

Trademark 1

<http://wendy.seltzer.org/neu/IP/>

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Contributory infringement

- Who can be liable for patent infringement?
- Recall *MGM v. Grokster*

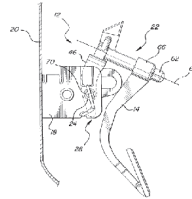
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Obviousness: *Graham*

- Scope and content of the prior art
- Difference between prior art and claims
- Level of ordinary skill in the prior art
- Secondary factors
 - Commercial success
 - Long-felt but unsolved needs
 - Failure of others

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KSR v. Teleflex



- How does the Supreme Court define obviousness?
- Lack of teaching, suggestion, or motivation doesn't mean it's non-obvious

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Patent recap

- What is protected?
- How do you get protection?
- What rights does it convey? Duration?
- What infringes?
- What defenses are available?

- What is the source of law?
- What is the policy behind it?

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Theories to explain patent

- How does it compare with copyright?
- With trade secret?

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“Trademark” 15 U.S.C. §1127

- Any word, name, symbol, or device, or any combination thereof—
 - (1) used by a person, or
 - (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,
- to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

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“Service Mark” 15 U.S.C. §1127

- Any word, name, symbol, or device, or any combination thereof—
 - (1) used by a person, or
 - (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,
- to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown.

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“Certification Mark” §1127

- Any word, name, symbol, or device, or any combination thereof—
 - (1) used by a person other than its owner, or
 - (2) which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by this chapter,
- to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.



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“Collective Mark” §1127

- A trademark or service mark—
 - (1) used by the members of a cooperative, an association, or other collective group or organization, or
 - (2) which such cooperative, association, or other collective group or organization has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,
- and includes marks indicating membership in a union, an association, or other organization.

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Protectable trademarks?

- “Exxon” for gasoline
- Apple logo 
- “Rabbit” corkscrew shape 
- Pink insulation
- Plumeria scent for sewing thread
- “Amazon” for online bookseller
- Blue roofs for IHOP restaurants
- “Northeastern”

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Why protect trademarks?

- Consumer protection – allow identification of goods
 - Fight consumer confusion
- Encourages advertising
- Encourages investment in quality and consistency
 - “goodwill”

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Sources of trademark law

- Federal registration
- Federal protection of unregistered marks
 - Lanham Act § 43(a) [15 U.S.C. § 1125(a)]
- State common law, unfair competition
- State and federal anti-dilution law

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Qualitex Co. v. Jacobson Products Co.

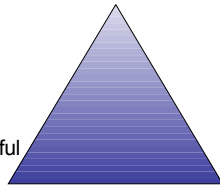


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Strength of Marks

(least protectable)

- Generic
 - Descriptive
 - Suggestive
 - Arbitrary or Fanciful
- (most protectable)



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Strength of Marks

(least protectable)

- Generic → • Not registrable
- Descriptive → • Registrable with proof of secondary meaning
- Suggestive → • Registrable without proof of secondary meaning
- Arbitrary or Fanciful (most protectable) ↗

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Zatarain's v. Oak Grove Smokehouse



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“Secondary Meaning”

- A term has secondary meaning when “the primary significance of the term in the minds of the consuming public is not the product but the producer.”
- Burden of proof rests at all times with the plaintiff

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