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# JUDICIAL SPECULATION ON CONSUMER IMPRESSION: THE PITFALLS OF MEASURING TRADEMARK TACKING AS A QUESTION OF LAW

*Megan Majcher Hartnett*<sup>+</sup>

Legal issues can arise in the courtroom from infinite variations of factual circumstances. Convoluted sets of facts applied to existing law exacerbates a court's struggle to resolve legal issues. It is even more difficult for the court to ascertain what is fact and what is law. As part of the judicial process, during a jury trial the judge determines legal issues and is expected to keep factual determinations to a minimum. However, judges often assume the burden of sorting out the facts even when they should not. This issue impacts all aspects of the legal profession, but it can be particularly relevant in trademark law.

"Tacking" is the further use of a trademark (or mark)<sup>1</sup> when the old mark has been altered and the owner continues to use the mark in its new form.<sup>2</sup> Trademark law permits mark owners to tack only in certain circumstances.<sup>3</sup> The proper test for determining when tacking should be permitted is whether the new mark is a legal equivalent of the old mark.<sup>4</sup> The court will assess the continuous commercial impression of the mark to determine legal equivalency.<sup>5</sup> Courts often disagree about whether a continuous commercial impression, specifically whether the mark has been substantially altered, is an issue of fact or an issue of law.<sup>6</sup>

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1. 15 U.S.C. § 1127 (2012) (defining "[t]he term 'mark' [to] include[] any trademark, service mark, collective mark, or certification mark").

2. See *Brookfield Commc'ns, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1048 (9th Cir. 1999) (noting that the mark's author joins the earlier use of the mark and the later use of the mark by "tacking" them together).

3. See *id.* (labeling the standard for tacking as "exceedingly strict").

4. *Louangel, Inc. v. Darden Rests., Inc.*, 106 U.S.P.Q.2d (BNA) 1809, 1812 (S.D. Tex. 2013). In cases where tacking is allowed, "[m]inor differences between marks, such as an inconsequential modification or modernization, would serve as a basis for tacking, because a consumer would consider the marks the same." *Specht v. Google Inc.*, 758 F. Supp. 2d 570, 583 (N.D. Ill. 2010).

5. *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 1159 (Fed. Cir. 1991) (quoting *Ilco Corp. v. Ideal Sec. Hardware Corp.*, 527 F.2d 1221, 1224 (C.C.P.A. 1976)); see also *Louangel*, 106 U.S.P.Q.2d (BNA) at 1813 (noting that "the marks must be quite similar and convey the same *impression to the consumer*" (emphasis added)).

6. *Louangel*, 106 U.S.P.Q.2d (BNA) at 1812 (stating that there is a circuit split regarding the issue, with the Ninth Circuit considering it a question of fact, whereas both the Federal Circuit and

Businesses market their trademarks to large audiences, and so a mark's commercial impressions can be varied and diverse.<sup>7</sup> Trademarks, and advertisements generally, help the viewer identify the source of a corresponding good or service.<sup>8</sup> Viewers may respond differently to the same visual stimulus depending on the viewer's unique circumstance.<sup>9</sup> Consequently, the courts need to employ a legal standard that identifies a trademark's commercial impression using a fact-based inquiry that recognizes these intricacies.<sup>10</sup>

Trademark status protects "any word, name, symbol . . . or any combination thereof" that is intended to identify the source of a good or service.<sup>11</sup>

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the Sixth Circuit consider it a question of law). Additionally, courts have viewed the tacking test as a question of fact, law, or a mixed question of both if the commercial impression of a mark has substantially been altered. *Id.*; Gideon Mark & Jacob Jacoby, *Continuing Commercial Impression: Applications and Measurement*, 10 MARQ. INTELL. PROP. L. REV. 433, 448–49 (2006) (positing that tacking is really a mixed question of law and fact).

7. See Mark & Jacoby, *supra* note 6, at 434–35. Commercial impression of a trademark is essentially the message the mark relays to the viewer and how that person reacts to that message. *Id.* Considering the numerous viewers of those marks, individual interpretation or commercial impression can vary from one viewer to another. *Id.* Additionally:

Trademarks contribute to economic efficiency by reducing consumer search costs. A consumer can look to trademarks as shorthand indicators of quality, prestige, or product attributes. Producers benefit because they can invest in building goodwill with the confidence that others will not appropriate it. Consumers benefit because trademarks relieve the burden of having to do exhaustive research about a product's features. While marketers do not speak of trademarks *per se*, they attribute these same functions to brands. Indeed, trademarks are essentially what marketers refer to as branding elements, the most salient being the brand name.

Robert C. Bird & Joel H. Steckel, *The Role of Consumer Surveys in Trademark Infringement: Empirical Evidence from the Federal Courts*, 14 U. PA. J. BUS. L. 1013, 1019–20 (2012) (footnotes omitted).

8. See BERND SCHMITT & ALEX SIMONSON, *MARKETING AESTHETICS* 85 (1997) (explaining the function of differing style choices for marketers, in that images "create brand awareness; they cause intellectual and emotional associations. They differentiate products and services; they help consumers categorize products and services as being related").

9. See, e.g., RAY CROZIER, *MANUFACTURED PLEASURES: PSYCHOLOGICAL RESPONSES TO DESIGN* 68–69 (1994) (explaining that generational differences may be the reason for differing reactions to images).

10. See MARCEL DANESI, *WHY IT SELLS: DECODING THE MEANINGS OF BRAND NAMES, LOGOS, ADS, AND OTHER MARKETING AND ADVERTISING PLOYS* 77 (2008) (stating how German philosopher Ernst Cassirer explained that humans are "a symbolic species—a species that responds to symbolism emotionally, aesthetically, and intellectually").

11. 15 U.S.C. § 1127 (2012). Under federal law a trademark:

[I]ncludes any word, name, symbol, or device, or any combination thereof—(1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

*Id.* Some trademarks may be more successful depending on how they tap into the "psychological function of symbols" as the purpose of trademarks depend on visual and aural cues, or, essentially, "a merchandising short-cut which induces a purchaser to select what he wants, or what he has been led to believe he wants." Elizabeth Cutter Bannon, *Revisiting "The Rational Basis of Trademark*

Trademarks are, by nature, visual or aural signals that prompt consumers to identify the source of products and services.<sup>12</sup> Marks range from simple designs to more artistic images.<sup>13</sup> The strength of trademark protection may correlate with both the complexity of the design and the leap consumers make to associate the mark with a good or service.<sup>14</sup>

Tacking is used to further the life of the trademark when the mark has been altered slightly.<sup>15</sup> Trademark law permits owners to modify their marks in response to changes in the marketplace.<sup>16</sup> Businesses often alter their marks to more accurately represent consumers' market preferences and general style trends.<sup>17</sup> Because trademark protection is derived from distinctive use in the

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*Protection: "Control of Quality and Dilution-Estranged Bedfellows?",* 24 J. MARSHALL L. REV. 65, 88 n.194 (1990) (quoting *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942)) (internal quotation marks omitted).

12. 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3:1 (4th ed. 2013). Sound marks have been established as legitimate trademarks, but "sound marks must be inherently distinctive or have acquired distinctiveness to be registered." Melissa E. Roth, *Something Old, Something New, Something Borrowed, Something Blue: A New Tradition in Nontraditional Trademark Registrations*, 27 CARDOZO L. REV. 457, 485 (2005). Well-known examples of sounds marks are the NBC chimes or the Metro-Goldwyn-Mayer lion's roar. *Id.* Trademarks may also extend to the trade dress of a brand, a "term [that] has grown to include the shape and appearance of a product as well as that of all the elements making up the total visual image by which the product is presented to consumers." See SCHMITT & SIMONSON, *supra* note 8, at 223.

13. *Quiksilver, Inc. v. Kymsta Corp.*, 466 F.3d 749, 760 (9th Cir. 2006) (noting the spectrum of marks). Specifically, the Ninth Circuit placed trademarks into five categories:

"(1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; and (5) fanciful." At one end of the spectrum, generic marks "give the general name of the product; they embrace an entire class of products." "Generic marks are not capable of receiving protection because they identify the product, rather than the product's source." At the other end of the spectrum, suggestive, arbitrary, and fanciful marks are "deemed inherently distinctive and are automatically entitled to protection because they naturally serve to identify a particular source of a product."

*Id.* (quoting *Yellow Cab Co. of Sacramento v. Yellow Cab of Elk Grove, Inc.*, 419 F.3d 925, 927 (9th Cir. 2005)).

14. See *id.* (discussing the relationship between the classification of a mark and the protection that classification affords the mark).

15. 3 MCCARTHY, *supra* note 12, § 17:26, at 17-63 to -64.

16. See SCHMITT & SIMONSON, *supra* note 8, at 110-11 (discussing the influence of customer feedback on a company's style). Often advertisers will rely on updates to their "look" in order to attract the attention of a waning consumer base. CROZIER, *supra* note 9, at 67-68 (suggesting that fashion designers alter their signature styles to adapt to changing times). The more radical the change, the more likely the design will stand apart from others in the marketplace, and therefore a higher likelihood exists that the design will grab consumer attention. See SCHMITT & SIMONSON, *supra* note 8, at 110-11.

17. See *Mark & Jacoby*, *supra* note 6, at 435 (citing Betty Crocker's image as an example of long-term, relatively frequent tacking). General Mills created the character of Betty Crocker in 1921 and, due to popularity in the fictional character, they decided to depict her likeness. *The History of Betty Crocker*, GEN. MILLS, [http://generalmills.com/-/media/Files/history/hist\\_betty.ashx](http://generalmills.com/-/media/Files/history/hist_betty.ashx) (last visited Aug. 14, 2014). Since 1936, when Betty Crocker's image first debuted, the

marketplace, protection is potentially endless.<sup>18</sup> If trademark law prohibited a mark's owner from updating the image to adapt to popular aesthetic developments, the mark could become stagnant.<sup>19</sup> Once this occurs, an owner may be forced to create a new mark and abandon the old mark, which will result in the owner losing trademark law's continued protection.<sup>20</sup> Additionally, by allowing a mark's owner to continue using an existing mark, the trademark remains protected "from appropriation by competitors and thus furthers the trademark law's objective of reducing the costs that customers incur in shopping and making purchasing decisions."<sup>21</sup> Thus, tacking plays a constructive role in long-term trademark protection and use.

Tacking an old mark to a newer mark, requires the two marks to be "legal equivalents," and the newer mark must not deviate substantially in form from the older version.<sup>22</sup> Whether a mark deviates substantially is determined by whether the newer mark creates "the same, continuing commercial impression."<sup>23</sup> However, courts disagree as to whether "continuing commercial impression" should be measured as a question of law or a question of fact.<sup>24</sup>

Some courts determine whether tacking is an issue of law or fact based on how they have determined similar trademark issues, such as the test for "likelihood of confusion" (the "likelihood" test).<sup>25</sup> The "likelihood" test compares two separate marks, and how consumers perceive them, to establish either a common or contrasting overall impression.<sup>26</sup> The "likelihood" test is

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image has been updated seven times. *Id.* In each portrait she wears a red garment with a white accent, but the style of her clothes, hair, and face have been updated to "reflect the changing faces of American women." *Id.*

18. *Merch. & Evans, Inc. v. Roosevelt Bldg. Prods. Co.*, 963 F.2d 628, 639 (3d Cir. 1992) ("Once the requisite showing has been made, trademark protection is of infinite duration.")

19. *Brookfield Commc'ns, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1048 (9th Cir. 1999).

20. *Id.*

21. *See Mark & Jacoby, supra* note 6, at 438 (quoting *Brookfield*, 174 F.3d at 1048).

22. 37 C.F.R. § 2.72(a)(2) (2013). Making an amendment to a federally registered mark tends to raise this issue. When amending a registered mark "the applicant may amend the description or drawing of the mark only if: . . . (2) The proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application." *Id.* *But see One Indus., LLC v. Jim O'Neal Distrib., Inc.*, 578 F.3d 1154, 1161 (9th Cir. 2009) (holding that "tacking will be allowed only if the marks are virtually identical").

23. *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 1159 (Fed. Cir. 1991) (quoting *Ilco Corp. v. Ideal Sec. Hardware Corp.*, 527 F.2d 1221, 1224 (C.C.P.A. 1976)) (internal quotation marks omitted).

24. *See Louangel, Inc. v. Darden Rests., Inc.*, 106 U.S.P.Q.2d (BNA) 1809, 1812 (S.D. Tex. 2013).

25. *Navistar Int'l Transp. Corp. v. Freightliner Corp.*, 49 U.S.P.Q.2d (BNA) 1116, 1119–20 (N.D. Ill. 1998) (deciding on whether tacking should be allowed where the new mark exists as "AMERICAN LAFRANCE EAGLE" and the old mark as "AMERICAN LA FRANCE" with the accompanying image of a bird).

26. *Id.*

used when a court is “determining whether one mark infringes upon the rights of the owner of a different mark,” whereas tacking is used when an owner is attempting to continue the life of his own mark.<sup>27</sup> Despite this difference, these analyses both use consumer impression as a determining factor; therefore, the rationalization for each is analogous.<sup>28</sup> But as the “likelihood” test is widely and fairly consistently used by the courts, tacking is not as common and lacks standardized application.<sup>29</sup>

The courts have yet to develop a precise test to determine the particular circumstances that permit continued trademark use.<sup>30</sup> Courts use varying devices to determine legal equivalency, and, given the lack of legal guidance, courts disagree on the appropriate method that should be used to resolve the issue.

This Comment addresses the difficulty in analyzing tacking as a matter of law and illustrates that tacking should be determined as a question of fact. First, this Comment discusses the legal differences between questions of law and questions of fact. This Comment then examines tacking with regard to trademarks and the analyses by courts that have determined the issue to be a question of law. Next, this Comment compares the decisions by courts that determined tacking to be a question of law with decisions by courts that have determined it to be one of fact. This Comment then analogizes tacking to the “likelihood of confusion” test. Further, this Comment examines the nature of trademarks and the complex effect of market and personal aesthetic preferences on viewer impression. Finally, this Comment finally concludes that measuring tacking by commercial impression is inherently a factual issue, and, without a clear legal test for continuous commercial impression, the analysis relies solely on a judge’s individualized perception of a mark’s potential impressions.

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27. *See id.* at 1120.

28. *Id.* at 1120–21. The court noted that “[t]he [likelihood] test is similar to the tacking inquiry because both depend on many of the same factors, and in a more abstract sense, both involve the degree of similarity between two marks.” *Id.* *See also Louangel*, 106 U.S.P.Q.2d (BNA) at 1812 (holding that “[t]he courts’ treatment of the tacking question is commensurate with their treatment of the related issue of ‘likelihood of confusion’ in the trademark context”). Additionally, these issues are so intertwined that in deciding many “likelihood of confusion” issues the question of tacking arises to determine whether one party used the mark prior to the other party’s use of the mark. *Id.*

29. *See infra* notes 98–113 and accompanying text.

30. *See Mark & Jacoby*, *supra* note 6, at 440 (noting that courts have a more difficult time determining tacking issues because there is no elemental test similar to the “likelihood of confusion” test).

## I. CIRCUITS ARE SPLIT AS TO WHETHER TACKING SHOULD BE TREATED AS A QUESTION OF LAW OR A QUESTION OF FACT

### A. *Distinguishing Questions of Law and Fact: Treatment Within the Courtroom and Upon Appeal*

Deciding whether an issue requires a legal or factual determination is complicated without knowing how each of these categories is defined.<sup>31</sup> The Supreme Court has stated, “we [do not] yet know of any other rule or principle that will unerringly distinguish a factual finding from a legal conclusion.”<sup>32</sup> Usually, these determinations are made based on the roles within the courtroom.

Whether something is considered a question of law or a question of fact is often determined by which member of the judicial process is best suited to make a determination on the specific issue.<sup>33</sup> The determination may be ascertained by differentiating the purposes of the judge and jury.<sup>34</sup> Typically, in a jury trial, the jury makes findings of fact and the judge decides issues of law.<sup>35</sup> Accordingly, in a jury trial, the judge formulates the applicability of the legal standard, while the jury, as the fact finder, “ascertain[s] what happened in a specific case.”<sup>36</sup> Regarding the court’s findings, the factual findings and legal determinations must be made separately and distinctly.<sup>37</sup> There is, however, an exception to this distinction at the trial level.

Before a trademark dispute even reaches appeal, most courts agree that “summary judgment is appropriate if the court is satisfied that the products or marks are so dissimilar that no question of fact is presented.”<sup>38</sup> Whether a factual

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31. Julia Reytblat, *Is Originality in Copyright Law a “Question of Law” or a “Question of Fact?”*: *The Fact Solution*, 17 CARDOZO ARTS & ENT. L.J. 181, 195 (1999).

32. *Pullman-Standard v. Swint*, 456 U.S. 273, 288 (1982).

33. See Reytblat, *supra* note 31, at 195 n.104. Reytblat quotes the Supreme Court’s discussion of matters of law and fact and how they should be decided within the courtroom, stating, “as a matter of the sound administration of justice, one judicial actor is better positioned than another to decide the issue in question.” *Id.* (quoting *Miller v. Fenton*, 474 U.S. 104, 114 (1985)).

34. See Richard A. Machonkin, *Markman v. Westview Instruments, Inc. and Hilton Davis Chemical Co. v. Warner-Jenkinson Co.: The Federal Circuit Gets Its Laws and Its Facts Straight*, 9 HARV. J.L. & TECH. 181, 181 (1996).

35. Machonkin, *supra* note 34, at 183 (discussing the analytical distinction between questions of law and questions of fact).

36. *Id.*

37. See FED. R. CIV. P. 52(a)(1). The Federal Rules of Civil Procedure also dictate that, “[f]indings of fact, whether based on oral or other evidence, must not be set aside unless clearly erroneous, and the reviewing court must give due regard to the trial court’s opportunity to judge the witnesses’ credibility.” FED. R. CIV. P. 52(a)(6).

38. *Universal City Studios, Inc. v. Nintendo Co., Ltd.*, 746 F.2d 112, 116 (2d Cir. 1984) (finding that as a matter of law “Donkey Kong” and “King Kong” were not confusingly similar after reviewing surveys, which offered no real proof that there was an issue of confusion). Further, the Federal Rules of Civil Procedure require that, “[t]he court shall grant summary judgment if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to

question even exists is also open for interpretation, as exemplified by cases where the evidence showed that different commercial impressions were ignored by the court when it granted summary judgment.<sup>39</sup> The distinction between fact and law is further complicated based on where the issue falls within the judicial process.

At the appellate level, issues are treated differently depending on whether an issue is a factual or legal matter.<sup>40</sup> Issues of fact will not be overturned on review unless they are clearly erroneous<sup>41</sup> because the trier of fact, whether the judge or jury, has been specifically designated to make factual findings.<sup>42</sup> Conversely, where there are issues of law “[o]n *de novo* review, an appellate court disregards the trial court’s findings and makes independent conclusions as if it is itself the trial court.”<sup>43</sup> Some courts have decided that these issues cannot easily be separated at either the trial or appellate level and instead apply a hybridized treatment of fact and law.

Some issues are considered mixed questions of fact and law and require the court to carefully balance facts with legal standards.<sup>44</sup> For example, in a multi-factor test, the court settles all evidence relating to the factors as a question of fact, but the weight and ultimate conclusion of the sum of those factors is a question of law.<sup>45</sup> There is not a clear method to determine how the mixed-question analytical framework should be applied.<sup>46</sup> Therefore, courts often

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judgment as a matter of law. The court should state on the record the reasons for granting or denying the motion.” FED. R. CIV. P. 56(a).

39. See, e.g., *Louangel, Inc. v. Darden Rests., Inc.*, 106 U.S.P.Q.2d (BNA) 1809, 1815 (S.D. Tex. 2013) (finding that expert testimony cannot necessarily show how consumers may respond to particular changes in trademarks design).

40. See, e.g., *Zenith Radio Corp. v. Hazeltine Research, Inc.*, 395 U.S. 100, 123 (1969) (asserting that appellate courts must remember that their role is not to review factual findings *de novo*).

41. See *Machonkin*, *supra* note 34, at 181.

42. *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 856 (1982).

43. See *Reytblat*, *supra* note 31, at 197 n.113. Historically, questions of law on appeal are to be treated completely separate from issues of fact. As an early Supreme Court case held with regard to legal review:

[I]t has been established by repeated decisions that each question so certified must be a distinct point or proposition of law, clearly stated, so that it can be definitely answered, without regard to other issues of law or of fact in the case. The points certified must be questions of law only, and not questions of fact, or of mixed law and fact—“not such as involve or imply conclusions or judgment by the court upon the weight or effect of testimony or facts adduced in the cause.”

*Jewell v. Knight*, 123 U.S. 426, 432 (1887) (quoting *Dennistoun v. Stewart*, 59 U.S. 565, 568 (1856)).

44. See *Machonkin*, *supra* note 34, at 183–84 (noting mixed questions of law and fact often have no mechanical test to assist the court with resolving the issue).

45. *Data Concepts, Inc. v. Digital Consulting, Inc.*, 150 F.3d 620, 624 (6th Cir. 1998) (identifying the “likelihood of confusion” test as a mixed question).

46. See *Machonkin*, *supra* note 34, at 183–84 (noting that the Supreme Court has not ruled on mixed questions).

apply the framework inconsistently.<sup>47</sup> Courts using this method will look at whether a jury or judge is in the best position to decide the issue.<sup>48</sup>

Mixed questions of law and fact are present not only in application, but also in the standard of review for these issues,<sup>49</sup> and courts often disagree about how that standard should apply.<sup>50</sup> Some courts review the entire issue *de novo*,<sup>51</sup> while some apply the clearly erroneous standard,<sup>52</sup> but, most commonly, courts will employ the clearly erroneous standard to those issues that were considered factual issues and *de novo* review to the legal issues.<sup>53</sup>

### B. Tacking: Furthering a Trademark Owner's Protection of His Mark

Tacking connects a newer mark that is currently in use to a former version of the mark, but only if the two marks are legal equivalents.<sup>54</sup> Two marks may “differ[] slightly in their literal meaning or grammatical presentation, [but] nevertheless possess the same connotation in context.”<sup>55</sup> Trademarks used over extended periods of time, or even those used for relatively short periods but during shifts in market trends, may qualify for continued protection under the tacking concept.<sup>56</sup> Tacking owners receive “the same rights in the new mark as [they] ha[d] in the old.”<sup>57</sup> Therefore, tacking deters appropriation by competitors.<sup>58</sup>

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47. *See id.* (discussing the implications of the Supreme Court's lack of guidance on the issue of mixed questions of law and fact).

48. *See id.* at 184. There are several policy factors to consider when determining which party is in the best position to assess either a factual or legal issue, such as, “judicial administration; the expertise of the actors; whether the decision will be dominated by fact-finding or rule-making; the type of evidence to be considered; the need for uniformity; and whether appellate review would produce useful precedent.” *Id.* at 184–85 (footnotes omitted).

49. 2A FEDERAL PROCEDURE, LAWYER'S EDITION § 3:824 (2003).

50. *Id.* (explaining that appellate courts do not agree as to how mixed questions of law and fact should be handled upon review).

51. *Id.*

52. *Id.*

53. *Id.* *De novo* review is defined as “[a]n appeal in which the appellate court uses the trial court's record but reviews the evidence and law without deference to the trial court's rulings.” BLACK'S LAW DICTIONARY 112 (9th ed. 2009).

54. *See Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 1160 (Fed. Cir. 1991) (stating that tacking may be permitted when two slightly different marks retain the same “connotation in context”).

55. *Id.*; *see also* 3 MCCARTHY, *supra* note 12, § 17:26, at 17–63 (“A mark can be modified or changed without abandonment or loss of priority if done in such a way that the continuing common element of the mark retains its impact and symbolizes a continuing commercial impression.”).

56. *See Brookfield Commc'ns, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1048 (9th Cir. 1999) (discussing the legal implications altering trademarks and tacking).

57. *Id.*

58. *Id.* The court asserted that “[w]ithout tacking, a trademark owner's priority in his mark would be reduced each time he made the slightest alteration to the mark.” *Id.*

Any alteration to the older mark may not be exceedingly drastic, because tacking is not permitted if the older mark is materially altered.<sup>59</sup> Material alteration is determined by legal equivalency, or more accurately, whether the marks create the “same continuing commercial impression.”<sup>60</sup> Consequently, the relationship between the two marks must be:

[T]he *legal equivalent* of the mark in question or *indistinguishable* therefrom, and the consumer should consider both as the same mark. However, for the purposes of “tacking,” even if the two marks are confusingly similar, they still may not be *legal equivalents*. Instead, the marks must create “the *same, continuing commercial impression*,” and the later mark should not materially differ from or alter the character of the mark attempted to be “tacked.”<sup>61</sup>

Use of the term “legal” in the phrase “legal equivalents” does not mean that the mark may not be measured by a question of fact, rather each mark must make a similar commercial impression on the viewer.<sup>62</sup> Courts that have applied tacking as a question of fact consider commercial impression as primarily measured by the consumer.<sup>63</sup> The impression on the consumer is measured by both the visual presentation of the mark and the mark’s aural appearance, such as how the viewer pronounces a word within the mark.<sup>64</sup> Because trademarks identify the source of products or services, tacking is generally allowed if “the new mark serves the same identificatory function as the old mark,”<sup>65</sup> and if the meaning conveyed or “mental reaction it evokes” is the same as the old mark.<sup>66</sup>

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59. 37 C.F.R. § 2.72(a)(2) (2013). Often times tacking is allowed where there are “[m]inor differences between marks, such as an inconsequential modification or modernization . . . because a consumer would consider the marks the same.” *Specht v. Google Inc.*, 758 F. Supp. 2d 570, 583 (N.D. Ill. 2010).

60. *Data Concepts, Inc. v. Digital Consulting, Inc.*, 150 F.3d 620, 623 (6th Cir. 1998) (quoting *Van Dyne-Crotty*, 926 F.2d at 1159) (internal quotation marks omitted).

However, there is one federal court that disagrees with using the phrase “legal equivalency” in considering tacking. In *Navistar*, the court held that legal equivalency was to be used in infringement cases and not for tacking. *Navistar Int’l Transp. Corp. v. Freightliner Corp.*, 49 U.S.P.Q.2d (BNA) 1116, 1120 (N.D. Ill. 1998). The court stated that the standard for tacking is the commercial impression test, but to refer to this as a legal equivalency analysis was inaccurate. *Id.* The court believed legal equivalency to be “an entirely different doctrine which holds that rights in a picture mark encompass rights in a word if the picture evokes the mental impression of the word.” *Id.*

61. *Van Dyne-Crotty*, 926 F.2d at 1159 (emphasis added) (quoting *Ilco Corp. v. Ideal Sec. Hardware Corp.*, 527 F.2d 1221, 1224 (C.C.P.A. 1976)).

62. *Id.*

63. *Id.*

64. *Data Concepts*, 150 F.3d at 623; see also *Louangel, Inc. v. Darden Rests., Inc.*, 106 U.S.P.Q.2d (BNA) 1809, 1813 (S.D. Tex. 2013) (determining that while the marks sound the same, the visual appearance of the two marks were substantially different).

65. *Brookfield Commc’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1048 (9th Cir. 1999).

66. *Mark & Jacoby*, *supra* note 6, at 434.

A consumer reaction test lends itself to being a fact-based inquiry, and many courts appropriately determine tacking cases as an issue of fact.

### C. Measuring Tacking as a Question of Law

A slim majority of federal circuits that addressed tacking disputes held that tacking should be settled as a question of law.<sup>67</sup> The U.S. Court of Appeals for the Federal Circuit treated tacking as a question of law, basing its analysis primarily on its own interpretation of the mark rather than the consumer's interpretation.<sup>68</sup> In *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, the Federal Circuit affirmed the U.S. Patent and Trademark Office's Trademark Trial and Appeal Board (TTAB) decision based purely on its visual inspection of the marks without regard to consumer impression.<sup>69</sup> The Federal Circuit refused to allow an owner to tack "a mark with a narrow commercial impression onto one with a broader commercial impression."<sup>70</sup> The Federal Circuit justified its finding by looking to the TTAB's decision and inferring that the TTAB's finding implied that the two marks created different commercial impressions.<sup>71</sup> However, the majority conceded that the only measurement that the TTAB used was its own impression of how a purchaser would perceive the mark.<sup>72</sup> Allowing a non-legal standard to determine the tacking issue, rather than relying on evidence that illustrated consumer perception, established precedent that could lead to inconsistent outcomes.<sup>73</sup>

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67. See, e.g., *Van Dyne-Crotty*, 926 F.2d at 1159–60 (affirming the TTAB's determination that the marks "CLOTHES THAT WORK" and "CLOTHES THAT WORK. FOR THE WORK YOU DO" are not legal equivalents as a matter of law); *Data Concepts*, 150 F.3d at 623 (deciding on whether "DCI.com" could be tacked on to the earlier use of "DCI"); *Louangel*, 106 U.S.P.Q.2d (BNA) at 1811 (discussing whether the newer mark with "a minimalist or more abstract . . . outline of a cow's head with horizontal horns, and with 'LongHorn' as one word over 'steakhouse' in a sleeker font" could be tacked onto the older mark with "chunky font and . . . a babyfaced cartoon cow's head with vertical horns").

68. *Van Dyne-Crotty*, 926 F.2d at 1160.

69. *Id.* at 1159–60.

70. *Id.* at 1160.

71. See *id.* (explaining that "the [TTAB's] conclusion necessarily implies a foundational finding that the two marks create differing commercial impressions in the minds of consumers, a finding that has not been proven clearly erroneous").

72. *Id.* at 1159. The court stated, "[i]t does not appear that the [TTAB] entertained any other evidence concerning the legal equivalence of these two marks except for the visual or aural appearance of the marks themselves." *Id.* The concurring judge disagreed with the finding by the majority and believed that ordinary consumers could find the two marks created the same commercial impression. *Id.* at 1160–61 (Newman, J., concurring). Judge Newman concurred because the facts did not support finding otherwise. *Id.*

73. See *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 346–47 (9th Cir. 1979) (noting that within the "likelihood of confusion" test the circuits often switch tests and have no consistent method of deciding these cases). Inconsistent decisions create the risk of undermining trust within the judicial system, and "without sufficient grounds for trust in the system, there is a greater risk of injustice for weaker parties with legitimate cases who will not pursue their rights (and in the long

The Federal Circuit clarified its holding in *In re Dial-A-Mattress Operating Corp.*<sup>74</sup> The court explained that for tacking, “[n]o evidence need be entertained other than the visual or aural appearance of the marks themselves.”<sup>75</sup> Additionally, courts may analogize the marks to marks that were analyzed in a different case.<sup>76</sup> Courts are often less likely to permit tacking when two marks share a higher degree of similarity than marks in other cases.<sup>77</sup>

The U.S. Court of Appeals for the Sixth Circuit shares the Federal Circuit’s approach in determining tacking as a question of law.<sup>78</sup> In *Data Concepts, Inc. v. Digital Consulting, Inc.*, the Sixth Circuit adopted the Federal Circuit’s approach by stating that legal equivalency is determined by how the mark looks and sounds, and the court provided no other criteria for either denying or allowing tacking.<sup>79</sup> The court began its analysis by remarking that the marks were not visually similar.<sup>80</sup> The court cited to other decisions, but it did not discuss the commercial impression with regard to the average consumer.<sup>81</sup> Instead, the Sixth Circuit conducted a piecemeal comparison of the marks to show that they were not similar and did not create a “continuous commercial impression.”<sup>82</sup>

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run the body of the law as a whole will suffer).” Sarah M. R. Cravens, *In Pursuit of Actual Justice*, 59 ALA. L. REV. 1, 12 (2007).

74. 240 F.3d 1341, 1347 (Fed. Cir. 2001) (deciding whether the previously registered marks, “(212)-M-A-T-T-R-E-S” and “1-800-MATTRES, AND LEAVE OFF THE LAST S THAT’S THE S FOR SAVINGS,” were the legal equivalents of “1-888-M-A-T-R-E-S”).

75. *Id.*

76. *Data Concepts, Inc. v. Digital Consulting, Inc.*, 150 F.3d 620, 624 (6th Cir. 1998). The *Data Concepts* court cited two other instances where the marks were similar but held not to be legal equivalents. The first example being “CLOTHES THAT WORK” and “CLOTHES THAT WORK FOR THE WORK YOU DO.” *Id.* (citing *Van Dyne–Crotty*, 926 F.2d at 1160). The other example given was a comparison of “Pro-Kut” and “Pro-Cuts.” *Id.* (citing *Pro–Cuts v. Schilz–Price Enters., Inc.*, 27 U.S.P.Q.2d (BNA) 1224, 1227 (T.T.A.B. 1993)). The court justified its decision on “DCI” and “DCI.com” based not on outside impressions, but by comparing those marks to the marks in other cases. *Data Concepts*, 150 F.3d at 624.

77. *See supra* note 76.

78. *Data Concepts*, 150 F.3d at 623.

79. *Id.* (quoting *Van Dyne–Crotty*, 926 F.2d at 1159); *see also* *Brookfield Commc’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1049 (9th Cir. 1999) (determining the marks could not be tacked because no showing was made that demonstrated that consumers viewed the two marks as identical). Before the Ninth Circuit moved to viewing tacking as a question of fact, the *Brookfield* court made a visual inspection of the marks “The Movie Buff’s Movie Store” and “moviebuff.com” and decided that because “the latter contains three fewer words, drops the possessive, omits a space, and adds ‘.com’ to the end,” they did not create a continuous commercial impression. *Id.* However, the court noted that their decision was partially based on the fact that one party failed to show that customers viewed the two marks as the same. *Id.*

80. *Data Concepts*, 150 F.3d at 624.

81. *See id.* (citing several illustrative cases).

82. *Id.* at 623–24.

*D. Measuring Tacking as a Question of Fact*

Judges who have ruled that tacking should be a question of law rely primarily on their own personal impression of the mark, but judges who believe tacking should be a question of fact rely on extrajudicial methods. The U.S. District Court for the Southern District of Texas, which views tacking as a question of fact, noted “[a] party . . . should submit evidence of consumer perceptions regarding the commercial impression of the marks sought to be tacked.”<sup>83</sup> Additionally, the court stated, “court[s] should not merely speculate on how consumers would perceive the marks.”<sup>84</sup>

Some jurisdictions have used the “likelihood of confusion” test, which is an analogous test, to determine whether tacking is a factual or legal issue.<sup>85</sup> The Ninth Circuit determined that tacking was a question of fact because it held the similar “likelihood” test to be one of fact as well.<sup>86</sup> In *Quiksilver, Inc. v. Kymsta Corp.*, the U.S. Court of Appeals for the Ninth Circuit found that because reasonable minds may differ regarding commercial impression, questions raised by these issues must be settled as a matter of fact.<sup>87</sup> The court relied on the Ninth Circuit’s earlier decision, that “likelihood of confusion” in trademarks should be measured as a question of fact, when it determined the proper test for tacking.<sup>88</sup> The *Quiksilver* court found the testimony of the Senior Vice President of Marketing, the original clothing designer, and the Chief Executive Officer sufficient to illustrate that a reasonable jury could have decided that the marks did not present the same continuing commercial impression.<sup>89</sup> The court used this evidence to find that the lower court’s decision to allow tacking was clearly erroneous.<sup>90</sup>

The U.S. Court of Appeals for the Seventh Circuit also adopted the view that determining whether a mark was substantially similar to another is a “threshold question,” which was typically a factual issue.<sup>91</sup> In *Navistar Int’l Transp. Corp.*

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83. *Louangel, Inc. v. Darden Rests., Inc.*, 106 U.S.P.Q.2d (BNA) 1809, 1812 (S.D. Tex. 2013) (holding that tacking should be a question of fact, despite believing that a court should not merely speculate on consumer perception).

84. *Id.*

85. *See supra* note 28 (discussing how the “likelihood of confusion” test and the tacking inquiry are similar).

86. *Quiksilver, Inc. v. Kymsta Corp.*, 466 F.3d 749, 759 (9th Cir. 2006).

87. *Id.* at 758–60 (deciding whether the mark “ROXY” could be tacked onto the older mark of “QUICKSILVER ROXY” when the evidence is not conclusive).

88. *Id.* at 759.

89. *Id.* at 759–60. Testimony showed that at the time the brand was launched there was a concern that no one would know what “ROXY” stood for. *Id.* at 759. The company combined the two names so that people would recognize the “ROXY” brand as being affiliated with Quiksilver, which might affect how consumers would react to the mark. *Id.* at 759–60.

90. *Id.* at 760.

91. *Exxon Corp. v. Exxene Corp.*, 696 F.2d 544, 550 (7th Cir. 1982) (finding that the difference in aural and visual impression is one of fact for the jury to decide, such as comparing the impression between “Exxon” and “Exxene”).

*v. Freightliner Corp.*, the court moved from considering tacking as a question of law to one of fact.<sup>92</sup> This transition was prompted by the Seventh Circuit's determination that "likelihood of confusion" was a question of fact.<sup>93</sup> The court, in *Navistar*, adopted this analysis, but noted that the Seventh Circuit did not have a test for analyzing tacking.<sup>94</sup> Ultimately, the court looked to the "likelihood" test and held that the commercial impression was best determined by capturing marketplace reactions rather than the court's own visual inspection.<sup>95</sup>

*E. Comparing the Tacking Analysis to the "Likelihood of Confusion" Test*

The "likelihood of confusion" test is a direct result of the Lanham Act.<sup>96</sup> Courts use the test to "determin[e] whether one mark infringes upon the rights of the owner of a different mark."<sup>97</sup> Because trademarks exist to signify the source of a certain product or service, consumer confusion about what a mark signifies is a key determination to establish whether there is infringement.<sup>98</sup>

Courts regularly use the "likelihood" test to decide whether tacking issues should be determined as a question of law or as a question of fact.<sup>99</sup> Both tests have similar elements and measure the mark's degree of similarity.<sup>100</sup> Additionally, the tests seek to determine the degree of commercial confusion

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92. 49 U.S.P.Q.2d (BNA) 1116, 1120–21 (N.D. Ill. 1998).

93. *Id.*

94. *Id.* at 1121.

95. *Id.* (agreeing with the plaintiff that "mere visual and aural comparison of two marks is an insufficient basis for a party seeking to tack").

96. J. Steven Gardner, *Trademark Infringement, Likelihood of Confusion, and Trademark Parody: Anheuser-Busch, Inc. v. L & L Wings, Inc.*, 28 WAKE FOREST L. REV. 705, 716 (1993). The Lanham Act was passed to protect trademarks. *Id.* The relevant portion of the Lanham Act is:

Any person who, on or in connection with any goods or services . . . uses in commerce any word, term, name, symbol . . . which [] is *likely to cause confusion*, or to cause mistake, or to deceive as to . . . his or her goods, services, or commercial activities by another person.

15 U.S.C. § 1125(a)(1) (2012) (emphasis added).

97. *Navistar*, 49 U.S.P.Q.2d (BNA) at 1120.

98. *Thane Int'l, Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 901 (9th Cir. 2002). There are three types of confusion that might materialize when viewing a mark: "(1) general-knowledge confusion, (2) sensory-perception confusion, and (3) subliminal confusion." SCHMITT & SIMONSON, *supra* note 8, at 218–19. General-knowledge confusion is essentially whether the viewer believed the companies to be associated. *Id.* at 219. Sensory-perception confusion is mistaking a brand to be another based on the relatedness in design. *Id.* Subliminal confusion is not as direct, but refers to "the likelihood that consumers will be attracted to defendant's product on the strength of the goodwill and positive image established by [the] plaintiff['s product]." *Id.* at 228.

99. *Navistar*, 49 U.S.P.Q.2d (BNA) at 1121 (agreeing with plaintiff's argument "that because the Seventh Circuit treats the likelihood of confusion inquiry as a matter of fact, tacking should also be treated as a matter of fact").

100. *Id.* (stating that "[i]t is undeniable that tacking and likelihood of confusion are similar inquiries, and we see no principled reason why tacking should be considered a matter of law when confusion is not").

and whether the two marks evoke similar reactions from the viewer.<sup>101</sup> The “likelihood” test directly compares the marks, but the comparison is just one factor.<sup>102</sup> Despite the presence of multiple factors, courts strongly consider the impact the mark makes within the commercial market.<sup>103</sup>

Although similar, the tests for “likelihood of confusion” and for determining commercial impression contain different standards. Tacking requires a higher standard than the “likelihood” test.<sup>104</sup> The “likelihood” test contains a variety of factors that are used by the court to determine whether confusion exists.<sup>105</sup> Unlike the “likelihood” test, the tacking analysis is “a more difficult [task] because no comparable multi-factor test has been developed.”<sup>106</sup> Additionally, whereas the “likelihood” test measures confusion, confusion cannot be equated with legal equivalency.<sup>107</sup>

The “likelihood” test consists of many different factors.<sup>108</sup> Some elements courts consider, but are not limited to, are the following:

- (1) the strength of the plaintiff’s mark;
- (2) the relatedness of the goods or services;
- (3) *the similarity of the marks*;
- (4) *evidence of actual confusion*;
- (5) the marketing channels used;
- (6) the likely degree of purchaser care;
- (7) the defendant’s intent in selecting the mark; and
- (8) the likelihood of the expansion of the product lines.<sup>109</sup>

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101. See, e.g., *Nike, Inc. v. “Just Did It” Enters.*, 6 F.3d 1225, 1228 (7th Cir. 1993) (determining that customer confusion is pivotal to the court’s analysis); *Mushroom Makers, Inc. v. R. G. Barry Corp.*, 580 F.2d 44, 47 (2d Cir. 1978) (holding that the determinative question is whether “ordinarily prudent purchasers are likely to be misled”); *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 1296 (C.C.P.A. 1974) (holding that confusion should be measured by “prospective purchasers”).

102. *James Burrough Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 274–75 (7th Cir. 1976) (stating that a visual comparison is only part of the “likelihood” test and the mark’s effect within the marketplace is equally important).

103. *Id.*

104. See *Brookfield Commc’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1048 (9th Cir. 1999) (referring to the tacking standard as “exceedingly strict”); see also *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 1159 (Fed. Cir. 1991) (noting that the marks may be so similar that it is confusing, yet the marks do not meet the tacking requirements).

105. See *infra* note 113 and accompanying text.

106. See *Mark & Jacoby, supra* note 6, at 440. See also *Navistar Int’l Transp. Corp. v. Freightliner Corp.*, 49 U.S.P.Q.2d (BNA) 1116, 1121 (N.D. Ill. 1998) (noting that there has been no test set forth to determine tacking issues in the Seventh Circuit).

107. See *Van Dyne-Crotty*, 926 F.2d at 1159 (“[F]or the purposes of ‘tacking,’ even if the two marks are confusingly similar, they still may not be legal equivalents.”).

108. *Data Concepts, Inc. v. Digital Consulting, Inc.*, 150 F.3d 620, 624 (6th Cir. 1998).

109. *Id.* (emphasis added) (citing *Frisch’s Rests., Inc. v. Elby’s Big Boy*, 670 F.2d 642, 648 (6th Cir. 1982)).

These factors serve as a guide rather than a required checklist.<sup>110</sup> Additionally, courts may consider these factors, but are not required to weigh the factors that do not aid their analysis.<sup>111</sup>

The “likelihood” test is not aimed at ascertaining what the court thinks about the marks, but rather how consumers within the market construe the mark.<sup>112</sup> The critical viewpoint is that of the “ordinary purchaser,” a category that consists of “both discriminating and casual, relatively unknowledgeable buyers.”<sup>113</sup> Courts that decide “likelihood” questions consistently look to the marketplace to resolve disputes.<sup>114</sup>

Courts routinely rely on surveys to establish whether confusion exists within the market.<sup>115</sup> Surveys are helpful because “actual confusion is persuasive proof

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110. *Homeowners Grp., Inc. v. Home Mktg. Specialists*, 931 F.2d 1100, 1107 (6th Cir. 1991). For the purpose of analogizing the “likelihood” test to tacking, the essential factors are similarity and actual confusion. Similarity refers to how closely the marks look and sound, and actual confusion refers to support and evidence that the public is confused by the marks. *See* *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 351 (9th Cir. 1979) (noting that “[s]imilarity of the marks is tested on three levels: sight, sound, and meaning”); *see also* *Thane Int’l, Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 902 (9th Cir. 2002) (“Evidence of actual confusion ‘constitutes persuasive proof that future confusion is likely.’” (quoting *Clicks Billiards, Inc. v. Sixshooters, Inc.*, 251 F.3d 1252, 1265 (9th Cir. 2001))).

111. *Homeowners Grp.*, 931 F.2d at 1107 (recognizing that all the factors may not be applicable in all cases). How these factors are applied varies from Circuit to Circuit:

While some circuits list at least ten factors, other circuits only articulate six or seven.

While all circuits consider the strength of the plaintiff’s mark, the similarity of the two marks, and the defendant’s intent, only six circuits consider the similarity of sales facilities and only ten circuits consider the sophistication of the consumer in determining the likelihood of confusion.

*See* *Bird & Steckel*, *supra* note 7, at 1022 (footnotes omitted).

112. *Omega Importing Corp. v. Petri-Kine Camera Co.*, 451 F.2d 1190, 1195 (2d Cir. 1971) (applying the test to camera purchasers).

113. *Id.*

114. *See AMF Inc.*, 599 F.2d at 351 (holding that similarity of the marks should be measured by how they are construed within the marketplace, and considering how the mark looks, how it sounds, and what meaning it creates in the viewer). Surveys are an accurate method of determining widespread consumer impression and are widely accepted by the court. *See, e.g., Thane Int’l*, 305 F.3d at 902–03 (making reference to a survey of 300 respondents); *Warner Bros. Inc. v. Am. Broad. Companies, Inc.*, 720 F.2d 231, 246 (2d Cir. 1983) (stating that the court used survey evidence as part of its “likelihood” analysis); and *James Burrough Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 279 (7th Cir. 1976) (using survey results as part of the court’s analysis).

115. *See* cases cited *supra* note 114. There are four main survey methods for determining “likelihood of confusion.” John P. Liefeld, *How Surveys Overestimate the Likelihood of Consumer Confusion*, 93 TRADEMARK REP. 939, 940 (2003). The first is “Top of Mind, in which respondents are shown the junior product and asked, ‘What is the first thing that comes to your mind when looking at this \_\_\_\_\_.’ If respondents do not mention the name of a company, they are asked directly which company comes to mind.” *Id.* Another method is “Company Identification-Forced Choice” where the survey taker is asked directly who they think makes the brand. *Id.* The next method is called “Company Identification” where products are shown together and the survey taker is asked whether they believe the products are made by different companies. *Id.* The last method is called “Simulated Choice” which measures a consumer’s purchase decision as if they were

of the likelihood of confusion, [with which] a reasonable jury could conclude that a likelihood of confusion exists.”<sup>116</sup> Testimony of individuals confused by two marks may not be enough to prove confusion under the test.<sup>117</sup> Surveys, however, capture an overall snapshot of consumer reaction.<sup>118</sup> There is no minimum percentage from the survey results required to show that confusion exists; rather, the standard is whether the number of participants reported as confused “create[s] a *reasonably* disputed factual issue.”<sup>119</sup> Relevant factors used to determine the weight of confusion, other than the number of confused viewers, may include the types of people surveyed and the degree of confusion.<sup>120</sup>

*F. “Likelihood of Confusion” Measured as a Matter of Law, Fact, or a Mixed Question of Both*

Courts have ruled on “likelihood of confusion” matters as a question of law, fact, or a mixed question of both.<sup>121</sup> The traditional view has been that the “likelihood” test is a factual question, but some circuits have moved away from this view and started to incorporate an issue of law into part of the analysis.<sup>122</sup>

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purchasing in real life and then has the survey taker explain why they chose one product over another. *Id.*

116. *Thane Int’l, Inc.*, 305 F.3d at 903 (holding that a survey where a quarter of people surveyed showed confusion was enough for a jury to conclude that likelihood of confusion exists between exercise machine marks “Trek” and “OrbiTrek”).

117. *Id.* at 902.

118. *See id.* (stating that “[i]f enough people have been *actually* confused, then a *likelihood* that people are confused is established”). The downside to requiring or giving substantial weight to surveys is the cost of conducting a survey. Larry C. Jones, *Developing and Using Survey Evidence in Trademark Litigation*, 19 MEM. ST. U. L. REV. 471, 474 (1989). Performing a proper survey can be expensive, as “[t]he direct cost of a survey often runs in the tens of thousands of dollars. In addition, there are indirect costs such as the increased attorney’s fees incurred in assisting in the preparation of the survey and in presenting and deposing survey experts.” *Id.*

119. *See Warner Bros.*, 720 F.2d at 246 (noting that in every survey there will be some participants confused between marks and stating that the existence of some confusion does not necessarily prove a likelihood of confusion); *see also James Burrough*, 540 F.2d at 279 (holding that a survey of fifteen percent of the “restaurant-going public” might be confused by the marks and that this is enough to show that confusion might exist).

120. *Safeway Stores, Inc. v. Safeway Disc. Drugs, Inc.*, 675 F.2d 1160, 1167 (11th Cir. 1982) (explaining that in determining the weight to give confusion, “[p]erhaps as important as . . . the number of instances of confusion are the kinds of persons confused and degree of confusion. Short-lived confusion or confusion of individuals casually acquainted with a business is worthy of little weight, while confusion of actual customers of a business is worthy of substantial weight”). When considering whether to use surveys, it is important to note that in “likelihood of confusion” cases the burden of proving confusion lies with the plaintiff. *See Jones, supra* note 118, at 474.

121. *Data Concepts, Inc. v. Digital Consulting, Inc.*, 150 F.3d 620, 624 (6th Cir. 1998); Brett Thomas Reynolds, *Appellate Review of Lanham Act Violations: Is Likelihood of Confusion A Question of Law or Fact?*, 38 SW. L.J. 743, 746–47 (1984).

122. Reynolds, *supra* note 121, at 746–47.

A number of circuits continue to treat “likelihood of confusion” as a factual issue.<sup>123</sup> The Seventh Circuit has consistently held that the “likelihood” issue is entirely a factual question, because without labeling it an issue of fact the court would have opened the door to appellate court review of decisions *de novo* rather than the clearly erroneous standard.<sup>124</sup> If the issue is a question of law, the outcome at the appellate level may depend on what the judge personally believes is similar, without any consideration of the “likelihood” factors.<sup>125</sup>

Courts that viewed “likelihood of confusion” as an issue of fact emphasized the importance of the relationship between the mark and the consumer.<sup>126</sup> The courts asserted that the best place to look for likelihood of confusion was within the marketplace and not in the “vacuum” of the courtroom.<sup>127</sup> The U.S. Court of Appeals for the Fifth Circuit was particularly at odds with the notion that this issue could be a matter of law, noting:

The fact that the litigating trademarks appear side by side in the judicial solemnity of the courtroom is by itself enough of a falsification of actual market conditions to defy realistic appraisal. Judges, therefore, must attempt to pierce this patently unreal situation and refer to the operative facts behind the scene.<sup>128</sup>

Each Circuit that treated tacking as a factual issue or a mixed issue reasoned that consumer reaction was the proper source to determine confusion.<sup>129</sup>

The majority of the remaining circuits consider this issue to be a mixed question of law and fact.<sup>130</sup> There is a clear line within these courts that separate

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123. See, e.g., *Nat'l Bus. Forms & Printing, Inc. v. Ford Motor Co.*, 671 F.3d 526, 532 (5th Cir. 2012) (holding that confusion was a question of fact only reviewed for clear error); *Peoples Fed. Sav. Bank v. People's United Bank*, 672 F.3d 1, 15 (1st Cir. 2012) (holding that determining the type of term being used and whether a secondary meaning exists was a question of fact and describing this as a high standard); *Bd. Of Regents of Univ. of Wis. Sys. v. Phx. Int'l Software, Inc.*, 653 F.3d 448, 452, 477 (7th Cir. 2011) (holding that an issue of fact existed, regarding the likelihood of confusion, and the jury was in the best position to decide); *Heartsprings, Inc. v. Heartspring, Inc.*, 143 F.3d 550, 553 (10th Cir. 1998) (upholding the rule of viewing confusion issues as questions of fact); *SquirtCo. v. Seven-Up Co.*, 628 F.2d 1086, 1091 (8th Cir. 1980) (acknowledging that as a question of fact the court must uphold the lower court's ruling unless clearly erroneous).

124. *Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1425, 1428–31 (7th Cir. 1985) (recognizing that the appellate court should not attempt to determine factual issues, because the trial court is in the best position to assess the factual issues).

125. *Id.* at 1429.

126. *Id.*

127. *Sun-Fun Prods., Inc. v. Suntan Research & Dev. Inc.*, 656 F.2d 186, 189 (5th Cir. 1981).

128. *Id.* (quoting 3 R. CALLMAN, *THE LAW OF UNFAIR COMPETITION TRADEMARKS AND MONOPOLIES* § 82.2 (3d ed. 1969)).

129. See *Homeowners Grp., Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1107 (6th Cir. 1991) (“The ultimate question remains whether relevant consumers are likely to believe that the products or services offered by the parties are affiliated in some way.”).

130. See, e.g., *Tana v. Dantanna's*, 611 F.3d 767, 775 (11th Cir. 2010) (holding that the issue is a question of fact, but the weight of the likelihood factors can be considered a question of law); *Playtex Prods., Inc. v. Georgia-Pac. Corp.*, 390 F.3d 158, 162 (2d Cir. 2004) (holding that while

what is considered a question of fact and what is considered a question of law. The courts weigh the “likelihood” factors as a question of fact and the weight given to each factor is considered a question of law.<sup>131</sup> The “likelihood” test elements are “foundational factors [which] are factual and subject to a clearly erroneous standard of review, while the weighing of these findings on the ultimate issue of the likelihood of confusion is a question of law.”<sup>132</sup>

The mixed method is consistent with the fluid balance between law and fact.<sup>133</sup> Because “courts retain an important authority to monitor the outer limits of substantial similarity within which a jury is permitted to make the factual determination,” they also have the ability to weigh the legal importance of those determinations.<sup>134</sup>

## II. THE LACK OF A CLEAR TEST FOR TACKLING ENCOURAGES GAP-FILLING AND CREATES INCONSISTENT HOLDINGS

### A. Visual and Aural Impressions are Unique to Each Viewer

Interpretation of images and sounds is unique to each consumer.<sup>135</sup> An observer’s reaction varies depending on age, location, personal preference, and other factors.<sup>136</sup> There is an entire discipline devoted to the study of how images and marks create meaning and “how they connect with the network of meanings present in a culture.”<sup>137</sup> Consumers form impressions from branding aesthetics based on “primary elements, styles, and themes,” which may evoke varying conscious or subconscious reactions.<sup>138</sup>

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the lower court’s determination should be reviewed if clearly erroneous, balancing the likelihood factors can be measured as a question of law and reviewed *de novo*); *A & H Sportswear, Inc. v. Victoria’s Secret Stores, Inc.*, 166 F.3d 197, 201–02 (3d Cir. 1999) (explaining that the confusion aspect was a matter of fact, but the standard applied to that confusion was a matter of law, therefore it was a mixed question); *Jet, Inc. v. Sewage Aeration Sys.*, 165 F.3d 419, 422 (6th Cir. 1999) (stating that the appellate court will accept the trial court’s factual findings unless clearly erroneous and review *de novo* the factors as applied to determine a likelihood of confusion).

131. *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 833 (6th Cir. 1983).

132. *Id.*

133. *Warner Bros. Inc. v. Am. Broad. Cos., Inc.*, 720 F.2d 231, 246 (2d Cir. 1983).

134. *Id.*

135. *See Bery v. City of New York*, 97 F.3d 689, 695 (2d Cir. 1996) (discussing the complex interaction between persons and images).

136. *See DANESI, supra* note 10, at 21.

137. *Id.* at 2. Semiotics is the study of how individuals react to different visual cues. *Id.* The term originates from the Greek word, “semeion,” meaning mark or sign. *Id.* at 17. It was originally used to refer to symptoms in medical science, in that the word referred to an indication of an underlying, more complex state. *Id.*

138. *See SCHMITT & SIMONSON, supra* note 8, at 168. The complex emotional reactions that occur when presented with visual stimuli is rooted in the development of “aesthetics.” *Id.* at 3. The word itself comes from the Greek word “aisthetikos” and was interpreted by a German philosopher, Alexander Baumgarten, who claimed that aesthetics was “a science of sensuous knowledge in contrast with logic, whose goal is truth.” *Id.* at 18 (internal quotation marks omitted).

Subtle changes from one mark to another may create significant discrepancies in perceived commercial impressions depending on the individual. An individual's reaction to a mark compared to another's reaction may depend on that individual's experience with that particular visual design,<sup>139</sup> color,<sup>140</sup> the context of an element within the mark,<sup>141</sup> sound,<sup>142</sup> or how that individual fills in missing information.<sup>143</sup> A more accurate picture of overall commercial impression can be achieved by looking to the marketplace for these reactions.<sup>144</sup>

Trademarks tend to be simplistic as to allow immediate identification by the consumer of the source of products or services. A complex design may not accomplish the same result. However, it is important not to assume that seemingly simplistic marks create only one commercial impression in every viewer. Trademarks are designed and intended to trigger widespread and immediate recognition, but every consumer will react in a slightly different way.<sup>145</sup> While the feelings and impressions of the viewer may not be as complex and diverse as they would be if the consumer was observing a Cézanne, Hopper, or other artistic masterpiece, individual impressions still vary, and courts have

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139. See CROZIER, *supra* note 9, at 67 (stating that familiarity with a design correlates to preference for that design); Elisa Steenberg, *Visual Aesthetic Experience*, 41 J. AESTHETIC EDUC. 89, 92 (2007) (explaining aesthetic association may create a cognitive stimulation of either pleasure or displeasure).

140. See CROZIER, *supra* note 9, at 144 (noting color related stimuli has been researched extensively). The regular person can distinguish 10,000 hues, and perception to color depends on the individual's sensitivity to light. *Id.* See also Steenberg, *supra* note 139, at 89 (offering that an individual's reaction to a particular color or set of colors may be connected to the same neurological process as emotions).

141. See DANESI, *supra* note 10, at 68–70 (noting that different symbols can take on a variety of meanings). For example, the letter “X” has different meanings in the context of branding, such as “[1] [t]he signature of any illiterate person . . . [2] [c]ancellation [3] [t]he unknown [4] [a] location on a map . . . [5] [a] motion picture rating . . . [or] [6] [t]he symbol for a kiss.” *Id.* at 69–70.

142. See SCHMITT & SIMONSON, *supra* note 8, at 85 (analogizing auditory stimuli to visual stimuli).

143. See SCHMITT, *supra* note 8, at 170. Marketing analysts look at these factors in order to create positive reactions in large portions of the purchasing public. See DANESI, *supra* note 10, at 16–17. To do so these images are understood to be interpreted on its face as well as the meaning it carries. *Id.* at 20. Branding experts will attempt to market from both of these levels, which have been termed the “signifier”—for the physical aspects of the mark, and the “signified”—the “meaning captured by the sign.” *Id.* at 17. Establishing a deeper connection between the consumer and the mark may bring marketers closer to establishing brand loyalty. See SCHMITT & SIMONSON, *supra* note 8, at 185–86.

144. *Id.*

145. *Id.* at 165–66, 168. Given the minimal nature of most marks, customers will make connections and interpret the mark based on their own personal history, knowledge, and practical inferences. *Id.* at 170. Because each viewer has different experiences in these areas, there is no guarantee that each conclusion a viewer draws about a mark will be identical to another person's conclusion. *Id.* For example, “[s]ometimes identity elements are literally misperceived by customers. . . . Mazda's original logo was a stylized representation of the letter ‘m,’ but it was perceived by most consumers outside Japans as an ‘l.’” *Id.* at 98.

not adequately created a standardized legal interpretation to deal with this reality.

Individual purchasers have varied reactions to different images, and measuring consumer impression without a clear legal standard increases the likelihood of inconsistencies within the judicial system. As a Chief Marketing and Creative Strategist for a corporate branding company stated: “We are bombarded with so much branding today that our minds have been trained to receive a lot of messages.”<sup>146</sup> Consumer reaction to brands is complex and something that marketing companies spend significant research and resources deciphering.<sup>147</sup> A broad survey indicated “that there are considerable varieties in individuals’ inclinations for visual aesthetic experiences. . . . This inclination may possibly be claimed to be due to an innate disposition for holding visual aesthetic attitudes . . . . it is undoubtedly also due to certain social circumstances.”<sup>148</sup> Because of this complexity and variation, courts are not suited to determine commercial impression without evidence to guide them.

### *B. Judges Are in a Poor Position to Decide Commercial Reaction*

Allowing individual judges to determine tacking cases without a clear legal standard increases the risk of inconsistent outcomes. Judges cannot divorce themselves entirely from their decisions, but they are expected to base their holdings on established legal standards.<sup>149</sup> Without a clear standard for a tacking analysis, “subjective likes and dislikes, predilections and prejudices, instincts emotions, and habits” become the rule.<sup>150</sup> Additionally, consistency creates a system that mark owners can depend on for guidance when changing their

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146. W.D. Murray, *Nike’s Swoosh Adjustment 9-18-98*, MARKETWATCH (Sept. 19, 1998, 8:43 PM), <http://www.marketwatch.com/story/nikes-swoosh-adjustment-9-18-98>.

147. See SCHMITT & SIMONSON, *supra* note 8, at 194–95. Design firms focused on creating brand identities often do not have the resources to perform their own research on customer reaction to their designs. These firms often hire specialized research companies who focus solely on performing design reaction surveys. *Id.* at 195.

148. Steenberg, *supra* note 139, at 90.

149. See Cravens, *supra* note 73, at 4–5. Cravens points out that it is not possible for anyone to make a decision solely based on the law as our statutes and rules are not comprehensive enough. *Id.* at 26–27. Additionally, Cravens argued that “human beings are simply not capable of completely excluding all of their personal perspectives in their reasoning.” *Id.* at 27.

150. Shirley S. Abrahamson, *Judging in the Quiet of the Storm*, 24 ST. MARY’S L.J. 965, 984 (1993). Abrahamson quotes Justice Cardozo himself, who recommends that a judge “disengage himself, so far as possible, of every influence that is personal or that comes from the particular situation which is presented to him, and base his judicial decision on elements of an objective nature.” *Id.* (quoting BENJAMIN N. CARDOZO, *THE NATURE OF THE JUDICIAL PROCESS* 121 (1921)); see also Cravens, *supra* note 73, at 4–5 (opining that the best way to ensure judges make unbiased decisions is to require more transparency). There is no contention here that judicial decisions can be completely divorced from the judge’s personal opinions, but without a proper rule on which to base tacking issues there cannot be a “legally justified outcome.” *Id.*

mark.<sup>151</sup> Consistency would provide assurance that a court's decision, in the event of a dispute, will be grounded in established law.<sup>152</sup>

Commercial impression may differ depending on whether consumers have been surveyed or whether the judge has made a decision based on his own personal observations. An "eyeball" comparison<sup>153</sup> of the old and new marks may not accurately capture a change in commercial impression.<sup>154</sup> For example, consider the famous Nike swoosh that many people worldwide identify with the Nike brand.<sup>155</sup> If Nike was to add an element to the design, thereby complicating the simple swoosh, a decision about whether tacking would be permitted may differ if it was analyzed as a question of law or a question of fact. A judge comparing the simple swoosh to the new, more complicated, swoosh might view the two as vastly different and, therefore, not eligible for tacking. However, by measuring the commercial impression based on consumer reaction, the swoosh alone may have enough influence on the overall impression of the mark that viewers may not see the added elements as important or confusing.<sup>156</sup> A market

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151. See Christopher J. Peters, *Foolish Consistency: On Equality, Integrity, and Justice in Stare Decisis*, 105 YALE L.J. 2031, 2039–40 (1996).

152. *Id.*

153. *Louangel, Inc. v. Darden Rests., Inc.*, 106 U.S.P.Q.2d (BNA) 1809, 1813 (S.D. Tex. 2013) (holding that "an 'eyeball' comparison, alone, does not end the inquiry, as 'the similarity of marks depends on evidence about the perceptions of consumers in the relevant market—considerations which an aural and visual comparison does not necessarily reveal to the full extent necessary'" (quoting *Navistar Int'l Transp. Corp. v. Freightliner Corp.*, 49 U.S.P.Q.2d (BNA) 1116, 1121 (N.D. Ill. 1998))).

154. *James Burrough Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 275 (7th Cir. 1976). Individual comparison of one visual with another can be skewed by the viewer's own unavoidable physical attributes. Studies have shown that eight percent of men and 0.5% of women are affected by colorblindness, many of whom are unaware that they may have some degree of this disorder. Melinda Beck, *New Outlook on Colorblindness*, WALL ST. J. (Nov. 6, 2012, 12:37 PM), <http://online.wsj.com/news/articles/SB10001424052970204349404578100942150867894>. Discerning different colors may not be an issue when the colors are bold, but it becomes an issue when the colors are melded or subdued. *Id.* While this disorder does not affect a large population, marketers may use services to simulate how their products and images may look to people with different variations of colorblindness. *Id.* With men holding just under sixty percent of the full-time federal judicial positions, the percentage of colorblind federal judges would be 5.7% of the total positions held, which equates to forty-four of the 772 full-time positions. See *Decades After O'Connor, Role Of Women Judges Still Growing*, THIRD BRANCH NEWS (Mar. 29, 2013), <http://news.uscourts.gov/decades-after-oconnor-role-women-judges-still-growing>. Even without colorblindness, an individual's perception of color may depend on their sensitivity to varying frequencies of light. CROZIER, *supra* note 9, at 144.

155. See W.D. Murray, *supra* note 146.

156. See DANESI, *supra* note 10, at 50. The original Nike logo was the word printed in orange on top of the outline of a checkmark, and "this check mark is now so recognizable that the company name itself has become [sic] superfluous." *Id.* In addition, many companies rely on themes to promote their brand, which are "cultural signs and symbols created . . . to express corporate and brand characteristics." See SCHMITT & SIMONSON, *supra* note 8, at 124. Theme elements may consist of visuals, slogans, jingles, etc. *Id.* at 139. These themes are a collective of interrelated logos and images, used repetitively in order to "embed[] [themselves] in the customer's memory," which in turn trigger the associated brand. *Id.* at 126.

survey might show that the two have the same continuous commercial impression, whereas a single judge may not.

As previously established, issues of fact and law often turn on whether the judge or jury is in the best position to make a determination on an issue.<sup>157</sup> The jury is in a far better position to assess commercial impression. Justice Holmes said, “[i]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.”<sup>158</sup> Juries consist of a diverse mixture of the public with varying degrees of personal taste. The unreasonableness of allowing a single judge to make a commercial impression decision is illuminated when considering why surveys are permitted as evidence within the “likelihood” test.

### *C. Surveys Establish Impression More Accurately Than the Individual Viewer*

Surveys capture actual confusion because they look to the mark’s actual audience.<sup>159</sup> They compile widespread opinion, and take into account different types of market participants.<sup>160</sup> Opinions that come directly from the marketplace draw feedback from a larger pool and may be more accurate than the opinion of a few people. A judge is one person, with certain visual and audial preferences, and may be only one type of market participant. Additionally, a judge who has been exposed to many different brands may have a very different viewpoint on both confusion and commercial impression than a judge who is a one-shop purchaser.

Surveys bring the test for confusion into the consumer environment where the mark is actually utilized and out of the sterile conditions of a courtroom. Consumers are presented with different influences when viewing trademarks, influences that may not exist when viewing the marks in an environment so removed from the marketplace.<sup>161</sup> The U.S. Court of Appeals for the Second Circuit aptly summarized the importance of outside impressions of marks: “The law is not made for the protection of experts, but for the public—that vast multitude which includes the ignorant, the unthinking and the credulous, who, in making purchases, do not stop to analyze, but are governed by appearances and general impressions.”<sup>162</sup> Courts will get a more accurate view of overall

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157. See *supra* note 48 and accompanying text.

158. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

159. See *supra* notes 112–17 and accompanying text.

160. See *Ilco Corp. v. Ideal Sec. Hardware Corp.*, 527 F.2d 1221, 1224 (C.C.P.A. 1976) (opining that commercial impression should be measured by consumers and persons familiar with the type of products the store represented).

161. *James Burrough Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 275 (7th Cir. 1976) (stating that the proper analysis is the effect of the mark on a consumer’s perception in a market atmosphere and not how it looks when placed next to the other mark, in a courtroom).

162. *Florence Mfg. Co. v. J.C. Dowd & Co.*, 178 F. 73, 75 (2d Cir. 1910).

consumer reaction by surveying consumers who actually view the marks within the marketplace.

Additionally, a judge may not be familiar with the particular good, service, or brand that the mark represents. Therefore, the judge's opinion about whether confusion exists may differ from that of someone who is familiar with goods or services within that particular market.<sup>163</sup> Commercial impression may also vary depending on generational differences.<sup>164</sup> For example, logos on clothing did not become popular until the 1970s and generations since then have become "logo conscious."<sup>165</sup> A wide survey sample helps to overcome other similar generational gaps.<sup>166</sup> Without surveys, a judge is left to speculate as to how a consumer might perceive a mark, and there is no guarantee that this speculation will be accurate.<sup>167</sup>

#### *D. The Continuous Commercial Impression Test Is Ill-Suited As a Question of Law*

Courts that measure tacking as a question of law are prone to make piecemeal comparisons of the marks to show that the marks are dissimilar and do not create a continuous impression.<sup>168</sup> Comparing whether one mark has a similar element to another is an improper method of deciding impression because the critical measurement is the mark as a comprehensive whole, not the individual pieces of the mark.<sup>169</sup> Additionally, concentrating on the individual features of the mark,

163. *Triangle Publ'ns v. Rohrlich*, 167 F.2d 969, 976 (2d Cir. 1948) (stating that the court was hesitant to rule on likelihood of confusion as a matter of law between the magazine *Seventeen* and a clothing line name "Seventeen" that was in the magazine, because no actor of the court was either a teenager or a female).

164. *See CROZIER*, *supra* note 9, at 68–69 ("What is commonplace for one generation can look odd or even funny to another. . . . any of these designs may become fashionable again, and look pleasing or 'normal.' . . . [while] some designs seem timeless.")

165. *DANESI*, *supra* note 10, at 19.

166. *See Jones*, *supra* note 118, at 479–80 (recognizing that surveys capture a range of consumer opinions, such as past, present, and future consumers, as well as competitor's purchasers, and many others).

167. *See, e.g., Caron Corp. v. V. Vivaudou, Inc.*, 4 F.2d 995, 997 (2d Cir. 1925) ("In all such cases we commonly use our own eyes, and must project in imagination any possible confusions to which a careless buyer might be subject. If there were proof of actual confusion, we could correct our naive impressions . . .").

168. *Cf. KeyCorp v. Key Bank & Trust*, 99 F. Supp. 2d 814, 820 (N.D. Ohio 2000) (stating that courts should not interpret marks based on the individual components of the mark).

169. *Id.*; *see also Hana Fin., Inc. v. Hana Bank*, 735 F.3d 1158, 1164 (9th Cir. 2013) (stating that an identical fragment shared by both the older and newer marks by itself is not enough to meet the tacking requirement); *Homeowners Grp., Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1109 (6th Cir. 1991) (explaining that "marks must be viewed in their entirety and in context," even though some marks may have similar pieces, each as a whole may have different commercial impressions); *Universal City Studios, Inc. v. Nintendo Co., Ltd.*, 746 F.2d 112, 117 (2d Cir. 1984) (discussing the "likelihood of confusion" test and finding that "[i]n order to determine if confusion is likely, each trademark must be compared in its entirety; juxtaposing fragments of each mark does not demonstrate whether the marks as a whole are confusingly similar").

rather than on the overall impression, may cause inconsistency when courts apply the test, if the focus centers on the incorrect component.<sup>170</sup> A mark is effective if it triggers an observer to recognize the source of a product or service it is supposed to represent.<sup>171</sup> A mark is recognized when viewed in its entirety, and, therefore, commercial impression should be measured in the same way.<sup>172</sup> To suggest that the test should be completed using fragments of the mark is an example of the court sidestepping the commercial impression analysis.

Judges erroneously supplant their own opinions about what they believe is a mark's commercial impression by deciding that tacking should be a question of law. Where tacking has been decided as a question of law, courts have rejected the opinions of legal experts as "nothing more than their own subjective conclusions based upon their view of the trademarks themselves and not upon anything but the most abstract principles of consumer conduct."<sup>173</sup> Despite rejecting the experts' testimony, this subjective method of analysis is essentially the same process used by the court when ultimately relying on its own so-called legal analysis.<sup>174</sup>

*E. Inconsistencies Exist in Application Between the Tests of Confusion and Commercial Impression*

When considering "likelihood of confusion," courts overwhelmingly have held that they must look to the discriminating public to make a sound decision

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170. *See* *Ilco Corp. v. Ideal Sec. Hardware Corp.*, 527 F.2d 1221, 1225 (C.C.P.A. 1976) (finding that, in comparing "HOME PROTECTION HARDWARE" and "HOME PROTECTION CENTER," the lower court erred in focusing on the first two words in each of those marks). The court reasoned that "[b]y regarding HOME PROTECTION to be *the* 'distinguishing feature' of the two terms which it 'merged,' the [TTAB] erroneously evaluated the overall commercial impression on the basis of only a portion of the two expressions." *Id.*

171. *See Homeowners Grp.*, 931 F.2d at 1109.

172. *See* *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 1295 (C.C.P.A. 1974) (stating that the "paramount interest [of the court's analysis] is not the descriptive nature of [the mark's elements], but the overall commercial impression derived by viewing the [two] marks in their entireties" (footnotes omitted)).

173. *Louangel, Inc. v. Darden Rests., Inc.*, 106 U.S.P.Q.2d (BNA) 1809, 1815 (S.D. Tex. 2013); *see also* *Bird & Steckel*, *supra* note 7, at 1015 (noting there was a legitimate concern with using only expert testimony, because "[e]xpert witnesses can testify about their beliefs regarding confusion, but such testimony may not represent the consumer's state of mind and can devolve into a 'battle of the experts' between hired guns paid to support a particular position"). There is also a concern that expert witnesses' opinions on visual similarities "represent only a fraction of what consumers might discern in order to determine whether a trademark comes from a particular source." *Id.*

174. *Louangel*, 106 U.S.P.Q.2d (BNA) at 1812 (referring to the test of comparing the marks and determining commercial impression as "in essence an 'eyeball' test"). This kind of subjective reasoning is discouraged within judicial decisions, as "the exercise of judicial power is not legitimate if it is based on a judge's personal preferences rather than law that precedes the case, on subjective will rather than objective analysis, on emotion rather than reasoned reflection." Paul Gewirtz, *On "I Know It When I See It"*, 105 YALE L.J. 1023, 1025 (1996).

about whether confusion actually exists.<sup>175</sup> Despite the higher standard,<sup>176</sup> the commercial impression test for tacking should look to the public as well. Courts deciding the tacking issue as a matter of law have declined to do so, despite the similarities between the two tests.<sup>177</sup>

The two factors of the “likelihood” test that are most similar to the test of commercial impression are the visual “similarit[ies] of the marks” and “evidence of actual confusion.”<sup>178</sup> These two factors focus on ordinary consumer perception of the marks, which is evidence that is essential to determine whether a continuous commercial impression exists.<sup>179</sup> Further, courts have found that the measurement of similarity “must be compared in [] light of what occurs in the marketplace, not in the courtroom.”<sup>180</sup> To do otherwise would be to speculate on how consumers will react to a mark, which creates neither consistent decisions nor well-reasoned ones.<sup>181</sup>

Courts that have determined the “likelihood” test to be a mixed question of law and fact have relied on both the similarity and actual confusion factors.<sup>182</sup> In *Data Concepts*, the Sixth Circuit held that tacking was a question of law, but the “likelihood” factors were factual issues the appellate court could only review for clear error.<sup>183</sup> The court found that balancing these factors was a legal issue.<sup>184</sup> The Sixth Circuit also determined that the lower court erred by justifying its own tacking decision by comparing the marks side-by-side.<sup>185</sup> The majority chastised the lower court for not considering the mark “in light of what occurs in the marketplace, whether the mark will be confusing to the public when singly presented.”<sup>186</sup>

These two holdings within the same circuit are inconsistent. Each test looks to the commercial market, but only the “likelihood” test actually requires evidence from that market. Using this test for “likelihood” but not looking to

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175. See *supra* note 159.

176. See *supra* note 100 and accompanying text.

177. See *supra* Part II.C (noting how the court, when examining tacking as a matter of law, chose not to evaluate consumer protection); see also *supra* note 25 and accompanying text.

178. *Data Concepts, Inc. v. Digital Consulting, Inc.*, 150 F.3d 620, 624 (6th Cir. 1998).

179. See *Louangel*, 106 U.S.P.Q.2d (BNA) at 1812 (quoting 1 ANNE GILSON LALONDE, GIBSON ON TRADEMARKS, § 3.03(g)(i) (Matthew Bender & Co. 2012)).

180. *James Burrough Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 275 (7th Cir. 1976) (noting that this comparison is important in pinpointing the “likelihood of confusion”).

181. See *supra* note 72 and accompanying text.

182. *Data Concepts*, 150 F.3d at 624.

183. *Id.*

184. *Id.*

185. *Id.* at 626; see also *James Burrough*, 540 F.2d at 275 (holding that a side-by-side comparison of marks is not the proper method of analyzing differences when determining “likelihood of confusion,” because the public will unlikely be presented with the marks in that way).

186. *Data Concepts*, 150 F.3d at 626 (quoting *Homeowners Grp., Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1109 (6th Cir. 1991)).

the same sources when considering tacking is inconsistent with determining actual consumer impression. It is contradictory to find that the factors in one test could be considered a factual issue, but that a test that focuses on the same elements should be considered a legal issue in an analogous situation.

### III. MEASURING COMMERCIAL IMPRESSION AS A QUESTION OF FACT AIDS IN PRODUCING CONSISTENT JUDICIAL OUTCOMES AND LENDS ITSELF TO THE NATURE OF VARIED CONSUMER PERCEPTION

Because the touchstone of tacking is commercial impression, it would be illogical, given current trademark jurisprudence, to measure tacking as a question of law. The problem with measuring tacking as a question of law arises from the nature of attempting to determine the kind of impression a visual or aural design makes on an individual consumer. The problem is not just that consumer impression is ill-suited to being a question of law, but rather the issue is that there is no proper guidance on how continuous commercial impression should be defined.<sup>187</sup> Determining tacking as a question of fact is difficult without a test that establishes the necessary factual requirements, but there is some guidance on what those factors should be.<sup>188</sup> Related precedent has not established a clear test for analyzing tacking as a question of law.<sup>189</sup>

In order to weigh the complexity of interpreting trademarks, the proper test for continuous commercial impression should be a question of fact that consists of specific prongs that mirror the “likelihood of confusion” test. An additional requirement should be an analysis of what the mark signifies, such as whether the underlying source represented by the mark has been altered significantly.<sup>190</sup> This directs the overall analysis towards a concrete application and away from the current undefined continuous commercial impression test.

Images have a complex impact on the viewer; therefore, continuing commercial impression should not be a question of law. The commercial impression test needs clear boundaries, because without them the courts are free to make unstandardized decisions and mislabel their analyses as questions of law. The foundation for the proper analysis is found in the “likelihood of

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187. See *supra* note 30 and accompanying text (recognizing that there is no standard tacking test).

188. See, e.g., *Quiksilver, Inc. v. Kymsta Corp.*, 466 F.3d 749, 759–60 (9th Cir. 2006) (permitting testimony from those familiar with the mark); *Louangel, Inc. v. Darden Rests., Inc.*, 106 U.S.P.Q.2d (BNA) 1809, 1812 (S.D. Tex. 2013) (referencing consumer perceptions of the mark); *Navistar Int’l Transp. Corp. v. Freightliner Corp.*, 49 U.S.P.Q.2d (BNA) 1116, 1121 (N.D. Ill. 1998) (mentioning the lack of a test, while demonstrating that it is appropriate to avoid purely visual comparisons of the marks).

189. See *Mark & Jacoby*, *supra* note 6, at 440 (indicating that there is no test for tacking similar to the “likelihood of confusion” test).

190. See, e.g., *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 1159 (Fed. Cir. 1991) (indicating that a later mark should not vary from what was attempted to be tacked); *KeyCorp v. Key Bank & Trust*, 99 F. Supp. 2d 814, 820 (N.D. Ohio 2000) (considering whether tacking should be allowed where “two marks are used to signify two entirely different legal entities”).

confusion” test. Determining this similar issue involves using data from the marketplace to conclude how viewers of marks react to those images. An accurate measurement of commercial impression for tacking purposes can be gathered from the same pool of data. The use of surveys and other evidence that help determine actual commercial impression is a step towards defining the test and fostering consistency. One commentator suggests that consistency can be achieved by moving to a more fact-based assessment, noting “that a root cause of the problem is the failure to adequately assess continuing commercial impression from the perspective of the consumer.”<sup>191</sup> In turn, consistency would give potential litigants initial guidance regarding whether judicial action is appropriate.<sup>192</sup>

Viewing tacking as a strict question of fact would clarify how these issues should be treated on appellate review. Although measuring tacking as a mixed question of law and fact is a step in the right direction, the proper standard of review on appeal may still be disputed. Mixed questions of law and fact should generally be used when the law is agreed upon, when the facts are undisputed, and when questioning whether the law was properly applied to the available facts.<sup>193</sup> There is a strong argument that the legal standard for tacking is still undecided. While courts apply the notion of continuous commercial impression, no clear definition exists. In order to consider tacking a mixed question a clear definition and test should be agreed upon. Using the three-prong test taken from the “likelihood of confusion” analysis, courts will be provided a consistent standard to decide tacking cases.

#### IV. CONCLUSION

Trademarks exist for source identification in the marketplace and the way tacking is measured should further that purpose. Measuring continuous commercial impression as a question of law is inconsistent with the inherent nature of the design and the identification purpose of the mark. Accurate measurement of commercial impression should be demonstrated by evidence of consumer reaction. Deciding tacking as a question of fact and incorporating evidence of actual consumer impressions brings consistency and accuracy to the tacking test. Furthermore, this approach harmonizes the tacking analysis with other analogous trademark assessments. Permitting judges to decide tacking as a matter of law allows judges to speculate about how others would view the mark. Such a subjective review is a poor legal standard.

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191. See Mark & Jacoby, *supra* note 6, at 448 (noting that it should be assessed from the viewpoint of a consumer and evaluating it as both a “question of fact and law”).

192. See *supra* note 151 and accompanying text.

193. ROBERT E. LARSEN, NAVIGATING THE FEDERAL TRIAL § 14:18 (2014).

