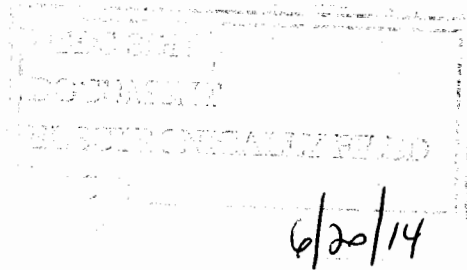


UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK



HERITAGE OF PRIDE, INC.,

Plaintiff,

-against-

No. 14 Civ. 4165 (CM)

MATINEE NYC, INC., VOSS NYC GROUP
CORP., JAKE RESNICOW, and BRANDON
VOSS,

Defendants.

**MEMORANDUM DECISION AND ORDER GRANTING PLAINTIFF'S
MOTION FOR A PRELIMINARY INJUNCTION**

McMahon, J.:

Plaintiff Heritage of Pride, Inc., brought this action against Defendants Matinee NYC, Inc., Voss NYC Group Corp., Jake Resnicow, and Brandon Voss (collectively, "Matinee"), alleging trademark infringement and unfair competition, in violation of the Lanham Act and New York state law.

On June 18-19, 2014, the Court held a hearing on Heritage's motion for a preliminary injunction. Yesterday, after hearing the parties' evidence, the Court entered an order granting the motion (ECF No. 30). This Memorandum Decision and Order explains the Court's reasoning in greater depth.

BACKGROUND

The following facts are taken from Heritage's Verified Complaint (the "Complaint"), its attached exhibits, the exhibits attached to Matinee's opposition motion, and the evidence offered at the hearing.

A. The Parties

Plaintiff Heritage of Pride, Inc., is a New York corporation with its principal place of business in New York, NY. (Compl. ¶ 15.) Heritage is a 501(c)(3) non-profit organization dedicated to serving New York City’s lesbian, gay, bisexual, and transgendered (“LGBT”) community. (*Id.*) Heritage was founded in 1984 to take over the responsibility of planning New York City’s annual gay pride March and Rally when the former organizers disbanded; it has handled that responsibility ever since. (*Id.*) Over time, it has added additional events to a roster of Pride Week celebrations. (Compl. ¶ 25.)

Heritage is a founding member of the International Association of Lesbian, Gay, Bisexual and Transgender Pride Coordinators, a non-profit organization supporting 180 groups that conduct LGBT Pride events around the world. (*Id.*) The organization’s mission is to “build a future without discrimination and promote equal rights under the law.” (Declaration of Chris Frederick dated June 18, 2014 (“Supp. Frederick Decl.”) ¶ 3.)

Defendants Matinee NYC, Inc., and Voss NYC Group are for-profit New York corporations with their principal places of business in New York City. Both are in the business of planning and promoting concerts and other events. Defendant Resnicow is the principal of Matinee and Defendant Voss is the principal of Voss NYC. (Compl. ¶ 8.) The complaint alleges that their target audience is a subset of the LGBT community, to wit: gay men. (Compl. ¶ 27; *id.* Ex. I.) Evidence adduced at the hearing indicates that Matinee NYC and Voss NYC Group sometimes work together to promote events. (Testimony of Brandon Voss, June 19, 2014.)

B. History of New York’s Pride Events

In the early morning hours of June 28, 1969, NYPD officers raided the Stonewall Inn on Christopher Street in the West Village, a well-known hangout for gay men. The raid set off what would become known as the Stonewall Riots, in which, for the first time, the gay community

rose up to protest being targeted by law enforcement and society for its lifestyle. A year later, the Christopher Street Liberation Committee organized the first Gay Pride March in New York, which began at the Stonewall Inn and continued uptown to Central Park. From these events, the modern Gay Rights movement was born.

Over the past three or four decades, June has become “Pride Month” in New York City and elsewhere in the country. Here in New York City, a week’s worth of “official” events have arisen around a celebration that begins with the commemoration of the Stonewall Riots and culminates in the Pride March (also known colloquially as the Pride Parade)—a huge parade that is often over-the-top, sometimes in-your-face, and always a celebration of the LGBT community’s breaking free of years of enforced shame and secrecy. This year’s events mark the 45th anniversary of the Stonewall Riots.

In 2013, approximately 2 million people attended the NYC Pride March to watch nearly 13,000 marchers, 350 organizations, and 68 floats. (Compl. ¶ 20; *id.* Ex. F.) Previous Grand Marshalls of the NYC Pride Parade have included former Governor David A. Paterson, Senator Charles Schumer, former Mayor Michael Bloomberg, musicians Cyndi Lauper and Harry Belafonte, actress and *Time Magazine* cover-person Laverne Cox, New York City’s first legally married same-sex couple Connie Kopelov & Phyllis Siegel, and last year, Edie Windsor herself. (Compl. ¶ 20.) Marchers have also included Governor Andrew Cuomo and Mayor Bill de Blasio. (*Id.*)

In addition to the Rally and March, Heritage has expanded the roster of NYC Pride to include various events throughout Pride Week. These include Family Movie Night, Teaze (formerly known as “Rapture on the River”), PrideFest, the VIP Rooftop Party, and the Dance on the Pier. Heritage also “licenses” events sponsored by others, including the WE Party. These

events attract well over a million attendees. (Compl. ¶ 25; *id.* Ex. D.) The events of Pride Week receive “extensive, positive, and unsolicited press coverage not only in New York, but across the country and around the world.” (*Id.*)

As “one of the leading LGBT organizations,” Heritage’s NYC PRIDE-branded events have featured such well-known performers and guests as Cher, Whitney Houston, Jennifer Hudson, Janet Jackson, Lady Gaga, Cyndi Lauper, Lil’ Kim, Jennifer Lopez, Madonna, Idina Menzel, Bette Midler, Liza Minnelli, Kylie Minogue, Rosie O’Donnell, RuPaul, and many others. (Compl. ¶ 21.) Heritage’s events have also attracted many high-profile corporate sponsors whose financial support helps to make NYC PRIDE events possible. (*Id.* ¶ 22.) This year’s NYC PRIDE corporate sponsors include Coca-Cola, Vitamin Water, TD Bank, Delta Airlines, Netflix, Budweiser, NBC, Whole Foods, Macy’s, Wells Fargo, W Hotels, Marriott, Amtrak, Comcast NBCUniversal, MasterCard, Citi, HSBC, Walgreens, Johnson & Johnson, Showtime Networks, and State Farm Insurance. (*Id.*)

C. The NYC PRIDE Marks

Since 1984, the Rally and March have been organized by Heritage, using the rubric “NYC Pride”—generally with the year added, as in “2014 NYC Pride.” As other events have been added to the roster, and especially since as early as 1998, Heritage and other third-party groups have used the phrase “NYC Pride” to refer to Heritage and its events. (Compl. ¶ 16; *id.* Exs. D, E.) In December 2009, Heritage formally rebranded itself as “NYC Pride,” and has since operated under that trade name. (Compl. ¶ 17; *id.* Ex. F.)

On April 8, 2014, the United States Patent and Trademark Office granted Heritage a federal registration on the Principal Register for the following NYC PRIDE service mark for use in connection with “charitable fund raising services for lesbian, gay, bisexual and transgender pride cultural events”:

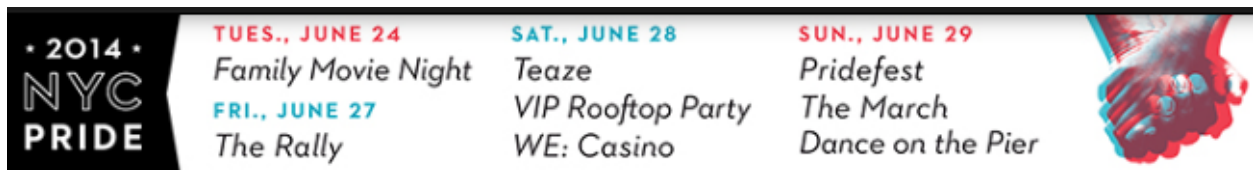


(Compl. ¶ 18; *id.* Ex. G.)

The record reveals that this year, Heritage has adopted the following logo to advertise the events it sponsors during Pride Week:



Heritage incorporates this logo in, for example, its banner ad for the various events it has organized and/or sponsored for Pride Week:



(Compl. ¶ 34.) The Rally and March are free to all; the other events are ticketed. Tickets are available on a website located at www.showclix.com/events/nycpride. Heritage also offers a weekend pass that admits a holder to all of its weekend events. (Testimony of Chris Frederick, June 19, 2014.)

D. The Parties' Commercial History

In December 2010, Matinee signed a contract with Heritage to become an “official Promotional Partner of NYC PRIDE” in connection with a 2011 New Year’s Day event. (Declaration of Chris Frederick dated June 16, 2014, ECF No. 11 (“Frederick Decl.”) Ex. A). Under the terms of this contract, Matinee agreed to support NYC PRIDE 2011 with contributions

of: (1) \$5 per ticket sold for its event, with a minimum contribution of \$2,000 and a maximum of \$10,000; (2) two free general admission tickets for Heritage's uses; and (3) a dedicated post on Matinee's Facebook page with a link to NYC Pride's Facebook page. (*Id.*) In return, Heritage agreed to bestow upon Matinee an official "Promotional Partner" title and to promote its event on Facebook and Twitter as NYC Pride's "official New Year's Event." (*Id.*) The contract contained the following "sponsorship condition":

NAME AND LOGO: Heritage of Pride and Dance on the Pier are trademarked names. Before [Matinee] executes any imprint of the name or logos, a quality proof of the logos must be sent to [Heritage's] Managing Director, Chris Frederick for approval. The logo must be clearly printed and of a quality equal to the Matinee logo.

(*Id.*) There is no mention of any trademark in New York or NYC PRIDE, but there is a mention of logos; the contract was written on Heritage letterhead, which included the organization's now-registered NYC PRIDE trademark:



Heritage of Pride, Inc.



Letter of Agreement 2011
Matinee New Years Day Event & Heritage of Pride, Inc.

(*Id.*)

Following the event, Jake Resnicow of Matinee NYC, Inc., emailed Chris Frederick, Heritage's Executive Director, to say that Matinee "had hoped for more support from the Heritage of Pride," and that he would be sending the organization a check for \$500 instead of the \$2,000 minimum required by the parties' contract. (Frederick Decl. Ex. B.) Matinee and Heritage did not have any further commercial dealings; Matinee was never a promotional partner of any NYC PRIDE events during Pride Week. (Testimony of Brandon Voss, June 19, 2014.)

On June 17, 2011, Resnicow emailed Frederick to report that he had seen a third-party flyer bearing the NYC Pride logo. (Frederick Decl. Ex. C.) Resnicow asked, “Is this event an official party of NYC Pride?” (*Id.*)

The following month, on July 19, 2011, Resnicow emailed Frederick about an “E-blast” that he was putting together to send to Matinee’s email list. (Frederick Decl. Ex. D.) Resnicow indicated that the “E-blast” was “featuring NYC Pride,” and asked Frederick if there were any “specific headlines or graphics” that Frederick wanted to include. (*Id.*) I am not aware of any response to this email.

Both of these communications suggest that Resnicow recognized that the name NYC Pride had come to be identified with Heritage and the events it sponsored.

The Voss defendants have no history of promoting events or being promotional partners with Heritage. (Testimony of Brandon Voss, *supra.*)

Sometime in February 2014, Chris Frederick of Heritage contacted Brandon Voss, a promoter who had been trying since 2009 to set up a Saturday night party during Pride Week. Frederick told Voss that Heritage was considering adding a Saturday night event to its roster of “official” NYC PRIDE events, and solicited a proposal from Voss. On March 3, 2014—having received no proposal from Voss—Frederick sent Voss the following email:

Hope all is well. I wanted to shoot you an email to give you an update on some items with us. The board was approached to partner on a Saturday evening event and because of the generous opportunity they have decided to pursue it for 2014. There could be ways that we still work together but as for a Saturday evening event we sadly won’t be able to partner for this year. Sorry we couldn’t get it to work for this year but it was out of my control. Let me know if you have any questions and I wish I had better news.

(Frederick Decl. Ex. F.) Later that afternoon, Voss sent the following response:

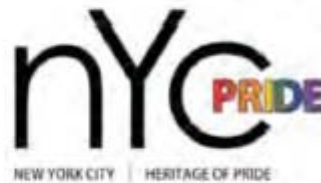
Awe, that’s a bummer. Anything we can do to change the board’s mind? I know I’ve been lagging on a formal proposal but I was waiting to finalize talent because

otherwise the budget is just guesswork. We are just about there and I'll have everything this week. Which event are you partnering with?

(*Id.*) There was apparently a telephone conversation between Voss and Frederick on the subject following this written exchange. It led to nothing. (Testimony of Christopher Frederick, June 19, 2014.) There is contradictory testimony about whether this telephone conversation included discussion about Heritage and Voss doing a different concert on Friday night, featuring an artist known as Robyn; Frederick says no, Voss says yes. Heritage already had one of the major events of Pride Week—the Rally—scheduled for Friday night.

E. Matinee's Allegedly Infringing Uses of NYC PRIDE

Notwithstanding the foregoing, on March 16, 2014, Voss emailed Carmen Cacciatore of FlyLife, Inc., to extend a formal offer of \$75,000 for a performance by Robyn at “the official Friday night pride event,” produced by “Voss NYC . . . in partnership with Heritage of Pride.” (Frederick Decl. Ex. H.) The top of the letter included the following letterhead, with Voss NYC's logo directly next to Heritage's now-registered NYC PRIDE trademark:



(*Id.*) Voss admitted on the witness stand that this email was not authorized by Heritage; however, it did not lead to any legal action.

On May 31, 2014, Matinee sent an email whose sender was identified as “NYC Pride” using an email address of nycpride2014@gmail.com, the body of which prominently displayed an image containing the phrase “NYC PRIDE” and stated that “SUPREME FESTIVAL,

BRANDON VOSS & JAKE RESNICOW PRESENT” followed immediately by a logo incorporating the phrase “NYC PRIDE” (a logo suspiciously similar to Heritage’s 2014 NYC PRIDE logo) followed by a listing of the dates—the same dates during which Heritage’s competing NYC PRIDE events occur. The email advertises “NYC PRIDE WEEKEND PASSES” and closes by listing an entity called “NYC Pride” with a New York City address unaffiliated with Heritage:



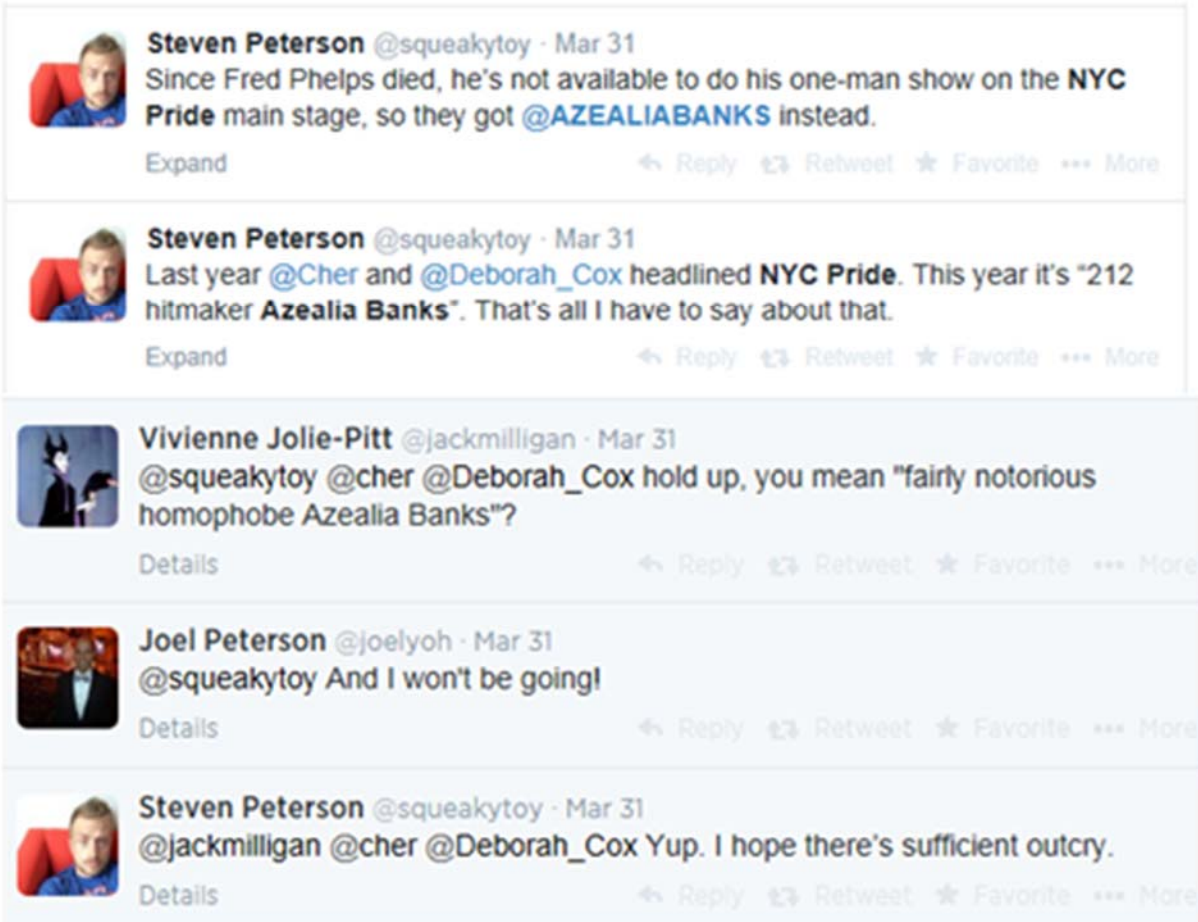
(Compl. ¶ 34; *id.* Ex. B.) On June 2, 2014, Matinee sent a substantially similar email from a sender called “NYC Pride 2014” with an email address of nycpride@vosnyc.com. (Compl. ¶ 35, Ex. C.)

Heritage alleges that Matinee’s conduct has “already caused confusion.” (Compl. ¶¶ 38–39.) For example, Azealia Banks, a bisexual singer who was heavily criticized for making allegedly homophobic comments directed at blogger Perez Hilton, has been wrongly identified by numerous individuals and organizations as a performer at a Heritage-sponsored NYC PRIDE event. (*Id.*)

Because of this, criticism over Matinee’s choice to include Azealia Banks as a headliner has been wrongly directed at NYC PRIDE. (Compl. ¶ 39.) On March 31, 2014, Twitter user Saeed Jones (whose Twitter homepage identifies him as the editor of “Buzzfeed LGBT,” and who boasts 12,900 Twitter followers as of this writing), retweeted another user’s complaint about what that user believed to be NYC PRIDE’s choice of Azealia Banks:



(*Id.*) In another post that day, a Twitter user joked that Azealia Banks replaced the recently deceased and notorious anti-gay pastor Fred Phelps of the Westboro Baptist Church on the “NYC Pride main stage.” In response, another user says in apparent disbelief: “hold up, you mean ‘fairly notorious homophobe Azealia Banks’?” And another responds: “I won’t be going!”



(*Id.*)

Two months later, on May 30, 2014, the New York-based music blog “Brooklyn Vegan” wrongly included Matinee’s Azealia Banks show in an article about “NYC Pride Week” that otherwise listed only official NYC PRIDE events. (Compl. ¶ 38; *see* Amanda Hatfield, *NYC Pride Week 2014 Coming Soon, Including an Azealia Banks Show, the March & More*, BROOKLYN VEGAN, http://www.brooklynvegan.com/archives/2014/05/nyc_pride_week.html).

F. Prior Third-Party Uses of “NYC Pride”

But Heritage does not, and cannot, claim exclusive use of the phrase “NYC Pride”—no one can. Throughout Pride Month, and especially during Pride Week, numerous commercial

establishments use the phrase to describe events that they are hosting during the week-long celebration. Matinee has offered a number of examples of third-party uses of Heritage's marks:

- An advertisement by an cruise company to "sail the Caribbean from NYC" on what the firm calls the "New York Pride Cruise." (Declaration of Grace Meador ("Meador Decl.") Ex. G.)
- An event hosted by Gumbo NYC labeled as "NYC PRIDE" in enormous bold letters. (Meador Decl. Ex. H.)
- A print advertisement for a pride-week party at the Posh Bar & Lounge in midtown Manhattan, featuring prominently the phrase "Posh Is NYC Pride." (Meador Decl. Ex. I.)
- Flyers for events put on by Josh Wood Productions in June 2012 and June 2013 indicating that they took place during "NYC PRIDE 2012" and "NYC PRIDE 2013," respectively. (Meador Decl. Exs. J & K.)
- A flyer for a nightclub party with the text: "LASREINAS PRESENTS 6th Annual NYC PRIDE 2013. (Meador Decl. L.)
- A flyer advertising a party called "Paper & Forever and the Sailor Man" featuring the phrase "NYC PRIDE 2014." (Meador Decl. M.)
- An advertisement for a June 2011 concert with the tag line "Kick off NYC Pride with GO! And Real L Word's Real Live Lesbians" (GO! is a band, and "The L Word" was a Showtime series about lesbians). (Meador Decl. Ex. N.)
- A flyer for a party promoted by Ferosh Productions called "Genesis: New York City Pride 2013." (Meador Decl. Ex. O.)
- A webpage titled "NYC Pride 2006," listing parties in the city during Pride Week 2006. (Meador Decl. Ex. P.)

None of these uses, however, involves sponsorship of a multi-day slate of Pride Week events targeted to the LGBT community, or includes a logo blatantly imitating the style of the logo that Heritage has been using to promote activities it sponsors:

Heritage



Matinee



G. Procedural History

On June 10, 2014, Heritage filed its complaint and submitted its motion for a preliminary injunction and TRO. Judge Keenan, sitting in Part One, denied the motion—largely, I gather, because he thought the application was untimely.

On June 18-19, 2014, the Court held a hearing at which the parties argued the preliminary injunction.

DISCUSSION

I. Standard for Determining the Motion

In trademark cases such as this one, courts in this Circuit have held that a preliminary injunction should issue upon a showing of a plaintiff's likelihood of success on the merits only where the plaintiff has also shown that: (1) "he is likely to suffer irreparable injury in the absence of an injunction"; (2) "remedies at law, such as monetary damages, are inadequate to compensate for that injury"; (3) the balance of hardships tips in his favor; and (4) "the 'public interest would not be disserved' by the issuance of a preliminary injunction." *New York City Triathlon, LLC v. NYC Triathlon Club, Inc.*, 704 F. Supp. 2d 305, 328 (S.D.N.Y. 2010) (quoting *Salinger v. Colting*, 607 F.3d 68, 79-80 (2d Cir. 2010)); *see also, e.g., U.S. Polo Ass'n, Inc. v. PRL USA Holdings, Inc.*, 800 F. Supp. 2d 515, 539 (S.D.N.Y. 2011), *aff'd*, 511 F. App'x 81 (2d Cir. 2013).

II. Heritage Is Likely to Succeed on the Merits of Its Unfair Competition Claim.

Many of Heritage's claims—its Lanham Act and common law trademark claims, and its claims for use of a trade name with intent to deceive under New York General Business Law

Section 133—require a showing that the mark NYC PRIDE (which Heritage has been using as a trade name since at least 2009) has acquired secondary meaning identifying it with the sponsor of the “official” events of Pride Week.¹

However, there is no need to demonstrate secondary meaning in connection with a common law unfair competition claim under New York law. *Tri-Star Pictures, Inc. v. Unger*, 14 F. Supp. 2d 339, 364 (S.D.N.Y. 1998). Heritage has amply met the standard for showing likelihood of success on the merits of that claim.

In New York, the “essence of unfair competition . . . is the bad faith misappropriation of the labors and expenditures of another, likely to cause confusion or to deceive purchasers as to the origin of the goods.” *Nabisco, Inc. v. PF Brands, Inc.*, 50 F. Supp. 2d 188, 212 (S.D.N.Y. 1999) (citations omitted). To assert an unfair competition claim, a plaintiff must demonstrate two things: (1) a likelihood of confusion, and (2) the defendant’s bad faith. *Kraft Gen. Foods, Inc. v. Allied Old English, Inc.*, 831 F. Supp. 123, 135 (S.D.N.Y. 1993). Unlike a claim for

¹ There is no need for Heritage to demonstrate secondary meaning in order to prevail on its claim that Defendants’ actions violate N.Y. Gen. Bus. Law § 349, New York’s deceptive business practices law—but it has absolutely no possibility of succeeding on such a claim. Corporate competitors may bring a claim under this statute “so long as some harm to the public at large is at issue.” *Securitron Magnalock Corp. v. Schnabolk*, 65 F.3d 256, 264 (2d Cir. 1995). However, because “section 349 is modelled after the Federal Trade Commission Act, federal courts have interpreted the statute’s scope as limited to the types of offenses to the public interest that would trigger Federal Trade Commission intervention under 15 U.S.C. § 45, such as potential danger to the public health or safety.” *DO Denim, LLC v. Fried Denim, Inc.*, 634 F. Supp. 2d 403, 408-09 (S.D.N.Y. 2009). It is therefore well-settled that “infringement claims are not cognizable under § 349 unless there is a specific and substantial injury to the public interest over and above ordinary trademark infringement or dilution.” *Luv N’ Care, Ltd. v. Walgreen Co.*, 695 F. Supp. 2d 125, 135 (S.D.N.Y. 2010) (quoting *Nat’l Distillers Prods. Co., LLC v. Refreshment Brands, Inc.*, 198 F.Supp.2d 474, 486–87 (S.D.N.Y. 2002)). Here, Heritage has not shown any likelihood of a “significant risk of harm to the public health,” *DePinto v. Ashley Scott, Inc.*, 635 N.Y.S.2d 215 (1st Dep’t 1995), nor of any specific injury to the public interest whatsoever beyond a general likelihood of consumer confusion sounding entirely in trademark.

trademark infringement, proof of secondary meaning (or, indeed, of a protectable mark at all) is not required. *Tri-Star Pictures*, 14 F. Supp. 2d at 364.

A. Heritage Has Shown A High Likelihood of Confusion.

“[L]ikelihood of confusion is judged in an unfair competition claim in the same manner as a Lanham Act claim.” *Nabisco*, 50 F. Supp. 2d at 212 (citation omitted); *see also Tri-Star*, 14 F. Supp. 2d at 363. “Likelihood of confusion includes confusion of any kind, including confusion as to source, sponsorship, affiliation, connection, or identification.” *Guinness United Distillers & Vintners B.V. v. Anheuser-Busch, Inc.*, 64 U.S.P.Q.2d 1039, 1041 (S.D.N.Y. 2002). “In order to be confused, a consumer need not believe that the owner of the mark actually produced the item and placed it on the market. The public’s belief that the mark’s owner sponsored or otherwise approved the use of the trademark satisfies the confusion requirement.” *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 204-05 (2d Cir. 1979) (internal citations omitted).

The Second Circuit has articulated eight factors (often referred to as the “*Polaroid* factors”) to be considered when assessing the likelihood of consumer confusion in the trademark context—which, perforce, are the standards applied in assessing likelihood of confusion on a New York unfair competition claim:

- (1) the strength of the plaintiff’s mark;
- (2) the similarity of the plaintiff’s and defendant’s marks;
- (3) the competitive proximity of the products or services;
- (4) the likelihood that the plaintiff will “bridge the gap” and offer a product or service similar to the defendant’s;
- (5) actual confusion between the products or services;
- (6) good faith on the defendant’s part;
- (7) the quality of the defendant’s products or services; and
- (8) the sophistication of buyers.

Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492, 495 (2d Cir. 1961). These factors apply to both competing and non-competing goods and services, and no single factor is dispositive.

See Natural Organics, Inc. v. Nutraceutical Corp., 426 F.3d 576, 578 (2d Cir. 2005); *Fruit-Ices Corp. v. Coolbrands Int'l, Inc.*, 335 F. Supp. 2d 412, 418-19 (S.D.N.Y. 2004).

1. Strength of Heritage's Marks

A mark's strength may be measured in two different ways: (1) inherent strength, resulting from the mark's degree of inherent distinctiveness, usually measured on the ladder ranging from unprotectable generic marks to arbitrary, fanciful marks that enjoy the broadest protection, *see Abercrombie*, 537 F.2d at 9-11; and (2) acquired strength, reflecting the degree of consumer recognition the mark has achieved. Because trademark law historically disfavored a grant of exclusive rights to descriptive marks, the Lanham Act's compromise allowed descriptive marks registration and a minimal scope of protection, which is contingent on establishing that the mark has acquired a secondary meaning. *TCPIP Holding Co. v. Haar Commc'ns, Inc.*, 244 F.3d 88, 100 (2d Cir. 2001).

Heritage's marks are descriptive and therefore weak marks, absent a showing that they have acquired secondary meaning.

2. Similarity of the Marks

Although courts compare conflicting marks² by looking at them as a whole, rather than breaking the marks into their component parts for comparison, *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 545-46 (1920), it is appropriate in determining the question of likelihood of confusion to give greater weight to the important or "dominant" parts of a composite mark. *Kangol Ltd. v. KangaROOS U.S.A., Inc.*, 974 F.2d 161, 163 (Fed. Cir. 1992). When a mark contains both a design and a word, the word is generally considered to be dominant and is therefore accorded greater weight. *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156,

² The word "marks," insofar as it refers to Heritage's common law unfair competition claim, refers to "NYC PRIDE" as the organization's trade name.

1165 (Fed. Cir. 2002); *In re 1st USA Realty Prof'ls, Inc.*, 84 U.S.P.Q.2d 1581, 1586 (T.T.A.B. 2007). This is especially true when the design or image “merely augments the message conveyed by the word.” *Worthington Foods, Inc. v. Kellogg Co.*, 732 F. Supp. 1417, 1440 (S.D. Ohio 1990) (word considered dominant in a composite mark consisting of a heart-shaped design and the word, “HEARTWISE”); accord *In re Strathmore Prods., Inc.*, 171 U.S.P.Q. 766, 767-68 (T.T.A.B. 1971) (GLISTEN and tear drop design was confusingly similar to GLISS’N word mark because of phonetic and meaning identity between the two words). In assessing which features of a mark are dominant, words and their pictorial representations should not be “equated as a matter of law,” but a fact finder may equate them as a “factual matter.” *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 257 (2d Cir. 1987).

There is absolutely no question on the record before the Court that Heritage has used “NYC PRIDE” as a trade name and service mark since at least 2009. Furthermore, the public recognizes that fact. There could be no better evidence of this than the fact that, in 2011, Resnicow emailed questions to Heritage about whether a third-party flyer using the name “NYC Pride” was affiliated with Heritage. (Frederick Decl. Ex. C.) Several of Heritage’s corporate sponsors have submitted affidavits indicating that (1) those corporations equate NYC PRIDE with the slate of Pride Week events that are organized and sponsored by Heritage, and (2) it is those events with which the sponsors wish to be associated. (*See, e.g.*, Aff. of Brian Rosman; Aff. of Lauren Rodolitz; Aff. of Matthew D. Tumminello).

Matinee’s use of the name NYC PRIDE verbatim—in its email handle, its web page on the ShowClix website, and in its advertising for its events next weekend—weighs heavily in favor of finding a likelihood of confusion. Matinee’s email blasts are especially problematic; in

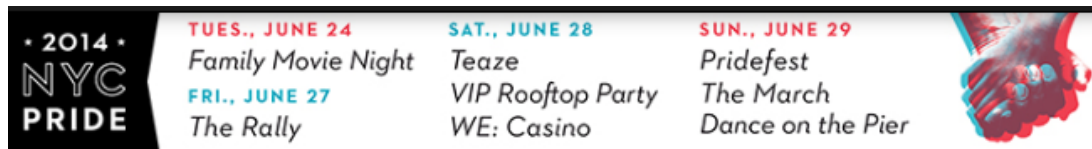
those headers, where a sender identifies itself by name and address, Defendants identify themselves as “NYC Pride.”

Where Matinee appropriates the NYC PRIDE trade name into its own logo, the resulting logo is confusingly similar artistically as well as verbally:

Matinee



Heritage



Here, both parties use the phrase “NYC PRIDE” in all caps, using substantially identical sans serif fonts. The “NYC” portions of both logos are written in an outline font, followed by the word “PRIDE” in solid lettering.³

Moreover, Matinee’s use of the NYC PRIDE name together with additional words or marks does not alter the confusing nature of Matinee’s misuse, and in many instances serves only to exacerbate confusion. *See, e.g., A.T. Cross Co. v. Jonathan Bradley Pens, Inc.*, 470 F.2d 689, 692 (2d Cir. 1972) (finding addition of “by Bradley” did not prevent confusion between plaintiff’s protected “Cross” pens and defendant’s “LaCross by Bradley” pens); *Rodgers v. Wright*, 544 F. Supp. 2d 302, 311 (S.D.N.Y. 2008) (defendants’ spin-off musical group “First Ladies of Chic” was confusingly similar to original “Chic”); *Am. Express Co. v. Am. Express Limousine Serv.*, 772 F. Supp. 729, 733 (E.D.N.Y. 1991) (finding the defendant’s addition of “Limousine Services” to the plaintiff’s “American Express” mark enhanced rather than dispelled confusion). Nor does Matinee’s substitution of “New York City” or “New York” in place of the abbreviation “NYC” help its case, because commonly known abbreviations, particularly geographic locations, and their expanded forms are treated the same. *See New York City Triathlon*, 704 F. Supp. 2d at 305.

Finally, Matinee sells its tickets at confusingly similar subdomains of the same online ticket vendor that Heritage uses for its NYC PRIDE events. Heritage’s tickets are sold at nycpride.showclix.com and www.showclix.com/events/nycpride, while Matinee’s tickets are sold at www.showclix.com/event/nycpride. ShowClix is a general use ticket vendor, and both

³ At today’s hearing, Defendants represented that they had removed the confusingly similar logo from their web sites, which, they believed, mooted Heritage’s application for an injunction. Having looked at Defendants’ proposed new logo, I opined that it, too, was confusingly similar to Heritage’s logo—especially as its reference to NYC PRIDE, in bold capital letters, is at least 20 times larger than any reference to any of the Defendants.

parties' addresses use the term "nycpride." Nothing in Matinee's URL for ticket sales indicates that the link leads to Matinee's events rather than NYC PRIDE's events.

This factor weighs heavily in favor of finding a likelihood of confusion.

3. Competitive Proximity/"Bridging the Gap"

To be "related" for the purposes of trademark law, conflicting goods or services do not have to be in direct competition with one another. Instead, the relevant question is whether a reasonable buyer is likely to think that a defendant's goods or services are somehow connected with or sponsored by the plaintiff, due to their similar marks. *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156 (Fed. Cir. 2002). In other words, goods are "related" if customers are likely to think that the infringer's goods come from the same source as the senior user's goods, or are sponsored by, affiliated with, or connected with the senior user. *In re Save Venice New York, Inc.*, 259 F.3d 1346, 1355 (Fed. Cir. 2001).

"The term 'bridging the gap' is used to describe the senior user's interest in preserving avenues of expansion and entering into related fields." *C.L.A.S.S. Promotions, Inc. v. D.S. Magazines, Inc.*, 753 F.2d 14, 18 (2d Cir. 1985). One court in this District has explained "bridging the gap" in the following way: "In the likelihood of confusion context, 'bridging the gap' refers to two distinct possibilities. The first is that the senior user presently intends to expand his sales efforts to compete directly with the junior user The second possibility is that, while there is no present intention to bridge the gap, consumers will assume otherwise and conclude, in this era of corporate diversification, that the parties are related companies." *Lambda Elecs. Corp. v. Lambda Tech., Inc.*, 515 F. Supp. 915, 926 (S.D.N.Y. 1981).

Here, both parties are active in the same field of hosting LGBT-oriented events, including dance parties and celebrity performances, though Matinee targets specifically the gay male subset of Heritage's demographic. Moreover, both parties are hosting a multi-day slate of events

during the same three days in June, in the same city. There is no gap left to bridge in this case. Indeed, Defendants complain that all Heritage is trying to do is halt competition from a second entity that, like Heritage, is offering multiple events and a weekend pass to attendees.

But competition is precisely the point. Heritage would have no case if Matinee were promoting its slate of competing events as the “NYC Pride Week SUPREME FESTIVAL” (“SUPREME FESTIVAL” appears in Defendants’ ads). But instead, Defendants blatantly suggest that there is some connection between Heritage’s “festival” events, which are offered under the organization’s trade name NYC PRIDE, and Matinee’s own competing slate of events. The fact that Matinee is trying to pass off its events as being affiliated with Heritage in a case where there is no gap to bridge (because Matinee and Heritage are direct competitors) makes the case that this factor favors Heritage all the more compelling.

4. Actual Confusion Between Products and Services

The “actual confusion” factor asks whether there is evidence of “consumer confusion that enables a seller to pass off his goods as the goods of another.” *Sports Authority, Inc. v. Prime Hospitality Corp.*, 89 F.3d 955, 963 (2d Cir. 1996) (internal quotations and citation omitted). Courts in this Circuit have held that a single instance of actual confusion is insufficient to find for the plaintiff under the “actual confusion” factor of the *Polaroid* test. *See, e.g., Nora Beverages, Inc. v. Perrier Group of Am., Inc.*, 269 F.3d 114, 124 (2d Cir. 2001). But this factor, like the others in the *Polaroid* test, is not dispositive, and a plaintiff need not prove any instances of actual confusion in order to show *likelihood* of confusion. *Centaur Commc’ns, Ltd. v. A/S/M Commc’ns, Inc.*, 830 F.2d 1217, 1227 (2d Cir. 1987). Moreover, as the Second Circuit explained in *Centaur*, where the parties are both in a market for a short time—in that case, four months—the lack of instances of actual confusion “is not especially significant.” *Id.* at 1227.

Here, over a relatively short period of time, there has already been actual confusion, even among the most sophisticated of consumers. Multiple sources, including BuzzFeed’s LGBT editor and the NYC-focused music blog “Brooklyn Vegan,” have made comments and posted stories indicating that controversial performer Azealia Banks—who has been heavily criticized for her recent homophobic comments directed at a well-known gay blogger—is performing at NYC PRIDE, when she is in fact a Matinee headliner. In this era of instant communications, this mistaken belief has been taken up on Twitter by a number of outraged individuals. (*See supra*; Compl. ¶ 39.)

This factor favors Heritage.

5. Good Faith

In determining a defendant’s intent, “actual or constructive knowledge” of the prior user’s mark or dress may indicate an absence of good faith or bad faith. *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 259 (2d Cir. 1987). In particular, where such prior knowledge is accompanied by similarities so strong that it seems plain that deliberate copying has occurred, the Second Circuit has upheld a finding of bad faith. *Id.* at 258-59. Put differently, where a junior user intentionally copies a mark, a presumption of bad faith arises. *Paddington Corp. v. Attiki Imps. & Distribs., Inc.*, 996 F.2d 577, 586 (2d Cir. 1993). But this presumption may be overcome with evidence that a defendant conducted a trademark search before using the mark, or that a defendant sought and relied on the advice of counsel; the mere fact that a defendant was aware of a plaintiff’s mark is not necessarily inconsistent with a defendant’s good faith. *See id.* Bad faith has also been found where a defendant adopts or uses a mark with the goal of capitalizing on the plaintiff’s reputation and goodwill through any confusion or deception. *Kadant, Inc. v. Seeley Mach., Inc.*, 244 F. Supp. 2d 19, 32 (N.D.N.Y. 2003) (finding

bad faith where defendant's company used mark in same industry and within same geographic area as plaintiff).

Here, Heritage has more than amply demonstrated Matinee's bad faith. As explained above, since Heritage declined to enter into a promotional partnership venture in connection with this year's Pride Week events, Matinee has been systematically attempting to siphon off Heritage's public good will. I do not credit Brandon Voss's testimony that he and Christopher Frederick had conversations about a Friday night Pride Week concert featuring Robyn after their abortive effort to co-promote a Saturday night Pride Week concert, and I do not believe that Voss had any authority, or believed that he had any authority, to send the March 15 letter to Robyn's agent incorporating Heritage's registered trademark and trade name. I think, rather, that he was belatedly engaged in a desperate effort to come up with an event that Heritage might like to sign onto.

After Voss sent that letter, the parties engaged in discussions that proved fruitless. Once talks broke down, Matinee's various misuses of the NYC PRIDE Marks (its website address, email advertisements, and logos) accelerated. Indeed, Matinee has actually represented itself as an organization called "NYC Pride" on at least two occasions, and has featured Heritage's trade name over its own office address in an email blast. (Compl. ¶ 34; *id.* Ex. B.)

In short, the record is replete with evidence that Matinee has acted in bad faith. This factor weighs heavily in favor of finding a likelihood of confusion.

6. Quality of Matinee's Products or Services

The "quality of goods and services" factor "generally considers whether the senior user's reputation could be tarnished by inferior merchandise [or services] of the junior user." *Cadbury Beverages, Inc. v. Cott Corp.*, 73 F.3d 474, 483 (2d Cir. 1996) (internal quotations omitted). However, the comparative difference in the quality of the products offered by a plaintiff and

defendant is one of the less probative factors in a determination of the likelihood of confusion. *Virgin Enters. Ltd. v. Nawab*, 335 F.3d 141, 151 (2d Cir. 2003). As the Second Circuit has explained, differing quality really goes more to the harm that confusion can cause than it does to the likelihood of confusion itself. *Id.* at 152.

Here, Matinee’s events may not be inferior in certain senses, but there is no question that Azealia Banks is a controversial performer, and Heritage chooses to avoid controversy. Contrary to Matinee’s argument, the fact that Heritage eschews controversy is a “business standard” that Heritage touts—and that renders use of a controversial performer an unacceptable variation from its standards. This factor favors Heritage.

7. Sophistication of Consumers

The last *Polaroid* factor—the inquiry into consumer sophistication—“considers the general impression of the ordinary purchaser, buying under the normally prevalent conditions of the market and giving the attention such purchasers usually give in buying that class of goods.” *Star Indus., Inc. v. Bacardi & Co.*, 412 F.3d 373, 390 (2d Cir. 2005) (internal quotations and citation omitted). The less sophisticated the average consumer of a product, the more likely that similarity in trademarks will result in confusion. *Home Shopping Club, Inc. v. Charles of Ritz Group, Inc.*, 820 F. Supp. 763, 772 (S.D.N.Y. 1993). Further, where the relevant market contains a range of amateur and experienced consumers, and a “highly sophisticated consumer” actually confused the parties’ goods or services, then this factor favors a likelihood of confusion. *New York City Triathlon*, 704 F. Supp. 2d at 320.

Here, there will be well over a million (and possibly over two million) attendees at NYC PRIDE events this year, who will necessarily run the gamut of sophistication, given the public nature of NYC PRIDE’s events and its stated goal of celebrating diversity and inclusiveness—even including those who overtly abhor homosexuality, such as the Catholic League, which

Heritage has permitted to participate in the March. (*See* Compl. ¶ 1, Ex. D, at 9, Ex. F, at 31.) In light of NYC PRIDE’s global appeal, attendees at NYC PRIDE events will necessarily range from first-time visitors to native New Yorkers. Thus, a significant number of attendees will likely be unfamiliar with NYC PRIDE and will tend to rely on signals such as trademarks to inform them about which events are affiliated with NYC PRIDE, whose events they came to see.

Further, the evidence of actual confusion includes consumers who are extremely sophisticated, including in an article from the prominent New York City music blog Brooklyn Vegan, and from individuals who had prior familiarity with NYC PRIDE. Apparently, sophistication does not shield individuals from confusion where, as here, the misappropriation of Heritage’s trade name and logo is so blatant. This factor favors Heritage.

B. Weighing the Polaroid Factors

Having entered findings as to each *Polaroid* factor, the Court must determine how much weight to give to each. The Second Circuit has counseled that “no single *Polaroid* factor is determinative,” *Plus Prods. v. Plus Discount Foods, Inc.*, 722 F.2d 999, 1004 (2d Cir. 1983), but the first three factors—strength of the plaintiff’s mark, similarity of the marks, and closeness of the good or services—are “perhaps the most significant.” *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 258 (2d Cir. 1987). Additionally, the absence of certain factors (alone or in combination) does not automatically mean there is no likelihood of confusion. *Id.* at 259-60; *Centaur Commc’ns, Ltd. v. A/S/M Commc’ns, Inc.*, 830 F.2d 1217, 1227 (2d Cir. 1987). Finally, the list of *Polaroid* factors does not exhaust the possibilities—the Court is still at liberty to take additional variables into account. *Physicians Formula Cosmetics, Inc. v. West Cabot Cosmetics, Inc.*, 857 F.2d 80, 85 (2d Cir. 1988).

As explained above, the Court finds that seven of the eight *Polaroid* factors favor Heritage. Heritage’s mark is descriptive and is therefore entitled to limited protection under the

Lanham Act, especially considering how close the secondary meaning question is. But given the similarity of the parties' marks, the closeness of the goods and services they offer, and Matinee's obvious bad faith, the Court finds that these three factors weigh strongly in favor of a finding of likely confusion between the marks. As to the fourth factor, there can be no question about Matinee's intent to bridge the gap, since both Heritage and Matinee offer overlapping services (LGBT-oriented entertainment services). And the remaining factors—actual confusion and sophistication of consumers—also weigh in favor of Heritage.

Accordingly, the Court finds that the *Polaroid* factors compel a finding of a likelihood of confusion between Heritage's and Matinee's marks.

C. Bad Faith

The standard for "bad faith" as an element of a New York unfair competition claim is indistinguishable from that of the corresponding *Polaroid* factor. *See New York City Triathlon, LLC v. NYC Triathlon Club, Inc.*, 704 F. Supp. 2d 305, 325 (S.D.N.Y. 2010); *Tri-Star Pictures, Inc. v. Unger*, 14 F. Supp. 2d 339, 364 (S.D.N.Y. 1998).

Here, as explained above, Heritage has provided ample evidence of Matinee's bad faith. Since March 2014, when Heritage passed them over as promoter for NYC PRIDE's official Saturday night event, Defendants have been attempting to claim Heritage's public goodwill as their own by, in essence, claiming to *be* NYC PRIDE. Heritage has established a likelihood of success on this element of its unfair competition claim.

III. Heritage Will Suffer Irreparable Harm If Preliminary Relief Is Not Granted.

"A showing of irreparable harm is the single most important prerequisite for the issuance of a preliminary injunction." *Faiveley Transp. Malmo AB v. Wabtec Corp.*, 559 F.3d 110, 118 (2d Cir. 2009) (citation omitted). "Irreparable harm 'exists in a trademark case when the party seeking the injunction shows that it will lose control over the reputation of its trademark pending

trial,’ because loss of control over one’s reputation is neither ‘calculable nor precisely compensable.’” *New York City Triathlon, LLC v. NYC Triathlon Club, Inc.*, 704 F. Supp. 2d 305, 343 (S.D.N.Y. 2010) (quoting *Power Test Petroleum Distribs., Inc. v. Calcu Gas, Inc.*, 754 F.2d 91, 95 (2d Cir. 1985)). “Furthermore, although irreparable harm may not be presumed upon a showing of likelihood of success on the merits, a party’s demonstration of a likelihood of success on an infringement claim often foretells a finding of irreparable harm.” *Juicy Couture, Inc. v. Bella Int’l Ltd.*, 930 F. Supp. 2d 489, 503 (S.D.N.Y. 2013) (internal citation omitted).

The question of irreparable harm dominated much of the preliminary injunction hearing, and it is a close one. However, while the balance tips only slightly in Heritage’s favor on this point, it does tip in its favor.

Heritage has invested substantial effort into New York’s Pride Week events over the past 30 years, and has amassed substantial goodwill and a very favorable reputation during this time. That favorable reputation is grounded in large measure on its avoidance of controversy and on keeping the goodwill of all constituencies within the very diverse LGBT community. Indeed, controversy is antithetical to the organization’s mission, which is to support and celebrate a set of historically disenfranchised minority groups.

Defendants, who cater to only one segment of that community (albeit a segment to which Heritage also caters), are, by contrast, content to generate controversy. They have done so by selecting Azealia Banks to headline their principal concert event. This has caused prominent members of the LGBT community—including individuals who cover that community in the press—to criticize NYC PRIDE. Heritage has submitted several affidavits from its corporate sponsors indicating that controversy might cause them to reevaluate their relationship with

Heritage, since they value the organization’s “superb record” of delivering “quality events and advancing the cause of equal rights for the LGBT community.” (Aff. of Lauren Banks ¶ 6.)

Admittedly, those same sponsors appear to have had little difficulty sponsoring Los Angeles’ Gay Pride celebration—at which Azealia Banks appeared (and, according to internet reports, apologized for the remark than engendered the controversy)—so it would be difficult to infer that sponsors will cut their ties to Heritage and Pride Week. (*See* Supplemental Aff. of Jake Resnicow ¶¶ 6-8.) But it is not difficult to infer that NYC PRIDE’s corporate sponsors are paying good money to affiliate themselves with the slate of events put on by Heritage during Pride Week in New York City—indeed, that is the tenor of their testimony. (*See, e.g.*, Aff. of Lauren Banks ¶ 6; Aff. of Matt Tumminello ¶4.) Heritage’s sponsors value their association with an organization that they believe “enhances our clients’ reputations within the LGBT community and helps demonstrate clients’ commitments to equality for LGBT people.” (Aff. of Matt. Tumminello ¶ 5.) It does not take a genius to intuit that controversy is anathema to advertisers; we see it in the marketplace every day. Any prospective loss of goodwill from controversy surrounding a performer wrongly believed to be sponsored by Heritage supports a finding of irreparable harm. *See Tom Doherty Assoc. v. Saban Entm’t, Inc.*, 60 F.3d 27, 37-38 (2d Cir. 1995).⁴

Matinee argues that Heritage’s “delay” in seeking a preliminary injunction precludes a finding of irreparable harm. Delay in seeking a preliminary injunction can weaken a claim of irreparable harm because “the failure to act sooner undercuts the sense of urgency that ordinarily accompanies a motion for preliminary relief.” *Tough Traveler, Ltd. v. Outbound Prods.*, 60 F.3d

⁴ I reject as unproven Heritage’s suggestion that the fact that Defendants cater solely to the gay male segment of the LGBT community threatens it with loss of goodwill.

964, 968 (2d Cir. 1995). Prior to the Second Circuit’s decision in *Salinger*, a finding of delay defeated the presumption of irreparable harm. *See, e.g., Weight Watchers Int’l. Inc. v. Luigino’s, Inc.*, 423 F.3d 137, 144 (2d Cir. 2005). Now that courts may not presume irreparable harm, however, “the effect of a finding of delay is uncertain.” *Juicy Couture, Inc. v. Bella Int’l Ltd.*, 930 F. Supp. 2d 489, 504 (S.D.N.Y. 2013).

However, although Heritage could have acted more swiftly, the record here does not support a finding of unconscionable delay. Matinee engaged in a single blatant act of passing itself off as affiliated with NYC PRIDE in mid-March 2014, but the bulk of the materials that Heritage identifies as offensive—which it characterizes as “categorically different” from Defendants’ earlier advertising materials—were not generated until May. Heritage commenced this lawsuit on June 10, after settlement negotiations broke down.

IV. The Balance of Hardships Favors an Injunction.

The balance of hardships in this case favors Heritage. Heritage has been wrongly characterized in the LGBT press and on Twitter feeds; Defendants have simply behaved badly. Defendants’ offer to remove Heritage’s logo from their advertising and promotional materials for next week’s events indicates that they will not be unduly inconvenienced (and any such inconvenience would be their own fault). As stated by the Court, Defendants’ proposed substitute logo is far too similar to the one it purports to replace for this Court not to view it as another instance of bad faith and unfair competition.

V. The Public Interest Favors an Injunction.

Finally, the Court must consider the public interest. *See Salinger*, 607 F.3d at 82. In this case, the public has an interest in not being deceived—in being assured that the mark it associates with a product is not attached to goods of unknown origin and quality. *See SK&F, Co. v. Premo Pharm. Labs., Inc.*, 625 F.2d 1055, 1067 (3d Cir. 1980); *Nat’l Rural Elec. Co-op Ass’n*

v. National Agr. Chemical Ass’n, 26 U.S.P.Q.2d (BNA) 1294, 1299 (D.D.C. 1992).

Accordingly, the public interest would not be disserved by an injunction.

VI. A Bond Is Not Required.

It is well-settled that a district court has “wide discretion in the matter of security and it has been held proper for the court to require no bond where there has been no proof of likelihood of harm.” *Doctor’s Assocs., Inc. v. Stuart*, 85 F.3d 975, 985 (2d Cir. 1996) (internal quotations and citation omitted). In this case, Matinee has not requested a bond in its opposition papers, nor has it demonstrated that it will likely suffer any harm absent the posting of a bond.

For these reasons, I grant Heritage’s motion for a preliminary injunction.

* * *

VII. Heritage Has Shown a Likelihood of Success on the Merits of Its Lanham Act, GBL § 133 and Common Law Trademark Claims.

It is not really necessary to go any further in order to enter a preliminary injunction in this case. However, Heritage has also established a likelihood of success on the merits of its various claims that require proof that its registered and common law trademarks have acquired secondary meaning—though on that issue, the question is much closer.

A. Elements of the Claims at Issue

Section 32 of the Lanham Act prohibits the use in commerce, 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,” in a way that is likely to cause confusion with plaintiff’s registered trademarks. 15 U.S.C. § 1114(1)(a). Section 43(a) is a broad federal unfair competition provision. It prohibits any misrepresentation likely to cause confusion about the source of a product or service, in particular the use by any person of

any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin . . . likely to cause confusion, or to cause mistake, or to

deceive as to the affiliation, connection, or association . . . 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); *see also Chambers v. Time Warner, Inc.*, 282 F.3d 147, 155 (2d Cir. 2002).

“Section 43(a), and unfair competition law in general, function primarily to protect consumers from confusion as to the source of goods in the market.” *Bi-Rite Enters., Inc. v. Button Master*, 555 F. Supp. 1188, 1193 (S.D.N.Y. 1983) (collecting cases). Section 43(a) protects unregistered as well as registered marks. *Warner Bros., Inc. v. Am. Broadcasting Co.*, 530 F. Supp. 1187, 1197 (S.D.N.Y. 1982).

The elements of the two types of Lanham Act claims are substantially identical, so courts generally examine them together. *Gucci Am., Inc. v. Action Activewear, Inc.*, 759 F. Supp. 1060, 1063 (S.D.N.Y. 1991); *GMA Accessories, Inc. v. Croscill, Inc.*, No. 06-cv-6236, 2008 WL 591803, at *3 n.2 (S.D.N.Y. Mar. 3, 2008) (“The legal standards governing § 1114(1)(a) and § 1125(a) claims are identical.”).

A trademark, as defined in 15 U.S.C. § 1127, includes “any word, name, symbol, or device, or any combination thereof” used by any person “to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” In order to be registered, a mark must be capable of distinguishing the applicant’s goods from those of others. 15 U.S.C. § 1052.

Following the classic formulation set out by Judge Friendly, marks are classified into five categories, in order of increasing distinctiveness: (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary, or (5) fanciful. *See Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976). “The latter three categories of marks, because their intrinsic nature serves to identify a particular source of a product, are deemed inherently distinctive and are entitled to protection.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992). By contrast, generic marks—

those that refer “to the genus of which the particular product is a species”—can never be registered as trademarks. *Abercrombie*, 537 F.2d at 9.

A descriptive mark (like “NYC PRIDE”)⁵ is not inherently distinctive and therefore only merits protection once it has acquired “secondary meaning.” *Park ‘N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 194 (1985).

To state a claim for trademark infringement under the Lanham Act, a plaintiff must show that (1) it has a valid trademark entitled to protection, and (2) the defendant’s mark is likely to cause confusion in the marketplace. *See Virgin Enters. Ltd. v. Nawab*, 335 F.3d 141, 146 (2d Cir. 2003); *Heisman Trophy Trust v. Smack Apparel Co.*, 595 F. Supp. 2d 320, 325 (S.D.N.Y. 2009).

To prevail on a claim of common law trademark infringement in New York, a plaintiff must establish that (1) its mark is valid and legally protectable and (2) the defendant’s use of a similar mark is likely to create confusion as to the origin of the product. *Horn’s, Inc. v. Sanofi Beaute, Inc.*, 963 F. Supp. 318, 328 (S.D.N.Y. 1997). Likelihood of confusion in a New York common law trademark case “is judged . . . in the same manner as a Lanham Act claim.” *Nabisco, Inc. v. PF Brands, Inc.*, 50 F. Supp. 2d 188, 212 (S.D.N.Y. 1999) (citation omitted); *see also Tri-Star Pictures, Inc. v. Unger*, 14 F. Supp. 2d 339, 363 (S.D.N.Y. 1998). A common law trademark claim also requires a showing that the plaintiff’s trade name has acquired a secondary meaning. *Camelot Associates Corp. v. Camelot Design & Dev. LLC*, 750 N.Y.S.2d 155, 156 (3d Dep’t 2002). “A secondary meaning is established when it is shown that a trade name has

⁵ Geographic terms, even when coupled with a generic term, are considered descriptive rather than generic. *See New York Stock Exchange, Inc. v. New York, New York Hotel, LLC*, 293 F.3d 550, 557 (2d Cir. 2002) (“New York” plus generic term “stock exchange” was descriptive). All parties concede the descriptive nature of Heritage’s purported marks.

become so associated in the public's mind with the plaintiff that it identifies goods sold by that entity as distinguished from goods sold by others." *Adirondack Appliance Repair, Inc. v. Adirondack Appliance Parts, Inc.*, 538 N.Y.S.2d 118, 120 (3d Dep't 1989).

Finally, N.Y. Gen. Bus. Law § 133 prohibits the adoption for purposes of trade, with intent to deceive or mislead the public, of "any name, designation or style, or any symbol or simulation thereof, or a part of any name, designation or style, or any symbol or simulation thereof, which may deceive or mislead the public as to the identity of such person, firm or corporation or as to the connection of such person, firm or corporation with any other person, firm or corporation." To prevail under § 133, a plaintiff must show that the defendant (1) used someone else's mark, and (2) acted in bad faith to deceive the public. *L & L Wings, Inc. v. Marco-Destin, Inc.*, 676 F. Supp. 2d 179, 190 (S.D.N.Y. 2009). As with Lanham Act and common law trademark claims, a plaintiff seeking relief under § 133 must also show that its name has acquired a secondary meaning. *Gasoline Heaven at Commack, Inc. v. Nesconset Gas Heaven, Inc.*, 743 N.Y.S.2d 825, 827 (Sup. Ct. N.Y. Co. 2002). "A secondary meaning is established when the trade mark or name's primary significance to the consuming public is not the descriptive information it imparts, but the rather the mark's association with the plaintiff's services." *Id.*

B. Secondary Meaning

For our purposes, the critical issue on all three of these claims is secondary meaning; likelihood of confusion and Defendants' bad faith have already been the subject of extensive discussion, which need not be repeated here.

A mark obtains secondary meaning in one of two ways: (1) "it may be proved as a matter of fact that the mark connotes a single source of origin to the public consumer," or (2) it can be

“established through registration of a trademark.” *Gruner + Jahr USA Publ’g v. Meredith Corp.*, 991 F.2d 1072, 1976 (2d Cir. 1993).

To determine whether a mark has obtained secondary meaning, courts in this Circuit examine six factors: (1) advertising expenditures; (2) sales success; (3) unsolicited media coverage of the product; (4) attempts to plagiarize the mark; (5) length and exclusivity of the mark’s use; and (6) consumer studies linking the mark to a source. *Tri-Star Pictures, Inc. v. Unger*, 14 F. Supp. 2d 339, 348 (S.D.N.Y. 1998) (citing *Centaur Commc’ns, Ltd. v. A/S/M Commc’ns, Inc.*, 830 F.2d 1217, 1221 (2d Cir. 1987)). None of these factors alone is dispositive in determining secondary meaning, nor is it necessary for a party to prove every element in order to establish secondary meaning. *Id.*

1. Advertising Expenditures/Sales Success

Heritage has spent a tremendous amount of time, effort, and money since 1984, when it took over the production of the Pride March and Stonewall Rally, to promote these events and to couple them with a multi-day roster of events celebrating LGBT pride. It has found corporate sponsors to cover the cost of producing those events, including Coca-Cola, Delta Airlines, Netflix, Budweiser, NBC, Whole Foods, Macy’s, Wells Fargo, MasterCard, Citi, and HSBC, among others. The affidavits that Heritage has gathered from sponsors and ad placement firms confirm that these sponsors value their association with *Heritage*, not simply with Pride Week.

Heritage can also boast a large following among the public: the organization’s website had over 419,000 unique visitors in June 2011; its Facebook page has over 51,000 “likes” (making it the most liked “Pride” page in the Western Hemisphere); and its Twitter account has over 13,000 followers.

These facts support Heritage’s claim that its marks, logos, and trade name have acquired secondary meaning.

2. Unsolicited Media Coverage of the Product

This factor, too, supports a finding of secondary meaning. Every year, Pride Week brings with it extensive, unsolicited press coverage of Heritage-sponsored events—especially the Pride March. *See, e.g.*, David Dunlap, *A Gay Pride March With Added Spring in Its Step*, THE NEW YORK TIMES (June 30, 2013), *available at* <http://www.nytimes.com/2013/07/01/nyregion/a-gay-pride-march-with-added-spring-in-its-step.html>; Stella Bugbee, *Stylish Moments From the Gay Pride Parade in New York*, NEW YORK MAGAZINE (June 25, 2012), *available at* <http://nymag.com/thecut/2012/06/stylish-moments-from-new-yorks-gay-pride-parade.html>; Derek Storm, *Gay pride parade marks one year anniversary of New York's same-sex marriage law*, NEW YORK POST (June 24, 2012), *available at* <http://nypost.com/2012/06/24/gay-pride-parade-marks-one-year-anniversary-of-new-yorks-same-sex-marriage-law/>.

3. Attempts to Plagiarize the Mark

As discussed extensively above, the credible evidence in this case admits of but one inference—Matinee is trying to capitalize on Heritage’s public goodwill, which it went to great lengths to expropriate when Heritage chose to deal with a different Saturday night concert partner. From adopting a virtually identical domain name on ShowClix, the ticket sales domain on which Heritage sells tickets to its Pride Week events (www.showclix.com/events/nycpride (Heritage) vs. www.showclix.com/event/nycpride (Matinee)), to using a logo for its concert series that looks suspiciously like the logo that Heritage has chosen to advertise this year’s NYC PRIDE events, Matinee has blatantly attempted to plagiarize Heritage’s marks. The fact that Defendants would attempt to connect themselves with Heritage in the mind of the public is strong evidence that NYC PRIDE has come to be associated by the public with the events sponsored by the organizer of the Rally and the March—Heritage.

4. Consumer Studies Linking the Mark to a Source

Heritage has not presented any consumer studies linking the name NYC PRIDE to Heritage. However, the same evidence that proves actual confusion also attests to the fact that knowledgeable members of the public—including, notably, the LGBT editor for BuzzFeed—associate the phrase “NYC PRIDE” with Heritage’s events. By criticizing NYC PRIDE for featuring “fairly notorious homophobe Azealia Banks” at this year’s concerts (which it is not) and by contrasting this purportedly unfortunate choice of artist with Cher (who *was* actually sponsored by Heritage in 2013), Saeed Jones and the other Twitter users quoted by Heritage demonstrate that they associate NYC PRIDE with the “official” presenter of Pride Week events—Heritage. (*See* Compl. ¶ 39.)

So to the extent this factor carries any weight at all, it actually weighs slightly in Heritage’s favor.

5. Length and Exclusivity of the Mark’s Use

This may not be the determinative factor, but it is a very important one—and here, the question is especially close.

Heritage has demonstrated that it has used “NYC PRIDE” for many years in connection with the events of Pride Week and other events it has sponsored for the LGBT community (although it seems that those are few in number). It has also established, without refutation, that it adopted the phrase “NYC PRIDE” as its trade name as long ago as 2009, and that in its dealings with Defendants, its sponsors, and the public, that name has come to be associated with the entity that sponsors the principal events of New York Pride Week.

However, as Defendants have shown, and as Heritage concedes, throughout Pride Month—and especially during Pride Week—numerous commercial establishments use the phrase “NYC Pride” to describe events that they are sponsoring during the week-long

celebration. Indeed, Heritage admits that, because NYC PRIDE is a descriptive mark, there would be no way to stop, say, a West Village watering hole from having an NYC PRIDE Happy Hour during the last week of June. And although Heritage has operated under the trade name NYC PRIDE for at least five years, and possibly longer, it has taken no steps until now to stop anyone else from using the phrase for commercial purposes.

As a result, this case is not precisely analogous to *NYC Triathlon*, in which there was for many years one and only one race known as the NYC Triathlon, such that the name became associated with that event and with no other triathlon that was run in the greater New York City area. *See New York City Triathlon, LLC v. NYC Triathlon Club, Inc.*, 704 F. Supp. 2d 305, 330 (S.D.N.Y. 2010). Although there is one and only one Pride March, there have always been events during Pride Week, a few of which were put on by Heritage, most of which were not—they were simply celebrations of gay pride that took place during Pride Week in New York City.

It does, however, appear that, until now, Heritage has enjoyed the exclusive use of the NYC PRIDE moniker (and certainly the logos it has registered with the PTO and used to advertise its events) to describe a *series* of Pride Week events. Although Defendants point to numerous “one-off” events that include the phrase New York or NYC Pride in their titles, until this year there was no other single-source “festival” of events during Pride Week other than the single-source “festival” of events sponsored by Heritage. In that sense, Heritage’s use of the phrase was exclusive for many, many years—during which time one of the defendants, Matinee, became a “promotional partner” of Heritage, albeit for a non-Pride Week concert.

There are, therefore, reasons to conclude that Heritage’s marks are not exclusive, and at least one reason to conclude that they are. The other factors, however, tilt more decisively in Heritage’s favor. On balance, I conclude that Heritage has demonstrated a likelihood—not,

perhaps, an overwhelming likelihood, but a likelihood—of success in establishing that its marks carry secondary meaning. And that is all it must do at this juncture: “make a showing that the probability of his prevailing is better than fifty percent.” *Abdul Wali v. Coughlin*, 754 F.2d 1015, 1025 (2d Cir. 1985).

I have already concluded that Heritage is likely to succeed in proving actual confusion as a result of Defendants’ use of its name, mark and logos, and that Defendants acted in bad faith and with an intent to associate their events with plaintiffs’ events in the public mind. For these reasons, I am prepared to grant the motion for a preliminary injunction on these grounds as well.

CONCLUSION

For the foregoing reasons, Heritage’s motion for a preliminary injunction is granted.

Dated: June 20, 2014



U.S.D.J.

BY ECF TO ALL COUNSEL