

Lemley & McKenna, Irrelevant Confusion

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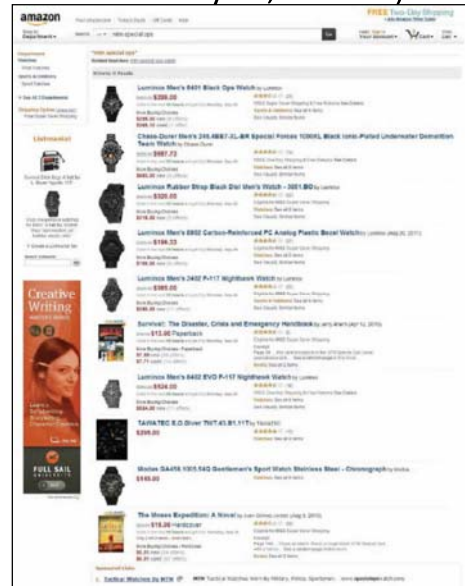
[W]e argue that courts can begin to rein in some of these excesses by focusing their attention on confusion that is actually relevant to purchasing decisions. Uses of a trademark that cause confusion about actual source or about responsibility for quality will often impact purchasing decisions, so courts should presume materiality and impose liability when there is evidence such confusion is likely. Uses alleged to cause confusion about more nebulous relationships, on the other hand, are more analogous to false advertising claims, and those uses should be actionable only when a plaintiff can prove the alleged confusion is material to consumers' decision making.

Louisiana State University v. Smack Apparel Co. (5th Cir. 2008)

- Follow *Boston Hockey* or *Rainbow for Girls*?
- “Universities exercise stringent control over the use of their marks on apparel through their licensing program. It is also undisputed that the Universities annually sell millions of dollars worth of licensed apparel. We further recognize the public’s indisputable desire to associate with college sports teams by wearing team-related apparel.”

Multi Time Machine v. Amazon.com (9th Cir. July 6, 2015)

- Amazon does not carry MTM watches
- But search on Amazon for MTM watches generates results
- Initial interest confusion for Luminox watch?
- Dist. Ct. found no LofC, but 9th disagrees
- Applies 8 *Sleekcraft* factors
- Initial interest
- Possible inference of affiliation between Luminox/competitor and MTM
- Dissent



initial interest and trade dress

- Sixth Circuit declined to apply initial interest confusion to trade dress
 - Why?
- Might pick a penumbra of shapes not otherwise qualifying for trademark protection

Int. Cl.: 15

Prior U.S. Cl.: 36

United States Patent and Trademark Office Reg. No. 1,782,606
Registered July 20, 1993

TRADEMARK
PRINCIPAL REGISTER



Gibson Les Paul



PRS

GIBSON GUITAR CORP. (DELAWARE CORPORATION)
P.O. BOX 10987
441 MASSMAN DRIVE
NASHVILLE, TN 37210

FOR GUITARS, IN CLASS 15 (U.S. CL. 36)
FIRST USE 12-0-1952; IN COMMERCE
12-0-1952.
THE LINING OF THE DRAWING IS NOT IN-
TENDED TO INDICATE COLOR.

THE MARK CONSISTS OF A UNIQUELY
SHAPED CONFIGURATION FOR THE BODY
PORTION OF THE GUITAR AS ILLUSTRATED
IN THE DRAWING BY THE SOLID LINES.
SEC. 3P3.

SER. NO. 71-675,665, FILED 7-31-1997.
MARY FRANCES BRUCE, EXAMINING AT-
TORNEY

Reverse Passing Off

- involves situations in which a “defendant falsely takes credit for another’s goods or services”
- Policy considerations with other areas of IP

Int. Cl.: 28

Prior U.S. Cls.: 22, 23, 38, and 50

Reg. No. 3,619,662

United States Patent and Trademark Office Registered May 12, 2009

TRADEMARK
PRINCIPAL REGISTER



DISNEY ENTERPRISES, INC. (DELAWARE CORPORATION)
500 SOUTH BUENA VISTA STREET
BURBANK, CA 91521

FOR: GAMES, NAMELY, ACTION SKILL GAMES, BOARD GAMES, MANIPULATIVE GAMES; PLAYTHINGS, NAMELY, ACTION FIGURES AND ACCESSORIES THEREFOR, BEAN BAG DOLLS, PLUSH TOYS, BATH TOYS, BUILDING BLOCKS, DOLLS AND DOLL CLOTHING, DOLL PLAYSETS, CRIB TOYS, ELECTRIC ACTION TOYS, PARTY FAVORS IN THE NATURE OF SMALL TOYS, MULTIPLE ACTIVITY TOYS, WIND-UP TOYS, TOY VEHICLES, TOY CARS, TOY TRUCKS,

TOY ROCKETS, MUSICAL TOYS, TOY FIGURINES, PUPPETS, FACE MASKS, HAND-HELD UNITS FOR PLAYING ELECTRONIC GAMES, IN CLASS 28 (U.S. CLS. 22, 23, 38 AND 50).

FIRST USE 3-28-2008; IN COMMERCE 3-28-2008.

OWNER OF U.S. REG. NOS. 2,461,981, 2,781,641, AND OTHERS.

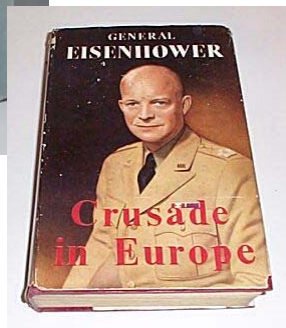
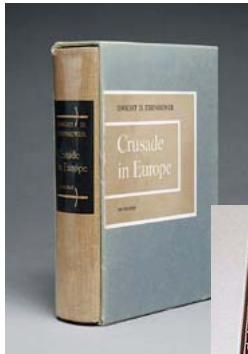
SN 76-588,173, FILED 4-19-2004.

TEJBIR SINGH, EXAMINING ATTORNEY

Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23 (2003)

- “Dastar manufactured and sold the Campaigns video set as its own product. The advertising states: “Produced and Distributed by: *Entertainment Distributing*” (which is owned by Dastar), and makes no reference to the Crusade television series. Similarly, the screen credits state “DASTAR CORP presents” and “an ENTERTAINMENT DISTRIBUTING Production,” and list as executive producer, producer, and associate producer employees of Dastar. Supp.App. 2–3, 30. The Campaigns videos themselves also make no reference to the Crusade television series, New Line’s Crusade videotapes, or the book. Dastar sells its Campaigns videos to Sam’s Club, Costco, Best Buy, and other retailers and mail-order companies for \$25 per set, substantially less than New Line’s video set.”
- Fox wins under copyright and Lanham act claim in the district court; 9th reverses on the copyright claim (renewal was in question for pre-1976 act copyright); 9th affirms under the Lanham act claim
- Lanham act provision in 43(a)
 - “a false designation of origin, or any false description or representation” in connection with “any goods or services.”
 - What is meant by “origin of the goods”?

Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 205 (2003)



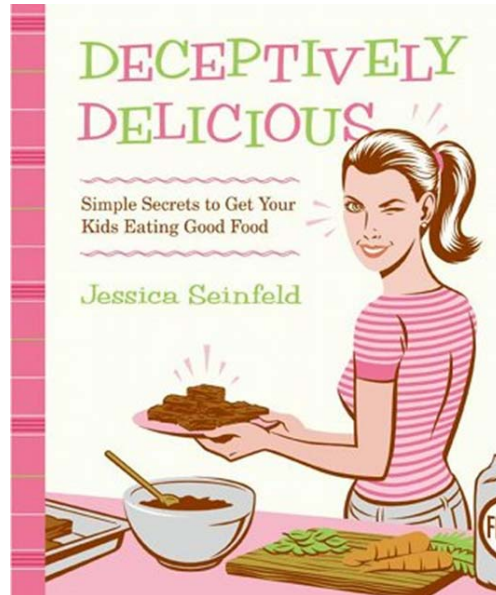
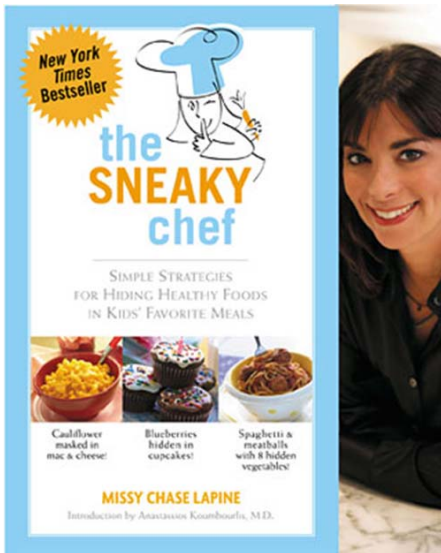
Gilliam v. ABC, 538 F.2d 14 (2d Cir. 1976)

- Provides moral rights-like remedies through Section 43(a) of the Lanham Act
 - Theory is that the television network mutilated the work to such an extent that the network falsely identified the plaintiff as the author of the work
- Moral rights are a type of copyright-like right associated with European legal systems
 - Right of integrity
 - Right of attribution



additional material above
and beyond casebook

LaPine v. Seinfeld (S.D.N.Y. 2009)



Bretford Mfg., Inc. v. Smith System Mfg. Corp., 419 F.3d 576 (7th Cir. 2005)



Bretford Mfg., Inc. v. Smith System Mfg. Corp., 419 F.3d 576, 580-81 (7th Cir. 2005)

“No one makes a product from scratch, with trees and iron ore entering one end of the plant and a finished consumer product emerging at the other. Ford's cars include Fram oil filters, Goodyear tires, Owens-Corning glass, Bose radios, Pennzoil lubricants, and many other constituents; buyers can see some of the other producers' marks (those on the radio and tires for example) but not others, such as the oil and transmission fluid. Smith System builds tables using wood from one supplier, grommets (including Teflon from du Pont) from another, and vinyl molding and paint and bolts from any of a hundred more sources-the list is extensive even for a simple product such as a table. If Smith System does not tell du Pont how the Teflon is used, and does not inform its consumers which firm supplied the wood, has it violated the Lanham Act? Surely not; the statute does not condemn the way in which all products are made.”

Lanham Act § 2(d) Confusion

- “The PTO’s test for determining whether Lanham Act § 2(d) bars a registration is essentially the same as the multifactor test for the likelihood of confusion in the federal court litigation context”
- Factor treatment from TMEP