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"A Focus on Initial Interest Confusion, Post-Sale Confusion and Related Strategies"

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Ronald D. Coleman
Goetz Fitzpatrick LLP
New York City
Author of the Likelihood of Confusion blog at
www.likelihoodofconfusion.com

INITIAL INTEREST CONFUSION

"You've probably never heard of the Initial Interest Confusion Doctrine. You probably don't want to hear about it now. You probably should turn the page. But let's face it, even reading this drivel is better than drafting that motion for summary judgment that's hanging over your head. So sit back and relax. It's almost quitting time anyway."

—JONATHAN PINK

July 6, 2005; Found at
http://www.ipfrontline.com/depts/article.asp?id=4697&deptid=4

Per the same article:

- That some courts have found infringement under this doctrine without an analysis under the multi-faction test is a major departure from traditional trademark law.
- The court's reasoning is encapsulated in its oft-quoted analogy about one video store putting up a billboard that misdirects customers by using the name of its more popular competitor, Blockbuster.
- You see: Blockbuster Video, *this exit*. Relieved, you get off, and find… There is no Blockbuster Video. Only a Hollywood Video store!!
- Despite the fact that you *know* Hollywood Video is not Blockbuster's, the intentional misdirection which resulted in you going there (rather than continuing your search for Blockbuster) caused a "trademark injury."

"This ignores the real-life difference between distraction and outright hijacking. Is there any **confusion** as to the source or sponsorship? Is this hijacking or merely distraction? "

When divorced from the multi-factor test for determining a likelihood of confusion, it becomes easy to find infringement because the Initial Interest Confusion Doctrine lacks any vigorous evaluative standard for assessing whether the conduct amounts to trademark infringement.

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"Secondly, the Initial Interest Confusion approach is a departure from the core principal of trademark law because it finds infringement where there is only a fleeting confusion, which is dispelled before any purchase. What is the policy justification for finding infringement where the consumer is not confused at the time of purchase? Isn't more information, and competition between vendors, in the consumer's best interest?"

Until clear policy and evaluative standard are articulated, the Doctrine can only lead to problems.

"And worst of all the Initial Interest Confusion Doctrine is totally unnecessary. The Lanham Act clearly spells out what constitutes trademark infringement, and what the plaintiff must prove in order to prevail on an infringement claim. See 15 U.S.C. §§ 1114(1)(a), 1125(a)(1)."

Certainly, an application of the traditional multi-factor test would provide a good starting point to determine whether there is a likelihood of confusion in the context of initial interest confusion, just like in a traditional infringement analysis

POST SALE CONFUSION

"Post-sale-confusion doctrine. . . applies when allegedly improper use of protected trade[mark] on a lower-quality [non-genuine] product diminishes the reputation of the holder of the rights to that [mark]."

—GIBSON GUITAR CORP. *v.* PAUL REED SMITH GUITARS, LP

U.S. Court of Appeals for the Sixth Circuit, September 12, 2005

Gibson argues that, taken together, the initial-interest-confusion and post-sale confusion doctrines should be extended to include something that we can only describe as a "smoky-bar theory of confusion."

Initial-interest-confusion doctrine, which we have already rejected on the facts of this case, applies when allegedly improper use of a trademark attracts potential purchasers to consider products or services provided by the infringer.

Post-sale-confusion doctrine, which we have also rejected on the facts of this case, applies when allegedly improper use of protected trade dress on a lower-quality product diminishes the reputation of the holder of the rights to that trade dress.

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In the smoky-bar context, however, Gibson does not suggest that consumer confusion as to the manufacturer of a PRS guitar would lead a potential purchaser to consider purchasing a PRS, rather than a Gibson, or that Gibson's reputation is harmed by poor-quality PRS guitars. Rather, Gibson argues that this confusion occurs when potential purchasers see a musician playing a PRS guitar and believe it to be a Gibson guitar.

In the context of guitar sales, initial interest confusion is of real consequence. Guitar manufacturers know that they can make sales by placing their guitars in the hands of famous musicians. On a distant stage, a smoky bar, wannabe musicians see their heroes playing a guitar they then want.

As Gibson concedes that PRS produces high-quality guitars, we do not believe such an occurrence could result in confusion harmful to Gibson. If a budding musician sees an individual he or she admires playing a PRS guitar, but believes it to be a Gibson guitar, the logical result would be that the budding musician would go out and purchase a Gibson guitar. Gibson is helped, rather than harmed, by any such confusion.

SOAP BOX TIME

The main reward for a great, original product is a successful **business** based on that product. Intellectual property notwithstanding, the best way to protect most great ideas is by consistently excellent execution, high quality, responsive customer service, continued innovation and overall staying ahead of the competition by delivering more value.

Absent the rare circumstance of an entire industry dedicated to counterfeits, à la Vuitton, if an enterprise can't fathom protecting its value proposition without some kind of gaudy trademark protection, ultimately something has to give.

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Thanks for having me!

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