

## SCOREBOARD FOR DETERMINING WHETHER SOMEONE IS INFRINGING ON YOUR TRADEMARK

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Determining whether someone is infringing on your mark (or you're infringing on theirs) is tricky. We created this scorecard to try to determine a "likelihood" or probability of infringement--as with most things in the law, there's a ton of variables. But, think of these factors as tipping the scale towards either likelihood or unlikelihood of confusion. So what we've done is create a scoring system based on the different infringement factors. All you need to do is plot the numbers given at every step on this formula below and then multiply. The higher the score the more likely it is that there is infringement; the lower, the less likely.

$$\left( \frac{\quad}{\text{Step 1}} \times \frac{\quad}{\text{Step 2}} \times \frac{\quad}{\text{Step 3}} \right) = \frac{\quad}{\text{Score}}$$

As a guide – if you get a score of 4 and above, infringement is possible. If you get 5 or higher, then infringement is likely. If you get a score between 0-3, infringement is unlikely, but it can still be smart to consult with an attorney just in case there's other factors applicable to your particular facts.

## Step 1: Do you own a bona fide Trademark?

This is the first element. You can only cry infringement if you actually own the mark or, more specifically, you have a better right to the use of that mark than the person you think is infringing on your mark. And how do you do that? It's not enough that you own the mark - it has to be a bona fide trademark (we say "trademark" but this include service marks, of course). To check ask yourself the following:

### ***Is the mark distinctive?***

Yes/No

This is the most important characteristic of a trademark: if it is not distinctive then it is not a trademark. It should identify your goods and distinguish it from the rest. It has to be able to do both. We discuss this more in the "how to make strong TMs video."

### ***Have you used it to identify your products in commerce?***

Yes/No

This use is specific: it has to be used to identify your goods. This means it can't just be on your product for aesthetic purposes, or for marketing or as part of a functional design. It's job should be particularly to identify your products. Also - it should be in products in commerce (unless you registered it with the USPTO as "intent to use."). The products you hold as inventory or sell to your buyers. It should be on those. The promotional pens, stationeries, caps and notepads don't count - they are not your business, not what people buy from you.

**Remember:**

The stronger the mark: the lower the threshold for proving infringement.

**Score:**

If you said Yes to both then put 1 on the blank for Step 1, otherwise, put 0.

## Step 2: Were you the one to use the mark first?

You should have used your mark first, otherwise, you could be the infringer (rare exception: someone else used the mark first but didn't register it; you registered it, so using the mark in areas where the person wasn't doing business won't subject you to infringement). Be sure to check when your would-be infringer started using his mark as a TM and compare it with yours. At the very least, you should be sure that you used it before he or she did.

**Remember:**

Use is specific: it must be used to identify your goods in trade! Meaning, even if the mark was used first - but not to identify goods in trade - it doesn't count. Also, obviously, you should not have authorized that party to use the mark.

**Score:** If you said Yes then put 1 on the blank for Step 2, otherwise, put 0. Unless the exception noted above applies, in which case mark this score as a 1.

## Step 3: Is there a likelihood of confusion?

Compare your mark and the suspected infringing mark, to see if the latter one creates a likelihood of confusion. This is tricky, so ask yourself the following questions to check.

### ***Are the products related?***

Your products don't have to be the same. But the real question is -- will the buyer think they came from the same company. So, they don't have to be relating to the exact same products -- they can also be just related in scenarios like the ones listed below:

- Goods may be related to services if they are used in connection with services
- They are in the same family or range of products

- One is in a category which is where the other could possibly naturally expand

Factor 1

1 - not related, 2 - related

### ***How similar are the marks?***

When looking at this factor, remember that we are not looking at any one particular element of either marks, rather, we're looking at the "general impression" the buyer gets.

Imagine the logo on your favorite brand of soap: you don't have the logo memorized but you'll recognize if you see it, right? What you remember of that logo - enough to recognize it next time you see it - that's what we're examining.

When comparing the marks look at the following:

- Is the dominant part (what you would remember about the mark) of the marks are the same or similar?

- Do they mean the same thing? (in terms of connotation, meaning, or translation)

- If you read them aloud (when applicable), do they sound similar or the same?

o Do they contain the same words or characters rearranged?

Factor 2: 0 - not at all similar, 1 - somewhat similar, 2 - very similar to identical.

*Start with* Multiply Factors 1 and 2

***Do people just grab your product and go rather than study and think about it before buying?***

The more time the usual buyers spend studying or thinking about the purchase, the harder it will be for them to get confused, hence the less likely the confusion. Then there are products like those you don't even look at when you throw into the cart - for those, the likelihood of confusion arises much easier. For example -- if you're buying a car, you'll spend a lot more time studying the details of the purchase than you would buying a pack of gum.

*Add:* 2 - impulse buy/ don't really care, 1 - they check the labels/brand, 0 - think about it long and hard

***Is your mark famous?***

More famous marks are given more protection. The marks don't have to be as similar for there to be infringement if the mark is famous. If the mark's famous, you won't necessarily have to prove that the level of similarity causes likelihood of confusion; instead, you can just show that people are making money off of simply associating their products with yours. Good example, Charbucks was found to be infringing on "Starbucks" because the latter was famous. Same with "South Butt" and "North Face."

*Note: Famous here means famous in the area where you want to stop the infringement.*

**Add:** If you said Yes then put 1, otherwise, put 0.

### Has anybody already gotten confused?

Lastly, if you know of people – those who would typically buy your product – that's a strong indicator as well of the likelihood of confusion especially if you need to sue later on.

**Add:** If you said Yes then put 1, otherwise, put 0.

### Remember:

If the products are closely enough related to create a likelihood of confusion, the similarity in marks doesn't matter as much. If the products are not as close, then you'll need to show a higher degree of similarity.

**Score:** Put the total in the blank for step 3.