Client Letter

Jamila Stokes

PLEG135 Wk-7

**To:** Ms. Christine Donnelly, Client

Owner of Sweet Lorraine’s Bakery, LLC

**From:** Jamila Stokes

**Date:** 4/26/2020

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

Dear Ms. Donnelly**,**

Here is a review of all factors of this case and exactly how I believe we should proceed and a projected result:

**The Statement of Facts of this case is:** You**,** Christine Donnelly, has been accused of tradename infringement on the name Sweet Lorraine’s and have been threatened with court litigation if you do not change the name of your business as well as, to stop using the phrase “Sweet Lorraine’s” for business purposes. You are currently the owner of “Sweet Lorraine’s Bakery, LLC in Charlotte, North Carolina and have been in business if six months. Mr. Sawyer and his wife, Detroit Michigan Residents, 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. They contacted you around the time they were offered an opportunity to franchise their business in North Carolina and now realize that your business already carries the name Sweet Lorraine’s which could cause confusion if they were to open a franchise with the same name within North Carolina. The legal issue here is whether or not you did infringe on the Tradename/Mark Sweet Lorraine’s knowingly, with intent to cause confusion, and whether your services and business logo it similar to that of Mr. Sawyers and his wives. We will start with your legal rights to the name “Sweet Lorraine’s” and how it was acquired the type of business whether commerce or local, as well as, logos, services and trademarks used to advertise your business. Does her business differ from that of Mr. Sawyer and his 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 that will be asked are:

**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?

Based on the answers to these questions we would have a better idea of how to move forward; but I feel we have a great chance of winning this case.

Cases that would be used to support our argument are the following case, the information from each case the Lanham Act and rulings made based on cases similar to yours. The Lanham Act infringement law protects your choice to use this name as well as how this choice causes no harm to Mr. Sawyers business or tradename within the Detroit area. Since he has interest of franchise his business in North Carolina this could be harmful to your establishment rather than his. Therefore, we would have to see where this case takes us and what the end results would be.

**Discussion/Analysis**

“*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*

Based on the above case Ms. Donnelly, your business name “Sweet Lorraine’s and has been in use for six months. The trade name was never contested when by the Sawyers therefore the “Sweet Lorraine’s” were cleared for usage my Licensing and Consumer and it was acquired legally; by going 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. The three elements of infringement that the Sawyers would have to prove in order to successfully win this case are 1). That he owns the registered trademark/name (which he does) 2). That you used the mark in commerce; and 3). That you intended to cause confusion when you chose to use the name Sweet Lorraine’s for your Bakery. Based on my research and careful review of this case these three elements have not been met and the accusation against Ms. Donnelly is weak. Your use of the name Sweet Lorraine’s is clearly descriptive and bears no markings related or associated to that of Mr. Sayers business. Therefore, I would not recommend that you change the name of your business; you should stand strong and challenge the suit.

Another case that we would be considering to use in your defense is this case from a Federal district court case that was heard in the U.S District Court for the District of Columbia: *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*.

This case focuses on the similarity of the names and the confusion that surround the usage of the names between both businesses. The circuit court ruling was in the petitioners’ favor because he clearly violated the and did infringe on the trade name Fox Trap Inc. all elements of infringement according to the Lanham Act was met. It was clear that they use the same trademark style and services were similar which was clearly confusing to consumers.

Your case provides a similar type of service, but you specialize in Italian baked goods which is the main focus of your business. You are working towards a web-based service that would cater to her clients within the state of North Carolina and not globally which has not been established as yet. The Sawyers’ business specializes in American fare cuisines, baked goods, and apparel as well, franchise opportunities which includes a Mac and Cheese chain.

There are also a few U.S Court of Appeals Sixth Circuit Court case we researched see the results of what can happen if you were to lose this case which I strongly believe is not a possibility

[PGP, LLC v. TPII, LLC, 734 Fed. Appx. 330, 2018 U.S. App. LEXIS 14315, 2018 WL 2446702](https://advance.lexis.com/api/document/collection/cases/id/5SFM-MNW1-FD4T-B2XF-00000-00?cite=734%20Fed.%20Appx.%20330&context=1000516)

This case is a little more complicated, but it helps the case as far as how the infringement and abandonment of a trademark/name would not be grounds for infringement. This case gives us another angle to look at if the trademark name was abandoned and not renewed then Ms. Donnelly has legal rights to the name.

[Grubbs v. Sheakley Group, Inc., 807 F.3d 785, 2015 U.S. App. LEXIS 21146, 2015 FED App. 0286P (6th Cir.), 117 U.S.P.Q.2D (BNA) 1209, 2015-2 Trade Cas. (CCH) P79,380](https://advance.lexis.com/api/document/collection/cases/id/5HJF-6821-F04K-P03H-00000-00?cite=807%20F.3d%20785&context=1000516)

If for any reason you are found to have infringed on the name “Sweet Lorraine’s” the remedies that Mr. Sawyer can sort described under the Lanham Act, [15 U.S.C.S. § 1117 (Act)](https://advance.lexis.com/document/?pdmfid=1000516&pddocfullpath=%2Fshared%2Fdocument%2Fcases%2Furn%3AcontentItem%3A3S4X-3TJ0-003B-G18G-00000-00&pddocid=urn%3AcontentItem%3A3S4X-3TJ0-003B-G18G-00000-00&pdcontentcomponentid=6397&crid=98b3b722-5ff9-453a-85df-c96827e5517e) are 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 I found on your behalf, I don’t think you should have to worry about having to meet these remedies, but it is important you know what can lye on the other side of the fence. However, the Lanham Act specifically forbids the award of a penalty. These case covers the fact of our case and Domicile of business within two different jurisdictions. It also points out that the element of confusion and commerce does not relate to your case if brought to litigation.

Infringement was never brought to the forefront until a franchise opportunity became available for the Sawyers in North Carolina, my recommendation for you to keep her business name “Sweet Lorraine’s Bakery” can affect the Sawyers who may be the one infringing on your business once they open their Mac & Cheese franchise in North Carolina which can affect your business.

**Conclusion**

The suit against you seems weak. The fact that you are being accused of infringement because the Sawyers want to open a franchise business in the North Carolinas does not make you liable of infringement. The name was legally acquired and there are no similarities between the service and goods between both businesses. Also, you did not act maliciously when you acquired the name as to cause harm to the Sawyers business. The above cases I believe are strong resources to support our argument. The Lanham Act defines a trademark/name to mean “any word, name, symbol, or device or any combination thereof” used by any person “to identify and distinguish his goods . . . from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”  The Lanham Act permits the holder of a registered trademark to file a trademark infringement claim against any person who, without the registered trademark holder’s consent, (1) uses any reproduction, counterfeit, or copy of a registered mark; (2) in commerce; (3) in connection with the sale, offering for sale, distribution, or advertising of any goods or services; (4) where such use is likely to cause confusion, or to cause mistake, or to deceive.

Sincerely,

Jamila Stokes

References

*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*

[*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*](https://advance.lexis.com/api/document/collection/cases/id/3S4X-3TJ0-003B-G18G-00000-00?cite=671%20F.2d%20636&context=1000516)

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*Hensley Mfg. v. ProPride, Inc., 579 F.3d 603, 2009 U.S. App. LEXIS 19797, 2009 FED App. 0324P (6th Cir.), 92 U.S.P.Q.2D*

[*https://www.michiganitlaw.com/Trademark-Infringement-Basics-Apple-Amazon*](https://www.michiganitlaw.com/Trademark-Infringement-Basics-Apple-Amazon)