

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

CERTAIN INK MARKERS AND
PACKAGING THEREOF

Inv. No. 337-TA-522

GENERAL EXCLUSION ORDER

The Commission has previously determined that there is a violation of section 337 of the Tariff Act of 1930 (19 U.S.C. § 1337) in the unlawful importation, sale, and/or sale after importation of certain ink markers and packaging thereof that infringe: (1) U.S. Registered Trademark Nos. 807,818 and 2,721,523 and (2) the trade dress of certain of Complainant's ink markers ("protected trade dress"). 70 *Fed. Reg.* 54079 (Sept. 13, 2005). The protected trade dress is as follows:

A distinctive gray, tapered, cigar-shaped barrel; a tapered, fully-colored cap that contrasts with the gray color of the barrel; and a cap-to-barrel ratio of approximately 1/3 to 2/3 (a 1:2 ratio) of the total size of the marker.

Unreviewed Initial Determination (Order No. 30, July 25, 2005) at 15.

Having reviewed the record in this investigation, including the written submissions of the parties, the Commission has made its determination on the issues of remedy, the public interest, and bonding. The Commission has determined that a general exclusion from entry for consumption is necessary to prevent circumvention of an exclusion order limited to products of named persons

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because there is a pattern of violation of section 337 and it is difficult to identify the source of infringing products. Accordingly, the Commission has determined to issue a general exclusion order prohibiting the unlicensed importation of infringing ink markers and packaging thereof.

The Commission has also determined that the public interest factors enumerated in 19 U.S.C. §§ 1337 (d) do not preclude the issuance of the general exclusion order and that the bond during the Presidential review period shall be in the amount of 100 percent of the entered value of the articles in question.

Accordingly, the Commission hereby **ORDERS** that:

1. Ink markers and packaging thereof that (i) infringe U.S. Registered Trademark Nos. 807,818 or 2,721,523¹ or any marks confusingly similar thereto or that are otherwise misleading as to source, origin, or sponsorship, or (ii) bear Sanford's protected trade dress or any trade dress confusingly similar thereto or that are otherwise misleading as to source, origin or sponsorship are excluded from entry into the United States for consumption, entry for consumption from a foreign-trade zone, and withdrawal from a warehouse for consumption until such date as the trademarks or trade dress are abandoned, canceled, or rendered invalid or unenforceable, except under license from, or with the permission of, the trademark or trade dress owner or as provided by law.
2. For the purpose of assisting U.S. Customs and Border Protection in the enforcement of this Order, and without in any way limiting the scope of the Order, the Commission has attached to this Order as Exhibit 3 a copy of a series of full-color photographs provided by Sanford, L.P. of exemplary Sanford ink markers containing the protected trade dress and a photograph of the trade dress broken down by its component parts. The Commission has also attached the relevant trademark registrations to this Order as Exhibits 1 & 2.

¹ Copies of these registrations are attached as Exhibits 1 and 2.

3. Notwithstanding paragraph 1 of this Order, the aforesaid ink markers and packaging thereof are entitled to entry into the United States for consumption, entry for consumption from a foreign-trade zone, and withdrawal from a warehouse for consumption, under bond in the amount of 100 percent of the entered value of such articles pursuant to subsection (j) of Section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337(j), from the day after this Order is received by the United States Trade Representative as delegated by the President, 70 *Fed. Reg.* 43251 (July 21, 2005), and until such time as the United States Trade Representative notifies the Commission that this action is approved or disapproved but, in any event, not longer than sixty (60) days after the date of receipt of this action.
4. Any party that believes itself to be excluded from this Order by the terms of a Commission consent order shall present evidence to that effect to U.S. Customs and Border Protection.
5. In accordance with 19 U.S.C. § 1337(l), the provisions of this Order shall not apply to ink markers and packaging thereof imported by and for the use of the United States, or imported for, and to be used for, the United States with the authorization or consent of the Government.
6. Complainant Sanford, L.P. shall file a written statement with the Commission, made under oath, each year on the anniversary of the issuance of this Order stating whether Sanford, L.P. continues to use each of the aforesaid trademarks and trade dress in commerce in the United States in connection with ink markers and packaging thereof and whether any of the aforesaid trademarks and trade dress has been abandoned, canceled, or rendered invalid or unenforceable.
7. The Commission may modify this Order in accordance with the procedure described in section 210.76 of the Commission's rules of Practice and Procedure (19 C.F.R. § 210.76).
8. The Commission Secretary shall serve copies of this Order upon each party of record in this investigation and upon the Department of Health and Human Services, the Department of Justice, the Federal Trade Commission, and U.S. Customs and Border Protection.

9. Notice of this Order shall be published in the *Federal Register* pursuant to section 337(j)(1)(A) of the Tariff Act of 1930 as amended (19 U.S.C. § 1337(j)(1)(A)) and section 210.49(b) of the Commission's Rules of Practice and Procedure (19 C.F.R. § 210.49(b)).

By order of the Commission

A handwritten signature in black ink, appearing to read 'Marilyn R. Abbott', with a large, stylized flourish at the end.

Marilyn R. Abbott
Secretary to the Commission

Issued: October 25, 2005

CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached **GENERAL EXCLUSION ORDER**, was served upon the Commission Investigative Attorney, Anne Goalwin, Esq. and all parties via first class mail and air mail where necessary on November 3, 2005.



Marilyn R. Abbott, Secretary
U.S. International Trade Commission
500 E Street, SW Room 112
Washington, DC 20436

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EXHIBIT 1

L-71193



THE UNITED STATES OF AMERICA

**TO ALL TO WHOM THESE PRESENTS SHALL COME:
UNITED STATES DEPARTMENT OF COMMERCE**

United States Patent and Trademark Office

May 18, 2004

THE ATTACHED U.S. TRADEMARK REGISTRATION 307,318 IS
CERTIFIED TO BE A TRUE COPY WHICH IS IN FULL FORCE AND
EFFECT WITH NOTATIONS OF ALL STATUTORY ACTIONS TAKEN
THEREON AS DISCLOSED BY THE RECORDS OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE.

REGISTERED FOR A TERM OF 20 YEARS FROM *May 03, 1966*
1st RENEWAL FOR A TERM OF 20 YEARS FROM *May 03, 1986*
SECTION 8 & 15

SAID RECORDS SHOW TITLE TO BE IN:

SANFORD, L.P.

A LIMITED PARTNERSHIP OF ILLINOIS

By Authority of the
COMMISSIONER OF PATENTS AND TRADEMARKS


[Handwritten Signature]
T. PROFFENBERG
Certifying Officer

United States Patent Office

307,818
Registered May 3, 1966

PRINCIPAL REGISTER Trademark

Ser. No. 194,243, filed May 25, 1964

Sharpie

Sanford Ink Company (Illinois corporation)
2740 Washington Blvd.
Bellwood, Ill.

For: MARKING AND WRITING PENS, in CLASS
37.
First use May 5, 1964; in commerce May 5, 1964.

B. C. WASHINGTON, Examiner.

EXHIBIT 2

1171292



THE UNITED STATES OF AMERICA

TO ALL TO WHOM THESE PRESENTS SHALL COME:

**UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office**

May 17, 2004

**THE ATTACHED U.S. TRADEMARK REGISTRATION 2,721,523 IS
CERTIFIED TO BE A TRUE COPY OF THE REGISTRATION ISSUED BY
THE UNITED STATES PATENT AND TRADEMARK OFFICE, WHICH
REGISTRATION IS IN FULL FORCE AND EFFECT.**

**REGISTERED FOR A TERM OF 10 YEARS FROM *June 03, 2003*
SAID RECORDS SHOW TITLE TO BE IN: *Registrant***

By Authority of the
COMMISSIONER OF PATENTS AND TRADEMARKS




N. WILLIAMS

Certifying Officer

Int. Cl.: 16

Prior U.S. Cls.: 2, 5, 22, 23, 29, 37, 38 and 50

Reg. No. 2,721,523

United States Patent and Trademark Office

Registered June 3, 2003

**TRADEMARK
PRINCIPAL REGISTER**

SHARPIE

**SANFORD, L.P. (ILLINOIS LIMITED PARTNER-
SHIP)
2711 WASHINGTON BLVD.
BELLWOOD, IL 60104**

FIRST USE 5-5-1964; IN COMMERCE 5-5-1964.

OWNER OF U.S. REG. NO. 807,818.

**FOR: WRITING INSTRUMENTS, NAMELY PENS
AND MARKERS, IN CLASS 16 (U.S. CLS. 2, 5, 22, 23,
29, 37, 38 AND 50).**

SER. NO. 78-143,334, FILED 7-12-2002.

TARAH HARDY, EXAMINING ATTORNEY

EXHIBIT 3

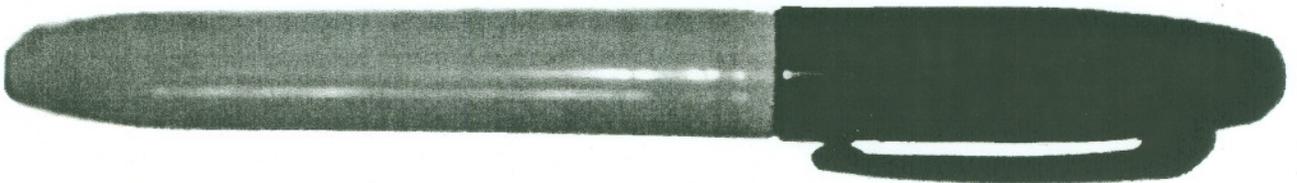
SHARPIE® TRADE DRESS



SHARPIE® Fine

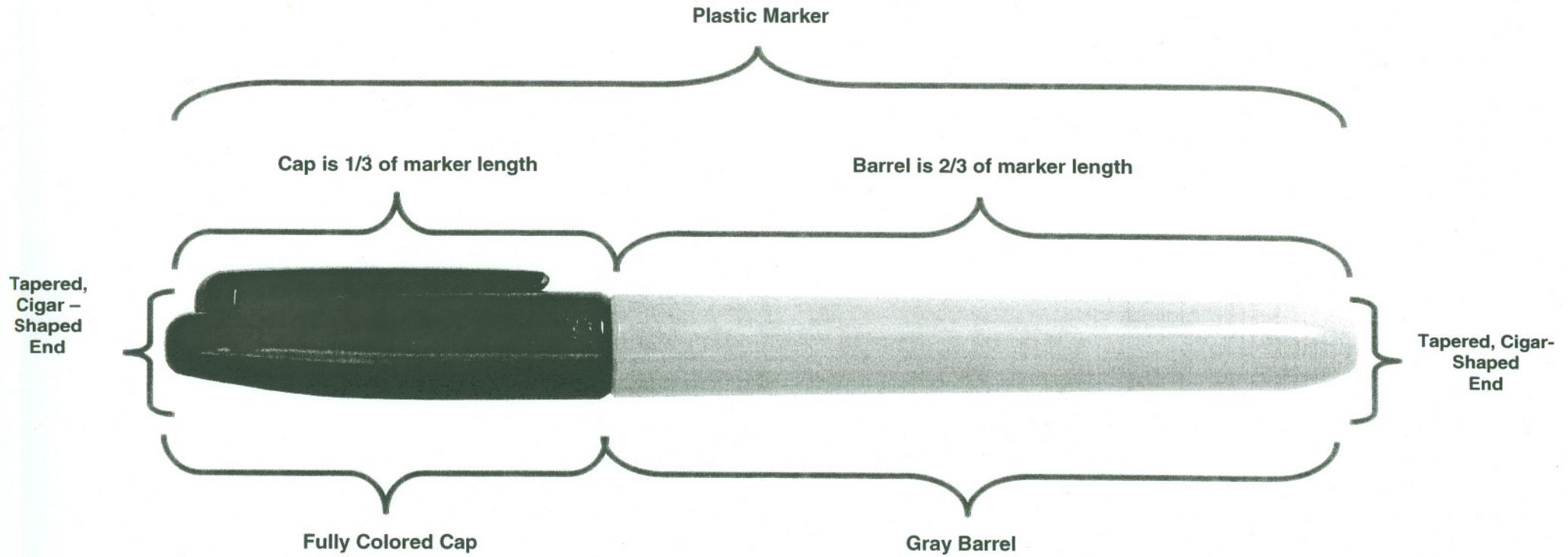


SHARPIE® Metallic



SHARPIE® Super

SHARPIE® TRADE DRESS



UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

CERTAIN INK MARKERS AND
PACKAGING THEREOF

Investigation No. 337-TA-522

ORDER TO CEASE AND DESIST

IT IS HEREBY ORDERED THAT Mon Ami Co., Ltd., 125-20 Jungdam 1-Dong, Gangnam-Gu, Seoul, 135-957, South Korea (hereinafter "Mon Ami" or "Respondent") cease and desist from conducting any of the following activities in the United States: importing, selling, offering for sale, marketing, advertising, distributing, transferring (except for exportation), and soliciting U.S. agents, dealers, distributors or the like for imported ink markers and packaging thereof that bear Sanford's protected trade dress or any trade dress confusingly similar thereto or that are otherwise misleading as to source, origin or sponsorship the protected trade dress in violation of section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337.

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U.S. INTERNATIONAL TRADE COMMISSION

I.

Definitions

As used in this Order:

(A) "Commission" shall mean the United States International Trade Commission.

(B) "Mon Ami Co., Ltd.," "Mon Ami" and "Respondent" shall mean Mon Ami Co., Ltd., 125-20 Jungdam 1-Dong, Gangnam-Gu, Seoul, 135-957, South

Korea and its affiliates, subsidiaries, assigns, and any other related business entities

(C) "Person" shall mean an individual, non-governmental partnership, firm, association, corporation, or other legal or business entity other than Respondent or its majority owned or controlled subsidiaries, their successors, or assigns.

(D) "United States" shall mean the fifty States, the District of Columbia, and Puerto Rico.

(E) The terms "import" and "importation" refer to importation for entry for consumption, entry for consumption from a foreign-trade zone, and withdrawal from warehouse for consumption under the Customs laws of the United States.

(F) The term "covered products" shall mean ink markers and packaging thereof that are manufactured abroad by or on behalf of, or are imported by or on behalf of, Respondent, that bear Sanford's protected trade dress or any trade dress confusingly similar thereto or that are otherwise misleading as to source, origin or sponsorship and thereby infringe the protected trade dress as described by the Commission and shown in the photograph attached hereto, and that are not imported by, under license from, or with the permission of the trade dress owner, or as provided by law. The Commission has described the protected trade dress as follows:

A distinctive gray, tapered, cigar-shaped barrel; a

tapered, fully-colored cap that contrasts with the gray color of the barrel; and a cap-to-barrel ratio of approximately 1/3 to 2/3 (a 1 :2 ratio) of the total size of the marker.

Unreviewed Initial Determination at 15 (Order No. 30, July 25, 2005).

II.

Applicability

The provisions of this Cease and Desist Order shall apply to Respondent and to any of its principals, stockholders, officers, directors, employees, agents, licensees, distributors, controlled (whether by stock ownership or otherwise) and majority-owned business entities, successors, and assigns, and to each of them, insofar as they are engaging in conduct prohibited by Section III, *infra*, for, with, or otherwise on behalf of, Respondent.

III.

Conduct Prohibited

The following conduct of Respondent in the United States is prohibited by the Order. Until the asserted trade dress is abandoned or rendered invalid or unenforceable, Respondent shall not:

- (A) import into the United States covered products;
- (B) market, distribute, offer for sale, sell, or otherwise transfer (except for exportation), in the United States imported covered products;
- (C) advertise imported covered products;
- (D) solicit U.S. agents, dealers, distributors, or the like for imported

covered products; or

(E) aid or abet other entities in the importation, sale for importation, sale after importation, transfer, or distribution of covered products.

IV.

Conduct Permitted

Notwithstanding any other provision of this Order, specific conduct otherwise prohibited by the terms of this Order shall be permitted if, in a written instrument, the owner of the protected trade dress licenses or authorizes such specific conduct, or such specific conduct is related to the importation or sale of covered products by or for the United States.

V.

Reporting

For purposes of this reporting requirement, the reporting periods shall commence on July 1 of each year and shall end on the subsequent June 30. However, the first report required under this section shall cover the period from the date of issuance of this Order through June 30, 2006. This reporting requirement shall continue in force until such time as Respondent will have truthfully reported, in two consecutive timely filed reports, that it has no inventory of covered products in the United States.

Within thirty (30) days of the last day of the reporting period, Respondent shall report to the Commission the quantity in units and the value in dollars of covered products that Respondent has imported or sold in the United States after

importation during the reporting period and the quantity in units and value in dollars of reported covered products that remain in inventory in the United States at the end of the reporting period.

Any failure to make the required report or the filing of any false or inaccurate report shall constitute a violation of this Order, and the submission of a false or inaccurate report may be referred to the U.S. Department of Justice as a possible criminal violation of 18 U.S.C. § 1001.

VI.

Record-keeping and Inspection

(A) For the purpose of securing compliance with this Order, Respondent shall retain any and all records relating to the sale, offer for sale, marketing, or distribution in the United States of covered products, made and received in the usual and ordinary course of business, whether in detail or in summary form, for a period of three (3) years from the close of the fiscal year to which they pertain.

(B) For the purpose of determining or securing compliance with this Order and for no other purpose, and subject to any privilege recognized by the federal courts of the United States, duly authorized representatives of the Commission, upon reasonable written notice by the Commission or its staff, shall be permitted access and the right to inspect and copy in Respondent's principal offices during office hours, and in the presence of counsel or other representatives if Respondent so chooses, all books, ledgers, accounts, correspondence, memoranda, and other records and documents, both in detail and in summary

form, as are required to be retained by subparagraph VI(A) of this Order.

VII.

Service of Cease and Desist Order

Respondent is ordered and directed to:

(A) Serve, within fifteen (15) days after the effective date of this Order, a copy of this Order upon each of its respective officers, directors, managing agents, agents, and employees who have any responsibility for the importation, marketing, distribution, or sale of imported covered products in the United States as well as upon those persons with these responsibilities at the licensees, distributors, contractors, and controlled (whether by stock ownership or otherwise) and/or majority owned business entities described in paragraph I;

(B) Serve, within fifteen (15) days after the succession of any persons referred to in subparagraph VII (A) of this Order, a copy of the Order upon each successor; and

(C) Maintain such records as will show the name, title, and address of each person upon whom the Order has been served, as described in subparagraphs VII(A) and VII(B) of this Order, together with the date on which service was made.

The obligations set forth in subparagraphs VII(B) and VII(C) shall remain in effect until the protected trade dress is abandoned or rendered invalid or unenforceable.

VIII.

Confidentiality

Any request for confidential treatment of information obtained by the Commission pursuant to Sections V and VI of this Order should be in accordance with Commission Rule 201.6, 19 C.F.R. § 201.6. For all reports for which confidential treatment is sought, Respondent must provide a public version of such report with confidential information redacted.

IX.

Enforcement

Violation of this Order may result in any of the actions specified in section 210.75 of the Commission's Rules of Practice and Procedure, 19 C.F.R. § 210.75, including an action for civil penalties in accordance with section 337(f) of the Tariff Act of 1930, 19 U.S.C. § 1337(f), and any other action as the Commission may deem appropriate. In determining whether Respondent is in violation of this Order, the Commission may infer facts adverse to Respondent if Respondent fails to provide adequate or timely information.

X.

Modification

The Commission may amend this Order on its own motion or in accordance with the procedure described in section 210.76 of the Commission's Rules of Practice and Procedure, 19 C.F.R. § 210.76.

XI.

Bonding

The conduct prohibited by Section III of this Order may be continued during the sixty (60) period in which this Order is under review by the United States Trade Representative, pursuant to section 337(j) of the Tariff Act of 1930, 19 U.S.C. § 1337(j), and the Presidential Memorandum for the United States Trade Representative of July 21, 2005 (70 *Fed. Reg.* 43251), subject to Respondent posting a bond of 100% of entered value of the covered products. This bond provision does not apply to conduct that is otherwise permitted by Section IV of this Order. Covered products imported on or after the date of issuance of this order are subject to the entry bond as set forth in the general exclusion order issued by the Commission, and are not subject to this bond provision.

The bond is to be posted in accordance with the procedures established by the Commission for the posting of bonds by complainants in connection with the issuance of temporary exclusion orders. *See* Commission Rule 210.68, 19 C.F.R. § 210.68. The bond and any accompanying documentation is to be provided to and approved by the Commission prior to the commencement of conduct which is otherwise prohibited by Section III of this Order.

The bond is to be forfeited in the event that the United States Trade Representative approves, or does not disapprove within the Presidential review period, this Order, unless the U.S. Court of Appeals for the Federal Circuit, in a

final judgment, reverses any Commission final determination and order as to Respondent on appeal, or unless Respondent exports the products subject to this bond or destroys them and provides certification to that effect satisfactory to the Commission.

The bond is to be released in the event the United States Trade Representative disapproves this Order and no subsequent order is issued by the Commission and approved, or not disapproved, by the United States Trade Representative, upon service on Respondent of an order issued by the Commission based upon application therefore made by Respondent to the Commission.

By Order of the Commission.

A handwritten signature in black ink, appearing to read 'Marilyn R. Abbott', with a large, stylized flourish at the end.

Marilyn R. Abbott
Secretary to the Commission

Issued: October 25, 2005

CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached **Order To Cease and Desist**, was served upon the Commission Investigative Attorney, and all parties via first class mail and air mail where necessary on October 26, 2005.



Marilyn R. Abbott, Secretary
U.S. International Trade Commission
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