



Identity & Origin  
Trademark

# Trademark Infringement

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Konomark  
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# 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.



“Squirt”  
“Quist”





## Likelihood of confusion factors

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- 1st: the Pignons factors
- 2d: the Polaroid factors
- 3d: the Lapp factors
- 4th: the Pizzeria Uno factors
- 5th: the Oreck factors
- 6th: the Frisco factors
- 8th: the Squibb factors
- 9th: the Sleepy Hollow factors
- 10th: the Beecham factors
- D.C.: the Polaroid factors

Notwithstanding the circuits' slightly different lists, here's a synthesized list you can use ...

## 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

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

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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).

