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Recent Development

RECENT DEVELOPMENTS IN TRADEMARK LAW

Betty Chang<sup>a1</sup>

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## \*66 I. Trademarks and Antitrust

### A. Settlement Agreements and Antitrust: *Clorox Co. v. Sterling Winthrop, Inc.*<sup>1</sup>

The Clorox Co. (Clorox), owner of the PINE-SOL trademark, sued Sterling Winthrop, Inc., owner of the LYSOL trademark. Clorox claimed that a 1987 settlement agreement imposing certain geographic and other limitations on the use of the PINE-SOL mark violated the Sherman Antitrust Act.<sup>2</sup>

In rejecting Clorox's claims, the court determined that the agreement was not *per se* illegal as "the agreement does not effect any of the types of restraints that have historically been condemned as illegal *per se*, such as price fixing, market divisions, tying arrangements, or boycotts."<sup>3</sup> The court also ruled that the agreement was permissible under the rule of reason.

The trademark agreement at issue here does no more than regulate how the name PINE-SOL may be used; it does not in any way restrict Clorox from producing and selling products that compete directly with the LYSOL brand, so long as they are marketed under a brand name other than PINE-SOL.<sup>4</sup>

The court added that "antitrust laws do not exist to protect competitors from agreements that in retrospect turn out to be unfavorable to the complaining party."<sup>5</sup> Furthermore, the agreement "does not entirely prevent Clorox from using the PINE-SOL name to compete against LYSOL products ... . Clorox is only hampered by the restriction that PINE-SOL be advertised primarily as a cleaner rather than primarily as a disinfectant."<sup>6</sup> "The antitrust laws do not guarantee competitors the right to compete free from encumbrances ... so long as competition as a whole is not significantly affected."<sup>7</sup>

### \*67 B. Antitrust as Compulsive Counterclaim in Trademark Action: *Harley-Davidson Motor Co. v. Chrome Specialties, Inc.*<sup>8</sup>

Harley-Davidson (HD), manufactures motorcycles. Chrome Specialties, Inc. (CSI), manufactures and sells motorcycle parts for use, in part, on Harley-Davidson motorcycles and clothing for motorcycle enthusiasts.<sup>9</sup> HD sued CSI in a Wisconsin federal court for trademark infringement, unfair competition, trademark dilution, and state law misappropriation of trademark and trade dress.<sup>10</sup> On the same day that CSI filed an answer to HD's suit, CSI initiated an antitrust action in a Texas state court against HD.<sup>11</sup> HD moved to enjoin CSI from prosecuting the state court action except those counts that were compulsory counterclaims to the trademark action.<sup>12</sup> The federal court granted the motion.<sup>13</sup>

Two rules applied in the court's determination: First, the Seventh Circuit rule:

[W]here an action is filed subsequent to another suit in a different forum[,] the court in the first-filed action may enjoin the subsequent suit if (1) the two suits involve the same parties and identical issues, or (2) the action sought to be enjoined is a compulsory counterclaim to the first-filed action.<sup>14</sup>

Second, Federal Rule of Civil Procedure Rule 13(a). Rule 13(a) requires as a counterclaim any claim arising from the same transaction as that of any opposing party's claim and which does not require for adjudication any third party over whom the court has no jurisdiction.<sup>15</sup>

The court held that the antitrust claims are compulsory counterclaims to the trademark claims.<sup>16</sup> HD's claim was essentially that CSI intentionally caused confusion among consumers by trading on HD's trademarks and goodwill. Thus, CSI injured

HD and CSI was unjustly enriched.<sup>17</sup> CSI's antitrust claims were essentially that (i) HD seeks to enforce its trademarks through frivolous lawsuits, (ii) HD forces HD's dealers to refuse to deal with HD's competitors, and (iii) HD uses shortages of HD motorcycles to control prices.<sup>18</sup>

\***68** Although CSI's claims in the antitrust action went beyond the issues in the trademark action, the two actions have a "logical relationship" to each other.<sup>19</sup> Further, CSI sought injunctive relief in its antitrust action that would prohibit HD from continuing allegedly "frivolous" trademark litigation against CSI which directly affects the trademark action.<sup>20</sup>

CSI argued that the requirements of Rule 13(a) were not met because the court had no personal jurisdiction over dealer-defendants in the antitrust case.<sup>21</sup> The court observed that Rule 13(a) does not define when a third party is required for adjudication,<sup>22</sup> but Rule 19(a) defines a party as indispensable when, "in that person's absence, complete relief cannot be accorded among those already parties."<sup>23</sup> The court concluded that alleged co-conspirators like the Texas dealers were not indispensable parties and were therefore unnecessary for according complete relief.<sup>24</sup>

After determining that CSI had not presented any special circumstances prohibiting such an order, and that HD filed the infringement action before CSI filed its antitrust action, the court granted HD's motion to enjoin CSI from proceeding in the antitrust action.<sup>25</sup>

## II. Substantive Issues

### A. Grounds for Cancellation: *Heroes Inc. v. Boomer Esiason Hero's Foundation Inc.*<sup>26</sup>

Plaintiff owns a 1964 federal service mark registration for the mark HEROES, INC. as used in the provision of charitable services to survivors of police officers and firefighters who died in the line of duty. Defendant adopted the name HEROES FOUNDATION in 1990 in connection with similar services.<sup>27</sup> Plaintiff sued Defendant for trademark infringement and unfair trade practices.<sup>28</sup> Defendant \***69** counterclaimed for cancellation of the plaintiff's registration on the basis that (1) the mark had become generic, (2) the mark falsely suggested a connection with an institution and a national symbol of the United States, (3) the mark consisted of or simulated an insignia of the United States, and (4) the plaintiff improperly uses the mark to misrepresent the source of the services provided in connection with the mark, violating the Lanham Act.<sup>29</sup>

The court rejected all of the defendant's counterclaims. The court held: (1) The mark has not become generic because the relevant public was not shown to understand the word "hero" to signify charitable services provided by the plaintiff.<sup>30</sup> (2) The defendant lacked standing to allege that the plaintiff's mark falsely suggested a connection with an institution of the United States because the defendant was not one of the institutions with which a false connection was alleged;<sup>31</sup> incorporation of the Capitol building by itself does not disqualify a mark from registration;<sup>32</sup> and consumers were not likely to be misled into believing that the plaintiff's charitable services are sponsored by or approved by the federal government.<sup>33</sup> (3) The defendant failed to submit evidence that the Capitol building had been formally adopted to serve as an emblem of governmental authority and thereby became an unregistrable insignia.<sup>34</sup> Further, (4) since the defendant acknowledged that the plaintiff did not seek to pass off its services as those of the defendant, the defendant lacked standing to raise that claim.<sup>35</sup>

### B. False Suggestion of Connection

#### 1. *In re Sloppy Joe's International, Inc.*<sup>36</sup>

Application Sloppy Joe's appealed the final refusal to register its design mark. The mark consisted of a stylized rendering of the name SLOPPY JOE'S arched over a portrait of Ernest Hemingway enclosed in an oval.<sup>37</sup> The registration was refused under Lanham Act Section 2(a) for falsely suggesting a connection with Hemingway \***70** and Section 2(d) for likelihood of confusion with previously registered word marks.<sup>38</sup>

The Board upheld the refusal to register.<sup>39</sup> The Board explained that the fact Hemingway spent substantial time in the applicant's restaurant did not constitute the type of connection contemplated by Section 2(a),<sup>40</sup> and that a permissible connection under Section 2(a) required documented commercial interest.<sup>41</sup> The Board held that without documentary evidence, the commercial interest pleaded by Sloppy Joe's was merely "folklore."<sup>42</sup>

The Board also explained that in a composite mark where the design is a prominent element comprised of a recognizable

portrait of a well-known person, the picture and its literal equivalent are given the same significance in determining likelihood of confusion.<sup>43</sup> Therefore, the mark is unregistrable because it was confusingly similar to the previously registered HEMINGWAY and HEMINGWAY'S word marks.<sup>44</sup>

## **2. Oliveira v. Frito-Lay Inc.<sup>45</sup>**

The defendant, Frito-Lay Inc., had used the plaintiff Astrud Oliveira's recording of *The Girl from Ipanema* as background music in a television commercial for Frito-Lay Baked Lays Potato Crisps that showed images of Miss Piggy "scarfing down" the advertised chips.<sup>46</sup> The plaintiff alleged that the defendants' use of her voice falsely implied her endorsement of Baked Lays.<sup>47</sup> The court denied the defendants' motion to dismiss the plaintiff's complaint.<sup>48</sup>

In deciding the motion to dismiss, the court used the standard that a court accepts as true all well-pleaded factual allegations of the complaint and draws all inferences in favor of the pleader.<sup>49</sup> Accordingly, the court accepted as true the \*71 plaintiff's allegations of strong public recognition of her voice and singing style.<sup>50</sup> The court also found that some intersection of audience may exist for the marks, since "t here is no obvious reason that fans of Oliveira would be drawn to Baked Lays, nor is there any reason that they would not be."<sup>51</sup> The court similarly accepted Oliveira's allegations that use of her recording falsely implied endorsement and the public believed that falsely implied endorsement;<sup>52</sup> and recognized that Oliveira may be able to show that the audience may interpret the background music as an implied endorsement of Baked Lays.<sup>53</sup>

## **C. Similarity or Distinction of Services**

### **1. Porsche Cars North America Inc. v. Manny's Porshop Inc.<sup>54</sup>**

The court granted a preliminary injunction against the defendant, Manny's Porshop, a "mom-and-pop" repair shop for pre-1990 Porsche race cars, for infringing the trademark rights of Porsche NA, the exclusive licensee of Porsche AG, a German corporation.<sup>55</sup> Porsche NA and its dealers or franchisees and certain sublicensees are the only authorized providers of vehicle maintenance services under the Porsche marks.<sup>56</sup>

In issuing the preliminary injunction, the court noted that in addition to the similarities between the marks, the services provided, and between the channels of trade,<sup>57</sup> the sophistication of the buyers may not mitigate the effects of a misused mark.<sup>58</sup> Further, Manny's admission of having referred some callers to Porsche dealers was evidence of actual confusion.<sup>59</sup> Moreover, the court found evidence of intentional infringement in that the assertion that "Porshop" stands for "performance oriented repair shop" was strained at best, and that it would be unlikely that a repair shop specializing in Porsche automobiles chose a name so similar to Porsche \*72 coincidentally.<sup>60</sup> The court ordered the defendant to cease using the name "Porshop" and Porsche's stylized script pending the outcome of the litigation.<sup>61</sup>

### **2. Petro Shopping Center L.P. v. James River Petroleum<sup>62</sup>**

The plaintiff offers a broad range of truck-stop services under the registered trademark PETRO.<sup>63</sup> The defendant uses the name and mark JAMES RIVER PETRO CARD in connection with payment cards used by business vehicle fleet account holders to purchase fuel at unstaffed self-service gas stations.<sup>64</sup> The plaintiff alleged that the defendant's mark infringes and dilutes the plaintiff's mark.<sup>65</sup>

The court found no infringement on the grounds that: (1) the mark PETRO is merely descriptive of the plaintiff's services and is a weak mark;<sup>66</sup> (2) design, color, and other word elements clearly distinguish the marks from each other;<sup>67</sup> (3) the plaintiff's facilities are much larger and offer a wide range of services and facilities, while the defendant's facilities are much smaller and rarely provide anything other than fuel;<sup>68</sup> (4) the plaintiff promotes its wide range of services while defendant promotes its card lock system;<sup>69</sup> (5) the court was unpersuaded by the plaintiff's allegation of intentional infringement;<sup>70</sup> and (6) the plaintiff showed little evidence of actual confusion.<sup>71</sup>

The court also found for the defendant on the dilution claim because the plaintiff failed to show that its mark had acquired fame.<sup>72</sup>

#### \*73 D. Foreign Language Marks: *Horn's Inc. v. Sanofi Beaute Inc.*<sup>73</sup>

The plaintiff Horn's, Inc., who publishes monthly industry forecasting magazines for the fashion industry and offers consulting services to the fashion industry under the mark HERE & THERE. Defendant Sanofi Beaute Inc. markets a perfume under the mark DECI DELA. The French phrase "deci dela" may be interpreted to mean "here and there."<sup>74</sup>

The court granted summary judgment to Sanofi because: (1) although the plaintiff's mark has strength in the fashion forecasting and consulting market, it is not known among consumers of fragrances;<sup>75</sup> (2) although the marks may have similar meaning, that similarity is outweighed by the marks' dissimilar appearance and sound;<sup>76</sup> (3) the two products are not proximate in that they are neither competing, nor complementary products like pancake flour and syrup;<sup>77</sup> (4) since the products are not in competitive proximity and the marks are not similar, confusion based on sophistication of buyers is unlikely;<sup>78</sup> (5) Horn's had submitted insufficient evidence of intent to enter the fragrance market;<sup>79</sup> (6) Horn's lack of evidence of actual confusion when the DECI DELA fragrance had been on the U.S. market for almost two years weighed against a finding of likelihood of confusion;<sup>80</sup> and (7) such facts as high ranking officials of Sanofi's French affiliate had developed the mark based on the French opera *Veronique* and Sanofi had performed a trademark search and relied on the advice of counsel were evidence of a lack of bad faith. The court also held that Sanofi's intent was largely irrelevant in determining if consumers would likely be confused as to source.<sup>81</sup>

#### E. International Reach of the Lanham Act: *Atlantic Richfield Co. v. Arco Globus International Co.*<sup>82</sup>

The court refused to apply the Lanham Act in a trademark infringement case brought by Atlantic Richfield Co. against the Arco Globus International Co.<sup>83</sup> Arco \*74 Globus was formed in 1990,<sup>84</sup> and is primarily involved in the petroleum and oil trading business in the former Soviet Union.<sup>85</sup> Arco Globus only has two employees in the United States, sells to no customers in the United States and sells to no U.S. customers abroad.<sup>86</sup> The plaintiff Atlantic Richfield obtained its first U.S. trademark registration for the ARCO mark in 1909 and has an enormous presence in the U.S. oil and petroleum industry.<sup>87</sup>

The court applied a three-part test to determine whether the Lanham Act applies to activities outside of the United States: (1) whether the defendant is a U.S. citizen; (2) whether a conflict exists between the defendant's trademark rights under foreign law and the plaintiff's rights under U.S. law; and (3) whether the defendant's conduct has a substantial effect on U.S. commerce.<sup>88</sup>

The court held that the Lanham Act does not reach the defendant because although it is a U.S. citizen,<sup>89</sup> the parties submitted no evidence regarding potential conflicts between trademark rights granted by foreign law and domestic law,<sup>90</sup> and the plaintiff had not shown that the defendant's conduct overseas has had a substantial effect on U.S. commerce.<sup>91</sup>

#### F. Trademark Use vs. Descriptive Use: *Sports Authority, Inc. v. Abercrombie & Fitch, Inc.*<sup>92</sup>

The Sports Authority (TSA), a sporting goods retailer, sued Abercrombie & Fitch (A&F) for trademark infringement, unfair competition, dilution, and false advertising under the Lanham Act based on A&F's use of the word "authority" on hangtags, labels, and logos.<sup>93</sup> A&F has a century-long heritage in retail sporting goods but currently operates as a casual apparel retailer. The court granted A&F's motion for summary judgment on the infringement, unfair competition, and dilution claims, but allowed trial to proceed on the false advertising claim.<sup>94</sup>

\*75 TSA owns a federal trademark registration for the trademark THE SPORTS AUTHORITY for apparel.<sup>95</sup> TSA acquired federal registration for the trademark AUTHORITY for apparel after filing the complaint in this case.<sup>96</sup>

A&F has used the word "authority" since 1989 or 1990 in a stylized label with the phrase "The Authority in Haberdashery and Fine Products for Gentlemen."<sup>97</sup> More recently, A&F has used the phrase "Original Outdoor Authority" on T-shirt labels underneath the more prominent word "Abercrombie."<sup>98</sup> TSA uses the phrase "Outdoor Authority" in print and Internet advertising.<sup>99</sup>

A&F claimed that its use of the word "authority" is made in a descriptive sense, which is a permissible fair use of the word.<sup>100</sup>

The court ruled that although in some situations A&F had placed patent and trademark symbols close to the word "authority," which diminishes the descriptive nature of A&F's use of the word, in general, A&F is entitled to use "authority" to describe

its tradition of providing outfits for the outdoors.<sup>101</sup> Moreover, the parties' goods are "somewhat related but not directly competitive,"<sup>102</sup> and A&F's use of the word "authority" is typically descriptive and not similar to TSA's use.<sup>103</sup> Further, TSA had not provided credible evidence of actual confusion,<sup>104</sup> and TSA's evidence of A&F's plans to directly compete with TSA was merely speculative.<sup>105</sup> Thus, no likelihood of confusion was found between the parties' marks.<sup>106</sup> Based on the holding of no likelihood of confusion, the court granted summary judgment to A&F on the infringement and unfair competition counts.<sup>107</sup>

On the dilution count, the court referred to current third-party uses of the word "authority," which diminish any "distinctive or famous" aspect of the word.<sup>108</sup> \*76 Therefore, the court held that the mark "authority" is not so famous as to deserve protection under the federal dilution statute.<sup>109</sup>

On the false advertising count, the court applied the Second Circuit's test of (1) whether the advertisement is literally false, or (2) whether it is likely to mislead or confuse consumers.<sup>110</sup> The court held that although the consumer survey on which TSA relies for evidence of actual confusion is unreliable,<sup>111</sup> the survey and evidence of A&F's close placement of patent and trademark symbols to the word "authority" were sufficient to allow the false advertising claim to survive summary judgment.<sup>112</sup>

### **III. Trademarks and the Internet--Jurisdiction over Website Owner: *Zippo Manufacturing Co. v. Zippo Dot Com Inc.*<sup>113</sup>**

Defendant Zippo Dot Com Inc. operates a web site and an Internet news service from California and provides access to Internet news groups subscribers.<sup>114</sup> Plaintiff manufactures cigarette lighters and has its principal place of business in Pennsylvania.<sup>115</sup> The United States District Court for the Western District of Pennsylvania found jurisdiction over the defendant.

The court based jurisdiction on a state statute which grants jurisdiction over non-resident aliens who "[c]ontract[] to supply services or things in this Commonwealth."<sup>116</sup> Nevertheless, the court analyzed the jurisdictional basis under the federal Constitution.<sup>117</sup>

The court found that the defendant's contracts with approximately three thousand subscribers and Internet access providers in Pennsylvania constituted sufficient minimum contacts with the state and rejected the defendant's argument that its contacts with Pennsylvania subscribers were fortuitous.<sup>118</sup> The court also found that the alleged infringement arose out of the defendant's conduct in Pennsylvania because the object of the defendant's contacts with Pennsylvania residents was to transmit the messages which the plaintiff alleges to infringe and \*77 dilute its ZIPPO mark.<sup>119</sup> Furthermore, the court found that assertion of jurisdiction was reasonable because Pennsylvania has a strong interest in the alleged infringement against a Pennsylvania corporation's trademark, and the plaintiff chose to file suit there.<sup>120</sup>

### **IV. Commissioner Proceedings**

#### **A. General Authorization to Charge Deposit Account: *In re Sky is the Ltd.*<sup>121</sup>**

The applicant's Intent-to-Use application was deemed abandoned after the applicant inadvertently failed to submit a check to cover filing fees for a Statement of Use.<sup>122</sup> The Commissioner reinstated the applicant's application based on a general authorization to charge a deposit account contained in the initial application.<sup>123</sup>

The Commissioner ruled that since the Trademark Rules do not expressly prohibit a general authorization to charge a deposit account for all fees that may be incurred during the pendency of an application, such authorizations may be accepted.<sup>124</sup> In so ruling, the Commissioner overruled *In re Gamla Enterprises, N.A. Inc.*<sup>125</sup> However, such general authorizations will be effective only on petition to the Commissioner.<sup>126</sup>

#### **B. Drawing Pages: *In re No. 120 Corporate Ventures Ltd.*<sup>127</sup>**

The Commissioner granted the petitioner's request to reinstate its original application filing date after the application was returned by the Patent and Trademark Office as incomplete. The application was returned because the drawing of the mark

was larger than the 4" x 4" limit specified by Rule 2.52(c) of the Trademark Rules.<sup>128</sup>

\*78 The Commissioner explained that the drawing size requirement was instituted to facilitate computerized storage and retrieval and to insure accurate reproduction of drawings.<sup>129</sup> The Commissioner ruled that drawings larger than 4" x 4" do substantially meet the requirements of Rule 2.52, as required by Trademark Rule 2.21(a)(3).<sup>130</sup> The Commissioner reasoned that as long as the drawing is legible, the objective of Rule 2.21(a)(3) is met in that the drawing provides public notice of marks intended to be registered.<sup>131</sup> "Thus, most drawings can be interpreted as substantially meeting the requirements of Rule 2.52."<sup>132</sup> The Commissioner further commented that "while reducing the size of drawings can increase application-processing time, strict enforcement of Rule 2.52 results in the denial of a filing date."<sup>133</sup> In so ruling, the Commissioner overruled *In re Fuller-Jeaney Broadcasting Corp.*<sup>134</sup>

However, the 4" x 4" requirement will be strictly enforced as a prerequisite to registration, because black and white drawings no larger than 4" x 4" are necessary for publication in the *Official Gazette* and in the preparation of registration certificates.<sup>135</sup> "The Legal Instruments Examiners in the Pre-Examination Section will prominently flag drawings that are not in compliance with Rule 2.52, so that Examining Attorneys can issue requests for acceptable drawings."<sup>136</sup>

A filing date will continue to be denied when an application contains no drawing page, lacks a trademark on the drawing page, puts color on the trademark on the drawing page, or when the drawing page contains no heading.<sup>137</sup>

## **V. Federal Trademark Dilution Act of 1995--Retroactive Application: *Circuit City Stores, Inc. v. OfficeMax, Inc.*<sup>138</sup>**

CarMax, a wholly owned subsidiary of Circuit City Stores, Inc., sought a declaratory judgment against OfficeMax, Inc., an operator of office supply superstores<sup>139</sup> under the Federal Dilution Act (15 U.S.C. § 1125).<sup>140</sup> The court \*79 granted judgment to CarMax, holding that the Dilution Act cannot be applied retroactively.<sup>141</sup>

CarMax began operations in 1993.<sup>142</sup> Currently, five CarMax stores are operating in four states, and \$12 million have been spent in promoting the CarMax name.<sup>143</sup> OfficeMax began promoting the OfficeMax service mark in 1988, and has spent more than \$100 million on promoting this mark.<sup>144</sup> The Dilution Act took effect on January 16, 1996.<sup>145</sup>

Relying on *Landgraf v. USI Film Products*,<sup>146</sup> the court examined the Dilution Act for "the clear intent of Congress with respect to retroactivity."<sup>147</sup> Finding both the statute's text and legislative history silent on retroactivity,<sup>148</sup> the court analyzed the Dilution Act for whether it "attaches new legal consequences to events completed before its enactment"<sup>149</sup> as judged by "familiar considerations of fair notice, reasonable reliance and settled expectations."<sup>150</sup>

Prior to enactment of the Dilution Act, federal trademark claims had to be based on likelihood of confusion.<sup>151</sup> The Dilution Act created a new federal cause of action for owners of famous marks based on loss of distinctiveness or tarnishment of a mark without requiring likelihood of confusion or that the parties' marks be used on competing goods.<sup>152</sup> "Thus, the Dilution Act significantly expanded the reach of the Lanham Act by creating new obligations, imposing new duties, and attaching new disabilities with respect to marks already adopted."<sup>153</sup> The court reasoned that if the Dilution Act were to be retroactively applied to CarMax, CarMax could "lose its very identity, achieved as the result of conduct and commercial investment, \*80 which was perfectly lawful at the time."<sup>154</sup> Thus, retroactive application would violate the "considerations of fairness."<sup>155</sup>

OfficeMax argued that *Landgraf* allows prospective application of a new statute against past conduct that may continue.<sup>156</sup> The court rejected this argument, and explained that the cases cited in *Landgraf* involved acts that were already illegal but were subject to new remedies as the result of new legislation, whereas CarMax's conduct was perfectly lawful until enactment of the Dilution Act.<sup>157</sup>

OfficeMax also argued that since the Dilution Act had been written about and discussed since the late 1980's, and half the states had dilution statutes in 1993, CarMax could not have been surprised by the enactment of the Dilution Act. Therefore, OfficeMax argued, the Dilution Act should apply retroactively to CarMax.<sup>158</sup> The court rejected this argument by explaining that "expectations, in retroactivity jurisprudence, are those grounded in the law controlling conduct at the time it occurred."<sup>159</sup> Since no federal cause of action for dilution existed when the CarMax name was adopted, and the then-existing state dilution laws varied in significant ways from the federal law-- many required evidence of confusion, some provided no monetary relief as the federal Dilution Act does--CarMax was justified in adopting its name more than two years prior to enactment of the Dilution Act.<sup>160</sup>

## Footnotes

<sup>a1</sup> Arnold, White & Durkee, Austin, Texas.

<sup>1</sup> 117 F.3d 50, 43 U.S.P.Q.2d (BNA) 1161 (2d Cir. 1997).

<sup>2</sup> *Id.* at 52, 43 U.S.P.Q.2d at 1162 (citing 15 U.S.C. § 1 (1994)).

<sup>3</sup> *Id.* at 56, 43 U.S.P.Q.2d at 1165.

<sup>4</sup> *Id.* at 57, 43 U.S.P.Q.2d at 1166.

<sup>5</sup> *Id.*

<sup>6</sup> *Id.* at 58-59, 43 U.S.P.Q.2d at 1168.

<sup>7</sup> *Id.* at 59, 43 U.S.P.Q.2d at 1168.

<sup>8</sup> 173 F.R.D. 250, 43 U.S.P.Q.2d (BNA) 1144 (E.D. Wis. 1997).

<sup>9</sup> *Id.* at 251, 43 U.S.P.Q.2d at 1145.

<sup>10</sup> *Id.* at 251, 43 U.S.P.Q.2d at 1145.

<sup>11</sup> *Id.*

<sup>12</sup> *Id.* at 251, 43 U.S.P.Q.2d at 1145-46.

<sup>13</sup> *Id.* at 254, 43 U.S.P.Q.2d at 1148.

<sup>14</sup> *Id.* at 251, 43 U.S.P.Q.2d at 1146 (citing *Warshawsky & Co. v. Arcata Nat'l Corp.*, 552 F.2d 1257, 1261-63 (7th Cir. 1977); *Martin v. Graybar Elec. Co.*, 266 F.2d 202, 203-05 (7th Cir. 1959)).

<sup>15</sup> *Id.* at 251-52, 43 U.S.P.Q.2d at 1146 (citing *FED. R. CIV. P.* 13(a)).

<sup>16</sup> *Id.* at 254, 43 U.S.P.Q.2d at 1148.

<sup>17</sup> *Id.* at 252, 43 U.S.P.Q.2d at 1146.

18 *Id.*

19 *Id.* 43 U.S.P.Q.2d at 1147.

20 *Id.* at 252-53, 43 U.S.P.Q.2d at 1147.

21 *Id.* at 253, 43 U.S.P.Q.2d at 1147.

22 *Id.*

23 *Id.* (citing FED. R. CIV. P. 19(a)).

24 *Id.* (citing *Lawlor v. National Screen Serv. Corp.*, 349 U.S. 322, 329-30 (1955); 7 CHARLES ALAN WRIGHT ET AL., FEDERAL PRACTICE AND PROCEDURE § 1623, at 346-47 (2d ed. 1986)).

25 *Id.* at 254, 43 U.S.P.Q.2d at 1148.

26 43 U.S.P.Q.2d (BNA) 1193 (D.D.C. 1997).

27 *Id.*

28 *Id.* at 1195.

29 *Id.*

30 *Id.* at 1196.

31 *Id.* at 1197.

32 *Id.*

33 *Id.*

34 *Id.* at 1198.

35 *Id.*

36 43 U.S.P.Q.2d (BNA) 1350 (T.T.A.B. 1997).

37 *Id.* at 1352.

<sup>38</sup> *Id.* at 1352, 1355 (citing Lanham Act § 2(a), (d), 15 U.S.C. § 1052(a), (d) (1994)).

<sup>39</sup> *Id.* at 1355-56.

<sup>40</sup> *Id.* at 1354.

<sup>41</sup> *Id.*

<sup>42</sup> *Id.*

<sup>43</sup> *Id.* at 1355.

<sup>44</sup> *Id.* at 1356.

<sup>45</sup> 43 U.S.P.Q.2d (BNA) 1455 (S.D.N.Y. 1997).

<sup>46</sup> *Id.* at 1457. Astrud Oliveira is also known as Astrud Gilberto. *Id.* at 1456. The court makes reference to Gilberto throughout the case.

<sup>47</sup> *Id.* at 1457.

<sup>48</sup> *Id.* at 1459.

<sup>49</sup> *Id.*

<sup>50</sup> *Id.* at 1458.

<sup>51</sup> *Id.* at 1458-59.

<sup>52</sup> *Id.* at 1459.

<sup>53</sup> *Id.*

<sup>54</sup> 43 U.S.P.Q.2d (BNA) 1475 (N.D.Ill. 1997).

<sup>55</sup> *Id.* at 1479.

<sup>56</sup> *Id.* at 1476.

57        *Id.* at 1477.

58        *Id.* at 1478.

59        *Id.*

60        *Id.*

61        *Id.* at 1479.

62        41 U.S.P.Q.2d (BNA) 1853 (E.D. Va. 1997).

63        *Id.* at 1854.

64        *Id.*

65        *Id.*

66        *Id.* at 1855.

67        *Id.*

68        *Id.* at 1856.

69        *Id.*

70        *Id.*

71        *Id.*

72        *Id.*

73        963 F. Supp. 318, 43 U.S.P.Q.2d (BNA) 1008 (S.D.N.Y. 1997).

74        *Id.* at 320, 43 U.S.P.Q.2d at 1010.

75        *Id.* at 322, 43 U.S.P.Q.2d at 1012.

76        *Id.* at 323, 43 U.S.P.Q.2d at 1013.

77 *Id.* (citing *Aunt Jemima Mills Co. v. Rigney & Co.*, 247 F. 407, 409-10 (2d Cir. 1917)).

78 *Id.* at 324-25, 43 U.S.P.Q.2d at 1014.

79 *Id.* at 325, 43 U.S.P.Q.2d at 1015.

80 *Id.* at 325-26, 43 U.S.P.Q.2d at 1015.

81 *Id.* at 326, 43 U.S.P.Q.2d at 1015-16.

82 43 U.S.P.Q.2d (BNA) 1574 (S.D.N.Y. 1997).

83 *Id.* at 1579.

84 *Id.* at 1575.

85 *Id.* at 1576.

86 *Id.* at 1577.

87 *Id.* at 1575-76.

88 *Id.* at 1578.

89 *Id.*

90 *Id.* at 1578-79

91 *Id.* at 1579.

92 965 F. Supp. 925, 42 U.S.P.Q.2d (BNA) 1662 (E.D. Mich. 1997).

93 *Id.* at 928, 42 U.S.P.Q.2d at 1663.

94 *Id.* at 942, 42 U.S.P.Q.2d at 1674.

95 *Id.* at 929, 42 U.S.P.Q.2d at 1664.

96 *Id.*

<sup>97</sup> *Id.* at 930, 42 U.S.P.Q.2d at 1665.

<sup>98</sup> *Id.* at 930-31, 42 U.S.P.Q.2d at 1665.

<sup>99</sup> *Id.* at 929-30, 42 U.S.P.Q.2d at 1664-65.

<sup>100</sup> *Id.* at 931-32, 934, 42 U.S.P.Q.2d at 1666, 1669.

<sup>101</sup> *Id.* at 936-37, 42 U.S.P.Q.2d at 1669-70.

<sup>102</sup> *Id.* at 937, 42 U.S.P.Q.2d at 1671 (citation omitted).

<sup>103</sup> *Id.* at 937-38, 42 U.S.P.Q.2d at 1671.

<sup>104</sup> *Id.* at 939-41, 42 U.S.P.Q.2d at 1672-73.

<sup>105</sup> *Id.* at 940, 42 U.S.P.Q.2d at 1672-73.

<sup>106</sup> *Id.*

<sup>107</sup> *Id.* at 941, 42 U.S.P.Q.2d at 1673.

<sup>108</sup> *Id.*

<sup>109</sup> *Id.*

<sup>110</sup> *Id.* (citing *Johnson & Johnson v. Smithkline Beecham Corp.*, 960 F.2d 294, 297, 22 U.S.P.Q.2d (BNA) 1362, 1365-66 (2d Cir. 1992)).

<sup>111</sup> *Id.* at 932-33, 42 U.S.P.Q.2d at 1667-68.

<sup>112</sup> *Id.* at 942, 42 U.S.P.Q.2d at 1674.

<sup>113</sup> 952 F. Supp. 1119, 42 U.S.P.Q.2d (BNA) 1062 (W.D. Pa. 1997).

<sup>114</sup> *Id.* at 1121, 42 U.S.P.Q.2d at 1063-64.

<sup>115</sup> *Id.*, 42 U.S.P.Q.2d at 1064.

<sup>116</sup> *Id.* at 1122, 42 U.S.P.Q.2d at 1065 (citing 42 PA. CONS. STAT. ANN. § 5322(a) (West Supp. 1997)).

<sup>117</sup> *Id.*

<sup>118</sup> *Id.* at 1126, 42 U.S.P.Q.2d at 1068.

<sup>119</sup> *Id.* at 1127, 42 U.S.P.Q.2d at 1069.

<sup>120</sup> *Id.*

<sup>121</sup> 42 U.S.P.Q.2d(BNA) 1799 (Comm'r Pats. 1997).

<sup>122</sup> *Id.* at 1799.

<sup>123</sup> *Id.* at 1799-1800.

<sup>124</sup> *Id.* at 1800.

<sup>125</sup> *Id.* (overruling *In re Gamla Enterprises, N.A. Inc.*, 33 U.S.P.Q.2d (BNA) 1476 (Comm'r Pats. 1994)).

<sup>126</sup> *Id.*

<sup>127</sup> 42 U.S.P.Q.2d (BNA) 1734 (Comm'r Pats, 1997).

<sup>128</sup> *Id.* at 1735 (citing 37 C.F.R. § 2.52 (1996)).

<sup>129</sup> *Id.* (citing 51 Fed. Reg. 29,920 (1986)).

<sup>130</sup> *Id.* at 1736.

<sup>131</sup> *Id.* at 1735-36.

<sup>132</sup> *Id.* at 1736.

<sup>133</sup> *Id.*

<sup>134</sup> *Id.* (overruling *In re Fuller-Jeaney Broadcasting Corp.*, 16 U.S.P.Q.2d (BNA) 1456 (Comm'r Pats, 1990)).

<sup>135</sup> *Id.*

<sup>136</sup> *Id.*

<sup>137</sup> *Id.*

<sup>138</sup> 949 F. Supp. 409, 42 U.S.P.Q.2d (BNA) 1194 (E.D. Va. 1996).

<sup>139</sup> *Id.* at 410, 42 U.S.P.Q.2d at 1195.

<sup>140</sup> 15 U.S.C.A. § 1125 (West Supp. 1997) [hereinafter the Dilution Act].

<sup>141</sup> *Id.* at 410, 418-19, 42 U.S.P.Q.2d at 1195, 1203.

<sup>142</sup> *Id.* at 411, 42 U.S.P.Q.2d at 1196.

<sup>143</sup> *Id.*

<sup>144</sup> *Id.* at 410, 42 U.S.P.Q.2d at 1196.

<sup>145</sup> *Id.* at 412, 42 U.S.P.Q.2d at 1197.

<sup>146</sup> 511 U.S. 244 (1994).

<sup>147</sup> 949 F. Supp. at 413-14, 42 U.S.P.Q.2d at 1198-99 (citing *Landgraf*, 511 U.S. at 272, 280).

<sup>148</sup> 949 F. Supp. at 414, 42 U.S.P.Q.2d at 1199.

<sup>149</sup> *Id.* (citing *Landgraf*, 511 U.S. at 270).

<sup>150</sup> *Id.*

<sup>151</sup> *Id.* at 415, 42 U.S.P.Q.2d at 1200 (citing 15 U.S.C. §§ 1114, 1125 (1994)).

<sup>152</sup> *Id.* at 412, 415, 42 U.S.P.Q.2d at 1197, 1200.

<sup>153</sup> *Id.* at 415, 42 U.S.P.Q.2d at 1200.

<sup>154</sup> *Id.*

<sup>155</sup> *Id.* (citing *Landgraf* v. USI Film Prods., 511 U.S. 244, 265-66 (1994)).

<sup>156</sup> *Id.* at 417, 42 U.S.P.Q.2d at 1201.

<sup>157</sup> *Id.*

<sup>158</sup> *Id.*, 42 U.S.P.Q.2d at 1201-02.

<sup>159</sup> *Id.* at 418, 42 U.S.P.Q.2d at 1202.

<sup>160</sup> *Id.* at 418-19, 42 U.S.P.Q.2d at 1202-03.