



Identity & Origin
Trademark

Trademark Fundamentals and Distinctiveness; Lanham Act Registration

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Konomark
Most rights sharable

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

TM











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))

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))

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

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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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unprotectable	generic

And to make it easy, for now, we'll just work with these categories.

Kodak

fanciful

Apple (for computers)



Apple (for computers)

(likely)
arbitrary



Apple (for an apple)



Apple (for an apple)



generic