

■ **Patent Infringement: Transfer of Venue.**

Judge Frank denied a motion to transfer a patent case, holding that “the Court will not penalize the true plaintiff for filing its suit in its forum state to protect its interests in the event that good faith settlement negotiations . . . prove fruitless.” Travel Tags sued Performance Printing, a Texas company, in Minnesota but did not immediately serve them. Travel Tags waited to serve its complaint until the parties’ settlement negotiations deteriorated. On the same day Travel Tags served its complaint, Performance Printing filed and served a declaratory judgment action against Travel Tags in Texas. Performance Printing moved to transfer Travel Tag’s Minnesota action to Texas because even though Travel Tags was first to file, the three month delay between filing and service supported a “compelling circumstance” exception to the “first-filed” rule. The “first-filed” rule gives priority to the first jurisdiction in which a suit is filed and applies in the absence of “compelling circumstances.” Some factors courts consider in determining “compelling circumstances” are inequitable conduct, bad faith, anticipatory suits, and forum shopping. The court disagreed with Performance Printing finding that the three month delay of service is not an example of a “compelling circumstance.” *Travel Tags, Inc. v. Performance Printing, Corp.*, Civ. No. 06-2970 (D. Minn. July 19, 2007).

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■ **Contingent Trademark License: Unenforceable.**

Judge Schiltz held that a contingent trademark license is unenforceable as a matter of law if it is nothing more than an agreement to agree. Cabela’s sued Gander Mounting to enforce a Contingent Trademark License (CTL), which required a perpetual, exclusive trademark license from Gander Mountain to Cabela’s. The CTL required that the license be “evidenced by a separate written agreement in form and content customary to licenses of the type described above.” The parties disputed whether the proper form and content of the exclusive trademark license was similar to a 1996 trademark license between the parties or just a general exclusive trademark license. The Court ruled that the 1996 license was not contemplated by the CTL and that there was no evidence presented as to what terms a “general” exclusive trademark license would include. The Court dismissed Cabela’s claims stating “[I]t is inconceivable . . . sophisticated parties represented by sophisticated counsel – would have chosen this language to refer to the 1996 License” when they could have easily included a reference to the 1996 License in the CTL. *Gander Mountain Co. v. Cabela’s, Inc.*, No. 04-CV-3125 (D. Minn. July 10, 2007).

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■ **Trade Secret Misappropriation: Preliminary Injunction.**

Judge Davis granted a preliminary injunction and temporary restraining order against a former Wells Fargo employee who was corresponding with Wells Fargo clients while he was in the possession of client spreadsheets. Wells Fargo argued that a preliminary injunction and temporary restraining order was needed due to Bengston's (the former employee) misuse of confidential information after leaving Wells Fargo. While employed, Bengston had signed an employment agreement that included a non-solicitation provision and a provision prohibiting the misuse of confidential information. At the hearing, Wells Fargo presented evidence of letters between Bengston and Wells Fargo clients, revealing active solicitation. Bengston solicited his former clients as well as clients with whom he had no previous interaction. In addition, Bengston was in possession of "spreadsheets containing personal Wells Fargo client information, including client account number and account values." Judge Davis found that the evidence, the balance of harms, and the public interest supported granting both the preliminary injunction and temporary restraining order. *Wells Fargo Inv., LLC. v. Bengston*, No. 0:07-CV-3192 (D. Minn. July 9, 2007).