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*