STANDING THE TEST OF TIME: LIKELIHOOD OF CONFUSION IN MULTI TIME MACHINE v. AMAZON

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In Multi Time Machine v. Amazon, a three-judge panel from the Ninth Circuit struggled once again to apply the brick-and-mortar doctrines of trademark law to an online context. This time, the court’s bête noire reappeared in questions about the multifactor, so-called Sleekcraft test. Amazon displayed watches with a similar trade dress in response to a search for the trademarked brand of military watches not sold on the site. First, the Ninth Circuit reversed the district court’s holding that none of the four relevant factors from the Sleekcraft test suggested that Amazon’s search results page was likely to confuse a reasonably prudent consumer. A few months later, in an unusual move, the same three-judge panel withdrew its opinion in response to Amazon’s petition for rehearing and affirmed the lower court. In a rejoinder to its previous opinion and the inclusion of intent among the Sleekcraft factors, the Ninth Circuit found that the multifactor test was “not particularly apt” to assess consumer confusion that was not between two competing brands. Instead, all that mattered was what a reasonably prudent consumer would believe based on Amazon’s search

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1. Multi Time Mach., Inc. v. Amazon.com, Inc. (MTM III), 804 F.3d 930 (9th Cir. 2015).
3. See AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341, 348815–49 (9th Cir. 1979).
4. MTM III, 804 F.3d at 935.
5. Multi Time Mach., Inc. v. Amazon.com, Inc. (MTM I), 926 F. Supp. 2d 1130, 1132 (C.D. Cal. 2013), rev’d and remanded sub nom. Multi Time Mach., Inc. v. Amazon.com, Inc. (MTM II), 792 F.3d 1070 (9th Cir. 2015), opinion withdrawn and superseded on reh’g, 804 F.3d 930 (9th Cir. 2015), and aff’d sub nom. Multi Time Mach., Inc. v. Amazon.com, Inc. (MTM III), 804 F.3d 930 (9th Cir. 2015).
6. MTM III, 804 F.3d at 933.
7. Id. at 936.
results.\(^8\) To assess those beliefs, the court turned to a prior application of the *Sleekcraft* factors to search results.\(^9\)

The court’s desire to revise the likelihood of confusion analysis for Internet commerce and shifting consumer expectations in its second opinion is understandable. Buying a watch on Amazon in 2015 resembles buying a speedboat in the 1970s,\(^{10}\) the context in which the circuit originally fashioned its test, in that it requires an exchange of money for goods. However, the way consumers learn about, pay for, and even physically receive goods has changed dramatically.\(^{11}\) Marketing channels, for instance, assume much less importance in the analysis of consumer confusion on the Internet.\(^{12}\) Although replacing the long-standing *Sleekcraft* test with the fast and frugal heuristic of a reasonable consumer might serve the aims of judicial economy,\(^{13}\) it does not necessarily better serve the aims of trademark law, which are the avoidance of consumer confusion and enforcement of market morality.

Part I of this Note tracks the development of intent and the tort of palming off in trademark law and judicial rhetoric. Part II explains how Amazon’s business model creates negative externalities for competitors and consumers akin to those that trademark law traditionally aims to deter. Part III discusses the Ninth Circuit’s analysis, using the *Sleekcraft* factors and the court’s more recent, reasonably-prudent-consumer formulation. Part IV argues that a multifactor likelihood of confusion test preserves deliberation and the historical construct of trademark infringement as a tort. Using the early-twentieth-century trade morals that motivated the Lanham Act, courts can craft the correct incentives for new technologies.

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8. *Id.* at 937.
9. The court’s use of the same four factors is somewhat strange considering that in the prior paragraph the court claimed that those factors were not particularly apt. *Id.* (citing Network Automation, Inc. v. Advanced Sys. Concepts, Inc., 638 F.3d 1137, 1152 (9th Cir. 2011) (using four of the *Sleekcraft* factors as a proxy for what a reasonably prudent consumer believes)).
10. The Ninth Circuit developed its *Sleekcraft* test for confusion in this context. *See Sleekcraft*, 599 F.2d at 346.
11. On the growth of Internet commerce, see Brief for Google, Inc. et al. as Amici Curiae Supporting Defendant-Appellee Amazon.com at 6–7, *MTM III*, 804 F.3d 930 (9th Cir. 2015) (No. 13-55575).
12. *See Network Automation*, 638 F.3d at 1151 (“[T]he shared use of a ubiquitous marketing channel does not shed much light on the likelihood of consumer confusion.”).
13. Some studies suggest that heuristics of two or three elements produce more accurate decisions than those that attempt to consider a situation more comprehensively. On “stampeding” factors in the analysis of trademark infringement, see Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CALIF. L. REV. 1581, 1586 n.25 (2006).
I. TRADEMARK LAW

To understand why the factors encompassed by the Sleekcraft likelihood of confusion test should continue to matter in analyzing trademark infringement on the Internet, it is important to understand why they ever mattered at all.

A. THE COMMON LAW OF PALMING OFF

The origins of and justifications for trademark law are murky. The first action for a fraudulent use of another’s mark occurred in the sixteenth century. Yet scholars of trademark law still debate why laws should limit competition and speech to protect signs, which have no intrinsic value.

One justification is that trademarks are not empty signs. Instead, they are potent symbols that perform the valuable work of identification in the market. Trademarks allow consumers to locate goods and services that they prefer, based on their past experiences or on advertising. Because of trademarks, once consumers have decided that they prefer goods from one mark, they can be confident that the product sold under that mark comes from the same source every time. Trademarks also assure their owners that their investments in the quality and consistency of their products will not go unnoticed by consumers. Consumers will reward trademark owners for their efforts with continued business. According to this economic view,


16. See Beebe, supra note 14, at 624.

17. Id. at 657.


19. See id. at § 2.5.

20. See id. at § 2.4.

21. See id.
trademark law “can best be explained on the hypothesis that the law is trying to promote economic efficiency.”

Others argue that trademark law originally enforced an honor code of market morality among merchants. While courts in early trademark cases balanced the competing interests of merchants and consumers, merchants invariably brought their claims as torts for fraud that hindered fair competition. In one early case in which the defendant had applied the plaintiff’s label to bolts of competing ticking, the court emphasized that trademark law should not restrain free trade. Rather, trademark law’s “direct tendency is to produce and encourage a competition, by which the interests of the public are sure to be promoted; a competition that stimulates effort and leads to excellence, from the certainty of an adequate reward.” Like any other tort, early trademark law sought not only to make injured parties whole but also to penalize the tortfeasors who used fraud to injure the public’s interest in free, informed competition.

In William R. Warner v. Eli Lilly, the Supreme Court identified palming off as a species of the tort of unfair competition. It held that Warner, who made a cheaper, chocolate-flavored quinine solution with a similar name and appearance to Eli Lilly’s quinine solution, was liable for encouraging retail druggists to palm it off in place of the plaintiff’s product. The similar name and appearance of the defendant’s product did not in themselves infringe the plaintiff’s trademark. The small, individual retailers ultimately deceived consumers when they presented the defendant’s product in response to requests for the plaintiff’s mark. Nevertheless, the Court reasoned that “[o]ne who induces another to commit a fraud and furnishes

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27. 265 U.S. 526, 532 (1924).
28. Id.
29. Id. (“The legal wrong does not consist in the mere use of chocolate as an ingredient, but in the unfair and fraudulent advantage which is taken of such use to pass off the product as that of respondent.”).
the means of consummating it is equally guilty and liable for the injury.” 30
While there is some question over whether this holding survived the passage of the Lanham Act (“Act”), 31 federal courts continued to hear claims for contributory trademark infringement before Congress passed the Act in 1946. 32

**B. LANHAM ACT**

The Lanham Act provides for the registration of trademarks and creates a federal cause of action for their infringement. Tort law once sufficed to ensure fair competition, protect merchants and consumers, and punish fraud from both direct and contributory infringers. However, by 1900, the risk of fraudulent, unfair competition to a producer’s investment in their brand appeared greater than before. 33 Technology and advertising allowed a mark to reach distant consumers more quickly and to build its reputation even among those who never bought the product. 34 The expanded reach of brands made their protection by state laws impractical, so Congress enacted the first federal trademark registration statute in 1905. 35

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30. Id. at 530–31.
33. On the history of trademark law as trade morals, see Louis D. Brandeis, Cutthroat Prices: Competition that Kills, HARPER’S WEEKLY, Nov. 15, 1913, at 10.
34. On the relationship between investment in advertising and moves to protect it through trademark law, see Mark Bartholomew, Advertising and the Transformation of Trademark Law, 38 N.M. L. REV. 1 (2008).
When this original statute proved inadequate to protect trademark owners, Congress passed the Lanham Act on July 5, 1946. It created a cause of action against “[a]ny person who shall, without the consent of the registrant, use in commerce any reproduction . . . of a registered mark in connection with the sale . . . of any goods or services on or in connection with which such use is likely to cause confusion.” The law never mentions those who merely facilitate the use in commerce of a mark, nor how a court might determine if a defendant has facilitated a use. The bill, nevertheless, “preserves the things which have demonstrated their usefulness.” Courts have looked to federal common law that preceded the Lanham Act to interpret its terms.

The Supreme Court affirmed the continued existence of the tort of palming off for trademarks in Inwood Laboratories v. Ives Laboratories in 1982. There, Inwood made a generic version of an expensive pill from Ives. The two versions of the pill appeared identical, and pharmacists substituted the cheaper Inwood version for Ives’s. Rather than hold the individual pharmacists accountable for palming off the cheap pill, Ives sued Inwood for both direct and contributory infringement.

36. In 1938, Erie threw the validity of federal common laws, such as trademark doctrines that held both retailer and manufacturer accountable for palming off, into question. See Cross, supra note 31, at 121; see also S. REP. NO. 1333, 79th Cong., 2d Sess. 3 (1946), reprinted in 1946 U.S. Code Cong. Serv. 1274, 1275. The Senate Report stated: The theory once prevailed that protection of trademarks was entirely a State matter and that the right to a mark was a common law right. This theory was the basis of previous national trademark statutes. Many years ago the Supreme Court held and has recently repeated that there is no Federal common law. It is obvious that the States can change the common law with respect to trademarks and many of them have, with the possible result that there may be as many different varieties of common law as there are States. A man’s rights in his trademark in one State may differ widely from the rights which he enjoys in another.

37. McCARTHY, supra note 17, at § 5:4.


39. These omissions, coupled with the increased rights and remedies available to trademark holders under the Act, make its relationship to previous common-law rules problematic. See Cross, supra note 31, at 111 n.35.

40. See S. REP. 1333, supra note 36, at 1275.


42. 456 U.S. 844, 861 (1982).

43. Id. at 846.

44. Id. at 850.

45. Id. at 846.
argued, directly infringed its trade dress when it copied the appearance of
the pill. It contributed to the pharmacists’ infringement by creating an
opportunity for them to mislabel its identical pill with Ives’s mark.

The Court confirmed the tort of palming off survived the Lanham Act’s
federalization of trademark law. It reiterated the holding from Warner that
a distributor who knowingly continues to supply a product that a retailer
uses to confuse consumers is likewise responsible for the retailer’s palming
off. Because Inwood imitated the color and size of Ives’s pills, it had reason
to know that pharmacists could mislabel the products and infringe Ives’s
mark, even if the color and size had a functional basis that prevented Inwood
from directly infringing Ives’s trade dress.

The Court’s analysis of Inwood’s behavior was simple: Inwood
continued making a cheaper, identical-looking pill, even as it knew
pharmacists would palm the pill off as a genuine Ives product and even as a
lengthy supply chain stood between the drug maker and retailer. The
emergence of the Internet in that supply chain, however, has complicated
courts’ more recent decisions about palming off.

C. THE INTERNET AS BILLBOARD: ADAPTING BRICK-AND-
MORTAR DOCTRINES TO THE INTERNET

Over the last twenty years, courts have grappled with how to apply these
trademark doctrines, designed to punish the fraudulent and confusing
application of marks to inferior bolts of ticking or vials of quinine, to the
more complex commercial landscape of the Internet. Consumers no longer
see and feel the bolts of ticking or vials of quinine before their purchase. On
the Internet, consumers interact with products only through their signs and
descriptions. Generally, courts have eschewed creating new doctrines to

46. Id.
47. Id. at 854.
48. Id. at 858.
49. Id. at 854 (citing William R. Warner v. Eli Lilly, 265 U.S. 526, 530 (1924)) (“The
wrong was in designedly enabling the dealers to palm off the preparation as that of the
respondent.”).
50. Id.
51. Id. at 861–62.
52. As semiotician Paul J. Thibault claimed, “The sign imposes digital order on the
analogue flux of perceptual experience.” PAUL J. THIBAULT, RE-READING SAUSSURE:
The Dynamics of Signs in Social Life 215 (1997). On the application of Thibault’s
semiotics to trademark law, see Beebe, supra note 15, at 635 n.72.
suit new technologies and instead stretch the limits of precedent and brick-and-mortar doctrines, such as palming off, through metaphor.53

1. Early Development: Brookfield Communications and the Information Superhighway

In Brookfield Communications v. West Coast Entertainment,54 the Ninth Circuit first addressed the application of the trademark law to Internet domain names and metatags that early search engines used to find relevant information.55 During its “venture into cyberspace,”56 the court spent more than five hundred words explaining the mechanics of the Internet.57 Internet users, the court claimed, found information by hazarding domain names and crossing their fingers that relevant information might appear.58 West Coast had purchased the moviebuff.com domain to market video rental stores.59 The site included a database of movie trivia, licensed from a competitor of Brookfield.60 Brookfield marketed a database of entertainment information, targeted at professionals, under the mark “MovieBuff.”61 The district court refused to grant an injunction against West Coast’s use because, as a video rental service, West Coast did not seem to compete with Brookfield, an information aggregator.62

To determine if West Coast’s site infringed Brookfield’s mark, the Ninth Circuit looked to the vernacular of the 1990s, which christened the Internet an “information superhighway.”63 Meta tags were billboards along

53. The Ninth Circuit has not been shy about citing Internet-specific precedent from other circuits to support its findings on likelihood of confusion. The final case discussed in this history, Network Automation, cites precedent from the first, second, and tenth circuits. Network Automation, Inc. v. Advanced Sys. Concepts, Inc., 638 F.3d 1137 (9th Cir. 2011). Thus, this otherwise Ninth-Circuit-focused history includes Rosetta Stone v. Google, 676 F.3d 144 (4th Cir. 2012).
54. 174 F.3d 1036 (9th Cir. 1999).
55. Id. at 1041.
56. Id.
57. Id. at 1044.
58. Id. at 1044–45.
59. Id. at 1042.
60. Id. at 1056.
61. Id. at 1051.
62. Id. at 1056.
that highway. Including a competitor’s trademark in those meta tags, the court argued, was just like posting a sign with a false trademark along a highway. Consumers, looking for the trusted, marked product, would pull off the highway, only to find the infringing product in the trademark’s place. By that time, the court theorized, they had invested time and effort in their search and might settle for an infringing product rather than continue their search. The court carefully crafted its highway metaphor to apply initial-interest confusion to a new context with drastically different dynamics and stakes, despite a lack of actual evidence that West Coast’s use of the mark and free movie trivia to promote its rentals diverted any potential purchaser of Brookfield’s detailed entertainment industry information. The court used only three factors from the Sleekcraft analysis—similarity of the marks, relatedness of goods, and use of the Internet as a marketing channel—to infer likelihood of confusion. Despite the court’s warning that “emerging technologies require a flexible approach,” courts in the Ninth Circuit enshrined these three factors as the “Internet troika,” the definitive test for infringement on the Internet.

2. Rosetta Stone and the Internet as a Commons

Although “information highway” eventually lost its cachet as a euphemism for the Internet, the billboard remained a potent metaphor for finding and supplying information on the Internet. By 2012, in Rosetta Stone v. Google, the Internet had become a commons. As it considered the

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64. Brookfield, 174 F.3d at 1064.
65. Id.
66. Id.
67. Id.
68. Id. at 1062. On the lowered search costs of the Internet and their implications for common-law trademark doctrines such as initial interest confusion, see Stacey L. Dogan & Mark A. Lemley, Trademarks and Consumer Search Costs on the Internet, 41 Hous. L. Rev. 777 (2004).
69. Id. at 1053–54.
70. Id. at 1054.
71. See Google Ngram, supra note 63.
73. See id. The metaphor of the Internet as a commons where users both contributed and took information and content appears to date from the late 1990s. See Lawrence Lessig, The Future of Ideas: The Fate of the Commons in a Connected World (2001) 23 n.11.
language-learning software maker’s claims for direct, contributory, and vicarious trademark infringement, the district court compared the Internet to Times Square.74 Ads on search engines like Google were like billboards.75 The search engine, the court found, was no different from the owner of the building.76 The building might supply the space for the billboard, but it does not exert control over the content of the displayed advertisements, and thus cannot be directly liable for infringement.77

On appeal, the Fourth Circuit affirmed the district court’s finding of vicarious liability.78 Nevertheless, the court overturned the lower court’s grant of summary judgment on Rosetta Stone’s claims for direct and contributory infringement.79 Google knew its search results and embedded advertisements could confuse consumers.80 Before 2004, the search engine had not allowed unauthorized advertisers to purchase ads triggered by trademarked keywords.81 In 2009, Google loosened its policies to allow any advertiser to purchase trademarked keyword ads and include the trademark in advertisements for competing products.82 Although expert reports and Google’s internal studies showed that users found both of these practices confusing,83 Google argued that the allegedly confusing ads provided “users with more choice and greater access to relevant information.”84 Google derived seven percent of its total revenue from trademarked terms when it began to loosen its restrictions in 2004.85 Its internal studies showed that loosening those restrictions would boost its revenue although fewer restrictions also risked consumer confusion and thus lawsuits from trademark holders.86

Because Google derived revenue only from ads, not from the sale of goods, the Fourth Circuit found, the search engine lacked the incentive to

75. Id.
76. Id.
77. On the problems of comparing targeted, keyword-generated advertisements to large billboards directed to the public at large, see Orrick, supra note 31, at 817.
79. Id. at 150.
80. Id. at 151.
81. Id.
82. Id. at 151–52.
83. Id. at 156, 158.
84. Id. at 155.
85. Id. at 156.
86. Id.
police confusing ads. Using the circuit’s multifactor confusion test and the Inwood standard, the court found that Google had reason to know that vendors of counterfeit software purchased advertising on the results page for searches of Rosetta Stone’s mark. Like the drugmaker in Inwood, Google had created the opportunity for infringement. Although Google had committed only one act—selling advertising space to likely infringers—the search company could be both directly and contributorily liable for the harm to Rosetta Stone, for it had known that there was a risk of confusing consumers.

3. Network Automation and the Internet as a Department Store

By 2011, in Network Automation v. Advanced System Concepts, in which the court examined whether purchasing advertisements keyed to a competitor’s trademark infringed that mark, the novelty of the Internet had evaporated for the Ninth Circuit. Internet commerce had become commonplace. Using the Internet was no longer the exciting road trip on the information superhighway it had been in Brookfield. Now using the Internet was more akin to buying shirts at a windowless, fluorescent-lit department store, filled with racks of mass-produced, but hardly generic garments. The Internet had become a necessity, a chore even, that “we all use.” Thus, the troika of factors the circuit had used to analyze Internet confusion in Brookfield was no longer relevant to assess consumers’ confusion. Rather than hew strictly to Internet-specific precedent, such as the troika, the circuit decided that the same eight-factor Sleekcraft test for confusion ought to apply equally to confusion on the Internet as anywhere else.

87. Id. at 163.
88. Although the Fourth Circuit cited to Playboy Enterprises, Inc. v. Netscape Communications Corp., 354 F.3d 1020 (9th Cir. 2004), in its decision, the Fourth Circuit’s multifactor, likelihood of confusion test differs slightly from the Ninth Circuit Sleekcraft test. The Fourth Circuit’s test considers the quality of the defendant’s product. See Sara Lee Corp. v. Kayser-Roth Corp., 81 F.3d 455, 463 (4th Cir. 1996).
90. Id.
91. Id.
92. 638 F.3d 1137, 1142 (9th Cir. 2011).
93. Id. at 1152.
94. Id.
95. Id. at 1147–48 (citing Judge Berzon’s concurrence to Playboy Enters., Inc. v. Netscape Comm’ns Corp., 354 F.3d 1020, 1035 (9th Cir. 2004) (Berzon, J. concurring)).
96. Id. at 1148.
97. This was especially true in Network Automation where the consumer in question was buying expensive enterprise software. Id. at 1152.
else.98 The circuit warned courts against adhering to the Sleekcraft test too closely in the Internet context.99 The multifactor test was not exhaustive, and in some circumstances, confusion and infringement might require the analysis of additional factors, such as the design of a website as a whole.100

II. AMAZON: HIGHWAY, BILLBOARD, DEPARTMENT STORE, BARTENDER, DINER, MONOPOLY?

Amazon, to be sure, aspires to be many things. However, unlike the defendants in many online trademark infringement cases, Amazon does not make much money from advertising.101 Thus, its incentives differ from brick-and-mortar defendants’ incentives. Those incentives and the online retailer’s business model elucidate the Ninth Circuit’s conflicting decisions. They also demonstrate why the many factors of the Sleekcraft test remain useful to analyzing likelihood of confusion on the Internet.

A. AMAZON’S ORIGINS

Founded as an online bookseller by Jeff Bezos in 1995, Amazon always aimed to leverage the advantages of technology to sell goods.102 However,
even from its earliest days, Bezos recognized that virtually anyone could sell goods on the Internet. The key was its customers, the trust that they placed in Amazon, and the community created by that trust. Amazon’s marketing materials continue to tout its business as “customer-centric” and based on “customer obsession rather than competition focus.” The retailer lists “customer reviews, 1-click shopping, [and] personalized recommendations” first among its signature, pioneering services. To attract and retain customers, Amazon offered quick shipping, responsive customer service, and generous return policies.

B. CONSUMER-CENTRIC MISSION

Amazon also had to learn what each of its customers liked. From the earliest business plans, Jeff Bezos told investors that Amazon would offer more than just an online version of a mail-order catalog. It would customize the site and its offerings to each customer. At first, Amazon simply asked its customers what they liked. Its Bookmatch program asked

103. de Jonge, supra note 102, at 38 (“While it is true that if all you want to do is to put up something for sale, the barriers of entry are extremely low on the Internet. If you actually want to sell a lot of that stuff, they’re quite high and getting higher all the time . . . .”).

104. In 1998, online retailers like Amazon spent twenty-six dollars per sale in advertising and marketing to attract customers. See id. Bezos was apparently candid about the importance of customer data from the start. He reportedly told another bookseller in 1995 that “Amazon intended to sell books as a way of gathering data on affluent, educated shoppers. The books would be priced close to cost, in order to increase sales volume. After collecting data on millions of customers, Amazon could figure out how to sell everything else dirt cheap on the Internet.” George Packer, Cheap Words, NEW YORKER, Feb. 17, 2014, at 66. In 1999, David Shaw confirmed, “Making money on books was almost irrelevant, compared with establishing Amazon as the most trusted brand in this new space.” See de Jonge, supra note 102, at 40.


106. Id.

107. Id. at 41, 51–52.

108. Bezos had long sought to capitalize on technology’s promise as a way to learn about individuals and offer customized products and services. In the late 1980s, he started a company that faxed customized newsletters to customers based on their characteristics and preferences. Id. at 20. In a 1998 speech, he cited customization as online retailing’s chief advantage over its brick-and-mortar competitors: “Great merchants have never had the opportunity to understand their customers in a truly individualized way. E-commerce is going to make that possible.” Id. at 52 n.13.

109. Id. at 41, 51–52.

110. Id. at 41.

111. Id. at 51.
customers to rate a dozen books. Based on those preferences and the preferences of similar users, it would recommend other books. However, the software was slow. Worst of all for consumer-centric Amazon, customers found rating books tedious and seldom took the extra effort necessary to produce the recommendations. Still eager to capitalize on technology’s nascent ability to engage customers through customized recommendations, which were essentially advertisements, Amazon needed a simpler way to learn what its customers wanted. So, it looked at what they had already purchased. Customization based on purchase history, a feature known as Similarities, avoided the extra rating step that customers disliked and led to an increase in sales of recommended products. Its success proved the predictive and thus monetary value of that information to Amazon and its advertisers.

C. SEARCH AS AN ASSET

Amazon continued to lean heavily on consumer information to sell products. After Similarities’s initial success, Amazon eliminated the editorial staff that wrote descriptions of products and targeted e-mails. Amabot, a recommendation system, replaced the writers. Around the

113. STONE, supra note 107, at 51.
114. Id.
115. Id.
116. Id.
117. When negotiating with publishers, Amazon threatened to banish their catalogs from the personalization and recommendation algorithms. Acting on this threat has made some publishers’ sales drop as much as 40 percent, according to one of Amazon’s senior book buyers. Id. at 243. For an argument that Amazon’s massive market power in digital books violates or at least should violate antitrust laws, see Franklin Foer, If You Like Amazon, You May Also Like, THE NEW REPUBLIC, Oct. 27, 2014, at 18–20. One proposal to reform Great Depression era trade morals to curb the excesses of large retailers today appears in John B. Kirkwood, Reforming the Robinson-Patman Act to Serve Consumers and Control Powerful Buyers, 60 ANTITRUST BULL. 358 (2015).
119. On the gradual decline of the editorial unit, of which Bezos had initially been a strong proponent, and the consequent rise of the personalization unit at Amazon, see generally JAMES MARCUS, AMAZONIA (2004).
120. See id. at 246 (“The editors, you see, still spent a disgraceful amount of time fiddling with content. That was a proven time sink and a money pit. The obvious solution: automate the category pages, add a host of personalization widgets . . . .”). Amazon
time that Amazon introduced Similarities, the retailer also realized that its search engine, licensed from Alta Vista, was inadequate to help customers locate goods in its vast catalog. Amazon replaced the licensed search with a proprietary search engine that identified which products customers clicked on most often for a given search term. Subsequent search results ranked those products more highly. However, as its catalog continued to grow and Google became synonymous with online search in the vernacular, Amazon worried that it would lose valuable information about its customers if it did not improve its search engine.

To that end, the company launched A9 in 2003. It pioneered using consumer behavior not just to rank matches, but also to understand the customer's original search query. The A9 site currently touts that its search can tell whether a customer's search for “Timbaland” seeks music by that artist or boots from the similarly named outfitter. It also designed the “Search Inside the Book” feature that allows consumers to look at snippets of text. The same feature allows Amazon’s product search to return books whose text contains customer search terms. Because A9’s algorithms rely on previous consumer behavior, they are just as likely to return similar products that do not explicitly contain the search term as they are products that do. The search results page does not differentiate between those products found using behavior-based search and those found with a more traditional

similarly uses data about its employees to manage them, leading one employee to remark, “If you’re a good Amazonian, you become an Amabot,” in an exposé of the company's corporate culture. See Jodi Kantor & David Streitfeld, Amazon’s Bruising, Thrilling Workplace, N.Y. TIMES, Aug. 15, 2015, at A1.

121. STONE, supra note 105, at 198.

122. On the pitfalls of early behavioral-based searches in Amazon’s expanding catalog, see MARCUS, supra note 117, at 181–82. (“If you came to the site in search of Frederick M. Lawrence’s Punishing Hate: Bias Crime Under American Law, we steered you toward a Z-Force Stun Gun. Visitors seeking a copy of Philip Pullman’s The Subtle Knife . . . were urged to bid on an assortment of switchblades.”).

123. STONE, supra note 105, at 198–99.

124. Amazon had reason for concern. In 1998, it purchased Junglee, a search engine that could compare prices across sites, in an effort to improve its search. Junglee's founders left Amazon within a year, one of them to advise Google. See STONE, supra note 105, at 83; MARCUS, supra note 117, at 145–46.


127. A9, supra note 126.

128. STONE, supra note 105, at 197.
keyword search. A9’s innovations improved the Product Search on Amazon’s website and the search function that Amazon licenses to other online retailers through its Web Services.129

Most defendants accused of palming off have lacked a Web Services division to subsidize their main retailing business. They sell things. To the extent that that sales price exceeds their costs, they profit. Amazon’s improved search function and their Web Services are a boon to consumers who enjoy lower prices and increased selection in exchange for their information. However, Amazon’s reliance on Web Services for profitability complicates its incentives and consequently the likelihood of confusion analysis.

III. MULTITIME MACHINE V. AMAZON

Multi Time Machine (MTM) is less enthusiastic about Amazon and A9’s innovations in product search.130 Customers who search Amazon for its trademark, it believes, should not see similar goods.131 Thus, in 2013, after e-mailing Amazon about its search algorithm, MTM filed a lawsuit for trademark infringement in the Central District of California and began a nearly three-year saga.132

A. MULTI TIME MACHINE

MTM manufactures and sells high-end, yet rugged, watches for the military and law enforcement in difficult conditions.133 They are niche products and the company’s sales average around four million dollars annually.134 It owns the registered trademarks for MTM Special Ops and MTM Military Ops and carefully cultivates the rugged, martial imagery

129. The importance of Amazon Web Services, including A9, to the company’s bottom line is difficult to overstate. In its quarterly earnings statement issued on October 22, 2015, Amazon Web Services logged a profit of $687 million on cloud services sales of $2.4 billion. See AMAZON, supra note 104. Amazon Web Services controls twenty-nine percent of the cloud computing market. Barb Darrow, In the Cloud, Google Jockeys for Position, FORTUNE, March 1, 2016, at 42–43.

130. Brief for the Plaintiff-Appellant at 2–3, MTM II, 792 F.3d 1070 (9th Cir. 2015) (No. 13-55575).

131. MTM III, 804 F.3d at 932.


that surrounds its watches. Its website displays testimonials from soldiers about wearing the watches during their tours in Iraq, alongside screenshots of celebrities, such as Jason Statham, sporting the watches in action films.

As part of this marketing strategy and to maintain its close association with the military elite and those who play them on TV, MTM limits the retailers who sell its watches. It does not allow Amazon.com to sell them, nor does it allow its authorized distributors to sell through Amazon. Nevertheless, when a consumer enters “mtm special ops” into Amazon’s search, the site returns results that include competitor watches from Luminox, Chase-Durer, and Modus beneath the phrase “mtm special ops,” in quotation marks. Images and large text labels indicate the brands of the competing products.

B. THE DISPUTED SEARCH RESULTS

Despite the individual labels, MTM contended that the results page confused potential purchasers of its watch. Amazon, MTM claimed, was no better than the bar in the Topaz Casino from Coca-Cola v. Overland, where bartenders passed off a presumably vile concoction of rum and Pepsi for orders of rum and Coke. MTM claimed that displaying competing watches under a search bar with MTM’s mark potentially implied a relationship between the brands and could divert sales away from its products to competing products with a similar trade dress. To support its contentions, MTM’s expert compared Amazon to other online retailers, such as Overstock and Buy.com, whose search engines returned no results for its trademark. The watchmaker also submitted an expert report stating

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137. Brief for the Plaintiff-Appellant, supra note 130, at 6.
138. Id. at 7.
139. See infra Appendix.
140. Id. at 7.
141. Complaint, supra note 135, at ¶ 25.
143. Complaint, supra note 135, at ¶ 25.
144. Plaintiff’s Memorandum, supra note 142, at 23 (citing the expert report of William A. Markson, Complaint, Exhibit 1, ¶ 2).
that the search results on Amazon were “very confusing, unclear, and at times very misleading to users.”

Amazon countered that showing competing products with similar trade dress in the search results for a trademarked term did not confuse consumers. Rather, it served them better. Consumers who search for a trademark, Amazon claimed, do not necessarily want to see only products associated with that trademark. Amazon argued it was not so much like the casino bar from Coca-Cola. Instead, Amazon, in its view, was more like the maker of expensive enterprise software from Network Automation who had not infringed its rival’s trademark when it purchased keyword ads for that trademark to allow informed consumers to comparison-shop. As a search term, a trademark could indicate that the consumer wants to see compatible products or broad categories of products. Consumers who searched for the “mtm” mark seldom ultimately buy expensive watches.

Amazon further argued that the repetition of the trademarked search phrase above the search results did not necessarily label those results. It was only a “breadcrumb,” included for consumers’ reference to allow them to revise their search. A thick gray bar “visually partitioned” the trademarked search term from the product results, obviating any risk of consumer confusion. Amazon argued that this breadcrumb was not “use in commerce” under the Lanham Act. Unlike search engines that sold

145. Id.
147. Defendant’s Motion, supra note 146, at 6–7.
148. Id.
150. Amazon’s search algorithm takes these different search motives into account by modifying search results based on prior searches and purchases. Its results page displays these results alongside more traditional keyword matches. See Defendant’s Motion, supra note 146, at 21.
151. Id. at 22.
152. “Breadcrumbs” are elements that aid navigation in user interfaces by allowing users to keep track of their locations within programs, documents, or websites. The term comes from the trail of breadcrumbs left by Hansel and Gretel in the eponymous fairytale. See Mark Levene, An Introduction to Search Engines and Web Navigation 221 (2011).
153. Defendant’s Motion, supra note 146, at 6–7.
154. Id. at 22.
155. Id. at 11.
keywords to others, Amazon only used them in its own proprietary search. MTM’s expert countered that Amazon’s proprietary search was nothing more than a glorified “behavior tracking platform that facilitates generating targeted advertising.” Amazon, according to MTM’s expert, could easily make its results less confusing, but it had no incentive to do so. The product listings included source labels next to the images and titles of the products. The question was whether the application of MTM’s mark to Amazon’s search results labeled those search results and thus created confusion about the source of the products included therein.

C. DISTRICT COURT’S GRANT OF SUMMARY JUDGMENT

The district court agreed with Amazon, holding that the online retailer’s search results did not confuse consumers or infringe MTM’s trademark. Like many courts tasked with applying trademark law to the Internet, the district court began its analysis of Amazon’s motion for summary judgment on MTM’s claims with a metaphor. The court stuck with the department store metaphor that first appeared in the concurrence of Playboy. There, Judge Berzon presciently doubted that Amazon, like a department store, could infringe a trademark by presenting competing goods to consumers.

Like Judge Berzon, the district court in MTM I doubted that Amazon’s search results infringed MTM’s trademark. Although it agreed that Amazon had used the mark in commerce because it provided a search engine for the purpose of selling goods, it held that the search results did not create a likelihood of confusion. To analyze likelihood of confusion, the court looked to Network Automation and its flexible application of the

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156. This argument echoes concerns about expanding direct liability for infringement to even uses that do not compete with the mark holder. See Dogan & Lemley, supra note 41, at 1686.

157. Complaint, supra note 135, at Exhibit 1, ¶ B.

158. Id. at 17, ¶ C.

159. Defendant’s Motion, supra note 146, at 21.


161. Id. at 1135.


163. Id. (quoted in MTM I, 926 F. Supp. 2d at 1135 (“If I went to Macy’s website and did a search for a Calvin Klein shirt, would Macy’s violate Calvin Klein’s trademark if it responded (as does Amazon.com, for example) with the requested shirt and pictures of other shirts I might like to consider as well? I very much doubt it.”).

164. MTM I, 926 F. Supp. 2d at 1142.

165. Id.
Sleekcraft factors to search results on the Internet.\textsuperscript{166} The court applied the same factors as the Ninth Circuit had in Network Automation—mark strength, actual confusion, consumers’ degree of care, and labeling.\textsuperscript{167} None of these, in the court’s view, created a likelihood of confusion.\textsuperscript{168} The court seized on MTM’s evocation of Overland and compared Amazon to a bartender.\textsuperscript{169} As a bartender, according to the court, Amazon had bizarrely presented its customer with “a tray with unopened, labeled, authentic cans of Pepsi-Cola, RC Cola, Blue Sky Cola, Dr. Pepper, and Sprecher Root Beer, and a copy of Coca Kola: The Baddest Chick, by Nisa Santiago.”\textsuperscript{170} Although Amazon does not resemble a casino bar by most measures, the court reasoned that this tray of substitutions would not confuse the bar’s patrons because each substitution bears a clear, individual label.\textsuperscript{171} Consumers on Amazon might be confused about why the site’s search algorithm presented them with certain results, but the Lanham Act protects only against confusion about the origin or affiliation of individual products.\textsuperscript{172}

D. \textbf{FIRST NINTH CIRCUIT DECISION}

Reviewing de novo, the Ninth Circuit reversed the district court’s grant of summary judgment to Amazon and held that the search results could confuse consumers.\textsuperscript{173} Like the district court, it relied on Network Automation and its flexible application of the Sleekcraft factors to ground its analysis.\textsuperscript{174} The court decided that labeling, previously one of the Sleekcraft factors, should be analyzed separately, rather than weighed against the others.\textsuperscript{175} While the labeling of the individual results adequately identified the source of goods to consumers, Amazon’s labeling of the search page overall and repetition of the user’s search term presented a question of fact for the jury.\textsuperscript{176} When combined with Amazon’s failure to notify users that it did not carry the trademarked products that the users initially searched

\begin{itemize}
  \item \textsuperscript{166} Id. at 1138.
  \item \textsuperscript{167} Id.
  \item \textsuperscript{168} Id. at 1142.
  \item \textsuperscript{169} Id. at 1138 n.3.
  \item \textsuperscript{170} Id. at 1138 n.3.
  \item \textsuperscript{171} Id. The court ignored that this violation of customers’ expectations arguably could confuse some customers. The court never considered if that confusion about the retailer and their business model satisfies the Lanham Act’s source confusion.
  \item \textsuperscript{172} Id. at 22 n.10.
  \item \textsuperscript{173} Id., 792 F.3d 1070, 1077 (9th Cir. 2015).
  \item \textsuperscript{174} Id. at 1073.
  \item \textsuperscript{175} Id. at 1075.
  \item \textsuperscript{176} Id. at 1076.
\end{itemize}
for, the court found that a jury could infer initial-interest confusion from that repetition.  

The court continued its likelihood of confusion analysis with the first of the Sleekcraft factors, mark strength. Because the MTM mark could be “suggestive and conceptually strong because it does not obviously refer to watches, or . . . merely descriptive because the watches are made in a military style,” the court found that only a jury could decide the mark’s strength.

The court also found that the second factor, similarity of goods, could favor confusion. Both Amazon and MTM sell high-end watches. Although MTM had presented only evidence that consumers were confused about Amazon’s search algorithm and not the brands of the items that it retrieved, the Ninth Circuit maintained that the Lanham Act protected against all types of consumer confusion. It chided the district court for making assumptions about the sophistication of would-be purchasers on summary judgment. Further, because Amazon claimed to offer the “Earth’s Biggest Selection of Products,” it had a heightened responsibility to differentiate between the goods. Amazon had not informed users that its algorithm would return more than just items with matching keywords, and thus a jury might find that Amazon had confused consumers, not merely informed them of other options.

The third factor, the defendant’s intent, similarly favored confusion. Amazon, according to its briefings, aspires to be the “Earth’s most customer-centric company.” While Amazon had taken affirmative action to clarify the source of its watches to customers, it had done nothing to clarify the source of its search results. It admittedly avoided explaining its search algorithm to consumers and ignored MTM’s requests to explain why

177. Id.
178. Id. at 1077.
179. Id.
180. Id. at 1077–78.
181. Id. at 1077.
182. Id. at 1078.
183. Id.
184. Defendant-Appellee Amazon.com’s Answering Brief at 2, MTM II, 792 F.3d 1070 (9th Cir. 2015) (No. 13-55575).
185. MTM II, 792 F.3d 1070, 1078 (9th Cir. 2015).
186. Id. at 1073.
187. Id. at 1079.
188. Defendant-Appellee Amazon.com’s Answering Brief at 3, MTM II, 792 F.3d 1070 (9th Cir. 2015) (No. 13-55575).
189. MTM II, 792 F.3d at 1079.
its search engine produced competing products in response to searches for the watchmaker’s trademark.\footnote{190}{Id.} From this avoidance, the Ninth Circuit found that a jury could infer intent to confuse consumers.\footnote{191}{Id.}

The court reasoned that a jury could also infer some evidence of the fourth factor, actual confusion, even though MTM presented no colorable evidence of it.\footnote{192}{Id.} Instead, the court looked at Amazon’s search records, which showed that occasionally a customer who searched for MTM’s trademark purchased a competing watch the same day.\footnote{193}{Id. at 1079–80.} A jury might find that “their interest in a Luminox watch was piqued because they were uncertain whether or how Luminox is affiliated with or approved by MTM,” and thus could favor confusion.\footnote{194}{Id. at 1079 n.8.}

For the fifth factor, degree of care, the court again looked to the search and purchase patterns Amazon presented.\footnote{195}{Id. at 1080.} Although MTM’s watches were relatively expensive, priced between several hundred and two thousand dollars, some Amazon customers who searched for MTM or its competitors did buy watches the same day as their search.\footnote{196}{Id.} The court found that a jury could infer that at least some buyers purchased their high-end watches quickly without careful consideration, even though it was not clear from Amazon’s records if those users who purchased on the same day as their search were, in fact, searching for the first time.\footnote{197}{Id.} To analyze this factor, the court also considered Amazon’s sophistication and relative resources. Amazon could have easily provided a caveat to its search results. Thus, for the court, Amazon’s failure to notify customers that it did not carry MTM’s watches had created genuine issues of material fact only a jury could resolve.\footnote{198}{Id.}

The court decided that, on balance, the Sleekcraft factors could cut either for or against likelihood of confusion.\footnote{199}{See id.} The label on Amazon’s search results page as a whole was not necessarily clear.\footnote{200}{See id.} Only a jury could resolve
the issues of fact necessary to determine if the earth’s largest retailer had violated MTM’s mark.201

Rather than earth’s largest retailer, the dissent compared Amazon to a greasy spoon.202 This humble greasy spoon did not serve Coke, but Pepsi, and it told any customer who asked for Coke, “No Coke. Pepsi.”203 This could confuse no one, the dissent countered.204 The Lanham Act aimed not to protect consumers from any and all confusion, but to shield reasonably prudent consumers from confusion “about the source of products.”205 Confusion about the source of the products, the dissent argued, was not at all likely, and the district court’s grant of summary judgment was appropriate.206 Amazon, the dissent continued, had no obligation to inform its shoppers that it did not carry the trademark brand.207 The retailer met its legal obligation with the clear, individual labels on products that it did sell.208 Further, the dissent questioned whether the Sleekcraft factors were even appropriate to the case.209

E. SUPERSEDING NINTH CIRCUIT DECISION

Three months after issuing the initial opinion, the Ninth Circuit granted Amazon’s petition for a rehearing.210 In a rare move, the court withdrew its previous opinion and issued a superseding opinion.211 Now the

201. See id.

202. The dissent actually compared Amazon to a fictional greasy spoon in Chicago, the Olympia Restaurant, from a Saturday Night Live sketch that aired in January 1978. See id. at 1080 (Silverman, J. dissenting). The majority opinion mocked this comparison, observing that Amazon had failed to provide the caveat of “No MTM,” that the sketch included. Id. at 1076 n.6.

203. Id. at 1080.

204. Id. at 1081.

205. Id. at 1083 (citing E. & J. Gallo Winery v. Gallo Cattle Co., 967 F.2d 1280, 1290 (9th Cir. 1992)).

206. Id. at 1082–83.

207. Id.

208. Id. at 1086.

209. Id. at 1084.

210. MTM III, 804 F.3d 930 (9th Cir. 2015).

211. Id. Withdrawing an opinion without the presentation of new facts or arguments is so rare that there are no statistics about exactly how rare it is. Some have observed that “few applications in our procedural system are so often made and so seldom granted as petitions for rehearing.” David W. Louisell & Ronan E. Degnan, Rehearing in American Appellate Courts, 44 CALIF. L. REV. 627 (1956). Some have suggested that the anomaly occurred here because one of the three judges on the panel sat by designation. See Noah Feldman, Judges Will Travel, Overturn Decisions, BLOOMBERGVIEW (Oct. 23, 2015), http://www.bloombergview.com/articles/2015-10-23/judges-will-travel-overturn-decisions [https://perma.cc/AA9Q-MJ8V]. Sitting by designation has long presented concerns about judicial consistency and familiarity with circuit precedent. See Richard B. Saphire &
same three-judge panel held that the retailer’s search results could not have confused a reasonably prudent consumer and affirmed the district court’s grant of summary judgment for Amazon.212 Abandoning the greasy-spoon metaphor, it otherwise reiterated the reasoning of the dissent from its original opinion.213 In its analysis, the court rejected the application of Sleekcraft to Amazon’s search results.214 Sleekcraft was designed to address whether competing marks likely confused consumers, not whether the presentation of those marks on a page of search results was likely to do the same.215 The proper standard was instead “whether a ‘reasonably prudent consumer’ in the marketplace is likely to be confused as to the origin of the goods.”216 The only relevant questions were, first, the identity of the relevant consumer and, second, what that consumer would reasonably believe when he looked at Amazon’s search results screen.217

The court spent about fifty words on the first question, holding that relevant consumers are likely to be careful.218 Unlike the original Ninth Circuit opinion that mused that the prospective consumer was as likely to be MTM’s rugged target audience as their sisters,219 here the court tersely inferred that because the watches were expensive, potential buyers were careful.220

The dissent to the new opinion again took the “Earth’s most customer-centric company” to task for its inability to provide the same level of candor that the Lanham Act demands of Overstock.com, fictional diners in Chicago, or casino bars on the outskirts of South Lake Tahoe.221 The disparity between Amazon and the niche watchmaker seemed to trouble the dissent.222 It noted that the majority showed deference for Amazon’s testimony and clear labels as evidence of its intent not to confuse.

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212. MTM III, 804 F.3d at 932.
213. Id. at 936–38.
214. Id. at 936.
215. Id.
216. Id. at 937 (citing Dreamwerks Prod. Grp. v. SKG Studio, 142 F.3d 1127, 1129 (9th Cir. 1998)).
217. Id.
218. Id.
219. MTM II, 792 F.3d 1070, 1071 (“If her brother mentioned MTM Special Ops watches, a frequent Amazon shopper might try to purchase one for him through Amazon.”).
220. MTM III, 804 F.3d at 937.
221. Id. at 941 (Bea, J., dissenting).
222. Id. at 945–46.
Nevertheless, the majority still expected MTM to proffer evidence of actual confusion.\textsuperscript{223} Given the flexibility and fact-sensitivity of the \textit{Sleekcraft} analysis, the dissent argued, only a jury could decide if Amazon should be accountable for the possible confusion its silence created among consumers.\textsuperscript{224}

### IV. MULTIFACTOR TESTS ENSURE JUDICIAL UNIFORMITY AND EFFICIENCY

Amazon petitioned for a rehearing for two reasons.\textsuperscript{225} First, it argued that the original Ninth Circuit decision failed to ground its likelihood of confusion analysis against the backdrop of a reasonably prudent consumer in the marketplace.\textsuperscript{226} The court dismissed all questions of confusion as entirely factual questions for the jury.\textsuperscript{227} Second, clear labeling, Amazon argued, might obviate any risk of confusion on the Internet.\textsuperscript{228} Because the original Ninth Circuit opinion admitted that the individual products were clearly labeled,\textsuperscript{229} Amazon argued, the likelihood of confusion analysis for the search results page as a whole was superfluous.\textsuperscript{230}

In withdrawing its original opinion, the Ninth Circuit agreed with Amazon’s arguments. On the Internet, the court held, courts must consider only what a consumer sees and believes to assess likelihood of confusion and trademark infringement.\textsuperscript{231} However, by substituting a “reasonably prudent consumer” test for the Ninth Circuit’s full likelihood of confusion test, the court misinterpreted its holding in \textit{Network Automation}, misunderstood the history of multifactor tests, and risked substituting its own opinions and experiences for those of most consumers. Further, substituting the question of whether there are clear labels for the full analysis of the multifactor likelihood of confusion test risks allowing palming off to run rampant on the Internet so long as goods are “clearly labeled” at some point in the transaction.

\textsuperscript{223} Id. at 946.
\textsuperscript{224} Id. at 946.
\textsuperscript{225} Defendant-Appellee Amazon.com’s Petition for Rehearing En Banc at 2, \textit{MTM III}, 804 F.3d 930 (9th Cir. 2015) (No. 13-55575).
\textsuperscript{226} Id. at 6–7.
\textsuperscript{227} Id.
\textsuperscript{228} Id. at 9 (citing \textit{Network Automation, Inc. v. Advanced Sys. Concepts, Inc.}, 638 F.3d 1137, 1147–48 (9th Cir. 2011)).
\textsuperscript{229} Id. (citing slip op. at 13).
\textsuperscript{230} Id.
\textsuperscript{231} \textit{MTM III}, 804 F.3d 930, 937 (9th Cir. 2015).
A. COURTS SHOULD EXAMINE CONSUMER CONFUSION IN CONTEXT

Replacing the multifactor test with the judge’s view of the reasonably prudent consumer limits liability for the kinds of behavior trademark law has always sought to deter. As the dissent to MTM III worried,232 it puts a burden on consumers and smaller competitors to show confusion where large corporations, such as Amazon, need only show “clear labels.” The multifactor Sleekcraft test accounts for that context, the discrepancy in resources, and thus is preferable to the second opinion’s fast and frugal heuristic.

1. The Multifactor Likelihood of Confusion Test Prompts Deliberation

In MTM III, the multifactor test for likelihood of confusion threatens to undermine justice with its many confusing factors where a single reasonable consumer will do.233 The second opinion reflects a certain frustration with the multifactor test for the likelihood of confusion.234 Courts struggle to apply the factors to the Internet, a context the writers of the 1938 Restatement and the Sleekcraft opinion likely never anticipated.235 Fearful of being overturned, courts only apply the same factors as similar precedent, despite factual differences and explicit warnings against applying the test inflexibly.236 Applied too rigidly, the factors become a checklist rather than judicial analysis.237 Further, empirical studies show that judges might not even consider all of the factors that they claim to consider.238 Judges tend to determine whether they think the defendant was liable for infringement based on a single factor and then read the other factors to support that liability.239 Some individual factors, such as the defendant’s

232. Id. at 941 (Bea, J., dissenting).
233. Many commentators have voiced similar concerns about the multifactor likelihood of confusion test. See Bone, supra note 14, at 1347.
235. Id. at 937.
238. See Beebe, supra note 13, at 1614–15.
239. Id.
intent, prove to be particularly persuasive. In a study of the Second Circuit, one of the most active for trademark cases, a defendant’s culpable intent led to a finding of infringement nearly ninety percent of the time.\textsuperscript{240} The multifactor tests then ultimately reproduce intuitive decisions. However, they are arguably worse for hiding their lack of analytic rigor beneath a veneer of rationality.\textsuperscript{241}

Stampeding factors behind a handful of critical ones does not necessarily make decisions less accurate or deliberative.\textsuperscript{242} Rather, it supports a cognitive coherence model of decision-making.\textsuperscript{243} Faced with a complex situation and tight deadlines, judges, like most people, tend to ignore all but the most urgent facts.\textsuperscript{244} Intuitively, these snap decisions must be worse than those made after a long, careful process. However, several studies prove that quick decisions can be just as accurate.\textsuperscript{245} The presence of a multifactor test, such as that for likelihood of confusion, can make these snap decisions even more accurate. They remind judges that they should depart from their gut instincts about the defendant or plaintiff’s relative guilt or innocence to consider a range of factors.\textsuperscript{246} Although the multifactor test might seem to complicate the ultimate question of consumer confusion that the Lanham Act poses, its complexity forces judges to slow down and make more careful, deliberative decisions.

2. The Multifactor Confusion Test Reflects the Aims of Trademark Law

Although the Lanham Act directs courts to consider only likelihood of consumer confusion, historically, courts, like the \textit{Inwood} court, have considered much more, especially for palming off, in which the harm of the

\textsuperscript{240} Id. at 1628–29. \textit{But see} Kevin Blum, Ariel Fox, Christina J. Hayes, & James Xu, \textit{Consistency of Confusion? A Fifteen-Year Revisiting of Barton Beebe’s Empirical Analysis of Multifactor Tests for Trademark Infringement}, 2010 STAN. TECH. L. REV. 3, 32 (finding, in a separate study of Second Circuit opinions over fifteen years, that defendant’s intent had a much less dramatic effect on outcomes).

\textsuperscript{241} See Bone, supra note 15, at 1347.

\textsuperscript{242} See Beebe, supra note 13, at 1614.


\textsuperscript{244} Guthrie, et al., supra note 237, at 10.

\textsuperscript{245} See Beebe, supra note 13, at 1602 n.93.

\textsuperscript{246} See Guthrie, et al., supra note 237, at 41; Chip Heath, Richard P. Larrick & Joshua Klazinga, \textit{Cognitive Repairs: How Organizational Practices Can Compensate for Individual Shortcomings}, 20 REV. ORGANIZATIONAL BEHAV. 1, 15 (1998) (“[I]ndividuals attend to and process information more comprehensively when they have a mental schema that tells them what information is needed in a given situation and where to find it.”).
activity to the markholder is obvious. Because Inwood was removed from the actual confusion, the drug maker’s intent played a much larger role in the court’s analysis of trademark infringement. The Court considered only fleetingly whether the consumer ultimately realized that the goods came from Inwood.247

Amazon’s search engine is similarly removed from the final purchase. This gulf between what an infringer hopes a reasonable consumer thinks and what that consumer actually thinks loomed large in both Ninth Circuit analyses of Amazon’s search results. Amazon seemed to intend to conceal the technology that produced its search results from consumers, yet some or even most consumers knew that its search engine returned products based on more than just keyword matches. Here, considering the defendant’s intent does not necessarily speak to consumer confusion. However, considering intent allows the test to account for a set of incentives that are in line with trademark law’s historical goals, such as deterring freeriding by forcing infringers to pay for the costs. This latitude is particularly important when courts encounter innovative businesses with novel incentives, such as Amazon. Without some latitude, courts tend to stretch the bounds of precedent with strained metaphors.

B. TRADEMARK LAW AS MARKET MORALITY

Under the Lanham Act, trademark infringement turns on the question of whether the defendant’s use of the plaintiff’s mark is likely to confuse a reasonably prudent purchaser.248 However, even twentieth-century proponents of trademark reform aimed for trademark law to do much more than protect consumers from confusion.249 They hoped it could also prevent monopolies and protect small businesses.250 Trademark law should continue to protect market morality.

247. Inwood Labs., Inc. v. Ives Labs., Inc., 456 U.S. 844, 853 (1982) (“[T]he District Court concluded that such incidents occurred too infrequently to justify the inference that the petitioners’ catalogs and use of imitative colors had ‘impliedly invited’ druggists to mislabel.”).
249. See Brandeis, supra note 33, at 10.
250. Id.
1. Trademark Infringement Should Consider Harms Beyond Confusion as It Has Historically

The structure of a multifactor test gives judges both guidance and latitude to determine when harms in addition to confusion result from the unauthorized use of a trademark. More than its structure, however, the content of the multifactor test allows judges to consider elements that, though external to confusion, have deterred unfair competition and thus should be preserved despite the statute’s focus on confusion per se.251 The Lanham Act never meant to abandon the traditional aims of trademark. Infringers should not avoid punishment simply because their attempts to palm off inferior goods were not convincing and thus produced little consumer confusion.252

Trademark infringement should consider a defendant’s state of mind and place blame on the party in the best position to avoid an activity’s harmful effects.253 Courts should not abandon the goal of ensuring fair competition because a defendant sells its goods through a search results page rather than over a counter. As Amazon’s business model demonstrates, retailers can now make money from consumers by doing more than just selling goods.254 They should similarly be held accountable for the harm that might result from those activities. The multifactor likelihood of confusion test, which accounts for product quality and intent alongside consumer confusion, does this better than an abbreviated reasonable consumer test.

Amazon touts itself as the “Everything Store,” and yet its retail business routinely loses money.255 Despite many courts’ vivid metaphors, Amazon has no clear analog in the brick-and-mortar world in which trademark law originated. Most of Amazon’s value resides in its Web Services where its trove of consumer data allows it to design better software to license to other

251. See S. REP. 1333, supra note 35.

252. Id.


254. On the mixed motives of Internet intermediaries, such as Amazon, in trademark infringement, see Ronald C. Goodstein, Gary J. Bamossy, Basil G. Englis, & Howard S. Hogan, Using Trademarks as Keywords: Empirical Evidence of Confusion, 105 TRADEMARK REP. 732, 741–42 (2015); M. Ryan Calo, Digital Market Manipulation, 82 GEO. WASH. L. REV. 995, 1027 (2014).

255. In the third quarter of 2015, Amazon’s North American retail operations finally eeked out an operating margin of 3.5%, an “inflection point” after twenty years of losses. Amazon’s operating margin on its Web Services was 25%. See AMAZON, supra note 103. But see Farhad Manjoo, Long Game at Amazon Produces Juggernaut, N.Y. TIMES, Nov. 19, 2015, at B1 (arguing that the latest quarterly earnings statement is an “inflection point” from which Amazon’s investments in retail infrastructure will grow exponentially).
Rather than simply selling goods of brick-and-mortar retailers, Amazon sells convenience to consumers and information about those consumers to other retailers and advertisers. Amazon is not the pharmaceutical maker failing to label its identical product to allow others to palm it off, nor is it a traditional retail pharmacist actively mislabeling cheaper vials of quinine as the more expensive brand. The drug makers from Warner or Inwood did not stand to benefit from collecting data about the consumers to whom they helped palm off cheaper substitutes.

Amazon, by contrast, has an incentive not to label its search results page clearly, so that it can show the consumer other goods, learn more about what they do eventually buy, and bolster its claims to offer “Earth’s Biggest Selection of Products.” The question is which standard should apply to a retailer who does not make money exclusively from retailing—whether courts should continue to analogize traditional standards to a new context or craft new standards to address new harms. The multifactor tests guide a court’s analysis of these new incentives rather than forcing them to compare the expectations of a reasonable consumer from brick-and-mortar precedent through strained analogy.

2. Amazon Can Best Prevent Harm to Markholders and Thus Should Be Responsible for Those Harms

As Part I, supra, discusses, harm to the merchant’s intellectual property or increased consumer search costs did not preoccupy early trademark cases. Instead, the tort of unfair competition punished the party who could best avoid the economic inefficiencies of unfair competition. Here, that party is Amazon.

Amazon, as it likes to note, is the earth’s largest retailer. For twenty years, it has been on a mission to be “the world’s most consumer-centric company.” As MTM’s expert observed, it nevertheless lags behind competitors Overstock and Buy.com in informing consumers that it does

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256. See AMAZON, supra note 105. On the possibly more nefarious consequences of Amazon’s constant consumer surveillance, see Sachil Singh & David Lyon, Surveilling Consumers: the Social Consequences of Data Processing on Amazon.com, ROUTLEDGE COMPANION TO DIGITAL CONSUMPTION 326 (2013). But see Paul Ford, Does the Data Speak for Itself?, THE NEW REPUBLIC, Mar. 2016, at 4–5 (questioning the utility of Amazon’s data to glean valuable predictions or insights, at least by an essayist).

257. See Part I.A, supra.

258. Defendant’s Motion, supra note 146, at 2.

259. See Sheff, supra note 22, at 772.

260. See Calabresi & Melamed, supra note 239.

261. Defendant’s Motion, supra note 146, at 2.

262. Id.
not carry certain trademarked goods. Their search engines readily reveal that they do not carry the trademarked product.

Despite A9’s accomplishments in other areas, Amazon has claimed that including a similar disclaimer in its search results would be technically difficult. Many details of Amazon’s search technology were redacted from their employees’ depositions, so assessing this claim is difficult. In a similar, recent case in the United Kingdom over the use of the mark “Lush” to sell cosmetics, however, Amazon made the same claim about the impossibility of excluding trademarked terms from its behavioral-based search. There, the court was “satisfied that Amazon has the expertise to do what is required if it wished, and that any shortcoming is because of its perception that the profitability of its site is the predominant criterion which should drive its efforts.” After the verdict, Amazon apparently overcame these technical difficulties. A recent search for “lush” on amazon.co.uk returns a list of items prefaced with the disclaimer, “Amazon doesn’t sell Lush cosmetics.”

Nothing seems to prevent earth’s largest retailer from including a similar warning on its North American site. As the British court noted, Amazon’s reasons for not including a disclaimer that it does not carry a trademarked product are more about profitability than technical limitations. The more consumers use Amazon, the more data Amazon has to sell. Admitting that it does not sell the brand of good for which a user has searched could drive users and their valuable data away from the site. Not only would Amazon be less likely to sell them something, but fewer users on the site would deprive Amazon’s search engine and the algorithms that drive it of their data. Consequently, they would become less predictive and thus less valuable. The multifactor test allows courts to consider these incentives and balance them against the low costs of truly clear labeling to large, sophisticated defendants, such as Amazon.

263. Plaintiff’s Memorandum, supra note 142, at 23 (citing the expert report of William A. Markson, Complaint, Exhibit 1, ¶ 2).
264. Id.
265. See Section II.C, supra.
266 MTM I, 926 F. Supp. 2d at 1130 n.1.
267. In Cosmetics Warriors Ltd. v. Amazon.co.uk, [2014] EWHC 181 (Ch), and its subsequent injunction at EWHC 1316 (Ch), ¶ 13–14, Amazon argued that it could not prevent its “breadcrumbs” from reproducing the term that the customer had entered.
268. Id.
Even if the costs of providing a disclaimer for searches of each and every registered mark are too high, Amazon already has measures in place to ward against consumer confusion for some trademark holders. As part of a settlement with another trademark holder with a similar complaint, Amazon supplied the trademark holder with an internal contact and a phone number for outside counsel. Amazon could provide a similar take down notice process for other small rights holders, such as MTM.

3. **Trademark Law Should Protect Competition**

The costs of providing a disclaimer and avoiding confusion seem relatively low for Amazon. The *MTM III* opinion, however, maintains that there is no risk of confusion “at all.” Thus, if trademark law only protects against confusion as the language of the Lanham Act might suggest, Amazon should not have to incur costs to guard against something of which there is no risk. Far from confusing and harming consumers, Amazon’s search arguably benefits them. Keeping them on Amazon.com and collecting their data improves its search algorithms and Web Services. As its earnings reports show, these subsidize the costs of its retail infrastructure to consumers. However, the Lanham Act strives not just to prevent consumer confusion, but also to codify the tort of unfair competition and “preserve[] the things which have demonstrated their usefulness.”

Early advocates for trade morals recognized the dangers posed even by price cutting. Like the court in *Warner*, which held the drug maker

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272. *Id.*
273. In its complaint, MTM found wanting Amazon’s terse responses to its inquiries about why competing watches were returned for searches for its trademark. *See* Complaint, *supra* note 133, ¶¶ 30–33.
274. “[C]onfusion on the part of the buyer is not at all likely.” *MTM III*, 804 F.3d 930, 936 (9th Cir. 2015).
276. *See supra* note 101.
278. Writing on the dangers of price cutting, Justice Brandeis compared consumers who cared only about prices to short-sighted Esau: “Thoughtless or weak, he yields to the temptation of trifling immediate gain, and, selling his birthright for a mess of pottage, becomes himself an instrument of monopoly.” *Brandeis*, *supra* note 32, at 12. More recently, some economics scholars have warned about the danger of platform business, such as Amazon, to smaller third-party business. *See* Feng Zhu & Qihong Liu, *Competing with
accountable for creating “the unfair and fraudulent advantage which is taken of such use to pass off the product as that of respondent,” 279 the Ninth Circuit was correct in *MTM II*. There, it used the *Sleekcraft* factors to hold Amazon accountable for all negative externalities, not just those that resulted in higher costs for the consumer. Although MTM could not point to actual confusion, it could point to the “visual similarity” of Luminox’s watches to its own. 280 Further, the watchmaker’s sales dipped slightly from a peak of $4.4 million in 2007 to $3.9 million in 2009. 281 MTM could not connect this dip to Amazon because the watchmaker lacked access to data about searches on the site. 282 Even in the vague statistics Amazon was willing to disclose, a few customers had bought a competing watch after searching for MTM’s mark. 283 Expecting a small plaintiff like MTM to provide something more, to provide evidence of actual consumer harm as though Amazon were a small jeweler selling knock-off watches, puts smaller plaintiffs at a distinct disadvantage against large, online vendors. 284 Like the trade moral law it has always been, trademark law should continue to protect the market against harm from all unfair competition, not just harms that result from consumers’ confusion and increased search costs.

V. CONCLUSION

For decades now, courts have struggled to adapt brick-and-mortar doctrines to confusion on the Internet. They have sought an analog to online retailers in highway rest areas, 285 in the billboards of Times Square, 286

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281. Id. at 178:15–180:2.
283. *MTM II*, 792 F.3d 1070, 1079 (9th Cir. 2015).
and in the department stores of suburban malls. Amazon, however, is not there. It never wanted to be there. Amazon makes money in a different way than those offline retailers. Using metaphors to compare Amazon’s advertising or retail segments to its offline counterparts misses the forest for the trees. It misses Amazon’s incentives and their wider effects on competition.

Courts in Warner and Ives did not need to compare the drug makers to apothecaries to see the effects of the drug makers’ deceptive labels. Thus, to avoid consumer confusion and enforce market morality, courts should consider the incentives and effects of activity as they actually are. The multifactor test for likelihood of confusion prompts courts to consider fully these wider consequences of an alleged infringer’s behavior. Using an abbreviated “reasonably prudent consumer” or “clear label” test will not.

287. Network Automation, 638 F.3d 1137, 1148 (citing Playboy Enterprises, Inc. v. Netscape Comm’ns Corp., 354 F.3d 1020, 1034–35 (9th Cir. 2004)).

288. If anywhere, Amazon can be found in a loophole. Bezos explained in 1996, “I’m not interested in retrofitting the physical bookstore experience in the virtual world.” See Tyler, supra note 102. This contrasts markedly with the language used in Amazon’s motion for summary judgment at the district court, in which the retailer claimed it “opened its virtual doors . . . in 1995.” See Defendant’s Motion for Summary Judgment, supra note 146, at 2.

289. See supra note 255 (comparing the operating margins on its retail and Web Services segments).

Figure 1: The Results of a Search for “mtm special ops” on Amazon.com