

**UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF ILLINOIS  
EASTERN DIVISION**

BEST VACUUM, INC,	)	DEFENDANT’S SUMMARY
	)	JUDGMENT MEMORANDUM
Plaintiff,	)	
	)	
v.	)	<b>JUDGE HART</b>
	)	
IAN DESIGN, INC.	)	<b>Civil Action No. 04 C 2249</b>
	)	
Defendant.	)	JURY TRIAL DEMANDED

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**DEFENDANT’S MEMORANDUM IN OPPOSITION TO PLAINTIFF’S  
MOTION FOR SUMMARY JUDGMENT AND IN  
SUPPORT OF DEFENDANT’S CROSS-MOTION FOR SUMMARY JUDGMENT**

NOW COMES Defendant IAN DESIGN, INC. (“Ian Design”), and respectfully submits this Memorandum in Opposition to Plaintiff BEST VACUUM, INC.’s (“Plaintiff”) Motion for Summary Judgment and also in Support of Defendant Ian Design’s Cross-Motion for Summary Judgment, and states as follows:<sup>1</sup>

**INTRODUCTION and PRELIMINARY STATEMENT**

This litigation represents a classic, modern representation of the story of David and Goliath. Ian Design is a small start-up business selling Dyson vacuum cleaners via the Internet from New Jersey. Defendant Response to Plaintiff L. R. 56.1 Statement of Undisputed Material Facts (“Def.’s Resp.”) ¶¶ II.2, III.2-3. Plaintiff also sells vacuums on the Internet and from a store in Chicago, Illinois. Plaintiff’s Statement of Undisputed Material Facts (“Pl.’s SUMF”) ¶ 1; Def.’s Resp. ¶¶ I.1, II.1, III.1-4. While Ian Design’s assets amount to no more than approximately \$20,000, Def.’s Resp. ¶ III.2, Plaintiff spends approximately \$60,000 per month on advertising and receives more than \$3,750,000 in gross sales. Pl.’s SUMF ¶ 4; Def.’s Resp. ¶ I.4; Affidavit of Paul Teven (Plaintiff’s Motion for Summary Judgment (“Pl.’s Mot.”), Ex. 8) ¶ 10. Although both Parties sell vacuums on the Internet, Plaintiff represents a vacuum Goliath

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<sup>1</sup> The Parties’ motions for summary judgment address the same issues on the three remaining claims in Plaintiff’s Complaint. Consequently, for purposes of efficiency and as the Court wisely directed, Ian Design has combined its arguments in opposition to Plaintiff’s motion for summary judgment with its arguments in support of its own cross-motion for summary judgment. Therefore, the arguments raised herein should be construed as applying to Ian Design’s respective positions as to both motions.

over Ian Design. Id. Plaintiff has used this advantage to pursue baseless and groundless litigation against Ian Design to prevent any use of the laudatory phrase “best vacuum” and to obtain economic damages for any prior uses thereof. See generally Compl. (Doc. #1).

Ian Design obtained the domain name “bestvacuumcleaner.com” to convey to the Internet that it sold what it believes to be the best vacuum cleaner. Def.’s Resp. ¶¶ III.5-6. The Plaintiff found this domain name to be objectionable and sent Ian Design a cease and desist letter. Id. ¶¶ III.12-13. In an effort to cooperate and avoid litigation, Ian Design obtained the domain name “bestchoicevacuums.com” and altogether ceased use of “bestvacuumcleaner.com.” Id. ¶¶ III.12-16. This did not satisfy Goliath. Rather, Plaintiff found “bestchoicevacuums.com” to be objectionable and filed this litigation against Ian Design for the purported use of the laudatory term “best vacuum.” See generally Compl.; Declaration of James D. Kole (“Kole Decl.”) (Doc. #3). Indeed, the Plaintiff seeks to preclude Ian Design, a small competitor, from using the laudatory term “best vacuum” at all. Id. If it succeeds, Ian Design would not be permitted to claim it sold the best vacuum! Plaintiff bases its position on the misguided notion that it has a protectable mark in the laudatory term “best vacuum.” Id.

Although the law could not abruptly end the Plaintiff’s predatory litigation,<sup>2</sup> it cannot allow the Plaintiff’s efforts to continue. Plaintiff has disclaimed any right to the terms “best” and “vacuum” other than as appearing in “best vacuum.” Def.’s Resp. ¶ III.28. Consequently, the only mark at issue is the term “best vacuum.” Plaintiff does not have a federally registered mark in “best vacuum.” Id. ¶ III.26. Plaintiff acknowledges that the mark is not arbitrary or fanciful, but rather descriptive. Id. ¶¶ III.29-30. Although the Plaintiff alleges “secondary meaning” in “best vacuum,” most people have never even heard of the Plaintiff or its website. Id. ¶¶ III.32-33. The term “best vacuum” has not acquired secondary meaning and is therefore not a protectable mark. Def.’s Resp. ¶¶ III.30-43. Ian Design’s intent has been and remains in good faith and impeccable. Id. ¶¶ III.8-25. There does not exist any evidence of actual confusion or any likelihood of confusion. Pl.’s SUMF ¶ 14; Def.’s Resp. I.14, III.44-46. For these reasons and those below, this Court must deny Plaintiff’s motion for summary judgment and grant Ian Design’s cross-motion for summary judgment on all counts in the Complaint.

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<sup>2</sup> Fortunately, however, this Court denied Plaintiff’s motion for preliminary injunction. Best Vacuum, Inc. v. Ian Design, Inc., No. 04 C 2249, 2005 U.S. Dist. LEXIS 9795 (N.D. Illinois January 18, 2005).

## THE UNDISPUTED FACTS

The Parties both sell Dyson vacuums on the Internet. Def.'s Resp. ¶¶ III.1-4. The Plaintiff operates from Illinois. Id. ¶ II.1. Ian Design operates from New Jersey. Id. ¶ II.2.

Ian Design believes it sells the best vacuums. Id. ¶¶ III.5-6. Ian Design registered the domains bestvacuumcleaners.com and bestchoicevacuums.com to market and operate its website on the Internet. Id. ¶¶ III.8,12. It did so in good faith and with no mal-intent. Id. ¶¶ III.8-23. Ian Design never marketed itself as Best Vacuum, Inc. or bestvacuum.com. Def.'s Resp. ¶ III.24. It has no intent to do so. Id. In fact, it explicitly made efforts to identify itself as the owner of the domains at issue in this litigation. Id. ¶¶ III.11,14. Further, it has never had any intent to copy any of Plaintiff's marks. Id. ¶ III.25. Indeed, prior to obtaining bestvacuumcleaner.com, it had no knowledge of Plaintiff. Def.'s Resp. ¶ III.9.

The Plaintiff does not have a registered mark in "best vacuum." Def.'s Resp. ¶ III.26. Most Internet consumers do not associate the term "best vacuum" with the Plaintiff or its website, "bestvacuum.com." Id. ¶ 31. In fact, Ninety-eight percent (98%) of Internet consumers have never heard of Plaintiff or its website. Id. ¶¶ III.32-33. In fact, most people consider the term "best vacuum" to mean a description of the best vacuum cleaner. Id. ¶ 31. Not surprisingly, "best vacuum" represents a laudatory, descriptive term that many individuals and entities use on the Internet for such purpose. Id. ¶¶ III.28-30, 40-41. Thus, "best vacuum" is not a recognized brand, not famous, and not a strong mark. Def.'s Resp. ¶¶ 39, 42, 43.

The Plaintiff filed a Complaint and motion for preliminary injunction. See generally Compl. (Doc. #1); Plaintiff's Mot. for Preliminary Inj. ("Pl.'s Mot. Prelim. Inj.") (Docs. ##2, 11). The Court denied Plaintiff's motion. Report and Recommendation of Magistrate Martin C. Ashman (Docs. ##29-30); Order of March 16, 2005 (Doc. #36). The Court also dismissed Count One of its Complaint. Report and Recommendation of Magistrate Martin C. Ashman (Docs. ##31, 37); Order of March 16, 2005 (Doc. #36). As discovery has closed, Plaintiff has filed its motion for summary judgment. See Pl.'s Mot. (Doc. #36). Ian Design now files its cross-motion for summary judgment. This memorandum is submitted in opposition to Plaintiff's motion for summary judgment and in support of Ian Design's cross-motion for summary judgment.

## ARGUMENT

This Court must decide the Parties' motions for summary judgment in favor of Ian Design because there exist no genuine issues of material fact. Indeed, it is undisputable that

“best vacuum” is not a protectable mark and there exists no likelihood of confusion.

## **I. SUMMARY JUDGMENT STANDARD**

Summary judgment is appropriate when there remains no genuine issue of material fact and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c); Cincinnati Ins. Co. v. Flanders Elec. Motor Serv., Inc., 40 F.3d 146, 150 (7th Cir. 1994). Disputed facts are material when they might affect the outcome of the suit. First Ind. Bank v. Baker, 957 F.2d 506, 507-508 (7th Cir. 1992). Indeed, a metaphysical doubt will not suffice. Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 586 (1986). Although a court must examine all inferences from the facts in the light most favorable to the non-moving party, summary judgment may be granted where the evidence cited by the non-moving party amounts to no more than a scintilla or is not significantly probative. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 247-250 (U.S. 1986).

## **II. THE ANALYSIS FOR ALL REMAINING CLAIMS IS THE SAME**

Only three of the Plaintiff’s original four claims remain at issue.<sup>3</sup> With respect to these claims, the Court may apply the same analysis to resolve all of them. Two of the remaining claims allege violations of the Lanham Act: Count Two alleges violation of 15 U.S.C. § 1125(c) and Count Three alleges violation of 15 U.S.C. § 1125(a) (collectively, the “Lanham Act Claims”). The fourth claim (“Count Four”) alleges violation of the Uniform Deceptive Trade Practices Act (“UDTPA”), 815 ILCS 510/1, et seq. The Parties agree that Count Four need not be addressed separately and must rise or fall based upon the Lanham Act Claims. Plaintiff’s Memorandum in Support of its Motion for Summary Judgment (“Pl.’s Mem. Supp. Summ. Judg.”), p. 14; see also MJ & Partners Restaurant Ltd. Pshp. v. Zadikoff, 10 F. Supp.2d 922, 929 (N.D. Ill. 1998); Gimix, Inc. v. JS & A Group, Inc., 699 F.2d 901, 908 (7th Cir. 1983); D 56 Inc. v. Berry’s Inc., 955 F. Supp. 908, 920 (N.D. Ill. 1997); Tarin v. Pellonari, 253 Ill.App.3d 542, 551, 625 N.E.2d 739, 746-47 (Ill. App. 1993). Thus, to resolve all remaining three claims, the Court need only determine whether the Plaintiff has viable Lanham Act Claims. Id.

## **III. NO VIABLE LANHAM ACT CLAIMS**

The undisputed evidence demonstrates the absence of any viable Lanham Act Claims. Under both 15 U.S.C. §§ 1125(a) and 1125(c), a plaintiff must have a protectable mark. See

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<sup>3</sup> This Court previously dismissed Count One that alleged violation of 15 U.S.C. § 1114 for which Plaintiff did not have a federally registered trademark. Report and Recommendation of Magistrate Martin C. Ashman (Docs. ##31, 37); Order of March 16, 2005 (Doc. #36).

International Kennel Club of Chicago, Inc. v. Mighty Star, Inc., 846 F.2d 1079, 1084 (7th Cir.1988) (citing A.J. Canfield Co. v. Vess Beverages, Inc., 796 F.2d 903, 906 (7th Cir.1986)). Moreover, a successful plaintiff must demonstrate the likelihood of confusion between the protectable mark and any alleged secondary mark. Id. Consequently, for both Lanham Act Claims, this Court need only decide whether the term “best vacuum” represents a protectable mark and whether there exists any likelihood of confusion. Id.

**A. The Undisputed Evidence Demonstrates Plaintiff Without Protectable Mark**

The Plaintiff’s claim to its mark “best vacuum” is problematic. The Plaintiff does not have a federally registered trademark. See Pl.’s Mem. Supp. Summ. Judg., p. 8; Def.’s Resp. ¶ III.26. Consequently, the Plaintiff has the burden to establish that “best vacuum” is not an unprotectable mark. See Technical Publishing Co. v. Lebhar-Friedman, Inc., 729 F.2d 1136, 1139 (7th Cir.1984); National Conference of Bar Examiners v. Multistate Legal Studies, Inc., 692 F.2d 478, 488 (7th Cir.1982), cert. denied, 464 U.S. 814, 104 S.Ct. 69 (1983). To do so, the Plaintiff must demonstrate that it has an arbitrary mark, a fanciful mark, or descriptive mark that has acquired secondary meaning. It cannot meet this burden.

1. Plaintiff Concedes “Best Vacuum” Descriptive Term

The Plaintiff concedes that “best vacuum” is not arbitrary or fanciful. Pl.’s Mem. Supp., p. 8; Def.’s Resp. ¶¶ III.29, 30. This Court previously held that “best vacuum” did not constitute a suggestive term, but rather a descriptive term. Best Vacuum, Inc. v. Ian Design, Inc., No. 04 C 2249, 2005 U.S. Dist. LEXIS 9795, \*11 (N.D. Illinois January 18, 2005). The Plaintiff admits this. Pl.’s Mem. Supp., p. 8. Thus, “best vacuum” represents a descriptive term that is not entitled to protection absent secondary meaning. See Technical Publ. Co., 729 F.2d at 1139; Miller Brewing Co. v. Jos. Schlitz Brewing Co., 605 F.2d 990, 994 (7th Cir. 1979) (merely descriptive term does not receive federal trademark protection); Echo Travel, Inc. v. Travel Associates, Inc., 870 F.2d 1264, 1267 n.6 (7<sup>th</sup> Cir. 1989) (the word “best” serves as a descriptive term for purposes of trademark law because it has a pre-existing or primary meaning). Consequently, the only issues remaining with respect to the Lanham Act Claims are (a) whether the Plaintiff’s mark “best vacuum” has acquired secondary meaning and (b) whether there exists a likelihood of confusion.

2. The Undisputed Evidence Demonstrates Absence of Secondary Meaning

Although a descriptive term can become protectable if the term acquires secondary

meaning, “best vacuum” has not done so. In determining whether a mark has acquired secondary meaning, courts consider direct and circumstantial evidence. With respect to direct evidence, courts consider direct consumer testimony and consumer surveys. The Plaintiff has neither offered nor referenced any direct consumer testimony or consumer surveys apart from its customer testimonials. In contrast, Ian Design has submitted herewith results from an independently administered random survey of Internet consumers. With respect to circumstantial evidence, courts consider the exclusivity, length, and manner of use; amount and manner of advertising; amount of sales and number of customers; established place in the market; and proof of intentional copying. See Vaughan Manufacturing Co. v. Brikam International, Inc., 814 F.2d 346, 349 (7th Cir.1987); Gimix, Inc., 699 F.2d at 907; Union Carbide Corp. v. Ever-Ready Inc., 531 F.2d 366, 380 (7th Cir.1976); American Scientific Chemical, Inc. v. American Hospital Supply Corp., 690 F.2d 791, 793 (9th Cir.1982). In considering all of these factors, there exists no genuine issue of material on the issue of whether “best vacuum” has acquired secondary meaning; simply stated, it has not.

*a. Consumer Surveys Demonstrate Lack of Secondary Meaning*

The actual consumer survey evidence submitted to this Court demonstrates the absence of secondary meaning with respect to the laudatory, descriptive term “best vacuum.” Ian Design commissioned a survey that was independently administered to three hundred (300) Internet consumers (“Best Vacuum Survey”). Def.’s Resp. ¶¶ 31-34, Exhibit 2B and 2C. The survey results demonstrate that more than 82% of the 300 respondents indicated that “best vacuum” meant a “descriptive term used to describe the best vacuum cleaner.” *Id.* More than 11% indicated that it meant the Dyson vacuum cleaner – the vacuum cleaner sold by Ian Design and which it believes to be the best vacuum. *Id.* Only 14 or 4.67% of the 300 respondents indicated that “best vacuum” meant a retail store named “Best Vacuum.” *Id.* ¶ III.31. However, apparently not all of these individuals referred to the Plaintiff. With respect to Plaintiff’s domain “www.bestvacuum.com,” 295 of the 300 respondents or 98.33% indicated that they had *never* heard of the domain name or business. *Id.* ¶ III.32. With respect to Best Vacuum, Inc. of Illinois, 294 of the 300 respondents or 98% indicated that they had *never* heard of it. *Id.* ¶ III.33. Of the fourteen (14) individuals who indicated they lived in Illinois, only six lived in the Chicagoland area. *Id.* ¶ III.34. Not even all of these six (6) individuals had heard of Plaintiff or its website. *Id.* Clearly, the results of the Best Vacuum Survey demonstrate the absence of

secondary meaning with respect to the laudatory, descriptive term “best vacuum.” Def.’s Resp. ¶¶ III.31-39.

The Plaintiff has failed to submit any consumer survey results. As with its motion for preliminary injunction, the only “consumer survey” evidence offered by Plaintiff in support of its summary judgment motion constitute its own customers’ testimonials. Pl.’s SUMF ¶¶ 10-13; Def.’s Resp. ¶¶ I.10-13. As this Court previously held:

Plaintiff’s reviews and surveys may constitute evidence of satisfied customers but they do not appear to constitute evidence of acquired secondary meaning. Plaintiff’s surveys target a select constituency already familiar with, and recent consumers of, Plaintiff’s product. Surveys that target a party’s core constituency and/or display the trademark in question may not be reliable indicators of secondary meaning. A.J. Canfield Co., 796 F.2d at 907-8 (finding consumer survey on CanField’s fudge unreliable because survey was conducted in Chicago, the heart of Plaintiff’s market, and because the polices were given both the source name and **trademark** term on the same can, thus lessening the associative response). Furthermore, the information obtained by Plaintiff’s consumer surveys is vague and unhelpful.

Best Vacuum, Inc., 2005 U.S. Dist. LEXIS 9795 at \*13-14. Nothing has changed. While Plaintiff cites seven (7) of some nine hundred surveys from its own customers that name “Best Vacuum,” the “surveys” remain problematic because they represent testimonials from individuals who had purchased products from the Plaintiff. See Pl.’s Mem. Supp. Summ. Judg., p. 10; Pl.’s SUMF ¶¶ 10-13; Def.’s Resp. ¶¶ I.10-13. Nothing more. See id. This remains insufficient. Best Vacuum, Inc., 2005 U.S. Dist. LEXIS 9795 at \*13-14.

Clearly, the actual consumer survey evidence submitted to the Court by Ian Design demonstrates the strong absence of any secondary meaning associated with the term “best vacuum.” Def.’s Resp. ¶¶ III.31-39. The Plaintiff has failed to submit any survey evidence to the contrary. Pl.’s SUMF ¶¶ 10-13; Def.’s Resp. ¶¶ I.10-13.

*b. No Exclusivity to Use*

Arguably, the Plaintiff has been using “Best Vacuum” as its corporate name since 1983. And, arguably, it has used this name exclusively in Illinois. However, its exclusive use of “Best Vacuum” extends no further. A wide variety of entities use the term “best vacuum” to identify the products they sell, namely vacuums and vacuum related products. Def.’s Resp. ¶¶ III.40-41. Further, entities use the term “best vacuum” to make claims similar to “We sell the best vacuums” or “This [manufacturer]’s [model] is the best vacuum.” See id.; Declaration of Charles

Lee Mudd Jr. (“Mudd Decl.”) (Doc. #15) ¶¶ 1-3, Exs. A-D. Entities also use the term “best vacuum” in the visible portion of their websites, in the metatags of their websites, and/or as “adwords” so that their websites are brought to the attention of people searching for the “best vacuum.” *Id.* For example, a search for “best vacuum” on Yahoo produced in excess of 3,300,000 web page results as of September 14, 2004. *See* Mudd Decl. (Doc. #15) ¶¶ 1-3, Ex. A. The same search on Google produces in excess of 3,000,000 web page results as of September 7, 2004. *Id.* ¶¶ 1-3, Ex. B. Clearly, the Plaintiff does not enjoy exclusive use of the term “Best Vacuum.” Def.’s Resp. ¶¶ III.40-41; Mudd Decl. ¶¶ 1-3, Exs. A-D. In fact, the extensive use of the term “best vacuum” for a variety of purposes by third parties outweighs any weight given the length of time the Plaintiff has used the term in Illinois. It simply remains indisputable that the use of “best vacuum” by Plaintiff has not been exclusive. Clearly, the extensive, non-exclusive use of the laudatory, descriptive term “best vacuum” demonstrates the strong absence of any secondary meaning associated with it. *Id.*

*c. No Intentional Copying*

The Plaintiff has no evidence of intentional copying and cannot produce any evidence of intentional copying. Pl.’s SUMF; Pl.’s Mem. Supp. Summ. Judg. It simply does not exist. John Roesler has explained Ian Design’s good faith intent in obtaining the domain names “bestvacuumcleaners.com” and “bestchoicevacuums.com.” Def.’s Resp. ¶¶ III.8-25. In fact, Ian Design had no knowledge of Plaintiff when it chose “bestvacuumcleaner.com” *Id.* ¶ III.9. When Ian Design received a cease and desist letter from Plaintiff, it ceased use of “bestvacuumcleaner.com” promptly and registered “bestchoicevacuums.com,” again in good faith and without any mal-intent. *Id.* ¶¶ III.12-16. The evidence before this Court clearly demonstrates the absence of any genuine issue of material fact as to Ian Design’s good-faith intent. Def.’s Resp. ¶¶ III.8-25. Thus, this factor weighs against finding secondary meaning. *Id.*

*d. No Predominant Place in Market*

As to the Plaintiff’s purported established place in the market, the Plaintiff overstates its predominance. The term “best vacuum” produces over 3,000,000 hits from the search engines at Google ([www.google.com](http://www.google.com)) and Yahoo ([www.yahoo.com](http://www.yahoo.com)). Def.’s Resp. ¶¶ III.40-41; Mudd Decl. ¶¶ 1-3, Exs. A-D. At Overture, a search using “best vacuum” listed 17 retailers before listing that of the Plaintiff’s site. *See* Kole Decl. (Doc. #3) ¶ 6. On this issue, the Plaintiff cites only to the affidavit of Paul Teven for the proposition that Plaintiff sells eight different brands of

vacuums and that it is “the leading sales representative [in the U.S. for Miele vacuums.]” Pl.’s Mem. Supp. Summ. Judg., p. 13. As to the first proposition, the Plaintiff does not explain how selling eight brands of vacuums demonstrates a predominance in the market. *Id.* As to the second proposition, the Plaintiff misstates Paul Teven’s testimony. Def.’s Resp. ¶ I.7. Even so, the Plaintiff does not explain the significance of being “a” or “the” leading Miele sales representative in the national or international vacuum market. Pl.’s Mem. Supp. Summ. Judg., p. 13. Additionally, based on Plaintiff’s own argument, there exist at least eight (8) brands of vacuums. Consequently, it could be inferred that someone other than Plaintiff is “the” leading sales representative for the remaining brands. *Id.* Consequently, its established place in the market cannot be said to be predominant. *See id.*; Def.’s Resp. ¶¶ III.40-41; Mudd Decl. ¶¶ 1-3, Exs. A-D.

*e. Remaining Factors Have Little Weight*

For purposes of summary judgment only, Ian Design does not dispute the length of time Plaintiff has used the term “best vacuum.” However, this alone is insufficient to find secondary meaning. *Best Vacuum, Inc.*, 2005 U.S. Dist. LEXIS 9795 at \*18. With respect to the amount and manner of Plaintiff’s advertising, the Plaintiff has failed to remedy the deficiencies previously identified by this Court. *See* Pl.’s Mem. Supp. Summ. Judg., p. 12; Pl.’s SUMF; *Best Vacuum, Inc.*, 2005 U.S. Dist. LEXIS 9795 at \*15-18. The Plaintiff continues to rely upon the “approximate figures for general expenditures on internet advertising.” *Best Vacuum, Inc.*, 2005 U.S. Dist. LEXIS 9795 at \*18; Pl.’s Mem. Supp. Summ. Judg., p. 12; Pl.’s SUMF. Although the Plaintiff has, apparently, submitted six years of advertising in Chicago-based publications, the advertisements actually suggest most advertising has occurred in Chicago – a locale in which Ian Design does not advertise. Consequently, the amount and manner of advertising remains insufficient to demonstrate secondary meaning. *Best Vacuum, Inc.*, 2005 U.S. Dist. LEXIS 9795 at \*18. As to the amount of sales and number of Plaintiff’s customers, the Plaintiff still has failed to address the deficiencies identified by the Court. *Id.* at \*19. Consequently, these factors should not be given much weight, if any weight at all. *Id.* at \*15-20.

3. Conclusion: “Best Vacuum” Remains Unprotectable

Based upon the “Best Vacuum Survey,” the lack of any survey evidence from Plaintiff, Ian Design’s good faith intent, and the non-exclusive use “best vacuum,” there exists no genuine issue of material fact with respect to the absence of secondary meaning. Indeed, “best vacuum”

has not acquired secondary meaning. Consequently, the term “best vacuum” is not protectable.<sup>4</sup> See Technical Publishing Co., 729 F.2d at 1139; Miller Brewing Co., 605 F.2d at 994.

Therefore, this Court must deny Plaintiff’s motion for summary judgment and grant Ian Design’s cross-motion for summary judgment. See id.

**B. The Undisputed Evidence Demonstrates No Likelihood of Confusion Exists**

The Plaintiff cannot demonstrate any likelihood of confusion. Where the use of a mark does not cause confusion, a competitor may permissibly use that mark. See Libman Co. v. Vining Indus., Inc., 69 F.3d 1360, 1362 (7<sup>th</sup> Cir. 1995). To demonstrate likelihood of confusion, a Plaintiff must do more than show a mere “possibility” of confusion. See Eli Lilly & Company v. Natural Answers, Inc., 233 F.3d 456, 461-62 (7<sup>th</sup> Cir. 2000); August Storck K.G. v. Nabisco, Inc., 59 F.3d 616, 619 (7<sup>th</sup> Cir. 1995). Indeed, a plaintiff must demonstrate that a likelihood of confusion would occur with respect to a significant number of consumers and not merely isolated incidents. Door Systems, Inc. v. Pro-Line Door Systems, Inc., 83 F.3d 169, 173 (7<sup>th</sup> Cir. 1996) (finding that “. . . it is wholly unlikely that any significant number of consumers will be misled” and, because “this is the test,” affirming summary judgment for the defendant); CAE, Inc. v. Clean Air Eng’g, 267 F.3d 660, 673-74 (7<sup>th</sup> Cir. 2001). In determining whether likelihood of confusion exists, courts consider the following factors: “(1) the similarity of the marks in appearance and suggestion; (2) the similarity of the products; (3) the area and manner of concurrent use; (4) the degree of care likely to be used by consumers; (5) the strength of the plaintiff’s mark; (6) whether any actual confusion exists; and (7) the defendant’s intent to palm off its goods as those of the plaintiffs.” Ty, Inc., 237 F.3d at 897. Depending on the facts and circumstances of each case, different factors will weigh more or less heavily than others. Id. at 898. Finally, the realities of consumer behavior in the market must be considered and cannot be ignored. See Rust Env’t & Infrastructures, Inc. v. Teunissen, 131 F.3d 1210, 1216 (7<sup>th</sup> Cir. 1997).

In this case, the Plaintiff has continually relied only on the *possibility* of confusion. See generally Pl.’s Mot. Prelim. Inj.; Pl.’s Mem. Supp. Summ. Judg.; Pl.’s SUMF. In its motion for summary judgment, the Plaintiff offers no evidence of likelihood of confusion apart from its

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<sup>4</sup> Where an unregistered trademark is at issue, an analysis of the strength of the complainant’s mark is completed to determine whether the mark is protectable. Munters Corp. v. Matsui America, Inc., 909 F.2d 250, 252 (7<sup>th</sup> Cir. 1990). The analysis above as well as the analysis on the strength of the Plaintiff’s mark in Section B.2 demonstrates the weakness of the laudatory, descriptive term “best vacuum.”

mischaracterization of John Roesler’s testimony.<sup>5</sup> Pl.’s Mem. Supp. Summ. Judg., p. 7; Pl.’s SUMF ¶ 14; Def.’s Resp. ¶ I.14. John Roesler testified that he has received but two (2) telephone calls from individuals confusing Ian Design with Plaintiff. *Id.* At best, this represents only isolated incidents of possible confusion. *Id.* It also ignores John Roesler’s testimony suggesting that, considered in comparison to other communications from consumers, the isolated incidents represent more an indication of “the realities of consumer behavior.” *Id.* Consequently, Plaintiff has produced absolutely no evidence upon which to support a finding of likelihood of confusion. As further articulated below, the facts and circumstances of this case considered in light of the seven “Ty” factors further demonstrate that Plaintiff cannot succeed in demonstrating a likelihood of confusion. Indeed, on this issue, there exists no genuine issue of material fact.

1. Most Important Factors Weigh Against Likelihood of Confusion

Although no one factor is dispositive, “the similarity of the marks, the intent of the defendant, and evidence of actual confusion are the ‘most important factors’ in a likelihood of confusion case.” *Ty, Inc.*, 237 F.3d at 898 (citing *G. Heileman Brewing Co., Inc. v. Anheuser-Busch, Inc.*, 873 F.2d 985, 999 (7th Cir.1989); see also *Eli Lilly & Co. v. Natural Answers, Inc.*, 233 F.3d 456, 462 (7th Cir.2000)). Indeed, although a majority of factors may weigh to one side or another, the “weight and totality of the most important factors in each case will be determinative of the likelihood of confusion.” *Ty, Inc.*, 237 F.3d at 898.

*a. Similarity of the Marks*

There exists no similarity between the laudatory term “best vacuum” and the domain “bestchoicevacuums.com.”<sup>6</sup> Def.’s Resp. ¶¶ III.44-45. The only similarity exists in the use of the words “best” and “vacuum” apart from one another. However, the Plaintiff has explicitly disclaimed any rights to the words “best” or “vacuum” apart from “Best Vacuum.” Def.’s Resp. ¶ III.28. Consequently, the Plaintiff has waived any claim to dispute the validity of “bestchoicevacuums.com.” *Id.* Indeed, it has no basis whatsoever to do so.

Waiver notwithstanding, the “bestchoicevacuums.com” domain is sufficiently distinct

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<sup>5</sup> In fact, the Plaintiff’s sole argument on the issue of actual confusion, without any analysis or citation to case law, relies on the “evidence” of its mischaracterization of John Roesler’s testimony. See Pl.’s Mem. Supp. Summ. Judg., p. 7.

<sup>6</sup> Although “bestchoicevacuums.com” does not incorporate “best vacuum,” Ian Design still contends that it can use the term “best vacuum.”

from “best vacuum.” See Trans Union LLC v. Credit Research, Inc., 142 F. Supp.2d 1029, 1042-1043 (N.D. Ill. 2001) (finding creditresearchtransunion sufficiently distinct from Trans Union). Ian Design’s domain name necessarily will always be associated with the “.com” ending. Moreover, the words “best” and “vacuum” will always be separated by the word “choice.” Additionally, the domain name places all of these words together in the form of “bestchoicevacuums.com” which, by itself, does not represent an identifiable word. “[A]s the differences separating the [defendant’s domain name] from the plaintiff’s mark become more noticeable, the similarities are likely to appear to consumers as more reflective of the fact that both are being used to designate something having to do with [the same business] rather than indicating a common source.” See id. (quoting TCPIP Holding Co., Inc. v. Haar Communications Inc., 244 F.3d 88, 101-02 (2nd Cir.2001)). This would also apply to the domain name “bestvacuumcleaners.” See id. Consequently, Ian Design contends that the dissimilarity in the domain names is sufficient enough to weigh against likelihood of confusion. See id. In any case, at the most, the similarity between the marks is a neutral factor. See id.

Beyond the domain names, the Court must also address the use of the term “best vacuum.” For, Plaintiff seeks to preclude the use of the term “best vacuum” in any advertising by Ian Design. With respect to the term “best vacuum” (eg in the context of a metatag or a statement on a webpage such as “We sell the best vacuum!”), Ian Design acknowledges that “best vacuum,” as distinct from its domain names, represents the same mark “best vacuum” which Plaintiff seeks to control. Nonetheless, Ian Design contends that the remaining factors weigh against any finding, potential or actual, of likelihood of confusion.

*b. Intent of Ian Design*

There exists no question that Ian Design had no mal-intent in registering and using the domains “bestvacuumcleaner.com” and “bestchoicevacuums.com.” Def.’s Resp. ¶¶ III.8-25. When Ian Design chose “bestvacuumcleaner.com,” it had no knowledge of Plaintiff. Id. ¶ III.9. It needed to acquire a domain name quickly and chose the domain as being descriptive of its business. Id. ¶ III.10. It explicitly stated on its website that “‘bestvacuumcleaner.com’ is wholly owned and operated by Ian Design.” Id. ¶ III.11. Ian Design believes it sells the best vacuum and used the term to market this belief. Id. ¶¶ III.5-6. When Ian Design received a cease and desist letter from Plaintiff, it ceased use of “bestvacuumcleaner.com” and registered “bestchoicevacuums.com” again in good faith and without any mal-intent. Id. ¶¶ III.12-16.

Again, Ian Design explicitly stated on its website that “‘bestchoicevacuums.com’ is wholly owned and operated by Ian Design, Inc.” Id. ¶ III.14. The Plaintiff has neither offered nor produced any evidence to the contrary. Pl.’s SUMF. Consequently, there exists no genuine issue of material fact as to whether Ian Design acted in anything but good faith. Id. ¶¶ III.8-25, 40-41. It is undisputed. Id. As one of the most important factors, the absence of evidence of any ill-intent or improper motive is significant. See Ty, Inc., 237 F.3d at 898. Thus, this factor weighs against finding likelihood of confusion. See id.

*c. Lack of any Actual Confusion*

As mentioned above, the Plaintiff has produced no evidence of likelihood of confusion. For its preliminary injunction motion, Plaintiff admitted that “[e]vidence of actual confusion is largely unavailable . . . .” See Pl.’s Mem. Supp. Preliminary Inj. (Doc. #11), p. 6. In fact, evidence of actual confusion arising from Ian Design’s use of the domain names was then and remains completely unavailable. At summary judgment, Plaintiff relies solely on its mischaracterization of John Roesler’s testimony. Pl.’s SUMF ¶ 14; Def.’s Resp. ¶ I.14. In doing so, Plaintiff focuses on two isolated incidents and ignores John Roesler’s testimony in which he expressly stated:

“ . . . I spoke to two customers who confused me with Best Vacuum, couple of customers who confused Best Vacuum with me and probably a dozen or so customers who confused me with other online retailers who sold Dyson vacuum who had entirely dissimilar names. So the closeness of the name didn’t appear to have any relevance whatsoever.”

Roesler Dep. (**Exhibit 3**) 31:25—32:7; 48:20—49:15; Pl.’s SUMF ¶ 14. At best, the two incidents to which Plaintiff refers represent isolated incidents that remain insufficient for a finding of likelihood of confusion. See Door Systems, Inc., 83 F.3d at 173. Most likely, the two incidents fall within the context of “the realities of consumer behavior” demonstrated by the remaining incidents to which Mr. Roesler referred. See Roesler Dep. (**Exhibit 3**) 31:25—32:7; 48:20—49:15; Pl.’s SUMF ¶ 14; Def.’s Resp. ¶ I.14; see also Rust Env’t & Infrastructures, Inc., 131 F.3d at 1216. As such, they are insignificant. See id. As one of the most important factors, the absence of evidence of any actual confusion is significant. See Ty, Inc., 237 F.3d at 898. Consequently, this factor weighs against any likelihood of confusion. Id.

*d. The Most Significant Factors Weigh Against Likelihood of Confusion*

Because the marks are dissimilar and the Plaintiff cannot produce evidence of either ill-

intent on behalf of the Ian Design or actual confusion caused by Ian Design, the most important factors in determining whether likelihood of confusion exists weigh against such a finding. See Ty, Inc., 237 F.3d at 898. Indeed, there exists no genuine issue of material fact as to this issue. Consequently, these factors weigh in favor of denying Plaintiff's motion for summary judgment and granting Ian Design's cross-motion for summary judgment. Id.

2. Plaintiff Lacks a Strong Mark

The Plaintiff does not have a strong mark in the descriptive term "best vacuum." Def.'s Resp. ¶¶ III.30- 43. As the discussion of survey evidence revealed, *supra* A.2.a, most people indicated that "best vacuum" meant a "descriptive term used to describe the best vacuum cleaner." Id. Nearly everyone (98%) had not heard of either Plaintiff or its domain name and do not associate the term "best vacuum" with Plaintiff. Id. The survey results clearly indicate that the Plaintiff does not have a strong mark or brand recognition in "best vacuum." Id. ¶¶ III.29-43. Its mark is not famous. Id. The Plaintiff has produced no evidence to the contrary. Pl.'s SUMF. Consequently, the Plaintiff has a weak mark in "best vacuum." There exists no genuine issue of material fact as to this issue. Thus, this factor weighs against finding likelihood of confusion.

3. Degree of Care by Consumers<sup>7</sup>

With respect to the degree of care exercised by consumers, this Court previously held:

Confusion is less likely where consumers are sophisticated and deliberative buyer. The more widely accessible and inexpensive the products and services, the more likely that consumers will exercise a lesser degree of care and discrimination in their purchases. The name-brand vacuum cleaners sold on Plaintiff's and Defendant's web sites range in price from approximately two hundred dollars (without accessories) to thirteen hundred dollars (without accessories). See [www.best-vacuum.com](http://www.best-vacuum.com). Consumer goods that cost over two hundred dollars are not inexpensive products so the Court assumes that the relevant consumers will exercise a fairly high degree of care.

Best Vacuum, Inc., 2005 U.S. Dist. LEXIS 9795 at \*31-32 (citations omitted). The Plaintiff has not submitted any evidence or argument to the contrary. See generally Pl.'s Mot.; Pl.'s Mem. Supp. Summ. Judg., p. 7; Pl.'s SUMF. Thus, this factor weighs against finding likelihood of confusion.

4. No Likelihood of Confusion

For the foregoing reasons, the Plaintiff has not and cannot demonstrate any likelihood of

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<sup>7</sup> The Parties agree that they both sell vacuums, particularly Dyson vacuums, and both do so on the Internet using their websites.<sup>7</sup> Def.'s Resp. ¶¶ III.1-4. However, neither party manufactures its own vacuums. Id. ¶ III.7.

confusion. See Ty, Inc., 237 F.3d at 897-899. Indeed, the evidence before this Court demonstrates the absence of any genuine issue of material fact as to a likelihood of confusion. A likelihood of confusion simply does not exist. Therefore, the Court must find in favor of Ian Design on the Parties' motions for summary judgment.

**C. No Viable Lanham Act Claims**

The evidence presented by Ian Design demonstrates, in its favor, the absence of any genuine issues of material fact. In contrast, the Plaintiff's evidence is not significantly probative. The mark "best vacuum" has not obtained secondary meaning and there does not exist any likelihood of confusion. Consequently, the Plaintiff does not have any viable Lanham Act Claims, and Ian Design is entitled to judgment as a matter of law. Thus, this Court must grant Ian Design's cross-motion for summary judgment and deny the Plaintiff's motion for summary judgment on the Lanham Act Claims. See Fed. R. Civ. P. 56(c); Anderson, 477 U.S. at 247-250; Cincinnati Ins. Co., 40 F.3d at 150; Matsushita Elec. Indus. Co., 475 U.S. at 586.

**IV. Dispositive as to All Remaining Claims**

As the disposition of the Lanham Act Claims resolves all remaining claims, this Court must grant Ian Design's cross-motion for summary judgment and deny Plaintiff's motion for summary judgment on the UDTPA claim. See, supra, Section II.

**CONCLUSION**

For the foregoing reasons, Ian Design, Inc. respectfully requests that the Court grant its Cross-Motion for Summary Judgment and deny Plaintiff's Motion for Summary Judgment in their entirety.

Dated: Chicago, IL  
February 23, 2006

Respectfully submitted,

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