

Trademark or Servicemark Infringement – Common Law Claim

PLF claims that DFT competed unfairly by distributing [or selling] products [services] with PLF's distinctive symbol [substitute more specific word as relevant such as label, logo, etc]. To prove this claim, PLF must show the following three things are more likely true than not true:

1. that when DFT started using PLF's symbol [or other term used above], the public recognized that symbol [or other term] as identifying PLF's products [services] and distinguishing them from other products [services];
2. that DFT used the symbol [or other term used above] in a way that would likely cause the public [consumer, customer, purchaser] to confuse DFT's products [services] with PLF's products [services]; and
3. that DFT's actions caused harm to PLF.¹

(a) Association of Symbol with Single Source

PLF must first prove that the public recognized PLF's symbol [or other term used above] as identifying PLF's products [services] and distinguishing them those of other companies.

For example, the public associates Nike's "Swoosh" and McDonald's golden arches with a specific company. The public does not need to know the exact identity of the company as long as a significant portion of the public connects the symbol [or other terms used above] with just one source. For instance, the public may recognize the "Swoosh" as a logo associated with a specific source without remembering that the source is Nike.

PLF does not need to prove that all or even a majority of the public connects the symbol [or other word used above] to one particular source. PLF does, however, have to show that a significant portion of the public

¹ See *Planned Parenthood Fed'n of America v. Problem Pregnancy of Worcester*, 398 Mass. 480 (1986); *Datacomm Interface, Inc. v. Computerworld, Inc.*, 396 Mass. 760, 769 (1986).

connects the symbol [or other terms used above] with just one source. To decide whether the number is significant, you may look at things such as:

- how long PLF has used the symbol [or other word used above];
- the nature and extent of PLF's advertising, promotion, and other efforts to promote the connection between the symbol [or other term used above];
- sales volume;
- consumer surveys;
- testimony of consumers about the meaning of the symbol [or other term used above]; and
- the unique nature of the symbol [or other term used above].²

(b) Likelihood of Confusion

Second, PLF must prove that DFT used the symbol in a way that was reasonably likely to confuse the public [consumer, customer, purchasers] about the source of the product [service]. In other words, you must find that purchasers who are buying under the usual conditions and exercising ordinary care would believe that PLF had produced [or other relevant term] DFT's products. PLF does not need to prove the DFT intended to deceive the public by using PLF's symbol [or other term used above].³ PLF does not have to prove that any specific person was confused or misled. It is enough to show that a reasonable customer would be confused about the product's [service's] source.

² See *Boston Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1, 12 (1st Cir. 2008); *Castricone v. Mical*, 74 Mass. App. Ct. 591, 594 (2009); *Planned Parenthood Fed'n of Am., Inc. v. Problem Pregnancy of Worcester, Inc.*, 398 Mass. 480, 485–496 (1986) (citing 1 J. T. McCarthy, McCarthy on Trademarks and Unfair Competition § 15:1(A) (2d ed.1974)); *Paramount Beverage Co. v. Davis Sq. Liquors, Inc.*, 354 Mass. 272, 274 (1968).

³ *Monroe Stationers & Printers, Inc. v. Munroe Stationers, Inc.*, 332 Mass. 278, 280 (1955).

< ***Alternative Instruction for “Palming Off”***⁴> PLF does not have to show that the public recognizes PLF’s symbol [or other term used above] as identifying [his/hers/its] products [services] and distinguishing them those of other companies if [he/she/it] proves DFT intentionally copied the symbol [or other term used above] in order to mislead consumers about the source of the product [service]; in other words, if DFT tried to “palm off” [his/hers/its] product [service] as having been made [or other relevant term] by PLF. [perhaps the instruction should include a cross-reference to the definition of “intentional” – assuming that the General Instructions committee is drafting one – or perhaps we need a Civil Definitions instruction, as exists for the Dist. Ct. Model Crim. Instructions]

< ***If applicable--Functional/Nonfunctional***⁵> PLF must prove that, more likely than not, the symbol [or other term used above] did not serve a practical purpose. PLF cannot recover damages for unfair competition if PLF’s symbol [or other term used above] is essential to the product’s use or affects its quality or cost. A symbol [or other term used above] may serve a practical purpose if it makes it easier to manufacture the product or contributes to the product’s use, reliability, and ease of use. For example, the design of a dental implant serves a practical purpose when its size, shape, and materials are essential to the product’s use, quality, and cost.⁶

If you find PLF’s symbol (or other term as used above) served a practical purpose, DFT was free to use it.

⁴ See *Datacom Interface, Inc. v. Computer World, Inc.*, 396 Mass. 760 (1986). See also *Shire City Herbals, Inc. v. Blue*, 410 F. Supp. 3d 270 (2019).

⁵ The Massachusetts state courts have not addressed whether the plaintiff has the burden of proving functionality or if it is an affirmative defense to proven by the defendant. While there is a split of authority in the federal courts, the majority, including the First Circuit, place the burden on the plaintiff. See e.g. *I.P. Lund Trading Aps v. Kohler Co.*, 163 F.3d 27, 37–38 (1st Cir. 1998). See generally, *The Burden of Proof in Determinations of Trade Dress Functionality*, 88 Trademark Rep. 325, 329 (1998).

⁶ *Staumann Cr. v. Lifecore Biomedical, Inc.*, 278 F. Supp. 2d 130, 137 (D. Mass. 2003).

(c) Damages

If PLF has proved its claim for unfair competition, you may award damages for the harm caused to PLF.

PLF seeks damages for the value of the goodwill lost as a result DFT's unfair competition. Goodwill is an employer's favorable reputation and relationship with its customers. The goodwill attached to a product [service] is a part of the overall business value. PLF must prove that DFT injured his/her/its goodwill either by injury to PLF's general business reputation or by damage to the reputation of a particular product. If so, you should award damages to PLF. The amount of damages is the difference between the value of the goodwill before and after DFT's wrongful actions.

You may also consider other losses the PLF suffered because of DFT's conduct, including lost profits. [Alternatively: You may base your award on the amount by which DFT profited by using PLF's symbol [or other term used above].⁷

To determine the amount of lost profits, first, determine the amount of sales PLF would have achieved but for the DFT's unfair competition with PLF. Second, subtract any costs and expenses that you find PLF would have incurred in making those sales.

If you decide that DFT did not cause any monetary damages to PLF [alternatively: DFT has not profited], you still must award some minimal damages such as \$1.

⁷ See *Jet Spray Cooler v. Crampton*, 377 Mass. 159, 169–170 (1979).