fishing rod manufacturer, failed to show that Silstar's use of a clear tip on its fishing rod was likely to cause confusion between the two rods. n251 Further, even if there was a likelihood of confusion, Silstar had established fair use. n252 This case was on remand from a Fourth Circuit decision that overturned the district court's ruling that Shakespeare's trademark could be canceled on the grounds of functionality. n253 The district court here limited its examination of functionality to the good faith issue and found that the clear tip was used

[*93] not as a source identifier, but rather as a functional feature. n254 Shakespeare's adsstressed the functional uses of a clear tip.

When assessing trade dress infringement, it is critical that the fact finder look not at each individual element of the trade dress, but whether the trade dress as a whole is deserving of protection. n255 In *Tools USA & Equipment Co. v. Champ Frame Straightening Equipment, Inc.*, the court affirmed a jury verdict for the plaintiff, holding that there was sufficient evidence to show that the defendant had intentionally copied the plaintiff's trade dress of its tool catalog. n256 The plaintiff established that its trade dress was primarily non-functional, that it acquired secondary meaning, and that the defendant's infringement caused confusion. n257 The court rejected the defendant's appeal because an examination of each individual part was the incorrect standard. n258 The plaintiff's trade dress, taken as a whole, was protectable.

In *Sazerac Co. v. Skyy Spirits, Inc.*, the court found that the shape of the bottles the plaintiff used to sell its vodka was not distinctive in shape or size, n259 so the defendant could use similar bottles without infringing. Further, the blue color of the bottles had not come to signify the plaintiff's product in the mind of consumers, and the same color blue was widely used not only for other alcohol products but for other brands of vodka. n260 Even if the plaintiff's trade dress was distinctive and meriting protection, the plaintiff failed to show that a likelihood of confusion existed. n261

In *Swisher Mower & Machine Co. v. Haban Manufacturing, Inc.*, the court granted the defendant summary judgment on the plaintiff's Lanham Act claims. n262 Swisher claimed that Haban copied Swisher's T-40 tow-behind mower when it designed Haban Model 614-001 tow-behind mower. The court determined that the over-all trade dress of the T-40

[*94] could not be considered arbitrary or nonfunctional. n263 Moreover, the design was not inherently distinctive, and no secondary meaning was established. n264 Copying of trademarks could not be found because the defendant's products prominently featured the defendant's own trademarks and label. n265 Finally, the court found as a matter of law that there is no likelihood that the consumers would confuse the Swisher T-40 with the Haban Model 614-001. n266 There were significant differences in the trade dress of the two mowers, most notably their distinctive colors and prominent display of the logos. Swisher presented no evidence on Haban's intent to trade upon Swisher's good will, and lawn equipment dealers said that they were not confused.

Several other notable cases include *Winning Ways, Inc. v. Holloway Sportswear, Inc.*, n267 *Boss Manufacturing, Inc. v. Parker Traps International, Inc.*, n268 *Carillon Importers, Ltd. v. Frank Pesce Group, Inc.*, n269 and *Elmer v. ICC Fabricating, Inc.* n270

[*95]

VIII. Jurisdiction and Remedies

A. Jurisdiction

1. Subject Matter Jurisdiction

In *PHC, Inc. v. Pioneer Health Care, Inc.*, the court considered the effect of a pending TTAB proceeding on a complaint for declaratory judgment. ⁿ²⁷¹ Pioneer Health Care (Pioneer), a medical care service provider, learned that PHC, Inc. (PHC), an alcohol and substance abuse center, had registered the mark PIONEER HEALTHCARE. Pioneer filed a petition to cancel PHC's registered mark based on Pioneer's common law use of the marks PIONEER HEALTH CARE and PIONEER HEALTH. PHC responded by filing a declaratory judgment action in the federal district court, seeking a declaration that its use of its registered mark PIONEER HEALTHCARE did not violate any rights of Pioneer. After filing the district court action, PHC asked the TTAB to suspend the cancellation proceeding pending the outcome of the district court action. In response, Pioneer moved the district court to dismiss PHC's action, alleging it was an improper attempt to circumvent the administrative process. The district court dismissed PHC's complaint. ⁿ²⁷² The First Circuit reversed. ⁿ²⁷³ Two factors weighed against deference to the administrative proceeding. First, under the Lanham Act, the findings of the TTAB could be challenged in federal district court, and Congress permits an initial proceeding in the district court to challenge or affirm a federal registered mark without resort to the TTAB. ⁿ²⁷⁴ Second, the First Circuit stressed the urgency of the infringement claims and the TTAB's limited remedial powers, including the TTAB's lack of power to grant equitable or monetary relief for an infringement. ⁿ²⁷⁵

2. Personal Jurisdiction

As the Internet continues to grow as means for communication and transacting business, various jurisdictional issues arise. In *Bensusan*

[*96] Restaurant Corp. v. King, the Southern District of New York addressed the issue of whether the existence of a World Wide Web site, without anything more, was sufficient to vest the court with personal jurisdiction over the defendant under New York's long-arm statute and the Due Process Clause of the U.S. Constitution. n276 The plaintiff night club owner alleged that the defendant's Web site infringed on its trademark "The Blue Note." The court held that the defendant was not subject to personal jurisdiction in New York under either the long-arm statute or the Due Process Clause. n277 Even assuming that the users were confused about the relationship between the plaintiff's and the defendant's night clubs, any act of infringement would have occurred in Missouri (where the defendant's club is located), not New York. n278 The defendant had done nothing to purposefully avail himself to the benefits of New York. n279 The defendant did not actively encourage New Yorkers to access his Web site, nor did he conduct any business in New York. Accordingly, the exercise of personal jurisdiction over the defendant would violate the Due Process Clause. n280

In contrast to the Bensusan decision, the Eastern District of Missouri found that the exercise of personal jurisdiction over a defendant regarding its activities over the Internet was proper in Maritz, Inc. v. Cybergold, Inc. n281 The alleged Lanham Act violation fulfilled the "commission of a tortious act" provision of Missouri's long-arm statute. n282 The defendant had maintained minimum contacts with the forum state by deciding to transmit advertising information to all Internet users globally. n283 The defendant had purposefully availed itself to the privilege of doing business in Missouri by intentionally communicating through its computer network with Missouri residents; the defendant communicated with Missouri residents concerning its services approximately 131 times. n284 Moreover, the defendant developed a mailing list through its acceptance of addresses on its Web site.

[*97] Consequently, the court denied the defendant's motion to dismiss for lack of personal jurisdiction. n285

In *Sculptchair, Inc. v. Century Arts, Ltd.*, n286 the plaintiff, a Florida corporation, brought an action for trademark infringement, inter alia, against a Canadian corporation, its successor, and its Canadian representatives. The defendants filed a motion to dismiss for lack of personal jurisdiction. First, the court applied Florida's long arm statute and found that Deena Rich, a sales representative, met the criteria: she had carried on a business in Florida through sporadic sales and marketing efforts. n287 Next, the court determined that Rich had sufficient minimum contacts with Florida. n288 Rich conducted marketing activities in Florida and purposefully availed herself of the privilege of doing business in Florida, so she could reasonably foresee being haled into court there. n289 In addition, although the defendant was a permanent resident of Canada, she was temporarily residing in Florida, she attended school in Florida, and she planned to set up a permanent residence in Florida. Accordingly, the court reversed the district court's grant of the defendant's motion to dismiss. n290

B. Remedies

1. Injunction

To obtain a preliminary injunction in a Lanham Act suit, as in other situations, the moving party must typically establish: (1) irreparable harm; and (2) either (a) likelihood of success on the merits or (b) "sufficiently serious questions going to the merits to make them a fair ground for litigation and a balance of hardships tipping decidedly toward the party requesting preliminary relief." n291 In *Eugene Biro Corp. v. Empire Diamond Corp.*, the plaintiff, a diamond wholesaler, brought an action against the defendant for its use of the plaintiff's "Dial-A-Diamond"

[*98] service. The court denied the motion for a preliminary injunction. n292 There was no irreparable harm because the plaintiff failed to show its continuous and widespread use of the mark, meaning the plaintiff could not establish that the defendant's advertisements caused lost sales. n293 In addition, the plaintiff was not likely to prevail on the merits because the plaintiff's mark was descriptive in nature and had not achieved secondary meaning status. n294 Finally, because the plaintiff had failed to show irreparable harm, there was no need to balance the hardships. n295

When issuing an injunction in a trademark or trade dress infringement action, a court must set forth specific reasons for its ruling and describe with sufficient detail the conduct that is prohibited. n296 In *Gasser Chair Co. v. Infanti Chair Manufacturing Corp.*, the defendant moved for a stay, pending appeal, of an injunction issued by the Southern District of New York prohibiting the defendant from making, using, and selling certain chairs. The Federal Circuit held that neither the judgment nor the district court's memorandum and order sufficiently described the products affected by the injunction. n297 According to the court, the injunction did not explain which products violated the plaintiff's trade dress, so the court remanded for further proceedings. n298

Once a plaintiff is able to show a sufficient likelihood of succeeding on a claim for trademark infringement, some courts find that there is a presumption that the plaintiff will suffer irreparable harm. n299 In *Malarkey-Taylor Associates, Inc. v. Cellular Telecommunications Industry Ass'n.*, the plaintiff was able to establish a likelihood of success on the merits. n300 Although the defendant argued that the claim of likely harm was speculative, the court found that the defendant was unable to rebut the presumption of irreparable harm; the court presumed that the

[*99] defendant's continued use of "Go Wireless Now!" could result in dilution of the plaintiff's "WirelessNOW" mark. n301

A court cannot preliminarily enjoin a party who has filed an intent-to-use (ITU) application from engaging in the necessary commercial use of that mark needed to gain registration on the grounds that the moving party has used the mark subsequent to the filing of the ITU application. n302 In WarnerVision Entertainment, Inc. v. Empire of Carolina, Inc., the defendant, Thomas Lowe Ventures (TLV), filed an ITU application for the trademark "REAL WHEELS." Subsequently, WarnerVision, acting in good faith, began using REAL WHEELS. Empire then acquired the title and interest in the REAL WHEELS product line from TLV. WarnerVision brought action against TLV and Empire, requesting a preliminary injunction to enjoin the defendants from using REAL WHEELS.

The Second Circuit vacated the preliminary injunction. n303 The court stated that the purpose of a preliminary injunction is to prevent irreparable injury, not to allow one party to gain an advantage by tying the hands of the adverse party. n304 Granting WarnerVision's motion for a preliminary injunction would prevent Empire from achieving use, registration and priority, so it would permanently eliminate its rights as the holder of the ITU application. n305 Consequently, the court held that "as long as an ITU applicant's privilege has not expired, a court may not enjoin it from making the use necessary for registration on the grounds that another party has used the mark subsequent to the filing of the ITU application." n306 A contrary conclusion would frustrate the purpose of the Lanham Act's ITU provisions; the ITU holder could be prevented from undertaking the use required to obtain registration, thus effectively terminating the ITU applicant's rights. n307

[*100]

2. Damages

Generally, damages that result from trademark infringement must be established with reasonable certainty. n308 In *McClaran v. Plastic Industries, Inc.*, the plaintiff claimed that the defendants' use of the plaintiff's "M" logo and design deprived the plaintiff of sales profits and deterred him from entering into business. The jury awarded the plaintiff \$ 843,750 for its claim of trademark infringement against Rotocast Plastic Products of Tennessee (R/T). The Ninth Circuit reversed, finding that the jury's award was based on pure speculation. n309 The plaintiff did not establish with reasonable certainty that he suffered any damages as a result of R/T's infringement. The plaintiff was not making products under the trademark at the time of the infringement and was not selling products under the trademark whose marketability was impaired as a result of defendant's infringement. Moreover, the plaintiff's estimation of lost profits was completely unsupported; none of the parties ever made a profit selling products under the plaintiff's trademark. Accordingly, the court reversed the jury's damage award. n310

One other noteworthy case is *Kransco Manufacturing, Inc. v. Hayes Specialties Corp.*, where the court vacated a damage award due to a lack of evidence of registration notice, despite a finding of a likelihood of confusion. n311

3. Attorneys' Fees

Under Section 35 of the Trademark Act, a court may award attorney's fees to the prevailing party in exceptional cases. n312 However, such an award requires an unambiguous showing of extraordinary misconduct or bad faith on the part of the plaintiff. n313 In *Sunmark, Inc. v. Ocean Spray Cranberries, Inc.*, the plaintiff brought an action to enjoin the words "sweet-tart" for fruit beverages on the grounds that it

[*101] caused likelihood of confusion and dilution of the plaintiff's mark "SWEETarts." In pursuing its claims the plaintiff relied on a defective registration as well as common law rights. Although the plaintiff's reliance on its invalid registration was objectively unreasonable, its reliance on common law rights was not. n314 Section 35 requires a showing of bad faith, not merely objective unreasonableness. n315 Because the plaintiff did not act in bad faith, this was not an exceptional case requiring attorney's fees. n316

In *Knitwaves, Inc. v. Lollytogs, Ltd.*, n317 the plaintiff sued under the Copyright Act and the Lanham Act for infringement of its sweater designs. The plaintiff (after one previous appeal n318) succeeded on its copyright claim, but not the Lanham Act claim. On remand, the district court, in awarding attorneys' fees to the plaintiff, reduced the plaintiff's fee award by twenty five percent to account for the plaintiff's lack of success on its Lanham Act count. n319 The Second Circuit upheld this reduction, holding that there is no precise rule or formula for determining reasonable attorneys' fees where the plaintiff has achieved partial success. n320

One other notable case involving monetary sanctions is *Baldwin Hardware Corp. v. Franksu Enterprise Corp.* n321

4. Temporary Restraining Order

Through its power to grant equitable relief in a suit under the Federal Trademark Dilution Act, a court can issue a temporary restraining order enjoining a defendant from activities that may dilute a plaintiff's

[*102] trademarks or trade dress. n322 In *Anheuser-Busch, Inc. v. Andy's Sportswear, Inc.*, the Northern District of California granted the plaintiff beer manufacturer's request for a temporary restraining order enjoining the manufacture and distribution of "Buttwiser" T-shirts. n323 The plaintiff's trademarks were unquestionably famous, and there were serious questions as to whether the defendant's T-shirts would dilute the plaintiff's marks. The court found that the balance of hardships weighed heavily in favor of the plaintiff. n324 Thus, the plaintiff was entitled to the temporary restraining order pending a hearing for a preliminary injunction. n325

IX. Insurance Coverage

The question of whether an insurance policy provided coverage for liability arising out of an action for trademark and trade dress infringement was addressed in *Advance Watch Co. v. Kemper National Insurance Co.* n326 The defendant had issued an insurance policy whereby it agreed to defend the plaintiff in any action for liability involving an "advertising injury" caused by "an offense committed in the course of advertising [the plaintiff's] goods, products or services." n327 The defendant refused to defend the plaintiff for trademark and trade dress infringement. The Sixth Circuit reversed the district court's order granting the plaintiff's motion for summary judgment, finding that the policy, which provided coverage for actions involving misappropriation of advertising ideas or style of doing business, did not extend to actions for trademark and trade dress infringement. n328 Specifically, the court noted that "trademark and trade dress infringement" is a distinct group of actionable conduct and was not expressly contained in the policy. n329 Therefore, the

[*103] court held that the defendant was not obligated to defend the plaintiff in the trademark and trade dress infringement action. n330

n1 77 *F.3d* 1372, 37 *U.S.P.Q.2d* (BNA) 1879 (*Fed. Cir.* 1996).

n2 *Id.* at 1373, 37 *U.S.P.Q.2d* (BNA) at 1880.

n3 *Id.* at 1376, 37 *U.S.P.Q.2d* (BNA) at 1883.

n4 *Id.*

n5 *Gazette Newspapers, Inc. v. New Paper, Inc.*, 934 *F. Supp.* 688, 692, 40 *U.S.P.Q.2d* (BNA) 1900, 1903 (*D. Md.* 1996).

n6 *Id.*

n7 *Id.*

n8 *Id.* at 693, 40 *U.S.P.Q.2d* (BNA) at 1904.

n9 *Id.*

n10 *Id.* at 694-95, 40 *U.S.P.Q.2d* (BNA) at 1905.

n11 *In re Intelligent Instrumentation, Inc.*, 40 *U.S.P.Q.2d* (BNA) 1792 (*T.T.A.B.* 1996) (citing *In re Abcor Dev. Corp.*, 538 *F.2d* 811, 200 *U.S.P.Q.* (BNA) 215, 217-18 (*C.C.P.A.* 1978)).

n12 *Id.*

n13 *Id.* at 1794-95.

n14 83 *F.3d* 169, 174, 38 *U.S.P.Q.2d* (BNA) 1771, 1775 (*7th Cir.* 1996).

n15 *Id.* at 173, 38 *U.S.P.Q.2d* (BNA) at 1774-75.

n16 According to the court, "[a]n appellee can defend the judgment appealed from on any nonwaived ground, even if the district court did not address it." *Id.* at 173, 38 *U.S.P.Q.2d* (BNA) at 1775 (citations omitted).

n17 The court stated that there were countless companies that sold black compacts, and the plaintiff failed to present evidence of the "amount of time that the compacts made exclusive use of the challenged design." 65 *F.3d* 1063, 1071, 36 *U.S.P.Q.2d* (BNA) 1176, 1181 (*2d Cir.* 1995) (emphasis added).

n18 *Id.* at 1070, 36 *U.S.P.Q.2d* (BNA) at 1180.

n19 *Id.*

n20 *Id.* at 1071, 36 *U.S.P.Q.2d* (BNA) at 1181.

n21 919 *F. Supp.* 198, 37 *U.S.P.Q.2d* (BNA) 1713 (*E.D.N.C.* 1995).

n22 *Id.* at 203-04, 37 *U.S.P.Q.2d* (BNA) at 1717.

n23 *Id.* at 204, 37 *U.S.P.Q.2d* (BNA) at 1718.

n24 37 *U.S.P.Q.2d* (BNA) 1731, 1733 (*E.D. La.* 1995), *aff'd* without opinion, 95 *F.3d* 53 (*5th Cir.* 1996).

n25 *Id. at 1732-33.*

n26 *In re Wilcher Corp.*, 40 *U.S.P.Q.2d* (BNA) 1929, 1930 (T.T.A.B. 1996) (citing *In re Riverbank Canning Co.*, 95 *F.2d* 327, 328, 37 *U.S.P.Q.* (BNA) 268, 269 (C.C.P.A. 1938)).

n27 *Id.*

n28 *Id.*

n29 *Id. at 1934.*

n30 *Id. at 1932-33.*

n31 *Id. at 1934.*

n32 *Id.*

n33 104 *F.3d* 38, 41 *U.S.P.Q.2d* (BNA) 1456 (2d Cir. 1997).

n34 *Id. at 40*, 41 *U.S.P.Q.2d* (BNA) at 1458.

n35 *Id. at 43*, 41 *U.S.P.Q.2d* (BNA) at 1460.

n36 *Id.*

n37 99 *F.3d* 244, 40 *U.S.P.Q.2d* (BNA) 1633 (7th Cir. 1996), cert. denied, 117 *S.Ct.* 1083 (1997).

n38 *Id. at 247*, 40 *U.S.P.Q.2d* (BNA) at 1636.

n39 *Id.*

n40 *Id.*

n41 *Id. at 248*, 40 *U.S.P.Q.2d* (BNA) at 1636.

n42 40 *U.S.P.Q.2d* (BNA) 1251 (T.T.A.B. 1995).

n43 *Id. at 1258.*

n44 *Id. at 1257.*

n45 *Id. at 1258.*

n46 *Id.*

n47 *Id.*

n48 *Id.*

n49 15 *U.S.C.A.* 1060 (1963 & Supp. 1997).

n50 40 *U.S.P.Q.2d* 1098 (T.T.A.B. 1996).

n51 *Id. at 1106.*

n52 *Id. at 1104.*

n53 *Id.*

n54 40 *U.S.P.Q.2d* 1370 (E.D. La. 1996)

n55 *Id. at 1373.*

n56 *Id.*

n57 *Id.*

n58 929 *F. Supp.* 473, 40 *U.S.P.Q.2d (BNA)* 1136 (*D.D.C. 1996*).

n59 "In assessing likelihood of confusion, the Court must consider a number of factors, including: (a) the strength of the plaintiff's mark; (b) the degree of similarity between the two marks; (c) the proximity of the products; (d) the likelihood that the prior owner will bridge the gap between its market or business and the second owner's market or business; (e) evidence of actual confusion; (f) the defendant's purpose or reciprocal of good faith in adopting its own mark; (g) the quality of the defendant's product; and (h) the sophistication of the buyers." *Id. at 477, 40 U.S.P.Q.2d (BNA) at 1138-39* (citing *Polaroid Corp. v. Polarad Elec. Corp.*, 287 *F.2d* 492, 495, 128 *U.S.P.Q (BNA)* 411, 413 (2d Cir. 1961)).

n60 *Id. at 478-79, 40 U.S.P.Q.2d (BNA) at 1140.*

n61 101 *F.3d* 645, 40 *U.S.P.Q.2d (BNA)* 1865 (10th Cir. 1996).

n62 *Id. at 652, 40 U.S.P.Q.2d (BNA) at 1870.*

n63 *Id. at 653, 40 U.S.P.Q.2d (BNA) at 1871.*

n64 *Id. at 654, 40 U.S.P.Q.2d (BNA) at 1872.*

n65 *Id. at 656, 40 U.S.P.Q.2d (BNA) at 1873.*

n66 *Id. at 656, 40 U.S.P.Q.2d (BNA) at 1873-74.*

n67 77 *F.3d* 909, 37 *U.S.P.Q.2d (BNA)* 1718 (7th Cir. 1996).

n68 *Id. at 914, 37 U.S.P.Q.2d (BNA) at 1722.*

n69 *Id. at 912, 37 U.S.P.Q.2d (BNA) at 1720.*

n70 *Id. at 912, 37 U.S.P.Q.2d (BNA) at 1720-21.*

n71 103 *F.3d* 196, 41 *U.S.P.Q.2d (BNA)* 1251 (1st Cir. 1996).

n72 *Id. at 206, 41 U.S.P.Q.2d (BNA) at 1260.*

n73 *Id. at 209, 41 U.S.P.Q.2d (BNA) at 1262* (Saris, J., concurring).

n74 932 *F. Supp.* 469, 40 *U.S.P.Q.2d (BNA)* 1461 (*E.D.N.Y. 1996*), *aff'd.*, 117 *F.3d* 50, 43 *U.S.P.Q.2d (BNA)* 1161 (2d Cir. 1997).

n75 *Id. at 474, 40 U.S.P.Q.2d (BNA) at 1465.*

n76 *Id. at 474, 40 U.S.P.Q.2d (BNA) at 1465.*

n77 76 *F.3d* 259, 265, 37 *U.S.P.Q.2d (BNA)* 1590, 1595 (9th Cir. 1996).

n78 *Id. at 264, 37 U.S.P.Q.2d (BNA) at 1595* (citing *Inwood Lab. v. Ives Lab.*, 465 *U.S.* 844, 854-55 (1982)).

n79 *Id. at 265, 37 U.S.P.Q.2d (BNA) at 1595.*

n80 *Id.*

n81 *Id.*

n82 Pub. L. No. 104-153, 110 Stat. 1386, 2 (1996).

n83 *Id.* 3.

n84 *Id.* 7.

n85 *Id.*

n86 *Id.* 6.

n87 69 *F.3d* 1360, 1364, 36 *U.S.P.Q.2d* (BNA) 1751, 1754 (7th Cir. 1995), cert. denied, 116 *S.Ct.* 1878 (1996).

n88 The plaintiff's "plausible narrative" went as follows: retail outlets typically will carry only one brand of broom (either plaintiff's or defendant's brand), and customers rarely take the time to examine the brooms before buying them. Suppose a customer buys one of plaintiff's brooms and likes it, but a year later it wears out. The customer goes to another store that only sells defendant's brooms. The customer sees a broom with contrasting color bands, assumes it is manufactured by the plaintiff, and buys it. The plaintiff suffers a harm from the lost sales. *Id.* at 1362, 36 *U.S.P.Q.2d* (BNA) at 1752-53.

n89 *Id.* at 1364, 36 *U.S.P.Q.2d* (BNA) at 1754.

n90 *Conopco, Inc. v. Campbell Soup Co.*, 95 *F.3d* 187, 191, 40 *U.S.P.Q.2d* (BNA) 1042, 1044 (2d Cir. 1996).

n91 *Id.* at 195, 40 *U.S.P.Q.2d* (BNA) at 1048.

n92 *Id.* at 191, 40 *U.S.P.Q.2d* (BNA) at 1045.

n93 *Id.* at 192, 40 *U.S.P.Q.2d* (BNA) at 1045.

n94 *Id.* at 193, 40 *U.S.P.Q.2d* (BNA) at 1046.

n95 929 *F. Supp.* 262, 40 *U.S.P.Q.2d* (BNA) 1130 (E.D. Mich. 1996).

n96 *Id.* at 268-69, 40 *U.S.P.Q.2d* (BNA) at 1136.

n97 *Id.* at 265, 40 *U.S.P.Q.2d* (BNA) at 1133.

n98 *Id.* at 266, 40 *U.S.P.Q.2d* (BNA) at 1133.

n99 86 *F.3d* 619, 620, 39 *U.S.P.Q.2d* (BNA) 1181, 1181-82 (6th Cir. 1996), cert. denied, 117 *S.Ct.* 770 (1997).

n100 *Id.* at 625, 39 *U.S.P.Q.2d* (BNA) at 1186.

n101 *Id.* at 623, 39 *U.S.P.Q.2d* (BNA) at 1184.

n102 *Id.* at 625, 39 *U.S.P.Q.2d* (BNA) at 1186.

n103 *Id.*

n104 930 *F. Supp.* 1502, 40 *U.S.P.Q.2d* (BNA) 1444 (M.D. Fla. 1996).

n105 *Id.* at 1506, 40 *U.S.P.Q.2d* (BNA) at 1446-47.

n106 *Id.* at 1506, 40 *U.S.P.Q.2d* (BNA) at 1447.

n107 960 *F. Supp.* 1438, 41 *U.S.P.Q.2d* (BNA) 1811 (C.D. Cal. 1996).

n108 *Id.* at 1445, 41 *U.S.P.Q.2d* (BNA) at 1818.

n109 *Id.* at 1444, 41 *U.S.P.Q.2d* (BNA) at 1816.

n110 *Id.* at 1443, 41 *U.S.P.Q.2d* (BNA) at 1816.

n111 *Id.* at 1443-44, 41 *U.S.P.Q.2d* (BNA) at 1816.

n112 *Id.* at 1445, 41 *U.S.P.Q.2d* (BNA) at 1818.

n113 15 *U.S.C.A.* 1125 (Supp. 1997)

n114 141 Cong. Rec. S19310 (daily ed. Dec. 29, 1995) (statement by Sen. Hatch).

n115 15 *U.S.C.A.* 1125(c)(1) (Supp. 1997).

n116 *Id.*

n117 15 *U.S.C.A.* 1127 (Supp. 1997).

n118 "Blurring" occurs where "the defendant uses or modifies the plaintiff's trademark to identify the defendant's goods and services, raising the possibility that the mark will lose its ability to serve as a unique identifier of the plaintiff's product." *Deere & Co. v. MTD Prods., Inc.*, 41 *F.3d* 39, 43, 32 *U.S.P.Q.2d* (BNA) 1936, 1938 (2d Cir. 1994) (emphasis omitted).

n119 "Tarnishment" occurs where "the plaintiff's trademark is linked to products of shoddy quality, or is portrayed in an unwholesome or unsavory context likely to evoke unflattering thoughts about the owner's product." *Id.* at 43, 32 *U.S.P.Q.2d* (BNA) at 1939.

n120 141 Cong. Rec. S19310 (daily ed. Dec. 29, 1995) (statement by Sen. Hatch).

n121 15 *U.S.C.A.* 1125(c)(4) (Supp. 1997).

n122 H.R. Rep. No. 374, 104th Cong., 1st Sess. 4 (1995), reprinted in 1995 *U.S.C.C.A.N.* 1029, 1031.

n123 40 *U.S.P.Q.2d* (BNA) 1836 (N.D. Cal. 1996).

n124 *Id.* at 1838.

n125 *Id.*

n126 *Id.* at 1839.

n127 *Ringling Bros.-Barnum & Bailey, Combined Shows, Inc. v. Utah Div. Travel Dev.*, 935 *F. Supp.* 763, 765-66, 40 *U.S.P.Q.2d* (BNA) 1303, 1305 (E.D. Va. 1996).

n128 *Id.* at 766-67, 40 *U.S.P.Q.2d* (BNA) at 1305-06.

n129 *Id.* at 765-66, 40 *U.S.P.Q.2d* (BNA) at 1305-06.

n130 40 *U.S.P.Q.2d* (BNA) 1629 (E.D. Pa. 1996), *aff'd* without opinion, 116 *F.3d* 471 (3d Cir. 1997).

n131 *Id.* at 1633.

n132 *Id.* at 1632.

n133 *Id. at 1633.*

n134 *Id.*

n135 947 *F. Supp. 1227, 40 U.S.P.Q.2d (BNA) 1412, 41 U.S.P.Q.2d (BNA) 1223 (N.D. Ill. 1996).*

n136 *Id. at 1240, 40 U.S.P.Q.2d (BNA) at 1422.*

n137 *Id.*

n138 *Id. at 1240, 40 U.S.P.Q.2d (BNA) at 1423.*

n139 945 *F. Supp 1296, 1302-04, 40 U.S.P.Q.2d (BNA) 1908, 1913-14 (C.D. Cal. 1996).*

n140 *Id. at 1303, 40 U.S.P.Q.2d (BNA) at 1913.*

n141 *Id. at 1304, 40 U.S.P.Q.2d (BNA) at 1914.*

n142 39 *U.S.P.Q.2d (BNA) 1545 (S.D. Miss. 1996), aff'd, 1997 U.S. App. LEXIS 24417 (5th Cir. 1997).*

n143 *Id. at 1550-51.*

n144 "This test includes a variety of factors including but not limited to (1) similarity of products, (2) identity of retail outlets and purchasers, (3) identity of advertising media, (4) type (i.e., strength) of trademark or trade dress, (5) defendant's intent, (6) similarity of design, (7) actual confusion, (8) degree of care exercised by purchasers." *Id. at 1552.*

n145 *Id. at 1554.*

n146 *Id. at 1555.*

n147 937 *F. Supp. 204, 40 U.S.P.Q.2d (BNA) 1010 (S.D.N.Y. 1996).*

n148 *Id. at 211, 40 U.S.P.Q.2d (BNA) at 1016.*

n149 *Id. at 212, 40 U.S.P.Q.2d (BNA) at 1016.*

n150 *Id. at 214, 40 U.S.P.Q.2d (BNA) at 1019.*

n151 924 *F. Supp. 1559 (S.D. Cal. 1996), aff'd, 109 F.3d 1394, 42 U.S.P.Q.2d (BNA) 1184 (9th Cir. 1997).*

n152 *Id. at 1574.*

n153 39 *U.S.P.Q.2d (BNA) 1953, 1954 (T.T.A.B. 1996).*

n154 *Coastal Communs. Corp. v. Adams/Laux Co., 40 U.S.P.Q.2d (BNA) 1383 (S.D.N.Y. 1996).*

n155 *Id. at 1384.*

n156 *Alto Prods. Corp. v. Ratek Indus. Ltd., 40 U.S.P.Q.2d (BNA) 1738, 1745 (S.D.N.Y. 1996).*

n157 *Id.*

n158 86 *F.3d 1379, 39 U.S.P.Q.2d (BNA) 1411 (5th Cir. 1996).*

n159 *Id. at 1389, 39 U.S.P.Q.2d (BNA) at 1419-20.*

n160 *Id. at 1386, 39 U.S.P.Q.2d (BNA) at 1417.*

n161 *Id. at 1384, 39 U.S.P.Q.2d (BNA) at 1415.*

n162 *Id. at 1386, 39 U.S.P.Q.2d (BNA) at 1417.*

n163 *40 U.S.P.Q.2d (BNA) 1840, 1843 (Cal. Super. 1996).*

n164 *Id.*

n165 *Id. at 1844.*

n166 *85 F.3d 407, 408 (9th Cir. 1996).*

n167 *Id. at 408.*

n168 *Id. at 416.*

n169 *EFS Mktg., Inc. v. Russ Berrie & Co., 76 F.3d 487, 490, 37 U.S.P.Q.2d (BNA) 1646, 1649 (2d Cir. 1996) (citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769-70 (1992)).*

n170 *Landscape Forms, Inc. v. Columbia Cascade Co., 113 F.3d 373, 377, 42 U.S.P.Q.2d (BNA) 1641, 1644 (2d Cir. 1996).*

n171 *921 F. Supp. 1065, 1067, 38 U.S.P.Q.2d (BNA) 1024, 1026 (S.D.N.Y. 1996).*

n172 *Id. at 1071, 38 U.S.P.Q.2d (BNA) at 1029.*

n173 *Id.*

n174 *Id. at 1072, 38 U.S.P.Q.2d (BNA) at 1030.*

n175 *Id.*

n176 *76 F.3d 481, 37 U.S.P.Q.2d (BNA) 1646 (2d Cir. 1996).*

n177 *Id. at 489, 37 U.S.P.Q.2d (BNA) at 1647-48.*

n178 *Id. at 491, 37 U.S.P.Q.2d (BNA) at 1649.*

n179 *Id. at 491, 37 U.S.P.Q.2d (BNA) at 1649-50.*

n180 *916 F. Supp. 322, 38 U.S.P.Q.2d (BNA) 1819 (S.D.N.Y. 1996).*

n181 *Id. at 328, 38 U.S.P.Q.2d (BNA) at 1823.*

n182 *Id.*

n183 *Id.*

n184 *Id. at 330, 38 U.S.P.Q.2d (BNA) at 1824.*

n185 *915 F. Supp. 595, 40 U.S.P.Q.2d (BNA) 1334 (S.D.N.Y. 1996).*

n186 *568 F.2d 1342, 1344, 196 U.S.P.Q. (BNA) 289, 291 (C.C.P.A. 1977).*

n187 *Krueger Int'l., Inc., 915 F. Supp. at 607, 40 U.S.P.Q.2d (BNA) at 1343.*

n188 *Id. at 603, 40 U.S.P.Q.2d (BNA) at 1340.*

n189 *Id. at 607, 40 U.S.P.Q.2d (BNA) at 1343.*

n190 *Id. at 608, 40 U.S.P.Q.2d (BNA) at 1344.*

n191 *Id.*

n192 *Id. at 607, 40 U.S.P.Q.2d (BNA) at 1343.*

n193 *Fun-Damental Too, Ltd. v. Gemmy Indus. Corp., 111 F.3d 993, 1001, 42 U.S.P.Q.2d (BNA) 1348, 1354 (2d Cir. 1996).*

n194 *Id. at 1001, 42 U.S.P.Q.2d (BNA) at 1354.*

n195 *Id. at 1005, 42 U.S.P.Q.2d (BNA) at 1357.*

n196 *Id. at 1007, 42 U.S.P.Q.2d (BNA) at 1359.*

n197 *98 F.3d 1358, 40 U.S.P.Q.2d (BNA) 1939, 1943 (Fed. Cir. 1996).*

n198 *Id., 40 U.S.P.Q.2d (BNA) at 1942 n.6.*

n199 *Id., 40 U.S.P.Q.2d (BNA) at 1943.*

n200 *Id.*

n201 *99 F.3d 1034, 40 U.S.P.Q.2d (BNA) 1705 (11th Cir. 1996).*

n202 *Id. at 1042, 40 U.S.P.Q.2d (BNA) at 1710.*

n203 *Id. at 1040-41, 40 U.S.P.Q.2d (BNA) at 1709-10.*

n204 *In re Polk's Model Craft Hobbies Inc., 40 U.S.P.Q.2d (BNA) 1711, 1729 (Bankr. D.N.J. 1995).*

n205 *Id. at 1725.*

n206 *Id. at 1725-26.*

n207 *Id. at 1726.*

n208 *40 U.S.P.Q.2d (BNA) 1239 (N.D. Ill. 1995).*

n209 *Id.*

n210 *Id. at 1246.*

n211 *Id. at 1247-48.*

n212 *Id. at 1250.*

n213 *76 F. 3d 380, 1996 U.S. App. LEXIS 3473, at *2-4 (6th Cir. Jan. 26, 1996), cert. denied, 117 S.Ct. 298 (1996).*

n214 *Id. at *11-12.*

n215 *Id. at *16.*

n216 *Id. at *17.*

n217 *Id. at *18.*

n218 *76 F.3d 743, 745-46, 37 U.S.P.Q.2d (BNA) 1779, 1781 (6th Cir. 1996).*

n219 *Id. at 747-48, 37 U.S.P.Q.2d (BNA) at 1782-83.*

n220 *Id. at 748, 37 U.S.P.Q.2d (BNA) at 1783.*

n221 *Id. at 749-50, 37 U.S.P.Q.2d (BNA) at 1784.*

n222 *94 F.3d 376, 377-78, 39 U.S.P.Q.2d (BNA) 1990, 1991-92 (7th Cir. 1996).*

n223 *Id. at 382, 39 U.S.P.Q.2d (BNA) at 1995.*

n224 *Id. at 383, 39 U.S.P.Q.2d (BNA) at 1995-96.*

n225 *Id. at 383-84, 39 U.S.P.Q.2d (BNA) at 1996.*

n226 *1996 U.S. Dist. LEXIS 6137 (N.D. Ill. May 7, 1996).*

n227 *Id. at *18.*

n228 *Id. at *6.*

n229 *Id. at *11.*

n230 *Id. at *13.*

n231 *Id. at *20, 22.*

n232 *913 F. Supp. 1246 (W.D. Ark. 1996).*

n233 *Id. at 1251.*

n234 *Id. at 1252.*

n235 *Id. at 1252-53.*

n236 *Id. at 1254.*

n237 *Id. at 1255-56.*

n238 *79 F.3d 258, 263, 38 U.S.P.Q.2d (BNA) 1202, 1205 (2d Cir. 1996).*

n239 *Id. at 263, 38 U.S.P.Q.2d (BNA) at 1205.*

n240 *Id. at 264, 38 U.S.P.Q.2d (BNA) at 1206.*

n241 *Benjamin Moore & Co. v. Talon Paints Prods., Inc., 917 F. Supp. 331, 334-35 (D.N.J. 1996), aff'd, 111 F.3d 125 (3d Cir. 1997).*

n242 *Id. at 336.*

n243 *Id. at 333.*

n244 *Id.*

n245 "The most common and effective means of appraising intended purchasers of the source of goods is a prominent disclosure on the container, package, wrapper, or label of the manufacturer's or trader's name." *50 F.3d 189, 203, 33 U.S.P.Q.2d (BNA) 1801, 1811 (3d Cir. 1995), cert. denied, 116 S.Ct. 54 (1995).*

n246 *Benjamin Moore & Co., 917 F. Supp. at 333.*

n247 *Id. at 334.*

n248 *Id. at 333.*

n249 *Id. at 336.*

n250 *Shakespeare Co. v. Silstar Corp. of America*, 906 F. Supp. 997, 1015, 37 U.S.P.Q.2d (BNA) 1481, 1494 (D.S.C. 1995), *aff'd*, 110 F.3d 234 (4th Cir. 1997), 42 U.S.P.Q. 2d (BNA) 1266.

n251 *Id. at 1011*, 37 U.S.P.Q.2d (BNA) at 1490-91.

n252 *Id. at 1015*, 37 U.S.P.Q.2d (BNA) at 1495.

n253 *Id. at 1003-04*, 37 U.S.P.Q.2d (BNA) at 1484.

n254 *Id. at 1016*, 37 U.S.P.Q.2d (BNA) at 1495.

n255 *Tools USA & Equip. Co. v. Champ Frame Straightening Equip., Inc.*, 87 F.3d 654, 658, 39 U.S.P.Q.2d (BNA) 1355, 1358 (4th Cir. 1996).

n256 *Id. at 662*, 39 U.S.P.Q.2d (BNA) at 1362.

n257 *Id.*

n258 *Id. at 658*, 39 U.S.P.Q.2d (BNA) at 1358.

n259 *Sazerac Co.*, 37 U.S.P.Q.2d (BNA) at 1732-33.

n260 *Id. at 1733.*

n261 *Id.*

n262 931 F. Supp. 645, 653, 42 U.S.P.Q.2d (BNA) 1596, 1602 (W.D. Mo. 1996).

n263 *Id. at 649*, 42 U.S.P.Q.2d (BNA) at 1599.

n264 *Id. at 650*, 42 U.S.P.Q.2d (BNA) at 1600.

n265 *Id.*

n266 *Id. at 653*, 42 U.S.P.Q.2d (BNA) at 1602.

n267 The court held that, absent a showing of inherent distinctiveness or secondary meaning, the fact that certain consumers are likely to be confused by an alleged trade dress infringement does not render the overall look of the products protectable trade dress. 913 F. Supp. 1454, 1476 (D. Kan. 1996).

n268 The court held that summary judgment is appropriate for a trade dress claim where there is insufficient evidence to proceed on the mere hope of finding evidence to support inherent distinctiveness, secondary meaning, non-functionality, or likelihood of confusion. 1995 U.S. Dist. LEXIS 19320, at *12-14 (D. Kan. Nov. 30, 1995).

n269 The court enjoined the defendant from infringing on the trade dress of the plaintiff after finding that all three elements of trade dress infringement were met. 913 F. Supp. 1559, 1568, 38 U.S.P.Q.2d (BNA) 1118, 1125 (S.D. Fla. 1996), *aff'd*, 112 F.3d 1125 (11th Cir. 1997).

n270 The court reversed part of a jury's verdict because the verdict as to the plaintiff's design patent infringement, trade dress infringement, and unfair competition claims was not supported by substantial evidence. 67 F.3d 1571, 1573, 36 U.S.P.Q.2d (BNA) 1417, 1418 (Fed. Cir. 1995).

n271 75 *F.3d* 75, 37 *U.S.P.Q.2d* (BNA) 1652 (1st Cir. 1996).

n272 *Id.* at 78, 37 *U.S.P.Q.2d* (BNA) at 1653-54.

n273 *Id.* at 81, 37 *U.S.P.Q.2d* (BNA) at 1656.

n274 *Id.* at 80, 37 *U.S.P.Q.2d* (BNA) at 1655.

n275 *Id.* at 80, 37 *U.S.P.Q.2d* (BNA) at 1655-56.

N276 937 *F. Supp.* 295, 297, 40 *U.S.P.Q.2d* (BNA) 1519, 1520 (S.D.N.Y. 1996).

n277 *Id.*

n278 *Id.* at 299, 40 *U.S.P.Q.2d* (BNA) at 1522.

n279 *Id.* at 301, 40 *U.S.P.Q.2d* (BNA) at 1523.

n280 *Id.* at 301, 40 *U.S.P.Q.2d* (BNA) at 1524.

n281 947 *F. Supp.* 1328, 1337, 40 *U.S.P.Q.2d* (BNA) 1729, 1738 (E.D. Mo. 1996).

n282 *Id.* at 1331, 40 *U.S.P.Q.2d* (BNA) at 1733.

n283 *Id.* at 1333, 40 *U.S.P.Q.2d* (BNA) at 1734.

n284 *Id.* at 1333, 40 *U.S.P.Q.2d* (BNA) at 1734-35.

n285 *Id.* at 1337, 40 *U.S.P.Q.2d* (BNA) at 1738.

n286 94 *F.3d* 623, 40 *U.S.P.Q.2d* (BNA) 1028 (11th Cir. 1996).

n287 *Id.* at 627, 40 *U.S.P.Q.2d* (BNA) at 1031.

n288 *Id.* at 631, 40 *U.S.P.Q.2d* (BNA) at 1034.

n289 *Id.*

n290 *Id.* at 632, 40 *U.S.P.Q.2d* (BNA) at 1035.

n291 *Eugene Biro Corp. v. Empire Diamond Corp.*, 40 *U.S.P.Q.2d* (BNA) 1527, 1529 (S.D.N.Y. 1996).

n292 *Id.*

n293 *Id.* at 1530.

n294 *Id.*

n295 *Id.* at 1531.

n296 *Gasser Chair Co. v. Infanti Chair Mfg. Corp.*, 95 *F.3d* 1165, 40 *U.S.P.Q.2d* (BNA) 1700, 1701 (Fed. Cir. 1996).

n297 *Id.*, 40 *U.S.P.Q.2d* (BNA) at 1701.

n298 *Id.*

n299 See, e.g., *Malarkey-Taylor Assocs. Inc.*, 929 *F. Supp.* 473, 478, 40 *U.S.P.Q.2d* (BNA) at 1140.

n300 *Id.*

n301 Id.

n302 *WarnerVision Entertainment Inc. v. Empire of Carolina, Inc.*, 101 F.3d 259, 262, 40 U.S.P.Q.2d (BNA) 1855, 1857 (2d Cir. 1996).

n303 *Id.* at 262-63, 40 U.S.P.Q.2d (BNA) at 1858.

n304 *Id.* at 261-62, 40 U.S.P.Q.2d (BNA) at 1857.

n305 *Id.* at 262, 40 U.S.P.Q.2d (BNA) at 1857.

n306 Id.

n307 Id.

n308 *McClaran v. Plastic Indus., Inc.*, 97 F.3d 347, 361, 40 U.S.P.Q.2d (BNA) 1225, 1233 (9th Cir. 1996).

n309 *Id.* at 361, 40 U.S.P.Q.2d (BNA) at 1234.

n310 *Id.* at 362, 40 U.S.P.Q.2d (BNA) at 1234.

n311 77 F.3d 503, 37 U.S.P.Q.2d (BNA) 1722, 1725 (Fed. Cir. 1996).

n312 15 U.S.C.A. 1117(a) (1963 & Supp. 1997).

n313 *Sunmark, Inc. v. Ocean Spray Cranberries, Inc.*, 40 U.S.P.Q.2d (BNA) 1213, 1215 (N.D. Ill. 1996).

n314 *Id.* at 1215.

n315 Id.

n316 *Id.* at 1216.

n317 104 F. 3d 353, 1996 U.S. App. LEXIS 30737 (2d Cir. 1996).

n318 *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 36 U.S.P.Q.2d (BNA) 1737 (2d Cir. 1995).

n319 104 F. 3d 353, 1996 U.S. App. LEXIS 30737, at *3.

n320 Id. at *5-6.

n321 The court affirmed the trial court's award of monetary sanctions against the appellants and permanently prohibited the appellant from appearing before the court pro hac vice in the future. 78 F.3d 550, 554, 39 U.S.P.Q.2d (BNA) 1090, 1091-92 (Fed. Cir. 1996), cert. denied, 117 S.Ct 360 (1996).

n322 *Anheuser-Busch, Inc. v. Andy's Sportswear, Inc.*, 40 U.S.P.Q.2d (BNA) 1542, 1543 (N.D. Cal. 1996).

n323 Id.

n324 Id.

n325 Id.

n326 99 F.3d 795, 40 U.S.P.Q.2d (BNA) 1545 (6th Cir. 1996).

n327 *Id.* at 798, 40 U.S.P.Q.2d (BNA) at 1547.

n328 *Id. at 804, 40 U.S.P.Q.2d (BNA) at 1552.*

n329 *Id.*

n330 *Id. at 806, 40 U.S.P.Q.2d (BNA) at 1553.*