

**15.18 Infringement—Likelihood of Confusion—Factors—*Sleekcraft* Test
(15 U.S.C. §§ 1114(1) and 1125(a))**

The plaintiff asserts that [*insert trademark*] is a trademark for its goods. The plaintiff contends that the defendant's use of [*insert the defendant's mark*] in connection with the defendant's [*insert the defendant's product*] infringes the plaintiff's trademark because it is likely to cause confusion.

You must consider whether a reasonably prudent consumer in the marketplace is likely to be confused as to the origin of the goods bearing one of the marks.

I will suggest some factors you should consider. You should not focus on any one factor to resolve whether there was a likelihood of confusion, because you must consider all relevant evidence. As you consider the likelihood of confusion you should examine the following:

- (1) Strength or Weakness of the Plaintiff's Mark. The more distinctive the plaintiff's mark is and the more the consuming public recognizes the plaintiff's trademark, the more likely it is that consumers would be confused about the source of the defendant's goods if the defendant uses a similar mark.
- (2) The Defendant's Use of the Mark. If the defendant and the plaintiff use their trademarks on the same, related, or complementary kinds of goods, there may be a greater likelihood of confusion about the source of the goods than otherwise.
- (3) Similarity of the Plaintiff's and the Defendant's Marks. If the overall impression created by the plaintiff's trademark in the marketplace is similar to that created by the defendant's trademark in [appearance] [sound] [or] [meaning], there is a greater chance [that consumers are likely to be confused by the defendant's use of a mark] [of likelihood of confusion]. [Similarities in appearance, sound or meaning weigh more heavily than differences in finding the marks are similar.]
- (4) Actual Confusion. If the defendant's use of the plaintiff's trademark has led to instances of actual confusion, this strongly suggests a likelihood of confusion. However, actual confusion is not required for a finding of likelihood of confusion. Even if actual confusion did not occur, the defendant's use of the trademark may still be likely to cause confusion. As you consider whether the trademark used by the defendant creates for consumers a likelihood of confusion with the plaintiff's trademark, you should weigh any instances of actual confusion against the opportunities for such confusion. If the instances of actual confusion have been relatively frequent, you may find that there has been substantial actual confusion. If, by contrast, there is a very large volume of sales, but only a

few isolated instances of actual confusion, you may find that there has not been substantial actual confusion.

- (5) The Defendant's Intent. Knowing use by the defendant of the plaintiff's trademark to identify similar goods may strongly show an intent to derive benefit from the reputation of the plaintiff's mark, suggesting an intent to cause a likelihood of confusion. On the other hand, even in the absence of proof that the defendant acted knowingly, the use of the plaintiff's trademark to identify similar goods may indicate a likelihood of confusion.
- (6) Marketing/Advertising Channels. If the plaintiff's and the defendant's goods are likely to be sold in the same or similar stores or outlets, or advertised in similar media, this may increase the likelihood of confusion.
- (7) Consumer's Degree of Care. The more sophisticated the potential buyers of the goods or the more costly the goods, the more careful and discriminating the reasonably prudent purchaser exercising ordinary caution may be. They may be less likely to be confused by similarities in the plaintiff's and the defendant's trademarks.
- (8) Product Line Expansion. When the parties' products differ, you may consider how likely the plaintiff is to begin selling the products for which the defendant is using the plaintiff's trademark. If there is a strong possibility of expanding into the other party's market, there is a greater likelihood of confusion.
- [(9) Other Factors. Insert any other factors that bear on likelihood of confusion.]

Comment

The Ninth Circuit has often reaffirmed the validity of the eight-factor test from *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979), *abrogated in part on other grounds by Mattel, Inc., v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003), that is covered in this instruction. *See, e.g., Multi Time Mach., Inc. v. Amazon.com, Inc.*, 804 F.3d 930, 935 & n.1 (9th Cir. 2015) ("To analyze likelihood of confusion, we utilize the eight-factor test set forth in *Sleekcraft*. However, '[w]e have long cautioned that applying the *Sleekcraft* test is not like counting beans.'" (quoting *One Indus. LLC v. Jim O'Neal Distrib., Inc.*, 578 F.3d 1154, 1162 (9th Cir. 2009))).

Because the eight likelihood-of-confusion factors identified in *Sleekcraft* are neither exclusive nor exhaustive, the Committee recommends that the judge instruct only on the factors that are relevant in the case presented to the jury. *See Brookfield Commc'ns Inc. v. W. Coast Ent. Corp.*, 174 F.3d 1036, 1054 (9th Cir. 1999) ("[I]t is often possible to reach a conclusion with respect to likelihood of confusion after considering only a subset of the [*Sleekcraft*] factors[.] . . .

[which do] not purport to be exhaustive, and non-listed variables may often be quite important.”); *Metro Pub., Ltd. v. San Jose Mercury News*, 987 F.2d 637, 640 (9th Cir. 1993) (“Because each [*Sleekcraft*] factor is not necessarily relevant to every case, this list functions as a guide and is neither exhaustive nor exclusive.” (citation and internal quotation omitted)), *abrogated in part on other grounds by Cooter & Gell v. Hartmarx Corp.*, 496 U.S. 384, 405 (1990).

Moreover, the third paragraph in this instruction warns that a jury should not focus on any one factor and to consider all relevant evidence in assessing likelihood of confusion. *See Kendall-Jackson Winery Ltd. v. E. & J. Gallo Winery*, 150 F.3d 1042, 1052 n.13 (9th Cir. 1998) (elaborating further on instructions on *Sleekcraft* factors dealing with defendant’s intent to cause confusion and causing actual confusion); *Brookfield Commc’ns*, 174 F.3d at 1054 (“A word of caution: This eight-factor [*Sleekcraft*] test for likelihood of confusion is pliant. Some factors are much more important than others, and the relative importance of each individual factor will be case-specific.”).

Domain Names. In trademark infringement cases involving domain names, the Ninth Circuit has affirmed the use of an additional instruction indicating that three of the *Sleekcraft* factors: (i) similarity of plaintiff’s and defendant’s mark; (ii) relatedness of services; and (iii) simultaneous use of the Internet as a marketing channel, otherwise known as the “Internet Troika,” are of greater importance. *Internet Specialties W., Inc. v. Milon-Digiorgio Enters., Inc.*, 559 F.3d 985, 989 (9th Cir. 2009) (holding that law of Ninth Circuit “places greater import on the ‘Internet Troika’ in Internet cases”).

Relevant Consumer Market. In *Rearden LLC v. Rearden Commerce, Inc.*, 683 F.3d 1190 (9th Cir. 2012), the Ninth Circuit assessed the relevant market as it examined one of the *Sleekcraft* factors—evidence of actual confusion. 683 F.3d at 1214. This instruction does not ask the jury or the court to first define the relevant consumer market before proceeding to the *Sleekcraft* factors; *but see Ironhawk Techs., Inc. v. Dropbox 2* F.4th 1150 (9th Cir. 2021).

Counterfeit Marks. There is a presumption of a likelihood of confusion “when the offending mark is a counterfeit mark, or a mark virtually identical to a previously registered mark coupled with the intent to pass off or borrow from established good will.” *Louis Vuitton Malletier, S.A. v. Akanoc Sols., Inc.*, 658 F.3d 936, 945 (9th Cir. 2011) (approving instruction). A counterfeit mark is “a counterfeit of a mark that is registered . . . , whether or not the person against whom relief is sought knew such mark was so registered.” *Id.* (quoting 15 U.S.C. § 1116(d)(1)(B)(i)).

Reverse Confusion. The Ninth Circuit recognizes two theories of consumer confusion that support a claim of trademark infringement: forward confusion and reverse confusion. Forward confusion occurs when consumers believe that goods bearing the junior mark came from, or were sponsored by, the senior mark holder. By contrast, reverse confusion occurs when consumers dealing with the senior mark holder believe that they are doing business with the junior mark holder. Reverse confusion is not a separate trademark claim that must be specifically pleaded. Instead, it is a theory of likely confusion that may be alleged by itself or in addition to forward confusion. *Marketquest Grp., Inc. v. BIC Corp.*, 862 F.3d 927, 932, 937 (9th Cir. 2017);

see also Ironhawk Techs., 2 F.4th at 1165 (“Evidence of actual confusion by consumers is strong evidence of likelihood of confusion.” Nevertheless, “failure to prove instances of actual confusion is not dispositive.” (citations omitted)).

Revised March 2024