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OWN YOUR MARK: TRADEMARK LAW AND THE LIKELIHOOD OF CONFUSION

Part I. Introduction

Oprah Winfrey's couch has had many iconic moments, after all who could forget Tom Cruise ecstatically jumping up and down declaring his love for Katie Holmes. Unfortunately, for Oprah, it may be trademark owners turn to jump for joy at her expense thanks to a recent Second Circuit decision. The Second Circuit expressly disavowed a standard proposed by the Sixth Circuit, which stated that an alleged infringer must use a trademark as a trademark in order for a plaintiff to bring an infringement action.¹ As a result, the Sixth Circuit broadened a narrow exception to non-infringing use of a mark that could result in serious injury to trademark owners. The Second Circuit correctly emphasized likelihood of consumer confusion as the proper test and not whether the alleged infringer had used the mark as a trademark.²

It is a considerable challenge to claim that Oprah is not a major celebrity and media giant today. Oprah's brand, which is her name, is internationally recognizable. Oprah is probably one of the most recognized and respected celebrities. She has created a media empire around her name and recently launched her own network. Around this empire, Oprah has established a family of trademarks and brands. The strength, reputation, and recognition of Oprah's brands, though, do not give Oprah carte blanche to promote her brands at the expense of smaller trademark owners. Recently, Oprah's company arranged to buy the rights to the trademark of "OWN ONYX WOMAN NETWORK" in order to avoid any infringement action with the

¹ See *Kelly-Brown v. Winfrey*, 717 F.3d 295 (2d Cir. 2013); *Hensley Mfg. v. ProPride Inc.*, 579 F.3d 603 (6th Cir. 2009).

² See *Kelly-Brown*, 717 F.3d 295.

previous owner of the mark.³ Oprah and her affiliates wanted the mark “OWN” for Oprah’s emerging cable channel. The only problem is that Oprah’s ensuing use of the “OWN” mark was eerily similar to one other trademark. Simone Kelly-Brown is a motivational speaker who cultivated a brand around the mark “Own Your Power.”⁴ Oprah’s company would have discovered this information when it was acquiring the rights to OWN ONYX WOMAN NETWORK.⁵ Oprah then launched a promotional event in conjunction with her new media empire by hosting an event around the theme “Own Your Power”.⁶ The Second Circuit held that although Oprah and her affiliates may not have used “Own Your Power” as a trademark there was still a real possibility that consumers were likely to be confused.⁷ In holding so, the Second Circuit directly attacked the standard promulgated by the Sixth Circuit that required use as a trademark as a threshold matter for an infringement action.⁸

A trademark is “any word, name, symbol, or device . . . used by a person . . . to identify and distinguish his or her goods, including a unique product, from those manufactured or sold to others and to indicate source of the goods, even if that source is unknown.”⁹ The basic function of trademarks is to serve as source-identifiers.¹⁰ Trademark law attempts to protect both the consumer and the owner of the mark from unfair competition that results when another appropriates the mark for his own benefit.¹¹ The danger is that infringing users can free ride on the owner of the mark’s goodwill and reputation by inducing the consumer to believe that the

³ Kelly-Brown v. Winfrey, 717 F.3d 295, 299–300 (2d Cir. 2013).

⁴ *Id.* at 299.

⁵ *Id.* at 299–300.

⁶ Kelly-Brown, 717 F.3d at 301.

⁷ *Id.* at 307.

⁸ *Id.* at 305–307.

⁹ 15 U.S.C. § 1127.

¹⁰ See Qualitex Co. v. Jacobsen Prods. Co., 514 US 159, 163–164 (1995).

¹¹ See Yale Elec. Corp. v. Robertson, 26 F.2d 972, 973–974 (2d Cir. 1928).

goods originate from the same source.¹² In order to bring an infringement action, a plaintiff must prove he owns the mark; the mark was used in commerce, and use of the mark likely caused consumer confusion.¹³ The main claim in an infringement action is likelihood of confusion. Likelihood of confusion exists when “an appreciable number of ordinary prudent purchasers are likely to be misled, or indeed simply confused, as to the source of the goods in question.”¹⁴

The Sixth Circuit in *Hensley* advocated that there could never be likelihood of confusion when trademarks are not used in a trademark way.¹⁵ The court based its decision off an earlier case that held that trademarks in the post-domain path do not signify source and thus the eight-factor likelihood of confusion analysis is not applicable.¹⁶ The rationale was that the purpose of trademarks is to signify source and that using a mark in the post-domain path of a website does not signify source to the consumer. Since the mark is not being used in such a “trademark way” the court found that the likelihood of consumer confusion was highly unlikely and declined to apply the eight-factor test.¹⁷ The Sixth Circuit founded this rationale off a case out of the Ninth Circuit, which propounded the concept of nominative fair use as a non-infringement use.¹⁸ The Second Circuit disagreed with this standard because it presupposes consumer confusion, or lack thereof, without even addressing the traditional eight-factor, fact intensive inquiry.¹⁹ The Second Circuit observed that the standard proffered by the Sixth Circuit could potentially prevent legitimate infringement claims from reaching the likelihood of confusion analysis.²⁰ Should the courts follow the Sixth Circuit and decide, as a threshold matter, whether the alleged

¹² Yale Elec. Corp. v. Robertson, 26 F.2d 972, 973–974 (2d Cir. 1928).

¹³ 15 U.S.C. § 1114(1).

¹⁴ Mushroom Makers, Inc. v. R.G. Barry Corp., 580 F.2d 44, 47 (2d Cir. 1978).

¹⁵ Hensley Mfg. v. ProPride, Inc., 579 F.3d 603, 610 (6th Cir. 2009).

¹⁶ Interactive Prods. Corp. v. a2z Mobile Office Solutions, Inc., 326 F.3d 687, 698 (6th Cir. 2003).

¹⁷ *See id.*

¹⁸ *See New Kids on the Block v. News America Pub. Inc.*, 971 F.2d 302, 307–308 (9th Cir. 1991)

¹⁹ *See Kelly-Brown v. Winfrey* 717 F.3d 295, 307 (2d Cir. 2013).

²⁰ *Id.*

infringement uses the mark in a trademark way or is the Second Circuit correct in disregarding this requirement as overly restrictive?

This Note will argue that the Second Circuit is correct in dismissing the Sixth Circuit's standard. Part II of this Note will outline the applicable background trademark law and policy. Part III will focus on the cases that led to the Second and Sixth Circuit split. Part IV will discuss how these cases apply to the relevant trademark law and the possible consequences.

Part II. Background Trademark Law

The History and Basics of Trademark Law

A trademark is “any word, name, symbol, or device . . . used by a person . . . to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”²¹ A service mark is “a mark used in the sale or advertising of services to identify the services of one person and distinguish them from the services of others.”²² Since both are extremely similar, they are often commonly labeled as trademarks.²³ Trademarks serve several functions, including; signifying source, to signify the same source controls the trademarked goods; to signify a consistent level of quality with the goods bearing the trademark; and as an advertisement tool.²⁴ Additionally, trademarks serve as “an objective symbol of the good will the business has built up.”²⁵

Trademark law thus strives to strike a balance between protecting the consuming public from deception and protecting property that a person has put considerable time, effort, and resources into developing, with encouraging competition.²⁶ The American concept of the free

²¹ 15 U.S.C. § 1127.

²² *Id.*

²³ J. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 3.1(4th ed. 2013).

²⁴ *Id.* at § 3.2.

²⁵ *Id.*

²⁶ *Zippo Mfg. Co. v. Rogers Imports, Inc.*, 216 F. Supp. 670, 694 (S.D.N.Y. 1963).

market focuses on the theory that competition, uninhibited, “is both socially and economically desirable” because it keeps prices down for consumers while still allowing business owners to turn a profit.²⁷ Within this system, the well-known adage “imitation is the greatest form of flattery” took shape. Businesses’ strategies, ideas, and other aspects, once placed in the public domain, become open to imitation.²⁸ Intellectual property, including trademarks, is one of the specifically identified exceptions to this thought.²⁹

Therefore, on one side is the basic tenet that free competition serves substantial social and economic interests and should be unfettered. On the other side, trademark law seeks to protect both the public and trademark owners from conduct that goes beyond imitation and approaches deception.³⁰ A competitor, who attempts to copy a mark, injures the trademark owner because he is, in essence, standing in as the owner and is speaking for him without the owner’s consent.³¹ It does not matter if there is no economic injury to the trademark owner or even if the competitor has enhanced the owner’s reputation, the injury occurs immediately when the competitor appropriates the mark and, by doing so, holds himself out as the owner.³² Additionally, the consuming public is harmed when there are multiple, similar marks. The consumer’s search costs, the time it takes him to make a decision, will rise as he must spend time differentiating between the competing marks and deciding which one stands for the quality

²⁷ McCarty on Trademarks and Unfair Competition, § 1.1.

²⁸ *Id.* at § 1.2.

²⁹ *Id.*

³⁰ “This area of the law is generally referred to as ‘unfair competition’ – unfair because, by using a rival’s mark, the infringer capitalizes on the investment of time, money and resources of his competitor, unfair also because, by doing so, he obtains the consumer’s hard-earned dollar through something akin to fraud.” *New Kids on the Block v. News America Pub., Inc.*, 971 F.2d 302, 305 (9th Cir. 1992).

³¹ “If another uses [the trademark], he borrows the owner’s reputation, whose quality no longer lies within his own control . . . for a reputation, like a face, is the symbol of its possessor and creator, and another can use it only as a mask.” *Yale Elec. Corp. v. Robertson* 26 F.2d 972, 973–974 (2d. Cir. 1928).

³² *See id.*

and product he desires.³³ Therefore, trademark laws serve an important function within the free market society because they prevent consumer confusion as well as allow the owner to control his products and reputation.³⁴

Use as a Trademark

Use as a trademark can be a tricky question since there are multiple meanings to “use as a trademark,” for instance, “use in commerce” and “use of a mark” both qualify as “trademark use.”³⁵ Use in commerce is a requirement for trademark protection. After all, how can something serve as a source-identifier to the consuming public if there is nothing for the public to consume?³⁶ “The term ‘use in commerce’ means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in the mark.”³⁷ Trademark plaintiffs do not need to prove the “use in commerce” requirement; rather, it is fulfilled whenever a mark is fixed to goods “in any manner.”³⁸ Token use does not count as “use in commerce.”³⁹ Courts have found use of a trademark on internet search engines to trigger a competitor’s mark or copy satisfied the “use in commerce” requirement.⁴⁰ Slogans have presented a particular difficult problem for courts in determining whether the slogans are trademarks. “Courts have protected advertising slogans under the theory that companies have devoted a great deal of time and

³³ See *Qualitex Co. v. Jacobsen Prods. Co.*, 514 U.S. 159, 163–164 (1995).

³⁴ See *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 205 (2d Cir. 1979).

³⁵ “Defendants conflate two distinct concepts, use of a trademark in commerce and use as a mark, both of which, confusingly, we describe by the shorthand phrase ‘trademark use.’” *Kelly-Brown v. Winfrey*, 717 F.3d 295, 305 (2d Cir. 2013).

³⁶ See McCarthy on Trademarks and Unfair Competition, § 3.3.

³⁷ 15 U.S.C. § 1127.

³⁸ 15 U.S.C. § 1127.

³⁹ See *Proctor & Gamble Co. v. Johnson & Johnson Inc.*, 485 F. Supp 1185 (S.D.N.Y. 1979) (finding Proctor and Gamble’s attempts to preserve rights in mark by attaching it to other products and sending out small, scheduled, shipments was token use); *Blue Bell, Inc. v. Farah Mfg. Co.*, 508 F.2d 1260 (5th Cir. 1975) (finding Blue Bell did not meet the “use in commerce” requirement by attaching the new mark to other blue jeans that already bore an established mark).

⁴⁰ See *Rescuecom Corp. v. Google, Inc.*, 562 F.3d 123, 125–126 (2d Cir. 2009).

expense into creating an association in the minds of consumers between a slogan and a particular product.”⁴¹ Courts have also determined that slogans did not give rise to trademark protection.⁴²

While “use in commerce” gives rise to trademark protection, trademark owners may still have recourse if others are using their mark. This “use as mark” is not as clear as the “use in commerce” requirement. “The critical enquiry in determining whether a designation functions as a mark is how the designation would be perceived by the relevant public.”⁴³ For the most part, whether a designation is used as a mark is readily apparent and should not involve focused legal examination.⁴⁴ The dispositive question of whether the designation is a mark is whether the user attempted to draw attention to the designation.⁴⁵ The Second Circuit has stated that when determining whether the trademark has been used as a mark, the critical inquiry is how the mark was used.⁴⁶

A subset of “use as a mark” that has particularly vexed courts is whether use of a personal name can give rise to an infringement action.⁴⁷ In *Madrigal*, the court held that “when an individual sells no more than the right to use his name as a trade name or trademark,” he is not prohibited “from taking advantage of his individual reputation by establishing a company which competes against the purchaser of the trade name,” or “from advertising, in a not overly intrusive manner, that he is affiliated with a new company.”⁴⁸ It follows then, that although a person establishes a trademark in his own name and is allowed to transfer ownership of that

⁴¹ *Kelly-Brown v. Winfrey*, 717 F.3d 295, 309 (2d Cir. 2013); *See, e.g., Nike, Inc. v. “Just Did It” Enters.*, 6 F.3d 1225 (7th Cir. 1993); *Cont’l Scale Corp. v. Weight Watchers Int’l, Inc.*, 517 F.2d 1378 (C.C.P.A. 1975); *Chem. Corp. of Am. v. Anheuser-Busch, Inc.*, 306 F.2d 433 (5th Cir. 1962).

⁴² *See, e.g., In re International Paper Company*, 142 U.S.P.Q. 503, 1964 WL 8038 (T.T.A.B. 1964); *In re Illinois Bronze Powder & Paint Co.*, 188 U.S.P.Q. 459, 1975 WL 20850 (T.T.A.B. 1975); *In re European-American Bank & Trust Company*, 201 U.S.P.Q. 788, 1979 WL 24821 (T.T.A.B. 1979).

⁴³ *In re Eagle Crest, Inc.*, 96 U.S.P.Q.2d 1227, 1229, 2010 WL 3441109 (T.T.A.B. 2010).

⁴⁴ *See* *McCarthy on Trademarks and Unfair Competition*, § 3.3.

⁴⁵ *See* *JA Apparel Corp. v. Abboud*, 568 F.3d 390, 400 (2d Cir. 2009).

⁴⁶ “In determining whether a use is made as a mark, however, we make a more detailed determination of the particular manner in which the mark was used.” *Kelly-Brown*, 717 F.3d at 306 (internal citations omitted).

⁴⁷ *See* *Madrigal Audio Laboratories v. Cello, Ltd.*, 799 F.2d 814 (2d Cir. 1986).

⁴⁸ *Id.* at 823.

mark, he is not prevented from capitalizing on his own reputation so long as he comports himself in the proper way.⁴⁹

Even if an alleged infringer uses a trademark, the infringer can utilize several defenses. For instance, an infringer can allege that the use is not likely to cause consumer confusion because the infringer is using the mark in a non-trademark way and it is not a source-identifier.⁵⁰ Additionally, if the alleged infringer used the mark in its original descriptive sense then the infringer could raise a fair use defense.⁵¹ This nominative fair use defense applies to cases where there is no “attempt to capitalize on consumer confusion or to appropriate the cachet of one product for a different use.”⁵² This occurs when “the only word reasonably available to describe a particular thing is pressed into service.”⁵³ The alleged infringer is not attempting to deceive the public because he is not using the mark to signify his own goods but is, instead, truthfully describing the original owner’s product.⁵⁴ The existence of direct competition does not turn nominative fair use into an infringement action.⁵⁵ In *New Kids on the Block*, several news outlets set up hotlines and charged customers to call and answer poll questions about the music group.⁵⁶ The nominative fair use defense requires the alleged infringer to prove three things: (1) the product is not “readily identifiable without the use of the trademark”; (2) “only so much of

⁴⁹ See *Madrigal Audio Laboratories v. Cello, Ltd.*, 799 F.2d 814, 823 (2d Cir. 1986); *Hensley Mfg. v. ProPride, Inc.*, 579 F.3d 603, 610 (6th Cir. 2009).

⁵⁰ See *Interactive Prods. Corp. v. a2z Mobile Office Solutions, Inc.*, 326 F.3d 687, 698 (6th Cir. 2003) (noting the existence of the trademark in the post-domain path was not a source-identifier and was not likely to cause consumer confusion).

⁵¹ See *Packman v. Chicago Tribune Co.*, 267 F.3d 628 (7th Cir. 2001) (finding the Chicago Tribune used the mark “The Joy of Six” to describe the Chicago Bulls sixth championship and did not infringe); *New Kids on the Block v. News America Pub.*, 971 F.2d 302 (9th Cir. 1991) (noting there was no feasible way to refer to music group other than as their name)

⁵² *New Kids on the Block*, 971 F.2d at 308.

⁵³ *Id.*

⁵⁴ “When the mark is used in a way that does not deceive the public we see no such sanctity in the word as to prevent its being used to tell the truth.” *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368 (1924).

⁵⁵ *New Kids on the Block*, 971 F.2d at 309.

⁵⁶ *Id.* at 309–310.

the mark . . . may be used as is reasonably necessary to identify the product”⁵⁷; and (3) the alleged infringer must do nothing that suggests sponsorship or affiliation by the trademark owner.⁵⁷

The concept of fair use expanded with the rise in technology. Courts have addressed when the use of trademarks can rise to the level of infringement with regard to the internet. Courts have stated “a website’s domain name signifies its source of origin.”⁵⁸ “Words in domain names can and do communicate information as to the source or sponsor of a website.”⁵⁹ But “when a domain name is used only to indicate an address on the Internet and not to identify the source of the specific goods and services, the name is not functioning as a trademark.”⁶⁰ Additionally, the post-domain path does not signify origin but instead, “serves a different function.”⁶¹ The court in *Interactive Products* noted that consumers looking for a specific product were not likely to be confused by the existence of the mark in the post-domain path of defendant’s website because that is not how a prospective purchaser would search for the product in question.⁶²

Therefore, use as a trademark does not give rise to an infringement action when the designation is used solely in its descriptive sense,⁶³ there is no other reasonable way to describe the product or service, the mark is being used to designate plaintiff’s goods or services and not defendants,⁶⁴ and the mark is not being used as a source-identifier on the internet.⁶⁵

⁵⁷ *New Kids on the Block v. News America Pub.*, 971 F.2d 302, 309 (9th Cir. 1991).

⁵⁸ *Patmont Motor Werks v. Gateway Marine, Inc.*, No. C96-2703, 1997 U.S. Dis. LEXIS 208877, *4 (N.D. Cal. Dec.18 1997).

⁵⁹ *PACCAR, Inc. v. Telescan Tech*, 319 F.3d 243, 250 (6th Cir. 2003).

⁶⁰ *Data Concepts, Inc. v. Digital Consulting, Inc.*, 150 F.3d 620, 62 –628 (6th Cir. 1998).

⁶¹ *Id.*

⁶² *See Interactive Prods Corp. v. a2z Mobile Office Solutions, Inc.*, 326 F.3d 687, 697 (6th Cir. 2003) (observing consumers were not likely to enter “a2zsolutions.com/desk/floor/laptraveler/dkfl-lt.htm” instead of “Laptraveler.com” when searching for plaintiff’s Laptraveler product).

⁶³ *See Packman v. Chicago Tribune Co.*, 267 F.3d 628 (7th Cir. 2001).

⁶⁴ *See New Kids on the Block*, 971 F.2d 302.

⁶⁵ *See Interactive Prods Corp.*, 326 F.3d 687.

The use of a mark in the secondary market also does not rise to the level of infringement.⁶⁶ In *Champion Spark Plug*, the defendant repaired used “CHAMPION” spark plugs and resold them with each individual plug stamped with the word “reused.”⁶⁷ The court noted that despite the restoration, the spark plugs remained the product of the plaintiff.⁶⁸ The court likened this situation to the selling of a used car and how it would be tedious to require a secondary seller to remove the manufacturer’s designation solely because he had repaired some aspect of the car.⁶⁹ “Inferiority is immaterial so long as the article is clearly and distinctly sold as repaired or recondition rather than as new.”⁷⁰ The court noted “the second-hand dealer gets some advantage from the trademark . . . that is wholly permissible so long as the manufacturer is not identified with the inferior qualities of the product resulting from wear and tear or the reconditioning by the dealer.”⁷¹

Likelihood of Confusion

The likelihood of consumer confusion and not actual consumer confusion is essential in a trademark infringement action.⁷² A requirement of actual confusion would frustrate trademark owners from protecting their marks when an infringing product is new on the market.⁷³ Courts look to whether there is a likelihood of confusion when examining whether or not there is an infringing use of a trademark.⁷⁴ Likelihood of confusion occurs when a significant number of prudent consumers are likely to be misled or confused “as to the source of the goods in

⁶⁶ See *Champion Spark Plug Co. v. Sanders*, 331 U.S. 125 (1947).

⁶⁷ *Id.* at 126.

⁶⁸ *Id.*

⁶⁹ *See id.*

⁷⁰ *Id.* at 130.

⁷¹ *Id.*

⁷² Likelihood of confusion results in injunctive relief but if a plaintiff seeks monetary damages then actual confusion must be proved. See *McCarthy on Trademarks and Unfair Competition*, § 23.12.

⁷³ *See id.*

⁷⁴ *Id.* at § 23.1.

question.”⁷⁵ “The ultimate question remains whether relevant consumers are likely to believe that the products or services offered by the parties are affiliated in some way.”⁷⁶ There are eight factors that courts consider in determining likelihood of confusion: (1) the strength of the mark; (2) degree of similarity between the marks; (3) the proximity of the products; (4) the likelihood the senior user will bridge the gap; (5) actual consumer confusion; (6) the junior user’s intent; (7) the quality of the junior user’s product; and (8) the sophistication of the buyers.⁷⁷ Nearly every circuit has this fact-intensive, eight-factor test, widely known as the *Polaroid* factors.⁷⁸ None of the *Polaroid* factors is expressly dispositive; instead, the analysis looks at the factors in their totality.⁷⁹ It should be noted that while no singular factor is dispositive, courts have sometimes found that intentional copying or bad faith in adopting a mark creates a presumption of actual confusion.⁸⁰ There is a circuit split of authority among the circuits as to whether likelihood of confusion is an issue of law or an issue of fact.⁸¹ Most circuits view likelihood of confusion as an issue of fact reviewed under the clearly erroneous standard.⁸² The Second and Sixth Circuits take the stance that likelihood of confusion is a mixed question of fact and law; the factual findings of the eight-factor test are questions of fact while the balancing of those factors is a question of law.⁸³

There are several types of confusion including initial interest confusion (or pre-sale confusion), post-sale confusion, confusion as to affiliation, and reverse confusion. Initial interest

⁷⁵ *Light Sources, iNc. v. Cosmedico Light, Inc.*, 360 F. Supp. 2d 432 (D. Conn. 2005).

⁷⁶ *Homeowners Group, Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1107 (6th Cir. 1991).

⁷⁷ *Polaroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492, 495 (2d Cir. 1961); *see also* *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979); *Interpace Corp. v. Lapp, Inc.*, 721 F.2d 460 (3d Cir. 1983).

⁷⁸ *See Polaroid Corp.*, 287 F.2d at 495.

⁷⁹ *Star Indus v. Bacardi & Co.*, 412 F.3d 373, 384 (2d Cir. 2005).

⁸⁰ “Intentional copying gives rise to a presumption of a likelihood of confusion.” *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 259 (2d Cir. 1987) (citing *Perfect Fit Industries v. Acme Quilting Co.*, 618 F.2d 950, 954 (2d Cir. 1980).

⁸¹ *McCarthy on Trademarks and Unfair Competition*, § 23.67.

⁸² *Id.*

⁸³ *See Id.*

confusion occurs when a prospective customer, at first glance, believes there is some connection between the product and the original mark owner.⁸⁴ Thus in *Steinway & Sons*, the court observed that a customer searching to buy a piano might think of the quality and reputation of a Steinway piano upon hearing the name “Grotrian-Steinweg” and believe the pianos are somehow connected.⁸⁵ The competing marks do not have to look or sound similar as long as the consumer would initially believe there is some kind of affiliation.⁸⁶ In *Mobil Oil*, the defendant company made wholesale oil deals, mostly by phone. The court found that the defendant could gain credibility “during the initial phases of a deal” because its use of the name “Pegasus” would call to mind Mobil’s well-known mark of a flying horse.⁸⁷ While courts are reluctant to extend such “call-to-mind” protection, it is appropriate when there is such overriding similarity between so many of the *Polaroid* factors.⁸⁸

Post-sale confusion normally occurs after the point of sale where the buyer is not the one confused but others may be.⁸⁹ The danger is that even if the buyer knows the product is a knock-off, others could be confused.⁹⁰ This could occur if the infringing product is gifted to another or sold on the secondary market as speaking to the quality of the legitimate product. Therefore, harm befalls the original trademark owner when inferior goods are traded on his reputation outside of his control.⁹¹ For example, a purchaser of imitation jeans that employ iconic,

⁸⁴ See *Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*, 523 F.2d 1331, 1342 (2d Cir. 1975); see also *Elvis Presley Enterprises Inc. v. Capece*, 141 F.3d 188 (5th Cir. 1998) (finding nightclub could induce potential customers to enter by believing the establishment was somehow affiliated with the estate of Elvis Presley, despite the fact that once inside, the consumer would realize there is no such affiliation).

⁸⁵ *Steinway & Sons*, 523 F.2d at 1342.

⁸⁶ See *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 259 (2d. Cir. 1987).

⁸⁷ *Id.*

⁸⁸ See *id.*

⁸⁹ See *Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-Le Coultre Wateches, Inc.*, 221 F.2d 464 (2d Cir. 1955).

⁹⁰ McCarthy on Trademarks and Unfair Competition, § 23.7.

⁹¹ See *Rolex Watch, Inc. v. Canner*, 645 F. Supp. 484 (S.D. Fla. 1986).

protectable, stitching could influence others who believe he has bought the original.⁹²

Additionally, back pocket designs on jeans have also been held likely to confuse in the post-sale context because of the effect on prospective purchasers “who carry even an imperfect recollection of Strauss’s mark and who observe Wrangler’s projecting label after the point of sale.”⁹³ Likelihood of confusion as to source is the more common occurrence but the Lanham Act expressly accounts for confusion “as to affiliation, connection, or association.”⁹⁴

“Reverse confusion occurs when the junior user’s advertising and promotion so swamps the senior user’s reputation in the market that customers are likely to be confused into thinking that the senior user’s goods are those of the junior user.”⁹⁵ Prospective consumers may believe that the senior user is infringing the junior user’s mark and, as a result, the senior user’s reputation is irreparably harmed.⁹⁶ “The result is that the senior user loses the value of the trademark, its product identity, corporate identity, and control over its goodwill and reputation, and ability to move into new markets.”⁹⁷ For the most part, cases of reverse confusion occur when a large company infringes the mark of a small trademark owner.⁹⁸ The seminal reverse confusion case originated in the Tenth Circuit.⁹⁹ In *Big O*, a small tire retailer in Colorado began selling its own “BIGFOOT” tires in the spring of 1974.¹⁰⁰ That summer, Goodyear set in motion the decision to sell its own “BIGFOOT” tires and began advertising.¹⁰¹ The court observed it was perfectly reasonable for prospective consumers to believe that Big O was selling Goodyear’s

⁹² “A consumer seeing the familiar stitching pattern will associate the jeans with appellee and that association will influence his buying decisions.” *Lois Sportswear, Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 873 (2d Cir. 1986).

⁹³ *Levi Strauss & Co. v. Blue Bell, Inc.*, 632 F.2d 817, 822 (9th Cir. 1980).

⁹⁴ 15 U.S.C. § 1125(a).

⁹⁵ *McCarthy on Trademarks and Unfair Competition*, § 23.10.

⁹⁶ *Banff v. Federated Dep’t Stores, Inc.*, 841 F.2d 486, 490 (2d Cir. 1988).

⁹⁷ *Ameritech v. American Information Technologies Corp.*, 811 F.2d 960 (6th Cir. 1987).

⁹⁸ *McCarthy on Trademarks and Unfair Competition*, § 23.10.

⁹⁹ *See Big O Tire Dealers, Inc. v. Goodyear Tire & Rubber Co.*, 561 F.2d 1365 (10th Cir. 1977).

¹⁰⁰ *Id.* at 1368.

¹⁰¹ *Id.*

tires.¹⁰² Reverse confusion cases are unique in that a plaintiff senior user is more likely to prevail when its trademark is relatively weak.¹⁰³ This is because the weaker the senior user's mark the more likely the junior user's appropriation of the mark, in conjunction with the junior user's advertising and saturation of the market, will lead consumers to believe the senior user is an unauthorized infringer.¹⁰⁴

The Second Circuit identified two explicit examples of instances when infringement actions involving non-trademark use that were allowed to proceed under a likelihood of confusion analysis. One such instance involved whether a slogan playing off a trademarked song was fair use.¹⁰⁵ The court in that case found fair use even though the slogan was not being used as a mark.¹⁰⁶ The owners of the trademark in the well-known song "Sing, Sing, Sing" brought an infringement action against a manufacturer and seller of golf clubs for using similar stock music and the phrase "Swing, Swing, Swing" in television advertisements.¹⁰⁷ The Second Circuit emphasized the proper inquiry for trademark infringement is there is a likelihood of confusion when "consumers believe that the trademark owner sponsors or endorses the use of the challenged mark."¹⁰⁸ Although the Second Circuit ultimately decided the case was within copyright law and not within the realm of trademark law, the court clearly stated that likelihood of consumer confusion was the key analysis and not whether the alleged infringing use was use of a trademark.¹⁰⁹

An in-depth look at the facts and reasoning of the seminal cases is helpful to understand the various trademark issues.

¹⁰² Big O Tire Dealers, Inc. v. Goodyear Tire & Rubber Co., 561 F.2d 1365, 1372 (10th Cir. 1977).

¹⁰³ McCarthy on Trademarks and Unfair Competition, §23.10.

¹⁰⁴ See Checkpoint Systems, Inc. v. Check Point Software Technologies, Inc., 269 F.3d 270 (3d Cir. 2001).

¹⁰⁵ EMI Catalogue P'ship v. Hill, Holiday, Connors, Cosmopolos Inc., 2000 U.S. App LEXIS 30761, at * 28.

¹⁰⁶ *Id.* at * 19.

¹⁰⁷ See *id.* at * 2–5.

¹⁰⁸ *Id.* at * 10.

¹⁰⁹ *Id.*

Part III: The Circuit Split

The Sixth Circuit and *Hensley Mfg. v. ProPride, Inc.*

Hensley Manufacturing and ProPride are both Michigan corporations that compete against each other in the trailer-towing industry.¹¹⁰ Hensley Manufacturing bought the business of Jim Hensley in 1994.¹¹¹ The company then registered trademarks for the name “Hensley” and “Hensley Arrow”.¹¹² “Hensley Manufacturing alleges that these trademarks have become widely known and respected in the marketplace for trailers and recreational vehicles.”¹¹³ In 2007, Hensley Manufacturing’s sales and marketing director, Sean Woodruff, left the company and formed ProPride.¹¹⁴ Jim Hensley also left Hensley Manufacturing and licensed his new trailer hitch design to ProPride.¹¹⁵ ProPride advertised the new trailer hitch as designed by Jim Hensley.¹¹⁶ ProPride’s advertisements expressly disclaimed Jim Hensley’s affiliation with Hensley Manufacturing.¹¹⁷ Hensley Manufacturing sued for trademark infringement and claimed that ProPride’s used its trademark and caused substantial confusion in the market.¹¹⁸

In determining the trademark infringement claim, the Sixth Circuit found the only issue was whether there was any likelihood of confusion.¹¹⁹ While the court acknowledged that it would typically apply the eight-factor test in a likelihood of confusion matter, it added an additional, threshold requirement of “whether the defendants are using the challenged mark in a way that identifies the source of the goods.”¹²⁰ The court further held that if the mark is not

¹¹⁰ *Hensley Mfg. v. ProPride, Inc.*, 579 F.3d 603, 607 (6th Cir. 2009).

¹¹¹ *Id.* There is some issue as to whether Jim Hensley sold or licensed his business.

¹¹² *Id.*

¹¹³ *Id.*

¹¹⁴ *Id.*

¹¹⁵ *Hensley Mfg.*, 579 F.3d at 607.

¹¹⁶ *Id.* at 607–608.

¹¹⁷ *Id.* at 608.

¹¹⁸ *Id.* at 607.

¹¹⁹ *Id.* at 609.

¹²⁰ *Id.* at 610 (internal citation marks omitted).

being used as a source-identifier then it is a non-trademark use and “trademark infringement laws, along with the eight-factor analysis, do not apply.”¹²¹

The Sixth Circuit founded its reasoning on a previous case, *Interactive Prods. Corp. v. a2z Mobile Office Solutions, Inc.*¹²² Interactive Products and a2z both sold portable laptop stands.¹²³ Problems arose when one of Interactive Products’ partners left and formed his own company.¹²⁴ Around the same time, Interactive Products ended its relationship with a2z, with whom it had previously sold its product.¹²⁵ Then, a2z sold the portable laptop stand through its website.¹²⁶ The departing Interactive Products partner then struck up a business relationship with a2z to sell his own design of laptop stand.¹²⁷ The problem was that a2z never changed the website. This resulted in Interactive Products’ trademark, “LAPTRAVELER”, to appear in the post-domain path of a2z’s website in conjunction with the sale of a now competing product The Mobile Desk.¹²⁸

The court recognized that it would traditionally apply the eight-factor likelihood of confusion test but only if relevant consumers would believe the products are affiliated.¹²⁹ The proper inquiry, for the Sixth Circuit, was “whether defendants are using the challenged mark in a way that identifies the source of their goods.”¹³⁰ The court found that if defendants were using the mark “in a non-trademark way – that is, in a way that does not identify the source of a

¹²¹ Hensley Mfg. v. ProPride, Inc., 579 F.3d 603, 610 (6th Cir. 2009).

¹²² 326 F.3d 687 (6th Cir. 2003).

¹²³ *Id.* at 692.

¹²⁴ *Id.*

¹²⁵ *Id.* at 693.

¹²⁶ *Id.*

¹²⁷ *Id.*

¹²⁸ *Interactive Prods. Corp.*, 326 F.3d at 693.

¹²⁹ *Id.* at 695 (quoting *Homeowners Group, Inc. v. Home Marketing Specialists, Inc.*, 931 F.2d 1100, 1107 (6th Cir. 1991)).

¹³⁰ *Id.*

product – then trademark infringement and false designation of origin laws do not apply.”¹³¹

Particular to this case, the court found distinctions to domain names and post-domain path controlling.¹³² “Words in many domain names can and do communicate source.”¹³³ While this is readily apparent it is not always the case, “[w]hen a domain name is used only to indicate an address on the Internet and not to identify the source of specific goods and services, the name is not functioning as a trademark.”¹³⁴ “The post-domain path of a URL, however, does not typically signify source. The post-domain path merely shows how the website’s date is organized within the host computer’s files.”¹³⁵ The court concluded that since “there is not any evidence that the post-domain path of a2z’s portable-computer-stand web page signifies source, it was unnecessary . . . to examine the eight-factors traditionally used to determine likelihood of confusion between two source-signifying marks.”¹³⁶ In summation, the Sixth Circuit expressly held that there is no likelihood of confusion when a trademark is used in a way that does not signify source.

The Second Circuit and *Kelly-Brown v. Winfrey*

Simone “Kelly-Brown owns a motivational services business organization around the concept ‘Own Your Power.’”¹³⁷ She “hosts a radio show, holds conferences and retreats, and writes a blog promoting” this concept.¹³⁸ She owns a federally registered service mark in “Own Your Power.”¹³⁹ As the court properly pointed out, “Oprah almost needs no introduction.”¹⁴⁰

¹³¹ Interactive Prods. Corp. v. a2z Mobile Office Solutions, Inc., 326 F.3d 687, 695 (6th Cir. 2003) (citing *New Kids on the Block v. News America Pub., Inc.*, 971 F.2d 302, 307 (9th Cir. 1991)).

¹³² *Id.* at 696–697.

¹³³ PACCAR, Inc. v. Telescan Tech, 319 F.3d 243, 250 (6th Cir. 2003).

¹³⁴ Data Concepts, Inc. v. Digital Consulting, Inc., 150 F.3d 620, 627–628 (6th Cir. 1998).

¹³⁵ *Interactive Prods. Corp.*, 326 F.3d at 696–697.

¹³⁶ *Id.* at 698.

¹³⁷ *Kelly-Brown v. Winfrey*, 717 F.3d 295, 299 (2d Cir. 2013).

¹³⁸ *Id.*

¹³⁹ *Id.*

¹⁴⁰ *Id.*

She has been a staple on television and has subsequently built a “vast media empire, which consists of, inter alia, a magazine, and a website.”¹⁴¹ Contemporaneously to Kelly-Brown registering her mark, Oprah and her affiliates “arranged for the transfer of a trademark in ‘OWN ONYX WOMAN NETWORK’ . . . to avoid an infringement action from that mark’s original owner.”¹⁴² The court noted that Oprah “would likely have been aware of Kelly-Brown’s pending registration . . . since the same search defendants would have run to locate and negotiate the transfer of the mark in ‘OWN ONYX WOMAN NETWORK’ would have also revealed Kelly-Brown’s mark.”¹⁴³ Kelly-Brown then brought a trademark infringement action against Oprah and her affiliates originating in September 2010.¹⁴⁴

On September 13, 2010 the October issue of Oprah’s magazine, “O”, hit shelves with a cover that “prominently featured the words ‘Own Your Power.’”¹⁴⁵ Three days later, the magazine held an “Own Your Power” event with other businesses.¹⁴⁶ The event featured “a seminar and workshop offering motivational advice regarding self-awareness, self-realization, and entrepreneurship, under the aegis of the them ‘Own Your Power.’”¹⁴⁷ Several celebrities in attendance posed for pictures against a backdrop that also prominently featured the phrase “Own Your Power.”¹⁴⁸ Oprah’s website uploaded videos of the event on over seventy-five webpages that featured an “Own Your Power” banner in the header “that resembled the layout of the October issue of the [m]agazine.”¹⁴⁹ Oprah’s magazine’s Facebook page displayed photographs from the event and Oprah showed the cover of the October issue on her nationally televised

¹⁴¹ *Kelly-Brown v. Winfrey*, 717 F.3d 295, 299 (2d Cir. 2013).

¹⁴² *Id.* at 299–300.

¹⁴³ *Id.* at 300.

¹⁴⁴ *Id.*

¹⁴⁵ *Id.*

¹⁴⁶ *Id.* at 301.

¹⁴⁷ *Kelly-Brown*, 717 F.3d at 302.

¹⁴⁸ *Id.* at 301–302.

¹⁴⁹ *Id.* at 302.

show.¹⁵⁰ As a result, Kelly-Brown and her business “received numerous inquiries from people who appears to have confused Kelly-Brown’s services with Oprah’s [e]vent, [w]ebsite, and [m]agazine.”¹⁵¹ This competition harmed Kelly-Brown’s brand.¹⁵²

Oprah contended that under the Sixth Circuit Standard and previous Second Circuit law, “use as a trademark, is a threshold requirement for adequately alleging a claim of infringement.”¹⁵³ While the Sixth Circuit viewed the use of a mark under a likelihood of confusion lens, the Second Circuit examined the criteria for use of a mark in relation to a fair use defense and disagreed with the Sixth Circuit’s use of a mark in its likelihood of confusion analysis.¹⁵⁴

Oprah claimed that this case was similar to *Packman v. Chicago Tribune Co.*¹⁵⁵ in that her use of the phrase “Own Your Power” as a headline but not as a trademark.¹⁵⁶ In *Packman*, the Chicago Tribune sold t-shirts with a reprinted headline from its issue celebrating the Chicago Bulls sixth NBA championship.¹⁵⁷ Plaintiff brought in action claiming that the newspaper had violated her rights in federal and state trademarks because the headline from that day read “the joy of six.”¹⁵⁸ The Seventh Circuit held that the use of the phrase “the joy of six” was a headline and that the distinctiveness of the Tribune’s masthead dispelled any possible consumer confusion because consumers would clearly identify the t-shirts and other memorabilia sold with the newspaper.¹⁵⁹

¹⁵⁰ *Kelly-Brown v. Winfrey*, 717 F.3d 295, 302–303 (2d Cir. 2013).

¹⁵¹ *Id.* at 303.

¹⁵² *Id.*

¹⁵³ *Id.* at 305.

¹⁵⁴ *Id.* at 307.

¹⁵⁵ 267 F.3d 628 (7th Cir. 2001).

¹⁵⁶ *Kelly-Brown*, 717 F.3d at 309.

¹⁵⁷ *Packman*, 267 F.3d at 632–633.

¹⁵⁸ “Diane Packman holds federal and Illinois trademarks for the phrase ‘the joy of six,’ for use in relation to football and basketball games.” *Id.* at 633.

¹⁵⁹ *Id.* at 639–640.

The Second Circuit in *Kelly-Brown* rejected this argument. The court found, that when determining whether an alleged infringer used a competitor's mark, the correct inquiry is "whether the defendant is using the term as a symbol to attract public attention."¹⁶⁰ The court further noted that in making this determination, "we must conduct a close examination of the content and context of the use."¹⁶¹ The court found that Oprah's "wide-ranging and varied" use met this standard because repetition "forges an association in the minds of consumers between a marketing device and a product."¹⁶² The court noted that it was apparent that Oprah was attempting to associate herself with the phrase "Own Your Power."¹⁶³

The court also took issue with the Sixth Circuit's attempt to change the well-established likelihood of confusion inquiry.¹⁶⁴ The court found the Sixth Circuit's standard inconsistent with a clearly delineated standard that required an intensive factual inquiry, especially since the Sixth Circuit "elevate[d] one particular consideration, which is not even one of the eight *Polaroid* factors, above all the other factors."¹⁶⁵ The Second Circuit also observed that it had previously allowed infringement claims to proceed when there was no use of a mark.¹⁶⁶ The court further expressed concern that the Sixth Circuit's standard would stop these cases at the door without looking into the determinative question of "whether consumers were actually confused by the allegedly infringing product."¹⁶⁷ In sum, the Second Circuit held that the likelihood of consumer

¹⁶⁰ *Kelly-Brown v. Winfrey*, 717 F.3d 295, 306 (2d Cir. 2013) (quoting *JA Apparel Corp. v. Abboud*, 568 F.3d 390, 400 (2d Cir. 2009)).

¹⁶¹ *Kelly-Brown*, 717 F.3d at 306.

¹⁶² *Id.* at 309–310.

¹⁶³ *Id.* at 310.

¹⁶⁴ "The Sixth Circuit has made a judgment that no consumer will be confused unless defendant is using the infringing content as a mark." *Kelly-Brown*, 717 F.3d at 307.

¹⁶⁵ *Id.*

¹⁶⁶ *Id.* (citing *EMI Catalogue P'ship v. Hill, Holliday, Connors, Cosmopolos Inc.*, No. 99-7922, 2000 U.S. App. LEXIS 30761, at * 2–5 (S (2d Cir. Sept. 15, 2000) (holding there were fact issues whether slogan referencing trademarked song was fair use) and *Louis Vuitton Malletier v. Burlington Coat Factory Warehouse Corp.*, 426 F.3d 532 (2d Cir. 2005) (holding confusion was likely without an allegation that defendant's design was a competing mark)).

¹⁶⁷ *Id.*

confusion is paramount in determining whether use of a trademark rises to the level of infringement.

Part IV. Analysis

Use as a Trademark and Public Policy

The ultimate question then is whether use as a trademark is a threshold requirement for an infringement action. The answer, as the Second Circuit correctly pointed out, should be unequivocally no.¹⁶⁸ This is not to say the Sixth Circuit reached the wrong result in *Hensley Mfg.* but the process and reasoning used to reach its conclusion was faulty. In fact, it appears the Sixth Circuit unnecessarily established a presumptive fair use standard by requiring a threshold showing that the alleged infringer is using the designation as a mark without any consideration of the *Polaroid* factors or the existence of the keystone of infringement, likelihood of confusion.¹⁶⁹

The Sixth Circuit expanded the nominative fair use defense further than was contemplated. The Ninth Circuit in recognition that sometimes, trademarks designate a product where “there is no descriptive substitute” promulgated nominative fair use.¹⁷⁰ This occurs when there is “a problem closely related to genericity and descriptiveness . . . when many goods and services are effectively identifiable only by their trademarks.”¹⁷¹ In *New Kids on the Block*, the court found particularly persuasive the fact that it would be unreasonable to refer to the music group in any other way.¹⁷² Furthermore, nominative fair use only occurs when the alleged infringer is using plaintiff’s mark *to refer to the plaintiff*.¹⁷³ That is, nominative fair use of a trademark is not infringing use because the alleged infringer is not trying to take advantage of

¹⁶⁸ See *Kelly-Brown v. Winfrey*, 717 F.3d 295, 307–308 (2d Cir. 2013).

¹⁶⁹ See *Hensley Mfg. v. ProPride, Inc.*, 579 F.3d 603, 610 (6th Cir. 2009).

¹⁷⁰ *New Kids on the Block v. News America Pub., Inc.*, 971 F.2d 302, 306 (9th Cir. 1991).

¹⁷¹ *Id.*

¹⁷² See *id.* (“one might refer to ‘the two-time world champions’ or ‘the professional basketball team from Chicago’ but it’s far simpler (and more likely to be understood) to refer to the Chicago Bulls.”).

¹⁷³ *Id.* (emphasis added)

plaintiff's reputation and goodwill by using plaintiff's mark as a designation of the infringer's goods.¹⁷⁴ Courts extended nominative fair use to include post-domain paths on the internet.¹⁷⁵ The courts noted that the internet is a unique medium and the existence of a trademark in a post-domain path probably does not signify source.¹⁷⁶ This is because consumers are unlikely to type in the full, complicated, web address that includes the trademark in question of a competitor to try and find plaintiff's product.¹⁷⁷ In *Hensley* though, the defendant was using the trademark as a way to identify the source of the goods.¹⁷⁸ After all, Jim Hensley moved his business to ProPride and attempted to capitalize on his personal reputation instead of the reputation of his previous business.¹⁷⁹ This fulfills the policy of allowing an individual to take advantage of his personal reputation not the policy advocated by nominative fair use.¹⁸⁰

This was not the case in *Kelly-Brown*. There, Oprah and her cohorts were attempting to forge a relationship between Kelly-Brown's mark and Oprah.¹⁸¹ The Second Circuit noted that Oprah did not use the mark once but had used repetition to try to nurture the association she was attempting to build between the mark and her brand.¹⁸² Oprah was not using the mark "Own Your Power" to refer to Kelly-Brown.¹⁸³ Oprah was, albeit possibly unintentionally, trying to convert Kelly-Brown's mark for her own use and benefit.¹⁸⁴ Nevertheless, such use would not fall under the Sixth Circuit's requirement of "use as a trademark" before going on to a likelihood

¹⁷⁴ *New Kids on the Block v. News America Pub., Inc.*, 971 F.2d 302, 306 (9th Cir. 1991).

¹⁷⁵ *See Interactive Prods. Corp. v. a2z Mobile Office Solutions, Inc.*, 326 F.3d 687 (6th Cir. 2003).

¹⁷⁶ *Id.*

¹⁷⁷ *Id.*

¹⁷⁸ *Hensley Mfg. v. ProPride, Inc.*, 579 F.3d 603, 607–608 (6th Cir. 2009).

¹⁷⁹ *See Id.*

¹⁸⁰ *See supra* note 31.

¹⁸¹ "[T]hese uses suggest that the defendants were attempting to build an association with consumers between the phrase "Own Your Power" and Oprah." *Kelly-Brown v. Winfrey*, 717 F.3d 295, 308 (3d Cir. 2013).

¹⁸² "Repetition is important because it forges an association in the minds of consumers between a marketing device and a product." *Kelly-Brown*, 717 F.3d at 310.

¹⁸³ *See supra* text accompanying notes 145–150.

¹⁸⁴ "[T]hus it was plausible that the defendants were attempting to build up a line of wide-ranging content all denoted by the phrase "Own Your Power." *Kelly-Brown*, 717 F.3d at 310.

of confusion analysis. Thus, Kelly-Brown would be without recourse and rendered helpless to defend her mark. This clearly frustrates the aims of trademark law.¹⁸⁵

Additionally, this argument should not even be raised. The fair use and nominative fair use defense are defenses. The Sixth Circuit, by requiring use as a trademark as a threshold requirement, is virtually requiring a plaintiff to disprove an element of a defense before it is even raised. It is the burden of the defendant to prove that he is using the mark in a non-infringing way that does not signify himself as the source of the goods. Trademark law serves the dual purpose of protecting both the consumer from confusing marks in the market place and to protect an owner's investment of time, resources, and capital of an owner into building a mark that signifies the owner's right to control the quality of his goods.¹⁸⁶

The Second Circuit properly recognized the futility of this standard. The ultimate question that needs to be asked in an infringement action is whether it is likely that consumers are going to be confused.¹⁸⁷ The Sixth Circuit inexplicably put itself in the shoes of the consumer when it announced that as long as an alleged infringer uses the trademark in some way that does not signify source, it is impossible for any significant portion of the relevant consumer population to be confused.¹⁸⁸

There are real dangers in adopting the Sixth Circuit's standard. Assuming that the Sixth Circuit is correct in holding use of a mark as a trademark is a threshold requirement how would the Second Circuit's interpretation of Kelly-Brown change? After all, Oprah was not using the phrase "Own Your Power" at the magazine event in conjunction with any goods or services.¹⁸⁹

¹⁸⁵ See supra notes 10–11.

¹⁸⁶ See supra note 31.

¹⁸⁷ *Star Indus., Inc. v. Bacardi & Co.*, 412 F.3d 373, 384 (2d Cir. 2005).

¹⁸⁸ *Hensley Mfg. v. ProPride, Inc.*, 579 F.3d 603, 610 (6th Cir. 2009).

¹⁸⁹ *Kelly-Brown v. Winfrey*, 717 F.3d 295, 301–302 (2d Cir. 2013).

On the actual issue of the magazine the phrase was being used just as that, as a phrase.¹⁹⁰ It was not being used to identify any of Oprah’s goods or services or to refer to any of Plaintiff’s goods or services.¹⁹¹ The interesting fact though was the pervasiveness and extensiveness with which Oprah and her affiliates attempted to create an association between the phrase “Own Your Power” and Oprah, an affiliation that led to direct consumer confusion.¹⁹² Under the Sixth Circuit’s analysis, such actual consumer confusion is immaterial because as long as the mark was not being used as a trademark then there can be no likelihood of confusion under trademark law.¹⁹³ This backwards thinking bears dire consequences for trademark owners because it has the danger of taking control away from owners protecting their reputation and goodwill.¹⁹⁴

Likelihood of Confusion

The Second Circuit remanded the case back to the district court to determine whether likelihood of confusion existed but it may be helpful to do a quick breakdown of whether or not a court could find likelihood of confusion in this instance. Recall that the eight factors for likelihood of confusion are: (1) the strength of the mark; (2) the degree of similarity between the marks; (3) the proximity of the products; (4) the likelihood the senior user will bridge the gap; (5) actual consumer confusion; (6) the junior user’s intent; (7) the quality of the junior user’s product; and (8) the sophistication of the buyers.¹⁹⁵ A brief look shows that some of these factors could very well exist in *Kelly-Brown*.

Similarity Between the Marks, Proximity of the Products, and Bridging the Gap

¹⁹⁰ *Kelly-Brown v. Winfrey*, 717 F.3d 295, 301 (2d Cir. 2013).

¹⁹¹ *Id.* at 301–302

¹⁹² *Id.* at 303

¹⁹³ *Hensley Mfg. v. ProPride, Inc.*, 579 F.3d 603, 610 (6th Cir. 2009).

¹⁹⁴ *See supra* note 31.

¹⁹⁵ *See supra* note 77.

“Similarity of the marks is judged by their sound, appearance and meaning.”¹⁹⁶ When goods or services which the alleged infringing mark is attached to compete with the trademark owners goods or services for sales then infringement is likely to be found.¹⁹⁷ The marks are extremely similar in that they contain the exact same words.¹⁹⁸ The services offered by Kelly-Brown and Oprah are also almost identical. Anyone who has ever seen Oprah’s show or knows of her reputation would be hard put to claim Oprah is not inspirational or motivational. These are the exact services that Kelly-Brown provides.¹⁹⁹ Since the proximity of the services offered are so close, it is unnecessary to contemplate whether Kelly-Brown will bridge the gap because there is no gap.²⁰⁰

Actual Consumer Confusion

Actual consumer confusion, though not required to prove a likelihood of confusion, “provides strong support for a finding of a likelihood of confusion.”²⁰¹ Kelly-Brown testified that she and her offices received numerous phone calls inquiring about the mark used in conjunction with Oprah.²⁰² Therefore, it is obvious that Oprah’s use of such a similar mark could have caused actual confusion.

Intent

“Where an infringer adopts a particular name with knowledge of plaintiff’s mark, courts presume there was an intent to copy the mark.”²⁰³ Intent is not required to actually prove

¹⁹⁶ E. & J. Gallo Winery v. Consorzio Del Gallo Nero, 782 F. Supp. 457, 463 (N.D. Cal. 1991) (citing Century 21 Real Estate Corp. v. Sandlin, 846 F.2d 1175, 1179 (9th Cir. 1988)).

¹⁹⁷ “When the goods produced by the alleged infringer compete for sales with those of the trademark owner, infringement usually will be found if the marks are sufficiently similar that confusion can be expected.” AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341, 348 (9th Cir. 1979).

¹⁹⁸ See Kelly-Brown v. Winfrey, 717 F.3d 295, 299–301 (2d Cir. 2013).

¹⁹⁹ *Id.*

²⁰⁰ *Id.*; see Polaroid Corp., 287 F.2d at 495.

²⁰¹ E. & J. Gallo Winery, 782 F. Supp at 465.

²⁰² Kelly-Brown, 717 F.3d at 29–303.

²⁰³ E. & J. Gallo Winery, 782 F. Supp. at 467.

likelihood of confusion.²⁰⁴ There is also evidence that Oprah’s representatives appropriated the mark in bad faith.²⁰⁵ The Second Circuit noted that Oprah’s representatives would have almost definitely come across Kelly-Brown’s pending registration when they were in the process of acquiring the rights to “OWN ONYX WOMAN NETWORK.”²⁰⁶ Based on this it is clear that a court or fact-finder could determine that there was intent to copy Kelly-Brown’s mark.

Types of Confusion Present

Initial Interest Confusion

Initial interest confusion occurs when a prospective customer believes there is some affiliation between the infringing product and the original trademark owner.²⁰⁷ Although in *Kelly-Brown* the marks were similar in sound and appearance this is not required for initial interest confusion as long as the prospective consumer initially believes there is some connection between the products.²⁰⁸ There could easily be initial interest confusion because consumers’ who saw the magazine in stores might think, reasonably, that Kelly-Brown has teamed up with Oprah. This could also be the case for anyone who visited Oprah’s website, Facebook page, or attended the September event.²⁰⁹

Post-Sale Confusion

Post-sale confusion does not affect the direct consumer but rather the secondary viewer of the mark.²¹⁰ Thus, it is another party who views the junior goods and believes them to be the product of the original trademark owner.²¹¹ This takes the quality of the goods outside the hands

²⁰⁴ E. & J. Gallo Winery, 782 F. Supp. 457, 467 (N.D. Cal. 1991).

²⁰⁵ *Kelly-Brown v. Winfrey*, 717 F.3d 295, 300 (2d Cir. 2013).

²⁰⁶ *Id.*

²⁰⁷ *See supra* note 84.

²⁰⁸ *See supra* note 86.

²⁰⁹ *Kelly-Brown*, 717 F.3d at 301–303.

²¹⁰ *See supra* note 89.

²¹¹ *See supra* note 90.

of the original trademark owner.²¹² There could be post-sale confusion when those with knowledge of Kelly-Brown would see others reading Oprah's magazine, say in a doctor's office, and assume that Kelly-Brown has now teamed up with Oprah.

Reverse Confusion

Reverse confusion occurs when consumers believe that the senior user's mark infringes the junior user's.²¹³ This can cause the senior user's reputation to be irreparably harmed.²¹⁴ Normally in a reverse confusion case, the weaker the senior user's mark the more likely he will prevail.²¹⁵ Here, there is a very real possibility of reverse confusion. Oprah is an international celebrity with far-reaching influence.²¹⁶ Her ability to saturate the market with references to potential marks is almost unparalleled. In this case, there was a strategic and well-implemented marketing plan to create an association in consumer's minds between "Own Your Power" and Oprah.²¹⁷ The average consumer is probably much more likely to encounter Oprah's products and services. A consumer who then subsequently found Kelly-Brown's services could very reasonably believe that Kelly-Brown was infringing on Oprah's mark. This is the very definition of reverse confusion.

As is readily apparent, the danger of likelihood of consumer confusion should not rest on a judicially created test to determine if the designation is being used as a trademark but instead should focus on the whole purpose of the likelihood of confusion test, whether a significant portion of the relevant public could be confused.²¹⁸ This focus fulfills both aims of trademark law and further reinforces the correctness of the Second Circuit's standard that, for trademark

²¹² See *supra* note 31.

²¹³ See *supra* note 95.

²¹⁴ See *supra* note 96.

²¹⁵ See *supra* text accompanying notes 103–104.

²¹⁶ See *Kelly-Brown v. Winfrey*, 717 F.3d 295, 299 (2d. Cir. 2013).

²¹⁷ See *id.* at 308.

²¹⁸ See *Star Indus., Inc. v. Bacardi & Co.*, 412 F.3d 373, 384 (2d Cir. 2005).

infringement, the use of a mark requirement should focus on whether or not the designation is being used to garner attention instead of whether it is being used as a source-identifier.

Conclusion

The Sixth Circuit inexplicably narrows trademark protection by raising one of the *Polaroid* factors, use as a trademark, above all others. The Sixth Circuit fails to account for one of the main pillars of trademark law, protecting consumers from confusion. The Second Circuit is correct in keeping the traditional likelihood of confusion analysis in assessing trademark infringement. The Second Circuit strikes the correct balance between upholding the goals of trademark law and extinguishing frivolous infringement claims.