

## **Fortune Dynamic, Inc. v. Victoria's Secret**

**618 F.3d 1025 (9th Cir. 2010)**

In *Fortune Dynamic, Inc. v. Victoria's Secret*, 618 F.3d 1025 (9th Cir. 2010), Fortune Dynamic sold women's shoes under the registered mark DELICIOUS in the font shown below on the left. To market a new line of products under the trademark BEAUTY RUSH, Victoria's Secret launched a promotion in which anyone who purchased more than \$35 worth of BEAUTY RUSH products would receive, among other things, a pink tank top across the chest of which, in silver typescript, was written the word "Delicious" as shown below on the right. "On the back, in much smaller lettering, there appeared the word "yum," and the phrase "beauty rush" was written in the back collar." *Id.* at 1025. Victoria's Secret distributed 602,723 such tank top shirts. Fortune Dynamic sued for trademark infringement.

In a lengthy opinion reversing the lower court's grant of summary judgment to Victoria's Secret and remanding for trial, the Ninth Circuit first considered the *Sleekcraft* factors for the likelihood of consumer confusion and found that a jury could reasonably find confusion. With respect to Victoria's Secret's fair use defense, the court concluded that a reasonable jury could find that Victoria's Secret was using the term "Delicious" as a trademark given the term's prominent placement on the front of the shirt, similar to where Victoria's Secret had placed two of its own trademarks PINK and VERY SEXY. The court also found issues of material fact on the question of whether Victoria's Secret was using the term "delicious" descriptively:

Victoria's Secret says that it used "Delicious" merely to "describe the flavorful attributes of Victoria's Secret's BEAUTY RUSH lip gloss and other products that feature the same popular fruit flavors." A jury, however, could reasonably conclude otherwise. For one thing, in its advertisements, Victoria's Secret described its BEAUTY RUSH lip gloss as "deliciously sexy," not delicious. For another, Victoria's Secret's executives testified that they wanted "Delicious" to serve as a "playful self-descriptor," as if the wearer of the pink tank top is saying, "I'm delicious." These examples suggest that a jury could reasonably decide that Victoria's Secret did not use "Delicious" "only to describe its goods." 15 U.S.C. § 1115(b)(4) . . . . [A]lthough we accept some flexibility in what counts as descriptive, we reiterate that the scope of the fair use defense varies with the level of descriptive purity. Thus, as a defendant's use of a term becomes less and less purely descriptive, its chances of prevailing on the fair use defense become less and less likely.

*Id.* at 1041-42. The court also noted Victoria's Secret's lack of "precautionary measures" to dispel confusion and the "abundance of alternative words" that it

could have used. *Id.* at 1042. On good faith, the court found that Victoria's Secret's failure to investigate whether anyone held a "delicious" trademark, combined with other evidence, suggested that a jury could reasonably find no good faith.



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