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Trademark Infringement: Did I Infringe When I Sold An Ebook With A Similar Title To A Published Book?

[Kristie Prinz](#)

Q. I sold a bundle of ebooks (approximately 2,000) on an online auction website. One of the files included was a 'similar' name to a published book. It was the same title, but one of the words was spelled differently. It was not their published book, but it was about bookkeeping. Mine (the one I purchased from someone else) was about mail order bookkeeping. Their book is about bookkeeping more generally. I purchased this bundle of ebooks from someone else on the online auction website with supposedly full resell rights. The company who owns the intellectual property rights in the published book is now saying I violated their intellectual property rights. Did I in fact do something wrong? Please help me to understand this.

-- *Anonymous*

A.

Based on the facts that you have provided, it is possible that you could be held by a court of law to have committed trademark infringement when you sold the ebook with the similar title online.

Why is the similar title potentially a problem? Well, the similarity in the two titles could be held by court to create a "likelihood of confusion" between the ebook and the published book of the similar title. Courts typically look at seven factors to make this determination, which are as follows:

1. the strength of the mark;
2. the similarity of the marks;
3. the relatedness of the goods;
4. the evidence of actual confusion;
5. the sophistication of the buyers;
6. the defendant's intent is selecting the mark; and
7. the likelihood of expansion of the product lines.

Your actions in selling the ebooks online clearly could rise to the level of trademark infringement. Section 15 USC 1114 of the Lanham Trademark Act states:

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"Any person who shall, without the consent of the registrant--

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive, shall be liable in a civil action by the registrant for the remedies hereinafter provided.

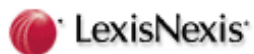
Under subsection (b) hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive."

In the case at hand, assuming that this book's mark is covered under the Lanham Act, a court could say that you were using in commerce a reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale of goods that on or in connection with which such use is likely to cause confusion or mistake, or to deceive. As a result, the potential exists that you could be determined to be an infringer.

My advice is to consult with an [attorney](#) in your jurisdiction specializing in trademark prosecution at your earliest convenience, where you can discuss with such attorney the specific facts of your situation and decide how best to proceed. It is quite possible that your best course of action is going to be to settle with the company owning the publication rights; however, your attorney should be in a position to advise you definitively on this issue.

-- *Kristie Prinz*

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