**To:** Lisa Howard, Managing Partner

**From:** Jamila Stokes

**Date:** 4/21/2012

**RE:** Christine Donnelly, Sweet Lorraine’s Bakery, LLC- Trademark Issue

**Statement of Facts:** Christine Donnelly, our client has been accused for tradename infringement on the name Sweet Lorraine’s and has been threatened with court litigation if she does not change the name of her business as well as for her to stop using the phrase “Sweet Lorraine’s”. She is currently the owner of “Sweet Lorraine’s Bakery, LLC in Charlotte, North Carolina. Mr. Sawyer and his wife, Detroit Michigan Residents and owners and operators of Sweet Lorraine’s LLC d/b/a Sweet Lorraine’s Café and Bar has a trademark on the phrase “Sweet Lorraine’s” for all restaurants and baking services in the United States. Therefore, the legal issue here is whether of not Ms. Connelly did infringe on the Tradename/Mark Sweet Lorraine’s knowingly. How does her business differ from that of Mr. Sawyer and Wife; such as reaching a decision as to whether the similarity of the name/mark and the commercial relationship between the goods and service are identified by the marks. Basically, are they confusingly similar.

**Question Presented #1**

Were you, Ms. Donnelly, notified by the Department of Licensing and Regulatory Affairs that the name ‘Sweet Lorraine’s was legal trademarked within the United States or in the state of Detroit Michigan?

**Question Present #2**

Do you have your letter from this bureau authorizing the use for this name “Sweets Lorraine’s”?

**Question Present #3**

Was the name “Sweet Lorraine’s” searched for use just within the state of North Carolina? or did you have it researched nationwide as well for usage?

**Question Presented #4**

Is there a logo associated with the name “Sweet Lorraine’s” that identifies with that of Mr. Sawyers “Sweet Lorraine’s”?

**Question Presented #5**

Are the goods and services you provide confusingly similar to that of Mr. Sawyer business?

**Short Answers #1**

No

**Short Answer #2**

Yes

**Short Answer #3**

Yes, to both

**Short Answer #4**

No

**Short Answer#5**

No

**Discussion/ Analysis**

The Lanham Act states: No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—**(a)** Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in [section 3501(9) of title 19](https://www.law.cornell.edu/uscode/text/19/3501#9)) enters into force with respect to the United States. **(d)** Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

For the issues in this case these following case identifies with our present case and could be used to show why the Ms. Donnelly’s use of “Sweet Lorraine’s is legal and would not be seen as infringement based on the Lanham Act of 1946 <https://www.law.cornell.edu/uscode/text/15/1052>

“*Park 'n Fly v. Dollar Park & Fly, 469 U.S. 189, 105 S. Ct. 658, 83 L. Ed. 2d 582, 1985 U.S. LEXIS 33, 53 U.S.L.W. 4044, 224 U.S.P.Q. (BNA) 327*

 **(Issue)** Petitioner argued that because its registered service mark "Park 'N Fly" had attained incontestable status, respondent infringed the mark by using the words "Park and Fly." Specifically, petitioner asserted that the appeals court erred in allowing respondent to successfully challenge the mark on the ground that it was merely descriptive.

**(Rule)** The Supreme Court agreed, holding that incontestability not only barred cancellation of petitioner's mark, but allowed petitioner to utilize that status to enjoin respondent's use of its mark. Nothing in the language of the Lanham Act of 1946 (Lanham), [15 U.S.C.S. § 1051 et seq.](https://advance.lexis.com/document/?pdmfid=1000516&crid=77fde463-bad5-408f-a1f6-ed0fd3610e76&pddocfullpath=%2Fshared%2Fdocument%2Fcases%2Furn%3AcontentItem%3A3S4X-CN50-0039-N2GF-00000-00&pdcontentcomponentid=6443&pdshepid=urn%3AcontentItem%3A7XW4-BVC1-2NSF-C2SC-00000-00&pdteaserkey=sr0&pditab=allpods&pdworkfolderlocatorid=NOT_SAVED_IN_WORKFOLDER&ecomp=ppnqk&earg=sr0&prid=ca91cab7-f82c-4940-baec-ea8257238425), supported the offensive/defensive distinction adopted by the appeals court in upholding respondent's challenge**.**

 **(Analysis)** Nothing in Lanham, or in its legislative history, allowed an incontestable mark to be challenged as merely descriptive and nothing supported a departure from Lanham’s clear language on incontestability that the trademark registrations were issued without inquiry into the application's merits was no basis for supporting respondent's position as challenges were permitted following publication of the registration**. (Conclusion)** The judgment holding that respondent's use of "Dollar Park and Fly" did not infringe petitioner's incontestable mark "Park 'N Fly" was reversed because the infringement of an incontestable mark could not be defended on the ground that the mark was purely descriptive, as neither the Lanham Act, nor legislative history supported this defense.

Based on the above case Ms. Donnelly who has the same trademark name “Sweet Lorraine’s and has been using it for six months. The trade name was never contested when by the Sawyers therefore the “Sweet Lorraine’s” were cleared for usage. Ms. Donnelly acquired to name for her business legally and went through the proper channels. If the Sawyers use of the Trademark name ‘Sweet Lorraine’s was used for less than five years then the suit for the name can be challenged if a declaration of incontestability has not been filed if the name has been used by the Sawyers for at least five years. Therefore, I would not recommend that Ms. Donnelly change the name of her business; she should challenge the suit and I feel she would have a chance of winning the suit.

Another case to consider for this client would be a Federal district court case: *Foxtrap, Inc. v. Foxtrap, Inc., 671 F.2d 636, 1982 U.S. App. LEXIS 21463, 215 U.S.P.Q. (BNA) 1105, 217 U.S. App. D.C. 130*.

**(Issue)** “Plaintiff, a private club in the District of Columbia, had members residing in several adjoining states, including Pennsylvania. Defendant was a public disco and bar in Philadelphia that operated under the same name. Plaintiff brought this action, claiming trademark infringement and unfair competition.

 **(Rule)** The district court permanently enjoined defendant from using defendant's tradename, and it issued a monetary award to plaintiff. Defendant appealed the injunction, contending that the parties did not offer competitive services and that plaintiff's trademark rights did not extend to Philadelphia. The court affirmed the injunction. **(Analysis)** The marks were identical, and customers actually had confused the parties' relationship. Defendant's limited area defense failed because defendant had knowledge of plaintiff's prior use. The injunction was not too broad because no descriptive legend would suffice to distinguish the clubs in the minds of potential customers.

 **(Conclusion)** The court vacated the monetary award and remanded the case for findings of fact to support an award. There were multiple legal theories of monetary remedies available, and each depended on a different factual underpinning for validity.

This case focuses on the similarity of the names and the confusion that surround the usage of the name between both businesses. The ruling was in the ruled in the petitioners’ favor because he clearly violated the and did infringe on the trade name Fox Trap Inc. Unlike the client in this case Ms. Donnelley provide a similar type of service but she specializes in Italian baked goods which is the main focus of this business. The Sawyers’ business specializes in American fare cuisines, baked goods, and apparel as well franchise Mac and Cheese.

Although this case does not support our argument, it relates to the facts of our case has similar traits but different outcomes This case covers the fact of our case and Domicile of business within two different jurisdictions.

If Ms. Donnelly is found guilty of infringement the remedies that Mr. Sawyer can sort could be anything from lost profits, damages, and at attorney fees. Worst case scenario the courts may order a name change or order a stop use, but I don’t see that happening. Because there are no violations or fraudulent behavior on Ms. Donnelly’s behalf. Infringement was never brought to the forefront until a franchise opportunity became available for the Sawyers in North Carolina and if Ms. Donnelly’s keeps her business name “Sweet Lorraine’s Bakery” the Sawyers may be the one infringing if Ms. Donnelley business is affected by the Sawyers new franchise.

**Conclusion**

The suit against me Donnelly seems to be weak. The fact that she is being accused of infringement because the Sawyers wants to open a franchise business in the North Carolinas does not make Ms. Donnelly liable of infringement. The name was legally acquired and there are no similarities between the service and goods. Also Ms. Donnelly did not act maliciously when she acquired the name as to cause harm to the Sawyers business. The above case I believe are strong resources to support our argument.

Jamila Stokes