LOUIS VUITTON MALLETIER S.A v. HAUTE DIGGITY DOG, LLC

1:06cv321 (JCC) (E.D. Va. 2006)

MEMORANDUM OPINION

JAMES C. CACHERIS, DISTRICT JUDGE

This matter comes before the Court on Plaintiff's and Defendants' cross-motions for summary judgment. This "dog of a case" gave the Court a great amount of facts to chew upon and applicable law to sniff out. Nonetheless, having thoroughly gnawed through the record, this Court finds that no material dispute of fact remains, and summary judgment is appropriate on all counts. For the following reasons, the Court will deny Plaintiff's motion and grant Defendants' motion.

I. Background

Plaintiff, Louis Vuitton Malletier S.A., ("LVM") is a manufacturer of luxury consumer goods, including luggage and handbags. In 1896, LVM created a Monogram Canvas Pattern Design mark and trade dress, which includes, *inter alia,* an entwined L and V monogram with three motifs and a four pointed star, and is used to identify its products. In 2002, Vuitton introduced a new signature design in collaboration with Japanese designer Takashi Murakami. LVM manufactures a limited number of high-end pet products, such as leashes and collars that range in price from $ 250 to $ 1600.

Plaintiff filed this action on March 24, 2006 against Defendants Haute Diggity Dog, LLC ("HDD"), Victoria Dauernheim, and Woofies, LLC d/b/a Woofie's Pet Boutique. HDD is a company that markets plush stuffed toys and beds for dogs under names that parody the products of other companies. HDD sells products such as Chewnel # 5, Dog Perignon, Chewy Vuiton, and Sniffany & Co. in pet stores, alongside other dog toys, bones, beds, and food, and most are priced around $ 10. Plaintiff's complaint specifically refers to HDD's use of the mark "Chewy Vuiton" and alleges that this mark, as well as other marks and designs that imitate Plaintiff's trademarks and copyrights, violate Plaintiff's trademark, trade dress, and copyright rights. Plaintiff and Defendants have filed cross-motions for summary judgment. These motions are currently before the Court.

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III. Analysis

Count I: Trademark Infringement

Plaintiff and Defendants have filed cross-motions for summary judgment on the issue of trademark infringement. To prevail on a claim for trademark infringement, Plaintiff must show that it possesses a protectable mark, which Defendants used in commerce in connection with sale, offering for sale, distribution, or advertising in a manner likely to confuse customers. *People for Ethical Treatment of Animals v. Doughney,* 263 F.3d 359, 364 (4th Cir. 2001). The unauthorized use of a trademark infringes the trademark holder's rights if it is likely to confuse an "ordinary consumer" as

to the source or sponsorship of the goods. *Anheuser-Busch, Inc. v. L&L Wings, Inc.,* 962 F.2d 316, 318 (4th Cir. 1992).

Factors considered when determining the likelihood of confusion are: (1) strength and distinctiveness of the plaintiff's mark; (2) degree of similarity between the two marks; (3) similarity of the products that the marks identify; (4) similarity of the facilities the two parties use in their business; (5) similarity of the advertising used by the two parties; (6) defendant's intent; and (7) actual confusion. *Pizzeria Uno Corp. v. Temple,* 747 F.2d 1522, 1527 (4th Cir. 1984). No single factor is dispositive, and these factors are not of equal importance or relevance in every case. *Petro Shopping Centers v. James River Petroleum, Inc.,* 130 F.3d 88, 91 (4th Cir. 1997). This Court must carefully consider each of these factors and determine by a totality of the circumstances if likelihood of confusion exists, and then determine if summary judgment is appropriate for Plaintiff or Defendants.

[After examining the *Pizzeria Uno* factors, the court concludes that confusion is unlikely.]

H. Conclusion for Trademark Infringement

For the foregoing reasons, this Court finds, taking the evidence in the light most favorable to the Plaintiff, no reasonable trier of fact would conclude that likelihood of confusion exists between Plaintiff's and Defendants' products. .... For these reasons, the Court concludes that summary judgment is appropriate on the issue of trademark infringement. The Court will therefore deny Plaintiff's motion for summary judgment and grant Defendants' cross-motion on the count of trademark infringement.

Count II: Dilution

Plaintiff seeks an injunction under the Federal Trademark Dilution Act (FTDA), 15 U.S.C. ß 1125(c). The Trademark Dilution Act provides that the owner of a famous mark can enjoin "another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark." *CareFirst of Maryland, Inc. v. First Care,* 434 F.3d 263, 274 (4th Cir. 2006) (citing 15 U.S.C. ß 1127). The Fourth Circuit has defined dilution as "the lessening of the capacity of a famous mark to identify and distinguish goods or services." *Id.*

While a court may find dilution even where it does not find likelihood of confusion, *Id.,* the Supreme Court has held that the dilution statute "unambiguously requires a showing of actual dilution, rather than a likelihood of dilution." *Moseley v. Secret Catalogue, Inc.,* 537 U.S. 418, 433, 123 S. Ct. 1115, 155 L. Ed. 2d 1 (2003). Actual dilution occurs by either a blurring of the mark's identification or a tarnishment of the positive associations the mark has come to convey. *See id.* This action commenced on March 24, 2006. However, following the commencement of litigation, the dilution statute was amended by Congress to exclude the "actual dilution" requirement in place of a "likely dilution" one. *See* Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, 120 Stat. 1730 (amending 15 U.S.C. ß 1125(c) (1946)). …

…In this case, Plaintiff has pled for injunctive relief on the issue of dilution. Therefore, the amended statute will apply in this case.

A. Dilution by Blurring

Dilution by blurring is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark. *See* Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, 120 Stat. 1730. Dilution by blurring occurs when consumers mistakenly associate a famous mark with goods and services of a junior mark, thereby diluting the power of the senior mark to identify and distinguish associated goods and services. *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev.,* 955 F. Supp. 605, 616 (E.D. Va. 1997) (citing *Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.,* 875 F.2d 1026, 1031 (2d Cir. 1989). According to the amended statute, in determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

> (i) the degree of similarity between the mark or trade name and the famous mark;
> (ii) the degree of inherent or acquired distinctiveness of the famous mark;
> (iii) the extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark;
> (iv) the degree of recognition of the famous mark;
> (v) whether the user of the mark or trade name intended to create an association with the famous mark; and
> (vi) any actual association between the mark or trade name and the famous mark.

Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, 120 Stat. 1730. Since the Fourth Circuit has not offered opinion on the new "likelihood of dilution" standard, for guidance this Court looks to the Second Circuit's application of New York General Business Law ß 360-l, which incorporates the likelihood of dilution standard now adopted by Congress. Using this standard, the Second Circuit and its district courts have held on numerous occasions that in the case of parody, "the use of famous marks in parodies causes no loss of distinctiveness, since the success of the use depends upon the continued association with the plaintiff." *See Yankee Publ'g, Inc. v. News Am. Publ'g, Inc.,* 809 F. Supp. 267, 282 (S.D.N.Y. 1992) (applying New York statute); *see also Tommy Hilfiger,* 221 F. Supp. 2d at 422-23 ("the presence of a famous mark on certain products may have little diluting effect, particularly where it is obvious that the defendant intends the public to associate the use with the true owner"); *Hormel,* 73 F.3d at 506 (finding no likelihood that defendant's puppet "Spa'am" would dilute the association of the Hormel mark with "Spam" lunchmeat).

Defendants do not dispute that the Plaintiff's mark is strong and famous. Nonetheless, this Court finds no likelihood that the parody of Plaintiff's mark by Defendants will result in dilution of Plaintiff's mark.[5] This Court finds, like the New York and Second Circuit courts, the mark continues to be associated with the true owner, Louis Vuitton. Its strength is not likely to be blurred by a parody dog toy product. Instead of blurring Plaintiff's mark, the success of the parodic use depends upon the continued association with Louis Vuitton. This Court finds that no reasonable trier of fact could conclude that Plaintiff's mark is diluted by blurring in this case, and summary judgment is appropri-

[5] This Court also agrees with Defendants' argument that actual dilution does not exist, but in light of the amended statute concentrates instead on likelihood of dilution.

ate. Accordingly, Defendants' motion for summary judgment will be granted for dilution by blurring.

B. Dilution by Tarnishment

Tarnishment occurs when the plaintiff's trademark is likened to products of low quality, or is portrayed in a negative context. *Deere & Co. v. MTD Prods.,* 41 F.3d 39, 43 (2d Cir. 1994). When the association is made through harmless or clean puns and parodies, however, tarnishment is unlikely. *Jordache Enters. v. Hogg Wyld, Ltd.,* 625 F. Supp. 48, 57 (D.N.M. 1985), *aff'd,* 828 F.2d 1482 (10th Cir. 1987). Plaintiff's assertions that Chewy Vuiton products tarnish LVM's marks by associating "inferior products" with the Vuitton name are baseless, and without merit. Plaintiff provides neither examples of actual tarnishment, nor any evidence that shows likely tarnishment. At oral argument, Plaintiff provided only a flimsy theory that a pet may some day choke on a Chewy Vuiton squeak toy and incite the wrath of a confused consumer against Louis Vuitton. Therefore, even taking into account the amended statute, this Court concludes that no reasonable trier of fact could find for the Plaintiff on the issue of dilution by tarnishment. Accordingly, this Court will grant summary judgment in favor of the Defendants on this issue.

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IV. Conclusion

For the foregoing reasons, will deny Plaintiff's motion for summary judgment and grant Defendants' motion for summary judgment. An appropriate Order will issue.


Amazing Parody
Designer Shoe Toys
Must have
Parody
Designer Bag Toys
Drooly & Bark
Small and Large
Tiny and Regular sizes
all toys have a
squeaky thing inside.
CHEWY VUITON
White Chewy Vuiton
Small and Large
Chewy Vuiton
Cherries
Puggs
Dogior
Small and Large
More>
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Images may not be to scale


Parody Designer Beds
Small Dog Sniffany Bed
CHEWY VUITON
Chewy Vuiton Bed
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5
France
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CO.
Big Dog Sniffany Bed
Teacup Bed
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