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Likelihood of Confusion Determinations: A Survey of Eleventh Circuit Jurisprudence

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LIKELIHOOD OF CONFUSION DETERMINATIONS: A SURVEY OF ELEVENTH CIRCUIT JURISPRUDENCE

Theodore H. Davis, Jr.*

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INTRODUCTION

Section 32 of the Lanham Act creates a cause of action on behalf of the owner of a federally registered trademark, service mark, collective mark, certification mark, or trade dress against anyone who, without consent, uses in interstate commerce a "reproduction, counterfeit, copy, or colorable imitation" of the registered mark or trade dress. Similarly, section 43(a) of the Act allows the owners

1 The relevant text reads:

Any person who shall, without the consent of the registrant
(a) 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; or
(b) reproduce, counterfeit, copy, or colorably imitate a registered mark
and apply such reproduction, counterfeit, copy, or colorable imitation to
labels, signs, prints, packages, wrappers, receptacles or advertisements
intended to be used in commerce upon or in connection with the offering
for sale, distribution, or advertising of goods or services on or in
connection with which such use is likely to cause confusion, or to cause
mistake, or to deceive,
shall be liable in a civil action by the registrant for the remedies
hereinafter provided.


Under the federal Lanham Act, Pub. L. No. 79-489, 60 Stat. 427 (1946), codified as amended at 15 U.S.C. §§ 1051-1127 (1988 & Supp. V 1993) [hereinafter "the Act"], a "trademark" may be "any word, name, symbol, or device, or any combination thereof" that may be used by its owner "to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." In contrast, a "certification mark" is a mark that certifies such things as a product's regional origin or mode of manufacture, while "collective marks" include designations indicating membership in a union, an association, or other organization. 15 U.S.C. § 1127 (1988 & Supp. V 1993). Consistent with the terminology employed by the Lanham Act, see, e.g., id., the term "marks" as used in this Article collectively refers to all of these designations unless otherwise noted.

In contrast to the types of marks discussed immediately supra, which are expressly defined by the Act, the concept of protectable "trade dress" is largely a judicial creation. "Trade dress' is defined as 'the total image of a product and may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques.'" AmBrit, Inc. v. Kraft, Inc., 812 F.2d 1531, 1535, 1 U.S.P.Q.2d (BNA) 1161, 1164 (11th Cir. 1986) (quoting John Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 980, 219 U.S.P.Q. (BNA) 515, 529 (11th Cir. 1983)), cert. denied, 481 U.S. 1041 (1987). Although, like trademarks, service marks, collective marks, and certification marks, trade dresses may be federally registered, see, e.g., McDonald’s Corp. v. Moore, 363 F.2d 435, 435, 150 U.S.P.Q. (BNA) 488, 489 (5th Cir. 1966) (permitting federal registration of yellow parabolic arches
of registered or unregistered marks or trade dresses to bring infringement actions against defendants using "false designation[s] of origin." Successful plaintiffs under these sections may enjoy

used in design of plaintiff's buildings), the majority of trade dress infringement cases involve owners of unregistered trade dresses proceeding under section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) (1988 & Supp. V 1993) [hereinafter "section 43(a)"]. For the text of this provision, see infra note 2.

The relevant text reads:

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which——

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.


In contrast to section 32, which provides for a cause of action only against the infringement of registered marks and trade dresses, section 43(a) allows for the owners of both registered and unregistered designsations of origin. Although the owner of a registered mark or trade dress may therefore seek protection under section 43(a), see, e.g., University of Ga. Athletic Ass'n v. Laite, 756 F.2d 1535, 1537-38, 225 U.S.P.Q. (BNA) 1122, 1123 (11th Cir. 1985) (unregistered design mark), the provision also is frequently invoked by owners of unregistered trade dresses. See, e.g., Bauer Lamp Co. v. Shaffer, 941 F.2d 1165, 1167-68, 20 U.S.P.Q.2d (BNA) 1128, 1129 (11th Cir. 1991) (per curiam) (product configuration of lamp); John H. Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 970-71, 219 U.S.P.Q. (BNA) 515, 519 (11th Cir. 1987) (configuration of check stub); Original Appalachian Artworks, Inc. v. Toy Loft, Inc., 884 F.2d 821, 831, 215 U.S.P.Q. (BNA) 745, 754 (11th Cir. 1982) (selling techniques); Sun-Fun Frods., Inc. v. Suntan Research & Dev. Inc., 656 F.2d 186, 192, 213 U.S.P.Q. (BNA) 91, 95 (5th Cir. Unit B 1981) (appearance of suntan lotion bottle); Alum-A-Fold Shutter Corp. v. Folding Shutter Corp., 441 F.2d 556, 556-57, 170 U.S.P.Q. (BNA) 68, 68 (5th Cir. 1971) (configuration of folding aluminum shutters).

Notwithstanding the availability of section 43(a), however, a would-be plaintiff's decision not to register its mark or trade dress is not without its costs. More specifically, an unregistered user seeking to enjoin a competitor's misappropriation of its mark or trade dress must, prior to demonstrating infringement, establish that the mark or trade dress serves as a distinct indicator of origin for its goods or services in that it either is (a) inherently distinctive; or (b) has acquired a unique association with the plaintiff, or so-called "secondary meaning." See generally Laite, 756 F.2d at 1540-41, 225 U.S.P.Q. (BNA) at 1126-27 (plaintiff must prove secondary meaning when protection is sought for descriptive mark); see also Soweco, Inc. v. Shell Oil Co., 617 F.2d 1178, 1184, 207 U.S.P.Q. (BNA) 278, 283 (5th Cir. 1980), cert. denied, 450 U.S. 981 (1981); American Heritage Life Ins. Co. v. Heritage Life
the remedies provided for in section 34 of the Act subject to "the principles of equity and upon such terms as the court may deem reasonable."3

The test for determining if a particular defendant has violated either section 32 or section 43(a) is whether the defendant's actions have created a likelihood of confusion that its goods or services are produced, sponsored, certified, or approved by the plaintiff or, alternatively, that the plaintiff's goods are produced, sponsored, certified, or approved by the defendant.4 Whether the defendant's use of its mark is, in fact, likely to result in any of these types of confusion typically turns on an examination of the entire context in which the parties use their marks.5

This Article surveys applications by the United States Court of Appeals for the Eleventh Circuit and its predecessor court, the

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Ins. Co., 494 F.2d 3, 11, 182 U.S.P.Q. (BNA) 77, 82 (5th Cir. 1974). Beyond these requirements, a plaintiff seeking to protect an unregistered trade dress bears the additional burden of demonstrating that the trade dress is "nonfunctional," or, in other words, unnecessary for competitors to use to compete effectively. See, e.g., Bauer Lamp, 941 F.2d at 1170, 20 U.S.P.Q.2d (BNA) at 1131 (per curiam) (plaintiff must prove 3 elements to establish trade dress infringement: secondary meaning, that features are nonfunctional and that two products are confusingly similar). On these requirements generally, see infra notes 141-186 and accompanying text.


4 "[F]alsely suggesting affiliation with the trademark owner in a manner likely to cause confusion as to source or sponsorship constitutes infringement." Professional Golfers Ass'n v. Bankers Life & Casualty Co., 514 F.2d 665, 670, 186 U.S.P.Q. (BNA) 447, 461 (5th Cir. 1975) (quoting World Carpets, Inc. v. Dick Littrell's New World Carpets, 438 F.2d 482, 488, 168 U.S.P.Q. (BNA) 609, 614 (5th Cir. 1971)); see also Kentucky Fried Chicken Corp. v. Diversified Packaging Corp., 549 F.2d 368, 388, 193 U.S.P.Q. (BNA) 649, 667 (5th Cir. 1977) ("Trademark infringement occurs . . . when the use sought to be enjoined is likely to confuse purchasers with respect to such things as the product's source, its endorsement by the plaintiff, or its connection with the plaintiff."); cf. Jellibeans, Inc. v. Skating Clubs, 716 F.2d 833, 839, 222 U.S.P.Q. (BNA) 10, 16 (11th Cir. 1983) (holding that no cognizable distinction exists between tests for infringement under sections 32 and 43(a)).

The usual case presenting allegations of infringement involves a smaller defendant accused of having appropriated the good will of a larger user's mark. Under the doctrine of "reverse confusion," however, infringement also occurs whenever consumers are likely to believe the goods or services of a first user are actually those of a second, larger entrant into a market. To protect the rights of both the public and smaller companies, "[r]everse confusion has now become a recognized doctrine within the scope of unfair competition . . . ." Capital Films Corp. v. Charles Fries Prods., Inc., 628 F.2d 387, 393, 208 U.S.P.Q. (BNA) 249, 253 (5th Cir. 1980).

5 See infra notes 21-23 and accompanying text.
former United States Court of Appeals for the Fifth Circuit, of likelihood of confusion doctrine under section 32 and section 43(a), as well as under the common law. This Article first traces the evolution of the court’s conception of the likelihood of confusion test from the test’s early origins under the common law of infringement to its current doctrinal formulation under the Lanham Act. Part Two of the Article then examines the varying treatments accorded by the court to each of the factors in its modern multifactored likelihood of confusion analysis.

I. LIKELIHOOD OF CONFUSION DOCTRINE IN HISTORICAL PERSPECTIVE

A. LIKELIHOOD OF CONFUSION DETERMINATIONS BEFORE ROTO-ROOTER

Under the common law, a cause of action existed (and continues to exist) for the "palming off" of products or, in other words, for the misrepresentation of the source of one's goods or services through the use of a mark or trade dress confusingly similar to that of a
competitor. As the Supreme Court summarized this rule in 1891:

The first appropriator of a name or device pointing to his ownership, or which, by being associated with articles of trade, has acquired an understood reference to the originator or manufacturer of the articles, is injured whenever another adopts the same name or device for similar articles, because such adoption is, in effect, representing falsely that the productions of the latter are those of the former. Thus the custom and advantages to which the enterprise and skill of the first appropriator had given him a just right are abstracted for another's use, and this is done by deceiving the public, by inducing the public to purchase the goods and manufactures of one person supposing them to be those of another.⁷

Notwithstanding widespread judicial recognition of this general rule of law by state courts within the former Fifth Circuit, their decisions provided little guidance to the factors properly governing determinations of whether infringement existed. To the extent that these courts addressed the issue, their treatment was similar to that of the Georgia Supreme Court, which adhered to the position that “[t]he principle on which courts of equity proceed in restraining the simulation of names is not that there is property acquired by one party in the name, but to prevent fraud and deception . . . [by] the party charged with the simulation of a name used by another . . . .”⁸ Consequently, these courts generally limited injunctive relief against infringement to those situations in which the defendant sought intentionally to “pass off” its goods as those of the plaintiff:

[Unfair competition] is the palming off by one of his goods as the goods of another, and nothing less than conduct tending to pass off one man's goods or business as the goods or business of another will

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constitute unfair competition. The basic principle of the law of unfair competition is that no one has a right to dress up his goods or business or otherwise represent the same in such a manner as to deceive an intending purchaser and induce him to believe he is buying the goods of another, and that no one has a right to avail himself of another's favorable reputation in order to sell his own goods.  

Consistent with this doctrinal framework, early applications of the common law of unfair competition by the former Fifth Circuit also placed heavy emphasis on the presence or absence of a defendant's malignant intent. Thus, for example, in Continental Insurance Co. v. Continental Fire Ass'n, the court upheld the denial of a preliminary injunction in a dispute between two insurance companies after finding that "[t]he word 'Continental' as a part of the defendant's corporate name has not deceived anybody, and was not adopted for the purpose of deceiving anybody." In contrast, however, the court upheld entry of a preliminary injunction in Vick Medicine Co. v. Vick Chemical Co. on the basis of the trial court's determination that "the moving cause for the adoption of [the infringing mark] was to obtain the benefit of the widespread publicity of that name, resulting from the money and efforts of the appellee, and for the purpose of appropriating a part of the good will of the appellee."  

Although this early test for infringement focused almost exclusively on the defendant's affirmative intent (or lack thereof) to deceive consumers, the court gradually drifted away from this strict "passing off" standard beginning in the 1930s. In the 1937 case of

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9 Id. at 213.  
10 101 F. 255 (5th Cir. 1900).  
11 Id. at 256.  
12 11 F.2d 33 (5th Cir. 1926).  
13 Id. at 34-35; see also Centaur Co. v. Hughes Bros., 91 F. 901, 904 (5th Cir. 1898) (upholding injunction against defendants' use of infringing medicine packaging on ground that "respondents' packages of the remedy have been so bottled, labeled, prepared, and put upon the market, in such form as is calculated to deceive, and does deceive, the public into the belief that they are buying the preparation manufactured and put up by the complainant").
Rhea v. Bacon,\(^\text{14}\) for example, the court upheld entry of injunctive relief on the basis of the defendants' bad faith intent to deceive would-be guests of the plaintiff's hotel.\(^\text{15}\) In doing so, however, the court noted in passing that the defendants had adopted the same decor as the plaintiff's place of business and also catered to the same guest base.\(^\text{16}\) Similarly, in Greyhound Corp. v. Goberna,\(^\text{17}\) a 1942 panel of the court found probative of infringement the engagement by the defendant and plaintiff in the related businesses of conducting tours and transportation, respectively.\(^\text{18}\)

The court's original heavy reliance on a scienter standard for infringement received its final blow with the 1946 passage of the Lanham Act, pursuant to section 22 of which federal registrants enjoy nationwide constructive notice of their ownership of their rights.\(^\text{19}\) Following the enactment of this provision, at least with respect to federally registered marks, the presence or absence of a defendant's good faith became of dramatically reduced consequence.\(^\text{20}\) Despite the demise of the "palming off" test, however, the court did not quickly advance an alternative doctrinal framework to take its place.

B. THE ROTO-ROOTER TEST

The absence of a doctrinal framework governing determinations of whether confusion was likely between two designations of origin continued until the court's 1975 decision in Roto-Rooter Corp. v. O'Neal.\(^\text{21}\) In Roto-Rooter, which involved allegations of infringement of the plaintiff's federally registered ROTO-ROOTER service mark by the defendant's unregistered use of ROTARY DE-ROOTING, the trial court dismissed the plaintiff's case after finding no

\(^{14}\) 87 F.2d 976 (5th Cir. 1937).
\(^{15}\) Id. at 977.
\(^{16}\) Id.
\(^{17}\) 128 F.2d 806, 54 U.S.P.Q. (BNA) 45 (5th Cir. 1942).
\(^{18}\) Id. at 807, 54 U.S.P.Q. (BNA) at 47.
\(^{21}\) 513 F.2d 44, 186 U.S.P.Q. (BNA) 73 (5th Cir. 1975).
“statistically significant” evidence of actual confusion. On appeal, however, the former Fifth Circuit overturned the district court’s heavy reliance on actual confusion as a relevant factor and instead drew upon its prior case law to articulate for the first time a comprehensive multifactored test:

In this circuit likelihood of confusion is determined by evaluating a variety of factors including the type of trademark at issue; similarity of design; similarity of product; identity of retail outlets and purchasers; identity of advertising media utilized; defendant’s intent; and actual confusion. While proof of actual confusion is not required to sustain a claim of infringement, the view of this court is that it is the best evidence of likelihood of confusion.

22 See id. at 45, 186 U.S.P.Q. (BNA) at 74. On defining “actual confusion” and its significance under the court’s modern doctrinal framework, see infra notes 332-376 and accompanying text.

23 513 F.2d at 45-46, 186 U.S.P.Q. (BNA) at 74 (footnotes and citation omitted).

Note that the court generally regards this test as identical to that applied to state law infringement causes of action. See, e.g., University of Ga. Athletic Ass’n v. Laits, 756 F.2d 1535, 1539 n.11, 225 U.S.P.Q. (BNA) 1122, 1131 n.11 (11th Cir. 1985) (applying identical test under federal and Georgia law); see also Conagra, Inc. v. Singleton, 743 F.2d 1508, 1512 n.3, 224 U.S.P.Q. (BNA) 552, 560 n.3 (11th Cir. 1984) (applying identical tests under federal and Florida law).

Subsequent applications of this test by the former Fifth Circuit and Eleventh Circuit have established a two-tiered standard of review for a lower tribunal's determination of whether confusion is likely. Although the former Fifth Circuit held in *B.H. Bunn Co. v. AAA Replacement Parts Co.* that the likelihood of confusion was a mixed question of fact and law, more recent decisions have expressly rejected this view in favor of the proposition that likelihood of confusion determinations are findings of fact. At least in infringement actions, a trial court's resolution of the issue is not to be disturbed unless clearly erroneous.

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24 451 F.2d 1254, 171 U.S.P.Q. (BNA) 780 (5th Cir. 1971).
25 Id. at 1261, 171 U.S.P.Q. (BNA) at 784. This holding subsequently was cited with apparent approval in dictum in American Heritage Life Insurance Co. v. Heritage Life Insurance Co., 494 F.2d 3, 15, 182 U.S.P.Q. (BNA) 77, 85 (5th Cir. 1974) (dictum).
Fifth Circuit has summarized this standard, "we reverse when the result in a particular case does not reflect the truth and the right


Despite this professed deference to the trial court, it is perhaps worth noting that the court has held in one case that an appellant may satisfy the "clearly erroneous" standard more easily if the trial court has merely adopted findings of fact submitted by counsel for the prevailing party. See Amstar, 615 F.2d at 258, 205 U.S.P.Q. (BNA) at 974 ("[W]e can take into account the District Court's lack of personal attention to factual findings in applying the clearly erroneous rule." (quoting Wilson v. Thompson, 593 F.2d 1375, 1384 n.16 (5th Cir. 1979)). In another case, however, the court upheld the ultimate result coming from this methodology, noting that "the scope of appellate review does not change simply because we disapprove the manner in which the court arrived at its findings of fact and conclusions of law. We are bound by the clearly erroneous rule in reference to factual determinations." Professional Golfers Ass'n v. Bankers Life & Casualty Co., 514 F.2d 665, 672, 186 U.S.P.Q. (BNA) 447, 453 (5th Cir. 1975). For commentary on this issue by the primary victims of the court's disapproval of the practice, namely counsel for the unsuccessful appellee in Amstar, see Julius R. Lunsford, Jr. & William R. Cohr, Trademark Protection: Judicial Inconsistency in the Fifth Circuit, 32 MERCER L. REV. 1167, 1228-29 (1981).
The standard is different, however, if the initial determination was made by the federal Patent and Trademark Office ("PTO"). In *Aloe Creme Laboratories, Inc. v. Texas Pharmacal Co.*, for example, the appellant challenged the Assistant Commissioner of Patents' finding that the appellant's marks were confusingly similar to those of a prior federal registrant and therefore not entitled to registration themselves. On the applicant's appeal from this decision, which ultimately reached the former Fifth Circuit, the court distinguished the "clearly erroneous" standard applied to district court determinations, instead adopting a test first articulated by the D.C. Circuit: "In . . . trademark cases 'a finding of fact by the Patent Office as to . . . confusing similarity of marks must be accepted as controlling, unless the contrary is established by evidence "which, in character and amount carries thorough conviction."'" Despite this apparent deference, however, which

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28 Armstrong Cork Co. v. World Carpets, Inc., 597 F.2d 496, 501, 203 U.S.P.Q. (BNA) 19, 24 (5th Cir.), cert. denied, 444 U.S. 932 (1979). See also Swatch Watch, S.A. v. Taxor Inc., 785 F.2d 956, 958, 229 U.S.P.Q. (BNA) 391, 392 (11th Cir. 1986) ("A district court's factual finding is clearly erroneous when, 'although there is evidence to support it, the reviewing court on the entire record is left with the definite and firm conviction that a mistake has been committed.'") (quoting University of Ga. Athletic Ass'n v. Laite, 756 F.2d 1535, 1543, 225 U.S.P.Q. (BNA) 1122, 1128 (11th Cir. 1985)).

29 Under present law, the Trademark Trial and Appeal Board (hereinafter "T.T.A.B." or "Board"), a quasi-judicial panel within the PTO, typically undertakes likelihood of confusion determination under two sets of circumstances. First, an applicant whose mark has been denied federal registration by the PTO on the ground that it is confusingly similar to a prior registered mark, see 15 U.S.C. § 1052(d) (1988), may appeal this finding to the Board in its administrative appellate capacity. Second, the Board may act as a fact-finder in an *inter partes* challenge to the mark's registrability brought by the prior registered mark's owner. *See id.* §§ 1063-64. Prior to 1958, the Commissioner of Patents made these determinations. *See id.* § 1063-64. Prior to 1958, the Commissioner of Patents made these determinations. *See Pub. L. No. 85-609, § 1(a), 72 Stat. 540 (1958) (current version at 15 U.S.C. § 1071 (1988)).

If dissatisfied with the initial registrability determination, parties to *inter partes* proceedings and unsuccessful applicants may appeal to the United States Court of Appeals for the Federal Circuit (formerly the Court of Customs and Patent Appeals), 35 U.S.C. § 1071(a) (1988), or, alternatively, may elect to have their cases heard on a *de novo* basis by a federal district court. *See id.* §§ 1071(b), 1121.

30 335 F.2d 72, 142 U.S.P.Q. (BNA) 289 (5th Cir. 1964).

stems from recognition of the PTO's "expertise" in the area,\textsuperscript{32} in disputes between two parties later engaged in litigation before a district court PTO determinations are not given res judicata or collateral estoppel effect.\textsuperscript{33} Should a district court accept the Board's findings of fact, however, they then become subject to a clearly erroneous standard of review.\textsuperscript{34}


\textsuperscript{33} As the court has justified this rule:

This Circuit has decided that Congress limited the res judicata or collateral estoppel effect to be given the decisions of the TTAB because the Lanham Act provides for extensive judicial involvement in the registration and protection of trademarks. Section 1071(b) of Title 15 U.S.C.A. (1982) empowers courts to hear appeals from the TTAB de novo.

... [T]he ability of courts to hear appeals on a de novo basis reflects a Congressional intent not to invoke the immunizing doctrines of res judicata or collateral estoppel with regard to TTAB proceedings. In this Circuit, a court hearing an infringement claim is not legally and conclusively bound by a prior decision of the TTAB regarding the same trademark dispute.

Freedom Sav. & Loan Ass'n v. Way, 757 F.2d 1176, 1180, 226 U.S.P.Q. (BNA) 123, 125 (11th Cir.) (footnote and citation omitted), cert. denied, 474 U.S. 845 (1985). See also American Heritage, 494 F.2d at 9-10, 182 U.S.P.Q. (BNA) at 81 (extending "thorough conviction" standard "to all findings made by the Patent Office in quasi-judicial, adversarial proceedings between the same parties and emanating from the office’s expertise").

On a somewhat related subject, the court has granted varying weight to state agencies' determinations that a party using a particular name was entitled to do business within their jurisdiction despite a prior user's use of an arguably similar name or mark. Compare Sears, Roebuck & Co. v. All States Life Ins. Co., 246 F.2d 161, 169, 114 U.S.P.Q. (BNA) 19, 23 (5th Cir.) (according great weight to approval of defendant's name by Texas State Board of Insurance Commissioners), cert. denied, 355 U.S. 894 (1957) with Seaboard Fin. Co. v. Martin, 244 F.2d 329, 331-32, 113 U.S.P.Q. (BNA) 362, 364 (5th Cir. 1957) (declining to defer to state's granting of corporate charter to defendant). See also Armstrong Cork Co. v. World Carpets, Inc., 597 F.2d 496, 499, 203 U.S.P.Q. (BNA) 19, 22 (5th Cir.) (addressing possibility that defendant could be enjoined from use of name approved by Delaware Secretary of State), cert. denied, 444 U.S. 932 (1979); cf. Citibank, N.A. v. Citibanc Group, Inc., 724 F.2d 1540, 1545-46, 222 U.S.P.Q. (BNA) 292, 296-97 (11th Cir. 1984) (declining to defer to Federal Reserve Board's failure to object to defendant's use of infringing name).

II. FORMER FIFTH CIRCUIT AND ELEVENTH CIRCUIT APPLICATIONS OF THE LIKELIHOOD OF CONFUSION ANALYSIS

Notwithstanding the apparently rigid doctrinal framework set forth by the Roto-Rooter court, likelihood of confusion determinations are not meant to be inflexible applications of that test. Rather, as the court has noted of its multifactored analysis:

The issue of likelihood of confusion is not determined by merely analyzing whether a majority of the subsidiary factors indicates that such a likelihood exists. Rather, a court must evaluate the weight to be accorded the individual factors and then make its ultimate decision. The appropriate weight to be given to each of these factors varies with the circumstances of the case.35

Importantly, "[t]he [trial] court does not have to consider all of these factors in every case and in some cases, 'new' factors may merit consideration."36 This section examines the court's often inconsistent treatment of the factors deemed important in varying cases.

A. TYPE AND STRENGTH OF THE PLAINTIFF'S MARK

1. Type of Mark.
   a. Word Marks. Consistent with virtually all other circuits,37 the Eleventh Circuit classifies word marks into four general categories:

36 Swatch Watch, S.A. v. Taxor, Inc., 785 F.2d 956, 958, 229 U.S.P.Q. (BNA) 391, 392 (11th Cir. 1986); see also University of Ga. Athletic Ass'n v. Laite, 756 F.2d 1535, 1543, 225 U.S.P.Q. (BNA) 1122, 1128 (11th Cir. 1985) (declining to require trial court's express consideration of each of relevant factors on ground that "[t]he real question is whether the court's ultimate determination about the 'likelihood of confusion' was correct").
Trademarks fall into four categories of strength: (1) generic, (2) descriptive, (3) suggestive, or (4) arbitrary. "Generic" terms are those which name "the genus or class of which an individual article or service is but a member." "Descriptive" terms "identify a characteristic or quality of an article or service." "Suggestive" terms suggest characteristics of the goods and services and "require an effort of the imagination by the consumer in order to be understood as descriptive." "Fanciful" or "arbitrary" terms are words or phrases that bear no direct relationship to the product. Generic terms represent the weaker end of the spectrum, and arbitrary terms represent the stronger.38

Applications of this framework are not always as straightforward as its statement, however, as "[u]se of a word may fall within more than one category; indeed, as a practical matter distinctions between use in one category and use in another may be difficult to make."39 Once made, however, a district court's categorization of


39 Safeway Stores, Inc. v. Safeway Discount Drugs, 675 F.2d 1160, 1163, 216 U.S.P.Q. (BNA) 599, 601 (11th Cir. 1982); see also Investacorp, Inc. v. Arabian Inv. Banking Corp., 931 F.2d 1519, 1522, 19 U.S.P.Q.2d (BNA) 1056, 1058 (11th Cir.) ("The demarcation between each category is more blurred than it is definite."); cert. denied, 112 S. Ct. 639 (1991); Soweco, Inc. v. Shell Oil Co., 617 F.2d 1178, 1183, 207 U.S.P.Q. (BNA) 278, 282 (5th Cir. 1980) ("Although meant as pigeon-holes, these useful labels are instead central tones in a spectrum; they tend to merge at their edges and are frequently difficult to apply."); cert. denied, 450 U.S. 981 (1981); Vision Ctr. v. Opticks, Inc., 596 F.2d 111, 115, 202 U.S.P.Q. (BNA) 333, 338 (5th Cir. 1979) ("These categories . . . are spectrum-like and tend to merge imperceptibly from one to another."); cert. denied, 444 U.S. 1016 (1980).

Obviously, classification of a mark becomes even more difficult if the associated goods or services have evolved over time. See Amstar Corp. v. Domino's Pizza, Inc., 615 F.2d 252, 260 n.8, 205 U.S.P.Q. (BNA) 969, 981 n.8 (5th Cir.) ("At one time, DOMINO as applied to
a mark is regarded as a factual determination\textsuperscript{40} and therefore subject to a clearly erroneous standard of review.\textsuperscript{41}

i. Generic Marks. In the Eleventh Circuit, as in all other jurisdictions, "[a] generic term is typically incapable of achieving [trademark or] service mark protection because it has no distinctiveness."\textsuperscript{42} Consequently, "[a] generic term can never become a trademark, [and] if a registered mark at any time becomes generic with respect to a particular article, the Lanham Act provides for the cancellation of that mark's registration."\textsuperscript{43}

\textsuperscript{40} See Investacorp, 931 F.2d at 1523, 19 U.S.P.Q.2d (BNA) 1056, 1058 ("[T]he distinctiveness categorization given a term is a question of fact."); American Television, 810 F.2d at 1549, 1 U.S.P.Q.2d (BNA) at 2086 (existence of secondary meaning is question of fact).


\textsuperscript{42} See generally Investacorp, 931 F.2d at 1524, 19 U.S.P.Q.2d (BNA) at 1059 ("Although we will bestow proper respect to the determinations of the PTO, we will not defer to an ethereal determination that is not affirmatively stated by the administrative agency.").

\textsuperscript{43} Investacorp at 1522, 19 U.S.P.Q.2d (BNA) at 1058.


\textsuperscript{44} Soweco, Inc. v. Shell Oil Co., 617 F.2d 1178, 1183, 207 U.S.P.Q. (BNA) 278, 283 (5th Cir. 1980) (citation and footnote omitted), cert. denied, 450 U.S. 981 (1981). As the court has noted of the rationale underlying the rule against allowing parties to acquire protectable rights to generic terms:

The obvious reason for giving less protection to generic terms in a . . . mark . . . is that to do otherwise would place an unreasonable burden on third parties. To exclude other providers of a good or service from the right to use generic terms once they have been appropriated by a provider of the good [or service], would quickly result in a situation in which businesses were struggling to convey information about their business in their mark but without using any words that described their business, because those words would already be protected in the . . . mark of another firm. In such a world, there would be almost no possibility of confusing one . . . mark with another. Unfortunately the
Despite these strong statements, however, a relative dearth of cases in which genericness was at issue hampers an examination of Eleventh Circuit jurisprudence concerning generic marks. Although the court has not expressly defined in an actual holding what constitutes a generic mark, its decisions routinely note that "generic terms . . . communicate "information about the nature or class of an article or service." Likewise, a generic term may also be "the name of a particular genus or class of which an individual article or service is but a member."

One case in which the court did have an opportunity to provide guidance on the issue was Soweco, Inc. v. Shell Oil Co., which involved the plaintiff's attempt to protect its federally registered LARVACIDE mark; a mark used in connection with "fumigants for public would also be receiving very little information about the nature of a business' service from its mark.


In Citibank, N.A. v. Citibanc Group, Inc., 724 F.2d 1540, 22 U.S.P.Q.2d (BNA) 292 (11th Cir. 1984), for example, the court, without extended discussion, affirmed the district court's conclusion that the plaintiff's CITIBANC mark for banking services was not generic. See id. at 1545, 222 U.S.P.Q. (BNA) at 296.

For cases in which the court has offered examples, in dictum, of marks it considers to be generic, see Investacorp, Inc. v. Arabian Investment Banking Corp., 931 F.2d 1519, 1522, 19 U.S.P.Q.2d (BNA) 1056, 1058 (11th Cir.) ("The term 'Milk Delivery' is an example of a generic service mark for a hypothetical milk delivery service."); cert. denied, 112 S. Ct. 639 (1991); Soweco, Inc. v. Shell Oil Co., 617 F.2d 1178, 1183, 207 U.S.P.Q. (BNA) 278, 283 (5th Cir. 1980) (noting that "'ivory' is generic of elephant tusks"); cert. denied, 450 U.S. 981 (1981).


Vision Ctr. v. Opticks, Inc., 598 F.2d 111, 115, 202 U.S.P.Q. (BNA) 333, 338 (5th Cir. 1979), cert. denied, 444 U.S. 1016 (1980); see also Freedom Sav. & Loan Ass'n v. Way, 757 F.2d 1176, 1182 n.5, 226 U.S.P.Q. (BNA) 123, 131 n.5 (11th Cir.) (concluding that generic marks "refer to a particular genus or class of which an individual service is but a member"); cert. denied, 474 U.S. 845 (1985).

exterminating bugs, insects, slugs, and rodents." The subjects of the plaintiff's ire were competing products sold as "SHELL Poultry Spray & Larvicide" and "RABON Oral Larvicide," the former covering "[a] liquid ordinarily used in spray form [and] either sprayed directly on birds to control mites and lice or sprayed on poultry droppings to inhibit the growth of larvae and maggots" and the latter a preparation "added to cattle feed to control fly larvae in manure." At trial, a jury found the word "larvicide" to be "the common descriptive name for an agent or substance for killing larvae." On the basis of this finding, the district court found the plaintiff's mark to be generic and ordered the cancellation of the mark's federal registration.

On the plaintiff's appeal, however, the former Fifth Circuit reversed. Although it was true that the term "larvicide" might well be the generic name for a preparation intended to combat the spread of larvae, as indeed the jury had found it to be, a finding that the defendant was using the term in a generic sense did not necessarily translate into a finding that the mark was generic with respect to the plaintiff's products. Rather, the appellate court noted, "plaintiff used its mark on products that are intended to kill many forms of animal life, not merely larvae." Concluding that the plaintiff's mark therefore fell outside the proper definition of "generic," the court thus held it eligible for protection.

ii. Descriptive Marks. "Descriptive" terms identify characteristics or qualities of the goods or services with which they are connected, such as color, odor, function, dimensions, or ingredients. They also include the personal names of providers of the

49 See id. at 1181, 207 U.S.P.Q. (BNA) at 281.
50 Id. at 1182, 207 U.S.P.Q. (BNA) at 282.
51 Quoted in id. at 1186, 207 U.S.P.Q. (BNA) at 285.
52 Id., 207 U.S.P.Q. (BNA) at 285.
54 In finding that the mark was, in fact, descriptive rather than generic, however, the appellate court found that the defendant was entitled to use the term in its purely descriptive sense. See id. For more on the so-called "fair use defense," see infra notes 197-206 and accompanying text.
relevant goods or services, as well as geographic terms corresponding to their physical origin. These types of marks are far from uncommon; rather, as the court has noted, "[a]pparently entrepreneurs can not resist the temptation to tie the name of their product to some . . . quality of description, geography, or vanity."

If an allegedly descriptive mark is not composed of a personal name or geographical designation, the issue of whether it is properly considered descriptive may be resolved through an application of one of several tests. On one level, a court may simply refer to the "plain dictionary definition" of a mark to determine "the idea conveyed to the observer" by the mark. Thus, for example, in Investacorp, Inc. v. Arabian Investment Banking Corp., the court concluded that "the two formatives combined in the term 'Investacorp' literally convey to the observer that [the plaintiff] is in the business of investing in corporations." Therefore, "because the customer who observes the term can readily perceive the nature of plaintiff's services, without having to exercise his imagination, . . . 'Investacorp' must be merely

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58 Investacorp, 931 F.2d at 1522, 19 U.S.P.Q.2d (BNA) 1056, 1058; see also Conagra, Inc. v. Singleton, 743 F.2d 1508, 1513, 224 U.S.P.Q. (BNA) 552, 556 (11th Cir. 1984) (finding SINGLETON name had acquired secondary meaning as designation of business of SINGLETON PACKAGING).

59 See, e.g., Continental Motors Corp. v. Continental Aviation Corp., 375 F.2d 857, 860-62, 153 U.S.P.Q. (BNA) 313, 316 (5th Cir. 1967); Continental Ins. Co. v. Continental Fire Ass'n, 101 F. 255, 257 (5th Cir. 1900) (both holding CONTINENTAL mark to be descriptive).

The court has, however, acknowledged that "[t]here are certain words, which while containing the germ of geographic significance, cannot be identified with any specific geographic unit or are not used in a descriptive sense . . . ." World Carpets, Inc. v. Dick Littrell's New World Carpets, 438 F.2d 482, 486, 168 U.S.P.Q. (BNA) 609, 612 (5th Cir. 1971). This acknowledgement notwithstanding, at least one Eleventh Circuit jurist has expressed a willingness to hold certain geographic terms generic, and hence unprotectable under any circumstances. See Citibank, N.A. v. Citibanc Group, Inc., 724 F.2d 1540, 1550 n.6, 222 U.S.P.Q. (BNA) 292, 300 n.6 (11th Cir. 1984) (Vance, J., dissenting).


Note, however, that the court has noted on at least one occasion that "the absence of a word or expression from dictionaries is not controlling on the question of [descriptiveness]." Vision Ctr. v. Opticks, Inc., 596 F.2d 111, 117 n.17, 202 U.S.P.Q. (BNA) 333, 342 n.17 (5th Cir. 1979) (quoting In re Cooper, 196 U.S.P.Q. (BNA) 182, 186 (T.T.A.B. 1977), cert. denied, 444 U.S. 1016 (1980)).

60 931 F.2d at 1524, 19 U.S.P.Q.2d (BNA) at 1059.
Dictionary definitions notwithstanding, "whether competitors would be likely to need the terms used in the [mark]" is also probative of the degree to which that designation is merely descriptive of the associated goods or services.\(^{62}\) Thus, the Investacorp court bolstered its etymological arguments as to the meaning of the putative INVESTACORP mark by noting that "[b]oth of the two formatives 'invest' and 'corp' pervade the lexicon of business terminology. Because the two formatives are indispensable to the investment services industry, we agree that it is very likely that competitors will need to use these terms."\(^{63}\) Likewise, another panel of the former Fifth Circuit held the term "Vision Center" to be merely descriptive after finding that "the word 'vision' is virtually indispensable . . . to the optical goods industry . . . [and] naturally occurs to one in thinking of the goods and services provided by the parties. Similarly, the word 'center' is a common term found useful by a variety of commercial enterprises."\(^{64}\)

Finally, consistent with the preceding factor, a court evaluating the descriptiveness of a particular mark may also refer to industry usage as a gauge.\(^{65}\) Thus, the Investacorp court found the "extreme" popularity of use within the industry probative of the descriptiveness of the primary component of the plaintiff's mark.\(^{66}\) Likewise, in American Heritage Life Insurance Co. v. Heritage Life Insurance Co.,\(^{67}\) the court upheld the trial court's determination

\(^{61}\) Id.  
\(^{63}\) 931 F.2d at 1523, 19 U.S.P.Q.2d (BNA) at 1058-59.  
\(^{64}\) Vision Ctr., 596 F.2d at 116, 202 U.S.P.Q. (BNA) at 339.  
\(^{65}\) Although very similar, this factor differs from the one previously discussed in a critical respect. The descriptiveness decisions addressed at supra notes 62-64 and accompanying text stand for the proposition that a mark is descriptive if its nature makes it competitively necessary for industry members to use, whether or not they actually do. In contrast, the industry-usage factor holds that a mark's descriptive nature may be discerned by examining how industry participants use it.  
As set forth in greater detail at infra notes 187-236 and accompanying text, evidence of third party usage also is relevant for determining a mark's "strength," or scope of protection.  
\(^{67}\) 494 F.2d 3, 182 U.S.P.Q. (BNA) 77 (5th Cir. 1974).
that the salient portion of the plaintiff's mark was descriptive by noting that "[t]he industry itself evidently recognizes the truth of the district court's finding because the word . . . is used in the corporate names of insurance companies all over the country."668

Under applications of these tests, marks held by the court to be merely descriptive of their goods or services include:

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<th>MARK</th>
<th>GOODS OR SERVICES</th>
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668 Id. at 11, 182 U.S.P.Q. (BNA) at 82.
70 American Television & Communications Corp. v. American Communications & Television, Inc., 810 F.2d 1546, 1549, 1 U.S.P.Q.2d (BNA) 2084, 2086 (11th Cir. 1987).
76 DryIce Corp. v. Louisiana Dry Ice Corp., 54 F.2d 882, 884-86 (5th Cir. 1931), cert. denied, 286 U.S. 558 (1932).
If a word mark is found to be descriptive, it is protectable only if its owner is able to demonstrate that the mark has acquired a "secondary" meaning. Although the concept defies easy definition, "[t]he secondary meaning doctrine . . . holds that words which have a primary [descriptive] meaning of their own . . . may by long use in connection with a particular product, come to be known by the public as specifically designating that product." To establish secondary meaning in the Eleventh Circuit, the plaintiff "must

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79 Beneficial Indus. Loan Corp. v. Allenstein, 173 F.2d 38, 40, 80 U.S.P.Q. (BNA) 537, 539 (5th Cir. 1949).
81 W.T. Wagner's Sons Co. v. Orange Snap Co., 18 F.2d 554, 555 (5th Cir. 1927).

Considered today as a part of the broader law of unfair competition, the doctrine of secondary meaning is another avenue to protection of trade names independent of any trademark act. The doctrine has been accounted as the response of the common law to the realities of business life. Apparently entrepreneurs can not resist the temptation to tie the name of their product to some disabling quality of description, geography, or vanity. While this foible [normally] prevents recourse to the Act, in a proper case the law will recognize the years of effort and expense, necessary to effect a turn of the public mind, with equivalent protection. Once secondary meaning is established, the beneficiary need only show a likelihood of confusion to enjoin an infringing use.

Id. at 848, 165 U.S.P.Q. (BNA) at 39-40 (footnotes omitted).
show that the primary significance of the term in the minds of the consuming public is not the product but the producer.' 86 Needless to say, the more descriptive the plaintiff's mark, the more burdensome a demonstration of this association becomes. 87 As with the likelihood of confusion determination itself, whether secondary meaning exists is an issue of fact. 88

Assuming that a defendant does not admit it exists, 89 a mark's secondary meaning generally is demonstrated through two mechanisms, the first of which is established by the Lanham Act itself. If a plaintiff has federally registered its mark, section 33(a) of the Act 90 provides that the registration constitutes "prima facie" evidence of the mark's validity, including its distinctiveness as an indicator of origin. 91 If the registration is more than five years


87 See American Television & Communications Corp. v. American Communications & Television, Inc., 810 F.2d 1546, 1549, 1 U.S.P.Q.2d (BNA) 2084, 2086 (11th Cir. 1987) ("A high degree of proof is necessary to establish secondary meaning for a descriptive term which suggests the basic nature of the product or service."); American Heritage, 494 F.2d at 12, 182 U.S.P.Q. (BNA) at 83 ("[T]he evidentiary burden necessary to establish secondary meaning is substantial" for descriptive marks); see also Milsan, 423 F.2d at 850, 165 U.S.P.Q. (BNA) at 41 ("We agree . . . that the evidentiary burden, necessary to establish secondary meaning, is substantial where the mark applied to an article designates a principal ingredient desired by the public.").


89 In cases in which the defendant has admitted that the plaintiff's descriptive mark has acquired secondary meaning, the court need not examine the accuracy of this admission. See Day-Brite Lighting, Inc. v. Sta-Brite Fluorescent Mfg. Co., 308 F.2d 377, 382, 135 U.S.P.Q. (BNA) 49, 52 (5th Cir. 1962) (accepting defendant's concession of secondary meaning as dispositive of issue).

90 15 U.S.C. § 1115(a) (1988); see also id. § 1057(b) ("A certificate of registration of a mark upon the principal register provided by this [Act] shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce . . . .'').


Under [section 33(a)], registration is prima facie evidence of the registrant's ownership of the mark and of the registrant's exclusive right to use the mark in commerce in connection with the [goods or] services
old, this presumption can become "conclusive," provided that the registrant complies with certain procedural formalities. Accordingly, the owner of a registered descriptive mark proceeding under either section 32 or section 43(a) need not demonstrate secondary meaning as part of its prima facie case.

In the absence of a federal registration of the plaintiff's mark, the standards for determining whether secondary meaning exists in an action under section 43(a) to protect an unregistered mark are largely judicial creations. Characteristic with its other decisions in the area, the Eleventh Circuit has set forth a multifaceted test to be used when determining whether a particular unregistered mark has achieved secondary meaning:

The factors to consider . . . are: (1) the length and manner of its use; (2) the nature and extent of advertising and promotion; (3) the efforts made by the plaintiff to promote a conscious connection in the

specified in the registration certificate. Thus registration is sufficient to establish prima facie (1) the required prior use (2) of registrable mark (3) which is likely to be confused with another's use of the same or similar mark.

Id., 182 U.S.P.Q. (BNA) at 82 (citations omitted).

See 15 U.S.C. §§ 1065, 1115(b) (1988); see also Soweco, Inc. v. Shell Oil Co., 617 F.2d 1178, 1190, 207 U.S.P.Q. (BNA) 278, 289 (5th Cir. 1980) (presuming secondary meaning from mark's statutory status), cert. denied, 450 U.S. 981 (1981); Roto-Rooter Corp. v. O'Neal, 513 F.2d 44, 46, 186 U.S.P.Q. (BNA) 73, 74 (5th Cir. 1975) (same). The primary requirement for conclusive evidentiary status is the registrant's filing of an affidavit averring that the underlying mark has been in continuous use since its registration and that there has been no final judicial decision adverse to the registrant's ownership of the mark. See 15 U.S.C. § 1065 (1988).


Id. § 1125(a).

See, e.g., Roto-Rooter, 513 F.2d at 46, 186 U.S.P.Q. (BNA) at 74 (holding that trial court incorrectly required federal registrant to demonstrate secondary meaning). Obviously, as with all presumptions, the statutory presumption may be overcome upon an appropriate showing by the defendant, provided that the plaintiff's registration has not become incontestable within the meaning of 15 U.S.C. § 1065. See, e.g., Vision Ctr. v. Opticks, Inc., 596 F.2d 111, 119-20, 202 U.S.P.Q. (BNA) 333, 340-41 (5th Cir. 1979) (establishing descriptive nature of mark will rebut presumption), cert. denied, 444 U.S. 1016 (1980). Moreover, even if this presumption of distinctiveness has, in fact, become conclusive, a defendant still may rely upon the narrowly drawn defenses set forth in section 33(b)(1)-(6) of the Act, including but not limited to the fair use defense applicable to descriptive marks generally. See 15 U.S.C. § 1115(b) (1988).

public's mind between the name and the plaintiff's product or business; and (4) the extent to which the public actually identifies the name with the plaintiff's product or venture.\textsuperscript{97}

In addition to these factors, at least one panel of the court has held that a defendant's intentional copying constitutes probative—but not conclusive—evidence of secondary meaning.\textsuperscript{98}

Obviously, an application of the second and third enumerated factors mandates that a descriptive mark's owner not only use the mark in her advertising but that she draw attention to it as well.\textsuperscript{99} Thus, a plaintiff may not prove secondary meaning by demonstrating extensive advertising of an acronym comprised of the first letters of the words making up her mark.\textsuperscript{100} Likewise, she also may not single out a descriptive word from a larger mark for protection without demonstrating that she has drawn consumer attention to that word, separately and independently of the mark as a whole.\textsuperscript{101}

\textsuperscript{97} Conagra, Inc. v. Singleton, 743 F.2d 1508, 1513, 224 U.S.P.Q. (BNA) 552, 555 (11th Cir. 1984); see also American Television & Communications Corp. v. American Communications & Television, Inc., 810 F.2d 1546, 1549, 1 U.S.P.Q.2d (BNA) 2084, 2086 (11th Cir. 1987) (applying Conagra factors to determine secondary meaning); Volkswagenwerk Aktiengesellschaft v. Rickard, 492 F.2d 474, 478, 181 U.S.P.Q. (BNA) 611, 614 (5th Cir. 1974) (applying first three factors to determine secondary meaning).

\textsuperscript{98} See Brooks Shoe Mfg. Co. v. Suave Shoe Corp., 716 F.2d 854, 860, 221 U.S.P.Q. (BNA) 536, 540 (11th Cir. 1983) ("Although we believe that proof of intentional copying is probative evidence on the secondary meaning issue, we cannot agree with [plaintiff] that proof of intentional copying conclusively establishes that the plaintiff's trademark or trade dress has acquired secondary meaning."); cf. CPG Prods. Corp. v. Pegasus Luggage, Inc., 776 F.2d 1007, 1012, 227 U.S.P.Q. (BNA) 497, 499-500 (Fed Cir. 1985) (concluding, in application of Eleventh Circuit law, that "evidence of deliberate imitation and copying in this case also supports a determination of secondary meaning").

\textsuperscript{99} See Brooks Shoe, 716 F.2d at 860, 221 U.S.P.Q. (BNA) at 540 (requiring substantial "image advertising" focusing on plaintiff's alleged mark).

\textsuperscript{100} American Television & Communications Corp. v. American Communications & Television, Inc., 810 F.2d 1546, 1549, 1 U.S.P.Q.2d (BNA) 2084, 2086 (11th Cir. 1987).

Of these factors, it is the last that the court is most likely to consider dispositive.\(^{102}\) In *Aloe Creme Laboratories, Inc. v. Mil- san, Inc.*,\(^ {103}\) for example, the plaintiff, although conceding that its use of ALO was descriptive of the aloe vera content of its goods, nevertheless maintained that the term had achieved secondary meaning. In support of this claim, the plaintiff alleged that it had spent "almost $3,000,000 in an effort to place the word 'Alo' on the lips of every prospective female customer in the American market," that it had achieved a "nationwide market," and that the "value and quality" of its products had been widely recognized by independent writers in newspaper and magazine articles.\(^ {104}\) Despite these relatively impressive efforts, however, the former Fifth Circuit affirmed the district court's holding that no secondary meaning existed, concluding, "[i]n considering this evidence, it must be remembered that the question is not the extent of the promotional efforts, but their effectiveness in altering the meaning of 'Alo' to the consuming public."\(^ {105}\)

In contrast, however, the court relied on the critical fourth factor in *ConAgra, Inc. v. Singleton*\(^ {106}\) to hold that secondary meaning *had* in fact been achieved. Although impressed with the plaintiff's expenditure of hundreds of thousands of dollars on advertising annually, the court found "most telling" market surveys revealing that the plaintiff's mark was strongly identified with the plaintiff's products.\(^ {107}\) On the basis of this widespread awareness, which extended through food brokers as well as the public generally, the appellate court found the district court's finding that no secondary meaning existed to be clearly erroneous.\(^ {108}\)

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\(^{102}\) Indeed, at least one panel of the former Fifth Circuit was willing to collapse the secondary meaning analysis into an application of this single factor: "The test of secondary meaning is the effectiveness of the effort to create it, and the chief inquiry is directed toward the consumer's attitude about the mark in question: does it denote to him or her 'a single thing coming from a single source?'" *American Heritage*, 494 F.2d at 12, 182 U.S.P.Q. (BNA) at 83 (quoting *Carter-Wallace, Inc. v. Procter & Gamble Co.*, 434 F.2d 794, 802, 167 U.S.P.Q. (BNA) 713, 719 (9th Cir. 1970)).


\(^{104}\) Id. at 850, 165 U.S.P.Q. (BNA) at 41.

\(^{105}\) Id., 165 U.S.P.Q. (BNA) at 41.

\(^{106}\) 743 F.2d 1508, 224 U.S.P.Q. (BNA) 552 (11th Cir. 1984).

\(^{107}\) Id. at 1513-14, 224 U.S.P.Q. (BNA) at 555-56.

\(^{108}\) Id. at 1514, 224 U.S.P.Q. (BNA) at 556.
iii. Suggestive Marks. According to the Eleventh Circuit, "[a] suggestive term suggests, rather than describes, a characteristic of the goods or services and requires an effort of the imagination by the consumer in order to be understood as descriptive . . . ."109

In contrast to descriptive marks, suggestive marks are considered inherently distinctive and their owners therefore have no need to acquire distinctiveness through long-term usage and promotion.110

Although suggestive marks may consist of single words,111 they may also be nothing more than combinations of otherwise purely descriptive words.112 In Citibank, N.A. v. Citibanc Group, Inc.,113 for example, the defendant user of the CITIBANC mark sought to defend an infringement suit brought by a prior user of the CITIBANK mark by arguing that its own mark was descriptive and therefore presumably eligible for the "fair use" defense.114

Affirming the district court, however, the Eleventh Circuit held that "[t]he term 'Citi' does not describe a class of banking services or a characteristic of banking services. As the district court stated, '[t]he most that can be said for City Bank is that it suggests a modern or urban bank.'"115 Under these circumstances, the appellate court held, "we find that Citibank indicates not a type of service, but a provider of that service."116

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110 Investacorp, Inc. v. Arabian Inv. Banking Corp., 931 F.2d 1519, 1522, 19 U.S.P.Q.2d (BNA) 1056, 1058 (11th Cir.), cert. denied, 112 S. Ct. 639 (1991); see also Safeway Stores, Inc. v. Safeway Discount Drugs, Inc., 675 F.2d 1160, 1165 n.9, 216 U.S.P.Q. (BNA) 599, 603 n.9 (11th Cir. 1982) ("Once a mark is shown at least to have a suggestive quality, secondary meaning need not be shown.").
111 See, e.g., Soweco, Inc. v. Shell Oil Co., 617 F.2d 1178, 1184, 207 U.S.P.Q. (BNA) 278, 283-84 (5th Cir. 1980) ("If used as a trademark for refrigerators, the term 'Penguin' would be suggestive."), cert. denied, 450 U.S. 981 (1981).
112 See Vision Ctr. v. Opticks, Inc., 596 F.2d 111, 116, 202 U.S.P.Q. (BNA) 333, 338 (5th Cir. 1979) ("We are, of course, aware that common, ordinary words can be combined in a novel or unique way and thereby achieve a degree of protection denied to the words when used separately."); cert. denied, 444 U.S. 1016 (1980).
114 On the fair use defense, see infra notes 197-206 and accompanying text.
115 Citibank, N.A., 724 F.2d at 1545, 222 U.S.P.Q. (BNA) at 296 (citation omitted) (second bracket in original).
The court reached a similar result in *Safeway Stores, Inc. v. Safeway Discount Drugs, Inc.*,\textsuperscript{117} in which it undertook to categorize the plaintiff's mark after the district court's failure to do so. Although acknowledging that "[o]ther than in its use as a mark, the word Safeway does indeed have no meaning," the court nevertheless declined to hold the mark a "coined," or fanciful one.\textsuperscript{118} Rather, the court held in analyzing a mark it characterized as "merely . . . a combination of two other common words," "[a]lthough not descriptive of the retail grocery services [plaintiff] provides, the word is suggestive of the reliability of the services."\textsuperscript{119}

**iv. Arbitrary and Coined Marks.** At the opposite end of the spectrum from generic marks are those found to be "arbitrary" or "coined." According to the court, an arbitrary mark "‘is a word in common use, but applied to a product or service unrelated to its meaning, so that the word neither describes nor suggests the product or service.’"\textsuperscript{120} Like suggestive marks, arbitrary marks are protectable, and may be federally registered, without a showing of secondary meaning.\textsuperscript{121}

In contrast, coined marks are "purely fanciful" words with no apparent meaning.\textsuperscript{122} Although the court in *Exxon Corp. v. Texas Motor Exchange, Inc.*\textsuperscript{123} passed up an obvious opportunity to deem the plaintiff's trademark a coined or fanciful mark, instead merely categorizing it as "strong,"\textsuperscript{124} other panels of the court have

\textsuperscript{117} 675 F.2d 1160, 216 U.S.P.Q. (BNA) 599 (11th Cir. 1982).
\textsuperscript{118} Id. at 1164, 216 U.S.P.Q. (BNA) at 602.
\textsuperscript{119} Id. at 1164-65, 216 U.S.P.Q. (BNA) at 602-603.
\textsuperscript{120} Jellibeans, Inc. v. Skating Clubs, 716 F.2d 833, 841 n.18, 222 U.S.P.Q. (BNA) 10, 17 n.18 (11th Cir. 1983) (quoting Tisch Hotels, Inc. v. Americana Inn, Inc., 350 F.2d 609, 611 n.2, 146 U.S.P.Q. (BNA) 566, 568 n.2 (7th Cir. 1965)).
\textsuperscript{123} 628 F.2d 500, 208 U.S.P.Q. (BNA) 384 (5th Cir. 1980).
\textsuperscript{124} Id. at 504, 208 U.S.P.Q. (BNA) at 387. For another missed opportunity to designate an apparently coined term as such, see Hydraulic Press Brick Co. v. Stevens, 15 F.2d 312, 313 (5th Cir. 1926) (categorizing HY-TEX mark as "arbitrary").
tendered such examples of coined marks as ESSO, SOHIO, KODAK, and XEROX, as well as the unquestionably fanciful BARNBARNFISH, offered by one panel "strictly for pedagogical reasons." Like arbitrary marks, coined and fanciful marks are considered inherently distinctive and therefore entitled to protection without a showing of secondary meaning.

b. Design Marks and Trade Dresses. Although the majority of infringement cases, in the Eleventh Circuit and elsewhere, involve allegations of infringement of marks comprised of a word or series of words, designations of origin need not consist simply of words to qualify for protection. On the contrary, the court has long recognized the possibility of extending protection to marks comprised of non-verbal components, such as stylized animal figures and sports-team emblems. Such designations of origin fall within the category of “design” marks, as opposed to their “word” mark counterparts.

Moreover, protection is available under certain circumstances even for the so-called “trade dress” associated with a particular product or service. Although the increasingly broad concept of trade dress does not lend itself to succinct definition, trade dress

126 Id., 150 U.S.P.Q. (BNA) at 316.
128 Soweco, 617 F.2d at 1184, 207 U.S.P.Q. (BNA) at 283-84; Amstar, 615 F.2d at 260, 205 U.S.P.Q. (BNA) at 976.
131 Id. at 1522 n.14, 19 U.S.P.Q.2d (BNA) at 1058 n.14.
132 Id. at 1523, 19 U.S.P.Q.2d (BNA) at 1058.
generally is the overall image used to present a product or service to purchasers. In its most common form, trade dress consists of the particular packaging and labels associated with a particular product. It can also, however, include such characteristics as size, shape, and color.

In less common situations, cognizable trade dress can even consist of the physical appearance of buildings associated with a plaintiff's services or a plaintiff's unique sales techniques.

As is the case with purely verbal word marks, a plaintiff seeking to protect its design mark or trade dress must demonstrate that the defendant has used a corresponding indicator of origin that is likely to cause confusion. Unlike word mark owners, however, owners of design marks and trade dresses bear the burden of proof on two other issues. First, they must demonstrate that their marks


137 See, e.g., T.G.I. Friday's, Inc. v. International Restaurant Group, Inc., 569 F.2d 895, 899, 197 U.S.P.Q. (BNA) 513, 515 (5th Cir. 1978) (addressing protectability of restaurant appearance); McDonald's Corp. v. Moore, 383 F.2d 435, 435, 150 U.S.P.Q. (BNA) 488, 489 (5th Cir. 1968) (same).


or trade dresses are not "functional." Second, they must establish that the design mark or trade dress is either inherently distinctive or, alternatively, has acquired secondary meaning.140 The remainder of this section examines the showings sufficient to satisfy these standards.

i. Functionality. The principle that functional designs are not protectable under unfair competition law corresponds generally to the principle precluding protection of generic designations as word marks.141 As a general rule, federal law encourages the widespread use of designs that are necessary for industry participants to compete effectively in the marketplace.142 In cases involving such designs, the appropriate mechanism for protecting them lies in the realm of patent, rather than trademark, law and, in the absence of a utility patent, "[o]utright copying is often a civilizing rather than a cannibalizing folkway."143 Thus, if a particular feature of a plaintiff’s design is functional, no amount of secondary meaning or consumer confusion will render it protectable.144

Nevertheless, although the court expressly has held that the distinction between “civilizing” and “cannibalizing” conduct is a question of fact,145 guidelines on how to draw that distinction are far less clear. On the most basic level, the court’s decisions reflect uncertainty whether differing tests for functionality apply to trade dress consisting of packaging for, or superfluous ornamentation attached to, a plaintiff’s goods, on the one hand, and the configuration or shape of the products, on the other. For example, in Brooks

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141 See supra notes 42-54 and accompanying text.


Shoe Manufacturing Co. v. Suave Shoe Corp., a case involving an ornamental design affixed to the parties' shoes, the court held that "to prevail on a trade dress infringement claim a plaintiff must prove... that features of... its trade dress are primarily nonfunctional..." The court has adopted a similar standard for product packaging and containers, suggesting that plaintiffs will be able to protect the overall appearance of this type of trade dress even if particular components are functional.

In contrast, however, the court's trade dress cases in the product configuration context have suggested—albeit without extended analysis—that a different standard applies to plaintiffs' efforts to protect their products. Specifically, in Bauer Lamp Co. v. Shaffer, the court upheld a successful challenge to the defendant's copying of the plaintiff's lamps. In doing so, however, the court offered a subtly different assessment of the plaintiff's burden on this issue, holding that "to establish trade dress infringement the plaintiff must show... that the... features in question are nonfunctional." Bauer Lamp and other decisions adopting a similar analysis suggest that the court may be moving toward the position taken by a growing number of jurisdictions, namely, that a product configuration owner may protect only those individu-

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147 Id., 221 U.S.P.Q. (BNA) at 538.
149 See, e.g., id. at 1538, 1 U.S.P.Q.2d (BNA) at 1166 ("That individual elements of packaging are functional does not, however, render the package as a whole unprotectible." (footnote omitted)). Perhaps significantly, however, even the AmBrit court held that the plaintiff in that case was entitled to protect only the purely nonfunctional ornamentation affixed to its foil wrapper. With respect to the remaining elements of the packaging, "Kraft was... free to imitate those features of the KLONDIKE packaging with complete impunity." Id. at 1538, 1 U.S.P.Q.2d (BNA) at 1166.
151 Id. at 1170, 20 U.S.P.Q.2d (BNA) at 1131 (emphasis added).
152 For other opinions by the court in the product configuration context that arguably require the plaintiff to demonstrate the nonfunctional nature of individual features making up a product's shape instead of trade dress as a whole, see Ross Bicycles, Inc. v. Cycles USA, Inc., 765 F.2d 1502, 1509, 226 U.S.P.Q. (BNA) 879, 880 (11th Cir. 1985) (adopting district court opinion), cert. denied, 475 U.S. 1013 (1986); John H. Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 960, 219 U.S.P.Q. (BNA) 515, 528 (11th Cir. 1983).
al features of its design that are demonstrably nonfunctional. Under this rule, a plaintiff seeking to protect an entire configuration presumably would need to do more than prove the existence of some nonfunctional elements or, alternatively, that the overall configuration is nonfunctional. Rather, such a plaintiff would bear the burden of demonstrating that its entire design is nonfunctional.

Whether differing degrees of nonfunctionality must be proved for packaging and product configurations, the court has not provided a clear definition of "functional" in either context. In perhaps what would have been its best opportunity to address the issue in a suit to protect a product's design John H. Harland Co. v. Clarke Checks, Inc., the court dodged the issue. Although ultimately approving of the trial court's jury instruction, namely, that "[i]n evaluating this issue, you must keep in mind that even though an object may serve some practical purposes, its design is protectable as trade dress if . . . the design in primarily nonfunctional," the court acknowledged that "[the defendant] makes a strong argument that the jury was inadequately instructed on the issue of functionality." To the extent that the court has provided any clear guidance on how to determine the functionality of product configurations, it has suggested that a finding of functionality is appropriate if the design is necessary to conform to industry standards, if the plaintiff has touted the functional aspects of its design in its

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153 At least one district court in the Eleventh Circuit has adopted this reading of Bauer Lamp. See Gale Group Inc. v. King City Indus. Co., 23 U.S.P.Q.2d (BNA) 1208, 1212 (M.D. Fla. 1992) ("Under Bauer, to establish trade dress infringement Plaintiff . . . must show that . . . the features allegedly copied are non-functional . . . ").


155 711 F.2d 966, 219 U.S.P.Q. (BNA) 515 (11th Cir. 1983).

156 Id. at 982 n.27, 219 U.S.P.Q. (BNA) at 530 n.27.

157 See id. at 983 n.30, 219 U.S.P.Q. (BNA) at 531 n.30 (denying protection to check stub used throughout banking industry).
advertising, or if the feature sought to be protected is "a result of a well known manufacturing process." As in the product configuration context, the court primarily has addressed the functionality of product packaging in its role as an appellate tribunal reviewing district courts' ultimate determinations of infringement or noninfringement, rather than as an arbiter of standards. In AmBrit, Inc. v. Kraft, Inc., for example, the plaintiff sought to protect the containers for its frozen ice cream bars in the face of the defendant's claim that the packaging was wholly functional. Lacking guidance from its own court of appeals, the district court for the Middle District of Florida turned to case law from the Court of Customs and Patent Appeals to hold that:

In determining whether [a] trade dress is primarily non-functional, the test is whether upholding an exclusive right to use the trade dress as a whole would hinder effective competition by others. Factors to be taken into account are whether a particular design is superior, whether there are alternative trade dress configurations available, and whether a particular design is comparatively simple or cheap.

On the defendant's appeal, the Eleventh Circuit upheld the district court's determination that although the plaintiff's use of a plastic tray with a foil overlap was functional, the appearance of the foil

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158 See id. at 983 n.28, 219 U.S.P.Q. (BNA) at 531 n.28 (considering advertising stressing ease with which plaintiff's product could be transported probative of functionality).


overlap was not. Other than agreeing that enjoining the defendant from use of the tray configuration "would hinder [the defendant] in its attempt to compete effectively," however, the appellate court did not comment on the district court's applied test. Thus, whether the language from the district court's opinion quoted above constitutes the proper test in the Circuit remains unresolved.

ii. Distinctiveness. Assuming that the owner of a non-verbal designation of origin is able to satisfy the nonfunctionality requirement, it must then demonstrate that its putative design mark or trade dress is distinctive. As with word marks, there are two primary avenues to achieving this purpose.

162 As the district court noted of these elements of the plaintiff's claimed trade dress:

Some of the features of the [plaintiff's] bar's packaging are functional. The open six bar tray offers stability to the product while it is in transit, in storage or on display. The tray is clearly superior protection to merely wrapping six bars in plastic. However, it offers less stability and protection than a closed carton. The tray also provides space to promote and describe the product as well as a location for coupons. The clear plastic overwrap provides only slight stability and protection, but permits the consumer to view the product—a significant disadvantage of a closed carton. The foil wrapper protects the ice cream bar and also provides a means of holding the ice cream while it is eaten. The fold technique, a deadfold wrap, is less secure than a heat sealed wrapper, but serves to adequately contain the product and is easy to open or reseal. In addition, there was evidence that the deadfold wrap is cheaper than a heat sealed wrapper, and that the foil of the wrapper tends to denote coldness and quality.

Given those considerations, the tray and plastic overwrap elements of [the plaintiff's] trade dress are primarily functional.

163 AmBrit, 812 F.2d at 1538, 1 U.S.P.Q.2d (BNA) at 1166.

164 Among other unresolved issues is the extent to which the district court's and court of appeals' focus in AmBrit on the mere existence of other designs in the relevant market precludes consideration of additional factors. For example, although the district court cited approvingly In re Morton-Norwich Products, Inc., 671 F.2d 1332, 213 U.S.P.Q. (BNA) 9 (C.C.P.A. 1982), as establishing the relevant test for functionality, see Isaly Co., 619 F. Supp. at 991, 226 U.S.P.Q. (BNA) at 806, the existence of alternative designs was only one factor taken into account by the Morton-Norwich court, with others including: (1) whether the design was or is the subject of a utility patent; (2) whether the advertising of the design owner touted the functional advantages of the design; and (3) whether the design is the result of a comparatively simple or cheap manufacturing method. See 671 F.2d at 1340-41, 213 U.S.P.Q. (BNA) at 16-16. Whether the AmBrit courts' failure to consider these additional Morton-Norwich factors was intentional or, alternatively, the result of insufficient record evidence to allow their evaluation is not apparent from either opinion.
(1) Inherently Distinctive Design Marks and Trade Dresses.

Well prior to the Supreme Court's holding to similar effect in *Two Pesos, Inc. v. Taco Cabana Inc.*, the Eleventh Circuit had rejected the theory that non-verbal marks or trade dresses require a demonstration of secondary meaning before they are eligible for protection. Instead, the court's decisions adopted the view that, by their very nature, some marks and trade dresses were inherently distinctive and thus could function as indicators of origin upon their adoption.

The precise test for determining whether a particular design mark or trade dress is inherently distinctive, however, is the subject of some judicial disagreement in the Eleventh Circuit. In one line of cases, the court has attempted to classify these designations into the same categories as word marks. In *University of Georgia Athletic Ass'n v. Laite*, for example, the court found the plaintiff's stylized bulldog design mark inherently distinctive after concluding that the mark, when used for sports teams, was not "descriptive," but was "at best, 'suggestive,' if not downright

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The decision to similar effect in *Chevron Chemical Co. v. Voluntary Purchasing Groups*, Inc., 659 F.2d 695, 212 U.S.P.Q. (BNA) 904 (5th Cir. Unit A 1981), cert. denied, 457 U.S. 1126 (1982) influenced the court's adoption of this point. Although decided on October 23, 1981, after the effective date of the Fifth-Eleventh Circuit split, section 9(3) of the Fifth Circuit Court of Appeals Reorganization Act of 1980, Pub. L. No. 96-452, 94 Stat. 1994, 1995 (1980) designated *Chevron* a former Fifth Circuit case. Whatever congressional intent in this designation, however, the Eleventh Circuit subsequently held in *Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 F.2d 821, 215 U.S.P.Q. (BNA) 745 (11th Cir. 1982), that *Chevron* was not binding authority, but was nevertheless "persuasive" in light of its being based directly on case law of the former Fifth Circuit that was binding authority. *Id.* at 831 n.14, 215 U.S.P.Q. (BNA) at 753 n.14.
168 756 F.2d 1535, 225 U.S.P.Q. (BNA) 1122 (11th Cir. 1985).
Similarly, in Sun-Fun Products, Inc. v. Suntan Research & Development Inc., the court reversed a directed verdict in the defendant's favor, noting in dictum that the trade dress of the plaintiff's bottles "arguably has many of the indicia of a suggestive mark and is therefore entitled to protection." 

In a subsequent case involving ornamentation attached to the plaintiff's product, however, the court jettisoned the word mark framework in favor of another test. Addressing the plaintiff's claim in Brooks Shoe Manufacturing Co. v. Suave Shoe Co. that the district court improperly had required a demonstration of secondary meaning, the court looked to the Court of Customs and Patent Appeals for guidance. Citing with approval the latter's decision in Seabrook Foods, Inc. v. Bar-Well Foods, Ltd., the court identified several factors that "should be considered" when determining if a particular design is inherently distinctive: (1) whether the design is a "common," or basic, shape or design; (2) whether it is unique or unusual in a particular field; and (3) whether it is a mere refinement of a commonly adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods. Applying this standard, the court found that the common use in the industry of the plaintiff's putative trade dress, together with its basic geometric shape, precluded the design from being considered inherently distinctive.

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169 Id. at 1541, 225 U.S.P.Q. (BNA) at 1127 (footnote omitted). As the court justified this conclusion:

We see very little connection between the attributes of an English bulldog and, for example, the University of Georgia tennis team. Furthermore, although the University of Georgia football team arguably may possess some of the attributes of a bulldog, one could hardly call the portrayal of a bulldog at issue in this case 'descriptive' of the average University of Georgia football player.

170 656 F.2d 186, 213 U.S.P.Q. (BNA) 91 (5th Cir. Unit B 1981).
171 Id. at 191 n.5, 213 U.S.P.Q. (BNA) at 95 n.5 (dictum).
174 Brooks Shoe, 716 F.2d at 857-58, 221 U.S.P.Q. (BNA) at 538.
175 Id. at 858, 221 U.S.P.Q. (BNA) at 538-39.
Faced with these apparently incongruous tests, the court attempted to reconcile them in *AmBrit, Inc. v. Kraft, Inc.*, a case that, unlike either *Laite* and *Brooks Shoe*, involved trade dress consisting of the packaging for the plaintiff's goods. At trial, the district court employed the *Brooks Shoe* analysis to find the plaintiff's ice cream bar wrapper inherently distinctive. On appeal, however, the defendant countered with arguments that the constituent elements of the plaintiff's trade dress connoted coldness and, additionally, with evidence of their widespread usage on similar or related goods.

Addressing these two challenges, the appellate court employed both the *Laite* and *Brooks Shoe* analyses. Applying the former, it concluded first that "[t]he trade dress does not describe the ice cream product, rather it suggests to the consumer the coldness of the product. Such trade dress is inherently distinctive . . . ." Having made this determination, the court next rejected the defendant's contention that widespread third-party usage of individual elements of the plaintiff's trade dress rendered the design a mere refinement of commonly adopted ornamentation:

[T]hird party use of one or more suggestive or arbitrary elements of a plaintiff's trade dress renders that trade dress indistinct only if the third party use is so extensive and so similar to the plaintiff's that it impairs the ability of consumers to use the trade dress of the products to identify their source.

Although on its face the decision upheld the plaintiff's initial victory, that the *AmBrit* court undertook to apply both *Laite* and *Brooks Shoe* suggests that a design mark or trade dress satisfying the *Laite* test may fall victim under *Brooks Shoe* to a finding of

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178 812 F.2d at 1536-37, 1 U.S.P.Q.2d (BNA) at 1165.
179 Id. at 1537, 1 U.S.P.Q.2d (BNA) at 1165-66.
180 Id., 1 U.S.P.Q.2d (BNA) at 1165-66.
non-inherent distinctiveness on a showing of extensive third-party usage. To a certain extent, this suggestion mirrors the axiom generally applicable to word marks that a court may determine the proper classification of a borderline descriptive or suggestive mark through an examination of third-party usage. AmBrit's apparent holding that an inherently distinctive trade dress can become ineligible for protection as a result of third-party usage, however, is without a corresponding principle in the doctrinal framework generally applicable to word marks.

(2) Non-Inherently Distinctive Design Marks and Trade Dresses. Like the owner of a descriptive mark, the owner of a design mark or trade dress found not to be inherently distinctive has the option of demonstrating that its designation of origin has acquired distinctiveness in the form of secondary meaning. As with word marks, there are two primary routes to fulfilling this requirement. First, a would-be plaintiff may federally register its mark or trade dress, thereby entitling it to the evidentiary presumptions of section 33 of the Lanham Act. Second, a plaintiff may demonstrate that its long-term usage of its design mark or trade dress has created secondary meaning. As with word marks, the proper inquiry in determining whether secondary meaning exists is whether prospective consumers would associate the design mark or trade dress with a particular source. Consequently, the putative owner of such a mark or trade dress should expect its claims to fail if the use in the relevant market of similar designs is such that this association is unlike-

181 See supra notes 65-68 and accompanying text.
183 See supra notes 84-88 and accompanying text.
Likewise, a plaintiff whose advertising historically has stressed the purely functional characteristics of its design, rather than the design's role as an indicator of origin, also will face a difficult time meeting its burden on this issue.

2. Strength of a Mark or Trade Dress.

a. Determining Strength or Weakness. Under Eleventh Circuit case law, "[t]he primary indicator of [mark or trade dress] strength measures the logical correlation between a name and a product. If a seller of a product or service would naturally use a particular name, it is weakly protected." Thus, under this rule, a "strong" mark or trade dress is one that is rarely used by parties other than its owner, while a "weak" mark or trade dress is one that is often used by other parties. "In short, the more distinctive a [mark or trade dress], the greater its 'strength.'"

As the secondary meaning requirement might suggest, descriptive marks often are not strong ones. Because, by definition, descriptive marks are those whose descriptive use is prevalent in particular industries, their nature frequently will render them weak ones for purposes of likelihood of confusion analyses. In *Chappell v. Goltsman*, for example, the plaintiff owner of a federal registration of the mark BAMA for preserves, jams, jellies, and mayonnaise sought to bar the defendant's use of an identical mark for wine. The district court, in an opinion affirmed by the former Fifth Circuit, however, declined to enter the requested relief. In substantial part, this holding was the result of the court's finding of widespread third-party use of the plaintiff's putative mark to describe a variety of goods and services having their origin.

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185 See, e.g., T.G.I. Friday's, Inc. v. International Restaurant Group, Inc., 569 F.2d 895, 899, 197 U.S.P.Q. (BNA) 513, 515 (5th Cir. 1978) (declining to enjoin defendant's "obvious copy" of plaintiff's restaurant trade dress on ground that no exclusive use shown by plaintiff).

186 Brooks Shoe, 716 F.2d at 860, 221 U.S.P.Q. (BNA) at 541.


188 Exxon Corp. v. Texas Motor Exch., 628 F.2d 500, 504, 208 U.S.P.Q. (BNA) 384, 387 (5th Cir. 1980).

189 See supra notes 65-68 and accompanying text.

in the state of Alabama.\textsuperscript{191}

Courts have not limited this principle to descriptive designations of geographic origin. In Holiday Inns, Inc. v. Holiday Out in America, Inc.,\textsuperscript{192} the plaintiff federal registrant sought to enforce its various HOLIDAY INN marks for hotel services against the defendant's operation of HOLIDAY OUT IN AMERICA outdoor campgrounds.\textsuperscript{193} Notwithstanding the presumption of secondary meaning attaching to the plaintiff's registrations,\textsuperscript{194} however, the former Fifth Circuit's analysis focused on the degree to which the parties' competitors also did business under similar names. Observing that "[p]laintiff admits that the word 'Holiday' is used, alone or in combination with words other than 'Inn,' throughout the United States . . . to designate motels and restaurants not affiliated in any way with plaintiff," the court concluded that "[t]he common word 'Holiday' is of weak trademark significance."\textsuperscript{195} Accordingly, the court affirmed the district court's denial of relief.\textsuperscript{196}

Significantly, even if the owner of a descriptive mark or non-inherently distinctive trade dress has succeeded, through advertising and promotion, in creating a strong designation of origin, this will not necessarily render the mark or trade dress protectable against all arguably similar competitive uses. In part because of the competitive need for particular industry members to employ descriptive words and terms, the use of these designations as marks is subject to another weakness largely unique to them, namely, the so-called "fair use defense." This doctrine has a statutory basis in section 33(b) of the Lanham Act, which provides for the defense in a suit brought by the plaintiff owner of a descriptive mark that "the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark,. of a term or device which is descriptive of and used fairly and in good

\begin{footnotes}
\item[191] See id. at 975-76, 91 U.S.P.Q. (BNA) at 34 ("There are numerous business establish-
ments [in] Alabama which use the word Bama in their trade name.").
\item[192] 481 F.2d 445, 178 U.S.P.Q. (BNA) 257 (5th Cir. 1973).
\item[193] Id. at 446-47, 178 U.S.P.Q. (BNA) at 257-58.
\item[194] See supra notes 90-95 and accompanying text.
\item[195] Holiday Inns, 481 F.2d at 448, 178 U.S.P.Q. (BNA) at 258.
\item[196] For criticism of this outcome, see generally Lunsford & Cohrs, supra note 27, at 1206; Walter Derenberg, The Twenty-Seventh Year of Administration of the Lanham Trademark Act of 1946, 64 TRADEMARK REP. 339, 415 (1974).
\end{footnotes}
faith only to describe the goods and services of such party.”\textsuperscript{197}

Although invoking the common law rather than the statute, the former Fifth Circuit first expressly recognized this defense in \textit{Creamette Co. v. Conlin,}\textsuperscript{198} a case involving the plaintiff's attempt to protect its federally registered CREAMETTE mark for macaroni. On the plaintiff's appeal from the district court's refusal to enjoin the defendant's use of "Creamette" in connection with frozen imitation cream desserts, the appellate court found little merit to the plaintiff's arguments that its mark was not descriptive, and hence entitled to broad protection. Even if the mark was arbitrary or coined when applied to the plaintiff's macaroni products,\textsuperscript{199} "it would not follow that the good faith use of the word by the defendants on a product which it correctly indicates would alone establish unfair competition."\textsuperscript{200} Rather, the court concluded,

A frozen sweet, or dessert, which is not made from the customary ice cream mix, but is similar to it, may well be called Creamette because it is an imitation or substitute of cream.

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We think it true that a name may be arbitrary or fanciful as applied to one or more products, but yet not be entitled to unlimited protection as against its good faith tradename adoption and use upon a product of which, because of its inherent properties, it is plainly and accurately descriptive in ordinary meaning. As applied to such an article it is a non-fanciful word because as thus used it is descriptive.\textsuperscript{201}

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\item \textsuperscript{198} 191 F.2d 108, 90 U.S.P.Q. (BNA) 160 (5th Cir. 1951), \textit{cert. denied}, 342 U.S. 945 (1952).
\item \textsuperscript{199} On the significance of these designations, see \textit{supra} notes 120-131 and accompanying text.
\item \textsuperscript{200} 191 F.2d at 112, 90 U.S.P.Q. (BNA) at 162.
\item \textsuperscript{201} \textit{Id.}, 90 U.S.P.Q. (BNA) at 162.
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Accordingly, the court upheld the district court's denial of relief.\(^2\)\(^0\)\(^2\)

The court since has made clear that the fair use defense is available only when, as in *Creamette*, the defendant's mark is, in fact, descriptive of its goods or services. In *Pure Foods, Inc. v. Minute Maid Corp.*,\(^2\)\(^0\)\(^3\) the defendant—seller of frozen meat under the designation "Minute Made"—attempted to rely on the fair use defense against a suit grounded in the plaintiff's federal registration of the MINUTE MAID mark for frozen fruit-juice concentrate.\(^2\)\(^0\)\(^4\) The court, however, rejected the defendant's invocation of section 33(b), noting:

> Defendant argues that "minute" refers to the time for cooking the meats and "made" means that the meats are processed. While all of defendant's products are processed, they could not truly be described as "made" meat. It took much longer than a minute to cook or prepare for serving most of the defendant's products.\(^2\)\(^0\)\(^5\)

Accordingly, the court held that the district court's rejection of the defendant's fair use theory had not been clearly erroneous.\(^2\)\(^0\)\(^6\)

Despite the arguably inherent weakness of descriptive marks, at least one panel of the court has held that a descriptive mark may become strong merely by virtue of being the subject of a federal registration that has become "incontestable" within the meaning of

\(^2\)\(^0\)\(^2\) *Id.*, 90 U.S.P.Q. (BNA) at 162; *see also* Day-Brite Lighting, Inc. v. Sta-Brite Fluorescent Mfg., 308 F.2d 377, 382 (5th Cir. 1962) (observing, in dictum, that "the plaintiff cannot secure any right to the exclusive use of such a descriptive term as 'bright' when applied to any kind of light, and when not used in such a manner as 'is likely to cause confusion or mistake or to deceive purchasers as to the source of origin'..." (citation omitted)).

\(^2\)\(^0\)\(^3\) *Id.* 102 U.S.P.Q. (BNA) at 271 (5th Cir.), *cert. denied*, 348 U.S. 888 (1954).

\(^2\)\(^0\)\(^4\) *Id.* at 797, 102 U.S.P.Q. (BNA) at 274.

\(^2\)\(^0\)\(^5\) *Id.*, 102 U.S.P.Q. (BNA) at 274.

\(^2\)\(^0\)\(^6\) *Id.*; cf. Frostie Co. v. Dr. Pepper Co., 341 F.2d 363, 367, 144 U.S.P.Q. (BNA) 516, 518 (5th Cir. 1965) ("Since such use of [the defendant's mark] incorporates the entire trademark of the [plaintiff] and can not be excused as being descriptive of the [defendant's] product, then it is, almost by definition, the equivalent of an infringing mark.").
sections 15 and 33 of the Lanham Act.\textsuperscript{207} In \textit{Dieter v. B & H Industries},\textsuperscript{208} the district court entered a verdict for the defendant after finding that the plaintiff’s descriptive, but federally registered SHUTTERWORLD mark, was a weak one entitled only to narrow protection.\textsuperscript{209} On appeal, however, the Eleventh Circuit reversed, holding that in light of the incontestable registration “Dieter’s mark... is presumed to be at least descriptive with secondary meaning, and therefore a relatively strong mark.”\textsuperscript{210} The court therefore remanded the litigation with an instruction to the district court to consider the incontestable status of the plaintiff’s registration in the likelihood of confusion analysis.\textsuperscript{211}

In addition to being arguably inconsistent with the court’s prior treatment of federal registrations,\textsuperscript{212} however, courts and commentators have criticized the \textit{Dieter} analysis as confusing the separate and independent inquiries of whether the plaintiff is the owner of an actual mark, on the one hand, and whether the defendant’s use is actionable, on the other.\textsuperscript{213} Specifically, the


\textsuperscript{209}Id. at 1355-56.


\textsuperscript{211}Id., 11 U.S.P.Q.2d (BNA) at 1726.

\textsuperscript{212}See, e.g., Citibank, N.A. v. Citibanc Group, Inc., 724 F.2d 1540, 1547, 222 U.S.P.Q. (BNA) 292, 297 (11th Cir. 1984) (“The presumption of validity afforded plaintiff’s [registered] mark under the Lanham Act is not material to [whether confusion is likely].”)

\textsuperscript{213}See, e.g., Oreck Corp. v. U.S. Floor Sys., Inc., 803 F.2d 166, 171, 231 U.S.P.Q. (BNA) 634, 637 (6th Cir. 1986), cert. denied, 481 U.S. 1069 (1987) (“Incontestable status does not make a weak mark strong.”); \textit{see also} 1 JEROME GILSON, TRADEMARK PROTECTION AND PRACTICE § 4.03[3][a][vi], at 4-39 (1993 ed.) (“Since even the owner of an incontestably registered mark must prove likelihood of confusion... the defendant should be entitled to reply on the weakness of the mark in attempting to disprove the claim.”); \textit{RESTATEMENT (THIRD) OF UNFAIR COMPETITION} § 21 cmt i, at 209 (Tentative Draft No. 2, 1990) (“The test for likelihood of confusion is the perception of consumers in the marketplace, which generally is unaffected by the status of the mark’s registration.”). Indeed, because \textit{Dieter}’s holding on this point is in direct conflict with the Seventh Circuit’s holding in Munters Corp. v. Matsui America, Inc., 909 F.2d 250, 15 U.S.P.Q.2d (BNA) 1686 (7th Cir.), cert. denied, 498 U.S. 1016
secondary meaning inquiry itself addresses only the threshold issue of whether the mark or trade dress is protectable, and is properly of limited relevance to determinations of the strength of the mark or trade dress for purposes of the likelihood of confusion analysis.\textsuperscript{214} That suggestive marks or inherently distinctive trade dresses frequently are considered strong indicators of origin\textsuperscript{215} is more a happenstance of their relationship to the underlying goods and services than a necessary function of it.

For example, notwithstanding the ability of the owner of a suggestive mark or inherently distinctive trade dress to protect itself from likely confusion absent a demonstration of secondary meaning, these indicators of origin are not necessarily strong ones. In \textit{Freedom Savings & Loan Ass'n v. Way},\textsuperscript{216} an Eleventh Circuit panel declined to disturb as clearly erroneous the trial court's finding that the primary component of the plaintiff's mark, the word "Freedom," was suggestive when applied to banking services.\textsuperscript{217} Despite this holding, however, the court refused to accept the plaintiff's apparent invitation to find its mark a strong one. Rather, although attaching some importance to "the relationship between the name and the service or good it describes," the court

\begin{quote}
\end{quote}


The strength of a particular trade dress is determined by a number of factors that establish its standing in the marketplace. Relying on its finding that the trade dress was inherently distinctive and had acquired secondary meaning, the district court concluded that the [plaintiff's] trade dress was strong. A more thorough analysis, however, is needed to determine the scope of protection appropriate for the [plaintiff's] trade dress. A finding of inherent distinctiveness indicates that the [plaintiff's] trade dress will be protected, but the appropriate degree of protection is determined by examining a number of factors that establish the standing of the trade dress in the marketplace: most notably, the type of trade dress and the extent of the third party uses.

\textit{Id.} at 1539, 1 U.S.P.Q.2d (BNA) at 1167 (footnote omitted).

\textsuperscript{215} See, e.g., Sun Banks, Inc. v. Sun Fed. Sav. & Loan Ass'n, 661 F.2d 311, 315, 211 U.S.P.Q. (BNA) 844, 847 (6th Cir. Unit B 1981) ("A strong mark is usually fictitious, arbitrary or fanciful and is generally inherently distinctive.").


\textsuperscript{217} \textit{Id.} at 1183, 226 U.S.P.Q. (BNA) at 127.
nevertheless held that "the strength of a mark [also] depends on the extent of third-party usage." Finding probative the defendant's evidence of such usage, the court upheld the trial court's holding in the defendant's favor.

Indeed, although the complete absence of a relationship between an arbitrary mark or inherently distinctive trade dress and its associated good or service might otherwise suggest the existence of a strong indicator of origin, this result does not necessarily hold. In Amstar Corp. v. Domino's Pizza, Inc., the former Fifth Circuit addressed the legality of an injunction entered against the defendant's use of its DOMINO'S PIZZA mark, which had been found by the trial court to infringe the plaintiff's arbitrary DOMINO mark for sugar. In reversing, the appellate court found persuasive the defendant's evidence that the word "Domino" was widely used as a trademark for a variety of goods. Although the court did not hold that "plaintiff's mark [was] not a distinctive, well-known mark for its sugar and related products," it nevertheless concluded in overturning a finding of likely confusion that the pervasive third-party usage significantly limited the mark's strength outside of those applications made by the plaintiff.

What constitutes acceptable evidence of third-party usage in the Eleventh Circuit is the subject of some uncertainty. For the most

218 Id. at 1182, 226 U.S.P.Q. (BNA) at 126.
219 See, e.g., Exxon Corp. v. Texas Motor Exch., 628 F.2d 500, 504, 208 U.S.P.Q. (BNA) 384, 387 (5th Cir. 1980) ("Our review of the record establishes that EXXON is a strong trademark. There is no evidence in the record indicating that any other party besides Exxon Corporation uses EXXON.").
221 Id. at 260, 205 U.S.P.Q. (BNA) at 975.

The court reached a similar conclusion in Sun Banks, Inc. v. Sun Federal Savings & Loan Ass'n, 651 F.2d 311, 211 U.S.P.Q. (BNA) 844 (5th Cir. 1981), in which it also reversed as clearly erroneous a finding that confusion was likely. Although declining to disturb the trial court's determination that the plaintiff's SUN BANKS mark was an arbitrary one, the court distinguished the threshold protectability inquiry from the consideration of the strength of the mark factor in the likelihood of confusion analysis by observing: "Arbitrariness refers to the quality of a mark, i.e., that it bears no relation to the service provided. The ultimate strength of a mark, the key inquiry before us, is determined by a number of factors which establish its standing in the marketplace." Id. at 315, 211 U.S.P.Q. (BNA) at 848. Taking into consideration the defendant's "impressive array of third party single and multiword uses of the SUN mark," the court dismissed the plaintiff's claims to an expansive zone of protection for its mark by overturning the plaintiff's victory at trial. Id. at 315-16, 211 U.S.P.Q. (BNA) at 848.
part, the court has accepted as evidence of third-party usage such submissions as copies of federal registrations of similar marks, the existence of business registrations of similar names with state agencies, and previous claims by the plaintiff to similar effect in earlier unrelated litigation. Consistent with the absence of a requirement that marks be identical for purposes of determining the likelihood of confusion between them, the weakness of a mark or trade dress may be demonstrated by the use of merely similar designations of origin in the same field.

Despite the court's traditional reliance on these types of evidence, however, a prudent Eleventh Circuit defendant should be prepared to go beyond a mere recitation of arguably relevant third-party marks. In Turner v. H M H Publishing Co., for example, the defendant attempted to demonstrate the weakness of the plaintiff's PLAYBOY mark by brandishing copies of "a number" of federal certificates of registration for the mark. The former Fifth Circuit, however, found the certificates of limited probative value of the mark's actual use and the significance of any such use: "We will not assume any knowledge . . . of the purchasing public by mere registrations in the Patent Office, nor will we assume that the marks are in continuing use, so as to have any effect on the mind of the purchasing public merely because they had been so regis-

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222 See, e.g., Amstar, 615 F.2d at 259, 205 U.S.P.Q. (BNA) at 975 ("We do not believe that . . . extensive third-party use and registration of [a mark] can be . . . readily dismissed."); El Chico, Inc. v. El Chico Cafe, 214 F.2d 721, 726, 102 U.S.P.Q. (BNA) 267, 269 (5th Cir. 1954) ("The evidence discloses such extensive use of the words El Chico as to bring them within the classification of a 'weak' trade name.").

223 See, e.g., Sun Banks, Inc., 651 F.2d at 316, 211 U.S.P.Q. (BNA) at 848 (considering evidence that "over 4,000 businesses registered with the Florida Secretary of State used the word 'Sun' in their names"); Sears, Roebuck & Co. v. All States Life Ins. Co., 246 F.2d 161, 169, 114 U.S.P.Q. (BNA) 19, 23 (5th Cir.), cert. denied, 355 U.S. 894 (1957).


225 See infra notes 237-252 and accompanying text.


228 Id. at 228 n.2, 154 U.S.P.Q. (BNA) at 332 n.2; cf. University of Ga. Athletic Ass'n v. Laite, 766 F.2d 1535, 1546 n.27, 225 U.S.P.Q. (BNA) 1122, 1131 n.27 (11th Cir. 1985) ("The proper inquiry is whether the unauthorized third-party uses significantly diminish the public's perception that the mark identifies items connected with the owner of the mark.").
 Likewise, the court may also disregard a list of third-party uses in the absence of a showing that the uses are in any way related to those of the parties to the litigation. Thus, in *Safeway Stores, Inc. v. Safeway Discount Drugs, Inc.*, the court rejected the defendant’s proffered evidence of third-party usage in substantial part because “[a]ll . . . [the uses] seem involved in relatively specialized businesses not closely related to the fairly general retail trade of Safeway Stores.”

b. Effects of Strength or Weakness. Once a trial court in the Eleventh Circuit has assessed the strength of a designation of origin this determination frequently plays a large role in the ultimate likelihood of confusion analysis. For example, that “‘[s]trong marks are widely protected, as contrasted to weak marks’” is apparent from the court’s decisions. Consequently, the classification of a plaintiff’s designation as strong or weak holds the potential for outweighing other factors.

The most frequent victim of this classification is the inquiry into the degree of similarity or dissimilarity between the parties’ goods and services mandated by *Roto-Rooter*. A mark or trade dress deemed to be strong can slice across wide gulfs in goods or services to secure protection against infringing uses for its owner. Thus, in *Chemical Corp. of America v. Anheuser-Busch, Inc.*, the owner

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229 *Turner*, 380 F.2d at 228 n.2, 154 U.S.P.Q. (BNA) at 332 n.2.
230 675 F.2d 1160, 216 U.S.P.Q. (BNA) 599 (11th Cir. 1982).
231 *Id.* at 1165, 216 U.S.P.Q. (BNA) at 603; *see also* Greyhound Corp. v. Goberna, 128 F.2d 806, 807, 54 U.S.P.Q. (BNA) 46, 46 (5th Cir. 1942) (“The [defendants] point out that the word GREYHOUND is used in Miami in connection with dog racing, and as the name of several business establishments. They concede, however, that [plaintiffs] have earned the right to use the name in connection with the bus transportation business . . . .”). For an example of this analysis reaching a contrary result, namely, a holding that the defendant’s evidence of third-party usage was relevant, see Armstrong Cork Co. v. World Carpets, Inc., 597 F.2d 496, 505 n.13, 203 U.S.P.Q. (BNA) 19, 27 n.13 (5th Cir.) (“World tries to distinguish between the use of WORLD by retailers as opposed to manufacturers. Insofar as consumers are concerned, the distinction seems tenuous.”), cert. denied, 444 U.S. 932 (1979).
233 *See, e.g., id.* at 259, 205 U.S.P.Q. (BNA) at 975 (“The strength and distinctiveness of a plaintiff’s mark is a vital consideration in determining the scope of protection it should be accorded.”).
of the massively promoted WHERE THERE'S LIFE . . . THERE'S BUD mark for beer was able to enjoin the defendant's use of WHERE THERE'S LIFE . . . THERE'S BUGS for its (presumably) unrelated product, namely, a combination insecticide and floor wax. Similarly, the University of Georgia Athletic Association successfully asserted its strong stylized bulldog design mark for "services related to sports activities" against the manufacturer of BATTLIN' BULLDOG beer, which featured a similar canine.\textsuperscript{238} In contrast, however, the owner of a weak mark or trade dress may be unable to protect it against similar uses on virtually identical goods or services.\textsuperscript{239}

B. SIMILARITY OR DISSIMILARITY OF MARKS OR TRADE DRESSES

1. Determining the Degree of Similarity or Dissimilarity. In Eskay Drugs, Inc. v. Smith Kline & French Laboratories,\textsuperscript{237} the former Fifth Circuit rejected the principle that to be found liable for unfair competition a defendant must adopt a designation of origin identical to the plaintiff's.\textsuperscript{238} Under this rule, the degree of similarity between two parties' marks or trade dresses is "really nothing more than a subjective eyeball test."\textsuperscript{239} In applying this test, "[t]he similarity of design is determined by the overall impression created by the mark as a whole rather than

\textsuperscript{234} See University of Ga. Athletic Ass'n v. Laite, 756 F.2d 1535, 225 U.S.P.Q. (BNA) 1122 (11th Cir. 1985) (suit successfully brought "against wholesaler of novelty beers, who marketed beer cans portraying an English Bulldog [that] infringed on the . . . Bulldog chosen by the university as a symbol for its athletic teams").

\textsuperscript{236} See, e.g., Swatch Watch, S.A. v. Taxor, Inc., 785 F.2d 956 (11th Cir. 1986) (no likelihood of confusion between watches sold under SWATCH and T-WATCH marks); Sun Banks v. Sun Federal Sav. & Loan Ass'n, 651 F.2d 311 (5th Cir. 1981) (no likelihood of confusion between SUN FEDERAL SAVINGS AND LOAN ASSOCIATION and SUN BANKS, INC.); Armstrong Cork Co. v. World Carpets, Inc., 597 F.2d 496, 203 U.S.P.Q. (BNA) 19 (5th Cir.), cert. denied, 444 U.S. 932 (1979) (no likelihood of confusion resulting from use of WORLD in ARMSTRONG WORLD INDUSTRIES, INC. and WORLD CARPETS, INC.).

\textsuperscript{235} 188 F.2d 430, 89 U.S.P.Q. (BNA) 202 (5th Cir. 1951).

\textsuperscript{236} Id. at 431-32, 89 U.S.P.Q. (BNA) at 203-04.

simply comparing individual features of the marks. Thus, it is improper to dissect the marks or trade dresses under consideration into their individual components.

Applications of the court's "overall impression" test have on occasion reached incongruous results. In *Webb's City, Inc. v. Bell Bakeries, Inc.* for example, the court upheld the district court's finding of no likelihood of confusion between the parties' respective DANDY and DANDEE marks, despite the marks' use on identical goods. Similarly, in *Exxon Corp. v. Texas Motor Exchange*, another panel of the court reached a similar result after examining the parties' EXXON and TEX-ON marks, albeit over the dissent of Judge Brown who, recanting his earlier participation in *Webb's City*, had come to object to "the notion that confusion dissipates by a simple hyphen."
In stark contrast, however, the court also has proven willing to ignore minor differences between designations of origin in holding confusion likely between, for example, CITIBANK and CITIBANC,\textsuperscript{244} F. REMY and REMY MARTIN,\textsuperscript{247} and two stylized English bulldog designs differing primarily in the lengths of their tails.\textsuperscript{248} Indeed, in \textit{Jellibeans, Inc. v. Skating Clubs},\textsuperscript{249} the court apparently jettisoned altogether reliance on the physical appearance of the marks themselves in holding that the marks JELLIBEANS and LOLLIPOPS—easily distinguishable on their face—created the same general impression when used as names for competing roller-skating rinks.\textsuperscript{250}

To the extent that these cases can be reconciled, it is on the basis of the strengths of the underlying marks or trade dresses at issue. In \textit{Sun Banks v. Sun Federal Savings \& Loan Ass'n},\textsuperscript{251} the court overturned the trial court's determination that the defendant's SUN FEDERAL SAVINGS AND LOAN ASS'N mark was likely to be confused with the plaintiff's SUN BANKS designation. Focusing on visual dissimilarities between the parties' marks, the court observed that such dissimilarities should be given greater weight if the similarities—the common word "Sun"—would be weak indicators of origin in and of themselves. As the court explained, "[w]hether an addition is sufficient to prevent confusion in a particular instance depends upon the strength of the main part of the mark and the distinctiveness of the additional feature. Where a trademark is itself weak, minor additions may effectively negate any confusing similarity."\textsuperscript{252}

\textsuperscript{244} Citibank, N.A. v. Citibanc Group, Inc., 724 F.2d 1540, 1547, 222 U.S.P.Q. (BNA) 292, 298 (11th Cir. 1984).
\textsuperscript{248} University of Ga. Athletic Ass'n v. Laite, 756 F.2d 1535, 1545 n.21, 225 U.S.P.Q. (BNA) 1122, 1131 n.21 (11th Cir. 1985).
\textsuperscript{249} Id. at 833, 222 U.S.P.Q. (BNA) 10 (11th Cir. 1983).
\textsuperscript{250} Id. at 842, 222 U.S.P.Q. (BNA) at 18.
\textsuperscript{251} Id. at 844, 222 U.S.P.Q. (BNA) at 844 (5th Cir. 1981).
\textsuperscript{252} Id. at 849.

For another example of this methodology in action, see Vision Center v. Opticks, Inc., 596 F.2d 111, 202 U.S.P.Q. (BNA) 333 (5th Cir. 1979), cert. denied, 444 U.S. 1016 (1980), which involved the plaintiff's attempt to enjoin use of the defendant's PEARLE VISION CENTER service mark. Finding that the only similarities between the parties' marks consisted of the descriptive words VISION CENTER, the court held the defendant's addition of a prefix to

https://digitalcommons.law.uga.edu/jipl/vol2/iss1/3
2. The Effects of Similarity or Dissimilarity. Once a court has determined the degree of similarity between two marks or trade dresses, the weight of such a determination within the likelihood of confusion analysis is a somewhat unsettling issue in the Eleventh Circuit. Obviously, there must be a threshold level of similarity before the other likelihood of confusion factors may come into play. Moreover, it is equally apparent that "the greater the similarity in the design of the trademarks, the greater the likelihood of confusion." Notwithstanding these generally clear principles, however, the extent to which this factor may influence the ultimate likelihood of confusion analysis has proven to be the subject of considerable judicial debate.

The court's early decisions addressing the issue strongly suggested that this factor was an important one. In Frostie Co. v. Dr. Pepper Co., for example, although noting that "all relevant evidence should be considered," the court observed that "[i]n determining whether there was likelihood of confusion, a matter as to which there was no substantial evidence, we are of the view that a mere ocular examination of the two marks might permit the trial court to make its conclusion." Similarly, in National Ass'n of Blue Shield Plans v. United Bankers Life Insurance Co., the court reversed the trial court's finding that confusion was unlikely by holding that "[w]e need only compare to the two symbols as they appear in the exhibits which are before the Court and to mentally juxtapose the two word-marks as they appear in print... to find that confusion is not only likely, but probable." A similar result occurred in Beef/Earer Restaurants, Inc. v. James Burrough
in which the court rejected the appellant’s argument that the trial court had failed to give appropriate weight to the absence of actual confusion with the observation that “[a]ppellant . . . overlooks the principle of law that the trial judge, by inspection of the trademarks, may himself determine, and must determine, the likelihood of confusion.”

These decisions did not, however, prepare the trademark bar for the court’s apparent holding in Boston Professional Hockey Ass’n, v. Dallas Cap & Emblem Manufacturing, Inc. that a close similarity between marks could support a finding of a likelihood of confusion, separately and independently of any consideration of the other Roto-Rooter factors. In Boston Professional Hockey, the defendant made and sold embroidered cloth symbols of various National Hockey League teams. As the court observed in distinguishing these facts from those in its prior decisions, “[t]he difficulty with this case stems from the fact that . . . [t]he statutory and case law of trademarks is oriented toward the use of such marks to sell something other than the mark itself.”

The court made short work of this difficulty, however, in rejecting the defendant’s argument that its customers were unlikely to think that the emblems originated from the plaintiffs:

This argument misplaces the purpose of the [Lanham Act’s] confusion requirement. The confusion or deceit requirement is met by the fact that the defendant duplicated the protected trademarks and sold them to the public knowing that the public would identify them as being the teams’ trademarks. The certain knowledge of the buyer that the source and origin of the trademark symbols were in [the] plaintiffs satisfies the requirement of the act. The argument that confusion must be as to the source of the manufacture of the emblem itself is unpersuasive, where

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259 398 F.2d 637, 158 U.S.P.Q. (BNA) 562 (5th Cir. 1968).
262 Id. at 1010, 185 U.S.P.Q. (BNA) at 368.
the trademark . . . is the triggering mechanism for the sale of the emblem. 263

The court thus held that the plaintiffs had a property right in the marks themselves, separate and independent from the traditional trademark right to use the mark as an indicator of the source of a product. 264 Consequently, under Boston Professional Hockey, any use of a mark constituted infringement per se, provided that consumers recognized that the plaintiff owned the mark.

Less than two years later, another panel of the court qualified Boston Professional Hockey's apparent wholesale disposal of the remaining likelihood of confusion factors. In Kentucky Fried Chicken Corp. v. Diversified Packaging Corp., 265 the plaintiff fast food franchisor sought to enjoin the defendant's sale to the plaintiff's franchisees of, inter alia, carry-out chicken boxes bearing colorable imitations of the plaintiff's distinctive red-and-white striped trade dress. Although it affirmed the district court's holding in the plaintiff's favor, the court renewed its adherence to the full-blown likelihood of confusion analysis, noting that "[o]ur cases demonstrate unbroken insistence upon likelihood of confusion, and by doing so they reject any notion that a trademark is an owner's 'property' to be protected irrespective of its role in the operation of our markets." 266 Distinguishing Boston Professional Hockey, the Kentucky Fried Chicken panel noted that in the earlier case the facts "supported the inescapable inference that many [consumers] would believe that the product itself originated with or was somehow endorsed by [the plaintiff]." 267

Subsequent to the Fifth-Eleventh Circuit split, 268 the modern Fifth Circuit effectively has repudiated the Boston Professional Hockey rule that the mere use of a plaintiff's trademark can

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263 Id. at 1012, 185 U.S.P.Q. (BNA) at 369.
264 Id. at 1014, 185 U.S.P.Q. (BNA) at 371.
265 549 F.2d 368, 193 U.S.P.Q. (BNA) 649 (5th Cir. 1977).
266 Id. at 388-89, 193 U.S.P.Q. (BNA) at 667 (citation omitted).
267 Id. at 389, 193 U.S.P.Q. (BNA) 668.
268 See supra note 6.
constitute infringement *per se.* Notwithstanding this retreat, however, the Eleventh Circuit not only has expressly reaffirmed the earlier case's infringement *per se* analysis in *University of Georgia Athletic Ass'n v. Laite,* but has defended its predecessor court against withering attacks from the Ninth Circuit.

Notwithstanding the continued viability of the infringement *per se* rule, the doctrine's applicability appears to be limited to facts such as those in *Boston Professional Hockey* and *Laite*, namely, those involving so-called "identification goods" whose marks' reproductions frequently represent the actual commodity being sold. In *Safeway Stores, Inc. v. Safeway Discount Drugs, Inc.,* for example, a panel of the court that included the future author of

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**Footnotes:**

269 See Supreme Assembly, Order of Rainbow for Girls v. J.H. Ray Jewelry Co., 676 F.2d 1079, 1085 n.7, 217 U.S.P.Q. (BNA) 767, 763 n.7 (5th Cir. 1982) ("It is not enough that typical buyers purchase the items because of the presence of the mark; it must be shown that they would purchase the items because the presence of the mark indicates to them the necessary connection between the items themselves and the owner of the mark.").

270 756 F.2d 1535, 1547, 225 U.S.P.Q. (BNA) 1122, 1131 (11th Cir. 1985).

271 The sharpest judicial attack on the *Boston Professional Hockey per se* doctrine occurred in *International Order of Job's Daughters v. Lindeburg & Co.,* 633 F.2d 912, 208 U.S.P.Q. (BNA) 718 (9th Cir. 1980), cert. denied, 452 U.S. 941 (1981), which accused the former Fifth Circuit as having "extended the protection [of trademark law] beyond that intended by Congress and beyond that accorded by any other court." *Id.* at 919, 208 U.S.P.Q. (BNA) at 725. With respect to *Boston Professional Hockey's* underlying assumption that consumers purchasing goods bearing reproductions of a plaintiff's trademarks would assume that the goods were sponsored or authorized by the plaintiff, the *Job's Daughters* court noted that "it would be naive to conclude that the name or emblem is desired because consumers believe that the product somehow originated with or was sponsored by the organization the name or emblem signifies." *Id.* at 918, 208 U.S.P.Q. (BNA) at 724. In response, the Eleventh Circuit observed:

- We respectfully disagree. The record in the instant case reveals that, in one week, at least ten to fifteen members of the public contacted [the plaintiff] to inquire about the connection between [the defendant's product] and the [plaintiff]. This evidence indicates that, contrary to the unsupported assertion of the Ninth Circuit in *Job's Daughters,* at least some members of the public do assume that products bearing the mark of a school or a sports team are sponsored or licensed by the School or team.

- Furthermore, in our view, most consumers who purchase products containing the name or emblem of their favorite school or sports team would prefer an officially sponsored or licensed product to an [unlicensed] product. Were this not true, the word "official" would not appear in so many advertisements for such products.

*Laite,* 756 F.2d at 1547 n.28, 225 U.S.P.Q. (BNA) at 1131 n.28 (citations omitted).

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the opinion in Laite failed to mention Boston Professional Hockey at all in applying a standard likelihood of confusion analysis to find that the defendant’s use of the SAFEWAY mark infringed the plaintiff’s rights to the identical mark. Indeed, other than Boston Professional Hockey and Laite, no decision of the court has applied the “triggering mechanism” analysis, suggesting that outside of the identification goods context this factor remains just that—a single factor, rather than a test in and of itself.²⁷³

C. SIMILARITY OF PRODUCTS AND SERVICES

The court’s statements of the importance of this factor often are deceptively simple: “That the products [or services] involved are similar is evidence tending to prove the existence of a likelihood of confusion.”²⁷⁴ “The greater the similarity between the products and services, the greater the likelihood of confusion.”²⁷⁵ Thus, holdings of infringement are more likely to occur in cases in which the parties’ wares are identical,²⁷⁶ while a “complete dissimilarity” in goods and services weighs toward a finding that confusion is unlikely.²⁷⁷

It is apparent, however, that an identity of goods or services is not a requirement for a finding of likelihood of confusion:

²⁷³ See, e.g., Wesco Mfg. v. Tropical Attractions, Inc., 833 F.2d 1484, 1489, 5 U.S.P.Q.2d (BNA) 1190, 1194 (11th Cir. 1987) (reversing holding in defendant’s favor on ground that “the court incorrectly focused solely on the degree of visual similarity between the two marks”).


²⁷⁵ Exxon Corp. v. Texas Motor Exch., 628 F.2d 500, 505, 208 U.S.P.Q. (BNA) 384, 388 (5th Cir. 1980).


²⁷⁷ See Sears, Roebuck & Co. v. All States Life Ins. Co., 246 F.2d 181, 167, 114 U.S.P.Q. (BNA) 19, 22 (6th Cir.) (“The complete dissimilarity of the articles in whose sale [the] mark is used... is relevant to the determination of whether there... is likelihood of confusion.”), cert. denied, 355 U.S. 894 (1957).
Often and recently we have made plain that direct competition between the products is not a prerequisite to protective relief. . . . Confusion, or the likelihood of confusion, not competition, is the real test of trademark infringement. Whether or not direct competition exists is but one of the elements to be considered in determining whether there is or will be a likelihood of confusion.\textsuperscript{278}

On one level, applications of this standard are likely to turn on the logical connection between particular non-competing goods and services.\textsuperscript{279} Often this association is natural, as in cases acknowledging the possibility of actionable confusion between similar marks used in connection with, for example, wine and brandy,\textsuperscript{280}


One's interest in a trade-mark or trade name came to be protected against simulation . . . not only on competing goods, but on goods so related in the market to those on which the trade-mark or trade name is used that the good or ill repute of the one type of goods is likely to be visited upon the other. Thus, one's interest in a trade-mark or trade name is protected against being subjected to the hazards of another's business.

\textsuperscript{279} As the court has explained:

Trademark jurisprudence . . . has long recognized that the lack of competitiveness is not always dispositive of the question of confusion and hence infringement. One such relationship where this is true exists when the sponsor or maker of one business or product might naturally be assumed to be the maker or sponsor of another business or product. The confusion evident in such cases is confusion of the business; the deceived customer buys the infringer's product in the belief that it originates with the trademark owner or that it in some way is affiliated with the owner. When this occurs, the infringer is unjustly trading on the true owner's established reputation. This is the precise wrong trademark legislation seeks to prevent.


food and gin, whisky and cigars, bus transportation and sightseeing tours, airplane engines and automobile engines, golf courses and golfers’ associations, and shrimp processing services and processed shrimp.

As previously indicated, however, the emphasis given to the apparent connection between the parties’ goods and services often varies with the court’s determination of the strength of the plaintiff’s mark or trade dress. Thus, a finding that the plaintiff’s mark or trade dress is weak will reduce significantly the weight accorded to the fact that both parties’ goods or services are edible, involve insurance, holiday lodging, or banking services. Indeed, in the face of such a finding, even an identity of the parties’ lines of business may not warrant a

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283 See Greyhound Corp. v. Goberna, 128 F.2d 806, 807, 54 U.S.P.Q. (BNA) 45, 47 (5th Cir. 1942) (confusion likely between GREYHOUND bus travel and GREYHOUND tours).


286 See Conagra, Inc. v. Singleton, 743 F.2d 1508, 1514, 224 U.S.P.Q. (BNA) 552, 556 (11th Cir. 1984) (confusion likely between use of SINGLETON name in connection with shrimp processing services and processed shrimp).

287 See supra notes 232-236 and accompanying text.


conclusion that confusion is likely.292

The contrary proposition holds with equal force. Under appropriate circumstances, a strong mark’s fame may assist dramatically its owner’s ability to challenge use of similar marks on differing goods. Thus, the defendant in Chemical Corp. of America v. Anheuser-Busch, Inc.293 was unable to interest the former Fifth Circuit in the differences between floor wax and beer in the face of “the good will created by the tremendous expenditure in advertising by the plaintiff.”294 Likewise, in another beer case, the court made equally short shrift of the defendant’s claim that “no one actually believes that the University of Georgia has gone into the brewing business” after finding that the plaintiff’s mark, used in connection with sports teams, was a strong one.295

D. SIMILARITY OF RETAIL OUTLETS AND PURCHASERS

“Dissimilarities between the retail outlets for and the predominant consumers of plaintiffs’ and defendants’ goods lessen the possibility of confusion, mistake, or deception.”296 Similarly, an identity of purchasers and outlets weighs in favor of a holding that confusion is likely.297 Significantly, however, the court has


294 Id. at 438, 134 U.S.P.Q. (BNA) at 528.


297 See, e.g., American Foods, Inc. v. Golden Flake, Inc., 312 F.2d 619, 624, 136 U.S.P.Q. (BNA) 286, 289 (5th Cir. 1965) (noting that goods sold “in same outlet to the same class of purchasers” indicates greater likelihood of confusion); Pure Foods, Inc. v. Minute Maid Corp., 214 F.2d 792, 797, 102 U.S.P.Q. (BNA) 271, 274 (5th Cir.) (observing that products purchased by “common purchasers . . . through common outlets” indicates greater likelihood of
suggested that this factor is, in and of itself, of insufficient weight to support a finding of infringement or noninfringement as a matter of law.298

Early decisions of the court, particularly those involving food, displayed a tendency to apply the "housewife" test, with the perceptiveness of this buying population typically faring poorly in the court's estimation. As the court noted in Pure Foods, Inc. v. Minute Maid Corp.,299 in support of its holding that confusion was likely between the parties' marks:

Plaintiff's frozen fruit juice concentrates and defendant's frozen meats are both purchased by common purchasers, housewives, through common outlets, retail stores, and are displayed in the frozen food departments in those stores, often in locations not far apart. A number of housewives testified to their actual confusion and mistake in buying the defendant's products on their faith in the plaintiff's reputation.300

Similarly, a separate panel of the court in American Foods, Inc. v. Golden Flake, Inc.301 also upheld a finding of infringement in part on the ground that "[i]t was undisputed that the products in question, all falling into the food category, are sold in the same types of stores, and on occasion in the same locations in the stores, and in the main are purchased by housewives during the course of grocery shopping."302


Obviously, it may be possible to have an identity of one of these elements without an identity of the other. See, e.g., Exxon Corp., 628 F.2d at 505-06, 208 U.S.P.Q. (BNA) at 388 (finding identity of parties' customers but not of retail outlets).

298 See Sun-Fun Prods., Inc. v. Suntan Research & Dev. Inc., 656 F.2d 186, 192, 213 U.S.P.Q. (BNA) 91, 96 (5th Cir. Unit B 1981) (comparing "retail outlets" used by parties "is an inadequate basis for directed verdict").


300 Id. at 797, 102 U.S.P.Q. (BNA) at 274.

301 312 F.2d 619, 136 U.S.P.Q. (BNA) 286 (5th Cir. 1963).

302 Id. at 622-23, 136 U.S.P.Q. (BNA) at 288. For a similar analysis, but reaching a different result from that in Minute Maid and Golden Flake, see Sun-Maid Raisin Growers v. Sunaid Food Products, Inc., 356 F.2d 467, 468, 149 U.S.P.Q. (BNA) 238, 238 (5th Cir. 1966) (per curiam) (upholding finding of no likelihood of confusion despite fact that "[t]he
Consistent with this analysis, the court's most significant treatment of this factor came in Amstar Corp. v. Domino's Pizza, Inc., a case that also involved homemakers. In Amstar, the manufacturer of DOMINO sugar sought to enjoin the defendant's use of the DOMINO'S PIZZA mark. Although the plaintiff was successful at trial, the former Fifth Circuit rejected the plaintiff's efforts to demonstrate a similarity in purchasers. In the face of evidence that the defendant's customers were "primarily young (85.6% under 35 years of age), single (61%) males (63.3%)," while those of the plaintiff were "middle-aged housewives," the court concluded that "[t]here are substantial dissimilarities between the predominant purchasers of plaintiff's and defendants' products." In addition to this evidence weighing against the trial court's determination that confusion was likely, the appellate court found these purchaser differences sufficient to render a survey conducted among a population consisting mostly of the plaintiff's customer base worthy only of limited weight.

E. SIMILARITY OF ADVERTISING MEDIA

Although the weight properly given to similarity or dissimilarity in advertising media in the likelihood of confusion analysis varies, this factor, as a general rule, has never been an overriding one. On the most basic level, it is apparent that similarities in advertising media are probative of a likelihood of confusion. Thus, in upholding the district court's finding that confusion was likely in Exxon Corp. v. Texas Motor Exchange, the court noted that "[t]he greater the similarity in the campaigns, the greater the likelihood of confusion. In the case at bar, both plaintiff and defendant use virtually identical advertising media. Both parties used radio, television, newspaper ads, yellow page ads, and large signs

goods of both parties are normally sold in food stores and purchased by the same consumers, usually grocery shopping housewives").

304 Id. at 262, 205 U.S.P.Q. (BNA) at 978.
305 See id. at 264, 205 U.S.P.Q. (BNA) at 979 (holding that purchaser differences "significantly reduce [the survey's] probative value").
306 628 F.2d 500, 208 U.S.P.Q. (BNA) 384 (5th Cir. 1980).
identifying their places of business. That individual media do not carry both parties' advertisements is irrelevant if their target audiences overlap.

The court has been unable to produce a precise rule of determining when an identity of advertising efforts exists, however, particularly if one party is engaged in national campaigns, while the other's efforts are more narrowly targeted. In Exxon, for example, the court found that the defendant could not escape a negative application of this factor by showing that its advertising was aimed specifically at the Houston market, while the plaintiff's promotional efforts had no such narrow focus. In contrast, however, the court in Amstar Corp. v. Domino's Pizza, Inc. relied upon just such a distinction in holding that the plaintiff's advertising campaign "in nationally circulated magazines, newspapers and trade journals, and [expenditure of] substantial sums of money on radio and television commercials" was distinct from the defendant's efforts, which were "targeted at young, male college students."

Assuming that dissimilarities do, in fact, exist, the court also has reached varying results on the weight to be given them. The court has, for example, recognized the converse of the rule set forth in Exxon, namely, that dissimilarities are probative of the absence of a likelihood of confusion. In contrast, however, the court in at least one case has upheld the district court's determination that

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307 Id. at 506, 208 U.S.P.Q. (BNA) at 388; see also John H. Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 976-77, 219 U.S.P.Q. (BNA) 515, 525 (11th Cir. 1983) (affirming finding of likelihood of confusion due, inter alia, to strong similarity of advertising campaigns); Volkswagenwerk Aktiengesellschaft v. Rickard, 492 F.2d 474, 478, 181 U.S.P.Q. (BNA) 611, 614 (5th Cir. 1974) (noting that finding of infringement is more likely where, as here, both companies used VW symbol and "bug" idea in their respective advertising campaigns).


311 Id. at 262, 205 U.S.P.Q. (BNA) at 978.

differences in the parties' advertising may be ignored if the relevant industry is one in which "'advertising habits can change at will,'" which raises the possibility that the parties' promotional efforts will converge in the future.315

F. DEFENDANT'S INTENT

In Aetna Casualty & Surety Co. v. Aetna Auto Finance, Inc.,314 the former Fifth Circuit articulated a classic formulation of the early common-law test of infringement316 that was to remain influential even after the 1946 enactment of the Lanham Act and the adoption of the Roto-Rooter factors:

[M]ore significant and important . . . is the purpose evidenced by the choice, by this new comer into the field . . . of name and advertising matter. This purpose is to project itself into that business arena panoplied in a name already favorably known, rather than to come into it on its own merits, and slowly building, here a little, there a little, establish its own place. . . . [W]here as here it plainly appears that there is a purpose to reap where one has not sown, to gather where one has not planted, to build upon the work and reputation of another, the use of the advertising or trade name or distinguishing mark of another, is in its nature, fraudulent and will be enjoined.316


For a case using analogous reasoning, but reaching a contrary result, see Armstrong Cork Co. v. World Carpets, Inc., 597 F.2d 496, 505, 203 U.S.P.Q. (BNA) 19, 25-26 (5th Cir.) (finding no likelihood of confusion in part because "[t]here is nothing in the record that suggests that [the defendant] will deviate from its own present policy of [advertising] . . . "), cert. denied, 444 U.S. 932 (1979).

314 123 F.2d 582, 51 U.S.P.Q. (BNA) 435 (5th Cir. 1941), cert. denied, 315 U.S. 824 (1942).

315 See supra notes 7-13 and accompanying text.

316 123 F.2d at 584, 51 U.S.P.Q. (BNA) at 427-38.
Indeed, although bad faith is not a prerequisite to a finding of liability, as with the similarity between marks factor under the Boston Professional Hockey per se rule, the court has suggested that a defendant's improper intent in and of itself may justify a finding of liability. In Sun-Fun Products, Inc. v. Suntan Research & Development Inc., for example, the court reversed a directed verdict for the defendant manufacturer of suntan lotion against the plaintiff's charges that the defendant's packaging was confusingly similar to its own. Although holding that a variety of factors justified submitting the case to the jury, the court found that one merited particular mention:

The linchpin of [the plaintiff's] case was Weisburg's testimony that he had been instructed to copy the Native Tan bottle. Evidence of intentional deception carries special weight in the calculus of determining likelihood of confusion. Indeed, proof that a defendant chose a mark with the intent of copying [a] plaintiff's mark, standing alone, may justify an

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317 [W]hile intent is of some probative value, particularly if a bad intent is shown, it is neither a necessary nor sufficient condition for determining the ultimate legal fact of the 'likelihood of confusion.' " Jellibean, Inc. v. Skating Clubs, 716 F.2d 833, 843 n.23, 222 U.S.P.Q. (BNA) 10, 19 n.23 (11th Cir. 1983). See also Original Appalachian Artworks, Inc. v. Toy Loft, Inc., 684 F.2d 821, 831-32, 215 U.S.P.Q. (BNA) 745, 754 (11th Cir. 1982) (noting that relevant test is likelihood of confusion, not intent to infringe); Kentucky Fried Chicken Corp. v. Diversified Packaging Corp., 549 F.2d 368, 385, 193 U.S.P.Q. (BNA) 649, 664 (5th Cir. 1977) (stating that intent is relevant, but not essential, to finding of unfair competition); Volkswagenwerk Aktiengesellschaft v. Rickard, 492 F.2d 474, 478, 181 U.S.P.Q. (BNA) 611, 614 (5th Cir. 1974) (holding that intent is not necessary element of tort of unfair competition); American Foods, Inc. v. Golden Flake, Inc., 312 F.2d 619, 625, 136 U.S.P.Q. (BNA) 286, 290 (5th Cir. 1963) (stating that absence of intent to mislead was not defense, but merely one factor of many to be considered).

318 See supra notes 261-273 and accompanying text.

319 Although the former Fifth Circuit observed in B.H. Bunn Co. v. AAA Replacement Parts Co., 451 F.2d 1254, 171 U.S.P.Q. (BNA) 780 (5th Cir. 1971), that intent has no relevance to a finding of infringement, id. at 1264, 171 U.S.P.Q. (BNA) at 787, the court has rejected this position. See Safeway Stores, Inc. v. Safeway Discount Drugs, Inc., 675 F.2d 1160, 1164 n.4, 216 U.S.P.Q. (BNA) 699, 602 n.4 (11th Cir. 1982) (noting rejection of B.H. Bunn standard by subsequent Fifth Circuit cases).

inference of confusing similarity.\textsuperscript{321}

Precisely what merits a finding of bad faith\textsuperscript{322} warranting invocation of this rule, however, is unclear. A defendant may, of course, admit that his actions were calculated to capitalize upon the plaintiff's popularity. In \textit{University of Georgia Athletic Ass'n v. Laite},\textsuperscript{323} for example, the defendant manufacturer of \textsc{Battlin' Bulldog} beer did not dispute the plaintiff's claims that he sought to sell his beer not by relying on its taste, but instead by attracting the attention of University of Georgia football fans.\textsuperscript{324} Likewise, in \textit{Bauer Lamp Co. v. Shaffer},\textsuperscript{325} both the district court and the Eleventh Circuit relied on the defendants' repeated pre-trial assertions that they were going to drive the plaintiff lamp manufacturer out of business by flooding the market with cheap products.

\textsuperscript{321} \textit{Id.} at 190, 213 U.S.P.Q. (BNA) at 94-95; see also \textit{Bauer Lamp Co. v. Shaffer}, 941 F.2d 1165, 1172, 20 U.S.P.Q.2d (BNA) 1128, 1133 (11th Cir. 1991) (per curiam) (noting that intent creates rebuttable presumption of likelihood of confusion); \textit{Sun Banks v. Sun Fed. Sav. & Loan Ass'n}, 651 F.2d 311, 318-19, 211 U.S.P.Q. (BNA) 844, 851 (5th Cir. 1981) (recognizing import of deliberately adopting another's mark to capitalize on reputation and resulting confusion); \textit{Exxon Motor Corp. v. Texas Motor Exch.}, 628 F.2d 500, 506, 208 U.S.P.Q. (BNA) 384, 389 (5th Cir. 1980) (holding that intent alone could provide inference of confusing similarity); \textit{Amstar Corp. v. Domino's Pizza, Inc.}, 615 F.2d 252, 263, 206 U.S.P.Q. (BNA) 969, 978 (5th Cir.) (noting that intent to adopt identical name would have been critical factor), \textit{cert. denied}, 449 U.S. 899 (1980). \textit{But see} \textit{Original Appalachian Artworks, Inc. v. Toy Loft, Inc.}, 684 F.2d 821, 831-32, 215 U.S.P.Q. (BNA) 745, 754 (11th Cir. 1982) ("The defendant's intent to tread on the goodwill of the plaintiff, while certainly a relevant factor in establishing a likelihood of confusion, is not the only factor." (citation omitted)).

Significantly, this rule presupposes that the plaintiff has a protectable mark, as "[t]here is nothing wrong with exact copying of an article or a symbol in the public domain." John H. Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 977 n.16, 219 U.S.P.Q. (BNA) 515, 525 n.16 (11th Cir. 1983) (quoting J. THOMAS McCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 23:35, at 111-12 (2d ed. 1984)).

\textsuperscript{322} Like the other factors making up the likelihood of confusion analysis, a trial court's determination of whether bad faith intent exists is a question of fact and not to be disturbed unless clearly erroneous. \textit{Chanel, Inc. v. Italian Activewear, Inc.}, 931 F.2d 1472, 1476, 19 U.S.P.Q. (BNA) 1068, 1070-71 (11th Cir. 1991).

\textsuperscript{323} 756 F.2d 1535, 225 U.S.P.Q. (BNA) 1122 (11th Cir. 1985).

\textsuperscript{324} \textit{Id.} at 1546, 225 U.S.P.Q. (BNA) at 1129. \textit{See also} \textit{Miami Credit Bureau, Inc. v. Credit Bureau, Inc.}, 276 F.2d 665, 668, 125 U.S.P.Q. (BNA) 87, 89 (5th Cir. 1960) (upholding trial court's finding of likely confusion in part because "in a colloquy between the trial judge and [the defendant] the latter virtually admitted that he picked out the [plaintiffs'] trade name and used it in the telephone directory in the hope that those looking for a credit bureau would find the name and come to him").

\textsuperscript{325} 941 F.2d 1165, 20 U.S.P.Q.2d (BNA) 1128 (11th Cir. 1991) (per curiam).
imitations of its products to find that the defendants had intended to infringe the plaintiff's trade dress.\textsuperscript{326}

Such cases obviously are rare, with plaintiffs usually being forced to rely on circumstantial evidence to prove bad faith intent. At least one pre-\textit{Roto-Rooter} decision held that adoption of a mark with knowledge of an earlier established use constitutes an impermissible intent because "a man intends the natural and probable consequences of his acts."\textsuperscript{327} More recent decisions, however, have required more, with the court in \textit{Amstar Corp. v. Domino's Pizza, Inc.}\textsuperscript{328} noting that "[b]ad faith in the adoption and use of a trademark normally involves the imitation of packaging material, use of identical code numbers, adopting of similar distribution methods or other efforts by a party to 'pass off' its product as that of another."\textsuperscript{329} Other factors accepted by the court as probative evidence of bad faith include an attempt by the defendant to get as close as possible to the plaintiff's mark without infringing\textsuperscript{330} and the defendant's otherwise unexplained depart-

\textsuperscript{326} Id. at 1172, 20 U.S.P.Q.2d (BNA) at 1133.


\textsuperscript{328} 615 F.2d 252, 205 U.S.P.Q. (BNA) 969 (5th Cir.), cert. denied, 449 U.S. 899 (1980).

\textsuperscript{329} Id. at 263, 205 U.S.P.Q. (BNA) at 978.

\textsuperscript{330} See, e.g., National Ass'n of Blue Shield Plans v. United Bankers Life Ins. Co., 362 F.2d 374, 377, 150 U.S.P.Q. (BNA) 80, 82 (5th Cir. 1966) (holding that where infringer tries to initiate mark as closely as possible, courts will follow infringer's judgment and find likelihood of confusion); Clifton Mfg. Co. v. Crawford-Austin Mfg. Co., 30 F.2d 392, 393 (5th Cir. 1929) (per curiam) (finding infringement where infringer attempted to come as close to mark as it could without incurring legal liability). Under these circumstances, that a defendant may have sought legal advice as to how close it could come to the plaintiff's mark does not preclude its infringement from being considered intentional. John H. Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 977-78, 219 U.S.P.Q. (BNA) 515, 525-26 (11th Cir. 1983).

Note that this factor is not triggered by a defendant's mere adoption of a mark with knowledge of the plaintiff's prior use of the same mark. See El Chico, Inc. v. El Chico Cafe, 214 F.2d 721, 726, 102 U.S.P.Q. (BNA) 267, 270 (5th Cir. 1954) (upholding district court's finding that confusion was unlikely, in part because "though the defendants knew of plaintiff's use of the name, they further knew that the plaintiff did not have an exclusive right to such use as against a noncompeting business"). Of perhaps equal significance in trade dress cases, that a defendant created its design while in possession of the plaintiff's design does not necessarily trigger a finding of bad faith intent to copy, particularly if the plaintiff's design was only one of many studied by the defendant. See Rose Bicycles, Inc. v. Cycles USA, Inc., 765 F.2d 1502, 1508, 226 U.S.P.Q. (BNA) 879, 880 (11th Cir. 1985) (adopting district court opinion that merely testing another company's bicycle did not show intent to copy, especially where almost every component differed between two bicycles).
ture from its prior mark usage.

G. ACTUAL CONFUSION

As reflected in the *Roto-Rooter* test itself, although it is not necessary for a plaintiff to show that a defendant's actions have created actual confusion, its existence weighs heavily in favor of an ultimate determination that confusion is likely. The court repeatedly has underscored this point:

While this circuit regards the question of confusion as a fact determination, it is not necessary to show actual confusion. One merely has to show that the likelihood of confusion exists. There can be no more positive or substantial proof of the likelihood of confusion than proof of actual confusion. Moreover, reason tells us that while very little proof of actual confusion would be necessary to prove the likelihood of confusion, an almost overwhelming amount of proof would be necessary to refute such proof.

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Although the court has identified these factors in the context of the likelihood of confusion standard for liability, questions of a defendant's intent also arise in cases considering whether a successful plaintiff is entitled to treble damages and attorneys' fees under 15 U.S.C. § 1117(b) (1988). In such cases, the court has held that a defendant's willful blindness to the unauthorized nature of its goods can, in and of itself, constitute bad faith intent. See Chanel, Inc. v. Italian Activewear, Inc., 931 F.2d 1472, 1476, 19 U.S.P.Q.2d (BNA) 1068, 1070-71 (11th Cir. 1991) (holding that willful blindness may provide requisite intent or bad faith).


333 World Carpets, Inc. v. Dick Littrell's New World Carpets, 438 F.2d 482, 489, 168 U.S.P.Q. (BNA) 609, 615 (5th Cir. 1971) (footnotes omitted); accord Roto-Rooter Corp. v. O'Neal, 513 F.2d 44, 45, 186 U.S.P.Q. (BNA) 73, 74 (5th Cir. 1975).
Although its statement is straightforward, applications of this rule have proven far less so. Indeed, it is on the subject of actual confusion that the court's decisions are perhaps themselves most confusing. This judicial disagreement has occurred primarily with respect to two types of actual confusion evidence, namely, (1) misdirected communications and inquiries; and (2) actual confusion surveys commissioned by the litigants.

1. Misdirected Communications and Inquiries. The first type of evidence typically accepted by the court as probative of actual confusion is a plaintiff's documentation of unsolicited and misdirected contacts. These contacts can consist of consumer inquiries regarding the possible affiliation between the parties or attempts to purchase goods or services actually offered by the other party. They also may consist of inquiries from nonconsumers or misdirected correspondence such as bills or let-

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334 See, e.g., Conagra, Inc. v. Singleton, 743 F.2d 1508, 1515, 224 U.S.P.Q. (BNA) 552, 557 (11th Cir. 1984) (holding evidence of customers assuming two business were affiliated strongly probative of likely confusion); Safeway Stores, Inc. v. Safeway Discount Drugs, Inc., 675 F.2d 1160, 1167, 216 U.S.P.Q. (BNA) 599, 604 (11th Cir. 1982) (same); Roto-Rooter, 513 F.2d at 46, 186 U.S.P.Q. (BNA) at 74 (same); Volkswagenwerk Aktiengesellschaft v. Rickard, 492 F.2d 474, 478, 181 U.S.P.Q. (BNA) 611, 614 (5th Cir. 1974) (same).


336 See, e.g., University of Ga. Athletic Ass'n v. Laite, 756 F.2d 1535, 1546, 225 U.S.P.Q. (BNA) 1122, 1130 (11th Cir. 1988) (holding that inquiries from fans concerned about product endorsement by university were evidence of actual confusion); Jellibeans, Inc. v. Skating Clubs, 716 F.2d 833, 843, 222 U.S.P.Q. (BNA) 10, 19 (11th Cir. 1983) (holding that concerned inquiries from three of plaintiff's friends and associates, who thought defendant's business was plaintiff's, constituted evidence of actual confusion); World Carpets, Inc. v. Dick Littrell's
The doctrinal problems posed by such communications are two-fold. First, the court has adopted inconsistent approaches in its treatment of communications from individuals who are not actual purchasers of the parties' goods or services. In at least two cases, American Television & Communications Corp. v. American Communications & Television, Inc. and Freedom Savings & Loan Ass'n v. Way, the court accorded little weight to the plaintiff's proffered evidence of mistaken inquiries about the parties' possible affiliation on the ground that none of the would-be confusion victims was a potential customer of either of the parties.

In contrast, however, most of the court's decisions addressing the issue have found probative any sort of actual confusion, provided that it may fairly be traced to a protectable aspect of the plaintiff's mark or trade dress. In John H. Harland Co. v. Clarke Checks, Inc., for example, the plaintiff check manufacturer introduced evidence that two bank employees had, at the request of customers, correctly filled out order forms for the defendant's products, but had mistakenly inserted the plaintiff's putative mark onto the forms.

New World Carpets, 438 F.2d 482, 489, 168 U.S.P.Q. (BNA) 609, 615 (5th Cir. 1971) (considering misdirected telephone calls from retailers probative of actual confusion).

337 See, e.g., Safeway, 675 F.2d at 1167, 216 U.S.P.Q. (BNA) at 604 (noting that misdirected letter from creditor warrants little weight); Conagra, 743 F.2d at 1515 n.10, 224 U.S.P.Q. (BNA) at 557 n.10 (noting that billing invoices sent to defendant for plaintiff's purchases constituted evidence of actual confusion).


339 810 F.2d 1546, 1 U.S.P.Q.2d (BNA) 2084 (11th Cir. 1987).


341 See American Television, 810 F.2d at 1550, 1 U.S.P.Q.2d (BNA) at 2087 (noting importance that plaintiff's evidence of actual confusion didn't involve consumers); Freedom Sav. & Loan, 757 F.2d at 1185, 226 U.S.P.Q. (BNA) at 129 (finding mistaken inquiries of firm's president's friends irrelevant).

342 For a case in which the court accorded little weight to the plaintiff's actual confusion evidence because it required "rank speculation" whether the confusion had been caused by the defendant's use of its marks (as opposed to some other reason), see Holiday Inns, Inc. v. Holiday Out in America, Inc., 481 F.2d 445, 448-449, 178 U.S.P.Q. (BNA) 257, 259 (5th Cir. 1973).

343 711 F.2d 966, 219 U.S.P.Q. (BNA) 515 (11th Cir. 1983).
On the defendant's appeal from an adverse jury verdict, the court acknowledged that "admittedly, neither instance involved an intended order for [the plaintiff's product] which was misdirected to [the defendant], and neither instance indicated that bank customers, the ultimate consumers, were confused." Without reference to its earlier holding in *Freedom Savings & Loan* that actual confusion among consumers was the relevant inquiry, the court observed that "we believe that the jury reasonably could have inferred that there was a likelihood of confusion from the evidence that there was at least some actual confusion among persons responsible for marketing and processing the orders for the [competing] check products."

Consistent with *John H. Harland*, the court also has accepted as evidence of actual confusion inquiries or communications from prospective employees, creditors, and the plaintiff's investors. The admission of such evidence does not necessarily mean it should be accorded equal weight, however, for "[s]hort-lived confusion or confusion of individuals casually acquainted with a business is worthy of little weight, while confusion of actual customers of a business is worthy of substantial weight."

The second area of doctrinal confusion created by this type of evidence involves the magnitude of confusion a plaintiff must show before he is entitled to relief. To a certain extent, the varying treatment of instances of actual confusion is intentional for, as the
court noted in *AmBrit, Inc. v. Kraft, Inc.*, 350 "[t]here is no absolute scale as to how many instances of actual confusion establish the existence of that factor. Rather, the court must evaluate the evidence of actual confusion in the light of the totality of the circumstances involved." 351

This sliding scale at times has resulted in apparently inconsistent results. In *AmBrit*, for example, the court found probative of a likelihood of confusion the testimony of four witnesses that they had been misled while making purchases in the marketplace. Over the strident objections of the defendant, which claimed that this number was insignificant in light of the parties' overall sales, the court noted:

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Viewed in the light of the totality of the circumstances, [the defendant's] protestations are without merit. With respect to [the defendant's] assertion that the reported instances of confusion are small given the high volume of sales, we note that it takes very little evidence to establish the existence of the actual confusion factor. Moreover, that there were only a few reported instances of actual confusion does not mean that only these individuals were actually confused. . . . It is likely that many consumers who were confused never realized they had been confused and that many of those who did realize they had been confused chose not to spend the time to register a complaint with a faceless corporation . . . . 352
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351 *Id.* at 1543, 1 U.S.P.Q.2d (BNA) at 1171. The court offered another formulation of these guidelines in *Jellibeans*, 716 F.2d at 844, 222 U.S.P.Q. (BNA) at 20 (citation omitted):

[1]n determining the sufficiency of the evidence to prove actual confusion, a court should examine the totality of the circumstances to determine how likely instances of confusion would be reported. This examination may include consideration of the time period in question and how extensively the product is advertised and made known to the public, as well as the type of confusion that exists and who suffers the confusion.

352 812 F.2d at 1544, 1 U.S.P.Q.2d (BNA) at 1172.
Relying on much the same analysis, the court has held one, two, three, four, thirteen, and "approximately ten (10) to fifteen (15)" instances of misdirected communications or inquiries probative of actual confusion, and indeed, has entered or upheld judgment as a matter of law based in part on two and four such instances.

In contrast to this line of cases, the court has found comparable numbers unconvincing in cases in which instances of actual confusion have occurred over long periods of time. In Amstar Corp. v. Domino's Pizza, Inc., for example, the court found that the context in which actual confusion had arisen weighed in the defendant's, rather than the plaintiff's, favor:

The evidence of actual confusion in this case is minimal. Plaintiff's evidence of actual confusion amounted to two verbal inquiries as to whether

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357 Aloé Creme Labs., Inc. v. Texas Pharmacal Co., 335 F.2d 72, 74, 142 U.S.P.Q. (BNA) 289, 291 (5th Cir. 1964).


360 Roto-Rooter Corp. v. O'Neal, 513 F.2d 44, 46, 186 U.S.P.Q. (BNA) 73, 74 (5th Cir. 1975).

361 Significantly, the court's willingness to accord weight to few instances of actual confusion does not extend to a willingness to consider testimony by a defendant's witnesses that they were not confused. See, e.g., AmBrit, Inc. v. Kraft, Inc., 812 F.2d 1531, 1544 n.69, 1 U.S.P.Q.2d (BNA) 1161, 1172 n.69 (11th Cir. 1986) ("Kraft offered the testimony of several consumers who testified that they had not been confused. The district court properly disregarded this evidence. If Kraft could not find at least a handful of consumers who would agree to testify that they had not been confused, it might as well have defaulted."). cert. denied, 481 U.S. 1041 (1987).

“Domino’s Pizza” was related to “Domino” sugar, and one misaddressed letter. In view of the fact that both plaintiff’s and defendant’s sales currently run into the millions of dollars each year, these isolated instances of confusion are insufficient to sustain a finding of a likelihood of confusion. Indeed, the fact that only three instances of actual confusion were found after nearly 15 years of extensive concurrent sales under the parties’ respective marks raises a presumption against likelihood of confusion in the future.363

The court reached a similar result in *Sun Banks v. Sun Federal Savings & Loan Ass’n*,364 in which it was equally unimpressed with the plaintiff’s evidence of “less than fifteen instances” of alleged actual confusion over a three-year period. As the *Sun Banks* court noted of this pattern, “[a]lthough the record contains several isolated instances of uncertainty whether there was a connection between the two businesses, in light of the number of transactions conducted and the extent of the parties’ advertising, the amount of past confusion is negligible.”365

2. Survey Evidence. Other than misdirected inquiries and communications, the most favored evidence of actual confusion is that arising from surveys conducted by the parties. Although the court’s more recent holdings have proven somewhat more receptive to surveys, its early decisions left considerable doubt over their worth. In substantial part, this was the result of litigants’ tendency to employ word-association questionnaires that asked respondents “what comes to mind” when they were presented with particular marks.366 Although the court initially treated such...
surveys as inadmissible hearsay, it later retreated from that position in favor of a rule admitting the studies, but according them limited weight: As the court noted approvingly in *Holiday Inns, Inc. v. Holiday Out in America, Inc.*, "[i]n this case, the trial court found that the survey degenerated into a mere word-association test entitled to little weight because the format failed to account for the number of responses attributable to use of the word 'Holiday' as distinguished from the service mark HOLIDAY OUT."

By the late 1970's, however, one litigant had discovered survey methodology that would satisfy the court’s standards. In *Exxon Corp. v. Texas Motor Exchange*, the plaintiff introduced into evidence a survey that, as in *Holiday Inns*, inquired "What is the first thing that comes to mind when looking at this sign?" In contrast to the earlier case, however, the plaintiff’s instructions to its interviewers went on to read, "What was there about the sign that made you say that? (PROBE FULLY)." Relying on the presence of this question, the court not only found the survey admissible, but probative as well.

Assuming that a plaintiff designs its survey to elicit the causes of a respondent’s confusion, the next methodological hurdle it must pass is a demonstration that the survey has targeted the proper universe. The leading case on this subject is *Amstar Corp. v. Domino’s Pizza, Inc.*, in which the court found critical defects in a survey intended to demonstrate that the defendant’s use of a similar mark on pizza was likely to create confusion with the plaintiff’s mark for sugar. Although the survey was accorded significant weight at trial, the former Fifth Circuit found the district court’s treatment of it critically deficient:

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367 See *Sears, Roebuck & Co.*, 246 F.2d at 171-72, 114 U.S.P.Q. (BNA) at 25-26 (ruled survey inadmissible as hearsay when offered to prove answers received by ten interviewers).
368 481 F.2d at 448, 178 U.S.P.Q. (BNA) at 258.
369 Others, however, continued to employ impermissible “word-association” surveys, with disastrous results. See, e.g., *Amstar Corp. v. Domino’s Pizza, Inc.*, 615 F.2d 252, 264, 205 U.S.P.Q. (BNA) 969, 979 (5th Cir.) (holding that word-association survey presented no meaningful evidence of actual confusion), *cert. denied*, 449 U.S. 899 (1980).
370 628 F.2d 500, 208 U.S.P.Q. (BNA) 384 (5th Cir. 1980).
371 Id. at 508, 208 U.S.P.Q. (BNA) at 391.
372 Id., 208 U.S.P.Q. (BNA) at 391.
373 Id. at 506-07, 208 U.S.P.Q. (BNA) at 389-390.
One of the most important factors in assessing the validity of an opinion poll is the adequacy of the "survey universe," that is, the persons interviewed must adequately represent the opinions which are relevant to the litigation. The appropriate universe should include a fair sampling of those purchasers most likely to partake of the alleged infringer's goods or services.\textsuperscript{375}

Applying this standard, the appellate court found that the survey's universe, which included primarily housewives in cities in which the defendants did not operate, "neglected completely defendants' primary customers—young, single, male college students." Under these circumstances, the court held, "we do not believe that the proper universe was examined, and the results of the survey must therefore be discounted."\textsuperscript{376}

H. OTHER FACTORS

Under appropriate circumstances, "'new' factors may merit consideration" in the likelihood of confusion analysis.\textsuperscript{377} Consistent with this philosophy, the court has, on a case-by-case basis, included within its analysis additional elements, including:

1. The Degree of Care Used by Purchasers. Perhaps the most significant additional factor employed by the court is the degree to which the parties' customers are likely to exercise care when purchasing their products. In Armstrong Cork Co. v. World Carpets, Inc.,\textsuperscript{378} the federal registrant of the WORLD trademark for carpet sought to enjoin one of its competitors from changing its

\textsuperscript{375} Id. at 264, 205 U.S.P.Q. (BNA) at 979 (citation omitted).
\textsuperscript{376} Id., 205 U.S.P.Q. (BNA) at 979.


corporate name to "Armstrong World Industries, Inc." The district
court agreed that confusion was likely to result from this change;
the former Fifth Circuit, however, disagreed. Although grounding
its decision largely in differences between the parties' uses of their
respective names, the latter tribunal also held the nature of the
parties' goods probative, noting that confusion was particularly
unlikely "since a person buying a 'big ticket' item such as carpeting
would ordinarily be expected to be a more careful buyer than the
impulse purchaser or the purchaser of a relatively inexpensive
item."\(^\text{379}\)

An application of this factor, however, does not necessarily
always weigh in favor of defendants. In *Sun-Fun Products, Inc. v.
Suntan Research & Development Inc.*,\(^\text{380}\) the district court
disposed of the plaintiff suntan-lotion manufacturer's trade dress
claims by directing a verdict for the defendant. Vacating this
action on the plaintiff's appeal, the court of appeals proceeded
through the standard likelihood of confusion analysis before adding
the following consideration: "Finally, since suntan preparations are
relatively inexpensive items the buyer may take less care in
shopping and selecting the product, thereby increasing the risk of
confusion."\(^\text{381}\) A similar pattern occurred in *AmBrit, Inc. v. Kraft,
Inc.*,\(^\text{382}\) in which the court upheld a judgment in favor of the
plaintiff ice cream manufacturer in part on the ground that "[i]ce
cream novelties are an impulse item that consumers purchase
without a great deal of care."\(^\text{383}\)

2. Prior Affiliation of the Parties. A prior affiliation of the
parties is an additional factor often considered by the court, albeit
one that typically weighs in favor of a finding of infringement.
Most frequently, this factor is invoked in cases involving former or
"runaway" franchisees. In *Professional Golfers Ass'n v. Bankers

\(^{379}\) 597 F.2d at 504 n.10, 203 U.S.P.Q. (BNA) at 25 n.10. For another case approving
consideration, albeit in a cursory manner, of the price charged for the parties' products to
reach a defense verdict, see *Swatch Watch*, 785 F.2d at 958, 229 U.S.P.Q. (BNA) at 392.

\(^{380}\) 666 F.2d 186, 213 U.S.P.Q. (BNA) 91 (5th Cir. Unit B 1981).

\(^{381}\) Id. at 191, 213 U.S.P.Q. (BNA) at 95.

\(^{382}\) 812 F.2d 1531, 1 U.S.P.Q.2d (BNA) 1161 (11th Cir. 1986), cert. denied, 481 U.S. 1041

\(^{383}\) Id. at 1544, 1 U.S.P.Q.2d (BNA) at 1172.
Life & Casualty Co.,\textsuperscript{384} for example, the defendant operated a golf course and club house that, for ten years, housed the plaintiff's headquarters and prominently featured the plaintiff's mark. Upon the termination of the parties' contractual relationship, the defendant continued to use the mark in the operation of its course, prompting the plaintiff to sue. Upholding a judgment in the plaintiff's favor, the court noted "[a] former licensee cannot mislead the public into believing that its affiliation continues once the licensing arrangement has ceased. For once the contract ends, a licensee's right to the mark ends, and any subsequent use constitutes infringement."\textsuperscript{385} Indeed, the court since has suggested that such situations warrant entry of summary judgment in franchisors' favor on the ground that "[c]ommon sense compels the conclusion that a strong risk of consumer confusion arises when a terminated franchisee continues to use the former franchisor's trademarks."

The probative nature of past affiliation of the parties has not been limited to franchise situations. In \textit{Sun-Fun Products, Inc. v. Suntan Research & Development, Inc.},\textsuperscript{386} the defendant, prior to entering the market as a manufacturer, had distributed the plaintiff's suntan product through its poolside stands. In vacating a directed verdict for the defendant, the court relied on the parties' relationship as evidence warranting submission of the case to a jury: "This past supplier-distributor relationship ... is also probative evidence of likelihood of confusion."\textsuperscript{387}

3. \textit{Prior Finding of Infringement.} Consistent with the general principle that a prior relationship between the parties may weigh

\textsuperscript{384} 514 F.2d 665, 186 U.S.P.Q. (BNA) 447 (11th Cir. 1975).
\textsuperscript{385} \textit{Id.} at 670, 186 U.S.P.Q. (BNA) at 451 (citations omitted); see also \textit{Ramada Inns, Inc. v. Gadsden Motel Co.}, 804 F.2d 1662, 1666-67, 1 U.S.P.Q.2d (BNA) 1011, 1014-1015 (11th Cir. 1986) (noting that holding trademark infringement damages are not recoverable from immediate ex-franchise would be contrary to purposes behind Lanham Act and might encourage other infringers to "hold over").
\textsuperscript{386} \textit{Burger King Corp. v. Mason}, 710 F.2d 1480, 1492, 219 U.S.P.Q. (BNA) 693, 701 (11th Cir. 1983).
\textsuperscript{387} 656 F.2d 186, 213 U.S.P.Q. (BNA) 91 (5th Cir. Unit B 1981).
in favor of likely confusion, the court has generally held that a defendant under a prior injunction is under a greater duty to avoid encroaching upon the plaintiff's rights than it might otherwise have been. In *Eskay Drugs, Inc. v. Smith, Kline & French Laboratories*, for example, the plaintiff drug manufacturer and owner of the ESKAY mark had succeeded in enjoining the defendants' use of its mark "or any colorable imitation thereof," only to have the defendants change their labels and name to ENKAY. The court, however, was not amused by the defendants' actions, and upheld the district court's summary finding of contempt by observing:

In such a case as this, where the [defendants] have been found guilty of infringing the trade-mark rights of others, they should thereafter be required to keep a safe distance away from the dividing line between violation of, and compliance with, the injunction. They must do more than see how close they can come with safety to that which they were enjoined from doing.

The court faced a similar situation in *Howard Johnson Co. v. Khimani*, in which several runaway franchisees were enjoined from further use of the plaintiff's marks. In response, the defendants resumed operations under the name H.J. INNS, notwithstanding their knowledge of widespread usage among the plaintiff's franchisees of the letters H.J. As it had in *Eskay Drugs*, the court was more than willing to uphold the district court's finding of contempt, noting that "[t]his is not the case of a lodge or restaurant owner using his or her own initials to name an establishment, unaware that a similar trademarked name was used by another facility." Rather, the court found, "there was evidence . . . that the defendants deliberately sought a name that 'would be close to Howard Johnson's name, yet . . . not infringe.'"

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389 188 F.2d 430, 89 U.S.P.Q. (BNA) 202 (5th Cir. 1951).
390 Id. at 431, 89 U.S.P.Q. (BNA) at 203.
391 Id. at 432, 89 U.S.P.Q. (BNA) at 203-204 (footnote omitted).
393 Id. at 1518, 13 U.S.P.Q.2d (BNA) at 1812.
4. Use of Several of the Plaintiff's Marks. In Volkswagenwerk Aktiengesellschaft v. Rickard, the plaintiff automobile manufacturer had brought suit in response to the defendants' operation of a garage specializing in the repair and maintenance of the plaintiff's cars. In contrast to the usual case of alleged infringement, however, the defendant used several of the plaintiff's marks. In affirming the district court's holding of infringement, the former Fifth Circuit court found such conduct particularly objectionable, concluding that "[the defendants] utilized not one, but five of [the plaintiff's] marks, the cumulative effect of which is greater likelihood of confusion."

Not all the court's decisions accord such weight to apparent multiple acts of infringement, however. In Holiday Inns, Inc. v. Holiday Out in America, Inc., for example, the court was unswayed by the plaintiff's arguments in upholding a defense verdict. Significantly, this holding occurred in the face of the defendant's use of HOLIDAY OUT, HOLIDAY OUT IN AMERICA, and THE NATION'S CAMPGROUND, notwithstanding the plaintiff's prior rights to its HOLIDAY INN, HOLIDAY INN OF AMERICA, and THE NATION'S INNKEEPER marks.

5. Geographic Proximity. Under certain circumstances, the geographical proximity of the parties can play a role in the likelihood of confusion calculus. On a basic level, cases examining the distance between the parties generally have involved the plaintiff's ownership of an unregistered mark, the rights to which necessarily are limited to the plaintiff's zone of operation. Thus, for example, in the early case of Pulitzer Publishing Co. v. Houston Printing Co., the court held that confusion was unlikely substantially because the parties operated in distinct areas. In contrast, however, the court held two hundred miles' worth of separation to be an inadequate barrier against confusion in Rhea v. Bacon, in light of the fact that the parties were "connected

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394 492 F.2d 474, 181 U.S.P.Q. (BNA) 611 (5th Cir. 1974).
395 Id. at 479, 181 U.S.P.Q. (BNA) at 614.
397 Id. at 447, 178 U.S.P.Q. (BNA) at 258.
398 11 F.2d 834 (5th Cir.), cert denied, 273 U.S. 694 (1926).
399 Id. at 835.
400 87 F.2d 976 (5th Cir. 1937).
by paved highways and, with modern means of transportation, come into direct competition with each other to the same extent as, in the days of horse drawn vehicles, they would have done if located only a few miles apart.  

The question of geographic proximity also may arise in cases in which a federal registrant seeks to enforce its rights against an apparently distant second user of the same mark. According to the court’s decisions in American Foods, Inc. v. Golden Flake, Inc. and John R. Thompson Co. v. Holloway, such a plaintiff will be able to challenge a defendant’s use only when that plaintiff expands into the junior user’s geographical area. If, as in John R. Thompson, the plaintiff is unable to demonstrate its imminent expansion, “then there will be no occasion to interfere with the defendants’ use of their tradename.” If, however, “future expansion of the plaintiff’s business or reputation does occur and confusion becomes likely, the rights of the plaintiff are definitely superior to those of the defendants.”

Determining the plaintiff’s actual areas of operations is not always the end of the inquiry, however, particularly in cases involving rights to unregistered marks. Rather, under the “zone of natural expansion doctrine,” “[t]he territorial extent of trademark protection is limited to those geographic areas in which a mark is actually used in commerce and a zone of reasonable future expansion.” Thus, if a plaintiff can demonstrate its imminent expansion into an area, its priority of rights will extend to that area.

Significantly, this rule applies with equal force in situations involving plaintiffs who are junior users but who own incontestable federal registrations. Because the effect of such a registration is to “freeze” the senior user into its area of operations, the owner of an incontestable registration will be able to restrict a senior user’s rights to that user’s “zone of reputation.” See Siragusa v. Travelodge Corp., 352 F.2d 516, 147 U.S.P.Q. (BNA) 379 (5th Cir. 1965) (per curiam) (enjoining junior user from using its mark at all and failing to enjoin senior user from using its mark in Birmingham, only place junior user had used mark), affg 228 F. Supp. 238, 141 U.S.P.Q. (BNA) 719 (N.D. Ala. 1964).
As the court has noted, the zone of natural expansion doctrine "is admittedly a legal fiction," and with one "few firm guidelines." The court has, however, endeavored to provide a loose doctrinal framework for district courts and litigants attempting to determine the plaintiff's likely geographical expansion. Several factors merit consideration in this framework, including: (1) the geographical distance from the senior user's actual location to a point on the perimeter of the zone of expansion; (2) the scope of the senior user's actual geographical area of penetration at the time of suit; (3) the senior user's past history of expansion; and (4) whether the senior user's actual expansion into the junior user's area would require "an unusual 'great leap forward' " or, alternatively, whether "that expansion would be . . . a logical, gradual, step of the same length as those previously made." Should the senior user demonstrate the natural inevitability of its penetration into a territory occupied by the junior user of an otherwise confusingly similar mark, it will prevail in any infringement dispute.

CONCLUSION

In affirming the trial court's verdict in *American Foods, Inc. v. Golden Flake, Inc.*, then-Circuit Judge Griffin Bell distinguished the authority cited by the defendant by noting that "[t]he ancient observation that each trade-mark case must be decided upon its own facts still obtains . . . ." As this Article has demonstrated, however, likelihood of confusion determinations in the Eleventh Circuit, perhaps more so than in many other jurisdictions, have produced a well developed and broad-based body of law applicable to each of the cases referenced by Judge Bell's "ancient observation."

It is to set forth and to explain this jurisprudence that this Article has surveyed the court's decisions involving competing claims to trademarks, service marks, trade dresses, and other designations of origin. To this end, this Article has not endeavored

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407 *Id.* at 1028, 13 U.S.P.Q.2d (BNA) at 1140.
408 *Id.* at 1028, 13 U.S.P.Q.2d (BNA) at 1141.
410 *Id.* at 627, 136 U.S.P.Q. (BNA) at 292.
to criticize the ultimate outcome of the individual cases discussed in it. It has, however, sought to articulate and to reconcile the well-developed doctrinal principles characteristic of unfair competition litigation in the Eleventh Circuit to accord litigants, if not absolute confidence in the likely outcome of their cases, then a reasonable degree of certainty.