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

Proceeding	91197669
Party	Plaintiff TYR Sport, Inc.
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Submission	Response to Board Order/Inquiry
Filer's Name	Donna A. Rubelmann, Esq.
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Signature	/dar/
Date	10/31/2013
Attachments	Motion to Reactivate Proceedings and Declaration.pdf(563623 bytes)

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

TYR SPORT, INC.)	
)	Opposition No. 91197669 (Parent Case)
Opposer,)	
)	Opposition No. 91197670
v.)	
)	
MARC DUSHEY)	
)	
Applicant.)	
_____)	

MOTION TO REACTIVATE PROCEEDINGS

On October 11, 2012 these two opposition proceedings were suspended based upon the motion of the applicant Marc Dushey (“Applicant”) pending the resolution of a civil action then pending before the United States District Court for the District of Connecticut. The action was captioned *Tyr Sport, Inc. v. Tyr Natural Spring Water, Inc., Manhattan Water Company, Inc., Marc Dushey and Coffee Distributing Corp.*, 3:12CV761 (SRU).

In that civil action, the judge entered the following against the Applicant Marc Dushey: (1) Default Judgment, (2) Injunction Order, and (3) Ruling on Motion for Default Judgment. True and correct copies are attached to the accompanying Declaration of Donna Rubelmann as Exhibits A, B, and C. No appeal was filed. Petitioner requests that the Board take judicial notice of the court’s rulings.

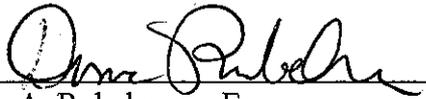
Inasmuch as the civil action has been finally resolved, petitioner Tyr Sport, Inc. requests that these opposition proceedings be reactivated and that a schedule be set for briefing and determination of petitioner’s motion for summary judgment which was filed May 11, 2012. In further support of that motion, petitioner requests leave to file a

supplemental brief with respect to the collateral estoppel and issue preclusion effects of the rulings of the district court.

October 31, 2013

Respectfully submitted,

DONNA RUBELMANN

By: 
Donna A. Rubelmann, Esq.
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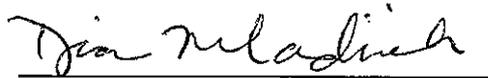
Attorneys for TYR SPORT, INC.

CERTIFICATE OF SERVICE AND MAILING

It is hereby certified that a true copy of the foregoing **MOTION TO REACTIVATE PROCEEDINGS** is being served upon Defendant by depositing a copy of the same in the U.S. mail, first class postage prepaid, in an envelopes addressed to:

Marc Dushey
1 State Street, 21st Floor
New York, NY 10004

Executed this 31st day of October 2013, at Redondo Beach, California.



DIANA MLADINICH

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

TYR SPORT, INC.)	
)	Opposition No. 91197669 (Parent Case)
Opposer,)	
)	Opposition No. 91197670
v.)	
)	
MARC DUSHEY)	
)	
Applicant.)	
<hr/>		

DECLARATION OF DONNA RUBELMANN

I, Donna Rubelmann, hereby declare and state:

1. I have personal knowledge of the facts set forth in this declaration.
2. Attached hereto respectively submitted as Exhibit A, B, and C are true and correct copies of the following documents executed and filed in the case captioned *Tyr Sport, Inc. v. Tyr Natural Spring Water, Inc., Manhattan Water Company, Inc., Marc Dushey and Coffee Distributing Corp.*, 3:12CV761 (SRU): (1) Default Judgment, (2) Injunction Order, and (3) Ruling on Motion for Default Judgment. I request that the Board take judicial notice of these court rulings.

I declare under penalty of perjury under the laws of California and the United States of America that the foregoing is true and correct.

October 31st, 2013

By: 
Donna Rubelmann

UNITED STATES DISTRICT COURT
DISTRICT OF CONNECTICUT

TYR SPORT, INC.

v.

3:12CV761 (SRU)

TYR NATURAL SPRING WATER,
INC., MANHATTAN WATER COMPANY,
INC., MARC DUSHEY and COFFEE
DISTRIBUTING CORP.

DEFAULT JUDGMENT

This action came on for consideration before the Honorable Stefan R. Underhill, United States District Judge, as a result of plaintiff's request for judgment on default pursuant to Rule 55(b) of the Federal Rules of Civil Procedure. On January 11, 2013, a default entered against the defendant Marc Dushey. The plaintiff filed a motion for default judgment and on June 5, 2013, plaintiff's request for entry of judgment on default was granted. On February 14, 2013, defendant Coffee Distributing Corp. was dismissed. On May 31, 2013, defendants Tyr Natural Spring Water, Inc. and Manhattan Water Company, Inc. were dismissed. On June 5, 2013, the Court entered an Injunction Order.

Therefore, it is ORDERED and ADJUDGED that judgment is entered in favor of the plaintiff Tyr Sport, Inc. against defendant Marc Dushey.

Dated at Bridgeport, Connecticut, this 12th day of June 2013.

ROBIN D. TABORA, Clerk

By /s/ Barbara Sbalbi
Deputy Clerk

Entered on Docket _____

EXHIBIT A

UNITED STATES DISTRICT COURT
DISTRICT OF CONNECTICUT

TYR SPORT, INC.,
Plaintiff,

v.

TYR NATURAL SPRING WATER, INC.,
MANHATTAN WATER COMPANY,
INC., MARC DUSHEY, and COFFEE
DISTRIBUTING CORP.,
Defendants.

No. 3:12-cv-761 (SRU)

INJUNCTION ORDER

The plaintiff, TYR Sport, Inc. (“TYR”), brought this action alleging, *inter alia*, trademark infringement under 15 U.S.C. § 1114, false designation of origin and unfair competition under 15 U.S.C. § 1125(a), trademark dilution under 15 U.S.C. § 1125(c), and common law trademark and trade name infringement. *See* Compl. (doc. # 1). On June 5, 2013, this court entered a default judgment against defendant Marc Dushey (“Dushey”), and granted TYR’s request for injunctive relief. *See* Ruling on Mot. for Default J. (the “Ruling”) (doc. # 35).¹ Accordingly, for the reasons set forth in the Ruling, and pursuant to Federal Rule of Civil Procedure 65, it is hereby ordered that Dushey is permanently enjoined from:

(1) using as a mark, domain name, or trade name, or as part of any mark, domain name, or trade name, the designation TYR or any other designation confusingly similar to any of the TYR marks;

¹ Prior to the Ruling, TYR voluntarily dismissed Coffee Distributing Corp., TYR Natural Spring Water, Inc., and Manhattan Water Company, Inc. as defendants. *See* Stipulation of Voluntary Dismissal (doc. # 31); Notice of Voluntary Dismissal (doc. # 34). Thus, Dushey is the sole remaining defendant in this action.

EXHIBIT B

(2) representing directly or indirectly, in any form or manner whatsoever, that any products or services offered for distribution or sale by Dushey are related to, affiliated with, approved by or sponsored by TYR;

(3) passing off, inducing, or enabling others to offer or pass off any products or services not offered or rendered by TYR as being TYR's products or services, or as being products or services sponsored by, approved by or somehow affiliated with TYR;

(4) committing any other acts calculated to cause consumers to believe that Dushey's products and services or that Dushey's business is that of TYR's or somehow related to TYR;

(5) committing any other acts that will tarnish, blur, or dilute, or have the tendency to tarnish, blur, or dilute, the distinctive quality of the famous marks of TYR; and

(6) advertising or promoting falsely the qualities or characteristics of Dushey's products.

Furthermore, the court orders Dushey to:

(1) cancel or transfer to TYR any and all internet registrations or reservations of the domain names "tyrwater.com," "tyrspringwater.com," and "tyrnaturalspringwater.com" and to cease any use of the term TYR as or as part of any name; and

(2) destroy any and all literature, products, forms, promotional materials, prints, advertising matter, circulars, stationery, labels, tags, wrappers, packaging, plates, stencils, sips and other materials used in the preparation of, or bearing any designation consisting of or including the term "TYR" domain name or mark in any media whatsoever.

It is so ordered.

Dated at Bridgeport, Connecticut, this 5th day of June 2013.

/s/ Stefan R. Underhill
Stefan R. Underhill
United States District Judge

UNITED STATES DISTRICT COURT
DISTRICT OF CONNECTICUT

TYR SPORT, INC.,
Plaintiff,

v.

TYR NATURAL SPRING WATER, INC.,
MANHATTAN WATER COMPANY,
INC., MARC DUSHEY, and COFFEE
DISTRIBUTING CORP.,
Defendants.

No. 3:12-cv-761 (SRU)

RULING ON MOTION FOR DEFAULT JUDGMENT

TYR Sport, Inc. (“TYR” or “the plaintiff”) brought this action against TYR Natural Spring Water, Inc. (“Spring”), Manhattan Water Company, Inc. (“Water”), Marc Dushey (“Dushey”), and Coffee Distributing Corporation (“CDC”), alleging trademark infringement, false designation of origin, false advertising, trademark dilution, common law trademark and trade name infringement, violations of the Connecticut Unfair Trade Practices Act, intentional infringement, and unfair competition. *See* Compl. (doc. # 1).¹ On May 29, 2012, TYR sent a waiver of service form to Dushey, which he signed and returned, and which TYR subsequently filed with this court. *See* Waiver of the Service of Summons (doc. # 21). Dushey, however, neither appeared nor answered in this case. On December 31, 2012, TYR filed a motion for default entry against Dushey in accordance with Rule 55(a) of the Federal Rules of Civil Procedure (doc. # 23). The court granted the motion on January 11, 2013, and entered a default (doc. # 27). TYR has now filed a motion for default judgment, seeking a permanent injunction,

¹ TYR has since voluntarily dismissed CDC, Spring, and Water as defendants. *See* Stipulation of Voluntary Dismissal (doc. # 31); Notice of Voluntary Dismissal (doc. # 34). Thus, Dushey is the sole remaining defendant in this action.

attorneys' fees, and costs (doc. # 28). As explained below, the plaintiff's motion for default judgment (doc. # 28) is GRANTED in part and DENIED in part.

I. Standard of Review

Federal Rule of Civil Procedure 55 establishes a “two-step process for the entry of judgment against a party who fails to defend: first, the entry of a default, and second, the entry of a default judgment.” *City of New York v. Mickalis Pawn Shop, LLC*, 645 F.3d 114, 128 (2d Cir. 2011) (internal quotation omitted). The first step—entry of a default—“formalizes a judicial recognition that a defendant has, through its failure to defend the action, admitted liability to the plaintiff.” *Id.* The second step—entry of a default judgment—“converts the defendant’s admission of liability into a final judgment that terminates the litigation and awards the plaintiff any relief to which the court decides it is entitled, to the extent permitted by [Federal Rule of Civil Procedure] 54(c).” *Id.*

Under Rule 54(c), “[a] default judgment must not differ in kind from, or exceed in amount, what is demanded in the pleadings.” Fed. R. Civ. P. 54(c). As the Second Circuit has explained, “[b]y limiting damages to what is specified in the ‘demand for judgment,’ [Rule 54(c)] ensures that a defendant who is considering default can look at the damages clause, satisfy himself that he is willing to suffer judgment in that amount, and then default without the need to hire a lawyer.” *Silge v. Merz*, 510 F.3d 157, 160 (2d Cir. 2007).

II. Discussion

A. Liability

Upon entry of a default, the court accepts as true all of the factual allegations of the complaint, except those relating to damages. *Greyhound Exhibitgroup, Inc. v. E.L.U.L. Realty Corp.*, 973 F.2d 155, 158 (2d Cir. 1992). The complaint (doc. # 1) alleges the following facts.

TYR is a well-known manufacturer and distributor of various sports apparel, equipment, and accessories, including water bottles, water coolers, and sports bags designed for carrying water. TYR also owns the exclusive rights to the federally-registered marks “TYR,” “TYR & Design,” “TYR.COM,” “TYRFIT,” “TYR FUSION 2,” the trade name “TYR Sport, Inc.,” and the domain names “tyr.com,” “tyrbottledwater.com,” “tyrsportsdrink.com,” “tyrbeverage.com,” and “tyrh20.com” (collectively, the “TYR marks”). *See* Compl., ¶¶ 1, 17 and 36.

Dushey is the CEO of Water and Spring, and is engaged in the business of collecting and bottling water for distribution. *Id.* ¶¶ 10, 42. According to the complaint, Dushey has wrongfully offered his goods under the identical mark “TYR” and similar marks “TYR WATER” and “TYR Design,” and operates confusingly-similar commercial websites at www.tyrwater.com, www.tyrspringwater.com, and www.tyrnaturalspringwater.com. *Id.* ¶¶ 5, 43. In addition to offering water products for sale, Dushey has also applied for registration of the marks “TYR” and “TYR and Design.” *Id.* ¶ 47.²

These facts, which the court deems admitted, establish Dushey’s liability for trademark infringement under 15 U.S.C. § 1114, false designation of origin and unfair competition under 15 U.S.C. § 1125(a), trademark dilution under 15 U.S.C. § 1125(c), and common law trademark

² According to TYR, shortly after the complaint was filed in May 2012, the parties engaged in extensive settlement negotiations, and an agreement was reached on all material terms of a resolution of this dispute. *See* Mem. of Law in Support of Pl.’s Mot. for Default J. at 6 (doc. # 28-1). Dushey, however, inexplicably cut off contact with the plaintiff and never executed the settlement documents. *Id.* Despite Dushey’s failure to finalize the settlement, TYR reports that Dushey has already ceased using the TYR mark, voluntarily changed the name of his corporation to “Tēr Natural Spring Water, Inc.,” and begun use of a new domain name. *Id.*

infringement.³ I address each of those claims below.

I. Trademark Infringement under 15 U.S.C. § 1114

“The owner of a trademark may enforce the right to exclude others from using the trademark in an action for trademark infringement.” *Mashantucket Pequot Tribe v. Redican*, 403 F. Supp. 2d 184, 190 (D. Conn. 2005). The Lanham Act defines trademark infringement as the use without consent of “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[.]” 15 U.S.C. § 1114(1)(a). Accordingly, the essential elements of a trademark infringement claim are (1) that the plaintiff has legally-protectable trademarks; and (2) that the defendant’s unauthorized use of those marks creates a likelihood of confusion among consumers. *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 454 F.3d 108, 115 (2d Cir. 2006). In evaluating likelihood of confusion, courts look to “eight principal factors, known as the *Polaroid* factors,” including: “(1) the strength of the senior mark; (2) the degree of similarity between the two marks; (3) the proximity of the products; (4) the likelihood that the prior owner will ‘bridge the gap’; (5) actual confusion; (6) the defendant’s good faith (or bad faith) in adopting its own mark; (7) the quality of defendant’s product; and (8) the sophistication of the buyers.” *Savin Corp. v. Savin Group*, 391 F.3d 439, 456 (2d Cir. 2004) (quoting *Polaroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492, 495 (2d Cir. 1961)).

Here, accepting the plaintiff’s factual allegations as true and applying the *Polaroid* factors, I conclude that TYR has established its claim for trademark infringement. TYR has

³ The plaintiff has not specifically moved for judgment by default on any of the other claims asserted in the complaint. *See* Mem. of Law in Support of Pl.’s Mot. for Default J. (doc. # 28-1). Thus, those claims are dismissed without prejudice with respect to Dushey.

shown that it owns all of the federally-registered trademarks at issue, *see* Compl., Ex. A (doc. # 1-1), and Dushey's use of highly similar, if not identical, marks is likely to cause considerable confusion in the marketplace. *See Savin Corp.*, 391 F.3d at 456. Indeed, by virtue of his default, Dushey has admitted that his infringing activities "are likely to confuse consumers as to the relationship of [Dushey's products] to TYR and its marks, products and services[.]" Compl. ¶ 6. Accordingly, judgment will enter against Dushey on the plaintiff's trademark infringement claim.

2. *False Designation of Origin and Unfair Competition under 15 U.S.C. § 1125(a)*

Section 1125(a) of the Lanham Act, which is not limited to registered trademarks, similarly makes liable:

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 . . . 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

15 U.S.C. § 1125(a). "As with actions for trademark infringement, the ultimate inquiry in most actions for false designation of origin is whether there exists a likelihood that consumers will be confused as to the source of the product." *Verilux, Inc. v. Hahn*, No. 3:05-cv-254 (PCD), 2007 WL 2318819, at *9 (D .Conn. Aug. 10, 2007) (citing *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 871 (2d Cir. 1986)). Thus, for substantially the same reasons articulated above, TYR has established Dushey's liability for false designation and unfair competition.

3. *Trademark Dilution under 15 U.S.C. § 1125(c)*

Section 1125(c) of the Lanham Act provides, in relevant part:

[T]he owner of a famous mark . . . shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

15 U.S.C. § 1125(c)(1). In order to prevail on a dilution claim, the plaintiff must prove: “(1) its mark is famous; (2) the defendant is making 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 dilutes⁴ the quality of the mark by diminishing the capacity of the mark to identify and distinguish goods and services.” *Savin Corp.*, 391 F.3d at 449 (internal quotation omitted).

Here, TYR has alleged—and, by defaulting, Dushey has admitted—that the TYR marks are “famous,” Compl. ¶¶ 1, 17-22, 34-35, that Dushey made commercial use of one or more of those marks after they achieved that fame, *id.* ¶¶ 20, 40-41, 48-50, and that Dushey's use of the TYR marks likely diluted their distinctive quality, *id.* ¶¶ 51-53. Accordingly, the plaintiff has established all of the required elements, and judgment will enter against Dushey on the plaintiff's trademark dilution claim.

4. *Common Law Trademark Infringement*

“The test for trademark infringement and unfair competition under Connecticut law is identical to the test under the Lanham Act.” *Hahn*, 2007 WL 2318819, at *10 (citations

⁴ In *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003), the Supreme Court held that the text of the Federal Trademark Dilution Act of 1995 “unambiguously requires a showing of actual dilution, rather than a likelihood of dilution.” *Id.* at 433. In 2006, however, Congress responded to this ruling by enacting the Trademark Dilution Revision Act of 2006, which expressly provides for relief based merely on a *likelihood* of dilution. See *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 104 (2d Cir. 2009).

omitted); *see also Miss Universe, Inc. v. Patricelli*, 271 F. Supp. 104, 109 (D. Conn. 1967) (“[T]here is no real difference between the relevant state and federal law[.]”). Thus, the analysis presented *supra* at Part II.A.1 also applies to the plaintiff’s common law claims, and for substantially the same reasons, judgment will enter against Dushey on those claims as well.

B. Request for Permanent Injunction

In light of Dushey’s unlawful conduct, the plaintiff seeks to permanently enjoin Dushey from using or unfairly benefiting from the TYR marks. To obtain a permanent injunction in a trademark action, a party who has otherwise succeeded on the merits must establish: “(1) that it has suffered an irreparable injury; (2) that remedies available at law, such as monetary damages, are inadequate to compensate for that injury; (3) that, considering the balance of hardships between the plaintiff and the defendant, a remedy in equity is warranted; and (4) that the public interest would not be disserved by a permanent injunction.” *Salinger v. Colting*, 607 F.3d 68, 77 (2d Cir. 2010) (quoting *eBay Inc. v. MercExchange, LLC*, 547 U.S. 388, 391 (2006)); *see also U.S. Polo Ass’n, Inc. v. PRL USA Holdings, Inc.*, 800 F. Supp. 2d 515, 539 (S.D.N.Y. 2011) (noting that “*Salinger* suggest[s] that [trademark infringement] cases should be analyzed under the standards for injunctive relief articulated by the Supreme Court in *eBay*”).

Here, the plaintiff has satisfied all of the elements required for permanent injunctive relief. As noted above, Dushey has admitted, by virtue of his default, that his infringing activities will likely result in confusion among consumers, and “in a trademark infringement case, proof of a likelihood of confusion establishes both a likelihood of success on the merits and irreparable harm.” *Brennan’s, Inc. v. Brennan’s Rest., L.L.C.*, 360 F.3d 125, 129 (2d Cir. 2004) (citing *Hasbro, Inc. v. Lanard Toys, Ltd.*, 858 F.2d 70, 73 (2d Cir. 1988)). Furthermore, the plaintiff has shown that money damages are inadequate to compensate TYR for the tarnishing of

its reputation and goodwill by Dushey's usurpation of its marks.⁵ The balance of the equities also weighs heavily in the plaintiff's favor, because the only hardship Dushey will suffer from this injunction will be that he must cease engaging in further illegal activity. Lastly, the public interest is served by an injunction that protects property interests in trademarks and helps enforce federal law.

In sum, the criteria for a permanent injunction have been met, and Dushey is permanently enjoined from: (1) using as a mark, domain name, or trade name, or as part of any mark, domain name, or trade name, the designation TYR or any other designation confusingly similar to any of the TYR marks; (2) representing directly or indirectly, in any form or manner whatsoever, that any products or services offered for distribution or sale by Dushey are related to, affiliated with, approved by or sponsored by TYR; (3) passing off, inducing, or enabling others to offer or pass off any products or services not offered or rendered by TYR as being

⁵ As explained *supra* note 2, the plaintiff admits that Dushey has already stopped using the TYR marks, changed the name of his company, and adopted a different domain name for his commercial website. Although Dushey has apparently ceased his infringing conduct for now, "[i]t is settled that an action for an injunction does not become moot merely because the conduct complained of has terminated, if there is a possibility of recurrence, since otherwise the defendants would be free to return to (their) old ways." *Allee v. Medrano*, 416 U.S. 802, 810-11 (1974) (internal quotation omitted). In trademark cases, there is "no bright line for when cessation of infringing activity moots the request for an injunction." *Fresh Del Monte Produce Inc. v. Del Monte Foods Co.*, No. 08-cv-8718 (SHS), 2013 WL 1242374, at *4 (S.D.N.Y. Mar. 28, 2013) (citations omitted). Rather, the question is "whether the record as a whole evinces 'some cognizable danger of recurrent violation.'" *Id.* (quoting *Robert Stigwood Grp. Ltd. v. Hurwitz*, 462 F.2d 910, 913 (2d Cir. 1972)).

In my view, the record here does reveal a cognizable danger of recurrence. According to the plaintiff, Dushey ceased his infringement as a direct result of settlement negotiations between the parties. *See* Mem. of Law in Support of Pl.'s Mot. for Default J. at 6-7 (doc. # 28-1). Dushey, however, abruptly cut off communications with TYR before executing the formal settlement agreement. *Id.*; *see also* Aff. of Donna A. Rubelmann ¶¶ 14-23 (doc. # 28-6). Dushey's conduct raises significant questions about his intentions going forward, and the risk that he will resume his infringing activities in the future is sufficient to warrant a permanent injunction under the circumstances of this case.

TYR's products or services, or as being products or services sponsored by, approved by or somehow affiliated with TYR; (4) committing any other acts calculated to cause consumers to believe that Dushey's products and services or that Dushey's business is that of TYR's or somehow related to TYR; (5) committing any other acts that will tarnish, blur, or dilute, or have the tendency to tarnish, blur, or dilute, the distinctive quality of the famous marks of TYR; and (6) advertising or promoting falsely the qualities or characteristics of Dushey's products. Furthermore, the court orders Dushey to (1) cancel or transfer to TYR any and all internet registrations or reservations of the domain names "tyrwater.com," "tyrspringwater.com," and "tyrnaturalspringwater.com" and to cease any use of the term TYR as or as part of any name; and (2) destroy any and all literature, products, forms, promotional materials, prints, advertising matter, circulars, stationery, labels, tags, wrappers, packaging, plates, stencils, sips and other materials used in the preparation of, or bearing any designation consisting of or including the term "TYR" domain name, or mark in any media whatsoever.⁶

C. Request for Attorneys' Fees and Costs

In addition to injunctive relief, the plaintiff also seeks attorneys' fees and costs under the Lanham Act. Pursuant to section 1117(a), the district court may award costs to the prevailing

⁶ In its motion for default judgment, the plaintiff also seeks an order specifically directing Dushey to "withdraw his applications for registration of the mark 'TYR,' Application Serial No. 77955633 and the mark 'TYR RETURN TO NATURE & Design,' Application Serial No. 85013113, and any other applications for marks containing the word TYR in any form." Pl.'s Mot. for Default J. at 3 (doc. # 28). Although the mandatory withdrawal of these applications is likely implied by the injunctive relief I have already granted in the plaintiff's favor, I will not include this proposed language in my final order. The complaint against which Dushey declined to defend made no mention of the withdrawal of these applications in its Prayer for Relief, and "plaintiffs are not entitled to judgment by default on allegations that were never raised in the complaint." *Adobe Systems Inc. v. Feather*, 895 F. Supp. 2d 297, 302 n.1 (D. Conn. 2012) (citing Fed. R. Civ. P. 54(c)).

party in cases of willful infringement and reasonable attorneys' fees in "exceptional cases." 15 U.S.C. § 1117(a). "In this Circuit, an 'exceptional case' under the Lanham Act typically requires a finding of fraud, bad faith, or willful infringement." *Rolex Watch U.S.A., Inc. v. Rolex Deli Corp.*, No. 11-cv-9321 (BSJ), 2012 WL 5177517, at *5 (S.D.N.Y. Oct. 18, 2012) (citing *Conopco, Inc. v. Campbell Soup Co.*, 95 F.3d 187, 194 (2d Cir. 1996)). "Whether to award attorney fees, and the amount of any award, are matters that fall within the discretion of the district court." *Goodheart Clothing Co. v. Laura Goodman Enters., Inc.*, 962 F.2d 268, 272 (2d Cir. 1992). Thus, "[e]ven with a finding of bad faith, the decision to award attorney's fees remains within the sound discretion of the district court." *Prot. One Alarm Monitoring, Inc. v. Exec. Prot. One Sec. Serv., LLC*, 553 F. Supp. 2d 201, 208 (E.D.N.Y. 2008).

Here, in my view, TYR has failed to establish fraudulent intent, bad faith, or willful infringement sufficient to warrant an award of costs and/or attorneys' fees. Indeed, by the plaintiff's own admission, Dushey promptly took steps to cease his infringing activities after TYR commenced this action and informed him of the problem. *See* Aff. of Donna A. Rubelmann ¶¶ 3-10 (doc. # 28-6). Those facts appear to negate any inference of willful infringement or bad faith. Thus, exercising my discretion, I decline to award costs and fees in favor of the plaintiff.⁷

III. Conclusion

The plaintiff's motion for default judgment (doc. # 28) is GRANTED in part and DENIED in part. The plaintiff is entitled to the injunctive relief provided herein, but is not otherwise entitled to attorneys' fees and costs.

⁷ The plaintiff has not sought monetary damages in its motion for default judgment. Thus, I need not consider whether TYR is entitled to any monetary relief.

It is so ordered.

Dated at Bridgeport, Connecticut, this 5th day of June 2013.

/s/ Stefan R. Underhill
Stefan R. Underhill
United States District Judge