

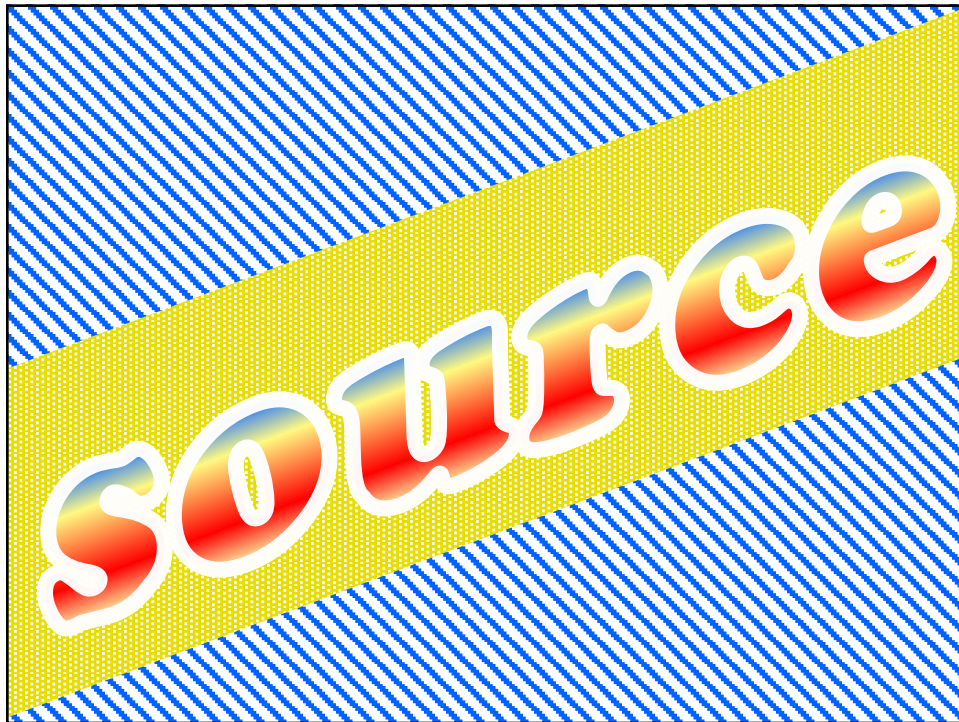


# Likelihood of Confusion

Trademark & Unfair Competition  
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ericejohnson.com



Konomark  
Most rights sharable



## Elements of trademark infringement

(regular passing-off theory)

1. The plaintiff owns
2. a valid trademark, and
3. that mark or a similar symbol was used by the defendant in commerce in connection with the sale, offering for sale, distribution or advertising of any goods or services
4. resulting in a **likelihood of confusion**

## 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
- 6th: the Frisch factors
- 8th: the SquirtCo factors
- 9th: the Sleekcraft factors

Different circuits have different lists of factors ...

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

[shown-in-class image of Squirt soda can omitted from this print-out]

**“Squirt”**  
**“Quist”**

[shown-in-class images of Polaroid and Polarad products omitted from this print-out]



**AMF Slickcraft.**  
**For those who know the difference.**

Some boaters, particularly beginners, regard boats as all pretty much alike. The only differences, they think, are how they are sold. Different colors, new styling, price.

But once you own a Slickcraft, you know better. Whenever you want to go Slickcraft, you quickly discover that almost part of the package, away from the feeling is an unmistakable confidence in the craft that gets you there. And back.

Slickcraft quality starts with the hull, with floor-panels that have a layer of epoxy in place of varnish. The hull is built on a well-wooded form for better retention and rigidity. Impact-modified fiberglass reinforces the deck. Solid hull, solid tracking up with the same amount of fuel that provides a safe and fast ride. Slickcraft's body is more rugged, and worth more for less.

There's gotten better and only looks like a clean getaway is a Slickcraft.

First stop, speed for your boat's engine. We're at AMF Slickcraft, 600 East 52nd Street, Hayward, Michigan 48043.

**AMF Slickcraft**  
 Since 1957, we've been here.

\*Slickcraft has regional distributors of AMF, no approval.

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

## Likelihood of confusion factors (synthesized list)

- the strength of plaintiff's mark
- similarity between plaintiff's and defendant's marks
- the proximity of the products in the marketplace
- the likelihood that the senior user will bridge the gap by beginning to sell in the market of the defendant's product
- evidence of actual confusion
- the sophistication of consumers in the relevant market
- defendant's good faith, or lack thereof, or bad faith, in adopting its own mark
- the quality of the defendant's product

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**BTW:** This list is a slightly re-worded version of the 2d Circuit's eight factors, put in the order that *Virgin v. Nawab* (2d Cir. 2003) puts them in.





[shown-in-class images of  
Virgin Megastores and  
Virgin Atlantic aircraft  
omitted from this print-out]



## Plaintiff gold

Solid gold hits from:



- that a significant number of consumers are likely to be confused about source is generally sufficient for both irreparable harm and a likelihood of success on the merits, which is all you need for a preliminary injunction
- law gives arbitrary or fanciful marks “broad, muscular” protection
- just one person recalling some people just *asking* about affiliation with  $\pi$  was probative for  $\pi$
- the more unusual (arbitrary or fanciful) the more consumers are going to think the same mark in different places represents the same source
- the more well-known the mark, the more likely consumers will think there's a connection

## Defendant gold

- “The trademark right does not protect the exclusive right to an advertising message – only the exclusive right to an identifier, to protect against confusion in the marketplace”
- $\Delta$ 's lack of good faith or bad faith “does not bear directly on whether consumers are likely to be confused”; not of high relevance

## Likelihood of confusion factors

Lessons from: 

- the strength of plaintiff's mark
  - *I.D.*: how inherently distinctive = strength (e.g., “Zzaqqq” more than “Kodak”)
  - *A.D.*: how well-known in the market = strength also
- similarity between plaintiff's and defendant's marks
- the proximity of the products in the marketplace
- the likelihood that the senior user will bridge the gap by beginning to sell in the market of the defendant's product
- evidence of actual confusion
- the sophistication of consumers in the relevant market
- defendant's good faith, or lack thereof, or bad faith, in adopting its own mark
- the quality of the defendant's product
- OVERALL

[shown-in-class image of  
Virgin Mobile flip phone  
omitted from this print-out]

## Likelihood of confusion factors

★ Most important to courts per empirical research

- the strength of plaintiff's mark ★
- similarity between plaintiff's and defendant's marks ★
- the proximity of the products in the marketplace
- the likelihood that the senior user will bridge the gap by beginning to sell in the market of the defendant's product
- evidence of actual confusion ★
- the sophistication of consumers in the relevant market
- defendant's good faith, or lack thereof, or bad faith, in adopting its own mark ★
- the quality of the defendant's product

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

[shown-in-class images of  
 Maker's Mark whiskey  
 bottle and Cuervo tequila  
 bottle omitted from this  
 print-out]

Maker's Mark Distillery, Inc. v. Diageo N. Am., Inc.,  
679 F.3d 410, 420 (6th Cir. 2012):

“[A] finding of conceptual strength is bolstered by the mark's status as “incontestable,” which entitles it to a presumption of strength[.]”

**This does not seem to make any sense at all!**

Incontestability means you can't attack the validity of a mark based on distinctiveness (i.e., that it isn't inherently distinctive and it never acquired distinctiveness).

That doesn't have anything to do with strength. And 15 U.S.C. § 1065 says nothing about strength.

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**SO WHERE DID THIS  
COME FROM?**

## Where did this come from?

*Maker's Mark Distillery, Inc. v. Diageo N. Am., Inc.*, 679 F.3d 410, 420 (6th Cir. 2012):

Here, the district court appropriately evaluated both components of the strength factor. From the physical characteristics of the mark, the district court specifically found the red dripping wax seal to be inherently distinctive based on its uniqueness and its potential to “draw in the customer” in an unusual manner. This finding of conceptual strength is bolstered by the mark’s status as “incontestable,” which entitles it to a presumption of strength, though the relative import of that presumption within the overall strength analysis still requires an analysis of “whether the mark is distinctive and well-known in the general population.” *Therma-Scan, Inc.*, 295 F.3d at 632; see also *Wynn Oil*, 839 F.2d at 1187.

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## Where did this come from?

[Therma-Scan, Inc. v. Thermoscan, Inc.](#),  
295 F.3d 623, 632 (6th Cir. 2002):

TSI does not attempt to establish that its trademark is widely recognized among the general population. Instead, it relies upon the presumption that a trademark that has been registered and uncontested for five years is a **strong mark**. [Data Concepts](#), 150 F.3d at 625 (stating that such a presumption exists); [Wynn Oil Co. v. Thomas](#), 839 F.2d 1183, 1187 (6th Cir.1988) (noting that “once a mark has been registered for five years, the mark must be considered strong and worthy of full protection”).

## Where did this come from?

[Data Concepts, Inc. v. Digital Consulting, Inc.](#),  
150 F.3d 620, 625 (6th Cir. 1998):

A mark that has been registered and uncontested for five years, as Digital's was, is entitled to a **presumption** that it is a **strong mark**. [Wynn Oil Co. v. American Way Serv. Corp.](#), 943 F.2d 595, 600 (6th Cir.1991).

## Where did this come from?

[Wynn Oil Co. v. Am. Way Serv. Corp.](#),  
943 F.2d 595, 600 (6th Cir. 1991):

In evaluating the first factor, the district court followed this court's holding in [Wynn I](#), 839 F.2d at 1187, that "once a mark has been registered for five years, the mark **must be considered strong and worthy of full protection.**" Since Wynn's mark had been registered over five years without being contested, it was **presumptively strong.**

So all roads eventually lead back to [Wynn Oil Co. v. Thomas](#), 839 F.2d 1183, 1187 (6th Cir. 1988).

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(6th Cir. 1988):

As the Supreme Court recently concluded in [Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.](#), 469 U.S. 189 (1985), an infringement action may not be defended on the grounds that a mark is merely descriptive, if that mark has met the requirements of incontestability.

Here Wynn registered the mark CLASSIC with the Patent and Trademark Office on September 9, 1975—nearly ten years before the commencement of this litigation. Yet in spite of the mark's incontestability, the District Court reasoned that CLASSIC is merely a descriptive term, and therefore a weak mark deserving "little, if any protection." Joint Appendix at 26. Permitting Thomas to relitigate the original strength or weakness of the mark runs afoul of Park 'N Fly's requirement that courts give full effect to incontestable trademarks. Therefore, while the strength of plaintiffs' mark will still be at issue in cases involving contestible marks, once a mark has been registered for five years, the mark must be considered strong and worthy of full protection.

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Here's the genesis! →

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## Where did this come from?

Wynn Oil Co. v. Thomas, 669 F. Supp. 831, 833 (M.D. Tenn. 1986):

In the case at bar, it is unnecessary to hold specifically that “CLASSIC” is inappropriate for trademark protection since we find no infringement. Additionally, the strength or weakness of a mark is but one element to be considered in determining whether confusion is likely to result. Moreover, the Supreme Court recently held that the holder of a registered mark may rely on incontestability to enjoin infringement and that such an action may not be defended on the ground that the mark is merely descriptive. See Park 'N Fly v. Dollar Park And Fly, 469 U.S. 189, 205, 105 S.Ct. 658, 667 (1985). Naturally, however, absence of likelihood of confusion remains a valid defense to an infringement claim. Therefore, we shall address the “merely descriptive” status of CLASSIC merely as one factor of many in determining likelihood of confusion.

## Where did this come from?

Wynn Oil Co. v. Thomas, 669 F. Supp. 831, 834–35 (M.D. Tenn. 1986):

*[Going through the likelihood of confusion factors:]*

### **Strength of Mark**

As addressed herein supra, CLASSIC is an inherently weak mark. Standing alone, the word “classic” is frequently used in its generic sense to describe a virtual \*835 panoply of goods and services. Additionally, the record is devoid of evidence tending to show that CLASSIC has acquired a secondary meaning. Wynn's sales revenues and advertising expenses do not prove secondary meaning. See Truckstops Corp. of America v. C-Poultry Co., 596 F.Supp., at 1099. Such an ineffective mark is entitled to little, if any protection.

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(M.D. Tenn. 1986):

*[Going through the likelihood of confusion factors:]*

**Stre** So the district court shouldn't have said "if any" -  
that's wrong insofar as it implies the possibility of  
there being no trademark rights at all because of  
a lack of distinctiveness. That possibility is  
foreclosed by 15 U.S.C. § 1065 and Park'n'Fly.

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But putting aside this loose language / cheap shot,  
a lack of validity wasn't the basis for the district  
court saying there was no infringement.

Now let's work our  
way forward in  
time ...

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## Where did this come from?

So the 6th Circuit just blew it in 1988. The district court didn't decide for the defendant based on validity (which § 1065 & Park'n'Fly would have prohibited). The district court said the mark was relatively weak in the likelihood of confusion analysis - which is about whether the defendant infringed, not whether the plaintiff has a valid mark.

And that mistake got repeated and amplified through the cases in the succeeding years.

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**Hay que ... ¿lindo?**  
**Hay que ... ¿\_\_\_\_\_?**

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## **SONY**

- sells consumer electronics
- the brand familiar to you

## **PONY**

- for an electronic 3-D terrain navigation and horse-health monitoring device for horse riders that costs \$9,000 per unit