

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

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PFIZER INC., :
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 Plaintiff, : 08 Civ. 8065 (WHP)
 :
 -against- : MEMORANDUM AND ORDER
 :
 ARYE SACHS and JETANGEL.COM, :
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 Defendants. :

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WILLIAM H. PAULEY III, District Judge:

Plaintiff Pfizer Inc. (“Pfizer”) brings this trademark infringement action against Defendants Arye Sachs (“Sachs”) and Jetangel.com for violations of the Lanham Act, 15 U.S.C. §§ 1114 et. seq., common law trademark infringement, and violations of New York General Business Law. Pfizer moves for a preliminary injunction on its Lanham Act claims. For the following reasons, Pfizer’s motion is granted.

BACKGROUND

Pfizer, a global pharmaceutical company, manufactures and sells Viagra, a prescription pharmaceutical used for the treatment of erectile dysfunction. (Declaration of Ruth Dovidavany dated Sept. 17, 2008 (“Dovidavany Decl.”) ¶ 4.) Pfizer uses two trademarks in connection with Viagra: (1) the Viagra mark, which has been registered as U.S. Registration No. 2,162,548 for a “compound treating erectile dysfunction”; and (2) the “Viva Viagra” mark, which is the subject of a pending federal trademark application for use in connection with marketing

and medical information services (collectively “the Viagra Marks”). (Declaration of Tiffany Trunko dated Sept. 17, 2008 (“Trunko Decl.”) ¶¶ 3, 4.) The Viva Viagra mark is depicted in blue text, with the word “Viagra” in block type preceded by the word “Viva” written at an angle in cursive type. (Dovdavy Decl. ¶ 14, Ex. D: Viagra Website Depicting the Viva Viagra Mark.) Pfizer has spent millions of dollars promoting Viagra, including a marketing campaign featuring the Viva Viagra slogan, and has achieved worldwide sales of nearly sixteen billion dollars. (Dovdavy Decl. ¶¶ 7-8, 12.)

Sachs is the proprietor of an unincorporated business that maintains a website— JetAngel.com. Through that website, Sachs sells outdoor mobile advertising on decommissioned military equipment such as fighter jets and missiles. (Complaint dated Sept. 17, 2008 ¶ 18.) According to its website, JetAngel “mobilize[s] squadrons of authentic fighter jet cockpits throughout major U.S. cities, towns and highways creating the right buzz for your company.” (Dovdavy Decl. ¶ 20, Ex. E: Excerpts of Defendants’ Website JetAngel.com.) Sachs identifies himself as JetAngel’s “Chief Fun Officer.” (Trunko Decl. Ex. F: E-mail from Arye Sachs to Paul C. Llewellyn dated Sept. 14, 2008.)

On September 8, 2008, Sachs appeared outside Pfizer’s world headquarters in midtown Manhattan with a pickup truck and trailer towing a decommissioned United States Air Force missile featuring the Viva Viagra mark. (Dovdavy Decl. ¶¶ 23, 24.) The pickup truck bore a large yellow JetAngel.com banner. (Dovdavy Decl. ¶ 24.) The JetAngel.com website also features images of a Viagra-branded missile at various locations throughout New York City. (Dovdavy Decl. ¶ 27.)

On September 9 and 11, 2008, Pfizer’s counsel sent letters demanding that

Defendants cease use of the Viagra Marks. (Trunko Decl. Ex. C, D: E-mails from Paul C. Llewellyn to Arye Sachs.) On September 14, 2008, Sachs responded to Pfizer's counsel by e-mail, announcing Defendants' intent to launch a "Voter Awareness Program" throughout major U.S. cities, featuring the Viagra Marks on their fighter jet cockpits and condoms with the images of presidential candidates Barack Obama and John McCain in an effort to encourage people to vote. (Trunko Decl. Ex. F: E-mail from Arye Sachs to Paul C. Llewellyn dated Sept. 14, 2008.) The e-mail also included a link to photographs of the Viagra-branded missile at an adult entertainment exposition. (Trunko Decl. ¶ 9.)

On September 17, 2008, Defendants issued a press release, promoting the "Voter Awareness Campaign" as well as providing information marketing JetAngel.com's advertising services. (Trunko Decl. Ex. I: Jet Angel.com Launches Voter Awareness Campaign with Candidates' Names on Viagra Missiles.) The following day Pfizer filed this civil action, and obtained a temporary restraining order. Pfizer now seeks a preliminary injunction prohibiting Defendants from utilizing the Viagra Marks in connection with their advertising business.

DISCUSSION

I. Legal Standard

To obtain a preliminary injunction the moving party must demonstrate (1) irreparable harm without the injunction, and (2) either (a) a likelihood of success on the merits or (b) sufficiently serious questions going to the merits of the case and that the balance of hardships tips in its favor. D.D. ex rel. V.D. v. New York City Bd. of Educ., 465 F.3d 503, 510 (2d Cir. 2006). In the trademark infringement context, a showing of success on the merits generally

establishes a risk of irreparable harm. See Hasbro, Inc. v. Lanard Toys, Ltd., 858 F.2d 70, 78 (2d Cir. 1988).

Defendants appear in this action pro se. “[C]ourts are . . . to construe a pro se litigant’s pleadings and motions liberally, and to allow amendments to a pro se litigant’s pleadings more freely.” In re Sims, 534 F.3d 117, 133 (2d Cir. 2008) (internal citations omitted). Accordingly, the Court has granted Defendants “extra leeway in meeting the procedural rules governing litigation.” In re Sims, 534 F.3d at 133. For example, the Court accepted amendments to Defendants’ opposition papers following Plaintiff’s reply.

II. Trademark Infringement

To obtain injunctive relief under either §§ 32 or 43(a) of the Lanham Act, plaintiff must establish ownership of a valid trademark and that “defendant’s use of the trademark creates a likelihood of confusion as to the source of the goods.” Gucci Am. Inc. v. Action Activewear, Inc., 759 F. Supp. 1060, 1063 (S.D.N.Y. 1991) (citing Lois Sportswear U.S.A., Inc. v. Levi Strauss & Co., 799 F.2d 867, 871 (2d Cir. 1986)); 1-800 Contacts, Inc. v. WhenU.Com, Inc., 414 F.3d 400, 406-07 (2d Cir. 2005) (applying the same test to claims under Section 32 and 43(a)).

A. Protection of the Marks

To be entitled to protection, a mark must be “sufficiently distinctive” either because it is “inherently distinctive”—i.e., its intrinsic nature serves to identify its particular source—or because it has acquired a “secondary meaning” in the minds of consumers. Star Indus. v. Bacardi & Co. Ltd., 412 F.3d 373, 381 (2d Cir. 2005).

In determining whether a mark is “inherently distinctive”, courts consider what

type of trademark is at issue—generic, descriptive, suggestive, or arbitrary and fanciful. Lois Sportswear, 799 F.2d at 871. Generic marks are never protectable, while suggestive and arbitrary or fanciful marks are inherently distinctive and therefore, protectable. Paddington Corp. v. Attiki Imps. & Distribs., Inc., 996 F.2d 577, 583 (2d Cir. 1993). The term “arbitrary” refers to the use of a common word in an unfamiliar way. Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 11 n.12 (2d Cir. 1976). “[W]hen a plaintiff sues for infringement of its registered mark, the defendant bears the burden to rebut the presumption of [the] mark’s protectability by a preponderance of the evidence.” Lane Capital Mgmt., Inc., 192 F.3d at 345.

Because Defendants have offered no evidence to rebut the presumption of the Viagra mark’s protectability, as a registered mark it is entitled to protection. As for the Viva Viagra mark, “viva” is a common, albeit Spanish, word used in an unfamiliar way to refer to Viagra. Therefore, the Viva Viagra mark is an arbitrary mark entitled to protection.

B. Likelihood of Confusion

In assessing likelihood of confusion, this Court considers the following eight factors: (1) strength of the senior user’s mark; (2) degree of similarity between the marks; (3) competitive proximity of the product; (4) likelihood that the senior user will bridge the gap; (5) evidence of actual confusion; (6) defendant’s bad faith; (7) the quality of defendant’s product; and (8) sophistication of the relevant group. Polaroid Corp. v. Polarad Elec. Corp., 287 F.2d 492, 495 (2d Cir. 1961). These factors do not create a “rigid formula” and no one factor is determinative. Lois Sportswear, 799 F.2d at 872.

1. Strength of the Mark

A mark's strength can be shown by its inherent distinctiveness, by proof that the mark has secondary meaning, or both. Paddington, 966 F.2d at 585. Advertising expenditures can support a finding of strength, but alone are insufficient. See Lexington Mgmt. Corp. v. Lexington Capital Partners, 10 F. Supp. 2d 271, 280 (S.D.N.Y. 1998). The commercial success of a product reinforces the strength of the mark. See Charles of the Ritz Group Ltd. v. Quality King Distributors, Inc., 832 F.2d 1317, 1321 (2d Cir. 1987).

Because the Viagra Marks are inherently distinctive marks, they are entitled to the utmost protection. Pfizer has spent millions of dollars advertising its Viagra product, which includes a campaign featuring the Viva Viagra slogan. Additionally, Pfizer has achieved worldwide sales of nearly sixteen billion dollars from its Viagra product. Accordingly this factor weighs in favor of finding a likelihood of confusion.

2. Degree of Similarity of Marks

“To apply [the degree of similarity factor], courts must analyze the marks' overall impression on a consumer, considering the context in which the marks are displayed and the totality of factors that could cause confusion among prospective purchasers.” Malletier v. Burlington Coat Factory Warehouse Corp., 426 F.3d 532, 537 (2d Cir. 2005).

The marks that Defendants displayed are virtually identical to the Viagra Marks. They include the same cursive and block type and are the same color. Additionally, Defendants displayed the marks directly outside Pfizer's worldwide headquarters. Accordingly, this factor weighs in favor of finding a likelihood of confusion.

3. Competitive Proximity and Likelihood of Bridging the Gap

This factor addresses “whether due to the commercial proximity of the competitive products, consumers may be confused as to their source.” Clinique Labs. Inc. v. Dep Corp., 945 F. Supp. 547, 553 (S.D.N.Y. 1996). The “concern with product proximity relates to the likelihood that customers may be confused as to the source of the products, rather than as to the products themselves.” Arrow Fastener Co., Inc. v. Stanley Works, 59 F.3d 384, 396 (2d Cir. 1995).

Although there are clearly differences between Pfizer’s Viagra product and Defendants’ services, consumers are likely to be confused as to the relationship between Plaintiff and Defendants’ advertising. See MGM-Pathe Commc’ns Co. v. Pink Panther Patrol, 774 F. Supp. 869, 875 (S.D.N.Y. 1991) (holding that members of the public could easily draw the inference that plaintiff was sponsoring defendants’ cause). Accordingly, this factor weighs in favor of finding a likelihood of confusion.

4. Actual Confusion

While the absence of proof of actual confusion favors defendants, Streetwise Maps, Inc. v. Vandam Inc., 159 F.3d 739, 745 (2d Cir. 1998), it is “not fatal to a finding of likelihood [of confusion], particularly where . . . the junior mark has been in the marketplace for a relatively short period of time,” Pink Panther Patrol, 774 F. Supp. at 875 (citing Centaur Commc’ns, Ltd. v. A/S/M Commc’ns, Inc., 830 F.2d 1217, 1227 (2d Cir. 1987)).

Although Pfizer has not submitted evidence of actual confusion, Defendants’ Viagra-branded missiles only entered the marketplace within the past several weeks. Accordingly, this factor neither weighs in favor nor against a likelihood of confusion.

5. Bad Faith

This factor concerns “whether the defendant adopted its mark with the intention of capitalizing on plaintiff’s reputation and goodwill, and any confusion between his and the senior user’s product.” Lang v. Ret. Living Pub. Co., 949 F.2d 576, 583 (2d Cir. 1991). The defendant’s awareness of plaintiff’s mark may give rise to an inference of bad faith, which is bolstered if the defendant offers no credible explanation for its adoption of the mark. See New York State Soc’y of Certified Public Accountants v. Eric Louis Assoc., Inc., 79 F. Supp. 2d 331, 348 (S.D.N.Y. 1999).

Defendants have made no attempt to hide their awareness of Plaintiff’s mark, as Defendants’ visit to Pfizer’s world headquarters should make clear. In using Pfizer’s world headquarters as a platform to promote their advertising business, Defendants used the Viagra Marks as a means of self-promotion. Accordingly, this factor weighs in favor of finding a likelihood of confusion.

6. Quality of Defendants’ Product

“This factor is primarily concerned with whether the senior user’s reputation could be jeopardized by virtue of the fact that the junior user’s product is of inferior quality.” Arrow Festerer Co. v. Stanley Works, 59 F.3d 384, 398 (2d Cir. 1995). The concern is “not so much with the likelihood of confusion as with the likelihood of harm resulting from any such confusion.” Pink Panther Patrol, 774 F. Supp. at 876; see also Virgin Enterprises Ltd. v. Nawab, 335 F.3d 141, 152 (2d Cir. 2003) (“the quality of the secondary user’s product goes more to the harm that confusion can cause the plaintiff’s mark and reputation than to the likelihood of confusion.”).

Defendants' intent to feature the Viagra Marks on their fighter jet cockpits while distributing condoms with the images of presidential candidates Barack Obama and John McCain could harm Pfizer's reputation. Pfizer may not wish to be associated with presidential campaigns, and consumers may consider Defendants' "Voter Awareness Campaign" to be sponsored by Pfizer. Accordingly, this factor weighs in favor of Pfizer.

7. Sophistication of the Relevant Group

"The more sophisticated the purchaser, the less likely he or she will be confused by the presence of similar marks in the marketplace." Savin Corp. v. Savin Group, 391 F.3d 439, 461 (2d Cir. 2004). There is nothing that indicates that purchasers of the Viagra product are a particularly sophisticated group of consumers. Accordingly, this factor weighs in favor of finding a likelihood of confusion.

Weighing all of these factors, this Court finds that Defendants' use of the Viagra Marks creates a likelihood of confusion. Accordingly, Pfizer has satisfied the requirements for a preliminary injunction with regard to Defendants' use of both Viagra Marks.

III. The First Amendment Defense

The key to First Amendment protection under the Lanham Act is whether a defendant's use is likely to cause confusion. See United We Stand America, Inc. v. United We Stand, America New York, Inc., 128 F.3d 86, 92 (2d Cir. 1997) (defendants were not entitled to First Amendment protection where they were using a slogan as a mark to suggest plaintiffs were the source of defendants' identification). "The relevant issue is not the content of defendants' message, but rather defendants' use of plaintiffs' marks." SMJ Group, Inc. v. 417 Lafayette

Restaurant LLC, 439 F. Supp. 2d 281, 291 (S.D.N.Y. 2006); see also Pink Panther Patrol, 774 F. Supp. at 877 (holding that defendants were subject to the trademark laws despite being engaged in political speech).

Defendants use the Viagra Marks as a means to associate themselves with Pfizer. Defendants acknowledge that fact when they assert that the missile is “an erected [sic] penis” and that, “Placing the name Viagra on a missile can and will be associated with what it is intended to be: [sic] an erection-boosting recreational drug” (Transcript of Preliminary Injunction Hearing Oct. 7, 2008 at 15, Defendants’ Amendment Opposition to TRO and Order to Show Cause dated Oct. 2, 2008 at “Generic” tab.) Using the Viagra Marks in this way is to suggest that Pfizer is the source of Defendants’ activities. “This is precisely the use that is reserved by the Lanham Act to the owner of the mark.” United We Stand, 128 F.3d at 93. As such, Defendants are likely to cause significant consumer confusion in the marketplace and therefore the advertising is not protected by the First Amendment.

IV. Dilution and State Law Claims

Having granted Pfizer’s motion for preliminary injunction based on its trademark infringement claims, the Court declines to address Pfizer’s claims for dilution under Section 43(c) of the Lanham Act or its claims under New York state law.


CONCLUSION

For the foregoing reasons, Pfizer’s motion for a preliminary injunction, enjoining Defendants, and all who act in concert with them, from displaying the Viagra Marks in any

media, including the internet, and from advertising, promoting, or distributing any goods or services, in connection with the Viagra Marks, is granted. Plaintiff is directed to submit a proposed order consistent with this Memorandum and Order on notice to Defendants by October 14, 2008. The Court will hold a status conference with the parties on October 24, 2008, at 10:15 a.m.

Dated: October 8, 2008
New York, New York

SO ORDERED:


WILLIAM H. PAULEY III
U.S.D.J.

Counsel of record:

Paul C. Llewellyn, Esq.
Kaye Scholer, LLP
425 Park Avenue
New York, NY 10022
Counsel for Plaintiff

Mr. Arye Sachs
1202 4th Street
West Babylon, NY 11704
Defendants pro se