

**HOW TO WIN TRADEMARK INFRINGEMENT
LAWSUITS AND INFLUENCE JURORS**

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Under the Lanham Trademark Act of 1946, 15 U.S.C. §§ 1051, 1127, a trademark is defined as “any word, name, symbol, or device or any combination thereof” used by any person “to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” The holder of a registered trademark can file a trademark infringement claim against any person who, without the registered trademark holder’s consent, (1) uses any reproduction, counterfeit, copy, or colorable imitation of a registered mark; (2) in commerce; (3) in connection with the sale, offering for sale, distribution, or advertising of any goods or services; (4) *where such use is likely to cause confusion, or to cause mistake, or to deceive.* 15 U.S.C. § 1114(1) (emphasis added); *see also* 15 U.S.C. § 1125(a) (“Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which . . . is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.”)

The central element of a claim for trademark infringement is the “likelihood of confusion.” When determining whether there is a likelihood of confusion between two marks, courts use several factors derived from a 1961 case, *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492 (2d Cir. 1961). Generally, these factors include the following considerations::

- **Strength of the mark.** The stronger or more distinctive the first user’s mark, the more likely the confusion.
- **Similarity of the marks.** The more similarity between the two marks, the more likely the confusion.
- **Similarity of the products or services.** The closer the goods or services, the more likely the confusion.
- **Overlap in trade channels, distribution and marketing.** The more overlap between the trade channels and marketing of the products, the greater the likelihood of confusion.
- **Intent in adopting the mark.** The second user’s intent in adopting the mark.
- **Evidence of actual confusion.** Actual confusion is not required, but it can be strong evidence if it is present.
- **Sophistication of the buyers.** The degree of care likely to be used by consumers when making purchasing decisions.

No single factor controls, and different factors may be entitled to more weight in different cases.

Strength of the Trademark:

Marks are generally classified according to increasing levels of distinctiveness: (a) generic; (b) descriptive; (c) suggestive; (d) arbitrary; or (e) fanciful. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992). Generic marks are actually not entitled to protection as they are incapable of serving as a source identifier. One court explained the levels of distinctiveness as follows:

At one end of the spectrum, generic marks refer to the genus of which the particular product is a species, such as ‘bread’ or ‘door,’ and are not registerable as trademarks. At the other end of the spectrum are arbitrary marks—actual words with no connection to the product—such as Apple computers and Camel cigarettes, and fanciful marks—made-up words with no discernable meaning—such as Kodak film and Sony electronics that are inherently distinctive and therefore receive maximum trademark protection. In the middle are descriptive marks, which describe the qualities or characteristics of a good or service and only receive protection if they acquire secondary meaning, and suggestive marks, which require a consumer to use imagination or any type of multistage reasoning to understand the mark’s significance and automatically receive protection.”

Fortune Dynamic, Inc. v. Victoria’s Secret Stores Brand Management, Inc., 618 F.3d 1025, 1032-33 (9th Cir. 2010) (citations, quotation marks and formatting omitted).

In determining the likelihood of confusion between two marks, the court determines where the first user’s mark falls on the spectrum to evaluate how much protection to afford the mark, and consequently, how likely a consumer is to associate the junior user’s mark with the products or services of the first user’s mark.

Similarity of the Trademarks:

As a general rule, marks must be compared in their entirety, including appearance, sound, connotation and commercial impression. In assessing commercial impression, courts consider marks as they appear in actual use on, for example, actual products, catalogs or in advertising. Determining the similarity of two marks may require comparison of each element of each mark, but ultimately, the court must determine whether the overall impression of the marks are the same or similar. Thus, the use of identical, even dominant, words in common does not automatically mean that two marks are similar. *General Mills, Inc. v. Kellogg Company*, 824 F.2d 622, 627 (8th Cir. 1987); *see also Luigino’s, Inc. v. Stouffer Corp.*, 170 F.3d 827, 830 (8th Cir. 1999).

Another way that users can distinguish between two similar marks is the use of a top brand that is emphasized in the marketing of the products, also known as a house mark. *See, e.g., ZW USA, Inc. v. PWD Sys., LLC*, 208 F. Supp. 3d 1025, 1051-52 (E.D. Mo. 2016) (no likelihood of confusion despite direct competition between the relevant products because defendant used its house mark prominently and repeatedly in connection with the product and the plaintiff’s mark was weak as applied to the relevant goods); *Gen. Mills, Inc.*, 824 F.2d at 627 (no likelihood of confusion based in part on the prominent use of house marks on both parties’ products).

Similarity and Relatedness of the Products or Services:

Courts consider whether the goods or services offered under the two marks are similar or related. The courts use a sliding scale when applying this analysis—the closer the relationship between the goods or services, the less similar the mark needs to be to support a finding of a likelihood of confusion. It is important to note that the protection afforded to a trademark owner may extend to related goods. For example, a trademark for automotive parts may extend to tires because they are closely related to the automobile industry. The courts consider whether a consumer would reasonably conclude that the goods came from the same source. The more widely known the use of the mark in commerce, the more likely consumers are to believe the products or services are an extension of the original products or services offered.

Overlap in Trade Channels, Distribution, Marketing, Customers, etc.

The courts also consider the similarity of the advertising and distribution channels, as well as the targeted consumers. If the first user only sells its products via wholesale distributors, and the mark is not well-known to the consumer at retail, the court is less likely to weigh this factor in favor of the first user. On the other hand, if the products or services are offered through the same trade channels, and have similar customers, the courts are more likely to weigh this factor in favor of a likelihood of confusion.

Alleged Infringer's Intent in Adopting the Trademark:

Although the intent of the second user in adopting the mark may be relevant, it is not a requirement to prove bad faith or improper motive to succeed on a claim of infringement. If there is evidence that the first user intended to adopt a similar mark to trade upon the goodwill of the first user, then this factor will likely weigh in favor of a finding of confusion because the attempt to create confusion is usually successful. On the other hand, this factor may be neutral or weigh against a finding of confusion if the second user has a reasonable explanation for its choice of the mark for the product or service.

Evidence of Actual Confusion, or Lack thereof:

Although not essential, proof of actual confusion is relevant to an ultimate finding of likely confusion. *General Mills*, 824 F.2d at 628; *see also Sensient Techs. Corp. v. SensoryEffects Flavor Co.*, 636 F. Supp. 2d 891, 901 (E.D. Mo. 2009), *aff'd*, 613 F.3d 754 (8th Cir. 2010) (no evidence of actual confusion presented, granting defendant summary judgment). This can be particularly compelling if the parties have actual instances showing that consumers are confused. On the other hand, it can be equally compelling to show that the parties have co-existed for a period of time and no instances of confusion have occurred to suggest that confusion is not likely. Some parties commission a survey to determine whether consumers are or will be confused. Courts have long-recognized an appropriately designed survey as reliable evidence of likely confusion in cases such as this. *Woodsmith Pub. Co. v. Meredith Corp.*, 904 F.2d 1244, 1249 (8th Cir. 1990) (although “the absence of a consumer survey [is] not per se fatal,” “[s]urveys are probably the most accurate evidence of actual confusion[.]”)

Sophistication of the Buyers:

Another factor in the court's analysis is the degree of care likely to be taken by a consumer when purchasing the item in question. The degree of care exercised by the consumer varies according to the purchase. This takes into account the price of the product or service, the type of product or service, and the conditions present when the consumer is buying the product or service.

Courts assume that the higher the price of the product or service, the more careful the consumer will be when making the purchase. The opposite is also true. A lower priced item with a similar mark may not garner enough attention from the consumer to allow the consumer to differentiate the products, and thus create a greater likelihood of confusion. The assumption is that less expensive items are purchased more frequently and less care is taken in the decision-making process. Thus, the greater the price of the product or service, the more showing of similarity is required to justify the likelihood of confusion. The courts also take into account the actual sophistication of the usual buyers. If the market for the product consists of professionals such as lawyers, physicians, or engineers, then it is less likely that these buyers will be confused by different brands because they have superior knowledge of the products or services.

Finally, the courts consider the circumstances surrounding the purchase. Courts evaluate the behavior of the buying public when purchasing this item, asking questions such as are consumers likely to do research on the products or services before purchase or is there a middleman such as a salesperson that interacts with the consumer prior to purchase. For example, the purchase of gum at the checkout line requires less scrutiny by the consumer than the purchase of an automobile at a dealership. In sum, courts attempt to stand in the shoes of the consumer to evaluate the consumer's behavior under normal buying conditions.

Conclusion:

The analysis of the likelihood of confusion is not a scorecard of how many factors weigh in favor of confusion and against, but instead is a holistic review of the factors in each case. If the marks are nearly identical, but the trade channels are different and the buying public exercises great care in making the purchase, the court is likely to find that there is no likelihood of confusion. On the other hand, if the marks are similar but not identical, but the goods are similar and the trade channels are similar, even if the product sells for a higher price, the court is likely to find the likelihood of confusion.

Each case is decided according to its own facts, which underscores the importance of a strong advocate. Trying trademark infringement cases to a jury can be a challenge because jurors do not understand the nuances of trademark law, and thus are likely to believe any similarity in the marks has the potential for confusing the consumer. There is a widespread misconception that a registered trademark gives the owner the right to prevent others from using the mark in any form, but in reality, it only allows the owner to prevent the use of the same or similar marks *if there is a likelihood of confusion*. This is the challenge of a jury trial on these issues.