

Charlie Jones, Jeff Becker, and Abby Ryan in World Trademark Review

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A longstanding circuit split could be resolved if the U.S. Supreme Court accepts certiorari in a case that hinges on the initial interest confusion doctrine. In this guest analysis, Haynes Boone Partners Charlie Jones and Jeffrey Becker and Associate Abby Ryan explain why a Supreme Court ruling could have significant implications for enforcement strategies.

Guest Analysis

A recently filed petition for writ of certiorari with the US Supreme Court highlights a dramatic split among the circuit courts. Mattress company Dires LLC filed the petition seeking clarification on one of trademark law's fringe but often determinative doctrines – initial interest confusion – and asked the court to draw a bright line where none currently exists (*Dires LLC v. Select Comfort Corporation*, petition for certiorari pending, 21-212 (filed 11 August 2021)). In fact, three circuits – the First, Fourth and Eleventh – have refused to adopt this judicially created doctrine.

Initial Interest Confusion and its Limits

Initial interest confusion is a pro-trademark owner doctrine used to impose trademark infringement liability even when consumers know that they are not buying from the legitimate trademark owner. Just as the name suggests, a defendant may be found liable if the trademark owner can merely prove that a consumer is 'initially' confused when they first see the mark, even though such initial confusion does not last up to the time of an actual sale.

Traditionally, the doctrine was used to prohibit competitors from passing off their services as those of a trademark owner in order to lure potential clients. Initial interest confusion was thus typically viewed as a 'bait and switch' tactic that allowed a "competitor to 'get a foot in the door' by confusing customers" (*Syndicate Sales v. Hampshire Paper*, 192 F.3d 633, 638 (7th Cir. 1999)).

The Sixth Circuit described it as follows:

Suppose that you are taking a long road trip, you have become very hungry, and you are keeping an eye out for a McDonald's, which is your fastfood restaurant of choice. Soon you spot a 'McDonald's' sign by an exit. You take the exit and follow the signs, looking forward to your favorite McDonald's hamburger. But – behold – it's a Burger King. The signs were misleading. You are not so fond of Burger King but, having already made the detour and loath to waste even more time, you reluctantly buy a Whopper and get on with your trip. (Groeneveld Transp Efficiency v. Lubecore International, 730 F.3d 494, 518 (6th Cir. 2013).)

Like any legal doctrine, initial interest confusion has its limits. To prevail on an initial interest confusion claim, the trademark owner must first be able to prove that actual confusion – rather than a risk of confusion – initially existed. In some circuits, the trademark owner must also show that the competitor financially profited from use of its mark.

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