



Distinctiveness

Trademark & Unfair Competition
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Konomark
Most rights sharable

source

source

source

source

distinctiveness

distinctiveness

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

- ## The need for distinctiveness
- Whether to be registered on the principal 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))

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can acquire distinctiveness	merely descriptive
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And to make it easy, for now, we'll just work with these categories.

How would you
classify this mark?

Kodak

Kodak

fanciful

**Apple
(for computers)**

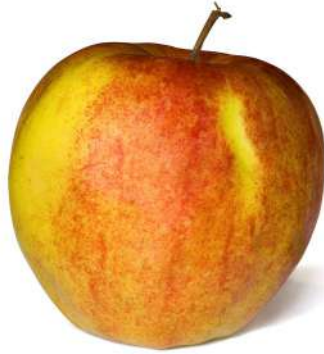


**Apple
(for computers)**

**(likely)
arbitrary**



**Apple
(for an apple)**



**Apple
(for an apple)**



generic

Apple
(for an apple)



generic

How should this come out under the ...

- **imagination test?**
- **useful-to-use/need-to-use test?**
- **actual-use-by-others-in-the-market test?**

TM



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The need for distinctiveness

Re-run

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can acquire distinctiveness	merely descriptive
unprotectable	generic







How should this come out under the actual-use-by-others-in-the-market test?

generic

inherently distinctive	fanciful arbitrary suggestive	
can acquire distinctiveness	merely descriptive	
unprotectable	generic	

COPPERTONE®





held:
suggestive

How should this come out under the useful-to-use / need-to-use test?



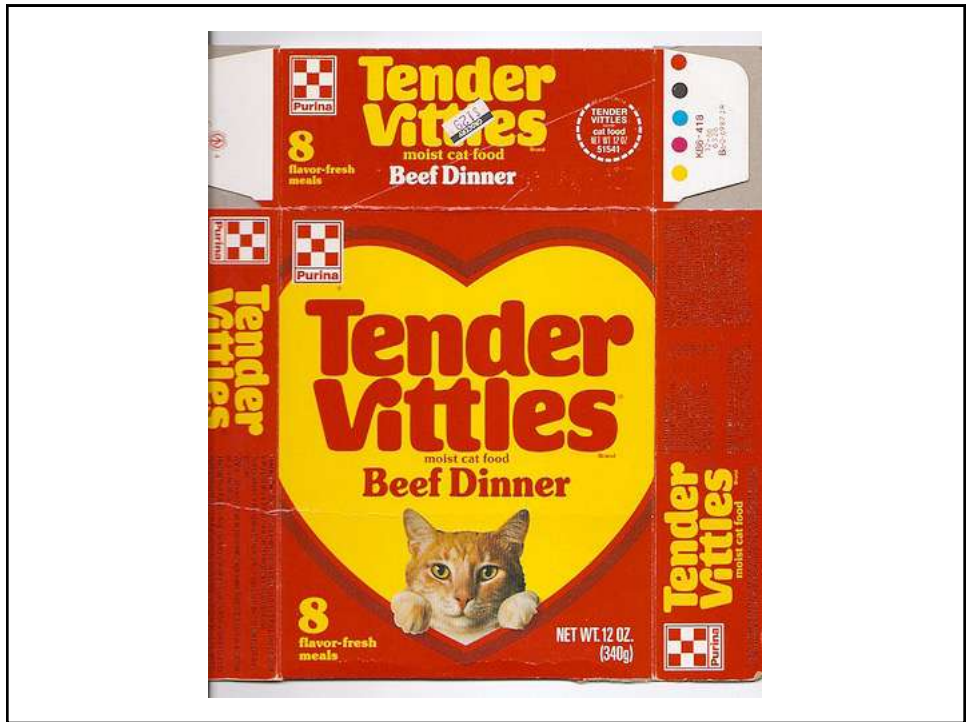
held:
suggestive

How should this come out under the actual-use-by-others-in-the-market test?





inherently distinctive	fanciful arbitrary suggestive
can acquire distinctiveness	merely descriptive
unprotectable	generic





How should this come out under the . . .

- imagination test?
- useful-to-use/need-to-use test?
- actual-use-by-others-in-the-market test?





held:
merely
descriptive

How should this come out under the . . .

- imagination test?
- useful-to-use/need-to-use test?
- actual-use-by-others-in-the-market test?

travel
CHANNEL®





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