

# Trademarks

Law 115 | Week 5 | Lecture 10  
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# Agenda

1. The Spectrum of Distinctiveness
2. Examples of Generic, Descriptive, Suggestive, Arbitrary, and Fanciful Marks
3. Trademark Infringement Claims
4. Examples

# The Spectrum of Distinctiveness

Strength of protection and ability to register depend on the mark's distinctiveness. The spectrum of distinctiveness from weakest to strongest...



# The Spectrum of Distinctiveness

## Inherently Distinctive

- Arbitrary marks
- Fanciful marks
- Suggestive marks
- Some unique eye-catching designs

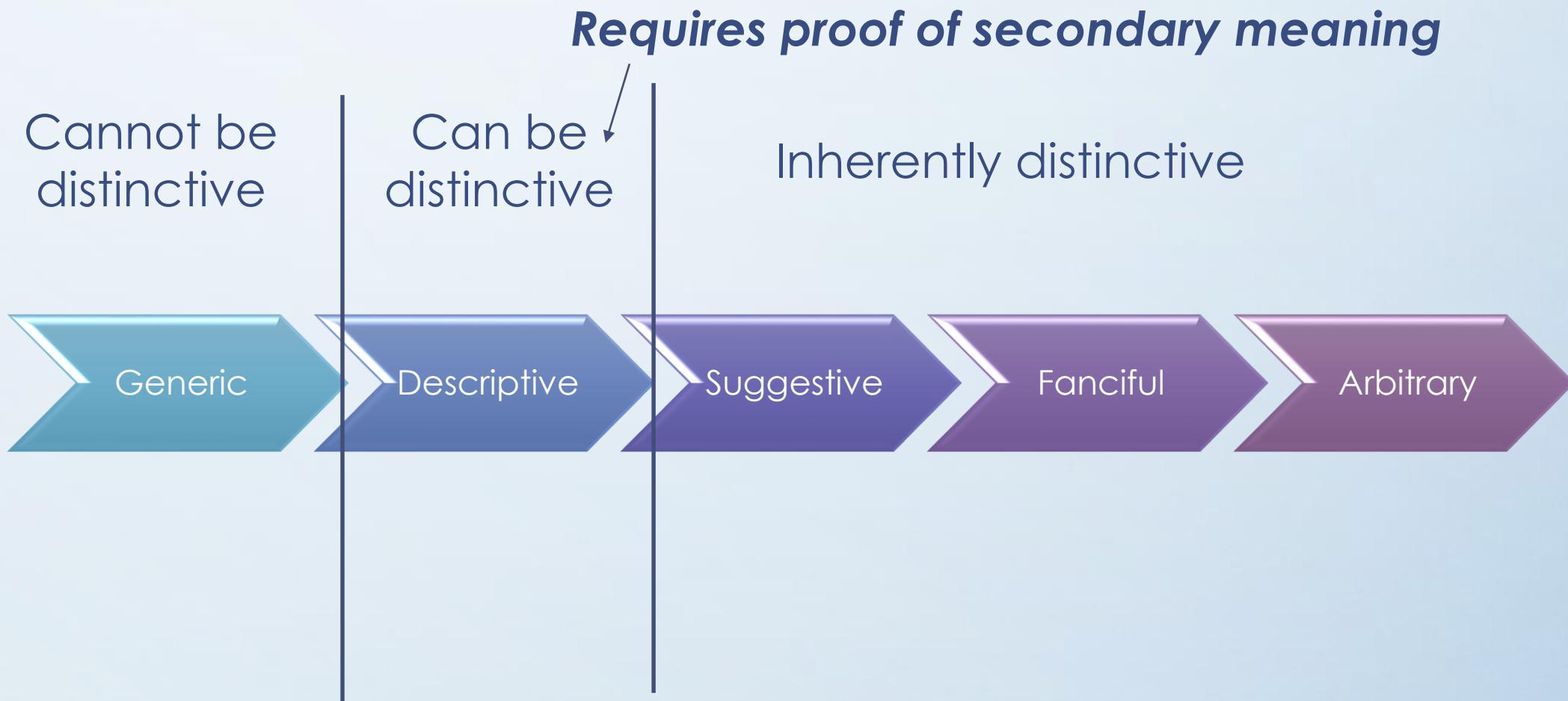
## Can Be Distinctive

- Descriptive marks
- Geographically descriptive marks
- Surname marks
- Common or simple abstract designs/colors

## Cannot Be Distinctive

- Generic words
- Generic symbols

# The Spectrum of Distinctiveness



# Generic Marks

Generic

**Generic:** Common name for a good/service, so cannot distinguish between different sources for that good/service.

- There must be some term for a product that may be used by anyone to identify the product itself, separate from its source.
- No registration permitted; no trademark protection.



# Descriptive Marks

Descriptive

**Descriptive:** A descriptive mark is a term with a specific meaning that is used in connection with products or services directly related to that meaning.

- An example might be “tasty” used in connection with snack cakes or other foods.
- Such terms are not registrable unless it can be shown that the mark has become distinctive through extensive use in the marketplace.



# Suggestive Marks

Suggestive

**Suggestive:** A suggestive mark points to/suggests the nature, quality, or a characteristic of a product, but does not describe the characteristic.

- Rather, it requires imagination on the part of the consumer to identify the characteristic. It provides clues about the product but doesn't specifically describe it.
- Suggestive marks may be registered immediately, without proof of distinctiveness.



# Fanciful Marks

Fanciful

**Fanciful:** A fanciful trademark employs an entirely invented or "fanciful" word as a mark.

- A fanciful mark had no meaning before it was adopted and used as a trademark in relation to goods.
- Fanciful marks are also immediately eligible for registration.



# Arbitrary Marks

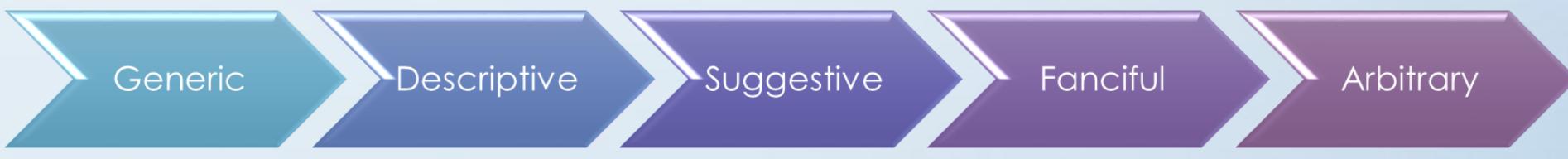
Arbitrary

**Arbitrary:** An arbitrary mark usually employs a common word or words that are used in a meaningless context.

- Have some standard dictionary definition, but are used in connection with products or services unrelated to that dictionary meaning.
- Arbitrary marks are also immediately eligible for registration (without showing proof of distinctiveness).



# Example



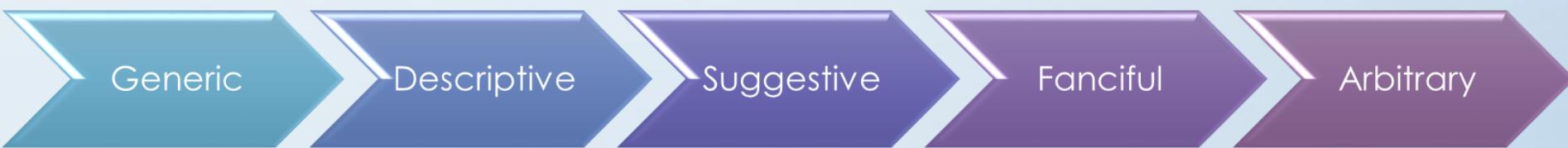
Weakest

Strongest

# Example



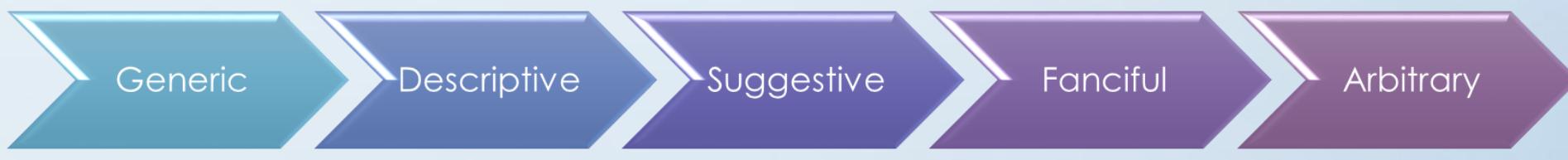
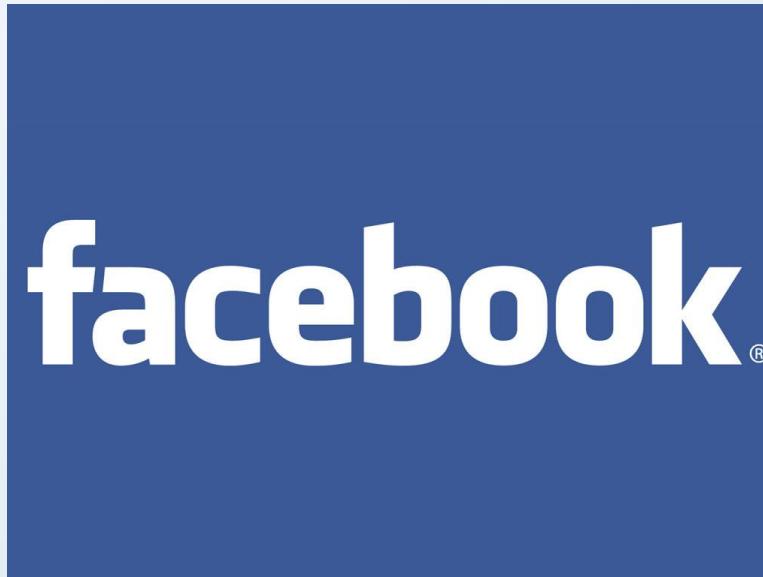
# Example



Weakest

Strongest

# Example



Weakest

Strongest

# Trademark Infringement Claims

1. Use in commerce
2. That causes a ***likelihood of confusion*** about origin, affiliation, association, or sponsorship

## Federal Law:

- §43(a) = federal common law for unregistered marks ("uses in commerce")
- §32(1) = standard infringement action for registered marks

Common Law: The first to use a trademark in a particular geographic area gets exclusive rights to it for the good or service provided in that geographic area only

# Trademark Infringement Claims

When courts evaluate likelihood of confusion, they look at several factors...

1. Strength of the mark
2. Degree of similarity of the marks
3. Whether the similar trademarks operate in the same market
4. Actual confusion
5. Quality of the products
6. Sophistication of the relevant consumer

# Trademark Infringement Claims

## Factor 1: Strength of the mark

Where on the distinctiveness spectrum does the mark fall?



Strength also refers to the commercial strength of the mark, based on market share, recognition among customers, and duration of use.

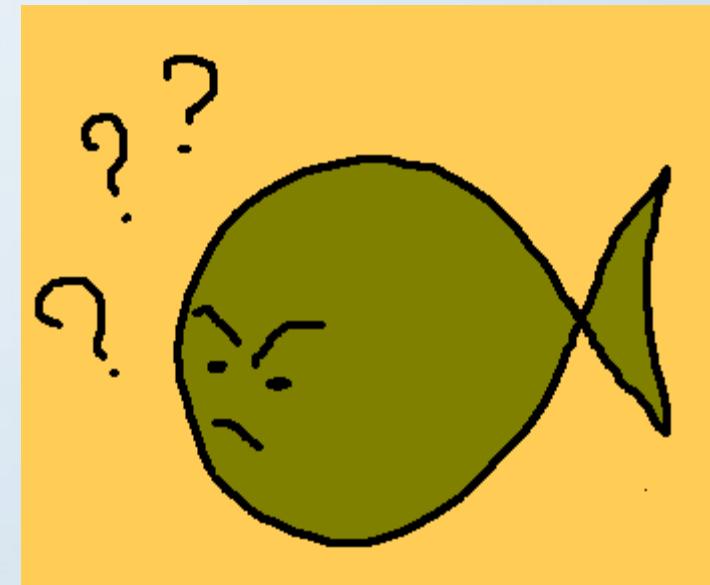
# Trademark Infringement Claims

## **Factor 2:** Degree of similarity of the marks

This factor looks to the “sight, sound and meaning” of the two marks.

For example, if the mark is “Fish”, then similar marks could be...

- “Fisch” (similar in sight)
- “Phish” (similar in sound)
- Picture of a fish (similar in meaning)



# Trademark Infringement Claims



**Factor 3:** Whether the similar trademarks operate in the same market

- The more similar or related the goods or services, the more likely the confusion
- The products do not need to be directly in competition

# Trademark Infringement Claims

## Factor 4: Actual confusion

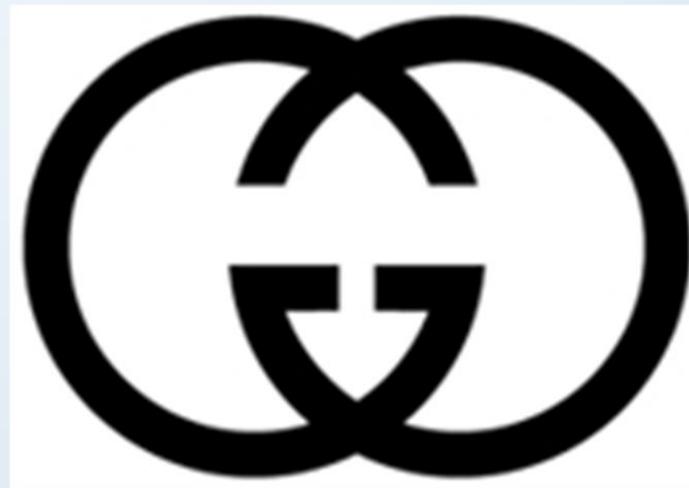
- Examines whether there is confusion in the “relevant purchasing community” not the public generally
- This includes misdirected emails, calls, or mail, and/or polls conducted for the purpose of the dispute



# Trademark Infringement Claims

## Factor 5: Quality of the products

- If the quality is similar, confusion is more likely
- If quality is disparate, confusion is less likely



# Trademark Infringement Claims



**Factor 6:** Sophistication of the relevant consumer

- Looks to how the typical buyer of the product is likely to behave
- Impulse buyers vs. buyers of a big-ticket item or a product used in a narrow field

# Example

Original Mark



Alleged Infringement



# Example

Original Mark



Alleged Infringement

