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Post-Termination Injunctions: Trademarks

Federal District Court Rules That Similarity of a Former Franchisee's Trademark to the Franchisor's Warrants an Injunction

In *You Fit, Inc. v. Pleasanton Fitness, LLC*, 2013 U.S. Dist. LEXIS 18106 (M.D. Fla. Feb. 8, 2013), a federal court in Florida granted the motion of You Fit, a franchisor, for a preliminary injunction under trademark law. The court found that the defendant former franchisee's operation of FIT U health clubs was confusingly similar to the franchisor's YOUFIT health clubs.

The court discussed the seven factors used to evaluate whether there was a likelihood of confusion, focusing primarily on the two most important—the strength of the plaintiff's mark and any actual confusion. The court determined YOUFIT to be a suggestive mark, requiring a customer to use his or her imagination to leap from the mark to the services of a health club. A suggestive mark is afforded a heightened level of protection, as compared to the protective given a merely descriptive term that had acquired secondary meaning. On the other hand, while suggestive, YOUFIT was deemed weak because of the common usage of the words "you" and "fit" in the fitness industry. Nevertheless, the court further determined that there were indications of actual confusion about the affiliation between the two businesses, based on reviews posted on the website yelp.com. Those postings, combined with the similarity in appearance, sound, and meaning between the marks YOUFIT and FIT U in the health club context— and by businesses competing for the same customers and having similar websites—led the court to conclude that there was a likelihood of confusion. Consequently, the franchisor was found likely to succeed on the merits of its trademark infringement, trademark dilution, and unfair competition claims, all warranting the issuance of a preliminary injunction.

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