

FOCUS - 1 of 1 DOCUMENT

Saint Mary's Press of Minnesota, Plaintiff, v. DeVore & Sons, Inc., a Kansas corporation, d/b/a Fireside Catholic Publishing and Fireside Bible Publishers, Defendant.

File No. 04-1561 (DWF/SRN)

UNITED STATES DISTRICT COURT FOR THE DISTRICT OF MINNESOTA

2004 U.S. Dist. LEXIS 12255

June 29, 2004, Decided

DISPOSITION: [*1] Plaintiff's Motion for Temporary Restraining Order denied.

CASE SUMMARY:

PROCEDURAL POSTURE: Plaintiff religious publisher sought a temporary restraining order (TRO) enjoining defendant bible publisher from further advertising, selling, shipping, or in any way distributing the book entitled fireside Catholic Youth Bible. Plaintiff published the Catholic Youth Bible and asserted that the similarity of the titles and art design of the two books, inter alia, was likely to result in consumer confusion regarding these products.

OVERVIEW: In 1995, plaintiff decided to develop a Bible aimed at young Catholics. It developed the product for five years prior to its release in November 1999 under the title "The Catholic Youth Bible." Following its success, plaintiff created a series of works under The Catholic Youth Bible mark which was responsible for more than one-third of its total revenues in fiscal year 2004. An announcement indicated that defendant would be making its fireside Catholic Youth Bible available for distribution. The court found that: (1) plaintiff had not met its burden of showing that consumers were likely to be confused as to the source or affiliation of plaintiff's and defendant's products because of the similarity of the marks; (2) the balance of harms weighed in favor of defendant; (3) since issues remained concerning whether use of the mark is likely to cause confusion, the public interest was best served by preserving the status quo until such time as those issues can be fully adjudicated. The court reserved judgment on the issue of whether the mark "The Catholic Youth Bible" was generic or descriptive.

OUTCOME: Plaintiff's motion for a temporary restraining order was denied.

LexisNexis(R) Headnotes

Civil Procedure > Injunctions > Temporary Restraining Orders

Civil Procedure > Injunctions > Elements

[HN1] Under Eighth Circuit precedent, a temporary restraining order may be granted only if the moving party can demonstrate: (1) that the movant will suffer irreparable harm absent the restraining order; (2) that the balance of harms favors the movant; (3) that the public interest favors the movant; and (4) a likelihood of success on the merits. None of the factors by itself is determinative; rather, in each case the factors must be balanced to determine whether they tilt toward or away from granting injunctive relief. The party requesting the injunctive relief bears the "complete burden" of proving all the factors listed above.

Civil Procedure > Injunctions > Elements

[HN2] A movant seeking injunctive relief must first establish that irreparable harm will result if injunctive relief is not granted and that such harm will not be compensable by money damages. A showing of speculative harm is insufficient to meet this burden. Failure to show irreparable harm alone is a sufficient basis for a court to deny injunctive relief.

Trademark Law > Infringement Actions > General Overview

Trademark Law > Likelihood of Confusion > Consumer Confusion > General Overview

[HN3] In trademark infringement cases injury is presumed once a likelihood of confusion has been established.

Trademark Law > Federal Unfair Competition Law > False Designation of Origin > Palming Off

Trademark Law > Likelihood of Confusion > Similarity > Appearance, Meaning & Sound > General Overview
Trademark Law > Likelihood of Confusion > Intent > General Overview

[HN4] A court must consider several factors in evaluating whether there is a likelihood of confusion between trademarks, including: (1) the strength of the mark; (2) the similarity between the mark and the defendant's mark; (3) the competitive proximity of the products on which the respective marks are placed; (4) the intent of the alleged infringer to pass off its goods as those of the mark holder; (5) the incidents of actual confusion; and (6) the degree of care likely to be exercised by potential customers of the mark holder.

Trademark Law > Federal Unfair Competition Law > Trade Dress Protection > Causes of Actions
Trademark Law > Federal Unfair Competition Law > False Designation of Origin > Elements
Trademark Law > Federal Unfair Competition Law > False Advertising > General Overview

[HN5] See 15 U.S.C.S. § 1125(a)(1).

Trademark Law > Infringement Actions > Burdens of Proof

Trademark Law > Infringement Actions > Determinations

[HN6] To succeed on its trademark infringement claim, a plaintiff must show that the claimed marks are entitled to protection and that the defendant's use of the marks is likely to confuse prospective purchasers. Courts classify marks into one of four categories: (1) generic; (2) descriptive; (3) suggestive; and (4) arbitrary or fanciful. The categorization of a given term is a factual determination.

Trademark Law > Infringement Actions > Determinations

[HN7] A descriptive mark conveys characteristics, qualities, or other features of a product and can be protected only if the mark has become distinctive by acquiring some secondary meaning. A generic term does not indicate the source of a service, but merely defines a type, genus or class of services, and is not entitled to any protection.

COUNSEL: John B. Lunseth, II, Esq., and Margaret K. Savage, Esq., Briggs & Morgan, Minneapolis, MN, counsel for Plaintiff.

Earl D. Reiland, Esq., and William D. Schultz, Esq., Merchant & Gould, Minneapolis, MN; Charles E. Mill-

sap, Esq., Fleeson Gooing Coulson & Kitch, Wichita, KS, counsel for Defendant.

JUDGES: DONOVAN W. FRANK, Judge of United States District Judge.

OPINIONBY: DONOVAN W. FRANK

OPINION:

ORDER AND MEMORANDUM

Introduction

The above-entitled matter was brought before the undersigned United States District Judge on June 23, 2004, pursuant to Plaintiff Saint Mary's Press of Minnesota's ("SMP") Motion for Temporary Restraining Order. Specifically, SMP requests that this Court enter a Temporary Restraining Order enjoining Defendant DeVore & Sons, Inc. ("DeVore") from further advertising, selling, shipping, or in any way distributing the book entitled *fireside Catholic Youth Bible*. For the reasons set forth below, the Court denies SMP's Motion for Temporary Restraining Order.

Background

SMP is a Minnesota corporation administered by De La Salle Christian Brothers [*2] ("Christian Brothers"). The ministry of the Christian Brothers is educating Catholic young people. Toward this end, Christian Brothers sponsors high schools and middle schools, Saint Mary's University of Minnesota, and SMP. Christian Brothers began publishing religious materials in 1943 and incorporated SMP in 1991. SMP publishes religious materials for Catholics between the ages of 10 and 19 years old. DeVore is a family owned business that has published Bibles since 1944. DeVore publishes Bibles under several names including, Fireside, Heirloom, and St. Jerome Press.

Bibles for Catholics are part of a \$ 306 million dollar market for Bibles. Bibles for Catholics contain seven additional Old Testament books, called the Apocrypha, that are not found in most Bibles. Catholic Bibles are primarily identified by reference to a scripture translation approved by the United States Catholic Conference of Bishops. The principal authorized translations are the New Revised Standard Version-Catholic Edition ("NRSVCE") and the New American Bible ("NAB").

In 1995, SMP decided to develop a Bible aimed at young Catholics. SMP developed the product for five years prior to its release in November 1999 [*3] under the title *The Catholic Youth Bible*. Bible publishers use three types of scriptural aids to help users understand the Biblical text: study aids, devotional aids, and life-application aids. While it is common to publish Bibles

with one or sometimes two of these aids, SMP took the unusual step of combining all three types of scriptural aids in *The Catholic Youth Bible*. SMP also decided to create context relevant scriptural aids, meaning that each scriptural aid was printed on the same page or facing the page of the related Biblical text.

In March 1999, SMP hired a public relations firm to assist in the marketing of the book. The first official announcement regarding the availability of *The Catholic Youth Bible* was in SMP's catalog of new books for fall 1999. *The Catholic Youth Bible* was an immediate success for SMP selling 149,000 copies in the first year. In response, SMP created a series of works under *The Catholic Youth Bible* mark. Over time, *The Catholic Youth Bible* series has become SMP's most valuable product line and it is responsible for more than one-third of SMP's total revenues in fiscal year 2004.

SMP sells *The Catholic Youth Bible* products [*4] to institutions, primarily Catholic middle schools and high schools, independent retail stores, and directly to customers through its website, direct mail solicitations, and telemarketing. Fifty-three percent of SMP's Bible sales are to church and school accounts, 15% through bookstores, 28% through wholesalers and distributors, 2% are direct consumer sales, and 2% are foreign sales.

On or about March 17, 2004, SMP learned that DeVore, under its Fireside Catholic Publishers imprint, had announced the publication of a new Bible. The announcement indicated that the *fireside Catholic Youth Bible* would be available for distribution in May 2004. The suggested retail price for the *fireside Catholic Youth Bible* was \$ 24.95.

SMP asserts that DeVore is familiar with *The Catholic Youth Bible* Series. SMP points out that DeVore and SMP exhibit at the same trade shows and that DeVore's employees have commented to SMP employees about the success of *The Catholic Youth Bible* Series. SMP also asserts that SMP's president contacted Mr. DeVore to discuss a possible collaboration between the two companies regarding future products. SMP asserts that Mr. DeVore acknowledged the success [*5] of *The Catholic Youth Bible* Series, but that Mr. DeVore expressed no interest in the proposed collaboration.

The titles, *The Catholic Youth Bible* and *fireside Catholic Youth Bible*, are nearly identical and SMP contends that the art contained on the cover and spine of the two books is confusingly similar. SMP points out that the title of the *fireside Catholic Youth Bible* is similar in the style of its lettering, the layout of the words in the title, and the color of the words in the title. SMP asserts that the design and color of the two books are also similar. SMP also asserts that the appearance of the spine of the two books is very similar.

SMP asserts that the similarity of the titles and art design of the two books, along with the fact that these books were both designed for Catholic youth, are both marketed in the same channels of trade, and are marketed to the same potential consumers, is likely to result in consumer confusion regarding these products. As evidence of actual confusion in the marketplace, SMP submits that at least two individuals have telephoned their office regarding purchases of *fireside Catholic Youth Bible* and another individual contacted [*6] SMP and asked how DeVore was able to use the *fireside Catholic Youth Bible* title for its product.

Discussion

I. Standard of Review

[HN1] Under Eighth Circuit precedent, a temporary restraining order may be granted only if the moving party can demonstrate: (1) that the movant will suffer irreparable harm absent the restraining order; (2) that the balance of harms favors the movant; (3) that the public interest favors the movant; and (4) a likelihood of success on the merits. *See Dataphase Sys., Inc. v. C L Sys., Inc.*, 640 F.2d 109, 113 (8th Cir. 1981). None of the factors by itself is determinative; rather, in each case the factors must be balanced to determine whether they tilt toward or away from granting injunctive relief. *See West Pub. Co. v. Mead Data Cent., Inc.*, 799 F.2d 1219, 1222 (8th Cir. 1986), cert. denied, 479 U.S. 1070, 93 L. Ed. 2d 1010, 107 S. Ct. 962 (1987). The party requesting the injunctive relief bears the "complete burden" of proving all the factors listed above. *Gelco Corp. v. Coniston Partners*, 811 F.2d 414, 418 (8th Cir. 1987).

A. Irreparable Harm

[HN2] The movant must first establish that [*7] irreparable harm will result if injunctive relief is not granted and that such harm will not be compensable by money damages. *See Packard Elevator v. I.C.C.*, 782 F.2d 112, 115 (8th Cir. 1986). A showing of speculative harm is insufficient to meet this burden. *See id.* Failure to show irreparable harm alone is a sufficient basis for a court to deny injunctive relief. *Gelco*, 811 F.2d at 420.

SMP asserts that it does not need to establish irreparable harm because where there is trademark infringement, the law presumes that irreparable harm exists. In *Mutual of Omaha Ins. Co. v. Novak*, the Eighth Circuit held that [HN3] in trademark infringement cases injury "is presumed once a likelihood of confusion has been established . . ." 836 F.2d 397, 403 n.11 (8th Cir. 1987). Therefore, the Court must consider whether SMP has demonstrated a showing of likelihood of confusion.

[HN4] A court must consider several factors in evaluating whether there is a likelihood of confusion,

including: (1) the strength of the mark; (2) the similarity between the mark and the defendant's mark; (3) the competitive proximity of the products on which the respective marks [*8] are placed; (4) the intent of the alleged infringer to pass off its goods as those of the mark holder; (5) the incidents of actual confusion; and (6) the degree of care likely to be exercised by potential customers of the mark holder. *See SquirtCo v. Seven-Up Co.*, 628 F.2d 1086, 1091 (8th Cir. 1980).

The Court finds that SMP has not met its burden of showing that consumers are likely to be confused as to the source or affiliation of SMP's and DeVore's products because of the similarity of the marks. While the record presently before the Court supports the assertion that the similarities in the title and appearance of SMP's and DeVore's products are not purely coincidental or fortuitous, the Court finds that the remainder of the factors either weigh in favor of neither party or weigh in favor of DeVore.

The Court begins by considering the strength of the mark. The mark, *The Catholic Youth Bible*, is not particularly distinctive. Thus, the mark is entitled to a narrower scope of protection. In fact, SMP acknowledged that for the purposes of this motion it "assumes that its mark is entitled to the lowest degree of protection -- as a descriptive mark." (Plaintiff's [*9] Memorandum In Support Of Motion For Preliminary Injunction, 21 n.9.)

Another factor that weighs heavily in DeVore's favor is the degree of care likely to be exercised by potential customers of the mark holder. DeVore has presented evidence that Catholic educational institutions, the largest purchasers of these products, have textbook committees that review complimentary copies of all of the available products before recommending the purchase of a particular Bible for its students. (Declaration of Ronald Leiker, P53.) DeVore has also presented evidence that the recommendations of the textbook committee often must be approved at the Diocesan level. (*See id.*) The Court finds that the evidence presented by DeVore supports a finding that Catholic educational institutions are sophisticated purchasers regarding purchases of Bibles for their students.

The Court also finds that the evidence of actual confusion that has been presented by SMP is fairly limited. SMP's president, John Vitek, stated in his affidavit that he was aware of at least two instances where customers contacted SMP and requested information about both the *fireside Catholic Youth Bible* and *The Catholic Youth Bible*. [*10] (Affidavit of John Vitek, P63.) In addition, Vitek stated that an employee of SMP had a conversation with an individual familiar with the industry and the SMP employee was asked how DeVore was able to "use the name of" SMP's product. (*See id.*)

While the two telephone calls support a finding of confusion regarding the source and affiliation of the products, the calls also evidence an understanding among consumers that there are two different products on the market. The conversation regarding the "use of the name of" SMP's product evidences confusion regarding the rights to the marks at issue in this case, but it is also evidence that those familiar with the industry associate each of the products with their respective publishers. Based on its review of the evidence, the Court finds that the incidents of actual confusion regarding the two products is limited at best.

The Court finds that SMP has failed to establish a likelihood of confusion among consumers as a result of DeVore's alleged infringement. Therefore, the Court finds that SMP will not be irreparably harmed absent the issuance of a temporary restraining order. While the failure to establish irreparable harm is sufficient [*11] alone to deny the injunctive relief sought, the Court will also discuss the remaining *Dataphase* factors.

B. Balance of Harms

The second *Dataphase* factor to be considered is whether the harm to the movant in the absence of injunctive relief outweighs the potential harm that granting injunctive relief may cause to the non-movant. *See Dataphase*, 640 F.2d at 114. Here, SMP asserts that it has invested considerable time, human resources, and money into developing goodwill in *The Catholic Youth Bible* series of products. SMP contends that DeVore's products and the alleged use of SMP's marks by DeVore will jeopardize the goodwill developed by SMP. DeVore, on the other hand, asserts that an injunction preventing it from delivering its product to Catholic schools would harm not only its reputation with these institutions, but would also harm these institutions as they would be forced to search for alternative products before the school year commenced. While the consequences DeVore sets out may not come to pass, DeVore has presented evidence that a temporary restraining order would inflict substantial harm on its present and future operations. In contrast, [*12] SMP has tied its assertions regarding harm to a likelihood of confusion in the marketplace regarding the products--a likelihood of confusion that this Court has already found has not been sufficiently established. Accordingly, the Court finds that the balance of harms weighs in favor of DeVore.

C. Public Interest

The third *Dataphase* factor to be considered by a court is whether injunctive relief is in the public's interest. *See Dataphase*, 640 F.2d at 114. SMP asserts that the public interest would be served by a temporary restraining order because confusion among consumers regarding the products would be avoided. In contrast,

DeVore asserts that a temporary restraining order would deprive consumers of the benefits of competition in the marketplace. The Court finds that since issues remain concerning whether use of the mark is likely to cause confusion, the public interest is best served by preserving the status quo until such time as those issues can be fully adjudicated. *See Nat'l Basketball Ass'n v. Minnesota Prof'l Basketball, Ltd. P'ship*, 56 F.3d 866, 872 (8th Cir. 1995).

D. Likelihood of Success on the Merits

The final *Dataphase* [*13] factor requires that the movant establish a substantial probability of success on the merits of its claim. *See Dataphase*, 640 F.2d at 114. The parties have focused their analysis on SMP's claim that DeVore violated the Lanham Act, 15 U.S.C. § 1051, *et seq.* The Lanham Act provides that:

[HN5] (1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading misrepresentation of fact, which--

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes [*14] that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125(a)(1).

[HN6] To succeed on its trademark infringement claim, SMP must show that the claimed marks are entitled to protection and that DeVore's use of the marks is likely to confuse prospective purchasers. *See Hubbard Feeds, Inc. v. Animal Feed Supplement, Inc.*, 182 F.3d 598, 601 (8th Cir. 1999). Courts classify marks into one of four categories: (1) generic; (2) descriptive; (3) suggestive; and (4) arbitrary or fanciful. *See Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976). The categorization of a given term is a factual determination. *See WSM, Inc. v. Hilton*, 724 F.2d 1320, 1326 (8th Cir. 1984).

The parties agree that the mark *The Catholic Youth Bible* is neither arbitrary nor suggestive, but disagree as to whether the mark is generic or descriptive. [HN7] A descriptive mark conveys characteristics, qualities, or other features of a product and can be protected only if the mark has become distinctive by acquiring some secondary meaning. *See General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 625 (8th Cir. 1987) [*15] (citing *Co-Rect Prods. v. Marvy! Adver. Photography*, 780 F.2d 1324, 1329 (8th Cir. 1985)). A generic term does not indicate the source of a service, but merely defines a type, genus or class of services, and is not entitled to any protection. *See id.*

SMP asserts that the title *The Catholic Youth Bible* is descriptive and has established secondary meaning. In support of this assertion, SMP presented the Court with the results of an electronic database search that showed that the vast majority of links to web pages containing the phrase "Catholic youth bible" were links to material about SMP and its products. DeVore, on the other hand, asserts that SMP's marks are generic and therefore are not entitled to protection. In support of its position, DeVore presented information taken from the Internet that showed that the phrase "Catholic youth bible" was being used by at least one other Bible manufacturer to promote its product and that the phrase had been adopted by some retailers as a general classification of Bibles.

Rather than making a determination of the strength of the mark based only on the limited evidence the parties were able to provide the Court within [*16] the time confines of a temporary restraining order hearing, the Court will reserve judgment on the issue. Whether that decision is one appropriate for the Court in the future or is one that needs to be considered by a jury will be made clearer as additional evidence about the products at issue, the market, and the relevant class of consumers of the products is obtained by the parties.

Conclusion

The Court believes it is in the best interests of the parties to negotiate a resolution of this dispute. To take a quote directly from the products at issue "settle with your opponent quickly while on the way to court with him. Otherwise your opponent will hand you over to the judge" (*The Catholic Youth Bible*, NAB, Matthew 5:25, pg. 1200; *fireside Catholic Youth Bible*, NAB, Matthew 5:25, pg. 1015.) As the parties may already be aware, Magistrate Judge Susan Richard Nelson is available to assist in the negotiation of a settlement should the parties find such services to be helpful. If the Court may be of assistance in this matter, the parties should contact Lowell Lindquist, Calendar Clerk for Judge Donovan Frank, at 651-848-1296, or Beverly Riches, Calendar

Clerk for [*17] Magistrate Judge Susan Richard Nelson, at 651-848-1200.

For the reasons stated, **LET IT BE ORDERED THAT:**

1. Plaintiff Saint Mary's Press of Minnesota's Motion for Temporary Restraining Order (Doc. No. 7) is **DENIED.**

Dated: June 29, 2004

DONOVAN W. FRANK

Judge of United States District Court

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