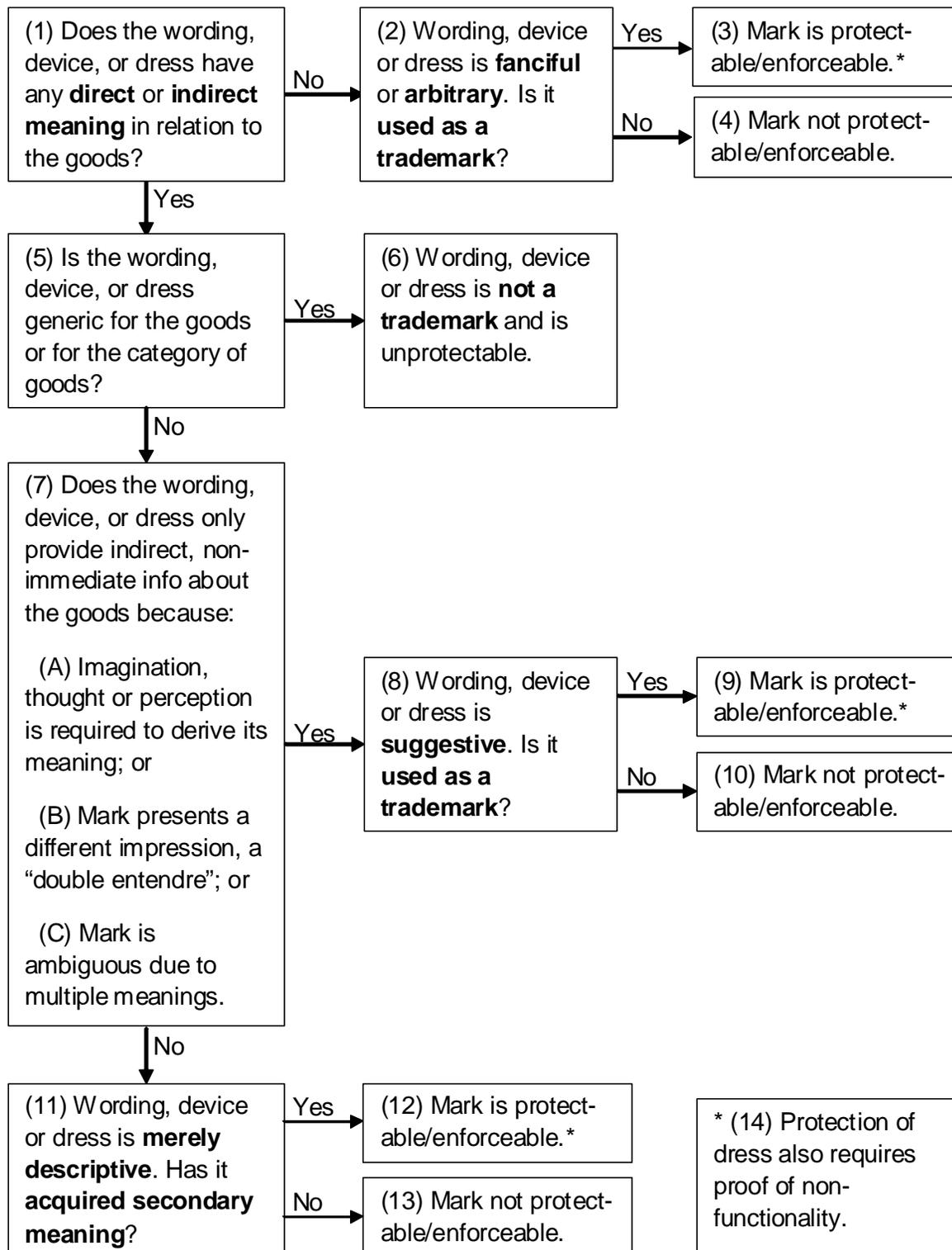


**Trademarks & Unfair Competition, Summer 2007
Final Exam with Model Answer**

Scenario One

The web site *LawSchoolCheatSheets.com* offers the following chart for assessing whether a purported mark or trade dress is protected against infringement and can be enforced:



The chart uses the word “device” to refer to graphic elements used in a logo, with or without additional wording. The chart uses the word “dress” to refer to trade dress in all its forms, as well as to colors claimed to be a trademark.

The following answers are not necessarily complete and comprehensive, and partial credit was given for various additional pertinent observations and arguments. A maximum of 7 points was awarded on each of these five questions.

Q1. What is the difference between options (B) and (C) in Box 7? Briefly describe one or two cases (court or TTAB) exemplifying each of these theories.

Option B is the well established theory that rather than perceive a mark as merely descriptive, relevant consumers will perceive it predominantly as a play on words or that it generally presents an overall impression different from its literal meaning. A classic example is the mark SUGAR & SPICE, which literally lists ingredients in some baked goods, but which would call to mind the nursery rhyme and the phrase “and everything nice.” The mark POLY PITCHER also could be considered to fall into this category. Industry insiders realized that poly referred to polyethylene, the substance of which the pitcher was made, but the court ruled that relevant consumers would perceive the mark as a reference to (or play on) Molly Pitcher, of Revolutionary War fame.

Option C is the less used argument that a word or phrase does not provide “immediate” information when it could be considered ambiguous because, in the context of the goods, it has multiple potential meanings. The sample office action responses for descriptiveness refusals (Nos. 2, 3, and 4) cited the Federal Circuit’s decision in In re Hutchinson Technology Incorporated as an example, where TECHNOLOGY was found not to convey specific information. They also cited the opinion of the TTAB regarding DIET-TABS, and two unpublished TTAB rulings. In each case, the information provided by the wording was too general to meet the test for a descriptive mark.

Q2. Box 7 is missing an argument often used successfully to distinguish suggestive marks from descriptive ones. What is that theory? Briefly describe one or two cases (court or TTAB) applying this theory.

The missing theory is that a phrase considered to be “incongruous” will be deemed suggestive rather than descriptive. A classic example is the mark MOUSE SEED, which is incongruous when used with poison pellets because the word “seed” usually is associated with life rather than death. The TTAB found VEGGIE VISE to be incongruous because it was illogical to imagine that one would need to use a vise to hold a vegetable onto a cutting board. Marks mixing English-language and foreign-language terms also have been deemed incongruous in some cases (e.g., LE CASE, LA YOGURT). These marks are not incongruous in relation to the goods, but the mix of languages gives them a similar “stop and think” quality that is associated with a suggestive rather than a descriptive mark.

Several students answered this question with the “third party use” or “competitor’s use” considerations. When several competitors are using the same term, it tends to show that the term has some descriptive significance, since companies are unlikely to all choose the same non-descriptive terms. And generally speaking, when third parties use a mark, it may become “diluted” and retain only narrow source identifying significance. However, I was looking for a theory that — like the imagination test and double entendre — would explain why some combinations that might seem descriptive are in fact deemed suggestive. Third party use, on the other hand, is more an evidentiary consideration in assessing each of the theories.

Q3. Is the chart correct in requiring use of fanciful, arbitrary, and suggestive marks (Boxes 2 and 8) before such marks can be protected? Briefly discuss whether the chart should provide, in the alternative, that rights in such inherently distinctive marks can be enforced against third parties once an intent-to-use application has been filed.

Generally speaking, rights in a trademark are established by use, not invention. This common law rule was modified with the creation of the intent-to-use system, but the benefit of being able to exercise rights as of the filing date require that the mark mature to registration. Such rights cannot be enforced during the interval between filing and registration. The chart therefore should not be modified. (On the other hand, any users adopting the mark during that time will be powerless to prevent the first filer from using the applied-for mark, thereby perfecting its registration. But enforcement must wait until that time.)

There might be a minor exception to the chart for registrations obtained under the Paris Convention by foreign filers based on a registration in the home country. Under the Dawn Donut rule, even if such a registration could be enforced in theory, a court would be reluctant to grant injunctive relief if the foreign filer were not yet using the mark in the U.S.

Q4. The chart’s treatment of trade dress might be misleading. What edit should be made (or what footnote should be added) to Boxes 1 and 7 to conform to current Federal law, and why?

Since the Supreme Court’s decision in Wal-Mart v. Samara Brothers, courts distinguish between “product design” and “product packaging.” In the case of “product design,” a party seeking protection for trade dress must prove that it has acquired secondary meaning. This is not true for product packaging, which can in theory be inherently distinctive. Therefore, Boxes 1 and 7 need a notation that “product design” dress requires proof of secondary meaning.

Since the Supreme Court did not draw a very clear line between “product design” and “product packaging” in other contexts (although it declined to overrule Two Pesos), the rule is that in cases of doubt, courts should require secondary meaning. The notation should reflect this as well.

At least one student suggested that the chart should reference the Seabrook analysis of inherent distinctiveness for trade dress. That’s a good idea, although the Supreme Court did hold in Two Pesos that the Abercrombie spectrum is the appropriate framework.

- Q5. Some might argue that another box should be inserted between numbers 2 and 3, 8 and 9, and 11 and 12. The box would ask whether the mark actually is “distinctive in the marketplace.” Does such a box belong in this chart? Briefly explain why or why not.

A mark that is inherently distinctive (Box 2 to 3: fanciful or arbitrary; Box 8 to 9: suggestive) is likely to be perceived as a source identifier, rather than a description. However, if others use the same or similar marks, then the mark may fail to signal a particular source; consumers might have to rely on other indications to answer the question “Which Acme is this?” Conversely, in some cases courts or the TTAB may conclude that despite the theoretical distinctiveness of a mark, it is not well known to relevant consumers and therefore, having little or no actual recognition in the marketplace, it fails to signal a particular source.

While these concerns are legitimate in considering whether a mark is infringed or whether a trademark owner is entitled to a broad injunction, the chart only answers the question of whether a mark is eligible for protection. If the mark is distinctive, then the fact that the mark might be weak is a separate issue better addressed under the “strength” factor of the likelihood of confusion test.

A mark that has attained secondary meaning (Box 11 to 12) has been proven to be distinctive in the marketplace: relevant consumers recognize that the primary significance of the mark is to identify the trademark owner as the source. Thus, no additional box is needed there.