

ESTTA Tracking number: **ESTTA351089**

Filing date: **06/04/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding.	91194736
Applicant	Defendant Malden International Designs, Inc.
Other Party	Plaintiff Fetco Home Decor, Inc.

Motion for Suspension in View of Civil Proceeding With Consent

The parties are engaged in a civil action which may have a bearing on this proceeding. Accordingly, Malden International Designs, Inc. hereby requests suspension of this proceeding pending a final determination of the civil action. Trademark Rule 2.117.

Malden International Designs, Inc. has secured the express consent of all other parties to this proceeding for the suspension and resetting of dates requested herein.

Malden International Designs, Inc. has provided an e-mail address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Respectfully submitted,
/Edward F. Perlman/
Edward F. Perlman
eperlman@wolfgreenfield.com, hkeeton@wolfgreenfield.com
jwelch@ll-a.com, nharris@ll-a.com, ahammitte@ll-a.com
06/04/2010

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

_____)	
FETCO HOME DECOR, INC.,)	
)	
Plaintiff,)	
)	
v.)	Civil Action No.
)	
MALDEN INTERNATIONAL DESIGNS,)	
INC,)	
)	
Defendant.)	
_____)	

COMPLAINT

Plaintiff FETCO HOME DECOR, INC., by its undersigned attorneys, by way of Complaint herein, alleges as follows:

THE PARTIES

1. Plaintiff FETCO HOME DECOR, INC. is a Massachusetts corporation having a place of business at 84 Teed Drive, Randolph, Massachusetts 02368.

2. On information and belief, Defendant MALDEN INTERNATIONAL DESIGNS, INC., is a Massachusetts corporation having a place of business at 20 Kendrick Road, Wareham, Massachusetts 02571.

JURISDICTION AND VENUE

3. This court has subject matter jurisdiction over this action pursuant to 28 U.S.C. §§ 1338(a) and (b), and pursuant to the doctrine of supplemental jurisdiction as codified in Title 28 U.S.C. § 1367.

4. Venue is proper in this judicial district pursuant to 28 U.S.C. § 1391(b) and (c).

COUNT I - VIOLATION OF LANHAM ACT SECTION 43(a)

5. Plaintiff is, and has been for many years, engaged in the business of designing and distributing photograph frames and related home decor items to department and specialty stores in the United States. Among its products are wood picture frames.

6. In early 2008, Plaintiff began marketing and distributing a line of wood picture frames under the trademark ECO WOODS! See Exhibit 1 hereto. These ECO WOODS! brand frames have continually been offered in an inherently distinctive trade dress comprising a light brown cardboard package with printed text in green and brown inks, as shown in Exhibit 2 hereto.

7. The term ECO WOODS! and the afore-described unique packaging trade dress serve as source indicators for Plaintiff's picture frames sold under that mark in that packaging.

8. On information and belief, in 2009 Defendant began offering for sale and distributing to department and specialty stores in the United States, a line of picture frames under the mark ECO-WOODS, which frames are striking similar to the frames sold by Plaintiff under its ECO WOODS! mark, and which frames are packaged in light brown cardboard packaging having text printed in green and brown inks, comprising a trade dress that is virtually identical to the trade dress of Plaintiff. A photocopy displaying one of Defendant's ECO-WOODS frames in its packaging appears in Exhibit 2, next to one of Plaintiff's frames in its packaging.

9. Defendant's use of the mark ECO-WOODS and its sale of picture frames in virtually identical trade dress to that of Plaintiff is likely to cause confusion, mistake, and deception as to the source of Defendant's goods. Customers and potential customers are likely to believe that Defendant's goods emanate from, or are licensed or approved by Plaintiff, when that is not the case. Any dissatisfaction with Defendant's ECO-WOODS brand picture frames may be falsely attributed to Plaintiff, thereby damaging irreparably Plaintiff's valuable reputation and goodwill vis-à-vis the mark ECO-WOODS! and its inherently distinctive packaging trade dress.

10. On information and belief, the aforesaid actions of Defendant were undertaken in a willful and deliberate attempt to trade on the reputation and goodwill of Plaintiff associated with its ECO WOODS! mark and trade dress.

10. The aforesaid actions of Defendant constitute false designations of origin and false representations in violation of 15 U.S.C. Sec. 1125(a). Unless permanently enjoined by this court, the acts of Defendant will cause irreparable injury and damage to Plaintiff and its trademark mark rights, for which damage and injury there exists no adequate remedy at law.

COUNT II - VIOLATION OF CHAPTER 110H, M.G.L.

11 Plaintiff repeats and re-alleges the averments set forth in paragraphs 1-10 above.

12. Plaintiff is the owner of Massachusetts Registration No. 71928 for the mark ECO WOODS! for picture frames.

13. The aforesaid actions of Defendant constitute a willful and deliberate infringement of Plaintiff's registered trademark ECO WOODS!, in violation of Section 110H of the Massachusetts General

Laws, for which Plaintiff is entitled to monetary and injunctive relief.

COUNT III - VIOLATION OF CHAPTER 93A, M.G.L.

14 Plaintiff repeats and re-alleges the averments set forth in paragraphs 1-13 above.

15. Defendant is engaged in the conduct of trade or commerce within the meaning of Ch. 93A of the Massachusetts General Laws.

16. Defendant's acts occurred primarily and substantially within the Commonwealth of Massachusetts.

17. Defendant's use of the mark ECO-WOODS for pictures frames, and its use substantially identical trade dress to that of Plaintiff, constitute unfair methods of competition and unfair or deceptive acts or practices in the conduct of trade or commerce, in violation of Ch. 93A, Sec. 2, of the Massachusetts General Laws.

18. Plaintiff has been and is being damaged by said acts of Defendant.

COUNT IV - COMMON LAW TRADEMARK INFRINGEMENT
AND UNFAIR COMPETITION

19. Plaintiff repeats and re-alleges the averments set forth in paragraphs 1-18 above.

20. Plaintiff's mark ECO WOODS! and its unique packaging trade dress are each distinctive of Plaintiff's goods, and the public has come to recognize the mark ECO WOODS! and the trade dress as identifying Plaintiff as the source of the picture frames sold in connection therewith.

21. Defendant's aforesaid actions is bound to cause confusion, mistake, and deception of the relevant public as to whether Defendant's goods emanate from, or are licensed or approved by, Plaintiff.

22. The conduct of Defendant complained of herein constitutes common law trademark infringement and unfair competition, all of which has damaged and will continue to damage irreparably Plaintiff's valuable goodwill unless enjoined by this court.

* * * * *

WHEREFORE, Plaintiff FETCO HOME DECOR, INC. demands judgment against Defendant MALDEN INTERNATIONAL DESIGNS, INC., as follows:

A. That Defendant MALDEN INTERNATIONAL DESIGNS, INC. be preliminarily and permanently enjoined from using the mark ECO-WOODS, and any similar variation thereof, in connection with picture frames.

B. That Defendant MALDEN INTERNATIONAL DESIGNS, INC. be preliminarily and permanently enjoined from marketing picture frames in trade dress confusingly similar to the trade dress of Plaintiff's ECO WOODS! line of picture frames, or any confusingly similar variation thereof.

C. That Defendant be required pursuant to 15 U.S.C. Sec. 1118 to deliver up for destruction any and all materials that include the mark or name ECO-WOODS and/or the infringing trade dress.

D. That Defendant be directed to file with this court and to serve upon Plaintiff within thirty days of service of the permanent injunction requested herein, a report in writing under oath, setting forth in detail the manner and form in which Defendant has complied therewith.

E. That Defendant pay to Plaintiff such damages as Plaintiff has incurred by reason of the actions complained of herein, and that said damages be tripled in light of the willfulness of Defendant's actions.

F. That Plaintiff recover its costs in this action, as well as its reasonable attorney fees and expenses.

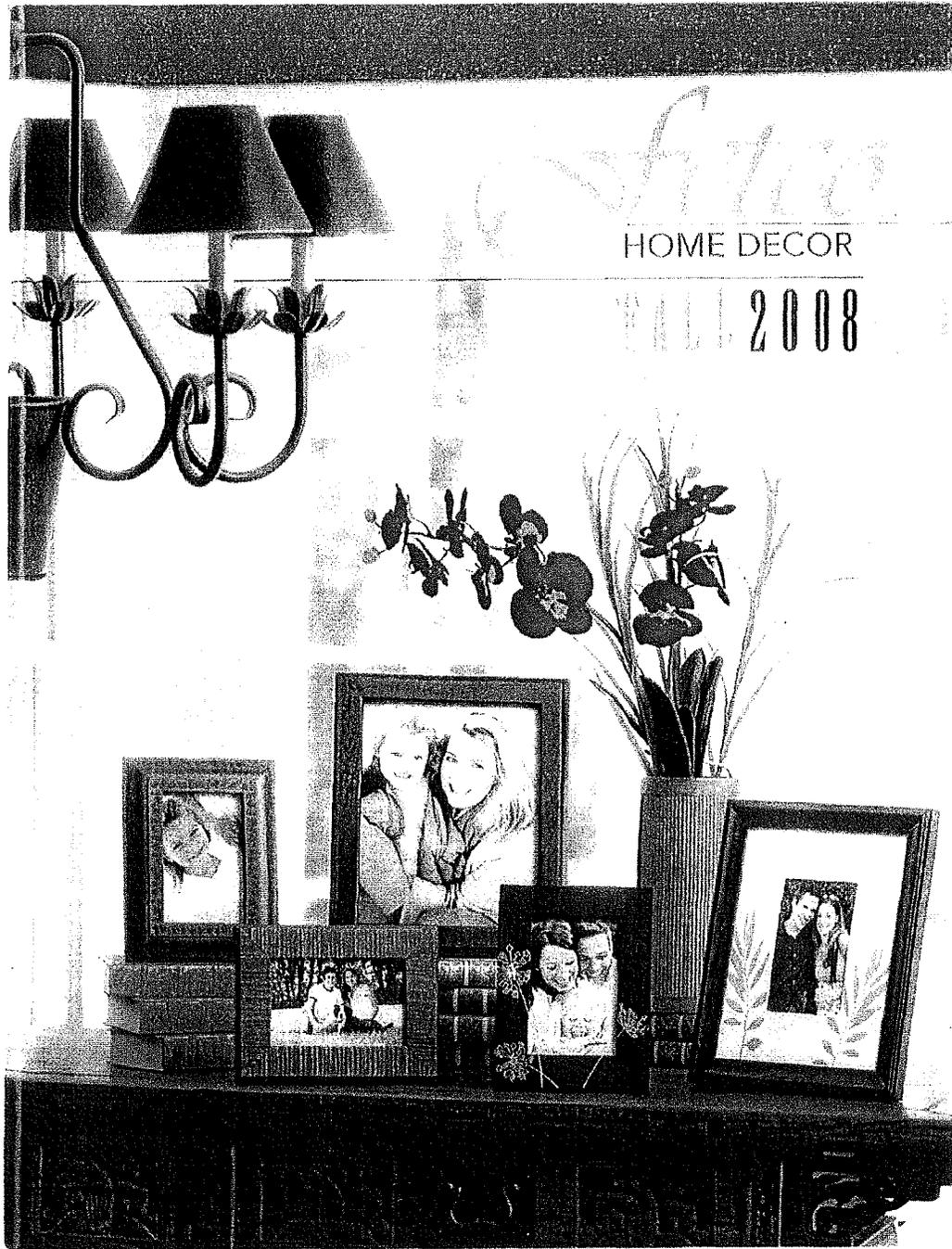
G. That this court grant such other order and further relief as it deems just and proper.

FETCO HOME DECOR, INC.

/s/ John L. Welch

John L. Welch BBO No. 522040
Ann Lamport Hammitte BBO No. 553263
LANDO & ANASTASI, LLP
One Main Street, Eleventh Floor
Cambridge, MA 02142
617/395-7000 (tel.)
617/395-7070 (fax)
emailservice@LL-A.com

EXHIBIT 1



Feteo Home Decor Eco Woods!

A

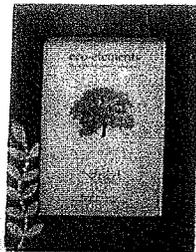


A Queen Anne's Lace - Espresso
F736946 4x6



B Ashland - Walnut
F750746 4x6

C



C Chandler - Mahogany w/Natural
F741257 5x7

D



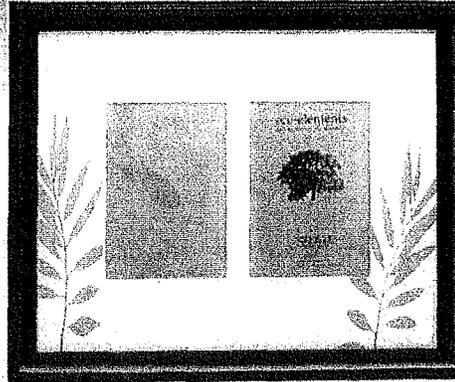
D Sadona - Two Tone Mahogany
F715646 4x6
F715657 5x7
F715680 8x10

Petco Home Decor *Eco Woods!*



F

F. Marquette - Linen Matted Fern - Espresso
F607046 8x10/4x6



G

G. Marquette - Linen Matted Fern - Espresso
F607057D 5x7 Double Wall Frame



H

H. Jackson - Walnut
F745057 5x7

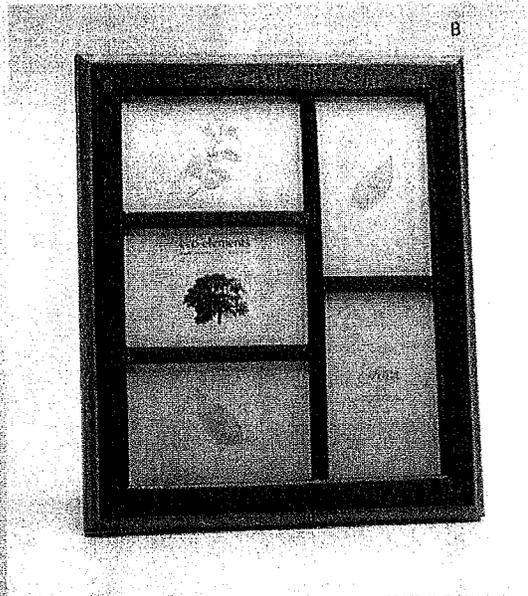
Petco Home Decor
Eco Woods!



A. Atwood - Walnut, Green and Gray
F741957 14x7

A

B. Sedona Cottage - Two Tone Mahogany
F715685C 10x12.5 Opening Cottage

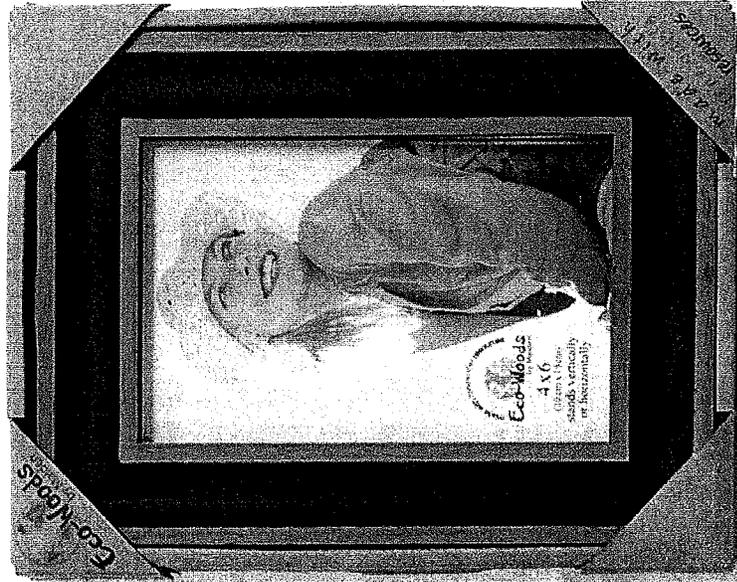


B

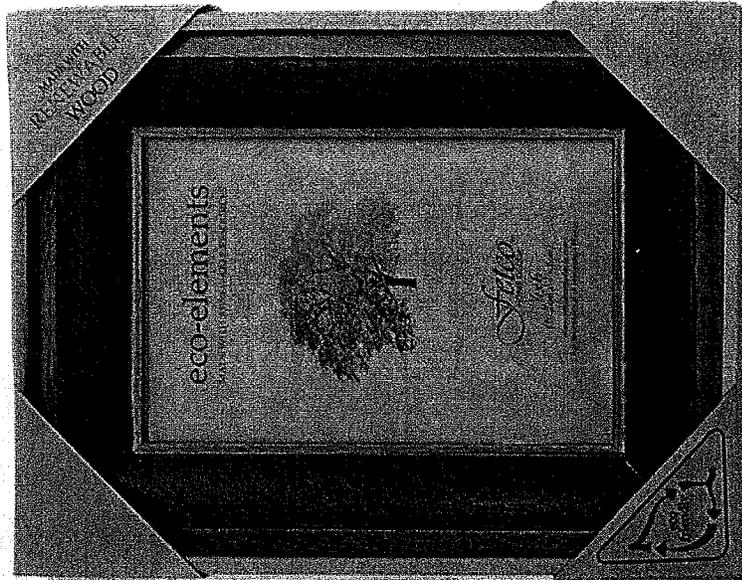


EXHIBIT 2

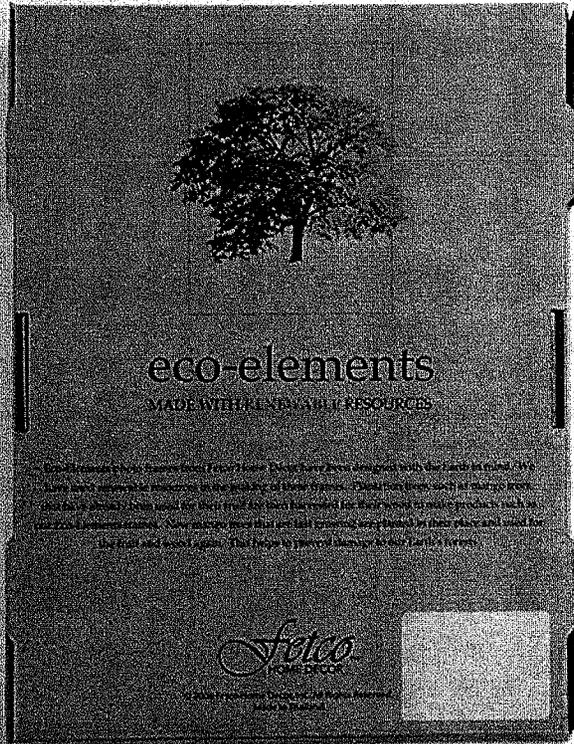
Malden



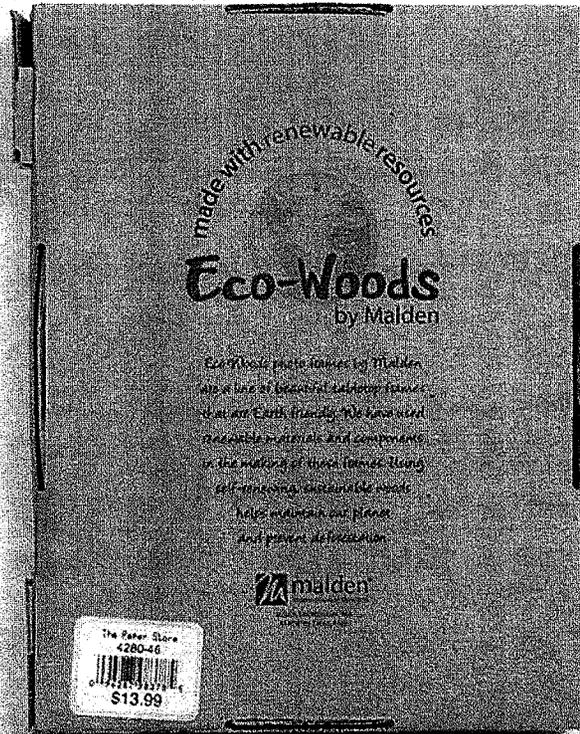
Fetco



Fetco



Malden



**UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS**

FETCO HOME DÉCOR, INC.,)	
)	
Plaintiff,)	
)	
v.)	Civil Action No.
)	1: 09-CV-11925-JLT
MALDEN INTERNATIONAL DESIGNS, INC.)	
)	
Defendant.)	
)	

DEFENDANT’S ANSWER TO COMPLAINT

Defendant, Malden International Designs Inc. (“Malden” or “Defendant”), by its attorneys, submits the following answer to the Complaint of Fetco Home Décor, Inc. (“Fetco” or “Plaintiff”):

1. Malden admits the factual allegations contained in Paragraph 1 of Plaintiff’s Complaint.
2. Malden admits that it is a Massachusetts corporation having a new place of business at 19 Cowan Drive, Middleboro, Massachusetts, 02346.
3. Paragraph 3 does not contain factual allegations that admit of a responsive pleading.
4. Paragraph 4 does not contain factual allegations that admit of a responsive pleading.

Count I: Violation of Lanham Act, Section 43(a)

5. Malden is without sufficient information or knowledge to form a belief as to the truth of the factual allegations asserted in Paragraph 5 of Plaintiff’s Complaint and, therefore, denies the same.
6. Malden is without sufficient information or knowledge to form a belief as to the truth of the factual allegations asserted in Paragraph 6 of Plaintiff’s Complaint and, therefore, denies the same.
7. Malden denies the factual allegations contained in Paragraph 7 of Plaintiff’s Complaint.

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8. Malden denies the factual allegations contained in Paragraph 8 of the Plaintiff's Complaint, but admits that the frame shown under the name "Malden" in Exhibit 2 of the Complaint is one of the Defendant's frames.

9. Malden denies the factual allegations contained in Paragraph 9 of Plaintiff's Complaint.

10. Malden denies the factual allegations contained in Paragraph 10 of Plaintiff's Complaint.

10.(repeated) Malden denies the factual allegations contained in Paragraph 10 (repeated) of Plaintiff's Complaint.

Count II: Violation of Chapter 110H, M.G.L.

11. Malden hereby repeats and incorporates herein by reference each and every response to the allegations of Paragraphs 1-11 of Plaintiff's Complaint.

12. Malden is without knowledge or information sufficient to form a belief as to the factual allegations contained in Paragraph 12 of the Plaintiff's Complaint, and therefore denies the same.

13. Malden denies the factual allegations contained in Paragraph 13 of Plaintiff's Complaint.

Count III: Violation of Chapter 93A, M.G.L.

14. Malden hereby repeats and incorporates herein by reference each and every response to the allegations of Paragraphs 1-13 of Plaintiff's Complaint.

15. Paragraph 15 does not contain factual allegations that admit of a responsive pleading.

16. Malden denies the factual allegations contained in Paragraph 16 of Plaintiff's Complaint.

17. Malden denies the factual allegations contained in Paragraph 17 of Plaintiff's Complaint.

18. Malden denies the factual allegations contained in Paragraph 18 of Plaintiff's Complaint.

Count IV: Common Law Trademark Infringement and Unfair Competition

19. Malden hereby repeats and incorporates herein by reference each and every response to the allegations of Paragraphs 1-18 of Plaintiff's Complaint.

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20. Malden denies the factual allegations contained in Paragraph 20 of Plaintiff's Complaint.

21. Malden denies the factual allegations contained in Paragraph 21 of Plaintiffs' Complaint.

22. Malden denies the factual allegations contained in Paragraph 22 of Plaintiffs' Complaint.

23. Malden asserts that the remaining Paragraphs of the Plaintiff's Complaint do not contain factual allegations that admit of a responsive pleading.

By: /s/ Edward F. Perlman
Edward F. Perlman (BBO #394900)
eperlman@wolfgreenfield.com
Wolf, Greenfield & Sacks, P.C.
Federal Reserve Plaza
600 Atlantic Avenue
Boston, Massachusetts 02210-2206
Attorney for Defendant

Date: January 11, 2010

Attorney Docket No: A0496.50000US00

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing document filed through the ECF system will be sent electronically to the registered participants as identified on the Notice of Electronic Filing (NEF) and that on January 11, 2010, I served a copy of the Answer on counsel the Plaintiff, FETCO HOME DÉCOR, INC., via first-class mail, postage-prepaid, addressed to:

John L. Welch
Ann Lamport Hammitte
LANDO & ANASTASI, LLP
One Main Street, Eleventh Floor
Cambridge, MA 02142

/s/ Edward F. Perlman
Edward F. Perlman
Wolf, Greenfield & Sacks, P.C.
Federal Reserve Plaza
600 Atlantic Avenue
Boston, Massachusetts 02210-2206
Tel.: (617) 646-8207

Date: January 11, 2010
Attorney Docket No: A0496.50000US00

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

FETCO HOME DECOR, INC.,

Plaintiff,

v.

MALDEN INTERNATIONAL
DESIGNS, INC.

Defendant.

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Civil Action No. 09-11925-JLT

ORDER

May 4, 2010

TAURO, J.

After a Scheduling Conference held on May 4, 2010, this court hereby orders that:

1. Plaintiff may conduct the following depositions: (1) a Rule 30(b)(6) representative of Defendant Malden International Designs, Inc., and (2) Mike Wluka, Defendant's Vice President of Sales.
2. Defendant may conduct the following depositions: (1) a Rule 30(b)(6) representative of Plaintiff Fetco Home Decor, Inc.; (2) Michael Ricciarelli; and (3) Nancy Babine Kucinski.
3. The Parties are permitted to exchange expert reports.
4. Authorized discovery, listed above, shall be completed by December 31, 2010.
5. No further discovery is permitted without leave of this court.

6. A Final Pre-Trial Conference is scheduled for January 4, 2011 at 10:30 a.m.

IT IS SO ORDERED.

/s/ Joseph L. Tauro
United States District Judge