

APPLICANT

Best Buy Enterprise Services, Inc.

ADDRESS

7601 Penn Avenue South
Richfield, Minnesota 55423

SERVICES IN CLASS 35

Retail store services in the field of
consumers electronics and
household appliances

DATE OF FIRST USE, CLASS 35

October 9, 1983

DATE OF FIRST USE
IN COMMERCE, CLASS 35

October 9, 1983



09-06-2007

U.S. Patent & TMO/™ Mail Rpt Dt. #51

BEST BUY

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U.S. Patent & TM Ofc/TM



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TRADEMARK APPLICATION SERIAL NO.-----

U.S. DEPARTMENT OF COMMERCE
AND PATENT AND TRADEMARK OFFICE
FEE SHEET

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK EXAMINING OPERATION**

In Re Application of:
Best Buy Enterprises, Inc.

Mark: BEST BUY

International Class: 35

Serial No.: Not Yet Assigned

Atty. Dkt. No.: BBUY:001/10212650

TRANSMITTAL LETTER

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Madam:

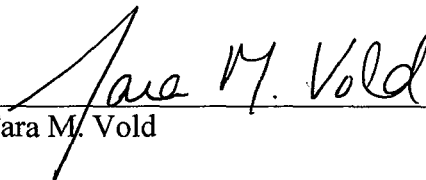
Attached are the following:

1. Application for Service Mark Registration of the mark BEST BUY; under Sections 1(a) and 2(f) in the name of Best Buy Enterprises, Inc. including Declaration and Power of Attorney;
2. One drawing showing the mark to be registered;
3. One specimen showing use of the mark;
4. Brief in Support of Application;
5. Declaration of Thomas Dupont with attachments;
6. Declaration of Ruby Anik with attachments; and
7. A check in the amount of \$375.00 to cover the filing fees.

The Commissioner is authorized to charge any additional fees associated with this filing, or credit any overpayments, to Deposit Account No. 06-2375, Order No. BBUY:001/10212650.

Respectfully submitted

Date: 9/6/2007


Tara M. Vold

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK EXAMINING OPERATION**

Mark: BEST BUY

International Class: 35

APPLICATION FOR SERVICE MARK REGISTRATION UNDER SECTIONS 1(a) AND 2(f)

Commissioner for Trademarks
P.O. Box 1451
Alexandria , VA 22313-1451

Madam:

Applicant is Best Buy Enterprise Services, Inc. a Minnesota corporation, with its principal place of business at 7601 Penn Avenue South, Richfield, Minnesota 55423.

The above-identified Applicant has adopted and is using the service mark shown in the accompanying drawing for:

**Retail store services in the field of consumers electronics
and household appliances, in International Class 35**

and requests that this mark be registered in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. § 1051 et seq., as amended).

The service mark was first used by Applicant, though its predecessors in interest, at least as early as October 9, 1983, was first used in commerce at least as early as October 9, 1983, and the mark is still in use in commerce for such services. A specimen for the Class 35 services is attached.

The mark sought to be registered has acquired distinctiveness under Section 2(f) of the Trademark Act, as demonstrated by the actual evidence of acquired distinctiveness submitted concurrently with and in support of this Application, namely the Brief in Support of Application,

the Declaration of Thomas Dupont, with attachments, and the Declaration of Ruby Anik, with attachments.

The Applicant is the owner of Registration Nos. 2,804,099, 2,673,874, 2,629,418, 2,539,223, 2,196,852, 1,899,212, 1,676,112, and 1,657, 622.

POWER OF ATTORNEY

The Applicant hereby appoints Michael S. Metteauer, member of the Bar of the State of Texas, and Tara M. Vold, member of the Bar of the District of Columbia, and Fulbright & Jaworski, L.L.P. as its attorneys and attorney, with full power of substitution or revocation, to prosecute this application, to make alterations and amendments therein, to handle all matters in the Patent and Trademark Office in connection with therewith and to receive the Certificate of Registration.

Please address all correspondence to:

Tara M. Vold
Fulbright & Jaworski L.L.P.
801 Pennsylvania Ave, N.W.
Washington, DC 20004-2623

(202) 662-0200

DECLARATION

Ruby Anik, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or registration resulting therefrom, declares:

She is a Senior Vice President of Applicant;

She is authorized to execute this instrument on behalf of the Applicant;

She believes the Applicant to be the owner of the mark sought to be registered;

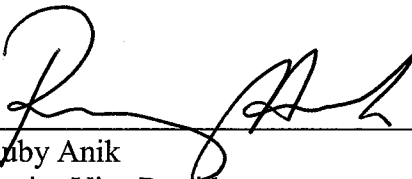
That to the best of her knowledge and belief, no other person, corporation, or association has the right to use the said mark in commerce, either in the identical form or in such near resemblance thereto as to be likely, when applied to the goods or services of such other person, to cause confusion, or to cause mistake, or to deceive;

That the facts set forth in this application are true; and

That all statements made of her own knowledge are true and all statements made on information and belief are believed to be true.

BEST BUY ENTERPRISE SERVICES, INC.

Date: 8/31/07

By: 

Ruby Anik
Senior Vice President

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK EXAMINING OPERATION

In re Application of:
Best Buy Enterprise Services, Inc.

Serial No.: _____

Filed: _____

Mark: BEST BUY

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Trademark Law Office _____

DECLARATION OF RUBY ANIK

I, Ruby Anik, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declare that:

1. I am Senior Vice President, Marketing Communications and Business Operations at Best Buy Enterprise Services, Inc. (hereinafter "Best Buy"), and am authorized to make this Declaration on its behalf.

2. I have worked for Best Buy since October, 2000. My job responsibilities include: overseeing all the marketing communications for the Best Buy Enterprise, including Advertising, Promotional Marketing, Consumer PR and Internal Communications, and Business Operations for the Marketing Capability.

Best Buy's early history

3. The company's history dates back to 1966, when Richard Schulze opened an audio specialty store called the Sound of Music in St. Paul, Minnesota, selling primarily stereo equipment.

4. In 1967, the Sound of Music ended its first year with less than \$200,000 in gross sales.

5. During the 1970's, the company added stores and product lines.

6. By 1983, the Sound of Music had increased its product offerings to include cameras, VCR's and major appliances. That same year, Sound of Music changed its name to Best Buy Company.

7. In 1984, Best Buy opened its first "superstore," featuring expanded selling space, a wide assortment of value-priced brand-name products, central service, and warehouse distribution.

8. By 1989, Best Buy had grown to approximately 40 stores in nine states, with about 3500 employees and approximately \$500 million in annual revenues.

Best Buy – 1989 to present

9. Since 1989, Best Buy has gone from a primarily Midwestern operation to one of the nation's largest retailers, with over 820 stores operating under the BEST BUY brand in forty-nine states (plus over forty stores in foreign countries), over 100,000 domestic employees and over \$30 billion in annual U.S. revenues (an over 60-fold increase over its 1989 revenues).

Since 1989, Best Buy's U.S. revenues under the BEST BUY mark collectively total over \$200 billion.

10. Best Buy currently operates over 30 million square feet of retail space under the BEST BUY mark in the U.S. The BEST BUY mark is prominently displayed at each store on exterior and interior signage and numerous displays.

11. Attached hereto as Exhibit A is a copy of the 2007 Best Buy Annual Report describing the nature and extent of Best Buy's current operations and activities.

Advertising and promotion

12. Since 1989, Best Buy Best Buy has spent over \$5 billion in promoting the BEST BUY mark through a variety of media, including but not limited to: (1) national television advertising; (2) Sunday catalogs distributed with newspapers to currently over 40 million households each week; (3) extensive Internet advertising, including the BestBuy.com website and over 200 other websites; (4) advertising in other media, such as radio, in-theater public service announcements, mobile marketing and direct mail; and (5) sponsorship of numerous entertainment and sports events.

13. As examples of its sponsorships, Best Buy is a team sponsor for the NASCAR Nextel Cup and the Best Damn Sports Show on Fox Television and has sponsored such events as the New York marathon (2002-2005), the National Hockey League (2003/2005 and 2005/2006 seasons), and the Sports Illustrated 50th Anniversary Tour (July 2003/2004). Best Buy has been a purchaser of prominent advertising space for Major League Baseball (Minnesota Twins and Chicago Cubs) and the National Football League (Minnesota Vikings and Chicago Bears). In the entertainment field, Best Buy has served as the main sponsor of four television episodes of

the Apprentice, the City of Chicago Music Festival (ongoing for 10 years) and the 2007 Police Reunion Tour.

14. Best Buy ranked no. 47 on the list of top 100 U.S. advertisers for 2006 (based on estimated annual advertising expenditures) as compiled by *Advertising Age*. Best Buy has ranked in the top 50 on this list since 2002. Copies of the 2006 *Advertising Age* article and rankings are attached as Exhibit B.

15. Best Buy's advertising and marketing initiatives, which have won numerous awards, are estimated to produce over ten billion impressions of the BEST BUY mark per year.

16. Best Buy's television commercials have aired on virtually all major U.S. broadcast and cable news networks, including on Fox, ABC, NBC, CBS, Fox News, CNN and MSNBC, and Best Buy has been mentioned in a number of prime-time television shows on major networks.

17. Best Buy has also been featured in stories run in many high-profile print media, and in a number of cases, multiple stories, including in *The New York Times*, *Wall Street Journal*, *Fortune*, *Forbes*, *Business Week*, *US News & World Report*, and *PC World*, as well as in dozens of local newspapers and magazines. Media references to Best Buy totaled over 4500 in 2006 alone and since 1990 have substantially exceeded 20,000.

Best Buy's internet presence

18. Best Buy's website, www.BestBuy.com, which prominently features the BEST BUY mark, now ranks sixth in estimated annual sales volume among all consumer/electronic retailers and eleventh overall out of the top 100 retail web sites according to *Internet Retailer*. A copy of *Internet Retailer's* rankings for 2006 are attached as Exhibit C.

19. Launched in 1998, the site had over 400 million hits in 2006 and well over one billion hits since its launch.

20. Additionally, since 2002, Best Buy's website consistently ranked among the top 10 websites in the Computer, Consumer Electronics and Home Appliance online industry in terms of online market share, according to comSource Networks. A copy of comSource Networks' rankings for 2002-2006 is attached as Exhibit D.

Evidence of brand awareness and value for the BEST BUY mark

21. *Advertising Age* ranked BEST BUY as no. 36 on its list of the top 200 "Megabrands" in 2007. These brands were ranked based on total estimated U.S. measured advertising spending. A copy of the 2007 *Advertising Age* article is attached as Exhibit E.

22. BEST BUY was ranked 86th among the Top 100 Most Powerful Brands, according to the 2007 Millward Brown BRANDZ™ report, with an estimated brand value of over \$6.6 billion. A copy of the Millward Brown BRANDZ™ report is attached as Exhibit F.

23. In the fourth quarter of 2006, the Delahaye Media Index of Corporate Reputation ranked Best Buy 26th overall out of the 100 largest U.S. companies. Attached hereto as Exhibit G is a copy of the Delahaye Media Index of Corporate Reputation for the fourth quarter of 2006.

24. According to a recent tracking study commissioned by Best Buy, at least 70% of targeted consumers are aware of the BEST BUY brand on an unaided basis. Over the life of the study (July 2006 to present), total brand awareness of Best Buy (calculated as the aggregate number of consumers which identify the BEST BUY mark through a first mention unaided, unaided or aided basis) has averaged between 98% and 100%. In the June 2007 research, at least 45% of targeted consumers identified Best Buy as the first brand that comes to mind, on an unaided basis, when thinking about purchasing consumer electronics, technology products and

entertainment items. Circuit City and Dell were next to be identified, each with only 9% top of mind awareness.

Selected recognitions and rankings

25. Best Buy was named "Company of the Year" by *Forbes* magazine in 2004. A copy of the *Forbes* article is attached as Exhibit H.

26. *Fortune* magazine named Best Buy a "Blue Ribbon" company in 2006 for being recognized on the publication's *Fortune* 500, Global 500, Most Admired and Top 100 MBA Employers lists. Copies of *Fortune's* "Blue Ribbon" rankings for 2005 and 2006 are attached as Exhibit I.

27. Best Buy was named second most-admired specialty retailer on *Fortune* magazine's list of "America's Most Admired Companies." A copy of the 2006 *Fortune* ranking is attached as Exhibit J.

28. Best Buy ranked 72nd in the *Fortune* 500 rankings for 2007, based on annual revenues. Best Buy first appeared in the *Fortune* 500 in 2003.

29. Best Buy was ranked 19th on the *Business Week* 50 for 2006 based on overall financial performance. Attached hereto as Exhibit K is a copy of the *Business Week* 50 rankings for 2006.

30. In 2001, *DSN Retailing Today* named Best Buy the "Specialty Retailer of the Decade." A copy of the *DSN Retailing Today* article is attached as Exhibit L.

Charitable activities

31. Best Buy has received extensive recognition for its community relations programs. Each year, Best Buy donates 1.5% (or more) of its pre-tax earnings to its giving programs, which are administered primarily by the Best Buy Children's Foundation. In fiscal year 2007, Best Buy gave \$25.3 million to community programs. These programs include college scholarships, technology grants to selected primary and secondary schools, and donations by local stores to youth-oriented non-profit organizations in their areas.

32. The Best Buy Children's Foundation, established in 1994, supports organizations and programs committed to making a difference in the lives of school-aged children. It provides resources to innovative programs that promote personal achievement, mentor relationships and life skills. Over the last decade (1997-2006), the Children's Foundation has donated a total of over \$55 million in grants and employee volunteer support. Further, since 1999, Best Buy, through its Children's Foundation and through corporate giving, has donated a total of nearly \$100 million.

33. Since 1999, Best Buy has awarded more than \$10 million in scholarships to more than 9000 high school seniors across the country.

34. Since 2003, Best Buy has donated over \$13 million in Te@ch Awards to more than 4800 schools across the country for purchase of classroom technology.

35. Best Buy's "Reboot & Rebuild" Program donated approximately \$8 million in equipment and funds in 2006 to help schools damaged, destroyed or over-capacitated from Hurricanes Katrina and Rita.

36. In fiscal year 2006, a donation of more than \$2 million matched customer and employee donations to the Disaster Relief Fund in response to Hurricanes Katrina, Rita and Wilma.

37. Best Buy has received numerous awards for its charitable giving. For example, in 2003, Best Buy was named the 4th "Most Generous Company in America" by *Forbes Magazine*. Best Buy was ranked 5th on *Forbes*' list of "Most Charitable Companies" in 2005. Attached hereto as Exhibit M is a copy of the *Forbes* articles.

38. Best Buy was also ranked 73rd on *CRO Magazine*'s 2007 survey of the "100 Best Corporate Citizens." This survey has gained national recognition as an indicator of best practices in the area of corporate responsibility. The list is drawn from over 1,100 of the largest U.S. publicly-traded companies. Copies of the *CRO* article and rankings are attached as Exhibit N.

* * *

I declare that the facts set forth in this Declaration are true, that all statements made of my own knowledge are true, and that all statements made on information and belief are believed to be true.

Signed at Richfield, Minnesota, this 17th of August, 2007.

By: 

Name: Ruby Anik

Title: Senior Vice President, Marketing
Communications and Business Operations

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK EXAMINING OPERATION**

In re Application of:
Best Buy Enterprise Services, Inc.

Serial No.: _____

Filed: _____

Mark: BEST BUY

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Trademark Law Office _____

BRIEF IN SUPPORT OF APPLICATION

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK EXAMINING OPERATION

In re Application of: §
Best Buy Enterprise Services, Inc. §
Serial No.: _____ § Trademark Law Office _____
Filed: _____ §
Mark: BEST BUY §

BRIEF IN SUPPORT OF APPLICATION

Applicant, Best Buy Enterprise Services, Inc. seeks registration of the mark BEST BUY on the Principal Register under Section 2(f) for “retail store services in the field of consumer electronics and major household appliances,” in Class 35. (Best Buy Enterprise Services, Inc. and its predecessors-in-interest and affiliated companies are hereafter referred to as “Best Buy.”)

In an effort to address certain issues in advance of examination, Applicant submits this brief in support of the application and, in particular, as to the registrability of the mark BEST BUY for Applicant’s services.

I. BACKGROUND

A. Best Buy’s origins

Best Buy, now one of the nation’s largest retailers, traces its history back to more modest beginnings. In 1966, Best Buy’s founder Richard Schulze opened an audio specialty store called the Sound of Music in St. Paul, Minnesota, selling primarily stereo equipment. In 1967, the Sound of Music ended its first year with gross sales of less than \$200,000.

During the 1970’s, the company added stores and product lines. By 1983, the Sound of Music had increased its offerings to include cameras, VCR’s and major appliances and changed

its name that year to “Best Buy Co.” In 1984, Best Buy opened its first “superstore,” featuring expanded selling space, a wide assortment of value-priced brand-name products, central service, and warehouse distribution. *See Declaration of Ruby Anik, filed herewith.*

B. Applicant’s prior applications to register the BEST BUY mark

In August 1984, Best Buy applied to register the service mark BEST BUY CO. & Design. The Examining Attorney refused registration on the grounds that the BEST BUY portion of the mark was merely laudatorily descriptive, noting that the “Co.” portion had already been disclaimed by Best Buy as generic. The Examining Attorney also cited two prior-filed applications for BEST BUY and BEST BUY & design for retail hardware services (Serial Nos. 73/484,889 and 73/484,314, which subsequently registered, supplemental, as 1,354,725 and 1,348,788), indicating that he would cite these against the present application under Section 2(d) in the event they matured into registrations. In response, Best Buy claimed the mark had become distinctive of its services, noting that it had used the mark since 1983 (almost two years) and had spent over \$1 million on advertising. Best Buy noted that there were a number of BEST BUY marks already on the register, some registered with less than two years of use, citing Reg. Nos. 1,225,254, 700,309, 885,547, 1,040,993 and 728,614. Best Buy also traversed the potential 2(d) rejection, noting the differences in the services and the coexistence of other similar marks on the register.

When the Examining Attorney maintained his 2(e) rejection, finding that Best Buy had not presented sufficient evidence of acquired distinctiveness, Best Buy disclaimed the remaining words of the mark (BEST BUY) rather than amending to the Supplemental Register. The application ultimately registered on July 1, 1986 but has since been cancelled (See Reg. No. 1,379,703).

Since then, Best Buy has obtained federal trademark protection for a number of marks incorporating “BEST BUY.” Following the disclaimer made in the BEST BUY CO. & Design registration, the “BEST BUY” designation was disclaimed in nearly all Best Buy’s subsequent filings, except for Reg. No. 2,539,223 (BEST BUY & Design), Reg. No. 2,619,418 (WWW.BESTBUY.COM), Reg. No. 2,638,360 (BESTBUY.COM), and Reg. No. 2,673,874 (BESTBUY.COM & Design).

C. Prior court decisions involving the BEST BUY mark

In the course of its early expansion in the Midwest under the BEST BUY brand, Best Buy opened three stores in the Kansas City, Missouri area in 1987. The following year, Best Buy was sued in Missouri federal court for trademark infringement by Best Buy Warehouse, a Kansas City office furniture retailer claiming prior use of the names “Best Buy Warehouse,” “Best Buy Office Warehouse” and “Best Buy Office Furniture.” Best Buy moved for summary judgment on several grounds, including that there was no likelihood of confusion in view of the parties’ different products and that the term BEST BUY was generic.

The district court sustained Best Buy’s motion, finding that “best buy” was generic, and not reaching the other grounds for Best Buy’s motion. *Best Buy Warehouse v. Best Buy Co., Inc.*, 751 F. Supp. 824, 827 (W.D. Mo. 1989). The court noted that there was “no evidence ... that the buying public associates ‘best buy’ with anything other than sales ‘puffing’ in the area of retail sales.” In reaching its finding of genericness, the court noted the following evidence: (1) there were numerous other businesses using “Best Buy” in their names, including in the Kansas City area; (2) the words “best” and “buy” appear in the dictionary, “best” meaning “most excellent” and “buy” meaning “to purchase”; (3) defendant’s survey of consumers in the Kansas City, Missouri area showed that “there is little if any consumer awareness of the term ‘best buy’ in reference to plaintiff’s business”; and (4) there were a number of competitors in the Kansas

City area using “best buy” in their advertising to indicate items were exceptionally good purchases. Further, “compounding the above facts, an expert patent attorney [defendant’s expert witness] and the United States Patent Office [referring to the handling of Best Buy’s first trademark application as described above] have concluded that ‘best buy’ cannot be accorded trademark protection [which] bolster[s] defendant’s contention that the general buying public understands ‘best buy’ to merely describe a general retail practice of touting particular products.” *Id.* at 826.

On appeal, the Eighth Circuit affirmed the District Court’s decision *per curiam* and held simply that the question presented was whether “the plaintiff has a legally protectable interest in the use of the words ‘best buy’ and that the district court’s opinion was “fully sufficient in its discussion of the legal issues of this case.” *Best Buy Warehouse v. Best Buy, Inc.*, 920 F.2d 536, 537, 17 U.S.P.Q.2d 1166, 1167 (8th Cir. 1990) (*per curiam*) *writ denied*, 501 U.S. 1252 (1991). The dissenting opinion, however, considered BEST BUY not generic, but rather merely descriptive, because the terminology “best buy” does not “denominate a type, a kind, a genus, or a subcategory of goods.” *Id.* The Eighth Circuit and district court decisions are collectively referred to as “the Best Buy Warehouse Decisions.”

D. Best Buy’s expansion since 1989

Since 1989, Best Buy has gone from a primarily Midwestern retail operation with approximately 40 stores in nine states, about 3500 employees and approximately \$500 million in annual revenues, to one of the nation’s largest retailers, with over 820 stores under the BEST BUY mark in forty-nine states, over 100,000 domestic employees and over \$30 billion in annual domestic revenues, an over sixty-fold increase over its 1989 revenues. Since 1989, Best Buy’s U.S. revenues under the BEST BUY mark total over \$200 billion. *See Declaration of Ruby Anik.*

As a result of Best Buy's remarkable success, as further supported below, the BEST BUY mark has become one of the most recognized marks in the country.

E. Best Buy's exposure, recognition and success under the BEST BUY mark

Best Buy's success over the past two and a half decades is attributable in no small measure to its enormous investment in building goodwill in the BEST BUY mark through advertising and promotion, backed up by delivering quality products and quality customer service, as well as through giving back to the community as a good corporate citizen. Evidence of this investment and its results includes the following objective and independent measures:

- Best Buy ranked no. 47 on the list of top 100 U.S. advertisers for 2006 (based on 2005 annual advertising expenditures) as compiled by *Advertising Age*, with a total of \$878 million in measured media and unmeasured spending. Best Buy has ranked in the top 50 on this list since 2002. Best Buy's annual advertising expenditures currently result in over 1 billion estimated media impressions each year. Best Buy has spent in excess of \$5 billion on advertising since 1989.
- *Advertising Age* ranked BEST BUY as no. 35 on its list of the top 200 "Megabrands" for 2006.
- Best Buy is ranked 86th among the Top 100 Most Powerful Brands, according to the 2007 Millward Brown BRANDZ™ report, with an estimated brand value of over \$6.6 billion.
- Best Buy ranked 76th in the *Fortune* 500 rankings for 2006. Best Buy first appeared in the *Fortune* 500 in 1995.
- Best Buy was named second most-admired specialty retailer on *Fortune* magazine's list of "America's Most Admired Companies" in 2006.
- *Fortune* magazine named Best Buy a "Blue Ribbon" company in 2006 for being recognized on the publication's *Fortune* 500, Global 500, Most Admired and Top 100 MBA Employers lists.
- In 4Q of 2006, the Delahaye Media Index of Corporate Reputation ranked Best Buy 26th overall out of the 100 largest U.S. companies.
- Best Buy ranked 73rd on *CRO* Magazine's 2007 survey of the "100 Best Corporate Citizens."
- Best Buy was named "Company of the Year" by Forbes in 2004.

- Best Buy's website, www.BestBuy.com, which prominently features the BEST BUY mark, now ranks sixth in sales volume among all consumer/electronic retailers and eleventh in overall in Top Retail Sites (*Internet Retailer*). Launched in 1998, the site had over 400 million hits in 2006 and over 1 billion hits since its launch.

Supporting documents and additional evidence is set out in the *Declaration of Ruby Anik*.

Clearly, Applicant's advertising and promotional efforts and other goodwill-building activities have not only been substantial – they have also been quite effective.

II. REGISTRABILITY OF THE "BEST BUY" MARK TODAY

Since the time of the Best Buy Warehouse decisions, Applicant's BEST BUY mark has acquired a level of consumer recognition that establishes it among the most well-known marks in the country. As such, the circumstances surrounding the evaluation of the protectability of the BEST BUY mark today is dramatically different from the circumstances before the court that resulted in the Best Buy Warehouse decisions. As explained in more detail below, to deny this mark protection as a source identifier for Applicant's services under these changed circumstances would be contrary to the purposes of the Trademark Act and would be manifestly unjust to Applicant and to the consumers who rely upon Applicant's BEST BUY mark to identify Applicant's services.

A. The evidence overwhelmingly demonstrates that consumers associate BEST BUY as a source identifier for Applicant's services.

Regardless of what BEST BUY meant to Kansas City consumers in 1989, today BEST BUY clearly identifies Applicant to consumers. Best Buy's sales under the BEST BUY mark, as noted above, and corresponding advertising efforts (which total over \$5 billion since 1989) amply support an inference that the BEST BUY mark has acquired secondary meaning and now means Applicant to consumers. The expected impact of this advertising is corroborated by the reputation rankings and other rankings noted above, but also by Best Buy's own market

tracking research, which indicates that at least 70% of targeted consumers are aware of the BEST BUY brand on an unaided basis. Further, over the life of that study (July 2006 to present), total brand awareness of Best Buy (calculated as the aggregate number of consumers which identify the BEST BUY mark through a first mention unaided, unaided or aided basis) has averaged between 98% and 100%. Pursuant to the June 2007 study results, at least 45% of targeted consumers identified Best Buy as the first brand that comes to mind, on an unaided basis, when thinking about purchasing consumer electronics, technology products and entertainment items. Circuit City and Dell were next to be identified, each with 9% top of mind awareness. *See Declaration of Ruby Anik.*

Finally, and perhaps most notably, Applicant has conducted a survey through an independent expert which confirms the present meaning of BEST BUY to consumers. In particular, Best Buy last year commissioned a survey conducted by D² Research to determine whether consumers perceive “BEST BUY” as a brand name or as a generic (common) name (hereafter referred to as the “2006 Consumer Survey”). The 2006 Consumer Survey reflected that an overwhelming 89% of respondents regarded BEST BUY as a brand name for a business that sells electronics and appliances, and not as a generic designation. A copy of the survey report is attached to the *Declaration of Dr. Thomas DuPont* offered concurrently herewith. The results of the 2006 Consumer Survey, which followed the accepted *Teflon* format, are projectable over the entire U.S. consumer population over 18 years of age. This survey demonstrates that the relevant consuming public understands the difference between a trademark and a generic term, and indisputably reflects that the vast majority of consumers regard BEST BUY as a trademark.

To put this evidence in proper context, the 89% who believed BEST BUY is a mark was higher than two other well-known marks tested in the survey, AMAZON.COM at 82% and HOME SHOPPING NETWORK at 66%, and comparable to DAIRY QUEEN (92%) and TOYS R US (91%). Applicant's survey results are even stronger than those in the survey of the landmark *Teflon* case and than similar surveys for other well-known marks. *See, e.g., E.I. du Pont v. Yoshida Int'l*, 393 F. Supp. 502, 526 (E.D.N.Y. 1975) (TEFLON not generic where 68% considered it a mark); *Coca-Cola v. Overland*, 692 F.2d 1250, 1254 n.11, 216 U.S.P.Q. 579 (9th Cir. 1982) (COKE not generic where 76% considered it a mark); *Burger King v. Pilgrim's Pride*, 705 F. Supp. 1522, 1526 (S.D. Fla. 1988), *aff'd* 894 F.2d 412 (11th Cir. 1990) (CHICKEN TENDERS not generic where 60% considered it a mark).

Under these circumstances, there can be no doubt that the primary significance of the term BEST BUY to today's relevant consumers is as a source identifier for Applicant's electronics retail stores, that the BEST BUY mark is currently not understood as generic for such services, and that, accordingly, the BEST BUY mark is deserving of (and entitled to) trademark protection and registration.

B. BEST BUY is not generic under the controlling *Marvin Ginn* analysis.

The traditional genericness inquiry established by the Federal Circuit "involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered . . . understood by the relevant public primarily to refer to that genus of goods or services?" *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 U.S.P.Q. 528 (Fed. Cir. 1986). The test of genericness is thus a factual inquiry into the primary significance of the contested term as it is used and understood by the relevant segment of the consuming public. *In re Web Communications*, 49 U.S.P.Q. 2d 1478, 1479 (T.T.A.B. 1998).

As noted in the dissenting opinion of the Eighth Circuit in *Best Buy Warehouse*, the term BEST BUY is not generic because it does not fit into this traditional genericness inquiry, that is it does not contain any use of the generic or common descriptive name of the goods or services at issue (i.e., “electronics” or “the retail sale of electronic goods”), or describe a fundamental characteristic of the genus of “electronics” or “the retail sale of electronic goods.” *Best Buy Warehouse*, 920 F.2d at 537 (citing *Henri's Food Products, Co. v. Tasty Snacks*, 817 F.2d 1303, 1304, 2 U.S.P.Q. 2d 1856 (7th Cir. 1987)).

In addition to not directly naming a product or genus of goods or services, the BEST BUY mark also does not name the purpose or a distinctive characteristic of the goods or services at issue. The TTAB has stated that a term that does not directly name a product but identifies the most important purpose of the product is a type of generic name known as a “generic adjective.” *See, e.g., In re Reckitt & Coleman North America, Inc.*, 18 U.S.P.Q.2d 1389, 1391 (T.T.A.B. 1991) (PERMA PRESS held to be a generic name for a type of garment as well as a generic name for a stain remover designed to clean that product). “Generic adjectives” are a subcategory of generic terms within a larger genus, whose primary significance to consumers is to describe a fundamental characteristic or quality of items within that genus. *See Continental Airlines, Inc. v. United Airlines, Inc.*, 53 U.S.P.Q.2d 1385 (T.T.A.B. 1999) (finding E-TICKET to be a generic term for “computerized reservation and ticketing of transportation services”); *In re Central Sprinkler Co.*, 49 U.S.P.Q.2d 1194 (T.T.A.B. 1998) (finding ATTIC generic as applied to automatic sprinklers for fire protection); *In re Reckitt & Coleman*, 18 U.S.P.Q.2d 1389 (finding PERMA PRESS generic for soil and stain removers); *In re Web Communications*, 49 U.S.P.Q.2d 1478 (finding WEB COMMUNICATIONS generic because it designates a type of consulting services offered by the applicant).

In contrast to the terms above which were found to describe a fundamental characteristic or quality, the term BEST BUY is instead a laudatory mark which speaks to the alleged merit of the product or service at issue and is protectable with secondary meaning. *See* 1 J. McCarthy, *McCarthy on Trademark and Unfair Competition* §11.17 (4th ed. 2006) “Self-laudatory or ‘puffing’ marks are regarded as condensed forms of describing the character or quality of the goods. This category includes such marks as ‘Best,’ ‘Premier,’ ‘America’s Best’ and ‘Super Buy.’”) *See* discussion *infra* at Section II.C.

Just as importantly, the BEST BUY term is not generic because the *second* prong of the genericness inquiry is not satisfied. Specifically, the BEST BUY term is not understood by the relevant public primarily to refer to the genus of “electronics” or of “the retail sale of electronic goods.” *See Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 118, 59 S. Ct. 109, 83 L. Ed. 2d 73 (1938) (emphasis added) (holding that in order to prove trademark significance in a term challenged as generic, it must be proven that the “primary significance of the term in the minds of the consuming public is not the *product* but the *producer*”).

In 1984, the Lanham Act was amended to codify the “primary significance” test as the one and only test of genericness. 2 J. McCarthy, *McCarthy on Trademark and Unfair Competition* §12:7 (4th ed. 2006). In particular, Section 14(3) of the Lanham Act was amended to include the following sentence:

The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.

The Federal Circuit has stated that the 1984 amendment dictates that primary significance to actual or potential consumers of the goods or services is the appropriate test. *See Magic Wand*,

Inc. v. RDB, Inc., 940 F.2d 638, 640, 19 U.S.P.Q. 2d (Fed. Cir. 1991) (“The 1984 amendment makes the understanding of the ‘relevant public’ central to the genericness inquiry.”)

Here, any uncertainty regarding whether the BEST BUY mark is understood by the relevant public primarily to refer to the genus of “electronics” or “the retail sale of electronic goods” is eliminated by the 2006 Consumer Survey, using the *Teflon* methodology, which answers this inquiry in the negative by showing that 89% of the respondent-consumers recognized the BEST BUY mark *not* as referring to the genus of products and services offered by Applicant, but instead, as a source identifier for Applicant itself.

C. BEST BUY is most accurately classified as a descriptive laudatory mark.

It is well settled that laudatory marks routinely are registrable on the Principal Register with a showing of secondary meaning. *Exquisite Form Industries, Inc. v. Exquisite Fabrics of London*, 378 F. Supp. 403 (S.D.N.Y. 1974) (“The weakness of the [laudatory] mark, of course is not fatal if the owner can establish a secondary meaning.”); *Taylor Brothers, Inc. v. The Pinkerton Tobacco Company*, 231 U.S.P.Q. 412 (TTAB 1986) (finding applicant established acquired distinctiveness for laudatory slogan).

When examining the registrability of laudatory marks such as BEST BUY -- which do not contain the generic or common descriptive name of the goods or services -- the relevant inquiry is whether the mark is descriptive or suggestive, not whether the mark is generic. *Taylor Brothers*, 231 U.S.P.Q. at 414 (AMERICA’S BEST CHEW found registrable under Section 2(f) for chewing tobacco). *See, also, In re Consolidated Cigar Co.*, 35 U.S.P.Q.2d 1290 (TTAB 1995) (SUPER BUY found descriptive of tobacco products); *In re Truck-Lite Co., Inc.*, 2006 TTAB LEXIS 26 (SUPER found suggestive for lighting products).

While Applicant recognizes the line of decisions finding certain laudatory marks so highly laudatory as being incapable of functioning as a mark, the marks involved in each of those

cases involved the inclusion of the generic or common descriptive name of the goods or services. *Burmel Handkerchief Corp. v. Cluett, Peabody & Co., Inc.* 53 U.S.P.Q. 368, 372 (CCPA 1942) (HANDKERCHIEF OF THE YEAR); *In re Carvel Corp.*, 223 U.S.P.Q. 65 (TTAB 1984) (AMERICA'S FRESHEST ICE CREAM); *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 U.S.P.Q.2d 1056 (Fed. Cir. 1999) *aff'g* 47 U.S.P.Q.2d 1914 (TTAB 1998) (THE BEST BEER IN AMERICA); *Tequila Cuervo La Rojena v. Cointreau Corp.*, 2000 TTAB LEXIS 95 (THE ORIGINAL MARGARITA). The Board itself has recognized this distinction. *Taylor Brothers, Inc. v. The Pinkerton Tobacco Company*, 231 U.S.P.Q. 412 (TTAB 1986) (distinguishing AMERICAN BEST CHEW from marks like AMERICA'S FRESHEST ICE CREAM for the reason that the generic or common descriptive name of the goods is not part of the slogan).

Further, in each of the cases where the laudatory mark was found unregistrable, there was no direct evidence, as there is here, of consumer perception of the source identifying function of the mark. Indeed, any suggestion that the term BEST BUY is incapable of functioning as a source identifier is belied by the 2006 Consumer Survey in which an overwhelming 89% of survey participants understood the term BEST BUY to be an indication of source and not a generic designation. As the Examining Attorney is aware, consumer surveys, in addition to dictionaries, have been identified as the best means of answering the "primary significance" test's central question as to how the relevant public understands a term. *Heroes Inc. v. Boomer Esiason Hero's Found.*, 43 U.S.P.Q.2d 1193 (D.D.C. 1997).

D. The Best Buy Warehouse Decisions do not preclude allowance of the instant application.

In light of the evidence presented above, the genericness finding of the Best Buy Warehouse Decisions should not be given preclusive effect because the factual circumstances controlling those decisions have changed to such an extent that they now bear little relationship to the realities of today's retail market.

In reaching its determination that the BEST BUY mark was unprotectable, the Missouri district court considered the level of buyer understanding of the term "best buy" then existing in the local retail market. *See Best Buy Warehouse*, 751 F. Supp. at 826. In light the state of the retail services market in the 1989 time frame and, more specifically, the lack of evidence of any particular understanding at that time of the term BEST BUY in the minds of Kansas City consumers, the district court concluded that the BEST BUY mark was generic and therefore unprotectable. *Id.* at 826-27.

By contrast, in today's retail services market, the term BEST BUY does indeed evoke a particular association in the minds of consumers, namely to Applicant, as evidenced by the 89% national consumer recognition identified in the 2006 Consumer Survey. This high level of brand recognition for the BEST BUY mark simply did not exist at the time the Best Buy Warehouse Decisions were rendered. Indeed, the regional retailer described in those decisions bears little resemblance to Applicant, now a Fortune 100 company. Accordingly, Best Buy should not be judicially or collaterally estopped from revisiting and disputing the alleged generic status of the BEST BUY mark. Requiring a party to pick a position and "stick to it in perpetuity" without regard to whether the facts which dictated that party's initial position have changed over time runs counter to the principles of equity upon which the doctrines of judicial and collateral estoppel are based, does nothing to further the purpose of those doctrines or the consumer

protection policy underlying the Lanham Act, and is simply unjust under the circumstances of this case.

Moreover, in view of the completely altered nucleus of operative facts underlying the Best Buy Warehouse Decisions, those decisions bear no relation to today's retail environment. Accordingly, a re-determination of the status of the BEST BUY mark is not only appropriate and warranted, but well overdue.

1. The doctrine of judicial estoppel should not apply here.

Judicial estoppel is an equitable doctrine to be invoked by the court at its discretion. *See New Hampshire v. Maine*, 532 U.S. 742, 750, 121 S. Ct. 1808, 149 L. Ed. 2d 968 (2001). The doctrine is intended to preclude a party's use of intentional self-contradiction as a means of obtaining unfair advantage. *See id.* at 749-50.

In the instant case, Applicant should not be precluded under principles of judicial estoppel from disputing the old status of the BEST BUY designation for at least the following reasons:

1. Preclusion may not apply where, as here, the position taken by a party in a later case is not "clearly inconsistent" with that assumed by the party in the earlier case;
2. Preclusion in this instance would not further the doctrine's goal of protecting our judicial system; and
3. Preclusion in this instance would work considerable injustice not only on Applicant, but on the consuming public as well.

Accordingly, because a consideration of the pertinent facts and equities weighs against application of judicial estoppel, the Best Buy Warehouse Decisions should not preclude Best Buy from getting a reexamination of the status of the BEST BUY mark before the United States Patent and Trademark Office.

a. The absence of clearly inconsistent positions precludes application of judicial estoppel.

Judicial estoppel is an equitable doctrine and will apply only if a party's later position is "clearly inconsistent" with its earlier position. *See New Hampshire v. Maine*, 532 U.S. at 750. Indeed, as the Federal Circuit has stated, the doctrine of judicial estoppel "should not be applied when the former position was the result of inadvertence or mistake or when there is only an appearance of inconsistency between the two positions." *Lampi Corp. v. Am. Power Prods.*, 228 F.3d 1365, 1377, 56 U.S.P.Q. 1444 (Fed. Cir. 2000).

Here, Best Buy's earlier position that "best buy" was generic (and the district court's determination to that effect) was based, in part, on a regional consumer survey demonstrating that "best buy" was not associated by consumers in the Kansas City area with the plaintiff Best Buy Warehouse's particular business or the products he sold and the lack of evidence that that the buying public, at that time, associated 'best buy' with anything other than sales puffing in the area of retail sales. *See Best Buy Warehouse*, 751 F. Supp. at 826-27.

With respect to the first ground, Best Buy's position is still the same – the plaintiff's use of "Best Buy" had not created a protectable interest in the designation. With respect to the second ground, i.e. that there was a lack of any association by consumers with BEST BUY as anything other than sales puffery – those factual circumstances no longer exist.

In the seventeen years since the Best Buy Warehouse Decisions were rendered, Applicant Best Buy has evolved from a regional consumer electronics retailer into the nation's largest specialty retailer of consumer electronics, with gross revenues for this period totaling over \$200 billion. Coupled with this growth has been an establishment of consumer awareness of BEST BUY as a brand – at a level which now stands at 89% per the 2006 Consumer Survey.

Furthermore, since the Best Buy Warehouse Decisions were issued in 1989 and 1990, Applicant Best Buy has invested over \$5 billion in advertising and promoting the BEST BUY marks through a variety of media, including but not limited to: (1) extensive Internet advertising, including the BestBuy.com website (over 1 billion hits since its launch) and over 200 other websites; (2) Sunday catalogs distributed with newspapers to over 40 million households each week; (3) national television advertising and advertising in other media, such as radio, in-theater public service announcements, mobile marketing and direct mail; and (4) sponsorship of numerous entertainment and sports events. Best Buy's award-winning advertising and marketing initiatives are estimated to produce well over a billion impressions of the BEST BUY mark per year. *See Declaration of Ruby Anik.*

In short, Best Buy's position in the earlier infringement suit that the BEST BUY designation was generic was based on the perceived factual conditions existing in that time frame, which established no consumer association of the term "best buy" with any particular company. Of course, lack of association with a particular company is not really the test for genericness, then or now. Applicant's position today, that BEST BUY is deserving of trademark protection, is based on an entirely altered set of factual conditions and, therefore, is not "clearly inconsistent" with the position Applicant assumed in the earlier Best Buy Warehouse Decisions.

b. Preclusion in this instance does not further the judicial estoppel doctrine's goal of protecting our judicial system.

The goal of the doctrine of judicial estoppel is to protect the judicial system from misuse by litigants. The Supreme Court has recognized that "[b]ecause the rule is intended to prevent 'improper use of judicial machinery,' [citation omitted], judicial estoppel 'is an equitable doctrine invoked by a court at its discretion.'" *New Hampshire v. Maine*, 532 U.S. at 750.

As an equitable doctrine, judicial estoppel “should be applied flexibly, with an intent to achieve substantial justice.” 18 J. Moore, MOORE’S FEDERAL PRACTICE § 134.31 (Matthew Bender 3d ed.); *see also New Hampshire v. Maine*, 532 U.S. at 751 (declining to establish “inflexible prerequisites or an exhaustive formula for determining the applicability of judicial estoppel” and recognizing that “[a]dditional considerations may inform the doctrine’s application in specific factual contexts”).

In the instant case, given the substantial intervening change in the use and understanding of the BEST BUY mark, resulting in large measure from Best Buy’s extensive sales and advertising, Best Buy’s current application cannot reasonably be perceived as an attempt to take advantage of or as a misuse of the judicial system.

Moreover, this is decidedly not a case of a party taking divergent positions in proceedings arising out of the same nucleus of operative facts. Rather, the underlying facts today are so substantially different from those underlying the Best Buy Warehouse Decisions as to render the determination of genericness in the earlier suit wholly inapposite in this new environment. Under these new circumstances, refusing to permit Best Buy a new examination of the status of its mark because of a position asserted so long in the past, and bearing little or no relationship to the realities of today’s retail services market, including current consumer recognition of the BEST BUY mark, would do nothing to protect the integrity of the judicial system. *Opryland USA v. Great American Music Show*, 970 F.2d 847, 853 (Fed. Cir. 1992) (holding that plaintiff was not estopped from presenting evidence of present public perception of the term “opry” given the potential for changed circumstances in the eight years since an earlier decision declaring the mark generic.) *See also Abercrombie & Fitch Co. v. Moose Creek Inc.*, Case No. 06-56774, (9th Cir. May 20, 2007) (judicial estoppel found to be an abuse of discretion when applied to

argument that plaintiff's mark was entitled to only a narrow scope of protection on grounds of third party use where field of third party use had changed).

A decision from the U.S. District Court for the Northern District of Georgia, *Meadowcraft, Inc. v. Bland*, based in part on a change in the laws of trade dress, is also instructive on this point. In *Meadowcraft*, a wrought iron furniture manufacturer filed a suit against a business competitor for trade dress infringement and conspiracy to infringe on its trade dress rights. The defendants moved for summary judgment arguing, in part, that the plaintiff was judicially estopped from taking a position inconsistent with that taken by plaintiff twelve years earlier. The district court held the doctrine of judicial estoppel inapplicable. *Meadowcraft, Inc. v. Bland*, 1997 U.S. Dist. LEXIS 22923, *20 (N.D. Ga. 1997). In reaching its decision, the court stressed the fact that the case did not fall within the class of cases “where a party is attempting to (1) take divergent positions on identical discrete factual or legal issues in contemporaneous litigations, [citations omitted]; or (2) take divergent positions in litigations or proceedings that arise from the same common nucleus of operative facts.” *Id.* Rather, the court determined that the underlying facts of the litigation were not even substantially similar to those of the previous litigation, most notably, because “over the past twelve years, the consuming public for wrought iron furniture and the industry itself have expanded and changed over time,” and the positions taken by the plaintiff twelve years earlier had necessarily been modified to fit this evolving market. *Id.* at *20. The court stated it was “aware of no rule that dictates that a party pick a position and stick to it in perpetuity irrespective of whether the facts and law which dictated that party’s initial position have changed over time.” *Id.* at *20-21.

c. Preclusion in this instance would result in injustice.

Additional equitable considerations also militate against application of judicial estoppel in this case. *See New Hampshire v. Maine*, 532 U.S. at 751 (recognizing that “[a]dditional considerations may inform the doctrine’s application in specific factual contexts”).

First, the Lanham Act’s underlying purpose of consumer protection weighs against application of the doctrine here. The principles underlying the Lanham Act, and trademark law in general, are intended to assure consumers that products or services with the same trademark originate from the same source. Refusing to allow Applicant Best Buy to assert the protectability of the BEST BUY mark despite drastic changes in market conditions would effectively foreclose Best Buy’s ability to secure registration of its mark (notwithstanding its ability to make the appropriate showing necessary for such protection). Moreover, such preclusion would enable third parties to propagate confusion among consumers of electronics products and appliances by trading on the valuable BEST BUY name using confusingly similar or even identical marks. Clearly, this outcome would turn the Lanham Act’s purpose of consumer protection on its head.

Second, application of judicial estoppel under these circumstances would work considerable injustice on Best Buy and its customers. To preclude Best Buy from revisiting the status of its mark despite the overall change in market conditions and widespread consumer recognition of the BEST BUY brand would effectively wipe out Best Buy’s efforts at building brand recognition and allow unfettered use of BEST BUY as a mark by competing businesses, to the detriment of both Applicant and its customers. As Judge Posner stated:

To determine that a trademark is generic and thus pitch it into the public domain is a fateful step. It penalizes the trademark’s owner for his success in making the trademark a household name and ... may confuse consumers who continue to associate the trademark with the owner’s brand when they encounter what they thought a brand name on another seller’s brand.

Ty Inc. v. Softbelly's Inc., 353 F.3d 528, 69 U.S.P.Q.2d 1213, 1215 (7th Cir. 2003).

2. The doctrine of collateral estoppel should not apply here.

Collateral estoppel is an equitable doctrine which bars litigation of the same issue in a second action. The purpose of the doctrine is to protect litigants from the burden of re-litigating an identical issue with the same party or his privy and to promote judicial economy by preventing needless litigation. *See Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 326, 99 S. Ct. 645 (1979).

In order for collateral estoppel to be applied, the following requirements *must* be met: (1) the issue at stake must be identical to the one involved in the prior litigation; (2) the determination of the issue in the prior litigation must have been a critical, necessary part of the judgment in that earlier action; and (3) special circumstances must not exist which would render preclusion inapplicable. *Montana v. United States*, 440 U.S. 147, 154, 99 S. Ct. 970, 974 (1979). In the absence of any one element, the doctrine does not apply.

Best Buy should not be collaterally estopped from revisiting the status of the BEST BUY mark for at least the following reasons:

1. The absence of an identity of issues renders the preclusion inapplicable;
2. The existence of special circumstances renders preclusion inapplicable; and
3. Preclusion in this instance would defeat the public policy underlying the Lanham Act.

As with the doctrine of judicial estoppel, a consideration of the pertinent facts and equities weighs against application of collateral estoppel.

a. The absence of an identity of issues renders preclusion inapplicable.

Given the inherent mutability of trade marks and the contextual nature of the “genericness” analysis as demonstrated by the Best Buy Warehouse Decisions -- namely the

determination of the protectability of BEST BUY not as an absolute matter but in view of specific factual conditions prevailing at that time -- a re-determination of the protectability of the BEST BUY mark under current factual conditions necessarily presents a separate and independent legal question.

In a situation such as this, where all questions of fact and/or law involved in a later proceeding were not determined in the earlier one, the doctrine of collateral estoppel will not apply. *See Mayer/Berkshire Corp. v. Berkshire Fashions, Inc.*, 424 F.3d 1229, 1234 (Fed. Cir. 2005) (quoting *Litton Industries, Inc. v. Litronix, Inc.*, 577 F.2d 709, 711 (C.C.P.A. 1978)); *see also Russell v. Place*, 94 U.S. 606 at 610, 24 L. Ed. 214 (1876) (denying preclusion in a patent infringement case and stating that “an estoppel must ‘be certain to every intent;’ and if upon the face of a record any thing is left to conjecture as to what was necessarily involved and decided, there is no estoppel in it when pleaded, and nothing conclusive in it when offered as evidence.”); *McNellis v. First Fed. Sav. And Loan Asso.*, 364 F.2d 251, 257 (2d Cir. 1966) (holding that “a reasonable doubt as to what was decided in the first action should preclude the drastic remedy of foreclosing a party from litigating an essential issue”).

This concept is well illustrated, in the instant trademark “genericness” context, by the Opry line of cases. WSM had provided entertainment services under the GRAND OLD OPRY mark since 1927 and obtained a registration for the mark in 1950. In the ensuing years, WSM obtained a number of additional registrations incorporating the OPRY designation. In 1962, an individual by the name of Lee Mace registered the mark OZARK OPRY for entertainment services. WSM sued. The parties ultimately settled.

In 1970, a Denny Hilton began using the mark “Country Shindig.” In 1973 Hilton changed the name to “Denny Hilton’s Country Shindig and Opry Show.” WSM brought an

infringement and unfair competition suit based on its rights in GRAND OLE OPRY, OZARK OPRY and other marks.

The district court held the term OPRY to be generic in connection with country music performances. In reaching this conclusion, the court evaluated historical and current usage of the term OPRY and found the generic nature of the term (as a dialectical and satirical version of the term “opera”) had not changed since the eighteenth century. *WSM, Inc. v. Hilton*, 545 F. Supp. 1212, 1218 (W.D. Mo. 1982). On appeal, the U.S. Court of Appeals for the Eighth Circuit referred to this finding and further explained its affirmation of the district court’s holding of genericness by noting that “[t]here is *temporally relevant evidence* in the record to support a finding that the *current* use of the word by the consuming public is of a generic nature.” *WSM, Inc. v. Hilton*, 724 F.2d 1320, 1327 (8th Cir. 1984) (emphasis added).

The question of the genericness of OPRY arose again in 1992, when Opryland USA (WSM’s successor) attempted to cancel the Great American Music Show’s registration for THE CAROLINA OPRY and oppose a second application. Cancellation No. 18,246; Opposition No. 80,323 (T.T.A.B. Nov. 16, 1990). The TTAB granted summary judgment for Great American Music Show in both proceedings upon its determination that no confusion was likely because OPRY was generic and Opryland USA was estopped on the basis of the Eighth Circuit decision from revisiting the issue of genericness. Opryland USA then appealed to the Federal Circuit.

The Federal Circuit reversed and remanded the TTAB’s grant of summary judgment, holding that Opryland USA was improperly denied the right to “obtain evidence on the material facts of public perception and actual confusion.” *Opryland USA v. Great American Music Show*, 970 F.2d 847, 853 (Fed. Cir. 1992). Paramount to the court’s reversal was the fact that Opryland

USA had not been given the opportunity to present evidence relevant to how the public perceived and used the term OPRY *currently, i.e.*, in 1992.

After remand from the Federal Circuit, the Board ultimately dismissed the cancellation/opposition proceeding. Gaylord Entertainment (successor to Opryland USA), then sought review of the Board's decision by way of a civil action. *Gaylord Entertainment v. Gilmore Entertainment Group*, 187 F. Supp. 2d 926 (M.D. Tenn. 2001). Gilmore argued that OPRY was generic and moved for summary judgment, which was denied by the district court. *Id.* The district court held that "Gaylord is not collaterally estopped from litigating the primary significance to the relevant public of the term 'Opry' today." *Id.* at 942. Further, the district court emphasized that summary judgment was improper because Gaylord's evidence presented a genuine issue of material fact as to whether the *current* public understanding of OPRY was primarily as a brand or as a generic term. *Id.* at 942, 944. Ultimately, in 2002, the district court held that OPRY was no longer generic, and was a "well known and famous" mark that the public understands to identify Gaylord Entertainment as "the sole source of the goods and services sold in connection with the OPRY mark." *Gaylord Entertainment Co. v. Gilmore Entertainment Group, LLC*, No. 3-99-0699 (M.D. Tenn., October 21, 2002) (Final Judgment).¹

Likewise, as discussed earlier in Section D.1.a., the issue adjudicated in the Best Buy Warehouse Decisions is not the same issue currently before the Examiner. Accordingly, the application of collateral estoppel is inappropriate.

¹ As a result of the remand from the District Court, the parties ultimately settled the case. Pursuant to the settlement, Gilmore agreed to assign the registration for THE CAROLINA OPRY to Gaylord and Gaylord agreed to dismiss the opposition proceeding without prejudice.

b. The existence of special circumstances renders collateral estoppel inapplicable.

Even if one were to ignore the contextual nature of the inquiry and presuppose that the factual issues involved in the current proceeding are determined to be identical to those previously at issue in the Best Buy Warehouse Decisions, preclusion is nevertheless inappropriate because the *circumstances* controlling the earlier decisions no longer accurately depict the situation in today's retail services market. Instead, a significant intervening change in market conditions and the level of consumer understanding of the BEST BUY mark necessitate a reexamination of the mark's status and preclude application of collateral estoppel.

The Supreme Court has held that in determining the applicability of collateral estoppel, it is proper to consider whether controlling facts or legal principles have changed since the initial determination. *See Montana v. United States*, 440 U.S. at 155. Indeed, according to the Court, “[i]t is, of course, true that changes in facts essential to a judgment will render collateral estoppel inapplicable in a subsequent action raising the same issues.” *Id.* at 159; *see also Russell v. Place*, 94 U.S. 606, 610, 24 L. Ed. 214 (1877) (“an estoppel must be certain to every intent”); *Int'l Shoe Machine Corp. v. United Shoe Machine Corp.*, 315 F.2d 449, 455 (1st Cir. 1963) (recognizing that “the passage of time may evoke change of circumstances which preclude the creation of an estoppel.”)

In the context of trademark law, courts and administrative panels have often refused to apply collateral estoppel and/or res judicata when the circumstances upon which the prior holding was based no longer prevail due to an intervening factual change. *See, e.g., Mayer/Berkshire Corp. v. Berkshire Fashions Inc.*, 424 F.3d at 1233 (recognizing that “[a] change in trademark usage can constitute a change in transactional facts that avoids preclusion”; *Opryland USA*, 970 F.2d at 853 (holding that a plaintiff was not collaterally estopped from

presenting evidence of present public perception of the term “opry” given the potential for changed circumstances in the eight years since an earlier decision declaring the term generic); *Haymaker Sports, Inc. v. Turian*, 197 U.S.P.Q. 32, 39 (T.T.A.B. 1977), *aff’d on point, rev’d on other grounds*, 581 F.2d 257, 198 U.S.P.Q. 610 (C.C.P.A. 1978) (holding when the circumstances upon which a prior holding was based may no longer prevail or where significant intervening events may have occurred, the operation of the doctrine of collateral estoppel may be put aside); *In re Honeywell, Inc.*, 8 U.S.P.Q.2d 1600, 1602 (T.T.A.B. 1988) (previous decision held that thermostat cover was not registrable as being functional; shape was held non-functional twelve years later because of a change in intervening facts and circumstances); *Johnson & Johnson v. Rexall Drug, Co.*, 186 U.S.P.Q. 167, 170 (T.T.A.B. 1975) (the claim that the BAND-AID mark was generic, though unsuccessful thirteen years earlier, was not precluded by res judicata or collateral estoppel; applicant was merely precluded from introducing evidence from the time period prior to the previous judgment); *Plus Prods. v. Natural Organics, Inc.*, 223 U.S.P.Q. 27, 28 (S.D.N.Y. 1984) (denying affirmative use of collateral estoppel on issue of likelihood of confusion, despite an identity of issues, where “the markets, consumers, volume of business and advertising of the parties have changed significantly”).

As discussed earlier in Section D.1.a., it is beyond question that the factual circumstances upon which the Missouri district court based its decision, namely, the lack of consumer association of the term “best buy” with anything more than sales “puffing,” have changed considerably in the seventeen years since the decision was rendered. Moreover, these factual circumstances were essential to the district court’s determination that the term BEST BUY was generic.

Accordingly, under these circumstances, the doctrine of collateral estoppel should not be applied to prevent Best Buy from getting a reexamination of the status of the BEST BUY mark.

c. Preclusion in the instant case would defeat the consumer protection policies underlying the Lanham Act.

For the reasons set forth in Section II.E.3 *supra*, the consumer protection policies underlying the Lanham Act would not be furthered by application of collateral estoppel in these circumstances. As noted, the 2006 Consumer Survey, a statistically projectable survey over the relevant consumer population, indicated that 89% of respondents recognized BEST BUY as a source identifier for Applicant's services. Indeed, as noted above, denying Best Buy the opportunity even to revisit the status of the BEST BUY term would ultimately increase rather than abate consumer confusion in the marketplace as it would open the door for other businesses to use BEST BUY as a mark and thereby trade off Applicant's valuable goodwill.

An examination of the BEST BUY mark under current factual conditions, regardless of any historical finding of genericness, should lead the Examining Attorney to the inevitable conclusion that the term BEST BUY is, today, capable of source identifying function and, in fact serves that function, and is therefore eligible for registration on the Principal Register.

E. The doctrine of de facto secondary meaning does not prevent the BEST BUY mark from attaining trademark status.

The so-called "de facto secondary meaning" doctrine has been relied on by some courts to prevent a generic term which has subsequently acquired some degree of source significance from attaining trademark status. See 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 12:47 (4th ed. 2006). Specifically, courts have used the doctrine to explain why evidence of some consumer association of a generic term with the trademark owner does not make the term protectable. Marc C. Levy, *From Genericism to Trademark Significance: Deconstructing the De Facto Secondary Meaning Doctrine*, 95 Trademark Rep. 1197, 1204

(2005) (citing cases). This notwithstanding, “[n]o court has ever invalidated a trademark as generic based exclusively on historical evidence, where the undisputed current primary significance of the mark is as a trademark and not the generic term for the product.” *Id.* at 1219.

In the instant case, the doctrine of de facto secondary meaning provides no impediment to current protection of the BEST BUY mark. As properly interpreted consistent with Supreme Court precedent, this doctrine recognizes the mutability of generic terms and permits a trademark owner to introduce temporally relevant evidence to show that the *primary* significance of the term, currently, in the minds of the consuming public is as a mark.

1. The de facto secondary meaning doctrine, as properly interpreted, permits a trademark owner to show that the primary significance of the term currently is a mark.

Beginning with Judge Learned Hand’s oft-cited proclamation in *Bayer Co. v. United Drug Co.*, 272 F. 505, 509 (S.D.N.Y. 1921), that the generic analysis is dependent on what “buyers understand by the word,” courts have repeatedly recognized the mutability of generic terms.

In the *Shredded Wheat* case, one of the earliest applications of the doctrine of de facto secondary meaning, Kellogg sought trademark protection for its alleged SHREDDED WHEAT brand. *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111 (1938). The Supreme Court held that because “Shredded Wheat” had been “the generic term of the article” since 1894, the term was unprotectable. *Id.* at 117. Kellogg argued, however, that beginning seven years later in 1901, the term “shredded wheat” had “acquired the ‘secondary meaning’ of shredded wheat” made at one specific Kellogg factory. *Id.* at 114, 118.

Although the Supreme Court ultimately rejected Kellogg’s contention, stating that “[t]here is no basis here for applying the doctrine of secondary meaning,” its decision was based on the fact that “the evidence shows only that . . . many people have come to associate . . . the

name by which the product is generally known, with the plaintiff's factory." *Id.* at 118. In other words, the evidence presented by Kellogg did not rise to the level of showing that the primary significance of the term "Shredded Wheat" in the minds of consumers was as a mark. This fact is highlighted by the Supreme Court's explanation that Kellogg could seek trademark protection for the mark SHREDDED WHEAT if the mark was *not* currently generic. *Id.* Specifically, the Supreme Court stated that in order for the mark to attain trademark status, Kellogg "must show more than a subordinate meaning which applies to ["shredded wheat"]. [Kellogg] must show that the *primary significance* of the term in the minds of the consuming public is not the product but the producer. This it has not done." *Id.* (emphasis added). Put another way, if Kellogg had shown that the term SHREDDED WHEAT had come to be associated with Kellogg's particular product, the term could be protectable.

Notwithstanding Kellogg's failure to make this showing in the *Shredded Wheat* case, the Supreme Court recognized that the trademark owner is entitled to show that its once-generic mark (even an inherently generic mark) has acquired secondary meaning and is therefore protectable. Many federal courts have followed this similar approach, as illustrated by the OPRY line of cases noted above. *See also In re Minnetonka, Inc.*, 212 U.S.P.Q. 772, 774-75 (T.T.A.B. 1981), overruled after district court appeal, 3 U.S.P.Q.2d, 1711, 1713 (T.T.A.B. 1987) (rejecting examining attorney's application of de facto secondary meaning doctrine in view of evidence of primary significance as a mark); *In re Recorded Books, Inc.*, 42 U.S.P.Q.2d 1275, 1997 TTAB LEXIS 6, *21 (T.T.A.B. 1997) ("[I]n making a genericness determination, the Board will consider all of the evidence touching on the public perception of [a] designation . . . including [] evidence of acquired distinctiveness.").

2. The interpretation of the doctrine of de facto secondary meaning found in the above cases is in line with key statutory premises of the Lanham Act.

The Lanham Act provides that in determining registrability, the USPTO must consider whether a mark is generic based on the *current* status of the mark. *See* 15 U.S.C. § 1052; *see also In re Thunderbird Prods. Corp.*, 406 F.2d 1389, 1392 (C.C.P.A. 1969) (validity of a mark must be determined on the basis of the facts that exist at the time the issue is under consideration). Likewise, the Act provides that a registered mark may later be invalidated if it “becomes the generic name” for the genus of products. 15 U.S.C. § 1064(3). Thus, “the Lanham Act contemplates that the current usage of a trademark will determine its status and mandates that a term which currently functions as a trademark is entitled to protection.” *See Levy*, 95 Trademark Rep. at 1210-11.

3. The more “stringent” interpretation of the de facto secondary meaning doctrine is unsound and at odds with fundamental principles of trademark law.

To hold that a mark found to be generic at one point in time can never function as a mark regardless of the trademark owner’s ability to show that consumer perception and usage of the mark has changed over time would do away with the notion of genericness as a question of fact and, instead, would treat genericness as a “near immutable characteristic of a mark,” a position “divorced from actual consumer usage.” *See Levy*, 95 Trademark Rep. at 1198, 1204; *see also 2 McCarthy* at § 12:47 (4th ed. 2006) (emphasis added) (“[I]f trademark law permits descriptive terms to function as trademarks once they have acquired distinctiveness, “[w]hy should not the same thinking be applied to generic names that might over time become subordinate and minor and replaced in public parlance by trademark significance? *It is a bold thing for a court to explicitly ignore customer perception.*”).

Likewise, Mr. Levy asserts the following with regard to this more stringent interpretation of the doctrine:

Once a mark has acquired sufficient secondary meaning such that its primary significance is to identify a producer, that mark is no longer generic. It has become a mark. There is no principled justification for denying trademark protection to a mark, the primary significance of which is to identify a particular producer, simply because that mark may have been generic sometime in the distant past. When evidence of secondary meaning reaches the level of primary significance, a trademark should be protectible, regardless of its history. Genericness cannot be an immutable quality because actual language use, on which a determination of genericness should be based, is not immutable.

Levy, 95 Trademark Rep. at 1198.

F. Even if considered once generic, the BEST BUY mark may be protected under the *Singer* doctrine.

Even if the BEST BUY mark were properly classified as a generic term in the Best Buy Warehouse Decisions seventeen years ago, the mark was not generic at its inception, and the evidence submitted herewith unequivocally demonstrates that the mark is not generic today.

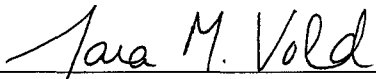
The ability of a trademark owner to recapture a term that has become generic is explicitly recognized in *Singer Mfg. Co. v. Briley*, 207 F.2d 519, 522, 99 U.S.P.Q. 303 (5th Cir. 1953). Singer began making sewing machines in the mid-nineteenth century. By 1896, however, the name SINGER had become a generic designation for a distinctive style of sewing machine. As a result of Singer's continuous and exclusive use and advertising of the SINGER mark, by 1953, the Fifth Circuit held that the mark had been "recaptured" from the public domain.

Similarly, in the present case, Applicant first began using the mark in late 1983. Prior to that time, the predominant treatment of the mark by the PTO was as a *descriptive* rather than a generic term. This is supported by the many third party registrations of the term BEST BUY (for miscellaneous products/services) existing prior to the issuance of the Best Buy Warehouse Decisions. See registrations cited in Section I.B. above; see also U.S. Reg. Nos. 1,164,135;

729,887; 557,818. As in *Singer*, the BEST BUY mark was subsequently found to be generic, in this case by the Missouri district court and (affirmed by the Eighth Circuit). Today, the evidence of Applicant's continuous and largely exclusive use of the BEST BUY mark for retail services featuring consumer electronics and, moreover, the current consumer perception of the BEST BUY mark, unequivocally demonstrate that the mark does not have, today, a generic meaning for Applicant's goods and services. Thus, in accordance with *Singer*, the mark is now registrable.

III. CONCLUSION

For the reasons stated above, Applicant respectfully requests that the instant Application be approved for registration on the Principal Register under Section 2(f) of the Trademark Act.

Date: <u>9/6/2007</u>	Respectfully submitted,  Tara Vold, Esq. Fulbright & Jaworski L.L.P 801 Pennsylvania Ave, N.W. Washington, DC 20004-2623 Ph. (202) 662-0200 Fax. (202) 662-4643 ATTORNEYS FOR APPLICANT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK EXAMINING OPERATION

In re Application of: §
Best Buy Enterprise Services, Inc. §
Serial No.: _____ § Trademark Law Office _____
Filed: _____ §
Mark: BEST BUY §

DECLARATION OF THOMAS D. DUPONT

I, Thomas D. Dupont, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declare that:

1. I am the President of D² Research, a research and consulting firm located in Kinnelon, New Jersey.
2. I have extensive education, training and experience in the area of survey research and analysis and interpretation of survey data. Since 1970, I have personally directed numerous survey research projects, including market research in a variety of industries. Attached hereto as Exhibit A is a curriculum vitae which summarizes my education and experience.
3. Last year, Fulbright & Jaworski L.L.P engaged D² Research to conduct a survey under my direction to determine whether consumers perceive BEST BUY as a brand name or as a generic (common) name. The survey design employed the well-known and commonly accepted *Teflon* methodology. A report on the results of that survey are attached hereto as Exhibit B. I am the author of that report and all statements contained therein are accurate.
4. The survey was conducted in accordance with generally accepted standards among survey professionals. In particular, the survey was consistent with the principles discussed in the *Manual for Complex Litigation, Fourth* (Federal Judicial Center, 2004).
5. The target population was appropriately defined and representatively sampled.
6. Respondents were appropriately screened to ensure that only eligible individuals participated in the survey.
7. The survey was conducted by qualified interviewers following proper interview procedures. Interviewers were appropriately trained and monitored by full-time, professional quality assurance staff trained to evaluate interviewing technique.

8. The data were analyzed in accordance with accepted statistical principles.
9. 89% of the respondents identified BEST BUY as a brand name.
10. In my professional opinion as a survey researcher, based on the survey conducted by D² Research, BEST BUY is considered by consumers to be a brand name for a business that sells electronics and appliances.

I declare under penalty of perjury that the foregoing is true and correct.



Thomas D. Dupont, Ph.D.

7/19/07

Date

Exhibit A
Curriculum Vitae

Exhibit B
Survey Report

PET SURVEY- RESPONDENT RECORD

**STAPLE THIS PAGE ON
TOP OF THE SCREENER**

For Office Use Only

ID#

**INTERVIEWER: STATE THE FOLLOWING WHEN YOU ASK FOR THE RESPONDENT'S
NAME AND PHONE NUMBER:**

I need your name and phone number so this interview can be verified. No one will ever call you as a result of this interview and try to sell something, but someone may call you just to verify that the interview was conducted. Therefore it is important that I get your name and phone number correctly.

PLEASE PRINT CLEARLY

NAME _____

PHONE NUMBER (_____) _____

(If respondent gives phone number in another part of the country, determine when respondent will be available at that number.)

INTERVIEWER'S NAME _____

DATE OF INTERVIEW _____

TIME STARTED _____ **TIME ENDED** _____

INTERVIEWER: YOU MUST SIGN BELOW OR THE INTERVIEW WILL NOT BE VALID!

I personally interviewed the respondent whose name appears on this questionnaire. I was not acquainted with the respondent prior to the interview. I asked the questions exactly as written and recorded the answers exactly as given.

(INTERVIEWER'S SIGNATURE)

(DATE)

EXHIBIT A

CURRICULUM VITAE OF THOMAS D. DUPONT, Ph.D.

Professional Experience

1993 - Present President, D² Research, Kinnelon, N. J.
1989 - 1993 President, Oxtoby-Smith Inc., New York, N.Y.
1970 - 1989 Oxtoby-Smith Inc., New York, N.Y. (Various titles)
1968 - 1970 Instructor/Assistant Professor of Psychology, Indiana University-Purdue University
at Indianapolis

Publications And Addresses - Past Ten Years

2001 "Use of Surveys and Survey Experts in Trademark Litigation," Practical Tips on Trademark Litigation, American Bar Association, Section of Intellectual Property Law, April, 2001

1998 "The Value of the Survey Expert in Lanham Act Deceptive Advertising Challenges," Advanced Consumer Protection -- Mastering The Challenge, American Bar Association, Section of Antitrust Law, February, 1998

1996 "Analysis of Consumer Perception Surveys, " Transcript Proceedings: NAD Workshop VI: Consumer Perception Communication Surveys, National Advertising Division, Council of Better Business Bureaus, June 1996

1996 "How Researchers Can Be Effective Partners in the Advertising Development Process," Quirk's Marketing Research Review, March 1996

THOMAS D. DUPONT, Ph.D.

Curriculum Vitae (continued/2)

Professional Associations

Council of American Survey Research Organizations
International Trademark Association
Market Research Council

Professional Activities

Advertising Research Foundation:

Copy Research Council (1980 - 1991)
Research Quality Council (1991 - 1993)
Chairman -- Research Quality Workshop (1991)
Technical Advisory Committee (1992 - 1993)
Instructor -- "SMART" Seminar (1993)

Council of American Survey Research Organizations:

Chairman of the Board (1993)
Board Of Directors (1991-1995)
Chairman: Survey Research Quality Committee (1990-1991)

Education

Ph.D., Consumer Psychology, Purdue University (1970)
M.S., Industrial Psychology, Purdue University (1968)
B.A., Psychology, Lake Forest College (1965)

THOMAS D. DUPONT, Ph.D.
Curriculum Vitae (continued/3)

Expert Witness Testimony - Past Four Years

- 2007 GMA Accessories v. Croscill, et. al., S.D.NY (Deposition)
Lucas Oil Products v. OAO Lukoil, et. al., S.D.N.Y. (Deposition)
- 2006 Hasbro v. MGA Entertainment, D. RI (P.I. Hearing)
Juicy Couture, et. al v. L'Oreal USA. et. al, S.D. NY (Deposition & Trial)
Bay State Savings Bank v. Baystate Financial Services, D. MA (Deposition)
Ty, Inc. v. Softbelly's, Inc., N.D.IL (Trial)
- 2005 TAP Pharmaceuticals v. AstraZeneca, D. DE (Deposition)
Nissan North America v. Audi A.G., E.D.MI (Deposition)
Peaceable Planet, Inc. v. Ty, Inc., N.D. IL (Trial)
Sara Lee Corporation v. Amine Mahmoud, TTAB (Deposition)
Ty, Inc. v. Softbelly's, Inc., N.D.IL (Deposition)
- 2004 BellSouth v. Hawk Communications, N.D.GA (P.I. Hearing)
In Re Gator Corporation Trademark and Copyright Litigation, N.D.GA (Deposition)
3M Company v. Intertape Polymer Group, et. al., D. MN (Deposition)
- 2003 Pharmacia Corp. v. GlaxoSmithKline Consumer Healthcare, D. NJ (P.I. Hearing)
McNeil – PPC, Inc. v. Bayer Corporation, D. NJ (Deposition)
Playtex v. Georgia-Pacific, S.D.N.Y. (Deposition)
Healthnet v. Health Net, S.D.WV (Deposition)