# Despite Prevailing on a Motion to Dismiss on the Merits of Plaintiff's Trademark Infringement Claims, the L.A. Times Could Not Recover its Attorneys' Fees Because the Plaintiff's Claims Were Not Exceptional Under the Lanham Act

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By Phillip Barengolts, Trademark Attorney

The L.A. Times published numerous articles questioning the practices of 1800 Get Thin – referencing the 1800 GET THIN mark in the articles. Get Thin sued the L.A. Times, including the reporter primarily responsible for the articles, for trademark infringement and false advertising under the Lanham Act. The L.A. Times moved to dismiss on grounds of nominative fair use and won - easily. See coverage here: http://tushnet.blogspot.com/2011/08/news-article-nominative-fair-use-not.html. Then, the L.A. Times moved for attorneys' fees – all $100k plus of them – and lost.[1]

Under the Lanham Act, the prevailing party may obtain its attorneys' fees in an exceptional case. For a plaintiff, generally, this standard is met by showing that an infringement is deliberate or willful. For the L.A. Times, the defendant here, "this requirement is met when the [plaintiff's] case is either 'groundless, unreasonable, vexatious, or pursued in bad faith.'" (citations omitted). To meet this burden, the L.A. Times asserted that the Lanham Act was never meant to apply to the use of a trademark in news reporting activities. The court thought this argument went too far.

The court specifically noted that the seminal nominative fair use defense case, *New Kids on the Block v. News America Pub., Inc.,* 971 F.2d 302, 307–08 (9th Cir.1992), excluded from this defense uses that were false or misleading. Here, Plaintiff's claims essentially were that the L.A. Times made false and misleading use of the 1800 GET THIN mark in its articles. Thus, the court found that the plaintiff's claims were "not without merit" even though the plaintiff failed to state a

[1] 1800 Get Thin, LLC v. Hiltzik, No. CV 11-00505 (C.D. Cal. Sept. 13, 2011), available at http://www.pattishall.com/pdf/1800_Get_Thin_Attys_Feees_Order.pdf

claim. The court also found that its own statement in a previous ruling that the claims were too speculative did not warrant a finding that the case was exceptional. Finally, in a jab at the plaintiff, the court stated that "subpar lawyering is not the standard to find an exceptional case" in relation to the "cumbersome" complaint.

Can defendants ever recover attorneys' fees when they prevail on a plaintiff's Lanham Act claim? Yes, but the standard for an exceptional case from the defendant's point of view is closer to Rule 11 than Rule 12(b). The Seventh Circuit, for example, in upholding an award of attorneys' fees to a defendant, ruled that the standards for both plaintiffs and defendants should mirror each other, "It should be enough to justify the award if the party seeking it can show that his opponent's claim or defense was objectively unreasonable." *Nightingale Homme Healthcare v. Anodyne Therapy*, 626 F.3d 958 (7th Cir. 2010) (Prior coverage here: http://blog.pattishall.com/2010/12/10/the-seventh-circuit-clarifies-what-constitutes-an-exceptional-case-under-the-lanham-act-and-calls-for-uniformity-among-the-circuits/). Those seeking to pursue claims under the Lanham Act must be mindful of this fee-shifting provision and consider the reasonableness of their allegations and defenses.

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*Phillip Barengolts is a partner with Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP, a leading intellectual property law firm based in Chicago, Illinois. Pattishall McAuliffe represents both plaintiffs and defendants in trademark, copyright, and unfair competition trials and appeals, and advises its clients on a broad range of domestic and international intellectual property matters, including brand protection, Internet, and e-commerce issues. Mr. Barengolts' practice focuses on litigation, transactions, and counseling in domestic and international trademark, trade dress, Internet, and copyright law. He teaches trademark and copyright litigation at John Marshall Law School, and co-authored Trademark and Copyright Litigation, recently published by Oxford University Press.*