

## **Pinterest fails to pin Pintrips on trademark infringement and dilution claims United States - Knobbe Martens Olson & Bear LLP**

**Confusion  
Dilution**

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In *Pinterest Inc v Pintrips Inc* (No 13-CV-04608-HSG, October 21 2015), the US District Court for the Northern District of California has held that the PINTRIPS and PIN marks used by Pintrips did not infringe or dilute Pinterest's PIN and PINTEREST registered trademarks.

Pinterest is a social media company that permits its users to view, post and organise content by creating pins on their virtual Pinterest pinboard. Popular pinboard categories include recipes, fashion, home décor and travel.

Pintrips is a website-based travel planning service that allows users to monitor the price fluctuations of airline flights by pinning trip itineraries to their tripboard on Pintrips' site.

After analysing the eight-factor test articulated by the Ninth Circuit in *AMF Inc v Sleekcraft Boats* (599 F2d 341, 348-49 (1979)), the court held that Pintrips' use of PINTRIPS does not infringe Pinterest's rights to its registered PINTEREST mark. Although the court found that many of the *Sleekcraft* factors were neutral, the two factors favouring Pintrips (the proximity of the parties' services and the likelihood of expansion) supported Pintrips to a significantly greater degree than the two factors favouring Pinterest (the strength of the PINTEREST mark and the similarity of the PINTEREST and PINTRIPS marks).

The court found that the differences between the parties' goods and services strongly weighed against confusion, reasoning that while both parties allow their users to research travel destinations, Pinterest is aimed at social networking and does not have the travel booking functions provided by Pintrips. Further, the court found that Pinterest did not establish that either party is likely to expand its services to directly compete with the other.

The court also held that Pintrips did not infringe Pinterest's registered PIN mark because Pintrips' use of the term 'pin' constitutes fair use. To prevail on a fair use defence, the alleged infringer must prove that the words at issue are being used "other than as a mark,... of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party" (15 USC § 1115(b)(4)). The court found that Pintrips used the term 'pin' other than as a mark and only to describe its goods or services, because the term 'pin' was being used in the same way that many other companies use it - as a verb for attaching one virtual object to another. Further, the court concluded that Pintrips exercised good faith because Pintrips decided to use the term 'pin' to describe the well-known computer operation of pinning before it had even heard of the website Pinterest.

To prevail on its dilution claims, Pinterest had to show that:

1. its mark is famous and distinctive;
2. the defendant is making use of the mark in commerce;
3. the defendant's use began after the mark became famous; and
4. the defendant's use of the mark is likely to cause dilution.

The court held that Pinterest could not support a trademark dilution claim because virtually all of the news articles offered by Pinterest to show fame were published after Pintrips first used its mark in commerce.

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