

1 UNITED STATES COURT OF APPEALS
2 FOR THE SECOND CIRCUIT
3

4 SUMMARY ORDER
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6 Rulings by summary order do not have precedential effect. Citation to summary
7 orders filed after January 1, 2007, is permitted and is governed by this court's Local Rule
8 0.23 and Federal Rule of Appellate Procedure 32.1. In a brief or other paper in which a
9 litigant cites a summary order, in each paragraph in which a citation appears, at least one
10 citation must either be to the Federal Appendix or be accompanied by the notation:
11 "(summary order)." Unless the summary order is available in an electronic database which
12 is publicly accessible without payment of fee (such as the database available at
13 <http://www.ca2.uscourts.gov/>), the party citing the summary order must file and serve a
14 copy of that summary order together with the paper in which the summary order is cited.
15 If no copy is served by reason of the availability of the order on such a database, the citation
16 must include reference to that database and the docket number of the case in which the
17 order was entered.
18

19 At a stated term of the United States Court of Appeals for the Second Circuit, held
20 at the Daniel Patrick Moynihan United States Courthouse, 500 Pearl Street, in the City of
21 New York, on the 11th day of January, Two thousand seven.
22

23 PRESENT:

24 GUIDO CALABRESI
25 JOSÉ A. CABRANES
26 *Circuit Judges,*
27 EDWARD R. KORMAN
28 *District Judge.**

29 -----X
30 LOUIS VUITTON MALLETIER,

31 *Plaintiff-Appellant,*

32 -v.-

No. 06-2540-cv

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36 BURLINGTON COAT FACTORY WAREHOUSE, CORP.,

37 *Defendant-Appellee,*
38
39

* The Honorable Edward R. Korman, Chief Judge of the United States District Court for the Eastern District of New York, sitting by designation.

1 FOUR SEASONS HANDBAG COMPANY, AND JOHN DOES 1-10,

2
3 *Defendants.*

4 -----x

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6 **FOR APPELLANT:** THEODORE C. MAX, Mintz, Levin, Cohn, Ferris,
7 Glovsky, and Popco, P.C. (Charles A. LeGrand,
8 *on the brief*), New York, NY.

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10 **FOR APPELLEE:** ROBERT S. WEISHEIN, Darby & Darby, P.C. (Atul R.
11 Singh, *on the brief*), New York, NY.

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13 Appeal from a judgment of the United States District Court for the Western District
14 of New York (Richard M. Berman, *Judge*).

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16 **UPON DUE CONSIDERATION, IT IS HEREBY ORDERED, ADJUDGED,**

17 **AND DECREED** that the cause is **AFFIRMED** and **REMANDED** for further proceedings.

18 Plaintiff-appellant Louis Vuitton Malletier appeals from a May 23, 2006 judgment of
19 the United States District Court for the Southern District of New York denying appellant’s
20 motion for preliminary injunction against defendant-appellee Burlington Coat Factory
21 Warehouse Corporation. We assume the parties’ familiarity with the facts and the procedural
22 history of the case.

23 Upon a review of the record and of the District Court’s opinion, we are uncertain
24 whether the District Court conducted a fully exhaustive analysis of the likelihood of
25 consumer confusion when it applied the criteria set forth in *Polaroid Corp. v. Polorad*
26 *Electronics Corp.*, 287 F.2d 492, 495 (2d Cir. 1961). Nevertheless, because we find it was not
27 error to deny the preliminary injunction on the record before the Court, we do not vacate the
28 grant of that injunction but remand the cause to the District Court so that a trial on the merits
29 can proceed. In applying the *Polaroid* factors during resolution of the parties’ claims at a trial

1 on the merits, the District Court should consider not only the potential for consumer
2 confusion as to the *source* of the marks in question, but should also consider the potential for
3 confusion as to the “sponsorship, affiliation, connection, or identification” of those marks.
4 *Star Indus. v. Bacardi & Co.*, 412 F.3d 373, 383 (2d Cir. 2005). The District Court should give
5 particular attention to the *Polaroid* factors in light of the potential for types of confusion other
6 than source confusion, focusing perhaps especially on (1) the proximity of the products and
7 their competitiveness with one another, (2) evidence that the imitative mark was adopted in
8 bad faith, and (3) sophistication of consumers. *See, e.g., Lois Sportswear, U.S.A., Inc. v. Levi*
9 *Strauss & Co.*, 799 F.2d 867, 874-75 (2d Cir. 1986); *Sports Auth. v. Prime Hospitality Corp.*, 89
10 F.3d 955, 964 (2d Cir. 1996). In considering both source and non-source confusion, the
11 district court should ensure it gives adequate weight to the strength of the Louis Vuitton
12 trademark when weighing the various *Polaroid* factors. *See Louis Vuitton Malletier v. Dooney*
13 *& Bourke, Inc.*, 454 F.3d 108, 116 (2d Cir. 2006). Finally, we note that the potential for non-
14 source confusion and its applicability to the *Polaroid* factors may be relevant to Louis
15 Vuitton’s claims under New York’s anti-dilution statute, New York General Business Law §
16 360-1 (McKinney Cum. Supp. 2007). *See Hormel Foods Corp. v. Jim Henson Prods.*, 73 F.3d 497,
17 506-08 (2d Cir. 1996).

18 In sum, we hereby **AFFIRM** the decision of the district court and **REMAND** the
19 cause to that court for further proceedings consistent with this order.

21 FOR THE COURT,
22 Thomas Asreen, Acting Clerk
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By _____