

# TRADEMARK CATEGORIES

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Young & Thompson  
*International Patent & Trademark Law*  
*Founded 1903*

# The Lanham Act – 15 U.S.C.

[http://www.uspto.gov/sites/default/files/trademarks/law/Trademark\\_Statutes.pdf](http://www.uspto.gov/sites/default/files/trademarks/law/Trademark_Statutes.pdf)

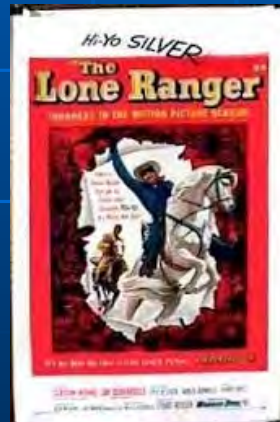
# What is a Trademark

- A trademark is an indication of the origin or source of the goods or services.
  - Words
  - Symbol
  - Color
  - Sound
  - Combination

# Trademark Examples



# Sounds Can Be Trademarked



See <http://www.uspto.gov/trademark/soundmarks/trademark-sound-mark-examples>

# Can't be a Trademark

15 U.S.C. § 1052

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of title 19) enters into force with respect to the United States.



# Can't be a Trademark

15 U.S.C. § 1052

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.





# Can't be a Trademark

15 U.S.C. § 1052

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: Provided, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to . . .



# Secondary Meaning

15 U.S.C. § 1052(f)

Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become **distinctive of the applicant's goods** in commerce. The Director may accept as *prima facie* evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.

# Secondary Meaning

The purpose and significance of secondary meaning may be described as follows:

A term which is descriptive . . . may, through usage by one producer with reference to his product, acquire a special significance so that to the consuming public the word has come to mean that the product is produced by that particular manufacturer. 1 Nims, *Unfair Competition and Trademarks* at § 37 (1947). This is what is known as secondary meaning.

The crux of the secondary meaning doctrine is that the mark comes to identify not only the goods but the source of those goods. To establish secondary meaning, it must be shown that the primary significance of the term in the minds of the consuming public is not the product but the producer (citations omitted). This may be an anonymous producer, since consumers often buy goods without knowing the personal identity or actual name of the manufacturer.

*Ralston Purina Co. v. Thomas J. Lipton, Inc.*, 341 F. Supp. 129, 133, 173 USPQ 820, 823 (S.D.N.Y. 1972).

# Categories

- 1) Generic
- 2) Descriptive
- 3) Suggestive
- 4) Arbitrary or Fanciful



# Donuts

DONUTS



# Generic

- A genus of which the particular product is a species.
- Merely descriptive of an article or its qualities, ingredients or characteristics.

Exceptions: - has acquired secondary meaning  
- use over time

# Descriptive

Lanham Act § 2

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.

# Suggestive

Neither exactly descriptive on one hand nor truly fanciful on the other.

If a term is suggestive, it is entitled to registration without proof of secondary meaning.



# Fanciful or Arbitrary

Fanciful or arbitrary terms enjoy all the rights accorded to suggestive terms as marks – without the need of debating whether the term is 'merely descriptive' and with ease of establishing infringement.

See *Abercrombie & Fitch v. Hunting World, Inc.* 537 F.2d 4 (2d Cir. 1976)



# QUIK-PRINT

Appeal to C.C.P.A. of Examiner's refusal to grant a trademark to "QUIK-PRINT"

Appellant argued that "Quick" and "Print" used individually are well known mundane names useful to the trade, the term "QUIK-PRINT" is a fanciful and distinctive term not ordinarily usable in the trade to describe any quality, characteristic or ingredient of the service.

Court noted that "QUICK-PRINT" = "QUIK-PRINT", and the appellant also used the term "Same Day Service" in advertising.

Appellant argued that "mental gymnastics" used by the Examiner and Court proved that mark is suggestive.

# Quick Print

Court found that the mark was merely descriptive.  
Court found “nothing in this record to establish that applicant has achieved a recognition or secondary meaning in the mark “QUIK-PRINT”

In re Quik-Print Copy Shops, 616 F.2d 523  
(C.C.P.A. 1980)



# Beanie Babies



Ty Inc. V Ruth  
Perryman (2001  
WL 826893 (N.D.  
III.)

Motion for  
Summary  
Judgment

# Beanie Babies

- Ty sells collectable toys under the names of BEANIE BABIES, THE BEANIE BABYS COLLECTION, BEANIE BUDDIES COLLECTION, BEANIE BUDDIES etc.

- Ruth Perryman established Bargain Beanies business to serve the second hand market. Sells only "retired" Bargain Beanies.

- Ty sued for trademark infringement.

- Ty had not registered the mark "Beanies"

Lanham Act protects a mark against infringement by "colorable imitations" which "likely to cause confusion, or to cause mistake or to deceive" consumers as to the source of the goods.

# Beanies

- “Beanies” is an important component of the mark.
- “Bargain” is a significant part of the mark.
- Disclaimer of not being affiliated with Ty on Perryman’s web site reduced likelihood of confusion.
- Ty has created a unique product
- “Taking all of these factors together, we believe that reasonable minds can differ as to whether the marks are sufficiently similar to create a likelihood of confusion . . . but there remains a genuine question of fact as to whether the similarity in the products creates a likelihood of confusion.”

# “Beanies” Generic?

Perryman claimed “Beanies” generic citing bean bags and bean bag chairs.

Ty claimed fanciful using dictionary definitions of beanies worn by collegians.

Court found that Ty had a strong mark and found “beanie” to be descriptive rather than suggestive, arbitrary and fanciful.

Court found defendant’s evidence of genericness “to be sparse at best”



# Secondary Meaning

- Articles referring to Beanie Babies as “Beanies”
- Tags and Boxes
- Neither party offered consumer testimony
- Consumer survey submitted by Ty, but was recent and not representative of consumer understanding at the time.

Based on strength of the mark, the Court found summary judgment of dilution by the defendants use of the word “Beanies”.

# AFTERMATH



Kyriakos Tsiolis v. Interscope Records,  
Aftermath Entertainment, and Andre  
Young (aka Dr. Dre) 946 F.Supp (N.D.  
Ill. 1996)

Motion for preliminary injunction

# AFTERMATH

- Tsiolis organized heavy metal band
- Illinois mark for "Aftermath"
- Service mark "Aftermath" registered at USPTO
- distributed about 2,500 copies of "Words That Echo Fear" album
- sold 162 copies of "Eyes of Tomorrow" album
- 33 live performances
- About \$5,000 per year

# AFTERMATH

- Dr. Dre dissociates from Death Row Records
- Chose "Aftermath" to symbolize split from Death Row
- Split and new label reported in Vibe and LA Times
- Promotional plan, ad in Billboard, posters
- Spent about \$200,000 on production, distribution and marketing

# AFTERMATH

Dictionary: "the period immediately following a usually ruinous event"



Stones album was  
before Tsiolis held  
the mark

# AFTERMATH

- Tsiolis' expert Prof. Weinstein opined lines separating genres of music are ever changing and there was considerable "melding together" of rock and rap.
- Dr. Dre's Expert Fred Bronson opined heavy metal is for teenage white working class males and rap is for young urban black males, and that the two genres of music are played on different radio stations.
- Gary Arnold of Best Buy testified that there are separate "rock" and "rap sections."

# AFTERMATH

- Registration of "Aftermath" is prima facie valid.
- Court noted the 5 categories of distinctiveness: generic, descriptive, suggestive, arbitrary and fanciful.
- A generic term, though registered with the USPTO, receives no protection under federal and state trademark law, citing Door Sys. V. Pro-line Door Sys., 83 F.3d 169, 171 (7<sup>th</sup> Cir. 1996).
- Neither party argued that "Aftermath" was generic.
- "aftermath" was in lower case in dictionary.
- Even if descriptive, there is no "secondary meaning" in the "music world".



# AFTERMATH

- No evidence of likelihood of confusion.

- Factors: 1) similarity of the services, 2) area and manner of concurrent use, 3) strength of the mark, 4) degree of similarity of marks in appearance and suggestion, 5) degree of care likely to be exercised by the consumers, 6) intent by the alleged infringer to “palm off” its services as that as another, and 7) evidence of actual confusion.

- Held: no evidence of actual confusion, appearance and suggestion of the two marks are dissimilar, no intent to “palm off”, “Aftermath” is weak, consumers likely to use a high degree of care, no likelihood of confusion demonstrated.

# AFTERMATH

- Court ordered injunction would cost the defendant about \$400,000.
- Injunction denied.
- "Likelihood of confusion is frequently a disputed issue upon which reasonable minds can differ. . . Tsiolis will have his day in court."



# Patents.com

In re Oppedahl & Larsen, LLP, 373 F.3d 1171 (Fed Cir. 2004)



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Judge Rader

# Patents.com

Trademark Trial and Appeal Board aff'd USPTO's refusal to register patents.com as being merely descriptive under the Lanham Act.

TMEP 1209.03(m):

"Because TLD's generally serve no source indicating function, their addition to an otherwise unregistrable mark typically cannot render it registrable."

# Current TMEP 1209.03

Because TLDs generally serve no source-indicating function, their addition to an otherwise unregistrable mark typically cannot render it registrable. In re 1800Mattress.com IP LLC, 586 F.3d 1359, 92 USPQ2d 1682 (Fed. Cir. 2009) (MATTRESS.COM generic for “online retail store services in the field of mattresses, beds, and bedding,” and applicant “presented no evidence that “.com” evoked anything but a commercial internet domain”); In re Hotels.com, L.P., 573 F.3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009) (HOTELS.COM generic for “providing information for others about temporary lodging; [and] travel agency services, namely, making reservations and bookings for temporary lodging for others by means of telephone and the global computer network”); In re Reed Elsevier Properties Inc., 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007) (LAWYERS.COM generic for “providing an online interactive database featuring information exchange in the fields of law, legal news and legal services”); In re Oppedahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004) (PATENTS.COM merely descriptive of computer software for managing a database of records and for tracking the status of the records by means of the Internet)

# TMEP 1209.3 Descriptiveness

- Third party registrations
- First or only user
- More than one meaning
- Foreign equivalents
- Intended users
- Laudatory terms
- Domain names
- No dictionary listing
- Combined terms
- Picture or illustration
- Acronyms
- Phonetic equivalent
- Telephone numbers

# American

If “AMERICA” or “AMERICAN” appears in a phrase or slogan, the examining attorney must evaluate the entire mark to determine whether it is merely descriptive as laudatory or even incapable. In *re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness); In *re Carvel Corp.*, 223 USPQ 65 (TTAB 1984) (AMERICA’S FRESHEST ICE CREAM held incapable for ice cream); In *re Wileswood, Inc.*, 201 USPQ 400 (TTAB 1978) (AMERICA’S BEST POPCORN! and AMERICA’S FAVORITE POPCORN! merely descriptive of unpopped popcorn). Typically, these marks primarily extol the quality or popularity of the goods or services and secondarily denote geographic origin. The examining attorney must look at each mark to determine whether it is capable, considering all relevant circumstances and case law.

TMEP 1209.03(n)



# Other TMEP Merely Descriptive

- "National"                      - "International"                      - "Global"                      - "Worldwide"
- Function or purpose                      - Source or provider of goods and services
- Retail store or distributor services                      - Slogans
- Repetition of descriptive or generic term                      - Punctuation

Examples: "Best Beer in America", "National Rent a Fence", "Screenwipe"

"La Lingerie", "Tires Tires Tires", "Ceasar! Ceaser!", "888 Patents"  
(phone number), "Hotels.com"

# Categorization Matrix

Inherently Distinctive		Non-inherently distinctive	No Distinctiveness
No secondary meaning required		Secondary meaning required	No TM distinctiveness
Arbitrary & Fanciful	Suggestive	Descriptive Geographic Personal Name	Generic

# Y&T Trademark Team

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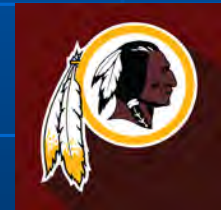
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P.J. Patch

Jennifer Coles

# Future Talks

- Classification, Search and Application – TESS and TEAS
- IP Options- Designs, Trademarks and Trade Dress
- Trademark Prosecution and Opposition
- Fighting Trademark Dilution
- Immoral/Scandalous/Disparaging Marks
- Copyrights



# Thank You

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