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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: Trial Courts, Appellate Courts, Supreme Court and Trademark Trial and Appeal Board. Also, at the end of some cases will be an O in brackets that represents Opposition Proceedings.

TRIAL COURTS

ADVANTAGE and NOFLEAS.COM for animal flea control preparations sold to consumers through veterinarians v. ADVANTAGE and NO-FLEAS.COM for plaintiff’s animal flea control preparations produced for sale outside of the United States and sold by defendant directly to consumers without the required U.S. labeling, Bayer Corp. v. Custom School Frames LLC, 67 U.S.P.Q.2d 1185 (E.D. La. 2003).


COMPACT and INTERMEDIATE for the overall look of mat-cutting systems and cutting tools sold under the names v. nearly identical trade dress for similar products sold under the names HOMEPRO and STUDIO PRO, Logan Graphic Products Inc. v. Textus USA Inc., 67 U.S.P.Q.2d 1470 (N.D. Ill. 2003) (preliminary injunction granted).


*= 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.
DISNEY, BUENA VISTA, MIRAMAX, HOLLYWOOD PICTURES, TOUCHSTONE for motion pictures v. the same marks displayed at the beginning of unauthorized video clip previews of motion pictures used on the Internet to promote video rentals, Video Pipeline Inc. v. Buena Vista Home Entertainment Inc., 67 U.S.P.Q.2d 1887 (D.N.J. 2003).


SKOFLO for chemical injection valves v. SKOFLO and SKOFLOW website metatags on amflow.com website and SKOFLO.COM domain name linking to amflow.com website selling competing line


APPELLATE COURTS


CASINO DE MONTE CARLO for resort and casino services v. CASINODEMONTECARLO.COM [and use of CASINODEMONTECARLO or parts thereof in various forms in 53 domain names] for online gambling, International Bancorp LLC v. Societe des Bains de Mer et du Cercle des Etrangers a Monaco, 66 U.S.P.Q.2d 1705 (4th Cir. 2003).

FORD for motor vehicles and related goods and services v. FORDWORLD.COM for a domain name allegedly registered in bad faith with the intent to confuse, Ford Motor Co. v. Catalanotte, 68 U.S.P.Q.2d 1050 (6th Cir. 2003).


PETERBILT and KENWORTH for trucks and used truck locator databases v. PETERBILT and KENWORTH for used truck locator databases, PACCAR, Inc. v. TeleScan Technologies, LLC, 65 U.S.P.Q.2d 1761 (6th Cir. 2003).

PRO FITNESS for physical therapy services v. PRO-FIT for physical therapy services, Pro Fitness Physical Therapy Center v. Pro-Fit Orthopedic and Sports Physical Therapy, P.C., 65 U.S.P.Q.2d 1195 (2d Cir. 2002).


**TRADEMARK TRIAL AND APPEAL BOARD**

OFFICENET v. OFFICE.NET, both for computer hardware and software products, *In re Microsoft Corp.*, 68 U.S.P.Q.2d 1195, T.T.A.B., 9/11/03.

**TABULATION—NO CONFUSING SIMILARITY FOUND**

**TRIAL COURTS**


SOUND BLASTER v. PREDATOR BLASTWAVE [used with SOUND BLASTER], both for sound cards used with personal computers—fair use, *Creative Labs Inc. v. Mad Dog Multimedia Inc.*, 66 U.S.P.Q.2d 1625 (N.D. Cal. 2002).


24 HOUR FITNESS and 24HOURFITNESS.COM v. 24/7 FITNESS and 247FITNESSCLUB.COM, both for health and fitness club services (plaintiff’s motion for preliminary injunction denied), *24 Hour Fitness USA, Inc. v. 24/7 Tribeca Fitness, LLC*, 68 U.S.P.Q.2d 1031 (S.D.N.Y. 2003).


APPELLATE COURTS


“Jeep grille design,” no similar trade dress found, AM General Corp. v. DaimlerChrysler Corp., 65 U.S.P.Q.2d 1001 (7th Cir. 2002).


TIGER WOODS golfer v. image of TIGER WOODS in limited edition prints of “Masters of Augusta” painting also featuring images of other golfers, ETW Corp. v. Jireh Publishing Inc., 67 U.S.P.Q.2d 1065 (6th Cir. 2003) (Lanham Act does not apply to artistic work where the public interest in avoiding confusion was not outweighed by the public interest in free expression).

TOUCAN SAM word mark and toucan logo for breakfast cereal v. TOUCAN GOLD word mark and toucan logo for golf equipment, Kellogg Co. v. Toucan Golf Inc., 67 U.S.P.Q.2d 1481 (6th Cir. 2003).
TRADEMARK TRIAL AND APPEAL BOARD

AK AMERICAN KHAKIS and design (“American khakis” disclaimed) for sportswear v. AK and design for athletic clothing, In re TSI Brands, 67 U.S.P.Q.2d 1657, T.T.A.B., 4/30/02.


TABULATION—DILUTION FOUND*

Editor’s Note: In each section that 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

ADVANTAGE and NOFLEAS.COM for animal flea control preparations sold to consumers through veterinarians v. ADVANTAGE and NO-FLEAS.COM for plaintiff’s animal flea control preparations produced for sale outside of the United States and sold by defendant directly to consumers without the required U.S. labeling, Bayer Corp. v. Custom School Frames LLC, 67 U.S.P.Q.2d 1185 (E.D. La. 2003).

CENTEX for various home maintenance services v. CEN-TEX and CENTEX for home cleaning and carpet repair services, Centex Corp. v. Cen-Tex Carpet Care, 2003 U.S. Dist. LEXIS 2087 (N.D. Tex., Feb. 12, 2003). Permanent injunction entered following

* Cases in this section were summarized by Marnie Barnhorst and Felicia Boyd, members of the TMR Editorial Board. We would like to thank Nicholas Barnhorst, Marquette University School of Law, for his invaluable assistance in reviewing these cases and preparing the tabulation. We would also like to express our appreciation to Mark Schollaert, University of San Diego School of Law, for his initial research.
default judgment on Texas state law dilution claims; Texas state law only.


PASHA DE CARTIER trade dress and GRILLE design for watches v. alleged copies of the design in similar watches, Cartier, Inc. v. Four Star Jewelry Creations, Inc., 2003 U.S. Dist. LEXIS 7844 (S.D.N.Y. May 8, 2003). Preliminary junction granted based on likelihood of success on New York statutory dilution and federal infringement claims; State law dilution claims only.


**APPELLATE COURTS**

FORD for automobiles and FORDWORLD.COM domain name merely for sale, *Ford Motor Co. v. Catalanotte*, 342 F.3d 543 (6th Cir. 2003). The court upheld judgment awarding motor company injunctive relief and statutory damages for cybersquatting, conspiracy, dilution, infringement, and false designation of origin.

PETERBILT and KENWORTH for heavy trucks and truck parts v. PETERBILTNEWTRUCKS.COM, PETERBILTEDTRUCKS.COM, KENWORTHNEWTRUCKS.COM, KENWORTHUSEDTRUCKS.COM, and other related domain names for truck dealer locator website, *Paccar, Inc. v. TeleScan Technologies, L.L.C.*, 319 F.3d 243, 65 U.S.P.Q.2d 1761 (6th Cir. 2003). Dilution found in lower court but issue not reached on appeal because likelihood of success on infringement claims warranted granting of preliminary injunction against defendants.

**TABULATION—NO DILUTION FOUND**

**TRIAL COURTS**

BEST CELLARS for specialty wine stores catering to novice wine drinkers v. BACCHUS for same, *Best Cellars, Inc. v. Wine Made Simple, Inc.*, 2003 U.S. Dist. LEXIS 3958 (S.D.N.Y. Mar. 11, 2003). Cross motions for summary judgment denied for both parties on trade dress claims, but defendant’s motion for summary judgment granted as to dilution as owner’s mark was not famous.

CATERPILLAR, CAT, CAT and design, and other marks for earth-moving construction machinery v. film production companies’ unauthorized use of same driven by evil henchmen in children’s movie, *Caterpillar, Inc. v. Walt Disney Co.*, 68 U.S.P.Q.2d 1461 (C.D. Ill. 2003). Plaintiff’s motion for TRO denied because of unlikelihood of success on the merits of all claims, including for dilution.
THE CRISTOPHER D. SMITHERS FOUNDATION for alcohol abuse treatment centers in a homelike setting v. hospital licensee trying to relocate the center to a hospital wing, Christopher D. Smithers Found. v. Luke’s-Roosevelt Hosp. Ctr. 2003 U.S. Dist. LEXIS 373 (S.D.N.Y. Jan. 13, 2003). Federal dilution claims dismissed as no reasonable trier of fact could conclude owner’s mark was famous and mark was descriptive rather than distinctive and so not entitled to protection under the Federal Trademark Dilution Act.

DAYTONA USA, DAYTONA 500, and various other DAYTONA marks for stock car and motorcycle races v. DAYTONA and DONZI DAYTONA for high-performance recreational boats, HBP, Inc. v. Am. Marine Holdings, Inc., 2003 U.S. Dist. LEXIS 20165 (M.D. Fla. June 13, 2003). Defendant’s motion for summary judgment granted, as owner failed to show any evidence that customers had formed a different impression of their products or services.

Deere & Co.’s yellow and green colors as applied to lawn care products v. same, Deere & Co. v. MTD Prods., 2003 U.S. Dist. LEXIS 19161 (S.D.N.Y. Oct. 27, 2003). Plaintiff’s motion to amend complaint denied because color combination was not inherently distinctive.

ECHO for fashion accessories and home design goods v. ECHO DAVIDOFF for men’s fragrances, Echo Design Grp. v. Zino Davidoff, S.A., 283 F. Supp. 2d 963 (S.D.N.Y. 2003). Plaintiff’s motion for preliminary injunction denied because of inability to show that mark was famous and distinctive.

FREEBIE.COM for incentive offers attached to retail cash registers and tied to customer purchases v. FREEBIES for Freebies Magazine displaying free mail order offerings, Retail Services, Inc. v. Freebies Publishing, 247 F. Supp. 2d 822 (E.D. Va. 2003). Defendant’s counterclaims for dilution dismissed and defendants trademark registration cancelled in its entirety because “freebies” is generic.

Gateway’s stylized black spots for computers and computer peripherals v. CODY COW for a cow stretch pet that wraps around a television or computer monitor, Gateway, Inc. v. Companion Products, Inc., 68 U.S.P.Q.2d 1407 (D.S.D. 2003). Trademark owner successful on infringement and other claims, but unsuccessful on dilution claims by failing to show actual dilution.

<<O>> for erotica and adult magazine v. O THE OPRAH MAGAZINE for modern women’s magazine, Brockmeyer v. Hearst
Corp., 248 F. Supp. 2d 281 (S.D.N.Y. 2003). Defendant’s motion for summary judgment granted dismissing all trademark owners’ claims, including dilution under NY state law only.


THE SANDY KANE COMEDY SHOW for public access television comic variety show featuring eponymous comedienne wearing little to no clothing v. cable television news comedy show making unauthorized use of clip to parody same, Kane v. Comedy Partners, 2003 U.S. Dist. LEXIS 18513 (S.D.N.Y. Oct. 15, 2003). Plaintiff’s claims under NY State law failed for failing to show any likelihood of confusion as required for dilution claim; State law dilution claim only.


SLIP ’N SLIDE for water-slide toy v. film company using product incorrectly and dangerously in motion picture, Wham-O, Inc. v.
Paramount Pictures Corp., 286 F. Supp. 2d 1254 (N.D. Cal. 2003). Plaintiff’s motion for TRO denied because of unlikelihood of success on the merits, because use of product and name in absurd light did not actually harm the mark as required for dilution.

SWEDISH FISH and THE ORIGINAL SWEDISH FISH for fish-shaped gummy candy v. FAMOUS SQWISH CANDY FISH for same, Malaco Leaf, Inc. v. Promotion in Motion, Inc., 2003 U.S. Dist. LEXIS 17086 (S.D.N.Y. Sept. 29, 2003). Defendant’s motion for summary judgment granted as to dilution claims because mark is neither inherently distinctive nor strong.


VOICE-TEL for voice messaging services v. franchisee whose website temporarily contained unauthorized link to pornography, Voice-Tel Enters. v. Joba, Inc., 258 F. Supp. 2d 1353 (N.D. Ga. 2003). Defendant website operator’s motion for summary judgment granted as extension of dilution protection to this situation would enhance scope of protection beyond that intended by Congress.

WET ONES for moist towelettes v. QUILTED NORTHERN MOIST ONES for general purpose wipes, Playtex Products, Inc. v. Georgia-Pacific, Inc., 67 U.S.P.Q.2d 1923 (S.D.N.Y. 2003). Defendant’s motion for summary judgment on dilution issue granted because marks were not sufficiently similar to support claim.
WORLD SAVINGS AND LOAN, WORLD, WORLD SAVINGS, and other related marks for mortgage lending v. WORLD LENDING GROUP, WORLD LENDING for mortgage services, *Golden W. Fin. v. WMA Mortgage Svcs.*, 2003 U.S. Dist. LEXIS 4100 (N.D. Cal. Mar. 12, 2003). Owner’s motion for preliminary injunction denied for failure to show that the alleged infringers’ conduct diluted their marks, even assuming they could show that the marks are famous.

**APPELLATE COURTS**


CASINO DE MONTE CARLO for resort casino v. CASINODEMONTECARLO.COM, CASINOMONECARLO.COM and several other websites for Internet gambling, *Int’l Bancorp, L.L.C. v. Societe des Bains de Mer et du Cercle des Estrangers a Monaco*, 329 F.3d 359 (4th Cir. 2003). Infringement claims upheld and dismissal of dilution claims based on failure to show actual economic harm affirmed.


ICEE for semi-frozen beverage and cups v. same in squeeze tubes, *Icee Distribs. v. J&J Snack Foods Corp.*, 325 F.3d 586, 66 U.S.P.Q.2d 1161 (5th Cir. 2003). Court determined that though injunction could stand based on breach of contract, the district court clearly erred in allowing dilution claims, because only trademark owner and not exclusive licensee has standing to sue under the act.

“Jeep grille design” claimed family of marks, no dilution found, *AM General Corp. v. DaimlerChrysler Corp.*, 65 U.S.P.Q.2d 1001 (7th Cir. 2002).

LAP TRAVELER for portable computer stands v. seller of THE MOBILE DESK advertised as a redesign and improvement of LAP TRAVELER, *Interactive Prods. Corp. v. A2z Mobile Office*

MERCEDES and MERCEDES BENZ for automobiles v. 1-800-637-2333 (MERCEDES) for locating automobile dealers, DaimlerChrysler AG v. Bloom, 315 F.3d 932, 65 U.S.P.Q.2d 1359 (8th Cir. 2003). Summary judgment for telecom affirmed because licensing of toll-free number with one possible alphanumeric translation being owner’s mark did not constitute use within Lanham Act.


PYCNOGENOL for pine bark extract product v. unauthorized Internet retailer selling same, Horphag Research, Ltd. v. Pellegrini, 337 F.3d 1036, 67 U.S.P.Q.2d 1532 (9th Cir. 2003). District court’s judgment on dilution claim vacated and remanded in light of new standard set forth in Moseley.

TIGER WOODS for marketing use of name, image, and likeness of golfer v. publisher and painter of images of same golfer, ETW Corp. v. Jireh Publ’g, Inc., 332 F.3d 915, 67 U.S.P.Q.2d 1065 (6th Cir. 2003). Summary judgment for publisher affirmed as court held that image or likeness could not function as a trademark.


TOUCAN SAM for breakfast cereal mascot v. TOUCAN GOLD for promotional golf equipment, Kellogg Co. v. Toucan Golf, Inc., 337 F.3d 616 (6th Cir. 2003). Lower court’s decision affirming TTAB’s registration of golf company’s mark affirmed and no showing of actual dilution.

TTAB decision that plaintiff's opposition to registration was barred by res judicata because of earlier determination that mark was not famous affirmed.

SUPREME COURT


TABULATION—OTHER

TRIAL COURTS


FIELDTURF for synthetic playing services v. FIELDTURF.NET and FIELDTURF.INFO domain names for competitor’s services, Fieldturf, Inc. v. Triexe Mgmt. Group, 2003 U.S. Dist. LEXIS 22280 (N.D. Ill. Dec. 10, 2003). Defendants’ motion for summary judgment on grounds that there was no commercial use denied.


FULL SAIL for a 4,000 student school in Florida v. FULLSAILSUCKS.COM and SHITTYSCHOOLS.COM domain names for informational sites that allow visitors to comment on schools, Full Sail, Inc. v. Spevack, 2003 U.S. Dist. LEXIS 20631 (M.D. Fla. Oct. 21, 2003). Defendant’s motion to dismiss for lack of personal jurisdiction granted.


INTERLOCKEN for summer camps and travel programs for boys and girls v. INTERLOCHEN for arts education, Interlocken Int’l Camp, Inc. v. Markel Ins. Co., 2003 DNH 30 (Dist. N.H. March 4, 2003). Insurance company not required to defend suit because allegedly infringing or diluting advertisements had been made prior to policy coverage.


Motions to dismiss and for declaration of ownership of trademarks denied without reaching dilution claims.

SHEPARD'S, LEXIS, NEXIS and other marks for legal research services v. unauthorized use of same to advertise new competing product, Reed Elsevier, Inc. v. thelaw.net Corp., 269 F. Supp. 2d 942 (S.D. Ohio 2003). Defendant’s motion to dismiss denied.

SPIN and SPIN SELLING for educational sales training and development materials v. alleged unauthorized use of same, Huthwaite, Inc. v. Sunrise Assisted Living, Inc., 261 F. Supp. 2d 502 (E.D. Va. 2003). Defendants’ motion for summary judgment on grounds that there was no commercial use denied.


VICTORIA'S SECRET for retail and catalog women’s lingerie sales v. VICTORIA'SSECRETDISESires.COM for adult Internet site, V Secret Catalogue, Inc. v. Zdrok, 2003 U.S. Dist. LEXIS 16159 (S.D. Ohio Aug. 28, 2003). The possibility that defendant may have been able to defend against dilution claim did not warrant setting aside entry of default judgment.


APPELLATE COURTS

CELLO for sale of audio equipment v. CELLO.COM domain name along with registration of approximately twenty other musical instrument domain names, Storey v. Cello Holdings, L.L.C., 347 F.3d 370; 68 U.S.P.Q.2d 1641 (2d Cir. 2003). Plaintiff's pending ACPA claim was not barred by earlier action dismissing with prejudice dilution and other claims because of events that had transpired since the first judgment.

COBRA and numerous other marks for sports cars and same for replicas of vintage sports cars, Superperformance Int'l, Inc. v. Hartford Casualty Ins. Co., 332 F.3d 215, 67 U.S.P.Q.2d 1040 (4th Cir. 2003). Court ruled that insurer was not required to defend
various suits falling outside trademark infringement exclusion of the policy.

L’OREAL for cosmetics v. LOREALCOMPLAINTS.COM domain name for communicating complaints, Hawes v. Network Solutions, Inc., 337 F.3d 377 (4th Cir. 2003). Owner voluntarily dismissed counterclaims including dilution after motion to dismiss granted.

NISSAN for automobiles v. NISSAN.COM and NISSAN.NET domain names for computer sales and services, State Auto Property and Casualty Ins. Co. v. Travelers Indemnity Co. Am., 343 F.3d 249 (4th Cir. 2003). Determination that defendant insurer company was not obligated to defend suit vacated and remanded.

ROLEX for watches v. alleged counterfeiter, Rolex Watch USA, Inc. v. JBJ Distribs, Inc., 77 Fed. Appx. 208 (5th Cir. 2003) (unpublished). Court determined that New York dilution law should not have been applied because there was no jurisdictional nexus connecting the defendant to New York, but that alone was not enough to warrant setting aside the judgment.