Unit 13

HEADS UP: Additional reading @ p. 345
http://www.net2.com/Reconsideration_Denied.pdf

281-307

§1502 = §2(e)(4)
No TM by which goods can be distinguished from another's to be refused registration UNLESS ...
(e) consists of a mark which ...(4) is primarily merely a surname.

In Re Quadrillion Publishing (TTAB 2000) [282]

BRAMLEY mark rejected for books magazines etc. in International Class 16

Applicant says it's a place and a type of apple. Examiner said it's a name and used a DB of 80 million names - which has 433 Bramley people in it. Plus it's not in the dictionary. CA-Fed says that's enough for prima facie surname case. Hutchinson Technology [mentioned 283]

Test: whether it is "primarily merely a surname" depends on "primary significance of the mark to the purchasing public"

Factors
:
(i) the degree of surname rareness;
(ii) whether anyone connected with applicant has the surname;
(iii) whether the term has any recognized meaning other than that of a surname; and
(iv) the structure and pronunciation or "look and sound" of the surname.

Examining attorney met initial burden of proving name is primarily surname.

Question p. 285. If you can show that the name is now distinctive w/in § 2(f) (i.e. 2ndary meaning), it's registerable. But does that registration give you exclusive use? [w/ great reluctance]

Numerals, Letters & Initials [285]

Grades generally not registerable, but possible 2ndary meaning.

IBM. Others?

§2(e)(5) [286]

can't register a mark that "comprises any matter that, a whole, is functional.
[thus, the clothes]

Qualitex v. Jocobson (USA 1995) [286]

An important reminder about functionality.

In re Morton-Norwich Products (CCPA 1982) [287]
[sets what come to be known as "Morton-Norwich factors"!]

Attempt to trademark the shape of bottle for cleaning fluids.

Long discussion of 'functionality' and 'utility' i.e. that which you would need to copy to compete effectively

Determine this by asking the right questions, e.g. is design "superior"?

NB. factors
- existence of utility patent tends to show utility;
- ads touting functional advantages tend to show utility
- availability of alternatives for effective competition
- mfg cost of alternatives

Held, here examiner failed to explain WHAT about the bottle shape was functional ie necessary or superior.

In re Babies Beat Inc. (TTAB 1990) [294]

Baby bottle shape: **de jure** functional (competitor's too hard to clean).

[some facts are just that obvious?]

In re Weber-Stephen Products Co. (TTAB 1987) [296]
Grill designs.

Nb. for 2nd *Morton-Norwich* factor, CCPA accepted deposition evidence that they made it up, or at least were puffing. (although physics suggests round should be best to me!)

Held, not de jure functional, not inherently distinctive, but registerable under 2(f) if there is 2ndary meaning.

Units 14

Lanham Act §§ 10, 45 (15 U.S.C. §§ 1060, 1127)
CB 312-356

Genericism

Bayer Co. v. United Drug Co. (SDNY 1921) [312]

typo: missing "that" after but in p. 313, line 6 (in old edition)

Aspirin (coined name) was patented, ran out in 1917. Up to 1915, however, main sales distribution channel was thru chemists - who sold it as "Aspirin" w/out anything indicating who manufactured it.

1915 Bayer starts selling direct to retail in package "bayer-Tables of Aspirin" but LH says by then it's too late - it's generic.

HELD: grant an injunction against direct sales of the drug under the name 'Aspirin' to manufacturing chemists, physicians, and retail druggists. This will, of course, include invoices and correspondence.

In sales to consumers there need, however, be no suffix or qualification whatever. In so far as customers came to identify the plaintiff with 'Aspirin' between October, 1915, and March, 1917, this may do it some injustice, but it is impracticable to give any protection based on that possibility. Among consumers generally the name has gone into the public domain.

Stix [SDNY 1968) (per Weinfeld) [315]
competitor's campaign to genericize a mark ruled out of order
....why? if "purpose of the genercism doctrine is to permit competitors to call their competing goods or services by their commonly -known names"
a) when you start campaign it's not generic
b) bad faith,
c) not 'natural'

PROBLEM p. 328: what's wrong with the ad?