

Trademark Law

Prof. Madison

Today: Introduction and big themes

About signs and symbols: what they are, what they do,
why we care



The first
registered TM
in the UK
(1876)



Why does trademark law exist?

It solves problems for society and for firms (in principle, all legal systems and tools within legal systems do this).

What problems does trademark law solve?

Describing and identifying products and services can be complex and time-consuming. Marks are symbols; symbols are simple and fast. Firms / competitors want simple and fast to identify themselves as producers in fair, competitive markets; “consumers” want simple and fast in order to get accurate information; everyone uses simple and fast to speak their mind and be who and what “they” “are”

That gives us overlapping ways to “see” trademark law:

- “Protecting” trademarks’ **symbolic** functions?
- Their **source**-signifying functions and their **brand**-related functions?
- Their **informational** functions?

Elementary trademark “arithmetic”: A trademark is legally valid only if it is **distinctive** *in the minds of consumers* in the context of the phrase “mark **X** for product [service] **Y**”

Compare two meanings of **distinctive**:

[1] Distinctive might mean **between categories**:

Mark X distinguishes product Y from [noncompeting] product Z:
“Coke” is distinctive relative to “Honda”

[2] Distinctive might mean **within categories**:

Mark X distinguishes product Y from [competing] product Y’:
“Coke” is distinctive relative to “Pepsi”

Understanding trademarks as signifiers of source

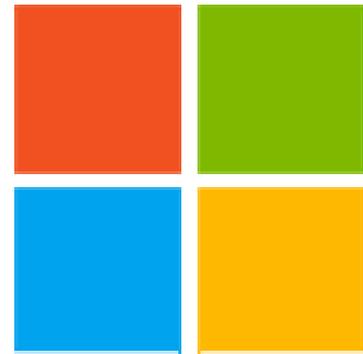
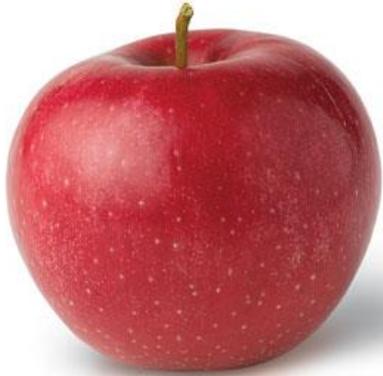
Key phrase: Mark **X** for product [service] **Y**

Key concept: **Distinctiveness** of source [or as to source] of [goods]

What happened to brands? To information? To other sorts of symbolic purposes and uses of trademarks?

Watch for costs and conflicts between “classic” or “core” purposes and uses of trademarks and trademark law (on the one hand) and other purposes and uses of branding and marketing material (on the other hand)

**Distinctiveness and similarity: When and how do marks help
mark owners? consumers? competitors?**



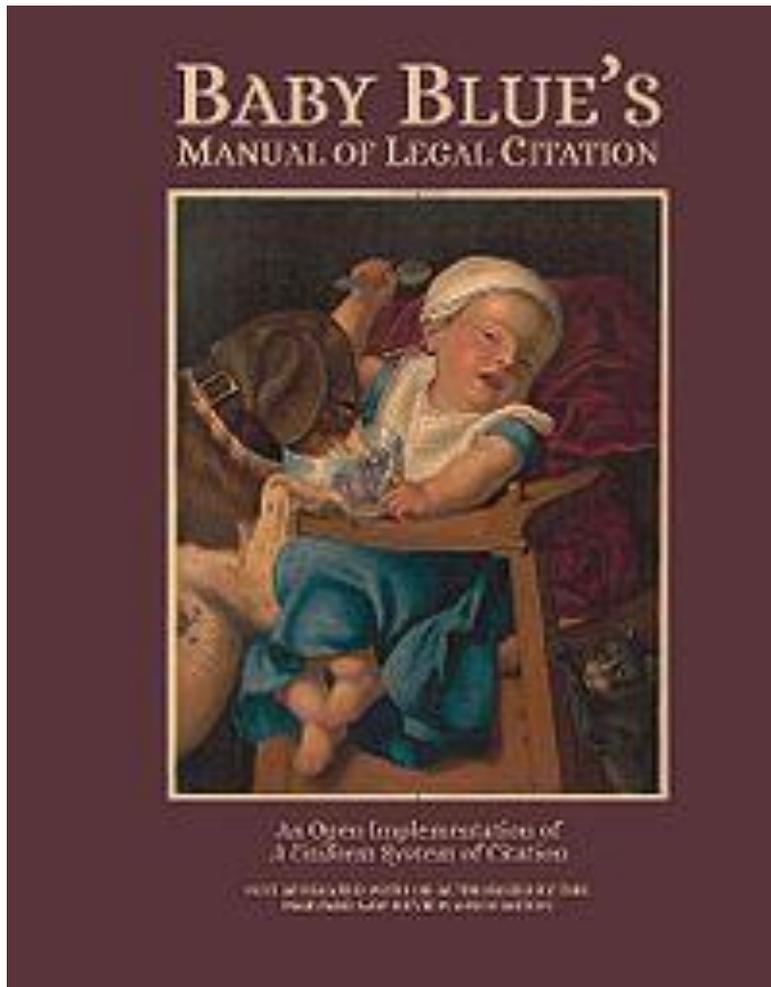


A case study involving a possibly familiar object

Focus on the title and on the design of the object:

What does “the Bluebook” mean to you?

[Note the ® symbol next to “THE BLUEBOOK”]

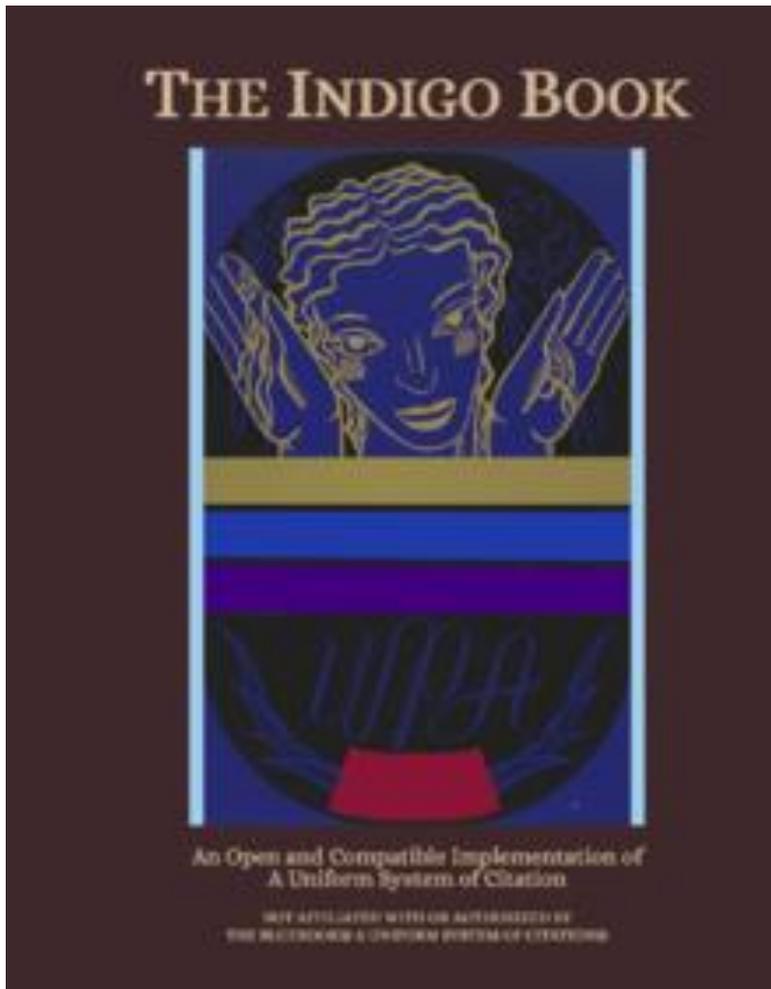


Here is the original name and cover of a **free** alternative to the Bluebook, produced by law professors at NYU, that teaches the ***same*** citation system that appears in the Bluebook (produced by students at Harvard, Yale, Columbia, and UPenn law schools).

The current retail price of the Bluebook is roughly **\$45 per copy**.

Focus on the title and the design of the object.

Should this – the title and cover – be problematic?



Here is the changed, current name and cover.

Should this be problematic? Less so than “Baby Blue”? Why? Why not?

Bonus questions:

How many Pitt Law students were told to purchase the **\$45** Bluebook rather than this free alternative?

Do professors prefer to assign the Bluebook rather than the Indigo Book because of trademark / brand considerations?



What does this logo (trademark) say to the consumer? Who is the consumer?



Looking at this logo, how is Walmart today – the company, as a retailer – the “the same” as Walmart in (1992-2008) (1981-1992) (1964-1981)?

How is it different?

Why did Walmart change the logo?





Walmart is now the biggest seller of firearms and ammunition in America

Imagine that Walmart wants to sue a nonprofit advocacy organization that uses this logo on its website, social media, and other communications?

You are Walmart's lawyer. Would you advise your client to pursue that claim? If so, how? If not, why not?

TACO TUESDAY

FREE-FOR-ALL

Is “Taco Tuesday” distinctive for restaurant services? Was it? Is it generic?



Should Penn State (left image) get a trademark injunction to stop sales of the t-shirt on the right? Why? Why not?

The End



WARNER BROS. - FIRST NATIONAL
PICTURE