I. INTRO
   A. McSleep—holding in favor of McDonald’s
      1. likelihood of confusion—yes, survey evidence
      2. actual appearance in marketplace (comparison in marketplace)—appearance not similar but suggests ownership, sponsorship or association
      3. used in different but related markets—dining and lodging
      4. intent of infringer—intentional attempt to benefit from good will but not bad faith (no atty fees)
   B. Origins and Sources of Trademark Protection
      1. Consumer-oriented TM: protect them from being deceived, helping them identify
         i. Prestonettes: TM only gives the right to prohibit the use of it so far as to protect the owner’s good will against the sale of another’s product as his; cannot prevent use of words, only if it is deceiving
         ii. Stahly, Inc. v. M.H. Jacobs Co., 7th Cir. 1950—razor case pro consumer
            a. Razors were collateral for loan; lender given razors when manufacturer defaulted on loan
            b. Manufacturer signed consent letter for razors, waiving corporate interest in its trademark rights
            c. Ct holding: manufacturer cannot waive public’s right to be protected from defective goods
            d. Focus of TM and UC law is protecting the public
            e. Who should bear burden of labeling razors as defective?
               (A) Stahly (acquirer) should bear the burden since the razors were give as collateral with the understanding that they had value/were sellable; therefore, they are responsible for making them ready to sell
         iii. Ralph Brown—persuasive advertising should not be protected, only informative
         iv. Landes & Posner—TM lower consumer costs b/c reduces time searching for what they want
      2. Business-oriented TM: protect producers, good will
         i. INS v. AP—misappropriation of commercial value
            a. Granted AP protection against competitor during period of initial dissemination of the information to AP’s members
            b. Competitor can’t reap what it has not sown; AP invested labor
         ii. Hanover Star Milling: TM merely protect source/goodwill, not the product itself except in connection with an existing business—indicates ownership/source
         iii. Mishwaka Rubber: TMs are symbols and when they convey desirability, owners have something of value
         iv. Yale Elec. Corp.: one merchant shall not divert customers from another by representing what he sells as emanating from the other
         v. Alfred Dunhill Ltd. v. Interstate Cigar, Co., Inc., 2d. Cir. 1874—water damaged tobacco pro producer
            a. Insurance company seized water-damaged tobacco and permitted to sell tobacco as part of terms of insurance contract
            b. Ct: Acquirer doesn’t have to label; Dunhill should bear the burden of labeling goods because they could’ve prevented goods from being sold on salvage market
            c. Unfair for Dunhill to impose obligation to label on others and decrease value of goods
      3. distinguish Stahly and Dunhill:
         i. razors v. tobacco
         ii. actual potential harm of razors to public is greater than consumer dissatisfaction with tobacco
         iii. Stahly—completely focused on consumers
            a. Poor goods/defective
            b. Stop deception
         iv. Dunhill—completely focused on ™ Holders/producers
      4. Champion Spark Plug Co. v. Sanders (SC 1947)—remedy for consumer and producer
         i. Plaintiffs manufactured spark plugs
         ii. Defendants sold reconditioned plugs without notice of reconditioning
         iii. Whether or not they can use manufacturer’s ™? Yes. They’re second-hand but they’re still Champion spark plugs
            a. Must label “Repaired” or “Used”
            b. Full disclosure gives the manufacturer all the protection to which he is entitled
Demonstrating ™ holder/producer interests re: passing off and deception
c. consumer confusion/deception and value in used market wrt reconditioned spark plugs

5. Reasons against protecting TMs
   i. Trade-Mark Cases
      a. Not within constitutional protection for PT and ©
      b. Often result of accident rather than design
      c. No novelty, imagination, or labor necessary—simply priority
   ii. Jessica Litman—persuasive TMs discourage competition, takes away consumer choice; anti persuasive protection

C. What is a TM?
   1. Lanham Act § 45
      i. Mark
      ii. Trademark
         a. Word, name, symbol, comb
         b. Use in commerce
         c. Distinguish or identify goods
         d. Indicate source
      iii. Service mark—replace “goods” with “service”
      i. Identifies goals: protecting consumer and producers
      ii. “The essence of the wrong consists in the sale of the goods of one manufacturer or vendor for those of another.” (passing off)
      iii. concerned with leaving room for competitors
      i. “shredded wheat” is a generic term which describes the product/indicates source
      ii. upon expiration, product and name went into public domain
      iii. “shredded wheat” did not acquire secondary meaning—has to show that the primary significance of the term in the minds of the consuming public is not the product but the producer
      iv. Kellogg markets product in distinguishable manner—number of biscuits per carton, distinctive carton, size of Kellogg identification
      v. “Sharing in the goodwill of an article unprotected by patent or trademark is the exercise of a right possessed by all”
      vi. according to Rothman: holding in contemporary law is limited b/c it rests so heavily on expiration of the patent

II. TYPES OF MARKS
   A. Word Marks
      1. Coca-Cola Co. Koke Co. of America
         i. Coca-cola’s change in formulation did not constitute fraudulent representation of the mark
         ii. Acquired secondary meaning, product more emphasized than producer
      2. Donald Trump’s “You’re Fired”
   B. Slogan
      1. as long as it is distinctive, can be a TM
      2. if merely descriptive, must acquire secondary meaning (Clairol case: billions on advertising)
   C. Trade Dress
      1. General
         i. the appearance of a container or package on a good
         ii. expanded to décor and shape and design of product
         iii. needs to indicate source and have secondary meaning; cannot simply be attractive product feature
         iv. cannot be functional (ie bright color of safety ear plugs)
         v. can be registered like ™ on federal registry
         vi. unregistered trade dress are protected like unregistered ™ (§ 43)
         vii. distinction originates in common law: originally, trade dress breaches could only be brought under unfair competition; distinction no longer exists
      2. Qualitex Co. v. Jacobson Products Co., Inc.—color
i. SC reversed saying that color can be registered if it has secondary meaning but is not functional
   a. In this case, however, color is not special and is functional because else, there would be a stain on the clothes
ii. cannot ™ the functional features of a color: ex orange marmalade, mint toothpaste
   a. if element is essential
   b. if element affects the cost of produce or purchase

D. Other Identifying Indicia
1. Scent
   i. Scented thread is protectable
      a. Not inherent attribute or natural characteristic of good
      b. Feature supplied by applicant
      c. Emphasized in advertising → established source of good
   ii. cannot protect scents or fragrances of products which are noted for those features—perfumes, colognes, scented household products

2. Sounds
   i. TM only after showing ppl recognize and associate the sound w services offered and/or rendered exclusively with single, albeit anonymous, source
   ii. Merely arbitrary, unique, or distinctive not enough
   iii. Ex: Intel musical notes, AT&T spoken words

III. ACQUISITION OF TRADEMARK RIGHTS
A. Distinctiveness
   1. Abercrombie—arbitrary, fanciful, suggestive, & descriptive terms
      i. Generic → automatic no protection
      ii. Arbitrary, fanciful → automatic protection
      iii. Descriptive → must have secondary meaning for protection
      iv. Suggestive
         a. Neither fanciful nor descriptive
         b. Requires imagination
         c. Entitled to registration without proof of secondary meaning
   2. Inherently Distinctive Marks
      i. Application of Reynolds Metals Co. — BROWN-IN-BAG™
         a. Mark is not merely descriptive
         b. Words themselves are not TM, but hyphenated combination is
      ii. In the Matter of the Application of Quik-Print Copy Shops, Inc.
         a. “QUIK-PRINT” is merely descriptive b/c the quality or essential characteristic of service immediately comes to mind: quick
      iii. “Labrador Software”
         a. LS sued Lycos for using their black lab for rival search engine
         b. Proliferation of labs in search engine industry → descriptive rather than suggestive
      iv. In re Oppendahl—Patents.com: .com is merely descriptive b/c it’s not source-identifying
   3. Technical TM
      a. Arbitrary, fanciful, or suggestive
      b. Policy rationale:
         (A) Inevitably recognized as TM
         (B) Doesn’t prevent competition from describing goods
         (C) Producers/competitors require certainty regarding TM status of term so that they know what to avoid, etc.

3. Acquisition of Secondary Meaning
   i. Intn'l Kennel Club of Chicago v. Mighty Star, Inc.
      a. D marketed tog toys under Internatl Kennel Club
      b. IKC of Chicago coordinates dog shows → no direct competition
      c. Name is descriptive → must have secondary meaning → IKC of Chi does
         (A) Amount invested in advertising, volume of sales, etc.
         (B) Actual confusion
         (C) History of use
ii. *Donchez v. Coors Brewing Company*
   a. “Bob the Beerman” of Colorado Rockies v. Coors’ “beerman”
   b. Ct: no secondary meaning b/c not enough evidence of actual confusion

4. **Trade Dress**
   i. *Two Peso Inc v. Taco Cabana*—product packaging does not need secondary meaning
      a. Mexican restaurant interior
      b. Trade dress must be
         (A) Non functional AND
         (B) Descriptive with secondary meaning OR
         (C) Inherently descriptive
      c. **Inherently distinctive trade dress does not require secondary meaning**
      d. Owners have propriety interest in unique design—opinion does not consider consumers’ interest/confusion
   
   ii. *Wal Mart v. Samara Brothers*—product design requires secondary meaning
      a. Children’s clothing design
      b. **Product design** requires secondary meaning
      c. Consumer-oriented policy: benefits of competition

B. **Adoption and Use**

1. *P&G v. Johnson & Johnson*—“minor brand program” not “in commerce”
   i. Need more than sporadic and causal use to be “in commerce”
   ii. P&G did not demonstrate intent to bring product to market

2. *Larry Harmon Pictures Corp. v. Williams Restaurant Corp.*—one restaurant is “in commerce”
   i. Bozo the Clown v. BOZO’s restaurant
   ii. One location that serves interstate customers is enough to est “in commerce”

3. *DaimlerChrysler AG v. Bloom (1800 Mercedes)*—licensing use of a number is not “in commerce”
   i. Mere licensing of phone number without active promotion or advertising of the mark is not “use” of the mark
   ii. Licensee did not register, advertise, or incorporate mark into a web page
   iii. Initial confusion and diversion from actual Mercedes number doesn’t matter

4. **Pop Up Ads, Keying, Triggering Techniques**
   i. Mixed rules
   ii. *1800 Contacts v. WhenU.com*
      a. use of 1800 Contacts’ address in unpublished triggering directory does not “use” TM
      b. WhenU’s pop up ads don’t display 1800 Contacts’ TM and do not interfere with 1800’s site
      c. Categorical associations rather than selling of keywords or TMs
   iii. *Playboy v. Netscape*
      a. Playboy succeeded on dilution claim b/c ct assumed TM used in their advertisements
      b. Keywords produced banner ads top or side of search page
      a. Google’s AdWords allow advertisers to purchase or bid on certain keywords
      b. Upholds *Playboy*
      c. Denies motion to dismiss
      a. Ads appear in separate window
      b. “use” not est just b/c simultaneously visible
      c. does not sell TM/keyword to advertisers—does not advertise or promote TM (1800 Mercedes)
      d. does not interfere with/hinder/impede use of website
   vi. *Wells Fargo & Co. v. WhenU.com* (meta tags—consumers don’t see use of TM)
      a. Use of TM in scrambled directory is not “use”
      b. Doesn’t use TM to indicate the source of anything it advertises

5. **Extraterritorial Use**
   i. *Buti*—Italian café owner advertising Italian café in U.S.
      a. Mere advertising or promotion without actual rendering of services or goods is insufficient to establish protection.
      b. Exceptions (where protection will be granted to foreign users):
(A) Famous mark exception
(B) Bad faith exception: if the US user expressly adopted the foreign users name to get their publicity or good will.
(C) Test-marketing. Impressa tried to use this, but was unsuccessful

ii. **Internatl Bancorp v. SBM**
   a. Monte Carlo casino v. online gambling company using MC name
   b. MC casino advertises in U.S. \(\rightarrow\) protectable

6. **Domain Name**
   i. use of a mark on a domain name and whether or not it is a use ties back to source identifying
   ii. If the mark only serves as an address, or a contact, then it is not a use
   iii. not considered to be distinctive, so wouldn’t be protected in that sense either.

C. **Ownership**
   1. **Bell v. Streetwise Records ("New Edition")**
      i. Record producer v. performer
      ii. Priority
         a. Priority determined by who controls nature and quality of the goods
         b. New Edition had first use (doesn’t have to be interstate) \(\rightarrow\) they have priority
         iii. Group members not replaceable & producers only did normal functions (according to industry standards) \(\rightarrow\) performers have control
   2. **Robi v. Reed ("The Platters")**
      i. Widow of member v. founder
      ii. Member did not have right to confer to wife
      iii. Founder was only consistent member of group \(\rightarrow\) retained control over quality of services

D. **Priority**
   1. **Lanham Act**
      i. §1(b): Intent to use
      ii. §7(c): Constructive use
   2. **Priority via Sales**
      i. **Blue Bell, Inc. v. Farah Manufacturing Co. ("Time Out")**
         a. Use of identical TM for men’s clothing
         b. Priority based on first sale to PUBLIC, not sample sale
      ii. **Lucent Info. v. Lucent Tech**—priority in geographic area
         a. Factors for priority use
            (A) Volume of sales
            (B) Growth trends
            (C) Number of persons purchasing product in relation to potential number of customers
            (D) Amount of product advertising
         b. “de minimis” sales (less than $5000 and less than 50 customers for any specific region) are not enough
      iii. **Herbko Int'l v. Kappa Books, Inc. ("Crossword Companion")**
         a. Use of single book does not create an association between book’s title and the source of the book
         b. Book titles of single works are not inherently distinctive b/c they ID book, not source
         c. Title of series can est priority with timeliness (between books) AND public association
   3. **Priority via Analogous Use**
      i. **Shalom Children’s Wear v. In-Wear A/S ("BODY GEAR")**—analogous use v. intent to use
         a. analogous trademark use priority has priority over intent to use application priority
         b. **analogous use**: non technical use of TM in connection with sale or promotion of a product under circumstances which does not provide a basis for application to register, usually b/c statutory requirement for use on or in connection with sale of goods in commerce has not been met
      ii. **Maryland Stadium Authority v. Becker ("Camden Yards")**
         a. As long as analogous use occurs within timely manner of actual use, use totality of circumstances test
            (A) Business plan
            (B) Publicity
Promotional events

Public interest

b. Stadium developer v. t-shirt seller
c. Camden Yards means baseball (secondary meaning)
d. MSA only has rights when used in connection with baseball

4. **Priority for foreign marks**
   
a. **Group Gigante SA v. Dallo & Co. (“Gigante”)**—Mexican grocery store
   
   a. Normally, territoriality rule applies
   
   b. Exception for famous foreign marks
   
   A. Est secondary meaning in U.S.
   
   B. Substantial percentage of consumers in U.S. market is familiar with foreign mark

E. **Concurrent Use**

1. **United Drug Co. v. Theodore Rectanus Co. (“Rex”)**
   
a. First user can have priority in geographic area first registered has not reached/developed (if used in good faith)

2. **Thrifty Rent-A-Car v. Thrift Cars**
   
a. Thrift Cars limited had limited geographic scope in Mass.
   
b. Limited area exception for junior user only if
   
   a. Likelihood of confusion
   
   b. Adopted mark prior to registered user without prior knowledge of registered’s prior use
   
   c. Mark used continuously in that location
   
   A. Limited advertising not enough
   
   B. Initially in good faith without notice of an infringing mark
   
   iii. rights frozen to area where use est prior to registration

3. **Dawn Donut Co. v. Hart’s Food Stores (“Dawn Donuts”)**
   
a. § 33(b)(5) does not apply when use occurred after registration an have knowledge of prior use
   
b. after registration, there is no good-faith adoption (§22)
   
c. no injunction b/c no likelihood of confusion

4. **V&V Food v. Cacique Cheese (“Rancherito”)**
   
a. Senior user requested amendment to injunction that barred it from advertising in limited area b/c it couldn’t advertise on national Spanish channels that were broadcast in limited area
   
b. Lost competitive edge in non-limited area ct modified injunction
   
c. Rejected request for national Spanish radio and national English media
   
   a. Radio ads are local and can easily avoid limited area
   
   b. Regional campaigns are feasible with national English media

5. **Pure Imagination Inc. v. Pure Imagination Studios, Inc.**—internet
   
a. Both website design services
   
b. Junior user’s first use was still after senior user’s first use
   
c. Dicta on limiting area on internet:
   
   a. Must prove use in specific markets
   
b. Evidence of type and amount of activity
   
c. Continuously offer services since first sale

F. **Intent to Use**

1. **Lanham Act § 1(b)**
   
a. Bona fide intention under circumstances of good faith to use the mark in commerce.
   
b. Application needs to set forth the goods, the person who is filing, and a drawing of the mark.
   
c. Statement that there is no one else, to your knowledge, using the mark, and there would be no likeness of confusion.
   
   d. 6 month period to file showing of actual use. At end of that, you can get another 6 months extension. Can get more, but no more than 24 months, if you can show good cause. Can get 6 months, plus 24 months. Not 24 months total.

2. **Policy rationale**
   
a. Disadvantage to foreign applicants who TM in other countries that allow intent to use
ii. Legal uncertainty & large financial investment for business in developmental stages
iii. Minimizes need for “token use”
   a. Lots of unused TM (P&G)
   b. Expensive for large items (airplanes)
3. Zirco Corp v. American Telephone & Telegraph Co. ("DATACELL")
i. to establish date of priority, look to the date that ITU was filed, not when actually registered
ii. ITU established constructive use
iii. If you allowed another person to take a mark that was registered but hadn’t but used and applied it to their good that had already been used, it would defeat the purpose of the ITU system.
iv. But, if the ITU user didn’t use their mark within requisite time, then other party could use it.
4. WarnerVision Entertainment Inc. v. Empire of Carolina, Inc. ("REAL WHEELS")
i. Can’t enjoin mark that has ITU pending
ii. But ITU applicant can’t prevent others from using it either, in case the ITU applicant fails to follow through
i. B&H filed ITU for “6200,” “6800,” and “8100” for microform readers/printers
ii. Kodak opposes b/c merely descriptive of model numbers
iii. Numerical model numbers may require secondary meaning OR they may be inherently distinctive
iv. Cannot decide until use, thus grant ITU
6. In re TM App of American Psychological Assoc. ("PSYCHOLOGICAL METHODS")
i. Kodak limited to when it is the manner in which designation is used that renders it descriptive
ii. Congress intended Board to review descriptiveness at first review of ITU
iii. Title of journal is merely descriptive of the subject matter of the publication
7. Racing Champions, Inc. v. Mattel, Inc. ("1/64th")
i. 1/64th is mere descriptive as an indicator of scale not model designation (Kodak)
ii. has preexisting meaning that goes towards its descriptiveness/non-descriptiveness

IV. REGISTRATION
A. Procedure for Registration
1. Trademark search: hire outside search agency to search USPTO, trade listings, Chambers of Commerce lists, The Official Gazette (USPTO publication)
i. Trademark report: see what conflicts there are and decide whether or not you may still prevail if there is a conflict
2. File application: most done electronically
i. Follow guidelines set by USPTO
ii. Follow guidelines in § 1 for regular registration under Lanham Act
3. Examined by TM attorney @ USPTO to see if TM is registerable
i. Meet procedural requirements
ii. Consider there are other bars to registration (see § 2)
iii. To appeal denial: Trademark Appeal Board (TAB) → District Ct OR Cir Appl
4. Published for opposition in “The Official Gazette” (§ 12)
i. Opportunity for ppl to oppose the TM before it’s approved officially (§ 13?)
ii. 30 days to oppose TM
5. Notice of registration in “The Official Gazette”
i. If under §1(b) → notice of allowance
6. After 5 years of continuous use → uncontestable
B. Registration advantages
1. nationwide protection from date of application
   i. unregistered → common law protection limited in areas where mark had actually become known or used
   ii. priority over good faith user whose first use is after senior user’s first but before registration
2. incontestability if used continuously for 5 years
3. warning to others—easily found in TM searches
4. barring imports—goods produced abroad bearing registered mark may be blocked @ Customs
5. protection against counterfeiting—more remedies available against counterfeitters of registered TM
6. evidentiary advantage—registered mark has presumption of right (challenger must overcome presumption); prima facie valid
7. use of ®
8. confirms ownership and validity
9. gives constructive notice (§ 22)
C. Supplemental registry (§ 27)
1. Mark is capable of distinguishing goods
2. Not constructive notice
3. Not admission that it’s not secondary meaning
4. Discourage others from adopting your mark by being on a registry
D. Bars to Registration
1. Lanham Act § 2(a)-(e)
2. Immoral/deceptive/scandalous/disparaging—absolute bars to registration (§2(a))
   i. immoral
   ii. deceptive
   iii. scandalous
   iv. disparages
   v. falsely suggests connection
   vi. brings into contempt or disrepute
   vii. Standing
      a. Real Interest Test
         (A) opposer has to show “real interest” in the outcome of the proceeding
         (B) direct and personal stake
         (C) belief must be reasonable and reflects a real interest in the issue
      b. “Reasonable” Belief of Damage
         (A) can use signed petition as evidence that others share view of being damaged
viii. Deceptively Misleading v. Deceptive
   a. Deceptive marks cannot be saved by secondary meaning
   b. Deceptively misleading are barred save showing of secondary meaning
   c. DECEPTIVE MISLEADING TEST (Fed. Cir. “Lovee Lamb” seat covers)
      (A) Is the term misdiscriptive of the character, quality, function, composition or use of the goods?
      (B) If so, are the prospective purchasers likely to believe that the misdescription actually describes the goods?
         (1) No—mark may be arbitrary or suggestive
         (C) If so, is the misdescription likely to affect the decision to purchase?
            (1) No—deceptively misleading
            (2) Yes—deceptive
ix. In re Bad Frog Brewery, Inc. (frog’s middle finger)
   a. frog depicted as “giving the finger”
   b. examining attorney did not find it obscene
   c. Trademark Appeal Board reversed original decision
   d. Obscene is not a bar to registration ➔ must be immoral or scandalous
      (A) First Amendment has exception when speech rises to the level of being obscene
x. Pro-Football v. Harjo (Washington Redskins)
   a. TEST FOR DISPARAGEMENT
      (A) What is the meaning of the matter in question, as it appears in the marks and as those are marks are used in connection with the services identified in the registrations?
         (1) Historical meaning associated with Native Americans
         (2) Meaning associated with football maintains original meaning associated with Native Americans
      (B) Is the matter in question is disparaging (to the referenced group)? NO
         (1) Fewer Native Americans than gen public in poll found it disparaging
         (2) Public/media’s negative association with Native Americans is not relevant
         (3) Could not establish opinion of “substantial composite” of Native Americans
   b. relevant time period for meaning is at the time of registration
(A) TTAB didn’t evaluate perception at time of registration
(B) Difficult to assess meaning at prior time
c. **Contempt or disrepute?** Yes, same rationale as disparagement

3. **§ 2(b): absolute bar for use of NATIONAL INSIGNIA & FLAGS**
   i. flags and coat of arms
   ii. national insignia
      a. interpret narrowly
      b. if it’s just department insignia which are merely used to identify a service or facility of the Govt are not insignia (ie, “National Park Service”)

4. **§ 2(c): absolute bar on NAME, PORTRAIT, or SIGNATURE of particular living individual or deceased U.S. President without consent**
   i. name, portrait, or signature
      a. president’s life or life of his widow
      b. doesn’t have to be full name (Prince Charles)
   ii. particular living individual or deceased president

5. **§ 2(d): confusing mark**
   i. *Nutrasweet Co. v. K&S Foods, Inc. (“NUTRA SALT”)*
      a. Likelihood of confusion—YES
      b. Products sold side by side
      c. “nutra” widely advertised and known
      d. no actual confusion doesn’t matter when sales have been de minimis
   ii. **13 factored test for Fed Cir**
      a. similarity of the marks, including appearance, sound
      b. similarity of the goods
      c. similarity of the trade channels or market
      d. condition of the sales whether its sophisticated purchase or impulse purchase
      e. fame of the prior mark
      f. use of similar marks on similar goods (lots of other ppl using same mark)
      g. actual confusion
      h. length of time during which there has been use of both marks
      i. types of goods on which a mark is or is not used
      j. market interface b/t applicant and owner (similar to trade channels)
      k. extent to which applicant has right to exclude others to use its rights
      l. the extent of potential confusion
      m. any other established fact probative of effective use
   iii. *Marshall Field & Co. v. Mrs. Fields Cookies*
      a. Marshall Field’s had first use priority but Mrs. Fields may also use
      b. **Likelihood of confusion analysis**
         (A) Relationship between parties’ goods and services—YES
            (1) Marshall Field’s has bakery in store and sells baked goods under “Field’s”
            (2) Mrs. Fields sells cookies and brownies
         (B) Similarity of marks—NO
            (1) Famous mark—Marshall Field’s is famous but “Field(s)” is a common surname
            (2) Mrs. and Marshall is enough to distinguish two marks
            (3) Mrs. Fields achieved significant fame
      c. adopted in good faith

6. **§ 2(e): Geographic terms**
   i. *American Waltham Watch Co. v. United States Watch Co.*
      a. “Waltham” is a geographic term (Mass.)
      b. Enjoined junior user of “Waltham” from using it on the dial even though that’s where they make the watches
      c. Senior user has secondary meaning
   ii. **Primarily geographically deceptively misleading**
      a. *In Re Nantucket, Inc.—“primarily geographical”*
         (A) Rejects TM Bd’s “readily recognizable geographic meaning” test
(B) **Primarily geographically deceptively misleading**
   (1) Primarily geographical term AND
   (2) Public associates goods with the geographic place
   (C) no public association of Nantucket with shirts

b. **In re California Innovations, Inc.**
   (A) Goods (insulated bags and wraps) do not originate in California
   (B) **3 prong test**
   (1) primarily geographical term
   (2) goods-place association
   (3) association is material to consumer’s decision to purchase goods

iii. **Geographically suggestive marks**
   a. do not describe the place of the goods’ origin, but conjure up desirable associations with the place whose name the goods or services bear
   b. “ALASKA” is suggestive for ice cream but is susceptible to private appropriation

7. § **2(e): Surnames**
   i. not absolute bar; must est secondary meaning
   ii. **In re Quadrillion Publishing Ltd (“BRAMLEY”)**
      a. Board est prima facie case for refusal with:
         (A) 80 million names associated with Bramley
         (B) word not listed in dictionary
      b. **Surname factors**
         (A) Degree of surname rareness—not rare
         (B) Whether anyone connected w applicant has the surname—no
         (C) Whether the term has any recognized meaning other than that of a surname—U.S. consumers would not recognize name of tiny English village
         (D) The structure or pronunciation or “look and sound” of the surname—common

8. § **2(e)(5): Functionality**
   i. **Morton-Norwich Test**: the mere fact that a product has utility does not necessarily preclude registration of its configuration; registrability depends upon the degree of design utility
   ii. **In re Morton-Norwich Products (spray bottle)**
      a. De jure vs. de facto functionality
         (A) de facto → “functional” in the lay sense of the word…although the design of a product is directed to performance of a function, it may be legally recognized as an indication of source.
         (B) de jure → such a design may not be protected as a trademark
            (1) **Functionality Test**—Essential to use
               (i) Alternative designs (is the feature ornamental or arbitrary?)
               (ii) Expense
               (iii) Advertisement
               (iv) Utility Patents
      b. We wish to make clear that a discussion of “functionality” is always in reference to the design of the thing under consideration (in the sense of its appearance) and not the thing itself.
   iii. **In re Babies Beat Inc. (baby bottle)**
      a. Degree of de jure too high
      b. Grippers allow easy grip
      c. Shape allows easy cleaning
   iv. **Talking Rain Beverage Co. v. South Beach Beverage Co. (“bike bottle”)**
      a. Bottle is functional
      b. Promotion—“Get a grip” → functional
      c. Design → grip is easy to hold and provides structural support
      d. Utilitarian → fits bike bottle holders
   v. **In re Weber-Stephen Products Co. (bbq grill)**
      a. Morton-Norwich functionality Factors
         (A) Utility Patents
         (1) Does not disclose utilitarian function of design
         (B) Promotion
(1) Suggests functionality (“it’s round for a reason”)
(2) Clearly indicated on the useful features but why didn’t the court give this weight?

(C) Other Designs
(1) The variety of other shapes suggests that it’s non-functional

(D) Cost and ease of alternatives
(1) Non functional because it’s no cheaper than other designs
b. refusal to register reversed

V. LOSS OF TRADEMARK RIGHTS
A. Genericism
1. Lanham Act § 14
2. Lanham Act § 15
   i. Recently expired patent of Aspirin; Bayer sued generic manufacturer
   ii. Common law TM suit
   iii. Two classes of buyers: MD v. consumers
   iv. Consumers only associated “aspirin” as an ingredient, not the manufacturer
   v. “aspirin” passed into public domain as generic name of drug
4. contact paper case: use must be in good faith, not to induce genericide
5. Factors in Genericism
   i. Packaging
   ii. Use of term
      a. Noun—suggests generic
      b. Verb—generic
      c. Adjective—nongeneric
   iii. alternate terms
   iv. advertising & promotion
   v. 3d party uses
   vi. Public awareness/use → surveys, dictionaries
   vii. Functional
   viii. Foreign meaning
   ix. Dual meaning
6. Survey evidence
   i. King-Seely Thermos Co. v. Aladdin Industries (“Thermos”)
      a. Asked “what is a synonym for ‘vacuum insulated’ container” → answer was “Thermos”
      b. Defendant can use “thermos” but there are limitations
         (A) Must indicate that it’s Aladdin’s thermos
         (B) Must use lowercase “t”
         (C) Never use “original” or “genuine”
   ii. McSleep
      a. Ct found that random mall intercept survey inherently biased
      b. Randomly sampled telephone callas not?
   iii. Anti-Monopoly, Inc. v. General Mills Fun Group—9th Cir used “motivation survey” to inquire
        whether ppl cared about who manufactured it or if they just wanted to play
   iv. Congress rejected survey for “significance of registered mark to the relevant public”
      a. Teflon won
      b. Teflon survey
         (A) Focuses on difference between a brand and a word
         (B) Explained difference between the two and asked whether each of eight names, including
             TEFILON was brand name or common name
         (C) 68% identified TEFILON as brand name, 31% as common name
         (D) this survey is more likely to produce that something is a brand name
7. De facto secondary meaning
   i. Has secondary meaning but no TM (Shredded Wheat)
ii. Policy rationale: generic words or commonly recognized name for goods must be free competitive use

iii. **AOL v. AT&T**
   a. AOL sued AT&T for use of Buddy List, IM, and “You Have Mail”
   b. “Buddy List” is possibly suggestive (registered)
   c. “You Have Mail”: not enforceable in connection with email notification service
      (A) functional—consistent with phrase’s common meaning
      (B) others in relevant industry use it
   d. IM: not generic but not enough evidence to indicate source

iv. **Harley Davidson v. Grottanelli (“Hog”)**
   a. Manufacturer with product identified by a word that is generic must rely on its tradename to identify its products
   b. **A word that starts as generic, stays generic**

v. **Sake case**—ct must consider generic meaning of foreign words b/c foreign-speaking customers may be confused

vi. **Microsoft Corp. v. Lindows.com, Inc.**
   a. “who-are-you/what-are-you” test: primary significance of the term to the relevant public
      (A) if answers, Who are you? OR Where did you come from? → valid TM
      (B) if answers, WHAT are you? → generic

B. **Abandonment**
   1. **Non Use**
      i. Lanham Act § 45
         a. No use AND
         b. No intent to resume—assumed after 3 years of non use
      ii. **Silverman v. CBS (“Amos ‘n’ Andy”)**
         a. 20 years since CBS used mark
         b. sporadic non-commercial licensing of mark is not use (for documentaries)
         c. abandoned by no intent to resume
   iii. **ITC Limited v. Punchgini (“Bukhara Indian restaurants”)**
         a. Had not used mark in over three years but claimed intent to resume
         b. 5 unsolicited proposals/negotiations do not constitute use

2. **Assignment in Gross, Naked Licensing, Failure to Police**
   i. Lanham Act § 10
   ii. **Clark & Freedom Corp. v. Heartland Co. Ltd (“Heartland”)**—assignments in gross
      a. In gross: without accompanying goodwill
      b. Assignment invalid and assignee must rely upon own use to est priority
      c. Sears’ ceased production has no bearing on whether or not it was valid
      d. **Goods must be substantially similar**—whether or not customers would not be deceived or harmed
         (A) Sears: women’s pixie boots
         (B) Heartland: only men’s shoes
         (C) Ct: substantially distinct
   iii. **Yocum v. Covington (“PIED PIPERS”)**—naked licensing
      a. Unsupervised, uncontrolled licensing agreements for music groups → abandonment
      b. Lack of intent to abandon is irrelevant
   iv. **Barcamerica (wine producer)**
      a. Barcamerica did not police their mark → naked licensing
      b. Barcamerica claimed that owner was randomly tasting the wine
         (A) Ct: No system, no regularity
      c. Barc claimed that licensed to famous winemaker
         (A) Ct: winemaker was dead
      d. Ct: not enough to show quality control
         (A) Ct left open a lot of unanswered questions as to what is enough for quality control
         (B) Quality needs to be same as quality of trademark holder → low/high quality not relevant; just need to ensure that consumers are not confused
(C) Intent is not necessary for finding of abandonment
(D) Needs to be clear that you haven’t just given away your trademark and are in some way controlling the product given to consumers

v. University Bookstore v. Board of Regent (“WISCONSIN BADGERS”)
a. sports merchandising
b. Ct: failure to police doesn’t matter b/c apparel imprinted with marks remained at an acceptable level in virtually all instances

VI. INFRINGEMENT
A. Direct Infringement
1. Likelihood of Confusion
   i. Lanham Act § 32
   ii. EIGHT Polaroid Factors
      a. STRENGTH OF PLAINTIFF’S MARK
      b. DEGREE OF SIMILARITY BETWEEN MARKS
         (A) Look at sight, sound, and meaning
         (B) ERTEC v. ERT
            (1) One script, one block font
            (2) 9th Cir found similarity in sound and appearance
            (3) initials require less degree of similarity b/c comprehended at a glance
         (C) similar meaning
            (i) confusion
               (a) roach traps—roach motel and roach hotel
               (b) artificial x mas trees—mountain king and alpine emperor
            (ii) no confusion
               (a) restaurants—EL Saturdays and TGI Friday’s
               (b) food products—healthy selections and healthy choice
      c. PROXIMITY OF PRODUCTS OR SERVICES
         (A) Medic Alert Foundation v. Corel (medic clipart)—endorsement
            (1) Source confusion v. approval confusion
            (2) No evidence of source confusion; issue: whether or not consumers in software market are likely to think endorsed or affiliated
            (3) NO b/c products are unrelated
      d. LIKELIHOOD P WILL BRIDGE GAP
         (A) In re Unilever Limited (“CLAX” v. “CLAK”)
            (1) Industrial laundry detergent v. cleaner for food processing plant
            (2) Similar in sound and sight
            (3) No confusion b/c not in competition with each other, different customers
      e. EVIDENCE OF ACTUAL CONFUSION (misdirection—missed calls, emails, letters)
      f. D’S GOOD FAITH IN ADOPTING MARK
         (A) Knowledge (Gallo)
         (B) Intent to confuse (Kendall Jackson)
         (C) Intent to adopt same or similar mark
      g. QUALITY OF D’S PRODUCT OR SERVICE
      h. SOPHISTICATION OF BUYERS
   iii. A & H Sportswear v. Victoria’s Secret: possibility of confusion is not enough, must be probable; discourages competition
   iv. Gallo Winery v. Gallo Nero
      a. U.S. winery v. Italian trade association
      b. Ct: CONFUSION
         (A) Strength of mark—US winery wins
            (1) Registration
            (2) Secondary meaning in U.S.
         (B) Similarity of marks used—US winery wins
            (1) Surrounding terms irrelevant b/c US winery combines “Gallo” with types of wine
            (2) Presentation on bottle—ct looks to UK and Canadian findings
(C) Similarity of goods sold—similar goods
   (1) All varieties of wine are the same
   (2) Even though US doesn’t produce chianti and Italian only produces chianti, in competition w each other/red wines

(D) Similarity of marketing channels used—same retail channels

(E) Degree of care exercised by purchasers (sophistication of buyers)—little
   (1) Wine is “impulse” purchase
   (2) Avg American wine drinker is unlearned in selection of wine

(F) Evidence of actual confusion
   (1) Italian wine hasn’t been sold in US yet—only side by side surveys
   (2) Some evidence of confusion in surveys is enough

(G) Intent
   (1) No bad faith but Italian assoc. was aware of “Gallo” at time of adoption
   (2) Canada & UK findings

v. Banfi v. Kendall-Jackson (COL DI SASSO v. COLLINI DI SASSI)
   a. Italian wine importer v. US winery
   b. No likelihood of confusion
      (A) Strength of Mark—weak; Banfi wins
         (1) Arbitrary—extensive 3rd party use
         (2) Minimal advertising expenditures
         (3) Limited scale distribution
      (B) Similarity between two marks—dissimilar
         (1) See—3 words w hyphens v. 5 words no hyphens; labels are different
         (2) Sound—different
         (3) Meaning—hill of stone v. little hills of stone
      (C) Proximity of products—different
         (1) Blended, everyday wine v. high-end special occasion
         (2) No evidence of being sold in same location (retail or restaurant)
         (3) One only by the bottle, one by the glass
      (D) Bridging the Gap—no
         (1) No evidence to bridge
      (E) Actual Confusion—none
      (F) Intent—good faith adoption
      (G) Quality of D’s Product—similar quality
      (H) Sophistication of buyers—wine purchasers are likely to be older, sophisticated, wealthier, and better educated

vi. Mobil Oil Corp. v. Pegasus Petroleum Corp. (flying horse)
   a. Found confusion using Polaroid

vii. Initial Interest Confusion
   (A) Playboy Enterprises v. Netscape (“playboy” and “playmate”)—initial interest confusion
      (1) Unlabeled banners when marks typed in as keywords
      (2) Initial interest confusion
         (i) Creates initial interest in competitor’s product
         (ii) Dispelled before actual sale
         (iii) Impermissibly capitalizes on goodwill associated with mark
      (3) Internet factors for likelihood of confusion
         (i) Actual Confusion—yes; survey questionable but issue of material fact (no summary judgment)
         (ii) Strength of Mark—PB created secondary meaning ➔ issue of fact
         (iii) Proximity of goods—yes
         (iv) Similarity of marks—yes
         (v) Marketing channels used—yes
         (vi) Type of goods—low price, adult-oriented ppl easily diverted
         (vii) Defendant’s intent—favors PB
         (viii) Bridge—already related
(4) majority favor PB  

(B) **Brookfield Communications v. West Coast Entertainment Corp. (“movie buff”)**  
(1) Movie buff software v. video rental co.  
(2) Brookfield has priority use of “moviebuff”  
(3) West Coast uses “moviebuff” in meta tags  
(4) Initial confusion  
   (i) Customers know they’re patronizing West Coast but diverts from Brookfield’s site  
   (ii) Improper benefit from goodwill  
   (iii) Can use the words with a space, but the one word is not descriptive  
(5) can use MovieBuff to refer to Brookfield’s product (like comparative advertising) but not to attract to its own site  

(C) **Munsingwear, Inc. v. Jockey International (H fly underwear)***  
(1) Injunction denied  
(2) Munsingwear has no federal registration but continuous use of design  
(3) Pre-sale confusion is more relevant  
   (i) Underwear is not seen by other ppl → potential for customer confusion is less  
   (ii) Inherently concealed nature of worn underwear diminishes the concern for post sale confusion  
(4) Likelihood of confusion  
   (i) Similarity—packaging not similar  
   (ii) Proximity—close proximity but function of market  
   (iii) Intent to pass off—no intent to pass off  
   (iv) Actual confusion—no  
   (v) Costs and conditions of purchase—inexpensive but favors neither party  

viii. **Reverse Confusion**—when a larger, more powerful entity takes advantage of the reputation and good will of a senior trademark owner by adopting a similar or identical mark; senior user loses value of the trademark  
   a. **Harlem Wizards Entertainment Basketball v. NBA (“Wizards”)**  
      (A) No likelihood of confusion  
         (1) Different channels of trade  
         (2) NBA fans sophisticated  
         (3) Different audiences  
   b. **Dreamworks Production, Inc. v. SKG Studio (“Dreamwerks”)**  
      (A) Similarity of the mark—yes for sight, sound  
      (B) Clincher: relatedness of goods—promoting sci fi merchandise v. making movies  
      (C) Dream Works has broader market that encompasses sci fi  

B. **Contributory and Vicarious Liability**—liability for infringing act of 3rd party  
   1. **Contributory**  
      i. **Inwoods Labs, Inc. v. Ives Labs**  
         a. Pharmacists dispensing generic brand drug in brand bottle; Rxs for only brand  
         b. Generic manufacturer produced look alike capsules without TM  
         c. **Contributory Test**: Whether or not induced infringement OR allowed it to happen  
            (A) District Ct said no  
            (B) COA set aside facts that were not clearly erroneous  
               (1) Weight of pattern of illegal substitution  
               (2) Could have anticipated substitution  
               (3) Degree of substitution taking place was not de minimis  
      ii. **Hard Rock Café Licensing Corp. v. Concession Services (counterfeit tees)**—contributory and vicarious  
         a. Hard Rock v. owner of flea markets & store that buys tees from various sources  
         b. DC found infringement  
         c. Flea market’s contributory infringement  
            (A) **Contributory Test**: knew or had reason to know of infringement  
               (1) Willful blindness: suspect wrongdoing and deliberately fail to investigate
Failure to take precautions is wrong standard and not relevant (this is contrary to Restatement)

ii. Polo Ralph Lauren Corp. v. Chinatown Gift Shop
   a. Landlord may be liable for tenant’s sale of counterfeit items if knew of sales and did nothing to prevent

iv. Lockheed Martin Corp. v. Network Solutions (“SKUNK WORKS”)—supplying product/service
   a. Lockheed Martin has incontestable service mark for “Skunk Works”
   b. Network Solutions registers domain names
   c. Providing domain registration does not constitute providing a service
      (A) Acts like the US Postal Service
      (B) Simply reroutes info
      d. no direct control and monitoring

2. Vicarious Liability
   i. Principles of agency law—legally responsible for others’ action
   ii. AT&T v. Winback
      a. Winback’s sales reps are contracted, made false associations with AT&T
      b. Rule: principal responsible for agents’ infringing actions if
         (A) Independent contractor working on behalf of principal AND
         (B) Principal receives financial benefits AND
         (C) Foreseeable AND
         (D) reasonable for 3rd pty to rely AND
         (E) 3rd pty had no notice of unauthorized

VII. OTHER THEORIES OF LIABILITY
   A. Lanham Act § 43(a)—does not require registered TM
      1. Infringement of Unregistered Marks
         i. Dastar Corp v. Twentieth Century Fox—false designation of origin
            a. § 43(a) covers origin of production as well as geographic origin for unregistered marks
         ii. Yarmuth-Dion, Inc. v. D’ion Furs, Inc.—surname
            a. Unregistered mark of surname “Peter Dion”
            b. Dion claims infringer enriched by his infringement
            c. All parties active in fur industry
            d. Test for unregistered infringement
               (A) Demonstrate that mark is protectable
                  (1) Surname is descriptive mark \(\rightarrow\) must have secondary meaning
                     (i) Secondary meaning
                        (a) Advertising expenditures
                        (b) Consumer studies
                        (c) Sales success
                        (d) Unsolicited media coverage of the product
                        (e) Attempts to plagiarize the mark
                        (f) Length and exclusivity of the mark’s use
                  (2) LC incorrectly ruled no secondary meaning without using Thompson factors
               (B) Likelihood of confusion—apply Polaroid factors
      2. Trade Dress
         i. Two Pesos v. Taco Cabana
         ii. Functionality
            a. TrafFix Devices, Inc. v. Marketing Displays—utility patent and cost
               (A) road signs with dual-springs system to withstand heavy winds
               (B) MDI’s patent expired and TrafFix copied
               (C) MDI sued for trade dress infringement
               (D) Issue: The issue is whether or not an expired utility patent forecloses the possibility of the patentee’s claiming trade dress protection in the product’s design.
               (E) SC test—whether it’s essential to the use of article or cost or quality
                  (1) Competitors should not have to investigate alternative designs b/c the design is functional
                  (2) Utility patent goes towards showing that it’s merely functional
b. **Leatherman Tool Group, Inc. v. Cooper Industries**—functional parts making a whole
   (A) **Leatherman doctrine**: whole is functional if:
      (1) whole is nothing other than the assemblage of functional parts AND
      (2) the arrangement and combination of parts is designed to result in superior performance
   (B) **Tie Tech v. Kinedyne (web cutter)**
      (1) Applies **Leatherman** to hold that merely arrangement of functional parts

c. **Eco v. Honeywell (thermostat)**—functionality of registered TM
   (A) Honeywell registered IM for round thermostat → presumption of validity
   (B) Ct refused to grant preliminary injunction even with TM b/c possible that round shape is functional


d. **Gateway, Inc. v. Companion Products, Inc. (cow screen hugger)**
   (A) Gateway’s cow is protectable trade dress—not functional
   (B) Evidence that cow created with Gateway in mind (intent of D)

e. **Aesthetic functionality—Qualitex**
   (A) Design feature that substantially contributes to the aesthetic appeal of product AND
   (B) Benefit cannot be duplicated by alternate design
   (C) Would significantly hinder competition
      (1) **Cookbook case**—many aesthetic features, but all deemed functional for all cookbooks

iii. Trade Dress Infringement
a. **Best Cellars Inc. v. Grape Finds at Dupont, Inc. (wine store)**
   (A) Wine store had inherently distinctive trade dress (architectural and graphic component)
      (1) Many wine stores that do not use their shelving system
      (2) Demonstrated non functional
      (3) “concrete expression” of concept is protectable
   (B) **Likelihood of Confusion**—Polaroid
   (C) Preliminary injunction granted

b. **Best Cellars v. Wine Made Simple**
   (A) Marketing style is not part of trade dress
   (B) “feel” of product is not protected
   (C) must be specific elements of trade dress (ie, names of tasting categories)

c. **Toy Manufacturers of America, Inc. v. Hamsley-Spear, Inc.**
   (A) Toy show; TD—registration process in Internatl Toy Center lobby
   (B) **Trade Dress Test**
      (1) Trade dress distinctive—found secondary meaning
      (2) Likelihood of confusion—used Polaroid factors to conclude confusion
   (C) enjoined from registration in lobby

d. **Conopco, Inc. v. May Dept Stores Co.**
   (A) **Test for TD infringement**
      (1) Actual Confusion (monetary relief) → NO
         (i) Private logo used, invited comparison w national label
         (ii) Must be clearly labeled and differentiated
      (2) Likelihood of Confusion (injunctive relief) →
         (i) Prominent placement of logo
         (ii) Side by side use of logo for extended period of time

e. **McNeil-PPC v. Guardian Drug**—initial interest confusion
   (A) Lactaid v. Lactase → TD infringement
   (B) Distinguished from Conopco b/c had not competed for 10 years already
   (C) Prominent logo doesn’t matter
   (D) Initial interest confusion → infringement b/c it uses competitor dress to consider buying its product

f. **Marlboro v. Cowboy**
   (A) Marlboro won for TD for use of cowboy even though not same image

3. **False Designation, False Advertising and False Representations**
i. **Comparative Advertising**
   a. **Smith v. Chanel (knockoff perfume)**
(A) Ct dismisses Chanel’s free-riding argument b/c just b/c you invest doesn’t mean you can have exclusive rights
(B) Ct dismisses Chanel’s genericide arguments—Smith not using term generically, only to identify TM product
(C) holding: comparative advertising is allowed
   (1) most beneficial for the consumer to have a reference so that the consumer knows what they’re getting
   (2) having cheaper imitations is better for competition
   (3) arguably, if they don’t say it’s Chanel No. 5, it would be confusing to consumers b/c they don’t know what they’re getting

b. August Storck KG v. Nabisco, Inc. (“Werther’s”)
   (A) Possibility of confusion is not enough
   (B) Reversed injunction because packages very different, overall appearance is what matters

ii. False representations
   a. claims countered by First Amendment concerns
   b. does not apply to political speech
   c. limited to commercial advertising for commercial products
   d. Types of falsehoods:
      (A) Explicit (or literal): explicitly false on its face. Proof? Just need to show that claim is false.
      (B) Implicit: there needs to be some additional step by the public to determine falsity. Proof for this or misleading? Whether substantial number of the public will find it misleading. No need for survey evidence.
      (C) Misleading: not necessarily false, but may mislead consumers.
      (D) Even though exact words aren’t explicitly false, if a consumer watching it can compare, then explicit. But if consumer has to take additional step, then implicit.
      (E) Puffery: exaggerated advertising, blustering, and boasting upon which no reasonable consumer would rely. A specific and measurable advertisement claim of product superiority is not puffery.

   e. Coca-Cola v. Tropicana Prod., Inc. (orange juice ad)—explicit falsehood
      (A) Tropicana had ad saying that juice was “pasteurized from the orange,” and that it was the “only leading brand not made with concentrate and water.” Coke says that this isn’t true, sue. Says that it is pasteurized in containers and is sometimes frozen.
      (B) Court suggests that ad is an explicit falsehood. Overwhelming visual impression was misleading. Might argue puffery claim, but the visual impression is so strong.

   f. United Industries Corp. v. Clorox Co. (roach bait)—implicit or misleading
      (A) side by side comparison for roach bait
      (B) The competitors box was present – had generic box designed to look like Clorox
      (C) Clorox complains of explicit and implicit falsity
      (D) Dispute as to what happens in 24 hour period. UI says it does, Clorox says it takes a lot more time to get rid of infestation.
      (E) Court disagrees – not claiming that it gets rid of infestation in 24, only that it can kill a roach within 24 hours.
      (F) Implicit falsity (or misleading) that consumers might think that infestation would end in 24 hours. Would have to show that the public is actually viewing it that way – Clorox doesn’t provide this evidence.
      (G) Take home: if you are going to make implicit or misleading, need evidence of public reaction.

   g. Clorox Puerto Rico v. P&G—puffery v. explicit falsehood
      (A) P&G had detergent products with slogan “whiter is not possible” and “compare with your detergent…whiter is not possible.”
      (B) Clorox claimed that slogan was false and name was false.
         (1) Claims that ads say that this product whitens better than bleach – all parties concede that this is not true. As to the name, there is a little bit of a falsity issue.
         (2) Litigants would prefer explicit falsehood because don’t have to show evidence.
(3) Explicit falsehood – necessarily implication. If you say “X is better,” it necessarily implies that it is better than competitors.

(4) “Whiter is not possible” is not mere puffing because it can be measurable.

h. Polar Corp. v. Coca-Cola Co.—injunction for disparagement
   (A) Polar commercial throws Coke can into trash that says “Keep the Arctic Pure”
   (B) CT: commercial implies Coke is not “pure” – injunction

i. Proctor & Gamble v. Haugen—false statements tied to commercial activities
   (A) representative for Amway disseminated statement saying that the president of P&G was part of the Church of Satan and used P&G profits to support it.
   (B) False statement – tie to satan – is verifiably false. But was the misleading statement about goods or services? No, but tied to commercial activities and this was actionable. Goes to consumer feelings toward the company and could be prejudicial.
   (C) Haugen also argues that the email he sent was not commercial communication – entitled to free speech rights to protect it because not exclusively commercial. Court clearly says that if you have mixed commercial and non-commercial, it can be treated as commercial. But here there was no substantial non-commercial use.
   (D) What about the content made it commercial v. non-commercial? It said you should stop buying P&G and start buying Amway. Competitive distributor sending out the message – much more explicit commercial transaction.

j. Coors Brewing Co. v. Anheuser-Busch Co.
   (A) Commercial implying Coors is not as fresh, transported from Colorado to Virginia
   (B) Literal falsehood: b/c only broadcast in Northeast, commercial is not literally false (transport takes place)
   (C) Implied Falsehood—a survey evidence is leading

4. Author’s and Performer’s Rights of Attribution
   i. Integrity of work
      a. Gilliam v. ABC (Monty Python case)—moral rights
         (A) ABC edited Monty Python programs
         (B) Moral rights arguments
            (1) Product is associated with Gilliam but they say that ABC destroyed the integrity of the work
         (C) Lanham Act
            (1) Misdescription to the origin of the product, § 43(a)
            (D) are disclaimers enough?
               (1) If they’re frequent, then most consumers would see it
               (2) If only one, some won’t see it if it’s only at the beginning of the show
         (E) majority focuses on § 43(a) claim—edited version impaired the integrity of authors’ work
      b. Choe v. Fordham Univ. Sch. of Law (law review note)
         (A) P was law student suing for “mutilation” of his published comment in a law review; § 43(a)
         (B) Holding: NO
            (1) Main message conveyed
            (2) P saw in final form and there were no changes
            (3) Grammatical errors were rampant – probably of his own making
   ii. Attribution/Reverse Passing Off
      a. Smith v. Montoro (Paul Smith actor)—false attribution/reverse passing off
         (A) Paul Smith (actor) required that he got star billing in screen credits and advertising of an Italian film
         (B) When distributed in U.S., Smith didn’t get credit in film or ads; substituted other name
         (C) Ct says:
            (1) Unfair competition is anything that violates “current conception of fairness”
            (2) Reverse passing off b/c of substitution
               (i) Misappropriates or profits from another’s talents and workmanship
               (ii) Originator of misidentified product involuntarily derived of advertising value and goodwill
Broad view of § 43(a) standing —any person means any person: actor is in the business and has standing to protect talent

b. **Lamothe v. Atlantic Recording Corp.** —omission as misattribution
   (A) coauthors of musical composition, only some of them credited when released
   (B) case for reverse passing off
   (C) doesn’t matter that some of them were credited

c. **Limits on attribution claims (Halicki—PG v. R rating)**
   (A) some competitive relationship
   (B) bodily appropriation of the work
   (C) works for hire are generally excluded
   (D) there is no right to attribution, only a right against misattribution

d. **Dastar Corp. v. 20th Cent. Fox Film Corp.**
   (A) Dastar did not give Fox credit when they distributed multipart television series that Fox created but was in public domain after expired © registration
   (B) Ct
      (1) Fox did not have cause of action under § 43(a); not reverse passing off
      (2) Who is the originator of goods?
         (i) Don’t associate with every component of a product
      (3) Fox creates Catch-22 situation for Dastar
         (i) If they put Fox on the packaging, then they would have been identified with the product when they did not sponsor it

iii. **Right of Publicity Related Claims**

      (A) Woody Allen alleges that National Video misappropriated his face on ads
      (B) Video used a look-alike; had disclaimer stating it on SOME ads, but it was small
      (C) Issues
         (1) Does he have a ™ on his name and image?
            (i) § 43(a) does not require a registered TM but he does need a protectable mark
            (ii) Here, Court assumes he has a protectable common law right in his name
         (2) What is his mark for?
            (i) Not clear but this case is about false endorsements
            (ii) Strength of his mark cuts against the d’s arguments
         (D) § 43(a) test
            (1) involving goods or services—celebrities have endorsement powers as “services”
            (2) effect on interstate commerce
            (3) false designation of origin or false description of goods or services
               (i) likelihood of confusion

   b. **Parks v. LaFace Records (Rosa Parks)**—First Amendment
      (A) Used Rosa Parks’ name in the title but not in the lyrics; used on the sticker on the album
      (B) Rosa Parks has standing because
         (1) Once you reach celebrity status, you have an automatic protectable entity, economic interest
         (2) She had sponsored/approved a tribute album
         (3) She’s a celebrity for the civil rights movt
         (4) Did she need secondary meaning for her name? no discussion about it
      (C) **Standard of analyzing cause of action**—Likelihood of confusion
         (1) CT: a reasonable jury could find a likelihood of confusion
         (2) Some affidavits offered from ppl who thought Parks sponsored the song
      (D) **Rogers Test (First Amendment)**
         (1) **Artistic relevance**—is the use of the person’s name or identity artistically relevant to the content of the work?
            (i) Her name is not artistically relevant to the content of the Outkast song
            (ii) They could’ve named it something not associated with Rosa Parks’ name
         (2) **Misleading** as to the source of content? (left for LC to decide, depending on first prong)

c. **Neville Brothers’ song**
A. Her name is artistically relevant to the topic and purpose of the song
d. \textit{ETW Corp. v. Jireh Publishing, Inc.},—fair use defense
   (A) Painting of Tiger Woods winning the Masters
   (B) § 32 (registered mark): words “Tiger Woods” on art prints, calendars, mounted photographs, notebooks, pencils, unmounted photographs, etc.
      (1) his name is mentioned in the narrative that accompanies the painting
      (2) no use of his name directly on the painting
      (3) CT: this falls under statutory fair use defense
         (i) Just describing the product in good faith
   (C) § 43(a) (unregistered mark)
      (1) claiming TM rights to image and likeness
      (2) CT: his image doesn’t indicate source—just a picture of Tiger Woods
         (i) But leaves open that there is a possibility that a particular pose could be trademarked (like Elvis), but not right now

B. Dilution
   1. § 43(c) & 45
   2. When use of the same or similar marks by others has caused a mark to become less distinctive than before
   3. Likelihood of confusion unnecessary
   4. dilution can only occur when confusion is absent
   5. Under state law
      i. \textit{Ringling Bros. (“Greatest Show on Earth”)}
         a. Even if Lanham preempts IL state def of “distinctive,” ct already applied Hyatt factors for distinctiveness
            (A) Coined or invented term
            (B) Length of time used
            (C) Scope of advertising
            (D) Nature and extent of the business
            (E) Scope of first user’s reputation
         b. Injunction b/c irreparable harm
      ii. \textit{Mead Data v. Toyota (LEXIS v. LEXUS)}
         a. In NY, the court makes clear that the mark doesn’t have to identical to senior user, but needs to be substantially similar.
         b. DC thought Lexus and Lexis were substantially similar, but this court said they were not.
         c. Commercial speech standard: doesn’t matter that some people would mispronounce these, but professional announcers would be able to do it correctly.
            (A) In visual appearance, you would be able to tell
            (B) \textbf{because the marks are not substantially similar, there is no cause of action.}
         d. The court continues on about distinctiveness of marks. Just being distinctive or well known in a smaller market isn’t enough. Have to be well known generally. Not about secondary meaning, but recognizable. The people who would see the marks as distinctive (attys) are fairly sophisticated.
         e. What about reverse dilution claim in this case? Lexis concerned that Lexus would become really famous, Lexis mark would be compromised. We allow for reverse confusion, why not reverse dilution? The only people having mental association are sophisticated and will be able to recognize the difference.
      iii. \textit{Deere v. MTD Products}—Tarnishment, Parody
         a. involved an advertisement between two competing lawn tractors. Competitor had ad with cartoon version of Deere ad, making fun of the deer.
         b. Court said that there wasn’t blurring because the competitor was referring to senior users mark – issue is not that consumers would think that the Deere mark was the MTD’s mark.
         c. Six factor test for determining blurring:
            (A) Similarity of the marks
            (B) Similarity of the products covered by the marks
            (C) Sophistication of consumers
(D) Predatory intent
(E) Renown of the senior user
(F) Renown of the junior mark
d. Not tarnishment either because that usually refers to linking products with shoddy quality.
e. Tarnishment is usually found where a distinctive mark is depicted in a context of sexual activity, obscenity, or illegal activity.
f. But there is dilution in the form of “making fun.” (form of tarnishment?)
   (A) Some satiric expression is ok, but there is a line that was crossed.
   (B) Not ok if in direct competition – meaning if competitor was making fun of senior mark to promote its own product. Also, this is in a commercial context.
   (C) Parody outside of commercial context is ok, as is comparative advertising.
iv. Hormel Food v. Jim Henson Productions—Parody
   a. Muppets use the name Spa’am. Court says that this is ok – not in commercial context.
   b. Specifically talks about Deere, reads it differently than we discuss. Revisits its holding – never said that there was a third category other than blurring or tarnishment – just a form of tarnishment that court hadn’t previously mentioned.
   c. Even if it had been in commercial context, would it be tarnishment? No. No evidence that the use causes negative associations, not direct competitor, and the parody inheres in the product.

6. Federal Dilution
   i. § 43(c) Dilution means the lessening of the capacity of a famous mark to identify and distinguish goods or services.
      a. Famous mark (most states is just “distinctive mark”)
         (A) Inherent/acquired distinctiveness
         (B) Duration/extent use
         (C) Ads and publicity
         (D) Trading area
         (E) Trade channels
         (F) Recognition (public generally in the trading areas of * and * mark, how they overlay)
         (G) 3rd party uses
         (H) registration
      b. Commercial use in commerce
      c. Diluting action has to occur after mark is famous
      d. Cause dilution (states is “likely to dilute”)
   ii. relief
      a. general injunctive relief
      b. damages if willful intent
   iii. defense—registered mark
   iv. Word Marks
      a. Moseley v. V. Secret Catalogue (Victor’s Little Secret)
         (A) Is proof of actual injury to economic value of famous mark for federal dilution? NO
         (B) Junior non-identical use of senior mark does not necessarily create actionable dilution
            (1) Mark had no effect on ppl’s opinion of Victoria’s Secret
            (2) Suggests need to use consumer surveys when not identical
         (C) Kennedy concurrence in Moseley:
            (1) diminishment of the famous mark’s capacity can be shown by the probable consequences flowing from use or adoption of the competing mark….a holder of a famous mark threatened with diminishment of the mark’s capacity to serve its purpose should not be forced to wait until the damage is done and the distinctiveness of the mark has been eroded.
      b. Ringling Bros. v. Utah Division of Travel Department
         (A) Utah used “the greatest snow on earth” on its license plates.
         (B) Elements of federal cause of action:
            (1) Sufficient similarity of marks to evoke in consumers a mental association of the two that
            (2) Causes actual harm to the senior mark’s economic value as a product-identifying and advertising agent.
(C) How do you show actual harm and that it was caused by * use?
(1) Consumer surveys whether there is association
(2) Loss of revenues, and exclude other potential causes for the loss
(3) Contextual factors such as the extent of the junior mark’s exposure, the similarity of the marks, the firmness of the senior mark’s hold.

(D) Can show dilution through circumstantial evidence. Evidence here shows that the reference actually boosted Ringling Bros. mark here. More people in Utah knew about the circus than the rest of the country.

c. Congress has proposed abrogating the holding in Moseley.
   (A) Would change to “likely to cause dilution by blurring or dilution by tarnishment of the famous mark,” Would lower standard to state level.
   (B) Argument for it is that * wouldn’t have to wait around until it was injured to bring an action.
   (C) Argument against the amendment? Limiting the language by letting companies to lock-up words – applies not just to arbitrary or fanciful.

VIII. DEFENSES
A. Possibilities
   1. attack P’s case
   2. genericism—basis for canceling a mark
   3. abandonment
      i. §33(b)
      ii. common law defense
      iii. basis for canceling a mark
   4. functionality
   5. prior use/registration—§ 33(b)(5)-(6)
   6. cancellation (not under § 33)
   7. preemption
      i. some instances TM yields to PT and © laws
      ii. fed preempting state law
         a. state laws generally are found to be in harmony with fed laws
         b. except wrt dilution laws
            (A) § 43(c)(3): if there is a federal registration, then it would prevent state dilution claim
   8. 1st sale doctrine—if you buy a product, simply selling it does not constitute a TM violation
   9. non-trademark use (1800 Mercedes)
   10. fair use
      i. statutory—§ 33(b)
      ii. nominative
   11. 1st Amendment
   12. misuse
      i. rarely successful
      ii. used in some way to misrepresent a mark
      iii. false designation of origin that D asserts against P
   13. antitrust law
      i. § 33(b)(7)
      ii. rarely succeeds
   14. equitable principles
      i. § 33(b)(9)
      ii. acqiescence
      iii. implied license
   15. other
   16. fraudulence
      i. must show intent to deceive USPTO (§ 33(b))

B. Statutory Defenses
   1. Lanham Act § 14
   2. Lanham Act § 15
   3. Lanham Act § 33
4. Lanham Act § 43(c)
C. Common Law, Equitable and Constitutional Defenses
D. Free Speech Defenses