

Trademark (2)

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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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Trademark

- Name / symbol / device
- used in commerce
- to identify and distinguish the source of goods or services

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Consumer-focused rationale

Protect consumers against marketplace confusion

by encouraging companies to maintain quality, establish goodwill

by protecting the names and symbols they use

within limits

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§ 1125. False designations of origin and false descriptions prohibited

- (a) (1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—
 - (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or
 - (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act. ⁵

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Classification

- How distinctive is the mark?
 - How good is it at helping consumers identify source?
 - How much would the public / competitors lose if it were monopolized?

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Zatarain's v. Oak Grove Smokehouse



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“Secondary Meaning”

- What was initially a descriptive term can become distinctive as a source-identifier.
- Factors:
 - **consumer surveys**
 - amount and manner of advertising
 - volume of sales
 - length and manner of use
- Burden of proof rests with the plaintiff

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Fair use of descriptive terms

- Use of a term “fairly and in good faith” to describe one’s own goods or services or their geographic origin
- Applies only when the term is used descriptively, not in a trademark sense

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Descriptive?

- Foreign terms
 - La Posada, Kaba
- Acronyms or misspellings
 - EZ, Klear, Fri, Lite
- Personal names
- Geographic marks
- e-, i-, -.com

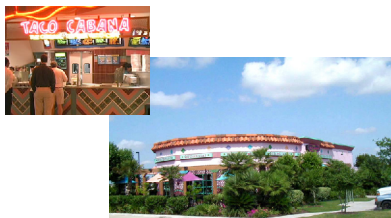
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Depends on relationship of mark to product

- “Hurricane” storm shutters: generic
- “Hurricane” anchors: descriptive
- “Hurricane” boats: suggestive
- “Hurricane” financial services: arbitrary

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Two Pesos v. Taco Cabana



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Trade Dress

- Total image and overall appearance of the product.
- Nonfunctional
- Distinctive
 - Inherently distinctive (arbitrary or suggestive)
 - or Descriptive + secondary meaning

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Wal-Mart Stores v. Samara Bros.



What guides you in choosing a mark?

- Want something memorable
- Something that helps in advertising
- Help describe the product to consumers

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Scope of rights

- Class of goods or services.
- Delta Airlines, Faucets, and Dental can all co-exist
 - At least until dilution enters the picture

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Priority

- Recall that § 1127 protects 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
- Intent to use added in 1989

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Zazu Designers v. L'Oreal S.A.

- ZHD salon registers Zazu trade name in Illinois, prepares to sell salon products
- L'Oreal chooses ZAZU mark
 - Obtains covenant not to sue from clothing manufacturer who had registered ZAZU
- L'Oreal markets ZAZU nationally
- Does ZHD have rights?

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