



## The DuPont Factors: The Trademark Infringement Test Explained

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What is trademark infringement? Without knowing that, you cannot evaluate whether you may be infringing on someone else's trademark or whether someone may be infringing on yours. Once you have a registered trademark, the question of what constitutes trademark infringement becomes of greater concern.

You have put time and money into coming up with your trademark, registering it, perhaps designing an advertising campaign around it and placing it on your packaging. Now, you want to defend it against infringers and you want to avoid having to change it due to the infringement allegations of others. Because a mark cannot be registered if it infringes on another registered mark, infringement may be a grounds for someone seeking to prevent or cancel your registration using a notice of opposition or petition for cancellation.

Having a basic understanding of the test used by courts to determine whether trademark infringement has taken place is a prerequisite to being able to make a reasonable evaluation of the seriousness of any dispute or conflict that arises. This article is intended to give you that understanding.

### **Confusing Similarity**

The test for whether one mark infringes on another is whether the marks are confusingly similar. A major purpose of trademark law is consumer protection. If two marks are confusingly similar, a consumer may be confused into believing that two different products or services are provided

by the same business, when in fact they are provided by different businesses. Thus, the consumer may expect a certain quality or functionality previously experienced with regard to the products of one business, only to be disappointed to find it lacking.

This may lead to harm to the consumer and a loss of goodwill for the business the consumer believes (erroneously) to be producing the disappointing product. In this scenario, one of the businesses may also be free-riding on the goodwill of the other, relying on this confusion to generate business that it would otherwise not receive. Thus another objective of trademark law is to avoid unfair competition of this sort.

If the marks are confusingly similar, the mark with priority (generally, the one used earliest), also known as the “senior mark” is being infringed. To determine whether two marks are confusingly similar, the courts have developed a multi-factor test. Not all courts use the exact same factors, but the factors are generally very similar. The test used at the Federal Circuit has 13 factors (known as the *DuPont* factors) as follows:

1. Appearance, sound, connotation, and commercial impression: The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation, and commercial impression.
2. The Goods: The similarity or dissimilarity and nature of the goods . . . described in an application or registration or in connection with which a prior mark is in use.
3. Trade Channels: The similarity or dissimilarity of established, likely-to-continue trade channels.
4. Sales: The conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing.
5. Fame: The fame of the prior mark
6. Similar Marks: The number and nature of similar marks in use on similar goods.
7. Actual Confusion: The nature and extent of any actual confusion.

8. Concurrent Use: The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion.
9. Variety of Goods: The variety of goods on which a mark is or is not used . . . .
10. Market Interface: The market interface between the applicant and the owner of a prior mark . . .
11. Right to Exclude: The extent to which applicant has a right to exclude others from use of its mark on its goods.
12. Potential Confusion: The extent of potential confusion . . . .
13. Any Other Fact: Any other established fact probative of the effect of use.

These factors are taken together and considered as a whole. They are not given equal weight and any one factor may dominate in a given case. An explanation of each factor follows.

### **1. Similarity In Appearance, Sound, Connotation, and Commercial Impression**

The first DuPont factor is generally the most important. If the marks are not similar in any way, none of the other factors are going to matter. For word marks, a court will look at how long or short the marks are and how many syllables they have, whether they contain the same words with the same meanings, how they would be pronounced, etc.

### **2. Similarity of the Goods**

The second, and perhaps next most important factor, is the similarity of the goods or services on which each mark is used. The key question is whether consumers are likely to be confused by the similarity of the marks. If the types of goods on which each mark is used vary dramatically, confusion is less likely. A consumer would not expect a tire manufacturer, for example, to also make cosmetics.

So if there were two similar marks, but one was used on tires and one on face cream, that might not be confusing to a consumer.

### **3. Similarity of Trade Channels**

How are the goods or services associated with each mark sold and distributed? If both sets of goods are sold in the same types of stores to the same types of people, confusion is more likely.

### **4. Sophistication of Buyers and Conditions Under Which Sales Are Made**

Although sophistication could cut both ways, generally it is considered to make confusion less likely. If the goods are industrial equipment and the purchasers are experts in such equipment who carefully evaluate the goods before purchase, it is less likely they will be confused by a similarity between two marks. They have taken the time to evaluate who is selling the goods and what the goods are.

In contrast, retail sales to the general public may be “impulse” purchases, made without careful consideration. Such buyers may have little knowledge of the goods they are buying and may be easily confused by two similar marks, which they do not consider carefully.

### **5. Fame of Prior Mark**

This could also cut both ways (a customer might be very familiar with a very famous mark and might be unlikely to confuse it with a small shop, etc.) but is generally considered to make confusion more likely. Consumers are more likely to be aware of a famous mark and to expect to see it and to have certain expectations about products with that mark.

## **6. Number and Nature of Similar Marks**

If the industry is “crowded” with many similar marks for similar products, confusion is less likely. A consumer will be used to seeing different similar marks for similar products and will not necessarily make the connection that two different but similar marks must come from the same source.

## **7. Actual Confusion**

Any instances of actual confusion by consumers will suggest that the marks are confusingly similar. If consumers are complaining to the wrong business about the quality of the product, or calling the wrong business for technical support, or contacting the wrong business to ask if they are the source of a product, based on the trademark, those are instances of actual confusion.

## **8. Length of Concurrent Use Without Actual Confusion**

If two marks have been in use at the same time over an extended period and there have been no instances of actual consumer confusion, that is an indication that the marks are not in fact confusingly similar.

## **9. The Variety of Goods On Which a Mark is Used**

If a mark is only used on one type of goods, for example only tires, it is less likely that a consumer will believe that a different type of goods is made by the same business, even if the trademark is similar (think about my earlier tires/cosmetic example). In contrast, if a mark is used on a wide variety of goods, confusion may be more likely, as a consumer will more readily believe that a

different type of product is made by the same company. For example, if the mark were used on both tires, and toys and accessories, maybe use of the mark on cosmetics would be a little less unbelievable.

## **10. Market Interface Between Applicant and Owner of Prior Mark**

This factor looks at how the two mark holders have interacted in the marketplace. Has the prior owner consented to the use of the other mark owner? This may suggest a lack of confusion. Have they agreed to take steps to minimize the potential confusion for consumers, for example by agreeing to continue using each mark only for certain goods, or in certain areas, or with certain marketing limitations? This may help to avoid confusion, but it could also indicate the possibility for such confusion. Has the prior owner failed to take steps to prevent the other owner from registering or using the mark? That may indicate a lack of confusion.

## **11. Right of Applicant to Exclude Others**

Does the applicant have a long-standing and well-known trademark associated with a specific type of goods? This may weigh in favor of finding no confusion and allowing registration of the application, to avoid the confusion that would result from others taking advantage of the applicant's goodwill and inability to protect their trademark.

## **12. Extent of Potential Confusion**

Is any confusion likely to be “de minimus”, or minor and unimportant? Or will there be substantial confusion that can cause real problems? Will consumers believe they will be getting one thing but instead get another? Will they be calling the wrong company for technical support, etc.?

Notice

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