

AMERICAN UNIVERSITY OF ARMENIA

LIKELIHOOD OF CONFUSION TESTS AND THEIR IMPORTANCE

Comparative Analysis of the US and Armenian Trademark Legislation and Practices

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1. Introduction

One of the most important fields of law in today's growing knowledge based economies, intellectual property rights, has been disregarded for many years in Armenia. The main reason for that was the absence of a free market economy in Armenia. However, according to the Armenian Intellectual Property Agency's statistics, as of today, starting from 1990s, Armenian Trademark Office has registered more than 65,000 trademarks and this number continues growing by up to five thousand trademarks, per year. The growing number of trademarks and competition among various companies and organizations led to many trademark infringement disputes in Armenia. However, the Armenian attorneys, litigators and judges lack sufficient practical skills and knowledge in this area of law, which may be noted by the existing improperly or unsatisfactorily analyzed court decisions.

The purpose of this paper is to 1) compare some of the most important aspects of the Armenian trademark legislation and practices with the legislation and practices of a country having developed intellectual property rights system, such as the United States of America; 2) identify the existing issues; and 3) propose relevant solutions. In particular, this paper focuses on one of the most important and sensitive aspects of the Armenian trademark legislation, namely the determination of a potential confusion or a possibility of confusion (likelihood of confusion) between two marks that may lead to a trademark infringement. The main reason for selecting this particular topic and issue is the uncertainty, lack of practical skills among Armenian trademark lawyers, litigators and judges with respect to applying relevant methods or tests for determining a likelihood of confusion between two marks, i.e. determining whether it is likely that the public will be confused or misled by the use of one company's trademark that seems or is alleged to be similar to the mark of another company.

The research of the Armenian local practices, the analysis of the trademark case law and interviews with various trademark attorneys, experts, law firms and representatives of relevant governmental organizations showed that there is sufficient lack of awareness of international best practices among trademark litigators and judges, uncertainty in making trademark infringement related decisions and lack of proper judicial practice in this area. These issues led to unpredictability of the Armenian courts' decisions, in this field. The courts are making approximate rather than well analyzed and reasoned decisions. The trademark applicants and right-holders are being treated unequally and subjectively. All the issues above create good basis for long-lasting corruption in this field, in Armenia.

The research of the US legislation and practices shows that the US trademark attorneys, trademark examiners, litigators and the courts, within last thirty years, have developed objective, useful and practical tools for addressing and solving the issues above.

Taking into consideration the rich practice of the US trademark case law, this paper proposes a solution to the issues above by introducing relevant guidelines proposed to be used by the Armenian trademark litigators and the courts, which will not only make their job easier and more straightforward but will also ensure making more objective and well reasoned decisions.

The views expressed in this paper are supported by a number of trademark attorneys such as Sarkis Knyazyan, the Managing Partner of Knyazyan & Partners Law Office, experts, as well as local judges (who heard trademark infringement cases in Armenia), such as Judge Chilingaryan.¹ It is worth to introduce briefly their views on this issue.

2. Similarities and Differences between the US and Armenian Trademark Legislation and Practices

The US Trademark legislation is regulated by the US Constitution, Article 1, Section 8, Clause 3 (the Commerce Clause), Trademark Act (Lanham Act), Implementing legislation and several

¹ Chilingaryan, Karen. Personal interview. 15 March 2011

international treaties and conventions. Statutory basis for a refusal to register a trademark due to **likelihood of confusion** with another mark is stipulated in Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), according to which:

“No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration ... on account of its nature unless it ... consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive....”²

The Armenian Trademark legislation is regulated by the Constitution of the Republic of Armenia (RA), RA Civil Code, RA Trademark Law, RA Implementing legislation and several international treaties and conventions. Statutory basis for a refusal to register a trademark due to **likelihood of confusion** with another mark is stipulated in RA Trademark law, Article 9(1) and 10(1) and (4), which, in essence, has the same requirements as the Section 2(d) of the US Trademark Act, above. The main difference, however, between the two countries’ trademark legislation, is in the tests applied for determination of **likelihood of confusion**. This matter, in more details, is discussed in the sections below.

2.1. Likelihood of Confusion Tests applied by the US and Armenian Patent and Trademark Offices

The United States Patent and Trademark Office (USPTO) is the Federal agency for granting U.S. patents and registering trademarks. In doing so, the USPTO fulfills the mandate of Article I, Section 8, Clause 8, of the Constitution i.e. to "*promote the progress of science and the useful arts by securing for*

² US Trademark Act (Lanham Act) - 15 U.S.C. §1052(d).

limited times to inventors the exclusive right to their respective discoveries." Trademarks are protected in the US based on the Commerce Clause of the US Constitution (Article 1, Section 8, Clause 3). The Agency for granting patents and registering trademarks in Armenia is the Armenian Intellectual Property Agency (AIPA) of the Ministry of Economy of the Republic of Armenia. All intellectual property rights, including trademarks are protected in Armenia based on the Constitution, Article 31.

The USPTO's refusal, under the U.S. Trademark Act §2(d), is normally based on the examining attorney's conclusion that the applicant's mark, as used on or in connection with the specified goods or services, so resembles a registered mark as to be likely to cause confusion.³ For that purpose the examining attorney conducts an official search in the United States Patent and Trademark Office's (USPTO) records to determine whether the applicant's mark so resembles any registered mark(s) (including pending applications) as to be likely to cause confusion or mistake, when used on or in connection with the goods or services identified in the application. If the examining attorney determines that there is a likelihood of confusion between applicant's mark and a previously registered mark, the examining attorney refuses registration under Trademark Act, §2(d). A similar procedure, without any major differences, is prescribed by the Armenian Trademark legislation.

As a rule, examiners' conclusions are based upon and the *likelihood of confusion* is determined by relevant tests. The main difference between the US and Armenian trademark legislation and practices, including case law, with respect to *likelihood of confusion*, is in these tests and their application. For example, in 1982 the US Court of Customs and Patent Appeals (CCPA)⁴ discussed the factors relevant to a determination of *likelihood of confusion* and stated that in an *ex parte* examination, the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks

³ See Trademark Manual of Examining Procedure (TMEP) §1207.02 concerning §2(d) refusals to register marks that so resemble another mark as to be likely to deceive, and TMEP §1207.03 concerning §2(d) refusals based on unregistered marks.

⁴ Currently, the US Court of Appeals for the Federal Circuit, which was established under Article III of the Constitution on October 1, 1982 by the merger of the US Court of Customs and Patent Appeals and the appellate division of the US Court of Claims.

and the relatedness of the goods or services.⁵ Other factors may be considered only if relevant evidence is contained in the record.⁶ In an *ex parte* case, the following six factors are usually the most relevant:

- 1st Factor:** The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression.
- 2nd Factor:** The relatedness of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
- 3rd Factor:** The similarity or dissimilarity of established, likely-to-continue trade channels.
- 4th Factor:** The conditions under which and buyers to whom sales are made, i.e., “impulse” vs. careful, sophisticated purchasing.
- 5th Factor:** The number and nature of similar marks in use on similar goods.
- 6th Factor:** A valid consent agreement between the applicant and the owner of the previously registered mark.⁷

Each of the factors above is discussed in more details, below. Unlike the Court of Appeals for the Federal Circuit (formerly US Court of Customs and Patent Appeals), Armenian Administrative Court (that has a similar jurisdiction in Armenia) does not have an established trademark case law providing any special guidelines to the Armenian Intellectual Property Agency (Armenian Trademark Office) to be applied for the purposes of determining *likelihood of confusion*. In many cases the Armenian Administrative Court itself applies the regulations developed by the Armenian Trademark Office,

⁵ See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973).

⁶ See *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003) (“Not all of the DuPont factors may be relevant or of equal weight in a given case, and ‘any one of the factors may control a particular case,’” quoting *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)); *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 640 (TTAB 1984).

⁷ See *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003) (“Not all of the DuPont factors may be relevant or of equal weight in a given case, and ‘any one of the factors may control a particular case,’” quoting *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)); *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 640 (TTAB 1984).

because of lack of relevant practice in this area of law. Unlike, e.g. *DuPont* case above, where the US Court of Customs and Patent Appeals provided the fundamental factors as guidelines for determining *likelihood of confusion* by the US Patent and Trademark Office, as well as the US Court of Appeals for the Federal Circuit, the guidelines for determining *likelihood of confusion* by the Armenian Trademark Office, are drafted and implemented by the same governmental agency, without taking into consideration the international best practices, i.e. the legislation, guidelines and case law of countries with a developed intellectual property rights legislation and case law. The only regulation developed in Armenia to be used for the purpose above, is the RA Government Resolution No. 1538-N, dated November 18, 2010 (which is the implementing regulation of RA 2010 Trademark Law) (hereinafter “Regulation”). The main difference is that the Armenian Regulation does not provide guidelines for determining *likelihood of confusion*, it rather, in its pertinent parts, provides guidelines as to how to determine the *confusing similarity* between the marks, which in essence, is just one of the components of the *likelihood of confusion* test applied in the United States.

Here, in more details, the paper describes the factors above applied by the USPTO and compares them with the Armenian Trademark Office’s practices.

1st Factor - The Similarity or Dissimilarity of the Marks

As discussed above, the first factor usually requires examination of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. However, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison, but whether the marks are sufficiently similar that there is a likelihood of confusion as to the source of the goods or services.⁸

⁸ TMEP, United States Patent and Trademark Office, Sixth Edition, Rev. 1, October 2009

A) Word Marks

The points of comparison for a word mark are appearance, sound, meaning, and commercial impression.⁹ Armenian Trademark legislation is not different from this approach.¹⁰ However, similarity of the marks in one respect – sight, sound, or meaning – will not automatically result in a finding of likelihood of confusion even if the goods are identical or closely related. Rather, the rule is that taking into account all of the relevant facts of a particular case, similarity as to one factor alone may be sufficient to support a holding that the marks are confusingly similar.¹¹

B) Similarity in Appearance

Similarity in appearance is one the factors in determining whether there is a likelihood of confusion between the marks. It is well established by many decisions that the marks may be confusingly similar in appearance despite the addition, deletion, or substitution of letters or words. For example in *Weiss Associates Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) the court held that the mark “TMM” is confusingly similar to the mark “TMS” (both mark were used for systems software). In *Canadian Imperial Bank of Commerce, N.A., v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) the court held that the mark “COMMCASH” is likely to be confused with “COMMUNICASH” (both marks were used for banking services). Other courts held that e.g. “AUDIO BSS USA” word mark and its design for car power amplifiers, car speakers, car stereos, and home theater speakers is likely to be confused with the mark “BOSS AUDIO SYSTEMS” and its design for

⁹ *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005), citing *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)

¹⁰ RA Government Decision No. 1538-N, dated 18.11.2010 (“RA Trademark Regulation”), Articles 115-117.

¹¹ *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987)

automobile audio components;¹² the mark “MILTRON” for microprocessor used in commercial laundry machines is likely to be confused with the stylized mark “MILLTRONICS” for electronic control devices for machinery.¹³

Despite the lack of relevant judicial practice, the Armenian legislation is relatively similar to that of US, with respect to this particular matter.¹⁴

C) Comparing Marks That Contain Additional Matter

It is a general rule that likelihood of confusion is not avoided between otherwise confusingly similar marks merely by adding or deleting a house mark or matter that is descriptive or suggestive of the named goods or services.¹⁵ Sometimes, the rule is expressed in terms of the dominance of the common term.¹⁶ Therefore, if the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences. For example the court in *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 96 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005) held that VEUVE ROYALE for sparkling wine is likely to be confused with VEUVE CLICQUOT and VEUVE CLICQUOT PONSARDIN for champagne, noting that the presence of the “strong distinctive term [VEUVE] as the first word in both parties’ marks renders the marks similar, especially in light of the largely laudatory (and hence non-source identifying) significance of the word ROYALE”. In *In re Denisi*, 225 USPQ 624 (TTAB 1985) the court found “PERRY’S PIZZA” likely to be confused with “PERRY’S,” (both for restaurant services).

¹² *Ava Enterprises, Inc. v. Audio Boss USA, Inc.*, 77 USPQ2d 1783 (TTAB 2006)

¹³ *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983)

¹⁴ RA Trademark Regulation, Articles 118-122.

¹⁵ Trademark Manual of Examining Procedure, United States Patent and Trademark Office, Sixth Edition, Rev. 1, October 2009.

¹⁶ *Id.*

Exceptions to the above-stated general rule regarding additions or deletions to marks may arise if:¹⁷

- (1) the marks in their entireties convey significantly different commercial impressions; or
- (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.

For example the court in *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) held that the marks “RITZ” and “THE RITZ KIDS” create different commercial impressions and are unlikely to be confused.

With respect to the first part of this subsection, the Armenian legislation provides a similar approach,¹⁸ however there are no such exceptions as provided in the second part.

D) Similarity in Sound – Phonetic Equivalents

Similarity in sound is another factor in determining whether there is a likelihood of confusion between marks. There is no “correct” pronunciation of a trademark because it is impossible to predict how the public will pronounce a particular mark.¹⁹ Therefore, “correct” pronunciation cannot be relied on to avoid a likelihood of confusion. For example, in *Centraz Industries Inc. v. Spartan Chemical Co. Inc.*, 77 USPQ2d 1698, 1701 (TTAB 2006) the court acknowledged that “*there is no correct pronunciation of a trademark*” and found that stylized mark “ISHINE” is likely to be confused with the word mark “ICE SHINE” (both are used for floor-finishing preparations. In *In re Energy Telecommunications & Electrical Ass’n*, 222 USPQ 350 (TTAB 1983) the court held that the mark “ENTELEC” for association services in the telecommunication and energy industries is likely to be confused with “INTELECT” for conducting expositions for the electrical industry. And lastly, in *In re Cresco Mfg. Co.*, 138

¹⁷ *Id.*

¹⁸ RA Trademark Regulation, Article 118.

¹⁹ *Id.*

USPQ 401 (TTAB 1963) the court held that the mark “CRESCO” for leather jackets is likely to be confused with “KRESSCO” for hosiery.

The relevant provision in the Armenian legislation is Article 117 of the RA Trademark Regulation; however, it does not clearly regulate this particular aspect.

E) Similarity in Meaning

Similarity in meaning or connotation is another factor in determining whether there is a likelihood of confusion between marks.²⁰ The focus is on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks.²¹ The meaning or connotation of a mark must be determined in relation to the named goods or services.²² Even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties’ goods or services so that there is no likelihood of confusion. For example, in *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987) held that the mark “CROSS-OVER” for bras is not likely to be confused with “CROSSOVER” for ladies’ sportswear. In *In re British Bulldog*, 1200-178 October 2009 Ltd., 224 USPQ 854 (TTAB 1984) the court held that the mark “PLAYERS” for men’s underwear is not likely to be confused with “PLAYERS” for shoes. Lastly, the court in *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977) held that the mark “BOTTOMS UP” for ladies’ and children’s underwear is not likely to be confused with “BOTTOMS UP” for men’s clothing.

²⁰ *Id.*

²¹ See, e.g., *In re M. Serman & Co., Inc.*, 223 USPQ 52 (TTAB 1984) (CITY WOMAN held likely to be confused with CITY GIRL, both for clothing); *Gastown Inc., of Delaware v. Gas City, Ltd.*, 187 USPQ 760 (TTAB 1975) (GAS CITY (“GAS” disclaimed) held likely to be confused with GASTOWN, both for gasoline); *Watercare Corp. v. Midwesco-Enterprise, Inc.*, 171 USPQ 696 (TTAB 1971) (AQUA-CARE (stylized) held likely to be confused with WATERCARE (stylized), both for water-conditioning products).

²² TMEP, United States Patent and Trademark Office, Sixth Edition, Rev. 1, October 2009.

Although the Armenian Regulation does specify the importance of similarity in meaning,²³ however, it does not provide clear guidelines with respect to this particular issue and the trademark examiners have a wide discretion to apply their subjective view on this matter and in most cases they are free to find confusing similarity between the marks without concentrating on a *different commercial impression*.

2nd Factor - Relatedness of the Goods or Services

If it appears that confusion may be likely as a result of the contemporaneous use of similar marks by the registrant and the applicant with the identified goods or services, the next step is to evaluate the marks themselves, in relation to the goods and services.²⁴ In some instances, because of established marketing practices, the use of identical marks on seemingly unrelated goods and services could result in a likelihood of confusion.²⁵

A) Goods or Services Need Not Be Identical

The goods or services do not have to be identical or even competitive in order to determine that there is a likelihood of confusion.²⁶ *The inquiry is whether the goods are related, not identical.*²⁷ *The issue is not whether the goods will be confused with each other, but rather whether the public will be confused about their source.*²⁸ It is sufficient that the goods or services of the applicant and the registrant are so related that the circumstances surrounding their marketing are such that they are likely to be encountered by the same persons under

²³ RA Trademark Regulation, Article 119.

²⁴ *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)

²⁵ *In re Phillips-Van Heusen Corp.*, 228 USPQ 949, 951 (TTAB 1986) (“*The licensing of commercial trademarks for use on ‘collateral’ products (such as clothing, glassware, linens, etc.), that are unrelated in nature to those goods or services on which the marks are normally used, has become a common practice in recent years.*”)

²⁶ TMEP, United States Patent and Trademark Office, Sixth Edition, Rev. 1, October 2009.

²⁷ *Id.*

²⁸ *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975).

circumstances that would give rise to the mistaken belief that they originate from the same source.²⁹ Conversely, if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely.³⁰ The Armenian legislation does not provide clear guidelines with respect to this matter.

B) Goods May Be Related to Services

It is well recognized that confusion is likely to occur from the use of the same or similar marks for goods, on one hand, and for services involving those goods, on the other. For example, the court in *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) held that the stylized mark “BIGG’S” for retail grocery and general merchandise store services is likely to be confused with the mark “BIGGS” for furniture. The court in *In re H.J. Seiler Co.*, 289 F.2d 674, 129 USPQ 347 (C.C.P.A. 1961) held that the mark “SEILER’S” for catering services is likely to be confused with “SEILER’S” for smoked and cured meats. The court in *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) held that the mark “21 CLUB” for various items of men’s, boys’, girls’, and women’s clothing is likely to be confused with the stylized mark “THE “21” CLUB” for restaurant services and towels.

Unfortunately, there are no clear guidelines with respect to this matter in the Armenian legislation.

²⁹ See, e.g., *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000) (ON-LINE TODAY for Internet connection services held likely to be confused with ONLINE TODAY for Internet content); *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984) (MARTIN’S for wheat bran and honey bread held likely to be confused with MARTIN’S for cheese).

³⁰ TMEP, United States Patent and Trademark Office, Sixth Edition, Rev. 1, October 2009. See, e.g., *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field).

C) Food and Beverage Products Versus Restaurant Services

While *likelihood of confusion* has often been found in situations where similar marks are used in connection with both food or beverage products and restaurant services, there is no per se rule to this effect.³¹ To establish *likelihood of confusion*, a party must show “something more than that those similar or even identical marks are used for food products and for restaurant services.”³² There are no clear guidelines with respect to this matter in the Armenian legislation.

The determination of the relatedness of the goods and services is usually based on the evidence provided by the applicant and the examining attorney.³³ In *Coors*, the examining attorney introduced evidence from several sources discussing the practice of some restaurants to offer private label or house brands of beer; evidence that brewpubs who brew their own beer often feature restaurant services; and copies of third-party registrations showing that a single mark had been registered for beer and restaurants services.³⁴ However, applicant countered with evidence that while there are about 1,450 brewpubs and microbreweries in the United States, there are over 800,000 restaurants, which means that brewpubs and microbreweries account for only about 18 one-hundredths of one percent of all restaurants.³⁵ Noting that “[t]here was no contrary evidence introduced on those points,” the court found that: While there was evidence that some restaurants sell private label beer, that evidence did not suggest that such restaurants are numerous.³⁶ And although the Board had before it a few registrations for both restaurant services and beer, the very small number of such dual use registrations does nothing to counter *Coors*’ showing that only a very small percentage of restaurants actually

³¹ TMEP, United States Patent and Trademark Office, Sixth Edition, Rev. 1, October 2009.

³² *In re Coors Brewing Co.*, 343 F.3d 1340, 1345, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003) (no likelihood of confusion between applicant’s BLUE MOON and design for beer and the registered mark BLUE MOON and design for restaurant services); *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 1236, 212 USPQ 641, 642 (C.C.P.A. 1982) (no likelihood of confusion between BOSTON SEA PARTY for restaurant services and BOSTON TEA PARTY for tea).

³³ TMEP, United States Patent and Trademark Office, Sixth Edition, Rev. 1, October 2009.

³⁴ 343 F.3d at 1346, 68 USPQ2d at 1063-1064.

³⁵ *Id.*

³⁶ *Id.*

brew their own beer or sell house brands of beer; instead, the small number of such registrations suggests that it is quite uncommon for restaurants and beer to share the same trademark.³⁷ Thus, the evidence before the Board indicates not that there is a substantial overlap between restaurant services and beer with respect to source, but rather that the degree of overlap between the sources of restaurant services and the sources of beer is de minimis.³⁸ For example the court in *In re Comexa Ltd.*, 60 USPQ2d 1118, 1123 (TTAB 2001) found a likelihood of confusion between the mark “AMAZON” for restaurant services and the mark “AMAZON” for chili sauce and pepper sauce.

D) Evidence Showing Relatedness of Goods or Services

The examining attorney must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion.³⁹ Evidence of relatedness might include news articles and/or evidence from computer databases showing that the relevant goods/services are used together or used by the same purchasers; advertisements showing that the relevant goods/services are advertised together or sold by the same manufacturer or dealer; or copies of prior use-based registrations of the same mark for both applicant’s goods/services and the goods/services listed in the cited registration.⁴⁰ The identification of goods/services in the subject application and in the cited registration(s) may in itself constitute evidence of the relatedness of the goods or services.⁴¹ According to Armenian trademark attorneys,⁴² trademark examiners, in Armenia, usually do not provide detailed reasoning or evidence.

³⁷ *Id.*

³⁸ *Id. In re Golden Griddle Pancake House Ltd.*, 17 USPQ2d 1074 (TTAB 1990) (likelihood of confusion between GOLDEN GRIDDLE for table syrup and GOLDEN GRIDDLE PANCAKE HOUSE for restaurant that serves pancakes and syrup); *Steve’s Ice Cream v. Steve’s Famous Hot Dogs*, 3 USPQ2d 1477, 1478 (TTAB 1987) (no likelihood of confusion between STEVE’S for ice cream and STEVE’S for restaurant featuring hot dogs, where the marks differed and “there [was] no evidence in the record before us that applicant makes or sells ice cream, or that any one business makes and sells ice cream under the same mark in connection with which it renders restaurant services”).

³⁹ TMEP, United States Patent and Trademark Office, Sixth Edition, Rev. 1, October 2009.

⁴⁰ *Id.* at §1207.01(d)(iii) and cases cited therein regarding the probative value of third-party registrations.

⁴¹ *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (Board erred in finding that there was insufficient evidence of relatedness, “because the Board did not consider the important evidence already before it, namely the ITU application and [opposer’s multiple] registrations”).

⁴² Knyazyan, Sarkis. Personal interview. 25 Feb 2011

They may simply refuse the registration and let the applicant to request an additional examination of the mark and provide his/her reasoning as to why the mark is subject to registration.

3rd Factor - The similarity or dissimilarity of established, likely-to-continue trade channels

The examining attorney must consider any goods or services in the registrant's normal fields of expansion to determine whether the registrant's goods or services are related to the applicant's identified goods or services under §2(d).⁴³ A trademark owner is entitled to protection against the registration of a similar mark on products that might reasonably be expected to be produced by him in the normal expansion of his business.⁴⁴ The test is whether purchasers would believe the product or service is within the registrant's logical zone of expansion.⁴⁵ This is something that is not prescribed by the Armenian Regulation and therefore the trademark examiners have all the rights to avoid paying attention to this matter.

4th Factor - The conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing

The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are immune from source confusion.⁴⁶ However, circumstances suggesting care in purchasing may tend to minimize likelihood of confusion.⁴⁷ There are no clear guidelines with respect to this matter in the Armenian Regulation as well.

5th Factor - The number and nature of similar marks in use on similar goods

⁴³ *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977).

⁴⁴ *In re 1st USA Realty Professionals, Inc.*, 84 USPQ2d 1581 (TTAB 2007); *CPG Products Corp. v. Perceptual Play, Inc.*, 221 USPQ 88 (TTAB 1983).

⁴⁵ *Id.*

⁴⁶ *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983).

⁴⁷ TMEP, United States Patent and Trademark Office, Sixth Edition, Rev. 1, October 2009.

Evidence of third-party use falls under the sixth *du Pont* factor,⁴⁸ i.e. if the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, this evidence “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.”⁴⁹ The Armenian Regulation does not provide clear guidelines with respect to this matter as well.

Other Factors and Miscellaneous Considerations

In addition to the factors above the USPTO also takes into consideration various other factors, including but not limited to the background of the marks; doctrine of foreign equivalents; transposition of terms; whether the marks are Parody marks; legal equivalents (comparison of words and their equivalent designs); absence of actual confusion; prior decisions of examining attorneys; fame of marks; family of marks; whether marks were previously used without any registration, etc. Most of these and other factors are not stipulated in the Armenian Regulation and are therefore not considered by the Armenian Trademark Office.

2.2. Likelihood of Confusion Tests applied by the US Court of Appeals for the Federal Circuit and the Armenian Administrative Court

The Federal Circuit is unique among the courts of appeals as it is the only court that has its jurisdiction based wholly upon subject matter rather than geographic location and has exclusive jurisdiction over appeals from the Trademark Trial and Appeal Board of the US Patent and Trademark Office. This means that a trademark applicant dissatisfied with the decision of the USPTO and its Trademark Trial and Appeal Board may appeal such a decision to the US Court of Appeals for the Federal Circuit.⁵⁰ A court in Armenia having a similar jurisdiction is the Administrative Court.

⁴⁸ *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973).

⁴⁹ *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005).

⁵⁰ US Court of Appeals for the Federal Circuit, 18 March 2011, <http://www.ca9c.uscourts.gov/the-court/court-jurisdiction.html>,

The Court of Customs and Patent Appeals (which was abolished in 1982 by the Federal Courts Improvement Act, and its jurisdiction, docket and judges were transferred to the United States Court of Appeals for the Federal Circuit) enunciated relevant factors for guidance in testing for the likelihood of confusion (so called *DuPont* Factors).⁵¹ In this case the appeal was “*from the decision of the Trademark Trial and Appeal Board affirming a refusal to register DuPont’s mark Rally for a combination polishing, glazing and cleaning agent for use on automobiles on the basis of likelihood of confusion under § 2(d) of the Lanham Act (US Trademark Act) with Horizon’s registered mark Rally for an all-purpose detergent.*”⁵² In its opinion, the Court of Customs and Patent Appeals stated that it is “*presented with a welcomed opportunity to set forth a reliable guide for decision-making in cases involving § 2(d)*”. This 13-prong test is the fundamental guide for the USPTO and includes the following factors to be considered by the USPTO’s trademark examiners while reviewing and making decisions upon trademark applications involving likelihood of confusion issues under § 2(d) of the US Trademark Act. The same test is applied by the Court of Appeals for the Federal Circuit while reviewing and making decisions on cases involving § 2(d), appealed from the USPTO’s Trademark Trial and Appeal Board. The test includes but is not limited to the following fundamental factors:⁵³

- 1st Factor:** The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- 2nd Factor:** The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
- 3rd Factor:** The similarity or dissimilarity of established, likely-to-continue trade channels.
- 4th Factor:** The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.

⁵¹ *E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (CCPA 1973).

⁵² *Id.*

⁵³ *E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (CCPA 1973).

- 5th Factor:** The fame of the prior mark (sales, advertising, length of use).
- 6th Factor:** The number and nature of similar marks in use on similar goods.
- 7th Factor:** The nature and extent of any actual confusion.
- 8th Factor:** The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
- 9th Factor:** The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).
- 10th Factor:** The market interface between applicant and the owner of a prior mark:
- (a) a mere "consent" to register or use.
 - (b) agreement provisions designed to preclude confusion, i.e. limitations on continued use of the marks by each party.
 - (c) assignment of mark, application, registration and good will of the related business.
 - (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.
- 11th Factor:** The extent to which applicant has a right to exclude others from use of its mark on its goods.
- 12th Factor:** The extent of potential confusion, i.e., whether de minimis or substantial.
- 13th Factor:** Any other established fact probative of the effect of use.

Sufficient number of factors of this 13-prong test is described above, in more details. Many factors of this test are also repeated in the tests of the courts of general jurisdiction, however it is important to note that the tests discussed above (specifically DuPont test) are applied by the USPTO, its trademark examiners, USPTO's Trademark Trial and Appeal Board and the US Court of Appeals for the Federal Circuit hearing trademark appeals from the Trademark Trial and Appeal Board of the US Patent and Trademark Office. As to the tests applied by the courts of general jurisdiction, unlike Armenia, every federal circuit court in the US has developed and applies a different set of rules for determining the

likelihood of confusion. Some circuits have gone even further and developed Model Jury Instructions based on Likelihood of Confusion tests and factors (see Appendix 1).⁵⁴ The next section discusses the US and Armenian local practices with respect to the existence and application of such tests.

2.3. Likelihood of Confusion Tests Applied by the US and Armenian Courts of General Jurisdiction

As was noted in the section above, every federal circuit court in the US has developed and applies a different set of rules for determining the *likelihood of confusion*. The analysis of all eleven tests of the US eleven circuit courts shows that most of the fundamental factors are similar in all circuits. Other, additional, factors are applied depending on the circumstances of a given case. Almost all circuits acknowledge that the factors of their tests are not of equal importance or equal relevance in every single case.⁵⁵ They may be a guide to help determine whether confusion would be likely to result from simultaneous use of the two contested marks.⁵⁶ They imply no mathematical precision, and a plaintiff need not show that all, or even most, of the factors listed are present in any particular case to be successful.⁵⁷ Some circuits stated that their factors are not a distinct test, but represent the sort of considerations which a court should consider in determining whether likelihood of confusion exists.⁵⁸ Finally, the ninth circuit concluded that its factors are to be considered in reaching a decision on the issue of likelihood of confusion, however, "[n]o mechanistic formula or list can set forth in advance" the variety of elements that comprise the market context from which likelihood of confusion must be

⁵⁴ See e.g. 2009 Federal Civil Jury Instructions of the Seventh Circuit. Prepared by the Committee on Pattern Civil Jury Instructions of the Seventh Circuit, Section 13.1.2.3, Infringement – Elements – Likelihood of Confusion – Factors.

⁵⁵ As reported in *Petro Stopping Centers, L.P. v. James River Petroleum, Inc.*, 130 F.3d 88 (C.A.4 (Va.), 1997).

⁵⁶ *Id.*

⁵⁷ *Id.*

⁵⁸ *Id.*

determined.⁵⁹ The *Sleekcraft* court noted that its "list is not exhaustive" and "[o]ther variables may come into play depending on the particular facts presented."⁶⁰

Unlike the US Courts of general jurisdiction, the courts in Armenia have not developed and do not follow any test for determining likelihood of confusion. The analysis of the trademark disputes, case law and interviews with various trademark attorneys, experts, law firms and representatives of relevant governmental organizations, show that the courts and judges in Armenia are not prepared to hear trademark related disputes. Particularly, in the cases where they need to determine the likelihood of confusion, they concentrate on the *similarity of the trademarks*, only (which is just one of the many factors for finding *likelihood of confusion*) and based on that analysis the courts come to a conclusion that the *likelihood of confusion* and a trademark infringement is established. For example, if an Armenian Court of General Jurisdiction would be requested to hear a trademark dispute involving the marks DRIZZLE and DRIZZLER (the same mark with an additional letter "R" at the end), the court would most likely find a likelihood of confusion and a trademark infringement. However, the US Court of Appeals of the Second Circuit in *McGregor-Doniger Inc. v. Drizzle Inc*⁶¹ where it applied the Second Circuit's Polaroid test, objectively, came to a conclusion that there was no actual confusion and the marks were not likely to confuse the public in the future as well. According to the Court because the goods were concededly not competitive, McGregor's sales of Drizzler jackets would not suffer, and consumer confusion as to source is unlikely. The court also stated that McGregor's reputation cannot be expected to be harmed. Additionally because of the improbability that McGregor would enter the women's coat field under the Drizzler name, its right to expand into other fields had not been unduly restricted. Thus the Court found no injury to McGregor resulting from denial of the relief requested. On the other hand, if forced to give up its mark Drizzle could be expected to be harmed by loss of the goodwill that has been associated with the Drizzle name since 1969.

⁵⁹ Restatement (Third) of Unfair Competition § 21, comment a (1995).

⁶⁰ *AMF Inc. v. Sleekcraft Boats*, 599 F.2d at 348 n. 11 (9th Cir.1979).

⁶¹ *McGregor-Doniger Inc. v. Drizzle Inc. U.S. Court of Appeals, Second Circuit* 599 F.2d 1126 (1979), Thomas G. Field, Jr. *Fundamentals of Intellectual Property: Cases & Materials*. New Hampshire: Carolina Academic Press, 1994.

The parties agreed that the Judge was correct in giving consideration to each of the factors mentioned in *Polaroid*.⁶²

The analysis of the Armenian Trademark case law from 2000 to 2011⁶³ shows that, virtually, in all trademark cases the courts focus on the comparison of the *marks* and in some cases the *goods* only, which is proved to be only *one* out of *eight* factors considered by the US courts. This means that, at least, six factors considered by the US courts are not considered by the Armenian courts. This shows that the courts are making approximate decisions without considering other important factors. In most of the cases, the courts subjectively, or based on the arguments of one or the other party, find infringement or fail to find an infringement without applying any test. The analysis of the Armenian trademark case law makes it clear that the judges have the widest possible discretion to find a trademark infringement or fail to find it where necessary. This is mainly because of the absence of clear guidelines regarding the application of the tests and factors above.

Appendix 2 shows that *likelihood of confusion tests* are used and applied by all the US circuit courts. Most of the tests include six to eight factors. The Armenian courts are not aware of the existence of other factors and apply only one or two of those factors, only (see footnote 63). For example, in *Grand Candy v. Armel*⁶⁴ the Court held that the defendant's (Armel) marks "GRANDOS", "GRANT'S CHOCOLATES" and "GRANT'S" are likely to be confused with plaintiff's (Grand Candy) trade name GRAND CANDY. In this case and the other cases listed in the footnote 63 the courts did not pay attention to or discussed such factors as, *e.g.*: (1) the relationship between the parties' channels of trade; (2) the relationship between the parties' advertising; (3) the classes of prospective purchasers; (4) evidence of actual confusion; (5) the defendant's intent in adopting its mark; and (6) the strength of the plaintiff's mark. The application of all the factors above has a potential of changing many trademark

⁶² Thomas G. Field, Jr. *Fundamentals of Intellectual Property: Cases & Materials*. New Hampshire: Carolina Academic Press, 1994.

⁶³ Civil Case # EKD 0325/02/08, RA Court of Appeals (2008); Civil Case # T-2101, RA Economic Court (2006); Civil Case # T-155, RA Economic Court (2006); Civil Case # T-1912, RA Economic Court (2006); Civil Case # T-1095, RA Economic Court (2006); Civil Case # T-164, RA Economic Court (2007); Civil Case # EKD 1066/02/08, RA Court of Appeals (2009); Civil Case # 2-2741, RA First Instance Court of General Jurisdiction (2000); etc.

⁶⁴ Civil Case # T-155, RA Economic Court (2006).

decisions in Armenia. Therefore, the courts should consider all possible factors for the purposes of making well grounded and analyzed decisions, even if they come to the same conclusion without applying those factors. The application of such factors provides predictability to the courts decisions. Therefore, the application of the factors must become a common practice in Armenia. In one case the court may come to the same conclusion with or without applying the tests, in other cases it may come to a totally different conclusion if it applies the test, as in case of the dispute involving the marks “Drizzle” and “Drizzler” for the same type of goods, where the court correctly and objectively found no actual or likelihood of any confusion between these two marks. In any event the application of the factors above assures making more objective, well grounded and analyzed decisions.

3. CONCLUSION

The analysis and comparison of the US and Armenian legislation and practices shows that there are many similarities in both countries main trademark laws but there are also substantial differences in trademark implementing legislation (regulations) and practices. This means that the general laws are similar but the regulations adopted based on the general laws and the implementation of the laws and regulations are substantially different. In case of Armenia the implementation of the trademark laws and regulations provide contradictory and inconsistent results which make the courts and their decisions absolutely unpredictable in this field.

With respect to similarities, the paper shows that both countries have similar institutions, i.e. both have governmental offices handling state registration of trademarks (USPTO and AIPA); both governmental offices have Boards of Appeals; both countries have courts of special jurisdiction hearing trademark cases appealed from the governmental offices (US Court of Appeals for the Federal Circuit and the Armenian Administrative Court); and both countries have courts of general jurisdiction hearing trademark cases between two private parties. The paper also shows that both countries have similar

general provisions in their main Trademark laws regarding determination of likelihood of confusion and trademark infringement.

As to the differences, the core difference between both country's legislation and practices is the implementing legislation (regulations) and its application (including case law). The application of the laws and regulations in the US and Armenia provide different results in practice, although the main trademark laws of both countries are based on the International Treaties and Conventions. Another difference is that, in the US, there is a clear distinction between the tests applied by the governmental office handling trademark registration (USPTO) and the special court hearing appeals from USPTO, on one side, and the courts of general jurisdiction hearing cases between two private parties, on the other side. In the first case the USPTO and the court hearing appeals from USPTO decide the case based on the same tests, while the courts of general jurisdiction apply different tests, since they hear cases between two private parties rather than a private and a governmental office. The courts in Armenia, both administrative and courts of general jurisdiction are either unaware of the existence of any test or are not certain what test must be applied to a trademark infringement dispute, or just apply the insufficient test developed by the Armenian Trademark Office. The test is insufficient because it includes only two out of eight possible factors.

As noted the issues above led to unpredictability of the Armenian courts' decisions, in this field. Because of their unawareness the courts are making approximate decisions and many trademark holders are being treated unequally. All these issues create strong basis for long-lasting corruption in this field in Armenia. In order to avoid this problem, this paper proposes to utilize the special tools, *i.e.* likelihood of confusion tests, developed by the participation of the US trademark attorneys, trademark examiners, litigators and the courts, within last thirty years. In particular the paper introduces relevant guidelines for determining likelihood of confusion by the Armenian courts and litigators, which may serve as an implementing regulation of the Armenian IP Enforcement Act, expected to be adopted within next two years.

APPENDIX 1 Guidelines for Determining Likelihood of Confusion Proposed to be used in the
Implementing Legislation of the Armenian IP Enforcement Law

Guideline for Armenian Courts of General Jurisdiction for Determining Likelihood of Confusion

In any trademark infringement litigation involving likelihood of confusion elements, one of the things that Plaintiff must prove is that Defendant used its trademark, logo or any element thereof in a manner that is likely to cause confusion or deception as to the source, origin, sponsorship or approval of Defendant's product.

Plaintiff must prove a likelihood of confusion among a significant number of people who buy or use, or consider buying or using, the product or similar products.

In deciding this, the court is advised to consider the following:

1. Whether the overall impression created by Defendant's trademark or logo is similar to that created by Plaintiff's trademark or logo in appearance, sound and/or meaning;
2. Whether Defendant and Plaintiff use their trademarks, logos on the same or related products;
3. Whether Plaintiff's and Defendant's products are likely to be sold in the same or similar stores or outlets, or advertised in same or similar media for the same category of consumers;
4. The degree of care that purchasers or potential purchasers are likely to exercise in buying or considering whether to buy the product. This may depend on the level of sophistication of potential buyers of the product and/or the cost of the product;
5. The degree to which purchasers or potential purchasers recognize Plaintiff's trademark as an indication of the origin of Plaintiff's product.
6. Whether Defendant's use of the trademark or logo has led to instances of actual confusion among purchasers or potential purchasers about the source, origin, sponsorship or approval of

Defendant's product. However, actual confusion is not required for finding a likelihood of confusion;

7. Whether Defendant intended to pass off his product as that of Plaintiff, or intended to confuse consumers.

The weight to be given to each of the factors above is up to the court to determine. No particular factor or number of factors is required to prove likelihood of confusion.

APPENDIX 2 Likelihood of Confusion Test Applied by the US Courts of General Jurisdiction

Although, many factors of different circuits may seem to be either the same or very similar, it may not be true for all instances, since each circuit uses its own language to define factors which, in each particular case, may give diminutively or substantially more or less weight to each such factor. Therefore, in order to correctly understand the full and accurate meaning of each circuit's test and factors, it is highly important to carefully examine the relevant case law of each particular circuit.

FIRST CIRCUIT - Likelihood of Confusion Test (“Pignon” Factors)

The first circuit has enumerated the following *eight* factors to guide the inquiry into likelihood of confusion:⁶⁵

- (1) the similarity of the marks;
- (2) the similarity of the goods;
- (3) the relationship between the parties' channels of trade;
- (4) the relationship between the parties' advertising;
- (5) the classes of prospective purchasers;
- (6) evidence of actual confusion;
- (7) the defendant's intent in adopting its mark; and
- (8) the strength of the plaintiff's mark.

NOTE: With respect to this test the courts of this circuit concluded that a proper analysis takes cognizance of all eight factors but assigns no single factor dispositive weight.⁶⁶

⁶⁵ *Borinquen Biscuit Corp. v. M.V. Trading Corp.*, 443 F.3d 112 (1st Cir., 2006)

⁶⁶ *Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1205 (1st Cir.1983); *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 487 (1st Cir.1981).

SECOND CIRCUIT - Likelihood of Confusion Test ("Polaroid" Factors)

The Second Circuit's Polaroid test is a well known test in the US. The factors of this test include:⁶⁷

- (1) the strength of the plaintiff's mark;
- (2) the similarity of plaintiff's and defendant's marks;
- (3) the competitive proximity of the products;
- (4) the likelihood that plaintiff will "bridge the gap" and offer a product like defendant's;
- (5) actual confusion between products;
- (6) good faith on the defendant's part;
- (7) the quality of defendant's product; and
- (8) the sophistication of buyers.

From the first glance, most of the factors of the first and second circuits seem to either be the same or very similar. The only major difference seems to be the 7th factor of Polaroid test, the quality of defendant's product.

THIRD CIRCUIT - Likelihood of Confusion Test ("LAPP" Factors)

This circuit has developed ten-prong Likelihood of Confusion test that includes the following factors:⁶⁸

- (1) degree of similarity between the owner's mark and the alleged infringing mark;
- (2) strength of the owner's mark;

⁶⁷ *Polaroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492, 495 (2d Cir.), as reported in *Fed. Express v. Federal Espresso*, 201 F.3d 168 (2d Cir., 1999).

⁶⁸ *Interpace Corp. v. Lapp, Inc.*, 721 F.2d 460, 463 (3d Cir.1983) as reported in *Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211 (Fed. 3rd Cir., 2005).

- (3) price of the goods and other factors indicative of the care and attention expected of consumers when making a purchase;
- (4) length of time the defendant has used the mark without evidence of actual confusion;
- (5) intent of the defendant in adopting the mark;
- (6) evidence of actual confusion;
- (7) whether the goods, though not competing, are marketed through the same channels of trade and advertised through the same media;
- (8) the extent to which the targets of the parties' sales efforts are the same;
- (9) the relationship of the goods in the minds of consumers because of the similarity of function; and
- (10) other facts suggesting that the consuming public might expect the prior owner to manufacture a product in the defendant's market or that he is likely to expand into that market.

FOURT CIRCUIT - Likelihood of Confusion Test

The courts in this circuit are guided by the following seven-prong test:⁶⁹

- (1) the strength or distinctiveness of the plaintiff's mark;
- (2) the similarity of the two parties' marks;
- (3) the similarity of the goods and services the marks identify;
- (4) the similarity of the facilities the two parties use in their businesses;
- (5) the similarity of advertising used by the two parties;
- (6) the defendant's intent; and
- (7) actual confusion.

⁶⁹ *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1527 (4th Cir.1984).

NOTE: With respect to this test the courts concluded that these factors are not of equal importance or equal relevance in every case.⁷⁰

FIFTH CIRCUIT - Likelihood of Confusion Test

The test of this circuit includes but is not limited to the following seven factors:⁷¹

- (1) the type of mark allegedly infringed,
- (2) the similarity between the two marks,
- (3) the similarity of the products or services,
- (4) the identity of the retail outlets and purchasers,
- (5) the identity of the advertising media used,
- (6) the defendant's intent, and
- (7) any evidence of actual confusion.

SIXTH CIRCUIT - Likelihood of Confusion Test

This circuit considers the following eight-prong test to determine whether there may be a likelihood of confusion among consumers:⁷²

- (1) strength of plaintiff's mark;
- (2) relatedness of the goods;
- (3) similarity of the marks;
- (4) evidence of actual confusion;
- (5) marketing channels used;
- (6) likely degree of purchaser care;
- (7) defendant's intent in selecting the mark;

⁷⁰ As reported in *Petro Stopping Centers, L.P. v. James River Petroleum, Inc.*, 130 F.3d 88 (C.A.4 (Va.), 1997

⁷¹ As reported in *The Southern Company v. Dauben Inc.*, No. 08-10248 (5th. Cir., 2009).

⁷² As reported in *Wynn Oil Co. v. Thomas*, 839 F.2d 1183 (C.A.6 (Tenn.), 1988)

(8) likelihood of expansion of the product lines.

NOTE: This circuit concluded that these factors are simply a guide to help determine whether confusion would be likely to result from simultaneous use of the two contested marks.⁷³ They imply no mathematical precision, and a plaintiff need not show that all, or even most, of the factors listed are present in any particular case to be successful.⁷⁴

SEVENTH CIRCUIT - Likelihood of Confusion Test

The test of this circuit is also limited to seven factors. Those factors include:⁷⁵

- (1) similarity between the marks in appearance and suggestion;
- (2) similarity of the products;
- (3) area and manner of concurrent use;
- (4) degree of care likely to be exercised by consumers;
- (5) strength of complainant's mark;
- (6) actual confusion; and,
- (7) intent of defendant to “palm off his product as that of another.”

EIGHTH CIRCUIT - Likelihood of Confusion Test

This circuit has limited its test to the following six factors:⁷⁶

- (1) the strength of the trademark;
- (2) the similarity between the plaintiff's and defendant's marks;
- (3) the competitive proximity of the parties' products;

⁷³ *Id.*

⁷⁴ *Id.*

⁷⁵ As reported in *Barbecue Max, Inc. v. 551 Ogden, Inc.*, 235 F.3d 1041 (7th Cir., 2000)

⁷⁶ *SquirtCo v. Seven-Up Co.*, 628 F.2d 1086 (C.A.8 (Mo.), 1980), as reported in *Anheuser-Busch, Inc. v. Balducci Publications*, 28 F.3d 769 (C.A.8 (Mo.), 1994)

- (4) the alleged infringer's intent to confuse the public;
- (5) evidence of any actual confusion; and
- (6) the degree of care reasonably expected of the plaintiff's potential customers.

NOTE: According to this circuit, the factors above are not a distinct test, but represent the sort of considerations which a court should consider in determining whether likelihood of confusion exists.⁷⁷

NINTH CIRCUIT - Likelihood of Confusion Test (“Sleekcraft” Test)

The ninth circuit considers the following, eight-prong, so called, *Sleekcraft* test.⁷⁸

- (1) strength of the mark;
- (2) proximity of the goods;
- (3) similarity of the marks;
- (4) evidence of actual confusion;
- (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 selecting the mark;
- (8) likelihood of expansion of the product lines.

NOTE: The ninth circuit concluded that the factors above are to be considered in reaching a decision on the issue of likelihood of confusion. However, “[n]o mechanistic formula or list can set forth in advance” the variety of elements that comprise the market context from which likelihood of confusion

⁷⁷ *Id.*

⁷⁸ *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir.1979), as reported in *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (C.A.9 (Cal.), 1997).

must be determined.⁷⁹ The *Sleekcraft* court noted that this "list is not exhaustive" and "[o]ther variables may come into play depending on the particular facts presented."⁸⁰

TENTH CIRCUIT - Likelihood of Confusion Test

Tenth Circuit has also limited its test to six prongs only.⁸¹

- (1) the degree of similarity between the marks;
- (2) the intent of the alleged infringer in using the mark;
- (3) evidence of actual confusion;
- (4) similarity of products and manner of marketing;
- (5) the degree of care likely to be exercised by purchasers; and
- (6) the strength or weakness of the marks.

NOTE: The court has stated that no one factor is dispositive."⁸²

ELEVENTH CIRCUIT - Likelihood of Confusion Test

Lastly, the Eleventh Circuit uses the following seven-prong test for determining likelihood of confusion.⁸³

- (1) the type of mark;
- (2) the similarity of the two marks;
- (3) the similarity of the goods;

⁷⁹ Restatement (Third) of Unfair Competition § 21, comment a (1995).

⁸⁰ *AMF Inc. v. Sleekcraft Boats*, 599 F.2d at 348 n. 11 (9th Cir.1979).

⁸¹ *Sally Beauty Co., Inc. v. Beautyco, Inc.*, 304 F.3d 964 (10th Cir.2002), as reported in *Utah Lighthouse Min. v. Foundation for Apologetic*, 527 F.3d 1045 (10th Cir., 2008)

⁸² *Id.*

⁸³ *Tally-Ho, Inc. v. Coast Community College District*, 889 F.2d 1018 (11th Cir.1989), as reported in *Carnival Brand Seafood Co. v. Carnival Brands*, 187 F.3d 1307 (11th Cir., 1999)).

- (4) the identity of customers and similarity of retail outlets, sometimes called the similarity of trade channels;
- (5) the similarity of advertising;
- (6) the intent, i.e., good or bad faith, of the alleged infringer; and
- (7) evidence of actual confusion, if any.

APPENDIX 3 Likelihood of Confusion Test Applied by the Armenian Intellectual Property Agency (AIPA)⁸⁴

A) Definition and Determination of Confusing Similarity

According to the Implementing Regulation of RA 2010 Trademark Law (hereinafter “Regulation”), Article 111 *“a trademark may be considered as confusingly similar to another mark, if it is generally associated with it (i.e. if the similarity of images, words, colors, and their combination used in one mark, despite the existence of other differences, may remind the consumer about another mark. The marks are generally considered to be associated with each other, if the key elements or parts of the marks are made in a way that remind an average consumer (hereinafter “consumer”) about another mark which s/he has seen before or is known by him/her. The existence of differences in the marks insufficient for perception of those marks, is usually determined by side-by-side comparison and, as a rule, they are not perceivable for the consumers, while choosing or selecting a product.”*⁸⁵

According to the Article 112 *“taking into consideration the requirements of the Article 114 of this regulation, the confusing similarity between the marks is determined by assessment of the impression made on an average consumer.”*⁸⁶

B) Average Consumer

According to the Article 113 *“an average consumer is a person whose memory, skills and professionalism, general attitude towards creation, comparison and assessment of graphical images are not strictly expressed and directed.”*⁸⁷

⁸⁴ Implementing Regulation of RA 2010 Trademark Law

⁸⁵ *Id.*

⁸⁶ *Id.*

⁸⁷ *Id.*

C) Determination of Confusing Similarity

The 114th Article of the Regulation stipulates *“in determining whether there is a likelihood of confusion it is necessary to take into consideration the peculiarity of the product for which the mark is submitted for registration. If the trademark is submitted for registration for products civil circularity of which is carried out by specialized organizations or natural persons or in special order precluding the possibility of consumers’ confusion particularly by specialists with particular knowledge or only through specialized organizations e.g. by means doctor’s prescriptions, pharmacies by pharmacutists, or special products being sold to well-informed or specialized organizations and/or to natural persons, it is necessary to take into consideration that in this case “confusing similarity” covers and applies especially to those specialists or organizations and not to all possible consumers. If the trademark being submitted for registration relates to expensive products or such products which are not considered consumer goods i.e. in each case prior to the acquisition of the product, consumer scrupulously exploring the goods, afterwards during determination of the degree of similarity is subject to the consumer’s inevitable watchful attitude.”*⁸⁸

D) Similarity of the Word Trademarks

According to the Article 115 *“word trademarks may be considered similar with:*

- 1) word trademarks,*
- 2) combined trademarks (included in word elements),*
- 3) trade names,*
- 4) visual trademarks, which can have word significance.”*⁸⁹

E) Determination of Confusing Similarity between Word Trademarks and Trade names

⁸⁸ *Id.*

⁸⁹ *Id.*

According to the Article 116 *“in order to determine the similarity between word trademark’s and trademarks’ and trade name’s (indicated in the Article 115 of this Regulation), word trademarks are compared with:*

- 1) word trademarks,*
- 2) word elements (included in combined trademarks),*
- 3) trade names,*
- 4) word meaning of a visual trademark and assessing their sound (phonetic), graphic (visual) and semantic (expressed mind) similar features.”⁹⁰*

F) Similarity in Sound

The Article 117 provides *“similarity in sound is mainly determined by the following characteristics:*

- 1) closeness to the comparing marks and matching of sounds,*
- 2) closeness of mark forming and matching sounds,*
- 3) close sounds and sound combinations (arrangement from each other),*
- 4) the existence of matching syllables and arrangements,*
- 5) the total number of syllables the mark contained,*
- 6) matching of the marks sounds in the place of connections,*
- 7) proximity of vowels,*
- 8) proximity of consonants,*
- 9) matching parts of the marks,*
- 10) characters situated into one another, especially lexical phrases, including trade names. In this case coincident presence of syllables (or one mark situated into another mark) the initial position of matching parts is considered decisive factor of raising similarity. In some cases, marks may be based on such recognition, as, both the beginning of the end coincidence in the case of various middle parts,*

⁹⁰ *Id.*

11) accentuation.”⁹¹

G) Similarity in Graphic

According to the Article 118 “graphic similarity is determined by the following criterias:

- 1) general visual impression,
- 2) the font used,
- 3) due to the nature of letters graphic writing style (e.g. printed or manuscripts, capitalized or lowercase, stylization etc.),
- 4) disposition of the letters to each other,
- 5) the alphabet with which letters are written,
- 6) color or color combination.”⁹²

H) Similarity in Meaning

The Article 119 states “Similarity in Meaning is determined on the basis of the following characteristics:

- 1) set of marks similar in the concept, idea, including coincidence in the meaning of the marks in different languages.
- 2) matching elements of marks, which has a specific meaning (i.e. with logical emphasis),
- 3) marks enacted with concepts, contradiction in ideas.”⁹³

According to the Article 120 “above listed characteristics (Articles 117-119 of this Regulation) are taken into account as separate, as well as in various combinations.”⁹⁴

⁹¹ *Id.*

⁹² *Id.*

⁹³ *Id.*

⁹⁴ *Id.*

I) Visual and Dimensional Trademarks

According to the Article 121 “*visual and dimensional trademarks may be similar to:*

- 1) visual trademarks,*
- 2) dimensional trademarks,*
- 3) combined trademarks which structure includes image or dimension elements.”⁹⁵*

J) Determination of Visual and Dimensional marks’ Similarity

According to the Article 122 “*visual and dimensional marks’ similarity is determined by the following characteristics:*

- 1) appearance,*
- 2) presence or absence of symmetry,*
- 3) similarity in meaning,*
- 4) with the appearance and nature of the image (naturalistic, stylized, caricature etc.),*
- 5) with the comparison of the colors and nuances,*
- 6) the existance of compared marks and matching images (components) and disposition from each other,*
- 7) with nature of matching parts of the marks,*
- 8) marks assosiated into one another,*
- 9) marks of elements (images) of any matching elements (image), which has a specific meaning, and on which falls the logical emphasis.”⁹⁶*

K) Similarity of the Marks

The Article 123 provides “*listed features are taken into account both separate and in different combinations. Similarity of the marks is an imitating phenomenon, which emerges in the result of identicity of the marks’ elements. The similarity of the marks is determined by the generality of elements.*

⁹⁵ *Id.*

⁹⁶ *Id.*

*The interrelation in matching and not matching elements leaves an influence in the degree of similarity, as well as their importance in the total composition of a mark.*⁹⁷

L) Consumer Confusion

According to the Article 124 *“the most common standard of trademarks’ similarity is consumer confusion during the economic turnover. While determining the similarity of the mark, is taken into account that the consumer usually has no opportunity to compare the two marks, but is guided by the previously seen mark on the overall impression.”*⁹⁸

M) Similarity of Combined Trademarks

According to the Article 125 *“combined trademarks may be similar to:*

1) combined trademarks,

*2) those types of trademarks, which are incorporated as elements tested in a combined trademark.”*⁹⁹

N) Determination of Combined Marks

The Article 126 states *“while determining similarity of combined marks above listed characteristics (Articles 116-123 of this Regulation) are used, as well as examining the claimed trademark’s identical or similar element’s place (position) significance.”*¹⁰⁰

O) Determination of Combined Trademarks

⁹⁷ *Id.*

⁹⁸ *Id.*

⁹⁹ *Id.*

¹⁰⁰ *Id.*

According to the Article 127 “when determining combined trademarks similarity is taken into account their lexical elements in the separate issue of similarity, if the elements are the main elements of the perception of the marks or the so-called "primary perception" elements or "names.”¹⁰¹

P) Basis for a Refusal to Register a Combined Trademark

According to the Article 128 “registration of combined trademark is subject to refusal, if there is an earlier priority date received, which basic perception of lexical item is confusingly similar to the claimed mark’s (i.e. lexical element) main perceptione, including in such cases when the lexical elements having the same meaning, words, or lexical expressions or their translation in different languages (even if the marks (image part) are completely different from each other), only in case if the translation is understandable to the average consumer. In this case, the claimed mark may be registered only for an earlier priority date received (by the legal protection of trademark owner’s consent).”¹⁰²

Q) Similarity of the Products

According to the Article 129 “while determining products’ similarity, it is possible that during the identical or confusingly similar products’ sale time the consumer may think that the product issued by the same person (manufacturer). During the examination, the expert takes into account the fact that how well known is the mark which submitted for registration, as well as takes into account mark which detected confusingly similar and identical degree of that mark. The mark application will be refused if the mark is well known (an earlier filed or registered mark), even when the products are different (but the marks are similar), if it confuses the consumer and becomes a reason to believe that products (registered or protected without registration) or owner of the well known mark (in the Republic of Armenia) are connected to each other, with the meaning that, it may harm its interests.”¹⁰³

¹⁰¹ *Id.*

¹⁰² *Id.*

¹⁰³ *Id.*

R) Determination of the Products' Similarity

According to the Article 130 *“the possibility of creating confusion of products of origin is less likely, even if the products are different (but the marks are similar). In this connection, when determining the similarity of the products taking into account type of products and common origin, sector of product use, type of material (from which they are made), places (net) and conditions of sale, scope of consumers and other features.”*¹⁰⁴

According to the Article 131 *“if different products are made by the same entities, or if consumers are inclined to think that usually they are produced by the same entities, most often it will be considered that they have a common origin.”*¹⁰⁵

S) Relatedness of the Products

According to the Article 132 *“identical products are considered in the same class, type, when using the same trademark is perceived by consumers, as the product of the same company.”*¹⁰⁶

T) Determination of Similar Goods

According to the Article 133 *“when determining the similarity of the goods, it should be taken into account the type of product, manufacturing features (technology) of the product, using area, sales conditions (industry and procedure).”*¹⁰⁷

U) Determination of the Products' Identity and Similarity

¹⁰⁴ *Id.*

¹⁰⁵ *Id.*

¹⁰⁶ *Id.*

¹⁰⁷ *Id.*

According to the Article 134 *“in determining the products’ identity and similarity during the course of the examination, it is taken into account that the same type of goods, which held the trademark examination, refer to the different classes. That is the case why if identical or in confusing way similar trademark is detected, the expert directly examines by the list of goods, irrespective of the lessons, which refer to that particular trademark. For example, lighter enerally refer to the 34th class, and the electric lighter 9th class, piece bags on the 24th class, and leather bags 18th class.”*¹⁰⁸

¹⁰⁸ *Id.*

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