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Featured Cases

Kellogg Co. v. Exxon Mobil Corp.

209 F.3d 562 (6th Cir.), cert denied, 531 U.S. 944 (2000). Kellogg Co. v. Exxon Mobil Corp., 59 U.S.P.Q.2d 1551 (W.D. Tenn. 2001). Trademark infringement and dilution action under the Lanham Act, alleging that Exxon's use of its cartoon tiger to promote foods, beverages and convenience stores infringed and diluted Kellogg's famous TONY THE TIGER character.

Zelle Hofmann attorneys represented Kellogg throughout this trademark infringement and dilution action against Exxon Mobil Corporation. The case involved Kellogg's famous anthropomorphic cartoon tiger, TONY THE TIGER, and the cartoon tiger used by Exxon in the 1960s to promote its motor fuels. In the lawsuit, Kellogg alleged that Exxon abandoned its Cartoon Tiger in the 1980s, reintroduced it in the 1990s in a modified form, and began to use it to directly promote food products, beverage products and convenience store services at its service stations. Kellogg claimed that this recent expansion of use of the Exxon cartoon tiger into the food, beverage and convenience store services areas infringed and diluted Kellogg's TONY THE TIGER mark. Examples of Exxon's food- and beverage-related use of its cartoon tiger are shown below:

Exxon filed a motion for summary judgment in late 1997, arguing that Kellogg's claims were barred under the doctrines of laches and acquiescence, and that there were no genuine issues of material fact on Kellogg's claim the Exxon abandoned its cartoon tiger during the 1980s. In August of 1998, the federal district court in Memphis granted summary judgment in Exxon's favor, reasoning that Kellogg was "grossly remiss" in failing to challenge Exxon's use of its cartoon tiger in the 1960s and 1970s; that Exxon did not "progressively encroach" on Kellogg's rights; and that, as a matter of law, Kellogg could not establish Exxon's "nonuse" of its cartoon tiger sufficient to prove abandonment. Kellogg Co. v. Exxon Corp, 50 U.S.P.Q.2d 1499 (W.D.Tenn.1998).

Kellogg appealed to the Sixth Circuit Court of Appeals, arguing that (1) Exxon presented no evidence that Kellogg acquiesced in Exxon's use of its cartoon

tiger in connection with foods, beverages and convenience stores; (2) the district court erred in requiring that Exxon use its cartoon tiger in direct competition with Kellogg's TONY THE TIGER in order to progressively encroach on Kellogg rights; (3) there were genuine issues of material fact on Kellogg abandonment claim; and (4) the district court improperly dismissed Kellogg's bad faith infringement and dilution claims as moot.

On April 6, 2000, the Sixth Circuit, reversed and remanded the case for trial on Kellogg's trademark infringement claims. Kellogg Company v. Exxon Corp., 209 F.3d 562 (6th Cir.), cert. denied, 531 U.S. 944 (2000). The Court of Appeals rejected the district court's ruling on acquiescence, reasoning that the district court improperly measured delay from the point at which Exxon began using the cartoon tiger to promote motor fuels; instead, delay should have been measured from the point at which Exxon established itself in the non-petroleum market of food, beverages and retail convenience stores and used its cartoon tiger in connection with those sales. 209 F.3d at 573-74. The Court of Appeals also ruled in Kellogg's favor on the issue of progressive encroachment, abandonment and on Kellogg's claims for bad faith infringement. See Kellogg, 209 F.3d at 575-77.

On remand, the district court considered Exxon's motion for summary judgment on Kellogg's claims for dilution under the Federal Trademark Dilution Act ("FTDA"). In June 2001, the district court upheld Kellogg's claim for dilution by blurring under the FTDA, concluding that Kellogg had shown proof of "actual dilution by blurring" sufficient to defeat Exxon's motion for summary judgment. See Kellogg Co. v. Exxon Mobil Corp., 59 U.S.P.Q.2d 1551, 1563, 1564 (W.D.Tenn. 2001). Soon after the district court's rulings on Kellogg's dilution claims, the parties settled the case.