

# An Open-Access Casebook

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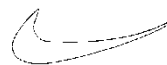


## Establishing Trademark Rights

In order to qualify for trademark protection under U.S. federal law, a trademark must meet three basic requirements: (1) the trademark must be “distinctive” of the source of the goods or services to which it is affixed, (2) the trademark must not be disqualified from protection by various statutory bars to protection, the most significant of which is that the trademark not be “functional,” and (3) the trademark must be used in commerce.

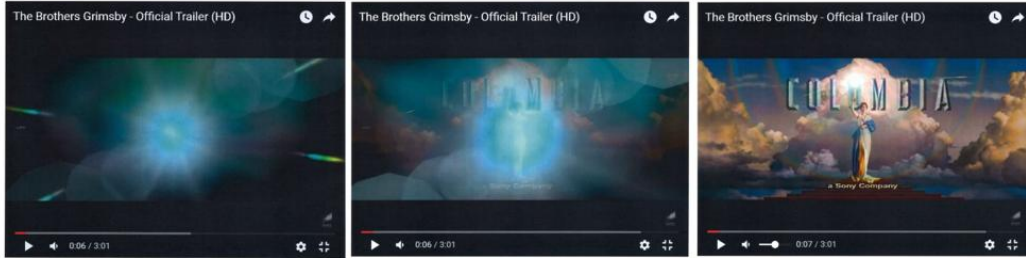
Note what is missing from this list of basic requirements for trademark protection. First, in order to qualify for protection under the Lanham Act, a trademark does not need to be registered at the PTO (though, as we will discuss in Class 10, there are significant benefits to registration). Lanham Act § 32, 15 U.S.C. § 1114, protects *registered* marks from unauthorized uses that are likely to cause consumer confusion as to the true source of the unauthorized user’s goods. Lanham Act § 43(a), 15 U.S.C. § 1125(a), does the same for *unregistered* marks. (And Section 43(c), 15 U.S.C. § 1125(c), protects both registered and unregistered marks from trademark dilution). As a matter of tradition, trademark lawyers sometimes refer to unregistered mark protection under § 43(a) as “common law” protection of trademarks even though this protection is based on statutory federal law.

Second, a protectable trademark need not manifest itself in any particular form.<sup>1</sup> Consider the extraordinary variety of forms that trademarks (here, all registered) may take:

- Words: APPLE for computers (U.S. Reg. No. 1,078,312, Nov. 29, 1977); AMAZON for online retailing services (U.S. Reg. No. 2,832,943, April 13, 2004); NIKE for athletic shoes (U.S. Reg. No. 978,952, Feb. 19, 1974); THE for clothing (U.S. Reg. No. 6,763,118, June 21, 2022).
- Phrases: JUST DO IT for clothing (U.S. Reg. No. 1,875,307, Jan. 24, 1995).
- Two-dimensional still images: a “‘wing’ design” for sports bags (U.S. Reg. No. 1145473, Jan. 6, 1981) 
- Two-dimensional moving images: for online entertainment services, “[t]he mark consists of a moving image of a flash of light from which rays of light are emitted against a background of sky and clouds. The scene then pans downward to a torch being held by a lady on a pedestal. The word “COLUMBIA” appears across the top running through the torch and then a circular rainbow appears in the sky encircling the lady.” (U.S. Reg. No. 1,975,999, May 28, 1996).

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<sup>1</sup> See Jerome Gilson & Anne Gilson LaLonde, Cinnamon Buns, Marching Ducks, and Cherry-Scented Racecar Exhaust: Protecting Nontraditional Trademarks, 95 TRADEMARK REP. 773 (2005).

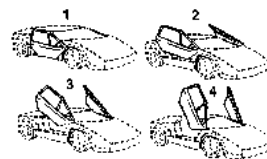


- Colors: the color canary yellow for adhesive stationary notes (U.S. Reg. No. 2,390,667, Oct. 3, 2000); the color brown for parcel delivery services (U.S. Reg. No. 2,131,693, Jan. 27, 1988). What about Pantone 219 C, otherwise known as Barbie Pink? See *Barbie Pink: What do Mattel's Trademark Rights Look Like?*, THE FASHION LAW, July 20, 2023 (noting that Mattel does not possess a trademark registration for the color Barbie Pink alone).
- Colors as used on apparel: for promotional services relating to sports events, where “[t]he mark consists of the colors green and gold where the color green is applied to the jacket and the color gold is applied to the three waist buttons and the two sleeve buttons on each arm of the jacket.” (U.S. Reg. No. 6,000,045, March 3, 2020).

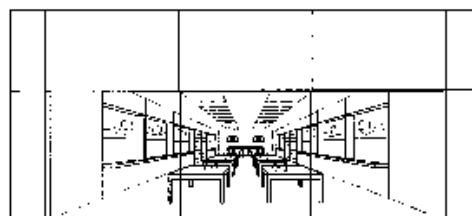


- Sounds: Tarzan’s yell for toy action figures (U.S. Reg. No. 2,210,506, Dec. 15, 1998); for canned and frozen vegetables where the mark consists of “the sound of a deep, male, human-like voice saying ‘Ho-Ho-Ho’ in even intervals with each ‘Ho’ dropping in pitch” (U.S. Reg. No. 2,519,203, Dec. 18, 2001).
- Scents: for toy modeling compounds, where “[t]he mark is a scent of a sweet, slightly musky, vanilla fragrance, with slight overtones of cherry, combined with the smell of a salted, wheat-based dough” (U.S. Reg. No. 5,467,089, May 15, 2018); for crayons, where “[t]he mark consists of a scent reminiscent of a slightly earthy soap with pungent, leather-like clay undertones” (U.S. Reg. No. 7,431,203, July 2, 2024).

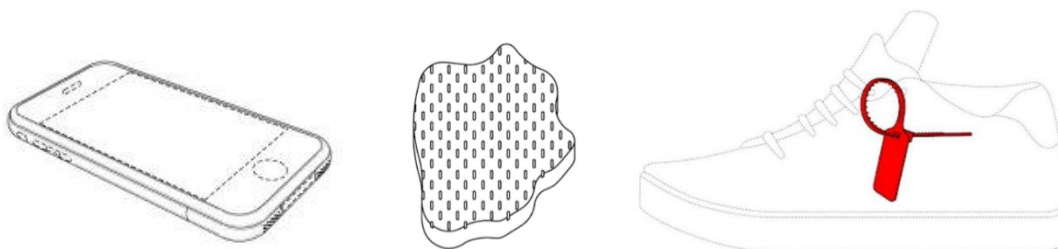
- Textures: for wines where “[t]he mark consists of a velvet textured covering on the surface of a bottle of wine” (U.S. Reg. No. 3,155,702, Oct. 17, 2006).<sup>2</sup>
- Motions: for automobiles where “[t]he mark consists of the unique motion in which the door of a vehicle is opened. The doors move parallel to the body of the vehicle but are gradually raised above the vehicle to a parallel position.” (U.S. Reg. No. 2,793,439, Dec. 16, 2003).
- Buildings exteriors: the design of a building for restaurant services (U.S. Reg. No. 1,045,615, Aug. 3, 1976).



- Building interiors: for retail consumer electronics services, “the mark consists of the design and layout of a retail store. The store features a clear glass storefront surrounded by a paneled facade consisting of large, rectangular horizontal panels over the top of the glass front, and two narrower panels stacked on either side of the storefront. Within the store, rectangular recessed lighting units traverse the length of the store’s ceiling. There are cantilevered shelves below recessed display spaces along the side walls, and rectangular tables arranged in a line in the middle of the store parallel to the walls and extending from the storefront to the back of the store. There is multi-tiered shelving along the side walls, and a oblong table with stools located at the back of the store, set below video screens flush mounted on the back wall. The walls, floors, lighting, and other fixtures appear in dotted lines and are not claimed as individual features of the mark; however, the placement of the various items are considered to be part of the overall mark.” (U.S. Reg. No. 4,277,914, Jan. 22, 2013).
- Product shapes: for mobile phones, where “the mark consists of the configuration of a rectangular handheld mobile digital electronic device with rounded corners” (U.S. Reg. No. 3,457,218, July 1, 2008); for uncooked hamburger patties, where “the mark consists of the configuration of a hamburger patty” (U.S. Reg. No. 5,742,743, May 7, 2019); for footwear, where “the mark consists of [sic] three-dimensional configuration of a zip tie with a substantially rectangular end, all in the color red” (U.S. Reg. No. 6,681,777, Mar. 29, 2022).



<sup>2</sup> See Christina S. Monteiro, *A Nontraditional Per-Spectrum: The Touch of Trademarks*, INTA BULL., June 15, 2010, at 4.



- Product packaging: for soft drinks, “[t]he mark consists of a three dimensional configuration of a version of the Coca Cola Contour Bottle, rendered as a two-liter bottle, having a distinctive curved shape with an inward curve or pinch in the bottom portion of the bottle and vertical flutes above and below a central flat panel portion.” (U.S. Reg. No. 4,242,307, Nov. 13, 2012).



The reader may be surprised to see that trademark rights can cover such a wide array of subject matter. This Part covers how these various marks have managed to qualify for trademark protection and why various other marks have failed to qualify. Section I.A devotes a great deal of attention to what is by far the most important requirement for trademark protection: that the trademark be “distinctive.” Section I.B then turns to the various statutory bars to protection, including the functionality bar, which disqualify marks from protection under the Lanham Act. Section I.C seeks to make sense of the “use in commerce” requirement for trademark protection. Section I.D reviews why it is worthwhile to register a mark at the PTO and how the registration process works. Section I.E addresses the geographic scope of the protection of registered and unregistered marks.

## A. Trademark Distinctiveness

### **Lanham Act § 45; 15 U.S.C. § 1127**

The term “trademark” includes any word, name, symbol, or device, or any combination thereof . . . used by a person . . . to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

The § 45 definition of the term “trademark” emphasizes that a protectable trademark must be distinctive of source — it must “identify and distinguish . . . goods . . . and . . . indicate the source of the goods.” Note that in order to qualify for protection, a trademark need not indicate the precise manufacturing source of the goods or the corporate name of the producer of the goods. For example, the trademark TIDE for laundry detergent need not indicate in exactly which factory the particular bottle of laundry detergent was made or that Proctor & Gamble ultimately owns the TIDE brand. Instead, consumers need only know that all products bearing the same trademark originate in or are sponsored by the same source,

even if that source is “anonymous” to consumers.<sup>3</sup> This is sometimes known as the “anonymous source” theory of trademark protection.

A trademark will qualify as distinctive if either (1) it is “inherently distinctive” of source or (2) it has developed “acquired distinctiveness” of source. A mark is inherently distinctive if “its intrinsic nature serves to identify a particular source.” *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 210 (2000) (alterations omitted). The underlying assumption is that as a matter of consumer literacy, consumers will almost instantly recognize that an inherently distinctive mark is a designation of source, even when they encounter the mark for the first time. After all, how else would a modern consumer make sense of the word “apple” as used in the sale of electronics that have nothing to do with apples? Inherently distinctive marks “almost *automatically* tell a customer that they refer to a brand,” *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159 162-63 (1995) (emphasis in original), and “immediately . . . signal a brand or a product ‘source.’” *Id.* at 163.

Marks that lack inherent distinctiveness may nevertheless qualify as distinctive if they have developed “acquired distinctiveness,” otherwise known as “secondary meaning,” through advertising or use in the marketplace. Over time, consumers may come to identify what might have seemed merely a description of the good or service (e.g., “American Airlines”) or merely a decoration on a product (e.g., three stripes on the side of an athletic shoe) as a designation of the source of that product. Indeed, consumers may come to identify the configuration of the product itself as a signifier of its source.

Here in Section I.A, we will spend considerable time reviewing how courts determine if a commercial sign qualifies as inherently distinctive or as possessing acquired distinctiveness. Before proceeding, two things should be kept in mind. First, some of the opinions below address the registrability of the marks at issue at the PTO while other opinions address the protectability under § 43(a) of marks that have never been registered. Recall that registration is not a prerequisite for trademark protection under the Lanham Act. Many significant trademark cases over past decades have involved unregistered marks. The important point for our purposes in this subsection is that the basic doctrine relating to the registrability of a mark is essentially the same as the doctrine relating to whether it may be protected regardless of its registration status. We may use opinions from either context to understand the distinctiveness requirement in trademark law.

Second, this subsection will first consider distinctiveness doctrine as it relates to verbal marks. It will then proceed to the more difficult area of distinctiveness doctrine that covers

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<sup>3</sup> See McCarthy § 3.9 (“[T]he ‘source’ identified by a trademark need not be known by name to the buyer. It may be anonymous in the sense that the buyer does not know, or care about, the name of the corporation that made the product or the name of the corporation which distributes it. But the buyer is entitled to assume that all products carrying the same trademark are somehow linked with or sponsored by that single, anonymous source.”). See also *P & P Imports LLC v. Johnson Enterprises, LLC*, 46 F.4th 953, 960–61 (9th Cir. 2022).

non-verbal marks, such as logos, colors, product packaging, and product configuration (i.e., the shape of the product itself).

## 1. Inherent Distinctiveness of Source and Acquired Distinctiveness of Source

### a. *Inherent Distinctiveness of Source*

#### i. *The Abercrombie Spectrum*

The excerpt below, from *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976), analyzes some of the most fundamental terms and concepts in trademark law. Though *Abercrombie* is now a relatively old opinion, its influence on U.S. and even foreign trademark law cannot be overstated. It is the origin of the “*Abercrombie* spectrum” of trademark distinctiveness, a classification scheme that is used in a wide variety of areas of trademark doctrine.

The essential facts underlying the opinion are as follows. Plaintiff Abercrombie & Fitch Company (“A&F”) operated various sporting goods stores in New York City and elsewhere. It had multiple PTO registrations for its trademark SAFARI. Among these was a registration for SAFARI for cotton clothing, a registration for SAFARI for hats, and a registration for SAFARI for shoes. Defendant Hunting World, Incorporated (“HW”) began to sell at its New York City store sporting apparel, including hats and shoes, bearing the terms “Safari,” “Minisafari,” and “Safariland.” A&F sued on the ground that HW’s conduct would confuse consumers as to the true source of HW’s goods. At the core of the case was the question of whether A&F’s SAFARI trademark possessed distinctiveness of source on certain of A&F’s goods.

As you read the excerpt, consider the following questions:

- To the extent that a mark’s categorization somewhere along the *Abercrombie* spectrum bears directly on whether the mark will qualify for trademark protection, which borders between categories do you suspect are especially disputed?
- Where would you classify the trademark “safari” for clothing? for boots? for hats?

[The opinion in *Abercrombie & Fitch Co. v. Hunting World, Inc.* is available separately.]

### Comments and Questions

1. Is “SAFARI” generic as to clothing, hats, and boots? Judge Friendly found that safari was a generic term when used in connection with certain items of clothing and hats. Here is part of his reasoning:

It is common ground that A&F could not apply ‘Safari’ as a trademark for an expedition into the African wilderness. This would be a clear example of the use of ‘Safari’ as a generic term. What is perhaps less obvious is that a word may have more than one generic use. The word ‘Safari’ has become part of a family of

generic terms which, although deriving no doubt from the original use of the word and reminiscent of its milieu, have come to be understood not as having to do with hunting in Africa, but as terms within the language referring to contemporary American fashion apparel. These terms name the components of the safari outfit well-known to the clothing industry and its customers: the ‘Safari hat’, a broad flat-brimmed hat with a single, large band; the ‘Safari jacket’, a belted bush jacket with patch pockets and a buttoned shoulder loop; when the jacket is accompanied by pants, the combination is called the ‘Safari suit’.

*Abercrombie*, 537 F.2d at 11-12. Judge Friendly determined that the term “safari” was not generic, however, when used in connection with boots; it was either suggestive or merely descriptive, and because the registration of SAFARI for boots had become “incontestable” (a concept we will discuss below), the mark was found in either case to be protected. *Id.* at 12. Nevertheless, HW was deemed to be making a “fair use” (another concept we will address below) of the term safari in connection with its boots and was thus found not to be infringing. *Id.* at 12-13.

We will devote much more attention to the question of genericism in Class 4.

2. *What Abercrombie borderlines are the most disputed?* Under the *Abercrombie* spectrum, suggestive, arbitrary, and fanciful marks qualify as inherently distinctive and may be protected without a showing that the mark has developed secondary meaning as a designation of source. Descriptive marks do not qualify as inherently distinctive and require a showing of secondary meaning to be protected. Generic marks may not be protected regardless of any showing of secondary meaning. Thus, there are two significantly disputed borders in the *Abercrombie* spectrum, the border between generic and descriptive marks and the border between descriptive and suggestive marks.

3. *Coined terms that are not fanciful, but rather suggestive.* Not all coined terms qualify as fanciful. In *Surfvivor Media, Inc. v. Survivor Productions*, 406 F.3d 625 (9th Cir. 2005), the court analyzed the *Abercrombie* classification of the trademark SURFVIVOR for beach-themed products:

Because “Surfvivor” is a coined term, [plaintiff] Deptula contends that it should be treated as a fanciful mark. However, the mere fact that a mark consists of a coined term does not automatically render that mark fanciful. See *Interstellar Starship Servs. Ltd. v. Epix, Inc.*, 184 F.3d 1107, 1111 (9th Cir. 1999) (determining that the coined phrase “EPIX” for electronic pictures should not automatically be considered an arbitrary [or fanciful] mark). Fanciful marks have no commonly known connotation to the product at hand. By contrast, the term “Surfvivor” is highly evocative of the company’s beach-related products.

*Id.* at 632. The court ultimately determined that the SURFVIVOR mark was suggestive. See *id.*

4. *Why choose a non-inherently distinctive descriptive mark?* Lawyers may advise their clients always to choose inherently distinctive marks (and ideally only fanciful marks)



because such marks do not require any showing of secondary meaning to qualify for protection. Yet clients often prefer — and the marketplace is full of — descriptive marks, particularly marks that are descriptive in a laudatory sense (e.g., BEST BUY). Why should this be the case? In an opinion involving the trademark FASHIONKNIT, Judge Learned Hand offered one persuasive explanation:

I have always been at a loss to know why so many marks are adopted which have an aura, or more, of description about them. With the whole field of possible coinage before them, it is strange that merchants insist upon adopting marks that are so nearly descriptive. Probably they wish to interject into the name of their goods some intimation of excellence, and are willing to incur the risk.

*Franklin Knitting Mills, Inc. v. Fashionit Sweater Mills, Inc.*, 297 F. 247 (S.D.N.Y. 1923). See also *Aloe Creme Labs., Inc. v. Milsan, Inc.*, 423 F.2d 845, 165 U.S.P.Q. 37 (9th Cir. 1970) (“Apparently entrepreneurs cannot resist the temptation to tie the name of their product to some disabling quality of description, geography, or vanity.”). The Gilson treatise discusses this issue thoroughly at JEROME GILSON & ANNE GILSON LALONDE, GILSON ON TRADEMARKS § 2.01 (2022).

5. *Do misspellings make any difference?* In short, no. See *Restatement (Third) of Unfair Competition* (1995) § 14, cmt. a (“The misspelling or corruption of an otherwise descriptive word will not ordinarily alter the descriptive character of the designation.”); *Spex, Inc. v. Joy of Spex, Inc.*, 847 F. Supp. 567 (N.D. Ill. 1994) (SPEX for eyeglasses merely descriptive); *In re Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 205 U.S.P.Q. 505 (C.C.P.A. 1980) (QUIK-PRINT for photocopy services merely descriptive). See also *Flexitized, Inc. v. National Flexitized Corp.*, 335 F.2d 774, 780, 142 U.S.P.Q. 334 (2d Cir. 1964) (“That the terms used to comprise a trademark are misspelled, or represent the combination of several words or parts of words, or are otherwise so formed or malformed that the mark does not appear in any standard dictionary, will not preclude a finding of invalidity based on descriptiveness if the terms which are used, interpreted according to the basic rules of the English language, do sufficiently describe.”).

6. *Beyond Abercrombie*. Students with a background in linguistics, semiotics, or literature may find the *Abercrombie* spectrum to be disappointingly primitive. For a far more sophisticated classification of trademarks by the poetic and rhetorical devices they employ, see Alexandra J. Roberts, *A Poetics of Trademark Law*, 38 BERKELEY TECH. L.J. 51 (2023).

## ii. Distinguishing Suggestive from Descriptive Marks

There are a number of reasons why a trademark owner would want to show that a mark on the border between descriptiveness and suggestiveness is in fact suggestive and thus inherently distinctive. First, it can be difficult and costly to show that a mark deemed descriptive has developed secondary meaning as a designation of source. Second, only inherently distinctive marks may be registered on an intent-to-use basis.

Where a mark falls along the continuum between suggestiveness and descriptiveness can be difficult to determine, and a court's determination of the issue difficult to predict. See Jake Linford, *The False Dichotomy Between Suggestive and Descriptive Trademarks*, 76 OHIO ST. L.J. 1367, 1371 (2015) (characterizing the distinction between descriptive and suggestive marks as "illusory at best" and urging reforms in trademark law's treatment of suggestive marks). Courts' approaches vary, but all emphasize, as did Judge Friendly in *Abercrombie*, the question of the degree of "imagination" a consumer must use to connect the meaning of the mark to the characteristics of the goods. See, e.g., *Platinum Home Mortgage Corp. v. Platinum Financial Group, Inc.*, 149 F.3d 722, 47 U.S.P.Q.2d 1587 (7th Cir. 1998) (stating the Seventh Circuit's "degree of imagination" test as "[I]f a mark imparts information directly it is descriptive. If it stands for an idea which requires some operation of the imagination to connect it with the goods, it is suggestive", and quoting approvingly the district court's reasoning that PLATINUM MORTGAGE is descriptive because "the mental leap . . . is nearly instantaneous and . . . requires little imagination to associate 'platinum' with superiority and quality service").

Because the borderline between descriptive and suggestive marks is so important, two representative analyses are provided here for your consideration. To give you a sense of the relative importance of various opinions in the trademark law canon, it is worth noting that neither of the opinions excerpted here has been nearly as influential as *Abercrombie*. They are provided instead as everyday examples from various circuits of how courts draw (sometimes unpredictably, sometimes wrongly) the border between suggestiveness and descriptiveness.

In reading these cases, consider the following questions:

- Which factors should be the most important to a court's determination of whether a mark is either descriptive or suggestive?
- How might you design a consumer survey to aid a court in determining whether a mark is either descriptive or suggestive?
- Has the court in *Innovation Ventures* (the second opinion below) adopted a sensible approach to analyzing descriptiveness versus suggestiveness? If you were the plaintiff (i.e., the asserter of trademark rights), would you prefer the *Zatarains* or the *Innovation Ventures* approach?

[The opinion in *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.* is available separately.]

[The opinion in *Innovation Ventures, LLC v. N.V.E., Inc.* is available separately.]

### Comments and Questions

1. *The PTO's conflicting analysis of the 5-HOUR ENERGY mark.* Innovation Ventures originally applied to register 5-HOUR ENERGY at the PTO in 2004, but the PTO denied registration on the ground that the mark was merely descriptive and lacked acquired distinctiveness. In 2005, Innovation Ventures resorted to registration of the mark on the Supplemental Register (U.S. Reg. No. 3,003,077, Sept. 27, 2005). In 2011, after showing the mark had developed acquired distinctiveness, Innovation Ventures finally managed to register the mark on the Principal Register. (U.S. Reg. No. 4,004,225, Aug. 2, 2011). (For a discussion of the difference between the Supplemental Register and the Principal Register, see the reading for Class 10.)

In a subsequent case, *Innovation Ventures, LLC v. N2G Distrib., Inc.*, 763 F.3d 524 (6th Cir. 2014), the Sixth Circuit noted this history and simply stated in a footnote: “By contrast, we have held that the ‘5-hour ENERGY’ mark was ‘suggestive and thus protectable’ by at least March 2006. *Innovation Ventures, LLC v. N.V.E., Inc.*, 694 F.3d 723, 730 (6th Cir. 2012).” *Innovation Ventures, LLC v. N2G Distrib., Inc.*, 763 F.3d at 530 n.1.

With whose determination do you agree, the PTO's or the Sixth Circuit's?

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Here are a few further examples of marks classified either as descriptive or suggestive. You are strongly encouraged to decide for yourself how you would predict the court ruled before consulting the actual outcome (and keep in mind that the court may simply have gotten it wrong):

- COASTAL WINE for wine made near a coast. See *Callaway Vineyard & Winery v. Endsley Capital Group, Inc.*, 63 U.S.P.Q.2d 1919 (TTAB 2002) (finding the mark to be descriptive since the mark describes “a significant feature of applicant's goods, namely the place or establishment where applicant produces its wine”).
- 24 HOUR FITNESS for fitness facilities. See *24 Hour Fitness USA, Inc. v. 24/7 Tribeca Fitness, LLC*, 277 F. Supp. 2d 356 (S.D.N.Y. 2003) (finding that the mark “describe[s] a physical training-related facility that is available, if not around the clock, at least for substantial periods of time on a regular basis.”).
- CROSSFIT for “fitness training and consulting.” See *Crossfit, Inc. v. Quinnie*, 232 F. Supp. 3d 1295, 1306 (N.D. Ga. 2017) (“The Court finds that the CROSSFIT® mark is a suggestive mark. The mark CROSSFIT® is a combination of the terms, “cross” and “fit,” which are both commonly associated with exercise and fitness. The term

“cross” has been used in sports and fitness as in cross-training to refer to combining different sports or types of exercises in order to improve a person’s fitness and performance. The combination of the terms into a single unique word places the mark in the “suggestive” category, requiring a leap of the imagination to get from the mark to the product. The CROSSFIT® mark is not an arbitrary term such as KODAK.” (citation omitted)).

- XTREME LASHES for artificial eyelashes. See *Xtreme Lashes, LLC v. Xtended Beauty, Inc.*, 576 F.3d 221 (5th Cir. 2009) (finding the mark to be suggestive; “The consumer must exercise some imagination to associate ‘xtreme lashes’ with ‘artificially elongated eyelashes.’”).
- 100% and 100% TIME RELEASE MOISTURIZER for skin moisturizer. See *Estee Lauder, Inc. v. The Gap, Inc.*, 108 F.3d 1503 (2d Cir. 1997) (affirming the district court’s finding the mark to be suggestive; “The phrase ‘100% Time Release Moisturizer’ could be read to indicate the purity of the moisturizing content of Lauder’s product, or to imply an enduring effect. Or, as the district court found, it could be read as indicating that the bottle contains nothing but time-release moisturizer or that the product moisturizes continuously until removed or worn off. All of these interpretations require some stretch of the imagination. And of course, as the court found, if the term ‘100%’ is simply viewed as the brand of time-release moisturizer, it plainly is suggestive.”).
- LITTLE MERMAID for a doll taking the form of a mermaid. See *In re United Trademark Holdings, Inc.*, 122 U.S.P.Q.2d 1796 (TTAB 2017) (finding the mark to be descriptive for a doll taking the form of a mermaid because consumers will “understand the mark to describe the public domain character in the Hans Christian Andersen fairy tale, as well as a young or little mermaid”; by contrast, “[c]onsumers reasonably expect goods and services bearing the name or image of {Superman} to emanate from, or be produced or marketed under license from, the entity which created the character and therefore owns the right to profit from commercialization of it.”).
- The app icon shown to the right for a mobile game consisting of block puzzles. See *Hangzhou Mengku Technology Co., Ltd v. Shanghai Zhenglang Technology Co., Ltd*, Opposition No. 91272143 (TTAB Dec. 30, 2024) (finding the asserted mark to be descriptive: “Considering the context in which Applicant’s proposed mark is used and the average purchaser of the goods, we find that Opposers have shown that Applicant’s proposed mark conveys an immediate idea of a feature of the goods, namely that Applicant’s product is a block puzzle game, as described in the identification of goods.”).



## Comments and Questions

1. *Surveying for suggestiveness versus descriptiveness.* In *Rise-N-Shine, LLC v. Duner-Fenter*, No. 14 Civ. 1305, 2015 WL 876470 (S.D.N.Y. Feb. 28, 2015), the plaintiff produced a dietary supplement under the mark GO AWAY GRAY that purportedly prevents the growth of gray hair. The defendant produced a competing dietary supplement under the mark GET AWAY GREY. The defendant asserted that the plaintiff's mark was descriptive (and both parties agreed that the plaintiff's mark lacked secondary meaning). The plaintiff presented survey evidence of the mark's suggestiveness. The methodology of the survey was essentially as follows:

First, the pool of respondents was limited—through screening questions at the beginning of the survey—to adults between the ages of 35 and 55, residing in the United States, who had purchased vitamins or supplements in the previous six months, and who reported that they would “definitely” or “probably” consider buying vitamins or supplements “to promote healthy hair” in the next six months. In all, 208 participants qualified after these screening mechanisms. Next, respondents were informed of the difference between a brand name and a product description, and given two test phrases (“ONE A DAY” and “IMMUNITY BOOSTER”) to evaluate whether they understood that distinction. Respondents were then asked whether they believed the Disputed Mark—as well as two other marks, “SLIM-FAST” and “MUSCLE BUILDER,” which were included to minimize potential bias—refers to a product's brand name or describes a product's function or purpose, or whether the respondent did not know. Respondents were also asked, at the conclusion of the survey, whether they had gray hair, and 176 of the 208 respondents answered affirmatively. Ultimately, 49% of survey respondents—and 51% of respondents with gray hair—answered that they believed the Disputed Mark was a brand name. {The survey expert} then excluded all those respondents who incorrectly identified either SLIM-FAST or MUSCLE BUILDER as a brand name or product description, which left 160 respondents. Of those respondents, 56% in total, and 59% of those with gray hair, answered that they believed the Disputed Mark was a brand name.

*Id.* at \*1. Judge Sullivan rejected the defendant's motion in limine to exclude the survey expert's testimony and allowed the survey results to be presented to the jury. *Id.* at \*4. Does this survey methodology for distinguishing between descriptive and suggestive marks appear valid?

2. *Is the protection of descriptive marks constitutionally sound?* See Lisa Ramsey, *Descriptive Trademarks and the First Amendment*, 70 TENN. L. REV. 1095 (2003) (arguing that the protection of descriptive marks violates the free speech clause of the First Amendment because it does not directly advance the government's interest in protecting consumers from confusion and is in any case more extensive than necessary).

### iii. Special Rules for Classification of Certain Kinds of Trademarks

There are many special rules that guide the *Abercrombie* classification of certain kinds of trademarks. Nearly all of them are detailed in the PTO's *Trademark Manual of Examining Procedure* ("TMEP"), [tmep.uspto.gov](http://tmep.uspto.gov), which is an excellent resource for the trademark lawyer, particularly one who specializes in trademark "prosecution," i.e., the process of registering trademarks at the PTO. Among the most important of these special rules are the following:

#### (a) *Descriptiveness of Geographic Terms*

Lanham Act § 2, 15 U.S.C. § 1052, has several provisions giving special treatment to geographic terms. Consider for the moment § 2(e)(2), which provides: "No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it . . . (e) Consists of a mark which . . . (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 1054 of this title."

Such "primarily geographically descriptive" marks may be registered or otherwise protected only upon a showing of secondary meaning (with one important exception relating to geographic certification or collective marks that we will address in a moment). Lanham Act § 2(f), 15 U.S.C. § 1052(f). The TTAB has established a relatively straightforward three-part test for determining whether a mark is "primarily geographically descriptive." The mark will fall into this category if: "(1) the primary significance of the mark is a generally known geographic location; (2) the goods or services originate in the place identified in the mark; and (3) purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark." TMEP § 1210.01(a). See, e.g., *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998) (finding CAROLINA APPAREL for clothing stores in North Carolina to be primarily geographically descriptive); *In re Brouwerij Nacional Balashi NV*, 80 U.S.P.Q.2d 1820 (TTAB 2006) (finding BALASHI BEER and BALASHI for beer made in the Balashi neighborhood of the Santa Cruz district of Aruba to be not primarily geographically descriptive where the term is "so obscure or remote that purchasers of beer in the United States would typically fail to recognize the term as indicating the geographical source of applicant's goods."). For a more problematic case, see *University Book Store v. Board of Regents of University of Wisconsin System*, 33 U.S.P.Q.2d 1385 (TTAB 1994) (finding WISCONSIN BADGERS for apparel to be not primarily geographically descriptive where consumers would not perceive the primary significance of the mark as a whole as designating a particular geographic location).

The third prong of the PGD test calls for evidence that consumers would make a "goods/place association" (or "service/place association") between (a) the geographic location referred to by the mark and (b) the goods sold under the mark. Importantly, if the geographic location is "neither obscure nor remote," TMEP § 1210.04, and the goods

actually originate from that location, then this goods/place association may ordinarily be presumed. The result is that the goods/place association is almost always found. See, e.g., *In re Spirits of New Merced, LLC*, 85 U.S.P.Q.2d 1614 (TTAB 2007) (finding YOSEMITE BEER to be primarily geographically descriptive where the registration applicant’s beer was brewed near Yosemite National Park and applicant failed to overcome presumption of goods/place association; “[s]ince the goods originate at or near [Yosemite National Park], we can presume an association of applicant’s beer with the park.”). *But see In re Mankovitz*, 90 USPQ2d 1246 (TTAB 2009) (finding THE MONTECITO DIET for a diet system to be not primarily geographically descriptive where evidence of goods/place association consisted only of the fact that the registration applicant lived in Montecito, California; “it would be speculation on our part to reach the conclusion that the goods or services originate there or that the public would understand that there is a goods/place relationship”).

### *(b) Certification Marks and Collective Marks*

“Certification marks” and “collective marks” are special forms of trademarks in the Lanham Act. Lanham Act § 45 defines a certification mark as follows:

The term “certification mark” means any word, name, symbol, or device, or any combination thereof—

- (1) used by a person other than its owner, or
- (2) which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by this Act,

to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person’s goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.

As the § 45 definition suggests, certification marks may take a variety of forms, including:

- certifications of a good’s quality, e.g., SCOTCH WHISKY “to certify that the goods/services provided originate in Scotland and have met the Standards as set forth in The Scotch Whisky Regulations 2009 and The Scotch Whisky technical file”, Reg. No. 6,763,223 (June 21, 2022); the UL mark of Underwriters Laboratories, Inc., Reg. No. 782,589 (Dec. 29, 1964); the U-in-a-circle mark of the Orthodox Union, Reg. No. 636,593 (Oct. 30, 1956);
- certifications of the regional origin of a product, e.g., the “Grown in Idaho” mark of the State of Idaho Potato Commission, Reg. No. 4,221,403 (July 24, 2012); the ROQUEFORT mark of the Community of Roquefort, France, Reg. No. 0571798 (Mar. 10, 1953); *but see Interprofessionel du Gruyere v. U.S. Dairy Exp. Council*, 61 F.4th 407, 425 (4th Cir. 2023) (in refusing registration of GRUYERE as a certification mark on the ground that the term is generic, finding that “the pervasive sales of non-Swiss and



non-French cheese labeled as gruyere in the United States} and the common usage of gruyere establish that when purchasers walk into retail stores and ask for gruyere, they regularly mean a type of cheese, and not a cheese that was produced in the Gruyère region of Switzerland and France” (cleaned up));

- certifications that a product was union-made e.g., the International Union of Painters and Allied Trades mark indicating that the designated services were performed by union members, Reg. No. 2,749,294 (Aug. 12, 2003)



Various specific rules apply to certification marks. First, certifying organizations may not themselves produce goods or services to which the certification mark is applied. See Lanham Act § 14(5)(B), 15 U.S.C. § 1064(5)(B). Rather, certifying organizations can only function as certifiers of other entities’ goods or services. Second, certifying organizations must restrict the use of their mark only to certify goods or services that meet the certification standards. See Lanham Act § 14(5)(A) & (C), 15 U.S.C. § 1064(5)(A) & (C). Third, certifying organizations must not “discriminately refuse[] to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies.” See Lanham Act § 14(5) (D), 15 U.S.C. § 1064(5) (D); *see also* Jeanne C. Fromer, *The Unregulated Certification Mark(et)*, 69 STAN. L. REV. 121 (2017) (discussing examples of certification organizations’ arbitrary, inconsistent, and anticompetitive application of their own certifying standards). To circumvent the constraints placed on certification marks, many certifying organizations prefer to register standard trademarks and license their use in a manner equivalent to a certification system. See Alexandra Mogyoros, *Attestation Marks and Pseudo-Certification Marks: A Divergence of Roles in Trademark Law*, 43 EURO. INTELL. PROP. REV. 219 (2021); C. Bradford Biddle, Frank X. Curci, Matthew Dodson & Molly Edwards,



*Standards Setting Organizations and Trademark Registration: An Empirical Analysis* (working paper, May 19, 2019).

In contrast to certification marks, collective marks are used by members of the collective to identify their goods and services as made by collective members. The “anti-use-by-owner” rule that applies to certification marks—i.e., the rule that the owner of the certification mark may not itself sell goods or services bearing the certification mark—does not apply to collective marks.<sup>4</sup> Lanham Act § 45 defines collective marks as follows:

The term “collective mark” means a trademark or service mark—

(1) used by the members of a cooperative, an association, or other collective group or organization, or

(2) which such cooperative, association, or other collective group or organization has a bona fide intention to use in commerce and applies to register on the principal register established by this Act,

and includes marks indicating membership in a union, an association, or other organization.

When certification or collective marks take the form of geographic designations, the distinctiveness analysis of them is unique in the statutory scheme. Lanham Act § 2(e)(2) establishes that proprietors of certification or collective marks that take the form of “indications of regional origin” need not establish that the indication of regional origin has secondary meaning in order to register the indication as trademark. A mark’s ability to qualify as a regional certification or collective mark turns on “whether the public understands that goods bearing the mark come only from the region named in the mark, not whether the public is expressly aware of the certification function of the mark per se.” TMEP § 1306.05(a). See also *Institut Nat’l Des Appellations D’Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875 (TTAB 1998).

### *(c) Surnames*

Just as it does with geographic marks, § 2 of the Lanham Act, 15 U.S.C. § 1052, also explicitly addresses the protectability of surnames and classifies them essentially as descriptive marks. It states: “No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it . . . (e) Consists of a mark which . . . (4) is primarily merely a surname.” Surnames may be registered only upon a showing of acquired distinctiveness under § 2(f), 15 U.S.C. § 1052(f). As the TMEP explains, § 2(e)(4) “reflects the common law

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<sup>4</sup> The distinction between certification and collective marks is sometimes very fine, leading McCarthy to lament that “[t]he problem with collective trademarks and service marks is that they are almost indistinguishable from certification marks.” MCCARTHY § 19:99. McCarthy suggests that one advantage (or disadvantage) of collective marks is that they offer a way to avoid the strict requirements for the operation of certification marks established in Lanham Act § 14(5).

that exclusive rights in a surname per se cannot be established without evidence of long and exclusive use that changes its significance to the public from that of a surname to that of a mark for particular goods or services. The common law also recognizes that surnames are shared by more than one individual, each of whom may have an interest in using his surname in business; and, by the requirement for evidence of distinctiveness, the law, in effect, delays appropriation of exclusive rights in the name.” TMEP § 1211.

But what qualifies as “primarily merely a surname”? “Fiore,” “Hackler,” and “Bird” are used as surnames, but each has been deemed not “primarily merely a surname” under trademark law. See *In re Isabella Fiore LLC*, 75 USPQ2d 1564 (TTAB 2005); *In re United Distillers plc*, 56 USPQ2d 1220 (TTAB 2000); *Fisher Radio Corp. v. Bird Elec. Corp.*, 162 USPQ 265 (TTAB 1969). The TTAB has established a five factor balancing test to determine whether the relevant purchasing public perceives the primary significance of a term to be that of a surname: (1) whether the surname is rare; (2) whether the term is the surname of anyone connected with the applicant; (3) whether the term has any recognized meaning other than as a surname; (4) whether it has the “look and feel” of a surname; (5) in cases of stylized, rather than standard character marks, whether the stylization of lettering is distinctive enough to create a separate commercial impression. *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1333-1334 (TTAB 1995) (finding that the mark BENTHIN in stylized lettering inside an oval design would not be perceived as primarily merely a surname). If it is determined that the relevant purchasing public does not perceive a term as a surname, then the term would likely be classified as either arbitrary or suggestive, or possibly even as fanciful. In any case, the term would qualify as inherently distinctive of source.<sup>5</sup>

What about historic surnames? “A term with surname significance may not be primarily merely a surname if that term also identifies a historical place or person.” TMEP § 1211.01(a)(iv). See, e.g., *Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp.*, 314 F. Supp. 329, 331 (S.D.N.Y. 1970) (finding that DA VINCI for jewelry and leather goods is not primarily merely a surname for purposes of Section 2(e)(4); “While defendant has

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<sup>5</sup> As for full names, the common law has long treated full names the same as it treats surnames: both require a showing of secondary meaning to merit protection. But importantly, the PTO treats full names differently from surnames for purposes of registration. It will allow the registration of a full name without any showing that the name carries secondary meaning (or is famous), provided that the applicant can show that the name is being used as an indication of commercial origin rather than as simply the applicant’s own name. See *Brooks v. Calloway*, 93 U.S.P.Q.2d 18232010 WL 595585, at \*8 (T.T.A.B. 2010) (“A personal name mark, unless it is primarily merely a surname, is registrable on the Principal Register without a showing of secondary meaning, and thus is deemed to be inherently distinctive under the Lanham Act if the record shows that it is used in a manner that would be perceived by purchasers as identifying the services in addition to the person.”). The divergence between the common law and the registration regime with respect to full names can lead to strange outcomes. See, e.g., *Zinner v. Olenych*, 108 F. Supp. 3d 369, 381–86 (E.D. Va. 2015) (explaining the difference between the USPTO’s “more lenient standard” and the common law doctrine and finding that plaintiff’s mark, ED ZINNER, was a personal name, unprotectable under the common law, yet awarding it a presumption of validity, because the USPTO had granted it registration).

demonstrated by way of the Manhattan telephone directory that the name Da Vinci is in current use as a surname (by one C. Leonardo da Vinci and one Lora Da Vinci), the name Da Vinci, even without the given name Leonardo, comes very near having as its exclusive connotation the world-renowned 15th century artist, sculptor, architect, musician, engineer and philosopher (to whom defendant refers as a ‘deceased Florentine painter’) and hardly suggests that he personally had-something to do with the designing of plaintiff’s luggage.”). *But see In re Champion Int’l Corp.*, 229 USPQ 550, 551 (TTAB 1985) (finding MCKINLEY to be primarily merely a surname despite being the surname of William McKinley, the 25th President of the United States).

*(d) Non-English Words: The Doctrine of “Foreign Equivalents”*

Under the “doctrine of foreign equivalents,” the distinctiveness analysis of non-English words is based on the English translation of those words if (1) the non-English words originate from “common, modern languages, which encompasses all but dead, obscure, or unusual languages,” TMEP § 1207.01(b)(vi)(B), and (2) “it is likely that the ordinary American purchaser would stop and translate the foreign wording into its English equivalent.” TMEP § 1209.03(g). Thus, “leche,” “lait,” and “Milch” as brand names for milk would be deemed generic, and “fresca,” “frais,” and “frisch” as brand names for milk would likely be deemed descriptive and require secondary meaning to be protected. *See, e.g., In re Tokutake Indus. Co.*, 87 USPQ2d 1697 (TTAB 2008) (finding AYUMI, meaning “walking,” and its Japanese character equivalent to be merely descriptive for footwear); *In re Oriental Daily News, Inc.*, 230 USPQ 637 (TTAB 1986) (finding Chinese characters meaning “Oriental Daily News” to be merely descriptive of newspapers). *See also In re Am. Safety Razor Co.*, 2 USPQ2d 1459 (TTAB 1987) (finding BUENOS DIAS for soap and GOOD MORNING for latherless shaving cream likely to cause confusion); *In re Hub Distrib., Inc.*, 218 USPQ 284 (TTAB 1983) (finding EL SOL for clothing and footwear and SUN for footwear likely to cause confusion). *But see In re Monfrere*, Serial No. 88004556 (TTAB March 2, 2020) [not precedential] (finding MONFRÈRE FASHION not confusingly similar with MY BROTHER, both for apparel). *See generally* Anne Gilson LaLonde, *Far From Fluent: Making Sense of the Doctrine of Foreign Equivalents* (LexisNexis 2021).

The doctrine of foreign equivalents has long been riddled with inconsistencies, limitations, and exceptions, however, and is arguably incoherent. In *In re Vetements Grp. AG*, \_\_ F.4th \_\_, 2025 WL 1449718 (Fed. Cir. May 21, 2025), the Federal Circuit sought to rationalize the doctrine. In the case, a fashion house applied to register the term “vetements” (which means “clothing” in French) for various items of apparel. The Federal Circuit found the term to be generic based on the following “guiding principles”:

First, the burden is on the party opposing translation to show that it is unlikely the ordinary American purchaser would stop and translate the word into its English equivalent. Placing the burden on a party opposing translation takes

into account the well-recognized tenet that words from modern languages are generally translated into English. . . .

Second, we consider the capability of the U.S. population to translate the word. . . . As long as an appreciable number of Americans, from the U.S. population as a whole, are capable of translating the word, the word likely will be translated. This principle does not require an absolute majority of the population being capable of translation because it takes into account that words from modern languages are generally translated into English.

Third, we consider whether in context, the mark would ordinarily be translated by a purchaser (from the U.S. population as a whole) with *ordinary sensibilities*. . . . Because the second principle considers language capability, this third principle does not depend on linguistic capabilities. Instead, it assumes linguistic ability but asks whether a purchaser with *ordinary sensibilities* would translate the word given the context in which the mark is used. This follows from cases that have articulated sometimes even a native speaker would not perform a literal translation because it would be irrelevant in the context of the specific goods, services, or market.

*Id.* at \*9–10 (quotation marks and citations omitted; emphasis in original).

What is an “appreciable number of Americans”? In *Vetements*, the record established that “approximately 2.1 million Americans over the age of five spoke a dialect of French at home. French is also the second most widely taught non-English language in schools in the United States.” *Id.* at \*1. See also *In re Hag Aktiengesellschaft*, 155 U.S.P.Q. 598 (TTAB 1967) (finding KABA, meaning coffee in Serbian and Ukrainian, to be descriptive for coffee). But see *Palm Bay Imports v. Veuve Clicquot*, 396 F.3d 1369 (Fed. Cir. 2005) (finding that VEUVE CLICQUOT is not confusingly similar to THE WIDOW, since most American consumers won’t know that “veuve” means “widow” in French).<sup>6</sup>

#### (e) Acronyms

The general rule is that an acronym will be classified as descriptive or generic if (1) the wording it stands for is merely descriptive of or generic as to the goods or services, and (2) relevant purchasers will recognize the acronym as an acronym of the merely descriptive or generic wording it represents (rather than as, say, a fanciful sequence of letters). TMEP § 1209.03(h). See, e.g., *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1715 (TTAB 2011) (finding NKJV to be substantially synonymous with merely descriptive term “New King James Version” and thus merely descriptive of bibles); *Baroness Small Estates, Inc. v. Am. Wine*

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<sup>6</sup> A common objection to the doctrine of foreign equivalents is that Americans don’t speak “foreign” languages. In fact, according to U.S. Census Bureau data, 1 in 5 Americans speak a language other than English at home. See <https://www.census.gov/acs/www/about/why-we-ask-each-question/language/>.

*Trade, Inc.*, 104 USPQ2d 1224, 1230-31 (TTAB 2012) (finding CMS to be inherently distinctive on the ground that it is not substantially synonymous with the grape varieties cabernet, merlot, and syrah and is thus not merely descriptive of wine).