



Trademark Infringement and Likelihood of Confusion

Michael G. Atkins
Graham & Dunn, PC
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Road map

- Trademark basics
- Why confusion matters
- Forms of confusion
- Proving confusion
 - Likelihood of confusion
 - *Sleekcraft* factors
- Applying what we've learned



What's a trademark?

- It's a source identifier
- Any combination of words, names, or symbols used in commerce to identify and distinguish one's goods from those manufactured or sold by others and to indicate the source of the goods

Lanham Act, 15 U.S.C. § 1127

What is a trademark?

- Words: AMAZON.COM, MCDONALD'S, GAP

- Symbols:



- Colors:



- Sounds: *e.g.*, NBC chimes

- Configuration: *e.g.*, iMac design



- Anything else used to identify source



Importance of confusion

- Basis for refusal of registration
 - 15 U.S.C. § 1052(d)
 - Supports opposition or cancellation proceedings
- Basis for lawsuit
 - 15 U.S.C. § 1114(1) – Infringement
 - 15 U.S.C. § 1125(a) – False designation of origin

Likelihood of confusion?



Monogram Multicolore is a creation of Takashi Murakami for Louis Vuitton



Louis Vuitton and Dooney & Bourke purses



Common forms of confusion

- Forward confusion
- Reverse confusion
- Initial interest confusion
- Post-sale confusion



Forward confusion

- Ordinary confusion
- Consumer mistakenly associates junior user's mark with that of the well-known senior trademark
 - *E.g.*, use of YALE for flashlights and batteries held to infringe the well-known YALE mark for locks and keys



Reverse confusion

- Consumer deals with senior mark owner mistakenly believing it is doing business with the junior one
- Occurs when junior user saturates the market with a similar TM and overwhelms the senior user



Reverse confusion

- Junior user does not seek to profit from the goodwill associated with the senior user's mark
 - But senior user loses value of TM in process
 - *E.g.*, MIRACLE SUIT for swimwear
- Designed to prevent a larger, more powerful junior user from usurping the business identity of a smaller senior user



Initial interest confusion

- Consumer seeks a particular TM holder's product and instead is lured to the product of a competitor by the competitor's use of the same or similar mark
- Even though customer may realize the product is not the one originally sought, she may stay with the competitor
- *E.g.*, Sign on highway: "McDonald's next exit," with off ramp leading to Burger King



Initial interest confusion

- Often seen on Internet (*e.g.*, metatags)
 - Unauthorized use of TM diverts Internet traffic to defendant's site, thereby capitalizing on TM owner's goodwill
- Even temporary advantage is enough



Post-sale confusion

- Senior user's potential purchasers might mistakenly associate the inferior quality work of the junior user with the senior user and, therefore, refuse to deal with the senior user in the future
 - *E.g.*, Infringer builds kits that make Corvettes look like far-more expensive Ferraris, making Ferrari cars appear more common and lower quality than they actually are
 - Counterfeit good is inferior to authentic good



What's infringement?

- It's based on likelihood of confusion
- Infringement occurs when the public is likely to be deceived or confused by the similarity of the marks as to source, relationship or sponsorship
 - 15 U.S.C. § 1114(a) & (b)
 - Public thinks good or service comes from one source when it really comes from another



Prima facie case of infringement

1. Valid trademark rights
2. Priority
 - First user generally wins
3. Likelihood of confusion



Proving likelihood of confusion

Sleekcraft factors:

1. Strength of mark
2. Proximity of goods
3. Similarity of marks
4. Evidence of actual confusion
5. Marketing channels used



Proving likelihood of confusion

6. Type of goods and degree of care likely to be exercised by the purchaser
7. Defendant's intent in selecting the mark
8. Likelihood of expansion of the product lines

Strength of mark

- Ability of mark to uniquely identify source

None	Low	→	→	High
Generic	Descriptive	Suggestive	Arbitrary	Fanciful
Coffee	Seattle's Best	Bright & Early	Appassionato	Sanka
Soap	Clean & Smooth	Ivory	Irish Spring	Camay



Strength of mark

- Initially weak mark can become strong through secondary meaning
 - Length of time mark has been used
 - TM holder's renown in the industry
 - Number of other similar registered marks in the field
 - TM holder's efforts to promote and protect mark



Proximity of goods or services

- When the goods are related or complementary, the danger of confusion is heightened
 - *E.g.*, Basketballs and basketball shoes
 - Consumers may mistakenly assume the maker of one also makes the other

Similarity of marks

- Sight



- Sound
 - *E.g.*, SLICKCRAFT and SLEEKCRAFT
- Meaning
 - *E.g.*, APPLE and ORANGE for computers
- Overall commercial impression
 - Focus is on similarities of marks as a whole rather than differences



Evidence of actual confusion

- Tests whether TMs have actually confused consumers
- Actual confusion is not necessary to prevail on infringement claim
 - Test is “likelihood” of confusion, not actual confusion
 - But, actual confusion is best evidence of possible future confusion
 - Lack of confusion significant when marks coexisted for long time
 - Surveys can help prove



Marketing channels used

- Convergent marketing channels increase the likelihood of confusion
- Are goods sold in same type of store or distributed by same wholesaler?



Type of goods and purchaser's likely degree of care

- The more sophisticated the purchaser, the less likely it will be confused by the presence of similar marks in the marketplace
- Where goods are expensive, it is assumed that buyers will exercise greater care in the marketplace
 - Where goods are inexpensive, consumers tend to exercise less care, and thus rely more on brand names



Defendant's intent in selecting the mark

- Considers whether the defendant adopted its mark intending to capitalize on the plaintiff's goodwill and confusion
- When the alleged infringer knowingly adopts a mark similar to another's, courts presume the public will be deceived
- Evidence of good faith:
 - Mark is descriptive
 - Request for TM search before adopting mark
 - Reliance on the advice of counsel



Likelihood of expansion of the product lines

- Goods don't compete, but may in future
- Strong possibility that senior user will enter junior user's market weighs in favor of infringement
- Protects senior user's interest in being able to enter a related field at some future time



Final *Sleekcraft* considerations

- Analysis is not a mechanical measurement, where most factors wins
- Courts focus on the ultimate question of whether consumers are likely to be confused
- Court looks to totality of product
- No one factor is necessarily dispositive, but any one factor may prove to be so



Key *Sleekcraft* cases

- *AMF Inc. v. Sleekcraft Boats*,
599 F.2d 341, 348 (9th Cir. 1979)
- *E. J. Gallo Winery v. Gallo Cattle Co.*,
967 F.2d 1280, 1293 (9th Cir. 1992)
- *M2 Software, Inc. v. Madacy
Entertainment*, 421 F.3d 1073 (9th Cir.
2005)



Other tests for likelihood of confusion

- *Sleekcraft Factors* – Ninth Circuit
- *Polaroid Factors* – Second Circuit
- *DuPont Factors* – Federal Circuit
- Other circuits have other “multi-factor” tests

MILK DUDS & MILKDUDZ



The banner features the Milkdudz logo on the left, which consists of a stylized 'W' with a heart inside, enclosed in a square frame. To the right of the logo, the brand name 'Milkdudz' is written in a large, brown, cursive font, with a trademark symbol (TM) to its upper right. Below the brand name, the tagline 'not your mommaz nursing wear' is written in a smaller, black, sans-serif font. A navigation bar below the logo and tagline contains the following links: Home, Here's Why..., Collection, Cart, About Us, Contact Us, Press, and Stores.

Below the navigation bar, the banner is divided into three main sections. The left section features a colorful illustration of two women sitting on a bench, surrounded by stylized flowers and butterflies. Below the illustration is a call to action: 'Join Our Mailing List' with a heart icon. The middle section shows a photograph of a woman in a pink dress and a man in a suit sitting at a table. Below the photo is the text 'SEXY & CONFIDENT' with a heart icon. The right section features a photograph of a colorful, patterned nursing top on a mannequin, with the text 'HIP & FEMINE' below it. Below that is another photograph of a woman in a white top and a man in a suit sitting at a table, with the text 'EVERLASTING LOVE' below it.

Welcome to Milkdudz.com

Join Our Mailing List

SEXY & CONFIDENT

HIP & FEMINE

EVERLASTING LOVE

Breastfeeding Clothes & Accessories Blended with Style, Love and Joy!



Resources

- J. Thomas McCarthy, McCarthy on Trademarks (7 volumes)
- Jerome Gilson, Trademark Protection and Practice (13 volumes)
- Richard L. Kirkpatrick, Likelihood of Confusion in Trademark Law (1 volume)
- SeattleTrademarkLawyer.com



Questions?

Michael Atkins

Graham & Dunn, PC

(206) 340-9614

matkins@grahamdunn.com

SeattleTrademarkLawyer.com



Thank you!
