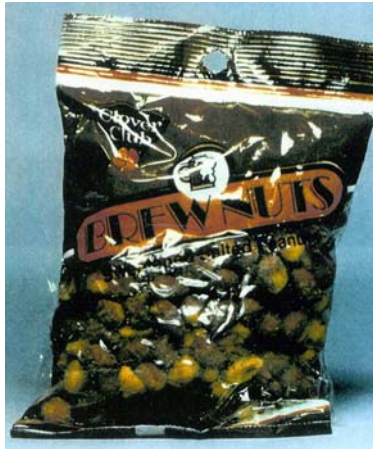


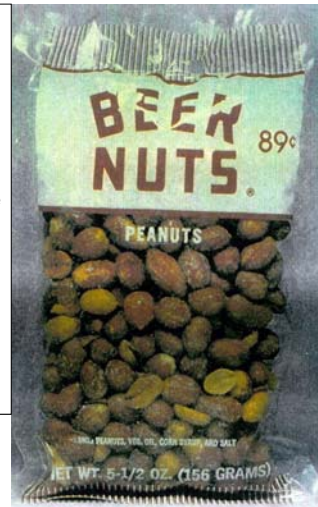
Overview of Trademark Infringement

- Actionable use
- Likelihood of confusion
 - Forward confusion
 - Initial interest confusion
 - Post-sale confusion
 - Reverse confusion
 - Section 2(d) confusion
- Likelihood of dilution
 - Dilution by blurring
 - Dilution by tarnishment
- UDRP / cybersquatting
- Contributory infringement

Likelihood of Confusion HYPO



1. strength of the mark
2. proximity of the goods
3. similarity of the marks
4. evidence of actual confusion
5. marketing channels used
6. type of goods and the degree of care likely to be exercised by the purchaser
7. defendant's intent in selecting the mark
8. likelihood of expansion of the product lines



Types of confusion

- Confusion as to the products
 - Confusion leading to purchase of infringer's product when trademark ("TM") owner sells the same product
- Confusion as to source
 - Infringer uses TM owner's mark on products the TM owner does not sell at all
 - Two possible types of harm: (i) potentially inferior quality of infringer's products; (ii) if TM owner expands into product area where infringer sells, very high chance of likelihood of confusion
- Confusion as to sponsorship
 - For example, United States Olympic Committee label on soup
- Initial interest confusion
 - Confusion that is dispelled before purchase occurs
- Post-sale confusion
 - Confusion after the sale of a product
- Reverse Confusion
 - A large company adopts the mark of a smaller TM owner
 - Risk is not junior user trading on goodwill of senior, but that the public comes to associate the mark not with its true owner, but with the infringing junior user who may have spent a lot of money to advertise it



Six aspects of “use in commerce”:

1. Commerce clause limitation
2. Establishing priority [**in the earlier list entitled “Use in commerce modalities”, related to “requirement for exclusive rights”**]
(actual use for common law rights; actual or constructive use for rights under federal registration)
3. Establishing ownership (who is the “user”?) [**in the earlier list entitled “Use in commerce modalities”, related to “requirement for exclusive rights”**]
4. Determining whether a mark has been abandoned (when does “use” stop?)
5. Determining types of actionable use
 - Did the defendant “use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services...” (“...on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive”)?
6. Determining “fair use” [**additional to the earlier list entitled “Use in commerce modalities”**]

Section 45 Definition of “Use in Commerce”

The term “use in commerce” means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this chapter, a mark shall be deemed to be in use in commerce—

(1) on goods when—

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and

(B) the goods are sold or transported in commerce, and

(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

(NB: The general view is that this definition was written to establish only what a plaintiff must do to establish trademark rights, not what a defendant must do to infringe those rights.)

Rescuecom Corp. v. Google Inc., 562 F.3d 123 (2d Cir. 2009)

- Two issues in Google keyword advertising litigation:

1. Is Google making a use in commerce? (*Rescuecom*)
2. Is this use in commerce likely to cause confusion? (*Network Automation v. Advanced Systems Concepts*, 638 F.3d 1137 (9th Cir. 2011))

unassigned

The screenshot shows a Google search for the keyword "flowers". The search results page includes a "search query" box, a "Results 1 - 10 of about 265,000,000 for flowers [definition] (0.08 seconds)" header, and a list of search results. The results are categorized into "Sponsored Links" and "Sponsored Links". The "Sponsored Links" section includes several advertisements for flower delivery services, such as "Save \$10 on Flowers Today" and "50% Off All Flowers". The "Sponsored Links" section also includes a "paid ads" label. The "Sponsored Links" section also includes a "paid ads" label. The "Sponsored Links" section also includes a "paid ads" label. The "Sponsored Links" section also includes a "paid ads" label.



flowers



unassigned

Search

About 865,000,000 results (0.31 seconds)

Web

Images

Maps

Videos

News

Shopping

More

New York, NY

Change location

Show search tools

Ads related to flowers

Flowers at 1-800-FLOWERS® - Same Day Delivery Available.

www.1800flowers.com/Flowers

100% Satisfaction at 1-800-FLOWERS

469 people +1'd or follow 1800Flowers.com

Same Day Delivery Sympathy & Funeral

Best Selling Flowers & Gifts Celebrate Fall

FTD® Flowers for \$19.99 1 (877) 413 0481

www.ftd.com/

Guaranteed Delivery on our Freshest **Flowers**. Up to 25% Off - Order Now!

Same Day Delivery - Birthday Shoppe - Sympathy & Funeral - The Sweet Shoppe

\$19.99 - Flowers - Same Day Delivery | fromyouflowers.com

www.fromyouflowers.com/Flowers

FromYouFlowers® "Best Value Florist" - CBS News

472 people +1'd or follow From You Flowers

Birthday Flowers & Gifts - Same Day Delivery - \$19.99 Flowers

FTD.COM - Flowers Online | Roses, Fresh Flowers, Plants and Gift ...

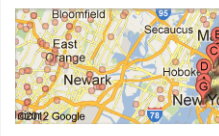
www.ftd.com/

Order **flowers** online for same day floral delivery. Shop for **flowers**, chocolates, roses,

gifts and gift baskets by occasion, season or get beautiful **flower** bouquets ...

Funeral Flowers - Mother's Day Flowers, Plants Under \$35 - Occasion

Map for flowers



Ads

Teleflora® Fresh Flowers

www.teleflora.com/

Beautiful **Flowers**, All \$10 Off.

Local, Same-Day Delivery! Order Now

ProFlowers® - \$19.99

www.proflowers.com/Flowers

★★★★☆ 4,102 seller reviews

Buy Roses, Tulips & other **Flowers**.

"Best Value" - Wall Street Journal

50% Off All Flowers Today

www.bloomstoday.com/

Join Others Who Have Saved 50%.

Plus Get Same Day Delivery!

CNET › News › Relevant Results

Rescuecom drops trademark suit against Google

by Tom Krazit | March 5, 2010 10:44 AM PST

comments 6 Like 5 Tweet 0 +1 0 Share More +

PC support company Rescuecom has dropped a trademark lawsuit against Google, giving it time to defend itself against a similar suit filed by Best Buy.

Rescuecom declared "victory" in a press release Friday, although it wasn't clear if anything had changed since Rescuecom was able to win an appeal of a 2008 decision dismissing its lawsuit over Google's keyword-based ad system. Rescuecom objected to the fact that competitors could buy ads that would appear when Google users searched for "Rescuecom," and was able to convince a federal court last year to rehear the case after it was initially dismissed.



But it will go no further. Rescuecom said it dropped the lawsuit after getting what it wanted out of the process, but the fact that it is currently involved in a dispute against Best Buy--where it is essentially arguing the opposite side of its dispute against Google--might have played into its decision.

Best Buy sued Rescuecom last year for using the term "geek squad" in keyword advertising, which Rescuecom has defended as an appropriate use of another company's trademarks in "comparative advertising." Eric Goldman, a professor at Santa Clara University who follows online trademark disputes closely, was quoted earlier this year by Online Media Daily as calling Rescuecom's position with Best Buy as "inherently inconsistent" with its position regarding Google, where it argued that Google did not have the right to sell its trademark to competitors.

Google released a statement on the dismissal. "As we've consistently maintained, Google's trademark policy strikes the proper balance between trademark owners' interests and consumer choice, and now even Rescuecom concedes that it's legally entitled to use a competitor's trademark as a keyword trigger. We're pleased to see Rescuecom finally affirm our position by dismissing their claims."

unassigned

Rescuecom Corp. v. Google, 562 F.3d 123 (2d Cir. 2009)

unassigned

- Google
 - AdWords
 - Keyword Suggestion Tool
- Upon search, sponsored link or relevant result?
 - Differences from 1-800
 - Website address, not mark, or descriptive terms
 - Advertisers could not request or purchase keywords
 - Internal use
- Sufficient allegations that it is “trademark use”



Portion of the Google AdWords FAQ, Trademark section, from 1/20/2008

Trademark Complaints
As a provider of space for advertisements, Google is not in a position to arbitrate trademark disputes between advertisers and trademark owners. As stated in our Terms and Conditions, advertisers are responsible for the keywords and ad text that they choose to use. Accordingly, Google encourages trademark owners to resolve their disputes directly with the advertiser, particularly because the advertiser may also be using your trademark on similar ads in other programs.

However, Google takes allegations of trademark infringement very seriously and, as a courtesy, we're happy to investigate matters raised by trademark owners. You are not required to be a Google AdWords advertiser in order to send a complaint.

If you have concerns about the **use of your trademark in AdWords ads**:

- [File a trademark complaint in the U.S. or Canada](#)
- [File a trademark complaint outside the U.S. and Canada](#)

If you have concerns about the **use of your trademark in a parked domain name**:

- [File an AdSense for Domains trademark complaint](#)

Once Google receives all of the required information from the trademark owner, the claim will be investigated, and appropriate action will be taken.

Please note: Such trademark investigations will only affect ads served on or by Google. In the case of an AdSense for Domains trademark complaint, an investigation will affect only the domain names of sites in our AdSense for Domains program. Additionally, **Google's trademark policy does not apply to search results, only to sponsored links**. For trademark concerns about websites that appear in Google search results, the trademark owner should contact the site owner directly.

Bosley Medical Institute, Inc. v. Kremer, 403 F.3d 672 (9th Cir. 2005)

The screenshot shows the Bosley Medical website. At the top, there is a navigation bar with links for 'About Hair Loss', 'Bosley Solutions', 'Bosley Results', 'Bosley Locations', and 'Bosley News'. Below this is a large banner with the text 'No cost. No commitment. No questions unanswered.' and a call to action 'Schedule a free consultation today on Bosley.com'. Below the banner are two video thumbnails: 'WATCH PATIENT VIDEOS' and 'WATCH DOCTOR VIDEOS'. To the right of these videos is a 'FREE \$250' offer. At the bottom, there is a section titled 'Experiencing Hair Loss? Thought about Hair Transplant Surgery? We can help.' followed by a paragraph of text and a list of two facts about hair loss.

The screenshot shows a section of the Bosley Medical website titled 'Bosley Medical Violations'. It contains several updates and news items:

- Targeting Your Inbox:** Consumers need to be wary before ordering the Bosley information kit (essentially an extended version of their information) as they will be treated as a sales lead. The information that consumers provide will not then go for an endless amount of open email, solicitations, and even telephone calls from Bosley salespeople.
- Surgical Drawbacks:** Finally some honesty, not from the Bosley website but from their affiliate the Adams Research Institute. They outline what a bad option surgery can be stating that with Bosley's type of surgery, "there often isn't enough hair on the back of the head to make up for the loss on top, leaving the client with a make-do patchwork of thinly implanted follicles" (adamsresearch.com/science.html).
- FTC Settles Charges Against Bosley (June 2012):** The Federal Trade Commission has imposed restrictions on Bosley after alleging it shared pricing information with competitors (an illegal practice that can result in higher prices for consumers). For details see www.ftc.gov/opa/2012/06/advertis.shtml.
- On a related note:** Bosley's parent company Adams of Japan has acquired Hair Club, known for their infomercial-marketed hair systems.
- Consumer Alert!** Five-Time Patients: Desperate for sales Bosley continues to produce simplistic and misleading ads to try to get consumers into the operating chair while not disclosing the known risks and pitfalls of surgery or advising that the best choice may be to wait for upcoming medical advancements. Bosley's Medical Director on impending new treatments (hair multiplication): "It is the thing people have been waiting for. There have been so many remedies for hair loss that didn't pan out. This is one that really looks like it is going to happen, and happen in the next few years". Compromised blood supply, decreased scalp vascularity, accelerated hair loss, the need for additional surgeries... these are all side effects of current Bosley procedures plus they can damage your ability to benefit from alternative treatments and future medical advancements. (see Procedures page)
- Adams Research Institute: Hair Regeneration Available by 2014.** The Adams Research Institute has come out with a timeline for finishing testing and bringing to market its i-J-Gem hair regeneration method. They have indicated a target date of early 2014. Hair regeneration can generate an unlimited number of hairs from an individual's own hair cells. The process is currently undergoing Phase Two testing. It is interesting to note that patients who have undergone previous conventional hair transplant surgery have been banned from clinical trials. ARS and Bosley are owned by the same company, Adams Co. of Japan. (see link on Resources page)

Summary

- *Rescuecom* established that keyword advertising constitutes a use in commerce.
- *Bosley Medical* stands for the proposition that non-commercial uses of trademarks are not actionable under the Lanham Act
 - Non-commercial uses are uses that are not made “in connection with the sale, offering for sale, distribution, or advertising of any goods or services”

Likelihood of Confusion HYPO



1. strength of the mark
2. proximity of the goods
3. similarity of the marks
4. evidence of actual confusion
5. marketing channels used
6. type of goods and the degree of care likely to be exercised by the purchaser
7. defendant's intent in selecting the mark
8. likelihood of expansion of the product lines

Suave



TABLE I
FACTORS CONSIDERED BY CIRCUIT

Factor	Circuit (Numbers in parentheses indicate the number of the factor in that circuit)											D.C.	Fed.	Total circuits considering the factor	Restatement (First) Torts Factors	Restatement (Third) Unfair Competition Factors
	1	2	3	4	5	6	7	8	9	10	11					
1 Similarity of the marks	(1)	(2)	(1)	(2)	(2)	(3)	(1)	(2)	(1)	(1)	(2)	(2)	(1)	13	§ 729(a)	§ 21(a)
2 Proximity of the goods	(2)	(3)	(9)	(3)	(3)	(2)	(2)	(3)	(3)	(4)**	(3)	(3)	(2)	13	§ 731(a),(c)	--
3 Evidence of actual confusion	(6)	(5)	(6)	(7)	(7)	(4)	(6)	(5)	(7)	(3)	(7)	(5)	(7)	13	--	§ 23(1)
4 Strength of plaintiff's mark	(8)	(1)	(2)	(1)	(1)	(1)	(5)	(1)	(2)	(6)	(1)	(1)	(5)	13	§ 731(f)	§ 21(d)
5 Defendant's intent	(7)	(6)	(5)	(6)	(6)	(7)	(7)	(4)	(6)	(2)	(6)	(6)	--	12	§§ 729(b), 731(i)	§ 22
6 Sophistication of the consumers	(5)	(8)	(3)	--	--	(6)	(4)	(6)	(5)	(5)	--	(8)	(4)	10	§§ 729(d), 731(g)	§ 21(e)
7 Similarity of advertising methods, marketing methods	(4)	--	(7)	(5)	(5)	(3)*	--	(4)	(4)**	(5)	--	--	--	9	§§ 729(c), 731(d)	§ 21(b)
8 Similarity of sales facilities	(3)	--	--	(4)	(4)	--	(3)*	--	--	(4)	--	(3)	--	6	--	--
9 Likelihood of bridging the gap	--	(4)	(10)	--	--	(8)	--	--	(8)	--	--	(4)	--	5	§ 731(b)	§ 21(e)
10 Comparative quality of the goods	--	(7)	--	--	--	--	--	--	--	--	--	(7)	--	2	--	--
11 Length of time of concurrent use without evidence of actual confusion	--	--	(4)	--	--	--	--	--	--	--	--	--	(8)	2	§ 731(b)	§ 23(2)
12 Extent to which targets of parties' sales efforts are the same	--	--	(8)	--	--	--	--	--	--	--	--	--	--	1	§ 731(c)	--
13 Third-party uses of plaintiff's mark	--	--	--	--	--	--	--	--	--	--	--	--	(6)	1	--	--
14 Variety of goods on which mark is used	--	--	--	--	--	--	--	--	--	--	--	--	(9)	1	--	--
15 Market interface between applicant and owner of prior mark	--	--	--	--	--	--	--	--	--	--	--	--	(10)	1	--	--
16 Extent of applicant's right to exclude	--	--	--	--	--	--	--	--	--	--	--	--	(11)	1	--	--
17 Extent of potential confusion, i.e., whether de minimis or substantial	--	--	--	--	--	--	--	--	--	--	--	--	(12)	1	--	--
18 Any other established fact probative of effect of use	--	--	--	--	--	--	--	--	--	--	--	--	(13)	1	--	--
19 Strength of plaintiff's mark in defendant's geographically-distinct market	--	--	--	--	--	--	--	--	--	--	--	--	--	--	--	21(f)
Total factors considered:	8	8	10	7	7	8	7	6	8	6	7	8	13		10	9

* The Seventh Circuit tends to consider both the similarity of advertising methods and the similarity of sales facilities under factor three. **The Tenth Circuit considers in factor four the "similarity of products and manner of marketing."

Virgin Enterprises Ltd. v. Nawab, 335 F.3d 141 (2d Cir. 2003)

The screenshot shows the Virgin Mobile website interface. At the top, there's a navigation bar with 'Pay As You Go', 'How It Works', 'Great Rates', 'Get a Phone', 'Accessories', 'Ringtones & More', 'Top-Up', 'Activate', 'Help', and 'En Español'. A shopping cart icon shows '0 items in your Shopping Cart'. Below the navigation is a 'User Central' section with a login form for 'Already a Paygoist?' and an 'Activate a Phone' button. The main content area features a large advertisement for 'Virgin Mobile FITS ANY STYLE' with a woman's image and the text 'Pay Day2Day ALWAYS 10¢ per minute for just 35¢ a day. No Long-Term Contracts. Great Rates. Pay On Your Terms.' To the right is a 'Special Online Offer' for a 'shorty' Nokia phone for '\$39.99'. At the bottom, there are four smaller promotional boxes: 'Check the Phones', 'Great Rates', 'FirstDibs Ringtones', and 'Limited Edition Faceplates'. The footer contains 'Store locator', 'ipcode', 'go', 'Track order | Search', 'About Virgin Mobile | Jobs | Privacy policy | Legal info', and '© Virgin Mobile USA, LLC 2002-2005. All Rights Reserved.'

The two-dimensional model of trademark scope

