

Doc Can't Block Bausch & Lomb's Slogan Use, Judge Says

By **Dan Prochilo**

Law360, New York (September 04, 2013, 7:39 PM ET) -- A Florida federal judge refused to grant a preliminary injunction Wednesday against Bausch & Lomb Inc. over its use of a Florida ophthalmologist's trademarked slogan, "See Better. Live Better," adopting the recommendation of a magistrate judge who felt such an order was unwarranted because the claims were likely to fail.

The court overruled Dr. Stuart Kaufman's objections to the recommendation of U.S. Magistrate Judge Elizabeth Jenkins, who found that Kaufman's trademark was weak and B&L's use of the phrase was unlikely to cause confusion among consumers.

U.S. District Judge Virginia Hernandez Covington agreed with the magistrate judge that the doctor "failed to establish that he is entitled to the extraordinary relief provided by a preliminary injunction."

Kaufman brought the case against the eyewear giant in February, arguing that B&L should be held liable for "reverse confusion" because it has used the slogan so regularly that the public will mistakenly believe B&L is the owner of the trademark and Kaufman is the infringer. Kaufman owns the mark in connection with ophthalmology services.

B&L launched a counterclaim in April, saying the mark should be canceled because it is merely descriptive or generic and is commonly used in the eye-care industry. The company said no one should have exclusive rights over the popular phrase.

The extensive use of the phrase demonstrated that it no longer served to identify a particular service provider.

"[W]hen a consumer sees the phrase 'See Better. Live Better,' the consumer does not associate it with Dr. Kaufman," the company said.

Judge Jenkins **determined** in late July that the trademark is merely descriptive and without a secondary meaning, and is therefore not protectable, citing many uses of the phrase by third parties in the industry. Based on this determination, she decided that Kaufman's claims were unlikely to succeed, which would have been sufficient to deny the injunction on its own.

But the judge also found that Kaufman had failed to produce evidence showing his business had been irreparably harmed by B&L's alleged infringement.

Kaufman argued that such harm should be presumed in trademark cases, but the magistrate judge cited an Eleventh Circuit ruling that found such a presumption could only be made if the plaintiff had shown a likelihood of success on the merits, which Kaufman had not.

The ophthalmologist filed an objection to the magistrate judge's report in early August, saying it contained a number of errors and that his mark was suggestive — meaning the reader had to

use some imagination or thought to determine what it was advertising — rather than merely descriptive.

He also claimed B&L challenged the validity of the mark only after he filed his complaint, but the company obviously felt differently about it when it allegedly offered to purchase his trademark registration from him in 2011 — an offer Kaufman says he declined.

The doctor argued the magistrate's decision, if adopted, would give too little weight to decisions of the U.S. Patent and Trademark Office, and he said "it would be extraordinary if a preliminary injunction were not granted" in the case, considering how B&L ripped off the mark "and used it in identical channels of trade and advertising to designate overlapping services with full knowledge of Kaufman's prior use."

The district court judge remained skeptical, however, saying the magistrate's report was "well-reasoned" and the objections provided no basis to reject it.

An attorney for B&L declined to comment Wednesday. A representative for Kaufman could not be immediately reached for comment.

Kaufman is represented by Stefan V. Stein and Debra Faulk of GrayRobinson PA.

Bausch & Lomb is represented by Floyd A. Mandell, Carolyn M. Passen and Julia L. Kasper of Katten Muchin Rosenman LLP and local counsel Anne-Leigh Moe.

The case is Stuart J. Kaufman, M.D. & Associates, P.A. v. Bausch & Lomb Inc., case number 8:13-cv-00461 before the U.S. District Court for the Middle District of Florida.

--Editing by Richard McVay.

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