

The background features several concentric circles in light gray, some solid and some dashed, creating a ripple effect. A large red speech bubble is centered on the page, pointing downwards. The text is white and centered within the red bubble.

TRADEMARK UPDATE

WHOSE MARK IS IT ANYWAY?

BRIEF TM REVIEW

A trademark or service mark can be any word, phrase, symbol, design, or a combination of these things - even a sound, smell or color.

- For consumer, they all will
 - Help identify specific goods or services, identify their source and origin and distinguish them from the competition; and
 - Serve as a form of quality control – consumer assured as to what it is purchasing.
- For TM/SM owner, they all will
 - Help establish customer good will
 - Provide legal protection for a brand;
 - Guard against counterfeiting and fraud

IN MANY RESPECTS, TRADEMARK LAW CAN BE SEEN AS THE FIRST LAW OF CONSUMER PROTECTION

*The right to protection as a TM/SM is based on **actual use**. A federally protected trademark TM/SM is protected nationwide; a state trademark is protected statewide; a common-law trademark is protected only in the area where it is actually being used.*

REGISTRABLE MARKS

*The essence of a tm/sm is its **inherent distinctiveness**. It must clearly and quickly identify the owner as the source or origin of the goods or services.*

- **Fanciful trademarks.** A word is simply made up, e.g., Exxon® for petroleum or Pepsi® for soft drinks.
- **Arbitrary trademarks.** A real word is used having nothing to do with product or service, e.g., Apple® for computers or Delta® for air travel.
- **Suggestive trademarks.** A word is used to suggest a quality but doesn't state it outright, e.g., Coppertone® for sun-tanning products or Drywall Shield® for a paint used to protect drywall.
- **Secondary Meaning Trademarks.** A word that is merely descriptive of the product ("e.g., Crunchy Cookies"), but over time, has acquired distinctiveness, e.g., Chap Stick® or Quote Investigator®. The same is true for marks that are primarily surnames, primarily geographic, and deceptively misdescriptive.

NOT
REGISTRABLE

The following marks cannot be registered with the USPTO (not all inclusive, but you get the idea):

- Immoral, deceptive or scandalous marks (very subjective, of course)
- Marks which disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute (But see, *Slants* case)
- Marks consisting of or comprising a name, portrait, or signature identifying a particular living individual except by written consent.
- The title of a single book and/or movie or a mark used in a purely ornamental manner
- Marks likely to cause confusion with a currently registered mark (through a USPTO refusal) or a mark/trade name previously used in the U.S. by another and not abandoned (through Opposition Proceedings) when used on or in connection with the same or similar goods/services.

GENERIC MARKS

Generic Marks: When a “mark” is the product or service itself or if over time, cannot be distinguished from the product or service, it is considered generic, i.e., it no longer identifies the source or origin and is not inherently distinctive. However, as a result of a recent case, just by adding a .com, a generic “mark” may be registrable if it has acquired a secondary meaning.

- ***USPTO v. Booking.com***, 591 U.S. ___, 140 S.Ct. 2298 (2020). USPTO initially refused registration of Booking.com based on genericness. The Supreme Court reversed, finding that the website address had acquired a secondary meaning among consumers as a particular online reservation system, e.g., as opposed to Travelocity
- As a result of **Booking.com**, the USPTO has published a guide for trademark examiners and website owners on how or when the former *per se* rule may now be overcome. To date, the USPTO has refused registration for wine.com (contested) and sneakers.com (abandoned).

See: <https://www.uspto.gov/sites/default/files/documents/TM-ExamGuide-3-20.pdf>

LITIGATING TRADEMARKS

TRADEMARK CAUSES OF ACTION

- **PRE-REGISTRATION: Opposition Proceedings:** Petitioner must establish statutory basis, priority, and likely confusion or non-use. May also assert fraud with intent to deceive USPTO.
- **POST-REGISTRATION: Cancellation of Existing Mark:** Usually based on abandonment (3 years) but also Fraud

Note: Effective this year, the filing fee for TTAB Opposition and Cancellation Proceedings has increased from \$400 to \$600 per class.

- **IN THE MARKETPLACE:**
 - Infringement of Federal/ State/Common Law Trademark
 - False Designation of Origin
 - Dilution By Blurring/Tarnishment
 - Unfair Competition/False Advertising/Counterfeiting

Tiffany & Co. v. Costco Wholesale Corp., 971 F.3d 74 (2d Cir. 2020): For those of you who have been waiting with bated breath (8 years) to find out the legitimacy of that Costco “Tiffany Ring” you purchased, the parties settled in June for an undisclosed amount to avoid a remand. The Second Circuit had vacated a judgment in favor of Tiffany, finding there was a triable issue of fact as to whether the word Tiffany was merely descriptive of the ring setting or either infringed on the Tiffany name and/or were counterfeits.

NOW FOR SOME
ENTERTAINMENT

- **NIKE, INC V. MSCHF PRODUCT STUDIO, INC.**, CASE NO. 21-CV-169 (3/29/21). Nike sued MSCHF for trademark infringement, false designation of origin, and trademark dilution for purchasing 666 pairs of Nike Air Max 97 Shoes and adding, among other things, a drop of blood so as to resemble “Satan’s Shoes.” A settlement was reached, which included an offer to let customers return their \$1,018 Satan Shoes — or a pair of MSCHF’s earlier “Jesus Shoes” — for a full refund. MSCHF said its intent was to comment on the absurdity of the brand collaboration culture and about the perniciousness of intolerance. Lil Nas X, who “collaborated” in the design of the “Satan Shoe” reinforced that message in his song “Montero (Call Me By Your Name).



MORE ENTERTAINMENT

- ***VIP Products, LLC v. Jack Daniel's Properties, Inc.***, 953 F.3d 1170 (9th Cir. 2020), cert den, ___ U.S. ____ (2021). The Ninth Circuit reversed a lower court opinion holding that VIP's dog toy ("Bad Spaniel") both infringed on Jack Daniel's trade dress and diluted its mark by tarnishment, finding instead that the toy should have been analyzed as an "expressive work" under the *Rogers v. Grimaldi* test. That test asks whether (a) such use is inherently related to the work, and (b) the work is explicitly misleading as to the complaining party's involvement. Since there was nothing explicitly



misleading, and given the toy's use of humor, the Ninth Circuit concluded that the Jack Daniel's trademarks had not been infringed or diluted. The U.S. Supreme Ct. has denied *certiorari*, leaving the decision to stand much to the chagrin of brand owners. Although there have been prior cases where the First Amendment was applied to commercial products, they argue that the underpinning of those decisions strictly involved the use of parody and not solely the application of the *Rogers-Grimaldi* test.