

Trademark Law

Prof. Madison

Today: Acquired distinctiveness

Key concepts from Class 5:

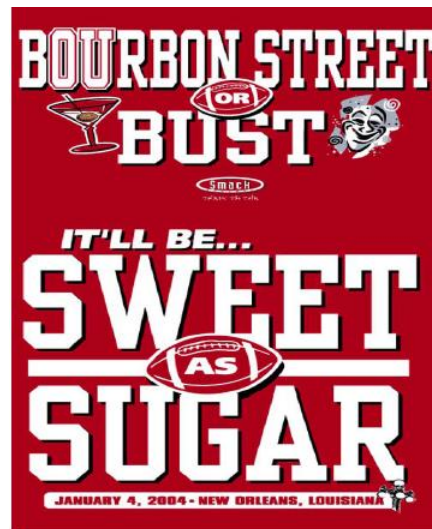
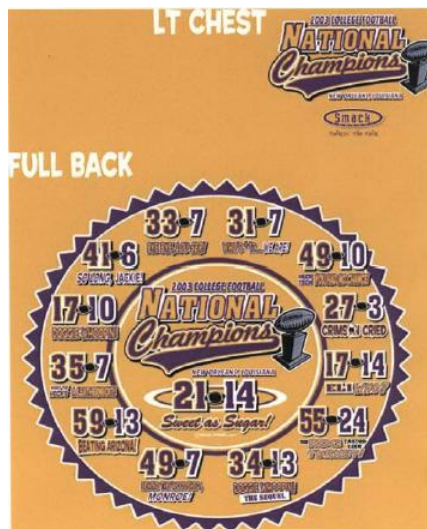
Legal rules and concepts as tools for problem solving.

Mark X for Product (Service) Y.

Bars to protection.

Utilitarian functionality and aesthetic functionality.

Protecting consumers or competition.



Are the **design marks [color combinations]** valid?

[1] Are they marks? Focus on the colors: are they *capable of indicating the source of goods/services?*

[2] Classify the marks, using factors and evidence going to *acquired distinctiveness*

[3] Now: are the colors *functional?*

Board of Supervisors for Louisiana State University Agricultural & Mechanical College v. Smack Apparel Co.
(5th Cir. 2008)



Consider both “is the mark valid?” and also “has the mark been infringed?” (caused a likelihood of confusion as to source) This defendant – Moore – was selling paintings that include Bama colors as part of the school’s uniforms.





Is the number “3” functional in the context of motor sports? That is: Can the number “3” be registered as a mark?

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 unless it -- (e) Consists of a mark which, ...

(5) comprises any matter that, as a whole, is **functional**

Lanham Act § 43(c)(3) (15 U.S.C. § 1025):

In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not **functional**.

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

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

Then why do lawyers, judges, or the Trademark Office use one or the other?



Qualitex Co.
Jacobson
Products Co.,
Inc.
(U.S. 1995)

[T]his Court consequently has explained that, "[i]n general terms, a product feature is functional," and cannot serve as a trademark, **"if it is essential to the use or purpose of the article or if it affects the cost or quality of the article,"** that is, **if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage.** Inwood Laboratories, Inc., *supra*, 456 U.S., at 850, n. 10

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Wallace Int'l Silversmiths Inc. v. Godinger Silver Art (2d Cir. 1990)

(design is *functional* b/c it is essential to the use or purpose of the article or affects its cost or quality (*Inwood Labs v. Ives Labs*, U.S. 1982); also note “competitive need” (*Morton-Norwich*))

What is the relevant market here?



Brunswick Corp. v. British Seagulls Ltd. (Fed. Cir. 1994)

The color black is *functional* for outboard motors: competitive need b/c the color is desirable.

Why?



Christian Louboutin

black suede 'Larissa Plato 150' platform sandals

LAWSUIT



Yves Saint Laurent

red suede 'Palais 105' platform pumps

Is the red sole mark invalid because of “aesthetic functionality” concerns? Court (dicta): “a mark is aesthetically functional, and therefore ineligible for protection under the Lanham Act, where protection of the mark *significantly* undermines competitors' ability to compete in the relevant market.”

Christian Louboutin v. Yves Saint Laurent America Holding, Inc. (2d Cir. 2012)



**Is the Abercrombie “look” protectable as trade dress?
Or is TM protection barred by the doctrine of functionality?**

**Abercrombie & Fitch Stores, Inc. v. American Eagle
Outfitters (6th Cir. 2002)**



John Deere (maker of *green* and yellow ag tractors, right) sued FIMCO (maker of green and yellow sprayers towed by JD tractors, left), for trademark infringement. Is the green/yellow color scheme *functional*? FIMCO products do not compete directly v JD products.



VS



New topic!

“It’s just a jump to the left ...”



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

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



VENUE IMAGES



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

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Is the mark “**Alaska**” registrable for dairy products?

What questions matter?

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

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

Arnold Palmer died in 2016.

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



A decorative frame made of pink, swirling lines that encircles the text "THE END".

THE END

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