

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK
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DESSERT BEAUTY, INC., :
 :
 Plaintiff, :
 :
 - against - :
 :
 MARA FOX, :
 :
 Defendant. :

- - - - -x

OPINION

MARA FOX, :
 :
 Third-Party :
 Plaintiff, :
 :
 - against - :
 :
 SEPHORA, INC. et al., :
 :
 Third-Party :
 Defendants. :

05 Civ. 3872 (DC)

- - - - -x

APPEARANCES: (see last page)

CHIN, District Judge

At the heart of this litigation are two words: "love potion." Defendant and third-party plaintiff Mara Fox registered the trademark LOVE POTION for perfumed essential oils in 1995 and filed a declaration of incontestability for the LOVE POTION mark in 2001. In 2004, plaintiff Dessert Beauty, Inc. ("DBI") launched a line of beauty products that included two fragrance products described as "love potion fragrance" and "belly button love potion fragrance." At issue is whether DBI's use of the words "love potion" infringed Fox's LOVE POTION trademark, or whether the use was fair use, immune from liability.



DBI seeks a declaratory judgment that it did not violate Fox's trademark; it also seeks to cancel the LOVE POTION trademark registration on the ground that it is generic. DBI additionally sues Fox for intentional interference with business relations arising from Fox's attempts to protect her trademark. In turn, Fox asserts claims against Sephora, Inc. ("Sephora") and other unnamed third-party defendants for trademark infringement under the Lanham Act and California law.

The parties cross-move for summary judgment. For the reasons that follow, I conclude that DBI's use of "love potion" constituted fair use. Thus, DBI's motion is granted to the extent that judgment will be entered declaring that DBI did not engage in trademark infringement. Fox's motion for summary judgment is granted to the extent that DBI's claim that she intentionally interfered with its business relations is dismissed; her motion is otherwise denied.

BACKGROUND

A. The Facts

The following facts are drawn from affidavits, attached exhibits, and deposition testimony submitted by the parties. For purposes of these cross-motions, the facts are construed in the light most favorable to Fox, except with respect to DBI's intentional interference with business relations claim.

1. **Fox's Love Potion Perfume**

Fox created the "Love Potion Perfume" in 1990. In 1995, she registered the words "love potion" for "perfumed essential oils for personal use" with the U.S. Patent and Trademark Office ("USPTO"). (Fox Decl. Ex. A). In 2001, Fox filed a declaration of incontestability with the USPTO for the mark LOVE POTION. (Id. ¶¶ 3, 5).

Fox concocted the Love Potion Perfume for a friend who "was having no luck in finding a relationship." (Krages Decl. Ex. 5). According to Fox's website www.lovepotionperfume.com, entitled "Love Potion: Magickal Perfumerie & Gift Shoppe," her Love Potion Perfume is the "first Magical, Mystical, Wearable Love Potion," "[c]omprised from Ancient Aphrodisiac Recipes." (Id.). Fox claims that she uses "the strongest ingredients known to inspire feelings of Love, Lust, Passion and Desire" and that her Love Potion Perfume "REALLY IS A Love Potion." (Id. (emphasis in original)).

The Love Potion Perfumes are sold in a clear bottle and packaged in a clear plastic bag and an organza¹ pouch²:

¹ "Organza" is a "sheer, stiff fabric of silk or synthetic material." The American Heritage Dictionary 876 (2d College Ed. 1991).

² Although Fox contends that she has used a variety of packaging over the years, she does not dispute that her products at one time were packaged in clear bottles and organza pouches as shown above. Furthermore, she has not produced any evidence of other types of packaging.



(Id. Ex. 4). A label with the words "Love Potion Perfume" is affixed to the bottle.

2. DBI's Beauty Products

In 2004, DBI launched a line of beauty products that were endorsed by celebrity Jessica Simpson. (Shimanoff Decl. Ex. 16). As part of DBI's advertising and marketing campaign, Simpson told the story that "every time [her then husband] would kiss [her] lips or skin, he would taste [her] lipstick, body lotion, and perfume -- and hate it." (Id.). Thus, the DBI products were created to "smell and taste good" and were advertised as "lickable, tasteable, and . . . kissable." (Id.). Products such as the "Whipped Body Cream with Candy Sprinkles," "Chocolicious Body Gloss," and "Powdered Sugar Body Shimmer" were named after ingredients used to make desserts to suggest their "edible nature." (Id.; Tr. 5).³

³ References to "Tr." are to the transcript of the oral argument on July 15, 2008.

In a catalogue entitled "Menu," DBI listed its products available in the Dessert Beauty line, such as "Bath Bubbles" and "Sugar Scrub." (Shimanoff Decl. Ex. 16). Two fragrance products are included. The "Love Potion Fragrance" was offered in three varieties: "Creamy, Juicy & Dreamy." (Id.). The "Belly Button Love Potion Fragrance," offered in "Creamy" and "Juicy," was intended to be applied to the navel and sold in a "roll-on" container. (Id.). The packages and bottles referred to the fragrance products as the "deliciously kissable love potion fragrance" or the "deliciously kissable belly button love potion." (Krages Decl. Ex. A; Shimanoff Decl. Ex. 13).



(Shimanoff Decl. Ex. 13).

DBI's trademark was DESSERT, which was indicated as such by the trademark symbol "TM" next to the word "Dessert" on

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