

## Corporate & Financial Weekly Digest

Posted at 1:28 PM on October 29, 2010 by [Bruce M. Sabados](#)

### District Court Prohibits Use of Banking Logo

Co-authored by [Jonathan Rotenberg](#)

Plaintiffs, Puerto Rico-based financial institutions offering commercial banking services, sought a preliminary injunction prohibiting defendant, a Puerto Rico-based nonprofit banking institution that offered services similar to plaintiffs', from using its current mark and dress.

Plaintiffs used the term "Oriental" in connection with their businesses, services and products for decades; registered various versions of the term with the Puerto Rico Department of State Trademark Registry; and in 2010 applied to both that office and the U.S. Patent and Trademark Office to register "Oriental" for exclusive use in financial and banking services. Plaintiffs also prominently used the color orange in their advertisements.

Defendant had used the word "Oriental" in its name for a number of years, but in 2009 began using predominantly orange in its advertisements, on its website and on its storefront signs. The term "Oriental" was also made more prominent in defendant's logo.

The court determined that evidence existed that defendant's new logo and advertising campaign caused customer confusion and a loss of business, and entered a preliminary injunction against defendant. The court found that plaintiffs suffered an ongoing injury that could not be compensated, and that defendant unfairly benefited from plaintiffs' advertising efforts. Given the consumer confusion, the court concluded that an injunction preventing defendant from using its current mark and dress was necessary to prevent further harm to plaintiffs and to the public. (*Oriental Financial Group, Inc. v. Cooperativa De Ahorro Y Credito Oriental*, No. 10-1444, 2010 WL 4117236 (D.P.R. Oct. 20, 2010))

Katten Muchin Rosenman LLP  
Charlotte Chicago Irving London Los Angeles New York Washington, DC