

## Lanham Act – Important Sections

- Section 1, 15 U.S.C. § 1051: Actual use and intent to use registration process
- Section 2, 15 U.S.C. § 1052: Bars to registration
- Section 32, 15 U.S.C. § 1114: Infringement of registered marks
- Section 43(a), 15 U.S.C. § 1125(a): Infringement of unregistered marks
- Section 43(c), 15 U.S.C. § 1125(c): Dilution of marks (registered or unregistered)
- Section 45, 15 U.S.C. § 1127: Definitions

## Acquired Distinctiveness of Source

- Rough synonyms
  - Secondary meaning
  - Trademark meaning
  - Acquired distinctiveness
  - Acquired trademark meaning

Imagine a situation in which Company David, after a great deal of market research, adopts an especially good descriptive mark and initiates a small-scale launch of the descriptive mark in the marketplace. Company Goliath then becomes aware of Company David's mark, adopts the mark as its own, and immediately spends enormous resources building up secondary meaning in the mark, so that when consumers see the mark, they think of Company Goliath. Which company should be granted rights in the mark? And is this in your view an equitable or efficient outcome? (Part I, pg. 42)

## Zatarain's, Inc. v. Oak Grove Smokehouse, Inc. (5th Cir. 1983)

- Approaches to determining whether a mark is descriptive (rather than suggestive/arbitrary):
  - Dictionary definition
  - Imagination test
  - Competitive need
  - Third-party uses
- See also TMEP 1209.03

## Frosty Treats Inc. v. Sony Computer Entertainment America (8th Cir. 2005)

- Alleged infringement is use in a video game
- Sony wins by summary judgment that Frosty Treat's mark is generic or descriptive lacking secondary meaning
- Secondary meaning analysis for FROSTY TREAT



Figure 1.



Figure 2.



## Cartier, Inc. v. Four Star Jewelry Creations, Inc. (S.D.N.Y. 2004)

- Discussion of survey evidence as to whether the designs had acquired distinctiveness



## Summary of Distinctiveness Doctrine So Far

- Distinctiveness and the *Abercrombie* spectrum
  - A mark is “distinctive” (of source) if it possesses either “inherent distinctiveness” or “acquired distinctiveness”
    - Inherently distinctive marks consist of suggestive, arbitrary, and fanciful marks.
    - Non-inherently distinctive marks consist of generic and descriptive marks. Descriptive marks may receive protection if they possess “acquired distinctiveness” (i.e., “secondary meaning”).
      - The mark’s “primary significance” is its “secondary meaning” as a designation of source
  - The most important borderlines in the *Abercrombie* spectrum are (1) between generic and descriptive marks, (2) between descriptive marks with secondary meaning and without secondary meaning, and (3) between descriptive marks and suggestive marks
  - Note that the distinctiveness analysis of verbal marks is different in several aspects from the distinctiveness analysis of non-verbal marks
  - Genericness

# Genericness . . .

A NOTE OF INFORMATION AND ENTREATY  
TO FASHION EDITORS, ADVERTISERS,  
COPYWRITERS AND OTHER  
WELL-INTENTIONED MIS-USERS OF  
OUR **CHANEL** NAME.

**CHANEL** was a designer, an extraordinary woman who made a timeless contribution to fashion.

**CHANEL** is a perfume.

**CHANEL** is modern elegance in couture, ready-to-wear, accessories, watches and fine jewelry.

**CHANEL** is our registered trademark for fragrance, cosmetics, clothing, accessories and other lovely things.

Although our style is justly famous, a jacket is not "a CHANEL jacket" unless it is ours, and somebody else's cardigans are not "CHANEL for now."

And even if we are flattered by such tributes to our fame as "Chanel-ismism, Chanel-ed, Chanel and Chanel-ized", PLEASE DON'T. Our lawyers positively detest them.

We take our trademark seriously.

Merci,

**CHANEL**, Inc.

# Genericness . . .

## There are two R's in Xerox.

One is right in the middle. But the really important one is the one you probably never notice. It's the little R in a circle—like the one you see at the bottom of this ad—that tells you that Xerox is a registered trademark.

And it reminds you that our name—which is also our trademark—should only be used in connection with the products and services of our corporation. Including everything from Xerox copiers to information processors to electronic printers.

So as you can see, our trademark is a very valuable one. To us. And to you, too. Because it ensures that when you ask for something you can be sure of what you're going to get.

Of course, we don't expect you to use the second R every time you use our name.

But we do hope you'll give it a second thought.

**XEROX**




If you use "Xerox" the way you use "zipper", our trademark could be left wide open. **There's a new way to look at it.**

No one likes to have their name open to misuse. Which is what happens when you use our name in a generic manner. Basically you're putting it in a compromising position which could cause it to lose its trademark status. That's what happened to the name "zipper" years ago. So when you use our name, please use it as an adjective to identify our products and services, such as "Xerox copiers." Never as a verb "to Xerox" in place of "to copy." Or as a noun "Xerox" in place of "copies." Now that you're aware of all this, that should just about zip things up. Thanks.

**XEROX**

[xerox.com/learn](http://xerox.com/learn) 1-888-488-6888 #ALearn Technology | Document Management | Consulting Services



When you use "Xerox" the way you use "aspirin," we get a headache. **There's a new way to look at it.**

Yes, what a headache! And all because some of you may be using our name in a generic manner. Which could cause it to lose its trademark status the way the name "aspirin" did years ago. So when you do use our name, please use it as an adjective to identify our products and services, e.g., Xerox copiers. Never as a verb "to Xerox" in place of "to copy," or as a noun "Xerox" in place of "copies." Thank you, Now, could your expense be, we've got to get down for a few minutes.

**XEROX**

## Frito-Lay North America, Inc. v. Princeton Vanguard, LLC (TTAB 2014)

- Category of goods: “pretzel crackers”
- Proposed mark is a compound term
- Is a “crisp” a “cracker”?
- Factors and evidence under the factors



## Frito-Lay North America, Inc. v. Princeton Vanguard, LLC, (Fed. Cir. May 15, 2015)

- Compound term proposed as mark versus understanding the term in its entirety
  - TTAB differentiation of compound term versus phrase

Specifically, as explained below, there is no evidence that the Board conducted the necessary step of comparing its findings with respect to the individual words to the record evidence demonstrating the public's understanding of the combined term: PRETZEL CRISPS. By failing to do so, the Board took the type of short-cut analysis we have said is prohibited and ignored evidence that might compel a contrary conclusion (Part I, pg. 78)



# Thermos Survey

- American Thermos Products Co. v. Aladdin Industries, Inc., 207 F. Supp. 9 (D. Conn. 1962)
  - Are you familiar with the type of container that is used to keep liquids, like soup, coffee, tea and lemonade, hot or cold for a period of time?
  - If you were going to buy one of these containers tomorrow— that is, the type that keeps food and beverages hot or cold—what type of store would you select to make your purchase?
  - What would you ask for—that is, what would you tell the clerk you wanted?
    - 75% of approx. 3,000 persons interviewed said “Thermos,” 11% said “Vacuum Bottle” and, as a result of follow-up questions, 12% said they thought that “Thermos” had some trademark significance.
  - Can you think of any other words that you would use to ask for a container that keeps liquids hot or cold?

# Teflon Survey

- E. I. Du Pont de Nemours & Co. v. Yoshida International, Inc., 393 F. Supp. 502, 185 U.S.P.Q. 597 (E.D.N.Y. 1975)
  - I'd like to read 8 names to you and get you to tell me whether you think it is a brand name or a common name; by brand name, I mean a word like Chevrolet which is made by one company; by common name, I mean a word like automobile which is made by a number of different companies. So if I were to ask you, “Is Chevrolet a brand name or a common name?,” what would you say?
  - Now, if I were to ask you, “Is washing machine a brand name or a common name?,” what would you say?
  - [If respondent understands continue. If not understand, explain again.]

# Teflon Survey

When the survey was conducted of 514 men and 517 women on the evening of June 4, 1973, in 20 cities, the results were as follows:

<u>NAME</u>	<u>BRAND/%</u>	<u>COMMON/%</u>	<u>DON'T KNOW/%</u>
STP	90	5	5
THERMOS	51	46	3
MARGARINE	9	91	1
TEFLON	68	31	2
JELLO	75	25	1
REFRIGERATOR	6	94	-
ASPIRIN	13	86	-
COKE	76	24	-

# Lindows . . .

Lindows.com Page 1 of 6

**Lindows.com™**  
The World's Most Affordable Software!

Home LindowsOS Click-N-Run My.Lindows Support Partners News Buy

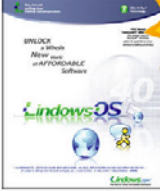
Get LindowsOS Screenshots Licensing Compatibility About LindowsOS FAQs

Search: Warehouse

[Buy LindowsOS 4.0 Now!](#)

**Already own LindowsOS?**  
[Click here](#) to download the latest version of LindowsOS or order it on CD.

**Want to help more? Become a Lindows.com Insider.**  
[Click here](#) to help us change the face of Desktop computing.

 **Includes FREE Bonus LindowsCD**

**LindowsOS 4.0 - \$59.95-~~88~~ US**  
(\$49.95 US - Digital-only Version)

LindowsOS™ is a new, affordable, fun, and exciting operating system that delivers the power, stability and cost-savings of Linux with

[http://www.lindows.com/lindows\\_sales\\_intro.php](http://www.lindows.com/lindows_sales_intro.php) 7/31/2003