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 cyberpiracy under § 1125(d)?

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