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TABULATION—CONFUSING SIMILARITY FOUND*

Editor's Note: In this section, as well as that of Tabulation—No Confusing Similarity Found, which follows, the first mark before the “versus” will be the prior mark and the mark after the versus will be the later mark. Each section will be divided in four parts: Courts, Court of Appeals for the Federal Circuit, Trademark Trial and Appeal Board and National Arbitration Forum. Also, at the end of some cases will be an O in brackets that represents Opposition Proceedings.

COURTS


BARCELONA trademarks owned in Spain by Barcelona city authority v. BARCELONA.COM domain name registration used for website featuring information about the city of Barcelona, email services, a chat room and referrals to other Internet services, Barcelona.com v. Excelentisimo Ayuntamiento de Barcelona, 63 U.S.P.Q.2d 1189, E.D. Va., 2/22/02.


CHURCH OF THE CREATOR for Christian Divine Right Order church v. WORLD CHURCH OF THE CREATOR for white supremacy organization, Te-Ta-Ma Truth Foundation-Family of URI, Inc. v. World Church of the Creator, 63 U.S.P.Q.2d 1760, 7th Cir., 7/25/02. The court reversed summary judgment for defendant (on ground that plaintiff's mark was generic) and instructed entry of judgment for plaintiff.


* Cases in this section were summarized by the following members of the TMR Editorial Board: Sean D. Johnson, Kathleen McCarthy, Linda Pickering, and Thomas J. Speiss.
COPITRAK for cost recovery equipment v. COPITRACK as a metatag on competitor’s cost recovery equipment website, Promatek Industries Ltd. v. Equitrac Corp., 63 U.S.P.Q.2d 2018, 7th Cir., 8/13/02. The court affirmed preliminary injunction.


GENERIC VALUE PRODUCTS v. GENERIX, both for hair care products (defendant’s motion for summary judgment denied), Sally Beauty Co. v. Beautyco Inc., 64 U.S.P.Q.2d 1321, 10th Cir., 9/3/02.


HARRODS for department store services v. HARRODSSSTORE.COM, CYBERHARRODS.COM, HARRODSSOUTHAMERICA.COM, HARRODSSUDAMERICA.COM, HARRODSBRAZIL.COM, and numerous other domain names with “HARRODS” allegedly registered in bad faith with intent to profit off of plaintiffs’ mark, Harrods Ltd. v. Sixty Internet Domain Names, 64 U.S.P.Q.2d 1225, 4th Cir., 8/23/02.

HENEGAN CONSTRUCTION CORPORATION for general contracting and construction management services for commercial interior work v. HENEGAN CONTRACTING CORPORATION for concrete and masonry subcontracting services for commercial construction projects, 63 U.S.P.Q.2d 1984, S.D.N.Y., 6/12/02.


REGISTER.COM and THE FIRST STEP ON THE WEB for domain name registration services v. use of REGISTER.COM and “first step” or references to “your recently registered domain name” in telemarketing and email solicitations to customers who recently registered domain names with Register.com, Register.com Inc. v. Verio Inc., 63 U.S.P.Q.2d 1957, S.D.N.Y., 12/8/00. The court granted preliminary injunction.

SWIX for ski waxes v. swix.net and swix.com Internet domain names used for an Internet service in Switzerland, Hartog & Co. v. swix.com, 63 U.S.P.Q.2d 1086, E.D. Va., 3/16/01. While the marks/domain names were found to be “confusingly similar” under the ACPA, the plaintiff’s ACPA claim was rejected for failure to prove bad faith.


COURT OF APPEALS FOR THE FEDERAL CIRCUIT


TRADEMARK TRIAL AND APPEAL BOARD


NATIONAL ARBITRATION FORUM

LANSOLUTIONS and LAN SOLUTIONS for computer hardware and computer operating systems software v. LANSOLUTIONS.BIZ for design, installation, servicing and maintenance of computers and computer networks, Princeton Linear Associates Inc. v. Copland, 61 U.S.P.Q.2d 1895, National Arbitration Forum, 2/8/02.

POCKETLOOX for personal digital assistant products v. POCKETLOOX.COM for a website featuring information that is “fictitious and disparaging” of the complainant’s products, 64 U.S.P.Q.2d 1853, National Arbitration Forum, 10/25/02.

TABULATION—NO CONFUSING SIMILARITY FOUND

COURTS

AFLAC for an insurance company advertisement featuring a real duck that quacks “Aflac” v. TAFTQUACK for a political campaign advertisement featuring a cartoon animal that quacks “Taft Quack,” American Family Life Insurance Co. v. Hagan, 64 U.S.P.Q.2d 1865, N.D. Ohio, 10/25/02.

ALTIRA GROUP for venture capital investment services v. ALTRIA and ALTRIA GROUP, INC. for new corporate parent name for the Philip Morris Companies, which include some subsidiaries that offer investment services, Altira Group LLC v. Philip Morris Co. Inc., 63 U.S.P.Q.2d 1438, D. Colo., 6/18/02. The court denied preliminary injunction.

BARBIE for dolls and accessories v. BARBIE GIRL song title and lyrics, Mattel Inc. v. MCA Records Inc., 63 U.S.P.Q.2d 1715, 9th Cir., 7/24/02.


FT-FASHION TELEVISION for journalistic cable television programming about fashion, art and architecture v. FASHION TV for voyeuristic cable television programming featuring runway
models and background music, Chum Ltd. v. Lisowski, 63 U.S.P.Q.2d 1569, S.D.N.Y., 4/18/02.


MACHINE HEAD and MH for “heavy metal” music services v. MACHINE HEAD for “sound design” services, Machine Head v. Dewey Global Holdings, Inc., 61 U.S.P.Q.2d 1313, N.D. Ca., 12/13/01.


MOMENTUM v. MOMENTUM, both for luggage (defendant’s motion for summary judgment granted on the grounds that plaintiff did not own the mark, and that, regardless, there was no likelihood of confusion), Momentum Luggage and Leisure Bags v. Jansport Inc., 64 U.S.P.Q.2d 1795, 2d Cir., 9/6/02.


THE POPCORN SHOPPE trade dress featuring “Chicago Style” and Chicago skyline graphic v. MEIJER trade dress featuring “Chicago Style” and Chicago skyline in a different layout, both for popcorn, Gray v. Meijer Inc., 63 U.S.P.Q.2d 1735, 6th Cir., 7/16/02.


SMART POWER v. SMART POWER, both for semiconductor products (defendant’s motion for summary judgment granted on the grounds of laches and genericness), Nartron Corp. v. STMicroelectronics, 64 U.S.P.Q.2d 1761, 6th Cir., 10/1/02.
THERMA-SCAN for infrared medical imaging services v. BRAUN


WHERE PETS ARE FAMILY for pet supplies and ancillary veterinary services v. WHERE PETS ARE FAMILY for pet supplies and ancillary veterinary services, Cohn v. Petsmart, Inc., 61 U.S.P.Q.2d 1688, 9th Cir., 2/12/02.

WINDOWS v. LINDOWS, both for computer operating system products (plaintiff’s motion for preliminary injunction denied), Microsoft Corp. v. Lindows.com, Inc., 64 U.S.P.Q.2d 1397, W.D. Wash., 3/15/02.

COURT OF APPEALS FOR THE FEDERAL CIRCUIT

HAWK EYE and MINI HAWK EYE v. EAGLE EYE and MINI EAGLE EYE, both for mirrors (plaintiff failed to prove ownership of the mark and likelihood of confusion), Rosco Inc. v. Mirror Lite Co., 64 U.S.P.Q.2d 1650, Fed. Cir., 9/30/02.

TRADEMARK TRIAL AND APPEAL BOARD

TORO for lawn and grounds care and maintenance v. TOROMR for magnetic heads for computer disk drives, Toro Co. v. Torohead, Inc. 61 U.S.P.Q.2d 1164, T.T.A.B., 12/12/01.
TABULATION—DILUTION FOUND

Editor's Note: In each section which follows, the first mark before the “versus” will be the allegedly earlier mark and the mark after the versus will be the allegedly diluting mark. Each section will be divided into two parts: Trial Courts and Appellate Courts (both including federal and state jurisdictions). When only state law dilution acts are involved, the expression “state law only” is used.

TRIAL COURTS

COMDEX for technology trade shows and conferences v. COMDEX, COMDEX.COM and LASVEGASCOMDEX.COM domain names for travel-related services at least in part addressed to consumers who may attend plaintiff's annual COMDEX trade show in Las Vegas, Key3Media Events, Inc. v. Convention Connection, Inc., 2002 WL 385546, D. Nev., 1/25/02. The court held that defendant's use of its marks constituted trademark infringement and dilution and granted plaintiff permanent injunctive relief.

FORD, BRONCO, EXCURSION and several other trademarks for cars and car floor mats v. FORD, BRONCO, EXCURSION and several other of plaintiff's marks for car floor mats, Ford Motor Co. v. Lloyd Design Corp., 62 U.S.P.Q.2d 1109, E.D. Mich., 2/1/02. On remand, the court granted plaintiff's motion for summary judgment on plaintiff's claim that defendant violated Federal Anti-Dilution Act.


LV, LOUIS VUITTON and related trademarks for handbags and related products v. LOUISVUITTONREPLICAS.COM domain name, Louis Vuitton Malletier and Oakley, Inc. v. Veit, 211 F. Supp. 2d 567, E.D. Penn., 6/28/02. The court held that the defendant's use and/or registration of the

* Cases in this section were summarized by Marnie Barnhorst and Felicia Boyd, members of the TMR Editorial Board.
LOUISVUITTONREPLICAS.COM website constitutes trademark dilution under federal and Pennsylvania law and cybersquatting.

NISSAN for automobiles v. NISSAN.COM and NISSAN.NET domain names for a computer company, Nissan Motor Co., Ltd. v. Nissan Computer Corporation, 2002 U.S. Dist. LEXIS 22212, C.D. Cal., 11/13/02. The court granted plaintiff’s motion for permanent injunction holding that the commercial use of the domain names constituted dilution. Defendant is enjoined from using the domain names for commercial purposes.

PHAT, PHAT FARM and related marks for urban and athletic apparel v. PHAT & PHAT GAME for same, Phat Fashions, L.L.C. v. Phat Game Athletic Apparel, Inc., 2002 WL 570681, E.D. Cal., 3/20/02. The court granted summary judgment in favor of plaintiff on its trademark infringement claim and dilution by blurring and issued a permanent injunction.


Three-stripe mark and trade dress of tennis shoes v. Four-stripe mark and trade dress of tennis shoes, Adidas-Salomon v. Target Corp., 2002 U.S. Dist. LEXIS 19592, Oregon, 7/31/02. The court recommended that defendant’s motion for summary judgment be denied holding that plaintiff has submitted sufficient evidence as to the fame of its mark.


Trade dress of M&Ms candy packaging v. packaging of ROCKLETS candy, Masterfoods USA v. Arcor USA, Inc., 230 F. Supp. 2d 302, W.D.N.Y., 11/4/02. The court found that the defendant should be preliminarily enjoined from selling their candies in the United States in the packaging at issue.

VELVEETA for cheese products v. KING VELVEETA identifier in connection with sexually explicit website, Kraft Foods Holdings, Inc. v. Helm, 63 U.S.P.Q.2d 1353, N.D. Ill., 6/7/02. The court held that plaintiff was likely to prevail on its dilution claims under federal and Illinois law and granted preliminary injunction.

VICTORIA’S SECRET for lingerie v. VICTORIA’S SECRET as a hyperlink to defendant’s commercial websites, Victoria’s Secret Stores v. Artock Equipment Co., Inc., 194 F. Supp. 2d 704, S.D.
Ohio, 3/27/02. The court denied defendant’s motion to set aside a default ruling, holding that plaintiff showed strong likelihood of confusion and dilution.

VISA for a variety of goods and services v. EVISA.COM domain name, Visa International Service Association v. JSL Corporation, 2002 U.S. Dist. LEXIS 24779, Nevada, 10/22/02. The court granted plaintiff’s motion for summary judgment on its dilution claim.

APPELLATE COURTS

BEIBE for upscale women’s clothing v. BE for upscale women’s clothing, Bebe Stores, Inc. v. May Department Stores International, 2002 U.S. App. LEXIS 26130, 8th Cir., 10/21/02. The court affirmed the preliminary injunction in favor of plaintiff.

CHURCH OF THE CREATOR for religious instruction and teaching materials v. WORLD CHURCH OF THE CREATOR to communicate religious message, Te-Ta Ma Truth Found. v. The World Church of the Creator, 63 U.S.P.Q.2d 1760, 7th Cir., 7/25/02. The appellate court reversed the trial court’s holding that plaintiff’s mark is generic, holding instead that it is descriptive, and remanded the case with instructions to enter judgment for plaintiff.

ERNEST & JULIO GALLO for wine v. ERNESTANDJULIOGALLO.COM domain name for website that was critical of this litigation, of alcohol, and of corporate America, E. & J. Gallo Winery v. Spider Webs Ltd., 62 U.S.P.Q.2d 1404, 5th Cir., 4/3/02. The court affirmed the district court’s grant of partial summary judgment in favor of the plaintiff on its Texas state dilution claim and the resulting permanent injunction, also finding that the defendant’s use of the domain name was commercial. The court also affirmed the district court’s finding that the defendant violated the Anti-Cybersquatting Protection Act.

TABULATION—NO DILUTION FOUND

TRIAL COURTS

05 for sportswear v. 05 for same, GTFM, Inc. v. Solid Clothing Inc., 215 F. Supp. 2d 273, S.D.N.Y., 7/11/02. The court ruled in favor of plaintiff on its trademark infringement, false designation of origin, common law trademark infringement and unfair competition, and state general business law claims. However, the court ruled in favor of the defendant on the dilution claim holding
that plaintiff's mark is not inherently distinctive and is not a famous mark.

AFLAC for insurance services v. TAFTQUACK for gubernatorial candidate's Internet commercial, American Family Life Insurance Company v. Timothy Hagan, 64 U.S.P.Q.2d 1865, N.D. Ohio, 10/25/02. The court denied plaintiff's motion for preliminary injunction concluding that the dilution claims were likely to fail because the use of the mark was used in a communicative message and not as a source identifier, therefore, the defendant is protected under the First Amendment.

BOO for use in connection with the sale of children's and adult clothing v. BOO.COM for use in connection with a portal site that offered a “click-through” service for clothing retailers, Boo, Inc. v. Boo.com Group Ltd., 62 U.S.P.Q.2d 1603, D. Minn., 2/21/02. The court granted defendant's motion for summary judgment on plaintiff's dilution claim because 1) there was “scant evidence” that plaintiff's mark was “famous” or strong before defendant began using BOO.COM, and 2) because plaintiff did not use its mark long before defendant launched BOO.COM, plaintiff cannot show dilution.

CHURCH OF THE CREATOR for religious instruction and teaching materials v. WORLD CHURCH OF THE CREATOR to communicate religious message, Te-Ta Ma Truth Found. v. The World Church of the Creator, 61 U.S.P.Q.2d 1914, N.D. Ill., 1/31/02. The court granted defendant's motion for summary judgment, holding that the mark CHURCH OF THE CREATOR is generic and, therefore, precluding recovery for trademark dilution. This decision was reversed and remanded by Te-Ta Ma Truth Found. v. The World Church of the Creator, 63 U.S.P.Q.2d 1769, 7th Cir., 7/25/02 (see above).

The colors green and yellow on agricultural equipment v. same, Deere & Company v. MTD Products, Inc., 2002 U.S. Dist. LEXIS 14799, S.D.N.Y., 8/9/02. The court granted defendant's motion to dismiss plaintiff's federal dilution claims holding that color alone cannot be inherently distinctive. The court granted defendant's motion to dismiss plaintiff's state dilution claim because, under Illinois law, commercial competitors cannot recover under the anti-dilution statute.

FUTURA for automotive tires v. FORTERA for same, The Pep Boys Manny, Moe & Jack v. The Goodyear Tire & Rubber Co., 2002 WL 52400, E.D. Pa., 4/5/02. The court denied plaintiff's motion for preliminary injunction on its claims for trademark infringement, unfair competition, and trademark dilution. Specifically, the court held that plaintiff failed to demonstrate actual or a likelihood of
confusion or that defendant’s product was inferior and, therefore, failed to demonstrate a likelihood of success on its dilution claims.

LAWOFFICES.NET domain name in connection with attorney directory and legal information services v. LAWOFFICE.COM in connection with legal directory and law information services, Degidio v. West Group Corp., 191 F. Supp. 2d 904, N.D. Ohio, 3/18/02. The court held that plaintiff failed to establish secondary meaning and, therefore, granted summary judgment to defendant on plaintiff’s trademark infringement, unfair competition and dilution claims.

LONGEVITY BRAND and Design for condensed milk v. LONGEVITY SWEETENED CONDENSED MILK (in Chinese) and Design, Friesland Brands, B.V. v. Vietnam National Milk Company, 228 F. Supp. 2d 399, S.D.N.Y., 10/16/02. The court granted summary judgment in favor of the defendants holding that plaintiff had not shown that their mark is famous. The court denied summary judgment on the state dilution claim holding that a reasonable trier of fact could find in favor of plaintiff.

LOUIS KEMP for rice products v. LOUIS KEMP for surimi-based seafood products, Louis Kemp v. Bumble Bee Seafoods, Inc., 2002 U.S. Dist. LEXIS 19316, Minn., 9/30/02. The court dismissed defendant’s counterclaim for dilution because the defendant has not carried its burden of proof. The court concluded that even if the defendant had carried its burden for a dilution claim, it has not shown that the plaintiff’s use of his personal name in connection with rice products dilutes the distinctive quality of defendant’s marks.

NO FLOAT for mulch packaging v. NON-FLOATING for the same, Corbitt Manuf. Co. v. GSO America, Inc., 197 F. Supp. 2d 1368, S.D. Ga., 4/19/02. The court denied plaintiff’s motion for preliminary injunction on its trademark infringement and trademark dilution claims. The court held with respect to the dilution claims that plaintiff had not shown the requisite level of fame required by the federal statute, nor did it establish distinctiveness as required by the Georgia dilution statute.

SEIKO for watches and clocks and PULSAR for watches, clocks and watch boxes v. SEIKO and PULSAR on watch boxes, Seiko Kabushiki Kaisha v. Swiss Watch Int’l, Inc., 63 U.S.P.Q.2d 1038, S.D. Fla., 2/4/02. The court denied plaintiff’s motion for preliminary injunction, holding that plaintiff did not demonstrate irreparable injury because plaintiff was aware of defendant’s activities for at least one year prior to filing suit, thereby negating need for speedy action.

STAR WARS for feature film v. STARBALLZ for production and distribution of animated pornographic film, Lucasfilm Ltd. v. Media Market Group, Ltd., 182 F. Supp. 2d 897, N.D. Cal., 1/8/02. The court denied plaintiff’s motion for preliminary injunction on dilution claim, holding that plaintiff failed to demonstrate a likelihood of success on the merits because the animated file was a parody and, therefore, a “non-commercial” use of the mark.

SURVIVOR for rock band v. SURVIVOR for reality television program, Sullivan v. CBS Corp., 2002 WL 554506, N.D. Ill., 4/15/02. Plaintiff alleged trademark infringement, federal and common law trademark dilution, unfair competition and deceptive trade practices. The court granted summary judgment in favor of the defendants, holding that the renown of the rock band’s mark SURVIVOR was limited to the fairly narrow rock music scene and that plaintiff failed to establish fame.

TETON GLACIER for vodka v. GLACIER BAY for vodka cooler, National Distillers Prods. Co. v. Refreshment Brands, Inc., 198 F. Supp. 2d 474, S.D.N.Y., 4/12/02. After a bench trial in this action involving claims for trademark and trade dress infringement, trademark dilution, and state unfair competition and false advertising, the court held that plaintiff failed to demonstrate that its mark was famous and, therefore, found that there was no dilution under federal law. Moreover, the court held that plaintiff’s dilution claim under state law failed as well, holding that the TETON GLACIER mark was not so distinctive or well known to pass the appropriate test under New York dilution law.

TOMMY HILFIGER for fragrances v. TOMMY HOLEDIGGER for pet perfumes, Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC, 221 F. Supp. 2d 410, S.D.N.Y., 8/6/02. The court granted defendant’s motion for summary judgment holding that parodies of this type do not cause blurring or tarnishment.

TYCOS for medical instruments v. TYCO for a variety of products in medical industry, Welch Allyn, Inc. v. Tyco Int’l Serv. AG, 63 U.S.P.Q.2d 1508, N.D.N.Y., 4/12/02. The court denied plaintiff’s motion for preliminary injunction on its trademark infringement and dilution claims, holding that plaintiff failed to demonstrate that its mark was famous.

WE for magazines and online magazines v. WE: WOMEN’S ENTERTAINMENT for cable television channel, WE Media, Inc. v. General Electric Co., 218 F. Supp. 2d 463, S.D.N.Y., 8/23/02. The court granted defendant’s motion for summary judgment holding that plaintiff’s marks were not sufficiently famous to support a claim for trademark dilution.

XALATAN for prescription glaucoma drug v. TRAVATAN for the same, Pharmacia Corp. v. Alcon Labs., Inc., 201 F. Supp. 2d 335, D.N.J., 5/14/02. The court denied plaintiff’s preliminary injunction motion on trademark infringement and dilution claims, holding plaintiff failed to demonstrate a likelihood of success.

X-MEN for comic book characters v. various domain names comprised of the term XMEN, Twentieth Century Fox Film Corporation v. Marvel Enterprises, Inc., 220 F. Supp. 2d 289, S.D.N.Y., 9/24/02. The court dismissed defendant’s counterclaim for trademark dilution because some of the domain names linked the Internet user to Fox’s main website that contained a link for the X-Men films. Although some websites were found inactive, the court found that this did not provide a basis for a claim for dilution.

YKK for zippers v. YPP for zippers, YKK Corporation v. Jungwoo Zipper Co., Ltd., 213 F. Supp. 2d 1195, C.D. Cal., 8/8/02. The court granted plaintiff’s motion for summary judgment of its claims for trademark infringement and unfair competition. However, the court denied plaintiff’s motion for summary judgment of its claim for trademark dilution holding that it is inappropriate when the parties are competitors offering similar goods.

APPELLATE COURTS

FINANCIA for Software company’s trade name v. corporation which operated www.efinancia.com website, Bird v. Parsons, 62 U.S.P.Q.2d 1905, 6th Cir., 5/21/02. The court affirmed the district court’s granting of defendant’s motion to dismiss for failure to state a claim, holding specifically with respect to plaintiff’s trademark dilution claim that because defendants did not engage in commercial use of plaintiff’s trademark, plaintiff failed to state a claim for trademark dilution.
PLAYBOY PLAYMATE OF THE YEAR IN 1981 and similar marks as designation of magazine model v. same or similar used by model on personal website, Playboy Enterprises, Inc. v. Welles, 61 U.S.P.Q.2d 1508, 9th Cir., 2/1/02. The district court granted defendant’s motion for summary judgment on plaintiff’s trademark infringement and dilution claims and plaintiff appealed. The appeals court affirmed the district court’s ruling insofar as defendant’s use on a website was nominative and that nominative use does not dilute trademark; however, with respect to defendant’s use of the PBOY 1981 mark on website’s “wallpaper,” the court held such use was not nominative and, therefore, the appellate court reversed and remanded the district court’s finding of non-dilution with respect to that use for further proceeding.

Trade dress infringement and dilution, court of appeals affirmed district court’s dismissal of plaintiff’s dilution claim where plaintiff claimed defendant’s use of a similar bottle for beverages constituted, Beverage Marketing USA, Inc. v. South Beach Beverage Corp., 2002 WL 1162789, 2d Cir., 6/3/02. The court affirmed the trial court’s ruling and held that because the overall trade dress of the bottles were dissimilar, no rational juror could conclude that defendant’s use of its bottle causes dilution.
TABULATION—OTHER

TRIAL COURTS

A6 for cars v. A6.COM for domain name for website displaying pornographic images, Audi A.G. & Volkswagen of Amer. v. Izumi, 204 F. Supp. 2d 1014, E.D. Mich., 5/17/02. The court in this cybersquatting, trademark infringement and trademark dilution action, found that plaintiff properly served defendant, that defendant’s website was sufficiently interactive to support personal jurisdiction, and that venue was proper.

ABC, A.B.C. CARPET and ABC CARPET & HOME in connection with retail services offering carpets, rugs and other home goods v. ABCCARPETANDHOME.NET, A.B.C. Carpet Co., Inc. v. Naeini, 2002 WL 100604, E.D.N.Y., 1/22/02. The court denied plaintiff’s motion for summary judgment holding that plaintiff failed to establish that its marks were famous as a matter of law.

ALLSTATE for insurance services v. use of false email address of eliddy@allstate.com for purposes of criticizing and challenging plaintiff’s services, Allstate Insurance Co. v. Mathison, 2002 WL 1396951, N.D. Ill., 6/26/02. On defendant’s motion, the court dismissed plaintiff’s count for willful infringement, which was based on an Illinois criminal statute, but denied defendant’s motion to dismiss plaintiff’s dilution claim under Illinois law. The court also granted defendant’s motion to transfer venue.


Armament Sys. and Procedures v. Lansky Lights, Inc., 2002 WL 726801, N.D. Ill., 4/24/02. Plaintiff who makes and sells handheld flashlights alleged that defendant’s sale of a handheld flashlight constitutes trade dress infringement and trade dress dilution. The court denied defendant’s motion for summary judgment on these claims holding with respect to the dilution claim that the federal anti-dilution statute might apply to this trade dress dilution claim.

counterclaims by trademark owner for trademark infringement, dilution, and relief under Anticybersquatting Consumer Protection Act. On cross-motions for summary judgment, the court held, among other things, that trademark was infringed and that operators violated anticybersquatting law. However, the court also held that trademark holders failed to establish basis for summary judgment on its dilution claims because plaintiff failed to demonstrate economic harm.

COHIBA for cigars v. COHIBA for same, Empresa Cubana del Tabaco v. Culbro Corp., 213 F. Supp. 2d 247, S.D.N.Y., 6/26/02. On motion for summary judgment, court held that fact issues existed with respect to whether defendant intentionally infringed trademark and whether plaintiff’s mark was well known throughout the United States at the time defendant registered its mark.

EQUAL for artificial sweetener v. EQUAL for the same; plaintiff alleged that defendant used identical mark on packages containing plaintiff’s product, but that defendant was not authorized to do so, Monsato Co. v. Campuzano, 206 F. Supp. 2d 1239, S.D. Fl., 4/25/02. The court held Florida’s anti-dilution statute did not apply because defendant was using similar mark on similar goods and denied plaintiff’s motion for summary judgment on that claim.

Imation Corp. v. Quantum Corp., 2002 WL 385550, D. Minn., 3/8/02. In a trade secret case involving counterclaims claim for false advertising, false association and trademark dilution, the court denied defendant’s motion to transfer case to California.

LEVTS tab for pants v. similar tab, Levi Strauss & Co. v. GFTM, Inc., 62 U.S.P.Q.2d 1394, N.D. Cal., 3/29/02. Plaintiff who manufactures jeans and clothing that bear patch pockets and a tab attached to one rear pocket at the lower seam sued defendant for trademark infringement and dilution because defendant manufactures and sells clothing that displays a tab sewn into a seam of a pocket. Defendant counterclaimed, challenging plaintiff’s five trademark registrations. The court granted plaintiff’s summary judgment on defendant’s counterclaims, holding that the basis for defendant’s counterclaims does not fall within the allowable grounds for challenging a trademark under the Lanham Act.

SCC Communications Corp. v. Andersen, 195 F. Supp. 2d 1257, D. Colo., 3/25/02. In an action involving trademark dilution, cybersquatting and unfair competition claims, the court held that an owner of an Internet domain name did not establish minimum contacts with Colorado, the forum state.
SFS Pac Program for food service sanitation package and products v. a similar plan, Portionpac Chemical Corp. v. Sanitech Sys., Inc., 210 F. Supp. 2d 1302, M.D. Fla., 6/14/02. The court held that plaintiff’s trade dress, trademark, and dilution claims state a cause of action and denied defendant’s motion to dismiss with respect to these claims.

STEINWAY for pianos v. STEINWAY for piano decals sold to people who apply decals to pianos which may or may not be plaintiff’s pianos, Steinway, Inc. v. Ashley, 2002 WL 122929, S.D.N.Y., 1/29/02. The court denied defendant’s motion to dismiss for failure to state a claim, holding specifically that plaintiff’s dilution claim is sufficiently supported by alleged facts and that the viability of a “contributory dilution” claim is plausible.

Storey v. Cello Holdings, L.L.C., 182 F. Supp. 2d 355, S.D.N.Y., 1/23/02. The court held that the discontinuance of trademark dilution and cybersquatting suit “with prejudice” operated as an adjudication on the merits, and therefore, barred plaintiff from asserting same claim in arbitration.

Trademark infringement, dilution, false designation of origin and unfair competition claims, as well as defendant’s counterclaims for malicious prosecution, Tommy Hilfiger Licensing, Inc. v. Bradlees, Inc., 2002 WL 737477, S.D.N.Y., 4/25/02. The court denied plaintiff’s motion to dismiss defendant’s counterclaim and plaintiff’s motion to strike.

TRES for family of hair care products v. TREVIVE for same, Alberto-Culver Co. v. Trevive, Inc., 199 F. Supp. 2d 1004, C.D. Cal., 5/8/02. The court granted plaintiff’s motion for partial summary judgment, holding 1) that collateral estoppel barred relitigation of TTAB’s determination that TREVIVE was likely to cause confusion with plaintiff’s marks, but that this decision did not cover defendant’s changed use of the mark since the TTAB ruling; and 2) that plaintiff’s requested permanent injunctive relief was too broad.

UPS for Shipping Services v. UPS.NET domain name. United Parcel Serv. v. Net, Inc., 185 F. Supp. 2d 274, E.D.N.Y., 2/15/02. In a case involving trademark owner’s trademark infringement and dilution claims, the court set aside default judgment because defendant’s default was not willful and plaintiff would not be prejudiced.

**APPELLATE COURTS**

DIANA PRINCESS OF WHALES for charitable services v. the use of Princess Diana’s name on various products, such as jewelry, plates and dolls, Cairns v. Franklin Mint Co., 63 U.S.P.Q.2d 1279, 9th
Cir., 2002. The Ninth Circuit affirmed the portion of the district court’s opinion that awarded defendant attorney’s fees for prevailing on plaintiff’s right of publicity, false advertising and trademark dilution claims.

Neogen Corp. v. Neo Gen Screening, Inc., 61 U.S.P.Q.2d 1845, 6th Cir., 2002. The district court dismissed plaintiff’s case, which included trademark infringement and dilution claims, for lack of personal jurisdiction. The Sixth Circuit held that defendant was subject to personal jurisdiction and had sufficient minimum contacts to satisfy due process and, therefore, reversed and remanded.

NEW YORK STOCK EXCHANGE marks for securities trading and related services v. variations of NYSE’s marks for casino gambling and related goods and services, New York Stock Exchange, Inc. v. New York, New York Hotel, LLC, 62 U.S.P.Q.2d 1260, 2d Cir., 2002. The court affirmed the dismissal of plaintiff’s dilution claims related to all but one mark on the grounds that the marks were not inherently distinctive. The one exception was with respect to a registered logo consisting of the NYSE building’s façade with the words NEW YORK STOCK EXCHANGE in which the court held that a trier of fact might find it to be distinct and, therefore, remanded the dilution claim with respect to this mark. With respect to the NEW YORK STOCK EXCHANGE dilution claims, the court affirmed dismissal of blurring claims, but reversed the dismissal of plaintiff’s tarnishment claim.

SMILECARE to promote dental care services v. SMILECARE to promote private dental practice, Community Dental Serv. v. Tani, 61 U.S.P.Q.2d 1922, 9th Cir., 2002. In an action for trademark infringement, dilution and unfair competition, in which the district court denied defendant’s motion for relief from default judgment, the Ninth Circuit held that the district court abused its discretion, finding that the party’s attorney was grossly negligent, and remanded the matter for reinstatement.