

Trademark protection

- Distinctive
- Not disqualified
- Used in commerce

- Not required:
 - registration
- Form of symbol can vary greatly

Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4 (2d Cir. 1976)

- Safari mark

- Alleged infringing uses by Hunting World
 - Safari
 - Minisafari
 - Safariland

- Use as applied to products versus in language?

- Continuum of distinctiveness for a word mark

- Application
 - Generic for clothing
 - Suggestive or descriptive for boots / shoes
 - But, “incontestable”

Trademark continuum of distinctiveness for word marks

Generic Descriptive Suggestive Arbitrary / Fanciful / Coined

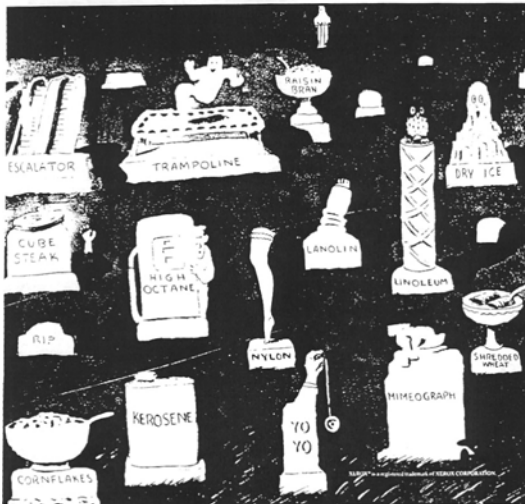


Descriptive?

- character
- function
- feature
- quality
- ingredient
- nature
- purpose
- use
- characteristics
 - dimensions, color, odor.
 - . .



Genericness



Once a trademark, not always a trademark.

They were once proud trademarks, now they're just names. They failed to take precautions that would have helped them have a long and prosperous life.

We need your help to stay out of there. Whenever you use our name, please use it as a proper adjective in conjunction with our products and services: e.g., Xerox copiers or Xerox financial services. And never as a

verb: "to Xerox" in place of "to copy," or as a noun: "Xeroxes" in place of "copies."

With your help and a precaution or two on our part, it's "Once the Xerox trademark, always the Xerox trademark."

Team Xerox. We document the world.

Generic-ness

**It's just not BOTOX[®]
without the ®.**

The ® after BOTOX[®] Cosmetic means it's a registered trademark of Allergan, Inc.
Not a nickname. Or a generic term for other botulinum toxins.
It's the BOTOX[®] you and your patients trust.
And the one we trust you'll always use with an ®.

**BOTOX[®]
Cosmetic**
Botulinum Toxin Type A

ALLERGAN ©2003 Allergan, Inc., Irvine, CA 92612. BOTOX is a registered trademark of Allergan, Inc. www.botox.com 0304625

Zatarain's

- Attributes of Zatarain's marks?
- Classification of marks?
- Secondary meaning?
- "Fair use" defense - 15 U.S.C. § 1115(b)(4)



Zatarain's

- Fish-Fri
 - Suggestive or generic – either side of descriptiveness
 - Dictionary - ordinary significance and meaning of the words
 - Imagination test
 - Whether competitors need to use the term
 - Extent of actual use by others to describe/identify
 - Secondary meaning
 - What if a mark is incontestable?
 - Factors / Circumstantial evidence
 - Amount of advertising and promotion of mark and connection to product
 - Volume and type of sales (repeat?)
 - Length and manner of use of mark
 - Market research - testimony / articles / reviews / surveys
 - Surveys – most direct and persuasive
 - Bad faith copying ("NY rule")
 - "Fair use" defense - 15 U.S.C. § 1115(b)(4)
 - Used fairly in good faith only to describe to users the goods or services . . . or their geographic origin.
 - Impact of trade dress on "fair use" in this case?



Zatarain's

- Chick-Fri
 - Classification?
 - Secondary meaning?



Innovation Ventures, LLC v. N.V.E., Inc. 694 F.3d 723, 729-730 (6th Cir. 2012)



“Primarily geographically descriptive” marks

- A mark will be deemed primarily geographically descriptive under § 2(e)(2) if:
 1. the primary significance of the mark is a generally known geographic location;
 2. the goods or services originate in the place identified in the mark; and
 3. purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark.

TMEP §1210.01(a).

Certification Marks

- The term "certification mark" means 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. 15 U.S.C. § 1127
- Must be open to any producer that meets the standards.



Collective Marks

- The term "collective mark" means 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. 15 U.S.C. § 1127
- Two possible functions of the collective mark with respect to the association, union, cooperative, fraternal organization or other organized collective group using the mark:
 - As a mark adopted for use only by its members, who in turn use the mark to identify goods or services – mostly treated as ordinary trademarks/service marks
 - Solely to identify the person displaying a mark as a member of the collective group – a membership mark
- The term "mark" includes any trademark, service mark, collective mark, or certification mark. 15 U.S.C. § 1127

Classifying other types of marks

- Surnames
- Acronyms
- Domain names
- Foreign Equivalents