



Identity & Origin
Trademark

Priority, Registration and Incontestability

Eric E. Johnson
ericejohnson.com



Konomark
Most rights sharable

source

first, some corrections ...

inherently distinctive	fanciful arbitrary suggestive	misdescriptive			inherently distinctive product packaging
<div>This is the previously shown table before correction.</div>					
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

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	immoral disparaging names/likenesses of living people <u>without consent</u> gov't symbols

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

So this is the corrected table that you should use.

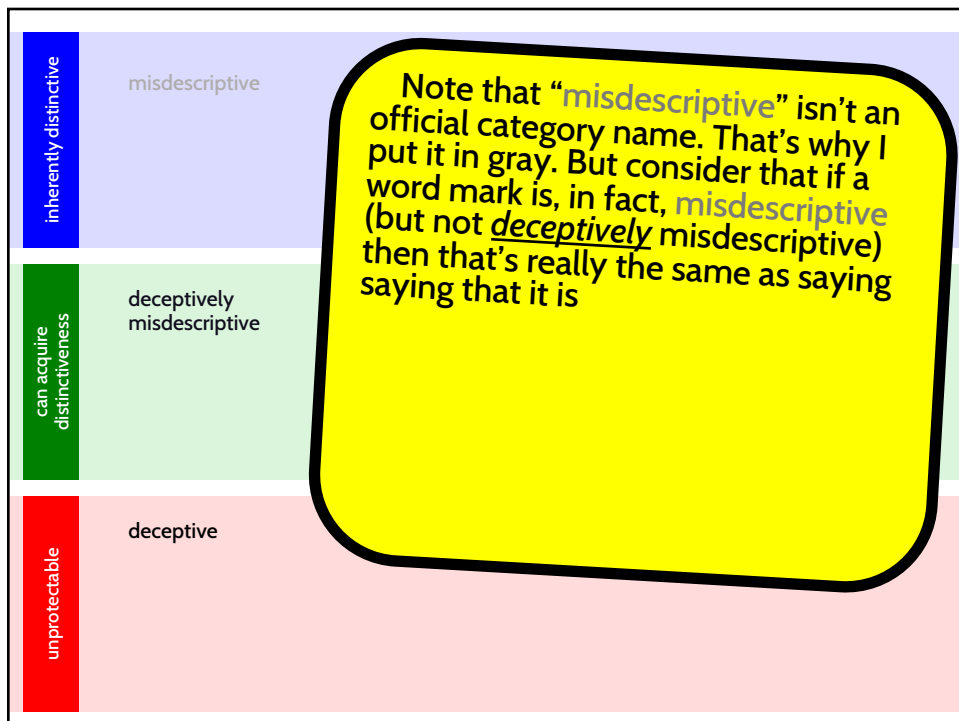
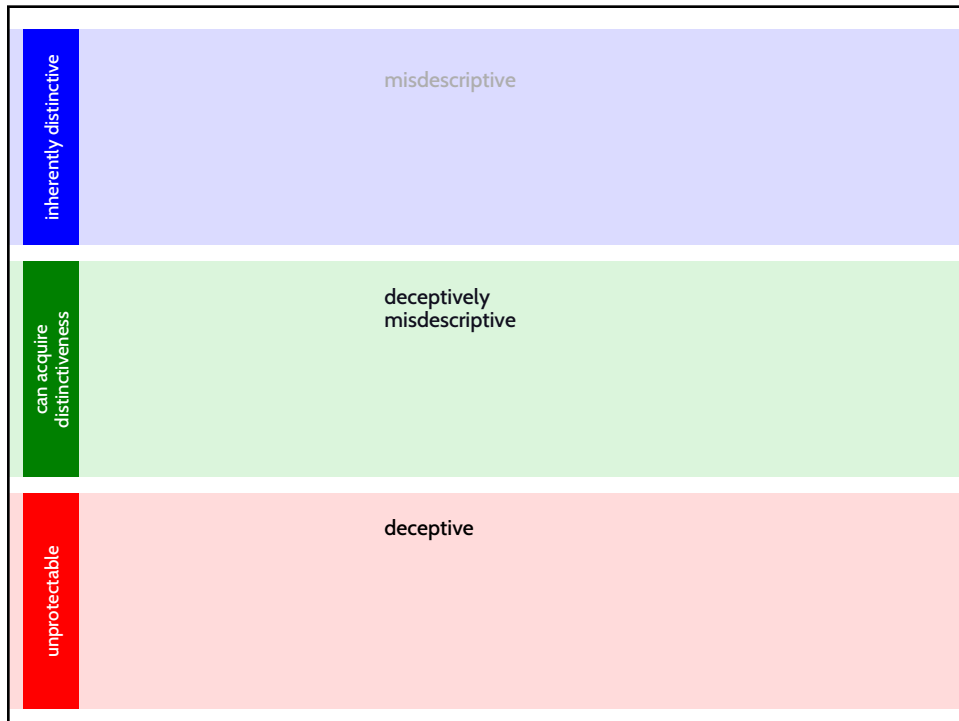
inherently distinctive	fanciful arbitrary suggestive	misdescriptive			inherently distinctive product packaging
can acquire distinctiveness	merely descriptive	primarily geographically descriptive	deceptively misdescriptive	non-inherently distinctive product packaging product design color	primarily a surname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

deceptively
misdescriptive and
deceptive ...

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

We're gonna remember
these with "IRONROOF"

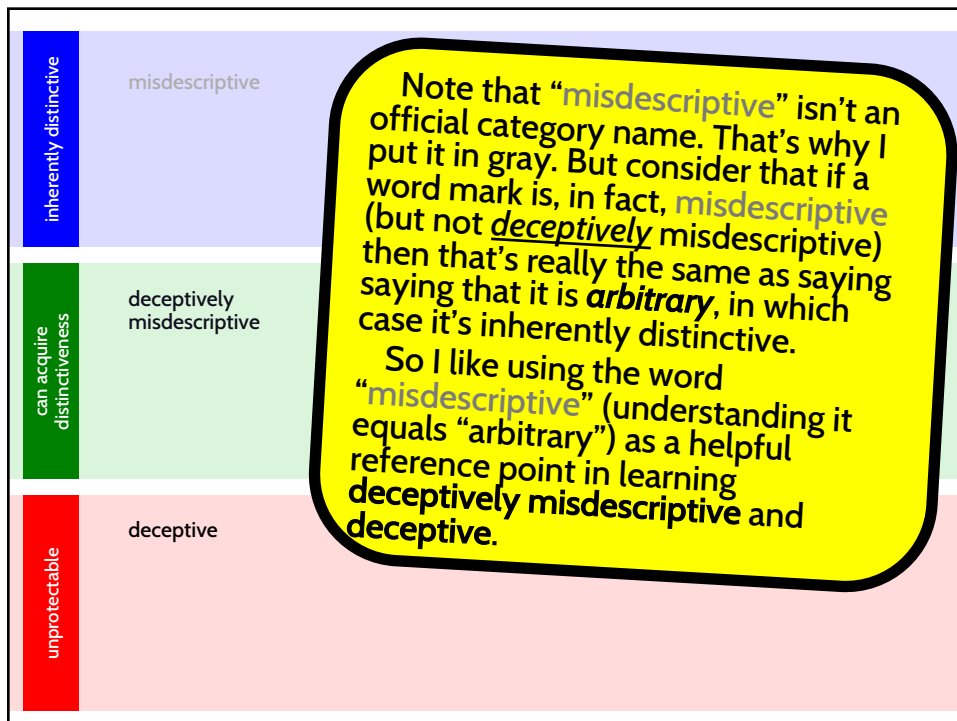
deceptively
misdescriptive and
deceptive ...



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

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 **arbitrary**, in which case it’s inherently distinctive.



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.

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	IRONROOF (for accounting 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 ...

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

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.”

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



Primarily
geographically
deceptively
misdescriptive?

(Battery company is in
New Jersey)



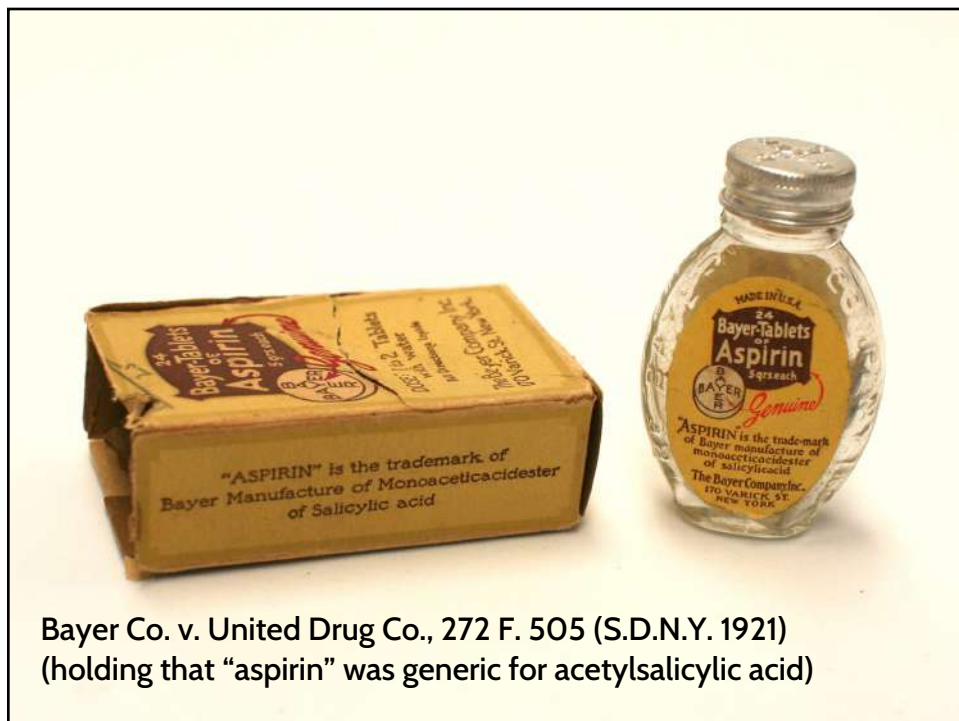
Registration denied for "SWISSCELL" batteries for lighting by examiner because mark is primarily geographically deceptively misdescriptive because Switzerland is a place where batteries are manufactured and this could influence the consumer's purchasing decision based on reputation for high quality.



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

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 ...





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)



If a trademark is misused it could come undone.

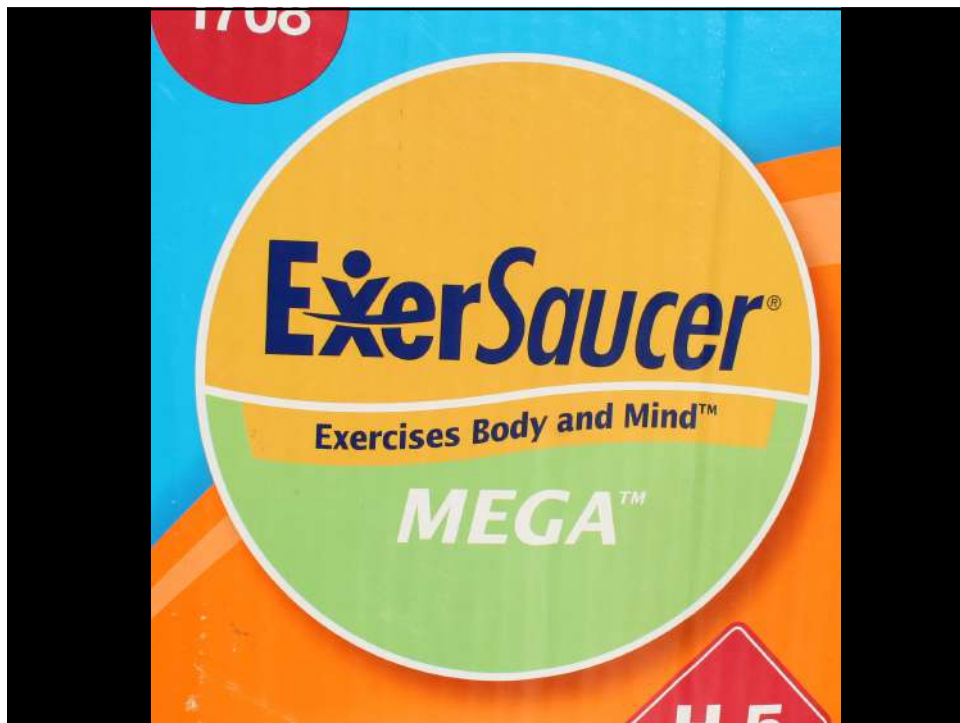
If you didn't know zipper was a trademark, don't worry, it's not. But it used to be. It was lost because people misused the name. And the same could happen to ours, Xerox. Please help us ensure it doesn't. Use Xerox only as an adjective to identify our products and services, such as Xerox copiers, not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

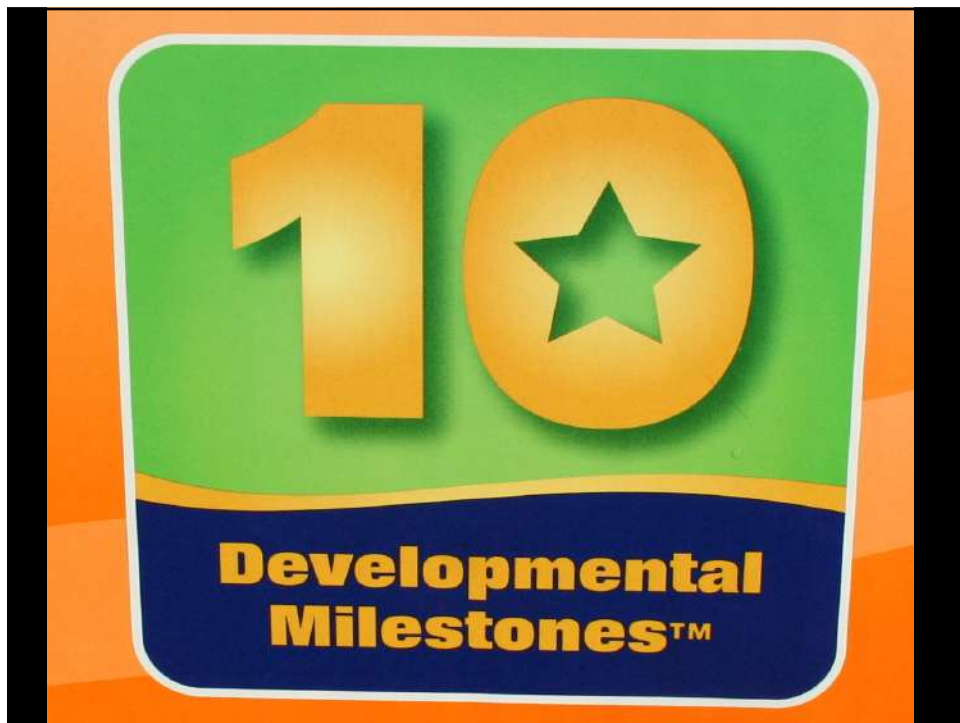
xerox.com

Ready For Real Business **xerox** 

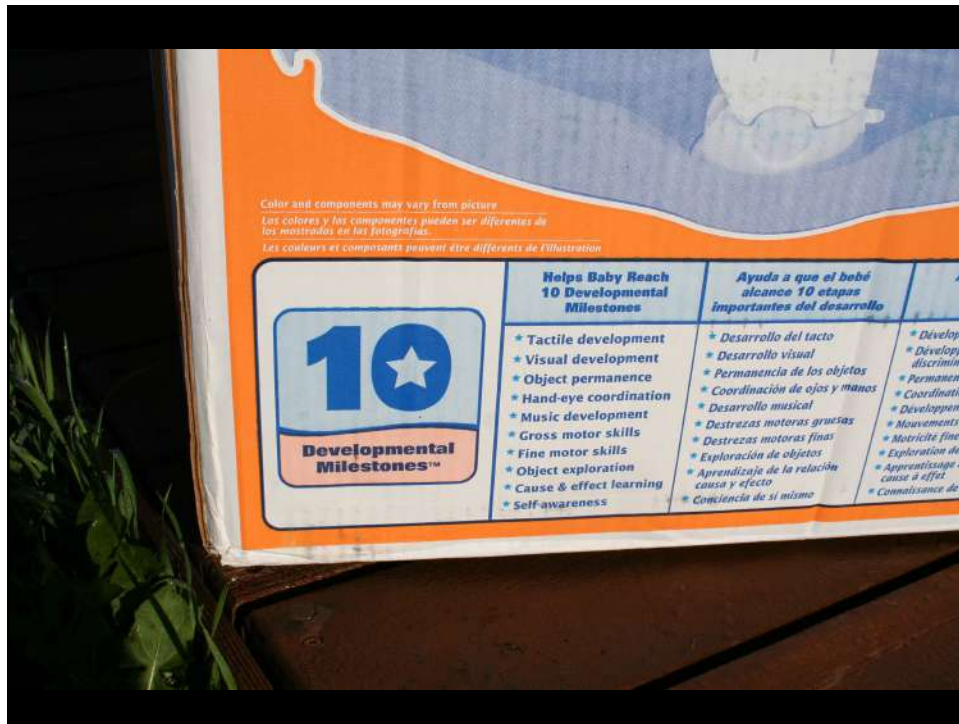
©2015 XEROX CORPORATION. All rights reserved. "Xerox," "XEROX and Design" and "Ready For Real Business" are trademarks of Xerox Corporation in the United States and/or other countries.

What do we make of this?









priority ...

Trademark Priority

- Two different firms can't both have the same trademark in the same market, because that would mean the mark doesn't indicate a particular commercial source.
- Between two rivals to the same mark, priority belongs to the first to use the mark in commerce in the relevant market (both product and geographical).
- Federal registration and geography:
 - Federal registration (on the primary register) provides constructive nationwide use.
 - Prior users get to carry on in their geographic market.
 - But constructive nationwide use gives the federal registrant priority everywhere else.









1953: A Burger King ("Big BK," destined for big things) opens in Jacksonville, Florida.

1957: Big BK now 38 restaurants across six southern states.

1957: A differently owned Burger King ("Little BK") opens in Mattoon, Illinois.

1961: Big BK federally registers (getting constructive nationwide use).

1962: Little BK tries to open in Charleston, Illinois. Not allowed. But the original Mattoon BK can continue indefinitely.