

TRADEMARK CHECKLIST

(Highly simplified. Use this to review our coverage of trademark law and to test your understanding of the doctrine.)

Does the plaintiff own a valid trademark/trade dress?

- Is there a “use in commerce”? *Planetary Motion*
- Is it used “as a mark”? *Microstrategy*
- Is it distinctive? *Abercrombie* (spectrum of distinctiveness); *Zatarains* (descriptive or suggestive)
- Does it fall into a category that requires acquired distinctiveness (e.g. merely descriptive, *Zatarains*, color, *Qualitex*, design as opposed to packaging, *Wal-Mart*)? If so, does it have acquired distinctiveness? § 1052(f)
- Is it functional; utilitarian or aesthetic? Functional product features are never protectable. *TrafFix*
- Does it fall into another category that is never protectable (generic, deceptive, etc.)?
- For federal registration of marks, is registration barred by any of the provisions in § 1052 (deceptive marks, names, geographic terms, etc.)? *See* Chapter 6; note the provisions of § 1052 invalidated by *Matal* and *Brunetti*. For unregistered marks, § 1125(a), many if not all of § 1052’s limitations also apply.

Was there confusion-based infringement?

- Did the defendant use a similar mark in commerce in connection with goods or services? *Rescuecom*, *PETA* (note: the reasoning in *PETA* has been disavowed or limited by subsequent courts)
- Was there a likelihood of confusion as to source or sponsorship? *Lois*, § 1114, § 1125. (note: some courts consider initial interest confusion and post-sale confusion) *Lois*; Chapter 7 summary
- Did the defendant engage in *direct* infringement (infringed through their own actions) or *contributory* infringement (facilitated someone *else’s* infringement)? *Tiffany*

Do any defenses apply?

- Was the defendant’s use a *classic* fair use (aka “descriptive fair use”? *KP Permanent Make-Up*, § 1115(b)(4)
- Was the defendant’s use a *nominative* use? *New Kids on the Block*, *Mattel*, *Playboy*
- Did the defendant use the trademark in the title of an artistic work? *Mattel* (applying *Rogers*)
- Was it a successful parody? (Effective parodies diminish likelihood of confusion) *Smith*

Was there false advertising under § 1125(a)?

- Was there a false or misleading statement of fact? *Pizza Hut*
- If it was true but misleading, was there materiality? *Pizza Hut*

Was there dilution under § 1125(c)?

- Was the plaintiff’s mark “famous”? *Coach*
- Was there dilution by blurring? *Starbucks*
- Was there dilution by tarnishment? *Smith*
- Do any exceptions apply? *Smith*, § 1125(c)(3)(c)

Was there cybersquatting under § 1125(d)?

- Was there a domain name registration with a “bad faith intent to profit”? *Lamparello*

