

this purpose, courts have held that even “subtle differences” are enough because there is a “low threshold of materiality.”⁴³ Material differences have been broadly interpreted to include: different warranties,⁴⁴ Cabbage Patch dolls with Spanish language birth certificates and adoption papers,⁴⁵ different soap ingredients,⁴⁶ TIC TACS with a different size and different calorie counts,⁴⁷ chocolates with different shapes,⁴⁸ quality control differences,⁴⁹ packaging or labeling differences,⁵⁰ or different advertising participation or marketing methods.⁵¹ According to several courts, the use of packaging that identifies the country of origin does not mitigate the likelihood of confusion arising from these material differences.⁵² Courts do not always agree, however, on whether particular differences are material.⁵³

Courts have also held that Sections 32 and 43(a) cannot be invoked to block importation of goods manufactured by a corporate affiliate of the U.S.

F.2d 68, 73 (2d Cir. 1987); Phillip Morris, Inc. v. Cigarettes for Less, 69 F. Supp. 2d 1181, 1189 (N.D. Cal. 1999), *aff'd*, 215 F.3d 1333 (9th Cir. 2000); Phillip Morris, Inc. v. Allen Distribs., Inc., 48 F. Supp.2d 844, 850-52 (S.D. Ind. 1999).

43. *Societe des Produits Nestle*, 982 F.2d at 641; accord, *Zino Davidoff*, 571 F.3d at 243, 246 (“In the context of gray-market goods, . . . we apply a low threshold of materiality, requiring no more than a slight difference which consumers would likely deem relevant when considering a purchase of the product.”).

44. *Societe des Produits Nestle*, 982 F.2d at 639 n.7.

45. *Original Appalachian Artworks, Inc.*, 816 F.2d at 73.

46. *Lever Bros. Co.*, 877 F.2d at 103, 108; *Dial Corp. v. Encina Corp.*, 643 F. Supp. 951, 952 (S.D. Fla. 1986).

47. *Ferrero U.S.A., Inc. v. Ozak Trading, Inc.*, 753 F. Supp. 1240, 1243, 1247 (D.N.J.), *aff'd in part, rev'd in part*, 935 F.2d 1281 (3rd Cir. 1991) (reversing only on the issue of attorney fees).

48. *Societe des Produits Nestle*, 982 F.2d at 643.

49. *Iberia Foods Corp. v. Romeo*, 150 F.3d 298, 302 (3d Cir. 1998) (gray market goods); *Davidoff & Cie, S.A. v. PLD Int'l Corp.*, 263 F.3d 1297, 1302 n.5 (11th Cir. 2001) (non-imported goods); *Warner-Lambert Co. v. Northside Dev. Corp.*, 86 F.3d 3, 5 (2d Cir. 1996) (nonimported goods); *Shell Oil Co. v. Commercial Petroleum, Inc.*, 928 F.2d 104, 106 (4th Cir. 1991) (nonimported goods); *El Greco Leather Prods. Co. v. Shoe World, Inc.*, 806 F.2d 392, 394 (2d Cir. 1986) (gray market goods); *Adolph Coors Co. v. A. Genderson & Sons, Inc.*, 486 F. Supp. 131, 133 (D. Colo. 1980) (nonimported goods).

50. *Zino Davidoff SA v. CVS Corp.*, 571 F.3d 238, 243, 246 (2d Cir. 2009) (removal of UPC codes from product packaging of gray market goods); *Shell Oil*, 928 F.2d at 106; *Davidoff & Cie*, 263 F.3d at 1299; *John Paul Mitchell Sys. v. Pete-N-Larry's, Inc.*, 862 F. Supp. 1020, 1027 (W.D.N.Y. 1994); *PepsiCo, Inc. v. Nostalgia Prods. Corp.*, No. 90 C 7024, 1990 U.S. Dist. LEXIS 18990, at *4 (N.D. Ill. Dec. 20, 1990); *El Greco*, 806 F.2d at 394; *Adolph Coors*, 486 F. Supp. at 133.

51. *Nostalgia Prods.*, 1990 U.S. Dist. LEXIS 18990, at *4; *PepsiCo, Inc. v. Giraud*, No. 87-01887(JP), 1988 U.S. Dist. LEXIS 12864, at *7-8 (D.P.R. Mar. 14, 1988).

52. *Societe des Produits Nestle*, 982 F.2d at 643; *Ferrero U.S.A.*, 753 F. Supp. at 1243, *aff'd*, 935 F.2d 1281.

53. *See Graham Webb Int'l Ltd. v. Emporium Drug Mart, Inc.*, 916 F. Supp. 909, 910 (E.D. Ark. 1995) (removal of batch codes from hair care products was not a material difference where it did not significantly affect overall appearance of product, and thus would not materially affect consumer decision to purchase); *John Paul Mitchell Systems v. Randall's Food Markets, Inc.*, 17 S.W.3d 721, 721 (Tex. Ct. App. 2000) (similar).