

Trademark 4

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Infringement?



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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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Infringement?



Photo: karroozi on flickr

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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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WhenU's SaveNow pop-up

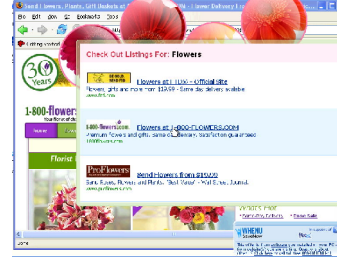


image from
affiliatefairplay.com

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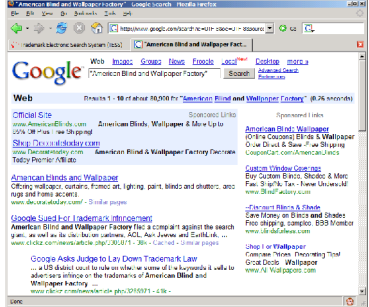
Trademark use?



**SaveNow:
Click HERE
for contact
lens offers!**

www.visiondirect.com -> contact lens ad
www.contacts.com -> contact lens ad
www.visiondirect.com -> contact lens ad
www.contacts.com -> contact lens ad
www.visiondirect.com -> eye care ->
www.1800flowers.com -> flowers ad
www.ftd.com -> flowers ad

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Google search results for "American Blind and Wallpaper Factory".

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Dilution

- § 1127: The term "dilution" means the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of—
 - (1) competition between the owner of the famous mark and other parties, or
 - (2) likelihood of confusion, mistake, or deception.
- e.g. DUPONT shoes, BUICK aspirin, KODAK pianos

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§ 1125(c) Remedies for dilution

- (1) The owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark, and to obtain such other relief as is provided in this subsection. In determining whether a mark is distinctive and famous, a court may consider factors such as, but not limited to—
 - (A) the degree of inherent or acquired distinctiveness of the mark;
 - (B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;
 - (C) the duration and extent of advertising and publicity of the mark;
 - (D) the geographical extent of the trading area in which the mark is used;
 - (E) the channels of trade for the goods or services with which the mark is used;
 - (F) the degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is sought;
 - (G) the nature and extent of use of the same or similar marks by third parties; and
 - (H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.



The image shows the classic Coca-Cola logo on the left and a white t-shirt on the right with a red circle containing the word "Cocaine" and the word "Enjoy" above it.

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The image shows a baseball card for Babe Ruth on the left and a license plate on the right that reads "GR 1133 306 HGP" with the slogan "Greatest Snow on Earth" below it.

"Greatest Show on Earth"

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Proving dilution, FTDA

- Mark must be famous
- Mark must be distinctive
- Junior use is commercial use in commerce
- Begun after senior mark has become famous
- Causes dilution of the distinctive quality of the senior mark

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Mosley v. V. Secret Catalogue



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Dilution

- Fame
- Distinctiveness

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- How do dilution and infringement compare?
- Do they serve the same policy interests?

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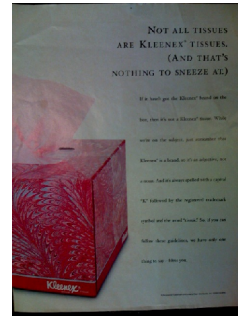


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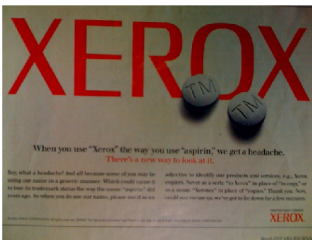
Generic trade dress



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Abandonment?



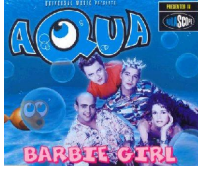
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Abandonment: 15 U.S.C. § 1127

- A mark shall be deemed to be "abandoned" if either of the following occurs:
- (1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. "Use" of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.
- (2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark

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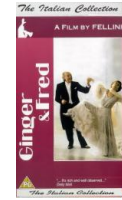
Mattel v. MCA Records (Speech-Zilla meets Trademark Kong)



- Infringement?
- Dilution?
- First Amendment

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Nominative and non-trademark use



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Tom Forsythe, Food Chain Barbie



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