

# Trademark Law

Prof. Madison

**Today: Territoriality**

**Key concepts from Class 10:**

Advantages of registration.

Obligations that come with registration.

Practical uses and strategies associated with registration.

Trademark bullying.

## Geographic scope of unregistered TM rights

Kansas State  
University  
Wildcats

First use: 1922



vs

Northwestern University  
Wildcats

First use: 1924



The *Tea Rose – Rectanus* doctrine protects a *good faith remote* junior user. [Tea Rose for flour; Rexall for drug stores]

Kansas State  
University  
Wildcats  
First use: 1922



vs

Northwestern University Wildcats  
First use: 1924  
*Is NWU remote? Did NWU adopt its nickname in good faith? In 1924? Would the answer be different today? Why?*



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## Geographic scope of unregistered TM rights: the *Tea Rose – Rectanus* doctrine in the case law



Where CA used the “CareLink” mark in in Arkansas before Healthcom used “CareLink” nationally.

Note the significance of *good faith* by the remote junior user.

And a quick note about trade names.

National Ass'n for Healthcare Communications, Inc. v. Central Arkansas Area Agency on Aging, Inc. (8<sup>th</sup> Cir. 2001)

### Geographic scope of registered TM rights:

Lanham Act §§ 7(c), 22, 35 (15 U.S.C. §§ 1057(c), 1065, 1072, 1115)

Constructive nationwide priority a/o date of *application* for applications filed on/after November 16, 1989 (1(a) or ITU applications).

Constructive nationwide priority a/o date of *registration for earlier-filed applications*.

Registration date as constructive notice of senior user's claim, nationwide.

“Intermediate junior user” defense against claims by owners of registered marks, where junior use began after A's actual use but before A's registration.

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Geographic scope of registered TM rights of the [1] senior common law user, [2] the intermediate junior user, where the senior's registration issues [3].

1. 1953: BK [senior – first US user] starts use of BK mark in Florida.
2. 1957: Hoots [junior – later US user] opens a BK in Mattoon, IL.
3. 1959: Hoots registers mark in IL
4. 1961: BK got a federal registration [senior gets fed reg a/o app date with national priority under § 7(c)]
5. BK [senior] expands nationally, with advertising/marketing conflict with Hoots. BK sues Hoots in TM.



**Burger King of Fla., Inc. v. Hoots (7<sup>th</sup> Cir. 1968)**



Burger King of Fla., Inc. v. Hoots (7<sup>th</sup> Cir. 1968)



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The *Dawn Donut* rule: The [1] senior user had a registration *before* [2] junior use commences. Can the junior user avoid an injunction?



Hart (deft): “Baked at midnight, delivered at Dawn”

**Dawn Donut Co. v. Hart's Food Stores  
(2d Cir. 1959)**

**DAWN**



## A typical drama, in Pittsburgh:

1. In Pittsburgh, "Hot Dogma" opens 2004.
2. Dogma Grill in Miami, Florida sends a cease and desist letter, based on a federal registration and claiming a priority date of 2002 and a filing date of 2003.

Must Hot Dogma change its name?  
Should it? Why?

## Downtown hot dog eatery ordered to change its name

Call off the dogmas



STEVE LEVIN  
Pittsburgh Post-Gazette

OCT 24, 2006 12:00 AM

ADVERTISEMENT

Franks for the memories, Hot Dogma.

In the dog-eat-dog world of hot dog restaurants, the Pittsburgh location has decided to settle and change its name to Franktuary.

The settlement ends 17 months of legal wrangling with a Miami Beach restaurant that made a federal case out of the Pittsburgh site's name. Dogma Grill has a trademark on the word "dogma" and its attorneys contended the similarity in names might confuse consumers.

The settlement includes a small, undisclosed financial compensation and an agreement to drop the name Hot Dogma from its signs, Web site and merchandising.

LATEST LOCAL

## National borders and “well-known” marks



**Grupo Gigante SA De CV v. Dallo & Co., Inc. (9<sup>th</sup> Cir. 2004)**  
("In addition, where the mark has not before been used in the American market, the court must be satisfied, by a preponderance of the evidence, that **a substantial percentage of consumers** in the relevant American market is familiar with the foreign mark.")

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## Belmore LLC v. Bayer Consumer Care AG (4<sup>th</sup> Cir. 2016)

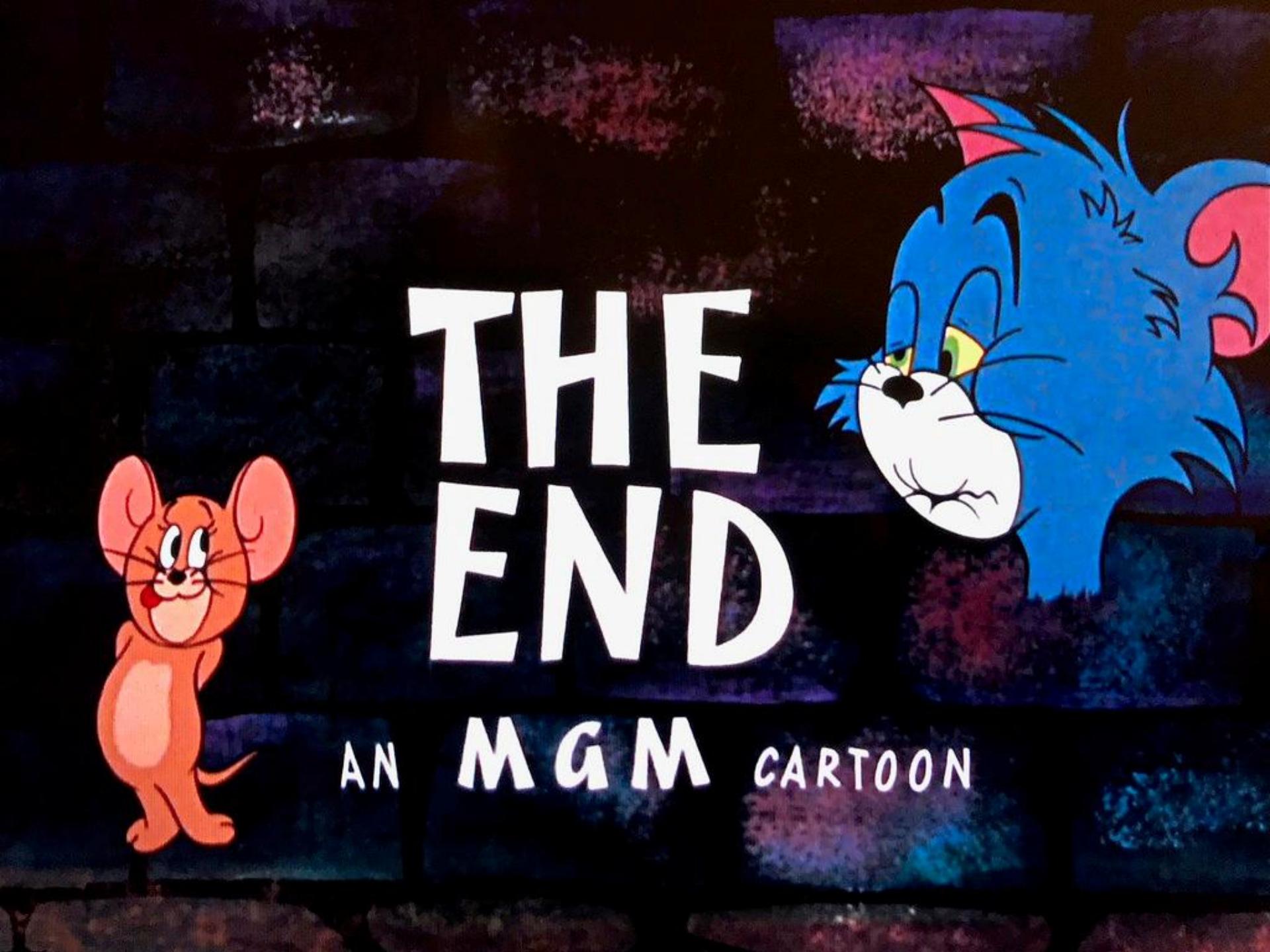


- Bayer successfully petitioned the TTAB to cancel Belmora's registration. Belmora appealed. Bayer also sued Belmora.
- The district court dismissed Bayer's claims on the pleadings; the Lanham Act does not allow an owner of a foreign mark not registered in the US to assert priority rights over a mark that is registered and used by another party in the US.
- Fourth Circuit: Section 43(a) claim is for unfair competition, not TM infringement. Reverses and remands.
- Section 43(a) permits suit by "any person who believes that he or she is or is likely to be damaged by [acts identified in Section 43(a) – i.e., false association (likely confusion, mistake, or deceptions as to origin, sponsorship, or affiliation) [caused by the defendant's use of "any symbol or device"] Bayer alleged loss of profits in by US consumers choosing US FLANAX thinking that it's Mexico FLANAX

## Priority exercise:

FC Bayern Munich is one of the most famous soccer clubs in the world. It plays in the German *Bundesliga* (top division). **Does Bayern's US priority of the mark "FC Bayern Munich," for entertainment services in the form of professional sports exhibitions, and merchandise and apparel, date from:**

- 1. 1976:** Bayern Munich matches appear in edited US TV broadcasts titled "Soccer Made in Germany," on PBS.
- 2. 1989:** Bayern Munich replica jerseys are imported and sold to US customers via mail order supplied by third parties.
- 3. 2006:** Bayern Munich matches appear on US cable and satellite TV networks licensed by the *Bundesliga*.
- 4. 2012:** US Bayern Munich Fan Club organizes and holds meetings in New York City, without official FC Bayern sponsorship. *Can the organizers claim rights to the Bayern Munich mark in New York?*
- 5. 2014:** Bayern Munich tours US for exhibition matches following German World Cup victory in Brazil; Bayern partners with a US soccer academy to train US youth soccer players at the Bayern academy in Germany; Bayern Munich opens a marketing office in New York City.
- 6. 2016:** Bayern Munich competes in tournament matches in the US.

A classic "The End" title card from an MGM cartoon. The background is a dark, starry night sky with a large, colorful nebula on the left and a blue cat (Tom) and a pink mouse (Jerry) on the right. The cat is sleeping with his head on his paw, and the mouse is standing to the left. The text "THE END" is in large, bold, white letters, and "AN MGM CARTOON" is in smaller white letters at the bottom.

THE  
END

AN MGM CARTOON