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Recent Developments

RECENT DEVELOPMENTS IN TRADEMARK LAW: ELUSIVE DILUTION AND SORTING THE RESULTING CONFUSION

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*353 Introduction

The past year was another active one for the trademark bar. Both courts and lawyers are sorting through the fallout from the two recent Supreme Court trade dress cases,[1] and the Court has now decided its first case addressing the Federal Trademark Dilution Act of 1995 (FTDA). Dilution and trade dress issues continued ***354** to receive a lot of attention in addition to the regular steady flow of infringement cases. While the number of Internet cases may be declining, several important precedents were set this past year. This paper surveys these and other trademark-related topics handled by the courts in 2002.

I. Dilution

A. Supreme Court Resolves Circuit Split on Likely vs. Actual Dilution: V Secret Catalogue, Inc. v. Moseley[2]

In March 2003, the Supreme Court decided the most hotly contested issue created by the FTDA.[3] The Court ruled that a plaintiff who owns a famous mark must prove that the defendant's use has actually diluted the famous mark, rather than only showing that a defendant's use is likely to dilute the famous mark's distinctive quality.[4] The Court granted certiorari in April 2002 and heard oral argument in November 2002.[5]

The Victoria's Secret chain of women's lingerie stores brought suit against the operators of an adult gift and novelty shop in Elizabethtown, Kentucky, which used the names "Victor's Secret" and "Victor's Little Secret."[6] The Sixth Circuit found that the shop diluted the VICTORIA'S SECRET mark both by blurring and by tarnishment, given that items sold at the shop included adult videos and novelties, as well as lingerie.[7]

In its opinion, the Sixth Circuit followed the Second Circuit's approach in Nabisco, Inc. v. PF Brands, Inc.,[8] concluding that a plaintiff need not prove actual, present injury to its mark to state a claim under the FTDA.[9] In so doing, the Sixth Circuit analyzed and then rejected the approach the Fourth Circuit took when it staked out the opposite position in Ringling Bros.-Barnum & Bailey Combined ***355** Shows, Inc. v. Utah Division of Travel Development,[10] ruling that actual, consummated injury is the correct standard under the FTDA.[11] The court noted that the Fifth Circuit sided with the Fourth's position in Westchester Media v. PRL USA Holdings, Inc.[12]

In the Supreme Court opinion, Justice Stevens wrote that the plain language of the statute ("causes dilution") "unambiguously requires a showing of actual dilution, rather than a likelihood of dilution."[13] That conclusion was bolstered by the FTDA's definition of dilution as "the lessening of the capacity of a famous mark to identify and distinguish goods or services."[14] The court noted, however, that consequences of dilution, such as actual loss of sales or profits, need not be proved.[15] Furthermore, direct evidence of dilution, such as consumer surveys, are not necessary if actual dilution can be reliably proven through circumstantial evidence, such as where the marks at issue are identical.[16] The Court also expressed some skepticism regarding the viability of a tarnishment cause of action under the FTDA, based on the language of the statute.[17]

The Supreme Court's opinion may prove to be of vital importance in determining the practical scope of the FTDA, unless Congress takes action to amend the language of the FTDA, which is considered likely. Owners of famous marks would prefer to stop would-be diluters before their marks lose value. Because the FTDA affords only injunctive relief unless a plaintiff can prove willful intent, requiring a mark owner to prove actual harm would seem to necessitate that the mark owner suffered an uncompensated - indeed, uncompensable - injury as well as a risk of being accused of failure to police. The dilution remedy also invokes serious evidentiary problems. A "gradual whittling away or dispersion of the identity and hold upon the public mind" of a famous mark, the classic definition of dilution originally laid out by Professor Schechter, would seem to defy proof at the inception of the process of dilution, that being the time when an injunction would be of most use.[18] On the other hand, the proponents of the actual dilution standard, who ultimately carried the day, argued that the "likelihood" approach would have improperly ***356** granted mark owners monopolistic rights in gross to words and inhibit a competitive market.

Meanwhile, dilution cases decided around the country in 2002 in advance of the V Secret opinion demonstrated that prevailing on a dilution claim was already a difficult task.

B. Inherently Distinctive Façade: New York Stock Exchange, Inc. v. New York, New York Hotel, LLC[19]

The New York Stock Exchange, Inc. (NYSE) sued the New York, New York Hotel & Casino, LLC (Casino) in Las Vegas to prevent the Casino's use of physical features and promotional materials based on modified versions of NYSE's marks.[20] Some examples of the Casino's use included a replica of the NYSE's architectural façade bearing the words "New York New York Stock Exchange," the Casino's "New York $lot Exchange" club for frequent gamblers, and the "NY$E" abbreviation displayed on some of its slot machines and used as a reference to its players club.[21] NYSE's suit included claims for trademark infringement and dilution under the Lanham Act and trademark blurring and tarnishment under New York law.[22] The U.S. District Court for the Southern District of New York granted the Casino's motion for summary judgment on all claims.[23]

On appeal, the Second Circuit found summary judgment proper on all of NYSE's Lanham Act infringement claims.[24] It agreed with the district court's conclusion that the "obvious pun" used by the Casino in NYSE's modified marks would not cause any consumer confusion.[25] The appellate court also affirmed the dismissal of all Lanham Act dilution claims except those claims related to one NYSE mark: a registered logo consisting of the NYSE building's façade bearing the words "New

York Stock Exchange."[26] The court concluded that the other NYSE marks are not inherently distinctive, whereas distinctiveness is required by the FTDA.[27] Even though the NYSE marks are famous, they are descriptive and cannot merit dilution protection because they have only acquired distinctiveness ***357** and are not inherently distinctive.[28] Because NYSE's architectural façade mark could be found inherently distinctive, the court remanded the claim involving that mark for further proceedings.[29]

Finally, the Second Circuit affirmed the dismissal of NYSE's state law blurring claim but reversed dismissal of the tarnishment claim.[30] Construing New York law, the court found that the Casino's humorous use of the modified NYSE marks disposed of the blurring claim.[31] In contrast, the court concluded that the same humorous analogy could be viewed by a trier of fact as injurious to NYSE's "reputation for integrity and transparency in the trading conducted on its floor."[32] The state tarnishment claim also was remanded to the district court.[33]

C. Failure to Establish Inherent Distinctiveness: Deere & Co. v. MTD Products, Inc.[34]

The green and yellow color combination plaintiff Deere & Co. (Deere) uses on its agricultural equipment is not inherently distinctive as a matter of law, and thus cannot qualify for protection under the FTDA.[35]

Deere has made agricultural equipment since the 1840s.[36] All the agricultural vehicles it has produced since the 1900s feature green bodies and yellow wheels.[37] Deere also owns three trademarks for agricultural equipment dressed in a green and yellow color combination.[38] Defendant MTD Products, Inc. (MTD) makes YARD-MAN agricultural equipment, including lawn and garden tractors, lawnmowers, and snow blowers.[39] Its products, too, are dressed in green and yellow. Deere filed suit alleging dilution of its green and yellow marks and trade dress, accusing MTD of choosing the same colors to capitalize on the goodwill established by Deere's famous marks and dress.[40]

***358** Citing New York Stock Exchange, Inc. v. New York, New York Hotel, LLC,[41] the district court wrote that a mark must be inherently distinctive for protection under the FTDA, although acquired distinctiveness may render a mark protectible under other federal trademark provisions.[42] The Court stated thatcolor alone cannot be inherently distinctive, citing the Supreme Court's Qualitex Co. v. Jacobson Products Co.[43] and Wal-Mart Stores, Inc. v. Samara Bros., Inc.[44] decisions.[45] Although colors that have acquired secondary meaning can be protected as trademarks, such acquired distinctiveness is inapplicable to the distinctiveness required under the FTDA.[46] "Therefore, since Deere's green and yellow color combination cannot be inherently distinctive as a matter of law, Deere's federal dilution claim must be dismissed."[47] The court also dismissed Deere's state law dilution claim, applying Illinois law and granting judgment on the pleadings to MTD on two of Deere's five claims.[48]

D. Failure to Establish Fame: Thane International, Inc. v. Trek Bicycle Corp.[49]

The question confronting the Ninth Circuit in this case was whether use of the "OrbiTrek" mark for a stationary exercise machine violated the trademark rights of the Trek Bicycle Corporation (Trek), which has used the TREK mark on its bicycles and related products since 1977.[50] Trek sells more than 1,000 products bearing the TREK mark, spends between $3 million and $5 million per year on advertising, and sponsors four-time Tour de France winner Lance Armstrong, among other activities.[51]

Thane International, Inc. (Thane) began selling the OrbiTrek stationary exercise machine in 1997 and applied to register the ORBITREK mark.[52] After Trek filed a Notice of Opposition, Thane filed a complaint seeking a declaration that it ***359** had not violated trademark laws.[53] Trek counterclaimed, alleging trademark infringement and dilution, false designation of origin, and unfair competition.[54] The U.S. District Court for the Central District of California granted Thane's motion for summary judgment.[55]

On appeal, the Ninth Circuit found that Thane's motion for summary judgment was improperly granted because Trek provided extensive survey evidence that consumers were actually confused by Thane's use of the "OrbiTrek" mark.[56] The court noted that a jury could find a likelihood of confusion and therefore trademark infringement under the Lanham Act.[57] The Ninth Circuit remanded the case to the district court for trial on Trek's trademark infringement claim.[58]

On the other hand, the Ninth Circuit found that summary judgment was properly granted to Thane on Trek's dilution claims, although for different reasons than those given by the district court.[59] First, the appellate court concluded that the issue of identity of the marks could not be decided on summary judgment; although the TREK and "OrbiTrek" marks are not identical, a reasonable fact-finder could find them nearly identical.[60] However, the court also found that TREK was not famous in any relevant market segment.[61] The court found that mobile bicycles and elliptical orbit machines do not operate in the same narrow market segment for purposes of the niche fame concept.[62] Even though Trek sold stationary bicycles for a fairly short time, the TREK mark was not famous in that market.[63] The court determined that TREK produced no evidence from which a reasonable fact-finder could conclude that the TREK mark is famous among members of the general consuming public, as opposed to bicycle enthusiasts.[64] Thus, the appellate court found ***360** that Trek's dilution claim was doomed.[65] The court remanded the case for proceedings only on the claims that turned on a likelihood of confusion.[66]

II. Strength of the Mark

A. Fame

1. For Dilution, Mark Must Change the English Language: Toro Co. v. ToroHead, Inc.[67]

The most significant case to address the quantum of proof required to show that a trademark is famous was decided shortly before the end of 2001. Toro marked the Trademark Trial and Appeal Board's (TTAB or the Board) first substantive decision involving a dilution claim in an opposition proceeding.

The Toro Co. (Toro) opposed an intent-to-use (ITU) trademark application by ToroHead, Inc. (ToroHead) to register the mark "ToroMR" and bull's head design for "very low reluctance, thin film magnetic reading and writing heads for sale to OEM manufacturers of high performance computer disk drives. . . ."[68] Toro, which owns more than two dozen registrations for the mark, TORO, for goods and services generally related to lawn care, maintenance, and landscaping, alleged that the "ToroMR" mark was likely to dilute its family of marks.[69]

The TTAB dismissed Toro's opposition.[70] The Board found no likelihood of confusion and that the ToroMR mark was not likely to dilute the TORO mark under the FTDA.[71] Although the Board found Toro's mark inherently distinctive, it also found that Toro had presented no direct evidence of consumer recognition of TORO as pointing uniquely to Toro as the source.[72] Evidence that the TORO mark has been in use since 1914 by Toro - which has 2,500 dealers in the United States alone, generates annual sales of $1.3 billion, spends $35-40 million per year on advertising, and uses its mark TORO on all its products and services - usually would help show fame in a niche market. The court determined, however, that this evidence was much less persuasive in establishing that TORO is truly famous and entitled to protection under the FTDA.[73] Toro did not produce sufficient evidence of ***361** the fame of the mark, TORO, among ToroHead's potential customers.[74] The Board determined that Toro's evidence was insufficient to show that its mark is famous for purposes of dilution even though the "fame" factor favored Toro in the less demanding likelihood of confusion analysis.[75] Additionally, the Board found insufficient evidence that ToroHead's mark would dilute Toro's marks.[76]

Perhaps the most significant facet of the Board's decision is the very high standard it sets for a mark to be entitled to protection under the FTDA. The Board explained that the level of fame and distinctiveness required for protection under the FTDA is that a mark has become the principal meaning of a word.[77] "In effect, an opposer of a famous mark is attempting to demonstrate that the English language has changed."[78] An opposer must provide evidence that "when the public encounters opposer's mark in almost any context, it associates the term, at least initially, with the mark's owner."[79] That is to say that an owner "must show a change has occurred in the public's perception of the term such that it is now primarily associated with the owner of the mark even when it is considered outside of the context of the owner's goods or services."[80]

2. Indirect Evidence of Fame: Bose Corp. v. QSC Audio Products[81]

The Federal Circuit reversed the TTAB in an opinion more generous than Toro to mark owners seeking to prove that their mark is famous, albeit in the context of likelihood of confusion and not dilution.[82]

The TTAB had dismissed an opposition by Bose Corp. (Bose) to the application of QSC Audio Products, Inc. (QSC) to register the mark, POWERWAVE, for amplifiers and power amplifiers.[83] The Board found no likelihood of confusion existed between the POWERWAVE mark and two of Bose's marks: WAVE, registered for goods that include radios, compact stereo systems, and portable compact disc players, and ACOUSTIC WAVE, registered for loudspeaker and music systems. ***362** [84] The Board also faulted Bose for failing to provide any direct survey evidence regarding the fame of its marks.[85]

On appeal to the Federal Circuit, both the court and QSC accepted for purposes of the litigation that the BOSE house mark was famous.[86] Considering such factors as sales volume, advertising, and critical acclaim the Federal Circuit also found the WAVE and ACOUSTIC WAVE marks famous independent of the BOSE mark.[87]

Direct evidence of fame, for example from widespread consumer polls, rarely appears in contests over likelihood of confusion. Instead, the cases teach that the fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark and by the length of time those indicia of commercial awareness have been evident.[88]

After evaluating other factors from the likelihood of confusion test in In re E.I. DuPont de Nemours & Co.[89] - including relatedness of the goods, similarity of the marks, and channels of trade - the Federal Circuit concluded that confusion was likely, sustained Bose's opposition, and denied QSC's registration of its POWERWAVE mark.[90]

B. Descriptive vs. Generic and the Importance of Secondary Meaning

None of the marks rose to the level of suggestiveness in the cases included in this section. While a finding of descriptiveness was a victory for the mark holder in the first case, a lack of distinctiveness limited the protection available to the plaintiffs in the second and third cases. The two latter findings probably are uncontroversial, given that the marks in question were BLISS for a beauty salon and U.S. SEARCH for an executive search service.

1. Te-Ta-Ma Truth Foundation - Family of Uri, Inc. v. World Church of the Creator[91]

The name of a religious organization was held to be descriptive rather than generic, meaning that a racist organization could not use a confusingly similar mark.

***363** The Church of the Creator (the operating name of plaintiff Te-Ta-Ma Truth Foundation - Family of Uri, Inc.), a recognized religious charity, began using the name "Church of the Creator" in 1982 and federally registered its mark while disclaiming the word "Church" in 1988.[92] The defendant, the World Church of the Creator (World Church), is an organization that depicts the "white race" as the "Creator," and is, per its slogan, "[d]edicated to the Survival, Expansion, and Advancement of the White Race."[93] The World Church was founded as the Church of the Creator, Inc., in 1973.[94] It was later reconstituted as an unincorporated association and changed its name in 1996 in an apparent attempt to avoid paying a court judgment against it for damages for orchestrating a murder.[95] The Church of the Creator (Foundation) filed suit seeking an injunction to protect its incontestable trademark rights after receiving complaints demonstrating confusion between it and the World Church.[96]

Defendant World Church argued that the Foundation's mark was generic based on dictionary definitions of the words in the mark, and the district court entered summary judgment against the Foundation.[97] The Seventh Circuit reversed, concluding that Church of the Creator was a denominational name and not the generic term for a class of monotheistic religions.[98] "Because there are so many ways to describe religious denominations, there is no risk that exclusive use of 'Church of the Creator' will appropriate a theology or exclude essential means of differentiating one set of beliefs from another."[99]

2. Bliss Salon Day Spa v. Bliss World LLC[100]

In another Seventh Circuit opinion penned by Judge Easterbrook, the court concluded that the mark BLISS used by two salons was not inherently distinctive, given that many other beauty industry businesses use BLISS as a mark for their products.

***364** Bliss Salon, which opened its single outlet in a Chicago suburb in 1979, is the senior user of the BLISS mark.[101] Bliss World adopted the mark in 1996 when it opened Bliss Spa in New York's SoHo district.[102] Bliss World registered its marks in 1997 for use in connection with spas and beauty-care products and has set out to create an international chain of beauty parlors while also selling "Blissout" and "Blisslabs" products.[103]

Bliss Salon asked the court for an injunction forbidding Bliss World from opening a beauty parlor or selling any of its products within 100 miles of Chicago's Loop.[104] The Seventh Circuit affirmed the district court's denial of Bliss Salon's motion.[105] The court rejected the plaintiff's argument that its BLISS mark was suggestive, and thus automatically entitled to trademark protection without the need to prove secondary meaning or likely confusion.[106]

Bliss marks are a glut on the market in hair styling and beauty care . . . . If Bliss Salon wants to get anywhere in this litigation, it will have to prove that its mark has acquired secondary meaning and that Bliss World's use of the same mark is likely to cause confusion about source in or near Wilmette.[107]

3. U.S. Search, LLC v. US Search.com, Inc.[108]

The Fourth Circuit affirmed a grant of summary judgment determining that U.S. SEARCH as a service mark for executive recruiting services was either generic or descriptive, notwithstanding the U.S. Patent and Trademark Office's (PTO) conclusion that a similar mark was suggestive.[109]

U.S. Search, LLC (LLC) is an executive recruiting and placement firm formed in 1998 specializing in recruitment for the plastics industry.[110] U.S. Search.com, Inc. (DotCom) is a publicly traded corporation that has provided access to online public record information over the Internet and through the use of its toll-free telephone number, 1-800-USSEARCH, since 1995.[111] In 1999, DotCom began offering a screening service to verify a prospective employee's credentials ***365** and background.[112] LLC sued for trademark infringement, and DotCom filed counterclaims and later moved for summary judgment.[113]

In dismissing LLC's claims, the district court found that U.S. SEARCH was at best descriptive in nature and that LLC was not entitled to service mark protection because it had not offered any evidence of secondary meaning.[114] The Fourth Circuit agreed that LLC "cannot show that its mark, in relation to the executive recruiting services it provides, is entitled to service mark protection."[115]

DotCom, on the other hand, produced substantial evidence that "search" is used as a synonym for executive recruiting.[116] The Fourth Circuit agreed with the district court "that the composite term, 'U.S. Search,' for executive recruiting services, operates to describe a service in a manner readily understandable to the consumer."[117]

LLC argued that the PTO's decision to allow DotCom to register 1-800-US-SEARCH as a service mark in 1998 for "computer services, namely providing databases in the field of individual telephone numbers, addresses, and social security numbers" without requiring a showing of secondary meaning was prima facie evidence that LLC's U.S. SEARCH was suggestive and not descriptive.[118] The Fourth Circuit, however, pointed out that while DotCom's mark had been registered by the PTO, LLC's mark had not.[119] The court held that the distinctiveness of a mark cannot be determined in the abstract but instead must be measured in connection with the particular goods or services on which it is used.[120] "That the PTO deemed DotCom's mark to be suggestive simply has no bearing on whether LLC's use of 'U.S. Search,' in connection with different services (executive recruiting), is suggestive as well."[121]

*366 III. "Use" of a Mark

A. If You Rebuild It, It May be a Trademark Use: Karl Storz Endoscopy-America v. Surgical Technologies, Inc.[122]

The Ninth Circuit addressed whether performing repair work and reselling another party's product constitutes use of that party's trademark in commerce.

Karl Storz Endoscopy-America (Storz) manufactures and sells rigid endoscopes (endoscopes are surgical tools that use fiber optic technology to view internal body areas).[123] Endoscopes cost thousands of dollars, and, due to their expense when they are damaged, they are repaired rather than replaced.[124] The defendant, Surgical Technologies Incorporated (STI), is one of many companies that offers repair services for surgical instruments.[125] A second defendant, Pacific Medical Repair (Pacific), acts as a "repair" broker by taking repair orders from hospitals and clinics and contracting the actual repair work out to companies like STI.[126]

Storz filed suit against STI and Pacific alleging trademark and trade dress infringement, unfair competition, and passing off.[127] In reversing the district court's grant of summary judgment for defendants on likelihood of confusion, the Ninth Circuit pointed out "that 'post-purchase confusion,' i.e. confusion on the part of someone other than the purchaser . . . can establish the required likelihood of confusion under the Lanham Act."[128] The court reasoned that even though surgeons are not the actual purchasers of the endoscopes, their opinions as users may influence hospital purchasing decisions.[129] Summary judgment was determined to be improper despite STI's argument that the hospitals who commissioned repair work knew who performed it.[130]

The court then examined whether STI actually "used" the trademark in commerce. Storz argued that while routine repairs can be made to trademarked goods without violating the Lanham Act, in many instances the scope of the work performed by STI was so great that what resulted was not a repaired product but the functional equivalent of a new sale.[131] Agreeing with Storz, the court noted "If the ***367** reconstructed product still bearing the original manufacturer's trademark is so altered as to be a different product from that of the original manufacturer, the repair transaction involves a 'use in commerce.'"[132] The court pointed to several factors a court should consider in determining whether a different product results from repair work: 1) the nature and extent of the alterations, 2) the nature of the device and how it is designed (whether some components have a shorter useful life than the whole), 3) whether a market has developed for service and spare parts, and 4) whether end users of the product are likely to be misled as to the party responsible for the composition of the product.[133]

B. "Analogous Use" is Important, but a Book Title is Still Not a Mark: Herbko International, Inc. v. Kappa Books, Inc.[134]

The Court of Appeals for the Federal Circuit addressed the "analogous use" doctrine and also reiterated its prior holdings that the title of a single book can never be source-identifying.

Herbko International, Inc. (Herbko) makes and sells the Crossword Companion Roll-A-Puzzle System, a handheld device with scrollable rolls of crossword puzzles.[135] Herbko obtained a registration for CROSSWORD COMPANION and claimed first use in 1994.[136] Kappa Books, Inc. (Kappa) publishes a series of crossword puzzle books under the name "Crossword Companion," and first used that name in 1993 and then again in 1995 for a crossword book.[137] Kappa sought cancellation of Herbko's registration, claiming priority of use and likelihood of confusion.[138] The TTAB granted summary judgment to Kappa on the grounds that Kappa's 1993 use was an analogous use that was perfected through the publication of the second book in 1995, but the Federal Circuit reversed.[139]

The Federal Circuit found that the TTAB only applied one of the two requirements for establishing analogous use: it required Kappa to show timeliness in its second use of the mark in 1995, but it did not require a showing that Kappa used ***368** the mark in a manner reasonably expected to create an association between the mark and its goods:[140]

[T]he publication of a single book cannot create, as a matter of law, an association between the book's title (the alleged mark) and the source of the book (the publisher) . . . [it was necessary for Kappa to show] evidence of a second volume before Herbko's 1994 ITU application . . . . Because sales of a single book title are insufficient to create proprietary rights and because Kappa provided no other evidence of association creating activities (e.g. use of mark as trade name), the Board erred in holding Kappa established priority to the mark.[141]

The Federal Circuit reaffirmed its precedent that a single book title identifies the book but not the source[142] and determined that copyright law would be unduly intruded upon by trademark law if trademark rights were granted to a single book title.[143] Despite finding a likelihood of confusion based on the DuPont factors, the Federal Circuit reversed summary judgment because of a lack of priority in the contested mark.[144]

IV. Likelihood of Confusion

A. Intent-to-Use Applications: Hewlett-Packard Co. v. Packard Press, Inc.[145]

The Court of Appeals for the Federal Circuit reversed the TTAB's dismissal of Hewlett-Packard's (HP) opposition to Packard Press's (Packard) registration of the mark PACKARD TECHNOLOGIES for data and digital information and data transfer.[146] The TTAB found no likelihood of confusion between the marks because it determined the goods and services were not sufficiently related.[147] The Board dismissed HP's opposition because HP failed to establish that the goods and services involved were related in the mind of the consuming public as to their source or origin.[148] Even though HP did not present evidence of relatedness of goods and services beyond the descriptions in the application and registrations, the ***369** Federal Circuit held that the Board failed to properly consider the description of goods in HP's registrations and Packard's application.[149]

Noting that there is a duty to evaluate each of the DuPont factors for which there is evidence, the Federal Circuit ruled that the TTAB erred when it refused to consider the information in Packard's ITU application and HP's registrations.[150] The appeals court stated that requiring HP to produce more evidence than what was in the ITU application could be seen as requiring a showing of actual confusion rather than likelihood of confusion.[151] Because Packard's application covered "data and information processing" and "conversion" and HP's registrations covered "information manipulation," the appeals court held that consumers would find the goods and services of both parties related to one another and, therefore, confusion likely as a matter of law.[152]

B. Initial Interest Confusion

1. Promatek Industries v. Equitrac Corp.[153]

Equitrac, a seller of cost-recovery equipment, appealed the granting of a preliminary injunction in favor of Promatek, a competitor in the cost-recovery industry.[154] Promatek owns the mark COPITRAK, and Equitrac placed the term "Copitrak" in metatags for its website because it provides maintenance and service on Copitrak equipment.[155] The district court granted Promatek a preliminary injunction requiring Equitrac to add to its website: (1) a phrase indicating that there is no connection between Equitrac and the term Copitrak and that Copitrak is a trademark of Promatek; and (2) a hyperlink to Promatek's website.[156] Equitrac argued on appeal that the language would not simply inform people of its competitor, Promatek, but it would actually encourage people to visit Promatek's website.[157] The court of appeals affirmed the granting of the preliminary injunction, agreeing with the district court that Promatek would suffer a greater harm without the language than Equitrac would suffer with it.[158]

***370** In reviewing whether Promatek's likelihood of success on the merits was sufficient to warrant a preliminary injunction, the Seventh Circuit found that the marks were very similar, the two parties were in direct competition, and the degree of care exercised by consumers could lead to initial interest confusion.[159] Initial interest confusion "occurs when a customer is lured to a product by the similarity of the mark, even if the customer realizes the true source of the goods before the sale is consummated."[160] "What is important is not the duration of the confusion, it is the misappropriation of Promatek's good will. Equitrac cannot unring the bell."[161] If the mark were allowed to remain in the metatags for Equitrac's website, Equitrac would be misappropriating Promatek's goodwill.[162] Consumers searching for Promatek goods and services on the Internet would arrive at Equitrac's website and likely spend some time there becoming more familiar with Equitrac and its products.[163] In determining whether the district court properly balanced the hardship of the injunction, the appellate court noted that Equitrac did not provide any evidence that it had actually lost any customers as a result of the language posted on the website.[164]

2. Interstellar Starship Services v. Epix Inc.[165]

Epix, an electronic-imaging hardware and software manufacturer, demanded that Network Solutions Inc. cancel the domain name registration for Epix.com, owned by Interstellar Starship Services (ISS).[166] ISS, whose website was mainly used to promote a local theater, responded by seeking a declaratory judgment that it was not infringing Epix's mark.[167] The district court ruled that the present ISS website did not infringe the Epix trademark, but past uses, which touted the technical and computer knowledge of the ISS president, did.[168] The district court enjoined ISS from such infringing uses and ordered that a disclaimer be placed on the website.[169]

***371** Epix appealed the district court's refusal to transfer the domain name and its decision that ISS's use of the domain name did not result in initial interest confusion.[170] In determining both likelihood of and initial interest confusion, the Ninth Circuit utilized the eight-factor test developed in AMF Inc. v. Sleekcraft Boats.[171] The court stated that in Internet cases, while all factors should be considered, the three most important factors are similarity of the marks, relatedness of goods and services, and simultaneous use of the Internet as a marketing channel.[172] Given the non-dispositive result of examining these three factors in this case, the court of appeals ruled it was proper for the district court to apply the other Sleekcraft factors and that in doing so it did not err in concluding they weighed against a finding of likelihood of confusion.[173] Rejecting Epix's argument that use of Epix.com creates initial interest confusion as a matter of law, the court of appeals pointed out that despite the fact that web users often assume that the domain name of a particular company will be the company's name followed by ".com", that incorrect guess does not generally amount to a likelihood of initial interest confusion.[174] "[A]ctionable initial interest confusion on the Internet is determined, in large part, by the relatedness of the goods offered and the level of care exercised by the consumer."[175] The appellate court concluded that the parties, a theater group presenting the Rocky Horror Picture Show and a digital imaging company, are so different that any consumer searching for the Epix site but arriving at the ISS website would know almost immediately that she was in the wrong place and resort to a search engine or attempt a second guess at the Epix domain name.[176] The court contrasted this situation with one where a consumer arrives at another location that deals in similar goods and decides to make a purchase from that site due to the initial interest confusion rather than continuing to look for the originally targeted website.[177] The court of appeals affirmed the district court's finding of no initial interest confusion.[178]

***372 C. Parody/Noncommercial Use: Mattel Inc. v. MCA Records Inc.[179]**

The Ninth Circuit ruled that the parodic use of a trademark in a song falls within the noncommercial use exemption of the FTDA[180]and hence is not actionable.[181] Mattel, the manufacturer of the internationally famous Barbie doll, filed suit against MCA Records, the recording label for the Danish band "Aqua," for its use of the Barbie mark in the song "Barbie Girl," alleging trademark infringement and dilution.[182]

The court noted that the "Barbie Girl" song mocks the doll, characterizes her as a "bimbo," and depicts Barbie as having a loose moral character.[183] The facts distinguished the case from Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.[184] The court noted in Dr. Seuss that the defendant in that case used the Dr. Seuss trademarks simply to get attention rather than to mock the Dr. Seuss books and therefore could not claim First Amendment protection as MCA Records did.[185] The Ninth Circuit applied the Second Circuit's decision in Rogers v. Grimaldi,[186] stating "literary titles do not violate the Lanham Act 'unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work."'[187]

Applying Rogers, the Ninth Circuit found the title "Barbie Girl" relevant to the underlying song because the song is about Barbie and the values the artists believe she stands for.[188] The court found that the title did not explicitly or otherwise suggest that it was produced by Mattel.[189]

Regarding the dilution claim, the court found the song did dilute Mattel's trademark, but that an issue remained as to whether or not a statutory exemption applied.[190] Because the FTDA applies to "commercial use in commerce" but at the ***373** same time exempts "noncommercial use," one could believe that the statutory exemption was illusory since any dilutive act must be commercial.[191] The court reasoned that this would also force the statute to face off against the First Amendment without the burden of showing a likelihood of confusion.[192] Reviewing legislative history, the Ninth Circuit determined that Congress meant the "noncommercial use" exemption to embody the doctrine of non-commercial speech as developed through existing case law.[193] With this interpretation, speech is commercial when it "does no more than propose a commercial transaction,"[194] but speech that does more is entitled full First Amendment protection.[195] The court acknowledged that "Barbie" was used to sell copies of the song, but because the song also lampooned and socially criticized the doll and its public perception, the song did more than simply propose a commercial transaction but also "inextricably entwined . . . expressive elements" and therefore was determined to be within the exemption to the FTDA.[196]

The Ninth Circuit also affirmed the grant of summary judgment against Mattel on its claim of unfair competition under the Paris Convention for the Protection of Industrial Property.[197] The court reasoned that because the Convention does not grant substantive rights but merely ensures "national treatment," foreign nationals are given the same treatment in a member country as that country makes available to its own citizens.[198] Treating Mattel like a foreign national, the court maintained that although Mattel is free to bring a state unfair competition claim, it can not assert a nonexistent federal unfair competition claim.[199]

D. Nominal Use

1. Truth in Advertising: Playboy Enterprises, Inc. v. Welles[200]

Playboy appealed the district court's grant of summary judgment to its former Playmate, Welles.[201] Welles was Playboy's

“Playmate of the Year” in 1981, and ***374** she used that and other Playboy trademarked terms on her website.[202] Playboy complained of Welles’s use of the marks “Playboy” and “Playmate” in the metatags of the website, use of the mark “Playmate of the Year 1981” on the masthead of the website, and use of marks in various banner ads throughout the website.[203] The district court granted Welles’s motion for summary judgment, and on appeal the court affirmed in part and reversed in part.[204]

The appeals court determined that the term “Playmate of the Year 1981” did not imply any current sponsorship and its use was merely nominative.[205] Relying on New Kids on the Block v. News America Publishing, Inc.,[206] the appellate court used a three-prong test to determine whether the use was permissible nominative use: (1) the product or service must be one not readily identifiable without use of the trademark; (2) the trademark may be used only to the extent reasonably necessary to identify the product; and (3) the user must not use the mark in a way that would suggest sponsorship or endorsement by the trademark holder.[207] The Ninth Circuit pointed out that the New Kids test is the proper test in a nominative use case and the circuit’s traditional likelihood of confusion test, created in Sleekcraft, should not be applied.[208] Because the Sleekcraft test focuses on the similarity of marks, its use would lead to the incorrect conclusion that virtually all nominative uses are confusing.[209]

The appeals court agreed with the district court that the use of Playboy’s trademarks in the headlines and banner advertisements was a nominative fair use because there was no other way for Welles to adequately or effectively describe herself and her website’s services.[210] The court also agreed that Welles only used as much of the trademark as was reasonably necessary because she used only the words “Playmate of the Year” and not the font or symbols associated with Playboy.[211] The temporal aspect of the trademark use, “Playmate of the Year in 1981,” served to limit any suggestion that there was a current affiliation or sponsorship ***375** with Playboy.[212] Additionally, Welles affirmatively disclaimed any sponsorship and described the legal dispute she was engaged in with Playboy regarding use of the marks.[213]

Welles’s use of the Playboy trademarks in metatags was also determined to be nominative because Welles could not describe her site in a way that would render the metatag useful without using the trademarked terms. If people searching the internet could not use trademarks in their search but were forced to guess the phrases to substitute for them, internet use would be seriously limited.[214] Furthermore, the Welles site did not repeat the terms extensively.[215]

The court of appeals reached a different conclusion with respect to the wallpaper on the site. The wallpaper contained the term “PMOY ‘81” throughout the website, but it did not contain Welles’ name before or after it.[216] The court held that the repeated and stylized use of the mark was not needed to describe Welles, nor did it truly attempt to do so because her name was not connected with the phrase in the wallpaper.[217] The court of appeals remanded the issue of trademark infringement based on the use of the PMOY abbreviation on the wallpaper.[218]

The court of appeals also affirmed the district court’s grant of summary judgment for Welles on the dilution claim by holding that nominative use by definition does not dilute trademarks.[219] The court of appeals reasoned that the same logic that excepts comparative advertising from dilution excepts nominative use: it does not create an improper association in consumers’ minds between a new product and the trademark holder’s mark.[220] “Uses that do not create an improper association between a mark and a new product but merely identify the trademark holder’s products should be excepted from the reach of the anti-dilution statute.”[221] Welles does not dilute the trademark “Playmate of the Year” by truthfully identifying herself as a past recipient of that moniker.[222] “It is in the nature of honors and awards to be identified with the people who receive them . . . . [T]he conferrer . . . ***376** is free to limit the honoree’s use of the title or references to the award by contract. So long as a use is nominative, however, trademark law is unavailing.”[223]

2. Ty Inc. v. Perryman[224]

Ty, the manufacturer of BEANIE BABIES toys, brought an infringement and dilution suit against Ruth Perryman, an aftermarket seller of second-hand beanbag stuffed animals specializing in BEANIE BABIES and using the domain name “bargainbeanies.com.”[225] The district court granted summary judgment in favor of Ty.[226] Perryman appealed on the grounds that the term “beanies” is generic for beanbag stuffed animals and that the injunction issued was overbroad.[227]

On appeal, the Seventh Circuit disagreed with Ty’s claims of dilution not only because of the very nature of secondary markets in trademarked goods but also because Perryman was selling genuine BEANIE BABIES products.[228] Perryman could no more sell her products without using the BEANIE BABIES trademark than a used car dealer could sell Toyota cars without using the auto maker’s mark.[229] The court conceded that there is free-riding involved in an aftermarket that sells trademarked goods, but it is so attenuated that it is almost inherent in all business.[230] The court was particularly unmoved by claims of free-riding because Ty took affirmative steps to create the secondary market which Perryman occupied.[231] "We do not think that by virtue of trademark law producers own their aftermarkets and can impede sellers in the aftermarket from marketing the trademarked product."[232] Despite not finding any basis for a dilution claim, the court did find that Perryman's website created confusion as to the source of non-Ty products by using the caption "Other Beanies" to refer to non-Ty products.[233] The appellate court reversed the grant of summary judgment and directed the district court to shape a limited injunction.[234]

***377 E. Reverse Confusion**

1. Same Mark Plus Same Services Equals Summary Judgment for Defendant: Cohn v. Petsmart Inc.[235]

In this somewhat surprising case, the Ninth Circuit affirmed summary judgment for defendant despite significant similarity of marks and at least an apparent overlap in services.

Cohn, a veterinarian in Boise, Idaho, began using the slogan "Where Pets are Family" to describe his services in 1993.[236] Petsmart, a national pet supply store chain, began using the same slogan in 1994.[237] Petsmart obtained a federal registration for the phrase in 1996, and Cohn obtained a state registration in 1997.[238] Once Petsmart began leasing space inside its Boise store for veterinary services and advertising those services, Cohn brought suit claiming reverse confusion.[239] The case was filed in Idaho state court, but the case was removed to federal court where the district court granted summary judgment to Petsmart.[240] The appellate court determined that removal was proper and affirmed the summary judgment.[241] Using federal trademark law as guidance, the court of appeals applied the Sleekcraft factors to the case and found two of them to favor Cohn: the relatedness of the goods and services and the ability of the junior mark to overtake the senior mark.[242] The court noted that Petsmart spends millions of dollars advertising the disputed phrase through television, print, and Internet advertising while Cohn advertised on a local and limited scale.[243]

The other Sleekcraft factors, however, weighed against a finding of confusion.[244] For instance, in examining the similarity of the marks the court noted that although both used the phrase "Where Pets are Family" each mark prefaced the phrase with its business name ("Petsmart - Where Pets are Family" and "Critter Clinic - Where Pets are Family").[245] Given the stress on the business name and the phrase's function as a tagline, the Ninth Circuit agreed with the district court ***378** that this factor did not support Cohn's claim.[246] Also undercutting the plaintiff's claim was that there was no evidence of actual confusion.[247] While the court noted that evidence of actual confusion is generally not noteworthy, it reasoned that here, where the two parties used the same mark in the same city for a period of six years, some evidence of actual confusion should have become available.[248] The court also concluded that pet owners are attentive enough in selecting veterinary care for their family pets that confusion was not likely.[249] The court therefore reasoned that the evidence did not raise a triable issue on likelihood of confusion despite the fact that both parties used the same mark for similar goods and services.[250]

2. Specialized Diagnostic Equipment vs. Mass-Market Thermometers: Therma-Scan, Inc. v. Thermoscan, Inc.[251]

In this Lanham Act infringement action, the Sixth Circuit held that defendant's mark THERMOSCAN did not infringe the mark THERMA-SCAN.

Plaintiff Therma-Scan, Inc. (TSI) registered the mark THERMA-SCAN in November 1988.[252] TSI performs infrared thermal-imaging examinations of the human body and prepares diagnostic reports that are provided to its clients or their physicians.[253] Most of TSI's clients are residents of the greater Detroit area.[254] Defendant Thermoscan, Inc. (Thermoscan), which began operations in Georgia in March 1989, manufactures electronic ear thermometers.[255] Thermoscan sold 3.2 million thermometers between January 1, 1997 and July 31, 2000.[256] It had sales of more than $147 million in 1996 along with advertising and promotional expenses in excess of $20 million.[257] The defendant registered the mark ***379** THERMOSCAN in September 1991.[258] TSI sued for trademark infringement and unfair competition.[259]

Applying the circuit's standard eight-factor likelihood of confusion test as stated in Daddy's Junky Music Stores, Inc. v. Big Daddy's Family Music Center,[260] the Sixth Circuit determined that the district court did not err in finding no likelihood of confusion.[261] The court focused on the relatedness of goods and services and the marketing channels used and found that they tipped the scales in favor of finding no likelihood of confusion.[262] The Sixth Circuit determined that the parties' goods and services utilize similar technology in very different ways, are marketed to different populations, and the parties do not compete in the marketplace.[263] Additionally, the Sixth Circuit concluded that the district court correctly found that the two parties' use of the Internet as a marketing channel was entitled to little weight.[264] Furthermore, Thermoscan sells 80 percent of its thermometers directly to consumers and 20 percent to physicians and hospitals, while TSI depends on referrals from physicians for the vast majority of its business.[265] Because the parties have predominantly different customers and no common marketing approach, the Sixth Circuit agreed the district court correctly found confusion to be unlikely.[266]

V. Trade Dress and Functionality

Federal courts continue to struggle with the doctrine of functionality in trade dress cases as they attempt to apply the Supreme Court's test from TrafFix Devices, Inc. v. Marketing Displays, Inc.[267] Decisions handed down in 2002 included the following - three of which involve a claim for trademark or trade dress infringement that floundered on the issue of functionality.

*380 A. Eppendorf-Netheler-Hinz GMBH v. Ritter GMBH[268]

The Fifth Circuit reversed summary judgment for the plaintiff asserting trade dress infringement, holding that it "failed to carry its burden" under 15 U.S.C. § 1125(a)(3)[269] to prove that features of its disposable pipette tips were non-functional and thus deserving of trade dress protection.[270]

Plaintiff-appellee Eppendorf-Netheler-Hinz GmbH (Eppendorf) makes a line of disposable pipette tips sold in the United States under the marks COMBITIPS, EPPENDORF, and EPPENDORF COMBITIPS.[271] All eight sizes of Combitips are designed to fit into Eppendorf's "Combitip Dispenser Syringe."[272] Defendants-appellants Ritter GmbH (Ritter) and its American distributor, RK Manufacturing, Inc. (RK), began selling virtually identical pipettes marked RITIPS in the United States in 1994.[273] The Ritips also were compatible with Eppendorf's Combitip Dispenser Syringe and were marketed as a "direct replacement" for Combitips.[274] Eppendorf sued for trademark and trade dress infringement in 1998.[275]

The jury returned a verdict for Eppendorf, finding that Ritter and RK willfully infringed Eppendorf's trade dress rights and awarded Eppendorf $750,000 in lost profits and $250,000 in lost licensing fees.[276] The district court entered final judgment for $1 million in damages awarded by the jury and then further enhanced the damages by $750,000 based on the finding of willfulness.[277]

Ritter and RK appealed, claiming that Eppendorf failed to carry its burden of proving that the eight elements of the Combitip trade dress it claimed were infringed were non-functional.[278] The Fifth Circuit agreed with Ritter's argument.[279] The court explained that functional product features may be copied freely ***381** by competitors and that "trade dress protection extends only to incidental, arbitrary or ornamental product features which identify the source of the product."[280]

Applying the Supreme Court's decision in TrafFix - decided ten months after the Eppendorf trial - the Fifth Circuit turned to the primary test for determining whether a product feature is functional: "whether the feature is essential to the use or purpose of the product or whether it affects the cost or quality of the product."[281] The court found the availability of alternative pipette tip designs irrelevant, given that each of the eight design elements at issue in Eppendorf's suit was essential to the use or purpose of the Combitips.[282] The Fifth Circuit rendered judgment for the defendants.[283]

B. Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters, Inc.[284]

Abercrombie & Fitch Stores, Inc. (A&F) sued competing casual clothing retailer American Eagle Outfitters, Inc. (AE) for alleged violations of the unregistered A&F trade dress in the design in certain articles of its clothing, in-store advertising displays, and a catalog, the A&F Quarterly.[285] The U.S. District Court for the Southern District of Ohio dismissed all of A&F's claims on summary judgment.[286] On appeal, the Sixth Circuit affirmed on different reasoning in a lengthy opinion, holding that the alleged trade dress (including the A&F clothing designs, in-store advertising displays, and use of college students as sales associates) was legally functional and non-protectible.[287] The catalog constituted distinctive trade dress; however, the AE catalog was not confusingly similar as a matter of law, the court concluded.[288]

The Sixth Circuit found that the district court erred in treating A&F's suit as an attempt to protect a "marketing theme."[289] The court found the three elements Abercrombie sought to protect constituted distinctive trade dress and were not generic.[290] Under the doctrine of aesthetic functionality, the court decided that allowing ***382** A&F to protect its clothing designs and in-store advertising displays would be impermissible because competitors would be put at a significant non-reputational disadvantage.[291]

Regarding the catalog, the court pointed to A&F's unique use of cougar vellum paper, grainy photographs, "clothesline" or "cutout" clothing depictions, color bars, and editorial content.[292] Although the American catalog used some of the same features, the Sixth Circuit concluded that its trade dress "is, as a matter of law, not similar to the A&F Quarterly in terms of the overall visual impression the two catalogs create."[293] The court found many significant dissimilarities in style, layout, and content as well as in the parties' use of their own respective trademarks on nearly every page.[294] In particular, the court concluded that A&F makes extensive use of photographs depicting college-aged people in often erotic or homoerotic poses, while American's catalog presented a wholesome image, with people of various ages in non-suggestive, often family-oriented situations.[295] "There is so little danger of a consumer picking up the two catalogs and not quickly realizing that they emanate from different sources that judgment as a matter of law for American Eagle is appropriate," the court concluded.[296]

C. Gray v. Meijer, Inc.[297]

In another trade dress case decided by the Sixth Circuit, the court again affirmed a grant of summary judgment by dismissing a claim of trade dress infringement, this time issued by the U.S. District Court for the Western District of Michigan.[298]

Plaintiffs, the Gray family and their businesses (collectively, Gray), sold a "Chicago Style" mix of three different types of popcorn: butter, caramel, and cheese.[299] The main elements of the Gray packaging were both the brand name "The Popcorn Shoppe" and descriptor "Chicago Style Mix" located on the top of the bag, a depiction of the Chicago skyline in the middle of the bag, and the use of ***383** red and yellow colors on the bag's top and bottom.[300] Meijer, a Midwest retailer, briefly sold Gray's popcorn along with its own private-label Chicago Style mix.[301]

The district court found no genuine issue of material fact as to the likelihood of consumer confusion between the parties' products.[302] Applying an eight-factor test, the appellate court turned first to the strength of the Gray mark and found that Gray's packaging was not unique and had no significant branding investment to create a secondary meaning.[303] Among its consideration of other factors, the court held that the parties' packaging was dissimilar and that Meijer's design and prominent use of its mark would prompt the conclusion that the product is a private-label snack.[304] Finally, the court examined Meijer's intent.[305] Even if Meijer copied elements of Gray's packaging, the court found those elements were not unique and therefore were unworthy of protection unless infused with some secondary meaning, which they were not.[306] The Sixth Circuit agreed with the district court that Gray did not raise a material issue of fact as to likelihood of confusion.[307]

D. Tie Tech, Inc. v. Kinedyne Corp.[308]

The Ninth Circuit found that the design for a cutting device was wholly functional and therefore lacking in trademark significance. The court affirmed a grant of summary judgment by the U.S. District Court for the Western District of Washington in favor of a defendant accused of infringing a product configuration mark.[309]

Plaintiff Tie Tech, Inc. ("Tie Tech"), which sells wheelchair securement systems, makes the SAFECUT web-cutter, a hand-held webbing cutter used in emergencies to quickly release individuals from their wheelchair securement systems.[310] In 1998, the PTO registered the device as a trademark with the exception of the scalloped finger indentations on the SAFECUT's handle, which the examiner ***384** deemed functional.[311] Defendant Kinedyne Corp. ("Kinedyne") later began producing a web-cutter that the Ninth Circuit found virtually indistinguishable from Tie Tech's product.[312] The only differences between the two were their color, the Kinedyne name embossed in the polycarbonate frame of its cutter, and - most noticeably - the absence of the scalloped finger indentations in the Kinedyne handle.[313]

On appeal, Tie Tech argued that its registration alone should have been sufficient to create a material issue of fact and defeat summary judgment on the issue of functionality.[314] The Ninth Circuit disagreed, explaining that while the registration discharges the plaintiff's original burden to prove validity in an infringement action, it remains subject to rebuttal.[315] Here, the presumption of validity was overcome by the defendant's evidence of functionality.[316] Adopting Tie Tech's approach would "inflate[] the evidentiary value of a trademark registration," the Ninth Circuit wrote, and mean that a defendant in a trademark infringement action could never prevail at summary judgment on an invalidity defense.[317]

E. Health Insurance Association of America v. Goddard Claussen Porter Novelli, et al.[318]

The U.S. District Court for the District of Columbia denied the request for a temporary restraining order and preliminary injunction sought by the plaintiff, Health Insurance Association of America ("HIAA"). HIAA sought to stop one of the defendants from airing television commercials that it believed infringed the trade dress of its series of political advertisements.[319]

HIAA, a health insurance and managed care lobbying organization, hired public relations company Goddard Claussen Porter Novelli (Goddard) to create the "Harry and Louise" advertisements that ran in opposition to then-President Clinton's proposed health care initiatives in 1993 and 1994.[320] HIAA again retained Goddard in 2000 to create Harry and Louise ads in connection with HIAA's "InsureUSA" ***385** initiative, which was aimed at increasing health insurance coverage among uninsured Americans.[321]

In April 2002, Goddard informed HIAA that it had created very similar advertisements, using the same actors and also referred to as "Harry and Louise" ads, for defendant CuresNow, an organization which advocates therapeutic cloning.[322] Shortly thereafter, HIAA registered copyrights for its Harry and Louise advertisements and their formats as "works made for hire."[323] HIAA also claimed to own the trade dress in the format of the Harry and Louise advertisements.[324] Defendant Goddard argued that HIAA owned neither the copyrights in the advertisements nor any trade dress rights in their format.[325]

The features that HIAA argued make up the Harry and Louise trade dress include the actors used, the roles they play, the setting of the advertisements, the discussion and tone regarding a serious political issue, and the display of contact information at the end.[326] "In effect, HIAA argues that its purported trade dress in the advertisements produced for CuresNow identifies HIAA to the public as the source of the message being presented in the advertisement, regardless of the content of the message itself."[327]

The court found that HIAA had not presented evidence to support its claim that the alleged trade dress of the advertisements was protectible under the Lanham Act.[328] The court concluded that HIAA failed to either establish that the trade dress was inherently distinctive or that it had acquired secondary meaning.[329] Although public advocacy organizations can be entitled to protection from trademark infringement under the Lanham Act, CuresNow did not use HIAA's name but merely the same advertising format.[330] Furthermore, because there was a substantial dispute regarding ownership of the copyrights of the Harry and Louise ads, the court could not conclude that HIAA had established that it was likely to prevail on its copyright infringement claim.[331]

*386 VI. Cybersquatting and Other Internet Issues

Although the number of reported cases involving the Anticybersquatting Consumer Protection Act (ACPA)[332] appears to be on the decline, courts continue to resolve important issues created by the Act.

A. Who is Liable for ACPA Violations: Bird v. Parsons[333]

The Sixth Circuit thwarted an attempt to apply trademark law to a domain name registrar and an auction company. Darrell Bird (Bird) sued Dotster, Inc. (Dotster) (a domain name registrar), Afternic.com, Inc. (Afternic) (a domain name auction company), and others based on cybersquatting, trademark infringement and dilution, and unfair competition.[334] Bird obtained a United States trademark registration for the mark FINANCIA in 1984 for computer software. Marshall Parsons (Parsons) registered the domain name "efinancia.com" with Dotster in 2000 and then immediately listed the "efinancia.com" domain name on the Afternic website, which provides auction services for the purchase, sale and exchange of domain names.[335]

The U.S. District Court for the Southern District of Ohio determined that Bird failed to state a claim against Dotster and Afternic and, therefore, granted the companies' motion to dismiss.[336] On appeal, the Sixth Circuit affirmed after determining that neither Dotster nor Afternic "used" a registered trademark in connection with the sale, distribution, or advertising of goods and services within the meaning of 15 U.S.C. §§ 1114(1)(a)[337] and 1125(a)(1).[338] In analyzing the infringement claim, the Sixth Circuit took note of two cases from the Central District of California, Academy of Motion Picture Arts & Sciences v. Network Solutions, Inc.[339] and Lockheed Martin Corp. v. Network Solutions, Inc.[340] The Bird court agreed by finding that

Network Solutions "used" domain names in a purely nominative sense by simply designating a set of computers on the Internet.[341] "A registrar that grants ***387** a particular domain name to a registrant simply grants it an address."[342] Similarly, the court reasoned that "the possibility that [an auction site's] customers might buy or sell infringing domain names does not alter the fact that [it] does not use those names."[343]

The court also ruled that Bird failed to state a claim under the FTDA because neither company made "commercial use" of a mark within the meaning of 15 U.S.C. § 1125(c).[344] Again relying on Lockheed, the court concluded that registering and selling domain names does not constitute commercial use under the dilution statute because the registrar does not trade on the value of domain names but rather on their technical function as a designation of computers on the internet.[345] The court recognized that the domain name auctioneer could profit from the trademark value of a domain name and, hence, fall under the concept of commercial use in the dilution statute, but Bird's complaint did not contain any allegations that would support that theory.[346]

Lastly, the court held that Bird failed to state a claim against the two companies under the ACPA.[347] The court agreed with the defendants that Bird's complaint failed to state the requisite bad faith intent to profit by registering the domain name.[348] Indeed such a showing was impossible against Dotster and Afternic because Parsons had registered the site.[349] The court pointed out that there was no allegation that its use came from a licensee and that liability for use under the ACPA can only attach to a registrant or its licensee.[350] In examining whether Dotster or Afternic "trafficked" in domain names, the court also pointed out, that while Afternic's auction site may be used for trafficking purposes, it is not necessarily liable for trafficking.[351] As to Dotster, the court determined that its fees did not stem from a transaction involving the transfer of domain names but from its registering and web hosting services.[352]

***388 B. In Rem Jurisdiction Determined at Time of Filing: Porsche Cars North America, Inc. v. Porsche.net[353]**

Porsche Cars North America, Inc. (Porsche) brought an in rem ACPA action in the U.S. District Court for the Eastern District of Virginia against 128 domain names containing some variant of Porsche trademarks.[354] Porsche also brought a dilution claim based on in rem jurisdiction under 28 U.S.C. § 1655,[355] which authorizes in rem jurisdiction to enforce or remove a lien or encumbrance on property.[356]

Two of the domain names at issue were registered to a British citizen, Christian Holmgreen (Holmgreen).[357] The district court granted Holmgreen's motion to dismiss the dilution claim on the ground that dilution was not contemplated by 28 U.S.C. § 1655.[358] Three days before trial, Holmgreen, who had previously contested personal jurisdiction, notified the district court that he would accept personal jurisdiction in the Southern District of California and then moved to dismiss the ACPA action on the grounds that the district court no longer had jurisdiction.[359] Although frustrated with Holmgreen's procedural jockeying, the district court concluded that, as long as personal jurisdiction was available, Porsche could not proceed in rem.[360] Porsche appealed both rulings.[361]

The Fourth Circuit could find no language in the statute supporting the contention that in rem jurisdiction must continue throughout the proceedings, nor did it find support in any ACPA-based case law.[362] Comparing in rem jurisdiction to diversity jurisdiction, the court noted that diversity is measured at the time of commencement of action.[363] The court also noted that personal jurisdiction, which is more analogous to in rem jurisdiction than subject matter jurisdiction, is waived absent a timely objection.[364] The court reasoned that "if a party may waive its objections to a form of jurisdiction, it follows that the conditions that create that jurisdiction ***389** cannot be necessary in every case to a court's power to hear the case, or required to exist throughout the life of the case."[365] The court also drew comparisons from other in rem proceedings such as forfeiture cases, where jurisdiction remains even after the res is removed from the jurisdiction.[366] The court also found support in the language of the ACPA. The statute's statement that the "owner of a mark" may "file" an in rem action if "the court finds that the owner . . . is not able to obtain in personam jurisdiction" indicated to the court a temporal aspect of when in rem jurisdiction is needed: at the time of filing.[367] The court pointed out that the diversity statute, which the court already concluded argued against the required persistence of in rem jurisdiction, has no temporal aspect.[368] Policy interests also argued against Holmgreen's position because a defendant could hijack a case across country on the eve of trial as Holmgreen attempted to do.[369] The court ruled that it is not necessary for in rem jurisdiction to persist throughout the lifetime of a case and that Holmgreen delayed too long (waiting nine months and then raising the issue three days prior to trial) in challenging in rem jurisdiction.[370]

The Fourth Circuit also rejected Holmgreen's arguments that the ACPA violated due process. The court determined that while cases like Shaffer v. Heitner[371] make it clear that the mere presence of property in a jurisdiction may be insufficient to establish jurisdiction for matters unrelated to the property, it is well settled that the presence of property in a jurisdiction is sufficient for cases where the property itself is the source of the underlying controversy.[372] Furthermore, because the ACPA treats domain names as property, the court was not persuaded by Holmgreen's contention that the domain names were addresses rather than property.[373]

The court affirmed the district court's dismissal of Porsche's dilution claims because they were filed under 28 U.S.C. § 1655, which provides in rem jurisdiction to enforce or remove any lien or encumbrance on property.[374] The court reasoned that no dilution remedy entitles a plaintiff to possess diluting material, a claim for dilution can not be characterized as a lien or encumbrance on property, jurisdiction ***390** can not be based upon 28 U.S.C. § 1655, and, therefore, the district court properly dismissed the claim.[375]

C. In Rem Jurisdiction Can Support Other Lanham Act Claims: Harrods Ltd. v. Sixty Internet Domain Names[376]

The Fourth Circuit, in a case of first impression, held that the in rem jurisdiction provided by the ACPA is not only limited to claims under the ACPA but also may provide jurisdiction for a claim that a domain name infringes or dilutes a mark.[377]

Harrods Limited (Harrods), the owner of the department store in Knightsbridge, London, brought suit in the Eastern District of Virginia against sixty domain names by relying upon the ACPA's in rem provision.[378] The domain names were registered by Harrods (Buenos Aires) Limited (Harrods BA), a former Harrods affiliate which severed all legal ties to the London store in 1963.[379] Harrods BA registered the domain names around the same time that Harrods was launching its website and making announcements in the press.[380]

The district court granted summary judgement to Harrods BA for six domain names; the .com, .net, and .org registrations for "harrodsargentina" and "harrodsbuenosaires."[381] After a bench trial, the district court not only found bad faith intent regarding the other fifty-four names and ordered their transfer to Harrods but also dismissed the infringement and dilution claims.[382] On appeal to the Fourth Circuit, Harrods BA contended that in rem jurisdiction was improper and that the burden of proof required under the ACPA is clear and convincing evidence rather than preponderance of evidence.[383]

The Fourth Circuit concluded that jurisdiction was proper because the action was related to Harrod BA's rights and duties arising out of the ownership of the property in question, and Virginia had important interests in not permitting foreign companies to use rights emanating from its territory to infringe U.S. trademarks.[384] ***391** In determining the proper standard of proof, the court noted that not only had no previous court opinion used a heightened standard of proof, the interests implicated by the cybersquatting provisions of the ACPA are not in the same category as those where a heightened standard of proof is traditionally used, such as proceedings to terminate parental rights, involuntary commitment proceedings, deportations or other controversies where "particularly important individual interests or rights are at stake."[385] Recognizing that some cases involving fraudulent or bad faith conduct require a showing of clear and convincing evidence, the court could not determine an overarching principle between those that do, such as tax fraud, and others that do not.[386] Relying on Supreme Court authority in Herman & MacLean v. Huddleston,[387] stating that heightened evidentiary burdens stemmed from a concern that charges of fraud could be easily fabricated, the court reasoned that the detailed guidelines for a finding of bad faith stated in the ACPA mitigated that concern of fabrication.[388] The court ruled that a preponderance of evidence is the correct standard.[389]

In perhaps the most significant aspect of the case, the Fourth Circuit concluded that in rem proceedings under the ACPA are not limited to ACPA claims (i.e., those involving bad faith registrations) but can also include claims for dilution and infringement.[390] Describing it as a "close question," the court focused on the language in the ACPA stating that the owner of a mark may file an in rem action against a domain name if it violates "any right" of the owner of a registered mark.[391] The plain language of the statute contains no limitation to ACPA claims.[392] The court could not understand why Congress would describe the types of marks covered by the statute as those marks "registered in the [PTO] or protected under [infringement and dilution statutes]" if it intended in rem jurisdiction to be available only for bad faith claims.[393] Whereas the district court viewed the phrase "a person who would have been a defendant in a civil action under paragraph (1)" of the Act as limiting the proceedings to bad faith claims, the Fourth Circuit viewed it as a shorthand reference for the current registrant of the domain name.[394] Lastly, the Fourth Circuit relied on legislative history indicating that the ***392** statute was meant to apply where the domain name violated "substantive Federal trademark law" and was "infringing or diluting under the Trademark Act."[395] The court reversed the district court's dismissal of the dilution and infringement claims.[396] The court went on to affirm the finding of bad faith registration of the fifty-four domain names but reversed the grant of summary judgment for the six "harrodsargentina" domain names because of an inadequate period of time for discovery.[397]

D. Negative Commentary May be Commercial Use: Nissan Motor Co. v. Nissan Computer Corp.[398]

Nissan Motor Company (Nissan), a Japanese automobile manufacturer, filed suit against Nissan Computer Corporation (NCC), a North Carolina computer retailer founded by Mr. Uzi Nissan. NCC registered the domain names "nissan.com" and "nissan.net" in 1994 and 1996, respectively.[399] After unsuccessful negotiations aimed at transferring the domain, Nissan sued NCC alleging dilution, domain name piracy, false designation of origin, and state law claims of unfair competition.[400] The district court had previously granted Nissan's motion for summary judgment on the dilution claim, and these proceedings dealt with the issuance of a permanent injunction.[401] NCC contended that the domain names should not be transferred as Nissan requested and that an injunction was inappropriate because it would be an impermissible retroactive application of the law.[402] The court determined that the relief requested was prospective and, thus, permissible.[403]

In refusing to transfer the domain names to Nissan, the court ruled that NCC could continue to use the domain names for noncommercial speech.[404] The district court pointed out, however, that "disparaging remarks or negative commentary at nissan.com and nissan.net (and links to such content) are sufficiently commercial to bring the defendants' use of the domain names within the scope of the FTDA, and therefore should be precluded."[405] The district court enjoined such conduct, distinguishing ***393** the present case from others such as Bally Total Fitness Holding Corp. v. Faber[406] and Ford Motor Co. v. 2600 Entertainers[407] in that the domain name at issue in this case was the trademark itself (nissan.com).[408] The court reasoned that the goodwill built up by Nissan would ensure a steady flow of visitors to the NCC website, but "critical commentary at nissan.com and nissan.net would exploit this goodwill in order to injure Nissan. Under these circumstances, the critical speech becomes commercial and is subject to the proscriptions of the FTDA."[409] The court noted that NCC was free to post critical commentary on other websites if it chose to do so.[410] Rather than order the domain names transferred, the court ordered that NCC not use the names for commercial purposes, which would include posting critical commentary or links to sites with critical commentary.[411]

VII. Laches

A. Nartron Corp. v. STMicroelectronics, Inc.[412]

In addition to finding plaintiff's alleged mark generic, the Sixth Circuit provided a discussion of that Circuit's law on laches and acquiescence.

In 1998, Nartron, a developer and producer of electronic devices, filed suit against STMicroelectronics (ST), a producer of microchips.[413] Nartron alleged that STM infringed its registration for SMART POWER on several occasions beginning as far back as 1987.[414] ST contended that since 1987 it had made continuous non-infringing use of "Smart Power" to describe its microchips that combine power transistors and control circuitry on one chip, that it never complied with any prior request from Nartron to cease use, and that ST always believed its use of the mark was proper and non-infringing.[415] The district court granted summary judgment that the mark was generic and that suit was barred under the doctrine of laches.[416]

***394** The Sixth Circuit agreed that the mark was generic and affirmed the district court's ruling. The court found that ST produced overwhelming evidence, which Nartron failed to rebut, that the term "smart power," as used by ST and other participants in the semiconductor industry, denotes a type of technology rather than goods associated with Nartron.[417]

The court stated that, even if the mark were not generic, laches would bar any monetary relief because an eleven year delay in filing suit was inexcusable and that ST would suffer prejudice as a result of the delay.[418] Nartron claimed that ST's use since 1987 was not continuous, that the facts presented a progressive encroachment by ST, that Nartron did not file suit earlier because it believed the infringing use had stopped, and that ST did not show any prejudice as a result of the delay.[419] The court rejected all of these arguments. In the Sixth Circuit, a rebuttable presumption of laches arises when the state law statute of limitations for injury to personal property has run.[420] To rebut the presumption, a party must rebut the presumption of prejudice and establish an excuse for the delay or establish that the defendant engaged in such egregious conduct that the equities should lie in plaintiff's favor.[421]

The record indicated not only ST's continued use with Narton's knowledge but also that ST notified Nartron of its intent to continue use.[422] The court found that claims of changes in management and font size of the mark altered its use were not enough to establish progressive encroachment.[423] With respect to lack of prejudice, the court noted that any prejudice is sufficient even it takes the form of a risk of increased damages or loss of evidence.[424] The court noted that some witnesses were no longer available and that others had faulty recollections because of the lapse of time.[425] The court also pointed out that the risk of increased damages goes up every year a mark is in use and that in this case, the cost of defending the suit grew in part due to the amount of evidence ST was now forced to produce.[426] The court pointed out that under Sixth Circuit law, plaintiff's laches claim would not ***395** bar it from obtaining injunctive relief but that Natron was not entitled to any relief because its alleged mark was determined to be generic.[427]

B. Profitness Physical Therapy Center v. Pro-fit Orthopedic and Sports Physical Therapy P.C.[428]

Profitness Physical Therapy Center (Profitness) and Pro-fit Orthopedic and Sports Physical Therapy (Pro-fit) both offer physical therapy services in New York City.[429] Profitness had used the mark PRO FITNESS in Manhattan since 1986 and owned a federal registration.[430] Pro-fit started in Queens in 1999 and opened an office in Manhattan in April 2000.[431] Profitness sent Pro-fit a cease and desist letter three months after Pro-fit began operating, and Pro-fit agreed to change its corporate identity (from Pro Fit Physical Therapy, P.C. to Pro-fit Orthopedic and Sports Physical Therapy) to avoid confusion and further conflict.[432] Pro-fit did not receive a response.[433] Pro-fit's counsel wrote a letter to Profitness indicating that Pro-fit would proceed with the name change if it did not receive a response from Profitness.[434] No response was received until one year later when Profitness learned of the opening of the Manhattan Pro-fit office.[435] Profitness demanded that Pro-fit cease use of the name Pro-fit.[436]

Profitness filed suit, and the district court granted summary judgment to the defendant on the bases of acquiescence and laches.[437] Nonetheless, it ordered each party to disclaim any affiliation with the other in their respective advertising.[438] On appeal, the Second Circuit found that Profitness' silence amounted to acquiescence because the letter from Pro-fit amounted to an understood agreement.[439] Rather than voice its objections or sue, Profitness did nothing and Pro-fit reasonably relied on its silence.[440] The court did find that the district court erred by not ***396** fully considering the plaintiff's contention that any acquiescence on its part was limited to the use of Pro-fit in Queens only.[441] "In order to determine whether Pro-Fit's expansion into Manhattan exceeded the scope of Profitness's prior acquiescence, the district court needed to compare the likelihood of confusion from Pro-Fit's Queens establishment at the time that Profitness acquiesced and the likelihood of confusion from its new Manhattan facilities."[442]

The appellate court agreed with Profitness that summary judgment was improper because the court did not consider likelihood of confusion essential to Profitness' claim of progressive encroachment.[443] Because progressive encroachment hinges on whether a defendant's use has been redirected such that likelihood of confusion with the plaintiff's mark becomes more discernable, the district court should have examined the likelihood of confusion prior to and after the opening of the Manhattan facility.[444] Hence, the court vacated the district court's judgment and remanded this issue for determination.[445]

VII. Abandonment: Cumulus Media, Inc. v. Clear Channel Communications, Inc.[446]

Clear Channel Communications (Clear Channel) and Cumulus Media Incorporated (CMI) operate competing radio stations in Tallahassee, Florida.[447] From 1994 to 2000, CMI used the name "The Breeze" to identify its station, which had the call letters WBZE.[448] In September of 2000, the station began referring to itself as "Star 98" and changed its programming format (although "The Breeze" still appeared on station materials such as the sign at the station's headquarters and some promotional materials).[449] Additionally, the Arbitron ratings service still listed the station as "The Breeze."[450]

About thirteen months after CMI's name change, Clear Channel changed its station's name from "The Mix" to "The Breeze," and it began using a logo nearly identical to CMI's "The Breeze" logo.[451] CMI promptly filed suit alleging trademark ***397** infringement and unfair competition.[452] The district court issued a preliminary injunction against Clear Channel's use of "The Breeze," and Clear Channel appealed by claiming that CMI had abandoned "The Breeze."[453] The district court found that CMI had not discontinued use because it was still using "The Breeze" logo on business cards and the sign at the studio.[454] The appellate court could not discern any clear error given the limited facts available at this stage of the litigation.[455]

Clear Channel contended that it had established a prima facie case of abandonment, and, under the Ninth Circuit's holding in

E. Remy Martin & Co. S.A. v. Shaw-Ross International Imports, Inc.,[456] the burden should have then shifted to CMI.[457] The court pointed out that a defendant asserting an abandonment defense has a heavy burden of proof and that Clear Channel overstated the Remy Martin holding.[458] Relying on case law from other circuits and Federal Rule of Evidence 301, the court of appeals held that although Remy Martin and the Lanham Act may shift the burden of production to the plaintiff, the burden of persuasion regarding abandonment always remains on the party asserting the defense.[459] The court found that CMI met its burden by pointing out its continued use of "The Breeze."[460] The decision of the district court was affirmed.[461]

IX. Naked Licensing

A. International Cosmetics Exchange, Inc. v. Gapardis Health & Beauty, Inc.[462]

CLM, a French corporation, produces and sells the perfume FAIR & WHITE in France.[463] International Cosmetics Exchange (ICE) is an American company that imports and sells ethnic cosmetic products.[464] The two companies entered into ***398** contract negotiations to develop, market, and promote FAIR & WHITE perfumes in the United States.[465] Pursuant to the resulting agreement, ICE was made the owner and holder of all rights, title, and interest in the mark FAIR & WHITE in the United States.[466] A second distributor of ethnic products, Gapardis, became interested in FAIR & WHITE around the same time, and it also entered into an agreement with CLM whereby Gapardis became the exclusive distributor in the United States for products bearing the FAIR & WHITE mark.[467] CLM discovered that counterfeit FAIR & WHITE goods were being sold in the United States, and, believing ICE to be the source, stopped shipment of all products to ICE.[468] ICE then provided a company with the formula for FAIR & WHITE and began selling the resulting products using the FAIR & WHITE mark.[469] When a former associate of Gapardis, McHeileh, began selling counterfeit FAIR & WHITE products as well, ICE filed suit against the former associate, Gapardis, CLM, and their principals, alleging trademark infringement and breach of contract.[470] The defendants brought counterclaims against ICE and moved for a preliminary injunction barring ICE and McHeileh from importing or selling counterfeit products.[471]

The district court found that CLM breached its agreement with ICE when it entered into the agreement with Gapardis and then ceased supplying ICE with FAIR & WHITE products.[472] The court also held, however, that ICE was not entitled to injunctive relief because it had breached the agreement as well by selling counterfeit products.[473] The court ruled that the mark reverted to CLM, and enjoined ICE and McHeileh from importing or distributing FAIR & WHITE products in the United States.[474]

On appeal, CLM contended that the agreement between it and ICE was an improper assignment in gross and therefore was invalid because ICE was only interested in owning the trademark and never purchased the formula or any other CLM assets.[475] Despite noting that the transfer of a trademark without the attendant goodwill of the business it represents is generally invalid, the appellate court ***399** determined that the assignment was not in gross at the time the agreement was entered because the agreement referenced ICE's efforts to develop, distribute, and market the FAIR & WHITE brand in connection with products in the United States.[476] Hence the agreement "was not in gross because it continued the association of the FAIR & WHITE trademark with the very goods which created its reputation."[477] The court affirmed the district court's interpretation of the contract that rights in the mark reverted to CLM despite the absence of a reversion clause.[478] The court determined that allowing ICE to retain ownership after the agreement was terminated would defeat the point of the agreement: to police the mark and prevent counterfeit goods.[479] Because the rights in the mark reverted to CLM when ICE breached the agreement, ICE could not have a property interest on which to base its request for preliminary relief.[480] The district court's ruling was affirmed.[481]

B. Barcamerica International Usa Trust v. Tyfield Importers Inc.[482]

The Ninth Circuit reaffirmed its position that impermissible naked licensing occurs where a trademark owner does not maintain any control over the quality of goods represented by the trademark.

Barcamerica International USA Trust (Barcamerica) registered LEONARDO DA VINCI for wine in 1984.[483] In 1988, Barcamerica entered into a licensing agreement with Renaissance Vineyards (Renaissance) for production and sale of wine under the LEONARDO DA VINCI trademark.[484] In 1989, the two parties entered into a second licensing agreement for the same mark, but neither agreement contained any quality control provision.[485]

Cantine Leonardo Da Vinci Soc. Coop. a.r.l. (Cantine), an Italian winery, had been making and selling wine under the LEONARDO DA VINCI mark in the U.S. since 1979. Cantine learned of Barcamerica's registration and commenced a cancellation proceeding with the PTO based on abandonment through naked licensing.[486] ***400** Barcamerica responded by filing a suit in the Eastern District of California for trademark infringement.[487]

Appealing summary judgment on the abandonment issue, Barcamerica did not contest the district court's finding that the license agreements failed to include quality control provisions or that Barcamerica was not familiar with Renaissance's quality control efforts.[488] Barcamerica contended "that because Renaissance makes good wine the public is not deceived by Renaissance's use of Barcamerica's LEONARDO DA VINCI mark and thus the license was legally acceptable."[489]

The Ninth Circuit noted that an explicit quality control provision is not always mandated, but where, as here, the licensor has no knowledge of the licensee's quality control provisions and does not rely on them, naked licensing has occurred.[490] The court rejected Barcamerica's arguments explaining that "[w]hether Renaissance's wine was objectively 'good' or 'bad' is simply irrelevant. What matters is that Barcamerica played no meaningful role in holding the wine to a standard of quality - good, bad, or otherwise."[491] The Ninth Circuit emphasized that consumers are entitled to assume that the quality of goods and services represented by a certain mark will be consistent and predictable.[492] Therefore, the Ninth Circuit upheld the district court's determination that Barcamerica abandoned its mark through naked licensing.[493]

X. Expansion: Times Mirror Magazines, Inc. v. Field & Stream Licenses Co.[494]

This case is a claim by the publisher of Field & Stream Magazine that a series of agreements entered into with the defendant left it with a residual, common law right to use the FIELD & STREAM mark on all itegoos associated with hunting and fishing. The Second Circuit determined that no such residual right existed.[495]

In 1984, Times Mirror Magazines, Inc. (TM) registered the mark FIELD & STREAM for its monthly Field & Stream Magazine which has been published since 1895.[496] Also in 1984, the Gordon & Ferguson Co. (G&F) formed defendant ***401** Field & Stream Licenses Company (FSLC) to license the FIELD & STREAM mark to third parties that make and sell clothing.[497] G&F, which has been in business since 1871, registered the FIELD & STREAM mark for clothing in 1926.[498] The parties entered into a series of agreements from 1984 to 1995 setting out their respective rights to the mark for various products.[499] In 1996, TM sued G&F alleging breach of contract, trademark infringement, false designation of origin, and unfair competition.[500] The district court granted summary judgment for the defendant.[501]

On appeal, TM claimed that "as the holder of a strong mark, it was entitled to expand into other fields and treat a junior user in those related fields as an infringer."[502] The court agreed with the district court that the rights of the parties were defined by their agreements rather than by any residual trademark rights.[503]

The Second Circuit found that the parties' use prior to their initial concurrent use agreement in 1984 "does not demonstrate that TM had a greater right than FSLC to expand use of the mark into the general domain of goods associated with hunting and fishing."[504] By 1984, both parties used the mark on products associated with hunting and fishing, and the court concluded that each had a strong mark.[505] The court distinguished this case from the more usual one in which a senior user moves to protect its mark against infringement by a junior user in a related field by finding that neither party had an automatic entitlement to expand into related markets for hunting and fishing products to the exclusion of the other.[506]

The Second Circuit also held that the parties' agreements addressed all of the breaches TM claimed that FSLC had committed.[507] Finally, the court rejected TM's argument that rescission of the agreements was necessary to protect the public from confusion.[508]

*402 XI. Monetary Awards

During 2002, several courts of appeal wrangled with the monetary issues near and dear to the hearts of trademark litigants: when it is appropriate to award an accounting of profits, whether damages can be trebled, and what makes a case "exceptional" to justify the award of attorneys' fees either at trial or on appeal.

A. Thompson v. Haynes[509]

Earl Thompson, Sr. and Henry Haynes, president of Fluid Controls, Inc. (Fluid Controls), were co-inventors of a fluid-conducting swivel for which a patent was issued and then assigned to Fluid Controls.[510] Thompson served as a distributor of the swivels which were manufactured by Fluid Controls and sold under the name "Whirl-Jet."[511] After a dispute, Thompson invented, patented and produced his own swivels which he sold to customers who had previously bought Fluid Controls swivels.[512] After Fluid Controls warned its other customers about what it believed to be infringing swivels, Thompson sued for a declaratory judgment of non-infringement, recovery of unpaid royalties, and other claims.[513] Fluid Controls' counterclaims included patent infringement and violations of the Lanham Act.[514]

After a bench trial, the district court found that Thompson had substituted his swivels for Fluid Controls' without informing a customer.[515] The court determined that this was a willful violation of the Lanham Act, the Oklahoma Deceptive Trade Practices Act (DTPA), and common law unfair competition.[516] The district court awarded the defendants, after trebling, more than two million dollars, representing Fluid Controls' lost profits on swivel sales, Thompson's profits on allegedly counterfeit swivels, and damages for an advertising campaign.[517] The final award came after an offset of $76,673 in unpaid royalties was credited to Thompson.[518]

The Federal Circuit affirmed the district court's holdings regarding Thompson's violations and issuance of a permanent injunction against further unfair competition, but the court vacated several aspects of the district court's monetary ***403** awards.[519] The district court fixed Fluid Controls' damages at $133,412.50, and then trebled that amount based on Thompson's willful violations of state and federal law.[520] The Federal Circuit found this assessment of exemplary damages to be erroneous because 15 U.S.C. § 1117(a)[521] allows for an award of up to treble actual damages but only for the amount of proven profits.[522] "The court may not, as it did here, simply lump profits together with damages and apply the same measure of enhancement to both," the appellate court wrote.[523] The court thus affirmed the award of Thompson's profits but vacated the trebling of those profits and remanded the case for a separate computation of damages and profits.[524]

In this decision, the Federal Circuit reversed the district court's award representing Fluid Control's lost sales of $605,526 because it found that the award was based on speculation.[525] The court also found clear error in the district court's award to Fluid Controls of $33,000 in actual damages for conducting a corrective advertising campaign.[526] The court determined that this award was unmerited because Thompson's advertising was not a source of marketplace confusion.[527]

B. Tamko Roofing Products, Inc. v. Ideal Roofing Co., Ltd.[528]

In this case of willful trademark infringement, the First Circuit affirmed the district court's award of attorneys' fees and profits to the plaintiff. The court concluded that Section 35 of the Lanham Act does not require a showing of bad faith or fraud for an award of attorneys' fees.[529]

Tamko Roofing Products, Inc. (Tamko) makes and sells asphalt roofing products, and Ideal Roofing Company, Ltd. (Ideal) manufactures metal roofing and siding products.[530] Tamko has used the mark, HERITAGE, in connection with its roofing products since 1975. By 1997, Tamko possessed ten related marks, including ***404** THE AMERICAN HERITAGE SERIES, when Ideal began using the mark HERITAGE SERIES for metal roofing panels.[531]

Tamko sued for trademark infringement and won a preliminary injunction to enjoin Ideal from using the mark until trial.[532] Nonetheless, Ideal continued to use the HERITAGE mark in its brochures and on its website.[533] The U.S. District Court for the District of New Hampshire held Ideal in contempt and assessed a fine.[534] At trial, the jury found that Tamko and Ideal's roofing products were in direct competition and that Ideal had willfully infringed Tamko's marks.[535] The court awarded Tamko both an accounting of Ideal's profits resulting in an award of over $200,000 and more than $500,000 in attorneys' fees and expenses.[536]

On appeal, Ideal argued that the fee award was inappropriate because the case was not "exceptional" under 15 U.S.C. § 1117(a).[537] The First Circuit rejected Ideal's argument that a finding of fraud or bad faith is a necessary precondition to the award of attorneys' fees.[538] "Willfulness short of bad faith or fraud will suffice when equitable considerations justify an award and the district court supportably finds the case exceptional."[539] In this case, under the totality of the circumstances, the court found adequate evidence of exceptional, deliberate, and willful behavior to justify the fee award.[540] The appellate court also affirmed the award of both Ideal's profits and the permanent injunction.[541]

The First Circuit subsequently considered Tamko's application to recover its attorneys' fees and expenses for defense of the appeal.[542] Tamko argued that fees should be awarded because the case was exceptional and attorneys' fees were awarded at the trial level.[543] The First Circuit rejected Ideal's view that the appeal must be frivolous in order to justify an award of appellate attorneys' fees, but it also ***405** rejected Tamko's argument that fees should be awarded automatically for the appeal of a case deemed exceptional at trial.[544] The court instead established several factors to weigh in such cases and, in doing so, denied Tamko's application by finding that Ideal's appeal did not constitute an exceptional case within § 1117(a).[545]

C. Quick Technologies, Inc. v. The Sage Group PLC[546]

Although the Fifth Circuit confirmed that willful infringement is not a prerequisite to an award of attorneys' fees to a trademark plaintiff, it did nothing to detract from its reputation as a difficult place to win such an award.

Quick Technologies, Inc. (QTI) provides online information about distributors in the promotional products industry along with online databases and other product offerings.[547] QTI began using the mark SAGE INFORMATION SYSTEM in 1992 as well as using a variety of marks incorporating the word SAGE since then.[548] Defendant The Sage Group PLC (Sage Group), which makes and sells software for accounting and business management, is organized under the laws of England and Wales.[549] Beginning in 1991, acting through Sage U.S. Holdings, Inc. (Holdings), Sage Group acquired several American companies that developed and sold accounting and business management software.[550] In 1995, the company adopted SAGE as an international brand name.[551]

When QTI filed an application to register the mark SAGE INFORMATION SYSTEM in 1995, Sage Group opposed the registration.[552] In 1998, Holdings and Sage Software, Inc. (Sage Software) began using the SAGE mark in connection with their products.[553] QTI filed suit against Sage Group, Holdings, and Sage Software, alleging trademark infringement and unfair competition.[554] A jury returned a verdict for plaintiff QTI on most of the likelihood of confusion issues, but it did not find the defendants' conduct willful nor did it award an accounting of ***406** profits.[555] The jury was instructed to determine the amount of damages owed to QTI, if any, only if it answered affirmatively regarding the issue of willful infringement.[556]

The Fifth Circuit first affirmed the district court's dismissal of Sage Group from the suit based on a lack of personal jurisdiction, finding that the British company's contacts both with the PTO and U.S. companies and through the operation of its website were insufficient to support jurisdiction.[557]

The court also turned to the question whether QTI was entitled to an accounting of profits from Holdings and Sage Software even though the defendants' infringement was not willful.[558] Construing the language of 15 U.S.C. § 1117(a), the court concluded:

> It is obvious from our cases that willful infringement is an important factor which must be considered when determining whether an accounting of profits is appropriate. In accordance with our previous decisions, and in light of the plain language of § 1117(a), however, we decline to adopt a bright-line rule in which a showing of willful infringement is a prerequisite to an accounting of profits.[559]

The Fifth Circuit reaffirmed the multi-factor test it used in prior cases to determine whether an award of profits is appropriate in trademark infringement cases.[560] The court concluded that the jury instruction was erroneous because it made an award of profits contingent on a finding of willful infringement, and because the jury was not allowed to consider the public interest in making the misconduct unprofitable in its damages determination,[561] one of the factors adopted by the Fifth Circuit in Pebble Beach Co. v. Tour 18 Ltd.[562] The court concluded, however, that despite the error, the principles of equity still did not weigh in favor of an award of profits to QTI.[563] The court found that the case did not involve an attempt to profit from QTI's SAGE marks but rather a simple disregard of QTI's rights.[564] The district court's judgments were affirmed.[565]

*407 XII. Insurer's Duty to Defend: R.C. Bigelow, Inc. v. Liberty Mutual Insurance Co.[566]

The Second Circuit reversed the district court's grant of summary judgment to the defendant insurance company, concluding that it had a duty to defend under an "advertising injury" policy provision in a trade dress infringement suit Celestial Seasonings, Inc. (Celestial) brought against rival tea maker R.C. Bigelow, Inc. (Bigelow).[567]

Celestial's claims for trade dress infringement and dilution centered on Bigelow's introduction of herbal teas in new packaging that Celestial contended was confusingly similar to its trade dress.[568] Celestial also accused Bigelow of false advertising.[569] Liberty Mutual Insurance Co. (Liberty Mutual), Bigelow's insurer, denied Bigelow's request to defend and indemnify.[570] The Colorado district court entered judgment in favor of Bigelow on all counts.[571]

Simultaneously, Bigelow brought suit against Liberty Mutual in Connecticut.[572] Bigelow argued that it was entitled to coverage under a provision of its policy that included one definition of an advertising injury as "[c]opying a person's or organization's advertising ideas or advertising style."[573] On appeal, Bigelow stated that the Connecticut district court erred as a matter of law in holding that trade dress infringement could never take place in the context of advertising.[574]

Applying Connecticut law on an insurer's duty to defend, the Second Circuit held that, "to the extent that Bigelow allegedly copied Celestial's packaging and displayed Bigelow's packaging in published advertisements, the Colorado complaint sufficiently alleged that Bigelow copied Celestial's 'advertising ideas or advertising style' within the plain meaning of the words in the insurance policy."[575] The Second Circuit concluded that the term "copying" used in the policy did not suggest a traditional tort that could readily be considered distinct from trademark or trade dress infringement.[576] The court also found the required causal nexus in Celestial's ***408** claim that Bigelow caused an "advertising injury" through its alleged offense of creating consumer confusion by using copied trade dress.[577]

XIII. Seizure: Waco International Inc. v. KHK Scaffolding Houston Inc.[578]

The Fifth Circuit affirmed the district court's finding of wrongful seizure, emphasizing that the standards for trademark infringement and seizure are different.[579]

Both plaintiff-appellant Waco International Inc. (Waco) and defendant-appellee KHK Scaffolding Houston Inc. (KHK) make scaffolding.[580] Waco's scaffolding products have a decal bearing the WACO mark and typically are red or blue in color.[581] KHK's scaffolding products do not bear a mark but instead feature a safety label that refers to KHK.[582] In its sales brochure KHK indicates which of its scaffolding is compatible with Waco's products.[583] In 1998, KHK mailed to prospective customers brochures and solicitation letters, some of which stated that KHK was offering "Waco" products.[584] In addition, a Waco investigator who purchased scaffold frames from KHK was given a sales report that identified the frames as WACO frames.[585] KHK admitted that fewer than twenty of its invoices used the terms "Waco" or "Hi-Load" - another of Waco's marks - without a qualifier such as "style" or "compatible."[586]

On the same day that Waco sued KHK for trademark infringement and unfair competition, it sought and obtained an ex parte seizure order under 15 U.S.C. § 1116(d)(1)(A).[587] Waco then entered KHK's place of business and seized its red and blue scaffolding, as well as certain business records.[588] At a later hearing, the seizure order was dissolved and KHK filed a counterclaim for compensatory and punitive damages for wrongful seizure under 15 U.S.C. § 1116(d)(11).[589] The district ***409** court denied KHK's motion for partial summary judgment on its damages from the seizure because it found the amount in dispute.[590] However, the court did grant KHK's motion in part by holding the seizure wrongful as a matter of law because the KHK frames were legitimate non-infringing merchandise.[591]

At trial, the jury found that KHK had infringed Waco's marks but determined that KHK's use constituted "fair use."[592] The jury awarded KHK over $900,000 in attorneys' fees and costs as well as $250,000 in punitive damages but gave no damages for lost profits or goodwill due to the wrongful seizure.[593]

In affirming the wrongful seizure award, the Fifth Circuit stressed that a defendant's liability for trademark infringement for representations in connection with the sale of its goods does not necessarily warrant seizure of the goods.[594] "The ex parte seizure remedy must be narrowly construed, and is not coextensive with liability for any Lanham Act claim."[595] The court also held that the focus of an ex parte seizure order must be on the goods themselves (which, here, did not bear the WACO mark) rather than on a business practice or representation.[596]

XIV. International Issues

A. The Madrid Protocol

This past November, Congress approved the Madrid Protocol Implementation Act.[597] The Madrid Protocol is one of two treaties that make up the Madrid system for registration of trademarks.[598] Essentially, the protocol allows for an international application to be filed based on an application or registration in any member country. The benefit of the protocol is that a company may now seek protection of its trademark rights in numerous countries at the same time while utilizing its own country's registration process, which, presumably, the company is more familiar with.

***410** The holder of a registration or an applicant for a registration can file an international application.[599] After receiving the international application, the PTO certifies that the information in the international application is the same as that in the basic (domestic) application or registration and then forwards the international application to the International Bureau of the World Intellectual Property Organization (WIPO).[600]

The holder of a foreign registration or application may seek extension of that protection into the United States, but all requests for extension that the PTO receives through the International Bureau of WIPO will be examined as an application for registration on the Principal Register.[601] Hence, an application under the Madrid Protocol will face the same rigorous examination as a domestic application. Unlike domestic applications, however, the Supplemental Register is not available to applications under the Madrid Protocol.[602] A helpful guide to the Madrid Protocol is available at http://www.wipo.org/madrid.

B. Barcelona.com, Inc. v. Excelentisimo Ayuntamiento De Barcelona[603]

The U.S. District Court for the Eastern District of Virginia has held that the ACPA protects foreign marks as well as domestic ones.[604]

Joan Nogueras Cobo (Nogueras) registered the domain name "barcelona.com" with Network Solutions, Inc. (NSI) under his wife's name in February of 1996.[605] One year later, Nogueras began using the domain name by providing information about the city of Barcelona, an email service, a chat room, and links to other Internet services.[606] Nogueras incorporated Barcelona.com, Inc. (BCI) under the laws of Delaware in October of 1999, and Nogueras's wife subsequently transferred title to the domain name to BCI.[607]

The City Council of Barcelona (Council) objected to BCI's use of "barcelona.com" and filed a complaint with the World Intellectual Property Organization (WIPO).[608] A WIPO panelist ordered the transfer of "barcelona.com" to the Council. ***411** [609] In response to the panelist's ruling, BCI filed a declaratory judgment action seeking declaration that its registration of "barcelona.com" was not unlawful.[610] The Council counterclaimed under the ACPA.[611]

Reviewing the district's case law[612] and the WIPO final report, the district court determined that the WIPO ruling "should be given no weight."[613] The court noted that neither BCI nor the Council owned any trademark for the name "Barcelona" in the United States or elsewhere.[614] The Council did own various Spanish trademarks containing the term "Barcelona," but did not have one for BARCELONA alone.[615] In considering the Council's claim under the ACPA, the court noted that Congress made no distinction between United States and foreign marks in the language of the ACPA.[616] The court stated that the ACPA "was framed to govern the registration of domain names on the Internet, and the framers were perfectly aware of the international nature of the Internet when enacting the law."[617]

It is untenable to suppose that Congress, aware of the fact that the internet is so international in nature, only intended for U.S. trademarks to be protected . . . . [T]he federal government established ICANN, which, in turn, authorized [WIPO] to resolve domain name disputes. This authorization was granted, in part, precisely because of the international nature of these disputes.[618]

Accordingly, the court determined that Spanish trademarks could be protected by the ACPA. After examining the nine factors in the ACPA, the court determined that bad faith intent existed on the part of Nogueras and that there was a confusing similarity of marks.[619] The court denied BCI's request for declaratory judgment and ordered that the domain name "barcelona.com" be transferred to the Council.[620]

***412 C. Rio Properties, Inc. v. Rio International Interlink[621]**

Rio Properties Incorporated (Rio) owns the Rio Hotel and Casino in Las Vegas, Nevada, and numerous registrations with the "Rio" name.[622] Rio International Interlink (RII) is an online gambling service that exists under the laws of Costa Rica.[623] RII's only physical presence in the United States is a mailing address in Miami that RII listed on its registration for the domain names "riosports.com" and "betrio.com."[624] Rio filed a trademark infringement suit but was unable to properly serve RII because of RII's limited presence in the United States.[625] The address used by RII for registering its domain names was actually the address of an international courier IEC.[626] Despite the fact that IEC was not authorized to accept service on RII's behalf, IEC agreed to forward the summons and complaint to RII in Costa Rica.[627] Despite efforts to locate RII in Costa Rica and elsewhere, Rio was unable to locate RII and, therefore, petitioned the district court for alternative service of process.[628] The court-ordered service through the mail to (1) a Los Angeles attorney to whom RII had apparently forwarded the summons and complaint, (2) IEC, and (3) RII via its email address.[629] RII filed a motion to dismiss based on improper service and lack of personal jurisdiction, but the district court denied it.[630] The Ninth Circuit Court of Appeals held that the service ordered was reasonably calculated to give RII notice of the suit and that the district court also properly had personal jurisdiction over RII.[631]

The appellate court pointed out that under Fed. R. Civ. P. 4(f)(3), service on a foreign business entity may be achieved by any means directed by a court that are not in contravention of an international agreement even if those means are in contravention of the laws of the business entity's home country.[632] Disagreeing with RII's contention, the appellate court did not read Rule 4 as presenting a hierarchy of ***413** preferred methods of service - each level of which must be exhausted before proceeding to the next.[633]

The appellate court also determined that service through IEC was proper because RII represented that address as its own when it registered the domain names at issue.[634] Furthermore, RII instructed its customers to submit payments through IEC, and RII eventually received the complaint that Rio served upon IEC.[635] The same was true for service upon the Los Angeles attorney.[636] In deciding whether ordering service of process through email was proper, the court acknowledged that it could find no precedent condoning it, but the court determined that in this case it was probably the best method of service.[637] Noting that there is no constitutional limitation on the means of service other than it must be reasonably calculated to give notice and an opportunity to respond, the court stated that "this broad constitutional principle unshackles the federal courts from anachronistic methods of service and permits them entry into the technological renaissance."[638] The court also relied on the fact that email was RII's preferred method of contact - it structured its business so that it could only be contacted via email and had embraced and profited by the "e-business model."[639] The court distinguished this case from WAWA Inc. v. Christensen[640] in which the plaintiff in that case took it upon itself to attempt service via email rather than doing it pursuant to a court order.[641]

The appellate court also determined that personal jurisdiction was proper because the defendant had purposefully availed itself to the Nevada forum by targeting Nevada customers through its advertisement campaign.[642] Finally, the appellate court affirmed the entry of a default judgment based on RII's continued violation of discovery orders.[643]

*414 XV. False Advertising

Defendants prevailed on key issues in two false advertising cases. The first opinion made an important pronouncement on the test for "commercial advertising or promotion" while the second evaluated focus group and survey evidence.

A. Fashion Boutique of Short Hills, Inc. v. Fendi USA, Inc.[644]

In the most significant aspect of this false advertising case, the Second Circuit adopted three elements of a district court test for ascertaining "commercial advertising or promotion" within Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(B).[645]

The plaintiff, retailer of Fendi products at an upscale mall in Short Hills, New Jersey between 1983 and 1991, claimed that it was driven out of business when defendant, Fendi, carried out a corporate policy to misrepresent the quality and authenticity of plaintiff's products after Fendi opened a store on New York's Fifth Avenue in 1989.[646] The U.S. District Court for the Southern District of New York granted partial summary judgment by dismissing Fashion Boutique's claims under the Lanham Act prohibiting misrepresentation of another person's goods or services in "commercial advertising or promotion."[647] Relying on a four-part test announced in Gordon & Breach Science Publishers S.A. v. American Institute of Physics,[648] the district court concluded that Fashion Boutique's evidence, which consisted of twenty-seven oral statements - a dozen of them admissible - to individual customers, did not constitute sufficient dissemination to constitute "commercial advertising or promotion."[649]

The Second Circuit noted that the Lanham Act does not define the phrase "commercial advertising or promotion" and that most courts have adopted the Gordon & Breach test.[650] Under the test, to qualify as commercial advertising or promotion (and, thus, be actionable under Section 43(a)), a representation must be
(1) commercial speech; (2) by a defendant who is in commercial competition with the plaintiff; (3) for the purpose of influencing consumers to buy defendant's goods or services; and, (4) although representations less formal than those made as part of a classic ***415** advertising campaign may suffice, they must be disseminated sufficiently to the relevant purchasing public.[651]

The Second Circuit adopted the first, third, and fourth elements of the Gordon & Breach test but expressed no view on the second element, which it did not need to reach in this case.[652] Applying the test, the court "easily conclude[d] that Fashion Boutique failed to put forward sufficient evidence that defendants' actions constituted 'commercial advertising or promotion.'"[653] The court found no evidence to suggest that the statements were part of an organized campaign to penetrate the marketplace.[654] In doing so, the oral comments were insufficient to satisfy the requirement that representations be disseminated widely to satisfy the terms of the Lanham Act.[655] The Second Circuit affirmed the district court's judgment.[656]

B. Scotts Co. v. United Industries Corp.[657]

The Fourth Circuit vacated a district court's preliminary injunction regarding a false message to consumers.

Scotts Company sued Pursell Industries and United Industries (defendants), claiming that the packaging of the defendants' "Vigoro" crabgrass-control product conveyed a false messages to consumers.[658] The court explained that chemical crabgrass-control products generally are most effective when applied to crabgrass that has yet to sprout and are effective on early "post-emergent" crabgrass (less than four weeks old) but generally are ineffective when applied to mature crabgrass plants.[659] Scotts, which makes "Halts" anti-crabgrass product, contends that an illustration of a mature crabgrass plant on the Vigoro packaging above the phrase "Prevents Crabgrass up to 4 Weeks After Germination" falsely suggests that Vigoro can kill mature crabgrass.[660] The U.S. District Court for the Eastern District of Virginia ordered the defendants to change the packaging and either remove existing Vigoro from store shelves or place a sticker over the crabgrass graphic.[661] The ***416** Fourth Circuit stayed the injunction pending resolution of the defendants' expedited appeal.[662]

The appellate court found that Scotts failed to make even a prima facie showing of consumer confusion.[663] First, the court concluded that the Vigoro message was not literally false.[664] The Fourth Circuit then considered whether evidence of consumer confusion showed that the claims were impliedly false or misleading.[665] Scotts presented evidence of two focus group discussions and the results of a survey of forty consumers.[666] The court found that "the manner in which the focus groups were conducted destroyed the objectivity of the discussions, rendering the results utterly unreliable on the question of whether the Vigoro packaging conveys a false message."[667] Furthermore, the court found the survey did not establish consumer confusion because it failed to address the question the Fourth Circuit deemed critical: "whether the Vigoro packaging conveys the message that Vigoro kills mature crabgrass, a message that would be false."[668]

Finally, the Fourth Circuit found the district court was incorrect in giving substantially less weight to the harm a preliminary injunction would visit on a defendant because that harm is self-inflicted.[669] The court found that this approach that would almost always tilt the balance-of-harms in favor of the plaintiff.[670] In this case, however, any error was inconsequential because neither party stood to suffer significant harm from the grant or denial of a preliminary injunction.[671] Balancing all factors, the court concluded that Scotts had failed to show a likelihood of success on the merits and, therefore, vacated the preliminary injunction.[672]

Footnotes

a1 Fulbright & Jaworski, LLP

1 Wal-Mart Stores,Inc. v. Samara Bros.,Inc., 529 U.S. 205, 54 U.S.P.Q.2d (BNA) 1055 (2000) and TrafFix Devices,Inc. v.

Marketing Displays, Inc., 532 U.S. 23, 32-33, 58 U.S.P.Q.2d (BNA) 1001 (2001).

2 259 F.3d 464, 59 U.S.P.Q.2d (BNA) 1650 (6th Cir. 2001) [hereinafter V Secret I].

3 15 U.S.C. §1125(c) (1997 & Supp. 2003).

4 Moseley v. V Secret Catalogue,Inc., 123 S. Ct. 1115, 1124, 65 U.S.P.Q.2d (BNA) 1801, 1807 (2003) [hereinafter V Secret II].

5 Moseley v. V Secret Catalogue,Inc., 535 U.S. 985 (2002).

6 V Secret I, 259 F.3d at 466-67, 59 U.S.P.Q.2d at 1651.

7 Id. at 477, 59 U.S.P.Q.2d at 1660.

8 191 F.3d 208, 51 U.S.P.Q.2d (BNA) 1882 (2d Cir. 1999).

9 V Secret I, 259 F.3d at 471, 59 U.S.P.Q.2d at 208. Other circuits that have at least arguably adopted the likelihood of dilution standard include the First, see I.P. Lund Trading ApS v. KohlerCo., 163 F.3d 27, 49 U.S.P.Q.2d (BNA) 1225 (1st Cir. 1998); the Third, see Times Mirror Magazines,Inc. v. Las Vegas Sports News, L.L.C., 212 F.3d 157, 56 U.S.P.Q.2d (BNA) 1942 (3d Cir. 2000); and the Seventh, Eli Lilly &Co. v. Natural Answers,Inc., 233 F.3d 456, 52 U.S.P.Q.2d (BNA) 1577 (7th Cir. 2000).

10 170 F.3d 449, 50 U.S.P.Q.2d (BNA) 1065 (4th Cir. 1999).

11 V Secret I, 259 F.3d at 472-75, 59 U.S.P.Q.2d at 1655-58.

12 Id. at 474, 59 U.S.P.Q.2d at 1657; 214 F.3d 658, 55 U.S.P.Q.2d (BNA) 1225 (5th Cir. 2000).

13 V Secret II, 123 S. Ct. at 1124, 65 U.S.P.Q.2d at 1807.

14 15 U.S.C. §1127 (2000).

15 V Secret II, 123 S. Ct. at 1124, 65 U.S.P.Q.2d at 1807.

16 Id. at 1125, 65 U.S.P.Q.2d at 1808.

17 Id. at 1124, 65 U.S.P.Q.2d at 1807.

18 Frank I. Schechter, The Rational Basis of Trademark Protection, 40 Harv. L. Rev. 813, 825 (1927).

19 293 F.3d 550, 62 U.S.P.Q.2d (BNA) 1260 (2d Cir. 2002).

[20] NYSE, 293 F.3d at 552, 62 U.S.P.Q.2d at 1260.

[21] Id., 62 U.S.P.Q.2d at 1261. The Casino altered some of these uses after NYSE filed suit. Id. at 553, 62 U.S.P.Q.2d at 1262.

[22] Id. at 552, 62 U.S.P.Q.2d at 1261.

[23] Id.

[24] Id.

[25] Id. at 555, 62 U.S.P.Q.2d at 1263.

[26] NYSE, 293 F.3d at 557, 62 U.S.P.Q.2d at 1265.

[27] Id.

[28] Id.

[29] Id.

[30] Id. at 558, 62 U.S.P.Q.2d at 1265.

[31] Id., 62 U.S.P.Q.2d at 1265-66.

[32] NYSE, 293 F.3d at 558, 62 U.S.P.Q.2d at 1266.

[33] Id.

[34] No. 00 CIV. 5936(LLM), 2002 WL 1837402 (S.D.N.Y. 2002).

[35] Deere, 2002 WL 1837402, at *4.

[36] Id. at *1.

[37] Id.

[38] Id.

[39] Id.

[40] Id.

[41] 293 F.3d 550, 62 U.S.P.Q.2d (BNA) 1260 (2d Cir. 2002).

[42] Deere, 2002 WL 1837402, at *2.

[43] 514 U.S. 159, 162-63, 34 U.S.P.Q.2d (BNA) 1161, 1162 (1995).

[44] 529 U.S. 205, 211, 54 U.S.P.Q.2d (BNA) 1055, 1068 (2000) ("[W]ith respect to at least one category of mark - colors - we have held that no mark can ever be inherently distinctive.").

[45] Deere, 2002 WL 1837402, at *2.

[46] Id.

[47] Id.

[48] Id. at *3.

[49] 305 F.3d 894, 64 U.S.P.Q.2d (BNA) 1564 (9th Cir. 2002).

[50] Thane Int'l, 305 F.3d at 898-99, 64 U.S.P.Q.2d at 1565.

[51] Id. at 899, 64 U.S.P.Q.2d at 1565.

[52] Id. at 900, 64 U.S.P.Q.2d at 1566.

[53] Id.

[54] Id.

[55] Id., 64 U.S.P.Q.2d at 1566-67.

[56] Thane Int'l, 305 F.3d at 902-03, 64 U.S.P.Q.2d at 1568.

[57] Id. at 902, 64 U.S.P.Q.2d at 1568.

[58] Id. at 913, 64 U.S.P.Q.2d at 1576.

[59] Id. at 912, 64 U.S.P.Q.2d at 1576.

[60] Id. at 907, 64 U.S.P.Q.2d at 1571.

[61] Id. at 907, 64 U.S.P.Q.2d at 1572.

[62] Thane Int'l, 305 F.3d at 904, 64 U.S.P.Q.2d at 1569.

[63] Id. at 908-09, 64 U.S.P.Q.2d at 1572-73.

[64] Id. at 910, 64 U.S.P.Q.2d at 1574.

[65] Id. at 912, 64 U.S.P.Q.2d at 1576.

[66] Id. at 913, 64 U.S.P.Q.2d at 1576.

[67] 61 U.S.P.Q.2d (BNA) 1164 (T.T.A.B. 2001).

[68] Toro, Id. at 1165-66.

[69] Id. at 1167-68.

[70] Id. at 1184.

[71] Id.; 15 U.S.C. §1125(c)(1) (2000).

[72] Toro, 61 U.S.P.Q.2d at 1177-78.

[73] Id. at 1178.

[74] Id. at 1179.

[75] Id. at 1183.

[76] Id. at 1183-84.

[77] Id. at 1180.

[78] Toro, 61 U.S.P.Q.2d at 1180.

[79] Id. at 1181.

[80] Id.

[81] 293 F.3d 1367, 63 U.S.P.Q.2d (BNA) 1303 (Fed. Cir. 2002).

[82] Bose, 293 F.3d at 1378, 63 U.S.P.Q.2d at 1312.

[83] Id. at 1369, 63 U.S.P.Q.2d at 1304.

[84] Id. at 1370, 63 U.S.P.Q.2d at 1305.

[85] Id. at 1373-74, 63 U.S.P.Q.2d at 1308.

[86] Id. at 1369, 63 U.S.P.Q.2d at 1304.

[87] Id. at 1372-78, 63 U.S.P.Q.2d at 1306-12.

[88] Bose, 293 F.3d at 1371, 63 U.S.P.Q.2d at 1305.

[89] 476 F.2d 1357, 177 U.S.P.Q. (BNA) 573 (C.C.P.A. 1973).

[90] Bose, 293 F.3d at 1378, 63 U.S.P.Q.2d at 1311-12.

[91] 297 F.3d 662, 63 U.S.P.Q.2d (BNA) 1760 (7th Cir. 2002).

[92] Te-Ta-Ma, 297 F.3d. at 664, 63 U.S.P.Q.2d at 1761-62.

[93] Id., 63 U.S.P.Q.2d at 1761.

[94] Id., 63 U.S.P.Q.2d at 1761-62.

[95] Id., 63 U.S.P.Q.2d at 1761. On January 8, 2003, World Church leader Matt Hale was arrested as he arrived at the federal courthouse in Chicago for a contempt hearing in this case and accused of attempting to have U.S. District Judge Joan Humphrey Lefkow killed. Jodi Wilgoren, White Supremacist is Held in Ordering Judge's Death, N.Y. Times, Jan. 9, 2003, at A16. Judge Lefkow ordered the World Church to stop using the infringing mark on remand from the Seventh Circuit. Id.

[96] Te-Ta-Ma, 297 F.3d at 664-65, 63 U.S.P.Q.2d at 1762.

[97] Id. at 665, 63 U.S.P.Q.2d at 1762.

[98] Id. at 666-67, 63 U.S.P.Q.2d at 1763-64.

[99] Id. at 667, 63 U.S.P.Q.2d at 1764.

[100] 268 F.3d 494, 60 U.S.P.Q.2d (BNA) 1443 (7th Cir. 2001).

[101] Bliss Salon, 268 F.3d at 495, 60 U.S.P.Q.2d at 1443.

[102] Id.

[103] Id.

[104] Id.

[105] Id. at 495, 497, 60 U.S.P.Q.2d at 1443, 1445.

[106] Id. at 496-97, 60 U.S.P.Q.2d at 1444.

[107] Bliss Salon at 497, 60 U.S.P.Q.2d at 1445.

[108] 300 F.3d 517, 63 U.S.P.Q.2d 2013 (BNA) (4th Cir. 2002).

[109] U.S. Search, 300 F.3d at 523, 525, 63 U.S.P.Q.2d at 2016, 2017.

[110] Id. at 520, 63 U.S.P.Q.2d at 2014.

[111] Id. at 521, 63 U.S.P.Q.2d at 2014.

[112] Id.

[113] Id. at 521-22, 63 U.S.P.Q.2d at 2015.

[114] Id. at 522, 63 U.S.P.Q.2d at 2015.

[115] U.S. Search, 300 F.3d at 523, 63 U.S.P.Q.2d at 2016.

[116] Id. at 525, 63 U.S.P.Q.2d at 2017-18.

[117] Id.

118 Id. at 524, 63 U.S.P.Q.2d at 2017.

119 Id.

120 Id.

121 U.S. Search, 300 F.3d at 525, 63 U.S.P.Q.2d at 2017 (emphasis in original).

122 285 F.3d 848, 62 U.S.P.Q.2d (BNA) 1273 (9th Cir. 2002).

123 Karl Storz, 285 F.3d at 851-52, 62 U.S.P.Q.2d at 1274.

124 Id. at 852, 62 U.S.P.Q.2d at 1274.

125 Id.

126 Id. at 853, 62 U.S.P.Q.2d at 1274-75.

127 Id., 62 U.S.P.Q.2d at 1275.

128 Id. at 854, 62 U.S.P.Q.2d at 1276.

129 Karl Storz, 285 F.3d at 855, 62 U.S.P.Q.2d at 1276.

130 Id. at 854-55, 62 U.S.P.Q.2d at 1276.

131 Id. at 855, 62 U.S.P.Q.2d at 1276

132 Id. at 856, 62 U.S.P.Q.2d at 1277.

133 Id. at 856-57, 62 U.S.P.Q.2d at 1277-78.

134 308 F.3d 1156, 64 U.S.P.Q.2d (BNA) 1375 (Fed. Cir. 2002).

135 Herbko, 308 F.3d at 1160, 64 U.S.P.Q.2d at 1377.

136 Id.

137 Id.

[138] Id.

[139] Id. at 1161-62, 64 U.S.P.Q.2d at 1377.

[140] Id. at 1162-63, 64 U.S.P.Q.2d at 1378 (citing Malcolm Nicol &Co. v. Witco Corp., 881 F.2d 1063, 1065, 11 U.S.P.Q.2d (BNA) 1638,1639 (Fed. Cir. 1989)).

[141] Herbko, 308 F.3d at 1163, 64 U.S.P.Q.2d at 1378-79.

[142] Id. at 1162-63, 64 U.S.P.Q.2d at 1378-79 (citing In re Cooper, 254 F.2d 611, 614-15, 117 U.S.P.Q. (BNA) 396, 398-400 (CCPA 1958)).

[143] Id. at 1163, 64 U.S.P.Q.2d at 1378-79.

[144] Id. at 1164-66, 64 U.S.P.Q.2d at 1380-81.

[145] 281 F.3d 1261, 62 U.S.P.Q.2d (BNA) 1001 (Fed. Cir. 2002).

[146] Hewlett-Packard, 281 F.3d at 1263, 62 U.S.P.Q.2d at 1002.

[147] Id. at 1268, 62 U.S.P.Q.2d at 1005.

[148] Id. at 1265, 62 U.S.P.Q.2d at 1003.

[149] Id.

[150] Id. at 1267, 62 U.S.P.Q.2d 1004.

[151] Id.

[152] Hewlett-Packard, 281 F.3d at 1268, 62 U.S.P.Q.2d at 1005.

[153] 300 F.3d 808, 63 U.S.P.Q.2d (BNA) 2018 (7th Cir. 2002).

[154] Promatek, 300 F.3d at 810, 63 U.S.P.Q.2d at 2019.

[155] Id. at 810-11, 63 U.S.P.Q.2d at 2019.

[156] Id. at 811, 63 U.S.P.Q.2d at 2019-20.

[157] Id., 63 U.S.P.Q.2d at 2020.

[158] Id.

[159] Id. at 812, 63 U.S.P.Q.2d at 2020-21.

[160] Promatek, 300 F.3d at 812, 63 U.S.P.Q.2d at 2020-21 (citing Dorr-Oliver,Inc. v. Fluid-Quip,Inc., 94 F.3d 376, 382, 39 U.S.P.Q.2d (BNA) 1990, 1995 (7th Cir. 1996)).

[161] Id.at 812-13, 63 U.S.P.Q.2d at 2021.

[162] Id.

[163] Id. at 813, 63 U.S.P.Q.2d at 2021.

[164] Id., 63 U.S.P.Q.2d at 2022.

[165] 304 F.3d 936, 64 U.S.P.Q.2d (BNA) 1514 (9th Cir. 2002).

[166] Interstellar Starship, 304 F.3d at 940, 64 U.S.P.Q.2d at 1516.

[167] Id.

[168] Id., 64 U.S.P.Q.2d at 1517.

[169] Id.

[170] Id.

[171] 599 F.2d 341, 346, 204 U.S.P.Q. (BNA) 808, 814 (9th Cir. 1979).

[172] Interstellar Starship, 304 F.3d at 942, 64 U.S.P.Q.2d at 1518.

[173] Id. at 943, 64 U.S.P.Q.2d at 1519.

[174] Id. at 943-45, 64 U.S.P.Q.2d at 1519-20.

[175] Id. at 945, 64 U.S.P.Q.2d at 1520.

[176] Id. at 945-46, 64 U.S.P.Q.2d at 1521.

[177] Id. at 944, 64 U.S.P.Q.2d at 1520.

[178] Interstellar Starship, 304 F.3d at 946, 64 U.S.P.Q.2d at 1521.

[179] 296 F.3d 894, 63 U.S.P.Q.2d (BNA) 1715 (9th Cir. 2002).

[180] 15 U.S.C. §1125(c)(4)(B) (2000).

[181] Mattel, 296 F.3d at 904-07, 63 U.S.P.Q.2d at 1721-23.

[182] Id. at 899, 63 U.S.P.Q.2d at 1717.

[183] Id. at 909, 63 U.S.P.Q.2d at 1725.

[184] Id. at 901, 63 U.S.P.Q.2d at 1719; Dr. Seuss Enterprises, L.P. v. Penguin Books USA,Inc., 109 F.3d 1394, 42 U.S.P.Q.2d (BNA) 1184 (9th Cir. 1997).

[185] Mattel, 296 F.3d at 901, 63 U.S.P.Q.2d at 1719.

[186] 875 F.2d 994, 10 U.S.P.Q.2d (BNA) 1825 (2d. Cir. 1989).

[187] Mattel, 296 F.3d at 902, 63 U.S.P.Q.2d at 1720 (quoting Rogers, 875 F.2d at 999, 10 U.S.P.Q. (BNA) 1825, 1828 (2nd Cir. 1989)).

[188] Id.

[189] Id.

[190] Id. at 903-904, 63 U.S.P.Q.2d at 1721

[191] Id. at 904, 63 U.S.P.Q.2d at 1721.

[192] Id.

[193] Mattel, 296 F.3d at 906, 63 U.S.P.Q.2d at 1722.

[194] Id., 63 U.S.P.Q.2d at 1723 (quoting Hoffman v. Capital Cities/ABC Inc., 255 F.3d 1180, 1184, 59 U.S.P.Q.2d (BNA) 1363, 1365 (9th Cir. 2001)).

[195] Id.

[196] Id. at 906-07, 63 U.S.P.Q.2d at 1723 (quoting Hoffman, 255 F.3d at 1185, 59 U.S.P.Q.2d at 1366).

[197] Id. at 908, 63 U.S.P.Q.2d at 1724; see generally Convention for the Protection of Industrial Property, Mar. 20, 1883, as revised at Stockholm, July 14, 1967, art. 10bis, 21 U.S.T. 1583, 1648, 828 U.N.T.S. 305, 337.

[198] Mattel, 296 F.3d at 908, 63 U.S.P.Q.2d at 1724.

[199] Mattel, 296 F.3d at 908, 63 U.S.P.Q.2d at 1724; see generally 15 U.S.C. §1126(b),(h),(i) (2000).

[200] 279 F.3d 796, 61 U.S.P.Q.2d (BNA) 1508 (9th Cir. 2002).

[201] Playboy Enters., 279 F.3d at 799, 61 U.S.P.Q.2d at 1509.

[202] Id.

[203] Id. at 800, 61 U.S.P.Q.2d at 1509.

[204] Id.

[205] Id., 61 U.S.P.Q.2d at 1510.

[206] 971 F.2d 302, 23 U.S.P.Q.2d (BNA) 1534 (9th Cir. 1992).

[207] Playboy Enters., 279 F.3d at 801, 61 U.S.P.Q.2d at 1510.

[208] Id.

[209] Id.

[210] Id. at 802, 61 U.S.P.Q.2d at 1511.

[211] Id.

[212] Playboy Enters., 279 F.3d at 803, 61 U.S.P.Q.2d at 1512.

[213] Id.

[214] Id. at 803-04, 61 U.S.P.Q.2d at 1512.

[215] Id.

[216] Id. at 804, 61 U.S.P.Q.2d at 1513.

[217] Id.

[218] Playboy Enters., 279 F.3d at 805, 61 U.S.P.Q.2d at 1513.

[219] Id.

[220] Id. at 806, 61 U.S.P.Q.2d at 1514.

[221] Id.

[222] Id.

[223] Id.

[224] 306 F.3d 509, 64 U.S.P.Q.2d (BNA) 1689 (7th Cir. 2002).

[225] Ty, 306 F.3d at 510, 64 U.S.P.Q.2d at 1690.

[226] Id.

[227] Id.

[228] Id. at 512-513, 64 U.S.P.Q.2d at 1691-92.

[229] Id. at 512, 64 U.S.P.Q.2d at 1692.

[230] Id.

[231] Id. at 512-13, 64 U.S.P.Q.2d at 1692.

[232] Ty, 306 F.3d at 513, 64 U.S.P.Q.2d at 1693.

[233] Id. at 514, 64 U.S.P.Q.2d at 1693-94.

[234] Id. at 515, 64 U.S.P.Q.2d at 1694.

[235] 281 F.3d 837, 61 U.S.P.Q.2d (BNA) 1688 (9th Cir. 2002).

[236] Cohn, 281 F.3d at 839, 61 U.S.P.Q.2d at 1688.

[237] Id.

[238] Id.

[239] Id.

[240] Id., 61 U.S.P.Q.2d at 1689.

[241] Id. at 839-40, 61 U.S.P.Q.2d at 1689.

[242] Cohn, 281 F.3d at 841, 61 U.S.P.Q.2d at 1690.

[243] Id. at 841-42, 61 U.S.P.Q.2d at 1690.

[244] Id. at 842, 61 U.S.P.Q.2d at 1690.

[245] Id., 61 U.S.P.Q.2d at 1690-91.

[246] Id., 61 U.S.P.Q.2d at 1691.

[247] Id.

[248] Cohn, 281 F.3d at 842-43, 61 U.S.P.Q.2d at 1691.

[249] Id. at 843, 61 U.S.P.Q.2d at 1691.

[250] Id.

[251] 295 F.3d 623, 63 U.S.P.Q.2d (BNA) 1659 (6th Cir. 2002).

[252] Therma-Scan, 295 F.3d at 628, 63 U.S.P.Q.2d at 1660.

[253] Id. at 627-28, 63 U.S.P.Q.2d at 1660.

[254] Id. at 628, 63 U.S.P.Q.2d at 1660.

[255] Id.

[256] Id.

[257] Id.

[258] Therma-Scan, 295 F.3d at 628, 63 U.S.P.Q.2d at 1660.

[259] Id.

[260] 109 F.3d 275, 42 U.S.P.Q.2d (BNA) 1173 (6th Cir. 1997).

[261] Therma-Scan, 295 F.3d at 641, 63 U.S.P.Q.2d at 1670.

[262] Id. at 639-41, 63 U.S.P.Q.2d at 1669-70.

[263] Id. at 633, 63 U.S.P.Q.2d at 1664.

[264] Id. at 634-36, 63 U.S.P.Q.2d at 1665-66.

[265] Id. at 636, 63 U.S.P.Q.2d at 1166-67.

[266] Id.at 640, 63 U.S.P.Q.2d at 1169-70.

[267] 532 U.S. 23, 32-33, 58 U.S.P.Q.2d (BNA) 1001, 1006-07 (2001).

[268] 289 F.3d 351, 62 U.S.P.Q.2d (BNA) 1534 (5th Cir. 2002).

[269] (2000).

[270] Eppendorf, 289 F.3d at 358, 62 U.S.P.Q.2d at 1538.

[271] Id. at 353, 62 U.S.P.Q.2d at 1534.

[272] Id., 62 U.S.P.Q.2d at 1534.

[273] Id. at 353-54, 62 U.S.P.Q.2d at 1535.

[274] Id. at 354, 62 U.S.P.Q.2d at 1535.

[275] Id., 62 U.S.P.Q.2d at 1535.

[276] Eppendorf, 289 F.3d at 354, 62 U.S.P.Q.2d at 1535.

[277] Id.

[278] Id.

[279] Id.

[280] Id. at 355, 62 U.S.P.Q.2d at 1536.

[281] Id. at 356, 62 U.S.P.Q.2d at 1536.

[282] Eppendorf, 289 F.3d at 357, 62 U.S.P.Q.2d at 1537.

[283] Id. at 358, 62 U.S.P.Q.2d at 1538.

[284] 280 F.3d 619, 61 U.S.P.Q.2d (BNA) 1769 (6th Cir. 2002).

[285] Abercrombie & Fitch, 280 F.3d at 624, 61 U.S.P.Q.2d at 1770.

[286] Id.

[287] Id. at 648, 61 U.S.P.Q.2d at 1788-89.

[288] Id.

[289] Id. at 630-31, 61 U.S.P.Q.2d at 1775.

[290] Id. at 635, 639, 61 U.S.P.Q.2d at 1779, 1781.

[291] Abercrombie & Fitch, 280 F.3d at 641, 61 U.S.P.Q.2d at 1783.

[292] Id. at 644-45, 61 U.S.P.Q.2d at 1785-86.

[293] Id. at 647, 61 U.S.P.Q.2d at 1788.

[294] Id. at 648, 61 U.S.P.Q.2d at 1788.

[295] Id. at 646-47, 61 U.S.P.Q.2d at 1787-88.

[296] Id. at 648, 61 U.S.P.Q.2d at 1788.

[297] 295 F.3d 641, 63 U.S.P.Q.2d (BNA) 1735 (6th Cir. 2002).

[298] Gray, 295 F.3d at 641-42, 63 U.S.P.Q.2d at 1735.

[299] Id. at 644, 63 U.S.P.Q.2d at 1736.

[300] Id.

[301] Id. The court noted that "Chicago Style" is a common label in the industry referring to a mixture of caramel, butter, and cheese popcorn. Id. at n.1.

[302] Id. at 645, 63 U.S.P.Q.2d at 1737.

[303] Id. at 646-47, 63 U.S.P.Q.2d at 1738.

[304] Gray, 295 F.3d at 648, 63 U.S.P.Q.2d at 1739.

[305] Id. at 650, 63 U.S.P.Q.2d at 1741.

[306] Id. at 651, 63 U.S.P.Q.2d at 1741.

[307] Id., 63 U.S.P.Q.2d at 1741-42.

[308] 296 F.3d 778, 63 U.S.P.Q.2d (BNA) 1587 (9th Cir. 2002).

[309] Tie Tech, 296 F.3d at 778, 63 U.S.P.Q.2d at 1587.

[310] Id. at 781, 63 U.S.P.Q.2d at 1587.

[311] Id., 63 U.S.P.Q.2d at 1588.

[312] Id.

[313] Id.

[314] Tie Tech, 296 F.3d at 781-82, 63 U.S.P.Q.2d at 1588.

[315] Id. at 783, 63 U.S.P.Q.2d at 1589.

[316] Id. at 786, 63 U.S.P.Q.2d at 1592.

[317] Id. at 783-84, 63 U.S.P.Q.2d at 1590.

[318] 211 F. Supp. 2d 23 (D.D.C. 2002).

[319] HIAA, 211 F. Supp. 2d at 23.

[320] Id. at 25.

[321] Id. at 26.

[322] Id.

[323] Id. at 27.

[324] Id.

[325] HIAA, 211 F. Supp. 2d at 27.

[326] Id. at 30.

[327] Id. at 30-31.

[328] Id. at 31.

[329] Id.

[330] Id. at 31-32.

[331] HIAA, 211 F. Supp. 2d at 29.

[332] See generally Anticybersquatting Consumer Protection Act, Pub. L. No. 106-113, §§3001-10, 113 Stat. 1501A-545, 1501A-545 to 1501A-552 (1999) (codified as amended in scattered section of 15 U.S.C. (1994 & Supp. 1999)) [hereinafter ACPA].

[333] 289 F.3d 865, 62 U.S.P.Q.2d (BNA) 1905 (6th Cir. 2002).

[334] Bird, 289 F.3d at 870, 62 U.S.P.Q.2d at 1908.

[335] Id. at 869-70, 62 U.S.P.Q.2d at 1907-08.

[336] Id. at 870-71, 62 U.S.P.Q.2d at 1908.

[337] (2000).

[338] Id. at 878-79, 62 U.S.P.Q.2d at 1914; (2000).

[339] 989 F. Supp. 1276, 45 U.S.P.Q.2d (BNA) 1463 (C.D. Cal. 1997).

[340] Bird, 289 F.3d at 877-78, 62 U.S.P.Q.2d at 1913-14; 985 F. Supp. 949, 44 U.S.P.Q.2d (BNA) 1865 (C.D. Cal. 1997).

[341] Bird, 289 F.3d at 877-79, 62 U.S.P.Q.2d at 1914.

[342] Id. at 878, 62 U.S.P.Q.2d at 1914.

[343] Id.

[344] Id. at 880, 62 U.S.P.Q.2d at 1915; (2000).

[345] Id. at 879, 62 U.S.P.Q.2d at 1915.

[346] Id.

[347] Bird, 289 F.3d at 881, 62 U.S.P.Q.2d at 1916.

[348] Id.

[349] Id.

[350] Id.

[351] Id.

[352] Id.

[353] 302 F.3d 248, 64 U.S.P.Q.2d (BNA) 1248 (4th Cir. 2002).

[354] Id. at 251-52, 64 U.S.P.Q.2d at 1249-50.

[355] (1948).

[356] Porsche Cars. 302 F.3d at 252, 64 U.S.P.Q.2d at 1249-50.

[357] Id., 64 U.S.P.Q.2d at 1250.

[358] Id. at 253, 64 U.S.P.Q.2d at 1250.

[359] Id. at 253-54, 64 U.S.P.Q.2d at 1251.

[360] Id. at 254, 64 U.S.P.Q.2d at 1251.

[361] Id. at 254, 64 U.S.P.Q.2d at 1251.

[362] Porsche Cars at 255, 64 U.S.P.Q.2d at 1252.

[363] Id. at 255-56, 64 U.S.P.Q.2d at 1252.

[364] Id. at 256, 64 U.S.P.Q.2d at 1252-53.

[365] Id., 64 U.S.P.Q.2d at 1253 (emphasis in original).

[366] Id. at 256-257, 64 U.S.P.Q.2d at 1253.

[367] Porche Cars, 302 F.3d at 258, 64 U.S.P.Q.2d at 1254.

[368] Id. at 257-58, 64 U.S.P.Q.2d at 1253-54.

[369] Id. at 258, 64 U.S.P.Q.2d at 1254.

[370] Id. at 258-59, 64 U.S.P.Q.2d at 1254-55.

[371] 433 U.S. 186 (1977).

[372] Porsche Cars, 302 F.3d at 259-60, 64 U.S.P.Q.2d at 1255.

[373] Id. at 260, 64 U.S.P.Q.2d at 1256.

[374] Id. at 261, 64 U.S.P.Q.2d at 1256.

[375] Id. at 261-62, 64 U.S.P.Q.2d at 1256-57.

[376] 302 F.3d 214, 64 U.S.P.Q.2d (BNA) 1225 (4th Cir. 2002).

[377] Harrods Ltd., 302 F.3d at 223, 64 U.S.P.Q.2d at 1229.

[378] Id. at 219-20, 64 U.S.P.Q.2d at 1226.

[379] Id. at 219, 64 U.S.P.Q.2d at 1226.

[380] Id. at 221, 64 U.S.P.Q.2d at 1228.

[381] Id. at 223, 64 U.S.P.Q.2d at 1229.

[382] Id.

[383] Harrods Ltd., 302 F.3d at 224, 64 U.S.P.Q.2d at 1229-30.

[384] Id. at 224-25, 64 U.S.P.Q.2d at 1230-31.

[385] Id. at 225-26, 64 U.S.P.Q.2d at 1230-31 (quoting Grogan v. Garner, 498 U.S. 279, 286 (1991)).

[386] Id. at 227, 64 U.S.P.Q.2d at 1232.

[387] 459 U.S. 375 (1983).

[388] Harrods Ltd., 302 F.3d at 226-27, 64 U.S.P.Q.2d at 1231-32.

[389] Id. at 227, 64 U.S.P.Q.2d at 1232.

[390] Id. at 228, 64 U.S.P.Q.2d at 1233.

[391] Id.

[392] Id.

[393] Id. at 228-29, 64 U.S.P.Q.2d at 1233-34.

[394] Harrods Ltd., 302 F.3d at 230-31, 64 U.S.P.Q.2d at 1234-35.

[395] Id. at 231, 64 U.S.P.Q.2d at 1235.

[396] Id. at 232, 64 U.S.P.Q.2d at 1236.

[397] Id.

[398] 231 F. Supp. 2d 977 (C.D. Cal. 2002).

[399] Nissan Motor, 231 F. Supp. 2d at 978.

[400] Id.

[401] Id. at 979.

[402] Id. at 978.

[403] Id. at 979.

[404] Id. at 980-81.

[405] Nissan Motor, 231 F. Supp. 2d at 980.

[406] 29 F. Supp. 2d 1161, 50 U.S.P.Q.2d (BNA) 1840 (C.D. Cal. 1998) (dealing with the website "ballysucks.com").

[407] 177 F. Supp. 2d 661, 61 U.S.P.Q.2d (BNA) 1757 (E.D. Mich. 2001) (discussing the website "fuckgeneralmotors.com").

[408] Nissan Motor, 231 F. Supp. 2d at 980.

[409] Id.

[410] Id.

[411] Id. at 981.

[412] 305 F.3d 397, 64 U.S.P.Q.2d (BNA) 1761 (6th Cir. 2002).

[413] Nartron, 305 F.3d at 402, 64 U.S.P.Q.2d at 1763.

[414] Id. at 401, 64 U.S.P.Q.2d at 1762.

[415] Id.

[416] Id. at 403, 64 U.S.P.Q.2d at 1764.

[417] Id. at 405, 64 U.S.P.Q.2d at 1765.

[418] Id. at 408, 64 U.S.P.Q.2d at 1768.

[419] Nartron, 305 F.3d at 410, 64 U.S.P.Q.2d at 1769.

[420] Id. at 408, 64 U.S.P.Q.2d at 1768.

[421] Id.

[422] Id.

[423] Id. at 409, 64 U.S.P.Q.2d at 1769.

[424] Id. at 412, 64 U.S.P.Q.2d at 1771.

[425] Nartron, 305 F.3d at 412, 64 U.S.P.Q.2d at 1771.

[426] Id.

[427] Id. at 413, 64 U.S.P.Q.2d at 1772.

[428] 314 F.3d 62, 65 U.S.P.Q.2d (BNA) 1195 (2d Cir. 2002).

[429] Profitness, 314 F.3d at 65, 65 U.S.P.Q.2d at 1196.

[430] Id.

[431] Id.

[432] Id. at 65-66, 65 U.S.P.Q.2d at 1197

[433] Id. at 66, 65 U.S.P.Q.2d at 1197.

[434] Id.

[435] Profitness, 314 F.3d at 66, 65 U.S.P.Q.2d at 1197.

[436] Id.

[437] Id.

[438] Id.

[439] Id. at 69, 65 U.S.P.Q.2d at 1199.

[440] Id.

[441] Profitness, 314 F.3d at 69, 65 U.S.P.Q.2d at 1199.

[442] Id.

[443] Id. at 70, 65 U.S.P.Q.2d at 1200.

[444] Id.

[445] Id. at 71, 65 U.S.P.Q.2d at 1201.

[446] 304 F.3d 1167, 64 U.S.P.Q.2d (BNA) 1353 (11th Cir. 2002).

[447] Cumulus Media, 304 F.3d at 1169, 64 U.S.P.Q.2d at 1354.

[448] Id.

[449] Id. at 1169, 64 U.S.P.Q.2d at 1354-55.

[450] Id., 64 U.S.P.Q.2d at 1355.

[451] Id.

[452] Id. at 1170, 64 U.S.P.Q.2d at 1355.

[453] Cumulus Media, 304 F.3d at 1170, 64 U.S.P.Q.2d at 1355-56.

[454] Id. at 1175 n.10, 64 U.S.P.Q.2d at 1359 n.10.

[455] Id.

[456] 756 F.2d 1525, 225 U.S.P.Q. (BNA) 1131 (11th Cir. 1985).

[457] Cumulus Media, 304 F.3d at 1175, 64 U.S.P.Q.2d at 1359-60.

[458] Id. at 1175, 64 U.S.P.Q.2d at 1359.

[459] Id. at 1176-77, 64 U.S.P.Q.2d at 1360.

[460] Id. at 1177, 64 U.S.P.Q.2d at 1361.

[461] Id. at 1179, 64 U.S.P.Q.2d at 1362.

[462] 303 F.3d 1242, 64 U.S.P.Q.2d (BNA) 1212 (11th Cir. 2002).

[463] Id.at 1244, 64 U.S.P.Q.2d at 1214.

[464] Id.

[465] Id.

[466] Id.

[467] Id. at 1245, 64 U.S.P.Q.2d at 1214.

[468] Int'l Cosmetics, 303 F.3d at 1245, 64 U.S.P.Q.2d at 1214..

[469] Id.

[470] Id.

[471] Id.

[472] Id. at 1245, 64 U.S.P.Q.2d at 1215.

[473] Id.

[474] Int'l Cosmetics, 303 F.3d at 1245-46, 64 U.S.P.Q.2d at 1215.

[475] Id.at 1246, 64 U.S.P.Q.2d at 1215.

[476] Id. at 1246, 64 U.S.P.Q.2d at 1216.

[477] Id.

[478] Id. at 1248, 64 U.S.P.Q.2d at 1217.

[479] Id.

[480] Int'l Cosmetics, 303 F.3d at 1248, 64 U.S.P.Q.2d at 1217.

[481] Id. at 1249, 64 U.S.P.Q.2d at 1217.

[482] 289 F.3d 589, 62 U.S.P.Q. 2d (BNA) 1673 (9th Cir. 2002).

[483] Id. at 591, 62 U.S.P.Q.2d at 1674.

[484] Id. at 592, 62 U.S.P.Q.2d at 1674.

[485] Id., 62 U.S.P.Q.2d at 1674-75.

[486] Id. at 593, 62 U.S.P.Q.2d at 1675.

[487] Id.

[488] Barcamerica, 289 F.3d at 597, 62 U.S.P.Q.2d at 1678.

[489] Id. at 597-98, 62 U.S.P.Q.2d at 1679.

[490] Id. at 596-97, 62 U.S.P.Q.2d at 1678.

[491] Id. at 597-98, 62 U.S.P.Q.2d at 1679.

[492] Id. at 598, 62 U.S.P.Q.2d at 1679.

[493] Id.

[494] 294 F.3d 383, 63 U.S.P.Q.2d (BNA) 1417 (2d Cir. 2002).

495 Times Mirror, 294 F.3d at 391-92, 63 U.S.P.Q.2d at 1422-23.

496 Id. at 384, 63 U.S.P.Q.2d at 1418.

497 Id. at 384-85, 63 U.S.P.Q.2d at 1418.

498 Id. at 385, 63 U.S.P.Q.2d at 1418.

499 Id.at 385-88, 63 U.S.P.Q.2d at 1418-20.

500 Id. at 388, 63 U.S.P.Q.2d at 1420.

501 Times Mirror, 294 F.3d at 388, 63 U.S.P.Q.2d at 1420.

502 Id. at 390, 63 U.S.P.Q.2d at 1422.

503 Id., 63 U.S.P.Q.2d at 1423.

504 Id. at 391, 63 U.S.P.Q.2d at 1423.

505 Id.

506 Id.

507 Times Mirror, 294 F.3d at 392-95, 63 U.S.P.Q.2d at 1424-26.

508 Id. at 396, 63 U.S.P.Q.2d at 1427.

509 305 F.3d 1369, 64 U.S.P.Q.2d (BNA) 1650 (Fed. Cir. 2002).

510 Thompson, 305 F.3d at 1372, 64 U.S.P.Q.2d at 1652.

511 Id. at 1373, 64 U.S.P.Q.2d at 1652.

512 Id.

513 Id.

514 Id.

[515] Id.

[516] Thompson, 305 F.3d at 1373, 64 U.S.P.Q.2d at 1652.

[517] Id. at 1374, 64 U.S.P.Q.2d at 1653.

[518] Id.

[519] Id. at 1380, 64 U.S.P.Q.2d at 1658.

[520] Id.

[521] (2000).

[522] Thompson, 305 F.3d at 1380, 64 U.S.P.Q.2d at 1658.

[523] Id.

[524] Id.

[525] Id. at 1381, 64 U.S.P.Q.2d at 1658.

[526] Id., 64 U.S.P.Q.2d at 1659.

[527] Id. at 1382, 64 U.S.P.Q.2d at 1659-60.

[528] 282 F.3d 23, 61 U.S.P.Q.2d (BNA) 1865 (1st Cir. 2002). The authors note their firm's involvement as counsel for plaintiff (Tamko) in this case.

[529] Tamko Roofing, 282 F.3d at 36, 61 U.S.P.Q.2d at 1877.

[530] Id. at 27, 61 U.S.P.Q.2d at 1866.

[531] Id.

[532] Id. at 28, 61 U.S.P.Q.2d at 1867.

[533] Id.

[534] Id.

535 Tamko Roofing, 282 F.3d at 29, 61 U.S.P.Q.2d at 1867.

536 Id., 61 U.S.P.Q.2d at 1868.

537 Id. at 30, 61 U.S.P.Q.2d at 1868.

538 Id. at 32, 61 U.S.P.Q.2d at 1870.

539 Id.

540 Id. at 38, 61 U.S.P.Q.2d at 1871.

541 Tamko Roofing, 282 F.3d at 38, 61 U.S.P.Q.2d at 1872.

542 Tamko Roofing Prods.,Inc. v. Ideal RoofingCo., Ltd., 294 F.3d 227, 63 U.S.P.Q.2d (BNA) 1538 (1st Cir. 2002) [hereinafter Tamko Roofing II].

543 Tamko Roofing II, 294 F.3d at 227, 63 U.S.P.Q.2d at 1539.

544 Id.

545 Id. at 228, 63 U.S.P.Q.2d at 1540.

546 313 F.3d 338, 65 U.S.P.Q.2d (BNA) 1130 (5th Cir. 2002).

547 Quick Technologies, 313 F.3d at 342, 65 U.S.P.Q.2d at 1131.

548 Id.

549 Id.

550 Id.

551 Id.

552 Id.

553 Quick Technologies., 313 F.3d at 342, 65 U.S.P.Q.2d at 1132.

[554] Id.

[555] Id. at 343, 65 U.S.P.Q.2d at 1132.

[556] Id.

[557] Id. at 343-45, 65 U.S.P.Q.2d at 1132-34.

[558] Id. at 343, 346-50, 65 U.S.P.Q.2d at 1132, 1134-38.

[559] Quick Tech., 313 F.3d at 349, 65 U.S.P.Q.2d at 1137 (footnote omitted).

[560] Id. at 348-50, 65 U.S.P.Q.2d at 1136-38.

[561] Id. at 347-50, 65 U.S.P.Q.2d at 1135-37.

[562] 155 F.3d 526, 554 (5th Cir. 1998).

[563] Quick Tech., 313 F.3d at 350, 65 U.S.P.Q.2d at 1137-38.

[564] Id.

[565] Id., 65 U.S.P.Q.2d at 1138.

[566] 287 F.3d 242, 62 U.S.P.Q.2d (BNA) 1529 (2d Cir. 2002).

[567] R.C. Bigelow, 287 F.3d at 243-44, 62 U.S.P.Q.2d 1529-30.

[568] Id. at 244, 62 U.S.P.Q.2d at 1530.

[569] Id.

[570] Id.

[571] Id. at 244-45, 62 U.S.P.Q.2d at 1530.

[572] Id. at 244, 62 U.S.P.Q.2d at 1530.

[573] R.C. Bigelow, 287 F.3d at 245, 62 U.S.P.Q.2d at 1531.

[574] Id. at 245-46, 62 U.S.P.Q.2d at 1530.

[575] Id. at 247, 62 U.S.P.Q.2d at 1532.

[576] Id. at 246-47, 62 U.S.P.Q.2d at 1531-32.

[577] Id. at 247-49, 62 U.S.P.Q.2d at 1532-33.

[578] 278 F.3d 523, 61 U.S.P.Q.2d (BNA) 1460 (5th Cir. 2002).

[579] Waco Int'l, 278 F.3d at 531, 61 U.S.P.Q.2d at 1466.

[580] Id. at 526, 61 U.S.P.Q.2d at 1462.

[581] Id.

[582] Id.

[583] Id.

[584] Id.

[585] Waco Int'l, 278 F.3d at 526, 61 U.S.P.Q.2d at 1462.

[586] Id. at 536, 61 U.S.P.Q.2d at 1470.

[587] Id. at 527, 61 U.S.P.Q.2d at 1462; (2000).

[588] Id., 61 U.S.P.Q.2d at 1462-63.

[589] Id., 61 U.S.P.Q.2d at 1463; (2000).

[590] Id.

[591] Waco Int'l, 278 F.3d at 527, 61 U.S.P.Q.2d at 1463.

[592] Id.at 528, 61 U.S.P.Q.2d at 1463.

[593] Id., 61 U.S.P.Q.2d at 1463-64.

594 Id. at 531-32, 61 U.S.P.Q.2d at 1466.

595 Id. at 531, 61 U.S.P.Q.2d at 1466 (emphasis in original).

596 Id. at 532, 61 U.S.P.Q.2d at 1466-67.

597 See generally Madrid Protocol Implementation Act, Pub. L. 107-273, § 10401-03, 116 Stat. 1920 (2002) (codified as amended in scattered section of 15 U.S.C. (Supp. 2002) [hereinafter Madrid Protocol]; 15 U.S.C. §1141 (Supp. 2003).

598 See generally Protocol Relating to Madrid Agreement Concerning International Registration of Marks, June 27, 1989, S. Treaty Doc. No. 106-41.

599 See 15 U.S.C. §1141(b) (2000).

600 Id.

601 See id. §1141(h).

602 Id.

603 189 F. Supp. 2d 367, 63 U.S.P.Q.2d (BNA) 1189 (E.D. Va. 2002).

604 Barcelona.com, 189 F. Supp. 2d at 373-74, 63 U.S.P.Q.2d at 1193-94.

605 Id. at 369, 63 U.S.P.Q.2d at 1190.

606 Id.

607 Id. at 370-71, 63 U.S.P.Q.2d at 1190-91.

608 Id.

609 Barcelona.com, 189 F. Supp. 2d at 370, 63 U.S.P.Q.2d at 1191.

610 Id. at 371, 63 U.S.P.Q.2d at 1191.

611 Id.

612 Parisi v. Netlearning,Inc., 139 F. Supp. 2d 745, 59 U.S.P.Q.2d (BNA) 1051 (E.D. Va. 2001).

613 Barcelona.com, 189 F. Supp. 2d at 371, 63 U.S.P.Q.2d at 1192.

[614] Id.

[615] Id. at 371, 63 U.S.P.Q.2d at 1192.

[616] Id. at 373, 63 U.S.P.Q.2d at 1193.

[617] Id., 63 U.S.P.Q.2d at 1194.

[618] Id.

[619] Id. at 374-77, 63 U.S.P.Q.2d at 1194-96.

[620] Barcelona.com, 189 F. Supp. 2d at 377, 63 U.S.P.Q.2d at 1196. See also 15 U.S.C. §1125(d)(1)(B) (2000).

[621] 284 F.3d 1007, 62 U.S.P.Q.2d (BNA) 1161 (9th Cir. 2002)

[622] Rio Properties, 284 F.3d at 1012, 62 U.S.P.Q.2d at 1162.

[623] Id.

[624] Id.

[625] Id. at 1012-13, 62 U.S.P.Q.2d at 1162.

[626] Id. at 1013, 62 U.S.P.Q.2d at 1162.

[627] Id.

[628] Rio Properties, 284 F.3d at 1013, 62 U.S.P.Q.2d at 1162-63.

[629] Id., 62 U.S.P.Q.2d at 1163.

[630] Id.

[631] Id. at 1012, 62 U.S.P.Q.2d at 1162.

[632] Id. at 1014, 62 U.S.P.Q.2d at 1163-64.

633 Id. at 1014-16, 62 U.S.P.Q.2d at 1164-65.

634 Rio Properties, 284 F.3d at 1016-17, 62 U.S.P.Q.2d at 1165-66.

635 Id. at 1017, 62 U.S.P.Q.2d at 1165.

636 Id.

637 Id. at 1017-19, 62 U.S.P.Q.2d at 1165-67.

638 Id. at 1017, 62 U.S.P.Q.2d at 1166.

639 Id.

640 No. 99-1454, 1999 U.S. Dist. LEXIS 11510 (E.D. Pa. July 29, 1999).

641 Rio Properties, 284 F.3d at 1018-19, 62 U.S.P.Q.2d at 1166-67.

642 Id. at 1019-21, 62 U.S.P.Q.2d at 1167-69.

643 Id. at 1021-22, 62 U.S.P.Q.2d at 1169-70.

644 No. 00-9094, 2002 U.S. App. LEXIS 26473 (2d Cir. Dec. 23, 2002).

645 (2000).

646 Fashion Boutique, 2002 U.S. App. LEXIS 26473, at *2.

647 Id. at *4.

648 859 F. Supp. 1521, 1535-36 (S.D.N.Y. 1994).

649 Fashion Boutique, 2002 U.S. App. LEXIS 26473, at *4-9.

650 Id. at *12. The court specifically cited cases in which the Fifth, Ninth, and Tenth Circuits adopted the test. Id. at *13.

651 Id. at *12-13 (citing Gordon & Breach, 859 F. Supp. at 1535-36).

652 Id. at *18.

[653] Id.

[654] Id. at *17-19.

[655] Id. at *19.

[656] Fashion Boutique, 2002 U.S. App. LEXIS 26473, at *31.

[657] Nos. 02-1738, 02-1739, 02-1775, 2002 U.S. App. LEXIS 26475 (4th Cir. Dec. 23, 2002).

[658] Scotts, 2002 U.S. App. LEXIS 26475, at *1.

[659] Id. at *2.

[660] Id. at *2-5.

[661] Id. at *6-7.

[662] Id. at *7-8.

[663] Id. at *15.

[664] Scotts, 2002 U.S. App. LEXIS 26475, at *16-23.

[665] Id. at *23-24.

[666] Id. at *23-28.

[667] Id. at *28-29.

[668] Id. at *31.

[669] Id. at *47-48.

[670] Scotts, 2002 U.S. App. LEXIS 26475, at *48-50.

[671] Id. at *50-52.

[672] Id. at *52-54.