**15.10 Infringement—Elements—Validity—Unregistered Mark—Distinctiveness**

**Strength as a Likelihood of Confusion Factor**

How [distinctively] [strongly] a trademark indicates that a good comes from a [particular] [specific] source [even if unknown] is an important factor to consider in [[assessing its validity] [and] [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 asserts [*insert claimed trademark*] is a valid and protectable trademark for its [*insert goods used in connection with the trademark*]. [The plaintiff contends that the defendant’s use of [those] [similar] words in connection with the defendant’s [*insert the defendant’s product or service or business*] [[infringes plaintiff’s trademark] [and] [is likely to cause confusion about the [origin of goods] [business] associated with that trademark.]]

In order to determine if the plaintiff 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. For deciding 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 is arbitrary trademarks. They are considered strong marks and are automatically protectable. They involve the arbitrary use of a word to designate the source of a [product] [service]. Such a trademark is a word that in no way describes or has any relevance to the particular [product] [service] 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] [service]. Such a trademark is a word that in no way describes or has any relevance to the particular [product] [service] 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] [service] is or its components, quality, or characteristics,] suggestive trademarks imply some characteristic or quality of the [product] [service] 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] [service] 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] [service] 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] [service] comes from, or the name of the person who makes or sells the [product] [service]. 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 CranApple) 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 names and they refer to a general name of the [product] [service], as opposed to the plaintiff’s brand for that [product] [service]. Generic names are part of our common language that we need to identify all such similar [products] [services]. A generic name is a name for the [product] [service] on which it appears.

If the primary significance of the alleged mark is to name the type of [product] [service] rather than the [manufacturer] [provider], 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] [service] rather than the [manufacturer] [provider], 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 to be 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 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 appropriate 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 mark, collective mark, etc., in lieu of the word trademark in this instruction. In the first paragraph, this instruction refers to the court’s instruction to the jury that sets out the factors of the *Sleekcraft* test for likelihood of confusion, Instruction 15.18 (Infringement—Likelihood of Confusion—Factors—*Sleekcraft* Test). The number that the court assigned to that instruction should be inserted in the first paragraph of this instruction. Similarly, in the fourth and in the last paragraph of the instruction, reference is made to an instruction concerning secondary meaning, e.g., Instruction 15.11. In the next to the last paragraph of this instruction, reference is made to an instruction concerning the elements of infringement, e.g., Instruction 15.6 (Infringement— Elements and Burden of Proof—Trademark).

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; usethis 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.”); *Surfvivor Media, Inc. v. Survivor* Productions, 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”), *judgment vacated on other grounds*, 543 U.S. 111 (2004); *U.S. Patent and Trademark Office v. Booking.com B.V.,* 140 S. Ct. 2298, 2308 (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 Company*, 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 America Inc*., 287 F.3d 866, 873–74 (9th Cir. 2002) (noting that descriptive trade name not protectable unless owner shows it acquired secondary meaning, and applying strength of mark analysis to tradename).

Traditionally, the Ninth Circuit has found 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. America 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 (9th Cir. 2002)] at 1142 n.3. 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. v. Lasting Impression I, Inc*., 328 F.3d 1061, 1071 (9th Cir. 2003) (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), *judgment vacated on other grounds*, 543 U.S. 111 (2004).

*Supplemental Instructions*

**Trade Dress Adjustments**

In trade dress cases, the Supreme Court suggested the appropriateness of the arbitrary - suggestive- descriptive - generic spectrum for word trademarks, as used in this instruction. *See Wal-Mart Stores, Inc., v. Samara Brothers, Inc.*, 529 U.S. 205, 212-13 (2000). Such a test might be appropriate for trade dress that is product packaging as well. The same is not true for trade dress that consists of product design or configuration. The court indicated that application of such a spectrum is “problematic” if not erroneous. *Id.*

Accordingly, if a case involves aspects of a product that is physically and functionally inseparable from the product as a whole, that is, consists of a product design or configuration, no instruction on inherent distinctiveness is appropriate. Rather, the jury should be instructed on secondary meaning. *See Wal-Mart Stores,* 529 U.S. at 212-13. Similarly, if the court faces a trade dress case in which it was ambiguous whether the dispute involves product packaging or product design, the court should require a showing of secondary meaning. *Wal-Mart Stores,* 529 U.S. at 215 (“[C]ourts should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning.”) *See* Instruction 15.11 (Infringement—Elements—Validity—Distinctiveness—Secondary Meaning).

In cases involving product packaging, the differences between use of a word as opposed to use of various symbols or devices will probably require modification of this spectrum of marks instruction (Instruction 15.9). In lieu of modifying the spectrum of mark instruction, the court might consider the propriety of giving an instruction using the test in *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 1344-46 (C.C.P.A. 1977). While the Ninth Circuit has not specifically addressed use of *Seabrook*, it has generally suggested that inherently distinctive trade dress involves the overall impression that is arbitrary or uncommon.

The Ninth Circuit has required, without delineating specific factors that should be considered, that an inherently distinctive symbol or device identify the particular source of the product and distinguish it from other products. *See International Jensen, Inc. v. Metrosound U.S.A., Inc*., 4 F.3d 819, 824 (9th Cir. 1993); *Fuddruckers, Inc. v. Doc’s B.R. Others, Inc*., 826 F.2d 837, 844 (9th Cir. 1987) (involving restaurant design). Some district courts have suggested the *Seabrook* test may be appropriate for certain types of trade dress. *See, e.g., Continental Laboratory Products, Inc. v. Medax International, Inc*., 114 F. Supp.2d 992, 999 n. 6 (S.D. Cal. 2000).

This instruction can be modified for trade dress cases involving packaging or other non-word symbols or designs 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. After the first four paragraphs and before the paragraph under the heading “Spectrum of Marks,” 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.

The various paragraphs under the heading “Spectrum of Marks” will need to be adjusted so that they describe the arbitrary, suggestive, descriptive or generic use of a symbol or device, rather than of a word. For instance, if an example of apple-flavored candy were the product, the modification involving the trade dress for that product would indicate that the trade dress would be:

**Generic,** if sold in red, plastic wrappers so that they looked like small round balls. Because they share a shape and color that many other candies have, the maker of the round apple flavored candy would not be able to get trade dress protection for this packaging. The red plastic wrapping on the small, round candy does not distinctively indicate any particular maker of candy, whatever its flavor.

**Descriptive**, if the producer sold the candy in a small plastic apple-shaped container. The packaging describes a characteristic of the product - it tastes like apple. This trade dress can only be protected if it acquires secondary meaning (e.g., while it does not “immediately” indicate the source of the candy, with time there may be proof that the small plastic apple container became known to children as the product of this particular maker of this apple flavored candy).

**Suggestive**, if the producer were to sell the candy in a box shaped like a school text book. The text book appearance of the box connotes a characteristic of the product, allowing the consumer to infer something about the product from the trade dress. Here, the book packaging suggesting the idea of children bringing an apple to school to share with their favorite teacher, and that perhaps they can bring the candy in lieu of the apple. This can suggest to the consumer that the candies have an apple flavor.

**Arbitrary,** if the candy were sold in a box shaped like a television, with a screen in which you could see the small, apple flavored candy. It would also be arbitrary if packaged in a container of some fanciful, new and previously unknown shape. It is totally unrelated to the apple flavored candy, whether using the shape of the television that has no relation to an apple flavored candy, or fanciful, previously unknown shape.

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