



Identity & Origin
Trademark

Trademark Distinctiveness for Word Marks (Geographical, Misdescriptive, Generic, and More)

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Konemark
Most rights sharable

source

TM



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

The need for distinctiveness

Re-run

- 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

Re-run

- “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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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.)

inherently distinctive	fanciful arbitrary suggestive
can acquire distinctiveness	merely descriptive
unprotectable	generic







How should this
come out under the
actual-use-by-
others-in-the-
market test?

generic

Sandra
Dee says

“Get the Fastest Suntan

with MAXIMUM PROTECTION!”

Sandra stars in
“TAMMY AND
THE DOCTOR”
in Eastman Color
a Ross Hunter
production

There's no tan like a Coppertone suntan! With
Coppertone's "sun-balanced" formula you get
the fastest tan possible with maximum sun-
burn protection. And Coppertone helps pre-
vent dryness and peeling, keeps skin supple
and soft. So, enjoy the sun! And get
the best looking tan—rich, smooth,
long lasting. Use Coppertone.
Outsells all others by far!
Also available in Canada.



COPPERTONE®

Sandra Dee says "Get the Fastest Suntan with MAXIMUM PROTECTION!"

Sandra stars in "TAMMY AND THE DOCTOR" in Eastman Color a Ross Hunter production

There's no tan like a Coppertone suntan! With Coppertone's "sun-balanced" formula you get the fastest tan possible with maximum sunburn protection. And Coppertone helps prevent dryness and peeling, keeps skin supple and soft. So, enjoy the sun! And get the best looking tan—light, smooth, long lasting. Use Coppertone. Outsell all others by far! Also available in Canada.

Coppertone is a Reg. T.M. of Parke, Inc.

COPPERTONE®

held: suggestive

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COPPERTONE®

held: suggestive

How should this come out under the imagination test?



How should this come out under the useful-to-use / need-to-use test?

held: suggestive



How should this come out under the actual-use-by-others-in-the-market test?

held: suggestive

Apple (for an apple)



inherently distinctive	fanciful arbitrary suggestive
can acquire distinctiveness	merely descriptive
unprotectable	generic

Apple (for an apple)



generic

Apple
(for an apple)



generic

How should this come out under the ...

- **imagination test?**
- **useful-to-use/need-to-use test?**
- **actual-use-by-others-in-the-market test?**

Apple
(for computers)



Apple
(for computers)

(likely)
arbitrary

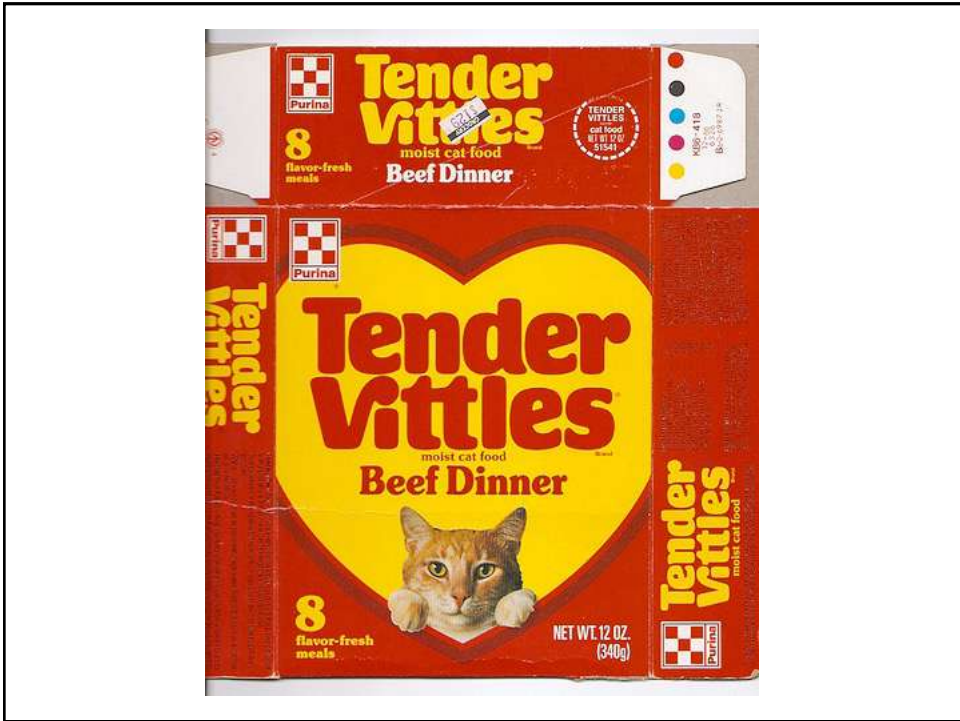




Here's new ones
to try (that have
right answers) ...

inherently distinctive	fanciful arbitrary suggestive
can acquire distinctiveness	merely descriptive
unprotectable	generic







held:
merely
descriptive

How should this come out under the . . .

- imagination test?
- useful-to-use/need-to-use test?
- actual-use-by-others-in-the-market test?

Wite-Out[®]

Wite-Out[®]

held:
suggestive

inherently distinctive

fanciful
arbitrary
suggestive

can acquire
distinctiveness

merely
descriptive

unprotectable

generic

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Let's get into
talking about
some of the
other categories

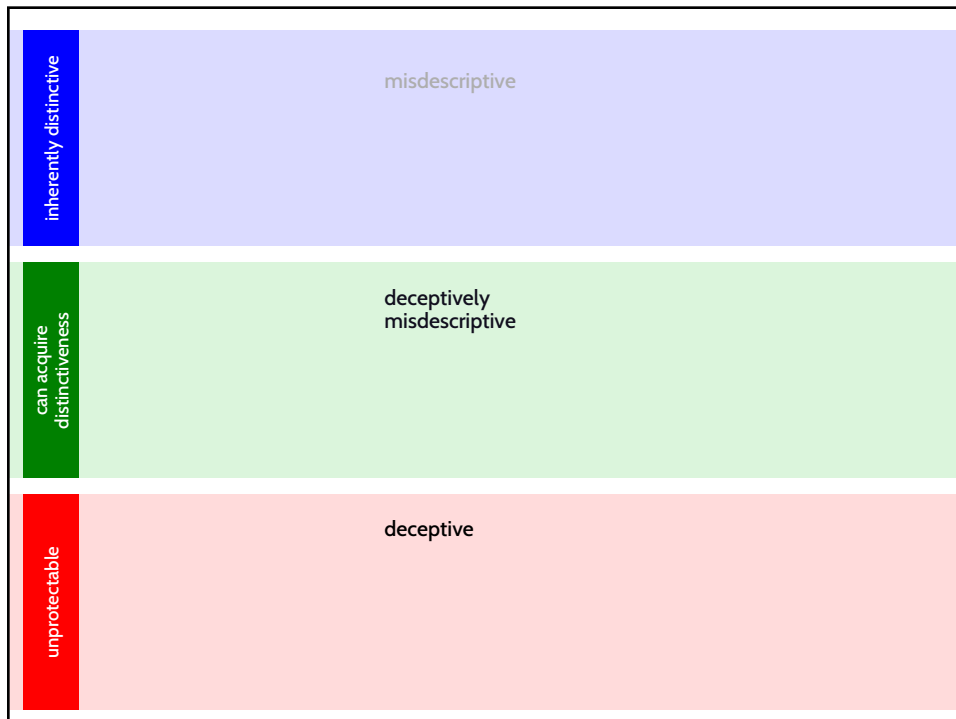


deceptively misdescriptive and deceptive ...

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We're gonna remember these with "IRONROOF"

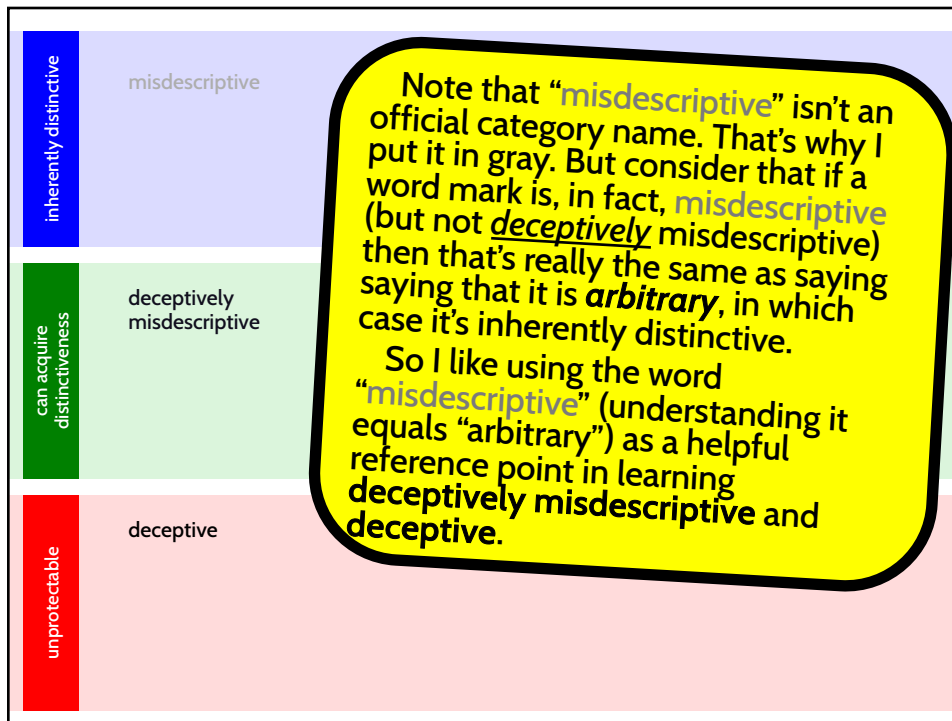
deceptively
misdescriptive and
deceptive ...



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inherently distinctive	misdescriptive
can acquire distinctiveness	deceptively misdescriptive
unprotectable	deceptive

Note that “misdescriptive” isn’t an official category name. That’s why I put it in gray. But consider that if a word mark is, in fact, *misdescriptive* (but not *deceptively misdescriptive*) then that’s really the same as saying saying that it is



Deceptively Misdescriptive vs. Deceptive

Deceptively misdescriptive:

- The mark immediately conveys an idea that is false yet plausible, but it is not material to the purchasing decision of a significant portion of relevant consumers.
- Registrable/protectable only with secondary meaning.

Deceptive:

- The mark immediately conveys an idea that is false yet plausible, and it is material to the purchasing decision of a significant portion of relevant consumers.
- Not registrable/protectable at all.

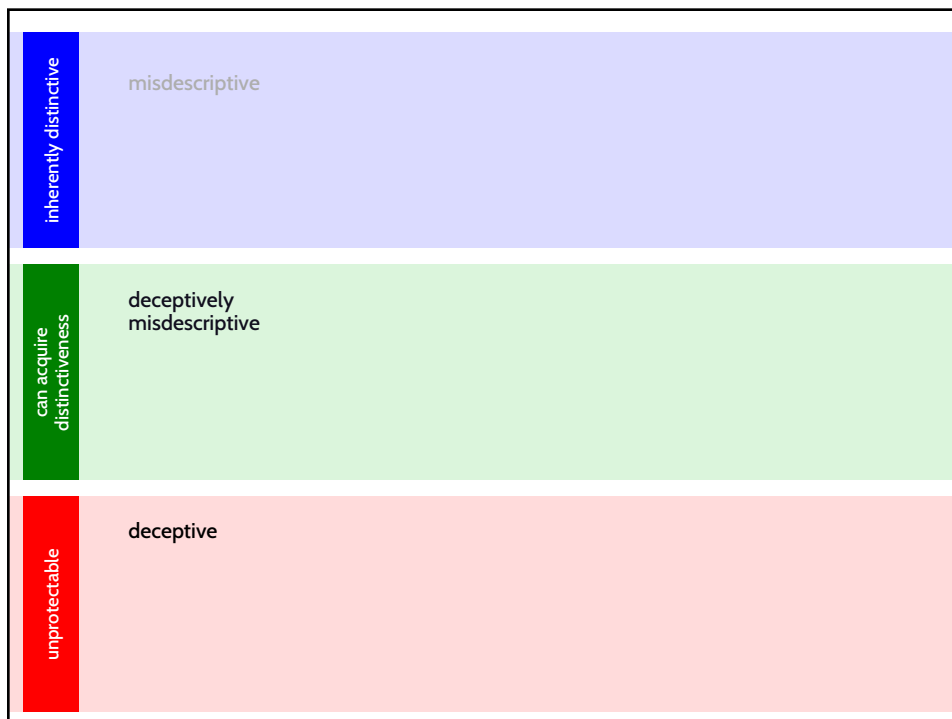
Deceptively Misdescriptive vs. Deceptive

Deceptively misdescriptive:

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- Registrable/protectable only with secondary meaning.

Deceptive:

- The mark immediately conveys an idea that is false yet plausible, and it is material to the purchasing decision of a significant portion of relevant consumers.
- Not registrable/protectable at all.



IRONROOF

IRONROOF

- for a restaurant with an asphalt shingle roof
- for a tornado shelter made of plastic
- for accounting software

inherently distinctive	misdescriptive
can acquire distinctiveness	deceptively misdescriptive
unprotectable	deceptive

Okay, where would you put these three examples?

IRONROOF

- for a restaurant with an asphalt shingle roof
- for a tornado shelter made of plastic
- for accounting software

inherently distinctive	misdescriptive
can acquire distinctiveness	deceptively misdescriptive
unprotectable	deceptive

inherently distinctive	misdescriptive	<p>IRONROOF (for accounting software)</p>
can acquire distinctiveness	deceptively misdescriptive	<p>IRONROOF (for a restaurant with an asphalt shingle roof)</p>
unprotectable	deceptive	<p>IRONROOF (for a tornado shelter made of plastic)</p>

geographically ...

inherently distinctive	fanciful arbitrary suggestive		misdescriptive		inherently distinctive product packaging
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Primarily Geographically Descriptive vs. Primarily Geographically Deceptively Misdescriptive

Primarily geographically descriptive:

- The primary significance of the mark is a geographic location, consumers are likely to believe the goods/services originate from that place, and they actually do.
- Registrable/protectable only with secondary meaning.

Primarily geographically deceptively misdescriptive:

- The primary significance of the mark is a geographic location, consumers are likely to believe the goods/services originate from that place, and they actually don't, and the false impression is material to the purchasing decision of a significant portion of relevant consumers.
- Not registrable/protectable at all.

Primarily Geographically Descriptive vs. Primarily Geographically Deceptively Misdescriptive

Primarily geographically descriptive:

- The primary significance of the mark is a geographic location, consumers are likely to believe the goods/services originate from that place, and they actually do.
- Registrable/protectable only with secondary meaning.

Primarily geographically deceptively misdescriptive:

- The primary significance of the mark is a geographic location, consumers are likely to believe the goods/services originate from that place, and they actually don't, and the false impression is material to the purchasing decision of a significant portion of relevant consumers.
- Not registrable/protectable at all.



Primarily
geographically
descriptive?

(Company is in
California and provides
janitorial services
there.)



Primarily geographically descriptive?

Registration DENIED by TTAB:
“[W]e find that the primary significance of CALIFORNIA GREEN CLEAN, in its entirety, is geographic. The addition of a descriptive term ('Green Clean') to a geographical term does not overcome the primary geographic significance of the mark as a whole.~ The term 'Green Clean' is merely descriptive for janitorial and maid services and the combination of that term with 'California' does nothing to alter the geographic significance of 'California' alone. Accordingly, we find that the primary significance of applicant's mark CALIFORNIA GREEN CLEAN is that applicant's janitorial and maid services originate from a California-based company.”

ANTARCTIC

for retail sales of snow cones
from a food truck in Texas

Primarily geographically deceptively misdescriptive?

ANTARCTIC

for retail sales of snow cones
from a food truck in Texas

(This is a hypothetical, FYI.)

Primarily
geographically
deceptively
misdescriptive?

ANTARCTIC

for retail sales of snow cones
from a food truck in Texas

(This is a hypothetical, FYI.)

This would not be primarily
geographically deceptively
misdescriptive, because
consumers would not think
that the snow cones
originated from Antarctica.

Primarily
geographically
deceptively
misdescriptive?

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Primarily geographically deceptively misdescriptive?

(Battery company is in New Jersey)



Registration denied for "SWISSCELL" batteries for lighting by examiner because mark is primarily geographically deceptively misdescriptive because Switzerland is a place where batteries are manufactured, consumers would likely believe the batteries were from Switzerland, and this could influence the consumer's purchasing decision based on reputation for high quality.



Registration denied for "SWISSCELL" batteries for lighting by examiner because mark is geographically

OVERRULED by TTAB
Mark held not primarily geographically deceptively misdescriptive, because of a lack of evidence. PTO had only "tenuous evidence" consumers would expect the batteries to come from Switzerland and because the evidence for materiality of misrepresentation fell short of showing "that Switzerland is noted for batteries for lighting."

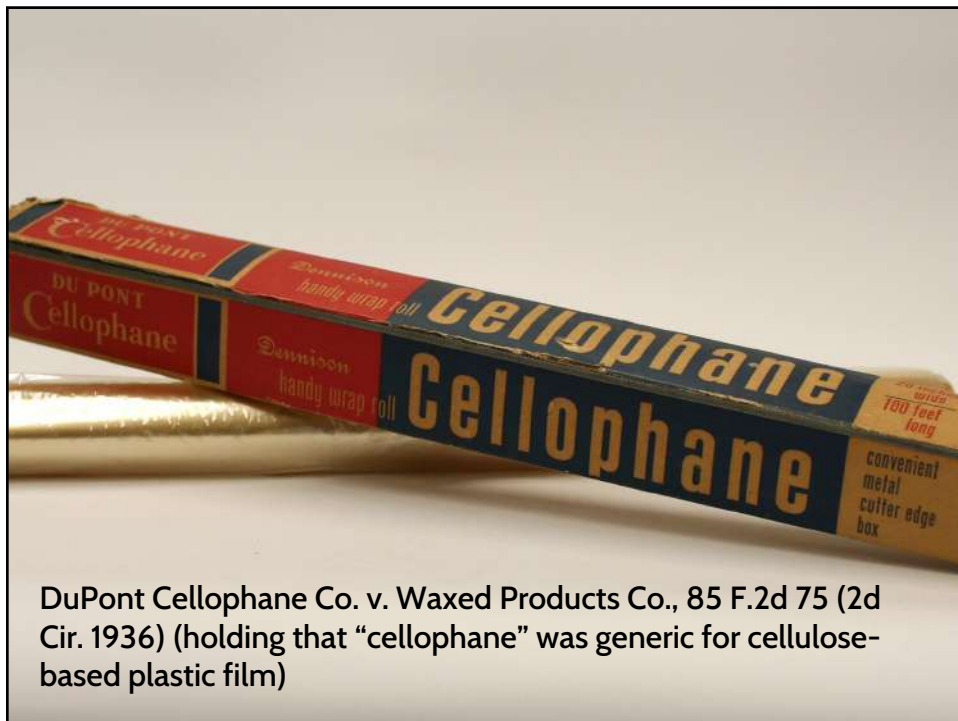
genericness ...



Bayer Co. v. United Drug Co., 272 F. 505 (S.D.N.Y. 1921)
(holding that “aspirin” was generic for acetylsalicylic acid)



King-Seeley Thermos Co v. Aladdin Industries Inc., 321 F.2d 577 (2d. Cir. 1963) (holding that “thermos” was generic for a vacuum-insulated bottle)



DuPont Cellophane Co. v. Waxed Products Co., 85 F.2d 75 (2d Cir. 1936) (holding that “cellophane” was generic for cellulose-based plastic film)



A.J. Canfield Co. v. Honickman, 808 F.2d 291 (3d Cir.1986)
(holding that “diet chocolate fudge soda” was a generic phrase)



Donald F. Duncan, Inc. v. Royal Tops Mfg. Co., 343 F.2d 655 (7th Cir. 1965) (holding that “yo-yo” was generic for return top)



Kellogg Co. v. National Biscuit Co., 305 U.S. 111 (1938)
(holding that trademark law would not allow Nabsico to prevent rival Kellogg's from making its own shredded wheat cereal; the cereal's shape was functional, and therefore unprotectable as a trademark, and the term "shredded wheat" was generic, and therefore unprotectable as well)



If a trademark is misused it could
come undone.

If you didn't know zipper was a trademark, don't worry, it's not. But it used to be. It was lost because people misused the name. And the same could happen to ours, Xerox. Please help us ensure it doesn't. Use Xerox only as an adjective to identify our products and services, such as Xerox copiers, not a verb, "to Xerox," or a noun, "Xeroxes." Something to keep in mind that will help us keep it together.

xerox.com

Ready For Real Business 

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This is an example of prophylactic advertising done for prospective use in litigation to defend against an invalidity attack based on the the XEROX mark having become generic.

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How much probative value does this have?

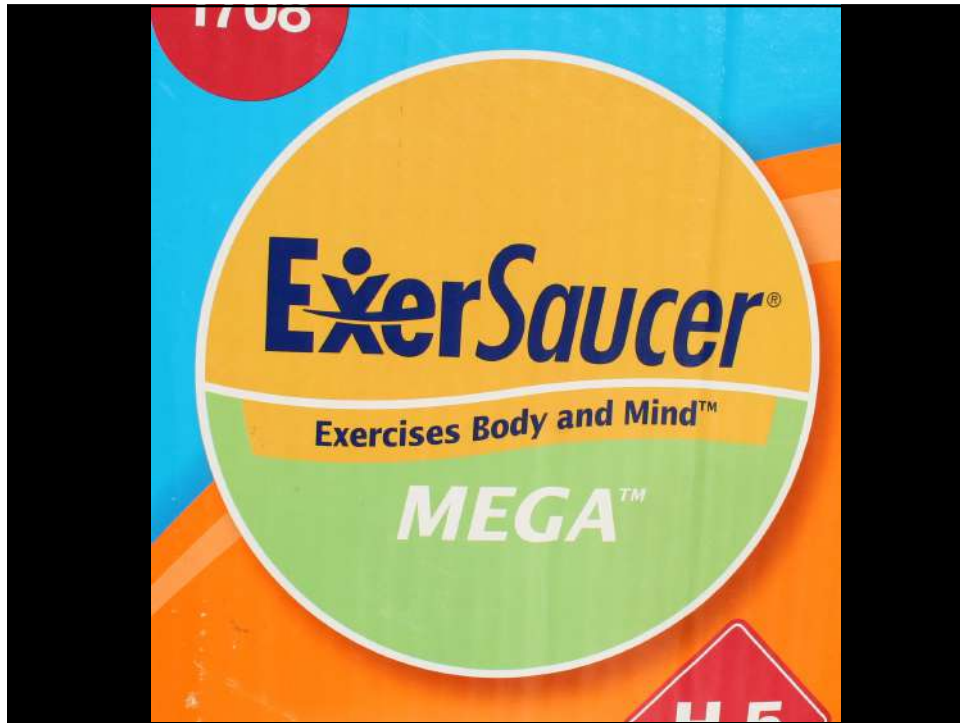
Probably not much.

What matters legally is not that Xerox is running these ads—what would matter is if they are effective in changing the public's use and understanding of the word.

But regardless, the fact that Xerox has put in this effort is something a judge or jury might latch on to, and that's probably what Xerox is really hoping for.

What do we make of this stuff?















A Charge Tube
Super-heated air is injected and mixed with the hot gases from the primary firebox and starts the secondary combustion process. No catalytic device needed.

B Large Reaction Chamber™
Final combustion occurs in the Reaction Chamber where extremely high temperatures aid in complete combustion. The Reaction Chamber features a large, hinged door for easy ash removal.

C EPA Hangtag
The E-Classic 2400 is EPA Phase 2 Hydronic Heater Program qualified.

D Urethane Foam Insulation
Insulation is sprayed on and forms a 100% airtight, waterproof seal around the water jacket.

E Triple Insulated Firebox Door
Ergonomically designed door is lockable and features a large opening for easy loading. Door is triple insulated for maximum efficiency. Panels are powder coated for durability. The heavy-duty door handle is lockable.

Door Closure
The door is closed by a heavy-duty door handle, for a tight seal.



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