

15.1 Preliminary Instruction—Trademark

The plaintiff [name] seeks damages against the defendant [name] for [trademark infringement] [unfair competition]. The defendant [name] denies [infringing the trademark] [unfairly competing] [and] [contends the trademark is invalid]. To help you understand the evidence that will be presented in this case, I will explain some of the legal terms you will hear during this trial.

DEFINITION AND FUNCTION OF A TRADEMARK

A trademark is a word, name, symbol, or device, or any combination of these items that indicates the source of goods. The [owner] [assignee] [licensee] of a trademark has the right to exclude others from using that trademark or a similar mark that is likely to cause confusion in the marketplace. The main function of a trademark is to identify and distinguish goods or services as the product of a particular manufacturer or merchant and to protect its goodwill.

[HOW A TRADEMARK IS OBTAINED]

[A person acquires the right to exclude others from using the same mark or a similar mark that is likely to cause confusion in the marketplace by being the first to use it in the marketplace, or by using it before the alleged infringer. Rights in a trademark are obtained only through commercial use of the mark.]

[TRADEMARK INTERESTS]

[The owner of a trademark may transfer, give, or sell to another person the owner's interest in the trademark. This type of [agreement] [gift] is called an assignment, and the person who receives the owner's interest is called an assignee and becomes the owner of the mark. An assignee has the right to exclude others from using the trademark or a similar mark that is likely to cause confusion in the marketplace. To be enforceable, the assignment must be in writing and signed. It must also include the goodwill of the business connected with the trademark.]

[The owner of a trademark may [also] enter into an agreement that permits another person to use the trademark. This type of agreement is called a license, and the person permitted to use the trademark is called a licensee.]

A trademark [owner] [assignee] [licensee] may enforce the right to exclude others in an action for [infringement] [or] [insert applicable form of unfair competition from 15 U.S.C. § 1125(a)].

[TRADEMARK REGISTRATION]

[After the owner of a trademark has obtained the right to exclude others from using the trademark, the owner may obtain a certificate of registration issued by the United States Patent and Trademark Office. Thereafter, when the owner brings an action for infringement, the owner may rely solely on the registration certificate to prove that the owner has the right to exclude others from using the trademark or a similar mark that is likely to cause confusion in the marketplace in connection with the type of goods specified in the certificate.] [These presumptions in favor of the owner created by the certificate of registration can be overcome or rebutted only by certain types of evidence that I will describe to you later as appropriate.]

[LIKELIHOOD OF CONFUSION]

[To prove infringement, the plaintiff [name] must prove, by a preponderance of the evidence, that the defendant [name], without the plaintiff [name]'s consent, used in commerce a reproduction, copy, counterfeit or colorable imitation of plaintiff [name]'s mark in connection with the distribution or advertisement of goods, such that the defendant [name]'s use of the mark is likely to cause confusion as to the source of the goods. It is not necessary that the mark used by the defendant [name] be an exact copy of the plaintiff [name]'s mark. Rather, the plaintiff [name] must demonstrate that, viewed in its entirety, the mark used by the defendant [name] is likely to cause confusion in the minds of reasonably prudent purchasers or users as to the source of the product in question.]

THE PLAINTIFF'S BURDEN OF PROOF

In this case, the plaintiff [name] contends that the defendant [name] has infringed the plaintiff [name]'s trademark. The plaintiff [name] has the burden of proving by a preponderance of the evidence that the plaintiff [name] is the owner of a valid trademark and that the defendant [name] infringed that trademark. Preponderance of the evidence means that you must be persuaded by the evidence that it is more probably true than not true that the defendant infringed the plaintiff [name]'s trademark.

[THE DEFENDANT'S BURDEN OF PROOF]

[The defendant [name] contends that [the [registered] trademark is invalid] [,] [the trademark has been abandoned] [or] [insert other affirmative defense]. The defendant [name] has the burden of proving by a preponderance of the evidence that [the [registered] trademark] is invalid] [,] [the trademark has been abandoned] [or] [insert other affirmative defense].]

[Preponderance of the evidence means that you must be persuaded by the evidence that it is more probably true than not true that the [[registered] trademark is invalid] [or] [insert other affirmative defense].]

Comment

This instruction is tailored to fit a classic trademark infringement case. If the case involves trade dress, trade name, or other unfair competition claims, this instruction will require modification.

Throughout these instructions, whenever the term “trademark” is used, as is appropriate for the facts of the case, a more specific term, such as “service mark,” “collective mark,” or “certification mark” may be substituted. *Lahoti v. VeriCheck, Inc.*, 586 F.3d 1190, 1194 n.1 (9th Cir. 2009) (“Under the Lanham Act, the only difference between a trademark and a service mark is that a trademark identifies goods while a service mark identifies services.” (internal quotation marks omitted)).

See generally 15 U.S.C. § 1051 *et seq.* The statute now protects both actual and intended use of a trademark. See 15 U.S.C. § 1051(b). In a case involving merely intended use of a trademark, these instructions must be tailored to fit the case.

A trademark infringement case can be brought under three different causes of action: (1) statutory trademark infringement, (2) common law trademark infringement, and (3) unfair competition.

Although elements of a claim in trademark may overlap with a claim in copyright, the acts do not preempt each other. See *Polar Bear Prods., Inc. v. Timex Corp.*, 384 F.3d 700, 721 & n.18 (9th Cir. 2004) (“Copyright and trademark are related but distinct property rights, evidenced by different federal statutes governing their protection” so that “[a]lthough there is a general bar to double recovery, we caution that damages arising from a copyright violation do not necessarily overlap wholly with damages from a trademark violation, even though there might be only one underlying action.”); *Nintendo of Am., Inc. v. Dragon Pac. Int’l*, 40 F.3d 1007, 1011 (9th Cir. 1994) (upholding award for statutory damages under Copyright Act and actual damages under trademark statute).

Additional useful references include: (1) *Model Jury Instructions: Copyright, Trademark and Trade Dress Litigation*, Chapter Two, “Trademark” (Alan Nathan Harris & Todd S. Holbrook eds., American Bar Association 2008); and (2) *Model Jury Instructions: Business Torts Litigation*, Chapter Four, “Confusion of Source” (Brian A. Hill ed., American Bar Association 5th ed. 2022).

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