

## Trademark Infringement

Likelihood of confusion is the central inquiry in a trademark infringement case. Ultimately, the question is “whether there is a ‘likelihood of confusion’ on the part of consumers between the names and symbols used by the two parties.” *Freedom Sav. & Loan Assn. v. Way* (11<sup>th</sup> Cir., 1985) 757 F.2d 1176, 1179, *cert denied* 474 U.S. 845. Further, Section 32(1) of the Lanham Act, 15 U.S.C. Section 1114(1), governs lawsuits for infringement of a federally registered trademark. A defendant is liable for infringement if, without consent of the registrant, he uses “in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark” which “is likely to cause confusion, or to cause mistake, or to deceive.” *John H. Harland Co. v. Clarke Checks, Inc.* (11<sup>th</sup> Cir., 1983) 711 F.2d 966, 972.

Of course, the burden of proof is on the plaintiff who must show by a preponderance of the evidence that an appreciable number of ordinarily prudent purchasers are likely to be confused between the marks. And “likelihood” does not mean a mere possibility of confusion, but rather a probability that confusion will occur. In determining the likelihood of confusion, most courts take into consideration trademark survey evidence, which can be relatively expensive, and consider the following factors:

- The strength of plaintiff’s mark;
- The degree of similarity between plaintiff’s and defendant’s marks,
- The proximity of the products or services,
- The likelihood that plaintiff will bridge the gap,
- Defendant’s good faith in adopting the mark,
- Evidence of actual confusion;
- The sophistication of the buyers; and
- The quality of defendant’s products or services.

These are commonly known as “the *Polaroid* factors,” having derived from the Federal court case of *Polaroid Corp. v. Polarad Elecs. Corp.* (1961) 287 F.2d 492,495, *cert. denied*, 368 U.S. 820.

### KEY CONCEPTS

- 1 Trademarks are protected by both state statutory law and judicial decisions, often called the common law, and the Federal Lanham Act which controls the registration and enforcement of trademarks at the Federal level.
- 2 A jury decides whether or not there is actual confusion or a “likelihood of confusion.”
- 3 Most trademark infringement trials involve expensive consumer survey evidence.

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*“In trademark infringement lawsuits, ‘actual confusion’ is the Holy Grail. Sufficient proof of actual confusion singlehandedly can win an infringement case..”*

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