



Identity & Origin  
Trademark

# Trademark Fundamentals and Distinctiveness; Lanham Act Registration

Eric E. Johnson  
ericejohnson.com



Konomark  
Most rights sharable

# source

|                             |                                     |   |                            |   |  |
|-----------------------------|-------------------------------------|---|----------------------------|---|--|
| inherently distinctive      | fanciful<br>arbitrary<br>suggestive |   | misdescriptive             | inherently distinctive<br>product packaging                             |  |
| can acquire distinctiveness | merely descriptive                  | primarily geographically descriptive                | deceptively misdescriptive | non-inherently distinctive product packaging<br>product design<br>color | primarily a surname  |
| unprotectable               | generic                             | primarily geographically deceptively misdescriptive | deceptive                  | functional  | names/likenesses of living people without consent<br>gov't symbols |

## Let's talk about terms

- “**trademark**” in general usage (very broad) vs. “**trademark**” under the Lanham Act (specific statutory meaning of a mark for goods in the context of federal registration)
  - You have to think about which sense is meant when reading something.
- Lanham Act is picky with terms, recognizes four marks, which it talks about in the context of registration:
  - “**trademark**” mark for goods
  - “**service mark**” mark for services
  - “**certification mark**” mark certifying things in commerce by a neutral third-party
  - “**collective mark**” mark for belonging to a collective/organization
- “trade dress” is just a term that means a particular kind of **trademark** that's not a logo or word mark, but is product packaging, product configuration

**TM**











## The need for distinctiveness

- Whether to be registered on the principal register under the Lanham Act ( § 2), or
- whether to be protectible under the common law or 43(a) of the Lanham Act
- a mark must be distinctive!
- It is only by being distinctive that it can signify a source.
- To be distinctive, marks can either be inherently distinctive or can acquire distinctiveness.

## Two ways to be distinctive

- “First a mark is inherently distinctive if ‘[its] intrinsic nature serves to identify a particular source.’”
- “Second, a mark has acquired distinctiveness, even if it is not inherently distinctive, if it has developed secondary meaning, which occurs when, “in the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself.”

Wal-Mart v. Samara Brothers (U.S. 2000)  
(citing Inwood Labs v. Ives Labs (U.S. 1982))

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**How would you  
classify this mark?**



How would you classify this mark?

# Kodak

BTW, for this series of slides, we are just asking about the word marks. (These slides show logos, logotypes, images, signage, advertisements, packaging, etc., just to be visually interesting.)

|                             |                                     |   |                            |   |  |
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And to make it easy, for now, we'll just work with these categories.

How would you classify this mark?

# Kodak

# Kodak

fanciful

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Apple  
(for computers)



Apple  
(for computers)

(likely)  
arbitrary



|                                |                                     |  |                               |   |  |
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# Apple (for an apple)



# Apple (for an apple)



generic







