Trademark and Unfair Competition Law

Slides 2: Use in Commerce as Prerequisite for Rights

LAWS 7341-001
Prof. Kristelia García
Class Outline

• Use in commerce requirement:
  – Bona fide use
  – Intent to use
Lanham Act Section 45:

The term “use in commerce” means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this chapter, a mark shall be deemed to be in use in commerce—

(1) On goods when—

(A) It is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and

(B) The goods are sold or transported in commerce, and

(2) On services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

The term “commerce” means all commerce which may lawfully be regulated by Congress.
Trademarks and Use

Compare to US Copyright, Patent Law:

- **Copyright:** it is possible to use copyright protection to ensure that there is no publication of a work during the term of copyright (non-use)

- **Patent:** it is possible to use patent protection to ensure that no one practices an invention during the patent term (non-use)

- **Trademark:** It is **NOT** possible to use trademark protection to ensure that no one uses the mark without more - the mark owner herself must use the mark to retain protection
Zazu Designs v. L’Oreal S.A.
Zazu Designs v. L’Oreal S.A.
White v. Paramount Pictures Corp.

“Romulans” from Paramount’s STAR TREK series

Mr. White’s 2001 Album