



Identity & Origin  
Trademark

# What a *Corrected Version* Trademark Is; Distinctiveness

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Konomark  
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# source

## 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









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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)







## The need for distinctiveness

- Whether to be registered on the primary 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))

**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

How would you classify this mark?

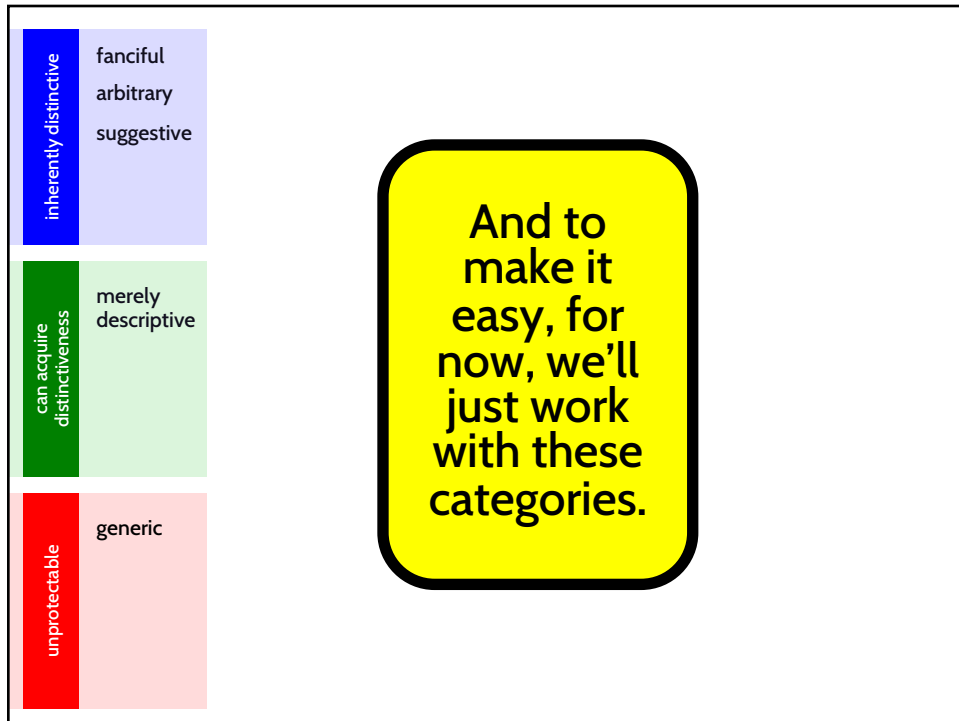
# Kodak

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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# Apple (for computers)

(likely)  
arbitrary



# Apple (for an apple)



generic





held:  
suggestive

drink



refreshing delicious

*Coca-Cola*<sup>®</sup>

merely  
descriptive  
(with acquired secondary  
meaning)





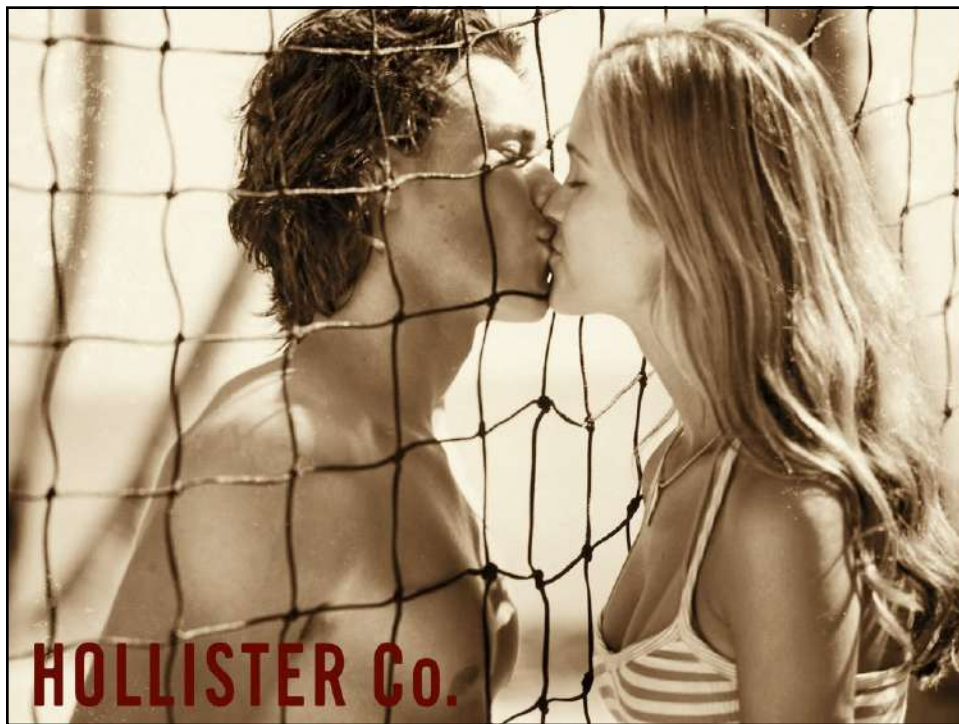
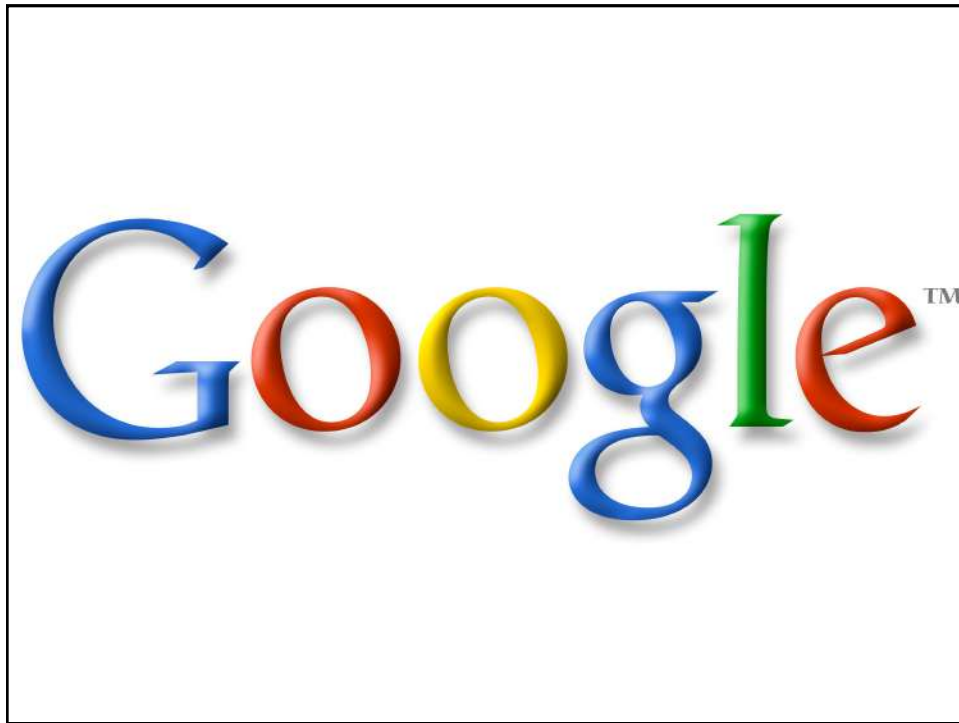
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