

Defending Against Trademark Injunction Requests:
A Closer Look at the Cases

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March 2003 to March 2008

- 307 cases concerning TM injunctions
- 172 granted preliminary injunction requests
- 135 denied preliminary injunction requests
- Same 5 years period: 99 permanent injunction request granted; 4 denied

March 2003 to March 2008

- 135 denied preliminary injunction requests
- Lack of Likelihood of Confusion
- Failed to Establish Priority
- Marks Not Entitled to Protection
- Unclean Hand

Successfully Defend Against PI: *No Likelihood of Confusion*

- *Playmakers LLC v. ESPN, Inc.*, 376 F.3d 894 (9th Cir. 2004) (Playmakers vs. Play-makers)
- Plaintiff: Agency representing professional athletes
- Defendant: ESPN's behind-the-scenes view of a fictional professional football team
- Different marketing channel, and high degree of care

Successfully Defend Against PI: *No Likelihood of Confusion*

- *Chicago Tribune Co. v. Fox News Network, LLC*, 520 F. Supp. 2d 930 (N.D. Ill. 2007)
- Plaintiff: free, tabloid-style daily newspaper called the REDEYE
- Defendant: "Redeye with Greg Gutfeld" (talk show)
- Different marks, usage, appearance, marketing channel

Successfully Defend Against PI: *No Likelihood of Confusion*

- *First Franklin Fin. Corp. v. Franklin First Fin., LTD*, 356 F. Supp. 2d 1048 (N.D. Cal. 2005)
- Plaintiff: "First Franklin" for use in mortgage services since 1995
- Defendant: Franklin First Financial
- extensive third-party use; each mark incorporates a different picture; different marketing channel

Successfully Defend Against PI: *No Likelihood of Confusion*

- *Nature's Best, Inc. v. Ultimate Nutrition, Inc.*, 323 F. Supp. 2d 429 (E.D.N.Y. 2004))
- Plaintiff: "Isopure" on a line of whey protein meal replacement/after workout supplements since 1998
- Defendant: "Isopreme" is used on a line of whey protein meal replacement
- Direct competitors, but consumers' sophistication

Successfully Defend Against PI: *No Likelihood of Confusion--Priority*

- *Gonannies, Inc. v. GoAupair.com, Inc.*, 464 F. Supp. 2d 603 (N.D. Tex. 2006)
- Plaintiff: "GoNannies" and registered www.gonannies.com in 2003; TM registration 2005
- Defendant: "goNANI" and the domain name www.gonani.com continuously since 1999
- Defendant's argument on priority defeated Plaintiff's case on the merit

Successfully Defend Against PI: *Marks Not Entitled to Protection*

- *Hasbro, Inc. v. MGA Entm't, Inc.*, 497 F. Supp. 2d 337 (D.R.I. 2007)
- Plaintiff: "Memory" games; TM registered in 1967
- Defendant: "Memory Match-Up" & "3-D Memory Match-Up" games
 - evidence that memory games generic mark before & in 1967
 - Plaintiff's own generic use of the term, calling all of its board games as "memory games"

Successfully Defend Against PI: *Marks Not Entitled to Protection*

- *Vista India v. RAAGA, LLC*, 501 F. Supp. 2d 605 (D.N.J. 2007)
- Plaintiff: "Raaga Entertainment Superstores," which sold Indian and other South Asian music in the United States
- Defendant: RAAGA Indian music downloads and streaming
 - commonly understood to refer to Indian or South Asian music generally, even though it literally meant color or passion or rhythmic patterns

Successfully Defend Against PI: *Marks Not Entitled to Protection*

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Successfully Defend Against PI: No Irreparable Harm

- *Gucci Am., Inc. v. Daffy's, Inc.*, 354 F.3d 228 (3d Cir. 2003)
- Defendant:
 - Gucci "Jackie-O" handbag
 - Instituted policy to handle Gucci products
 - Plaintiff could not demonstrate irreparable harm

Successfully Defend Against PI: *Unclean Hand*

- *First Global Commc'ns v. Bond*, 413 F. Supp. 2d 1150 (W.D. Wash. 2006)
- Plaintiff: "World Sex Guide" website; information about prostitution services in U.S. and worldwide
- Defendant: website "Wsgforum.com" to divert users from plaintiff's site to his own site
- Court: Unclean hand doctrine
 - granting an injunctive relief would have the effect of encouraging illegal activity, and would serve an unconscionable purpose

Successfully Defend Against PI?

- Factually Intensive
- Costly
- Settle After PI Results