**15.18 INFRINGEMENT—LIKELIHOOD OF CONFUSION—FACTORS— *SLEEKCRAFT* TEST (15 U.S.C. §§ 1114(1) and 1125(a))**

You must consider whether the defendant’s use of the trademark is likely to cause confusion about the source of the plaintiff’s or the defendant’s goods.

I will suggest some factors you should consider in deciding this. The presence or absence of any particular factor that I suggest should not necessarily resolve whether there was a likelihood of confusion, because you must consider all relevant evidence in determining this. As you consider the likelihood of confusion you should examine the following:

(1) Strength or Weakness of the Plaintiff’s Mark. The more the consuming public recognizes the plaintiff’s trademark as an indication of origin of the plaintiff’s goods, the more likely it is that consumers would be confused about the source of the defendant’s goods if the defendant uses a similar mark.

(2) Defendant’s Use of the Mark. If the defendant and plaintiff use their trademarks on the same, related, or complementary kinds of goods there may be a greater likelihood of confusion about the source of the goods than otherwise.

(3) Similarity of Plaintiff’s and Defendant’s Marks. If the overall impression created by the plaintiff’s trademark in the marketplace is similar to that created by the defendant’s trademark in [appearance] [sound] [or] [meaning], there is a greater chance [that consumers are likely to be confused by defendant’s use of a mark] [of likelihood of confusion]. [Similarities in appearance, sound or meaning weigh more heavily than differences in finding the marks are similar.]

(4) Actual Confusion. If use by the defendant of the plaintiff’s trademark has led to instances of actual confusion, this strongly suggests a likelihood of confusion. However actual confusion is not required for a finding of likelihood of confusion. Even if actual confusion did not occur, the defendant’s use of the trademark may still be likely to cause confusion. As you consider whether the trademark used by the defendant creates for consumers a likelihood of confusion with the plaintiff’s trademark, you should weigh any instances of actual confusion against the opportunities for such confusion. If the instances of actual confusion have been relatively frequent, you may find that there has been substantial actual confusion. If, by contrast, there is a very large volume of sales, but only a few isolated instances of actual confusion you may find that there has not been substantial actual confusion.

(5) Defendant’s Intent. Knowing use by defendant of the plaintiff’s trademark to identify similar goods may strongly show an intent to derive benefit from the reputation of the plaintiff’s mark, suggesting an intent to cause a likelihood of confusion. On the other hand, even in the absence of proof that the defendant acted knowingly, the use of plaintiff’s trademark to identify similar goods may indicate a likelihood of confusion.

(6) Marketing/Advertising Channels. If the plaintiff’s and defendant’s [goods] [services] are likely to be sold in the same or similar stores or outlets, or advertised in similar media, this may increase the likelihood of confusion.

(7) Consumer’s Degree of Care. The more sophisticated the potential buyers of the goods or the more costly the goods, the more careful and discriminating the reasonably prudent purchaser exercising ordinary caution may be. They may be less likely to be confused by similarities in the plaintiff’s and defendant’s trademarks.

(8) Product Line Expansion. When the parties’ products differ, you may consider how likely the plaintiff is to begin selling the products for which the defendant is using the plaintiff’s trademark. If there is a strong possibility of expanding into the other party’s market, there is a greater likelihood of confusion.

[(9) Other Factors. *Insert any other factors that bear on likelihood of confusion*.]

**Comment**

The Ninth Circuit has often reaffirmed the validity of the eight-factor test from *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979), that is covered in this instruction*. See Multi Time Machine, Inc. v. Amazon.com, Inc.*, 792 F.3d 1070, 1074 (9th Cir. 2015), *opinion withdrawn*, *see* 801 F.3d 930, 935 n.1 (9th Cir. 2015), *cert. denied*, 136 S. Ct. 1231 (2016) (applying “eight non-exhaustive factors, known as the *Sleekcraft* factors, to determine whether a trademark use gives rise to a likelihood of confusion”); *Dr. Seuss Enters., L.P. v. Penguin Books*, 109 F.3d 1394, 1404 n.13 (9th Cir. 1997) (noting that Ninth Circuit uses eight-factor *Sleekcraft* test “simply to be over-inclusive”). Before applying the *Sleekcraft* factors, the court first should “define[] the relevant consumer market.” *Ironhawk Techs., Inc. v. Dropbox, Inc.*, 2 F.4th 1150, 1160 (9th Cir. 2021).

The Committee recommends that the judge instruct only on the factors that are relevant in the particular case presented to the jury. *See Brookfield Commc’ns. Inc. v. West Coast Entm’t Corp.*, 174 F.3d 1036, 1054 (9th Cir. 1999) (“it is often possible to reach a conclusion with respect to likelihood of confusion after considering only a subset of the [*Sleekcraft* factors, which do] not purport to be exhaustive, and non-listed variations may often be quite important”); *Metro Pub., Ltd. v. San Jose Mercury News*, 987 F.2d 637, 640 (9th Cir. 1993) (“Because each factor [of eight-factor *Sleekcraft* test] is not necessarily relevant to every case, this list functions as a guide and is ‘neither exhaustive nor exclusive.’”) (citations omitted)*. See generally Thane Intern., Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 901 (9th Cir. 2002) (“Unless properly used, this long list of [likelihood of confusion] factors has the potential to befuddle the inquiry. The list of factors is not a score-card–whether a party ‘wins’ a majority of the factors is not the point. Nor should ‘[t]he factors ... be rigidly weighed; we do not count beans.’ *Dreamwerks Prod. Group v. SKG Studio*, 142 F.3d 1127, 1129 (9th Cir. 1998). ‘Some factors are much more helpful than others, and the relative importance of each individual factor will be case specific.... [I]t is often possible to reach a conclusion with respect to likelihood of confusion after considering only a subset of the factors.’ *Brookfield Communications [v. West Coast Entertainment*], 174 F.3d [1036] at 1054 [(9th Cir. 1999)].”).

A jury should be warned not to focus on any one factor and to consider all relevant evidence in assessing likelihood of confusion, by use of the second paragraph in this instruction. *See Kendall-Jackson Winery Ltd. v. E.& J. Gallo Winery*, 150 F.3d 1042, 1052, n.13 (9th Cir. 1998) (elaborating further on instructions on *Sleekcraft* factors dealing with defendant’s intent to cause confusion and causing actual confusion).

In cases involving claims of trademark infringement on the Internet, the Ninth Circuit has affirmed the use of an additional instruction indicating that three of the *Sleekcraft* factors: (i) similarity of plaintiff’s and defendant’s mark; (ii) relatedness of services; and (iii) simultaneous use of the Internet as a marketing channel, otherwise known as the “Internet Troika,” are of greater importance. *Internet Specialties West, Inc. v. Milon-Digiorgio Enters., Inc.*, 559 F.3d 985, 989 (9th Cir. 2009) (holding that law of Ninth Circuit “places greater import on the ‘Internet Troika’ in Internet cases”).

“The Ninth Circuit enumerated likelihood of confusion tests as helpful guidelines to the district courts. These tests were not meant to be requirements or hoops that a district court need jump through to make the determination . . . . [W]e have identified a non-exclusive series of factors that are helpful in making the ultimate factual determination of likelihood of confusion.” *Eclipse Associates Ltd. v. Data General Corp.*, 894 F.2d 1114, 1117-18 (9th Cir. 1990). *See Brookfield Communications Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1054 (9th Cir. 1999) (“A word of caution: This eight-factor [*Sleekcraft*] test for likelihood of confusion is pliant. Some factors are much more important than others, and the relative importance of each individual factor will be case-specific.”). Because these lists are “neither exhaustive nor exclusive,” *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1290 (1992), a ninth factor has been included.

There is a presumption of a likelihood of confusion “when the offending mark is a counterfeit mark, or a mark virtually identical to a previously registered mark coupled with the intent to pass off or borrow from established good will.” *Louis Vuitton Malletier, S.A. v. Akanoc Solutions, Inc.*, 658 F.3d 936, 945 (9th Cir. 2011) (approving instruction). A counterfeit mark is “a counterfeit of a mark that is registered . . . , whether or not the person against whom relief is sought knew such mark was so registered.” *Id.* (citing 15 U.S.C. § 1116(d)(1)(B)(I)).

The Ninth Circuit recognizes two theories of consumer confusion that support a claim of trademark infringement: forward confusion and reverse confusion. Forward confusion occurs when consumers believe that goods bearing the junior mark came from, or were sponsored by, the senior mark holder. By contrast, reverse confusion occurs when consumers dealing with the senior mark holder believe that they are doing business with the junior mark holder. Reverse confusion is not a separate trademark claim that must be specifically pleaded. Instead, it is a theory of likely confusion that may be alleged by itself or in addition to forward confusion. *Marketquest Group, Inc. v. BIC Corp*., 862 F.3d 927, 932, 937 (9th Cir. 2017); *see also Ironhawk Techs.,* 2 F.4th at 1165 (“Evidence of actual confusion by consumers is strong evidence of likelihood of confusion.” Nevertheless, “failure to prove instances of actual confusion is not dispositive.”)

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