

TRADEMARK LAW

FALL 2008/CRN 30494

Cardozo School of Law

Professor Justin Hughes

Take Home Examination

Introduction

This is a twenty-four (24) hour, take-home examination. You have 24 hours from the time you access this examination to submit the answers online.

Conditions and your professional commitments

Once you have received this examination, you may not discuss it with anyone prior to the end of the examination period. Nor may you discuss the examination at ANY time with any student in the class who has not taken it. Nor may you collaborate on the exam.

Professor Hughes permits you to use any and all inanimate resources. The only limitations on outside resources are those established by the law school for take home examinations.

By turning in your answers you certify that you did not gain advance knowledge of the contents of the examination, that the answers are entirely your own work, and that you complied with all relevant Cardozo School of Law rules. Violations of any of these requirements will lead to discipline by the Academic Standing Committee.

The Examination consists of two parts. Part I is a set of true/false questions. Part II consists of one essay problem with an 1,800 word limit. With the Part II essay, I take on no obligation to read beyond this 1,800 word limit. **The illustrations appear at the end of this document AND/OR in a separate document called x-08TM-Exhibits.doc.**

GOOD LUCK

Happy holidays to everyone, thanks for a fun class.

II. TRUE/FALSE QUESTIONS

(30 points)

This part of the exam is worth 30 points. Each answer is worth 1.5 points. There are 22 questions, so in the same spirit as the LSAT and other standardized tests, you can get 2 wrong and still get a maximum score on this section.

Since this exam is being administered online, please provide your answers to this section as a single column series, numbered 1 to 17, with “T” or “F” beside each number.

If you are concerned about a question being unclear, you may write a note at the end, but only do so if you believe that there is a fundamental ambiguity in the question.

SOME GENERAL QUESTIONS

TRUE FALSE

___ ___ 01.

In a situation in which customers may be initially confused as to the source of the goods or service, but are NOT confused at the time the customers complete the transaction (purchase the goods or service), any actionable claim for trademark infringement must be characterized as “reverse confusion.”

___ ___ 02.

According to *Eastman Kodak v. Bell & Howell Document Management Products* (1993), with an intent-to-use application, all questions of mere descriptiveness must be resolved before the USPTO issues any “notice of allowance.”

___ ___ 03.

The courts in *Bayer Co. v. United Drug Co.* (1921) and *Kellogg Co. v. Nabisco* (1938) concluded that the claimed names in question – “aspirin” and “shredded wheat” – had become the product names generally known by the public and, therefore, had become “generic.”

TIME AND TIDE WAIT FOR NO MAN

One of Proctor & Gamble's most successful products is TIDE brand detergent. Exhibit A shows the TIDE product with minor variations in its packaging. Investigators for Proctor & Gamble (P&G) have found that a small chain of discount stores called "El Cheapo Markets" is marketing a detergent called TIME. Exhibit B shows this product as it appears on the shelves of El Cheapo Markets. El Cheapo Markets do not sell P&G's TIDE detergent, although they do sell another of P&G's detergent products, CHEER.

In addition to its stores in New York, Cheapo has a website where it offers to sell and ship all its products throughout the US, including offering its TIME detergent on the "household products" page of the www.elcheapostore.com website.

TRUE FALSE

- ___ ___ 04. Under the doctrine announced in *TrafFix Devices v. Marketing Displays, Inc.* (2001), the fact that Proctor & Gamble has several expired utility patents for the chemical formula for TIDE detergent will not bar trademark protection of the TIDE trade dress.
- ___ ___ 05. In its likelihood of confusion analysis, a court will likely consider detergent to be an "impulse purchase."
- ___ ___ 06. Under Justice Scalia's analysis of product design trade dress in *Wal-Mart Stores v. Samara Brothers* (2000), Proctor & Gamble will not be able to argue that the TIDE bottle is inherently distinctive.
- ___ ___ 07. If El Cheapo's website uses metatags that say <TIDE TIDE TIDE TIDE TIDE CHEER CHEER CHEER>, all those metatags will be permissible under the nominative fair use analysis in *Playboy Enterprises, Inc. v. Welles* (2002).
- ___ ___ 08. Under the principle stated in *Qualitex* (1995) and reiterated in *TrafFix Devices v. Marketing Displays* (2001), a product feature cannot be protected trade

dress if its exclusive use by one party would “put competitors at a *significant* non-reputation-related disadvantage”

FINNISH GEISHAS

Fazer, a Finnish chocolate company, has begun importing some of its candy bars to the United States. One of their first imports is GEISHA. The product is shown in Exhibit C. Fazer has filed a “use in commerce” application for registration of the GEISHA trademark at the USPTO, stating that the date of their first use in commerce was June 1, 2008.

Of course, “geisha” is a word from Japanese. Several online dictionaries define “geisha” as “[o]ne of a class of professional women in Japan trained from girlhood in conversation, dancing, and singing in order to entertain professional or social gatherings of men.” Wikipedia also notes “[t]here remains some confusion, even within Japan, about the nature of the geisha profession. Geisha are portrayed as prostitutes in much Western popular culture. However, geisha do not engage in paid sex with clients. Their purpose being to entertain their customer Geisha engagements may include flirting with men and playful innuendos; however, clients know that nothing more can be expected.”

The GEISHA candy bar is, according to the packaging, “milk chocolate with soft hazelnut filling.” Fazer has filed the application for US product class 046 which covers chocolate, candy, and ice cream.

TRUE FALSE

- | | |
|--------------------|--|
| <p>___ ___ 09.</p> | As a trademark for a “milk chocolate with soft hazelnut filling” product, GEISHA is almost certainly a descriptive trademark. |
| <p>___ ___ 10.</p> | If the USPTO trademark examiner establishes that as of now - December 2008 - Fazer has only imported five boxes of GEISHA chocolate bars (each box with 48 bars) this may very well be considered “token use” by the examiner. |
| <p>___ ___ 11.</p> | If a group of Japanese-American women oppose the GEISHA application under section 2(a) on the grounds that the trademark is disparaging and will |

bring them into contempt or disrepute, this group will probably have standing under the test described in *McDermott v. San Francisco Women's Motorcycle* (2006) and other cases we discussed in class.

- ___ ___ 12. If the Premium Spirits Company already has a registered trademark for GEISHA for “Alcoholic beverages namely sake” [US class 047] and has used the GEISHA trademark for sake since November 2004, Premium Spirits will very likely succeed in opposing Fazer’s application under section 2(d).
- ___ ___ 13. In considering the opposition filed by the group of Japanese-American women (#11 above), the USPTO will first have to determine the meaning of “geisha” in the context of how Fazer will use the mark in the marketplace in connection with its product.
- ___ ___ 14. On the question whether GEISHA disparages women, Japanese women, or Japanese-American women, if Fazer produces a convincing survey that shows that 51% of Japanese-American and 62% of Japanese women do NOT consider the term disparaging, Fazer will win.
- ___ ___ 15. If on June 1, 2008 Fazer had only imported five boxes of GEISHA chocolate bars [240 bars in total] and distributed those only to its five regional sales managers, this will still be a bona fide use in commerce under *Blue Bell, Inc. v. Farah Manufacturing Co.* (1975).

MORE GENERAL QUESTIONS . . .

- ___ ___ 16. In *Hormel Foods v. Jim Henson Productions* (1996), the Second Circuit reinterpreted its holding in

John Deere v. MTD Products, Inc. (1994) and embraced a “broad view of tarnishment” that includes a variety of negative associations, not just associating a trademark with “seamy conduct” or “sexual activity, obscenity, or illegal conduct.”

- ___ ___ 17. Disclaimers can be very useful for a successful nominative fair use defense because appropriate disclaimers help establish that the defendant did “nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.”
- ___ ___ 18. Recognizing that “use in commerce” includes “trade between subjects of the United States and subjects of a foreign nation” wherever it occurs, the court in *Buti v. Impresa Perosa* (1998) held that FASHION CAFÉ could be protected in the United States because of the large number of American fashion models who eat and drink at the “Fashion Café” in Milan, Italy.
- ___ ___ 19. Likelihood of confusion is not necessary for a court to find that a defendant’s activities dilute a famous trademark through either “blurring” or “tarnishment.”
- ___ ___ 20. In a section 2(e) determination whether a trademark is a surname, the USPTO will consider the structure and pronunciation of the word to determine whether it has the “look and sound” of a surname.
- ___ ___ 21. One of the key determinations in a “descriptive fair use” analysis is whether the defendant used no more of the trademark than necessary to refer to the trademarked product or service.
- ___ ___ 22. To be eligible for federal registration at the USPTO, a trademark must be used in “commerce which may lawfully be regulated by Congress.”

COMMENTS on FUNDAMENTAL AMBIGUITIES? Note them with your T-F answers!

II. Essay Question (70 points)

This year there is only ONE essay question. Please write an essay answer of no more than 1,800 words. This essay is worth 70 points of the 100 point exam.

Please make sure that you use 1.5 line or double line spacing and include a header or footer that has the page number **and the exam number** on each page. **At the end of the essay, please provide the essay's word count.**

IT'S MISTER SOFTEE TO YOU . . .

The head of the IP practice at your law firm, Mona L. Jaconde, needs you to prepare a memorandum analyzing a problem from one of the firm's clients, the Mister Softee Company. The following is the information that Mona obtained during her meeting this morning with Mister Softee's CEO, Luol Michael Deng.

Mister Softee is a company that operates (with its franchisees) trucks that sell ice cream cones, sundaes, and shakes in 15 northeastern states. The company was founded in 1956 in Philadelphia and is now the largest franchisor of soft ice cream in the United States with over 600 Mister Softee trucks selling ice cream at urban street corners during the spring, summer, and fall months. Mister Softee also has significant operations in Hong Kong SAR (since 1970) and China (since 2007).

Mister Softee has a very strong market presence in New York City. A 2006 survey by Jacob Jacoby established that Mister Softee's trucks, painted in their distinctive and well-known blue-and-white pattern, are instantly recognized by 67% of Manhattan residents and 59% of residents in the other NYC boroughs. The usual location of Mister Softee trucks in midtown Manhattan is at <http://www.mistersofteeny.com/locations.html>, but they are all over the city.

Mister Softee has several registered trademarks as follows:

#0667335 for MISTER SOFTEE in a script and with the “conehead” as shown in Exhibit D. This trademark has been registered in US class 019 for “ice cream trucks” since September 23, 1958.

#2128918 for MISTER SOFTEE in block letters for US classes 100-102 for “retail mobile vending services through the use of trucks featuring soft ice cream” since January 13, 1998.

#2906357 for the MISTER SOFTEE truck trade dress as shown in Exhibit E, also in US classes 100-102 since Septemeber 7, 2004. The USPTO registration describes the truck dress as follows:

“The color(s) BLUE AND WHITE is/are claimed as a feature of the mark. The mark consists of a blue horizontal stripe at the bottom of the white truck with blue wheels and includes the word mark Mister Softee and the design of an ice cream cone head. The mark also includes a sundae container with the Mister Softee word mark and milkshake container with the Mister Softee ice cream cone head included therein. The stippling indicates the color blue, which is a feature of the mark.”

Another picture of the classic Mister Softee truck design, which the company has used consistently since the 1960s, can be seen in Exhibit F. As part of this truck design/trade dress, Mister Softee has consistently used the same style of “menu” on the side of the trucks since the 1960s. That menu design can be seen in Exhibit F and, close up, in Exhibit G.

Recently, Mister Softee investigators have discovered a competitor on New York’s streets called “CAPTAIN SOFTEE.” These trucks also sell soft ice cream and use a blue-and-white color scheme. Investigators have learned that Captain Softee trucks are owned and operated from a warehouse in New Jersey by a subsidiary of El Cheapo Markets. Exhibit H shows five photos of the Captain Softee trucks taken by the investigators, including the Captain Softee logo, general trade dress, and menu. Assume that CAPTAIN SOFTEE has never been seen before in New York or other US cities before summer 2008.

Tomorrow – just 24 hours from now – Mona Jaconde has another meeting with Mr. Deng. Write a memorandum that tells her everything she needs to know about the claims the Mister Softee Company can bring against El Cheapo Markets and their “Captain Softee” trucks. Consider all possible

trademark rights, claims, and defenses. Remember that you have an 1,800 word limit for office memos. So keep it short . . . and sweet.

END OF WRITTEN EXAMINATION – EXHIBITS FOLLOW

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EXHIBIT A – TIDE from Proctor & Gamble



EXHIBIT B – TIME detergent from El Cheapo Markets



EXHIBIT C – FINNISH GEISHAS



EXHIBIT D – MISTER SOFTEE USPTO registration #0667335




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Word Mark	MISTER SOFTEE																					
Goods and Services	IC 012. US 019. G & S. ICE CREAM TRUCKS. FIRST USE: 19561005. FIRST USE IN COMMERCE: 19561005																					
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS																					
Design Search Code	02.01.01 - Busts of men facing forward; Heads of men facing forward; Men - heads, portraiture, or busts facing forward; Portraiture of men facing forward 02.01.34 - Monsters (not robots); Other grotesque including men formed by plants or objects 04.07.02 - Objects forming a person; Person formed by objects 08.09.01 - Ice cream, sherbet and frozen yogurt in cones; Sundae																					
Serial Number	72044034																					
Filing Date	January 15, 1958																					
Current Filing Basis	1A																					
Original Filing Basis	1A																					
Registration Number	0667335																					
Registration Date	September 23, 1958																					
Owner	(REGISTRANT) MISTER SOFTEE, INC. CORPORATION PENNSYLVANIA 3646 WALNUT STREET PHILADELPHIA PENNSYLVANIA (LAST LISTED OWNER) MISTER SOFTEE, INC. CORPORATION ASSIGNEE OF NEW																					
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EXHIBIT E – MISTER SOFTEE USPTO registration #2906357

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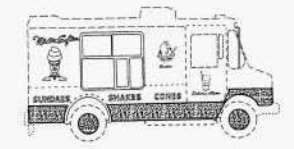
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Word Mark **MISTER SOFTEE SUNDAES SHAKES CONES DELICIOUS SHAKES**
Goods and Services IC 035. US 100 101 102. G & S: Retail mobile vending services through the use of trucks featuring soft ice cream. FIRST USE: 19561005. FIRST USE IN COMMERCE: 19561005
Mark Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code 18.05.07 - Campers (vehicles); Mobile homes; Motor homes; Recreational vehicles; Trailers
Serial Number 78257992
Filing Date June 4, 2003
Current Filing Basis 1A
Original Filing Basis 1A
Published for Opposition September 7, 2004
Registration Number 2906357
Registration Date November 30, 2004
Owner (REGISTRANT) Mister Softee, Inc. CORPORATION NEW JERSEY 901 Clements Bridge Road Rummecede NEW JERSEY 08078
Attorney of Record JEFFREY ZUCKER

<http://tess2.uspto.gov/bin/showfield?f=doc&state=9v9me3.2.1> 11/3/2008

EXHIBIT F – The MISTER SOFTEE truck in all its wonder



EXHIBIT F – MISTER SOFTEE menu, used since the 1960s



EXHIBIT H – CAPTAIN SOFTEE (five pictures from the investigators)







END OF EXHIBITS

END OF EXAMINATION/ Fall 2008