Trademark Law

Prof. Madison

Today: Distinctiveness

Key concepts from Class 2:

Legal rules and concepts as tools for problem solving.

Mark X for Product (Service) Y.

Distinctiveness.

Goodwill.

Abandonment.

“Naked” licensing; assignments “in gross.”

University of Pittsburgh
School of Law

(Things may or may not have more than one name.)

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

A problem (or two problems?):

- You are A&F. You sell this jacket. What do you call the jacket (what TM do you pick?)
- You compete with A&F. You sell jackets like this one. What do you call your jacket?

How to solve it:

- How does *distinctiveness of the mark* help?
- How is distinctiveness determined?
- What facts / evidence matter?

Imagine TM law as framed by a hypothetical lawsuit.

That's the logic of a standard or typical TM-based argument.

Plaintiffs must plead, then prove, elements of a claim for relief:

[1] Ownership of a valid mark (*X for Y; don't forget: goodwill*). *What's the mark? Is it valid?*

[2] Use of the mark by the defendant(s). *How did the defendant use the mark?*

[3] In a way that violates a TM entitlement (passing off, appropriation of goodwill, likelihood of confusion, dilution) *What facts support the claim of infringement?*

[4] Harm (?) (*TM blends (i) tort / unfair competition law & (ii) property-ish concepts / mis-appropriation*) Is there harm/damage/loss *other than the infringement itself? What's the evidence?*

Trademark lawyers are planners and builders, not only litigators.

All hypothetical TM lawsuits are business deals (licenses, assignments) waiting to happen, or that could happen. So: re-imagine TM law as a set of tools for building, not suing.

Who uses TM tools? I.e., develops marks, "brands" [image/ reputation, which may/may not build on specific marks], portfolios of marks.

- Incumbents (licensors/plaintiffs?).
- Competitors (including challengers to incumbents; defendants?).

Who also relies on TM tools?

- Vendors/partners/distributors allied with incumbents.
- Consumers.
- Critics / citizens.

[1] If GOODWILL is one essential anchor for trademark law and policy, then the MARK itself is its essential partner.

[2] Start exploring trademark law and practice (law, business, and culture) by asking: what is the mark?

[3] Is it a mark at all? What is a mark? See the Lanham Act § 45.

[4] Next: Is a given mark valid and enforceable? Why/how, or why not/how not?

[4] Only "distinctive" marks are valid and enforceable under the Lanham Act. (Remember to ask yourself: why does the law focus on "distinctiveness"?)

The general rule: Mark X is valid relative to product / service Y if it is distinctive as to the source of Y in the minds of consumers.

[1] "Distinctive" means: Consumers are likely to believe that products/services bearing the X mark are produced/sponsored by a common source, even if they don't know the identity of that source. The mark distinguishes the product/service from others in the same market/sector, and from other markets/sectors.

[2] Do not say/write "distinct." Talk/write like a trademark lawyer.

[3] "Distinctiveness" is a common law concept that is now embedded in the Lanham Act, § 45 (15 U.S.C. § 1127) ("any word, name, symbol, or device" etc.).

[4] Distinctiveness is both a binary (the mark is distinctive, or it is not) and a range (distinctive marks may be stronger or weaker).

[5] The *scope* of validity of the mark (broad/narrow) is linked to the *scope* of liability for infringement (broad/narrow) for use that is "likely to cause confusion, or to cause mistake, or to deceive." *See* Lanham Act, § 32 (15 U.S.C. § 1114) (for marks that are registered); Lanham Act, § 43(a) (15 U.S.C. § 1125) (for marks that are not registered). Strong marks are more likely to trigger valid claims for infringement. *Why? Is that backward?*

Taxonomy of Distinctiveness Under the Lanham Act

(summarized in *Abercrombie & Fitch Co. v. Hunting World, Inc.* and known as the *Abercrombie* spectrum)

Generic

Descriptive without "Secondary Meaning"

INTERNET ARCHIVE

"Acquired Distinctiveness"*

Descriptive with "secondary Meaning"

AmericanAirlines

"Inherent Distinctiveness"

Suggestive

Coppertone

AMTRAK

Arbitrary

Apple

CAMEL

Fanciful

iORMYX

acela

INTERNET ARCHIVE
WayBackMachine
??

Ineligible for protection

(**Generic marks** describe the type or class of goods/services rather than the source of a specific good or service and are incapable of being distinctive.)

(**Descriptive marks** describe some feature(s) or function(s) of the goods and are capable of becoming distinctive.)

= "eligibility for trademark status and the degree of protection accorded"

[* Recognized for the first time under the Lanham Act]

[source for this slide: Barton Beebe, NYU Law]

Both trademark law and marketing strategy encourage distinctiveness (trademark) and product differentiation (branding).

But a small number of companies control the vast majority of consumer brands.

Consumers can be overwhelmed by choices among products with minimal differences.

Does trademark law *cause* consumer confusion?

Does it hinder us from understanding the scale of economic concentration in the marketplace? Is that bad?

The *Abercrombie* spectrum should be turned into a tool, for lawyers and judges, for *classifying* marks.

Using the tool requires gathering relevant facts. Ask questions.

Which ones? TM law and policy tell you.

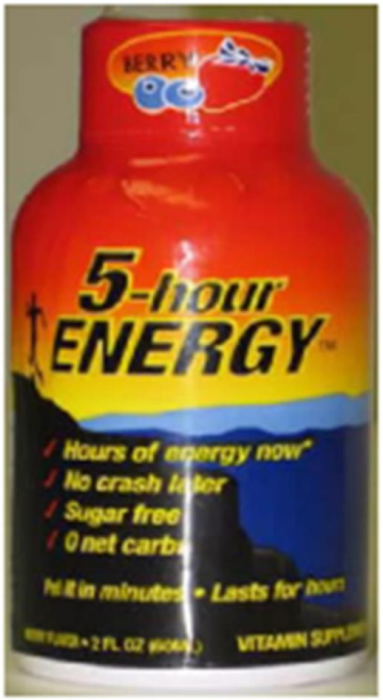
[1] Ask - basics: What is the mark [X]? What type of mark is it (word mark, design mark, combination mark, other)? What is the product/ service [Y]? Are these [the mark and the product] the same, different, or related in some respect(s)?

[2] Ask - context: What is the problem to be solved by finding a valid mark (or not)?

- A consumer problem (do consumers need help – in the form of a distinctive mark – in searching for or identifying relevant products)?
- A producer problem (do producers need help – in the form of a distinctive mark – in recouping the costs of investing in goodwill, or excluding competitors)?

[3] Ask - evidence: What evidence exists relative to the questions that the court asks in *Zatarain's*? In *Innovation Ventures*?

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



Innovation Ventures, LLC v. N.V.E., Inc. (6th Cir. 2012)

Classification exercise:

Analyze 

for syringes.

Ask - context: What problem is the company trying to solve?

What steps should a lawyer or fact-finder (court, Trademark Office) follow to determine whether the mark is distinctive?

Step 1: What is the mark? (Hint: it is a design mark).
Step 2: Analyze the mark for distinctiveness via the *Abercrombie* spectrum.

How do you do Step 2?
Use the facts. Ask: What do you know? What do you need to know? Ask: How is the product used? How is it advertised? How do consumers learn about it? Choose it?

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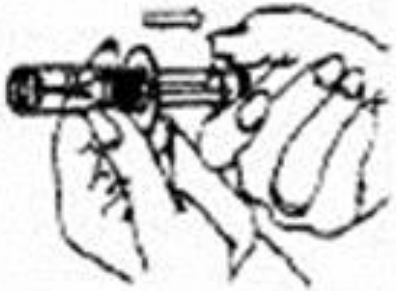
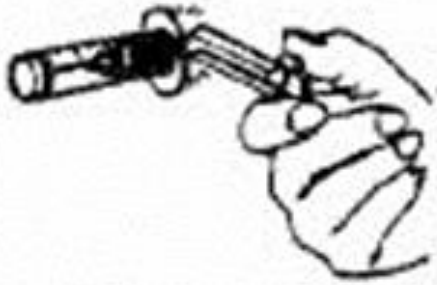
To disable:

1. Rotate plunger clockwise to release needle.



2. Pull plunger back fully watching needle retraction



3. Snap off plunger. Dispose safely.

Litigation assessment exercise:

"Boston Duck Tours" (the original operator) vs. "Super Duck Tours" (an upstart rival operator)

Ask: What problem is the (plaintiff – BDT) trying to solve? What's the mark? What's the product/service? How strong is the plaintiff's mark?

Today: Duck boats

Original "DUKW" ("duck") vehicle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THE END
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