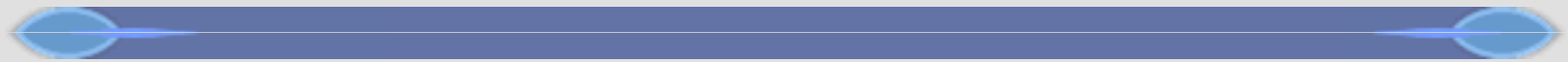


LIKELIHOOD OF CONFUSION BEFORE THE USPTO AND BEYOND



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THE ROLE OF LIKELIHOOD OF CONFUSION IN THE U.S. TRADEMARK REGISTRATION PROCESS

- “Likelihood of confusion” is the standard used by the United States Patent and Trademark Office (USPTO) when issuing refusals to register.
- Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), provides the statutory basis for a refusal to register based on likelihood of confusion.

- *No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the Principal register on account of its nature unless it –*

(d) consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.... 15 U.S.C. § 1052(d).

- Likelihood of confusion depends upon whether the purchasing public would mistakenly believe that the applicant's goods or services originate with, are sponsored by, or are in some way associated with the goods sold under a cited registration or trademark. *McCarthy on Trademarks 23:78; 23-281.*

- During the *ex parte* examination of a trademark application, a likelihood of confusion refusal is based on the Examining Attorney's conclusion that the applicant's mark, as used on or in connection with the relevant goods or services, so resembles a registered mark as to be likely to cause confusion.

- Once an application is filed in the U.S. trademark office, the assigned Trademark Examining Attorney searches the Office Register for existing registrations or pending applications for confusingly similar marks.

- The Examining Attorney does not search the Internet, state trademark or other databases. Determination is based solely on a search of USPTO records of registered marks and pending applications.

In re E.I. du Pont de Nemours & Co.

When evaluating potential for likelihood of confusion, the Examining Attorney takes into account the factors set forth in the *du Pont*:

1. The similarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
2. The similarity and nature of the goods and services as described in an application or registration or in connection with which a prior mark is in use;
3. The similarity or dissimilarity of established, likely-to-continue trade channels;
4. The conditions under which and buyers to whom sales are made, *i.e.* "impulse" vs. careful, sophisticated purchasing;
5. The fame of the prior mark (sales, advertising, length of use);
6. The number and nature of similar marks in use on similar goods;
7. The nature and extent of any actual confusion;
8. The length of time and conditions under which there has been concurrent use without evidence of actual confusion;
9. The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark);
10. The market interface between applicant and the owner of a prior mark;
11. The extent to which applicant has a right to exclude others from use of its mark on its goods;
12. The extent of potential confusion, *i.e.*, whether *de minimis* or substantial; and
13. Any other established fact probative of the effect of use.

***In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. at 567**

- In *ex parte* examination, likelihood of confusion analysis usually focuses on the first two factors, the similarity of the marks and the relatedness of the goods/services.
- The other factors listed in *du Pont* may only be considered if evidence relating to such factors is included in the record.

**Other du Pont Factors
Most Relevant in ex
parte Likelihood of
Confusion Analysis
before the USPTO are:**

- The similarity or dissimilarity of established, likely-to-continue trade channels.

- The conditions under which and buyers to whom sales are made, *i.e.*, “impulse” vs. careful, sophisticated purchasing.

- The number and nature of similar marks in use on similar goods.

- It is very important to note that during the examination process, the Trademark Examiner must consider the goods or services as listed in the Registration or pending application. Doubts in such disputes are resolved in favor of the owner of the cited registration.
- Therefore, the fact that the owner of a registration may not be using the mark in connection with the relevant goods or services, or may not be using the mark at all, is not a factor considered by the Examining Attorney.

Goods/Services Association

The goods associated with the application and those of the cited registration or pending application need not be identical to support a finding of likelihood of confusion. The issue is whether the **public** will be confused as to the source of the goods. Further, goods may be related to services. For example:

- TVS for transmitters and receivers of still television pictures held likely to be confused with TVS for television broadcasting services. *Corinthian Broadcasting Corporation v. Nippon Electric Co., Ltd.*, 219 USPQ 733 (TTAB 1983); TMEP § 1207.01(a)(ii).

- STEELCARE INC. for refinishing services for furniture, office furniture, and machinery held likely to be confused with STEELCASE for office furniture and accessories. *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983); TMEP § 1207.01(a)(ii).

- CAREER IMAGE (stylized) for retail women's clothing store services and clothing held likely to be confused with CREST CAREER IMAGES (stylized) for uniforms. *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985); TMEP § 1207.01(a)(ii).

- There is no *per se* rule when deciding the issue of likelihood of confusion. Each case is unique and must be decided based upon the facts of the specific case.
- Examining Attorneys are not bound by prior decisions of other Examining Attorneys for similar marks. Therefore, inconsistent treatment may be given to similar marks.

- The more arbitrary, coined or fanciful a mark is, the more protection it is afforded:

The Google logo, featuring the word "Google" in its characteristic multi-colored font (blue, red, yellow, green, blue, red) with a trademark symbol (TM) to the upper right.The Exxon logo, featuring the word "EXXON" in a bold, red, sans-serif font with a registered trademark symbol (®) to the upper right.The Kodak logo, featuring the word "Kodak" in a bold, red, sans-serif font with a registered trademark symbol (®) to the upper right.

Role of Owner of Registration or Prior Applications

The owner of a registration cited as a basis for refusal is not a party to *ex parte* examination. The role of the owner of a prior registration during examination is limited to:

- 1) Consent to register.
- 2) Providing evidence that no likelihood of confusion will result from registration of the mark.

The Role of Consent Agreements in the Registration Process

- An Applicant that has a prior registration cited as a basis for refusal may attempt to overcome the refusal by obtaining consent from the owner of the cited registration.
- A valid consent agreement must set forth why the parties believe no likelihood of confusion exists as well as arrangements undertaken by the parties to avoid confusion.
- A valid consent agreement is afforded great weight by the U.S. trademark office and is often sufficient to convince the Examining Attorney to withdraw the likelihood of confusion refusal.

TRADEMARK INFRINGEMENT AND LIKELIHOOD OF CONFUSION

- The U.S. trademark office deals only with issues relating to trademark registration. When disputes arise pertaining to trademark infringement outside of the registration process, trademark owners seek redress in court. In addition, an owner or applicant may appeal a decision of the Trademark Trial and Appeal Board in U.S. federal court.

- In determining the issue of trademark infringement, U.S. federal courts will use the same “likelihood of confusion” test provided by the Trademark Act and used by the U.S. trademark office.

Different courts may use slightly different tests, but they are essentially the same factors.



- The strength of the mark.
- The degree of similarity between the two marks.
- The proximity of the products.
- The likelihood that the prior owner will bridge the gap.
- Actual confusion.
- Defendant's good faith in adopting its own mark.
- The quality of defendant's product.
- The sophistication of the buyers.

Polaroid Corp. v. Polarad Electronics Corp., 287 F.2d 492 (2d Cir. 1961)

Common Types of Trademark Infringement

- Use of a federally registered mark, or unregistered mark with priority of use, in connection with sale or advertising.
- Unauthorized use by trademark licensee.
- Alteration of goods or labels bearing trademark.
- Improper use by Distributors or Dealers.
- The issue of trademark infringement of federally registered marks is decided based on whether the defendant's mark is "likely to cause confusion, or to cause mistake, or to deceive." Lanham Act § 32 U.S.C.A. 1114(1).

Use is Everything

- It is not necessary that a mark be registered to bring an action for trademark infringement in U.S. courts. The owner of an unregistered mark may bring an action for trademark infringement in U.S. courts if they have used the mark in commerce in connection with goods or services and have priority of use. Priority of actual use in commerce gives rise to common law trademark rights.

- Trademark infringement for unregistered marks is governed by Lanham Act § 43(a) which provides protection for an unregistered mark if use of a junior mark “is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association” with the senior user.
- The Trademark Act does not require a plaintiff to show intent to infringe on the part of the defendant in order to show trademark infringement. Good faith is not a defense to trademark infringement. However, bad faith or a showing of intent to confuse customers is relevant and can strengthen a claim of trademark infringement.



®

LOUIS VUITTON

*Louis Vuitton Malletier S.A. v. Haute Diggity Dog LLC,
464 F. Supp. 2d 495 (E.D. Va. 2006), aff'd, 507 F. 3d
252 (4th Cir. 2007)*

Remedies for Trademark Infringement

- Injunction – Upon a showing of trademark infringement, the trademark owner can obtain a permanent injunction to prevent the infringer from using the mark, or any confusingly similar variation thereof, in connection with the relevant goods or services.
- Monetary damages – Normally in the form of profits of defendant. Plaintiff need only prove amount of defendant's sales. Actual damages, such as sales loss, or harm to reputation and goodwill are hard to prove as the plaintiff must show that these losses would not have occurred but for the defendant's conduct.
- Treble damages – In rare cases, the court may award treble damages where infringement was malicious or intentional or when it is shown that the defendant engaged in counterfeiting.
- Destruction of Infringing Products – Defendant must destroy goods bearing infringing mark.
- Attorney's fees – Only awarded in exceptional cases (e.g., malicious conduct, fraudulent conduct, willful conduct, etc.)

Thank You. Questions?

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