

UNITED STATES DISTRICT COURT  
DISTRICT OF MASSACHUSETTS

O.C. WHITE CO., )  
Plaintiff )  
)  
)  
v. ) Civil Action No. 03-30190-KPN  
)  
)  
)  
SCIENTIFIC TECHNOLOGY )  
ELECTRONIC PRODUCTS, INC. d/b/a )  
SCIENSCOPE INTERNATIONAL, )  
Defendant )

MEMORANDUM AND ORDER WITH REGARD TO DEFENDANT'S  
MOTION FOR SUMMARY JUDGMENT (Document No. 20)  
November 10, 2005

NEIMAN, U.S.M.J.

O.C. White Co. ("Plaintiff") claims that Scientific Technology Electronic Products, Inc. d/b/a Sciencoscope International ("Defendant")'s use of the term "Magni-Light" infringes its registered trademark "MAGNILITE." The parties have consented to the jurisdiction of this court, see 28 U.S.C. § 636(c), and Defendant has filed a motion for summary judgment. For the following reasons, Defendant's motion will be denied.

I. BACKGROUND

For summary judgment purposes, the following facts are undisputed and stated in a light most favorable to Plaintiff, the non-moving party. See *Uncle Henry's, Inc. v. Plaut Consulting Co.*, 399 F.3d 33, 41 (1st Cir. 2005). Plaintiff manufactures lighting

fixtures and equipment, including a product line of electrical magnifying light fixtures identified as Magnilites. Plaintiff first registered the trademark "MAGNILITE" in 1959.

Since 1959, Plaintiff has continuously manufactured and marketed Magnilites on a wholesale basis to the electronics industry through a network of non-exclusive distributors. Plaintiff has a family of "Lite" products, including a "Vision-Lite 2000," a "Prolite," an "Exhaust-A-Lite" and a "Micro-Lite." For summary judgment purposes, there appears to be no dispute that Plaintiff is the leading seller of electrical magnifying light fixtures or that Plaintiff's Magnilites are distributed both nationally and internationally. Nor for present purposes does Defendant dispute Plaintiff's factual assertion that, within the relevant industry, the MAGNILITE trademark is known to refer to Plaintiff's product line or that Plaintiff has attempted to protect its mark "through pervasive marketing, an active sales force, quality control, policing infringers, distinctive packaging and labeling on the products."

In April of 2002, Defendant introduced a competing line of electrical magnifying light fixtures called "Magni-Lights." Defendant's Magni-Lights share certain similarities with Plaintiff's products, most notably, they too are electrical magnifying light fixtures. Both companies' products are also sold wholesale through a distribution network, with a number of distributors carrying both brands.

Shortly after Plaintiff learned about Defendant's products, it demanded that Defendant cease using the name "Magni-Light." According to Defendant, it has not only complied with this demand, but it has also posted stickers in its catalog and a statement on its website specifically disclaiming any connection to Plaintiff. Defendant

claims as well that it now refers to its products simply as the “M-Series.”

Plaintiff filed this action on July 31, 2003, and four counts remain: Count I, alleging trademark infringement in violation of 15 U.S.C. § 1114; Count II, alleging false designation of origin and false descriptions and representations in violation of 15 U.S.C. § 1125(a); Count IV, alleging violations of Mass. Gen. L. ch. 93A (“chapter 93A”); and Count V, alleging unfair competition under the common law of Massachusetts. The parties have stipulated to the dismissal of a fifth count, Count III, alleging dilution under 15 U.S.C. § 1125(c). In due course, Defendant filed the instant motion for summary judgment. Among other arguments, Defendant asserts that the term MAGNILITE is so generic -- *i.e.*, commonly descriptive -- that Plaintiff cannot prove infringement.

## II. STANDARD OF REVIEW

“Summary judgment is warranted ‘if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law.’” *Uncle Henry’s*, 399 F.3d at 41 (quoting Fed. R. Civ. Pro. 56(c)). “An issue is ‘genuine’ for purposes of summary judgment if the evidence is such that a reasonable jury could return a verdict for the nonmoving party, and a ‘material fact’ is one which might affect the outcome of the suit under the governing law.” *Carciari v. Norton*, 423 F.3d 45, 53 (1st Cir. 2005) (citations and further internal quotation marks omitted). The central inquiry is “whether the evidence presents a sufficient disagreement to require submission to a jury or whether it is so one-sided that

one party must prevail as a matter of law.” *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 251-52 (1986).

### III. DISCUSSION

Defendant seeks summary judgment on all of Plaintiff’s remaining counts. Defendant first addresses Counts I, II and V in tandem insofar as each concerns Plaintiff’s claim that Defendant’s use of the term “Magni-Light” infringes Plaintiff’s “MAGNILITE” mark. Defendant then argues that the chapter 93A claim (Count IV), being “built upon” the other three causes of action, is subject to summary judgment as well. The court will follow Defendant’s lead, analyzing first its arguments with respect to Counts I, II and V (hereinafter, the “infringement claims”) and then turning to the chapter 93A cause of action.

#### A. Infringement Claims

Plaintiff’s infringement claims derive from 15 U.S.C. § 1114<sup>1</sup> and 15 U.S.C. §

---

<sup>1</sup> In pertinent part, 15 U.S.C. § 1114 provides as follows:

(1) Any person who shall, without the consent of the registrant--

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive,

1125(a).<sup>2</sup> Generally speaking, these provisions seek to prevent one seller from using a mark identical or similar to that used by another in a way that confuses the public about the actual source of the goods or services in question. See *Star Fin. Servs., Inc. v. Asstar Mort. Corp.*, 89 F.3d 5, 9 (1st Cir. 1996). To prevail on an infringement claim, a plaintiff must show (1) that it has a valid and protectable mark and (2) that the defendant's use of the mark is likely to confuse the public as to the product's origin

---

shall be liable in a civil action by the registrant for the remedies hereinafter provided.

Under subsection (b) hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive.

15 U.S.C. § 1114.

<sup>2</sup> In pertinent part, 15 U.S.C. § 1125(a) provides as follows:

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which--

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125(a).

and, thus, harm the plaintiff. See *Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25, 38 (1st Cir. 2001). Defendant challenges both elements.

1. Whether Plaintiff's Mark is Valid and Protectable

As to the first element, the parties agree that there are four categories of marks:

(1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful. *Id.* at 41.

Recognizing that “the level of trademark protection . . . increases with each step along this spectrum,” District Judge Michael A. Ponsor recently summarized the law with respect to these categories:

A generic term, or the ‘common descriptive name’ for a product, receives no trademark protection. *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 193-94 (1985); see also *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 39 (1st Cir. 1998). A descriptive mark conveys a quality or characteristic of a product, and can be protected only where it has acquired a secondary meaning such that the mark is specifically associated with the product in question. See *Flynn v. AK Peters, Ltd.*, 377 F.3d 13, 19 (1st Cir. 2004); *Equine Techs. v. Equitech, Inc.*, 68 F.3d 542, 554 (1st Cir. 1995). Finally, suggestive, arbitrary, and fanciful marks are inherently distinctive and are therefore always entitled to protection. See *Lund*, 163 F.3d at 39.

*National Nonwovens, Inc. v. Consumer Prods. Enters., Inc.*, --- F. Supp. 2d ---, 2005 WL 2850861, at \*5 (D. Mass. Oct. 31, 2005).

Defendant argues that the term MAGNILITE is generic for a magnifier with a light and, thus, afforded no trademark protection. See *S. S. Kresge Co. v. United Factory Outlet, Inc.*, 598 F.2d 694, 696 (1st Cir. 1979) (“Generally speaking, generic terms are unprotectable through trademark or trade name registration.”). In response, Plaintiff argues that, at a minimum, the genericness of the term MAGNILITE is a question of fact

and that there are enough factual questions about the relevant public's understanding of the MAGNILITE mark for its case to survive summary judgment. At trial, Plaintiff continues, it will prove that MAGNILITE is a descriptive mark that has acquired secondary meaning. For present purposes, the court finds Plaintiff's position more persuasive.

Defendant concedes that Plaintiff's federal registration of MAGNILITE is *prima facie* evidence that the mark is not generic. See *Liquid Controls Corp. v. Liquid Control Corp.*, 802 F.2d 934, 936 (7th Cir. 1986). Nonetheless, Defendant argues that it has provided sufficient evidence to overcome the presumption and prove that the mark is generic as a matter of law. See *id.* (while a contestable federal registration is *prima facie* evidence that a term is not generic, this presumption "bursts" once the challenger presents "sufficient evidence" of genericness). See also *Nartron Corp. v. STMicroelectronics, Inc.*, 305 F.3d 397, 403 (6th Cir. 2002) (similar); *National Nonwovens*, 2005 WL 2850861, at \*6 (same, collecting cases).

Whether an alleged mark is generic involves a two-step analysis, first determining the class of goods at issue and then determining whether the alleged mark is understood by the relevant public to refer primarily to that class of goods. *In re Gould Paper Corp.*, 834 F.2d 1017, 1018 (Fed. Cir. 1987). With regard to the first step, Defendant contends -- with no objection from Plaintiff -- that the class of goods at issue is "electrical magnifying light fixtures," the term Plaintiff used during both its initial registration in 1959 and its re-registration in 1997.

Regarding the second step -- whether MAGNILITE is understood by the relevant

public to refer primarily to an electrical magnifying light fixture -- Defendant argues, with regard to the facts, that “[t]he overwhelming undisputed evidence . . . demonstrates that MAGNILITE is nothing more than a generic, common descriptor for magnifier lights (or illuminated magnifiers).” First, Defendant relies on representations by Plaintiff’s officers that the two functions of Plaintiff’s Magnilites are magnification and lighting. Defendant then notes that other products by other manufacturers -- several of which apparently magnify and illuminate as well -- also use the phonetic equivalent of “Magnilite,” e.g., Magna-Lite (optical magnifier having flashlight lighting capability), Magnilight (optical fibers and fiber optic cables), Magnalite (illuminated signs), Magnalite (electric generators), MagniLight (magnifier light for portable video game system), and Magni-Light (magnifier with white light). Defendant also points out that Plaintiff references “Magnilite” in common trade language. For example, Defendant states, Plaintiff often uses the term in its marketing literature in lower case letters and with other modifiers, such as “Big Eye magnilite” or “Vision-Lite magnilite” or as part of a “line of magnilites.” (*Id.*)

As for the law, Defendant argues that it is of no moment that Plaintiff uses the misspelling “lite” for “light.” According to Defendant, courts typically make no distinction between generic words and their misspelled equivalents. See, e.g., *Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75, 81 (7th Cir. 1977) (holding that “Lite and “Light” are interchangeable as generic descriptors of low-calorie beer). See also 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 12:38 (2005) (hereinafter “*McCarthy*”) (observing that the following are deemed generic even



though misspelled: AL-KOL (rubbing alcohol), JYMBAR (gym bar), SAFE T PLUG (safety plug) and GLUE STIK (glue stick)). Similarly, Defendant cites other cases where abbreviations -- e.g., “magni” -- can constitute generic descriptors. See, e.g., *National Conf. of Bar Examiners v. Multistate Legal Studies, Inc.*, 692 F.2d 478, 488 (7th Cir. 1982) (MBE is generic abbreviation for “multistate bar examination”); *Surgicenters of Am., Inc. v. Med. Dental Surgeries Co.*, 601 F.2d 1011, 1015 (9th Cir. 1979) (SURGI means “surgery” as applied to surgical centers). Finally, Defendant cites other cases where so-called “composite” terms have been deemed generic as a matter of law. See, e.g., *Nupla Corp. v. IXL Mfg. Co.*, 114 F.3d 191, 196 (Fed. Cir. 1997) (CUSH-N-GRIP held to be generic misspelled composite of the generic name “cushion grip”); *Gould*, 834 F.2d at 1018 (SCREENWIPE constitutes generic composite of “screen” and “wipe” for anti-static cloth); and *Cummins Engine Co. v. Continental Motors Corp.*, 359 F.2d 892, 894 (C.C.P.A. 1966) (TURBODEISEL generic composite term for engines with turbine superchargers).

Defendant’s argument has significant force. Factually, the court recognizes that “Magnilite” or its equivalent has often been used by Plaintiff and others in ways that might be considered generic or as a common descriptor for magnifier lights. On the law, too, the term seems as common as many of the terms other courts have found to be generic and not entitled to trademark protection.

There are, however, a variety of countervailing reasons why, for present purposes, the court will not deem MAGNILITE generic as a matter of law. For starters, the First Circuit has repeatedly warned that “courts contemplating the entry of summary

judgment cannot simply presume that plaintiffs will lose difficult cases and act accordingly.” *Levya v. On The Beach, Inc.*, 171 F.3d, 717, 720 (1st Cir. 1999). *Cf. Conward v. Cambridge Sch. Comm.*, 171 F.3d 12, 18 (1st Cir. 1999) (summary judgment rule “acts as a firewall to contain the blaze of cases that are so lacking in either factual foundation or legal merit that trial would be a useless exercise”); *Greenburg v. P. R. Mar. Shipping Auth.*, 835 F.2d 932, 936 (1st Cir. 1987) (“Fed. R. Civ. P. 56 does not ask which party’s evidence is more plentiful, or better credentialed, or stronger.”). This is particularly so “[w]hen, as now, the question comes down to one of fact.” *Levya*, 171 F.3d at 720.

Defendant agrees that the issue of “[w]hether a name is generic is a question of fact.” *Bath & Body Works, Inc. v. Luzier Personalized Cosmetics, Inc.*, 76 F.3d 743, 748 (6th Cir. 1996). *Accord Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 292 n.18 (3d Cir. 1991); *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 1559 (Fed. Cir. 1985); *McCarthy* § 12:12 (citing cases). Defendant has little choice but to agree as well that there are numerous cases where genericness has been submitted to the jury, even in the face of what might be considered “overwhelming” evidence to the contrary. *See, e.g., Bath & Body Works*, 76 F.3d at 748 (district court’s finding that BATH AND BODY is generic was erroneous insofar as “the public,” and thus the jury, might reach a different conclusion); *Riggs Mkg., Inc. v. Mitchell*, 993 F. Supp. 1301, 1307 (D. Nev. 1997) (summary judgment unwarranted where “the public could arguably associate Plaintiff’s ‘universal’ machine with [Plaintiff itself], and thus find ‘universal’ is not generic”). As one court recently put it, so long as “facts are at issue that could

cause a reasonable jury to decide the mark is a descriptive mark with secondary meaning or a suggestive mark, then the mark would be protected by trademark law and summary judgment for Defendant [on the issue of genericness] would be improper.” *J & J Snack Foods Corp. v. Earthgrains Co.*, 220 F. Supp. 2d 358, 376 (D.N.J. 2002) (finding insufficient evidence to show that BREAK & BAKE is generic as a matter of law). *Cf. In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1569 (Fed. Cir. 1987) (“Whether a term is classified as ‘generic’ or as ‘merely descriptive’ is not easy to discern when the term sits at the fuzzy boundary between these classifications.”) (citation omitted).

In addition, the court has considered other terms, cited by Plaintiff, which have been held *not* generic. See, e.g., the following non-generic examples Plaintiff culls from *McCarthy* § 12.19: CALIFORNIA COOLER (beverages from California), CHICKEN TENDERS (chicken parts), DICTAPHONE (dictation machines), HONEY BAKED HAM (hams that are honey glazed), PARK ‘N FLY (airport parking areas with shuttle bus service), POLY PITCHER (polyethylene pitcher), SOFT SOAP (liquid soap), TELECHRON (electric clocks), TINKER TOYS (construction set toys), and TOUCHLESS (auto wash services.) Yet other examples exist as well. See, e.g., *First Federal Sav. & Loan Ass’n v. First Federal Sav. & Loan Ass’n*, 929 F.2d 382, 383-84 (8th Cir. 1991) (FIRST FEDERAL not generic with regard to savings and loan associations); *In re Merrill Lynch*, 828 F.2d at 1571 (CASH MANAGEMENT ACCOUNT not generic as applied to stock broker services); *Petro Shopping Ctrs. L.P. v. James River Petroleum*, 1997 WL 187335, at \* (E.D. Va. Jan. 17, 1997) (PETRO is not

generic, but descriptive of truck stop services), *aff'd on other grounds*, 130 F.3d 88 (4th Cir. 1997). Like MAGNILITE, many of these marks are “composite” terms where, perhaps, one part is generic, but the whole is not. See *National Nonwovens*, 2005 WL 2850861, at \*7 (noting that composite words may form a protectable mark even though the term’s individual words are generic) (citation omitted).

It is also telling that Defendant has supplied no dictionary definition of the composite term “magnilite” since, presumably, none exists. To be sure, “[d]ictionary definitions are merely one source from which genericness may be proven” and it has been made “quite clear” in a number of decisions “that the absence of a composite term from the dictionary does not end the analysis, because numerous terms have been found to be generic despite their absence from the dictionary.” *Nartron*, 305 F.3d at 407 (holding that composite term “smart power” is generic). See also *Liquid Controls*, 802 F.2d at 937 (holding that “liquid controls” is generic); *National Conf. of Bar Examiners*, 692 F.2d at 487-88 (holding that “multistate bar examination” is generic); *Technical Publ’g Co. v. Lebhar-Friedman, Inc.*, 729 F.2d 1136, 1139 (7th Cir. 1984) (finding “software news” probably generic); *Miller Brewing Co.*, 561 F.2d at 81 (holding that “light beer” is generic). See also *National Nonwovens* (holding that “wool felt” is generic). Nonetheless, the case at bar is distinct in at least one important respect. Here -- unlike with the terms “smart power,” “liquid controls,” “multistate bar examination,” “software news,” “light beer” and “wool felt” -- there appears to be no dictionary definition of *either* of the term’s component words, “magni” or “lite,” at least insofar as those words are intended to mean magnification and illumination.

Of course, the word “surgi” also does not appear in the dictionary, yet the composite term “surgicenter” has been held to be generic as applied to surgical centers. See *Surgicenters*, 601 F.2d at 1015. But even in that example, the *other* word in the mark -- center -- is obviously defined independently as “a place of concentrated activity or influence.” *American Heritage Dictionary* (2d college ed. 1982). There is simply no parallel with either “magni” or “lite” as applied to magnification and illumination. Indeed, “-lite” is defined as a suffix for stone, minerals, or fossils. See *id.* See also *Webster’s Third New Int’l Dictionary, Unabridged* (1967) (defining “lite” as a variation of the word “little”); *Miller Brewing Co.*, 561 F.2d at 81 (“lite” refers to low-calorie). And “magni-” is part of several words which have nothing to do with magnification, e.g., “magnificent” (splendid in appearance), “magnifico” (nobleman of the Venetian Republic), and “magniloquent” (lofty and extravagant in speech). *American Heritage Dictionary, supra.* (See also Defendant’s Exhibit J (no indication that “magni-” in Italian company’s “Magnilight” mark for “optical fibers, fiber optic cables” has anything to do with magnification).)

Finally, it is worth repeating that “when a plaintiff has a federally registered mark, the plaintiff enjoy a strong presumption that the mark is not generic.” *J & J Snack Foods*, 220 F. Supp. 2d at 377 (citations omitted). That presumption cannot be overlooked here, particularly in light of the fact that Plaintiff first registered MAGNILITE nearly one-half century ago. See *id.* (considering presumption as further reason for denying summary judgment in lieu of having jury determine genericness of “break and bake”).

It is also important to note that Plaintiff has continuously manufactured and marketed its electrical magnifying light fixtures for these fifty years, that it is the leading manufacturer of such products which it distributes both nationally and internationally, that it has attempted to protect its MAGNILITE trademark through pervasive marketing, packaging, labeling and the like, and that the mark is known within the industry as referring to Plaintiff's product line. For all these reasons, therefore, the court concludes that Defendant has not sustained its burden of proving that MAGNILITE is generic as a matter of law. In effect, therefore, Plaintiff will be given the opportunity to establish at trial that "Magnilite" is a "descriptive" term with "secondary meaning" and, therefore, entitled to trademark protection. See *McCarthy* § 15:1. See also *Purolator, Inc. v. EFRA Distributors, Inc.*, 524 F. Supp. 471, 477 (D.P.R. 1981) ("Under [the descriptive] paradigm, the name must clearly denote what goods or services are provided in such a way that the consumer does not have to exercise powers of perception or imagination."), *aff'd*, 687 F.2d 554 (1st Cir. 1982).

## 2. Whether Plaintiff can Establish Likelihood of Confusion

Even assuming Plaintiff has a protectable trademark, Defendant argues that Plaintiff, as a matter of law, will be unable to prove at trial that Defendant's use of the mark is likely to confuse the public. The court disagrees. For summary judgment purposes, Plaintiff has raised genuine issues of material fact with regard to this issue.

To be sure, Plaintiff's burden in this regard is no trifling matter. In order to demonstrate likelihood of confusion, the holder of a mark "must show more than the theoretical possibility of confusion." *International Ass'n of Mach. & Aero. Workers v.*

*Winship Green Nursing Ctr.*, 103 F.3d 196, 200 (1st Cir. 1996) (citing *American Steel Foundries v. Robertson*, 269 U.S. 372, 382 (1926)). Not only has the law “long demanded a showing that the allegedly infringing conduct carries with it a likelihood of confounding an appreciable number of reasonably prudent purchasers exercising ordinary care,” the plaintiff must adduce “significantly probative evidence” on this score even at summary judgment. *Id.* at 201 (citations omitted).

Still, for the reasons explained below, the court believes that the eight factors typically considered when assessing the likelihood of confusion, on balance, presently favor Plaintiff. These factors are: (1) similarity of the marks; (2) similarity of the goods; (3) the relationship between the parties’ channels of trade; (4) the juxtaposition of their advertising; (5) the classes of prospective purchasers; (6) evidence of actual confusion; (7) the defendant’s intent in adopting the allegedly infringing mark; and (8) the strength of the plaintiff’s mark. *Id.* The factors must be evaluated “in context,” that is, they must be considered in light of “the circumstances in which the ordinary consumer actually confronts (or probably will confront) the conflicting mark.” *Id.*

a. *Similarity of the marks*

As for the first factor, the court agrees with Plaintiff that Defendant’s term “Magni-Light” is quite similar to Plaintiff’s MAGNILITE mark. To be sure, Defendant argues that the marks are not similar when viewed in the context of different channels of trade. The channels of trade, however, is a separate factor which is addressed independently.

b. *Similarity of the goods*

Regarding the second factor, Plaintiff observes that the products are nearly identical in appearance and function. Defendant, on the other hand, asserts that Plaintiff's own President sees a difference between the products: Plaintiff's products are "high end" while Defendant's are "low end." This, in the court's estimation, is a distinction without a difference. As described, both parties agree that the class of their products is "electrical magnifying light fixtures" without reference to "high" or "low" end. This factor, therefore, favors Plaintiff as well.

*c. Relationship between the parties' channels of trade*

With regard to the third factor, Plaintiff argues that the parties share distributors and market their products to the same segment of the electronics industry. Defendant, for its part, points out that the companies never share sales representatives and there is very little overlap at the distributor level. Again, however, it appears that Defendant is splitting hairs, at least for summary judgment purposes. Clearly, there is some relationship between the parties' channels of trade. The extent of that relationship can be explored at trial.

*d. Relationship between the parties' advertising*

As for the fourth factor, Plaintiff argues that both product lines are carried in the same distributor catalogues, are sold at the same trade shows, are advertised through proprietary websites and are marketed through competing sales forces and catalogues directed to the same buyers. Nonetheless, Defendant argues that there can be no confusion between the parties' respective catalogues and websites. That may be true, but even Defendant concedes that sales representatives sometimes bring actual



products from both companies into the field to show end users. Granted, as Defendant asserts, the products invariably bear either the corporate name and/or a distinct emblem that signifies the origin of the manufacturer. Still, in the court's estimation, Plaintiff has the stronger argument for summary judgment purposes.

e. *Classes of prospective purchasers*

Defendant does not appear to address the fifth factor. Plaintiff simply notes that both parties market their products to distributors in the electronics industry on a wholesale basis and do not sell directly to end users. Accordingly, the court has little choice but to conclude that this factor favors Plaintiff as well.

f. *Evidence of actual confusion*

Defendant's position as to the sixth factor is a bit more persuasive, at least as the facts now stand. Plaintiff asserts that there are two reported instances of confusion in the relevant electronics industry, but, as Defendant points out, these are somewhat weak examples.

The first instance occurred when Plaintiff's President instructed an employee to call a distributor and request a "Magni-Light," *i.e.*, Defendant's product. The distributor, in turn, then called Plaintiff. While the distributor may have been confused, it might not be an accurate test of the consuming public's confusion, prompted as it was by Plaintiff itself. The second instance involved a variety of hearsay and little, if any, harm. Ostensibly, a customer called one of Plaintiff's distributors, Techni-Tool, looking for a "Mag light 3000" or "Magni-Lite 3000." The Techni-Tool employee did some research and determined, apparently incorrectly, that the product might be available

from Defendant. While there may have been some confusion, it does not appear that the Techni-Tool employee was actually confused about the distinction between the two companies. Moreover, as Defendant notes, quoting Plaintiff's President, "Techni-Tool simply indicated that the customer provided a 'vague information request' and that the 'opportunity went dead before developing into anything.'"

Even assuming these two instances constituted actual confusion, they might, in the end, be considered *de minimis*. See *Astra Pharmaceutical Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d at 1201, 1208 (1st Cir. 1983). Similarly, the *absence* of any evidence of actual confusion is highly relevant to a finding of no likelihood of confusion. See *Pegnons S. A. de Macanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 490 (1st Cir. 1981). Still, the trial facts have yet to unfold. Even assuming that this final factor favors Defendant, the bulk of the other factors favor Plaintiff at this time.

g. *Defendant's intent in adopting the mark*

Regarding the seventh factor, Plaintiff argues that Defendant's intent can be inferred, while Defendant asserts that there is no evidence of bad faith. This factor presently appears to be a wash, although its development at trial could prove revealing.

h. *Strength of Plaintiff's mark*

Finally, Plaintiff argues that its forty-six year history of marketing demonstrates the strength of its MAGNILITE mark. For its part, Defendant again asserts that the mark is "generic" and, thus, not entitled to trademark protection. As indicated, however, Defendant has not proven that MAGNILITE is generic as a matter of law. Accordingly, this factor appears to support Plaintiff as well.

### 3. Summary

In sum, the court finds there to be genuine issues of material fact as to the likelihood of confusion. The court also finds that Defendant has not sustained its burden of proving that Plaintiff's use of the term MAGNILITE is generic as a matter of law. Accordingly, Defendant's motion for summary judgment with respect to Counts I, II and V will be denied.

#### B. Chapter 93A

With regard to Count IV, Defendant makes two arguments, both of which can be dealt with in short order. First, Defendant asserts that Plaintiff's chapter 93A claim must fail because the underlying infringement claims cannot survive summary judgment. As described, however, the court will allow the infringement claims to survive.

Second, Defendant contends that the chapter 93A claim must fail because the purportedly unfair and deceptive acts did not occur "primarily and substantially" in Massachusetts. See *Yankee Candle*, 259 F.3d at 47 (chapter 93A is actionable only if the alleged conduct occurred "primarily and substantially in Massachusetts"). There are, however, genuine issues of material in this regard. For example, according to Plaintiff's Statement of Facts, approximately two-thirds of Defendant's Magni-Light sales occurred "in or through the Commonwealth." Accordingly, Defendant's motion with respect to Count IV will be denied.

#### IV. CONCLUSION

For the reasons stated, Defendant's motion for summary judgment is denied.

The clerk is directed to schedule the matter for a case management conference.

IT IS SO ORDERED.

DATED: November 10, 2005

/s/ Kenneth P. Neiman  
KENNETH P. NEIMAN  
U.S. Magistrate Judge