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Copyright, Patent & (and) Trademark

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Marker International v. DeBruler, 844 F.2d 763

On appeal, the panel affirmed the district court's grant of summary judgment, which permanently enjoins defendant-appellants from selling or advertising for sale any product bearing the Marker name with the sloping 'M' logo.

In this trademark infringement case, the panel found the appellant's statements constitute an admission that appellee's trademark has a secondary meaning and thus is protectable under the Lanham Act.

Hartford House, Ltd. v. Hallmark Cards, Inc., 846 F.2d 1268

Hallmark appeals the district court's grant of a preliminary injunction, which restrains Hallmark from manufacturing and marketing its "Personal Touch" line of cards during the pendency of this action. Affirmed.

Blue Mountain alleges in the pending action that Hallmark's "Personal Touch" line of greeting cards is deceptively and confusingly similar to Blue Mountain's "AireBrush Feelings" and "Watercolor Feelings" lines. As such, Blue Mountain asserts that Hallmark's "Personal Touch" cards infringe the trade dress, i.e., the overall look of Blue Mountain's cards, in violation of section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) (1982).

The panel finds no error or abuse of discretion by the district court. The district court could issue a preliminary injunction if Blue Mountain established four elements, including a substantial likelihood that it will eventually prevail on the merits. It is this finding by the district court that is the subject of Hallmark's appeal.

The panel concludes that the district court was correct in finding that the combination of the features comprising the trade dress of Blue Mountain's lines of greeting cards is nonfunctional and thus protectable under section 43(a) of the Lanham Act. The issue of functionality turned on whether protecting a combination of features would hinder competition. The district court properly relied on the availability to Hallmark of alternative appealing designs as a key factor in determining that the trade dress of Blue Mountain cards is nonfunctional. Thus, the feature-by-feature functionality analysis encouraged by Hallmark was unnecessary.

San Juan Products v. San Juan Pools, 849 F.2d 468

Plaintiff, San Juan Products, Inc., is suing San Juan Pools and Dwight Lien (collectively Lien) for common law and federal trademark infringement as a form of unfair competition.

The district court found that San Juan's registered trademark was

never exclusive and that its failure to so notify the patent office made the trademark void from the outset, and the claim for violation of common law trademark was "utterly frivolous" since San Juan had never done business in Kansas (where defendant conducted business) and was pursued "for no other reason than to intimidate defendants." The court then denied plaintiff's claims, exercising its "inherent equitable power" to award Lien all expenses and attorney's fees incurred in defense of the case. Both parties appealed.

The Tenth Circuit reversed the voiding of the trademark by holding defendant Lien failed to properly plead and prove the elements of fraud in the procurement of the federal trademark. The district court did not abuse its discretion in awarding attorney's fees for bringing an unfounded action in bad faith.