

## 15.10 Infringement—Elements—Validity—Unregistered Marks—Distinctiveness

### Strength as a Likelihood of Confusion Factor

In deciding whether there is infringement, an important factor is how strong and well-known a trademark is. [See Instruction insert number of instruction regarding Sleekcraft Test, e.g., 15.18 for determining whether the trademark used by the defendant creates for consumers a likelihood of confusion with the plaintiff’s trademark].]

The plaintiff [name] asserts [insert claimed trademark] is a valid and protectable trademark for its [insert goods used in connection with the trademark]. [The plaintiff [name] contends that the defendant [name]’s use of [those] [similar] words in connection with the defendant’s [insert the defendant’s product or service or business] [[infringes plaintiff [name]’s trademark] [and] [is likely to cause confusion about the [origin of goods] [business] associated with that trademark.]] To determine if the plaintiff [name] has met its burden of showing that [insert claimed trademark] is a valid trademark, you should classify it on the spectrum of trademark distinctiveness that I will explain in this instruction.

[An inherently distinctive trademark is a word, symbol or device, or combination of them, which intrinsically identifies a particular source of a good in the market. The law assumes that an inherently distinctive trademark is one that almost automatically tells a consumer that it refers to a brand or a source for a product, and that consumers will be predisposed to equate the trademark with the source of a product.]

### Spectrum of Marks

Trademark law provides [great] protection to distinctive or strong trademarks. Conversely, trademarks that are not as distinctive or strong are called “weak” trademarks and receive less protection from infringing uses. Trademarks that are not distinctive are not entitled to any trademark protection. To decide trademark protectability, you must consider whether a trademark is inherently distinctive. Trademarks are grouped into five categories according to their relative [strength] [distinctiveness]. These five categories are, in order of strength or distinctiveness: arbitrary (which is inherently distinctive), fanciful (also inherently distinctive), suggestive (also inherently distinctive), descriptive (which is protected only if it acquires in consumers’ minds a “secondary meaning” which I explain in Instruction [insert number of instruction regarding secondary meaning, e.g., 15.11], and generic names (which are entitled to no protection).

**Arbitrary Trademarks.** The first category of trademarks is arbitrary trademarks. They are considered strong marks and are clearly protectable. They involve the arbitrary use of a word to designate the source of a product. Such a trademark is a word that in no way describes or has any relevance to the particular product it is meant to identify. It may be a common word

used in an unfamiliar way.

For instance, the common word “apple” became a strong and inherently distinctive trademark when used by a company to identify the personal computers that company sold. The company’s use of the word “apple” was arbitrary because “apple” did not describe and was not related to what the computer was, its components, ingredients, quality, or characteristics. “Apple” was being used in an arbitrary way to designate for consumers that the computer comes from a particular manufacturer or source.

**Fanciful (or Coined) Trademarks.** The next category is fanciful (or coined) trademarks.

These trademarks are also inherently distinctive and have the same level of strength as arbitrary marks. They are therefore automatically protectable. Fanciful trademarks involve the use of a fanciful or fictitious word to designate the source of a product. Such a trademark is a word that in no way describes or has any relevance to the particular product it is meant to identify. It is a newly created (coined) word, which is used solely as a trademark. For instance, the fanciful trademark “Google” is a strong and inherently distinctive trademark, identifying a prominent technology company. “Google” is a coined word that had no meaning or application prior to its use as the name of this company.

**Suggestive Trademarks.** The third category is suggestive trademarks. These trademarks are inherently distinctive but are considered weaker than arbitrary and fanciful trademarks. Unlike arbitrary trademarks, [which are in no way related to what the product is or its components, quality, or characteristics,] suggestive trademarks imply some characteristic or quality of the product to which they are attached. If the consumer must use imagination or any type of multi-stage reasoning to understand the trademark’s significance, then the trademark does not describe the product’s features, but merely suggests them.

A suggestive use of a word involves consumers associating the qualities the word suggests to the product to which the word is attached. For example, when “apple” is used not to indicate a certain company’s computers, but rather “Apple–A–Day” Vitamins, it is being used as a suggestive trademark. “Apple” does not describe what the vitamins are. However, consumers may come to associate the healthfulness of “an apple a day keeping the doctor away” with the supposed benefits of taking “Apple–A–Day” Vitamins.

**Descriptive Trademarks.** The fourth category is descriptive trademarks. These trademarks directly identify or describe some aspect, characteristic, or quality of the product to which they are affixed in a straightforward way that requires no exercise of imagination to be understood.

For instance, the word “apple” is descriptive when used in the trademark “CranApple” to designate a cranberry-apple juice. It directly describes ingredients of the juice. Other

common types of descriptive trademarks identify where a product comes from, or the name of the person who makes or sells the product. Thus, the words “Apple Valley Juice” affixed to cider from the California town of Apple Valley is a descriptive trademark because it geographically describes where the cider comes from. Similarly, a descriptive trademark can be the personal name of the person who makes or sells the product. So, if a farmer in Apple Valley, Judy Brown, sold her cider under the label “Judy’s Juice” (rather than “Apple Valley Juice”) she is making a descriptive use of her personal name to indicate and describe who produced the apple cider [and she is using her first name as a descriptive trademark.]

**Generic Names.** The fifth and final category is entitled to no protection at all. They are called generic terms and are the names of a product, as opposed to a term that designates the source of a product. Generic names are part of our common language that we need to identify all such similar products. A generic name is a name for the product on which it appears.

If the primary significance of the alleged mark is to name the type of product rather than the manufacturer, the term is a generic name and cannot be a valid trademark. If the majority of [relevant] consumers would understand the term to name the type of product rather than the manufacturer, the primary significance of the term is generic and not entitled to protection as a trademark.

The word “apple” can be used as a generic name and not be entitled to any trademark protection. This occurs when the word is used to identify the fruit from an apple tree.

The computer maker who uses the word “apple” as a trademark to identify its personal computer, or the vitamin maker who uses that word as a trademark on vitamins, has no claim for trademark infringement against the grocer who used that same word to indicate the fruit sold in a store. As used by the grocer, the word is generic and does not indicate any particular source of the product. As applied to the fruit, “apple” is simply a commonly used name for what is being sold.

### **Mark Distinctiveness and Validity**

If you decide that [*insert the plaintiff’s claimed trademark*] is arbitrary or suggestive, it is considered inherently distinctive. An inherently distinctive trademark is valid and protectable.

On the other hand, if you determine that [*insert the plaintiff’s claimed trademark*] is generic, it cannot be distinctive and therefore is not valid nor protectable. You must render a verdict for the defendant [*name*] on the charge of infringement in Instruction [*insert number of instruction regarding Trademark Elements and Burden of Proof, e.g., 15.6*].

If you decide that [*insert the plaintiff’s claimed trademark*] is descriptive, you will not know if the trademark is valid or invalid until you consider whether it has gained distinctiveness by the acquisition of secondary meaning, which I explain in Instruction [*insert*

number of instruction regarding secondary meaning, e.g., 15.11].

#### Comment

This instruction sets forth the first prong of the two-prong test of mark strength used in the Ninth Circuit. The second prong of the test is found in Instruction 15.11 (Infringement—Elements—Validity—Distinctiveness—Secondary Meaning). This instruction sets out the general standard for assessing the strength of a trademark. It may require modifications in a case involving service marks, collective trade or service marks, or certification trade or service marks. Often this adjustment is possible by inserting the term service, service mark, collective mark, etc., in lieu of the words “product” and “trademark” in this instruction.

While the elements of mark distinctiveness are the same in determining mark validity or likelihood of confusion, use Instruction 15.19 (Infringement—Likelihood of Confusion—Factor—Strength [Distinctiveness] of Trademark) for assessing distinctiveness in the context of alleged infringement of a valid mark; use this instruction (15.10) if distinctiveness goes to the question of whether a mark can be protected as a valid mark.

This instruction is based upon the test in *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 10-11 (2d Cir.1976) (setting forth spectrum of marks from arbitrary to generic). The Supreme Court notes this case sets out a “classic test” of trademark strength. *Wal-Mart Stores, Inc., v. Samara Brothers, Inc.*, 529 U.S. 205, 210 (2000). It sets out the traditional spectrum of marks. *See, e.g., Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (“Marks are often classified in categories of generally increasing distinctiveness; following the classical formulation ... they may be (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful.”); *Survivor Media, Inc. v. Survivor Prods.*, 406 F.3d 625, 631-32 (9th Cir. 2005) (noting that trademarks are divided into five categories: arbitrary, fanciful, suggestive, descriptive, and generic). *See also KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 328 F.3d 1061, 1067 (9th Cir. 2003) (noting that trademark categories of arbitrary and fanciful “are deemed inherently distinctive and are automatically entitled to protection”), *vacated on other grounds*, 543 U.S. 111 (2004); *U.S. Pat. & Trademark Off. v. Booking.com B.V.*, 591 U.S. 549, 564 (2020) (rejecting proposition that combining generic term with “.com” yields generic composite).

A mark’s strength is equivalent to its distinctiveness. *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1291 (9th Cir. 1992). Since 1988, the Ninth Circuit has utilized a two-prong test of mark strength. *See GoTo.Com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 1207 (9th Cir. 2000) (“‘strength’ of the trademark is evaluated in terms of its conceptual strength and commercial strength”). Generally, use of the second prong is appropriate in cases of descriptive or suggestive marks. *See, e.g., Japan Telecom, Inc. v. Japan Telecom Am., Inc.*, 287 F.3d 866, 873-74 (9th Cir. 2002) (noting that descriptive trade name is not protectable unless owner shows it acquired secondary meaning and applying strength of mark analysis to

tradename).

Traditionally, the Ninth Circuit has held that even though a mark has become incontestable, this status does not necessarily mean that it is a strong mark. *See Miss World (UK) Ltd. v. Mrs. Am. Pageants*, 856 F.2d 1445, 1449 (9th Cir. 1988). However, in 2003, the Ninth Circuit appeared to indicate that when a mark has become incontestable, it is presumed to be a strong mark as well. The Circuit noted that “[a] descriptive mark that has become incontestable is conclusively presumed to have acquired secondary meaning. *Entrepreneur Media, [Inc. v. Smith,]* 279 F.3d [1135, 1142 n.3 (9th Cir. 2002)]. This means that a defendant in a trademark infringement action cannot assert that an incontestable mark is invalid because it is descriptive and lacks secondary meaning. *Park ’N Fly*, 469 U.S. at 205.” *KP Permanent Make-Up, Inc.*, 328 F.3d at 1071. *See id.* (holding that trademark’s “incontestable registration is conclusive evidence that the mark is non-descriptive or has acquired secondary meaning, and there is no need to require a showing of secondary meaning” of the mark), *vacated on other grounds*, 543 U.S. 111 (2004).

### ***Supplemental Instructions***

#### **Trade Dress Adjustments**

In *Wal-Mart Stores Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 212-13 (2000), the Supreme Court distinguished between two types of trade dress: product packaging and product design. Product packaging can be inherently distinctive, product design trade dress can never be classified as “inherently distinctive.” *Id.* at 212-14 (noting that product packaging “is most often to identify the source of the product,” while product design is “almost invariably . . . intended not to identify the source, but to render the product itself more useful or more appealing”). To be protected under § 43(a) of the Lanham Act, a product design must have secondary meaning.

*Wal-Mart* requires courts to distinguish between trade dress that is product packaging and trade dress that is product design. Courts generally “use[] a common sense approach” in making that classification, “asking what is the primary product that the buyer is purchasing.” 5 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 8:12 (5th ed. 2019) (collecting cases). In close cases, “courts should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning.” *Wal-Mart Stores*, 529 U.S. at 215. *See* Instruction 15.11 (Infringement—Elements—Validity—Distinctiveness—Secondary Meaning).

In cases involving product packaging, neither the Supreme Court nor the Ninth Circuit has adopted a specific test for determining inherent distinctiveness. The Ninth Circuit has generally suggested that inherently distinctive trade dress involves an overall impression that is arbitrary or uncommon. *Fuddruckers, Inc. v. Doc’s B.R. Others, Inc.*, 826 F.2d 837, 844 (9th Cir. 1987) (“Fuddruckers claims trade dress protection for the impression created by a

collection of common or functional elements of restaurant decor. Such an overall impression may receive protection, but it is simply not the sort of arbitrary or uncommon trade dress that might qualify as inherently distinctive.” (citation omitted)). A combination of individual elements “that are separately unprotectable can be protected together as part of a trade dress.” *Clicks Billiards, Inc. v. Sixshooters, Inc.*, 251 F.3d 1252, 1259 (9th Cir. 2001).

Some courts apply the *Abercrombie* spectrum for word marks to assess whether product packaging is inherently distinctive. *E.g.*, *Fun-Damental Too, Ltd. v. Gemmy Indus.*, 111 F.3d 993, 1000-01 (2d Cir. 1997) (“We see no reason to abandon the *Abercrombie* distinctiveness spectrum in this [product packaging] case.”). But courts and scholars have noted that the *Abercrombie* categories are not always useful outside the word mark context. *E.g.*, *Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225, 243 (5th Cir. 2010) (holding that *Abercrombie* test was unhelpful in assessing whether star symbol was inherently distinctive but declining to hold that *Abercrombie* test was never appropriate outside word mark context); McCarthy on Trademarks § 8:13 (“Only in rare cases do the word categories make sense when applied to the shapes, images and colors of product packaging.”).

Other courts have used the test announced in *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 1344-46 (C.C.P.A. 1977), either alone or in combination with the *Abercrombie* categories, to assess whether product packaging is inherently distinctive. *E.g.*, *Mattel, Inc. v. MGA Entertainment, Inc.*, 782 F. Supp. 2d 911, 1004 (C.D. Cal. 2011) (applying *Seabrook* test and observing that *Seabrook* test is the “predominant test for inherent distinctiveness” of product packaging); *Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25, 42 (1st Cir. 2001) (“[W]e have found it appropriate to supplement the somewhat bare-boned *Abercrombie* categories with the questions asked in *Seabrook*.”). The *Seabrook* test requires that packaging trade dress meet four elements to be inherently distinctive: (1) the design or shape should not be a common, basic shape or design; (2) it should be unique or unusual in a particular field; (3) it should not be a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods or services which consumers would view as mere ornamentation; (4) it should create a separate commercial impression apart from any accompanying words. *Seabrook Foods*, 568 F.2d at 1344-46. *But see* McCarthy on Trademarks § 8:13 (contending that fourth element does not belong on the list because it does not relate to inherent distinctiveness).

This instruction can be modified for trade dress cases involving packaging by inserting the words “trade dress” in lieu of “trademark” and the words “symbol” or “design” in lieu of the term “word” when they are used in this instruction. Courts might also remove references to the “Spectrum of Marks,” including everything that follows the “Spectrum of Marks” heading. After the first three paragraphs, the following should be added for trade dress cases:

Trade dress is inherently distinctive if the total impression it gives the consumer is one that identifies it as coming from a specific origin or source, whether or not that source is known to the consumer. Inherently distinctive trade dress helps consumers identify the

product, distinguishing the plaintiff's product from that produced by others, such as the defendant.

You should consider the total visual impression of the trade dress, not each element of it in isolation. Inherently distinctive trade dress often uses common, non-distinctive elements when considered individually. However, it is the combination of elements and the total impression that the dress conveys to the consumer that shows if it is distinctive.

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