Identity & Origin
Trademark

Trademark Infringement

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source

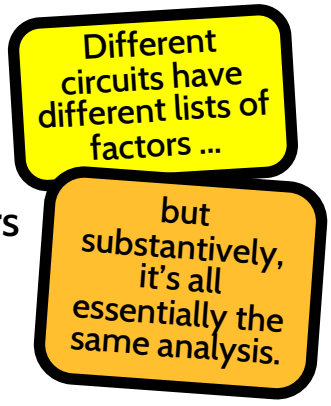
Elements of trademark infringement

(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



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- 9th: the Slee
- 10th: the Bee
- D.C.: the Pola

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

Likelihood of confusion factors
(synthesized list)

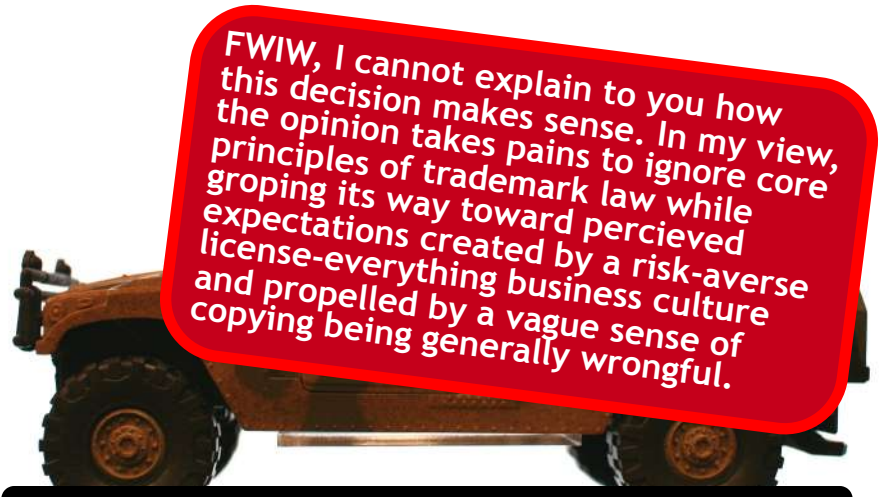
- strength of the plaintiff's mark (commercial strength and distinctiveness)
- degree of similarity between marks
- proximity of products in the marketplace
- likelihood the prior owner will bridge the gap
- actual confusion
- defendant's good faith (or lack thereof) in adopting its own mark
- care and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


Wallace Int'l Silversmiths, Inc., v. Godinger Silver Art Co., Inc., (2d Cir. 1990) (holding that the ornate design of silverware is unprotectable as a trademark)


Ferrari prevailed in using litgation to end Mera's business.
Huh? Who could possibly be confused about buying a hyperexpensive car based on the overall shape?

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).



General Motors Corp. v. Lanard Toys, Inc., (6th Cir. 2006) (upholding exclusive right to vehicle design represented in toy on the basis of trademark doctrine)