**10.1 Trademark Infringement – Registered Trademark**

[Name of plaintiff] claims that [name of defendant] has infringed [his/her/its] registered trademark. To prove [his/her/its] claim, [name of plaintiff] must prove the following facts by a preponderance of the evidence:

1: [Name of plaintiff] owns a trademark that is entitled to protection; and

2: That [name of defendant] is using a mark that infringes upon [name of plaintiff]’s trademark.

[You are instructed and must accept as a fact that [name of plaintiff] owns a federal registration of the trademark [he/she/it] seeks to protect in this action. It is [name of defendant]’s burden to prove that [name of plaintiff]’s trademark is invalid.]

[This instruction should be used if the parties do not stipulate regarding a federal registration:

You must first find that [name of plaintiff] owns a federal registration of the trademark at issue in this case. To do this, you must find that the trademark is covered by a registration on the Principal Register of the U.S. Patent and Trademark Office. If you do not find that [name of plaintiff] owns a federal registration, then you must determine whether [name of plaintiff] owns a trademark that is entitled to protection. [If it is disputed whether [name of plaintiff] has a registered trademark, the unregistered trademark instructions also should be given.]]

If you find [name of plaintiff]’s trademark is covered by a federal registration, [name of plaintiff] enjoys what is known as “constructive nationwide priority” in [his/her/its] trademark, whether or not [name of plaintiff] uses the trademark on a nationwide basis. [name of plaintiff] is presumed to have started using the trademark nationwide as of its filing date, even if [he/she/it] only used it in a limited area. In this case, [name of plaintiff] enjoys nationwide priority of rights dating back to the filing date of the application, which is [filing date].

Because [name of plaintiff] owns a federal registration of the trademark, [name of defendant] is deemed to have knowledge of the registration and of the rights claimed in the registration. This is known as “constructive notice,” and [name of defendant] cannot claim that [he/she/it] adopted [his/her/its] trademark without knowledge of [name of plaintiff]’s trademark. In this case, [name of plaintiff] enjoys nationwide constructive notice of rights dating back to the filing date of the application, which is [filing date].

Infringement: Introductory Jury Charge

If you have determined that [name of plaintiff] owns a trademark that is entitled to protection, you must next consider whether [name of defendant] infringed [name of plaintiff]’s trademark. The test for infringement is whether [name of defendant]’s trademark is “likely to cause confusion” with [name of plaintiff]’s trademark.

That is, you must determine if [name of defendant], without [name of plaintiff]’s consent, used the same or a similar trademark in connection with the sale of, or the offer to sell, goods in a manner that is likely to cause confusion among consumers as to the source, affiliation, approval, or sponsorship of the goods. “Source,” “origin,” “affiliation,” “approval,” or “sponsorship” means that the public believes that [name of defendant]’s goods come from, are affiliated with, are approved by, or sponsored by [name of plaintiff].

It is not necessary that the trademark used by [name of defendant] be an exact copy of [name of plaintiff]’s trademark. Instead, [name of plaintiff] must demonstrate, by a preponderance of the evidence, that [name of defendant]’s use of [his/her/its] trademark is, when viewed in its entirety, likely to cause confusion as to the source, origin, affiliation, approval, or sponsorship of the goods in question.

Infringement

[Name of plaintiff] claims that [name of defendant] has infringed [his/her/its] trademark. For [name of plaintiff] to succeed on this claim you must find by a preponderance of the evidence that [name of defendant]:

1: used the trademark in connection with the sale or offer to sell goods;

2: used the trademark in commerce; and

3: used the trademark in a manner that is likely to:

a. cause confusion, mistake, or deception as to

b. the source, origin, affiliation, approval, or sponsorship of [name of defendant]’s goods.

Infringement: Likelihood of Confusion (Seven-Factor Test)

There are seven factors you can use to determine whether a likelihood of confusion exists. No single factor or consideration controls, and [name of plaintiff] is not required to prove all, or even most, of the factors are present in any particular case. You may also use factors other than these seven. You should weigh all of the relevant evidence in determining whether a likelihood of confusion exists.

Type and Strength of [Name of Plaintiff]’s Trademark

The first factor is the “type and strength” of the trademark. Trademarks come in different “types” or categories, namely, “generic,” “descriptive,” “suggestive,” “arbitrary,” and “fanciful” or “coined.” The type of a claimed trademark is relevant to the trademark’s strength.

Some trademarks are stronger than others. The “stronger” the trademark, the more protection should be given to it. I will now describe each type of trademark in the order of their general relative strength.

Generic:

A claimed trademark is generic if it is the word, name, symbol, device, or any combination thereof, by which the good commonly is known. An example of a generic trademark is “escalator” for moving stairs.

Whether a claimed trademark is generic does not depend on the term itself, but on use of the term. A word may be generic of some things but not of others. For example, “ivory” is generic for elephant tusks, but it is not generic for soap.

Whether a claimed trademark is a generic term is viewed from the perspective of a member of the public evaluating the trademark.

Generic trademarks are not protected. They cannot be registered with the U.S. Patent and Trademark Office.

Descriptive:

A “descriptive” trademark only describes an ingredient, quality, characteristic, function, feature, purpose, or use of the good provided under it. An example of a descriptive trademark would be Vision Center for an eyeglasses store. Descriptive trademarks are eligible for registration with the U.S. Patent and Trademark Office if the trademark has acquired “secondary meaning.” A trademark has acquired secondary meaning if the primary significance of the trademark in the minds of the consuming public is not the associated good itself, but instead the source or producer of the good.

There are four factors you may use in determining whether secondary meaning exists:

The length and nature of the trademark’s use;

The nature and extent of advertising and promotion of the trademark;

The efforts of the trademark owner to promote a conscious connection between the trademark and its business; and

The degree to which the public recognizes [name of plaintiff]’s good by the trademark.

[This instruction should be used if [name of plaintiff]’s trademark registration has achieved incontestable status under 15 U.S.C. § 1065:

In this case, I have determined that [name of plaintiff]’s trademark is covered by an incontestable registration on the Principal Register. The effect of that determination is that the registration is conclusive evidence that the trademark is at least descriptive with secondary meaning. You must accept that [name of plaintiff]’s trademark was at least descriptive and possessed secondary meaning at the time [name of plaintiff] applied for its registration.]

[This instruction should be used if [name of plaintiff]’s trademark registration has not achieved incontestable status under 15 U.S.C. § 1065:

In this case, I have determined that this trademark is registered on the Principal Register and that it is at least descriptive with secondary meaning. Therefore [name of defendant] has the burden of proving by a preponderance of the evidence that the trademark is invalid because it was descriptive but lacked secondary meaning before [name of defendant] began using [his/her/its] trademark.]

Suggestive:

A “suggestive” trademark suggests, rather than describes, qualities of the underlying good. If a consumer’s imagination is necessary to make the connection between the trademark and the goods then the trademark suggests the features of the good. An example of a suggestive trademark is Iceberg for a refrigerator. Suggestive trademarks are eligible to be registered in the U.S. Patent and Trademark Office without proof of secondary meaning.

Arbitrary and Fanciful or Coined:

An “arbitrary” trademark is a real word but has no logical relationship, to the underlying goods. An example of an arbitrary trademark is Domino for sugar.

A “fanciful” or “coined” trademark is a trademark created solely to function as a trademark but which has no meaning beyond the trademark itself. An example of a fanciful or coined trademark is Exxon for gasoline.

Arbitrary and fanciful or coined trademarks are eligible to be registered in the U.S. Patent and Trademark Office without proof of secondary meaning.

Additional Considerations Relating To Trademark Strength:

When evaluating the strength of [name of plaintiff]’s trademark, you may also consider the extent of any use by third parties of similar trademarks, [name of plaintiff]’s promotional expenditures, the volume of [name of plaintiff]’s sales under [his/her/its] trademark, and whether [name of plaintiff]’s registration has achieved incontestable status.

Similarity of the Parties’ Trademarks

In evaluating whether trademarks are similar, you may consider the “overall impression” that [name of plaintiff]’s and [name of defendant]’s trademarks create, including the sound, appearance, and manner in which they are used. You may look at the trademarks as a whole rather than simply comparing their individual features.

Similarity of the Parties’ Goods

This factor considers not only whether the consuming public can readily distinguish between the parties’ goods, but also whether the goods at issue are of a kind that the public attributes to a single source.

Similarity of the Parties’ Sales Channels, Distribution, and Customers

This factor considers where, how, and to whom the parties’ goods are sold. Similarities increase the possibility of consumer confusion, mistake, or deception.

Similarity of the Parties’ Advertising Media

This factor looks to each party’s method of advertising. It is not a requirement that [name of plaintiff] and [name of defendant] advertise in the same magazines, publications, or other advertising outlets. The issue is whether the parties use the same forums and media outlets to advertise, leading to possible confusion.

[Name of Defendant]’s Intent

You may also consider whether [name of defendant] intended to infringe on [name of plaintiff]’s trademark. That is, did [name of defendant] adopt [his/her/its] trademark with the intention of deriving a benefit from [name of plaintiff]’s reputation? If you determine that [name of defendant] intentionally ignored the potential for infringement, you may impute to [name of defendant] an intent to infringe.

Actual Confusion

Because the presence of actual confusion usually is difficult to show, a finding of actual confusion is not required to find trademark infringement. Alternatively, the absence of actual confusion does not necessarily mean [name of defendant] is not liable for trademark infringement.

The evidence of actual confusion of trademarks should be reasonably significant. You should weigh the alleged actual confusion using the following factors:

The amount and duration of the confusion;

The degree of familiarity the confused party has with the goods;

The type of person complaining of the alleged actual confusion (for example, whether that person is a customer or a noncustomer); and

The alleged number of people who are actually confused (for example, whether the confused person is an actual customer or someone else).

If you find that [name of defendant] has infringed [name of plaintiff]’s trademark, you must next consider [name of defendant]’s affirmative defenses. [See Defense Interrogatories at 10.3]

[The following instruction should be given in cases in which plaintiff claims third party “contributory infringement” for an underlying claim of infringement.

[Name of plaintiff] claims that [name of defendant] is liable for the “contributory infringement” of [name of plaintiff]’s trademark. “Contributory infringement” occurs when a defendant intentionally induces or causes another party to infringe a plaintiff’s trademark. If this occurs, [name of defendant] can be held liable for other party’s infringement.]

Trademarks: Remedies

If you find that [name of plaintiff] owns a valid trademark, that [name of defendant] has infringed it, and [name of defendant] does not have a defense you must consider whether, and to what extent, monetary relief should be awarded.

Plaintiff’s Actual Monetary Damages

You may award actual damages that [name of plaintiff] has sustained. [name of plaintiff] may recover the economic injury to [his/her/its] business proximately resulting from [name of defendant]’s wrongful acts. You are not required to calculate actual damages with absolute exactness – you may make reasonable approximations. But an award of actual damages to [name of plaintiff] must be just and reasonable, based on facts, and proved by [name of plaintiff] by a preponderance of the evidence.

Defendant’s Profits and Calculation of Profits

In addition to [name of plaintiff]’s actual damages, you may also make an award based on an accounting of [name of defendant]’s profits if you find that:

[Name of defendant]’s conduct was willful and deliberate;

[Name of defendant] was unjustly enriched; or

An award of [name of defendant]’s profits is necessary to deter [name of defendant]’s future conduct.

A defendant commits a “willful violation” of a trademark when that defendant knowingly and purposefully capitalizes on and appropriates the goodwill of a plaintiff.

“Unjust enrichment” occurs if [name of defendant] receives a benefit to which [he/she/it] is not entitled.

In determining [name of defendant]’s profits, [name of plaintiff] only is required to prove [name of defendant]’s gross sales. [Name of defendant] may then prove the amount of sales made for reasons other than the infringement. [Name of defendant] also may prove its costs or other deductions which [he/she/it] claims should be subtracted from the amount of [his/her/its] sales to determine [his/her/its] profits on such sales. Any costs or deductions that [name of defendant] proves by a preponderance of the evidence are required to be subtracted from the sales attributable to the infringement and the difference is the amount that may be awarded to [name of plaintiff].

Nominal Damages

If you find that [name of defendant] infringed [name of plaintiff]’s trademark, but you do not find that [name of plaintiff] sustained any actual damages or damages based on [name of defendant]’s profits, you may return a verdict for [name of plaintiff] and award what are called “nominal” damages. By “nominal” I mean a small amount of damages that you, in your discretion, determine.

Infringement of a Registered Trademark

**Special Interrogatories to the Jury**

**Do you find by a preponderance of the evidence that:**

[Name of plaintiff] owns a federal registration of [his/her/its] trademark on the Principal Register.

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “No,” this ends your deliberations, and your foreperson should sign and date the last page of this verdict form. If your answer is “Yes,” go to the next question.

[Name of defendant]’s use of [his/her/its] trademark caused a likelihood of confusion with [name of plaintiff]’s trademark.

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “Yes,” answer the “Defenses” special interrogatories. If your answer is “No” and [name of defendant] asserted that [name of plaintiff]’s trademark registration is invalid, then answer the “Validity” special interrogatories. If your answer is “No” and [name of defendant] has not asserted that [name of plaintiff]’s trademark registration is invalid, then your foreperson should sign and date the last page of this verdict form.

**[Use these special interrogatories if plaintiff is claiming contributory infringement:**

A party, other than [name of defendant], has infringed [name of plaintiff]’s trademark and [name of defendant] knew that the other party would be engaging in trademark infringement if [he/she/it] undertook the challenged activity.

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “Yes,” go to Question No. 4. If your answer is “No,” then go to Question No. 6.

[Name of defendant] intentionally induced the other party to engage in the infringing activity.

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “Yes,” go to Question No. 5. If your answer is “No,” then go to Question No. 6, if appropriate.

[Name of defendant] is liable for contributory infringement.

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer to this question is “Yes,” then go to Question No. 6.]

**[These special interrogatories should be used if plaintiff seeks actual damages:**

[Name of plaintiff] has suffered actual monetary damages.

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_]

If your answer is “Yes,” in what amount?

$\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_.]

If your answer is “No,” go to Question No. 8.

**[These special interrogatories should be used if plaintiff seeks an award of defendant’s profits:**

[Name of defendant]’s conduct was willful and deliberate, or [name of defendant] was unjustly enriched, or an award of [name of defendant]’s profits is necessary to deter future conduct.

Answer Yes or No \_\_\_\_\_\_\_\_\_\_\_\_\_

If your answer is “Yes,” in what amount?

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If your answer is “No,” go to Question No. 10.]

**[This special interrogatory should be used if plaintiff seeks nominal damages:**

[Name of plaintiff] has not proved any actual monetary damages nor have [name of defendant]’s profits been awarded, but [name of plaintiff] is awarded nominal damages.

If your answer is “Yes,” in what amount?

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So Say We All.

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Foreperson’s Signature

Date: \_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_\_