

GIBSON v. PRS: THE APPLICABILITY OF THE INITIAL
INTEREST CONFUSION DOCTRINE TO TRADEMARKED
PRODUCT SHAPES

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I. INTRODUCTION

A prospective customer peers through the front window of a guitar shop. Although she cannot yet determine the brand and model, she is almost certain that she sees an electric guitar on the back wall. In fact, the shape of the guitar is familiar and she believes that it is a famous model she has read about in magazines. She enters the shop and heads to the rear of the store to inquire about the guitar. However, upon close inspection she realizes that the instrument is not the famous guitar from the magazines, but rather is a similarly shaped model from a different brand entirely.

Should the manufacturer of the similarly shaped guitar be liable for trademark infringement to the manufacturer of the famous guitar who owns a trademark in the shape of its product? If so, is it significant to the trademark holder's claim that the customer mistakenly believed that the guitar she observed through the window was the famous model, even though she was not close enough to make out the shape for certain? Should the manufacturer of the similarly-shaped guitar be prevented from producing a guitar in a shape that would cause confusion when

viewed from such a distance?

These are the issues that the Court of Appeals for the Sixth Circuit faced in *Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP*.¹ Specifically, the court considered whether the shape of Paul Reed Smith's ("PRS") "Singlecut" model guitar infringed the trademark obtained by Gibson Guitar Corp. ("Gibson") on the shape of their "Les Paul" model. In doing so, the court had to determine whether the initial interest confusion doctrine was the appropriate doctrine to apply in a product shape trademark infringement suit.² This Note will focus primarily on the majority's rejection and the dissent's application of the initial interest confusion doctrine to trademarked product shapes under the facts of the case. This Note argues that the majority did not correctly apply the initial interest confusion doctrine in its infringement analysis, which led it to reject the doctrine's application. This Note further contends that to appropriately apply the initial interest doctrine in a product shape infringement suit, it is essential to determine and take into account the distance at which an ordinary consumer with ordinary vision can clearly see the trademarked shape.

After concluding that Sixth Circuit case law did not dictate application of the initial interest confusion doctrine,³ the majority held that application of the doctrine would grant holders of trademarks in product shapes too much protection and prevent legitimately similar products from competing in the marketplace.⁴ Accordingly, the court found that under the facts of this case, initial interest confusion could not be substituted for point of sale confusion.⁵ The dissent argued that the majority's concern about preventing competition was "misplaced" because "[e]vidence that a competitor's product shape is similar to a trademark holder's product shape when viewed from afar is irrelevant unless the product shape trademark holder maintains that its product shape identifies its source when viewed from afar."⁶ The majority, however, criticized the dissent's application of the initial interest doctrine to the facts of the case as a "needlessly complicated and unworkable inquiry."⁷

¹ *Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP*, 423 F.3d 539 (6th Cir. 2005), *cert. denied*, 126 S. Ct. 2355 (2006).

² *Id.* at 548-49.

³ *Id.* at 550-51.

⁴ *Id.* at 552.

⁵ *Id.*

⁶ *Id.* at 555 (Kennedy, J., concurring in part, dissenting in part).

⁷ *Id.* at 550 n.15 (majority opinion). The majority continued its critique by adding: Particularly when the product is sold by many diverse retailers with varying display styles and store configurations, it would seem to require the district court to conduct an initial hearing as to whether each instance of alleged initial-interest confusion is admissible. As consumers will often observe a product from

Despite legitimate criticism, the dissent correctly recognized that the distance from which a trademarked shape is viewed must be considered when applying the initial interest confusion doctrine to product shape infringement suits. However, the dissent incorrectly focused on the distance at which the trademark holder believes that his product's shape identifies the source of the product. Instead, the distance should be determined from the point at which an ordinary consumer with ordinary vision can clearly see the product's shape. This distance can be used in conjunction with a witness' testimony to determine if the confusion occurred at a point in which an ordinary person could clearly see the object in question, or at some point farther than that. In addition, this information could be used in a consumer survey to show evidence of actual confusion.

Underlying the Sixth Circuit's decision to apply point of purchase confusion over initial interest confusion was its belief that the initial interest doctrine should not be applied in instances where competitors would be prevented from producing legitimately competing products.⁸ However, taking this principle too far could lead to an unnecessary limitation on future applications of the initial interest doctrine. For example, if the initial interest doctrine should not be applied in product shape trademark cases due to the limited number of shapes in which a product can be made,⁹ it could also be argued that the doctrine should not be applied to internet related cases involving the use of trademarks in the metatags of websites that are not operated by the trademark holder because there are only a limited number of ways in which a web designer can inform web users that their site is somehow related to the trademarked product or service.¹⁰ Therefore, taking the court's holding to its extreme would not only limit future applications, but would in fact conflict with past holdings of many circuits who have adopted the doctrine of initial

multiple different locations, it seems difficult to determine in any non-arbitrary manner what observation distances are appropriate when considering whether a given product shape creates initial-interest confusion (e.g., in front of the product shelf, from a store aisle, from the store's front door, etc.).

Id.

⁸ *See id.* at 552. Although the court explicitly limited its holding to the facts of the case, it stated "we are unable to imagine such a situation at this juncture" where the initial interest confusion doctrine could be appropriately applied to a product shape trademark. *Id.* at 551.

⁹ *Id.* at 550 n.15.

¹⁰ As one commentator has argued, "[d]irect competitors need to be able to mention a competitor's trademark. Such comparative advertisements and commentary are necessary for fair competition, promotion of consumer interests and free speech." Jennifer E. Rothman, *Initial Interest Confusion: Standing at the Crossroads of Trademark Law*, 27 CARDOZO L. REV. 105, 185 (2005).

interest confusion in the context of the internet¹¹ and, as a result, would require a serious re-examination of the use of the initial interest confusion doctrine.¹²

To preserve the doctrine and its underlying principles, the majority should not have rejected its application so quickly. The majority's reluctance to over-broaden the doctrine's application is valid to a point. In fact, scholars have noted that to comply with the Lanham Act, likelihood of confusion, not merely an initial interest in the product, must be shown.¹³ However, the use of the initial interest confusion doctrine is important because it prevents a competitor from using deceptive practices and "confusion to generate initial interest in its own product."¹⁴ This preventive measure preserves the two principles behind the Lanham Act, which are to "protect consumers against confusion, and therefore reduc[e] [their] decision making costs," and to "protect an owner's interest in its mark, thereby ensuring an opportunity to reap the financial and goodwill benefits associated with desirable

¹¹ See, e.g., *PACCAR Inc. v. TeleScan Techs., L.L.C.*, 319 F.3d 243, 253 (6th Cir. 2003), *overruled in part by* *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004); *Eli Lilly & Co. v. Natural Answers, Inc.*, 233 F.3d 456, 464 (7th Cir. 2000); *Brookfield Commc'ns, Inc. v. West Coast Entm't Corp.*, 174 F.3d 1036, 1062 (9th Cir. 1999); Rothman, *supra* note 10, at 109. *But see, e.g.*, Michael Grynberg, *The Road Not Taken: Initial Interest Confusion, Consumer Search Costs, and the Challenge of the Internet*, 28 SEATTLE U. L. REV. 97, 135-36 (2004) (noting the tension that results when courts find trademark infringement by applying initial interest confusion to internet-related cases, but where no such infringement would be found in the "real world"); Chad J. Doellinger, *Recent Developments In Trademark Law: Confusion, Free Speech And the Question of Use*, 4 J. MARSHALL REV. INTELL. PROP. L. 387, 398 (2005) (noting that at least one commentator has argued that the courts have "wrongly decided an entire line of initial-interest confusion cases"); Rothman, *supra* note 10, at 168-70 (criticizing the line of internet-related initial interest confusion cases).

¹² See, e.g., Rothman, *supra* note 10, at 179-83 (arguing that the initial interest confusion doctrine should be reformed by reclaiming the pre-sale confusion doctrine, the application of which "consider[s] only reasonably prudent potential purchasers," and refuses to allow "de minimis pre-sale confusion to be actionable").

¹³ See generally *id.* Rothman argues that one of the causes of the overly-broad application of the initial interest confusion doctrine is improper terminology, and suggests that courts should eliminate the term "initial interest" and instead use the term "pre-sale" confusion. *Id.* at 180; see also Robert M. Kunststadt & Ilaria Maggioni, *Tell Tchaikovsky the News: Trade Dress Rights in Musical Instruments*, 94 TRADEMARK REP. 1271, 1289-90 (2004) (noting that "recognizing a particular guitar as having a LES PAUL pattern is not the same thing as recognizing it as being a guitar that originated with Gibson as the source of origin. To equate the two would be a logical fallacy similar to saying that because a violin has a Stradivarius pattern, it must have been made by Stradivarius.").

However, in *Gibson*, the court recognized that Gibson's expert was confused when he saw the guitar on the wall and believed he was viewing a Les Paul, when in fact he was not. *Gibson*, 423 F.3d at 552. It was not the case that the observer noticed a guitar that looked similar to the Les Paul, and was interested due to its similarity to a Les Paul, while knowing it was not actually a Les Paul. Instead, the observer in this case was initially confused when he first saw the guitar.

¹⁴ Joseph V. Marra, *Playboy Enterprises, Inc. v. Netscape Communications Corp.: Making Confusion a Requirement for Online Initial Interest Confusion*, 20 BERKELEY TECH. L.J. 209, 211 (2005).

products.”¹⁵

In Part II of this Note, I will provide a background of the Lanham Act and the development of the initial interest confusion doctrine. In Part III, I will provide the factual background of the case, including the history of the companies, a description of the guitars involved, and an analysis of the district court’s decision. In Part IV, I will discuss the majority and dissenting opinions from the Sixth Circuit’s decision. In Part V, I will critique both the majority and dissenting opinions in *Gibson v. PRS*. I will then propose a new standard for analyzing trademark infringement claims on product shapes, which should be based on whether an ordinary consumer with ordinary vision will be confused as to the source of the product shape when he first clearly perceives the shape. In Part VI, I will consider the future implications of *Gibson v. PRS*. In conclusion, I will argue that using my proposed standard will allow the initial interest confusion doctrine to be applied in appropriate circumstances, and will greatly reduce the ability of a manufacturer to free ride on a trademarked product shape.

II. BACKGROUND

A. *The Lanham Act*

Trademark law has two primary purposes: “to secure to the owner of the mark the goodwill of his businesses and to protect the ability of consumers to distinguish among competing producers.”¹⁶ The Lanham Act provides a cause of action against:

Any person who shall, without the consent of the registrant . . . [either] use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is *likely to cause confusion*, or to cause mistake, or to deceive; or . . . reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use *is likely to cause confusion*, or to cause mistake or to deceive[.]¹⁷

¹⁵ *Id.* at 210. See also *Qualitex Co. v. Jacobson Prod. Co.*, 514 U.S. 159, 164 (1995).

¹⁶ *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985).

¹⁷ 15 U.S.C. § 1114(1) (2006) (emphasis added).

In order to prevail on a Lanham Act claim for infringement, a trademark holder must first demonstrate that she owns a valid mark, and thus a protectable interest.¹⁸ Second, she must prove “that the alleged infringer’s use of the mark ‘is likely to cause confusion, or to cause mistake, or to deceive.’”¹⁹ Trademarks are divided into five categories: (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; and (5) fanciful.²⁰ Marks that are “suggestive,” “arbitrary,” or “fanciful” are deemed inherently distinctive and are automatically entitled to protection.²¹ A descriptive mark, however, which is not inherently distinctive, is entitled to protection only if the owner can show that it has “become distinctive of the applicant’s good in commerce,” and thus has acquired a “secondary meaning.”²² In contrast, a generic mark, one that “refer[s] to the genus of which the particular product is a species— [is] not registrable as [a] trademark[.]”²³ As to the second prong of the infringement test, whether or not the use of a mark is likely to cause confusion, different circuits apply their own multi-factor tests.²⁴ Although the factors applied vary between the circuits, “there is little substantive variation among the tests.”²⁵

B. *The Initial Interest Confusion Doctrine*

As previously discussed, one of the necessary elements for a claim of trademark infringement is the showing of a “likelihood of confusion.”²⁶ In order to satisfy this prong, courts have utilized a

¹⁸ *KP Permanent Make-up, Inc. v. Lasting Impression I, Inc.*, 408 F.3d 596, 602 (9th Cir. 2005) (citing 15 U.S.C. § 1114(1); *Tie Tech, Inc. v. Kinedyne Corp.*, 296 F.3d 778, 783 (9th Cir. 2002); *Thane Int’l, Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 900 (9th Cir. 2002)).

¹⁹ *KP Permanent Make-up*, 408 F.3d at 602 (quoting 15 U.S.C. § 1114(1) (a)-(b)).

²⁰ *Id.*

²¹ *See id.*; *Two Pesos v. Taco Cabana*, 505 U.S. 763, 768 (1992) (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976)).

²² *See Two Pesos*, 505 U.S. at 769.

²³ *Id.* (quoting *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985)).

²⁴ Grynberg, *supra* note 11, at 102. *See, e.g.*, the eight *Polaroid* factors of the Second Circuit, *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492 (2d Cir. 1961), the ten *Lapp* factors in the Third Circuit, *Interpace Corp. v. Lapp, Inc.*, 721 F.2d 460 (3d Cir. 1983), the eight *Frisch* factors in the Sixth Circuit, *Frisch’s Rests. v. Elby’s Big Boy*, 670 F.2d 642 (6th Cir. 1982), the seven *Helene Curtis* factors of the Seventh Circuit, *Helene Curtis Indus., Inc. v. Church & Dwight Co.*, 560 F.2d 1325 (7th Cir. 1977), the six *SquirtCo* factors of the Eighth Circuit, *SquirtCo v. Seven-Up Co.*, 628 F.2d 1086 (8th Cir. 1980), and the eight *Sleekcraft* factors of the Ninth Circuit, *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979). *See generally* 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 24:30-24:43 (4th ed. 2006).

²⁵ Note, *Confusion in Cyberspace: Defending and Recalibrating the Initial Interest Confusion Doctrine*, 117 HARV. L. REV. 2387, 2410 n.27 (2004) (citations omitted). For example, “a majority of the circuits consider the following factors in one form or another: the strength of the plaintiff’s mark, evidence of actual confusion, and the sophistication of relevant customers of the product.” *Id.*

²⁶ 15 U.S.C. § 1114(1) (2006).

number of confusion doctrines including: (1) post-sale confusion; (2) point-of-sale confusion; and (3) pre-sale, or initial interest confusion.²⁷ The initial interest confusion doctrine was first recognized in *Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*,²⁸ and has since been justified on the theory that “[a] junior user should not free ride on [a] senior user’s goodwill as a means of getting his foot in the door with prospective customers.”²⁹ “Initial-interest confusion takes place when a manufacturer improperly uses a trademark to create initial customer interest in a product, even if the customer realizes, prior to purchase, that the product was not actually manufactured by the trademark-holder.”³⁰ *Grotrian*, along with the cases discussed below, provide a background of the development of the initial interest confusion doctrine, and how it has been applied in various circuits.

Like *Gibson*, *Grotrian* was also a case involving musical instruments. Steinway & Sons was a piano-making business founded in New York in 1850 by Heinrich E. Steinweg after he emigrated from Germany.³¹ Theodor Steinweg, his son, remained in Germany for a few years and ran his own piano production business, but later joined his father’s company in 1866 after he sold the business to Wilhelm Grotrian, Adolph Helfferich, and H.G.W. Schulz.³² The new owners changed the name of the company to “Grotrian, Helfferich, Schulz, Th. Steinweg Nachf.”³³ Grotrian then registered the trademarks “Grotrian-Steinweg” and “Steinweg”³⁴ in Germany, and eventually began exporting its pianos under the mark and company name “Grotrian-Steinweg” to the United States.³⁵ Steinway opposed the application of the “Grotrian-Steinweg” mark in the United States, and Grotrian responded by seeking a declaratory judgment that “Grotrian’s use

²⁷ See, e.g., *Malletier v. Burlington Coat Factory Warehouse Corp.*, 426 F.3d 532, 537 n.2 (2d Cir. 2005) (“The Lanham Act protects against several types of consumer confusion, including *point-of-sale* confusion, *initial interest* confusion, and *post-sale* confusion. . . .”) (citations omitted). See also Julieta L. Lerner, *Trademark Infringement and Pop-up Ads: Tailoring the Likelihood of Confusion Analysis to Internet Uses of Trademarks*, 20 BERKELEY TECH. L.J. 229, 236 (2005) (“Likelihood of confusion can exist at the point of sale, or at a point prior or subsequent to the sale.”).

²⁸ *Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*, 523 F.2d 1331 (2d Cir. 1975).

²⁹ Grynberg, *supra* note 11, at 98.

³⁰ *Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP*, 423 F.3d 539, 550 (6th Cir. 2005), *cert. denied*, 126 S. Ct. 2355 (2006) (citations omitted).

³¹ *Grotrian*, 523 F.2d 1331.

³² *Id.* at 1334.

³³ *Id.*

³⁴ The “Steinweg” mark was cancelled in Germany when Steinway brought suit against Grotrian. *Id.* However, German officials granted Grotrian’s petition to change its name to “Grotrian-Steinweg.” *Id.*

³⁵ *Id.*

of its trademark and corporate name in the United States d[oes] not infringe Steinway's trademark rights and d[oes] not constitute unfair competition."³⁶ Steinway counterclaimed under multiple sections of the Lanham Act, seeking to enjoin Grotrian from using its mark in the United States.³⁷ The district court granted a permanent injunction against Grotrian on the ground that the use of "Grotrian-Steinweg" was likely to cause confusion, and, therefore, infringed the "Steinway" and "Steinway & Sons" marks.³⁸ On appeal, the Second Circuit upheld the district court's finding of likelihood of confusion, noting that although the marks are visually distinct from one another, "[t]he examination of the similarity of the trademarks . . . does not end with a visual comparison of the marks. Trademarks, like small children, are not only seen but heard. Similarity of sound also enters into the calculation of likelihood of confusion."³⁹ In so holding, the Second Circuit focused not on the likelihood that a customer would *purchase* a Grotrian-Steinweg with the mistaken belief that he was buying a Steinway, but rather on "the likelihood that a consumer, hearing the 'Grotrian-Steinweg' name and thinking it had some connection with 'Steinway', would consider it on that basis. The 'Grotrian-Steinweg' name therefore would attract potential customers based on the reputation built up by Steinway in this country for many years."⁴⁰ The court held that the district court's finding of actual confusion was supported by substantial evidence because the intended purchaser of the pianos at issue, "upon hearing the name 'Grotrian-Steinweg', would associate Grotrian's product with Steinway."⁴¹ The court declined to hold

³⁶ *Id.* at 1334-35. Grotrian began selling pianos in the United States in 1925, and between 1926 and 1928 had sold a total of twenty-five pianos. *Id.* at 1334. Although Steinway demanded that Grotrian stop doing business in the United States because of its claim that the mark "Grotrian-Steinweg" infringed on the trade names "Steinway" and "Steinway & Sons," Grotrian increased its shipments to forty-seven pianos in 1929. *Id.* A settlement agreement between the two parties reduced the amount of business Grotrian conducted in the United States until 1952 when Grotrian began conducting business in the United States on a mail order basis. *Id.* Grotrian continued to regularly export a small number of pianos to the United States for approximately twenty years. Then, in 1967, Grotrian entered into a five-year distribution agreement with the Wurlitzer Company. *Id.* Steinway threatened Wurlitzer with legal action if they continued to distribute the Grotrian-Steinweg pianos. *Id.* As a result, Wurlitzer cancelled the distribution agreement, which led to Grotrian seeking the declaratory judgment. *Id.* at 1334-35.

³⁷ *Id.* at 1335.

³⁸ *Id.*

³⁹ *Id.* at 1339-40 (citing *LaTouraine Coffee Co. v. Lorraine Coffee Co.*, 157 F.2d 115, 117 (2d Cir. 1946)); accord *David Sherman Corp. v. Heublein, Inc.*, 340 F.2d 377, 380 (8th Cir. 1965)).

⁴⁰ *Id.* at 1342.

⁴¹ *Id.* at 1340. The court noted several instances of confusion. For example, an American Grotrian dealer represented to a Steinway dealer that the "*Grotrian-Steinweg was a German Steinway.*" *Id.* at 1339 (citing *Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v.*

“that actual or potential confusion *at the time of purchase* necessarily must be demonstrated to establish trademark infringement under the circumstances of this case.”⁴²

In *Mobil Oil Corp. v. Pegasus Petroleum*,⁴³ the Second Circuit again recognized the initial interest confusion doctrine⁴⁴ and applied it in its multi-factor test for likelihood of confusion.⁴⁵ The plaintiff, Mobil Oil, was a large corporation that manufactured and sold oil to both industrial consumers and to the public.⁴⁶ For over fifty years, Mobil had used the mark of a “flying horse,” which represented “Pegasus, the winged horse of Greek Mythology.”⁴⁷ Mobil was also in the business of buying and selling crude and refined oil in bulk,⁴⁸ although it did not use its flying horse mark in its oil trading business.⁴⁹ The defendant, Pegasus Petroleum, was incorporated in 1981, and participated solely in the business of oil trading.⁵⁰ Although the defendant had neither used a mark similar to Mobil’s flying horse symbol, nor sold any products labeled with the word “Pegasus,”⁵¹ the court found trademark infringement under the Lanham Act.⁵² The court applied the initial interest confusion doctrine under the “actual confusion” factor of the *Polaroid* test for likelihood of confusion.⁵³ The court explained:

[The district court] found a likelihood of confusion not in the fact that a third party would do business with Pegasus Petroleum believing it related to Mobil, but rather in the likelihood that Pegasus Petroleum would gain crucial credibility during the initial phases of a deal. For example, an oil trader might listen to a cold phone call from Pegasus Petroleum . . .

Steinway & Sons, 365 F. Supp. 707, 716 (S.D.N.Y. 1973)). On another occasion, a customer was confused when a Grotrian dealer referred to the piano as “the original Steinway” and “the German Steinway.” *Id.* at 1341.

⁴² *Id.* at 1342.

⁴³ *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254 (2d Cir. 1987).

⁴⁴ *Id.* at 260 (citing *Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*, 523 F.2d 1331, 1342 (2d Cir. 1975)).

⁴⁵ The Second Circuit follows the likelihood of confusion test defined in *Polaroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492, 495 (2d Cir. 1961), which includes the following eight non-exclusive factors: (1) the strength of the plaintiff’s mark; (2) the degree of similarity between the two marks; (3) the competitive proximity of the products or services; (4) the existence of actual confusion; (5) the likelihood that the plaintiff will “bridge the gap” between the two markets; (6) the defendant’s good faith in adopting its mark; (7) the quality of the defendant’s product; and (8) the sophistication of the purchasers.

⁴⁶ *Mobil Oil Corp.*, 818 F.2d at 255.

⁴⁷ *Id.*

⁴⁸ *Id.* at 256.

⁴⁹ *Id.*

⁵⁰ *Id.*

⁵¹ *Id.*

⁵² *Id.* at 260.

⁵³ *Id.* at 259.

when otherwise he might not, because of the possibility that Pegasus Petroleum is related to Mobil.⁵⁴

While the court did find that this instance of initial confusion constituted “actual confusion” in favor of Mobil, ultimately, initial interest confusion was just one of many factors that the court considered.⁵⁵

Likewise, the Fifth Circuit also applied initial interest confusion under the actual confusion factor of its likeliness of confusion analysis in *Elvis Presley Enterprises v. Capece*.⁵⁶ The plaintiff, Elvis Presley Enterprises, Inc. (“EPE”), had registered trademarks for “Elvis Presley” and “Elvis.”⁵⁷ The defendant opened a nightclub named “The Velvet Elvis” in Houston, Texas and registered “The Velvet Elvis” as a service mark for “restaurant and tavern services.”⁵⁸ The club closed less than two years later⁵⁹ but reopened the next year in a new Houston location.⁶⁰ EPE filed claims of trademark infringement and dilution.⁶¹ Witnesses testified that, based on the name “The Velvet Elvis,” they believed defendant’s bar was associated with Elvis Presley.⁶² However, once they entered the bar, they realized that they were mistaken.⁶³ Counter to the district court’s ruling,⁶⁴ the Fifth Circuit held that the witnesses’ initial confusion could be considered under the actual confusion factor, citing *Mobil Oil* for the proposition that a finding of initial interest confusion is grounds for infringement.⁶⁵ The court reasoned:

Despite the confusion being dissipated, this initial-interest confusion is beneficial to the Defendants because it brings patrons in the door; indeed, it brought at least one of EPE’s witnesses into the bar. Once in the door, the confusion has succeeded because some patrons may stay, despite realizing that the bar has no relationship with EPE.⁶⁶

Like in *Mobil Oil*, initial interest confusion was applied as part

⁵⁴ *Id.*

⁵⁵ *Id.* at 257-60.

⁵⁶ *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 203-04 (5th Cir. 1998).

⁵⁷ *Id.* at 191. EPE not only had the above-mentioned trademarks, but also owned the trademarks, copyrights, and publicity rights of the entire Elvis Presley estate. *Id.*

⁵⁸ *Id.*

⁵⁹ *Id.* at 191-92.

⁶⁰ *Id.*

⁶¹ *Id.* In addition to using the word “Elvis” in the name of its nightclub, the defendant also made references to Elvis Presley in items such as paintings, menus, advertising, and other decorations. *Id.* at 192. The district court ruled in favor of EPE on all of its claims except for those against the use of “The Velvet Elvis” mark. *Elvis Presley Enters., Inc. v. Capece*, 950 F. Supp. 783, 796-97 (D. Tex. 1996), *rev’d*, 950 F. Supp. 783 (5th Cir. 1998).

⁶² *Id.* at 204.

⁶³ *Id.*

⁶⁴ *Id.* at 195.

⁶⁵ *Id.* at 204.

⁶⁶ *Id.* (footnote omitted).

of the multi-factor likeliness of confusion analysis. After considering all such factors, the court reversed the district court and found defendant liable for the use of “The Velvet Elvis.”⁶⁷

In *Brookfield Communications v. West Coast Entertainment Corp.*,⁶⁸ the Ninth Circuit applied the initial interest confusion doctrine to a case involving the use of metatags on the internet.⁶⁹ Brookfield Communications gathered and sold entertainment industry information using the mark “MovieBuff.”⁷⁰ Shortly after Brookfield registered the mark, West Coast Video announced plans to launch a website under the domain name “moviebuff.com,” which would be used to provide information regarding movies to the public as well as provide them with the ability “to purchase movies, accessories, and other entertainment-related merchandise”⁷¹ West Coast had registered the domain name prior to Brookfield’s registration of the mark.⁷² Brookfield brought suit claiming trademark infringement and unfair competition.⁷³ The court ruled that although “it is difficult to say that a consumer is likely to be confused about whose site he has reached West Coast’s use of ‘moviebuff.com’ in metatags will still result in what is known as initial interest confusion.”⁷⁴ The court continued:

Web surfers looking for Brookfield’s “MovieBuff” products who are taken by a search engine to “westcoastvideo.com” will find a database similar enough to “MovieBuff” such that a sizeable number of consumers who were originally looking for Brookfield’s product will simply decide to utilize West Coast’s offerings instead. Although there is no source confusion in the sense that consumers know they are patronizing West Coast rather than Brookfield, there is nevertheless initial interest

⁶⁷ *Id.* at 207.

⁶⁸ *Brookfield Commc’ns, Inc. v. West Coast Entm’t Corp.*, 174 F.3d 1036 (9th Cir. 1999).

⁶⁹ *Id.*

Metatags are HTML code intended to describe the contents of [a] web site. There are different types of metatags, but those of principle concern to us are the “description” and “keyword” metatags. The description metatags are intended to describe the web site; the keyword metatags, at least in theory, contain keywords relating to the contents of the web site. The more often a term appears in the metatags and in the text of the web page, the more likely it is that the web page will be “hit” in a search for that keyword and the higher on the list of ‘hits’ the web page will appear.

Id. at 1045 (citing *Niton Corp. v. Radiation Monitoring Devices, Inc.*, 27 F. Supp. 2d 102, 104 (D. Mass. 1998)).

⁷⁰ *Id.* at 1041.

⁷¹ *Id.* at 1042-43.

⁷² *Id.* at 1042. West Coast claimed that they chose the domain name “moviebuff.com” because it is part of their service mark “The Movie Buff’s Movie Store,” which West Coast registered prior to Brookfield’s registration. *Id.*

⁷³ *Id.* at 1043.

⁷⁴ *Id.* at 1062.

confusion in the sense that, by using “moviebuff.com” or “MovieBuff” to divert people looking for “MovieBuff” to its website, West Coast improperly benefits from the goodwill that Brookfield developed in its mark.⁷⁵

The *Brookfield* court’s reasoning was in line with the prior holdings of *Steinweg* and *Elvis Presley Enterprises*, which were based on the idea that using another’s protected trademark to get one’s foot in the door is a violation of the Lanham Act. Also, although none of these courts specifically addressed the issue, it is important to note that each court seemed to assume during their initial interest confusion analysis that the allegedly infringing marks were clearly comprehended and understood by the allegedly confused consumer. As I will argue, this is essential in initial interest confusion analysis, and, in the case of product shape infringement suits, occurs at the point in which a consumer with ordinary vision first clearly views the shape in question.

III. THE COMPANIES, THEIR GUITARS, AND A LAWSUIT

A. *The Companies*

Gibson has been in the musical instrument manufacturing business for over 100 years.⁷⁶ In 1935, Gibson introduced its first electric guitar pickup,⁷⁷ and in 1936, shipped its first electric guitar, the ES-150.⁷⁸ This first model was played by Jazz great Charlie Christian, and its pickup is still considered by some Jazz players “to be the best Jazz pickup ever made.”⁷⁹ Gibson continued to be at the cutting edge of the guitar manufacturing industry; in 1946, it introduced the P-90 pickup, and in 1949, it introduced the first three-pickup guitar, called the ES-5, and “the first guitar with a sharply pointed cutaway bout,” called the ES-175.⁸⁰ In 1952, Gibson introduced its first Les Paul model, a solid-body, single-cutaway electric guitar.⁸¹

⁷⁵ *Id.*

⁷⁶ *Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP*, 423 F.3d 539, 543 (6th Cir. 2005), *cert. denied*, 126 S. Ct. 2355 (2006).

⁷⁷ According to Henry Juskiewicz, Gibson’s CEO, a pickup is an “electro magnetic transducer that captures the motion of the strings in a magnetic field and therefore, turns it into an analog sound signal.” *Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP*, 311 F. Supp. 2d 690, 710 (M.D. Tenn. 2004), *rev’d*, 423 F.3d 539 (6th Cir. 2005), *cert. denied*, 126 S. Ct. 2355 (2006) (quoting Juskiewicz deposition Tr. 19: 25-26).

⁷⁸ Gibson.com, *The Gibson Story: The First Electrics*, <http://www.gibson.com/AboutUs/> (follow “The Gibson Story” hyperlink; then follow “First Gibson Electrics” hyperlink) (last visited Aug. 23, 2006).

⁷⁹ *Id.*

⁸⁰ Gibson.com, *The Golden Age Of Innovation*, <http://www.gibson.com/AboutUs/> (follow “The Gibson Story” hyperlink; then follow “Golden Age of Innovation” hyperlink) (last visited Aug. 23, 2006).

⁸¹ *Gibson*, 423 F.3d at 543.

Paul Reed Smith Guitars, on the other hand, is relatively new to the guitar manufacturing business. Its founder, Paul Reed Smith, “began manufacturing custom guitars in the mid-1970s and opened a guitar factory in 1985.”⁸²

B. *The Guitars*

The Les Paul model guitar:

is a traditionally shaped guitar with a portion removed from [the] body of the guitar where the lower section of the fingerboard meets the body of the guitar. The term “cutaway guitar” denotes that portion of the guitar between the neck and its lower[] part, that appears to be missing from the natural, rounded body contour. The removal of this portion forms what is often referred to as the “horn.” One aspect of this horn design is that the musician can access higher strings [and] positions.

As to other parts of a guitar, a pickup selector switch allows the player to change quickly the electromagnetic inputs to any one of three options: the pickup closest to the neck (the “neck pickup”), the one furthest from the neck (the “bridge pickup”), or a combination of both. The combination of volume and tone knobs for each pickup[] allows the player to set the tone and volume of each pickup and[] switching among these pickups can achieve different sounds.⁸³

PRS introduced its “Singlecut” model guitar in 2000.⁸⁴ The following features distinguish the Singlecut from the Les Paul:

[A] longer [] scale length, a lack of binding (contrasting color striping around the body and neck), different headstock colors, a vertical instead of horizontal logo on the headstock, no pickguard, a one-piece bridge, no ring around the toggle switch, a belly carve in the back, a contoured neck joint (as opposed to a right angle), a thinner body, a significantly different outside shape, and a differently shaped truss rod cover.⁸⁵

In an effort to aid consumers in identifying PRS as the source of the “Singlecut,” PRS claimed to have

included such characteristic and source-indicating PRS features as [their] own characteristic three-dimensional “scoop” in the cutaway portion of the guitar body, the PRS trademarked headstock shape, the PRS logo on the headstock, distinctive

⁸² *Id.*

⁸³ *Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP*, 311 F. Supp. 2d 690, 694-95 (M.D. Tenn. 2004) (quotation marks and footnote omitted), *rev’d*, 423 F.3d 539 (6th Cir. 2005), *cert. denied*, 126 S. Ct. 2355 (2006).

⁸⁴ *Id.* at 701.

⁸⁵ *Id.* at 702.

PRS bird inlay on the fretboard, and accompanying materials such as tags that hang from the guitar when it is displayed for sale.⁸⁶

C. *The District Court Decision*

1. Procedural History

In March of 2000, Gibson sent a cease and desist letter to PRS asserting that PRS's "Singlecut" guitar infringed Gibson's trademark and trade dress rights in its "Les Paul" model guitar, and also alleging unfair competition and false advertising claims.⁸⁷ PRS failed to comply with their demands and Gibson filed suit under multiple sections of the Lanham Act in the United States District Court for the Middle District of Tennessee, Nashville Division, claiming that PRS's "Singlecut" model guitar infringed the registered trademark of Gibson's "Les Paul" single-cutaway guitar.⁸⁸ PRS filed a counterclaim seeking a declaration that Gibson's alleged trademark and trade dress in its "Les Paul" model were unenforceable, and, alternatively, that even if they were enforceable, that Gibson did not infringe the trademark or trade dress.⁸⁹ The district court considered motions for partial summary judgment from both parties.⁹⁰ In its motion for summary judgment, Gibson claimed that PRS's "Singlecut" guitar infringed the trademark of Gibson's "Les Paul" model and that the "Singlecut" model would likely cause consumer confusion to the detriment of Gibson.⁹¹ PRS sought summary judgment on all of Gibson's claims and its counterclaims, asserting that the PRS "Singlecut" guitar did not infringe Gibson's trademarked "Les Paul" model, and that there was no evidence of actual consumer confusion as to the origin of the guitars at issue.⁹²

2. Findings of Fact

After reviewing the history of both companies and their guitars, the court heard evidence pertaining to the guitar market and the issue of consumer confusion. The court found that Gibson's "Les Paul" and PRS's "Singlecut" are both high end

⁸⁶ *Id.* at 701.

⁸⁷ *Id.* at 710-11.

⁸⁸ *Id.* at 692-93. In addition to its trademark infringement claim, Gibson also asserted claims for counterfeiting, unfair competition, and trademark dilution. *Id.*

⁸⁹ *Id.* at 693.

⁹⁰ *Id.*

⁹¹ *Id.*

⁹² *Id.* In its motion for summary judgment, PRS alternatively argued that Gibson's trademark was invalid, fraudulently-obtained, abandoned, and that Gibson's claims should be barred due to the functional and generic design of the guitar. *Id.*

guitars that directly compete in the market, and that the companies have similar marketing strategies.⁹³ An expert witness for PRS testified that prospective buyers of these high end guitars do not buy on impulse, but instead research before making their final decision as to which guitar to purchase.⁹⁴

The court next heard testimony regarding consumer confusion. Walter Carter, Gibson's expert witness, testified that when viewing the PRS Singlecut guitars on the wall at a guitar retail store in Nashville, "I initially thought I was looking at Les Pauls, and on a closer look, I saw I wasn't."⁹⁵ Gibson's President stated that on several occasions his son and some of his son's friends were watching MTV, and believed that they viewed a Gibson "Les Paul" when in fact the performer in the music videos was playing a PRS "Singlecut."⁹⁶ Testimony was also given by Edwin Wilson, who observed a friend and fellow guitar-player mistake a photograph of a PRS "Singlecut" in "Guitar Player" magazine for a Gibson "Les Paul."⁹⁷ A PRS expert witness conceded that at a certain distance, a potential buyer could mistake a PRS "Singlecut" for a Gibson "Les Paul."⁹⁸

After hearing testimony, the court considered Gibson's Lanham Act claims.⁹⁹ In order to determine the likelihood of confusion, the court considered the following eight factors, known in the Sixth Circuit as the *Frisch* test:

1. strength of plaintiff's mark;
2. relatedness of the good;
3. similarity of the marks;
4. evidence of actual confusion;
5. marketing channels used;
6. likely degree of purchaser care;

⁹³ *Id.* at 707.

⁹⁴ *Id.* at 709.

⁹⁵ *Id.* at 709-10.

⁹⁶ *Id.* at 710.

⁹⁷ *Id.*

⁹⁸ *Id.*

⁹⁹ Before addressing the Lanham act claims, the court first had to resolve the issues regarding burden of proof and validity of the mark. The court concluded that Gibson had the burden of proof on its infringement claims and had to show both actual use of the trademark and use of a same or a similar designation as a trademark by PRS. *Id.* at 715; *see also id.* at 712-15 (analyzing relevant holdings regarding summary judgment). In reviewing the validity of Gibson's trademark, the district court noted that Gibson has an "incontestable" trademark in its Les Paul guitar. *Id.* at 716. The court acknowledged a split among the circuits as to whether the doctrine of functionality is a valid defense to an incontestable trademark. *Id.* Ultimately, it was persuaded by the Eleventh Circuit's affirmation of the defense. *Id.* However, the court held that PRS's functionality argument lacked merit after determining that the "horn shape was not shown to be essential," and that while "other parts, knobs, frets and switches serve essential functions," the precise locations or arrangement on the guitar could vary. *Id.* at 715-20.

7. defendant's intent in selecting the mark; and
8. likelihood of expansion of the product line.¹⁰⁰

The court noted that these factors “imply no mathematical precision, and a plaintiff need not show that all, or even most of the factors listed are present in any particular case to be successful.”¹⁰¹

The district court addressed the initial interest confusion doctrine under the *Frisch* factor of actual confusion. The court noted that “[u]nder the Lanham Act, ‘a successful plaintiff must show a sufficient *potential* of confusion, not actual confusion.’”¹⁰² The court acknowledged that “any confusion would be at the initial viewing of the guitar” and that “[p]ersonal inspection of these high price guitars that are sold with clear markings of their origins would dispel the initial confusion.”¹⁰³ However, despite the fact that there would be no actual confusion after close examination of the guitar, the court found there was a likelihood of confusion under the Lanham Act because the facts of the case dictated application of the “initial interest confusion” doctrine.¹⁰⁴ The court pointed out that the doctrine “has been followed by the Second and Ninth Circuits” and agreed that it “applies where the defendant’s ‘use of another’s trademark in a manner is calculated ‘to capture initial consumer attention, even though no actual sale is finally completed as a result of the confusion.’”¹⁰⁵ The court also noted that “[t]he high price of the parties’ guitars, the sophisticated buyers and the opportunity for actual inspection at the point of sale do not preclude ‘potential confusion’ as to the origin of the PRS Singlecut.”¹⁰⁶ After reviewing Sixth Circuit case law, the court determined that protection under the Lanham Act “is not limited to confusion at the point of sale”¹⁰⁷ and that “the presence of sophisticated buyers” does not preclude the possibility of finding confusion.¹⁰⁸ Therefore, the court concluded that the actual confusion factor favored Gibson because “initial confusion would occur in the marketplace between parties’ products as to the ‘Singlecut’ guitar’s source” due to the “striking similarity of

¹⁰⁰ *Id.* at 721 (quoting *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 626-27 (6th Cir. 2000)).

¹⁰¹ *Id.*

¹⁰² *Id.* at 723 (quoting *Daddy's Junky Music Stores, Inc. v. Big Daddy's Family Music Ctr.*, 109 F.3d 275, 284 (6th Cir. 1997)).

¹⁰³ *Id.*

¹⁰⁴ *Id.*

¹⁰⁵ *Id.* (quoting *Brookfield Commc'ns Inc., v. West Coast Entm't Corp.*, 174 F.3d 1036, 1062 (9th Cir. 1999)).

¹⁰⁶ *Id.*

¹⁰⁷ *Id.* (quoting *Ferrari S.P.A. Esercizio Fabriche Automobili E. Corse v. Roberts*, 944 F.2d 1235, 1245 (6th Cir. 1991)).

¹⁰⁸ *Id.*

the PRS Singlecut to Gibson's Les Paul and the instant market recognition of Gibson's Les Paul."¹⁰⁹

After finding that most of the eight *Frisch* factors should be decided in Gibson's favor,¹¹⁰ the court granted Gibson's motion for partial summary judgment.¹¹¹

IV. THE DECISION OF THE SIXTH CIRCUIT COURT OF APPEALS

Through an interlocutory appeal, PRS challenged the July 2, 2004, injunction¹¹² and the January 22, 2004, order granting partial summary judgment to Gibson and denying summary judgment to PRS.¹¹³ The Sixth Circuit conducted *de novo* review of "(1) the district court's determination of what material facts are in dispute; and (2) the legal conclusions the district court drew from the undisputed facts."¹¹⁴

The majority disagreed with the district court and held that the scope of the Les Paul trademark covered only the shape of the guitar, not the entire guitar (including the knobs, switches, and other hardware).¹¹⁵ According to the majority, the district court appeared to have confused *trademark law* with *trade dress law* when it made its determination regarding the scope of the trademark, which prevented the district court from analyzing the parties' claims properly.¹¹⁶ The majority argued that the design of the entire guitar, not just the shape, would be covered by trade dress law.¹¹⁷ However, any potential for Gibson to bring a claim of trade

¹⁰⁹ *Id.* at 724.

¹¹⁰ For the court's analysis of the relevant *Frisch* factors, see *id.* at 722-25.

¹¹¹ *Id.* at 725.

¹¹² On July 2, 2004, the district court granted Gibson's motion for injunctive relief, enjoining PRS from "manufacturing, selling, or distributing, or in any matter, enabling or aiding others to [do the same to] the PRS Singlecut guitar and all versions thereof, including but not limited to their exterior shapes and features . . ." Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP, 325 F. Supp. 2d 841, 855 (M.D. Tenn. 2004), *vacated*, 423 F.3d 539 (6th Cir. 2005), *cert. denied*, 126 S. Ct. 2355 (2006). In addition, the court granted Gibson's motion *in limine* to exclude testimony from a PRS expert relating to market research regarding confusion in the marketplace because the testimony was "irrelevant to an award of damages or lost profits." *Id.* at 850, 854-55.

¹¹³ Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP, 423 F.3d 539, 545 (6th Cir. 2005), *cert. denied*, 126 S. Ct. 2355 (2006).

¹¹⁴ *Id.* at 546 (citing *Jet, Inc. v. Sewage Aeration Sys.*, 165 F.3d 419, 422 (6th Cir. 1999)).

¹¹⁵ *Id.*

¹¹⁶ *Id.*

¹¹⁷ *See id.* at 546-47.

However, different treatment of trade dress and trademark has been criticized. *See* 1 MCCARTHY, *supra* note 24, § 7:62 ("For all practical purposes, there should be no difference in the substantive law of product simulation whether one uses the labels 'trademark,' 'trade dress,' or simply 'unfair competition.' Changing the labels does not change the rules of recovery.") (citing *American Greetings Corp. v. Dan-Dee Imports, Inc.*, 807 F.2d 1136, 1140 (3d Cir. 1986)). "The Supreme Court made this clear in its 1992 *Taco Cabana* decision: '[T]he protection of trademarks and trade dress under § 43(a) serves the same statutory purpose of preventing deception and unfair competition. There is no persuasive reason to apply different analysis to the two.'" 1 MCCARTHY, *supra*

dress infringement was lost when the district court allowed PRS to dismiss with prejudice all of Gibson's claims, except for that of trademark infringement.¹¹⁸ Therefore, the court limited the inquiry to whether there was trademark infringement of the shape of the Les Paul.¹¹⁹

The majority concluded "that neither initial-interest confusion, nor post-sale confusion, nor any combination of the two [i.e., "Gibson's Smoky-Bar Theory of Confusion"]¹²⁰ is applicable in this case."¹²¹ Like the district court, the majority analyzed the likelihood of confusion by examining the eight *Frisch* factors.¹²² However, the majority disagreed with the district court's substitution of point of sale confusion with initial interest confusion. The majority held that the initial interest doctrine is not applicable to the facts of the case, and, therefore, "Gibson's concession that there is no point-of-sale confusion (which goes to the fourth *Frisch* factor, actual confusion) is dispositive of Gibson's claims."¹²³ Accordingly, the court did not discuss the remaining *Frisch* factors.¹²⁴

In a footnote, the majority gave three reasons why they believed initial interest confusion was inapplicable to the facts of the case. First, prior Sixth Circuit case law involving the use of initial interest confusion had only been in the context of the internet.¹²⁵ Second, if initial interest confusion was applied to protect trademarked product shapes, it would give the trademark holders protection not only over their trademarked shape, but over a "penumbra" of similar shapes.¹²⁶ Third, if initial interest

note 24, § 7:62 (quoting *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992); *Herman Miller, Inc. v. Palazzetti Imports and Exports, Inc.*, 270 F.3d 298, n.2 (6th Cir. 2001) ("Trade dress issues follow the same rules and laws as trademark issues.")).

Nevertheless, even if Gibson's mark protected the entire guitar, it should not affect the infringement analysis. The scope of protection does not have an effect on the application of the initial interest confusion doctrine.

¹¹⁸ *Gibson*, 423 F.3d at 547.

¹¹⁹ *Id.*

¹²⁰ The "Gibson's Smoky-Bar Theory of Confusion" is a reference to Gibson's argument that:

In the context of guitar sales, initial interest confusion is of real consequence. Guitar manufacturers know that they can make sales by placing their guitars in the hands of famous musicians. On a distant stage, a smoky bar, wannabe musicians see their heroes playing a guitar they then want.

Id. at 553. The majority, however, rejected this theory based on its reasoning that "[i]f a budding musician sees an individual he or she admires playing a PRS guitar, but believes it to be a Gibson guitar, the logical result would be that the budding musician would go out and purchase a Gibson guitar." *Id.* Therefore, it concluded that "Gibson is helped, rather than harmed, by any such confusion." *Id.*

¹²¹ *Id.* at 549.

¹²² *Id.* at 548.

¹²³ *Id.* at 549.

¹²⁴ *Id.*

¹²⁵ *Id.* at 550 n.15.

¹²⁶ *Id.*

were applied to trademarked product shapes, it would greatly increase the chances of a plaintiff surviving a defendant's motion for summary judgment because "nearly all product-shape trademark-holders will be able to show an issue of fact as to whether a competing product creates initial-interest confusion".¹²⁷ However, the majority made it clear that its holding was restricted to the facts of the case, stating "we do not go so far as to hold that there is never a circumstance in which it would be appropriate to apply the initial-interest-confusion doctrine to product-shape trademark. However, we are unable to imagine such a situation at this juncture" ¹²⁸

The court began its analysis by distinguishing the facts of the case from prior case law involving initial interest confusion. The majority cited *PACCAR Inc., v. TeleScan Techs., L.L.C.*¹²⁹ as the only other case in the Sixth Circuit that arguably applied the initial interest confusion doctrine.¹³⁰ The plaintiff in *PACCAR* was a heavy truck manufacturer who owned the trademarks "Peterbilt" and "Kenworth."¹³¹ *PACCAR*'s website, www.PACCAR.com, provided a listing of used Peterbilt and Kenworth trucks that were for sale from authorized dealers.¹³² The defendant, TeleScan, provided a similar service at www.truckscan.com, which allowed consumers to search not only for used Peterbilt and Kenworth trucks, but also for new trucks from many dealers from whom TeleScan collected a monthly fee.¹³³ In addition, TeleScan had "manufacturer-specific" sites, some of which used *PACCAR*'s trademarks in the domain names, such as "www.peterbiltnewtrucks.com, www.peterbiltusedtrucks.com, www.peterbilttruckdealers.com, www.kenworthnewtrucks.com, www.kenworthusedtrucks.com, and www.kenworthtruckdealers.com."¹³⁴ Furthermore, TeleScan used *PACCAR* trademarks "in the wallpaper underlying the manufacturer-specific web sites in fonts similar to the distinctive fonts in *PACCAR*'s trademarks . . . and include[d] the words "Peterbilt" and "Kenworth" in the sites' metatags."¹³⁵ Each of the TeleScan websites contained a disclaimer stating: "This web site provides a listing service for name brand products and has no affiliation with any manufacturer whose branded

¹²⁷ *Id.*

¹²⁸ *Id.*

¹²⁹ *PACCAR, Inc., v. TeleScan Techs., L.L.C.*, 319 F.3d 243 (6th Cir. 2003), *overruled in part* by *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004).

¹³⁰ *Gibson*, 423 F.3d at 549-50.

¹³¹ *PACCAR*, 319 F.3d at 247.

¹³² *Id.*

¹³³ *Id.*

¹³⁴ *Id.*

¹³⁵ *Id.* at 248.

products are listed herein.”¹³⁶

The district court found “that PACCAR demonstrated a strong likelihood of success on its trademark infringement . . . claim[]” and “granted PACCAR’s motion for a preliminary injunction.”¹³⁷ On appeal, TeleScan argued that the district court should have given greater weight to its disclaimer.¹³⁸ However, the Sixth Circuit agreed with the district court that “Telescan’s disclaimer does not remedy the confusion caused by the use of PACCAR’s trademarks in its domain names.”¹³⁹ The court added “[a] disclaimer disavowing affiliation with a trademark owner read by a consumer after reaching the website comes too late. This ‘initial interest confusion’ is recognized as an infringement under the Lanham Act.”¹⁴⁰ Unlike the district court in *Gibson* which applied the initial interest doctrine under the “actual confusion” factor, the *PACCAR* court considered the doctrine under the “marketing channel” factor.¹⁴¹ The *PACCAR* majority adopted the Ninth Circuit’s reasoning that “in the Internet context, similarity of the marks, relatedness of the goods or services, and simultaneous use of the Internet as a marketing channel are the three most important factors in finding a likelihood of confusion.”¹⁴² The *PACCAR* court found that “TeleScan’s domain names are very similar to PACCAR’s marks [and] [b]oth Telescan and PACCAR offer used truck locator services via the internet.”¹⁴³ Consequently, the court held that “PACCAR ha[d] demonstrated a likelihood of confusion and thus a strong likelihood of success on the merits of its trademark infringement claim.”¹⁴⁴

¹³⁶ *Id.*

¹³⁷ *Id.*

¹³⁸ *Id.* at 253.

¹³⁹ *Id.*

¹⁴⁰ *Id.* (citing *Eli Lilly & Co. v. Natural Answers, Inc.*, 233 F.3d 456, 464 (7th Cir. 2000) (“Such confusion, which is actionable under the Lanham Act, occurs when a consumer is lured to a product by its similarity to a known mark, even though the consumer realizes the true identity and origin of the product before consummating a purchase.”); *Brookfield Commc’ns, Inc. v. West Coast Entm’t Corp.*, 174 F.3d 1036, 1062 (9th Cir. 1999) (“The use of another’s trademark in a manner calculated ‘to capture initial consumer attention, even though no actual sale is finally completed as a result of the confusion, may be still an infringement.”); *Green Prods. Co. v. Independence Corn By-Products Co.*, 992 F. Supp. 1070, 1077 (N.D. Iowa 1997) (“Due to the nature of Internet use, defendant’s appropriation of plaintiff[']s mark as a domain name and home page address cannot adequately be remedied by a disclaimer. Defendant’s domain name and home page address are external labels that, on their face, cause confusion among Internet users and may cause Internet users who seek plaintiff[']s web site to expend time and energy accessing defendant’s web site.”)) (footnote omitted).

¹⁴¹ *See id.* at 252-53. In *PACCAR*, both parties agreed that there was no evidence of actual confusion. *Id.* at 253.

¹⁴² *Id.* at 254-55 (citing *GoTo.com v. Walt Disney Corp.*, 202 F.3d 1199, 1205 (9th Cir. 2000) (citing *Brookfield Commc’ns, Inc. v. West Coast Entm’t Corp.*, 174 F.3d 1036, 1054 n.16 (9th Cir. 1999)).

¹⁴³ *Id.* at 255.

¹⁴⁴ *Id.*

The *Gibson* court pointed out that the three cases cited by the Sixth Circuit in *PACCAR* to support its application of initial interest confusion were also internet-related cases.¹⁴⁵ For example, in *Eli Lilly*, the Seventh Circuit was faced with the issue of whether Natural Answers, an internet start-up company that marketed an herbal product named HERBROZAC, violated the Lanham Act by coming too close to Eli Lilly's "protected mark for PROZACthorn, a prescription drug used to treat clinical depression."¹⁴⁶ Natural Answers also used the term PROZAC in the metatags of its website.¹⁴⁷ Although the Seventh Circuit did not find that the district court erred in finding a likelihood of confusion,¹⁴⁸ the court held that the district court's analysis of the evidence of actual confusion factor was misguided.¹⁴⁹ The circuit court agreed with the district court's finding that there was no evidence of actual consumer confusion due to the limited amount of sales of HERBROZAC,¹⁵⁰ and noted that "[e]ven a statistically reliable consumer survey would likely require a greater sampling than the total number of HERBROZAC customers."¹⁵¹ However, the majority disagreed with the district court's weighing the "actual confusion" factor in favor of Eli Lilly, based on its finding that a risk of "initial interest confusion" existed due to the "phonetic similarity of HERBROZAC to PROZACthorn, as well as Natural Answers' use of the 'Prozac' metatag on its web site."¹⁵² The majority held that the district court should have limited its analysis of the "actual confusion" factor to "evidence of *actual* confusion, not a mere risk of confusion."¹⁵³ The Seventh Circuit reasoned that the issue of phonetic similarity "is a separate consideration in our analysis, and although it does create a risk of confusion, it does not constitute evidence of actual confusion."¹⁵⁴ Likewise, the court held that the use of the term "Prozac" in its metatags is not evidence of actual confusion, but instead should be considered under the intent factor.¹⁵⁵ The court stated that evidence of actual

¹⁴⁵ *Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP*, 423 F.3d 539, 550 (6th Cir. 2005), *cert. denied*, 126 S. Ct. 2355 (2006) (noting that the following internet-related cases were cited in *PACCAR*: (1) *Eli Lilly & Co. v. Natural Answers, Inc.*, 233 F.3d 456, 464 (7th Cir. 2000); (2) *Brookfield Commc'ns, Inc. v. West Coast Entm't Corp.*, 174 F.3d 1036, 1062 (9th Cir. 1999); and (3) *Green Prods. Co. v. Independence Corn By-Products Co.*, 992 F. Supp. 1070 (N.D. Iowa 1997)).

¹⁴⁶ *Eli Lilly & Co. v. Natural Answers, Inc.*, 233 F.3d 456, 459 (7th Cir. 2000).

¹⁴⁷ *Id.* at 460.

¹⁴⁸ *Id.* at 465-66.

¹⁴⁹ *Id.*

¹⁵⁰ *Id.* at 464.

¹⁵¹ *Id.*

¹⁵² *Id.* at 464.

¹⁵³ *Id.* at 465.

¹⁵⁴ *Id.*

¹⁵⁵ *Id.*

consumer confusion “would most likely take the form of a consumer survey, which would not be limited to a sampling of HERBROZAC customers because ‘initial interest confusion’ is complete prior to any actual purchase.”¹⁵⁶ In summary, the Seventh Circuit recognized the doctrine of initial interest confusion, but found that there was no evidence of it under the facts of that case.¹⁵⁷

In *Green Products, Co. v. Independence Corn By-Products, Co.*,¹⁵⁸ the Northern District of Iowa also recognized a form of initial interest confusion. However, unlike *Eli Lilly*, the *Green Products* court analyzed initial interest confusion under the “intent” factor and, because the website in question had not yet been designed, it considered the *potential* for confusion as opposed to actual confusion.¹⁵⁹

The parties in *Green Products* were “direct competitors in the corncob by-products industry.”¹⁶⁰ Independence Corn By-Products (“ICBP”) registered several domain names, one of which was “greenproducts.com.”¹⁶¹ When Green Products found out that they could not register “greenproducts.com” because it was already registered by ICBP, they brought suit alleging infringement under section 43(a) of the Lanham Act.¹⁶² The court found that ICBP’s use of the domain name “greenproducts.com” was “likely to cause consumer confusion as to who owns the site.”¹⁶³ The court added, “[j]ust as customers entering a store that advertises ‘Green Products’ as its store name would be initially confused to find, upon entering the store, that ICBP actually owned it, so will customers typing the domain name ‘greenproducts.com’ be initially confused to find that ICBP owns the web site.”¹⁶⁴ The court held that “ICBP did intend to pass off its domain name as though it belonged to Green Products” and this “could deceptively lure potential customers onto its own turf, where customers would be told how ICBP is better than Green Products.”¹⁶⁵ The court found that “such a deceptive use of a

¹⁵⁶ *Id.*

¹⁵⁷ Although, the court disagreed with the application of the initial interest doctrine to the facts of the case, the Seventh Circuit affirmed the district court’s preliminary injunction on other grounds. *Id.* at 466 (holding that “other factors—especially the similarity of the marks, the strength of the PROZACthorn mark, and Natural Answer’s intent to confuse—strongly support the district court’s ultimate conclusion.”).

¹⁵⁸ *Green Prods. Co. v. Independence Corn By-Products Co.*, 992 F.Supp. 1070 (N.D. Iowa 1997).

¹⁵⁹ *See id.* at 1077-78 (emphasis added).

¹⁶⁰ *Id.* at 1074.

¹⁶¹ *Id.*

¹⁶² *Id.* at 1072, 1074

¹⁶³ *Id.* at 1077.

¹⁶⁴ *Id.*

¹⁶⁵ *Id.* at 1078.

competitor's trademark as a way to lure customers away from the competitor is a kind of consumer confusion."¹⁶⁶ Although the court determined that there was no "evidence of actual confusion because ICBP's web site is not yet operational," it stated that there was "a substantial probability that Green Products will prevail on the merits."¹⁶⁷

Based on these cases, the court in *PACCAR* concluded that initial interest confusion occurs when a web user is confused by an infringer's use of another's trademark in its domain name.¹⁶⁸ The court noted that once a web user has reached an infringer's website based on such confusion, a disclaimer can not offset the confusion that has already occurred.¹⁶⁹ However, nowhere in its opinion did the *PACCAR* court limit its application of the initial interest confusion to internet cases.¹⁷⁰

After analyzing *PACCAR* and finding that Sixth Circuit precedent did not mandate application of the initial interest doctrine, the *Gibson* majority concluded that if the doctrine were applied to product shapes, it would have the effect of giving owners of trademarked products more protection than the trademark holder of a "product's name, a company's name, or a company's logo."¹⁷¹ The court explained:

Specifically, there are only a limited number of shapes in which many products can be made. A product may have a shape which is neither functional nor generic (and hence which can be trademarked) but nonetheless is still likely to resemble a competing product when viewed from the far end of a store aisle. Thus, many legitimately competing product shapes are likely to create some initial interest in the competing product due to the competing product's resemblance to the better-known product when viewed from afar. In other words, application of the initial-interest-confusion doctrine to product shapes would allow trademark holders to protect not only the

¹⁶⁶ *Id.*

¹⁶⁷ *Id.* at 1079. The court based its conclusion on:

[T]he strength of Green Products' trademark, the strong similarity between Green Products' trademark and ICBP's domain name 'greenproducts.com', the close competitive proximity, the likelihood that ICBP intended to capitalize on consumer confusion as a strategy to lure potential customers onto ICBP's web site (even though the actual web site will announce that Green Products does not own the site), and the degree of care that Green Products' potential customers will reasonably exercise in browsing the web to find Green Products' site.

Id.

¹⁶⁸ See *PACCAR, Inc. v. Telescan Techs.*, 319 F.3d 243, 253 (6th Cir. 2003), *overruled in part by* *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004) .

¹⁶⁹ *Id.*

¹⁷⁰ *Id.*

¹⁷¹ *Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP*, 423 F.3d 539, 550 n.15 (6th Cir. 2005), *cert. denied*, 126 S. Ct. 2355 (2006).

actual product shapes they have trademarked, but also a “penumbra” of more or less similar shapes that would not otherwise qualify for trademark protection.¹⁷²

In an effort to resolve this concern, the dissent suggested that product-shape trademark holders be required to show “that its product shape identifies its source when viewed from the vantage point where the confusion is alleged to have occurred.”¹⁷³ However, the majority rejected this standard on the ground that it would be “difficult to determine in any non-arbitrary manner what observation distances are appropriate when considering whether a given product shape creates initial-interest confusion.”¹⁷⁴

The majority’s final argument in opposition to the applicability of initial interest in a product shape infringement action was based on the “severe anti-competitive effects such a decision could have” in the “summary-judgment context.”¹⁷⁵ The court explained:

To the extent we allow it to do so, evidence of initial-interest confusion comes into the eight-factor *Frisch* test as a substitute for evidence of actual confusion. If our belief that *nearly all* product-shape trademark-holders will be able to show an issue of fact as to whether a competing product creates initial-interest confusion is correct, application of the initial-interest confusion doctrine in the product-shape context would make it substantially easier for product-shape trademark-holders to survive a defendant’s summary-judgment motion than for plaintiffs alleging any other type of trademark infringement.¹⁷⁶

Based on these three arguments, the majority held that “initial-interest confusion cannot substitute for point-of-sale confusion on the facts of this case.”¹⁷⁷ Therefore, given that Gibson had already conceded that there was no point-of-sale confusion, the court held that Gibson’s claim for summary judgment must be denied.¹⁷⁸

The dissent agreed with the majority as to its analysis of Gibson’s post-sale and point-of-purchase infringement claims, but argued that Gibson should be able to bring a claim based on the initial-interest confusion doctrine.¹⁷⁹ The dissent argued that the Sixth Circuit had “recognized initial-interest confusion as an

¹⁷² *Id.*

¹⁷³ *Id.* at 555 (Kennedy, J., concurring in part, dissenting in part).

¹⁷⁴ *Id.* at 550 n.15 (majority opinion). See *supra* note 7, for details of the majority’s critique.

¹⁷⁵ *Id.*

¹⁷⁶ *Id.*

¹⁷⁷ *Id.* at 552.

¹⁷⁸ *Id.*

¹⁷⁹ *Id.* at 553-54 (Kennedy, J., concurring in part, dissenting in part).

infringement under the Lanham Act¹⁸⁰ and that the majority had failed to adequately explain why it should not be applied to product shapes.¹⁸¹

According to the dissent, the majority's concern that the application of initial interest confusion would "prevent competitors from producing even dissimilar products that appeared from a sufficient distance to be somewhat similar to a trademarked shape" was "misplaced" because the majority failed to take into account whether the confusion occurred from the same distance at which the "trademark holder maintains that its product shape identifies its source."¹⁸²

[I]f a product shape trademark holder does not assert that its product shape identifies its source when viewed from a certain distance, then any alleged confusion between the trademark holder's product shape and a competitor's product shape would not support the trademark holder's claim for infringement. If a product shape trademark holder does assert that its product shape serves to identify the product's source when viewed from a distance where many competitor products appear substantially the same, then this will be evidence that the trademark holder's product shape does not identify its source. If most product shapes in the same product category have similar shapes, a product shape trademark holder will have a difficult time establishing that its trademark identifies the source of its product when viewed from afar, for the further one is away from a product, the more similar products in the same category will look to each other and, thus, the less likely a product shape will identify the source of the product (i.e. serve as a trademark) from that vantage point. In other words, a product shape trademark holder will not be able to present probative evidence of initial interest confusion unless it first shows that its product shape identified its source when viewed from the vantage point where the confusion is alleged to have occurred.¹⁸³

Therefore, according to the dissent, before one could bring a claim for trademark infringement of a product shape, one would have to first establish the distance at which the trademarked product shape identifies its source.¹⁸⁴ The dissent argued that this determination is logically established prior to a claim of trademark infringement because if "the product shape does not identify its source, then . . . there can be no confusion as to the source of the

¹⁸⁰ *Id.* at 554.

¹⁸¹ *Id.* at 554 n.3.

¹⁸² *Id.* at 554-55.

¹⁸³ *Id.* at 555 (footnotes omitted).

¹⁸⁴ *Id.*

product due to the product's shape, since, in such a case, a consumer would not associate the product's shape with its source."¹⁸⁵ The dissent acknowledged that an owner of a trademarked product shape could argue that there are many distances at which a consumer would be confused as to the source of the product, but stated that in these situations "the court will need to address this argument."¹⁸⁶

In this case, the only relevant allegation of initial-interest confusion is from Gibson's expert, who claimed that upon entering Gruhn's Guitar store . . . he looked at what he thought was a wall of Gibson Les Paul guitars to discover, upon closer inspection, that the guitars were actually PRS Singlecuts. Since PRS argues that Gibson's guitar shape does not identify its source, Gibson must establish that its shape does identify its source from the perspective where the alleged confusion occurred.¹⁸⁷

Although the dissent recognized that Gibson may ultimately be unsuccessful on this claim, it believed that Gibson had put forth enough evidence to survive summary judgment.¹⁸⁸ However, because the district court did not address "the issue of whether Gibson's trademark served to identify its source from the distance where the confusion was alleged to have occurred" the dissent would have remanded the case for consideration of this issue.¹⁸⁹

In a footnote, the dissent noted that it is important for initial interest confusion to be applied to trademarked product shapes, because in most instances this would be "the only kind of confusion that could arise with product shapes."¹⁹⁰ The dissent added that point-of-sale confusion will only rarely be found due to distinguishing characteristics of an allegedly infringing product that will be recognized at the point-of-sale.¹⁹¹ Therefore, without the ability to use initial interest confusion, "a product shape trademark holder may be quite limited, if not foreclosed, from successfully prosecuting a trademark infringement claim."¹⁹²

Gibson's petition for an en banc rehearing was denied on December 30, 2005,¹⁹³ and the Supreme Court denied certiorari on June 5, 2006.¹⁹⁴

¹⁸⁵ *Id.* at 555-56.

¹⁸⁶ *Id.* at 555 n.5.

¹⁸⁷ *Id.*

¹⁸⁸ *Id.*

¹⁸⁹ *Id.* at 556.

¹⁹⁰ *Id.* at 556 n.7.

¹⁹¹ *Id.*

¹⁹² *Id.*

¹⁹³ *Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP.*, 2005 U.S. App. LEXIS 29220 (6th Cir. Dec. 30, 2005) (*en banc* rehearing denied).

¹⁹⁴ *Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP.*, 126 S. Ct. 2355 (2006) (cert.

V. CRITIQUE OF THE REASONING AND A NEW STANDARD

The conclusions of the majority and dissent regarding the applicability of the initial interest confusion doctrine differed with respect to scope, with the majority limiting the use of the doctrine to internet-related cases, and the dissent broadening its application not only to product shape infringement, but, presumably, to any trademark infringement action. As the dissent correctly noted, while *PACCAR* and the cases cited therein were internet-related, the principle derived from those cases need not be limited to cases involving the internet. As the majority stated, the Sixth Circuit's concern in *PACCAR* "was with 'whether the defendant's use of the disputed mark is likely to cause confusion among consumers regarding the origin of the goods offered by parties.'"¹⁹⁵ This, however, is no different from the concern of other circuits in applying the doctrine to non-internet cases.¹⁹⁶ Therefore, this principle should not be limited to cases involving the internet.¹⁹⁷

In addition, the majority misinterpreted the holding in *PACCAR* when it concluded that the *PACCAR* decision "did not rest on initial-interest confusion" but "focused primarily on three other *Frisch* factors that are particularly important in an Internet-domain-name case."¹⁹⁸ Specifically, the *PACCAR* court concluded that "marketing channels" was one of the three most relevant factors in its likelihood of confusion analysis.¹⁹⁹ However, the *PACCAR* court used the initial interest confusion doctrine in analyzing the "marketing channels" factor.²⁰⁰ Therefore, because the marketing channels factor was deemed by the court to be an "important factor[] in finding a likelihood of confusion,"²⁰¹ and the initial interest confusion doctrine was considered under that factor, the initial interest confusion doctrine arguably was an important part of the court's analysis.

denied).

¹⁹⁵ *Gibson*, 423 F.3d at 550 n.15 (quoting *PACCAR Inc. v. Telescan Techs.*, 319 F.3d 243, 249 (6th Cir. 2003)).

¹⁹⁶ See, e.g., *Grotian, Helfferich, Shulz, Th. Steinweg Nachf. v. Steinway & Sons*, 523 F.2d 1331 (2d Cir. 1975); *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254 (2d Cir. 1987); *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188 (5th Cir. 1998).

¹⁹⁷ See e.g., Thomas P. Haggerty, Note, *A Blue Note: The Sixth Circuit, Product Design and the Confusion Doctrines in Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP*, 8 TUL. J. TECH. & INTELL. PROP. 219, 229 (2006) (arguing that the decision of the Gibson majority to refuse to apply the initial interest confusion doctrine was "incomplete and evasive" because it "merely distinguish[ed] the facts before it from that of *PACCAR*" and did "not address why the initial-interest confusion [doctrine] should apply to Internet domain names and not to product designs").

¹⁹⁸ *Gibson*, 423 F.3d at 550-51 (citing *PACCAR*, 319 F.3d at 254-55).

¹⁹⁹ *PACCAR Inc. v. Telescan Techs.*, 319 F.3d 243, 255 (6th Cir. 2003)

²⁰⁰ *Id.* at 253.

²⁰¹ *Id.* at 254-55.

Furthermore, two of the cases cited in support of the initial interest confusion doctrine, albeit also internet-related cases, analyzed initial interest confusion under the “intent” factor, not the “marketing channels” factor.²⁰² Unlike the *PACCAR* court, which held that initial interest confusion was particularly applicable to the internet due to the ease of transferring from one website to the next, the three courts cited in *PACCAR* held that initial interest confusion was applicable because the infringer was able to take advantage of the structure of the internet by intending to “lure” consumers to its website. It is the intent to cause initial interest confusion which is the key in these cases. The framework of the internet simply provides an easy means for an alleged infringer to cause initial interest confusion. Therefore, there should be no distinction between trademark infringement on the internet and traditional trademark infringement.²⁰³ The internet can either allow an alleged infringer to intentionally cause initial interest confusion, or it can increase the ease by which a potential consumer can be confused. Of course, in traditional marketing this is also true. An alleged infringer can still find a way to lure consumers to his or her product based on initial interest confusion, and a consumer can still experience initial interest confusion.

The majority’s argument that the applicability of initial interest confusion to trademarked product shapes would give too much protection to trademark holders misses the point. The majority’s concern with expanding initial interest confusion to a situation where a consumer is confused when looking at a guitar from across the room does not take into account the distance at which the average consumer with average vision clearly sees the product. Of course, as the majority points out, “[m]any, if not most, consumer products will tend to appear like their competitors at a sufficient distance.”²⁰⁴ The majority seemed reluctant to extend the doctrine because of a potential situation where—to use the extreme example—a consumer viewing a guitar from the length of a football field, is unable to make out the shape of the product, and instead sees only a blurry colored dot in the distance. However, application of the initial interest confusion

²⁰² See *Brookfield Commc’ns, Inc. v. West Coast Entm’t Corp.*, 174 F.3d 1036, 1062 (9th Cir. 1999); *Green Prods. Co. v. Independence Corn By-Products Co.*, 992 F. Supp.1077-78 (N.D. Iowa 1997).

²⁰³ See, e.g., Rothman, *supra* note 10, at 169 (“[N]umerous courts have repeated the erroneous proposition from *Brookfield* that confusion is more likely on the Internet than offline.”).

²⁰⁴ *Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP*, 423 F.3d 539, 552 (6th Cir. 2005), *cert. denied*, 126 S. Ct. 2355 (2006).

doctrine has never been applied to situations where the alleged infringing mark was incomprehensible to the consumer. For example, it was not the case in *Steinway* that the consumer was confused as a result of mishearing the salesman pronounce “Grotrian-Steinweg.” It is not as if the salesman said “Steinweg” with emphasis on the “Stein” while trailing off at the “weg,” leaving the consumer to believe that he had spoken the word “Steinway.” The consumer clearly heard “Grotrian-Steinweg” and, as a result, believed it was a “Steinway” product.²⁰⁵

Once this distance is factored into the initial interest confusion analysis, the majority’s concern is greatly reduced. Using a distance at which an ordinary person with ordinary vision can clearly see the shape in question would prevent the finding of infringement in circumstances where a consumer sees a guitar on a wall on the other end of a shop, and is confused even though she is unable to clearly make out the shape. Factoring this distance into the analysis will also alleviate the majority’s unease in applying the doctrine in the summary judgment context, because it would reduce the likelihood that a holder of a trademarked product shape could show an issue of fact as to whether a competing product creates initial interest confusion.²⁰⁶

The dissent was correct in recognizing that the likelihood of confusion analysis should take into account confusion from a particular distance, not just any distance. However, the distance at which the trademark owner claims that his mark identifies the source of the product is not the appropriate distance. A particular mark cannot be said to identify a product unless that mark can be clearly seen by the average consumer. It is only at this point that an owner of a trademarked product shape can say that its trademark shape identifies the source of the product. The majority emphatically criticized the dissent’s standard because it would be difficult to determine whether, under a particular set of facts, the distance from which the product was viewed, is the distance at which the trademark holder claims the product’s shape identifies its source.

To reconcile the concerns of the majority with the standard offered by the dissent, I propose that the standard used to judge initial interest confusion in regard to trademarked product shapes should be whether an ordinary consumer with ordinary vision is confused when he or she initially *clearly sees* the shape in question. This standard distinguishes the point at which a consumer first

²⁰⁵ Grotrian, Helfferich, Shulz, Th. Steinweg Nachf. v. Steinway & Sons, 523 F.2d 1331, 1340 (2d Cir. 1975)

²⁰⁶ See *supra* text accompanying note 176.

sees the object but cannot make out the exact shape from the point at which an individual clearly sees the shape.

The distance could be determined by scientific information pertaining to an ordinary person's sight. For example, a test similar to Snellen's visual acuity test could be applied. In Snellen's test, "letters are printed on a large card. . . with the largest letter being on the top . . . [and] the subject is placed 20 feet from the chart."²⁰⁷ The subject is then given a score, with the "upper number indicat[ing] the distance at which the subject is removed from the chart [and] the lower number indicat[ing] the distance at which most people see the line *clearly*. . . ."²⁰⁸ Based on this standard, it would seem possible for expert testimony to be introduced to determine the distance at which a person with normal vision can clearly see the shape of a particular object based on its size. The initial inquiry would be: If viewed from the distance at which a consumer with 20/20 vision can clearly see the product shape, would the consumer likely be confused as to the product's source?

This standard is similar to the dissent's; however, it has several advantages. Of course, in certain instances the distance at which the trademark holder claims that the shape identifies the source may in fact be the same point at which an ordinary person can first clearly see the shape. However, this standard, unlike the dissent's, overcomes the majority's concern that additional hearings will be required to determine the admissibility of the distance at which the alleged initial-interest confusion took place and will also eliminate the risk of an arbitrary determination.²⁰⁹ First, there would be no need to conduct an additional hearing, because this information can be used at trial either in conjunction with witness accounts or as part of a survey admitted into evidence. Second, even taking into account the surrounding characteristics of a store, this determination would not be arbitrary, but instead would be based on scientific evidence.

In addition, this standard survives the majority's penumbra problem. There may be circumstances where a product shape resembles a trademarked product shape at a distance where the customer can first clearly see the shape in question. However, this situation is no different from any other mark that resembles a trademark. If the resemblance occurs because it is essential for a product to be shaped in such a way as to look like the allegedly

²⁰⁷ 5-S ATTORNEY'S DICTIONARY OF MEDICINE SCOPE 1, app. S, fig.S-4 (Matthew Bender & Co. 2005).

²⁰⁸ *Id.*

²⁰⁹ See *Gibson*, 423 F.3d at 551; see also *supra* note 7 and accompanying text.

infringed product, then the functionality doctrine would prevent the shape from being trademarked in the first place.²¹⁰

In applying this standard, a court must adhere to the established trademark principle that confusion must be considered in “the context in which ordinary buyers see the conflicting marks in the marketplace.”²¹¹ Therefore, the standard could not be applied by simply placing the guitar in question before jurors at the farthest distance at which an ordinary person could clearly see the guitar in order to determine whether there would be initial interest confusion. Because the context of the marketplace is a necessary element, the distance should be established by expert testimony and used in conjunction with testimony concerning instances of actual confusion to determine whether the confusion occurred at a distance in which an ordinary individual could clearly comprehend the shape in question, or at some farther distance.

In addition, a consumer survey could be used as evidence to determine initial interest confusion at the point at which an ordinary consumer can first clearly see the product.²¹² In fact, “[s]urveys as to the state of mind of prospective purchasers have been offered as evidence . . . of the existence of a likelihood of confusion.”²¹³ A survey could be important evidence for two

²¹⁰ See *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 29 (2001) (noting that it is a “well-established rule that trade dress protection may not be claimed for product features that are functional”) (citing *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164-65 (1995); *Two Pesos, Inc., v. Taco Cabana, Inc.*, 505 U.S. 763, 775 (1992)).

For an argument that the district court in *Gibson* should have granted summary judgment in favor of PRS on functionality grounds, see *Kunstadt & Maggioni*, *supra* note 13, at 1287 (“Given the generic nature of the overall LES PAUL outline, and the admitted functional nature of the single cutaway horn, Gibson’s trademark registration is nothing more than a combination of a generic outline with a functional feature. As such, it should not be shielded from cancellation.”). See also *In re Gibson Guitar Corp.*, 61 U.S.P.Q.2d 1948, 5-7 (T.T.A.B. 2001) (finding that Gibson’s Epiphone “Advanced Jumbo” model guitar is de jure functional because “the evidence indicates that the specific shape of applicant’s guitar is necessary for such a sound”); *Switchmusic.com, Inc. v. U.S. Music Corp.*, 416 F. Supp. 2d 812 (C.D. Cal. 2006) (holding that plaintiff’s “Wild” and “Stein” line of guitars did not infringe the trade dress on defendant’s “Parker” line of guitars because defendant’s trade dress was functional, had not acquired secondary meaning, and there was no likelihood of confusion). Whether or not the shape of Gibson’s Les Paul is functional, however, is beyond the scope of this Note.

²¹¹ 3 MCCARTHY, *supra* note 24, § 23:58.

²¹² See e.g., *Eli Lilly & Co. v. Natural Answers, Inc.*, 233 F.3d 456, 465 (7th Cir. 2000) (acknowledging that evidence of actual confusion can take the form of a consumer survey).

²¹³ 5 MCCARTHY, *supra* note 24, § 32:158 (citing *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397 (8th Cir. 1987); *Piper Aircraft Corp. v. Wag-Aero, Inc.*, 741 F.2d 925 (7th Cir. 1984) (forty-five percent confusion results “weigh[] strongly” in support of a likelihood of confusion); *Exxon Corp. v. Texas Motor Exch., Inc.*, 628 F.2d 500 (5th Cir. 1980); *James Burrough, Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266 (7th Cir. 1976); *Standard Oil Co. v. Standard Oil Co.*, 252 F.2d 65 (10th Cir. 1958); *Jenkins Bros. v. Newman Hender & Co.*, 289 F.2d 675 (C.C.P.A. 1961); *McDonald’s Corp. v. McBagel’s, Inc.*, 649 F. Supp. 1268 (S.D.N.Y. 1986) (twenty-five percent level supports finding of a likelihood of confusion)).

reasons. First, if experts have determined the distance at which an ordinary consumer can clearly see the product, the survey could incorporate such information. For example, assuming that to an expert, a guitar was clearly visible at a distance of twenty feet, a survey question might ask:

When you were approximately twenty feet away from the guitar, did you believe that the guitar you were viewing was manufactured, or otherwise associated with Gibson?

In this scenario, the words “twenty feet” could be substituted for a specific location like the entrance of the store or the sales counter.

Second, a survey could be used even without an expert determination of the precise distance at which the average person clearly perceives the object. A series of questions could distinguish between the distance at which a customer first clearly sees the product and the point at which a customer initially sees the product but without regard for the object’s clarity. For example, the survey could ask:

(1) At the point you first perceived what you believed was a guitar, without regard for complete clarity of the shape of the guitar, did you believe it was a Gibson Les Paul, or did you believe it was manufactured or otherwise affiliated with Gibson’s Les Paul?

(2) At the point you could first clearly make out the shape of the guitar, did you believe it was a Gibson Les Paul, or did you believe it was manufactured or otherwise affiliated with Gibson’s Les Paul?

An affirmative response to the second question would be required to find strong evidence of initial interest confusion. However, an affirmative response to the first question would not be sufficiently strong evidence to find initial interest confusion, because the allegedly infringing mark would not have been clearly comprehended. In making this distinction, a court would not be faced with the majority’s concern of an over-expansive view of the initial interest confusion doctrine because a court would only have to apply initial interest confusion at the point at which the consumer could clearly see the shape.

When dealing with matters regarding trademark infringement of a product shape by itself, this proposed standard would suffice. However, what complicates the analysis is that a trademarked product shape is rarely the only characteristic of a product. For example, in addition to the trademarked shape of Gibson’s Les Paul, the Les Paul also has distinguishing characteristics such as the knobs and pickups. Furthermore, although one may produce a product with a potentially infringing product shape, most products have other distinguishing characteristics, such as the logo and name of the company. Not

only is it likely that these distinguishing characteristics will dispel any instance of confusion after close examination, but these distinguishing features may be clearly visible at the same distance a consumer with 20/20 vision can clearly see the product shape. Therefore, although the average consumer may conclude that the product shape is similar to the trademarked product shape, he or she would not be confused as to the source of the product when he or she sees other distinguishing characteristics.

If the circumstances are such that a consumer can clearly see distinguishing characteristics on the guitar, then a court should apply the “anti-dissection rule,” which states that “[c]onflicting composite marks are to be compared by looking at them as a whole, rather than breaking the marks up into their component parts for comparison.”²¹⁴ Of course, under certain circumstances, more weight can be “given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.”²¹⁵ Ultimately, however, it is a question for the trier of fact whether PRS’s differences in the cutaway, headstock shape, and bird inlay on the fret board, when compared to the corresponding portions of the Les Paul, would carry enough weight to give the impression that there is no likelihood of confusion when viewed from a vantage point at which an ordinary consumer can clearly see the guitar.²¹⁶

The foregoing arguments show that it is unclear whether initial interest confusion would have been found if *Gibson* were decided with consideration of the distance in which an ordinary consumer could clearly perceive the shape in question. Therefore, it would have been helpful if the majority addressed the remaining *Frisch* factors and explained why they disagreed with the district court’s analysis.²¹⁷ If they had, perhaps the Sixth

²¹⁴ 3 MCCARTHY, *supra* note 24, § 23:41 (citing *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 545-46 (1920)).

The commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety . . . , and to strike out a considerable part of it, certainly any conspicuous part of it, would be to greatly affect its value.
Estate of P.D. Beckwith Inc. v. Comm’r of Patents, 252 U.S. 538, 545-46 (citation omitted).

²¹⁵ 3 MCCARTHY, *supra* note 24, § 23:42 (quoting *In re Nat’l Data Corp.*, 752 F.2d 1056 (Fed. Cir. 1985)).

²¹⁶ Although, if it is found that the shape of the PRS Singlecut causes a likelihood of confusion with the Les Paul based solely on the shape, it is unlikely that any clarifying marks or labels on the guitar will provide a defense for PRS because “[t]he majority of cases have held that such labeling does not avoid what would otherwise be an infringement of a shape mark.” *Id.* § 23:53.

²¹⁷ See *Gibson Guitar Corp. v. Paul Reed Smith Guitars*, 423 F.3d 539, 548 n.12 (6th Cir. 2005), *cert. denied*, 126 S. Ct. 2355 (2006). (“We disagree with several of the district court’s conclusions on the individual *Frisch* factors. However, as these remaining factors are not relevant to our disposition of this case, we need not discuss them separately.”). For the district court’s analysis of the remaining *Frisch* factors, see *supra*, note 110.

Circuit would have found that the purchaser of such products should be held to a “discriminating purchaser” standard because of the high-end quality of the guitars, and, therefore, held that a high degree of purchaser care would weigh heavily in the likelihood of confusion analysis.

VI. FUTURE IMPLICATIONS AND CONCLUSION

Although the *Gibson* court limited its holding to the facts of the case, it clearly concluded that applying initial interest to product shapes would give too much protection to the trademark holder and restrict legitimate products from being developed. Unfortunately, if this position is adopted in future cases, courts may fail to prevent one of the fundamental concerns which the initial interest confusion doctrine was developed to address, which is preventing an alleged infringer from “getting a foot in the door” by luring potential customers into using a competitor’s trademark. For example, the district court, when going through its analysis of the intent factor, concluded “that PRS’s meeting notes clearly reflect that PRS was imitating the Les Paul PRS’s repeated references that this Singlecut product would be viewed as a copy of Gibson’s Les Paul reflect PRS’s awareness of its imitation of the Les Paul guitar.”²¹⁸ The dissent in *Gibson* went so far as to argue that “if initial interest confusion were not a viable theory upon which a product shape trademark holder could proceed, a product shape trademark holder may be quite limited, if not foreclosed, from successfully prosecuting a trademark claim.”²¹⁹ It explained that it would be rare for confusion other than initial interest confusion to exist in a product shape infringement case because distinctions like a company logo would likely dispel point of sale confusion.²²⁰ Therefore, the majority’s holding in effect allows a manufacturer to copy a trademarked product shape, so long as it places on the product a distinguishing mark which serves to identify its source by the time the product is purchased.

However, if the proposed standard were applied in these situations, the ability of a manufacturer to free ride on a trademarked product shape would be greatly reduced. A manufacturer who desired to make his product resemble the

²¹⁸ *Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP*, 311 F. Supp. 2d 690, 724 (M.D. Tenn. 2004), *rev’d*, 423 F.3d 539 (6th Cir. 2005), *cert. denied*, 126 S. Ct. 2355 (2006).

²¹⁹ *Gibson*, 423 F.3d at 556 n.7.

²²⁰ *Id.*

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shape of a trademarked product-shape would be forced to manufacture the product in such a way that, when a consumer first clearly perceives the product, the consumer knows that the product he is viewing is from a source other than the owner of the trademarked product-shape.

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