

# Trademark Review

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## Facebook Stops FACEMAIL

Facebook prevailed in its opposition to Think Computer's application to register the mark FACEMAIL. Think Computer had applied to register FACEMAIL for email services. The Trademark Trial and Appeal Board ("TTAB") agreed with Facebook that there was a likelihood of confusion, finding the FACEBOOK mark famous for purposes of likelihood of confusion, the marks similar, and the services nearly identical. Facebook submitted a survey showing that approximately 36% of potential consumers of email and/or instant message services thought Think's FACEMAIL services were either offered by Facebook or that the FACEMAIL mark was affiliated with Facebook in some way.

In defense, Think Computer accused Facebook of being a "trademark bully" because it uses "fraud, deceit, and an army of well-paid litigators to effectively crush any entity deemed a threat by its megalomaniacal leadership." The TTAB found nothing in the record to suggest Facebook was acting egregiously or unconscionably in pursuing the opposition.

*Facebook Inc. v. Think Computer Corp.*, Opposition number 91198355 (TTAB July 26, 2013)

## Quiksilver Hit with a \$3.5 Million Punitive Damages Award

A jury found surf wear giant Quiksilver liable for federal and common law trademark infringement and for unfair competition, and awarded World Marketing more than \$3.6 million in damages. World Marketing owns a 1998 registration for the mark VISITOR and sells clothing under that mark to stores including Saks Fifth Avenue and Macy's. Quiksilver had a clothing line under the mark VSTR. After World Marketing sent a cease and desist letter to Quiksilver, Quiksilver filed a lawsuit for declaratory relief. World Marketing counterclaimed for trademark infringement. A jury awarded World Marketing \$125,000 in reasonable royalty damages and \$3.5 million in punitive damages. World Marketing, however, was not entitled to any disgorgement of profits because Quiksilver had actually lost several million dollars on the VSTR line.

*QS Wholesale Inc. v. World Marketing Inc.*, (Case No. 8:12-cv-00451 (D.C.Cal. July 19, 2013)).

### In This Issue

- Facebook Stops FACEMAIL
- Quiksilver Hit with \$3.5 Million Punitive Damages Award
- The Battle of the Rolled Chips

## The Battle of the Rolled Chips

In a trade dress battle between snack food makers Grupo Bimbo and Snak King, the District Court denied Grupo Bimbo's request for a preliminary injunction. Grupo Bimbo claimed trade dress rights in the shape of the rolled snack. The Court, however, found that a reasonable consumer would not confuse the two rolled corn products:

Snak King's TACO-LITOS



Grupo Bimbo's TAKIS



*Grupo Bimbo SAB de CV et al. v. Snak King Corp. et al.*, (case number 2:13-cv-02147 (C.D.Cal, July 22, 2013).

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