Greetings,

Congrats to all for making it to the halfway point, and for successful completion of the midterm project.

In this brief memo, I will make a few general observations and will attempt to clarify a few points of common misunderstanding that were revealed during grading. These are the same points I'll make at the top of class on Wednesday, and I'm happy to take questions at that time.

By now, you should have received your score out of 15 points with brief comments (if/where applicable). The class median was 12 points.

If you have any questions about your specific exam, please feel free to send me an email, or to set up a time to come and speak with me.

**Generic v. Store Brand**

Many of you conflated the layman’s understanding of a generic brand (usually a store brand) with trademark’s term-of-art “generic” (as in, unprotectable).

Examples of generic marks in the trademark sense are: Milk for Milk, or Banana for Banana.

Examples of store brands (which are not generic) are Up & Up (Target), Great Value (Walmart) or 365 (Whole Foods). For all of these, the store brand is still a brand. We often know this by the ® that follows the brand name.

Examples of products generic by origin (as opposed to genericide, which is different) would be something like this:
A sufficient portion of the class missed this as to effectively negate the question (with a little bonus bump to the few of you who managed to find a beer called Beer, or who attached a photo of an ad for lemons).

**The ® symbol**

In response to the question “has the descriptive product you located...acquired secondary meaning?” some of you answered “no” and attached a photograph of a product whose brand clearly bore the ® symbol.

The ® symbol usually tells us that a mark has been federally registered. While it’s true that the ® symbol can be misused, it can also be properly used (especially in the context of large, well-known brands). And you can always run a TESS search to confirm.

This means one of two things: either the mark was found inherently distinctive and was granted registration right away; or the mark acquired secondary meaning and then was granted registration.

Thus, the answer to “has the descriptive product you located...acquired secondary meaning?” is always yes if you see a ® symbol, since we know that descriptive products always require secondary meaning.

In addition, marks based on a color, or on product design (as opposed to product packaging) we know also require secondary meaning, so if we see the ® on those products, we know that we’ve acquired it.
Deceptive v. Deceptively Misdescriptive

The difference between a deceptively misdescriptive mark and a deceptive mark is that in the case of a deceptive mark, the falsehood is material.

Importantly, both deceptive and deceptively misdescriptive marks share believability (or plausible believability). Some students found an “inaccurate” mark but said it wasn’t believable. In that case, it’s neither deceptive or deceptively misdescriptive, but rather puffery.

Scandalous & Disparaging Marks pre- and post Tam/Brunetti

This question asked you how they could use such a mark. Companies could always use scandalous and disparaging marks, they just couldn’t register them prior to Tam and Brunetti, which prohibit the PTO from refusing registration on these bases. Post-Tam and Brunetti, they presumably can.

Inherent Distinctiveness of Trade Dress

When asked whether the trade dress identified was inherently distinctive, surprisingly few of you engaged in the analysis we discussed in class; namely:

(1) Does the trade dress in question belong to a category (color, product design/configuration) that the courts have said will never be inherently distinctive? (If yes, can never be inherently distinctive).
(2) If no, apply Seabrook (common, unique, refinement, etc.) or Abercrombie (and, ideally, tell me why you’re picking one or the other); and finally
(3) We double-check by asking whether the trade dress is functional – i.e. does it provide information about the good or service in question that we think competitors need access to?

Many said something along the lines of “when you see this [trade dress], your mind is drawn to the source, ergo inherent distinctiveness” or the opposite. Of course, this same drawing of the mind could be said of a trade dress that acquired distinctiveness through secondary meaning so this conclusion is not indicative of inherentness.

Functionality

For utilitarian functionality, we don’t want to protect design features that competitors need to effectively compete. So we apply the Disc factors (or something like them). Focus here is on availability and price of alternatives. The fact that a design feature is useful does not = utilitarian functionality.

Likewise, in the case of aesthetic functionality, we don’t want to reserve to one entity a monopoly over a design element that consumers will seek (in order to control prices via healthy competition). And so, likewise, the inquiry focuses on the availability of alternatives. The fact that something is “pretty” does not = aesthetic functionality.

K.G.