UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF OHIO
EASTERN DIVISION

J.M. SMUCKER COMPANY,	)	CASE NO. 5:20-cv-1132
PLAINTIFF,	)	JUDGE SARA LIOI
vs.	)	MEMORANDUM OPINION AND ORDER
HORMEL FOOD CORPORATION,	)	
DEFENDANT.	)	

This matter is before the Court on defendant Hormel Food Corporation's ("Hormel" or "defendant") motion to dismiss (Doc. No. 13 ["Mot."]) the complaint (Doc. No. 1 ["Compl."]) of plaintiff J.M. Smucker Company ("Smucker" or "plaintiff"). Smucker opposed the motion (Doc. No. 14 ["Opp'n"]), to which Hormel replied (Doc. No. 15 ["Reply"]).

For the reasons that follow, Hormel's motion is granted.

I. Background

Smucker brings this action under the Lanham Act, 15 U.S.C. § 1052 *et seq*., and the Court has jurisdiction over this matter under 28 U.S.C. §§ 1331, 1332, 1338(a), 2201–2202, and 1367. (Compl. ¶ 8.) The following is a summary of the facts as alleged in Smucker's complaint.

Smucker is an American food manufacturer, incorporated in Ohio, whose products include JIF peanut butter. Smucker's principal place of business is Orville, Ohio. (Compl. ¶¶ 2,11.) Hormel is also a food manufacturer whose products include SKIPPY peanut butter. (*See id*. ¶¶ 35–37.) Hormel is a Delaware corporation with its principal place of business in Minnesota, and a sales office in Cincinnati, Ohio. (*Id.* ¶ 3.) In February 2020, Smucker announced plans to launch new

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JIF products in June 2021, and released a graphic of Smucker's FY21 product launch. (*Id.* ¶¶ 29–30.) Smucker claims that it chose a light blue color (Pantone 2925C) for its JIF No Added Sugar product to distinguish it from other JIF products, because consumers associate the color blue with sugar content in food products, and because Smucker already utilizes a lid of that color for a JIF product in Canada. (*Id.* ¶¶ 19–21.)

On March 17, 2020, Hormel's in-house counsel emailed a letter to Smucker's counsel claiming to own "teal in the ray design on the labels" of SKIPPY peanut butter and expressing concern over Smucker's planned launch of JIF No Added Sugar with a blue lid. (*Id.* ¶ 31.) Smucker responded that Hormel made no public claim to the use of teal in connection with its SKIPPY peanut products, teal was just one of many colors Hormel used to distinguish different varieties of SKIPPY products, and consumers were not likely to confuse Smucker's new JIF product with a blue lid with SKIPPY products. (*Id.* ¶ 34–40, 43–44.) After an exchange of letters between March 2020 and May 2020 (*id.* ¶¶ 31, 32, 50–53), Hormel warned Smucker that a nationwide launch of JIF No Added Sugar with a blue lid would constitute willful infringement of Hormel's teal colored trade dress. (*Id.* ¶ 52.) The letters exchanged between Hormel and Smucker are attached to the complaint.[1]

In April 2020, Hormel filed two trademark applications with the United States Patent and Trademark Office ("USPTO") claiming use of the color teal in product packaging for SKIPPY peanut butter. (*Id.* ¶¶ 54–57.) Smucker claims that it will take years for these applications and

[1] "[D]ocuments attached to the pleadings become part of the pleadings and may be considered on a motion to dismiss." *Commercial Money Ctr., Inc. v. Illinois Union Ins. Co.*, 508 F.3d 327, 335 (6th Cir. 2007) (citing Fed. R. Civ. P. 10(c)). "In addition, when a document is referred to in the pleadings and is integral to the claims, it may be considered without converting a motion to dismiss into one for summary judgment." *Id.* at 335–36 (citation omitted).

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challenges thereto to work their way through the USPTO and, during that time, Smucker will be left in a state of uncertainty regarding its legal liability in connection with JIF No Added Sugar with a blue lid. (*See id.* ¶¶ 58–61.)

Smucker alleges that Hormel believed Smucker's product launch would "eclipse" Hormel's own new SKIPPY peanut butter product announcement planned for June 2021. Smucker contends that Hormel's new trademark applications and cease and desist letters claiming trademark infringement are designed to interfere with Smucker's JIF No Added Sugar product launch. (*Id.* ¶¶ 42, 58–64.)

Based on these factual allegations, Smucker asserts four claims for relief. First, Smucker seeks a declaration that Hormel has no enforceable trade dress rights in and to the color teal on peanut butter products. (*Id.* ¶¶ 65–69.) Second, Smucker seeks a declaration that Smucker's use of Pantone 2925C for its JIF No Added Sugar product does not infringe any trade dress right owned by Hormel in the color teal. (*Id.* ¶¶ 70–73.) Third, Hormel's claims of trade dress infringement constitute tortious interference with Smucker's prospective economic advantage. (*Id.* ¶¶ 74–83.) And fourth, Hormel's trade dress infringement claims constitute common law unfair competition. (*Id.* ¶¶ 84–92.)

In response, Hormel moves to dismiss the complaint pursuant to Fed. R. Civ. P. 12(b)(2), 12(b)(3), and 12(b)(6). (Mot. at 93.) Defendant maintains that the entire complaint should be dismissed under Rule 12(b)(2) for lack of personal jurisdiction and, in addition, claims 3 and 4 should be dismissed under Rule 12(b)(6) for failure to state a claim. (*Id.* at 106.)

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And to the extent the Court lacks personal jurisdiction over Hormel in Ohio, Hormel maintains that the entire complaint should be dismissed for the additional reason of improper venue under Rule 12(b)(3). (*Id*. at 120.)

The Court begins with the threshold issue of personal jurisdiction. *See Friedman v. Estate of Presser*, 929 F.2d 1151, 1156 (6th Cir. 1991) (without personal jurisdiction over a defendant the court lacks jurisdiction to proceed on the merits of the case even if the court has subject matter jurisdiction).

II. Discussion

A. Hormel's Rule 12(b)(2) Motion

1. Standard of review

Federal Rule of Civil Procedure 12(b)(2) provides for dismissal of a defendant where the Court lacks personal jurisdiction over the defendant. Smucker bears the burden making a prima facie showing that this Court has personal jurisdiction over Hormel. *Theunissen v. Matthews*, 935 F.2d 1454, 1458 (6th Cir. 1991). In the face of a supported motion to dismiss, Smucker may not rest upon its pleadings, but must, by affidavit or otherwise, set forth specific evidence supporting personal jurisdiction of this Court over Hormel. *Id.*

To assert personal jurisdiction over a defendant, a federal court with subject matter jurisdiction pursuant to either 28 U.S.C. § 1331 or § 1332 must find that (1) defendant is amenable to service of process under the forum state's long-arm statute, and (2) the exercise of personal jurisdiction will not deny defendant due process. *See Theunissen*, 935 F.2d at 1459 (diversity); *Bird v. Parsons*, 289 F.3d 865, 871 (6th Cir. 2002) (federal question); *see also Chapman v. Lawson*, 89 F. Supp. 3d 959, 970 (S.D. Ohio 2015) ("Under Ohio law, personal jurisdiction over

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non-resident defendants exists only if: (1) Ohio's long-arm statute confers jurisdiction, *and* (2) the requirements of the federal due process clause are met.") (emphasis in original) (citations omitted). Service under Ohio's long-arm statute is governed by Ohio Rev. Code § 2307.382(A). The due process inquiry requires determining "whether the facts of the case demonstrate that the non-resident defendant possesses such minimum contacts with the forum state that the exercise of jurisdiction would comport with 'traditional notions of fair play and substantial justice.'" *Theunissen*, 935 F.2d at 1459 (quoting *Int'l Shoe Co. v. State of Wash.*, 326 U.S. 310, 316, 66 S. Ct. 154, 90 L. Ed. 95 (1945)). Even if a defendant's contact with the State of Ohio satisfies Ohio's long-arm statute, personal jurisdiction fails unless exercising jurisdiction over the defendant comports with traditional notions of fair play and substantial justice.

Personal jurisdiction exists in two forms: "general" or "specific." *Conti v. Pneumatic Prods. Corp.*, 977 F. 2d 978, 981 (6th Cir. 1992). General jurisdiction exists over a defendant when his "contacts with the forum state are of such a 'continuous and systematic' nature that the state may exercise personal jurisdiction over the defendant even if the action is unrelated to the defendant's contacts with the state." *Third Nat'l Bank in Nashville v. WEDGE Group Inc.,* 882 F.2d 1087, 1089 (6th Cir. 1989). Specific jurisdiction exists when a plaintiff's claims arise out of or relate to a defendant's contacts with the forum state, that is, there is a nexus between a defendant's contacts in the forum state and plaintiff's claim. *Kerry Steel, Inc. v. Paragon Indus., Inc.*, 106 F.3d 147, 149 (6th Cir. 1997); *Conti*, 977 F.2d at 981.

In deciding Hormel's Rule 12(b)(2) motion the Court may, at its discretion, (1) decide the motion on affidavits alone, (2) permit discovery in aid of deciding the motion, or (3) conduct an evidentiary hearing to resolve any apparent factual questions. *Theunissen*, 935 F.2d at 1458;

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