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Second round of *Simon Property Group v mySimon* likely

Giant shopping mall owner [Simon Property Group](#) (SPG), headquartered in Indianapolis, Indiana, plans to pursue a second trademark infringement case against California-based internet shopping service [mySimon](#). SPG won an earlier [case](#) but saw a \$26.8 million verdict reduced to \$50,000. The discovery of new evidence has now led a district court judge to nullify the earlier verdict and pave the way for a second trial.

In August 2000 an Indiana jury recommended that SPG be awarded \$26.8 million in damages for mySimon's infringement of the SIMON trademark. mySimon had been using the domain name 'mysimon.com' and a cartoon character called Simon in connection with its internet shopping service. US District Court Judge David Hamilton later reduced the jury award to \$50,000 and issued a permanent injunction in favour of SPG, which he then stayed pending an appeal. Hamilton also ordered a new trial on the issue of corrective advertising damages, as evidence indicated that SPG did not have a strong brand image or presence on the Internet.

During the course of discovery for the trial on corrective advertising damages, new information was turned over to mySimon. A consultant's report directly addressed the question of whether SPG had acquired secondary meaning in its SIMON mark, including whether consumers knew that SPG was the owner and operator of their local shopping malls. In addition, the consultant's report provided insight into the degree of competition between mySimon's internet-based comparison shopping service and SPG's shopping malls, as well as into the likelihood that online consumers would be confused between the services offered by the two companies. Perhaps most detrimental to SPG, the documents revealed that SPG's senior management had made decisions in the summer of 2000 that contradicted the positions SPG took at the August 2000 trial.

In *Simon Property Group v mySimon* (2003 WL 1807135 (SD Ind)), Hamilton ordered that based on the newly discovered evidence - evidence which SPG should have produced before the August 2000 trial - mySimon is entitled to a new trial on all of the issues, and not just on the issue of corrective advertising damages. Hamilton stated that the consultant's report "calls into question the justice and fairness of the original verdict in favour of SPG, especially on the critical threshold issue of secondary meaning". He also indicated that sanctions against SPG would be appropriate in light of its withholding this type of key evidence.

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