

I. Types of Trademarks and the Rules Applicable to Their Qualifying as Trademarks

A. Overview

i. Common definition of trademark: A “source” identifier (even if the source is anonymous). They are defined by what they do, not what they are. In general however, they tend to be symbols (logos), words, numbers, phrases (slogans), color or color combinations, and “trade dress” (product or service features, design, ornamentation, or any other sensory perceived “device” that indicates to the consumer a unique source or sponsor of a product or service).

ii. Examples:

-POM Wonderful (bottle design)



-Tiffany (package color and design)



-Nike (logo)



-T-Mobile (mere color, used in numerous ways in advertising)



-Hershey (candy bar design of 3x4 rectangular sections)



-Apple (iPhone trade dress)



In all of these cases, the trademark is something that a consumer recognizes as being controlled by a single “source”, and that whenever they see the trademark they can be certain that the product is related in some way to that unique source (which means that all of the goodwill in the trademark is transferred to this other product, so consumers can make better decisions about buying products – their feelings about the trademark are used to form some opinion about this new product before they even try or consume it). It’s usually easier to understand these ideas in the realm of word trademarks but for the more exotic trademarks (often referred to generally as “trade dress”) the rules are not as intuitive, however they are now clearly set

according to various cases, some decided by the U.S. Supreme Court. Here's a simple example to illustrate that this is really a "know it when you see it" type of situation. Does this polka dot design tell you anything about the source of the sneakers?



How about this plaid design?



Why? (I hope your answers were 'no' and 'yes')

B. How is a trademark obtained?

- i. Registration - ® (gives you legal presumption of validity)
- ii. Under Common Law - TM or SM (you can claim you own, but you won't know if you're right until you sue someone and Judge or Jury agrees with you)

The Legal Test: Distinctiveness or Secondary Meaning

II. Word Marks

A. Categories of Word Marks

- i. Generic: refers to the genus to which a particular branded product is a species. Can never be trademarks; examples: SUV/smartphone/Yo-Yo/Ping-Pong (gotcha!...this is actually a trademark for table tennis equipment).



Genericide: Loss of Trademark

- A trademark becomes generic when it becomes associated with a thing instead of the source.

-Evidence of Genericness:

- a. Owner's own generic use of the term
- b. Third-party generic use of the term
- c. Dictionaries
- d. Media usage

-Examples:

- a. Escalator
- b. Trampoline
- c. Aspirin

- ii. Descriptive: immediately conveys information about the ingredients, qualities, or characteristics of the product. Descriptive terms are not protectable initially, but can be protectable with a showing of “secondary meaning”

-Examples:

- a. Chap Stick - it's for your chapped lips and is in stick form so its owner was only able to claim it as a trademark after it could prove that sufficient sales and advertising changed consumer perceptions to the point that it functioned as a brand (i.e. it has secondary meaning).

- b. Best Buy



Evidence that proves secondary meaning:

- a. Direct consumer testimony
- b. Consumer surveys
- c. Amount & manner of advertising
- d. Volume of sales
- e. Length & manner of use
- f. Competitors intentional copying

- c. Names of Persons

General rule is that a name of a person or a surname is descriptive without secondary meaning. This is because it is presumed that a name is so common that it cannot identify a single source of a product (i.e. the source can be any one of the people having this name).

Peaceable Planet v. Ty Beanie Babies



Peaceable Planet sold a camel stuffed animal named Niles. Later Ty sold a camel Beanie Babies also named Niles. Peaceable Planet sued Ty for trademark infringement.

The court didn't follow the general rule and determined that the name 'Niles' for a camel stuffed animal could be a trademark without a showing of secondary meaning, because in this unique case, the name refers to the camel and not the source of the product.

d. Geographic terms are also descriptive without secondary meaning.

Geographic term that clearly has secondary meaning:



iii. Suggestive: suggests rather than describes an aspect of a product; requires imagination, thought, and perception to reach a conclusion as to the nature of the goods. The difference between descriptive and suggestive is perhaps the most litigated and argued issue at the USPTO. It notoriously often seems to be purely subjective with cases often being decided in unpredictable ways.

-Examples:

a. Coppertone



b. facebook



c. LinkedIn

d. Twitter (“To utter a succession of light chirping or tremulous sounds”)



iv. Arbitrary: An existing word applied in unfamiliar way or contrary to normal meaning. Such words can be trademarks immediately and are said to be “inherently distinctive” (the category that ALL trademarks, whether words, logos, or product designs and packaging, must fall into to receive protection).

-Examples (words):

- a. Apple
- b. Google (a very large number...or is it suggestive?)
- c. Nickelodeon (an old music playing device)

v. Fanciful: A coined word that has no other meaning but the trademark. Also inherently distinctive. The “strongest” trademarks (given the broadest scope of protection by the law)

-Examples (words):

- a. Xerox
- b. XK



iii. Non-word marks and trade dress

A. Distinctiveness of Non-Word Marks

- i. *Star Industries v. Bacardi*



Is the Georgi O a trademark (i.e. is it inherently distinctive?). Can't use the categories for word marks because they make no sense (although in some cases, they can, as where a picture of an otherwise descriptive word can be considered descriptive). The test for design marks and product packaging is as follows:

Whether the design is a common basic shape or design;
whether it is unique or unusual in a particular field; whether it is a mere refinement of a commonly adopted and well-known form of ornamentation of goods; and whether the mark is capable of creating a commercial impression distinct from the accompanying words (if any). (the "Seabrook Test")

The Court held that Georgi's O design was not a common basic shape but that it had at least the minimal amount of stylization to render it inherently distinctive. It also held that it stood on its own sufficiently on the bottle that it could be protected by itself as a trademark apart from the rest of the bottle graphics, etc. Unfortunately for Georgi, the Court further held that although this mark was protectable, Bacardi's use of a similar orange O was not likely to cause consumer confusion and therefore was not an infringement.

B. Trade Dress & Distinctiveness

Trade Dress refers to the look of a product or its packaging, including the design, colors, ornamentation and shape of the product itself. It might be the overall design of a product or merely a particular distinctive feature of it.



i) *Makers Mark v Diageo*

After nine years of litigation, Diageo finally lost their fight when the Sixth Circuit Court of Appeals ruled that Maker's Mark has a valid trademark for its red dripping wax seal trademark and that Diageo, the owner of the Jose Cuervo brand had to cease using a similar red dripping wax seal. This trademark has been registered to Maker's Mark since the mid 1990s but as a legal matter was still subject to attack on the grounds of "functionality". Diageo insisted that a type of functionality, known as "aesthetic functionality" allowed Jose Cuervo to disregard the Maker's Mark trademark.

According to the doctrine of aesthetic functionality, there are certain product features that, if given trademark status, would put competitors at a significant non-reputational disadvantage in the marketplace if it could not use that trademark. This doctrine has limited applicability. A good example of aesthetic functionality comes from a case where the manufacturer of black outboard boat engines tried to claim trademark rights in its black colored engines but the Court found that black was aesthetically functional because black engines appeared smaller and matched boat colors, thus offering a strong competitive advantage and therefore could not be monopolized as a trademark. The Court easily dismissed this doctrine in the case of the red dripping wax seals, which offered no competitive advantage apart from reputational.



Landmark Supreme Court Cases on Trade Dress:

ii. Two Pesos, Inc. v. Taco Cabana (1992)

Plaintiff and defendant were both Mexican restaurants with bright colors and similar restaurant designs. Taco Cabana claimed the entire look of its restaurant to be their trade dress. This case resolved a question that was open at the time: “Can trade dress that is inherently distinctive be protectable without a showing of secondary meaning?” The lower court found that Taco Cabana’s trade dress was inherently distinctive (so it was presumed to be by the Supreme Court). The Court held that “inherently distinctive, nonfunctional trade dress is protectable without evidence of secondary meaning.”

iii. Qualitex v. Jacobson Products (1995)

Qualitex wanted trademark protection for the green/gold color of their dry-cleaning press pad. The Supreme Court held that a color alone can be registered as a trademark, but a color can never be inherently distinctive and proof of secondary meaning will always be required. It dismissed the arguments against protecting color, namely that colors could be depleted in a given market (Answer: This is not a practical concern because for products that are commonly colored, proving secondary meaning would be very difficult if not impossible) and shade confusion – the idea that courts would have a hard time comparing subtly different shades of color (Answer: Courts do the same thing all the time with word marks).

iv. Wal-Mart v. Samara (2000)

The issue in this case was what is the test for inherently distinctive product design (recall in *Two Pesos* the issue was whether trade dress *in general* could be inherently distinctive). Samara wanted a trademark for their “line of spring/summer one-piece seersucker outfits decorated with appliqués of hearts, flowers, fruits, and the like.”

The Court held that when it’s not clear if trade dress is product packaging or product design, it should be presumed to be product design. It further held that product design cannot be inherently distinctive under any circumstances and secondary meaning must be proven. The case was remanded to see if Samara could prove secondary meaning existed. So now, the law was finally clear on the tests for distinctiveness for different types of trademarks.

Trade Dress Distinctiveness

	Product Packaging	Unknown	Product Design
EXAMPLE	Pom bottle shape = source indicator - not mere decoration		Ugg boots
RULE	Capable of being inherently distinctive (and therefore protectable without evidence of secondary meaning)	Courts equate <i>uncertainty</i> with product design (<i>Two Pesos</i>)	Like color, not capable of being inherently distinctive; protectable only with evidence of secondary meaning
TEST	Inherent Distinctiveness tests: Seabrook (packaging) Abercrombie (words)		No test (can’t be inherently distinctive)

Other Cases:

iv. In Re Slokevage (2004)

It was just a matter of time before someone would try a run-around of the rule established by Wal-Mart by claiming that their trademark was not product design at all. In this case the Applicant for registration of a trademark that combined the words “Flash Dare” with a flap on the back pocket of jeans that when unbuttoned, exposed the wearer’s, well, whatever was under the jeans. Plaintiff, Slokevage, claimed that the back pockets of her jeans were product packaging and therefore could be inherently distinctive. Slokevage said that consumers usually associate the back pockets of jeans with source and because her back pockets were different consumers would automatically identify her as the source The Court didn’t buy this and classified this trademark as product design. So now, product design doesn’t have to be the overall design of a product, but merely a minor feature of a product.

