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The Post-Sale Confusion Doctrine: Why the General Public Should Be Included in the Likelihood of Confusion Inquiry

Cover Page Footnote

This Note is dedicated to my mom for her infinite support and encouragement. I am grateful to Professor Hugh C. Hansen for his invaluable guidance.

THE POST-SALE CONFUSION DOCTRINE: WHY THE GENERAL PUBLIC SHOULD BE INCLUDED IN THE LIKELIHOOD OF CONFUSION INQUIRY

Anne M. McCarthy*

INTRODUCTION

In its developing stages, trademark law focused primarily on ensuring that the use of similar trade symbols by competing merchants would not confuse purchasing consumers.¹ Courts, however, recognized long ago the harm to the trademark owner that resulted from limiting the scope of the confusion focus.² Courts were particularly concerned with protecting the owner's goodwill, and found it an anomaly to allow parties to reap the benefits of others' efforts.³ As a result, some early trademark infringement decisions strained the inquiry by finding confusion in cases where the actual likelihood of confusion was quite slim.⁴ Opinions of this kind have been generally criticized for being intellectually dishonest.⁵

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1. See 1 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* § 2:8, at 2-15 (4th ed. 1996) [hereinafter McCarthy 4th].

2. See, e.g., *Yale Elec. Corp. v. Robertson*, 26 F.2d 972, 974 (2d Cir. 1928) (extending trademark protection beyond the then governing "same descriptive properties" test in favor of a standard that contemplated the loss of reputation of the trademark owner); see also Jerome Gilson, *Trademark Dilution Now a Federal Wrong: An Analysis of the Federal Trademark Dilution Act of 1995*, at 3 (1996) ("[T]he [*Yale Electric*] case was an important step in the development of trademark protection that went beyond the use of a similar mark on competing goods.").

3. See, e.g., *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942) ("If another poaches upon the commercial magnetism of the symbol [that a trademark owner] has created, the owner can obtain legal redress."); see also *Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-Le Coultre Watches, Inc.*, 221 F.2d 464, 466 (2d Cir. 1955) ("Plaintiff's intention thus to reap financial benefits from poaching on the reputation of the Atmos clock is of major importance.").

4. See, e.g., *Stork Restaurant, Inc. v. Sahati*, 166 F.2d 348, 350-51, 364 (9th Cir. 1948) (granting injunctive relief against the use of "Stork Club" by an unsophisticated tavern in a distant city in favor of the owner of a similar mark for a glittering New York nightclub).

5. See, e.g., Note, *Dilution: Trademark Infringement or Will-O'-The-Wisp?*, 77 Harv. L. Rev. 520, 525 (1964) ("As the likelihood of confusion in any particular case becomes attenuated, the operative role of dilution in prompting relief increases, however orthodox the language in which the decision is announced."); see also 2 J. Thomas McCarthy, *Trademarks and Unfair Competition* § 23.26, at 84-85 (1st ed. 1973) ("[T]he decision-maker has an immediate 'gut reaction' to the likelihood of confusion between two conflicting marks, and the opinion written to justify this intuitive reaction is merely rationalization after the fact of decision.").

These courts engaged in such analyses because the limitation of the confusion theory offered the trademark owner insufficient protection.⁶ While the courts' objective may have been noble, the legal standard of the day did not sanction the outcome.⁷ Even though Congress recognized the dual aim of trademark law as protecting the interests of both the public and the trademark owner,⁸ this sentiment was not apparent in early legislation. Under the Lanham Act of 1946, trademark infringement occurred only when the infringing mark was likely to confuse actual purchasers at the point of sale.⁹ The legislation was ineffective, though, because there was still confusion among the public and injury to trademark owners' reputations.

When Congress amended the Lanham Act in 1962, deleting the "purchaser" and "source of origin" limitations in the infringement section, the federal courts differed regarding the significance of the amendment. Many courts interpreted the revision as evincing congressional intent to encompass and prohibit a greater range of confusion.¹⁰ Some of these courts concluded, therefore, that the amendment supports an infringement action based on post-sale confusion of the general public.¹¹ Other courts construed the amendment as supporting an action involving post-sale confusion of only purchasers or potential purchasers.¹² Finally, a number of courts, despite explicit legislative authority to the contrary, still limit protection to circumstances posing the risk of consumer confusion at the time of purchase.¹³

This Note argues that, in light of the dual aim of trademark law to protect the interests of both the public and the trademark owner, the use of a trademark likely to cause confusion among the general public in a post-sale context should be actionable under federal trademark law. Part I of this Note discusses the functions of a trademark and the major policy rationales underlying trademark law. This part then outlines the history of trademark law in the United States and defines the parameters of a trademark infringement claim. This part also sets

6. See Robert J. Shaughnessy, *Trademark Parody: A Fair Use and First Amendment Analysis*, 77 *Trademark Rep.* 177, 183 (1987) (stating that commentators likewise believed that the confusion standard offered inadequate protection).

7. In 1946, section 32 of the Lanham Act provided a cause of action for the use of a registered mark in a manner "likely to cause confusion or mistake or to deceive purchasers as to the source of origin" of the infringer's goods or services. Lanham Act, Pub. L. No. 79-489, 60 Stat. 437 (1946) (codified as amended at 15 U.S.C. § 1114(1)(a) (1994)).

8. See *infra* note 31 and accompanying text.

9. See *supra* note 7; see also Note, *supra* note 5, at 523 ("[I]t seems indisputable that Congress confined protection under the [1946] act to circumstances posing the risk of consumer confusion.").

10. See *infra* Part II.B.2-3.

11. See *infra* Part II.B.3.

12. See *infra* Part II.B.2.

13. See *infra* Part II.B.1.

forth the various aspects of the likelihood of confusion test. Part II assesses the ramifications of the 1962 Lanham Act amendment on the likelihood of confusion analysis. Part II also analyzes differing judicial interpretations of the congressional measure. Part III identifies why a likelihood of confusion analysis in a post-sale context should, in certain circumstances, include the general public. This Note concludes that congressional intent and trademark policy favors prevention of the post-sale confusion of non-purchasers.

I. TRADEMARK LAW

This part provides the definition of a trademark, the purposes of trademark law, and the elements of a cause of action required to successfully prosecute a trademark infringement claim.

A. *What Is a Trademark?*

A trademark is "any word, name, symbol, or device, or any combination thereof" used by a party to identify and distinguish its products from those of another.¹⁴ The term "trademark" also denotes words or symbols that identify services.¹⁵ The range of what can be considered a trademark is vast;¹⁶ it can include words indicating brand names,¹⁷ slogans,¹⁸ letters,¹⁹ numbers,²⁰ colors,²¹ building shapes,²² and

14. 15 U.S.C. § 1127 (1994).

15. See 1 McCarthy 4th, *supra* note 1, § 3:1, at 3-2. In his treatise, Professor McCarthy instructs that although the term trademark is commonly used to refer to the symbol that identifies both goods and services, trade symbols are technically called "service marks." See *id.* The definition of a service mark is "any word, name, symbol, or device, or any combination thereof . . . used . . . to identify and distinguish the services of one person . . . from the services of others" 15 U.S.C. § 1127.

16. See J. Steven Gardner, Note, *Trademark Infringement, Likelihood of Confusion, and Trademark Parody: Anheuser-Busch, Inc. v. L & L Wings, Inc.*, 28 Wake Forest L. Rev. 705, 712-13 (1993) (listing a variety of trademark forms).

17. See, e.g., *Jordache Enters. v. Hogg Wyld, Ltd.*, 828 F.2d 1482, 1490-91 (10th Cir. 1987) (upholding "Jordache" as a brand name for jeans).

18. See, e.g., *Chemical Corp. of Amer. v. Anheuser-Busch, Inc.*, 306 F.2d 433, 436, 439 (5th Cir. 1962) (enjoining the use of a slogan similar to "Where there's life . . . there's Bud"); see also 1 McCarthy 4th, *supra* note 1, § 7:20, at 7-28 to -29 (identifying slogans as serving as marks).

19. See 1 McCarthy 4th, *supra* note 1, § 7:9, at 7-12 (stating that "an individual letter or a group of letters, not forming a recognizable word, can function as a mark").

20. See, e.g., *Nabisco Brands, Inc. v. Kaye*, 760 F. Supp. 25, 27-29 (D. Conn. 1991) (finding infringement of the "A.1" mark for steak sauce by the maker of "A.2" brand meat sauce).

21. See, e.g., *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1122 (Fed. Cir. 1985) (holding registrable the color pink for fiberglass insulation upon proof of secondary meaning because "'pink' has no utilitarian purpose, [and] does not deprive competitors of any reasonable right or competitive need").

22. See, e.g., *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 765-67, 776 (1992) (affirming trade dress infringement judgment for the appearance and décor of a Mexican-style restaurant).

scents.²³ To qualify as a trademark, the symbol must be "distinctive"; i.e., capable of identifying the products or services that bear the symbol.²⁴ This is necessary to indicate to consumers that a particular product comes from a specific source.²⁵

Trademarks perform several protective functions.²⁶ Besides serving as an identification symbol,²⁷ a trademark signifies that any product bearing the mark comes from or is controlled by a single source,²⁸ and that the goods are of an equal level of quality.²⁹ Further, a trademark is a primary feature in advertising.³⁰ The preservation of these attributes benefits both consumers and trademark owners.³¹

Trademark law pursues two related goals: the prevention of consumer confusion and the protection of proprietary interests in trademarks.³² The first major principle of trademark protection is

23. See, e.g., *In re Clarke*, 17 U.S.P.Q.2d (BNA) 1238, 1239-40 (T.T.A.B. 1990) (approving trademark for scented yarn); see also Moon-Ki Chai, *Protection of Fragrances Under the Post-Sale Confusion Doctrine*, 80 Trademark Rep. 368, 371-72 (1990) (arguing for the extension of trademark protection to fragrances).

24. See 1 McCarthy 4th, *supra* note 1, § 3:1, at 3-2.

25. See Gardner, *supra* note 10, at 712; see also *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 412 (1916) ("The primary and proper function of a trade-mark is to identify the origin or ownership of the article to which it is affixed.").

26. See 1 McCarthy 4th, *supra* note 1, § 3:2, at 3-3.

27. See *id.*

28. See *id.* The Lanham Act states that a trademark will "indicate the source of the goods, even if that source is unknown." 15 U.S.C. § 1127 (1994).

29. See 1 McCarthy 4th, *supra* note 1, § 3:2, at 3-3.

30. See *id.*

31. The Senate Committee on Patents in its Report on the Lanham Act instructed that:

The purpose underlying any trade-mark statute is twofold. One is to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get. Secondly, where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats. This is the well-established rule of law protecting both the public and the trade-mark owner.

S. Rep. No. 79-1333 (1946), *reprinted in* 1946 U.S.C.C.A.N. 1274, 1274; see also 1 McCarthy 4th, *supra* note 1, § 2:1, at 2-2 to -3 (identifying the two major reasons for trademark protection as the concern for the interest of the public in not being confused and the trademark owner's "interest in not having the fruit of his labor misappropriated"). Professor McCarthy goes on to state that "there is also the policy of encouraging competition from which the public benefits." *Id.* § 2:1, at 2-3.

32. See S. Rep. No. 79-1333 (1946), *reprinted in* 1946 U.S.C.C.A.N. 1274, 1274; see also *Keds Corp. v. Renee Int'l Trading Corp.*, 888 F.2d 215, 218 (1st Cir. 1989) ("The injury in an infringement case is two-fold: to the trademark owner through loss of good will and presumably profits and to the public because of confusion caused by the similar marks."). A third policy underlying the protection of trademarks is protection of competitors' interests in preventing a limitation on the availability of new marks. See Stanley A. Bowker, Jr., Note, *The Song Is Over But the Melody Lingers on: Persistence of Goodwill and the Intent Factor in Trademark Abandonment*, 56 Fordham L. Rev. 1003, 1010 (1988). This third policy, however, is tangentially relevant in relation to the other two policies. See *id.* at 1014 ("The competitor's interest in using a mark occupies the place of a stepchild in the policy factor family.").

predicated on preventing consumer confusion that occurs when a junior user³³ adopts a mark confusingly similar to that used by a senior user.³⁴ The importance of protecting the public from confusion is obvious.³⁵ Absent protection for the exclusive use of trademarks, consumers would be unable to distinguish between related goods sold under similar marks.³⁶ Similarly, consumers may falsely associate goods bearing similar marks as being derived from the same source.³⁷ Consumers, therefore, "would be forced to re-educate themselves with each purchase or possible purchase of a branded product."³⁸ This outcome belies an important economic benefit attributed to trademarks by increasing consumer search costs.³⁹

The second major principle of trademark law is the recognition that a trademark is a symbol of the goodwill associated with the owner's goods or services.⁴⁰ This canon recognizes the trademark owner's interest in preventing the misappropriation of his efforts.⁴¹ A trademark owner's goodwill is often characterized by his investment of time, energy, and effort that culminates in "commercial magnetism."⁴² More specifically, "[g]ood will' is the best semantic term we have to describe the consumer recognition or drawing power of a trade-

33. The term "junior user" "refers to a party who adopts and uses a trademark similar or identical to a mark previously adopted and used by the senior user." Michael J. Allen, *The Scope of Confusion Actionable Under Federal Trademark Law: Who Must Be Confused and When?*, 26 Wake Forest L. Rev. 321, 321 n.3 (1991).

34. The term "senior user" "refers to the first party to adopt and use a particular trademark in connection with its goods or services." *Id.*

35. *See id.* at 323.

36. *See id.* As Justice O'Connor has stated, trademark infringement "deprives consumers of their ability to distinguish among the goods of competing manufacturers." *Inwood Lab., Inc. v. Ives Lab., Inc.*, 456 U.S. 844, 854 n.14 (1982).

37. *See* Allen, *supra* note 33, at 323.

38. *Id.*

39. *See* William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & Econ. 265, 270 (1987) ("The value of a trademark is the saving in search costs made possible by the information or reputation that the trademark conveys or embodies about the brand (or the firm that produces the brand)."); Roger E. Meiners & Robert J. Staaf, *Patents, Copyrights, and Trademarks: Property or Monopoly?*, 13 Harv. J.L. & Pub. Pol'y 911, 931 (1990) ("A trademark would have zero value in a world of perfect information because consumers could determine variations in quality and performance among products at no cost.").

40. *See* 1 McCarthy 4th, *supra* note 1, § 2:1, at 2-3.

41. *See* Courtenay Brian Allen, Note, *Holiday Inns, Inc. v. 800 Reservation, Inc.: Defining Use of a Mark and the Source of Confusion in Trademark Infringement*, 49 Baylor L. Rev. 847, 856 (1997) (stating that trademark law seeks to "protect the trademark owner's investment of time, energy, and money").

42. *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942). As Justice Frankfurter asserted, "[i]f another poaches upon the commercial magnetism of the symbol [that a trademark owner] has created, the owner can obtain legal redress." *Id.*; *see also* *White Tower Sys., Inc. v. White Castle Sys. of Eating Houses Corp.*, 90 F.2d 67, 69 (6th Cir. 1937) ("Good will may be defined as the favorable consideration shown by the purchasing public to goods known to emanate from a particular source.").

mark.⁴³ This trademark characteristic is so significant, it is considered a type of property that the owner has the exclusive right to enjoy.⁴⁴

Likewise, courts recognize the "right of a trademark owner to control his product's reputation"⁴⁵ by policing infringing uses of its mark. A trademark owner, therefore, has a proprietary interest in preventing freeriding on its goodwill through the unauthorized use of a similar mark.⁴⁶ Justice Frankfurter succinctly articulated the freerider concept: "[T]he wrongdoer who makes profits from the sales of goods bearing a mark belonging to another was enabled to do so because he was drawing upon the good will generated by that mark."⁴⁷

B. *Legislative History of Trademarks*

In the United States, trademark protection developed in the early nineteenth century as an offshoot of the tort of fraud and deceit, and was known as "passing off" or "palming off."⁴⁸ Due to its origins, early trademark infringement claims centered on the fraudulent intent of the defendant, rather than the protection of consumers.⁴⁹ By the early twentieth century, however, courts shifted their focus from the fraudulent aspects of passing off to the effect of confusingly similar marks on consumers.⁵⁰

In 1870, Congress enacted the first federal statute governing trademarks,⁵¹ but the Supreme Court struck it down in 1879 as unconstitutional.⁵² Congress passed new legislation in 1881 that limited

43. 1 McCarthy 4th, *supra* note 1, § 2:15, at 2-36.

44. *See id.* § 2:14, at 2-29; *see also* Schenck, A.G. v. Nortron Corp., 713 F.2d 782, 786 n.3 (Fed. Cir. 1983) (classifying the term "property" as the right to exclude others). As one commentator instructed, "[f]or the trademark owner, the chief value of the mark lies in its ability to associate favorable experiences or impressions with the product to which it is attached, not simply in its capacity to identify the source or sponsorship of that product." Shaughnessy, *supra* note 6, at 184.

45. James Burrough Ltd. v. Sign of Beefeater, Inc., 540 F.2d 266, 274 (7th Cir. 1976).

46. *See* Landes & Posner, *supra* note 39, at 270 ("If the law does not prevent it, free riding will eventually destroy the information capital embodied in a trademark, and the prospect of free riding may therefore eliminate the incentive to develop a valuable trademark in the first place.").

47. *Mishawaka Mfg.*, 316 U.S. at 207.

48. *See* 1 McCarthy 4th, *supra* note 1, § 5:2, at 5-3 (tracing the development of trademark law in Anglo-American common law). The tort of passing off consisted "of one passing off his goods as the goods of another." *Id.*

49. *See id.* § 5:3, at 5-4.

50. *See id.*

51. Act of July 8, 1870, ch. 230, §§ 77-84, 16 Stat. 198, 210-12 ("An Act to revise, consolidate, and amend the Statutes relating to Patents and Copyrights.").

52. *See* Trade-Mark Cases, 100 U.S. 82, 99 (1879); David Klein, *The Ever Expanding Section 43(a): Will the Bubble Burst?*, 2 U. Balt. Intell. Prop. L.J. 65, 65 n.2 (1993) ("[R]egulation of marks used in intrastate and interstate commerce was unconstitutional because Congressional power to regulate trademarks comes from the Commerce Clause, not the clause empowering the regulation of patents and copyrights

registration to trademarks used in commerce with foreign nations and the Indian tribes.⁵³ In 1905, Congress enacted another trademark regulation statute that enabled registration of trademarks used in interstate commerce.⁵⁴ This statute proved to be inadequate, however, because it permitted registration of only fanciful and arbitrary marks.⁵⁵ Finally, in 1946, Congress replaced the Trademark Act of 1905 with the Lanham Act,⁵⁶ which is the statute currently in place.

C. Elements of a Cause of Action for Trademark Infringement

A plaintiff in a trademark infringement claim must prove that his mark distinguishes his goods from those of another, and that the defendant's mark is likely to cause confusion.⁵⁷ Sections 32(1)⁵⁸ and 43(a)⁵⁹ of the Lanham Act are especially significant in trademark infringement actions. Section 32(1) proscribes the infringement of a federally registered mark,⁶⁰ while section 43(a) embodies the principles of federal unfair competition law and provides a cause of action for the infringement of an unregistered mark.⁶¹ For the most part, the

(U.S. Const. art. I, § 8, cl. 8)"); see also 1 McCarthy 4th, *supra* note 1, § 5:3, at 5-6 (stating that "the Act of 1870 was short-lived . . . [because the] United States Supreme Court held . . . [it] unconstitutional on the ground that Congress's power to regulate trademarks was limited to an exercise of the Commerce power").

53. Act of Mar. 3, 1881, ch. 138, 21 Stat. 502, 502 (repealed 1946).

54. Act of Feb. 20, 1905, ch. 592, 33 Stat. 724 (repealed 1946).

55. See 1 McCarthy 4th, *supra* note 1, § 5:3, at 5-8.

56. Lanham Act, Pub. L. No. 79-489, 60 Stat. 427 (1946) (codified as amended at 15 U.S.C. §§ 1051-1127 (1994)).

57. See *A.J. Canfield Co. v. Vess Beverages, Inc.*, 796 F.2d 903, 906 (7th Cir. 1986) (stating that to prevail against an alleged infringer, the plaintiff "must show a valid trademark and a likelihood of confusion on the part of the public"); Patricia J. Kaeding, *Clearly Erroneous Review of Mixed Questions of Law and Fact: The Likelihood of Confusion Determination in Trademark Law*, 59 U. Chi. L. Rev. 1291, 1292 (1992). To prove trademark infringement: (1) Plaintiff must establish the validity of its mark, which means that the public recognizes the plaintiff's symbol as identifying its goods and distinguishing them from those of others. There are two ways to establish validity: (a) the plaintiff's trademark is inherently distinctive, or (b) the symbol has become distinctive through the acquisition of secondary meaning. (2) Plaintiff must prove the infringement of its mark; i.e., that the defendant's conduct caused a likelihood of confusion among the relevant purchasing class. See 3 J. Thomas McCarthy, *Trademarks and Unfair Competition* § 15.1(B) (2d ed. 1984).

58. 15 U.S.C. § 1114(1) (1994). Infringement under Section 32(1) is determined by whether the alleged infringer's use is "likely to cause confusion, or to cause mistake, or to deceive." *Id.* § 1114(1)(b).

59. *Id.* § 1125. Section 43(a) forbids the use "in commerce [of] any word, term, name, symbol, or device, . . . or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which . . . is likely to cause confusion." *Id.*

60. See 3 McCarthy 4th, *supra* note 1, § 23:1, at 23-8.

61. See *id.* § 23:1, at 23-8. Under section 43(a), the owner of an unregistered mark must establish two requirements. See Jacqueline Pasquarella, *Third Circuit Review: Trademark Law-Confusion over the Likelihood of Confusion?: Dranoff-Perlstein Associates v. Sklar* (1993), 38 Vill. L. Rev. 1317, 1322 (1993). First, the owner must demonstrate that the mark is sufficiently distinctive. See *id.* Marks that are either

fundamental principles of trademark infringement are the same whether the claim proceeds under either section 32 or section 43.⁶² A cause of action under each section rests “on a likelihood of public confusion as to the source of the respective products.”⁶³

The keystone of a trademark infringement action is the likelihood of confusion test.⁶⁴ The phrase “likelihood of confusion” is also used to describe the standard of liability for trademark infringement under state trademark statutes.⁶⁵ Likelihood of confusion is the probability that an alleged infringer’s mark is the legal cause,⁶⁶ or cause in fact,⁶⁷ of confusion in the minds of potential consumers.⁶⁸ Specifically, the confusion inquiry centers on whether the public is likely to believe that the infringer’s product originates from or is endorsed by the plaintiff.⁶⁹

arbitrary or fanciful, which are known as “inherently distinctive,” automatically qualify for trademark protection. *See id.* A suggestive mark likewise qualifies for automatic protection. *See id.* A mark that is merely descriptive of the goods to which it is affixed qualifies for protection, however, only if it has acquired secondary meaning. *See id.* at 1322-23.

62. *See* Graeme B. Dinwoodie, *Reconceptualizing the Inherent Distinctiveness of Product Design Trade Dress*, 75 N.C. L. Rev. 471, 476 (1997); *see also* Richard L. Kirkpatrick, *Likelihood of Confusion in Trademark Law* § 1.4.B, at 1-15 n.43 (1995) (“For most trademark infringement purposes, Sections 1114(1) [§ 32] and 1125(a) [§ 43] are now virtually coextensive except, of course, for the former’s requirement that the complainant own a registration.”).

63. Dinwoodie, *supra* note 62, at 477 (footnote omitted).

64. *See* 3 McCarthy 4th, *supra* note 1, § 23:1, at 23-6.

65. *See* Restatement (Third) of Unfair Competition § 20 cmt. d (1995) (“The term ‘likelihood of confusion’ has long been used to describe the standard of liability for trademark infringement in actions at common law and under federal and state trademark and unfair competition statutes.”).

66. *See* Kirkpatrick, *supra* note 62, § 1.3, at 1-7 (defining confusion in the legal sense as “confusion of source or sponsorship”).

67. *See id.* § 1.3, at 1-10 (“Where there is confusion in fact, which is the proper subject of a legal claim, it must be ‘the direct and proximate result of an act undertaken by the defendant.’”).

68. *See id.* § 1.1, at 1-4; *see also* *Lindy Pen Co. v. Bic Pen Corp.*, 725 F.2d 1240, 1243 (9th Cir. 1984) (explaining that likelihood of confusion “exists when consumers viewing the mark would probably assume that the product or service it represents is associated with the source of a different product or service identified by a similar mark” (citation omitted)); Sean H. Brogan, *Who Are These “Colts?”: The Likelihood of Confusion, Consumer Survey Evidence and Trademark Abandonment in Indianapolis Colts, Inc. v. Metropolitan Baltimore Football Club, Ltd.*, 7 Marq. Sports L.J. 39, 45 (1996) (“‘Likelihood of confusion’ can be defined as the probability that the accused infringer’s mark is the legal cause, or cause in fact, of confused, mistaken or deceived states of mind of potential consumers.”)

69. *See* Brogan, *supra* note 68, at 45. Judge Learned Hand aptly summarized the likelihood of confusion concept: “[R]elief always depends upon the idea that no man shall be allowed to mislead people into supposing that his goods are the plaintiff’s, and that there can be no right or remedy until the plaintiff can show that at least presumptively this will result.” *Bayer Co. v. United Drug Co.*, 272 F. Supp. 505, 509-10 (S.D.N.Y. 1921); *see also* Brett Thomas Reynolds, Comment, *Appellate Review of Lanham Act Violations: Is Likelihood of Confusion a Question of Law or Fact?*, 38 Sw. L.J. 743, 747 (1984) (“Likelihood of confusion involves both the right of the public not to be confused by dishonest competitors and the right of business owners to

In determining likelihood of confusion, courts generally consider several factors. Although these factors differ among the federal circuits,⁷⁰ the traditional set of factors developed by the Second Circuit in *Polaroid Corp. v. Polarad Electronics Corp.*⁷¹ is illustrative: (1) the strength of the plaintiff's mark; (2) the degree of similarity between plaintiff's and defendant's marks; (3) the proximity of the products or services; (4) the likelihood that plaintiff will bridge the gap; (5) evidence of actual confusion; (6) defendant's good faith in adopting the mark; (7) the quality of defendant's product or service; and (8) the sophistication of the buyers.⁷² Courts apply this test in cases involving both competing and noncompeting products.⁷³ The *Polaroid* factors are not meant to be exhaustive; rather, they are helpful guidelines for courts to follow.⁷⁴ Not all of the factors are relevant in any given case, nor are they given equal weight.⁷⁵ Further, a trial court's findings regarding each factor are reviewed by appellate courts for clear error, but the further determination of likelihood of confusion is a legal conclusion, which is reviewed de novo.⁷⁶

benefit from the goodwill and reputation that their time and money have established.").

70. The following cases set forth the factors considered by the Circuits: First Circuit, *see Keds Corp. v. Renee Int'l. Trading Corp.*, 888 F.2d 215, 222 (1st Cir. 1989); Third Circuit, *see Merchant & Evans, Inc. v. Roosevelt Bldg. Prods. Co.*, 963 F.2d 628, 637 (3d Cir. 1992); Fourth Circuit, *see Anheuser-Busch, Inc. v. L & L Wings, Inc.*, 962 F.2d 316, 320 (4th Cir. 1992); Fifth Circuit, *see Sno-Wizard Mfg., Inc. v. Eisemann Prods. Co.*, 791 F.2d 423, 428 (5th Cir. 1986); Sixth Circuit, *see Homeowners Group, Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1106 (6th Cir. 1991); Seventh Circuit, *see Smith Fiberglass Prods., Inc. v. Ameron, Inc.*, 7 F.3d 1327, 1329 (7th Cir. 1993); Eighth Circuit, *see Squirtco v. Seven-Up Co.*, 628 F.2d 1086, 1091 (8th Cir. 1980); Ninth Circuit, *see E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1290 (9th Cir. 1992); Tenth Circuit, *see Coherent, Inc. v. Coherent Techs., Inc.*, 935 F.2d 1122, 1125 (10th Cir. 1991); Eleventh Circuit, *see Dieter v. B&H Indus. of Southwest Fla., Inc.*, 880 F.2d 322, 326 (11th Cir. 1989); *see also* Jane C. Ginsburg et al., *Trademark and Unfair Competition Law* 428-29 (2d ed. 1996) (listing the cases that set forth the factors by circuit).

71. 287 F.2d 492 (2d Cir. 1961).

72. *See id.* at 495.

73. *See* Anthony L. Fletcher & Robert M. Kunstadt, *Trademark Law Handbook* 91 (1990 ed.).

74. *See id.* at 90 ("Each [factor] is to be evaluated as to how it bears on the ultimate question of likelihood of confusion, and the court may have to take into account other variables. . . . The factors are not the end-all of the determination, merely a useful guide." (footnote omitted)).

75. *See Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1527 (4th Cir. 1984) (applying likelihood of confusion factors but cautioning that "[n]ot all these [factors] are always relevant or equally emphasized in each case" (alteration in original) (quoting *Modular Cinemas of America, Inc. v. Mini Cinemas Corp.*, 348 F. Supp. 578, 582 (S.D.N.Y. 1972))).

76. *See Esercizio v. Roberts*, 944 F.2d 1235, 1242 (6th Cir. 1991). The Courts of Appeals are split on the appropriate appellate review standard for the likelihood of confusion analysis conducted at the trial level. For a discussion of the differing applications, *see Reynolds, supra* note 69, at 752-63.

Examination of the likelihood of confusion standard is a multi-faceted exercise. It requires scrutiny of the type of confusion actionable,⁷⁷ the relevant population of confused persons,⁷⁸ and the relevant time of confusion.⁷⁹ The traditional type of actionable confusion in a trademark infringement suit relates to confusion as to the source of goods or services, known as "source confusion."⁸⁰ Courts confined their inquiry to source confusion because of the express "source of origin" language in the 1946 Lanham Act.⁸¹ Source confusion occurs when "[a]n infringing mark confuses the consumer into attributing the product to the wrong source."⁸² This type of confusion often occurs between marks affixed to competitive products.⁸³ Nonetheless, likelihood of confusion of source may also occur when a similar mark is used on unrelated and dissimilar products.⁸⁴ Further, in an action premised on source confusion, a consumer's knowledge of the exact source is not required, provided the consumer identifies the goods as emanating from only one source.⁸⁵

The next aspect of the likelihood of confusion standard requires a determination of the relevant population. To be actionable, confusion must occur in the minds of a relevant class of persons.⁸⁶ Under the Lanham Act of 1946, to establish trademark infringement, the plaintiff had to prove that the infringing mark was "likely to cause confusion or mistake or to deceive purchasers as to the source of origin of such

77. See Kirkpatrick, *supra* note 62, § 1.4, at 1-13.

78. See *id.* § 1.6, at 1-24.

79. See *id.* § 1.7, at 1-28.

80. See *id.* § 1.4.A, at 1-15 (defining "source" as "the entity which controls the nature and quality of the product").

81. Lanham Act, Pub. L. No. 79-489, § 32(1), 60 Stat. 427, 437 (1946) (codified as amended at 15 U.S.C. § 1114(1) (1994)).

82. Kirkpatrick, *supra* note 62, § 1.4.A, at 1-15; see also Allen, *supra* note 33, at 325 (defining confusion as to source as "a mistaken belief that the junior user's good or service originates from the source of the good or service marketed under the senior user's mark").

83. See Allen, *supra* note 33, at 325.

84. See *FASA Corp. v. Playmates Toys, Inc.*, 912 F. Supp. 1124, 1172 (N.D. Ill. 1996) ("The fact that the products at issue may be 'very different' is not dispositive of the issue of the similarity of the products in determining the existence of a likelihood of confusion The issue is whether the products are the kind the public attributes to a single source." (citation omitted)).

85. See Kirkpatrick, *supra* note 62, § 1.4.A, at 1-15; see also *Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-Le Coultre Watches, Inc.*, 221 F.2d 464, 466 (2d Cir. 1955) ("[I]t matters not whether the customers know just who is the source."). For example, few customers know that CREST toothpaste is made by Procter & Gamble. See 1 McCarthy 4th, *supra* note 1, § 3:7, at 3-15.

86. See Kirkpatrick, *supra* note 62, § 1.6, at 1-24; see also *Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1206 (1st Cir. 1983) ("If likelihood of confusion exists, it must be based on the confusion of some relevant person"); *Koppers Co. v. Krupp-Koppers GmbH*, 517 F. Supp. 836, 843 (W.D. Pa. 1981) ("Clearly the likelihood of confusion cannot be considered in a vacuum, but must be determined with respect to certain persons.").

goods.”⁸⁷ Because of the express purchaser reference, courts accordingly focused their likelihood of confusion examination on whether actual purchasers were likely to buy a product bearing an infringing mark while mistakenly believing it was the plaintiff’s product.⁸⁸

The final aspect of the likelihood of confusion examination addresses the relevant time of confusion. This timing element is closely related to the class of persons likely to be confused.⁸⁹ A purchaser, for example, may be confused in a sale setting, while a user may be confused in a post-sale environment.⁹⁰ Consequently, because courts traditionally focused their analysis on the likely confusion of purchasers, the temporal element likewise involved a point of sale focus.⁹¹ As a result of these likelihood of confusion elements, a trademark infringement action under the 1946 Lanham Act involved purchaser confusion of source that occurred at the time of sale.⁹²

The state of trademark law was significantly altered in 1962, when Congress enacted the first amendment to the Lanham Act. The principle purpose of the amendment was to correct typographical errors and to clarify the meaning of various provisions whose language was inconsistent or unclear.⁹³ Additionally, some revisions were designed to effect procedural changes.⁹⁴ Because many of the revisions were administrative in nature,⁹⁵ the 1962 amendments to the Lanham Act are sometimes described as the “housekeeping amendments.”⁹⁶ The congressional measure, however, did affect substantive changes in trademark law.⁹⁷ In particular, as discussed below in part II, the bill has had a substantial impact on the likelihood of confusion inquiry.

II. THE 1962 AMENDMENT TO THE LANHAM ACT

This part examines the substantive changes to the Lanham Act as a result of a congressional amendment in 1962. This part also looks at the various interpretations courts have given to the amendment.

87. Lanham Act, Pub. L. No. 79-489, § 32(1), 60 Stat. 427, 437 (1946) (codified as amended at 15 U.S.C. § 1114(1) (1994)).

88. See Allen, *supra* note 33, at 331 (“Prior to the 1962 Amendment, many courts focused their likelihood of confusion analyses on whether purchasers are likely to purchase the defendant’s product while mistakenly thinking it was the plaintiff’s.”).

89. See Kirkpatrick, *supra* note 62, § 1.7, at 1-28.

90. See *id.*

91. See Allen, *supra* note 33, at 330-31.

92. See 3 McCarthy 4th, *supra* note 1, § 23:5, at 23-15.

93. See James F. Hoge, *The Lanham Act’s Housekeeping Amendments*, 52 Trade-mark Rep. 1245, 1245 (1962).

94. See *id.* at 1246. Specifically, the amendment revised internal Patent Office procedure and prescribed changes in the procedures to be followed by trademark owners when dealing with the Patent Office. See *id.* at 1247-48.

95. See *id.* at 1248.

96. *Id.* at 1246.

97. See *id.* at 1248.

A. Effect of the 1962 Amendment on Likelihood of Confusion

Congress amended the Lanham Act⁹⁸ to encompass and prohibit a greater range of confusion.⁹⁹ This congressional aim was achieved by broadening the key definition of trademark infringement.¹⁰⁰ The revision expanded the type of confusion prohibited, the relevant population, and the applicable time of confusion.¹⁰¹ This section examines the scope of these amendments.

1. Type of Actionable Confusion

The 1962 amendment significantly expanded the type of actionable confusion considered under the likelihood of confusion test. In its original form, the Lanham Act required that confusion be "as to the source of origin" of the goods or services.¹⁰² In amending the statute in 1962, Congress struck out the "as to source of origin" language.¹⁰³ As a result, some courts interpreted the deletion as evincing congressional intent to proscribe the use of trademarks that are likely to cause confusion of any kind.¹⁰⁴ These forms of confusion included confusion as to affiliation, sponsorship, or association, collectively referred to as "sponsorship confusion."¹⁰⁵ This type of confusion arises out of

98. See Pub. L. No. 87-772, 76 Stat. 769 (1962) (codified as amended at 15 U.S.C. §§ 1051-1127 (1994)).

99. See Allen, *supra* note 33, at 330-31.

100. See 1 McCarthy 4th, *supra* note 1, § 5:6, at 5-14.

101. See *id.*

102. Lanham Act, Pub. L. No. 79-489, 60 Stat. 427, 437 (1946) (codified as amended at 15 U.S.C. § 1114(1) (1994)); see also Kirkpatrick, *supra* note 62, § 1.4, at 1-13 n.36, 1-15 n.43.

103. See Kirkpatrick, *supra* note 62, § 1.4, at 1-13 n.36.

104. See *Syntex Labs., Inc. v. Norwich Pharmacal Co.*, 437 F.2d 566, 568 (2d Cir. 1971) (construing the 1962 amendment as outlawing "the use of trademarks which are likely to cause confusion, mistake, or deception of any kind, not merely of purchasers nor simply as to source of origin" (emphasis added)); see also *Marathon Mfg. Co. v. Enerlite Prods. Corp.*, 767 F.2d 214, 221 (5th Cir. 1985) (interpreting the 1962 amendment to "allow any kind of confusion in support of a trademark infringement action" (citations omitted)); *Boston Prof'l Hockey Ass'n v. Dallas Cap & Emblem, Mfg., Inc.*, 510 F.2d 1004, 1012 (5th Cir. 1975) ("[T]he act was amended to eliminate the source of origin as being the only focal point of confusion.").

105. See Kirkpatrick, *supra* note 62, § 1.4.B, at 1-15; see also *Boston Athletic Ass'n v. Sullivan*, 867 F.2d 22, 32 (1st Cir. 1989) (recognizing potential buyer confusion that the plaintiff may have "licensed, or otherwise sponsored" the team emblem); *Rodeo Collection, Ltd. v. West Seventh*, 812 F.2d 1215, 1217 (9th Cir. 1987) (stating that a "likelihood of confusion exists . . . when the consumer would be likely to assume that the identified services are in some way associated with another service-provider"); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 204-05 (2d Cir. 1979) (holding that an X-rated movie would cause an association with the cheerleaders in the minds of viewers and that such an "association results in confusion"). Reverse confusion is another type of actionable confusion. See Kirkpatrick, *supra* note 62, § 1.4.C, at 1-17; 3 McCarthy 4th, *supra* note 1, § 23:10, at 23-28 ("In 'reverse confusion,' customers purchase the senior user's goods under the mistaken impression that they are getting the goods of the junior user."); see also Allen, *supra* note 33, at 328 (explaining that reverse confusion occurs when "the similarity of marks used by

an erroneous belief that, as a result of the similarity of the parties' marks, the junior user's goods or services are somehow affiliated or endorsed by the senior user.¹⁰⁶ While sponsorship confusion normally does not lead to a diversion of sales,¹⁰⁷ it does jeopardize the plaintiff's reputation and goodwill.¹⁰⁸ When this occurs, "[t]he infringer may benefit from the trademark owner's goodwill, and that goodwill may be tarnished by the inferior quality of the infringer's product."¹⁰⁹ In fact, the infringer is able to freeride on the goodwill of the plaintiff regardless of the quality of the infringing goods.

The inference created by the 1962 amendment was confirmed in 1988, when Congress expressly included sponsorship confusion in the infringement statute for unregistered marks.¹¹⁰ As amended, the Lanham Act now includes confusion "as to the affiliation, connection, or association" of sources, and as to "the origin, sponsorship, or approval" of goods.¹¹¹ The 1988 amendment codified the liberalized likelihood of confusion interpretation given to the 1962 revision by many courts.¹¹² Indeed, the congressional record reveals that the infringement section was substantially amended "to codify the interpretation [the section] has been given by the courts."¹¹³

2. Relevant Population

Congress also enlarged the scope for determining the relevant confused person. To determine the range of the likelihood of confusion inquiry, the relevant population of confused persons must be formu-

the parties will cause the public to believe that the senior user's products emanate from or are sponsored by the junior user"). For an extensive discussion on the reverse confusion doctrine, see Thad G. Long & Alfred M. Marks, *Reverse Confusion: Fundamentals and Limits*, 84 Trademark Rep. 1 (1994).

106. See Allen, *supra* note 33, at 325-26.

107. See *Ameritech, Inc. v. American Info. Techs. Corp.*, 811 F.2d 960, 964 (6th Cir. 1987) ("[C]onfusion of sponsorship . . . occurs where the goods do not directly compete. In this situation, the goods are unrelated enough that no inference arises that they originated from the same source, but the similarity of the trademarks erroneously suggests a connection between the sources . . .").

108. See Kirkpatrick, *supra* note 62, § 1.4.B., at 1-16.

109. *Id.*

110. See Pub. L. 100-667, 102 Stat. 3935, 3946 (1988) (codified as amended at 15 U.S.C. § 1125(a) (1994)); see also Kirkpatrick, *supra* note 62, § 1.4.B., at 1-15 n.43 (citing cases utilizing the sponsorship confusion standard).

111. 15 U.S.C. § 1125(a).

112. See *Boston Prof'l Hockey Ass'n v. Dallas Cap & Emblem, Mfg., Inc.*, 510 F.2d 1004, 1010 (5th Cir. 1975) (stating that the 1962 amendment accomplished a "broadening of the protection afforded by the statute").

113. S. Rep. No. 100-515, at 40 (1988), reprinted in 1988 U.S.C.A.N. 5577, 5603. This response displays how the judiciary is often the first to recognize and react to changes in the marketplace in terms of trademark protection and how Congress will at times follow suit with an amendment. See Kirkpatrick, *supra* note 62, § 1.4, at 1-13 ("Judges and legislators have by turns outpaced or followed one another in expanding [trademark] law's reach." (footnote omitted)).

lated.¹¹⁴ Based on the express reference to "purchasers" in the 1946 Lanham Act, courts limited their likelihood of confusion inquiry to likely confusion among actual purchasers.¹¹⁵ In amending the statute in 1962, Congress omitted the word "purchasers" from the confusion section.¹¹⁶ There are basically two explanations for the change.¹¹⁷ The first explanation is that Congress sought to coordinate the sections¹¹⁸ of the statute because the term "purchaser" did not exist elsewhere in the Lanham Act.¹¹⁹ The second explanation is that Congress intended to eliminate a possible restriction on the types of people whose confusion is relevant.¹²⁰

3. Relevant Time

Finally, the 1962 amendment led to an expansion of the relevant time of confusion. Although the most commonly recognized form of confusion is consumer confusion at the time of purchase,¹²¹ under the amendment, confusion need not occur at the point of sale to harm a trademark owner.¹²² By omitting the term "purchaser" in the 1962 revision, Congress not only enlarged the relevant population, it also expanded the temporal aspect of confusion. Specifically, the term used to refer to the relevant group also denotes the appropriate temporal aspect of the confusion inquiry.¹²³ Thus, with the omission of the purchaser limitation, confusion "may occur prior to or after purchase."¹²⁴ Pre-sale confusion¹²⁵ results from an infringing mark that creates initial customer interest, even though the confusion is dispelled before an actual sale is finalized.¹²⁶ Under the post-sale confusion doctrine, courts determine if third parties may be misled by

114. See Allen, *supra* note 33, at 321-22.

115. See *supra* note 88 and accompanying text.

116. Act of Oct. 9, 1962, Pub. L. No. 87-772, 76 Stat. 769. Similarly, Congress struck out the word "purchasers" from § 2(d) of the Lanham Act so that it too would state to cause "confusion, or to cause mistake or to deceive." *Id.*

117. See Hoge, *supra* note 93, at 1248-49.

118. In 1962, Congress struck the term "purchasers" from sections 2(d), 16, 32(1) and 45. See *id.* at 1248.

119. See *id.* ("[T]he reference to 'purchasers' is not found elsewhere in the Lanham Act, e.g., Sections 1, 5 and 42.").

120. See *Syntex Lab., Inc. v. Norwich Pharmacal Co.*, 437 F.2d 566, 568 (2d Cir. 1971) (stating that "Congress eliminated . . . qualifying language").

121. See 3 McCarthy 4th, *supra* note 1, § 23:5, at 23-15.

122. See Kirkpatrick, *supra* note 62, § 1.7, at 1-28.

123. See *supra* notes 89-90 and accompanying text.

124. See Kirkpatrick, *supra* note 62, § 1.7, at 1-28. As the Sixth Circuit explained, "[s]ince Congress intended to protect the reputation of the manufacturer as well as to protect purchasers [through the 1962 amendment], the Act's protection is not limited to confusion at the point of sale." *Esercizio v. Roberts*, 944 F.2d 1235, 1245 (6th Cir. 1991).

125. Pre-sale confusion is also referred to as initial interest confusion. See 3 McCarthy 4th, *supra* note 1, § 23:6, at 23-17. For a detailed discussion on pre-sale confusion, see Allen, *supra* note 33, at 339-44.

126. See 3 McCarthy 4th, *supra* note 1, § 23:6, at 23-17 to -18.

viewing items put to their intended use after purchase.¹²⁷ Post-sale confusion is based on the notion that while a consumer may not be confused at the time they purchase a product bearing an allegedly infringing mark, the consumer's use of the product is likely to cause others to be confused.¹²⁸

The essence of this idea was first expounded in *Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-Le Coultre Watches, Inc.*,¹²⁹ a 1955 case involving state common-law unfair competition. In this case, Mastercrafters had marketed a low-priced imitation of the senior user's expensive atmospheric clock.¹³⁰ Although purchasers of the duplicate knew that they were buying a look-alike, observers could not readily distinguish between the two once the clock was in a domestic setting.¹³¹ The court found that even though the imitation did not cause consumer confusion, it did produce confusion among the general public.¹³² The court held, therefore, that Mastercrafters' conduct was unlawful because the existence of an inferior product would result in a loss of the original manufacturer's reputation or customers.¹³³

127. See Chai, *supra* note 23, at 373. For an extensive list of post-sale confusion cases involving trademark or trade dress infringement actions, see Ann K. Wooster, Annotation, "Post-Sale Confusion" in *Trademark or Trade Dress Infringement Actions Under § 43 of Lanham Trade-Mark Act (15 U.S.C.A. § 1125)*, 145 A.L.R. Fed. 407 (1998).

128. See Allen, *supra* note 33, at 344-45; see also *Academy of Motion Picture Arts and Sciences v. Creative House Promotions, Inc.*, 944 F.2d 1446, 1455 (9th Cir. 1991) ("Post-sale confusion occurs when consumers view a product outside the context in which it is originally distributed . . ."); Kirkpatrick, *supra* note 62, § 1.7, at 1-30 ("Postsale confusion occurs when prospective purchasers or others in the relevant public encounter the marks after the goods have been purchased and put to their intended use.");

129. 221 F.2d 464 (2d Cir. 1955). In fact, Second Circuit jurisprudence recognized non-purchaser confusion as relevant at least as far back as *G.H. Mumm Champagne v. Eastern Wine Corp.*, 142 F.2d 499 (2d Cir. 1944), a case that involved a cheap domestic champagne's label that looked like the plaintiff's select French import. As Judge Learned Hand cleverly observed:

[A]s an evening wears on, the label, and only a very casual glance at the label, is quite enough to assure the host and his table that he remains as freehanded and careless of cost as when he began. At such stages of an entertainment nothing will be easier than for an unscrupulous restaurant keeper to substitute the domestic champagne.

Id. at 501.

130. See *Mastercrafters*, 221 F.2d at 465.

131. See *id.* at 465-66.

132. See *id.*

133. See *id.* at 466-67. This early case demonstrates the notion that a trademark owner has an interest in protecting its goodwill and reputation against the unauthorized use of its mark outside of the consumer confusion context. *Mastercrafters* did not involve consumer confusion; rather, it centered on public confusion and the exploitation of a trademark owner's goodwill. Accordingly, Judge Frank commented that:

[S]ome customers would buy [the] cheaper clock for the purpose of acquiring the prestige gained by displaying what many visitors at the customers' homes would regard as a prestigious article. [Mastercrafters'] wrong thus consisted of the fact that such a visitor would be likely to assume that the clock was an Atmos clock. Neither the electric cord attached to, nor [Mas-

Moreover, the Second Circuit found Mastercrafters' freeriding on the goodwill and reputation of the original manufacturer to be offensive.¹³⁴ In so doing, the *Mastercrafters* court implicitly recognized the proprietary value that may develop in a trademark due to the efforts of a trademark owner.

Congress facilitated federal recognition of the post-sale doctrine with the expansion of the confusion test under the 1962 amendment. The courts uniformly interpret certain changes in the amendment.¹³⁵ In particular, the courts agree that the 1962 revision increased the type of actionable confusion.¹³⁶ Judicial decisions, however, continue to disagree over the assessment of relevant population and the relevant time for confusion purposes.

B. *Different Judicial Approaches to the 1962 Revisions*

As mentioned above, courts generally concur on the expansion of the types of actionable confusion under the 1962 amendment to the Lanham Act.¹³⁷ This consensus can likely be attributed to the emphasis placed by Congress's two-step revision of the Act, first, through the omission of the "source of origin" language in 1962,¹³⁸ and second, through the explicit incorporation of sponsorship confusion in the 1988 amendment.¹³⁹ Courts are not in accord, however, concerning the expansion of the relevant population and the relevant time of confusion that was brought about by the 1962 amendment. Some courts, despite the 1962 measure, continue to limit their focus to the likelihood of actual purchaser confusion at the point of sale.¹⁴⁰ Other courts have adopted a post-sale inquiry, recognizing that the confusion of persons other than actual purchasers is actionable. Judicial approaches toward classifying the appropriate population in terms of post-sale confusion differ in basically two ways. Some courts interpret the amendment as authorizing recognition of confusion among purchasers or potential purchasers.¹⁴¹ A potential purchaser is one who is

tercrafters'] name on, its clock would be likely to come to the attention of such a visitor; the likelihood of such confusion suffices to render [the] conduct actionable.

Id. at 466.

134. *See id.* ("[Mastercrafters'] intention thus to reap financial benefits from poaching on the reputation of the Atmos clock is of major importance.").

135. *See Allen, supra* note 33, at 322.

136. *See id.* ("Courts have been substantially uniform in assessing the types of confusion prohibited by the Lanham Act.").

137. *See supra* notes 102-13 and accompanying text.

138. *See supra* notes 102-03 and accompanying text.

139. *See supra* notes 110-11 and accompanying text.

140. *See Allen, supra* note 33, at 332.

141. *See id.* at 331; *see also* *Electronic Design & Sales, Inc. v. Electronic Data Sys. Corp.*, 954 F.2d 713, 716 (Fed. Cir. 1992) ("[I]n the case of goods and services that are sold, the inquiry generally will turn on whether actual or potential 'purchasers' are confused.").

considering a purchase because of a desire to buy a particular item.¹⁴² Other courts, however, define the relevant population for post-sale confusion purposes as the general public.¹⁴³ In addition to encompassing purchasers and potential purchasers, the general public classification consists of people who view others using the goods, but who are not themselves contemplating an impending purchase.¹⁴⁴

1. Analyzing Decisions Requiring Point of Sale Confusion of Actual Purchasers

Despite the 1962 amendment to the Lanham Act, some courts confine the likelihood of confusion analysis to actual purchasers at the point of sale.¹⁴⁵ These courts expressly reject an after-sale confusion focus.¹⁴⁶ These decisions simply announce that the likelihood of confusion inquiry involves only customer confusion at the time of purchase, not public confusion in the post-sale context.¹⁴⁷ For example, in *Nike, Inc. v. "Just Did It" Enterprises*,¹⁴⁸ the plaintiff had brought a trademark infringement action of its trademarks, "NIKE," "JUST DO IT," and swoosh symbol.¹⁴⁹ The defendant marketed t-shirts and sweatshirts with a "swoosh" design identical to the plaintiff's, but with the word "MIKE" instead of "NIKE."¹⁵⁰ The defendant admitted that the purpose of adopting a similar symbol was to cause confusion with the famous Nike mark among casual observers

142. See Shashank Upadhye, *Trademark Surveys: Identifying the Relevant Universe of Confused Consumers*, 8 Fordham Intell. Prop. Media & Ent. L.J. 549, 571 (1998); see also 3 McCarthy 4th, *supra* note 1, § 23:5, at 23-15 to -16 ("A potential customer is one who might some day purchase this kind of product or service and pays attention to brands in that market.").

143. See Kirkpatrick, *supra* note 62, § 1.6, at 1-25.

144. See Upadhye, *supra* note 142, at 571.

145. See *Dorr-Oliver, Inc. v. Fluid-Quip, Inc.*, 94 F.3d 376, 382 (7th Cir. 1996) ("The proper examination is not whether some people viewing clamshells in industry plants might be confused, but rather whether consumers in the market for clamshells are likely to be confused."); *Nike, Inc. v. "Just Did It" Enters.*, 6 F.3d 1225, 1229 (7th Cir. 1993); *Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1206 (1st Cir. 1983) ("If likelihood of confusion exists, it must be based on the confusion of some relevant person; i.e., a customer or purchaser."); *Smithkline Beckman Corp. v. Pennex Prods. Co.*, 605 F. Supp. 746, 751 (E.D. Pa. 1985) ("[T]he inquiry into the likelihood of confusion should center on confusion at the time of purchase."); *American Greetings Corp. v. Easter Unlimited, Inc.*, 579 F. Supp. 607, 616 (S.D.N.Y. 1983) ("[I]t is buyer confusion that the Lanham Act addresses."); *Beneficial Corp. v. Beneficial Capital Corp.*, 529 F. Supp. 445, 450 (S.D.N.Y. 1982) ("[T]he trademark laws do not protect against the possibility that a member of the general public might fall under the mistaken impression that the companies are related.").

146. See *Nike*, 6 F.3d at 1229; *Smithkline*, 605 F. Supp. at 752 ("The inquiry into the likelihood of confusion is directed towards the time of purchase.").

147. See *Nike*, 6 F.3d at 1229 ("We are dealing here with customer confusion when choosing to purchase, or not purchase, the items, not public confusion at viewing them from afar.")

148. 6 F.3d 1225.

149. See *id.* at 1226-27.

150. See *id.* at 1227.

in a non-sale setting.¹⁵¹ Nonetheless, the Seventh Circuit, without explanation, declined to adopt the post-sale doctrine.¹⁵² Rather, the court asserted that the confusion issue was limited to likely confusion of customers, in terms of assessing both the timing element and the relevant population.¹⁵³ Courts adopting this restricted confusion approach usually do not discuss the evolution of the likelihood of confusion standard.¹⁵⁴ Although some of the decisions explicitly recognize that sponsorship confusion is actionable,¹⁵⁵ the opinions do not address the impact of the omission of the purchaser limitation.¹⁵⁶

2. Analyzing Decisions Requiring Confusion of Purchasers or Potential Purchasers

In contrast to the point of sale approach, other courts have expanded the confusion inquiry to include purchasers or potential purchasers.¹⁵⁷ These opinions often cite the 1962 amendment for support, classifying the revision as a clarification rather than as a substantive change.¹⁵⁸ These opinions construe the congressional mea-

151. *See id.* (“[Defendant] admitted that his ‘whole point’ was to give someone viewing from a distance the impression that the shirt actually read NIKE.”).

152. *Id.* at 1229. Although the *Nike* court explained that with a legitimate parody the customer should be amused, not confused, the court opted for a circumscribed relevant confusion population. *See id.* at 1228. Indeed, the Seventh Circuit determined that the inquiry was whether defendant’s goods confused actual customers. *See id.*

153. In finding that the plaintiff failed to establish a likelihood of confusion as a matter of law, the court focused on how involved the purchasing process was for the defendant’s products because the items were only available via mail-order. *See id.* at 1229-30. This discussion illustrates the limitation of the court’s confusion analysis to likely confusion of actual purchasers at the time of purchase.

154. *See, e.g.,* *Smithkline Beckman Corp. v. Pennex Prod. Co.*, 605 F. Supp. 746, 752 (E.D. Pa. 1985) (dismissing post-purchase confusion without citing statutory support for this determination).

155. *See, e.g., Nike*, 6 F.3d at 1228-29 (“[C]ustomer ‘confusion’ need not be restricted to a mistake regarding the source of the goods; the court should also consider whether the customer would believe that the trademark owner sponsored, endorsed or was otherwise affiliated with the product.” (citations omitted)).

156. *See Upadhye, supra* note 142, at 566-67 (“Point of purchase confusion is the most widely analyzed factor for determining when confusion occurs or vests. When courts apply this approach alone, however, they act contrary to the intent behind the 1962 amendment to the Lanham Act . . .”).

157. *See Electronic Design & Sales, Inc. v. Electronic Data Sys. Corp.*, 954 F.2d 713, 716 (Fed. Cir. 1992) (“[I]n the case of goods and services that are sold, the inquiry generally will turn on whether actual or potential ‘purchasers’ are confused.”); *Keds Corp. v. Renee Int’l Trading Corp.*, 888 F.2d 215, 222 (1st Cir. 1989) (“[I]nquiry centers on whether there is likely to be confusion between the two marks among perspective purchasers of women’s canvas sneakers.”); *FASA Corp. v. Playmates Toys, Inc.*, 912 F. Supp. 1124, 1173 (N.D. Ill. 1996) (“The relevant consumer group in this case includes purchasers and potential purchasers. . . .”); *Redken Lab., Inc. v. Clairol Inc.*, 350 F. Supp. 1301, 1305 n.10 (C.D. Cal. 1972) (interpreting the confusion doctrine to include potential purchasers to a degree).

158. In *Redken*, for example, the court expressed the following view of the 1962 amendment:

sure as removing the distinction between actual and potential customers only to the extent that the selection of particular types of goods may differ depending on the kind of industry.¹⁵⁹ Under this approach, trademark protection extends only slightly beyond actual purchaser confusion to include individuals who have engaged in the purchasing process up to the point of finalizing a sale.¹⁶⁰ In effect, there is not much difference between this posture and the stance generally adopted in pre-amendment cases.¹⁶¹

For the most part, however, courts utilizing the potential purchaser approach do interpret the 1962 amendment as facilitating a more significant expansion of the confusion test. In general, these opinions acknowledge that the original statute explicitly limited consideration of likely confusion to purchasers and, thus, by striking out the purchaser reference in 1962, Congress intended to ease this restriction.¹⁶² Courts adopting this view usually rely on a legislative comment that suggests that the confusion provision relates to potential purchasers as well as to actual purchasers.¹⁶³

Some opinions that endorse the potential purchaser approach assert that a more expansive application of the likelihood of confusion test injects an unwarranted dilution standard into the confusion section.¹⁶⁴ For example, in *Esercizio v. Roberts*,¹⁶⁵ a dissenting judge recognized

Congress merely sought to clarify the logical thrust of the Act—that when products cross in the marketplace for consideration by a consumer the likelihood of confusion is to be determined not only with respect to those who actually make a purchase, but also with respect to those who view the wares with the prospect in mind of making a purchase.

Redken, 350 F. Supp. at 1305-06 n.10.

159. See *id.* at 1305 n.10 (“Congress appeared only to remove the distinction between potential and actual consumers insofar as confusion in selection of goods may be likely to occur in a particular trade.”).

160. See Allen, *supra* note 33, at 354.

161. See *id.* (criticizing the *Redken* court for taking too narrow a view of the scope of confusion).

162. See, e.g., *Electronic Design*, 954 F.2d at 716 (stating that Congress deleted the word “purchasers” from the statute to allow for consideration of potential purchasers).

163. See S. Rep. No. 87-2107, at 4 (1962), reprinted in 1962 U.S.C.C.A.N. 2844, 2847 (“The purpose of the proposed change is to coordinate the language here with that used elsewhere and to omit the word ‘purchasers’, since the provision actually relates to potential purchasers as well as to actual purchasers.”). For example, in *Electronic Design*, the court relied on the 1962 congressional remark to assert that in the case of goods and services that are sold, the appropriate inquiry is the likelihood of confusion among actual and potential purchasers. *Electronic Design*, 954 F.2d at 716. As a result, the court articulated the correct analysis for such situations as whether there is likely to be enough overlap of the respective buyers of the parties’ goods to confuse actual or potential purchasers. See *id.*

164. See, e.g., *Esercizio v. Roberts*, 944 F.2d 1235, 1248 (6th Cir. 1991) (Kennedy, J., dissenting) (arguing that the majority “misconstrues the scope of protection afforded by the Lanham Act by . . . reading an anti-dilution provision into the language of section 43(a)”).

165. 944 F.2d 1235 (6th Cir. 1991).

the prevention of consumer confusion and the protection of the trademark owner's interests as the two main goals of trademark law.¹⁶⁶ Yet, the dissenting opinion contended that the protection accruing to a trademark owner is merely derivative of and incidental to the goal of preventing consumer confusion.¹⁶⁷ In criticizing the majority, Judge Kennedy claimed that the opinion "does more than protect consumers against a likelihood of confusion as to the source of goods; it protects the source of the goods."¹⁶⁸ As a result, the dissent maintained that the majority misconstrued the likelihood of confusion test by identifying the target group as the public.¹⁶⁹ In addition, the dissenting opinion articulated that, in effect, the majority inserted an anti-dilution provision into a trademark infringement action, and thus, produced a remedy that is contrary to the language and purpose of the Lanham Act.¹⁷⁰

3. Analyzing Decisions Finding a Likelihood of Post-Sale Confusion of the General Public

Although the potential purchaser approach recognizes an expanded view of the confusion test, this interpretation in certain circumstances may not be enough to protect the trademark owner.¹⁷¹ Accordingly, many courts assertively hold that a finding of likelihood of confusion under the revised Lanham Act can include confusion of the general public after purchase.¹⁷² The phrase "general public," for these pur-

166. *See id.* at 1249 (Kennedy, J., dissenting).

167. *See id.* (Kennedy, J., dissenting).

168. *Id.* at 1248 (Kennedy, J., dissenting).

169. *See id.* at 1248-49. (Kennedy, J., dissenting).

170. *See id.* (Kennedy, J., dissenting).

171. Post-sale confusion is not applicable in all trademark infringement cases because of the product at issue in a given case. For example, as the court explained in *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 631 F. Supp. 735 (S.D.N.Y. 1985), "[t]he possibility of post or non-sale confusion among prospective purchasers is not a significant factor in cases involving products which are not generally visible post-sale, such as food products or toiletries, . . . or where the mark in question is not highly visible even if the product remains in circulation." *Id.* at 746 (citations omitted).

172. *See Insty*Bit, Inc. v. Poly-Tech Indus., Inc.*, 95 F.3d 663, 672 (8th Cir. 1996) ("[A]n action for trademark infringement may be based on confusion of consumers other than direct purchasers, including observers of an allegedly infringing product in use by a direct purchaser."); *Payless Shoesource, Inc. v. Reebok Int'l Ltd.*, 998 F.2d 985, 991 (Fed. Cir. 1993) (applying Tenth Circuit law, the Federal Circuit vacated the denial of a preliminary injunction based primarily on pre-sale differences, and remanded with instructions to consider post-sale confusion); *Esercizio*, 944 F.2d at 1245 ("[I]n this case . . . members of the public, but not necessarily purchasers, were actually confused by the similarity of the products."); *United States v. Hon*, 904 F.2d 803, 808 (2d Cir. 1990) (holding that the Trademark Counterfeiting Act, which contains the same confusion element as the Lanham Act, prohibits confusion among the public at large); *United States v. Torkington*, 812 F.2d 1347, 1350, 1352-53 (11th Cir. 1987) (recognizing that although no one would buy cheap Rolex copies thinking they were genuine, counterfeit Rolex watches created likelihood of post-sale confusion); *Marathon Mfg. Co. v. Enerlite Prods. Corp.*, 767 F.2d 214, 221 (5th Cir. 1985) (interpreting the 1962 Amendment as allowing "any kind of confusion in support of a trademark

poses, does not refer to society at large; rather, these cases typically involve situations where ordinary observers are likely to be confused by viewing the goods bearing the mark in question after they have been put to their intended uses. Specifically, individuals may examine the infringing goods believing them to be those of the senior user, and find themselves disappointed with the quality of the item, which could inhibit them from purchasing the genuine product.¹⁷³ This scenario implicates the two main principles of trademark law: the protection of the trademark owners' interests and the prevention of confusion.¹⁷⁴ The trademark owner's interests are affected by the potential harm to its reputation that results from individuals believing that either the infringing goods emanate from the trademark owner or that the defendant is somehow affiliated with the owner.¹⁷⁵ The effect on consumer confusion generally occurs because, due to an unfavorable impression, individuals may find themselves discouraged from acquiring the genuine item.¹⁷⁶ The effect is magnified when the infringed

infringement action"); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 205 (2d Cir. 1979) (holding that an X-rated movie would cause an association in the minds of the viewers with the cheerleaders, and that "[t]his association results in confusion"); *Grotrian, Helfferich, Schultz, Th. Steinweg Nachf. v. Steinway & Sons*, 523 F.2d 1331, 1342 (2d Cir. 1975) (reasoning that even though customers may know the difference between the products, the public may subliminally associate the names, thereby causing confusion); *Clinique Lab., Inc. v. Dep Corp.*, 945 F. Supp. 547, 557 (S.D.N.Y. 1996) (finding a likelihood of post-sale confusion because point-of-purchase displays and advertising did nothing to address the problem of post-sale confusion of non-purchasers); *Foxworthy v. Custom Tees, Inc.*, 879 F. Supp. 1200, 1216 (N.D. Ga. 1995) (finding that the placement of infringing t-shirts in the public after sale would cause the public viewing the t-shirts to associate the shirts with plaintiff, thereby finding a likelihood of confusion regardless of whether the purchaser was confused); *Educational Testing Serv. v. Touchstone Applied Science Assocs.*, 739 F. Supp. 847, 853 (S.D.N.Y. 1990) (finding a likelihood of confusion among schoolchildren, the ultimate consumers of the infringed product); *Nabisco Brands, Inc. v. Conusa Corp.*, 722 F. Supp. 1287, 1291 (M.D.N.C. 1989) (finding a likelihood of post-sale confusion because the similarity in the parties' candy would not be evident until a consumer opened the candy); *Lois Sportswear*, 631 F. Supp. at 747 ("Because the mark is consistently visible to the purchasing public as a constant advertisement of the product on which an evaluation of it is affixed, the similarity of the marks in a post-sale setting must be taken into consideration."); *Rolls-Royce Motors, Ltd. v. A & A Fiberglass, Inc.*, 428 F. Supp. 689, 694 n.10 (N.D. Ga. 1977) (stating that the non-confusion of purchasers does not preclude a finding of public confusion that results when a product is put to its intended use). In *Nabisco, Inc. v. PF Brands, Inc.*, No. 99 Civ. 0008 (SAS), 1999 WL 47313 (S.D.N.Y. Feb. 3, 1999), Judge Scheindlin of the Southern District of New York asserted that "[p]ost-sale confusion is undoubtedly actionable." *Id.* at *1 n.3. Although the court's grant of a preliminary injunction was based on a finding that the plaintiff was likely to succeed on its federal dilution claim, *see id.* at *18, the opinion stated that the Goldfish crackers at issue in the case are normally eaten from small plastic bags or bowls, rather than out of the packaging. *See id.* at *1. This reference indicates the court's concern over likely confusion among non-purchasers.

173. *See Esercizio*, 944 F.2d at 1244-45.

174. *See supra* note 32 and accompanying text.

175. *See Esercizio*, 944 F.2d at 1244-45.

176. *See id.*

product is a prestige item because observers may develop the impression that the original product no longer possesses the renown it once enjoyed.¹⁷⁷ This situation, at least to a degree, deprives consumers of freedom of choice in the marketplace.

The need to expand the relevant time of confusion to a post-sale context can be demonstrated by conspiracy cases, i.e., when defendants attempt to persuade purchasers to participate in a conspiracy perpetrated against the public. For example, in *A.T. Cross Co. v. Jonathan Bradley Pens, Inc.*,¹⁷⁸ the defendant marketed its look-alike "Cross" brand writing instruments by boldly attempting to convince purchasers that their donees would think they were receiving a genuine Cross pen.¹⁷⁹ In imposing liability, the Second Circuit concluded that non-purchasers could be confused by thinking that the infringer was somehow licensed by the plaintiff to sell writing instruments under a similar mark.¹⁸⁰ This conspiracy theory is redolent of the Second Circuit's decision in *Mastercrafters*, where it likewise prevented an infringer from freeriding on the prestige of the plaintiff and misleading the public.¹⁸¹ Because, in these collusive situations, the defendant acts in concert with the buyer,¹⁸² traditional steps utilized in trademark infringement cases is inappropriate because the purchaser is obviously not confused.¹⁸³

This conspiracy theory often surfaces in cases involving imitation or counterfeit goods. Courts in these cases generally glean congressional intent for protection of non-purchasers by recognizing the evolution of the Lanham Act.¹⁸⁴ In particular, the opinions often cite the 1962 congressional measure that eliminated the source of origin and purchaser references in the statute.¹⁸⁵ These courts believe that, based on the congressional alterations, confinement of the confusion inquiry to purchasers undermines the effect of the Act.¹⁸⁶ In *Rolex Watch U.S.A., Inc. v. Canner*,¹⁸⁷ the court, in addition to referring to the 1962 amendment,¹⁸⁸ cited the "in commerce" clause of the infringement

177. *See id.*

178. 470 F.2d 689 (2d Cir. 1972).

179. *See id.* at 692.

180. *See id.*

181. *See supra* notes 129-34 and accompanying text.

182. *See* David M. Tichane, *The Maturing Trademark Doctrine of Post-Sales Confusion*, 85 Trademark Rep. 399, 414 (1995).

183. *See* *Rolex Watch U.S.A., Inc. v. Canner*, 645 F. Supp. 484, 493 (S.D. Fla. 1986) ("The fact that an immediate buyer of a \$25 counterfeit watch does not entertain any notions that it is the real thing has no place in [the confusion] analysis.").

184. *See id.* at 492-95.

185. *See id.* at 492.

186. *See id.* at 493 ("This Court is of the belief that not only does the Defendants' narrow view of the confusion question jar with the evolution of the Act, but also that it serves to undermine the effect of the law.").

187. 645 F. Supp. 484.

188. *See id.* at 492.

section to support a finding of non-purchaser confusion.¹⁸⁹ The court reasoned that “[o]nce a product is injected into commerce, there is no bar to confusion . . . occurring at some future point in time.”¹⁹⁰

Additionally, post-sale confusion analysis is often applied in cases involving counterfeit goods under the Trademark Counterfeiting Act of 1984.¹⁹¹ Congress incorporated the confusion standard of the Lanham Act into this criminal counterfeiting statute.¹⁹² Courts have interpreted the operative confusion requirement in the Counterfeiting Act as applying to general public confusion, not simply confusion of purchasers or potential purchasers.¹⁹³ In a counterfeiting case, a counterfeiter often conspires with a purchaser to deceive the public.¹⁹⁴ As one commentator explained, a “purchaser is in effect buying a

189. *See id.* A trademark infringement suit involving a federally registered trademark is governed by section 32(1) of the Lanham Act, 15 U.S.C. § 1114(1) (1994). Section 32(1) provides in pertinent part: “Any person who shall, without the consent of the registrant . . . use in commerce any reproduction . . . of a registered mark . . . likely to cause confusion, or to cause mistake, or to deceive . . . shall be liable in a civil action” *Id.*

190. *Rolux Watch*, 645 F. Supp. at 493.

191. 1984 Pub. L. No. 98-473, 98 Stat. 2178 (codified as amended at 18 U.S.C. § 2320 (1994)). The Act prohibits the intentional trafficking or attempted trafficking in goods or services bearing a counterfeit mark. *See* 18 U.S.C. § 2320(a). For a detailed discussion of the Trademark Counterfeiting Act and its legislative history, see Brian J. Kearney, Note, *The Trademark Counterfeiting Act of 1984: A Sensible Legislative Response to the Ills of Commercial Counterfeiting*, 14 *Fordham Urb. L.J.* 115, 133-44 (1986).

192. In *United States v. Hon*, 904 F.2d 803 (2d Cir. 1990), the Second Circuit found that Congress desired to include the confusion requirement of the Lanham Act into 18 U.S.C. § 2320, and that it was successful in doing so. *See id.* at 805. The court further instructed:

As stated by the chief House and Senate sponsors of the Trademark Counterfeiting Act, likely “to cause confusion, to cause mistake, or to deceive.” . . . is the key phrase in the remedial section of the Lanham Act . . . and its inclusion here is intended to ensure that no conduct will be criminalized by this act that does not constitute trademark infringement under the Lanham Act.

Id. at 805 (quoting Joint Statement on Trademark Counterfeiting Legislation, 130 *Cong. Rec.* 31,673, 31,675 (1984)).

193. *See id.* at 805-08; *United States v. Yamin*, 868 F.2d 130, 132-33 (5th Cir. 1989); *United States v. Gantos*, 817 F.2d 41, 43 (8th Cir. 1987); *United States v. Torkington*, 812 F.2d 1347, 1351-53 (11th Cir. 1987); *United States v. Infurnari*, 647 F. Supp. 57, 59-60 (W.D.N.Y. 1986); *United States v. Gonzalez*, 630 F. Supp. 894, 896 (S.D. Fla. 1986).

194. *See Tichane, supra* note 182, at 414. Although the case of *Rolux Watch*, 645 F. Supp. 484, involved a trademark infringement claim, the court’s consideration of the injuries that might ensue as a result of counterfeit goods is helpful:

Individuals examining the counterfeits, believing them to be genuine Rolex watches, might find themselves unimpressed with the quality of the item and consequently be inhibited from purchasing the real time piece. Others who see the watches bearing the Rolex trademarks on so many wrists might find themselves discouraged from acquiring a genuine because the items have become too common place and no longer possess the prestige once associated with them.

Id. at 495.

close replica of a status product at a much lower price, intending to pass it off as the genuine item while using, displaying, or wearing it."¹⁹⁵ These situations are particularly appropriate for utilization of the post-sale confusion doctrine. In fact, the doctrine is critical for safeguarding the status of the legitimate product and its manufacturer's reputation, because no one doubts that the purchaser is not confused.¹⁹⁶

The Second Circuit's decision in *United States v. Hon*¹⁹⁷ illustrates the application of the post-sale confusion concept in a criminal counterfeiting context. In *Hon*, the court upheld a jury verdict that found that the defendant violated the Trademark Counterfeiting Act by trafficking imitation Rolex, Gucci, Piaget, and Movado time pieces.¹⁹⁸ On appeal, the defendant contended that the trial judge erred by instructing the jury to consider a likelihood of confusion among the non-purchasing public when determining if confusion was likely.¹⁹⁹ Instead, the defendant maintained that the district court's jury charge should have been limited to the likelihood of confusion among purchasers or potential purchasers.²⁰⁰ He argued that the confusion requirement under the Trademark Counterfeiting Act must be read more narrowly than its Lanham Act counterpart.²⁰¹ For support, the defendant maintained that Congress intended to prohibit only egregious instances of conduct under the criminal statute.²⁰² While the Second Circuit agreed with *Hon*'s characterization of the congressional intent of the Trademark Counterfeiting Act,²⁰³ the court explained that the limitation is not measured by the status of the person deceived, but instead based on whether the mark is a counterfeit.²⁰⁴ Even though the Trademark Counterfeiting Act is narrower than the Lanham Act provisions, *Hon* articulated that the legislative history of the Trademark Counterfeiting Act supports the view that the reach of the statute is public, non-purchaser confusion.²⁰⁵

195. Tichane, *supra* note 182, at 414.

196. *See id.* at 414-15.

197. 904 F.2d 803.

198. *Id.* at 804.

199. *See id.* at 804-05.

200. *See id.*

201. *See id.* at 805.

202. *See id.*

203. *See id.*

204. *See id.* at 805-06.

205. *See id.* at 806. The decision quoted instructive legislative history: "Congress was concerned not only that '[t]rademark counterfeiting . . . defrauds purchasers, who pay for brand-name quality and take home only a fake,' but also that 'counterfeiters [can earn] enormous profits . . . by capitalizing on the reputations, development costs, and advertising efforts of honest manufacturers at little expense to themselves.'" *Id.* (quoting S. Rep. No. 98-526, at 4-5 (1984), *reprinted in* 1984 U.S.C.C.A.N. 3182, 3630-31).

The Second Circuit provided three rationales to support the public, non-purchaser confusion standard.²⁰⁶ First, the court explained that its interpretation advanced the important policy underlying trademark law of protecting a trademark owner's goodwill from freeriding by a defendant.²⁰⁷ Second, the court advised that courts in sister circuits that have addressed the confusion requirement of the Trademark Counterfeiting Act uniformly rejected the position posited by the defendant.²⁰⁸ Finally, the court found support for the broader confusion standard in previous Second Circuit opinions interpreting the Lanham Act.²⁰⁹ These opinions construed the 1962 amendment as evincing congressional intent to extend protection to confusion of any kind.²¹⁰ The court concluded, therefore, that "[b]ecause the purposes of the trademark laws include protection of the integrity of the mark itself, as well as prevention of consumer fraud, we hold that the 'likely to confuse' standard of 18 U.S.C. § 2320 is not limited to purchasers or potential purchasers."²¹¹ As one commentator surmised, "[a]lthough the *Hon* decision was decided under the Trademark Counterfeiting Act, the Second Circuit left no question that it was interpreting, at least indirectly, the scope of confusion actionable under the Lanham Act."²¹²

As discussed above, there are generally three approaches the federal courts utilize for analyzing cases involving a likelihood of post-sale confusion. The first approach limits the confusion inquiry to purchasers at the time of sale. The second approach focuses on the likely confusion of purchasers and potential purchasers. The third approach considers the likelihood of confusion of members of the general public after purchase. As discussed below in part III, the general public approach best comports with the legislative and policy aims of federal trademark law.

III. WHY THE GENERAL PUBLIC SHOULD BE INCLUDED IN THE CONFUSION INQUIRY

This part examines the legislative and policy justifications for courts' interpretation that the 1962 amendments to the Lanham Act enabled the judiciary to prohibit confusion among the general public

206. See Allen, *supra* note 33, at 353 (identifying two of the rationales that the Second Circuit offered for the *Hon* decision).

207. See *Hon*, 904 F.2d at 806 ("[A]n interpretation of section 2320's confusion requirement to include the non-purchasing public advances the important purpose underlying the trademark laws of protecting the trademark owner's investment in the quality of the mark and his product's reputation . . .").

208. See *id.* at 807.

209. See *id.* at 807.

210. See *id.*

211. *Id.* at 808.

212. Allen, *supra* note 33, at 353-54.

after purchase, rather than just among purchasers and/or potential purchasers.

A. Interpretation of Legislative Intent

1. Dilution/Confusion Distinction

While the argument that extending the relevant population to casual observers injects an anti-dilution provision²¹³ into trademark infringement may be shortsighted, it has nonetheless carried favor with commentators. As a result, some commentators argue that post-sale protection should not extend beyond potential purchasers, because a broader construction would be tantamount to dilution and is therefore unjustified.²¹⁴ This stance misses the import of the dilution concept. In particular, “[c]onfusion and dilution involve ‘distinct and inconsistent’ states of mind.”²¹⁵ A dilution claim is predicated on protecting against the lessening of the capacity of a mark to identify and distinguish goods or services.²¹⁶ Such a claim proceeds notwithstanding the presence of confusion.²¹⁷ Conversely, a post-sale confusion claim involving non-purchasers does not eliminate the requirement that a plaintiff establish confusion. In fact, a post-sale claim differs from a traditional confusion claim only in terms of the temporal and relevant population aspects of the confusion analysis.²¹⁸ Admittedly, a typical post-sale confusion decision often refers to dilution concepts.²¹⁹ Nevertheless, this does not offend any trademark precept. Rather, it appears that courts in infringement actions generally use dilution-like

213. See *supra* text accompanying notes 164-70.

214. See Allen, *supra* note 33, at 351 (“The *Ferrari* court’s grant of injunctive relief is difficult to accept. . . . [T]he court’s reliance on a likelihood of confusion to find infringement is improper, unless one takes the view that the Lanham Act protects against confusion among the general non-purchasing public.” (footnotes omitted)); William D. Raman, *Ferrari—Can Dilution Be the Standard for Likelihood of Confusion?*, 1 *Tex. Intell. Prop. L.J.* 1, 1 (1992) (“[T]he majority [opinion] looked to the public as the relevant universe and essentially adopted a tarnishment or dilution test for determining likelihood of confusion.”).

215. Kirkpatrick, *supra* note 62, § 1.5.A, at 1-22.

216. See Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 *Harv. L. Rev.* 813, 825 (1927) (articulating the dilution concept as “the gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name by its use upon non-competing goods”).

217. Section 45 of the Lanham Act sets forth the definition of “dilution” as the: “lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of—(1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake, or deception.” 15 U.S.C. § 1127 (Supp. III 1997).

218. See *supra* Part II.A.1-2.

219. See, e.g., *Esercizio v. Roberts*, 944 F.2d 1235, 1245 (6th Cir. 1991) (quoting the district court’s findings that a mark was diluted in a discussion of point-of-sale confusion); see also Kirkpatrick, *supra* note 62, § 1.5.A, at 1-22 (“Many of the evidentiary factors used in the analysis of likelihood of confusion cases also apply to dilution cases.”).

language to underscore the trademark owners' proprietary interests, which is one of the basic underpinnings of trademark protection.²²⁰

A trademark infringement claim based on post-sale confusion should not succeed in the absence of confusion. Even in jurisdictions that prohibit confusion among non-purchasers, the facts of a particular case often render the doctrine inapplicable because confusion is not likely. For instance, in *Munsingwear Inc. v. Jockey International Inc.*,²²¹ the plaintiff had sought an injunction to protect the distinctive design of its men's underwear.²²² In rejecting the plaintiff's post-sale confusion claim, the court explained that the inherently concealed nature of undergarments diminished the concern that non-purchaser might be confused.²²³ Yet in so holding, the court did not reject the concept of non-purchaser confusion, but simply found the doctrine inapplicable to the facts of the case before it. *Munsingwear* demonstrates that although courts favor the protection of trademark owners' interests, these courts will not do so at the expense of confusion.²²⁴

2. Lack of Congressional Qualification

If Congress intended solely to extend the likelihood of confusion inquiry to include potential purchasers, it could have simply qualified the existing "purchaser" limitation in the statute with the additional phrase "potential purchasers." Instead, Congress omitted the purchaser condition entirely. Although a legislative comment refers to potential purchasers, it does so in an offhanded manner. In fact, the brief legislative history provides no guidance regarding the appropriate application of the revisions.²²⁵ As a result, there is no indication of the appropriate consideration to be given to the vague phrase "potential purchasers." One commentator aptly described the ambiguity:

Linguistically, "potential customer" could mean anyone anywhere on a probability-of-later-purchase continuum, from a person standing at a sales counter handing an item to a cashier who has not yet

220. See *supra* text accompanying notes 40-47.

221. 31 U.S.P.Q.2d (BNA) 1146 (D. Minn. 1994).

222. See *id.* at 1147.

223. See *id.* at 1150.

224. Although some decisions by the Eighth Circuit are receptive to non-purchaser confusion, see, e.g., *Insty*Bit, Inc. v. Poly-Tech Indus., Inc.*, 95 F.3d 663, 672 (8th Cir. 1996) (indicating that the likely of post-sale confusion among observers of an allegedly infringing product is actionable), *Munsingwear* illustrates that if the facts of a particular case do not support a finding of confusion, a plaintiff will not succeed.

225. The Second Circuit, in *United States v. Hon*, 904 F.2d 803 (2d Cir. 1990), articulated this point: "[T]he Senate Report suggests that the amendment's purpose was to make clear that the confusion requirement includes potential purchasers as well as actual purchasers. . . . Still, nothing in the legislative history or the statute as amended excludes from its reach public, nonpurchaser confusion . . ." *Id.* at 807 n.2; see also Allen, *supra* note 33, at 357 ("Unfortunately, neither the 1962 Amendment nor any other legislative source provides or even suggests a definition of the ambiguous term 'potential purchaser.'").

rung up the sale, to a person as yet unborn who might conceivably develop a need for the product.²²⁶

As this observation illustrates, although Congress intimated that the confusion inquiry should extend to potential purchasers, this remark should not be applied too restrictively. Moreover, as another trademark scholar has noted, the broad wording of the amended Lanham Act has led courts to conclude that “the statute protects *at least* potential purchasers in addition to purchasers.”²²⁷ Thus, absent some directive as to its appropriate scope, the potential purchaser phrase should be used as a guideline not as a stringent limitation. Indeed, this may suggest that Congress did not intentionally seek to express a potential purchaser limitation.

Even if this analysis, in and of itself, does not sanction an expansive view of the relevant population, recognition of the legal landscape at the time of the amendment is instructive.²²⁸ Prior to the congressional revision, many courts had already employed an expansive view of confusion.²²⁹ As *Mastercrafters* illustrates, courts of the day recognized that a trademark owner could suffer injury from imitation products if the non-purchasing public was likely to confuse the imitation with the genuine product.²³⁰ Given that the amendment was characterized as a clarification,²³¹ it is reasonable to conclude that Congress referred solely to confusion by design. Thus, because the statute speaks only of confusion, a “purchaser or potential purchaser” approach to every case may inject an unintended qualifying condition for testing infringement.

3. Lack of Subsequent Congressional Action

Even if it could be successfully argued that the amendment was not meant to encompass public confusion, Congress’s subsequent reticence on the issue should be regarded as acquiescence. Based on the 1962 amendment, a plethora of courts have utilized the post-sale confusion doctrine to prohibit confusion among casual observers and

226. Malla Pollack, *Your Image Is My Image: When Advertising Dedicates Trademarks to the Public Domain—With an Example from the Trademark Counterfeiting Act of 1984*, 14 Cardozo L. Rev. 1391, 1455 (1993).

227. Kirkpatrick, *supra* note 62, § 1.6, at 1-25.

228. See *Koppers Co. v. Krupp-Koppers GmbH*, 517 F. Supp. 836, 844 (W.D. Pa. 1981) (“Although the findings [in *G.H. Mumm* and *Mastercrafters*] were made under theories of unfair competition, they certainly were part of the legal context in which Congress acted in adopting the 1962 amendment.”).

229. See, e.g., *Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-Le Coultre Watches, Inc.*, 221 F.2d 464 (2d Cir. 1955) (stating confusion of the general public actionable); *G.H. Mumm Champagne v. Eastern Wine Corp.*, 142 F.2d 499 (2d Cir. 1944) (recognizing the relevance of non-purchaser confusion).

230. *Mastercrafters*, 221 F.2d at 466.

231. See Hoge, *supra* note 93, at 1245.

members of the general public.²³² Moreover, Congress was evidently aware of this judicial interpretation.²³³ If Congress did not initially intend an expansive construction of the confusion section, it is quite significant that they have not since chosen to thwart the prevailing judicial interpretation.

Indeed, in recent times, reaction to judicial decisions have often lead to Lanham Act amendments.²³⁴ For example, in *Fleischmann Distilling Corp. v. Maier Brewing Co.*,²³⁵ the Supreme Court held that the Lanham Act did not authorize an award of attorney's fees to the prevailing party in a trademark infringement case.²³⁶ In response to the holding, Congress changed section 35 of the Lanham Act to allow the award of fees in "exceptional" cases.²³⁷

It has been over twenty-seven years since the decision in *Syntex Laboratories, Inc. v. Norwich Pharmacal Co.*,²³⁸ the first decision to interpret and apply the amended statute in a post-sale confusion context.²³⁹ In *Syntex*, the Second Circuit held that the 1962 revision was intended to prevent confusion among the general public.²⁴⁰ Not sur-

232. See *supra* Part II.B.3; see also Tichane, *supra* note 182, at 399 (stating that the post-sale confusion doctrine has spread to virtually every federal circuit and that it is well-settled that the doctrine covers confusion among casual observers).

233. See The United States Trademark Association Trademark Review Commission Report and Recommendations to USTA President and Board of Directors (1987) [hereinafter USTA Report], reprinted in 77 Trademark Rep. 375, 378 (1987). The USTA Report commented that, "a number of courts have viewed the deletion as evidence of Congressional intent to broaden the test for likelihood of confusion. Now, they say, the Act is designed to prohibit confusion of any kind, not merely of purchasers or customers nor as to source of origin." *Id.*, reprinted in 77 Trademark Rep. 375, 378 (1987) (citation omitted). Although the commission referred to the change as inadvertent, and thus appeared to disagree with the purportedly expansive interpretation, it nonetheless did not recommend any congressional action. See *id.*, reprinted in 77 Trademark Rep. 375, 378 (1987).

234. See *id.*, reprinted in 77 Trademark Rep. 375, 378 (1987).

235. 386 U.S. 714 (1967); see also USTA Report, *supra* note 233, reprinted in 77 Trademark Rep. 375, 378-79 (1987).

236. *Fleischmann Distilling*, 386 U.S. at 717-21.

237. See Pub. L. 93-600, 88 Stat. 1955 (1975) (codified as amended at 15 U.S.C. § 1117 (1994)). Another example of congressional reaction to a judicial decision was the passage of the Trademark Clarification Act of 1984, Pub. L. 98-620, 98 Stat. 3335 (codified as amended at 15 U.S.C. § 1127(2)), which nullified the "consumer motivation" test of genericness announced in *Anti-Monopoly, Inc. v. General Mills, Inc.* 684 F.2d 1326 (9th Cir. 1982). The Ninth Circuit held that, in determining if a trademark was generic, the purchaser's motivation for requesting the product was the crucial test. See *Anti-Monopoly, Inc. v. General Mills Fun Group*, 611 F.2d 296, 303-04 (9th Cir. 1979). Under this test, the court held that the famous MONOPOLY trademark was generic and thus unprotectible. In response to clamor within the trademark community, Congress restored the traditional test of genericness, which is an assessment of the primary significance of the term to the purchasing public, see 1 McCarthy 4th, *supra* note 1, § 5:8, at 5-15 to -16, not, as the Ninth Circuit held, the purchaser's motivation for requesting the product by its mark, see *Anti-Monopoly*, 611 F.2d at 303; see also 1 McCarthy 4th, *supra* note 1, § 5:8, at 5-15 to -16.

238. 437 F.2d 566 (2d Cir. 1971).

239. See Tichane, *supra* note 182, at 403.

240. See *supra* note 104.

prisingly, the *Syntex* rationale has continued to enjoy significant favor in numerous judicial decisions.²⁴¹ Yet, Congress has not attempted to rectify the interpretation, which has been its practice when judicial decisions run afoul of congressional intent.²⁴² Perhaps Congress determined that a separate response to *Syntex* and its progeny was not warranted, even if Congress thought the decisions differed from its objectives. Nonetheless, Congress had a perfect opportunity to remove any misconception when it promulgated the Trademark Law Revision Act of 1988,²⁴³ which it classified as "the first overall revision of the Lanham Act."²⁴⁴ Indeed, a principal purpose of the bill was to update the trademark law to reflect present day business practices.²⁴⁵ Thus, to borrow a rule of thumb from another area of the law, sustained statutory interpretation applied to unamended statutes should be deemed to have received congressional approval.²⁴⁶ Based on this theory, non-purchaser confusion should be regarded as an appropriate measure of congressional intent.

4. Noteworthy Scholarly Reaction

Immediately after Congress's 1962 amendment, scholars interpreted congressional intent as prohibiting confusion among the public at large.²⁴⁷ In an article published shortly after Congress amended the Lanham Act in 1962, James F. Hoge, the chairman of the Coordinating Committee of the United States Trademark Association ("USTA"),²⁴⁸ sought to explain the changes. He determined that the revision of the confusion section did not alter the basic law of trademarks.²⁴⁹ On the contrary, Mr. Hoge explained that the Lanham Act clearly exhibits that the purpose of a trademark is to identify the products of its owner and to distinguish them from those of others, "not just for purchasers, but for everyone."²⁵⁰ Further, the article provided a compelling explanation for the general use of the term "purchasers"

241. See, e.g., *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 631 F. Supp. 735, 745 (S.D.N.Y. 1985) (quoting the interpretation of the 1962 amendment in the *Syntex* case).

242. See *supra* notes 234-37 and accompanying text.

243. Pub. L. No. 100-667, 102 Stat. 3946 (codified as amended at 15 U.S.C. § 1125(a) (1994)).

244. S. Rep. No. 100-515, at 2 (1988), *reprinted in* 1988 U.S.C.C.A.N. 5577, 5578.

245. See *id.* at 5577.

246. See, e.g., *United States v. Correll*, 389 U.S. 299, 305-06 (1967) (quoting a settled principle in tax law that long continued interpretation of statutes by the Treasury are deemed to have received congressional approval and thus have the effect of law).

247. See Hoge, *supra* note 93, at 1245.

248. See *id.* at 1245-46, 1254.

249. See *id.* at 1248.

250. *Id.* In addition, the commentator noted that this view of trademark law is also consistent with the 1905 Act. See *id.* He explained that although a section of the 1905 Act expressly referred to purchasers, the section also contained a reference to "the mind of the public." *Id.*

in trademark infringement decisions.²⁵¹ It stated that instead of considering this reference as a definitive pronouncement of the relevant population, it should be regarded as a generic allusion to the relevant population.²⁵² Specifically, Mr. Hoge aptly expounded:

If the courts refer to "purchasers" it is because of the necessity in each case to identify the persons or group of persons if any, who are likely to be confused by the use of different marks upon specified goods. In many cases these would indeed be the purchasers or *potential* purchasers of such goods but the outcome of a particular case does not depend on whether or not actual purchasers, as opposed to other members of the public, are likely to be thus confused.²⁵³

As a board member of the USTA, the entity that provided the report and recommendation on the proposed amendments, Mr. Hoge was well-positioned to assess the objectives of the revisions.²⁵⁴ Consequently, his unequivocal view that the Lanham Act is meant to encompass non-purchaser confusion is persuasive.

B. Policy Justification

Protection of the trademark owner's proprietary interest in its mark also warrants a prohibition of confusion of any kind.²⁵⁵ Congress continuously recognizes the importance of protecting a trademark owner's investment.²⁵⁶ Likewise, courts often fashion trademark relief with this objective in mind. For example, in *W.W.W. Pharmaceutical Co. v. Gillette Co.*,²⁵⁷ the Second Circuit refused to grant injunctive relief against a junior user who had expended a large amount of capital to build up goodwill in the mark at issue.²⁵⁸ The Second Circuit reasoned that an injunction would greatly harm the junior user, while providing little benefit for the plaintiff.²⁵⁹ Under the circumstances,

251. *See id.* at 1249.

252. *See id.*

253. *Id.*; *see also* *Calvin Klein Cosmetics Corp. v. Parfums de Coeur, Ltd.*, 824 F.2d 665, 669 n.4 (8th Cir. 1987) ("In applying principles of trademark law, courts commonly refer to 'the consumer,' much like the references made to 'the reasonable person' in resolving questions of tort law.").

254. *See* Hoge, *supra* note 93, at 1245. Further, Mr. Hoge expressed satisfaction with the committee's recommendations: "The work of the Coordinating Committee demonstrated that negotiation—when patient and sincere—can lead to constructive accomplishment." *Id.* at 1254.

255. *See* *Trade-Mark Cases*, 100 U.S. 82, 92 (1879) ("This exclusive right was not created by the act of Congress, and does not now depend upon it for its enforcement. The whole system of trade-mark property and the civil remedies for its protection existed long anterior to that act, and have remained in full force since its passage.").

256. *See, e.g.*, 135 Cong. Rec. H1207, H1215 (daily ed. Apr. 13, 1989) (statement of Rep. Kastenmeier) ("For businesses, trademarks are a kind of badge of honor, and it is important that their investments in those marks be protected.").

257. 984 F.2d 567 (2d Cir. 1993).

258. *See id.* at 570 ("After an expensive advertising campaign, Gillette's product began to sell very well.").

259. *See id.* at 576.

the court concluded that equitable relief was not warranted.²⁶⁰ *Gillette* demonstrates that courts are cognizant of the need to protect the goodwill in a mark.

Trademark owners annually invest vast amounts of money to promote their trademarks and develop goodwill.²⁶¹ These expenditures are made to encourage the public to associate the marks with "high quality, desirable products."²⁶² The more successful a trademark owner is in this endeavor, the more valuable a trademark becomes.²⁶³ Although difficult to quantify, trademark valuations often play a significant role in determining the stock price of its corporate owner.²⁶⁴ Trademarks and the goodwill they symbolize, therefore, constitute significant proprietary interests. In fact, a trademark is more than simply a symbol of goodwill, it is itself an instrument for creating goodwill.²⁶⁵

Confusion of any kind is a form of "trespass" against the owner because his effort in developing an association with the mark is thwarted. Because any instance of confusion jeopardizes the goodwill cultivated by a trademark owner, confusion is contrary to the main tenets of trademark law. This is the approach espoused by the Second Circuit in *United States v. Hon*:²⁶⁶ "[T]o include the non-purchasing public advances the important purpose underlying the trademark laws of protecting the trademark owner's investment in the quality of the mark and his product's reputation, one that is independent of the goal of preventing consumer deception."²⁶⁷

CONCLUSION

By amending the Lanham Act in 1962, Congress evinced intent to broaden the likelihood of confusion test in terms of the relevant universe. Based on the way in which Congress elected to revise the confusion section, and the policy rationales behind the measure, many courts have adopted an expansive view of the relevant population. These courts reason that the revision reveals Congress's intent to prohibit confusion of non-purchasers in a post-sale setting. This expansive view is justified by assessing the legal environment at the time Congress made the revisions and by analyzing Congress's previous responses when judicial interpretations misconstrue legislative intent. Further, this interpretation comports with the two main purposes of

260. *See id.*

261. *See Gardner, supra* note 16, at 705.

262. *Id.*

263. *See* John V. Tait, Note, *Trademark Regulations and the Commercial Speech Doctrine: Focusing on the Regulatory Objective to Classify Speech for First Amendment Analysis*, 67 *Fordham L. Rev.* 897, 936 (1998).

264. *See id.* at 936-37.

265. *See* 1 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* § 2.07, at 2-37 (3d ed. 1992).

266. 904 F.2d 803 (2d Cir. 1990)

267. *Id.* at 806.

trademark law, which is prevention of confusion and protection of the proprietary interests in a trademark. Although a relevant universe consisting of casual observers is not appropriate in every situation, through its 1962 amendment, Congress armed the judiciary with legislation that can be enlisted when the facts of a given case dictate.

Notes & Observations