

Trademark, Trade Dress and Trade Secret Litigation

Examples of Trademark Infringement, Trademark Dilution, Trade Dress And Trade Secret Cases

Rhino Sports, Inc. v. Sport Court, Inc. (D. Ariz.). Zelle attorneys represented Rhino Sports in this trademark action involving alleged improper use of claimed trademarks and other terms in keyword and sponsored link advertising. Zelle attorneys successfully defended Rhino Sports in a contempt proceeding alleging trademark infringement and breach of a stipulated injunction entered in a prior proceeding. The case also involved antitrust counterclaims asserted by Rhino Sports against Sport Court. The case settled on terms favorable to our client. Opinions: *Rhino Sports, Inc. v. Sport Court, Inc.*, 2007 WL 1302745 (D. Ariz. Apr. 5, 2007)

Trademark and trade dress infringement, unfair competition action (N.D. Cal.). Zelle attorneys represented a manufacturer of fire protection equipment in this case, which involved claims for trademark and trade dress infringement under the Lanham Act, and state common law claims. The defendant allegedly distributed fire protection equipment featuring plaintiff's marks and improperly used depictions of plaintiff's products to sell other companies' fire protection equipment. Zelle attorneys obtained a temporary restraining order and stipulated permanent injunction against the defendant enjoining the defendant from unauthorized use of plaintiff's marks, product depictions and trade dress.

Kellogg Company v. Exxon Mobil Corp. (W.D.Tenn. and 6th Cir.). Zelle attorneys represented Kellogg in this trademark infringement and dilution action against Exxon Mobil Corporation. The case involved Kellogg's famous anthropomorphic cartoon tiger, TONY THE TIGER, and the cartoon tiger used by Exxon in the 1960s to promote its motor fuels. In the lawsuit, Kellogg alleged that Exxon abandoned its Cartoon Tiger in the 1980s, reintroduced it in the 1990s in a modified form, and began to use it to directly promote food products, beverage products and convenience store services at its service stations. Kellogg claimed that this recent expansion of use of the Exxon cartoon tiger into the food, beverage and convenience store services areas infringed and diluted Kellogg's TONY THE TIGER mark. In August of 1998, the federal district court in Memphis granted summary judgment in Exxon's favor.

On April 6, 2000, however, the Sixth Circuit Court of Appeals, reversed and remanded the case for trial on Kellogg's trademark infringement claims. *Kellogg Company v. Exxon Corp.*, 209 F.3d 562 (6th Cir. 2000). In June 2001, the district court additionally upheld Kellogg's claim for dilution by blurring under the Federal Trademark Dilution Act ("FTDA"), concluding that Kellogg had shown proof of "actual dilution" by blurring sufficient to defeat Exxon's motion for summary judgment. *Kellogg Co. v. Exxon Mobil Corp.*, 192 F.Supp.2d 790 (W.D.Tenn. 2001). Key issues raised by the litigation and appeal included laches, acquiescence, abandonment, progressive encroachment and myriad issues under the FTDA.

NBA Properties, Inc. v. ABA, Inc. et al. (E.D.N.Y.). Zelle attorneys represented the original founders of the American Basketball Association in a trademark infringement action brought by NBA Properties, Inc. ("NBAP"). This case involved ABA, Inc.'s efforts to launch a new basketball league called "ABA2000," and allegations by NBAP that use of the "ABA" mark infringed NBAP's alleged rights in that mark. Zelle attorneys had represented the ABA in the 1970s in antitrust proceedings against NBA. Trademark issues presented by this litigation included, among others, the validity of NBAP's trademark registrations, whether NBAP's alleged use of the ABA marks has been "sham" or mere "token" use designed to reserve rights in the mark, and the scope of protection provided by certain trademark registrations.

Gardetto's Bakery, Inc. v. Kellogg Company (D. Minn.). Zelle attorneys represented Kellogg in this action alleging trademark infringement and trademark dilution under the Lanham Act and state unfair competition laws. In this case, the plaintiff claimed that Kellogg's use of the term "SNACK'UMS™" for a cereal-based snack food product infringed and diluted the plaintiff's federally registered "SNAK-ENS®" mark, which the plaintiff used on its snack mix products. The plaintiff filed its complaint in late-October 1999, filed a motion for a preliminary injunction in November 1999, and sought to enjoin Kellogg's nationwide product launch scheduled for January 2000. Zelle attorneys expeditiously assembled and submitted to the court extensive evidence, including survey evidence, supporting Kellogg's opposition to the motion for a preliminary injunction. Oral argument on the motion was held in mid-December 1999, and the court denied the plaintiff's motion from the

bench. The case settled thereafter.

Trademark and trade dress infringement, unfair competition action (N.D.Cal. and 9th Cir.). Zelle attorneys represented the plaintiff Kendall-Jackson Winery, Ltd. in this case, which involved, among others, claims for trademark and trade dress infringement under the Lanham Act, and state common law claims. This case, which was tried to a jury and involved an appeal to the Ninth Circuit Court of Appeals, pertained to the labeling and packaging of bottled wine products.

Trade secret misappropriation action (Mich. Cir. Ct., Calhoun Cty. and W.D.Mich.). Zelle attorneys represented the plaintiff in this case, which brought claims for breach of contract and misappropriation of trade secret information. This action was initially filed in Michigan state court and pertained to the product formulations and manufacturing processes for food products. During discovery, Zelle attorneys uncovered evidence of other unlawful conduct on the part of the defendant which enabled the plaintiff to amend its complaint to assert additional claims for unfair competition under the Michigan Consumer Protection Act and the Lanham Act. Shortly after the plaintiff amended its complaint, the matter was removed to federal court and settled favorably.

Trade secret misappropriation action (M.D.Pa.). Zelle attorneys represented the plaintiff in this action which brought claims for breach of contract, misappropriation of trade secret information and conversion. The action pertained to the design and engineering of a mechanical device used in the manufacture of food products, as well as the processes associated with the use of that device. Zelle attorneys obtained a stipulated final judgment and consent decree, which enjoined the defendant from further use or disclosure of the plaintiff's trade secret information.

International trademark infringement action (Intermediate People's Court of Meizhou City; on appeal, High People's Court of Guangdong Province, People's Republic of China). This action involved infringement of the trademarks and trade dress of KELLOGG'S® CORN FLAKES ready-to-eat cereal in the People's Republic of China ("P.R.C."). Kellogg brought this action against the Meizhou Kongalu Nutritious Food Company in the Intermediate

People's Court of Meizhou City, located in the Guangdong Province of the P.R.C. Kellogg alleged claims for violation of P.R.C. Trademark Law, P.R.C. Unfair Competition Law and various international treaties and agreements, including the Paris Convention. Kellogg initially was successful in obtaining a temporary order enjoining Kongalu's sale of the product. The Meizhou Intermediate Court, however, later ruled against Kellogg. Kellogg appealed to the High People's Court of Guangdong province.

Zelle attorneys, who had no involvement in the lower court proceeding, were extensively involved in the appeal of this matter. Zelle attorneys first assisted Kellogg in the search for and retention of new Chinese local counsel; they then worked closely with that counsel in the appellate proceeding. Zelle prepared extensive briefs, affidavits and other materials on a number of legal and evidentiary issues. Zelle supervised the translation of these materials into Chinese, as well as their review and finalization by local counsel. Kellogg obtained a reversal of the lower court's order and a judgment in its favor.

Trade dress infringement and unfair competition claims preliminary injunction hearing (D. Utah). In this case, Zelle attorneys represented the defendant against trade dress infringement and other claims. The plaintiff alleged infringement of a trade dress or product configuration for various plastic food molds under the Lanham Act and related state common law claims. The plaintiff unsuccessfully sought a preliminary injunction against the defendant which would have required a nationwide recall and/or re-labeling of millions of packages of defendant's product. Thereafter, Zelle attorneys obtained summary judgment on all of the plaintiff's state common law claims and the case settled.

Trademark infringement action preliminary injunction hearing (S.D. Ohio). Zelle attorneys represented the defendant in this case, and successfully defeated a motion for preliminary injunction after a two-day hearing. This case involved a broad range of trademark and other issues, including the related goods doctrine, dilution, confusion of sponsorship and the necessary showing for irreparable injury. This matter settled before trial. Published opinion: *Worthington Foods, Inc. v. Kellogg Company*, 732 F.Supp. 1417 (S.D. Ohio 1990).

Trade secret misappropriation and trade disparagement action (Circuit Court, Cook County, Ill., N.D. Ill., C.D. Cal.). Zelle attorneys represented one of the top financial printers in a number of matters involving its competitors. The disputes concerned allegations of stealing trade secrets and employees, as well as trade disparagement and other violations.

Trade secret misappropriation action (N.D. Cal.). Zelle attorneys represented a large company in the semiconductor industry which was accused of stealing trade secrets by one of the largest computer companies in the world.

Examples of False Advertising Matters and Regulatory Cases

Unfair advertising action (W.D. Mich.). In this case, Zelle attorneys represented a defendant in a Lanham Act case involving claims for misleading advertising on product comparisons. Extensive briefing was required in preparation for a court-mandated alternative dispute resolution session. The action settled before trial.

State regulation of advertising (S.D. Iowa). Zelle attorneys represented a national advertiser in this action against various state attorneys general in federal court. The action alleged that the A.G.s' threatened or actual enforcement actions against the plaintiff were preempted by federal law, unduly burdened interstate commerce, improperly restricted free speech, constituted discriminatory enforcement and/or violated the interstate compact clause. This case was favorably settled.

State regulation of food labeling claims (N.D. Tex. and 5th Cir.). Zelle attorneys represented a company seeking to enjoin preliminary enforcement of the Texas Food, Drug and Cosmetic Act as it applied to commercial speech contained on labels of, and in advertising for, certain food products. While the trial court denied a preliminary injunction, the company's position was later vindicated by the United States Supreme Court in opinions such as *Rubin v. Coors Brewing Co.*, 115 S.Ct. 1585 (1995) and *44 Liquormart, Inc. v. Rhode Island*, 116 S.Ct. 1495 (1996).