



Registration

Trademark & Unfair Competition
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Konomark
Most rights sharable

Important note about this chapter/topic

- Chapter 12 “Registration” in Grynberg contains a lot of important content that goes to the validity of a valid mark, which can be generally assumed to be applicable to unregistered marks under the common law or § 43(a) of the Lanham Act.
- So consider this material to have relevance to questions beyond what registration entails and whether or not a mark is registerable.
- See, e.g., the Table of Distinctiveness, which I offer as general picture of protectability of marks whether via registration on the principal register (§ 2, 3, 32) or litigated via common law or § 43(a).

The "Table of Distinctiveness"

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

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Two ways to be distinctive

Re-run

- “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))

deceptively
misdescriptive and
deceptive ...

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.

Budge/Shapley test for Deceptiveness

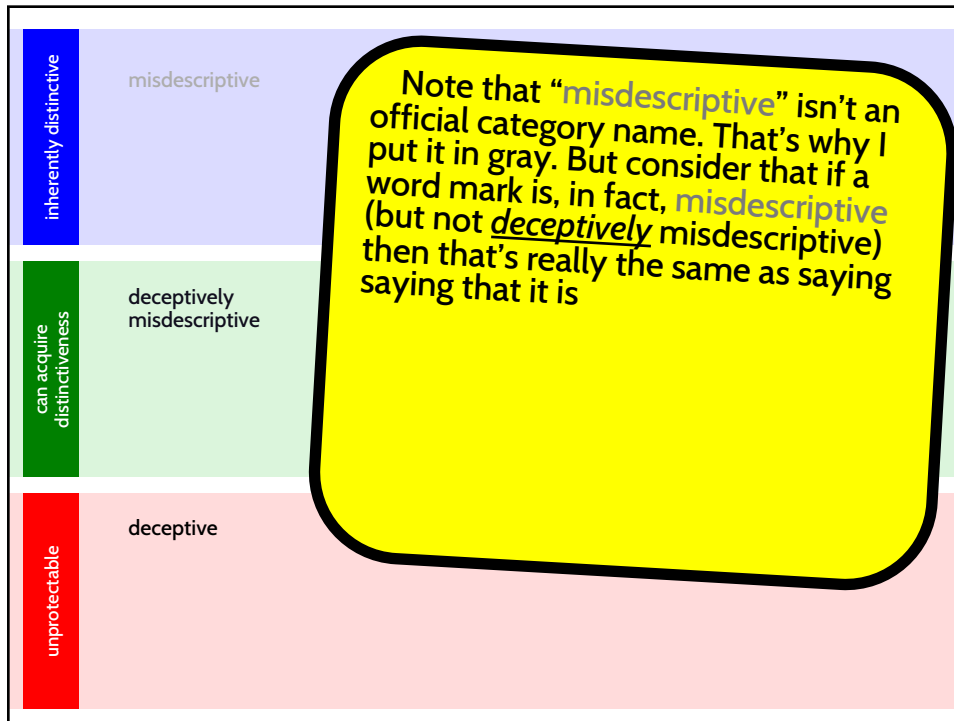
Is it deceptive and not registrable/protectable?

- Ask (1) whether the term is misdescriptive as applied to the goods, (2) if so, whether anyone would be likely to believe the misrepresentation, and (3) whether the misrepresentation would materially affect a potential purchaser's decision to buy the goods.
→ If the answer to all questions is YES, then it's deceptive.
- Also consider this "amplification" of the standard:
 - (1) Is the term misdescriptive of the character, quality, function, composition or use of the goods?
 - (2) If so, are prospective purchasers likely to believe that the misdescription actually describes the goods?
 - (3) If so, is the misdescription likely to affect the decision to purchase?→ Again, if you get a YES from all of these, then it's deceptive.

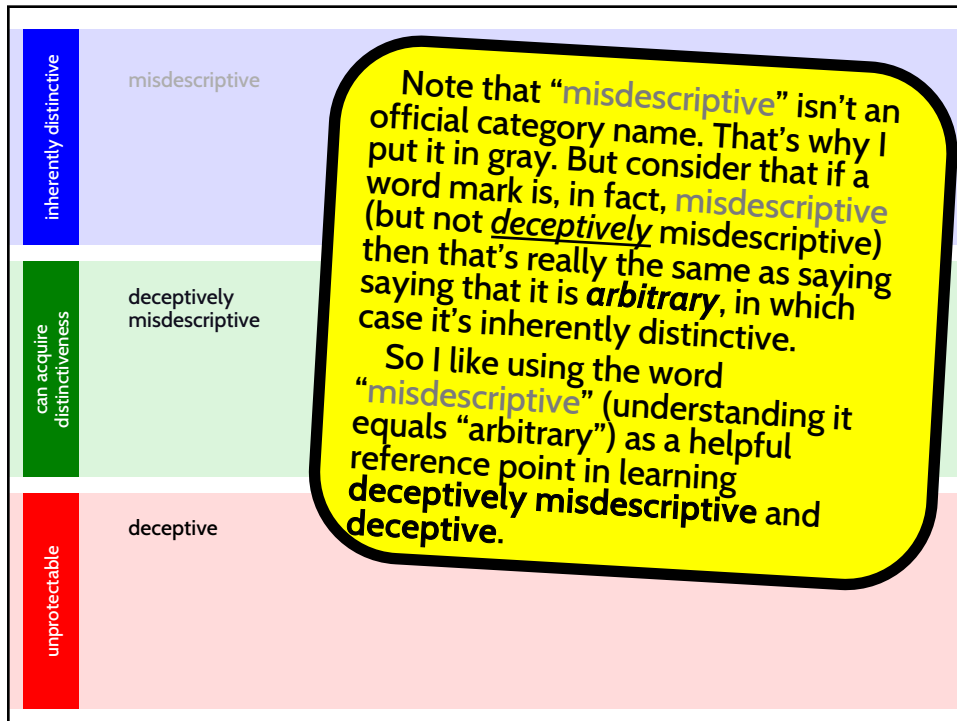
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We're gonna remember these with "IRONROOF"

deceptively
misdescriptive and
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IRONROOF

- for a restaurant with an aluminum-panel and asphalt-shingle roof
- for a tornado shelter made of plastic
- for accounting software

inherently distinctive	misdescriptive	<div style="border: 2px solid black; background-color: yellow; padding: 5px; display: inline-block; margin-bottom: 10px;"> <p>Okay, where would you put these three examples?</p> </div> <h1 style="margin: 0;">IRONROOF</h1> <ul style="list-style-type: none"> for a restaurant with an aluminum-panel and asphalt-shingle roof for a tornado shelter made of plastic for accounting software
can acquire distinctiveness	deceptively misdescriptive	
unprotectable	deceptive	

inherently distinctive	misdescriptive	<h2 style="margin: 0;">IRONROOF</h2> <p style="margin: 0;">(for accounting software)</p>
can acquire distinctiveness	deceptively misdescriptive	<h2 style="margin: 0;">IRONROOF</h2> <p style="margin: 0;">(for a restaurant with aluminum-panel and asphalt-shingle roof)</p>
unprotectable	deceptive	<h2 style="margin: 0;">IRONROOF</h2> <p style="margin: 0;">(for a tornado shelter made of plastic)</p>

geographically ...

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Primarily Geographically Descriptive vs. Primarily Geographically Deceptively Misdescriptive

Here's my boiling down of what the casebook says . . .

Primarily Geographically Descriptive vs. Primarily Geographically Deceptively Misdescriptive

Primarily Geographically Descriptive:

A mark is primarily geographically descriptive if:

- (1) the primary significance of the mark is a generally known geographic location;
- (2) the goods or services originate in the place identified in the mark; and
- (3) purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark

In which case, it is registrable/protectable only with secondary meaning.

Primarily Geographically Deceptively Misdescriptive:

A mark is primarily geographically deceptively misdescriptive if:

- (1) and (3), above, are true, and
- (2) the goods or services do not originate from the place identified, and
- (4) the geographical representation would materially affect a significant portion of potential purchasers' decision to buy

In which case it is not registrable/protectable at all.

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Primarily Geographically Descriptive vs. Primarily Geographically Deceptively Misdescriptive

Here's a more compact representation of the doctrine, if you prefer (which I based on the TMEP) . . .

(Use which ever one you prefer! They are analytically and substantively equivalent.)

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?

Yes

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

The TTAB said it was. That means registration will require a showing of secondary meaning.



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.”

ANTARCTIC

for retail sales of snow cones
from a food truck in Texas

(This is a hypothetical, FYI.)

Primarily geographically deceptively misdescriptive?

ANTARCTIC

for retail sales of snow cones
from a food truck in Texas

Primarily
geographically
deceptively
misdescriptive?

(This is a hypothetical, FYI.)

This would not be primarily
geographically deceptively
misdescriptive, because
consumers would not think
that the snow cones
originated from Antarctica.

No

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Primarily
geographically
deceptively
misdescriptive?

(Battery company is in
New Jersey)



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, consumers would likely believe the batteries were from Switzerland, 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

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."



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evidence" consumers would expect the
batteries to come from Switzerland and
because the evidence for materiality of
misrepresentation fell short of showing
"that Swiss"

That means this mark is registrable if it otherwise counts
as distinctive.

incontestability

Incontestability

- Once a mark has been in continuous use for five years following registration, the registrant can file an affidavit to that effect with the PTO. The mark then becomes “incontestable.”
- “Incontestable” doesn’t literally mean “incontestable,” but it does preclude the defendant from arguing that the mark lacks distinctiveness either for not being inherently distinctive or for lacking secondary meaning.

Valid defenses despite incontestability

The following defense is applicable per 15 USC § 1065:

- genericness

The following defenses are applicable per 15 USC § 1115:

- (1) registration or the incontestable right was obtained fraudulently
- (2) abandoned by the registrant
- (3) use of mark by or with the permission of the registrant so as to misrepresent the source of goods or services
- (4) fair use (the use of the mark is use - otherwise than as a mark – of the party’s individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin
- (5)&(6) a user has rights in the mark established prior to the registrant’s rights (but this defense applies only for the geographical area of continuous prior use
- (7) mark is being or has been used to violate the U.S. antitrust law
- (8) mark is functional
- (9) equitable principles, including laches, estoppel, and acquiescence