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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

PINTEREST, INC.,
Plaintiff and Counter-Defendant,
v.
PINTRIPS, INC.,
Defendant and Counter-Plaintiff.

Case No. 13-cv-04608-HSG

**FINDINGS OF FACT AND
CONCLUSIONS OF LAW**

I. INTRODUCTION

In this case, Plaintiff and Counter-Defendant Pinterest, Inc. (“Pinterest”) alleges that its rights to its “Pinterest,” “Pin,” and “Pin It” word marks are infringed by the “Pintrips” and “Pin” word marks used by Defendant and Counter-Plaintiff Pintrips, Inc. (“Pintrips”). Pinterest asserts five causes of action: (1) federal trademark infringement under the Lanham Act, 15 U.S.C. § 1114; (2) false designation of origin under 15 U.S.C. § 1125(a); (3) trademark dilution under 15 U.S.C. § 1125(c); (4) unfair competition under Cal. Bus. & Prof. Code § 17200; and (5) trademark dilution under Cal. Bus. & Prof. Code § 14247. Pinterest asks the Court to permanently enjoin Pintrips from using the Pintrips and pin marks. For its part, Pintrips seeks a declaration from the Court that its use of the Pintrips and pin marks does not infringe, as well as an order cancelling Pinterest’s pin registrations (at least in part) if those registrations are construed to prohibit the manner in which Pintrips uses the term.

This matter was tried to the Court, sitting without a jury, from May 18, 2015 to May 27, 2015. On July 3, 2015, the parties submitted post-trial briefs, *see* Dkt. Nos. 251 (“Pl. Br.”) and 248 (“Def. Br.”), and Proposed Findings of Fact and Conclusions of Law, *see* Dkt. Nos. 250 (“Pl. FFCL”) and 249 (“Def. FFCL”). The parties filed reply briefs three weeks later. *See* Dkt. Nos.

251 (“Pl. Reply Br.”) and 252 (“Def. Reply Br.”). Closing arguments were heard August 28,

United States District Court
Northern District of California

1 2015. The Court has carefully considered the evidence presented at trial, the exhibits admitted
2 into evidence, the parties' briefs, and the arguments of counsel. This memorandum opinion will
3 constitute the Court's Findings of Fact and Conclusions of Law.

4 **II. JURISDICTION**

5 The Court has original jurisdiction under 15 U.S.C. § 1121 (claims arising under the
6 Lanham Act), as well as 28 U.S.C. §§ 1331, 1338, and 1367(a). Venue is proper in this district
7 pursuant to 28 U.S.C. § 1391(b) because the parties reside in this judicial district and a substantial
8 portion of the events giving rise to this action occurred here.

9 **III. BACKGROUND**

10 **A. Pinterest**

11 Launched in March of 2010, the Pinterest website permits its users to view, post, and
12 organize content in which they are interested by creating pins on their virtual Pinterest "Pinboard."
13 Pins are pieces of digital content that are shaped like a vertical rectangular box, and contain a
14 photo, caption, and various action buttons. To create a pin, users can either go to a different
15 website and transfer content by clicking on a "Pin It" action button, or browse content others have
16 already pinned on Pinterest and "re-pin" that content to their Pinboard. Some pins, called "rich
17 pins," are associated with a particular product offered by one of Pinterest's partners. For example,
18 a rich pin of a pair of sandals from a shoe retailer's website will automatically show the current
19 price of the sandal and whether it is in stock.

20 Pinterest permits its users to create multiple Pinboards with different subject matters.
21 Some of the most popular areas about which Pinterest users create pins on Pinterest are recipes,
22 fashion, home décor, and travel. Regardless of its subject matter, each Pinboard a Pinterest user
23 creates is viewable by all other Pinterest users by default. Pinterest users have the option to
24 change the default by creating "secret" boards that only they and their specifically invited friends
25 can see. In November of 2013, Pinterest launched a particular type of Pinboard called a "Place
26 Board," which allows Pinterest users to add location information to certain pins. Many Pinterest
27 users use these Place Boards as part of their vacation and travel-related research on Pinterest.

28 Pinterest owns two federal trademark registrations for the word mark "PINTEREST" and

1 Trial Exhibit (“TX”) 23; TX24, and two federal trademark registrations for the word mark “PIN,”
2 *see* TX25; TX26. It does not have a federal trademark registration for the word mark “PIN IT.”
3 Pinterest has used each of the Pinterest, Pin, and Pin It word marks since March of 2010.

4 **B. Pintrips**

5 Pintrips is a website-based travel planning service that enables users to monitor the price
6 fluctuations of airline flights. Co-founder and CEO Stephen Gotlieb came up with the concept of
7 Pintrips (initially called Flightrax) in 2010 and created a mockup for the service as part of a class
8 project for his MBA program in January of 2011. In order to use the Pintrips service, users must
9 create an account on the Pintrips website and download a Google Chrome browser extension.
10 Once installed, the Chrome browser extension inserts Pintrips’ pin button next to airline itineraries
11 when the user visits certain third-party travel websites. When a Pintrips user clicks on the pin
12 button next to an itinerary, that itinerary is automatically “pinned” to that user’s “Tripboard” on
13 the Pintrips website. Once pinned, the price displayed next to the itinerary on the user’s Tripboard
14 will update to reflect the flight’s real-time pricing and availability. Pintrips users may return to the
15 Tripboard at any time to see if their pinned flights have changed in price and to compare their
16 pinned travel options side-by-side. When a Pintrips user decides to purchase a flight, he or she
17 may click on the pinned itinerary, which redirects the user to the website from which the flight
18 was originally pinned.

19 Pintrips’ default configuration permits only individual users to access and view the trip
20 information stored on each Pintrips user’s Tripboard. Access to this information may be shared
21 with other Pintrips users only when the Pintrips user grants authorization to an individual email
22 address to view his or her Tripboard. Email addresses may only be invited one at a time; Pintrips
23 does not allow users to share their Tripboards with all other Pintrips users or any subset of Pintrips
24 users. Users can communicate with each other through a Pintrips chat feature once they are
25 invited to collaborate on the same Tripboard.

26 Pintrips does not own any federal trademark registrations. Its current application for
27 registration of the “PINTRIPS” mark has been administratively stayed pending the outcome of this
28

1 **IV. DISCUSSION**

2 The Court was presented with three primary questions at trial: (1) does Pintrips' use of the
3 "Pintrips" mark infringe Pinterest's rights to its registered "Pinterest" mark; (2) does Pintrips' use
4 of the term "Pin" infringe Pinterest's rights to its registered "Pin" and/or unregistered "Pin It"
5 marks; and (3) was Pinterest sufficiently famous at the time Pintrips first used its marks in
6 commerce to support a trademark dilution claim. The Court resolves each question below.

7 **A. "Pinterest" vs. "Pintrips"**

8 The Lanham Act prohibits the "use[] in commerce [of] any word, term, name, symbol, or
9 device, or any combination thereof, or any false designation of origin" that "is likely to cause
10 confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of
11 such person with another person, or as to the origin, sponsorship, or approval of his or her goods."
12 15 U.S.C. § 1125(a)(1)(A). To establish trademark infringement under the Lanham Act, a plaintiff
13 must demonstrate that (1) it has a valid, protectable ownership interest in a mark, (2) its mark is
14 the senior mark, and (3) the defendant's mark is likely to cause consumer confusion in the
15 marketplace. *Rearden LLC v. Rearden Commerce, Inc.*, 683 F.3d 1190, 1202-03 (9th Cir. 2012);
16 *see also Brookfield Commc'ns, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1046-47 (9th Cir.
17 1999).

18 In this case, Pinterest asserts that Pintrips' name infringes its registered Pinterest word
19 mark. There is no dispute that Pinterest has a valid, protectable ownership interest in the Pinterest
20 mark, and that the Pinterest mark is senior to the Pintrips mark. Pinterest's trademark registration
21 is prima facie evidence of the validity of its marks. 15 U.S.C. § 1057(b). Accordingly, the
22 resolution of this infringement claim turns on whether the Pintrips mark is likely to cause
23 consumer confusion in the marketplace. Specifically, the question is whether consumers are likely
24 to mistakenly believe that Pintrips is "somehow affiliated with or sponsored by" Pinterest. *Cohn*
25 *v. Petsmart, Inc.*, 281 F.3d 837, 841 (9th Cir. 2002); *see also Dreamwerks Prod. Grp., Inc. v. SKG*
26 *Studio*, 142 F.3d 1127, 1130 (9th Cir. 1998) ("[T]he question here is whether a reasonable
27 consumer attending a [convention sponsored by the plaintiff] might do so believing that it is a
28 convention sponsored by [the defendant].")

1 To answer this question, the Court applies the eight-factor test articulated by the Ninth
2 Circuit in *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979). The “*Sleekcraft*
3 factors” include: (1) the strength of the allegedly infringed mark; (2) the proximity of the parties’
4 goods; (3) the similarity of the parties’ marks; (4) the extent to which there is evidence of actual
5 confusion; (5) the marketing channels used by the parties; (6) the degree of care likely to be
6 exercised by the purchasers of the parties’ products; (7) the alleged infringer’s intent in selecting
7 its marks; and (8) the likelihood of expansion of the parties’ product lines. *Id.*

8 The courts’ application of the eight *Sleekcraft* factors in determining the likelihood of
9 confusion is supposed to be “pliant,” and the Ninth Circuit has warned against “excessive rigidity”
10 in their application. *Jada Toys, Inc. v. Mattel, Inc.*, 518 F.3d 628, 632 (9th Cir. 2008). Instead,
11 “[t]he test is a fluid one and the plaintiff need not satisfy every factor, provided that strong
12 showings are made with respect to some of them.” *Survivor Media, Inc. v. Survivor Prods.*, 406
13 F.3d 625, 631 (9th Cir. 2005); *see also Dreamwerks*, 142 F.3d at 1129-32 (allowing case to
14 proceed past summary judgment where the plaintiff overwhelmingly satisfied three *Sleekcraft*
15 factors). Courts have extensive discretion in determining how much weight to accord each factor
16 based on the circumstances of the case. *See Interstellar Starship Servs., Ltd. v. Epix, Inc.*, 304
17 F.3d 936, 941 (9th Cir. 2002).

18 As will be discussed in more detail below, after considering each *Sleekcraft* factor and
19 balancing them as a whole, the Court finds that the factors considered in their totality weigh
20 against a finding that consumer confusion is likely.

21 **1. The “Pinterest” Mark is Suggestive**

22 The purpose of examining the strength of the plaintiff’s mark is to determine the scope of
23 trademark protection to which the mark is entitled. *Entrepreneur Media, Inc. v. Smith*, 279 F.3d
24 1135, 1141 (9th Cir. 2002). The strength of the senior mark determines the scope of trademark
25 protection which applies. *Survivor Media*, 406 F.3d at 631 n.3. The strength of the junior mark,
26 while important in cases of reverse infringement, is not relevant to the Court’s analysis outside of
27 that context. *See La Quinta Worldwide LLC v. Q.R.T.M., S.A. de C.V.*, 762 F.3d 867, 875 (9th Cir.

28 2014) (“This is not a reverse infringement case, and the district court should not have considered

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