

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

DELTA SIGMA THETA SORORITY, INC.
1707 New Hampshire Avenue, NW
Washington, DC 20009

Plaintiff,

v.

Case No. \_\_\_\_\_

LETISHA D. BIVINS,
1260 Oxford Lane
Naples, FL 34105

ALPHONSO D. GOINS
1260 Oxford Lane
Naples, FL 34105

FRATHOUSE CLOTHING, LLC
1260 Oxford Lane
Naples, FL 34105

Defendants.

MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF
PLAINTIFF'S APPLICATION FOR A PRELIMINARY INJUNCTION

Delta Sigma Theta Sorority, Incorporated ("Delta") files this Memorandum of Points and
Authorities in Support of its Application for a Preliminary Injunction against Defendants Letisha
D. Bevins, Alphonso D. Goins, and FratHouse Clothing, LLC ("Defendants").

I. INTRODUCTION

This is an action for trademark infringement under federal and District of Columbia law;
federal trademark counterfeiting; federal trademark dilution; and unfair competition under
federal and District of Columbia law. The issue in this case is whether Defendants will be

allowed to continue to use Delta's intellectual property for their own benefit, and thereby profit from and dilute the value of Delta's property and damage Delta's goodwill.

Defendants are marketing and selling merchandise bearing the imprint of trademarks, service marks, and trade dress (collectively "Marks") owned exclusively by Delta. Defendants are not licensed to use Delta's Marks and otherwise have no right to use Delta's Marks. By illegally using Delta's Marks, Defendants suggest that they are affiliated with or have been endorsed by Delta. Defendants' actions, by their very nature, are causing irreparable harm to Delta and the public because they are deceptive and misleading.

Delta has repeatedly appealed to Defendants to cease and desist from infringing on its Marks and engaging in activities designed to damage Delta's goodwill. Defendants have rejected all such appeals and continue to use Delta's property illegally. Delta thus seeks judicial intervention. In a complaint filed with this motion, Delta seeks injunctive and monetary relief, and alleges causes of action based on violations of Sections 32, 43(a) and 43(c) of the Lanham Act, federal and District of Columbia common law trademark infringement, and unfair competition. Defendants' conduct, as set out more specifically in the complaint, entitles Delta to injunctive relief. Delta can and has met each requirement for the issuance of a preliminary injunction, and respectfully urges this Court to grant its motion.

## **II. FACTUAL BACKGROUND**

### **A. Overview of Delta and Importance of its Marks**

Delta is a well-established, highly-regarded, and internationally recognized not-for-profit membership service organization. Delta was founded in 1913 on the campus of Howard University by twenty-two collegiate women who wanted to establish a vehicle for social improvement within their individual communities and the larger society. Since its founding,

Delta has been known to its members, other members of the National Pan-Hellenic Council (an umbrella organization of the nine African American Greek letter organizations), educational institutions, and the general public, not only by its official name “Delta Sigma Theta Sorority, Incorporated,” but also as “Delta,” “Delta Sigma Theta,” “Delta Sorority,” and “DST.” It also is known and recognized by its Greek letter symbols ΔΣΘ. Any iteration of Delta’s name, its Greek letter symbols, or any of its other distinctive identifying Marks is famous and recognized as belonging only to Delta, including its color combination used along with its founding year. Ex. 4 (N. Lenon Johnson Aff. dated 02/25/13) at 2.

Delta now has more than 940 collegiate and alumnae chapters located in the District of Columbia, forty-five states, and eight foreign countries. Since its founding, more than 200,000 women have joined the organization, tens of thousands of whom remain dues paying members, while tens of thousands of other members maintain a less formal affiliation with Delta. More than ten thousand members typically attend Delta’s biennial national conventions, and each of the seven regional conferences (held during years when there is no national convention) typically hosts thousands of members. At its recent centennial celebration in the District of Columbia, more than 12,000 members attended. All categories of members are substantial consumers of merchandise emblazoned with Delta’s Marks. Ex. 4 at 3.

Delta’s growth has increased its zeal to carry out its Founders’ mission. In 1956, Delta established a formal mechanism – its Five Point Programmatic Thrust – to provide service to a greater segment of society. The Five Point Programmatic Thrust is a program emphasizing: (1) economic development; (2) educational development; (3) international awareness and involvement; (4) physical and mental health; and (5) political awareness and involvement. Delta’s profile, name, reputation, and goodwill are continually being enhanced through such

much-acclaimed public service programs. Delta's Marks are widely used and distinctively associated with implementing and administering programs and projects developed to meet the objectives of its Five Point Programmatic Thrust. Ex. 4 at 3-4.

One program that has raised the national stature and reputation of Delta and increased the renown of its Marks is its annual legislative conference, known as Delta Days in the Nation's Capital, now in its twenty-fourth year. Each year almost 1,000 Delta members from across the country come to Washington and spend three days interacting with members of Congress and other elected officials and high level policy makers. At these conferences, materials imprinted with various Delta Marks are routinely disseminated. Similarly, Delta hosts an annual Delta Days at the United Nations ("UN"), having been awarded consultative status with the Economic and Social Council ("ECOSOC") of the UN. Ex. 4 at 4.

A short list of the hundreds of nationally-acclaimed Delta members who remain active (or remained active until their death) highlights one other reason Delta so values its Marks and endeavors to control their use. Among Delta's nationally-known members are: Patricia Roberts Harris, Delta's first Executive Director, who served as Ambassador to Luxembourg and was appointed by President Jimmy Carter to two cabinet positions (Secretary of Housing and Urban Development and Secretary of Health and Human Services); Alexis M. Herman, a past Executive Board member, who served as Secretary of Labor under President Bill Clinton; and Dr. Dorothy I. Height, a past National President of Delta and civil rights icon, who, until a few months before her death in 2010, continued to be called upon by national political leaders to provide her insight and viewpoint on issues. Other nationally-known members include: Barbara Jordan, a former National Treasurer of Delta, who served in the United States House of Representatives with exceptional distinction; Dr. Regina M. Benjamin, Surgeon General of the

United States; and Marcia L. Fudge, a past President of Delta, who is currently serving in the United States House of Representatives. Ex. 4 at 5-6.

Delta's Marks are distinctively its own, and it vigorously protects them. One demonstration of Delta's vigorous protection of its Marks is registration of its Marks with the United States Patent and Trademark Office ("USPTO"); Delta has registered numerous Marks in numerous categories, and has applications pending for the registration of even more Marks. *See* Ex. 1 (List of Delta's Registered Marks). Delta also vigorously protects its registered and common law Marks by employing a staff member whose primary responsibility is to protect Delta's intellectual property, monitor its use, and pursue violators who use Delta's registered and common law Marks. Further, Delta vigorously protects its registered and common law Marks by following a well-defined procedure for licensing the use of its Marks. Ex. 4 at 1, 4-5.

Any person or entity interested in obtaining a license to use Delta's name or Marks must complete an application. If the application is approved by Delta, after careful review, the vendor must execute a License Agreement, which includes and incorporates by reference Delta's *Operating Guidelines and Code of Conduct for Vendors*. *See* Ex. 3 (License Agreement). These documents make clear the importance Delta attaches to its intellectual property, and the vendor's compliance obligations.

Each year, Delta receives hundreds of requests from vendors seeking a license to sell products and merchandise imprinted with Delta's name(s) and/or one or more of its many other protected Marks. Delta grants a license only to those vendors who meet its licensing requirements. Over the years, it has granted hundreds of such licenses. At its centennial celebration recently held in January 2013, seventy-five (75) licensed vendors participated as

exhibitors. These licensed vendors routinely sell the same categories of items Defendants are selling. Ex. 4 at 4-6.

The License Agreement provides, among other requirements, that any licensed vendor shall confine its sales of merchandise bearing Delta's Marks solely to Delta members and solely at Delta-approved events; that it shall put in place and enforce safeguards designed to protect against unauthorized sales of merchandise bearing Delta's Marks, including sales to non-members; and that Delta has the right to inspect samples of designs and samples of any merchandise prior to its sale or distribution. The *Operating Guidelines and Code of Conduct for Vendors*, which is incorporated into the License Agreement, reiterates and elaborates upon the restrictions Delta imposes upon the use of its Marks. Ex. 3 at 10-11.

**B. Defendants' Infringement of Delta's Marks**

Defendants Bivins and Goins are managing members and the legal owners of FratHouse Clothing, LLC ("FratHouse"). Defendants sell clothing and other merchandise bearing Delta's Marks and display images of the merchandise on their Facebook page, their Twitter account, their Flickr account, and on their website located at [www.frathouseclothing.com](http://www.frathouseclothing.com). Defendants do not have a license or authorization to use Delta's name or any of the Delta Marks. Defendants have never contacted Delta to seek a license or authorization to use Delta's name or any of Delta's Marks. Nevertheless, Defendants market and sell merchandise bearing Delta's Marks ("Infringing Merchandise") without Delta's authorization, and unlawfully trade on Delta's name, reputation, goodwill, and the strength of members' and the public's association of Delta's Marks with Delta. Defendants have advertised for sale through various media the following Infringing Merchandise, which sale is not restricted to Delta members:

- T-Shirts bearing the ΔΣΘ and "Delta Sigma Theta" Marks ;

- Drawstring and Tote Bags bearing the ΔΣΘ Mark; and
- Drawstring and Tote Bags bearing Delta’s common law marks, “1913” and the Greek letter Δ, used with Delta’s red and white color combination.

See Ex. 5 (Images of some of Defendants’ Infringing Merchandise)

**C. Notice to Defendants of their Infringing Activities**

Delta notified Defendants of their infringing activities and demanded that they cease such activities. By letter dated September 29, 2011, Delta, by and through its counsel, demanded that Defendants immediately cease and desist all infringement of Delta’s Marks. Ex. 4, Attach. A. After Defendants failed to respond to Delta’s September 29, 2011 letter, Delta by and through its counsel, sent a second cease and desist letter to Defendants by express mail on October 19, 2011. Ex. 4, Attach. B. Defendants again failed to respond; thus, on November 13, 2012, Delta sent a third cease and desist letter to Defendants, again demanding that they discontinue advertising and selling the Infringing Merchandise.<sup>1</sup> Ex. 4, Attach. C. Defendant Bivins, a member of the Florida Bar, responded by sending two brief electronic messages, the substance of which states that she did not understand the cease and desist letters and that she would not cease the infringing activities. Ex. 4, Attach. D.

Despite having been put on notice that it is infringing on Delta’s Marks and despite having been directed to cease advertising for sale and selling the Infringing Merchandise, Defendants continue to advertise and offer for sale merchandise that infringes on Delta’s

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<sup>1</sup> As a not-for-profit service organization, Delta seeks first to resolve disputes informally on the theory that litigation should be a last resort. See Ex. 4 at 8. Its view has been confirmed based on the positive response it has received from most infringers contacted. Given that Defendant Bivins is a member of the Florida Bar, who practices law in a firm that specializes in securities law, Delta believed she would appreciate the gravity of Defendants’ action and the importance of resolving this dispute without judicial intervention. See Ex. 6 (Copy of Defendant Bivins’ Bar Standing Information).

intellectual property rights. See Ex. 5 (copies of images from Defendants' website dated 02/21/13 showing current Infringing Merchandise for sale).

### **III. STANDARD FOR ISSUANCE OF A PRELIMINARY INJUNCTION**

This Court follows the long-established four part test set out in *Washington Metro. Area Transit Comm'n v. Holiday Tours, Inc.*, 559 F.2d 841, 843 (D.C. 1977) for determining whether to grant a preliminary injunction. The Court is well within its rights to grant a preliminary injunction where the plaintiff has demonstrated:

- (1) A likelihood of success on the merits;
- (2) That the plaintiff would be irreparably harmed in the absence of preliminary injunctive relief;
- (3) That an injunction would not substantially harm other interested parties; and
- (4) That public interest would not be significantly harmed by the granting of an injunction.

*Holiday Tours*, 559 F.2d at 843.

That the issue is protection of intellectual property does not change the standard. *Malarkey-Taylor Assocs. v. Cellular Telecomm. Indus. Assoc.*, 929 F. Supp. 473, 475 (D.D.C. 1996) (trademark infringement case); *Sears, Roebuck & Co. v. Sears Fin. Network, Inc.*, 576 F. Supp. 857 (D.D.C. 1983) (trademark infringement case). In trademark infringement cases, the Court should grant a preliminary injunction when presented with "sufficiently serious questions going to the merits to make them a fair ground for litigation plus a balance of hardships tipping decidedly toward the party requesting the preliminary relief." *Jones v. Ground Zero Entm't.*, No. 05-6461, 2006 U.S. Dist. LEXIS 44364, \*2-3 (S.D.N.Y. June 27, 2006) (quoting *Federal Express Corp. v. Federal Espresso, Inc.*, 201 F.3d 168, 173 (2d Cir. 2000)). As discussed below, Delta satisfies these criteria, and granting a preliminary injunction is appropriate in this case.



## ARGUMENT

### IV. DELTA IS LIKELY TO SUCCEED ON THE MERITS

#### A. **Counts I-IV (Trademark Infringement and Counterfeiting) and Counts VI and VII (Unfair Competition)**

The facts demonstrate that Delta has a strong likelihood of success on the merits on its statutory trademark infringement, trademark counterfeiting, and unfair competition claims. “The Lanham Act was intended to make ‘actionable the deceptive and misleading use of marks’ and ‘to protect persons engaged in . . . commerce against unfair competition.’” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 767 (1992). Delta will demonstrate that it satisfies the prima facie elements of each of its claims for trademark infringement under both federal statutory and common law, and District of Columbia common law.

To prevail on its statutory claim of trademark infringement under federal law, Delta must show: (1) that it owns a valid trademark; (2) that the mark is distinctive *or* has acquired secondary meaning; and (3) that there is a likelihood of confusion. *Sears*, 576 F. Supp. at 861 (emphasis added); *American Ass’n. for the Advancement of Science (AAAS) v. Hearst Corp.*, 498 F. Supp. 244, 254 (D.D.C. 1980).<sup>2</sup>

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<sup>2</sup> As pertinent, Section 32(1) of the Lanham Act provides: (1) Any person who shall, without the consent of the registrant--

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive, shall be liable in a civil action by the registrant for the remedies hereinafter provided. Under subsection (b) hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive.

15 U.S.C. 1141(1).

The elements of a claim for unfair competition are the same as those for common law trademark infringement. *Breaking the Chain Found., Inc. v. Capitol Educ. Support, Inc.*, 589 F. Supp. 2d 25, 29 (D.D.C. 2008) (“claims for common law trademark infringement and unfair competition are evaluated under the same standards”). To prevail on a claim for unfair competition, a plaintiff must show: (1) that it owns a valid trademark; (2) that its trademark is distinctive *or* has acquired a secondary meaning; and (3) that there is a substantial likelihood of confusion between the plaintiff's Mark and the alleged infringer's mark. *Id.*; *See Sears* 576 F. Supp. at 861 (emphasis added). *See also Dart Drug Corp. v. Schering Corp.*, 320 F.2d 745, 750 (D.C. Cir. 1963) (“confusion to the public is the essence of ... unfair competition”).<sup>3</sup>

Further, the overarching concern with respect to common law trademark infringement is identical to that for statutory trademark infringement or for unfair trade practices under Section 43(a) of the federal Lanham Act – likelihood of confusion. *Dr. Seuss Enter., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1403-04 (9th Cir. 1997) (citing 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 23.01[1] (rev. ed. 1994)); *see also Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 157 (1989) (noting that the law of unfair competition has its roots in the common-law concern with protecting consumers from confusion as to source). Finally, the standard for infringement under District of Columbia law

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<sup>3</sup> As pertinent, section 43(a) of the Lanham Act provides:

(a) Civil action.

(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 representation 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 that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125(a).

mirrors that for federal trademark infringement. *Ward One Democrats, Inc. v. Woodland*, 898 A.2d 356, 361 (D.C. 2006) (District of Columbia trademark statutes and applicable case law are modeled after the Lanham Act). Thus, Delta will demonstrate that it is likely to prevail on its common law claims.

Given that the elements of all claims – federal statutory claims, the unfair competition claims, and federal and District of Columbia common law claims – are the same; that the facts relating to all claims are the same; and that the elements of proof for the claims are the same, the claims will be analyzed together.<sup>4</sup>

### **1. Delta Owns the Valid Marks at Issue.**

In this case, there should be no issue with regard to the first element of the *Sears* test. Defendants cannot legitimately challenge that Delta owns valid trademarks of the Marks they are using. As reflected in Section II-A of this Memorandum, Delta has registered certain Marks with the USPTO. *See* Ex. 1 (List of Registered Marks). Registration is *prima facie* evidence of the validity of those Marks. *Malarkey-Taylor Assocs. v. Cellular Telecomm. Indus. Assoc.*, 929 F. Supp. 473 (citing *American Ass'n for Advancement of Science v. Hearst Corp.*, 498 F. Supp. 244, 254 (D.D.C 1980)). In addition, having been established 100 years ago and having used its Marks continuously, Delta has valid common law rights to all of the Marks at issue in this case.<sup>5</sup>

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<sup>4</sup> To establish trademark counterfeiting, Plaintiff must show that Defendants infringed a registered trademark in violation of 15 U.S.C. 1114(1)(1) and that Defendants “intentionally used a mark, knowing such mark is a counterfeit mark.” *Lifted Research Group, Inc., v. Behdad, Inc.*, 591 F. Supp. 2d 3, 7 (D.D.C. 2008). A “counterfeit mark” is “a counterfeit of a mark that is registered on the principal register in the [USPTO] for such goods and services sold, offered for sale, or distributed and that is in use, whether or not the person against whom relief is sought knew such mark was so registered.” 15 U.S.C. § 1116(d)(1)(B). “Counterfeit” refers to “a spurious mark which is identical with, or substantially indistinguishable from, a registered mark.” 15 U.S.C. § 1127. Both Plaintiff’s Sept. 29, 2011 and Oct. 19, 2011 cease and desist letters to Defendants (Ex. 4, Attachments A and B) put Defendants on notice that they were infringing USPTO registered marks. Defendants continued to advertise and sell Infringing Merchandise bearing counterfeit marks after receipt of the letters.

<sup>5</sup> Most of Delta’s Marks have been used continuously since its founding. Delta’s Symbol for Fortitude has been used since at least the 1970s. *See* Ex. 2 (List of Common Law Marks).

## 2. Delta's Marks are Distinctive or Have Acquired a Secondary Meaning.

There should be no issue with regard to the second element of the *Sears* test. “The general rule regarding distinctiveness is clear: an identifying mark is distinctive and capable of being protected if it either (1) is inherently distinctive or (2) has acquired distinctiveness through secondary meaning.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992).<sup>6</sup> This case concerns several Marks that have been registered with the USPTO and some Marks that are protected by common law. In *Malarkey-Taylor Assocs. v. Cellular Telecomm. Indus. Assoc.*, 929 F. Supp. 473, Judge Friedman held that registration of a trademark not only is *prima facie* evidence of the plaintiff's exclusive right to use the mark for the services described in the registration statement, but also *prima facie* evidence that the “mark is distinctive of [the plaintiff's] products in commerce.” *Id.* at 476, (quoting *Hearst*, 498 F. Supp. at 254).

This Court has noted also that, “[s]ince one ground for refusal of registration under 15 U.S.C. § 1052(e) is that a mark is merely descriptive or “weak,” the fact of registration is *prima facie* evidence that a mark is sufficiently distinctive to warrant trademark protection and eliminates the need to prove secondary meaning.” *Hearst*, 498 F. Supp. at 256. In any event, both Delta's registered and unregistered Marks are inherently distinctive because they are symbolic of the Delta sorority, and, therefore, products emblazoned with the Marks are associated with Delta in the eye of the potential consumer. One need look no further than the name and concept of Defendants' website (FratHouse Clothing), and the descriptions of the

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<sup>6</sup> With respect to certain unregistered Marks, it is necessary also that the Marks be non-functional in order to be protected under section 43(a) of the Lanham Act. *Two Pesos*, 505 U.S. at 769. Delta's Marks are not functional in that they are not “essential to the use or purpose of the articles” upon which they are affixed. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995).

items offered on the website, to recognize that Defendants are capitalizing on the targeted consumers' recognition of the Delta sorority, and are banking on potential consumers' association of Defendants' products with Delta in order to peddle successfully their unauthorized wares.

To have secondary meaning, it must be demonstrated that “in the minds of the public, the primary significance [of a Mark] is to identify the source of the product rather than the product itself.” *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, at 211 ( 2000) (quotation omitted). As noted above, the Delta Marks are directly symbolic of the organization itself, and that is the very reason that Defendants are illegally using them.

**3. Defendants' Use of Delta's Marks is Likely to Cause Confusion and Constitutes Infringement.**

For a finding of infringement and unfair competition, the relevant question thus is whether Delta can satisfy the third prong of the *Sears* test – demonstrate that the relevant purchasing public is likely to be confused by the Defendants' use of the mark. Court opinions evaluating claims of likelihood of confusion properly may be analyzed and relied upon whether the claim originates in statutory or common law; the test remains the same. The principle question is whether “an appreciable number of ordinary prudent consumers are likely to be misled, or simply confused, as to the source of the goods in question.” *Sears*, 576 F. Supp. at 861 (citations omitted); *AAAS*, 498 F. Supp. at 258. Plaintiff has alleged sufficient facts to suggest they will.

Defendants sell the same types of merchandise that Delta has authorized its licensed vendors to sell. The goods and the Marks used upon them are substantially the same and/or identical to those offered by Delta's licensed vendors. *See Ex. 4* at 6. In its complaint, Delta also alleges that Defendants sell goods bearing counterfeits of registered marks. Several jurisdictions

have noted, in cases alleging only trademark infringement and in cases alleging both trademark infringement and counterfeiting, that there is a presumption of a likelihood of confusion “[w]here, as here, one produces counterfeit goods in an apparent attempt to capitalize upon the popularity of, and demand for, another’s product.” *Polo Fashions, Inc. v. Crafttex, Inc.*, 816 F.2d 145, 148 (4th Cir.1987) (federal and common law infringement claims). *See also Exercizio v. Roberts*, 944 F.2d 1235, 1243 (6<sup>th</sup> Cir. 1991) (noting, in a case involving unregistered trade dress, that a likelihood of confusion is presumed when a Defendant intentionally copies a trademark of a design with the intent to derive a benefit from the reputation of another); *General Motors Corp. v. Autovation Technologies, Inc.*, 317 F. Supp. 2d 756; 761 (E.D. Mich. 2004) (the “likelihood of confusion is presumed where an identical trademark is intentionally copied by the infringer on competing goods”); *Topps Co., Inc. v. Gerrit J. Verburg Co.*, 41 U.S.P.Q.2d 1412, 1417 (S.D.N.Y.1996) (“Where the marks are identical, and the goods are also identical and directly competitive, the decision [regarding likelihood of confusion] can be made directly without a more formal and complete discussion of all of the *Polaroid* factors.”<sup>7</sup>). While our research uncovered no similar (or contrary) cases from this jurisdiction stating the definitive principle that the likelihood of confusion is presumed where identical trademarks are intentionally copied, we would urge this court to adopt the presumption of confusion in this case of outright copying of marks.

Delta, however, can establish the likelihood of confusion with respect to both its registered and unregistered Marks by applying the facts of this case to the traditional factors for

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<sup>7</sup> In appropriate cases, courts in this jurisdiction have assessed the likelihood of confusion under the analysis set forth in *Polaroid Corp. v. Polarad Electronics Corp.* 287 F.2d 492 (2d Cir. 1961), *cert. denied*, 368 U.S. 820 (1961), where the Second Circuit held that the following factors, among others, are to be evaluated in determining likelihood of confusion: the strength of the plaintiff’s Mark; the degree of similarity between the two marks; the similarity of the products; the likelihood that the owner will bridge the gap between its market or business and the infringer’s market or business; evidence of actual confusion; the defendant’s purpose or reciprocal of good faith in adopting its own mark; the quality of defendant’s product; and the sophistication of the buyers. *Id.* at 495.

determining the likelihood of confusion. The *Sears* court made clear that, “[i]n determining the likelihood of confusion it is not necessary to show actual evidence of confusion.” 576 F. Supp. at 861 (citing *Hearst*, 498 F. Supp. at 258; *James Burrough, Ltd. v. Sign of the Beefeater, Inc.*, 572 F.2d 574, 578 n. 3 (7th Cir.1978)). The *Sears* court assessed likelihood of confusion in that case under four criteria Delta believes are the most appropriate barometers for assessing the likelihood of confusion in this case: (a) the strength of the senior user’s mark (secondary meaning); (b) the degree of similarity between the two marks; (c) the proximity of the products; and (d) the intent of the infringer.<sup>8</sup> Application of the *Sears* test demonstrates that Defendants’ use of Delta’s Marks fosters both confusion as to the source and improper inference of Delta affiliation and sponsorship.

**(a) Delta’s Name and Marks Are Undisputedly Strong.**

Many of Delta’s Marks are registered with the USPTO and therefore are presumptively deserving of protection under the trademark law. Further, as alleged in the complaint, Delta’s family of Marks is indisputably strong and famous. Since its founding in 1913, Delta has been known to its members, other members of the National Pan-Hellenic Council (an umbrella organization of the nine African American Greek letter organizations), educational institutions, and the general public not only by its official name “Delta Sigma Theta Sorority, Incorporated,” but also as “Delta,” “Delta Sigma Theta,” “Delta Sorority,” and “DST.” It also is known and recognized by its Greek letter symbols – “ΔΣΘ.” Any iteration of Delta’s name or its Greek letter symbols is famous and recognized as belonging only to Delta. Delta is similarly identifiable by its signature trade dress color combination of red and white, when used in combination with its founding year.

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<sup>8</sup> *Sears*, 576 F. Supp. at 862. Cases within this Circuit do not consistently analyze all of the *Polaroid* factors. However, Delta is prepared to address all of those factors should this Court wish Delta to address them.

Delta can demonstrate that to prevent dilution it vigorously protects the substantial goodwill and reputation associated with its valuable Marks. Delta prohibits the distribution and sale of merchandise bearing its Marks except through authorized and licensed manufacturers and distributors. Delta receives hundreds of requests from vendors seeking a license to sell products and merchandise imprinted with Delta's name(s) and/or one of its many symbols or Marks. As Delta can demonstrate, it grants a license to only those vendors who meet its strict License requirements. Delta undertakes these rigorous standards to protect the value of and goodwill associated with its name and Marks.

**(b) Defendants Use Marks Identical to Delta's Marks.**

Defendants' use of Marks similar to Delta's Marks is startling; in fact, the Marks are identical. Defendants' use of marks identical to Delta's Marks is apparent from reviewing advertisements of the infringing products on Defendants' Facebook, Twitter, Flickr, and website accounts. Ex. 5. In addition to using Delta's word mark, "Delta Sigma Theta" and its Greek letter logo Mark, "ΔΣΘ," the Defendants also use common law Marks that historically have been used by Delta and associated exclusively with it, including "1913" and the Greek letter "Δ," when used with Delta's color combination. Use of Delta's Marks by Defendants creates the impression that Delta is the source of or has authorized the merchandise, or is otherwise affiliated with Defendants.

**(c) The Infringing Merchandise Produced by Defendants is Strikingly Similar to Legally Produced Merchandise.**

Where the product in question is similar to or competitive with products of the original trademark holder, the likelihood of confusion increases. *Sears*, 576 F. Supp. at 863. That is the case here. Defendants use Delta's Marks on the Infringing Merchandise to produce merchandise similar to that produced by Delta and its licensed vendors. In fact, the similarity of the marks



Defendants illegally use to Delta's registered Marks, and the similarity of the goods bearing the marks to authorized goods, prompt Delta to seek redress for federal trademark counterfeiting. The actual similarity of products is likely to confuse consumers and lead them to believe that Defendants are somehow associated with Delta, or that its merchandise has been approved by Delta.

**(d) Defendants' Intent in Using Delta's Marks is to Cause Confusion and Increase Sales.**

Defendants' actions are deliberately designed with the commercial intent to confuse Delta's membership into presuming Delta sponsorship, a gambit to increase sales among Delta's membership. Clearly, Defendants seek to exploit Delta members' close-knit ties to the sorority in order to sell their products.

Additionally, Defendants have acted in bad faith in proceeding with their use of Delta's Marks despite Delta's demand that Defendants cease and desist their infringing activities. *See, e.g., Partido Revolucionario Dominicano (PRD) Seccional de Metropolitan de Washington DC, Maryland y Virginia v. Partido Revolucionario Dominicano, Seccional de Maryland y Virginia*, 312 F. Supp. 2d 1, 15 (D.D.C. 2004) (intent to infringe and bad faith evidenced by continued use of the infringing mark after receiving a cease and desist request).

It bears repeating that in making a determination as to similarity and likelihood of confusion, courts "consider the general impression as a whole that the mark creates." *Sears*, 576 F. Supp. at 862. The test is whether "the impression which the infringing mark makes upon the consumer is such that he is likely to believe the product is from the same source as the one he knows under the trademark." *Id.* The "probability" that some members of the public might believe that Delta is the source of the product is sufficient to support a claim of likelihood of confusion. *See Id.* ("the probability that some consumers might believe that the two marks

originated from the same source or that some consumers might mistake one mark for the other when seeing or hearing the mark alone” is sufficient).

It also bears repeating that the intent of the infringer is an important factor in determining the likelihood of confusion, if the intent is “wrongful on the part of the defendant[s].” *Sears*, 576 F. Supp. at 862. Where a defendant attempts to trade on a plaintiff’s goodwill by using a mark so similar or identical to the plaintiff’s, its use is wrongful and likely to cause confusion. *Id.* at 863.

**B. Count V (Dilution)**

There is a strong likelihood that Delta will prevail on its dilution claim. The owner of a famous, distinctive mark is entitled to an injunction against the user of a mark that is “likely to cause dilution” by blurring or tarnishing of the famous mark. 15 U.S.C. § 1125(c)(1). In order to establish a case for dilution under § 1125(c), plaintiff must show (1) that it owns a mark which is “distinctive and famous,” (2) that defendant adopted its mark after plaintiff’s became famous, and (3) that defendant’s mark dilutes the famous mark. *The Appleseed Found., Inc., v. Appleseed Inst., Inc.*, 981 F.Supp. 672, 676-677 (D.D.C. 1997) (citing *Clinique Labs, Inc. v. DEP Corp.*, 945 F. Supp. 547, 561 (S.D. N.Y. 1996)). “The dilution can occur either by tarnishment (a junior mark presents shoddy products or services, thereby damaging the reputation of the senior mark), or by “blurring” (the junior use erodes the distinctive, identifying force of the senior mark).” *Appleseed*, 981 F.Supp. at 677 (citing *Mead Data Cent., Inc. v. Toyota Motor Sales, Inc.*, 875 F.2d 1026, 1031 (2d Cir. 1989); *Ringling Bros. v. Utah Div. of Travel*, 955 F. Supp. 605, 613 (E.D. Va. 1997)).

Likelihood of confusion is not an element of a claim for trademark dilution. *Fed'n Internationale de Football Ass'n v. Nike, Inc.*, 285 F. Supp. 2d 64, 72 (D.D.C. 2003) (citing *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003)).<sup>9</sup>

To determine whether a mark is famous, courts examine all relevant factors, including those articulated by Congress:

- (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties;
- (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark;
- (iii) The extent of actual recognition of the mark; and
- (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

15 U.S.C. § 1125(c)(2).

*Duration, extent, geographic reach and publicity of the Marks.* Delta's strong and nationally renowned Marks are sufficiently distinctive and famous to deserve protection. Delta owns, among others, the Marks identified earlier in this Memorandum. Delta has owned most of those Marks for a century. The geographic reach and publicizing of the Marks is worldwide as the Marks appear on Delta's website, which has been in operation for over fifteen (15) years; the Marks are used broadly by Delta's more than 942 chapters, which operate in forty five (45) states and eight (8) foreign countries; and the Marks are advertised and used broadly by Delta's more than one hundred forty (140) licensed vendors who operate throughout the United States.

*The amount, volume, and geographic extent of services offered under the Mark.*

Although the volume of sales of merchandise bearing Delta's Marks is huge, the value of Delta's Marks is measured just as much by the use of the Marks in the services Delta offers. The Marks

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<sup>9</sup> Pursuant to 15 U.S.C. 1125(c)(1), injunctive relief is available against one whose use of a mark is likely to cause dilution by blurring or tarnishment of the famous mark "regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury."

are used by the more than 940 chapters and recognized by the public, including national, state, and local elected officials with whom Delta interacts as it implements its Five Point Programmatic Thrust.<sup>10</sup> As noted earlier and in the accompanying complaint, Delta has entered into strategic partnership with international corporate entities, and its leaders and members regularly interface with a broad spectrum of elected and appointed officials and community leaders. These relationships have served to enhance not only the profile of Delta members, but also that of its Marks, which its members proudly display and use in their daily interactions.

*The extent of actual recognition of the Marks.* As indicated above, Delta's Marks are recognized worldwide. Even a cursory search of the USPTO website reveals that Delta has registered the Marks in question as well as numerous others in numerous categories, including for use on merchandise such as that on which Defendants have imprinted Delta's Marks and sell on their website.

Defendants' wrongful use of Delta's famous Marks is likely to cause dilution of Delta's Marks. As explained in the Complaint, Delta receives hundreds of requests from vendors seeking a license to sell products and merchandise imprinted with Delta's trademarks. Because of the value that is associated with Delta's Marks, Delta grants a license to only those vendors who meet its License requirements. Delta's Vendor Agreement provides that Delta has the right to inspect any merchandise prior to its sale or distribution and has the right to restrict sale or distribution if the merchandise does not conform to Delta's specification.

Using Delta's famous and distinctive Marks, Defendants are offering for sale products of the same type offered by Delta's vendors. Defendants' wrongful use of Delta's famous Marks will diminish the value of these Marks. Furthermore, upon information and belief, Defendants'

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<sup>10</sup> As evidenced by the number of licensed vendors who market Delta's merchandise and the number who regularly appear at Delta sponsored events – such as conventions and conferences.

products are inferior to those offered by Delta's vendors. Defendants' use of Delta's Marks in connection with substandard products is likely to have the effect of tarnishing Delta's Marks and diminishing the goodwill associated therewith. Delta has therefore shown a likelihood of success on the merits of its claim for dilution by tarnishment and dilution by blurring.

**V. DELTA WILL BE IRREPARABLY HARMED BY DEFENDANTS' ACTIVITIES**

In contrast to the lack of harm a preliminary injunction would cause Defendants, discussed fully below, Delta will be irreparably harmed if the court does not grant an injunction. This court has recognized that, "[g]enerally . . . trademark infringement, by [its] very nature, carr[ies] a presumption of harm." *Lifted Research Group*, 591 F. Supp. 2d at 8 (D.D.C. 2008); *Health Ins. Ass'n of America v. Novelli*, 211 F. Supp. 2d 23, 28 (D.D.C. 2002) (quoting *Hart v. Sampley*, Civ. No. A.91-3068, 1992 U.S. Dist. LEXIS 1154, 1992 WL 100135 at \*3 (D.D.C. Feb. 4, 1992)). Moreover, the Court has recognized that a "Defendant's continuing disregard for Plaintiff's rights demonstrates that Defendant will continue to infringe on Plaintiff's rights, absent an injunction. This finding alone entitles Plaintiff to a permanent injunction." *Lifted Research Group*, 591 F.Supp.2d at 8.

Defendants refuse to stop infringing Delta's Marks despite having received three cease-and-desist letters. To prevent irreparable harm to Delta by the dilution of the distinctiveness of its trademark, the loss of control of its Marks and its reputation and the diminishment of its good will, Delta respectfully requests that the Court grant a preliminary injunction to cease Defendants' infringement.

**VI. NO INTERESTED THIRD PARTIES WILL BE HARMED BY A PRELIMINARY INJUNCTION**

Granting Delta's Application for Preliminary Injunction will not harm any interested third parties. The stakeholders in this case are limited to Defendants and Delta. Defendants will

not be harmed by a preliminary injunction because Defendants will be able to continue to operate their business and market their products that do not infringe upon Delta's Marks to the potential purchasing public. Delta does not seek to enjoin all sales of Defendants' products. Delta seeks to halt only infringing use of Delta's Marks. This would entail removing images of products bearing Delta's Marks from Defendants' website, Facebook, Twitter, and Flickr accounts and ceasing the sale of infringing merchandise. This limited requirement of time and funds does not constitute a hardship.

Moreover, any harm that Defendants might claim is mitigated by the fact that they are not authorized to use Delta's Marks. *See PRD*, 312 F. Supp. 2d at 16. "The balance of harms cannot favor a defendant whose injury results from the knowing infringement on the plaintiff's trademark." *Malarkey-Taylor*, 929 F. Supp. at 478. Thus, even if the court were to find that editing a website, Facebook, Twitter, and Flickr accounts and ceasing the sale of infringing products constituted hardship, "hardship" must be balanced against other factors. Those factors include: "(1) the public confusion created by defendants' actions; (2) plaintiff's loss of control over its reputation; and (3) defendants ... intentionally trading off plaintiff's name." *Sears*, 576 F. Supp. at 864. As discussed above, all the relevant criteria favor award of a preliminary injunction, including Defendants' deliberate actions trading on Delta's name, the high likelihood of consumer confusion and resulting harm to Delta's reputation and goodwill.

## **VII. THE PUBLIC INTEREST WOULD NOT BE HARMED BY A PRELIMINARY INJUNCTION**

Granting Delta's request for a preliminary injunction will not harm the public interest, either specifically, based on the facts of the case, or generally, based on the application of law. In fact, the public interest mandates granting an injunction. It is within the public interest to prevent public deception and confusion over the source of public goods. *Sears*, 576 F. Supp. at

865. This is particularly true when issuing an injunction will not stop Defendants from marketing its other products, but would only require cessation of infringing trademark use. *See Malarkey-Taylor*, 929 F. Supp. at 478. Therefore, the injunction should be granted.

### **VIII. CONCLUSION**

Defendants have deliberately used Delta's valid, distinctive Marks on its products in a manner that is likely to cause consumer confusion. Printouts from Defendants' website, Facebook, Twitter, and Flickr accounts, attached at Exhibit 5, clearly represent unlicensed and unauthorized use by Defendants of Delta's registered Marks ("Delta Sigma Theta" and its Greek letter symbols "ΔΣΘ") and its common law Marks on Infringing Merchandise. Defendants also use Delta's color combination, red and white in ways that imply affiliation with Delta, further fostering confusion. Moreover, Defendants have willfully and knowingly acted, in bad faith, initially refusing to communicate with Delta after Delta put them on notice of their infringement, and later acknowledging receipt of Delta's communications, but still refusing to cease and desist their unlawful use of Delta's Marks.

For the above reasons Delta respectfully requests that the court grant its Application for a Preliminary Injunction.

Respectfully Submitted,

/s/ Devarieste Curry

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