

# Trademark Law

Prof. Madison

**Today: Acquired distinctiveness**

**Key concepts from Class 3:**

Legal rules and concepts as tools for problem solving.

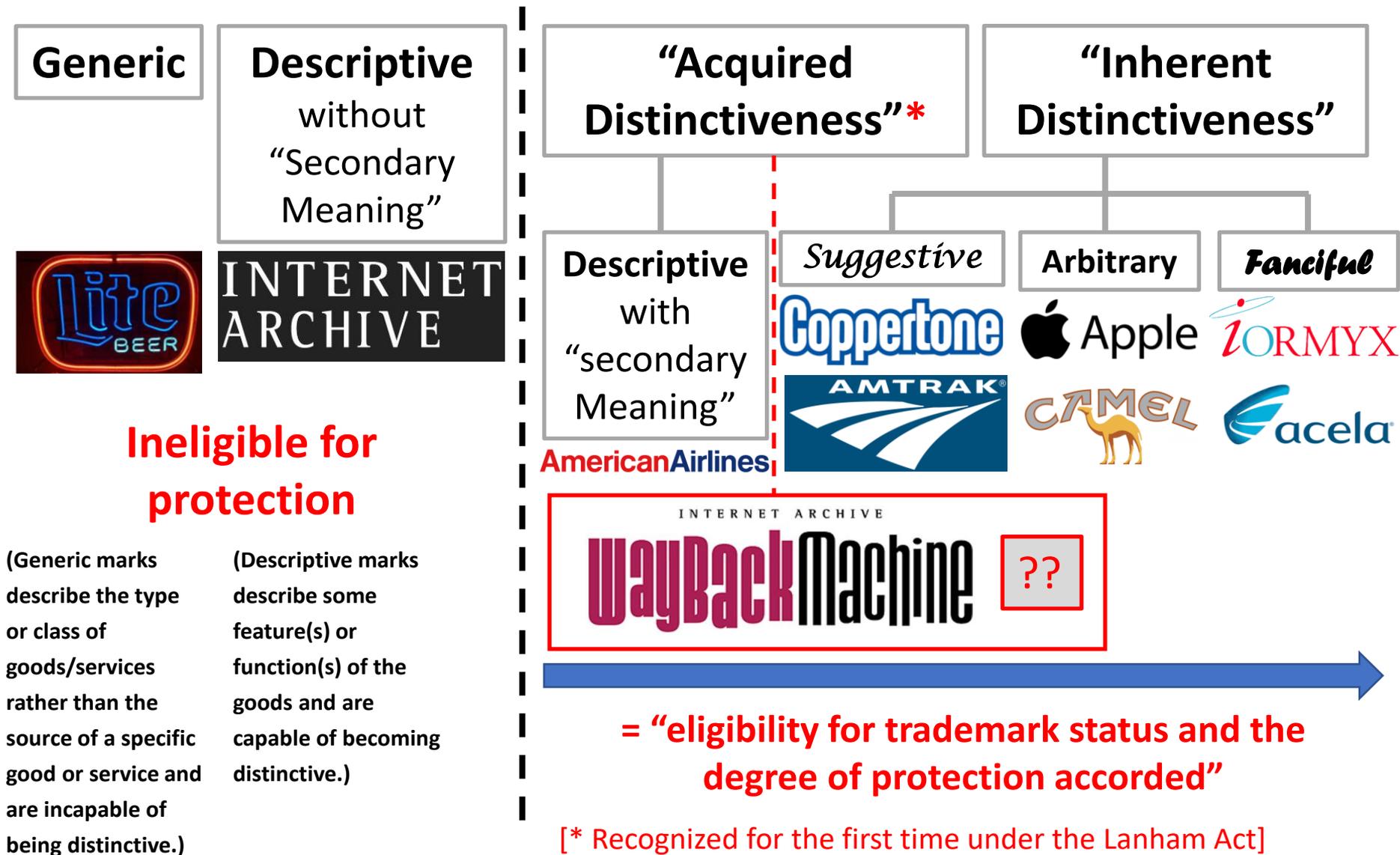
Mark X for Product (Service) Y.

Lanham Act and combination of common law and statutory concepts; tort law and property law.

The *Abercrombie* distinctiveness spectrum.

# Taxonomy of Distinctiveness Under the Lanham Act

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

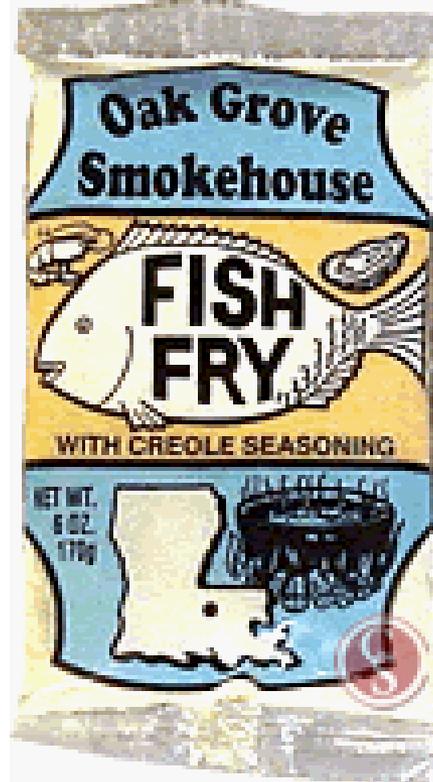


= “eligibility for trademark status and the degree of protection accorded”

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

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

The line between *descriptive marks* (not valid or protected unless secondary meaning / acquired distinctiveness is shown; consumer goodwill must be built) and *suggestive marks* (automatically valid because inherently distinctive; consumer goodwill is assumed):



Types of questions/types of evidence that may be relevant to applying the *Abercrombie* spectrum:

1. Dictionary definition
2. Imagination test
3. Competitive need
4. Third-party uses

## “Choose a mark” exercise:

**Winemaking client located in Breckenridge, Colorado (a ski resort town) asks: For the wine, should we choose**

- Breckenridge Winery *or*
- Mountain Winery at Breckenridge *or*
- Breckenridge Mountain Winery *or*
- ??

**In each case, why or why not?**

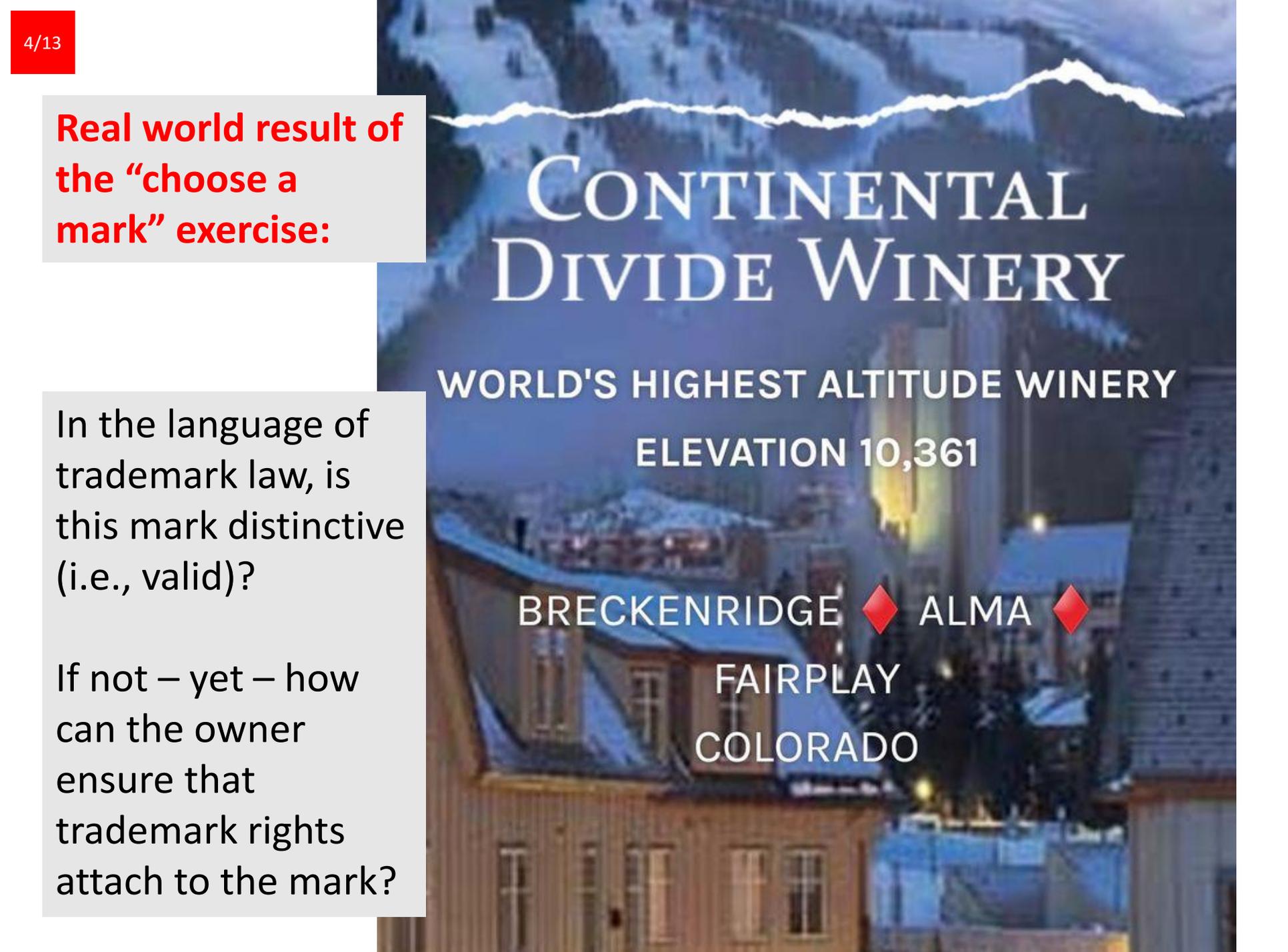
**What questions do you ask the client?**

**Remember: TM basics (mark; type of mark; classification; product(s)); context; evidence)**

**Real world result of the “choose a mark” exercise:**

In the language of trademark law, is this mark distinctive (i.e., valid)?

If not – yet – how can the owner ensure that trademark rights attach to the mark?



# CONTINENTAL DIVIDE WINERY

WORLD'S HIGHEST ALTITUDE WINERY

ELEVATION 10,361

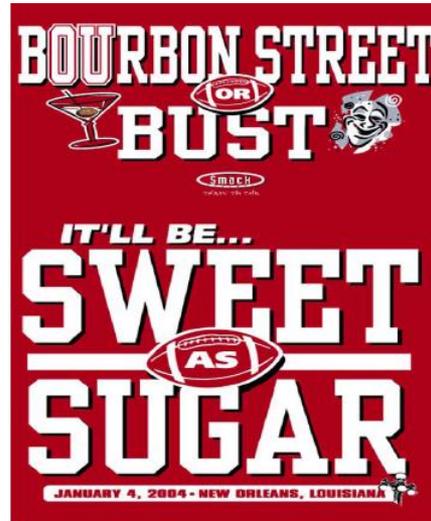
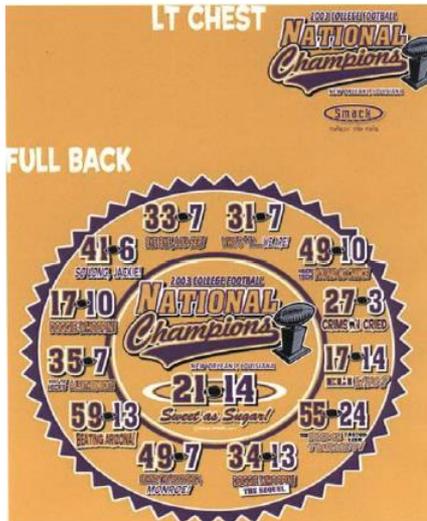
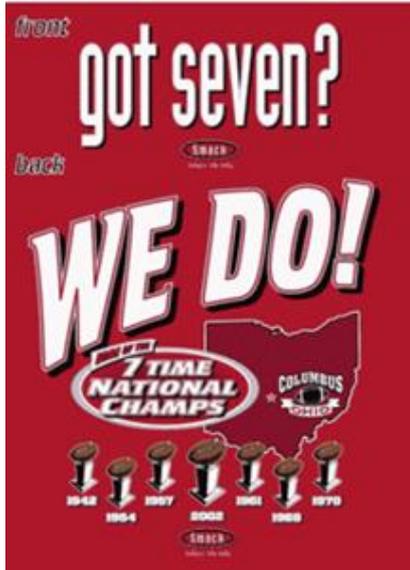
BRECKENRIDGE  ALMA 

FAIRPLAY  
COLORADO

The line between *descriptive* marks that lack secondary meaning (not valid or protected) and descriptive marks that have developed secondary meaning (valid and protected because they have *acquired distinctiveness*).



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



Are the **design marks [color combinations]** valid?

**[1]** Are they marks? Focus on the colors: are they *capable of indicating the source of goods/services?*

**[2]** Classify the marks, using factors and evidence going to *acquired distinctiveness*:

- Producer investment (time, ad \$\$, sales success)?
- Consumer/ competitor use / reliance/ opportunity / need?

Board of Supervisors for Louisiana State University Agricultural & Mechanical College v. Smack Apparel Co.  
(5<sup>th</sup> Cir. 2008)

**Do these colors indicate the source of  
(educational) (athletic) goods/services?**



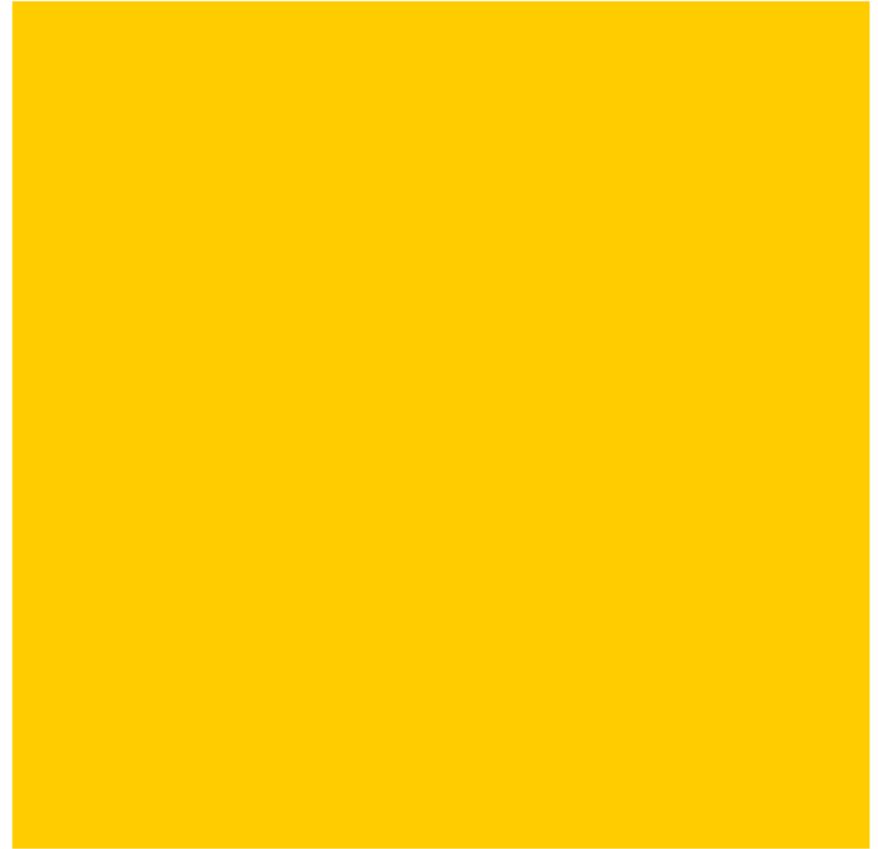
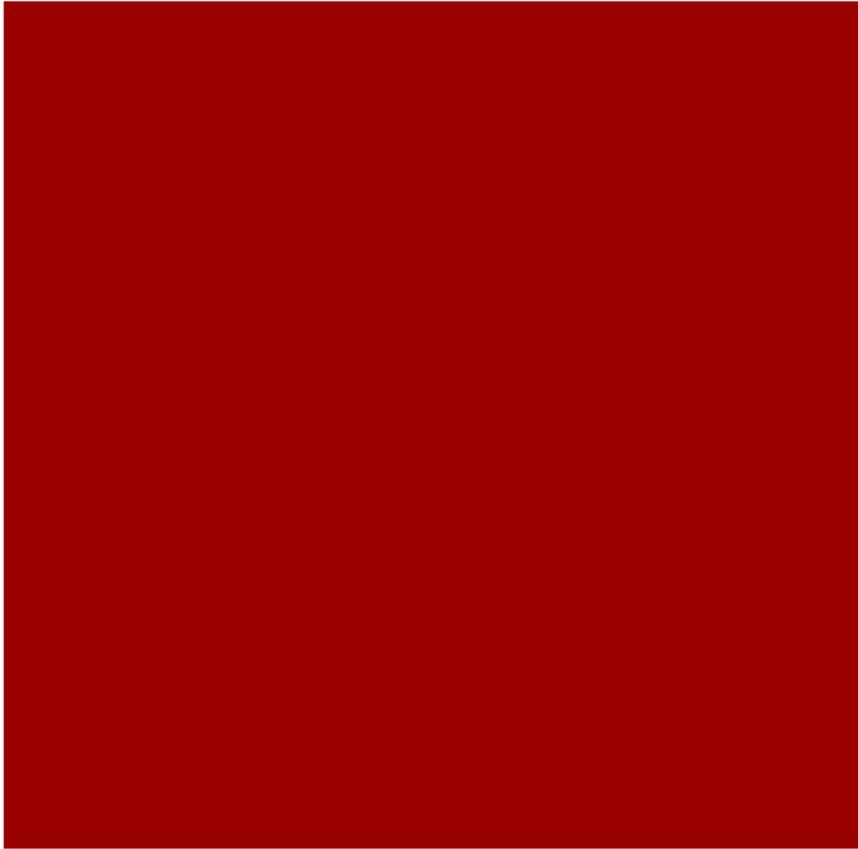
**(Bonus, though not required for TM validity)  
Can you name the college/university?**

**Do these colors indicate the source of (educational) (athletic) goods/services?**



**What evidence/data do you need to establish that the colors are source-indicating?**

**Do these colors indicate the source of  
(educational) (athletic) goods/services?**



**Can you name the college/university?**

## Primary Brand Colors

The official colors, USC Cardinal and USC Gold, are of equal importance as a brand element.



**USC Cardinal**



**USC Gold**



## Timing and Identity problems with distinctiveness

Trademark is a *first in time* system among firms competing to use the same mark. The first to achieve “distinctiveness” usually wins. But “first” is fragile.



“**Red for staplers**”: created for “Office Space” as a **film prop, 1999**, but not offered for sale. Produced and **sold by fans, 1999-2002**. Then manufactured by **Swingline** in **2002**.

**Hypo:** The “Fun Stapler Co.” starts selling a red stapler in **2001**. Does Swingline have a strong trademark lawsuit against that company? Why? Why not? What questions do you ask?

**Generic marks:** describe a type of thing (or service) rather than the thing itself; granting TM rights would deprive competitors of an essential marketing/identity device, because consumers rely on the generic category.

**Once generic, always generic.** That's the general rule. Is the mark generic now, even if it was distinctive at some point in the past.

**Ask** “what do consumers believe the product / service is? Is the mark source-indicating *to them?*”

**Is “Booking, Inc.”  
distinctive? Generic?**

USPTO v. Booking.com B.V.  
(Supreme Court, 2020)

## If “Booking, Inc.” is – we believe – generic, then what’s different about “Booking.com”?

**In this case:** Right outcome, wrong reasoning?

**Majority** (Ginsburg, J.): TM validity is completely separate from TM scope (proving infringement). TM validity depends 100% on consumer perceptions. *Seems wooden.*

**Dissent** (Breyer, J.): Appropriate to worry about anticompetitive implications of TM validity; i.e., validity and scope are linked, or should be.

Can we construct a more persuasive argument to justify the Court’s result?

The logo for Booking.com, featuring the word "Booking" in white and ".com" in light blue, set against a dark blue rectangular background.



# The End

COPYRIGHT MMXVI SUMMIT ENTERTAINMENT, LLC. ALL RIGHTS RESERVED.