



UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF NEW YORK

CAR-FRESHNER CORPORATION and  
JULIUS SÄMANN LTD.,

Plaintiffs,

v.

D & J DISTRIBUTING AND  
MANUFACTURING INC. d/b/a  
EXOTICA FRESHENERS CO.,

Defendant.

)  
)  
) Civil Action No:

) 7:11-cv-00617-NAM-ATB

)  
) CONSENT JUDGMENT

IT IS HEREBY STIPULATED and agreed, by and among the undersigned parties, that:

1. This is an action for (a) federal trademark infringement, (b) federal false designation of origin, (c) common law trademark infringement, and (d) common law unfair competition.
2. The Court has jurisdiction over the subject matter of this action and over the parties. Venue is proper in this Court.
3. Plaintiff, CAR-FRESHNER CORPORATION ("CFC"), is a Delaware corporation with its principal place of business at 21205 Little Tree Drive, Watertown, New York 13601-0719.
4. Plaintiff, JULIUS SÄMANN LTD. ("JSL"), is a Bermuda corporation with a place of business at Victoria Place, 31 Victoria Street, Hamilton HM 10, Bermuda.
5. CFC and its predecessors have manufactured and sold air fresheners for over 60 years. The air fresheners are sold through many channels of trade including to gas stations, car washes, automotive, food, drug and department stores as well as through the Internet. The trademarks under which the air fresheners are sold are owned and licensed by JSL.

6. CFC's and JSL's air fresheners have various fragrances, of which two are identified by the unique trademarks BLACK ICE and ICE BLUE. Since at least as early as 2004, directly and/or by license from JSL, CFC has manufactured and marketed air fresheners under the mark BLACK ICE, as shown below:



7. JSL owns U.S. Registration No. 3,126,834 for the mark BLACK ICE for air fresheners. The registration is valid, subsisting and incontestable.

8. BLACK ICE currently is the most popular air freshener fragrance sold by CFC.

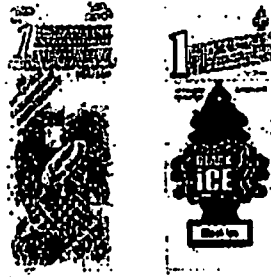
9. Since at least as early as 1996, CFC directly, through predecessors in interest and/or by license from JSL, has manufactured and marketed air fresheners under the mark ICE BLUE, as shown below:



10. Defendant, D & J DISTRIBUTING AND MANUFACTURING INC. d/b/a EXOTICA FRESHENERS CO. ("Exotica"), is an Ohio corporation with a place of business at 1302 Holloway Road, Holland, Ohio 43528.

11. Exotica manufactures, promotes, sells and distributes air fresheners.

12. In or about 2007, Exotica used the mark **BLACK ICE**, and the packaging shown immediately below, which mimicked the packaging being used by Plaintiffs at that time.



13. In the spring of 2007, CFC and JSL wrote to Exotica demanding that use of **BLACK ICE** be discontinued. By the summer of 2007, Exotica's infringing **BLACK ICE** air fresheners did not appear to be in the marketplace.

14. On December 9, 2009, Exotica filed Application Serial No. 77/889,308 to register the mark **ICEE BLACK** for air fresheners with the U.S. Patent and Trademark Office ("USPTO"). The USPTO refused registration of Exotica's **ICEE BLACK** mark based on likelihood of confusion with JSL's registered **BLACK ICE** mark. This application was deemed abandoned the USPTO on February 21, 2012.

15. On December 2, 2010, Exotica filed Application Serial No. 85/189,556 to register the mark **ICEY BLACK** for air fresheners with the USPTO. On June 6, 2011, JSL opposed registration of Exotica's **ICEY BLACK** mark and the Trademark Trial and Appeal Board (the "Board") sustained JSL's opposition, refusing registration of the **ICEY BLACK** mark.

16. Exotica's adoption and/or use of the marks **BLACK ICE**, **ICEE BLACK** and **ICEY BLACK** for air fresheners was with knowledge of Plaintiffs' **BLACK ICE** mark.

17. CFC and JSL have no control as to the quality or commercial use of the air

fresheners that Exotica adopted for use and/or used in connection with the marks BLACK ICE, ICEE BLACK and/or ICEY BLACK.

18. The complained of activities of Exotica have irreparably harmed and are continuing to damage CFC and JSL, and will continue unless enjoined by this Court.

BASED ON THE FOREGOING, THE COURT FINDS, ORDERS, ADJUDGES AND DECREES AS FOLLOWS:

A. The trademarks BLACK ICE and ICE BLUE for air fresheners are valid, subsisting, enforceable and owned by Plaintiff JSL.

B. Exotica infringed CFC's and JSL's BLACK ICE trademark by promoting and selling air fresheners that included the terms "BLACK ICE," "ICEY BLACK" and "ICEE BLACK", and by applying for trademark registrations for the marks "ICEY BLACK" and "ICEE BLACK".

C. Exotica, including its directors, officers, employees, agents, affiliated or otherwise related companies, suppliers, customers and their successors and assigns, and all persons and companies otherwise acting in concert with Exotica, are hereby permanently enjoined from violating Plaintiffs' BLACK ICE and ICE BLUE marks, the trade dress associated therewith and from adopting or using any colorable imitation(s) thereof, and from procuring, manufacturing, advertising, distributing, licensing and/or selling air fresheners or other merchandise associated therewith, and from any other acts of trademark infringement, false designation of origin and unfair competition with respect to Plaintiffs' air fresheners and associated intellectual property.

D. Exotica, and all persons and companies described immediately above, are hereby further enjoined from engaging in activities intended to induce the belief that its products are authorized, sponsored, approved or licensed by, or related to, JSL or CFC.

E. Exotica, and all persons and companies described above, are hereby additionally enjoined from applying to register with the USPTO, with any other agency of the United States, or with any state or territory of the United States, the marks BLACK ICE, ICEY BLACK, ICEE BLACK, or any other name or mark confusingly similar to either of Plaintiffs' marks BLACK ICE or ICE BLUE.

F. Within five (5) business days from the entry of this Consent Judgment, Exotica will deliver to CFC by wire transfer, or by a certified or bank check, the sum of \$35,000.

G. Within five (5) business days from the entry of this Consent Judgment, Exotica will deliver to CFC its inventory of air fresheners incorporating any of the names or marks BLACK ICE, ICEE BLACK, or ICEY BLACK, freight prepaid.


H. If Exotica breaches the terms of this Consent Judgment, Exotica will pay to CFC \$10,000 per breach, \$1.00 for each unit manufactured, procured, distributed and/or sold, as well as all attorney fees and costs associated with any action required to enforce the terms of this Consent Judgment.

I. The parties herein waive their right to appeal from the entry of this Consent Judgment.

J. Except as provided above, all parties shall bear their own costs, expenses and counsel fees.

K. The Court shall retain jurisdiction over this matter and the parties for the purpose of potential future enforcement of this Consent Judgment.

SO ORDERED, this \_\_\_\_ day of \_\_\_\_\_, 2012

  
NORMAN A. MORDUE  
UNITED STATES DISTRICT CHIEF JUDGE

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, L.L.P.

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and JULIUS SÄMANN LTD.

Dated: 5/10/12

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EXOTICA FRESHENERS CO.

Dated: 5/10/12

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By: John E. Ellassir  
Name: Oussama ("John") Ellassir  
Title: President  
Date: 5-9-12