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V. Sed Non Olet Denarious, Ltd., 817 F. Supp. 1103
(S.D.N.Y. 1993)

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TRADEMARK

MAJOR LEAGUE BASEBALL PROPERTIES, ET AL. V. SED NON OLET DENARIOUS, LTD., 817 F. Supp. 1103 (S.D.N.Y. 1993).

Major League Properties and the Los Angeles Dodgers ("L.A.") sued in equity for trademark infringement against defendant restaurant owners ("Brooklyn") for misappropriating the Brooklyn Dodgers trademark claimed by L.A.. In 1988, Brooklyn began operating restaurants exclusively in the Brooklyn borough of New York City which bore the name "The Brooklyn Dodger." After finding no restaurant or bar with such a service mark, Brooklyn registered the name with the office of Patents and Trademarks. Brooklyn also notified L.A. that they were going to use this mark. L.A. had ceased to use this mark in 1958 when it moved its baseball club from Brooklyn to Los Angeles. It resumed nationwide use of the mark in 1981 in limited form, licensing the mark, "Brooklyn Dodgers" to sportswear manufacturers and novelty item producers. Otherwise, it had licensed limited use of the mark to, inter alia, Dodger stadium hot dog concessionaires and to two restaurant owners, to the extent that they displayed memorabilia of both the Brooklyn and Los Angeles Dodgers. In 1989, after Brooklyn had made a considerable investment in their enterprise, and after L.A. had been on notice for a full nine months, L.A. demanded that Brooklyn cease and desist from use of the "Brooklyn Dodger" trademark. Brooklyn ultimately refused to do so, and this litigation followed.

Held: The court denied L.A. claim of infringement because L.A. had failed to prove the test in equity of the likelihood of confusion between its mark and Brooklyn's mark, and that in any event, L.A. had abandoned the "Brooklyn Dodger" trademark and stood on equal footing with Brooklyn as to its use. Using the eight part test set out in the *Polarad* case, the court held that although the two marks at issue bore great similarity, other factors, such as the disparity in services offered by the two parties, the lack of L.A.'s intent to enter the restaurant business, the sophistication and lack of actual confusion on the part of Brooklyn's customers, and the good faith effort of Brooklyn to ensure that no one else was using the mark in the restaurant business compelled a judgment denying L.A. its infringement claim. The court also held that under the Lanham Act, non-use of a trademark or servicemark is prima facie evidence of abandonment of that mark, and that L.A. failed to rebut that presumption. The court, however, refused to deny L.A. its trademark rights to the "Brooklyn Dodger" mark in

the clothing and novelty industry, but limited those rights in favor of Brooklyn's rights in their Brooklyn-based restaurants.

S.W.

FIRST AMENDMENT - FORFEITURE

ALEXANDER V. UNITED STATES, 113 S. Ct. 2766 (1993).

Ferris J. Alexander, Sr. ("Alexander"), petitioner, appeals an Eighth Circuit Court of Appeals decision which ordered him to forfeit his business and almost nine million dollars he acquired through racketeering activity. Alexander was in the "adult entertainment business," selling and renting sexually explicit material. He received these materials at a warehouse in Minnesota and then distributed his products through various retail stores in several Minnesota cities. In 1989, Alexander was charged in a forty-one count indictment which alleged both obscenity and RICO violations. After a four month jury trial, Alexander was convicted of seventeen obscenity offenses and three RICO offenses, predicated on the obscenity convictions. The District Court imposed a prison term and fine on Alexander, and ordered him to forfeit his business assets. The Court of Appeals affirmed.

Held: Forfeiture was a permissible punishment for Alexander and did not violate his First Amendment rights. The Court dismissed Alexander's argument that the forfeiture constituted an unconstitutional prior restraint on speech, since the term prior restraint pertains to court orders that actually forbid expressive activity before the communication occurs. The Court characterized the forfeiture order as merely depriving Alexander of assets derived from his prior racketeering activity, and not a prevention from engaging in expressive activity. Furthermore, the Court found Alexander's argument overbroad and inapposite since the RICO statute does not criminalize constitutionally protected speech. The Court of Appeals, however, should have determined whether RICO's forfeiture provisions resulted in an excessive penalty within the Eighth Amendment's excessive fines clause, restricting the government's power to demand payment as punishment for a criminal act. Vacated and remanded.

R.C.