

15.11 Infringement—Elements—Validity—Distinctiveness—Secondary Meaning

If you determined in Instruction [*insert number of instruction e.g. 15.10*] that [*identify plaintiff's claimed trademark*] is descriptive, you must consider the recognition that the mark has among prospective consumers to determine whether it is valid and protectable even though it is descriptive. This market recognition is called the trademark's "secondary meaning."

A [word] [name] [symbol] [device] [or any combination of these items] acquires a secondary meaning when it has been used in such a way that its primary significance in the minds of the prospective consumers is not the product itself, but the identification of the product with a single source, regardless of whether consumers know who or what that source is. You must find that the preponderance of the evidence shows that a significant number of the consuming public associates the [*identify the alleged trademark*] with a single source, to find that it has acquired secondary meaning.

When you are determining whether [*describe symbol or term*] has acquired a secondary meaning, consider the following factors:

(1) Consumer Perception. Whether the people who purchase the product that bears the claimed trademark associate the trademark with the [owner] [assignee] [licensee];

(2) Advertisement. To what degree and in what manner the [owner] [assignee] [licensee] may have advertised under the claimed trademark;

(3) Demonstrated Utility. Whether the [owner] [assignee] [licensee] successfully used this trademark to increase the sales of its product;

(4) Extent of Use. The length of time and manner in which the [owner] [assignee] [licensee] used the claimed trademark;

(5) Exclusivity. Whether the [owner's] [assignee's] [licensee's] use of the claimed trademark was exclusive;

(6) Copying. Whether the defendant intentionally copied the [owner's] [assignee's] [licensee's] trademark;

(7) Actual Confusion. Whether the defendant's use of the plaintiff's trademark has led to actual confusion among a significant number of consumers; and

(8) [*Insert any other factors that bear on secondary meaning*]

The presence or absence of any factor should not necessarily resolve whether [*identify the alleged trademark*] has acquired secondary meaning.

Descriptive marks are protectable only to the extent you find they acquired distinctiveness [[through secondary meaning] [by the public coming to associate the mark with the [owner of the mark] [a particular source]]. Descriptive marks are entitled to protection only as broad as the secondary meaning they have acquired, if any. If they have acquired no secondary meaning, they are entitled to no protection and cannot be considered a valid mark.

[The plaintiff [name] has the burden of proving that the [identify plaintiff's trademark] has acquired a secondary meaning.] [The defendant [name] has the burden of proving that the [identify plaintiff's trademark] lacks a secondary meaning.]

The mere fact that the plaintiff [name] is using [describe symbol or term], or that the plaintiff [name] began using it before the defendant [name], does not mean that the trademark has acquired secondary meaning. There is no particular length of time that a trademark must be used before it acquires a secondary meaning.

Comment

The test for secondary meaning is the same whether for product configuration or trade dress or trademark cases. *See Avery Dennison Corp. v. Sumpton*, 189 F.3d 868, 876 n. 6 (9th Cir. 1999). The penultimate paragraph to this instruction specifies two different burdens of persuasion as to secondary meaning. The burden is on the plaintiff if the mark is not registered, in which case part of the plaintiff's burden is to show the mark is distinctive (either by being inherently distinctive or by having acquired secondary meaning), and hence protectable. *See Self-Realization Fellowship Church v. Ananda*, 59 F.3d 902, 910-12 (9th Cir. 1995) (holding that plaintiff's unregistered mark was descriptive and lacked secondary meaning, and therefore, was invalid). *See also Filipino Yellow Pages. v. Asian J. Publ'ns*, 198 F.3d 1143, 1151-52 (9th Cir. 1999). On the other hand, if the mark is validly registered but has not yet attained incontestable status, the plaintiff's registration carries a presumption of secondary meaning, because registered marks are presumed distinctive. *Americana Trading, Inc., v. Russ Berrie & Co.*, 966 F.2d 1284, 1287 (9th Cir. 1992). In that case, if the defendant wishes to argue that the plaintiff's mark was weak (*e.g.*, was descriptive) and not entitled to trademark protection, the burden is on the defendant to prove that secondary meaning has not attached. *Id.*

Failure to list actual confusion as one of the factors the jury should consider in determining whether the plaintiff had established secondary meaning is not harmless error. *See Adray v. Adry-Mart, Inc.*, 76 F.3d 984, 987 (9th Cir. 1995). *See also Comm. for Idaho's High Desert, Inc. v. Yost*, 92 F.3d 814, 822-23 (9th Cir. 1996) ("Factors considered in determining whether a secondary meaning has been achieved include: (1) whether actual purchasers of the product bearing the claimed trademark associate the trademark with the producer, (2) the degree and manner of advertising under the claimed trademark, (3) the length and manner of use of the claimed trademark, and (4) whether use of the claimed trademark has been exclusive." (citation omitted)).

Secondary meaning can be proved in a variety of ways, including “direct consumer testimony; survey evidence; exclusivity, manner, and length of use of mark; amount and manner of advertising; amount of sales and number of customers; established place in the market; and proof of intentional copying by the defendant.” *P & P Imps. LLC v. Johnson Enters., LLC*, 46 F.4th 953, 961 (9th Cir. 2022). Because “[t]here is no logical reason for the precise copying save an attempt to realize upon a secondary meaning that is in existence,” *Audio Fid., Inc. v. High Fid. Recordings, Inc.*, 283 F.2d 551, 558 (9th Cir. 1960), “[p]roof of copying strongly supports an inference of secondary meaning,” *P & P Imps. LLC*, 46 F.4th at 961. The plaintiff does not have to prove that the defendant intended to confuse consumers and pass off its products as the plaintiffs to raise such an inference. Secondary meaning can also be established by evidence of a likelihood of confusion. *Id.* Evidence of retailer confusion may be appropriate when a market involves specialized distributors that leads to retailers functionally operating as consumers. *Jason Scott Collection, Inc. v. Trendily Furniture, LLC*, 68 F.4th 1203, 1217 (9th Cir. 2023).

When a mark is not in the public domain, a showing of secondary meaning requires a mark to be associated in common thought, not merely with the thing produced, but with the source or origin of the production, even if anonymous. *See Maljack Prods. v. Goodtimes Home Video Corp.*, 81 F.3d 881, 887 (9th Cir. 1996) (holding that when a movie title is not in the public domain, showing of secondary meaning only requires proof that the public associates the movie title with a single source, even if anonymous); *Grupo Gigante SA De CV v. Dallo & Co., Inc.*, 391 F.3d 1088, 1095-96 (9th Cir. 2004) (“Secondary meaning refers to a mark’s actual ability to trigger in consumers’ minds a link between a product or service and the source of that product or service. That is, a mark has secondary meaning ‘when, in the minds of the public, the primary significance of a mark is to identify the source of the product rather than the product itself.’ Determining whether a mark has secondary meaning requires taking into account at least seven considerations”) (quoting *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 211 (2000)). This rule also applies in trade dress infringement cases. *See P & P Imps. LLC*, 46 F.4th at 960 (holding with respect to trade dress that “[s]econdary meaning exists when in the minds of the public, the primary significance of [the trade dress] is to identify the source of the product rather than the product itself,” and this requirement is satisfied by evidence establishing “association with only a single—even anonymous—source” (internal quotation marks omitted)).

“While evidence of a manufacturer’s sales, advertising and promotional activities may be relevant in determining secondary meaning, the true test of secondary meaning is the effectiveness of this effort to create it.” *International Jensen v. Metrosound U.S.A.*, 4 F.3d 819, 824-25 (9th Cir. 1993) (citation omitted). The Ninth Circuit has said that when a descriptive mark is especially weak, “we require a ‘strong showing of strong secondary meaning.’” *Japan Telecom, Inc.*, 287 F.3d at 873 (citations omitted).

Regarding how a descriptive word acquires a secondary meaning, the following text may be added to the second paragraph of this instruction:

Only if a descriptive word acquires secondary meaning will the law protect it as a trademark. For instance, the words a business might use for its special oil change service, “10-Minute Oil Change,” are descriptive when used in connection with this service because it literally describes a feature or attribute of the product or service available there. However, over time, the consuming public may come to associate those four words with a service offered only by that particular garage. The words would no longer designate their original ordinary, descriptive meaning. Instead the words have taken on a new, “secondary” meaning to identify the particular garage that performs the oil change.

“Secondary meaning” may be referred to as “acquired meaning.” *See Wal-Mart Stores, Inc.*, 529 U.S. at 211, n.*. If it is not inherently distinctive, a mark may acquire distinctiveness if it has developed secondary meaning. *Id.* at 211. This means the mark’s primary significance in the public mind is to identify the source of the product rather than the product itself. *Id.* But the term secondary meaning “is often a misnomer,” particularly when applied to non-word marks. *Id.* “Clarity might well be served by using the term ‘acquired meaning’ in both the word-mark and the non-word mark contexts” rather than the term “secondary meaning.” *Id.* However, the Ninth Circuit continues to use the term “secondary meaning.” *See Jason Scott Collection, Inc. v. Trendily Furniture, LLC*, 68 F.4th 1203, 1212 (9th Cir. 2023) (“To obtain a judgment for trade dress infringement, a plaintiff must prove: (1) that its claimed trade dress is nonfunctional; (2) that its claimed dress serves a source-identifying role either because it is inherently distinctive or has acquired secondary meaning; and (3) that the defendant’s product or service creates a likelihood of consumer confusion.” (citation omitted)); *P & P Imps. LLC v. Johnson Enters., LLC*, 46 F.4th 953, 958 (9th Cir. 2022) (enumerating elements for trade dress infringement as “(1) the trade dress is nonfunctional, (2) the trade dress has acquired secondary meaning, and (3) there is a substantial likelihood of confusion between [the parties’] products.” (citation omitted)). If using the term “acquired meaning” would provide clarity for the jury in trademark cases involving non-word marks, the court may opt to use “acquired meaning” throughout its instructions in place of or in addition to “secondary meaning.”

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