Class 3: Acquired Distinctiveness
CLASS OUTLINE

• Descriptive Marks
• Secondary Meaning
• Memes, “Informational Slogans,” and Failure to Function
For a mark to be deemed “distinctive”...

Applicant must show one of two things:

1. That mark is inherently distinctive (i.e., fanciful or arbitrary); or

2. That the mark has become distinctive through “secondary meaning.”
Descriptive Marks

(1) Describe an ingredient, quality, characteristic or feature of a product; and

(2) Meaning comes immediately to the mind of the consumer

→ Only protected after achieving “secondary meaning” (Lanham Act 2(e)(1))
Lanham Act Section 2

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it –

... 

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive . . . of them

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce.
# The Continuum of Distinctiveness

<table>
<thead>
<tr>
<th>Inherently Distinctive</th>
<th>Capable of becoming distinctive</th>
<th>Never distinctive</th>
</tr>
</thead>
<tbody>
<tr>
<td>Fanciful &amp; Arbitrary</td>
<td>Suggestive</td>
<td>Descriptive</td>
</tr>
<tr>
<td>KODAK cameras</td>
<td>COPPERTONE lotion</td>
<td>BEST BUY</td>
</tr>
<tr>
<td>APPLE computers</td>
<td></td>
<td>retail stores</td>
</tr>
</tbody>
</table>
Evidence of Secondary Meaning

• **Direct:**
  – Consumer Testimony
  – Consumer Surveys

• **Circumstantial:**
  – Exclusivity, length, manner of use
  – Amount and manner of advertising
  – Amount of sales
  – Established place in the market
  – Proof of intentional copying
a substantial proportion of the relevant consumer population
MEET DICK.
DON'T BE A DICK.
DICK IS A MICHIGAN FAN...
GO BLUE!

I DON'T OFTEN HATE,
BUT WHEN I DO...
I PREFER TO HATE
THE OHIO STATE BUCKEYES.

YOU BET YOUR SWEET ASS I HATE OKLAHOMA!

YBYSAA
5th Circuit’s Secondary Meaning Multi-Factor Test:

(1) Length and manner of use of the mark or trade dress;
(2) Volume of sales;
(3) Amount and manner of advertising;
(4) Nature of use of the mark or trade dress in newspapers and magazines;
(5) Consumer-survey evidence;
(6) Direct consumer testimony; and
(7) The defendant’s intent in copying the trade dress
NEVERTHELESS, SHE PERSISTED.
**Word Mark**
JE SUIS CHARLIE

**Goods and Services**
(ABANDONED) IC 018. US 001 002 003 022 041. G & S: bags, luggage, suitcases, backpacks, key cases, key chains with leather, wallets, brief cases

(ABANDONED) IC 021. US 002 013 023 029 030 033 040 050. G & S: mugs, cups, beverage glasses, bowls, dishes, salt and pepper shakers, lunch boxes, porcelain ware, pot holders, serving platters, trays, serving dishes, pottery, statues, coasters

(ABANDONED) IC 025. US 022 039. G & S: clothing and footwear

**Standard Characters Claimed**
(4) STANDARD CHARACTER MARK

**Serial Number**
86506015

**Filing Date**
January 16, 2015

**Current Basis**
1B

**Original Filing Basis**
1B

**Owner**
(APPLICANT) Latin American Trading Group, Inc. CORPORATION FLORIDA No. 1031 19400 Turnberry Way Aventura FLORIDA 33180

Max Moskowitz

**Attorney of Record**
TRADEMARK

**Type of Mark**
PRINCIPAL

**Register**
DEAD

**Abandonment Date**
September 29, 2015
I CAN’T BREATHE

Word Mark: I CAN’T BREATHE
Goods and Services: (ABANDONED) IC 025. US 022 039. G & S: Clothing, namely hoodies, t-shirts for men, women, boys, girls and infants. FIRST USE: 20140818. FIRST USE IN COMMERCE: 20140818

Standard Characters Claimed

Mark Drawing Code: (4) STANDARD CHARACTER MARK

Serial Number: 85479784

Filing Date: December 13, 2014

Current Basis: 1A

Original Filing Basis: 1A

Owner: (APPLICANT) Crump, Catherine L. INDIVIDUAL UNITED STATES 206 N. Green Bay Rd., Apt. 408 Waukegan ILLINOIS 60085

Type of Mark: TRADEMARK

Register: PRINCIPAL

Live/Dead Indicator: DEAD

Abandonment Date: September 8, 2015
MAYBE HE’S BORN WITH IT MAYBE IT’S “COVFEFE”
But First, Covfefe