

## Articles

August 27, 2013

### Trademark Litigators Should Take Care in Alleging "Use of Mark in Commerce" – The Split Between the Second and Sixth Circuits

#### AUTHORS

Justin E. Pierce  
Christopher S. Crook

#### RELATED PRACTICES

Intellectual Property  
Intellectual Property  
Litigation  
Trademarks and Brand  
Protection  
Trademark Litigation

#### ARCHIVES

2013 2009 2005  
2012 2008 2004  
2011 2007 2003  
2010 2006

The Second Circuit recently announced a split with the Sixth Circuit regarding the pleading requirements for trademark infringement under the Lanham Act, 15 U.S.C. §§ 1114, 1125. *See Brown v. Harpo et al.*, 717 F.3d 295 (2d Cir. N.Y. 2013). In both Circuits, plaintiffs are required to allege, among other things, that the allegedly infringing mark has been “used in commerce.” However, the Second and Sixth Circuits have different interpretations of what it means to use a mark in commerce for purposes of satisfying the Lanham Act.

In *Brown*, Defendants argued that Plaintiff failed to allege that Defendants used the mark at issue **as a trademark** in commerce, an essential element of trademark infringement. Defendants relied on cases from the Second and Sixth Circuits in support of their position. The District Court agreed with Defendants and dismissed the case.

On appeal, the Second Circuit disagreed and reversed the District Court, finding that Defendants had misinterpreted prior Second Circuit law by conflating two distinct concepts—use in commerce and use as a trademark in commerce. The appellate court explained that, when determining whether a mark is used in commerce, “we ask whether the trademark has been displayed to consumers in connection with a commercial transaction.” *Op.* at 14. And when determining whether a mark has been used as a trademark, “we ask whether the defendant is using the ‘term as a symbol to attract public attention.’” *Op.* at 13.

The appellate court explained that the law is well settled in the Second Circuit, that “a plaintiff is not required to demonstrate that a defendant made use of the mark in any particular way to satisfy the ‘use in commerce’ requirement.” Rather, the “use in commerce” requirement is met if the mark “is affixed to the goods ‘in any manner.’” *Op.* at 13 (citing cases).

The Second Circuit panel openly acknowledged that the Sixth Circuit *does require* plaintiffs to allege use of an infringing mark *as a trademark* in order to pursue a Lanham Act claim, but stated that the Sixth Circuit’s case law does not comport with the law of the Second Circuit. According to the court, the Sixth Circuit improperly extrapolated this requirement not from the “use in commerce” requirement of the Lanham Act, but from the consumer confusion element of the likelihood of confusion analysis, “reasoning that in instances where the defendant does not use the mark as a designation of origin, consumers are unlikely to be misled as to the source of the goods.” *Op.* at 15.

The court explained that the Sixth Circuit approach is overly narrow and could exclude cases where consumers are confused through a non-trademark use of a mark. *Op.* at 16. The court cited the example of *Rescuecom Corp. v. Google, Inc.*, 562 F.3d 123, 125-26, 129 (2d Cir. 2009), in which it held that the use of a trademark in keyword advertising constitutes a use in commerce despite the fact that the keyword was not technically used as a trademark. The Second Circuit further explained that the factual analysis conducted pursuant to the likelihood of confusion factors is the proper venue for determining whether consumers are confused as opposed to a motion to dismiss.

Trademark litigators should take care to recognize this split when filing a complaint for trademark infringement, thereby avoiding an easy ground for a motion to dismiss.