

A Blue Note: The Sixth Circuit, Product Design and the Confusion Doctrines in *Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP*

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I. INTRODUCTION

Gibson Guitar Corp. has offered high quality guitars, including solid-body single-cutaway electric guitars, under the Les Paul (LP) name since 1952.¹ Gibson applied for registration of the LP trademark, the solid-body single-cutaway guitar shape, on July 29, 1987.² However, the United States Patent and Trademark Office did not issue registration of the LP trademark until July 20, 1993.³ On September 27, 1999, the LP trademark became incontestable in accordance with §§ 1065 and 1115(b) of the Lanham Act.⁴ Paul Reed Smith (PRS), a recent entrant into the solid-body single-cutaway electric guitar market, began production of its Singlecut in January 2000 and displayed models at a music tradeshow a month later.⁵ On March 27, 2000, Gibson sent a letter demanding PRS cease and desist production of its Singlecut.⁶ On November 6, 2000, Gibson brought suit against PRS in the federal district court of Nashville, Tennessee, seeking injunctive relief, costs, attorney fees, and treble damages for claims that included trademark infringement and unfair competition.⁷ PRS counterclaimed and sought declaratory and injunctive relief.⁸

1. *Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP*, 423 F.3d 539, 543 (6th Cir. 2005). Although in the 1960s Gibson ceased manufacturing guitars under the LP name, Gibson subsequently resumed manufacturing solid-body, single-cutaway electric guitars under the LP name. *Id.* at 543-44.

2. *Id.* at 544. Gibson’s solid-body single-cutaway guitar is “a traditionally shaped guitar with a portion removed from [the] body of the guitar where the lower section of the fingerboard meets the body of the guitar.” *Id.* at 543 n.3 (quoting *Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP*, 311 F. Supp. 2d 690, 694-95 (M.D. Tenn. 2004)).

3. *Id.* at 544.

4. *Id.* (citing 15 U.S.C.A. §§ 1065, 1115(b) (2000)).

5. *Id.*

6. *Id.*

7. *Id.*

8. *Id.* PRS claimed that

PRS moved for summary judgment on all claims and counterclaims, and Gibson moved for partial summary judgment on its trademark infringement claim.⁹ The district court granted Gibson's motion for partial summary judgment and denied PRS's motion.¹⁰ On July 2, 2004, the district court entered a permanent injunction precluding PRS from producing their new Singlecut.¹¹ PRS filed an interlocutory appeal challenging the injunction and the order granting summary judgment to Gibson and denying PRS summary judgment.¹² The United States Court of Appeals for the Sixth Circuit *held* that postsale confusion is inapplicable in cases where both manufacturers produce goods of comparable quality and declined to extend the initial interest confusion doctrine to the product design context. *Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP*, 423 F.3d 539, 552 (6th Cir. 2005).

II. BACKGROUND

The Lanham Act grants protection to both trademarks and trade dress. The Lanham Act broadly defines a trademark as “any word, name, symbol, or device, or any combination thereof used by a person . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods.”¹³ Generally, trademarks indicate to consumers the source of a particular product, even if the name of the source is unfamiliar.¹⁴ Trademarks also function to indicate product quality and the reputation of the producer, thus creating goodwill in the producer of the trademarked product.¹⁵

While not defined under the Lanham Act, the term “trade dress” originally denoted the distinctive appearance of a product—including labels, wrapping, and containers used to package a product.¹⁶ However, modern practice has included in the concept of trade dress the design and

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- (1) the LP trademark is invalid and unenforceable;
 - (2) the LP trademark is not infringed by the PRS Singlecut;
 - (3) any trade dress associated with the Gibson Les Paul series of guitars cannot be protected under the Lanham Act or is otherwise unenforceable; and
 - (4) the PRS Singlecut guitar does not infringe any such trade dress.

Id.

9. *Id.*

10. *Id.*

11. *Id.* at 545.

12. *Id.*

13. 15 U.S.C. § 1127 (2000).

14. MICHAEL A. EPSTEIN, EPSTEIN ON INTELLECTUAL PROPERTY § 7.01 (4th ed. 2005).

15. *Id.*

16. J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 8:4 (4th ed. 2005).

shape of the product itself.¹⁷ The amended Act also permits “civil action[s] for trade dress infringement . . . for trade dress not registered on the principal register.”¹⁸ In addition, the Lanham Act’s definition of “trademark” appears to encompass trade dress, thereby granting registered packaging and product design trademark protection under the Act.¹⁹

While trademarks have traditionally consisted of words, logos, or other graphic designs, over time, “nontraditional marks,” such as product designs, colors, scents, sounds, and even moving images, have been registered with the United States Patent and Trademark Office and received judicial approval.²⁰ The owner of a nontraditional trademark may register the mark if it distinguishes the source of the product and is not functional or descriptive.²¹

Although registration of a mark is not required, it grants a number of rights to the trademark holder. These rights include federal jurisdiction over the infringement claim (without regard to the amount in controversy or diversity of citizenship of the parties) and the presumption of the validity of the registered mark.²² Subject to a few statutory defenses, a registered trademark will become incontestable after five years of continuous use.²³ For an incontestable mark, registration is “conclusive evidence of the validity of the registered mark . . . and of the registrant’s exclusive right to use the registered mark in commerce.”²⁴ Thus, a mark cannot be challenged on the grounds of mere descriptiveness or for lack of secondary meaning.²⁵

The United States Supreme Court first recognized the validity of nontraditional trademarks and trade dress in *Qualitex Co. v. Jacobson Products Co.*, where the Court held that color may be used as a trademark when it has acquired secondary meaning.²⁶ The Court determined that colors are capable of satisfying the statutory requirement

17. *Id.*

18. 15 U.S.C. § 1125(a)(3).

19. See *Lars Smith, Trade Distinctiveness: Solving Scalia’s Tertium Quid Trade Dress Conundrum*, MICH. ST. L. REV. 243, 247 (2005).

20. See THOMAS P. ARDEN, PROTECTION OF NONTRADITIONAL MARKS 1, 7 (2000).

21. Jerome Gilson & Anne Gilson LaLonde, *Cinnamon Buns, Marching Ducks and Cherry-Scented Racecar Exhaust: Protecting Nontraditional Trademarks*, 95 TRADEMARK REP. 773, 774 (2005).

22. 15 U.S.C. §§ 1057(b), 1121.

23. See *id.* § 1065. The statutory defenses to an incontestable trademark include: (1) that registration of the mark was fraudulently obtained, (2) that the mark has been abandoned, (3) that the mark is functional, and (4) that the mark has become generic. § 1115(b).

24. *Id.* § 1115(b).

25. See *Sunrise Jewelry Mfg. Corp. v. Fred S.A.*, 175 F.3d 1322, 1325 (C.A. Fed. 1999).

26. 514 U.S. 159, 163 (1995).

that a mark holder use or intend to use the mark to indicate the source of the product and distinguish it from competing products.²⁷ The Supreme Court was not persuaded by the competitor's argument that since there is a limited number of colors available, color should be denied trademark protection.²⁸ The Court found instead that the functionality doctrine adequately protects competitors.²⁹ The functionality doctrine forbids the use of product features as a trademark where doing so will put competitors at a significant disadvantage because such features are essential to the "use or purpose" of the product or affect its cost or quality.³⁰ Therefore, if the recognition of trademark rights would significantly hinder competition, the court may deem the color functional, thereby precluding trademark protection.³¹

Subsequently, the Supreme Court extended the *Qualitex* holding to the product design context. In *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, the Court found that product design trade dress may be protected under the Lanham Act upon a showing of secondary meaning.³² Unlike categories of marks such as word marks or product packaging trade dress, whose purpose is generally to identify the source of the product (and therefore may be "inherently distinctive"), product designs, as well as color, do not necessarily "equate the feature with the source."³³ Therefore, the Court found that a showing of secondary meaning is required for a product design to warrant protection from infringement under the Lanham Act.³⁴

Infringement of a registered mark is determined by whether the junior user's mark is "likely to cause confusion, or to cause mistake, or to deceive."³⁵ A showing of actual consumer confusion is not necessary in

27. *Id.* at 162; see 15 U.S.C. § 1127.

28. See *Qualitex*, 514 U.S. at 168.

29. *Id.*

30. *Id.* at 169.

31. See *id.* at 170 (citing RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17, cmt. c (1993)).

32. 529 U.S. 205, 216 (2000). The Court distinguished its prior holding in *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992). In *Two Pesos*, the Court held that trade dress can be inherently distinctive and protectable under § 43(a) of the Lanham Act without a showing of secondary meaning. See *id.* at 773-76. The *Wal-Mart* Court distinguished *Two Pesos* as applying solely to product packaging and not product design. See *Wal-Mart*, 529 U.S. at 215.

33. *Wal-Mart*, 529 U.S. at 212-13. Justice Scalia took a modern approach by referring to product design as a protectable "trade dress" rather than a trademark. However, once a product design has been registered as a trademark under the Lanham Act, it is granted protection as a trademark under § 43(a) as a trademark, rather than under § 2 as unregistered trade dress. See *id.* at 209-11.

34. *Id.* at 216.

35. 15 U.S.C. § 1114(1)(a) (2000).

order to demonstrate infringement.³⁶ Rather, a plaintiff need only prove that a reasonable purchaser is likely to be confused as to source, endorsement, affiliation, or sponsorship between the plaintiff's and defendant's products or services.³⁷

By judicial interpretation of the Lanham Act, the federal courts have generally formulated three types of confusion in determining the "likelihood of confusion" of a trademark: initial-interest confusion, point-of-sale confusion, and postsale confusion.³⁸ Initial-interest confusion occurs when a potential purchaser is attracted to an infringing product because of confusingly similar marks, even if the consumer discovers that the product is not manufactured by the trademark holder prior to purchase.³⁹ For example, the United States Court of Appeals for the Fifth Circuit found that the Velvet Elvis night club would cause potential customers to mistakenly believe that the bar was associated with or licensed by the estate of Elvis Presley.⁴⁰ The court stated, "[I]nitial-interest confusion is beneficial to the Defendants because it brings patrons in the door Once in the door, the confusion has succeeded because some patrons may stay, despite realizing that the bar has no relationship with [the estate of Elvis Presley]."⁴¹ Point-of-sale confusion, the most common and widely recognized type of confusion, occurs when the purchaser is confused as to the source of the infringing product at the time of purchase.⁴² Postsale confusion occurs when potential consumers see an infringing mark in use by other consumers and believe it to be the trademarked product.⁴³

The confusion doctrines seek to protect the economic interests and reputation of the producers and consumers. The Supreme Court has stated that the Lanham Act "secure[s] to the owner of the mark the goodwill of his business."⁴⁴ In enacting the Lanham Act, Congress sought to promote competition and maintain quality in the marketplace

36. See *World Carpets, Inc. v. Dick Littrell's New World Carpets*, 438 F.2d 482, 489 (5th Cir. 1971).

37. 15 U.S.C. § 1125(a)(1)(A). In addition to initial-interest, point-of-sale, and postsale confusion, six circuits have adopted the doctrine of reverse confusion. See MCCARTHY, *supra* note 16, § 23:10. Reverse confusion occurs when a junior producer saturates the market and overwhelms the senior producer resulting in a loss of product identity and goodwill. See *id.*

38. RICHARD L. KIRKPATRICK, *LIKELIHOOD OF CONFUSION IN TRADEMARK LAW* § 1.7 (1995).

39. *Id.*

40. *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 204 (5th Cir. 1998).

41. *Id.*

42. See MCCARTHY, *supra* note 16, § 23:1.

43. See *id.*

44. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992) (quoting *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985) (internal quotation omitted)).

by protecting a producer's reputation from infringing competitors.⁴⁵ Judge Learned Hand, writing for the United States Court of Appeals for the Second Circuit, articulated this reputational interest, stating that a manufacturer's mark

is his authentic seal; by it he vouches for the goods which bear it; it carries his name for good or ill. If another uses it, he borrows the owner's reputation, whose quality no longer lies within his own control. This is an injury, even though the borrower does not tarnish it, or divert any sales by its use; for a reputation, like a face, is the symbol of its possessor and creator, and another can use it only as a mask. And so it has come to be recognized that, unless the borrower's use is so foreign to the owner's as to insure against any identification of the two, it is unlawful.⁴⁶

When determining likelihood of confusion, courts generally use a multifactor test. Although the factors in each circuit vary, the test adopted by the Sixth Circuit in *Frisch's Restaurants, Inc. v. Elby's Big Boy of Steubenville, Inc.* is typical.⁴⁷ The Sixth Circuit weighed the following eight factors: (1) the strength of the plaintiff's mark, (2) the relatedness of the goods, (3) the similarity of the marks, (4) the 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 expansion of the product lines.⁴⁸

III. THE COURT'S DECISION

In the noted case, the Sixth Circuit refused to adopt the initial-interest confusion doctrine in the product design context and found that the postsale confusion doctrine is inapplicable to cases where allegedly infringing products are of comparable quality. After outlining the procedural history and factual background of Gibson's case, the court "took [the] opportunity to clarify" the distinction between trademark law and trade dress law.⁴⁹ The court believed that the district court confused trademark and trade dress law in determining that Gibson's mark covered the entire guitar, rather than the two-dimensional silhouette.⁵⁰ The district court believed that the two-dimensional drawing included in the

45. *See id.*

46. *Yale Elec. Corp. v. Robertson*, 26 F.2d 972, 974 (2d Cir. 1928) (emphasis added).

47. 670 F.2d 642, 648 (6th Cir. 1982), *cert. denied*, 459 U.S. 916 (1982).

48. *Id.* (adopting the Ninth Circuit's test set forth in *Toho Co. v. Sears, Roebuck & Co.*, 645 F.2d 788 (9th Cir. 1981)); *see* KIRKPATRICK, *supra* note 38, § 2.4 (listing each circuit's test for likelihood of confusion).

49. *Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP*, 423 F.3d 539, 546 (6th Cir. 2005).

50. *Id.*

registered mark should be construed to create a trademark on the entire guitar.⁵¹ The Sixth Circuit stated that trademark and trade dress are two distinct legal concepts, and while the Lanham Act defines a trademark, trade dress is not explicitly defined in the Act.⁵² Citing the Supreme Court, the Sixth Circuit described trade dress as the “design or packaging of a product which has acquired a secondary meaning sufficient to identify the product with its manufacturer or source.”⁵³

Next, the court stated that the burden was on Gibson to show that the PRS Singlecut was likely to cause confusion among consumers regarding its origin.⁵⁴ In reaching its determination, the court used the eight *Frisch* factors.⁵⁵ The district court concluded that, with the exception of actual confusion, all of the *Frisch* factors favored Gibson for purposes of summary judgment.⁵⁶ While the district court concluded that initial-interest confusion could occur in the marketplace as to the source of PRS’s guitar, the Sixth Circuit disagreed.⁵⁷ The court further concluded that Gibson could not prevail on any theory of confusion.⁵⁸ Therefore, the court found it unnecessary to discuss the remaining factors.⁵⁹

Next, the court discussed Gibson’s arguments of initial-interest and postsale confusion. Gibson argued that despite the lack of actual confusion at the point of sale, the district court’s decision should be affirmed under either initial-interest or postsale confusion, or a combination of both.⁶⁰ After defining initial-interest and postsale confusion, the court concluded that “neither initial-interest confusion, nor post-sale confusion, nor any combination of the two is applicable.”⁶¹

The court then discussed the single Sixth Circuit case that applied the initial-interest confusion doctrine. In *PACCAR Inc. v. TeleScan Technologies, L.L.C.*, the Sixth Circuit encountered a dispute between TeleScan, a company that operated used-truck-locator Web sites, and PACCAR, a truck manufacturer that operated its own used-truck-locator

51. *Id.*

52. *Id.* at 547.

53. *Id.* (quoting *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 28 (2001) (internal quotation omitted)).

54. *See id.* at 548.

55. *See id.*

56. *See id.* Because there was no evidence of point-of-sale confusion, the fourth factor favored PRS. *See id.*

57. *See id.* at 549.

58. *Id.*

59. *Id.*

60. *Id.*

61. *Id.*

Web site.⁶² TeleScan used trademarks owned by PACCAR as part of an Internet domain name on its used-truck-locator Web site.⁶³ In deciding *PACCAR*, the Sixth Circuit found that initial-interest confusion might apply since an infringing domain name may misdirect consumers searching for Web sites associated with the trademark owner.⁶⁴ However, in the noted case, the Sixth Circuit stated that their decision in *PACCAR* did not rest on initial-interest confusion.⁶⁵ Rather, the Sixth Circuit stated that *PACCAR* focused primarily on three other *Frisch* factors determined to be particularly important in an Internet domain name case.⁶⁶ The court stated that their concern in *PACCAR* was similar to other circuits applying the initial-interest confusion doctrine, namely whether the consumer might be misled about the source of the product.⁶⁷

The Court believed that Gibson's initial-interest confusion argument is "essentially . . . that the shape of the PRS guitar leads consumers standing on the far side of the room in a guitar store to believe they see Gibson guitars and walk over to examine what they soon realize are PRS guitars."⁶⁸ The court declined to adopt such a broad reading of the initial interest confusion doctrine.⁶⁹ The court believed that many, if not most, consumer products may appear similar to their competitors at a distance.⁷⁰ The court further stated that it believed even "*dissimilar* products . . . might appear, from the far end of an aisle in a warehouse store, somewhat similar to a trademarked shape."⁷¹ In a footnote, the court stated its fear that if they extended the initial-interest confusion doctrine to the product design context, markholders would be able to not only protect the actual product shape, but create a "penumbra" of protection around a mark.⁷² Because the court determined that even dissimilar products would appear similar when initially viewed from afar,

62. *Id.* at 550 (citing *PACCAR Inc. v. TeleScan Techs., L.L.C.*, 319 F.3d 243 (6th Cir. 2003)).

63. *Id.* (citing *PACCAR*, 319 F.3d at 253).

64. *Id.* at 550-51 (citing *PACCAR*, 319 F.3d at 254-55).

65. *See id.*

66. *See id.*

67. *See id.*

68. *Id.* at 552.

69. *Id.*

70. *Id.*

71. *Id.*

72. *Id.* at 550 n.15 ("[A]pplication of the initial-interest-confusion doctrine to product shapes would allow trademark holders to protect not only the actual product shapes they have trademarked, but also a 'penumbra' of more or less similar shapes that would not otherwise qualify for trademark protection.").

the court held that initial-interest confusion could not substitute for point-of-sale confusion in the product design context.⁷³

Next, the court analyzed Gibson's postsale confusion argument. The court found that *Esercizio v. Roberts*, the only case in which the Sixth Circuit had applied the postsale confusion doctrine, was clearly distinguishable from the facts before it.⁷⁴ Although the *Esercizio* court was concerned that Ferrari's reputation could be damaged by the marketing of "clearly inferior" replicas, in the instant case the court found that "PRS guitars are not clearly inferior to Gibson's guitars."⁷⁵ Therefore, the court quickly dismissed Gibson's theory of postsale confusion as inoperative in the product design context.⁷⁶

The court then discussed what it derisively termed Gibson's "smoky-bar theory of confusion."⁷⁷ Gibson argued that consumer confusion occurs under a combination of the initial-interest and postsale confusion doctrines when potential purchasers see a musician playing a PRS guitar and believe it to be a Gibson.⁷⁸ Since Gibson conceded that PRS produces high-quality guitars, the court did not believe that such an occurrence would be harmful to Gibson.⁷⁹ If a potential purchaser saw a musician playing what he believed was a Gibson, the court believed the "logical result" would be that he or she would attempt to purchase a Gibson guitar, which would help, rather than harm, Gibson.⁸⁰

Finally, the court summarized its decision, stating that neither initial-interest confusion, postsale confusion, nor a combination of the two was applicable to the facts before it.⁸¹ Further, the court stated that since point-of-sale confusion does not occur, and Gibson could not show confusion that would violate the Lanham Act, PRS, rather than Gibson, must be granted summary judgment.⁸² Accordingly, the Sixth Circuit reversed the district court's decision, vacated the permanent injunction issued by the district court, denied all other claims as moot, and remanded the case to the district court with instructions that summary judgment be entered in favor of PRS.⁸³

73. *Id.* at 552.

74. *See id.* (citing *Esercizio v. Roberts*, 994 F.2d 1235 (6th Cir. 1991), *cert. denied*, 505 U.S. 1219 (1992)).

75. *Id.*

76. *See id.*

77. *Id.*

78. *Id.* at 552-53.

79. *See id.* at 553.

80. *Id.*

81. *Id.*

82. *Id.*

83. *Id.*

Judge Kennedy concurred in part and dissented in part. Kennedy agreed that the district court erred in granting summary judgment in favor of Gibson and that Gibson could not maintain its trademark infringement claim on a theory of point-of-sale or postsale confusion.⁸⁴ However, Kennedy dissented because he believed that Gibson should be able to present evidence to maintain a trademark infringement claim on the theory of initial-interest confusion.⁸⁵ The dissent began by recognizing that initial-interest confusion is recognized in the Sixth Circuit and that product shape may serve as a trademark because it can identify the source of the product.⁸⁶ The dissent believed that a holder of a product shape trademark, whose product shape identifies the product's source, should not be precluded from presenting evidence that a competitor's product shape "causes consumers to be attracted to it because of its similarity to a trademark holder's mark."⁸⁷

The dissent found the majority's concern regarding the initial-interest confusion doctrine's application to product shape misplaced. The dissent deemed the evidence that a competitor's product shape is similar to a trademark holder's product shape irrelevant, unless the shape identifies the source of the product when viewed from afar.⁸⁸ The dissent believed that a product shape trademark holder will not be able to show initial-interest confusion unless it can first show that the product shape identified the source from the vantage point where the confusion allegedly occurred.⁸⁹ Since this preliminary question is disputed, the dissent argued for remand with consideration as to whether Gibson's guitar serves to identify its source from the distance where the confusion is alleged to have occurred.⁹⁰

IV. ANALYSIS

The Sixth Circuit's decision suffers from two major problems. First, the Sixth Circuit should have extended initial-interest confusion to the product design context or provided reasoning for failing to do so. Second, by rejecting Gibson's postsale confusion claims, the Sixth Circuit ignored and defeated the recognized policy behind the Lanham Act of protecting the reputation and goodwill of the producers.

84. *Id.* at 553-54 (Kennedy, J., dissenting).

85. *See id.* at 554.

86. *See id.*

87. *Id.*

88. *Id.* at 554-55.

89. *Id.* at 555.

90. *Id.* at 556.

The Sixth Circuit's primary reason for failing to adopt the initial-interest confusion doctrine in the product design context is that Gibson's circumstances were "strikingly different" from those of *PACCAR*. This reasoning is incomplete and evasive. Product design is entitled to protection under the Lanham Act. The Sixth Circuit restricted the initial-interest doctrine by merely distinguishing the facts before it from that of *PACCAR* and stating its fear of granting a mark holder protection over a "penumbra" of product shapes. This does not address why the initial-interest confusion should apply to Internet domain names and not to product designs.

The dissent adopts a somewhat better rule; however, the requirement for source identification at the vantage point where infringement allegedly occurred may prove unworkable. Initial-interest confusion in the product design context should involve a two-step analysis. First, the producer claiming infringement should be required to show that its product shape has acquired secondary meaning and is therefore source identifying. Second, the fact-finder should determine whether a competitor's product causes initial-interest confusion due to its similarity to a trademark holder's shape.⁹¹ However, if a trademark has become incontestable under the Lanham Act, the product shape should be presumed to be source identifying.⁹²

The majority is concerned that applying the initial-interest confusion doctrine to the product design context would allow a trademark holder not only to protect the actual product shape, but also to create a "penumbra" of protection around a mark. This concern is unfounded. The dissent correctly states that if other products appear similar from afar, it is unlikely that the mark's product shape will identify its source, thereby precluding a claim of initial-interest confusion. In the context of an incontestable mark, the presumption of source identification may be rebutted upon a showing that the product cannot be distinguished from an allegedly infringing product from the distance where the alleged infringement occurs. In addition, the Supreme Court has stated that a product design may be found to be "legally functional, and thus unprotectable, if it is one of a limited number of equally efficient options available to competitors and free competition would be

91. Initial-interest confusion may occur at a variety of vantage points and distances, and would therefore be extremely fact-intensive. When claimed, initial-interest confusion should be a substitute for actual confusion under the Sixth Circuit's *Frisch* factors and therefore be merely one factor considered.

92. Under the Lanham Act, a mark cannot be challenged for lack of secondary meaning after it has become incontestable. *See supra* note 23 and accompanying text.

unduly hindered by according the design trademark protection.”⁹³ Therefore, if a limited number of shapes exist and competition would be stifled by protecting the shape, even an incontestable mark may be challenged as functional, thereby subjecting the mark to cancellation.

In finding that the postsale confusion doctrine is inapplicable to circumstances where the products are of comparable quality and price, the Sixth Circuit disregarded established policies of trademark law. The Sixth Circuit’s reasoning for rejecting Gibson’s postsale confusion claims rested solely on the fact that, while *Esercizio* involved two products with disparate qualities and prices, PRS’s guitar was not “clearly inferior” to Gibson’s singlecut. The Sixth Circuit failed to recognize that any infringing product may damage Gibson’s reputation and goodwill.⁹⁴ Actionable confusion does not only result from a direct loss of sales, but also from a producer using the reputation and goodwill of another.⁹⁵ The Sixth Circuit makes great note of the comparative quality of the products. However, the actual quality of the goods is irrelevant; rather, the producer should be entitled to maintain the future quality of its mark and prevent infringers from benefiting from the quality of the mark holder’s product.⁹⁶ If PRS has used Gibson’s mark to its gain, the similarity between the marks will relinquish quality control of Gibson’s mark to PRS. While PRS currently produces high-quality guitars, there is no guarantee that PRS will not begin mass-producing cheap, poor quality PRS Singlecuts, thereby diluting Gibson’s mark. Therefore, product shapes capitalizing on the goodwill or reputation of a competing producer, should be found unlawful under the Lanham Act.

Thomas P. Haggerty*

93. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 775 (1992).

94. Indeed, the Sixth Circuit implicitly recognized in *Esercizio* trademark law’s policy of protecting the reputation and goodwill of the mark holder. *See Esercizio v. Roberts*, 944 F.2d 1235, 1244-45 (6th Cir. 1991) (citing *Rolex Watch, U.S.A., Inc. v. Canner*, 645 F. Supp. 492-93, 495 (S.D. Fla. 1986)), *cert. denied*, 505 U.S. 1219 (1992).

95. *See* MCCARTHY, *supra* note 16, § 23:5.

96. *See Shell Oil Co. v. Commercial Petroleum, Inc.*, 928 F.2d 104, 107 (4th Cir. 1991) (citing *El Greco Leather Prods. Co. v. Shoe World*, 806 F.2d 392, 395 (2d Cir. 1986)).

* J.D. candidate 2007, Tulane University School of Law; B.S. 2003, Florida State University.