

15.2 Definition—Trademark (15 U.S.C. § 1127)

A trademark is any word, name, symbol, device [, or any combination thereof,] used by a person to identify and distinguish that person’s goods from those of others and to indicate the source of the goods[, even if that source is generally unknown].

[Name of corporation, if a party] is a person as that term is used in these instructions.]

[A person who uses the trademark of another may be liable for damages.]

Comment

This instruction is a model for any case involving a trademark as defined by the Lanham Act, 15 U.S.C. § 1127. Under the Lanham Act, the term “mark” is often used to define the various types of mark protected by the trademark law, such as trade and service marks, collective trade and service marks, and certification trade and service marks. *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 306 (9th Cir. 1992). For instructions on other trade devices protected by trademark law, see Instruction 15.3 (Definition—Trade Dress) and Instruction 15.4 (Definition—Trade Name/Commercial Name).

A corporation is a person. See Instruction 4.2 (Liability of Corporations—Scope of Authority Not in Issue).

A trademark is a limited property right in a particular word, phrase or symbol. See *New Kids on the Block*, 971 F.2d at 306. A trademark identifies the source of goods. See *Brookfield Commc’ns Inc. v. W. Coast Ent. Corp.*, 174 F.3d 1036, 1051 (9th Cir. 1999). But it fails to serve its source-identifying function when the public has never seen it, for instance when registered for an Internet domain name. *Id.* Accordingly, a trademark is not protected until it is used in public in a manner that creates an association among consumers between the mark and the mark’s owner. *Id.* The ability of a trademark to distinguish the source of the goods it marks, not the uniqueness of its color, shape, fragrance, word, or sign, entitles it to protection. See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164, 166 (1995). Accordingly, even “a color may sometimes meet the basic legal requirements for use as a trademark” if it can sufficiently serve the basic purpose of source identification. *Id.*

If other types of marks are involved in the case, adjustments to this instruction should be made as follows:

Service Mark Cases

If a service mark is at issue, the court should replace “goods” with “services” for the remaining instructions. Further, the court should substitute the following paragraph for the first paragraph of this instruction and substitute the word “service mark” for “trademark” in the second paragraph:

A service mark is any word, name, symbol, device[, or any combination thereof,] used by a person to identify and distinguish such person's services from those of others and to indicate the source of the services[, even if that source is generally unknown]. [Titles, character names, and other distinctive features of radio or television programs may be registered as service marks as well].

"Generally speaking, a service mark is a distinctive mark used in connection with the sale or advertising of services" *Am. Int'l Grp. v. Am. Int'l Bank*, 926 F.2d 829, 830 n.1 (9th Cir. 1991).

Collective Trademark Cases

When a collective trademark is at issue, in lieu of this instruction, insert the following two paragraphs:

A collective trademark is any [word] [name] [symbol] [device][, or combination thereof,] used by [a cooperative] [an association][, or other collective group or organization] to identify and distinguish its goods from those of others, and to indicate the source of the goods[, even if that source is generally unknown].

[A person who uses the collective trademark of a [cooperative] [an association] [, or another collective group or organization] may be liable for damages].

For a description of a collective mark, see *Sebastian Int'l v. Longs Drug Stores*, 53 F.3d 1073, 1077-78 (9th Cir. 1995) (Ferguson, J., concurring).

Collective Service Mark Cases

When a collective service mark is at issue, in lieu of this instruction, insert the following two paragraphs:

A collective service mark is any [word] [name] [symbol] [device][, or combination thereof,] used by [a cooperative] [an association][, or other collective group or organization] to identify and distinguish its services from those of others, and to indicate the source of the services[, even if that source is generally unknown].

[A person who uses the collective service mark of a [cooperative] [an association] [, or another collective group or organization] may be liable for damages.].

Regarding a collective service mark, see *Robi v. Reed*, 173 F.3d 736, 739-40 (9th Cir. 1999) (holding that musical group members, as collective owners of the group's service mark, do not retain the right to use the service mark when they leave the group if the members of original group continue to use service mark; manager of group, who was in a position to control the quality of its services, retained right to use service mark).

Certification Mark for Goods Cases

When a certification mark for goods is at issue, in lieu of this instruction, insert the following two paragraphs:

A certification mark for goods is any [word] [name] [symbol] [device] [, or any combination thereof,] which its owner permits others to use to certify [[a good's [origin] [material] [mode of manufacture] [quality] [accuracy] [*fill in other certifiable characteristics*]] [that the work or labor on the goods was performed by members of a union or other organization].

[A person who uses the certification mark for goods of a [cooperative] [an association] [, or another collective group or organization] may be liable for damages.]

Certification Mark for Services Cases

When a certification mark for services is at issue, in lieu of this instruction, insert the following two paragraphs:

A certification mark for services is any [word] [name] [symbol] [device][, or any combination thereof,] which its owner permits others to use to certify [a service's [origin] [quality] [accuracy] [*fill in other certifiable characteristics*]] [that a service is performed by members of a union or other organization].

[A person who uses the certification mark of a [cooperative] [an association][, or another collective group or organization] may be liable for damages.]

Revised March 2024