Hasbro, Inc. v. Lanard Toys, Ltd.: G.I. Joe Emerges from Trademark Wars Victorious but Second Circuit Continues Search for Appropriate Scope of Review

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HASBRO, INC. v. LANARD TOYS, LTD.:  
G.I. JOE EMERGES FROM TRADEMARK WARS VICTORIOUS BUT SECOND CIRCUIT CONTINUES SEARCH FOR APPROPRIATE SCOPE OF REVIEW

The Lanham Act of 1946 provides holders of trademarks with statutory protection against trademark infringement.\(^1\) The statute was designed to prevent consumer confusion between products marketed by the trademark holder and those marketed by competitors seeking to use identical or similar marks.\(^2\) To warrant protec-

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\(^1\) Lanham Act, ch. 540, 60 Stat. 427 (1946) (codified as amended at 15 U.S.C. §§ 1051-1127 (1982 & Supp. V 1987)). The Lanham Act defines a trademark as including “any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify and distinguish his goods . . . from those manufactured or sold by others.” 15 U.S.C. § 1127 (Supp. V 1987). Trademark law is recognized as but a part of the law of unfair competition, and this entire legal area evolved out of the tort law concepts of fraud and deceit. See 1 J. McCarthy, TRADEMARKS AND UNFAIR COMPETITION § 5:2 (2d ed. 1984); Kurtz, The Independent Legal Lives of Fictional Characters, 1986 Wis. L. Rev. 429, 474-75. Today, trademark infringement differs from early forms of unfair competition in that a plaintiff does not have to show the competitor has deliberately infringed, but rather, that the alleged infringing use has created a likelihood of confusion between the two products. See E. Kintner & J. Lahr, AN INTELLECTUAL PROPERTY LAW PRIMER 274 (2d ed. 1982).

Section 43(a) provides protection for trademarks that are not formally registered under the Act’s other provisions. See Lanham Act § 43(a), 15 U.S.C. § 1125(a) (1982). The intent of Congress in enacting section 43(a) of the Lanham Act was to fashion a new federal remedy for a category of unfair competition protected under the common law. See Norman M. Morris Corp. v. Weinstein, 466 F.2d 137, 141 (5th Cir. 1972); F.E.L. Publications Ltd. v. National Conference of Catholic Bishops, 466 F. Supp. 1034, 1044 (N.D. Ill. 1978). Further, section 43(a) has been held to protect various designs and characteristics that the public identifies with a specific product or manufacturer. See, e.g., Warner Bros. v. Gay Toys, Inc., 658 F.2d 76, 78 (2d Cir. 1981) (“General Lee” automobile from “Dukes of Hazard” television show); Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200, 203 (2d Cir. 1979) (Dallas Cowboys Cheerleader costumes); DC Comics, Inc. v. Filmaton Assocs., 486 F. Supp. 1273, 1277 (S.D.N.Y. 1980) (“Aquaman” and “Plastic Man” cartoon characters). While the Lanham Act provides for protection of certain trademarks, it may also forbid the use of certain symbols, slogans, or names as trademarks. See, e.g., Bromberg v. Carmel Self Serv., Inc., 198 U.S.P.Q. (BNA) 176, 177 (Pat. & Trademark Off. 1978) (restaurant service mark, “Only a Breast in the Mouth is Better than a Leg in the Hand,” opposed on ground that mark indecent, obscene, and chauvinistic).

\(^2\) See Lanham Act § 45, 15 U.S.C. § 1127 (1982). Section 45 provides in part that the statute was intended “to regulate commerce . . . by making actionable the deceptive and misleading use of marks [and] to protect persons engaged in such commerce against unfair competition.” Id.; see also Home Box Office, Inc. v. Showtime/The Movie Channel, Inc., 832
tion under the Lanham Act, the trademark must satisfy a multi-
tripronged test enunciated by the United States Court of Appeals
for the Second Circuit in Abercrombie & Fitch Co. v. Hunting
World, Inc. If it is found that a trademark is protectible and has
been infringed upon, a party may be entitled to a preliminary in-
junction, an equitable remedy granted at the discretion of the trial
court. An appellate court may not set aside a lower court’s order

F.2d 1311, 1314 (2d Cir. 1987) (Lanham Act designed to prevent likely confusion in minds of
same). See generally E. KINTNER & J. LAHR, supra note 1, at 271 (purpose of Lanham Act
to protect consumers from purchasing goods mistakenly believed to be goods of another).

Registration with the United States Patent and Trademark Office is not a requirement
for protection under section 43(a) of the Lanham Act. See Warner Bros., 658 F.2d at 77-78;
action arises when a trademark or trade name is likely to confuse or deceive purchasers as to
the source or origin of a particular product. See Metric & Multistandard Components Corp.
v. Metric’s, Inc., 635 F.2d 710, 714 (8th Cir. 1980); Quabaug Rubber Co. v. Fabiano Shoe
733, 746 (S.D.N.Y.), aff’d, 497 F.2d 1343 (2d Cir. 1974). Section 43(a) of the Lanham Act is
interpreted as remedial in nature and is generally applied broadly to effectuate that inter-
pretation. See Purolator, Inc. v. EFRA Distrib., 687 F.2d 554, 560-61 (1st Cir. 1982); Matern-
nally Yours, Inc. v. Your Maternity Shop, Inc., 234 F.2d 538, 546 (2d Cir. 1956) (Clark, C.J.,
concurring).

§ 3 537 F.2d 4 (2d Cir. 1976). The four categories that measure the degree of protection a
mark merits are, in ascending order of protection: generic, descriptive, suggestive, and arbi-
trary or fanciful. See id. at 9. A generic mark is entitled to no protection. See id. A generic
term conveys information regarding the nature of a product and can attach to goods manu-
factured by numerous producers. See 3 R. CALLMANN, THE LAW OF UNFAIR COMPETITION,
TRADEMARKS, AND MONOPOLIES § 18.03, at 9-13 (4th ed. 1983). Descriptive marks—which
describe the qualities, ingredients, or characteristics of a product—are protectible only when
a secondary meaning can be established. See Thompson Medical Co. v. Pfizer, Inc., 753 F.2d
208, 212-13 (2d Cir. 1985); Elizabeth Taylor Cosmetics Co. v. Annick Goutal, S.A.R.L., 673
F. Supp. 1238, 1243 (S.D.N.Y. 1987); 3 R. CALLMANN, supra, § 18.03, at 12. Secondary mean-
ing is established when a claimant shows “consumers have come to associate [the mark]
with a particular manufacturer or source.” See Perfect Fit Indus. v. Acme Quilting Co., 618
F.2d 950, 953 (2d Cir. 1980), cert. denied, 459 U.S. 832 (1982); see also infra note 53 (ele-
ments of secondary meaning). A suggestive mark is eligible for protection without proof of
secondary meaning. See Thompson Medical, 753 F.2d at 213. Arbitrary or fanciful marks
are also entitled to full protection without a showing of secondary meaning. See Abercrom-
bie & Fitch, 537 F.2d at 11.

fringement of registered marks); see also Banff, Ltd. v. Federated Dept Stores, Inc., 841
F.2d 486 (2d Cir. 1988) (Bloomingdale’s enjoined from using “B Wear” mark on its apparel);
enjoined from using magazine title “Playmen”).

“court may deem reasonable”; see, e.g., Hecht Co. v. Bowles, 321 U.S. 321, 329 (1944) (dis-
cussing discretionary nature of equitable relief); Charles of the Ritz Group, Ltd. v. Quality
against alleged infringer), aff’d, 832 F.2d 1317 (2d Cir. 1987).
granting or denying an injunction absent a finding that the factual basis for the trial court's action was either clearly erroneous or the result of an improvident exercise of judicial discretion. Recently,
however, in *Hasbro, Inc. v. Lanard Toys, Ltd.*, the Second Circuit reversed a magistrate's order denying a motion for a preliminary injunction against an alleged infringing party but failed to clearly state the legal grounds for doing so.\(^8\)

The appellant, Hasbro, Inc. ("Hasbro"), manufactures toy military figures marketed under the unregistered trademark "G.I. JOE."\(^9\) The "G.I. JOE" line consists of individual characters each with his or her own code name.\(^9\) From 1983 to 1985, and again in 1987, Hasbro's toy line included a military figure whose code name was "GUNG-HO."\(^11\) In January 1987, the respondent, Lanard Toys, Ltd. ("Lanard"), introduced its own line of toy military figures under the trademark "GUNG-HO!."\(^12\) The appearance of the figures and the packaging of the "GUNG-HO!" line were substantially similar to those of the "G.I. JOE" line.\(^13\) Hasbro brought suit under the Lanham Act to prevent the further marketing of "GUNG-HO!" by Lanard and, alleging trademark infringement and unfair competition, moved for a preliminary injunction.\(^14\) The

\(^7\) 858 F.2d 70 (2d Cir. 1988).

\(^8\) See id. at 71.

\(^9\) Id. at 71. Hasbro, a Rhode Island corporation, is the world's largest toy manufacturer. Id.

\(^10\) Id. The "G.I. JOE" line consisted of thirty-four characters, "each with his or her own real name, code name, uniform, military specialty, biography, and personality." Id.

\(^11\) Id. In 1983, Hasbro introduced the figure/character "'Ettienne R. LaFitte'—code name 'GUNG-HO'—a bare-chested tattooed marine" into its "G.I. JOE" line. Id. The toy figure was removed from the line in 1986 but was reintroduced in 1987 in a distinctive, full-dress marine uniform. Id. In addition to its toy sales, Hasbro promoted its characters, including "GUNG-HO," through licensing of comic books, book cover illustrations, and album covers. Id. at 72. Since 1983, Hasbro had spent over $65 million to promote its "G.I. JOE" line; however, Hasbro could not specify what portion of that amount was attributable to the "GUNG-HO" character. Id. Sales of the "G.I. JOE" line in 1986 amounted to $170 million (13 percent of the corporation's total sales). Id. Since 1983, Hasbro had shipped close to two million "GUNG-HO" figures. Id.

\(^12\) Id. Lanard, a Hong Kong corporation, had commissioned a toy designer to create a product to compete with other toy companies in the secondary market for action figures. Id. Lanard had not advertised, marketed, or promoted the "GUNG-HO!" line except for a 1987 catalogue and a 1987 toy fair. Id. In 1987, Lanard shipped over $350,000 (retail value) of this line, accounting for four percent of its total sales. Id.

\(^13\) Id. Like Hasbro's "G.I. JOE" line, Lanard's figures were 3¾ inch plastic figures, each with its own code name, and sold in blister-card packaging. Id. Lanard's packaging for accessories even included a claim that they were for use with "G.I. JOE" figures. Id.

\(^14\) Id. Hasbro originally brought suit in New York State Supreme Court, alleging common law unfair competition, but Lanard removed the action to the United States District Court for the Southern District of New York. Id. Hasbro was then permitted to amend its complaint to explicitly assert the Lanham Act cause of action. Hasbro, Inc. v. Lanard Toys, Ltd., No. 87 Civ. 6214, slip op. (S.D.N.Y. Nov. 18, 1987), *rev'd on other grounds*, 858 F.2d 70 (2d Cir. 1988).
United States District Court for the Southern District of New York denied Hasbro's motion, concluding that "GUNG-HO" was a descriptive mark and that Hasbro failed to prove likelihood of confusion as to the product's source. On appeal, the Second Circuit reversed the magistrate's order, holding that the trademark, as used by Hasbro, was a suggestive mark and that there was a likelihood of confusion.

Writing for the circuit court, Judge Cardamone observed that in a Lanham Act case, assuming Hasbro had a protectible mark, a showing of likelihood of confusion would satisfy both prongs of the Second Circuit's preliminary injunction test. That test requires the moving party to demonstrate irreparable harm; and either a likelihood of success on the merits, or serious questions going to the merits and a balancing of hardships tipping decidedly in the moving party's favor. The court utilized a bifurcated approach, first resolving whether Hasbro's unregistered mark was entitled to protection, and then turning to the "critical inquiry" of likelihood of confusion. Judge Cardamone disagreed with the magistrate's holding that "GUNG-HO" was descriptive as applied to Hasbro's product. After examining past interpretations of the term "suggestive," the court concluded: "Connecting the fantasy personality to the toy action figure requires imagination. And, quite simply, it is this need to resort to imagination that renders 'GUNG-HO' suggestive rather than descriptive."

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18 See Hasbro, 858 F.2d at 73; see also supra note 3 (discussing categories used to determine if mark protectible); infra note 23 (discussing test for likelihood of confusion).
19 Hasbro, 858 F.2d at 79.
17 Id. at 73-75; see also supra note 5 (reviewing likelihood of confusion and preliminary injunctions).
18 See supra note 5 and accompanying text (discussing preliminary injunctions in Second Circuit).
19 Hasbro, 858 F.2d at 73-75.
20 Id. at 75-79.
21 Id. at 75. The court found the magistrate had improperly analogized marks that convey an immediate idea of the characteristics of a fantasy persona to marks that make known the characteristics of the goods. Id. See generally supra note 3 (discussing descriptive and other protectibility categories).
Having decided the mark was suggestive, the court next applied factors enumerated in *Polaroid Corp. v. Polarad Electronics Corp.* to evaluate the likelihood of confusion issue. Judge Cardamone examined each factor "in the context of how it bears on the ultimate question of likelihood of confusion as to the source of the product." The first factor the court considered was the strength of the mark. While the mere fact that a mark is suggestive is not dispositive of this issue, in this case the court found the mark's suggestiveness provided convincing evidence of its strength. Considering the second and third factors, similarity between the marks and commercial proximity of the competitive products, the court ruled that the magistrate's findings were clearly erroneous. After examining all relevant factors, the court...


*Polaroid test* extends to both competing and noncompeting products. See Banff, Ltd. v. Federated Dep't Stores, Inc., 841 F.2d 486, 490 (2d Cir. 1988); Thompson Medical Co. v. Pfizer, Inc., 753 F.2d 208, 214 (2d Cir. 1985).

Specifically, the court questioned whether Lanard's sale of "GUNG-HO!" action figures would cause "an appreciable number of ordinarily prudent purchasers . . . to be misled, or indeed simply confused, as to the source of the goods in question." *Id.* (quoting Mushroom Makers, Inc. v. R.G. Barry Corp., 580 F.2d 44, 47 (2d Cir. 1978) (per curiam), cert. denied, 439 U.S. 1116 (1979)).

The court addressed two additional arguments raised by Lanard: (1) that the code name of each of Hasbro's characters was merely a style designation which would be accorded status as a strong mark only if secondary meaning were shown; and (2) that proof of secondary meaning was still relevant in this case. *Id.*

Because Hasbro and Lanard used the marks differently, as a code name and a toy-line name respectively, the magistrate did not believe otherwise similar marks gave rise to a likelihood of confusion. *See id.* at 78. In rejecting the lower court's factual finding, the Second Circuit pointed to the high likelihood of actual confusion. *Id.* The court also suggested that if individual code names were not entitled to protection, Lanard could legally incorporate a "G.I. JOE" figure into its "GUNG-HO!" line. *Id.*
concluded that a preliminary injunction was warranted because there was a likelihood of confusion as to the source of the toy figures.\textsuperscript{29}

It is submitted that the Hasbro court erred by inadequately addressing its grounds for reversal and ineffectively explaining the applicability of the clearly erroneous standard to its findings of fact. This Comment will examine the relevant scope of appellate review in the Second Circuit and will suggest how it should have been applied in this instance. This Comment will then assert that the issue of protectibility of a mark should be treated as a question of fact. Finally, this Comment will propose that a bifurcated approach to analyzing trademark infringement cases be applied consistently in the Second Circuit.

**SCOPE OF APPELLATE REVIEW**

Currently, no uniformity exists among the courts of appeals in their application of the clearly erroneous standard to reviews of trademark infringement cases under the Lanham Act.\textsuperscript{30} Several circuits hold that likelihood of confusion as to the source of a product is a factual issue and, therefore, appellate review is subject to the clearly erroneous standard at all levels.\textsuperscript{31} The Federal Circuit

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29 Id.


has not treated likelihood of confusion as a factual question, but rather, as one of law. A third group of circuit courts, including the Second Circuit, considers the determination of each specific Polaroid factor a question of fact, but the ultimate determination of the likelihood of confusion a question of law. The application of this law/fact dichotomy is critical because the clearly erroneous rule protects fact-findings from summary reversal but does not apply to errors of law which are subject to de novo appellate review. Appellate courts often circumvent this rule by finding the inquiry to be grounded in legal, as opposed to purely factual, concerns. Additionally, appellate courts make a distinction between trial court conclusions based on evidence from oral testimony of wit-
nesses and those based on documentary or real evidence. This broader review of fact-findings has been criticized by some for increasing appeals, undermining confidence in the judicial system, and demoralizing district judges.

Under the Second Circuit's hybrid approach, the district court's determination of each Polaroid factor is a finding of fact to which the clearly erroneous standard applies, while the court's use of those factors to determine likelihood of confusion is a legal conclusion reviewable de novo by the appellate court. The Hasbro court followed this approach by applying the clearly erroneous standard to its review of the district court's findings for seven of the eight Polaroid factors. It is submitted, however, that the Second Circuit deviated from its own standard of review by not explaining its conclusion on the first Polaroid factor, strength of the mark, and on the related issue, the protectibility of the mark.

36 See United States ex rel. Lasky v. La Vallee, 472 F.2d 960, 963 (2d Cir. 1973) (circuit court makes independent fact finding when credibility not an issue); Childress, supra note 35, at 117-18; Nangle, The Ever Widening Scope of Fact Review in Federal Appellate Courts—Is the "Clearly Erroneous Rule" Being Avoided?, 59 Wash. U.L.Q. 409, 423-25 (1981); Comment, supra note 30, at 757-59. Some courts have held that "ultimate findings," which are factual inferences drawn from other facts, are free of the restraints of the clearly erroneous rule. See Consolidated Naval Stores Co. v. Fahs, 227 F.2d 923, 926-26 (5th Cir. 1955). "To the degree that the determination of 'likelihood of confusion' rests upon a visual comparison of the marks [and products] themselves, the appellate court is in as good a position as the trial judge to decide the issue." McGregor-Doniger Inc. v. Drizzle Inc., 599 F.2d 1126, 1133 (2d Cir. 1979); see E. KINTNER & J. LAHR, supra note 1, at 274; cf. Lever Bros. v. American Bakers Co., 693 F.2d 251, 254 n.1 (2d Cir. 1982) (where finding based not only on analysis of documentary evidence of similarity, but also on testimony of experts, court applied "clearly erroneous" standard).


28 See supra note 33 and accompanying text.

29 See Hasbro, 858 F.2d at 76-79; see supra notes 26-28 and accompanying text (discussing Hasbro court's treatment of Polaroid factors). The court found the magistrate's findings for the second and third Polaroid factors were clearly erroneous. Hasbro, 858 F.2d at 77.

30 See generally supra notes 3 & 26 (discussing protectibility and strength of mark). There is a relation between the protectibility and the strength of a mark. Generally, if a term is suggestive it is a strong mark and is entitled to protection without proof of meaning; while an unregistered descriptive mark is a weak mark and is entitled to protection only
The Hasbro court first reviewed the magistrate’s conclusion on what it considered to be the threshold question: Is Hasbro’s mark suggestive or descriptive?\(^1\) The Hasbro court stated that it simply disagreed with the district court’s conclusion and held the mark to be suggestive.\(^2\) It is submitted that this cursory treatment of protectibility affords little guidance as to the legal or factual nature of the issue. Whether the district court made an error of fact, of law, or in the application of the law was left unanswered.\(^3\) The importance of the Hasbro court’s failure to express its grounds for reversal on the protectibility issue became more evident when it next applied its determination to the discussion of the strength of the mark.\(^4\) Presented with an opportunity to clarify its legal grounds for reversing the magistrate’s ruling, the court again failed to state its grounds for reversal by omitting any reference to the clearly erroneous standard which, by its own admission, is applicable to this Polaroid factor.\(^5\) Additionally, the court conducted what appears to be a de novo review of the issue by discussing two additional arguments raised by Lanard regarding the strength of the mark which were not relied on by the magistrate.\(^6\)

It is submitted that the categorization of a mark for the deter-

\(^{1}\) See Hasbro, 858 F.2d at 73-75.

\(^{2}\) Id. at 75.

\(^{3}\) See id. at 73-79. The court did not express its grounds for reversal anywhere in this segment of the opinion. The court stated: “The magistrate assumed that an expression that conveyed an immediate idea of the characteristics of a fantasy persona is legally analogous to one that makes known the characteristics of the goods. We disagree . . . .” Id. at 74 (emphasis added). Whether with this statement the Hasbro court meant to convey that it either considered the issue of protectibility a question of law or that it reversed because the magistrate applied an erroneous legal principle is unclear. If a trial court bases its findings upon a mistaken impression of applicable legal principles, the reviewing court is not bound by the clearly erroneous standard. See Inwood Laboratories, Inc. v. Ives Laboratories, Inc., 456 U.S. 844, 855 n.15 (1982); see also supra note 6 (discussing clearly erroneous standard).

\(^{4}\) See Hasbro, 858 F.2d at 76.

\(^{5}\) See id. at 75-76; see also supra notes 33 & 38 and accompanying text (discussing applicability of clearly erroneous standard to each specific Polaroid factor and likelihood of confusion in general).

\(^{6}\) Hasbro, 858 F.2d at 76-77. The Supreme Court has stated that “[i]n applying the clearly erroneous standard to the findings of a district court sitting without a jury, appellate courts must constantly have in mind that their function is not to decide factual issues de novo.” Zenith Radio Corp. v. Hazeltine Research, Inc., 395 U.S. 100, 123 (1969).
mination of protectibility should be a factual conclusion subject to the clearly erroneous rule. This would instill confidence and stability in the fact-finding proceedings at the trial level and, more importantly, would require an appellate court, in reversing a lower court's ruling, to clearly state whether the trial court's findings were either clearly erroneous or based on a mistaken impression of applicable legal principles, as arguably was the case in Hasbro.

SECOND CIRCUIT "LIKELIHOOD OF CONFUSION" ANALYSIS

It is suggested that the Second Circuit should establish the bifurcated approach to infringement claims as the exclusive analysis to be utilized in future trademark cases. By doing so, the court will take a step towards expediting the adjudication of trademark cases. Under the single-step analysis the court does not pass separately on the protectibility issue, but instead, moves directly to and carries out the likelihood of confusion analysis. This approach considers the Abercrombie & Fitch categorization simply as part of the "strength of the mark" determination, rather than as an integral issue on its own.

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47 See, e.g., Anheuser-Busch Inc. v. Stroh Brewery Co., 750 F.2d 631, 635 (8th Cir. 1984) (protectibility category of beer trademark "LA" is factual issue reviewable under clearly erroneous standard); WSM, Inc. v. Hilton, 724 F.2d 1320, 1325-26 (8th Cir. 1984) (categorization of term for which trademark protection is claimed is factual issue); Blisscraft of Hollywood v. United Plastics Co., 294 F.2d 694, 699-701 (2d Cir. 1961) (critical question of whether mark is descriptive to prospective purchasers of article is question of fact).

48 See supra note 37 and accompanying text (discussing criticism of broad appellate review). Appellate courts have been admonished for failing to articulate their specific rationale for reversing findings of fact. See, e.g., Dennison Mfg. Co. v. Panduit Corp., 475 U.S. 809, 810 (1986) (remanding case to appellate court because of "lack [of] an adequate explanation" for reversing lower court's fact-findings).

49 The Second Circuit has often applied the bifurcated approach in the past. See, e.g., Banff, Ltd. v. Federated Dep't Stores, Inc., 841 F.2d 486, 489 (2d Cir. 1988); Centaur Communications, Ltd. v. A/S/M Communications, Inc., 830 F.2d 1217, 1221 (2d Cir. 1987); Thompson Medical Co. v. Pfizer, Inc., 753 F.2d 208, 212-13 (2d Cir. 1985); Elizabeth Taylor Cosmetics Co. v. Annick Goutal, S.A.R.L., 673 F. Supp. 1238, 1243-44 (S.D.N.Y. 1987). However, such an approach has not been applied consistently. See infra note 50.

50 See, e.g., Plus Prods. v. Plus Discount Foods, Inc., 722 F.2d 999, 1003-05 (2d Cir. 1983) (court concentrated solely on Polaroid factors); Spring Mills, Inc. v. Ultrasashmere House, Ltd., 689 F.2d 1127, 1129-30 (2d Cir. 1982) (Abercrombie & Fitch categories considered only part of "strength of the mark" Polaroid factor); McGregor-Doniger Inc. v. Drizzle Inc., 599 F.2d 1126, 1130-32 (2d Cir. 1979) (court conducted likelihood of confusion analysis using only Polaroid factors).

51 See generally supra note 50 (cases utilizing single-step likelihood of confusion analysis). While the Abercrombie & Fitch "categories can be useful for analytical purposes, the strength of a mark depends ultimately on its distinctiveness, or its 'origin-indicating' quality, in the eyes of the purchasing public." McGregor-Doniger, 599 F.2d at 1131.
In the bifurcated approach the court first analyzes the protectibility of the mark.\(^2\) If a mark is deemed to be descriptive, the court must also determine whether secondary meaning has been established.\(^3\) If the court finds the mark generic or without secondary meaning, then it is not entitled to protection and the inquiry ends.\(^4\) Only when protectibility is established does the court turn to the likelihood of confusion issue.\(^5\) It is at this phase of the analysis that the court examines the Polaroid factors.\(^6\) Because the Polaroid factors are nonexclusive, trial courts should also examine any factors unique to the particular facts presented.\(^7\)

**CONCLUSION**

The case law governing the analysis on a motion for a preliminary injunction for trademark infringement in the Second Circuit is substantially settled. What is not settled is the appropriate analytical approach to be utilized and the deference to be accorded the conclusions of the trial court at each step of the analysis. Stat-

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\(^2\) See cases cited supra note 49 (applying bifurcated approach).

\(^3\) See cases cited supra note 3 (discussing descriptive marks). The elements utilized in determining secondary meaning are: (1) advertising expenditures, (2) consumer studies linking the mark to a source, (3) unsolicited media coverage of the product, (4) sales success, (5) attempts to plagiarize the mark, and (6) length and exclusivity of the mark’s use. See Centaur Communications, 830 F.2d at 1222-25; Thompson Medical, 753 F.2d at 217. A decision by the Patent and Trademark Office to register a mark without requiring proof of secondary meaning affords a rebuttable presumption that the mark is more than merely descriptive. See McGregor-Doniger, 599 F.2d at 1132. In determining whether secondary meaning is established, no single element is determinative, nor does every element have to be proven. See Thompson Medical, 753 F.2d at 217. Secondary meaning is a factual issue subject to the clearly erroneous standard. See McGregor-Doniger, 599 F.2d at 1133 n.4.

\(^4\) See cases cited supra note 49 (utilizing bifurcated approach to determine trademark infringement).

\(^5\) See Thompson Medical Co. v. Pfizer, Inc., 753 F.2d 208, 212-13 (2d Cir. 1985).

\(^6\) See Polaroid, 287 F.2d at 495; see also supra note 23 (detailing Polaroid analysis). Each factor must be individually examined and no one factor is predominant, “nor can the presence or absence of one without analysis of the others, determine the outcome of an infringement suit.” Thompson Medical, 753 F.2d at 214.

\(^7\) See Centaur Communications, Ltd. v. A/S/M Communications, Inc., 830 F.2d 1217, 1228 n.2 (2d Cir. 1987); Mobil Oil Corp. v. Pegasus Petroleum Corp., 818 F.2d 254, 256 (2d Cir. 1987). Some additional factors a court may examine are the senior user’s priority, its delay in asserting a claim, and whether the granting of a preliminary injunction would harm the junior user significantly more than a denial would harm the senior user. See, e.g., Harlequin Enters. v. Gulf & W. Corp., 644 F.2d 946, 950 (2d Cir. 1981) (court examined plaintiff’s delay in bringing suit); McGregor-Doniger Inc. v. Drizzle Inc., 599 F.2d 1126, 1140 (2d Cir. 1979) (conflicting interests of parties a factor); Chandon Champagne Corp. v. San Marino Wine Corp., 385 F.2d 531, 536 (2d Cir. 1964) (senior users’ priority, delay in asserting claim, and potential for harm and/or benefit examined).
ing only its own reasoning for reversing the magistrate's conclusions, the Second Circuit missed an opportunity to clarify the scope of appellate review applicable to each level of analysis. It is suggested that the Second Circuit can achieve uniformity in its decisions by consistently applying a bifurcated approach under which the threshold inquiry, a question of fact, is the degree of protectibility of a mark. If necessary, this threshold inquiry should be followed by an analysis of the likelihood of confusion. Such an approach will increase the consistency, clarity, and predictability of court decisions and conserve judicial resources by speeding unwarranted infringement claims through the system.

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