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Recent Development

RECENT DEVELOPMENTS IN TRADEMARK LAW

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This article reviews noteworthy trademark and unfair competition decisions reported in The United States Patent Quarterly, Second Edition, Volume 43, Number 9 (September 8, 1997) through Volume 44, Number 8 (November 24, 1997).

I. Jurisdiction

A. Standing: *Nordco A.S. v. Ledes*¹

In *Nordco*, the United States District Court of the Southern District of New York granted the defendant's motion for summary judgment because the plaintiff failed to produce evidence showing ownership and commercial interest in the trademark at issue.² “[O]nly the registrant of a trademark and its legal representatives, predecessors, successors[,] and assigns have standing to bring a [Section] 32 action” under the Lanham Act for trademark infringement.³ Similarly, “at a minimum,

standing to bring a claim [of unfair competition] requires the potential for a commercial or competitive injury.”⁴ Because of the convoluted history of ownership of the BOXING ILLUSTRATED mark at issue and because of the lack of documentation from the plaintiff to support its assertions that it owned and had a commercial interest in the mark, the plaintiff had not satisfied the requirements for standing to bring a trademark and unfair competition claim.⁵

B. Case or Controversy: *Kosmeo Cosmetics, Inc. v. Lancome Parfums et Beaute & Cie.*⁶

The plaintiff filed a declaratory judgment action seeking a declaration of noninfringement.⁷ The plaintiff had filed a trademark application that the *242 defendant had opposed.⁸ The issue was whether a case or controversy existed at the time the declaratory judgment action was filed.⁹

The plaintiff filed its declaratory judgment action after the opposition had been filed, but later withdrew its trademark application.¹⁰ The court found that an opposition proceeding “cannot serve as the basis for reasonable apprehension of an infringement suit.”¹¹ Otherwise, the administrative process would be short-circuited.¹²

The plaintiff also sought to rely on letters written after the suit was filed.¹³ The court dismissed these letters because these later events could not create jurisdiction where none existed at the time of filing the suit.¹⁴

C. Internet Personal Jurisdiction: *Bensusan Restaurant Corp. v. King*¹⁵

Although recognizing “that attempting to apply established trademark law in the fast-developing world of the [I]nternet is somewhat like trying to board a moving bus,”¹⁶ the Second Circuit in *Bensusan* applied the New York long-arm statutes to affirm the district court’s dismissal for lack of personal jurisdiction.¹⁷ In this case, both the plaintiff, Bensusan, and the defendant, Richard B. King, used the mark THE BLUE NOTE to identify their respective live entertainment clubs, although the plaintiff’s club was located in New York City and the defendant’s club was located in Columbia, Missouri.¹⁸ Although the plaintiff had earlier demanded that King cease using THE BLUE NOTE mark, this action arose after King created a Web site (or cyberspot) on *243 the Internet to promote his own club.¹⁹ As a result, the plaintiff sued for trademark infringement, trademark dilution, and unfair competition.²⁰

Applying the two personal jurisdiction provisions of New York which deal with tortious acts committed by non-domiciliaries, the court found no personal jurisdiction.²¹ The first provision states that a New York court may exercise personal jurisdiction over a non-domiciliary who “in person or through an agent ... commits a tortious act within the state.”²² The Second Circuit noted that the New York courts have interpreted this provision to require literally the physical presence of the person in the state at the time of the tort.²³ Because the Web site using THE BLUE NOTE was created by a person physically located in Missouri, the court found no personal jurisdiction under this provision.²⁴

The second provision states that a New York court may exercise personal jurisdiction over non-domiciliaries committing tortious acts outside of New York that harm people or property in New York and who expect “or should reasonably expect the [tortious] act to have consequences in the state and [[[who] derive[] substantial revenue from interstate commerce.”²⁵ Because the defendant’s business was of a local character and did not derive substantial revenues from interstate commerce, the Second Circuit also found no personal jurisdiction under this provision.²⁶ From this result, it appears that the Second Circuit will apply the personal jurisdiction requirements very strictly when dealing with Internet-related actions.

D. Internet Personal Jurisdiction: *Haelan Products Inc. v. Beso Biological Research Inc.*²⁷

In *Haelan*, the United States District Court of the Eastern District of Louisiana also considered the issues of personal jurisdiction and venue as they *244 apply to trademark infringement and unfair competition involving advertisement through the Internet. In particular, the defendant, Beso, was a Kansas corporation with its principal place of business in California.²⁸ Its only contacts with the forum state of Louisiana were that it advertised nationally, maintained a national toll-free phone number, unknowingly had its products advertised on an Internet Web site for which it did not pay, and made four isolated sales in the state during the previous two years.²⁹ The court found that these contacts were sufficient to meet due process considerations in establishing personal jurisdiction and appropriate venue.³⁰

Specifically, the court found that each of these contacts with the state of Louisiana would be insufficient to establish

jurisdiction individually, but the combination of the four indicated that Beso had attempted to attract customers nationally and therefore met the due process requirement of systematic and continuous contacts with the forum state.³¹ Furthermore, traditional notions of fair play and justice were met in this jurisdiction because Beso's contacts with the state indicated that it was reasonably foreseeable that a Louisiana corporation, such as the plaintiff, could be injured by an infringement of its trademark and also because the interests of the plaintiff, the forum state, and other states would all be served by establishing personal jurisdiction.³² Finally, venue was deemed appropriate because Beso was legally deemed a resident of the state once personal jurisdiction was established³³ and because the balance of conveniences supported a Louisiana venue.³⁴

Regarding the general question of personal jurisdiction in cases involving the Internet, the court chose to limit its holding, rejecting the view that advertising on a global network automatically confers personal jurisdiction.³⁵ In making this determination, the court considered two typical positions.³⁶ At one extreme is the argument that because "modern technology has made nationwide commercial transactions simpler and more feasible, ... it *245 must broaden correspondingly the permissible scope of jurisdiction exercisable by the courts."³⁷ The counterargument is that allowing personal jurisdiction in all such cases would be inappropriate because it "would be tantamount to a declaration that this Court, and every other court throughout the world may assert jurisdiction over all information providers on the global World Wide Web."³⁸ The court chose to adopt the latter position by requiring additional evidence showing contacts with the forum other than by simply advertising on the Internet.³⁹

E. Purposeful Availment: *No Touch North America v. Blue Coral Inc.*⁴⁰

No Touch involved a question of personal jurisdiction and venue after the defendant had accepted an assignment of the TOUCHLESS ACRYLIC mark during the pendency of litigation.⁴¹ The court concluded that personal jurisdiction was appropriate in California because the defendant had purposefully availed itself of the forum by accepting the assignment of the trademark at the heart of the litigation while aware that the litigation was pending in this California district.⁴² Furthermore, the fair play and substantial justice requirement was met because the defendant was accepting benefits from the assignor's continued sales of products bearing this trademark in California.⁴³ Finally, the convenience of the parties also supported maintaining venue in California because the defendant intentionally stepped into this lawsuit by accepting the assignment and the associated responsibilities.⁴⁴

***246 II. Infringement**

A. Likelihood of Confusion: *Time, Inc. v. Petersen Publishing Co.*⁴⁵

A preliminary injunction was requested by Petersen, the publisher of 'TEEN magazine, to prevent further use by Time of the name "Teen People." Because of the weak nature of the 'TEEN mark, the plaintiff did not establish a likelihood of success on the merits sufficient to justify a preliminary injunction.⁴⁶

The court, noting that the word "teen" was generic, held that the plaintiff's use of its 'TEEN mark in distinctive upper case block letters with the apostrophe could not prevent the use of the generic term "teen" by others in describing magazines targeted at teenagers.⁴⁷ The court found that the mark 'TEEN lacked sufficient strength and thus denied the injunction.⁴⁸ Nevertheless, the court addressed other factors of the likelihood of confusion analysis. It noted that "Teen People" would use the same trademark as *People* magazine and that the word "teen" would be in smaller print.⁴⁹ It also noted that the magazine stated that it was published by the publishers of *People* magazine.⁵⁰

In an attempt to show likelihood of confusion, the plaintiff submitted a survey, but the court rejected the survey because it failed to show confusion regarding the publishers of the two magazines.⁵¹ There was a small amount of confusion present when people were asked whether they thought 'TEEN and TEEN PEOPLE were associated or connected; however, the court noted that the study did not address the issue of whether TEEN PEOPLE was more likely to be associated with *People* magazine or with 'TEEN magazine.⁵² Thus, the survey evidence did not support a likelihood of confusion with the plaintiff's product.

***247 B. Likelihood of Confusion/Fair Use: *Cosmetically Sealed Industries, Inc. v. Chesebrough-Pond's USA Co.*⁵³**

The focus of this case was the fair use defense as applied to the mark SEALED WITH A KISS.⁵⁴ The plaintiff had federally registered this mark and used it to identify a lip gloss product designed for prolonged wear.⁵⁵ The defendant, on the other hand, launched a promotional campaign for a new long-wearing lipstick called CUTEX COLOR SPLASH wherein the campaign utilized a display holding trial-sized lipsticks and complimentary postcards, and encouraged consumers to imprint a lipstick “kiss” on the postcard and send it to a loved one.⁵⁶ This campaign was described by the phrase “Seal it with a Kiss!!”⁵⁷ The plaintiff alleged this promotional campaign was trademark infringement while the defendant argued against liability based on the defense of fair use.⁵⁸

The court explained that the fair use defense applies when a name or term is used “to describe the goods.”⁵⁹ The court noted that “we have recognized that the phrase [to describe the goods] permits use of words or images that are used ... in their ‘descriptive sense.’”⁶⁰ Applying this expanded interpretation, the court determined that the phrase at issue was clearly used in a non-trademark descriptive sense because it simply instructed the consumer “to seal by kissing the complimentary postcard to signify the amorous sentiment conveyed to the recipient of the card.”⁶¹ Also determinative was the fact that the defendant clearly identified its product using its own protected marks on the display.⁶² Finally, the court held that choosing a common phrase as a mark forced the plaintiff to accept the inherent risk that others would use widely this well known descriptive phrase in a fair use descriptive sense.⁶³

***248 C. Genericness: *Genesee Brewing Co. v. Stroh Brewing Co.*⁶⁴**

The Second Circuit in *Genesee* was required to explore the world of brewing and its traditional categories of lagers and ales. At issue was the right to use the term HONEY BROWN as the plaintiff and the defendant both labeled their lager products HONEY BROWN.⁶⁵ The plaintiff, Genesee, attempted to protect its substantial success in marketing its product under this term by requesting a preliminary injunction against Stroh for trademark infringement and unfair competition.⁶⁶

The court’s initial analysis concentrated on the potential trademark infringement. The court specifically adopted a test to determine whether a mark descriptive of the class and characteristics of a product should be considered generic for trademark purposes: “[W]hen a producer creates a new product that differs from an established product class in a particular characteristic, the law of trademark will not grant the producer the exclusive right to label its product with words that are necessary to describe that new characteristic.”⁶⁷ Applying this standard to the facts of the case, the court found that brown ales comprise a traditional category of beers and thus, Stroh’s flavoring of such a class of beers with honey required the description “honey brown ale.”⁶⁸ This required description mandated a finding of genericness to ensure that the first producer was not granted a virtual monopoly on this new class of products simply because other producers would be unable to describe their own honey-flavored brown ales.⁶⁹ As such, the court found that Genesee’s HONEY BROWN mark was generic when applied specifically to Stroh’s honey brown ale product and therefore, a preliminary injunction against Stroh was not warranted because there was no infringement.⁷⁰ On the other hand, since there is no traditional brown lager category of beers, the court withheld any determination of whether or not the HONEY BROWN mark was generic when applied to Genesee’s honey brown lager product.⁷¹

***249** The court next considered Genesee’s unfair competition claim. Although the HONEY BROWN mark was generic as applied to Stroh’s product, it was still possible that unfair competition could result if Stroh’s use of the mark did not utilize “every reasonable means to prevent confusion”⁷² as to the source of the products.⁷³ Since Stroh specifically emphasized the HONEY BROWN portion of its labeling, engaged in counter-coupon efforts to compete with Genesee, and allowed bars to replace Genesee’s product with its own without replacing or modifying the designation HONEY BROWN on their menus, the court concluded that Stroh had not taken reasonable precautions to prevent confusion.⁷⁴ However, the preliminary injunction requested by Genesee would completely forbid Stroh from using the words HONEY BROWN on its product, and thus, improperly bar Stroh from using a generic name to describe its product. As a result, the preliminary injunction was still denied because a preliminary injunction involving a generic name can only properly require the defendant to make reasonable efforts to distinguish its product and prevent consumer confusion.⁷⁵

D. Affirmative Defenses: *TMT North America, Inc. v. Magic Touch GmbH*⁷⁶

The Seventh Circuit in *TMT* clarified and reinforced trademark law regarding implied assignment, acquiescence, and abandonment. Because of the district court’s misunderstanding of the effects of these defenses on trademark infringement, the Seventh Circuit vacated and remanded the district court’s grant of a preliminary injunction against the defendant, Magic

Touch.⁷⁷

The district court's opinion mistakenly stated that the equitable defense of acquiescence could constitute an implied agreement to transfer ownership of the trademark such that the implied transferor could be enjoined from using the trademark.⁷⁸ The appellate court clarified that these two concepts must be separated. First, the court determined that there was insufficient evidence to *250 constitute an implied agreement to transfer the trademark rights completely.⁷⁹ Second, the court clarified that acquiescence is "where the trademark owner, by affirmative word or deed, conveys its implied consent [to use] to another."⁸⁰ As a result, acquiescence is at most a *defense* such that the trademark owner is deprived of a remedy for infringing uses by others, but still retains the right to use the mark.⁸¹ In contrast, the defense of abandonment can result in the trademark owner's loss of trademark rights against the world, but the law is unclear on how uncontrolled or "naked" the owner's licensing must be before abandonment has occurred.⁸² Because of this limitation to the acquiescence doctrine and the district court's failure to specify a doctrine that would adequately support its conclusion, it was inappropriate for the district court to actually enjoin Magic Touch from using its trademark.⁸³

The Seventh Circuit also addressed further complications that may occur if acquiescence results for both the senior trademark user and the junior trademark user with rights to use the trademark. If injunctive relief is denied to both parties, it is possible that "inevitable confusion" may result because of both parties' freedom to use the same mark in the same marketplace.⁸⁴ In such a scenario, it is still within the discretion of the court to completely enjoin the junior user from using the mark but "only if the junior user fails to demonstrate the availability of a feasible and effective alternative means of redressing the senior user's revived claim and vindicating the public interest in eliminating marketplace confusion, without causing undue hardship to the senior user."⁸⁵

***251 E. Presumption of Harm: *American Board of Psychiatry & Neurology, Inc. v. Johnson-Powell*⁸⁶**

The plaintiff was the owner of a certification mark for members in its organization.⁸⁷ The defendant was an expert who had testified under oath and had listed on her rsum that she was a member of the association when, in fact, she was not.⁸⁸ She repeated these claims of membership even though she was challenged in several proceedings.⁸⁹ The district court denied a preliminary injunction because the defendant had revised her rsum and had represented to the court that she would not again engage in such misstatements.⁹⁰

A denial of preliminary injunction can only be overturned if the district court had abused its discretion.⁹¹ A district court abuses its discretion if it applies an improper legal standard or incorrectly applies the law to the facts.⁹² While there is a presumption of harm to a trademark owner that shows a likelihood of success on the merits, there is no parallel presumption that just because an infringement has occurred in the past, it will inevitably continue in the future.⁹³ Voluntary reform will always suffice to prevent injunctive relief if it is demonstrated to be a total reform.⁹⁴ While past infringements may give some evidence that infringement is likely in the future, the court of appeals found that the district court did not abuse its discretion in accepting the defendant's representations.⁹⁵

***252 F. Preliminary Injunctions: *Meridian Mutual Insurance v. Meridian Insurance Group*⁹⁶**

The plaintiff owned the federally registered mark MERIDIAN when the defendant began operating a business using the mark MERIDIAN for selling insurance to companies with twenty to a thousand employees.⁹⁷ The Seventh Circuit reversed the denial of a preliminary injunction.⁹⁸

The district court's determination that the marks were not similar was based largely on an analysis of how the marks appeared in writing.⁹⁹ However, the court of appeals reversed this finding because most consumers were approached verbally and did not necessarily see this writing.¹⁰⁰ As a result, the difference in the marks as used on stationery was not controlling.

Goodwill is the intangible advantage or benefit acquired by an establishment in consequence of the public patronage and encouragement it receives from constant or habitual customers.¹⁰¹ Harm to a plaintiff's goodwill can be just as damaging as harm to a plaintiff's sales.¹⁰² However, the district court improperly dismissed evidence of actual confusion of the plaintiff's policyholders who had mistakenly contacted the defendant to make claims.¹⁰³ As a result, the district court failed to consider harm to the plaintiff's goodwill and erred by focusing only on harm to the plaintiff's sales.¹⁰⁴

The defendant contended that an injunction was improper because the plaintiff failed to produce a consumer survey, noting that the plaintiff could not be excused from survey evidence because of a lack of resources.¹⁰⁵ However, the court dismissed this objection because a preliminary injunction *253 requires less proof than a permanent injunction.¹⁰⁶ Although the lack of survey evidence might have supported the denial of a permanent injunction, the plaintiff was not required at the preliminary injunction stage to offer the same proof as would be necessary for a full trial on the merits.¹⁰⁷

The court of appeals concluded that the district court must enter an injunction prohibiting the defendant from including MERIDIAN in telephone directories, Internet Web pages, billboards, broadcast advertisements, and newspaper advertisements, but the injunction could permit the defendant to continue using the name in direct solicitations within its present service area.¹⁰⁸

G. Surnames: *Rosenthal A.G. v. Rite Lite Ltd.*¹⁰⁹

Rosenthal involved a motion for summary judgment by the plaintiff, Rosenthal A.G., on its claim for trademark infringement.¹¹⁰ The plaintiff manufactured and marketed china, glassware, tableware, giftware, home furnishings, and other related goods under the federally registered ROSENTHAL mark, and had done so in the United States since 1907.¹¹¹ The defendant, Rite Lite Ltd., had sold Judaica items at wholesale since 1948, and had sold them specifically under the Rosenthal family name, “The Rosenthal Judaica Collection,” since the 1970’s.¹¹²

The first issue was the protectability of the ROSENTHAL mark. Because Rosenthal is a surname, or family name, the mark was categorized as a descriptive mark that must have secondary meaning for protection under the Lanham Act.¹¹³ The defendant, however, conceded that secondary meaning was present because of the incontestable status of the plaintiff’s federally registered mark and the long use of the mark.¹¹⁴

*254 The court then considered whether the Judaica products market would constitute a natural extension or a continuation of the plaintiff’s product lines. Although the marks at issue may not have been directly competing, the Lanham Act protects a senior trademark owner’s rights and interests in entering a related field at some future time so long as “the non-competitive products are sufficiently related that customers are likely to confuse the source of origin.”¹¹⁵ Because the plaintiff had already partially entered the Judaica market and the Judaica market is sufficiently related to the china, dinnerware, and glassware market, the court found that the plaintiff’s mark should be protected in the Judaica market.¹¹⁶

After the court concluded that there was a likelihood of confusion based on the traditional *Polaroid* test,¹¹⁷ the plaintiff’s motion for summary judgment was granted.¹¹⁸ A permanent injunction was issued to enjoin the defendant from using the name “The Rosenthal Judaica Collection” unless the name “Rosenthal” is preceded by the first name “Jacob” or “Alex” in a manner that adequately emphasizes the different sources of the products.¹¹⁹ The plaintiff was awarded full relief because “despite [the] plaintiff’s request in the complaint for monetary damages, [the] plaintiff’s primary goal was to obtain the injunctive relief granted.”¹²⁰

H. Gray Market: *In re Certain Agricultural Tractors Under 50 Power Takeoff Horsepower*¹²¹

At issue was the importation of gray market Kubota tractors. Used Kubota tractors, some bearing Japanese warning labels and some bearing no labels, were being imported for resale in the United States.¹²² The Kubota Tractor Corporation of America sought an exclusion order.¹²³

*255 In order to establish infringement by gray market goods, there must be proof of material differences between the accused imported product and the products authorized for sale in the United States.¹²⁴ The administrative law judge (ALJ) found that, for at least one tractor model, the tractors were identical with the exception of the warning labels.¹²⁵ The ALJ’s determination that the warning labels did not constitute a material difference was overruled by the Commission.¹²⁶ In the Commission’s view, the labels attached to the tractor at sale did not constitute nonphysical or after-market items, unlike replacement parts and service or operator’s manuals.¹²⁷ Thus, these labels created a material difference because the warning labels were important to the safe utilization of the equipment. In particular, the Commission noted that weekend farmers were the primary consumers of these tractors.¹²⁸ Thus, imported tractors with Japanese language labels would infringe. The Commission took pains to note that two factors must be addressed or proven to succeed: (1) importation and (2) infringement.¹²⁹

As to the remedy, the ALJ had recommended a general exclusion order.¹³⁰ However, this order still allowed importation if appropriate labels were affixed to the tractors warning the consumer that the tractor was not manufactured for sale in the United States, that service may not be available, that parts may not be available, that instruction manuals may not be available in English, and that the tractor might not meet U.S. safety requirements.¹³¹

The Commission rejected this order.¹³² The decision rested on the practicalities of this particular fact situation and did not rest on a general proposition that labels were ineffectual to prevent confusion. The Commission ignored the complainant's evidence that the labels would be ineffective to prevent confusion.¹³³ On the other hand, labels must be seen by *256 prospective purchasers at the point of sale before they can be effective.¹³⁴ Here, the Commission noted that most of these used tractors were reconditioned and the labels were often removed when the tractor was reconditioned.¹³⁵ Further, the Commission noted that the exclusion order would not be able to prevent this removal because it does not have any effect on actions occurring after importation.¹³⁶ As a result, a label was concluded to be insufficient protection against infringement to allow continued importation of the goods.

III. Trade Dress

A. Product Configuration: *Sunbeam Products, Inc. v. West Bend Co.*¹³⁷

In *Sunbeam*, the Fifth Circuit considered whether the trade dress of Sunbeam Products' mixer was worthy of protection,¹³⁸ and if so, whether it was infringed by the mixer marketed by The West Bend Co.¹³⁹ The court affirmed the preliminary injunction ordered by the district court.¹⁴⁰

The Fifth Circuit first considered whether the product configuration of Sunbeam's mixer merited trade dress protection. While the court declined to address whether a product configuration can ever be inherently distinctive, it did find that a nonfunctional product configuration can acquire secondary meaning.¹⁴¹ Sunbeam presented evidence showing that the external appearance of its mixer had not changed in over seventeen years.¹⁴² Sunbeam also showed that the other competitive mixers on the market did not even closely resemble its product.¹⁴³ Although this evidence standing alone would have been insufficient to support secondary meaning in a final judgment of trade dress infringement because of the lack of evidence that the design "has *257 come through use to be uniquely associated with a specific source," the court deemed this evidence sufficient for the lowered "substantial likelihood of success" standard for a preliminary injunction.¹⁴⁴

Next, the mixer was found to be nonfunctional. "Even if a product design incorporates certain functional features, [the Fifth Circuit] has held that 'a particular arbitrary combination of functional features, the combination of which is not itself functional, properly enjoys protection.'"¹⁴⁵ Although certain features of the mixer were named in utility patents, the court still found the "total image" and "overall appearance" of the mixer to be nonfunctional since the product configuration was not shown to be "optimal in terms of engineering, economy of manufacture, or accommodation of utilitarian function."¹⁴⁶

The defendant's further arguments regarding likelihood of confusion, public interest, and its prior attempts to comply with the preliminary injunction were dismissed by the court.¹⁴⁷ The wrongful intent of the defendant was indicated by its use of a photo of the plaintiff's product while designing its own, supporting an inference of consumer confusion.¹⁴⁸ The court also affirmed the district court's conclusions regarding the overall similarities of the products and the effects of the defendant's product labeling on consumer confusion.¹⁴⁹ Regarding public interest, a finding that trade dress protection was warranted for the product necessarily indicated that the public interest would be served by a preliminary injunction.¹⁵⁰ Finally, the "safe distance" rule supported the district court's issuance of an injunction that sweeps more broadly than the Lanham Act normally permits because the defendant had already been found liable for infringing the plaintiff's trademark rights.¹⁵¹ As a result, the district court possessed broad discretion *258 to prohibit subsequent modifications to the infringing product "that do not move a 'safe distance' away from the trademark infringement."¹⁵²

B. Product Configuration/Functionality: *Mid-America Building Products Corp. v. Richwood Building Products, Inc.*¹⁵³

The United States District Court for the Eastern District of Michigan considered whether the defendant, Richwood, unfairly competed with the plaintiff, Mid-America, by infringing the trade dress for Mid-America's patented device, which mounts an outdoor electrical socket cover or faucet to the siding of a building.¹⁵⁴ The court found no trade dress infringement because

the plaintiff failed to show that the product configuration at issue was nonfunctional and had acquired secondary meaning.¹⁵⁵

In contrast to the Fifth Circuit *Sunbeam* decision¹⁵⁶ discussed above,¹⁵⁷ the court here cited the Tenth Circuit opinion in *Vornado Air Circulation Systems v. Duracraft Corp.*¹⁵⁸ for the proposition that “product configurations which are patented as inventions may be freely marketed when the patent expires, rather than protected under two different doctrines.¹⁵⁹ ... This is so even when the configuration is nonfunctional.”¹⁶⁰ Because the configuration of the product was an inventive component of the patented invention, it was determined to be functional.¹⁶¹ The court also found that no evidence was presented showing any secondary meaning identifying the source.¹⁶²

***259 C. Product Configuration/Functionality: *Chem-Tainer Industries Inc. v. Wilkin*¹⁶³**

The court in *Chem-Tainer* refused to grant a preliminary injunction to prevent sales of the allegedly infringing products, and instead preliminarily enjoined all parties from communicating with each other or each other’s customers, distributors, and suppliers regarding any potential infringement or patent status.¹⁶⁴ This preliminary injunction was issued simply to maintain the status quo without severely harming the business interests of either side.¹⁶⁵

The parties in this case had been engaged for several years in an ongoing war of words regarding the patent and trade dress rights for various equipment used for fish bait tanks, including the pump bracket at issue.¹⁶⁶ Since the pump bracket at issue was also covered by a utility patent, the court stated that this aspect created functionality problems if the plaintiff was claiming the entire configuration of the product was nonfunctional.¹⁶⁷ The court addressed arguments by the plaintiff that *Clamp Manufacturing Co. v. Enco Manufacturing Co.*¹⁶⁸ had rejected the rule set out in *Vornado Air Circulation Systems v. Duracraft Corp.*¹⁶⁹ that “where a disputed product configuration is part of a claim in a utility patent, and the configuration is a described, significant inventive aspect of the invention ... so that without it the invention could not fairly be said to be the same invention, patent law prevents its protection as trade dress, even if the configuration is nonfunctional.”¹⁷⁰ In *Clamp*, the plaintiff’s patent had expired, but the plaintiff still claimed trademark protection for the design and name of its clamp.¹⁷¹ The Ninth Circuit noted that the case was “close” but still affirmed the lower court’s finding that the product configuration of the clamp was still protectable because it was distinctive, primarily nonfunctional, and arbitrary.¹⁷² The court in *Chem-Tainer* simply distinguished *Clamp* by stating that, unlike the *260 plaintiff in *Clamp*, Chem-Tainer had failed in its pleadings to identify specific nonfunctional elements of the pump bracket that could be protected.¹⁷³ As a result, the court found that no preliminary injunction was justified because there was no likelihood of success on the merits of the trade dress infringement claim.¹⁷⁴

D. Product Configuration/Functionality: *Leatherman Tool Group Inc. v. Cooper Industries Inc.*¹⁷⁵

This trade dress infringement case addressed the plaintiff’s motion for a preliminary injunction to protect the product configuration of a multi-function tool.¹⁷⁶

The court was primarily concerned with the question of the functionality of the tool.¹⁷⁷ Four factors were deemed relevant to the court’s consideration of functionality: 1) a utility patent application disclosing utilitarian advantages of the design sought to be protected by the trade dress; 2) the extent of advertising promoting the design’s utilitarian advantages (e.g., the “Reach” toothbrush); 3) “the availability of a ‘reasonable’ number of design alternatives”; and 4) the extent the particular design utilizes a comparatively simple or cheap method of manufacture.¹⁷⁸ The court first considered a 1980 patent application that never issued for a somewhat similar tool that disclosed the utilitarian advantages of the design.¹⁷⁹ Second, the court found that the advantages promoted in the advertising were just typical puffery used by others in the industry.¹⁸⁰ Finally, in regard to the last two factors, the court determined that *exact* interchangeability of features is not required for either design alternatives or method of manufacture alternatives.¹⁸¹ The plaintiff’s suggested alternatives were considered to be true alternatives that indicated *261 that the tool configuration and design was likely to be determined to be nonfunctional.¹⁸²

After finding that the tool was likely to be determined on the merits as nonfunctional, the court held that the product configuration of the multi-function tool was likely to demonstrate secondary meaning¹⁸³ and that there was a likelihood of confusion between the two products at issue.¹⁸⁴ Accordingly, the court granted the plaintiff’s motion for a preliminary injunction enjoining the defendant’s U.S. sales or offers for sales of its infringing tool.¹⁸⁵

E. Product Configuration/Functionality: *Marketing Displays, Inc. v. TrafFix Devices, Inc.*¹⁸⁶

The court in *Marketing Displays* denied the plaintiff's motion for summary judgment for trade dress infringement of its roadside wind-resistant traffic signs and granted the defendant's motion for summary judgment.¹⁸⁷ The court conducted standard analyses of secondary meaning of the product configuration constituting the trade dress¹⁸⁸ and of likelihood of confusion.¹⁸⁹ Finally, the court addressed the plaintiff's arguments that its product configuration was nonfunctional and therefore merited trade dress protection.¹⁹⁰

The plaintiff made three arguments allegedly supporting its position of nonfunctionality.¹⁹¹ First, it argued that the existence of two utility patents which it had vigorously enforced in the past did not disclose the nonfunctional *262 configuration now being asserted.¹⁹² However, the court rejected this position because the arguments made by the plaintiff during prior patent infringement proceedings had resulted in an injunction prohibiting a competitor's product configuration that was determined to be virtually identical to the plaintiff's product.¹⁹³ The plaintiff then argued that there were alternative competitive embodiments available.¹⁹⁴ Again, the court discounted the plaintiff's position, this time because the plaintiff failed to meet completely its burden of showing nonfunctionality in that the plaintiff neglected to show that these alternatives were adequate substitutes for the features claimed by the plaintiff as trade dress.¹⁹⁵ Finally, the court rejected the plaintiff's argument that its advertising promoted the "look" of the sign rather than the functional features.¹⁹⁶ As a result, the court found that the plaintiff's product configuration was functional as a matter of law.¹⁹⁷

IV. Registration

A. Services: *United We Stand America, Inc. v. United We Stand America, New York, Inc.*¹⁹⁸

The plaintiff, a political party initiated by Ross Perot, owned the federally registered service mark UNITED WE STAND AMERICA.¹⁹⁹ The defendant was a New York group organized by a campaign worker who had worked for Perot in the 1992 campaign.²⁰⁰ The primary issue before the court was whether political activities were "services" within the meaning of the Lanham Act.²⁰¹ The defendant also contended that the Lanham Act did not apply to entirely intrastate fair use, and that its mark was protected under the First Amendment as a political activity.²⁰²

*263 The court determined that services include political organizations that support particular candidates, solicit funds, and advance particular causes.²⁰³ It is just as important for a nonprofit organization to maintain its distinct identity as it is for a commercial company.²⁰⁴ Interestingly, the court reasoned that voters should be able to rely on a party's endorsement of a candidate so that the voter could know with some confidence that the endorsed candidate supported the voters' objectives.²⁰⁵ The court reasoned that to exclude political parties from the scope of the Lanham Act would be impractical for the functioning of a political system.²⁰⁶ However, the court stated in a footnote that there was no restriction on adopting nonconfusing related trade names such as "Democrats for Jones."²⁰⁷ This decision does not address whether the court would have approved a fundraising slogan such as "Members of United We Stand America for Jones," which was not before the court.

In rejecting the defendant's First Amendment argument, the court briefly concluded that the defendant was using the phrase "United We Stand America" to associate itself with this particular political movement rather than for an expressive purpose, such as commentary, comedy, parody, news reporting, or criticism.²⁰⁸ The court said little to distinguish First Amendment use from commercial use, and did not engage in a discussion to distinguish an appropriate First Amendment use from an infringing non-First Amendment use.²⁰⁹ The court dismissed out of hand the defense that intrastate fair use of a mark cannot be affected by the Lanham Act.²¹⁰

B. Motion to Stay Pending Trademark Trial and Appeal Board Review: *Citicasters Co. v. Country Club Committee*²¹¹

The United States District Court for the Central District of California granted the defendant's motion to stay the case pending resolution of a *264 cancellation proceeding by the Patent and Trademark Office's Trademark Trial and Appeal Board (Board) in *Citicasters*.²¹² After considering the relevant precedential opinions, the court determined that a decision to stay rests primarily within the district court's discretion, either under the "primary jurisdiction" doctrine or the court's power to monitor its own docket.²¹³ In this situation, the court found that there was no showing that demonstrable harm would result to either party if a stay should be granted, and noted that the Board's specialized knowledge as applied to these facts would be an advisory opinion helpful to the district court once the district court proceedings continued.²¹⁴

C. Bona Fide Intent to Use: *Salacuse v. Ginger Spirits, Inc.*²¹⁵

This proceeding to cancel the registration for SOUTH BEACH BEER was filed by an intent-to-use applicant seeking to use SOUTH BEACH for beer, wine, and other products. The intent-to-use applicant moved for summary judgment, claiming that its applications established superior rights.²¹⁶ The registrant responded that there was a substantial issue of material fact as to whether the applicant had a bona fide intention to use the marks.²¹⁷ The registrant challenged the applicant's intent-to-use applications as not being supported by a bona fide intention, emphasizing the applicant's other SOUTH BEACH intent-to-use applications for different types of products and other applications for various other products.²¹⁸

The Trademark Trial and Appeal Board (Board) confirmed that the applicant was entitled to rely on the filing date of the intent-to-use application for his constructive date of first use and that he was entitled to offensively assert this use in the cancellation proceeding.²¹⁹ However, the Board rejected the applicant's argument that his applications could not be challenged to support cancellation.²²⁰ The Board noted that the applicant may be entitled to *265 constructive use as priority, but that this priority is contingent upon the maturing of his prior filed applications into registrations, and not merely their pendency.²²¹ Further, the applicant bears the burden of proof in the cancellation proceedings.²²² Additionally, the applications the applicant relies on must be proper.²²³ The Board found that a genuine issue of fact existed as to whether those applications were proper and whether the requisite bona fide intention to use the mark was present.²²⁴ The Board considered the legislative history for examples of circumstances which may cast doubt on a bona fide intention to use.²²⁵ These reasons for doubt included the filing of numerous intent-to-use applications for many more new products than were contemplated and the filing of numerous intent-to-use applications for a variety of desirable trademarks intended to be used on a single new product.²²⁶ Here the Board found that the registrant had raised a substantial issue of fact by showing numerous products listed in intent-to-use applications for SOUTH BEACH by the applicant.²²⁷ Additionally, the same products were identified in other intent-to-use applications filed by the applicant.²²⁸

V. Attorneys' Fees and Costs

A. Attorneys' Fees to the Defendant: *Door Systems, Inc. v. Pro-Line Door System, Inc.*²²⁹

At issue in this case was Section 35(a) of the Lanham Act, 15 U.S.C. § 1117(a), which authorizes awards of attorneys' fees to prevailing parties in "exceptional cases,"²³⁰ and a provision of the Illinois Consumer Fraud and Deceptive Business Practices Act, which provides that the court "may" award *266 fees to the prevailing party.²³¹ The defendant had successfully defeated the plaintiff's claims of trademark infringement, but the district court only awarded fees under the Illinois statute because there was no bad faith to justify an award under the Lanham Act.²³²

Illinois law is inconclusive as to whether bad faith is needed or whether it is enough that there are special circumstances present.²³³ The district court treated the Illinois statute as if it gave the prevailing party an automatic right to attorneys' fees.²³⁴ The court of appeals held that this was error and that there was no automatic right.²³⁵

The court then struggled with determining the standard for an award of attorneys' fees to the defendant, finally concluding that bad faith was too narrow a standard.²³⁶ The court first determined that the Illinois standard did not provide a dual standard for the award of attorneys' fees.²³⁷ However, the court did conclude that the standards for awarding fees could be different depending upon the nature of the parties.²³⁸ The court noted that policy reasons may dictate that standards for awarding fees can be different between plaintiffs and defendants.²³⁹ For example, a stricter standard may be applied for an award of fees to a defendant against a plaintiff who is a consumer in a case enforcing consumer laws.²⁴⁰ Further, the court found that the special circumstances warranting an award to the plaintiff may not be the same as those warranting an award to the defendant.²⁴¹ The court noted that the typical canonical formula is whether the conduct was "malicious, fraudulent, deliberate, or willful."²⁴² The court rejected "deliberate" as a standard for awarding fees to a defendant, and then noted the differences between *267 deliberate acts that would support fees for a plaintiff but not for a defendant.²⁴³ For example, a defendant could deliberately choose to use a mark similar to the plaintiff's, thereby incurring liability for fees.²⁴⁴ On the other hand, every plaintiff engages in a deliberate act when he files suit. Such a deliberate act would not be the basis for an exceptional case.²⁴⁵ As result of this conclusion, the court remanded the case for the district court to determine whether the plaintiff's suit could fairly be regarded as oppressive.²⁴⁶

B. Attorneys' Fees to the Defendant: *Stephen W. Boney, Inc. v. Boney Services, Inc.*²⁴⁷

In *Boney*, the Ninth Circuit also considered the award of attorneys' fees to a defendant under the Lanham Act. The court first determined the standard of review for awarding attorneys' fees under the Lanham Act by reviewing the relevant standards of review for such awards under the Copyright Act²⁴⁸ and other analogous statutes.²⁴⁹ Because each of these statutes uses an abuse of discretion standard, the court concluded that an award of attorneys' fees under the Lanham Act was within the district court's discretion and was reviewable only for an abuse of discretion.²⁵⁰

Next, the court considered the requirements that a prevailing defendant must meet to justify an award of attorneys' fees under the Lanham Act. Section 35(a) of the Lanham Act provides that “[t]he court in exceptional cases may award reasonable attorney fees to the prevailing party,” but offers no definition for “exceptional.”²⁵¹ Although the Ninth Circuit had earlier explained that “[g]enerally, a trademark case is exceptional for purposes of an award of attorney's fees when the infringement is malicious, fraudulent, deliberate, or willful,”²⁵² the defendant, Boney Services, attempted to argue that this standard applies to plaintiffs seeking attorneys' fees but not to *268 defendants.²⁵³ To consider this argument, the court reviewed the Supreme Court's opinion in *Fogerty v. Fantasy, Inc.*,²⁵⁴ in which the Supreme Court held that courts must apply an “evenhanded” standard when determining whether prevailing plaintiffs or defendants are entitled to attorney's fees under the Copyright Act.²⁵⁵ The Ninth Circuit therefore determined that an “evenhanded” approach was also required under the Lanham Act.²⁵⁶ As a result, the court determined that the same bad faith or other malicious conduct standard applies to both plaintiffs and defendants attempting to show exceptional circumstances that justify an award of attorneys' fees under the Lanham Act.²⁵⁷

C. Judicial Discretion in Exceptional Cases: *Dorr-Oliver, Inc. v. Fluid Quip, Inc.*²⁵⁸

In this case, the United States District Court for the Northern District of Illinois denied a motion by the defendant for an award of attorneys' fees under the Lanham Act.²⁵⁹ The court first determined that this case could not have been exceptional or in bad faith because the plaintiff actually prevailed in the district court before that decision was later overturned by the appellate court.²⁶⁰ Accordingly, it would be impossible to conclude that such a close case was “malicious, fraudulent, deliberate or willful.”²⁶¹ Even a plaintiff that economically dwarfs the defendant does not automatically qualify a case as exceptional because even a powerful plaintiff should be expected to protect its market position.²⁶² The plaintiff must act “in a predatory, unreasonable manner to harass defendants or take advantage of their lesser economic ability to litigate an obviously meritless case” before the case becomes exceptional.²⁶³ Finally, the court determined that even when a case is deemed *269 exceptional in some manner, the district court still retains discretion to award attorney's fees.²⁶⁴

D. Calculation of Attorneys' Fees and Costs: *Good Earth Corp. v. M.D. Horton & Associates*²⁶⁵

A contract providing that attorneys' fees would be awarded to the prevailing party was involved in this case.²⁶⁶ The fees were disputed as containing duplicative and unintelligible entries, charges for travel time, a request for costs in the nature of postage, duplicating services, faxes, long distance telephone calls, computer data research, travel expenses, and secretarial overtime.²⁶⁷ Also, there was a request to reduce the fees by one-half because the defendant had prevailed on some points and had retained the rights to use the trademark in limited situations.²⁶⁸ This case demonstrates that accurate records of copying charges should be maintained in actions involving a large number of produced documents.

The rules governing attorneys' fees are substantive because they serve specific state policy considerations.²⁶⁹ Additionally, the factors considered in calculating the fees are also substantive state law.²⁷⁰ Many of the objections to the fees charged were dismissed as being unsupported by any reason other than merely stating the objection.²⁷¹ However, the court did find that an award of travel time expense was appropriate.²⁷²

The defendant argued that the equities required a reduction of the attorneys' fees by one-half because it was successful in retaining some rights to continue use of the trademark.²⁷³ California law defined the prevailing party as the party who recovered the greater relief in the action on the *270 contract; thus, there was no basis in the law for apportioning the award of attorneys' fees.²⁷⁴

The only costs allowed by the court were those costs covered by California civil procedure or by 28 U.S.C. § 1920.²⁷⁵ Thus, the request for reimbursement of postage, overnight delivery, faxes, messengers, long distance telephone calls, computer assisted research, travel expenses of the attorneys, and secretarial overtime was not allowed.²⁷⁶ However, photocopying charges were allowed under Section 1920 as “fees for copies of papers necessarily obtained for use in the case.”²⁷⁷ However, photocopying charges were allowed only for reproducing formal discovery documents and trial exhibits, but not for

reproducing motion papers or pleadings.²⁷⁸

VI. Estoppel by Laches: *Kason Industries, Inc. v. Component Hardware Group, Inc.*²⁷⁹

This case came before the Eleventh Circuit following the district court's summary judgment for the defendant on the ground that laches barred the plaintiff's suit for trade dress infringement and unfair competition.²⁸⁰ The Eleventh Circuit disagreed with the district court's determination of an appropriate limitations period to apply to laches under the Lanham Act.²⁸¹ Furthermore, the court noted, even when laches appropriately bars a suit for damages, injunctive relief may still be awarded at the court's discretion if the equities so favor such a result.²⁸²

Since the Lanham Act does not contain a statute of limitations, the court found it necessary to find an analogous state law and to use its statute of limitations as a touchstone for estoppel by laches under the Lanham Act.²⁸³ The court reviewed two Georgia statutes, the Fair Business Practices Act *271 (FBPA) and the Uniform Deceptive Trade Practices Act (UDTPA), to determine which was more analogous to a trademark infringement.²⁸⁴ Because the standard for an FBPA claim is "actual confusion" while the standard for a claim under the UDTPA, like the Lanham Act, is "likelihood of confusion," the court found the UDTPA to be more analogous.²⁸⁵ Since the UDTPA also does not contain a limitations period, the court further reviewed Georgia's general statute of limitations provisions.²⁸⁶ Because an action under the UDTPA has many of the same characteristics as an action for fraud, the court concluded that the four-year statute of limitations period associated with an action for fraud rather than the twenty-year statute of limitations period in the catchall provision, is applicable for estoppel by laches under the Lanham Act when the alleged infringement occurs in Georgia.²⁸⁷

Additionally, the Eleventh Circuit determined that the district court erred by beginning the measure of delay without accounting for the doctrine of progressive encroachment.²⁸⁸ "Under this doctrine, where a defendant begins use of a trademark or trade dress in the market, and then directs its marketing or manufacturing efforts such that it is placed more squarely in competition with the plaintiff, the plaintiff's delay is excused."²⁸⁹ The end result is that a plaintiff's measure of delay should not begin until the plaintiff knows or should know there is a *provable* claim for infringement.²⁹⁰ Any other rule "would require each trademark owner to sue first and ask questions later."²⁹¹ Because the district court applied an incorrect period for laches and failed to apply the doctrine of progressive encroachment, the Eleventh Circuit vacated the decision and remanded for further consideration.²⁹²

***272 VII. Federal Trademark Dilution Act/Retroactive Application: *Resorts of Pinehurst, Inc. v. Pinehurst National Development Corp.*²⁹³**

In *Pinehurst*, the United States District Court for the Middle District of North Carolina considered whether the Federal Trademark Dilution Act (Dilution Act), which became effective in January 1996, can be applied retroactively.²⁹⁴ The case involved a motion for a preliminary injunction by a hotel and golf course resort against two new golf course operations located nearby that used PINEHURST as part of their marks.²⁹⁵ The plans and development of the defendants' new golf course operations were begun well before the passage of the Dilution Act.²⁹⁶

Relying on the analysis of the Lanham Act used in *Circuit City Stores, Inc. v. Office Max, Inc.*,²⁹⁷ the court found that there was no evidence in the statute nor any indication in its history that Congress intended the Dilution Act to be applied retroactively.²⁹⁸ The court determined that retroactive application of the Dilution Act would attach new and possibly unforeseeable legal consequences to an event occurring prior to enactment of the Act.²⁹⁹ As a result, retroactive application of the Dilution Act is not appropriate if the acts complained of were legal at the time performed because of the importance of protecting the business and legal expectations of these actors.³⁰⁰ If, on the other hand, the acts were "illegal because of any dilutive effect they may have had under federal law prior to the enactment of the Dilution Act,"³⁰¹ then retroactive application would likely be appropriate.³⁰² Since there was no federal law prohibiting trademark dilution prior to the Dilution Act, the court declined to apply this Act retroactively.³⁰³

***273 VIII. The Eleventh Amendment and the Lanham Act: *Sofamor Danek Group, Inc. v. Brown*³⁰⁴**

In *Sofamor*, the Ninth Circuit determined that Eleventh Amendment state immunity does not bar a suit in federal court against an state official who allegedly violated federal trademark law under the Lanham Act.³⁰⁵ The court noted that the *Ex parte Young* doctrine, the one exception to states' immunity from suit otherwise mandated by the Eleventh Amendment's

protection of state agencies and officers, allows suits in federal court against state officers to enjoin official actions that violate federal law.³⁰⁶ However, the Supreme Court in *Idaho v. Coeur d'Alene*³⁰⁷ warned against allowing this exception to swallow the Eleventh Amendment mandate because “application of the *Young* exception must reflect a proper understanding of its role in our federal system and respect for state courts instead of a reflexive reliance on an obvious fiction.”³⁰⁸ As a result, *Young* must be interpreted consistently with the “real interests served by the Eleventh Amendment.”³⁰⁹

The court noted that the Ninth Circuit has previously held that *Ex parte Young* applies to violations of federal statutory law as well as federal constitutional violations.³¹⁰ Because the plaintiffs claim only requested *prospective* injunctive relief enjoining the state official from making statements about the plaintiffs product in violation of federal law, and not retrospective relief requiring payment of funds from the state treasury, the *Ex parte Young* doctrine does not bar Sofamor’s request for injunctive relief.³¹¹ Further, no relief was requested which implicated “state policies or procedures” of the state to an extent which would make the state a real party in interest.³¹² The plain language of the Lanham Act indicates that Congress intended to authorize suit against state officials.³¹³ Specifically, the Lanham Act provides that “any person” can be held liable and defines “any person” to *274 include “any State, instrumentality of a State or employee of a State or instrumentality of a State acting in his or her official capacity.”³¹⁴ As a result, the Ninth Circuit held that suits requesting prospective injunctive relief against state officials who violate the Lanham Act in their official capacities are not barred by the Eleventh Amendment.³¹⁵

IX. Right of Publicity

A. Interaction of the Right of Publicity and Copyright Law: *Wendt v. Host International, Inc.*³¹⁶

The Ninth Circuit in *Wendt* addressed various issues regarding the right of publicity and unfair competition as applied to the defendant’s use of animatronic robots placed in airport bars modeled upon the set from the television show *Cheers*.³¹⁷ The appearances of these robots were based upon the likenesses of actors George Wendt and John Ratzenberger, but were used without their permission.³¹⁸

Regarding the right of publicity, the court addressed both the statutory and the common law right under California law.³¹⁹ Applying the statutory right, the court reinforced its earlier position that this statutory right is not preempted by federal copyright law and therefore issues of material fact existed regarding the similarities between the robots and the likenesses of the plaintiffs.³²⁰ As to the common law right, the court found that the plaintiffs still retained the right to control the commercial exploitation of their physical likenesses even though they may have been portraying copyrighted fictional characters in the particular setting depicted.³²¹ Accordingly, the plaintiffs had raised genuine issues of material fact concerning the degree of similarity between their likenesses and the robots.

*275 The Ninth Circuit also conducted a traditional analysis of unfair competition resulting from false endorsement as previously applied to celebrity endorsement cases.³²² In this analysis of false endorsement, the traditional factor inquiring as to the strength of the “mark” inquires as to the level of recognition the celebrity enjoys.³²³ Otherwise, the analysis is unchanged. The court found that a reasonable jury could conclude that most of the factors weigh in the plaintiff’s favor, and that the district court had improperly excluded survey evidence and expert testimony regarding the likelihood of confusion.³²⁴

B. Commercial Benefit/Public Figures: *Polsby v. Spruill*³²⁵

In *Polsby*, the court addressed several claims, one of which was an alleged violation and misappropriation of the plaintiff’s right of publicity based on the similarities between the life of the plaintiff and that of the main character of the defendant’s novel.³²⁶ The court granted summary judgment against the plaintiff on this claim for three separate reasons. First, it determined that the defendant derived no commercial benefit that was specifically attributable to the use of the plaintiff’s name or likeness.³²⁷ The mere fact that the defendant intended to profit from creating the novel was not sufficient to prove that this profit would be derived specifically from the parallels to the plaintiff.³²⁸ Second, even if this general intent was enough, there was no showing that the defendant ever actually used the plaintiff’s name or likeness in the novel.³²⁹ Finally, regardless of either of these first two considerations, the plaintiff had already forfeited her exclusive right to her life story because she had become a public figure by testifying before Congress about her experiences at the National Institute of Health, and such testimony had been nationally televised.³³⁰

Footnotes

¹ 44 U.S.P.Q.2d (BNA) 1220 (S.D.N.Y.1997).

² *Id.* at 1222-23.

³ *Id.* at 1222.

⁴ *Id.* (quoting *Berni v. Int'l Gourmet Restaurants of America, Inc.*, 838 F.2d 642, 648, 5 U.S.P.Q.2d (BNA) 1723, 1727 (2d Cir.1988)).

⁵ *Id.*

⁶ 44 U.S.P.Q.2d (BNA) 1472 (E.D.Tex.1996).

⁷ *Id.* at 1473.

⁸ *Id.*

⁹ *Id.* at 1474.

¹⁰ *Id.* at 1473.

¹¹ *Id.* at 1474.

¹² *Id.*

¹³ *Id.* at 1475.

¹⁴ *Id.* at 1475.

¹⁵ 126 F.3d 25, 44 U.S.P.Q.2d (BNA) 1051 (2d Cir.1997).

¹⁶ *Id.* at 27, 44 U.S.P.Q.2d at 1052.

¹⁷ See *id.* at 27, 29, 44 U.S.P.Q.2d at 1052-53, 1054.

¹⁸ *Id.* at 26, 44 U.S.P.Q.2d at 1052.

¹⁹ *Id.* at 26-27, 44 U.S.P.Q.2d at 1052.

²⁰ *Id.* at 27, 44 U.S.P.Q.2d at 1052 (citing 15 U.S.C. §§ 114(1) (1994); 15 U.S.C.A. § 1125(a), (c) (West 1998)).

²¹ *Id.* at 27-29, 44 U.S.P.Q.2d at 1053-54.

²² N.Y. C.P.L.R. 302(a)(2) (McKinney 1990 & Supp.1997-1998).

²³ 126 F.3d at 28-29, 44 U.S.P.Q.2d at 1053-54.

²⁴ *Id.* at 29, 44 U.S.P.Q.2d at 1054.

²⁵ N.Y.C.P.L.R. 302(a)(3) (McKinney 1990 & Supp.1997-1998).

²⁶ 126 F.3d at 29, 44 U.S.P.Q.2d at 1054.

²⁷ 43 U.S.P.Q.2d (BNA) 1672 (E.D.La.1997).

²⁸ *Id.* at 1673.

²⁹ *Id.*

³⁰ *Id.* at 1674, 1677.

³¹ *Id.* at 1674-76.

³² *Id.* at 1676-77.

³³ *Id.* at 1677.

³⁴ *Id.* at 1677-78.

³⁵ *Id.* at 1675-76.

³⁶ *Id.* at 1675.

³⁷ *Id.* (quoting California Software Inc. v. Reliability Research, Inc., 631 F.Supp. 1356, 1363 (C.D.Cal.1986)).

³⁸ *Id.* (quoting Playboy Enter., Inc. v. Chuckleberry Publ'g, Inc., 939 F.Supp. 1032, 1039, 39 U.S.P.Q.2d (BNA) 1746, 1752 (S.D.N.Y.1996)).

³⁹ *Id.* at 1676.

⁴⁰ 43 U.S.P.Q.2d (BNA) 1862 (C.D.Cal.1997).

⁴¹ *Id.* at 1863-64.

⁴² *Id.*

⁴³ *Id.* at 1864.

⁴⁴ *Id.*

⁴⁵ 976 F.Supp. 263, 44 U.S.P.Q.2d (BNA) 1478 (S.D.N.Y.1997).

⁴⁶ *Id.* at 265, 44 U.S.P.Q.2d at 1480.

⁴⁷ *Id.* at 264, 44 U.S.P.Q.2d at 1479.

⁴⁸ *Id.*

⁴⁹ *Id.*

⁵⁰ *Id.*, 44 U.S.P.Q.2d at 1479-80.

⁵¹ *Id.* at 265, 44 U.S.P.Q.2d at 1480.

⁵² *Id.*

⁵³ 125 F.3d 28, 43 U.S.P.Q.2d (BNA) 1956 (2d Cir.1997).

⁵⁴ *Id.* at 29, 43 U.S.P.Q.2d at 1957.

⁵⁵ *Id.*

⁵⁶ *Id.*

⁵⁷ *Id.* at 29-30, 43 U.S.P.Q.2d at 1957-58.

⁵⁸ *Id.*

59 *Id.* at 30, 43 U.S.P.Q.2d at 1958.

60 *Id.*

61 *Id.*

62 *Id.*

63 *Id.*

64 124 F.3d 137, 43 U.S.P.Q.2d (BNA) 1734 (2d Cir.1997).

65 *Id.* at 141, 43 U.S.P.Q.2d at 1736.

66 *Id.*, 43 U.S.P.Q.2d at 1737.

67 *Id.* at 140, 43 U.S.P.Q.2d at 1735.

68 *Id.*

69 *Id.* at 145, 43 U.S.P.Q.2d at 1740.

70 *Id.* at 140, 43 U.S.P.Q.2d at 1735-36.

71 *Id.* at 148, 43 U.S.P.Q.2d at 1742-43.

72 *Id.* at 150, 43 U.S.P.Q.2d at 1744 (quoting *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 121 (3d Cir.1938)).

73 *Id.*

74 *Id.* at 151, 43 U.S.P.Q.2d at 1745.

75 *Id.*

76 124 F.3d 876, 43 U.S.P.Q.2d (BNA) 1912 (7th Cir.1997).

77 *Id.* at 887, 43 U.S.P.Q.2d at 1920.

78 *Id.* at 884, 43 U.S.P.Q.2d at 1918.

79 *Id.*

80 *Id.* at 885, 43 U.S.P.Q.2d at 1919 (quoting 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 31.41 (4th ed. 1997)).

81 *Id.*

82 *Id.*

83 *Id.* at 886-87, 43 U.S.P.Q.2d at 1920.

84 *Id.* at 886, 43 U.S.P.Q.2d at 1920.

85 *Id.* (quoting *SunAmerica Corp. v. Sun Life Assurance Co. of Canada*, 77 F.3d 1325, 1336, 38 U.S.P.Q.2d (BNA) 1065, 1073 (11th Cir.1996), *cert. denied*, 117 S.Ct. 79 (1996)).

86 129 F.3d 1, 44 U.S.P.Q.2d (BNA) 1517 (1st Cir.1997).

87 *Id.* at 2, 44 U.S.P.Q.2d at 1517.

88 *Id.*, 44 U.S.P.Q.2d at 1517-18.

89 *Id.*

90 *Id.* at 2, 44 U.S.P.Q.2d at 1518.

91 *Id.* at 2-3, 44 U.S.P.Q.2d at 1518.

92 *Id.*

93 *Id.* at 4, 44 U.S.P.Q.2d at 1519.

94 *Id.* at 5, 44 U.S.P.Q.2d at 1520.

95 *Id.* at 6, 44 U.S.P.Q.2d at 1521.

96 128 F.3d 1111, 44 U.S.P.Q.2d (BNA) 1545 (7th Cir.1997).

97 *Id.* at 1114, 44 U.S.P.Q.2d at 1546.

98 *Id.* at 1113, 44 U.S.P.Q.2d at 1546.

⁹⁹ *Id.* at 1115, 44 U.S.P.Q.2d at 1547.

¹⁰⁰ *Id.* at 1116, 44 U.S.P.Q.2d at 1548.

¹⁰¹ *Id.* at 1117, 44 U.S.P.Q.2d at 1549 (citing Newark Morning Ledge Co. v. United States, 507 U.S. 546, 555 (1993)).

¹⁰² *Id.*

¹⁰³ *Id.* at 1119, 44 U.S.P.Q.2d at 1551.

¹⁰⁴ *Id.* at 1118, 44 U.S.P.Q.2d at 1550.

¹⁰⁵ *Id.* at 1119, 44 U.S.P.Q.2d at 1551.

¹⁰⁶ *Id.*

¹⁰⁷ *Id.*

¹⁰⁸ *Id.* at 1122, 44 U.S.P.Q.2d at 1553.

¹⁰⁹ 44 U.S.P.Q.2d (BNA) 1249 (E.D.N.Y.1997).

¹¹⁰ *Id.* at 1250.

¹¹¹ *Id.* at 1251.

¹¹² *Id.*

¹¹³ *Id.* at 1254.

¹¹⁴ *Id.*

¹¹⁵ *Id.* at 1255.

¹¹⁶ *Id.*

¹¹⁷ *Id.* at 1255-59 (citing Polaroid Corp. v. Polaroid Elecs. Corp., 287 F.2d 492, 495, 128 U.S.P.Q. (BNA) 411, 413 (2d Cir.1961)).

118 *Id.* at 1259.

119 *Id.*

120 *Id.*

121 44 U.S.P.Q.2d (BNA) 1385 (U.S. Int'l Trade Comm'n 1997).

122 *Id.* at 1389.

123 *Id.* at 1388-89.

124 *Id.* at 1389.

125 *Id.* at 1388-90.

126 *Id.* at 1389.

127 *Id.* at 1395.

128 *Id.* at 1392.

129 *Id.* at 1393.

130 *Id.* at 1395.

131 *Id.* at 1395-96.

132 *Id.* at 1398.

133 *Id.*

134 *Id.* at 1403.

135 *Id.*

136 *Id.*

137 123 F.3d 246, 44 U.S.P.Q.2d (BNA) 1161 (5th Cir.1997).

¹³⁸ *Id.* at 252, 44 U.S.P.Q.2d at 1164.

¹³⁹ *Id.* at 257, 44 U.S.P.Q.2d at 1169.

¹⁴⁰ *Id.* at 260, 44 U.S.P.Q.2d at 1172.

¹⁴¹ *Id.* at 255, 44 U.S.P.Q.2d at 1167.

¹⁴² *Id.* at 255 n. 16, 44 U.S.P.Q.2d at 1167 n. 16.

¹⁴³ *Id.*

¹⁴⁴ *Id.* at 254, 44 U.S.P.Q.2d at 1166.

¹⁴⁵ *Id.* at 256, 44 U.S.P.Q.2d at 1168 (citing *Taco Cabana Int'l, Inc. v. Two Pesos, Inc.*, 932 F.2d 1113, 1119, 19 U.S.P.Q.2d (BNA) 1253, 1257 (5th Cir.1991), *aff'd*, 505 U.S. 763, 23 U.S.P.Q.2d (BNA) 1081 (1992)).

¹⁴⁶ *Id.* at 257, 44 U.S.P.Q.2d at 1169.

¹⁴⁷ *Id.* at 257-61, 44 U.S.P.Q.2d at 1169-72.

¹⁴⁸ *Id.* at 258, 44 U.S.P.Q.2d at 1170.

¹⁴⁹ *Id.* at 259, 44 U.S.P.Q.2d at 1171.

¹⁵⁰ *Id.* at 260, 44 U.S.P.Q.2d at 1172.

¹⁵¹ *Id.*

¹⁵² *Id.*

¹⁵³ 970 F.Supp. 612, 44 U.S.P.Q.2d (BNA) 1207 (E.D.Mich.1997).

¹⁵⁴ *Id.* at 613, 44 U.S.P.Q.2d at 1208.

¹⁵⁵ *Id.* at 615, 44 U.S.P.Q.2d at 1210.

¹⁵⁶ *Sunbeam Prods., Inc. v. West Bend Co.*, 123 F.2d 246, 44 U.S.P.Q.2d (BNA) 1161 (5th Cir.1997).

¹⁵⁷ *See supra* III.A.

¹⁵⁸ 58 F.3d 1498, 35 U.S.P.Q.2d (BNA) 1332 (10th Cir.1995), *cert. denied*, 116 S.Ct. 753 (1996).

¹⁵⁹ 970 F.Supp. at 616, 44 U.S.P.Q.2d at 1210 (citing *Vornado*, 58 F.3d at 1508, 35 U.S.P.Q.2d at 1340).

¹⁶⁰ *Id.* (citing *Vornado*, 58 F.3d at 1510, 35 U.S.P.Q.2d at 1342).

¹⁶¹ *Id.*

¹⁶² *Id.* at 616, 44 U.S.P.Q.2d at 1210-11.

¹⁶³ 44 U.S.P.Q.2d (BNA) 1115 (C.D.Cal.1997).

¹⁶⁴ *Id.* at 1122.

¹⁶⁵ *Id.* at 1121-22.

¹⁶⁶ *Id.* at 1115-17.

¹⁶⁷ *Id.* at 1120-21.

¹⁶⁸ 870 F.2d 512, 10 U.S.P.Q.2d (BNA) 1226 (9th Cir.1989).

¹⁶⁹ 58 F.3d 1498, 35 U.S.P.Q.2d (BNA) 1332 (10th Cir.1995), *cert. denied*, 116 S.Ct. 753 (1996).

¹⁷⁰ *Id.* at 1510, 35 U.S.P.Q.2d at 1342.

¹⁷¹ *Clamp*, 870 F.2d at 514, 10 U.S.P.Q.2d at 1227.

¹⁷² *Id.* at 516-17, 10 U.S.P.Q.2d at 1229-30.

¹⁷³ Chem-Tainer Indus., Inc. v. Wilkin, 44 U.S.P.Q.2d (BNA) 1115, 1120-21 (C.D.Cal.1997).

¹⁷⁴ *Id.* at 1121.

¹⁷⁵ 44 U.S.P.Q.2d (BNA) 1275 (D.Or.1996).

¹⁷⁶ *Id.* at 1276.

¹⁷⁷ *Id.* at 1277-79.

¹⁷⁸ *Id.* at 1277, 1278-79.

¹⁷⁹ *Id.* at 1278.

¹⁸⁰ *Id.*

¹⁸¹ *Id.* at 1278-79.

¹⁸² *Id.*

¹⁸³ *Id.* at 1279-80.

¹⁸⁴ *Id.* at 1280.

¹⁸⁵ *Id.* at 1280-81.

¹⁸⁶ 971 F.Supp. 262, 43 U.S.P.Q.2d (BNA) 1865 (E.D.Mich.1997).

¹⁸⁷ *Id.* at 263-64, 43 U.S.P.Q.2d at 1866.

¹⁸⁸ *Id.* at 266-70, 43 U.S.P.Q.2d at 1869-72. The court concluded that no reasonable trier of fact would have found that the plaintiff had established secondary meaning. *Id.* at 269, 43 U.S.P.Q.2d at 1872. However, after its analysis of likelihood of confusion, the court could not conclude as a matter of law that there was no likelihood of confusion between the respective trade dress of the opposing parties. *Id.* at 272, 43 U.S.P.Q.2d at 1874.

¹⁸⁹ *Id.* at 270-72, 43 U.S.P.Q.2d at 1872-74.

¹⁹⁰ *Id.* at 272-76, 43 U.S.P.Q.2d at 1874-77.

¹⁹¹ *Id.* at 272-73, 43 U.S.P.Q.2d at 1874.

¹⁹² *Id.* at 273, 43 U.S.P.Q.2d at 1875.

¹⁹³ *Id.* at 273-74, 43 U.S.P.Q.2d at 1875-76.

¹⁹⁴ *Id.* at 275, 43 U.S.P.Q.2d at 1877.

¹⁹⁵ *Id.* at 275-76, 43 U.S.P.Q.2d at 1877.

196 *Id.* at 276, 43 U.S.P.Q.2d at 1877.

197 *Id.*

198 128 F.3d 86, 44 U.S.P.Q.2d (BNA) 1351 (2d Cir.1997).

199 *Id.* at 88, 44 U.S.P.Q.2d at 1353.

200 *Id.*

201 *Id.*, 44 U.S.P.Q.2d at 1352-53.

202 *Id.*

203 *Id.* at 89-90, 44 U.S.P.Q.2d at 1354-55.

204 *Id.* at 90, 44 U.S.P.Q.2d at 1355.

205 *Id.*

206 *Id.*

207 *Id.* at 90 n. 1, 44 U.S.P.Q.2d at 1355 n. 1.

208 *Id.* at 93, 44 U.S.P.Q.2d at 1357.

209 *Id.*

210 *Id.*

211 44 U.S.P.Q.2d (BNA) 1223 (C.D.Cal.1997).

212 *Id.* at 1224.

213 *Id.* at 1223.

214 *Id.* at 1224.

215 44 U.S.P.Q.2d (BNA) 1415 (T.T.A.B.1997).

216 *Id.* at 1416-17.

217 *Id.* at 1417.

218 *Id.* at 1419.

219 *Id.* at 1418.

220 *Id.*

221 *Id.*

222 *Id.* at 1419.

223 *Id.*

224 *Id.*

225 *Id.* at 1420.

226 *Id.* (quoting *Lane Ltd. v. Jackson Int'l Trading Co.* Kurt D. Bruhl Gesellschaft m.b.G. & Co. KG., 33 U.S.P.Q.2d (BNA) 1351, 1355 (1988)).

227 *Id.*

228 *Id.*

229 126 F.3d 1028, 44 U.S.P.Q.2d (BNA) 1376 (7th Cir.1997).

230 15 U.S.C.A. § 1117(a) (West 1998).

231 126 F.3d at 1029, 44 U.S.P.Q.2d at 1377.

232 *Id.*

233 *Id.* at 1029-30, 44 U.S.P.Q.2d at 1377.

234 *Id.* at 1030, 44 U.S.P.Q.2d at 1377.

235 *Id.*

²³⁶ *Id.*

²³⁷ *Id.*

²³⁸ *Id.* at 1031, 44 U.S.P.Q.2d at 1378.

²³⁹ *Id.*

²⁴⁰ *Id.* at 1030, 44 U.S.P.Q.2d at 1377-78.

²⁴¹ *Id.*

²⁴² *Id.* at 1031, 44 U.S.P.Q.2d at 1378.

²⁴³ *Id.* at 1031-32, 44 U.S.P.Q.2d at 1378-79.

²⁴⁴ *Id.* at 1031, 44 U.S.P.Q.2d at 1379.

²⁴⁵ *Id.* at 1032, 44 U.S.P.Q.2d at 1379.

²⁴⁶ *Id.*

²⁴⁷ 127 F.3d 821, 44 U.S.P.Q.2d (BNA) 1225 (9th Cir.1997).

²⁴⁸ 17 U.S.C.A. §§ 101-1101 (West 1997 & Supp.1998).

²⁴⁹ 127 F.3d at 825, 44 U.S.P.Q.2d at 1227-28.

²⁵⁰ *Id.*, 44 U.S.P.Q.2d at 1288.

²⁵¹ *Id.* (quoting 15 U.S.C.A. 1117(a) (West 1998)).

²⁵² *Id.* at 825-26, 44 U.S.P.Q.2d at 1228.

²⁵³ *Id.* at 826, 44 U.S.P.Q.2d at 1228.

²⁵⁴ *Id.* (citing *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 29 U.S.P.Q.2d (BNA) 1881 (1994)).

255 *Id.* (citing Fogerty, 510 U.S. at 534, 29 U.S.P.Q.2d at 1888).

256 *Id.* at 826, 44 U.S.P.Q.2d at 1228-29.

257 *Id.* at 827, 44 U.S.P.Q.2d at 1229.

258 966 F.Supp. 718, 44 U.S.P.Q.2d (BNA) 1057 (N.D.Ill.), *aff'd*, 132 F.3d 36 (7th Cir.1997).

259 966 F.Supp. at 722, 44 U.S.P.Q.2d at 1060.

260 *Id.* at 721, 44 U.S.P.Q.2d at 1059.

261 *Id.*

262 *Id.*

263 *Id.*

264 *Id.*, 44 U.S.P.Q.2d at 1060.

265 44 U.S.P.Q.2d (BNA) 1505 (N.D.Cal.1997).

266 *Id.* at 1506.

267 *Id.* at 1506, 1511.

268 *Id.* at 1506.

269 *Id.* at 1507.

270 *Id.*

271 *Id.* at 1508-09.

272 *Id.* at 1509.

273 *Id.* at 1506.

274 *Id.* at 1509-10.

²⁷⁵ *Id.* at 1510-11 (citing 28 U.S.C. § 1920 (1994)).

²⁷⁶ *Id.* at 1511.

²⁷⁷ *Id.* (citing 28 U.S.C. § 1920(4)).

²⁷⁸ *Id.*

²⁷⁹ 120 F.3d 1199, 43 U.S.P.Q.2d (BNA) 1831 (11th Cir.1997).

²⁸⁰ *Id.* at 1201, 43 U.S.P.Q.2d at 1832.

²⁸¹ *Id.* at 1204, 43 U.S.P.Q.2d at 1834.

²⁸² *Id.* at 1207, 43 U.S.P.Q.2d at 1837.

²⁸³ *Id.* at 1204-05, 43 U.S.P.Q.2d at 1834-35.

²⁸⁴ *Id.* at 1203-05, 43 U.S.P.Q.2d at 1834-35 (citing Fair Business Practices Act of 1975, GA.CODE ANN. §§ 10-1-390 to -407 (1994 & Supp.1997); Uniform Deceptive Trade Practices Act, GA.CODE ANN. §§ 10-1-370 to -375 (1994)).

²⁸⁵ *Id.* at 1204, 43 U.S.P.Q.2d at 1834.

²⁸⁶ *Id.* at 1204-05, 43 U.S.P.Q.2d at 1835.

²⁸⁷ *Id.*

²⁸⁸ *Id.* at 1207, 43 U.S.P.Q.2d at 1837.

²⁸⁹ *Id.* at 1205, 43 U.S.P.Q.2d at 1836.

²⁹⁰ *Id.* at 1206, 43 U.S.P.Q.2d at 1836.

²⁹¹ *Id.* (quoting 4 THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 31.19 (4th ed. 1997)).

²⁹² *Id.*

²⁹³ 973 F.Supp. 552, 43 U.S.P.Q.2d (BNA) 1746 (M.D.N.C.1997).

²⁹⁴ *Id.* (citing Federal Trademark Dilution Act as codified at 15 U.S.C.A. §§ 1125(c), 1127 (West 1998)).

295 *Id.*

296 *Id.*

297 949 F.Supp. 409, 42 U.S.P.Q.2d (BNA) 1141 (E.D.Va.1996).

298 *Resorts of Pinehurst*, 973 F.Supp. at 557, 43 U.S.P.Q.2d at 1748.

299 *Id.* at 559-60, 43 U.S.P.Q.2d at 1752-53.

300 *Id.*

301 *Id.* at 560, 43 U.S.P.Q.2d at 1752.

302 *Id.*, 43 U.S.P.Q.2d at 1752-53.

303 *Id.*

304 124 F.3d 1179, 44 U.S.P.Q.2d (BNA) 1144 (9th Cir.1997).

305 *Id.* at 1186, 44 U.S.P.Q.2d at 1149.

306 *Id.* at 1183, 44 U.S.P.Q.2d at 1147 (citing *Ex parte Young*, 209 U.S. 123, 155-57 (1908)).

307 117 S.Ct. 2028 (1997).

308 124 F.3d at 1184, 44 U.S.P.Q.2d at 1147 (quoting *Idaho*, 117 S.Ct. at 2034).

309 *Id.*

310 *Id.*

311 *Id.*, 44 U.S.P.Q.2d at 1148.

312 *Id.*

313 *Id.* at 1185, 44 U.S.P.Q.2d at 1148.

³¹⁴ *Id.*

³¹⁵ *Id.* at 1184, 44 U.S.P.Q.2d at 1149.

³¹⁶ 125 F.3d 806, 44 U.S.P.Q.2d (BNA) 1189 (5th Cir.1997).

³¹⁷ *Id.* at 809-10, 44 U.S.P.Q.2d at 1190-91.

³¹⁸ *Id.* at 809, 44 U.S.P.Q.2d at 1190.

³¹⁹ *Id.* at 810-12, 44 U.S.P.Q.2d at 1191-92 (citing Cal.Civ.Code § 3344 (West 1997)).

³²⁰ *Id.* at 810, 44 U.S.P.Q.2d at 1191.

³²¹ *Id.* at 811, 44 U.S.P.Q.2d at 1192.

³²² *Id.* at 812-14, 44 U.S.P.Q.2d at 1193-94.

³²³ *Id.* at 812 n.1, 44 U.S.P.Q.2d at 1193 n.1.

³²⁴ *Id.* at 814, 44 U.S.P.Q.2d at 1194-95.

³²⁵ 43 U.S.P.Q.2d (BNA) 1904 (D.D.C.1997).

³²⁶ *Id.* at 1905.

³²⁷ *Id.* at 1908.

³²⁸ *Id.*

³²⁹ *Id.* at 1908-10.

³³⁰ *Id.* at 1910.