

## 1 ☐ **Trademark: Unit 3**

### 2 ☐ **Review**

- Three theories of TM basis/purpose
- Strange case of TM that have value independent of source

### 3 ☐ **Review of Last Notes**

- Generic - can't TM
- Useful - can't TM
- CAN TM surnames, slogans
- Secondary meaning as source of TM rights
- Trade dress (packaging)
  - ▮ Can TM
    - ▮ color,
    - ▮ sounds
    - ▮ other things?

### 4 ☐ **More on Trade Dress (*Qualitex*)**

- Nothing in "functionality doctrine" prevents color from being a mark. [98-99]
  - The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, 35 U.S.C. §§ 154, 173, after which competitors are free to use the innovation. If a product's functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity). See *Kellogg Co. v. National Biscuit Co.*, ...

### 5 ☐ **Trade Dress (*Qualitex*, continued)**

- ▮ This Court consequently has explained that, "in general terms, a product feature is functional," and cannot serve as a trademark, "if it is essential to the use or purpose of the article or if it affects the cost or quality of the article," that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage. [99] So color can be TM so long as it has no non-trademark function.
- ▮ Note case on p. 101 where pill color WAS **functional** since it identified a type of medicine (*Inwood Labs* (US 1982)).

### 6 ☐ **Trade Dress (Restatement (3rd))**

- Restatement (Third) of Unfair Competition adds that, if a design's "aesthetic value" lies in its ability to "confer a significant benefit that cannot practically be duplicated by the use of alternative designs," then the design is "functional." Restatement (Third) of Unfair Competition § 17, Comment c, pp. 175-176 (1995).
- The "ultimate test of aesthetic functionality," it explains, "is whether the recognition of trademark rights would significantly hinder competition." [102]

### 7 ☐ **On to Distinctiveness**

- Only a "distinctive" mark can be registered
- Stands to reason - job of TM is to distinguish source of goods
- Many types of distinctiveness
  - ▮ TM status depends very much on the type of term
  - ▮ effect on TM-ability
  - ▮ effects on *strength of mark*

### 8 ☐ **Purgatory for not-Distinctive Marks?**

- If they have secondary meaning, get treated like distinctive marks
  - ┆ Placed on Principal Register for 10 years at a time
- Otherwise, they are relegated to the **Supplemental Register**

## 9 ☐ **Supplemental Register**

- ┆ "a kind of "trademark Purgatory."
- ┆ It does not offer the owner any of the protections that accompany marks on the Principal Register. Rather, it only provides notice to would-be users of the mark that it is already in use. A Supplemental Register registration, if properly maintained, also lasts for ten years and can be renewed for periods of ten years. After the trademark remains on the Supplemental Register for five years, the owner can petition to move it to the highly-desirable Principal Register. However, if the mark has become distinctive of the goods and services any time during the period of registration, the owner can petition to have it moved to the Principal Register.

## 10 ☐ **Levels of Distinctiveness**

- Generic
- Descriptive
  - ┆ Includes
    - ┆ surnames
    - ┆ geographically distinctive marks
  - ┆ Requires secondary meaning
- Suggestive
  - ┆ Weaker protection
- Arbitrary, Fanciful
  - ┆ Stronger protection

## 11 ☐ ***Abercrombie & Fitch Co. V. Hunting World, Inc.*(2d Cir. 1976) [108] (per Friendly).**

- The cases, and in some instances the Lanham Act, identify four different categories of terms with respect to trademark protection. Arrayed in an ascending order which roughly reflects their eligibility to trademark status and the degree of protection accorded, these classes are
  - ┆ **(1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful.**
- "The lines of demarcation, however, are not always bright."

## 12 ☐ **Generic Terms**

- Generic terms cannot be TM'd
  - ┆ Not even with secondary meaning -- in the field for which they are generic.
- Example:
  - ┆ Cannot TM "computer" for electronic calculating machines
  - ┆ CAN TM "computer" for socks

## 13 ☐ **Descriptive Term**

- E.g. "deep bowl spoon" see, fn 11
- **Requires secondary meaning**
  - ┆ Which can be shown as set out in §2(f) of Lanham Act, 15 USC §1052
    - ┆ **Except as expressly excluded** in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, **nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce.** The Director may accept as **prima facie evidence** that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, **proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.** ... A mark which when used would cause dilution under section 1125(c) of this title may be refused registration only pursuant to a proceeding brought under section 1063 of this title. A registration for a mark which when used would cause dilution under section 1125(c) of this title may be canceled pursuant to a proceeding brought under either section 1064 of this title or section 1092 of this title

## 14 ☐ **Suggestive Terms**

- "[N]either descriptive on one hand nor truly fanciful on the other"



- 21 ☐ **International Kennel Club of Chicago, Inc. v. Mighty Star, Inc. (7th Cir., 1988) [118]**
- To win on merits need to show
    - ┆ Protectable mark
    - ┆ likelihood of confusion
  - For injunction need to show
    - ┆ likelihood of winning on merits
    - ┆ plus irreparable harm
- 22 ☐ **Kennel Club (2)**
- Here mark is UNREGISTERED, so first issue is whether mark is protectable.
    - ┆ "International kennel club" is descriptive, hence needs secondary meaning.
    - ┆ To win on this at trial you need
      - ┆ a consumer survey
      - ┆ and other evidence.
    - ┆ But PI can go on common sense. court thinks dog fanciers are confused
- 23 ☐ **Kennel Club - Dissent**
- Dissent says, "no harm, no foul":
    - ┆ different lines of goods (dog shows, dog toys).
    - ┆ No competition, no economic loss.
  - "if this case can be a winner, it is difficult to imagine one that could lose"
- 24 ☐ **Restatement (3rd) of Unfair Competition Definition [125]**
- § 13. DISTINCTIVENESS; SECONDARY MEANING  
A word, name, symbol, device, or other designation, or a combination of such designations, is "distinctive" under the rules stated in §§ 9-12 if:
    - (a) the designation is "inherently distinctive," in that, because of the nature of the designation and the context in which it is used, prospective purchasers are likely to perceive it as a designation that, in the case of a trademark, identifies goods or services produced or sponsored by a particular person, whether known or anonymous, or in the case of a trade name, identifies the business or other enterprise of a particular person, whether known or anonymous, or in the case of a collective mark, identifies members of the collective group or goods or services produced or sponsored by members, or in the case of a certification mark, identifies the certified goods or services; **or**
- 25 ☐ **Restatement (cont)**
- (b) the designation, although not "inherently distinctive," has become distinctive, in that, as a result of its use, prospective purchasers have come to perceive it as a designation that identifies goods, services, businesses, or members in the manner described in Subsection (a). Such acquired distinctiveness is commonly referred to as "secondary meaning."
- 26 ☐ **Restatement sec. 13, Comment e**
- e. Secondary meaning. ... Secondary meaning exists only if a significant number of prospective purchasers understand the term, when used in connection with a particular kind of good, service, or business, not merely in its lexicographic sense, but also as an indication of association with a particular, even if anonymous, entity. The concept of secondary meaning is also applicable to designations such as graphic designs, symbols, packaging features, and product designs. In these contexts secondary meaning denotes that the feature, although not inherently distinctive, has come through use to be uniquely associated with a particular source. A designation that has acquired secondary meaning thus distinguishes the goods, services, or business of one person from those of others.
  - When a designation has become distinctive through the acquisition of secondary meaning, it is protected under the same principles applicable to inherently distinctive designations. Protection extends, however, only to the secondary meaning that has attached to the designation. The trademark owner acquires no exclusive right to the use of the term in its original, lexicographic sense.
- 27 ☐ **Rock & Roll Hall of Fame v. Gentile Productions [126] (6th Cir. 1998)**
- Issue: does a photo of the RRHoff infringe the Museum's TM on the building?
  - Held, no (over a dissent) because to function as a TM something must function as a TM

■ i.e. serve "to identify and distinguish the goods 'of the mark's owner'...from those manufactured or sold by others and to indicate the source of the goods." 15 USC § 1126.

■ a SM right in design would stop others copying the design for another 'confusingly similar building']

28  **Questions p. 133**

■ Answers not on the slides...