TRADEMARKS AND DECEPTIVE PRACTICES
Mid-Semester Quiz—February 23, 1999
Professor Susan M. Richey

INSTRUCTIONS:

The quiz is open-book and you may take any written material that you wish into the exam with you. **Do not work with any of your classmates during the quiz.** All statutory references are to the Lanham Act unless otherwise indicated.

Use the Scantron answer sheet provided and select the **single best answer** for each question. Clearly mark your choice on the Scantron answer sheet. Be certain to follow the proctor's instructions for filling out the Scantron answer sheet; misplaced marks may be read by the scanning machine as incorrect answers. **Place your exam number on the Scantron sheet.**

You have one hour to complete the quiz unless otherwise instructed by the proctor. You may earn a total of 30 points on this quiz—the quiz contains 15 questions worth 2 points each, so pace yourself accordingly.

1. (2 pts.) What issue, left open by its decision in *Two Pesos, Inc. v. Taco Cabana Int'l, Inc.*, did the United States Supreme Court indicate it would resolve when it granted certiorari in *Samara Bros., Inc. v. Wal-Mart Stores*?

(a) the appropriate test for inherent distinctiveness of trade dress in a line of products

(b) the types of evidence admissible to prove acquired distinctiveness of trade dress

(c) whether or not trade dress consists of the "overall look" of a product

(d) whether or not the owner of inherently distinctive trade dress must nevertheless prove secondary meaning to establish valid trade dress

(e) whether or not valid trade dress may consist of a single color

2. (2 pts.) What survey did the Trademark Law Clarification Act of 1984 implicitly invalidate as a means to measure genericness?

(a) the Thermos survey

(b) the Teflon survey

(c) the purchaser motivation survey

(d) the mall intercept survey

(e) the telephone survey

3. (2 pts.) De facto secondary meaning:

(a) renders functional trade dress protectible under the trademark laws.

(b) converts a generic term into a protectible trademark.

(c) arises when a descriptive mark becomes recognized by a substantial segment of the consuming public as an indicator of commercial origin.

(d) all of the above.

(e) none of the above.

Fact Pattern for Questions 4, 5, and 6

In 1902, Konrad Birkenstock designed a contoured insole, molded to the shape of the human foot, to be used by shoemakers in the production of custom footwear and inserted in the factory-made, flat-soled shoes that had become widely distributed in Germany at that time. In 1964, the contoured footbed was incorporated into a sandal by Konrad's grandson, Karl Birkenstock, and "Birkenstock Sandals" rose to popularity in many countries, including the United States where the sandals are distributed through an exclusive distributor, Birkenstock USA. Birkenstock USA owns all domestic trademark rights associated with the sandals it distributes.



Representation of a Birkenstock sandal



Logo of Birkenstock USA

"Think of Birkenstock sandals as a performance shoe, orthopedically designed and constructed to offer comfort and support that other shoes just can't match. They look wider than most shoes because the design follows the natural shape of the foot. Many shoe styles feature a narrow toe area, which not only compresses the toes, but throws the foot out of alignment. The shape of Birkenstock sandals guides the toes and feet into correct alignment so the weight is evenly distributed and good posture is possible."

Advertisement for Birkenstock Sandals

4. (2 pts.) If Birkenstock USA sues for infringement of the mark "Birkenstock" as applied to sandals, the court will likely categorize the mark as:

(a) fanciful

(b) arbitrary

(c) suggestive

(d) descriptive

(e) functional

5. (2 pts.) Assume that Birkenstock USA has decided to adopt the suggestive logo shown above for use in conjunction with the sale of sandals. Assume further that the company mails a drawing of the logo to an independent retailer located across state lines to obtain the retailer's opinion as to the potential market response to the logo. If Birkenstock USA adopts the logo shortly thereafter and affixes it to all sandals distributed nationwide, will the company be able to rely on the date of the earlier mailing to establish priority in its use of the logo?

(a) Yes, because the mailing took place in interstate commerce.

(b) No, because the mailing did not involve transfer of the trademarked goods in interstate commerce.

(c) Yes, because the mailing was part of an arm's length transaction.

(d) No, because the logo is not inherently distinctive and, therefore, priority cannot be claimed until secondary meaning has been built up in the logo.

(e) Yes, because the company ultimately adopted the logo as a trademark.

6. (2 pts.) The advertisement quoted above might be used to support what defense to an action by Birkenstock USA for infringement of the configuration of its sandal?

(a) lack of inherent distinctiveness

(b) abandonment

(c) functionality

(d) lack of commercial viability because the shape is ugly

(e) none of the above

7. (2 pts.) Hormel Foods coined the term "Spam" for luncheon meat in the 1930s when it began marketing a canned meat product made primarily of spiced ham that it called "Spam."



Representation of Hormel's Spam luncheon meat

Should Hormel Foods be concerned that strong colloquial use of the term "spam" to mean unsolicited e-mail messages will cause its mark "Spam" to cease designating source and become generic? In answering this question, do not consider whether Hormel Foods should be concerned about dilution of its mark "Spam."

(a) Yes, because the referenced colloquial usage is widespread and probably encompasses a majority of the consuming public.

(b) Yes, because the term is being used colloquially as a noun.

(c) No, because the law imposes no duty on trademark owners to police the public's popular usage of their marks.

(d) No, because unsolicited e-mail is not a food product.

(e) None of the above.

Fact Pattern for Questions 8, 9, and 10



The original Slinky toy

Slinky Dog from Disney's movie, *Toy Story 2*



The Slinky toy was invented in 1943 by mechanical engineer, Richard James, while he was trying to develop a tension spring that would steady sensitive ship-board instruments at sea. Mr. James knocked some of these experimental springs off a shelf, and was amused by the way they "walked" down, end over end, rather than just falling. When their children became fascinated with the spring's movement, Mr. and Mrs. James decided to market the spring as a toy under the name "Slinky," a Swedish word meaning stealthy, sleek and sinuous. In 1947, Richard James received a now-expired utility patent on the toy—the spiral structure of the toy, although prior art, was recited in the claims. Since that time, over a quarter billion Slinky toys have been sold worldwide, and Mrs. James continues to head James Industries, which owns the "Slinky" trademark.

8. (2 pts.) The holding in which of the following cases indicates that a court likely would not protect the spiral configuration of the "Slinky" toy as valid trade dress:

(a) *Dogloo, Inc. v. Doskocil Mfg. Co.*, 893 F.Supp. 911 (C.D.Cal. 1995)

(b) *Vornado Air Circulation Sys. v. Duracraft Corp.*, 58 F.3d 1498 (10th Cir. 1995)

(c) *Thomas & Betts Corp. v. Panduit Corp.*, 138 F.3d 277 (7th Cir. 1998)

(d) *In re Mogen David Wine Corp.*, 328 F.2d 925 (C.C.P.A. 1964)

(e) *Qualitex Co. v. Jacobson Products, Co.*, 514 U.S. 159 (1995)

9. (2 pts.) The court's holding in the case that correctly answers Question No. 8 is based on considerations of:

(a) the core goals of the utility patent system

(b) the core goals of the design patent system

(c) aesthetic functionality

(d) utilitarian functionality

(e) none of the above

10. (2 pts.) James Industries recently licensed use of the mark "Slinky" to Walt Disney Co. which used the mark as the name of a character, Slinky Dog, in its 1999 movie, *Toy Story 2*. Walt Disney Co. conducted a merchandising program in conjunction with the movie's release, involving the sale of small poseable figures of the film's characters, including Slinky Dog, complete with a small Slinky toy as the dog's body . Assume that James Industries manufactured all of the poseable Slinky Dog figures sold by Disney and that the agreement between James Industries and Walt Disney Co. for licensing of the "Slinky" mark made no mention of quality control with respect to such manufacture. Lack of written quality control provisions governing manufacture of the poseable Slinky Dog figures:

(a) is an example of abandonment

(b) is an example of acquiescence

(c) is an example of an assignment in gross

(d) is an example of naked licensing

(e) none of the above

11. (2 pts.) In the late 1970s, the owners of the New Orleans Jazz, a National Basketball Association (NBA) team, moved their team to Utah where it became known as the Utah Jazz.

Before the move



After the move



Around the NBA, news of the move was met with raised eyebrows and predictable jokes about taking a team, named for the famed jazz music in New Orleans, into the relatively staid atmosphere of Salt Lake City, Utah. Since the move, only the name "Utah Jazz" has been used by the team to advertise its sports entertainment services. Assume that the team must defend itself in infringement litigation from a charge of trademark abandonment due to its long nonuse of the name "New Orleans Jazz." What is the probable result if the court follows the logic of Judge Posner, who wrote the 7th Circuit's opinion in *Indianapolis Colts, Inc. v. Metropolitan Baltimore Football Club Ltd. Partnership*?

(a) Abandonment, because more than 3 years of nonuse of the name "New Orleans Jazz" has elapsed.

(b) Abandonment, because an intent to abandon may be inferred from over 20 years of nonuse of the name "New Orleans Jazz."

(c) Abandonment, because "New Orleans" is more than a geographic designation or appendage to the word "Jazz"; "New Orleans Jazz" is a non-transportable cultural institution that has been abandoned.

(d) No abandonment, because the team was moved intact and, therefore, there has been no interruption in the association between the mark "Jazz" and the goodwill it represents.

(e) No abandonment, because the name of a basketball team cannot act as a trademark in the first place.

12. (2 pts.) Use of a trademark in a remote trade area by an entity that was unaware of another entity's earlier and continuous use of the same mark on the same goods is an example of an intervening junior user, if what event occurs next in time?

(a) The senior user announces plans to expand into the junior user's market.

(b) The senior user obtains a federal trademark registration for the mark in issue.

(c) The senior user obtains a state trademark registration for the mark in issue.

(d) The junior user obtains a state trademark registration for the mark in issue.

(d) The junior user obtains a federal trademark registration for the mark in issue.

13. (2 pts.) In trademark parlance, "constructive use" refers to:

(a) bona fide use of a mark in advertising and promotion of goods or services within a commercially reasonable period of time ***prior to*** actual sale of the goods or actual rendition of the services in question.

(b) affixation of a mark on goods that are then placed into interstate commerce or advertising of services that are available at the time of advertising.

(c) filing of an intent-to-use application that matures into a federal trademark registration.

(d) filing of an intent-to-use application that matures into a state trademark registration.

(e) affixation of a mark on goods that already carry a different trademark, for purposes of reserving the mark that was added.

14. (2 pts.) In *Qualitex Co. v. Jacobson Products Co.* the Supreme Court holds that a single color may be protected as valid trade dress. In that opinion, Justice Breyer indicates that what type of evidence would always be required of a plaintiff in an infringement action involving a single color as the asserted trade dress?

(a) evidence that "shade confusion" has not occurred among the consuming public.

(b) evidence that no other single color was available.

(c) evidence that no combination of colors was available.

(d) evidence that no combination of color and logo was available.

(e) evidence that the single color in issue had acquired secondary meaning.

15. (2 pts.) One of the hottest new musical groups on the scene today is a trio of howling dogs, known as *The Dawgs,* who are able to mimic the melodies from numerous country music songs at the top of the charts. Each of the dogs, Manny, Moe, and Jack, shown below, has a different owner, but the group as a whole is managed by Jack Titus. Mr. Titus is a dog trainer of many years' experience who recruited Manny, Moe, and Jack after extensive auditions. Mr. Titus has trained Manny, Moe, and Jack to perform certain movements on stage while they howl, and he elicits howls of a certain tonal quality with a doggie treat reward system. In addition, Mr. Titus chooses the songs that the group records and he books each concert tour undertaken by the group. After an argument with the dogs' respective owners, Mr. Titus decides to reconstitute the band with new dogs and seeks a judicial declaration that he alone is the owner of the service mark "*The Dawgs.*" The court probably will:

Publicity shot of members of the original band, *The Dawgs*



(a) rule for Mr. Titus because he controlled the quality of the performances and it is not likely that the public associates the mark with the personalities of Manny, Moe and Jack.

(b) rule for the dogs' owners because they control the quality of the performances and the public likely associates the mark with the personalities of Manny, Moe and Jack.

(c) rule for the dogs' owners because they own the dogs and, therefore, own the mark under which they perform.

(d) rule for Mr. Titus because case law indicates that the managers of musical groups usually win these types of lawsuits.

(e) none of the above.