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Civil Cases

Facebook, Inc. v. Teachbook.com LLC, 2011 WL 4449686 (N.D. Ill. Sept. 26, 2011)

by Anna Balishina Naydonov

ABSTRACT

The Northern District of Illinois refused to dismiss Facebook, Inc.'s ("Facebook") complaint for trademark infringement and dilution under federal and state law against Teachbook.com LLC ("Teachbook"), the operator of a social networking website called TEACHBOOK for teachers. The court rejected the defendant's attempt to boil the case down to the suffix "BOOK," which the defendant claimed was generic for the parties' services. Considering the parties' marks as a whole, the court held that the defendant's choice of TEACHBOOK—"a combination of the suffix-BOOK preceded by [a] fairly mundane, monosyllabic word"—for social networking services was "no accident" in light of Facebook's claimed "ubiquity."

CASE SUMMARY

FACTS

Facebook sued Teachbook, a social networking website targeted to teachers, asserting trademark infringement and dilution. Facebook alleged continuous use of its FACEBOOK marks since 2004, and owns multiple registrations for its FACEBOOK marks. Facebook alleged that Teachbook "trad[ed] on the fame the FACEBOOK mark has achieved" when it positioned its service as a "substitute for Facebook," and by targeting teachers, some of whom are prohibited from having Facebook accounts by their employers.

ANALYSIS

Before analyzing Facebook's infringement and dilution claims, the court dealt with the threshold issue of the genericness of the "BOOK" portion of the FACEBOOK mark. Relying on the decision in *Le Book Publishing v. Black Book Photography, Inc.*, 418 F. Supp. 2d 305 (S.D.N.Y. 2005), where the court granted a motion to dismiss a trademark infringement claim by the owner of the mark LE BOOK NY for print directories against the mark THE BLACK BOOK for similar directories, Teachbook argued that the shared term "BOOK" in both parties' marks is generic.

Facebook responded to Teachbook's arguments regarding genericness by noting that it was not asserting "blanket trademark rights in the suffix-BOOK" but instead was relying on its ownership of a composite FACEBOOK mark.

The court declined to dismiss Facebook's complaint based on Teachbook's arguments regarding genericness. The court refused to rely on *Le Book* and other similar cases because, unlike the marks in those cases, the dissected term "BOOK" was not generic as applied to Facebook's services. The court explained that "[e]ven in this age of 'e-books,' social networking services do not fall within the category of what one would traditionally call 'books.'" The court also agreed with Facebook that it was not appropriate to "disaggregate" the FACEBOOK mark by focusing on the suffix "BOOK." The court noted that nothing about the "FACE" and "BOOK" elements of the mark made "one more salient than the other. Rather it is the aggregate effect of the conjoined parts that gives the mark its distinctiveness." The court concluded that, in light of the "ubiquity Facebook claims its mark has achieved, one could reasonably infer that the choice of the TEACHBOOK mark—which, like the FACEBOOK mark, is a curt, two-syllable conjunction of otherwise unremarkable words—to offer a similar service in the same medium was no accident."

After deciding the issue of genericness, the court turned to the issue of likelihood of confusion. The court focused its analysis on the following three likelihood of confusion factors: (1) similarities between the marks; (2) actual confusion; and (3) intent.

The court held that Facebook adequately alleged similarities between the marks to survive Teachbook's motion to dismiss, observing that "[b]oth marks are a combination of the suffix-BOOK preceded by fairly mundane, monosyllabic words. And in both instances, it is the uninterrupted conjunction of the mundane words with the suffix-BOOK that gives the marks their verve."

Teachbook asserted that failure to point to any instances of actual confusion was a fatal omission "in light of Facebook's claim to have an 'enormous and loyal user base.'" The court disagreed and held that failure to allege actual confusion did not warrant a dismissal of a trademark infringement claim.

With regard to the intent factor, Teachbook pointed to a statement on its website that purportedly distinguished its services from those of Facebook and rebutted the allegation of bad intent:

> Many schools forbid their teachers to maintain Facebook and MySpace accounts because of the danger that students might learn personal information about their teachers. With Teachbook, you can manage your profile so that only other teachers and/or school administrators can see your personal information, blogs, posts, and so on.

The court held that nothing in the above language prevented consumers from mistakenly assuming that Facebook expanded into offering a specialized social networking service for teachers and, "in order to draw on its famous name, decided to call that service TEACHBOOK." The court relied on the Seventh Circuit opinion in *Eli Lilly & Co. v. Natural Answers, Inc.*, 233 F.3d 456, 465 (7th Cir. 2000), where the court found likelihood of confusion between the marks PROZAC and HERBOZAC because, "even though the defendant was offering an alternative to 'Prozac,' it was doing so by unfairly invoking the fame of the 'Prozac' name." The court ultimately denied Teachbook's motion to dismiss Facebook's trademark infringement claim.

The court also denied Teachbook's motion to dismiss Facebook's trademark dilution claim. Notably, the court rejected Teachbook's argument that a degree of similarity necessary to establish dilution is higher than that which is required to prove trademark infringement. The court relied on the recent Ninth Circuit decision in *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 633 F.3d 1158, 1172 (9th Cir. 2011), which rejected a heightened "identical or nearly identical" standard of similarity for trademark dilution claims.

CONCLUSION

The decision has two notable take-aways. First, with regard to Facebook's trademark infringement claim, the case reaffirms the broad scope of protection afforded to well-known marks. The court based its decision largely on a finding that Facebook sufficiently pleaded Teachbook's intent to coin a mark that would play off Facebook's fame and success. Second, this decision reaffirms the recent Ninth Circuit *Levi Strauss* decision, which rejected a heightened standard of similarity of marks for trademark dilution claims.

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Civil Cases

GoPets Ltd. v. Hise, 2011 WL 4394353 (9th Cir. Sept. 22, 2011)

by David M. Kelly

ABSTRACT

Edward Hise ("Defendant") registered the domain name gopets.com in 1999 and planned to use it to provide pet-care information. GoPets Ltd. ("Plantiff") launched a "GoPets" online game in 2004. After several failed attempts to purchase gopets.com from Defendant, Plaintiff filed a UDRP complaint and lost. Defendant then transferred the domain name to a company he owned. Plaintiff sued for cybersquatting and other claims, and the district court granted summary judgment in Plaintiff's favor. On appeal, the Ninth Circuit reversed the finding of cybersquatting, holding that Defendant did not violate the ACPA when he registered gopets.com in 1999, because Plaintiff was not even using its mark then. The Ninth Circuit also held that Defendant's later re-registration of the domain name in the name of his company in 2006, which occurred after Plaintiff's mark became distinctive, did not constitute a new registration under the ACPA.

CASE SUMMARY

FACTS

Defendant registered the domain name gopets.com in 1999 and planned to use it to provide information about pet care. Plaintiff created GoPets, an online game featuring virtual pets, in 2004. Beginning in 2004, Plaintiff made several unsuccessful attempts to purchase gopets.com from Defendant for hundreds of dollars. In 2006, Plaintiff filed a UDRP complaint, but the panel held in Defendant's favor. Shortly thereafter, Plaintiff offered again to buy the domain from Defendant, this time offering $5,000 and then $40,000. A few months later, Defendant counteroffered to sell gopets.com for $5,000,000 and threatened to add "competitive metatag[s]" to gopets.com to drive traffic away from Plaintiff's site. Two days after making this offer, Defendant transferred the domain name to a company he owned with his brother. Defendant also registered eighteen additional "gopets"-formative domains. In March 2007, Defendant added content to the gopets.com site consisting of a logo and the text, "Welcome to **goPets.com** the official online website. goAhead pet lovers tell your friends that **GoPets.com** will be arriving soon!" Plaintiff sued Defendant for cybersquatting, trademark infringement, and unfair competition. The district court granted Plaintiff's motion for summary judgment on all claims and awarded statutory damages for cybersquatting of $100,000 for gopets.com and $1,000 each for the other domains. Defendant appealed.

ANALYSIS

The Ninth Circuit reversed in part and affirmed in part. Defendant's main argument on appeal was that he did not violate the ACPA when he registered gopets.com in 1999, because the domain name was not "identical or confusingly similar to a mark that was distinctive *at the time of registration*" as required to establish cybersquatting under the ACPA. Plaintiff obviously could not meet this standard because it did not even start using its GoPets mark until years later in 2004. Although Plaintiff conceded that Defendant did not violate the ACPA when he registered the domain in 1999, Plaintiff argued that when Defendant transferred the domain to his company in 2006, he "re-registered" a domain name that constituted a "new" registration made in bad faith.

The Ninth Circuit rejected Plaintiff's argument, holding that "Congress meant 'registration' to refer only to the initial registration" and not to re-registrations. It distinguished the Third Circuit's decision in *Schmidheiny v. Weber*, 319 F.3d 581 (3d Cir. 2003), which held that re-registration was a new registration under the ACPA. Initially, *Schmidheiny* involved the provision prohibiting registration of domains consisting of a *living person's name* and selling them for profit regardless of whether the person's name enjoyed trademark rights (15 U.S.C. § 8131(1)(A)), and not the provision covering conventional trademarks (15 U.S.C. § 1125(d)(1)). Moreover, the Third Circuit assumed that the ACPA did not cover the initial registration of the disputed domain because it occurred before the ACPA's passage, and was concerned that holding for the Defendant would allow the domain names of living persons to be sold in perpetuity without the living person's consent. The Ninth Circuit, however, agreed with the Second Circuit that the ACPA applies retroactively to domains registered before its enactment, and thus that the Third Circuit erred in assuming that the ACPA did not cover the original registration in *Schmidheiny*.

Moreover, the Ninth Circuit looked at the statute and did not see "[any] basis in [the] ACPA to conclude that a right that belongs to an initial registrant of a currently registered domain name is lost when that name is transferred to another owner." It noted that "the general rule is that a property owner may sell all of the rights he holds in a property," and that allowing re-registration to count as a new registration under the ACPA would "make the rights to many domain names inalienable."

However, the Ninth Circuit affirmed the district court's holding that Defendant's eighteen additional "gopet(s)" domains constituted cybersquatting. It also affirmed the district court's award of statutory damages of $1,000 for each domain and ordered the transfer of those domains to Plaintiff. The court held that Defendant's reliance on the UDRP decision was misplaced because it was valid only for the original gopets.com domain name and did not apply to Defendant's later registrations.

Finally, the district court held that Defendant's actions regarding the gopets.com name constituted both cybersquatting and infringement, but it granted relief only under the ACPA. Although the Ninth Circuit reversed the ACPA violation, it stated that "it is possible that some relief . . . may be appropriate based on the Lanham Act violation," presumably based on the logo and wording Defendant displayed on his gopets.com website. The Ninth Circuit thus remanded the case to the district court "for determination of any relief [it] might find appropriate for [the infringement] violation."

CONCLUSION

This decision is of interest because it appears to create a split between the Ninth and Third Circuits on whether a transfer of a domain name constitutes a new registration for purposes of evaluating a cybersquatting claim under the ACPA. This distinction could make the difference between a winning and losing a cybersquatting claim.

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Civil Cases

Hart v. Elec. Arts, Inc., 2011 WL 4005350 (D.N.J. Sept. 9, 2011)

by Lynn M. Jordan

ABSTRACT

In the latest in a series of video-game avatar cases, the U.S. District Court for the District of New Jersey granted summary judgment to Electronic Arts, Inc. ("EA"), finding its use of a former football player's likeness in its annual *NCAA Football* video games was fully protected noncommercial speech. Recognizing that the right of publicity may encroach First Amendment rights in some circumstances, the court found little clarity in the existing case law as to how the competing interests should be balanced, ultimately concluding that under either the "transformative use" test grounded in copyright law, which it favored, or the *Rogers v. Grimaldi* balancing test from trademark law, EA's First Amendment rights should prevail.

CASE SUMMARY

FACTS

EA produces a video-game series permitting users to manipulate the actions of college football teams with virtual players in a virtual world of simulated games. The football teams are identifiable by name, and the uniform designs, logos, and stadium fight songs are all licensed from the NCAA. The virtual players, on the other hand, are identified only by jersey number and position. Players can edit game data to give the player a surname and alter the players' personal characteristics either individually, or by downloading custom rosters that replicate actual, current, and former teams. Ryan Hart ("Plaintiff"), a former college football player for Rutgers—a team depicted in the video games—alleged that the depiction of a player avatar bearing his former number and position violated his right of publicity under New Jersey law. EA moved for summary judgment on the ground that despite its sale commercially, the video game is an expressive work protected by the First Amendment, which trumps Plaintiff's publicity right.

ANALYSIS

As an initial matter, the court concluded that under existing Supreme Court law, video games are expressive works fully protected under the First Amendment. Turning to what it deemed the "more thorny question" of whether the First Amendment grants EA the right to impinge upon Plaintiff's common-law right of publicity, the court noted the lack of clarity as to how to balance the competing interests that each set of rights protects, pointing to at least eight "balancing" tests other courts have used, and noting that neither New Jersey nor the Third Circuit has explicitly adopted any one test. Ultimately, the court focused on the "transformative use" test developed by California courts and the balancing test set forth in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). Concluding that the transformative test is more refined and better balances the competing interests of right of publicity and the First Amendment, the court nevertheless refused to explicitly adopt either test because it found that the First Amendment prevailed under both tests.

Regarding the transformative test, the court noted that this test looks to whether artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain without adding significant expression, in which case the right of privacy prevails, or whether the celebrity likeness is only one of the "raw materials" from which a work is created, making it transformative and protected. Specifically, the court looked to two California cases involving video-game avatars, and found that the facts in the case before it fell somewhere in between. In *Kirby v. Sega*, 144 Cal. App. 4th (Cal. App. 2006), the court found that a video-game character modeled after, but not meant to be, the singer Dee Lite was transformative, as contrasted with *No Doubt v. Activision*, 192 Cal. App. 4th 1018 (Cal. App. 2011), where the court found that avatars of the band members from No Doubt in the *Band Hero* game that were literal depictions, and could not be altered, were not transformative. Because users of EA's video game could change player features, the court concluded it was more akin to *Kirby*, and thus transformative.

Turning next to the *Rogers* test developed in the context of trademark law, the court explained that, under this test, there is no liability for trademark infringement unless the challenged mark is wholly unrelated to the underlying work and misleads the public as to the source or content of the work, or in the case of a right-of-publicity claim, there is no relevance to the underlying work and it is essentially a disguised commercial advertisement. Noting that the Third Circuit has not specifically adopted *Rogers* in the context of either a Lanham Act claim or a right-of-publicity claim, the court nevertheless acknowledged some precedent for applying it to misappropriation actions like the one before it. The court concluded that it could not reasonably be argued that Plaintiff's image is wholly unrelated to the game, that its inclusion did not mislead the public as to the content or source, and that it was not used to advertise an unrelated product, thereby satisfying the tests enumerated in *Rogers*.

Because Defendant was entitled to First Amendment protection under either test, the court granted summary judgment in EA's favor.

CONCLUSION

This opinion provides a detailed and lengthy analysis of the two leading tests for balancing the right to free expression under the First Amendment with an individual's right of publicity. While ultimately declining to decide which test should generally apply to misappropriation of likeness cases, the case is useful for its insightful analysis of both the transformative test and the *Rogers* test, and the application of both in the context of likenesses appearing in video games.

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Louis Vuitton Malletier S.A. v. Akanoc Solutions, Inc., 2011 WL 4014320 (9th Cir. Sept. 9, 2011)

by David M. Kelly

ABSTRACT

Plaintiff Louis Vuitton Malletier S.A. ("Vuitton") sells luxury goods under the famous LV mark. Defendant Akanoc Solutions, Inc. ("Akanoc") provided web-hosting services to websites selling counterfeit LV goods. Despite numerous notices of infringement sent by Vuitton placing Akanoc on notice of the counterfeit websites and requesting their removal from Akanoc's hosting service, Akanoc neither responded nor removed the infringing content. Vuitton sued Akanoc for contributory trademark and copyright infringement. The jury found Akanoc liable for contributory trademark counterfeiting and infringement, and awarded damages of $10,500,000 each against the web-hosting company and two other defendants. On appeal, the Ninth Circuit affirmed the finding of contributory counterfeiting and infringement against the hosting company.

CASE SUMMARY

FACTS

Vuitton sells luxury goods under the mark LV. Akanoc provided web-hosting services. From 2006 to 2007, Vuitton sent eighteen notices of infringement to Akanoc documenting trademark and copyright infringement on websites hosted by Akanoc that sold counterfeit LV goods and demanding that Akanoc remove the infringing content. Akanoc neither responded to these notices nor removed the infringing content. Vuitton sued for contributory trademark infringement/counterfeiting and copyright infringement. The jury returned a verdict for Vuitton, holding Akanoc liable for willful contributory trademark and copyright infringement. The jury awarded $10,500,000 for contributory trademark infringement/counterfeiting against each of the defendants for a total of $31,500,000. The district court denied Akanoc's motion to set aside the jury verdict and Akanoc appealed.

ANALYSIS

The Ninth Circuit affirmed the jury's finding of liability, holding that Akanoc "continued to supply its services to one who it knew, or had reason to know, was engaging in trademark infringement." Akanoc also had "direct control and monitoring of the instrumentality used by a third party to infringe" Vuitton's marks. Akanoc argued that the jury instructions failed to differentiate between Akanoc's web-hosting services on the one hand and the websites operated by Akanoc's customers that were the "means of infringement" on the other hand. The Ninth Circuit, however, agreed with the district court that Akanoc "physically host[ed] websites on [its] servers and route[d] internet traffic to and from those websites," the Internet equivalent of "leasing real estate." According to the Ninth Circuit, Akanoc had control over the "services and servers" provided to its customers, and had "direct control" over the "master switch" that "kept the websites online and available."

Akanoc also argued that the jury instructions were erroneous because its contribution to the infringement had to be "intentional" to be actionable. The Ninth Circuit disagreed, holding that Vuitton had to prove only that Akanoc "provided [its] services with actual or constructive knowledge that the users of their services were engaging in trademark infringement." In short, there was no requirement of an "express finding of intent." Turning to damages, Akanoc argued that 15 U.S.C. § 1117(c) does not authorize statutory damages for counterfeiting against contributory infringers because it requires defendants to actually "*use* . . . [the] counterfeit mark." The Ninth Circuit disagreed, holding that Section 1117(c) expressly applies to any cases "*involving* the use of a counterfeit mark" (emphasis added). In calculating damages, the jury awarded $10,500,000 in statutory damages per defendant for the infringement of thirteen of Vuitton's trademarks for a total of $31,500,000 in damages. The Ninth Circuit, however, vacated the judgment, finding "no legal basis for multiplying the award by the number of defendants." According to the court, Section 1117(c) "entitles a plaintiff to *an* award, not multiple awards." Accordingly, the Ninth Circuit remanded the case to the district court with instructions to award total damages in the amount of $10,500,000 for contributory trademark damages.

CONCLUSION

This decision is of interest because it is one of the few decisions holding an online-services provider liable for contributory trademark counterfeiting and infringement. This decision should cause web-hosting companies to implement a system for responding to legitimate objections of trademark owners.

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Gen. Mills, Inc. v. Fage Dairy Processing Indus. S.A., Opp. Nos. 91118482, 91118950, 91155075, 91182937 (TTAB Sept. 14, 2011)

by Linda K. McLeod and Stephanie H. Bald

ABSTRACT

Applicant filed fifteen applications to register various design marks containing the mark TOTAL for yogurt, among other products. Opposers asserted claims of likelihood of confusion and dilution based on its previously used and registered TOTAL mark for cereal. The Board found a likelihood of confusion between the parties' marks and sustained the opposition with respect to all applications, except for one class of goods in one application covering non-yogurt products. Among other things, the Board concluded that Opposers' TOTAL mark was famous; the similarities between the marks in their entireties outweighed the dissimilarities; cereal and yogurt were related goods, traveled in the same channels of trade, and were purchased by the same consumers; the goods were low-cost items such that consumers were more vulnerable to confusion; third-party use was either not relevant or minimal; and the lack of actual confusion was not highly probative. Because of its finding of likelihood of confusion, the Board did not reach Opposers' dilution claim.

CASE SUMMARY

FACTS

Applicant Fage Dairy Processing Industry S.A. filed fifteen applications to register various design marks containing the mark TOTAL for yogurt, among other products. Opposers General Mills, Inc. and General Mills IP Holdings II, LLC asserted claims that Applicant's marks were likely to cause confusion with Opposers' previously used and registered TOTAL marks, and that Applicant's TOTAL marks diluted the distinctiveness of Opposers' TOTAL marks. Opposers asserted registrations for the mark TOTAL in typed form for "wheat flakes" and "ready to eat breakfast cereal." In its Answer, Applicant admitted that it did not use its marks in the United States prior to 1998.

ANALYSIS

The Board first addressed Opposers' motions to strike certain testimony and evidence submitted by Applicant. Regarding emails that Applicant received from customers, the Board found that although they were not admissible under Notice of Reliance, because Applicant's witness testified as to their existence and to his review of them, there was a sufficient indicia of reliability to accept them as being authenticated. The Board indicated, however, that they were not being considered for the truth of the matter asserted, but only for what they showed on their face. With respect to certain third-party reports and presentations that had been created for Opposers and produced by Opposers during discovery, the Board found that although they were not the type of documents contemplated for submission under Notice of Reliance, there had been ambiguity on this issue because of an email from Opposer suggesting that no authentication of these documents was necessary. Accordingly, the Board did not strike this evidence. The Board also admitted third-party evidence of use of the term "total" because it was introduced through testimony, but struck demonstrative exhibits created by counsel that constituted "summaries" of that evidence because they were not introduced through testimony. The Board also precluded Applicant from relying on testimony and exhibits reflecting advice of counsel because such evidence, if not privileged, should have been produced to Opposers during discovery, and not the day before the testimony deposition of Applicant's witness.

Turning to the merits, the Board first found that Opposers' TOTAL mark was a famous mark for ready-to-eat cereal based on Opposers' registration of the mark dating back to 1961 (wheat flakes) and 1986 (ready-to-eat cereal), substantial sales and advertising figures, market share (TOTAL ranks among the top ten or fifteen of all cereal brands), exposure in the marketplace (TOTAL cereal is sold in "pretty much any store that's selling grocer[ies]"), the very high number of U.S. households that purchase TOTAL cereal, the scope of Opposers' advertising of TOTAL cereal (national television, radio, Internet, nationally distributed magazines and newspapers, coupons, and partnerships), Opposers' use of public figures, such as Paul Harvey and Richard Lewis, to promote TOTAL cereal, Opposers' partnership with the Food Network to feature TOTAL cereal on its programs, media mentions of TOTAL cereal, the nearly universal household penetration of advertising for TOTAL cereal, the high recognition of TOTAL cereal shown in internal consumer surveys, the high recognition of TOTAL cereal as shown by Opposers' consumer survey conducted for the case, and Brandweek's consistent recognition of TOTAL as one of the top 2000 "Superbrands" in the United States. The Board dismissed Applicant's arguments that the TOTAL brand was in general decline based on its decreasing sales figures, finding that whatever the sales' ebb and flow, the brand awareness had remained steady.

Regarding inherent distinctiveness, the Board recognized that TOTAL was a suggestive mark in that it suggests a significant feature of the product, namely, that it contains 100 percent of the daily recommended vitamins and minerals. The Board nevertheless found that the mark was entitled to a broad scope of protection because of the use of the mark for many years and the high level of exposure and recognition for several generations of American consumers. The Board also found that the evidence of record clearly established a close relationship between Opposers' ready-to-eat cereal and Applicant's yogurt, given consumers' long-standing mixing of these types of products and the circumstances surrounding their marketing. Specifically, the Board concluded that yogurt and ready-to-eat cereal are viewed and consumed as breakfast foods, yogurt and cereal compete for a share of consumers' market baskets and breakfast tables, consumers mix and consume yogurt and cereal together, and consumers are regularly exposed to yogurt and cereal combined as a food product, both in the marketplace as a parfait and in the media in the form of information about eating options. The Board also recognized that Opposers, through their Yoplait Division, had a history of marketing and selling yogurt, including yogurt with grains mixed in; that Opposers cross-promoted their yogurt and cereal products; that Opposers offered cereal with "yogurt coated clusters"; and that Applicant had even marketed a product that combined cereal in yogurt outside the United States. Accordingly, the record supported the complementary and competitive relationship between cereal and yogurt, and the likely confusion resulting from the use of a famous cereal brand name on yogurt.

As to channels of trade and classes of purchasers, the Board presumed that the parties' goods would be sold in all ordinary channels of trade for the goods. The Board noted that the parties' goods were simple consumer food items that would be sold wherever groceries are sold, and the record established that cereal and yogurt are sold in the same stores, convenience stores, drugstores, and mega-stores. Accordingly, the channels of trade and purchasers overlapped. The Board further found that while cereal is usually in a center aisle and yogurt is in the refrigerated section of the perimeter of the store, there is increasing utilization of smaller refrigerated units and display bunkers where dairy products, including yogurt, are placed next to cereal. Further, Opposers promoted cereal in the dairy aisle and yogurt in the cereal aisle, and there was a strong overlap in the parties' consumer base in the sector of the health-conscious consumer, which was reflected in both parties' advertising. The record also showed that the goods involved were relatively inexpensive, and purchasers of such low-cost ordinary consumer items exercise less care in their purchasing decisions and were more likely to be confused as to the source of the goods.

In considering the similarity-of-the-marks factors, the Board divided Applicant's fifteen applications into two groups—seven applications in which the word TOTAL was clearly the most prominent and memorable component of the mark, and eight other applications wherein the TOTAL portion was depicted in smaller font in the middle of the marks. For the first group, the Board found that the additional English wording on the marks was descriptive, the design elements comprised a simple background design that was suggestive of the ingredients of origin of the product, and the house mark FAGE appeared in Greek lettering in each of the marks, such that it was unlikely to be perceived by consumers as a mark. Further, the common element TOTAL evoked the same meaning of "complete nutrition" in Applicant's and Opposers' marks. The Board thus found that consumers would focus on the word TOTAL as the source-identifying element. For the second group, the Board found that the analysis was the same because, as compared to the descriptive wording and design elements, the word TOTAL continued to be dominant, despite its smaller size. Further, although the additional word FAGE (in Roman letters) was presented in larger typeface and emphasized by the banner design in these marks, the house mark did not dispel likely confusion because use of a house mark generally does not obviate confusion and the exceptions to this rule—(1) that the marks in their entireties convey significantly different commercial impressions, or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted—did not apply here. The Board found that a junior party's fame cannot excuse likelihood of confusion and, in any event, the record did not show the level of fame needed to establish fame in the FAGE mark. Further, the Board distinguished this case from a situation where the common element of the marks is weak, noting its finding of the fame of Opposers' TOTAL mark.

The Board also found that the vast majority of evidence of third-party use of the term TOTAL related to unrelated products, such that it was not sufficient to limit the scope of protection of the famous TOTAL mark. The Board dismissed Applicant's arguments regarding the third-party use and registration by Bally Total Fitness of BALLY TOTAL FITNESS for, among other things, snack bars, yogurt-based beverages, grain-based foods, and frozen yogurt based on testimony that "Bally's has never sold its product in grocery stores." The Board also found that Applicant's registration of the mark FAGE FETA TOTAL for cheese did not show that Opposers had abandoned TOTAL or even that they had acquiesced to such use. Additionally, the Board found that the significant time period for measuring the parties' coexistence was three years, not twelve years, because the product's sales had previously been limited to ethnic stores and stores that did not sell Opposers' products. The Board found the "actual confusion" factor to be neutral based on this shorter period of time (three years) and the inherent difficulty in obtaining evidence of actual confusion, especially with inexpensive items.

In sum, the Board concluded that there was a likelihood of confusion between Opposers' TOTAL marks and Applicant's TOTAL marks, sustaining the opposition as to all but one class of goods in one application (covering non-yogurt products that the parties had not addressed at trial). Because of its finding on likelihood of confusion, the Board did not reach Opposers' dilution claim.

CONCLUSION

Fame continues to play an important role in the Board's likelihood-of-confusion analysis. Because Opposers' TOTAL mark was found famous and the parties' goods were found to be related, other potentially distinguishing features between the parties' marks, such as the display of Applicant's house mark, additional design elements, and other descriptive wording, were insufficient to avoid a likelihood of confusion.

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If you have any questions or need additional information, please contact:
Jonathan M. Gelchinsky, Editor-in-Chief
Mary Beth Walker, Associate Editor
Anna Bonny Chauvet, Assistant Editor

Julia Anne Matheson, Senior Editor

Washington, DC • Atlanta, GA • Cambridge, MA • Palo Alto, CA • Reston, VA • Brussels • Shanghai • Taipei • Tokyo

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Back to Main

Unregistrable

"D®ive?" She Said

by Robert D. Litowitz

A recent headline on the *Entertainment Weekly* blog stated: "Woman sues over misleading 'Drive' trailer." According to *EW*, a Michigan woman, Sarah Deming, sued because she said the trailer misled her into buying a ticket for the film. Ms. Deming's complaints listed in the lawsuit apparently included:

- "*Drive* was promoted as very similar to *Fast and Furious*, when in actuality, it wasn't."
- "*Drive* bore very little similarity to a chase, or race action film, for reasons including but not limited to *Drive* having very little driving in the motion picture."

The disgruntled plaintiff not only wants her money back, but wants the producers to issue a corrective notice, so that other film buffs won't suffer the same fate. She's even threatened to throw in a class-action suit for good measure. A sequel, so to speak.

At first blush, the suit seems not just crazy, but symptomatic of our litigious society, where folks don't just cry over spilled coffee, they sue over it and win.

Now, I've sat through my share of movies that didn't quite synch with their enticing trailers. Just recently, I rushed to see *Take Shelter* on its opening weekend, lured by a hauntingly compelling preview and strong critical praise. The actual movie, however, was more excruciating than two hours in a dentist's chair. The audience collectively spent more time checking its watches than watching the screen. But did it occur to me to sue for a refund? Before last week, the thought would never have crossed my mind. But the *Drive* dispute certainly got me thinking. In the annals of cinema, there must have been dozens of missed opportunities for angry film buffs to cash in on similar grounds. Here are just a few.

John Doe v. The Graduate—A suit for false representation under the Lanham Act to remedy economic loss and severe emotional distress experienced due to the false and deceptive nature of this movie's title and portions of the trailer. After all, it's called THE GRADUATE, and the trailer shows a *graduation party* where Dustin Hoffman receives canny advice to pursue a career in "Plastics" ("Enuff said!"). So plaintiff justifiably expected a story about a successful Ivy League track star who forges a lucrative business career. Instead, the film features an adulterous alcoholic seductress, Mrs. Robinson (koo koo catchoo), and two sordid affairs between Hoffman's character and the mother/daughter Robinson girls, culminating in Hoffman ditching his snazzy Alfa Romeo Spider, desecrating a church, and ruining a perfectly good wedding. We don't even learn whether Dustin and Elaine Robinson—last seen losing their smiles in the back seat of a getaway bus—live happily ever after? A getaway bus!!! That alone warrants treble damages!

Jane Doe v. Bridge on the River Kwai—To whom it may concern, when I saw the coming attraction for *Bridge,* I took delight in the bright, wordless theme song and the Japanese Commander's inspiring order for the men to "Be Happy in Your Work." Like seeing the Seven Dwarfs heading off to their own happy anthem “Whistle While You Work,” I expected a story of dedicated men using ingenuity and pluck to erect a bamboo jungle bridge that rivaled the famous brick and cable one in Brooklyn. Nothing suggested a movie filled with deprivation, torture, pervasive suffering, and a wisecracking William Holden. And to make matters worse, they destroy the bridge even before they get to install the EZ Pass lane! I hereby demand that they cease and desist immediately all commercial screenings of this film. I would settle, however, if the producers agree to spend two days collecting trash on the Santa Monica Freeway while whistling the Colonel Bogey March.

John Q. Tortellini v. Goodfellas—Another false-advertising suit. The trailer shows a group of fun-loving guys engaged in the types of male-bonding activities typically seen at the average groom’s bachelor party. Just a bunch of “Good Fellas” out on the town. One of them is Joe Pesci. I loved him as *Cousin Vinny* in his purple velour tuxedo telling judge Herman Munster about “two yoots,” and outsmarting that smarmy prosecutor with Marisa Tomei. When I saw that he was in this “buddy movie,” I rushed to buy my ticket, expecting another warm-hearted comedy. That delusion ended when he began dropping F-bombs by the score and routinely maimed, shot, or killed anyone who looked at him the wrong way. Then I realize it’s a MAFIA movie, and boy, does Pesci have a short fuse!! Not for me, sister. I demand a refund and an apology to the entire Italian American community for this vicious ethnic slander!! In the alternative, I demand that the film be pulled from distribution for being a Mafia film with a lead character named Henry Hill. Whoever heard of a Mafioso named Hill?

The list of lawsuits that might have been could go on forever. Indeed, Orson Welles is probably breathing a sigh of relief from his eternal repose, thankful that he lived in a simpler time where he was immune from a trademark suit by the famous Pasadena New Year’s parade and bowl game over the iconic last word uttered by Citizen Kane—“Rosebud.”

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If you have any questions or need additional information, please contact:
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