

- 1 ☐ **Unit 6**
- 2 ☐ **Review: Concurrent Use**
 - Common law rule: *Rectanus*
 - ┆ priority only in geographic area -- for category of goods -- of actual use
 - ┆ Many simultaneous users possible. First come, first served.
- 3 ☐ **Review: Lanham Act**
 - Filing gives NATIONAL priority for type of goods used
 - BUT - Lanham Act §33(b), 15 U.S.C. §1115(b)(5), limited area exception
 - ┆ *prior* CL users keep rights, but only where actual prior use (Thrifty)
 - ┆ But, *Delta Donuts* rule: Holder of Lanham Act TM registration can't get injunction against infringing user until the infringement is likely to create confusion (e.g. geographical overlap)
- 4 ☐ **Review: ITUs**
 - Require timely use to perfect priority (up to 36 mo. total window)
 - If so, priority relates back to filing date
 - ITU + perfection beats other use after filing date
 - But, use prior to ITU beats ITU (if asserted in timely way)
 - Beware rules on assignments of ITUs!!!
- 5 ☐ **WarnerVision Ent v. Empire of Carolina [201] (2nd Cir. 1996)**
 - Can person filing ITU application (per 15 USC § 1051(b)) be preliminarily enjoined from engaging in commercial use sufficient to achieve full registration via §1051(d) by holder of similar mark who
 - ┆ commenced commercial use of mark subsequent to ITU application
 - ┆ *and* filed for a TM before ITU applicant's actual use date
- 6 ☐ **Facts**
 - ┆ Sept. 9 '94: TLV sends ITU application for REAL WHEELS (filed 9/23)
 - ┆ Buddy L & WarnerVision
 - ┆ pick the name for their toy cars, and car videos respectively, and package them together.
 - ┆ They do TM searches but TLV's mark isn't in DB yet, so they go forward
 - ┆ Jan 3, '95: Warner Vision applies for registration, accepted
 - ┆ Jan 6, '95 Buddy L applies, rejected
 - ┆ BuddyL negotiates w/ TLV for license
 - ┆ Buddy L goes broke, sells out to Empire
- 7 ☐ **More Facts**
 - ┆ Empire
 - ┆ Oct 25, '95 Empire buys TLV's REEL WHEELS product line, TMs etc., including ITU application
 - ┆ Empire licenses REEL WHEELS to TLV for toy cars
 - ┆ WarnerVision brings this case Nov 13, '95
- 8 ☐ **WarnerVision's Theory?**
 - ┆ What's WarnerVision's claim?
 - ┆ What's its argument in support of that claim?
- 9 ☐ **WarnerVision's Theory**
 - ┆ Its use & application for TM should trump ITU applicant's later use
 - ┆ And, indeed, DCT grants injunction preventing Empire (TLV) from making sales and filing for mark
 - ┆ Result would be to kill any chance of Empire/TLV from converting ITU to TM
- 10 ☐ **ITU Applicant (Usually) Has Right To Go Forward With Use ...**

- CTA2 think this creates window for 'unscrupulous entrepreneurs' to find ITU's, then rush in and do 'use' which would undermine purpose of ITUs.
 - Held, Injunctions against ITUs use should be limited to those who used BEFORE ITU was filed. [204] or for other showing that application is invalid.
- 11 **Question on p. 205:**
- Can you legitimately seek cancellation of a mark
 - not yet used,
 - whose ITU pre-dates your client's actual use
 - but which hasn't been used yet?
 - Other options?
- 12 **Answer**
- In fact they sought declaratory judgement, but court wouldn't give it...
 - on theory that single cease & desist letter without threat to sue ("we hope you will amicably agree") didn't give actual case or controversy since there's not "'reasonable apprehension' of being sued for infringement."
 - Court also said that common law trademark misuse claim can NOT be asserted as an affirmative cause of action. ("Trademark misuse is not an independent cause of action, but is, instead, only an affirmative defense to a trademark infringement claim."
-- Eastman Kodak v. Bell & Howell Doc. Mg't Prod. co. [205] (Fed Cir. 1993)
- 13 **Eastman Kodak v. Bell & Howell Doc. Mg't Prod. co. (Fed Cir. 1993) [205]**
- Oct 12 '90 B&H files ITU for three **numbers** as TMs for microfilm reader/printer
 - Examined, approved
 - Kodak files timely notice of opposition
 - Alleging numbers would be 'solely as model designators...and therefore would be merely descriptive' and there had been no showing of secondary meaning
 - Board stated that a number which functions only in part to designate a model could be inherently distinctive without a showing of secondary meaning.
- 14 **Inherent Distinctiveness at Application Distinguished from at ITU Application**
- Board held it can't determine at ITU, without use, if numbers are 'merely descriptive' or more.
 - So Board 'dismissed opposition without prejudice' to initiation of a cancellation proceeding against the mark if mark is registered.
 - What are the consequences of this for Kodak?
- 15 **(more)**
- Issue: Is "board's implied creation of a presumption in favor of the applicant for a numerical mark intended for use as more than a model designator" a reasonable interpretation of Lanham Act?
 - Held, yes. Time to challenge registration for "mere descriptiveness" is when evidence of actual use exists. [theory: without use, how to tell?]
 - Decisions of TTAB subsequent to *Eastman Kodak* substantially undermine it. At best it's now very narrow – TTAB will reject ITUs for 'mere descriptiveness'.
- 16 **Q2 on p.211**
- Q: Why wouldn't TTAB say "where no evidence of descriptiveness can be found in applications" then we'll apply *Eastman Kodak* presumption for applicant?
 - A: Would create incentive to submit minimal applications?
- 17 **REVIEW PROBLEMS**
- IMPORTANT (re q. 1): Note that five years of continuous use after registration makes mark

incontestable and thus cannot be challenged for mere descriptiveness. cf. *Park 'n Fly* (US 1985).

18 ☐ **CHAPTER FOUR: Registration of Trademarks**

19 ☐ **Practicalities**

- Trademark Searches
- Use
- Registration Process
 - Preparing the application
 - Filing the application
 - Examination by PTO [217]
- Publication for opposition
 - 30 day window to oppose
- State registrations [219]
- Foreign registrations [220]

20 ☐ **What Might Concern the PTO? [217-218]**

- See 15 USC 1052(a)
 - Consists of or comprises immoral, deceptive, or scandalous matter; or
 - matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute;
 - or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after [Jan. 1, 1995]

21 ☐ **Main points of 15 USC 1052(b)-(d)**

- (b): "Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof"
- (c): a name, portrait, or signature identifying a particular living individual except by his written consent
- (d): Mark likely to cause confusion with PTO registered mark

22 ☐ **15 USC 1052(e): Cannot register a mark which...**

- (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, [*]
- (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 4 [15 USC §1054], [*]
- (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them,
- (4) is primarily merely a surname, or [*]
- (5) comprises any matter that, as a whole, is functional.
 - * Can be overcome by 2ndary meaning, 1052(f)

23 ☐ **What if you can't register?**

- Marks which have been refused registration pursuant to §2(e)(1) on the ground of deceptive misdescriptiveness
 - may be registrable under §2(f) upon a showing of acquired distinctiveness,
 - or on the Supplemental Register. 15 U.S.C. §§1052(f) and 1091.
- Marks which are deceptive under §2(a) are not registrable under any circumstances.
- Also (b),(c),(d) -- secondary meaning will not help

24 ☐ **Advantages of Federal Registration [221]**

- Nationwide preemption of all future users in category
- Stop any senior user from expanding territory

- After 5 years: *Incontestability*
 - ┆ Limits challenges to mark
- Actual & constructive notice to others
- Right to bar imports of infringing goods
- Enhance anti-counterfeiting
- Use of ® symbol, 15 USC § 1111

25 ☐ **The Supplemental Register [222]**

- For non-registerable marks “capable” of distinguishing applicant’s goods or services
 - ┆ descriptive marks
 - ┆ geographic terms
 - ┆ surnames
- Not an admission that mark isn’t distinctive, § 27, 15 USC § 1095
- Not much use
 - ┆ deterrent value?
 - ┆ Notice value
 - ┆ PTO may refuse other confusing similar marks

26 ☐ **The ® Symbol [223]**

- ┆ “a registrant of a mark registered in the Patent and Trademark Office, may give notice that his mark is registered by displaying with the mark the words "Registered in U.S. Patent and Trademark Office" or "Reg. U.S. Pat. & Tm. Off." or the letter R enclosed within a circle” - 15 USC § 1111
- Only registered marks may use it,
 - ┆ constructive notice of registration
- Failure to use it bars infringement suit award of
 - ┆ profits
 - ┆ damages
 - ┆ unless can show D had actual notice of registration

27 ☐ **Service Marks**

- 15 USC § 1053
 - ┆ Very similar to TMs
- Issue: What’s a “service”
 - ┆ “performance of labor for the benefit of another”
 - ┆ anything other than things done only for the markholder?
- First use generally requires a sale of service (“in commerce”) rather than mere advertising
 - ┆ Ads may be enough for 1st use of a TM

28 ☐ **Collective & Certification Marks**

- § 4, 15 USC § 1054 [226]
- § 45, 15 USC § 1127 [226]
- §14(5), 15 USC §1064(5) [227]
- Can benefit from CL protection if not registered
- Note. Certification mark
 - ┆ Doesn’t show source of goods
 - ┆ Must be available to all who qualify

29 ☐ **Certifications - generic?**

- Issue with regional certifications can be whether they are generic [228]

36  **Budge test [253]**

- | 1) Is term misdescriptive of character, quality, function, composition, or use of good?
- | 2) If so, are prospective purchasers likely to believe that the misdescription actually describes the goods?
- | 3) If so, is misdescription likely to affect decision to purchase?
- If Q1 is true but not Q2: TM may be arbitrary or suggestive
- If Q1 & Q2 are true, but not Q3: deceptively misdescriptive
- If Q1 & Q2 & Q3 are true: deceptive

37  **Questions on p. 253**

- answers not on slide...
 - | [Slide notes]