

Claims of trademark infringement are becoming increasingly more common worldwide. A **trademark** is a word, symbol, or phrase, used to identify a particular manufacturer or seller's product and distinguish them from those sold by another. Technically, trademarks are used on both goods and services, with the latter marks often being referred to as "service marks." Under certain circumstances, trademark protection can extend to include other aspects of a product, such as color or packaging. Such features generally fall under the term "trade dress" and may be protected if consumers associate that feature with a particular manufacturer rather than the product in general. However, keep in mind, a manufacturer cannot lock up the use of a particular unique bottle shape if the shape confers some sort of functional advantage (e.g. ease in stacking or grip). One can apply for a trademark before it is used, so long as one has a bona fide intention to use the mark in commerce.

Federal registration of the trademark gives the owner certain enhanced rights.

Trademark infringement is a violation of the exclusive rights attaching to a trademark without the authorization of the trademark owner or any licensees (provided that such authorization was within the scope of the license). A touchstone to trademark infringement is the likelihood of confusion. An infringement may occur when a party, the "infringer," uses a mark which is identical or confusingly similar to a trademark owned by another party in relation to products or services which are identical or similar to the products or services which the registration covers.

In *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341 (C.A.9) 1979, the Ninth Circuit Court of Appeals established eight specific elements to establish likelihood of confusion relating to a mark:

1. Strength of the Plaintiff's mark;
2. Similarity of the goods and services involved;
3. Similarity in the overall impression created by the mark;
4. Evidence of actual confusion by consumer;
5. Marketing channels used;
6. Type of goods and the degree of care likely to be exercised by the purchaser;
7. Defendant's intent in adopting the mark;
8. Likelihood of expansion of the product lines.

Of these eight elements, the first three are the most important. The plaintiff in a trademark infringement case has the overall burden of proving that the defendant's use of a mark has created a likelihood of confusion about the origin of the defendant's goods or services. In order to do this, the plaintiff must show that it has developed a protectable trademark right in a trademark. The plaintiff then must show that the defendant is using a confusing similar mark in such a way that it creates a likelihood of confusion, mistake and/or deception with the consumer. The confusion can be that the defendant's products are the same as plaintiffs or somehow associated, affiliated, connected, approved, authorized or sponsored by plaintiff.

If the respective marks and products or services are entirely dissimilar, trademark infringement may still be established if the registered mark is well known pursuant to the Paris Convention. In the United States, a cause of action for use of a mark for such dissimilar services is called "trademark dilution." This damage can occur in two different ways. The first is a blurring of the distinctiveness of the mark (the mark is used on a number of different goods and services not controlled by the original owner, the original owner's mark will lose "cachet" or distinctiveness. The second damage to the mark is by tarnishment (the original mark is used in such a way that the consumer knows, because of the context or usage, that there is no connection between the owners of the respective marks). Use of the mark by the other party brings the trademark owner's mark into disrepute or shows the trademark in a bad light.

The most common relief granted to a successful Plaintiff in a trademark infringement case is an injunction against further infringement, attorney's fees and possible damages under the Lanham Act.