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ARTICLES

THE ROLE OF ACTUAL CONFUSION EVIDENCE IN FEDERAL TRADEMARK INFRINGEMENT LITIGATION*

MICHAEL J. ALLEN**

In deciding the issue of trademark¹ infringement, courts must determine, among other things,² whether the defendant's use of his trademark is likely to cause confusion among the consuming public as to the source of the goods on which the mark is used. In analyzing this issue the courts consider a number of factors.³

* Based on an article which appeared at 83 TRADEMARK REP. 267 (1993).

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1. Unless stated otherwise, the term trademark as used in this article includes common law trademarks and trade dresses protected under Section 43(a) of the Lanham Act as well as federally registered trademarks. "Trade dress' involves the total image of a product and may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques." *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980 (11th Cir. 1983). *See also* *Fuddrucker, Inc. v. Doc's B.R. Others, Inc.*, 826 F.2d 837, 841 (9th Cir. 1987); *Vaughan Mfg. Co. v. Brikam Int'l, Inc.*, 814 F.2d 346, 348 n.2 (7th Cir. 1987); *Ideal Toy Corp. v. Plawner Toy Mfg. Corp.*, 685 F.2d 78, 80 n.2 (3d Cir. 1982).

2. In order for a plaintiff to prove federal trademark infringement, he must show that he possesses a valid, protectable trademark and that the defendant's use of a similar trademark is likely to cause confusion among the consuming public.

3. In determining whether or not a likelihood of confusion exists, courts normally consider the following factors: (1) the strength of the plaintiff's trademark; (2) the similarity of the parties' trademarks; (3) the similarity of the parties' products; (4) the similarity of the retail outlets for the products; (5) the similarity of advertising media utilized by the parties; (6) the defendant's intent

Among these is "actual confusion", that is, whether or not there has been any reported instances of individuals who have actually been confused as to the source of the defendant's products because of the similarity between the parties' trademarks.

While most courts agree that actual confusion is one of the most important factors, if not the most important factor, considered in determining the likelihood of confusion, they have displayed inconsistency in determining what evidence is considered probative, substantial evidence of actual confusion. This problem has been exacerbated by the failure of some courts to describe fully the evidence being considered on this issue and to explain why they find such evidence to be either probative or non-probative of actual confusion.

This article seeks to provide an overall discussion of the role of actual confusion evidence in federal trademark infringement actions and to reconcile the differences among the courts as to the value given to various types of actual confusion evidence. Section I discusses the effect of the existence or absence of actual confusion evidence in infringement actions, and the relative importance which the courts place on such evidence. Section II discusses the various types of evidence which trademark infringement plaintiffs have proffered in attempting to prove the existence of actual confusion, and the weight which the courts have given to these types of evidence. This section also discusses whose confusion (e.g., consumers, suppliers, competitors) is relevant to and probative of actual confusion, and how much evidence of actual confusion is necessary to have this factor support a finding of a likelihood of confusion. Finally, Section III discusses the evidentiary problems, such as hearsay and other concerns, encountered by those attempting to introduce evidence of actual confusion.

I. THE VALUE AND EFFECT OF ACTUAL CONFUSION EVIDENCE

A. *The Presence of Actual Confusion Evidence*

Probative evidence of actual confusion is, without question, highly relevant to the issue of whether confusion between two

in adopting his mark; (7) the existence of actual confusion; and (8) the degree of care exercised by purchasers in making their purchasing decision. See, e.g., *Blue Bell Bio-Medical v. Cin-Bad, Inc.*, 863 F.2d 1253, 1260 (5th Cir. 1989); *Centaur Communications, Ltd. v. A/S/M Communications, Inc.*, 830 F.2d 1217, 1225 (2d Cir. 1987); *Plus Products v. Plus Discount Foods, Inc.*, 722 F.2d 999, 1004 (2d Cir. 1983); *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979). See also RESTATEMENT OF TORTS, §§ 729-31 (1938).

trademarks is likely. While courts recognize the difficulty of obtaining evidence of actual confusion⁴ and therefore generally do not require such evidence in order to find a likelihood of confusion,⁵ a plaintiff able to proffer credible evidence of actual confusion has gone a long way in proving likely confusion. The courts have used various language to characterize the importance of actual confusion evidence to the likelihood of confusion issue; some have called it the "best evidence,"⁶ while others have termed it the "strongest evidence,"⁷ of the existence of a likelihood of confusion.

The Fifth Circuit Court of Appeals has gone even further, intimating that the presence of credible actual confusion evidence creates an inference that a likelihood of confusion exists:

There can be no more positive or substantial proof of the likelihood of confusion than proof of actual confusion. Moreover, reason tells us that while very little proof of actual confusion would be neces-

4. See, e.g., *Bandag, Inc. v. Al Bolser's Tire Stores*, 750 F.2d 903, 914 (Fed. Cir. 1984); *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 353 (9th Cir. 1979); *W.E. Bassett Co. v. Revlon, Inc.*, 435 F.2d 656, 662 (2d Cir. 1970); *Tisch Hotels, Inc. v. Americana Inn, Inc.*, 350 F.2d 609, 612 (7th Cir. 1965); *Earth Technology Corp. v. Environmental Research & Technology, Inc.*, 222 U.S.P.Q. (BNA) 585, 589 (C.D. Cal. 1983).

5. See, e.g., *International Kennel Club of Chicago, Inc. v. Mighty Star, Inc.*, 846 F.2d 1079, 1090 (7th Cir. 1988); *E. Remy Martin & Co. v. Shaw-Ross Int'l Imports*, 756 F.2d 1525, 1529 (11th Cir. 1985); *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d at 353; *W.E. Bassett Co. v. Revlon, Inc.*, 435 F.2d at 662; *Harold F. Ritchie, Inc. v. Chesebrough-Pond's, Inc.*, 281 F.2d 755, 761-62 (2d Cir. 1960); *Earth Technology Corp. v. Environmental Research and Technology, Inc.*, 222 U.S.P.Q. (BNA) at 589.

6. See, e.g., *Allied Mktg. Group, Inc. v. CDL Mktg., Inc.*, 878 F.2d 806, 813 (5th Cir. 1989); *Jordache Enters., Inc. v. Hogg Wyld, Inc.*, 828 F.2d 1482, 1487 (10th Cir. 1987); *Freedom Sav. and Loan Ass'n v. Way*, 757 F.2d 1176, 1185 (11th Cir. 1985); *E. Remy Martin & Co. v. Shaw-Ross Int'l Imports, Inc.*, 756 F.2d at 1529; *AmStar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 263 (5th Cir. 1980), cert. denied, 449 U.S. 899 (1980); *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 383 (7th Cir. 1976), cert. denied, 429 U.S. 830 (1976); *Worthington Foods, Inc. v. Kellogg Co.*, 732 F. Supp. 1417, 1443 (S.D. Ohio 1990).

7. See, e.g., *Brunswick Corp. v. Spinit Reel Co.*, 832 F.2d 513, 521 (10th Cir. 1987); *Polo Fashions, Inc. v. Extra Special Products, Inc.*, 451 F. Supp. 555, 561 (S.D.N.Y. 1978); see also *Safeway Stores, Inc. v. Safeway Discount Drugs, Inc.*, 675 F.2d 1160, 1166 (11th Cir. 1982) (the presence of actual confusion is "[p]erhaps the most important single factor" in determining likelihood of confusion).

sary to prove the likelihood of confusion, an almost overwhelming amount of proof would be necessary to refute such proof.⁸

Other courts have followed the Fifth Circuit's language in discussing the effect of the existence of actual confusion on the likelihood of confusion issue.⁹ Courts are justified in giving great weight to credible evidence of actual confusion, for if substantial confusion as a result of the similarity of the parties' trademarks has already occurred, it usually illustrates that future confusion is likely.¹⁰

B. Actual Confusion Evidence and "Secondary Meaning"

Evidence of actual confusion also is relevant to the issue of whether a plaintiff's descriptive trademark has acquired "secondary meaning" and therefore is protectable. As one leading commentator has stated, "[e]vidence of actual confusion is strong evidence of secondary meaning."¹¹ This statement is logical, since those confused must necessarily associate the plaintiff's trademark with the plaintiff in order for actual confusion to exist:

It must be recognized that secondary meaning and likelihood of buyer confusion, although two separate legal issues, will be difficult to distinguish in viewing the evidence. That is, if buyers are confused, then this also means that they must have recognized plaintiff's word as a trademark and associated it only with plaintiff.¹²

While few courts have discussed the issue of actual confusion as evidence of secondary meaning, those that have done so have given weight to such evidence. For example, in *International Ken-*

8. *World Carpets, Inc. v. Dick Littrell's New World Carpets*, 438 F.2d 482, 489 (5th Cir. 1971) (footnote omitted).

9. *E.g.*, *International Kennel Club of Chicago, Inc. v. Mighty Star, Inc.*, 846 F.2d 1079, 1089 (7th Cir. 1988); *Fuji Photo Film Co. v. Shinohara Shoji Kabushiki Kaisha*, 754 F.2d 591, 596-97 (5th Cir. 1985); *Yankelovich, Skelly and White, Inc. v. White, Yankelovich, Skelly Consulting Group, Inc.*, 14 U.S.P.Q.2d (BNA) 1384, 1388 (S.D.N.Y. 1989); *American Ass'n for the Advancement of Science v. Hearst Corp.*, 498 F. Supp. 244, 258 (D.D.C. 1980).

10. In fact, some courts have concluded that a trial court cannot summarily reject evidence of actual confusion based upon its own conclusion from a side-by-side analysis that confusion is unlikely. *Frito-Lay, Inc. v. Morton Foods, Inc.*, 316 F.2d 298, 301 (10th Cir. 1963); *Harold F. Ritchie, Inc. v. Chesebrough-Pond's, Inc.*, 281 F.2d 755, 761-62 (2d Cir. 1960).

11. 1 J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 15.12, at 15-55 (3d ed. 1992).

12. 1 *id.* § 15.3 at 15-20.

nel Club v. Mighty Star, Inc.,¹³ the Seventh Circuit Court of Appeals stated as follows:

As evidence of secondary meaning, the International Kennel Club also introduced evidence that the club received a number and a variety of letters and phone calls asking about the defendants' toy dogs. In *A.J. Canfield*, the court found similar evidence — letters and phone calls to Canfield “all searching for the elusive diet chocolate fudge drink” (after a competitor advertised its own “Chocolate Fudge” drink) — “sufficient to show that when consumers think of diet chocolate fudge soda they think of Canfield.” Likewise, the correspondence directed to the plaintiff provides support for the inference that when dog fanciers see the “International Kennel Club” name, they think of the plaintiff.¹⁴

Thus, credible evidence of actual confusion is not only extremely helpful in proving a likelihood of confusion, it is also helpful in establishing that the plaintiff's trademark has acquired secondary meaning.¹⁵

C. *The Absence of Actual Confusion Evidence*

Just as the courts have considered the impact of the existence of actual confusion evidence, they have also considered the effect of a lack of actual confusion evidence on a plaintiff's ability to prove infringement. As noted above, courts generally acknowledge that a plaintiff need not prove actual confusion in order to establish trademark infringement.¹⁶ This fact is especially true where the unavailability of such evidence is expected,¹⁷ for exam-

13. 846 F.2d 1079 (7th Cir. 1988).

14. *Id.* at 1086 (quoting *A.J. Canfield Co. v. Vess Beverages, Inc.*, 796 F.2d 903, 907 (7th Cir. 1986)); *see also* *American Scientific Chemical, Inc. v. American Hospital Supply Co.*, 690 F.2d 791, 793 (9th Cir. 1982) (where court relied upon instances of actual confusion as an “inducium” of the secondary meaning achieved in the plaintiff's mark).

15. Some courts have considered actual confusion evidence in making its secondary meaning determination, but have held that evidence of actual confusion on the part of a few non-consumers was insufficient by itself to establish secondary meaning in the plaintiff's trademark. *Bank of Texas v. Commerce Southwest, Inc.*, 741 F.2d 785, 788 (5th Cir. 1984); *Norm Thompson Outfitters, Inc. v. General Motors Corp.*, 448 F.2d 293, 1297 (9th Cir. 1971).

16. *See supra* note 5 and accompanying text.

17. *See, e.g.*, *Bandag, Inc. v. Al Bolser's Tire Stores, Inc.*, 750 F.2d 903, 914 (Fed. Cir. 1984); *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 353 (9th Cir. 1979) (“this factor is weighed heavily [against a likelihood of confusion] only when there is evidence of past confusion or, perhaps, when the particular circumstances indicate such evidence should have been available.”).

ple, where the competing items are low-priced goods usually purchased on impulse and consumers would not be expected to complain about purchasing the wrong product,¹⁸ or where the defendant's product has been on the market for such a short period of time that the receipt of reported instances of actual confusion is unlikely.¹⁹ In such instances, courts generally treat the

18. *E.g.*, *Brunswick Corp. v. Spinit Reel Co.*, 832 F.2d 513, 522 (10th Cir. 1987) (evidence of actual confusion when the products are low priced is more valuable because consumers are more likely to avoid the brand in the future than to complain); *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1543 (11th Cir. 1986), *cert. denied*, 481 U.S. 1041 (1987); *Beer Nuts, Inc. v. Clover Club Foods Co.*, 805 F.2d 920, 928 (10th Cir. 1986); *Chevron Chemical Co. v. Voluntary Purchasing Groups*, 659 F.2d 695, 704-05 (5th Cir. 1981), *cert. denied*, 457 U.S. 1126 (1982); *Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366, 383 (7th Cir. 1976); *Olay Co. v. Cococare Products, Inc.*, 218 U.S.P.Q. (BNA) 1028, 1040 (S.D.N.Y. 1983); *Gillette Canada, Inc. v. Ranir Corp.*, 23 U.S.P.Q.2d (BNA) 1768, 1774 (T.T.A.B. 1992); *see also Tiffany & Co. v. Classic Motor Carriages Inc.*, 10 U.S.P.Q.2d (BNA) 1835, 1843 (T.T.A.B. 1989) (absence of actual confusion is of no consequence because "customers might not make inquiry because they simply assume a connection with opposer"); *Bottega Veneta, Inc. v. Volume Shoe Corp.*, 226 U.S.P.Q. (BNA) 964, 971 (T.T.A.B. 1985) ("both the limitation of opposer's channels [of information] and the natural reluctance of retail purchasers to admit they've been deceived, materially reduce the likelihood that any confusion of purchasers would be reported or that evidence of such would be found"); *Tony Lama Co. v. DiStefano*, 206 U.S.P.Q. (BNA) 176, 185 (T.T.A.B. 1980) (absence of actual confusion evidence is of no consequence "especially where, as here, there is nothing to suggest that the products of the parties are not well constructed and of good quality . . ."). *But see Old Tyme Foods, Inc. v. Roundy's Inc.*, 961 F.2d 200, 205 n.1 (Fed. Cir. 1992) ("Low price, however, does not necessarily mean that actual confusion would not be reported.").

19. *Nina Ricci S.A.R.L. v. E.T.F. Enters., Inc.*, 12 U.S.P.Q.2d (BNA) 1901, 1903 (Fed. Cir. 1989) (defendant's goods not yet marketed); *Hasbro, Inc. v. Lanard Toys*, 858 F.2d 70, 78 (2d Cir. 1988); *Banff, Ltd. v. Federated Dep't Stores, Inc.*, 841 F.2d 486, 492 (2d Cir. 1988) (less than one year); *Centaur Communications, Ltd. v. A/S/M Communications, Inc.*, 830 F.2d 1219, 1227 (2d Cir. 1987) (four months); *Nabisco Brands, Inc. v. Kaye*, 19 U.S.P.Q.2d (BNA) 1465, 1466-67 (D. Conn. 1991) (where defendant's marked product had not yet achieved a "mass market and its sales have been largely confined to defendants' deli restaurant"); *Farberware, Inc. v. Mr. Coffee, Inc.*, 16 U.S.P.Q.2d (BNA) 1103, 1110 (D. Del. 1990) (where defendant only recently began shipping alleged infringing product); *Educational Testing Serv. v. Touchstone Applied Science Assoc., Inc.*, 739 F. Supp. 847, 852 (S.D.N.Y. 1990) (this element is "inapplicable" because "the defendant's product had not yet entered the stream of commerce."); *Worthington Foods, Inc. v. Kellogg Co.*, 732 F. Supp. 1417, 1444 (S.D. Ohio 1990) (sales only recently began); *Kusan, Inc. v. Fairway Siding Corp.*, 7 U.S.P.Q.2d (BNA) 1202, 1209 (D. Mass. 1988) (because defendant's product has been on the market for less than one year, defendant was not entitled to presumption of lack of likelihood of confusion based upon no actual confusion evidence); *Elizabeth*

actual confusion factor as a non-factor, with the absence of such evidence having no adverse impact on the plaintiff's ability to prove infringement.²⁰

In other circumstances, however, a plaintiff's failure to introduce evidence of actual confusion will be highly probative of the unlikelihood of confusion. Indeed, in certain circumstances a plaintiff's inability to produce credible actual confusion evidence has created an almost insurmountable inference of no likelihood of confusion. For example, in *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*,²¹ the First Circuit Court of Appeals addressed the effect of a lack of credible actual confusion evidence on the plaintiff's ability to prevail. After stating that, "absent evidence of actual confusion, when the marks have been in the market, side-by-side, for a substantial period of time, there is a presumption that there is little likelihood of confusion,"²² the First Circuit held that the plaintiff's inability to bring forth more than a "single, feeble and indirect" example of confusion "strongly indicates" that the defendant's use of its mark is not likely to create confusion.²³ Other courts have followed *Pignons*²⁴ or have otherwise similarly recognized that a lack of actual confusion evidence over a substantial period of time creates a presumption or inference,²⁵ or at least strongly supports a finding,²⁶ that confusion is unlikely.

Taylor Cosmetics Co. v. Annick Goutal, S.A.R.L., 673 F. Supp. 1238, 1246 (S.D.N.Y. 1987); Gillette Canada, Inc. v. Ranir Corp., 23 U.S.P.Q.2d (BNA) 1768, 1774 n.13 (T.T.A.B. 1992); Jockey Int'l, Inc. v. Butler, 3 U.S.P.Q.2d (BNA) 1607, 1612 (T.T.A.B. 1987) (applicant's sales "were insignificant"); Chemetron Corp. v. Morris Coupling and Clamp Co., 203 U.S.P.Q. (BNA) 537, 541 (T.T.A.B. 1979) (lack of actual confusion evidence is of no consequence where applicant's mark has been used for one and a half years and there was no evidence of the extent of sales of applicant's goods bearing the mark).

20. See *supra* notes 18 and 19.

21. 657 F.2d 482 (1st Cir. 1981).

22. *Id.* at 490 (quoting 3 ROBERT CALLMANN, THE LAW OF UNFAIR COMPETITION, TRADEMARKS, AND MONOPOLIES § 82.3(a) at 849 (3d ed. 1969)).

23. *Pignons*, 657 F.2d at 491 (four years is a substantial period of time).

24. See, e.g., NEC Elecs., Inc. v. New England Circuit Sales, Inc., 722 F. Supp. 861, 865 (D. Mass. 1989) (five years); Greentree Labs., Inc. v. G.G. Bean, Inc., 718 F. Supp. 998, 1002 (D. Me. 1989) (four years).

25. See, e.g., AmStar Corp. v. Domino's Pizza, Inc., 615 F.2d 252, 263 (5th Cir. 1980) (three instances of actual confusion over fifteen years); McGregor-Doniger, Inc. v. Drizzle Inc., 599 F.2d 1126, 1136 (2d Cir. 1979); Beneficial Corp. v. Beneficial Capital Corp., 529 F. Supp. 445, 451 (S.D.N.Y. 1982).

26. See, e.g., Scotch Whisky Ass'n v. Majestic Distilling Co., 958 F.2d 594, 598 (4th Cir. 1992) (absence of actual confusion after 25 years of use and millions of

While a plaintiff's inability to introduce instances of actual confusion is certainly relevant where both parties' marks have been before the consuming public's eye in a significant manner for a substantial period of time, courts should avoid automatically applying a blanket presumption or inference that confusion is unlikely. Instead, courts should consider the types of products and companies involved and whether confused consumers are likely to make their confusion known, the number of sales of the trademarked products, the opportunity for confusion to occur, and other factors relating to the accessibility of such evidence if confusion has occurred. It must be remembered that in many instances the fact that a plaintiff has not adduced actual confusion evidence does not necessarily mean that actual confusion has not occurred.²⁷

dollars of sales is "strongly probative" evidence that confusion is unlikely); *Western Publishing Co. v. Rose Art Indus., Inc.*, 910 F.2d 57, 63 (2d Cir. 1990) (absence of actual confusion evidence despite substantial sales of the defendant's products over the course of about one year weighs heavily in favor of the defendant); *Oreck Corp. v. U.S. Floor Systems, Inc.*, 803 F.2d 166, 173 (5th Cir. 1986), *cert. denied*, 481 U.S. 1069 (1987) (lack of actual confusion evidence despite 17 months of use by the defendant is highly significant); *Plus Products v. Plus Discount Foods, Inc.*, 722 F.2d 999, 1006 (2d Cir. 1983) (absence of actual confusion evidence "over a three-year period during which substantial sales occurred, is a strong indicator that the likelihood of confusion is minimal."); *Keebler Co. v. Rovira Biscuit Corp.*, 624 F.2d 366, 377 (1st Cir. 1980) (absence of actual confusion evidenced over a three and a half year period is "strongly probative" of no likelihood of confusion); *Scott Paper Co. v. Scott's Liquid Gold, Inc.*, 589 F.2d 1225, 1230-31 (3d Cir. 1978) (19 misdirected letters and phone calls in forty years when the defendant sold \$50 million of products is insignificant and supports a finding that confusion is unlikely); *S.C. Johnson & Son, Inc. v. Lever Brothers Co.*, 19 U.S.P.Q.2d (BNA) 1027, 1036 (E.D. Wis. 1991) (absence of actual confusion evidence despite more than 100 million dollars of sales of products bearing the allegedly infringing mark was "highly persuasive evidence that confusion is not likely."); *Hutchinson v. Essence Communications, Inc.*, 769 F. Supp. 541, 556-57 (S.D.N.Y. 1991); *Paramount Pictures Corp. v. Video Broadcasting Sys., Inc.*, 724 F. Supp. 808, 816 (D. Kan. 1989) (absence of actual confusion evidence is important in finding confusion unlikely); *Sunnen Products Co. v. Sunex Int'l, Inc.*, 1 U.S.P.Q.2d (BNA) 1744, 1749-50 (T.T.A.B. 1987) (absence of actual confusion evidence over a five-year period is "highly significant evidence corroborating applicant's position and our view that confusion is not likely.")

27. Some courts have recognized that generally the number of instances of actual confusion in a given case will exceed the number of reported or adduced instances of actual confusion. *See, e.g., AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1543 (11th Cir. 1986); *NAACP v. NAACP Legal Defense Fund*, 559 F. Supp. 1337, 1344 (D.D.C. 1983).

In instances where the plaintiff seeks a recovery of damages, its inability to introduce actual confusion evidence may be fatal to obtaining that remedy. Some courts have held that in order to recover damages, a plaintiff must show that at least some consumers were actually deceived and that the plaintiff was injured as a result.²⁸ Other courts have held that proof of a wrongful intent on the part of the defendant to deceive the consuming public establishes the plaintiff's right to recover the defendant's profits or its damages.²⁹

II. EVIDENCE PROBATIVE OF ACTUAL CONFUSION

In contrast to the relative uniformity of court decisions concerning the importance and effect of actual confusion evidence to the issue of likelihood of confusion are court decisions concerning what evidence constitutes probative evidence of actual confusion. While courts generally agree that mistaken purchases are the best evidence of actual confusion,³⁰ they have not treated other evidence quite so uniformly, such as evidence of misdirected letters or phone calls³¹ and evidence of inquiries regarding a possible relationship or affiliation between the two parties or their goods.³² The courts have also been inconsistent in determining whose confusion, other than consumers (whose confusion is uniformly treated as relevant) is relevant evidence probative of the existence of actual confusion and, hence, likely confusion.³³ Courts have also varied in analyzing how much actual confusion evidence must be introduced in order for this factor to weigh in favor of a conclusion that confusion is likely.³⁴ Finally, some courts have treated market survey evidence as evidence of actual confusion even

28. See, e.g., *Web Printing Controls Co. v. Oxy-Dry Corp.*, 906 F.2d 1202, 1205 (7th Cir. 1990); *Wordsmith Publishing Co. v. Meredith Corp.*, 904 F.2d 1244, 1247 n.5 (8th Cir. 1990); *Getty Petroleum Corp. v. Island Trans. Corp.*, 878 F.2d 650, 655 (2d Cir. 1989); *Brunswick Corp. v. Spinit Reel Co.*, 832 F.2d 513, 525; *Co-Rect Products, Inc. v. Marvy! Advertising Photography, Inc.*, 780 F.2d 1324, 1329-30 (8th Cir. 1985); *Shonac Corp. v. Amko Int'l, Inc.*, 763 F. Supp. 919, 934 (S.D. Ohio 1991); *Miller v. Chisholm*, 20 U.S.P.Q.2d (BNA) 1376, 1379 (D. Kan. 1991); see also 2 MCCARTHY, *supra* note 11, § 30:25 at 500 n.16.

29. See generally 2 MCCARTHY, *supra* note 11, § 30.25.

30. See *infra* notes 37-41 and accompanying text.

31. See *infra* notes 46-66 and accompanying text.

32. See *infra* notes 67-87 and accompanying text.

33. See *infra* notes 88-114 and accompanying text.

34. See *infra* notes 115-25 and accompanying text.

though it is limited to responses to the artificially created survey stimuli.³⁵

While courts have varied in their treatment of these types of evidence, it is axiomatic that any evidence of actual confusion, to be entitled to any weight, must be related to the similarity of the trademarks involved in suit and not to something else.³⁶ It should also be noted that given the unlimited factual scenarios in which alleged instances of actual confusion may occur, it is impossible and inadvisable to categorize certain groups of evidence as either clearly probative or not probative without analysis of the specific facts involved. The only category of evidence which even approaches justifying uniform treatment as clearly probative is unambiguous evidence of mistaken purchases made as a result of the confusing similarity of the parties' trademarks.

A. *Mistaken Purchases and Similar Evidence*

The best evidence of actual confusion is evidence of individuals who have purchased, as a result of similar trademarks, the product of one of the parties under the mistaken belief that they are purchasing the other party's product.³⁷ Courts have found such evidence to be highly probative of the existence of both actual and likely confusion.³⁸ Other courts have accentuated the great

35. See *infra* notes 126-27 and accompanying text.

36. See, e.g., *Toys "R" Us, Inc. v. Lamps R Us*, 219 U.S.P.Q. (BNA) 340, 346 (T.T.A.B. 1983) ("One important defect [of the actual confusion evidence] is that there is nothing to indicate whether the reason for the question as to affiliation was the result of the similarity of the marks."); *UMC Indus., Inc. v. UMC Elecs. Co.*, 207 U.S.P.Q. (BNA) 861, 879 (T.T.A.B. 1980) ("[T]he instances of actual confusion referred to by opposer involve confusion of the corporate identities of the parties in the financial world rather than confusion arising from applicant's use of [its mark] [T]his is not the type of confusion contemplated under [the Lanham Act]."); *Transamerica Fin. Corp. v. Trans-American Collections, Inc.*, 197 U.S.P.Q. (BNA) 43, 52 (T.T.A.B. 1977); see also 2 McCARTHY, *supra* note 11, § 23.2 at 23-28 ("[E]vidence of actual confusion must be viewed in its evidentiary context. Confusion may not be causally related to the use of similar marks at all.").

37. Generally, in trademark infringement cases the concern is that consumers will mistakenly believe that the defendant's product emanates from the plaintiff. In certain instances, however, there is a greater concern about the likelihood of reverse confusion, i.e., where consumers will mistakenly believe that the plaintiff's product emanates from the defendant. See Michael J. Allen, *Who Must Be Confused and When?: The Scope of Confusion Actionable Under Federal Trademark Law*, 81 TRADEMARK REP. 209, 216-18 (1991).

38. See, e.g., *Brunswick Corp. v. Spinit Reel Co.*, 832 F.2d 513, 521-22 (10th Cir. 1987); *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1543-44 (11th Cir. 1986),

weight given to such evidence by noting the effect of a lack of it.³⁹

cert. denied, 481 U.S. 1041 (1987) (four mistaken purchases); *Louisiana World Exposition, Inc. v. Logue*, 746 F.2d 1033, 1041 (5th Cir. 1984) (one mistaken purchase); *Union Carbide Corp. v. Ever-Ready Inc.*, 513 F.2d 366, 384-85 (one mistaken purchase); *Roto-Rooter Corp. v. O'Neal*, 513 F.2d 44, 46 (5th Cir. 1975) (four mistaken purchases); *Crain Communications, Inc. v. Fairchild Publications, Inc.*, 12 U.S.P.Q.2d (BNA) 1214, 1216 (E.D. Mich. 1989) (one misplaced advertisement in defendant's publication); *Varitronics Sys. Inc. v. Merlin Equip., Inc.*, 682 F. Supp. 1203, 1208-09 (S.D. Fla. 1988) (one mistaken purchase was "very compelling incident: of actual confusion"); *Molenaar, Inc. v. Happy Toys, Inc.*, 188 U.S.P.Q. (BNA) 469, 471 (T.T.A.B. 1975) (one mistaken order).

39. *W.W.W. Pharmaceutical Co. v. Gillette Co.*, 984 F.2d 567, 574 (2d Cir. 1993) ("[T]he relevant confusion is that which affects 'the purchasing and selling of the goods or services in question.'"); *Lang v. Retirement Living Publishing Co.*, 949 F.2d 576, 583 (2d Cir. 1991) (where court gave little weight to evidence of misdirected telephone calls and affiliation inquiries, stating "no evidence links the confusion evinced by the calls to any potential or actual effects on consumers' purchasing decisions"); *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1207 (1st Cir. 1983) ("There is no evidence whatsoever that anyone ever bought a Beckman analyzer thinking it came from Astra, or that anyone bought Astra products believing that they came from Beckman."); *Telmed Corp. v. Telmed, Inc.*, 588 F.2d 213, 220 (7th Cir. 1978); *Intricate Metal Prods., Inc. v. Schneider*, 324 F.2d 555, 562 (9th Cir. 1963) (finding no likelihood of confusion where "[t]here is no testimony that anyone ever bought the accused mechanism mistaking it for [plaintiff's product]"); *McGraw-Hill Publishing Co. v. American Aviation Assoc., Inc.*, 117 F.2d 293, 295 (D.C. Cir. 1940) ("The plaintiff did not show one instance of a newsstand purchaser receiving the magazine he did not intend to buy"); *Taj Mahal Enters., Ltd. v. Trump*, 745 F. Supp. 240, 250-51 (D.N.J. 1990); *Broadcasting Publications, Inc. v. Burnup & Sims, Inc.*, 582 F. Supp. 309, 318 (S.D. Fla. 1983); *American Greetings Corp. v. Easter Unlimited, Inc.*, 579 F. Supp. 607, 616 (S.D.N.Y. 1983) (where court discounted actual confusion evidence, stating "it is buyer confusion that the Lanham Act addresses."); *Mushroom Makers, Inc. v. R. G. Barry Corp.*, 441 F. Supp. 1220, 1231 (S.D.N.Y. 1977), *aff'd*, 580 F.2d 44 (2d Cir. 1978) (per curiam), *cert. denied*, 439 U.S. 1116 (1979); *Fotomat Corp. v. Photo Drive-Thru, Inc.*, 425 F. Supp. 693, 701 (D.N.J. 1977) (where court found plaintiff's "actual confusion" evidence unconvincing, stating, "these customer affidavits generally fail to indicate that customers have mistakenly made purchases at Photo Drive-Thru thinking it to be Fotomat; in some cases, the confusion was dissipated upon seeing the Photo Drive-Thru name, while in others the confusion was not great enough that the affiants actually made purchases at Photo Drive-Thru."); *Jewel Cos. v. Westhall Co.*, 413 F. Supp. 994, 999 (N.D. Ohio 1976) ("The strongest confusion would have been that which resulted in a customer going to Jewel Mart and making a purchase because the customer thought the store was operated by Jewel Tea. There is no indication at all that such a situation, or one approximating it, developed."), *aff'd*, 575 F.2d 1176 (6th Cir. 1978); *Sears Roebuck and Co. v. Allstate Driving School, Inc.*, 301 F. Supp. 4, 14 (E.D.N.Y. 1969) ("No one testified at the trial that he enrolled at

As one of these courts has stated, "[w]hen considering evidence of actual confusion, the key is whether there actually has been a diversion of customers from plaintiff to defendant."⁴⁰ The courts so highly regard this evidence that very little of it is necessary to establish actual confusion.⁴¹ The great weight given to such evidence is justified for several reasons besides the general difficulty of obtaining this evidence. First, while courts disagree as to whether confusion among non-consumers is relevant, there is no question that confusion among purchasers at the time of the purchase is relevant. Second, unlike other types of actual confusion evidence, a proven mistaken purchase leaves little room for doubt as to whether the person was actually confused. Third, evidence of mistaken purchases usually is introduced through the testimony of the confused purchaser, so that the form of the evidence also leaves little or no room for ambiguity as to its substance.

There are other types of evidence which, while perhaps not so clearly probative of actual confusion as mistaken purchases, are nevertheless sufficiently clear that courts generally credit them as being probative of the existence of actual confusion. This evidence includes such things as complaints made or sent to the plaintiff about the defendant's trademarked product⁴² and requests made to the plaintiff for purchases of or information regarding the defendant's product.⁴³ Likewise, returns of the defendant's products to the plaintiff for repair or refund have been considered cred-

Driving School because he was under the impression that it was operated or sponsored by plaintiff. . . ."); see also *Blue Bell Bio-Medical v. Cin-Bad*, 863 F.2d 1253, 1260 n.9 (5th Cir. 1989); *Sno-Wizard Mfg., Inc. v. Eisemann Prod. Co.*, 791 F.2d 423, 429 n.6 (5th Cir. 1986); *Source Serv. Corp. v. Source Telecomputing Corp.*, 635 F. Supp. 600, 614 (N.D. Ill. 1986).

40. *Taj Mahal Enters., Ltd. v. Trump.*, 745 F. Supp. 240, 249 (D.N.J. 1990).

41. See *supra* note 38 and accompanying text.

42. See, e.g., *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d at 383-84; *Savin Corp. v. National Tower Warehouse, Inc.*, 528 F. Supp. 636, 640-42 (N.D. Ga. 1981); *Midway Mfg. Co. v. Dirkschneider*, 543 F. Supp. 466, 489 (D. Neb. 1981); *Council of Better Business Bureaus, Inc. v. Better Business Bureau, Inc.*, 220 U.S.P.Q. (BNA) 282, 297 (S.D. Fla. 1978).

43. See, e.g., *International Kennel Club, Inc. v. Mighty Star, Inc.*, 846 F.2d at 1090 (7th Cir. 1988); *The Comic Strip, Inc. v. Fox Television Stations, Inc.*, 10 U.S.P.Q.2d (BNA) 1608, 1612 (S.D.N.Y. 1989); *American Ass'n for the Advancement of Science v. Hearst Corp.*; 498 F. Supp. 244, 258-59 (D.D.C. 1980). Cf. *Academy of Motion Picture Arts and Sciences v. Creative House Promotions, Inc.*, 944 F.2d 1446, 1456 (9th Cir. 1991) (telephone calls by members of plaintiff who mistakenly believed that an award marketed by defendant and bestowed on

ible evidence of actual confusion.⁴⁴ Some courts have also treated as probative of actual confusion instances where a plaintiff was sued and/or served with legal complaints where the defendant was actually the party intended to be sued.⁴⁵

Generally, these various types of confusion evidence are considered credible and probative for the same reasons as evidence of mistaken purchases. With each, the "confused" party takes some affirmative action (often to the confused party's detriment or inconvenience) which illustrates his confusion. In other words, if he were not confused, he would not have taken the action he did. As a result, the form or circumstances of these incidents do not lend themselves to much speculation that there is any reason that they occurred other than because of a confusing similarity between the parties' marks. As discussed below, these types of actual confusion evidence do not represent an exhaustive list of evidence which has been found probative of actual and likely confusion; they have been discussed in this section because courts have more uniformly regarded them as credible, probative evidence of actual confusion.

an actors workshop, pictured in a Daily Variety photograph, was actually an Oscar).

44. See, e.g., *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 297 (3d Cir. 1991); *Brunswick Corp. v. Spinit Reel Co.*, 832 F.2d at 521-22; *Harold F. Ritchie, Inc. v. Chesebrough-Pond's, Inc.*, 281 F.2d at 761-62; *Gemveto Jewelry Co. v. Jeff Cooper, Inc.*, 613 F. Supp. 1052, 1063 (S.D.N.Y. 1985); *Savin Corp. v. National Tower Warehouse, Inc.*, 528 F. Supp. 636, 641 (N.D. Ga. 1981); *Dr. Ing. H.C.F. Porsche AG v. Zim*, 481 F. Supp. 1247, 1249 (N.D. Tex. 1979); see also *Harlequin Enters. Ltd. v. Gulf & Western Corp.*, 644 F.2d 946, 949 (2d Cir. 1981) (retailers' return of large numbers of the defendant's books to the plaintiff); *Helene Curtis Indus., Inc. v. Church & Dwight Co.*, 560 F.2d 1325, 1331 (7th Cir. 1977) (retailers sending the defendant's coupons to the plaintiff for redemption), *cert. denied*, 434 U.S. 1070 (1978); *Glamorene Products Corp. v. Boyle-Midway, Inc.*, 188 U.S.P.Q. (BNA) 145, 158-59 (S.D.N.Y. 1975) (retailers sending the defendant's coupons to the plaintiff for redemption); *Jockey Int'l, Inc. v. Burkard*, 185 U.S.P.Q. (BNA) 201, 205 (S.D. Cal 1975) (letter from retailer to the plaintiff requesting reimbursement for advertisement of the defendant's product). *But see Mushroom Makers, Inc. v. R.G. Barry Corp.*, 441 F. Supp. 1220, 1231 (S.D.N.Y. 1977).

45. *Perini Corp. v. Perini Constr., Inc.*, 715 F. Supp. 719, 723 (D. Md. 1989), *rev'd on other grounds*, 915 F.2d 121 (4th Cir. 1990); *Schering Corp. v. Shering A.G.*, 4 U.S.P.Q.2d (BNA) 1596, 1603-04 (D.N.J. 1987); *Santucci Construction Co. v. Carlo V. Santucci, Inc.*, 200 U.S.P.Q. (BNA) 783, 787 (N.D. Ill. 1978).

B. *Misdirected Communications*

Courts have been quite inconsistent in their treatment of misdirected communications as evidence of actual confusion. This category of actual confusion evidence generally refers to correspondence and telephone calls mistakenly directed to one party even though actually intended for receipt by the other party. This judicial variance can be explained in part by the nature of the evidence itself. Often, it is difficult or even impossible to determine the precise reasons the letters or calls were misdirected; that is, often there is no way for the parties or court to confirm that the misdirection resulted from the sender's confusion of the two marks in question. Without any method of verification, a court is essentially forced to read minds in determining whether there was any confusion at all on the part of the senders and whether it was caused by a similarity of the parties' marks.

There may be other reasons for the misdirection aside from confusion of the parties' marks. For example, if a person making a telephone call attempts to get the plaintiff's telephone number from directory assistance and the operator hastily provides him with the phone number of a similarly-named company, the caller has experienced no confusion.⁴⁶ On the other hand, in other circumstances misdirected letters and telephone calls can be persuasive evidence of the existence of actual consumer confusion. For example, it may be difficult to explain away as mere carelessness misdirected letters or phone calls where the trademarks in question do not comprise the parties' business names or mailing addresses. In such instances, the "blame" for the misdirection cannot be placed on a directory assistance operator or the sloppy use of an address directory or telephone book. The trademark must be mistakenly associated with the wrong party in order for misdirections to occur. This faulty connection (or confusion) most likely occurs at least partially in the sender's mind, and not as a result of some extraneous occurrence unrelated to the sender's thought process.

Some courts have found evidence of misdirected mail or phone calls to be probative of actual confusion where such evidence was the primary or only evidence introduced on this issue.⁴⁷ Other

46. See *infra* note 50 and accompanying text.

47. See, e.g., *Armco, Inc. v. Armco Burglar Alarm Co.*, 693 F.2d 1155, 1160 (5th Cir. 1982); *Berkshire Fashions, Inc. v. Sara Lee Corp.*, 725 F. Supp. 790, 797 (S.D.N.Y. 1989) (where two customers had returned plaintiff's defective slippers to defendant and one customer had complained to defendant about plaintiff's

courts have given such evidence weight where the plaintiff also introduced other forms of credible, probative actual confusion evidence.⁴⁸ At least one other court appears to have treated a misdi-

product, the court stated that “[m]isdirected orders and correspondence have been held to evidence actual confusion that is worthy of consideration.”); *Cullman Ventures, Inc. v. Columbian Art Works, Inc.* 717 F. Supp. 96, 130 (S.D.N.Y. 1989) (where there was one misdirected order, court said that “this misdirected order evidences some actual confusion that is worthy of consideration.”); *Yankelovich, Skelly & White, Inc. v. White, Yankelovich, Skelly Consulting Group, Inc.*, 14 U.S.P.Q.2d (BNA) 1384, 1388 (S.D.N.Y. 1989) (misdirection of telex, misdirection of letter to plaintiffs about services performed by defendants, and misdirection of checks received by plaintiffs in payment for services rendered by defendants were “convincing instances of actual confusion.”); *Moore Business Forms, Inc. v. Seidenburg*, 619 F. Supp. 1173, 1184 (W.D. La. 1985) (where two of plaintiff’s long-term customers telephoned defendant in order to make a purchase and where the post office and UPS have confused the parties); *IMS Ltd. v. International Medical Sys., Inc.*, 1 U.S.P.Q.2d (BNA) 1268, 1274-75 (E.D.N.Y. 1986) (one misdirected request for a price quotation and a mistaken phone call to defendant for plaintiff by nurse conducting a study was “persuasive proof of the likelihood of future confusion.”); *Wells Fargo & Co. v. Wells Fargo Constr. Co.*, 619 F. Supp. 710, 712-13 (D. Ariz. 1985) (two telephone calls to plaintiff requesting defendant’s phone number constituted some evidence of actual confusion); *Mustang Motels, Inc. v. Patel*, 226 U.S.P.Q. (BNA) 526, 527 n.1 (C.D. Cal. 1985) (telephone calls to plaintiff requesting reservation and rate information about defendant’s motel); *Sears, Roebuck & Co. v. Sears Fin. Network, Inc.*, 576 F. Supp. 857, 861-62 (D.D.C. 1983) (where defendant conceded that actual confusion had occurred, “citing as an example a telephone operator who gave one of its customers the number of Sears, Roebuck and Co.”); *Quill Corp. v. Quill Printing Corp.*, 215 U.S.P.Q. (BNA) 986, 988-89 (N.D. Ill. 1982) (where defendant had received telephone calls from people who mistakenly believed that they were calling plaintiff); *Purofied Down Products Corp. v. Puro Down Int’l Corp.*, 530 F. Supp. 134, 135 n.2 (E.D.N.Y. 1982) (where a proposed contract for repairs to equipment was sent to the attention of defendant’s president but was mistakenly addressed to plaintiff); *Lambda Elecs. Corp. v. Lambda Technology, Inc.*, 515 F. Supp. 915, 927 (S.D.N.Y. 1981) (where court rejected defendant’s argument that misdirected checks and orders were mere clerical errors, and stated that such evidence was “sufficient to show actual confusion.”); *Citibank, N.A. v. City Bank of San Francisco*, 206 U.S.P.Q. (BNA) 997, 1006, 1009 (N.D. Cal 1980) (where four packages, more than 41 checks and numerous telephone calls intended for defendant have reached plaintiff); *Technicon Co. v. Erickson Tool Co.*, 116 U.S.P.Q. (BNA) 97, 98-99 (Comm’r Pat. & Trademarks 1958) (where opposer had received requests for information regarding defendant’s “Techni-Freezer” refrigerating unit, such evidence, while “by no means conclusive,” was “entitled to consideration as an indication of probable confusion.”).

48. See, e.g., *Country Floors, Inc. v. Gepner*, 930 F.2d 1056, 1064 (3d Cir. 1991); *First Federal Sav. and Loan Ass’n v. First Federal Sav. & Loan Ass’n*, 18 U.S.P.Q.2d (BNA) 1394, 1396 (8th Cir. 1991); *International Kennel Club, Inc. v.*

rected letter as good evidence of actual confusion, but found that the overall amount of actual confusion evidence presented was too small to be significant.⁴⁹

In other cases, however, courts have refused to recognize misdirected communications as credible evidence that actual confusion has occurred between the parties' trademarks. Many of these courts have based their refusal to credit such evidence on their belief, or evidence illustrating, that the so-called confusion was due to confusion or carelessness on the part of a telephone operator or the postal service.⁵⁰ In other cases, courts have blamed the "confusion" on the "mere carelessness" of secretaries or others mistakenly mailing items to the wrong party.⁵¹ Yet other courts have stated, without explanation, that evidence of misdirected

Mighty Star, Inc., 846 F.2d 1079, 1090 (7th Cir. 1988); Safeway Stores, Inc. v. Safeway Discount Drugs, Inc., 675 F.2d 1160, 1167 (11th Cir. 1982) (one misdirected dunning letter); NLC, Inc. v. Lenco Elecs., Inc., 798 F. Supp. 1419, 1426 (E.D. Mo. 1992) (misdirected mail, checks and facsimile transmissions, as well as evidence of a supplier's irritation with the plaintiff for failure to pay a bill belonging to the defendant); Transfer Print Foils, Inc. v. Transfer Print America, Inc., 720 F. Supp. 425, 431, 439 (D. N.J. 1989) (misdirected checks and purchase orders); Perini Corp. v. Perini Constr., Inc., 715 F. Supp. 719, 723 (D. Md. 1989); Santucci Constr. Co. v. Carlo v. Santucci, Inc., 200 U.S.P.Q. (BNA) 786-87 (N.D. Ill. 1978); Armstrong Cork Co. v. Armstrong Plastic Covers Co., 434 F. Supp. 860, 868 (E.D. Mo. 1977) (misdirected telephone calls and complaints misdirected to plaintiff by local better business bureau); Prudential Ins. Co. v. Prudential Title Co., 189 U.S.P.Q. (BNA) 617, 620 (S.D. Tex. 1976) (misdirected mail, personal visitors and telephone calls where the parties had offices in adjacent buildings).

49. AmStar Corp. v. Domino's Pizza, Inc., 615 F.2d 252, 263 n.10 (5th Cir. 1980).

50. E.R. Squibb & Sons, Inc. v. Princeton Pharmaceutical, Inc., 17 U.S.P.Q.2d (BNA) 1447, 1449, 1452-53 (S.D. Fla. 1990); McGraw-Hill, Inc. v. Comstock Partners, Inc., 743 F. Supp. 1029, 1035 (S.D.N.Y. 1990); Inc. Publishing Corp. v. Manhattan Magazine, Inc., 616 F. Supp. 370, 388-89 (S.D.N.Y. 1985); Markel v. Scovill Mfg. Co., 471 F. Supp. 1244, 1252 (W.D.N.Y. 1979); Allstate Ins. Co. v. Allstate Inv. Corp., 210 F. Supp. 25, 29 (W.D. La. 1962), *aff'd*, 328 F.2d 608 (5th Cir. 1964). *See also* Lang v. Retirement Living Publishing Co., 949 F.2d 576, 583 (2d Cir. 1991) (misdirected telephone calls ceased after defendant obtained listing in local phone books, "likely indicating that the confusion resulted from the absence of any listing for [defendant's magazine].").

51. McGraw-Hill, Inc. v. Comstock Partners, Inc., 743 F. Supp. 1029, 1035 (S.D.N.Y. 1990); Mushroom Makers, Inc. v. R.G. Barry Corp., 441 F. Supp. 1220, 1231 (S.D.N.Y. 1977), *aff'd*, 580 F.2d 44, 48 (2d Cir. 1978)(*per curiam*), *cert. denied*, 439 U.S. 1116 (1979); United States Blind Stitch Machine Corp. v. Union Special Machine Co., 287 F. Supp. 468, 471 (S.D.N.Y. 1968); Polaroid Corp. v. Polarad Elecs. Corp., 182 F. Supp. 350, 354 (E.D.N.Y. 1960), *aff'd on other grounds*, 287 F.2d 492 (2d Cir. 1961).

correspondence is weak evidence of actual confusion and, standing alone, is insufficient to establish this factor in the plaintiff's favor.⁵² In most of these decisions, it appears from the opinions that the plaintiffs failed to explain the exact nature of the misdirected correspondence or, if an explanation was given, it was unsatisfactory in terms of showing actual confusion on the part of the sender.

It is extremely difficult, if not impossible, to summarize and assess neatly the value of misdirected communications in view of the varying weight courts have afforded such evidence. There are three main reasons for this. First, courts have varied as to their definitions of misdirected communications.⁵³ Second, many courts have credited or discredited such evidence without delineating in their opinions the specific nature of the misdirected mail or telephone calls in question.⁵⁴ Third, as with most evidentiary issues, it is difficult to categorize this evidence, for it is important to analyze its probativeness and credibility within its specific factual context.

Given variations in the treatment of misdirected correspondence, can the various court holdings be synthesized? To a certain extent, they can. If a plaintiff has obtained evidence of misdirected communications, he should do everything possible to prove to the court's satisfaction that the misdirection resulted from confusion or mistake on the part of some consumer/sender instead of the postal service or a telephone operator. A plaintiff able to do so

52. *Nutri/System, Inc. v. Con-Stan Indus., Inc.*, 809 F.2d 601, 606 (9th Cir. 1987) ("the instances of confusion, at best, were thin, and at worst, were trivial."); *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d at 489-90 (1st Cir. 1981); *Alpha Indus., Inc. v. Alpha Steel Tube & Shapes, Inc.*, 616 F.2d 440, 445 (9th Cir. 1980); *Everest & Jennings, Inc. v. E & J Mfg. Co.*, 263 F.2d 254, 260 (9th Cir. 1958); *Nikon, Inc. v. Ikon Corp.*, 803 F. Supp. 910, 921 (S.D.N.Y. 1992) ("Isolated instances of misdirected mail are inconsequential."); *American Int'l Group, Inc. v. American Int'l Airways, Inc.*, 14 U.S.P.Q.2d (BNA) 1933, 1936 (E.D. Pa. 1989); *B.D. Communications, Inc. v. Dial Media, Inc.*, 429 F. Supp. 1011, 1014 n.6 (S.D.N.Y. 1977); *T.G.I. Friday's, Inc. v. International Restaurant Group, Inc.*, 405 F. Supp. 698, 707 (M.D. La. 1975). Court decisions discussing the insufficiency of such evidence in terms of the amount necessary to show actual confusion are discussed *infra* at notes 116 to 126 and accompanying text.

53. See *supra* notes 48-52 and accompanying text and *infra* notes 55-57 and accompanying text.

54. See, e.g., *Perini Corp. v. Perini Constr., Inc.*, 715 F. Supp. 719, 723 (D. Md. 1989), *rev'd on other grounds*, 915 F.2d 121 (4th Cir. 1990).

leaves less room for doubt or for a court's unfavorable assumption as to who, if anyone, was actually confused.

The decisions bear out that such an explanation is important to ensure that a court credits such evidence. With only a few exceptions,⁵⁵ in the cases in which courts have credited misdirected communications as probative of actual confusion,⁵⁶ it was clear that the misdirection resulted from some confusion on the part of the sender and not someone else. In contrast, those courts refusing to give much weight to misdirected communications appear to have done so because either (1) the evidence demonstrated that the misdirection was caused by something other than confusion on the part of the consumer/sender or (2) there was either no evidence or inadequate evidence that the misdirection was caused by a confused consumer/sender.

A good example of the costly consequences of a failure to provide such an explanation is found in *Mushroom Makers, Inc. v. R. G. Barry Corp.*⁵⁷ There, the plaintiff sought a declaratory judgment that its use of the mark "mushroom" for its casual footwear did not infringe the defendant's "mushroom" trademark used in connection with its misses sportswear. The defendant counter-claimed for trademark infringement. In an attempt to prove actual confusion, the defendant introduced "over a dozen instances of misdirected invoices, checks, [and] return slips from retail stores. . . ."⁵⁸ In finding the evidence to be of limited probative value, the district court specifically noted the defendant's failure to explain the cause of the misdirections:

These instances indicate some kind of confusion on the part of employees of the retailers, but the testimony of the persons was not obtained and no explanation was offered for the errors. In some instances it is obvious they were the result of carelessness or inefficiency on the part of employees of the retailers.⁵⁹

55. *Moore Business Forms, Inc. v. Seidenburg*, 619 F. Supp. 1173, 1184 (W.D. La. 1985); *Sears, Roebuck and Co. v. Sears Fin. Network, Inc.*, 576 F. Supp. 857, 861-62 (D.D.C. 1983); *Citibank, N.A. v. City Bank of San Francisco*, 206 U.S.P.Q. (BNA) 997, 1006, 1009 (N.D. Cal. 1980); *Prudential Ins. Co. v. Prudential Title Co.*, 189 U.S.P.Q. (BNA) 617, 619-20 (S.D. Tex. 1976).

56. See *supra* notes 47-49 and accompanying text.

57. 441 F. Supp. 1220 (S.D.N.Y. 1977), *aff'd*, 580 F.2d 44 (2d Cir. 1978) (per curiam), *cert. denied*, 439 U.S. 1116 (1979).

58. 441 F. Supp. at 1231.

59. *Id.*

The district court found that while the misdirections "may have some probative value, they are far from compelling,"⁶⁰ and held that confusion was unlikely.

On appeal, the defendant asserted, *inter alia*, that the trial court's treatment of the misdirected communications was clearly erroneous. The Second Circuit Court of Appeals affirmed the district court's holding and rejected the plaintiff's argument:

the district court quite properly noted that not a single instance of consumer confusion was actually demonstrated in the trial record. There was some evidence of clerical errors and joint advertising involving the two companies' products, but in the absence of any testimony to explain these events, the court was clearly entitled to find that they did not demonstrate actual confusion among retail customers. In any event, the instances cited by Barry are clearly *de minimis* in light of the sales histories of the parties.⁶¹

As the *Mushroom Makers* case illustrates, a trademark infringement plaintiff's failure to explain that the sender's confusion of the parties' marks caused the misdirections can be extremely costly and may render the evidence of little value.

Undoubtedly, it will be impossible always to show that misdirections were caused by sender confusion and not by some other reason. The best example of this inability is the misdirected telephone call, where there generally is no way for a plaintiff to obtain the reason for the misdirection unless that caller is asked why he called the plaintiff at the time of the call.⁶² Even if the plaintiff's employees have the presence of mind to ask this question, and even if the caller answers it truthfully, a defendant may raise objections to the introduction of such evidence if the caller himself is not produced.⁶³ Nevertheless, a plaintiff should make every effort to offer a factual explanation to the court that the misdirected communications resulted from the caller's/sender's confusion of the two marks involved.

There also may be certain instances where a plaintiff may hesitate to question senders of misdirected communications because he fears that the explanation will be unfavorable to his

60. *Id.*

61. *Mushroom Makers*, 580 F.2d at 48.

62. In contrast to telephone calls, most misdirected mailings will contain at least a return address, if not the name of the individual sender, so that either party willing to do so can at least attempt to verify the precise cause of the misdirection.

63. Admissibility and other evidentiary concerns are discussed *infra* at notes 132-36 and accompanying text.

case. In such instances, a plaintiff may decide that he is better off not offering any explanation, because to do so would make clear that confusion of the marks did not cause the misdirection. Such a plaintiff should be well aware of the risk that he is taking, for, as discussed above, some courts will treat equally unfavorably unexplained misdirections and misdirections caused by someone other than the consumer/sender.

Some courts also have considered whether "misspellings" constitute probative evidence of actual confusion. In a few cases, plaintiffs have tried to show the existence of actual confusion between two similar trademarks by showing that people will spell the defendant's mark when referring to the plaintiff's mark, or vice versa. One such case is *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*⁶⁴ There, the plaintiff alleged that the defendant's use of the mark "Alpha" on a series of cameras infringed its trademark "Alpa" used on a camera. In support of its case, the plaintiff introduced several registration cards and a letter wherein the "Alpa" product was referred to as "Alpha." The plaintiff also introduced other evidence where its "Alpa" camera was referred to as "Alpha." The First Circuit Court of Appeals rejected all of this evidence as being mere misspellings of the plaintiff's trademark, noting that such misspellings occurred both before and after the defendant started using its "Alpha" mark:

Beyond demonstrating what is obvious - that "Alpa" is "Alpha" minus an "h" - this evidence demonstrates only that for over 20 years Pignons' trademark has been subject to misspelling. There is nothing in the cards or letters to suggest confusion of products or businesses. Pignons also cites misspellings of its trademark in advertisements, catalogs, magazines and newspapers, but again these evince not product confusion but, at most, that the two words are very close (or, at least, that some people spell badly).⁶⁵

The *Pignons* decision illustrates yet again the potentially fatal nature of the plaintiff's failure to satisfy the court that the proffered evidence was the result of confusion between the parties' trademarks. At least one court has followed *Pignons* in holding that the alleged instances of actual confusion between the parties' marks were mere misspellings.⁶⁶

64. 657 F.2d 482 (1st Cir. 1981).

65. *Id.* at 489.

66. *Greentree Labs., Inc. v. G. G. Bean, Inc.*, 718 F. Supp. 998, 1002 (D. Me. 1989) (where plaintiff received some letters requesting ODOR KLEEN or ODORKLEEN (the defendant's mark), rather than ODOKLEEN, the plaintiff's

C. *Inquiries as to Affiliation or Relationship*

Courts also have varied in their treatment of evidence of inquiries made to one of the parties regarding whether or not it is affiliated with, related to or sponsored by the other party.⁶⁷ When discussing inquiries as evidence of actual confusion, it is important to distinguish affiliation inquiries from consumer inquiries regarding one party's product or service which are misdirected to the other based upon the mistaken impression that that product or service emanates from that party. This latter type of inquiry is generally regarded as credible, probative evidence of actual confusion.⁶⁸ This section discusses the value assigned by courts to the former type of inquiry. Usually, such inquiries take the form of a consumer or someone else asking, "Say, Federal Bank, are you the same company as, or related to, Federal Finance?"

Many courts have found such affiliation inquiries to be probative of the existence of actual confusion.⁶⁹ Unfortunately, most

mark). *But see* Dr. Ing. h.c.F. Porsche AG v. Zim, 481 F. Supp. 1247, 1249 (N.D. Tex. 1979) (where court appeared to give some credit to misspellings as evidence of actual confusion: "[The defendant] testified that he had had 'problems with people' about the spelling of his company's name. This problem has carried over to Por-sha's suppliers, who spell Por-sha's name in at least 16 different ways, many of which are direct variations of plaintiff's name.").

67. Confusion as to affiliation, relationship, sponsorship or approval is actionable under federal trademark law. *See generally* Allen, *supra* note 37, at 214-16.

68. *See, e.g.*, Harlequin Enters. Ltd. v. Gulf & Western Corp., 644 F.2d 946, 949 (2d Cir. 1981); Transfer Print Foils, Inc. v. Transfer Print America, Inc., 720 F. Supp. 425, 431 (D.N.J. 1989); Schering Corp. v. Schering A.G., 4 U.S.P.Q.2d (BNA) 1596, 1603 (D.N.J. 1987).

69. Country Floors, Inc. v. Gepner, 930 F.2d 1056 (3d Cir. 1991); International Kennel Club v. Mighty Star, Inc., 846 F.2d 1079, 1090 (7th Cir. 1988); Fuddrucker, Inc. v. Doc's B.R. Others, Inc., 826 F.2d 837, 845 (9th Cir. 1987); Jellibeans, Inc. v. Skating Clubs, Inc., 716 F.2d 833, 844 (11th Cir. 1983), *affg* 212 U.S.P.Q. (BNA) 170, 177 (N.D. Ga. 1981); Fuji Photo Film Co. v. Shinohara Shoji Kabushiki Kaisha, 754 F.2d 591, 593 (5th Cir. 1985); Armco, Inc. v. Armco Burglar Alarm Co., 693 F.2d 1155, 1160 (5th Cir. 1982); Donsco, Inc. v. Casper Corp., 587 F.2d 602, 605 (3d Cir. 1978); Breakers of Palm Beach, Inc. v. International Beach Hotel Development, Inc., 824 F. Supp. 1576, 1580-81, 1586 (S.D. Fla. 1993); Multi-Local Media Corp. v. 800 Yellow Book Inc., 813 F. Supp. 199, 204-05 (E.D.N.Y. 1993); National Rural Elec. Coop. Ass'n v. National Agricultural Chem. Ass'n, 26 U.S.P.Q.2d (BNA) 1294 (D.D.C. 1992); Olay Co. v. Cococare Prods., Inc., 218 U.S.P.Q. (BNA) 1028, 1040 (S.D.N.Y. 1983); Steinway & Sons v. Robert DeMars & Friends, 210 U.S.P.Q. (BNA) 954, 966 (C.D. Cal. 1981); Playboy Enters., Inc. v. Chuckleberry Publishing, Inc., 486 F. Supp. 414, 427 and n. 19 (S.D.N.Y. 1980); Polo Fashions, Inc. v. Extra Special Prods., Inc.,

courts have credited such evidence without explanation. However, the rationale for crediting such evidence is understandable. If, based upon a similarity between the parties' trademarks, individuals ask one party whether it is affiliated with or related to the other party, these individuals are at least sufficiently confused to believe that some relationship between the parties may exist. That is, if they go to the trouble of asking whether the parties are related or affiliated, there must be at least some doubt in their mind that the parties are separate entities.

Other courts have given little or no weight to affiliation inquiries as evidence of actual confusion. While some of these courts have rejected such evidence without explanation,⁷⁰ many have stated that affiliation inquiries not only do little to prove actual confusion, but they in fact illustrate that the inquirers are not confused.⁷¹ As one of these courts has stated, "[f]ar from revealing such confusion, [the inquiries and other] statements indicate that these customers, at least, had the difference in source clearly in mind."⁷² Other courts have cited the plaintiff's failure to prove that confusion between the parties' marks caused the inquiries in giving little weight to such evidence.⁷³

451 F. Supp. 555, 561 (S.D.N.Y. 1978); *Armstrong Cork Co. v. Armstrong Plastic Covers Co.*, 434 F. Supp. 860, 868, 871 (E.D. Mo. 1977); *Kroger Co. v. Superx, Inc.*, 193 U.S.P.Q. (BNA) 245, 247 (E.D. Pa. 1976); *John Wright, Inc. v. Casper Corp.*, 419 F. Supp. 292, 321-22 (E.D. Pa. 1976); *Prudential Ins. Co. of Amer. v. Prudential Title Co.*, 189 U.S.P.Q. (BNA) 617, 619-20 (S.D. Tex. 1976); *First Int'l Services Corp. v. Chuckles, Inc.*, 5 U.S.P.Q.2d (BNA) 1628, 1634 (T.T.A.B. 1988).

70. *See, e.g.*, *Elizabeth Taylor Cosmetics Co. v. Annick Goutal, S.A.R.L.*, 673 F. Supp. 1238, 1246 (S.D.N.Y. 1987); *Electronic Water Conditioners, Inc. v. Turbomag Corp.*, 221 U.S.P.Q. (BNA) 162, 164 (T.T.A.B. 1984); *Toys "R" Us, Inc. v. Lamps R Us*, 219 U.S.P.Q. (BNA) 340, 346 (T.T.A.B. 1983).

71. *See, e.g.*, *Miss World (UK) Ltd. v. Miss America Pageants, Inc.*, 856 F.2d 1445, 1451 (9th Cir. 1988); *Jordache Enters., Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482, 1487 (10th Cir. 1987); *Fisher Stoves, Inc. v. All Nighter Stove Works, Inc.*, 626 F.2d 193, 195 (1st Cir. 1980); *Gruner + Jahr USA Publishing v. Meredith Corp.*, 793 F. Supp. 1222, 1232 (S.D.N.Y. 1992); *Taj Mahal Enters., Ltd. v. Trump*, 745 F. Supp. 240, 250-51 (D.N.J. 1990); *Pump, Inc. v. Collins Management, Inc.*, 746 F. Supp. 1159, 1169 (D. Mass. 1990); *Inc. Publishing Corp. v. Manhattan Magazine, Inc.*, 616 F. Supp. 370, 389 (S.D.N.Y. 1985); *Programmed Tax Sys., Inc. v. Raytheon Co.*, 439 F. Supp. 1128, 1130-32 (S.D.N.Y. 1977).

72. *Fisher Stoves, Inc. v. All Nighter Stove Works*, 626 F.2d 193, 195 (1st Cir. 1980).

73. *See, e.g.*, *Inc. Publishing Co. v. Manhattan Magazine, Inc.*, 616 F. Supp. 370, 389 (S.D.N.Y. 1985); *Toys "R" Us, Inc. v. Lamps R Us*, 219 U.S.P.Q. (BNA) 340, 346 (T.T.A.B. 1983); *Transamerica Financial Corp. v. Trans-American*

Professor McCarthy has recommended an apparent middle ground with respect to the weight given to affiliation inquiries: "The better view would seem to be that while inquiry evidence is admissible and relevant, standing alone with no other evidence it is insufficient proof of actual confusion. Such enquiries alone reveal a less than totally 'confused' state of mind of the enquiring persons."⁷⁴ Some of the courts giving no weight to affiliation inquiries have relied on this language,⁷⁵ and one has quoted it but gone beyond Professor McCarthy's "better view," stating, "[w]e hold that even when combined with other evidence inquiries to the plaintiff about the source of a product are of comparatively little value."⁷⁶

Is Professor McCarthy's the better view? In some instances yes, and in some instances no. While it may be true that in some cases the affiliation inquiries illustrate a less than "totally" confused state of mind, they nevertheless illustrate a degree of confusion sufficiently serious to cause the inquirers to ask whether the parties or their branded products or services are somehow related. Moreover, this view and the view taken by those courts rejecting such evidence are apparently based upon the premise that all instances of confusion which have occurred have been introduced into evidence, and no other "confused" individuals exist. For example, in *Pump, Inc. v. Collins Management, Inc.*,⁷⁷ the court rejected four affiliation inquiries as revealing a less than totally confused states of mind and further stated, "[c]rucially, [plaintiff's president] himself alleviated any confusion by informing [the inquirers] that there was no connection between the bands."⁷⁸ While the author does not quarrel with the court's holding in that

Collections, Inc., 197 U.S.P.Q. (BNA) 43, 52 (T.T.A.B. 1977); see also *Chicago Corp. v. North American Chicago Corp.*, 20 U.S.P.Q.2d (BNA) 1715, 1717 (T.T.A.B. 1991) (where the Board found inquiries tended to show actual confusion, but found that opposer had failed to show the reason for the inquiries and that other factors supported finding that confusion was likely independent of the inquiry evidence).

74. 2 McCARTHY, *supra* note 11, § 23.02[2][d] at 23-32 and 33 (footnote omitted).

75. *Taj Mahal Enters., Ltd. v. Trump*, 745 F. Supp. 240, 251 (D.N.J. 1990); *Pump, Inc. v. Collins Management, Inc.*, 746 F. Supp. 1159, 1169 (D. Mass. 1990).

76. *Jordache Enters., Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482, 1487 (10th Cir. 1987).

77. 746 F. Supp. 1159 (D. Mass. 1990).

78. *Id.* at 1169.

case,⁷⁹ the above-quoted language illustrates the court's presupposition that all confused individuals have confronted the plaintiff and that all instances of confusion which have occurred have been reported to the plaintiff and have been "cleared up." Such an assumption is improper, and a court must be sure to distinguish between instances of actual confusion and *reported* instances of actual confusion; the latter generally being a mere subset of the former.⁸⁰ Indeed, in some instances it may be proper for a court to infer that if several individuals have inquired about a possible affiliation between the parties or their products based upon a confusing similarity between their marks, several more individuals would not bother to inquire but rather would mistakenly assume, without question, that such a relationship does in fact exist.⁸¹

The "better view" also fails to take into account the number of individuals who have made affiliation inquiries. That is, under that view, it apparently does not matter whether there have been one or one thousand affiliation inquiries; if this is the only type of actual confusion evidence adduced, it is insufficient to show actual confusion. Such a rule is too rigid for courts to adopt, for if there has been a large number of well-documented affiliation inquiries made, and it is clear that the inquiries were made because of the similarity between the parties' trademarks, this may very well constitute compelling evidence that actual confusion has occurred and is likely to continue.⁸²

79. The other grounds stated by the court for rejecting this evidence — such as that each inquirer was a friend or acquaintance of the plaintiff's president or otherwise affiliated with plaintiff's band — appear to be sufficient to find that this evidence is not incredibly probative of actual confusion. *See id.* at 1170.

80. Courts generally recognize the difficulty of obtaining evidence of actual confusion. *See supra* note 4 and accompanying text. This difficulty should not be ignored when evaluating the types and amount of actual confusion evidence introduced by the plaintiff. *See also* *Forum Corp. of North America v. Forum, Ltd.*, 903 F.2d 434, 443 (7th Cir. 1990) ("it does not seem reasonable to classify appellant's [actual confusion] evidence . . . as de minimis, since it was not based on a full survey of customers. In other words, this is not a case in which we could conclude that there was a statistically insignificant percentage of confusion, since the actual percentage is unknown.")

81. *See, e.g., Tiffany & Co. v. Classic Motor Carriages Inc.*, 10 U.S.P.Q.2d (BNA) 1835, 1843 (T.T.A.B. 1989) (where the Trademark Trial and Appeal Board justified the absence of actual confusion on the basis that "consumers might not make inquiry because they simply assume a connection with opposer.").

82. *See Fuddruckers, Inc. v. Doc's B.R. Others, Inc.*, 826 F.2d 837, 845 (9th Cir. 1975).

On the other hand, a court should not always necessarily conclude that a few affiliation inquiries prove that actual confusion exists, for such evidence clearly is not the strongest type of actual confusion evidence. For example, unlike with a mistaken purchase, an inquirer does not necessarily take any action to his detriment or inconvenience in inquiring of the parties' relationship. He may simply be curious, and the opportunity to ask one of the parties may be readily at hand.⁸³ A court should analyze the number of inquiries and the specific factual context in which they arose.⁸⁴ For example, the evidence on this point should establish that the inquiries resulted from the similarity of the parties' trademarks or, at the least, that there is no other logical reason for individuals to so inquire as to a possible relationship between the parties. If this is shown, and if there is a significant number of "quality" inquiries, this evidence should be of value to the plaintiff on the actual confusion issue.

There are other decisions which concern "actual confusion" evidence somewhat analogous to affiliation inquiry evidence, and therefore merit discussion. In some of these cases, the plaintiffs introduced testimony of individuals who believed, assumed or "just wondered" if, the parties were the same or related, or their products emanated from the same source. Some courts apparently have found such evidence to be probative of actual confusion,⁸⁵ while others have given it little or no weight.⁸⁶ In other instances some courts have found that the testimony of individu-

83. *But see* *Jellibeans, Inc. v. Skating Clubs, Inc.*, 716 F.2d 833, 844 (11th Cir. 1983) ("the reports of confusion that do exist [three affiliation "inquiries" by friends of plaintiff asking whether or stating that plaintiff opened up a new skating rink] appear genuine, given that the three witnesses independently and on their own initiative contacted [plaintiff's president] to inquire about the new rink. Thus, this testimony alone might be sufficient to support a finding of actual confusion.").

84. These concerns are discussed as they apply to all types of actual confusion evidence *infra* at notes 115-25 and accompanying text.

85. *Marathon Mfg. Co. v. Enerlite Prods. Corp.*, 767 F.2d 214, 220 (5th Cir. 1985); *Earth Technology Corp. v. Environmental Research & Technology, Inc.*, 222 U.S.P.Q. (BNA) 585, 589 (C.D. Cal. 1983); *Wuv's Int'l, Inc. v. Love's Enters., Inc.*, 208 U.S.P.Q. (BNA) 736, 752-53 (D. Colo. 1980); *Markel v. Scovill Mfg. Co.*, 471 F. Supp. 1244, 1251 (W.D.N.Y. 1979); *Jockey Int'l, Inc. v. Burkard*, 185 U.S.P.Q. (BNA) 201, 205 (S.D. Cal. 1975).

86. *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 490 (1st Cir. 1981); *Bridges in Organization, Inc. v. Bureau of National Affairs, Inc.*, 19 U.S.P.Q.2d (BNA) 1827, 1836 (D. Md. 1991); *Hutchinson v. Essence Communications, Inc.*, 769 F. Supp. 541, 555-56 (S.D.N.Y. 1991); *Broadcasting*

als who stated they were initially confused between the parties' marks is of some value on the issue of actual confusion.⁸⁷ While these courts have given it some weight, such evidence should be scrutinized carefully to determine whether the initial confusion actually was confusion, or whether it really was an instance where the defendant's mark merely called the plaintiff or his mark to mind. In other words, such initial confusion evidence should illustrate more than trivial, momentary and passing thoughts.

D. *Whose Confusion Is Relevant*

Another question which courts have addressed in a variety of ways is whose actual confusion is relevant to the likelihood of confusion inquiry. Courts have uniformly credited evidence of mistaken purchases. Likewise, courts have not discredited other evidence of actual confusion on the part of purchasers and other ultimate consumers except for reasons other than the identity of such individuals. Beyond that, however, is where the variance lies. For example, some courts have stated that evidence on the part of those other than purchasers or consumers is of little or no value.⁸⁸ On the other hand, the Fifth Circuit Court of Appeals has stated that "[i]n no case have we sanctioned total disregard of evi-

Publications, Inc. v. Burnup & Sims, Inc., 582 F. Supp. 309, 319 (S.D. Fla. 1983); Jewel Cos. v. Westhall Co., 413 F. Supp. 994, 999 (N.D. Ohio 1976).

87. Transfer Print Foils, Inc. v. Transfer Print America, Inc., 720 F. Supp. 425, 430-31 (D. N.J. 1989); Central Benefits Mutual Ins. Co. v. Blue Cross and Blue Shield Ass'n, 11 U.S.P.Q.2d (BNA) 1103, 1108-10 (S.D. Ohio 1989); First Int'l Servs. Corp. v. Chuckles, Inc., 5 U.S.P.Q.2d (BNA) 1628, 1634 (T.T.A.B. 1988); see also Anheuser-Busch, Inc. v. L & L Wings, Inc., 962 F.2d 316, 325 (4th Cir. 1992) (Powell, J., dissenting) (where Justice Powell considered testimony of one of the defendants' wholesale purchasers that his "initial reaction" to the defendants' design was that "it was a copy" of the plaintiff's shirt to be "substantial evidence of likely confusion."). But see Safeway Stores, Inc. v. Safeway Discount Drugs, Inc., 675 F.2d 1160, 1167 (11th Cir. 1982) ("Short lived confusion or confusion of individuals casually acquainted with a business is worthy of little weight. . ."); Homeowners Group, Inc. v. Home Mktg. Specialists, Inc., 931 F.2d 1100, 1109-10 (6th Cir. 1991).

88. See, e.g., Bridges in Organizations, Inc. v. Bureau of National Affairs, Inc., 19 U.S.P.Q.2d (BNA) 1827, 1836 (D. Md. 1991); American Cyanamid Co. v. S. C. Johnson & Son, Inc., 13 U.S.P.Q.2d (BNA) 1032, 1043-45 (D.N.J. 1989); Inc. Publishing Corp. v. Manhattan Magazine, Inc., 616 F. Supp. 370, 389 (S.D.N.Y. 1985); see also *supra* note 36 and cases cited therein.

dence of actual confusion; there is simply no precedent for such a view, regardless of the identity of the person confused."⁸⁹

Courts have considered the probativeness of evidence of actual confusion on the part of retailers and distributors, competitors and other members of the trade of which the parties are members, suppliers, friends and acquaintances of the parties, and advertising media as well as others, often with varying results. Courts have been consistent, however, in finding that confusion on the part of the alleged infringer or its employees as to the parties' trademarks is probative of actual confusion.⁹⁰ One such court referred to the inability of the defendant's president to distinguish between the parties' trade dresses as "probably the best indirect proof of actual confusion [His] inability to distinguish between the two lamps portends the consumers' inability to do the same."⁹¹

1. *Retailers and Distributors*

Most courts addressing the issue have found that confusion on the part of distributors, such as retailers, of the parties' trademarked products or their employees is probative evidence of actual confusion.⁹² Some of these courts have found such evidence

89. *Fuji Photo Film Co. v. Shinohara Shoji Kabushiki Kaisha*, 754 F.2d 591, 597 (5th Cir. 1985).

90. *PAF S.r.l. v. Lisa Lighting Co.*, 712 F. Supp. 394, 409 (S.D.N.Y. 1989); *Marshak v. Sheppard*, 3 U.S.P.Q.2d (BNA) 1829, 1838 (S.D.N.Y. 1987); *Armstrong Cork Co. v. Armstrong Plastic Covers Co.*, 434 F. Supp. 860, 868 (E.D. Mo. 1977); *Stix Products, Inc. v. United Merchants & Mfrs., Inc.*, 295 F. Supp. 479, 495 (S.D.N.Y. 1968).

91. *PAF S.r.l. v. Lisa Lighting Co.*, 712 F. Supp. at 409.

92. *Americana Trading, Inc. v. Russ Berrie & Co.*, 966 F.2d 1284, 1289 (9th Cir. 1992); *Marathon Mfg. Co. v. Enerlite Prods. Corp.*, 767 F.2d 214, 221 (5th Cir. 1985); *Sicilia Di R Biebow & Co. v. Cox*, 732 F.2d 417, 433 n.11 (5th Cir. 1984); *Harlequin Enters. Ltd. v. Gulf & Western Corp.*, 644 F.2d 946, 949 (2d Cir. 1981); *Donsco, Inc. v. Casper Corp.*, 587 F.2d at 605 (3d Cir. 1978); *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 384; *World Carpets, Inc. v. Dick Littrell's New World Carpets*, 438 F.2d 482, 489 (5th Cir. 1971); *Interstate Battery System of America, Inc. v. Wright*, 811 F. Supp. 237, 243 (N.D. Tex. 1993); *Veryfine Prods, Inc. v. Colon Brothers, Inc.*, 799 F. Supp. 240, 253 (D.P.R. 1992); *White Swan Ltd. v. Clyde Robin Seed Co.*, 12 U.S.P.Q.2d (BNA) 1985, 1989 (N.D. Cal. 1989); *Gemveto Jewelry Co. v. Jeff Cooper, Inc.*, 613 F. Supp. 1052, 1063 (S.D.N.Y. 1985); *Steinway & Sons v. Robert Demars & Friends*, 210 U.S.P.Q. (BNA) 954, 966 (C.D. Cal. 1981); *Waples-Platter Cos. v. General Foods Corp.* 439 F. Supp. 551, 582 (N.D. Tex. 1977); *Glamorene Prods Corp. v. Boyle-Midway, Inc.*, 188 U.S.P.Q. (BNA) 145, 158-59 (S.D.N.Y. 1975); *Jockey Int'l, Inc. v. Burkard*, 185 U.S.P.Q. (BNA) 201, 205 (S.D. Cal. 1975); *Telechron, Inc. v.*

to be "indirect" evidence of actual confusion because it is not evidence of confusion on the part of the purchasing public.⁹³ However, such generally is not the case. While such evidence does not illustrate actual *retail* consumer confusion, retailers and distributors, and certain of their employees, are nonetheless consumers of the parties' trademarked products. Moreover, as at least three courts have noted, if professional buyers such as retailers are actually confused by the parties' trademarks, it follows that less knowledgeable and discriminating retail consumers are likely to be confused.⁹⁴

The Seventh Circuit's treatment of evidence of sales clerk confusion in *Union Carbide Corp. v. Ever-Ready Inc.*,⁹⁵ illustrates how courts could, and perhaps should, treat such evidence. In *Ever-Ready*, in support of the existence of actual confusion the plaintiff had introduced evidence, inter alia, that when plaintiff's counsel's secretary sought to purchase EVER-READY bulbs at a store, the sales clerk showed her the defendant's bulbs and assured her that they were made by Union Carbide. The trial court discounted this evidence, stating that "it is impossible to distinguish between [the sales clerk's] alleged confusion and her desire to make a sale."⁹⁶ The trial court also found suspect "actual confusion" evidence that is manufactured by the plaintiff.⁹⁷

The Seventh Circuit disagreed with the district court, and found that this evidence was probative of confusion irrespective of whether the sales clerk in fact knew that the bulbs in question were not made by Union Carbide:

Although we have great difficulty conceiving that a clerk's anxiety to make this small-dollar sale would prompt a deliberate and knowledgeable misrepresentation, if we assume that the clerk was not confused, the evidence is nevertheless relevant because it is unfair competition for a person to put a product into a dealer's hands which a producer can reasonably anticipate may be easily

Telicon Corp., 97 F. Supp. 131, 143 (D. Del. 1951), *aff'd*, 198 F.2d 903 (3d Cir. 1952).

93. See, e.g., *Ferrara v. Scharf*, 466 F. Supp. 125, 134 (S.D.N.Y. 1979); *Polo Fashions, Inc. v. Extra Special Prods., Inc.*, 451 F. Supp. 555, 561 (S.D.N.Y. 1978).

94. *Interstate Battery System of America, Inc. v. Wright*, 811 F. Supp. at 243; *White Swan Ltd. v. Clyde Robin Seed Co.*, 12 U.S.P.Q. (BNA) at 1989; *Jockey Int'l, Inc. v. Burkard*, 185 U.S.P.Q. (BNA) at 205.

95. 531 F.2d 366 (7th Cir. 1976).

96. 392 F. Supp. 280, 291 (N.D. Ill. 1975).

97. *Id.*

passed off as the goods of another. Assuming the clerk was confused, this gives rise to an inference that purchasers would also be confused because salespersons are more likely than customers to be familiar with various marks on the merchandise they sell and hence are less likely to be confused.⁹⁸

While this evidence was somewhat manufactured, the Seventh Circuit nevertheless recognized its significance.

Not all courts have found sales clerk confusion to be relevant to the issue of infringement. In contrast to the *Ever-Ready* decision and the other decisions cited in this section is *Olay Co. v. Coco Care Products, Inc.*⁹⁹ There, the plaintiff, which manufactured OIL OF OLAY skin care products, sought to have a court enjoin the defendant's use of the term OILS & ALOE in connection with its skin care products. In trying to show actual confusion, the plaintiff introduced the testimony of its representatives and of drug store employees that drug store personnel mistakenly believed that OILS & ALOE was a new product offered by the plaintiff. Though the court found infringement, it gave this evidence little weight:

This evidence of confusion is not particularly significant because it is confusion on the part of the buying public that is important. A product is viewed differently by a purchaser with money in hand than it is by a store employee. Indeed, it is difficult to give greater credibility to such evidence than can be obtained by a simple comparison of the products' packages.¹⁰⁰

The *Olay* court's finding concerning this evidence is contrary to the weight of authority and ignores the reasons such evidence is entitled to at least some weight. First, to the extent that retail employees are wholesale purchasers (on behalf of their employers), they are direct consumers. Second, even if they are not, they are nevertheless members, albeit presumably more sophisticated, of the class of consumers for the products they sell. Third, as the *Ever-Ready* court pointed out, the fact that such knowledgeable, brand-educated retail employees are confused supports an inference that less sophisticated ordinary consumers will likewise be confused. In fact, one court has asserted that,

Confusion among clerks is in itself enough to establish infringement because it is certain that if clerks who sell a product are con-

98. *Union Carbide*, 531 F.2d at 384 (citations omitted).

99. 218 U.S.P.Q. (BNA) 1028 (S.D.N.Y. 1983).

100. *Id.* at 1039 (citations omitted).

fused to the point of selling one article for another such is evidence of the probability of confusion by customers.¹⁰¹

2. Suppliers, Competitors and Members of the Trade

Based upon the third reason stated in the preceding paragraph, most courts have found evidence of actual confusion on the part of the parties' competitors or other members of the parties' trade or industry to be relevant and probative, though indirect, evidence of actual confusion.¹⁰² At least one court, however, has rejected such evidence on the ground that the mistaken impressions of such individuals — in that case a fashion professional — “cannot reasonably be said to reflect that of the average consumer.”¹⁰³ Confusion on the part of suppliers of goods or services to the parties may be probative indirect evidence of actual confusion.¹⁰⁴

3. The Media, Advertisers and Others

Courts have generally been willing to credit as relevant to the actual confusion issue evidence that members of the media in magazine or newspaper articles confused the parties' products or services.¹⁰⁵ In most of these cases, the media confusion was not

101. *Telechron, Inc. v. Telicon Corp.*, 97 F. Supp. 131, 143 (3d Cir. 1952) (quotation omitted). *Accord Interstate Battery System of America, Inc. v. Wright*, 811 F. Supp. 237, 243 (N.D. Tex. 1993) (“[T]he fact that these retailers were confused regarding genuine and mislabeled batteries is highly probative of likelihood of confusion in the marketplace generally because retailers are less likely to be confused than average consumers.”).

102. *See, e.g., Marathon Mfg. Co. v. Enerlite Prods. Corp.*, 767 F.2d 214, 220-21 (5th Cir. 1985); *Citibank, N.A. v. City Bank*, 206 U.S.P.Q. (BNA) 997, 1009 (N.D. Cal. 1980); *Santucci Constr. Co. v. Carlo V. Santucci, Inc.*, 200 U.S.P.Q. (BNA) 783, 786 (N.D. Ill. 1978) (confusion by publishers of trade journal); *Jonbil Inc. v. International Multifoods Corp.*, 3 U.S.P.Q.2d (BNA) 1882, 1885-86 (T.T.A.B. 1987). *But see Windsor, Inc. v. Intravco Travel Centers, Inc.*, 799 F. Supp. 1513, 1524-25 (S.D.N.Y. 1992) (where court stated that one instance of alleged actual confusion on the part of another supplier in the parties' industry was, *inter alia*, irrelevant, since “plaintiff must prove that an appreciable number of reasonable consumers - rather than suppliers or retailers - would be confused. . .”).

103. *Brown v. Quiniou*, 16 U.S.P.Q.2d (BNA) 1161, 1168-69 (S.D.N.Y. 1990). *See also Windsor, Inc.*, 799 F. Supp. 1513, 1524-25.

104. *See, e.g., Safeway Stores, Inc. v. Safeway Discount Drugs, Inc.*, 675 F.2d 1160, 1167 (11th Cir. 1982); *Purofied Down Prods. Corp. v. Puro Down Int'l*, 530 F. Supp. 134, 135 n.2 (E.D.N.Y. 1982).

105. *See, e.g., Academy of Motion Picture Arts and Sciences v. Creative House Promotions, Inc.*, 944 F.2d 1446, 1456 (9th Cir. 1991); *Brunswick Corp. v. Spinit Reel Co.*, 832 F.2d 513, 522 (10th Cir. 1987); *Schering Corp. v. Schering A.G.*, 4

the sole type of actual confusion introduced by the plaintiff or relied upon by the court in finding actual confusion. However, in *Pro Hardware, Inc. v. Home Centers of America, Inc.*,¹⁰⁶ the court discounted other evidence proffered on this point and relied solely on one instance of media confusion in finding that the actual confusion factor had been satisfied:

The Court considers persuasive of actual confusion, however, the fact that a neutral reporter from the Corpus Christi Caller-Times in a newspaper article about this dispute confused the two names. The Court finds that there has been actual confusion of the names.¹⁰⁷

Courts have also given weight to evidence illustrating that a defendant's advertising agency or its representatives or advertisers in the plaintiff's publication, were confused by the parties' trademarks.¹⁰⁸

One court has found that evidence of actual confusion as to the parties' marks on the part of an insurance investigator supported a finding of actual confusion.¹⁰⁹ Another court found evidence that local Better Business Bureau organizations erroneously directed complaints about plaintiff's products to defendants constituted actual confusion.¹¹⁰

4. *Friends and Acquaintances of the Senior User*

A few courts have also considered whether confusion among friends, relatives or acquaintances of the senior user constitutes credible, probative actual confusion evidence. The courts in two

U.S.P.Q.2d (BNA) 1596, 1604 (D.N.J. 1987); *Pro Hardware, Inc. v. Home Centers of America, Inc.*, 607 F. Supp. 146, 152 (S.D. Tex. 1984); *Koppers Co. v. Krupp-Koppers GmbH*, 517 F. Supp. 836, 842 (W.D. Pa. 1981); *Santucci Constr. Co. v. Carlo V. Santucci, Inc.*, 200 U.S.P.Q. (BNA) 783, 786 (N.D. Ill. 1978); *Stembridge Prods., Inc. v. Gay*, 335 F. Supp. 863, 866 (M.D. Ga. 1971). *But see Centaur Communications Ltd. v. A/S/M Communications, Inc.*, 830 F.2d 1217, 1227 (2d Cir. 1987).

106. 607 F. Supp. 146 (S.D. Tex. 1984).

107. *Id.* at 152.

108. *See, e.g.*, *Donsco, Inc. v. Casper Corp.*, 587 F.2d 602, 605 (3d Cir. 1978); *Multi-Local Media, Inc. v. 800 Yellow Book Inc.*, 813 F. Supp. 199, 204 (E.D.N.Y. 1993); *Armstrong Cork Co. v. Armstrong Plastic Covers Co.*, 434 F. Supp. 860, 868 (E.D. Mo. 1977); *Chester Barrie, Ltd. v. Chester Laurie, Ltd.*, 189 F. Supp. 98, 102 (S.D.N.Y. 1960).

109. *Quill Corp. v. Quill Printing Corp.*, 215 U.S.P.Q. (BNA) 986, 988 (N.D. Ill. 1982).

110. *Armstrong Cork Co. v. Armstrong Plastic Covers Co.*, 434 F. Supp. 860, 868 (E.D. Mo. 1977).

decisions did not discount the evidence of actual confusion experienced by the plaintiff's acquaintances.¹¹¹ In one of the decisions, the Eleventh Circuit noted that these "reports of confusion that do exist appear genuine, given that the three [acquaintances] independently and on their own initiative contacted [the plaintiff's principal shareholder] to inquire about the new rink."¹¹² On the other hand, in three other decisions, two of which were from the same two courts, little weight was given to evidence of actual confusion of the plaintiff's friends or relatives where there was no showing that these individuals were customers or potential customers of the parties.¹¹³ Another court, addressing the plaintiff's counsel's statement that he was confused by the parties' trade dresses — the only actual confusion "evidence" proffered by the plaintiff — wisely found that such a statement "can be accorded only limited probative value because of the party's obvious allegiance to plaintiff."¹¹⁴

E. Putting It Into Context — The Quantum of Actual Confusion Evidence Required

Not only must courts decide what evidence constitutes "good" evidence of actual confusion, they must also decide how much evidence of actual confusion is required to establish this factor in the plaintiff's favor. As with the former issue, the analyses engaged in by courts to determine the latter issue have varied widely. Not surprisingly, the debate on this issue most often arises in cases where the plaintiff has presented only a relatively small number of instances of actual confusion.

Some courts have held that evidence of a few instances of actual confusion established this factor in the senior user's favor,¹¹⁵ often relying specifically upon the rule that since actual

111. *Jellibeans, Inc. v. Skating Clubs, Inc.*, 716 F.2d 833, 844 (11th Cir. 1983), *affg* 212 U.S.P.Q. (BNA) 170, 177 (N.D. Ga. 1981); *Armco, Inc. v. Armco Burglar Alarm Co.*, 693 F.2d 1155, 1160 (5th Cir. 1982).

112. *Jellibeans*, 716 F.2d at 844.

113. *W.W.W. Pharmaceutical Co. v. Gillette Co.*, 984 F.2d 567, 574 (2d Cir. 1993); *Freedom Sav. & Loan Ass'n v. Way*, 757 F.2d at 1185, *affg* 583 F. Supp. 544, 548 (M.D. Fla. 1984); *Sun Banks, Inc. v. Sun Fed. Sav. & Loan Ass'n*, 651 F.2d 311, 319 (5th Cir. 1981).

114. *Warner Lambert Co. v. McCrory's Corp.*, 718 F. Supp. 389, 399 (D.N.J. 1989).

115. *See, e.g., Louisiana World Exposition, Inc. v. Logue*, 746 F.2d 1033, 1041 (5th Cir. 1984); *Safeway Stores, Inc. v. Safeway Discount Drugs, Inc.*, 675 F.2d 1160, 1166-67 (11th Cir. 1982); *Jellibeans, Inc. v. Skating Clubs, Inc.*, 716 F.2d

confusion evidence is difficult to obtain, even a small number of instances is significant.¹¹⁶ Some courts also have relied upon the facts that the goods involved are lower-priced items and, therefore, consumers are less likely to make their confusion known.¹¹⁷ Other courts, however, have dismissed the plaintiff's evidence of a few actual confusion instances as *de minimis*, without further analyzing the issue.¹¹⁸ Still other courts have similarly found that the plaintiff's proffered instances of actual confusion were insufficient to establish this factor, but have based their decisions on a comparison of the number of instances submitted to the amount of opportunity for consumers to experience actual confusion.¹¹⁹

833, 843-45 (11th Cir. 1983); *Roto-Rooter Corp. v. O'Neal*, 513 F.2d 44, 46 (5th Cir. 1975); *Varitronics Sys., Inc. v. Merlin Equip., Inc.*, 682 F. Supp. 1203, 1208-09 (S.D. Fla. 1988); *IMS, Ltd. v. International Medical Sys., Inc.*, 1 U.S.P.Q.2d (BNA) 1268, 1275 (E.D.N.Y. 1986); *Olay Co. v. Cococare Prods., Inc.*, 218 U.S.P.Q. (BNA) 1028, 1040 (S.D.N.Y. 1983); *American Ass'n for the Advancement of Science v. Hearst Corp.*, 498 F. Supp. 244, 258-59 (D.D.C. 1980); *MRI Sys. Corp. v. Wesley-Jessen, Inc.*, 189 U.S.P.Q. (BNA) 214, 220 (T.T.A.B. 1975); *Molenaar, Inc. v. Happy Toys, Inc.*, 188 U.S.P.Q. (BNA) 469, 471 (T.T.A.B. 1975).

116. *Id.* See also *supra* notes 4 and 5 and accompanying text.

117. See, e.g., *Brunswick Corp. v. Spirit Reel Co.*, 832 F.2d 513, 522 (10th Cir. 1987); *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1544 (11th Cir. 1986); see also *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 383 (7th Cir. 1976).

118. *Homeowners Group, Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1107 (6th Cir. 1991); *American Int'l Group v. American Int'l Airways, Inc.*, 14 U.S.P.Q.2d (BNA) 1933, 1936 (E.D. Pa. 1989); *Information Clearing House, Inc. v. Find Magazine*, 492 F. Supp. 147, 160 (S.D.N.Y. 1980); *B.D. Communications, Inc. v. Dial Media, Inc.*, 429 F. Supp. 1011, 1014 n.6 (S.D.N.Y. 1977). *Contra* *Forum Corp. v. Forum, Ltd.*, 903 F.2d 434, 443 (7th Cir. 1990).

119. See, e.g., *Nutri/System, Inc. v. Con-Stan Indus., Inc.*, 809 F.2d 601, 606-07 (9th Cir. 1987) (evidence of actual confusion was insignificant in view of both parties' high volume of business); *Sun Banks, Inc. v. Sun Fed. Sav. and Loan Ass'n*, 651 F.2d 311, 319 (5th Cir. 1981) (several isolated instances of actual confusion were negligible "in light of the number of transactions conducted and the extent of the parties' advertising"); *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 263 (5th Cir. 1980) (three instances of actual confusion over 15 years of extensive concurrent sales found insignificant); *Scott Paper Co. v. Scott's Liquid Gold, Inc.*, 589 F.2d 1225, 1231 (3d Cir. 1978) (nineteen misdirected letters in four-year period during which defendant sold 50 million cans of its product found to be insufficient); *DeCosta v. Columbia Broadcasting Sys., Inc.*, 520 F.2d 499, 514-15 (1st Cir. 1975), *cert. denied*, 423 U.S. 1073 (1976) (six weak instances of confusion over eleven years is either no evidence or minimal evidence of actual confusion); *Clinton Detergent Co. v. Proctor & Gamble Co.*, 133 U.S.P.Q. (BNA) 520, 522-23 (C.C.P.A. 1962); *Bayshore Group Ltd. v. Bay Shore Seafood Brokers, Inc.*, 762 F. Supp. 404, 413 (D. Mass. 1991); *Universal Money Ctrs., Inc. v. American Tel. & Tel. Co.*, 17 U.S.P.Q.2d (BNA) 1435, 1440 (D. Kan. 1990) (ten

Yet other courts have either discounted or expressed reservations regarding the significance of actual confusion evidence in light of the plaintiff's failure to introduce evidence which would allow the courts to compare the number of instances to the amount of the parties' sales activities. For example, in *Mile High Upholstery Fabric Co. v. General Tire & Rubber Co.*¹²⁰, the court analyzed this very issue, and stated,

Although plaintiff has offered evidence of several instances of actual confusion by the consuming public, it has made no effort to place those instances in perspective. We have no idea whatsoever of the weight to be given the recounted incidents in comparison with plaintiff's total sales activity. . . . [P]laintiff's failure to indicate in any way the weight to be given to its evidence of actual confusion detracts significantly from its showing.¹²¹

With the exception of the *Mile High* decision and those in accord with it, the decisions discussed above illustrate that most courts apparently have experienced little difficulty in determining — often with little or no discussion or analysis — that the number of actual confusion incidents either were significant and therefore probative of confusion, or were de minimis and therefore could be disregarded. The apparent ease with which these courts have been able to resolve this issue is surprising; it would be difficult

instances of actual confusion found to be "numerically insignificant"); *Official Airline Guides, Inc. v. Churchfield Publications, Inc.*, 17 U.S.P.Q.2d (BNA) 1897, 1904 (D. Or. 1990) (seven misdirected mailings in a period when 600,000 mailings were made was de minimis and did not establish actual confusion); *Safeway Stores, Inc. v. Safeway Ins. Co.*, 657 F. Supp. 1307, 1317 (M.D. La. 1985), *aff'd without opinion*, 791 F.2d 929 (5th Cir. 1986); *Inc. Publishing Corp. v. Manhattan Magazine, Inc.*, 616 F. Supp. 370, 386 (S.D.N.Y. 1985); *American Greetings Corp. v. Easter Unlimited, Inc.*, 579 F. Supp. 607, 616 (S.D.N.Y. 1983); *Mushroom Makers, Inc. v. R.G. Barry Corp.*, 441 F. Supp. 1220, 1231 (S.D.N.Y. 1977), *aff'd*, 580 F.2d 44, 48 (2d Cir. 1978); *Polaroid Corp. v. Polarad Elecs. Corp.*, 182 F. Supp. 350, 354 (E.D.N.Y. 1960), *aff'd on other grounds*, 287 F.2d 492 (2d Cir. 1961) (the less than 100 instances of misdirected mail were "an insignificant fraction of the mail received by the plaintiff and the defendant."); *Amica Mut. Ins. Co. v. R.H. Cosmetics Corp.*, 204 U.S.P.Q. (BNA) 155, 163-64 (T.T.A.B. 1979) (ten misdirected letters over a five-year period during which opposer received approximately one million pieces of mail found to be "inconsequential, insignificant, and of no legal consequence."); *Transamerica Fin. Corp. v. Trans-American Collections, Inc.*, 197 U.S.P.Q. (BNA) 43, 52 (T.T.A.B. 1977). *But see* *Forum Corp. v. Forum, Ltd*, 903 F.2d at 443.

120. 221 U.S.P.Q. (BNA) 217 (N.D. Ill. 1983).

121. *Id.* at 223 (citation omitted). *Accord* *Imperial Serv. Sys., Inc. v. ISS Int'l Serv. Sys., Inc.*, 701 F. Supp. 655, 659 (N.D. Ill. 1988); *Source Serv. Corp. v. Source Telecomputing Corp.*, 635 F. Supp. 600, 614 (N.D. Ill. 1986).

enough to determine how much evidence of actual confusion must be proven if all such evidence were equally probative and credible, but this issue is made even more difficult in view of the types of actual confusion evidence and the varying probative values which courts have given them.

Some courts have specifically recognized the difficulty of “quantifying” actual confusion evidence to determine whether or not a plaintiff has presented evidence sufficient to establish the actual confusion factor in its favor. For example, in *Forum Corporation of North America v. Forum, Ltd.*¹²², the Seventh Circuit Court of Appeals addressed the district court’s characterization of the plaintiff’s actual confusion evidence as being *de minimis*. In finding the district court erred by discounting the plaintiff’s evidence of actual confusion, the Seventh Circuit stated,

it does not seem reasonable to classify [the plaintiff’s actual confusion] evidence . . . as *de minimis*, since it was not based on a full survey of customers. In other words, this is not a case in which we would conclude that there was a statistically insignificant percentage of confusion, since the actual percentage is unknown.¹²³

The court implicitly recognized one major difficulty of quantifying actual confusion evidence — that a plaintiff generally is unable to produce evidence of all instances of actual confusion but rather can only introduce evidence of those instances brought to his attention.

In *Lambda Electronics Corp. v. Lambda Technology, Inc.*¹²⁴, Judge Ward acknowledged a court’s inability to categorize easily the amount of actual confusion and the consequences that follow therefrom:

The difficult question for the Court is not to decide whether the factor of actual confusion is present here, but rather to assess how significantly that factor is implicated by the facts of the case. This requires consideration of the magnitude of the actual confusion proven by Veeco. Veeco argues that the actual confusion in this case is “rampant”; Lambda Technology styles this actual confusion as being “*de minimis*.” The truth lies somewhere between these two extremes. Lambda Technology persuasively points out that it receives numerous checks and orders from those companies that sent the half-dozen or so misdirected checks, and that its marketing representatives come in contact with thousands of potential or

122. 903 F.2d 434 (7th Cir. 1990).

123. *Id.* at 443.

124. 515 F. Supp. 915 (S.D.N.Y. 1981).

existing customers each year, making the reported instances of confusion much less striking than they appear on their face. On the other hand, Veeco soundly argues that the recorded instances of actual confusion should be magnified by virtue of the general inaccessibility of such information, and also of the relatively brief period within which it occurred in this case. *Plainly there is no analytical mechanism for determining that actual confusion is significant in one case, rampant in a second, and de minimis in a third. The trial judge must rely upon his own common sense rather than upon any well-articulated legal principle in such cases . . .* [T]he Court holds that there was appreciable actual confusion in this case, meaning that this particular likelihood of confusion factor is not only present here, but significantly implicated. At the same time, the Court does not view this actual confusion to be "rampant" in the manner suggested by plaintiffs. The Court accordingly declines plaintiffs' invitation to consider this actual confusion not only in its own right as a factor probative of likelihood of confusion, but also as probative of whether certain of the other Polaroid factors are implicated in this case. In the Court's view, to allow the evidence of actual confusion to play this dual role here would be to give this evidence more probative weight than it may justifiably be said to deserve.¹²⁵

Judge Ward's language illustrates the potential dilemma which courts face in assessing the amount of actual confusion needed in order for this factor to weigh in favor of a likelihood of confusion and, if it does, the extent to which it does. There is no articulable formula which courts can utilize in answering this question. Nevertheless, in attempting to resolve this issue courts should consider (1) the type and number of actual confusion instances presented by the plaintiff; (2) the extent to which opportunities exist for actual confusion to occur; and (3) the extent to which opportunities exist for the plaintiff to learn of instances of actual confusion.

F. Survey Evidence and Expert Opinions as Evidence of Actual Confusion

Many courts have considered a properly conducted likelihood of confusion market survey to be probative evidence of actual confusion.¹²⁶ There is no question that a properly conducted market

125. *Id.* at 927 (emphasis added).

126. *See, e.g.,* E. & J. Gallo Winery v. Gallo Cattle Co., 967 F.2d 1280, 1293 (9th Cir. 1992); Mutual of Omaha Ins. Co. v. Novak, 836 F.2d 397, 400 (8th Cir. 1987); Centaur Communications, Ltd. v. A/S/M Communications, Inc., 830 F.2d

survey indicating that a substantial percentage of respondents confuse the two trademarks in question is relevant to, probative of, and supports a finding of, a likelihood of confusion.¹²⁷ However, survey evidence is not *actual* confusion in fact, and it is questionable whether courts should consider it as such. Survey results do not constitute instances of actual confusion, for they do not represent incidents of actual consumers who have experienced actual confusion in the “real” marketplace.

One court has considered whether expert opinion testimony that the public is “being misled” by the defendant’s use of a similar mark constitutes probative actual confusion evidence, and properly held that it was “not competent, admissible evidence of actual confusion.”¹²⁸

G. Evidence of Non-Confused Consumers

A few courts have also considered the value to be given to evidence introduced by trademark infringement defendants that certain consumers or other individuals were not confused when confronted with the parties’ marks. At least two courts have given such evidence at least some weight.¹²⁹ In two others, however, the

1217, 1227; *Jordache Enterprises, Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482, 1487 (10th Cir. 1987); *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1544 n.68 (11th Cir. 1986); *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 875 (2d Cir. 1986); *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1360 (9th Cir. 1985); *Helene Curtis Indus., Inc. v. Church & Dwight Co.*, 560 F.2d 1325, 1330-31 (7th Cir. 1977); *Gilbert/Robinson v. Carrie Beverage-Missouri*, 758 F. Supp. 512, 524 (E.D. Mo. 1991); *Paramount Pictures Corp. v. Video Broadcasting Sys., Inc.*, 724 F. Supp. 808, 816 (D. Kan. 1989); (“Evidence of actual confusion can consist of customer inquiries and public recognition surveys; the latter being more persuasive than the former.”); *Inc. Publishing Corp. v. Manhattan Magazine, Inc.*, 616 F. Supp. 370, 386, 390 (S.D.N.Y. 1985); *Mushroom Makers, Inc. v. R.G. Barry Corp.*, 441 F. Supp. 1220, 1231 (S.D.N.Y. 1977), *aff’d*, 580 F.2d 44 (2d Cir. 1978).

127. See generally 2 McCARTHY, *supra* note 11, at §§ 32.46 to 32.55. A general discussion of survey evidence is beyond the scope of this article.

128. *Paramount Pictures Corp. v. Video Broadcasting Sys., Inc.*, 724 F. Supp. 808, 816 (D. Kan. 1989). Other courts have properly concluded that such opinion testimony regarding the likelihood of confusion between the marks in question is entitled to little or no weight. See, e.g., *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 979 n.23 (11th Cir. 1983); *American Meat Inst. v. Horace W. Longacre, Inc.*, 211 U.S.P.Q. (BNA) 712, 720-21 (T.T.A.B. 1981).

129. *Wordsmith Publ. Co. v. Meredith Corp.*, 904 F.2d 1244, 1248-1249 (8th Cir. 1990); *Official Airline Guides, Inc. v. Churchfield Publications, Inc.*, 17 U.S.P.Q.2d (BNA) 1897, 1904 (D. Or. 1990). See also *Hutchinson v. Essence Communications, Inc.*, 769 F. Supp. 541, 555 (S.D.N.Y. 1991) (“[O]n the other

courts said such evidence is not helpful in determining the actual confusion issue and should be disregarded.¹³⁰ The courts in these latter decisions take the proper view. As one of those courts stated,

[The defendant] offered the testimony of several consumers who testified that they had not been confused. The district court properly disregarded this evidence. If [the defendant] could not find at least a handful of consumers who would agree to testify that they had not been confused, it might as well have defaulted.¹³¹

III. EVIDENTIARY CONCERNS INVOLVING ACTUAL CONFUSION

Courts have also addressed a number of evidentiary issues relating to actual confusion. These issues range from admissibility concerns, focusing primarily on the issue of whether the actual confusion sought to be introduced constituted inadmissible hearsay evidence, to concerns regarding the form of the actual confusion evidence and whether the defendant's counsel had the opportunity to examine the confused consumers.

Many courts have addressed the issue of whether certain evidence of actual confusion constitutes inadmissible hearsay evidence. Usually, the evidence objected to on this basis has been in the form of testimony by the recipient of the statements of the confused consumer regarding the substance or the nature of the statements made. Courts which have addressed this issue have found that such evidence is admissible because it either falls within the Federal Rule of Evidence 803(3) "state of mind" exception to the hearsay rule, or because the evidence is not being offered "to prove the truth of the matter asserted" (Federal Rule of Evidence 801(c)), or both.¹³² Of course, depending on its form and

side of the equation, Hutchinson testified that no one asked her whether she worked with or was associated with *ESSENCE* magazine in any way. I found Hutchinson to be a credible witness and accept that testimony.").

130. *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d at 1544 n.69; *Earth Technology Corp. v. Environmental Research & Technology, Inc.*, 222 U.S.P.Q. (BNA) 585, 589 (C.D. Cal. 1983); *Oleg Cassini, Inc. v. Cassini Tailors, Inc.*, 764 F. Supp. 1104, 1112 (W.D. Tex. 1990) ("That certain individuals are not confused does not convince the Court that other consumers will not be confused. . .").

131. *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1544 (11th Cir. 1986).

132. *See, e.g., Jordache Enters., Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482, 1487 n.1 (affiliation inquiry evidence admissible pursuant to state of mind exception); *Armco, Inc. v. Armco Burglar Alarm Co.*, 693 F.2d 1155, 1160 n.10 (5th Cir. 1982) (inquiry evidence admissible based upon state of mind exception and because such evidence was not offered to prove the truth of the matter asserted);

substance, actual confusion evidence may well constitute inadmissible hearsay, and courts have rejected such evidence where plaintiffs have failed to establish a proper basis for admissibility.¹³³ Given the important role actual confusion evidence can play in the outcome of the case, trademark infringement plaintiffs should be prepared to address questions of admissibility of the actual confusion evidence which they intend to proffer. Likewise, defendants should no doubt challenge the admissibility of such evidence where no proper basis for its admission appears to exist.

Courts also have grappled with the difficult issue of the weight to be given to evidence of actual confusion where there is no opportunity either to substantiate or to challenge such evidence. More specifically, some courts have questioned the weight to be given to actual confusion evidence where the defendant is not afforded an opportunity to cross-examine the allegedly confused individuals. Such a problem has arisen where the evidence of actual confusion is presented through the testimony of the

Harold F. Ritchie, Inc. v. Chesebrough-Pond's, Inc., 281 F.2d 755, 761 n.13 (2d Cir. 1960) (evidence admissible based upon state of mind exception); Imperial Serv. Sys., Inc. v. ISS Int'l Serv. Sys., Inc., 701 F. Supp. 655, 659 (N.D. Ill. 1988) (evidence admissible based upon state of mind exception); Source Servs. Corp. v. Source Telecomputing Corp., 635 F. Supp. 600, 612 (N.D. Ill. 1986) (certain evidence of actual confusion admissible pursuant to state of mind exception); Inc. Publishing Corp. v. Manhattan Magazine, Inc., 616 F. Supp. 370, 388 (S.D.N.Y. 1985) (inquiry evidence admissible pursuant to state of mind exception and because an inquiry is not an "assertion" and, accordingly, cannot be a hearsay statement); Mustang Motels, Inc. v. Patel, 226 U.S.P.Q. (BNA) 526, 527 n.1 (E.D. Cal. 1985) (actual confusion evidence admissible because such evidence was not being offered to prove the truth of the matter asserted); Mile High Upholstery Fabric Co. v. General Tire and Rubber Co., 221 U.S.P.Q. (BNA) 217, 222-223 (N.D. Ill. 1983) (actual confusion evidence admissible because it is not offered to prove the truth of the matter asserted and falls within the state of mind exception); American Orthodontics Corp. v. American Hosp. Supply Corp., 531 F. Supp. 247, 250 (N.D. Ill. 1981) (actual confusion evidence admissible pursuant to present sense impression and state of mind exceptions to the hearsay rule); Toys "R" Us, Inc. v. Lamps Are Us, 219 U.S.P.Q. (BNA) 340, 345-46 (T.T.A.B. 1983).

133. See, e.g., Vitek Sys., Inc. v. Abbott Labs., 675 F.2d 190, 194 (8th Cir. 1982); Ocean Bio-Chem, Inc. v. Turner Network Television, Inc., 741 F. Supp. 1546, 1558-61 (S.D. Fla. 1990); McKee Baking Co. v. Interstate Brands Corp., 17 U.S.P.Q.2d (BNA) 1528, 1529 (E.D. Mo. 1990); Pro Hardware, Inc. v. Home Ctrs. of Am., Inc., 607 F. Supp. 146, 152 (S.D. Tex. 1984); Programmed Tax Sys., Inc. v. Raytheon Co., 439 F. Supp. 1128, 1131 n.1 (S.D.N.Y. 1977). *But see* Kusan, Inc. v. Fairway Siding Corp., 7 U.S.P.Q.2d (BNA) 1202, 1209 (D. Mass. 1988) (where court ruled that affiliation inquiry evidence was inadmissible hearsay, without mention of the state of mind exception whether the inquiries were assertions or were offered for proving the truth of the matter asserted.).

recipient of statements illustrating confusion on the part of those making the statements, and where (usually in the context of a preliminary injunction hearing), affidavits concerning actual confusion are proffered instead of live testimony. Courts have varied in their assessment of such evidence; some have taken the position that the inability for either substantiation or cross-examination warrants heavily discounting the probative value of such evidence,¹³⁴ while others have given such evidence substantial weight despite these concerns.¹³⁵ In the context of a motion for a preliminary injunction, another court admitted and relied upon affidavit testimony of actual confusion where the opposing party had an opportunity to conduct depositions of the affiants who had reported instances of actual confusion, but failed to do so.¹³⁶

Such a variance is to be expected, and should not be construed as illustrating an unnecessary inconsistency in rulings by the courts. The courts probably have implicitly focused, and in fact should focus, on whether the plaintiff has submitted its evidence of actual confusion in the best, most complete manner possible. For example, courts should consider the reason the alleged confused individuals did not testify at trial. If legitimate reasons exist, such a failure should not necessarily result in giving the actual confusion evidence little or no weight. On the other hand, if through reasonable efforts the plaintiff could have obtained testimony directly from the allegedly confused individuals, thus allowing the defendant an opportunity to cross-examine them, a failure to produce such witnesses should raise serious questions as to the weight to be afforded to such evidence.

134. See, e.g., *Holiday Inns, Inc. v. Holiday Out in Am.*, 481 F.2d 445, 448-49 (5th Cir. 1973); *Hutchinson v. Essence Communications, Inc.*, 769 F. Supp. 541, 555 (S.D.N.Y. 1991); *Bridges in Orgs., Inc. v. Bureau of Nat'l Affairs, Inc.*, 19 U.S.P.Q.2d (BNA) 1827, 1836 (D. Md. 1991); *Warner Lambert Co. v. McCrory's Corp.*, 718 F. Supp. 389, 399 (D.N.J. 1989); *Lobo Enters., Inc. v. Tunnel, Inc.*, 693 F. Supp. 71, 74-75, 77 (S.D.N.Y. 1988); *Victory Pipe Craftsman, Inc. v. Faberge, Inc.*, 582 F. Supp. 551, 558 (N.D. Ill. 1984); *Freedom Sav. and Loan Ass'n v. Way*, 583 F. Supp. 544, 548 (M.D. Fla. 1984), *aff'd*, 757 F.2d 1176 (11th Cir. 1985); *Mushroom Makers, Inc. v. R.G. Berry Corp.*, 441 F. Supp. 1220, 1231 (S.D.N.Y. 1977), *aff'd*, 580 F.2d 44 (2d Cir. 1978); *Transamerica Fin. Corp. v. Trans-American Collections, Inc.*, 197 U.S.P.Q. (BNA) 43, 51-2 (T.T.A.B. 1977).

135. See, e.g., *International Kennel Club, Inc. v. Mighty Star, Inc.*, 846 F.2d 1079, 1090 (7th Cir. 1988); *Edison Bros. Stores, Inc. v. National Dev. Group, Inc.*, No. 89-0612-Z, 1992 WL 55465, at *3 (D. Mass. Mar. 6, 1992); see also generally the decisions cited *supra* at note 132.

136. *Home Shopping Club, Inc. v. Charles of the Ritz Group, Inc.*, 820 F. Supp. 763, 775 (S.D.N.Y. 1993).

IV. CONCLUSION

Actual confusion evidence, where present, can play a crucial role in the outcome of federal trademark infringement litigation. In certain situations, courts have held that the absence of actual confusion evidence can likewise play a pivotal role in the outcome of such litigation, in that the absence of actual confusion evidence over a long period of time illustrates that future confusion between the marks involved is unlikely. Not only can credible, probative evidence of actual confusion support the finding of a likelihood of confusion, such evidence also indicates that the plaintiff's trademark has acquired secondary meaning.

There are several types of evidence which parties have proffered in an attempt to prove the existence of actual confusion, including such evidence as mistaken purchases, products returned to the wrong party for refund or repair, consumer complaints made to the wrong party, misdirected correspondence and telephone calls, inquiries regarding a possible relationship or affiliation between the parties, and survey evidence. Moreover, such evidence has been proffered as it relates not only to consumers, but also as to suppliers, competitors, other members of the trade, the media, advertisers and even acquaintances of one of the parties who may be familiar with the two marks. Given that evidence purporting to prove the existence of actual confusion has taken many forms and has involved many different classes of individuals, it is not surprising that decisions involving the probative value of such evidence provide a full spectrum of interpretation of the various types of evidence. As a result, a party on either side of a federal trademark infringement suit can generally find some case law supporting its position with respect to almost every type of actual confusion evidence. The lone exception may be clear evidence of instances where consumers have purchased the product of one party under the mistaken belief that they were purchasing the product of the other party. Courts have uniformly accepted such evidence as probative of the existence of actual confusion.

The judicial variance in the treatment of other types of actual confusion evidence is not necessarily the result of improper court rulings. Rather, often the divergence may be more accurately explained as resulting from two factors. First, determining whether actual confusion exists in a given case is very much a fact-intensive inquiry. Second, in many instances courts are forced to speculate as to the precise cause of the resulting "confusion," either because parties fail to provide evidence regarding the

reason for the manifestation of alleged confusion or because such evidence is unavailable. That is, often courts are presented only with the result of the purported actual confusion without being presented with direct evidence of the cause of such confusion. As discussed in this article, some types of purported actual confusion evidence require more explanation as to their cause than do others.

Parties involved in trademark infringement litigation must be mindful of the various types of evidence which courts have found to be probative of actual confusion, and the weight accorded to each such type. Such parties also must recognize the value of providing the court with at least some evidence illustrating that the manifestation of actual confusion was, in fact, caused by confusion on the part of the relevant party with respect to the trademarks involved in suit. The more that a party can explain the evidence as being truly the result of actual confusion, the less likely a court is to dismiss such evidence as being utterly without value on this issue. Parties and courts alike should therefore be sensitive to the need to consider thoughtfully proffered evidence of actual confusion in order to determine properly the credibility and probativeness of such evidence; given its potential importance such evidence should neither be blindly accepted nor rejected when determining whether actual confusion, as well as the likelihood of confusion, exists.