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Cases of Note -- Copyright -- The Attrezzi of Trademark Violations -- Reverse Confusion

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LEGAL ISSUES

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Cases of Note — Copyright

The Attrezzi of Trademark Violations — Reverse Confusion

by **Bruce Strauch** (The Citadel) <strauchb@citadel.edu>

Attrezzi, LLC v. Maytag Corporation, United States Court of Appeals For the First Circuit, 436 F.3d 32; 2006 U.S. App. LEXIS 2018 (2006).

Goodness. The First Circuit. One hardly knows it exists. At least in copyright/trademark matters. But here we are.

Jennifer Slade of Portsmouth, New Hampshire opened a lone retail store for high-end kitchen products under the name of **Attrezzi, LLC**. In November, 2003, she registered “Attrezzi” as a New Hampshire trademark and launched a Website which you can visit at www.attrezziinh.com.

And of course we all know the famous brand name appliance-maker **Maytag**. Six months prior to her registration, their marketing whizzes had hit upon the brand name “Attrezzi” for a new line of small kitchen appliances. As they did their customary trademark investigation, their counsel found **Jennifer’s** business and warned this created “a problem.”

The higher-ups were not pleased with this and instructed counsel to “take another look” which presumably meant find us a way over this speedbump. In March 2003 they filed an “intent-to-use” application with the **Patent and Trademark Office (PTO)**. In April they launched **Attrezzi** as a sub-brand of “Jenn-Air” — the “Jenn-Air Attrezzi” line.

PTO approved **Maytag’s** application. **Attrezzi LLC** filed a “use” service mark application for retail store and online use of kitchen and dining stuff. **Maytag** answered there was no likelihood of customer confusion. **Attrezzi LLC** sued.

A jury found willfull infringement by **Maytag** and damages of \$5,400 for the costs of opposing **Maytag** before the **PTO**. The judge ordered a permanent injunction, double damages (\$10,800 for the math challenged) and attorneys’ fees.

And of course there was an Appeal.

Maytag had objected to a jury trial as injunctive relief is equitable. But the First Circuit held an infringement claim where dam-

ages were requested is a common-law claim and thus triable by jury even when the injunction request was joined. *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500, 508-11 (1959).

For all you readers without the dubious benefit of a Juris Doctor, this is nearly impossible to explain without an hour’s lecture on the strange history of law and equity.

Originally there were courts of law, and you’re saying “well duh.” But they had only one remedy which was money damages. If I trespassed on your pasture to graze my cows, you had to sue me for the damages each time. You couldn’t stop me from doing it.

But there were kings in those days, and any subject could go to the king and ask for a boon. Since kings like to keep busy hawking and wenching and boozing, they appointed Chancellors to hear all the requests. The Chancellery developed what for all intents and purposes was a parallel legal system with the case heard by the Chancellor rather than a jury. And they developed the nifty remedy of the injunction. They could issue an order to keep my cows from your pasture.

The courts of law and equity were later merged, but the tradition of jury trial for law matters and judge trial for equitable matters was retained. The U.S. Constitution makes specific reference to a right to jury trial for matters that were by tradition at common law.

While it is of no relevance to this case, all government regulatory law is not derived from common law so there’s a mountain of “law” out there where the citizen is not protected by a trial of his peers.

Anyhoos, I just thought I’d clear up your questions on this little matter of — hem — law.

Maytag also questioned the sufficiency of evidence showing a protectable mark and likely customer confusion. But the challenge fails unless “reasonable persons could not

have reached the conclusion the jury embraced.” *Sanchez v. P.R. Oil Co.*, 37 F.3d 712, 716 (1st Cir. 1994).

Protectable Marks.

To be protected under the **Lanham Act**, a mark must be distinctive. It may be arbitrary or “suggestive.” If it’s “descriptive” it must have acquired “secondary meaning” because it’s been around long enough that consumers link it with a particular product or source. *Boston Beer Co. Ltd. P’ship v. Slesar Bros. Brewing Co.*, 9 F.3d 175, 180 (1st Cir. 1993).

The jury found **Attrezzi** to be suggestive, but even if descriptive, it had acquired secondary meaning.

The secondary meaning is a little tough to swallow, but evidence showed

the little mail-order business had a regional reputation.

So What Does Attrezzi Mean?

Yes, get out that Italian dictionary. Beat you to it. It means “tools.”

The “doctrine of foreign equivalents” requires the translation to figure whether it’s descriptive or suggestive. *See, e.g., Pizzeria Uno corp. v. Temple*, 747 F.2d 1522, 1531-32 (4th Cir. 1984); *see also 2 McCarthy, McCarthy on Trademarks and Unfair Competition* § 11:34, at 11-66 (4th ed. 2005).

Maytag says the translation “tools” makes it descriptive as **Attrezzi LLC’s** business is selling chef’s tools. But the court said “tools” aren’t limited to “chef’s tools” hence suggestive — suggesting a similarity but not an identity between workman’s tools and chef’s tools.

Of course. The giant salad fork and a pitchfork.

Likelihood of Confusion.

The required showing is **Maytag’s** use of **Attrezzi** “carries with it a likelihood of con-

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founding an appreciable number of reasonably prudent purchasers exercising ordinary care." *Int'l Ass'n of Machinists & Aerospace Workers, AFL-CIO v. Winship Green Nursing Ctr.*, 103 F.3d 196, 201 (1st Cir. 1996).

An ordinary confusion claim would have an infringer diverting customers and free-riding on claimant's goodwill. **Attrezzi, LLC**, however, claimed "reverse confusion." Purchasers might view **Maytag** as the source of **Attrezzi LLC's** goods. See *DeCosta v. Viacom Int'l, Inc.*, 981 F.2d 602, 608 (1st Cir. 1992).

In reverse confusion, the infringer could be selling an inferior product or it could "saturate the market and 'overwhelm the senior user.'" The senior user loses its product identity, control over its reputation and ability to move into new markets. 3 McCarthy, supra, § 23:10, at 23-36 (quoting *Ameritech, Inc. v. Am. Info. Techs. Corp.*, 811 F.2d 960, 964 (6th Cir. 1987)). Internal memos at **Maytag** acknowledged problems with its products, and whatever the degree of severity, this risked tarring **Attrezzi LLC** with the same brush.

Let's Compare and Contrast.

Winship Green, 103 F.3d at 201 holds the series of factors to be considered.

Both companies use the identical word **Attrezzi**. **Maytag** hooks it onto **Jenn-Air**

which might diminish confusion, but in a reverse confusion case the more recognized **Jenn-Air** mark makes things worse to **Attrezzi LLC**. *A & H Sportswear v. Victoria's Secret Stores, Inc.* 237 F.3d 198, 230 (3d Cir. 2000).

Edge Attrezzi LLC.

True, **Jenn-Air** is appliances, but **Attrezzi LLC** has appliances along with gourmet foods and dinnerware. The products are not radically dissimilar. And **Maytag** had announced the possibility of extending its line to include bar ware, cups, glasses and cutlery. 3 McCarthy, supra, § 23:20.1, at 23-73 to 23-74 & nn. 1-2 (collecting cases).

Edge Attrezzi LLC.

What about channels of trade, advertising modes and prospective customers? **Maytag** is a big deal selling nationally through stores and catalogues while **Attrezzi LLC** is one store patronized by Portsmouth locals. But both have Websites and those search engines turn up both. And both are selling up-market products.

Edge Attrezzi LLC.

Attrezzi LLC had eight emails griping about the quality of **Jenn-Air Attrezzi** products. And there were phone calls for **Jenn-Air** coming into the **LLC** shop. A declaration from an **LLC** customer read:

"I thought that **Maytag** operated **Attrezzi** as one of a chain of retail shops. Part of the reason for this belief is the dis-

tinguiveness of the **Attrezzi** name. I figured that because both companies were using the same name in the kitchen products market, they must be related."

Whups. Well that sure seems to go to Attrezzi LLC.

As to the willfulness of it all, **Maytag** could not be found to be operating in utter good faith. The jury found **Maytag** was well aware of the clash of names and just bulld ahead.

And finally, **Attrezzi LLC** had actually achieved regional success with features in the *Boston Globe*, *Accent Magazine* and an award from *Business NH* magazine for its **Attrezzi** branding campaign. **Maytag** had dropped a bundle on advertising. And in a reverse confusion case, the well known giant **Maytag** is hurt rather than helped by its greater renown.

Another round to Attrezzi LLC.

With the final tally in, the First Circuit found that while they might have arrived at a different result as fact finders, there was no basis for finding the jury's verdict to be irrational. **Maytag** would just have to get busy and find another Italian word for their products.

And the Attrezzi Website is up and running without a Maytag appliance in sight. Classes in Tuscan cooking. Scharffen Berger chocolates for \$6 per 3 oz. bar and Carpe Diem locally roasted coffee at \$11/lb.

Questions & Answers — Copyright Column

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QUESTION: *A photographer has donated his negatives to the library. Does the library now own the copyright in the photographs?*

ANSWER: No, the library owns the physical objects, the negatives. The copyright is separate from any physical object in which the work may be stored such as a print or a negative. The library may even own the only existing copy of a photograph, but it does not own the copyright unless the copyright owner (in this case, the photographer) specifically transfers the copyright in writing.

QUESTION: *An employee in a non-profit organization sends out email updates to the staff that consist of items taken from news stories/articles on the Web (from Reuters, Associated Press and various newspapers), news stories posted on other listservs, emails from colleagues, etc. Because this is disseminated as an internal list the employee thought it was okay just to reproduce the news stories in these emails. Now,*

"he wishes to" disseminate the updates to a much wider audience outside the organization. What are the copyright infringement concerns with circulating these internal emails containing the full text of articles?

ANSWER: If any of these sources are licensed products, the license agreement controls the redistribution of this content by an employee. If the organization has a CCC annual photocopy license, then redistribution within the organization is permitted. If the organization is not a CCC licensee, and redistribution of full text is done more than very occasionally, permission is required, and often there is a fee, even for a nonprofit organization. He could, however, prepare a brief description of the contents and distribute it along with a link to where the item is found on the Web. In the alternative, he could use the headline and distribute that since headlines are not copyrightable in the United States, in contrast with many European countries. Distribution outside the organization

other than headlines and links is even more likely to be infringement.

QUESTION: *A patron requested an interlibrary loan of a 124-page article published in a freely available e-journal on the Web. The patron could not download or read the article in the 30 minutes time limit that the library imposes on patrons using library computers. The library printed the first 20 pages for free and the patron paid for copying the remaining pages. Did the library violate the copyright law?*

ANSWER: No, it did not. In fact, the library could have printed the entire 124 pages for the patron had it chosen to do so. Under section 108(d), libraries are permitted to re-

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