*This is your Release #11 (November 2018)*

# Likelihood of Confusion in Trademark Law

## *Second Edition*

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In this release to *Likelihood of Confusion in Trademark Law*, Richard Kirkpatrick updates and expands the treatise, including a new addition to the color illustrations in the appendix and new case law integrated into the text throughout. Among the topics addressed are the following:

**PTO actions:** An *inter partes* case in district court litigation in which the PTO was not a party does not bind the PTO in a later *ex parte* proceeding (*In re FCA US LLC*). See § 1:8.5, at note 213.1.

**Registration—description of the goods:** The TTAB in *In re Solid State Design Inc*. stated that "where the goods in an application or registration are broadly described, they are deemed to encompass 'all the goods of the nature and type described therein.'" The Board "lack[s] the authority to read limitations into the identification." See § 2:8, at note 159. The *Solid State* decision also commented on how some terms will be understood in identifications of products and services: the term "namely" is clearly limiting, while "primarily" leaves open the legal possibility of other channels and classes of customers. See § 2:8, at note 162.

**Third-party use:** There is no strict rule indicating how much third-party use can be said to weaken a mark. In *In re I.Am.Symbolic, LLC*, the TTAB found that five third-party uses, while somewhat probative, were insufficient to "show that customers . . . have been educated to distinguish between different . . . marks on the basis of minute distinctions." In *In re FabFitFun, Inc*., the Board determined that ten third-party uses plus a dictionary definition of "smokin' hot" made the mark "somewhat weak" for cosmetics. See § 3:6.4, at note 224.

*(continued on reverse)*

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**Hashtags:** According to the TTAB, "a hash symbol or the word HASHTAG generally adds little or no source-indicating distinctiveness to a mark" (*In re I.Am.Symbolic, LLC*). See § 4:6, at note 170.1.

**First words of mark as dominant:** In *In re Detroit Athletic Co*., the Federal Circuit stated: "The identity of the marks' initial two words is particularly significant because consumers typically notice those words first." See § 4:9, at note 226.

**Words as dominant over designs:** *In re Aquitaine Wine USA, LLC* involved the TTAB's comparison of a mark consisting of words only, and a mark that included both words and an image, both used for wine. The marks are illustrated in new Appendix A33. Among other things, the TTAB observed: "[W]ords are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods." See § 4:9.2, at note 259.

**Confusion as to source, not as to goods**: In *In re Aquitaine Wine USA, LLC,* the TTAB reiterated the principle that "the issue is not whether purchasers would confuse the goods, but whether there is a likelihood of confusion as to the source of the goods . . . and the relevant inquiry is not whether such consumers can tell the wines apart but whether they are likely to mistakenly perceive that such different wines emanate from a single source." See § 5:3, at note 29.

**Evidence of actual confusion—ex parte proceedings:** Applicants faced with an existing registered mark sometimes contend that they have no evidence of any actual consumer confusion. However, in *In re FCA US LLC*, the TTAB observed: "Generally, in an *ex parte* proceeding a lack of evidence of actual confusion carries little weight, because the cited registrant is not a party to the proceeding and the typical contentions of the applicant's witnesses, to the effect that they are not aware of any instances of actual confusion, tell only one side of the story and are often uncorroborated." See § 7:7, at note 130.

For this release, the **Table of Cases** and the **Index** have been updated.

# FILING INSTRUCTIONS

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