

## PROBLEM SET #2

[adapted in part from James Boyle & Jennifer Jenkins, [\*Open Intellectual Property Casebook\*](#). Boyle & Jenkins is distributed under a [Creative Commons Attribution, Non Commercial, Share-Alike license](#). This adaptation is distributed under the same terms.]

### One (comparatively easy)

Go into your kitchen or bathroom and do a “trademark audit.” List at least 10 products and classify their names according to the four categories of trademark “distinctiveness.” Then classify their logos and slogans (if any) in the same way. Finally, classify their shapes and designs.

### Two (harder)

Find a product—in or out of your home or living space—that (a) has the ® symbol indicating a registered mark and (b) seems “descriptive.” Go to the USPTO Trademark Search Page <http://tmsearch.uspto.gov/> (The site is not user-friendly, but it repays the time spent mastering it. Hint: click the TSDR button and the “Documents” tab to see the details.) Search for the mark. Was the mark treated by the Trademark Office as descriptive? If so, does the record for its registration include persuasive evidence of secondary meaning? Be sure to consider in advance whether you are examining a “word mark,” a “design mark,” or something else.

Did the Trademark Office agree with you? How was the mark registered?

### Three (harder)

A client has come to you for legal advice in connection with setting up what the client calls a rollerblading rental business on Venice Beach in Southern California.

You can handle the business basics with relative ease – entity formation, registration of the business name, banking arrangements, employee agreements, compliance with state and local labor and tax laws and so forth.

But the reference to “rollerblading” nags at you. You do some brief research at the USPTO and learn that “Rollerblade” is a registered trademark. What do you do next, and why?

#### Four (harder)

You're a junior lawyer in a large law office whose client, Alan Turning, is the brilliant computer scientist behind a new program known as Faceplant.

Mr. Turning is a long-time vocal critic of Facebook, the social network site. He believes that its privacy practices are poor and less than transparent, that it imposes on its users a tightening spiral of narcissism and withdrawal from the "real" world, and that its network structure and architecture is overly controlling and anti-competitive. Mr. Turning is fond of pointing out that Facebook was able to supplant Myspace as the dominant social network because there was "open competition on the open web." Facebook, by contrast, has boasted that its goal is to be the portal through which users get *all* their content, e-commerce services and forms of communication. Mr. Turning believes that Facebook is trying to replace the "open" structure of the World Wide Web with its own carefully controlled gated community, from which competitors or rivals can be excluded. His saying, "Their goal is to be the *last* social network!" has become something of a rallying cry for Facebook's critics.

Mr. Turning's solution was to create an app called Faceplant that he claims would restore "control of privacy to the user and control of competition to the free market." Mr. Turner is giving the app away for free, but he does make a considerable amount of money from advertisements seen by the millions of users flocking to his website, Faceplant.com.

Mr. Turning's program simplifies the process of selecting and fine-tuning one's privacy preferences by automating the process of jumping through Facebook's cumbersome sets of menus. It also "nags" users if they stay on Facebook for too long, sending messages such as "Enough with the profile tweaks!" "Only losers stalk their high school boyfriends!" and "It's Spring! Go for a walk outside!" Finally, the program "unlocks" Facebook's integration with other apps, so that users can use any app or play any game "inside" Facebook, not merely those approved by the Facebook app store. Mr. Turning made clear by both the name of his program and the logo he selected that his product was critical of Facebook. He claimed that the name "Faceplant" was designed to highlight two of his criticisms – that users become effectively unconscious because of Facebook's influence ("doing a faceplant" is a slang expression for falling rapidly asleep) and that they turn away from more imaginative engagement with forms of culture such as *books*, into vegetative recipients of manipulative advertising, mere "*plants*."

Both Facebook's name and its original logo have been registered on the Principal Register since 2005. The logo is shown at right.



Mr. Turning's logo for Faceplant, shown at left, is based on a modification of that image to send a very different message.

Your firm's standard business strategy for new clients includes applying to register their business name and logo as trademarks with the USPTO. Along with the application, the firm customizes its confidential advice to the client about the virtues of registration, to include appropriate guidance about the likelihood of being able to register the marks, including the character of possible opposition arguments (sources, bases in law, strengths and weaknesses) and the likelihood that the mark will be enforceable in the context of future disputes, whether or not it is registered successfully. The partner you work for has asked you to prepare a sketch of this customized advice that the partner will deliver to Mr. Turning.

Prepare that advice.

**Five (hardest; this is the hypothetical that was "Assignment Two" for the Fall 2023 version of this course)**

As you know, our firm offers legal services to food entrepreneurs, with a special focus on clients opening new restaurants in the so-called "fast casual" marketplace. This matter concerns one of those clients and a question that's arisen about the color scheme chosen for their new location.

The client is called Big Dog Hospitality, or BDH for short. The owner of BDH, Sam Gerard, is in the process of planning a new restaurant that he intends to call "Simply Red." The concept for "Simply Red" is, it appears, simple. The

restaurant will serve a limited menu that focuses entirely on what I'll call, generically, hamburgers – although the beef will be locally sourced and all of the cheeses, vegetables, and condiments will come through an organically-certified farm-to-table pipeline, and buns will be baked locally by artisanal bakers, sourcing appropriately. Sides, desserts, and drinks (including lemonade, iced tea, milkshakes, and alcoholic versions of all three, and there will be a cocktail menu to go with wines and beers) will be, similarly, locally produced, organic, and so on.

The décor of the restaurant seems to be the crux of the issue. Everything will be red. Placemats, napkins, tableware, and glassware will be red. The surfaces of the tables and seats (both benches and seats) will be red. The walls will be red; the floors will be red; the hosts, servers, and kitchen staff all will be outfitted in red uniforms.

Using what apparently is a cutting-edge format for efficient dining room operation, customers will be greeted at the door by a host/order-taker; will place their orders via smart phones promptly as they come in; and then will be escorted to their tables by the host. When the food order is ready, it will be delivered to the table. The hamburgers themselves can be ordered both in pre-designed configurations specified on the menu and also in idiosyncratic versions specified by the customer.

Physically, the dining room will resemble a fast-food restaurant, with hard plastic tables and booths that seat 4 to 6 people each, and some number of 2-top and 4-top stand-alone tables. But the food itself will be significantly higher quality than the food in a fast-food restaurant, with prices somewhere above typical fast-food prices but below prices charged in sit-down or other fast-casual restaurants.

Sam Gerard has asked us to advise him as to trademark and branding questions. I've already told him, off the top of my head, that In-N-Out may have a concern about the red-focused color scheme. Some time back, I saw a case in which In-N-Out sued another restaurant over the red-themed décor. (I checked, and my memory is right. When you can, have a look at [In-N-Out Burgers v. Doll N' Burger, 2022 WL 791924 \(E.D. Michigan March 14, 2022\)](#)).

Somewhat disappointingly, to me at least, when I mentioned In-N-Out, Mr. Gerard replied that he knows In-N-Out extremely well from his childhood in Southern California and imagines "Simply Red" as a kind of upscale "homage" to that chain. ("Simply Red" is expected to open in suburban

Nashville, Tennessee, and there are no current plans to develop more than one location.) He also told me that he thought about approaching In-N-Out to talk about a business partnership or even some kind of licensing deal but then decided against it; he didn't want to be told "no." And, last, he says that he has completely fallen in love with the "all red" color scheme and thinks that the restaurant will be a big hit. Apparently, he has also fallen in love with some pop psychology floating around the restaurant industry that suggests that the color red is good for restaurants, because it makes people hungry. Allegedly.

I need from you an outline of questions, issues, and possible recommendations that I can use in my next, follow-up conversation with Mr. Gerard,