
Multifactors, Multiconfusion? Refining “Likelihood of Confusion” Factors for Reverse-Confusion Trademark Infringement Claims To Achieve More Consistent and Predictable Results

“I would be most reluctant to accept an approach that calls on the district judge to throw a heap of factors on a table and then slice and dice to taste. Although it is easy to identify many relevant considerations . . . a court’s job is to reach judgments on the basis of rules of law rather than to use a different recipe for each meal.”¹

I. INTRODUCTION

On the surface, trademark law protects trademarks, defined as any “word, logo or package design, [or some combination thereof,] used by a manufacturer or merchant to identify its goods [or services] and distinguish them from others.”² Typical trademark infringement cases involve a “senior” trademark owner seeking to prohibit a subsequent, “junior” user from using the same or similar mark.³ On a deeper level, however, trademarks also serve as objective,

1. *Reinsurance Co. of Am., Inc. v. Administratia Asigurarilor de Stat*, 902 F.2d 1275, 1283 (7th Cir. 1990) (Easterbrook, J., concurring).

2. JANE C. GINSBURG ET AL., *TRADEMARK AND UNFAIR COMPETITION LAW* 17 (4th ed. 2007) (defining trademarks and their purpose); see *Frequently Asked Questions About Trademarks*, U.S. PAT. & TRADEMARK OFF., http://www.uspto.gov/faq/trademarks.jsp#_Toc275426672 (last modified Apr. 23, 2013) [hereinafter *FAQ*] (defining and distinguishing trademarks from patents and copyrights; explaining filing and obtaining federal protection). Trademarks exist in a variety of ways: trademarks themselves refer to brand names identifying particular goods; “trade dress” refers to the graphics, shape, or color of product packaging; “service marks” are used to identify services; “collective marks” identify the goods or services of various collective organizations; and “certification marks” refer to marks identifying the goods or services that meet particular qualifications. See GINSBURG ET AL., *supra*. The Commerce Clause of the Constitution authorizes trademark protection, on the basis that, like the federal copyright system, it provides a public benefit. See U.S. CONST. art. I, § 8, cl. 3 (giving Congress power “[t]o regulate Commerce with foreign Nations, and among the several States”); see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 & cmts. b-c (1995) (describing historical evolution of trademarks and recognizing them “as an indirect form of consumer protection”).

3. See Deborah F. Buckman, Annotation, *Reverse Confusion Doctrine Under Lanham Trademark Act*, 187 A.L.R. FED. 271, 287 (2003) (explaining forward confusion thrives on junior users “trading off” senior users’ better-established market presence); Molly S. Cusson, Note, *Reverse Confusion: Modifying the Polaroid Factors To Achieve Consistent Results*, 6 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 179, 181-82 (1995) (explaining structure of typical forward-confusion cases). In trademark law, and for purposes of this Note, a “senior” user is the first user to use a trademark, while a “junior” user is one who starts using the trademark after a senior user has adopted and used it. See Cusson, *supra*; Buckman, *supra*. See generally 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 23:10, 26:5 (4th ed. 2013).

goodwill symbols of consumer satisfaction, representing and reinforcing to the public a distinctive good or service.⁴ “In trademark law, the question is always of consumer perception in the marketplace rather than judicial perception in the courtroom.”⁵

The Lanham Act (the Act) governs federal trademark protection, providing for nationwide protection of a trademark against threats, such as the unauthorized reproduction or imitation of a trademark that is “likely to cause confusion, or to cause mistake, or to deceive,” and creates two statutory bases for any confusion-based causes of action.⁶ Under the Act, a trademark is “any word, name, symbol, or device . . . used by a person, or . . . which a person has a bona fide intention to use in commerce . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods”⁷ Case law and the Act identify four categories of terms that reflect a mark’s eligibility for trademark registration and its deserved amount of protection.⁸ Regardless of the amount of protection a mark is

4. See 1 MCCARTHY, *supra* note 3, § 3:2 (presenting public policy rationale underlying trademark laws); see also Buckman, *supra* note 3, at 286 (arguing trademarks serve as identifiers of goods’ source rather than property right). Trademark infringement actions, especially in the context of counterfeit goods, is an increasing problem in the United States, with eighty-seven percent of chief brand protection officers of Fortune 1000 companies reporting that the U.S. government is failing to take sufficient protective measures to shield them from copyright and trademark infringement. See CONSERO GROUP LLC, 2013 BRAND PROTECTION & ANTI-COUNTERFEITING DATA SURVEY 2, 4 (2013), available at <http://consero.com/wp-content/uploads/2013/08/Brand-Protection-Strategic-Sourcing-Data-Survey.pdf>.

5. Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CALIF. L. REV. 1581, 1646 (2006).

6. See 15 U.S.C. § 1114 (2012); see also 15 U.S.C. §§ 1051, 1125 (2012). There are two standard ways to refer to the Act’s provisions: either by the Act’s section designations or their corresponding U.S. Code section designations. See GINSBURG ET AL., *supra* note 2, at 332. Section 32(1)(a) of the Act provides for remedies for infringement of registered trademarks, while section 43(a) of the Act is a parallel cause of action applying to unregistered rights, also commonly known as “common law trademark infringement.” GRAEME B. DINWOODIE & MARK D. JANIS, TRADEMARKS AND UNFAIR COMPETITION: LAW AND POLICY 1, 443 (3d ed. 2011) (explaining other common names for section 43 causes of action for unregistered rights); see Lanham Act §§ 32(1)(a), 43(a), 15 U.S.C. §§ 1114, 1125 (2012).

7. Lanham Act § 45, 15 U.S.C. § 1127 (2012); see *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995) (defining trademark “universe” in “broadest of terms”); cf. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 (1995) (“A trademark is a word, name, symbol, device, or other designation, or a combination of such designations, that is distinctive of a person’s goods or services and that is used in a manner that identifies those goods or services and distinguishes them from the goods or services of others.”). The Act protects both registered and unregistered trademarks, but courts will give registered marks the benefit of a presumption of validity. See *Giggle, Inc. v. netFocal Inc.*, 856 F. Supp. 2d 625, 629 (S.D.N.Y. 2012) (discussing scope of protection under Act); see also *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 767-68 (1992) (recognizing spirit of Act protects all persons engaged in commerce from unfair competition). To recover under the Act, a plaintiff must show the trademark is entitled to protection and that the defendant’s use of the same or similar mark has caused a likelihood of confusion in the marketplace. See *Two Pesos, Inc.*, 505 U.S. at 768-69; *Mushroom Makers, Inc. v. R.G. Barry Corp.*, 580 F.2d 44, 47-48 (2d Cir. 1978); *Giggle, Inc.*, 856 F. Supp. 2d at 629; see also David D. Mouery, Comment, *Trademark Law and the Bottom Line—Coke Is It!*, 2 BARRY L. REV. 107, 115-16 (2001) (noting original Act’s focus on common-law goal of protecting consumer from likelihood of confusion).

8. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (creating four

eligible to receive, however, the fundamental question under confusion-based infringement actions is “whether there is any likelihood that an appreciable number of ordinarily prudent purchasers are likely to be misled, or indeed simply confused, as to the source of the goods in question.”⁹

The most common trademark actions are known as forward-confusion cases and involve instances of a junior user infringing upon a senior user, creating an impression that the junior user’s goods are the same goods as the senior trademark holder’s.¹⁰ The law for analyzing forward-confusion cases is well-established among the circuit courts; each circuit, however, has adopted its own individual, multipronged likelihood-of-confusion test for analyzing consumer confusion.¹¹ In recent years, courts have faced a growing trend of reverse-

classes of trademarks). These four classes, first coined in *Abercrombie*, are: generic, descriptive, suggestive, and arbitrary or fanciful. *Id.*; *Two Pesos, Inc.*, 505 U.S. at 768; *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 39 (1st Cir. 1998); *W.W.W. Pharm. Co. v. Gillette Co.*, 984 F.2d 567, 572 (2d Cir. 1993); *Giggle, Inc.*, 856 F. Supp. 2d at 629; *FM 103.1, Inc. v. Universal Broad. of N.Y., Inc.*, 929 F. Supp. 187, 194 (D.N.J. 1996).

9. *Mushroom Makers, Inc.*, 580 F.2d at 47; see Robert C. Denicola, *Institutional Publicity Rights: An Analysis of the Merchandising of Famous Trade Symbols*, 62 N.C. L. REV. 603, 606, 613 (1984) (identifying likelihood of consumer confusion as touchstone of infringement actions). Plaintiffs can prove the likelihood-of-confusion requirement by showing that the defendant duplicated a protected trademark and publicly sold goods bearing it with the knowledge that a generic consumer would identify the goods bearing the plaintiff’s trademark. See Denicola, *supra*; see also *Bos. Prof’l Hockey Ass’n, Inc. v. Dall. Cap & Emblem Mfg.*, 510 F.2d 1004, 1009-10 (5th Cir. 1975) (equating defendant’s recognition that buyers would associate trademark with plaintiff with likelihood of consumer confusion).

10. See Buckman, *supra* note 3, 287-88 (outlining roles of junior and senior users). In a typical forward-confusion claim, a senior user alleges that a junior user is using the senior user’s mark, and thereby trading off of the typically larger and more established senior user’s public image and goodwill. *Id.*; see *Mushroom Makers, Inc.*, 580 F.2d at 48 (noting prior trademark use not entitlement for first user to bar its use by others). Senior users possess two legitimate interests warranting equitable or injunctive relief against junior users: that the senior user may desire to expand his business into the field that the junior user is operating and that the senior user should be able to develop his current business without the “stain and tarnishment which may result from improper trade practices of the junior user.” *Id.* at 49; *Avon Shoe Co. v. David Crystal, Inc.*, 279 F.2d 607, 613 (2d Cir. 1960).

11. See Beebe, *supra* note 5, at 1588-89 (observing distinctions in likelihood-of-confusion tests among circuit courts). Originating from the spirit and text of the Restatement (First) of Torts, four factors are currently common to all circuits’ multifactor tests: similarity of the marks, proximity of the goods, evidence of actual confusion, and strength of the plaintiff’s mark. *Id.* at 1589. See generally Nancy Del Pizzo, Comment, *Developing a Uniform Test for “Reverse Confusion” Trademark Cases in the Sports & Entertainment Industries*, 14 SETON HALL J. SPORTS & ENT. L. 175 (2004) (listing circuit courts’ individual factors). One of the first frameworks developed for forward-confusion cases was the Second Circuit’s eight factor test, known colloquially as the *Polaroid* test. See Del Pizzo, *supra*, at 181-82. Its eight elements are: strength of the plaintiff’s trademark; similarity of the plaintiff’s and defendant’s marks; the proximity of the products; the likelihood that the senior owner will bridge the gap; evidence of actual confusion; the sophistication of the buyers; the defendant’s good faith in adopting its mark; and the quality of the defendant’s product. *Id.* at 183-85; see *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961). Other circuits use variations of the *Polaroid* test and may have fewer or additional elements. See Beebe, *supra* note 5, at 1582 (acknowledging circuits’ use of oft-overlapping multifactor analysis). For example, the Third Circuit balances ten factors, known as either the *Lapp* factors or the *Scott Paper* factors. *Id.* at 1583 n.9; see 5-5 ANNE GILSON LALONDE, GILSON ON TRADEMARKS § 5.02 (2013). Those ten factors are:

- (1) the degree of similarity between the owner’s mark and the alleged infringing mark; (2) the

confusion cases where a senior user is actually the smaller, weaker user, and is faced with a larger junior user poaching a mark that the senior user originally established.¹² While some circuit courts utilize a similar framework for forward-confusion and reverse-confusion cases, only recently have all circuits recognized the reverse-confusion phenomenon, and some have no framework or factors firmly in place to analyze reverse-confusion cases.¹³ This deficiency can encourage parties to file suit and leverage a lack of precedent to their advantage, ultimately leading to diminished economic and judicial efficiency and increased forum shopping.¹⁴

strength of the owner's mark; (3) the price of the goods and other factors indicative of the care and attention expected of consumers when making a purchase; (4) the length of time the defendant has used the mark without evidence of actual confusion arising; (5) the intent of the defendant in adopting the mark; (6) the evidence of actual confusion; (7) whether the goods, though not competing, are marketed through the same channels of trade and advertised through the same media; (8) the extent to which the targets of the parties' sales efforts are the same; (9) the relationship of the goods in the minds of consumers because of the similarity of function; and (10) other facts suggesting that the consuming public might expect the prior owner to manufacture a product in the defendant's market, or that he is likely to expand into that market.

Interpace Corp. v. Lapp, Inc., 721 F.2d 460, 463 (3d Cir. 1983) (citing *Scott Paper Co. v. Scott's Liquid Gold, Inc.*, 589 F.2d 1225, 1229 (3d Cir. 1978)). Alternatively, the Eighth Circuit utilizes a six-factor test to gauge the likelihood of consumer confusion:

(1) the strength of the owner's mark; (2) the similarity between the owner's mark and the alleged infringer's mark; (3) the degree to which the products compete with each other; (4) the alleged infringer's intent to "pass off" its goods as those of the owner; (5) incidents of actual confusion; and (6) the type of product, its costs, and conditions of purchase.

Heartland Bank v. Heartland Home Fin., Inc., 335 F.3d 810, 821 (8th Cir. 2003) (Smith, J., concurring). The Sixth and Ninth Circuits adopted an eight-factor test, commonly known as the *Frisch* factors, reviewing the strength of the plaintiff's mark; proximity or relatedness of goods; similarity of sight, sound, and meaning of the marks; evidence of actual consumer confusion; marketing channels; type of goods and purchaser care; defendant's intent in choosing the mark; and likelihood of product expansion. See *Frisch's Rests., Inc. v. Elby's Big Boy of Steubenville, Inc.*, 670 F.2d 642, 648 (6th Cir. 1982) (citing *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979)). Yet, the Fifth Circuit uses a seven-factor "digits of confusion" analysis: the type of trademark allegedly infringed, the similarity between the two marks, the similarity of the products or services, the identity of the retail outlets and purchasers, the identity of the advertising media used, the defendant's intent, and any evidence of actual consumer confusion. See *Elvis Presley Enters. v. Capece*, 141 F.3d 188, 194 (5th Cir. 1998) (citing *Conan Props., Inc. v. Conans Pizza, Inc.*, 752 F.2d 145, 149 (5th Cir. 1985)).

12. See *Buckman*, *supra* note 3. The concern with reverse confusion is that the public misperceives the more powerful junior user as the source of the smaller senior user. *Id.* Because the junior user is using the same or similar trademark as the senior user, the public may invert its perception of which user is trading off of the other and mistakenly decide that the junior user first used the mark. *Id.*

13. See *Del Pizzo*, *supra* note 11, at 176-77 (explaining reverse-confusion more likely recognized in sports and entertainment litigation context). Because reverse-confusion doctrine involves smaller, weaker users, factors commonly used by circuit courts, such as the Second Circuit's *Polaroid* Factors, are facially inadequate due to the disparity in commercial prowess between plaintiff and defendant. See *id.* at 186; see also *Buckman*, *supra* note 3, at 288 (explaining logic of Tenth Circuit, first federal court to consider reverse confusion, in 1977).

14. See *Del Pizzo*, *supra* note 11, at 203 (calling reverse confusion a failing "cloak of protection");

This Note will first examine the historical development and basic doctrines of general trademark law.¹⁵ Part II.A will describe the goals of trademark protection, analyzing its evolution from a tort-based theory of fraud prevention into a property-based notion of trademark rights; the functions of trademarks; and the underlying intentions of Congress in passing the Act.¹⁶ Part II.B will look at traditional, forward-confusion trademark infringement analysis and protectibility of trademarks.¹⁷ Part II.C will track the development and application of each circuit's multifactor likelihood-of-confusion test that is used to answer the principal question in federal trademark infringement cases: does the defendant's trademark confuse consumers as to the true source of the defendant's product due to its similarity to the plaintiff's mark?¹⁸ Part II.D discusses the development and divergence of reverse-confusion analysis from the more common forward-confusion instances and the current state of the fragmented analytical framework among the circuits.¹⁹ Part III will analyze the inherent difficulties present in the disjointed circuit framework for both forward- and reverse-confusion cases.²⁰ Finally, this Note will advocate for a

Daniel D. Domenico, Note, *Mark Madness: How Brent Musburger and the Miracle Bra May Have Led to a More Equitable and Efficient Understanding of the Reverse Confusion Doctrine in Trademark Law*, 86 VA. L. REV. 597, 646-47 (2000) (arguing for reduction of opportunity for strategic behavior and incentive for questionable lawsuit); see also Beebe, *supra* note 5, at 1594 (noting only 1 out of 331 opinions sampled examines other circuits for precedent).

15. See *infra* Part II.

16. See *infra* Part II.A.

17. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 & cmt. a (1995); *infra* Part II.B.

18. See Beebe, *supra* note 5, at 1582 (alleging multifactor analysis of likelihood of consumer confusion in severe state of disrepair); *infra* Part II.C; see also *Maker's Mark Distillery, Inc. v. Diageo N. Am., Inc.*, 679 F.3d 410, 419 (6th Cir. 2012) (considering eight factors in infringement action); *George & Co. v. Imagination Entm't Ltd.*, 575 F.3d 383, 393 (4th Cir. 2009) (applying nine-factor test); *AutoZone, Inc. v. Strick*, 543 F.3d 923, 929 (7th Cir. 2008) (analyzing seven factors in likelihood-of-confusion action); *Frehling Enters. v. Int'l Select Grp., Inc.*, 192 F.3d 1330, 1335 (11th Cir. 1999) (considering seven factors, placing most weight on type of mark and evidence of actual confusion); *King of the Mountain Sports, Inc. v. Chrysler Corp.*, 185 F.3d 1084, 1089-90 (10th Cir. 1999) (listing six-factor analysis); *Elvis Presley Enters. v. Capece*, 141 F.3d 188, 194 (5th Cir. 1998) (setting forth nonexhaustive seven-factor test); *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769, 774 (8th Cir. 1994) (declining naming factors as "distinct test" but rather considerations in likelihood-of-confusion analysis); *Interpace Corp. v. Lapp, Inc.*, 721 F.2d 460, 463 (2d Cir. 1983) (listing ten factors); *Frisch's Rests., Inc. v. Elby's Big Boy of Steubenville, Inc.*, 670 F.2d 642, 648 (6th Cir. 1982) (applying eight-factor test); *Pignons S. A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 487 (1st Cir. 1981) (applying eight factors to assess likelihood of confusion); *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979) (discussing eight relevant factors); *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973) (considering thirteen factors while recognizing no easy analytical framework for all cases); *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (recognizing circuit's catalogue of factors not exhaustive); Richard L. Kirkpatrick, *Likelihood of Confusion Issues: The Federal Circuit's Standard of Review*, 40 AM. U. L. REV. 1221, 1222 (1991) (providing generally followed list of factors utilized in multifactor tests); Paula B. Mays, *Determining the Likelihood of Confusion in Ex Parte Examination: A Trademark Examining Attorney's Perspective*, 89 J. PAT. & TRADEMARK OFF. SOC'Y 207, 207-08 (2007) (examining DuPont factors); Cusson, *supra* note 3, at 185 (expounding multifactor likelihood-of-confusion test highly subjective and easy to manipulate).

19. See *infra* Part II.D.

20. See *infra* Part III.

more appropriate framework to analyze reverse-confusion cases, based upon modifying—or even eliminating—certain current forward-confusion multifactor schemes that weigh factors considering the commercial strength of the junior user’s mark, the inherent strength or protectibility of the senior user’s mark, and whether the junior user exhibited bad faith more greatly than others.²¹

II. HISTORY

A. Trademark Foundations in Antiquity, the Middle Ages, and English Common Law Influencing the Lanham Act

Using marks to identify and distinguish one’s work originated in antiquity.²² Trademark use began more than 3500 years ago, recorded in archeological artifacts, such as potters’ marks to identify the source of fired clay pots.²³ A potter’s mark, “a scratchy form of commercial signature,” identified the potter with the quality of his craftsmanship to all who saw his work.²⁴ The earliest instance of pottery of discernible origin is found on Chinese pots exhibiting two types of marks identifying the Emperor of the period and the maker of the pottery, and dating to the reign of Chinese Emperor Hoang-To, approximately 2700 B.C., some twelve centuries before the introduction of ceramics to Europe.²⁵

The Hindus are credited with likely influencing the beginnings of European

21. See *infra* Part IV.

22. See FRANK I. SCHECHTER, THE HISTORICAL FOUNDATIONS OF THE LAW RELATING TO TRADEMARKS 11, 19-37 (1925) (articulating earliest origins of trademark use); Mouery, *supra* note 7, at 111-12 (tying historical trademark development to modern era in terms of “quest for profits” in business); Benjamin G. Paster, Note, *Trademarks—Their Early History: Part I*, 59 TRADEMARK REP. 551, 551 (1969) (noting origins of modern American trademark jurisprudence in English common law and Chancery courts). The Bible even indicates instances of trademark use in its account of the building of the Temple during Solomon’s reign by Phoenician skilled builders, and its noting the unique signs of origin on stone blocks painted in vermilion paint by quarry mechanics who prepared stone for building projects. See Abraham S. Greenberg, *The Ancient Lineage of Trade-Marks*, 33 J. PAT. OFF. SOC’Y 876, 876-77 (1951) (noting trademark origins in biblical references, specifically in books of Genesis and Exodus); Paster, *supra*, at 553 & n.13 (recognizing use of distinctive marks present in Biblical books of Kings and Deuteronomy).

23. See 1-1 LALONDE, *supra* note 11, § 1.06 (noting potters’ marks one of earliest uses of trademarks); see also SCHECHTER, *supra* note 22, at 20 (explaining present concept of trademarks symbolizing ownership evolved from medieval rationale underlying using proprietary marks); Thomas D. Drescher, *The Transformation and Evolution of Trademarks—From Signals to Symbols to Myth*, 82 TRADEMARK REP. 301, 309-320 (1992) (tracing historical development of trademarks); Paster, *supra* note 22, at 551-55 (explaining historical use of trademarks in Egyptian, Greek, and Roman societies). See generally Sidney A. Diamond, *The Historical Development of Trademarks*, 73 TRADEMARK REP. 222 (1983).

24. 1-1 LALONDE, *supra* note 11, § 1.06 (2013); see Gerald Ruston, *On the Origin of Trademarks*, 45 TRADEMARK REP. 127, 130 (1955) (detailing Stone Age pottery, jars, with markings buried in tombs of First Dynasty Egyptian Kings). Ruston also posits that animal branding was likely the first commercial use of trademarks. See *id.* at 129.

25. See Greenberg, *supra* note 22, at 878 (describing trademarks found on Chinese pottery); Paster, *supra* note 22, at 552 (explaining use of identifying marks on Chinese pottery).

pottery, demonstrated by the many emblems affixed to Hindu merchandise found throughout the eastern Mediterranean region.²⁶ Even temple excavations at Nineveh and throughout Egypt reveal common building bricks imprinted with names of their supposed manufacturers, often accompanied by additional, intricate pictures indicating the individual brick's maker.²⁷ Moreover, Greek pottery, which typically showed pictorials of the adventures of classical heroes, also bore marks signifying the origin of the pottery on the base of the pots, and almost all Grecian sculptures displayed inscriptions of the sculptors' names.²⁸ In addition to the maker's name, cup handles used at the Ceramicus of Athens often revealed symbolic marks such as oil jugs, bees, and lions' heads.²⁹

Roman relics and everyday objects—including pottery, stone, lead pipes, marble, glassware, bronze instruments, gold and silverware, knives and other iron articles, gems, and even bread—also display various distinguishing inscriptions.³⁰ Scholars infer that these marks signify a level of governmental

26. See Paster, *supra* note 22, at 552. Similarities between Hindu and European symbols are likely due to the considerable amount of commerce between India and Asia Minor occurring from 1200 to 1300 B.C. See *id.* The many emblems affixed to Hindu merchandise found throughout the eastern Mediterranean region highlight this influence, and the marks were often simple picture symbols of the craft, rather than personal or imperial designations. *Id.*

27. See Greenberg, *supra* note 22, at 877 (asserting Nebuchadnezzar used bricks' marks to "perpetuate his mighty name"); Paster, *supra* note 22, at 552-53 (reporting Nebuchadnezzar had his name stamped on every brick of his palace). Scholars suggest that during this period, bricks were fit for construction only after drying for a period of two to five years, and they could be used in a building only after a local magistrate marked them with his seal of approval and attested to the age of the brick. See Edward S. Rogers, *Some Historical Matter Concerning Trade-Marks*, 9 MICH. L. REV. 29, 29 (1910) (explaining Roman bricks marked with either date, consuls' initials, name of maker, or brick-factory owners/lessees). In Egyptian society, bricks stamped with the King's name were used to construct public structures, while those bearing the marks of other "simple functionaries" were used in building private homes or tombs. See SAMUEL BIRCH, *HISTORY OF ANCIENT POTTERY: EGYPTIAN, ASSYRIAN, GREEK, ETRUSCAN, AND ROMAN* 12 (1873).

28. See Paster, *supra* note 22, at 553 (stating mark on base signified origin); see also Rogers, *supra* note 27, at 30 (noting sculptors' marks on sculptures). Ruins of the prehistoric Korakou settlement near Corinth revealed saucers and bowls with potters' marks at least 4000 years old, while published catalogues within the Yale University collection of Greek and Italian vases exhibits potters' factory marks imprinted in the fourth and fifth centuries B.C. See SCHECHTER, *supra* note 22, at 20.

29. See BIRCH, *supra* note 27, at 322, 335 (outlining how potters marked pieces in Ancient Greece); Rogers, *supra* note 27, at 30 (explaining identification marks on Greek pottery). See generally JOHN K. PAPADOPOULOS, *CERAMICUS REDIVIVUS: THE EARLY IRON AGE POTTERS' FIELD IN THE AREA OF THE CLASSICAL ATHENIAN AGORA* (2003) (describing pottery production from Early Iron Age through Athenian Acropolis, noting symbolic markings).

30. See Paster, *supra* note 22, at 553-54. During the Roman Empire, pottery was often inscribed with the date of manufacture and sometimes had the initials or name of the period's consul or the product's maker. *Id.* at 553. Later years of the Roman Empire saw increasing use of names of the owners of estates where the kilns were located, the owners or lessees of factories, and the freedmen or slaves in charge of the production of the products. *Id.* Italian stonecutters' marks appear most frequently in ordinary circumstances, such as on ancient Roman republic pottery, on city walls, on the buildings of the Palatine, and on the walls of Pompeii, but are not found on more pretentious and artistic buildings such as the Colosseum or the Forum. *Id.* Even the bread of Pompeii was stamped with designating seals. *Id.* at 554. As the market for Roman occultists' eye salves grew worldwide, the occultists often stamped the dry salve cakes with the physician's name, the formula for the salve, and the directions for proper use, and placed similar labels on earthen vessels holding liquid medications. *Id.* Cheese makers marked the famed cheeses of Etruscan Luna with a picture of that city, and wine, the "most

regulation aimed at preserving quality workmanship, punishing faulty workmanship, and enhancing personal responsibility for inferior goods.³¹ Not dissimilarly, Mediterranean culture in the sixth- and seventh-centuries B.C. widely used trademark-bearing amphorae in the wine and oil trade, and many of these vessels bore incised marks, or graffiti, on the shoulder or the neck, ranging from full owner's marks or names to single letters or nonalphabetic decorative shapes.³²

In the Middle Ages, artisans widely used trademarks on armor, cloth, cutlery, and pewterware, but definitive trademark law did not develop until much later.³³ Merchants also historically used marks to demonstrate ownership

important [Roman] commodity, . . . was subject to extensive trademark use, [with] the jugs often describing the origin of the grapes, the manufacturer of the wine, [and] the date of the wine's pressing." *Id.* Roman lamps bear numerous inscriptions, such as simple marks of the name of the maker or the place where it was made, the date of manufacture, dedications to deities, or acclamations used at public games and events; manufacture of these lamps has been attributed to slaves. *Id.* at 553-54. Signs of Roman inns and shops also made use of distinguishing slogans: the famous sign of the Elephant Inn of Pompeii read *Hos pitium hic locator triclinium cum tribus lectis et cum (modis)* (an inn with a dining room and with three comfortable couches). *Id.* at 554. Compilations of identifying seals and designs used on Roman ceramics indicate a catalogue of more than 6000 different marks, which were also used to advertise certain products. *Id.* For example, the popular Fortis oil-burning lamps bear such inscriptions as *VTERE* (use this) and *EME* (buy me). *Id.*; see BIRCH, *supra* note 27, at 519 (detailing types of early, simple inscriptions on lamps). See generally SEVEN DESIGNERS LOOK AT TRADEMARK DESIGN (Egbert Jacobson ed., 1952) (highlighting certain fifth-century Roman lamp inscriptions); JACOB LARWOOD & JOHN CAMDEN HOTTEN, *THE HISTORY OF SIGNBOARDS FROM THE EARLIEST TIMES TO THE PRESENT DAY* 2-4 (1908) (detailing variety of signage used in ancient Rome).

31. See Paster, *supra* note 22, at 553; see also Daphne Leeds, *Trademarks—Our American Concept*, 46 TRADEMARK REP. 1451, 1452 (1956) (suggesting ceramic trademarks provided purchaser right of action against potter, thus dissuading faulty workmanship).

32. See 1-1 LALONDE, *supra* note 11, § 1.06. The undersides of many Greek vases of the era were often painted in red with alphabetic characters specifying the names of shippers, and many also contained decorations in the form of spirals, swastikas, and asterisks. See A. W. JOHNSTON, *TRADEMARKS ON GREEK VASES* 1, 2, 51 (1979).

33. See 1-1 LALONDE, *supra* note 11, § 1.06; see also Arthur P. Greeley, Dissenting Report of Mr. Greeley with Reference to the Revision of the Trademark Law, in REPORT OF THE COMMISSIONERS APPOINTED TO REVISE THE STATUTES RELATING TO PATENTS, TRADE AND OTHER MARKS, AND TRADE AND COMMERCIAL NAMES, S. DOC. NO. 56-20, at 89 (2d Sess. 1900) (detailing first suggestion for statutory protection by Samuel Breck to Second Congress for marking sailcloth); Diamond, *supra* note 23, at 239-45 (noting modern versions of old marking customs; late development of Anglo-American laws). See generally SCHECHTER, *supra* note 22 (discussing comprehensive historical treatment of trademark jurisprudence). During the Dark Ages, immediately following the downfall of the Roman Empire, trademark usage by most manufacturers ceased because broad trade markets were not as important. See Leeds, *supra* note 31, at 1452; Paster, *supra* note 22, at 555. The only exception to the decline was an increase in sword blade manufacture, on which the names of the armorers were typically inscribed. See Paster, *supra* note 22, at 555. When trade finally surged again during the Middle Ages, large quantities of guild and municipal legislation regulating the use of marks also occurred. See *id.* at 555-56. Political conditions greatly influenced trademark use, including the disintegration of the feudal system, the establishment of the Hanseatic League in northern Germany for the protection of sea trade, the rise of the free cities which were sovereign and self-directing, and most importantly, the formation of trade and craft guilds throughout Europe; all of these conditions helped shape systems of trade supervision and trademarking that were both discriminating and complex. See *id.* at 556-60. Trade and craft guilds grew from a need to adhere to the obligations of charity, brotherhood, and ritual; and in their strict regulation of the conduct and dealings of its members, it was not unheard of for these guilds to usurp functions of government. See *id.* at 556. Ultimately these guilds were a precursor to modern-day trade unions in their oversight and

of physical goods, much in the way that ranchers use cattle brands to identify their cattle, and using marks to indicate ownership of goods was particularly important for owners whose goods moved in transit, as those marks often allowed owners to claim goods that were lost.³⁴ Representative of the deference to these marks, a statute of Parma, allegedly better tailored and concise than the U.S. Trademark Act, protected against

frauds which are or may be committed upon [guilds and artisans in this state];—that no person in the trade or guild shall use the mark of any other person in such trade or guild, nor place such mark, or a similar one, upon knives or swords; and if any person in such guild has continuously used a mark . . . for ten years, and any other person is found to have used, within one or two years, the same mark or an imitation thereof, whether stamped or formed in any other way, the latter shall not in future be allowed to use such mark . . . under penalty of ten pounds of Parma for each and every offense, and that regardless of any compromise or award of arbitrators which may have been made.³⁵

Even if one loaned a mark to another, the loaner and loanee would be in violation of the public ordinances and good-faith practices of the day.³⁶

The earliest reported case dealing with unauthorized replication of another's mark—the improper use of a clothier's mark—dates back to 1584, but was not widely known until it was discussed in the dictum of the 1618 *Southern v. How*

direction of the trade activities of its members. *See id.* Specifically, each guild promulgated regulations to control the activities of its members, and by compelling each member to use his own distinguishing mark, the guilds strengthened their control of the trade. *See id.*; Rogers, *supra* note 27, at 36. As a rule, when one became a master craftsman, he was required to choose a mark, obliged to use it on all goods he produced, and compelled to retain it his entire life. *See Paster, supra* note 22, at 556. Use of a mark was obligatory, part of the duty to the community, and demanded by the strict social order of craft guilds of the Middle Ages. *See* Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1850 (2007) (explaining guilds' marks indicated collective goodwill of guild, not individual producer's goodwill); Paster, *supra* note 22, at 556 (observing individual guild member's use of mark for lifetime part of duty to guild).

34. *See* McKenna, *supra* note 33, at 1849; *see also* Diamond, *supra* note 23, at 242 (explaining marks used on timber floating downstream). For example, identifying marks enabled merchants to prove their ownership of any goods that were lost and subsequently recovered at sea. *See* McKenna, *supra* note 33, at 1849; *see also* SCHECHTER, *supra* note 22, at 20–21.

35. Rogers, *supra* note 27, at 37 (quoting JOSEF KOHLER, DAS RECHT DES MARKENSCHUTZES (1884)); *see* Paster, *supra* note 22, at 559. Rogers also notes the compactness of the Parma statute as compared with the U.S. Trademark Act. Rogers, *supra* note 27, at 36–37. The reason for the then-regarded “dangerous” ten-year provision, later introduced into the English Trade Marks Act of 1875 as the “old mark” section, and into the U.S. Statute of February 20, 1905 as the “ten[-]year proviso,” is the safe assumption that after a mark has been continuously used for ten years, it will identify the origin of the goods that bear it. *See id.* at 37; *cf.* 15 U.S.C. § 1052(f) (2012) (noting mark used continuously for five years prima facie evidence of mark's distinctiveness). Legislation similar to the Parma Statute appeared in France, Germany, England, and other parts of Italy. *See* Paster, *supra* note 22, at 560; *see also* SCHECHTER, *supra* note 22, at xxvii–xxviii.

36. *See* Paster, *supra* note 22, at 561.

Common Pleas decision, which involved the sale of counterfeit jewels.³⁷ In the most widely cited report of the clothier's case, appearing in *Popham's Reports*, and in the dictum discussion appearing in *Southern v. How*, a reputed clothier—J.G.—brought an action against another clothier—Sandforth—for applying the “same mark to his ill-made cloth on purpose to deceive him.”³⁸ The reliability of Popham's account is repeatedly questioned; however, his characterization of *Southern* and *J.G. v. Sandforth* played a prominent role in early English law.³⁹ Many judges deciding trademark cases in the eighteenth and nineteenth centuries went so far as to rely on Popham's report of *J.G. v. Sandforth* as standing for the proposition that cases based on use of another's mark could be brought as actions sounding in the common-law tort of deceit.⁴⁰ Ultimately, *Southern* demonstrates a “most fragile link between the Middle Ages and the modern commercial law of trademarks,” and signifies that trademarks still remained centered in the guilds and companies rather than

37. See *Southern v. How*, (1618) 79 Eng. Rep. 1243 (K.B.) 1244, Pop. 142, 144; 1-1 LALONDE, *supra* note 11, § 1.06 (noting cited clothier case has “remarkable parallels” to present-day intentional-infringement trademark cases); SCHECHTER, *supra* note 22, at 6-12; McKenna, *supra* note 33, at 1850-51; Paster, *supra* note 22, at 562-63; see also FRANCIS H. UPTON, A TREATISE ON THE LAW OF TRADE MARKS, WITH A DIGEST AND REVIEW OF THE ENGLISH AND AMERICAN AUTHORITIES 10-12 (1860).

38. Paster, *supra* note 22, at 562 n.57; see 1-1 LALONDE, *supra* note 11, § 1.06.

39. See SCHECHTER, *supra* note 22, at 6-12 (outlining English cases relying on Popham's account of *Southern* to establish jurisdiction for trademark cases); McKenna, *supra* note 33, at 1850-51.

40. See Daniel M. McClure, *Trademarks and Unfair Competition: A Critical History of Legal Thought*, 69 TRADEMARK REP. 305, 311 (1979) (asserting trademark protection originated in claims for deceit); McKenna, *supra* note 33, at 1851 (recognizing *Southern's* role in establishing trademark claims stemming from deceit); see also SCHECHTER, *supra* note 22, at 9 (citing early English cases relying on authority of *Southern*). The other reports in addition to Popham's were: (1659) Bridg. J. 125, 123 Eng. Rep. 1248 (C.P.); (1659) Cro. Jac. 468, 79 Eng. Rep. 400 (K.B.); (1676) 2 Rolle 5, 81 Eng. Rep. 621 (K.B.); and (1676) 2 Rolle 26 (K.B.), 81 Eng. Rep. 635. See McKenna, *supra* note 33, at 1851 n.35 (listing other reports relying on same proposition). The report attributed to Popham was not even reported by Popham himself but was included in the section of his collection titled “Some Remarkable Cases Reported by other learned Pens since his death.” See SCHECHTER, *supra* note 22, at 7; Paster, *supra* note 22, at 562 n.57 (describing creation of Popham's report). While some reports make no mention of the clothier's case, others suggest that it was a deceived customer who brought the action rather than the merchant himself: Croke's Report stated that Judge

Dodderidge cited a case to be adjudged 33 Eliz in the Common Pleas: a clothier of Gloucestershire sold very good cloth, so that in London, if they saw any cloth of his mark, they would buy it without searching thereof; and another who made ill cloth put his mark upon it without his privity; and an action upon the case was brought by him who bought the cloth, for this deceit; and adjudged maintainable.

Paster, *supra* note 22, at 562 n.57 (explaining case brought by consumer against alleged infringing clothier cited in *Southern*). The second of *Rolle's Reports* is ambiguous, but it also suggests it may have been the purchaser who brought the case. See *id.* (corroborating Croke's report). Ultimately, the seed from which trademark law grew was the common-law tort of deceit rather than property law. See Robert C. Denicola, *Institutional Publicity Rights: An Analysis of the Merchandising of Famous Trade Symbols*, 62 N.C. L. REV. 603, 605-06 (1984) (“The protection of trade symbols has been founded chiefly on notions of deception and consumer confusion.”). But cf. Daniel M. McClure, *Trademarks and Competition: The Recent History*, 59 LAW & CONTEMP. PROBS., Spring 1996, at 13, 13-16 [hereinafter McClure, *Recent History*] (arguing current confusion-based trademark standard replaced early property rights conception in 1930s).

common law and the courts.⁴¹

The law of trademarks and unfair competition began as a tort theory known as “passing off” or “palming off,” and the major focus of the early courts was the fraudulent intent of the infringing party, rather than the impact on consumers or any right of the “owner” to control a mark as property.⁴² In 1723, Giles Jacob, in his *New Law Dictionary*, maintained that a “mark of goods . . . is what ascertains the Property or Goodness And if one Man shall use the Mark of another, to the intent to do him Damage, Action upon the Case lieth.”⁴³ The beginning of the Industrial Revolution marked a significant expansion in the means of production and distribution, and in the advertising of goods, where trademarks for the first time gained a national significance.⁴⁴ Both the United States and England, however, failed to consider trademarks as assets of value in commerce until the second half of the nineteenth century.⁴⁵

In the first case of its type, Lord Hardwicke in *Blanchard v. Hill* denied a

41. See Paster, *supra* note 22, at 562; see also 1-1 LALONDE, *supra* note 11, § 1.06 (2013) (opining *Sandforth* is “bridge” between medieval guilds’ marks and current trademark jurisprudence). In discussing pre-common-law origins of trademark jurisprudence, Schechter states:

In addition to the law developed by the guilds and companies or, as Stubbs has aptly termed such law, “gild jurisprudence,” we have seen germs of modern trade-mark law in statute law and also in the conciliar law, i.e. the law developed by the King’s Council and the Star Chamber. All three of these sources of modern trade-mark law, and especially “gild jurisprudence,” had by the seventeenth century, made contributions to trade-mark law of much greater significance than that of the common law itself.

SCHECHTER, *supra* note 22, at 125.

42. See 1 MCCARTHY, *supra* note 3, § 5:2 (noting nineteenth-century cases emphasized “element of fraudulent intent . . . over the objective facts of consumer confusion”). The tort of “passing off” is founded in bad faith and deceit, and occurs when one distributes his own goods under the assumption that they are the goods of someone else. See *id.* “In 1842 Lord Langdale wrote: ‘I think that the principle on which both the courts of law and equity proceed is very well understood. A man is not to sell his own goods under the pretence that they are the goods of another man.’” *Id.*; see *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 414 (1916) (expounding laws against passing off protect goodwill embedded in business); Domenico, *supra* note 14, at 599-600 (distinguishing common-law trademark rights founded in tort from modern-day laws grounded in property).

43. See Paster, *supra* note 22, at 564. Interestingly, Blackstone’s *Commentaries* (1766) do not reference trademarks as a type of recognized personal property “by Occupancy,” yet include patents and copyrights among the list of “[t]hings [p]ersonal.” *Id.*

44. See *id.* at 564 (explaining convergence of manufacturing, distribution, and advertising of goods led to need for trademark protection); see also SCHECHTER, *supra* note 22, at 130 (noting post-Industrial Revolution trademark protection effort in United States stemmed from sailcloth and duck industries).

45. See SCHECHTER, *supra* note 22, at 130. Schechter recounts Samuel Breck’s petition to Congress, and Thomas Jefferson—then Secretary of State—issuing his report that recognized “an exclusive right” to use a distinctive mark on one’s manufactured sailcloth, as well as “rendering it penal in others to put the same mark to any other wares.” *Id.*; see Greeley, *supra* note 33, at 89 (discussing recognizing trademark rights in U.S. law). An illustrative example of the increasing value of trademarks to a business was the temporary liquidation of Hostess Brands: the value of its intellectual property portfolio alone, consisting largely of trademarks, was \$134.5 million. See Jeff Bounds, *Hostess’ Intellectual Property Portfolio Worth \$134.5M*, DALL. BUS. J. (Nov. 30, 2012, 1:20 PM), <http://www.bizjournals.com/dallas/blog/2012/11/hostess-intellectual-property.html>.

plaintiff, a playing-card maker, exclusive trademark protection by refusing to grant an injunction to restrain the defendant from using the plaintiff's Mogul stamp on his cards to the prejudice of the plaintiff, on the ground that such an injunction would help the plaintiff achieve a monopoly in playing cards.⁴⁶ In his decision rejecting *Southern*, the Chancellor stated: "[t]he objection has been made, that the defendant in using this mark prejudices the plaintiff, by taking away his customers. But there is no more weight in this, than there would be in an objection to one innkeeper setting up the same sign with another."⁴⁷ The decision in *Blanchard*, however, specifically distinguished the plaintiff's claim from the clothier's claim referenced in *Southern*; unlike the plaintiff in *Blanchard*, who claimed the exclusive right to use his Mogul mark without qualification, the clothier based his case on the defendant's "fraudulent design, to put off bad cloths by this means, or to draw away customers from the other clothier."⁴⁸

In 1870, Congress enacted the first statute providing for federal trademark registration.⁴⁹ In the 1879 *Trade-Mark Cases*, the Supreme Court essentially found the 1870 Act unconstitutional, commenting that trademark rights—existing at common law regardless of whether the trademark had been registered—were "a property right for the violation of which damages may be recovered in an action at law."⁵⁰ In response to the *Trade-Mark Cases*, Congress enacted a statute providing for registration of marks used in commerce with foreign nations and Indian tribes; not until 1905, however, did Congress enact an additional statute permitting registration of marks used in interstate commerce, and limiting registration of marks to those that are inherently distinctive.⁵¹ Today, the substantive rights afforded to an

46. See McKenna, *supra* note 33, at 1852; Paster, *supra* note 22, at 564 (discussing *Blanchard v. Hill* holding). Lord Hardwicke also refused to find the plaintiff had the sole right to the stamp, having appropriated it to himself in conformance with the charter granted to the card makers' company by King Charles I. See McKenna, *supra* note 33, at 1852; Paster, *supra* note 22, at 564. An ongoing battle between Parliament and the King grew from royal charters that granted exclusive rights to card makers. See Paster, *supra* note 22, at 563-64; see also McKenna, *supra* note 33, at 1852-53 (distinguishing plaintiff's exclusive, monopoly right in *Blanchard* from passing-off theory in *Southern*); Thomas B. Nachbar, *Monopoly, Mercantilism, and the Politics of Regulation*, 91 VA. L. REV. 1313, 1333-40 (2005) (discussing struggle between Parliament and Crown over ability to grant exclusive privileges).

47. SCHECHTER, *supra* note 22, at 134; see 1-1 LALONDE, *supra* note 11, § 1.06 n.21 (discussing imitation of signs and signboards fairly common even until early eighteenth century).

48. See *Blanchard v. Hill*, (1742) 2 Atk. 484, 485; McKenna, *supra* note 33, at 1852-53.

49. See DINWOODIE & JANIS, *supra* note 6, at 37-38 fig.1-1 (providing chronological development of U.S. trademark law).

50. See *id.* at 37-38 fig.1-1 (explaining unconstitutionality of 1870 Act); see also *Trade-Mark Cases*, 100 U.S. 82, 97-98, 99 (1879) (holding 1870 Act unconstitutional because remedies not restricted to trademarks used in foreign or interstate commerce).

51. See DINWOODIE & JANIS, *supra* note 6, at 37 fig.1-1, 48-49. The two seminal trademark cases, *Two Pesos* and *Abercrombie*, discuss marks deemed inherently distinctive. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 10 (2d Cir. 1976).

unregistered trademark owner under section 43(a) of the Act are largely coextensive with those afforded to owners of registered marks who bring actions under section 32 of the Act.⁵²

“[O]n or about December 1910[,] human character changed.”⁵³ While the older, production-oriented agrarian culture of small entrepreneurs had been the norm prior to the turn of the century, with the Industrial Revolution came a revolutionary shift that favored larger businesses and promoted consumption of tangible goods among the general public.⁵⁴ With the rise of a corporate-dominated society, two main justifications supporting trademark protection emerged: “protect[ing] the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get,” and ensuring that “where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats.”⁵⁵ Additionally, developing case law and economic scholars began advancing strong arguments for economic efficiency through trademark protection, which many courts, including the Supreme Court, started utilizing.⁵⁶

52. See S. REP. NO. 79-1333, at 3, 4 (1946). Actions for infringement of an unregistered trademark are often noted as actions for unfair competition. *Id.* at 4. The advantage of registering a trademark is that registration creates a presumption of validity in the registered mark and is prima facie evidence that the registrant actually owns the mark and has an exclusive right to use the registered mark in or on goods or services within commerce. See DINWOODIE & JANIS, *supra* note 6, at 306-07. Registering a mark with the United States Patent and Trademark Office (USPTO) gives the registrant of a mark certain benefits, including: public notice that the registrant owns the mark; public notice of the registrant’s claim of ownership of the mark; the ability to bring legal action regarding the mark in federal court; the ability to prevent importation of foreign goods that infringe the mark; the ability to use the federal registration symbol; and database listing in publicly available and searchable USPTO databases. See *FAQ*, *supra* note 2.

53. VIRGINIA WOOLF, MR. BENNETT AND MRS. BROWN 4 (1924).

54. Jerre B. Swann, Sr., *Dilution Redefined for the Year 2002*, 92 TRADEMARK REP. 585, 586-618 (2002) (tracing shift from agricultural-based society to consumption-oriented society to age of information).

55. S. REP. NO. 79-1333, at 3.

56. See *Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1429-30 (7th Cir. 1985). Judge Easterbrook described the economic benefit that the Chicago School sees in trademarks:

Trademarks help consumers to select goods. By identifying the source of the goods, they convey valuable information to consumers at lower costs. Easily identified trademarks reduce the costs consumers incur in searching for what they desire, and the lower the costs of search the more competitive the market. A trademark also may induce the supplier of goods to make higher quality products and to adhere to a consistent level of quality.

Id. at 1429; see William M. Landes & Richard A. Posner, *The Economics of Trademark Law*, 78 TRADEMARK REP. 267, 270-79 (1988) (advancing Chicago School economic theory within trademark law scope). The circuit court also described trademark doctrine in economic terms, such as when analyzing likelihood of confusion, reasoning that “[c]onfusingly similar marks make consumers’ task in searching for products harder.” *Scandia Down Corp.*, 772 F.2d at 1430. Judge Posner also announced “competition is not impaired by giving each manufacturer a perpetual ‘monopoly’ of his identifying mark” if he has chosen a “distinctive” trademark where the available names are “for all practical purposes infinite.” *W. T. Rogers Co. v. Keene*, 778 F.2d 334, 339 (7th Cir. 1985); see also McClure, *Recent History*, *supra* note 40, at 28-33 (noting expanded trademark protection trend because of society and courts growing increasingly politically conservative). Professor

“You can break 6 of the 10 commandments in America, but please, Thou Shalt not Violate the Brand.”⁵⁷ Trademarks are used increasingly to not just identify products, but also to enhance or adorn them, or create new commodities altogether, while simultaneously carrying a significant communicative value and playing a significant role in public discourse.⁵⁸ Businesses often choose trademarks “for their effervescent qualities, and then [inject them] into the stream of communication with the pressure of a firehose by means of mass media campaigns.”⁵⁹ However, the public’s right to use a specific trademark must be balanced against the rights afforded to the trademark’s owner.⁶⁰

William M. Landes and Judge Richard A. Posner advance the Chicago School economic theory because it has the capacity to provide a comprehensive and unifying approach to almost any legal issue in trademark law, reasoning that the function of trademark law is reduced to a single goal of economic efficiency to maximize wealth. See McClure, *Recent History*, supra note 40, at 29-30 (naming Judges Easterbrook and Posner as Chicago School leaders, noting their representative 1985 Seventh Circuit opinions); see also Landes & Posner, supra, at 267.

57. David Brooks, *No Sex Magazines, Please, We’re Wal-Mart Shoppers*, N.Y. TIMES, May 11, 2003, <http://www.nytimes.com/2003/05/11/weekinreview/no-sex-magazines-please-we-re-wal-mart-shoppers.html> (explaining Wal-Mart’s entrenched brand identity with middle-class American values, decision banishing risqué magazines from stores).

58. See Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 961-71 (1993) (questioning role of trademark law protecting marks enhancing or becoming functional part of product). In 1860, Francis Upton published the first comprehensive treatise describing a trademark, and defined a trademark as

the name, symbol, figure, letter, form or device, adopted and used, by a manufacturer, or merchant, in order to designate the goods that he manufactures, or sells, and distinguish them from those manufactured or sold by another; to the end that they may be known in the market, as his, and thus enable him to secure such profits as result from a reputation for superior skill, industry or enterprise.

UPTON, supra note 37, at 9. At present, a trademark is construed to be any “word, name, symbol, [or] device, . . . that is distinctive of a person’s goods or services and that is used in a manner that identifies those goods or services and distinguishes them from the goods or services of others.” RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 (1995); see Lanham Act § 45, 15 U.S.C. § 1127 (2012) (defining trademark); see also *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 413 (1916) (discussing exclusive right to unregistered, common-law trademarks grounded in property rights). This exclusive right includes the “right to the continued enjoyment of [merchant’s] trade reputation and the good will that flows from it, free from unwarranted interference by others.” *Hanover Star Milling Co.*, 240 U.S. at 413. Modern trademarks have evolved from their definition as solely words, names, symbols, or devices that identify a product’s source or origin, to also indicate characteristics about the users of that product, the quality of the product, and have become an “emerging lingua franca.” See Kozinski, supra, at 965-66 (proposing statutory reforms of trademarks as larger parts of language and distinct profitable commodities); see also SCHECHTER, supra note 22, at 19 (noting convergence of law and equity in trademark law; injunctive relief more effective than monetary compensation).

59. See Kozinski, supra note 58, at 973-74 (stipulating sensitive balance exists between First Amendment, communicative qualities of trademark law).

60. See *id.* at 975. Parodies present an intriguing tension between the creator of a symbol, image, or slogan and society’s communicative interests. See *id.*; *Eveready Battery Co. v. Adolph Coors Co.*, 765 F. Supp. 440, 448-50 (N.D. Ill. 1991). For example, can a beer manufacturer run a commercial in which the comedian hawking its product wears a rabbit suit and carries a bass drum? See *Eveready Battery Co.*, 765 F. Supp. at 448-50. The court ultimately approved this parody of Eveready’s Energizer Bunny commercial, holding that the commercial could “keep going, and going . . .” because it created no likelihood of confusion. See *id.* at 442. In contrast, a T-shirt bearing the phrase “Hard Rain Cafe: Seattle” was enjoined because the

Congress enacted the Act in 1946, extending federal trademark protection to marks used in interstate commerce, and in many respects, codifying state common-law trademark principles.⁶¹ The Senate Report accompanying the Act expressly stated that the purpose of the trademark law was to not only protect trademark owners' investments in goodwill, but also to protect the public against deception.⁶² According to the Supreme Court, Congress "intended to make 'actionable the deceptive and misleading use of marks' and 'to protect persons engaged in . . . commerce against unfair competition.'"⁶³ The Act remains the basic trademark statute today and has been amended several times since 1946, with the most comprehensive reform occurring in 1988 and including a substantial revision to trademark-registration procedures.⁶⁴ Today, most cases arise under federal trademark law, but unlike copyright and patent law where Congress has specifically preempted state law, state trademark law endures.⁶⁵

B. Trademark Infringement Analysis and Protectibility

The Act requires proving two factors before liability may attach: first, the mark must merit protection and second, the defendant's use of the same or similar mark has caused a likelihood of confusion in the marketplace.⁶⁶ The

court thought consumers were likely to confuse it with the "Hard Rock Cafe" T-shirt. *Hard Rock Cafe Licensing Corp. v. Pacific Graphics Inc.*, 776 F. Supp. 1454, 1461, 1463-64 (W.D. Wash. 1991). *See generally* *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994) (categorizing commercial parody as fair use under copyright law if it sufficiently transforms original work); Harriette K. Dorsen, *Satiric Appropriation and the Law of Libel, Trademark, and Copyright: Remedies Without Wrongs*, 65 B.U. L. REV. 923, 924-28, 963-64 (1986) (arguing development of tort of "satiric appropriation" impermissibly intrudes upon freedom of expression).

61. *See* Robert C. Denicola, *Some Thoughts on the Dynamics of Federal Trademark Legislation and the Trademark Dilution Act of 1995*, 59 LAW & CONTEMP. PROBS., Spring 1996, at 75, 77-80 ("[T]he Lanham Act codifie[d] the basic common law principles governing both the subject matter and scope of [trademark] protection.").

62. S. REP. NO. 79-1333, at 3 (1946) (explaining underlying rationale of Act).

63. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 767-68 (1992); *see* 15 U.S.C. § 1127; *see also* Buckman, *supra* note 3, at 286-87.

64. *See* DINWOODIE & JANIS, *supra* note 6, at 37-38 fig.1-1 (presenting timeline of Act).

65. *See id.* at 217-28 (explaining evidence of "use" required as prerequisite under common-law and federal rights). Even before federal trademark laws allowed for federal registration of trademarks, the common law recognized trademark ownership by any party that first used a mark on a product or service in commerce. *See id.* at 217 (citing *Columbia Mill Co. v. Alcorn*, 150 U.S. 460, 463-64 (1893)); *see also* Steven John Olsen, *Mixed Signals in Trademark's "Likelihood of Confusion Law": Does Quality Matter?*, 44 Val. U. L. Rev. 659, 662 & n.16 (2010) (reporting individual states first statutorily protected trademark rights). Today, showing actual use of a mark in commerce remains a prerequisite to establishing common-law trademark rights. *See* DINWOODIE & JANIS, *supra* note 6, at 217-20 (contrasting common-law prerequisites with Act's prerequisites).

66. *See* *Checkpoint Sys., Inc. v. Check Point Software Techs., Inc.*, 269 F.3d 270, 279 (3d Cir. 2001) (requiring evidence of plaintiff's ownership of legally protectable mark and defendant's use likely causes confusion); Robert G. Bone, *Taking the Confusion out of "Likelihood of Confusion": Toward a More Sensible Approach to Trademark Infringement*, 106 NW. U. L. REV. 1307, 1313-15 (2012) (offering brief summary of trademark doctrine, including ownership and infringement prongs). A mark will merit protection if the plaintiff can show it owns the asserted mark, and the mark is valid and legally protectable. *Id.* at 1313-14. When a

Act provides for two possible remedies once liability is established: injunctive relief and monetary damages, including costs.⁶⁷ Trademark infringement cases are decided on a case-by-case basis and the determinative analytical question is whether there is a likelihood of consumer confusion.⁶⁸ Likelihood of confusion can either be found in a “forward” configuration or in a “reverse” situation, but the issue in both is whether a general consumer would likely be confused with regard to the source of the products of competing marks.⁶⁹ Traditional, forward-confusion infringement cases involve junior users of a mark using a senior user’s mark to sell products or services, capitalizing on the well-established goodwill of the senior user, and perpetuating a misperception that the products originate with the senior user of the mark.⁷⁰ Reverse confusion is the opposite of forward confusion in that the junior—and typically larger—user attempts to perpetuate the misperception that the junior user is the source of a senior—usually smaller—user’s goods.⁷¹

Protectibility of a mark is based on the mark’s distinctiveness.⁷² An identifying mark is protectable if it either is inherently distinctive or has acquired distinctiveness through secondary meaning.⁷³ Judge Friendly, in the

mark has been federally registered, there is a presumption that the registrant meets the first requirement of ownership of a legally protectable mark; where a mark is not registered, the owner must provide evidence showing its ownership and the mark’s validity. *See* DINWOODIE & JANIS, *supra* note 6, at 303-63, 444 (discussing registration process, substantive rules on registrability, and advantages of registration). After establishing that the asserted mark merits protection, analysis for likelihood of confusion is undertaken. *See id.* at 444; *see also* Mushroom Makers, Inc. v. R.G. Barry Corp., 580 F.2d 44, 47-48 (1978) (recognizing and applying multifactor likelihood-of-confusion test).

67. *See* Buckman, *supra* note 3, at 286 (pointing to injunctive relief as most common remedy). Under section 34 of the Act, courts can grant injunctions based on principles of equity and on any reasonable terms to prevent the violation of any registered mark. *Id.*; *see* Lanham Act § 34, 15 U.S.C. § 1116(a) (2012). Alternatively, under section 35, monetary damages can be awarded, including defendant’s profits, any damages sustained by the plaintiff, and the costs of the action. Buckman, *supra* note 3; *see* Lanham Act § 35, 15 U.S.C. § 1117(a) (2012). Monetary awards under the Act are considered compensation and not a penalty. Buckman, *supra* note 3; *see* 15 U.S.C. § 1117(a). Under the Act, however, punitive damages are unavailable. Buckman, *supra* note 3, at 290.

68. *See* Buckman, *supra* note 3 (articulating likelihood-of-confusion standard used because actual confusion often impossible to prove). Likelihood of confusion examines the source, affiliation, connection, or sponsorship of goods or services and analyzes among relevant and potential customers, the likelihood of those customers being confused between two similar marks. *Id.*

69. *Id.*; *see* Domenico, *supra* note 14, at 606-08 (presenting forward-confusion doctrine, reverse-confusion doctrine); *supra* notes 10-13 and accompanying text (distinguishing doctrines of forward and reverse confusion).

70. *See* Buckman, *supra* note 3, at 287-88; *supra* note 10 and accompanying text (explaining forward-confusion infringement cases).

71. *See* Buckman, *supra* note 3, at 287-88; *supra* notes 12-14 and accompanying text (articulating reverse-confusion doctrine and concerns with current courts’ incongruous analyses of cases).

72. *See* Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9 (2d Cir. 1976) (presenting categories of terms to determine mark’s distinctiveness affecting its level of protectibility); *see also* Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 768 (1992) (utilizing *Abercrombie* scale of generally increasing distinctiveness). Marks classified in one of the final three categories—suggestive, arbitrary, and fanciful—are deemed inherently distinctive and therefore protectable. *See* *Two Pesos, Inc.*, 505 U.S. at 768.

73. *See* *Two Pesos, Inc.*, 505 U.S. at 769 (providing descriptive marks not inherently distinctive because

Abercrombie court, first established a four-category classification system, ranging from not distinctive at all to inherently distinctive, that reflected a mark's eligibility for protection: generic, descriptive, suggestive, and arbitrary or fanciful.⁷⁴ Later, the *Two Pesos* court upheld the *Abercrombie* classification system, but split the fourth factor into two separate factors, altering the classification of marks by categories of generally increasing distinctiveness: generic, descriptive, suggestive, arbitrary, and fanciful.⁷⁵ On one hand, generic and descriptive marks are not inherently distinctive, though descriptive marks may acquire distinctiveness—known as secondary meaning—while on the other hand, suggestive, arbitrary, and fanciful marks are deemed inherently distinctive and are entitled to protection.⁷⁶ Ultimately, liability under section 43(a) of the Act requires proof of the likelihood of confusion.⁷⁷

C. Traditional Likelihood of Confusion

The fundamental inquiry in federal trademark infringement cases is whether the defendant's trademark is so similar to the plaintiff's mark that it is likely to cause, or did cause, consumer confusion regarding where the defendant's goods

do not identify good's particular source); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 cmt. a (1995) (equating distinctiveness with functioning as symbol of identification).

74. See *Abercrombie & Fitch Co.*, 537 F.2d at 9 (cautioning distinction between each category not always "bright").

75. See *Two Pesos, Inc.*, 505 U.S. at 768 (reiterating *Abercrombie* distinctiveness scale, splitting arbitrary or fanciful category into two distinct categories). The *Two Pesos* Court analyzed whether the trade dress of a restaurant can be protected under section 43(a) of the Lanham Act, based upon finding inherent distinctiveness without proof that the trade dress has a secondary meaning. *Id.* at 767; see Lanham Act § 43(a), 15 U.S.C. § 1125(a) (2012). The District Court Judge instructed the jury that trade dress was

the total image of the business . . . [and] may include the shape and general appearance of the exterior of the restaurant, the identifying sign, the interior kitchen floor plan, the decor, the menu, the equipment used to serve food, the servers' uniforms and other features reflecting on the total image of the restaurant . . . [Simply,] [t]he "trade dress" of a product is essentially its total image and overall appearance.

See *Two Pesos, Inc.*, 505 U.S. at 764 n.1 (citations omitted). The Court held that trade dress is protectable if it is inherently distinctive because trade dress serves the same function as trademarks—preventing deception and unfair competition. See *id.* at 771-76.

76. See *Two Pesos, Inc.*, 505 U.S. at 769. The concept of secondary meaning is applicable to actions under section 43(a) of the Lanham Act. See, e.g., *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 41-43 (1st Cir. 1998); *Univ. of Ga. Athletic Ass'n v. Laite*, 756 F.2d 1535, 1540-41 (11th Cir. 1985); *Thompson Med. Co. v. Pfizer Inc.*, 753 F.2d 208, 215-16 (2d Cir. 1985). Additionally, section 2(e) and (f) of the Lanham Act provides that a descriptive mark that otherwise could not be registered under the Act may be registered if it "has become distinctive of the applicant's goods in commerce," by acquiring "secondary meaning." Lanham Act § 2(e)-(f), 15 U.S.C. § 1052(e)-(f) (2012); *Two Pesos, Inc.*, 505 U.S. at 769; see also *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194, 196 (1985) (discussing acquired distinctiveness through secondary meaning).

77. See *Two Pesos, Inc.*, 505 U.S. at 769 (specifying liability under section 43(a) requires "undisputed" proof of likelihood of confusion); see also *I.P. Lund Trading ApS*, 163 F.3d at 43.

originated.⁷⁸ To analyze the likelihood of confusion, each circuit applies a multifactor analysis according to the factors that the particular circuit has established, and each circuit utilizes its own, unique multifactor test.⁷⁹ Professor Barton Beebe appropriately writes that the disparate system of multifactor analysis among the circuit courts is such an unsettling “heuristic” and disheveled arrangement that “[i]ts current condition is Babelian.”⁸⁰

The Second Circuit uses the most well-known set of factors, known as the *Polaroid* factors, and like the First, Sixth, Ninth, and D.C. Circuits, analyzes eight elements.⁸¹ Other circuit courts, such as the Seventh and Fourth, typically use seven factors, while the Third generally uses ten and the Federal Circuit thirteen.⁸² Still others, including the Eighth and Tenth Circuits, use a six-factor test.⁸³ Some overlap among each circuit’s factors does exist, but there is also great variance in which factors are used and to what extent the courts choose to weigh—or even ignore—them.⁸⁴

78. See Beebe, *supra* note 5, at 1582.

79. See 4 MCCARTHY, *supra* note 3, § 24:30 (reporting all circuits have unique factors and “each appears . . . jealous of its own formulation”); Beebe, *supra* note 5, at 1582.

80. Beebe, *supra* note 5, at 1582. Beebe also opines that considering too many factors can be problematic due to physiological and mental attributes; empirical studies demonstrate the brain’s capacity to consider only a limited number of factors or attributes before it makes a decision. See *id.* at 1601-03. He further suggests that the heuristic that judges use is “evidence . . . of human ingenuity rather than human fallibility.” *Id.* at 1603.

81. See *Polaroid Corp. v. Polaroid Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (employing eight-factor *Polaroid* test); see also, e.g., *I.P. Lund Trading ApS*, 163 F.3d at 43; *Basile, S.p.A v. Basile*, 899 F.2d 35, 37 (D.C. Cir. 1990) (citing with approval *Polaroid Corp.*, 287 F.2d at 495); *Frisch’s Rests., Inc. v. Elby’s Big Boy of Steubenville, Inc.*, 670 F.2d 642, 648 (6th Cir. 1982); *Pignons S. A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 487 (1st Cir. 1981); *AMF Inc., v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979) (analyzing likelihood of confusion under eight-factor test).

82. The Seventh Circuit established its seven-factor test in *Helene Curtis Industries, Inc. v. Church & Dwight Co.*, and later cases, such as *AutoZone, Inc. v. Strick*, affirmed those factors. See *Helene Curtis Indus., Inc. v. Church & Dwight Co.*, 560 F.2d 1325, 1330 (7th Cir. 1977); *AutoZone, Inc. v. Strick*, 543 F.3d, 923, 929 (7th Cir. 2008). The Fourth, Fifth, and Eleventh Circuits also usually utilize a seven-factor test, though case law in the Fourth Circuit after 1996 reflects the addition of two factors. See, e.g., *George & Co. v. Imagination Entm’t Ltd.*, 575 F.3d 383, 393 (4th Cir. 2009) (using nine-factor test); *Frehling Enters. v. Int’l Select Grp., Inc.*, 192 F.3d 1330, 1335 (11th Cir. 1999); *Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 463-64 (4th Cir. 1996) (identifying Fourth Circuit’s eighth and ninth factors); *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1527 (4th Cir. 1984) (establishing original seven-factor test); *Roto-Rooter Corp. v. O’Neal*, 513 F.2d 44, 45 (5th Cir. 1975). But see, e.g., *Sunbeam Prods., Inc. v. W. Bend Co.*, 123 F.3d 246, 257 (5th Cir. 1997) (employing eight-factor test); *Perini Corp. v. Perini Constr., Inc.* 915 F.2d 121, 127 (4th Cir. 1990) (using eight-factor test); *Teaching Co. v. Unapix Entm’t, Inc.*, 87 F. Supp. 2d 567, 580 (E.D. Va. 2000) (citing *Pizzeria Uno* and *Perini*, but using nine-factor test). The Third Circuit typically uses ten factors in their analysis, commonly referred to as the *Lapp* or *Scott Paper* factors. See *Interpace Corp. v. Lapp, Inc.*, 721 F.2d 460, 463 (3rd Cir. 1983); *Scott Paper Co. v. Scott’s Liquid Gold, Inc.*, 589 F.2d 1225, 1229 (3d Cir. 1978). The Federal Circuit uses a thirteen-factor test, of which the last factor is “[a]ny other established fact probative of effect of use.” *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973).

83. See, e.g., *King of the Mountain Sports, Inc. v. Chrysler Corp.*, 185 F.3d 1084, 1089-90 (10th Cir. 1999); *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769, 774 (8th Cir. 1994); *SquirtCo v. Seven-Up Co.*, 628 F.2d 1086, 1091 (8th Cir. 1980).

84. See Beebe, *supra* note 5, at 1583; Michael H. Bierman & Jeffrey D. Wexler, *Toward a Reformulation of the Test for Determining Trademark Infringement*, 80 TRADEMARK REP. 1 app. (1990) (detailing

Each of the circuits' current multifactor tests originated in some respect from the 1938 Restatement (First) of Torts, which proposed a four-factor test for cases where the parties' goods were competitive and an additional nine-factor test where the parties' goods were not competitive.⁸⁵ Eventually abolishing the competitive versus noncompetitive goods distinction, the circuits began using a single, multifactored test for any type of good, and this test formed the basis for the circuits' present-day analyses.⁸⁶ Despite their differences, all circuits share a common core four factors—the similarity of the marks; the proximity of the goods; evidence of actual confusion; and the strength of the plaintiff's mark—while a fifth factor, the defendant's intent, is shared by all but the Federal Circuit.⁸⁷

commonalities and differences between each circuit court); David J. McKinley, *Proving Likelihood of Confusion: Lanham Act v. Restatement*, 12 J. CONTEMP. LEGAL ISSUES 239, 243 (2001) (reporting "[l]itigation of trademark likelihood-of-confusion issues has become litigation within lists of factors"). See generally Mark D. Robins, *Actual Confusion in Trademark Infringement Litigation: Restraining Subjectivity Through a Factor-Based Approach To Valuing Evidence*, 2 NW. J. TECH. & INTELL. PROP. 1 (2004) (analyzing extensively courts' treatment of actual confusion).

85. Compare RESTATEMENT (FIRST) OF TORTS § 729 (1938) (highlighting four factors for competitive goods analysis), with *id.* § 731 (establishing nine-factor test for noncompetitive goods analysis). Section 729 governs competitive goods and states:

In determining whether the actor's designation is confusingly similar to the other's trade-mark or trade name, the following factors are important:

- (a) the degree of similarity between the designation and the trade-mark or trade name in
 - (i) appearance;
 - (ii) pronunciation of the words used;
 - (iii) verbal translation of the pictures or designs involved;
 - (iv) suggestion;
- (b) the intent of the actor in adopting the designation;
- (c) the relation in use and manner of marketing between the goods or services marketed by the actor and those marketed by the other;
- (d) the degree of care likely to be exercised by purchasers.

Id. § 729.

86. See *Physicians Formula Cosmetics Inc. v. W. Cabot Cosmetics, Inc.*, 857 F.2d 80, 83 (2d Cir. 1988) (recognizing *Polaroid* test originally applied to noncompeting products, but expanded to competing goods). In large part, circuit courts' use of multifactor tests in early cases determined the factors that circuit uses today: the *Polaroid* factors in the Second Circuit, the *Roto-Rooter* factors in the Fifth, and the *Lapp* factors in the Third. See Beebe, *supra* note 5, at 1588-89 nn.33-37. But see *Helene Curtis Indus., Inc.*, 560 F.2d at 1330 (drawing from Second Circuit case law, excluding *Polaroid*, adding factors to develop circuit test).

87. See Beebe, *supra* note 5, at 1589-90. The Federal Circuit will consider the defendant's intent when it is relevant even though it is not explicitly listed among the factors. See *Univ. of Notre Dame Du Lac v. J.C. Gourmet Foods Imps. Co.*, 703 F.2d 1372, 1374 (Fed. Cir. 1983); see also Richard L. Kirkpatrick, *Likelihood of Confusion Issues: The Federal Circuit's Standard of Review*, 40 AM. U. L. REV. 1221, 1223 n.5 (1991); Olsen, *supra* note 65, at 668-70 & n.29. Additionally, survey evidence in trademark cases is predominantly viewed as a highly probative and persuasive form of evidence, and a good survey can even supersede all other factors in a court's analysis. See *Playboy Enters. v. Netscape Commc'ns Corp.*, 354 F.3d 1020, 1026 & n.28 (9th Cir. 2004) ("Surveys are commonly introduced as probative evidence of actual confusion."); *Schering Corp. v. Pfizer Inc.*, 189 F.3d 218, 225 (2d Cir. 1999) ("Surveys are . . . routinely admitted in trademark and false advertising cases to show actual confusion, genericness of a name or secondary meaning, all of which depend

Beyond these five factors, circuits consider a wide variety of additional factors, which can lead to stark differences in case analyses and outcomes.⁸⁸ Courts apply their respective tests in a relatively methodical manner, despite often asserting that the test should not be applied mechanically, the list of factors is not exhaustive, all factors are not weighted equally (and some may even be irrelevant), and winning the most factors does not necessarily equate with the final outcome of the test.⁸⁹ District courts follow a basic weighted-additive strategy when analyzing each factor because in most circuits, failing to address each individual factor risks remand or reversal on that basis alone.⁹⁰

on establishing that certain associations have been drawn in the public mind.”); *Nat’l Envelope Corp. v. Am. Pad & Paper Co. of Del.*, No. 06 Civ. 12988 (SHS) (RLE), 2009 U.S. Dist. LEXIS 121308, at *11 (S.D.N.Y. Dec. 30, 2009) (“Consumer surveys are probative and routinely employed”); *Predator Int’l, Inc. v. Gamo Outdoor USA, Inc.*, 669 F. Supp. 2d 1235, 1254 (D. Colo. 2009) (“A common, though not required, way to establish actual confusion is by conducting customer surveys.”); *Committee Print To Amend the Federal Trademark Dilution Act: Hearing Before the Subcomm. on Courts, the Internet, & Intellectual Prop. of the Comm. on the Judiciary*, 108th Cong. 14 (2004) (statement of Robert W. Sacoff, Chair, Section of Intellectual Property Law, American Bar Association); Sandra Edelman, *Failure To Conduct a Survey in Trademark Infringement Cases: A Critique of the Adverse Inference*, 90 TRADEMARK REP. 746, 747 (2000) (“[S]urvey evidence has become de rigueur in trademark infringement cases.”); Edward George Epstein, *Surveys: Growing Admissibility but Narrow Utilization*, 83 TRADEMARK REP. 863, 863-70 (1993); Itamar Simonson, *The Effect of Survey Method on Likelihood of Confusion Estimates: Conceptual Analysis and Empirical Test*, 83 TRADEMARK REP. 364, 364 (1993) (“[S]urveys are now routinely employed to prove likelihood of confusion, and a failure to introduce a survey into evidence often leads to harsh criticism by the courts.”).

88. See *supra* note 11 (outlining factors considered by different circuits).

89. See, e.g., *Scott Fetzer Co. v. House of Vacuums Inc.*, 381 F.3d 477, 485 (5th Cir. 2004) (stating factors do not apply mechanically and “serve . . . as guides, not as an exact calculus”); *Thane Int’l, Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 901 (9th Cir. 2002) (“The list of factors is not a score-card—whether a party ‘wins’ a majority of the factors is not the point.”); *Shakespeare Co. v. Silstar Corp. of Am.*, 110 F.3d 234, 242 (4th Cir. 1997) (explaining factor list “neither exhaustive nor exclusive” and factor relevance depends on individual case). The “nonexhaustive collection of considerations” theme has siphoned down to the district courts as well. See *RE/MAX Int’l, Inc. v. Trendsetter Realty, LLC*, 655 F. Supp. 2d 679, 708 (S.D. Tex. 2009) (quoting *Society of Fin. Exam’rs v. Nat’l Ass’n of Certified Fraud Exam’rs*, 41 F.3d 223, 228 n.15 (5th Cir. 1995)). Perhaps the Ninth Circuit put it best in reasoning that

[s]ince each factor represents only a facet of the single dispositive issue of likely confusion, the factors, not surprisingly, tend to overlap and interact, and the resolution of one factor will likely influence the outcome and relative importance of other factors [T]he determination of one factor is often, in essence, only another way of viewing the same considerations already taken into account in finding the presence or absence of another one.

Entrepreneur Media, Inc. v. Smith, 279 F.3d 1135, 1141 (9th Cir. 2002).

90. See JOHN W. PAYNE ET AL., *THE ADAPTIVE DECISION MAKER* 24 (1993). Payne writes that the

weighted additive rule considers the values of each alternative on all the relevant attributes and considers all the relative importances or weights of the attributes to the decision maker. Further, the conflict among values is assumed to be confronted and resolved by explicitly considering the extent to which one is willing to trade off attribute values, as reflected by the relative importances or weights.

Id. (emphasis omitted); cf. Richard A. Posner, *Judicial Behavior and Performance: An Economic Approach*, 32 FLA. ST. U. L. REV. 1259, 1271 (2005) (discussing judges’ aversion to being reversed). The Second Circuit

Most circuits have also identified certain factors, or combinations of factors, that are most important to their circuit's analysis.⁹¹ Circuits disagree, however, as to which factor receives the greatest weight: the Second Circuit has pointed to the similarity of the marks and the proximity of the goods, or to the strength of the plaintiff's mark, similarity, and proximity; the Third to similarity; the Fourth to evidence of actual confusion; the Sixth to proximity; the Seventh to similarity, the defendant's intent, and actual confusion; the Ninth to actual confusion in cases outside the context of Internet domain names; and the Eleventh to the type of mark and actual confusion.⁹²

D. Reverse-Confusion Doctrine

Reverse-confusion doctrine stems from Justice Holmes's dissenting opinion

especially favors meticulous adherence to analyzing each factor under a weighted-additive decision strategy; the Ninth Circuit is less deferential, declining to follow such a rigid test, and also appears to be the only circuit allowing district courts to consider a "subset" of factors. See Beebe, *supra* note 5, at 1593 (asserting district courts "give every appearance of scrupulously following a basic weighted additive decision strategy"); see also *Brookfield Commc'ns, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1054 (9th Cir. 1999) (supporting using "subset" of factors in internet context).

91. See *Checkpoint Sys., Inc. v. Check Point Software Techs., Inc.*, 269 F.3d 270, 281 (3d Cir. 2001). As the court stated, similarity "may be the most important of the ten factors." *Id.* (quoting *Fisons Horticulture, Inc. v. Vigoro Indus., Inc.*, 30 F.3d 466, 476 (3d Cir. 1994)); see *Eli Lilly & Co. v. Natural Answers, Inc.*, 233 F.3d 456, 462 (7th Cir. 2000) ("[A]lthough no one factor is decisive, the similarity of the marks, the intent of the defendant, and evidence of actual confusion are the most important considerations." (citing *G. Heileman Brewing Co., Inc. v. Anheuser-Busch, Inc.*, 873 F.2d 985, 999 (7th Cir. 1989))); *Homeowners Grp., Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1109 (6th Cir. 1991) (referring to "relatedness" of goods as "the important inquiry in the likelihood of confusion determination"); *Dieter v. B & H Indus. of Sw. Fla., Inc.*, 880 F.2d 322, 326 (11th Cir. 1989) ("[T]he type of mark and the evidence of actual confusion are the most important in this circuit."); *Mobil Oil Corp. v. Pegasus Petrol. Corp.*, 818 F.2d 254, 256-58 (2d Cir. 1987) (opining first three factors considered most important, no one factor determinative, and list nonexclusive); *Vitarroz Corp. v. Borden, Inc.*, 644 F.2d 960, 966 (2d Cir. 1981) ("Our cases demonstrate, moreover, that the likelihood of confusion, the 'crucial' issue in a case such as this, often depends on the similarity of the marks and the proximity of the products." (citation omitted)); *Tillamook Country Smoker, Inc. v. Tillamook County Creamery Ass'n*, 311 F. Supp. 2d 1023, 1041 (D. Or. 2004) (citing *GoTo.com v. Walt Disney Co.*, 202 F.3d 1199, 1205 (9th Cir. 2000)) (referring to similarity, proximity, and marketing channels factors as "controlling troika" of factors); *Comerica Inc. v. Fifth Third Bankcorp*, 282 F. Supp. 2d 557, 570 (E.D. Mich. 2003) (citing *Homeowners Group* for same); *Giant Brands, Inc. v. Giant Eagle, Inc.*, 228 F. Supp. 2d 646, 654 (D. Md. 2002) (affirming earlier decisions recognizing "[a]ctual confusion is the final and most important *Pizzeria Uno* factor" (citing *Lyons P'ship, L.P. v. Morris Costumes, Inc.*, 243 F.3d 789, 804 (4th Cir. 2001))); *Lexington Mgmt. Corp. v. Lexington Capital Partners*, 10 F. Supp. 2d 271, 288 (S.D.N.Y. 1998) ("In this case I am influenced by the Court of Appeals' recognition that determining likelihood of confusion 'often depends on the similarity of the marks and the proximity of the products.'" (quoting *Vitarroz Corp. v. Borden, Inc.*, 644 F.2d 960, 966 (2d Cir. 1981))).

92. See *George & Co. v. Imagination Entm't Ltd.*, 575 F.3d 383, 393 (4th Cir. 2009); *Checkpoint Sys., Inc.*, 269 F.3d at 281; *Eli Lilly & Co.*, 233 F.3d at 462; *Homeowners Grp., Inc.*, 931 F.2d at 1109; *Dieter*, 880 F.2d at 326; *Mobil Oil Corp.*, 818 F.2d at 256-58; cf. *Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137, 1146 (9th Cir. 2011) (determining marks' similarity, relatedness of goods, and simultaneous marketing-channel use most important for Internet cases). But see *Playmakers, LLC v. ESPN, Inc.*, 297 F. Supp. 2d 1277, 1280 (W.D. Wash. 2003) (stating "controlling troika" analysis confined to Internet cases).

in the 1918 *International News Service v. Associated Press* case, although not explicitly termed “reverse confusion” at that time.⁹³ Reverse confusion is present in cases where a senior user is the smaller, weaker user faced with a larger, junior user who poaches a mark that the senior user originally established.⁹⁴ In reverse-confusion cases, consumers are confused as to the source of the senior user’s goods, and are led to believe that the senior user is actually the second user and that the senior user’s goods pirate the idea from the junior user, which is typically the more financially powerful party.⁹⁵ While some circuit courts analyzing instances of reverse confusion apply a similar framework to that used in forward-confusion cases, only recently have all circuits recognized the reverse-confusion phenomenon, and some have no framework in place whatsoever to analyze these cases.⁹⁶

In *Big O Tire Dealers, Inc.*, the Tenth Circuit recognized the plaintiff’s reverse-confusion argument, holding that a junior user could be liable for infringement, even without proof from the senior user that the junior user intentionally traded on its goodwill, and therefore established a legal premise under which a smaller user could recover for infringement by a larger user; the court, however, failed to establish a test for analyzing such reverse-confusion claims.⁹⁷ Nevertheless, all of the circuit courts since the landmark *Big O Tire Dealers* decision recognized and adopted the doctrine.⁹⁸ Not surprisingly, no court acknowledged the need for a test for reverse-confusion claims until six

93. Buckman, *supra* note 3, at 288 (explaining basis for reverse-confusion theory embedded in *International News Service*); *Int’l News Serv. v. Assoc. Press*, 248 U.S. 215, 246-48 (1918) (Holmes, J., dissenting); *see also* Cusson, *supra* note 3, at 186. In *International News Service*, the Court held that the defendant misappropriated the plaintiff’s news product and found substantial “false representation” in the defendant’s work in producing its news product. *Int’l News Serv.*, 248 U.S. at 242. Justice Holmes based his dissent wholly on the false representation aspect, categorizing it as unfair trade or competition. *See id.* at 247 (Holmes, J., dissenting). “The ordinary case [of unfair competition] is palming off the defendant’s product as the plaintiff’s but the same evil may follow from the opposite falsehood—from saying whether in words or by implication that the plaintiff’s product is the defendant’s, and that . . . is what has happened here.” *Id.* at 247.

94. *See supra* note 12 and accompanying text (defining reverse confusion).

95. *See Cusson, supra* note 3, at 182. In these cases, the outcome is that “reverse confusion occurs when the junior user’s advertising and promotion so swamps the senior user’s reputation in the market that customers are likely to be confused into thinking that the senior user’s goods are those of the junior user: the reverse of traditional confusion.” 4 MCCARTHY, *supra* note 3, § 23:10; *see Tanel Corp. v. Reebok Int’l, Ltd.*, 774 F. Supp. 49, 56 (D. Mass. 1990).

96. *See supra* note 13 and accompanying text (noting lack of consistent framework for reverse-confusion analysis).

97. *See Cusson, supra* note 3, at 190 n.63. The court merely acknowledged that reverse-confusion claims were actionable and set forth likelihood of confusion as the relevant test. *See id.* But, it never specified a test to apply that likelihood-of-confusion analysis unique to reverse-confusion claims. *See Big O Tire Dealers, Inc. v. Goodyear Tire & Rubber Co.*, 561 F.2d 1365, 1371 (10th Cir. 1977); Cusson, *supra* note 3, at 190 n.63. In 1968, the Seventh Circuit Court of Appeals was the first federal circuit to address the concept, but flatly rejected it in the case of *Westward Coach Manufacturing Co. v. Ford Motor Co.* *See* 388 F.2d 627, 634 (7th Cir. 1968), *reh’g denied*, 388 F.2d 627 (7th Cir. 1968); *see also* Cusson, *supra* note 3, at 186-87 (discussing *Westward* decision).

98. *See* Buckman, *supra* note 3, at 288.

years later, when the Second Circuit in *Plus Products v. Plus Discount Foods, Inc.* determined an analysis for reverse-confusion infringement should take the same form as a forward-confusion analysis.⁹⁹

Reverse-confusion claims should invoke, at minimum, two basic exceptions from forward-confusion cases, as highlighted in the Seventh Circuit's landmark 1992 *Sands, Taylor & Wood Co. v. Quaker Oats Co.* decision: analyzing the commercial strength of the junior user's mark, rather than the senior user's; and utilizing a bad-faith test to determine whether the junior user knew of the senior user's similar mark but proceeded anyway.¹⁰⁰ To date, the Second, Third, Seventh, and Eighth Circuits employ some form of reverse-confusion analysis that takes the above exceptions into account.¹⁰¹ However, while the First,

99. See *Plus Prods. v. Plus Disc. Foods, Inc.*, 722 F.2d 999, 1003-04 (2d Cir. 1983) (requiring showing of both protectable mark and likelihood of confusion); see also *Cusson*, *supra* note 3, at 190-91, 197-99 (providing further discussion of forward-confusion analysis used to determine reverse confusion).

100. See *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 959, 961-63 (7th Cir. 1992); *Del Pizzo*, *supra* note 11, at 185-87. The Seventh Circuit's determination of these two exceptions is similar to the Third Circuit's three exceptions. See *Fisons Horticulture, Inc. v. Vigoro Indus., Inc.*, 30 F.3d 466, 479-80 (3d Cir. 1994); *Sands, Taylor & Wood Co.*, 978 F.2d at 959-61. The *Sands* commercial-strength exception looks at the commercial strength of the junior user's mark rather than the senior user's, and favored the plaintiff senior user. *Sands, Taylor & Wood Co.*, 978 F.2d at 959. The *Sands* court also determined that the good-faith factor for forward confusion morphs into a bad-faith test for reverse confusion: in reverse confusion, the defendant junior user "is not palming off or otherwise attempting to create confusion as to the source of his product," and consequently the court must look at whether the defendant junior user knew that the senior user's mark was in use and similar, and proceeded to use the senior user's mark anyway. *Sands, Taylor & Wood Co.*, 978 F.2d at 961 (emphasis omitted) (suggesting willful infringement can be basis of award of profits).

101. See *Del Pizzo*, *supra* note 11, at 186-95 (reviewing circuit courts' analysis in reverse-confusion cases). The Second Circuit used *Fisons* and *Sands* for guidance in deciding *Sunenblick v. Harrell*, utilizing a modified *Polaroid* factor analysis; the court found that the commercial strength of the junior user's mark, evidence of actual confusion by "consumers [who] erroneously believe the senior user is the source of the junior user's product," and defendant's intent in adopting the allegedly infringing mark are the traditional *Polaroid* factors that require modification in a reverse-confusion claim. See *Sunenblick v. Harrell*, 895 F. Supp. 616, 627-33 (S.D.N.Y. 1995). Not dissimilarly, the Third Circuit developed three exceptions to its forward-confusion analysis that include looking at the commercial strength of the junior user's mark, the senior user's mark's inherent strength or distinctiveness, and the bad faith of the junior user in using its mark. See *Fisons*, 30 F.3d at 479-80 (differentiating commercial strength evidence and weight between forward- and reverse-confusion cases). In the Seventh Circuit, the court determined that the commercial strength of the junior user's mark was determinative, and the forward-confusion good-faith test should instead be a bad-faith test to find whether the defendant knew of the senior user's mark and continued to use its own similar mark anyway. See *Sands, Taylor & Wood Co.*, 978 F.2d at 959-62. Finally, the Eighth Circuit modified its six-factor forward-confusion test for reverse confusion to analyze the commercial strength of the junior user's mark rather than the commercial strength of the senior user's mark and to utilize a similar exception to the good-faith factor as the Second, Third, and Seventh Circuits. See *Dream Team Collectibles, Inc. v. NBA Props., Inc.*, 958 F. Supp. 1401, 1411-15 (E.D. Mo. 1997). The *Dream Team* court further explained that the commercial strength of a senior user's mark is less important in reverse-confusion cases because an "aggressive junior user may thereby achieve greater commercial strength in a short[er] period of time than the senior user has after years of marketing its product." *Id.* at 1412 (quoting *Fisons*, 30 F.3d at 479). Additionally, the *Dream Team* court suggested that the relatedness of the products is not as significant a factor in a reverse-confusion case because consumers might associate the smaller, senior user plaintiff's mark with the larger, junior user defendant's mark on unrelated products, even though it is a determinative factor in forward-confusion cases. *Id.* at 1414-15.

Fourth, Ninth, Tenth, and Eleventh Circuits recognize that the concept of reverse confusion exists, they have yet to adopt appropriate uniform exceptions to their respective forward-confusion analytical frameworks.¹⁰²

III. ANALYSIS

A. Towards a National Forward-Confusion Multifactor Test

The circuits' differing identification of individual factors—or combinations of factors—as leading factors engenders the debate over which factors ultimately drive each circuit's multifactor analysis, how those factors interact, and what the ultimate outcome will be.¹⁰³ Recognizing the latent problems of different circuit factors for forward-confusion analyses should caution and guide prospective reformers of forward- and reverse-confusion analyses.¹⁰⁴ Instead of scrutinizing the inherent differences between the circuits' multifactor tests, courts can utilize a less complicated, more uniform multifactor test for reverse-confusion cases by focusing on the similar core forward-confusion factors that exist among all circuits.¹⁰⁵

Judicial predictability supports consolidation of each circuit's factors to streamline judges' determinations and eliminate the haphazard "slice and dice"

102. See Del Pizzo, *supra* note 11, at 195 (discussing shortcomings of certain circuit courts in analyzing reverse-confusion claims). Representative of these circuit courts is a Tenth Circuit attempt to vary its typical forward-confusion good-faith factor in the 1999 *King of the Mountain Sports, Inc. v. Chrysler Corp.* case; the case mistakenly focused its analysis on whether the defendant intended to benefit from the senior user's goodwill rather than if the defendant junior user used due diligence in its research efforts prior to adopting the similar mark. See *King of the Mountain Sports, Inc. v. Chrysler Corp.*, 185 F.3d 1084, 1091 (10th Cir. 1999); Buckman, *supra* note 3, at 293-95 (reporting *King of the Mountain Sports* holding did not use modification to defendant's intent). In *King of the Mountain Sports, Inc.*, the plaintiff used its trademark *King of the Mountain* to brand its hunting, fishing, and camping products, and subsequently expanded it to skiing and snowboarding products; the defendant, a television and sports marketing firm, utilized its *King of the Mountain* logo to promote a Chrysler-Jeep sponsored skiing event. *King of the Mountain Sports, Inc.*, 185 F.3d at 1088. The plaintiff's claim centered on the idea that consumers would assume that it was affiliated with the ski event, a classic reverse-confusion allegation. *Id.* The court reasoned that there was no evidence of reverse confusion, despite not explicitly naming it as such, because the plaintiff failed to show evidence of the defendant's knowledge of the plaintiff's similar mark or that the defendant acted with the intention to "trade on [the] plaintiff's reputation or goodwill." *Id.* at 1091.

103. See *supra* notes 91-92 and accompanying text (enumerating factors most critical to each circuit's likelihood-of-confusion analysis).

104. See generally Beebe, *supra* note 5; Cusson, *supra* note 3; Del Pizzo, *supra* note 11; Buckman, *supra* note 3, at 287-89.

105. See Beebe, *supra* note 5, at 1601-07 (discussing importance of common core factors). Beebe reports empirical decision-making studies show decision makers reach a "stopping threshold" after considering "a remarkably low number of decision-relevant factors," at the time they make their decision. *Id.* at 1601-02. Interestingly, social science researchers demonstrated that, on average, three cues are able to be considered as significant to the decision-making process. See *id.* Still other empirical studies show that decision makers tend to utilize a "core attributes heuristic" with a low threshold for the number of attributes or cues one is able to process before making a decision. See *id.* at 1602. Ultimately, considering "too much information impairs decision-making accuracy." *Id.*

approach that courts are currently compelled to use.¹⁰⁶ Streamlining multifactor tests across circuits would remedy the “internal incoherence” present in current multifactor schemes that stems from the historical functions different factors serve.¹⁰⁷ Research and outcome analyses also indicate that single-factor outcomes can individually trigger the overall multifactor test outcome.¹⁰⁸ Because, however, a multifactor analysis is theoretically a balancing test, judges and courts can still balance efficiency with accuracy by considering only a few (i.e., the most decisive) factors.¹⁰⁹

A reconstituted, nationally uniformed multifactor test would ideally include a limited number of core factors aimed at assisting judges in determining results from an archetypal survey of the relevant consumer population.¹¹⁰ The factors should be carefully worded to emphasize the analysis’s empirical nature.¹¹¹ Additionally, factors would be ordered according to their respective analytical weights, explicitly noting any factors that do not directly corroborate the level of actual likelihood of consumer confusion.¹¹² Ultimately, a new national multifactor forward-confusion test should consist of the following five factors: the degree of consumer perception of the marks’ similarity; the degree of consumer perception of the proximity of the goods; evidence of actual confusion, mistake, or deception; the marketplace strength of the allegedly infringed upon mark; and the alleged infringer’s intent in adopting and using its mark.¹¹³ The remaining noncore factors in circuit courts’ current schemata have little, if any, influence on the ultimate outcome of the analysis, and not

106. *Reinsurance Co. of Am., Inc. v. Administratia Asigurarilor de Stat*, 902 F.2d 1275, 1283 (7th Cir. 1990) (Easterbrook, J., concurring); *see Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1141 (9th Cir. 2002) (positing interdependent nature of factors); Beebe, *supra* note 5, at 1601 & n.87, 1602-03 & nn.94-96, 1607; *cf.* Cusson, *supra* note 3, at 233-34 (suggesting bright-line approach for uniform confusion analysis impractical).

107. *See* Bone, *supra* note 66, at 1335, 1348-78 (advocating restructuring infringement analyses to fit public policies of trademark law).

108. *See* Beebe, *supra* note 5, at 1607-08. Single factors can overly influence the outcomes of other factors in the multifactor analysis and the overall outcome. *See id.* at 1607. For example, if a court were to find that the similarity-of-the-mark factor disfavored finding likelihood of confusion, that court would be more likely to find an overall lack of likelihood of confusion, regardless of the analysis of any other factor. *See id.*

109. *See id.* at 1614 (characterizing judges as “consummate pragmatists” engaged in rational “take the best” decision-making strategy); *supra* notes 91-92 and accompanying text; *see also* *Maker’s Mark Distillery, Inc. v. Diageo N. Am., Inc.*, 679 F.3d 410, 422-24 (6th Cir. 2012) (balancing *Frisch* factors de novo).

110. *See* Beebe, *supra* note 5, at 1646; *supra* note 87 (detailing highly probative nature of survey evidence to proving likelihood of confusion).

111. *See* Beebe, *supra* note 5, at 1646. Beebe reiterates that in trademark law, courts should consider consumer-marketplace perception rather than judicial-courtroom perception to uphold the practical goals of trademark law. *Id.*

112. *See id.* at 1646. Beebe proposes sample statutory language that takes into account the preceding principles, and instructs that the analysis “should remain a tightly-focused fact-finding inquiry into the likelihood of consumer confusion rather than into the commercial morality of the defendant.” *Id.* at 1646-47.

113. *See id.* at 1646-47. The suggested factors appear in order of decreasing weight. *Id.* at 1622-42, 1647. Evidence of the degree of consumer’s perception of the marks’ similarity could still be demonstrated through survey evidence. *See supra* text accompanying notes 110-11.

surprisingly, play little, if any, role in influencing the outcomes in practice.¹¹⁴

The courts, their critics, and empirical evidence support designating the similarity-of-the-marks factor as the most important in a classic forward-confusion case.¹¹⁵ The proximity-of-the-goods factor considers the similarity of the goods, and whether consumers of each good are likely to confuse the goods as having a common source or affiliation.¹¹⁶ Courts analyze evidence of actual confusion, mistake, or deception by looking at survey evidence and direct evidence, such as testimony from confused consumers, and there currently appears to be little significant variation in this factor's assigned weight among the circuits.¹¹⁷ However, empirical data suggests that courts inconsistently apply and make doctrinal mistakes in their analysis of the strength of the plaintiff's mark—assessed in terms of its inherent and acquired distinctiveness.¹¹⁸ Circuits disagree over the weight a defendant's intent plays, but regardless of the weight a court places on a defendant's intent, the bad faith of either party can influence the court in at least two regards: presence of bad faith by one party can predispose the court to decide in favor of the opposing party, and the good or bad faith of the parties can influence the court's

114. See Beebe, *supra* note 5, at 1642-45 (discussing rationale for eliminating all but core factors from multifactor analyses).

115. See *id.* at 1623. Moreover, this factor acts as a threshold factor and serves as a gatekeeper, as it is hard to conceive how a trademark infringement case could properly be heralded into court if two marks were not similar in some way. See *id.* at 1623-24. *But cf.* 4 MCCARTHY, *supra* note 3, § 23:13 (positing actual consumer confusion strongest indicator of likelihood of confusion).

116. See *Checkpoint Sys. v. Check Point Software Techs., Inc.*, 269 F.3d 270, 286 (3d Cir. 2001); Beebe, *supra* note 5, at 1631. Again, courts place varying degrees of importance on this factor, with some regarding it as the most important factor and others deeming it as having no "overriding importance." *Vitarroz Corp. v. Borden, Inc.*, 644 F.2d 960, 967 (2d Cir. 1981); Beebe, *supra* note 5, at 1631-32.

117. See Beebe, *supra* note 5, at 1640-42 (reporting survey evidence best at showing actual confusion, which can supersede rest of multifactor analysis); *supra* note 87 (evidencing highly probative and persuasive nature of admitted survey evidence in courts' analyses). It is not unheard of for a court to adversely infer no likelihood of confusion if a plaintiff with the time and resources to produce survey evidence fails to conduct the surveys. See Beebe, *supra* note 5, at 1641.

118. See *id.* at 1633. Inherent distinctiveness deals solely with a mark's "theoretical potential" to distinguish a good, while acquired distinctiveness refers to the commercial recognition a mark has earned through its designation of the plaintiff's goods. *Id.* The more inherently strong a mark is, the more likely it is to prevail in a multifactor analysis. *Id.* at 1633-34. Fanciful marks are likely to have the highest level of inherent distinctiveness while descriptive and generic marks are deemed as lacking inherent distinctiveness. *Id.* at 1634. Judge Easterbrook and others, however, have criticized the formalistic nature of this *Abercrombie* classification system. See *id.*; *Scandia Down Corp v. Euroquilt, Inc.*, 772 F.2d 1423, 1431 & n.3 (7th Cir. 1985); see also *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992); *Abercrombie & Fitch, Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 cmt. a (1995); *supra* notes 72-76 and accompanying text. Interestingly, in situations where courts' assessments of a mark's inherent strength differ from the assessments of the mark's acquired strength, the acquired-strength assessments seem to control the analyses outcomes. See Beebe, *supra* note 5, at 1636. This suggests that acquired—or perhaps more aptly, actual—strength is a broader category, encompassing its own subfactors such as advertising expenditure, duration of the mark's use, revenues procured because of the mark, third-party uses of the mark, and the inherent strength of the mark. *Id.* Circuits vary substantially in the doctrine and subfactors they apply in evaluating the strength of a mark, but there seems to be no significant variation on their application of the strength factor. See *id.* at 1636-40.

administration of equitable relief.¹¹⁹

B. The Case for a Unified, Modified Reverse-Confusion Framework

Courts' failure to recognize reverse-confusion doctrine, or inflexibility to modify their forward-confusion analyses, deprives small senior users of a cause of action to defend their marks from larger and more powerful companies using identical or confusingly similar marks.¹²⁰ If the law was limited to the passing-off doctrine or traditional forward confusion, anyone with sufficient power and resources could adopt any trademark and develop new meaning for it to identify its own products, as the Tenth Circuit first recognized in *Big O Tire Dealers* in 1977.¹²¹

Moreover, if courts are hesitant to modify existing multifactor schemata and apply forward-confusion tests to reverse-confusion cases, inconsistent results will form a precarious standard for future cases.¹²² Alternatively, if courts are too eager to adopt other circuits' precedents to modify their own analyses, they can also impose additional inconsistencies into their own circuit's precedent.¹²³ Such a double-edged sword highlights the need for comprehensive reverse-confusion analysis reform.¹²⁴

Factors typically employed in forward-confusion cases by circuit courts are often inadequate in a reverse-confusion case due to the disparity in commercial prowess between the parties.¹²⁵ The typical *Polaroid* factors that many courts utilize are ineffective for reverse-confusion cases because they assume litigants of equal strength rather than a stronger, larger, junior-user defendant and a

119. See Beebe, *supra* note 5, at 1626-27. The Second Circuit has held that a finding that a defendant acted in bad faith, or intentionally copied a mark, creates "a presumption of a likelihood of confusion" that the defendant will prevail in confusing consumers. *Mobil Oil Corp. v. Pegasus Petrol. Corp.*, 818 F.2d 254, 258 (2d Cir. 1987). At least one district court in the Fifth Circuit has determined that showing bad-faith intent might validate a finding that the defendant succeeded in confusing consumers. See *RE/MAX Int'l, Inc. v. Trendsetter Realty, LLC*, 655 F. Supp. 2d 679, 702 (S.D. Tex. 2009). Yet, other circuits, such as the Ninth Circuit, have held that a defendant's intent to deceive is "strong evidence of a likelihood of confusion," or as the Eleventh Circuit held, sufficient to establish any presumption of confusion. See *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1148 (9th Cir. 2002) (quoting *Interstellar Starship Servs., Ltd. v. Epix Inc.*, 184 F.3d 1107, 1111 (9th Cir. 1999)); *Frehling Enters., Inc. v. Int'l Select Grp., Inc.*, 192 F.3d 1330, 1340 (11th Cir. 1999). See generally 1 MCCARTHY, *supra* note 3, § 5:2 (discussing historical basis for alleged infringer's intent factor).

120. See Cusson, *supra* note 3, at 184-85.

121. *Big O Tire Dealers, Inc. v. Goodyear Tire & Rubber Co.*, 561 F.2d 1365, 1372 (10th Cir. 1977) (citing lower court decision, 408 F. Supp. 1219, 1236 (D. Colo. 1976)); see Buckman, *supra* note 3, at 288; see also Cusson, *supra* note 3, at 186.

122. See Cusson, *supra* note 3, at 200.

123. See *Sunenblick v. Harrell*, 895 F. Supp. 616, 627-28 (S.D.N.Y. 1995); Cusson, *supra* note 3, at 229.

124. See Cusson, *supra* note 3, at 230 (critiquing *Sunenblick* methodology for analyzing reverse confusion).

125. See *id.* at 181, 231-40 (analyzing *Polaroid* factors, explaining their inadequacy for reverse-confusion cases, and proposing new framework); Del Pizzo, *supra* note 11, at 177.

smaller, senior-user plaintiff.¹²⁶ Even the above-proposed set of streamlined forward-confusion factors would do a disservice to reverse confusion, but with some modification, they could form the foundation of a viable, unified framework for all circuits to utilize.¹²⁷

Reverse-confusion analysis can be similarly reformed using analogous principles as those used in the forward-confusion reform stated above.¹²⁸ Following Justice Cardozo's approach to changing the law with the times, the above multifactor framework containing five core factors can be modified to

126. See Del Pizzo, *supra* note 11, at 204 (highlighting three exceptions to *Polaroid* test discussed in *Fisons*). For example, in *Fisons Horticulture, Inc. v. Vigoro Industries, Inc.*, the Third Circuit advanced several modifications to its typical *Polaroid* forward-confusion test to analyze reverse-confusion cases. See 30 F.3d 466, 479-81 (3d Cir. 1994). The court reasoned that in reverse-confusion cases, the commercial strength of the junior user's mark merits analysis rather than solely focusing on the strength of the senior user's mark. See *id.* at 479; Del Pizzo, *supra* note 11, at 187.

[I]n a case of reverse confusion, the evidence of commercial strength is different from what we expect in a case of forward confusion, where the junior user tries to palm off his goods as those of the senior user In reverse confusion, the junior user is typically a wealthier, more powerful company who can overwhelm the market with advertising. An aggressive junior user may thereby achieve greater commercial strength in a short period of time than the senior user has after years of marketing its product.

Fisons, 30 F.3d at 479. Additionally, in reverse-confusion cases, the inherent strength or distinctiveness of the senior user's mark should carry more weight than its commercial strength because, unlike forward-confusion cases, the senior user's mark is typically commercially weaker than the junior user's mark. See *id.* at 479; Del Pizzo, *supra* note 11, at 187. Should the senior user in a reverse-confusion case have a strong or distinctive mark—suggestive, arbitrary, or fanciful on the distinctiveness scale—it will prevail on the strength factor even though it is not as commercially strong as the junior user. *Fisons*, 30 F.3d at 479; see *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (classifying suggestive, arbitrary, and fanciful marks as inherently distinctive, meriting protection). Finally, the good-faith factor should be analyzed with the intent to determine whether the defendant junior user failed to use due diligence in researching previous users of a similar trademark, and was remiss in investigating any companies it found who used similar marks; ultimately, the good-faith factor morphs into a bad-faith factor for reverse-confusion cases. See *Fisons*, 30 F.3d at 480; Del Pizzo, *supra* note 11, at 187-88. The *Polaroid* good-faith factor for forward-confusion cases aims to determine whether the junior user is attempting to capitalize on the senior user's reputation and whether the junior user conducted a trademark search, sought legal advice, or continued to use a mark after learning of the senior user's mark; this analysis is fruitless for reverse-confusion cases because the senior user is unlikely to have as strong of a reputation as the larger junior user. See Del Pizzo, *supra* note 11, at 184, 206.

127. See Cusson, *supra* note 3, at 233-40 (proposing new test retaining four *Polaroid* factors and modifying remaining); *supra* notes 100-01 and accompanying text (describing several circuits' modifications of *Polaroid* factors). Cusson explains and advocates for the courts to follow Justice Cardozo's approach: regarding new technology, the courts should first apply existing law, but recognizing that if that approach fails, they have a duty to develop the law to adapt to the new technology. See Cusson, *supra* note 3, at 231. For example, the *W.W. Pharmaceutical Co.* court applied the *Polaroid* intent factor to a reverse-confusion case, failing to recognize that reverse confusion requires different analysis than forward confusion. See *W.W. Pharm. Co., v. Gillette Co.*, 984 F.2d 567, 575 (2d Cir. 1993). Other courts, however, were not so hesitant to modify the forward-confusion framework for reverse-confusion cases. See *Sands, Taylor, & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 960-61 (7th Cir. 1992) (reasoning intent irrelevant in reverse-confusion analysis); *Big O Tire Dealers, Inc.*, 561 F.2d at 1372 (disregarding intent factor in reverse-confusion analysis).

128. See Cusson, *supra* note 3, at 233-34.

accommodate the unique challenges of reverse-confusion cases.¹²⁹ The similarity-of-the-marks factor remains unchanged from its forward-confusion role, but is likely not the most important factor in a reverse-confusion analysis.¹³⁰

The proximity-of-the-goods factor should be considered within a consistent, objective framework of categories common to all circuits, and take into account the ever-growing mass-merchandise environment conducive to two types of products often perceived as emanating from the same source.¹³¹ Actual confusion is arguably the best indicator of likelihood of confusion, but courts must adopt a more consistent approach for evaluating survey evidence.¹³² The Third and Seventh Circuits led the way in reformulating the critical strength-of-the-mark factor to consider the strength of the junior user's mark, rather than the senior user's, and focus solely on the attributes of the mark itself.¹³³ Some reverse-confusion analyses associate a junior user's lack of intent with good faith, generally supporting a finding of no infringement, but in reverse-confusion cases, intent to pass off another's mark as one's own is not a factor.¹³⁴ In sum, a uniform reverse-confusion multifactor analysis, ordered in decreasing importance, may look like: actual confusion of actual, potential, or end users; strength of the infringed upon mark; consumer perception of

129. See *id.* at 233-40 (advocating new test modifying *Polaroid* factors and following Justice Cardozo's approach); *supra* note 100 (discussing Seventh Circuit modifications to *Polaroid* factors); see also *Sands, Taylor, & Wood Co.*, 978 F.2d at 960-61 (intimating intent irrelevant in likelihood-of-reverse-confusion cases).

130. See *Cusson*, *supra* note 3, at 235.

131. See *id.* at 211 n.176, 238-39. Proximity of the goods is a factual determination, and is inconsistently decided among circuits due to a lack of guidelines as to what products are considered proximate to one another. *Id.* at 238-39; see *W.W.W. Pharm.*, 984 F.2d at 573 (failing to address whether lip balm and deodorant proximate products in public perception).

132. See *Cusson*, *supra* note 3, at 204-05 nn.139-40, 239-40. Ultimately, courts need to adopt a uniform standard for considering evidence of actual confusion, determining whether only actual consumers' confusion is probative, or whether potential purchasers or end users are also persuasive. *Id.* at 205 n.140.

133. See *Buckman*, *supra* note 3, at 291-93; see also *Cusson*, *supra* note 3, at 228-29 & n.296; *supra* note 126. Confusion in reverse-confusion cases stems from consumer recognition of the stronger, junior user's mark and the belief that the senior user's mark is derived from it. See *Sands, Taylor, & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 959 (7th Cir. 1992) (reforming strength-of-mark factor to assess junior user's mark instead of senior user's); *Sunenblick v. Harrell*, 895 F. Supp. 616, 627 (S.D.N.Y. 1995) (presenting plaintiff's argument that court should reject Second Circuit strength-of-the-mark precedent, follow Third Circuit's lead). The second way the strength-of-the-mark requirement should be reformed is to focus its analysis on the mark itself, and not consider the senior user's financial success or the junior user's advertising budget to indicate a mark's strength. See *W.W.W. Pharm., Inc. v. Gillette Co.*, 984 F.2d 567, 573 (2d Cir. 1993); *Cusson*, *supra* note 3, at 238.

134. See *Cusson*, *supra* note 3, at 209-10; *supra* note 127 (discussion of courts' modifications of intent factor). Both good- and bad-faith issues should be considered only after assessing whether infringement occurred, and ultimately should influence the relief awarded, if any, to the infringed-upon party. See *Big O Tire Dealers, Inc. v. Goodyear Tire & Rubber Co.*, 561 F.2d 1365, 1373-76 (10th Cir. 1977) (holding defendant's false statements harming plaintiff's reputation influenced damage assessment); *Cusson*, *supra* note 3, at 236-37. Good-faith issues can include whether the junior user researched existing trademarks or relied on counsel before adopting their mark, while bad-faith issues typically consist of the defendant continuing to adopt or use a mark while knowing another user already adopted it. See *Cusson*, *supra* note 3, at 236-37.

proximity of the goods; and degree of consumer perception of the marks' similarity.¹³⁵

IV. CONCLUSION

American trademark law, unlike copyright and patent law, has yet to be adequately overhauled and updated; even more egregious is that other areas of trademark, such as fame and cybersquatting doctrines, have had statutorily imposed multifactor tests. As society evolves, one of the courts' main functions is to establish applicable legal parameters to promote fairness and efficiency. By failing to recognize reverse confusion or refusing to modify existing forward-confusion analyses, courts not only deprive many small businesses—hallmarks of our economy—from a cause of action to defend their marks against larger users, but also hinder consumers from making informed decisions in choosing products. Creating and implementing a more uniform reverse-confusion framework will not only improve judicial economy in trademark law, but will also reduce forum shopping and improve consumer confidence in our economic and legal systems.

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135. See *supra* Part III.B (explaining rationale for adopting uniform reverse-confusion analysis).