Class 11: Distinctiveness And Trade Dress

- Adminstrative
  - Next Time: Rescuecom v. Google case (on website)
  - News
    - Apple asserting the "pod" and "iPod" marks.
      - cease-and-desist letters recently sent to Podcastready (Mypodder software).
      - Now seeking TM registration for "Pod" in many countries.
    - Hormel tried to register "Spam" for unsolicited bulk email
      - UK rejected registration.
      - Basis for rejection?
- Last Time
  - Correction: Fanciful v. Arbitrary
    - Already corrected on posted slides.
  - A Little Bit on Registration
    - Registration at the USPTO
    - Use-based system
      - First party to use gets the registration.
      - Since 1989: Intent to use filing with constructive use priority date
        - But no right to sue unless actual use.
      - Registration does not create the TM
        - Without it, can sue under 43(a) and state law.
    - Benefits of registration
      - 1. Nationwide constructive use and notice.
      - 2. Possibility of incontestable status after five years.
        - Defenses lost: confusing similarity; functionality; lack of secondary meaning.
        - Many defenses still remain: genericness; obtained through fraud in registration; abandonment; misrepresentation of source; scandalousness; fair use; prior use; prior registration; antitrust violations.
      - 3. Right to sue in Federal Court
    - The Process, roughly
      - Two requirements
        - Use
        - Distinctiveness
      - Applicant does it own search. Files it.
      - Typically, published by PTO shortly after filing
        - Compare to 18 months for Patent.
      - Granted unless mark previously registered or similar mark used prior in US such that confusion is likely.
      - Two registers
        - Principal
          - Gives host of rights under Act.
          - Circle-R symbol
        - Supplemental
          - Lacks most of the rights of registration, but you can go to other countries which require "registration" in your home country.
          - Can use the Circle-R symbol.
- Distinctiveness
  - Test
    - Two Classes
      - Inherently Distinctive
        - For Words: Arbitrary, fanciful, and suggestive.
        - No secondary meaning needed.
      - NOT inherently Distinctive but Acquired distinctiveness
        - For words: Descriptive
        - Also: Geographic Marks; Personal Name Marks; Non-inherently descriptive designs and symbols; Non-inherently distinctive trade dress and packaging; All product and container shapes; colors.
        - Secondary Meaning Needed.
    - Some can NEVER be distinctive
      - For words: Generic
  - When this is used / important.
    - 1. Can the mark be federally registered?
    - 2. Should a court agree to cancel a registration due to lack of distinctiveness?
    - 3. Can a suit for infringement under 43(a) (no registration) be brought? -- only for things that could have been registered in the first instance.
  - Classification
    - Question of Fact
    - 1. Generic
      - Name of a particular genus or class of which an individual article or service is but a member.
    - 2. Descriptive
    - 3. Suggestive
      - Suggests rather than describes some particular characteristic and requires an exercise of imagination.
    - 4. Arbitrary
    - 5. Fanciful
    - Line between Descriptive and Suggestive?
      - Zatarain's has many tests.
        - Dictionary Test
        - Imagination Test
        - Whether competitors are likely to need the term.
        - How the term has actually been used.
  - Specific Mark Types
- Secondary Meaning
  - Test: Is the primary significance of the term in the minds of the consuming public to the product or to the producer?
  - Policy Rationale
    - Consumer protection -- if consumers aren't associating your name with a source,
    - Producer: language is finite.
    - Reverse Question: Why not for amazon?
      - Hard for courts to measure this?
      - Producer: Protect your investment.
      - Reflects a risk--not taking anything from language.
  - Types of Evidence
  - Zatarain's
- Fair Use
  - Affirmative Defense
    - Used only to describe the goods or services or their geographic origin.
  - Policy