

Trademark Law

Prof. Madison

Today: Actionable use as an element of the infringement claim

Key concepts from Class 13:

Common law unfair competition.

Lanham Act Sections 32 and 43: elements of the infringement claim.

Consumer focus.

Under the Lanham Act, building on the Restatement of Torts and Restatement of Unfair Competition), older unfair competition concepts and older technical trademark concepts are blended:

1. Section 32 (registered marks):

(1) Any person who shall, without the consent of the registrant —

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark **in connection with the sale, offering for sale, distribution, or advertising of any goods or services** on or in connection with which such use is **likely to cause confusion, or to cause mistake, or to deceive**; ...

2. Section 43(a) (unregistered distinctive marks, unfair competition):

(a) (1) Any person who, **on or in connection with any goods or services, or any container for goods, uses in commerce** any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—(A) is **likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person**, ...

Elements of the claim: To win their case, plaintiffs must plead, then prove, all 4 elements of a valid claim for relief.

1 - Ownership of a valid mark (*X for Y; don't forget: primary significance of the mark in the minds of consumers is distinctiveness as to source, a/k/a goodwill*)

2 - Use of the mark by the **defendant(s)**

3 - In a way that violates a TM entitlement (passing off, appropriation of goodwill, likelihood of confusion, dilution)

4 - Harm (?) (*TM blends (i) tort / unfair competition law & (ii) property-ish concepts*)

Recall: aspects of “use in commerce” in TM generally:

1. Congressional **jurisdiction to enact TM law**: Commerce clause
2. Establishing **ownership** (who is the “user”?)
3. Establishing **priority** (scope of actual use for common law rights; actual or constructive use for rights under federal registration)
4. Determining whether a mark has been **abandoned** (when does “use” stop?)
5. Determining types of **actionable use (i.e., use by a deft that gives rise to liability for infringement)**
 - Did the defendant “use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services...” (“...on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive”)?

Element one of the case for likelihood of confusion:

Plaintiff must allege and prove that the defendant used the plaintiff's mark in commerce.

Does “use in commerce” by the defendant mean:

- (1) Use *in commerce* (cf. Section 45);
- (2) Use of the mark *as a mark* (as an indicator of source of goods/services);

And/or

- (3) Use of the mark *commercially* (to offer/sell goods or services for money)?

GOODYEAR



Has the plaintiff adequately alleged use of the mark in commerce? *Goodyear Tire & Rubber Co. v. The Pimps* (October 2019)

37. *The use by Defendants of the GOODYEAR Marks in connection with providing musical entertainment services, on props in providing those services, in promoting its services and in merchandise that it is selling bearing those marks, are a reproduction, counterfeit, copy, and/or colorable imitation of Goodyear's federally-registered mark.*

Litigated questions of “use in commerce” in the context of “likelihood of confusion”:

The defendant might argue:

- “We did not use the plaintiff’s mark as a mark, that is, as an indicator of source” (“**trademark use**”) (rarely litigated; even less often successful in defense – but it may be coming back, under the *Jack Daniel’s* opinion – see Class 24)
- “We did not **use** the mark at all; we built a business ‘around’ the mark” (occasionally litigated; more often seen simply in practice)
- “We did not use the mark **commercially**” (*Radiance Foundation, Inc. v. National Association for the Advancement of Colored People*)

“Use” of a trademark *as a mark*, illustrated:

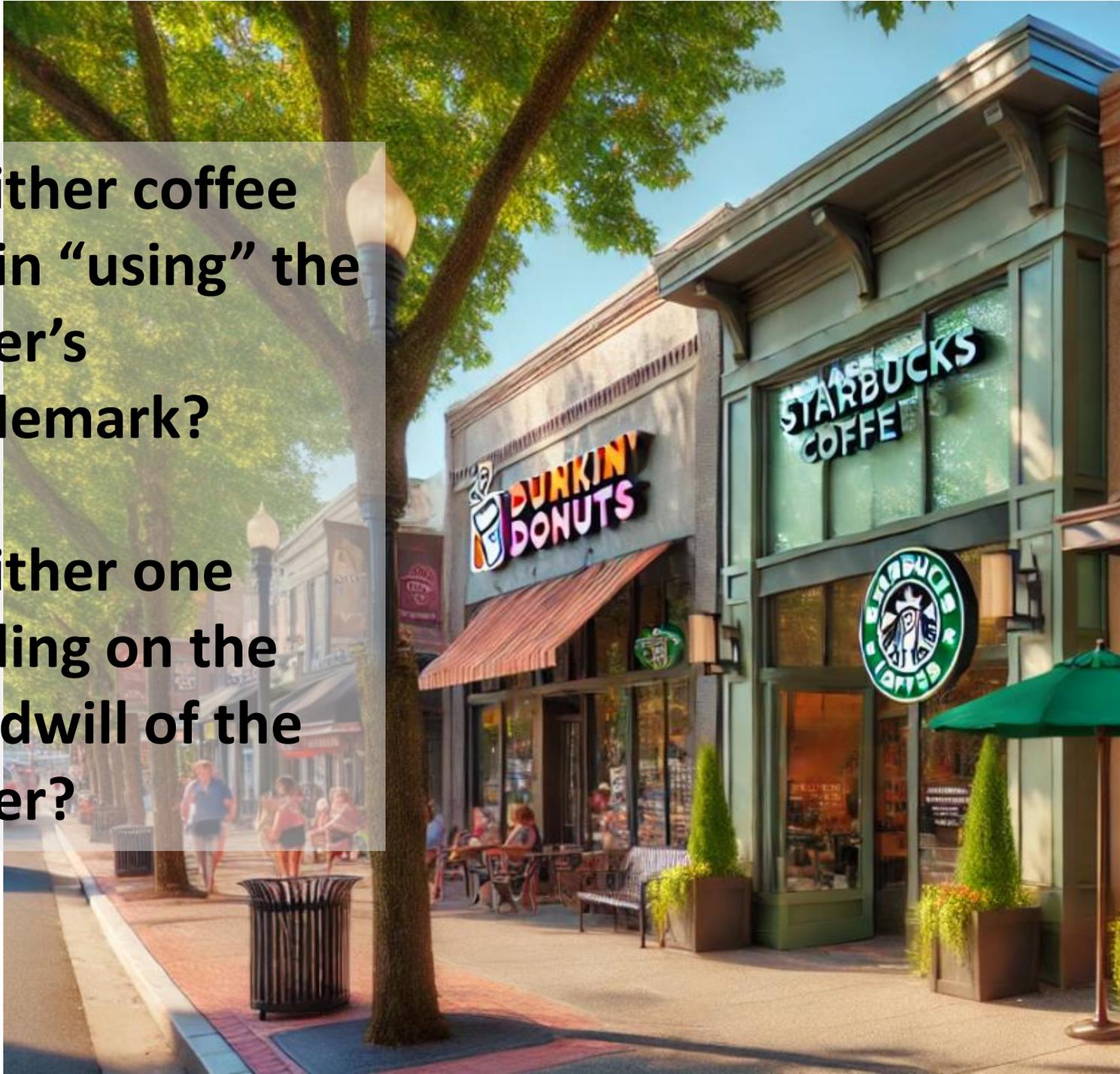
Arsenal Football Club v. Reed (Court of Appeal UK 2003):

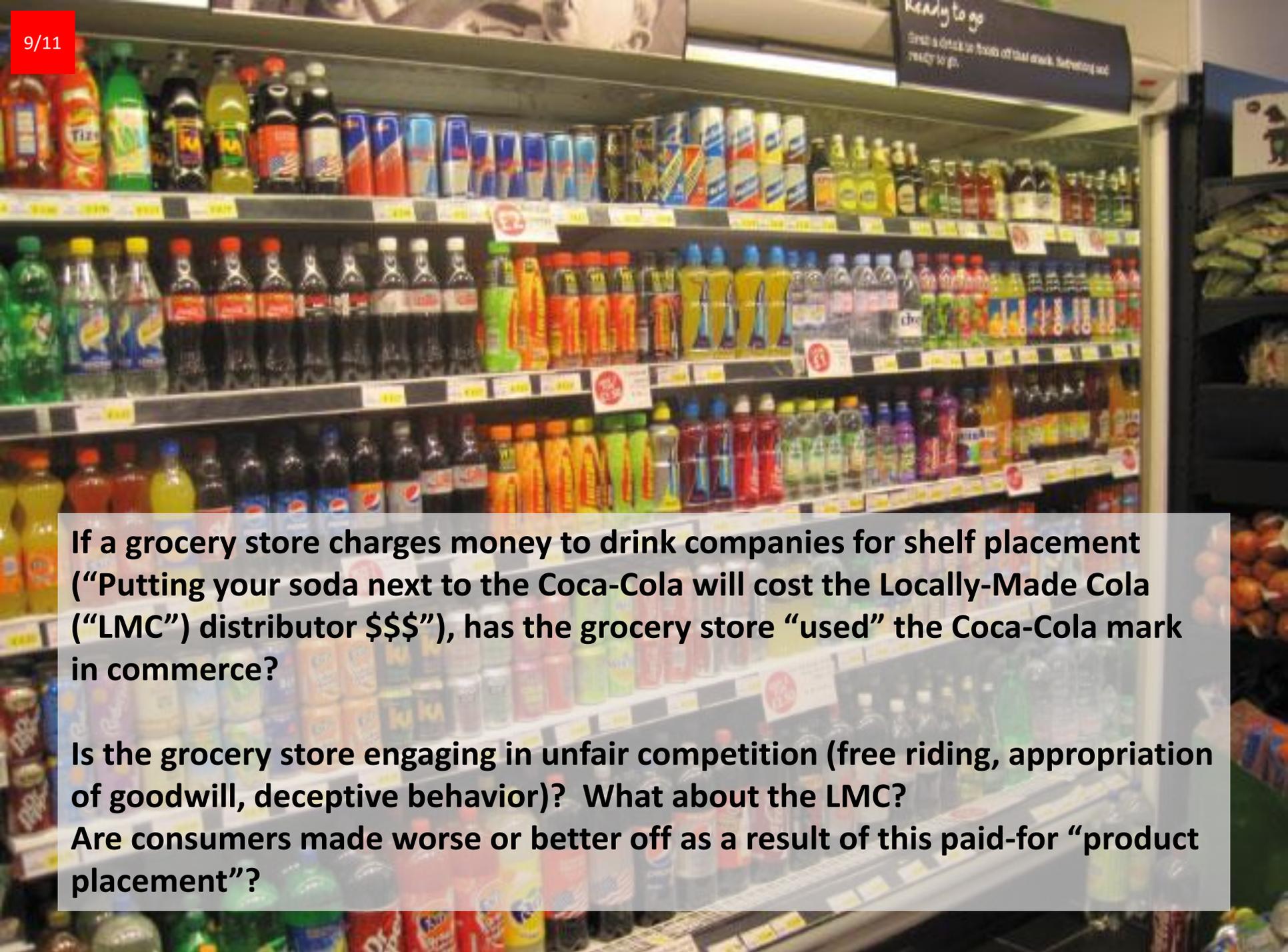
Laddie, J.: No; the marks would be perceived by consumers as badges of support, rather than as indicators of source
 European Court of Justice:
Reversed! The defendant used the plaintiff’s mark in the course of trade and in a way that affected its status as a mark, that is, as a guarantee of origin.



Is either coffee chain “using” the other’s trademark?

Is either one trading on the goodwill of the other?





If a grocery store charges money to drink companies for shelf placement (“Putting your soda next to the Coca-Cola will cost the Locally-Made Cola (“LMC”) distributor \$\$\$”), has the grocery store “used” the Coca-Cola mark in commerce?

Is the grocery store engaging in unfair competition (free riding, appropriation of goodwill, deceptive behavior)? What about the LMC?

Are consumers made worse or better off as a result of this paid-for “product placement”?



In online advertising, Google pioneered the practice of keyword sales, meaning charging companies for the power to have a word (possibly a word covered by a trademark registration) associated with certain search results. The technology changed over time, but trademark owners objected to “their” words being sold by Google.

**Plaintiff: 1-800-HOLIDAY (unregistered)
[1-800-4654329]**

Defendant: 1-800-4054329]

Court: Even if the Plaintiff’s phone number is a protected mark, Defendant did not use that mark in commerce.

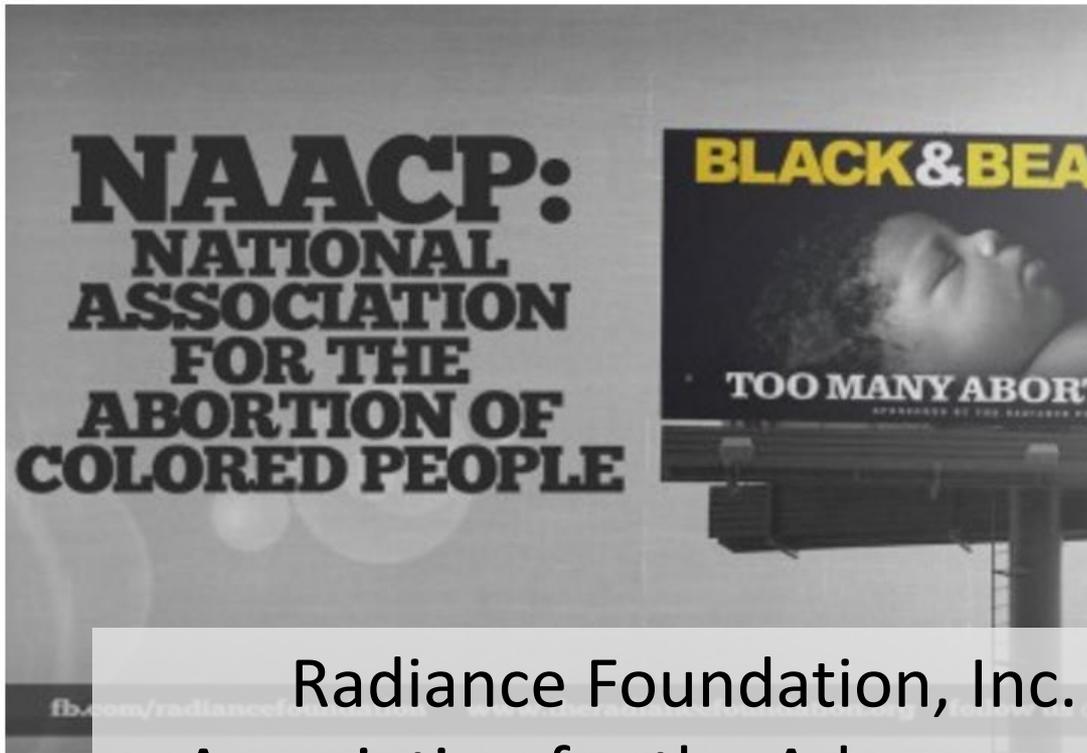
**Holiday Inns, Inc. v. 800 Reservations, Inc.
(6th Cir. 1996)**

DONATE



NAACP: National Association for the Abortion of Colored People

OPINION RYAN BOMBERGER JAN 16, 2013 | 11:45AM WASHINGTON, DC



CLICK HERE TO SIGN UP FOR PRO-LIFE NEWS

f t r e

ADVERTISEMENT

— ADD YOUR NAME TO —

END ABORTION

HUMAN COALITION

ADVERTISEMENT

A CONTEMPTIBLE Attack on **MARY**

visitors of Estonia National Shrine of Grace over and over again!

Radiance Foundation, Inc. v. National Association for the Advancement of Colored People (4th Cir. 2015)

1.3K

KISS ME KATE

THE END



MADE IN HOLLYWOOD, U.S.A.

BY
Metro-Goldwyn-Mayer