

ACTMEDIA, INC., a Delaware corporation, Plaintiff,
v.
ACTIVE MEDIA INTERNATIONAL, INC.
an Illinois corporation, Defendant.

Case No. 96C3448.

1996 WL 466527

United States District Court, N.D. Illinois
July 17, 1996.

Stanley J. Adelman, Keith William Medansky, Rudnick & Wolfe, Chicago, IL,
J. Douglas Baldrige, Collier, Shannon, Rill & Scott, Washington, DC, for
plaintiff Actmedia, Inc.

Thomas A. O'Donnell, Jr., Hoffman Estates, IL, for Defendant Active Media
International, Inc.

FINAL JUDGMENT AND PERMANENT INJUNCTION

ZAGEL, District Judge.

This matter having come before the Court upon the Complaint For Damages
And Injunctive Relief filed by ActMedia, Inc. ("Plaintiff") against Active
Media International, Inc. ("Defendant"), the Court having reviewed the
Complaint and all other matters of record, and being otherwise knowledgeable
of the premises, it is hereby;

FINALLY ORDERED, ADJUDGED, AND DECREED as follows:

Pursuant to 15 U.S.C. Section 1121(a), this Court has original subject matter
jurisdiction over this action as it arises under U.S.C., Title 15, Chapter 22 (the
"Act"), and involves Defendant's unauthorized use and false designation of
origin in commerce of a federally registered trademark owned by Plaintiff. This
Court has personal jurisdiction over Defendant, because it is an Illinois
corporation doing business in the State of Illinois. Pursuant to 28 U.S.C.
Section 1391(b)(1), venue is proper before this Court.

Since June of 1972, Plaintiff has provided advertising and promotional services, domestically and internationally, through use and ownership of its trademark, "ActMedia" ("Mark"), relating to the promotion of goods and services of others through planning, arranging, and designing in-store signage, print displays, video and audio displays, sampling and couponing events, conducting demonstrations, and providing post-event analysis and demonstrations (the "Services"). Plaintiff has become widely known in the marketplace as a preeminent source for such Services. The Services are strongly associated with and identified by Plaintiff's registered Mark, which has been continuously owned and used by Plaintiff in commerce since June of 1972. On April 8, 1986, Plaintiff registered the Mark with the United States Patent and Trademark Office, Registration No. 1,389,370. Pursuant to 15 U.S.C. Section 1065, Plaintiff has the incontestible right to use the Mark in commerce in connection with the Services.

The Mark has also been affixed to and used in commerce in connection with a wide variety of promotional and sales items, such as posters, signs, display units, uniforms, and promotional materials. Through great expense and effort incurred by Plaintiff, the Mark has become known in commerce as a strong identifier of the source of the Services and these related consumer items; that source being Plaintiff. As a direct result of Plaintiff's extensive efforts, the Mark has acquired substantial and valuable secondary meaning.

In or about 1995, Plaintiff began implementation of its plan to go "on line" through the Internet. In or about February, 1996, Plaintiff attempted to reserve the Internet domain name, "actmedia.com" ("Domain Name"), as its Internet address. When it attempted to reserve the Domain Name, Plaintiff discovered for the first time that Defendant, without authorization from Plaintiff, had already reserved the Domain Name. Defendant's reservation of the Domain Name has precluded Plaintiff from reserving an Internet domain name incorporating its registered Mark.

Defendant's reservation of the Domain Name violates 15 U.S.C. Section 1125 and Illinois common law because it: (a) constitutes unauthorized use and misappropriation of Plaintiff's Mark; (b) constitutes false designation of origin; (c) is likely to cause confusion in the marketplace that Plaintiff and Defendant are affiliated; and (d) is likely to cause confusion that Plaintiff sponsors or approves Defendant's commercial activities. Further, Defendant's reservation of the Domain Name also violates the Illinois Anti-Dilution Act, Ill. Rev. Stat ch. 140, Section 22, because it creates a likelihood of dilution of the distinctive quality of the Mark. Plaintiff has no adequate remedy at law, and has and will continue to suffer irreparable harm if Defendant continues its unauthorized use

and misappropriation of the Mark by precluding Plaintiff from using its Mark as an Internet domain name. The public interest will be served by issuing the injunctive relief requested by Plaintiff.

Relief Granted

Plaintiff is hereby granted the following permanent injunctive relief:

1. Pursuant to 15 U.S.C. Section 1116, the Illinois Anti-Dilution Act, and Illinois common law, Defendant, and its officers, agents, servants, employees, and attorneys, and those persons in active concert or participation with them who receive actual notice of this Final Judgment And Permanent Injunction are hereby mandatorily and permanently enjoined from using or infringing in any manner Plaintiff's registered trademark, "ActMedia;"
2. Pursuant to 15 U.S.C. Section 1116, the Illinois Anti-Dilution Act, and Illinois common law, Defendant, and its officers, agents, servants, employees, and attorneys, and those persons in active concert or participation with them who receive actual notice of this Final Judgment And Permanent Injunction are hereby directed to immediately release to Plaintiff their interest(s) in the Internet Domain Name, "actmedia.com", and immediately transfer all interests in said Domain Name to Plaintiff, and execute all documents necessary to immediately effect such transfer of the Domain Name to Plaintiff;
3. The Court reserves jurisdiction to enforce the requirements of this Final Judgment And Permanent Injunction.