

This is your Release #12 (May 2019)

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 new additions to the color illustrations in the appendix and new case law integrated into the text throughout. Among the topics addressed are the following:

Post-sale confusion: In *Yellowfin Yachts, Inc. v. Barker Boatworks, LLC*, the Eleventh Circuit indicated that that sophistication of customers may cut against post-sale confusion. See § 1:7, at note 161.

Multiple factor test: Addressing the issue for the first time, the D.C. Circuit listed the following factors to be considered in assessing likelihood of confusion: “the strength of the mark, the similarity of the marks, the proximity of the goods, the similarity of the parties’ marketing channels, evidence of actual confusion, the defendant’s intent in adopting the mark, the quality of the defendant’s product, and the sophistication of the buyers” (*American Society for Testing & Materials v. Public.Resource.Org, Inc.*). See § 2:4, at note 56.1.

Registrability proceedings: As noted by the Federal Circuit in *Zheng Cai v. Diamond Hong, Inc.*, TMEP 807.14(e)(i) provides: “If a mark is initially depicted in a black-and-white special form drawing in which no color is claimed, the drawing is presumed to contemplate the use of the mark in any color, without limitation.” See § 2:8, at note 171.1.

Effect of registration: A Principal Register registration presumptively establishes the validity or distinctiveness of the registered mark for the registered goods or services. In *Converse, Inc. v. International Trade Commission*, the Federal Circuit said the presumption applies as of the date of registration, not before. See § 3:7, at note 265.1.

(continued on reverse)

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Similarity of the marks: In *Sturgis Motorcycle Rally, Inc. v. Rushmore Photo & Gifts, Inc.*, the Eighth Circuit observed that if “the purportedly infringing mark appears confusing or deceptive on its face, and relevant consumers do not bring to their purchasing decisions atypical or specialized knowledge, a visual inspection might represent a bare-bones way of proving likely confusion.” See § 4:1, at note 3.

Comparing the dominant portions of marks: The Federal Circuit explained that “[t]he identity of the marks’ initial two words is particularly significant because consumers typically notice those words first” (*In re Detroit Athletic Co.*). See § 4:9, at note 223.

Wholesale versus retail: Confusion is not likely where the marks compared are used at the wholesale level rather than the retail level; according to the Sixth Circuit, the ultimate consumer will ordinarily not know of or be confused by the wholesaler’s name (*Sterling Jewelers, Inc. v. Artistry Ltd.*). See § 5:12.6, at note 200.

New color illustrations of trademark and trade dress infringement cases: The release expands Appendix A with illustrations from *Alliance for Good Government v. Coalition for Better Government* (logos of civic organizations, see Appendix A34); *Zheng Cai v. Diamond Hong, Inc.* (tea, see Appendix A35); and *Kodiak Cakes v. Continental Mills* (pancake mixes, see Appendix A36).

For this release, the **Table of Cases** has been updated.

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