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Trademark Trivia Part 2

Class 6 – October 10, 2008

SI 519 / PubPol 688

Bryce Pilz

Fall 2008

Q) Party X uses TM “Pure Imagination” in connection with graphic design services on magazines sold in Illinois, Indiana, and Wisconsin, and in Internet advertising, in 2002. Registers the federal TM in 2004.

In 2003, Party Y uses “Pure Imagination” for graphic design services on publications in Texas and Oklahoma. Also uses TM in advertising on Internet in 2003. Who has the rights and where?

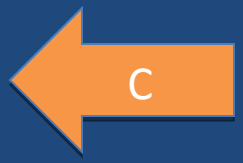
A) Probably Party X everywhere but in Texas and Oklahoma.

Getting TM Rights

- One gets a TM through use in commerce (like © in that no need to mark or register)
- Registration can make mark incontestable after five years
- To register, need to show proof of use in commerce (or intent to use); distinctiveness or secondary meaning
- Registration = Constructive nationwide use

Q) If I have an unregistered mark that I'm using to identify a product, how should I provide notice of my trademark rights?

A) SM
B) ®
C) TM
D) M



Q) Does Domino's Pizza have to license it's use of the Domino's name from Domino's sugar? (Sugar was first to use in commerce.) Why or why not?

Source: http://graphics.samsclub.com/images/products/0004920004754_LG.jpg

A) Yes – both in food sector

B) Yes – exact same word

C) No – different fields

D) No – it's fair use

C

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TM Infringement Test

- Likelihood of Confusion
  - Strength of mark
  - Proximity of the goods
  - Similarity of the marks
  - Evidence of actual confusion
  - Similarity of marketing channels
  - Degree of caution from typical consumer
  - Defendant's intent

Confusingly Similar?

Source: http://bp0.blogger.com/_ef_M4U2nwus/R_D5AnHQZII/AAAAAAAABMQ/ZdHEohRufRE/s1600-h/2verts.jpg

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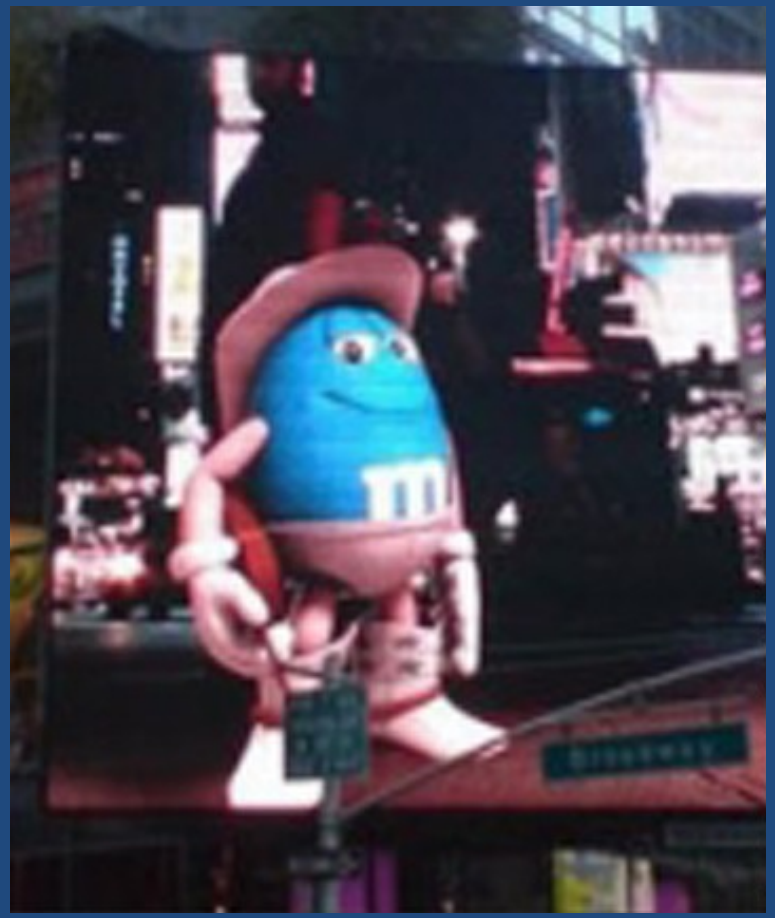
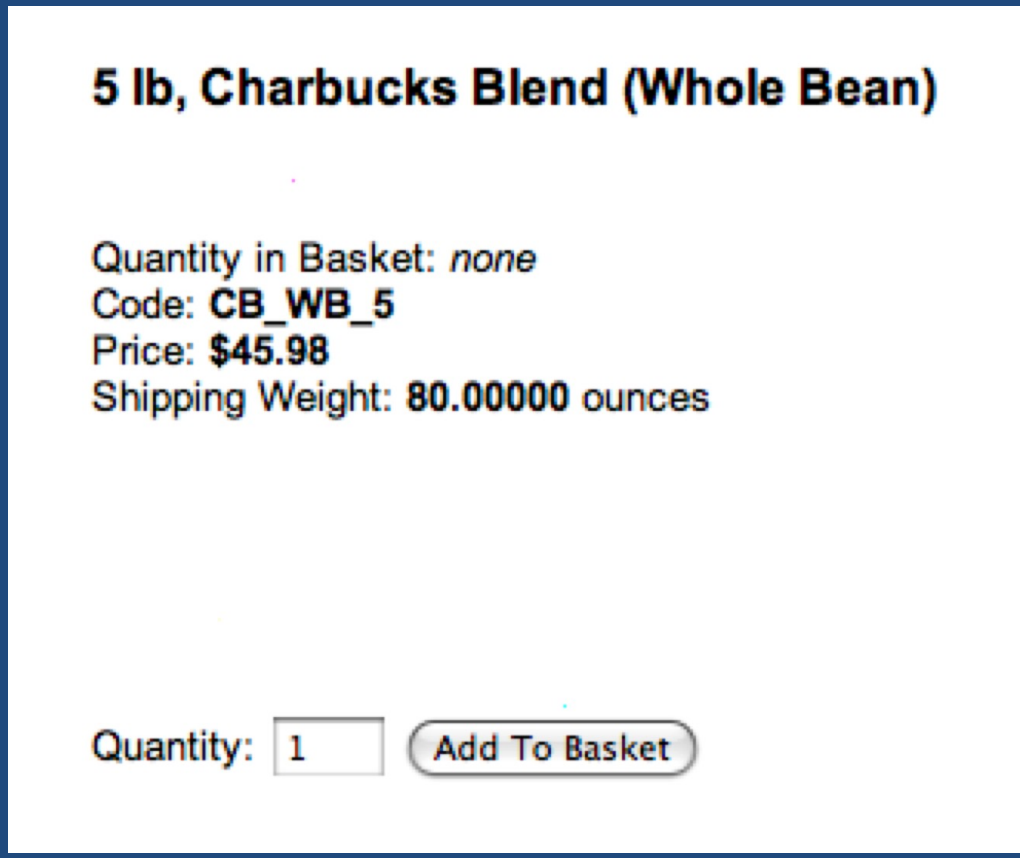


Source: http://serfcity.files.wordpress.com/2008/02/naked-cowboy-mm.jpg

Q) Does the use of "Charbucks" as a blend of coffee infringe any TM rights of Starbucks? Why or why not?

A) Yes – confusingly similar
B) Yes - dillution
C) Both A & B
D) Neither

D



Source: http://www.blackbearcoffee.com/

Dilution

- Only for “famous” marks
- Protects harm to your trademark, not necessarily competition
- Blurring or tarnishing
    - Not necessarily confusing

Q) Is the following use of the “Canon” TM an act of infringement and why or why not?

Source: Undetermined

a) Yes – they are using the TM in commerce

b) Yes – you can’t tell who makes the toner

c) No – it’s a fair use

C

d) No – TM law doesn’t apply to replacement parts

Brookfield Communications

- “stealth” use of trademarks
- Holding?
- Exit sign analogy – perfect?

Patent v. Copyright

Copyright	Patent
Protects expression not ideas	Protects ideas that have been reduced to practice
Life of author + 70 years	20 years from filing
Fair Use	No Fair Use No Research Exemption
Works for hire	Employee inventor owns
Protects against copying	Innocent infringement not a defense
Protection is automatic (registration is relatively simple)	Extensive examination process before any rights granted
Originality (low bars)	Novelty and Nonobvious (high bars)

Software Considerations

- Copyright (automatic; covers the authorship in the source code) may be sufficient if:
  - Commercial life of software is less than time to get patent
  - Value is in the source code rather than in the method it performs
  - Method may not be patentable
  - Open source used
- Patentability standard for software patents is strict and uncertain (*Bilski* case pending)
  - Must be tied to a machine (possibly more than a general use computer) or result in a physical transformation