

Trademark Law

Prof. Madison

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

Key concepts from Class 7:

Legal rules and concepts as tools for problem solving.

Mark X for Product (Service) Y.

Bars to protection.

Aesthetic functionality.

Distinctiveness analysis (eligibility for TM protection) and **bars to TM protection (including functionality)** as two versions of the same policy questions:

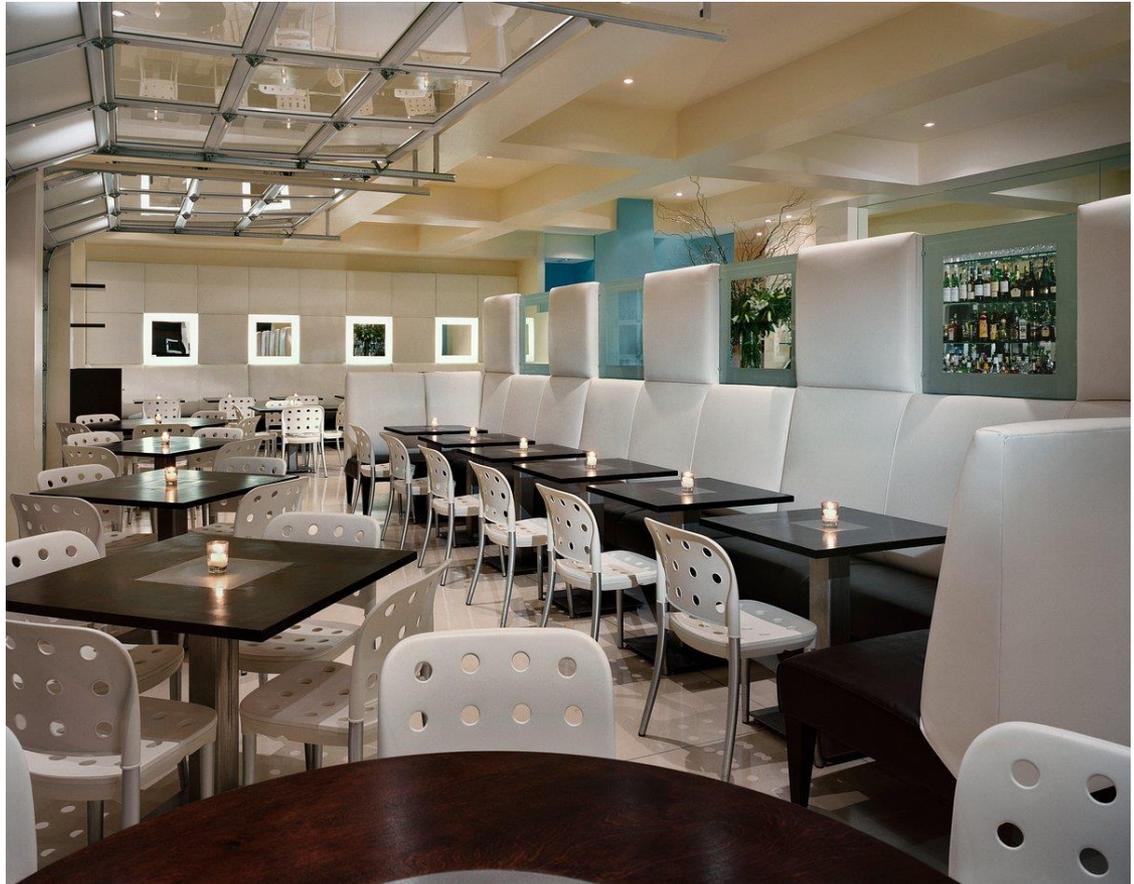
1. Protect new competitors (*right to copy* reasoning)
2. Channel innovation into the right IP category (patent, trademark, copyright have their distinct policy balances)
3. Protect consumer interests in accurate search
4. Protect producer investments in goodwill

Rule: *Deceptive* marks cannot be registered, under § 2(a)

Is the mark “**Cafeteria**” for restaurant services other than cafeteria-style restaurants unregistrable because it is **deceptive** (§2(a)), or **deceptively misdescriptive** (§2(e)(1))?

CAFETERIA open 24 hours a day • 24/7 • seven days a week
YOU ARE. YOU EAT.

VENUE IMAGES



Rule: *Primarily geographically deceptive and geographically misdescriptive* marks cannot be registered, under § 2(e)



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ALASKA MILK CORPORATION

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Wala pa ring tatalo sa ALASKA!

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ALASKA ACE

ALASKA POWER CAMP

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A dairy dose of delight

A collection of pleasing evaporated milk and condensed milk recipes to try.

Is the mark
“Alaska”
registrable for
dairy
products?

Rule: Marks that falsely suggest a connection with living or dead persons, institutions, beliefs, or national symbols cannot be registered, under § 2(a). Also, § 2(c) for a mark that consists of living person's name, that person's written consent must be filed.

During Arnold Palmer's lifetime, could a beverage company register the mark "**Arnold Palmer**" for a drink that blends iced tea and lemonade – without Arnold Palmer's written consent? (Obviously not.)

Arnold Palmer died in 2016.

Today, could a company register the mark "Arnold Palmer" for a drink consisting of lemonade and iced tea (an "Arnold Palmer")?



Marks that

- “may disparage” persons, institutions, beliefs, or national symbols or “bring them into contempt, or disrepute,” and
- comprise “scandalous matter” and
- comprise “immoral” matter ... may be registered.

The statutory bar has been held to be unconstitutional under the First Amendment.

- *Iancu v. Brunetti* (U.S. 2019) (“FUCT” for apparel)
- *Matal v. Tam* (U.S. 2017) (“The Slants” for entertainment, specifically music)

More later on free expression and trademark law ...

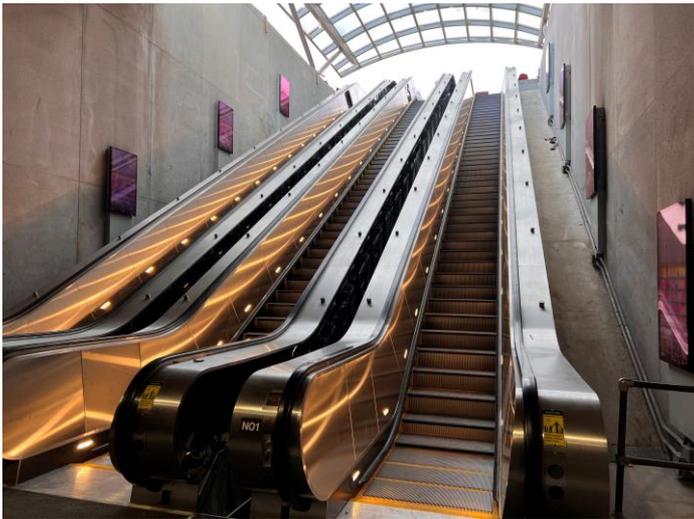
One

Given public policy tensions between the “unfair competition” roots of trademark law and the theory that trademarks are intended to facilitate efficient producer-consumer information flow, how should a trademark lawyer advise a trademark owner client seeking to enforce a trademark against a business operating in a **different** market?

E.g.: “Monster” Energy drinks v. Pokémon [“pocket monster”] games.

Two

Do you agree that genericide best explains the loss of rights to a novel, invented term—Escalator, Thermos, Aspirin? What other explanations might be better?



“Escalator” was a mark registered by Otis Elevator Co.

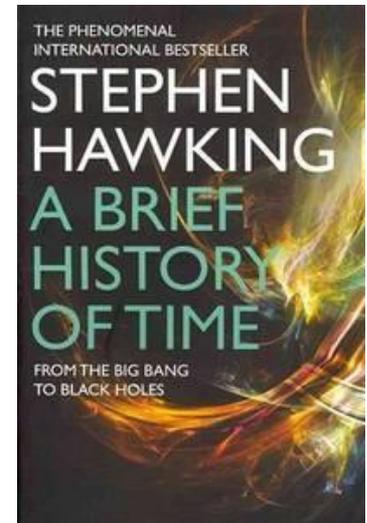


“Thermos” (also the name of the company) and “Aspirin” are registered marks in some other countries, but not in the US.



Three

Unlike patents and copyrights, trademarks can (so long as continually used and renewed) last for an unlimited period of time. Why? If your answer is that the U.S. Constitution requires that copyright and patent be for limited times, why do we also find that difference in other countries not bound by the U.S. Constitution?



Four

Critics of “brand fetishism,” such as Naomi Klein, author of *No Logo*, argue that we define ourselves in terms of brands (both those we accept and those we reject), that we obsess about the messages that come with these symbols, and that the public space for debate, self-definition and meaning is increasingly privatized via trademark law (and contract, and copyright, and other legal systems). The social harms attributed to this process range from thefts or crimes of violence to acquire favored status symbols such as branded jackets or shoes, to the claim that in turning over our visions of self to private logoed creations, we impoverish our culture and ourselves.

One central thesis of this argument is that trademarks have long since left behind the rationale of efficient consumer information flow. The logo does not tell us something about the producer of the good. The logo is the good. The person who purchases a plain white T-shirt with a large Nike swoosh is not buying the shirt. The shirt is merely the transport mechanism for the logo. **Is this right? Not? How?** What implications does the brand fetishism critique have for trademark law?



Trademarks mentioned in “Uptown Funk”:
Chuck Taylor (shoes); Yves St. Laurent (clothing); Skippy (peanut butter).

Should Mark Ronson/his label have to get permission to mention those marks in the lyrics? Why/why not?

A photograph of the singer Lorde performing on stage. She has long, wavy brown hair and is wearing a black fishnet top. She is singing into a microphone with her eyes closed. The background is dark with some stage lights.

LORDE

ROYALS

Trademarks mentioned in “Royals”:
Cristal, Maybach, Cadillac
Should Lorde/her label have to get permission to mention those marks in the lyrics? Why/why not? **Queen Bee / Queen Bey?**

BYE!

