

**IM 450-01**  
**Intellectual Property Law and New Media**  
**Fall 2022**  
**September 29, 2022**  
**Class 11**

**Trademark Cases**  
**And “A Day in the Life of a Trademark Lawyer”**

# Kevin Mikolajczak: U.S. Trademark Application Serial No. 90691425 - BELLEVUE LIGHTING - N/A

- BU IM Graduate 2018
- ex-Microsoft, ex-Salesforce
- Currently a UX consultant and owner of a lighting design firm
- <https://bellevue.lighting/>
- Kevin's trademark action started with a domain registration request that prompted the registry to ask if Kevin had a trademark on "Bellevue Lighting." He did not have that trademark, so he applied for one.
- His application was denied.
- Why was it denied?
- What might he do about it?

**A USPTO examining attorney has reviewed your trademark application and issued an Office action. You must respond to this Office action in order to avoid your application abandoning. Follow the steps below.**

**(1) Read the Office action [HERE](#). This email is NOT the Office action.**

The USPTO must receive applicant's response to this letter within six months of the issue date below or the application will be abandoned. Respond using the Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office action.

Issue date: February 24, 2022

### Introduction

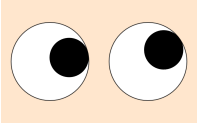
The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

### Summary of Issues

- Search Results – No Conflicting Marks Found
- **Section 2(e)(2) - Geographically Descriptive Refusal**
- **Specimen Does Not Show Use of the Mark in Commerce**
- **Descriptive Wording – Disclaimer Required**

# What might he do?

- Kevin writes: “I think I decided to just register the BL square icon and see where that goes. Don't really need anything else”
- I suggested (something like) the following:

**BELLEV  LIGHTING**

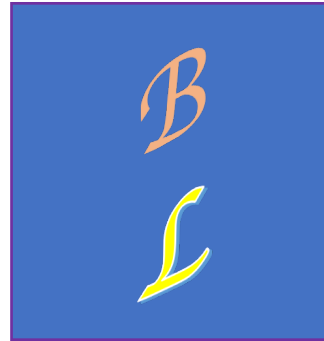
or

 **VU LIGHTING**

Those solve the “descriptive place” problem AND the generic aspect of that in the denial.

# Kevin Re-applied/answered in two ways

1. He submitted a graphic logo (that's on his trucks) instead of the word mark (BL in a box)



2. His lawyer “answered” the complaints on the service/word mark. In May. He’s waiting.

[https://tsdr.uspto.gov/#caseNumber=90691425&caseSearchType=US APPLICATION&caseType=DEFAULT&searchType=documentSearch](https://tsdr.uspto.gov/#caseNumber=90691425&caseSearchType=US_APPLICATION&caseType=DEFAULT&searchType=documentSearch)>

3. I don’t think he’ll get it. I doubt they will let him lock down the place name (he can use it but can’t keep others from it) and he’ll have to sign a waiver that says he won’t sue anyone who uses the generic (lighting).

# Some fine points in trademark law, illustrated by

## **Traditional cases:**

- ***Polaroid Corp. v. Polarad Electronics, Corp.*, 287 F.2d 492 (2<sup>nd</sup> Cir. 1961).**
  - Established the *basic 8-part test for likelihood of confusion*
- ***Zazu Designs v. L'Oreal*, 979 F.2d 499 (7<sup>th</sup> Cir. 1992).**
  - Sets “*use in commerce*” standards.
- ***Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).**
  - Distinctive trade dress as grounds for trademark infringements.
- ***Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205 (2000).**
  - Trade dress protection . . . if it's design? (or color)?
  - Not unless the element develops secondary meaning in the market . . . in other words, a common design feature doesn't do it. UNTIL it becomes so ubiquitously associated with the product that it takes on secondary meaning....
- ***TrafFix Devices, Inc. v. Marketing Displays, Inc.* 532 U.S. 23 (2001).**
  - Product function is an issue for patents, not trademarks.

# Some fine points in trademark law, illustrated by **New media cases:**

- ***Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161 (C.D. Cal.**
  - “LAMOUREUX\_SUCKS\_AS\_A\_TEACHER.COM doesn’t infringe on Lamoureux’s trademarks.
  - There can be a fair use element in trademarks (for social commentary); parody of this sort isn’t confusing AND isn’t “in commerce” in the protected categories.
- ***Playboy Enters., Inc. v. Welles*, 279 F.3d 796 (9<sup>th</sup> Cir. 2002).**
  - There are legitimate uses of famous marks by people other than the mark owner. Nominative use might be ok (in meta-tags, words but not the logo, not in commerce).
  - However... gotta be careful here.... Welles had a legitimate use based on her prior involvement. This defense might have been less effective for someone who wasn’t as affiliated as she was. Also, meta-tags aren’t much in the picture any longer.
- ***March Madness Athletic Ass’n v. Netfire, Inc***
  - Is interesting for local flavor.
  - Btw: the IHSA subsequently sold these rights



- ***Tiffany (NJ) Inc. v. eBay Inc.*, 600 F.3d 93 (2<sup>nd</sup> Cir. 2010).**
  - Examining third party liability is really important . . . as there isn't a formal "trademark safe harbor" in laws relating to Internet commerce.
  - "the Court reasoned that liability can arise if a service provider (1) intentionally induces another to infringe a trademark, or (2) continues to supply its service to one who it knows or has reason to know is engaging in trademark infringement."
- Search terms--Use in commerce?
- **NOPE (and this is the predominant finding):**
- ***U-Haul Int'l, Inc. v. WhenU.com, Inc.*, 279 F. Supp. 2d 723 (E.D. Va. 2003).**
- ***1-800 Contacts, Inc. v. WhenU.Com, Inc.*, 414 F.3d 400 (2<sup>nd</sup> Cir. 2005).**
- **Use in commerce? maybe:**
- ***Rescuecom Corp. v. Google Inc.*, 562 F.3d 123 (2<sup>nd</sup> Cir. 2009).**
  - The court went a direction that Google does not want: Focused on GOOGLE'S USE (in THEIR commerce) – rather than on the searcher/advertiser/purchasers' use during the search.
- ***Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137 (9<sup>th</sup> Cir. 2011).**
  - At the trial level: the Google model IS confusing. On appeal, no it's not. The model holds, but there's a fissure in the wall.
- ***Rosetta Stone, Ltd. v. Google, Incorporated*, 676 F.3d 144 (4<sup>th</sup> Cir. 2012).**
  - The initial fissure in the wall shows some additional cracks: Google allows resellers into the auction. Rosetta Stone sues for contributory infringement when customers buy bogus RS stuff. Google wins at trial, but loses on appeal and quickly settles . . . the LAST thing they wanted was for this to go back to trial and to lose.

# **Trademark Checklists**

**A lawyer's perspective**

# Trademark Considerations:

- Rights acquired by using mark in commerce.
- First in time, first in right.
- Look before you leap.
- Assess likelihood of confusion.
- Registration is a powerful way to enhance rights.
- Police your mark. You snooze. You lose.
- Give and get trademark licenses.
- The big guys often win.

# **I just got a “cease and desist” letter, what now?**

- **What is a cease-and-desist letter?**
  - **A letter from a trademark owner or lawyer asking you to stop using a mark.**
  - **Not the same as a lawsuit, but it often comes before a lawsuit.**
  - **A lawyer’s letter does not have the same effect as an injunction from a court.**

# ***Saint Xavier University v. Mossuto,*** **1:20-cv-05206 (N.D. Ill)**

- **SXU owns and operates Twitter accounts relating to athletics:**
  - **SXUFootball**
  - **SXUSoftball**
  - **SXUSoccer**
  - **SXUVolleyball**
  - **SXUWBasketball**
- **SXUMensSoccer**
- **SXUMesVolleyball**
- **SXUBowling**
- **SXUCheer**
- **SXU\_MBB**
- **SXU\_Golv**

# ***Saint Xavier University v. Mossuto, 1:20-cv-05206 (N.D. Ill)***

- SXU Men's Baseball Coach, Mossuto, gets fired.
- Mossuto took sole possession of SXU Twitter account.



# ***Saint Xavier University v. Mossuto, 1:20-cv-05206 (N.D. Ill)***



**Saint Xavier University baseball**

@SXU\_Baseball

The Saint Xavier University baseball account

# ***Saint Xavier University v. Mossuto,*** **1:20-cv-05206 (N.D. Ill)**

- **SXU sues Mossuto for trademark infringement**
- **Mossuto files a motion for summary judgment**
- **Who wins?**



# ***Saint Xavier University v. Mossuto,*** **1:20-cv-05206 (N.D. Ill)**

- **Court rules in favor of Mossuto.**
- **Mossuto's use of SXU's trademark was not "commercial."**
- **He did not use the Twitter account for any monetary purpose.**
- **He used the Twitter account as a platform to criticize his termination from employment by SXU.**

# *The Ohio State University v. Redbubble* *[that's right: THE OSU!]*



Sell your art Login Signup

**REDBUBBLE** Search designs and products

Clothing Stickers Masks Phone Cases Wall Art Home & Living Kids & Babies Accessories Stationery Gifts Explore designs

**FIND YOUR THING**  
Unique products designed and sold by independent artists.

Shop Product Range

Shop Masks

Shop Stickers

Shop T-Shirts

**Weirdly meaningful art**  
Millions of designs on over 70 high quality products.

**Purchases pay artists**  
Money goes directly into a creative person's pocket.

**Socially responsible production**  
We're investing in programs to offset all carbon emissions.

# ***The Ohio State University v. Redbubble***

- OSU earns \$100 million each year from licensing merchandise
- Redbubble operates online marketplace with 600,000 independent artists who can upload images
  - Consumers can select images and place them on customized item
- OSU sues for trademark infringement
- Redbubble wins summary judgment in trial court – Redbubble did not use the OSU marks but was merely a “transactional intermediary”
- OSU appeals

# ***The Ohio State University v. Redbubble***

- **Sixth Circuit Court of Appeals reverses in favor of OSU.**
- **Redbubble is different from Amazon.**
- **Redbubble “used” OSU’s marks on products ordered on Redbubble’s website and was not a mere facilitator of sales (like Amazon).**
- **The products do not yet exist and come into existence only when ordered on the site.**
- **The products are delivered in Redbubble packaging with Redbubble tags.**
- **Why wasn’t Redbubble protected from third-party content by a safe harbor? Aren’t they just a web-services provider?**
- **OSU wins. (OSU always wins – ugh!)**

# **Coachella Music Festival v. Raashaun Casey a/k/a DJ Envy et al. 21-cv-17624 (New Jersey)**

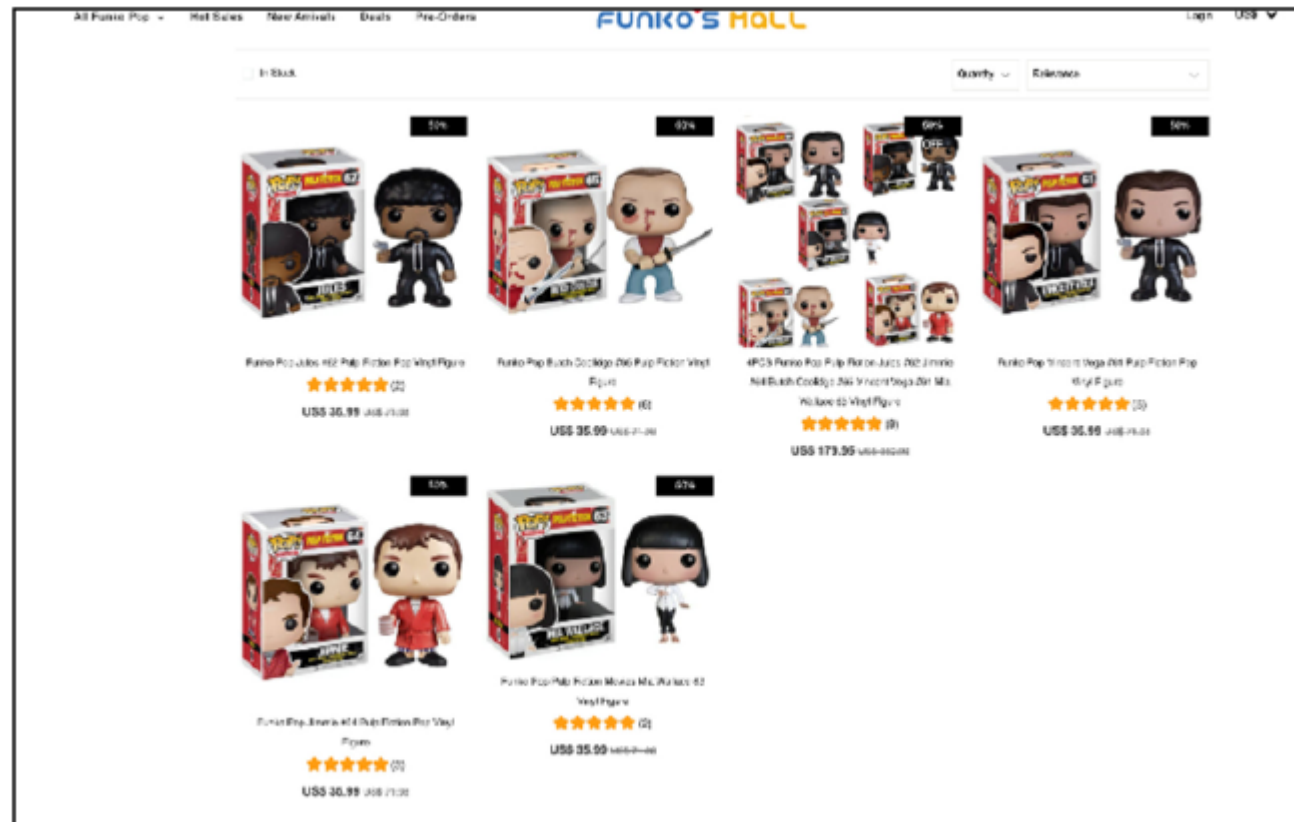
- **Coachella Music Festival:**
  - Annual music fest. in Southern Cal – attracts 750,000
  - owns 12 registrations for the mark COACHELLA
  - Cars are exhibited at Coachella
- **Defendants:**
  - Operate car-themed entertainment events named CARCHELLA
  - Feature celebrity guests whose cars will be exhibited, including musical artists
- **Claims:**
  - Trademark Infringement under federal and state law
- **Who should win?**

# ***Miramax, LLC v. Quentin Tarantino et al.,*** **Case No. 2:21-cv-08979 (C.D. Cal)**

- Tarantino directed the 1994 film *Pulp Fiction*.
- Miramax financed and produced the film.
- In 2021, Tarantino announced plans to auction off seven “exclusive scenes” from the film as NFTs.
- Miramax sues Tarantino for breach of contract, copyright infringement and trademark infringement.

# ***Miramax, LLC v. Quentin Tarantino et al., Case No. 2:21-cv-08979 (C.D. Cal)***

- Miramax alleges it continuously used the PULP FICTION mark in commerce on a wide variety of goods:



# ***Miramax, LLC v. Quentin Tarantino et al.,***

## **Case No. 2:21-cv-08979 (C.D. Cal)**

- Miramax owns U.S. Trademark Registration Number 5581017 on the mark PULP FICTION for:
- IC 009. G & S: Magnets.
- IC 014. G & S: Ornamental pins for clothing.
- IC 016. G & S: Calendars; Posters; Limited edition and non-limited edition framed and unframed posters.
- IC 018. G & S: Tote Bags; Wallets; Identification and business card holders and cases in the nature of wallets.
- IC 021. G & S: Cups and Mugs.
- IC 025. G & S: T-shirts; Sweatshirts; Hoodies; Constructed Apparel and fashion garments, namely, knit and woven tops, jackets; Blouses; Pants; Caps; Hats; Socks; Ties; Halloween and masquerade costumes; Costumes for use in children's dress up play.
- IC 028. G & S: Action figures and accessories therefor; Action figure toys; Bendable toys; Jigsaw puzzles, puzzles and puzzle games; Mechanical action toys; Mechanical Toys; Collectable toy figures; Modeled plastic toy figurines; Molded toy figures; Plastic character toys positionable toy figures; PVC toy figures; Rubber Character Toys; Toy action figures and accessories therefor; Toy figures; Toy motion picture prop replicas; Vinyl dolls.



***Miramax, LLC v. Quentin Tarantino et al.,***  
**Case No. 2:21-cv-08979 (C.D. Cal)**

- Who wins?
- Notice of Settlement filed 9-8-22.