

# An Open-Access Casebook

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Barton Beebe  
John M. Desmarais Professor of Intellectual Property Law  
New York University School of Law

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## Aesthetic Functionality

As the Supreme Court briefly explained in *TraFFix*, a product (or packaging) feature that performs no technical, mechanical function may nevertheless be barred from protection on the ground that it is “aesthetically functional.” Under *TraFFix*, the test to determine whether a product feature is aesthetically functional is not the *Inwood* test. Instead, courts should ask whether there are a limited range of alternative designs available to competitors such that exclusive rights in the product feature would put competitors at a significant non-reputation-related competitive disadvantage. What might have prompted courts to abandon the *Inwood* test in the aesthetic functionality context?

A few classic illustrations of aesthetically functional product configuration from the *Restatement (Third) of Unfair Competition* may help to convey the general idea of aesthetic functionality:

8. A is the first seller to market candy intended for Valentine’s Day in heart-shaped boxes. Evidence establishes that the shape of the box is an important factor in the appeal of the product to a significant number of consumers. Because there are no alternative designs capable of satisfying the aesthetic desires of these prospective purchasers, the design of the box is functional . . . .

9. A manufactures outdoor lighting fixtures intended for mounting on the walls of commercial buildings to illuminate adjacent areas. The evidence establishes that architectural compatibility with the building is an important factor in the purchase of such fixtures and that A’s product is considered to be aesthetically compatible with contemporary architecture. The evidence also establishes that only a limited number of designs are considered compatible with the type of buildings on which A’s product is used. Because of the limited range of alternative designs available to competitors, a court may properly conclude that the design of the lighting fixture is functional under the rule stated in this Section.

### RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17.

A few examples from the aesthetic functionality case law may also help to introduce the doctrine:

- *British Seagull Ltd. v. Brunswick Corp.*, 35 F.3d 1527 (Fed. Cir. 1994) (affirming the TTAB’s refusal to register the color black for outboard marine engines and approving of the Board’s reasoning that “although the color black is not functional in the sense that it makes these engines work better, or that it makes them easier or less expensive to manufacture, black is more desirable from the perspective of prospective purchasers because it is color compatible with a wider variety of boat colors and because objects colored black appear smaller than they do when they are painted other lighter or brighter colors.”).

- *In re Florists' Transworld Delivery, Inc.*, Serial No. 77590475 (TTAB Mar. 28, 2013) (precedential) (affirming examiner's rejection of application to register the color black for boxes containing flowers and floral arrangements; “[c]ompetitors who, for example, want to offer flowers for bereavement purposes, Halloween or to imbue an element of elegance or luxury to their presentations through packaging therefor will be disadvantaged if they must avoid using the color black in such packaging.”).
- *Deere & Co. v. Farmhand, Inc.*, 560 F. Supp. 85, 217 U.S.P.Q. 252 (S.D. Iowa 1982) (finding the color “John Deere green” to be aesthetically functional as used on farm loaders because farmers prefer to match the color of their loaders and tractors). *But see Deere & Co. v. FIMCO Inc.*, 239 F.Supp.3d 964, 997-1003 (W.D. Ky. 2017) (finding John Deere's green and yellow color scheme to be non-functional and distinguishing *Farmhand* on grounds that (1) it was adjudicated before *Qualitex*, *TraFFix*, and the Sixth Circuit's establishment of the “comparable alternatives” and “effective competition” tests for aesthetic functionality, and (2) Deere sought in *Farmhand* to prevent competitors from using “John Deere green” either alone or in combination with any other color, whereas Deere seeks here merely to prevent competitors from using a combination of green and yellow).
- *In re Ferris Corp.*, 59 U.S.P.Q.2d 1587 (TTAB 2000) (not citable as precedent) (affirming examiner's refusal to register the color pink for surgical bandages; the color is “de jure functional” in that it blends well with the natural color of certain human ethnicities' skin and there are no viable alternative colors available).

Of the three opinions that follow, *Pagliero v. Wallace China Co.*, 198 F.2d 339 (9th Cir. 1952), is somewhat notorious for having proposed a definition of aesthetic functionality that, when interpreted loosely, could end up prohibiting the protection of anything that was “an important ingredient in the commercial success of the product,” including the trademark itself. The Ninth Circuit no longer follows *Pagliero*. See, e.g., *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1072 (9th Cir. 2006) (“In the case of a claim of aesthetic functionality, an alternative test inquires whether protection of the feature as a trademark would impose a significant non-reputation-related competitive disadvantage.”). In *Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co.*, 916 F.2d 76 (2d Cir. 1990), the Second Circuit explicitly rejected *Pagliero*. In *Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc.*, 696 F.3d 206, 218- (2d Cir. 2012), the Second Circuit was asked to determine whether a particular color applied to the outsole (the underside) of shoes was aesthetically functional.

Two final points. First, not all circuits are receptive to the concept of aesthetic functionality. See, e.g., *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 487-88 (5th Cir. 2008) (“We do not believe that the Court's dictum in *TraFFix* requires us to abandon our long-settled view rejecting recognition of aesthetic

functionality.”). Why might these circuits refuse to consider aesthetic functionality as a special case of functionality? Second, and related, the student hoping to understand the essence of aesthetic functionality doctrine may do well not to focus too much on the term “aesthetic” or even on the term “functionality.” “Aesthetic functionality” is a horribly chosen name for a doctrine that seeks to make up for one particular shortcoming of utilitarian functionality doctrine, which is that it is simply not well designed to analyze *non-utilitarian, non-mechanical* product features. Aesthetic functionality doctrine seeks to accomplish the same procompetitive goals as utilitarian functionality doctrine, but it does so precisely with respect to non-mechanical product features, be they strictly “aesthetic” or not, that all competitors must be able to include in their products in order to compete effectively. See generally Justin Hughes, *Cognitive and Aesthetic Functionality in Trademark Law*, 36 CARDOZO L. REV. 1227 (2015).

#### i. Foundational Cases

[The opinion in *Pagliero v. Wallace China Co.* is available separately.]

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In reading *Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co.*, 916 F.2d 76 (2d Cir. 1990), consider the following questions:

- How should a court define the relevant market for purposes of assessing competitive alternatives to the plaintiff’s design? What exactly is wrong with Wallace’s argument that it merely wants to claim the baroque style of silverware, and that countless other styles of silverware are still available for competitors to use?
- Even if we are able reliably to define the relevant marketplace, how many alternative designs should be available for a court to determine that the plaintiff’s design is not aesthetically functional?

[The opinion in *Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co.* is available separately.]

#### ii. Aesthetic Functionality and the Apparel Fashion Industry

In reading the excerpt below from *Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc.*, 696 F.3d 206 (2d Cir. 2012), consider the following question:

- Perhaps the Second Circuit is correct that there should be no *per se* rule against the trademark protection of individual colors with respect to apparel, but should there at least be a *TrafFix*-like “strong presumption” against such protection?
- Many followers of the *Louboutin* case were quite surprised by the Second Circuit’s resolution of the dispute. Do you think the court reached the right result?

[The opinion in *Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc.* is available separately.]

### Comments and Questions

1. Are *Louboutin*’s and YSL’s shoes nevertheless confusingly similar? The Second Circuit’s resolution of the dispute was unconventional, to say the least. Given the secondary meaning of Louboutin’s mark, do you think the court was justified in finding that there would be no consumer confusion as to source between Louboutin’s shoes bearing a red outsole with contrasting upper and YSL’s shoes bearing both a red outsole and red upper?

2. *Trademark placement*. Would granting one producer exclusive trademark rights in entirely red shoes put competitors at a significant non-reputation-related disadvantage? What about granting one producer exclusive trademark rights only in an entirely red upper? Why is an outsole different? Is this a case just about color or about color and the placement of the mark? On the importance of where a trademark is placed to how consumers perceive the trademark, see Thomas R. Lee, Eric D. DeRosia, & Glenn L. Christensen, *An Empirical and Consumer Psychology Analysis of Trademark Distinctiveness*, 41 ARIZ. ST. L.J. 1033 (2009). See also Mark A. Lemley & Mark P. McKenna, *Trademark Spaces and Trademark Law’s Secret Step Zero*, 75 STAN. L. REV. 1 (2023) (discussing “locations that consumers are likely to assume are serving as trademarks”).

## Deceptive and Deceptively Misdescriptive Marks

### Lanham Act § 2; 15 U.S.C. § 1052

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—

(a) Consists of or comprises . . . deceptive . . . matter . . .

....

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, . . . (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them.

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. . . .

In determining whether marks are “deceptive” or “deceptively misdescriptive” with respect to the goods to which they are affixed, U.S. trademark law analyzes geographic marks (i.e., marks that convey a geographic meaning) differently from how it analyzes non-geographic marks. Before turning to the peculiar manner in which the law treats geographically deceptive or “primarily geographically deceptively misdescriptive” marks, Lanham Act § 2(e)(3), 15 U.S.C. § 1052(e)(3), we first consider the law’s more straightforward analysis of the deceptiveness or deceptive misdescriptiveness of non-geographic marks.

### *a. Non-Geographic Deceptive and Deceptively Misdescriptive Marks*

A non-geographic deceptive trademark cannot be registered or otherwise protected under federal trademark law. See Lanham Act § 2(a), 15 U.S.C. § 1052(a). By contrast, a non-geographic “deceptively misdescriptive” mark may be registered or otherwise protected under federal trademark law, but only if the mark is shown to have developed secondary meaning as a designation of source. See Lanham Act §§ 2(e)(1) & 2(f), 15 U.S.C. §§ 1052(e)(1) & 2(f).

The basic test for determining whether a non-geographic mark is deceptive or deceptively misdescriptive is relatively straightforward. In *In re Budge Mfg. Co.*, 857 F.2d 773 (Fed. Cir. 1988), the Federal Circuit affirmed the TTAB’s refusal to register the mark LOVEE LAMB for automobile seat covers that were not in fact made of lambskin on the ground that the mark was deceptive. In doing so, it established a three-step test for determining whether a mark is deceptive or deceptively misdescriptive. The TMEP summarizes the three steps as follows:

- (1) Is the term misdescriptive of the character, quality, function, composition or use of the goods?
- (2) If so, are prospective purchasers likely to believe that the misdescription actually describes the goods?
- (3) If so, is the misdescription likely to affect a significant portion of the relevant consumers’ decision to purchase?

TMEP § 1203.02(b). If the answer to each question is yes, then the mark is deceptive under Section 2(a) and cannot be protected. If the answer to question (2) is yes (consumers would likely believe that the misdescription actually describes the goods), but the answer to question (3) is no (the misdescription would nevertheless not affect their decision to purchase), then the mark is deceptively misdescriptive under Section 2(e)(1) and can be protected upon a showing of secondary meaning. (And if the answer to question (2) is no, then the mark is likely arbitrary and thus inherently distinctive—e.g. DIAMOND pencils).

Thus, for non-geographic marks, the question of whether the mark's misdescription would be material to consumers' decisions to purchase the good is what separates an unprotectable deceptive mark from a potentially protectable deceptively misdescriptive mark. This can be a difficult question to answer. The TMEP instructs trademark examining attorneys to focus on "objective criteria" such as whether the misdescription conveys superior quality, enhanced performance or function, difference in price, health benefits, or conformity with meritorious religious practice or social policy. See TMEP § 1203.02(d)(i). The Federal Circuit has emphasized that the misdescription must be material to a "significant portion of relevant consumers." See *In re Spirits Intern.*, N.V., 563 F.3d 1347, 1356 (Fed. Cir. 2009).

Examples of non-geographic marks found to be deceptive:

- *In re White Jasmine LLC*, 106 USPQ2d 1385 (TTAB 2013) (finding the term "white" in WHITE JASMINE to be deceptive for tea that did not include white tea, where "[t]he evidence establishes that consumers perceive that white tea has desirable health benefits. Thus, the misdescription is material to consumers interested in purchasing or drinking white tea to obtain these health benefits, and is likely to induce such purchasers to buy or drink the tea.")
- *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047 (TTAB 2002) (finding SUPER SILK to be deceptive for clothing made of "silk-like" fabric, even where labeling indicated true fiber content of fabric).
- *In re Shapely, Inc.*, 231 USPQ 72 (TTAB 1986) (holding SILKEASE deceptive for clothing not made of silk, even where hangtag claimed that the product has "the look and feel of the finest silks with the easy care of polyester").
- *In re Organik Technologies, Inc.*, 41 USPQ2d 1690 (TTAB 1997) (holding ORGANIK deceptive for clothing and textiles made from cotton that is neither from an organically grown plant nor free of chemical processing or treatment).

Examples of non-geographic marks found to be deceptively misdescriptive:

- *Gold Seal Co. v. Weeks*, 129 F. Supp. 928 (D.D.C. 1955) (affirming TTAB's finding GLASS WAX to be deceptively misdescriptive for glass cleaner where "[t]he evidence does not show that the public has been influenced to purchase the product on account of believing that it contained wax, or that the product was simply a wax to be placed upon glass.").
- *In re Berman Bros. Harlem Furniture Inc.*, 26 U.S.P.Q.2d 1514 (TTAB 1993) (affirming examiner's determination that FURNITURE MAKERS was deceptively misdescriptive for a retail furniture store that sells, but does not make furniture)
- *In re Christopher C. Hinton*, 116 U.S.P.Q.2d 1051 (TTAB 2015) (affirming examiner's determination that THCTea was deceptively misdescriptive for tea-based beverages not containing THC (tetrahydrocannabinol), the primary psychoactive ingredient in

marijuana; TTAB repeatedly noted that the question of whether the mark was deceptive under Section 2(a) was not before it, since the examiner had stopped at a finding of deceptive misdescriptiveness under Section 2(e)(1))

### *b. Geographic Deceptive and Deceptively Misdescriptive Marks*

While trademark law's analysis of the deceptive misdescriptiveness and deceptiveness of *non-geographic* marks is relatively uncomplicated, the same cannot be said about the law's analysis of the deceptive misdescriptiveness and deceptiveness of *geographic* marks. American trademark law devotes special attention to geographic marks primarily because many foreign trading partners have significant economic and cultural interests in preserving the exclusivity of their geographic names (such as CHAMPAGNE, CAMEMBERT, or PARMA). In trade negotiations, particularly those leading to the North American Free Trade Agreement of 1992, the Americans agreed to amend the Lanham Act so that geographic marks that were merely deceptively misdescriptive would be treated the same as geographic marks that were outright deceptive—specifically, geographic marks that were merely deceptively misdescriptive would be unregistrable regardless of whether they possessed secondary meaning. The mechanics of this change in the Lanham Act took the form, in essence, of amending Lanham Act § 2(f) to exclude geographically deceptively misdescriptive marks from that subsection's mechanism by which certain otherwise defective marks can be registered upon a showing of secondary meaning. See Lanham Act § 2(f), 15 U.S.C. § 1052(f) (providing that marks that fall under the provision of § 2(e)(3), in that they are “primarily geographically deceptively misdescriptive,”<sup>1</sup> do not qualify for registration upon a showing of secondary meaning).

Thus, we now have a scheme in which *non-geographic* marks that are merely deceptively misdescriptive can be registered upon a showing of secondary meaning while *geographic* marks that are merely deceptively misdescriptive cannot be registered, even if they possess secondary meaning. Meanwhile, any mark that is outright deceptive, be it non-geographic or geographic, is unregistrable. America's trading partners and perhaps even American trade negotiators at the time could be forgiven for having thought that the Americans had indeed made a significant trade concession, one that limited the ability of trademark applicants at the PTO to register even merely deceptively misdescriptive geographic terms.

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<sup>1</sup> No one likes this statutory phrase “primarily geographically deceptively misdescriptive” from Section 2(e)(3), but we appear to be stuck with it. In her opinion in *In re Miracle Tuesday, LLC*, 695 F.3d 1339 (Fed. Cir. 2012), Judge O’Malley took pains to distance her own elegant prose from the statutory language: “The phrase ‘primarily geographically deceptively misdescriptive’ is a statutory term of art in the trademark context; we neither take responsibility for nor endorse the split infinitives or absence of necessary commas its use in this opinion requires.” *Id.* at 1342 n. 2. Where possible, this casebook will drop “primarily” and simply speak of “geographically deceptively misdescriptive” marks.

Enter the Federal Circuit. In *In re California Innovations, Inc.* 329 F.3d 1334, 1336–1341 (Fed. Cir. 2003), the Federal Circuit reviewed the history of the amendment to the Lanham Act and reached the following conclusion: just as the Lanham Act now treats geographically deceptively misdescriptive terms and geographically deceptive terms the same way (neither is registrable under any circumstances), so the PTO should employ exactly the same test that it uses to determine if a geographic mark is outright deceptive under Lanham Act § 2(a) also to determine if a geographic mark is merely deceptively misdescriptive under Lanham Act § 2(e)(3). Specifically, a mark may be found to be geographically deceptively misdescriptive only if its misdescription is found to be material to consumers' decision to purchase. (Recall that materiality need not be shown for a *non-geographic* mark to be found deceptively misdescriptive.) See also *In re Miracle Tuesday LLC*, 695 F.3d 1339, 1343 (Fed. Cir. 2012); *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1350–54 (Fed. Cir. 2009).

In summarizing the current test for geographic deceptive misdescriptiveness (and geographic deceptiveness), the *Trademark Manual of Examining Procedure* states that a mark will be found to be geographically deceptively misdescriptive (or geographically deceptive) if:

- (1) The primary significance of the mark is a generally known geographic location;
- (2) The goods or services do not originate in the place identified in the mark;
- (3) Purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark; and
- (4) The misrepresentation would be a material factor in a significant portion of the relevant consumers' decision to buy the goods or use the services.

TMEP § 1210.05(b). The result is that if all four elements of this test are met, then the mark may be geographically deceptive, geographically deceptively misdescriptive, or both geographically deceptive and geographically deceptively misdescriptive. In any of these cases the mark is unprotectable. For marks not claiming use in commerce or acquired distinctiveness prior to December 8, 1993 (the date of enactment of the NAFTA Implementation Act), the PTO will typically issue a refusal based on Section 2(e)(3) and Section 2(a).<sup>2</sup> See TMEP § 1210.05(d).

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<sup>2</sup> The Gilson treatise explains why the difference between the two categories might matter:

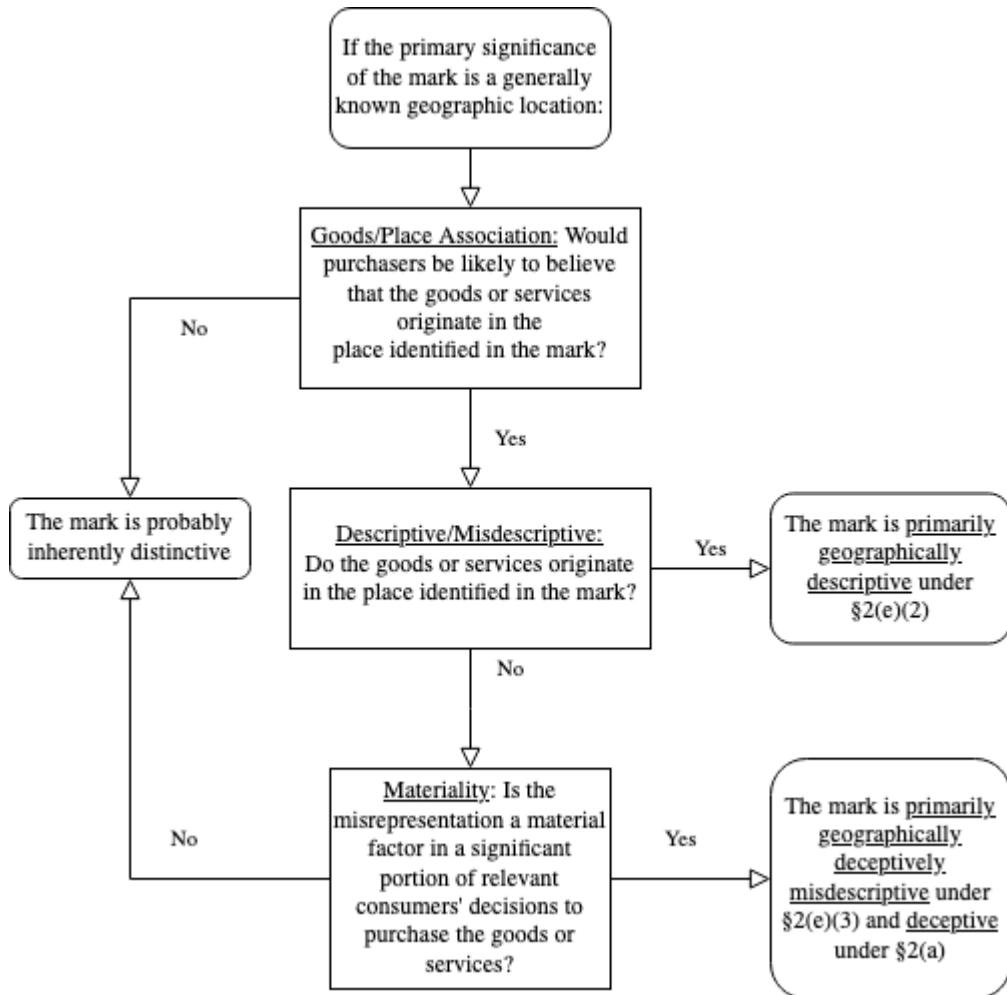
The test for determining whether a mark is deceptive under Section 2(a) is now the same as that for determining whether a mark is primarily geographically deceptively misdescriptive under Section 2(e)(3). The difference comes with respect to registrability: Geographically deceptive marks cannot be registered on either the Principal or Supplemental Register, while primarily geographically deceptively misdescriptive marks may be registered on the Principal Register if the marks became distinctive of the goods or services before December 8, 1993, and they may be registered on the Supplemental Register if they have been in use in commerce since before December 8, 1993.

GILSON § 2.03[4][c][3].

Consider the strange implications of the Federal Circuit's holding in *California Innovations*. Before the NAFTA amendments in 1993, geographically deceptively misdescriptive marks could be registered upon a showing of secondary meaning. The Americans then amended the Lanham Act to provide that any terms that qualify as geographically deceptively misdescriptive may not be registered. However, by adding a materiality requirement, *California Innovations* then made it much more difficult for terms to be classified as geographically deceptively misdescriptive. As a result, at least for certain marks, the U.S. has arguably adopted an even laxer standard for registration of geographically misdescriptive terms. If the misdescriptiveness of such terms is not material to the consumer's decision to purchase, then the term may be registrable, and now *without any need to show secondary meaning*. For if such terms are not geographically deceptively misdescriptive (because the materiality requirement is not satisfied), neither are they geographically descriptive, a status which would trigger the secondary meaning requirement. Instead, in the wake of *California Innovations*, it would appear that such terms are essentially suggestive or arbitrary, i.e., inherently distinctive. For a thorough discussion of this turn of events, see Robert Brauneis & Roger E. Schechter, *Geographic Trademarks and the Protection of Competitor Communication*, 96 TRADEMARK REP. 782 (2006).

### **Comments and Questions**

1. *Synthesizing the Tests.* The tests for geographic descriptiveness, geographic deceptiveness, and geographic deceptive misdescriptiveness may appear quite complicated. Experience has shown that these tests distract the student from far more important issues in trademark law. To try to aid in understanding the tests, the flowchart below attempts to synthesize the tests into a series of questions (with thanks to Professor Jeremy Sheff).



2. *Examples of marks held to be geographically deceptively misdescriptive.* There are many examples of marks held to be geographically deceptively misdescriptive. See, e.g., *In re Miracle Tuesday LLC*, 695 F3d 1339, 104 USPQ2d 1330 (Fed. Cir. 2012) (affirming the TTAB's refusal to register the composite mark consisting of JPK PARIS 75 and design as primarily geographically deceptively misdescriptive for apparel that did not originate in Paris; "Although [applicant's Miami-based designer] Mr. Klifa may still consider himself to be Parisian, the goods that applicant seeks to register are not because there is no current connection between the goods and Paris."); *In re Premiere Distillery, LLC*, 103 USPQ2d 1483 (TTAB 2012) (finding REAL RUSSIAN primarily geographically deceptively misdescriptive for vodka not made in Russia; "In view of this demonstrated fame and reputation of Russian vodka to the relevant public, we may infer that a substantial portion of consumers who encounter REAL RUSSIAN on applicant's vodka are likely to incorrectly believe that the vodka comes from Russia and that such mistaken belief would materially influence their decision to purchase the vodka"); *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841 (TTAB 2012) (finding OLD HAVANA primarily geographically deceptively

misdесcriptive for rum not made in Cuba); *Corporacion Habanos, S.A. v. Guantanamera Cigars Co.*, 102 USPQ2d 1085 (TTAB 2012) (finding GUANTANAMERA, a Spanish word literally meaning “girl from Guantanamo” or “of or from Guantanamo, Cuba,” primarily geographically deceptively misdescriptive for cigars not made in Cuba).

3. *Example of a mark held not to be geographically deceptively misdescriptive.* For an example of a mark held not to be geographically deceptively misdescriptive, consider *In re Glaze Inc.*, Serial No. 76565437 (TTAB Mar. 17, 2005) (not citable as precedent). In *In re Glaze*, the applicant sought to register the mark SWISSCELL for batteries not made in Switzerland. The examining attorney refused registration and then the TTAB reversed. The Board found that because the mark incorporated the word “Swiss,” the primary significance of the mark was a generally known geographic location. However, the Board found that consumers would not likely believe that the batteries originated in Switzerland:

Even when we view the evidence that perhaps two Swiss companies make different type of batteries and that Switzerland is a country with a prosperous and stable market economy, we hold that, as in *California Innovations*, 66 USPQ2d at 1859, this is tenuous evidence that purchasers would expect batteries for lighting to come from Switzerland . . . .

[H]ere the evidence of a goods/place association consists of a single battery company (Renata) and another company that makes vehicle batteries. Under the stricter *California Innovations* standards, we are constrained to find that the examining attorney has not established the required goods/place association between Switzerland and batteries for lighting.

*Id.* at \*4. Finally, the Board found no evidence that the misrepresentation of the source of the batteries would influence consumers’ decision to purchase them:

The few references in the retailers’ advertisements to “Swiss quality” and “Swiss manufacture” in relation to {another Swiss company’s Swiss-made} batteries do not show that prospective purchasers’ decisions would be materially influenced by the term “Swiss” when purchasing batteries for lighting . . . .

The only other evidence that could indicate that the term “Swiss” may materially impact purchasing decisions is the nebulous references to “Swiss quality.” There is simply insufficient evidence to hold that the term “Swiss” applied to virtually any product materially influences purchasers.

*Id.* at \*4-5. Thus the mark was neither geographically descriptive nor geographically deceptively misdescriptive. Apparently, it therefore qualified as inherently distinctive.

## Marks that May Falsely Suggest a Connection

### **Lanham Act § 2; 15 U.S.C. § 1052**

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—

(a) Consists of or comprises ... matter which may ... falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols

....

....

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

[The opinion in *In re Nieves & Nieves LLC* is available separately.]

### **Comments and Questions**

1. *Difference between § 2(a) false suggestion of a connection and § 2(c) identification of living individual without consent.* Lanham Act § 2(c), 15 U.S.C. § 1052(c) prohibits the registration of a mark which “consists of or comprises a name . . . identifying a particular living individual except by his written consent . . .” This does not mean that, for example, every person bearing the surname Singh has the ability under § 2(c) to prohibit the registration of a mark incorporating the word Singh. On the contrary,

A name is deemed to “identify” a particular living individual, for purposes of Section 2(c), only if the “individual bearing the name in question will be associated with the mark as used on the goods, either because that person is so well known that the public would reasonably assume the connection, or because the individual is publicly connected with the business in which the mark is used.”

*In re Sauer*, 27 U.S.P.Q.2d 1073 (TTAB 1993) (quoting *Martin v. Carter Hawley Hale Stores, Inc.*, 206 USPQ 931 (TTAB 1979)). In practice, for well-known celebrities, § 2(a), which tends to require a showing of general notoriety, and 2(c), which tends only to require a showing of niche notoriety, are redundant. See, e.g., *In re Sauer*, 27 U.S.P.Q.2d 1073 (TTAB 1993) (finding the composite mark consisting of BO BALL and design to be prohibited from registration under § 2(a) as falsely suggesting a connection with professional sportsmen Bo Jackson and under § 2(c) as identify a living individual so well-known that the public would

reasonably assume a connection); *In re Richard M. Hoefflin*, 97 U.S.P.Q.2d 1174 (TTAB 2010) (prohibiting registration of marks, for pajamas, OBAMA PAJAMA, OBAMA BAHAMA PAJAMAS and BARACK'S JOCKS DRESS TO THE LEFT under § 2(c)). But for non-celebrities, § 2(c) can prohibit registrations that § 2(a) may not, provided that the non-celebrity is “publicly connected with the business in which the mark is used.” See, e.g., *Ross v. Analytical Technology Inc.*, 51 U.S.P.Q.2d 1269 (TTAB 1999) (prohibiting registration of ROSS for equipment for electrochemical analysis where plaintiff James W. Ross, Jr., was a retired inventor well-known in the field).

2. *Deceased celebrities.* The use of famous historical names will not necessarily trigger the § 2(a) bar. See, e.g., *Lucien Piccard Watch Corp. v. Crescent Corp.*, 314 F. Supp. 329 (S.D.N.Y. 1970) (finding that mark DA VINCI on various goods, including luggage, will not falsely suggest a connection with Leonardo da Vinci because the mark “hardly suggests that he personally had something to do with the designing of plaintiff’s luggage”). *But see Association Pour La Defense et La Promotion De Loeuvre De Marc Chagall Dite Comite Marc Chagall v. Bondarchuk*, 82 U.S.P.Q.2d 1838, 2007 WL 749714 (TTAB 2007) (prohibiting registration of MARC CHAGALL for vodka; “we conclude that the evidence in this record is more than adequate to establish that the mark would be recognized as the name of the painter Marc Chagall and that the name is of sufficient fame or reputation that when the respondent’s mark is used on the goods a connection with the painter Marc Chagall would be presumed”).

3. For a comprehensive review of section 2(a) caselaw, see Anne Gilson LaLonde, *Giving the Wrong Impression: Section 2(a)’s False Suggestion of a Connection*, 110 TRADEMARK REP. 877 (2020).

## Confusingly-Similar Marks Under Lanham Act § 2(d)

Lanham Act § 2(d), 15 U.S.C. § 1052 (d), prohibits the registration of a mark that:

Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

Because this particular statutory bar bears so much in common with the likelihood of confusion analysis reviewed at length below, in the section on likelihood of confusion as a basis for a claim of trademark infringement, we will discuss the § 2(d) bar in that section (Class 12).