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An Illuminating Tale of Likely Confusion

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Quiz time. Here's the setup:

Company A owns the following registered trademarks for use in connection with the listed goods:

- MAXSTAR for "electric lanterns"
- MAGNUM MAX for "hand-held electric spotlights"
- MAXFIRE for "portable, battery-operated lighting products, namely flashlights"

Company B owns these registered trademarks:

- MAG-LITE and MAGLITE for "flashlights"
- MAG for "flashlights"
- MAG-NUM STAR for "flashlight bulbs"

Assume that the above registered trademarks for both companies have coexisted on the trademark register and in the marketplace for a substantial period of time--fifteen years or more.

Now, here are the questions:

1. Can Company A register MAGNUM MAXFIRE for use on "hand-held portable lamps, namely flashlights and spotlights" in view of Company B's registered trademarks?
2. Can Company B register MAG STAR for use on "flashlights" and related goods in view of Company A's registered trademarks?

Answers after the jump...



The answers are no and no, according to [this July 28, 2010 opinion](#) from the Trademark Trial and Appeal Board. The TTAB held in a consolidated proceeding that [The Brinkmann Corporation](#) could not register its proposed MAGNUM MAXFIRE trademark in view of [Mag Instruments'](#) MAG-NUM STAR registration on the basis of priority and a likelihood of confusion. Similarly, Mag Instruments could not register MAG STAR in view of Brinkmann's MAXSTAR trademark registration.

Like the TTAB, I will assume that both parties are acting in good faith. With that assumption, this case offers an excellent lesson for what can happen when companies are not proactive about policing registered trademarks--trademarks that a company may believe are "not that close" may foreclose a company's ability to register a new trademark--particularly one that appears to be simply a logical extension or next step from the company's existing portfolio. Policing involves asking not just whether there is a likelihood of confusion, but also whether a newly-filed application represents a threat to future expansion.

Obviously, it is sometimes difficult to predict these things, but it does call to mind the old adage of the ounce of prevention being worth the pound of cure. Mag Instruments' MAG-NUM STAR registration pre-dated both the MAXSTAR and MAGNUM MAX trademark applications by Brinkmann, and one wonders whether the current proceedings would have been necessary had Mag Instruments taken a stand years ago against those applications (perhaps they did -- I've not investigated).

We'll keep an eye out for an appeal on this one and report on any developments.

