Index

ABANDONMENT OF RIGHTS	ABANDONMENT OF RIGHTS
Generally, 17:1 to 17:28	—Cont'd
Activity level, 17:14	Laches and delay, 17:17, 31:27
Application of tacking rules, 17:27	Licensing of mark, uncontrolled, 17:6
Assignments, 18:19	Limited territorial area, abandonment in
Automobiles, 17:15	17:22
Avoiding abandonment, changes in usage, 17:25	Loss of all rights, abandonment by, 17:0 to 17:8
Bona fide use, 17:9	Material alteration rule, 17:26
Cancellation proceedings, 20:57	Modernization of marks, 17:28
Cessation of business, temporary, 17:14	Nature of goods sold, change in, 17:24
Changes in usage	Non-use of mark, generally, 17:9 to
generally, 17:23 to 17:28	17:22
avoiding abandonment, 17:25	Objective evidence can outweigh self- serving testimony, 17:13
continuing commercial impression	Persisting recognition, 17:15
rule, 17:26	Presumption of abandonment after three
illustrative examples, 17:27	years, 17:18
modernization of marks, 17:28	Presumption of abandonment after three
nature of goods sold, change in, 17:24	years, burden to rebut, 17:21
priority, 17:25	Prima facie evidence, 17:21
products, change in use of mark to different, 17:23	Priority, changes in usage, 17:25
tacking-on older to newer version of	Procedural contexts, 17:4
mark, 17:25 to 17:28	Products, change in use of mark to dif-
updating marks, 17:28	ferent, 17:23
Clear and convincing evidence, 17:12	Rebutting inference, 17:11
Closed business, sale of, 17:14	Re-cyclying unused trademarks, 17:2
Continuing commercial impression rule, changes in usage, 17:26	Resumption of use after abandonment, 17:3
Continuing use, abandonment through	Sale of
nonuse, 17:9	closed business, 17:14
Corporate names, 17:14	mark, 17:14
Evidence, missing, 17:9	Stopping use, abandonment through
Federal law, 17:18 to 17:21	nonuse, 17:9
Federal registration, petition to revive abandoned application, 19:125.50	Tacking-on older to newer version, 17:25 to 17:28
GATT amendment, 17:19	Temporary suspension of use of mark due to outside causes, 17:16
Generic term, trademark becoming, 17:8	Trademark rights in others after
Good will, loss of, 17:14 "Indistinguishable" rule, 17:26	abandonment, 17:2
"Indistinguishable" rule, 17:26 Infringers, failure to prosecute, 17:17	Updating marks, 17:28
Intent, 17:9, 17:11, 17:13	ABBREVIATIONS
Intent, 17.5, 17.11, 17.13 Intent, old rule, 17:10	Generally, 7:18
Issue of fact, 17:5	Descriptive marks, 11:32
10000 01 1000, 17.0	Descriptive marks, 11.02

ACQUISITION AND PRIORITY OF

Generic terms, 12:37 RIGHTS—Cont'd Changes in usage, 17:25 Personal names as marks, 13:20 Common law **ABROAD** generally, 16:1 Infringement, extraterritorial reach of archaic rule, 16:22 the Lanham Act, 25:58 modern rule, 16:22.50 ABUSE OF PROCESS Constructive use Strength of marks, enforcement, 11:93 generally, 16:15 to 16:18.50 federal registration, 16:16, 16:18, ACCELERATED CASE 16:18.50 RESOLUTION PROCEDURE intent to use application, 16:16 (ACR) pre-existing common law rights, Inter partes proceedings, summary of federal registration does not cut trial procedure, 20:102 off, 16:18.50 **ACCOUNTING** statutory provisions, 16:15 Jury trial, 32:124 Displays associated with goods, use on, 16:30 to 16:32.30 Monetary Recovery (this index) Domain names, 16:7 **ACQUIESCENCE** Employee sales, 16:7 Generally, 31:41, 31:42 Evidence of priority Cancellation proceedings, failure to burden of proof, 16:20 object to use of mark, 20:74 to federal registration, 16:19 20:77 Federal **Consent** (this index) constructive use priority, 16:2 Defense distinct from laches, 31:41 registration Estoppel, 32:105 generally, 16:27 to 16:33 Inter partes proceedings, failure to advertising not a use, 16:29 object to use of mark, 20:32 to catalog uses, 16:32 20:38 constructive use, 16:16, 16:18.50 Types, 31:42 displays associated with goods, use ACOUISITION AND PRIORITY OF on, 16:30 to 16:32.30 RIGHTS evidence of priority, 16:19 Generally, **16:1** to **16:34** inherently distinctive marks, 16:8 Advertising not a use for federal Internet website use, 16:32.70 registration, 16:29 Lanham Act, affixation of Affixation of mark trademark, 16:23 generally, 16:22 to 16:23 methods of use, 16:28 common law, 16:22, 16:22.50 proper use on goods, 16:27 Lanham Act rule for registration, service marks, 16:33 16:23 television infomercial uses, Analogous use, 16:14 16:32.30 Assignments, 18:16.50, 18:18 trade show uses, 16:31 Assignment to acquire priority, **16:9.50** First use, inherently distinctive marks, Bad faith and add-on use, inherently 16:4 distinctive marks, 16:10 Idea for trademark, 16:11 Beta testing, 16:7 Inherently distinctive marks Bona fide transactions, inherently generally, 16:3 to 16:10.50 distinctive marks, 16:7 acquisition of ownership by priority Burden of proof of priority, 16:20 of use, 16:4 Catalog uses, federal registration, 16:32 bad faith and add-on use, 16:10

ABBREVIATIONS—Cont'd

ACQUISITION AND PRIORITY OF ACQUISITION AND PRIORITY OF RIGHTS—Cont'd RIGHTS—Cont'd Inherently distinctive marks—Cont'd Trade name, priority of use as, 9:2 bona fide transactions, 16:7 Trade show uses, federal registration, federal registration, 16:8 Traditional rule, preparing to do busifirst use, 16:4 ness not sufficient, 16:12 governance of ownership by priority United States vis-a-vis world priority, of use, 16:5 making and breaking chain of priority, Unlawful use, inherently distinctive 16:5 marks. 16:10.50 prior and continuous usage, 16:9 quantity and quality of use necessary Use, **16:1.50**, **16:18** World priority, 16:21 to achieve priority, 16:6 to 16:8 small scale transactions, 16:6 ACTIVITY unlawful use, 16:10.50 Level of, abandonment of rights, 17:14 Intent to use application, constructive use, 16:16 ACTUAL CONTROVERSY Internet website use, affixation—federal REQUIREMENT registration, 16:32.70 Declaratory judgments, 32:51 to 32:52 Inter partes proceedings, 20:17 **ADJECTIVES** Inventions, 16:11 Generic terms, adjective-noun debate, Lanham Act rule for registration, 16:23 12:10 Literary, artistic and entertainment rights, 10:4 ADMISSIONS, REQUESTS FOR Pre-existing common law rights, federal Inter partes proceedings, T.T.A.B. registration does not cut off, discovery, 20:109 16:18.50 **ADVERTISING** Preparatory steps, 16:12 Generally, 3:13 Preparing to do business, use of mark in, Acquisition and priority of rights, 16:12 to 16:14 federal registration, 16:29 Prior and continuous usage, inherently Ambush advertising, **27:66** distinctive marks, 16:9 Commercial advertising or promotion, Priority in secondary meaning, 16:34 27:95 Quantity and quality of use necessary to Copyrights (this index) achieve priority, inherently distinc-Cyberspace, Infringement in (this tive marks, 16:6 to 16:8 index) Registration, 16:1.50, 16:18 Disparagement law limited to Secondary meaning, 16:34 commercial advertising or promotion, Service marks, federal registration, 27:95 16:33 fact representation, not opinion, 27:96 Small scale transactions, inherently Fact representation, not opinion, 27:96 distinctive marks, 16:6 **False Advertising** (this index) SNOB precedent, 16:6 Federal registration, use of United States Statutory provisions, constructive use, flag prohibited, 19:79 16:15 Geographic terms, common law reme-Sufficient pre-sales activity, preparing to dies for false advertising, 14:24 do business, **16:13 Infringement** (this index) Teletrak, 16:13, 16:14 Injunctions, 30:6 Television infomercial uses, federal

registration, **16:32.30** Trademark maintenance, **16:6**

Insurance (this index)

Monetary recovery, 30:80 to 30:84

ADVERTISING—Cont'd

Periodicals, 10:6

Personal jurisdiction, long-arm statutes, 32:41

Registration, federal, acquisition and priority of rights, **16:29**

Territorial extent of rights, 26:17, 26:46

The sale of goods and services bearing an infringing mark is infringement, 25:27

ADVERTISING AGENCIES

Ownership of trademarks, 16:39

AESTHETIC FUNCTIONALITY

Functionality (this index)

AFFILIATION

Related goods or services, likelihood of confusion as to affiliation, **24:6**, **24:7**

AFFIRMATIVE DEFENSE

Classic fair use. 11:49

Freedom of speech, 31:153, 31:156.50

AFFIXATION OF MARK

Acquisition and Priority of Rights (this index)

AGENCY

Advertising agencies, ownership of trademarks, **16:39**

Franchises, tort liability, 18:75

AGGRESSIVE USE OR ENFORCEMENT OF TRADEMARKS

Monopolies and Restraints of Trade (this index)

AGRICULTURAL FOOD DISPARAGEMENT STATUTES

Trade libel and product disparagement, 27:112.10

AMBUSH ADVERTISING

Generally, 27:66

AMENDMENTS

Federal Registration (this index)

AMOUNT IN CONTROVERSY

Federal diversity jurisdiction, **32:34**

ANALOGOUS USE

Acquisition and priority of rights, 16:14

ANCILLARY FEDERAL JURISDICTION

Generally, 32:30

ANCILLARY SERVICES

Service marks, 19:89

ANTI-COUNTERFEITING TRADE AGREEMENT (ACTA)

Generally, 29:33.50

ANTI-CYBERSQUATTING ACTS

Anti-Cybersquatting Protection Act (ACPA), **25A:48 to 25A:69**

California Anti-Cybersquatting Act, **25A:84**

Hawaii Anti-Cybersquatting law, **25A:86**

Louisiana Anti-Cybersquatting law, **25A:86**

New York Anti-Cybersquatting Act, 25A:85

ANTI-DILUTION LAWS

Generally. **Dilution of Trademarks** (this index)

ANTI-TRUST LAWS

Unfair competition, 1:20, 1:21

APPAREL

Generally, 7:103

Design or appearance of wearing apparel, 7:103

Trademark or trade dress, 7:103

APPEAL AND REVIEW

Generally, 21:1 to 21:25

Attorney fees, 30:105

Civil action, review by, 21:20

Counterfeiting, preliminary injunctions, 30:41

Court of Appeals for Federal Circuit (this index)

Cyberspace, infringement in, ICANN
Uniform Dispute Resolution Policy
(UDRP), 25A:37

De novo trial, 21:21

Director of Patents and Trademarks (this index)

District Court, appeal to, generally, 21:20 to 21:25

Election of forum, 21:20

Ex parte appeal, 19:127

APPEAL AND REVIEW—Cont'd

Geographic terms, deceptive usage, three part test, **14:32.50**

Inter partes proceedings, 20:100, 20:106, 21:24

Judicial power, 21:23

Jury trial, 32:133

Kappos precedent, standard of review, 21:21, 21:22

Likelihood of confusion, questions of law or fact, 23:68 to 23:75

Preliminary injunctions, 30:56

Procedure on appeal, 21:2

Standard of review, 21:22

Trademark Trial and Appeal Board (this index)

APPLICATIONS

Federal Registration (this index)

APPORTIONMENT

Monetary recovery, 30:65

ARBITRARY MARKS

Generally, 11:11 to 11:14

Common word fallacy, 11:12

Descriptive marks, distinguished, 11:60

Examples of arbitrary marks, 11:13

Strength of marks, 11:14

Suggestive marks, compared, 11:12

ARBITRATION

Generally, 32:197 to 32:200

Availability of arbitration, 32:197

International disputes, 32:200

Literary, artistic and entertainment rights, **10:37**

Motion picture titles, 10:37

Patent and antitrust arbitration, distinguished, 32:198

Scope, 32:199

ARTISTIC RIGHTS

Literary, Artistic and Entertainment Rights (this index)

ASSERTIVE ENFORCEMENT

Strength of marks, 11:93

ASSIGNMENTS

Generally, 18:1 to 18:37

Abandonment of rights, 17:6, 18:19

Anti-assignment in gross rule generally, **18:1 to 18:13**

ASSIGNMENTS—Cont'd

Anti-assignment in gross rule—Cont'd continuity, break in, **18:3**

contract as assignment, license or

ntract as assignment, license or consent, **18:5**

establishment of business, assignment prior to, **18:6**

evidence of existence of assignment,

federal assignment and recordation law, **18:11 to 18:13**

good will, trademark cannot be assigned apart from, **18:2**

history and critique of rule, **18:10**

intent to use applications, assignment of, **18:13**

license-back, assignment and, 18:9 other documents, federal recordation, 18:12

reservation of rights in assignor, **18:8** security interests in trademarks, **18:7**

Assignments for benefit of creditors, 18:28 to 18:31

Automatic updating of ownership of applications and registrations, 18:11.50

Bankruptcy, assignment in, 18:28 to 18:31

Business in bankruptcy, sale, 18:29

Consent, contract as, 18:5

Continuity

break in, 18:3

tangible assets, 18:24

Contract as assignment, license or consent, **18:5**

Critique of anti-assignment in gross rule, **18:10**

Distinct and separate portion of business, mark assignment with, **18:21**, **18:22**

Effect of assignments, 18:15 to 18:20

Establishment of business, assignment prior to, **18:6**

Estoppel, 18:16, 32:108

Evidence of existence of assignment, **18:4**

Federal assignment and recordation law, 18:11 to 18:13

Good will, trademark cannot be assigned apart from, **18:2**

Haymaker precedent, 18:7

ASSIGNMENTS—Cont'd

History of anti-assignment in gross rule, **18:10**

Implied assignment in sale of business, **18:37**

Incontestability, 18:15

Infringement case against bankrupt company, **18:64.50**

Insolvency, assignment in, **18:28 to 18:31**

Intent to use applications, assignment of, 18:13

Invalid assignments, effect of, **18:17 to 18:20**

License, contract as, 18:5

License-back, assignment and, 18:9

Literary titles, 18:36

Nature of goods sold by assignee, significant change in, **18:27**

Ownership of applications and registrations, automatic updating of, **18:11.50**

Personal name marks

generally, 18:32 to 18:35

bankruptcy, sale, 18:31

non-contracting parties, use by, **18:34** personal skill, name as symbolizing, **18:35**

post sale use of name by assignor, **18:33**

Priority

assignment to acquire, **16:9.50**, **18:16.50**

use vis-a-vis third parties after invalid assignment, **18:18**

Reservation of rights in assignor, 18:8

Rights of licensee if licensor declares bankruptcy, **18:64**

Security interests in trademarks, 18:7

Service marks, sale of tangible assets as symbolic of transfer of good will, 18:25

Significant change in nature of goods sold by assignee, **18:27**

Succession to rights of assignor, **18:15**Tangible assets, sale as symbolic of

transfer of good will, **18:23 to 18:26**

Trademark in bankruptcy, sale, **18:28** U.S. government seizure, **18:20.50**

ASSIGNMENTS—Cont'd

Valid assignments, effect of, **18:15 to 18:16.50**

ASSIGNMENTS FOR BENEFIT OF CREDITORS

Generally, 18:28 to 18:31

ATTORNEY FEES

Generally, 30:98 to 30:107

Appellate review, 30:105

Apportionment among claims, 30:103

Court costs, 30:107

Cyberspace, infringement in, Anti-Cybersquatting Consumer Protection Act (ACPA), **25A:67**

Exceptional cases, 30:99 to 30:105

False advertising, 30:104

Federal law, generally, **30:98 to 30:105** Fraud, **31:87**

Jury trial, 32:125

Measurement of reasonable attorney fee, 30:102, 30:103

Over-aggressive trademark enforcement, 11:93

Prevailing defendant, award to, **30:101**Prevailing plaintiff, award to, **30:100**State law, **30:106**

"BACK DOOR" PATENTS

Fear of, trade dress, 8:5

BACKGROUND DESIGNS, SHAPES AND SYMBOLS

Generally, 7:26 to 7:29

Descriptive non-word designs, 11:16.50 Federal registration, symbols, 19:78.50 Inherently distinctive and non-distinctive designs, 7:29

BACKGROUND NOISE

Survey evidence, 32:187

BAD FAITH

Good Faith (this index)

BANKRUPTCY AND INSOLVENCY

Assignments, **18:28 to 18:31** Federal question jurisdiction, **32:8**

BANKS

Corporate, business and professional trade names, **9:10**

BANNER ADVERTISING

Cyberspace, infringement in, 25A:7

BARS TO REGISTRATION

Federal Registration (this index)

BIOGRAPHIES

Literary, artistic and entertainment rights, **10:44**

BLACKOUT PERIOD

Intent to use applications, 19:19

BLANK SLATE

Descriptive marks, 11:21

BLURRING

Dilution of Trademarks (this index)

BONA FIDE TRANSACTIONS

Acquisition and priority of rights, inherently distinctive marks, **16:7**

BONDS

Preliminary injunctions, 30:55

BRAND NAME

Definitions, 4:11

BREACH OF LICENSE

Exclusive license, breach by licensor, 18:44.50

BRIDGING THE GAP

Related goods or services, 24:18

BRIEFS

Inter partes proceedings, 20:103

BROADCAST FREQUENCY DESIGNATIONS

Generally, 7:17

BROADCAST STATION CALL LETTERS

Generally, 7:12

BUILDINGS

Generally, 7:100, 7:101

Color, 7:48

Federal registration, 7:101

Protection of building exterior and interior, **7:100**

Trademark formats, 7:100

Trademark or service mark, 7:101

BURDEN OF PROOF

Acquisition and priority of rights, 16:20

BURDEN OF PROOF—Cont'd

Cancellation proceedings, 20:64

Concurrent use proceedings, 20:85

Fraud, 31:68

Generic terms, 12:12

Personal names, federal registration, 13:33

Plaintiff, infringement, 1:2

Secondary meaning, 15:32 to 15:35

Summary judgment, 32:116, 32:117

Utilitarian functionality, 7:72

Venue, transfer for inconvenience, 32:74

BUSINESS NAMES

Corporate, Business and Professional Trade Names (this index)

BUSINESS VEHICLES

Color, 7:48

CALIFORNIA

Anti-cybersquatting act, **25A:84**Unfair competition and consumer remedies acts, **27:115**

CALIFORNIA

ANTI-CYBERSQUATTING ACT

Infringement in cyberspace, 25A:84

CANCELLATION PROCEEDINGS

Generally, 20:40 to 20:80

Abandonment of mark, 20:57

Acquiescence by failure to object to use of mark, **20:74 to 20:77**

Attack on validity of registration, 20:65

Burden of proof, 20:64

Certification mark, misuse of, 20:61

Collateral cancellation during, 20:70.50

Compulsory counterclaims, 20:66

Conditional judgment for intent to use applicants, **20:45**

Consumer standing, opposition proceeding, **20:47**

Counterclaim in opposition proceeding, 20:51

Descriptiveness, standing, 20:50

Equitable defenses

generally, 20:73 to 20:80

delay times prejudice to registrant, laches as, **20:76**

estoppel, 20:79

exceptions to laches, 20:77

CANCELLATION PROCEEDINGS	CANCELLATION PROCEEDINGS
—Cont'd	—Cont'd
Equitable defenses—Cont'd	Pleading and proof
laches or acquiescence by failure to object to use of mark, 20:74 to	generally, 20:41 , 20:43 , 20:65 to 20:72
20:77	attack on validity of registration,
similar registration, acquiescence by	20:65
failure to oppose, 20:78	burden of proof, 20:64
supplemental registration, cancella-	collateral cancellation, 20:70.50
tion of, 20:80	compulsory counterclaims, 20:66
Estoppel, 20:79	ex parte grounds, cancellation on,
Evidence. Pleading and proof, below	20:69
Exceptions to laches, 20:77	filing petition to cancel, 20:72
Ex parte	proof, 20:41
grounds, cancellation on, 20:69	tolling of the statutory limit for
inter partes matters, 4:18	cancellation counterclaim in
Federal Trade Commission, 20:63	opposition proceedings, 20:67
Filing petition to cancel, 20:72	use of mark, proof of, 20:71
Five years	withdrawal of petition, 20:70
registration for less than, 20:52 to 20:54	Previously registered marks not republished, 20:62
registration for more than, 20:55 to	Procedure, 20:43
20:64	Purpose, 20:40
Fraud, 20:58, 31:80	Rectifying the register, 20:44
Functionality, standing, 20:50	Scandalous matter, standing required to
Functional mark, 20:56.50	petition to cancel, 20:50.50
Generic, designation is or has become, 20:56	Similar registration, acquiescence by failure to oppose, 20:78
Genericness, standing, 20:50	Standing
Grounds, generally, 20:52 to 20:64	generally, 20:46 to 20:51
Immoral, standing required to petition to cancel on grounds of, 20:50.50	counterclaim, opposition proceeding, 20:51
Intent to use applications, 20:45	descriptiveness, 20:50
Laches by failure to object to use of	functionality, 20:50
mark, 20:74 to 20:77	genericness, 20:50
Lanham Act	immoral or scandalous, standing
Section 2(a), (b) or (c) or 4 as ground, 20:59	required to petition to cancel on grounds of, 20:50.50
Section 2(d) as ground, 20:53	likelihood of damage, 20:46, 20:49
Section 43(c) as ground, 20:53.50	petition to cancel, 20:46, 20:49
Likelihood of damage, standing, 20:46 , 20:49	Statutory limit for cancellation counterclaim in opposition
Misrepresentation of source of goods or	proceedings, tolling of, 20:67
services, 20:60	Supplemental registration, cancellation
Morality, standing required to petition to	of, 19:41, 20:80
cancel on grounds of, 20:50.50	Time to file petition, 20:42
No consumer standing in the trademark	Tolling of statutory limit for cancellation
trial	counterclaim in opposition
and appeal Board, 20:9	proceedings, 20:67
Partial cancellation, 20:44	Use of mark, proof of, 20:71
Petition to cancel, 20:46, 20:49, 20:72	Withdrawal of petition, 20:70

CATALOG USES

Acquisition and priority of rights, federal registration, 16:32

CEASE AND DESIST LETTERS

Aggressive use or enforcement of trademarks, 31:100 Continued use of mark after, likelihood of confusion, 23:120

Estoppel, 32:109, 32:110

CELEBRITY IDENTITY

Publicity, privacy, 28:3

CERTIFICATION MARKS

Generally, **4:7**, **19:90** to **19:96**

Anti-use by owner rule, 19:94

Application for registration, 19:95

Bars to registration, 19:95

Cancellation proceedings, 20:61

Comment, 19:96

Common law, unregistered, 4:8

Defined, 4:7, 19:91

Infringement, 19:92.50

Special criteria, 19:92

Symbol, proper use of, 19:93

CHANGES IN GOODS AND LABELS

Generally, 25:35 to 25:40

Alteration and modification of goods or labels, 25:40

Blend, use of original product as part of, 25:36

Contents or ingredients, use of trademark of, 25:35.50

Ingredients, use of trademark of, 25:35.50

Repacking and rebottling goods, use of trademark in, 25:35 to 25:37

Repaired and reconditioned goods. 25:39

State laws, **25:37**

CHANGES IN USAGE

Abandonment of Rights (this index)

CHARACTERS IN LITERATURE

Literary, Artistic and Entertainment **Rights** (this index)

CHARITABLE AND NONPROFIT **ORGANIZATIONS**

Trade names, 9:5

CHARTS

Copyrights, 6:6

Definitions, 4:2

Patents, 6:6

Publicity, significant differences between trademarks and right of publicity, 28:9

CHEESE

Types, geographic terms, 14:18.50

CHOICE OF LAW

Hague convention, treaties, 29:36.50

Pendent state claims, 32:36

State trademark dilution, 24:83

CIRCUMSTANTIAL EVIDENCE

Secondary meaning, 15:30, 15:48 Survey evidence, 32:186

CIVIL RIGHTS ACT

Service marks, 19:105

CLAIM PRECLUSION

Res Judicata and Collateral Estoppel (this index)

CLASSIC FAIR USE

Descriptive, non-trademark use, 11:45

CLEAR AND CONVINCING **EVIDENCE**

Abandonment of rights, 17:12

CLIPART

Infringement, 25:52.50

CLOTHING

Generally, 7:103

Design or appearance of wearing apparel, 7:103

Freedom of speech, T-shirt as medium, 31:152

Related goods or services, 24:47

Trademark or trade dress, 7:103

COAT OF ARMS

Federal registration, 19:78

CO-BRANDING

Multiple marks on a product, 7:8

CODE OF ETHICS

Franchises, 18:69

Unfair competition, 1:12

COINED WORDS COLOR—Cont'd Registration—Cont'd Generally, 11:5 to 11:9 Oualitex rule, 7:44 Definitions, 11:5 single color registrations, examples, Examples, 11:8 7:44.50 Generic terms, 11:9, 12:17.50 strategy, including color in registra-Inherent strength, 11:6 tion, 7:45.30 Legal vs. merchandising conflicts, 11:7 Scope of rights in color mark, 7:45.70 COLLATERAL CANCELLATION Secondary meaning, 7:44 Pleading and proof, 20:70.50 "Shade confusion," 7:44, 7:45.70 Single color **COLLATERAL ESTOPPEL** generally, 7:40 Res Judicata and Collateral Estoppel anti-single color, antiquated rule, (this index) 7:40, 7:41, 7:42 COLLECTIVE MARKS registrations, examples, 7:44.50 Generally, 4:9, 19:98 to 19:101 service marks, 7:40 Anti-use by owner rule, 19:100 Strategy, including color in registration, Collective membership marks, 19:101 7:45.30 Definitions, 4:9 Type or size, 7:52 Geographic terms, regional certification marks and collective marks, 14:21 "COLORABLE IMITATION" Identification of goods and services of Counterfeiting, distinguished from, members, **19:99** 25:15.50 **COLOR COMBINED MARKS** Generally, 7:39 to 7:52 Co-branding, 7:8 Building designs, color in combination **COMMERCE** with, 7:48 Infringement Business vehicles, color in combination generally, 25:53 to 25:56 with, 7:48 Coding system, 7:52 definition of interstate commerce, mark in 8220commerce,8221 Commonplace vs. distinctive, 7:45 25:55 Defined designs, color combinations and Federal Question Jurisdiction (this color in, 7:40, 7:45 index) Definition of color, defining and narrowforeign commerce, 25:53 ing in registration, 7:45.30 internet, infringing use on, 25:54.50 Depletion, 7:40, 7:44 interstate commerce, 25:53 Descriptive indication, 7:52, 11:41 Lanham Act Distinctive vs. commonplace, 7:45 internet, infringing use on, Drug capsule colors, 7:50, 7:51 25:54.50 Flavor, 7:52 local and intrastate infringement, Functionality, 7:40, 7:49, 7:88 25:56 Generic or descriptive indication, 7:52 must be in 8220commerce, 8221 Judicial power, definition of color, 25:54 7:45.30 mark in 8220commerce, 8221 defini-Likelihood of confusion, 23:52 tion of interstate commerce. Liquid products, color of, 7:47 25:55 Non-specified color, design of, **7:46 Use in Commerce** (this index) Registration

COMMERCIAL ACTIVITY

Advertising or promotion, 27:71

defining and narrowing definition in,

7:45.30

COMMERCIAL ACTIVITY—Cont'd

Disparagement law limited to, 27:95, 27:96

Fact representation, not opinion, **27:96** False advertising, two part test, **27:54**, **27:54.50**, **27:55**

Misrepresentations regarding, **27:64.50** Opinion statements, **27:67**

Speech, generally, 27:67 to 26:69, 28:18

COMMERCIAL IMPRESSION

Similarity of marks, likelihood of confusion, 23:21.50

COMMERCIAL MARKS

Literary, Artistic and Entertainment Rights (this index)

COMMERCIAL MORALITY

Generally, 2:9

COMMERCIAL STRENGTH

Strength of marks, 11:80

COMMON LAW

Acquisition and Priority of Rights (this index)

Consistency, state statutory and common law, federal trademark law, 22:1.50

Corporate, business and professional trade names, **9:1 to 9:4, 9:12**

Dilution of trademarks, 24:76

False Advertising (this index)

Federal registration, 19:8

Fraud on U.S.P.T.O, trademark, **31:60** Likelihood of confusion, intent, **23:106**

Service marks, 19:80

Territorial Extent of Rights (this index)

COMMONPLACE OBJECTS

Descriptive marks, 7:36

COMMUNICATIONS DECENCY ACT (CDA)

Internet service provider, Federal CDA immunity

state claim, 22:4.50

trademark infringement claim, 25A:42.50

COMPOSITE MARKS

Dena precedent, 19:66

Descriptive Marks (this index)

Federal registration, disclaimers, 19:66

COMPOSITE MARKS—Cont'd

Generic terms, 12:39

Geographic terms, descriptiveness, **14:11**

Likelihood of confusion, 23:41, 23:44, 23:47

Secondary meaning, federal registration, 15:67

COMPOSITES

Descriptive marks, 7:36

COMPULSORY COUNTERCLAIMS

Cancellation proceedings, **20:66**Federal supplemental jurisdiction, **32:30**Inter partes proceedings, oppositions, **20:23**

COMPUTERS

Counterfeiting, 25:12

Cyberspace, Infringement in (this index)

Infringement, 25:51.50

Internet (this index)

Related goods or services, 24:44

CONCEPTUAL STRENGTH

Strength of marks, 11:80

CONCLUSIVENESS OF JUDGMENTS

Res Judicata and Collateral Estoppel (this index)

CONCURRENT USE PROCEEDINGS

Generally, 20:81 to 20:88

Awarding territories, 20:84

Burden of proof, 20:85

Court determination, concurrent registration after, **20:88**

Ex parte and inter partes matters, **4:18**

Impact of Internet usage, 20:85.50

Likelihood of confusion, 20:85

Non-territorial restrictions in registrations, **20:87**

Patent and Trademark Office proceedings, 20:81 to 20:88

Priority rules, 20:86

Statutory basis, 20:82

Territorially restricted registration, source of, **20:83**

CONDITIONAL JUDGMENTS

Cancellation proceedings, intent to use applicants, **20:45**

CONFLICTS OF LAW

Choice of Law (this index)

CONFUSION

Likelihood of Confusion (this index)

CONJOINT USE RULE

Likelihood of confusion, 23:61.25

CONSENT

Acquiescence (this index)

Consent Agreements (this index)

Contempt, consent decrees, 30:24, 30:24.50

Estoppel, **32:106**

Inter partes proceedings, consenting to judgment, **20:120**

Letters, likelihood of confusion, federal registration, 23:85 to 23:89

Name, portrait or signature of living individual, federal registration of marks without consent, 13:37 to 13:39

CONSENT AGREEMENTS

Generally, 18:79 to 18:81

Apple agreements, **18:79**

Assignment, contract as consent, **18:5** Defined, **18:79**

Disputes between contracting parties, 18:80

Third parties, impact on, 18:81

CONSENT LETTERS

Likelihood of confusion, federal registration, 23:85 to 23:89

CONSTITUTIONAL LAW

Copyrights, **6:2**

Fifth Amendment, summary judgment, 32:121.25

First Amendment defense under Noerr-Pennington, **31:104, 31:105**

Freedom of Speech (this index)

Patents, 6:2

Punitive damages, constitutional limits, 30:96.50

Trademarks, 6:2

CONSTRUCTIVE NOTICE

Laches and delay, 31:40

Likelihood of confusion, infringement of federally registered marks, 23:109

CONSTRUCTIVE NOTICE—Cont'd

Territorial extent of rights, federally registered marks, **26:31**, **26:32**

CONSTRUCTIVE USE

Acquisition and Priority of Rights (this index)

Territorial extent of rights, federally registered marks, 26:37 to 26:40

CONSUMER PROTECTION

Generally, 2:22 to 2:25

California statutes, 27:115

Confusion, protection from, 2:1

Fraud, infringement as, 2:23

"Irrational" consumer preferences, trademarks as creating, **2:25**

Trademark protection, generally, **2:22**Truth, consumer's right to be told, **2:24**

CONTAINER SHAPES

Product and Container Shapes (this index)

CONTEMPT

Generally, **30:17 to 30:29**

Attack on injunction at contempt hearing, **30:18**

Compensatory award vs. coercive sanction, **30:25**

Consent decrees, 30:24, 30:24.50

Defenses, 30:23

Jury trial, right to, 30:20

Monetary recovery

generally, 30:25 to 30:29

attorney fees, 30:28

compensatory award vs. coercive sanction, 30:25

profits made as result of contempt, 30:27

Nature, 30:17

Private attorney as prosecutor, 30:19

Profits made as result of contempt, 30:27

Safe distance rule. 30:21

Settlements, 30:24.50

Standard of compliance, 30:22

Types, 30:17

CONTENTS

Changes in goods and labels, use of trademark of contents or ingredients, **25:35.50**

CONTINUING USE

Abandonment of rights through nonuse, **17:9**

CONTRACTS AND AGREEMENTS

Assignments (this index)

Consent Agreements (this index)

Contest validity of trademark, agreement not to. **18:83**

Franchises (this index)

Insurance for infringement claims, breach of contract exclusion, **33:17**

Licenses (this index)

Registration of trademark, agreement not to, **18:82**

Use of trademark, agreement not to, 18:82

CONTRIBUTION

Monetary recovery, 30:78

CONTRIBUTORY INFRINGEMENT

Generally, 25:17 to 25:25

Anti-dilution act, vicarious liability under Lanham Act section 43(c), 25:21.75

Distributing process, liability of knowing participants in, **25:19**

Distributor liable for enabling dealers to pass off or infringe, 25:18

Franchisors, 25:21

Internet site, 25:20.50

Joint tortfeasors and personal liability, 25:23

Knowing participants in distributing process, liability of, **25:19**

Landlords, 25:20

Lanham Act section 43(c), contributory and vicarious liability, **25:21.25**, **25:21.75**

Liability of knowing participants in distributing process, **25:19**

Manufacturer liable for enabling dealers to pass off or infringe, 25:18

Nonparty contributory infringers held to obey injunction, **25:25**

Personal liability and joint tortfeasors, **25:24**

Vicarious liability, 25:21.25 to 25:22

CONTROLLED LICENSEE

Related company, 18:51

CONVERSION

Trademarks, 25:70

COOPER PRECEDENT

Literary, artistic and entertainment rights, **10:4**

COPYRIGHTS

Generally, 6:1 to 6:6, 6:13 to 6:31

Advertising. Commercial works and advertising, below

Artistic style, 6:14, 10:40.50

Chart, **6:6**

Commercial works and advertising

generally, **6:25** to **6:31**

advertising material, catalogs and price lists, **6:30**

advertising theme, copyrightability, **6:22**

elements of copyright notice, 6:25

labels, 6:19, 6:22

notice, 6:25, 6:26

pictures, 6:18

registration of claim to copyright, **6:28**

trademark in copyright notice, **6:26** trademark infringement and false advertising in connection with copyright infringement, **6:27**

trademark protection in works out of copyright, **6:31**

Common denominators, 6:4

Confusion in the legal world, 6:1

Constitutional basis, 6:2

Copying as essential for infringement, **6:24**

Dastar rule, 6:27

Designs, 6:18

Elements of copyright notice, **6:25**

False advertising in connection with copyright infringement, **6:27**

Federal preemption

generally, 6:15

Infringement, 6:23, 6:24, 6:27

Ingredients, 6:19

Instructions, 6:19

Labels. Trademarks and labels, below Literary, artistic and entertainment

rights, 10:34, 10:41, 10:44

Monetary recovery, 6:16

Nature, 6:13

Notice, 6:25, 6:26

COPYRIGHTS—Cont'd	CORPORATE, BUSINESS AND
Overlap with trademark, 6:14 , 6:17.50	PROFESSIONAL TRADE NAMES
Pictures, 6:18	—Cont'd
Policy, 6:3	Federal
Price lists, copyright in, 6:30	protection, 9:1 to 9:4
Registration of claim to copyright, 6:28	registration
Regulations, 6:20	generally, 9:13 to 9:17
Scope of exclusivity, 6:14	definition of "trade name," 9:13
Single words, 6:19	dual trade name and service mark
Slang, 6:19	usage, 9:15
Slogans, 6:19	dual trade name and trademark
State preemption	usage, 9:16
generally, 6:15.50	use to prevent registration to another, 9:17
Statutes, 6:20	
Style, artistic, 6:14 , 10:40.50	Fictitious name certificates, 9:9
Trademarks and labels	Fraternal groups, 9:6 Government marks, 9:7.75
generally, 6:17 to 6:24	
advertising, 6:22	Infringement, incorporation as, 9:3, 9:8
copying as essential for infringement,	Laches as a defense, 9:5
6:24	Multiple uses, 9:14 Nonprofit organizations, 9:5
copyrightable work, trademarks in,	
6:17.50	Political groups, 9:6 Priority of use as trade name, 9:2
copyrights, compared, 6:3	Professional groups, 9:6
infringement, 6:23 , 6:24	Public exposure, 9:3
labels, 6:19 , 6:21	Religious Freedom Information Act,
patents, compared, 6:3	9:7.50
pictures and designs, 6:18	Religious organizations, 9:7.50
slogans and words, 6:19	Senior users, 9:6
statute and regulations, 6:20	Service marks, 4:7 , 9:12
trademark in copyrightable work, 6:17.50	State incorporation or registration
	generally, 9:8 to 9:11
Warnings, product, 6:19 Words, 6:19	bank names, 9:10
Works out of copyright, trademark	corporate charter, forfeiture of, 9:11
protection in, 6:31	failure to
	obtain license, 9:11
CORPORATE, BUSINESS AND	register to do business in state, 9:11
PROFESSIONAL TRADE NAMES	tax payments, 9:11
Generally, 9:1 to 9:17	fictitious name certificates, 9:9
Archaic meaning, 4:4, 4:5	junior user's corporate charter is no
Bank names, 9:10	defense, 9:8
Charitable and nonprofit organizations,	Unregistered trade names, 9:4
9:5	Use to prevent registration to another,
Common law, 9:1 to 9:4, 9:12	9:17
Designation only, 4:5, 9:13	Validity, 9:2
Distinctiveness, 9:2	COCIEC
Dual trade name	COSTS
service mark usage, 9:15	Buyers, trademark protection, 2:5
trademark usage, 9:16	Court costs, 30:107
Education institutions, 9:7	Deductions to arrive at profits, 30:68
Eleemosynary organizations, 9:5	Search costs reduction, 2:5

COUNSEL FEES	COUNTERFEITING—Cont'd
Attorney Fees (this index)	Preliminary injunctions—Cont'd
COUNTERCLAIMS	1984 statute, special federal seizure remedies, 30:35
Compulsory Counterclaims (this	post-seizure hearing, 30:43
index)	procedure, 30:38
COUNTERFEITING	purpose of statute, 30:36
Generally, 25:10 to 25:16.50	seizure of goods and records, 30:39
Anti-counterfeiting amendments, 25:16.50	special federal seizure remedies, 30:35 to 30:44
Anti-Counterfeiting Trade Agreement (ACTA), 29:33.50	wrongful seizure, remedies for, 30:44 Remedies
Appeals, preliminary injunctions, 30:41	criminal penalties, above
Attachment of property, preliminary	preliminary injunctions, above
injunctions, 30:40	Safe harbor, 25:16 , 30:120
"Colorable imitation" distinguished from, 25:15.50	Seizure of goods and records, preliminary injunctions, 30:39
Computer programs, 25:12	Similarity, 25:15.50
Criminal penalties	Special civil remedies, 25:15
generally, 30:114 to 30:120	"Substantially indistinguishable" test,
anti-counterfeiting, 25:14	25:15.50 Tariff Act
Criminal Counterfeiting Act, gener-	elements, 25:45
ally, 30:115 to 30:120	remedies against imported goods,
definition of counterfeit mark, 30:117	25:11
elements of crime, 30:118	Wrongful seizure, remedies for, 30:44
procedure, 30:119	
safe harbor, 30:120 Defined, 25:10	COURT OF APPEALS FOR FEDERAL CIRCUIT
Destruction of goods, preliminary	Generally, 21:10 to 21:19
injunctions, 30:42	Diversion, trademark appeals, 21:14
Federal Counterfeiting Act, 25:13 to	Final decisions, 21:19
25:16.50	History, 21:11 to 21:13
Freezing assets, preliminary injunctions,	Jurisdiction over PTO appeals, 21:13
30:40	Patent claims, trademark infringement
Imported goods, 29:45	issues joined with, 21:11
Infringement compared to, 25:15.50	Precedents, CCPA decisions as, 21:12
Insurance coverage for infringement	Procedure, 21:16 to 21:19
claims, 33:6	Standard of review, 21:18
Monetary recovery, 30:94 , 30:95	Status, 21:11 to 21:13
Motion pictures, 25:12	COVENANT NOT TO SUE
Phonorecords, 25:12	Federal jurisdiction, 32:2.50
Post-seizure hearing, preliminary injunc-	
tions, 30:43	CRIMINAL PENALTIES
Preliminary injunctions	Counterfeiting (this index)
generally, 30:34 to 30:44	CROSS-EXAMINATION
appeal, 30:41	Survey evidence, hearsay objection,
coverage of statute, 30:37 destruction of goods, 30:42	32:167
freezing assets and attaching property,	CYBER-GRIPING
30:40	Gripe Sites (this index)

CYBERSPACE, INFRINGEMENT IN

Generally, 25A:1 to 25A:86

Abuse of a dispute resolution procedure reverse domain name hijacking, **25A:69**

Acquired prior to trademark rights, ICANN Uniform Dispute Resolution Policy (UDRP), **25A:30**

Additional top level domain in the Twenty First century, **25A:14**

Advertising

banner advertising, sales of, 25A:7 pop-up advertising, 25A:9 search engines, triggered by keywords, use, 25A:6

Anti-Cybersquatting Consumer Protection Act (ACPA), **25A:48 to 25A:83**

Appeal and review, ICANN Uniform Dispute Resolution Policy (UDRP), 25A:37

Asserting a 43(d) violation, in rem jurisdiction, federal Anti-Cybersquatting Act, **25A:75**

Attorney fees, Anti-Cybersquatting Consumer Protection Act (ACPA), 25A:67

Author's opinion, advertising search engines, **25A:8**

Bad faith

ICANN Uniform Dispute Resolution Policy (UDRP), **25A:27**

nine factors, Anti-Cybersquatting Consumer Protection Act (ACPA), **25A:53 to 25A:62**

Banner advertising, sales of, **25A:7** California Anti-Cybersquatting Act, **25A:84**

Choice of law, ICANN Uniform Dispute Resolution Policy (UDRP), 25A:26

Coexist, bad faith, Anti-Cybersquatting Consumer Protection Act (ACPA), 25A:54

Commercial use, Lanham Act, **25A:42**Communications decency act (cda),
federal immunity, trademark
infringement, **25A:42.50**

Complainant's trademark rights, ICANN Uniform Dispute Resolution Policy (UDRP), 25A:23

Confusingly similar

Anti-Cybersquatting Consumer Protection Act (ACPA), **25A:51**

CYBERSPACE, INFRINGEMENT IN —Cont'd

Confusingly similar—Cont'd ICANN Uniform Dispute Resolution Policy (UDRP), **25A:24**

Lanham Act, 25A:43

site, 25:20.50

Confusion, advertising, **25A:7**Contributory infringement of Internet

Control, in rem jurisdiction, federal Anti-Cybersquatting Act, **25A:76**

Copyright owner's exception, personal names, Federal Anti-Cybersquatting Act, 25A:82

Country code domains, domain name resolution procedures in, **25A:20**

Cyber-griping. **Gripe Sites** (this index) **Cybersquatting** (this index)

Cyber-stuffing, **25A:3**

Damages, Anti-Cybersquatting

Damages, Anti-Cybersquatting
Consumer Protection Act (ACPA),
25A:66

Dealer's and distributor's use, ICANN Uniform Dispute Resolution Policy (UDRP), **25A:32**

Defaults, ICANN Uniform Dispute Resolution Policy (UDRP), **25A:35**

Defenses

Anti-Cybersquatting Consumer Protection Act (ACPA), **25A:64** reasonable belief defense. **25A:63**

ICANN Uniform Dispute Resolution Policy (UDRP), **25A:29**

personal names, Federal Anti-Cybersquatting Act, **25A:83**

registered domain name as defense, **25A:17**

Dispute resolution procedures, domain names, 25A:19 to 25A:38

Domain names, generally, **25A:11 et seq.**

Elements

Anti-Cybersquatting Consumer Protection Act (ACPA), **25A:50** in rem jurisdiction, federal Anti-

Cybersquatting Act, 25A:74

Enforcement, in rem jurisdiction, federal Anti-Cybersquatting Act, 25A:78

Fan sites, ICANN Uniform Dispute Resolution Policy (UDRP), **25A:31**

Federal Anti-Cybersquatting Act, 25A:48 to 25A:83

CYBERSPACE, INFRINGEMENT IN CYBERSPACE, INFRINGEMENT IN —Cont'd —Cont'd Federal immunity, communications Intent to divert, bad faith, Antidecency act (cda), trademark Cybersquatting Consumer Protecinfringement, 25A:42.50 tion Act (ACPA), 25A:58 Forum, in rem jurisdiction, federal Anti-Internet Cybersquatting Act, 25A:73 domain names, 25A:10 et seq. Framing and linking, 25A:4 hashtags, 25A:4.50 nonfungible tokens (NFTs), Use and Good faith. Bad faith, above misuse of trademarks, 25A:4.70 Gripe sites Judicial review, ICANN Uniform ICANN Uniform Dispute Resolution Dispute Resolution Policy (UDRP), Policy (UDRP), 25A:33 25A:37 Lanham Act, 25A:45 Key words, sales of, **25A:6** Hawaii anti-cybersquatting law, 25A:86 Lanham Act, 25A:41 to 25A:47 Hidden code, 25A:3 Legitimate rights, ICANN Uniform ICANN (Internet Corporation for Dispute Resolution Policy (UDRP), Assigned Names and Numbers), 25A:25 25A:12 Liability, Anti-Cybersquatting ICANN Uniform Dispute Resolution Consumer Protection Act (ACPA), Policy (UDRP), 25A:21 et seq. 25A:52 acquired prior to trademark rights, Linking and framing, 25A:4 25A:30 Louisiana anti-cybersquatting law, bad faith use, 25A:27 25A:86 choice of law, 25A:26 Meta tags, 25A:3 complainant's trademark rights, Misleading false contact information, 25A:23 bad faith, Anti-Cybersquatting confusingly similar, 25A:24 Consumer Protection Act (ACPA), dealer's and distributor's use, 25A:32 25A:60 defaults, 25A:35 Multiple similar names, bad faith, Antidefenses, 25A:29 Cybersquatting Consumer Protection Act (ACPA), **25A:61** fan sites, **25A:31** New York Anti-cybersquatting Act, gripe sites, 25A:33 25A:85 judicial review, 25A:37 Non-commercial or fair use, bad faith, legitimate rights, 25A:25 Anti-Cybersquatting Consumer passive holding rule, 25A:28 Protection Act (ACPA), 25A:57 personal names, 25A:31 Notice, in rem jurisdiction, federal Antiprecedential weight, 25A:36 Cybersquatting Act, 25A:77 procedural issues, 25A:34 Open framework for new top level successful challenge, elements, domains, 25A:15 25A:22 Passive holding rule, ICANN Uniform Text. 25A:39 Dispute Resolution Policy (UDRP), Text of rules, 25A:40 25A:28 Initial interest confusion, Lanham Act, Personal e-mail web sites, Lanham Act, 25A:44 25A:47 Personal jurisdiction, Anti-Cybersquat-Injunctions, Anti-Cybersquatting ting Consumer Protection Act Consumer Protection Act (ACPA), 25A:65 (ACPA), **25A:68** Personal names In rem jurisdiction, federal Anti-Cybersquatting Act, 25A:70 to bad faith, Anti-Cybersquatting 25A:78 Consumer Protection Act

CYBERSPACE, INFRINGEMENT IN —Cont'd

Personal names—Cont'd (ACPA), **25A:55**

Federal Anti-Cybersquatting Act, 25A:79 to 25A:83

ICANN Uniform Dispute Resolution Policy (UDRP), **25A:31**

Political groups, Lanham Act, **25A:46** Pop-up advertising, **25A:9**

Pre 2000, NSI top level domain name dispute resolution, **25A:19**

Precedential weight, ICANN Uniform Dispute Resolution Policy (UDRP), 25A:36

Prior use, bad faith, Anti-Cybersquatting Consumer Protection Act (ACPA), 25A:56

Procedural issues, ICANN Uniform
Dispute Resolution Policy (UDRP),
25A:34

Reasonable belief defense, Anti-Cybersquatting Consumer Protection Act (ACPA), **25A:63**

Registering

domain name, 25A:13, 25A:16 to 25A:18

term, Lanham Act, 25A:41

Religious groups, Lanham Act, **25A:46** Remedies, Anti-Cybersquatting

Consumer Protection Act (ACPA), 25A:48

Reverse domain name hijacking, **25A:38**

Search engines, 25A:5 et seq.

Sell for financial gain without bona fide use, bad faith, Anti-Cybersquatting Consumer Protection Act (ACPA), 25A:59

Shopping, trademark problems, **25A:9.50**

Strength of plaintiff's mark, bad faith, Anti-Cybersquatting Consumer Protection Act (ACPA), **25A:62**

Successful challenge, elements, ICANN Uniform Dispute Resolution Policy (UDRP), 25A:22

Text of ICANN dispute resolution policy (UDRP)

generally, **25A:39** rules, **25A:40**

CYBERSPACE, INFRINGEMENT IN —Cont'd

Top level domains, open framework, **25A:15**

Trademark infringement, federal immunity, communications decency act (cda), **25A:42.50**

Transfer of authority to ICANN, 25A:12

Uniform Dispute Resolution Procedure (UDRP)

See specific entries throughout this heading

generally, 25A:19 to 25A:40

Uniform Rapid Suspension System, 25A:15

Valid trademark not created by domain name registration, 25A:18

CYBERSQUATTING

California Anti-Cybersquatting Act, **25A:84**

Dilution of trademarks, 24:82 Federal Anti-Cybersquatting Act, 25A:48 to 25A:83

DAMAGES

Cyberspace, infringement in, Anti-Cybersquatting Consumer Protection Act (ACPA), **25A:66**

Infringement, prima facie case requirement, 30:2.50

Monetary Recovery (this index)

DASTAR

Copyright infringement, **6:27**Literary, artistic and entertainment rights, 2003 Supreme Court decision in Dastar, **6:27**, **27:78**, **27:78.30**

DEALERS

Distributors and Dealers (this index)

DECEASED PERSONS

Literary, artistic and entertainment rights, 10:26

Publicity (this index)

DECEPTIVE USAGE

Descriptive Marks (this index)
Geographic Terms (this index)
Unclean hands, relevant conduct, 31:50

DECLARATORY JUDGMENTS

Generally, 32:50 to 32:58

DECLARATORY JUDGMENTS —Cont'd

Actual controversy

MedImmune rule, law after 2007, 32:51.50

reasonable apprehension, law before 2007, **32:51**

threat or filing of challenge, **32:52** Exhaustion of administrative remedies, **32:53**

Filing of inter partes challenge, actual controversy, **32:52**

Inter partes challenge, actual controversy, **32:52**

Jurisdiction, 32:56 to 32:58

MedImmune rule, **32:51.50**

Nature of suit threatened, jurisdiction, 32:56, 32:57

Reasonable apprehension, actual controversy, **32:51**

Threat or inter partes challenge, actual controversy, **32:52**

DECORATIVE SYMBOLS AND DESIGNS

Generally, 3:5, 7:24

DE FACTO SECONDARY MEANING

Secondary Meaning (this index)

DEFAMATION

Trade Libel and Product Disparagement (this index)

DEFAULT JUDGMENT

Inter partes proceedings, 20:130 Motions, 32:121.90

DEFECTIVE GOODS

Dilution of trademarks, tarnishment, 24:91

DEFENSES

Collateral estoppel, motion for summary judgment, waiver, **32:87**

Contempt, 30:23

Copyright, defense as to trademark infringement, **6:14**

Cyberspace, infringement in (this index)

Dilution of trademarks, 24:123 to 24:130, 24:134

Freedom of speech and press. **Publicity** (this index)

DEFENSES—Cont'd

Freedom of Speech (this index)

Infringement (this index)

Insurance (this index)

Intermediate junior user

generally, 26:43

limited territory exception, 26:44

Laches, charitable and nonprofit organizations, **9:5**

Limited territory exception, intermediate junior user, **26:44**

Senior user, common law, 26:53

Territorial Extent of Rights (this

index)

Trademark, defense as to copyright infringement, **6:14**

DEFENSIVE AESTHETIC FUNCTIONALITY

Generally, 7:82

DEFINITIONS

Generally, **4:1 to 4:18**

Archaic definitions, 4:2 et seq.

Brand name, 4:11

Certification marks, 4:7, 4:8

Chart, 4:2

Coined words, 11:5

Collective marks, 4:9

Competition, unfair, 4:6

Constructive use, **26:37** Descriptive marks, **11:16**

Dictionaries, 12:13

Distinctiveness, 4:13, 4:15

Ex parte, **4:18**

Fair use, 4:17

Famous, 4:16

Generic Terms (this index)

Intermediate junior user, defense, 26:43

Inter partes, 4:18

Interstate commerce, 25:55

Marks, 4:10

Modern definitions, 4:1 et seq.

Principal register, 4:12

Secondary meaning, 4:14, 4:15

Service marks, 4:7

Strength, 4:15

Supplemental register, 4:12

Technical trademark, 4:3

Trade dress traditionally, 8:1

Trademark, 4:1 et seq., 4:3

DEFINITIONS—Cont'd	DESCRIPTIVE MARKS—Cont'd
Trade name, 4:1 et seq. , 4:4 , 4:5	Deceptive and deceptively misdescrip-
Unfair	tive marks—Cont'd
competition, 4:6	arbitrary and deceptive usage,
trade practices, 4:1 et seq.	distinguished, 11:60
Well-known, 4:16	examples, 11:59
Words (this index)	gullibility of reasonably prudent
DEMAND FOR HIDY/PDIAL	purchaser, 11:61
DEMAND FOR JURY TRIAL	legal status variations, 11:55
Generally, 32:128	materiality, 11:58
DE NOVO TRIAL	Defined, 11:16
Generally, 21:21	Descriptive/suggestive battle line, 11:22
·	Designs, 7:35 to 7:37, 11:48
DEPOSITIONS	Direct information about product or ser-
Inter partes proceedings, 20:101, 20:108	vice, 11:19
DESCRIPTIVE MARKS	Disclaimer, admission of descriptive-
Generally, 11:15 to 11:49	ness, 11:52
Abbreviations, 11:32	Distinctively shaped goods, 7:36
Anti-dissection rule, composite marks,	Double entendre, 11:19
11:27	Evidence, 11:20, 11:38, 11:81
Arbitrary and deceptive usage,	Expert testimony, 11:20
distinguished, 11:60	Fair use
Blank slate view, 11:21	generally, 11:45 to 11:49
Cancellation proceedings, 20:50	affirmative defense, 11:49
Challenges to applications for federal	classic fair use, 11:45 et seq.
registration, 11:51.50	confusion, fair use can co-exist with
Change of form, 11:29	some degree of, 11:47
Color, 7:52, 11:36, 11:41	examples of fair use defense rejected, 11:48.50
Combination of descriptive terms, 11:26	federal law, 11:49
Commonplace objects, 7:36	former employers, 11:48
Competitive need test v. imagination	illustrative examples, 11:48
test, 11:68	microcolor, 11:47
Composite marks	other than as trademark, use as, 11:46
generally, 11:26 to 11:28.25	primary descriptive meaning, use in,
anti-dissection rule, 11:27	11:45
combination of descriptive terms,	prize or awards, 11:48
11:26	technological, 11:48
repetition of descriptive or generic	used fairly and in good faith, 11:49
term, 11:28.50	False advertising, 11:59
size superlatives, 11:28	Fanciful representations, 7:36
"smart" descriptive or composite	Federal registration
marks, 11:28.25	generally, 11:50 to 11:61
Composites, 7:36	challenges to applications, 11:51.50
Consumer perception, evidence of,	container shapes, 11:51
11:82	contestable registration, 11:43, 11:44
Container shapes, 11:51	deceptive and deceptively misdescrip-
Contestable registration, 11:43, 11:44	tive marks, below
Deceptive and deceptively misdescrip-	disclaimers, 11:52, 19:65
tive marks	merely descriptive marks, 11:50 to
generally, 11:54 to 11:61	11:53

DESCRIPTIVE MARKS—Cont'd	DESCRIPTIVE MARKS—Cont'd
Federal registration—Cont'd	Secondary meaning, 11:15, 11:25,
secondary meaning, registration upon	11:38, 11:53
proof of, 11:53	Self-laudatory terms, 11:17
Flavor, 11:41	Simile, 11:19
Foreign equivalents doctrine, 11:34,	Size, 11:36
11:35	"Smart" descriptive or composite
Foreign web sites evidence, 11:51	marks, 11:28.25
Former employer, 11:48	Sophisticated buyers, 11:16
Geographic Terms (this index)	Status, 11:15 to 11:18
Google searches, 11:20	Strength of Marks (this index)
Grade designations. Style and grade	Style and grade designations generally, 11:36 to 11:41
designations, below	color designations, 11:41
Gullibility of reasonably prudent purchaser, deceptive and	secondary meaning, 11:38
deceptively misdescriptive marks,	Stylized representations, 7:36
11:61	Suggestive Marks (this index)
Illustrative examples, 11:24	Super size, size superlative composites,
Image of goods offered, 7:36	11:28
Imagination test v. competitive need	Survey evidence, 11:51
test, 11:68	Symbols, 7:35 to 7:37
Inter partes proceedings, standing,	non-word, 11:16.50
opposition, 20:11	Technological fair use, 11:48
Knowledge of reasonable customer,	Telescoped terms, 11:26
11:21	Terms used as trademarks, 11:23
Languages, 11:34	Tests of descriptiveness, 11:19 to 11:25
Legal protection, narrow, 11:23.50	Trade dress, 11:16.50
Lettering, distinctive display of, 11:30	"Trademark bullies," 11:92
Literary, artistic and entertainment	Used fairly and in good faith, 11:49
rights—descriptive series titles,	Validity, presumption of, 11:43
10:7.10	Variations in legal status, deceptive and
Materiality, deceptive and deceptively misdescriptive marks, 11:58	deceptively misdescriptive marks, 11:55
Metaphor, 11:19	DESIGNATIONS
Mini size, size superlative composites,	Federal registration, 4:5, 19:78.50
11:28	rederal registration, 4.3, 19.76.30
Misspelling, 11:31	DESIGNS
Obscure terms, 11:33	Background Designs, Shapes and
Opposition proceedings, standing, 20:11	Symbols (this index)
Owner, narrow legal protection,	Copyrights, 6:18
11:23.50	Descriptive marks, 7:35 to 7:37, 11:48
Pictures, 7:35 to 7:37	Functionality (this index)
Puffery, 11:17	Images of goods, 7:36
Quantity, 11:36	Likelihood of confusion, 23:47
Rationale for rule, 11:18	Packaging design, inherently distinctive,
Reasonably informed buyer, 11:21	8:13.50
Repetition of descriptive term, 11:28.50	Seabrook test, 8:13.50
Retail sales services, 11:16	Secondary meaning, 7:29 , 15:23
Right to inform consumers, 11:15, 11:18	Separate commercial impression test,
Scent, 11:36	7:27

DILUTION OF TRADEMARKS DESIGNS—Cont'd Test for background designs, 7:28 —Cont'd Fair use. 24:124 to 24:126 TM symbol, 3:6 Famous marks, 24:104 to 24:110 Trade dress, **6:11** Trademarks, claiming too many designs, Federal anti-dilution statute, 24:93 et seq. Unfair competition, 1:24 prior to 1996, 24:94 law, generally, 24:89 to 24:134 **DESTRUCTION ORDERS** preemption of state law, 24:80 Injunctions, 30:9 registration defense, 24:83 **DETERIORATED GOODS** Federal Anti-Dilution Revision Act, Dilution of trademarks, tarnishment, 24:115 24:91 Free riding v. impairment of distinctiveness, 24:68 **DICTIONARIES** Free speech and parody, 24:90, 24:126 Generic terms, 12:28 Generic usage of valid trademarks, Suggestive marks, use by dictionaries, 24:75 11:69 Historic structures, names of, 24:134 DILUTION OF TRADEMARKS Injunction, territorial scope of, 24:82 Generally, 24:67 to 24:134 Injury to famous mark, proving, 24:119 Anti-dilution statutes, 24:116 Inter partes proceedings, 20:20.50, 24:100 Appeal, state, 24:83 Laches, 24:83, 24:130 Association, likelihood of, 24:116 Lanham Act section 43(c), contributory Association requirements, 24:117 and vicarious liability, 25:21.75 Background of federal anti-dilution statute, 24:95, 24:96 LEXIS vs. LEXUS, 24:85 Likelihood of Blurring generally, 24:69, 24:113 to 24:115 association, 24:116 non-trademark use, 24:122 confusion, distinguished, 24:72, 24:73 state laws, 24:84 Causation, 24:121 Multi-factor test, 24:119 Choice of law, 24:83 Nature of dilution, 24:111, 24:112 Commentary as defense, 24:126, 24:127 Negative setting, alteration in, 24:92 Common law, 24:76 News reporting as defense, 24:127 Comparative advertising defense, New York, 24:85 24:125 Niche fame, 24:105 Competitive goods and services, 24:74 Noncommercial use statutory defense, Contributory and vicarious liability, 24:128 25:21.75 Non-trademark use. 24:122 Criticism, 24:126 Over-enforcement, anti-dilution law, Defective goods, tarnishment, 24:91 24:70 Defenses, 24:83, 24:123 to 24:130, Parody and free speech, 24:90, 24:126 24:134 Prima facie case, 24:99 Defined, 24:73 Procedure Degree of similarity of conflicting generally, **24:133** marks, 24:83 state law, 24:83 Deteriorated goods, tarnishment, 24:91 Remedies, 24:81, 24:82, 24:132 Dissonant usage, tarnishment, 24:91 Repaired products, tarnishment, 24:91 Distinctiveness, 24:118 Retroactivity, 24:131 Evidence of likelihood of injury to famous mark, 24:119, 24:121 Small segments, niche fame, 24:105

DILUTION OF TRADEMARKS	DISCLAIMERS—Cont'd
—Cont'd Standing, dilution by blurring argument,	Federal Registration (this index) Likelihood of confusion, 23:51
24:121.50 State law generally, 22:3, 24:76 to 24:88	DISCLOSURE, INTER PARTES PROCEEDINGS
anti-dilution statutes, 24:77 to 24:79.50	Pretrial disclosure, 20:115.50 Trademark Trial and Appeal Board discovery, 20:112
blurring, 24:84, 24:86 common law, 24:76	DISCOVERY
federal preemption, 24:80	Inter Partes Proceedings (this index)
injunction, territorial scope of, 24:82	
LEXIS vs. LEXUS, 24:85	DISMISSAL
New York, 24:85	Summary judgment, failure to state a claim, 32:121.75
procedure, 24:83	,
remedies, 24:81	DISPARAGEMENT OF PRODUCTS
strength of mark, 24:87, 24:88	Trade Libel and Product Disparage- ment (this index)
substantive aspects, 24:83 Statute of limitations, 24:130	
Statute of initiations, 24.130 Statutory factors, 24:120	DISPARAGING MARKS
Strength of marks	Bar to registration of, 19:77.25
generally, 24:87 , 24:88	DISPUTE RESOLUTION
likelihood of impairment, 24:118	ICANN Uniform Dispute Resolution
niche fame, 24:105	Procedure (UDRP). Cyberspace,
Substantive aspects, state law, 24:83	infringement in (this index)
Tarnishment	DISSONANT USAGE
generally, 24:89 et seq.	Dilution of trademarks, tarnishment,
defective goods, 24:91 deteriorated goods, 24:91	24:91
dissonant usage, 24:91	DISTINCTIVELY SHAPED GOODS
negative setting, alteration in, 24:92	Descriptive marks, 7:36
parody and free speech, 24:90	DISTINCTIVENESS
Territorial scope of injunction, 24:82	Generally, 4:13 , 11:1 to 11:93
Timing of acquisition of fame, 24:103	Acquired, 4:14
Trade dress, 24:83, 24:102	Arbitrary Marks (this index)
Trademark Dilution Revision Act, fac-	Coined Word Marks (this index)
tors, 24:120	Comparison, strength and secondary
Vicarious liability, 25:21.75	meaning, 4:15
Victoria's Secret decision, 24:112	Corporate, business and professional trade names, 9:2
DIRECTOR OF PATENTS AND	Definitions, 4:13 , 4:15
TRADEMARKS	Descriptive Marks (this index)
Generally, 21:5 to 21:7	Dilution of trademarks, 24:118
Invoking the supervisory power, 21:7	False advertising, 11:59
Review of a requirement of the	Inherently distinctive marks, 4:13 , 11:4
examiner in an ex parte examination, 21:6	Placement of candidates on spectrum,
Trademark petitions, 21:5 to 21:7	11:2, 11:3
_	Proving, 4:13
DISCLAIMERS	Secondary Meaning (this index)
Descriptive marks, 11:52	Strength of Marks (this index)

DISTINCTIVENESS—Cont'd

Suggestive Marks (this index)

DISTRIBUTORS AND DEALERS

Generally, 25:41 to 25:50

Authorized dealers, 25:43, 25:44

Changes in goods that result in material differences, 25:42.50

Collective mark of association of authorized dealers, **25:44**

Contractual restrictions on distribution, 25:47

Exhaustion rule, 25:41 to 25:44

False representation of being authorized dealer, **25:43**

Independent dealer or repairer, use of trademark by, **25:50**

Less than full quality branded goods, sales of, **25:46**

Ownership of trademarks, **16:46 to 16:49**

Quality control by trademark owner, resale of goods lacking, **25:42**

Rejected goods, 25:49

Resale of branded goods without change, **25:41**

Substitution of goods sold through dispensers or in containers, 25:48

The sale of goods and services bearing an infringing mark is infringement, 25:27

DIVERSIFICATION

The argument that consumers know that many firms diversify into several different kinds of goods and services, 24:54

DOMAIN NAMES

Acquisition and priority of rights, **16:7** Anti-Cybersquatting Protection Act (ACPA), **25A:48 to 25A:69**

Generic and top level combinations, 12:39.50

Trademarks

domain names as trademarks, 7:17.50, 25A:18

infringement, 25A:41 to 25A:47

Uniform Dispute Resolution Procedure (UDRP). See **Cyberspace**, **Infringement In** (this index)

DRAWINGS

Federal Registration (this index)

DRUG CAPSULES

Color, 7:50, 7:51

DRUGS (PRESCRIPTION)

Pharmaceuticals (this index)

ECONOMIC FUNCTIONS

Generally, 2:3

Unfair competition, 1:12 to 1:14

EDUCATION INSTITUTIONS

Trade names, 9:7

ELECTRONIC APPLICATIONS

Federal registration, communications with USPTO, 19:45.75

ELEEMOSYNARY ORGANIZATIONS

Trade names, 9:5

ENTERTAINMENT RIGHTS

Literary, Artistic and Entertainment Rights (this index)

ENVIRONMENTAL MARKETING CLAIMS

Trade libel and product disparagement, Federal Trade Commission, 27:121

EQUITABLE DEFENSES

Cancellation Proceedings (this index) Inter Partes Proceedings (this index) Opposition, defenses to, 20:31 to 20:39 Presumptions, 32:150, 32:151

EQUITABLE ESTOPPEL

Generally, 32:112

ESTOPPEL

Generally, 32:105 to 32:112

Acquiescence or laches, 32:105

Agreement, 32:110

Assignments, 18:16, 32:108

Cancellation proceedings, 20:79

Cease and desist letters, 32:109, 32:110

Collateral Estoppel. Res Judicata and Collateral Estoppel (this index)

Consent to use, **32:106**

Equitable estoppel, 32:112

File wrapper estoppel, **32:111**

Inter partes proceedings, 20:39

Judicial estoppel, 32:112

Laches or acquiescence, 32:105

Licenses, 18:63, 32:107

Prosecution history estoppel, 32:111

ESTOPPEL—Cont'd

Settlement agreements, 32:110

ETHICS

Code of Ethics (this index)

EUROPEAN COMMUNITY

Treaties, 29:35

EUROPEAN UNION (EU)

International trademark treaties, 29:35

EVIDENCE

Acquisition and priority of rights, **16:19**, **16:20**

Assignments, 18:4

Burden of Proof (this index)

Cancellation Proceedings (this index)

Circumstantial Evidence (this index)

Descriptive marks, 11:20, 11:38, 11:81

False advertising, 27:42 to 27:44, 27:53 to 27:58

Functionality, 7:74, 7:75, 7:89.30, 7:93

Generic terms, 12:12, 12:13

Hearsay (this index)

Inter Partes Proceedings (this index)

Likelihood of confusion, 23:2.75, 23:62, 23:63, 23:113 to 23:120

Presumptions (this index)

Prima Facie Evidence (this index)

Reconsideration of new evidence, appeal and request for, **19:127**

Secondary Meaning (this index)

Survey Evidence (this index)

Trade dress, proving secondary meaning, **8:11.50**

Use as a trademark. 3:4

EXAMINATION OF APPLICATION

Federal Registration (this index)

EXCLUSIVE DEALING RESTRICTIONS

Generally, **31:135**, **31:136**

EXCLUSIVE LICENSE

Modern rule of licensing, 18:44.50

EXCUSABLE NEGLECT

Reopening of testimony period, 20:119

EXHAUSTION OF REMEDIES

Declaratory judgments, 32:53

EXHAUSTION RULE

Resale of branded goods without change, **25:41 to 25:44**

EX PARTE

Cancellation proceedings, 4:18, 20:69

Definitions, 4:18

Impact on later T.T.A.B. case, ex parte examiner decision, **32:103**

Rejection to trademark board, appeal of, 19:127

Review of a requirement of the examiner, 21:6

Trademark trial and appeal board, 21:1, 21:2

Weight given in courts res judicata, PTO decisions, **32:95**

EXPERT TESTIMONY

Descriptive marks, 11:20

Likelihood of confusion, 23:2.75

EXPORT OR IMPORT TRADE

Federal registration, 29:9.25

EXPRESSIVE RIGHTS

Exclusive rights in titles, 10:1

EXPRESSIVE WORKS

Generally, 10:1 to 10:57

Advertising, periodicals, 10:6

Affiliation, confusion of, 10:18

Arbitration of motion picture titles, 10:37

Artistic style, **6:14**, **10:40.50**

Art works

single source, identifying, **3:8**

use of commercial marks in, 10:23

Assignments, 18:36

Author's name, use of, 10:26, 10:44

Biography of author, 10:44

Book titles, 10:15

Characters in literature

generally, 10:41 to 10:46

commercial products, sale of, 10:43

copyright, 10:44

copyright and patent law, 10:41

distinctive characterizations, 10:46

expressive media other than, 10:42.50

federal preemption, 10:46

names, 10:20

trademark protection, visual and, 10:42

EXPRESSIVE WORKS—Cont'd	EXPRESSIVE WORKS—Cont'd
Characters in literature—Cont'd	False
unfair competition, 10:42	advertising
Coincidental use of personal name in	generally, 27:77 to 27:90
fictional works, 27:87	coincidental use of personal name
Commercially valuable data misappro-	in fictional works, 27:87
priation, 10:57	copyright, false use of name on work that infringes, 27:81 to
Commercial marks, goods and services generally, 10:18 to 10:23	27:83
art works, use of commercial marks	copyright notice, false matter in,
in, 10:23	27:79
character names, 10:20	Dastar, 2003 Supreme Court deci-
entertainment free speech, 31:149	sion in, 6:27 , 27:78.30
expressive works, 10:22 , 31:149	false endorsement, 27:88
false endorsement, 10:22	imitator's claim of being creator of
infringement, 10:22	work, 27:81
media, commercial marks used in,	motion pictures and television programs, distinctive features
generally, 10:22, 10:23	of, 27:89
Media and magazine titles without	name, unauthorized use, 27:83
permission on, 10:19	name of artist, author, or performer,
media titles used on commercial	false use of, 27:85
goods and services, 10:18 to	over-representation of artist's,
10:20	author's or performer's contri-
movies, 10:22	bution or currency of perfor-
negative connotations, 10:22	mance, 27:84
parodies, 10:22	personal name, use in title or
radio, television, and movie titles and character names, 10:20	content of another's work, 27:86
Rock and Roll Hall of Fame, 10:23	unauthorized editing of creative
	work, 27:83
Rogers test, 10:22	unauthorized use of copyrighted
sponsorship and affiliation, confusion of, 10:18	work, 27:82
television, 10:22	endorsement, 27:88
Tiger Woods painting, 10:23	representation of being creator of idea
video games, 10:22	or invention, 27:78
Cooper precedent, 10:4	use of name of artist, author, or
Copyright law, 10:34 , 10:41 , 10:44	performer
Cover illustrations, 10:4	generally, 27:85
•	another's use of work, 10:30
Dastar, 2003 Supreme Court decision in, 6:27, 27:78, 27:78.30	Federal 10.27 10.46
Deceased person, use of name of, 10:26	preemption, 10:35, 10:46
Descriptive series titles, 10:6 , 10:7.10	protection, 10:38 to 10:40
Design patents, 6:11	registration, 10:38 Freedom of speech, unpermitted use in
Exclusive rights in titles, 10:1	expressive works, 31:149
Expressive media other than titles and	Generic series titles, 10:9
characters, 10:42.50	House marks, 10:15
Expressive works, commercial marks	Identification of single source, 10:10
used in, 10:22 , 31:149	Insurance coverage for intellectual prop-
Fair use, 10:14	erty, 33:18 to 33:22

EXPRESSIVE WORKS—Cont'd Likelihood of confusion, 10:15 Literary works series of generally, 10:6 to 10:9 descriptive series titles, 10:7.10 generic series titles, 10:9 illustrative examples, 10:8 periodical section or column, title of, 10:6.10 secondary meaning, 10:7 single generally, 10:2 to 10:5 author's comment: single work titles should be registerable,	Over-representation of artist's, author's or performer's contribution or currency of performance, 27:84 Parodies, 10:22 Patent law, characters in literature, 10:41 Performing group names, federal protection, 10:40 Periodicals advertising in, 10:6 section or column, title of, 10:6.10 Personal names generally, 10:26 to 10:30 author's name, use of, 10:26, 10:44
10:4.10	biography of author, 10:44
registration of titles, USPTO, 10:4 secondary meaning required, 10:2	deceased person, use of name of, 10:26
USPTO register, 10:4 Media, generally. Commercial marks, goods and services, above Misappropriation	false representation of being creator of idea or invention, 27:78 public domain work, use of name of author of, 10:26
generally, 10:47 to 10:57 commercially valuable data, 10:57 creation of doctrine, 10:48	title or content of work, use in, 27:86 truthful and false use of name on work, 10:26 to 10:30
history of doctrine, 10:51	use of names in connection with works, 10:26 to 10:30
limitations on doctrine, 10:55	Visual Artist's Rights Act, 10:29
preemption provisions, 10:52 to 10:54	Pictures, single source, identifying, 3:8
prima facie case, 10:49	Pre-release publicity and recognition,
sporting events, 10:56	10:12
trademark, generally, 10:50	Priority rights, 10:4 Protection from one medium to another,
Mockbusters, 10:12	10:17
Movies books, based on, 10:12	Public domain work, use of name of author of, 10:26
commercial goods and services,	Radio titles, 10:20
10:20, 10:22	Rock and Roll Hall of Fame, 10:23
entertainment free speech, use of	Sears-Compco defense, 10:35
commercial mark, 31:149	Secondary meaning
Lanham Act section 43(a), 27:89	generally, 10:10 to 10:14, 15:21
Music as trademark, 6:17.50 Name of artist, author, or performer	fair use, 10:14
editing, unauthorized use, 27:83	identification of single source, 10:10
false use of	pre-release publicity and recognition, 10:12
generally, 27:85	relevant evidence, 10:13
another's use of work, 10:30	series of literary works, 10:7
use on a work, 10:30	single literary works, 10:2
Names of characters	tests of secondary meaning, 10:10
commercial goods and services, 10:20	Song titles, 10:15
personal names, below	Sponsorship, confusion of, 10:18

EXPRESSIVE WORKS—Cont'd Sporting events, misappropriation, 10:56 Style, copyright, **6:14, 10:40.50** Suggestive marks, use by media, 11:69 Supreme Court decision in Dastar (2003), **6:27**, **27:78**, **27:78.30** Television, 10:20, 10:22 Third party uses, 10:15 Tiger Woods painting, 10:23 Titles and characters, expressive media other than, 10:42.50 Trade dress, 10:15 Trademark protection, visual and literary characters, 10:42 Truthful and false use of name on work, 10:26 to 10:30 Unauthorized editing of creative work, 27:83 use, 27:82, 27:83 Unfair competition, characters in literature, 10:42 Unregistered names and pictures, federal protection, 10:39 Video games, 10:22

Visual characters, trademark protection, 10:42
Weak titles, 10:15
Website menu, service mark, 10:6
Works out of copyright, 10:36

Visual Artist's Rights Act, 10:29

EXTRA-TERRITORIAL

Reach of Lanham Act, infringement abroad, 25:58

FADS

Unfair competition, copying market trend or fad, 1:25

FAILURE TO STATE A CLAIM

Summary judgment, motion to dismiss, **32:121.50 to 32:121.90**

FAIR TRADE

Supreme court constitutional cases on free speech and trademark law, 31:138

FAIR USE

Classic fair use, 11:45
Definitions, 4:17
Descriptive Marks (this index)

FAIR USE—Cont'd

Geographic Terms (this index)
Likelihood of Confusion (this index)
Literary, artistic and entertainment
rights, 10:14
Nominative fair use, 11:45, 23:11
Personal Names (this index)

FALSE ADVERTISING

Generally, **27:1 to 27:121**Actual deception or confusion, proving damages, **27:42**

Ambush advertising, 27:66

Antitrust analogies, monetary remedies, proving damages, **27:44**

Attorney fees, 30:104

"Better than" claims and "tests prove" claims, **27:62**

Causation, monetary remedies, **27:41** Challenged advertising under section 43(a), **27:63**

Commercial Activity (this index)

Commercial statements, 27:54, 27:54.50, 27:55

Common law

generally, 27:1 to 27:15

geographic source, false representation of, **27:5**

geographic terms, remedies, 14:24 single source exception, 27:4, 27:26 standing, 27:1

vicarious avenger of consumer interests, competitor as, 27:2

Comparative advertising, **27:30**, **27:59 to 27:62**

Confusion, proving damages, **27:42**Consumer and noncommercial standing,

27:39 Copyrights, **6:27**

Creation of item, false claim, 27:75

Deception, proof

damages, 27:42

injunctions, 27:36

Descriptive marks, 11:59

Disparagement of product. **Trade Libel and Product Disparagement** (this index)

Distinctiveness, 11:59

Diverted customers, proving damages, 27:42

Doctor Ford case, 27:34

FALSE ADVERTISING—Cont'd	FALSE ADVERTISING—Cont'd
Elements of prima facie case, 27:24	Laches and statute of limitations in &
Evidence, 27:42 to 27:44, 27:53 to 27:58	section 43(a) cases, jurisdiction, 27:48
Examples, 27:72 to 27:76	Lanham Act, 27:6 to 27:112.10
Factual support for comparative	Legislative intent, 27:25
advertising, 27:61 Failure to disclose facts, 27:65	Libel. Trade Libel and Product Disparagement (this index)
False comparative advertising, standing,	Likelihood of damage, standing, 27:31
27:30 Federal question jurisdiction, 27:45,	Literally false or misleading, two part test, 27:53 to 27:55
32:10	Literary, Artistic and Entertainment
Federal Trade Commission, power to	Rights (this index)
prohibit, 27:118	Material misrepresentation, standing,
Final injunctions, standing, 27:36, 27:37	27:35
Food, Drug & Cosmetic Act, Lanham Act claims, 27:65.50	Measures of recovery, monetary remedies, 27:43
Formatting, deceptive, 27:66.70	Media liability, free speech, 27:70
Free speech	Methods of proof, 27:56 to 27:58
generally, 27:67 to 27:71	Misleading statements or literally false,
commercial advertising or promotion, false statements, 27:71	two part test, 27:53 to 27:55
commercial speech, 27:67 to 26:69	Monetary remedies
media liability, 27:70	generally, 27:40 to 27:44
remedies that impact on commercial speech, 27:69	actual deception or confusion, proving damages, 27:42
Generic terms, 12:26, 12:48	antitrust analogies, proving damages, 27:44
Geographic false designation, 14:23	causation, 27:41
origin, false designation of, 27:49	diverted customers, proving damages, 27:42
source, false representation of, 27:5	measures of recovery, 27:43
Good faith, false claim of infringement, 27 :66.40	Native advertising, 27:66.70
Gray market, imported goods, 29:53	Nature of goods, false representations as to, 27:50 to 27:66
Growth of section 43(a), 27:8	Necessary implication, 27:54.50
Imported goods, gray market, 29:53	New York statutes, 27:116
Infringement of patent, false claim, 27:66.40	Non-competitors, 1:8, 1:11, 27:32
Infringement (this index)	Number of people deceived, 27:57
Inherent quality or characteristic, 27:64	Opinion statements, 27:67
Injunctions, standing, 27:27 to 27:33,	Parties liable, 27:52
27:36, 27:37	Patent protection, false claim, 27:66.40
Intent, 27:51, 27:58	
Interstate commerce, jurisdiction, 27:47	Picture of plaintiff's product, use to sell defendant's different product,
Jurisdiction	27:74
generally, 27:45 to 27:48	Preliminary injunctions, standing, 27:36,
federal question, 27:45	27:37
interstate commerce, effect on, 27:47	Prima facie case, elements of, 27:24
Laches and statute of limitations in &	Product disparagement. Trade Libel
section 43(a) cases, 27:48	and Product Disparagement (this
state courts, 27:46	index)

FALSE ADVERTISING—Cont'd FAMILY OF MARKS RULE Protection under trademark, false claim, Likelihood of confusion, 23:61 27:66.20 **FAMOUS MARKS** Proving false representation, 27:34 to Definitions, 4:16 27:38 Dilution of trademarks, 24:104 to Puffing defense, standing, 27:38 24:110, 24:119 Oualities of goods, false representations Doctrine, 29:61 et seq. as to, 27:50 to 27:66 International aspects Registration, false claim, 27:66.20 generally, 29:61 to 29:64 Retailer liability, 27:34.50 description of doctrine, 29:61 Retroactivity of amendments to section NAFTA and GATT TRIPs use of doc-43(a), **27:10** trine, 29:63 Single source exception, common law, Paris Convention and Well-Known 27:4, 27:26 Marks Doctrine, 29:62 Standing spill over of fame between nations, generally, 27:27 to 27:39 29:64 actual deception not necessary, 27:36 Marks Doctrine, 29:62 common law, 27:1 NAFTA and GATT TRIPs use of docconsumer and noncommercial standtrine, 29:63 ing, 27:39 Paris Convention, 29:62 false comparative advertising, 27:30 Strength of marks. 11:78 injunctions, 27:27 to 27:33, 27:36, TRIPs, 29:63 27:37 Well-known Marks doctrine, 29:61 et likelihood of damage, proof of, 27:31 material misrepresentation, 27:35 Well-known works doctrine. 29:63 non-competitors, 27:32 preliminary and final injunctions, FANCIFUL REPRESENTATIONS 27:36, 27:37 Descriptive marks, 7:36 proving false representation, 27:34 to **FASTENER QUALITY ACT** 27:38 PTO registration of insignias, 19:149 puffing defense, 27:38 State courts, jurisdiction, 27:46 FEDERAL ANTI-DILUTION Survey evidence, significance of results, REVISION ACT 32:193 Dilution of trademarks, 24:115 Text of section 43(a), 27:6 to 27:11 FEDERAL DIVERSITY Trade Libel and Product Disparage-JURISDICTION ment (this index) Generally, 32:32 to 32:34 Trademark Law Revision Act, 27:10 Amount in controversy, 32:34 Trademarks and trade dress, examples, Complete diversity, 32:33 27:73 Two part test, literally false or mislead-FEDERAL PREEMPTION ing, 27:53 to 27:55 Copyrights, **6:5**, **6:15** Types of false advertising, 27:63 Dilution of trademarks, 24:80 Unclean hands, 31:54 Literary, artistic and entertainment Vicarious avenger of consumer interests, rights, 10:35, 10:46 competitor as, 27:2 Product designs, Sears-Compco. Product and Container Shapes (this FALSE ENDORSEMENTS index) **Publicity** (this index) Trade dress, 6:15 **FAMILY NAME** Trademarks, 6:15

Unfair competition, 1:18

Personal names, 13:9.50

FEDERAL QUESTION

JURISDICTION Actions after registrations, generally, Generally, 32:2 to 32:19 Advantages of registration in Principal Bankruptcy proceedings, 32:8 Register, 19:9 Covenant not to sue, 32:2.50 Advertising, use of United States flag in, False advertising, 27:45, 32:10 19:79 False or fraudulent registration, damages Allowance of registration, 19:132 from. 32:9 Alternative bases, 19:1 Foreign commerce, infringement must Amendments affect, 32:5 applications, 19:49, 19:58.50, 19:131 Infringement in interstate or foreign disclaimers, 19:70 commerce intent to use applications, 19:18 to generally, 32:3 to 32:8 19:21 bankruptcy proceedings, 32:8 registrations, 19:133 basis of suit must be infringement, Supplemental Register, Trademark 32:4 Law Revision Act, 19:35 foreign commerce, infringement must **Appeal and Review** (this index) affect, 32:5 **Applications** interstate commerce, infringement generally, 19:45.25 to 19:61.50 must affect, 32:5 accuracy of information, 19:51 Lexmark test, **32:3.50** amendment and response after rejecstanding to sue, registrant only, 32:3 tion of application, 19:131 suit filed in state court and removed to amendment of definition of goods and federal court, 32:7 services, 19:49 Interstate commerce, infringement must amendment to drawing of mark in affect, 32:5 application, **19:58.50** Lanham Act, 32:11 classification of goods and services, Licensee standing to sue, 32:18 registration in Principal Register, Non-owner of mark, standing, 32:12 19:56 Patent and Trademark Office decision, defining goods and services, 19:48, 19:49 review in federal court, 32:14 Registered mark, infringement of, 32:18 disclaimers, below **Standing** (this index) division of application, 19:57 State court action and removal. 32:13 drawing of mark in application, below Suit filed in state court and removed to electronic registration communicafederal court, 32:7 tions with USPTO using Internet, 19:45.75 Unfair competition claims, 32:15 elements, 19:45.25 to 19:54 Unregistered marks, infringement of, 32:11 to 32:13 examination of application, below **Venue** (this index) federal court litigation, pending applications, **30:113.50** FEDERAL REGISTRATION form, 19:46 Generally, **19:1 to 19:149** fraud, risks of charge of, 19:51 Abandoned application, petition to Madrid Protocol (this index) revive, **19:125.50** multiple classifications, application Access to pending applications, **19:7** for goods and services falling in, Accuracy of information, applications, 19:56.50 19:51 mutilation, registration of less than **Acquisition and Priority of Rights** whole trademark, 19:59 (this index) one mark per registration, 19:60.50

FEDERAL REGISTRATION—Cont'd

FEDERAL REGISTRATION—Cont'd FEDERAL REGISTRATION—Cont'd Applications—Cont'd Calendar priority and balancing equities, owner of trademark, application must intent to use applications, 19:30 be made by, 19:53 Cancellation petitions, Supplemental Register, 19:41 phantom registrations, 19:61 **Cancellation Proceedings** (this index) Principal Register, registration in, 19:56, 19:56.50 **Certification Marks** (this index) specification of goods and services, Classification of goods and services, 19:48, 19:49 registration in Principal Register, 19:56 specimens of mark, 19:61.50 Clear error rule, 19:24 Trademark Law Treaty changes, Coat of arms of United States, state, 19:45.25 municipality or foreign nation, Approval of government, registration marks that comprise, 19:78, 19:79 does not connote, 19:3.50 Collective Marks (this index) Attack on interstate use, 19:119 Commerce, use necessary to support Attorney, U.S.-based required for registration, 19:83, 19:123, 19:124 foreign domiciled applicants, Common law rights not condition preceregistrant and parties, 19:50 dent to registration, 19:8 Author's comment, 19:60 Composite marks, disclaimers, 19:66 Bars to registration Concurrent cancellations pending in generally, 19:75 to 19:79 court and trademark board, 30:111 advertising, use of United States flag in, 19:79 Contingent injunctions, intent to use applications, 19:26 certification marks, 19:95 Corporate, Business and Professional disparaging marks, 19:77.25 **Trade Names** (this index) flag, coat of arms or insignia of Country of origin of foreign applicant, United States, state, municipality 29:19 or foreign nation, marks that DATCEL precedent, 19:31 comprise, 19:78, 19:79 Defining goods and services, applicaforeign nations and nationals, 29:13 tions, 19:48, 19:49 immoral or scandalous marks, 19:77 Definitions, 4:12 names and symbols, special legisla-Dena precedent, 19:66 tion protecting, 19:78.50 Depletion of word marks, 19:2.50 persons, institutions, beliefs or **Descriptive Marks** (this index) national symbols, marks that Direct association test, 19:81 falsely suggest connection with, 19:76 Disclaimers generally, **19:62 to 19:72** service marks, 19:82 amendment does not eliminate standing to challenge registration, disclaimer, 19:70 19:77.75 confusion, likelihood of, 19:72 Supplemental Register, 19:40 Dena precedent, 19:66 Beliefs, marks that falsely suggest condescriptiveness, concession of, 19:65 nection with, 19:76 Blackout period, intent to use applicaform, 19:71 tions, 19:19 ground for a petition to cancel, 19:69 Bona fide contingent intent to use, **19:17** incontestable registrations, 19:68 purpose, **19:63** Bona fide intention to use, 19:14 to 19:16 unitary and composite marks, 19:66 Buildings, 7:101 unregistrable matter, 19:64 trademark or service mark, 7:101 voluntary disclaimers, 19:67

FEDERAL REGISTRATION—Cont'd	FEDERAL REGISTRATION—Cont'd
Disparaging marks, bars to registration,	Federal court litigation—Cont'd
19:77.25	concurrent cancellations pending in
Division of	court and trademark board,
application, 19:57	30:111
registration, 19:57.50	criteria for cancellation by court, 30:112
Documentary evidence, lack of, 19:14	order to register mark, 30:113
Drawing of mark in application	pending applications, 30:113.50
material alteration rule, 19:58.50	sole basis of action, cancellation can-
standard character and special format word marks, 19:58	not be, 30:110
variance between drawing and speci-	Filing date, requirements, 19:46
men, amendment to drawing,	Final rejection of application, 19:127
19:58.50	Flag of United States, state, municipality
Duration of sales, filing Section 8	or foreign nation, 19:78, 19:79,
affidavits, 19:139	29:24
Electronic registration communications with USPTO using Internet,	Foreign domiciled applicants, registrant and parties require U.Sbased
19:45.75	attorney, 19:50
Eligibility for Principal Register, 19:10	Foreign nations and nationals
Equality and uniformity of examination	generally, 29:9.25 to 29:24
of application under Lanham Act,	bars to registration, 29:13
19:126.50	country of origin of foreign applicant,
Examination of application	29:19
generally, 19:125 to 19:132	export or import trade, 29:9.25
abandoned application, petition to	foreign flags, 29:24
revive, 19:125.50	foreign symbols, 29:23
ex parte appeal, 19:127	inter partes challenges to validity of
final rejection, 19:127	country of origin registration, 29:16
protest letter, 19:130	legal effects of registered marks,
response to examining attorney, 19:128	29:20, 29:21
	Madrid Protocol (this index)
special, petition to make, 19:126 Trademark Manual of Examining Pro-	multiple grounds for application and
cedure, 19:129	registration, 29:15
uniformity and equality of examina-	notice regarding trademark in nations
tion under Lanham Act,	other than U.S., 19:146.50
19:126.50	Protocol protoction Modrid
Ex parte appeal, 19:127	Protocol protection. Madrid Protocol (this index)
Exportation, 19:118	predicate foreign registration, rela-
Extension of time to file statement of	tionship of U.S. registration to,
use, intent to use applications,	29:12
19:25	priority in U.S. based on priority in
Failure to function as a trademark, 19:4.50	foreign nation, 29:17 , 29:18
False claims, 27:66.20	registrations issued to foreign nationals, 19:73, 19:74
Fastener Quality Act, registration of	unregistrable foreign marks, 29:23 ,
insignias with PTO, 19:149	29:24
Federal court litigation	use in United States, 29:11
generally, 30:108 to 30:113.50	Foreign symbols, 29:23
cancellation of registrations, 30:109	Fraud (this index)

FEDERAL REGISTRATION—Cont'd FEDERAL REGISTRATION—Cont'd **Generic Terms** (this index) Intent to use applications—Cont'd use, registration after, 19:28 **Geographic Terms** (this index) Immoral marks, bars to registration, Internet, electronic registration communications with USPTO, 19:45.75 19:77 "In commerce," sale or transportation of **Inter Partes Proceedings** (this index) goods in, 19:117 Issuance of registration, 19:132 Incontestable registrations, disclaimers, Joint ownership of trademarks, 16:41 19:68 Kind of sale or transportation necessary, **Infringement** (this index) 19:111 Initial sales, nature of, 19:115 Laches and delay, 31:33 to 31:34 Insignias Late and defective filings, Section 8 Fastener Quality Act, registration with affidavits, 19:137 PTO, 19:149 **Licenses** (this index) United States, state, municipality or **Likelihood of Confusion** (this index) foreign nation, marks that Literary, artistic and entertainment comprise insignias of, 19:78, rights, 10:38 19:79 Location of designated mark, 19:104, Institutions, marks that falsely suggest 19:108.50 connection with, 19:76 Madrid Protocol (this index) Intent to use applications Marketplace, register reflects, 19:2 generally, 19:12 to 19:31.10 Misuse of notice, 19:146, 19:147 advantages of amendment to allege use, 19:20 Monetary Recovery (this index) amendment to allege use, 19:18 to Multiple classifications, application for goods and services falling in, 19:21 19:56.50 blackout period, 19:19 bona fide Mutilation, registration of less than whole trademark, 19:59 contingent intention to use, 19:17 Names and symbols, special legislation intention to use, 19:14 to 19:16 protecting, 19:78.50 calendar priority and balancing equi-National symbols, marks that falsely ties, 19:30 suggest connection with, 19:76 contingent injunctions, 19:26 Nonuse of mark, Section 8 affidavits, defendant, applicant as, 19:29, 19:31 19:136 extension of time to file statement of use, 19:25 Notice inter partes disputes, 19:31, 19:31.10 generally, 19:144 to 19:148 more than one mark for same goods foreign nations (nations other than or services, 19:15 U.S.), 19:146.50 objective test of bona fide/good faith, misuse of notice, 19:146, 19:147 reasonable efforts to prevent misuse plaintiff, applicant as, 19:26, 19:31.10 of notice, 19:147 procedure for registration, 19:13 "TM" or "Trademark" on labels, use of, author's comment, 19:148 requirements of amendment to allege use, 19:21 use of notice, 19:145 statement of use, 19:23 Objective test of bona fide/good faith, intent to use applications, 19:14 rights of applicant, 19:26 to 19:31.10 One mark per registration, 19:60.50 second stage examination, statement of use, 19:24 One-year period of incubation, Supplemental Register, 19:39 statement of use, 19:22 to 19:25

Paris Convention, 19:74

Supplemental Register, 19:34

FEDERAL REGISTRATION—Cont'd Patent and Trademark Office (this	FEDERAL REGISTRATION—Cont'd Section 8 affidavits—Cont'd
index)	duration of sales, renewal of registra-
Personal Names (this index)	tion, 19:139
Persons, marks that falsely suggest connection with, 19:76	late and defective filings, 19:137 post 1999 practice for late and defec-
Phantom registrations, 19:61	tive filings, 19:137
Presumptions (this index)	renewal of registration, 19:139
Principal Register	six years, filing before end of, 19:135
generally, 19:9 to 19:11, 19:56	ten years, filing every, 19:135
multiple classifications, application	time to file, 19:135 to 19:138
for goods and services falling in, 19:56.50	variance between mark as registered and as used, 19:138
Supplemental Register, compared and	Section 15 affidavits, 19:140
distinguished, 19:36, 19:42	Service marks, 4:7
Principal register, defined, 4:12	Service Marks (this index)
Product and Container Shapes (this index)	Six years, filing Section 8 affidavit before end of, 19:135
Product different from that intended, use of mark on, 19:122	Specification of goods and services, applications, 19:48 , 19:49
Protest letter, examination of application, 19:130	Specific designations, legislation prohibiting registration and use,
Quantum of use necessary, 19:109 to	19:78.50
19:115	Specimens of mark
Related Goods or Services (this index)	applications, 19:61.50
Remedies. Federal court litigation, above	variance between drawing and specimen, 19:58.50
Renewal	Standing to challenge registration,
generally, 19:142 to 19:142.75	19:77.75
duration of sales, filing Section 8	State-federal relationship, 19:8
affidavits, 19:139 post-1999 procedure, 19:142.25	Statement of use, intent to use applications, 19:22 to 19:25
variance between registered mark and	Supplemental Register
mark as used at time of renewal, 19:142.75	generally, 19:32 to 19:43
Republication of trademark, 19:44,	amendments, Trademark Law Revision Act, 19:35
19:45	cancellation petitions, 19:41
Response to examining attorney, 19:128	challenges, 19:41
"Sale," transportation in commerce	cited, later applications, 19:37
without, 19:118 Scandalous marks, bars to registration,	designation need only be capable of trademark significance, 19:38
19:77	intent to use applications, 19:34
Search of marks preparatory to application or selection, 19:6	inter partes challenges, 19:41 inter parties cases, 19:37
Secondary Meaning (this index)	likelihood of confusion test, strict-
Second stage examination, statement of use, 19:24	ness, 19:37 nature, 19:33 to 19:37
Section 8 affidavits	one-year period of incubation, 19:39
generally, 19:135 to 19:138 affidavit of nonuse of mark, 19:136	Principal Register, compared and distinguished, 19:36, 19:42
,	<i>E</i> , ,

FEDERAL REGISTRATION—Cont'd

Supplemental Register—Cont'd secondary meaning, estoppel of proof of. **19:43**

Section 2 bars, 19:40

statutory provisions, 19:32

Trademark Law Revision Act amendments. **19:35**

Supplemental register, defined, **4:12**Symbols and names, special legislation protecting, **19:78.50**

Ten years intervals, filing Section 8 affidavits, **19:135**

Territorial Extent of Rights (this index)

Time to file Section 8 affidavits, **19:135** to **19:138**

Trademark Law Revision Act, 19:5, 19:35

Trademark Law Treaty changes, 19:45.25

Trademark Manual of Examining Procedure, examination of application, 19:129

Trademark registration maintenance programs, **19:120**

Types of registrable marks, 19:4

Uniformity and equality of examination of application under Lanham Act, 19:126.50

Unitary marks, disclaimers, **19:66** Unregistered rights, **19:3.50**

"Use-based" trademark law (U.S.), 19:1.25

Use before registration, 19:1.75

Use necessary to support registration generally, **19:108 to 19:122**

abandonment charges, 19:123

attack on interstate use, 19:119

commerce, 19:83, 19:123, 19:124

Creagri Rule, 19:123

exportation, 19:118

fraud charges based on false claim of use, 19:121

"in commerce," sale or transportation of goods in, **19:117**

initial sales, nature of, 19:115

kind of sale or transportation necessary, **19:111**

labeling laws, use in violation, **19:123** legislative history, **19:110**

FEDERAL REGISTRATION—Cont'd

Use necessary to support registration
—Cont'd

location of designation, **19:108.50** marijuana-related goods and services, **19:124**

modern policy, 19:123

New Generation Rule, 19:123

product different from that intended, use of mark on, 19:122

quantum of use necessary, **19:109 to 19:115**

registration use vs. priority use, **19:116**

"sale," transportation in commerce without, **19:118**

Satinine Precedent, 19:123

trademark registration maintenance programs, 19:120

"Unlawful Use" defense, 19:123

USPTO Patent and Trademark Office (this index)

Variance between drawing and specimen, 19:58.50

Variance between mark as registered and as used, 19:138, 19:142.75

Voluntary disclaimers, 19:67

Word marks, drawing of mark in application, 19:58

FEDERAL SUPPLEMENTAL JURISDICTION

Generally, 32:20 to 32:30

Ancillary federal jurisdiction, 32:30

Compulsory counterclaim, 32:30

Dropping out of federal claims, 32:25

Pendent federal jurisdiction, 32:20

Related claims, 32:24

Retention of case if federal claims drop out. **32:25**

Substantiality of federal claim, 32:28

FEDERAL TRADE COMMISSION

Cancellation proceedings, 20:63

Trade Libel and Product Disparagement (this index)

FICTITIOUS NAME CERTIFICATES

Corporate, business and professional trade names, **9:9**

FIFTH AMENDMENT

Summary judgment, 32:121.25

dence, 32:181

FRAGRANCE MARKS

Generally, 7:106

FILE WRAPPER ESTOPPEL FRAMING Generally, **32:111** Cyberspace, infringement in, 25A:4 FIRST AMENDMENT **FRANCHISES Freedom of Speech** (this index) Generally, 18:65 to 18:78 Agency, tort liability, 18:75 FIRST SALE RULE Code of Ethics, 18:69 Resale of branded goods without Contributory infringement, 25:21 change, 25:41 Defined, 18:66 **FLAGS** Franchisor/franchisee relations, 18:67 Federal registration, 19:78, 19:79, 29:24 Investment rules, generally, 18:70 Negligence, 18:76 FLAVOR MARKS State law controls, 18:68 Generally, 7:107 Strict liability, 18:78 Color indicating flavor, 7:52 Tort liability **FLEA MARKETS** generally, 18:74 to 18:78 Liability of landlord, 25:20 agency, 18:75 negligence, 18:76 **FOOD** strict liability, 18:78 Cheese, 14:18.50 warranty, 18:77 Flavor marks, 7:107 Warranty, tort liability, 18:77 Product disparagement, 27:112.10 Related goods or services, 24:48 FRATERNAL GROUPS Trade names, 9:6 **FOREIGN COURT** Issue preclusion, 32:93 **FRAUD** Generally, 31:59 to 31:89 FOREIGN NATIONS AND Attorney fees, civil liability, 31:87 **NATIONALS** Bona fide intention to use and fraud, Descriptive marks, foreign equivalents 31:78 doctrine, 11:34, 11:35 Burden of proof, 31:68 **Federal Registration** (this index) Cancellation proceedings, 20:58, 31:80 **Infringement** (this index) Causation, civil liability, 31:86 **International Ownership** (this index) Civil liability Inter partes proceedings, 20:114, generally, 31:85 to 31:89 20:117.50 attorney fees, 31:87 **Likelihood of Confusion** (this index) causation, 31:86 Phenomenon of trademarks, 2:6 false registration, 31:85 to 31:89 FOREIGN TRADE substantive liability, 31:88 Extraterritorial reach of the Lanham Act, Commercial activities, misrepresenta-25:58 tion as to, 27:64.50 Consumer protection, 2:23 **FORMAT** Damages resulting from false registra-Likelihood of confusion, 23:52 tion under Lanham Act, 31:85 to FORUM NON CONVENIENS 31:87 Deceptive Usage (this index) Generally, 32:76 Defects in use of mark, 31:72, 31:73 **FOUNDATION** Descriptive nature of mark, fraud as to Survey evidence, introduction into evi-

the generic or descriptive status or

functionality of the mark, 31:69

False advertising, 14:24, 27:1 to 27:121

Elements, 31:61 to 31:68

FRAUD—Cont'd

False claim of use, charges based on, 19:121

False testimony and documents, **31:83** First use, misstatement of date of, **31:74**

Generic nature of mark, fraud as to the generic or descriptive status or functionality of the mark, **31:69**

Geographic terms, false advertising, 14:24

Good faith

bona fide intention to use and fraud, 31:78

failure to disclose use by others, application declaration, **31:76**

History, comparison of trademark and patent fraud, 31:63, 31:64

Inconsistent use of mark, 31:72

Inequitable conduct, pleading fraud in USPTO, 31:84

Intention to use and fraud, 31:78

Knowing use by others, signing the application, **31:75**

Lack of ownership of mark, 31:71

Materiality (this index)

Monopolies and Restraints of Trade (this index)

Omission of use of mark on any or all of goods or services, 31:72, 31:73

Ownership of mark, defects in, 31:70, 31:71

Palming off, 25:3

Patent fraud, compared, **31:62 to 31:67** Pleadings, **31:84**

Post registration declar

Post registration declarations, **31:79**, **31:80**, **31:81**

Procedural contexts, 31:59, 31:60

Promotion, false statements made in, **27:71**

Registration of trademarks and patents, generally, **31:59 et seq.**

Risks of charge of fraud, 19:51

Scienter, 31:66

Signature on application, knowing use by others, **31:75**

State of mind, 31:66

Third persons, failure to disclose use by, 31:75 to 31:77

Types of fraud in procurement of registration, 31:69 to 31:83

FRAUD-Cont'd

Use of mark

bona fide intention to use, 31:78 defects in, 31:70, 31:72, 31:73

failure to disclose of use by others,

application declaration, **31:76** false claim of use, charges based on,

19:121 inconsistent use, 31:72 omission of use, 31:72, 31:73

U.S.P.T.O, common law trademark, 31:60

FREEDOM OF SPEECH

Generally, 31:139 to 31:156.50

Accommodating free speech, two step balancing test, **31:144.50**

Affirmative defense, 31:153, 31:156.50

Applications of the Jack Daniels limitation on the Rogers analysis, 31:144.30

Balancing trademark enforcement with first amendment free speech principles, **31:139**

Commercial speech, 31:139.25 to 31:142

Copyright analogy, 31:156

Criticism of company or product, 31:148

Deceptive commercial speech, 31:139.25 to 31:142

Defenses

generally, 31:139 to 31:156.50

Dilution of trademarks, 24:90

Entertainment free speech, 31:149

Expressive works, unpermitted use of trademarks, **31:149**

False Advertising (this index)

Films, unpermitted use of trademarks, 31:149

First Amendment

generally, 31:139 to 31:152

federal registration, 13:37.50

Government action, 31:143

Internet free speech, 31:148.50

Jack Daniel's case, putting limits Rogers test, 31:144.20

Levels of constitutional protection, 31:140, 31:141

Literary works, unpermitted use of trademark, **31:149**

Medium, significance, 31:152

FREEDOM OF SPEECH—Cont'd	FUNCTIONALITY—Cont'd
New meaning of trademarked words, 31:150	De facto secondary meaning for functional features, 7:66
Nominative fair use, 31:156.50	Defensive functionality
Parody	generally, 7:77.50
affirmative defense, 31:153	aesthetic, 7:82
copyright analogy, 31:156	Job's Daughters precedent, 7:82
infringement, 31:154	Design patents
non-infringement, 31:155	generally, 6:11 , 7:90 to 7:93
Publicity (this index)	dual design patent and trademark
Putting limits Rogers test, Jack	protection, 7:91
Daniel8217s case, 31:144.20	evidence of non-functionality, 7:93
Rogers test	nature, 7:90
procedural aspects, 31:144.70	Shredded Wheat case, 7:92
putting limits, Jack Daniel8217s case, 31:144.20	Dual design patent and trademark protection, 7:91
Significance of medium, 31:152	Evidence, 7:74, 7:75, 7:93
Supreme court constitutional cases on	Evidentiary weight of utility patent,
free speech and trademark law,	7:89.30
31:138	Fact issue, functionality as, 7:71
Trade libel and product disparagement,	Fair competition, utilitarian functional-
27:105 to 27:108	ity, 7:78
Trademark	Fan loyalty, 7:82
property right, 31:144	Functional use of mark and "defensive"
third person, owned by, use to convey	functionality, 7:77.50
message, 31:145	Illustrative lists, 7:85, 7:86
T-shirts as medium, 31:152 Unauthorized communicative uses of	Images, 7:83
trademark, 31:146 to 31:150	Incontestable registration, 7:84
	Instruction to jury, defining functionality, 7:69.50
FREEZING ASSETS	Jury instruction, defining functionality,
Counterfeiting, preliminary injunctions, 30:40	7:69.50
30:40	New meanings for trademarked words,
FUNCTIONALITY	3:3
Generally, 3:1 to 3:7, 7:63 to 7:93	Norton-Norwich Four Factors analysis,
Aesthetic functionality	7:73
generally, 7:79 to 7:83	Packaging materials, 7:87
defense, 7:82	Patent-like rights of exclusion, 7:64
1938 Restatement and Pagliero case,	Patents, 6:10
7:79	Pictures, 7:37
uneven use in modern courts, 7:80	Policy, 7:63 to 7:65 Pagistration affect of 7:84
words that are the product, 7:83 Available alternative designs, 7:65	Registration, effect of, 7:84 Repeating marks, 7:32
Bar of, color secondary meaning, 7:44	Rule against trademark protection, 7:63
Burden of proof, utilitarian functionality,	Shapes and designs
7:72	de facto secondary meaning, 15:23
Cancellation proceedings, 20:50 ,	trade dress protection, 6:10
20:56.50	Trade dress, packaging, 6:10
Color, 7:44 , 7:49 , 7:88	Traffix case, 7:89, 7:89.30
Competition, 7:65	Two-dimensional functional designs,
Court definition survey, 7:69	7:77

FUNCTIONALITY—Cont'd	GENERIC TERMS—Cont'd
Utilitarian functionality	Color, 7:52
generally, 7:67 to 7:78	Combination of descriptive terms, 11:26
alternative designs available, 7:75	"Common descriptive name" changed
burden of proof, 7:72	to "generic name," statutory
combination of functional and non-	change, 1989, 12:21
functional features, 7:76	Composite marks, 11:28.50 , 12:39
defendant's functional use of mark	Consumer surveys, 12:14 to 12:17
and "defensive" functionality,	De facto secondary meaning
7:77.50	generally, 12:47 to 12:51, 15:24
"defensive" functionality, 7:77.50	evidence of association with generic
definitions, 7:67 to 7:69.50	name, 12:47
evidence, 7:74	generic name to some, trademark to
fact issue, functionality as, 7:71	others, 12:51
fair competition, 7:78	protection to generic names, 12:48
jury instruction, defining functional-	single source of product, 12:49
ity, 7:69.50	unique product or service, 12:50
look to functionality of claimed feature or features, 7:70	Dictionaries, prevention of generic use in, 12:28
promotion touting utilitarian advan-	Dictionary definitions, 12:13
tages, 7:74	Dilution of trademarks, 24:75
two basic policies, 7:68	Domain name generic and top level
two-dimensional functional designs,	combinations, 12:39.50
7:77	Domestic industries, government protec-
Utility patents, 7:89 to 7:89.70	tion, 12:32.50
Vornado analysis, 7:68	Dropping the generic name in common
Web pages, 3:7	usage, 12:8
Words, new meanings, 3:3, 4:1	Enforcing a mark, prevent genericness, 12:29
Words that are the product, aesthetic	Evidence, 12:12, 12:13
functionality, 7:83	False advertising, 12:26 , 12:48
GATT	Federal registration
Generally, 29:36	generally, 12:56 to 12:60
Abandonment of rights, 17:19	Principal Register, 12:58
Geographic terms deceptive usage,	status of registration, 12:60
14:22, 14:32, 14:40	statutory provisions, 12:56
GENERIC TERMS	Supplemental Register, 12:59
Generally, 12:1 to 12:60	Foreign generic terms, 12:44
Abandonment of rights, 17:8	generally, 12:41 to 12:45
Abbreviations, 12:37	adoption as generic names in Ameri-
Absolute bar, 12:22	can usage, 12:44.50
Adjective-noun debate, product attri-	another English-speaking nation,
bute, 12:10	12:43
Appropriation of previously generic term, 12:11	doctrine of foreign equivalents, 12:41
Burden of proof, 12:12	foreign prefixes, 12:42
Buyer understanding test, 12:11	illustrative examples, 12:45
Cancellation proceedings, 20:50 , 20:56	list of non-english language words
Class of buyers, meaning to, 12:4	held to be generic names in the
Closely related goods or services, 12:24	United States, 12:45
Coined words, 11:9 , 12:17.50	spelling variants or phonetic equivalents, 12:44

GENERIC TERMS—Cont'd	GENERIC TERMS—Cont'd
Fraud, 31:69, 31:99	Phonetic equivalents, foreign generic
Game, name of, 12:35	terms, 12:44
Generic name to some, trademark to	Pictures, 7:37
others, 12:51	Plant varietal names, 12:36
Generic trade dress, 8:6.50 , 12:36.50	Precautions to prevent generic use
Genus of products, 12:23	generally, 12:26 to 12:29
Geographic Terms (this index)	enforcing a mark, prevent generic-
Highly descriptive	ness, 12:29
category, Trademark Board, 12:22 terms, distinguished	media and dictionaries, prevention of generic use in, 12:28
generally, 12:20 to 12:22	product and brand, creation of, 12:26
category, Trademark Board, 12:22	trademark, use of generic name with,
"Common descriptive name"	12:27
changed to "generic name,"	Primary significance test, 12:6, 12:7
statutory change, 1989, 12:21	Principal generic significance, 12:6 to
describing versus naming, 12:20	12:8
naming versus describing, 12:20	Principal Register, 12:58
Illustration of product, 12:34	Product and brand, creation of, 12:26
Illustrative examples, 12:18, 12:19	Product attribute, 12:10
Ingredients, 12:23	Professional buyers, meaning to, 12:5
Inter partes proceedings, standing,	Public policy, 12:2
opposition, 20:11	Purchaser motivation test, 12:7
Irrelevancy of surveys, minority view, 12:17.25	Raising generic terms from public domain, 12:30 to 12:32.50
Languages, 12:41	Relevant public, 12:5
Likelihood of confusion, 23:49	Seats decision and rule, 12:22
Literary, artistic and entertainment	Secondary meaning
rights, series titles, 10:9	de facto secondary meaning, above
Logo registrations, 12:40	Single source
Majority use controls, 12:6	cases, consumer survey, 12:17
Media, prevention of generic use in, 12:28	product, de facto secondary meaning, 12:49
Media use of evidence, 12:13	Spelling variations, 12:38
Misspellings, 12:38	Statutory provisions, federal registra-
Monopolies and restraints of trade,	tion, 12:56
31:99	Steelbuilding decision, 12:39.50
Multiple generic names for same product, 12:9	Supplemental Register, 12:59 , 19:38 Survey evidence, 12:14 to 12:17.25 ,
New products and services, 12:25	32:192
Non-trademark remedies for misuse,	Surveys, generally, 12:17.50
12:2	Teflon consumer survey, 12:16
Nonword symbols, 12:36.50	Terms held to be a generic name, not a
Opposition proceedings, standing, 20:11	trademark, 12:18
Part of country, generic in, 12:8.50	Terms that were challenged as being a
Patent, expiration of	generic name, but found not to be
Supreme Court cases, reconciling,	generic, 12:19
12:53	Test for genericness, generally, 12:4 to
trademark does not automatically	12:19 Testiment of newsons in trade 12:13
become generic, 12:52	Testimony of persons in trade, 12:13
Personal names, 12:33, 12:34	Thermos consumer survey, 12:15

GENERIC TERMS—Cont'd	GEOGRAPHIC TERMS—Cont'd
Timing	Deceptive usage—Cont'd
generally, 12:17.50	NAFTA Amendments, 14:31
critical date for genericness survey,	registration, 14:25
12:17.75	service-place association test,
evidence, 12:13	14:33.50
Types of generic use, 12:33 to 12:36.50 Unique product or service, de facto sec-	suggestive names and prestige locations, 14:36
ondary meaning, 12:50	three part test, 14:32.50
Use of evidence by competitor and plaintiff, 12:13	wine and liquor, misleading geographic indications of, 14:40
Who are you - what are you test, 12:2	Descriptiveness
Windows case, 12:30	generally, 14:2 to 14:11
GEOGRAPHICALLY REMOTE USE	composite geographic marks, 14:11 CONTINENTAL, 14:6
Territorial Extent of Rights (this index)	earth, locations on, 14:3
maex)	earthly origins, indications of, 14:4
GEOGRAPHIC TERMS	illustrative examples, 14:6.50, 14:8
Generally, 14:1 to 14:40	NATIONAL, 14:6
Absolute injunctions, fair use, 14:15	non-descriptive and arbitrary usage,
Appeal and review, three part test,	14:7
deceptive usage, 14:32.50 Cheese types, 14:18.50	non-earthly origins, indications of, 14:5
Collective marks, regional certification	secondary meaning, 14:9
marks and, 14:21	value indications, 14:6
Commercially named locations, fair use,	Earth, locations on, 14:3
14:16 Common law remedies for false	Earthly origins, indications of, 14:4
advertising of geographic origin,	Fair use
14:24	generally, 14:12 to 14:17
Composite geographic marks,	absolute injunctions, 14:15
descriptiveness, 14:11	balancing rights of users, 14:13
CONTINENTAL, vague geographical	commercially named locations, 14:16
indication, 14:6 Deceptive usage	federal recognition of right to describe location, 14:17
generally, 14:22 to 14:25, 14:30 to	limited right to indicate location,
14:40	14:12
appeal and review, three part test,	qualified injunctions, 14:14
14:32.50	False advertising, 14:24 , 27:5 , 27:49
common law remedies, 14:24	False designation of geographic origin,
false designation of geographic origin, 14:23	14:23 Federal registration
federal registration, generally, 14:30	generally, 14:26 to 14:40
to 14:39	deceptive usage, 14:30 to 14:39
GATT provisions, 14:22, 14:32,	geographic marks, 14:26
14:40	interpretation of statute, 14:28
material goods-place association test,	misleading, 14:30
14:33	primarily geographically descriptive
materiality, 14:39	marks, 14:27 to 14:29
misdescriptive marks, 14:30 to 14:36 multi-step test, 14:34	test for geographical descriptiveness, 14:29

GEOGRAPHIC TERMS—Cont'd GEOGRAPHIC TERMS—Cont'd GATT provisions, deceptive usage, 2003 Le Marais Rule, **14:33.50** 14:22, 14:32, 14:40 United States compared to E.U. 14:1.50 Generic designations Unites States Appellations of Origin for generally, 12:33 Wine, generic designations, 14:19.50 geographic descriptive, but not generic, 14:20 Value indications, descriptiveness, 14:6 regional certification marks and col-Waltham Watch, key precedent, 14:13 lective marks, 14:21 Wine and liquor Unites States Appellations of Origin generic designations, 14:19, 14:19.50 for Wine, 14:19.50 misleading geographic indications, wine and liquor, 14:19, 14:19.50 14:40 Generic name GEOMETRIC SHAPES AND generally, 14:18 to 14:21 SYMBOLS type of product, 14:18 Generally, 7:33, 7:34 Geographical indications, 14:1.50 Geographic descriptive, but not generic, **GLOBAL REALITY** 14:20 Generally, 2:6 Goods-place association test, deceptive **GOOD FAITH** usage, 14:33 Acquisition and priority of rights, bad Indications, geographical, 14:1.50 faith and add-on use, 16:10 Injunctions, fair use, 14:14, 14:15 Cyberspace, infringement in (this Liquor. Wine and liquor, below index) Lisbon Agreement, 14:1.50 Failure to conduct trademark search, Material goods-place association test, 23:117.50 deceptive usage, 14:33 False advertising, alleged patent Materiality, deceptive usage, 14:39 infringement, **27:66.40** Misleading, federal registration, 14:30 Fraud (this index) NAFTA Amendments, deceptive usage, Infringement suits, 31:102 14:31 **Personal Names** (this index) NATIONAL, vague geographical indica-Territorial Extent of Rights (this tion, 14:6 index) Non-earthly origins, indications of, 14:5 Unfair competition, 1:8, 1:11 Paris Convention, 14:1.50 GOODS IN TRADE REJECTION Prestige locations, deceptive usage, 14:36 Service marks, sale of incidental goods, 19:87 Qualified injunctions, fair use, 14:14 Regional certification marks and collec-**GOOD WILL** tive marks, generic designations, Generally, 2:15 to 2:21 14:21 Abandonment of rights, 17:14 Registration, deceptive usage, 14:25 Assignments, 18:2 Relevant goods test, 14:33 Buying habits, 2:18 Secondary meaning, descriptiveness, Continued business, 2:16, 2:17 14:9 Defined, 2:17 Service-place association test, deceptive Methods of valuation, 2:21 usage, 14:33.50 Symbol of, 3:2 Suggestive names, deceptive usage, 14:36 Tax valuation, 2:21 Swiss Army Knife precedent, 14:23 Valuation of trademark, 2:20 Three part test, deceptive usage, appeal Value of business beyond tangible and review, 14:32.50 assets, 2:19

GOVERNING LAW

Choice of Law (this index)

GOVERNMENT MARKS

Generally, 1:7

Corporate, business and professional trade names, **9:7.75**

GRADE DESIGNATIONS

Descriptive Marks (this index)

Numbers, 7:16

GRAY MARKET

Imported Goods (this index)

GRIPE SITES

As trademark infringement, **25A:44**As UDRP violation, **25A:33**Using the trademark of the target, **25A:45**

GULLIBILITY

Deceptive and deceptively misdescriptive marks, 11:61

GUTHRIE PRECEDENT

Territorial extent of rights, 26:35

HAGUE CONVENTION

Treaties, 29:36.50

HASHTAGS

Trademark and trade dress formats, 7:17.70

Trademark infringement on the internet, 25A:4.50

HAWAII ANTI-CYBERSQUATTING

Infringement in cyberspace, 25A:86

HEARINGS

Contempt, attack on injunction at contempt hearing, **30:18**

Preliminary injunctions

generally, 30:54

counterfeiting, post-seizure hearing, **30:43**

unclean hands, 31:56

HEARSAY

Likelihood of confusion, 23:15 Survey evidence, 32:167 to 32:169

HISTORIC STRUCTURES

Dilution of trademarks, 24:134

HISTORY

Generally, **5:1 to 5:11**

Anglo-American common law, 5:2

Early origins of trade symbols, 5:1

Fear of monopoly power, 1:4

Lanham Act (this index)

Unfair competition, 1:15 to 1:19

United States trademark legislation, 5:3

HOLDOVER LICENSES

Damages, reasonable royalties, **30:86** Preliminary injunctions, irreparable injury, **30:48**

HOUSE MARKS

Generally, 7:5

Likelihood of confusion, 23:43

Literary, artistic and entertainment rights, **10:15**

ICANN (INTERNET CORPORATION FOR ASSIGNED NAMES AND NUMBERS)

Cyberspace, infringement in, 25A:12
Dispute resolution. Uniform Dispute
Resolution Procedure (UDRP)
(this index)

IDENTIFICATION

Generally, 3:8

Name of owner, 3:9

Trade dress, need for identification of elements, 8:3

IMMORALITY

Cancellation proceedings, standing required to petition to cancel on grounds of immoral or scandalous, **20:50.50**

IMPLIED LICENSE

Modern rule of licensing, 18:43.50

IMPORTED GOODS

Generally, 29:37 to 29:55

Antitrust, gray market goods, 29:52

Country of origin marketing requirements, **29:54**

Disclosure, gray market, 29:47

Early attempts to deal with gray market goods, **29:51.25**

False representations, gray market, **29:53**

IMPORTED GOODS—Cont'd INCIDENTAL USE Gray market Publicity, 28:7.50 generally, 29:46 **INCOME TAXES** antitrust questions, 29:52 Monetary recovery deductions to arrive deception and confusion, 29:51 at profits, 30:67 disclosure, 29:47 INCONVENIENCE early attempts to deal with gray mar-**Venue** (this index) ket goods, 29:51.25 false representations, 29:53 **INDEMNITY** legal sources for prohibition, 29:48 Insurance for infringement claims, duty Lever-Rule. 29:50.50 to indemnify, 33:3 likelihood of confusion, 29:46 Monetary recovery, 30:78 material differences rule. 29:51.75 INDIAN TRIBES Tariff Act. 29:49 Infringement of official insignia, territoriality principle, 29:51 25:67.50 trademark infringements, "material INEQUITABLE CONDUCT differences" rule, 29:51.75 Pleading fraud in USPTO, 31:84 Identification of foreign manufacturing source or domestic importer of gray **INFOMERCIALS** goods, 29:51.25 Acquisition and priority of rights, Infringements, importation into United federal registration, 16:32.30 States, 29:56 INFORMATIONAL WORDS AND International Trade Commission **SLOGANS** proceedings, 29:55 Generally, 3:5 Lanham Act Lever Rule, 29:50.50 INFRINGEMENT Legal sources for prohibition, gray mar-Generally, 25:1 to 25:67.50 ket, **29:48** Abandonment of rights, failure to prose-Lever-Rule, gray market, 29:50.50 cute infringers, 17:17 Likelihood of confusion, gray market, **Acquiescence** (this index) 29:46 Advertising Material differences between genuine comparative advertising, 25:52 goods and gray goods, 29:51.75 false claim of patent infringement, Monopolies and restraints of trade, gray 27:66.40 market goods, 29:52 **Insurance** (this index) Parallel imports of genuine goods, 29:46 the sale of goods and services bearing Recordation of registered mark with an infringing mark, 25:27 U.S. Customs Service, 29:38 trademarked products, advertising Recordation of trade names with U.S. goods to fit or use with, 25:51, Customs, 29:41 25:51.50 Seizure, 29:45 Assignments, bankrupt company, Seizure, infringing or counterfeit mark, 18:64.50 29:37 Burden of proof, plaintiff, 1:2 Seizure procedures, 29:42 Certification marks, 19:92.50 Tariff Act, gray market, 29:49 Changes in Goods and Labels (this index) Territoriality principle, gray market, Clipart and logos, collections of, 29:51 25:52.50 INCIDENTAL GOODS Collections of logos and clipart, Service marks, 19:87 25:52.50

INFRINGEMENT—Cont'd	INFRINGEMENT—Cont'd Delay. Laches and Delay (this index)
Commerce generally, 25:53 to 25:56	Design patents, 6:11
definition of interstate commerce,	Dilution of Trademarks (this index)
mark in 8220commerce,8221	Distributors and Dealers (this index)
25:55	Elements of trade dress claim, 7:59, 8:1
Federal Question Jurisdiction (this	Extraterritorial reach of the Lanham Act,
index)	25:58
foreign commerce, 25:53	Federal CDA immunity, internet service
internet, infringing use on, 25:54.50	provider
interstate commerce, 25:53	state claim, 22:4.50
Lanham Act	trademark infringement, 25A:42.50
internet, infringing use on, 25:54.50	Federally registered marks
local and intrastate infringement,	generally, 25:26 to 25:29
25:56	classification of goods and services,
must be in 8220commerce,8221	19:56
25:54	innocent infringement of printers,
mark in 8220commerce,8221 defini-	publishers and broadcasters,
tion of interstate commerce,	25:29
25:55	liability, transport infringing goods,
Commercial marks, goods and services, 10:22	25:27.50
Comparative advertising, 25:52	printers and labelers, 25:28
Computer products, advertising as com-	sales and advertising, 25:26
patible, 25:51.50	search engine liability for allowing
Contributory Infringement (this	searches of plaintiff 8217s
index)	trademark, 25:28.50
Copyrights, 6:23 , 6:24 , 6:27	Federal Question Jurisdiction (this index)
Counterfeiting compared to, 25:15.50	Foreign government, infringement by,
Counterfeiting (this index)	25:64
Cyberspace, Infringement in	Foreign infringement
Dealers. Distributors and Dealers (this index)	generally, 29:55.25 to 29:60
Defenses	importation of infringements into
generally, 31:1 to 31:160	United States, 29:56
Acquiescence (this index)	presumption against U.S. federal law
cyberspace, infringement in, 25A:17	extraterritoriality, 29:55.25
delay. Laches and Delay (this index)	reach of the Lanham Act, activities
Fraud (this index)	outside the United States, 29:57
Freedom of Speech (this index)	tests used by circuit courts, prior to
Jus Tertii (this index)	Abitron decision, 29:59
Laches and Delay (this index)	Fraud (this index)
Monopolies and Restraints of Trade	Freedom of Speech (this index)
(this index)	Imported Goods (this index)
restraints of trade. Monopolies and	Incorporation as, 9:3, 9:8
Restraints of Trade (this index)	Indian tribes, infringement of official
Section 43(a) of Lanham Act, 27:19	insignia of, 25:67.50
Unclean Hands (this index)	Innocent infringement of printers, publishers and broadcasters, 25:29
Definition of interstate commerce, mark in 8220commerce,8221 25:55	Insurance (this index)

Internet infringing use on, Lanham Act, 25:54.50 service provider, Federal CDA immunity state claim, 22:4.50 trademark infringement, 25A:42.50 Intrastate commerce, controlling power, Lanham Act, 25:55 Jus Tertii (this index) Labelers, federally registered marks, 25:28 Labor union, infringement by, 25:59 Laches and Delay (this index) Lanham Act commerce internet, infringing use on, 25:54.50 must be in 8220commerce,8221 25:54 elements of trade dress infringement, 7:59 extraterritorial reach, 25:58 Licensees generally, 25:30 to 25:33 ex-licensee, use by, 25:31 to 25:33 merger rule, use by ex-licensee, 25:32 sale of licensee's rights, 25:33 unauthorized use, 25:30 Likelihood of Confusion (this index) Local and intrastate infringement, Lanham Act, 25:56 Logos and clipart, collections of, 25:52.50 Mark in 8220commerce,8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monotary recovery, section 43(a) of Lanham Act, 27:23 Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services, Use of Mark on (this index) Unfair competition, 1:11 Non-Competitive Goods or Services, Use of Mark on (this index) Unfair competition, 1:11 Non-Competitive Goods or Services, Use of Mark on (this index) Unfair competition, 1:11 Non-Competitive Goods or Services, Use of Mark on (this index) United States government, infringement by, 25:59 United States government, infringement by, 25:59 United States government, infringement	INFRINGEMENT—Cont'd	INFRINGEMENT—Cont'd
service provider, Federal CDA immunity state claim, 22:4.50 trademark infringement, 25A:42.50 Intrastate commerce, controlling power, Lanham Act, 25:55 Jus Tertii (this index) Labelers, federally registered marks, 25:28 Labor union, infringement by, 25:59 Laches and Delay (this index) Lanham Act commerce internet, infringing use on, 25:54.50 local and intrastate infringement, 25:56 must be in 8220commerce, 8221 25:54 elements of trade dress infringement, 7:59 extraterritorial reach, 25:58 Licensees generally, 25:30 to 25:33 ex-licensee, use by, 25:31 to 25:33 merger rule, use by ex-licensee, 25:32 sale of licensee's rights, 25:33 unauthorized use, 25:30 Likelihood of Confusion (this index) Local and intrastate infringement, Lanham Act, 25:56 Logos and clipart, collections of, 25:52.50 Mark in 8220commerce, 8221 definition of interstate commerce, 25:55 Monotary recovery, section 43(a) of Lanham Act, 27:23 Monotoness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services,		
service provider, Federal CDA immunity state claim, 22:4.50 trademark infringement, 25A:42.50 Intrastate commerce, controlling power, Lanham Act, 25:55 Jus Tertii (this index) Labelers, federally registered marks, 25:28 Labor union, infringement by, 25:59 Laches and Delay (this index) Lanham Act commerce internet, infringing use on, 25:54.50 local and intrastate infringement, 25:56 must be in 8220commerce, 8221 25:54 elements of trade dress infringement, 7:59 extraterritorial reach, 25:58 Licensees generally, 25:30 to 25:33 ex-licensee, use by, 25:31 to 25:33 merger rule, use by ex-licensee, 25:32 sale of licensee's rights, 25:33 unauthorized use, 25:56 Logos and clipart, collections of, 25:52.50 Mark in 8220commerce, 8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monopolies and Restraints of Trade (this index) Moontary recovery, section 43(a) of Lanham Act, 27:23 Monopolies and Restraints of Trade (this index) Moonters, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services,		
immunity state claim, 22:4.50 trademark infringement, 25A:42.50 Intrastate commerce, controlling power, Lanham Act, 25:55 Jus Tertii (this index) Labelers, federally registered marks, 25:28 Labor union, infringement by, 25:59 Laches and Delay (this index) Lanham Act commerce internet, infringing use on, 25:54.50 Local and intrastate infringement, 7:59 extraterritorial reach, 25:58 Licensees generally, 25:30 to 25:33 ex-licensee, use by, 25:31 to 25:33 merger rule, use by ex-licensee, 25:32 sale of licensee's rights, 25:33 unauthorized use, 25:30 Mark in 8220commerce,8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monetary recovery, section 43(a) of Lanham Act, 27:23 Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services,		
rademark infringement, 25A:42.50 Intrastate commerce, controlling power, Lanham Act, 25:55 Jus Tertii (this index) Labelers, federally registered marks, 25:28 Labor union, infringement by, 25:59 Laches and Delay (this index) Lanham Act commerce internet, infringing use on, 25:54.50 local and intrastate infringement, 25:56 must be in 8220commerce, 8221 25:54 clements of trade dress infringement, 7:59 extraterritorial reach, 25:58 Licensees generally, 25:30 to 25:33 merger rule, use by ex-licensee, 25:32 sale of licensee's rights, 25:33 merger rule, use by ex-licensee, 25:32 sale of licensee's rights, 25:33 munuthorized use, 25:30 Likelihood of Confusion (this index) Looa and intrastate infringement, Lanham Act, 25:56 Logos and clipart, collections of, 25:52.50 Mark in 8220commerce, 8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services,		
trademark infringement, 25A:42.50 Intrastate commerce, controlling power, Lanham Act, 25:55 Jus Tertii (this index) Labelers, federally registered marks, 25:28 Labor union, infringement by, 25:59 Laches and Delay (this index) Lanham Act commerce internet, infringing use on, 25:54.50 local and intrastate infringement, 25:56 must be in 8220commerce,8221 25:54 elements of trade dress infringement, 7:59 extraterritorial reach, 25:58 Licensees generally, 25:30 to 25:33 ex-licensee, use by, 25:31 to 25:33 merger rule, use by ex-licensee, 25:32 sale of licensee's rights, 25:33 unauthorized use, 25:30 Likelihood of Confusion (this index) Local and intrastate infringement, Lanham Act, 25:56 Logos and clipart, collections of, 25:52.50 Mark in 8220commerce,8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monopolies and Restraints of Trade (this index) Moontess, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services Printers, federally registered marks, 25:28, 25:29 Related Goods or Services (this index) Restraints of Trade (this index) Sale and advertising uses, 25:26 Sale of licensee's rights, 25:33 Section 43(a) of Lanham Act generally, registered marks, 21:10 and advertising uses, 25:26 Sale of licensee's rights, 25:33 section 43(a) of Lanham Act generally, registered (this index) Restraints of Trade, (Monopolies and Restraints of Trade (this index) Restraints of Trade, (Monopolies and Restraints of a trade, Monopolies and Restraints of a trade of licensee's rights, 25:33 section 43(a) of Lanham Act, 27:12 uncleaset, a variation of interstate commerce, 25:32 Monopolies and Restraints of Trade (this index)	·	
Intrastate commerce, controlling power, Lanham Act, 25:55 Jus Tertii (this index) Labelers, federally registered marks, 25:28 Labor union, infringement by, 25:59 Laches and Delay (this index) Lanham Act commerce internet, infringing use on, 25:54.50 local and intrastate infringement, 25:56 must be in 8220commerce,8221 25:54 elements of trade dress infringement, 7:59 extraterritorial reach, 25:58 Licensees generally, 25:30 to 25:33 merger rule, use by ex-licensee, 25:32 sale of licensee's rights, 25:33 unauthorized use, 25:30 Likelihood of Confusion (this index) Local and intrastate infringement, Lanham Act, 25:56 Logos and clipart, collections of, 25:52.50 Mark in 8220commerce, 8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monetary recovery, section 43(a) of Lanham Act, 27:23 Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services,		· · · · · · · · · · · · · · · · · · ·
Lanham Act, 25:55 Jus Tertii (this index) Labelers, federally registered marks, 25:28 Labor union, infringement by, 25:59 Laches and Delay (this index) Lanham Act commerce internet, infringing use on, 25:54.50 local and intrastate infringement, 7:59 extraterritorial reach, 25:58 Licensees generally, 25:30 to 25:33 ex-licensee, use by, 25:31 to 25:33 merger rule, use by ex-licensee, 25:32 sale of licensee's rights, 25:33 unauthorized use, 25:30 Likelihood of Confusion (this index) Local and intrastate infringement, Lanham Act, 25:56 Logos and clipart, collections of, 25:52.50 Mark in 8220commerce, 8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services (this index) Remedies (this index) Restraints of Trade. (Monopolies and Restraints of Trade (this index) Restraints of Trade. (Monopolies and Restraints of Trade (this index) Restraints of Trade (this index) Restraints of Trade. (Monopolies and Restraints of Trade (this index) Sale and advertising uses, 25:26 Sale of licensee's rights, 25:33 ection 43(a) of Lanham Act generally, 27:12 to 27:23 defenses, 27:19 development into federal source of assertion, infringement, unregistered marks, 27:12 monetary recovery, 27:23 non-owner of mark has standing, 27:21 state claim, avoiding section 43(a) to bring, 27:16 substantive content of section 43(a), 27:18, 27:19 unregistered marks, claim for infringement of, 27:15 Standing, 27:20, 27:21 state claim, avoiding section 43(a) of Lanham Act, 27:20, 27:21 State claim avoiding section 43(a) to bring, 27:16 internet service provider, Federal CDA immunity, 22:4.50 State godes of Services (this index) Local and advertising uses, 25:26 sale of licensee's rights, 25:33 non-owner of mark has standing, 27:21 unregistered marks, claim for infringement of, 27:18 state claim, avoiding section 43(a) to bring, 27:16 internet service provider, Fede	•	
Labelers, federally registered marks, 25:28 Labor union, infringement by, 25:59 Laches and Delay (this index) Lanham Act commerce internet, infringing use on, 25:54.50 local and intrastate infringement, 25:56 must be in 8220commerce, 8221 25:54 elements of trade dress infringement, 7:59 extraterritorial reach, 25:58 Licensees generally, 25:30 to 25:33 merger rule, use by ex-licensee, 25:32 sale of licensee's rights, 25:33 merger rule, use by ex-licensee, 25:32 sale of licensee's rights, 25:33 unauthorized use, 25:30 Likelihood of Confusion (this index) Local and intrastate infringement, Lanham Act, 25:56 Logos and clipart, collections of, 25:52.50 Mark in 8220commerce, 8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monetary recovery, section 43(a) of Lanham Act, 27:10 outline of claim, 27:13 standing, 27:20, 27:21 state claim, avoiding section 43(a) to bring, 27:16 substantive content of section 43(a), 27:18, 27:19 unregistered marks, claim for infringement of, 27:14 unregistered marks, claim for infringement of, 27:15 Standing, section 43(a) of Lanham Act, 27:20, 27:21 state claim, avoiding section 43(a) to bring, 27:16 substantive content of section 43(a), 27:18, 27:19 unregistered marks, 21:12 monetary recovery, 27:23 non-owner of mark has standing, 27:21 outline of claim, 27:13 standing, 27:20, 27:21 state claim, avoiding section 43(a) to bring, 27:16 substantive content of section 43(a), 27:18, 27:19 unregistered marks, 21:12 monetary recovery, 27:23 non-owner of mark has standing, 27:21 outline of claim, 27:13 standing, 27:20, 27:21 state claim, avoiding section 43(a) to bring, 27:16 substantive content of section 43(a), 27:18, 27:19 unregistered marks, claim for infringement of, 27:15 Standing, 27:20, 27:21 State claim, avoiding section 43(a) to bring, 27:16 substantive content of section 43(a), 27:18, 27:19 unregistered trade dress and trade names, claim for infringement of, 27:15 state claim avoiding section 43(a) to bring, 27:16 substantive content of section 43(a		Related Goods or Services (this index)
Labelers, federally registered marks, 25:28 Labor union, infringement by, 25:59 Laches and Delay (this index) Lanham Act commerce internet, infringing use on, 25:54.50 local and intrastate infringement, 7:59 extraterritorial reach, 25:58 Licensees generally, 25:30 to 25:33 merger rule, use by ex-licensee, 25:32 sale of licensee's rights, 25:33 merger rule, use by ex-licensee, 25:32 sale of licensee's rights, 25:33 merger rule, use by ex-licensee, 25:32 sale of licensee's rights, 25:33 merger rule, use by ex-licensee, 25:32 sale of licensee's rights, 25:33 merger rule, use by ex-licensee, 25:32 sale of licensee's rights, 25:33 merger rule, use by ex-licensee, 25:32 sale of licensee's rights, 25:33 mon-owner of mark has standing, 27:21 outline of claim, 27:13 standing, 27:20, 27:21 state claim, avoiding section 43(a) to bring, 27:16 substantive content of section 43(a). 27:18, 27:19 unregistered marks, 21:12 monetary recovery, 27:22 monetary recovery, 27:23 non-owner of mark has standing, 27:21 outline of claim, 27:13 standing, 27:20, 27:21 state claim, avoiding section 43(a) to bring, 27:16 substantive content of section 43(a). 27:18, 27:19 unregistered marks, 27:12 monetary recovery, 27:22 monetary recovery, 27:23 non-owner of mark has standing, 27:21 outline of claim, 27:13 standing, 27:20, 27:21 state claim, avoiding section 43(a) to bring, 27:16 substantive content of section 43(a). 27:18, 27:19 unregistered marks, 27:12 unregistered marks, 27:12 state claim, avoiding section 43(a) to bring, 27:15 state claim avoiding section 43(a) of Lanham Act, 27:20, 27:21 State claim avoiding section 43(a) to bring, 27:16 substantive content of section 43(a). 27:18, 27:19 unregistered marks, 27:21 state claim, avoiding section 43(a) to bring, 27:16 substantive content of section 43(a). 27:18, 27:19 unregistered marks, 26:am for infringement of, 27:15 state claim avoiding section 43(a) to bring, 27:16 substantive content of section 43(a). 27:20, 27:21 State claim avoiding section 43(a) to bring, 27:16 substantive content	Jus Tertii (this index)	Remedies (this index)
Laches and Delay (this index) Lanham Act commerce internet, infringing use on,	Labelers, federally registered marks,	Restraints of Trade (this index)
Lanham Act commerce internet, infringing use on, 25:54.50 local and intrastate infringement, 25:56 must be in 8220commerce,8221 25:54 elements of trade dress infringement, 7:59 extraterritorial reach, 25:58 Licensees generally, 25:30 to 25:33 merger rule, use by ex-licensee, 25:32 sale of licensee's rights, 25:33 manuthorized use, 25:30 Likelihood of Confusion (this index) Local and intrastate infringement, Lanham Act, 25:56 Logos and clipart, collections of, 25:52.50 Mark in 8220commerce,8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monetary recovery, section 43(a) of Lanham Act, 27:23 Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services,		
commerce internet, infringing use on, 25:54.50 local and intrastate infringement, 25:56 must be in 8220commerce,8221 25:54 elements of trade dress infringement, 7:59 extraterritorial reach, 25:58 Licensees generally, 25:30 to 25:33 merger rule, use by ex-licensee, 25:32 sale of licensee's rights, 25:33 unauthorized use, 25:30 Likelihood of Confusion (this index) Local and intrastate infringement, Lanham Act, 25:56 Logos and clipart, collections of, 25:52.50 Mark in 8220commerce,8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services,	Laches and Delay (this index)	
defenses, 27:19 development into federal source of assertion, infringement, unregistered marks, 27:12 monetary recovery, 27:23 non-owner of mark has standing, 27:21 outline of claim, 27:13 standing, 27:20, 27:21 state claim, avoiding section 43(a) to bring, 27:15 substantive content of section 43(a), 27:15 substantive content of section 43(a), 27:16 substantive content of section 43(a), 27:18, 27:19 unregistered marks, claim for infringement of, 27:15 standing, section 43(a) of Lanham Act, 25:56 Logos and clipart, collections of, 25:52.50 Mark in 8220commerce, 8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monetary recovery, section 43(a) of Lanham Act, 27:23 Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services,	Lanham Act	
development into federal source of assertion, infringement, unregistered marks, 27:12 monetary recovery, 27:23 non-owner of mark has standing, 27:21 outline of claim, 27:13 standing, 27:21 outline of claim, 27:13 standing, 27:20, 27:21 state claim, avoiding section 43(a) to bring, 27:16 substantive content of section 43(a), 27:18, 27:19 unregistered marks, claim for infringement of, 27:14 unregistered marks, claim for infringement of, 27:14 unregistered marks, claim for infringement of, 27:15 state claim, avoiding section 43(a), 27:18, 27:19 unregistered marks, claim for outline of claim, 27:13 standing, 27:20, 27:21 state claim, avoiding section 43(a) to bring, 27:16 substantive content of section 43(a), 27:18, 27:19 unregistered marks, claim for infringement of, 27:15 state claim, avoiding section 43(a), 27:18, 27:19 unregistered marks, 27:12 monetary recovery, 27:23 non-owner of mark has standing, 27:21 state claim, avoiding section 43(a) to bring, 27:16 substantive content of section 43(a), 27:18, 27:19 unregistered marks, 27:12 monetary recovery, 27:23 non-owner of mark has standing, 27:21 outline of claim, 27:13 standing, 27:20, 27:21 state claim, avoiding section 43(a) to bring, 27:16 substantive content of section 43(a), 27:18, 27:19 unregistered marks, 27:12 monetary recovery, 27:23 non-owner of mark has standing, 27:21 outline of claim, 27:13 standing, 27:20, 27:21 state claim, avoiding section 43(a) to bring, 27:16 substantive content of section 43(a), 27:18, 27:19 unregistered marks, 27:12 monetary recovery, 27:23 non-owner of mark has standing, 27:21 outline of claim, 27:13 standing, 27:20, 27:21 state claim, avoiding section 43(a) to bring, 27:16 substantive content of section 43(a), 27:18, 27:19 unregistered marks, claim for infringement of, 27:15 state claim, avoiding section 43(a) to bring, 27:16 substantive content of section 43(a), 27:18, 27:19 unregistered marks, claim for infringement of, 27:15 state claim, avoiding section 43(a) to bring, 27:16 substantive content of section 43(a) to bring		
local and intrastate infringement, 25:56 must be in 8220commerce,8221 25:54 elements of trade dress infringement, 7:59 extraterritorial reach, 25:58 Licensees generally, 25:30 to 25:33 ex-licensee, use by, 25:31 to 25:33 merger rule, use by ex-licensee, 25:32 sale of licensee's rights, 25:33 unauthorized use, 25:30 Likelihood of Confusion (this index) Local and intrastate infringement, Lanham Act, 25:56 Logos and clipart, collections of, 25:52.50 Mark in 8220commerce,8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services,		
unregistered marks, 27:12 monetary recovery, 27:23 non-owner of mark has standing, 27:21 outline of claim, 27:13 standing, 27:20, 27:21 state claim, avoiding section 43(a) to bring, 27:16 substantive content of section 43(a), 27:18, 27:19 unregistered marks, 27:12 monetary recovery, 27:23 non-owner of mark has standing, 27:21 outline of claim, 27:13 standing, 27:20, 27:21 state claim, avoiding section 43(a) to bring, 27:16 substantive content of section 43(a), 27:18, 27:19 unregistered marks, claim for infringement of, 27:14 unregistered marks, claim for infringement of, 27:15 Standing, section 43(a) of Lanham Act, 25:56 Logos and clipart, collections of, 25:52.50 Mark in 8220commerce,8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monetary recovery, 27:23 non-owner of mark has standing, 27:21 outline of claim, 27:13 standing, 27:20, 27:21 state claim, avoiding section 43(a) to bring, 27:16 substantive content of section 43(a), 27:18, 27:19 unregistered marks, 27:12 monetary recovery, 27:23 non-owner of mark has standing, 27:21 outline of claim, 27:13 standing, 27:20, 27:21 state claim, avoiding section 43(a) to bring, 27:16 substantive content of section 43(a), 27:18, 27:19 unregistered marks, 27:12 monetary recovery, 27:23 non-owner of mark has standing, 27:21 outline of claim, 27:13 standing, 27:20, 27:21 state claim, avoiding section 43(a) to bring, 27:16 substantive content of section 43(a), 27:18, 27:19 unregistered marks, claim for infringement of, 27:14 unregistered marks, claim for infringement of, 27:15 Standing, 27:20, 27:21 State claim avoiding section 43(a) to bring, 27:16 Standing, 27:16 substantive content of section 43(a) to bring, 27:16 substantive content of section 43(a) to bring, 27:16 substantive content of section 43(a) to bring, 27:16 substantive content of section 43(a) to bring 27:16 substantiv		
must be in 8220commerce,8221 25:54 elements of trade dress infringement, 7:59 extraterritorial reach, 25:58 Licensees generally, 25:30 to 25:33 ex-licensee, use by, 25:31 to 25:33 merger rule, use by ex-licensee, 25:32 sale of licensee's rights, 25:33 unauthorized use, 25:30 Likelihood of Confusion (this index) Local and intrastate infringement, Lanham Act, 25:56 Logos and clipart, collections of, 25:52.50 Mark in 8220commerce,8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monetary recovery, section 43(a) of Lanham Act, 27:23 Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services,		
elements of trade dress infringement, 7:59 extraterritorial reach, 25:58 Licensees generally, 25:30 to 25:33 ex-licensee, use by, 25:31 to 25:33 merger rule, use by ex-licensee, 25:32 sale of licensee's rights, 25:33 unauthorized use, 25:30 Likelihood of Confusion (this index) Local and intrastate infringement, Lanham Act, 25:56 Logos and clipart, collections of, 25:52.50 Mark in 8220commerce, 8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services,		
ris9 extraterritorial reach, 25:58 Licensees generally, 25:30 to 25:33 ex-licensee, use by, 25:31 to 25:33 merger rule, use by ex-licensee, 25:32 sale of licensee's rights, 25:33 unauthorized use, 25:30 Likelihood of Confusion (this index) Local and intrastate infringement, Lanham Act, 25:56 Logos and clipart, collections of, 25:52.50 Mark in 8220commerce, 8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monetary recovery, section 43(a) of Lanham Act, 27:23 Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services,	25:54	
standing, 27:20, 27:21 state claim, avoiding section 43(a) to bring, 27:16 substantive content of section 43(a), 27:18, 27:19 unauthorized use, 25:33 unauthorized use, 25:30 Likelihood of Confusion (this index) Local and intrastate infringement, Lanham Act, 25:56 Logos and clipart, collections of, 25:52.50 Mark in 8220commerce, 8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monetary recovery, section 43(a) of Lanham Act, 27:23 Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services,		
Licensees generally, 25:30 to 25:33 ex-licensee, use by, 25:31 to 25:33 merger rule, use by ex-licensee, 25:32 sale of licensee's rights, 25:33 unauthorized use, 25:30 Likelihood of Confusion (this index) Local and intrastate infringement, Lanham Act, 25:56 Logos and clipart, collections of, 25:52.50 Mark in 8220commerce, 8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monetary recovery, section 43(a) of Lanham Act, 27:23 Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services,		Ç. ,
generally, 25:30 to 25:33 ex-licensee, use by, 25:31 to 25:33 merger rule, use by ex-licensee, 25:32 sale of licensee's rights, 25:33 unauthorized use, 25:30 Likelihood of Confusion (this index) Local and intrastate infringement, Lanham Act, 25:56 Logos and clipart, collections of, 25:52.50 Mark in 8220commerce, 8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monetary recovery, section 43(a) of Lanham Act, 27:23 Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services,		
ex-licensee, use by, 25:31 to 25:33 merger rule, use by ex-licensee, 25:32 sale of licensee's rights, 25:33 unauthorized use, 25:30 Likelihood of Confusion (this index) Local and intrastate infringement, Lanham Act, 25:56 Logos and clipart, collections of, 25:52.50 Mark in 8220commerce, 8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monetary recovery, section 43(a) of Lanham Act, 27:23 Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services, Merger rule, use by ex-licensee, 25:32 Monopolies and Restraints of Trade (this index) Unfair competition, 1:11 Union, infringement by, 25:59		
merger rule, use by ex-licensee, 25:32 sale of licensee's rights, 25:33 unauthorized use, 25:30 Likelihood of Confusion (this index) Local and intrastate infringement, Lanham Act, 25:56 Logos and clipart, collections of, 25:52.50 Mark in 8220commerce,8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monetary recovery, section 43(a) of Lanham Act, 27:23 Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services, unregistered marks, claim for infringement of, 27:14 unregistered trade dress and trade names, claim for infringement of, 27:15 Standing, section 43(a) of Lanham Act, 27:20, 27:21 State claim avoiding section 43(a) to bring, 27:16 internet service provider, Federal CDA immunity, 22:4.50 State government, infringement by, 25:63 to 25:66 Trade dress infringement of, 27:14 unregistered marks, claim for infringement of, 27:14 unregistered marks, claim for infringement of, 27:14 unregistered marks, claim for infringement of, 27:14 unregistered trade dress and trade names, claim for infringement of, 27:15 Standing, section 43(a) to bring, 27:16 internet service provider, Federal CDA immunity, 22:4.50 State government, infringement by, 25:63 to 25:66 Trade dress infringement of, 27:14 unregistered marks, claim for infringement of, 27:15 Standing, section 43(a) of Lanham Act, 27:20, 27:21 State claim avoiding section 43(a) to bring, 27:16 internet service provider, Federal CDA immunity, 22:4.50 Unclean Hands (this index) Unclean Hands (this index) Unfair competition, 1:11		
sale of licensee's rights, 25:33 unauthorized use, 25:30 Likelihood of Confusion (this index) Local and intrastate infringement, Lanham Act, 25:56 Logos and clipart, collections of, 25:52.50 Mark in 8220commerce, 8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monetary recovery, section 43(a) of Lanham Act, 27:23 Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services,	•	
unauthorized use, 25:30 Likelihood of Confusion (this index) Local and intrastate infringement, Lanham Act, 25:56 Logos and clipart, collections of, 25:52.50 Mark in 8220commerce, 8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monetary recovery, section 43(a) of Lanham Act, 27:23 Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services, unregistered trade dress and trade names, claim for infringement of, 27:15 Standing, section 43(a) of Lanham Act, 27:20, 27:21 State claim avoiding section 43(a) to bring, 27:16 internet service provider, Federal CDA immunity, 22:4.50 State government, infringement by, 25:63 to 25:66 Trade dress infringement, elements of, 7:59, 8:1 Unclean Hands (this index) Unfair competition, 1:11 Union, infringement of, 27:15 Standing, section 43(a) of Lanham Act, 27:20, 27:21 State claim avoiding section 43(a) to bring, 27:16 internet service provider, Federal CDA immunity, 22:4.50 State government, infringement by, 25:69 Unclean Hands (this index) Unfair competition, 1:11 Union, infringement	·	
Local and intrastate infringement, Lanham Act, 25:56 Logos and clipart, collections of, 25:52.50 Mark in 8220commerce,8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monetary recovery, section 43(a) of Lanham Act, 27:23 Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services, of, 27:15 Standing, section 43(a) of Lanham Act, 27:20, 27:21 State claim avoiding section 43(a) to bring, 27:16 internet service provider, Federal CDA immunity, 22:4.50 State government, infringement by, 25:63 to 25:66 Trade dress infringement, elements of, 7:59, 8:1 Unclean Hands (this index) Unfair competition, 1:11 Union, infringement by, 25:59	unauthorized use, 25:30	unregistered trade dress and trade
Lanham Act, 25:56 Logos and clipart, collections of, 25:52.50 Mark in 8220commerce, 8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monetary recovery, section 43(a) of Lanham Act, 27:23 Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services, Standing, section 43(a) of Lanham Act, 27:20, 27:21 State claim avoiding section 43(a) to bring, 27:16 internet service provider, Federal CDA immunity, 22:4.50 State government, infringement by, 25:63 to 25:66 Trade dress infringement, elements of, 7:59, 8:1 Unclean Hands (this index) Unfair competition, 1:11 Union, infringement by, 25:59	Likelihood of Confusion (this index)	
Logos and clipart, collections of, 25:52.50 Mark in 8220commerce, 8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monetary recovery, section 43(a) of Lanham Act, 27:23 Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services, Mark in 8220commerce, 8221 definition avoiding section 43(a) to bring, 27:16 internet service provider, Federal CDA immunity, 22:4.50 State government, infringement by, 25:63 to 25:66 Trade dress infringement, elements of, 7:59, 8:1 Unclean Hands (this index) Unfair competition, 1:11 Union, infringement by, 25:59		
25:52.50 Mark in 8220commerce,8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monetary recovery, section 43(a) of Lanham Act, 27:23 Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services, State claim avoiding section 43(a) to bring, 27:16 internet service provider, Federal CDA immunity, 22:4.50 State government, infringement by, 25:63 to 25:66 Trade dress infringement, elements of, 7:59, 8:1 Unclean Hands (this index) Unfair competition, 1:11 Union, infringement by, 25:59		Standing, section 43(a) of Lanham Act,
Mark in 8220commerce, 8221 definition of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monetary recovery, section 43(a) of Lanham Act, 27:23 Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services, avoiding section 43(a) to bring, 27:16 internet service provider, Federal CDA immunity, 22:4.50 State government, infringement by, 25:63 to 25:66 Trade dress infringement, elements of, 7:59, 8:1 Unclean Hands (this index) Unfair competition, 1:11 Union, infringement by, 25:59		
of interstate commerce, 25:55 Merger rule, use by ex-licensee, 25:32 Monetary recovery, section 43(a) of Lanham Act, 27:23 Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services, internet service provider, Federal CDA immunity, 22:4.50 State government, infringement by, 25:63 to 25:66 Trade dress infringement, elements of, 7:59, 8:1 Unclean Hands (this index) Unfair competition, 1:11 Union, infringement by, 25:59		
Merger rule, use by ex-licensee, 25:32 Monetary recovery, section 43(a) of Lanham Act, 27:23 Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services, CDA immunity, 22:4.50 State government, infringement by, 25:63 to 25:66 Trade dress infringement, elements of, 7:59, 8:1 Unclean Hands (this index) Unfair competition, 1:11 Union, infringement by, 25:59		
Monetary recovery, section 43(a) of Lanham Act, 27:23 Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services, State government, infringement by, 25:63 to 25:66 Trade dress infringement, elements of, 7:59, 8:1 Unclean Hands (this index) Unfair competition, 1:11 Union, infringement by, 25:59		CDA immunity, 22:4.50
Monopolies and Restraints of Trade (this index) Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services, Trade dress infringement, elements of, 7:59, 8:1 Unclean Hands (this index) Unfair competition, 1:11 Union, infringement by, 25:59	Monetary recovery, section 43(a) of	State government, infringement by,
Mootness, injunction after cessation of infringing actions, 30:11 Non-Competitive Goods or Services, Unclean Hands (this index) Unfair competition, 1:11 Union, infringement by, 25:59	Monopolies and Restraints of Trade	457.057 1.07 457.000
infringing actions, 30:11 Non-Competitive Goods or Services, Unfair competition, 1:11 Union, infringement by, 25:59		Trade dress infringement, elements of,
Non-Competitive Goods or Services, Union, infringement by, 25:59	Montness injunction after resention of	Trade dress infringement, elements of, 7:59, 8:1
,		Trade dress infringement, elements of, 7:59, 8:1 Unclean Hands (this index)
A =	infringing actions, 30:11	Trade dress infringement, elements of, 7:59, 8:1 Unclean Hands (this index) Unfair competition, 1:11
7:16 Use in commerce. Commerce, above	infringing actions, 30:11	Trade dress infringement, elements of, 7:59, 8:1 Unclean Hands (this index) Unfair competition, 1:11

INGREDIENTS

Changes in goods and labels, use of trademark of contents or ingredients, **25:35.50**

Copyrights, 6:19

INHERENTLY DISTINCTIVE MARKS

Acquisition and Priority of Rights (this index)

INJUNCTIONS

Generally, 30:1 to 30:56

Advertising, corrective, 30:6

Affirmative steps, injunction requiring, 30:5 to 30:9

Balancing the equities, 30:3, 30:4

Cessation of infringing actions, injunction after, **30:11**

Contempt (this index)

Corrective advertising, 30:6

Cyberspace, infringement in, Anti-Cybersquatting Consumer Protection Act (ACPA), **25A:65**

Damage not required, 30:2.50

Destruction orders, 30:9

Dilution of trademarks, 24:82

False advertising, 27:27 to 27:33, 27:37

Geographic terms fair use, 14:14, 14:15

Hearings (this index)

Injury not required, 30:2.50

Irreparable harm required for permanent, 30:2

Laches and delay, bar to relief

generally, 31:5 to 31:9

deliberate infringement, prevention of laches defense, **31:9**

denial of injunction, hard cases, **31:8** equities in favor of defendant, **31:6** plus factors lead to denial of final injunction, **31:7**

Legal acts, injunction against, **30:4** Modification, **30:16**

Mootness, injunction after cessation of infringing actions, **30:11**

Permanent, irreparable harm required, 30:2

Persons bound by injunction, 30:14

Preliminary Injunctions (this index)

Recall of products, 30:8

Refunds to customers, 30:8

Scope, 30:1 to 30:16

INJUNCTIONS—Cont'd

Specificity, 30:13

Tailoring injunction to case, 30:3

Telephone listings, requiring, 30:7

Territorial scope, 30:15

Time of relief, 30:10, 30:11

Trade libel and product disparagement, 27:112

Unclean Hands (this index)

INJURY

Irreparable Injury (this index)

IN REM JURISDICTION

Generally, 32:38.50

Federal Anti-cybersquatting Act, **25A:70 to 25A:78**

INSIGNIAS

Fastener Quality Act, registration with PTO, 19:149

Federal registration, **19:78**, **19:79**, **19:149**

INSOLVENCY

Bankruptcy and Insolvency (this index)

INSTRUCTIONS

Copyrights, 6:19

INSTRUCTIONS TO JURY

Jury trial, **32:131**

Utilitarian functionality, defining functionality, **7:69.50**

INSURANCE

Breach of contract exclusion from coverage for infringement claims, 33:17

Counterfeiting, coverage of traditional liability policies for infringement claims, **33:6**

Coverage for trademark matters, **33:2 et seq.**

Damages, coverage of traditional liability policies coverage for infringement claims, **33:9**

Defend

duty to defend infringement claims, 33:3

intellectual property defense coverage, **33:20**

Duty to defend and to indemnify, 33:3

INSURANCE—Cont'd INSURANCE—Cont'd Exclusions from coverage of traditional Intentional injuries exclusion from liability policies for infringement coverage for infringement claims, claims, 33:12 to 33:17 33:16 Introduction, 33:1 Indemnification duty, 33:3 Key insurance policy language, 33:2 Infringement Knowledge of falsity coverage exclusion generally, 25:67 of traditional liability policies, advertising infringement claims, 33:14.50 causal nexus, 33:10 Language of policy, coverage of misappropriation of advertising traditional liability policies for ideas, coverage under infringement claims, 33:2, 33:13 traditional liability policies, Misappropriation of advertising ideas or 33:5 style of doing business, insurance claim, guidelines in event of, 33:23 coverage for, 33:5 defense of intellectual property. Prior publication or prior acts coverage special coverage, 33:20 exclusion of traditional liability intellectual property, special coverage policies for infringement claims, for, 33:18 to 33:22 33:15 traditional liability policies, coverage Purchasing and preserving insurance for infringement claims assets, 33:22, 33:23 generally, 33:1 et seq. Slogan infringement, coverage of breach of contract exclusion, 33:17 traditional liability policies for infringement claims, 33:7 counterfeiting, 33:6 Title infringement, coverage of covered offense requirement, 33:4 traditional liability policies for damages, 33:9 infringement claims, 33:7 exclusions, 33:12 to 33:17 Trade dress, coverage of traditional intellectual property exclusion, liability policies for infringement 33:14 claims, **33:8** intentional injuries exclusion, Using insurance assets, 33:22, 33:23 33:16 INTENT key policy language, 33:2 Abandonment of rights, 17:11 knowledge of falsity exclusion, 33:14.50 Abandonment of rights, old rule, 17:10 False advertising, 27:51, 27:58 misappropriation of advertising ideas or style of doing busi-Fraud, bona fide intention to use and ness, 33:5 fraud, 31:78 offenses covered, 33:4 Infringement, 23:106 Insurance for infringement claims, policy language of exclusions, 33:13 intentional injuries exclusion, 33:16 prior publication or prior acts exclusion, 33:15 **Intent to Use Applications** (this index) Laches and delay. 31:9 slogan infringement, 33:7 **Likelihood of Confusion** (this index) title infringement, 33:16 Mens Rea (this index) trade dress, 33:8 Trade libel and product disparagement, trigger of coverage, 33:11 27:104 willful violation of penal statute exclusion, 33:16 INTENT TO USE APPLICATIONS Intellectual property Assignments, 18:13 coverage, 33:18 to 33:22 Cancellation proceedings, 20:45 exclusion, 33:14 Federal Registration (this index)

INTENT TO USE APPLICATIONS

—Cont'd

Inter partes proceedings, **19:31**, **19:31.10**

Secondary meaning, federal registration, 15:65

INTERFERENCE PROCEEDINGS

Generally, 20:89 et seq.

Creation, decline, and end of, **20:90** Lanham Act provision, **20:89**

INTERNATIONAL DISPUTES

Arbitration, 32:200

INTERNATIONAL OWNERSHIP

Generally, 29:1 to 29:9

Assignment of U.S. trademark rights from foreign manufacturer to exclusive U.S. distributor, **29:9**

Change of ownership of international registration, **19:31.75**

Decisions of foreign courts and registration offices and foreign governments, 29:5

Domestic priority controls, 29:2

European Union trademarks, 29:35

Expropriation of trademark rights by government, **29:6**

Foreign

courts, 29:5

governments, 29:5

made goods, ownership in U.S. of trademark of, **29:8**

mark "well-known" in U.S., 29:4 senior user vs. first U.S. user, 29:3

Government expropriation of trademark rights, 29:6

Madrid Protocol, change of ownership of international registration, 19:31.75

Multiple ownership of mark worldwide, **29:7**

Registration offices, **29:5** World priority, **29:1 to 29:7**

INTERNATIONAL TRADE COMMISSION

Imported goods, 29:55

INTERNATIONAL TRADEMARK ASSOCIATION

Model state trademark act, 22:5 to 22:9.25

INTERNET

Acquisition and priority of rights, internet website use, **16:32.70**

Auction house liability, 25:20.50

Concurrent use proceedings, impact of Internet usage, **20:85.50**

Contributory infringement of Internet site, **25:20.50**

Cyberspace, Infringement in (this index)

Descriptive marks, foreign web sites evidence, 11:51

Domain names

generic combinations, 12:39.50

trademarks and trade dress, **7:17.50** Federal registration, electronic registra-

Federal registration, electronic registration communications with USPTO, **19:45.75**

Freedom of speech on Internet, 31:148.50

Hashtags, 7:17.70

Infringement

federal CDA immunity, state claim, internet service provider, 22:4.50

use in commerce, Lanham Act, **25:54.50**

Inter partes proceedings, evidence, 20:126.50

Personal jurisdiction, 32:45.50

Related goods or services, use for selling or advertising, **24:53.50**

Service marks

abroad, internet delivery, 19:106

menu items, 10:6

Survey evidence, **32:165.25**

Territorial extent of rights, **26:30.50**Trade dress in appearance of web site, **8:7.25**

Trademark use as an internet web page, 3.7

Use in commerce under Lanham Act, 25:54.50

Web sites, generally, 7:17.50

INTER PARTES PROCEEDINGS

Generally, 4:18, 20:1 to 20:137

Accelerated case resolution procedure (ACR), **20:102**

Acquiescence by failure to object to use of mark, 20:32 to 20:38

Admissions, requests for, 20:109

Amend, motion to, 20:135

INTER PARTES PROCEEDINGS	INTER PARTES PROCEEDINGS
—Cont'd	—Cont'd
Analogous use, 20:16	Equitable defenses—Cont'd
Appeals, 20:100, 20:106	laches or acquiescence by failure to
Attack on validity of registration, 20:22	object to use of mark, 20:32 to
Briefs, 20:103	20:38
Cancellation, 4:18	opposition, 20:32 to 20:35, 20:39
Cancellation Proceedings (this index)	prior registration defense, 20:38
Compulsory counterclaims, oppositions,	Estoppel, 20:39
20:23	Evidence and witnesses
Concurrent Use Proceedings (this	generally, 20:115 to 20:128
index)	correcting transcript, 20:118
Conditional judgment for intent to use applicants, 20:27	discovery results, notice of reliance on, 20:126
Consenting to judgment, 20:120	files of applications and registrations,
Continuous use, proof of, 20:29	20:123
Correcting transcript, 20:118	filing transcript, 20:118
Country of origin registration, chal-	Internet materials, 20:126.50
lenges to validity of, 29:16	issue tried by implied consent,
Damages, standing, 20:12	20:122.50
Declaratory judgments, 32:52	matters not in evidence, 20:128
Default judgment, 20:130	notice of taking testimony, 20:116
Definitions, 4:18	notices, 20:124 to 20:126
Depositions, 20:101, 20:108	pleading and proof, below
Descriptiveness, standing, opposition,	pretrial disclosure, 20:115.50
20:11 Dilution, 20:20.50, 24:100	printed publications, notice of reliance on, 20:125
Disclosure	reopening trial period, 20:119
pretrial disclosure, 20:115.50	residence of witness outside United
Trademark Trial and Appeal Board	States, 20:117.50
discovery, 20:112	taking testimony, 20:115 to 20:119
Discovery	testimony, 20:115 to 20:119, 20:127
generally, 20:107 to 20:114 depositions, 20:108	Trademark Trial and Appeal Board
foreign nations, discovery in, 20:114	evidence rules, 20:122
interrogatories, 20:111	Exceptions to laches defense, 20:36
notice of reliance on results, 20:126	Failure to state a claim, dismissal for,
production of documents, 20:110	20:133
remedies for failure to co-operate, 20:113	Files of applications and registrations, 20:123
requests for admissions, 20:109	Filing
required disclosure, 20:112	opposition, time of, 20:5
T.T.A.B. discovery, 20:107 to 20:114	transcript, 20:118
Disqualification of opposing attorney,	Foreign nations, discovery in, 20:114
motion for, 20:137	Genericness, standing, opposition, 20:11
Earlier registration, laches from failure	Grounds, generally, 20:13 to 20:21.50
to object, 20:35.50 Equitable defenses	Improper grounds for opposition, 20:21.50
generally, 20:31 to 20:39 estoppel, 20:39	Intent to use applications, 19:31 , 19:31.10
exceptions to laches defense. 20:36	Interference Proceedings (this index)

INTER PARTES PROCEEDINGS	INTER PARTES PROCEEDINGS
—Cont'd	—Cont'd
Internet materials as evidence,	Opposition—Cont'd
20:126.50	standing, 20:7 to 20:12
Interrogatories, 20:111	time within which to file, 20:5
Jurisdiction and procedure, Trademark	Oral argument, 20:104
Trial and Appeal Board, 20:99	Ownership, 20:18, 20:29
Laches	Pleading and proof
failure to object to earlier registration, 20:35.50	generally, 20:22 to 20:30
failure to object to use of mark, 20:32	attack on validity of registration,
to 20:38	20:22
Lanham Act	compulsory counterclaims, oppositions, 20:23
section 2(a) as grounds, 20:20	conditional judgment for intent to use
section 2(d) as grounds, 20:14 to	applicants, 20:27
20:18	evidence and witnesses, opposition,
section 2(e) as grounds, 20:19	20:6, 20:22 to 20:30
section 13, opposition, 20:1	forms, 20:30
Likelihood of	issues raised in notice of opposition
confusion, 20:14, 20:15, 23:81	and in application, 20:24
damage, standing, 20:7	opposition, 20:3, 20:6, 20:22 to 20:30
Litigation misconduct, motion for sanc-	ownership and continuous use, proof
tions, 20:136	of, 20:29
Motions	prior use, proof of, 20:28
generally, 20:129 to 20:137	rectifying the register, 20:26
amend, 20:135	use of mark, 20:28 , 20:29
default judgment, 20:130	Pretrial disclosure, 20:115.50
disqualification of opposing attorney, 20:137	Printed publications, notice of reliance on, 20:125
failure to state a claim, dismissal for,	Prior
20:133	registration defense, 20:38
sanctions, litigation misconduct,	use, 20:16, 20:28
20:136	Priority of use, 20:17
setting aside judgment, 20:134	Procedure
strike, motion to, 20:135.50	generally, 20:99 to 20:137
summary judgment, 20:132	opposition, 20:6
testimony, dismissal for failure to take, 20:131	Production of documents, 20:110 Purpose, opposition proceedings, 20:2
TTAB motions, generally, 20:129	Rectifying the register, 20:26
Notice	Reliance notice, 20:124 to 20:126
evidence, 20:124 to 20:126	Remedies for failure to co-operate in
taking testimony, 20:116	discovery, 20:113
Official Gazette, search of, 20:4	Reopening trial period, 20:119
Opposing attorney's disqualification,	Requests for admissions, 20:109
motion for, 20:137	Residence of witness outside United
Opposition 20.14.20.6	States, 20:117.50
generally, 20:1 to 20:6	Res Judicata and Collateral Estoppel
equitable defenses, 20:32 to 20:35 ,	(this index)
20:39	Review, Director of Patents and
grounds, 20:13 to 20:21.50	Trademarks is not party to, 21:24
pleading and proof, 20:22 to 20:30	Sanctions, 20:136

INTER PARTES PROCEEDINGS	IQBAL
—Cont'd	Summary judgment, motion to dismiss,
Secondary meaning, 15:73	failure to state a claim, 32:121.60
Setting aside judgment, 20:134	IRREPARABLE INJURY
Standing	Permanent injunctions, 30:2
damages, 20:12	
descriptiveness, opposition, 20:11 entitlement, 20:7	Preliminary injunctions, 30:46 to 30:49 , 31:32
genericness, opposition, 20:11 infringement suit against opposer,	Prima facie case, 30:2.50 Unfair competition, 1:14
20:12	ISSUE PRECLUSION
likelihood of damage, 20:7 opposition, 20:7 to 20:12	Res Judicata and Collateral Estoppel (this index)
trade association cases, 20:8	JACK DANIEL'S CASE
Summary judgment, 20:132	
Summary of trial procedure, 20:102	Supreme Court8217s decision, putting limits on Rogers8217 test,
Supplemental Register, 19:41	31:144.20
Time to file opposition, 20:5	
Trade association cases, standing, 20:8	JOINT OWNERSHIP OF
Trademark Trial and Appeal Board	TRADEMARKS
depositions, 20:108	Generally, 16:40 to 16:45
disclosure, 20:112	Difficulties, 16:40, 16:41
discovery, generally, 20:107 to 20:114	Dissolution of entity, 16:42 to 16:45
evidence and witnesses, above	Federal registration, 16:41 Performing group, dissolution of, 16:45
foreign nations, discovery in, 20:114	
interrogatories, 20:111	Typical cases, 16:42
jurisdiction, 20:111	JOINT TORTFEASORS
motions, 20:129	Contributory infringement, 25:23
procedure, 20:99	HIDICIAL ECTODDEI
production of documents, 20:110	JUDICIAL ESTOPPEL
remedies for failure to co-operate in	Generally, 32:112 JUDICIAL NOTICE
discovery, 20:113	Secondary meaning, 15:31
request for admission, 20:109	Secondary meaning, 13.31
required disclosure, 20:112	JUDICIAL REVIEW
Transcript, correcting and filing, 20:118 Trial briefs, 20:103	Appeal and Review (this index)
Trial procedure, 20:101 to 20:106	JURISDICTION
Use of mark, 20:28 , 20:29	Generally, 32:1 to 32:45.50
Witnesses. Evidence and witnesses,	Choice of law, 32:36
above	Concurrent jurisdiction in federal and state courts, 32:1
INTERPRETATION Licenses, 18:43	Court of Appeals for Federal Circuit, 21:13
INTERROGATORIES	Covenant not to sue, federal jurisdiction 32:2.50
Inter partes proceedings, T.T.A.B. discovery, 20:111	Declaratory judgments, 32:56 to 32:58
discovery, 20:111	Diversity jurisdiction. Federal Diver-
INVESTMENT RULES	sity Jurisdiction (this index)
Franchises (this index)	False Advertising (this index)

.JURISDICTION—Cont'd

Federal Diversity Jurisdiction (this index)

Federal Question Jurisdiction (this index)

Federal Supplemental Jurisdiction (this index)

In Rem Jurisdiction (this index)

Lanham Act, 32:1

Personal Jurisdiction (this index)

Site where tort of trademark infringement occurs, 32:38.40

Supplemental jurisdiction. **Federal Supplemental Jurisdiction** (this index)

Trademark Trial and Appeal Board, inter partes proceedings, **20:99**

JURY TRIAL

Generally, 32:122 to 32:133

Accounting of profits, 32:124

Appellate review of jury verdict, 32:133

Attorney fees, 32:125

Choice of jury or judge, 32:130

Contempt, 30:20

Demand for jury trial, 32:128

Equitable relief, prayer for only, 32:127

Federal courts, 32:124 to 32:128

Instructions to Jury (this index)

Law and equity, dichotomy of, 32:123

Prayer for only equitable relief, 32:127

Profits, accounting of, 32:124

Right to jury trial, federal and state, 32:122

Statutory damages, 32:125

Strategy, 32:130 to 32:133

Verdict binds court, 32:126

JUS TERTII

Generally, 31:157 to 31:160

Defined, 31:157

Disfavored status, 31:158

KNOWLEDGE

Notice and Knowledge (this index)

LABELS

Copyrights (this index)

Federal registration, use necessary to support registration in violation of federal labeling laws, **19:123**

Likelihood of confusion, 23:53

LABOR UNIONS

Infringement, 25:59

LACHES AND DELAY

Generally, 31:1 to 31:43

Abandonment, 31:27

Acquiescence, distinguished, 31:41

Balancing of public interest, 31:10,

Cancellation proceedings, failure to object to use of mark, **20:74 to 20:77**

Charitable and nonprofit organizations, 9:5

Conflicting interests, balancing of, 31:22

Confusion inevitable, balancing of public interest, 31:10

Constructive notice from registration, 31:40

Corporations, imputation of notice, 31:39

Deliberate infringement, prevention of laches defense, **31:9**

Denial of injunction, hard cases, **31:8**

Dilution of trademarks, 24:130

Encroachment of use by defendant, 31:19 to 31:21

Equities in favor of defendant, 31:6

Escalation of use by defendant, 31:19 to 31:21

Estoppel, generally, 31:2, 32:105

Federally registered marks, 31:33 to 31:34

Imputation of notice, 31:38 to 31:40

Inevitable confusion, balancing of public interest, **31:10**

Injunctions, bar to relief

generally, 31:5 to 31:9

deliberate infringement, prevention of laches defense, **31:9**

denial of injunction, hard cases, 31:8

equities in favor of defendant, 31:6

plus factors lead to denial of final

injunction, 31:7

Intermittent periods of infringement, 31:25

Inter partes proceedings

failure to object to earlier registration, 20:35.50

failure to object to use of mark, 20:32 to 20:38

LACHES AND DELAY—Cont'd	LACHES AND DELAY—Cont'd
Irreparable injury, preliminary injunc-	Territorial extent of rights, federal
tions, 31:32	registrant as junior user, 26:57
Jurisdiction, statute of limitations in &	Waiver defense, existence of, 31:43
section 43(a) cases, 27:48	LANDLORD AND TENANT
Knew or should have known standard, notice, 31:38	Contributory infringement, 25:20
Measurement of delay	Ownership of trademarks, 16:38
generally, 31:23 to 31:30	LANHAM ACT
abandonment by infringer, 31:27	-
examples, 31:28 to 31:30	See also more specific topics throughout this index
intermittent periods of infringement,	Generally, 1:18 , 1:19 , 3:11 , 5:4 to 5:11
31:25	Acquisition and priority of rights, affixa-
non-infringement, periods of, 31:24	tion of mark, 16:23
statute of limitations and laches,	Amendments
31:23	1947 to 1984, 5:6
tacking, 31:26	1989 to 2000, 5:10
Monetary recovery, 31:4	2000, since, 5:11
Notice	Cancellation Proceedings (this index)
knew or should have known standard,	Commerce. Infringement (this index)
31:38	Concurrent jurisdiction in federal and
lack of, 31:17	state courts, 32:1
Partnerships, imputation of notice, 31:39	Contributory and vicarious liability
Patent and Trademark Office proceed-	under Lanham Act section 43(c),
ings, 31:37	25:21.25, 25:21.75
Plus factors lead to denial of final	Copyrights, 6:15
injunction, 31:7	Defense, senior user, 26:53
Prejudice, 31:2 , 31:12 , 31:13 Preliminary injunctions, 31:31 , 31:32	Definitions, 4:1 et seq.
Public interest, balancing of, 31:10,	Extraterritorial reach, infringement abroad, 25:58
31:11	False advertising, class action, 27:34
Reasons for delay	False Advertising (this index)
generally, 31:14 to 31:21	False endorsements, 28:15
challenged use, progressive encroach-	Federal
ment and other changes in, 31:20	preemption, copyright, 19:126.50
encroachment or escalation of use by	question jurisdiction, 32:11
defendant, 31:19 to 31:21	registration, examination of applica-
notice, lack of, 31:17	tion, 19:126.50
other litigation, 31:16	Gray market goods
settlement negotiations, 31:15	Lever Rule, 29:50.50
significant infringement, 31:19	History, generally, 5:4 to 5:11
Reliance, 31:13	Interference proceedings, 20:89
Settlement negotiations, 31:15	Inter Partes Proceedings (this index)
Significant infringement, reasons for	Licenses, 18:49
delay, 31:19	Likelihood of Confusion (this index)
Statute of limitations, 31:33	Movies, 27:89
Statute of limitations and laches, 31:23	Product and container shapes, 7:59
Statutory constructive notice from	Retailer liability, 27:34.50
registration, 31:40	Search engine liability for allowing
Supreme Court precedent, 31:3	searches of plaintiff 8217s
Tacking, measurement of delay, 31:26	trademark, 25:28.50

rule, federally registered marks, 18:49

LICENSES—Cont'd LANHAM ACT—Cont'd Abandonment of rights, 17:6 Sears-Compco cases, 1:18, 1:19 Senior user's defense, 26:53 Antitrust laws, 18:62 State law "federalized," 1:19.50 Assignments, 18:5, 18:64 Trade libel and product disparagement, Benefit of trademark owner, licensee's 27:91 to 27:112.10 use inures to, 18:45.50 Breach of exclusive license by licensor, Trademark, **4:1 et seq., 4:3** Trademark Clarification Act of 1984, 18:44.50 Contractual provision for quality 5:8 Trademark Counterfeiting Act of 1984, control, **18:56** 5:7 Controlled licensee, related company, Trademark Law Revision Act of 1984, 18:51 Delegation of quality control, 18:60 Trade name, **4:1 et seq., 4:4, 4:5** Development of law, 18:39 to 18:41 **Duration**, **18:43** Unfair competition, 1:19, 1:19.50 Estoppel, 18:63, 32:107 LEADING QUESTIONS Exclusive license, 18:44.50 Survey evidence, 32:172 Failure to obtain state, 9:11 Federal, foreign and state law compared, LEASES 18:54 **Landlord and Tenant** (this index) Federally registered marks LETTER OF PROTEST generally. 18:49 to 18:54 Generally, 19:130 Lanham Act. 18:49 Formalities, 18:43 **LETTERS** Franchising, 18:38, 18:40 Generally, 7:9 to 7:13 Holding companies, 18:51 As trademarks, 7:9 **Implied** Broadcast station call letters, 7:12 license, 18:43.50 Combinations, validity and strength, obligations, 18:44 7:11 Confusingly similar, 23:34, 23:35 **Infringement** (this index) **Consent Letters** (this index) Interpretation, 18:43 Descriptive marks, 11:30 Lear v. Adkins, 18:63 Likelihood of confusion, 23:33 to Legitimate control by licensor, 18:53 23:35, 23:52 Market extension licensing, 18:40 Protest letter, 19:130 Merger, 18:47 Scope of protection, 7:10 Modern rule, 18:42 to 18:47 Scope of protection of arbitrary letter **Monetary Recovery** (this index) combinations, 7:10 Naked licensing, 18:48 Strength, 7:11 Name of licensor, use not required, Telephone number letter combinations, 18:45 7:13 Need quality control, 18:61 Validity, 7:11 Overly strict control, 18:56 LIBEL Owner of trademark, licensee's use Trade Libel and Product Disparageinures to benefit of, 18:45.50 ment (this index) **Publicity** (this index) Quality control, 18:40, 18:42, 18:55 to LICENSE MERGER RULE 18:61 Generally, **18:47** Related company LICENSES controlled licensee, 18:51

Index-56

Generally, 3:8, 18:38 to 18:63

LICENSES—Cont'd	LIKELIHOOD OF CONFUSION
Reliance upon licensee's quality control,	—Cont'd
18:57	Competitive differences, degree of
Special relationships, reliance upon licensee's quality control, 18:57	similarity needed varies with, 23:21
Sub-license, 18:43	Composite marks, 23:41 , 23:44 , 23:47
Summary of trademark licensing, 18:38	Concurrent use proceedings, 20:85
Three part test, quality control, 18:55	"Confusingly similar"
Trademark license merger rule, 18:47	likelihood of confusion, 23:4
Transfer, 18:43	probability of confusion, 23:3
Use	Confusion without competition, 24:1
licensee inures to benefit of licensor, 18:52	Conjoint use rule, 23:61.25 Constructive notice, infringement of
licensees, only by, 18:46	federally registered marks, 23:109
licensor's name not required, 18:45	Context, 23:37
I HEE STODIES	Copying, 23:121 to 23:123 Courtroom, recreation of marketplace in,
LIFE STORIES	23:58, 23:59
Publicity, rights, 28:20	Customer and potential customer confu-
LIKELIHOOD OF CONFUSION	sion, 23:5 to 23:9
Generally, 23:1 to 23:124	Deception, emphasis change, 23:104
Actual confusion	Degree of buyer care varies with price
generally, 23:12 to 23:18	of goods and services, 23:95
evidence of likelihood of confusion,	Design marks, dominant part of, 23:47
23:13 to 23:18	Dilution of trademarks, distinguished,
hearsay, 23:15	24:72, 24:73
lack of evidence of actual confusion,	Direct copying, 23:121 to 23:123
23:18	copying to compete, 23:122 Disclaimers, 19:72, 23:51
necessity, 23:12	Discriminating purchaser, 23:95 to
questions and inquiries, 23:16	23:99
survey evidence, 23:17	Dominant and subsidiary parts of
weight of the evidence, 23:14 Addition of matter, 23:50	competitor, consideration of, 23:42
	Du Pont decision, informed consent to
Affiliation, connection or sponsorship, confusion as to, 23:8	register, 23:86
Anti-dissection rule, 23:41 , 23:42	Duty of newcomer to avoid confusion, 23:65
Appeals, questions of law or fact, 23:68	Emphasis change from deception to
to 23:75	confusion, 23:104
Appearance, similarity of, 23:25	Evidence, 23:2.75, 23:62, 23:63, 23:113
Balancing public interest, inevitable confusion, 31:10	to 23:120 Expensive goods, purchases of, 23:96,
Call to mind is not confusion, 23:9	23:97
Cease and desist, continued use of mark after, 23:120	Expert testimony, 23:2.75
•	Factors leading to confusion, 23:19 to
Circuit courts, survey of, 23:73	23:32 Fairman
Color similarity, 7:45.70 , 23:52	Fair use
Commercial impression, similarity in marks, 23:21.50	descriptiveness of mark, fair use can co-exist with some degree of
Comparing marks, generally, 23:40.50	confusion, 11:47
to 23:60	microcolor, 11:47

LIKELIHOOD OF CONFUSION LIKELIHOOD OF CONFUSION —Cont'd -Cont'd Hearsay, actual confusion, 23:15 Fair use—Cont'd non-confusing nominative fair use, House marks, use of, 23:43 Imported goods, gray market, 29:46 Family of marks rule, 23:61 Indifferent, reasonably prudent Federal law, test of infringement, purchaser, 23:94 23:1.50 Inevitable confusion, balancing public Federal registration interest, 31:10 generally, 23:76 to 23:89 Inference of intent, 23:111, 23:115 "clothed" consent, 23:88 Infringement determinative consents, 23:87 generally, 23:1 to 23:11.50 Du Pont decision, informed consent, intent, significance, 23:124 23:86 mark, federally registered, 23:76 infringement, 23:76, 23:76.50 service mark, registered, 23:76.50 inter partes proceeding, effect of, use as a "trademark," 23:11.50 23:81 Initial interest confusion, 23:6 Lanham Act, refusal of federal Inquiries, actual confusion, 23:16 registration, 23:77 to 23:83 Intent, 23:106 letters of consent, 23:85 to 23:89 generally, 23:104 to 23:124 mutual consent agreement, sample, cease and desist, continued use of 23:89 mark after, 23:120 "naked" consent, 23:88 close similarity, 23:117 refusal of federal registration, 23:77 constructive notice, infringement of to 23:84 federally registered marks, senior user, doubt resolved in favor 23:109 of. 23:82 duty to avoid confusion, 23:118 service mark, 23:76.50 emphasis change, 23:104 subsequent litigation, effect of decievidence, 23:113 to 23:120 sion in, 23:84 knowledge of plaintiff's mark, adopsubsidiary of applicant, cited registration with, 23:115 to 23:118 tion owned by, 23:83 Lanham Act, infringement under, thirteen factors, refusal of registration, 23:107 to 23:109 23:79 legal advice on how close to come, validity of cited registration, chal-23:117 lenge on, **23:80** presumption or inference, 23:111, Foolish, reasonably prudent purchaser, 23:115 23:94 relevance, 23:110 to 23:112 Foreign words significance of, 23:124 generally, 23:36 to 23:40 wrongful intent, 23:104 to 23:106 conflicting non-English words, 23:40 Inter partes proceedings, 20:15, 23:81 context, similarity of meaning in, Judging other people's confusion, 23:90 23:37 Jury verdict, review of, 23:74 inexact correspondence of meaning, Keystone of infringement, 23:1 to 23:38 23:11.50 Format, similarity of, 23:52 Knowledge of plaintiff's mark, adoption "Former," "formerly," "formerly with, 23:115 to 23:118 known as," use of, 23:54 Label, addition of, 23:53 Foundational factors, 23:19 Lanham Act Generic element of marks, 23:49 intent and infringement under Act, Gray market, imported goods, 29:46 generally, 23:107 to 23:109

LIKELIHOOD OF CONFUSION —Cont'd	LIKELIHOOD OF CONFUSION —Cont'd
Lanham Act—Cont'd	Reasonably prudent purchaser
refusal of federal registration, 23:77	generally, 23:91 to 23:103
to 23:83	degree of care of ordinary buyer,
Legal advice on how close to come, 23:117	23:95
Lettering, similarity of, 23:52	discriminating purchaser, 23:95 to 23:99
Letter marks, 23:33 to 23:35 Letters of consent, federal registration,	expensive goods, purchases of, 23:96 , 23:97
23:85 to 23:89	hurried, 23:93
Literary, artistic and entertainment	inattentive, 23:93
rights, 10:15	indifferent or foolish, 23:94
Meaning, similarity of, 23:26 to 23:30	judicial attempts at defining
Mens rea, 23:90	characteristics, 23:92
Methods of proving likelihood of confusion, 23:2.50	non-expensive goods, discriminating purchaser, 23:99
Newcomer rule, 23:65	professional buyers, 23:100 to 23:103
Nominative fair use, non-confusing,	special buyer classes, 23:98
23:11	Refusal of federal registration, 23:77 to
Non-customer confusion, 23:5 to 23:9	23:84
Number of buyers confused, 23:2	Related goods or services, 24:1 to 24:3,
Overall impression, similarity of mean-	24:6, 24:7
ing, 23:26	Relevance, intent, 23:110 to 23:112
Palming Off (this index)	Reversal of parts of mark, 23:46
Phonetic similarity, 23:22 to 23:24	Reverse confusion, 23:10
Picture-work equivalency, similarity of meaning, 23:27	Rule of doubt, resolution in favor of senior use, 23:64
Plural versions of words, 23:46.25	Scope of protection for stronger marks,
Post-sale confusion, 23:7	23:40.50
Prefix, similar, 23:55	Secondary meaning, 15:11 , 15:25
Preliminary injunctions, irreparable injury, 30:47	Senior user, resolution in favor of, 23:64, 23:65, 23:82
Preponderance of evidence, 23:62	Service mark, 23:76.50
Presumptions, 23:111, 23:115, 32:154	Significance of intent, 23:124
Probability as synonymous with likelihood, 23:3	Similarity, confusing, 23:20, 23:20.50, 23:21.50
Professional buyers, 23:100 to 23:103	Singular versions of words, 23:46.25
Protection of consumers, 2:1	Split of authority, questions of law or
Questions	fact, 23:71
actual confusion, 23:16	State law, test of infringement, 23:1.50
law or fact	State of mind, 23:90
generally, 23:67 to 23:75	Stronger marks, 23:40.50
appeal, 23:68 to 23:75	Subsequent litigation, effect of decision
fact issue, 23:67	in, 23:84
federal appeals, 23:68 to 23:74	Subsidiary of applicant, cited registra-
jury verdict, review of, 23:74	tion owned by, 23:83
law issue, 23:67	Suffix, similar, 23:56
split of authority, 23:71	Summary judgment, 32:120, 32:121
state appeals, 23:75	Supplemental Register, when cited,
Supreme Court, 23:72	19:37

Rock and Roll Hall of Fame, 10:23

LIKELIHOOD OF CONFUSION LITERARY, ARTISTIC AND —Cont'd **ENTERTAINMENT RIGHTS** Supreme Court, questions of law or fact, —Cont'd 23:72 Arbitration of motion picture titles, 10:37 Survey Artistic style, 6:14, 10:40.50 circuit courts, 23:73 Eveready Format, 32:174 Art works evidence, 23:17, 32:174, 32:174.50, single source, identifying, 3:8 32:184 to 32:189 use of commercial marks in, 10:23 Squirt Format, 32:174.50 Assignments, 18:36 Territorial extent of rights, 26:33 Author's name, use of, 10:26, 10:44 Test of infringement, state and federal Biography of author, 10:44 law, 23:1.50 Book titles, 10:15 The Dawn Donut Rule, 26:33 Characters in literature **Trade Dress** (this index) generally, 10:41 to 10:46 Unfair competition, 2:7 commercial products, sale of, 10:43 Use, infringing use as a "trademark," copyright, 10:44 23:11.50 copyright and patent law, 10:41 Validity of cited registration, challenge distinctive characterizations, 10:46 on, 23:80 expressive media other than, 10:42.50 Validity of trademark, expert testimony, federal preemption, 10:46 23:2.75 names, 10:20 Weak element of marks, 23:48 trademark protection, visual and, Word marks, dominant part of, 23:45 10:42 Wrongful intent, 23:104 to 23:106 unfair competition, 10:42 Coincidental use of personal name in LIMITATION OF ACTIONS fictional works, 27:87 **Statutes of Limitation** (this index) Commercially valuable data misappro-LIMITATION OF DAMAGES priation, 10:57 Punitive damages., constitutional limits, Commercial marks, goods and services 30:96.50 generally, 10:18 to 10:23 art works, use of commercial marks LIMITED AREA DEFENSE in, 10:23 **Territorial Extent of Rights** (this character names, 10:20 index) entertainment free speech, 31:149 LIMITS ON ROGERS TEST expressive works, **10:22**, **31:149** Jack Daniel's case, free speech defense, false endorsement, 10:22 31:144.20 infringement, 10:22 media, commercial marks used in, LINKING generally, 10:22, 10:23 Cyberspace, infringement in, 25A:4 Media and magazine titles without **LIQUOR** permission on, 10:19 Geographic Terms (this index) media titles used on commercial goods and services, 10:18 to LISBON AGREEMENT 10:20 Generally, 29:28 movies, 10:22 LITERARY, ARTISTIC AND negative connotations, 10:22 **ENTERTAINMENT RIGHTS** parodies, 10:22 Generally, **10:1 to 10:57** radio, television, and movie titles and Advertising, periodicals, 10:6 character names, 10:20

Affiliation, confusion of, 10:18

LITERARY, ARTISTIC AND ENTERTAINMENT RIGHTS —Cont'd	LITERARY, ARTISTIC AND ENTERTAINMENT RIGHTS —Cont'd
Commercial marks, goods and services	False—Cont'd
—Cont'd	advertising—Cont'd
Rogers test, 10:22	personal name, use in title or
sponsorship and affiliation, confusion of, 10:18	content of another's work, 27:86
television, 10:22	unauthorized editing of creative work, 27:83
Tiger Woods painting, 10:23	unauthorized use of copyrighted
video games, 10:22	work, 27:82
Cooper precedent, 10:4	endorsement, 27:88
Copyright law, 10:34 , 10:41 , 10:44	representation of being creator of idea
Cover illustrations, 10:4	or invention, 27:78
Dastar, 2003 Supreme Court decision in, 6:27, 27:78, 27:78.30	use of name of artist, author, or performer
Deceased person, use of name of, 10:26	generally, 27:85
Descriptive series titles, 10:6, 10:7.10	another's use of work, 10:30
Design patents, 6:11	Federal
Exclusive rights in titles, 10:1	preemption, 10:35, 10:46
Expressive media other than titles and	protection, 10:38 to 10:40
characters, 10:42.50	registration, 10:38
Expressive works, commercial marks used in, 10:22, 31:149	Freedom of speech, unpermitted use in expressive works, 31:149
Fair use, 10:14	Generic series titles, 10:9
False	House marks, 10:15
advertising	Insurance coverage for intellectual prop-
generally, 27:77 to 27:90	erty, 33:18 to 33:22
coincidental use of personal name	Likelihood of confusion, 10:15
in fictional works, 27:87	Literary works
copyright, false use of name on	series of
work that infringes, 27:81 to 27:83	generally, 10:6 to 10:9 descriptive series titles, 10:7.10
copyright notice, false matter in, 27:79	generic series titles, 10:9 illustrative examples, 10:8
Dastar, 2003 Supreme Court decision in, 6:27 , 27:78 , 27:78.30	periodical section or column, title of, 10:6.10
false endorsement, 27:88	secondary meaning, 10:7
imitator's claim of being creator of work, 27:81	single generally, 10:2 to 10:5
motion pictures and television programs, distinctive features of, 27:89	author's comment: single work titles should be registerable, 10:4.10
name, unauthorized use, 27:83	registration of titles, USPTO, 10:4
name of artist, author, or performer, false use of, 27:85	secondary meaning required, 10:2 USPTO register, 10:4
over-representation of artist's, author's or performer's contri- bution or currency of perfor- mance, 27:84	Media, generally. Commercial marks, goods and services, above Misappropriation generally, 10:47 to 10:57

LITERARY, ARTISTIC AND	LITERARY, ARTISTIC AND
ENTERTAINMENT RIGHTS	ENTERTAINMENT RIGHTS
—Cont'd	—Cont'd
Misappropriation—Cont'd	Personal names—Cont'd
commercially valuable data, 10:57 creation of doctrine, 10:48	public domain work, use of name of author of, 10:26
history of doctrine, 10:51	title or content of work, use in, 27:86
limitations on doctrine, 10:55 preemption provisions, 10:52 to	truthful and false use of name on work, 10:26 to 10:30
10:54	use of names in connection with works, 10:26 to 10:30
prima facie case, 10:49	Visual Artist's Rights Act, 10:29
sporting events, 10:56 trademark, generally, 10:50	Pictures, single source, identifying, 3:8
Mockbusters, 10:12	Pre-release publicity and recognition,
Movies	10:12
books, based on, 10:12	Priority rights, 10:4
commercial goods and services,	Protection from one medium to another,
10:20, 10:22	10:17
entertainment free speech, use of commercial mark, 31:149	Public domain work, use of name of author of, 10:26
Lanham Act section 43(a), 27:89	Radio titles, 10:20
Music as trademark, 6:17.50	Rock and Roll Hall of Fame, 10:23
Name of artist, author, or performer	Sears-Compco defense, 10:35
	Secondary meaning
editing, unauthorized use, 27:83 false use of	generally, 10:10 to 10:14, 15:21
	fair use, 10:14
generally, 27:85	identification of single source, 10:10
another's use of work, 10:30	pre-release publicity and recognition,
use on a work, 10:30	10:12
Names of characters	relevant evidence, 10:13
commercial goods and services, 10:20	series of literary works, 10:7
personal names, below	single literary works, 10:2
Over-representation of artist's, author's	tests of secondary meaning, 10:10
or performer's contribution or cur-	Song titles, 10:15
rency of performance, 27:84	Sponsorship, confusion of, 10:18
Parodies, 10:22 Patent law, characters in literature,	Sporting events, misappropriation, 10:56
10:41	Style, copyright, 6:14 , 10:40.50
Performing group names, federal protection, 10:40	Suggestive marks, use by media, 11:69 Supreme Court decision in Dastar
Periodicals	(2003), 6:27, 27:78, 27:78.30
advertising in, 10:6	Television, 10:20, 10:22
section or column, title of, 10:6.10	Third party uses, 10:15
Personal names	Tiger Woods painting, 10:23
generally, 10:26 to 10:30	Titles and characters, expressive media
author's name, use of, 10:26 , 10:44	other than, 10:42.50
biography of author, 10:44	Trade dress, 10:15
deceased person, use of name of, 10:26	Trademark protection, visual and literary characters, 10:42
false representation of being creator of idea or invention, 27:78	Truthful and false use of name on work, 10:26 to 10:30

LITERARY, ARTISTIC AND **ENTERTAINMENT RIGHTS** —Cont'd

Unauthorized

editing of creative work, 27:83 use, 27:82, 27:83

Unfair competition, characters in literature, **10:42**

Unregistered names and pictures, federal protection, 10:39

Video games, 10:22

Visual Artist's Rights Act, 10:29

Visual characters, trademark protection, 10:42

Weak titles, 10:15

Website menu, service mark, 10:6

Works out of copyright, 10:36

LITTLE FEDERAL TRADE **COMMISSION ACTS**

Trade libel and product disparagement, 27:114

LOCATION

Tort of trademark infringement, 32:38.40

LOGOS

Generic terms, 12:40 Infringement, 25:52.50

LONG-ARM STATUTES

Generally, 32:39 to 32:42

"LOOK FOR" PROMOTION

Secondary meaning, 15:30

Trade dress, 8:8.50

Types of marks, 7:29, 7:30

LOUISIANA

ANTI-CYBERSQUATTING ACT

Infringement in cyberspace, 25A:86

MADE IN THE USA

Generally, 29:54.50

MADRID AGREEMENT

Interaction with Madrid Protocol. 19:31.80

Members of Protocol and Agreement, 19:31.90

MADRID PROTOCOL

Generally, 19:31.20 et seq., 29:32

MADRID PROTOCOL—Cont'd

Agreement (Madrid), interaction with, 19:31.80

Applications

in-bound to USPTO for protection within U.S., 19:31.60

out-bound from USPTO to abroad, 19:31.55

Central attack and transformation, 19:31.65

Change of ownership of international registration, 19:31.75

Changes in international registration, 19:31.70

Eligible applicants, **19:31.40**

Federal registration. See entries throughout this topic

In-bound applications to USPTO for protection within U.S., 19:31.60

Interaction with Madrid Agreement, 19:31.80

International registration under, generally, 19:31.50

Members of Protocol and Agreement, 19:31.90

Out-bound applications from USPTO to abroad, 19:31.55

Overview, 19:31.20

Patent and Trademark Office operations, generally, **19:31.30**

Registration. See entries throughout this

USPTO operations, generally, 19:31.30

MADRID REGISTRATION OF MARKS TREATY

Generally, 29:31

MADRID SOURCE OF GOODS TREATY

Generally, 29:30

MALICIOUS PROSECUTION

Strength of marks, 11:93

MANUFACTURERS

Ownership of trademarks, 16:48, 16:49

MARIJUANA

Federal registration of marks, 19:124

MARKET POWER

Generally, 2:10 to 2:14

Barriers to entry, 2:13

MARKET POWER—Cont'd

Competitive process, **2:14**Judicial rejection, **2:12**Trademark as property right, **2:10**

MARKS

Definitions, **4:10**Doctrine, generally, **29:62**Infringement of a mark in 8220commerce, 8221 **25:55**

MATERIALITY

Deceptive and deceptively misdescriptive marks, 11:58
Fraud, generally, 31:67
Geographic terms, deceptive usage, 14:39

MEDIA

Literary, Artistic and Entertainment Rights (this index)

MEDIMMUNE RULE

Declaratory judgments, 32:51.50

MENS REA

Fraud, **31:66**Likelihood of confusion, **23:90**

MERCHANT'S MARK

Generally, 3:8, 16:46

MERGER

Trademark license merger rule, 18:47

META TAGS

Cyberspace, infringement in, 25A:3

MICROCOLOR

Descriptive marks, 11:47

MINIMUM CONTACTS

Personal jurisdiction, 32:38

MINI SIZE

Descriptive marks, composites, 11:28

MISAPPROPRIATION

Insurance for infringement claims, misappropriation of advertising ideas or style of doing business, **33:5**

Literary, Artistic and Entertainment Rights (this index)

Trademarks, 25:71

MISLEADING STATEMENTS

False advertising, two part test, **27:53 to 27:55**

MISSPELLINGS

Descriptive marks, 11:31 Generic terms, 12:38

MOCKBUSTERS

Literary, artistic and entertainment rights, **10:12**

MODEL STATE TRADEMARK ACT

Generally, 22:5 to 22:9.25

MODEL STATE TRADEMARK BILL

1964 version of text, **22:8** 1992 version of text, **22:9** Text of anti-dilution statute, **24:79.50** 2007 version of text, **22:9.25**

MONETARY RECOVERY

Generally, 30:57 to 30:107

Accounting of profits. Profits, recovery of, below

Actual confusion, evidence of, **30:74**Actual damages, generally, **30:72 to 30:87**

Advertising, corrective, **30:80 to 30:84** Antitrust analogy, **30:76**

Apportionment of profits, 30:65

Attorney Fees (this index)

BIGFOOT, corrective advertising, 30:81, 30:82

Constitutional limits on punitive damages, **30:96.50**

Contempt (this index)

Contribution, 30:78

Copyrights, 6:16

Corrective advertising, **30:80 to 30:84** Costs, deductions to arrive at profits,

30:68

Counterfeiting, 30:94, 30:95

Damages, generally, 30:72 to 30:87

Deception, evidence of, 30:74

Deductions from gross sales to arrive at profits, **30:66 to 30:69**

Definitions, 30:57

Design patents, 6:11

Equities, recovery of profits and weighing the equities, 30:61

False Advertising (this index)

Index-64

MONETARY RECOVERY—Cont'd	MONETARY RECOVERY—Cont'd
Federal law	Profits, recovery of—Cont'd
generally, 30:88 to 30:95	damages, recovery of, 30:79
Attorney Fees (this index)	damages and profits, recovery of,
compensation and not penalty, 30:91	30:73
counterfeiting, 30:94 , 30:95	deductions from gross sales to arrive
grounds for recovery, 30:89	at profits, 30:66 to 30:69
judicial power to adjust award, 30:90	equities, weighing, 30:61
power to increase or adjust profits, 30:90 to 30:92	income taxes, deductions to arrive at profits, 30:67
prejudgment interest, 30:93	non-competitive relationships, 30:64
punitive damages, 30:97	referral of accounting to master or
special anti-counterfeiting remedies,	magistrate, 30:71
30:94	weighing the equities, 30:61
Franchisees, reasonable royalty, 30:86	willful infringement, 30:62
Fraud, false registration, 31:85 to 31:87	Punitive damages, 30:96, 30:96.50 ,
Holdover licensees and franchisees, rea-	30:97
sonable royalty, 30:86	Referral of accounting to master or magistrate, 30:71
Income taxes, deductions to arrive at	
profits, 30:67	Registration, fraud in obtaining, 31:85 to 31:87
Indemnity, 30:78	Royalties, 30:85 to 30:87
Insurance, coverage of traditional liability policies for infringement	Theory, 30:58
claims, 33:9	Tie-ins, franchisees, 31:132 to 31:134
Intentional infringement, 30:75	
Inter partes proceedings, standing, 20:12	Weighing the equities, recovery of profits, 30:61
Laches and delay, 31:4	Willful infringement, 30:62 , 30:75
Licensees	willful lillfillgement, 30:02, 30:75
	MONOPOLIES AND RESTRAINTS
holdovers, 30:48, 30:86	MONOPOLIES AND RESTRAINTS OF TRADE
holdovers, 30:48, 30:86 irreparable injuries, 30:48	
holdovers, 30:48, 30:86 irreparable injuries, 30:48 royalties, reasonable, 30:86 Magistrate, referral of accounting to,	OF TRADE
holdovers, 30:48, 30:86 irreparable injuries, 30:48 royalties, reasonable, 30:86 Magistrate, referral of accounting to, 30:71	OF TRADE Generally, 2:11 to 2:13, 31:90 to 31:138 Aggressive use or enforcement of trademarks
holdovers, 30:48, 30:86 irreparable injuries, 30:48 royalties, reasonable, 30:86 Magistrate, referral of accounting to, 30:71 Measure of damages	OF TRADE Generally, 2:11 to 2:13, 31:90 to 31:138 Aggressive use or enforcement of trademarks generally, 31:100 to 31:103
holdovers, 30:48, 30:86 irreparable injuries, 30:48 royalties, reasonable, 30:86 Magistrate, referral of accounting to, 30:71 Measure of damages generally, 30:77	OF TRADE Generally, 2:11 to 2:13, 31:90 to 31:138 Aggressive use or enforcement of trademarks generally, 31:100 to 31:103 bad faith infringement suits, 31:102
holdovers, 30:48, 30:86 irreparable injuries, 30:48 royalties, reasonable, 30:86 Magistrate, referral of accounting to, 30:71 Measure of damages generally, 30:77 false advertising, 27:43	OF TRADE Generally, 2:11 to 2:13, 31:90 to 31:138 Aggressive use or enforcement of trademarks generally, 31:100 to 31:103
holdovers, 30:48, 30:86 irreparable injuries, 30:48 royalties, reasonable, 30:86 Magistrate, referral of accounting to, 30:71 Measure of damages generally, 30:77 false advertising, 27:43 Multiple recoveries, 6:16	OF TRADE Generally, 2:11 to 2:13, 31:90 to 31:138 Aggressive use or enforcement of trademarks generally, 31:100 to 31:103 bad faith infringement suits, 31:102 cease and desist letters, indiscriminate
holdovers, 30:48, 30:86 irreparable injuries, 30:48 royalties, reasonable, 30:86 Magistrate, referral of accounting to, 30:71 Measure of damages generally, 30:77 false advertising, 27:43 Multiple recoveries, 6:16 Practice, 30:58	OF TRADE Generally, 2:11 to 2:13, 31:90 to 31:138 Aggressive use or enforcement of trademarks generally, 31:100 to 31:103 bad faith infringement suits, 31:102 cease and desist letters, indiscriminate sending, 31:100
holdovers, 30:48, 30:86 irreparable injuries, 30:48 royalties, reasonable, 30:86 Magistrate, referral of accounting to, 30:71 Measure of damages generally, 30:77 false advertising, 27:43 Multiple recoveries, 6:16 Practice, 30:58 Prejudgment interest, 30:93	OF TRADE Generally, 2:11 to 2:13, 31:90 to 31:138 Aggressive use or enforcement of trademarks generally, 31:100 to 31:103 bad faith infringement suits, 31:102 cease and desist letters, indiscriminate sending, 31:100 over-aggressive enforcement, 31:101 over-lax enforcement, 31:101
holdovers, 30:48, 30:86 irreparable injuries, 30:48 royalties, reasonable, 30:86 Magistrate, referral of accounting to, 30:71 Measure of damages generally, 30:77 false advertising, 27:43 Multiple recoveries, 6:16 Practice, 30:58 Prejudgment interest, 30:93 Profits, recovery of	OF TRADE Generally, 2:11 to 2:13, 31:90 to 31:138 Aggressive use or enforcement of trademarks generally, 31:100 to 31:103 bad faith infringement suits, 31:102 cease and desist letters, indiscriminate sending, 31:100 over-aggressive enforcement, 31:101
holdovers, 30:48, 30:86 irreparable injuries, 30:48 royalties, reasonable, 30:86 Magistrate, referral of accounting to, 30:71 Measure of damages generally, 30:77 false advertising, 27:43 Multiple recoveries, 6:16 Practice, 30:58 Prejudgment interest, 30:93 Profits, recovery of generally, 30:59 to 30:71	OF TRADE Generally, 2:11 to 2:13, 31:90 to 31:138 Aggressive use or enforcement of trademarks generally, 31:100 to 31:103 bad faith infringement suits, 31:102 cease and desist letters, indiscriminate sending, 31:100 over-aggressive enforcement, 31:101 over-lax enforcement, 31:101 Agreements among competitors, 31:109
holdovers, 30:48, 30:86 irreparable injuries, 30:48 royalties, reasonable, 30:86 Magistrate, referral of accounting to, 30:71 Measure of damages generally, 30:77 false advertising, 27:43 Multiple recoveries, 6:16 Practice, 30:58 Prejudgment interest, 30:93 Profits, recovery of generally, 30:59 to 30:71 accounting of profits, 30:59 et seq.	OF TRADE Generally, 2:11 to 2:13, 31:90 to 31:138 Aggressive use or enforcement of trademarks generally, 31:100 to 31:103 bad faith infringement suits, 31:102 cease and desist letters, indiscriminate sending, 31:100 over-aggressive enforcement, 31:101 over-lax enforcement, 31:101 Agreements among competitors, 31:109 to 31:112
holdovers, 30:48, 30:86 irreparable injuries, 30:48 royalties, reasonable, 30:86 Magistrate, referral of accounting to, 30:71 Measure of damages generally, 30:77 false advertising, 27:43 Multiple recoveries, 6:16 Practice, 30:58 Prejudgment interest, 30:93 Profits, recovery of generally, 30:59 to 30:71 accounting of profits, 30:59 et seq. accounting period, 30:70	OF TRADE Generally, 2:11 to 2:13, 31:90 to 31:138 Aggressive use or enforcement of trademarks generally, 31:100 to 31:103 bad faith infringement suits, 31:102 cease and desist letters, indiscriminate sending, 31:100 over-aggressive enforcement, 31:101 over-lax enforcement, 31:101 Agreements among competitors, 31:109 to 31:112 Antitrust law, 31:90.50
holdovers, 30:48, 30:86 irreparable injuries, 30:48 royalties, reasonable, 30:86 Magistrate, referral of accounting to, 30:71 Measure of damages generally, 30:77 false advertising, 27:43 Multiple recoveries, 6:16 Practice, 30:58 Prejudgment interest, 30:93 Profits, recovery of generally, 30:59 to 30:71 accounting of profits, 30:59 et seq. accounting period, 30:70 actual confusion, evidence of, 30:63	Generally, 2:11 to 2:13, 31:90 to 31:138 Aggressive use or enforcement of trademarks generally, 31:100 to 31:103 bad faith infringement suits, 31:102 cease and desist letters, indiscriminate sending, 31:100 over-aggressive enforcement, 31:101 over-lax enforcement, 31:101 Agreements among competitors, 31:109 to 31:112 Antitrust law, 31:90.50 Bad faith infringement suits, 31:102
holdovers, 30:48, 30:86 irreparable injuries, 30:48 royalties, reasonable, 30:86 Magistrate, referral of accounting to, 30:71 Measure of damages generally, 30:77 false advertising, 27:43 Multiple recoveries, 6:16 Practice, 30:58 Prejudgment interest, 30:93 Profits, recovery of generally, 30:59 to 30:71 accounting of profits, 30:59 et seq. accounting period, 30:70 actual confusion, evidence of, 30:63 apportionment of profits, 30:65	Generally, 2:11 to 2:13, 31:90 to 31:138 Aggressive use or enforcement of trademarks generally, 31:100 to 31:103 bad faith infringement suits, 31:102 cease and desist letters, indiscriminate sending, 31:100 over-aggressive enforcement, 31:101 over-lax enforcement, 31:101 Agreements among competitors, 31:109 to 31:112 Antitrust law, 31:90.50 Bad faith infringement suits, 31:102 Case law, generally, 31:109 to 31:112
holdovers, 30:48, 30:86 irreparable injuries, 30:48 royalties, reasonable, 30:86 Magistrate, referral of accounting to, 30:71 Measure of damages generally, 30:77 false advertising, 27:43 Multiple recoveries, 6:16 Practice, 30:58 Prejudgment interest, 30:93 Profits, recovery of generally, 30:59 to 30:71 accounting of profits, 30:59 et seq. accounting period, 30:70 actual confusion, evidence of, 30:63 apportionment of profits, 30:65 background, 30:59	Generally, 2:11 to 2:13, 31:90 to 31:138 Aggressive use or enforcement of trademarks generally, 31:100 to 31:103 bad faith infringement suits, 31:102 cease and desist letters, indiscriminate sending, 31:100 over-aggressive enforcement, 31:101 over-lax enforcement, 31:101 Agreements among competitors, 31:109 to 31:112 Antitrust law, 31:90.50 Bad faith infringement suits, 31:102 Case law, generally, 31:109 to 31:112 Competitors, agreements among, 31:109 to 31:112 Constitutional right of free access to
holdovers, 30:48, 30:86 irreparable injuries, 30:48 royalties, reasonable, 30:86 Magistrate, referral of accounting to, 30:71 Measure of damages generally, 30:77 false advertising, 27:43 Multiple recoveries, 6:16 Practice, 30:58 Prejudgment interest, 30:93 Profits, recovery of generally, 30:59 to 30:71 accounting of profits, 30:59 et seq. accounting period, 30:70 actual confusion, evidence of, 30:63 apportionment of profits, 30:65	Generally, 2:11 to 2:13, 31:90 to 31:138 Aggressive use or enforcement of trademarks generally, 31:100 to 31:103 bad faith infringement suits, 31:102 cease and desist letters, indiscriminate sending, 31:100 over-aggressive enforcement, 31:101 over-lax enforcement, 31:101 Agreements among competitors, 31:109 to 31:112 Antitrust law, 31:90.50 Bad faith infringement suits, 31:102 Case law, generally, 31:109 to 31:112 Competitors, agreements among, 31:109 to 31:112

MONOPOLIES AND RESTRAINTS MONOPOLIES AND RESTRAINTS OF TRADE—Cont'd OF TRADE—Cont'd Distribution of trademarked goods. Relationship between antitrust law and restrictions on, 31:113, 31:114 trademark and unfair competition law, 31:90.50 Distribution or business format Requirements of monopolization and franchise, tie-ins, 31:129 attempts to monopolize, 31:94 Exclusive dealing restrictions, 31:135, Resale price control, 31:115 31:136 Restraints of trade, generally, 31:108 to First Amendment defense under Noerr-31:138 Pennington, 31:104, 31:105 Safety justification, vertical restrictions, Franchise tie-ins, 31:128 31:118 Fraudulently obtained registration Sham exception to Noerr-Pennington generally, 31:95 to 31:99 First Amendment defense, 31:105 economic market, trademark does not Soft-drink bottlers act, vertical restricdefine, 31:97 tions, 31:122 generic names, 31:99 Standing to sue, restrictions on distribuincremental exclusionary effect of tion of trademarked goods, 31:114 registration, 31:98 Tie-ins patent and trademark differences. generally, 31:123 to 31:134 31:96 damages to franchisees, 31:132 to 31:134 Free access to courts and administrative defining two separate items, 31:126 to tribunals, constitutional right, 31:131 31:105 distribution or business format Free competition and fair competition, franchise, 31:129 1:20 to 1:22 franchise tie-ins, 31:128 Generic terms, 31:99 offset theory, damages to franchisees, Health justification, vertical restrictions, 31:133 31:118 patent-trademark tying, 31:131 Historical fear of, 1:4 quality control, 31:125 Image restrictions, 31:137 sufficient economic power to impose, Imported goods, gray market, 29:52 31:124 Incontestable registrations, 31:92 test of separateness, 31:127 Licenses, 18:62 Trademark law, 31:90.50 Monopolization, generally, 31:93 to Unclean hands, 31:91 31:107 **Unfair Competition** (this index) Non-approved products, bans on sale by Vertical restrictions licensee, 31:136 generally, 31:116 to 31:122 Non-price vertical restrictions, 31:116 health and safety justification, 31:118 Offset theory, damages to franchisees, non-price, 31:116 31:133 non-sale trademark licenses, restrictions in, 31:121 Over-aggressive enforcement of trademarks, 31:101 parallel imports restrictions, 31:120 product quality restrictions, 31:119 Over-lax enforcement of trademarks, 31:101 rule of reason, 31:117 to 31:121 Parallel imports restrictions, 31:120 soft-drink bottlers act, exemption, 31:122 Patent-trademark tying, 31:131 Supreme Court's trilogy, 31:116 Political power, 1:5 Product quality restrictions, 31:119 MOOTNESS

Injunctions, 30:11

Quality control, tie-ins, 31:125

MOTION MARKS

Generally, **7:109**

MOTIONS

Default judgment, **32:121.90**Inter Partes Proceedings (this index)
Summary judgment, failure to state a claim, **32:121.50** to **32:121.90**

MOVIES

Commercial marks, goods and services, 10:22

Counterfeiting, **25:12**False advertising, **27:89**Freedom of cheech supporting to the counterfeit of the co

Freedom of speech, unpermitted use of commercial mark, **31:149**

Literary, artistic and entertainment rights, 10:20, 27:89, 31:149
Registration, 10:37

MULTIDISTRICT LITIGATION

Venue, 32:77

MULTIPLE CLASSIFICATIONS

Federal registration, application for goods and services falling in multiple classifications, **19:56.50**

MULTIPLE MARKS

Generally, **7:1 to 7:8** Co-branding, **7:8** House marks, **7:5**

International ownership, multiple owners, 29:7

Multiple owners, **7:8**, **29:7** One owner, **7:1** to **7:7**

Product or service can be identified by more than one mark, 7:2

Too many marks, 7:7

MUSIC

Eligibility trademark, 6:17.50

MUTILATION

Federal registration of less than whole trademark, **19:59**

NAFTA

Geographic terms deceptive usage, 14:31

NAKED LICENSING

Generally, 18:48

NAMES

Federal registration, 19:78.50

NAMES—Cont'd

Infringement of Native American names, **25:67.50**

Literary, Artistic and Entertainment Rights (this index)

Personal Names (this index)

NATIVE ADVERTISING

Deceptively formatted, 27:66.70

NATIVE AMERICAN INSIGNIA AND NAMES

Infringement of, 25:67.50

NATURAL EXPANSION

Territorial extent of rights, **26:20**, **26:22 to 26:24**

NEGLECT, EXCUSABLE

Reopening of testimony period, 20:119

NEGLIGENCE

Franchises, 18:76

NEWS REPORTING AND COMMENTARY

Dilution of trademarks, 24:127

NEW YORK

False advertising and deceptive practices, **27:116**LEXIS vs. LEXUS, **24:85**

NEW YORK ANTI CYBERSQUATTING ACT

Infringement in cyberspace, 25A:85

NEW YORK RULE

Secondary meaning, 15:12 to 15:18

NICHE FAME

Dilution of trademarks, **24:79.50**, **24:105**

NICKNAMES

Generally, 7:18

Personal names as marks, 13:20

NOERR-PENNINGTON ACT

Monopolies and restraints of trade. First Amendment defense, **31:104**, **31:105**

NOMINATIVE FAIR USE

Generally, 11:45

Freedom of speech, 31:156.50 Likelihood of confusion, 23:11

NON-COMPETITIVE GOODS OR SERVICES, USE OF MARK ON

Generally, 24:1 to 24:134

Dilution of Trademarks (this index) **Related Goods or Services** (this index)

NON-COMPETITORS

False advertising, 1:11 Infringement, 1:11 Standing, 27:32 Unfair competition, 1:8, 1:11

NONFUNGIBLE TOKENS (NFTS)

Use and misuse of trademarks, 25A:4.70

NON-MARKS

Supplemental register, 4:12

NONPROFIT ORGANIZATIONS

Trade names, 9:5

NON-TRADITIONAL FORMATS

Policy issues, 7:105

NORTON-NORWICH FOUR FACTORS ANALYSIS

Functionality, 7:73

NOTICE AND KNOWLEDGE

Constructive Notice (this index)

Copyright, elements of, 6:25, 6:26

Federal Registration (this index)

Insurance coverage for infringement claims, knowledge of falsity exclusion, 33:14.50

Inter Partes Proceedings (this index)

Laches and delay, 31:17

Territorial extent of rights, geographically remote use, **26:9**, **26:10**

Trade libel and product disparagement, 27:104

NUMBERS

Generally, 7:14 to 7:17

Broadcast frequency designations, 7:17

Strength, 7:15

Style or grade designations, 7:16

Telephone number letter combinations, 7:13

Validity, 7:15

OBJECTIONS

Survey evidence, 32:179

OBSCURE TERMS

Descriptive marks, 11:33

OCTANE RULE

Enforcement, strength of marks, 11:93

OFFICIAL GAZETTE

Inter partes proceedings, 20:4

OFFSET THEORY

Monopolies and restraints of trade, damages to franchisees, **31:133**

OLYMPIC SYMBOLS

Infringement, 25:60 to 25:62

OPPOSITION

Generally, **20:1** to **20:6**

Consumer standing, petition to cancel, **20:47**

Equitable defenses, 20:31 to 20:39

Ex parte and inter partes matters, 4:18

Grounds, 20:13 to 20:21.50

Inter partes proceedings, compulsory counterclaims, 20:23

Inter partes proceedings, generally, **20:1** et seq.

Pleading and proof, 20:22 to 20:30

Standing, 20:7 to 20:12

Time within which to file, 20:5

ORNAMENTAL SYMBOLS AND DESIGNS

Generally, 7:24

OVERLY-AGGRESSIVE ENFORCEMENT

Strength of marks, 11:93

OWNERSHIP OF TRADEMARKS

Generally, 16:35 to 16:49

Advertising agency/client, 16:39

Assignments, automatic updating of ownership of applications and registrations, 18:11.50

Change of ownership of international registration, **19:31.75**

Corporate officer, employer/employee or. **16:36**

Dealers, 16:46 to 16:49

Descriptive marks, 11:23.50

Domestic disputes, manufacturers and dealers, 16:48

Employer/employee or corporate officer, 16:36

Index-68

OWNERSHIP OF TRADEMARKS —Cont'd	PARIS CONVENTION—Cont'd Federal registration, 19:74
Foreign disputes, manufacturers and	PARODY
dealers, 16:49 Government owned, 1:7 Group and leaving member, 16:39.50 Inter partes proceedings, 20:18, 20:29 Joint Ownership of Trademarks (this index) Landlord/tenant, 16:38 Leaving member, group and, 16:39.50 Licensee's use inures to benefit of trademark owner, 18:45.50 Manufacturers, 16:48, 16:49 Parent and subsidiary corporations,	PARODY Commercial marks, goods and services, 10:22 Dilution of trademarks, 24:90 Freedom of speech affirmative defense, 31:153 infringement, 31:154 non-infringement, 31:155 PARTIES Standing (this index) PARTNERSHIPS
16:37	Laches and delay, imputation of notice, 31:39
PALMING OFF Generally, 25:1 to 25:9.50 Adding brand to unbranded goods, 25:9 Express passing off, 25:5 reverse passing off, 25:6 Fraud, 25:3 Implied	PASSING OFF Different meanings of, 25:1 Express, 25:5 Implied, 25:7 Reverse express, 25:6 implied, 25:8
passing off, 25:7 reverse passing off, 25:8 Intentional substitution, 25:3 Likelihood of confusion, hyperbole for, 25:2	PATENT AND TRADEMARK OFFICE Generally, 6:9 Concurrent use proceedings, 20:81 to 20:88 Director of Patents and Trademarks
Passing off different meanings of, 25:1 express, 25:5 implied, 25:7 reverse, express, 25:6 reverse implied, 25:8 Removing mark and selling product unbranded, 25:8 Secondary meaning, 15:16 Variations, 25:4 to 25:9	(this index) Fastener Quality Act, federal registration with PTO, 19:149 Federal question jurisdiction, 32:14 Laches and delay, 31:37 Madrid Protocol (this index) Pleading fraud in USPTO, 31:84 Related goods or services, federal registration, 24:66 Res Judicata and Collateral Estoppel (this index)
PARALLEL IMPORTS	Survey evidence, 32:180
Imported Goods (this index) Restraints of trade, 31:120	PATENTS Generally, 6:1 to 6:12
PARENT AND SUBSIDIARY CORPORATIONS Ownership of trademarks, 16:37	"Back door" patents, trade dress, 8:5 Chart, 6:6 Common denominators, 6:4
PARIS CONVENTION	Confusion in the legal world, 6:1 Constitutional basis, 6:2
Generally, 29:25 , 29:62 Famous marks, 4:16	Court of Appeals for Federal Circuit, 21:11

PATENTS—Cont'd

Design patents and trade dress, **6:11**Design patents and trademarks, **7:91**Expiration of patent, effect on trade dress, **6:12**

Expiration of patent, effect on trademark, **6:12**

False advertising, alleged infringement, **27:66.40**

Functionality, 6:10

Generic Terms (this index)

Literature, characters in, 10:41, 10:44

Policy, 6:3

Trademarks, compared, 6:3

Types of patents, 6:7

Unfair competition, 1:8, 1:11

United States Patent and Trademark Office, **6:9**

form statements in support of a secondary meaning, **15:74**

Utility patent and trademark conflict, **6:10**

PENDENT JURISDICTION

Choice of law, **32:36**Federal supplemental, **32:20**Unfair competition claims, **32:36**

PERCEPTION

Secondary Meaning (this index)

PERSONAL JURISDICTION

Generally, 32:38 to 32:45.50

Advertising, long-arm statutes, 32:41

Federal courts, 32:43 to 32:45

Foreign defendants, 32:45

In rem jurisdiction, 25A:71, 32:38.50

Internet usage, **32:45.50**

Long-arm statutes, 32:39 to 32:42

Minimum contacts, 32:38

National contacts, 32:45

Personal service, 32:38

Service of process, 32:38, 32:44

Site where tort of trademark infringement occurs, 32:38.40

Torts, long-arm statutes, 32:39

Transaction of business, long-arm statutes, **32:39**

PERSONAL LIABILITY

Contributory infringement, 25:24

PERSONAL NAMES

Generally, 13:1 to 13:39

Abbreviations and nicknames, 13:20

Absolute injunctions, 13:9, 13:12

Acquisition of name rights, bad faith, 13:15, 13:17

Assignments (this index)

Bad faith

generally, 13:15, 13:17

acquisition of name rights, 13:17 to 13:19

corporation, acquisition of name by, 13:18

personal name, use, **13:15**, **13:17** purchase and use of personal name,

13:17

Rogers Silverware, 13:17

use of one's own name, 13:15

Waterman Pen, 13:17

Burden of proof, federal registration, 13:33

Business mark, absolute prohibition against use of own name as, 13:12

Classic fair use defense, freedom to use one's own name, 13:13

Commercial interest in, false endorsements, **28:17**

Composite surname marks, federal registration, 13:31

Consent, federal registration of marks which comprise name, portrait or signature of living individual without, 13:37 to 13:39

Corporation, acquisition of name by, 13:18

Courtesy prefixes and suffixes to surnames, federal registration, 13:32

Cyberspace, infringement in (this index)

Expressive media, Rogers Test, 27:86

Fair use, generally, **13:6 to 13:22**

False suggestion of connection with persons living or dead, federal registration, 13:35

Family name, 13:9.50

Famous names, 13:25, 13:26

Federal Anti-cybersquatting Act, **25A:79** to **25A:83**

Federal registration

generally, 13:27 to 13:39

PERSONAL NAMES—Cont'd	PERSONAL NAMES—Cont'd
Federal registration—Cont'd	Limited injunctions against use of own
burden of proof, 13:33	name, 13:9
composite surname marks, 13:31	Literary, Artistic and Entertainment
consent, marks which comprise name,	Rights (this index) Modifications of one's personal name,
portrait or signature of living individual without, 13:37 to	13:19
13:39	Modifications ordered to prevent confu-
courtesy prefixes and suffixes to	sion, freedom to use one's own
surnames, 13:32	name, 13:11
false suggestion of connection with	Nicknames, 13:20
persons living or dead, 13:35	No one in defendant's organization with
first amendment limitations, 13:37.50	name in issue, 13:14 Professional professes and suffixes to
illustrative examples, 13:30.50 incontestable surname registration,	Professional prefixes and suffixes to surnames, federal registration,
effect of, 13:36	13:32
names of performers and	Publicity, right of, 13:39
sportspersons, 13:34	Qualified right to use one's own name,
primarily merely a surname, 13:29,	13:8
13:30	"Sacred" right to use one's own name,
professional prefixes and suffixes to	13:7, 13:8 Sala of rights in own name, use ofter
surnames, 13:32	Sale of rights in own name, use after, 13:10
publicity, right of, 13:39	Secondary meaning
tests for determining whether term is primarily merely a surname,	generally, 13:2 to 13:5
13:30	identification of source, 13:4
Findlay Brothers, 13:8	rationales, 13:3
Freedom to use one's own name	requirement, 13:2
generally, 13:6 to 13:13	Tarantino's Restaurant, 13:8
archaic right, 13:7	Telephone directories, 13:30
bad faith use, 13:15	Video games, 27:86
business mark, absolute prohibition	PERSONAL SERVICE
against use of own name as,	Personal jurisdiction, 32:38
classic fair use defense, 13:13	PETITIONS
limited injunctions against use of own	Cancellation proceedings, standing,
name, 13:9	20:46, 20:49
modifications of one's personal name,	Director of Patents and Trademarks, 21:5 to 21:7
13:19	
modifications ordered to prevent confusion, 13:11	PHANTOM REGISTRATIONS
qualified right, 13:8	Generally, 19:61
"sacred" right, 13:7	PHISHING
sale of rights in name, use following,	Generally, 25A:2
13:10	PHONETIC SIMILARITY
Generic terms, 12:33, 13:24	Generic terms, foreign, 12:44
Given names, abbreviations and	Likelihood of confusion, 23:22 to 23:24
nicknames, 13:20	
Historical names, 13:25, 13:26	PICTURES
Incontestable surname registration,	Commercial use, 6:18
effect of, 13:36	Copyrights, 6:18

PICTURES—Cont'd

Descriptive marks, 7:35 to 7:37 Functionality, 7:37 Generic terms, 7:37 Single source, identifying, 3:8

PILOT TESTS

Survey evidence, 32:163.50

PLACE OR LOCATION

Tort of trademark infringement, 32:38.40

PLANT VARIETAL NAMES

Generic terms, 12:36

PLEADINGS

Generally, **32:201 to 32:204**Cancellation Proceedings (this index)

Compulsory Counterclaims (this index)

Fraud, **31:84**

Inter Partes Proceedings (this index) Secondary meaning, 32:202

PLURAL VERSIONS OF WORDS

Likelihood of confusion, 23:46.25

POLICY REASONS FOR PROTECTION

Generally, **2:1 to 2:9**

Commercial morality violation, 2:9

Costs, buyers, 2:5

Economic functions of trademarks, 2:3

Encouragement of quality, 2:4

Exclusive rights or monopolies, 1:23 to

1:26, 2:11 to 2:13

Global reality of trademarks, 2:6

Historical origin, 2:1

Likelihood of confusion, 2:7

Property right, 2:10

Scope, broad, 2:8

Search costs reduction, 2:5

Unclean hands, 31:53

Unfair competition, generally, 2:7, 2:8

POLITICAL GROUPS

Cyberspace, infringement in, Lanham Act, **25A:46**

Trade names, 9:6

POLITICAL POWER

Unfair competition, 1:5

POLITICAL USE OF COMMERCIAL MARKS

Free speech protection, 31:147

PREDATORY ENFORCEMENT

Strength of marks, 11:93

PREDOMINANT USE TEST, MINORITY RULE

Publicity, 28:19

PREEMPTION

Federal Preemption (this index)

PREJUDGMENT INTEREST

Monetary recovery, 30:93

PREJUDICE

Laches and delay, 31:2, 31:12, 31:13

PRELIMINARY INJUNCTIONS

Generally, 30:30 to 30:56

Appeals, 30:56

Balancing of hardships, 30:51

Basic factors, 30:31

Bond, 30:55

Counterfeiting (this index)

Criteria, 30:30 to 30:33

Delay in seeking preliminary injunction, irreparable injury, **30:48.50**

Ebay patent precedent, irreparable injury, 30:47.30, 30:47.70

False advertising, 27:37

Hearings (this index)

Holdover licenses, irreparable injury, 30:48

Irreparable injury

generally, 30:46 to 30:49

presumption, 30:47, 30:47.50

Laches and delay, 31:31, 31:32

Nature, 30:30

Preservation of status quo, 30:50

Presumption, irreparable injury, **30:47 to 30:47.50**

Probability of success, 30:45

Procedure, 30:54 to 30:56

Public interest, 30:52

Res judicata, 32:92

Third parties, protection of, 30:52

Unclean hands, 31:56

PREPONDERANCE OF EVIDENCE

Likelihood of confusion, 23:62

PRESCRIPTION DRUGS	PRESUMPTIONS—Cont'd
Pharmaceuticals (this index)	Likelihood of confusion
PRESUMPTIONS	generally, 23:115, 32:154
Generally, 32:134 to 32:157	intent to confuse, 23:111
Abandonment of rights, presumption after three years, 17:18	Prima facie evidentiary status, 32:134 to 32:139
Abandonment of rights, presumption	Quieting title of mark, 32:142
after three years, burden to rebut, 17:21	Scope of presumption, 32:136, 32:137, 32:152
Contestable registrations	Strength of
generally, 32:134 to 32:139	mark, challenge to, 32:155 presumption, 32:138
elements presumed, 32:136	Trademark Law Revision Act, 32:135,
goods and format, 32:137	32:140
mark may be challenged on any	Validity
ground, 32:139	foreclosed challenges to, 32:148
prima facie evidentiary status, 32:134 to 32:139	registration, 32:134 to 32:157
scope of presumption, 32:136, 32:137	PRETRIAL DISCLOSURE
strength of presumption, 32:138	Inter partes proceedings, 20:115.50
Trademark Law Revision Act, 32:135	PRICE LISTS
Equitable defenses, 32:150 , 32:151	Copyright in, 6:30
Foreclosed challenges to validity,	
32:148	PRIMA FACIE CASE
Format, contestable registrations,	Consumer protection, 2:24
32:137	PRIMA FACIE EVIDENCE
Goods, contestable registrations, 32:137	False advertising, 27:24
Incontestable registrations	Misappropriation, 10:49
generally, 32:140 to 32:157	Presumptions, 32:134 to 32:139
defenses to incontestability, effect of, 32:157	Publicity, 28:7
equitable defenses, 32:150, 32:151	PRIMARILY GEOGRAPHICALLY
exceptions to incontestability, 32:147	DESCRIPTIVE MARKS
to 32:153	Federal registration, 14:27 to 14:29
likelihood of confusion, 32:154	PRINCIPAL REGISTER
list of nine exceptions to incontest- ability, 32:149	Definition, 4:12 Federal Registration (this index)
offensive-defensive distinction, 32:144	Generic terms, 12:58
proof of exception, effect of, 32:153	Product and container shapes, 7:94
quieting title of mark, 32:142	PRIORITY OF RIGHTS
scope of presumption as to goods and format, 32:152	Acquisition and Priority of Rights (this index)
status of incontestability, 32:141,	
32:142	PRIVACY
strength of mark, challenge to, 32:155	Publicity, 28:3 , 28:5 , 28:6
"swiss cheese" rule, 32:147	Survey evidence, respondents, 32:183
Third Circuit, 32:156	PRIVILEGE
Trademark Law Revision Act, 32:140	Exempt, trade libel and product
validity of mark, 32:142	disparagement, 27:110

PRODUCT AND CONTAINER SHAPES

Generally, 7:53 to 7:59, 7:94 to 7:97

Descriptive marks, 11:51

Federal

law, generally, 7:54 to 7:59

preemption, 7:56 to 7:58, 7:96, 7:97

protection, Lanham Act, 1:18, 7:59

registration, 7:60

registration, below

Functional or commonplace packaging, 7:87

Lanham Act

elements of trade dress infringement, 7:59

federal protection, 1:18, 7:59

Principal Register, 7:94

Product simulation law becomes part of trade dress law, **7:55**

Registration

generally, 7:94 to 7:97

preemption, 7:96, 7:97

Principal Register, 7:94

Sears-Compco, federal preemption, **7:96, 7:97**

Supplemental Register, 7:95

Sears-Compco, federal preemption of state law

generally, 1:18, 1:19, 7:53

case law, **7:56**, **7:58**, **7:96**

federal registration, 7:96, 7:97

impact, 7:57, 7:96

Supreme Court, 7:58

State law, generally, 7:53

Supplemental Register, 7:95

Trade dress law, 1:24, 7:55

PRODUCT ATTRIBUTE

Adjective-noun debate, generic terms, 12:10

PRODUCT DISPARAGEMENT

Trade Libel and Product Disparagement (this index)

PRODUCTION OF DOCUMENTS

Inter partes proceedings, T.T.A.B. discovery, **20:110**

PRODUCT WARNINGS

Copyrights, 6:19

PROFESSIONAL GROUPS

Trade names, 9:6

PROFESSIONAL TRADE NAMES

Corporate, Business and Professional Trade Names (this index)

PROFITS

Monetary Recovery (this index)

Valuation of good will, 2:21

PROMOTIONAL GOODS

Related goods or services, trademark rights on promotional goods, **24:9.50**

PROMOTION OR COMMERCIAL ADVERTISING

False advertising, 27:71

PROPERTY RIGHTS

Good will, 2:15

Policy reasons for protection, 2:10

PROTEST LETTER

Generally, 19:130

P.T.O.

Patent and Trademark Office (this index)

PUBLICATION

Trade libel and product disparagement, 27:102

PUBLIC DOMAIN

Unfair Competition (this index)

PUBLICITY

Generally, 28:1 to 28:21

Advertising, noncelebrity, 28:17

Balancing free speech with right of

publicity, 28:19

Celebrity identity, 28:3

Chart of significant differences between trademarks and right of publicity, **28:9**

Commercial speech, 28:16, 28:18

Defenses. Freedom of speech and press, below

Entertainment speech, 28:18

Expressive speech, 28:16

False endorsements

generally, 28:14 to 28:17

commercial marks, goods and services, **10:22**

PUBLICITY—Cont'd	PUNITIVE DAMAGES—Cont'd
Freedom of speech and press	Monetary recovery, 30:96, 30:96.50,
generally, 28:18 to 28:21	30:97
advertising protected works, 28:21	QUALIFICATION OR
balancing free speech and right of	DISQUALIFICATION
publicity, 28:19	Inter partes proceedings, motion for
balancing methods, 28:19	opposing attorney's disqualifica-
commercial speech, 28:18 defense to false endorsements, 28:16	tion, 20:137
entertainment speech, 28:18	QUALITY
football players, college, 28:19	Generally, 3:11
life story rights, 28:20	Encouragement of quality, 2:4
past issues, media, 28:21	Licenses, 18:55 to 18:61
Predominant Use Test, minority rule,	Related goods or services, 24:15
28:19	Source
Rogers Test, 28:19	control, 3:11
Transformative Test, majority rule,	theory, supplements, 3:11
28:19	QUESTIONS OF LAW OR FACT
video games, 28:19	Likelihood of Confusion (this index)
Incidental use, 28:7.50 Lanham Act, false endorsements, 28:15	
Licenses. Assignments and licenses,	QUIETING TITLE
above	Presumptions, 32:142
Life story rights, 28:20	REASONABLY INFORMED BUYER
Noncelebrity false endorsements, 28:17	Descriptive marks, 11:21
Origin of right, 28:3 to 28:5	-
Personal names, 13:39, 28:17	REASONABLY PRUDENT
Predominant Use Test, minority rule,	PURCHASER
28:19 Proliminary injunctions 28:15	Likelihood of Confusion (this index)
Preliminary injunctions, 28:15 Pre-release, 10:12	RECALL OF PRODUCTS
Prima facie case, 28:7	Injunctions, 30:8
Prior exploitation, 28:11	REFUNDS
Privacy, right of, 28:2, 28:3, 28:5, 28:6	
Rogers Test, 28:16, 28:19	Injunctions, 30:8
Secondary meaning, 15:57	REGISTRATION
Sources of right, 28:3 to 28:5	Generally. Federal Registration (this
State law, 28:2	index)
Test of infringement, 28:12	Foreign courts, 29:5
Transfer rules, 28:13	Foreign governments, 29:5
Transformative Test, 28:19 PUERTO RICO	Incontestabable registration status, strength of marks, 11:84
Generally, 22:10	International aspects of trademark law 29:5
PUFFING	Priority, 16:1.50, 16:18
Descriptive marks, 11:17	Territorial extent of rights, 26:52.50
Examples, 27:38.50	REJECTION
False advertising, 27:38	Final rejection and ex parte appeal,
PUNITIVE DAMAGES	19:127
Constitutional limits 30:96 50	Service marks goods in trade 19:87

RELATED COMPANY

Controlled licensee, 18:51 Rule, federally registered marks, 18:49

RELATED GOODS OR SERVICES

Generally, 24:1 to 24:66

Adjacent markets, protection of, **24:17** Affiliation, likelihood of confusion as to, 24:6, 24:7

Applications, Polaroid test, 24:58 Archaic "same descriptive properties" rule, 24:4

Bridging the gap, 24:18

Channels of trade, products sold through same, **24:51 to 24:53.50**

Class of related goods, defining, 24:46 to 24:48

Clothing, 24:47

Competition not necessary, 24:13, 24:14 Competitive goods, 24:22, 24:23

Complementary goods used together, 24:26

Computer technology, 24:44

Conflict between goods and services, 24:25

Confusion without competition, 24:1 Customer perception of likely expansion of product market, 24:19

Decisions that step beyond the line, 24:10

Defined, 24:24 to 24:27

Distance, how great, 24:8

District of Columbia Circuit, factors used by, 24:42

Eighth Circuit, factors used by, 24:38 Eleventh Circuit, factors used by, 24:41

Examples, 24:61, 24:62

Factors used by circuits, 24:30 to 24:43 Federal Circuit, factors used by, 24:43

Federal registration

generally, 24:63 to 24:66

identification of goods, determination of, 24:64

Patent and Trademark Office classification, 24:66

refusal of registration, 24:63, 24:64 remedies of owner of registered mark, 24:65, 24:66

Fifth Circuit, factors used by, 24:35 First Circuit, factors used by, 24:31 Food items, 24:48

RELATED GOODS OR SERVICES

—Cont'd

Fourth Circuit, factors used by, 24:34

Gross, right in, **24:11**

Historical development, 24:2

Identification of goods, federal registration, **24:64**

Internet, use for selling or advertising, 24:53.50

Intervening rights and zone of expansion, 24:20, 24:21

Judicial skepticism, 24:12

Learned Hand-Frank restrictive view, 24:56

Likelihood of confusion, 24:1 to 24:3, 24:6, 24:7

Modern rule: likelihood of confusion as to sponsorship, affiliation, or connection, 24:6, 24:7

Multi-factor tests for infringement, 24:28

Nature of confusion, 24:3

Ninth Circuit, factors used by, 24:39

Patent and Trademark Office classification, federal registration, 24:66

Perception or licensing, which comes first, **24:9**

Polaroid test, 24:57

applications, 24:58

Price ranges, products sold through same channels of trade, 24:52

Promotional goods, trademark rights on, 24:9.50

Quality of goods, lower, 24:15

Reasons for extension of protection, 24:15 to 24:21

Refusal of federal registration, 24:63,

Remedies of owner of registered mark, 24:65, 24:66

Restatement factors, 24:29 to 24:43

"Same descriptive properties," 24:4

Second Circuit, 24:32, 24:55 to 24:58

Seventh Circuit, factors used by, 24:37

Sixth Circuit, factors used by, 24:36

Sponsorship, likelihood of confusion as to, 24:6, 24:7

Stronger marks, greater protection for, 24:49

Tenth Circuit, factors used by, 24:40

RELATED GOODS OR SERVICES —Cont'd

The argument that consumers know that many firms diversify into several different kinds of goods and services, 24:54

Third Circuit, factors used by, **24:33** Toy reproductions, **24:48.50**

"Under the same roof," sales, **24:45** Wearing apparel, **24:47**

Zone of natural expansion of product market, **24:17 to 24:20**

RELIANCE

Laches and delay, 31:13

RELIGIOUS FREEDOM INFORMATION ACT

Corporate, business and professional trade names, **9:7.50**

RELIGIOUS ORGANIZATIONS

Cyberspace, infringement in, Lanham Act, **25A:46**

Trade names, **9:7.50**

REMEDIES

Generally, 30:1 to 30:120

Anti-Cybersquatting Consumer Protection Act (ACPA), **25A:48**

Contempt (this index)

Counterfeiting (this index)

Criminal penalties. **Counterfeiting** (this index)

Damages. **Monetary Recovery** (this index)

Dilution of trademarks, 24:81, 24:82, 24:132

Federal Registration (this index)

Injunctions (this index)

Inter partes proceedings, 20:113

Monetary Recovery (this index)

Preliminary Injunctions (this index)

Related goods or services, 24:65, 24:66

Trade libel and product disparagement, 27:111, 27:112

RENEWAL

Federal Registration (this index)

REPAIRED AND RECONDITIONED GOODS OR PRODUCTS

Changes in goods and labels, 25:39

REPAIRED AND RECONDITIONED GOODS OR PRODUCTS—Cont'd

Dilution of trademarks, tarnishment, **24:91**

REPETITION

Composite marks, repetition of descriptive or generic term, **11:28.50**

Descriptive marks, composite terms, 11:28.50

Marks, generally, 7:31

Pattern covering product or packaging repeated, 7:32

REPUTATION

Territorial extent of rights, 26:16 to 26:19

REQUESTS FOR ADMISSIONS

Inter partes proceedings, T.T.A.B. discovery, **20:109**

RESERVATION OF RIGHTS

Assignments, 18:8

RESIDENCE OF WITNESS

Inter partes proceedings, 20:117.50

RES JUDICATA AND COLLATERAL ESTOPPEL

Generally, 32:78 to 32:104

Changes in the facts, 32:88

Court-court, 32:89 to 32:93

Court-Patent and Trademark Office, 32:94

Court-Trademark Trail and Appeal Board, 32:94

Creation of issue preclusion in later litigation, **32:97**

Customer differences, 32:101

Definitions, 32:79

Effect on later inter partes case, **32:104** Elements required, issue preclusion,

32:84

Equitable decrees and preliminary injunctions, **32:92**

Ex parte Patent and Trademark Office decisions, **32:95**

Foreign court, 32:93

Generic terms, 12:30

Goods and services differences, 32:101

Impact on later T.T.A.B. case, ex parte examiner decision, **32:103**

Inconsistent prior decisions, 32:86

RES JUDICATA AND COLLATERAL RES JUDICATA AND COLLATERAL ESTOPPEL—Cont'd ESTOPPEL—Cont'd Inter partes T.T.A.B. decisions Preliminary injunctions and equitable decrees, 32:92 generally, 32:96 to 32:104 Sameness of issues, 32:100 creation of issue preclusion in later litigation, 32:97 Secondary meaning, 15:29 customer differences, 32:101 Splitting of cause of action, 32:80 effect on later inter partes case, State-federal preclusion, 32:91 32:104 Summary judgment, 32:87 goods and services differences, Supreme Court precedent, 32:97, 32:98 32:101 Trademark Board proceedings, 32:82 impact on later T.T.A.B. case, ex parte Two lawsuits, 32:81 examiner decision, 32:103 Validity, issue preclusion, 32:99 marks differences, 32:102 Waiver of defense, 32:87 sameness of issues, 32:100 Weight given in courts, ex parte Patent Supreme Court precedent, 32:97, and Trademark Office decisions, 32:98 32:95 Trademark Trial and Appeal Board, generally, 32:96 to 32:104 RESTATEMENTS validity, 32:99 Generally, 1:17 Issue preclusion RESTRAINTS OF TRADE generally, 32:83 to 32:88 **Monopolies and Restraints of Trade** changes in the facts, 32:88 (this index) court litigation, 32:96 to 32:102 customer differences, 32:101 RETAILERS elements required, 32:84 Liability, false advertising, 27:34.50 goods and services differences, Marks of. 16:46, 16:47 32:101 RETROACTIVITY inconsistent prior decisions, 32:86 Dilution of trademarks, 24:131 inter partes decisions, T.T.A.B., 32:96 False advertising, amendments to secto 32:102 tion 43(a), **27:10** litigated factual issues, 32:83 marks differences, 32:102 REVERSAL OF PARTS opportunity to litigate, 32:85 Likelihood of confusion, 23:46 sameness of issues, 32:100 REVERSE CONFUSION summary judgment, motion for, 32:87 Generally, 23:10 Supreme Court precedent, 32:97. 32:98 REVERSE DOMAIN NAME Trademark Trial and Appeal Board, HIJACKING 32:94 Cyberspace, infringement in, 25A:38 validity, 32:99 waiver of defense, 32:87 **REVIEW** Litigated factual issues, 32:83 Appeal and Review (this index) Litigation opportunity, 32:85 ROCK AND ROLL HALL OF FAME Marks differences, 32:102 Commercial marks, goods and services, Merger and bar, 32:80 10:23 Non-essential issues, 32:90 ROGERS TEST Opportunity to litigate, 32:85 Patent and Trademark Office, generally, Commercial marks, goods and services,

10:22

32:94 to 32:104

ROGERS TEST-Cont'd

Elements of, two step balancing test, 31:144.50

procedural aspects, 31:144.70

False endorsement, 28:15

Publicity, 28:16, 28:19

Putting limits, Jack Daniel8217s case, 31:144.20

Use of personal name in expressive media, **27:86**

ROYALTIES

Monetary recovery, 30:85 to 30:87

SAFE DISTANCE RULE

Contempt, 30:21

SAFE HARBOR

Counterfeiting, 25:16, 30:120

SAFETY

Vertical restrictions, 31:118

SANCTIONS

Inter partes proceedings, 20:136 Overly-aggressive trademark enforcement, 11:93

Rule 11, strength of mark enforcement, 11:93

SCANDALOUS MARKS OR MATTER

Cancellation proceedings, **20:50.50** Federal registration, bars to, **19:77**

SCIENTER

Fraud, 31:66

SEABROOK TEST

Determine if a packaging design, inherently distinctive, **8:13.50**

SEARCH COSTS

Reduction, 2:5

SEARCH ENGINES

Cyberspace, infringement in, 25A:5 et seq.

Liability for allowing searches of plaintiff 8217s trademark, **25:28.50**

SEARS-COMPCO CASES

Defense, literary, artistic and entertainment rights, **10:35**

Federal preemption of state law, product design

generally, 1:18, 1:19, 7:53

SEARS-COMPCO CASES—Cont'd

Federal preemption of state law, product design—Cont'd case law, 7:56, 7:58, 7:96 federal registration, 7:96, 7:97 impact, 7:57, 7:96

Supreme Court, 7:58

Lanham act, 1:18, 1:19

Unfair competition, 1:18, 1:19

SECONDARY MEANING

Generally, **3:4**, **4:14**, **4:15**, **15:1** to **15:82** Acquisition and priority of rights, **16:34** Actual

deception, 15:17

Actual deception, 15:17

Admission that term is not inherently distinctive, Section 2(f) application, **15:68**

Anatolia case, 1864, **15:55**

Burden of proof, 15:32 to 15:35

Buyer's association, 15:5

Categories of designations that require a secondary meaning, **15:2**

Circumstantial evidence, 15:30, 15:48

Color. 7:44

Comparison, distinctiveness and strength, **4:15**

Composite marks, federal registration, **15:67**

Conduct as substitute, 15:15 to 15:18

Confusion, likelihood, 15:25

Copying, proof of, 15:38

Customer association, 15:30

Dealers, testimony of, 15:39

De facto secondary meaning

generally, 15:23, 15:24

functional shapes and designs, 15:23

Generic Terms (this index)

Definitions, 4:14

Descriptive marks, 11:15, 11:25, 11:38, 11:53

Designations that are not given trademark validity by acquisition of a secondary meaning, **15:3**

Designations that require a secondary meaning, 15:2

Direct evidence, 15:30

Distinctiveness through secondary meaning, generally, **15:1 to 15:27**

SECONDARY MEANING—Cont'd	SECONDARY MEANING—Cont'd
Employees of trademark owner,	Inter partes proceedings, 15:73
testimony of, 15:40	Judicial notice, 15:31
Evidence, generally, 15:1 , 15:28 to 15:73	Lanham Act five year presumption, 15:54
Evidence of acquired distinctiveness, 15:66	Length of use, 15:53 to 15:56 Likelihood of confusion, 15:11, 15:25
Evidence of extensive advertising and sales using the designation, 15:49	Literary, Artistic and Entertainment Rights (this index)
Fact question, 15:29	"Look for" promotion, 15:30
Federal registration	Misappropriation, 15:18
generally, 15:59 to 15:82 actual evidence and the prima facie	Necessity of secondary meaning, 15:1 to
rules, 15:61 to 15:65	New York Rule. Substitutes for second-
admission that term is not inherently	ary meaning, below
distinctive, Section 2(f) applica-	Non-verbal symbols, 15:9
tion, 15:68	Number of buyers, 15:45
burden of proof, effect on, 15:34 , 15:35	Old primary meaning and new secondary meaning, 15:6
composite marks, 15:67	Opinions of some buyers, 15:41
evidence of secondary meaning,	Palming off, 15:16
15:59 to 15:73	Penumbra analogy, 15:5
filing date is not cutoff for evidence, 15:71	Perception
	generally, 15:39 to 15:44
five year use, 15:62 form statements and questionnaires in	dealers, testimony of, 15:39
applications, 15:74 to 15:82	employees of trademark owner, testimony of, 15:40
intent to use application, 15:65	opinions of some buyers, 15:41
inter partes attack, 15:73	survey evidence, 15:42
ITU application, 15:65	Personal Names (this index)
ownership of other registrations, 15:63	Pleadings, 32:202
quantum of evidence required, 15:66	Pre-sales secondary meaning, 15:57 , 15:58
scope of secondary meaning necessary, 15:72	Public domain, 15:1
Supplemental Register, 19:43	Publicity creating pre-release secondary meaning, 15:57
text of Lanham Act, 15:59 Trademark Rules, 15:70 to 15:73	Required, background designs, shapes and symbols, 7:29
types of evidence, 15:61, 15:70	Res judicata, 15:29
Filing date is not cutoff for evidence, federal registration, 15:71	Secondary meaning "in the making," 15:58
Five year presumption, 15:54	Single, albeit anonymous rule, 15:8
Five year use, 15:62	Single anonymous source, association
Functional shapes and designs, de facto	with, 15:8
secondary meaning, 15:23	Strength of mark
Generic Terms (this index)	generally, 11:82, 15:25 to 15:27
Geographic	third party use, 15:27
location, 15:45	Substitutes for secondary meaning
Identity of buyers, 15:46	generally, 15:12 to 15:18
Intentional palming off, 15:16	actual deception, 15:17
Intent to use application, 15:60, 15:65	conduct as substitute, 15:15 to 15:18

SECONDARY MEANING—Cont'd SERVICE MARKS—Cont'd Substitutes for secondary meaning Abroad, internet delivery of into U.S. —Cont'd commerce, 19:106 intentional palming off, 15:16 Acquisition and priority of rights, federal registration, 16:33 misappropriation, 15:18 Ancillary services, 19:89 "New York Rule," 15:12 to 15:18 Assignments, 18:25 origin of rule, 15:13 Santa's Workshop, 15:13, 15:14 Bars to registration, 19:82 Changing conceptions of services Suggestive marks, 11:62 rendered in commerce, 19:105 Summary judgment, 15:33, 32:119 Civil Rights Act, 19:105 Survey evidence, 15:30, 15:42, 32:190, Collective Marks (this index) 32:191 Common law, 19:80 Symbols that are not inherently distinc-Corporate, business and professional tive, 15:1.50, 15:68 trade names, 9:12 Synonyms for secondary meaning, 15:10 Definitions, 4:7 Dual trade name and service mark Territorial extent of rights, 26:25 usage, 9:15 Third party use, strength of mark, 15:27 Time of acquisition of secondary mean-Federal registration, 4:7 Foreign or interstate commerce use, ing, 15:4 19:105 **Trade Dress** (this index) Gastown Decision, 19:105 Trademark Rules. 15:70 to 15:73 Goods in trade rejection, 19:87 Use of form statements. 15:74 Identification and distinguishing of ser-Weight of evidence, 15:33 vices rendered, 19:81 SECONDARY SOURCE Incidental goods, sales of, 19:87 Identifying, 3:8 Infringement, **23:76.50** Internet delivery of marks abroad into **SECTION 8 AFFIDAVITS** U.S. commerce, 19:106 **Federal Registration** (this index) Likelihood of confusion, 23:76.50 **SECTION 15 AFFIDAVITS** Location of designated mark, 19:104 Federal registration, 19:140 Retail sales service, 19:86 Scope of time of services rendered, SECURITY INTERESTS 19:105 Assignments, 18:7 Services rendered abroad to U.S. citizens, 19:105 **SEIZURES** Trade name vis-a-vis service mark, 4:7, Counterfeiting, preliminary injunctions, 19:88 30:39 Use in commerce to identify services, Imported goods, 29:37, 29:42 19:83 Mongol Nation case, 18:20.50 Use necessary to support registration U.S. government, trademarks, 18:20.50 generally, 19:103 to 19:106 SELF-LAUDATORY TERMS abandonment charges, 19:123 Descriptive marks, 11:17 changing conceptions of services rendered in commerce, 19:105 SERIES OF LITERARY WORKS Civil Rights Act, 19:105 **Literary, Artistic and Entertainment** commerce, 19:83, 19:123, 19:124 **Rights** (this index) Creagri Rule, **19:123** SERVICE MARKS foreign or interstate commerce, 19:105 Generally, 19:80 to 19:89, 19:103 to 19:106 labeling laws, use in violation, 19:123

SERVICE MARKS—Cont'd

Use necessary to support registration
—Cont'd
location of designation, 19:104
modern policy, 19:123
New Generation Rule, 19:123
Satinine Precedent, 19:123
"Unlawful Use" defense, 19:123
Website menu, 10:6

SERVICE OF PROCESS

Personal jurisdiction, 32:38, 32:44

SETTING ASIDE JUDGMENT

Inter partes proceedings, 20:134

SETTLEMENT

Contempt, 30:24.50 Estoppel, 32:110 Laches and delay, 31:15 Stay of proceedings, 32:112.50

"SHADE CONFUSION"

Color, 7:44, 7:45.70

SHADE DEPLETION

Generally, 7:44

SHAPES

Background Designs, Shapes and Symbols (this index)

Labels, 7:38

Product and Container Shapes (this index)

Trade dress, 8:5

SHOPS AND SHOPPING

Trademark problems, 25A:9.50

SINGULAR VERSIONS OF WORDS

Likelihood of confusion, 23:46.25

SLANG

Copyrights, 6:19

SLANTED QUESTIONS

Survey evidence, 32:172

SLOGANS

Generally, 7:19 to 7:23

Boasting and self-laudatory slogans, 7:22

Common phrases, 7:23

Copyrights, 6:19

Descriptive slogans, 7:21

Insurance for infringement claims, 33:7

SLOGANS—Cont'd

Political, 7:23

Slang, 6:19

Trademarks, 3:5, 7:19

Used or incorporating product mark, house mark, **7:20**

SOCIALISM

Unfair competition, 1:7

SOFT-DRINK BOTTLERS ACT

Vertical restrictions, 31:122

SOUND MARKS

Generally, 7:104

Music as trademark, 6:17.50

SOURCE

Generally, 3:10, 3:12

Control, **3:11**

Physical source of goods, 3:10

Quality theory supplements, 3:11

Secondary, 3:8

Single anonymous source of goods, 3:12

SPECIAL DAMAGES

Trade libel and product disparagement, **27:111**

SPECIMENS OF MARK

Federal registration, applications, 19:61.50

SPLITTING CAUSE OF ACTION

Generally, 32:80

SPONSORSHIP

Related goods or services, likelihood of confusion as to sponsorship, **24:6**, **24:7**

SPORTING EVENTS

Misappropriation, 10:56

STANDING

Cancellation Proceedings (this index)

Consumer,

opposition or cancelation proceeding in the trademark trial and Appeal board, **20:9**

Dilution by bluring, 24:121.50

Distribution of trademarked goods, restrictions on, 31:114

False Advertising (this index)

Federal question jurisdiction

Lexmark test, 32:3.50

STATUTES OF LIMITATION STANDING—Cont'd Federal question jurisdiction—Cont'd Cancellation counterclaim in opposition licensee, 32:18 proceedings, tolling of, **20:67** non-owner of mark, 32:12 Dilution of trademarks, 24:130 registrant only, 32:3 False advertising, 27:48 Federal registration, challenge to, Federal, **31:33** 19:77.75 Laches and delay, 31:23, 31:33 Infringement, section 43(a) of Lanham State, 31:33, 31:34 Act, 27:20, 27:21 STAY OF PROCEEDINGS **Inter Partes Proceedings** (this index) Generally, 32:46 to 32:48 STATE OF MIND Court, actions pending in, 32:47, 32:48 Mens Rea (this index) Settlement, vacating judgment after, 32:112.50 STATE PREEMPTION Trademark Board, actions pending in, Copyrights, **6:15.50** 32:47, 32:48 STATE PROTECTION AND Two courts, actions pending in, 32:46 REGISTRATION Vacating judgment after settlement, 32:112.50 Generally, **22:1** to **22:11** Consistency, state statutory and common STRENGTH OF MARKS law, federal trademark law, 22:1.50 Generally, 11:73 to 11:93 **Corporate, Business and Professional** Abuse of process, 11:93 **Trade Names** (this index) Arbitrary marks, 11:14 **Dilution of Trademarks** (this index) Assertive enforcement, 11:93 Display of trademark, control over, 22:4 Attorney fees award, over-aggressive Federal enforcement, 11:93 CDA immunity, internet service Balanced program of trademark enforceprovider, **22:4.50** ment, 11:91 law, use to interpret state statutes, Bullying, **11:92** Coined word marks, 11:6 preemption, 22:1, 22:2 Commercial strength, 11:80 rights, limitation of, 22:1, 22:2 Common use, terms in, 11:86 state relationships, 22:1 to 22:4 Common word fallacy, 11:87 Internet service provider, federal CDA Comparison, distinctiveness and secondimmunity, 22:4.50 ary meaning, 4:15 Likelihood of confusion test of infringe-Conceptual strength, 11:80 ment, 23:1.50 Consumer perception, 4:15 Limitation of federal rights, 22:1, 22:2 Crowded trademark markets, third party Model State Trademark Act, 22:5 to use. 11:85 22:9.25 Definitions, 4:15 Model State Trademark Bill Determination of strength comment, 1996 and 2007 versions, 22:6.25 generally, 11:80 to 11:84 1992 version of text, 22:8, 22:9 commercial strength, 11:80 text, 24:79.50 conceptual strength, 11:80 2007 version of text, 22:9.25 incontestabable registration status, 11:84 Peaceful co-existence, federal / state relationships, 22:1 to 22:4 placement on spectrum, 11:80 Publicity, 28:2 secondary meaning, 11:82 Puerto Rico, 22:10 traditional approach, 11:80 to 11:82 Registration laws, 22:10 two-prong test, 11:80

STRENGTH OF MARKS—Cont'd

Determination of strength—Cont'd USPTO ex parte examination, 11:80

Dilution of Trademarks (this index)

Distinctiveness, 11:75

Enforcing trademark rights using balanced program, **11:91**

Famous marks, **4:16**, **11:74**, **11:78**

Greater protection for stronger marks, 11:73

Incontestabable registration status, 11:74, 11:84

Letters, 7:11

Likelihood of confusion, 4:15, 23:40.50

Malicious prosecution, 11:93

Measurement, 4:15

Numbers, 7:15

Octane rule, 11:93

Overly-aggressive enforcement, 11:93

Predatory enforcement, 11:93

Presumptions, 32:155

Prevailing defendant, attorney fees, 11:93

Rule 11 sanctions, **11:93**

Secondary Meaning (this index)

Significance of strength, 11:73 to 11:78, 23:40.50

Similar marks by third parties, **11:88** Spectrum, **11:74**

Strength or weakness of a mark, 11:89

Strong there, weak here, 11:77

Third party registrations

evidence of meaning of terms, 11:90 not evidence of the strength or weakness of a mark, 11:89

Third party registrations, 11:89

Third party use, 11:85 to 11:90

Torts, enforcement, 11:93

Two-prong test, 11:80

Unfair competition, 11:93

Unrelated third party use, 11:88

Weakening mark, third party use, 11:88

Weak marks are alive but frail, 11:76

Well-known marks, 11:78

STRICT LIABILITY

Franchises, 18:78

STYLE DESIGNATIONS

Generally, 11:36 to 11:41

Descriptive Marks (this index)

5-prong test, 11:00 Trade use test,

Generally, **32:113 to 32:121.75**

Burden on moving party, 32:116

Burden on responding party, 32:117

Collateral estoppel, **32:87**

Conactal estopper, 32.07

Dismissal, failure to state a claim, 32:121.75

Failure to state a claim, motion to dismiss, 32:121.50 to 32:121.90

Federal Rule 56, 32:115 to 32:118

Fifth Amendment, 32:121.25

STYLE DESIGNATIONS—Cont'd

Numbers, 7:16

STYLE OF DOING BUSINESS

Insurance coverage for infringement claims, misappropriation of style of doing business, **33:5**

STYLIZED REPRESENTATIONS

Descriptive marks, 7:36

SUBSIDIARY CORPORATIONS

Ownership of trademarks, 16:37

"SUBSTANTIALLY

INDISTINGUISHABLE" TEST

Counterfeiting, 25:15.50

SUGGESTIVE MARKS

Generally, 11:62 to 11:72

Arbitrary marks, compared, 11:12

Comment: tests for descriptive-sugges-

tive distinction, 11:71

Competitor's need test, 11:68

Competitor's use test, 11:69

Degree of imagination test, 11:67

Descriptive marks, distinguished, 11:66 to 11:72

Dictionaries, use by, 11:69

Illustrative examples, 11:72

Intuitive boundary line, 11:70

List of marks held to be suggestive, not descriptive, 11:72

Media, use by, 11:69

Middle ground between arbitrary and descriptive marks, 11:64

Secondary meaning, 11:62

Test application, 11:70

Tests for determining descriptive/ suggestive distinction, 11:66 to 11:72

Trade use test, 11:69

SUMMARY JUDGMENT

SUMMARY JUDGMENT—Cont'd

Inter partes proceedings, 20:132 Likelihood of confusion, 32:120, 32:121 Motion to dismiss, failure to state a claim, 32:121.50 to 32:121.75

SUPER SIZE

Descriptive marks, composites, 11:28

Secondary meaning, 15:33, 32:119

SUPPLEMENTAL REGISTER

Cancellation, **20:80** Definition, **4:12**

Federal Registration (this index)

Generic terms, 12:59

Inter partes proceedings, 19:41

Non-marks, **4:12**

Product and container shapes, 7:95

SURVEY EVIDENCE

Generally, 32:158 to 32:196

Actual confusion, survey data as evidence of, **32:184**

Aided awareness questioning, **32:173** "Appreciable" number, **32:185**

Approximation of market conditions, 32:163

Attorney participation in survey design, 32:166

Background noise, using control to filter out. **32:187**

Circumstantial evidence of confusion, 32:186

Commonly used formats to test for confusion, **32:173.50**

Confusion formats, **32:173 to 32:174.50** Control, background noise, **32:187**

Cross-examination, hearsay objection, 32:167

Deficiencies in methodology, **32:170**, **32:171**

Defining the universe surveyed, 32:159

Descriptive marks, 11:51

Eveready Format, 32:173, 32:174

False advertising, significance of results, 32:193

Federal Rules of Evidence, hearsay objection, **32:169**

Formats and methods, generally, **32:170** to **32:178**

Foundation, introduction into evidence, **32:181**

SURVEY EVIDENCE—Cont'd

Generic terms, 12:14 to 12:17.25, 32:192

Hearsay objection, 32:167 to 32:169

History of judicial reception to survey evidence, **32:194**

Internet surveys, **32:165.25**

Judicial receptiveness to survey evidence, **32:194 to 32:196**

Likelihood of confusion, 23:17, 32:184 to 32:189

Methods, 32:158 to 32:166

Methods for eliciting buyer perceptions, 32:175

Need for survey evidence, 32:194 to 32:196

Noise, control, 32:187

Objections to procedures, 32:179

Patent and Trademark Office, use in, 32:180

Percentage figures, 32:188, 32:189

Pilot tests, **32:163.50**

Privacy of survey respondents, 32:183

Probability and non-probability surveys, 32:164, 32:165

Product "line-up" survey methods, 32:177

Proper survey methods, 32:158 to 32:166

Realism regarding surveys, 32:178

Report, 32:181.50

Secondary meaning, **15:30**, **15:42**, **32:190**, **32:191**

Significance of results, generally, **32:184** to **32:193**

Slanted or leading questions, 32:172, 32:173

Squirt Format, 32:173, 32:174, 32:174.50

Survey director, testimony of, 32:182

Tests of properly conducted survey, 32:170 to 32:172

Universe surveyed, **32:159 to 32:162**Use of surveys

generally, 32:179 to 32:183

foundation, introduction into evidence, **32:181**

introduction into evidence, 32:181 to 32:183

objections to procedures, 32:179

SURVEY EVIDENCE—Cont'd

Use of surveys—Cont'd
Patent and Trademark Office, use in,
32:180
privacy of survey respondents, 32:183
report, 32:181.50

survey director, testimony of, **32:182** Word association questions, **32:176**

SYMBOLS

Background Designs, Shapes and Symbols (this index)

SYNONYMS

Secondary meaning, 15:10

TACKING-ON OLDER TO NEWER VERSION

Changes in usage, 17:25 to 17:28

TACTILE MARKS

Generally, 7:108

TARIFF ACT

Counterfeit, 29:45
Counterfeiting, 25:11
Elements of counterfeiting, 29:45
Imported goods
gray market, 29:49
seizure, 29:45

TARNISHMENT

Dilution of Trademarks (this index)

TELEPHONE LISTINGS

Injunctions, **30:7** Personal names, **13:30**

TELEPHONE NUMBER LETTER COMBINATIONS

Generally, 7:13

TELESCOPED TERMS

Descriptive marks, 11:26

TELETRAK

Acquisition and priority of rights, 16:13, 16:14

TELEVISION INFOMERCIALS

Acquisition and priority of rights, federal registration, **16:32.30**

TENANTS

Landlord and Tenant (this index)

TERRITORIAL EXTENT OF RIGHTS

Generally, 26:1 to 26:57 Advertising, 26:17, 26:46 Common law generally, 26:1 to 26:30 senior user's defense, 26:53 territorially separated uses, internet

Conclusive presumption, limited area defense, **26:47**

Concurrent use proceedings, 20:83, 20:84

age, 26:1.50

Constructive

notice, federally registered marks, **26:31, 26:32**

use, federally registered marks, **26:37** to **26:40**

Contestable registrations, limited area defense, **26:51**

Defenses

laches, 26:57
limited area defense, below senior user, Lanham Act, 26:53
Disputed territory, rights in, 26:13 to 26:15

Expanding zones of sales, **26:20**, **26:22 to 26:24**

Federally registered marks generally, **26:31 to 26:57** constructive notice, **26:31, 26:32** constructive use, **26:37 to 26:40** continuing use by senior user, federal registrant as junior user, **26:55**

Dawn Donut rule, **26:33 to 26:36** definition, statutory, constructive use,

exceptions, statutory, constructive use, **26:40**

26:37

good faith defense, elimination by constructive notice, **26:32**

Guthrie Precedent, Second Circuit limits Dawn Donut, **26:35**

immediate decision on priority issue under Dawn Donut, procedural devices, **26:36**

junior user, federal registrant as, **26:53 to 26:57**

laches, federal registrant as junior user, **26:57**

likelihood of confusion, no remedy until, **26:33**

Index-86

TERRITORIAL EXTENT OF RIGHTS —Cont'd	TERRITORIAL EXTENT OF RIGHTS —Cont'd
Federally registered marks—Cont'd	Likelihood of entry into jr. user's terri-
likelihood of entry, 26:39	tory, federally registered marks,
likelihood of entry into jr. user's terri-	26:34
tory, 26:34	Limited area defense
limited area defense, below	generally, 26:43 to 26:52.50
nationwide	advertising nationwide, 26:46
priority as of application, constructive use, 26:38	application or rejection freezes junior user's area, 26:45 , 26:46
protection of registered marks, 26:31	conclusive presumption, negation of, 26:47
secondary meaning	contestable registrations, 26:51
scope of rights requiring, 26:41 territorial remoteness, federal	intermediate junior user's defense, 26:43, 26:44
registrant as junior user, 26:56 Geographically remote use	missing remoteness requirement, 26:48
generally, 26:1 to 26:30	prior registration, 26:52.50
critical date of good faith, 26:11	Localized businesses, 26:29
defined, 26:1	Minimum sales volume, rights in unoc-
good faith use by remote junior user,	cupied territory, 26:14
26:6 to 26:11	Nationwide
knowledge destroys good faith, 26:9,	businesses, 26:30
26:10 preservation of rights of each party,	priority as of application, constructive use, 26:38
26:3	protection of registered marks, 26:31
senior user, finding, 26:5 Good faith	Natural expansion, zone of, 26:20, 26:22 to 26:24
	Perambulating customers, rights by rep-
constructive notice, 26:32	utation, 26:17
geographically remote use, 26:6 to 26:11	Prior registration exception, 26:52.50
Guthrie Precedent, Second Circuit limits	Registration exception, 26:52.50
Dawn Donut, 26:35	Reputation, rights by, 26:16 to 26:19
Immediate decision on priority issue	Secondary meaning
under Dawn Donut, procedural	generally, 26:25
devices, 26:36	scope of rights requiring, 26:41
Internet usage establishing territory, 26:30.50	Shrinking senior user, 26:21 State lines, 26:28
Junior user, federal registrant as, 26:53	Static senior user, 26:21
to 26:57 Knowledge destroys good faith,	Statutory exceptions, constructive use, 26:40
geographically remote use, 26:9 , 26:10	Territorial remoteness, federal registrant as junior user, 26:56
Laches, federal registrant as junior user,	The Dawn Donut Rule, 26:33
26:57 Laying out the zones, 26:27	Unoccupied territory, rights in, 26:13 to 26:15
Likelihood of confusion, no remedy until, 26:33	TIE-INS
Likelihood of entry, federally registered marks, 26:39	Monopolies and Restraints of Trade (this index)

TRADE DRESS-Cont'd TIGER WOODS Insurance for infringement claims, 33:8 Commercial marks, goods and services, 10:23 Intentional copying, 8:9 TITLES imitation, 8:19 Literary, artistic and entertainment Likelihood of confusion rights, 10:4.10, 10:7.10, 10:9, generally, 8:15 to 8:19, 23:52 10:18 to 10:20, 10:37, 10:42.50 comparison of conflicting trade TOP LEVEL DOMAINS dresses, 8:15 Additional top level domain in the conflicting trade dress, illustrations, Twenty First century, 25A:14 8:17 Open framework, 25A:15 defendant's mark on look-alike, 8:16 Pre 2000, NSI top level domain name intentional imitation, 8:19 dispute resolution, 25A:19 secondary meaning, 8:8.50 Line of different products or packages, **TORTS** 8:5.50 Commercial torts, 1:8 Literary, artistic and entertainment Franchises (this index) rights, 10:15 Personal jurisdiction, long-arm statutes, Marketing theme, 8:6 32:39 Milstein Precedent, 8:6.50 Strength of marks, enforcement, 11:93 Packaging, inherently distinctive, 8:13 Unfair competition, generally, 1:12 Packaging design, inherently distinctive, TOY REPRODUCTIONS 8:13.50 Related goods or services, 24:48.50 Product and container shapes, 1:24 Product design, 8:5 TRADE DRESS Registered, federal protection, 8:7 Copyright, overlap, 6:17.50 Seabrook test, 8:13.50 Decorative design, 3:4 Secondary meaning Descriptive trade dress, 11:16.50 generally, 8:8 to 8:14 Design of product, 8:5 copying as evidence, 8:9 Design or appearance of wearing apparel, 7:103 likelihood of confusion, 8:8.50 Design patents, 6:11 modern rule, 8:11 Dilution of trademarks, 24:102 packaging, inherently distinctive, Distinctiveness of marks, 11:16.50 8:13 Elements of trade dress proof of secondary meaning old rule, identification of, 8:3 infringement claim, 7:59, 8:1 proving, 8:8.50, 8:11.50 Examples of, **8:4.50** 2000 Wal-Mart decision, law after. Federal preemption 8:12 copyrights, 6:5 Wal-Mart rule and its impact, 8:12 Federal protection, 8:7 when required for trade dress, 8:8 Federal registration word marks, marketing under differtrademark or service mark, 7:101 ing, 8:14 Functional Services, categorizing, 8:12 Source, indication of, 8:1 design, 6:10 Functional design barrier, 6:10 State trademarks, 24:83 Generic, 8:6.50 Style of doing business, 8:6

Totality of elements, focus on, 8:2

Trademarks, compared, 8:1 to 8:3

Trademark or trade dress, 7:103

Identification of elements, need for, 8:3

Infringement claim, elements, 7:59, 8:1

Imitation of trade dress, 24:48.50

TRADE DRESS—Cont'd TRADE LIBEL AND PRODUCT 2000 Wal-Mart decision, law after, **8:12** DISPARAGEMENT—Cont'd Amendments to statute—Cont'd Unregistered, federal protection, 8:7 law prior to amendment, 27:92 Utility patents, non-functional element preclusion, 7:89.70 Commenting on litigation, exemption, 27:109.50 Web dress, 8:7.25 Commercial speech, 27:107 site appearance, 8:7.25 Constitutional constraints, free speech, Word marks, marketing under differing, 27:105 8:14 Corporate defamation, distinguished, 27:101 TRADE DRESS LAW Deceptive endorsements and testimoni-Product and container shapes, 7:55 als, Federal Trade Commission, 27:120 TRADE DRESS PROTECTION Defamation rules, free speech, 27:106 2000 Wal-Mart decision, law after, 8:12 Generally, 8:8 to 8:14 Disparagement law limited to Intentional copying, 8:9 commercial speech or promotion, Likelihood of confusion fact representation, not opinion, secondary meaning, 8:8.50 27:96, 27:96.10 Modern rule, 8:11 Elements of product disparagement, Packaging, inherently distinctive, 8:13 state claims, 27:99 Packaging design, inherently distinctive, 8:13.50 Environmental marketing claims, Proof of secondary meaning old rule, Federal Trade Commission, 27:121 8:10 Fact representation, not opinion, 27:96, 27:96.10, 27:109 Proving, 8:8.50 Seabrook test, 8:13.50 False or disparaging statement, 27:103 Secondary meaning Federal claim, creation of by amendment, 27:94 copying as evidence, 8:9 Federal law likelihood of confusion, 8:8.50 generally, 27:91 to 27:97 packaging, inherently distinctive, 8:13 amendments to statute when required for trade dress, 8:8 generally, 27:93 to 27:98 word marks, marketing under differlaw prior to amendment, 27:92 ing, 8:14 claim, creation of by amendment, Secondary meaning proving, 8:11.50 27:94 Services, categorizing, 8:12 disparagement law limited to Trade dress, **8:8.50** commercial speech or promotion, Trade dress, proving secondary mean-27:95 ing, 8:11.50 fact representation, not opinion, Wal-Mart rule and its impact, 8:12 27:96 Word marks, marketing under differing, requirements and restrictions, 27:97 8:14 Federal registration, bars to, 19:77.25 TRADE LIBEL AND PRODUCT Federal Trade Commission DISPARAGEMENT generally, 27:118 to 27:121 Generally, 27:91 to 27:112.10 deceptive endorsements and Agricultural food disparagement testimonials, control over, statutes, 27:112.10 27:120 Amendments to statute environmental marketing claims, generally, 27:93 to 27:98 27:121

Corporate, Business and Professional

Trade Names (this index)

TRADEMARK FORMATS TRADE LIBEL AND PRODUCT DISPARAGEMENT—Cont'd Buildings Federal Trade Commission—Cont'd federal registration, 7:101 power to prohibit unfair competition protection of building exterior and and false advertising, 27:118 interior, 7:100 private remedy, absence of, 27:119 trademark or service mark, 7:101 Free speech, 27:105 to 27:108 Design or appearance of wearing Injunctions, 27:112 apparel, 7:103 Intent to injure, 27:104 Trademark or trade dress, 7:103 Knowledge of falsity, 27:104 TRADEMARK LAW REVISION ACT Little Federal Trade Commission Acts, False advertising, 27:10 27:114 Federal registration, 19:5, 19:35 Personal defamation, distinguished, Presumptions, 32:135, 32:140 27:101 Privileges exempt, 27:110 TRADEMARK LAW TREATY Publication of statement, 27:102 Generally, 29:34 Public interest, publications on matter Federal registration, 19:45.25 of, 27:108 TRADEMARK LICENSE MERGER Remedies, 27:111, 27:112 RULE Requirements and restrictions, 27:97 Generally, **18:47** Special damages, 27:111 State law TRADEMARK MANUAL OF generally, 27:91, 27:98 to 27:112.10 **EXAMINING PROCEDURE** agricultural food disparagement Federal registration, examination of statutes, **27:112.10** application, 19:129 commenting on litigation, exemption, TRADEMARK REGISTRATION 27:109.50 TREATY corporate defamation, distinguished, Generally, 29:27 27:101 elements of product disparagement, TRADEMARK RULES 27:99 Secondary meaning, 15:70 to 15:73 fact representations, not opinions, TRADEMARK TRIAL AND APPEAL 27:109 **BOARD** false or disparaging statement, 27:103 Generally, 21:1 to 21:4 free speech Appeal process, 21:4 generally, 27:105 to 27:108 Cancellation proceedings,no consumer commercial speech, 27:107 standing constitutional constraints, 27:105 to bring an opposition or cancelation defamation rules, 27:106 proceeding, 20:47 public interest, publications on Ex parte appeals, 19:127, 21:1, 21:2 matter of, **27:108 Inter Partes Proceedings** (this index) injunctions, 27:112 No consumer standing intent to injure, 27:104 to bring an opposition or cancelation knowledge of falsity, 27:104 proceeding, 20:9 personal defamation, distinguished, Procedure on appeal, 21:2 27:101 Res Judicata and Collateral Estoppel privileges exempt, 27:110 (this index) publication of statement, 27:102 remedies, 27:111, 27:112 TRADE NAMES

special damages, 27:111

State statutes, 27:113 to 27:116

TRADE SHOWS	TYPES OF MARKS—Cont'd
Acquisition and priority of rights, federal registration, 16:31	Background Designs, Shapes and Symbols (this index)
TRAFFIX CASE	Buildings
Functionality, 7:89, 7:89.30	protection of building exterior and interior, 7:100
TRANSCRIPT	Combined marks, 7:8
Inter partes proceedings, 20:118	Decorative symbols and designs, 7:24
TRANSFORMATIVE TEST Publicity, 28:19	Descriptive symbols, pictures, and designs, 7:35 to 7:37
TREATIES	Design or appearance of wearing apparel, 7:103
Generally, 29:25 to 29:36.50	Distinctive designs and symbols, 7:25
Anti-Counterfeiting Trade Agreement	Federal registration
(ACTA), 29:33.50	trademark or service mark, 7:101
European Union Trademark, 29:35	Flavor marks, 7:107
GATT TRIPs, 29:36	Fragrance marks, 7:106
Hague convention, 29:36.50	Functional pictures, 7:37
Lisbon Agreement, 29:28	Generic pictures, 7:37
Madrid Protocol, 29:32	Geometric shapes and symbols, 7:33,
Madrid Registration of Marks Treaty, 29:31	7:34 Internet
Madrid Source of Goods Treaty, 29:30	domain names, 7:17.50
Paris Convention, 19:74 , 29:25	hashtags, 7:17.70
Regional treaty organizations and bilat-	Letters (this index)
eral treaties, 29:26	Location of label, 7:38
Self-execution of treaties, 29:33 Trademark Law Treaty, 29:34	"Look for" promotion, 7:29, 7:30
Trademark Registration Treaty, 29:27	Motion marks, 7:109
Uruguay Round Agreements Act, 29:36	Nicknames, 7:18
	Non-marks, 4:12
TRENDS	Non-traditional formats, 7:105
Unfair competition, copying market	Numbers (this index)
trend or fad, 1:25	Ornamental symbols and designs, 7:24
TRIPs	Policy issues, non-traditional formats,
Famous marks, 29:63	7:105
T-SHIRTS	Repetition
Freedom of speech, significance of	mark, 7:31
medium, 31:152	pattern covering product or packaging repeated, 7:32
T.T.A.B.	Shape of label, 7:38
Trademark Trial and Appeal Board	Slogans (this index)
(this index)	Sound marks, 7:104
TWOMBLY	Symbols and designs
Summary judgment, motion to dismiss,	decorative, 7:24
failure to state a claim, 32:121.60	descriptive, 7:35 to 7:37 distinctive, 7:25
TYPES OF MARKS	Tactile marks, 7:108
Generally, 7:9 to 7:38	Trademark or trade dress, 7:103
Abbreviations, 7:18	Vehicles, 7:102

UNCLEAN HANDS	UNFAIR COMPETITION—Cont'd
Generally, 31:44 to 31:58	False advertising, 1:8
Antitrust violation, 31:47	Federalization of law, 1:19, 1:19.50
Balancing of parties' conduct, 31:52 to	Federal question jurisdiction, 32:15
31:55	Federal Trade Commission, power to
Deceptive trademarks, relevant conduct,	prohibit, 27:118
31:50	Free competition, 1:1, 1:20
Discontinued conduct, 31:55	Free copying, 1:2
Examples, 31:57 , 31:58	General rule is that of public domain,
False advertising by both parties, 31:54	1:2, 1:23
Filing of infringement suit not basis for	Good faith, 1:8, 1:11
unclean hands, 31:51	Government owned trademarks, 1:7
Infringement cases, relevant conduct,	Historical development, 1:15 to 1:19
31:49	Imitation, 1:24, 1:25
Injunctions	Infringement
enforcing other rules by refusing, 31:52	non-competitor, 1:15
	patent, 1:8
preliminary injunction hearing, 31:56 Misuse of trademark, 31:47	trademark law as, 2:7, 2:8
Monopolies and restraints of trade,	unfounded charges, 1:11
31:91	Inherent judicial power, unfair competi-
Public protection from confusion and	tion law as, 1:16
deception, 31:53	Injury, 1:14 Judicial power, 1:16
Rejection of defense, 31:53	Laissez Faire
Relevant conduct, 31:48 to 31:51	
Unlawful use of mark, defense, 31:58.50	Adam Smith, 1:4 government control, 1:3
	Thomas Jefferson, 1:4
UNFAIR COMPETITION	Lanham Act federalization, 1:19,
Generally, 1:1 to 1:26, 4:1 et seq., 4:6	1:19.50
Anti-trust laws, 1:20	Literature, characters in, 10:42
California statutes, 27:115	Modern growth and change in scope of
Capacity for development and growth of	law, 1:15 to 1:19
law, 1:15	Monopoly power
Choice of law, 32:36	generally, 1:4, 1:5, 1:20 to 1:22,
Commercial	31:90.50
ethics, 1:12	competition, 1:4
torts, 1:8	dual policies, 1:20
Competitive injury, 1:14	political power, 1:5
Definitons, 1:8 to 1:11, 4:1 to 4:6	relationship between antitrust law and
Designs, 1:24	trademark and unfair competi-
Economic principles, 1:12 to 1:14	tion law, 31.90.50
Economy, competition as basic premise	1938 Restatement, 1:17
of, 1:3	1995 Restatement, 1:17
Efficiency, competition and, 1:6	Non-competitors, 1:8
Encouragement of imitation of public	Political power and monopoly power,
domain materials, 1:24	1:5
Enforcement, legal system as an instru-	Preemption of state law by federal law,
ment of, 1:3	1:18
Examples, 1:10	Product design law, 1:18
Fad in market, copying, 1:25	Public domain
Failing competitor, 1:8	generally, 1:2, 1:23 to 1:26, 6:5

UNFAIR COMPETITION—Cont'd

Public domain—Cont'd defined. **1:26**

general rule, 1:2, 1:23

imitation of public domain concepts and designs is encouraged, **1:24**

trend or fad in market, copying, 1:25

Public policy, 1:1, 1:2

"Regulated" economy, 1:3

Regulation and de-regulation, 1:7

Remedies (this index)

Restatement, generally, 1:17

Sears-Compco Cases, 1:18, 1:19

Socialism and government regulation of industry, 1:7

Strength of marks, enforcement, 11:93

Synonyms, 1:9

Torts, 1:8, 1:12

Trade dress, 1:24

Trend or fad in market, copying, 1:25

Unfounded charges of patent infringement, 1:11

Why do businesspeople engage in unfair competition, 1:13

UNIFORM DISPUTE RESOLUTION PROCEDURE (UDRP)

Cyberspace, infringement in (this index)

UNIFORMITY

Federal registration, examination of application—uniformity and equality of examination under Lanham Act, 19:126.50

Usage of trademark, 7:38.50

UNIONS

Infringement, 25:59

UNITARY MARKS

Dena precedent, 19:66

Federal registration, disclaimers, 19:66

UNITED STATES GOVERNMENT

Infringement by, 25:63

UNITED STATES PATENT AND TRADEMARK OFFICE

Patent and Trademark Office (this index)

UNITES STATES APPELLATIONS OF ORIGIN FOR WINE

Geographic terms generic designations, 14:19.50

UNJUST ENRICHMENT

Trademarks, 25:72

UPDATING MARKS

Abandonment of rights, 17:28

URUGUAY ROUND AGREEMENTS ACT

Generally, 29:36

USE AS A TRADEMARK

Generally, 3:1 to 3:7

Fraud (this index)

Misuse, nonfungible tokens (NFTs), **25A:4.70**

Priority of use, 9:2, 16:1.50, 16:18

Section 8 affidavit of nonuse after federal registration, **19:136**

Three part test, 3:1

To acquire trademark rights, 3:4, 16:1

To qualify for federal registration as a service mark, 19:103 to 19:106 as a trademark, 19:108 to 19:122

To trigger liability as an infringement, 23:11.50

"USE-BASED" TRADEMARK LAW

Federal registration, 19:1.25

USE IN COMMERCE

False advertising, jurisdiction, 27:47

Infringement (this index)

Use necessary to support registration **Federal Registration** (this index)

USPTO

Patent and Trademark Office (this index)

UTILITARIAN FUNCTIONALITY

Service Marks (this index)

Functionality (this index)

UTILITY PATENTS

Trade dress, non-functional element, preclusion, **7:89.70**

UTILITY PATENTS AND TRADEMARKS

Functional design barrier, 6:10

UTILITY PATENTS AND TRADEMARKS—Cont'd Functionality, 7:89 to 7:89.70

VALIDITY OF REGISTRATION

Presumptions, 32:134 to 32:157

VALUATION

Good Will (this index)

VEHICLES

Generally, **7:102** Business vehicles, color, 7:48

VENUE

Generally, 32:59 to 32:77

Burden of proof, transfer for inconvenience, 32:74

Challenge to venue, 32:68

Corporate and association defendants, federal question cases, 32:67

Dismissal for forum non conveniens, 32:76

Federal question cases

generally, 32:62 to 32:67

corporate and association defendants, 32:67

possible districts or proper venue, 32:62

substantial part of events, place of occurrence of, 32:63 to 32:65

where events occur, 32:64

Federal venue, 32:59 to 32:69

Foreign court litigation, 32:76

Forum non conveniens, dismissal for, 32:76

Inconvenience. Transfer for inconvenience, below

Multidistrict litigation, 32:77

Nature of rules, 32:60

Substantial part of events, place of occurrence of, 32:63 to 32:65

Tort of trademark infringement, 32:38.40

Transfer for inconvenience

generally, 32:71 to 32:76 burden of proof, 32:74

factors of convenience, 32:73

VERTICAL RESTRICTIONS

Monopolies and Restraints of Trade (this index)

VICARIOUS LIABILITY

Anti-dilution, 25:21.75

Contributory infringement, 25:21.25 to 25:22

Lanham Act section 43(c), 25:21.25, 25:21.75

VIDEO GAMES

Commercial marks, use of, 10:22 False endorsement by use in, 28:15 Personal name, use of, 27:86 Transformative Test analysis, publicity, 28:19

VISUAL ARTIST'S RIGHTS ACT

Generally, 10:29

VISUAL CHARACTERS

Trademark protection, 10:42

VOLUNTARY DISCLAIMERS

Federal registration, 19:67

WAIVER

Collateral estoppel, defenses, summary judgment, motion for, 32:87 Defense, existence of, 31:43

WALLPAPER EFFECT

Repeating pattern, 7:32

WARRANTY

Franchises, tort liability, 18:77

WEARING APPAREL

Clothing (this index)

WEBSITES

Internet (this index)

WELL-KNOWN MARKS

Famous Marks (this index)

Geographic Terms (this index)

WORD MARKS

Depletion of, 19:2.50

Drawing of mark in application, federal registration, 19:58

WORDS

Coined Words (this index)

Copyrights, 6:19

Definitions (this index)

Foreign, 23:36 to 23:40

Generic Terms (this index)

INDEX

WORDS—Cont'd

Informational, 3:5
Meanings, new, 3:3, 4:1
New meanings, 3:3, 4:1
Slogans, 3:5
Slogans (this index)

WORDS—Cont'd

Trademarks, claiming too many words, **3:6**

Versions, singular and plural, 23:46.25

WORLD-WIDE PHENOMENON

Generally, 2:6