



Identity & Origin  
Trademark

# Trademark Substantive Standards for Protection

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Konomark  
Most rights sharable

# source

## The need for distinctiveness

- Whether to be registered on the primary register under the Lanham Act, *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

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- A mark must be distinctive!
- It is only by being distinctive that it can signify a source
- 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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inherently distinctive	fanciful arbitrary suggestive	<i>misdescriptive</i>	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	immoral disparaging names/likenesses of living people gov't symbols

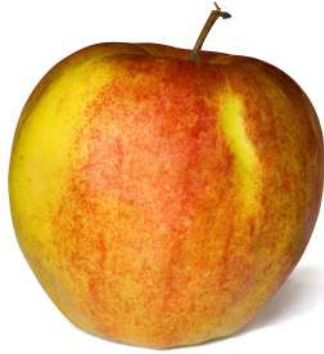
# Kodak

fanciful

# Apple (for computers)



# Apple (for an apple)



*held:  
suggestive*



***Wite-Out***<sup>®</sup>

held:  
suggestive



**DELTA**







held:  
suggestive

drink

ORANGE  
**Crush**

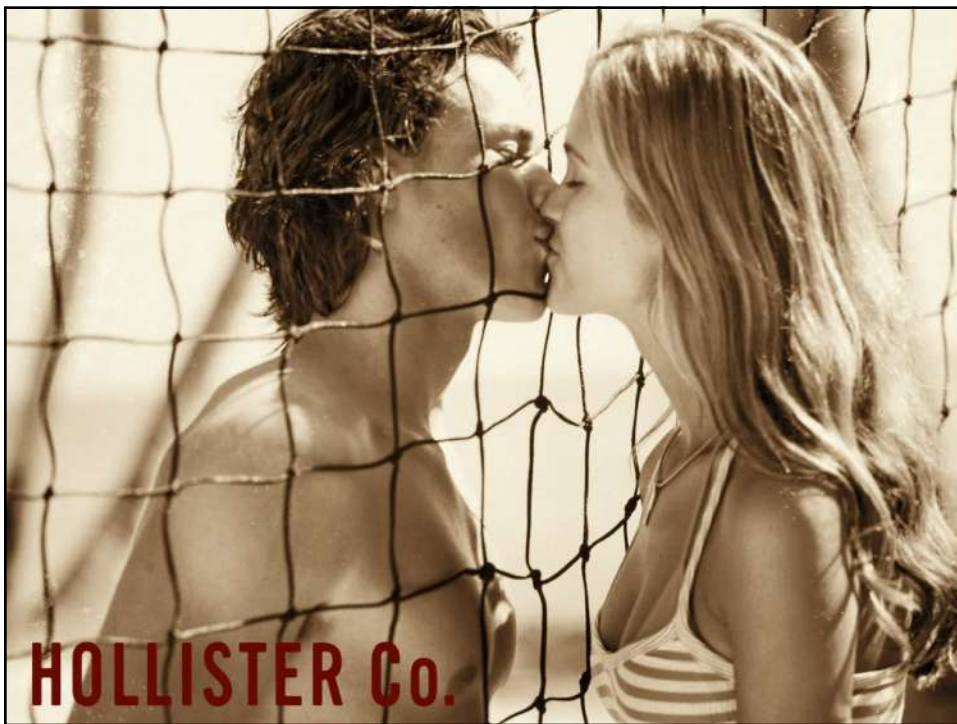
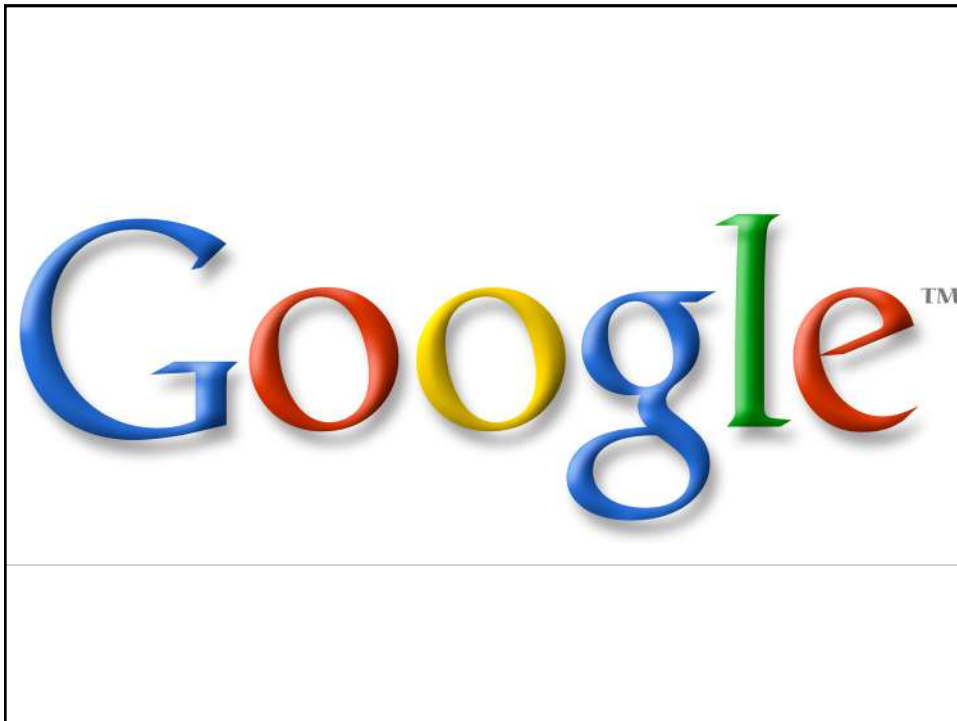
refreshing delicious

A glass bottle of Crush Orange soda is shown on the right side of the advertisement, with condensation on the glass. The bottle is set against a background of ice cubes and a light blue liquid.

held:  
suggestive

The Citibank logo features the word "citibank" in a blue, lowercase, sans-serif font. A red arc is positioned above the "i" and "t".





**travel**  
CHANNEL®

**accenture**



**GOLF CHANNEL®**



**American Airlines®**









The Exxon logo is displayed in a white rectangular box with a black border. The word "Exxon" is written in a bold, red, sans-serif font. The second 'x' is stylized, with its top bar overlapping the top bar of the first 'x' and its bottom bar overlapping the bottom bar of the first 'x'.

deceptively  
misdescriptive  
and deceptive ...

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inherently distinctive	<i>misdescriptive</i>				
can acquire distinctiveness	deceptively misdescriptive				
unprotectable	deceptive				

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

geographically ...



Primarily  
geographically  
descriptive?

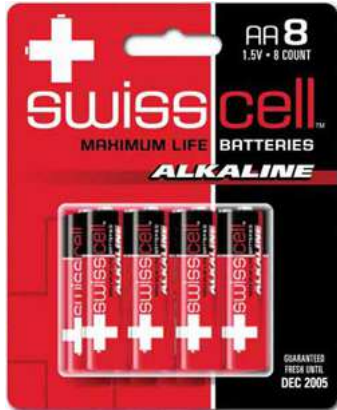
(Company is in  
California and  
provides janitorial  
services there.)



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.”



Primarily  
geographically  
deceptively  
misdescriptive?

(Battery company is  
in New Jersey)

inherently distinctive	fanciful arbitrary suggestive	<i>misdescriptive</i>	inherently distinctive product packaging		
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Registration denied for "SWISSCELL" batteries for lighting by examiner because mark is primarily geographically deceptive/misdescriptive because Switzerland is a place where batteries are manufactured 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 primarily geographically deceptive/misdescriptive

**OVERRULED by TTAB**  
Mark held not primarily geographically deceptive/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."

color ...





### SUN GLOW® PRESS PADS

Leading the industry in fit, performance and durability, **Sun Glow® Press Pads** are consistently used by more award-winning dry cleaning plants, by a margin of 8 to 1, than any other press pad on the market.



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(The color on your screen may NOT be an accurate display of the Qualitex Green Gold!)

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product  
design ...

Wal-Mart v. Samara “a line of spring/summer one-piece seersucker outfits decorated with appliques of hearts, flowers, fruits, and the like”



Disney



Land's End



Carters



Mon Petit

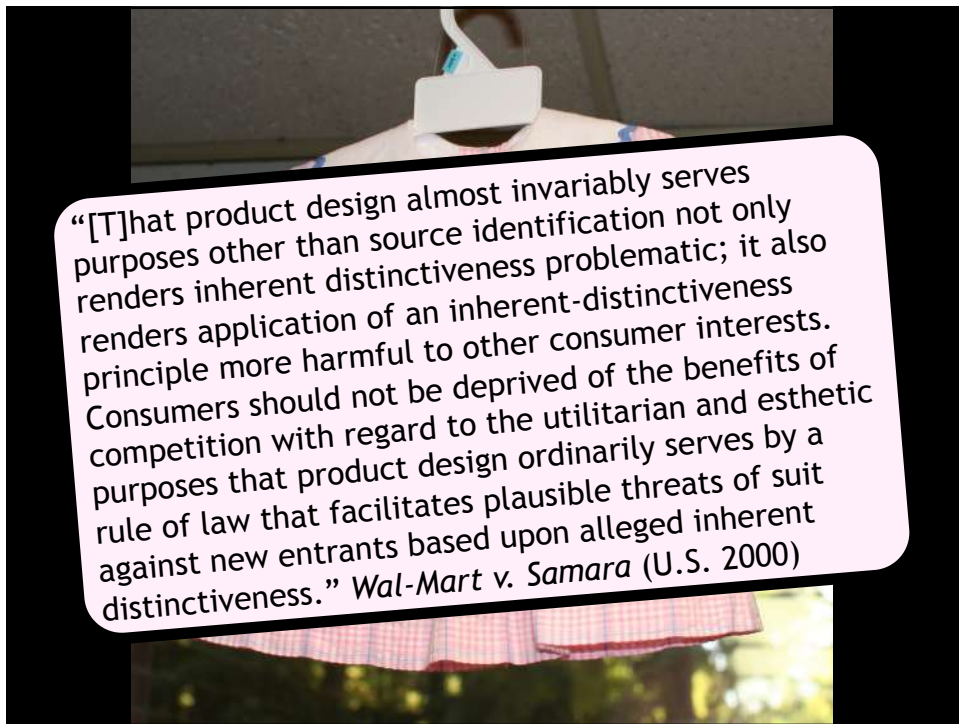


New Potatoes

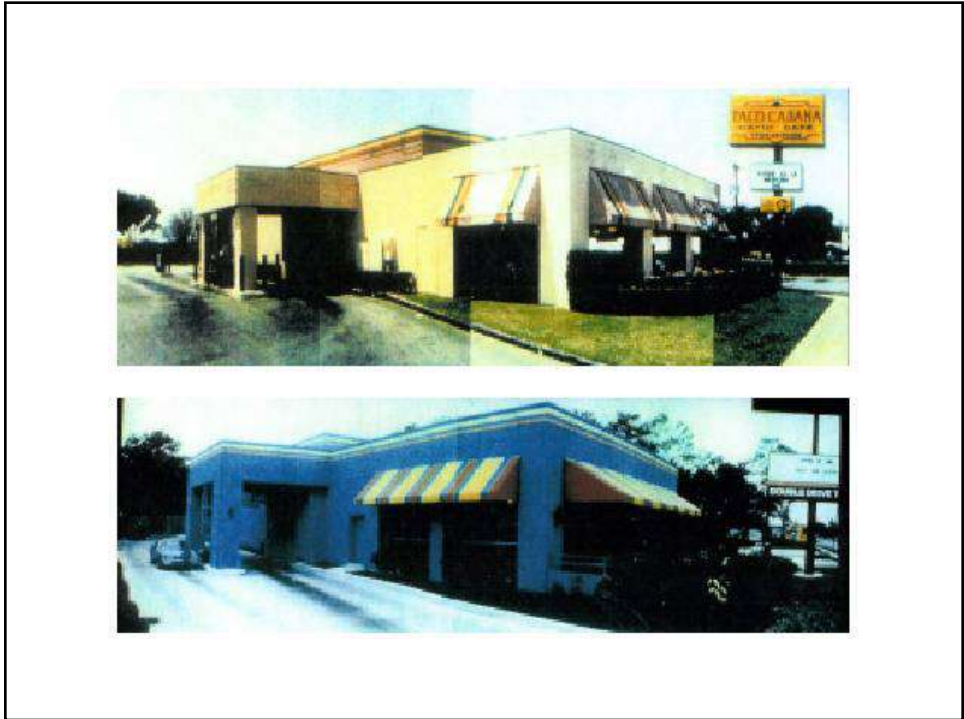
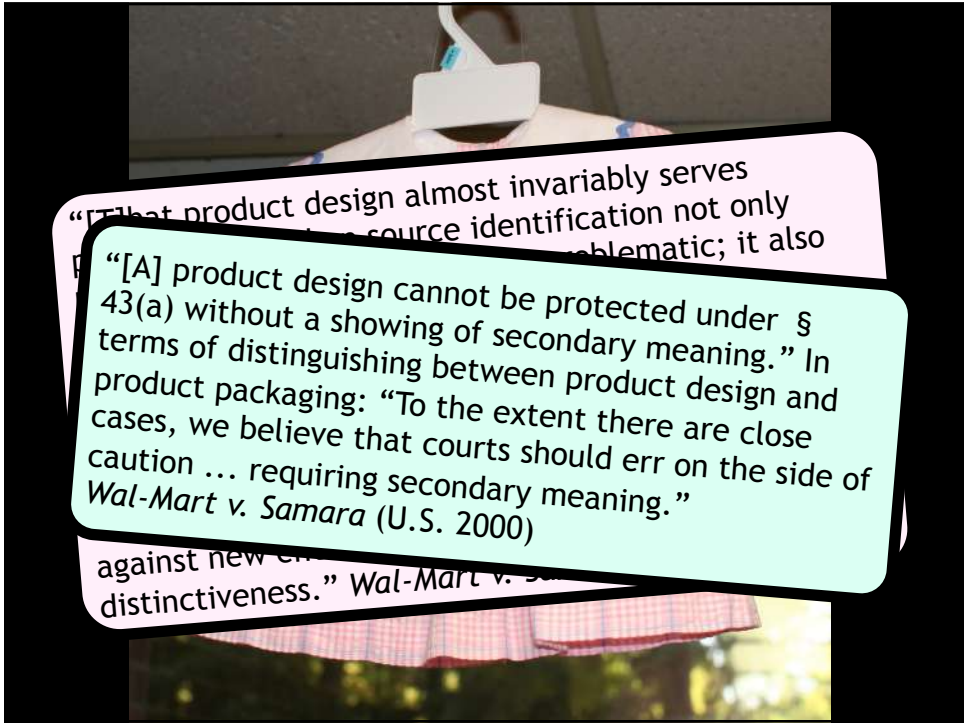


Homespun Heaven



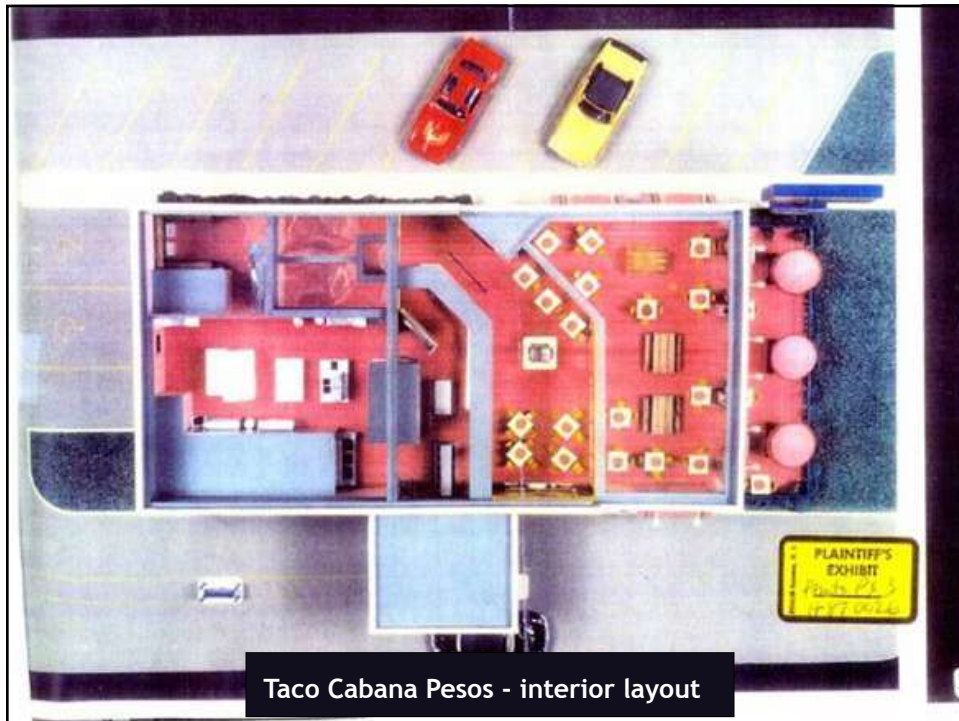


“[T]hat product design almost invariably serves purposes other than source identification not only renders inherent distinctiveness problematic; it also renders application of an inherent-distinctiveness principle more harmful to other consumer interests. Consumers should not be deprived of the benefits of competition with regard to the utilitarian and esthetic purposes that product design ordinarily serves by a rule of law that facilitates plausible threats of suit against new entrants based upon alleged inherent distinctiveness.” *Wal-Mart v. Samara* (U.S. 2000)

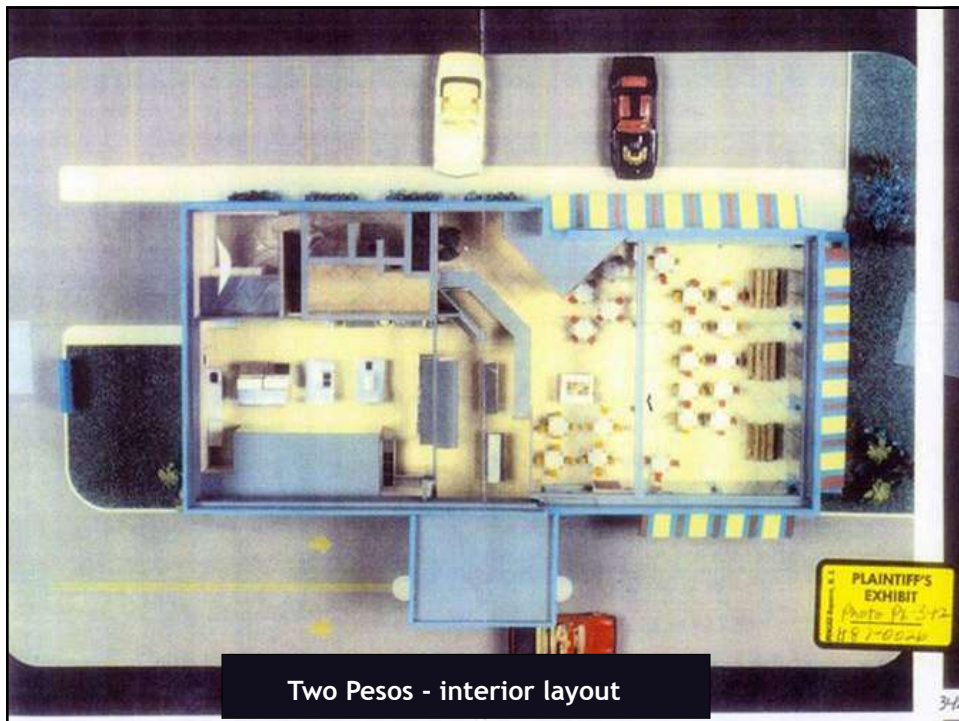








Taco Cabana Pesos - interior layout



Two Pesos - interior layout



# genericness ...





*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)

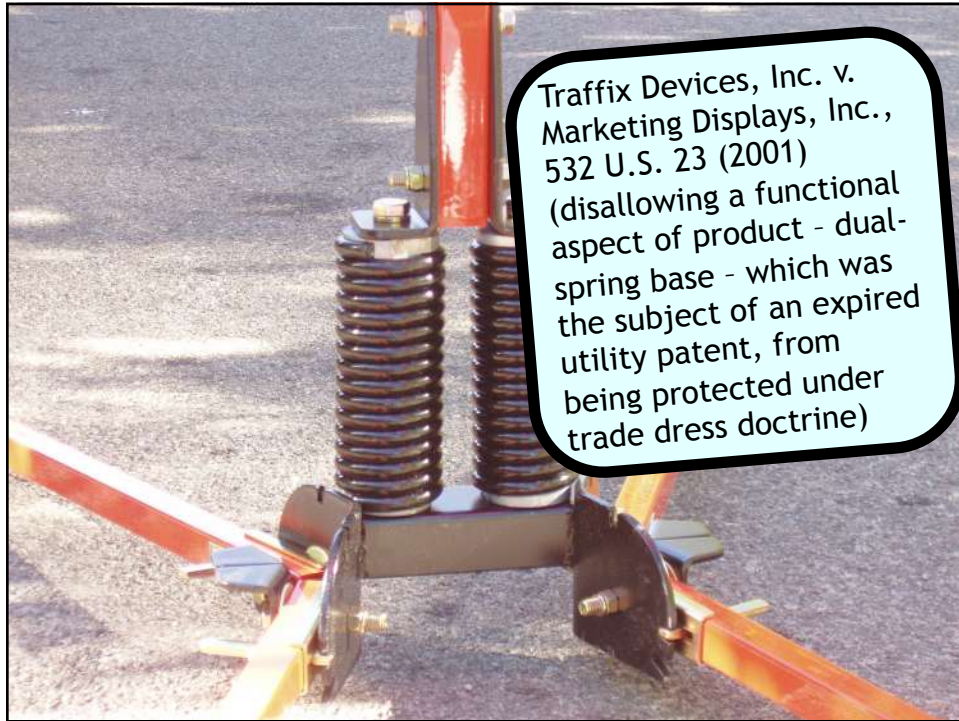
# functional matter ...



*Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938)  
(holding that trademark law would not allow Nabsico to prevent rival Kellogg 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)

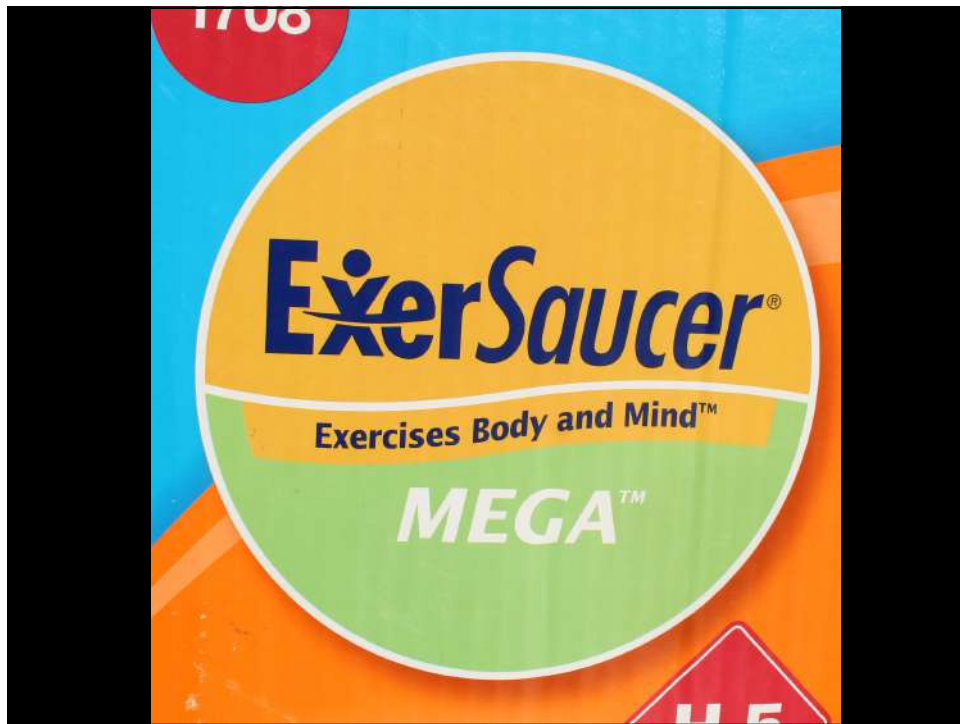


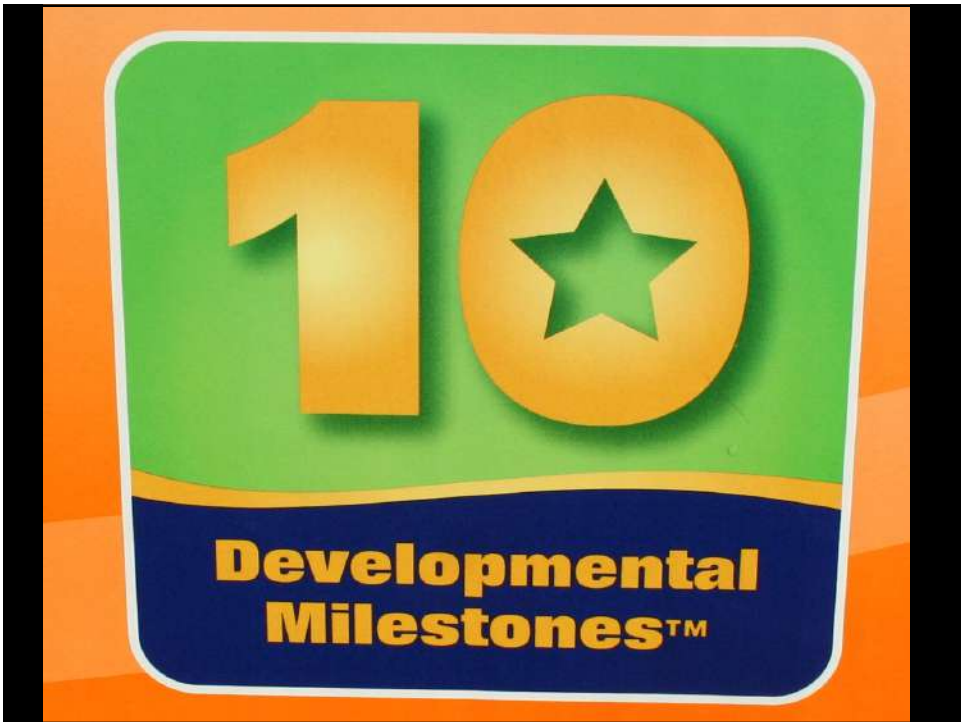




Traffix Devices, Inc. v.  
Marketing Displays, Inc.,  
532 U.S. 23 (2001)  
(disallowing a functional  
aspect of product - dual-  
spring base - which was  
the subject of an expired  
utility patent, from  
being protected under  
trade dress doctrine)

What do we  
make of this?















**CENTRAL BOILER**

## E-CLASSIC

### 2400 IGNITION READY

Outdoor Wood Furnace

**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 efficiency. Panels are powder coated for long life. Duty door handle is durable.

**F High Capacity Water Jacket**  
Provides maximum heat output.

**G Insulation Chamber**  
Insulation is sprayed on and forms a 100% airtight, waterproof seal around the water jacket.

**H Triple Insulated Firebox Door**  
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**I Air Wash System**  
Prevents ash from accumulating on the heat exchanger.

**J Ash Pan**  
Removes ash from the furnace.

**K Air Wash System**  
Prevents ash from accumulating on the heat exchanger.

**L Air Wash System**  
Prevents ash from accumulating on the heat exchanger.

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