

Gibson's Trademark Conundrum:
Confusion over Guitar Shapes, Initial Interest, and FRISCH Factors 73

John Wie

In this recent trademark infringement case, John examines the value of a multi-factor test commonly used to identify the “likelihood for consumer confusion.” He argues that, with one small exception, the district court employed the multi-factor test appropriately. John’s concerns are elevated, though, when the appellate court reverses the ruling, basing its own analysis on only *one* of these relevant factors.

Cite as:

5 UCI L. Forum J. 73 (Fall 2007).

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INTRODUCTION

Why do some buyers specifically seek electronic devices featuring an apple icon? Why will other buyers only look at sneakers featuring a three-stripe design? Such idiosyncrasies are easy to understand: in ever-growing markets where competing firms create countless choices, consumers rely on hard-earned, time-tested assumptions to purchase most goods or services. Trademarks are the recognizable symbols that sustain these assumptions by instantaneously identifying the origin, quality, and expectations associated with particular products. Hence, when consumers rely on words, symbols, and logos to facilitate shopping decisions, trademarks prove that "perception is reality" – a finding that gives companies enough reason to create, promote, and vigorously defend their distinguishing marks.

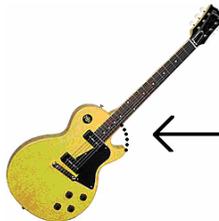
Trademark protection allows companies to own, advertise, and profit from their hard-earned reputations and unique products. On a grander scale, when laws recognize and respect this form of intellectual property, consumer confidence and fair trade increase accordingly. However, expanding markets and increased competition have made it harder for companies to protect their exclusive marks; with every business trying to stand out, and many businesses trying to get started, unintentional overlaps are possible, if not expected. Thus, because each trademark infringement case presents unique facts, courts must use both objective standards and subjective interpretation to determine when trademark protection is applicable.

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Recently, the case of *Gibson Guitar Corporation v. Paul Reed Smith Guitars* showcased the dispute over the use of a certain guitar shape as a trademark. Both the background history of the case and the appropriate legal standard will be presented. This legal standard will then be illustrated through its use in three other trademark infringement cases. Next, the focus will shift back to *Gibson*, where the differences in the district court and appellate court opinions will be analyzed. This analysis will ultimately show that the Sixth Circuit Court of Appeals misapplied the legal standard by misinterpreting one of the relevant factors and disregarding several others. The appellate court should have instead emulated the district court by looking at the *totality* of the relevant factors before deciding the *Gibson* case.

BACKGROUND

Gibson Guitar Corporation (“Gibson”) has been manufacturing expensive, high-quality guitars for over a century, and is best known for its electric models – most notably, those sold under the “Les Paul” brand. The first Les Paul was sold in 1952, and since then Gibson has offered different versions of this guitar. However, all share the original feature of a Gibson Les Paul: the solid-body, “single-cutaway” shape.¹ This produces the horn-like figure carved from the Les Paul’s body, near the protruding neck of the instrument.²



Gibson Les Paul Single-Cutaway Guitar
(dotted lines and arrow added to denote removed portion of the guitar body)

¹ *Gibson Guitar Corp. v. Paul Reed Smith Guitars*, 311 F. Supp. 2d 690, 693-94 (M.D. Tenn. 2004). The Les Paul was named after Lester Polfus, a popular musician who was also part of the guitar’s marketing pitch in the 1950s. Also, Gibson noted that during the 1960s, the company temporarily stopped selling the Les Paul. *Id.*

² *Gibson Guitar Corp. v. Paul Reed Smith Guitars*, 423 F.3d 539, 543-44 (6th Cir.), *reh’g denied* 2005 U.S. App. LEXIS 29220 (2005), *cert. denied* 2006 U.S. LEXIS 4362 (2006). The term “single-cutaway” literally derives from the portion of guitar cut out from a traditional guitar to create the horn shape. *Id.*

In addition to creating a distinctive look, this “horn” creates a new opening for hand placement, which gives musicians more flexibility to reach for higher notes. Gibson applied for and received federal trademark protection of the Les Paul’s single-cutaway “guitar body design” in 1993.³ Guitar shapes further evolved over time, with particular respect to “horns.”



LEFT: *Classic Acoustic Guitar*;⁴ MIDDLE: *Single-cutaway Guitar*;⁵ RIGHT: *Double-cutaway Guitar*⁶

Gibson eventually offered full-bodied, single-cutaway, and double-cutaway guitars.⁷ The center image pictured here, which features a single-cutaway Les Paul, represents the trademarked shape at issue.

³ *Gibson*, 311 F. Supp. 2d at 695.

⁴ Gibson Small Body “Blues King,” <http://www.gibson.com/Products/> (follow “Acoustic Guitars/Basses” hyperlink; then follow “Gibson” hyperlink; then follow “Small Bodies” hyperlink; then follow “Blues King” hyperlink).

⁵ Gibson Les Paul “Standard,” http://www.gibson.com/Products (follow “Electric Guitars/Basses” hyperlink; then follow “Gibson USA” hyperlink; then follow “Les Paul” hyperlink; then follow “Standard” hyperlink).

⁶ Gibson Les Paul “Doublecut Pro,” <http://www.gibson.com/Products/> (follow “Electric Guitars/Basses” hyperlink; then follow “Gibson USA” hyperlink; then follow “Les Paul” hyperlink; then follow “Double Cuts” hyperlink; then follow “DC Pro” hyperlink).

⁷ Gibson never owned trademark rights to the “double-cutaway” style.

Paul Reed Smith Guitars (“PRS”) first produced custom guitars in the mid-1970s, and eventually began manufacturing high-quality models. In early 2000, PRS developed its own single-cutaway guitar called the “Singlecut,” which was exhibited at a music industry trade show.⁸ The PRS Singlecut’s horn resembled that of a Gibson Les Paul in shape and appearance.

After learning of the horn similarity, Gibson sent PRS a formal letter that requested an end to the Singlecut’s production and distribution. PRS did not comply.⁹ In 2000, Gibson filed suit in a federal district court, contending (among other claims) that PRS committed trademark infringement under the Lanham Act.¹⁰ PRS responded with its own claims and counterclaims, arguing that a guitar’s horn was generic enough to merit common use. Each party requested summary judgment in its favor.

In 2004, the district court granted summary judgment to Gibson, and ordered PRS to cease production, sale, and distribution of its Singlecut guitars. PRS appealed to the Sixth Circuit on the issue of trademark infringement.

LEGAL STANDARD

Trademark Infringement under the Lanham Act

The United States Constitution provides specific protection for the owners of patents and copyrights, but not trademarks.¹¹ In 1946, Congress used its power to regulate interstate commerce by passing the Lanham Act, which was designed to prevent “consumer confusion” over the origin of a good or service. Without faith in the ability to identify the origin of goods and

⁸ *Gibson*, 311 F. Supp. 2d at 700. Because this case was decided on cross motions for summary judgment, certain unproven facts may have been construed in the light most favorable to the non-moving party. This presentation of the facts may have been generated by the court for that purpose.

⁹ *Gibson*, 423 F.3d at 544. Gibson charged PRS with several other claims that are beyond the scope of this paper. These include “counterfeiting, false designation of origin, and dilution under the Lanham Act [as well as] unfair competition, fraud, and deceptive business practices under state law.” *Id.*

¹⁰ *Id.*

¹¹ U.S. Const. art. I, § 8: “Congress shall have the power ... To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”

services, both consumers and producers in a market economy would lose; wary shoppers would make purchases reluctantly, and companies would have less incentive to innovate or maintain the highest possible quality. Thus, the Lanham Act established federal trademark protection because it is a company's mark that "actually sells the goods" and creates further consumer "desire."¹²

The Lanham Act prohibits "any reproduction, counterfeit, copy, or colorable imitation of a registered mark [if] such use is likely to cause confusion, or to cause mistake, or to deceive."¹³ To measure the "likelihood of consumer confusion" caused by marks that identify competing goods, courts consider eight separate factors, often referred to as the "*Frisch*" factors:¹⁴

1. Distinctiveness (i.e., "strength") of the plaintiff's mark,
2. Similarities in sight, sound or meaning of the two marks,
3. Relatedness of the two products,
4. Likelihood of expansion of the product line,
5. Overlap in marketing networks used by both parties,
6. Degree of purchaser care,
7. Any signs of actual confusion (including "initial interest confusion"), &
8. Intent of the defendant in selecting a similar mark.

In using this list of factors, the courts have explained that there is "no mathematical precision [for identifying trademark infringement] ... [and the factors] are simply a guide to help determine whether confusion is likely."¹⁵ Thus, the specific facts of each case must be reviewed on an individual basis, with a court determining whether a significant mix of *Frisch* factors favor the plaintiff or the defendant.¹⁶

¹² *Gibson*, 311 F. Supp. 2d at 690, 721 (citing Schechter, *The Rational Basis of Trademark Protection*, 40 Harv. L. Rev. 813, 818-819 (1927)).

¹³ 15 U.S.C. § 1114(1)(a).

¹⁴ *Gibson*, 311 F. Supp. 2d at 721. The name derives from the factors' initial use in *Frisch's Restaurant, Inc. v. Shoney's Inc.*, 759 F.2d 1261, 1264 (6th Cir. 1985).

¹⁵ *Daddy's Junky Music Stores v. Big Daddy's Family Music Ctr.*, 109 F.3d 280 (6th Cir. 1997) (quoting *Homeowners Group, Inc. v. Home Marketing Specialists, Inc.*, 931 F.2d 1100, 1104 (6th Cir. 1991)).

¹⁶ *Id.*

The following cases demonstrate that each *Frisch* factor can have a varying impact on a court's decision. These cases also make clear that – in the end – what matters is the *totality* of findings.

Application of Legal Standard in Other Cases

Mobil Oil v. Pegasus Petroleum

In the *Mobil Oil* case, the court considered all eight *Frisch* factors before delivering a verdict. Mobil alleged that Pegasus Petroleum committed trademark infringement by using the word “Pegasus” in its company name. Mobil incorporated in 1931 as a manufacturer and retailer of petroleum products. A “flying horse” symbol – “representing Pegasus, the winged horse of Greek mythology” – is widely used to represent Mobil's goods.¹⁷

Pegasus Petroleum incorporated in 1981 and focused solely on oil trading (it did not make direct sales with the general public). Pegasus' founder claimed to have selected his company's moniker based on the want “for a name with both mythical connotations and alliterative qualities.”¹⁸ Still, the company did not use the “Pegasus” word or symbol on its products.¹⁹ Upon inception, Pegasus Petroleum sent a letter to all oil companies about its existence.

In 1982, Mobil asked Pegasus Petroleum to change its name. The latter failed to comply, so Mobil sued, contending that Pegasus committed trademark infringement under the Lanham Act. After the court ruled in favor of Mobil, Pegasus appealed to the Second Circuit Court of Appeals. However, the appellate court affirmed the lower court's opinion.²⁰

The *Mobil* Majority considered all eight *Frisch* factors to determine if infringement had occurred. The court offered particularly useful insight on three factors: “strength of the mark,” “similarities in sight, sound, or meaning of the two marks,” and “likelihood of product line expansion.” These analyses help to illustrate application of the *Frisch* factors to a particular case.

¹⁷ *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 255 (2d Cir. 1987).

¹⁸ *Id.* at 256.

¹⁹ *Id.*

²⁰ *Id.*

Strength of the mark concerns the inspiration for the plaintiff's trademark. Four levels of strength are used to describe a plaintiff's mark: generic, descriptive, suggestive, or arbitrary.²¹ The strongest degree of protection applies to an arbitrary mark, which "has a significance recognized in everyday life, but the thing it normally signifies is unrelated to the product or service to which the mark is attached" (such as using an apple to signify a particular brand of computer). The weakest is a generic mark, which either was, or has become, nothing more than a common label (such as "Corner Grocery Store," "Kleenex" or "Thermos").²²

Under this inquiry, Pegasus did not challenge the opinion that Mobil's symbol was unique "without question, and perhaps without equal."²³ Thus, given Pegasus' own recognition that Mobil's trademark was strong, the district court concluded that Mobil's flying horse mark deserved "the most protection the Lanham Act can provide."²⁴

Similarities in sight, sound or meaning of the two marks examines "pronunciation, appearance, and verbal translation."²⁵ Courts view the marks separately from each other, and additionally compare the marks side-by-side. This tests the possibility that consumer will mistake one mark for the other, which suggests potential confusion. If both marks contain strikingly similar elements, that finding can be counted against the defendant.²⁶

For this inquiry, the district court held that Mobil's "symbol of the flying horse" and Pegasus Petroleum's name were "synonymous."²⁷ Though pictorial representations did not always necessarily equate, a potential consumer might confuse Mobil's symbol with Pegasus' company. Thus, the court established "that the word 'Pegasus' evokes the symbol of the flying red horse and that the flying horse is associated in the mind with Mobil."²⁸

²¹ *Daddy's Junky*, 109 F.3d at 275, 280.

²² *Id.* at 280-82.

²³ *Mobil Oil*, 818 F.2d at 257.

²⁴ *Id.*

²⁵ *Daddy's Junky*, 109 F.3d at 275, 283-84.

²⁶ *Id.*

²⁷ *Mobil Oil*, 818 F.2d at 254, 257.

²⁸ *Id.* at 259.

Likelihood of product line expansion examines whether either party plans to increase the distribution of its goods or services. If there are signs that either party plans to expand into the other's territory, then the potential for confusion could increase.²⁹

Relevant to this inquiry, no evidence could be found that Pegasus or Mobil would completely fall within each other's market territory. Mobil competed in the oil trading market, but did not use its "flying horse" symbol there.³⁰ The court did not scrutinize whether or not Mobil would expand. But even without factual proof, a "finding of likelihood of confusion" was still sufficient, because the Lanham Act protected senior users of a mark from potential restraints on market expansion.³¹

Ultimately, the court's consideration of these particular factors – combined with its equal appreciation of the remaining *Frisch* components – led to a ruling in Mobil's favor. The court found that the totality of the factors favored the plaintiff, Mobil. Thus, Pegasus was prohibited from using its name in the oil industry.³²

PACCAR v. TeleScan

In the *PACCAR* case, the court looked at all eight *Frisch* factors before issuing a verdict. *PACCAR* sued *TeleScan* for using the trademarked terms "Peterbilt" and "Kenworth" in website domain names. *PACCAR*, a manufacturer of heavy trucks and truck parts, used the website "www.paccar.com" as a locator service. *PACCAR* owned trademarks for several of its truck divisions, including "Peterbilt" and "Kenworth."³³

TeleScan also used websites as locator services. *TeleScan* created sites with generic domain names, such as "www.truckscan.com" and "www.telescanequipment.com." Those websites linked to *TeleScan*'s other

²⁹ *Daddy's Junky*, 109 F.3d at 275, 287.

³⁰ *Mobil Oil*, 818 F.2d at 254, 257.

³¹ *Id.* at 254, 259.

³² *Id.* at 254, 260.

³³ *PACCAR Inc. v. TeleScan Techs., L.L.C.*, 319 F.3d 243, 247 (6th Cir. 2003).

manufacturer-specific websites, which contained “Peterbilt” and “Kenworth” in their domain names.³⁴

In 1999, PACCAR sent a letter demanding that TeleScan stop using the trademarked terms “Peterbilt” and “Kenworth.” TeleScan rejected this request, stating that those terms were generic enough to use in TeleScan-owned domain names. PACCAR then sued, contending that TeleScan committed trademark infringement under the Lanham Act. In 2000, the district court ruled that PACCAR sufficiently showed that a likelihood of confusion existed.³⁵

TeleScan appealed to the Sixth Circuit, which affirmed the lower court’s decision. The Sixth Circuit Majority considered all eight *Frisch* factors to determine whether trademark infringement had occurred. The court offered particularly useful insight on three factors: “degree of purchaser care,” “any signs of actual confusion” (presented under the concept of “initial interest” confusion), and “defendant intent.” These analyses help provide context for application of these *Frisch* factors.

Degree of purchaser care asks whether the consumer is a sophisticated purchaser or a less knowledgeable individual. Price of the goods or services in question becomes relevant, under the assumption that sophisticated buyers would usually be associated with more expensive items, and thereby less likely to purchase a competitor’s goods by mistake.³⁶

Under this inquiry, the *PACCAR* Majority held that even sophisticated buyers could be confused by TeleScan’s websites, which contained “Peterbilt” and “Kenworth” in their domain names. Because PACCAR and TeleScan both used the same trademarked terms, then “purchaser care will decrease the likelihood of confusion only minimally.”³⁷ Further, the confusing domain names could lead even the most knowledgeable and careful purchasers to “assume that [TeleScan] is affiliated with or identical to the other party.”³⁸

³⁴ *Id.* (for instance, “www.peterbiltnewtrucks.com,” “www.peterbiltusedtrucks.com,” “www.peterbilttruckdealers.com,” “www.kenworthnewtrucks.com,” “www.kenworthusedtrucks.com,” and www.kenworthtruckdealers.com).

³⁵ *Id.* at 248-49.

³⁶ *Id.* at 253-54.

³⁷ *Id.* at 254 (quoting *Daddy’s Junky Music Stores, Inc. v. Big Daddy’s Family Music Ctr.*, 109 F.3d 275, 280 (6th Cir. 1997)).

³⁸ *Id.*

Defendant intent stipulates that if a plaintiff can prove that a defendant intended to confuse customers, then it becomes more likely that consumers really *would be* confused.³⁹

For this inquiry, the *PACCAR* Majority held that TeleScan's intent could not be proven, but could still be inferred in two ways. First, TeleScan knew that "Peterbilt" and "Kenworth" were trademarks associated with PACCAR; thus, TeleScan intentionally used those trademarks in its website domain names to make customer searches easier. Second, the way TeleScan used PACCAR's trademarked terms on websites – such as "mimicking the distinctive scripts of the marks" – reflected TeleScan's goal of making its websites appear "sponsored by or affiliated with PACCAR."⁴⁰

Any signs of actual confusion help by identifying whether any consumer experienced confusion at the point-of-sale. Positive evidence creates the strongest proof, but absent this element, the plaintiff can prove a "likelihood of confusion" in another way.⁴¹ "Initial interest" confusion occurs when a consumer, before making a purchase, is misled about a product's origin or producer. Even if a customer later realizes the true nature of a mistaken product, harm might have already occurred by generating that initial interest.⁴²

Relevant to this inquiry, the *PACCAR* Majority held that the nature of the Internet increased the likelihood of consumer confusion. Because "entering a website takes little effort," Internet users are likely to be confused about the ownership of a website.⁴³ The court also held that misleading domain names can "misdirect consumers as they search for web sites associated with the owner of a trademark."⁴⁴ It did not matter that TeleScan's websites contained disclaimers stating non-affiliation with PACCAR; by the time consumers saw these disclaimers, "initial interest" confusion already occurred, by way of typing in or selecting TeleScan's domain names.⁴⁵

³⁹ *Mobil Oil*, 818 F.2d at 258-59.

⁴⁰ *PACCAR*, 319 F.3d at 254.

⁴¹ *Gibson*, 311 F. Supp. 2d at 723.

⁴² *PACCAR*, 319 F.3d at 253.

⁴³ *Id.* at 252 (quoting *Brookfield Commc'ns, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1057 (9th Cir. 1999)).

⁴⁴ *Id.* at 253.

⁴⁵ *Id.*

Ultimately, the court's consideration of these particular factors – combined with its appreciation of the remaining *Frisch* components – led to a ruling in PACCAR's favor. The court found that the totality of the factors favored the plaintiff, PACCAR. Thus, TeleScan was prohibited from using "Peterbilt" and "Kenworth" in the domain names of its websites.⁴⁶

Daddy's Junky Music Stores v. Big Daddy's Family Music Center

In the *Daddy's Junky* case, the court once again looked at all eight *Frisch* factors before issuing a verdict. Daddy's Junky sued over the use of "Daddy" in another store's name. Based in the Northeast, Daddy's Junky sold new and used musical instruments and equipment. Daddy's Junky also distributed mail order catalogs to customers. Since 1975, Daddy's Junky held the trademarks "Daddy's Junky Music Stores" and "Daddy's" for retail music and instruments.⁴⁷

Big Daddy's Family Music Center had operated in Delaware, Ohio since 1993. The store moniker was based on the owner's nickname. Big Daddy's also sold musical instruments and equipment. Big Daddy's did not have a formal mail order program, but did send out catalogs within its business area and market itself by holding events there.⁴⁸

In 1995, Daddy's Junky sued Big Daddy's for trademark infringement. The district court concluded that Big Daddy's name created no likelihood of confusion; however, the Sixth Circuit reversed this finding on appeal.⁴⁹ Again the Sixth Circuit Majority considered all eight *Frisch* factors, this time providing particularly useful insight on the remaining factors: "relatedness of the two products" and "use of similar marketing networks."

Relatedness of the two products considers the similarities between the goods or services offered by the plaintiff and the defendant. If both parties compete directly, or if the products seem indistinguishable, then the possibility of consumer confusion increases.⁵⁰

⁴⁶ *Id.* at 258.

⁴⁷ *Daddy's Junky*, 109 F.3d at 278-79.

⁴⁸ *Id.* at 279.

⁴⁹ *Id.* at 278.

⁵⁰ *Id.* at 282-83.

Under this inquiry, the court held that the likelihood of confusion increased because both parties sold musical instruments. Additionally, both Daddy's Junky and Big Daddy's placed emphasis on their electrical instruments. The court therefore reasoned that customers could fulfill the same needs by purchasing from either retailer, which increased potential confusion.⁵¹

Use of similar marketing networks concerns the markets that both parties use to distribute their goods or services. If both parties compete with each other in the same marketplace, the chance of confusion is higher.⁵²

For this inquiry, the *Daddy's Junky* Court felt that the parties' marketing channels were comparable, because some mailings (which contained similar products) reached the same residents. Though unknown as to how many people actually received advertisements from both parties, the court found that 381 Ohio residents who received Daddy's Junky catalogs lived within 30 miles of Big Daddy's store, and could be receiving the local Big Daddy's advertisements as well.⁵³

Ultimately, the court's consideration of these particular factors – combined with its appreciation of the remaining *Frisch* components – led to a ruling in favor of Daddy's Junky. The court found that the totality of the factors favored the plaintiff, Daddy's Junky, and remanded the case to the lower court.⁵⁴

APPLICATION OF THE LEGAL STANDARD IN *GIBSON*

District Court Opinion

A return to *Gibson v. PRS* first requires discussion of the initial district court ruling. Gibson had sued PRS for infringing the trademarked design of its single-cutaway guitar, the Gibson Les Paul. After deliberating on *all eight Frisch* factors, Judge Haynes, Jr., of the district court ruled in Gibson's favor.⁵⁵

⁵¹ *Id.* at 283.

⁵² *PACCAR*, 319 F.3d at 252-53.

⁵³ *Daddy's Junky*, 109 F.3d at 285.

⁵⁴ *Id.* at 288.

⁵⁵ *Gibson*, 311 F. Supp. 2d at 725.

(i) Strength of the mark

Judge Haynes determined that the strength of the Les Paul trademark was incontestable.⁵⁶ The guitar shape was considered a “classic,” and thus unique only to Gibson.⁵⁷ Due to widespread recognition of the Les Paul throughout the guitar industry, Judge Haynes concluded that Gibson’s trademark (i.e., the shape of the guitar) was “worthy of full protection.”⁵⁸

(ii) Relatedness of the two products

Judge Haynes also noted that Gibson and PRS were “direct and primary competitors in the high price electric guitar market.”⁵⁹ Both the Les Paul and PRS Singlecut were expensive, high quality guitars, and due to their similarities in appearance and design, Judge Haynes held that the goods could “be connected [and confused] in the mind of a prospective purchaser.”⁶⁰

(iii) Similarities in sight, sound and meaning; and

(iv) Degree of purchaser care

Judge Haynes grouped these factors together, because for this particular case, they intertwined. Judge Haynes ruled that the Gibson Les Paul and PRS Singlecut were “strikingly similar” in appearance: the displays, the horn shapes, the configuration of knob features, and use of “the effect of a sunburst color” made the products very comparable. Thus, the guitars could be viewed as confusing to the public – even sophisticated consumers.⁶¹

(v) Evidence of actual confusion

No satisfactory evidence of actual consumer confusion at the point-of-sale had been provided. However, based upon the Les Paul’s wide recognition within the guitar industry, and the fact that both Gibson and PRS competed in the same market, Judge Haynes determined that “initial interest” confusion (i.e., consumers approaching a PRS guitar by mistake) was highly likely.⁶²

⁵⁶ The doctrine of trademark “incontestability” is beyond the scope of this article.

⁵⁷ *Gibson*, 311 F. Supp. 2d at 722.

⁵⁸ *Id.*

⁵⁹ *Id.*

⁶⁰ *Id.*

⁶¹ *Id.*

⁶² *Id.* at 723-24.

(vi) Use of similar marketing networks

Judge Haynes repeated that Gibson and PRS competed in the market of high price guitars. Because both parties “distribut[ed] their goods through the same type of retailers,” Gibson and PRS therefore used similar “marketing approaches.”⁶³

(vii) Defendant’s intent

Gibson did not prove to Judge Haynes’ satisfaction that PRS actually intended to infringe on a trademark, but did find that due to Gibson’s widespread popularity and recognition in the guitar community, PRS must have at least known that the Singlecut was similar to the Les Paul. Meeting notes also offered into evidence also showed that PRS aimed to compete directly with Gibson by offering a single-cutaway shape for guitars, which had been previously absent in the existing PRS product line.⁶⁴

(viii) Likelihood of product line expansion

Judge Haynes also took note of PRS’ plans to expand its single-cutaway line with cheaper models. This would enhance PRS’ method of competing, and “would contribute further to the confusion between PRS’ Singlecut and Gibson’s Les Paul products in the marketplace.”⁶⁵

After determining that all of the *Frisch* factors favored Gibson’s position, Judge Haynes concluded that consumers were likely to be confused about the actual source of the PRS Singlecut guitar. Therefore, the court granted Gibson’s motion for summary judgment, finding that the PRS Singlecut infringed on Gibson’s trademarked guitar shape.⁶⁶

Appellate Court Decision

On appeal, the Sixth Circuit found two major flaws in the district court’s opinion. First, the court determined that Gibson’s trademark only protected the general shape of the Les Paul, not guitar embellishments like the

⁶³ *Id.* at 724.

⁶⁴ *Id.*

⁶⁵ *Id.* at 724-25.

⁶⁶ *Id.* at 725.

knobs and body color.⁶⁷ This holding dispelled Judge Haynes' finding that the intertwined "similarity in sight" and "degree of purchaser care" factors cut in Gibson's favor.

Secondly, the court viewed "actual confusion" (and its subcomponent of "initial interest confusion") as *the* decisive factor in the case. The Sixth Circuit agreed with the district court's finding that actual confusion had not been proven, placing greater emphasis on Gibson's own admission that truly "sophisticated purchasers" would never be confused between Gibson Les Paul and PRS Singlecut guitars.⁶⁸ Then the Sixth Circuit went a step further, holding that in the absence of actual confusion, "initial interest" confusion did *not* automatically suffice to tip this factor in Gibson's favor.

The Sixth Circuit did not favor the concept of initial interest confusion in general, because doing so might create a slippery slope: trademark holders – if permitted to sue any competitor whose products draw attention – would try to protect generic shapes, which would unfairly keep competitors out of the marketplace. Many instrument shapes have a similar look, which in the court's view could give these shapes a generic quality less deserving of trademark protection.⁶⁹ Therefore, the Sixth Circuit reversed the district court decision, and ruled in favor of PRS.⁷⁰

Judge Kennedy dissented on the issue of initial interest confusion. Although agreeing that the district court failed to correctly apply the *Frisch* factors, he disagreed with how the majority interpreted "actual confusion." Judge Kennedy argued that a plaintiff should be able to present substantial evidence about a product's shape in order to prove initial interest confusion, because shapes *are* protected under the Lanham Act.⁷¹ Judge Kennedy agreed that Gibson needed to prove that confusion occurred from some specific vantage point; however, Gibson had never been given this chance to prove that from a certain distance, its Les Paul appeared unique and noticeable among other guitars, and that a similar PRS design could create consumer confusion.⁷²

⁶⁷ *Gibson*, 423 F.3d at 546-47.

⁶⁸ *Id.* at 549.

⁶⁹ *Id.* at 548-52.

⁷⁰ *Id.* at 553.

⁷¹ *Id.* at 553-56 (Kennedy, J., dissenting).

⁷² *Id.*

ANALYSIS

The Sixth Circuit ruling in *Gibson* contained two major errors. First, the court misinterpreted the concept of “initial interest confusion.” Second, the court failed to properly test all eight *Frisch* factors. These missteps show that the Sixth Circuit should have analyzed the *Gibson* case more thoroughly. More importantly, these missteps demonstrate why courts cannot forego any part of the legal standard when deciding trademark infringement cases.

The Sixth Circuit did appropriately correct one aspect of the lower court’s decision. Judge Haynes mistakenly considered all elements of the guitar’s appearance when deciding on trademark infringement, but only the actual *shape* of the Gibson Les Paul was a protected trademark. However, the Sixth Circuit constricted its analysis to focus solely on a separate factor – namely, “actual confusion.” To award this factor (and summarily, the case) in PRS’ favor, the court cited Gibson’s confession that no point-of-sale confusion had actually occurred – an honest yet inadvertently detrimental admission.⁷³

The *Gibson* Majority prematurely dismissed the remaining factors: “We disagree with several of the district court’s conclusions on the individual *Frisch* factors. However, as these remaining factors are not relevant to our disposition of this case, we need not discuss them separately.”⁷⁴ The majority erred here because each *Frisch* factor was meant to be viewed as part of a greater whole – and no factor was meant to be individually superior to any other. As stated in *Daddy’s Junky*, “When determining whether a likelihood of confusion exists, a court must examine and weigh the ... eight factors ... [because] they are interrelated in effect.”⁷⁵

The following analysis will reveal that select factors had the potential to significantly contribute to the *Gibson* case, and that the Sixth Circuit should have adhered to a holistic consideration of all eight *Frisch* factors. After seeing how certain factors contribute important elements to the overall evaluation of the case, it becomes evident that “totality” should always be at the forefront of any thorough *Frisch* analysis. Further, a view as to how the *Gibson* Majority questionably interpreted the “decisive” factor for this case further demonstrates why courts should *not* rely on a sole *Frisch* component to reach a decision.

⁷³ *Id* at 549 (majority opinion).

⁷⁴ *Id.*

⁷⁵ *Daddy’s Junky*, 109 F.3d at 280.

Similarities in Sight, Sound or Meaning

This *Frisch* factor looks at the aesthetic view of both guitars, because the overall impression is an extremely important issue.⁷⁶ In the district court opinion, Judge Haynes compared every knob and musical attribute of the guitars, but he should have only considered how much the Gibson Les Paul and PRS Singlecut *body shapes* looked alike.



LEFT: *Gibson Les Paul*; RIGHT: *PRS Singlecut*

At first glance, a general view of the guitars reveals convincing similarities in the placement and body shape of each guitar’s “horn.” Further, the rest of each guitar remained full-bodied, which essentially left the Les Paul and Singlecut with similar silhouettes. Thus, because the “look” of these guitars presented important issues relevant to the *Gibson* case, the Sixth Circuit should have given some consideration to this factor. It was not fair to Gibson that “similarities in sight” went ignored, given that the legal standard instructs courts to look at the totality of the *Frisch* factors.

⁷⁶ *Mobil Oil*, 818 F.2d at 257.

Degree of Purchaser Care

This factor examined the type of consumers targeted by Gibson and PRS. As previously explained in the *PACCAR* case:

When a buyer has expertise or is otherwise more sophisticated with respect to the purchase of the services at issue, a higher standard is proper. Similarly, when services are expensive or unusual, the buyer can be expected to exercise greater care in her purchases. When services are sold to such buyers, other things being equal, there is less likelihood of confusion.⁷⁷

In *Gibson*, both parties reached out to guitarists with products priced into the thousands of dollars. Gibson admitted that its clientele was “sophisticated” – guitar enthusiasts would never, at the point-of-sale, confuse the PRS and Gibson single-cutaways.⁷⁸ Further, Gibson’s Les Paul was better known worldwide by guitar enthusiasts; from television to rock concerts, when guitar musicians saw the single-cutaway style, most automatically thought of the Gibson Les Paul. At this point, had the Sixth Circuit applied this factor of “purchaser care,” the court might have ruled in PRS’s favor. If Gibson customers were really impervious to deceit, then this reduced likelihood of confusion would hurt Gibson’s lawsuit.

However, the *Daddy’s* case introduced an important cross-component to the analysis of this factor: the relevance of consumer sophistication varies along with the degree of similarity between the products. In other words, if the products are clearly distinct, the sophisticated consumer is quite likely to notice the difference early on. However, if the products are quite similar, the sophistication of consumers is less likely to impact the likelihood of confusion. Thus, in essence, this factor must be considered hand-in-hand with the “relatedness of goods” factor.⁷⁹ This point is equally relevant to the *Gibson* case, because even highly knowledgeable musicians could still make incorrect initial assumptions as to who manufactured a certain guitar if the guitars are quite similar. Thus, the Sixth Circuit should have either given more thorough consideration to this *Frisch* factor, or explained (for the benefit of future courts) that it had already done so and found sophistication less relevant for this reason.

⁷⁷ *PACCAR*, 319 F.3d at 253.

⁷⁸ *Gibson*, 423 F.3d at 549.

⁷⁹ *Daddy’s Junky*, 109 F.3d at 286.

Defendant's Intent

The *Mobil* case emphasized that “intentional copying [of another producer’s mark] gives rise to a presumption of a likelihood of confusion.”⁸⁰ Two levels of intent need to be recognized: “direct” and “indirect.” No evidence proved that PRS directly intended to exploit Gibson’s trademarked shape for competitive advantage. However, the district court ruled that due to Gibson’s popularity in the guitar community, another guitar manufacturer like PRS “should have known” about the Les Paul single cutaway. Although the Les Paul was officially trademarked only a decade before, that guitar’s single-cutaway shape had been utilized for over half a century.⁸¹

The *Mobil* Majority also noted that “decisions have recognized that the second comer has a duty to so name and dress his product as to avoid all likelihood of consumers confusing it with the product of the first comer.”⁸² There was indirect evidence that PRS “rode the coattails” of the Les Paul trademark, because PRS constantly referenced Gibson and its single-cutaway guitar line during quarterly meeting sessions.⁸³ PRS intended to create only minor internal and external differences in its Singlecut, which would leave the Les Paul’s overall design concept intact.⁸⁴ As established in *Mobil*, it was the defendant’s duty to avoid any confusion. Thus, because “intent” presented important issues relevant to the *Gibson* case, the Sixth Circuit should have given more careful consideration to this factor. The legal standard instructs courts to look at the totality of the *Frisch* factors, and this one was important.

Actual Confusion

The potential evidence showing “actual” confusion by consumers was the most controversial factor in the *Gibson* case. The district court originally discussed an important sub-factor, “initial interest confusion,” which refers to confusion at first sight of the product, *rather than* at the point of purchase. The

⁸⁰ *Mobil Oil*, 818 F.2d at 258.

⁸¹ *Gibson*, 311 F. Supp. 2d at 698.

⁸² *Mobil Oil*, 818 F.2d at 259 (quoting *Harold F. Ritchie Inc. v. Chesebrough-Pond’s, Inc.*, 281 F.2d 755, 758 (2d Cir. 1960)).

⁸³ *Gibson*, 311 F. Supp. 2d at 704.

⁸⁴ *Id.* at 704-07.

Sixth Circuit ruled that the existence of any “initial” interest or product confusion over similarly shaped guitars was neither applicable to Gibson’s Les Paul, nor other instruments in general, since instrument shapes were inherently generic. Further, the Sixth Circuit concluded that granting Gibson’s “initial interest” argument would create a slippery slope for future cases: shapes of future instruments would be limited, and dominance would be enjoyed by companies that secured their trademarks to certain shapes first.⁸⁵

The Gibson Majority’s view on “initial interest confusion” differed from those provided in the *PACCAR* and *Mobil* cases. The *PACCAR* Court ruled on initial interest confusion against TeleScan, finding that TeleScan fooled consumers into believing that they traveled to a website owned by or affiliated with PACCAR.⁸⁶ The *PACCAR* Majority defined initial interest confusion as “such confusion, which is actionable under the Lanham Act ... when a consumer is lured to a product by its similarity to a known mark, even though the consumer realizes the true identity and origin of the product before consummating a purchase.”⁸⁷ The *Mobil* Court also used initial interest confusion against Pegasus Petroleum, finding that Pegasus might have attracted customers who wrongly assumed it to have a business affiliation with Mobil.⁸⁸ The *Mobil* Majority held that initial interest confusion was found “not in the fact that a third party would do business with Pegasus Petroleum believing it related to Mobil, but rather in the likelihood that Pegasus Petroleum would gain crucial credibility during the initial phases of a deal.”⁸⁹

Although Gibson conceded that consumers probably did not *purchase* PRS guitars under the mistaken belief that they were Gibson guitars, the possibility for “*initial* interest” confusion is one of the many factors relevant to a trademark infringement analysis, and the Sixth Circuit should have treated it as such. If it is possible that a web user might “initially” arrive at the wrong website due to confusingly similar domain names, it is also possible that a guitar shopper might “initially” approach a PRS Singlecut because of its confusing similarities to a Gibson Les Paul.

⁸⁵ *Gibson*, 423 F.3d at 550-52. In his dissent, Judge Kennedy pointed out that a shape *can* be protected under the Lanham Act under the current interpretation of that law.

⁸⁶ *PACCAR*, 319 F.3d at 253.

⁸⁷ *Id.*

⁸⁸ *Mobil Oil*, 818 F.2d at 259.

⁸⁹ *Id.*

Even if this initial confusion lasted no more than a moment, confusion *still existed* as an “initial” matter. The Gibson Majority should not have singled out the *Frisch* factor of “actual confusion” to rule in either party’s favor; instead, the court should have viewed the potential for “initial interest confusion” as *part of the mix* of relevant factors, because it presented important concerns relevant to the *Gibson* case.

Totality of the FRISCH Factors

The Sixth Circuit admittedly relied on its disagreement with the relevance of “initial interest confusion” to decide the *Gibson* case, but this subcomponent of the “actual confusion” factor cannot serve as the only dispositive element from a test that contains seven other (and equally-important) *Frisch* factors. In a recent law journal article, Yas Raouf puts this point in perspective:

Initial interest or initial confusion comprises only one factor in evaluating confusion. The idea that initial confusion dissipates and only threatens credibility transference, or never exists but in the form of distraction, does not warrant a doctrine separate from and superior to traditional infringement analysis.⁹⁰

Raouf’s point is particularly valid for the *Gibson* case. Although the district court misapplied one of the *Frisch* factors, that error pales in comparison to the Sixth Circuit’s failure to address seven out of the eight *Frisch* factors. Simply inserting a footnote stating that “a small disagreement may have been present”⁹¹ over the other factors is not a valid excuse to skip over important points that relate to the totality of the circumstances. Further, presenting a decision that read as if PRS won by “default” did *not* reflect the spirit of the *Frisch* factors, nor did it accurately reflect the seriousness of trademark infringement cases.

In the end, Gibson could have presented a strong case against PRS. If the Sixth Circuit considered other factors in addition to “actual confusion,” the court might have determined that a potential likelihood of confusion *did* exist.

⁹⁰ Yas Raouf, *Intellectual Property: Trademark: Note: Lamparello v. Falwell & Bosley Medical v. Kremer: Undercutting the Applicability of Initial Interest Confusion to Trademark-In-Domain-Name Gripe Sites*, 21 Berkeley Tech. L.J. 445 (2006).

⁹¹ *Id.*

However, this reasoning equally applies in the opposite direction. If the Sixth Circuit considered other factors in addition to “actual confusion,” the court might have determined that a potential likelihood of confusion *did not* exist; this would have resulted in PRS making a stronger case against Gibson. The point is, had the Sixth Circuit simply utilized the entire legal standard before reaching a conclusion, then the court’s present decision would not be open to second-guessing and criticism. Regardless of the court’s verdict, the final outcome in *Gibson* would at least be tenable, which is ultimately the best goal that courts can achieve when hearing trademark infringement cases.

The purpose of using all eight *Frisch* factors is to navigate unique cases like *Gibson*, which offer no set formula for reaching a decision, yet deserve thoughtful consideration of unique factual scenarios. Taken holistically, the *Frisch* factors provide a blueprint for identifying an amorphous concept, which cannot be directly proven, known as the “likelihood of consumer confusion.” However, the Sixth Circuit did not use this approach based on a totality of the circumstances; instead, that court relied upon only one limited factor to resolve its case. Consequently, the court’s incomplete implementation of the multi-factored *Frisch* test set a poor standard for future courts and rendered the *Gibson* outcome subject to debate, yielding more reasonable questions than convincing answers.

CONCLUSION

This article took an extensive look at the *Gibson* case. First, the history of the dispute between Gibson and PRS was presented, along with background facts about the respective guitar features. The Lanham Act and eight *Frisch* factors were also introduced to illustrate the traditional application of trademark infringement law. Three unique cases highlighted different applications of certain *Frisch* components, with each case demonstrating the importance of considering the “totality of factors” above any one factor in particular. Returning to the *Gibson* case to apply this standard, analysis of the Sixth Circuit’s ruling revealed problems with the court’s sole emphasis on a specific *Frisch* factor and subsequent misapplication of the prevailing legal standard.

The *Gibson* Majority narrowly construed the Lanham Act and ignored the totality of the factors within the prevailing legal standard. The appellate court’s questionable interpretation of initial interest confusion, combined with its failure to address seven out of the eight *Frisch* components, suggests that the

court should have gone through the entire factor-by-factor process to produce a more satisfactory decision. Trademark infringement analysis, although inherently subjective in its application, needs an overarching set of guidelines in order to function properly. If courts abandon the eight-factor test, and instead issue verdicts without foundation or precedent, then few rulings would convincingly address the “consumer confusion” issue that the Lanham Act originally intended to dissipate.

The eight-factor *Frisch* test was created for holistic use rather than partial, arbitrary application. Although there might be room for evolution in the legal standard (given the dynamic nature of business and the goods and services offered to the public), courts should respect established precedent and work with the *Frisch* factors as a whole. Otherwise, newcomers to the marketplace might find the courage to put apple icons or three-stripe designs on their own products, taking advantage of the reputation for quality earned by the original producers of those goods. People who don’t use iPods or wear Adidas might not initially care. But if trademark protection continues to disappear, those same people will undoubtedly care if they “consume” the wrong product. Better to follow the *Frisch* factors than deal with the duped.