

2022 WL 521778

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United States District Court, N.D. Illinois, Eastern Division.

FERRARA CANDY COMPANY, Plaintiff,

v.

HIGHARCHY LLC, **ReRoot Chicago LLC** and **Christopher J. Accetta**, Defendants.

Civil Action No. 1:21-cv-05757

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Signed 01/28/2022

Attorneys and Law Firms

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JUDGMENT AND PERMANENT INJUNCTION








Thomas M. Durkin, United States District Court Judge

***1** The Court, pursuant to the Stipulation for Entry of Judgment and Permanent Injunction between Plaintiff Ferrara Candy Co. (“Ferrara”) and the Defendants Higharchy LLC (“Higharchy”), ReRoot Chicago LLC (“ReRoot”) and Christopher J. Accetta (“Accetta”) (collectively, “Defendants”), hereby ORDERS, ADJUDICATES, and DECREES that the final judgment, including permanent injunction, shall be and hereby is entered on the Complaint in the above-referenced matter as follows:

JUDGMENT

It is hereby found by the Court, with the consent of the Plaintiff, Ferrara and the Defendants, Higharchy, ReRoot, and Accetta that:

1. This Court has jurisdiction over Ferrara, Higharchy, Reroot, and Accetta, and over the subject matter of this action, and venue is proper.
2. Accetta owns and operates Higharchy and ReRoot.
3. Ferrara is engaged in the manufacture, distribution, sale, and marketing of well-known candy products, including its famous NERDS candy, throughout the United States.
4. Ferrara owns trademark rights in the NERDS trademark and the depictions of certain NERDS characters, as reflected, in part, by its registrations and applications to register these marks in the United States Patent and Trademark Office shown below:

MARK	REG. NO. / SER. NO.	REG. DATE / FILING DATE	RELEVANT GOODS
NERDS	2,209,131	December 8, 1998	Candy in Class 30
	4,400,174	September 10, 2013	Candy in Class 30
	4,414,355	October 8, 2013	Candy in Class 30
	6,570,731	November 23, 2021	Candy in Class 30
	6,556,724	November 9, 2021	Candy in Class 30
	6,556,722	November 9, 2021	Candy in Class 30
	90/203,686	September 23, 2020	Candy in Class 30
	90/203,814	September 23, 2020	Candy in Class 30


(collectively referred to herein as the “NERDS Marks”). US Trademark Reg. Nos. 2209131, 4400174, and 4414355 are valid, subsisting and constitute conclusive evidence of Ferrara's exclusive right to use the NERDS Marks. [15 U.S.C. § 1115\(b\)](#).


5. Since its introduction in the 1980s, the NERDS candy brand has achieved enormous commercial success throughout the United States, including in Illinois. As a result of this commercial success, the NERDS Marks have become famous among the general consuming public of the United States, and represent extraordinarily valuable goodwill owned by Ferrara.

6. Ferrara has marketed its NERDS candy products to parents as a fun and enjoyable treat for children of all ages. Therefore, Ferrara would never condone or authorize the use of the NERDS Marks in connection with products that could be harmful to children. Moreover, Ferrara has never authorized the use of any of the NERDS Marks, or any of other marks it owns, in connection with products infused with Tetrahydrocannabinol (“THC-infused products”) or for any cannabis products.

7. Ferrara filed its Complaint on October 27, 2021, alleging, *inter alia*, claims for trademark infringement, trade dress infringement, and unfair competition under federal and Illinois state law based on Defendants’ unauthorized marketing, sale, distribution, and advertising of THC-infused products bearing imitations of the NERDS Marks called “Medicated Bud Clusters” and “Medicated Bud Bites” (collectively herein, “Medicated Buds”).

8. The manufacture, marketing, sale, distribution and advertising of Medicated Buds constitutes:

- a. trademark infringement in violation of Section 32 of the Lanham Act,  [15 U.S.C. § 1114](#) and Illinois common law;
- b. trade dress infringement in violation of Section 43(a) of the Lanham Act, [14 U.S.C. § 1125](#) and Illinois common law;

*2 c. unfair competition in violation of Section 43(a) of the Lanham Act,  15 U.S.C. § 1125(a);

d. unfair competition in violation of the Illinois Uniform Deceptive Trade Practices Act (815 ILCS § 510);

e. unjust enrichment in violation of Illinois common law;

9. Therefore, the Court finds that injunctive relief is appropriate.

ORDER


WHEREFORE, IT IS ORDERED, ADJUDGED AND DECREED that:

a) Higharchy, ReRoot, and their agents, corporate and entity affiliates related through common ownership or control, servants, employees, agents, attorneys, heirs, executors, administrators, successors and assigns, and all persons or entities acting in concert or participation with them or any of them, including Accetta, are hereby permanently enjoined from:

i) the manufacture, marketing, sale, advertising, and distribution of Medicated Buds or any other unauthorized products bearing the NERDS Marks, or any mark similar to or dilutive of the NERDS Marks; and

ii) engaging in any other conduct that tends to falsely represent, or that is likely to confuse, mislead, or deceive consumers into believing, that Higharchy, ReRoot, Accetta, or their products or services are sponsored, approved, or licensed by Ferrara, or are in some way connected or affiliated with Ferrara.

b) Higharchy, ReRoot, Accetta and all others holding by, through or under them, are hereby required, jointly and severally, to:

i) account for and pay over to Ferrara all profits derived from their acts of trademark infringement, trade dress infringement, and unfair competition in accordance with  15 U.S.C. § 1117(a) and Illinois common law;

ii) destroy any remaining Medicated Buds in their possession, including packaging, and any advertising, marketing, or promotional materials that include unauthorized uses of the NERDS Marks; and

iii) send a notice to any existing customers or vendors that dealing in, selling, marketing or distributing Medicated Buds is unlawful.

c) This Court shall retain jurisdiction over this matter for the purpose of enforcing this Judgment.

d) The action against Accetta is dismissed without prejudice.

e) Each party shall bear its own costs and attorneys' fees.

All Citations

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