Class 8: Bars to Protection: Aesthetic Functionality, Deceptive Marks, and False Suggestion of a Connection
Class Outline

• Aesthetic Functionality
• Deceptive and Deceptively Misdescriptive Marks
  – Non-Geographic
  – Geographic (aka “Primarily Geographically Deceptively Misdescriptive”)
• Geographic Certification Marks
• False Suggestion of a Connection
Aesthetic Functionality

Whether there are a limited range of alternative designs available to competitors such that exclusive rights in the trade dress feature would put competitors at a significant, non-reputation-related competitive disadvantage.
Wallace Int’l Silversmiths v. Godinger

Wallace Grand Baroque

Godinger 20th Century Baroque
Goods and Services IC 008. US 023. G & S: sterling silver flatware; namely, knives, forks and spoons. FIRST USE: 19410101. FIRST USE IN COMMERCE: 19410101
Serial Number 74024669
Filing Date February 1, 1990
Registration Number 1966039
Registration Date April 9, 1996
Owner (REGISTRANT) WALLACE INTERNATIONAL SILVERSMITHS, INC. CORPORATION DELAWARE 175 McClellan Highway East Boston MASSACHUSETTS 021289114
Register PRINCIPAL-2(F)
Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20060712. Renewal 1ST RENEWAL 20060712
Wallace on “Aesthetic Functionality”

1. Item must be purchased for aesthetic reasons

2. Product design must have aesthetic appeal

3. There must be no viable design alternatives that would have similar aesthetic appeal
Louboutin v. YSL

Louboutin

YSL
Ruby Slippers From 'Wizard Of Oz' To Be Conserved At National Museum Of American History

WASHINGTON -- Dorothy's ruby slippers from "The Wizard of Oz" are being removed from a Smithsonian exhibit to be conserved.

Curators say the famous shoes are old and need to be prepared for a future display at the National Museum of American History. The last day to see the slippers in their current exhibit is Wednesday. They will return to public view April 5 in a new exhibit called "American Stories."
Lanham Act §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 –

(a) Consists of or comprises...deceptive...matter...

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them,...(3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them.
Non-Geographic
Deceptive v. Deceptively Misdescriptive Marks

I. The Statutory Distinction

A. Lanham Act §2(a): bars registration of mark if it consists of or comprises . . . deceptive . . . matter”

B. Lanham Act §2(e)(1): bars registration of a mark which is “deceptively misdescriptive” of goods in connection with which it is used; *but Lanham Act §2(f) allows registration of such a mark if it “has become distinctive of the applicant’s goods in commerce.”
Non-Geographic
Deceptive v. Deceptively Misdescriptive Marks

II. The Consequence of the Distinction:

A. “Deceptive” marks can never be registered

B. “Deceptively Misdescriptive” marks can be registered once they develop secondary meaning
Non-Geographic
Deceptive v. Deceptively Misdescriptive Marks

III. The Basis of the Distinction

A. Marks are “Deceptively Misdescriptive” if they
   1) Misdescribe the character, quality, function, composition or use of the goods, and
   2) Do so in a way that likely deceives prospective purchasers into believing that the misdescription actually describes the goods

B. Marks are “Deceptive” if, in addition to the above, they also
   3) Are likely to be material to the decision to purchase
In other words, a mark is *deceptive* if it is . . .

- false;
- believable; and
- material

A mark is merely *deceptively misdecriptive* of the goods if it is . . .

- false; and
- believable; but
- the falsehood is *not* material
Budge Test

1. Is the term misdescriptive of the character, quality, function, composition or use of the goods?

2. If so, are prospective purchasers likely to believe that the misdescription actually describes the goods?

3. If so, is the misdescription likely to affect a significant portion of the relevant consumers’ decision to purchase?

If “yes” to all 3 = deceptive; no protection. If “yes” to 1 & 2, but “no” to 3 = deceptively misdescriptive; protectable upon showing of secondary meaning.
Tillamook®

All Natural

MEDIUM CHEDDAR CHEESE

Aged Over 60 Days

Voted WORLD'S BEST MEDIUM CHEDDAR

2010 World Championship Cheese Contest

Baby Loaf®

NET WT 2 lb (907g)
Something that’s harder to say than “primarily geographically deceptively misdescriptive marks”:
A mark will be denied registration if “when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them…”
### BEFORE NAFTA (pre-1993)

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| Deceptively Misdescriptive | Registrable (and protectable at common law) with secondary meaning | **TOTALLY UNREGISTRABLE**  
|                 |                                                     | **-- Secondary Meaning will not help**           |
3-part test for primarily geographically deceptively misdescriptive marks:

A mark is primarily geographically deceptively misdescriptive only if:

1. The primary significance of the mark is a generally known geographic location; and

2. The consuming public is likely to believe the place identified by the mark indicates the origin of the goods...when in fact the goods do not come from that place; and

3. The misrepresentation was a material factor in the consumer’s decision.
“Goods-Place Association”

• Public must associate the goods in question with the place identified by the mark

• Even a geographic connotation that is not important to consumers can still satisfy the Goods-Place Association requirement

• The geographic place does not have to be famous for the goods
Goods-Place Association?
Lanham Act §4 – Geographic Certification Marks

→ “indications of regional origin may be registrable under section 4”

United States Patent Office

PRINCIPAL REGISTER
Certification Mark
(Goods)

Ser. No. 204,792, filed Oct. 26, 1964

IDAHO

For: POTATOES AND ONIONS, in CLASS A.
First use on or about July 1, 1935; in commerce in or about July 1939.
The mark certifies that goods so marked are grown in the State of Idaho.
Owning of Reg. No. 631,499.

E. L. HANCOCK, Examiner.
02. State Brand Grade and Packaging Requirements. Idaho® potatoes shall meet all requirements of U.S. Extra No. 1 as defined in the U.S. Standards for Grades of Potatoes, March 27, 1991, with the following additions or exceptions:

a. Mature.

b. Fairly well shaped. Defined as excluding the lower limits of such classification.

c. Appearance as related to russetting. Defined: at least seventy five percent (75%) of the surface of the individual potato shall be moderately netted which means the netting will be solid net-like in appearance.

d. Size shall be two and one eighth (2-1/8) inches in diameter and four (4) ounces minimum, eleven (11) ounces maximum.

e. Tolerances for grade defects are defined in 51.1546(a)(2), for U.S. No. 1.

f. All other tolerances and definitions of the Standards apply.
False Suggestion of a Connection

LA 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—

(a): Consists of or comprises... matter which may ... falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols ...

(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.
1. Whether Applicant’s mark is the same or a close approximation of [person or entity’s] previously used name or identity;

2. Whether Applicant’s mark would be recognized as such by purchasers, in that the mark points uniquely and unmistakably to [the person or entity];

3. Whether [the person or entity] is not connected with the goods that will be sold by Applicant under its mark; and

4. Whether [the person or entity’s] name or identity is of sufficient fame or reputation that when Applicant’s mark is used on Applicant’s good, a connection with [person or entity] would be presumed.
Lanham Act §2(c)

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—

(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.