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Tilting At Windmills and Counterfeit Trademark Designs?

by [Steve Baird](#)

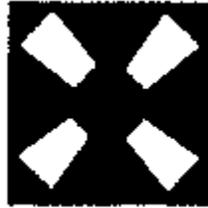


My first oral argument, as a very young lawyer, involved a small discovery dispute in a trademark case, in which there were complaints about inadequate and deficient discovery responses. During the hearing, the U.S. Magistrate Judge who decided the motion said something to the effect that my client's positions reminded him of [tilting at windmills](#). Needless to say, we didn't get what we were asking for, and I've never forgotten that phrase.



Capella Tower | Suite 3500 | 225 South Sixth Street | Minneapolis, MN 55402
Main: (612) 604-6400 | Fax: (612) 604-6800 | www.winthrop.com | *A Professional Association*

A brand new trademark case, recently filed in the United States District Court for the District of Minnesota, caused my trip down windmill memory lane. Here is a pdf copy of the [complaint](#), complete with exhibits. The case is *Holland USA, Inc. v. Comda Ltd.*, and alleges, among other claims, trademark dilution, trademark infringement, and trademark counterfeiting of pens bearing the following "famous" "windmill design" logo:



Can you see it on plaintiff's pen clip?



Not easily, without a magnifying glass, and far more visible are the two horizontal bars, which appear to lack any trademark significance, because they appear on both plaintiff's pen clips and defendant's pen clips, yet plaintiff is not complaining about the use of the identically positioned horizontal bars:



Besides wondering whether anyone pays attention to the subtle and barely visible windmill design that plaintiff claims famous trademark rights in, I'm left wondering why the only registered rights for this design cover "mail order catalog services"? No registered rights for pens?

OK, given that, I'm wondering something else too. Even assuming that defendant's pens also bear a barely visible yet identical windmill design on the clip, can they really depict a "counterfeit mark" on pens, as defined by [Section 34\(d\)\(1\)\(B\) of the Lanham Act, 15 USC 1116\(d\)\(1\)\(B\)](#), since the federal registration in question only covers "mail order catalog services" in Int'l Class 35 -- as opposed to pens -- the allegedly infringing and counterfeit goods in Int'l Class 16?



Not every trademark infringement involves the unique scenario of counterfeit goods.

So, how likely will plaintiff's allegation of trademark counterfeiting similarly be considered tilting at windmills, i.e., "[attacking imaginary enemies, or fighting unwinnable or futile battles.](#)"

Click on the link to read [Tilting at Windmills and Counterfeit Trademark Designs? on DuetsBlog.](#)



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