

Trademark (3)

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

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What's protected by TM:

- word, name, symbol, or device, or any combination thereof
- total image and overall appearance
- that serves to identify and distinguish source of goods or services
- ®: Registered trademark
- ™: Trademark claimed

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Federal registration

- Registrable
- Registrable with proof of secondary meaning
- Not registrable

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Registrable upon use

- Arbitrary or fanciful
- Suggestive
- Geographic terms used arbitrarily or suggestively
- Personal names to designate goods or services provided by the person

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Registrable with proof of secondary meaning

- Merely descriptive marks
- Deceptively misdescriptive
- Geographically descriptive
- Primarily merely surnames

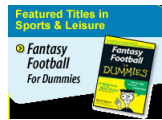
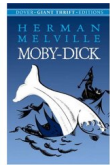
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Not protectable as TM:

- Generic terms
- Immoral, deceptive, or scandalous matter
- Disparagement
- Flags or coats of arms of states or nations
- Names of living persons without their permission
- Functional
- Title of single book

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What about these?



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The screenshot shows a search result for "Cease and Desists for Dummies?". The page includes a title, a date of April 20, 2002, and a table of contents. The table lists sections such as "Table of Contents", "Introduction", "Chapter 1: Why You Need a Cease and Desist Letter", "Chapter 2: How to Write a Cease and Desist Letter", "Chapter 3: How to Enforce a Cease and Desist Letter", "Chapter 4: How to Draft a Cease and Desist Letter", "Chapter 5: How to Draft a Cease and Desist Letter", "Chapter 6: How to Draft a Cease and Desist Letter", "Chapter 7: How to Draft a Cease and Desist Letter", "Chapter 8: How to Draft a Cease and Desist Letter", "Chapter 9: How to Draft a Cease and Desist Letter", "Chapter 10: How to Draft a Cease and Desist Letter". The page also includes a "Related Links" section and a "Footer" section.

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Merely Descriptive or Deceptively Misdescriptive

- § 1052. Trademarks registrable on principal register;
- No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—
- (e) Consists of a mark which
 - (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them,

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Geographical terms

- “Nantucket” shirts
- “Nantucket” juices
- “Nantucket” lobster
 - if it’s caught off Nantucket?
 - if it’s caught in Maine?

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Katonah



- Martha Stewart applies for a trademark on “KATONAH” for a line of home furnishings.
- Should the PTO grant?
- Over the Katonah Village Improvement Society’s objection?

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Park 'N Fly v. Dollar Park and Fly

- “Incontestable” mark
 - Subject to cancellation if generic
 - or if acquired by fraud, abandoned, used to misrepresent, functional, violate antitrust,
 - What if it no longer has secondary meaning?
 - What if it never had secondary meaning?
- Can competitors use “Park and Fly”?

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Incontestability: § 1065

- [T]he right of the registrant to use such registered mark in commerce for the goods or services on or in connection with which such registered mark has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in commerce, shall be incontestable: Provided, That –
 - No adverse decision
 - No pending challenges
 - File an affidavit of continuous use for 5 consecutive years, and continuing use in commerce

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§ 1115(b)

- (b) **Incontestability; defenses**
- To the extent that the right to use the registered mark has become incontestable under section 1065 of this title, the registration shall be conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce. Such conclusive evidence shall relate to the affidavit filed under the provisions of section 1065 of this title, or in the renewal application filed under the provisions of section 1059 of this title if the goods or services specified in the renewal are fewer in number, subject to any conditions or limitations in the registration or in such affidavit or renewal application. Such conclusive evidence of the right to use the registered mark shall be subject to proof of infringement as defined in section 1114 of this title, and shall be subject to the following defenses or defects:
 - (1) That the registration or the incontestable right to use the mark was obtained fraudulently; or
 - (2) That the mark has been abandoned by the registrant; or
 - (3) That the registered mark is being used by or with the permission of the registrant or a person in privity with the registrant, so as to misrepresent the source of the goods or services on or in connection with which the mark is used; or
 - (4) That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin; or
 - (5) That the mark whose use by a party is charged as an infringement was adopted without knowledge of the registrant's prior use and has been continuously used by such party or those in privity with him from a date prior to (A) the date of constructive use of the mark established pursuant to section 1057 (c) of this title, (B) the registration of the mark under this chapter if the application for registration is filed before the effective date of the Trademark Law Revision Act of 1988, or (C) publication of the registered mark under subsection (c) of section 1052 of this title. Provided, however, That this defense or defect shall apply only for the area in which such continuous prior use is proved; or
 - (6) That the mark whose use is charged as an infringement was registered and used prior to the registration under this chapter or publication under subsection (c) of section 1052 of this title of the registered mark of the registrant, and not abandoned: Provided, however, That this defense or defect shall apply only for the area in which the mark was used prior to such registration or such publication of the registrant's mark; or
 - (7) That the mark has been or is being used to violate the antitrust laws of the United States; or
 - (8) That the mark is functional; or
 - (9) That equitable principles, including laches, estoppel, and acquiescence, are applicable.

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Incontestability defenses: §1115(b)

- To the extent that the right to use the registered mark has become incontestable under section 1065 of this title, the registration shall be conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce. ...Such conclusive evidence of the right to use the registered mark shall be subject to proof of infringement as defined in section 1114 of this title, and shall be subject to the following defenses or defects:
 - Fraud, abandonment, defendant's use of own name, priority, misuse, functionality, equitable principles (laches, estoppel).

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What's protected against:

- Infringement
- Dilution of famous marks
- Cybersquatting

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Infringement, § 1114(1)

- Any person who shall, without the consent of the registrant
 - (a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive...
- shall be liable in a civil action by the registrant for the remedies

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Infringement

- TM plaintiff must prove
 - It possesses a mark
 - Defendant used the mark
 - ...in commerce
 - ...in connection with the sale, offering for sale, distribution, or advertising of goods or services
 - ...without authorization
 - **Use was likely to confuse consumers**

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AMF Inc. v. Sleekcraft Boats



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Sleekcraft factors

1. Strength of the mark
2. Proximity of the goods
3. Similarity of the marks
4. Evidence of actual confusion
5. Marketing channels used
6. Type of goods and the degree of care likely to be exercised by the purchaser
7. Defendant's intent in selecting the mark
8. Likelihood of expansion of the product lines

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Sleekcraft factors

1. Strength of the mark
 - generic, descriptive, suggestive, arbitrary or fanciful
2. Proximity of the goods
 - complementary, sold to same class of purchasers, similar in use and function
3. Similarity of the marks
 - sight, sound, meaning
 - as encountered in the marketplace
4. Evidence of actual confusion
5. Marketing channels used
 - same, parallel, or distinct
6. Type of goods and the degree of care likely to be exercised by the purchaser
 - "typical buyer exercising ordinary caution"
 - excludes "wholly indifferent"; includes "ignorant and credulous"
7. Defendant's intent in selecting the mark
8. Likelihood of expansion of the product lines

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"Confusion"

- Purchaser confusion
 - As between competitive products (passing off)
 - As to source
 - As to sponsorship
- Post-sale confusion
- "Initial interest" confusion
- Reverse confusion

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Infringement?



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Infringement?



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