

Case 1:09-cv-00593-DC Document 10 Filed 08/14/09 Page 1 of 5

USDC SDNY
DOCUMENT
ELECTRONICALLY FILED
DOC #:
DATE FILED: 08/14/09

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

MAJOR LEAGUE BASEBALL PROPERTIES,
INC.,

Plaintiff,

-against-

DONRUSS PLAYOFF, L.P. and DONRUSS LLC,

Defendants.

09 Civ. 593 (DC)

**FINAL JUDGMENT
ON CONSENT**

WHEREAS, Plaintiff Major League Baseball Properties, Inc. ("MLBP") is a licensee of and acts as licensing agent for each of the 30 Major League Baseball clubs (each referred to herein individually as an "MLB Club" and collectively as the "MLB Clubs"), the Office of the Commissioner of Baseball (the "BOC") and their respective affiliated and related entities (collectively, the "MLB Entities"), and represents and warrants that it also acts as licensing agent for the National Association of Professional Baseball Leagues, Inc. d/b/a Minor League Baseball ("Minor League Baseball"), its member leagues and member clubs and their respective affiliated and related entities (the "Minor League Baseball Entities"); and

WHEREAS, included among the intellectual property licensed and enforced by MLBP on behalf of itself and the other MLB Entities are its trademarks, service marks and trade name and the trademark names owned and used by and under which each of the MLB Clubs competes, along with a variety of other names, trademarks, service marks, logos, designs and trade dresses owned and used by the MLB Clubs (all referred to collectively herein as the "MLB Marks"), including, without limitation, the unique and inherently distinctive color combinations, striping, uniform designs and/or positioning of the Club names, logos and other elements (such as geographic designations) used on the MLB Clubs' uniforms (sometimes referred to herein

separately as the "MLB Uniform Trade Dress"); and

WHEREAS, as a result of the substantial use, marketing and promotion of the MLB Marks for many years in connection with baseball-related services and as part of an extensive licensing program on a wide variety of goods and services relating to and promoting the MLB Clubs, the MLB Marks have become associated by fans, consumers and the trade, press, media and public with the MLB Entities and have developed considerable and valuable goodwill of great value to the MLB Entities; and

WHEREAS, MLBP represents and warrants that included among the intellectual property licensed and enforced by MLBP on behalf of the Minor League Baseball Entities are the various names, trademarks, service marks, logos, designs and trade dresses, including uniform designs, of the Minor League Baseball Entities (collectively, the "Minor League Baseball Marks"); and

WHEREAS, by virtue of the long and extensive use, marketing and promotion of the Minor League Baseball Marks, including without limitation, the substantial sales of authorized goods and services bearing such marks, the Minor League Baseball Marks have become associated by fans, consumers and the trade, press, media and public with Minor League Baseball and have developed considerable and valuable goodwill of great value to the Minor League Baseball Entities; and

WHEREAS, MLBP represents and warrants that pursuant to its agency agreement with the Minor League Baseball Entities, MLBP also is responsible for enforcement of the names and likenesses of the Minor League Baseball players (the "Minor League Baseball Players Images"), which rights are exclusively controlled by the MLB Club to whom they are under contract and the Minor League clubs to which they are assigned to play; and

WHEREAS, Defendant Donruss Playoff, L.P. and its general partner, Defendant Donruss

LLC (collectively "Donruss") were previously in the business of designing, selling and distributing sports trading cards throughout the United States; and

WHEREAS, Donruss was previously party to two license agreements with MLB (the "Donruss License Agreements") pursuant to which MLB granted Donruss the right to produce trading card sets bearing the MLB Marks and featuring Major League Baseball players in the MLB Uniform Trade Dress during a term that expired on December 31, 2005 (with a two month sell-off period expiring on February 28, 2006); and

WHEREAS, in provisions surviving the expiration of the term of the Donruss License Agreements, Donruss acknowledged the proprietary nature and the MLB Entities' ownership of the MLB Marks, and agreed not to make any use of the MLB Marks or derivatives thereof without the prior written consent of MLB; and

WHEREAS, beginning in 2008, without MLB's consent, Donruss created and commenced distributing trading card sets containing images of former Major League Baseball players and current Minor League Baseball players depicted in uniform; and

WHEREAS, MLB commenced the present action (the "Action") on or about January 21, 2009, asserting claims for breach of contract, false designation of origin and trademark dilution under the Lanham Trademark Act, 15 U.S.C. § § 1125 (a), (c), unfair competition, common law trademark infringement and violations of New York General Business Law § 360-1 and New York Civil Rights Law § § 50, 51; and

WHEREAS, MLB and Donruss have agreed to resolve the claims asserted by MLB in the Action pursuant to the terms of this Final Judgment on Consent.

NOW, THEREFORE, upon the consent of MLB and Donruss, it is hereby ORDERED, ADJUDGED AND DECREED as follows:

1. Donruss and any of its subsidiaries or commonly owned entities, and any entities or businesses that in the future may be owned in whole or substantially in part or directly controlled by Ann Powell (collectively, the "Donruss Entities"), are hereby permanently enjoined from manufacturing, selling, distributing, advertising or promoting any items depicting Major League Baseball players or Minor League Baseball players in uniform, or with MLB Marks, MLB Uniform Trade Dress, Minor League Baseball Marks or any component of any of them, including, but not limited to, caps, helmets, jerseys, pants, jackets and catchers' equipment. For the avoidance of doubt, the foregoing shall preclude all such individuals and entities from, among other things, using any images, pictures, posters, photographs, caricatures, depictions or likenesses that feature a component of a Major League Baseball or Minor League Baseball uniform that is airbrushed, intentionally blocks or covers, or otherwise alters, any of the MLB Marks, MLB Uniform Trade Dress and Minor League Baseball Marks.

2. The Donruss Entities are hereby permanently enjoined from using the Minor League Baseball Player Images on or in connection with any goods or services.

3. Donruss represents that all merchandise, signs, point of purchase displays and materials, boxes, packaging, wrappings, catalogs, decals, flyers, brochures, or other goods or printed matter or advertising or promotional materials bearing the MLB Marks, including without limitation the MLB Uniform Trade Dress, the Minor League Baseball Marks, or any derivative or confusingly similar versions or colorable imitations of the foregoing marks, or the Minor League Baseball Players Images previously has been sold or disposed of.

4. Donruss agrees that it will not oppose, attempt to oppose, cancel, attempt to cancel, object to or otherwise interfere with the use and/or registration of the MLB Marks, MLB Uniform Trade Dress and Minor League Baseball Marks by the MLB Entities and/or Minor

League Baseball Entities.

5. Any breach by Donruss of the terms of this Final Judgment on Consent shall be deemed to constitute immediate and irreparable injury to MLB and the respective MLB Entities and/or Minor League Baseball Entities.

6. The Court shall retain continuing jurisdiction over the parties and the subject matter of the Action for the purposes of interpreting and enforcing the terms of this Final Judgment on Consent.

7. All of the parties hereby waive their right to appeal from or otherwise contest this Final Judgment on Consent, which may be entered without further notice to any party.

8. Each party shall bear its own costs and expenses of this Action.

SO ORDERED this 14th
day of Aug. 2009


U.S.D.J.

The parties hereby consent to the form and entry of this Final Judgment on Consent:

COWAN, LIEBOWITZ & LATMAN, P.C.

By: 

Richard S. Mandel (RM-4884)

1133 Avenue of the Americas
New York, New York 10036-6799
(212) 790-9200

Attorneys for Plaintiff
Major League Baseball Properties, Inc.

COOPER & DUNHAM LLP

By: 

Eric D. Kirsch (EK-3714)

30 Rockefeller Plaza
New York, New York 10112
(212) 278-0400

Attorneys for Defendants
Donruss Playoff, L.P. and Donruss LLC