

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF KANSAS**

BIG DOG MOTORCYCLES, L.L.C.,

Plaintiff,

v.

Case No. 04-2419-JWL

BIG DOG HOLDINGS, INC.,

Defendant.

MEMORANDUM AND ORDER

This is a declaratory judgment action involving claims for trademark infringement and unfair competition. Plaintiff Big Dog Motorcycles, L.L.C. (Motorcycles) seeks a declaratory judgment that its use of the mark “Big Dog Motorcycles” in conjunction with the sale of motorcycles, motorcycle parts and accessories, promotional products (including apparel and collectibles), and related services does not infringe upon defendant Big Dog Holdings’ (Holdings) marks, or otherwise constitute unfair competition under the Lanham Act. This matter is before the court on Motorcycles’ motion for summary judgment (Doc. 69). By way of this motion, Motorcycles asks the court to grant the requested declaratory relief on the grounds that Holdings has failed to establish a genuine issue of material fact concerning the likelihood of confusion among consumers as to the source, sponsorship, or affiliation of Motorcycles’ products. For the reasons explained below, the court finds that no rational trier of fact could find a likelihood of confusion between the two sets of products. Accordingly, the court will grant Motorcycles’ motion in its entirety.

STATEMENT OF FACTS

Consistent with the well established standard for evaluating a motion for summary judgment, the following facts are uncontroverted or, if disputed, are viewed in a light most favorable to Holdings, the non-moving party. *See Adler v. Wal-Mart Stores, Inc.*, 144 F.3d 664, 670 (10th Cir. 1998) (setting forth summary judgment standards).

A. General Nature of the Parties and the Origin of Their Dispute

Holdings is a holding company for related entities that market and sell clothing and other consumer products bearing the “Big Dogs” and “Big Dog” trademarks and other related marks, which it also licenses to third parties for a variety of goods and services. Holdings’ predecessor, Sierra West, first used the name “Big Dogs” in 1984. In 1992, Andrew Feshbach, Holdings’ current chief executive officer, and another investor, Fred Kayne, bought the assets of Sierra West out of bankruptcy. They changed the name of the company to Big Dog Holdings for the parent corporation and established operating companies of Big Dogs U.S.A., Inc. and Big Dogs Sportswear, among others. Big Dog U.S.A., Inc. develops, markets, and sells a collection of high quality consumer lifestyle products such as activewear, casual sportswear, accessories, and gift items under the brand name “Big Dogs.” Holdings is the owner of numerous trademarks and service marks registered with the United States Patent and Trademark Office and around the world for the mark “Big Dogs” and related marks, including “Big Dogs” for all manner of clothing (specifically including t-shirts) and a number of other consumer goods and services, including a wide variety of recreational and sports equipment,

watches and clocks, sunglasses, and mail order and retail store services featuring clothing, jewelry, accessories, home furnishings, and sporting goods.¹

Motorcycles manufactures and sells high-end customized motorcycles. Sheldon Coleman is Motorcycles' founder and chief executive officer. According to Mr. Coleman, he first used the term "Big Dog" in conjunction with one of his other endeavors in the early 1980s. At that time (before Holdings' predecessor Sierra West first utilized the Big Dog mark in 1984), Mr. Coleman organized a band called Dewy and the Big Dogs. Sometime after 1985, Mr. Coleman saw a t-shirt made by Sierra West that had a picture of a St. Bernard-like dog with the words "Big Dogs." Mr. Coleman contacted Sierra West and suggested a co-promotion on a big dog theme between Sierra West, Dewy and the Big Dogs, and The Coleman Company, a company for which he was at that time the chief executive officer. Sierra West rejected Mr. Coleman's proposal. In 1988, Mr. Coleman continued his commercial use of the term "Big Dog" when he incorporated Big Dog Productions, Inc., a music recording studio in Wichita.

In 1992, Mr. Coleman began customizing Harley Davidson motorcycles in his own residential garage with the help of a motorcycle mechanic. Later that year, he moved the operation to a larger, commercial space and formed the company Big Dog Custom Motorcycles.² By 1993, Big Dog Custom Motorcycles had three people working to customize

¹ A number of these marks were registered prior to 1994 (when Motorcycles was formed) and many were based on use prior to 1994.

² There is no evidence that Mr. Coleman made any further attempt (after Sierra West rejected his suggestion of doing a co-promotion between the two companies in the 1980s) to determine how Holdings was using its marks at the time he adopted this as the name of his motorcycle company. He stated in his deposition that at the time he formed his motorcycle

Harley Davidson motorcycles, which were then sold. In 1994 the company shifted from customizing Harley Davidson motorcycles to making its own motorcycles from after-market parts. Consistent with this new approach, Mr. Coleman changed the name of the business to Big Dog Motorcycles, L.L.C., the name that it has today. According to his deposition testimony and an affidavit from him, he believed “Big Dog Motorcycles” was an appealing name because it connoted a certain image that fit well with motorcycle culture, it had a good rhythm and sound, and he had a previous association with the term “Big Dog.”

In June of 1995, Holdings contacted Motorcycles claiming that Motorcycles’ use of the name “Big Dog Motorcycles” violated Holdings’ trademarks. Holdings expressed concern that Motorcycles’ sale of t-shirts constituted an infringement of Holdings’ trademarks, but Holdings stated that it did not at that time oppose Motorcycles’ use of the name Big Dog Motorcycles on motorcycles. Holdings demanded that Motorcycles cease using the “Big Dog” mark or any confusingly similar mark in connection with any t-shirts or other items of apparel. This led to the two companies filing lawsuits against each other. These actions were eventually settled in 1997. The settlement agreement provided that Motorcycles would assign its rights in the marks “Big Dog,” “Big Dog Motorcycles,” “Big Dog Service Center,” and the “Big Dog Motorcycles” logo to Holdings in return for an exclusive, perpetual license to use the marks in conjunction with its business under the terms set forth in a license agreement.

business he planned to sell clothing under the “Big Dog Motorcycles” mark.

Holdings unilaterally terminated the license agreement in August of 2004. Under the terms of the settlement agreement, this meant that the parties' relative positions reverted to the time of the settlement. At the time Holdings terminated the license agreement, Holdings demanded that Motorcycles cease using the names "Big Dog" and "Big Dog Motorcycles" with its business. Shortly thereafter, Motorcycles brought this action seeking a declaratory judgment of noninfringement and no unfair competition. Following is a more thorough explanation of the manner in which each of the parties uses the marks at issue.

B. Big Dog Holdings, Inc.

A picture of the exterior of a Big Dogs store, a copy of its catalog, and its Internet website reflects that Holdings uses the wording "Big Dogs" in stenciled capital letters on its signage, point of sale materials, catalogs, and web site, and that this logo is commonly displayed in close proximity to Holdings' distinctive black and white dog. Holdings frequently, but not exclusively, uses this black and white, anthropomorphic dog "character" on many of its products. For example, Holdings' biggest selling product is t-shirts and the "Big Dogs" logo in combination with the black and white dog appears on the vast majority of Holdings' t-shirts as a decorative element and/or on the tags and labels.

The "Big Dog(s)" marks are used so that products on which they appear will appeal to a wide range of consumers who want to send a message about themselves to those who see them with the "Big Dog(s)" products: men, women, and children of all ages, and especially baby boomers and their children who have an interest in any of a wide variety of leisure or recreational activities—including motorcycle riding. The kind of "interest" Holdings seeks

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