

BATTLE BETWEEN SURVIVORS

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A recent case shows us how hard it can be to prove “likelihood of confusion” – to show trademark infringement – even where the infringement involves nearly identical marks for similar products.

THE FACTS OF SULLIVAN V. CBS (7TH CIRCUIT)

The band “Survivor” released its first album in 1977 and its last album in 1993. Frank Sullivan registered the name “Survivor” in 1994 for “band and musical services.” He continued to perform and license music and sell CDs and t-shirts.

CBS launched the hit show “Survivor,” which started the reality TV craze, in 2000. Its logo was the word “SURVIVOR” in an oval surrounded by a scene from the current season’s location (e.g., a kangaroo and sunset when filmed in Australia) and the words “OUTWIT,” “OUTPLAY” and “OUTLAST” around the perimeter. In 2000 CBS released a soundtrack of music from the series and a second soundtrack of music “inspired” by the show. The first soundtrack had the word “SURVIVOR” with the words “THE OFFICIAL SOUNDTRACK TO THE HIT CBS TV SERIES” printed beneath; the second contained the series logo with the words “OFFICIAL PARTY SURVIVOR KIT” beneath.

Sullivan claimed that CBS infringed his mark by using “Survivor.” The 7th Circuit Court of Appeals held that he failed to prove a likelihood of confusion, a victory for CBS.

OAK FROM ACORNS

Many will find this puzzling: Since both parties used the same distinctive term to market musical recordings, why wasn’t this a slam-dunk for Sullivan?

First, the court reminds us that, even where the dominant portion of two marks is the same, what matters is what consumers see “as a whole.” “[T]he word ‘Survivor’ never appears alone on any of CBS’s merchandise at issue.” Rather, there is always the oval border, three extra words and relevant scene. CBS also specifically referred to its TV show on both CDs, minimizing confusion.

Second, although the products overlapped, important differences remained. For example, the band’s CDs were in the rock music section of stores, while CBS’s CDs were with soundtracks. And while band t-shirts were only sold at Survivor concerts, CBS t-shirts were sold through several outlets, but always displaying the entire “Survivor” mark (oval, words, scenes). “[N]o rational factfinder could conclude that any consumer would be confused as to the source of the merchandise.”

Finally, the court notes several times that Sullivan didn’t produce survey evidence or other proof of confusion.

LESSONS LEARNED

This case reminds us of several important facts about trademarks, confusion and infringement.

1. The use of similar terms on similar goods might not infringe. There is no silver bullet factor, no substitute for considering all significant factors identified by the courts. *So in order to reach a conclusion about infringement, your trademark attorneys will usually need to collect facts and conduct a full review, and may express their advice in shades of gray rather than black and white.*
2. Though the *dominant* features get the most weight, ultimately what counts is the *what, where and how* as seen by customers. Even with strong marks, confusion can be reduced by adding or changing features to create a distinctive impression on customers. *So your attorney may suggest adding a graphic here or a word, phrase or slogan there to minimize confusion and decrease the likelihood of infringement.*
3. Though channels of trade and advertising are less significant in our e-commerce age, that customers will rarely encounter two products at the same location (on or off the Internet) can help lessen confusion. *So when your attorney asks detailed questions about how you will promote your wares, in what sections of stores they’ll appear and whether they’re “rock music” or “soundtracks,” they’re seeking information that could determine whether your mark infringes another.*

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