

The Fame of a Trademark May Be an Obstacle in a Case of Reverse Confusion

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In 1971, Charles Roger Hargreaves developed a series of children's books which featured the "Mr. Men" and "Little Miss" characters. These characters eventually were used in television programs, variety shows, comedy sketches, music videos and other entertainment venues. The characters in the book series used names relevant to the stories, for instance, "Little Miss Chatterbox" was shown talking on the telephone. In 2007, the Walt Disney Co. began to license a series of "Miss Disney" t-shirts featuring its own characters. An example of Disney's use was a t-shirt with the words "Miss Chatterbox" along with a photo of Minnie Mouse talking on the telephone. The current owner of the rights in the "Little Miss" characters, Thoip, brought a trademark infringement action against Disney in the Southern District Court of New York. *Thoip (a Chorion Ltd. Company) v. Walt Disney Co.*, Case No. 1:2008cv06823, S.D.N.Y. 8/13/10. Disney moved for summary judgment. The court granted the motion in part and denied it in part.

In analyzing the Thoip claim, the court used the eight-factor test for likelihood of confusion developed in *Polaroid Corp. v. Polarad Electronics Corp.* 287 F.2d 492 (2d Cir. 1961), and examined the first factor regarding strength of the Thoip mark. The court determined that the strength, or fame, of the mark can result in differing results depending on the type of confusion being asserted. Thoip had asserted both forward and reverse confusion. In regard to forward confusion, Thoip asserted that consumers will believe that the Disney shirts are approved by Thoip. In regard to reverse confusion, Thoip asserted that consumers will believe that Disney was the senior user and Thoip was the junior user.

After weighing the remaining factors, the court disagreed with Thoip on its forward confusion argument finding that the fame and distinctiveness of Disney's characters would prevent consumer confusion. The court determined that there was no prima facie showing of infringement on Thoip's forward confusion theory and agreed with Disney's expert that no consumer seeing a Disney shirt would think it came from Thoip.

In regard to reverse confusion, the court found that the fame of the Disney characters works against Disney. The Disney characters increase the likelihood that consumers will believe that Disney is the source of the Little Miss Thoip shirts or, put another way, that Disney is the senior user. "The undisputed strength of Disney's characters and the Disney name, however, works against Disney on Thoip's reverse confusion theory. . . [T]he fame of Disney's characters and its name increases the likelihood that consumers will mistakenly believe that Disney is the source of or approved the Little Miss Thoip shirts." *Id.* at 42. The court noted that Thoip failed to provide evidence of actual reverse confusion and offered an opportunity for the record to be further developed through discovery.

The court granted Disney's motion for summary judgment on the forward confusion claim, but denied the motion on the reverse confusion claim.

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