

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

BINNEY & SMITH, and : CIVIL ACTION
BINNEY & SMITH PROPERTIES, INC. :
 :
v. :
 :
ROSE ART INDUSTRIES : NO. 00-2939

MEMORANDUM AND ORDER

HUTTON, J.

December 20, 2000

Presently before this Court are Plaintiffs' Motion for a Preliminary Injunction (Docket No. 3) and Memorandum of Law in Support of Plaintiffs' Motion for a Preliminary Injunction, Defendant's Brief in Opposition (Docket No. 9) and Plaintiffs' Reply Memorandum in Support of Plaintiffs' Motion for a Preliminary Injunction (Docket No. 10). For the reasons set forth below, the Motion is **DENIED with leave to renew** by supplemental submission or by oral argument.

I. BACKGROUND

Plaintiffs are the makers of products under the name Crayola. When Crayola crayons were first produced in 1903, they were packaged in a green and yellow box. Since that time, Plaintiffs have continuously used the green and yellow color combination for the packaging of virtually all Crayola products. Approximately fifty years ago, Plaintiffs settled on the use of a green chevron laid over a yellow background. This design is still used today by Plaintiffs. Plaintiffs have eleven registered trademarks for this

green and yellow design.¹

On June 9, 2000, Binney & Smith Inc. and Binney & Smith Properties, Inc. ("Plaintiffs") filed a motion for preliminary injunction against Rose Art Industries, Inc. ("Defendant") pursuant to Rule 65 of the Federal Rules of Civil Procedure. Plaintiffs' are seeking a preliminary injunction against Defendant based on alleged trademark infringement, dilution of their trademark and trade dress infringement. In particular, Plaintiffs seek to preliminarily enjoin Defendant from shipping, selling, advertising or promoting marker products in packaging using the green and yellow color combination and to enjoin Defendant from shipping, selling, advertising or promoting marker products in any other packaging that dilutes or is likely to cause confusion with Plaintiffs' use of the green and yellow color combination in the packaging of its Crayola markers, crayons or related products.

Plaintiffs allege that Defendant seeks to capitalize on the fame and recognition of Plaintiffs' mark by launching a line of children's markers in packaging that blatantly copies the Crayola green and yellow color scheme. Furthermore, Defendant's use of the Crayola green and yellow color scheme constitutes a direct misappropriation of the reputation and goodwill associated with

¹ Plaintiffs list two registered trademarks in their Motion. They are:
(1) Registration No. 1,252,617, issued by the U.S. PTO on October 4, 1983, for the chevron design, including the green and yellow colors, on chalk, crayons and numerous other products;
(2) Registration No. 1,924,580, issued by the U.S. PTO on October 3, 1995, for the green and yellow chevron in connection with the sale of markers.

Plaintiffs' famous trademark and trade dress. As a result of Defendant's alleged acts, Plaintiffs ask this Court to grant a preliminary injunction.

II. STANDARD OF REVIEW

The grant of injunctive relief "is an 'extraordinary remedy, which should be granted only in limited circumstances.'" See *Instant Air Freight Co. v. C.F. Air Freight, Inc.*, 882 F.2d 797 (3d Cir. 1989). The Court must carefully weigh four factors in deciding whether to issue a preliminary injunction: "(1) whether the movant has shown a reasonable probability of success on the merits; (2) whether the movant will be irreparably injured by denial of the relief; (3) whether granting preliminary relief will result in even greater harm to the nonmoving party; and (4) whether granting the preliminary relief will be in the public interest." See *Allegheny Energy, Inc., v. DQE, Inc.*, 171 F.3d 153, 158 (3d Cir. 1999). Nevertheless, if the Court finds that "either or both of the fundamental preliminary injunction requirements - a likelihood of success on the merits and the probability of irreparable harm if relief is not granted - to be absent," the Court cannot issue an injunction. See *McKeesport Hosp. v. Accreditation Council for Graduate Medical Educ.*, 24 F.3d 519, 523 (3d Cir. 1994). For a movant to prove irreparable harm, it must demonstrate "potential harm which cannot be redressed by a legal or an equitable remedy following trial." See *Instant Air Freight*, 882

F.2d at 801. "Mere injuries, however substantial, in terms of money, time and energy necessarily expended in the absence of a stay are not enough. The possibility that adequate compensatory or other corrective relief will be available at a later date, in the ordinary course of litigation, weighs heavily against a claim of irreparable harm." Id. Thus, an injury warranting a preliminary injunction must "be of a peculiar nature, so that compensation in money cannot atone for it" See *Acierno v. New Castle County*, 40 F.3d 645, 653 (3d Cir. 1994). Further, the irreparable injury claimed by the movant cannot be speculative or remote. "[M]ore than a risk of irreparable harm must be demonstrated." Id. at 655.

III. DISCUSSION

Plaintiffs bring three causes of action against Defendant: trademark infringement, dilution of their trademark and trade dress infringement. They will be discussed in that order.

A. Trademark Infringement Claim

"The law of trademark protects trademark owners in the exclusive use of their marks when use by another would be likely to cause confusion." See *Interpace Corp. v. Lapp, Inc.*, 721 F.2d 460, 462 (3d Cir. 1983). A claim of trademark infringement is established when the plaintiff proves that: (1) its mark is valid and legally protectable; (2) it owns the mark; and (3) the

defendant's use of the mark to identify its goods or services is likely to create confusion concerning the origin of those goods or services. See *A & H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, Civ.A. 99-1734, 99-1735, 2000 WL 1763334, *5 (3d Cir. 2000); *Commerce Nat. Ins. Servs., Inc. v. Commerce Ins. Agency, Inc.*, 214 F.3d 432, 437 (3d Cir. 2000); *Opticians Ass'n of Am. v. Indep. Opticians of Am.*, 920 F.2d 187, 192 (3d Cir. 1990). If the mark at issue is federally registered and has become incontestible, then validity, legal protectability, and ownership are proved. See *Commerce Nat.*, 214 F.3d at 438; *Ford Motor Co. v. Summit Motor Prods.*, 930 F.2d 277, 292 (3d Cir. 1991). A mark becomes incontestable after the owner files affidavits stating that the mark has been registered, that it has been in continuous use for five consecutive years, and that there is no pending proceeding and there has been no adverse decision concerning the registrant's ownership or right to registration. See *Fisons Horticulture, Inc. v. Vigoro Industries, Inc.*, 30 F.3d 466, 472 n. 7. (3d Cir. 1994).

Here, the elements requiring a mark to be valid, protectable and owned by the Plaintiffs are satisfied. First, Plaintiffs' marks are registered. See Affidavit of David E. Hall, ¶¶ 9, 19. Second, the marks are incontestable under the Lanham Act because they have been in continuous use for five consecutive years, there is no pending proceeding and there has been no adverse decision concerning the registrant's ownership or right to registration. See

id. Thus, the validity, legal protectability, and ownership of Plaintiffs marks are proved.

The final element of a trademark infringement claim is whether Defendant's use of the mark to identify its goods or services is likely to create confusion concerning the origin of those goods or services. A likelihood of confusion exists when "consumers viewing the mark would probably assume that the product or service it represents is associated with the source of a different product or service identified by a similar mark." See *Dranoff Perlstein Assocs. v. Sklar*, 967 F.2d 852, 862 (3d Cir. 1992) (quotation marks omitted). In *Interpace Corp. v. Lapp, Inc.*, 721 F.2d 460 (3d Cir. 1983), the United States Court of Appeals for the Third Circuit stated that when the goods involved in a trademark infringement action directly compete with each other, a court "need rarely look beyond the mark itself" to determine the likelihood of confusion. *Id.* at 462. For noncompeting goods, the Third Circuit developed a nonexhaustive list of factors to consider in determining whether there is a likelihood of confusion between marks. These factors are:

1. the degree of similarity between the owner's mark and the alleged infringing mark;
2. the strength of the owner's mark;
3. the price of the goods and other factors indicative of the care and attention expected of consumers when making a purchase;
4. the length of time the defendant has used the mark without evidence of actual confusion arising;
5. the intent of the defendant in adopting the mark;
6. the evidence of actual confusion;

7. whether the goods, though not competing, are marketed through the same channels of trade and advertised through the same media;
8. the extent to which the targets of the parties' sales efforts are the same;
9. the relationship of the goods in the minds of consumers because of the similarity of function;
10. other facts suggesting that the consuming public might expect the prior owner to manufacture a product in the defendant's market, or that he is likely to expand into that market.

Id. at 463 (citing *Scott Paper Co. v. Scotts Liquid Gold, Inc.*, 589 F.2d 1225, 1229 (3d Cir. 1978)). In a recent opinion, the Third Circuit held that whether or not the goods directly compete, these factors should be employed to test for likelihood of confusion. See *A & H Sportswear, Inc.*, 2000 WL 1763334, at *9. The Court, however, noted that a district court is not mandated to use these factors. See *id.*

1. **The degree of similarity between the owner's mark and the alleged infringing mark**

"The single most important factor in determining likelihood of confusion is mark similarity." *Id.* at *11, *Fisons*, 30 F.3d at 476. "The test for such similarity is whether the labels create the same overall impression when viewed separately." *A & H Sportswear*, 2000 WL 1763334, at *11; *Fisons*, 30 F.3d at 476. Marks "are confusingly similar if ordinary consumers would likely conclude that [the two products] share a common source, affiliation, connection or sponsorship." *A & H Sportswear*, 2000 WL 1763334, at *11; *Fisons*, 30 F.3d at 476. "Side-by-side comparison of the two marks is not the proper method for analysis when the products are not usually

sold in such a fashion." See *A & H Sportswear*, 2000 WL 1763334, at *11. If, however, goods are sold "side-by-side" then it is reasonable to compare the marks side by side. See 3 J. THOMAS MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:59 (4th ed. 1997).²

Here, Plaintiffs assert that Defendant infringed their trademarks that they claim protects the Crayola color scheme: a green chevron laid over a yellow background. Plaintiffs posit that there are eleven registered trademarks for the green and yellow design. They, however, point to only two in their Motion. One registered trademark covers a chevron. See Affidavit of David E. Hall, exhibit C. The register indicates that the drawing is lined for the colors green and yellow. See *id.* Plaintiffs other trademark covers another chevron design that is also lined for the colors green and yellow. See *id.* exhibit R. Color was claimed in that application. See *id.* Plaintiffs also point to the "Crayola Green and Yellow" combination as protectable, but the Court fails to distinguish this mark from Plaintiffs' registered marks.

In comparing the marks side-by-side, the mark used by Plaintiffs is an orange-yellow background upon which is laid a dark green in the form of a chevron. Defendant's package consists of a neon green background upon which is laid a bright yellow oval.

² Because the law is unclear whether only a side-by-side comparison is appropriate where the goods are sold in the same manner, the Court will analyze Plaintiffs Motion under both approaches.

Based on this comparison alone, it is clear that Defendant's mark is different from Plaintiffs' protected trademark, a green and yellow chevron. Based on this side-by-side comparison, there is little similarity between the owner's mark and the alleged infringing mark.

When viewed separately, the Court finds that the marks do not create the same overall impression and the marks are not confusingly similar. Ordinary consumers would not likely conclude that the two products share a common source, affiliation, connection or sponsorship. First, Plaintiffs' registered marks consist of a chevron lined with the colors green and yellow. Although Plaintiffs protected the use green and yellow in connection with its marks, Defendant, however, uses different shades of green and yellow with its mark. Second, Plaintiffs' protected marks consist of a distinctive symbol: a green chevron. Defendant's mark provides a different impression because Defendant uses a neon green background over a yellow oval. Based on this comparison, the Court concludes that Defendant's mark is not similar.

Furthermore, otherwise similar marks are not likely to be confused where used in conjunction with the clearly displayed name and or logo of the manufacturer. See *id*; see also *Henri's Food Prods. Co. Inc, v. Kraft, Inc.* 717 F.2d 352, 355-56 (7th Cir. 1983). Here, Defendant's alleged infringing mark is the use of a

green and yellow color scheme. Defendant's "Rose Art" housemark is prominently displayed on its package in conjunction with the color scheme. Moreover, Defendant's housemark appears in white letters on a bold black background. The bold black oval is surrounded by a bright rainbow band that communicates that Defendant is the source of the product. Any similarity that may exist between Defendant's and Plaintiffs' trademark is significantly diminished by the use of Defendant's housemark.

Based on the overall impression of Plaintiffs' and Defendant's marks, the Court concludes that the two marks are not similar and this first and very important factor weighs in favor of Defendant.

2. The strength of the owner's mark

The next element examined is the strength of the owner's mark. The strength of the owner's mark is measured by both the distinctiveness or conceptual strength of the mark and the commercial strength or marketplace recognition of the mark. See *A & H Sportswear, Inc.*, 2000 WL 1763334, at *15; *Fisons*, 30 F.3d at 479. The level of distinctiveness or conceptual strength is determined by a classification as generic, descriptive, suggestive and arbitrary or fanciful. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 , 768 (1992).

Here, the Court determines that Plaintiffs' marks are arbitrary or fanciful because the marks "neither describe nor suggest anything about the product . . . [and] they 'bear no

logical or suggestive relation to the actual characteristics of the goods.'" See *A & H Sportswear, Inc.*, 2000 WL 1763334, at *16; see also *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 296 (3d Cir. 1986). This Court finds Plaintiffs mark is arbitrary because the green and yellow color scheme in conjunction with a chevron bears no relationship to markers, crayons and other goods Plaintiffs sell.

Arbitrary marks, however, may be weak marks if they are used in connection with a number of different products. See *A & H Sportswear, Inc.*, 2000 WL 1763334, at *16. Defendant's demonstrate evidence showing that Plaintiffs' mark is conceptually weaker than Plaintiffs' assert. First, at least three other crayon and writing instrument manufacturers have used green and yellow for their products. See Declaration of Lawrence Rosen, ¶¶ 10-11 and exhibits C-E. The companies used packages with the green and yellow color schemes almost identical to that of Plaintiffs. See *id.* exhibits C-E. The use of this color scheme has a weakening effect on Plaintiffs' mark. The strength of the marks is weakened because if consumers are aware that a particular mark, such as Plaintiffs color scheme, is often used to designate a variety of products made by a variety of manufacturers, that consumer will be less likely to assume that in a particular case, two individual products, both with a similar mark, came from the same sources. See *A & H Sportswear, Inc.*, 2000 WL 1763334, at *18. Based on this analysis,

the Court finds Plaintiffs' marks to be somewhat distinct because although other competitors have been shown to use a green and yellow color scheme, no evidence has been shown that any competitor also uses Plaintiffs' chevron design.

The Court must also examine the commercial strength or marketplace recognition of the mark. Advertising expenses and public recognition demonstrate commercial strength and marketplace recognition. See *A & H Sportswear, Inc.*, 2000 WL 1763334, at *18. During the last five years, Plaintiffs spent nearly \$200 million in advertising, promotional and marketing activity for products sold under the Crayola name. See Affidavit of David E. Hall, ¶ 6. Plaintiffs have sold over \$1.5 billion worth of its products. See *id.* Plaintiffs also offer evidence that demonstrates a high marketplace recognition among its target consumers, the mothers of young children. See *id.*, ¶ 7, exhibit A. A survey conducted in 1999 revealed that ninety two percent of mothers of children aged 2-12 demonstrated an unaided brand awareness Crayola. See *id.* As to Plaintiffs markers, eighty percent demonstrated unaided awareness and ninety six percent demonstrated aided awareness. See *id.* In the same survey, eighty four percent of mothers viewed Crayola as a high quality brand and eighty three viewed Crayola as a brand "I can trust." See *id.* Plaintiffs efforts, through marketing and advertising, has been demonstrably successful based on the substantial brand recognition. As a result, the Court

concludes that Plaintiffs mark has a high level of commercial strength.

Considering the distinctiveness and commercial recognition of Plaintiffs' mark, the Court concludes that this factor weighs in favor of Plaintiffs and Plaintiffs have a strong mark.

3. **The price of the goods and other factors indicative of the care and attention expected of consumers when making a purchase**

The Court believes this factor weighs in favor of finding a likelihood of confusion because the products are relatively inexpensive and customers bring little care when making the purchase. See Pls['] Memo of Law in Support of Pls['] Preliminary Injunction, at 13.

4. **The length of time the defendant has used the mark without evidence of actual confusion arising**

Defendant's product has been sold since June, 2000. See Declaration of Lawrence Rosen, ¶ 13. Since that time, Defendant has shipped at least 214,900 units of the product contained in this package and there has been no evidence of actual confusion. See id. Plaintiffs acknowledge that there is no evidence of actual confusion. See Pls['] Memo. of Law, at 13, ¶ 4. Based on this information, the Court concludes this factor weighs in favor of Defendant.

5. **The intent of the defendant in adopting the mark**

Intent is relevant to the extent that it bears on the likelihood of confusion. See *A & H Sportswear*, 2000 WL 1763334, at *20. The Third Circuit has held that a defendant's mere intent to copy, without more, is not sufficiently probative of the defendant's success in causing confusion to weigh such a finding in the plaintiffs' favor. See *id.* Rather, a defendant's intent will indicate a likelihood of confusion only if an intent to confuse consumers is demonstrated via purposeful manipulation of the junior mark to resemble the senior's. See *id.*; *Versa Prods. Co. Inc.*, 50 F.3d 189, 205-06 (3d Cir. 1995). Plaintiffs allege bad faith on the part of Defendant in choosing its "new package" because it has been a long competitor of Plaintiffs and because Defendant failed to protect another color scheme not involved with this instant matter. See Pls['] Memo. of Law, at 13, ¶ 5. Plaintiffs' allegations are undercut because Defendant has used green and yellow packaging for "classic" markers before. See Declaration of Lawrence Rosen, ¶ 7. Defendant offers two examples of a green and yellow color scheme it used to sell its markers. See *id.* This would suggest, contrary to Plaintiffs' charge that Defendant's package is new, that Defendant's package is simply an update of a previously used color scheme. To do so can hardly be considered a purposeful manipulation of Defendant's mark to resemble the Plaintiffs'. The Court thus finds that this factor weighs in favor of Defendant.

6. The evidence of actual confusion

As indicated in discussing factor number four above, there has been no evidence of actual confusion presented to this Court.

7. Factors 7, 9 and 10

The Third Circuit has stated that a district court need not apply each and every factor. See *A & H Sportswear*, 2000 WL 1763334, at *9. The Court in this case declines to discuss factors 7, 9 and 10 because, as the Third Circuit noted, "[t]hese factors are not apposite for directly competing goods. The Plaintiffs and Defendant products are "competing, their function is the same, and the senior and junior already use each other's markets." See *id.*

8. The extent to which the targets of the parties' sales efforts are the same

Factor 8 clearly weighs in favor of Plaintiffs. Both Plaintiffs and Defendant are selling the same exact product and necessarily target the same group of consumers.

Based on an analysis and consideration of the factors discussed above, the Court concludes that Plaintiffs' marks and the mark used by Defendant are not so similar that they are likely to cause confusion. As a result, the third element of a trademark infringement claim has not been established. The Motion for preliminary injunction on these grounds must fail because Plaintiffs have failed to demonstrate a reasonable probability of success on the merits.

B. Dilution Claim

The Federal Trademark Dilution Act of 1995 provides:

The owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark, and to obtain such other relief as is provided in this subsection.

15 U.S.C. § 1125(c)(1) (West 2000).

The federal cause of action for trademark dilution grants extra protection to strong, well-recognized marks even in the absence of a likelihood of consumer confusion, the classical test for trademark infringement, if the defendant's use diminishes or dilutes the strong identification value associated with the plaintiff's famous mark. 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:70 (4th ed. 1997). The dilution doctrine is founded upon the premise that a gradual attenuation of the value of a famous trademark, resulting from another's unauthorized use, constitutes an invasion of the senior user's property rights in its mark and gives rise to an independent commercial tort for trademark dilution. Id.

To establish a prima facie claim for relief under the federal dilution act, the plaintiff must plead and prove:

1. The plaintiff is the owner of a mark that qualifies as a "famous" mark in light of the totality of the eight factors listed in § 1125(c)(1),
2. The defendant is making commercial use in interstate commerce of a mark or trade name,
3. Defendant's use began after the plaintiff's mark became

- famous, and
4. Defendant's use causes dilution by lessening the capacity of the plaintiff's mark to identify and distinguish goods or services.

See 4 McCarthy, *supra*, S 24:89; see also *Hershey Foods Corp. v. Mars, Inc.*, 998 F.Supp. 500, 504 (M.D. Pa. 1998).

Plaintiffs claim that Defendant's package will likely dilute Plaintiffs' famous Crayola mark by "blurring" the distinctiveness of the Crayola green and yellow color scheme. See Plaintiffs' Memo. of Law, at 20. Blurring occurs when the defendant's use of its mark causes the public to no longer associate the plaintiff's famous mark with its goods and services; the public instead begins associating both the plaintiff and the defendant with the famous mark. See *Times Mirror Magazines, Inc. v. Las Vegas Sports News, L.L.C.*, 212 F.3d 157, 168 (3d Cir. 2000). In *Times Mirror*, the Third Circuit adopted a 10 part test. See *id.* The factors include:

1. Similarity of the marks;
2. Similarity of the products covered by the marks;
3. Sophistication of consumers;
4. Predatory intent;
5. Renown of the senior mark;
6. Renown of the junior mark;
7. Actual confusion and likelihood of confusion;
8. Shared customers and geographic isolation;
9. The adjectival quality of the junior use; and
10. The interrelated factors of duration of the junior use, harm to the junior user and delay by the senior in bringing the action.

See *id.*

We limit our discussion to the factors that we find most

relevant to our inquiry. See *McNeil Consumer Brands, Inc. v. U.S. Dentek Corp.*, 116 F.Supp.2d 604, 606 (E.D. Pa. Sep 22, 2000). Here, several factors weigh in Defendant's favor and indicate Plaintiffs have failed to demonstrate dilution. As more fully discussed in connection with Plaintiffs' trademark infringement claim, the marks are not similar. The marks used by Plaintiffs involve an orange-yellow background upon which is laid a dark green in the form of a chevron. Defendant's package consists of a neon green background upon which is laid a bright yellow oval. There is no use of a chevron. Also discussed above was the lack of evidence showing actual confusion or the likelihood of confusion. In addition, Plaintiffs claim that Defendant's mark "has no 'renown' of its own" and in this connection "its trade name itself is scarcely known to consumers." See Pls['] Memo. of Law, at 21. Defendant, however, has used the green and yellow packaging for classic markers. See Affidavit of Lawrence Rosen, ¶ 7. Defendant's assert that it used the a green and yellow color scheme at issue in this instant matter in 1996. See *id.* Also contrary to Plaintiffs assertions that Defendant's trade name, "Rose," is scarcely known, Defendant has been in business since 1923 and has sold over \$1 billion of products bearing Defendant's trade name. See *id.* ¶ 4. Intent was also discussed above and there the Court determined Plaintiffs allegations of Defendant's predatory intent were undercut because Defendant has used green and yellow packaging

for "classic" markers on prior packaging. See Declaration of Lawrence Rosen, ¶ 7. Although the other factors weigh in favor of Plaintiffs, the Court concludes that Defendant's mark will not dilute Plaintiffs' mark. Accordingly, a preliminary injunction on these grounds cannot be ordered because Plaintiffs have failed to demonstrate a reasonable probability of success on the merits.

C. Trade Dress Infringement

To obtain trade dress protection under section 43(a) of the Lanham Act, Plaintiffs must prove that (1) the design is non functional; (2) the design was inherently distinctive or distinctive by virtue of having acquired secondary meaning; and (3) there was a likelihood of confusion. See *Versa Prods. Co, Inc.*, 50 F.3d 189, 200 (3d Cir. 1995). A plaintiff may prevail in a trade dress infringement action only if it shows that an appreciable number of ordinarily prudent consumers of the type of product in question are likely to be confused as to the source of the goods. See *id.*; see also *Nikon, Inc. v. Ikon Corp.*, 987 F.2d 91, 94 (2d Cir. 1993); *West Point Mfg. Co. v. Detroit Stamping Co.*, 222 F.2d 581, 589 & n. 2 (6th Cir. 1955). "The mere possibility that a customer may be misled is not enough." See *Versa Prods. Co., Inc*, 50 F.3d at 200; see also *Surgical Supply Serv., Inc. v. Adler*, 321 F.2d 536, 539 (3d Cir. 1963).

Here, in Plaintiffs' Memorandum of Law in Support of its Motion for a Preliminary Injunction, the memorandum included an

exhibit that displayed Defendant's trade dress. See Plaintiffs' Memo. in Support of Motion for Preliminary Injunction, at 6. In Plaintiffs' Reply Memorandum, Plaintiffs include an altered version of Defendant's trade dress. See Plaintiffs' Reply Memo, exhibit B. This difference raises question for this Court that warrant further submissions or oral argument by the parties. Based on the submission by the parties to this Court, it is uncertain which of Defendant's package was actually introduced into commerce. Also, it appears from the exhibits that the shade of green is different between the two exhibits. It is unclear to what extent, if at all, these changes alter the arguments made by the litigants. Because of these concerns, the Court declines at this time to discuss Plaintiffs' trade dress claims.

An appropriate Order follows.

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

BINNEY & SMITH, and : CIVIL ACTION
BINNEY & SMITH PROPERTIES, INC. :
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v. :
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ROSE ART INDUSTRIES : NO. 00-2939

O R D E R

AND NOW, this day of December, 2000, upon consideration of Plaintiffs' Motion for Preliminary Injunction (Docket No. 3) and Memorandum of Law in Support of Plaintiffs' Motion for a Preliminary Injunction, Defendant's Brief in Opposition (Docket No. 9) and Plaintiffs' Reply Memorandum in Support of Plaintiffs' Motion for a Preliminary Injunction (Docket No. 10), IT IS HEREBY ORDERED that said Motion is **DENIED with leave to renew** by supplemental submission or by oral argument.

BY THE COURT:

HERBERT J. HUTTON, J.