1987 WL 14544
United States District Court, N.D. California.

CAROL CABLE COMPANY, INC. Plaintiff,
v.
GRAND AUTO, INC. Defendant.

No. C–87–1036 MHP.
|
April 24, 1987.

Attorneys and Law Firms

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Harris Zimmerman, Law Offices of Harris Zimmerman, Oakland, CAL., for Defendants.

ORDER GRANTING PRELIMINARY INJUNCTION

PATEL, District Judge.

***1** In this trademark, trade dress, and copyright infringement action, plaintiff Carol Cable Company, Inc. ('Carol'), a manufacturer and distributor of battery booster cables, moves to preliminary enjoin defendant Grand Auto, Inc. ('Grand Auto'), another distributor of booster cables, from infringing on its product packaging. For the reasons set forth below, the motion is granted.

I. FACTS

Carol is a manufacturer and distributor of various automotive products. Since May 1985, Carol has sold battery booster cables in a particular packaging trade dress under the 'Tangle-Proof' trademark, assigned to Carol by Avnet, Inc., in 1981. See assignment dated November 13, 1981, and Trademark Reg. No. 1,073, 535 dated September 20, 1977, attached to Michaelson Decl. On March 6, 1987, Carol registered the copyright for its booster cable packaging, which has included a notice of copyright since the packaging first was utilized in 1985. See Copyright Reg. No. TX1993003, attached to Michaelson Decl.; Perelman Decl. ¶20.

Carol's packaging is based on a color-coded system used to identify the four different gauges of its booster cables. The thickest and highest quality cable, 4 gauge, is designated 'professional' and is marketed in blue boxes. The next-highest quality cable, 6 gauge, is designated 'best' and is packaged in red boxes. 8 and 10 gauge cables are designated 'better' and 'good,' respectively, and are marketed in yellow and green boxes. The graphic design of the boxes for the four different cables is essentially the same.

Carol's booster cables are sold nationwide; the company is apparently among the largest, if not the largest, manufacturer and distributor of the product in the United States. Perelman Decl. ¶6. Carol has spent approximately $117,335.00 to advertise its newly packaged line of cables, and has distributed 50,000 brochures displaying the new trade dress as part of its advertising campaign. Id. at ¶13. The company currently realizes annual booster cable sales of approximately

$4,750,000.00. Id. at ¶14. The product has been sold in California through various retail outlets, including those of the defendant. Grand Auto purchased $68,193.00 of Carol's booster cables in 1985.

In early March 1987, Carol learned that Grand Auto was marketing its own 'Autostart' line of booster cables in packaging substantially similar to Carol's. Carol immediately brought suit. Comparison of the two products reveals that Grand Auto's packaging duplicates Carol's identifying color scheme and substantially duplicates Carol's graphic design. The graphic design duplication involves the following similarities: (1) on the boxes' front panels, the words 'Booster Cable' are located in approximately the same position and are rendered in substantially the same lettering; the picture of the booster cable clamp and battery is essentially a duplicate, taken from the same angle with the same lighting and mechanical arrangement; the words 'heavy duty clamp' are located in substantially the same position; the words 'flexible in sub zero temperatures' are located in the same position; the words 'fits top & side post batteries' are located in the same position; and the phrase 'Tangle-Free Construction' is located in the same position as Carol's trademark, 'Tangle-Proof'; (2) on the boxes' rear panels, the upper left photograph of a clamp is essentially a duplicate; the words 'heavy duty clamp features' are located in the same position at the top of the panels; duplicate lines lead from similar text to the same part of the clamp pictured in the upper left corner; duplicate representations of the four types of colored cables are found in the same area of the panels, and are identically labelled as 'good,' 'better,' 'best,' and 'professional'; 'Booster Cable Selection Chart' and 'Carol Booster Cable Selection Guide' are rendered in substantially identical lettering and are located in the same location, identifying the same pictorial representation of the four types of cables; different illustrations of clamps attached to the top and sides of batteries are located in the upper right corner, and are accompanied by similar text; and (3) on the boxes' side panels, different illustrations showing various battery hook-ups are located in the same position; similar language is used in warning and instruction paragraphs; and the words 'Booster Cable' are located in substantially the same position, rendered in substantially the same lettering.

***2** Grand Auto asserts that it 'engaged independent agencies to produce camera ready art work and create the text appearing on Defendant's boxes. The photographs are obviously not the same as those on the Carol Cable boxes, but were independently created. It is apparent that the clamps, the clamp handles and batteries illustrated are not the same. The textual material is also different.' Hoxsie Decl. ¶16. Nowhere does Grand Auto indicate when its packaging was first developed, or by whom.

II. DISCUSSION

Carol moves for a preliminary injunction on the basis of Grand Auto's alleged infringement of its trade dress, copyright, and trademark. 'A preliminary injunction is warranted if the movant demonstrates either '(1) a combination of probable success on the merits and the possibility of irreparable injury or (2) that serious questions are raised and the balance of hardships tips sharply in its favor." Int'l Molders' and Allied Workers' Local Union v. Nelson, 799 F.2d 547, 550–51 (9th Cir. 1986), quoting Los Angeles Memorial Coliseum Comm'n v. Nat'l Football League, 634 F.2d 1197, 1200 (9th Cir. 1980).

A. Trade Dress Infringement

Likelihood of Success on the Merits. Plaintiff's first claim arises under section 43(a) of the Lanham Act, 15 U.S.C. 1125(a), which 'establishes a federal law of unfair competition by providing a statutory remedy to a party injured by a competitor's 'false designation of origin' of its product, whether or not the aggrieved party has a federally registered trademark.' LeSportsac, Inc. v. K Mart Corp., 754 F.2d 71, 75 (2d Cir. 1985). [1] This statute protects from infringement the 'trade dress' of a product, which 'involves the total image of a product and may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques.' John H. Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 980 (11th Cir. 1983). Trade dress infringement actions typically involve the packaging or labelling of products. 754 F.2d at 75; 711 F.2d at 980.

To establish the infringement of a product's trade dress under section 43(a), the plaintiff must 'prove three basic things: '[T]hat the trade dress of the two products is confusingly similar, that the features of the trade dress are primarily non-functional, and that the trade dress has acquired secondary meaning." Harland, 711 F.2d at 980, quoting Black & Decker Co. v. Ever-Ready Appliance Mfg. Co., 518 F. Supp. 607, 616 (E.D. Mo. 1981), aff'd, 684 F.2d 546 (8th Cir. 1982). See First Brands Corp. v. Fred Meyer, Inc., No. 85–4146, slip op. at 5 (9th Cir. February 6, 1987).

To satisfy the initial prong of the required showing, plaintiff must demonstrate that 'there is a likelihood of confusion resulting from the total effect of the defendant's product and package on the eye and mind of an ordinary purchaser.' First Brands, slip op. at 10. As the court in Harlequin Enter. Ltd. v. Gulf & Western Corp., 644 F.2d 946, 949 (2d Cir. 1981), observed, 'it is the 'combination of features as a whole rather than a difference in some of the details which must determine whether the competing product is likely to cause confusion in the mind of the public." (citation omitted).

***3** The court is satisfied that Grand Auto's packaging of its booster cables is sufficiently similar to that of Carol's product in total effect to create a high likelihood of confusion among the consuming public. As enumerated above, the product packaging is remarkably similar in coloration, graphic design, and text. While there exists certain differences in detail between the two packages, the entire effect is one of extreme similarity which strongly suggests the likelihood of confusion. [2] The substantial duplication of graphic design and text on the boxes is compounded by the duplication of the entire product line's identification system, linking package coloring to cable gauge and quality.

Defendant's response on the issue of confusion is exceedingly feeble. Defendant first asserts that confusion resulting from the necessary similarity of booster cables themselves is not protected under the Lanham Act, citing Funnelcap, Inc. v. Orion Indus., Inc., 421 F. Supp. 700 (D. Del. 1976). Obviously, this action does not concern the cables; it concerns the boxes they come in. [3] With respect to the design of the boxes themselves, defendant argues that it is entitled to utilize a picture of its booster cable hooked to a battery, just as a manufacturer of records featuring the sounds of a train could feature a photograph of a steam engine on the record jacket, since both represent the natural way of describing the product. See Audio Fidelity, Inc. v. High Fidelity Recordings, Inc., 283 F.2d 551, 556 (9th Cir. 1960). While the court fully agrees with this general proposition, it is obvious that plaintiff does not simply object to defendant's depiction of a booster cable hooked to a battery; the issue is defendant's impermissibly confusing use of an identical photograph with identical lighting and perspective, coupled with the myriad other duplicated features discussed above. As noted above, trade dress must be considered in its entirety. When this dress is so considered, the court concludes that plaintiff likely will prevail in establishing the likelihood of confusion between its product and that of Grand Auto. [4]

Plaintiff's second required showing is that the infringed trade dress is primarily non-functional. This, too, requires the court to consider the trade dress as a whole. First Brands, slip op. at 5. The test of functionality is whether 'a product feature . . . is essential to the [product's] use . . . or if it affects the cost or quality of the article.' Inwood Laboratories, Inc. v. Ives Laboratories, Inc., 456 U.S. 844, 850 n.10 (1982). While some of the specific aspects of the disputed trade dress are functional insofar as they depict or describe the use of the product contained within and the precautions one must take in its use, the confusing dress as a whole is clearly nonfunctional. The confusing similarities between the two boxes are the product of graphic design, coloration, and text placement and phrasing rather than the functional information communicated in the process. As defendant itself has demonstrated to the court in its submission containing examples of other companies' booster cable packaging, the functional aspects of the trade dress can be communicated in a variety of ways which are entirely distinct from plaintiff's particular packaging design. See attachments to Hoxsie Decl.

***4** Defendant argues correctly that under the color depletion theory, the use of any specific color is functional and cannot be appropriated by a specific manufacturer, since to hold otherwise would soon leave no colors for competitors' packaging. First Brands, slip op. at 6. What plaintiff seeks to protect, though, is the use of a series of colors to connote a series of products of differing quality. Surely defendant's choice of precisely the same four colors to depict the same four

gauges of booster cables amounts to a nonfunctional usage. Again, it is likely that plaintiff will prevail in establishing that the disputed trade dress is nonfunctional.

The final prong of the required showing is that the protected trade dress possess a secondary meaning among consumers. 'A product's trade dress attains a secondary meaning when the purchasing public associates the dress with a single producer or source rather than just the product itself.' First Brands, slip op. at 8. Evidence of advertising and promotional activities bear on this determination if the advertising features the trade dress itself. Id. The secondary meaning of a trade dress may also be inferred from the fact that defendant copied it, since '[t]here is no logical reason for the precise copying save an attempt to realize upon a secondary meaning that is in existence.' Audio Fidelity, 283 F.2d at 558; LeSportsac, 754 F.2d at 78. Particularly on a motion for a preliminary injunction, plaintiff need not come forward with survey evidence establishing a secondary meaning in the minds of consumers, though such evidence is highly desirable. LeSportsac, 754 F.2d at 78.

While plaintiff has come forward with some evidence of advertising, it is relatively limited in scope for a nationally distributed product. Plaintiff has spent approximately $117,335.00 to advertise its booster cables since the introduction of the new trade dress in May 1985. Furthermore, while the 50,000 brochures distributed by plaintiff prominently display the dress, much of plaintiff's other advertising has not featured the dress at all. See Sloan Decl. attachments. While plaintiff claims to be the largest distributor of booster cables in the United States, and thus quite possibly enjoys some measure of product recognition among its customers, the court has not been presented with sufficient evidence on the booster cable market and its requirements for effective advertising to conclude that plaintiff's efforts are likely to have established a secondary meaning in the minds of consumers. This is particularly true in light of the fact that most of plaintiff's advertising has been directed at retailers rather than actual consumers. Thus the ultimate purchaser of Carol's booster cables has likely not been exposed to a significant amount of its merchandising efforts.

Nonetheless, the evidence that defendant copied plaintiff's dress is compelling. The only evidence Grand Auto offers to rebut the obvious inference of copying is the declaration of one of Grand Auto's 'auto parts buyers,' Mr. Al Hoxsie. Hoxsie declares that Grand Auto, 'engaged independent agencies to produce camera ready art work and create the text appearing on Defendant's boxes. The photographs are obviously not the same as those on the Carol Cable boxes, but were independently created.' Hoxsie Decl. ¶16. First, the court seriously doubts that an auto parts buyer has sufficient personal knowledge to credibly testify about Grand Auto's packaging design and production activities. Second, Hoxsie states only that the dress was produced by independent agencies, not that the dress was independently designed. This is wholly consistent with copying; it simply suggests that an independent agency, rather than Grand Auto's employees, accomplished it. Hoxsie's testimony thus is not credible and largely without probative value. Weighed against this testimony is the slight probability that an independent agency could have randomly developed trade dress as duplicative of Carol's as that before the court. The court concludes that plaintiff likely will prevail in establishing that Grand Auto copied plaintiff's trade dress.

***5** As the court in Audio Fidelity observed, 'proof [of copying], without any opposing proof, is sufficient to establish a secondary meaning . . .. '[A] late comer who deliberately copies the dress of his competitors already in the field, must at least prove that his effort has been futile." 283 F.2d at 558, quoting Nat'l Lead Co. v. Wolfe, 223 F.2d 195, 202 (9th Cir.), cert. denied, 350 U.S. 883 (1955). Thus, once plaintiff has established copying, the burden appropriately shifts to the defendant to offer its own evidence rebutting the inference of secondary meaning. This is a particularly compelling consideration in the instant action, where the competing product is sold by one of Carol's prior retailers, who now places its booster cables in the precise stores and shelves which previously contained plaintiff's goods. These facts raise a strong inference that Grand Auto's copying represents an attempt to capitalize on a secondary meaning previously developed by Carol.

At this juncture, defendant has come forward with no probative evidence rebutting this inference of secondary meaning. The only evidence offered by defendant is an informal survey which defendant's counsel purportedly conducted among friends and associates, which allegedly revealed no secondary meaning. Obviously, this is inadmissible and wholly without probative value. Absent any showing by Grand Auto that no secondary meaning attaches to the trade dress it has apparently copied, the court must conclude that plaintiff is likely to establish secondary meaning. See LeSportsac, 754 F.2d at 78. Thus, plaintiff is likely to prevail on the merits of its trade dress infringement claim.

Irreparable Injury. The final showing required for a preliminary injunction is the possibility of irreparable injury. [5] The court in LeSportsac set forth the relevant considerations to guide this determination:

> Likelihood of confusion is itself strong evidence that in the absence of an injunction LeSportsac might face irreparable harm . . .. Similarly, while K mart must store its [potentially infringing] bags pending the outcome of this litigation, the true hardships tip markedly in favor of LeSportsac. It would risk loss of both sales and goodwill if K mart were permitted to continue selling its confusingly similar bags pending resolution of this action. The district court was justified in concluding that the potential damage to LeSportsac's mark and goodwill in the absence of a preliminary injunction outweighs the short-term economic harm that K mart may suffer.

(citations omitted) 754 F.2d at 79. This analysis is controlling. Carol risks the loss of goodwill and sales, while Grand Auto faces only short-term economic harm. Significantly, Carol has also offered evidence suggesting that Grand Auto's product is inferior to its own and possibly dangerous, since the Autostart cables apparently contain significantly less than the number of copper strands required by industry specifications for their gauge ratings. Daigneault Decl. ¶6. Apart from rendering the product less effective, plaintiff asserts that this deficiency creates a fire hazard when the cable is used at low temperatures. If product confusion does occur, this deficiency could seriously undermine Carol's goodwill among its customers.

***6** Plaintiff has established the likelihood of success on the merits of its trade dress infringement claim and the potential for irreparable injury. Defendant thus is preliminarily enjoined from marketing its booster cables in the disputed trade dress.

B. Copyright Infringement

Likelihood of Success on the Merits. Plaintiff's second claim is for copyright infringement arising under 17 U.S.C. § 101 et seq. Under 17 U.S.C. § 502(a), a preliminary injunction may issue to enjoin such infringement. To establish copyright infringement, 'a plaintiff must prove ownership of the copyright and 'copying' by the defendant.' Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp., 562 F.2d 1157, 1162 (9th Cir. 1977); Topolos v. Caldewey, 698 F.2d 991, 994 (9th Cir. 1983).

Ownership requires a showing of '(1) [o]riginality in the author, (2) copyrightability of the subject matter, (3) citizenship status of the author such as to permit a claim of copyright, (4) compliance with applicable statutory formalities, and (5) (if the plaintiff is not the author) a transfer of rights or other relationship between the author and the plaintiff . . ..' 3 M. Nimmer, Nimmer on Copyright, § 13.01[A] (1985). Plaintiff's copyright registration certificate is prima facie evidence of ownership, particularly with respect to the issues of originality, copyrightability and citizenship status, since registration was made within five years of the work's publication date. Id. See Murray v. Gelderman, 566 F.2d 1307, 1311 n.8 (5th Cir. 1978). Significantly, defendant has not offered any rebuttal evidence challenging plaintiff's prima facie showing.

Plaintiff is a Delaware corporation, thus satisfying the citizenship requirement. Plaintiff developed its booster cable packaging as a work for hire, and therefore is considered the author under 17 U.S. C. § 201(b). Perelman Decl. ¶¶9, 12. Plaintiff also satisfies the requirements of copyrightability and originality. As the court in Doran v. Sunset House Distrib. Corp., 197 F. Supp. 940, 944 (S.D. Cal. 1961), aff'd, 304 F.2d 251 (9th Cir. 1962), stated, '[t]he requirements for the 'originality' necessary to support a copyright are modest. The author must have created the work by his own skill, labor and judgment, contributing something 'recognizably his own' to prior treatments of the same subject. However, neither great novelty nor superior artistic quality is required.' Clearly the packaging of Carol's booster cables is recognizably its own and sufficiently distinct from prior booster cable packaging to constitute an original work. Furthermore, the work is copyrightable insofar as it represents a particular expression of an idea, embodied in the particular graphic design, text and color scheme of the packaging, rather than simply the idea itself. See Roth Greeting Cards v. United Card Co., 429 F.2d 1106, 1109 (9th Cir. 1970).

Statutory formalities have been complied with. While registration is clearly not a requirement for obtaining a copyright after January 1, 1978, the effective date of the current Copyright Act, see M. Nimmer, Nimmer on Copyright, at § 7.16[A], such registration is a condition precedent to bringing an infringement action. 17 U.S.C. § 411(a). Plaintiff has satisfied this requirement. In addition to the registration of the copyright, Carol has properly affixed a copyright notice to all of its newly developed booster cable boxes. This notice comports with the requirements that the word 'copyright' or a prescribed substitute be affixed to all visually perceptible copies of the work, accompanied by the year of first publication and the name of the copyright owner, and be located in a position giving reasonable notice of the claim of copyright. 17 U.S.C. § 401. See Perelman Decl., Exhibit B, C, D, E.

***7** The remaining inquiry, and the only grounds upon which defendant challenges plaintiff's claim of copyright infringement, is whether defendant copied plaintiff's work. Copying may be shown by establishing the defendant's access to the work and a substantial similarity between the two products. Kamar Int'l, Inc. v. Russ Berrie & Co., 657 F.2d 1059, 1062 (9th Cir. 1981). Access is not disputed; plaintiff's booster cable boxes sat on the shelves of defendant's retail outlets since 1985.

The determination of substantial similarity in this circuit involves a two-part inquiry. Under the holding in Krofft, the court first must establish the similarity of the general ideas contained in the two works. 562 F.2d at 1164. This is accomplished by use of 'the 'extrinsic test.' It is extrinsic because it depends not on the responses of the trier of fact, but on specific criteria which can be listed and analyzed. Such criteria include the type of artwork involved, the materials used, the subject matter, and the setting for the subject.' Id. Considering these specific criteria, it is clear that these two works involve the same general ideas: they both involve precisely the same type of artwork and design on booster cable boxes, both utilize the same materials, and both occur in the same commercial setting.

The court thus turns to the second inquiry required under Krofft—whether there exists substantial similarity 'between the forms of expression . . ..' Id. Here the court must employ an intrinsic test, which depends 'on the response of the ordinary reasonable person . . .. It is intrinsic because it does not depend on the type of external criteria and analysis which marks the extrinsic test.' (citations omitted) Id. This test has been variously described as an inquiry into "whether the work is recognizable by an ordinary observer as having been taken from the copyrighted source," Roth Greeting Cards, 429 F.2d at 1110, quoting White-Smith Music Publishing Co. v. Apollo Co., 209 U.S. 1, 17 (1908), or an inquiry into 'whether an ordinary reasonable person would fail to differentiate between the two labels or consider them dissimilar by reasonable observation.' Int'l Luggage Registry v. Avery Products Corp., 541 F.2d 830, 831 (9th Cir. 1976).

Defendant seizes upon the latter language and argues that unless an ordinary observer finds the two works indistinguishable—that is, concludes that they are identical copies—no infringement has taken place. Defendant thus argues that the occasional dissimilarities between the two booster cable boxes are sufficient to defeat plaintiff's copyright

infringement claim. Defendant, though, fails to appreciate that the holding in Int'l Luggage Registry does not conflict with the holding in Roth Greeting Cards, but merely reflects its negative implication; the former directs the court to consider whether a reasonable observer would consider the boxes dissimilar, while the latter directs the court to consider whether the observer would find them similar. The guiding paradigm for both is the circuit's subsequent holding in Krofft—that the court must consider the effect of the disputed packaging as a whole, rather than analytically dissect the works and seize upon particular distinctions. 562 F.2d at 1169. Infringement therefore can occur absent literal copying, so long as the subjective effect is one of substantial similarity. As the court in Krofft definitively observed,

***8** [d]uplication or near identity is not necessary to establish infringement . . .. '[A]n infringment is not confined to literal and exact repetition or reproduction; it includes also the various modes in which the matter of any work may be adopted, imitated, transferred, or reproduced, with more or less colorable alterations to disguise the piracy.' And, as Judge Learned Hand put it, copyright 'cannot be limited literally to the text, else a plagiarist would escape by immaterial variations.'

(citations omitted) 562 F.2d at 1167.

Ad discussed more fully above, defendant's booster cable boxes differ, at best, in purely immaterial ways from the work of the plaintiff. Defendant's meager evidence of independent creation is neither probative nor credible. The entire effect is one of substantial duplication and appropriation of plaintiff's expression, thus constituting impermissible copying. Plaintiff therefore establishes the likelihood of success on the merits of its copyright infringement claim. Since irreparable injury is presumed upon a prima facie showing of copyright infringement, Universal City Studios, Inc. v. Film Ventures Int'l, Inc., 543 F. Supp. 1134, 1139 (C.D. Cal. 1982), the defendant is preliminarily enjoined from further infringing upon plaintiff's copyrighted booster cable packaging.

C. Trademark Infringement

Likelihood of Success on the Merits. Plaintiff's final claim is for trademark infringement. Plaintiff alleges that defendant's use of the phrase 'Tangle-Free Construction' infringes upon its registered trademark, 'Tangle-Proof,' because the two are similar and appear in the same location on the disputed booster cable boxes. Given plaintiff's uncontested ownership of the registered mark 'Tangle-Proof,' the determinative inquiry is 'whether the defendant's use of the mark creates a likelihood of confusion as to the source of the goods or services offered in the mind of the average customer.' Golden Door, Inc. v. Odisho, 437 F. Supp. 956, 963 (N.D. Cal. 1977), aff'd, 646 F.2d 347 (9th Cir. 1980). The court in Golden Door identified six factors relevant to this determination: '(1) similarity in appearance, sound and meaning; (2) the class of goods or services in question; (3) the marketing channels and trade areas involved; (4) the intent of the defendant; (5) the strength or weakness of the mark; and (6) the evidence of actual confusion.' Id. See J.B. Williams Co., Inc. v. Le Conte Cosmetics, Inc., 523 F.2d 187, 191 (9th Cir. 1975), cert. denied, 424 U.S. 913 (1976). Because there is no evidence presently before the court regarding the final factor, the inquiry must be directed to the remaining five considerations.

While many of these factors favor a finding of confusion, the most significant ones do not. Obviously, the second and third factors point to confusion, since both marks appear on identical products and are marketed in identical settings. Given the context in which the disputed marks appear, it is also reasonable to conclude at this juncture that the defendant's use of 'Tangle-Free Construction' was motivated at least in part by its broader intent to create a substantially similar and confusing product package. Given the phrase's important and legitimate descriptive function, though, this intent cannot be given great weight.

***9** While these factors suggest the possibility of confusion, the remaining considerations are sufficient to defeat plaintiff's required showing. 'Tangle-Free Construction' and 'Tangle-Proof' are similar, but not compellingly so. Though conveying a similar meaning, they sound and appear distinctive. Additionally, while the size, location, and lettering of

'Tangle-Free Construction' on Grand Auto's boxes are quite similar to Carol's placing and rendition of 'Tangle-Proof,' Grand Auto's mark appears on two lines, while Carol's appears on only one. This is more consistent with descriptive commentary than an attempt to mimic an identifiable trademark.

Most significantly, the trademark 'Tangle-Proof' is quite weak, commanding far less protection than a strong mark. As the court observed in Williams, '[a] 'strong' mark is one which is used only in a 'fictitious, arbitrary and fanciful manner,' . . . whereas a 'weak' mark is a mark that is a meaningful word in common usage . . . or is merely a suggestive or descriptive trademark . . .. A 'strong' mark is entitled to a greater degree of protection than is a 'weak' one because of its unique usage . . ..' (citations omitted) 523 F.2d at 192. 'Tangle-Proof' is clearly a descriptive usage, without any fanciful or fictitious connotation. It conveys important descriptive information about the product, as does 'Tangle-Free Construction.' While descriptive words and phrases nonetheless may be protected under the trademark laws if they acquire secondary meaning, Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 10 (2d Cir. 1976), the weakness of Carol's mark coupled with the significant dissimilarities between the two usages suggest that plaintiff has not demonstrated a likelihood of confusion. Carol therefore fails to establish the likelihood of prevailing on the merits of its trademark infringement claim.

ACCORDINGLY, it is hereby ordered that pending trial of this action, defendant Grand Auto, Inc., its principals, agents, servants, employees, successors and assigns, and all those in privity, concert or participation with it, are enjoined from:

(a) Manufacturing, distributing or offering for sale, selling or advertising any battery booster cable or packaging that is a simulation, reproduction or counterfeit copy or colorable imitation of plaintiff's trade dress for its Tangle-Proof battery booster cable so as to be likely to cause confusion, to cause mistake or to deceive including without limitation defendant's product stock nos. 812B, 1012B, 416B, and such products in different gauges and lengths;

(b) Using the trade dress of plaintiff's Tangle-Proof battery booster cable products or goods of a similar nature in connection with the advertising, distribution, offering for sale or sale of similar booster cables not originating from plaintiff or authorized by plaintiff, or which falsely describes the quality or strength or gauges of defendant's cables;

(c) Imitating, copying, counterfeiting, or making unauthorized use of plaintiff's copyrighted material;

***10** (d) Engaging in any false or misleading advertising which can or is likely to lead the trade or public, or individual members thereof, to believe that any product manufactured, distributed or sold by defendant is in any manner associated or connected with plaintiff or is sold, manufactured, licensed, sponsored, approved, or authorized by plaintiff, or which falsely describes the quality or strength or gauges of defendant's cables;

(e) Using any false designation of origin or false description which can or is likely to lead the trade or public, or individual members thereof, to believe that any product manufactured, distributed or sold by defendant is in any manner associated or connected with plaintiff or is sold, manufactured, licensed, sponsored, approved, or authorized by plaintiff; and

(f) Assisting, aiding or abetting any other person or business entity from engaging or performing any of the activities referred to in subparagraphs (a)–(g) above.

The amount posted by plaintiff to secure the temporary restraining order in this matter is deemed sufficient security for the issuance of this preliminary injunction.

IT IS SO ORDERED.

All Citations

Not Reported in F.Supp., 1987 WL 14544, 1987 Copr.L.Dec. P 26,126, 4 U.S.P.Q.2d 1056

Footnotes

1 Plaintiff also states causes of action under the common law and the law of unfair competition. Since the showing for these causes is identical to that required under the Lanham Act, the court will not independently discuss these claims. First Brands Corp. v. Fred Meyer, Inc., No. 85–4146, slip op. at 3 (9th Cir. February 6, 1987).

2 The court must note that plaintiff's repeated reference to Grand Auto's packaging as a 'Chinese copy' is dated, ethnocentric, and wholly unnecessary. While the phrase may have been (or, sadly, continue to be) a common reference among practitioners, its use remains entirely inappropriate.

3 Plaintiff did assert at oral argument that the color-coding of the cables themselves constitutes protected trade dress. The court seriously doubts that customers open or scrutinize the boxes here in dispute to determine the color of the cables contained within, and then purchase cables accordingly. The court's analysis therefore focuses on the product's packaging, not the product's cable color.

4 Defendant argues that its brand name, 'Autostart,' is displayed on its packaging, thus dispelling any possible confusion. The brand name is found only in the lower right corner of the front panel, though, and could be easily overlooked. It hardly dispels the overwhelming and far more prominent similarities in the packaging of the two products leading to possible confusion.

5 The court notes that defendant has made no response in its opposition papers to plaintiff's claims on the issues of injury and hardship.