**15.19 Infringement—Likelihood of Confusion—**

**Factor—Strength of Trademark**

**Strength as a Factor for Evaluating Likelihood of Confusion**

How strongly the plaintiff’s trademark indicates that the goods or services come from a particular source is an important factor to consider in determining whether the trademark used by the defendant is likely to create confusion with the plaintiff's mark.

The plaintiff asserts that [*insert trademark*] is a trademark for its [goods or services]. The plaintiff contends that the defendant’s use of [*insert defendant’s mark*] in connection with the defendant’s [*insert the defendant’s product or service*] infringes plaintiff’s trademark because it is likely to cause confusion.

**The Strength of Marks**

The more distinctive and strong a trademark is, the greater the scope of protection the law provides. The law measures trademark strength by considering two prongs:

1. Commercial Strength: This is the amount of marketplace recognition of the mark; and

2. Conceptual Strength: This is the placement of the mark on the spectrum of marks.

**Commercial Strength**: What is “commercial strength?” Not all marks are equally well known. Trademark strength is somewhat like the renown of people. Only a few very famous people are widely known and recognized around the world. Most people are known and recognized only by a small circle of family and friends.

Some trademarks are relatively “strong,” in the sense they are widely known and recognized. A few trademarks are in the clearly “famous” category. These “famous” marks are those like “Apple” for computers and mobile phones, “Google” for a search engine, “Coca-Cola” for beverages and “Toyota” for vehicles. Some trademarks may be strong and well known only in a certain market niche such as mountain climbing gear, plumbing supplies, or commercial airplane electronics equipment, but relatively weak outside that field.

**Conceptual Strength**: What is “conceptual strength?” All trademarks are grouped into two categories: either inherently distinctive or not inherently distinctive. If a mark is inherently distinctive it is immediately protected when first used. If it is not inherently distinctive, to become a legally protected mark, a designation must acquire distinctiveness in people’s minds by becoming known as an indication of source of goods or services. The law calls this “secondary meaning.” [*See* Instruction 15.11 (Infringement—Elements—Validity— Distinctiveness—Secondary Meaning). If the plaintiff’s mark is determined to be inherently distinctive, there will be no need to instruct the jury on acquiring a secondary meaning for the mark.]

For determining the conceptual strength of a mark, trademarks are grouped on a spectrum according to the nature of the mark. In the spectrum, there are three categories of word marks that the law regards as being inherently distinctive: arbitrary, fanciful (or coined), and suggestive. Descriptive word marks are regarded as not being inherently distinctive and require a secondary meaning to become a valid trademark. Finally, generic names have no conceptual

strength.

**Arbitrary** marks are words that in no way describe or suggest the nature of the goods or services they are used with. For example, “apple” is a common word, but it does not describe or suggest anything about the nature of “Apple” brand computers or smart phones. It is an arbitrary word when used as a mark on those products. Arbitrary trademarks are regarded as conceptually strong marks.

**Fanciful (or Coined)** marks are words that are created solely to serve as trademarks. For example, “Clorox” and “Exxon” are coined marks for cleaning products and gasoline, respectively. Fanciful trademarks are regarded as conceptually strong marks and are equal to arbitrary marks in conceptual strength.

**Suggestive** word marks are not being as conceptually strong as arbitrary or fanciful marks. Suggestive trademarks suggest some characteristic or quality of the goods or services with which they are used. If the consumer must use her imagination or think through a series of steps to understand what the trademark is telling about the product, then the trademark does not directly describe the product’s features, but merely suggests them. For example, the trademark “Tail Wagger” for dog food merely suggests that your dog will like the food. As another example, when “apple” is used in the mark “Apple-A-Day” for vitamins, it is being used as a suggestive trademark. “Apple” does not describe what the vitamins are. However, it suggests the healthfulness of “an apple a day keeping the doctor away” with the supposed benefits of taking “Apple-A-Day” vitamins.

**Descriptive** word marks are not inherently distinctive. These marks directly describe some characteristic, or quality of the goods or services with which they are used in a straightforward way that requires no exercise of imagination. For instance, the word “apple” is descriptive when used in the trademark “CranApple” to designate a cranberry-apple juice. It directly describes one of the ingredients of the juice.

**Generic Names**. If the primary significance of an alleged mark is to name the type of product or service on offer, rather than to name the manufacturer or provider, the primary significance of the term is generic, and it cannot be a valid trademark. Such terms are known as generic names.

The word “apple” can be used as a generic name. This occurs when the word is used to identify the fruit of an apple tree. The computer maker who uses the word “apple” as a trademark to identify its personal computer, or the vitamin maker who uses that word as a trademark on vitamins, has no claim for trademark infringement against a grocer who uses that same word to indicate fruit sold in its stores. As used by the grocer, the word is generic and does not indicate any particular source of the product. As applied to the fruit, “apple” is simply a commonly used name for what is being sold. Generic names have no conceptual strength.

**Comment**

These instructions relate to the strength of a trademark in the likelihood of confusion context. For strength of trademark analysis in the context of a mark validity determination, *see* Instruction 15.10 (Infringement—Elements—Validity—Unregistered Mark—Distinctiveness). Modify this instruction as necessary in any case involving service marks, collective trade or service marks, or certification trade or service marks, by inserting such terms in lieu of the word “trademark” in this instruction. An adjustment will also be necessary when the mark consists of a designation other than a word, such as an image, package appearance or the shape of a product.

This instruction uses a two prong test of mark strength. *See* 2 J. Thomas McCarthy, Trademarks And Unfair Competition § 11:83 (4th ed. 2015); *One Industries, LLC v. Jim O’Neal Distrib., Inc*., 578 F.3d 1154, 1164, (9th Cir. 2009) (noting that after placing mark on spectrum of distinctiveness, “The second step is to determine the strength of this mark in the marketplace”); *Lahoti v. Vericheck, Inc*., 636 F.3d 501, 508, (9th Cir. 2011) (noting that strength is determined by two-part test of conceptual and commercial strength); *Pom Wonderful LLC v. Hubbard*, 775 F.3d 1118, 1126-27 (9th Cir. 2014) (“To determine the strength of Pom Wonderful’s ‘POM’ mark, we begin by placing it on the conceptual distinctiveness spectrum…. [W]e next consider whether the ‘POM’ mark has achieved sufficient marketplace recognition to transform it into a strong mark.”)

This instruction supplements Instruction 15.18 (Infringement—Elements—Likelihood of Confusion—Factors—Sleekcraft Test) by explaining how one *Sleekcraft* factor–strength of mark–is determined. This instruction describes the traditional spectrum of marks. *See, e.g.*, *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (“Marks are often classified in categories of generally increasing distinctiveness; following the classical formulation . . . [T]hey may be (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful.”); *Surfvivor*

*Media, Inc. v. Survivor* Productions, 406 F.3d 625, 631-32 (9th Cir. 2005) (noting that trademarks are divided into five categories: arbitrary, fanciful, suggestive, descriptive, and generic); *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1291 (9th Cir. 1992) (holding that strength of mark is determined by its placement on continuum of marks from “generic,” afforded no protection; through “descriptive” or “suggestive,” given moderate protection; to “arbitrary” or “fanciful” awarded maximum protection). *See also U.S. Patent and Trademark Office v. Booking.com B.V.*, 140 S. Ct. 2298, 2308 (2020) (rejecting proposition that combining generic term with “.com” yields generic composite).

The examples of the multiple uses of the word “apple” given in this instruction when used on a variety of different products are from 2 J. Thomas McCarthy, Trademarks And Unfair Competition § 11:71 (4th ed. 2015). Some of these examples are quoted with approval in *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1041 (2d Cir.1992).

For evaluating the strength of a mark in reverse confusion cases, the questions are “‘whether consumers doing business with the senior user might mistakenly believe that they are dealing with the junior user’” and what the conceptual strength of the senior mark is compared to the commercial strength of the junior mark*. Ironhawk Techs., Inc. v. Dropbox, Inc.,* 994 F.3d 1107, 1118 (9th Cir. 2021) (quoting *JL Beverage Co., LLC v. Jim Beam Brands Co*., 828 F.3d 1098, 1107 (9th Cir. 2016)).

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