

TRADEMARK INFRINGEMENT

SPECIFIC PRELIMINARY INSTRUCTIONS TO THE JURY

14.1 Trademark Infringement – Nature of Claims and Defenses

Before the attorneys give their opening statements, to help you follow the evidence, I will now give you a summary of what this case is about.

The Plaintiff in this case is [].

The Defendant in this case is [].

Plaintiff claims that Defendant has infringed, or committed trademark infringement, false designation of origin, and unfair competition by infringing, a trademark[s] or service mark[s] owned by Plaintiff.

A trademark or a service mark is a word, symbol, or combination of words and symbols used by an individual or company to identify its products or services, to distinguish its products from those manufactured or sold by others, or to distinguish its services from those offered by others, and to indicate the source of its products or services.¹

Defendant denies that it has infringed any of Plaintiff's trademarks or service marks or committed any acts of unfair competition by infringing any of Plaintiff's trademarks.

¹ 15 U.S.C. § 1127.

14.2 Plaintiff's Trademarks

Plaintiff claims that Defendant has infringed [x number of] Plaintiff's trademarks and service marks. The trademarks at issue are: [LIST and describe, *e.g.*, (1) a word mark for [], (2) a combined word and design mark for [] with an associated design or logo; and (3) a word mark for []].

A trademark is a property right that is acquired by use. If through its use, a word or design comes to symbolize an individual's product or service in the public mind, the individual acquires a property right in that trademark.² Plaintiff bears the burden of proving it has acquired trademark rights in the trademark(s) it asserts in this case.

A trademark need not, but can be, registered with the United States Patent and Trademark Office. A federal trademark registration is [rebuttable] evidence of the registrant's exclusive right to use the mark in commerce, but only on or in connection with the goods or services specified in the registration and subject to any conditions or limitations stated in the registration.³

Plaintiff's federal trademark registration for the word mark [] specifies the goods associated with this mark as: [].⁴

² *Trade-Mark Cases*, 100 U.S. 82, 94-95 (1879); *Bos. Prof'l Hockey Ass'n v. Dall. Cap & Emblem Mfg., Inc.*, 510 F.2d 1004, 1014 (5th Cir. 1975).

³ 15 U.S.C. § 1115(a); *Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 1184 (5th Cir. 1980); *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 194 (5th Cir. 1998) (citing 15 U.S.C. § 1115(a)); *Violet Crown Cinemas, LLC v. Int'l Dev. Mgmt., LLC*, No. 21-CV-1142, 2022 U.S. Dist. LEXIS 166518, at *1-11 (W.D. Tex. Sept. 15, 2022); *Waterloo Sparkling Water Corp. v. Treaty Oak Brewing & Distilling Co., LLC*, No. 21-CV-161, 2021 U.S. Dist. LEXIS 227700, at *10-13 (W.D. Tex. Nov. 28, 2021).

⁴ U.S. Trademark Reg. No. [].

Plaintiff's federal trademark registration for the combined word and symbol mark for [] specifies the goods associated with this mark as: [].⁵

Plaintiff's federal trademark registration for the combined word mark for [] specifies the services associated with this mark as: [].⁶

⁵ U.S. Trademark Reg. No. [].

⁶ U.S. Trademark Reg. No. [].

14.3 The Parties' Burdens of Proof

Plaintiff contends that Defendant infringes its [each of these] marks by selling [] to dealers under the brand name [] and with its [] logo. To prevail against Defendant, Plaintiff has the burden of proving, by a preponderance of the evidence, that Defendant infringes one or more of Plaintiff's marks.

Defendant denies that it infringes, but contends that, even if Plaintiff could prevail on one or more of its trademark-related claims, Plaintiff still is not entitled to any recovery or relief on any of those claims under [any affirmative defense, such as the doctrine of unclean hands]. Defendant bears the burden of proving [any affirmative defense] that Defendant has asserted by a preponderance of the evidence.⁷

⁷ *Janes v. Watson*, No. SA-05-CA-0473, 2006 U.S. Dist. LEXIS 59004, at *50-51 (W.D. Tex. Aug. 2, 2006) (citations omitted); *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 271-72 (5th Cir. 1999); Restatement (Third) of Unfair Competition § 32 & cmt. a (Am. L. Inst. 1995); 5 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §§ 31:44-58(4th ed. 2009).

The standard in a trademark infringement claim is “likelihood of confusion.” To prevail on a claim of trademark infringement or unfair competition against Defendant, Plaintiff must prove by a preponderance of evidence that Defendant’s use of its [] brand and [] logo in connection with selling [] creates a likelihood of consumer confusion as to source, affiliation, or sponsorship.⁸ Merely reproducing a trademark is not trademark infringement if there is no likelihood of confusion. A “likelihood of confusion” means that confusion is not just possible, but probable.⁹ [10].

⁸ 15 U.S.C. § 1114(1); *Elvis Presley Enters. v. Capece*, 141 F.3d 188, 193 (5th Cir. 1998); *Rex Real Est. I, L.P. v. Rex Real Est. Exch., Inc.*, 80 F.4th 607 (5th Cir. 2023).

⁹ 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 25.28 (4th ed. 2009); *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 478 (5th Cir. 2008); *Nat’l Bus. Forms & Printing, Inc. v. Ford Motor Co.*, 671 F.3d 526, 532 (5th Cir. 2012).

¹⁰ The analysis with respect to plaintiff’s federal and common law claims under the federal law may often be dispositive of its corresponding claims under Texas law as well. *Luxottica Grp. S.P.A. v. Atl. Sunglasses LLC*, No. 15-CV-1795, 2017 U.S. Dist. LEXIS 217991, at *19 (S.D. Tex. Mar. 24, 2017) (“The same legal standard applies to Lanham Act infringement claims, Texas statutory trademark infringement claims, Texas common-law trademark infringement claims, and federal and state unfair competition claims.” (quoting *RE/MAX Int’l, Inc. v. Trendsetter Realty, LLC*, 655 F. Supp. 2d 679, 711 (S.D. Tex. 2009))); *Dall. Cowboys Football Club, Ltd. v. Am.’s Team Props., Inc.*, 616 F. Supp. 2d 622, 636 (N.D. Tex. 2009) (“Likelihood of confusion is the central evidentiary test for infringement under the Lanham Act and unfair competition under Texas common law.” (citing *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 663 n.1 (5th Cir. 2000))).

JURY CHARGE

14.4 Summary of Claims and Defenses

MEMBERS OF THE JURY:

The Plaintiff in this case is []. [] claims in this case that it owns certain trademarks. Those trademarks are: [LIST and describe, *e.g.*, (1) a word trademark for the word [] (2) a combined word and design trademark for the words [] and an associated logo; and (3) a word service mark for the words []. I will discuss these in more detail a bit later.

Plaintiff claims that Defendant committed trademark infringement, false designation of origin, and unfair competition by using the brand name [] and the [] logo on [] it has sold to []. Plaintiff's claims arise under both a federal and Texas law.

Defendant denies Plaintiff's claims of trademark infringement, false designation of origin, and unfair competition. Defendant also contends that, even if Plaintiff could prevail on one or more of its trademark-related claims, Plaintiff still is not entitled to any recovery or relief on any of those claims under the doctrine of [unclean hands].

I will now instruct you on the law you must apply to the evidence you have heard.

14.5 Burden of Proof: Preponderance of the Evidence¹¹

Plaintiff [] has the burden of proving its case by a preponderance of the evidence.

If Plaintiff prevails on any of its claims, Defendant has the burden of proving its affirmative defense of [] by a preponderance of the evidence.

To establish by a preponderance of the evidence means to prove something is more likely so than not so. If you find that Plaintiff [] has failed to prove any element of its claim by a preponderance of the evidence, then it may not recover on that claim.

¹¹ Fifth Circuit Pattern Jury Instructions (Civil Cases) § 3.2 (2020).

SPECIFIC INSTRUCTIONS

14.6 Trademark Infringement – Nature of Plaintiff’s Claims

Plaintiff claims that, by selling [] under the brand name [] and with the [] logo, Defendant infringed [each of] Plaintiff’s trademarks for the word [], for its [] Logo, and for its word service mark [].

The purposes of trademark law are to secure to the owner of the mark the goodwill of its business and to protect the ability of consumers to distinguish among competing producers.¹² The central question in trademark law is the likelihood of consumer confusion.

14.7 Trademark Infringement – Definition of Trademark

Ownership of a trademark is established by use of the trademark and does not need to be registered in order to obtain protection.¹³

As I instructed you before trial, a trademark or service mark is a property right that is acquired by use. A trademark is any word, name, symbol, device or any combination of these things, used by a person or corporation to identify and distinguish that person’s goods from those manufactured or sold by others and to indicate the source of the goods, even if

¹² *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992); *Park ‘N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 198 (1985) (“The Lanham Act provides national protection of trademarks in order to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers.”).

¹³ *Union Nat’l Bank of Tex., Laredo, Tex. v. Union Nat’l Bank of Tex., Austin, Tex.*, 909 F.2d 839, 842 (5th Cir. 1990).

that source is unknown to the consumer.¹⁴ If through use, the word or design comes to symbolize a person's or corporation's product or service in the public mind, that person or corporation acquires a property right in the mark.¹⁵

Plaintiff bears the burden of proving by a preponderance of the evidence that it has acquired property rights in each trademark it asserts in this case before there can be infringement of that trademark. A trademark need not, but can be, registered with the United States Patent and Trademark Office. This is called a United States or federal trademark registration. A federal trademark registration is [rebuttable] evidence of the registrant's exclusive right to use the mark in commerce in connection with the goods or services specified in the registration.¹⁶

Plaintiff asserts that it is the owner of the following [e.g., three] trademarks and corresponding U.S. Trademark Registrations:

1) The Word Trademark [Describe]. Plaintiff claims rights to this trademark under Texas common law and under federal law. Plaintiff owns a federal trademark registration for this trademark, which has been admitted as Exhibit [] in this trial. Plaintiff's federal trademark registration for the word mark [] specifies the goods associated with this mark as: [] in Class []. I will refer to this trademark as the "[] Word

¹⁴ 15 U.S.C. § 1127; *Bd. Of Supervisors for La. State Univ. Agric. & Mech. Coll. V. Smack Apparel Co.*, 550 F.3d 465, 475 (5th Cir. 2008).

¹⁵ *Trade-Mark Cases*, 100 U.S. 82, 94-95 (1879); *Bos. Prof'l Hockey Ass'n v. Dall. Cap & Emblem Mfg., Inc.*, 510 F.2d 1004, 1014 (5th Cir. 1975).

¹⁶ *Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 1184 (5th Cir. 1980); *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 194 (5th Cir. 1998) (citing 15 U.S.C. § 1115(a)).

Trademark.”

2) The Logo Trademark, [DESCRIBE using word description in registration]: Plaintiff claims rights to this trademark under both federal and Texas law. Plaintiff owns a federal trademark registration for this trademark, which has been admitted as Exhibit [] in this trial. Plaintiff’s federal trademark registration for this logo trademark specifies the goods associated with the mark as: []. I will refer to this trademark as the “[] Logo Trademark.”

3) The service mark []. Plaintiff claims rights to this service mark under both federal and Texas law. Plaintiff owns a federal registration for this trademark, which has been admitted as Exhibit [] in this trial. Plaintiff’s federal trademark registration for the combined word mark for [] specifies the services associated with this mark as: [] in. I will refer to this trademark as the “Service Mark.”

The following instructions on trademark infringement focus on these marks. Plaintiff must prove infringement of each asserted mark independently of the other two.

14.8 Trademark Infringement ¹⁷

Plaintiff accuses Defendant of trademark infringement based on the sale of [] to [] under the brand name [] and with the associated [] logo. Plaintiff accuses Defendant of four different violations of its rights in each of its marks: (1) trademark infringement under federal law, (2) unfair competition under federal law, (3) trademark infringement under

¹⁷ *Union Nat’l Bank of Tex., Laredo, Tex. v. Union Nat’l Bank of Tex., Austin, Tex.*, 909 F.2d 839, 844 (5th Cir. 1990); *Riviana Foods Inc. v. Societe Des Produits Nestle S.A.*, No. CIV.A. H-93-2176, 1994 WL 761242, at *5 (S.D. Tex. Dec. 20, 1994).

Texas law, and 4) unfair competition under Texas law. These are four theories of liability, but they each require the same proof against Defendant, and so I will instruct you on the elements only once.¹⁸

To prevail on a trademark infringement claim, a plaintiff must establish: (1) ownership in a legally protectable mark; and (2) infringement by demonstrating a likelihood of confusion. Ownership of a mark is established by actual use in the market.¹⁹

If you find that Plaintiff has proved each of these things [for any trademark] by a preponderance of the evidence, and that Defendant did not prove by a preponderance of the evidence that Plaintiff [acted with unclean hands], then you must find for Plaintiff [as to that trademark]. However, if Plaintiff did not prove each of these things [for any trademark] by a preponderance of the evidence, then you must find for Defendant [as to that trademark]. In addition, if you find that Defendant proved by a preponderance of the evidence that Plaintiff [acted with unclean hands], then you must find for Defendant.

I will now explain what I mean by these terms.

¹⁸ Infringement claims under Texas common law are analyzed under the same framework as federal trademark law. *Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225, 236 (5th Cir. 2010). Texas unfair competition claims are also governed by the likelihood of confusion standard. *Scott Fetzer Co. v. House of Vacuums Inc.*, 381 F.3d 477, 484 (5th Cir. 2004); *RE/MAX Int'l, Inc. v. Trendsetter Realty, LLC*, 655 F. Supp. 2d 679, 711 (S.D. Tex. 2009); *Waterloo Sparkling Water Corp. v. Treaty Oak Brewing & Distilling Co., LLC*, No. 1:21-CV-161-RP, 2021 U.S. Dist. LEXIS 227700, at *10 (W.D. Tex. Nov. 24, 2021).

¹⁹ *Bd. Of Supervisors for La. State Univ. Ag. & Mech. Coll. V. Smack Apparel Co.*, 550 F.3d 465, 474-475 (5th Cir. 2008); *Am. Rice, Inc. v. Producers Rice Mill, Inc.*, 518 F.3d 321, 329 (5th Cir. 2008); *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 194 (5th Cir. 2007) (stating “the threshold requirement that the plaintiff must possess a protectible mark, which must be satisfied before infringement can be actionable”).

14.9 Trademark Infringement – Ownership of a Protectable Mark²⁰

As I have already mentioned, Plaintiff's [] Word Trademark, its [] Logo Trademark, and its [] Service Mark are federally registered trademarks. As federally registered marks, they are presumed to be valid and owned by Plaintiff.²¹ [The parties have stipulated that each of these federally registered trademarks is valid and owned by Plaintiff and that each trademark extends to the respective goods or services specified in the federal registration for each trademark].²² The parties also agree that []. You must accept these facts as true in your deliberations.

As to Plaintiff's common law trademarks, Plaintiff must show by a preponderance of the evidence that those marks are owned by Plaintiff. Plaintiff owns rights in its common law trademarks to the extent Plaintiff used the marks in a manner that allowed consumers to identify them with Plaintiff or its products before Defendant began using the [] brand and logo. [The parties agree that Defendant began using the [] brand and logo on [] in [

²⁰ *Nautilus Grp., Inc. v. ICON Health & Fitness, Inc.*, 372 F.3d 1330, 1339 (Fed. Cir. 2004); *Xtreme Lashes, LLC v. Xtended Beauty, Inc.*, 576 F.3d 221, 227 (5th Cir. 2009); *Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225, 237–38 (5th Cir. 2010); *Springboards to Educ., Inc. v. Hous. Indep. Sch. Dist.*, 912 F.3d 805, 814 (5th Cir. 2019).

²¹ 15 U.S.C. § 1115(a)-(b).

²² *Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 1184 (5th Cir. 1980); *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 194 (5th Cir. 1998) (citing 15 U.S.C. § 1115(a)); *Violet Crown Cinemas, LLC v. Int'l Dev. Mgmt., LLC*, No. 21-CV-1142, 2022 U.S. Dist. LEXIS 166518, at *1-11 (W.D. Tex. Sept. 15, 2022); *Waterloo Sparkling Water Corp. v. Treaty Oak Brewing & Distilling Co., LLC*, 2021 U.S. Dist. LEXIS 227700, at *10-13 (W.D. Tex. Nov. 28, 2021).

] and that Plaintiff began using its common law trademarks before that time on []].²³

²³ *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 267-68 (5th Cir. 1999); Seventh Circuit Pattern Civil Jury Instructions § 13.1.2.1.

14.10 Trademark Infringement – Likelihood of Confusion

To prevail on its claim against Defendant, Plaintiff must prove by a preponderance of the evidence that Defendant’s sale of [] under the [] brand and the [] logo creates a likelihood of confusion in the minds of potential consumers as to the source, affiliation, or sponsorship of the [] brand on [].²⁴

Likelihood of confusion means a probability of confusion, which is more than a mere possibility of confusion.²⁵ [²⁶].

In determining whether Plaintiff has proven by a preponderance of the evidence that there is a likelihood of confusion with respect to the source, affiliation, or sponsorship of the [] brand sold by Defendant[s], you should consider the following factors, known as “digits of confusion,” separately as to each Defendant and separately as to each allegedly infringed mark:

1. the type and strength of each allegedly infringed mark;
2. the similarity between Plaintiff’s and Defendant’s respective marks;
3. the similarity of the products or services supplied by Plaintiff and the product

²⁴ *Springboards to Educ. v. Hous. Indep. Sch. Dist.*, 912 F.3d 805, 811-12 (5th Cir. 2019); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 663 (5th Cir. 2000); *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 193 (5th Cir. 1998).

²⁵ *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 478 (5th Cir. 2008); *Streamline Prod. Sys., Inc. v. Streamline Mfg., Inc.*, 851 F.3d 440, 453 (5th Cir. 2017); *Springboards to Educ. v. Hous. Indep. Sch. Dist.*, 912 F.3d 805, 812 (5th Cir. 2019).

²⁶ Unfair competition claims and common law trademark infringement under Texas law are analyzed under the same standard as claims under the Lanham Act. For that reason, you can consider all of Plaintiff’s claims under the same standard. *See RE/MAX Int’l, Inc. v. Trendsetter Realty, LLC*, 655 F. Supp. 2d 679, 711 (S.D. Tex. 2009).

- or services supplied by Defendant under their respective marks;
4. the identity of retail outlets and purchasers of the products or services supplied by Plaintiff and Defendant under their respective marks;
 5. the identity of advertising media used by Plaintiff and Defendant;
 6. Defendant's intent in selecting its mark;
 7. any evidence of actual confusion caused by Defendant's use of the [] brand and [] logo; and
 8. the degree of care exercised by potential purchasers.²⁷

The weight to be given to the factors depends on the facts and circumstances of each case.²⁸ The absence or presence of any one of the digits does not determine whether there is, or is not, a likelihood of confusion. In some cases, a jury may find a likelihood of confusion even if it finds less than a majority of the factors.²⁹ In other cases, a jury may find no likelihood of confusion, even if it finds that a majority of the factors are present.³⁰ These digits of confusion are flexible and do not apply mechanically or to every case. These digits serve only as guides, not as an exact calculus. You must consider the application of each digit in light of the specific facts and circumstances of [evidence in]

²⁷ *Springboards to Educ., Inc. v. Pharr-San Juan-Alamo Indep. Sch. Dist.*, 33 F.4th 747, 750 (5th Cir. 2022); *Streamline Prod. Sys. v. Streamline Mfg.*, 851 F.3d 440, 453 (5th Cir. 2017).

²⁸ *Xtreme Lashes, LLC v. Xtended Beauty, Inc.*, 576 F.3d 221, 227 (5th Cir. 2009) (quoting *Marathon Mfg., Co. v. Enerlite Prods. Corp.*, 767 F.2d 214, 218 (5th Cir. 1985) (per curiam)).

²⁹ *Am. Rice, Inc. v. Producers Rice Mill, Inc.*, 518 F.3d 321, 329 (5th Cir. 2008).

³⁰ *Scott Fetzer Co. v. House of Vacuums Inc.*, 381 F.3d 477, 485 (5th Cir. 2004).

this case, and you must consider the marks in the context that a consumer perceives them in the marketplace.³¹

You may determine how much weight to give each factor. I will discuss each of these factors in turn.

³¹ *Scott Fetzer Co. v. House of Vacuums Inc.*, 381 F.3d 477, 485 (5th Cir. 2004); *Springboards to Educ. v. Hous. Indep. Sch. Dist.*, 912 F.3d 805, 812 (5th Cir. 2019) (citations omitted); *Rex Real Est. I, L.P. v. Rex Real Est. Exch., Inc.*, 80 F.4th 607, 620 (5th Cir. 2023) (“In addition to the digits of confusion, the particular context in which the mark appears must receive special emphasis.” (quoting *Scott Fetzer Co. v. House of Vacuums Inc.*, 381 F.3d 477, 485-86 (5th Cir. 2004))).

14.11 Trademark Infringement – Strength of the Asserted Mark³²

In determining whether Plaintiff has proven a likelihood of confusion by a preponderance of the evidence, the first digit of confusion for you to consider is the strength of Plaintiff's alleged trademarks. The strength or distinctiveness of a mark determines the amount of protection the mark receives. Generally, the stronger the mark, the greater the likelihood that consumers will be confused by competing uses of the mark.³³

A mark's strength depends on (1) the categorization or type of mark, and (2) the mark's recognition in the marketplace.³⁴

Trademarks can be categorized along the following range of generally increasing strength or distinctiveness: (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary, or (5) fanciful. Generic marks are the least distinctive and fanciful marks are the most distinctive.

The stronger or more distinctive the mark, the greater the likelihood that consumers will be confused and the more protection it receives. The last three categories of marks – suggestive, arbitrary and fanciful – are considered inherently distinctive marks and are entitled to protection without a showing that the marks have secondary meaning.

³² *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 259 (5th Cir. 1980); *Union Nat'l Bank of Tex., Laredo, Tex. v. Union Nat'l Bank of Tex., Austin, Tex.*, 909 F.2d 839, 845 (5th Cir. 1990); *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 201 (5th Cir. 1998); *Xtreme Lashes, LLC v. Xtended Beauty, Inc.*, 576 F.3d 221, 227 (5th Cir. 2009).

³³ *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 479 (5th Cir. 2008).

³⁴ *Homax Prods., Inc. v. Homax, Inc.*, No. H-08-CV-01560, 2009 WL 7808951, at *6 (S.D. Tex. Aug 5, 2009); *see also Sun Banks of Fla., Inc. v. Sun Fed. Sav. & Loan Assn.*, 651 F.2d 311, 315 (5th Cir. 1981) ("The ultimate strength of a mark, the key inquiry before us, is determined by a number of factors which establish its standing in the marketplace.").

Suggestive marks are marks that suggest an attribute of a good or service without describing it. These marks require the consumer to exercise his or her imagination to apply the trademark to the goods or services.³⁵ Arbitrary marks are marks that use ordinary words that do not suggest or describe the goods or services involved.³⁶ Fanciful marks are most often coined words.³⁷ [The parties disagree in this case as to whether Plaintiff's marks used in connection with [] is arbitrary or suggestive. Plaintiff contends they are arbitrary. Defendants contend they are suggestive.]

A plaintiff can show that a mark is strongly recognized in the marketplace based on extensive advertising, length of time in business, public recognition, uniqueness, and the quantity of sales of the branded products.³⁸

A strong trademark is one that consumers are likely to associate with the owner of the mark, and is rarely used by parties other than the trademark owner, while a weak trademark is one that is not well recognized or is often used by other parties. In short, the more distinctive a trademark, the greater its strength.

A trademark's strength is important in determining the scope of protection that it receives. The greater the number of identical or similar trademarks already used on different

³⁵ *Springboards to Educ. v. Hous. Indep. Sch. Dist.*, 912 F.3d 805, 814 (5th Cir. 2019); *Xtreme Lashes, LLC v. Xtended Beauty, Inc.*, 576 F.3d 221, 227 (5th Cir. 2009).

³⁶ *Xtreme Lashes, LLC v. Xtended Beauty, Inc.*, 576 F.3d 221, 227 (5th Cir. 2009).

³⁷ *Future Proof Brands, L.L.C. v. Molson Coors Beverage Co.*, 982 F.3d 280, 292 n.13 (5th Cir. 2020).

³⁸ *Homax Prods., Inc. v. Homax, Inc.*, No. H-08-CV-01560, 2009 WL 7808951, at *6 (S.D. Tex. 2009); *Quantum Fitness Corp. v. Quantum LifeStyle Ctrs., L.L.C.*, 83 F. Supp. 2d 810, 819-20 (S.D. Tex. 1999).

kinds of goods, the weaker the trademark and the lower the likelihood of confusion. You should consider all third-party use and third-party U.S. trademark registrations, and not just use in the same industry, to determine whether a mark is weak or strong.³⁹ A mark that is widely used on a variety of commercial goods is a weaker mark and entitled to a narrower range of protection.⁴⁰

³⁹ *Exxon Corp. v. Tex. Motor Exch. of Hous., Inc.*, 628 F.2d 500, 504 (5th Cir. 1980) (quoting Restatement (First) of Torts § 729 cmt. g (Am. L. Inst. 1938)); *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 259-60 (5th Cir. 1980) (abandoned and expired registrations are relevant). *See also Union Nat'l Bank of Tex., Laredo, Tex. v. Union Nat'l Bank of Tex., Austin, Tex.*, 909 F.2d 839, 848 n.24 (5th Cir. 1990) (stating that, in the “likelihood of confusion analysis, the trier of fact looks at all third party use, not just use in the same industry, to determine whether a mark is a ‘weak’ or a ‘strong’ mark”); *Rex Real Est. I, L.P. v. Rex Real Est. Exch., Inc.*, 80 F.4th 607, 621 (5th Cir. 2023); *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 260 (5th Cir. 1980) (“[T]hird-party uses and registrations . . . limit the protection to be accorded plaintiff’s mark outside the uses to which plaintiff has already put its mark.”).

⁴⁰ *Oreck Corp. v. U.S. Floor Sys., Inc.*, 803 F.2d 166, 170 (5th Cir. 1986); *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 259-60 (5th Cir. 1980); *Accord Picturecode, LLC v. Dig. Ninja, LLC*, No. A-10-CA-188-LY, 2010 U.S. Dist. LEXIS 154855, at *7 (W.D. Tex. Sep. 3, 2010) (“Registration itself establishes only a rebuttable presumption of use as of the filing date.” (citing *Zazu Designs v. L'Oreal, S.A.*, 979 F.2d 499, 504 (7th Cir. 1992))).

14.12 Trademark Infringement – Similarity of Marks⁴¹

The second digit, or factor, you may use in analyzing the likelihood of confusion is the similarity of the parties' respective marks.

The similarity of marks is determined by comparing their appearance, sound, and meaning. This factor focuses not on whether the marks are identical, but on whether they are sufficiently similar that consumers are likely to believe that Plaintiff's product is somehow associated with Defendant. A mark must be viewed in its entirety and in the context in which it is used in the marketplace, including how and where it is used on product packaging, labeling, and advertising. It is the overall impression of the mark that counts. You should not dissect the marks to compare individual features. Although more attention should be given to the dominant portion of the marks, the use of the same dominant words does not automatically equate to similarity between marks.⁴² Similarity of appearance is determined on the basis of the total effect of the trademark, rather than on a comparison of individual features.⁴³

⁴¹ *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 201 (5th Cir. 1998); *All. for Good Gov't. v. Coal. for Better Gov't.*, 901 F.3d 498, 510-11 (5th Cir. 2018); *Xtreme Lashes, LLC v. Xtended Beauty, Inc.*, 576 F.3d 221, 228 (5th Cir. 2009).

⁴² *Springboards to Educ. v. Hous. Indep. Sch. Dist.*, 912 F.3d 805, 815 (5th Cir. 2019) (citing *Sensient Techs. Corp. v. SensoryEffects Flavor Co.*, 613 F.3d 754, 765 (8th Cir. 2010)).

⁴³ *Sun Banks of Fla. v. Sun Fed. Sav. Loan*, 651 F.2d 311, 317-18 (5th Cir. 1981) (first quoting Restatement (First) of Torts § 729 cmt. b (Am. L. Inst. 1938); and then citing *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 260-61 (5th Cir. 1980) (quoting Restatement with approval)); *Armstrong Cork Co. v. World Carpets, Inc.*, 597 F.2d 496, 506 (5th Cir. 1979) ("It is the overall impression that counts.").

14.13 Trademark Infringement – Similarity of Products and Services⁴⁴

The third digit, or factor, to consider in analyzing likelihood of confusion is the similarity between the parties' respective products and services. The greater the similarity of the products or services, the greater the likelihood of confusion. Competition between the parties' products or services is not necessary for consumers to confuse them. When a company is diversified, that is, offers a number of different goods and services, that makes it more likely that a potential consumer would associate a non-diversified company's services with the diversified company.⁴⁵ Products that are often used or sold together, or complementary, are particularly susceptible to confusion. Products are also complementary when each product is useless without the other.⁴⁶

Even when products or services do not compete, there can be confusion as to sponsorship, affiliation, or connection. The danger of affiliation or sponsorship confusion increases when the more recent, or junior, user's goods are in a market into which the longer-time, or senior, user would naturally expand.⁴⁷ A plaintiff can show that a

⁴⁴ *Exxon Corp. v. Tex. Motor Exch. of Hous., Inc.*, 628 F.2d 500, 504 (5th Cir. 1980); *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 202 (5th Cir. 1998); *Viacom Int'l v. IJR Cap. Invs., L.L.C.*, 891 F.3d 178, 194 (5th Cir. 2018); *Fuji Photo Film Sun Banks of Fla. v. Sun Fed. Sav. Loan*, 651 F.2d 311, 317-18 (5th Cir. 1981).

⁴⁵ *Fuji Photo Film Co. v. Shinohara Shoji Kabushiki Kaisha*, 754 F.2d 591, 598 (5th Cir. 1985).

⁴⁶ *Id.* ("Shinohara's presses are useless without equipment and materials of the sort made by Fuji (among others); some of Fuji's products are useless without an offset press like Shinohara's.")

⁴⁷ *Quantum Fitness Corp. v. Quantum Lifestyle Ctrs. L.L.C.*, 83 F. Supp. 2d 810, 826 (S.D. Tex. 1999) (citing *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 202 (5th Cir. 1998)).

defendant's products fall within its natural zone of expansion by showing that its customers believe it to be in that zone, even if that perception is false.⁴⁸

⁴⁸ *Waterloo Sparkling Water Corp. v. Treaty Oak Brewing & Distilling Co., LLC*, 2021 U.S. Dist. LEXIS 227700, at *14-15 (W.D. Tex. Nov. 28, 2021).

14.14 Trademark Infringement – Identity of Retail Outlets and Purchasers⁴⁹

The fourth digit to consider in analyzing likelihood of confusion is whether there is overlap between the parties' retail outlets and consumers. The greater the overlap between the parties' retail outlets and consumers, the greater the likelihood of confusion. On the other hand, dissimilarities between the retail outlets for, and the [predominant][main][primary] consumers of, plaintiff's and defendants' goods lessen the possibility of confusion, mistake, or deception.⁵⁰

⁴⁹ *Viacom Int'l v. IJR Cap. Invs., L.L.C.*, 891 F.3d 178, 194 (5th Cir. 2018).

⁵⁰ *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 262 (5th Cir. 1980); *GetMe, LLC v. Abello*, No. 16-CV-00111-N, 2017 U.S. Dist. LEXIS 226034, at *10 (N.D. Tex. Sep. 20, 2017).

14.15 Trademark Infringement – Identity of Advertising Media⁵¹

The fifth digit to consider in analyzing likelihood of confusion is whether the parties use the same advertising media, such as websites, social media, magazines and trade journals, trade shows. The greater the similarity of advertising media, the greater the likelihood of confusion.

⁵¹ *Exxon Corp. v. Tex. Motor Exch. of Hous., Inc.*, 628 F.2d 500, 506 (5th Cir. 1980).

14.16 Trademark Infringement – Defendants’ Intent⁵²

The sixth digit to consider in analyzing likelihood of confusion is whether a defendant intended to derive benefit from the reputation of the plaintiff’s products when selecting its product name.

Evidence that a defendant adopted the mark with the intent to derive benefit from the reputation of a plaintiff’s products is evidence of a likelihood of confusion. But a defendant’s mere awareness of the plaintiff’s existing mark does not establish bad intent.⁵³

Even if a defendant adopts a mark with innocent intent, you may find intent to confuse if the defendant subsequently used the mark in a way that evidenced an intent to trade on the plaintiff’s reputation. Bad faith in adopting and using a trademark normally involves the imitation of packaging material, use of identical code numbers, adopting of similar distribution methods, or other efforts by a party to “pass off” its product as that of another. A party’s continued use of a mark even after it receives a cease and desist letter alleging infringement is not evidence of an intent to confuse, because that party may have considered that the allegation was without a legally supportable basis and made a rational

⁵² *All. for Good Gov’t. v. Coal. for Better Gov’t.*, 901 F.3d 498, 512 (5th Cir. 2018); *Am. Rice, Inc. v. Producers Rice Mill, Inc.*, 518 F.3d 321, 332 (5th Cir. 2008); *Future Proof Brands, L.L.C. v. Molson Coors Beverage Co.*, 982 F.3d 280, 289 (5th Cir. 2020); *Streamline Prod. Sys., Inc. v. Streamline Mfg., Inc.*, 851 F.3d 440, 455 (5th Cir. 2017); *Fuji Photo Film Co. v. Shinohara Shoji Kabushiki Kaisha*, 754 F.2d 591, 597 (5th Cir. 1985).

⁵³ *Amstar*, 615 F. 2d at 263 & n.9 (“Although Monaghan was aware of ‘Domino’ sugar at the time, he was unaware of any other pizzerias by that name. There is no evidence the name was adopted with any intent to confuse . . .”).

business decision to continue use until a court stated otherwise.⁵⁴ If there is no evidence of intent to confuse, this factor is neutral.⁵⁵

⁵⁴*Streamline Prod. Sys. v. Streamline Mfg.*, 851 F.3d 440, 456 (5th Cir. 2017) (citing 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 23:120 (4th Ed. 2009)); *Scott Fetzer Co. v. House of Vacuums Inc.*, 381 F.3d 477, 486 (5th Cir. 2004) (“Intent to compete, however, is not tantamount to intent to confuse.”).

⁵⁵ *Rex Real Est. I, L.P. v. Rex Real Est. Exch., Inc.*, 80 F.4th 607, 623 (5th Cir. 2023).

14.17 Trademark Infringement – Evidence of Actual Confusion⁵⁶

The seventh digit to consider in analyzing likelihood of confusion is evidence of actual confusion or mistake as to the source, affiliation, or sponsorship of Defendant's products. Actual confusion need not be proven but may be the best evidence of likelihood of confusion.⁵⁷ There may be actual confusion if people inadvertently contact Defendant while looking to do business or contact Plaintiff, or if people are confused about whether Plaintiff is affiliated with Defendant.

In determining the weight to be given to this factor, you should consider the extent to which the type of confusion shown has been or would be likely to sway consumer purchases. Evidence that confusion in fact swayed consumer purchases is strong evidence of a likelihood of confusion.⁵⁸ However, more evidence is required to show a likelihood of confusion when the type of confusion shown did not or cannot sway purchases.⁵⁹

Actual confusion has more weight if it affects a potential consumer considering whether to transact business with Plaintiff or Defendant. To show actual confusion, Plaintiff may rely on reported instances of consumer confusion. However, isolated instances of confusion about the affiliation of two companies that do not result in redirected

⁵⁶ *Streamline Prod. Sys., Inc. v. Streamline Mfg., Inc.*, 851 F.3d 440, 457 (5th Cir. 2017); *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 483 (5th Cir. 2008); *Moore Bus. Forms, Inc. v. Ryu*, 960 F.2d 486, 491 (5th Cir. 1992); *Fuji Photo Film Co. v. Shinohara Shoji Kabushiki Kaisha*, 754 F.2d 591, 595 (5th Cir. 1985).

⁵⁷ *Rex Real Est. I, L.P. v. Rex Real Est. Exch., Inc.*, 80 F.4th 607, 623 (5th Cir. 2023).

⁵⁸ *Rex Real Est. I, L.P. v. Rex Real Est. Exch., Inc.*, 80 F.4th 607, 625 (5th Cir. 2023).

⁵⁹ *Id.*

business are not enough to find actual confusion. Instances of uncertainty about affiliation or connection should be weighed against each party's volume of business as a whole.⁶⁰ The confusion of both retailers and consumers is relevant evidence of actual confusion.

Actual confusion evidence can demonstrate a likelihood of confusion even if confused persons realize their mistake after further investigation. This is called "initial interest" confusion. A potential consumer may not consider Plaintiff's trademarked goods or services even if the confusion with Defendant's goods or services is cleared up. Defendant may have gained the consumer's credibility and obtained the business before or after the confusion is cleared.⁶¹ However, short-lived impressions or a fleeting and quickly corrected mix-up of names is not evidence of actual confusion.⁶²

⁶⁰ *Id.*

⁶¹ *Id.* at 626-27 (5th Cir. 2023); *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 204 (5th Cir. 1998).

⁶² *Rex Real Est. I, L.P. v. Rex Real Est. Exch., Inc.*, 80 F.4th 607, 626-27 (5th Cir. 2023); *Casa Tradición S.A. de C.V. v. Casa Azul Spirits, LLC*, No. H-22-2972, 2022 U.S. Dist. LEXIS 227492, at *25 (S.D. Tex. Dec. 19, 2022) (quoting *Streamline Prod. Sys., Inc. v. Streamline Mfg., Inc.*, 851 F.3d 440, 457 (5th Cir. 2017)); *True Believers Ink 2, Corp. v. Russell Brands, LLC*, No. 18-CV-00432, 2020 U.S. Dist. LEXIS 77689, at *19-20 (E.D. Tex. May 4, 2020); *Armstrong Cork Co. v. World Carpets, Inc.*, 597 F.2d 496, 506 (5th Cir. 1979) (stating that "short-lived impressions," if "confusion at all," did not tip scales).

14.18 Trademark Infringement – Degree of Care⁶³

The eighth digit to consider in analyzing likelihood of confusion is the degree of care exercised by purchasers. Confusion is generally more likely if the products in question are impulse items or are inexpensive. Conversely, a person buying a big-ticket or expensive item is ordinarily expected to be a more careful buyer than the impulse purchaser or the purchaser of a relatively inexpensive item.⁶⁴ If there is evidence that consumers use a great deal of care when making purchasing decisions, then they may be less likely to be confused. If the items are expensive and the buyers are sophisticated, then confusion is less likely to occur.⁶⁵

However, even sophisticated purchasers can be confused by similar marks used in the same general field. Additionally, even sophisticated purchasers can be subject to initial-interest confusion. Initial-interest confusion is especially relevant if the parties are direct competitors in the same market.⁶⁶

⁶³ *Fuji Photo Film Co. v. Shinohara Shoji Kabushiki Kaisha*, 754 F.2d 591, 595 (5th Cir. 1985).

⁶⁴ *RE/MAX Int'l, Inc. v. Trendsetter Realty, LLC*, 655 F. Supp. 2d 679, 711 (S.D. Tex. 2009) (citing *Falcon Rice Mill, Inc. v. Comty. Rice Mill, Inc.*, 725 F.2d 336, 345 n.9 (5th Cir.1984)); *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 483 (5th Cir. 2008); *Armstrong Cork Co. v. World Carpets, Inc.*, 597 F.2d 496, 504 n.10 (5th Cir. 1979).

⁶⁵ *Bd. of Regents of the Univ. of Hous. Sys. v. Hous. Coll. of Law, Inc.*, 214 F. Supp. 3d 573, 597 (S.D. Tex. 2016).

⁶⁶ *RE/MAX Int'l, Inc. v. Trendsetter Realty, LLC*, 655 F. Supp. 2d 679, 707, 711 (S.D. Tex. 2009).

14.19 Weighing the Digits of Confusion

As I told you earlier, it is up to you to determine how to weigh each digit in determining if Plaintiff has proved by a preponderance of evidence there is a likelihood of confusion. You do not need to give equal weight to each factor. You must weigh the digits separately for each of the [] trademarks asserted by Plaintiff. You must also weigh the factors for each mark against each Defendant separately.

14.20 Expressive Works

Defendant's work [describe allegedly infringing work], is an expressive work that is not using Plaintiff's mark as its own mark,⁶⁷ but rather is using Plaintiff's mark in a way that is artistically relevant to the expressive aspects of Defendant's work,⁶⁸ and is accordingly protected by the First Amendment.⁶⁹ Therefore, you may find for Plaintiff on

⁶⁷ See *Jack Daniel's Props., Inc., v. VIP Prods. LLC*, 599 U.S. 140, 155-63 (2023) (explaining that First Amendment protection does not apply when the defendant uses the plaintiff's mark "as a mark," that is, as a source identifier for the defendant's own products). If the defendant is using the plaintiff's mark as a source identifier, although First Amendment protection does not apply, the final paragraph of this section on the relationship between parody and likelihood of confusion could still apply, as in *Jack Daniel's*. See *id.* at 161.

⁶⁸ The artistic relevance prong of the First Amendment analysis is generally considered a low threshold in circuits that have adopted this doctrine. See *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 665 n.3 (5th Cir. 2000) ("The magistrate judge did not decide the threshold matter whether Westchester's title bears some artistic relevance to the underlying magazine. There can be no question on this point, however."); see also *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2nd Cir. 1988) (discussing the "low threshold of minimal artistic relevance"); *Dr. Seuss Enters., L.P. v. ComicMix LLC*, 983 F.3d 443, 462 (9th Cir. 2020) (explaining that "any artistic relevance above zero" satisfies the required).

⁶⁹ See *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 665 (5th Cir. 2000) (citing *Sugar Busters LLC v. Brennan*, 117 F.3d 258, 269 n.7 (5th Cir. 1999)). Cf. *Estate*

its trademark-infringement claim against this work only if you find that the case for likelihood of consumer confusion is particularly strong.⁷⁰

One way, though not the only way, to find a particularly strong case for likelihood of confusion is to find that Defendant intended to trade on Plaintiff's goodwill and reputation.⁷¹ Another way might be if the case for likelihood of confusion is clear and unambiguous, or if Defendant's use of Plaintiff's trademark explicitly misleads consumers as to the source or content of the work.⁷²

On the other hand, if Defendant's work is a successful parody of Plaintiff's work, such that consumers would be likely to understand that Defendant's work is poking fun at or criticizing Plaintiff's work rather than identifying with it, this would generally tend to lessen the likelihood of confusion.⁷³

of Barre v. Carter, 272 F. Supp. 3d 906, 945 (E.D. La. 2017) ("The Fifth Circuit has applied the *Rogers* test with respect to trademark infringement claims involving titles of works. However, it does not appear that the Fifth Circuit has considered whether the *Rogers* test should be applied in trademark cases involving artistic works generally."); *Rin Tin Tin, Inc. v. First Look Studios, Inc.*, 671 F. Supp. 2d 893, 902 (S.D. Tex. 2009) (stating "the First Amendment applies to protect titles and works from federal claims of confusion.")

⁷⁰ See *Westchester*, 214 F.3d at 667-68 ("As has been discussed, Westchester's First Amendment interest in choosing a title for its magazine requires a particularly compelling likelihood of confusion."). The court should carefully consider whether and how to frame this issue for the jury versus treating it as a matter of law.

⁷¹ See *id.* at 668.

⁷² See *Estate of Barre*, 272 F.3d at 945-946.

⁷³ See *Jack Daniel's Props., Inc., v. VIP Prods. LLC*, 599 U.S. 140, 161 (2023) (explaining that an allegedly infringing work's expressive message, particularly a parodic one, "may properly figure in assessing the likelihood of confusion," and that to succeed, a parody must create contrasts with the original "so that its message of ridicule or pointed humor comes clear," and that *if* that is done, "a parody is not often likely to create confusion").

14.21 Affirmative Defense of Abandonment (15 U.S.C. § 1127)

Defendant contends that, even if Plaintiff could prevail on one or more of its trademark or trade dress claims against Defendant, Plaintiff is not entitled to any recovery or relief on any of those claims under what is known as the doctrine of abandonment. The owner of a trademark cannot exclude others from using the mark if it has been abandoned. Defendant bears the burden of proving abandonment by clear and convincing evidence.⁷⁴

Defendant must show that Plaintiff has discontinued the bona fide use of its trademarks at issue, and did so with the intent to not resume use in the reasonably foreseeable future. If you find that Plaintiff has not used the trademark for three consecutive years, you may presume that Plaintiff did not intend to resume use of the trademark, but Plaintiff may rebut that presumption by producing evidence that it intended to resume use.⁷⁵

14.22 Affirmative Defense of Fair Use (15 U.S.C. § 1115(b)(4))

Defendant contends that, even if Plaintiff could prevail on one or more of its trademark or trade dress claims against Defendant, Plaintiff is not entitled to any recovery or relief on any of those claims under what is known as the defense of fair use. A defendant makes fair use of a descriptive trademark when the defendant does not use it as a trademark, but instead to accurately describe aspects of the defendant's own product or service.

⁷⁴ *Perry v. H.J. Heinz Co. Brands, LLC*, 994 F.3d 466, 474 (5th Cir. 2021) (“[A] party claiming that a trademark has been intentionally abandoned bears a heavy burden. . . . Courts have equated the requirement for strict proof to the burden of providing clear and convincing evidence.”).

⁷⁵ *See id.* (“Nonuse for 3 consecutive years shall be prima facie evidence of abandonment.” (quoting 15 U.S.C. § 1127)).

Defendant has the burden of proving its fair use of the marks by a preponderance of the evidence. Defendant must show that it used the mark fairly and in good faith, to describe its own goods or services. The fair-use defense does not apply if Defendant used Plaintiff's mark as its own trademark to identify Defendant's goods or services, but the fair use of a term may be protected even if some residual confusion is likely.⁷⁶

14.23 Affirmative Defense – First Sale

Defendant contends that, even if Plaintiff could prevail on one or more of its trademark or trade dress-related claims against Defendant, Plaintiff is not entitled to any recovery or relief on any of those claims under what is known as the first-sale doctrine.

After the first authorized sale of an item, the holder of the item's trademark may not claim trademark infringement for subsequent sales, distributions, or displays, of that particular item.⁷⁷ If you find that the particular item Defendant [distributed, sold, stocked, displayed] was previously subject to a genuine sale authorized by Plaintiff, your verdict should be for Defendant on the Plaintiff's trademark infringement claim.

⁷⁶ See *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 270-71 (5th Cir. 1999); see also *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2005) (possible consumer confusion does not foreclose application of the fair-use defense); 15 U.S.C. § 1115(b)(4) (discussing the defense that “use, otherwise than as a mark . . . of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party”).

⁷⁷ See *Martin's Herend Imps., Inc. v. Diamond & Gem Trading USA, Co.*, 112 F.3d 1296, 1303 (5th Cir. 1997) (“Once a trademark owner sells his product, the buyer ordinarily may resell the product under the original mark without incurring any trademark law liability.” (emphasis omitted)).

14.24 “Unclean Hands” Affirmative Defense

Defendant contends that, even if Plaintiff could prevail on one or more of its trademark or trade dress claims against Defendant, Plaintiff is not entitled to any recovery or relief on any of those claims under the doctrine of unclean hands. This bars a plaintiff from benefiting when its own conduct in connection with the same matter has been unjust, marked by a lack of good faith, or violates the principles of equity and fair dealing.⁷⁸

Defendant bears the burden of proving by a preponderance of the evidence that Plaintiff has unclean hands. Defendant must show that Plaintiff’s conduct has been inequitable and that Plaintiff’s conduct relates to the subject matter of its trademark-related claims it asserted against Defendant. Defendant also must show that it has been seriously harmed by Plaintiff’s conduct and that these wrongs cannot be corrected without applying the doctrine of unclean hands.⁷⁹

⁷⁸ *Janes v. Watson*, No. SA-05-CA-0473, 2006 U.S. Dist. LEXIS 59004, at *50-51 (W.D. Tex. Aug. 2, 2006) (citations omitted); *see also Fuddruckers, Inc. v. Doc’s B.R. Others, Inc.*, 826 F.2d 837, 847 (9th Cir. 1987). The Fifth Circuit has cited with approval *Fuddruckers* and other authorities recognizing the applicability of the unclean hands defense in trademark and unfair competition cases. *See Sugar Busters LLC v. Brennan*, 177 F.3d 258, 271-72 (5th Cir. 1999) (citing *Levi Strauss & Co. v. Shilon*, 121 F.3d 1309, 1313 (9th Cir. 1997)); Restatement (Third) of Unfair Competition, § 32 & cmt. a (Am. L. Inst. 1995) (“The doctrine of unclean hands is applicable in actions for the infringement of registered trademarks ... and in actions involving unregistered marks under § 43(a) of the [Lanham Act] and at common law.”); 5 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §§ 31:44-58 (4th ed. 2009).

⁷⁹ *Janes v. Watson*, No. SA-05-CA-0473, 2006 U.S. Dist. LEXIS 59004, at *50-51 (W.D. Tex. Aug. 2, 2006) (citations omitted).

14.25 Trademark Infringement – Award of Defendants’ Profits⁸⁰

If you find that Defendant infringed Plaintiff’s trademark rights, you must then determine what damages, if any, Plaintiff is entitled to recover from Defendant. [In this case, Plaintiff does not seek any actual damages, but instead seeks damages from Defendant in the form of the profits attributable to Defendant’s alleged infringement].

You should not conclude from the fact that I am instructing you about damages that I have any opinion as to whether Plaintiff has proved liability against Defendant. It is your task first to decide whether Defendant is liable. I am instructing you on damages only so that you will have guidance in the event you decide that Defendant is liable and that Plaintiff is entitled to recover money from Defendant for infringement.⁸¹

Plaintiff must prove by a preponderance of evidence its entitlement to, and, if so, the amount of profits resulting from the infringement of Defendant. In determining whether to award profits in this case, the factors to be considered include, but are not limited to:

- 1) whether Defendant had the intent to confuse or deceive,
- 2) whether sales have been diverted from Plaintiff to Defendant,
- 3) the adequacy of other remedies,
- 4) any unreasonable delay by Plaintiff in asserting its rights,
- 5) the public interest in making the misconduct unprofitable, and

⁸⁰ 15 U.S.C. § 1117(a); *Am. Rice, Inc. v. Producers Rice Mill, Inc.*, 518 F.3d 321, 337 (5th Cir. 2008).

⁸¹ Fifth Circuit Pattern Jury Instructions (Civil Cases) § 15.1 (2020).

6) whether it is a case of palming off.⁸²

It is up to you to determine how to weigh each factor, and you do not need to give each factor equal weight.

If you find, subject to these principles of equity, that Plaintiff is entitled to recover Defendant's profits, you must then determine the amount of Defendant's profits that are attributable to the infringement.

Plaintiff's burden is to prove, by a preponderance of the evidence, Defendant's individual sales of the product bearing the infringing trademark. It also is Plaintiff's burden to prove, by a preponderance of the evidence, the amount of profits attributable to Defendant's unlawful use of its mark.⁸³ Defendant then has the burden to prove by a preponderance of the evidence any costs or deductions that it believes must be deducted to calculate its net profits.

⁸² *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 554 (5th Cir. 1998) (collecting cases); *see also Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 28 n.1 (2003) (stating that palming off occurs when a seller misrepresents his own product as someone else's product.).

⁸³ *Pebble Beach*, 155 F.3d at 554-55.