

article, but merely maintains and sells an inventory of goods previously produced by an original manufacturer which has abandoned the mark, establishes no rights in the mark. In order for a new party to acquire such rights the mark must have ceased being identified with the former owner and the mark must be identified with the new supplier of goods under the mark. *Acme Valve and Fittings Co. v. Wayne, dba Gibraltar, Ltd.*, 183 USPQ 529 (D.C. S.Tex. 1974).

Petitioner in this case has not established that he has acquired rights in the trademark "VORNADO" for reconditioned fans. Petitioner has pleaded standing but cannot prove it. Respondent has shown by the answers to its interrogatories and materials submitted by petitioner in connection with those answers that there are no facts dispute as to petitioner's use of "VORNADO." Petitioner has not established the existence of any genuine issues of fact as to his use of the term as a mark. There is no reason to expect a trial to result in any more evidence on this point than we already have. Moreover, speculation, without supporting evidence, will not suffice to withstand a motion for summary judgment. *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984). Petitioner's plans to use "VORNADO" in the future as a trademark for newly designed fans which have yet to be marketed have no effect on his right to register the word for reconditioned fans.

Petitioner has not, by affidavit or any other evidence, established the existence of a genuine issue of fact as to whether he can be considered to be the owner of the mark for rebuilt electric fans. When confronted with a well supported motion for summary judgment it is petitioner's burden under Rule 56 to support his claim with affidavits on other evidence showing that a genuine issue exists. Petitioner has not met this burden.

Because there are no material facts in issue concerning petitioner's standing and because, based on the undisputed facts of record, respondent is entitled to judgment as to petitioner's standing, respondent's motion for summary judgment is granted.

District Court, S.D. New York

Architemps Inc. v. Architemps Ltd.

No. 88 Civ. 5152

Decided November 2, 1988

TRADEMARKS AND UNFAIR TRADE PRACTICES

1. Acquisition, assignment, and maintenance of marks — Scope of trademark — As to territory (§305.0205)

Acquisition, assignment, and maintenance of marks — Acquisition through use — Priority of use (§305.0503)

"Help wanted" advertisements placed in nationally-distributed newspapers by New York-based "Architemps" firm specializing in temporary jobs for architects and designers do not entitle firm to claim "continuous prior use" of "Architemps" mark in California, in view of evidence showing that no job placements actually occurred outside New York, nor can firm's mere expectations of expanding operations in California, without more, confer priority to mark under common law, and thus owner of federally registered mark "Architemps" is entitled to injunction barring defendant's use of mark in California.

TRADEMARKS AND UNFAIR TRADE PRACTICES

2. Infringement; conflicts between marks — Likelihood of confusion — Particular marks — Marks similar (335.0304.03)

Infringement; conflicts between marks — Likelihood of confusion — Relatedness of goods — Goods similar (§335.0305.03)

REMEDIES

Non-monetary and injunctive — Equitable relief — Preliminary injunctions — Trademarks and unfair trade practices (§505.0707.09)

Defendant's use of "Architemps" mark will cause irreparable injury to business of plaintiff, which owns registered mark "Architemps," in view of likelihood that appreciable number of ordinarily prudent purchasers would be misled or confused as to source of services in question in view of identity of parties' marks and services.

Action by Architemps Inc. against Architemps Ltd., seeking to enjoin defendant from conducting business under mark "Architemps" in California. On plaintiff's motion for preliminary injunction and defendant's cross-motion for summary judgment. Pre-

liminary injunction denied.

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liminary injunction granted; cross-motion denied.

Jane Shay Wald, Amy B. Goldsmith, and George Gottlieb, of Gottlieb, Rackman & Reisman, New York, N.Y. (Daniel L. Kegan and Esther O. Kegan, of Kegan & Kegan, Chicago, Ill., of counsel), for plaintiff.

Pasquale A. Razzano and Marilyn Brogan, of Curtis, Morris & Safford, New York, for defendants.

Owen, J.

Plaintiff Architemps, Inc., located in Chicago, Illinois, has been in the business of placing architects and designers into temporary positions with architecture and interior design firms since 1985. It has held a federally registered trademark in the service mark “Architemps” since December of 1986. Defendant Architemps, Ltd., located in New York, New York, has been in the identical business since 1981; it has never sought trademark registration for its use of the mark “Architemps.” The parties’ current dispute is territorial in nature:¹ in view of defendant’s expressed desire to open an office in California, plaintiff, whose California office has been in operation since March of 1988, seeks to enjoin defendant from conducting its business in California utilizing the “Architemps” mark. In response, defendant cross moves for summary judgment, asserting protection for its use of the mark under common law and the invalidity of plaintiff’s trademark registration, for which it seeks cancellation.² For the reasons set forth below, plaintiff’s motion for a preliminary injunction is granted and defendant’s cross motion for summary judgment is denied.

Ownership of a federally registered trademark is prima facie evidence of the mark’s validity and of the owner’s exclusive right to its use. *Rick v. Buchansky*, 609 F.Supp. 1522, 1529 [226 USPQ 449, 453] (S.D.N.Y. 1985). However, continuous use of the same mark by another predated federal registration serves as a defense to an infringement action “only for the area in which such continuous prior use is proved.” 15 U.S.C. §1115(b)(5). The prior user of an unregis-

tered mark is entitled to common law protection for its continued use of the mark in areas of use that predate registration. *Ace Hardware Co., Inc. v. Ace Hardware Corp.*, 532 F.Supp. 770, 773 [218 USPQ 240, 242] (N.D.N.Y. 1982); see also *Natural Footwear Ltd. v. Hart, Schaffner & Marx*, 760 F.2d 1383, 1395 [225 USPQ 1104, 1111-12] (3d Cir.), cert. denied, 474 U.S. 920 (1985).

[1] Since defendant as the senior and unregistered user of the mark “Architemps” has failed to show actual use of the mark in California predating plaintiff’s federal registration, I find that plaintiff has demonstrated likelihood of success on the merits.³ From the essentially undisputed factual picture presented by the parties, it appears that defendant’s activities in soliciting clients to utilize its temporary workers have basically been restricted to the New York metropolitan area. Defendant relies upon advertisements it placed in various newspapers, including allegedly national distributed sections of the New York Times, the Chicago Tribune, and “other newspapers in Boston, San Francisco, Houston, Seattle and San Diego” to demonstrate that it has established a national reputation in the architectural community for providing the services of architects and designers on a temporary basis prior to plaintiff’s registration. However, the vast majority of these advertisements are of the “Help Wanted” variety and cannot be considered *client* solicitation or promotion of its services. In any event, any advertisements (“Help Wanted” or otherwise) placed in California newspapers after December, 1986, the date of plaintiff’s trademark registration,⁴ do not entitle defendant to claim “continuous prior use” of the mark in California. Significantly, the deposition testimony of defendant’s principal indicates that, although some of the “Help Wanted” advertisements indicated the availability of tempo-

³ Plaintiff’s status as an innocent user of the “Architemps” service mark following a March, 1986 search of business and corporate listings, trade names, trade directories and telephone directories is not contested by defendant.

⁴ See Exhibit 19 of defendant’s declaration in opposition to plaintiff’s motion (“Help Wanted” advertisement placed in the May 15, 1988 Los Angeles Times) and Fields deposition at 135.

Defendant’s Exhibit 20 is a want ad invoice from the San Francisco Chronicle dated September, 1986, which predates plaintiff’s registration. However, there is no indication that this ad solicited clients rather than temporary workers, nor does it rebut defendant’s deposition testimony that defendant has not made any placements with architectural firms in California to date.

¹ Plaintiff concedes defendant’s rights to use the name “Architemps” in the New York metropolitan area, so long as defendant disclaims affiliation with plaintiff.

² The parties have agreed to stay cancellation proceedings pending the outcome of this litigation.

rary job placements in cities other than New York, such placements never actually occurred (Fields deposition, pages 132-37, 141-42). Moreover, defendant neither maintains an office nor has clients with which it placed temporary workers in California to date (*id.* at 138, 153). In light of defendant's extremely limited presence outside the New York metropolitan area, I find that defendant does not enjoy common law trademark protection in the state of California so as to prevail over the federally registered plaintiff. Defendant's mere expectation of expanding operations in California, without more, cannot confer priority to the mark under common law. *See Liqwacon Corp. v. Browning-Ferris Industries, Inc.*, 203 U.S.P.Q. (BNA) 305, 309 (T.T.A.B. 1979) (prior use confers superior rights in mark when there is "a viable corporation and, as in the case of a . . . service mark, 'open and notorious' use thereof calculated to come to the attention of customers and prospective customers for the corporation's present or prospective offerings"). Plaintiff's use of the mark in California is therefore entitled to protection and it has demonstrated a likelihood of success on the merits.

[2] Moreover, the identity of names and services will lead to irreparable injury to plaintiff's business if the parties coexist in California. Clearly, the facts before the Court demonstrate "any likelihood that an appreciable number of ordinarily prudent purchasers are likely to be misled, or indeed simply confused, as to the source of the goods in question" so as to satisfy the standard for finding irreparable injury in a trademark case. *Joseph Scott Co. v. Scott Swimming Pools, Inc.*, 764 F.2d 62, 66 [226 USPQ 496, 570] (2d Cir. 1985), quoting *McGregor-Doniger, Inc. v. Drizzle Inc.*, 599 F.2d 1126, 1130 [202 USPQ 81, 86] (2d Cir. 1979).

In conclusion, plaintiff's motion for a preliminary injunction is granted, and defendant's cross motion for summary judgment is denied.

So ordered.

District Court, D. Maryland

Kahn v. Head

No. HM-85-5027

Decided September 6, 1988

REMEDIES

1. Monetary — Attorney's fees; costs — In general (§510.0901)

Defendant who made offer of judgment that exceeded amount awarded by jury is entitled to costs.

COPYRIGHTS

2. Infringement pleading and practice — Relief and damages — Costs and attorney's fees (§217.1105)

REMEDIES

Monetary — Attorney's fees; costs — Copyright (§510.0909)

Award of attorney's fees to copyright infringement defendant is warranted under 17 USC 505, in view of delay caused by plaintiff's refusal to travel to forum state for discovery, in view of virtually non-existing evidence against defendant, and in view of plaintiff's insistence upon reviewing negligible or unavoidable similarities between his and defendant's catalogs, which caused trial to be greatly extended.

Action by Harry C. Kahn, III against Harry W. Head, for copyright infringement, unfair competition, misrepresentation, product disparagement, unjust enrichment, and misappropriation. On plaintiff's motion for j.n.o.v., and defendant's motion for costs. Defendant's motion granted.

Stuart E. Beck, Philadelphia, Pa., and Morton J. Rosenberg, of Rosenberg, Maleson & Bilker, Columbia, Md., for plaintiff.

JoAnne S. Beery and Leonard Bloom, of Law Offices of Leonard Bloom, Towson, Md., for defendant.

Murray, J.

Plaintiff Harry Kahn ("Kahn") sued defendant Harry Head ("Head") for copyright infringement in violation of 17 U.S.C. §501 *et seq.*; unfair competition; misrepresentation in violation of 15 U.S.C. §1123(a); product disparagement; and unjust enrichment and misappropriation. Both plaintiff and defendant are manufacturers and sellers of jumps for horses. Jury trial commenced on January 20, 1987. After the close of the plaintiff's evidence, the Court granted directed verdict on Counts 3, 4 and 5, and permitted Counts 1 and 2, those for copyright infringement and unfair competition, to go to the jury. On February 5, 1987, the jury found for defendant on both of these counts.

Pending before the Court are plaintiff's motion for judgment notwithstanding the verdict under Rule 50(b) Fed.R.Civ.P., Paper No. 43,¹ and defendant's motion for costs, Paper No. 42. The Court has reviewed the memoranda submitted by the parties and

¹ The number is the docket entry number in the official Court file.

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