

# Trademark Law

Prof. Madison

**Today: Open-ended questions about trademark law and policy, based on the readings and lectures so far**

**Key concepts from Class 17:**

Trademark owners get to choose their remedies.

Equitable vs. legal remedies.

Registration has remedial virtues!

Be strategic. Look to the Lanham Act and beyond

## One

Go into your kitchen or bathroom and do a “trademark audit.” List at least 10 products and classify their names according to the four categories of trademark “distinctiveness.” Then classify their logos and slogans (if any) in the same way. Finally, classify their shapes and designs.

## Two

Find a product—in or out of your home or living space—that (a) has the ® symbol indicating a registered mark and (b) seems “descriptive.” Go to the USPTO Trademark Search Page ([tmsearch.uspto.gov/](https://tmsearch.uspto.gov/)) (Click the TSDR button and the “Documents” tab to see the details.) Be sure to consider in advance whether you are examining a “word mark,” a “design mark,” or something else. Did the PTO agree with you? How was the mark registered?

## Three

A client has come to you for legal advice in connection with setting up what the client calls a rollerblading rental business on Venice Beach in Southern California.

You can handle the business basics with relative ease – entity formation, registration of the business name, banking arrangements, employee agreements, compliance with state and local labor and tax laws and so forth.

But the reference to “rollerblading” nags at you. You do some brief research at the USPTO and learn that “Rollerblade” is a registered trademark. What do you do next, and why?



*“Ah, Venice!”*

## Four

You're a junior lawyer in a large law office whose client, Alan Turning, is the brilliant computer scientist behind a new program known as Faceplant.

Mr. Turning is a long-time vocal critic of Facebook, the social network site. He believes that its privacy practices are poor and less than transparent, that it imposes on its users a tightening spiral of narcissism and withdrawal from the "real" world, and that its network structure and architecture is overly controlling and anti-competitive. ... Mr. Turning believes that Facebook is trying to replace the "open" structure of the World Wide Web with its own carefully controlled gated community, from which competitors or rivals can be excluded. His saying, "Their goal is to be the last social network!" has become something of a rallying cry for Facebook's critics.

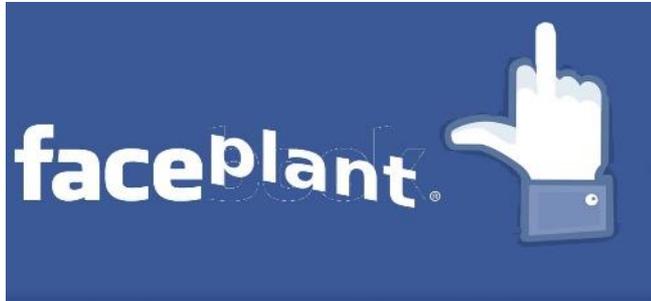
## Four

Mr. Turning's solution was to create an app called Faceplant that he claims would restore "control of privacy to the user and control of competition to the free market." Mr. Turner is giving the app away for free, but he does make a considerable amount of money from advertisements seen by the millions of users flocking to his website, Faceplant.com.

Mr. Turning's program simplifies the process of selecting and fine-tuning one's privacy preferences by automating the process of jumping through Facebook's cumbersome sets of menus. It also "nags" users if they stay on Facebook for too long, sending messages such as "Enough with the profile tweaks!" "Only losers stalk their high school boyfriends!" and "It's Spring! Go for a walk outside!" Finally, the program "unlocks" Facebook's integration with other apps, so that users can use any app or play any game "inside" Facebook, not merely those approved by the Facebook app store. Mr. Turning made clear by both the name of his program and the logo he selected that his product was critical of Facebook. He claimed that the name "Faceplant" was designed to highlight two of his criticisms – that users become effectively unconscious because of Facebook's influence ("doing a faceplant" is a slang expression for falling rapidly asleep) and that they turn away from more imaginative engagement with forms of culture such as books, into vegetative recipients of manipulative advertising, mere "plants."

## Four

Both Facebook's name and its original logo have been registered on the Principal Register since 2005. The logo is shown at right, below.



Mr. Turning's logo for Faceplant, shown at left, above, is based on a modification of that image to send a very different message.

Your firm's standard business strategy for new clients includes applying to register their business name and logo as trademarks with the USPTO. Along with the application, the firm customizes its confidential advice to the client about the virtues of registration, to include appropriate guidance about the likelihood of being able to register the marks, including the character of possible opposition arguments (sources, bases in law, strengths and weaknesses) and the likelihood that the mark will be enforceable in the context of future disputes, whether or not it is registered successfully. The partner you work for has asked you to prepare a sketch of this customized advice that the partner will deliver to Mr. Turning. **Prepare that advice.**

BYE!

