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Civil Cases

Bd. of Supervisors for La. State Univ. v. Smack Apparel Co., 2008 WL 4981326 (5th Cir. Nov. 25, 2008)

by Margaret A. Esquenet

ABSTRACT

Universities sued T-shirt maker over shirts that incorporated school colors together with other facts and indicia about the schools, such as sports accomplishments and geographic location. The Fifth Circuit upheld the district court's finding that the T-shirt maker's use of those elements constituted trademark infringement, even if neither the school names nor other school-related marks or logos were included on the products.

CASE SUMMARY

FACTS

Louisiana State University, the University of Oklahoma, Ohio State University, and the University of Southern California, together with their licensing agent (collectively the "Universities"), brought a trademark infringement action against Smack Apparel Company ("Smack") alleging that Smack's use on T-shirts of their respective school color schemes, together with references to other facts about each school, created a likelihood of confusion. The Universities, each with established and successful athletic programs, particularly American football, argued that Smack infringed their trademark rights by using their century-old color schemes on T-shirts, together with references to one or more of: (1) well-known athletic events in which the university participated, (2) the university's opponent in a particular event or a known rival, (3) the geographic area in which the event took place, (4) titles and honors bestowed on the university as a result of the event, (5) the university's past athletic accomplishments, and/or (6) the geographic area in which the university was located. The Universities alleged that Smack's products were identical to and competed directly with the Universities' own officially licensed products. The Eastern District of Louisiana agreed, granting summary judgment in favor of the Universities and holding that Smack's use of the schools' color schemes and other indicia constituted trademark infringement. Smack appealed. The Fifth Circuit, reviewing the grant of summary judgment de novo, affirmed the district court's decision.

ANALYSIS

Noting that colors—both alone and in combination with other elements—may be protectable trademarks, the Fifth Circuit evaluated the Universities' arguments under its eight-factor likelihood-of-confusion test.

In view of Smack's concession that the Universities' color schemes were well known and used to identify the respective plaintiffs, and the fact that their respective color schemes had been in use for more than 100 years, the court found the Universities' marks to be strong. Notwithstanding that "all third party use of a mark, not just use in the same industry as a plaintiff, may be relevant to whether a plaintiff's mark is strong or weak," the court rejected Smack's argument that third-party uses of similar color schemes weakened the Universities' rights in their marks, finding Smack's evidence to fall short of the "extensive" use required to weaken a trademark and negate a likelihood of confusion.

Evaluating the similarity of the marks and the similarity of the goods, the Fifth Circuit rejected Smack's attempt to distinguish between the parties' respective "marks" based upon the fact that none of its T-shirts were identical to those licensed by the Universities and its text was less conservative and more creative than what was available on the Universities' licensed merchandise. The court held that the colors used by Smack were identical to the Universities' color schemes and that the schools themselves also used indicia such as references to events, game scores, and humorous taunts against rivals on identical merchandise.

Regarding the issue of intent, while Smack conceded that it used the colors and other indicia to identify each respective school, it argued that an intent to copy is not the same as an intent to confuse. The court rejected this argument, finding that Smack did not hope to sell its T-shirts based on quality or design differences, but rather to capitalize on the popularity of the Universities' football programs and the appearances of the schools' teams in the various bowl games. The court further held that the adoption of a mark "with the intent of deriving benefit from the reputation of the mark holder" qualifies as strong evidence of a likelihood of confusion.

Smack further argued that it did not intend to infringe because the inclusion of its own mark and name on products distinguished them from the Universities' licensed products and acted as a form of disclaimer, negating any intent to confuse. The court rejected this argument as well, noting that all merchandise licensed by the Universities must include the name of the licensee, making it more likely that a consumer seeing the Smack label would believe that Smack was an official licensee.

The court also carefully considered the degree of care exercised by the parties' consumers. Noting that the parties agreed that their T-shirts are inexpensive impulse items offered in identical channels of trade, which increases the risk of confusion, the court rejected Smack's claim that the Universities should be required to show that consumers prefer officially licensed T-shirts over unlicensed products. Importantly, the court distinguished the well-known decision of *Supreme Assembly, Order of Rainbow for Girls v. J.H. Rey Jewelry Co.*, 676 F.2d 1079 (5th Cir. 1982), which held that retailer J.H. Rey did not infringe the fraternal organization's registered trademark when it sold necklaces bearing its official Rainbow emblem. The court here found that consumers expect the Universities to license merchandise, whereas consumers do not expect fraternal organizations to do so. Accordingly, unlike in *Rainbow for Girls*, use of the school colors together with the other indicia would lead consumers to believe that the goods were endorsed, sponsored, or approved by the Universities.

After analyzing the relevant likelihood-of-confusion factors and finding in favor of the Universities, the court considered and ultimately rejected each of Smack's defenses.

The court first rejected Smack's arguments that the Universities' marks were functional and thus not protectable as trademarks, noting that the doctrine of aesthetic functionality—the only form of

functionality that might apply to the Universities' color scheme marks—has been rejected in the Fifth Circuit. Indeed, the court disparaged Smack's reliance on *TrafFix v. Marketing Displays, Inc.*, 532 U.S. 23 (2001), for the proposition that aesthetic functionality was recognized by the Supreme Court, noting that the *TrafFix* decision has been widely criticized as mischaracterizing the opinion in *Qualitex Co. v. Jacobsen Products Co.*, 514 U.S. 159 (1995).

The panel also rejected Smack's nominative fair use defense, holding that although Smack used the Universities' color scheme combination marks to identify the Universities as the subject of the T-shirts, it did so in a way that "improperly suggested affiliation, sponsorship, or endorsement." Finally, notwithstanding the fact that one of the schools actually sold certain Smack T-shirts in its on-campus student bookstore, the court held that Smack's intentional copying—a form of bad faith—precluded the application of a laches defense.

Finally, the appellate court upheld the district court's decision to deny the Universities' request for attorney's fees, holding that this case was not "exceptional" within the meaning of the Lanham Act because it involved novel legal issues.

CONCLUSION

The Fifth Circuit's analysis provides a blueprint for companies seeking to use sports-team color schemes in connection with unlicensed products or services. It is important to note that because Smack's products also contained specific information and indicia relating to each school, the court did not address the issue of whether use of the Universities' color schemes alone, without the other indicia, would have constituted infringement.

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Civil Cases

Dress for Success Worldwide v. Dress 4 Success, 2008 WL 5137010 (S.D.N.Y. Dec. 5, 2008)

by Naresh Kilaru

ABSTRACT
In deciding cross-motions for a preliminary injunction, the Southern District of New York evaluated whether a licensee could resume use of its former name following entry into a license to use a substantially identical name and the subsequent termination of that license. In granting a preliminary injunction in favor of the licensor, the court held that any common law rights a licensee may have held in its former name were extinguished by the "merger rule," pursuant to which a licensee relinquishes any independent rights it may have had in a licensed name upon entering into a license, as those rights are merged into the license and inure to the licensor's benefit.

CASE SUMMARY

FACTS
Plaintiff Dress for Success Worldwide ("Worldwide"), an international nonprofit organization that provides disadvantaged women with business attire and career support services, owns the federally registered trademark DRESS FOR SUCCESS. Defendant Dress 4 Success ("D4S") operated independently in the Los Angeles area under the substantially identical name DRESS 4 SUCCESS. Each organization commenced use of its respective marks at approximately the same time.

In 2001, the parties executed a multiyear affiliation agreement pursuant to which D4S entered into a trademark license with Worldwide to use the name DRESS FOR SUCCESS LOS ANGELES. Following the termination of that license in 2008 for alleged poor performance, D4S resumed operations under its former name DRESS 4 SUCCESS. Worldwide sued for trademark infringement and moved to preliminarily enjoin D4S from using the DRESS 4 SUCCESS name and exploiting confusion over the organizations' names following termination of the license. D4S cross-moved to preliminarily enjoin Worldwide from using its DRESS FOR SUCCESS mark in the Los Angeles area. For the purpose of deciding the parties' motions, Worldwide stipulated that D4S had prior common law rights in its DRESS 4 SUCCESS mark in the Los Angeles area.

ANALYSIS
In granting Worldwide's motion for a preliminary injunction and denying D4S's cross-motion, the court held that any prior common law trademark rights D4S may have owned in its DRESS 4 SUCCESS mark

were extinguished upon its entry into a license agreement with Worldwide pursuant to the “merger rule.” The merger rule provides that a licensee relinquishes any independent rights it may have in a licensed mark upon entry into a license agreement for that same or a substantially identical mark. The rule recognizes that, by definition, entry into a license requires that a licensee acknowledge that the licensor owns the mark that is the subject of the license and, further, that the licensee’s rights are derived from the licensor. The court noted that while the validity of the merger rule was a question of first impression in the Second Circuit, the Fourth Circuit and several district courts in other circuits had applied the rule under similar facts. The court found that D4S could not meaningfully distinguish any of these prior decisions, and also noted D4S’s failure to cite any case expressly rejecting the rule. Further, the court rejected D4S’s argument that the rule should not be applied in situations where the parties’ marks are not identical, citing a prior decision from the Central District of Illinois that applied the rule to “substantially identical” marks.

Because D4S relinquished any common law rights it had in the DRESS 4 SUCCESS mark upon entry into a license with Worldwide, the court held that D4S could not rely on such rights as a defense to infringement of Worldwide’s federally registered trademark. Noting D4S’s concession that a likelihood of confusion existed between its DRESS 4 SUCCESS and Worldwide’s DRESS FOR SUCCESS marks based on both the similarity of the parties’ marks and the similarity of their services, the court had little trouble finding that Worldwide was likely to succeed on the merits of its trademark infringement claim. The court also noted that irreparable harm is automatically presumed in licensor-licensee disputes once the plaintiff has demonstrated unlawful use of its mark and consumer confusion.

CONCLUSION

Trademark licensees with prior rights in a licensed mark (or in a substantially identical mark) should be aware of the merger rule prior to entry into a license agreement. If the licensee’s bargaining position permits, a licensee may consider contractually opting out of the rule, particularly in situations where the licensee has prior rights in a limited geographic area and wants to preserve those rights upon expiration or termination of the license.

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Grocery Outlet Inc. v. Albertsons, Inc., 2008 WL 5245962 (N.D. Cal. Dec. 17, 2008)

by Kenneth H. Leichter

ABSTRACT

The Northern District of California held that the declaratory judgment defendant had not abandoned its rights in the LUCKY trademark, even though it made only limited use of the mark between 1999 and 2005, and ceased use of the mark altogether in 2005. The court found that the sell-off of existing merchandise bearing the mark constituted use for purposes of avoiding abandonment and that the mark owner had established an intent to resume use of the mark.

CASE SUMMARY

FACTS

In 1998, defendant Albertsons, Inc. ("Albertsons") merged with the owner of the LUCKY brand of grocery products and supermarket and grocery store services. Following the merger, Albertsons decided to rebrand all of the existing LUCKY stores with the ALBERTSONS name and, although Albertsons never unequivocally announced that it would cease use of the LUCKY mark, it was clear that the new postmerger brand name for the store and its products was to be ALBERTSONS. By November 1999, all former LUCKY stores were converted to ALBERTSONS stores.

Nevertheless, Albertsons continued using the LUCKY mark in a limited manner after the conversion of LUCKY stores. Specifically, Albertsons continued to sell LUCKY brand private label merchandise in its stores for several years in an effort to use up existing LUCKY branded inventory and packaging. Also, on the advice of counsel, Albertsons created a few signs featuring the LUCKY mark for the purpose of supporting the renewal of its trademark registrations. Albertsons also maintained the registration of the luckystores.com domain name and made general efforts to police the LUCKY mark.

In 2001, Albertsons commissioned research to determine if there was any residual goodwill in the LUCKY mark and assembled focus groups to evaluate the loss of LUCKY customers as a result of the name change. Also in 2001, Albertsons explored the possibility of using the LUCKY mark for a new line of stores targeted at specific ethnic markets. In 2004, Albertsons created a business plan that included the proposed opening of California stores targeted at Hispanic customers and the development of warehouse-type "price impact" stores, both under the LUCKY banner. By the time of the decision, Albertsons had begun operating and rebranding many stores under the LUCKY name in both California

and Nevada.

Plaintiff Grocery Outlet Inc. ("Grocery Outlet"), an "extreme value grocer" operating in California, sought to open a number of grocery stores under the name LUCKY. In January 2006, Grocery Outlet filed an intent-to-use application for the LUCKY mark covering retail grocery store services and shortly thereafter opened its first grocery store under the LUCKY mark.

Grocery Outlet filed an action seeking a declaration that Albertsons had abandoned the LUCKY trademark and alleging trademark infringement based on Grocery Outlet's purported rights in the mark. Albertsons counterclaimed for a declaration of nonabandonment and for infringement by Grocery Outlet. The court granted Albertsons's request for a preliminary injunction in July 2006, finding that the mere sell-off of existing LUCKY inventory was insufficient to establish a continued bona fide commercial use of that mark, but that there was sufficient evidence to demonstrate Albertsons's intent to resume use of the LUCKY mark within the reasonably foreseeable future during the period of alleged nonuse. The Ninth Circuit affirmed at *Grocery Outlet Inc. v. Albertson's, Inc.*, 497 F.3d 949 (9th Cir. 2007). Albertsons subsequently moved for summary judgment on the ground that its sell-off of inventory constituted a continued bona fide commercial use of the LUCKY mark and that it intended to resume use of the mark within the period of nonuse.

ANALYSIS

The court held that a putative trademark infringer must prove both of two separate elements to show that a mark has been abandoned: that the trademark owner has ceased using the mark in dispute, and that it has done so with an intent not to resume its use. A showing of three years of consecutive nonuse creates a rebuttable presumption of an intent not to resume.

On the first factor—whether Albertsons ceased use of the LUCKY mark—the court noted that Albertsons made a concerted effort to remove the vestiges of the old LUCKY mark when it converted former LUCKY stores to ALBERTSONS stores in November 1999, and that its use of the mark since then had been somewhat limited. The court concluded that the precipitous drop in the number of LUCKY products sold over the years following the 1999 conversion was merely a sell-off of residual inventory, and the court had earlier ruled that a mere sell-off of inventory could not constitute use for purposes of withstanding an abandonment challenge.

However, since the time of the court's preliminary injunction ruling, the Ninth Circuit issued a decision holding that "the meaning of 'use' for the purposes of abandonment necessarily signifies 'use in commerce' and thus includes the placement of a mark on goods sold or transported." *Electro Source, LLC v. Brandess-Kalt-Aetna Group, Inc.*, 458 F.3d 931, 936 (9th Cir. 2006). The Ninth Circuit specifically rejected the argument that "attempts to merely 'rid oneself of inventory,' were not bona fide uses in the ordinary course of trade" because "abandonment requires *complete* cessation or discontinuance of trademark use . . . [and] even a single instance of use is sufficient against a claim of abandonment of a mark if such use is made in good faith." In view of the change in the law of abandonment in the Ninth Circuit, the court reversed its earlier ruling and held that evidence of Albertsons's continued sell-off of LUCKY branded inventory between 1999 and 2005 constituted a bona fide commercial use of that mark during those years.

The court did not credit evidence demonstrating that Albertsons displayed signage bearing the LUCKY mark on a few stores after the 1999 conversion, because the signage was erected solely on the advice of counsel for the purpose of maintaining an active trademark registration and such usage is not considered

use in the ordinary course of trade.

On the second abandonment factor—whether Albertsons demonstrated an intent not to resume use of the mark—the court held that the issue only arises at the point of cessation of use. The court again found that Albertsons's undisputed evidence demonstrated that it intended to resume use of the LUCKY mark. This evidence included internal discussions regarding the use of the mark for a Hispanic-themed neighborhood store or for a warehouse-type "price impact" store, discussions about rebranding such stores with a LUCKY brand storefront as early as 2001, and Albertsons's decision in 2004 to convert existing Albertsons stores to the LUCKY banner in California.

The court concluded that because Grocery Outlet was unable to demonstrate that Albertsons abandoned the LUCKY mark, it had by its own admission infringed Albertsons's trademark rights.

CONCLUSION

The court's decision demonstrates that even very limited use of a mark may be sufficient to avoid a finding of abandonment when combined with some demonstrable plans to resume use of that mark. It also suggests that actions undertaken on the advice of counsel solely for the purpose of maintaining a trademark registration may not be considered a bona fide commercial use sufficient to defeat a claim of abandonment.

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Civil Cases

Spiegel & Assocs. v. Spiegel, 2008 U.S. Dist. LEXIS 100558 (E.D. Va. Dec. 11, 2008)

by David M. Kelly

ABSTRACT

The Eastern District of Virginia denied plaintiff's motion for a preliminary injunction against defendant's use of the domain name spiegellaw.com for a law firm website based on plaintiff's prior use of the virtually identical domain name spiegelaw.com, also for a law firm website. Because the parties operated in different practice areas, clients and potential clients would immediately recognize if they had visited the wrong website. As a result, the risk of serious harm to plaintiff was low. In contrast, an injunction shutting down defendant's website would likely seriously harm defendant's practice.

CASE SUMMARY

FACTS

Plaintiff H. Jay Spiegel & Associates, a Virginia intellectual property law firm since 1989, registered the domain name spiegelaw.com in January 1999 and established a website at that domain a month later. Plaintiff federally registered the mark SPIEGELAW.COM on the Supplemental Register in 2000 and later registered the mark on the Principal Register in 2006. Defendant Steven Spiegel, a Virginia employment lawyer, created a website at spiegellaw.com in 2008, using the domain name apparently registered for him by his sister in March 1999. Both plaintiff and defendant maintained law offices in Alexandria, Virginia. Plaintiff became aware of defendant's website when an opposing lawyer sent plaintiff an email copied to defendant using a spiegellaw.com email address. Plaintiff then sent defendant a letter demanding that defendant shut down his website and transfer his domain name to plaintiff. Defendant refused and plaintiff filed this action for trademark infringement and unfair competition. Plaintiff also filed a motion to preliminarily enjoin defendant from using his spiegellaw.com domain name.

ANALYSIS

The court initially noted that preliminary injunctions are extraordinary remedies that should be granted sparingly, and that plaintiff had to make "a clear showing of irreparable harm" to establish entitlement to a preliminary injunction. The court then applied the Fourth Circuit's four-factor test for preliminary injunctions: (1) the likelihood of harm to plaintiff if an injunction is denied, (2) the likelihood of harm to defendant if an injunction is granted, (3) plaintiff's likelihood of success on the merits, and (4) the public interest. Applying these factors, the court denied plaintiff's motion.

For purposes of plaintiff's motion, the court assumed that plaintiff could show a likelihood of confusion, which created a presumption of irreparable harm. Plaintiff also argued that it will suffer actual harm in several ways. First, because its law practice is international in scope, many clients contact plaintiff through its website. Second, plaintiff expended "time and energy" to create its website and to update it over the past eight years.

The court agreed that defendant's use of the spiegellaw.com domain name "pose[d] some threat to the goodwill [p]laintiff has built up in his [spiegelaw.com] domain name" because the two names were "nearly identical" such that "some risk of confusion certainly exists." According to the court, "[i]ndividuals searching the Internet for [p]laintiff could be misled or diverted by [d]efendant's website." In addition, the court noted that persons given oral instructions to visit spiegelaw.com could be confused by the spelling of the domain name and "stumble onto" defendant's website instead of plaintiff's. And plaintiff submitted evidence that at least one person was confused by defendant's website.

The court was not convinced, however, that plaintiff would be harmed to "a significant extent" during the pendency of the litigation for several reasons. Primary among these was the noncompeting, specialized legal practices of each firm, such that a potential client searching for an IP attorney named Spiegel and finding defendant's website "would quickly realize he had located the wrong attorney." Moreover, noting the existence of the website www.spiegel-law.com for yet another law firm, the court found that defendant's website did not "pose a wholly novel threat" to potential clients' ability to locate plaintiff's site. As a result, "the actual possibility that potential clients will be confused in a way that leads to serious harm to [p]laintiff appears low." Nor was there any evidence that defendant had attempted to "poach" plaintiff's clients. Finally, the court gave little weight to the single, misdirected email.

In contrast, an injunction shutting down defendant's website "present[ed] a substantial likelihood of significant harm." Defendant used his website primarily in his capacity as class counsel in a large civil-rights class-action lawsuit, and he claimed that he spent 18 months planning the site before launching it earlier in the year. If required to shut down his website, defendant would lose the ability to communicate with geographically diverse members of the large class, which would "disrupt, perhaps severely," defendant's law practice and the interests of those he represented.

Regarding plaintiff's likelihood of success on the merits, the court noted that a stronger showing on the merits is required if the balance of hardships favors the defendant. Here, however, the court found that plaintiff's SPIEGELAW mark was likely descriptive, not suggestive as plaintiff argued, and there were questions at this early stage of the case whether secondary meaning existed and, if so, the extent of such secondary meaning. Accordingly, the court could not conclude that plaintiff was likely to win on the merits. Finally, the court found that the public interest did not clearly favor either party.

In sum, balancing the four preliminary injunction factors, the court denied plaintiff's motion because the balancing of harms favored defendant and plaintiff failed to show that it is likely to prevail on the merits to overcome the harm factor.

CONCLUSION

In contrast to the *Visa* case where the contextual differences between the parties' websites was deemed "largely irrelevant" to a dilution analysis, a different approach was applied in this infringement case. In addition to the balancing of harms favoring defendant, the court relied on the fact that the parties' websites offered different, noncompeting legal services to deny plaintiff's motion for preliminary

injunction.

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Civil Cases

Visa Int'l Serv. Ass'n v. JSL Corp., 2008 WL 5255813 (D. Nev. Dec. 16, 2008)

by David M. Kelly

ABSTRACT

Following two remands from the Ninth Circuit, the District of Nevada found that defendant's use of EVISA in both its domain name evisa.com and as a trademark on its website for an English-language school was likely to dilute the famous VISA mark for credit-card services. Defendant argued that its use of the EVISA mark was "easily and immediately" distinguishable from the VISA mark based on the context in which the two marks appeared. The court disagreed, holding that on its face, defendant's evisa.com domain name offered no such context, thus making the different contexts represented by the parties' websites "largely irrelevant" for purposes of assessing the similarity of the parties' marks.

CASE SUMMARY

FACTS

Plantiff Visa International Service Association ("Visa"), the global financial-services company that owns the trademark VISA for credit-card and other financial services, sued defendant regarding its registration and use of the domain name evisa.com and use of the mark EVISA in connection with an English-language school in Japan named "Eikaiwa Visa." In October 2002, the district court granted Visa's motion for partial summary judgment on its trademark dilution claim applying a likelihood-of-dilution standard. On appeal, the Ninth Circuit vacated and remanded the case to the district court in January 2004 based on the Supreme Court's intervening *Moseley v. V Secret Catalogue* decision in 2003, which established an actual dilution rather than likelihood-of-dilution standard. Following the remand, Congress enacted the Trademark Dilution Revision Act ("TDRA") in 2006, which specified a likelihood-of-dilution standard. The district court, however, still applied the prior Federal Trademark Dilution Act ("FDTA") on remand, based on the Ninth Circuit's decision in *Jada Toys v. Mattel* in which it applied the FTDA to a case filed before the TDRA's enactment. The district court again granted summary judgment for Visa on its dilution claim and defendant appealed. Following the district court's second grant of summary judgment, the Ninth Circuit reversed its prior ruling in *Jada Toys* and applied the TDRA, even though that case was filed before the TDRA's enactment. Based on that decision, Visa filed a motion for relief from the district court's final judgment based on the court's "mistake" in applying the FTDA instead of the TDRA. Pursuant to the district court's request, the Ninth Circuit remanded the case back to the district court to consider Visa's motion.

ANALYSIS

Applying the TDRA, the district court granted Visa's motion, finding that Visa met its burden of proof of showing that defendant's use of "evisa" as both a domain name and as a mark on its website created a likelihood of dilution with Visa's VISA mark. First, the court found that the VISA mark was famous on a nationwide scale based on evidence of the mark's length of use (the mark was widely advertised in various media for 25+ years); the duration, extent, and geographic reach of advertising and publicity under the mark (more than $1 billion spent on advertising in the United States from 1997-2000 alone); the extent of sales under the mark ($1.3 trillion in sales in 2006 alone and the VISA card was accepted at more than 6.3 million U.S. locations); consumer survey results (survey evidence showed a 99% level of aided recognition of the VISA mark and an 85% level of unaided recognition); and the mark's federal registration status (Visa owned 66 registrations for VISA-formative marks). The court also found that the VISA mark was arbitrary for financial and banking services, and thus was inherently distinctive.

Second, the court held that defendant made commercial use of the VISA mark. The Ninth Circuit previously held in *Thane International v. Trek Bicycle* that "the mark used by the alleged diluter must be identical, or nearly identical, to the protected mark." Moreover, in *Jada Toys II*, the Ninth Circuit stated that to be nearly identical, two marks "must be similar enough that a significant segment of the target group of customers sees the two marks as essentially the same." Here, the district court reiterated its earlier finding that the only difference between the two marks was defendant's addition of the letter "e" as a prefix, which was "commonly used to denote the online version of a business." Third, the court held that defendant commenced use of its mark after the VISA mark had become famous.

Fourth, applying the TDRA's six nonexclusive factors set forth in Section 43(c)(2)(B) of the Lanham Act, the court held that defendant's use of the EVISA mark and evisa.com domain name was likely to cause dilution by blurring the distinctiveness of the VISA mark. Regarding the degree-of-similarity factor, defendant argued that its EVISA mark was "easily and immediately distinguishable" from the VISA mark both "visually and intellectually" based on "the context on which the two marks actually appear." Defendant also argued that "when EVISA is taken in the context of the <evisa.com> website, that mark is remarkably dissimilar from the VISA mark." The court disagreed, however, pointing out that defendant's use of the EVISA mark was *not* limited to the content of its website. Rather, because defendant also used the EVISA mark as the domain name for its website, defendant "used the EVISA mark in a setting where context-specific factors, such as the appearance of [d]efendant's homepage, are largely irrelevant." Accordingly, in the context of a domain name, the court found that the VISA and EVISA marks were "very similar."

The remaining blurring factors also favored VISA or were neutral. The VISA mark was arbitrary and had a "moderately high" level of inherent distinctiveness. As to whether Visa engaged in substantially exclusive use of the VISA mark, although defendant failed to present any evidence of third-party use of VISA as a trademark, the court noted that it was Visa's burden to show the absence of a genuine issue of material fact. The court thus deemed this factor neutral. The VISA mark also carried a "very high degree of recognition" with the general public based on the consumer survey evidence noted above. However, there was no evidence that defendant intended to create an association with the famous VISA mark. The court pointed to defendant's submission of evidence that its owner selected the EVISA mark as a contraction of the words "Eikaiwa Visa," the name of defendant's language school, and that he selected "Eikaiwa Visa" because "Eikaiwa" is the Japanese word for English and the word "visa" connoted "the ability to travel, both linguistically and physically, through the English-speaking world." This factor thus weighed against a finding of blurring.

Regarding the factor of whether there is "any actual association" between the EVISA and VISA marks, Visa submitted a survey showing that 73% of survey respondents "mentioned VISA when asked whether EVISA reminded them of another brand name." Defendant argued that this survey was inadmissible because it "completely removed the context within which the survey responder could relate the image to anything and was specifically not reproduced in the context of how they would have come to the page reflecting the 'evisa' image," and it was "presented only to business owners, and not to consumers, which is not comparable to the relevant population-[defendant's] consumer/customers." The court rejected these arguments because the survey did present the EVISA mark in the context of defendant's website as it appeared shortly before Visa filed this lawsuit in 2001, and defendant in discovery stated that its customers, with one exception, were businesses.

The court also discussed a prior Ninth Circuit dilution case decided under the FTDA, *Panavision*, in which the court held that the defendant's use of the domain name panavision.com diluted the plaintiff's PANAVISION mark because a "significant purpose of a domain name is to identify the entity that owns the website." The court found *Panavision*'s reasoning "still persuasive" here to defendant's EVISA mark, especially given the common use of the letter "e" to denote the online version of a business.

In sum, the four blurring factors that favored Visa constituted "an exceptionally strong showing" that supported the conclusion that the EVISA mark was likely to cause blurring of the VISA mark as a matter of law. In doing so, the court noted that the degree to which consumers actually associated the EVISA and VISA marks was a more important factor than defendant's intent to create such an association. It also held that Visa's failure to submit any evidence regarding the extent to which it was engaged in substantially exclusive use of the VISA mark was not fatal, noting that the blurring factors were "discretionary and nonexclusive," and "the inherent difficulty of proving the nonexistence of a fact, that is, that there are not others using the VISA mark."

The court thus enjoined defendant from using or registering the EVISA mark and from using the evisa.com domain name.

CONCLUSION

Although the website context in which a mark is used is often relevant in a trademark infringement analysis, the same is not necessarily true for trademark dilution claims involving domain names. When the similarity-of-marks factor is considered and the only difference between the parties' marks is a generic descriptor like the letter "e," as was the case with defendant's EVISA mark and Visa's VISA mark, the domain name provides no differences in context and renders any differences in context between the parties' websites "largely irrelevant."

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TTAB Cases

Ballet Tech Found., Inc. v. Joyce Theater Found., Inc., Opp'n No. 91180789, Can. No. 92042019 (TTAB Dec. 11, 2008)

by Linda K. McLeod and Stephanie H. Bald

ABSTRACT

Petitioner, the owner of the Joyce Theater, sought to cancel and oppose various JOYCE-formative registrations and an application for entertainment and charitable services owned by Respondent, the tenant and manager of the Joyce Theater. The TTAB found that because Petitioner selected the JOYCE marks, intended to control the use of those marks though Respondent, and controlled the nature and quality of the services rendered under the JOYCE marks, Petitioner was the owner of the JOYCE marks and Respondent was using the JOYCE marks pursuant to an implied license. Accordingly, the TTAB sustained Petitioner's opposition and granted its petition to cancel.

CASE SUMMARY

FACTS

Ballet Tech Foundation, Inc. ("Petitioner") is a charitable foundation responsible for funding the Feld Ballet Company and operating a tuition-free dance school for public school children. It is also the owner of the premises known as the Joyce Theater. The Joyce Theater Foundation, Inc. ("Respondent") is a charitable foundation that, among other things, manages the Joyce Theater. Respondent registered the marks JOYCE, JOYCE THEATER, JOYCE SOHO, and JOYCE (stylized) for "dance performance theaters and entertainment in the nature of performance arts theater productions" in Class 41. Respondent also registered the mark JOYCE THEATER FOUNDATION and filed a use-based application for the mark JOYCE for "charitable fund raising services" in Class 36. Collectively, the marks shown in these registrations and application are referred to as the JOYCE marks.

Petitioner sought to cancel all of the JOYCE registrations and opposed the JOYCE application on the ground that Petitioner, not Respondent, was the owner of the JOYCE marks, and that Respondent used the marks pursuant to an implied license. Respondent denied the salient allegations in the petition for cancellation and notice of opposition.

In 1978, Petitioner bought an empty motion picture theater known as the Elgin Theater for use by the Feld Ballet Company and other midsized dance companies. Petitioner intended to operate the theater under the Elgin Theater name unless a donor agreed to contribute a significant sum to finance the

renovation of the theater. After LuEsther Mertz, a patron of the arts, agreed to fund the acquisition of the theater and to contribute a significant sum to finance its renovation, the theater was renamed the "Joyce Theater" in honor of her late daughter. Ms. Mertz was promised by Eliot Feld and Cora Cahan, trustees of Petitioner and board members and officers of Respondent, that the theater "would be known forevermore as the Joyce." The Feld Ballet Company performed at the Joyce Theater every season since 1982 except for the 1997-1998 and 2003-2004 seasons.

The trustees of Petitioner, including Mr. Feld and Ms. Cahan, created Respondent because they believed that Petitioner should form a separate, tax-exempt entity to raise funds for the renovation and operation of the Elgin Theater (now the Joyce Theater). During the initial operation of Respondent, the staffs of Petitioner and Respondent were the same.

Petitioner decided to lease the premises to Respondent to ensure that the theater was operated in accordance with Petitioner's intentions. Under the terms of the lease, Respondent was required to maintain the premises consistent with "first class" buildings of similar construction, Petitioner had the right to enter the theater and inspect the premises, Respondent was precluded from changing or altering the premises without Petitioner's consent under certain circumstances, Petitioner could terminate the lease if Respondent failed to comply with its provisions, and upon termination of the lease, Respondent was required to surrender possession to Petitioner.

Ms. Cahan was responsible for planning the renovation of the theater, including fundraising and acting as Respondent's first CEO and Vice President of its board of directors. In addition, Petitioner decided that a board of trustees would manage Respondent's affairs, with Mr. Feld and Ms. Cahan elected to this board with the power to remove directors and officers of Respondent. Petitioner controlled Respondent by virtue of the fact that Mr. Feld and Ms. Cahan, who were both directors of Petitioner, were also permanent members of Respondent's board of trustees with the power to remove other members of the board that voted contrary to their wishes. This system of interlocking directorships terminated in 1993 when Mr. Feld resigned from Respondent's board.

ANALYSIS

In determining the ownership of the JOYCE marks, the TTAB explained that the ownership of a service mark may be acquired through controlled use by one's related companies (or licensees) even in the absence of any use by the purported trademark owner. Based on the record, the TTAB found that Petitioner ultimately controlled the nature and quality of the services rendered in connection with the JOYCE marks. First, the TTAB found that Petitioner selected the JOYCE name and intended to control its use through an authorized licensee (i.e., Respondent). The TTAB agreed with Petitioner's witness, Mr. Feld, that it would be "ludicrous" to find that Petitioner did not own the JOYCE marks after Petitioner purchased the Elgin Theater, did all the work raising the funds and renovating the theater, and took all of the risk involved in the undertaking. Further, the TTAB found that the decision that the theater would be called the Joyce Theater also supported Petitioner's ownership of the marks because no matter who managed the theater for Petitioner, the theater would always be called the Joyce Theater.

Second, the TTAB found that Petitioner informally monitored the quality of the services rendered by Respondent under the JOYCE marks, and such control was sufficient to support a licensing relationship. Specifically, the TTAB found that the course of conduct between Petitioner and Respondent constituted an implied license because: (1) when Petitioner purchased the Elgin Theater and then formed Respondent, Petitioner intended to own the name of the theater and license it to Respondent; (2) Petitioner designed Respondent so that Petitioner could maintain control over it, including through the

use of interlocking directorships; (3) the lease provided that Respondent must render “first class” dance theater services, could not make alterations or changes to the theater without Petitioner’s consent, and upon termination of the lease for any reason, Respondent had to surrender the premises; (4) Petitioner had a right to inspect the premises under the lease; and (5) Petitioner monitored the nature and quality of the services through its use of the theater.

Finally, the TTAB rejected Respondent’s argument that Petitioner’s failure to object to the JOYCE SOHO, a second location acquired and operated by Respondent for the past 12 years without permission or any input from Petitioner, demonstrates that Petitioner had not exercised any control over the services rendered by Respondent, and thus an implied license did not exist. The TTAB found that the lease between the parties and its performances at the theater constituted sufficient control to avoid abandonment of its JOYCE marks. Further, the TTAB found that Petitioner had no reason to object to Respondent’s use of the JOYCE SOHO mark because it was consistent with the mission and goals of the original Joyce Theater. Thus, its failure to object did not constitute abandonment of Petitioner’s rights in the JOYCE marks.

Based on the evidence describing the relationship of the parties, the TTAB concluded that Petitioner was the owner of the JOYCE marks and that Respondent used the JOYCE marks pursuant to an implied license.

CONCLUSION

In cases where two parties claiming ownership in the same mark have a relationship with one another that includes elements typical of a licensing arrangement (e.g., quality control, right to inspect, restrictions on use of the mark), the TTAB may find the existence of an implied license.

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TTAB Cases

In re Heeb Media, LLC, App. No. 78558043 (TTAB Nov. 26, 2008)

by Linda K. McLeod and Stephanie H. Bald

ABSTRACT

The Examining Attorney refused to register the mark HEEB for clothing and entertainment services on the ground that it is disparaging to a substantial composite of the Jewish people. Based on dictionary evidence that HEEB is a derogatory term for Jewish people and evidence that a substantial composite of Jewish people continue to believe HEEB has a derogatory connotation, the TTAB affirmed the refusal to register.

CASE SUMMARY

FACTS

Heeb Media, LLC ("Applicant") filed an application for the mark HEEB for "clothing, namely, jackets, jerseys, sweat pants, sweat shirts, track suits, t-shirts, tank tops and pants; headwear," in Class 25, and "entertainment, namely, conducting parties" in Class 41. Applicant included a claim of ownership of its trademark registration for the mark HEEB for "publication of magazines" in Class 41. The Examining Attorney refused registration under Section 2(a) on the ground that Applicant's HEEB mark is disparaging to a substantial composite of the referenced group, namely, Jewish people. Applicant appealed the Examining Attorney's decision.

On appeal, the Examining Attorney contended that the word HEEB is a highly disparaging reference to Jewish people, that it retains that meaning when used in connection with Applicant's goods and services, and that a substantial composite of the referenced group finds it to be disparaging. In support of her position, the Examining Attorney submitted dictionary definitions indicating that "Hebe" and "Heeb" are derogatory or offensive terms for Jewish people, excerpts retrieved from the NEXIS database discussing the derogatory or offensive nature of the term HEEB (including in connection with Applicant's HEEB magazine), and evidence of Applicant's acknowledgement that some Jewish people have been offended by the use of the HEEB mark in connection with its magazine.

In support of its position that the HEEB mark is not disparaging, Applicant submitted letters from various individuals representing prominent Jewish organizations, or in their individual capacity, discussing Applicant's use of HEEB, as well as advertisements in Applicant's HEEB magazine allegedly showing the

acceptance of the term by a wide range of Jewish organizations, and a list of Jewish organizations that support Applicant's publication. Applicant also noted that the 1998 edition of the *Cassel Dictionary of Slang* defines "heeb" as " a derog. term for a Jew," but the 2005 second edition includes the additional entry "[1920's+] Jewish," suggesting a change in the perception of the term in recent years.

ANALYSIS

To determine whether the HEEB mark is disparaging, the TTAB applied a two-part test:

> (1) what is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services; and
>
> (2) if that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

With respect to the first prong, the TTAB found that there was no dispute that HEEB means a Jewish person and that it had no other meaning pertinent to clothing or entertainment services. Regarding the second prong, the TTAB found that the dictionary definitions unanimously underscored the derogatory nature of the HEEB mark.

Further, although Applicant submitted evidence showing that certain organizations and individuals did not believe the HEEB mark was disparaging, the TTAB noted that there was also substantial evidence that other members of the Jewish population did consider the mark to be derogatory. The TTAB explained that its consideration of whether the term is disparaging is not restricted to the perception of Applicant's magazine subscribers who have no objection to HEEB as the title of Applicant's magazine, but rather takes into account the views of the entire referenced group who may encounter Applicant's clothing and advertising for its entertainment services in any ordinary course of trade for the identified goods and services. The TTAB also relied on an article in which Applicant's founder acknowledged that certain prominent members of the Jewish community were offended by the name of its HEEB magazine. Based on this and other evidence, the TTAB found that, among the older generation of Jews, the term retained its negative meaning, and that the postcollege-age Jewish population constituted "a substantial composite" of the Jewish population. The TTAB rejected Applicant's argument that a minority opinion should not veto registration of a particular mark, noting that while there is no fixed number or percentage, it is well established that a "substantial composite" is not necessarily a majority. Finally, the TTAB made clear that evidence that Applicant had good intentions with its use of the HEEB mark did not obviate the fact that a substantial composite of the referenced group found the term objectionable. The TTAB affirmed the refusal to register.

CONCLUSION

Although an applicant may intend to transform the meaning of a mark, if that mark continues to be viewed as disparaging by a substantial component of the referenced group, it will be barred registration under Section 2(a).

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Unregistrable

Mondo Trademark

by Robert D. Litowitz

I write this month's column from a shoreline in Zanzibar, peering out at the Indian Ocean at dawn, while a group of boys do calisthenics on the beach, with a flock of crows adding cacophonous melody to the rhythm of the waves. We have come here after spending several days in the interior of Tanzania, where, en route to the Serengeti on a visit with friends who live here, we travelled through a collection of small towns, hamlets, and villages. As we passed by rows of brick, concrete, stucco, cinder block, and wooden structures, what stood out were the prominence and ubiquity of brand names. Coke and Pepsi logos battled for position on practically every available inch of retail wall space. It seemed that no matter how modest or desperate a business might appear to our jaded American-consumer eyes, these storefronts were prime battlegrounds in the cola wars, which apparently have gone global. Not to be outdone were the cell phone providers, Voda, Tigo, and others, all intent on displaying the colorful banners of the digital age throughout towns located in the shadows of Masai villages whose dung-covered huts and pastoral traditions seem not far removed from the Biblical era.

To paraphrase Jerry Seinfeld, "What's the deal with all these trademarks?" I don't profess to have the answer, only some thoughts. People respond to and respect brands. They enliven and enrich our lives, adding color and excitement to the mundane and ordinary. They inspire loyalty, they connote and impart prestige and status, and they are aspirational. Even painted on a windowless storefront facade, the power of the bright, familiar Pepsi logo is undiminished, while the Voda and Tigo cell phone brands underscore Thomas Friedman's thesis that, indeed, "The World Is Flat." But of course, brands are no stranger to this part of the world. The Masai herders have been branding their cattle for centuries.

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