

15.9 Infringement—Elements—Validity—Unregistered Marks

[Describe plaintiff's alleged trademark] is not registered. Unregistered trademarks can be valid and provide the trademark owner with the exclusive right to use that mark. Instruction [insert number of instruction regarding Trademark Elements and Burden of Proof, e.g., 15.6] requires the plaintiff to prove by a preponderance of the evidence that [describe plaintiff's alleged trademark] is valid. A valid trademark is a [word, name, symbol, device, or any combination of these items] that is either:

- > (1) inherently distinctive; or
- > (2) descriptive but has acquired a secondary meaning.

[Only a valid trademark can be infringed.] [Only if you determine plaintiff proved by a preponderance of the evidence that the [describe plaintiff [name]'s alleged trademark] is a valid trademark should you consider whether plaintiff [name] owns it or whether defendant [name]'s actions infringed it.]

Only if you determine that [describe plaintiff [name]'s alleged trademark] is not inherently distinctive should you consider whether it is descriptive but became distinctive through the development of secondary meaning, as I will direct in Instruction [insert number of instruction regarding Distinctiveness and Secondary Meaning, e.g., 15.11].

Comment

A trademark is valid only if it is inherently distinctive or if it became distinctive through development of secondary meaning. *Two Pesos, Inc. v. Taco Cabana, Int'l Inc.*, 932 F.2d 1113 (5th Cir. 1991), *aff'd*, 505 U.S. 763, 769 (1992). Whether a symbol acquired secondary meaning is a question of fact for the jury. *See Transgo, Inc. v. Ajac Transmissions Parts Corp.*, 768 F.2d 1001, 1015 (9th Cir. 1985).

In trademark law, the Supreme Court has noted that using the term “secondary meaning”

when referring to descriptive non-word marks that have acquired “source-identifying meaning”

“is often a misnomer in that context, since non-word marks ordinarily have no ‘primary’

meaning” and “[c]larity might well be served by using the term ‘acquired meaning’ in both the word-mark and the non-word-mark contexts.” *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529

U.S. 205, 211 n.* (2000). 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.”

See also Instruction 15.11
(Infringement—Elements—Validity—Distinctiveness—Secondary Meaning).

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