

## TRADEMARK LAW

### I. (60 min.)

#### “Miss Mizzou” in *Steve Canyon* comic strip

##### MU v. Caniff:

- MU has a registered mark.
- but for decades before registration, MU used the “Mizzou” term as a source identifier.
  - “Mizzou” is a corruption of “Missouri University”.
  - as such, it is a suggestive term, which is distinctive.
    - also, “Mizzou” undoubtedly has secondary meaning by the association in the minds of the public between the term and MU.
  - it has been used in commerce for years in promotional materials and the football cheer.
- by being used in commerce, it is a common law mark.
- [by being distinctive, it was entitled to registration in 2004.]
- Caniff started drawing “Steve Canyon” 4 years before MU’s TM registration, has continued to do so after 2004.
  - thus, in its suit, MU can rely on both its common law mark and registered TM.
- Caniff is using the word “Mizzou” without consent.
- but is he using the term to refer to the MU or its goods and services? Is there any reference implied with MU, other than the word itself?
  - No!
- is there anything about Caniff’s comic strip to suggest that it is sponsored or endorsed by MU?
  - No!
- there is no trademark usage at all in Caniff’s use of the word “Mizzou”.
  - it is instead “artistic expression”, a form of fair use.
- *result*: MU has n cause of action.

bonus: false designation of origin - §43(a) – *see D.C. Comics* [“Daily Planet”]

##### Monroe v. Caniff:

- Caniff intentionally drew his character “Miss Mizzou” to resemble Marilyn Monroe.
- *right of publicity*: under the right of publicity, a celebrity is entitled to protection against appropriation of his/her name, signature, or likeness without consent for commercial purposes.
  - Monroe is an iconic “celebrity”.
- here, Monroe’s facial features and figure – her “likeness” – were used by Caniff without her consent.
- it is arguable that Caniff drew “Miss Mizzou” to resemble Marilyn Monroe to enhance the marketability of his comic strip “Steve Canyon”.
- this would be an appropriation of her “likeness” for commercial purposes. [Allen]
  - but, there is no unapproved testimonial here or implied sponsorship/endorsement.
- while there is a resemblance in appearance, there is no likelihood of consumer confusion about whether Monroe herself is being depicted as a character in the comic strip.
  - this means there is no § 43(a) false representation or false advertising involved.
  - also, there is no “commercial speech” here, because Caniff is not trying to sell a specific product or service with the “Miss Mizzou” image/character.

- § 43( c) “famous name” dilution: dilution of “famous names” by blurring or tarnishment is barred.
  - “famous” mark is one “widely recognized by the general consuming public of the U.S. as a designation of source of goods or services of mark’s owner”.
    - Monroe’s name and persona are iconic, that is, extremely famous.
  - there must be a sufficient similarity between the junior and senior marks to evoke an “instinctive mental association” of the two by a relevant universe of consumers .
    - “blurring” is similarity between a mark and a famous mark which impairs the distinctiveness of the famous mark.
    - “tarnishment” is similarity between a mark and a famous mark which harms the reputation of the famous mark.
- here, Monroe’s persona and image are not blurred by Caniff’s use of an artistic adaptation of her image, since no one’s memory of her persona and image are rendered less distinct by Caniff’s drawings.
  - and it is not tarnished, since the artistic reference is complimentary.
- fair use: there are some fair uses which could immunize Caniff from liability.
  - descriptive use, nominative use, comparison ads, social/cultural commentary (inc. parody).
    - none of those fit.
- works of “artistic expression” can be made.
  - they are protected by the 1<sup>st</sup> Amendment: the public interest in freedom of artistic expression should be favored against the commercial interests of a celebrity unless the likelihood of consumer confusion or dilution is great. [*Rogers; ETW*]
  - there should be some transformative alteration of the original appearance. [*Comedy III; ETW*]
  - it is “artistic expression” if it (1) has minimal artistic relevance to content, and (2) does not explicitly mislead consumers about celebrity’s involvement. [*Rogers; ETW*]
    - the beauty and appearance of the “Miss Mizzou” is relevant to her character.
    - there is no explicit misleading about Monroe’s involvement in the comic strip.
  - but, can “art” retain its immunity when it is sold commercially? (As here.)  
[see *Nussensweig*]

If Monroe posed for Caniff:

- posing for Caniff implies approval of his drawings and consent to publication of the his comic strip.
  - it does not matter whether Caniff paid Monroe a posing fee or not.
  - Monroe was in a position to disapprove of publication.
- thus, the “without consent” element of the right of publicity fails (unlike in *Allen, Midler* or *ETW*).
  - that same element in § 43( c) dilution also fails.

II. (30 min.)

yellow-soled shoes

- trademark infringement:
- defined as “use in commerce any reproduction, counterfeit, copy, or colorable imitation of a

- registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive”. § 32(1)(a)
- shapes and colors can be protected only after they acquire secondary meaning, because they are not inherently distinctive. [*Qualitex; Wal-Mart*]
  - lack of distinctiveness is a defense to infringement.
    - mark can be denied registration for lack of distinctiveness. § 2(e)(1).
    - proposed mark can be opposed for that reason. § 13(a).
  - but a registered mark is presumptively valid. § 7(b)
    - petition for cancellation can be filed for mere descriptiveness. § 14(1).
      - within 5 years of registration. (It is not yet incontestable. See §§ 8(b), 15)
  - single colors are not considered inherently distinctive. [*Qualitex*]
  - but, color combinations can be.
    - a yellow sole on a shoe could be considered a color combination, and, thus, potentially distinctive.
    - here, PTO considered Chevalier’s yellow-soled shoes unique.
    - are they distinctive because:
      - they are a distinctive color combination? or
      - are recognized by consumers as coming from a single source (*i.e.*, acquired secondary meaning)?
    - PTO must have concluded that yellow-soled shoes are inherently distinctive, because it concluded that they were unique (*i.e.*, no one else sold such shoes at the time of registration).
    - but, they could have acquired secondary meaning by the time Brown Shoe began marketing such shoes.
      - is it because women bought such shoes in large numbers that Brown Shoe began marketing such shoes in the face of Chevalier’s registration?
    - but, is a claim to a single color shoe sole too broad? (*See Qualitex; Two Pesos*)
      - there are only six primary colors. If those all were claimed by different shoe manufacturers, no one else could have colored shoe soles.
      - besides, there are many shades of “yellow”. It is too broad a claim for Chevalier to monopolize all shades of yellow when it is using only one. How is anyone else to determine whether its shade of yellow infringes or not?
    - *result*: Chevalier’s registration should not have been granted, because of lack of distinctiveness.
      - thus, the requested injunction should be denied and Chevalier’s registration should be cancelled.
  - *unfair competition*:
    - federalizes common law unfair competition, "passing off", and misappropriation concepts.
    - trade dress is protected by § 43(a) unfair competition provision.
      - it prohibits “any person who ... uses ... any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin ... which is likely to cause confusion or to cause mistake or to deceive as to the affiliation ... of such person with another person, or as to the origin, sponsorship, or approval of his ... goods ... by another person”.
    - same rules apply both to trademarks and to protected trade dress under § 43(a). [*Two Pesos*]
      - they must be inherently distinctive or have acquired secondary meaning.

- hence, secondary meaning is not required for suggestive or arbitrary forms of trade dress, because they are inherently distinctive.
- because trademark is invalid for lack of distinctiveness, an unfair competition claim will not lie.
  - copying nondistinctive trade dress does not violate § 43(a).

### III. (15 min.)

#### “Jello wrestling”

- *freedom of expression – linguistic usage in a non-trademark manner*
- *Jello* is a registered trademark.
- here, “Jello wrestling” is a reference to wrestling in a pit full of gelatin (any brand).
  - it is not a reference to a particular brand of gelatin or to a gelatin-based food product.
- freedom of expression and trademark protection must be balanced. [*Cliffs Notes; Mattel*]
- whenever the public imbues the mark with a meaning beyond its source-identifying function, the trademark owner does not have the right to control public discourse. [*New Kids; Walking Mountain*]
  - there can be no monopoly over the words of public communication.
- thus, there is no trademark infringement.
- *sovereign immunity*: – Act provision applying Lanham Act to states & political subdivisions is unconstitutional. [*Florida Prepaid*]

### IV. (15 min.)

#### Disney cartoon images on craft basket

- *trademark infringement*:
- literal copying of trademark and affixing it on goods of another is infringement if it is likely to cause consumers to believe the item is made, sold, sponsored, or endorsed by trademark owner.
  - defined as “use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive”. § 32(1)(a)
  - copying of trademarks is literal here – they were cut out of a Disney book.
- issue is whether consumers would believe the basket originated with Disney.
  - consumers universally associate Disney’s trademarked cartoon images with Disney, not with someone else.
  - purchaser of item with Disney images surely would think the item was made, sold, sponsored, or endorsed by Disney, because almost all collectibles with Disney images are made or licensed by Disney.
  - but, purchaser of basket at craft show certainly knew basket was made by Smythe, because Smythe sold it herself and put her “Made by Sharon Smythe” label on the basket.
  - however, purchaser probably assumed Smythe had the right to use the Disney images.
- *fair use*: Lanham Act does not provide for a fair use defense; it is a matter of case law.
  - fair uses include: descriptive use, nominative use, comparison ads, and criticism (including parody).
  - none of those apply here.
- *first sale doctrine*: allows purchaser of trademarked goods to use, resell, rent, and otherwise

dispose of those goods.

- here, Smythe purchased the Disney book; thus, she could cut off images from those books and paste them on plastic backings and affix those to baskets.
  - but only for herself. So, making a basket for herself is not trademark infringement.
  - while the doctrine would theoretically allow her to sell such a basket, she cannot do so in circumstances where consumers might believe the baskets were made, sold, sponsored or endorsed by Disney.
  - because doctrine does not allow purchaser to use the mark as a source-identifier.
- *result*: Smythe committed trademark infringement.

## V. (30 min.)

### “Granny” computer store

- *trade dress infringement*.
- trade dress is a combination of specific features embedded in a product that identifies its source to the consuming public. [*Hammerton*]
- trade dress is protected by § 43(a) unfair competition provision.
  - it prohibits “any person who ... uses ... any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin ... which is likely to cause confusion or to cause mistake or to deceive as to the affiliation ... of such person with another person, or as to the origin, sponsorship, or approval of his ... goods ... by another person”.
- same rules apply both to trademarks and to protected trade dress under § 43(a). [*Two Pesos*]
  - they must be inherently distinctive or have acquired secondary meaning. [*Two Pesos; Wal-Mart*]
    - hence, secondary meaning is not required for suggestive or arbitrary forms of trade dress, because they are inherently distinctive. [*Two Pesos*]
- all *Apple Stores* have a uniform decoration – that is trade dress.
  - it is distinctive, either inherently, or by secondary meaning, because of their ubiquitous presence in the marketplace.
- Richards is copying that trade dress.
  - facts so state.
  - it is counterfeit trade dress.
- that is a violation of § 43(a) unfair competition provision.
- *dilution by blurring and tarnishment*:
  - § 43( c) “*famous name*” *dilution*: dilution of “famous names” by blurring or tarnishment is barred.
  - “famous” mark is one “widely recognized by the general consuming public of the U.S. as a designation of source of goods or services of mark’s owner”.
    - here, *Apple* is an extremely famous name.
    - but here, Richards did not use *Apple*’s name, only its trade dress and a similar “apple” logo.
- there must be a sufficient similarity between the junior and senior marks to evoke an “instinctive mental association” of the two by a relevant universe of consumers .
  - “blurring” is similarity between a mark and a famous mark which impairs the

distinctiveness of the famous mark.

- “tarnishment” is similarity between a mark and a famous mark which harms the reputation of the famous mark.

- here, arguably there is *blurring* between *Apple’s* “apple” logo and Richard’s “green apple” logo that is very similar in appearance, except for color.

- here, there is *tarnishment* because Richard’s is selling an inferior quality and incompatible computer bearing a “green apple” logo which looks like an *Apple* computer bearing *Apple’s* “apple” logo.

- *Apple’s* reputation for computer quality and reliability would be impaired by consumers believing incorrectly that they were buying *Apple* computers.

## VI. (30 min.)

Briefly define the following terms:

- (1) supplemental register – register for mark *capable* of distinguishing a product or service, but has not yet acquired secondary meaning.
- (2) suggestive term – term requiring imagination, thought and perception to deduce nature or qualities of product or service.
- (3) geographically deceptively misdescriptive term – geographic term which could lead public to believe that the product or service originates from a geographic place when in fact it does not come from that place. Since 1993 under NAFTA, they cannot be registered.
- (4) secondary meaning – merely descriptive mark which consumers have come to associate with the origin of a particular good or service.
- (5) reverse confusion – arises when a larger more powerful junior user adopts the mark of a smaller less powerful senior user and thereby causes consumer confusion about the origin of the senior user’s products or services.
- (6) incontestability – after 5 years use, a trademark is deemed to have acquired secondary meaning and cannot be declared invalid for lack of distinctiveness or is a prohibited term
- (7) use in commerce – *bona fide* placing goods on the open market [Lanham Act § 45]
- (8) famous name – a term or name which is widely recognized by consumers as a designation of the source of products or services. (A prerequisite to federal protection from dilution under § 43(c).)
- (9) trade dress – nonfunctional combination of specific design features and/or color combinations which are distinctive and identify the source of products or services to

consumers.

- (10) concurrent use – use of same or similar marks on same or similar goods/services in separate geographic areas