

Identity & Origin Trademark

Eric E. Johnson ericejohnson.com



source

Elements of trademark infringement

(regular passing-off theory)

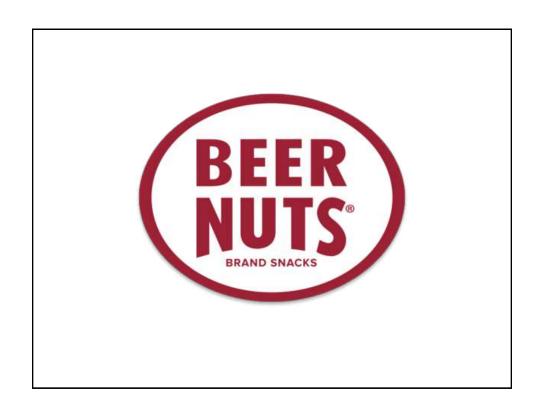
- 1. Ownership of a valid mark, and
- 2. the defendant used
- 3. in commerce
- 4. that mark or a similar symbol
- 5. in connection with the sale, offering for sale, distribution, or advertising of goods or services, and
- 6. the use caused likelihood of confusion, mistake, or deception

Likelihood of confusion factors

- Fed: the DuPont factors
- 1st: the Pignons factors
- 2d: the Polaroid factors
- 3d: the Lapp factors
- 4th: the Pizzeria Uno factors
- 5th: the Oreck factors
- 6th: the Frisch factors
- 8th: the SquirtCo factors
- 9th: the Sleekcraft factors
- · 10th: the Beer-Nuts factors
- D.C.: the Polaroid factors

Different circuits have different lists of factors ...

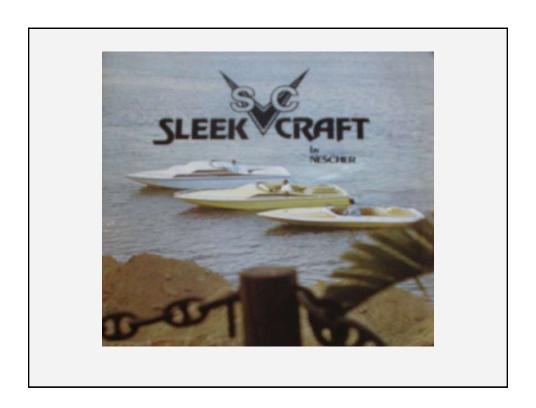
> but substantively, it's all essentially the same analysis.

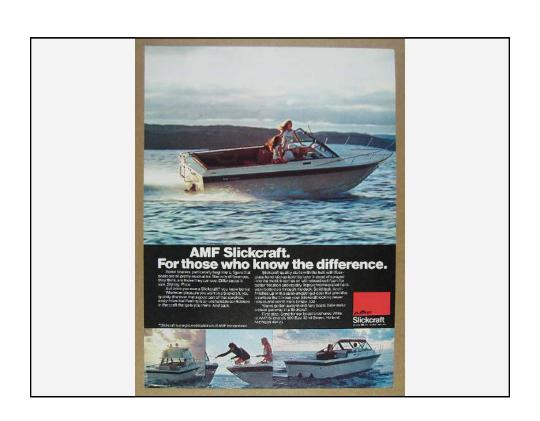












Likelihood of confusion factors

- Fed: the DuPont factors
- 1st: the Pignons factors
- 2d: the Polaroid factors
- 3d: the Lapp factors
- 4th: the Pizzeria Uno factors
- Notwithstanding the 5th: the Ored
- circuits' slightly 6th: the Frise
- different lists, here's 8th: the Squ
- a synthesized list 9th: the Slee
- you can use ... 10th: the Bee
- D.C.: the Pola

Likelihood of confusion factors (synthesized list)

- strength of the plaintiff's mark (commercial strength and distinctiveness)
- degree of similarity between marks
- proximity of products in the marketplace
- likelihood the prior owner will bridge the gap
- actual confusion
- defendant's good faith (or lack thereof) in adopting its own mark
- care and sophistication of relevant consumer

| 3 | inherently distinctive | fanciful arbitrary suggestive | | misdescriptive | inherently distinctive product packaging | |
|---|------------------------|-------------------------------------|--|-------------------------------|---|--|
| can acquire | distinctiveness | merely descriptive | primarily geographically descriptive | deceptively misdescriptive | non-inherently distinctive product packaging product design color | primarily a surname |
| | unprotectable | generic | primarily geographically deceptively misdescriptive | deceptive | functional | names/likenesses of living people without consent gov't symbols |

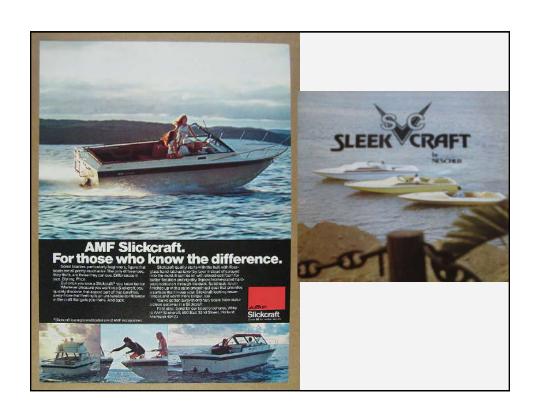
Likelihood of confusion factors (synthesized list)

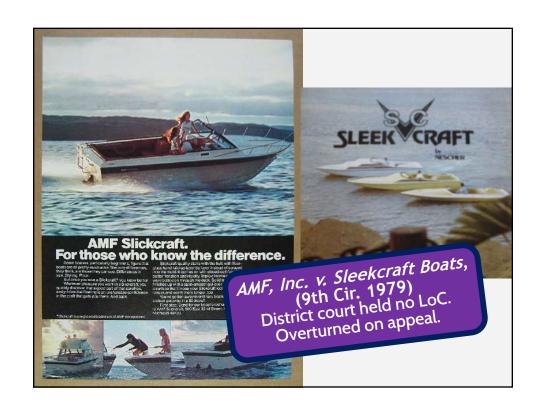
- strength of the plaintiff's mark (commercial strength and distinctiveness)
- degree of similarity between marks
- proximity of products in the marketplace
- likelihood the prior owner will bridge the gap
- actual confusion
- defendant's good faith (or lack thereof) in adopting its own mark
- care and sophistication of relevant consumer















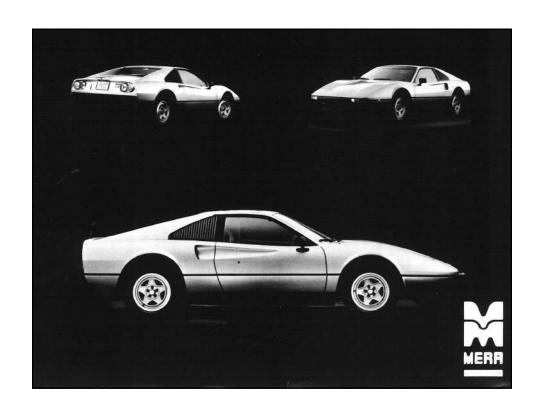
















ring LL

This shows how courts are often willing to stretch trademark doctrine in a way that becomes entirely divorced from its roots in protecting indications of source.

In a similar litigation against another firm, the court offered that some people might think "the mark's owner sponsored or otherwise approved the use of the trademark [design]." Ultimately, the court fixated on "the [defendant's] intent of deriving benefit from the reputation of Ferrari," even (astoundingly) saying, "When a mark is chosen with the intent of deriving benefit from the reputation of the senior user, then that fact alone may show confusing similarity." Ferrari SPA Esercizio Fabriche v. Roberts, (E.D. Tenn. 1990).



