ACQUIRING TM RIGHTS

INTRODUCTION / JURISDICTION OVER TM SUITS

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Intl Order of Job’s Daughters v Lindeburg & Co

Facts:

Issue: Was the 9th Circuit opinion entitled to collateral estoppel effect in this matter?

Did Lindeburg have standing?

Holding:

TTAB decision?

OBTAINING AND PROTECTING TM RIGHTS AT COMMON LAW

Blue Bell, Inc. v Farah Manufacturing Co. (5th Cir. 1975)

Facts:

Issue: Which party established valid prior use?

Holding:

Zazu Designs v L’Oreal, SA; U.S. Court of Appeals, Seventh Circuit (1992)

Facts:

Issue on appeal: How much “use” (prior to the effective date of the Trademark Law Revision Act of 1988) is enough “use in commerce” to obtain enforceable rights in a trademark?

Holding:

OBTAINING TM RIGHTS BY FED TM REGISTRATION

After 1987 ITU Applications permitted

White Ri v. Paramount Pictures Corporation, (CAFC 1987) 108 F. 3d 1392
August 19, 2015 first class assignment outline

Facts:

Issue: How much “use” is sufficient to claim that a mark is “used in commerce” under §45?

Holding:

Central Manufacturing, Inc. v. Brett (Stoller case)

Facts:

Issue:

Holding:

Reg Based on ITU

Commodore Electronics Ltd v. CBM Kabushiki Haisha

Facts:

Issue:

Holding:
Reg based on Previously obtained Foreign Registration

In Re Societe D’Exploitation de la Marque Le Fouquet”s

Facts:

Issue:

Holding:

§1052. Trademarks registrable on the principal register; concurrent registration

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 immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 2(9) of the Uruguay Round Agreements Act [19 USC §3501(9)]) enters into force with respect to the United States.

(b)

Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(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.

(d)

Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: Provided, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this Act; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.

(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, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 4 [15 USC 1054], (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, (4) is primarily merely a surname, or (5) comprises any matter that, as a whole, is functional.

(f)

Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before the date of the enactment of the North American Free Trade Agreement Implementation Act [enacted Dec. 8, 1993].

A mark which when used would cause dilution under section 43(c) [15 USC 1125(c)] may be refused registration only pursuant to a proceeding brought under section 13 [15 USC 1063]. A registration for a mark which when used would cause dilution under section 43(c) [15 USC 1125(c)] may be canceled pursuant to a proceeding brought under either section 14 [15 USC 1064] or section 24 [15 USC 1092].

SKIM (to read, study, consider, treat, etc., in a superficial or cursory manner) the following:
Blackhorse, et. al. v. Pro-Football, Inc. / Cancellation No. 92046185 / 214 WL 2757516 and

Pro-Football, Inc., v. Amanda Blackhorse (ED VA 2015)


**Class Participation:** Every licensed attorney should have a general knowledge of U.S. Intellectual Property law. While copyrights and patents are significant elements of IP law, trademark and unfair competition is, from a consumer’s point of view, most important. Unlike the former two areas which have a limited life span, a brand has a potentially indefinite life when used and maintained properly.

We will cover many cases during this class. You must attend all classes and arrive prepared to participate by having read (or where specified “skimmed”) and thought about the assigned reading materials. I reserve the right to grant up to 5 points to a student’s final numerical grade for consistent class participation. The goal of this course is to equip you with the understanding and ability to apply trademark and unfair competition law to real world situations for the benefit of your future clients.

**Grading:** Final (letter) grades are determined from numerical grades, on a distribution curve according to GMUSL curve policy. Final numerical grades are determined by final (closed book) examination performance, plus class participation. There usually are four (4) essays and twenty-four (24) multiple choice questions on the three (3) hour closed book final examination.