

Summary judgment vacated in reverse confusion case

Confusion

United States - McDermott Will & Emery LLP

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In *The Great American Restaurant Company v Domino's Pizza LLC* (Case 08-40654, September 30 2009), the US Court of Appeals for the Fifth Circuit, addressing the issue of trademark genericness and infringement, has vacated a decision of the US District Court for the Eastern District of Texas in which the latter had held that the name Brooklyn Style Pizza was generic.

Plaintiff *The Great American Restaurant Company* operates a chain of restaurants in the Dallas (Texas) area called Brooklyn's Old Neighborhood Style Pizzeria. Great American owns registrations for the trademarks BROOKLYN'S OLD NEIGHBORHOOD STYLE PIZZERIA and A TASTE OF THE OLD NEIGHBORHOOD.

Defendant *Domino's Pizza LLC* introduced a style of pizza called Brooklyn Style Pizza, and used the phrase "[a] taste of the old neighborhood" for 10 months to advertise the pizza. Because Domino's is a much larger company, this presented a case of reverse confusion, where the larger and more well-known company is alleged to have used the mark of a smaller, senior user.

Great American filed claims against Domino's in the US District Court for the Eastern District of Texas for infringement of its trademarks under both the *Lanham Act* and common law. The district court granted summary judgment to Domino's on both counts. Two central factual issues were contested before the district court and on appeal:

- whether BROOKLYN STYLE PIZZA was generic; and
- whether there was a likelihood of confusion as to the source of Domino's Brooklyn Style Pizza.

The Fifth Circuit vacated the summary judgment findings. After stating the general rule that generic trademarks are entitled to no protection, the Fifth Circuit found that there was a genuine issue of fact as to whether BROOKLYN STYLE PIZZA was generic. The court stated that there was evidence from multiple sources indicating that there is no such thing as a 'Brooklyn-style pizza', so it could not be a generic term, or even a descriptive term.

The Fifth Circuit also vacated the summary judgment of no likelihood of confusion. Great American presented direct evidence of actual confusion, showing that customers attempted to use Domino's coupons at Great American restaurants. The court also held that Domino's used the exact words of Great American's trademarked phrase "[a] taste of the old neighborhood", even though Domino's eventually discontinued its use. Lastly, since this was a reverse confusion case, evidence that Domino's had acquired secondary meaning in the BROOKLYN STYLE PIZZA mark weighed in favour of Great American. Therefore, the court found that Great American had presented enough evidence of a likelihood of confusion to create a genuine issue of material fact and vacated summary judgment on that basis as well.

The decision highlights the fact that marks that have no common and easily understandable

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