

A.T. Cross Co. v. Cross Electronics, Inc., Not Reported in F.Supp. (1981)

213 U.S.P.Q. 181

1981 WL 61264

United States District Court, S. D. Florida

A. T. Cross Company

v.

Cross Electronics, Inc. et al.

No. 79-5619-CIV.

|

Decided Feb. 9, 1981.

Attorneys and Law Firms

Leslie D. Taggart, Frank J. Colucci, and Watson, Leavenworth, Kelton & Taggart, all of New York, N.Y., and Dennis G. King, and Patton, Kanner, Segal, Zeller, King & Kubit, both of Miami, Fla., for plaintiff.

John Cyril Malloy, William E. Levin, John Cyril Malloy, P.A., Mike Nachwalter, Brian Spector, and Kenny, Nachwalter & Seymour, P.A., all of Miami, Fla., for defendants.

Opinion

Spellman, District Judge.

*1 This cause came before the Court on Defendant's motion to dismiss the amended complaint. Having reviewed the record in this cause and being otherwise duly advised, it is hereby,

ORDERED AND ADJUDGED that said motion is GRANTED for the following reasons:

Defendant makes several arguments in support of their motion. First, Defendant contends that Plaintiff has failed to allege that the acts complained of affect interstate commerce. In order to establish a federal trademark infringement action under the Lanham Act, 15 U.S.C. §1051 et seq., a Plaintiff must either allege facts that show that the Defendant is engaged in intrastate commerce which has a substantial effect upon interstate commerce, or allege that Defendant is engaged in interstate commerce. *World Carpets, Inc. v. Dick Littrell's New World Carpets*, 438 F.2d 482, 488-89, 168 USPQ 609, 614-615 (5th Cir. 1971). Nowhere in the amended complaint does Plaintiff set forth these requisite allegations.

Defendant next argues that Count I of the amended complaint improperly attempts to set forth a claim for infringement of Plaintiff's corporate or tradename under section 32(1) of the Lanham Act, 15 U.S.C. §1114(1). Although Plaintiff did not restrict Count I to section 32(1), it is the opinion of the Court that Plaintiff should separate their claims for trademark and tradename infringement into separate counts. See Fed. R. Civ. P. 10(b).

Based on the aforesaid, the motion to dismiss is granted. Plaintiff shall have ten (10) days from the date of this Order to file an amended complaint.

Defendant's motion presents several arguments in addition to those mentioned above. One of these arguments is that the Court should rule as a matter of law that there is no likelihood of confusion between Plaintiff's and Defendant's use of the trademark "Cross" because the goods to which the trademarks are affixed are totally unrelated. In *Exxon Corporation v. Texas Motor Exchange of Houston, Inc.*, 628 F.2d 500, 208 USPQ 384 (5th Cir. 1980), the Fifth Circuit stated:

A.T. Cross Co. v. Cross Electronics, Inc., Not Reported in F.Supp. (1981)

213 U.S.P.Q. 181

In determining whether there is a likelihood of confusion, the *finder of fact* evaluates a variety of factors: the type of trademark, the similarity of design, the similarity of the product, the identity of retail outlets and purchasers, the similarity of advertising media used, the defendant's intent, and actual confusion.

Id. at 504, 208 USPQ at 387 (emphasis added). It is clear from the Exxon case that the similarity of the products is only one factor to be considered in determining the likelihood of confusion, and that such a determination should be made by the trier of fact. Accordingly, the Court rejects Defendant's contention that, as a matter of law, no likelihood of confusion exists in the case sub judice, and the motion to dismiss, to the extent that it relies on this contention, is denied.

*2 Even if Plaintiff proves likelihood of confusion, Defendant argues that equitable relief should be denied based on Avon Shoe Company v. David Crystal, Inc., 279 F.2d 607, 125 USPQ 607 (2d Cir. 1960), cert. denied, 364 U.S. 909, 127 USPQ 555 (1960), and Mushroom Makers, Inc. v. R. G. Barry Corp., 580 F.2d 44, 199 USPQ 65 (2d Cir 1978). In both of these cases, however, the denial of injunctive relief was based on a balancing of factors such as the defendant's good faith in adopting their trademark, the degree of confusion among customers, the defendant's interest in retaining the trademark and the extent of plaintiff's injury resulting from defendant's continued use of the trademark. Until the relevant factors are established this Court cannot determine whether or not injunctive relief would be appropriate if Plaintiff prevails in the case at bar.

The Court finds Defendant's other arguments in support of their motion to dismiss to be without merit. Specifically, the Court cannot find beyond a doubt that the Plaintiff can prove no set of facts that would entitle them to the relief requested with regard to the individual defendants. Conley v. Gibson, 78 S.Ct. 99 (1957). In addition, the principles of McCollum Aviation, Inc v. Cim Associates, Inc., 438 F.Supp. 245 (S.D. Fla. 1977), are not applicable because Plaintiff is not asserting pendent state claims and the jurisdiction of this Court does not rest on diversity. Finally, in light of the Court's finding that the motions filed by both parties have merit, the respective motions for attorneys' fees are denied.

Done and ordered.

All Citations

Not Reported in F.Supp., 1981 WL 61264, 213 U.S.P.Q. 181