**UNITED STATES DISTRICT COURT**
**SOUTHERN DISTRICT OF FLORIDA**

**CASE NO. 09-20408-CIV-ALTONAGA/Brown**

**TARDIEU GROUP, INC.**, a Florida corporation,

Plaintiff,

vs.

**MEC APPAREL GROUP, INC.**, a Florida corporation; **BEN CIURARU**, an individual; and **PIERRE BENITAN**, an individual,

Defendants.
____________________________________/

**ORDER**

THIS CAUSE came before the Court for a hearing on April 28, 2009 on a Motion for Temporary Restraining Order and Preliminary Injunction ("Motion") [D.E. 12], filed earlier by Plaintiff, Tardieu Group, Inc. ("Tardieu"). The Court has carefully considered the parties' written submissions and oral arguments, as well as the applicable law.

## I. BACKGROUND

This case involves allegations of trade dress infringement, copyright infringement, and unfair trade practices. Tardieu is in the business of designing and selling men's button-down tailored shirts under the Bogosse brand name. (*See* Complaint ("*Compl*.") [D.E. 1] at ¶ 9). Tardieu has sold thousands of shirts at retail stores across the nation and around the world. (*See id*. at ¶ 11). Bogosse shirts have a specific design of features, including:

- square buttons;
- wide-set collars;
- stacked buttons on the front placket of the shirt;
- buttons on the sides of the collars and on the back of the collar;

- contrasting fabric on the inside collar, cuffs, and front placket of the shirt;
- the appearance of the G (stylized) mark on a small black fabric square placed underneath the second set of buttons on the left front placket of the shirt; and
- contrasting color stitching, buttons, and button holes.

(*See id*. at ¶ 12).

Tardieu markets Bogosse shirts to men who wish to appear well-traveled, affluent, and successful. (*See id*.). Tardieu has been selling Bogosse shirts for approximately five years, and has met with great commercial success. (*See id*. at ¶ 13). Bogosse shirts have been featured in international fashion shows and numerous magazines, and written about in various publications. (*See id*. at ¶¶ 14-16). Bogosse shirts have been the subject of several online blogs, and have been worn by several celebrities. (*See id*. at ¶¶ 17- 20).

The homepage of the Bogosse website features a photograph of a man wearing a Bogosse shirt. (*See id*. at ¶ 24). Tardieu received all rights, title and interest in the photograph by assignment from the author. (*See id*. at ¶ 26). Tardieu owns the copyright to the photograph, and has had the copyright registered. (*See id*. at ¶¶ 27-28).

In October 2008, Defendant, MEC Apparel Inc.'s ("MEC['s]") President, Ben Ciuraru ("Ciuraru"), and Vice-President, Pierre Benitan ("Benitan"), traveled to Istanbul, Turkey, and visited the showroom of Tardieu's current manufacturer, Armateks, Ltd. (*See id*. at ¶ 33). Through a local agent, Defendants asked Armateks to manufacture Bogosse shirts for MEC. (*See id*. at ¶ 34; *see* Affidavit of Savas Kaya ("*Kaya Aff*.") [D.E. 13-4] at 2). Armateks refused to produce Bogosse shirts for MEC.[1] (*See id*.). Defendants then approached Tardieu's former manufacturer; that manufacturer

[1] There is some dispute concerning the trip to Istanbul. Ciuraru insists he did not go to Istanbul and approach the Armateks manufacturer in an effort to duplicate Bogosse shirts. (*See* Affidavit of Ben Ciuraru ("*Ciuraru Aff*.") [D.E. 25-7] at ¶¶ 14-15). Rather, Ciuraru claims that Istanbul is a main source for clothing

is currently manufacturing shirts for the Defendants. (*See Compl.* at ¶ 36).

Thus, several years after Bogosse had been in business and had achieved public recognition, Defendant, MEC, began to manufacture shirts identical, or nearly identical, to Bogosse shirts. (*See Compl.* at ¶ 29). The MEC shirts are being sold at a lower wholesale price than Bogosse shirts. (*See id.*). Defendants are selling their shirts in similar trade channels through which the Bogosse shirts are sold. (*See id.*). Tardieu has experienced difficulty in selling its shirts since Defendants have been selling their near-identical shirts. (*See id.* at ¶ 52). Defendants also reproduced the copyrighted photograph belonging to Tardieu and placed the photograph on the MEC website. (*See id.* at ¶ 45). The photograph is no longer on MEC's website. (*See id.* at ¶ 54).

Tardieu filed suit against MEC in a six count Verified Complaint, alleging: (1) Count I – federal trade dress infringement under 15 U.S.C. § 1125(a); (2) Count II – false designation of origin under 15 U.S.C. § 1125(a); (3) Count III – unfair competition under 15 U.S.C. § 1125(a); (4) Count IV – copyright infringement under 17 U.S.C. § 501; (5) Count V – violations of the Florida Deceptive and Unfair Trade Practices Act ("FDUTPA"), Fla. Stat. 501.201 *et seq.*; and (6) Count VI – common law unfair competition. Tardieu presently moves for a temporary restraining order and preliminary injunction against MEC, seeking to enjoin MEC from:

> 1) Using, reproducing, creating derivative works from and otherwise infringing the Bogosse® Photo and/or any other photographs which are owned by Tardieu Group;
>
> 2) Using, reproducing, and copying the distinctive and nonfunctional elements of the Bogosse® Trade Dress in Defendants' Infringing Shirts;
>
> 3) Using any colorable imitations of the Bogosse® Trade Dress and/or any trade

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production, and he chose Vizon, Bogosse's former manufacturer, based on its reputation. (*See id.* at ¶ 14). He further claims Armateks did not refuse to produce shirts for MEC. (*See id.* at ¶¶ 15-16).

dress confusingly similar thereto; and

4) Otherwise deceptively and/or unfairly competing with Tardieu Group.

(Plaintiff's Motion for Temporary Restraining Order and Preliminary Injunction ("*Plaintiff's Mot.*") [D.E. 12] at 1-2).

In support of its Motion, Tardieu filed affidavits by Anael Francillon ("Francillon"), Savas Kaya ("Kaya"), and Sandrine Santana ("Santana"). For a long time, Francillon has purchased Bogosse shirts. (*See* Affidavit of Anael Francillon ("*Francillon Aff.*") [D.E. 13-3] at ¶ 3). He stated he was in a restaurant in Miami, wearing a Bogosse shirt, when he noticed two men wearing what appeared to be Bogosse shirts. (*See id.* at ¶¶ 5-6). Francillon approached the men, complimented them on their shirts, and told them he knew who made them: Bogosse. (*See id.* at ¶¶ 7-9). One of the men, who had introduced himself as Pierre, said the shirts were not Bogosse, but his company's, MEC, and that Bogosse had copied the MEC shirts which had been manufactured for the past 15 years. (*See id.* at ¶¶ 10-12). Upon closer inspection, Francillon stated he could see that the shirts were of a lesser quality in fabric and stitching than a Bogosse shirt. (*See id.* at ¶ 11).

Kaya, the Managing Partner of Armateks – the company that manufactures Bogosse shirts for Tardieu – stated that a man representing MEC Apparel came to his showroom and asked Kaya to manufacture Bogosse shirts for them. (*See Kaya Aff.* at ¶¶ 4-6). Kaya refused and told them to leave his showroom. (*See id.* at ¶ 7).

Santana stated that while working as a sales representative for a local magazine, she went to a salon to solicit advertising sales. (*See* Affidavit of Sandrine Santana ("*Santana Aff.*") [D.E. 13-5] at ¶¶ 1-2). While there, she mentioned that Bogosse advertised in the magazine. The manager of

the salon told her that he was "'doing the same thing as BOGOSSE®.'" (*Id*. at ¶ 7) The manager went on to tell her that his uncle manufactures shirts that look like Bogosse, and that his idea had been to "'copy the design, sell it cheaper and target a more affordable clientele.'" (*Id*. at ¶ 9).

At the April 28, 2009 hearing, Tardieu produced several shirts manufactured by Tardieu and several manufactured by MEC. Tardieu also presented photographs of several Bogosse and MEC shirts. On a cursory inspection, the first pair of shirts – one by Bogosse and one by MEC – looked identical. Both of the shirts had contrasting cuffs and collars, square buttons, and stacked buttons. Notably, other shirts by Bogosse did not have stacked buttons or contrasting collars and cuffs. Tardieu identified three features that appear in every Bogosse shirt: the wide-set collar, square buttons, and the "G" logo on a black fabric square placed underneath the front placket at the second button. The other Bogosse features – contrasting collar and cuffs, contrasting stitching, and collar buttons, appear only on select lines of Bogosse shirts.

## II. LEGAL STANDARD

To prevail on a motion for preliminary injunction, a plaintiff must show:

> "(1) a substantial likelihood of success on the merits of the underlying case, (2) the movant will suffer irreparable harm in the absence of an injunction, (3) the harm suffered by the movant in the absence of an injunction would exceed the harm suffered by the opposing party if the injunction issued, and (4) an injunction would not disserve the public interest."

*N. Am. Medical Corp. v. Axiom Worldwide, Inc.*, 522 F.3d 1211, 1217 (11th Cir. 2008) (quoting *Johnson & Johnson Vision Care, Inc. v. 1-800 Contacts, Inc.*, 299 F.3d 1242, 1246-47 (11th Cir. 2002)). "It is well established that '[a] preliminary injunction is an extraordinary and drastic remedy not to be granted unless the movant clearly establishe[s] the burden of persuasion' as to all four

elements." *Davidoff & CIE, S.A. v. PLD Int'l Corp.*, 263 F.3d 1297, 1300 (11th Cir. 2001) (quoting *Siegel v. LePore*, 234 F.3d 1163, 1176 (11th Cir. 2000)).

## III. ANALYSIS

Although Tardieu filed a six-count Complaint against MEC, it seeks injunctive relief only as to its claims of trade dress infringement and copyright infringement, asserting that the elements required to succeed under the other counts stating claims under Florida statutes and under common law are substantially the same as the elements for a trade dress infringement claim. (*See* Memorandum of Law ("*Mem. of Law*") [D.E. 13] at 10). Thus, the Court only examines Plaintiff's likelihood of succeeding on the two claims briefed and argued.

### A. Trade Dress Infringement

The Court begins its analysis by determining if Tardieu has shown a substantial likelihood of success on the merits of its trade dress infringement claim. "[T]o prevail on a trade dress infringement claim under § 43(a), the plaintiff must prove three elements: 1) its trade dress is inherently distinctive or has acquired secondary meaning, 2) its trade dress is primarily non-functional, and 3) the defendant's trade dress is confusingly similar." *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1535 (11th Cir. 1986) (citations omitted); 15 U.S.C. § 1125(a). "Trade dress" originally included only the packaging, or "dressing," of a product, but in recent years has been expanded by many courts of appeals to encompass the design of a product. *Wal-Mart Stores v. Samara Bros.*, 529 U.S. 205, 209 (2000).

The Eleventh Circuit has stated, "'[t]he touchstone test for a violation of § 43(a) is the likelihood of confusion resulting from the defendant's adoption of a trade dress similar to the

plaintiff's.'" *AmBrit, Inc.*, 812 F.2d at 1538 (quoting *Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 F.2d 821, 831-32 (11th Cir. 1982)). In determining whether a likelihood of confusion exists, the fact finder evaluates a number of elements including the following seven factors: (1) the strength of the trade dress, (2) the similarity of design, (3) the similarity of the product, (4) the similarity of retail outlets and purchasers, (5) the similarity of advertising media used, (6) the defendant's intent, and (7) actual confusion. *Id*. (citations omitted). The issue of likelihood of confusion is not determined by merely analyzing whether a majority of the subsidiary factors indicate that such a likelihood exists. *Id*. Rather, the Court must evaluate the weight to be accorded the individual factors and then make its ultimate decision. *Id.* The appropriate weight to be given to each of these factors will vary depending on the circumstances of each case. *Id*. Moreover, the "extent to which two marks are confusingly similar cannot be assessed without considering all seven factors to ensure that the determination is made in light of the totality of the circumstances." *Wesco Mfg., Inc., v. Tropical Attractions of Palm Beach, Inc.*, 833 F.2d 1484, 1488 (11th Cir. 1987).

1. The Strength of the Trade Dress

"The strength of the [product's] trade dress determines the scope of protection it will receive: strong trade dress receives strong protection, and weak trade dress receives weak protection. The strength of a particular trade dress is determined by a number of factors that establish its standing in the marketplace." *AmBrit, Inc.*, 812 F.2d at 1539 (citation omitted). "[T]he appropriate degree of protection is determined by examining a number of factors that establish the standing of the trade dress in the marketplace: most notably, the type of trade dress and the extent of the third party uses." *Id*. (citations omitted).

In determining the type of trade dress at issue, the undersigned must consider whether the trade dress is generic, descriptive, suggestive, or arbitrary. *Id*. The Eleventh Circuit has explained the classifications as follows:

> Generic marks refer to a particular genus or class of which an individual service [or product] is but a member; such marks may never receive . . . protection. Descriptive marks directly describe a characteristic or quality of the service [or product], and can only be protected if they have acquired "secondary meaning." "Vision Center," when used to describe a place to purchase eyeglasses, would be a descriptive name. Suggestive marks subtly connote something about the service [or product] so that a consumer could use his or her imagination and determine the nature of the service [or product]. The term "Penguin" would be suggestive of refrigerators.
>
> . . . An arbitrary or fanciful mark is a word in common usage applied to a service [or product] unrelated to its meaning; "Sun Bank" is such an arbitrary or fanciful mark when applied to banking services.

*Id*. at 1537 n.20 (quoting *Freedom Savings and Loan Assoc. v. Way*, 757 F.2d 1176, 1182 n.5 (11th Cir. 1985)). While the discussion above deals with trademark rather than trade dress, the court applied the same classifications in *AmBrit, Inc.*, a trade dress case. In *AmBrit, Inc.*, the court found that the trade dress of a Klondike Bar was suggestive as it consisted of images suggestive of coldness. *Id*. at 1539.

In this case, the trade dress consists of certain elements used in every Bogosse shirt, and certain elements used in particular lines of Bogosse shirts. The elements used in every Bogosse shirt include square buttons, a wide-set collar, and a square logo placed on the inside of the front placket beneath the second button. Many Bogosse shirts also have contrasting fabric at the cuffs and collar, contrasting stitching, buttons on the backs or sides of the collar, and stacked buttons on the cuffs and placket. The use of the design details can only be considered arbitrary, as the details are not standard in men's shirts, nor do they describe or suggest anything about the shirts. Under Eleventh Circuit

law, arbitrary trade dress is strong, and receives the most protection. *Id*.

Notably, Tardieu acknowledges that only three elements are used in every Bogosse shirt: square buttons, a wide-set collar, and the square "G" logo on the inside of the placket. Many other shirt manufacturers produce shirts with wide-set collars; this element is not at all unique to Bogosse shirts. While the square buttons and square logo may be unique to Bogosse, these two elements together and alone do not create a strong trade dress. The Bogosse shirts that utilize all of the specific design elements in conjunction do possess a noticeable trade dress; significantly, however, the Motion seeks protection for all of the Bogosse shirt designs, even the most basic, which carry only a weak trade dress.

The next factor in a trade dress strength analysis is the extent of third party use. *Id*. In *Ambrit, Inc.*, the court found that several third parties used similar images to those found on a Klondike Bar, and the trade dress was afforded less protection. *Id*. The court also found that "[u]se of isolated elements of the Klondike trade dress that do not convey the same total image does not, however, lead to the Klondike wrapper being stripped of protection." *Id*. The court determined that based on third party use, the Klondike trade dress was entitled to moderate protection.

In this case, many men's shirts use contrasting fabric at the cuffs or collar, contrasting stitching, and wide-set collars. Few men's shirts use square buttons, and fewer still use stacked, square buttons. The use of all of the design elements of a Bogosse shirt in conjunction creates a "total image" comparable to the total image in *AmBrit, Inc.*. Again, not all Bogosse shirts use all of the design elements in conjunction. Several of the Bogosse shirts shown at the hearing were indistinguishable from any other line of men's shirts. The amount of third party use of the majority

of the design features utilized by Bogosse is high, weakening the strength of its trade dress.

In sum, because Tardieu's trade dress is not strong, it is entitled to weak protection under the Lanham Act. Moreover, as MEC points out, Tardieu has only been making Bogosse shirts for five years, and while there has been some promotional buzz about the shirts in certain segments of the fashion industry, Tardieu has not shown the shirts are well-known across a wide segment of the population. These facts further weaken the strength of the trade dress, and the amount of protection it deserves.

2. The Similarity of Design

The Eleventh Circuit has described the similarity of design test as a "subjective eyeball test." *AmBrit, Inc.*, 812 F.2d at 1540. This eyeball test requires consideration of the overall impression of the trade dress as a whole rather than examining the individual elements of the trade dress. *Id.* Applying that test here, some of the MEC shirts are, at first glance, identical to the Bogosse shirts. Even those "identical" MEC shirts differ from Bogosse shirts, however, with respect to the inside label, the quality of the fabric, and the fact that the MEC shirts are cut longer and wider than Bogosse shirts. Moreover, not all of the MEC shirts are superficially identical to the Bogosse shirts. Bogosse shirts come in a variety of styles, with different mixes of features. While the similarity of design is close as to some shirts, the similarity is not at all close in others.

The Eleventh Circuit has cautioned that "a court may not view trade dress in a vacuum. Rather, a court must consider how the trade dress would function in the actual market place." *Id.* at 1541. The court has also noted that "[i]ce cream novelties are impulse items stored in frosty freezer cases and sold in busy grocery stores to hurried shoppers. When viewed in this context, the

general similarity of the design of the trade dress of the two products is an even stronger indication of the existence of likelihood of confusion." *Id.*

In this case, the shirts in question are not impulse purchases. Bogosse shirts generally retail for $200.00 to $250.00 dollars, and MEC shirts for about $150.00. The majority of consumers spending that amount of money for a shirt will likely spend some time inspecting the shirt. If a consumer wanted to buy a Bogosse shirt, he or she would not accidentally purchase a MEC shirt. The differences in size, quality, and the label itself would insure that a consumer would notice that the shirt in question is not a Bogosse, but rather a MEC shirt.

3. <u>The Similarity of the Product</u>

The similarity of the product prong is easily disposed of here: both Bogosse and MEC manufacture men's button-down shirts. The products are the same and serve the same purpose; the only differences are in design, fabric, label, and price.

4. <u>The Similarity of Retail Outlets and Purchasers</u>

Tardieu asserts that the two companies sell their products through the same channels, namely, high-end retail outlets. Tardieu further asserts that Bogosse and MEC target the same purchasers: men who want to appear fashionable and worldly. MEC claims that the two entities sell their products in very different channels. Tardieu sells worldwide, at both the retail and wholesale level. Tardieu has a website through which a consumer can buy a Bogosse shirt directly. In contrast, MEC sells only at the wholesale level, sells primarily to Florida boutiques, and does not sell directly to the public.

Likelihood of confusion is more probable when the products are sold through the same

channels. *AmBrit, Inc.*, 812 F.2d at 1541. Here, both companies sell their products to high-end boutiques. However, MEC sells only wholesale; the boutique's buyers are presumably sophisticated enough to know the difference between a Bogosse shirt and a MEC shirt, especially when the label identifies MEC. Moreover, Bogosse does a good part of its business directly through its website, whereas an individual cannot buy a MEC shirt through MEC's website. While the trade channels have some similarities, more differences than similarities exist.

5. The Similarity of Advertising Media Used

Tardieu boasts that Bogosse has achieved international recognition. It has received unsolicited press in various fashion magazines, and the shirts have been worn by numerous celebrities. Bogosse shirts have appeared on runways in international fashion shows. Bogosse advertises through its website and in print media.

MEC has no formal method of advertising. At this time, MEC's only method of advertising is by personally visiting retail stores to promote its product. While MEC has a website, it is available only to retailers and is inaccessible to the general public. The advertising methods of the two products are quite dissimilar.

6. The Defendants' Intent

Many facts suggest that MEC and its principals intended to copy the design of certain Bogosse shirts. The affidavits of Kaya and Santana reveal that MEC's founders decided they could make a shirt that looked like a Bogosse shirt and sell it for less. The use of Tardieu's copyrighted photograph of a man wearing a Bogosse shirt on MEC's website is further evidence of intent to copy. As the Eleventh Circuit has observed, "intent in adopting the [product's] trade dress is a critical

factor because a finding that [defendant] adopted the trade dress with the intent of deriving benefit from the reputation of [plaintiff's product] may alone be enough to justify the inference that there is confusing similarity." *AmBrit, Inc.*, 812 F.2d at 1542 (citation omitted).

In this case, however, intent is not dispositive of confusing similarity. Bogosse manufactures and sells a wide variety of men's shirts. MEC manufactures and sells a variety of men's shirts as well. While one style of MEC shirts looks *very* similar to one particular line of Bogosse shirts, other MEC shirts do not look like Bogosse shirts. The facts of this case are distinguishable from *AmBrit, Inc.*, where the product at issue was an ice cream bar, and the defendant packaged a new ice cream bar to resemble a longstanding, popular brand. Under *AmBrit, Inc.*'s facts, each time a consumer has a craving for an ice cream bar, he or she could mistakenly purchase the infringing brand because it looks so similar to the protected brand. Here, as discussed, it is virtually impossible for an average purchaser to mistakenly purchase a MEC shirt when he or she wants a Bogosse.

Moreover, both the Supreme Court and the Eleventh Circuit have noted that copying is permissible under many circumstances. The Supreme Court has stated that

> Trade dress protection must subsist with the recognition that in many instances there is no prohibition against copying goods and products. In general, unless an intellectual property right such as a patent or copyright protects an item, it will be subject to copying. As the Court has explained, copying is not always discouraged or disfavored by the laws which preserve our competitive economy.[2]

*TrafFix Devices v. Mktg. Displays, Inc.*, 532 U.S. 23, 29 (2001). In *Epic Metals Corp. v. Souliere*, the court stated:

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[2] This is not to say that unless a trade dress is registered it may never have protection from copying, but a plaintiff carries a heavy burden to qualify for trade protection under the Lanham Act when it is not registered. *TrafFix*, 532 U.S. at 29.

> It is plainly obvious that Condec copied Epic's product. We empathize with the reaction of the magistrate judge to the faithless malfeasance of a defendant who copies his employer's unpatented product while purporting to be its agent. However, public policy favors competition by all fair means, and that encompasses the right to copy, very broadly interpreted, except where copying is lawfully prevented by a copyright or patent . . . .

99 F.3d 1034, 1042 n.20 (11th Cir. 1996) (citing *In re Deister Concentrator Co.*, 289 F.2d 496, 503-06 (C.C.P.A. 1961). As one district court recently noted, "[t]he law allows for copying, as long as there is no likelihood of confusion." *Vital Pharms., Inc. v. Am. Body Bldg. Prods., LLC*, 511 F. Supp. 2d 1303, 1317-1318 (S.D. Fla. 2007).

In this case, Tardieu's trade dress is unregistered, and, as discussed, the trade dress itself is not very strong. Moreover, even accepting that MEC intended to copy one style of a Bogosse shirt, there is little likelihood of confusion given the nature of the product and the typical consumer.

7. Actual Confusion

The final factor in a likelihood of confusion analysis is actual confusion. "Actual consumer confusion is the best evidence of likelihood of confusion. There is no absolute scale as to how many instances of actual confusion establish the existence of that factor. Rather, the court must evaluate the evidence of actual confusion in the light of the totality of the circumstances involved." *AmBrit, Inc.*, 812 F.2d at 1543 (citations omitted).

On this point, Tardieu relies on the sworn statement of its long-time customer, Francillon. Francillon saw two men wearing MEC shirts and believed they were Bogosse shirts. Upon closer inspection, however, he attests that he was able to tell the shirts were not Bogosse because of the inferior quality of the fabric and stitching. His affidavit does not support Tardieu's claim of actual confusion; it supports a contrary finding.

The facts here are comparable to those in *Vital Pharms*. In *Vital Pharms*. the court found that where consumers initially were confused, but realized their mistake prior to purchase, evidence of actual confusion was not established. The court explained:

> Plaintiff directs me to several cases that have held that "initial interest confusion," such as that present [here], is sufficient to find a likelihood of confusion. . . . The Eleventh Circuit has not embraced this principle, and I find it unpersuasive. When the bottom line is sales of a particular product, initial confusion prior to and concluding before the point of purchase does not seem dispositive in a likelihood of confusion analysis.

*Vital Pharms*., 511 F. Supp. 2d at 1318 (internal citations omitted).

The facts here compel the same result. Francillon was initially confused, but upon a closer inspection, recognized that the MEC shirts were not Bogosse. Francillon was not even attempting to purchase the shirts at the time; he merely saw two men wearing what appeared to Bogosse shirts. Surely any purchaser who wants to purchase a real Bogosse shirt will take the time to inspect the shirt to at least the degree employed by Francillon, and upon inspection notice the differences in quality, and the tag. Tardieu has failed to present evidence of actual confusion.

8. Totality of the Factors

A review of the likelihood of confusion factors reveals the following: Tardieu's trade dress merits weak protection; the design of the trade dress is extremely similar as to one particular line of Defendants' shirts, but not similar as to many of the other shirts at issue; the products are essentially identical; the retail channels share some similarities and some differences; the advertising is entirely different; MEC intended to copy Tardieu's product; and there is no evidence of actual confusion. While some of these factors weigh in favor of a finding of a likelihood of confusion, when considering the practical realities of this expensive product and its market, there is little likelihood

of confusion for a consumer seeking to purchase a Bogosse shirt. True, some customers may choose to buy the cheaper MEC knock-off, but that will be a choice, not an accident, and that scenario does not sustain a finding of a substantial likelihood of prevailing on a Lanham Act claim.

9. Likelihood of Success on the Merits

To succeed in an action for trade dress infringement, a party must establish each element of the claim. Because Tardieu has failed to establish the likelihood of confusion prong, it has failed to demonstrate a substantial likelihood of success on the merits of its claim. Tardieu has therefore failed to establish the first requirement for the grant of a preliminary injunction. Accordingly, an injunction will not issue as to Tardieu's claim for trade dress infringement.

### B. Copyright Infringement

Tardieu seeks to enjoin MEC from using Tardieu's registered photograph on the MEC website. As MEC has explained, and a review of MEC's website reveals, MEC is no longer using Tardieu's copyrighted photograph. It is therefore unnecessary to determine whether Tardieu has established the elements necessary for a preliminary injunction. With no ongoing behavior to enjoin, an injunction will not issue.[3]

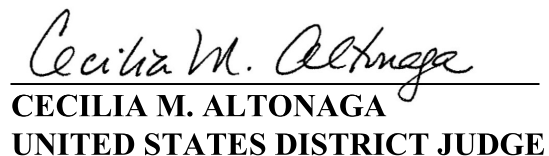
## IV. CONCLUSION

For the foregoing reasons, it is hereby

**ORDERED AND ADJUDGED** that Tardieu's Motion for Temporary Restraining Order and Preliminary Injunction [**D.E. 12**] is **DENIED**.

[3] If there is an indication that MEC intends to use Tardieu's photograph in the future, the Court will revisit the request for an injunction as to the copyright infringement claim. From the evidence adduced at the hearing, it is highly unlikely that MEC will make such an attempt.

**DONE AND ORDERED** in Chambers at Miami, Florida, this 5th day of May, 2009.



**CECILIA M. ALTONAGA**
**UNITED STATES DISTRICT JUDGE**

cc: counsel of record