

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF OHIO
EASTERN DIVISION**

Elizabeth Arden, Inc.,

Plaintiff,

vs.

Belcam, Inc.,

Defendant.

Case No. 05-CV-397
Judge Gregory L. Frost
Magistrate Judge Abel

OPINION & ORDER

This matter is before the Court pursuant to a motion for a temporary restraining order and preliminary injunction filed by Plaintiff Elizabeth Arden, Inc. (“Arden”).¹ (Doc. # 5).

Defendant Belcam, Inc. (“Belcam”) filed a memorandum in opposition. (Doc. # 13). The Court conducted an informal telephone conference as mandated by S.D. Civ. R. 65.1(a) on May 10, 2005 and later held oral argument on the motion on May 12, 2005. Also before the Court is Arden’s oral motion to strike the affidavit of Michael Bellm (“Bellm”). After considering the pleadings, filings, and arguments of the parties, the Court **GRANTS** the motion for a temporary restraining order and **DENIES** Arden’s motion to strike Bellm’s affidavit for the reasons that follow.

BACKGROUND

The following recitation of the facts, which the Court has culled from the parties’ briefs,

¹ Although Arden’s motion is styled as a motion for a temporary restraining order and a preliminary injunction, the Court shall treat it as a motion for a temporary restraining order only. (Doc. # 5).

oral arguments, and testimony elicited during the May 12, 2005 temporary restraining order hearing, is set forth for the limited purpose of addressing the motion for a temporary restraining order and preliminary injunction. The parties should note that findings of fact and conclusions of law made by a district court in granting a temporary restraining order are not binding at a trial on the merits. *See United States v. Edward Rose & Sons*, 384 F.3d 258, 261 (6th Cir. 2004) (discussing preliminary injunctions under Fed. R. Civ. P. 65(a)) (citing *University of Texas v. Camenisch*, 451 U.S. 390, 395 (1981)).

Arden is a Florida corporation that creates, sells, and distributes fragrance and beauty products worldwide. (Doc. # 1 at ¶ 2). Belcam is a New York corporation that also develops fragrance and bath products. *Id.* at ¶ 3. Delagar (“Delagar”) is a division of Belcam that manufactures and markets the same type of products. (Doc. # 5 at 5; Doc. # 1 at ¶¶ 3, 13).

In September 2004, Arden launched the “curious Brittny Spears” fragrance line. (Doc. # 1 at ¶ 5). The fragrance line includes perfume, eau de toilette, scented body lotions, bath gels, face powder, face glitter, skin moisturizers, and the like. *Id.* at ¶ 6. Arden owns the published U.S. trademark application Serial No. 78/418,384 for the trademark “curious Brittny Spears™.” Arden’s constructive use date is May 13, 2004. *Id.* at ¶ 6.

At issue is the “curious™” trade dress. The trade dress is comprised of the colors, shapes, designs, and visual impression of the packaging is described as follows. The fragrance line products are encased in black boxes. *Id.* at ¶ 9. Thin turquoise and bright pink contemporary floral line drawings, as well as turquoise and pink circles, cover the box. *Id.* A bright pink rectangle is in the center on the front of the box. *Id.* The rectangle is referred to as a “cartouche.” *Id.* The product name “curious Brittny Spears™” appears in turquoise lettering

within the cartouche. *Id.* “Curious” is in all lower-case letters. *Id.* The side of the box is the same with the exception that instead of a pink cartouche, “Brittney Spears” is overlaid against a turquoise cartouche. *Id.* The color of the cartouche appearing on the bottom of the box alternates between pink and turquoise. *Id.* Lastly, the fragrance bottle itself is turquoise. *Id.* A “necklace” of pink hearts surround the neck of the bottle. *Id.* A 1.7 ounce bottle of “curious™” eau de parfum costs about \$40. (Doc. # 13 at 5); *see also* http://store.nordstrom.com/category/cat_medium.asp?category=2377899~2384712 (visited May 11, 2005).

In addition to the package itself, Arden selected “do you dare” as the advertising slogan for the fragrance line. (Doc. # 1 at ¶ 8). Arden is the owner of published U.S. trademark application Serial No. 78/144,059. *Id.* Arden’s constructive use date is June 24, 2004. *Id.* The slogan appears on the inside of some of the “curious” packaging. *Id.* at ¶ 9.

Belcam’s primary business is developing and selling imitations of expensive fragrances at reduced prices. *Id.* at 14. Belcam’s fragrance at issue here is “risky.” *Id.* at ¶ 16. “[R]isky” is packaged in a black box. A turquoise rectangular cartouche is located on the front side of the box in the center. *Id.* at ¶ 17. “[R]isky” appears in all lowercase letters within the cartouche. *Id.* at ¶¶ 16, 17. Directly beneath the cartouche, “OUR VERSION OF CURIOUS BRITNEY SPEARS*” is printed in all capital white letters. (Doc. # 13 at 5). This phrase appears nine (9) times on the box in various locations and in three different languages. *Id.* “*Trademark of EA Fragrances Co. Not Connected with risky” is printed on the back of the box. *Id.* Turquoise and pink line drawings of flowers, as well as turquoise and pink hearts, are scattered across the box. (Doc. # 1 at ¶¶ 16, 17). The bottom strip of the box is turquoise, the same color as the

cartouche. *Id.* The slogan “Created for women who dare” is printed on the back of the box. *Id.* Lastly, the bottle containing “risky” is turquoise and has a pink cap. *Id.* The purchase price of a 1.7 fluid ounce bottle of “risky” costs \$9. (Doc. # 13 at 5).

Arden’s complaint asserts claims for infringement of common law trademarks under 15 U.S.C. § 1125(a)(1)(a) and unfair competition, false designation of origin, and passing off under 15 U.S.C. § 1125(a). (Doc. # 1). Arden seeks injunctive relief as well as damages. *Id.*

Given the similarity of the trade dress between the two fragrances, Arden now moves the court for a temporary restraining order. Specifically, Arden asks the Court to issue an order restraining Belcam: (1) from advertising, marketing, promotion, selling, shipping, or distributing, without Arden’s consent, any merchandise packaged in the “curious™” trade dress or any trade dress confusingly similar thereto, or marked with the “Created for women who dare” slogan or any other mark or slogan confusingly similar to Arden’s “Do You Dare?” mark; (2) from making any commercial use of the “curious™” trade dress or marks confusingly similar thereto; (3) from falsely designating the origin of or infringing upon Arden’s trademarks by use of . . . the “curious” trade dress or . . . the “Do You Dare” mark; (4) from injuring Arden’s reputation; (5) to immediately remove all content from any websites owned, operated, or controlled by Belcam that contains graphics depicting packaging that infringes upon the curious trade dress; (6) to immediately destroy all advertising and excess packaging materials that either depict or infringe upon the “curious™” trade dress; (7) to immediately send out a notice of recall . . . and take appropriate action to have its employees and/or agents physically retrieve all such product from each store and warehouse of their customers that had been shipped in packaging infringing upon the “curious™” trade dress or the “Do You Dare” mark; and (8) to file with the Court, no later

than five (5) days from the entry of the temporary restraining order an affidavit signed by an officer of the defendant indicating that all of the above [1-7] have been complied with and detailing the steps taken to comply with the Court's Order. (Doc. # 5 at 1). The Court will now turn to an examination of Arden's motion.

DISCUSSION

A. STANDARD

Arden moves the Court for a temporary restraining order pursuant to Fed. R. Civ. P. 65. (Doc. # 5). "Injunctive relief is an extraordinary remedy whose purpose is to preserve the status quo." *Ewald v. DaimlerChrysler Corp.*, 2002 U.S. Dist. LEXIS 16648, 2-3 (N.D. Ohio 2002). The Court may grant injunctions to effect preventative or protective relief. *Id.*

In determining whether to issue a temporary restraining order under Rule 65 of the Federal Rules of Civil Procedure, a court is to consider: 1) whether the movant has shown a strong or substantial likelihood of success on the merits; 2) whether irreparable harm will result without an injunction; 3) whether issuance of a preliminary injunction will result in substantial harm to others; and 4) whether the public interest is advanced by the injunction. *Michigan State AFL-CIO v. Miller*, 103 F.3d 1240, 1249 (6th Cir.1997). The factors are not prerequisites, but are elements that the Court must balance. *See Chabad of S. Ohio & Congregation Lubavitch v. City of Cincinnati*, 363 F.3d 427 (6th Cir. 2004). As the party seeking the restraining order, Arden has the burden of persuasion on each of those factors. *Stenberg v. Cheker Oil Co.*, 573 F.2d 921, 925 (6th Cir. 1978). The degree of proof necessary for each factor used in determining whether to grant a preliminary injunction depends on the strength of plaintiff's case on other factors. *Golden v. Kelsey-Hayes Co.*, 73 F.3d 648, 657 (6th Cir.), *cert. denied*, 519 U.S. 807, 136

L. Ed. 2d 13, 117 S. Ct. 49 (1996). The Court shall address each factor in turn.

B. MOTION TO STRIKE

The Court **DENIES** Arden's oral motion to strike Bellm's affidavit.

C. EXAMINATION OF ELEMENTS FOR A TEMPORARY RESTRAINING ORDER

1. LIKELIHOOD OF SUCCESS ON THE MERITS

Arden asserts that Belcam intentionally mimicked the trade dress of "curiousTM" for its "risky" product in hopes of confusing consumers that "risky" is actually affiliated with, approved or sponsored by, or connected to "curiousTM". (Doc. # 5 at 9). Belcam responds that its trade dress is not confusingly similar to Arden's; therefore, the Court should deny Arden's motion. (Doc. # 13 at 7). Thus, at the heart of Arden's motion lies a deceptively simple question: Is Belcam's "risky" trade dress too similar to Arden's "curiousTM" trade dress so as to create consumer confusion?

As noted, Arden asserts a claim of trademark infringement based upon 15 U.S.C. § 1125(a). Known as § 43 of the Lanham Act, the statute provides:

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which . . . is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

In passing the statute, Congress intended to

regulate commerce . . . by making actionable the deceptive and misleading use of marks in such commerce; to protect registered marks used in such commerce from interference by State, or territorial legislation; to protect persons engaged in such commerce against unfair competition; to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks; and to provide rights and remedies stipulated by treaties and conventions respecting trademarks, trade names, and unfair competition entered into between the United States and foreign nations.

15 USCS § 1127.

In essence, Arden asserts that Belcam is trying to “pass off” its product in violation of § 43. (Doc. # 5 at 8). The Sixth Circuit described “passing off” as involving “defendant's use of plaintiff's well-known product name, symbol, or familiar packaging to attract the public to the product under the assumption that it is the plaintiff's product which is bought.” *Frisch's Restaurants v. Elby's Big Boy*, 670 F.2d 642, 647 (6th Cir. 1982) (citing Comment, The Present Scope of Recovery for Unfair Competition Violations Under Section 43(a) of the Lanham Act, 58 Neb.L.Rev. 159, 163 (1978)). Phrased differently, “[T]he ultimate question [is] whether relevant consumers are likely to believe that the products or services offered by the parties are affiliated in some way.” *Homeowners Group, Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1107 (6th Cir. 1991).

Arden must show “only a likelihood of confusion” in order to obtain equitable relief. *Id.* The Court will consider eight (8) factors when determining whether Belcam’s use of the “risky” trade dress might lead to a likelihood of confusion. Those factors include the:

1. strength of the plaintiff's trade dress;
2. relatedness of the goods;
3. similarity of the trade dress;
4. evidence of actual confusion;

5. marketing channels used;
6. likely degree of purchaser care;
7. defendant's intent in selecting the trade mark; and
8. likelihood of expansion of the product lines.

Id. at 648. Much like the elements of a temporary restraining order, these factors merely serve as a guide and “imply no mathematical precision, and a plaintiff need not show that all, or even most, of the factors listed are present in any particular case to be successful.” *Wynn Oil Co. v. American Way Serv. Corp.*, 943 F.2d 595, 600 (6th Cir. 1991). The determination of whether the facts at issue establish a likelihood of confusion is a question of law. *Champions Golf Club v. Champions Golf Club*, 78 F.3d 1111, 1116 (6th Cir., 1996)

i. Strength of trade dress

The stronger the trade dress, the more protection it receives. A trade dress is strong if “it is highly distinctive, i.e., if the public readily accepts it as the hallmark of a particular source; it can become so because it is unique, because it has been the subject of wide and intensive advertisement, or because of a combination of both.” *Frisch's Restaurant, Inc. v. Shoney's, Inc.*, 759 F.2d 1261, 1264 (6th Cir. 1985) (citing Callmann, *Unfair Competition, Trademarks & Monopolies*, para. 20.43 (4th ed. 1983)).

There can be no doubt that Arden has spent a great deal of money to advertise the “curious Brittny Spears™” trade dress. For example, Arden spent \$7 million on retail advertising and \$8 million on print, television, and internet advertising featuring the trade dress. (Doc. # 5 at 12). Additionally, Tamara Steele, Arden’s Senior Vice President of Marketing, testified at the Court’s hearing that market studies revealed that young women purchased the

product because of the trade dress. This indicates that the public perceives the trade dress as unique. Moreover, the trade dress won an award for cosmetics packaging. *Id.* Accordingly, the strength of the trade dress is strong.

ii. Relatedness of the goods

Both “risky” and “curious Britney Spears™” are fragrances. Thus, the goods are related.

iii. Similarity of the trade dress

As described above, the trade dress for “risky” and “curious Britney Spears™” are strikingly similar. The boxes are both black in color and have blue and pink flowers. Moreover, both have a cartouch on the center of the box that contains the name of the fragrance in all lower-case letters. The bottom strip for both packages is blue. Thus, the Court concludes that the trade dress for “risky” and “curious Britney Spears” is remarkably similar.

The Court’s conclusion is not altered by Belcam’s argument that the use of a black box and of the colors pink and blue in the fragrance industry packaging is common. (Doc. # 13 at 8, 9). The Sixth Circuit held “it is the total, overall image of the product, including color combinations, that matters and that, even if the individual elements (such as colors) are not protectable, the sum total can be protectable trade dress.” *See Aberombrie & Fitch Stores, Inc. v. American Eagle Outfitters, Inc.*, 280 F.3d 619, 629 (6th Cir. 2002).

iv. Evidence of actual confusion

Arden failed to present any evidence of actual confusion. However, this is not fatal to Arden’s motion. The Sixth Circuit noted that such evidence is not required in order for a court

to find likelihood of confusion. *Frisch 's*, 670 F.2d at 648.

v. Marketing channels used

Arden indicated that it advertised in department stores as well as on the radio, television, and the internet. (Doc. # 5 at 12). Belcam apparently advertises on the internet as well as in stores in which “risky” is located. (Doc. # 1 at ¶ 2). Currently, the two fragrances are not sold in the same department stores. However, “risky” is currently being sold at Walmart and “curious Brittney Spears™” will be sold at Walmart in July 2005. (Doc. # 5 at 13). Thus, the number of shared marketing channels appears to be few.

vi. Likely degree of purchaser care

The normal consumer is the “reasonably prudent buyer.” *Little Caesar Enters., Inc. v. Pizza Caesar, Inc.*, 834 F.2d 568, 571 (6th Cir. 1987). Such consumers are not necessarily “very cautious” or experts, but they are also not “indifferent” or “careless.” *Worthington Foods, Inc. v. Kellogg Co.*, 732 F. Supp. 1417, 1448 (S.D. Ohio 1990). Instead, they are those consumers of “reasonable intelligence and discrimination” *Id.*

While the Court recognizes that it is to consider the degree of purchaser care, the Court believes that this factor is of limited application to the situation at hand. In essence, a reasonable consumer could exercise both a high and a low degree of care when selecting between one of the fragrances at issue. A consumer might exercise a high degree of care in order to ensure that they obtain the lower-priced fragrance. On the other hand, because “risky” is relatively inexpensive at \$9 a bottle, a reasonable consumer could utilize a low degree of care because of the low cost. *Id.* at 1448-1449. Thus, the Court finds that the likely degree of purchaser care factor only

slightly adds to the possibility of confusion.

vii. Defendant's intent in selecting the trade mark

Belcam admits that they designed its “risky” trade dress to resemble Arden’s trade dress. (Doc. # 13 4). The Court concludes that Belcam was successful in its attempt to mimic the trade dress of “curious Brittney Spears™.”

viii. Likelihood of expansion of product lines

It appears that “curious Brittney Spears™” fragrance line has already expanded to include body lotion, shower gel, body glimmer and other similar products. Belcam failed to introduce any evidence regarding its intentions to expand “risky.”

In brief, the Court concludes that there is a likelihood of confusion. The both “risky” and “curious Brittney Spears” are fragrances, and both smell alike. Belcam admits that it intended to mimic the trade dress of “curious Brittney Spears™” and the Court concludes that the trade dress of “risky” is remarkably similar to that of “curious Brittney Spears™.” The fragrances are currently competing for business on the internet, and will soon do the same in Walmart stores. Thus, the factors, taken as a whole, establish a likelihood of confusion.

2. IRREPARABLE HARM

Belcam admits that it intentionally mimicked the “curious Brittney Spears™” trade dress. As such, Arden has satisfied the requisite of irreparable harm. *See Wynn Oil Co. v. American Way Serv. Corp.*, 943 F.2d 595, 608 (6th Cir. 1991); see also *Design & Mfg. v. Sharp Corp.*, 656 F. Supp. 178, 180 (S.D. Ohio 1987).

3. HARM TO OTHERS

The Court holds that Belcam would be the only party harmed if the temporary restraining order is granted. However, because Belcam acted intentionally when deciding to mimic Arden's trade dress, the Court will not consider the possible harm to Belcam. *See Central Benefits Ins. Co. v. blue Cross and Blue Shield Ass'n*, 711 F. Supp. 1423, 1435 (S.D. OH 1989).

4. THE PUBLIC INTEREST

The Court holds that the public interest favors granting Arden's motion. Specifically, the temporary restraining order is likely to stop consumer confusion that Arden has established likely exists. *Worthington Foods*, 732 F. Supp. 1463.

For the foregoing reasons, the Court **GRANTS** Arden's motion for a temporary restraining order. (Doc. # 5).

Plaintiff, Arden, having moved for a temporary restraining order to order the recall of, and to prevent the further distribution of, Belcam, Inc.'s risky product in its current or confusingly similar packaging, and the Court having reviewed the complaint, pleadings, and declarations submitted by plaintiff and defendant, and both parties having come before the Court and having been heard on the issue, the Court finds that it clearly appears that plaintiff is likely to succeed in showing that the defendant infringed upon the curious trade dress in connection with the sale, offering for sale, and/or distribution of Belcam's "risky" perfume product; the sale of such product packaged in trade dress infringing upon the curious trade dress will result in an immediate and irreparable injury to plaintiff if a recall of, and the further distribution of, the risky product packaged in the infringing trade dress is not ordered; and the harm to plaintiff by

denying the requested relief outweighs the harm to the legitimate interests of defendant from granting such an order.

THEREFORE, it is hereby ordered, adjudged and decreed that defendant Belcam, and its agents, servants, employees, assigns, representatives and successors and all persons in active concert or participation with them are hereby ordered:

1. to refrain from advertising, marketing, promoting, selling, shipping or distributing, without Arden's consent, any merchandise packaged in the curious trade dress or any trade dress confusingly similar thereto;
2. to refrain from making any commercial use of the curious trade dress or any trade dress confusingly similar thereto;
3. to refrain from falsely designating the origin of or infringing upon Arden's trademarks by use of the curious trade dress;
4. to immediately remove all content from any website owned, operated or controlled by Belcam that contains graphics depicting packaging that is confusingly similar to the curious trade dress;
5. to destroy all advertising and excess packaging materials that either depict or are confusingly similar to the curious trade dress; and
6. to immediately send out a notice of recall to each retailer and/or distributor and take appropriate action to have its employees and/or agents physically retrieve all such product from each store and warehouse of their retailers/distributors that had been shipped in packaging that depicts or is confusingly similar to the curious

trade dress.

IT IS FURTHER ORDERED that the defendant shall file with this Court, no later than ten (10) days from the entry of this order an affidavit signed by an officer of the defendant indicating that all of the above orders have been complied with and detailing the steps taken to comply with this Court's order.

IT IS FURTHER ORDERED that the temporary restraining order shall remain in effect until the date of the hearing on the motion for preliminary injunction, which is scheduled for May 23, 2005 at 9:00 a.m. or such further dates set by the court, and

IT IS FURTHER ORDERED that plaintiff shall post a cash or corporate surety bond in the amount of \$250,000 as security determined adequate for the payment of such damages as any person may be entitled to recover as a result of a wrongful issuance of a temporary restraining order hereunder. This order shall not become effective until plaintiff posts the security bond.

IT IS SO ORDERED.

 /s/ Gregory L. Frost
GREGORY L. FROST
UNITED STATES DISTRICT JUDGE