

# Trademark Analysis Synthesis

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[This document is very much a work-in-progress! Check back for a fuller and more refined version to be posted later!]

This handout is intended to give you a generalized to-do list for approaching typical trademark problems – mostly concerning whether an infringement has occurred, but also adaptable to answer more particular questions, such as whether something can be protected via trademark law

**Important notes regarding how this document relates to our course:**

First, note that **this document does not cover all the legal doctrine in the course**. This document attempts to provide a structure for applying core trademark law, but there will be substantial material covered in the course that is not embraced by this document.

Second, this document is not meant to be a source for helping you to understand the law. Rather, it is meant to be a road map for approaching problems in order to apply what you've learned.

Third, **do not try to make inferences about what will be on the exam from this document**. The amount of words devoted to a topic in this document reflects a judgment with regard to the amount of detail necessary to provide a comprehensible scheme for applying much of what you've learned. For topic coverage on the exam, as the syllabus says: "I work hard to ensure that the emphasis on the exam will track the emphasis in class and in the materials, and the topics covered on the exam will be at least roughly proportional to the time spent on those topics in the course." (This is what the syllabus calls the "Correspondence Principle.")

This document comes out of the Spring 2024 course in Trademark at OU College of Law.  
Course webpage: [http://www.ericejohnson.com/courses/Trademark\\_24/](http://www.ericejohnson.com/courses/Trademark_24/)

## Thinking of the Law in Action

***Think about the law functionally: What can you do with it? In what proceedings is it employed to some legal effect? What questions can trademark law answer?***

A variety of proceedings make use of trademark law, including an application to register a mark with the USPTO and an infringement lawsuit in court against a particular defendant.

This document primarily concentrates on infringement action for trademark infringement based on a passing-off theory. The principal cause of action for trademark is the action for infringement. And the archetypal theory of trademark infringement is that of “passing off.” Moreover, the analysis for a passing-off infringement case ends up including within it much of the analysis needed for other questions, such as whether a mark is registrable. **Thus, this document focuses on a “passing off” theory of infringement.**

A trademark infringement cause of action for passing off, *requires*:

- (1) there is a valid trademark
- (2) that trademark is owned by the plaintiff
- (3) that mark or a similar symbol was used by the defendant in commerce in connection with the sale, offering for sale, distribution or advertising of goods or services
- (4) resulting in a likelihood of confusion

Subsequently, this document suggests a structure for unpacking and analyzing those elements. For other questions, you can apply portions of that analysis as appropriate (including, for instance, *Who owns a given mark? Can a given mark’s registration be cancelled?*).

# Trademark infringement by passing off

## *Prima facie case:*

For a regular passing-off action for trademark infringement

- whether under state common law (applicable to unregistered marks), under Lanham Act §43(a) (applicable to unregistered marks), or under Lanham Act §32 (infringement action applicable only to registered marks)
- and whether for a word mark, a logo, product packaging, product configuration, or other symbol

the plaintiff must prove four things:

- (1) there is a valid trademark,
- (2) that trademark is owned by the plaintiff,
- (3) that mark or a similar symbol was used by the defendant in commerce in connection with the sale, offering for sale, distribution or advertising of goods or services, and
- (4) resulting in a likelihood of confusion

### **Element (1)** is: There is **a valid trademark**.

To be a valid trademark, a mark must be capable of, be used as, serve as, and be allowed to serve as an identifier of commercial source. But for the time being, let's pull "and be allowed to serve as" out of that sentence. That's an analytically squirrely clause. The fact is, the law excludes some things from trademarkability on policy grounds (big examples are government symbols and names and likenesses of living individuals without their consent). Having removed that bit, we are left with something that is conceptually compact and analytically pure:

**To be a valid trademark, a mark must be capable of, be used as, and serve as an identifier of commercial source.**

All or nearly all of the various court-articulated concepts concerning trademark validity are really just extensions of that single idea. For instance: genericness, distinctiveness, functionality, secondary meaning – all of those concepts are deduced from the maxim of source identification.

What this means for you is that you should free yourself from thinking of, for instance, genericness, distinctiveness, and functionality as wholly separate questions. There's a great deal of conceptual overlap among these doctrines. For instance, what is said in one case that is putatively about distinctiveness might be useful in applying to a dispute that is understood to be about functionality.

While doctrines of trademark validity have a tendency to overlap and blend together, articulating them separately can be very useful as a checklist for your analysis. Thus:

**Analyze:**

[N.B.: The word “mark” includes not only word marks and logos, but whatever is sought to be protected through trademark law – including trade dress (product packaging, product configuration), etc.]

**Distinctiveness: Is the mark capable of identifying and distinguishing goods or services from those manufactured or sold by others and to indicate the source of the goods or services (even if that source is unknown)?**

This can be a complex question. See the Table of Distinctiveness for a representation of the broader picture.

Consider:

### Is the mark inherently distinctive?

To determine this, look over the green questions below. Then, answer . . .

→ *if NO*, then go down to the next blue question (acquired distinctiveness).

→ *if YES*, then go down to the next purple question (genericness):

- As a general, conceptual matter, an “inherently distinctive” mark is one whose intrinsic nature serves to identify a particular source of a product or service.

### Is the mark a word mark that is arguably fanciful, arbitrary, or suggestive?

Word marks that are characterized as **fanciful**, **arbitrary**, or **suggestive** are inherently distinctive.

- The category of “fanciful” is described, *inter alia*, in Surveyor chapter M-4: “a fanciful term is a neologism invented for the sole purpose of serving as a trademark and has no preexisting meaning.” Two examples given were “Kodak” and “Fanta.”
- The category of “arbitrary” embraces terms that have nothing to do the product or service to which they are applied as a mark. An example give was “Apple” for a brand of computers since apples have nothing to do with computers
- The category of “suggestive” embraces marks that suggest, but do not clearly describe, the nature of the product or service. An example given was “Coppertone” for sunscreen, since the word suggests something about suntanning but does not clearly describe sunscreen.

## Is the mark not inherently distinctive but in a category where distinctiveness can be acquired?

To determine this, consider . . .

## Is the mark a word mark that is arguably merely descriptive?

Word marks that are **merely descriptive** are not inherently distinctive, but they can acquire distinctiveness through secondary meaning.

- For the dividing line between suggestive and merely descriptive, see *Zatarains v. Oak Grove Smokehouse*, which discussed and employed four standards:
  - Dictionary definitions
  - The imagination test
  - Needed by or useful for competitors
  - Actual use by others for similar goods or services

## Is the mark a color?

Where color alone is claimed as a mark, Qualitex holds that it is not inherently distinctive it can acquire distinctiveness through secondary meaning.

In addition to analyzing whether the color may have secondary meaning, consider also functionality. If a color is functional, it's unprotectable whether it has secondary meaning or not.

## Has the mark acquired distinctiveness through secondary meaning?

## Can it be argued that the mark is generic?

If a mark is generic, it is not protectable as a trademark. What matters is the primary significance of the claimed mark – whether its primary significance is as a kind of product as opposed to a source-identifying mark.

Keep in mind that it's not necessary that the public uses the term in a generic sense. What matters is that they would understand the term to be generic.

To understand what arguments are likely to be persuasive one way or the other, reason from the cases: Filipino Yellow Pages, USPTO v. Booking.com, and Elliott v. Google.

## Can it be argued that the mark is functional?

If a mark is functional, it is not protectable as a trademark. This is doctrinally messy terrain. The more you can reason from the cases and find support for potential outcomes in the cases, the better your analysis is likely to be.

Consider:

### Does the mark fit within any of the courts' various articulated concepts of functionality?

As we discussed in class, it is not clear how to articulate a single blackletter rule for this. (See the slides on functionality for some of our explorations in this regard.) Thus, it can't be said with certainty what things are *required* for functionality, but it's clear at least that the following questions are highly relevant.

#### Is there competitive need for others to use the mark?

Competitive need implies functionality.

#### Does the mark affect the cost of the article?

Lowering the cost implies functionality.

#### Does the mark affect the quality of the article?

An effect on quality implies functionality.

#### Does the mark put competitors at a significant non-reputation-related disadvantage?

Putting competitors at such a disadvantage implies functionality. This way of looking at functionality seems to be particularly important in cases involving issues of aesthetic functionality. But it's not limited to that context.

### Does the mark seem close on the facts to any functionality cases?

The closer any given case comes to precedent on the facts, the more likely it is a court will decide the issue in line with that precedent.

So you might consider:

#### Is the mark like . . .

- the pillow form of shredded wheat in *Kellogg v. Nabisco*?
- the sign in *TrafFix*?
- the grease pump in *Groeneveld v. Lubecore*?
- the beach towel in *Jay Franco v. Franek*?

→ IF YES, that could suggest functionality and a defendant win.

### Is the mark like . . .

- the restaurant trade dress in *Two Pesos v. Taco Cabana*?
  - the wine store trade dress in *Best Cellars v. Wine Made Simple*?
  - the red-soled shoes in *Christian Louboutin v. Yves Saint Laurent*
  - the accessories in *Au-To Gold v. Volkswagen*?
- IF YES, that could suggest non-functionality and a plaintiff win.

### Does the reasoning of any of the cases support finding functionality? Or finding non-functionality?

The cases we read were filled with a variety of views, rationales, policy prescriptions, admonitions, convictions, and proffered wisdom about the purpose of trademark law, its powers, its limits, its promises, its perils, and so on. Much of this is applicable to forming persuasive arguments.

Consider:

#### Did a court explicitly tell us something relevant about the law?

If so, this could be **persuasive to future courts**. And as far as this goes, it is likely to be most persuasive if it is from the U.S. Supreme Court, with lessening value as you move down to circuit courts and then district courts.

When considering cases in this vein, **don't forget to include Qualitex and Wal-Mart v. Samara**. These cases didn't involve functionality as such, but they loom very large as authoritative expositions on modern trademark law. So what they say is can be quite relevant to figuring out what functionality means in any given case.

#### Did a court reveal how it reasons and what it finds persuasive?

If so, this could be **predictive of future decisions**. And as far as that goes, the predictive value of lower court decisions is arguably as great or even greater than U.S. Supreme Court cases. Reasoning in this vein, you're not necessarily limited to the letter of the doctrine. You might draw from the cases some grounded speculation about the effect of industry expectations, longstanding practice, apparent equities, economic realities, and so forth.

## Use in commerce: Has the mark been the subject of bona fide use in commerce?

This doesn't often come up as an issue by itself. But it remains a rock-solid requirement that a mark must be used in commerce before it can be successfully upheld as a valid trademark.

The relevant doctrine regarding what constitutes use for trademark validity tends to come up in two contexts that are treated elsewhere in this document:

- First is a dispute between two rival claimants to the same mark. See the treatment below under the second infringement element – (2) *that trademark is owned by the plaintiff*.
- Second is *abandonment*. This is noted below under defenses.

Thus, if it's an issue in the prima facie case, consider the teachings of the law and cases under those headings.

Keep in mind that an intent-to-use application can reserve a date for the sake of priority, but the trademark right doesn't vest until bona fide use in commerce.

## Functions as a trademark: Does the claimed mark actually function as a trademark?

Grynberg's book discussed this over pages 265–266 (in Chapter 12, *Registration*). As Grynberg notes, the failure-to-function doctrine has been used frequently by the USPTO to reject registrations for popular or culturally ascendant phrases (“I can't breathe”) on t-shirts and so forth.

The doctrine also appeared in Grynberg's book over pages 65–66 (in Chapter 4, *Non-Word Marks, Colors, and Trade Dress*), in the excerpt from the Trademark Manual of Examining Procedure, §1202.03(a) Commercial Impression, which notes, e.g., “The significance of the proposed mark is a factor to consider when determining whether ornamental matter serves a trademark function. Common expressions and symbols (e.g., the peace symbol, ‘smiley face,’ or the phrase ‘Have a Nice Day’) are normally not perceived as marks.”

This the failure-to-function doctrine *as such* hasn't been fleshed out much by the courts. And we didn't read a case that focused in on it by that name. But the concept is woven through out many cases. One example is *Qualitex*, where the court goes to some effort to explain that color can be a trademark precisely because it functions as a source identifier (in other words, does *not* fail to function.)

**Note that “functions as a trademark” (the negation of which is “failure to function”) is a distinct concept from “functionality” (the negation of which is that mark is “nonfunctional”), which is a doctrine saliently represented by *TrafFix*.** A mark must function as a trademark to be valid as a trademark. And a mark must be nonfunctional in a utilitarian/*TrafFix* sense to be valid as a trademark.



**Element (2)** is: That trademark is **owned by the plaintiff**.

The plaintiff must be the owner of the trademark to be able to sue a defendant for infringement. In essence, being the owner of a trademark means being the source of the goods to which that trademark is affixed.

Consider:

**Is there a dispute as to priority – i.e., more than one party claims to own a particular mark for a particular market?**

If so, consider the law and notes presented with and the teachings of *Burger King v. Hoots*, *FN Herstal v. Clyde Armory* (SCAR guns case).

**Is there a dispute as to geographical extent of the trademark right?**

Again, *Burger King v. Hoots* is relevant.

**Is there a dispute as to whom among former collaborators is the owner?**

If so, apply the teachings of *Bell v. Streetwise Records*.

**Is there a question of tacking – where a newly modified mark is claimed as having the priority of the older version of the mark?**

If so, apply the teachings of *Hana v. Hana* and associated notes. Tacking is a jury issue as to whether the new mark carries the same commercial impression for an ordinary consumer as the prior mark and hasn't materially altered the character of the prior mark.

**Element (3)** is: That the mark or a similar symbol was **used by the defendant** in commerce in connection with the sale, offering for sale, distribution or advertising of goods or services.

Consider:

**Is the defendant's use of the mark or a similar mark something *other* than a straight-up affixing of the mark as a source indicator for its goods?**

→ **if NO**, if it's just the defendant using the mark as a mark for the defendant's goods or services, then this requirement will be very easy for the plaintiff to prove.

→ **if YES**, if it's something that doesn't quite fit the use-of-mark-as-a-mark mold, then this requirement may be a significant contested issue in an infringement. Apply relevant cases. Examples of such non-straight-up defendant uses – and possible relevant cases to apply – would be:

- a search engine selling advertising based on a user's input of the plaintiff's mark (*Rescuecom v. Google*)

- including the plaintiff's mark in a headline of an article hostile to the plaintiff (*Radiance Foundation v. NAACP*)
- a record company including the plaintiff's word mark within the title of a song (*Mattel v. MCA Records*; but note dilution context)

**Element (4)** is: That the use results in a **likelihood of confusion**.

Apply the factors. I suggest working from the synthesized list I gave you in the slides, which is a slightly re-worded version of the Second Circuit's *Polaroid* factors as related in the *Virgin v. Nawab* case we read. Here's that list:

- the strength of plaintiff's mark
- similarity between plaintiff's and defendant's marks
- the proximity of the products in the marketplace
- the likelihood that the senior user will bridge the gap by beginning to sell in the market of the defendant's product
- evidence of actual confusion
- the sophistication of consumers in the relevant market
- defendant's good faith, or lack thereof, or bad faith, in adopting its own mark
- the quality of the defendant's product

In terms of how these factors can be applied, take your cues from the cases we read. The more genuine potential you perceive in using these factors to fashion arguments that could be persuasive to a court – your perception having been developed from the cases we've read and your own reflections about them – the better your analysis will be.

Please keep in mind that in an area as indeterminate and "fuzzy" as this often is, it very well may be that the best lawyerly analysis arrives at no definite conclusion on whether the plaintiff will succeed in showing likelihood of confusion.

*Other non-normal sorts of confusion:*

*Reverse confusion*

*Post-purchase*

*Initial interest confusion*

# Trademark infringement by passing off

## *Defenses:*

Consider:

- License
- Naked license / Abandonment
- First sale
- Classic fair use
- Nominative fair use