

Judge Sticks It To Notepaper Rival In 3M's Post-It IP Suit

By **Stewart Bishop**

Law360, New York (January 04, 2013, 12:19 PM ET) -- A Minnesota federal judge ruled Thursday against Unemployed Philosophers Inc. in 3M Co.'s trademark and unfair competition suit over its famous Post-It notes, finding the novelty company's line of sticky notepaper is too similar to 3M's mark.

At issue are Unemployed Philosophers' Jeez-Its, Buddh-Its, Femin-Its and other products, which 3M claims infringe its "Post-It" trademark by using the "-Its" suffix on a confusingly similar item. Two others — Post Structural-Its and Vincent Van Gogh Post Impressions — also allegedly infringe 3M's trademarked name by using the word "post," according to 3M.

In a consent judgment, U.S. District Judge Susan Richard Nelson ruled that Unemployed Philosophers' use of 3M's marks was likely to cause confusion, to cause mistake and to deceive current and potential customers about the origin or approval of Unemployed Philosophers' products by 3M.

"[Unemployed Philosophers'] use of [its] marks is likely to cause dilution by blurring and dilution by tarnishment of 3M's famous 'Post-It' mark," the judge wrote.

An attorney for Unemployed Philosophers, Lindsay G. Arthur Jr. of Arthur Chapman Kettering Smetak & Pikala PA, said Friday that the consent judgment didn't contain the terms of a confidential settlement that was reached earlier in the case, and noted that his clients were "very happy" with the result.

Judge Nelson barred Unemployed Philosophers from future use of any mark or product name that is confusingly similar to or likely to cause dilution of 3M's mark.

Furthermore, the judge ordered the novelty company to cease selling and making sticky note products or related goods that use or feature the terms "Post-," "-It" or "-Its," whether alone or in combination with other terms or characters.

Judge Nelson gave Unemployed Philosophers until Aug. 1 to sell out of its existing stock of products that feature the marks at issue. After the phase-out period is complete, the judge ruled, the company may only hang onto a small number of the products for historical or archival purposes.

3M and Unemployed Philosophers are to bear their own costs and attorneys' fees, the judge wrote.

Representatives for 3M could not be immediately reached for comment Friday.

Operating under the name Unemployed Philosophers Guild, the New York-based company sells

a wide range of household products parodying famous philosophers, artists, scientists and politicians on its website and through retail stores. Examples include a mug covered in Shakespearean insults and finger puppets of Sigmund Freud, Andy Warhol and Abraham Lincoln.

3M first brought suit in October 2011, contending that Unemployed Philosophers' use of the "Post-It" name "enables it to trade on and receive the benefit of goodwill built up at great labor and expense by 3M over many years, and to gain acceptance for its products and services not solely on their own merits, but on the reputation and goodwill of 3M," the suit said.

Minnesota-based 3M alleged trademark infringement and dilution, unfair competition, deceptive and unlawful trade practices, false designation of origin, and unjust enrichment.

Unemployed Philosophers has been selling sticky notes including the "-Its" suffix for about seven years, although 3M only informed it of the alleged infringement months before it filed suit, according to Unemployed Philosophers co-owner Stephan Shaw.

The plaintiff introduced the Post-It brand about 30 years ago, has acquired common law rights to the mark and has registered the name for various goods sold by 3M, according to the complaint.

3M is represented by Heather J. Kliebenstein of Merchant & Gould PC as well as by Wendy Larson and William G. Barber of Pirkey Barber LLP.

Unemployed Philosophers is represented by Lindsay G. Arthur Jr. and Michelle M. Carter of Arthur Chapman Kettering Smetak & Pikala PA.

The case is 3M Co. v. Unemployed Philosophers Inc., case number 0:11-cv-2916, in the U.S. District Court for the District of Minnesota.

--Editing by Eydie Cubarrubia.

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