TRADEMARK LAW

1. WHAT IS A TRADEMARK?
   1. Dominant Framework
      1. Trademark: word or symbol designation which identifies the source of the goods or services
         1. Source: production (manufacturer), commercial (design, IP), geographic (also certification marks)
         2. Includes trade marks (goods), service marks (service providers), trade names (corporations), trade dress (packaging and product features)
      2. Purpose of trademark protection
         1. Consumer protection
            1. Efficient communication in market economy
            2. Economically motivates product differentiation – consumer wants assurance that producer maintains consistent quality
            3. *Champion* allow use of TM in sale of refurbished/used goods as long as clearly indicated – better to give consumer more information (efficient, non-deceptive)
         2. Producer protection
            1. Creates value in the marks/brands themselves –
            2. *Hanover* protects goodwill and reputation of the producer – TM is a property right appurtenant to the established business or trade one is engaged in
         3. Two types of liability
            1. Infringement: likelihood of confusion (confusion of the consumer)
            2. Dilution: damaging the brand value (producer protection)
      3. Subject matter – what is protected
         1. Taxonomy of Trademarks
            1. Arbitrary: word mark that has no logical association with the product it is attached (Apple computers)
            2. Fanciful: a created word (Kodak, Exxon)
            3. Descriptive: if the name describes the good/service it is only protectable if it has acquired secondary meaning

Secondary meaning: term/phrase was second to arise in time, but the source of the good becomes the first thing people think of

*Coca-Cola* although name misdescriptive, it had acquired secondary meaning so public did not think it was actually coca leaves and cola beans

*Kellogg* expired patent meant term and shape of “shredded wheat” belonged to the public, Nabisco could not trademark b/c it was descriptive and no secondary meaning (must show primary significance of term in minds of consuming public is the producer not the product)

* + - 1. Trade dress
         1. Product features

Cannot trademark functional aspects (*Qualitex, Inwood*)

*Kellogg* pillow shape was cost-effective way to produce

*Traffix* expired patent (spring design to keep roads signs upright) is strong evidence that feature is functional, could not meet heavy burden to show that features of expired patent are ornamental, incidental, or arbitrary

* + - * 1. Packaging features
      1. Slogans
         1. Tend to be descriptive, but can be protected if they acquire secondary meaning through use – but less important b/c advertising changes so quickly (except Just Do It)
      2. Color
         1. Can be trademarked if it acquires secondary meaning – using color for branding purposes (e.g. insulation)

*Qualitex* color can distinguish source, an ordinary requirement for TM

Color is by default descriptive, must have secondary meaning for TM protection

* + - * 1. Color cannot be protected if it is functional

Functional: confers a non-reputation advantage on the producer – product better, easier to manufacture, cost of production or distribution

Color can be functional for aesthetic tastes, so cannot TM (matching gardening tools is functional, but making motor look smaller is neurological not just functional)

Colors to blend in/match and colors to stand out serve functional purposes

* + - 1. Sound marks – identify the source, must establish secondary meaning
         1. How consumer experiences is important; fleeting impression harder to establish secondary meaning
      2. Scent – as indicator of source (*In re Clark* scented yarn)
         1. Excludes fragrances of products noted for those features (perfumes, scented household products)
      3. Taste – harder to TM b/c cannot taste product before purchase and would not serve to indicate source
      4. Touch – distinguish product prior to purchase (back velvet wine bottle)
  1. Alternative Frameworks
     1. Dilution – producer protection
        1. Consumer not confused to source/producer, but TM is diminished in some way
        2. *Stork Restaurant* producer fairness to prevent other users from reaping where they have not sown – prohibits passing off someone else’s trade name as their own and whittling away at goodwill of TM
        3. *Ringling Bros* dilution is caused by blurring or tarnshiment, such that the mark is losing part of its distinctiveness and value
     2. Unfair Competition: business competition is allowed unless harm results from
        1. Deceptive marketing (consumer protection paradigm)
        2. Infringement of TM
        3. Appropriation of intangible trade values, right of publicity (producer protection paradigm)
           1. *INS v. AP* though news is not protectable, INS appropriated stories and published as their own on West Coast was unfair competition ~ reaping where they have not sown
  2. Trademarks in bigger World of IP
     1. *Trade-Mark Cases* Congress has authority to regulate under commerce clause
     2. Borchard: no bar to one thing being protected under more than one type of law
     3. Collective marks: production (Napa wine growers) and membership (Elks club)
     4. Certification marks: owner does not use but allows other to use when they meet certification standards
        1. Standards: regional origin (Idaho potatoes), material (wool), mode of manufacture (Kosher), quality, accuracy, or labor performed by members of a union
        2. How owner loses rights of certification marks Lanham Act §14
        3. Geographical indications

1. ACQUISITION OF RIGHTS
   1. Distinctiveness of a Trademark
      1. Taxonomy of marks (*Abercombie*) – very contextual
         1. Fanciful: technical TM, don’t need secondary meaning to register
         2. Arbitrary: technical TM, don’t need secondary meaning to register
         3. Suggestive: technical TM, don’t need secondary meaning to register
            1. Requires imagination, thought and perception to reach a conclusion as to the nature of the goods
         4. Descriptive: conveys and immediate idea of the ingredients, qualities, or characteristics of the goods
            1. Can only register if it has acquired secondary meaning, can also protect CL rights in court if secondary meaning
            2. Prima facie showing of secondary meaning: substantially exclusive and continuous use of the mark for five years preceding application
         5. Generic: common descriptive term can never be registered and doesn’t deserve protection
      2. Descriptive
         1. *Quik-Print* immediately conveys characteristics of appellant’s service – don’t need mental gymnastics to figure it out
         2. *Waltham Watch* geographic designation is descriptive though Waltham had acquired secondary meaning, can not bar another producer from saying where their products come from as long as they uphold obligation to prevent any deception
         3. Secondary Meaning
            1. *International Kennel Club* whether descriptive term has acquired secondary meaning – Gimix factors: consumer survey, amount and manner of advertising, volume of sales, length and manner of use, consumer testimony
      3. Inherently Distinctive
         1. *Rock N Roll Hall Of Fame* not all inherently distinctive symbols function as protectable marks – must be used as a TM with purpose of identifying source of the merchandise
            1. P wasn’t using on all their stuff like graphic mark and not using it consistently – did not create separate and distinct commercial impression
            2. Buildings only permitted to be TM when it acquires secondary meaning (e.g. Disneyland castle)
   2. Acquisition of TM Rights through Use
      1. Lanham Act §45 Use In Commerce: bona fide use of a mark in ordinary course of trade, not merely to reserve a right in a mark
         1. Commerce = that which can be regulated by Congress (interstate commerce)
         2. Mark is used in commerce on goods when it is placed on the goods, their containers, displays associated with it, tags, labels, or on documents if placement on goods is impracticable (e.g. crude oil), and when goods are sold or transported in commerce
         3. Mark is used in commerce on services when it is used or displayed in the sale or advertising of services
         4. *Procter & Gamble* **token use** will not constitute adequate use to establish TM rights
            1. Use must not be sporadic, nominal and intended solely for TM maintenance
            2. P&G’s minor brands program failed to establish TM rights in selected brands b/c they were repackaging other companies’ products for a nominal 50 packages a year $2 each

Not using on their own product and not intended to make a profit

* + - 1. *Harmon* single location restaurant satisfied use in commerce requirement for registering Bozo where restaurant served interstate travellers in tri-state metropolitan area, and articles about restaurant in out-of-state magazines (other evidence: located on interstate highway, 50% meals served to interstate travelers, regularly advertises out-of-state)
    1. Priority of Use and Ownership
       1. *Maryland Stadium Authority* CL rights to “Camden Yards” established b/c ads and promotions are sufficient within a commercially reasonable time prior to rendition of goods/services
          1. Analogous Use: look back in time from when goods/services entered the market, at ad/promotion activity and totality of acts which create association with the mark – planning committee, newsletters, pamphlets (though hadn’t came up with the name yet)
          2. If it never goes to market, ad/promotion does not start the clock on use
       2. *Blue Bell* internal transaction to managers was not sufficiently public to establish priority
          1. Adoption + Use that is sufficiently public to identify or distinguish the marked goods in an appropriate segment of the public mind as those of the adopter of the mark, is competent to establish ownership
          2. Court looks at bona fide use when goods first shipped to customers
       3. *Tavern on the Green* prior use since 1934 of name for building leased out to concessionaires, and continuous use b/c periodic renovations do not interrupt use (looks like intent to continue to use)
    2. Concurrent Use
       1. Rule: first to use mark in geographical area, creates priority CL rights to the mark in that geographical area. Registration expands priority nationwide except to areas where another used the mark first or concurrently in bona fide good faith.
          1. Registered mark treated as constructive use throughout the country
       2. *Rex* United Drug’s nationwide priority started after Rectanus’ priority in Louisville, so could not get exclusive use
          1. United did not have business in KY, there was no right appurtenant to an established business or trade to establish priority there
       3. Limited Area Exception (defense to incontestable TM & codification of *Rex*)
          1. Incontestable: status of registered TM after 5 years, cannot claim that it is merely descriptive
          2. Must demonstrate for defense

Adopted its mark before junior user’s registration of the mark, and without knowledge of junior user’s prior use

The extent of the trade area in which senior user used the mark prior to junior user’s registration

That senior user has continuously used the mark in the pre-registration trade area

* + - * 1. *Thrift Cars* could show it adopted mark in good faith before Thrifty’s registration, but could not show sufficient market presence in Nantucket before registration to establish continuous use in pre-registration trade area
        2. *HealthSource* Limited Area Exception does not apply to Internet – senior CL user cannot claim exclusive use to Internet b/c the Internet is used all over (not a single geographic area) and would undermine the benefits of registration and critical use of advertising
        3. *Dawn Donut* although Dawn’s registration gave Hart constructive notice of prior use, court said there was no likely confusion at present time due to separate trading areas
  1. Registration Process and Intent To Use
     1. Bases for Registration
        1. Use in Commerce
           1. File application with date of first use and date of first use in commerce, the goods connected with the mark, and a drawing of the mark

Include verified statement that to best of applicant’s knowledge, no one else has right to use the mark or similar marks

* + - * 1. Application reviewed by TM Examiner/Attorney and conducts search
        2. If approved, published in *Gazette* which allows people to oppose
        3. If no opposition, proceeds to registration
      1. Intent to Use
         1. File application of bona fide intention, with circumstances showing good faith, to use mark in commerce
         2. Mark approved by Examiner, no oppositions or oppositions are overcome
         3. Notice of Allowance issued, starts clock
         4. ITU applicant has 6 months to file Statement of Use stating first date of use in commerce and provide specimens of mark of goods

If applicant cannot prove use in first 6 mos, can apply for 6 mos extention up to 5 times, maximum total of 3 years from Notice of Allowance

Must have good cause to apply for another 6 mos

* + - * 1. Registration proceeds once use is established
    1. Advantages of Principle Register
       1. Nationwide protection from date of application
       2. Incontestability if used for 5 years
       3. Warning to others
    2. Supplemental Register
       1. If descriptive or geographic mark does not have secondary mean, applicant can opt to get it on Supplemental Register
       2. Puts others on notice that you are using – PTO will see when examining other’s application
    3. Notice of Registration is required on mark
       1. Can’t get damages for infringement if you don’t use ® consistently on mark, unless you can prove that infringer had actual notice
       2. *Hacky Sack* can display ® for two marks
    4. Maintenance and Renewal
       1. §8 Affidavit of Use within 1 year after 5th year of use that mark is in use
       2. §9 Renew every 10 years by Renewal Notice + §8 affidavit
  1. Bars on Registration
     1. §2(a) Immoral, Deceptive, Scandalous or Disparaging Marks
        1. *In Re Fox* court will not use gov time and money on scandalous marks, PTO can prove scandalousness by establishing that a mark is vulgar
           1. **Scandalous or immoral** is measured by if a substantial composite of the population would find vulgar, in context of contemporary attitudes and of marketplace as applied only to the goods described in the application
           2. How TM is perceived visually and aurally – no difference between Cocksucker and Cock Sucker
        2. *Boston Red Sox* **Disparagement** two-part test (*Greyhound*)
           1. The mark will be understood as referring to the opposer’s mark

Sex Rod copied font, style and structure of mark, admitted he intended to refer

* + - * 1. The mark is disparaging: offensive or objectionable by a person of reasonable sensibilities – casts doubt on opposer’s goodwill

Mark is sexually vulgar version of club’s symbol and makes an offensive comment on the club

* + - * 1. Standing for disparagement case: anyone who has a reasonable belief that they have a real interest
      1. *In re Squaw Valley* Test for **disparagement** (*Harjo*)
         1. What is the likely meaning of the TM?

Contextual – relationship between other elements of the mark and nature of goods/services

Does that meaning refer or point to an identifiable person, group, institution or belief?

* + - * 1. If so, is it disparaging to a substantial composite of the referenced group?

Examiner must provide sufficient evidence that substantial composite finds it disparaging

* + - 1. *Bayer v. Stamatios* **deceptive** marks are absolute bar, but deceptively misdescriptive marks have potential to attain secondary meaning and be registered
         1. *Budge* test to distinguish b/w deceptive and deceptively misdescriptive

Is the term misdescriptive? – does not accurately describe the goods

Yes, organic aspirin does not contain acetylsalicylic acid (aspirin)

If so, do purchasers believe the misdescription? – believe that it actually describes the goods?

Yes, purchasers likely to believe based on advertising on website, depends on how smart the consumer is

If so, will it affect the purchasing decision of relevant consumers?

Yes, people want health benefits of aspirin without side effects of synthetic aspirin

* + - * 1. If answer to all three questions is Yes 🡪 2(a) Deceptive (absolute bar)
        2. If answer to 1& 2 are Yes, but 3 is No 🡪 2(e)(1) Deceptively Misdescriptive (can attain registration with proof of secondary meaning)
        3. If answer to 1 is Yes, but answer to 2&3 is No 🡪 arbitrary or suggestive
    1. §2(f): (a), (b), (c), (c), (e)(3), and (e)(5) are absolute bars, but (e)(1), (e)(2), (e)(4) can become registered if they become distinctive (proof of secondary meaning)
    2. §2(b) consists or comprises the flag or coat of arms of the US, or any State or municipality, or foreign nation, or any simulation thereof
       1. *Old Glory Condom Corp* simulation means it is pretty close to exact copying of flag, many registered marks have flag design
    3. §2(c) name, portrait, signature of living person without their consent, or of dead president if his widow is still alive without her consent
       1. *Hoefflin* test for determining whether person would be associated with the mark
          1. Person is so well know that the public would reasonably assume a connection to them
          2. The individual is publicly connected with the business in which the mark is being used

Celebrities and world-famous politicians such as Obama, are entitled to 2(c) protection without having to evidence a connection with the involved goods or services

* + - 1. 2(a) also bars anything that falsely suggests a connection with persons, living or dead
    1. §2(e)(2) & §2(e)(3)
       1. (e)(2) marks that are **geographically** **descriptive**, except if it indicates regional origin (aka certification mark)
          1. Not an absolute bar if you can show secondary meaning
       2. (e)(3) marks that are primarily **geographically deceptively misdescriptive**
          1. An absolute bar b/c it looks as though mark holder is being deceptive
       3. *Baik* look at relevant consumer (vodka drinking consumer) to determine if mark is geographically descriptive to them
          1. Is the name of the place generally known to the public?

Deepest lake, scientific expeditions, energy pipeline

* + - * 1. Would the public make a goods/place association – would they believe that the goods/services originate in that place?

Can assume association if goods are actually made in geographic location – made next to Lake Baikal and from the water of the lake

* + - * 1. If yes to 1 and 2 🡪 primarily geographically descriptive
        2. If good does not actually come from that place, but consumer makes goods/place association 🡪 primarily geographically deceptively misdescriptive
        3. If there is no goods/place association 🡪 no bar, can use on any product even if it doesn’t come from there
    1. §2(e)(4) marks which is primarily merely a **surname**
       1. *Quadrillion* Examiner has initial burden of proof that it is surname using *Benthin* factors
          1. Surname rareness – no threshold, but Bramley had ‘measurable exposure’ 433 in US
          2. Anyone connected with the applicant has the surname
          3. Any other recognized meaning
          4. Structure and pronunciation (look or sound) of the surname
       2. Not an absolute bar if it achieves secondary meaning
    2. §2(e)(5) marks which comprises any matter that, as a whole, is **functional**
       1. *Becton, Dickinson & Co.* tried to register trade dress for cap on blood collection tube
          1. *Morton-Norwich* factors to determine if mark is functional

Existence of utility patent

Existence of design patent might have completely opposite effect on functionality analysis – shows that aspects are ornamental not functional

Advertising touts utilitarian advantages of design

If ads true, admit it is functional, if false, deceiving customers will be estopped

“Look for” advertising shows using shape of mark as indicator of source (as a TM) to distinguish from others

Simple or inexpensive method of manufacture

Does cost effective manufacture confer a non-reputational advantage

Availability of alternative designs

Design patent can be evidence of alternative designs

* + - 1. *In re Vertex* pulsating sound/audible alarm is essential to use of applicant’s product – barred for functionality
         1. Note: sounds require secondary meaning
    1. §2(d) mark consists of or comprises a mark which so resembles a registered mark or previously used mark that is not abandoned, and is **likely to cause** **confusion**
       1. *Nutrasweet* opposed registration for Nutra Salt, TTAB uses *DuPont* factors (not same likelihood of confusion test used for infringement in federal courts)
          1. Similarity of marks: sight, sound, meaning
          2. Proximity of goods
          3. Marketing channels
          4. Consumer sophistication: low cost + impulse 🡪 les sophistication, likely confusion
       2. *Marshall Fields* dept. store waited to sue Mrs. Fields because originally marks were fine, but started to grow more similar and make similar products
          1. Similarity: composite marks with “Fields” but not dominant, trade dress with different script and different colors
          2. Strength of mark: Marshall famous for department store not cookies
          3. Channels: would not expect Marshall bakery on its own
          4. Evidence of confusion: surveys must present neutral questions, and products as they appear in the marketplace (not side by side)

1. CONFUSION BASED INFRINGEMENT
   1. Infringement and the Likelihood of Confusion
      1. Action in court under Lanham Act §32 for registered TM or §43 for unregistered TM
         1. Standard for Infringement – using a designation that causes likelihood of confusion
            1. That actor’s business is the business of the other or is associated or otherwise connected with the other; or
            2. That goods/services marketed by actor are produced, sponsored, certified, or approved by the other; or

Classical confusion – passing off

* + - * 1. That goods/services marketed by other are produced, sponsored, certified, or approved by the actor

Reverse confusion – people think senior user’s mark is subsidiary of junior user

* + - 1. 9th circuit *Sleekcraft* factors, not exhaustive
    1. Lanham Act §32 action brought by owners of registered TM
       1. *Gallo* compared marks for wines, court found D’s use would lead to consumer confusion
          1. Strength: stronger marks awarded greater protection b/c consumer more likely confused when she sees similar designations; universal recognition v. widespread use by third parties
          2. Similarity of mark: “gallo” used among diff terms, could think E&J made Italian wine; registration problems in Canada and UK b/c confusingly similar
          3. Similar marketing channels
          4. Degree of care: court deems wine an impulse buy, but could be categorized in either
          5. Evidence of actual confusion: never do side-by-side survey (only generic versions sold right next to major brand), and no leading questions
          6. D’s intent in adopting mark: most determinative factor is whether D is acting in good or bad faith
       2. *Banfi* no actual confusion (misdirected phone mail or calls), and widespread third-party use means consumer is accustomed to distinguish them
          1. Strength of mark: conceptual strength (descriptive, suggestive, arbitrary, fanciful), market strength (advertising spending), crowdedness of the field (consumer distinguish b/w multiple uses)
          2. Similarity: dissimilar number of words, different translations, different labels
          3. Proximity: *Polaroid* factors blend proximity of goods and market channels
          4. Quality of D’s product: least relevant factor (looks like dilution so ignored)
       3. *Leelanau* market channels factor is determinative – survey flawed b/c only way to experience B&R’s TM is in their tasting rooms
    2. Likelihood of confusion as a question of law or a question of fact –
       1. Three-way split
          1. Question of Law – Federal circuit (appeals from TTAB)
          2. Mixed Question – 2nd and 6th

Each judgment on a factor is a factual finding

The balancing of factors can be done de novo

* + - * 1. Question of Fact – other 9
      1. *Maker’s Mark* 6th circuit two-part test, Cuervo appealed on findings of 3 factors
         1. Strength: dripping wax is conceptually strong (unique and draws in costumer), commercial strength ads and publications focus on red wax, crowdedness – third-party use of similar mark in relevant market (not all distilled spirits)
         2. Similarity: generally, house marks decrease confusion (*Autozone*), but really good brand marks become house marks, confusion as to association (not source/palm off)
         3. After reviewing each factor under clearly erroneous standard, review court’s findings under de novo review to balance factors
    1. Initial Interest Confusion
       1. *Mobil* standard: likelihood that an appreciable number of ordinarily prudent purchasers are likely to be misled, or indeed simply confused, as to the source of the goods in question
          1. Similarity: as a matter of law, cannot equate word Pegasus with picture of flying horse, but court could find as factual matter based on context and common sense
          2. Strength: Mobil’s mark has unparalleled strength = broader protection
          3. Actual confusion: no actual confusion at the end of a deal, but potential clients confused during initial process of the deal – initial interest confusion, even if confusion is cleared up by the end
       2. *Blockbuster* question is whether the name confused consumers, not whether the name attracted consumers or whether consumer was confused at point of sale
       3. *Network Automation* using competitor’s TM as keyword in Google ads constitutes a use in commerce, and looks like comparative advertising but it is initial interest confusion (not mere initial diversion)
          1. Strength: federally registered are presumptively distinctive (not inherently distinctive)
          2. Proximity of goods: complementary (Aunt Jemima sold and consumed together), sold to same class of purchasers, similar use and function
          3. Marketing channels: clear error in district court finding both companies’ use of internet advertising constitutes shared market channels b/c both use internet to sell as well
          4. Type of good and purchaser sophistication: precedent that Internet is low degree of care, but must consider the type and cost of good here looks more like capital investment
          5. Initial interest confusion on the Internet is problematic b/c all you have to do is click back to get out of where you don’t want to be
    2. Post-sale Confusion – only used in some lower courts
       1. *Mastercrafters* counterfeit of Atmos clock confuses source of goods post-sale, hurts luxury brand reputation
          1. Policy problem: design patents expire, but TM in product design trade dress can be protected forever with renewing TM – risks creating permanent design protection
       2. *Munsingwear* court found no confusion – must consider whether to compare pre-sale or post-sale products, and *Squirt* factors
          1. Compares pre-sale products b/c underwear not seen post-sale (worn under clothes) – pre-sale includes product packaging
          2. *Squirt*

Similarity – should compare as consumer experiences the product in the marketplace

Proximity

Sophistication of consumers – underwear is inexpensive but not an impulse buy

* + 1. Reverse Confusion: when junior user who adopts lesser known mark of senior user, becomes so well known that senior user customers think the senior user is affiliated, subsidiary or infringing on junior user
       1. *Harlem Wizards* analysis focused on NBA customers, but should focus on whether Harlem customers would be confused by comparing similarity of services (same generally, different specifically), consumer care (disparity in ticket prices)
       2. *Dreamwerks v. SKG* uses 3 *Sleekcraft* factors to determine confusion
          1. Arbitrariness (strength): conceptual strength at best suggestive
          2. Similarity: perfect similarity of sound, sight is very similar in print – dumb consumers won’t notice, smart consumer will notice and assume it is a subsidiary of DreamWorks
          3. Relatedness: film production and film fan conventions are complementary products – movie studios control a lot of related industries
    2. Lanham Act §43 action brought by unregistered TM holders
       1. *Taco Cabana* unregistered trade dress is protected if it is either inherently distinctive (arbitrary, fanciful, suggestive) or acquires distinctiveness through secondary meaning (descriptive), is not functional, and with proof of a likelihood of confusion
          1. Trade dress can be inherently distinctive *Taco Cabana* 1992
          2. No single color can be inherently distinctive (must show secondary meaning) *Qualitex* 1995
          3. Product design cannot be inherently distinctive (must show secondary meaning) *Samara* 2000
          4. Packaging can be inherently distinctive, as long as it is not a single color
    3. Contributory and Vicarious Liability
       1. *Inwood* generic drug manufacturer copied pill colors of TM drug (not primary infringement b/c colors functional and cannot protect functional even if it acquires secondary meaning)
          1. Secondary liability for infringement if manufacturer (two prong test)

Intentionally induces another to infringe a TM, or

Continues to supply its product to one whom it knows or has reason to know is engaging in TM infringement

Standard based on knowledge or constructive knowledge

* + - 1. *Tiffany* under second prong of liability test, knowledge must be specific, generalized knowledge is insufficient – liability for generalized knowledge of all counterfeiting could threaten eBay’s business model
         1. Liability for **identified individuals known by it** (*Sony* Betamax case)
         2. Willful blindness that prevents specific knowledge shows bad intent = satisfies standard for specific knowledge?
  1. Defenses
     1. §33(b)(4) Fair Use
        1. *US Shoe* small print ad copy used “feels like a sneaker” in fragment of a sentence was fair use of a descriptive phrase, not infringing on US Shoe’s slogan
           1. If a TM has a descriptive meaning, fair use allows them to remain part of vocabulary by using it in their descriptive way
           2. Brown was not using as a TM or a slogan, not trying to get secondary meaning
        2. Is user pointing away from TM’d product/service 🡪 descriptive fair use
     2. Nominative Fair Use – judge-made defense
        1. *New Kids* newspaper polls voted on favorite members of the group court, nominative fair use test:
           1. Product or service in question must be one not readily identifiable without use of the TM
           2. Only so much of the mark(s) may be used as is reasonably necessary to identify the product or service (don’t copy font, just use it in print)
           3. User must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the TM holder
        2. *Volkswagon* repair service provider uses TM for which cars it specializes in repairing
        3. Is user pointing towards TM’d product/service 🡪 nominative fair use
        4. *Toyota v. Tabari* use of TM in domain name
           1. Under 3rd part of NKOTB test, when domain name consists of only the mark looks more like sponsorship/endorsement, but when mark is used with other words less like sponsorship

No initial interest confusion b/c consumers accustomed to clicking back button when they are not satisfied with the landing page

* + - 1. Nominative fair use looks like a complete defense, but also looks like disproof of likelihood of confusion b/c burden reverts back to P to prove likelihood of confusion outside of NKOTB
      2. *Mattel v. Universal* First A protection for TM that are imbued with such expressive value b/c the mark becomes a word in our language and assumes a role outside the bounds of TM law
         1. Aqua song targets Barbie herself 🡪 Parody 🡪 Nominative Fair Use

Parody: using mark to make fun of the thing itself

Satire: using mark to make fun of other things

* + - * 1. Artistic Free Expression

Literary titles do not violate Lanham Act unless title has no artistic relevance to the underlying work whatsoever (*Rogers*)

If no relevance, apply likelihood of confusion test

If there is relevance, D is fine unless the title explicitly misleads as to the source or content of the work

* + - 1. *Walking Mountain* use of Barbie in title and dolls in photographs
         1. In title, protected under artistic free expression b/c title has artistic relevance to the work
         2. Trade dress plays a role in our culture beyond TM – nominative fair use b/c it is a parody
         3. No dilution b/c non-commercial artistic expression protected under First A
  1. §43(c) Dilution
     1. Injunctive relief for famous mark (activity must occur after mark becomes famous) against a person who uses a mark in commerce that is likely to cause dilution by blurring or tarnishment
        1. Famous: widely recognized by general consuming public of the U.S. (nationwide)
        2. Blurring: impairing distinctiveness (6 factors FDTA)
        3. Tarnishment: association arising from similarity that harms the reputation of the famous mark in a way that sullies it
        4. Exceptions
           1. Fair use – descriptive and nominative (comparative advertising, parody, criticizing, commenting on mark)
           2. News reporting
           3. Any noncommercial use of a mark
     2. *Art Van* court found dilution for use of Hershey-like trade dress for couch bar ad
        1. Hershey trade dress not registered, but trade dress taken as a whole is immediately recognizable and famous
        2. FTDA factors 1 and 5 important: similarity of marks, and whether user intended to create association with famous mark

1. CANCELLATION OF TRADEMARKS
   1. Genericism
      1. *Bayer v. United Drug* Bayer’s patent on acetyl salicylic acid under name Aspirin expired, no TM
         1. Druggists knew Aspirin as Bayer, but test is general consuming public
         2. Consumers thought it was the type of drug in powder form, and in pill form Bayer labeled it as “Tablets of Aspirin” showing it had acquired descriptive meaning
   2. §45 Abandonment
      1. Mark can be abandoned if
         1. Nonuse for three consecutive years and intent not to resume such use (prima facie evidence)
         2. Doing or failing to do something that causes the mark to become generic
      2. *Silverman v. CBS* radio character shows portrayed on TV were demeaning and CBS stopped using in 1966, Silverman used for Broadway musical
         1. Non-use for 21 years was more than enough to establish abandonment (sporadic licensing for documentary purposes not sufficient use)
         2. Intent not to resume refers to the reasonably foreseeable future, not ever