

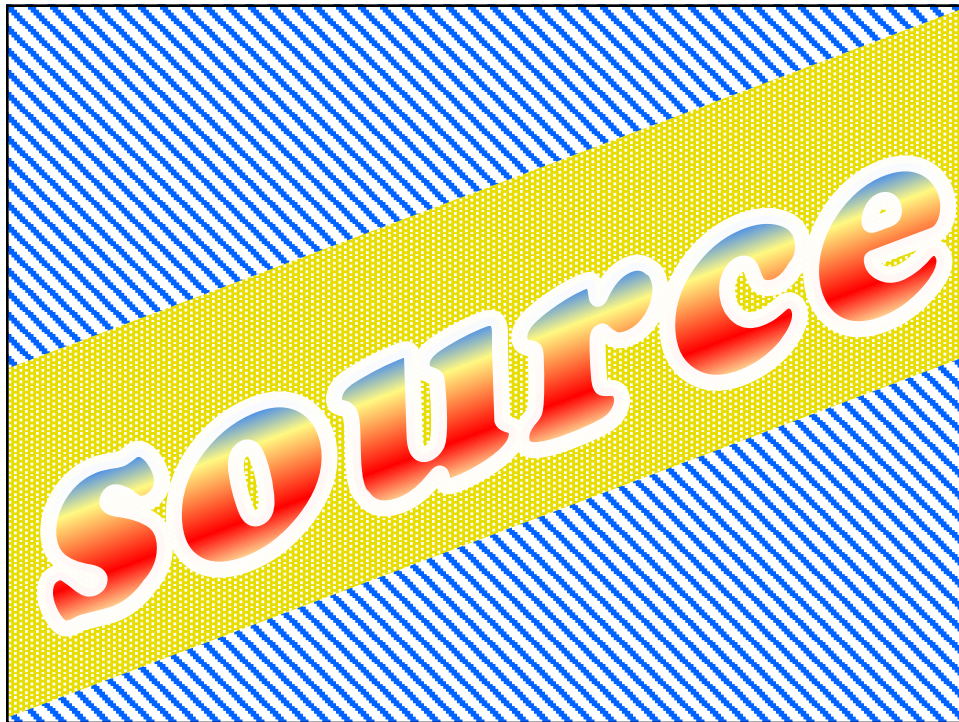


Likelihood of Confusion

Trademark & Unfair Competition
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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

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]



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
- 8th: the Squ
- 9th: the Slee

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

Likelihood of confusion factors

(synthesized list)

- the strength of plaintiff's mark
- similarity between plaintiff's and defendant's marks
- the proximity of the goods and services
- the likelihood that the defendant is beginning to sell in the plaintiff's market
- the quality 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

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.

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

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

★ 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

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



[shown-in-class images of Virgin Records store storefront, Virgin Megastore storefront, and Virgin Atlantic jumbo jet in flight omitted from this print-out]



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

Plaintiff gold

Solid gold hits from:



Defendant gold

- 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 π was probative for π
- 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
- "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"
- Δ 's lack of good faith or bad faith "does not bear directly on whether consumers are likely to be confused"; not of high relevance