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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF INDIANA, HAMMOND DIVISION

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UNION OF ORTHODOX JEWISH
CONGREGATIONS OF AMERICA
11 Broadway
New York, New York 10004

Plaintiff,

v.

LUKE OIL CO., INC.
3592 North Hobart Road
Hobart, IN 46342

Defendant.

CIVIL ACTION NO. 2 09 C V 331

MEMORANDUM OF LAW IN SUPPORT
OF MOTION FOR PRELIMINARY
INJUNCTION

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I. PRELIMINARY STATEMENT

Plaintiff Union of Orthodox Jewish Congregations of America (the “Orthodox Union”), through its attorneys, respectfully submits this memorandum of law in support of its motion for a preliminary injunction, to enjoin Defendant Luke Oil Co., Inc. (“Luke Oil” or “Defendant”) from infringing the Orthodox Union’s famous  kosher certification mark (the “OU mark”).

The Orthodox Union is a New York not-for-profit corporation that performs kosher certifications for food products in the United States and around the world. Luke Oil is in the business of operating gasoline service stations and convenience stores, and has recently begun to brand its operations with an exact replica of the OU mark. Luke Oil has continued its infringing use of the OU mark despite the Orthodox Union’s demands that it cease its infringing activity. Luke Oil has therefore demonstrated a willful disregard for the Orthodox Union’s trademark rights and the rights of the kosher consuming public.

The facts of this case are simple and straightforward, and demand injunctive relief. Luke Oil is using the OU mark in connection with its operations and sale of food and beverage products without authorization, and such use has caused, and continues to cause, irreparable harm to the Orthodox Union and to the kosher consuming public. The Orthodox Union has an overwhelming likelihood of success on the merits of its claims, since Luke Oil has absolutely no right to use the OU mark, and has failed to respond to demands by the Orthodox Union to cease its unauthorized use of the mark. Under these circumstances, injunctive relief is both proper and required.

II. STATEMENT OF FACTS

A. The Orthodox Union And The OU Mark

One of the basic tenets of Jewish law is that all food consumed must be kosher.

Declaration of Rabbi Menachem Genack, attached hereto as Attachment 1 (“Genack Decl.”) at ¶ 3. Kosher laws dictate which foods may and may not be eaten and how kosher food is to be prepared. Because Kosher laws are complex, most consumers choose to rely upon a certification agency’s authoritative certification that a particular packaged food or beverage product has been prepared according to strict kosher standards. *Id.* at ¶ 9. Not only do Jewish consumers seek out kosher food, but so do many Seventh-day Adventists, Muslims, vegetarians and health-conscious consumers because of the high standards of quality under which kosher food is manufactured. *Id.* at ¶ 7.

Pronouncing a food to be “kosher,” and the koshering process undertaken for products related to food preparation, does not depend upon a Rabbi “giving his blessing” for the product. Rather, it involves a meticulous examination of the product itself to determine whether the product, all of its ingredients, its method of preparation, and the equipment used to prepare the product meet the strict standards and high level of quality demanded by kosher laws. Before certifying a product, the Orthodox Union gathers information about the product, its ingredients, and the location and conditions under which the product is manufactured. *Id.* at ¶¶ 5. Thereafter, a licensed rabbinic inspector (a “Mashgiach”) visits the applicant’s facilities to examine each step of the manufacturing process to determine strict compliance with kosher laws. *Id.* at ¶ 4, 13. Applicants who meet all the standards and obtain certification from the Orthodox Union must subsequently undergo periodic follow-up inspections to ensure that their compliance is ongoing. *Id.* at ¶¶ 12-15.

After a product has been certified as kosher, the Orthodox Union licenses the producer to use the famous OU mark on the approved product pursuant to a written license agreement. The Orthodox Union is the exclusive owner of the OU mark and has obtained incontestable federal registrations for the OU mark. *Id.* at ¶ 14; *see also* Complaint Ex. A.

The Orthodox Union is the preeminent kosher certification entity in the United States and throughout the world. Genack Decl. at ¶¶ 9, 15. For over 80 years, the Orthodox Union has inspected, supervised, and certified as kosher thousands of food and beverage producers' products. *Id.* at ¶ 9. The Orthodox Union has spent considerable money, time and energy promoting its certification services and its OU mark. *Id.* at ¶ 11. The OU mark is the central feature of the Orthodox Union's promotional efforts and has received extensive coverage in print and on television and radio, in religious and dietary-conscious media sources, and also in the general interest media. *Id.* at ¶ 11.

The Orthodox Union views its role in kosher certification as a critical public service that serves the kosher consuming public. The Orthodox Union has set high standards for its licensees, and thus its good will and reputation with consumers is its stock-in-trade. This good will and reputation are presented to the public in the form of the OU mark. *Id.* at ¶ 16. Accordingly, Orthodox Union vigilantly monitors the authorized and unauthorized use of the OU mark in commerce, in connection with food products and also with other products and services offered in commerce outside the food industry.

B. Luke Oil's Willfully Infringing Activity

Luke Oil currently operates at least 23 convenience stores and gasoline service stations in northwest Indiana and the Chicago area. Luke Oil markets and sells food and drink products at its convenience store chain which is affiliated with its gasoline service activities. On or about August 16, 2009, the Orthodox Union learned that Luke Oil was using the OU mark without the

Orthodox Union's knowledge or authorization as part of the Luke Oil corporate branding for at least 10 of its convenience store and gas station locations, and in connection with the marketing and sale of food and drink products. See Exhibits B through G attached to the Complaint. On September 10, 2009 the Orthodox Union informed Luke Oil by letter (sent by e-mail and US mail) that its use of the OU mark was unauthorized and constituted trademark infringement. See Exhibit H attached to the Complaint. Orthodox Union informed Luke Oil that it was "willing to work with Luke Oil on the development of a prompt timetable for necessary corrective action and cessation by Luke Oil of any further unauthorized uses of the OU mark." Exhibit H.

On September 10, 2009, Tom Collins, Vice President of Luke Oil, responded by e-mail to the Orthodox Union's letter and informed counsel that the letter "was fair" and that either he or his counsel would contact Orthodox Union's counsel by the September 15 deadline set in Orthodox Union's notification letter. See Exhibit I attached to the Complaint. On September 15, 2009, counsel for Orthodox Union contacted Mr. Collins by e-mail and informed him that he had not heard from either Luke Oil or Luke Oil's counsel.

On September 16, 2009, Mr. Collins contacted counsel for Orthodox Union by e-mail and informed him that Luke Oil had retained the services of a trademark attorney. Mr. Collins promised that either his counsel or he would "personally respond to [Orthodox Union's] letter and outline Luke's plan moving forward." Exhibit J attached to the Complaint. On September 21, 2009, counsel for Orthodox Union again contacted Mr. Collins by e-mail and informed him that he still had not heard from Luke Oil or Luke Oil's counsel. See Exhibit K attached to the Complaint. Counsel for Orthodox Union informed Mr. Collins that if Luke Oil did not provide a substantive response by close of business on September 22, 2009, that Orthodox Union would begin to prepare a lawsuit and motion for injunctive relief. Exhibit K.

On September 22, 2009, counsel for Luke Oil notified counsel for Orthodox Union by e-mail that “Luke Oil was totally unaware of the Orthodox Union’s trademark rights, and will be respectful of those rights as they are understood.” Counsel for Luke Oil further promised to provide to Orthodox Union a “definitive response within a week.” *See* Exhibit L attached to the Complaint. Notwithstanding that representation, Counsel for Luke Oil has failed to contact counsel for Orthodox Union or to respond to Orthodox Union’s demands. As of the date of the filing of this action, Luke Oil has not responded substantively to Orthodox Union’s September 10 correspondence, and has continued its unauthorized use of the OU mark in the same manner as before Orthodox Union’s notice of infringement and demand for cessation of the infringement.

Once Orthodox Union notified Luke Oil on September 10, 2009 of the existence of the OU mark’s federal registrations; that the OU mark is incontestable; that the OU mark is a famous mark; that Luke Oil’s unauthorized use of the OU mark constituted trademark infringement, dilution of a famous mark, unfair competition and a deceptive sales practice, Luke Oil’s continued unauthorized use of the OU mark became knowing and willful. As such, since at least September 11, 2009, Luke Oil has willfully and intentionally infringed the OU mark.

III. ARGUMENT

A. Plaintiff is Entitled to a Preliminary Injunction.

The Lanham Act gives the Court the power to grant injunctive relief “according to the principles of equity and upon such terms as the court may deem reasonable, to prevent the violation of any right of the registrant of a mark registered in the Patent and Trademark Office” 15 U.S.C. § 1116(a) (2004).

A preliminary injunction should issue if the moving party shows that (1) it will suffer irreparable harm if relief is denied, (2) there is a likelihood of success on the merits, (3) the balance

of hardships tips in the movant's favor, and (4) an injunction will serve the public interest. *Hoosier Energy Rural Elec. Co-op., Inc. v. John Hancock Life Ins. Co.*, Case Nos. 08-4030, 08-4248 2009 WL 2981884 at *2 (7th Cir. Sept. 17, 2009) citing *Winter v. Natural Resources Defense Council, Inc.*, 129 S. Ct. 365, 374 (2008).

As demonstrated below, the Orthodox Union fully satisfies the requirements preliminary for injunctive relief.

B. The Orthodox Union Will Be Irreparably Injured If the Requested Relief is Denied.

The Seventh Circuit has held that the law presumes that trademark dilution or infringement threatens irreparable injury for which there is no adequate remedy at law, thus relieving the plaintiff of the need to prove such harm independently. *Abbott Labs. v. Mead Johnson & Co.*, 971 F.2d 6, 16 (7th Cir. 1992); *International Kennel Club, Inc. v. Mighty Star, Inc.*, 846 F.2d 1079, 1092 (7th Cir. 1988). In this case, the likelihood of confusion is inevitable and obvious because Luke Oil is using the *exact same mark* as the Orthodox Union's OU mark.

Moreover, the Orthodox Union and the public have suffered, and continue to suffer, irreparable harm because of Defendant's infringing activities. These infringing activities compromise both the Orthodox Union's reputation as the preeminent kosher certification entity as well as the kosher-consuming public's ability to adhere to strict kosher laws in accordance with their religious beliefs and health concerns.

If Luke Oil is allowed to continue using the OU mark without authorization, the value of the OU mark as a guarantee of kosher standards will be diminished. The loss of control over the use of a trademark "is the very thing that constitutes irreparable harm in the licensing context." *Id.* at 44.

C. The Orthodox Union Has an Overwhelming Likelihood of Success On The Merits of its Lanham Act Claims.

Section 1114 of Title 15 of the United States Code protects registered trademarks from infringement. It provides, in pertinent part, that “[a]ny person who shall, without the consent of the registrant . . . 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 . . . shall be held liable in a civil action by the registrant” 15 U.S.C. § 1114 (2004).

Section 1125(a) of Title 15 of the United States Code addresses a broader category of conduct, and provides that “[a]ny person who, on or in connection with any goods or services . . . uses in commerce any word, term, name, symbol, or device . . . or any . . . false or misleading description of fact, which . . . 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 . . . shall be held 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) (2004). The Lanham Act expressly protects certification marks to the same degree as more traditional trademarks.

The key element in any Lanham Act claim is whether unauthorized use of a mark is “likely to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. §1125(a). To determine the likelihood of confusion, the Seventh Circuit analyzes seven factors to determine whether consumers are likely to be confused:

- (1) the similarity between the marks in appearance and suggestion;
- (2) the similarity of the products;

- (3) the area and manner of concurrent use;
- (4) the degree and care likely to be exercised by consumers;
- (5) the strength of the plaintiff's mark;
- (6) any actual confusion; and
- (7) the intent of the defendant.

Packman v. Chicago Tribune Co., 267 F.3d 628, 642 (7th Cir. 2001). No single factor is dispositive. Courts may assign varying weight to each of the factors depending on the facts presented, though usually the similarity of the marks, the defendant's intent, and actual confusion are particularly important. *Id.* Under this test, there is a strong likelihood that confusion will result from Luke Oil's unauthorized use of the OU mark.

1. The Marks of the Parties Are Identical.

In determining the degree of similarity between the marks, the Seventh Circuit views the marks as a whole. *See Estate of Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 545-546, 40 S.Ct. 414, 64 L.Ed. 705 (1920) ("The commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail."); *see also Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1431 (7th Cir. 1985). The Seventh Circuit compares the marks "in light of what happens in the marketplace and not merely by looking at the two marks side-by-side." *Sullivan v. CBS Corp.*, 385 F.3d 772, 777 (7th Cir. 2004) (*quoting Ty, Inc. v. The Jones Group, Inc.*, 237 F.3d 891, 898 (7th Cir. 2001)); *see also Meridian Mut. Ins. Co. v. Meridian Ins. Group, Inc.*, 128 F.3d 1111, 1115 (7th Cir. 1997). "[T]he test is not whether the public would confuse the marks, but whether the viewer of an accused mark would be likely to associate the product or service with which it is connected with the source of products or services with which an earlier mark is connected." *James Burrough Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 275 (7th Cir. 1976). The court should therefore "consider whether the customer would

believe that the trademark owner sponsored, endorsed or was otherwise affiliated with the product.” *Nike, Inc. v. “Just Did It” Enters.*, 6 F.3d 1225, 1228-29 (7th Cir. 1993).

The degree of similarity here is indisputable because the marks are *identical*. Thus, Defendant’s unauthorized display of the OU mark conveys to the public the exact same impression to the public as do authorized displays of the mark: that the products are kosher, and/or are sponsored by the Orthodox Union, and that they have met the Orthodox Union’s stringent certification standard.

2. The Products and Services are Sufficiently Similar.

The Seventh Circuit’s inquiry into comparing two products “is not whether they are interchangeable, but whether the parties’ products are the kind the public might very well attribute to a single source (the plaintiff).” *Eli Lilly & Co. v. Natural Answers, Inc.*, 233 F.3d 456, 463 (7th Cir. 2000) (quoting *Int’l Kennel Club of Chicago, Inc. v. Mighty Star, Inc.*, 846 F.2d 1079, 1089 (7th Cir. 1988)). The rights of an owner of a registered trademark extend to any goods or services that, in the minds of consumers, might be put out by a single producer. Thus, “[a] likelihood of confusion may exist even if the parties are not in direct competition, or their products and services are not identical.” *CAE, Inc. v. Clean Air Eng’g, Inc.*, 267 F.3d 660, 679 (7th Cir. 2001) (internal citation omitted).

Here, Luke Oil uses the OU mark in connection with its sale and marketing of food and beverage products in its convenience stores, in addition to its use of the OU mark in connection with its sale of gasoline. The OU mark is the preeminent signifier to the public that a particular food or beverage product has been certified as Kosher by the Orthodox Union. Given that the mark used by Luke Oil is identical to the OU symbol trademarked by Orthodox Union, the OU mark imprinted directly upon Luke Oil’s food and beverage products are likely to be interpreted in the minds of consumers as a certification by the Orthodox Union that these products are

certified as Kosher. Similarly, Luke Oil's use of the OU mark in its signage on the front and within its convenience stores, gives the impression to consumers that the Luke Oil convenience stores are under the supervision of the Orthodox Union, and are the purveyors of certified Kosher products.

3. Luke Oil and Orthodox Union Use the OU Mark Concurrently.

“The third factor in the likelihood of confusion analysis assesses ‘whether there is a relationship in use, promotion, distribution, or sales between the goods or services of the parties.’” *CAE, Inc.*, 267 F.3d at 681 (quoting *Forum Corp. of N. Am. v. Forum, Ltd.*, 903 F.2d 434, 442 (7th Cir. 1990)). Here, the OU mark is marketed and promoted at the national and international levels. Luke Oil uses the OU mark in at least Northern Indiana and the greater Chicago area. The Orthodox Union's mark is undoubtedly used in the same geographic areas, and in the same channels of commerce (food distribution and food products), that Luke Oil operates. The difference in market sizes of the parties is irrelevant to the Court's analysis. The Seventh Circuit has held that “trademark law makes no exception for the localized infringer.” *AutoZone, Inc. v. Strick*, 543 F.3d 923, 932 (7th Cir. 2008).

4. The Public is Not Sufficiently Sophisticated With Respect to the Goods at Issue.

In evaluating whether or not the public is sufficiently sophisticated to evaluate the goods at issue, “the more widely accessible and inexpensive the products and services, the more likely that consumers will exercise a lesser degree of care and discrimination in their purchases.” *CAE, Inc. v. Clean Air Eng'g, Inc.*, 267 F.3d 660, 683 (7th Cir. 2001) (holding that customers' technical sophistication does not equate to trademark sophistication), citing *Fuji Photo Film Co. v. Shinohara Shoji Kabushiki Kaisha*, 754 F.2d 591, 598 (5th Cir. 1985) (explaining that, even though consumers of printing presses were sophisticated and did not buy on impulse, those

factors were not determinative). Where relatively small sums are involved, the public is not likely to be as discerning about their purchases. *CAE, Inc. v. Clean Air Eng'g, Inc.*, 267 F.3d 660, 683 (7th Cir. 2001); J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 23:95, at 23-188 (4th ed. 1998).

Here, consumers are unable to make independent determinations of whether a product is kosher. Consumers cannot devote the substantial resources necessary to studying and mastering the detailed and complex kosher laws, and are not able to inspect the facilities and suppliers of the manufacturers who produce kosher products. Rather, they rely on the OU mark to help them identify kosher products. When purchasing food, consumers can not be expected to differentiate between a valid OU mark, and an identical replica. But even for other products, consumers have no way of distinguishing between a valid OU mark that indicates endorsement or affiliation with the Orthodox Union, and an invalid—but identical—replica, such as the mark used by Luke Oil here. Under these circumstances, a likelihood of confusion exists.

5. The OU Mark is Strong.

“The stronger the mark, the more likely it is that encroachment on it will produce confusion.” *AutoZone, Inc. v. Strick*, 543 F.3d 923, 933 (7th Cir. 2008) (internal citations omitted). The “strength” of a trademark refers to the mark’s distinctiveness, meaning its propensity to identify the products or services sold as emanating from a particular source. *CAE, Inc. v. Clean Air Eng'g, Inc.*, 267 F.3d 660, 684 (7th Cir. 2001) The Orthodox Union is the owner of two incontestable Federal Registrations of the OU mark. See Complaint Exhibit A. The registrations are prima facie evidence of the validity of the Orthodox Union’s mark, and they establish its exclusive rights to the mark in commerce, and serve as constructive notice of its claim of ownership of the mark. See 15 U.S.C. §§ 1057(b), 1072, and 1115(b) (2004).

“The strength of a mark usually corresponds to its economic and marketing strength.” *AutoZone, Inc. v. Strick*, 543 F.3d 923, 933 (7th Cir. 2008). The Orthodox Union has used the OU mark since 1925. Throughout more than 80 years, the Orthodox Union has expended substantial resources in promoting the OU mark as a guarantee that the highest standards of kosher supervision have been met by any product which bears the OU mark. These efforts have established the OU mark as the most widely recognized and respected imprimatur of kosher compliance in the world. The OU mark is relied upon by millions of people in the daily observation of their religious beliefs, and by millions more in the care of their health.

6. Defendant Acted In Bad Faith In Continuing to Use the Mark.

Defendant here is acting in bad faith in continuing to use the OU mark despite the Orthodox Union’s demands that it cease its infringing action. While Defendant may not have known that the OU mark was a famous and registered trademark of the Orthodox Union when it first began use of the mark, it has been aware of the Orthodox Union’s rights in the OU mark since at least September 10, 2009. Despite such knowledge, Luke Oil has continued to use the OU mark in commerce in an infringing manner, and failed even to respond to Orthodox Union’s repeated efforts to discuss possible remedial action. The fact that Luke Oil continues to use the OU mark in connection with the sale of food and beverage products demonstrates the company’s manifest bad faith.

D. The Orthodox Union Has A Strong Likelihood Of Success On The Merits Of Its Trademark Dilution Claim.

Section §1125(c) of Title 15 of the United States Code, The Trademark Dilution Act, in pertinent part, states that “[t]he owner of a famous mark shall be entitled . . . to an injunction against another person’s commercial use in commerce of a mark or trade name, if such use . . . causes dilution of the distinctive quality of the mark.” 15 U.S.C. § 1125(c) (2004). The statute

defines dilution as “the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of competition between the parties, or likelihood of confusion.” 15 U.S.C. § 1127 (2004). Section 1125(c) provides a list of factors that the court may consider in determining whether a mark is famous, including its degree of inherent or acquired distinctiveness; the duration and extent of its use in connection with its associated goods or services; the duration and extent of its advertising and publicity; the geographic extent of the trading area in which it is used; the channels of trade for the goods or services with which it is used; its degree of recognition; and the nature and extent of use of similar marks by third parties.

Courts recognize two principal forms of dilution: tarnishing and blurring. *Eli Lilly & Co. v. Natural Answers, Inc.*, 233 F.3d 456, 466 (7th Cir. 2000). Dilution by tarnishing occurs when a junior mark's similarity to a famous mark causes consumers mistakenly to associate the famous mark with the defendant's inferior or offensive product. *Panavision Int'l, L.P. v. Toebben*, 141 F.3d 1316, 1326 n. 7 (9th Cir. 1998). Dilution by blurring, the injury at issue here, occurs when consumers “‘see the plaintiff's mark used on a plethora of different goods and services,’ ... ‘raising the possibility that the mark will lose its ability to serve as a unique identifier of the plaintiff's product.’” *Hormel Foods Corp. v. Jim Henson Prod., Inc.*, 73 F.3d 497, 506 (2d Cir. 1996) (quoting 3 McCarthy on Trademarks and Unfair Competition § 24.13[1][a][i] (3d ed. 1995)). The Trademark Dilution Act seeks to prevent both of these forms of dilution by “protect[ing] the trademark owner from the erosion of the distinctiveness and prestige of a trademark caused by ... a proliferation of borrowings, that while not degrading the original seller's mark, are so numerous as to deprive the mark of its distinctiveness and hence impact.” *Illinois High School Ass'n v. GTE Vantage Inc.*, 99 F.3d 244, 247 (7th Cir. 1996).

Unquestionably, the OU mark is “famous” under the statutory criteria. The Orthodox Union has used the OU mark to illustrate the highest standards of supervision and compliance for over 80 years. Genack Decl. at ¶ 9. The mark is recognized throughout the world as a guarantee that approved products meet these high standards. *See, id.* at ¶ 15. The mark appears on a wide range of foods and beverages around the world, including many famous name-brands, thus demonstrating the value manufacturers and consumers alike attach to the Orthodox Union’s certification mark.

Similarly, there is no doubt that Defendant’s conduct causes dilution of the OU mark. When kosher consumers purchase and consume products with the OU mark, they regard the OU mark as proof that the products are properly certified as kosher. Genack Decl. at ¶ 15. Using the OU mark in connection with the sale of products that have not been certified by the Orthodox Union or manufactured under the Orthodox Union’s supervision poses a great threat to consumer confidence and trust in the Orthodox Union and its certification mark. *See Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 217 (2d Cir. 1999) (unauthorized use “diminishes the ‘selling power that a distinctive mark or name with favorable associations has engendered for a product in the mind of the consuming public’”) (quoting *Sally Gee, Inc. v. Myra Hogan, Inc.*, 699 F.2d 621, 624-25 (2d Cir. 1983)). Under these circumstances, the Orthodox Union has a strong likelihood of success on its trademark dilution claim, and it is entitled to injunctive relief.

E. The Balance of the Equities Decidedly Favors Plaintiff and Injunction is in the Public Interest.

The balance of equities weighs in favor of the Orthodox Union. The Orthodox Union has spent considerable money advertising and promoting the OU mark, and prides itself on being the preeminent kosher certification agency. Genack Decl. at ¶ 11. Kosher consumers all over the world rely on the OU mark as an indicator that a product is not only kosher, but that it has been

certified as such by the Orthodox Union. *Id.* at ¶ 15. Consumers trust the Orthodox Union; and therefore, they trust the OU mark. Defendant's continued use of the OU mark threatens the Orthodox Union's reputation and the trust it has built with kosher consumers.

By contrast, Luke Oil simply has no right to use the OU mark. Further, it appears that Luke Oil's use of the OU mark is part of a relatively new branding campaign, and that Luke Oil could revert to its previous corporate symbol without undue burden. Under these circumstances, Luke Oil cannot claim any harm if required to immediately cease from infringing on the Orthodox Union's federal registered and incontestable certification mark.

Moreover, Luke Oil's unauthorized use of the OU mark constitutes a fraud on the public. Consumers of all faiths, whether Jewish or not, have a right to and expectation of truthful representations of food and beverage products' quality and contents. Luke Oil's use of the OU mark falsely represents to consumers that its food and beverage products have undergone the rigorous inspection process and certification standards employed by the Orthodox Union. Injunctive relief preventing Luke Oil from continuing to falsely mark its products with the OU mark will vindicate the public's right to truthful representation of food and beverage products.

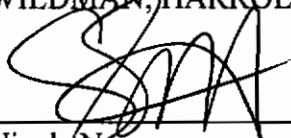
IV. CONCLUSION

For the foregoing reasons, the Orthodox Union respectfully requests that the Court grant its Motion for Preliminary Injunction in all respects, and such other relief as the Court deems just and proper.

Respectfully submitted,

Dated: October 7, 2009.

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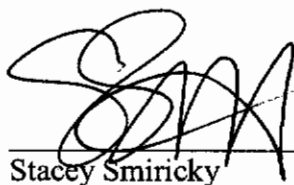
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CERTIFICATE OF SERVICE

The undersigned attorney hereby certifies that a true and correct copy of the foregoing **Memorandum of Law in Support of Motion for Preliminary Injunction** will be served this 7th day of October, 2009, via messenger delivery by It's Your Serve, to:

Luke Oil Co., Inc.
3592 North Hobart Road
Hobart, Indiana 46342



Stacey Smiricky

Ex. 1

UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF INDIANA

UNION OF ORTHODOX JEWISH
CONGREGATIONS OF AMERICA
11 Broadway
New York, New York 10004

Plaintiff,

v.

LUKE OIL CO., INC.
3592 North Hobart Road
Hobart, IN 46342

Defendant.

CIVIL ACTION NO. _____

**Declaration of Rabbi Menachem Genack
in Support of Orthodox Union's Motion
for Preliminary Injunction**

Pursuant to Section 1746 of Title 28 of the United States Code, Rabbi Menachem Genack declares and states as follows:

1. My name is Rabbi Menachem Genack. I am over eighteen years of age and competent to make this declaration.
2. I am an ordained Rabbi and employed by Plaintiff, the Union of Orthodox Jewish Congregations of America (the "Orthodox Union") as Rabbinic Administrator and Chief Executive Officer of the Orthodox Union's Kashruth Division. My responsibilities include, among other things, overseeing the protection and enforcement of rights in the Orthodox Union's ® certification mark (the "OU mark"). I am aware of the events surrounding the Orthodox Union's handling and consideration of Luke Oil Co., Inc.'s ("Luke Oil" or "Defendant") use of the OU mark. I respectfully submit this declaration in support of the application of Orthodox Union for a preliminary injunction, to enjoin Luke Oil from further infringement of the OU mark.

BACKGROUND ON KOSHER CERTIFICATION BY THE ORTHODOX UNION

3. Basic to the Jewish religion is the observance of kosher laws relating to what types of foods may and may not be eaten, and how foods are to be prepared and handled. This stems from the Jewish concept that food has both spiritual as well as physical relevance.

4. Given the wide variety of food and food preparation products available, kosher laws are particularly complex and certain Rabbis known as “Mashgiachs” (Inspectors) have dedicated their entire careers to the study and practical implementation of these laws. The Orthodox Union employs hundreds of such Rabbis to help administer its kosher certification programs, through which it certifies thousands upon thousands of products.

5. Pronouncing a certain food product to be “kosher,” and the koshering process undertaken for products related to food preparation, does not depend upon a Rabbi giving his “blessing” for the product. Rather, it involves a meticulous examination of the product itself to determine whether the product, all its ingredients, its method of preparation, and the equipment used to prepare the product meet the strict standards and high level of quality demanded by kosher laws.

6. Many foods can be kosher or non-kosher depending upon whether certain guidelines were followed in their preparation. For example, beef can be made kosher only if cattle are slaughtered in a prescribed manner. Thus, as between two identical beef steaks, one may be kosher and one non-kosher depending upon how the cattle from which each was obtained were slaughtered.

7. The market for kosher foods is significant, reaching far beyond those who follow the Jewish faith. Many Seventh-day Adventists, Muslims, vegetarians and health-conscious

consumers purchase kosher foods. In the United States alone the kosher market is estimated at over 8.5 million consumers, and accounts for over one billion dollars in annual sales.

8. The Orthodox Union is a New York not-for-profit corporation, and maintains its principal place of business at 11 Broadway, New York, New York 10004.

9. Since 1925, the Orthodox Union has been the preeminent certification agency for kosher foods in the United States and in much of the world. Due to the complexity of kosher laws and the inability of consumers to inspect the manufacturing process for each food item brought into stores, the Orthodox Union serves as a kosher certification agency to provide consumers with the information they require in order to make informed choices regarding food purchases. As part of this process, the Orthodox Union licenses its famous OU mark for use on thousands of products that have been certified by the Orthodox Union as kosher.

10. The Orthodox Union is the exclusive owner of the famous OU mark. The appearance of the OU mark on products indicates not only that the product is kosher, but that it has been certified as kosher by the Orthodox Union rather than by a competing kosher certification agency.

11. The Orthodox Union has spent considerable money in advertising and other promotion of the OU mark. Indeed, the OU mark has been the central feature of most of the Orthodox Union's promotional efforts. The OU mark also has received extensive coverage in print and on television and radio, both in religious and dietary-conscious media sources, as well as in the general interest media.

12. The Orthodox Union has registered the OU mark with the United States Patent and Trademark Office and is the owner of Registration Nos. 636,593 (dated October 30, 1956) and 1,087,891 (dated March 21, 1978). The OU mark has become incontestable. True and correct

copies of the Certificates of Registration for the OU mark are attached as Exhibit A to the Orthodox Union's Complaint in this matter (the "Complaint").

13. In order to qualify to use the OU mark, and thus benefit from affiliation with OU certification, food producers must first file an application with the Orthodox Union. The application must include information about the producer, as well as detailed information regarding the product to be certified, including its ingredients, the source of such ingredients and the location where, and method(s) by which, the item is prepared by the manufacturer. An application fee is also paid to the Orthodox Union. The Orthodox Union assigns a new application to a specialist rabbi (a New Company Rabbinic Coordinator) who initially checks the information contained in the application against its extensive database of approved food ingredients and approved producers. If this initial stage of the application process is completed to the satisfaction of the New Company Rabbinic Coordinator, a specialist Rabbi ("Mashgiach") will be dispatched to the applicant's place of business to physically inspect the manufacturing process. The food ingredients and the manufacturing and warehouse facilities are inspected for strict compliance with kosher laws. Every ingredient in the food and every step in the manufacturing process must be reviewed and approved by the New Company Rabbinic Coordinator and there must be no "contamination" of the approved items by mixing or coming into contact with non-approved foodstuffs or machinery.

14. If all of the approval standards are met, the Orthodox Union will enter into an agreement with the applicant stating that its specific product has been certified as kosher, and granting it the right to use, within defined limitations, the OU mark in connection with its product. An applicant must have its products and facilities re-inspected periodically by a Mashgiach in order to maintain its OU certification. Similar standards and procedures are in place

for services provided under the OU mark. Depending upon the product or service in question, and the risk of the kosher status being tainted, re-inspections may be conducted on a monthly, quarterly, or yearly basis, or within some intermediate time frame. For a limited range of products, the manufacturing process may only be conducted under the constant supervision of a Mashgiach in order to meet kosher standards. If, at any time, the producer or supervised service provider fails to maintain the standards necessary for kosher certification, the Orthodox Union reserves the right to revoke such certification and to rescind the applicant's right to use the OU mark on the particular product or in connection with the particular service(s).

15. The OU certification mark has an extraordinary reputation within the food and beverage market, and consumers have come to associate it with the Orthodox Union. Many consumers will only purchase kosher foods and products bearing the OU certification mark and will pass up products that bear the marks of other kosher certifying agencies.

16. The Orthodox Union views its task in kosher certification as a critical public service and not necessarily as a profit-making venture. This is evidenced, in part, by the Orthodox Union's not-for-profit corporate status. Its primary concern is the welfare of the kosher consumer. The Orthodox Union has set high standards for its licensees and thus its good will and reputation with consumers is its stock-in-trade. This good will and reputation are presented to the public in the form of the OU mark.

LUKE OIL'S WILLFUL TRADEMARK INFRINGEMENT

17. Luke Oil is not now and never has been authorized to use the OU mark in connection with any of the food and beverage products it distributes, or in connection with the branding of its gasoline service stations and convenience stores.

18. None of Luke Oil's products or services have been certified by the Orthodox Union, and Luke Oil has not been willing to cooperate with the Orthodox Union's demands that Luke Oil stop its unauthorized use of the OU mark.


19. The Orthodox Union has no knowledge of whether the food products and beverages Luke Oil sells are kosher. As such, kosher consumers are being misled as to both the certification of the products by the Orthodox Union as well as its actual kosher status.

20. Luke Oil's unauthorized use of the OU mark compromises the Orthodox Union's reputation as the preeminent kosher certification entity. As detailed above, the Orthodox Union has spent considerable time, effort and expense in advertising and promoting the OU mark. If Luke Oil is allowed to continue using the OU mark without authorization, the value of the OU mark as a guarantee of kosher standards would be rendered meaningless.

21. No previous request has been made for the relief requested herein.

Pursuant to 28 U.S.C. § 1746, I declare, under the penalty of perjury, that the foregoing is true and correct.

Executed in the State of New York, this 6 day of October, 2009.



Rabbi Menachem Genack