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ARE YOU READY TO RUM-BLE? A PROPOSAL ON FIGHTING TRADEMARK INFRINGEMENT FOR SMALL BUSINESSES

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ABSTRACT

A company's trademark is its public brand identity. One that is relatively inexpensive to create but has become increasingly difficult to maintain and protect. The Ninth Circuit Court of Appeal's decision in *Lodestar Anstalt v. Bacardi & Co.* demonstrates the battle smaller, lesser-known companies face when attempting to protect their marks from unauthorized uses by larger, well-known corporations. This case note argues that the Ninth Circuit's overall ruling in *Lodestar* is incorrect because of its inconsistent reasoning. While the Ninth Circuit correctly concluded on the legal standard underlying the Madrid Protocol, this case note argues that the court incorrectly concluded on the likelihood of confusion and bona fide use analyses. This case note further argues that the court failed to recognize a public policy interest in protecting the trademarks of small businesses. This case note presents a new approach for courts to consider when a larger, well-known brand appropriates the mark of a smaller, lesser-known company.



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ARE YOU READY TO RUM-BLE? A PROPOSAL ON FIGHTING TRADEMARK INFRINGEMENT FOR SMALL BUSINESSES

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I. INTRODUCTION

You are sitting ringside at a high-profile boxing match. The crowd begins to roar, and the bright lights focus on the contenders as they walk down the ramp, entourage following steadily behind them. The boxers enter the ring, and the announcer shouts, “Let’s get ready to rumble!” Contender one, a lesser-known boxer, is introduced as untamed, and contender two, a well-known boxer, is introduced using his famous slogan: forever *untameable*. Clearly both contenders believe that they cannot be tamed, but who should fans support because they have the same name? Although fictional, this is a problem for many consumers with respect to goods and services provided by brands. What happens when two brands in the same market use similar names to sell or promote their products? *Lodestar* would call this trademark infringement.¹

In *Lodestar Anstalt v. Bacardi & Co.*, *Lodestar Anstalt* (“*Lodestar*”) was knocked out of the fight when the Ninth Circuit ruled in favor of *Bacardi & Co.* (“*Bacardi*”).² The trademark protection of *Lodestar*’s mark “Untamed” for rum came into question when *Bacardi* began advertising a rum product using the phrase “Bacardi Untameable.”³ The court held that *Bacardi*’s use of the phrase “Bacardi Untameable” for rum did not as a matter of law infringe on *Lodestar*’s “Untamed” mark for distilled spirits because no likelihood of confusion existed.⁴ The court found that consumers would encounter the marks differently in the marketplace, the marketing efforts were concentrated in different media, and no evidence of actual confusion existed.⁵

II. BACKGROUND

A. *The Lanham Act*

The Lanham Act provides the national system of trademark registration and

* © 2023 PARIS O. BOOKER, Juris Doctor Candidate, May 2024, UIC School of Law; B.A. in Political Science, Valparaiso University (2018). At the forefront, I want to thank God because with Him all things are possible. Thank you to my editor, Jessica Swank, for all the help along the way and to the rest of the UIC School of Law Review of Intellectual Property Law editors and staff for their unwavering dedication to the journal. I would like to dedicate this article to my husband, Jordan James, mother, Shanika Flowers, nana, Dorothy Flowers, as well as my family, friends, and mentors – thank you for providing me with love, support, and motivation that helped me achieve this accomplishment. To my siblings – Mikayla, Juan, Siniyah, and Josiah – I hope this achievement inspires you to follow your own dreams and aspirations.

¹ *Lodestar Anstalt v. Bacardi & Co.*, 31 F.4th 1228, 1235 (9th Cir. 2022).

² *Id.*

³ *Id.*

⁴ *Id.* at 1261.

⁵ *Id.*

protection, managed by the United States Patent and Trademark Office (“USPTO”), to assist in establishing priority of trademark rights.⁶ A trademark is defined “as any word, phrase, name, symbol, or device used in commerce to identify and distinguish the goods or services of one person from those of others, and to indicate the source of the goods.”⁷ A trademark must be distinctive in source,⁸ and one who first uses a distinct mark in commerce acquires rights to that mark.⁹

The Lanham Act also provides the process for filing a civil action in federal court against anyone who uses a similar mark that “is likely to cause confusion, mistake, or deception as to the affiliation or origin of goods or services with that of another person.”¹⁰ To prevail on a Lanham Act claim, a plaintiff must prove that they have (1) a protectable ownership interest in the mark and (2) the defendant’s use of the mark is likely to cause consumer confusion.¹¹ A registered trademark with the USPTO is given a presumption of validity in court.¹²

B. Madrid Protocol

The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, commonly referred to as “the Madrid Protocol,” is a treaty implemented in the 2002 amendments contained in Title XII of the Lanham Act.¹³ This international trademark registration system enables foreign trademark owners to obtain a U.S. trademark registration *without* first use of the mark in U.S. commerce.¹⁴ This is an exception to the traditional “first-to-use” rule.¹⁵ An extension of protection for international registration may be granted under Title XII based on the foreign applicant’s declaration of a bona fide intent-to-use its foreign-registered mark in U.S. commerce at the time it applies for U.S. registration.¹⁶

⁶ The Trademark Act of 1946 (Lanham Act), 15 U.S.C. § 1051.

⁷ 15 U.S.C. § 1127; *See also* *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992).

⁸ *See* 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3:9 (5th ed. 2021) (“The primary purpose of a trademark is to identify and distinguish goods or services”) (explaining that a trademark will qualify as distinctive if either (1) it is inherently distinctive of source or (2) it has developed acquired distinctiveness of source).

⁹ *B&B Hardware, Inc. v. Hargis Indus.* 575 U.S. 138, 142 (2015) (emphasis added); *see also* *Hana Fin., Inc. v. Hana Bank*, 574 U.S. 418, 419 (2015) (“Rights in a trademark are determined by the date of the mark’s first use in commerce.”).

¹⁰ 15 U.S.C. § 1125(a).

¹¹ *See* *Rearden LLC v. Rearden Com., Inc.*, 683 F.3d 1190, 1202 (9th Cir. 2012); *Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137, 1144 (9th Cir. 2011) (quoting *Dep’t of Parks & Recreation v. Bazaar Del Mundo Inc.*, 448 F.3d 1118, 1124 (9th Cir. 2006)).

¹² *Iancu v. Brunetti*, 139 S. Ct. 2294, 2297 (2019). Another benefit of registering a trademark is that it serves as constructive notice of the holder’s claim of ownership. *Id.* at 2298. This prevents some defenses in infringement suits. *Id.*

¹³ Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, 15 U.S.C. §§ 1141-1141n.

¹⁴ *See* Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, art. 2, June 27, 1989, T.I.A.S. No. 03-1102.

¹⁵ *Lodestar*, 31 F.4th at 1238.

¹⁶ *Id.*

C. Likelihood of Confusion

The Ninth Circuit uses an eight-pronged test called the “*Sleekcraft* factors” to assess the likelihood of confusion in a trademark infringement claim.¹⁷ These factors include: (1) the strength of the mark; (2) proximity of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used; (6) type of goods and the degree of care likely to be exercised by the purchaser; (7) defendant’s intent in selecting the mark; and (8) likelihood of expansion of the product lines.¹⁸ The non-exhaustive list of flexible factors is intended to guide the court in making a factual determination as to whether a likelihood of confusion exists.¹⁹ These factors should be considered together under a totality of the circumstances analysis.²⁰

1. Strength of Mark

The first factor, strength of mark, refers to the five categories regarding eligibility of trademark status and the degree of protection accorded.²¹ In ascending order, the categories are (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary, or (5) fanciful.²² A generic mark is the least distinctive, and an arbitrary or fanciful mark is the most distinctive.²³ A more distinctive mark has greater strength and will receive greater protection from infringement.²⁴

2. Proximity of Goods

The second factor, proximity of goods, assesses whether the goods are related²⁵ or complementary.²⁶ The more related or complementary the goods, the more likely the consumer will be confused as to the producers of the goods.²⁷ A diminished standard of similarity must be applied when comparing the marks of closely related goods.²⁸

3. Similarity of Marks

The third factor, similarity of marks, is used to evaluate the sight, sound, and

¹⁷ *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979).

¹⁸ *Id.*; *See generally* *Pom Wonderful LLC v. Hubbard*, 775 F.3d 1118, 1125 (9th Cir. 2014); *Lahoti v. Vericheck, Inc.*, 636 F.3d 501, 507-08 (9th Cir. 2011); *Eclipse Assocs. v. Data Gen. Corp.*, 894 F.2d 1114, 1116-18 (9th Cir. 1990); *Dreamwerks Prod. Grp. V. SKG Studio*, 142 F.3d 1127, 1129 (9th Cir. 1998); *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1140 (9th Cir. 2002).

¹⁹ *Ironhawk Techs., Inc. v. Dropbox, Inc.*, 2 F.4th 1150, 1160-61 (9th Cir. 2021) (“[i]t is the totality of facts in a given case that is dispositive”).

²⁰ *Id.*

²¹ *Two Pesos, Inc.*, 505 U.S. at 768-69.

²² *Id.* (“The latter three categories of marks, because of their intrinsic nature serves to identify a particular source of a product, are deemed inherently distinctive and are entitled to protection. In contrast, generic marks – those that ‘refer to the genus of which the particular product is a species,’ . . . are not registrable as trademarks.”).

²³ *Id.*

²⁴ *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1291 (9th Cir. 1992).

²⁵ *AMF, Inc.*, 599 F.2d at 348 n.10 (“related goods are those products which would be reasonably thought by the buying public to come from the same source if sold under the same mark”).

²⁶ *Official Airline Guides, Inc. v. Goss*, 6 F.3d 1385, 1392 (9th Cir. 1993).

²⁷ *Id.*

²⁸ *AMF, Inc.*, 599 F.2d at 350.

meaning of the marks.²⁹ The marks must be considered in their entirety and as they appear in the marketplace.³⁰ Similarities are weighed more heavily than differences.³¹ The greater the similarity between the two marks at issue, the greater the likelihood of confusion.³²

4. *Evidence of Actual Confusion*

The fourth factor, evidence of actual confusion, is used to gauge whether consumers have already been confused by the mark.³³ Where evidence of actual confusion is provided, it is strong proof that future confusion is likely.³⁴ But actual confusion is not necessary for a finding of likelihood of confusion under the Lanham Act.³⁵ In fact, “proving actual confusion is difficult . . . and the courts have often discounted such evidence because it was unclear or insubstantial.”³⁶

5. *Marketing Channels*

The fifth factor, marketing channels, addresses marketing channel convergence by considering whether the parties’ customer bases overlap and how the parties advertise and market their products.³⁷ Convergent marketing channels increase the likelihood of confusion.³⁸ Products likely to be sold in the same or similar stores or outlets or advertised in similar media may increase the likelihood of confusion.³⁹

6. *Type of Goods and the Degree of Care*

The sixth factor, type of goods and the degree of care, is used to determine whether a reasonably prudent consumer would take the time to distinguish between the two products.⁴⁰ Where the buyer has expertise in the field, or the goods are expensive, the buyer can be expected to exercise greater care in his purchases.⁴¹ However, confusion

²⁹ *M2 Software, Inc. v. Madacy Entm’t*, 421 F.3d 1073, 1082 (9th Cir. 2005).

³⁰ *Id.*

³¹ *AMF, Inc.*, 599 F.2d at 351.

³² *GoTo.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 1206 (9th Cir. 2000); *see also E. & J. Gallo*, 967 F.2d at 1286.

³³ *M2 Software, Inc.*, 421 F.3d at 1082-83.

³⁴ *Id.*

³⁵ *E. & J. Gallo*, 967 F.2d at 1292.

³⁶ *AMF, Inc.*, 599 F.2d at 353 (“Because of the difficulty in garnering such evidence, the failure to prove instances of actual confusion is not dispositive. (citation omitted) Consequently, this factor is weighed heavily only when there is evidence of past confusion or, perhaps, when the particular circumstances indicate such evidence should have been available”); *E.g.*, *Carter Wallace, Inc. v. Procter & Gamble Co.*, 434 F.2d 794, 800 (9th Cir. 1970) (letters did not show actual confusion); *Norm Thompson Outfitters, Inc. v. General Motors Corp.*, 448 F.2d 1293, 1295 (9th Cir. 1971) (showing insufficient evidence to establish secondary meaning).

³⁷ *Nutri/System, Inc. v. Con-Stan Indus.*, 809 F.2d 601, 606 (9th Cir. 1987).

³⁸ *AMF, Inc.*, 599 F.2d at 353.

³⁹ *Pom Wonderful LLC*, 775 F.3d at 1131-32.

⁴⁰ *Ironhawk Techs.*, 2 F.4th at 1167.

⁴¹ *Brookfield Communs., Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1060 (9th Cir. 1999).

may still be likely even in the case of expensive goods sold to discerning customers.⁴² On the other hand, consumers are likely to exercise less care when purchasing inexpensive products, thus making confusion more likely.⁴³

7. *Defendant's Intent in Selecting the Mark*

The seventh factor, the defendant's intent in selecting the mark, ensures that the junior user avoids using a mark that they know is likely to cause confusion with the senior user's mark.⁴⁴ In the usual infringement case, a junior user attempts to pass off its goods as those of the senior user.⁴⁵ In a reverse confusion infringement case, like *Lodestar*, the question is whether consumers doing business with the senior user might mistakenly believe that they are dealing with the junior user.⁴⁶

8. *Likelihood of Expansion of the Product Lines*

The eighth and final factor, the likelihood of expansion of the product lines, considers the possibility that the actions of the junior user may hinder the senior user's expansion plans,⁴⁷ and that trademark holders may properly choose to expand "both geographically and in the products and services that they offer."⁴⁸ In the context of non-competing goods, a strong likelihood that either party may expand his business to compete with the other favors a finding of infringement.⁴⁹ When the goods or services are closely related, any expansion is likely to cause direct competition.⁵⁰

D. Trademark Dilution

The Trademark Dilution Revision Act of 2006 is a federal statute that entitles the owner of a famous mark or trade name to injunctive relief against a third party's commercial use of the mark if such use causes the dilution of the "distinctive quality" of the mark.⁵¹ A trademark dilution action is available to protect trademark owners against alleged infringers who diminish the strength or value of their mark by blurring

⁴² See *AMF Inc.*, 599 F.3d at 353; *E.g.*, *Daddy's Junky Music Stores Inc. v. Big Daddy's Family Music Ctr.*, 109 F.3d 275, 286 (6th Cir. 1997); *Banff, Ltd. v. Federated Dep't Stores, Inc.*, 841 F.2d 486, 492 (2d Cir. 1988).

⁴³ See, e.g., *E. & J. Gallo*, 967 F.2d at 1293 (wine and cheese).

⁴⁴ *Marketquest Group, Inc. v. BIC Corp.*, 862 F.3d 927, 934-35 (9th Cir. 2017).

⁴⁵ *Id.*

⁴⁶ *Id.* In a reverse confusion case, there are various ways to weigh the defendant's intent in selecting the mark. *Id.* The defendant's intent can be shown by "evidence that, for example, the defendant knew of the mark, should have known of the mark, intended to copy the plaintiff, failed to conduct a reasonably adequate trademark search, or otherwise culpably disregarded the risk of reverse confusion." *Id.*

⁴⁷ *Survivor Media, Inc. v. Survivor Prods.*, 406 F.3d 625, 634 (9th Cir. 2005).

⁴⁸ *Cohn v. PetSmart, Inc.*, 281 F.3d 837, 843 (9th Cir. 2002).

⁴⁹ See *AMF Inc.*, 599 F.3d at 354.

⁵⁰ *Id.* (emphasis added).

⁵¹ Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, 120 Stat. 1730 (codified in various sections of 15 U.S.C.). This Act is an amendment to the Federal Trademark Act of 1995. *Id.*

or tarnishing the mark's image.⁵² This action differs from a trademark infringement action, in that the owner of the famous mark can show liability without having to prove actual or likely confusion, mistake, or deception.⁵³

III. THE CASE

A. Facts of Lodestar Anstalt

Lodestar is a small, independent Liechtenstein-based distilled spirits company founded in June 2000 by Andre Levy.⁵⁴ The company developed a brand of Irish whiskey called "The Wild Geese."⁵⁵ Due to losing a dispute with a holder of an existing mark for "Wild Turkey" liquor products, Lodestar changed the brand name in the U.S. to "The Wild Geese Soldiers & Heroes" or "The Wild Geese Irish Soldiers & Heroes."⁵⁶ As an outgrowth of this trademark dispute, Lodestar developed the idea for the "Untamed" word mark and logo around 2008-2009.⁵⁷ In 2011, Lodestar obtained its extension of protection for the mark "Untamed" for whiskey, rum, and other spirits.⁵⁸ In 2013, Bacardi began a marketing campaign using the slogan "Bacardi Untameable" to promote its rum products.⁵⁹ The slogan appeared only in various forms of advertisements on television, print publications, outdoor billboards and signs, and digital formats.⁶⁰ In July 2013, Bacardi sought extension of protection in the U.S., under the Madrid Protocol, for its Liechtenstein-registered trademark in the phrase "Bacardi Untameable."⁶¹ In response to the USPTO publishing Bacardi's request for extension of protection in December 2013, Lodestar filed an opposition with the Trademark Trial and Appeal Board.⁶² Bacardi filed counterclaims seeking cancellation of both the "Untamed" word and design marks.⁶³ Shortly after, Lodestar began to use its mark in the United States on its complementary product "Untamed Revolutionary Rum".⁶⁴ In 2016, Lodestar filed suit against Bacardi and its affiliates alleging

⁵² *Id.* This action only protects famous marks that are inarguably well-known to the general consuming public. An example of trademark dilution would be if a Chicagoan opened a bakery called "Apple" in downtown Chicago. It is highly unlikely that patrons would be confused into believing that the multinational technology company owns the bakery and is leveraging its brand into the sales of baked goods. However, the concept of dilution asserts that the existence of the bakery may still harm the famous tech company by diminishing the uniqueness or distinctiveness of its mark.

⁵³ Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat. 985.

⁵⁴ *Lodestar*, 31 F.4th at 1238.

⁵⁵ *Id.*

⁵⁶ *Id.* at 1239.

⁵⁷ *Id.*

⁵⁸ *Id.* The "Untamed" design mark was included on the packing of The Wild Geese Irish Soldiers & Heroes whiskey, and the "Untamed" word mark was used in advertising this same product as early as 2011. *Id.*

⁵⁹ *Lodestar*, 31 F.4th at 1242.

⁶⁰ *Id.*

⁶¹ *Id.*

⁶² *Id.* Proceedings with the Trademark Trial and Appeal Board were suspended due to the pending suit regarding this matter before the Ninth Circuit. *Id.*

⁶³ *Id.*

⁶⁴ *Lodestar*, 31 F.4th at 1242-43. Before the Bacardi campaign, Lodestar had paused its efforts

infringement of the registered “Untamed” mark.⁶⁵

B. Procedural History

Between August 25, 2016, and November 16, 2016, the Central District Court of California considered two questions: (1) whether the “Bacardi Untameable” mark is sufficiently similar to the “Untamed” marks to cause a likelihood of confusion; and (2) whether Lodestar’s “Untamed” marks should be canceled due to abandonment.⁶⁶ After trial, the district court held that neither party was entitled to summary judgment with respect to the issue of abandonment.⁶⁷ Moreover, the court granted Bacardi’s motion for summary judgment, finding that no reasonable jury could find a likelihood of confusion.⁶⁸

The district court rejected Lodestar’s expert report asserting a likelihood of confusion between “Bacardi Untameable” and the “Untamed” mark as it appeared on the Untamed Revolutionary Rum.⁶⁹ The court held that the Untamed Revolutionary Rum should be excluded from the analysis because it did not exist prior to Bacardi’s campaign.⁷⁰ This, coupled with the evaluation of the relevant *Sleekcraft* factors, led the court to find “no evidence that a reasonably prudent consumer in the marketplace would mistake The Wild Geese Soldiers & Heroes Rum with Bacardi.”⁷¹ Following the district court decision, Lodestar appealed.⁷²

C. The Holding of the Court

The Ninth Circuit Court of Appeals analyzed two elements to determine whether Lodestar had a viable trademark infringement claim: (1) whether Lodestar owns a legally protectable mark in “Untamed,” and (2) whether Bacardi’s use of the mark creates a likelihood of confusion as to source, affiliation, or sponsorship.⁷³ To ascertain the protectability of Lodestar’s mark, the court had to address a question of first

to market this product in the U.S. *Id.* at 1257. In early 2014, Lodestar imported 2,000 cases of the Untamed Revolutionary Rum bearing the “Untamed” trademark in the United States. *Id.* at 1243. Lodestar did not begin selling this product to a wholesaler until late December. *Id.* Specifically, Lodestar made an initial sale to a mid-west distributor in late 2014 for 96 cases or 576 bottles. *Id.* at 1257. Lodestar only had one other distribution of this product delivering 19 sample bottles. *Id.*

⁶⁵ *Id.* at 1244. Lodestar’s claims against Bacardi are for trademark infringement under § 32 of the Lanham Act and unfair competition under § 43. *Id.* Where, as here, a plaintiff’s § 43 unfair competition claim is based on alleged infringement of a registered mark, the legal analysis under the two sections is essentially identical. *Id.* at 1245.

⁶⁶ *Lodestar Anstalt v. Bacardi & Co.*, No. 16-06411, 2016 U.S. Dist. LEXIS 167983, at *7-8 (C.D. Cal. Nov. 16, 2016).

⁶⁷ *Lodestar*, 31 F.4th at 1244-45. The evidence presented was both “sufficient to create a triable issue as to whether Lodestar intended to abandon the UNTAMED word mark” and “insufficient to establish that Lodestar had not abandoned the UNTAMED word mark as a matter of law.” *Id.*

⁶⁸ *Id.*

⁶⁹ *Id.*

⁷⁰ *Id.*

⁷¹ *Id.*

⁷² *Lodestar*, 31 F.4th at 1244-45.

⁷³ *Id.*

impression:⁷⁴ who has priority in a mark registered in the U.S. under the Madrid Protocol if the senior user did not use the mark in U.S. commerce before a junior user did?⁷⁵ The Ninth Circuit found that, even if Lodestar had not used its “Untamed” mark in U.S. commerce before Bacardi’s allegedly infringing behavior, Lodestar still had a right of priority and was the senior user based on its application under the Madrid Protocol and its prior use of the mark in its home country.⁷⁶

Next, the court looked at two of Lodestar’s distinct uses of the mark to address bona fide use.⁷⁷ The first use, which occurred before the Bacardi campaign, consisted of the “Untamed” mark on the back of its bottles.⁷⁸ The second use, developed in response to Bacardi’s campaign⁷⁹, is the Untamed Revolutionary Rum products that display the mark on the front label more prominently.⁸⁰ The court found that the second use should be excluded from the analysis because it is “merely to reserve its rights for a lawsuit.”⁸¹

Lastly, the court analyzed the eight *Sleekcraft* factors.⁸² Since Lodestar’s claim is one of reverse confusion, the question is whether consumers doing business with Lodestar might mistakenly believe that they are doing business with Bacardi.⁸³ The court found that the strength of the mark and Bacardi’s intent weighed in favor of confusion.⁸⁴ Bacardi’s “Untameable” mark was so commercially strong that it overtook

⁷⁴ *Id.* at 1248. The court, finding no controlling authority, analogized the circumstances to those in decisions applying the comparable provisions of Section 44(d) of the Lanham Act. *Id.* This section governs constructive use priority for US registrations granted on the basis of other treaties, such as Paris Convention registrations. *Id.* at 1248-49. After analyzing the facts in Lodestar, the court found Section 44(d) standards to be analogous and applicable. *Id.* at 1250. Thus, the court applied these to find that Lodestar’s Madrid Protocol registrations and subsequent actual use entitled it to constructive use priority extending back to its earliest claimed priority date of July 16, 2009, and to the presumptions of validity, registration, ownership, and exclusive rights to use afforded by U.S. trademark registration. *Id.* at 1250-51.

⁷⁵ *Id.*

⁷⁶ *Id.* at 1246 (explaining that once a registrant under the Madrid Protocol actually begins using the registered mark within the U.S., it is then entitled to assert an infringement claim, based on its statutory priority of right, against those who may have used the mark after the registrant’s constructive use date but before the registrant’s actual use in the U.S.).

⁷⁷ *Lodestar*, 31 F.4th at 1254.

⁷⁸ *Id.* at 1256-57.

⁷⁹ *Id.* at 1257-58. It is an undisputed fact that Lodestar’s “Untamed Revolutionary Rum” product was indisputably developed after Bacardi’s “Untameable” advertising campaign began. *Id.* Additionally, the creation of the product was motivated in part by Lodestar’s desire to combat Bacardi’s perceived infringement. *Id.*

⁸⁰ *Id.*

⁸¹ *Id.* at 1257-58. Although the appellate court agreed with the district court that Lodestar’s “Untamed Revolutionary Rum” products should be excluded from the analysis, the reasoning differs. *Id.* at 1253. The Ninth Circuit found that the district court’s use of a bright-line temporal rule excluding any consideration of a senior user’s post-infringement use of the mark on additional goods was legal error. *Id.* Specifically, this categorical rule could not be squared away with the Madrid Protocol which grants priority to the foreign registrant even if that registrant does not actually use the mark in commerce until after the alleged infringer began use. *Id.*

⁸² *Lodestar*, 31 F.4th at 1252.

⁸³ *Id.*

⁸⁴ *Id.* at 1258-61. Based on the findings of an expert, Lodestar argues that its “Untamed” word mark is arbitrary, thus accorded greater protection from trademark infringement. *Id.* The expert

the senior mark, and it was undisputed that Bacardi knew about Lodestar’s “Untamed” mark.⁸⁵ Conversely, the similarity of the marks, based on the “manner in which consumers actually encountered the marks,” weighed against any likelihood of confusion.⁸⁶ Since Lodestar’s “Untamed” mark only appeared on the back of the label of the bottles below a considerable amount of writing, consumers would encounter the two marks differently.⁸⁷ The remaining *Sleekcraft* factors were not challenged on appeal.⁸⁸ On September 29, 2022, Lodestar appealed the Ninth Circuit’s decision to the Supreme Court of the United States, but the Supreme Court declined to hear the case.⁸⁹

IV. DISCUSSION

The Ninth Circuit maintains that summary judgment for trademarks is disfavored because they are fact intensive, which means defendants often face a higher standard with summary judgment.⁹⁰ As a result of the *Lodestar* decision, defendants may now have a stronger chance of throwing out a trademark infringement case at the summary judgment stage even where the *Sleekcraft* factors weigh more in favor of the infringed party.⁹¹ The court’s overall ruling in *Lodestar* is incorrect because of its inconsistent reasoning. This section argues that the court incorrectly concluded on the *Sleekcraft* factors. Additionally, the court failed to recognize Lodestar’s second use of its “Untamed” mark as a bona fide use in commerce. Finally, this section concludes by proposing that courts should consider creating a new “inverse” trademark dilution test to be used in some trademark infringement analyses.

A. *Sleekcraft* Factors

While the Ninth Circuit analyzed the eight *Sleekcraft* factors correctly, the court

concluded that the term “Untamed” “clearly did not describe the product – namely rum” and, in ordinary usage, is more commonly associated with things of nature. *Id.* However, the Ninth Circuit agreed with the district court that the mark is more suggestive than arbitrary. *Id.*

⁸⁵ *Id.*

⁸⁶ *Id.* at 1260.

⁸⁷ *Lodestar*, 31 F.4th at 1261. When “two parties use the same or similar marks “merely as a tagline to their distinctive business names,” the subordinate position of that tagline mark to their “housemarks” weighs against a likelihood of confusion.” *Id.* at 1260.

⁸⁸ *Id.* at 1258, 61. The second factor, proximity of goods, weighed in favor of a likelihood of confusion. *Id.* at 1261. The sixth and eighth factors, the type of goods and the degree of care likely to be exercised by the purchaser and likelihood of expansion of product line respectively, both were neutral. *Id.* The fourth factor, evidence of actual confusion, weighed slightly against any likelihood of confusion. *Id.* The fifth factor, marketing channels used, also weighed slightly against a likelihood of confusion. *Id.*

⁸⁹ *Lodestar*, 31 F.4th 1228 (9th Cir. 2022), *cert. denied*, 2022 WL 16909195 (2022) (No. 316, 2022 Term).

⁹⁰ *Entrepreneur Media*, 279 F.3d at 1140; *Interstellar Starship Servs. v. Epix, Inc.*, 184 F.3d 1107, 1109 (9th Cir. 1999); *Ironhawk Techs.*, 2 F.4th at 1159; *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1325, 1356 n.5 (9th Cir. 1985).

⁹¹ *See generally Lodestar*, 31 F.4th at 1235.

erred when it weighed the actual evidence factor more heavily than the other factors in this case.⁹² The inquiry of the actual evidence factor is whether consumers are confused by the junior user's use of the mark.⁹³

It is true that Lodestar was unable to identify "any U.S. consumers who were confused as to the source of its products."⁹⁴ However, the court neglected to acknowledge that in some cases, it is difficult to prove actual confusion.⁹⁵ In *Eclipse Assocs. v. Data General Corp.*, the Ninth Circuit found that "a likelihood of confusion can exist irrespective of the lack of evidence of actual confusion because it is neither essential nor required in the use of a mark."⁹⁶ Furthermore, in *Official Airline Guides, Inc. v. Goss*, the same court held that a likelihood of confusion existed despite no persuasive evidence of actual confusion because the absence of such evidence is not dispositive.⁹⁷ These are just a few cases in which the Ninth Circuit found that actual evidence is not determinative.⁹⁸

Surprisingly, in *Lodestar*, the court drastically shifted the amount of weight placed on the actual confusion factor. The mere fact that Lodestar failed to provide evidence of consumer confusion regarding the use of Bacardi's mark seems to be the true reason why the court ruled in favor of Bacardi.⁹⁹ The court's inconsistency on how this factor is weighed is problematic. Courts should not be able to pick and choose how much weight is given to the actual evidence factor, especially if the consensus is that

⁹² *Id.* at 1261.

⁹³ *M2 Software, Inc.*, 421 F.3d at 1082-83.

⁹⁴ *Lodestar*, 31 F.4th at 1261.

⁹⁵ *AMF, Inc.*, 599 F.2d at 352; *see also Cohn*, 281 F.3d at 842 ("Because evidence of actual confusion can be difficult to obtain, its absence is generally unnoteworthy" and is given little probative weight." (quoting *Brookfield Communs.*, 174 F.3d at 1050)).

⁹⁶ *Eclipse*, 894 F.2d at 1118-19. The defendant manufactured and distributed a full range of computer products using its mark "ECLIPSE" since 1974. *Id.* at 1115. The mark was also used in 1975 to expand its brand to software and computer publications. *Id.* In 1978, the plaintiff began using the same "ECLIPSE" mark in the United Kingdom to sell software systems. *Id.* at 1116. The plaintiff then used the mark in the U.S. *Id.* Although the defendant could not prove actual confusion, the court affirmed the district court's finding of a likelihood of confusion. *Id.* at 1118-19.

⁹⁷ *Official Airline Guides*, 6 F.3d at 1393. The plaintiff published travel directories listing travel and accommodations around the world using the trademark "OAG TRAVEL PLANNER." *Id.* at 1388. The defendant sold and advertised a similar travel directory using the trademarks "THE TRAVEL PLANNER USA" and "USA TRAVEL PLANNER." *Id.* at 1389. The plaintiff only received seven out of the 80,000 listing forms mailed by defendant. *Id.* at 1393. The district court found this to be minimal evidence of actual confusion. *Id.* Moreover, the plaintiff failed to prove lost sales from the advertisements placed in the defendant's guide. *Id.* The travel agents and advertisers testified that they were not confused by the two companies' travel directories. *Id.* However, this lack of evidence did not keep the appellate court from affirming the lower court's decision that a likelihood of confusion existed in the use of the marks. *Id.* at 1395.

⁹⁸ *Eclipse*, 894 F.2d at 1118; *see also Res. Lenders, Inc. v. Source Sols., Inc.*, 404 F. Supp. 2d 1232, 1244 (E.D. Cal. 2005); *VersaTop Support Sys., LLC v. Ga. Expo, Inc.*, 921 F.3d 1364, 1372 (Fed. Cir. 2019); *Rodeo Collection, Ltd. v. West Seventh*, 812 F.2d 1215, 1219 (9th Cir. 1987); *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 782 F.2d 1508, 1509 (9th Cir. 1986).

⁹⁹ *Lodestar*, 31 F.4th at 1261. The court suggests in its analysis that the lack of actual confusion was an important determining factor in deciding against a likelihood of confusion regarding Bacardi's campaign. *Id.*

actual evidence is not necessary to prove a likelihood of confusion.¹⁰⁰

B. Bona Fide Use in Commerce

The court also erred when it determined that Lodestar's use of the "Untamed" mark on its Untamed Revolutionary Rum product was not a bona fide use in commerce.¹⁰¹ The Lanham Act limits enforceable trademark rights to "bona fide" uses of the mark "in the ordinary course of trade."¹⁰² The use must be for genuine commercial reasons and not merely to reserve rights for a lawsuit.¹⁰³ The court excluded Lodestar's "Untamed Revolutionary Rum" from the likelihood of confusion analysis because it believed the rum was not a "serious effort" to develop a product for genuine commercial reasons.¹⁰⁴ The court is correct that, unlike Lodestar's Wild Geese Soldiers & Heroes Rum, the Untamed Revolutionary Rum did not exist prior to Bacardi's Untameable campaign, there were no substantial steps in marketing the product, and that the bottling and labeling were put together very quickly within weeks of the start of the campaign.¹⁰⁵

However, Lodestar's creation of the Untamed Revolutionary Rum was a bona fide use because the product was created for genuine commercial reasons, thus warranting trademark protection. First, the existence of a product before the junior user's infringement is not a required element of a trademark infringement analysis. In fact, the senior user possesses superior rights in the mark, "irrespective of "whether or not [it] has actually expanded its use of its mark, after the commencement of the subsequent user's use, to goods or services which are the same as or closely related to those of the subsequent user."¹⁰⁶ Lodestar's use of the mark on the Untamed Revolutionary Rum was an expansion of its mark and should not be categorically excluded.¹⁰⁷

Moreover, it is the *mark*, not the specific product, on which it appears that is entitled to protection.¹⁰⁸ The court is more concerned with the product rather than the "Untamed" word mark itself. When focusing on the actual mark, the timing of the creation of the Untamed Revolutionary Rum is irrelevant because the "Untamed" mark was in commerce well before Bacardi's campaign in November 2013.¹⁰⁹ The court acknowledged that the use of the "Untamed" word mark on the back of The Wild Geese

¹⁰⁰ *Eclipse*, 894 F.2d at 1118; *see also Res. Lenders, Inc.*, 404 F. Supp. 2d at 1244; *VersaTop Support Sys., LLC*, 921 F.3d at 1372; *Rodeo Collection, Ltd.*, 812 F.2d at 1219; *Park 'N Fly, Inc.*, 782 F.2d at 1509.

¹⁰¹ *Lodestar*, 31 F.4th at 1258.

¹⁰² *See* 15 U.S.C. § 1127. In regard to the sale of goods, the relevant language of § 45 states that a mark will be deemed to be used in commerce on goods when: (1) "it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto"; and (2) "the goods are sold or transported in commerce." *Id.*

¹⁰³ *Id.*

¹⁰⁴ *Lodestar*, 31 F.4th at 1257.

¹⁰⁵ *Id.*

¹⁰⁶ *Id.* at 1254.

¹⁰⁷ *Id.* ("Post-infringement uses are not categorically excluded from the likelihood of confusion analysis").

¹⁰⁸ *See* MCCARTHY ON TRADEMARKS, *supra* note 8, § 2:10.

¹⁰⁹ *Lodestar*, 31 F.4th at 1255.

Soldiers & Heroes Rum constituted a bona fide use in commerce.¹¹⁰ Therefore, it should not matter whether Lodestar's subsequent use of the mark is bona fide, because Lodestar has statutory priority of the mark under the Madrid Protocol,¹¹¹ and a bona fide use in commerce making it a valid registration.¹¹²

Furthermore, the use of the "Untamed" mark on the "Untamed Revolutionary Rum" product was not merely an attempt to reserve Lodestar's rights in the mark and to secure a basis for a potential lawsuit.¹¹³ It is true that the rum used for this product was the same for "The Wild Geese Soldiers & Heroes Rum".¹¹⁴ It is also true that other than the 96 cases sold in late 2014, no other major sales were made during the period of 2014-2018.¹¹⁵ Though this may be the case, the court should have considered the totality of the circumstances. Given that Lodestar is an alcoholic beverage company, there could be a myriad of reasons why additional sales were not made. During this period, Lodestar was battling with Bacardi before the Trademark Trial and Appeal Board and the district court regarding its use of the phrase "Bacardi Untameable."¹¹⁶ It is possible that Lodestar did not have the time to further its expansion of the "Untamed Revolutionary Rum" product given legal proceedings.

Regardless, the lack of sales during the five-year period does not negate the fact that evidence was produced to prove that there was a genuine commercial reason for using the "Untamed" word mark on the Untamed Revolutionary Rum.¹¹⁷ An internal email indicated that this product was conceived "to complement the Wild Geese Rum and also to combat Bacardi's attempts to take over the Untamed mark."¹¹⁸ The court failed to acknowledge Lodestar's legitimate business interest in creating a complementary rum that would expand its use of the mark, and instead placed significantly more emphasis on the fact that Lodestar wanted to preserve its mark.¹¹⁹ The decision to exclude this product from the likelihood of confusion analysis is inconsistent with the court's beliefs.¹²⁰ The court mentions that "the use of the word 'merely' confirms that an otherwise genuine commercial use is 'bona fide' even though one of the purposes of the use is to 'reserve a right in a mark.'"¹²¹ Lodestar had a

¹¹⁰ *Id.* at 1256.

¹¹¹ *Id.* at 1235-36. Bacardi does not argue on appeal that Lodestar did not satisfy the necessary requirements in connection with its application for extension of protection under the Madrid Protocol. *Id.*

¹¹² *Id.* at 1251.

¹¹³ *Id.* at 1257.

¹¹⁴ *Lodestar*, 31 F.4th at 1257.

¹¹⁵ *Id.* Lodestar delivered 19 sample bottles to potential customers during this period, but this was not a sale. *Id.* The court claimed that the one-time sale of the 96 cases to a single distributor within the five-year period was a token use that was merely ancillary to the effort to reserve rights in the mark. *Id.* at 1258. It does not constitute a "continuing effort or intent to continue such use and place the product on the market on a commercial scale within a reasonable period of time." *Id.*

¹¹⁶ *Id.* at 1242, 44.

¹¹⁷ *Id.* at 1257.

¹¹⁸ *Id.*

¹¹⁹ *Lodestar*, 31 F.4th at 1257.

¹²⁰ *Id.* at 1255. The court excluding the Untamed Revolutionary Rum product from the analysis is in direct conflict with its belief that the word "merely" allows a genuine commercial use to be bona fide even if one of the purposes of the use is to "reserve a right in a mark." *Id.* Here, Lodestar had *one* general commercial use for developing the Untamed Revolutionary Rum: to expand its brand by complementing the Wild Geese Rum. *Id.*

¹²¹ *Id.* at 1256.

genuine commercial use for developing its product and was not solely focused on reserving its right to the mark for future litigation.

As a way to justify its decision to exclude the Untamed Revolutionary Rum from the likelihood of confusion analysis, the court relies on its recent decision in the case *Soc. Techs. LLC v. Apple Inc.*¹²² The court's reliance on *Social Technologies* case is misguided. The court concluded that the plaintiff's use of its "MEMOJI" mark was not a bona fide use in commerce because it was not developed for genuine commercial reasons, thus warranting no trademark protection.¹²³

When comparing *Lodestar* and *Social Technologies*, both companies' marks were not considered bona fide because of minimal to no sales and limited preparatory activities.¹²⁴ Still, there are some stark differences to consider. In *Social Technologies*, internal emails revealed that the creation of the memoji application was "merely to reserve its rights for a lawsuit against Apple."¹²⁵ In contrast, *Lodestar* developed its Untamed Revolutionary Rum to complement The Wild Geese Soldiers & Heroes Rum *and* combat Bacardi's campaign.¹²⁶ The other key difference is the manner in which the mark was used. *Social Technologies* only had a single use of its mark in commerce.¹²⁷ Whereas, *Lodestar* had two uses of its mark in commerce.¹²⁸ *Lodestar* used its "Untamed" mark in commerce on The Wild Geese Rum prior to its use of the mark on Untamed Revolutionary Rum.¹²⁹ While *Social Technologies* never

¹²² *Soc. Techs. LLC v. Apple Inc.*, 4 F.4th 811, 819-22 (9th Cir. 2021). In April 2016, Social Tech filed an application to register the trademark MEMOJI, based on its bona fide intent to use the mark on mobile phone software. *Id.* at 814. After the USPTO approved the application, Social Tech made a business plan and secured an investor. *Id.* On June 4, 2018, Apple announced its own MEMOJI software. *Id.* After Apple's MEMOJI announcement, Social Tech rushed to develop and launch its product and used the app launch to submit a statement of use for its trademark application in order to secure its MEMOJI mark. *Id.* at 815. Social Tech sued Apple for infringing upon its registered mark. *Id.* at 816. In response, Apple argued that Social Tech's mark should be canceled because it failed to use the mark in commerce sufficiently. *Id.*

¹²³ *Id.* at 821.

¹²⁴ *Lodestar*, 31 F.4th at 1257-58.

¹²⁵ *Soc. Techs LLC*, 4 F.4th at 820. In emails exchanged between *Social Technologies* and its software developer, Bonet stated:

The lawsuit is coming together nicely. . . . [We are just waiting for the trademark registration to file the lawsuit and get PAID." "[w]e are lining up all of our information, in preparation for a nice lawsuit against Apple, Inc! We are looking REALLY good. Get your Lamborghini picked out!" and "[i]t's better if we split up the updates, so it looks like we have more of them for the lawsuit.

Id. at 815-16. *Social Technologies*' goal was never to deliver a product. *Id.* Instead, its goal was for Apple to open up its wallet. *Id.* Unlike *Social Technologies*, *Lodestar* had pure intentions in developing its Untamed Revolutionary Rum product. *Lodestar* wanted to complement its first product and prevent a larger corporation from pilfering its mark. *Lodestar*, 31 F.4th at 1257.

¹²⁶ *Id.*

¹²⁷ *Soc. Techs. LLC*, 4 F.4th at 820. The single use was the app launch of the MEMOJI software application that had to be immediately removed from the Google Play Store due to system bugs. *Id.* at 815.

¹²⁸ *Lodestar*, 31 F.4th at 1255. *Lodestar*'s two uses included The Wild Geese Soldiers & Heroes Rum and the Untamed Revolutionary Rum. *Id.*

¹²⁹ *Id.*

had a valid registered mark to begin with,¹³⁰ Lodestar did because of its first use.¹³¹ Lodestar was simply extending its use of the mark with the subsequent product.

C. Proposing an “Inverse” Trademark Dilution Test

In affirming summary judgment for Bacardi, the Ninth Circuit failed to recognize the opportunity to comment on a valid public policy concern: protecting smaller, lesser-known businesses from larger, well-known corporations.¹³² In ruling in favor of Bacardi, the court sets a precedent in favor of allowing well-known, larger corporations to use the mark of a smaller business despite the smaller business being the owner and first user of the mark.¹³³ Such an outcome could enable larger corporations to easily pilfer trademarks and stifle smaller companies’ opportunities to grow and expand their brands. The goal of the court should be to encourage and promote the development and expansion of smaller businesses.¹³⁴ After all, a company’s mark can only become famous if it is allowed the opportunity to expand.

Since trademark dilution was designed only to protect owners of “famous” trademarks from unauthorized uses of their mark in a way that diminishes its distinctiveness, a new approach should be considered to protect owners of less “famous” trademarks in the interest of public policy.¹³⁵ Rather than only protecting already established “famous” marks from unauthorized uses by other companies,¹³⁶ an “inverse” trademark dilution test would prioritize the protection of the smaller company’s less “famous” protected mark if well-established companies wrongfully use the mark for their own benefit. Such an approach to trademark infringement would allow the smaller business with a protected mark to continue using their mark without mistakenly being connected to a well-known business. Essentially, this new test would operate the opposite of trademark dilution because it would favor small businesses that have a protected mark that is not “famous” over a wider-known company infringer. Perhaps a smaller business could benefit from a larger company using its trademark if that company’s reputation would positively impact the smaller business. However, it is important to consider that a smaller business may want to exist apart

¹³⁰ *Soc. Techs. LLC*, 4 F.4th at 815.

¹³¹ *Lodestar*, 31 F.4th at 1257.

¹³² *Id.* at 1261.

¹³³ *Id.* at 1235-36. The Ninth Circuit concluded that Lodestar had a valid right of priority over Bacardi in the U.S. for the “Untamed” mark – and thus a valid right to pursue a trademark infringement claim – through the Madrid Protocol as adopted by the Lanham Act, even though Lodestar may not have used the mark in the U.S. until after Bacardi had begun using its mark. *Id.* Even after deciding Lodestar owned the mark, the court still ruled in favor of Bacardi. *Id.*

¹³⁴ How Small Businesses Impact Their Communities, (Sept. 27, 2022), <https://cumberlandbusiness.com/news/how-small-businesses-impact-their-communities/>. When smaller businesses are encouraged to develop and expand, they become larger corporations. *Id.* As larger corporations, they become major players in the national and international marketplace. *Id.* Specifically, these smaller companies are an essential part of building the economy by encouraging competition in the market and providing employment opportunities. *Id.* They also attract talent who invent new products and services or solutions for already existing ideas. *Id.* Lastly, smaller companies create a more diverse marketplace. *Id.*

¹³⁵ See Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, 120 Stat. 1730 (codified in various sections of 15 U.S.C.).

¹³⁶ *Id.*

from the larger, well-known corporation. More importantly, a smaller business may not want to be associated with a company that has a poor reputation.¹³⁷ Overall, the concept of an “inverse” trademark dilution test would allow courts a legal avenue for protecting smaller companies from larger corporations.

The argument for “inverse” trademark dilution is rooted in public policy. Some smaller businesses cannot afford to defend themselves in court against larger corporations due to the lack of resources, status, and leverage.¹³⁸ Notably, Lodestar was not discouraged by Bacardi attempting to infringe on its mark.¹³⁹ Lodestar continues to use its “Untamed” mark in different ways to grow and expand its business.¹⁴⁰ However, not all smaller companies have the courage or ability to fight larger corporations.¹⁴¹ If courts continue to neglect the valid intellectual property interests of smaller companies, it will suppress their growth, development, and ingenuity.¹⁴²

¹³⁷ *Bisous Bisous LLC v. Clé Grp.*, No. 3:21-CV-1614-B, 2021 U.S. Dist. LEXIS 153427, at *38-39 n.8 (N.D. Tex. Aug. 16, 2021). *Bisous Bisous*, a smaller business, filed a trademark infringement suit against Clé Group, a large company, for using the word “Bisou” for Clé Group’s restaurant. *Id.* at *2. *Bisous Bisous* is a French bakery, and *Bisou* is a restaurant with nightclub-like experiences. *Id.* The original location for *Bisou* was in Houston, and the second location was in Dallas. *Id.* *Bisous Bisous* asserted that *Bisou Houston*’s negative reputation could tarnish *Bisous Bisous*’s reputation if it is mistakenly associated with *Bisou Dallas*. *Id.* at n.8. This is an example of a smaller business that owns a protected mark, not wanting to be associated with a larger corporation that infringed on the protected mark due in part to the larger corporation’s poor reputation. *Id.*

¹³⁸ Anthony James Dispoto, *Protecting Small Businesses Against Trademark Bullying: Creating a Federal Law to Remove the Disparity of Leverage Trademark Holders Maintain Over Small Businesses*, 16 SAN DIEGO INT’L L.J. 457, 473 n.102 (2015); see also Leah Chan Grinvald, *Shaming Trademark Bullies*, 2011 WIS. L. REV. 625, 654-57 (2011) (discussing the effectiveness and availability of shaming to small business and individuals).

¹³⁹ *Lodestar*, 31 F.4th at 1244.

¹⁴⁰ See *The Wild Geese Irish Soldiers & Heroes Collection* (illustration), <https://twgisah.com/> [<https://web.archive.org/web/20160323181054/https://twgisah.com/>] (last visited Oct. 23, 2022, 10:50 AM). In 2014, The Wild Geese website displayed two Wild Geese Rum collections: Irish Whiskey and Rum. On one bottle, the “Untamed” word is displayed inside its logo and on the back of the bottle. *Id.* Today, the Wild Geese website displays three different Wild Geese Rum collections: Heritage, Rum, and Descendants. *Id.* The Heritage Collection includes five different Irish Whiskies. *Id.* The Rum Collection includes three different Rums. *Id.* Lastly, the Descendants Collection includes four different Malt and Rum Irish Whiskies. *Id.* The Wild Geese also developed five Untamed Spirits that range from rum, whiskey, gin, and vodka. *Id.* The Untamed Revolutionary Rum is included in this range of spirits. *Id.* The “Untamed” word mark appears prominently on the front of all the bottles. *Id.* Over the past eight years, Lodestar has used its “Untamed” mark to simply expand and grow its business which now includes a wide range of Untamed spirits. *Id.*; *Clothing & Accessories* (photographs), THE WILD GEESE SOLDIERS & HEROES COLLECTION, <https://www.irishpremiumspirits.com/clothing-accessories/> (last visited Oct. 23, 2022, 11:00 AM). Not only did The Wild Geese expand its use of the “Untamed” mark pertaining to alcoholic beverages, but it also extended its use to apparel. *Id.* The “Untamed” mark appears on various t-shirts. *Id.*

¹⁴¹ Sara M. Andrzejewski, *Leave Little Guys Alone!: Protecting Small Businesses from Overly Litigious Corporations and Trademark Infringement Suits*, 19 J. INTELL. PROP. L. 117, 134 (2011) (“the small business owner may feel defeated before even stepping foot into the courthouse when ‘faced with uncertainties such as length of a trial, the amount of discovery required, the success of winning on the merits and the likelihood of appeal’”).

¹⁴² See Dispoto, *supra* note 138, at 470 (“Threatening a small business not only imposes the costs of trademark infringement but, based on Justice Kennedy’s words, could harm potential future profits

V. CONCLUSION

The Ninth Circuit erred when it affirmed the district court's grant of summary judgment in favor of Bacardi, concluding that no reasonable jury could find for Lodestar on its infringement claims.¹⁴³ Although the court correctly found that Lodestar had a right of priority and was the senior user of its "Untamed" mark under the Madrid Protocol,¹⁴⁴ it incorrectly concluded on the *Sleekcraft* factors and bona fide use in commerce analyses.

Regarding the *Sleekcraft* factors, the court wrongfully placed a significant amount of weight on the evidence of actual confusion factor.¹⁴⁵ The court heavily emphasized the fact that Lodestar was unable to identify actual confusion among consumers.¹⁴⁶ However, the Ninth Circuit repeatedly claims that evidence of actual confusion is not required to find a likelihood of confusion.¹⁴⁷ Clearly, this did not apply in *Lodestar* because the court still found in favor of Bacardi despite this precedent.¹⁴⁸ This alone proves that the Ninth Circuit's reasoning is inconsistent.

Furthermore, the court wrongfully excluded Lodestar's Untamed Revolutionary Rum product from the likelihood of confusion analysis because it was a bona fide use. A genuine commercial use and a use to reserve a right in a mark can co-exist.¹⁴⁹ The use of the "Untamed" mark on the Untamed Revolutionary Rum was a bona fide use because Lodestar created the product to expand its brand *and* combat Bacardi's campaign.¹⁵⁰ Thus, Lodestar's "Untamed" mark on this product should have been given trademark protection against Bacardi's use of the mark in the phrase "Bacardi Untameable."

for a business as well. With a small business where the potential to improve can be astronomical, the harm that can be incurred cannot reasonably be valued. For those trademark bullies that bring actions against small companies, there is potential for abuse that may bring a trademark infringement action purposefully to stall a small businesses development.”).

¹⁴³ *Lodestar*, 31 F.4th at 1261. Overall, the Ninth Circuit's decision in *Lodestar* lowered the summary judgment standard for defendants by making it easier to prove no likelihood of confusion exists. *See generally Id.* at 1235. It is the start of larger corporations using the marks of smaller businesses despite the smaller businesses being the owners and first users of their marks. *Id.*

¹⁴⁴ *Id.* at 1248-51. On August 19, 2009, the Patent and Trademark Office (PTO) approved an extension of protection application for Lodestar's Untamed Word Mark in connection with rum, whiskey, and distilled spirits. *Id.* Thus, Lodestar was given a "right of priority" against Bacardi regarding the use of the Untamed Word Mark on or in connection with rum. *Id.* In addition, this extension of protection constitutes "prima facie evidence" that Lodestar owns the mark and has the "exclusive right" to use it "on or in connection with" rum or whiskey. *Id.*

¹⁴⁵ *Id.* at 1261.

¹⁴⁶ *Id.*

¹⁴⁷ *Eclipse*, 894 F.2d at 1118; *see also Res. Lenders, Inc.*, 404 F. Supp. 2d at 1244; *VersaTop Support Sys., LLC*, 921 F.3d at 1372; *Rodeo Collection, Ltd.*, 812 F.2d at 1219; *Park 'N Fly, Inc.*, 782 F.2d at 1509; *see also Ironhawk Techs.*, 2 F.4th at 1161 (previously ruling that "the presence or absence of a particular factor does not necessarily drive the determination of a likelihood of confusion").

¹⁴⁸ *Lodestar*, 31 F.4th at 1261.

¹⁴⁹ *Id.* at 1256. ("The use of the word 'merely' confirms that an otherwise genuine commercial use is 'bona fide' even though one of the purposes of the use is to 'reserve a right in a mark'").

¹⁵⁰ *Id.* at 1257.