UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

BEST VACUUM, INC, Plaintiff, v. IAN DESIGN, INC. Defendant.	)))))))))	DEFENDANT'S MOTION TO DISMISS PLAINTIFF'S COMPLAINT **JUDGE HART** **Civil Action No. 04 C 2249** JURY TRIAL DEMANDED

DEFENDANT'S MOTION TO DISMISS PLAINTIFF'S COMPLAINT

NOW COMES Defendant Ian Design, Inc., pursuant to 12(b)(6) of the Federal Rules of Civil Procedure, and moves this Court to dismiss all counts of the Plaintiff's Complaint. In support of its motion, the Defendant incorporates the accompanying memorandum and states as follows:

The Plaintiff has failed to state claims upon which relief may be granted. Specifically, the Plaintiff's claim under 15 U.S.C. § 1114 is inapplicable to the instant circumstances. Moreover, the remaining counts fail to allege all requisite elements and properly identify the specific claims being made. Consequently, the Plaintiff's Complaint should be dismissed pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure. See Fed. R. Civ. P. 12(b)(6). Alternatively, should the Court find that any of Counts II, III or IV should not be dismissed, the Defendant moves for a more definite statement as more fully articulated in the accompanying memorandum.

CONCLUSION

For the foregoing reasons and those in the accompanying memorandum, the Defendant respectfully moves this Court to dismiss Plaintiff's Complaint in its entirety.

Dated: Chicago, IL
September 30, 2004

Respectfully submitted,

DEFENDANT,
IAN DESIGN, INC.

By: _____

Its Attorney
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CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing MOTION TO DISMISS PLAINTIFF'S COMPLAINT has been sent by facsimile and First Class Mail, postage prepaid, this 30 day of September 2004, to counsel for Plaintiff, to wit:

To: Mr. David M. Adler
David M. Adler, Esq. & Associates
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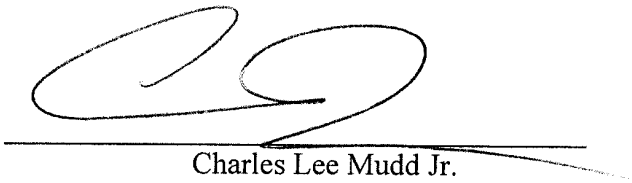
Suite 1600
Chicago, Illinois 60602



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Dated: September 3 2004
Chicago, Illinois

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF ILLINOIS

EASTERN DIVISION

BEST VACUUM, INC,	)	DEFENDANT'S MEMORANDUM
	)	IN SUPPORT OF ITS MOTION TO
Plaintiff,	)	DISMISS PLAINTIFF'S COMPLAINT
	)	
v.	)	**JUDGE HART**
	)	
IAN DESIGN, INC.	)	**Civil Action No. 04 C 2249**
	)	
Defendant.	)	JURY TRIAL DEMANDED

NOTICE OF FILING

To: Mr. David M. Adler
David M. Adler, Esq. & Associates
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Suite 1600
Chicago, Illinois 60602

Please take notice that I have this 3rd day of September 2004 filed with the Clerk of the above Court the **DEFENDANT'S MEMORANDUM IN SUPPORT OF ITS MOTION TO DISMISS PLAINTIFF'S COMPLAINT**, a copy of which is herewith served upon you.

Dated this 3rd day of September 2004.

Charles Lee Mudd Jr.

Charles Lee Mudd, Jr.
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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF ILLINOIS

EASTERN DIVISION

BEST VACUUM, INC, Plaintiff, v. IAN DESIGN, INC. Defendant.	)))))))))	DEFENDANT'S MEMORANDUM IN SUPPORT OF ITS MOTION TO DISMISS PLAINTIFF'S COMPLAINT **JUDGE HART** **Civil Action No. 04 C 2249** JURY TRIAL DEMANDED

CHARLES LEE MUDD JR.

Attorney for Defendant

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MEMORANDUM IN SUPPORT OF DEFENDANT'S

MOTION TO DISMISS PLAINTIFF'S COMPLAINT

DEFENDANT'S MEMORANDUM IN SUPPORT OF ITS

MOTION TO DISMISS PLAINTIFF'S COMPLAINT

NOW COMES Defendant Ian Design, Inc., pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure, and respectfully submits this Memorandum in Support of Its Motion to Dismiss Plaintiff's Complaint. In support of its motion to dismiss, Defendant states as follows:

OPENING STATEMENT

By this action, the Plaintiff seeks to obtain a monopoly on the ability to claim that it sells the best vacuums. In this action, the Plaintiff has filed claims against the Defendant for using the descriptive words "best" and "vacuum" in domain names it has registered to advertise its vacuum business. In doing so, the Plaintiff has stated an inapplicable claim due to the lack of a registered trademark and has failed to adequately and properly plead its remaining claims. Not only has the Plaintiff filed an oppressive and anti-competitive complaint against the Defendant, it has done so carelessly. Without addressing the validity and viability of the Plaintiff's mark, which the Defendant does not concede, the Defendant moves to dismiss the Plaintiff's Complaint in its entirety.

BACKGROUND

This controversy involves vacuums. The Plaintiff sells vacuums manufactured by third parties, among other related products. See Compl. (#1), ¶5. The Defendant sells vacuums manufactured by third parties, among other related products. See id., ¶6. In fact, the Parties sell vacuums manufactured by the some of the same third parties. The Plaintiff's business operates from the State of Illinois. See id., ¶5. The Defendant's business operates from the State of New Jersey.[1] Both parties sell their products on and through the Internet. See id., ¶¶ 5, 13, 14.

In the operation of its business, the Plaintiff has used the descriptive and generic phrase

"Best Vacuum." In 1996, it obtained the domain name www.bestvacuum.com. See Compl.,at Summary. The Defendant has never operated under the name "Best Vacuum" or claimed any relation to the Plaintiff. Rather, the Plaintiff claims that the Defendant obtained the domain names www.bestvacuumcleaner.com and www.bestchoicevacuums.com. See id., ¶¶ 13, 14.

In March 2004, the Plaintiff filed this action seeking to preclude the Defendant from using the words "best" and vacuum" in the operation of its business selling vacuums. See generally Compl. The Defendant now moves to dismiss Plaintiff's Complaint in its entirety.

ARGUMENT

The Court should dismiss Plaintiff's Complaint in its entirety for failure to state a claim. Specifically, Count I of the Complaint should be dismissed because the Plaintiff does not have a registered mark. Counts II, III and IV should be dismissed because the Plaintiff does not sufficiently plead the claims it seeks to make. In the alternative, the Plaintiff should be ordered to provide a more definite statement as to Counts II, III, and IV.

STANDARD

In deciding a motion to dismiss brought pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure, a Court will accept all well-pleaded facts as true and will draw all reasonable inferences in favor of the Plaintiff. See Hernandez v. City of Goshen, 324 F.3d 535, 537 (7th Cir. 2003). However, a Court must dismiss any claim where it appears beyond all doubt that the Plaintiff can prove no set of facts that would entitle him to relief. See id. Moreover, a plaintiff must allege in its complaint sufficient facts to set forth the essential elements of a cause of action to survive a motion to dismiss. See Lucien v. Preiner, 967 F.2d 1166, 1168 (7th Cir. 1992), cert. denied, 506 U.S. 893 (1992).

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[1] In contrast to Plaintiff's allegation, Ian Design, Inc. is a Delaware corporation.

I. Count I Should Be Dismissed for Lack of Registered Mark

The Defendant moves to dismiss the Count I of the Complaint. In Count I, the Plaintiff brings a claim for trademark infringement under § 32 of the Lanham Act. Section 32 is codified at 15 U.S.C. § 1114. See 15 U.S.C. § 1114. To succeed on a claim under Section 1114, a plaintiff must have a registered mark. See Brennan's Inc. v. Brennan's Restaurant, L.L.C., 360 F.3d 125, 129-130 (2nd Cir. 2004) (characterizing § 1114 claim as one of "imitation of registered mark"); Virgin Enterprises Ltd. v. Nawab, 335 F.3d 141, 146 (2d Cir. 2003) (characterizing § 1114 claim as one of "imitation of registered mark"); Dakota Industries, Inc. v. Dakota Sportswear, Inc., 946 F.2d 1384, 1388 n.1 (8th Cir. 1991) ("[s]ection 1114 prohibits the infringement of a registered mark, while section 1125(a) does not require a registered mark and simply prohibits false designations of origin"); Maier Brewing Co. v. Fleischmann Distilling Corp., 390 F.2d 117, 119 (9th Cir. 1968) ("[s]ection 1114 provides civil liability for the infringement of a registered trade-mark by goods used in commerce"); S Industries, Inc. v. Diamond Multimedia Systems, Inc., 991 F. Supp. 1012, 1017 (N.D. Ill. 1998) (Section 1114 applies only to registered marks). Here, Best Vacuum, Inc. does not have a registered trademark. See Compl., Ex. A. Thus, Best Vacuum, Inc. cannot file a claim pursuant to § 1114 for the mark "Best Vacuum." See S Industries, Inc., 991 F. Supp. at 1017. Therefore, this Court must dismiss Count I of the Complaint. See id.

II. Motion to Dismiss or, Alternatively, for a More Definite Statement as to Count II

In Count II, the Plaintiff claims the Defendant has used "bestchoicevacuums" and "bestvacuumcleaners" to promote, market, and sell identical products. See Compl. ¶ 30. The Plaintiff contends this amounts to willful trademark dilution in violation of 15 U.S.C. § 1125(c).

See id. To properly plead a claim for trademark dilution in violation of 15 U.S.C. § 1125(c), a plaintiff must allege, and eventually prove, that

> (1) the mark is famous; (2) the defendant is making a commercial use of the mark in commerce; (3) the defendant's use began after the mark became famous; and (4) the defendant's use of the mark dilutes the quality of the mark by diminishing the capacity of the mark to identify and distinguish goods and services.

Panavision Int'l, L.P. v. Toeppen, 141 F.3d 1316, 1324 (9th Cir. 1998); see also 15 U.S.C. § 1125(c). Here, the Plaintiff has not alleged that its mark is famous for purposes of 15 U.S.C. § 1125(c). See generally Compl. And, while it refers briefly and quite generally to the "fame" of its mark, this does not satisfactorily allege that the mark is famous in the context of 15 U.S.C. § 1125(c) and the factors that a court may consider in determining whether a mark is famous.[2] See 15 U.S.C. § 1125(c). Moreover, the Plaintiff fails to allege when its mark purportedly became famous and whether the Defendant began using its marks before or after the Plaintiff's mark purportedly became famous. See generally Compl. Consequently, the Plaintiff has failed to allege the requisite elements of trademark dilution under § 1125(c). See Panavision, 141 F.3d at 1324; 15 U.S.C. § 1125(c). Therefore, Count II should be dismissed. See Lucien, 967 F.2d at 1168.

Alternatively, should the Court deny Defendant's motion to dismiss Count II, the Defendant moves this Court pursuant to Rule 12(e) of the Federal Rules of Civil Procedure to order the Plaintiff to provide a more definite statement as to (a) the specific elements supporting an allegation, if one exists, that its mark is "famous" and (b) the date upon which its mark allegedly became famous. See Fed. R. Civ. P. 12(e).

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[2] Although the Defendant does not believe the Plaintiff's mark to be famous for purposes of § 1125(c), it does not make such arguments here in this motion to dismiss.

III. Motion to Dismiss or, Alternatively, for a More Definite Statement as to Count III

In Count III, the Plaintiff broadly claims the Defendant engaged in unfair competition in violation of 15 U.S.C. § 1125(a). See Compl. ¶ 32. However, the Plaintiff does not specifically allege which portion of § 1125(a) it claims to have been violated, 1125(a)(1)(A) or 1125(a)(1)(B). Moreover, the Plaintiff's surrounding allegations do not make this clear. See generally Compl. While the Plaintiff uses general terms such as "confusion" and "deception," it does not properly allege the nature of this confusion or deception, including the nature of the specific conduct giving rise to such alleged "confusion" or "deception." See id. Consequently, the Plaintiff has failed to properly allege the requisite elements of unfair competition under § 1125(a). In addition, the Plaintiff has failed to allege that it has actually been harmed by lost or diverted sales because of the Defendant's alleged conduct. For example, the Plaintiff claims only that its capacity to identify and distinguish its patterns "is likely to lessen" and consumers are "likely to be misled." See Compl., ¶¶ 24, 26. As such, the Plaintiff has failed to allege a requisite element under § 1125(a).[3] See Navistar Intern. Transp. Corp. v. Freightliner Corp., 1997 WL 729060, *2, 1997 U.S. Dist. LEXIS 19000, *5 (N.D. Ill. Aug 28, 1997) (holding that allegations of "likely" to be injured insufficient under money damages claim under § 1125(a)). Thus, Count III should be dismissed. See Lucien, 967 F.2d at 1168. At a minimum, the Court must dismiss that portion of Count III that seeks monetary damages. See Navistar, 1997 U.S. Dist. LEXIS at *5; Lucien, 967 F.2d at 1168.

Alternatively, should the Court deny Defendant's motion to dismiss Count III, the Defendant moves this Court pursuant to Rule 12(e) of the Federal Rules of Civil Procedure to order the Plaintiff to provide a more definite statement. Indeed, the Defendant cannot reasonably

[3] Arguably, the Plaintiff has also failed to specifically allege that interstate commerce has been affected. However, the Defendant concedes that interstate commerce can be implied from the pleadings.

be required to properly frame a responsive pleading at this juncture. Specifically, the Defendant moves this Court to order a more definite statement as to which provision of § 1125(a) the Plaintiff claims to have been violated. See Fed. R. Civ. P. 12(e).

IV. Motion to Dismiss or, Alternatively, for a More Definite Statement as to Count IV

In Count IV, the Plaintiff claims violations of the Illinois Deceptive Trade Practices Act. In doing so, the Plaintiff broadly claims a violation of "815 ILCS 510/2 et seq." See Compl. ¶ 34. However, the Plaintiff again does not specifically identity the subsection of the statute that it claims to have been violated. See id. The IDTPA contains 12 subsections to section 510/2.[4] See 815 ILCS 510/2, et seq. Moreover, each specific provision requires similar but distinct elements. See Stephen & Hayes Const., Inc. v. Meadowbrook Homes, Inc., 988 F. Supp. 1194, 1198 (N.D. Ill. 1998) (identifying similar but distinct elements for sections 510/2(2) and

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[4] § 2. Deceptive trade practices.

(a) A person engages in a deceptive trade practice when, in the course of his or her business, vocation, or occupation, the person:

(1) passes off goods or services as those of another;
(2) causes likelihood of confusion or of misunderstanding as to the source, sponsorship, approval, or certification of goods or services;
(3) causes likelihood of confusion or of misunderstanding as to affiliation, connection, or association with or certification by another;
(4) uses deceptive representations or designations of geographic origin in connection with goods or services;
(5) represents that goods or services have sponsorship, approval, characteristics, ingredients, uses, benefits, or quantities that they do not have or that a person has a sponsorship, approval, status, affiliation, or connection that he or she does not have;
(6) represents that goods are original or new if they are deteriorated, altered, reconditioned, reclaimed, used, or secondhand;
(7) represents that goods or services are of a particular standard, quality, or grade or that goods are a particular style or model, if they are of another;
(8) disparages the goods, services, or business of another by false or misleading representation of fact;
(9) advertises goods or services with intent not to sell them as advertised;
(10) advertises goods or services with intent not to supply reasonably expectable public demand, unless the advertisement discloses a limitation of quantity;
(11) makes false or misleading statements of fact concerning the reasons for, existence of, or amounts of price reductions;
(12) engages in any other conduct which similarly creates a likelihood of confusion or misunderstanding.

510/2(3)). As such, the Plaintiff has failed to allege a requisite element under 815 ILCS 510/2.[5] Therefore, Count IV should be dismissed. See Lucien, 967 F.2d at 1168.

Alternatively, should the Court deny Defendant's motion to dismiss Count IV, the Defendant moves this Court pursuant to Rule 12(e) of the Federal Rules of Civil Procedure to order the Plaintiff to provide a more definite statement. Indeed, the Defendant cannot reasonably be required to properly frame a responsive pleading at this juncture. Specifically, the Defendant moves this Court to order a more definite statement as to which provision of 815 ILCS 510/2 the Plaintiff claims to have been violated. See Fed. R. Civ. P. 12(e).

[5] Arguably, the Plaintiff has also failed to specifically allege that interstate commerce has been affected. However, the Defendant concedes that interstate commerce can be implied from the pleadings.

CONCLUSION

For the foregoing reasons, the Defendant respectfully moves this Court to dismiss Plaintiff's Complaint in its entirety. In the alternative, for each count not dismissed, the Defendant respectfully moves this Court to order the Plaintiff to make a more definite statement.

Dated: Chicago, IL
September 3rd, 2004

Respectfully submitted,

DEFENDANT,
IAN DESIGN, INC.

By: _____
Its Attorney

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CERTIFICATE OF SERVICE

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To: Mr. David M. Adler
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Dated: September 30 2004
Chicago, Illinois