Introduction

Brown-Forman will likely prevail on an infringement claim under Lanham Act §32(1) and should claim, in the alternative, dilution under Lanham Act §43(c).

Likelihood of Confusion

The following analysis will proceed through the *Polaroid/Sleekcraft* factors to determine the likelihood of confusion between Brown-Forman's SOUTHERN COMFORT and Northern Comfort's NORTHERN COMFORT marks.

As a preliminary matter, Northern Comfort ("Northern") may argue that a comparison between NORTHERN COMFORT and the *classic* SOUTHERN COMFORT label is inappropriate as Brown-Forman discontinued the use of the classic label on bottles in May 2007, so the classic trade dress registration has been abandoned. Brown-Forman will want to argue that the March 2008 date of advertisement of the classic label is the governing date, as such use was bona fide use of the mark in the ordinary course of trade, so the three-year period necessary under Lanham Act §45 to trigger a prima facie case of abandonment has not been met. Brown-Forman will also want to argue that it never abandoned use because of its licensing efforts with third parties who sold goods with the classic label. Because such use was commercial and a legitimate use of the trade dress in the "trademark sense" (unlike the licensing of a mark for purposes of documentary making in *Silverman*), a court would likely find that the classic trade dress had not been abandoned.

Strength of Plaintiff's Mark

SOUTHERN COMFORT is theoretically strong because it is a suggestive mark requiring imagination to reach a conclusion as to the nature of the goods (*Quik-Print*). Even if Northern tried to argue that the mark is descriptive, SOUTHERN COMFORT has become incontestable under §15 and can no longer be challenged on such grounds (*Thrifty*). SOUTHERN COMFORT also has great market strength as it is "one of

America's best known liquors," around since 1874, and marketed in 60 countries, as well as widely licensed and advertised in magazines. In fact, a court would likely find SOUTHERN COMFORT to be famous under 43(c)(2), thus affording it a broader scope of trademark protection (*Nutrasweet; Mobil*). This factor favors Brown-Forman.

Similarity of the marks

Both marks are composite marks. Northern will argue that the dominant portion of Brown-Forman's mark is "Southern" because of the way SOUTHERN COMFORT is marketed as originating in the South, but a court would probably find that "Southern" is merely a description of the dominant COMFORT, which strengthens Brown-Forman's claim because Northern also uses the word COMFORT.

The marks are quite similar in sight with each mark consisting of two words, the second word being "Comfort" in both cases, and the first word containing the same number of letters, with only three letters different. The marks are also similar in sound; they share the same second word, and the first word of each mark contains two syllables. Finally, the two mark hold similar meanings, as "Northern" and "Southern" are merely modifications of the word Comfort, and are both indications of cardinal direction and cultural regions. In fact, "Northern" is more similar to "Southern" than "Western would be since it complements "Southern" as its opposite, both directionally and culturally.

Upon examination of the trade dresses of the two marks, the marks appear to converge even more. Both versions of Northern's trade dress mimic Brown-Forman's classic trade dress and also share similarity with Brown-Forman's revised label. Both labels portray the words NORTHERN (or SOUTHERN) COMFORT in stylized capital letters, above a horizontal oval depicting a scene (a cabin on Northern's bottle, a plantation home on Brown-Forman's classic label, and what appears to be a scene of New Orleans on Brown-Forman's revised label). Brown-Forman's bottles print beneath the oval in script the phrase "The Grand Old Drink of the South; Originated on the Banks of the Mississippi, in New Orleans, Louisiana" while Northern's bottles, in the same location with the same script, read "The Legendary Liquid of the North; Originated in the Grand Sugar Maples of Upstate New York, U.S.A." and "Packed on the banks of the

Moose River in St. Johnsbury, Vermont, 13819, U.S.A. by Maple Grove Farms of Vermont" (with the words "Pride of the Northeast Kingdom" above the oval). The similar marks, combined with the similar labeling on a glass containing similar colored liquid make the marks exceptionally similar.

Proximity of the Products

At first blush, whiskey and syrup are not similar goods (despite the honey rumored to be found in Southern Comfort's recipe). However, because SOUTHERN COMFORT appears on licensed products such as sweet tea, ice cream, and candy, which evoke quaint country stores, maple syrup could be found similar, as it also evokes sugary nostalgia.

SOUTHERN COMFORT, the whiskey, is likely not sold in the same channels of commerce as NORTHERN COMFORT, as the whiskey is marketed to a mass audience and sold mostly in liquor stores, while NORTHERN COMFORT syrup was found in Chelsea Market, where high-end, unique specialty goods, often from local regions, are sold. However, the other SOUTHERN COMFORT goods could easily be found in the same type of country store as Northern's syrup, especially if Northern sold its goods in locations outside of Manhattan.

While there is some proximity of the products, this factor cuts in favor of Northern.

Likelihood that Plaintiff will bridge the gap

While a product such as maple syrup could easily complement the other products sold with the SOUTHERN COMFORT license, there is no evidence that Brown-Forman is interested in bridging the gap to sell syrup products.

Evidence of Actual confusion

This factor favors Northern, as there is no evidence of actual confusion.

Northern's Intent

This factor is particularly damning to Northern because of the text, script, and oval used in on its labels, which show that Northern was clearly intending to riff off of Southern Comfort's trade dress. Northern's use of the flask container further implies that Northern was not innocent to Southern Comfort's mark and intended to evoke it. Courts will infer bad faith when one adopts a particular name with knowledge of a mark (*Gallo Nero*). Such bad faith could lead to a rebuttable presumption of confusion, if Brown-Forman sues in the Second Circuit, or something similar if Brown-Forman sues elsewhere. This factor cuts heavily in favor of Brown-Forman.

Quality of Northern's products

This factor is not useful to the analysis.

Degree of Care likely to be exercised by Purchaser

Purchasers of maple syrup, candy, or ice cream are not likely to exercise a great deal of care in making a purchase, because of the impulse-buy nature of those items. Consumers of whiskey may exercise a bit more care, but similar to wine, can be classified in two tiers of sophistication. Because Southern Comfort is not a high-end whiskey brand, purchasers of it are not likely to exercise a great deal of care. Therefore, this factor cuts in favor of Brown-Forman.

Almost every factor builds a case for a likelihood of confusion. Though the proximity of the products are different, Brown-Forman can claim that because of the initial interest confusion caused when a purchaser picks up a bottle of NORTHERN COMFORT, thinking it is sponsored by the source of Southern Comfort. While Northern and Brown-Forman do not compete directly for the maple syrup market, such initial interest confusion may tax consumers who are disappointed to discover that they have wasted their time and are not purchasing a product from their beloved Southern Comfort line (*Playboy*). Additionally, because maple syrup is a "country store" type staple, some of Southern Comfort's licensed products may suffer a loss of business.

Parody Defense

The most damning evidence from the above analysis is Northern's intent to copy Southern Comfort's trade dress. It would be very difficult for Northern to convince a court that it did not intend to copy the label, so Northern's best defense will be to argue that the trade dress was copied as a form of parody, and so is protected as a form of nominative fair use (*Mattel v. Universal Music*). However, Northern's does not really use Southern Comfort's trade dress to refer to SOUTHERN COMFORT and lampoon it. In fact, Northern does not even use the exact mark or trade dress, so its use is more analogous to the use in *Mutual of Omaha* or *Anheuser Busch.* Because Northern does not adequately indicate that its label is a parody (*Anheuser Busch*) and because there are "adequate alternative avenues of communication" (*Mutual of Omaha; USOC*), a court will be unlikely to extend First Amendment protection to such use.

Dilution

Brown-Forman should also bring a claim for dilution by blurring. By applying the *Chewy Vuitton* factors for blurring, a court would likely find a high degree of similarity between the marks, a high degree of distinctiveness in the famous mark, extensive exclusive use of SOUTHERN COMFORT, a high degree of recognition of SOUTHERN COMFORT, that Northern intended to create and association with SOUTHERN COMFORT, though probably no actual association between the two marks. Even if the two products are dissimilar enough to defeat a likelihood of confusion claim (which is not likely), Brown-Forman could argue that Northern is "whittling away" at SOUTHERN COMFORT's commercial magnetism (*Deere*).

The dilution doctrine does not apply to noncommercial speech (*Mattel*), so Northern may argue that it imitates Southern Comfort's label for comedic value, and purchasers buy its maple syrup because of the humorous association with Southern Comfort, so its use is not "pure commercial speech." However, while perhaps humorous, Northern's label may be considered a form of advertising, since the value of the product is the syrup itself, and the label merely induces customers to purchase it.

Northern may also argue that its use should be protected as a parody. If found to be a parody, a court would probably not find Northern to be direct competitor attacking

SOUTHERN COMFORT, the *Deere* exception would not apply, and the court might find that as a parody, Northern is not taking anything away from SOUTHERN COMFORT because it is referring to it (*Chewy Vuitton*). Because Northern is associating not SOUTHERN COMFORT with anything unsavory, a court would probably not find Northern's use to tarnish SOUTHERN COMFORT (*Hormel*).

Conclusion

Brown-Forman will likely prevail on its infringement claim based on the similarity of the marks and Northern's intent to copy. However, if a court found the products to be sufficiently different to lead to confusion, Brown-Forman would likely prevail on a blurring claim, as a court would probably find that Northern's use was not a parody deserving protection.

This Essay is 1747 words.