

**Class 20:  
Distinctiveness And  
Trade Dress**

Administrative

Next Time: 686-87;  
Rescuecom (on  
website); 725-32

Last Time

A Little Bit on  
Registration

Registration at the  
USPTO

Use-based system

First party to use gets  
the registration.

Since 1989: Intent to use  
filing with constructive  
use priority date

But no right to use  
unless actual use.

Registration does not  
create the TM

Without it, can sue  
under 43(a) and state  
law.

Benefits of registration

1. Nationwide  
constructive use and  
notice.

Next Time

2. Possibility of  
incontestable status  
after five years.

Zatarain's FN 5  
Defenses lost: confusing  
similarity; functionality;  
lack of secondary  
meaning.

Many defenses still  
remain: genericness;  
obtained through fraud  
in registration;  
abandonment;  
misrepresentation of  
source; scandalousness;  
fair use; prior use; prior  
registration; antitrust  
violations.

3. Right to sue in  
Federal Court

Two requirements

Use

Distinctiveness

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Last Time

**Distinctiveness**

When this is used / important.

1. Can the mark be federally registered?
2. Should a court agree to cancel a registration due to lack of distinctiveness?
3. Can a suit for infringement under 43(a) (no registration) be brought? -- only for things that could have been registered in the first instance.

**Test**

Only distinctive marks can be protected.

Rules vary for words, symbols, trade dress, etc.

**Two Classes**

**Inherently Distinctive**

For Words: Arbitrary, fanciful, and suggestive.  
Perhaps some product packaging  
No secondary meaning needed.

**NOT inherently Distinctive**

For words: Descriptive  
Also: Geographic Marks; Personal Name Marks; Non-inherently descriptive designs and symbols; Non-inherently distinctive trade dress and packaging; All product and container shapes; colors.  
Secondary Meaning Needed.

Some can NEVER be distinctive

For words: Generic

**Classification**

**Question of Fact**

Compare to Patent: Why not Question of Law a la Non-Obviousness or Claim Construction?

1. Generic

Strategies to avoid genericide

Xerox ad on 791  
Google's threat letters to Dictionaries

2. Descriptive
3. Suggestive
4. Arbitrary
5. Fanciful

Line between Descriptive and Suggestive? +

**Rules for Specific Mark Types**

- Misspelled Words
- Geographic Marks
- Personal Names

**Secondary Meaning**

Test: Is the primary significance of the term in the minds of the consuming public to the product or to the producer?

- Policy Rationale
- Types of Evidence

Zatarain's

- Basic Facts
- Held (Dist Ct and CA5)

**Fair Use**

- Affirmative Defense
- Policy