

Index

ABANDONMENT OF RIGHTS

Generally, **17:1 to 17:28**
Activity level, **17:14**
Application of tacking rules, **17:27**
Assignments, **18:19**
Automobiles, **17:15**
Avoiding abandonment, changes in usage, **17:25**
Bona fide use, **17:9**
Cancellation proceedings, **20:57**
Cessation of business, temporary, **17:14**
Changes in usage
 generally, **17:23 to 17:28**
 avoiding abandonment, **17:25**
 continuing commercial impression rule, **17:26**
 illustrative examples, **17:27**
 modernization of marks, **17:28**
 nature of goods sold, change in, **17:24**
 priority, **17:25**
 products, change in use of mark to different, **17:23**
 tacking-on older to newer version of mark, **17:25 to 17:28**
 updating marks, **17:28**
Clear and convincing evidence, **17:12**
Closed business, sale of, **17:14**
Continuing commercial impression rule, changes in usage, **17:26**
Continuing use, abandonment through nonuse, **17:9**
Corporate names, **17:14**
Evidence, missing, **17:9**
Federal law, **17:18 to 17:21**
Federal registration, petition to revive abandoned application, **19:125.50**
GATT amendment, **17:19**
Generic term, trademark becoming, **17:8**
Good will, loss of, **17:14**
“Indistinguishable” rule, **17:26**
Infringers, failure to prosecute, **17:17**
Intent, **17:9, 17:11, 17:13**
Intent, old rule, **17:10**
Issue of fact, **17:5**

ABANDONMENT OF RIGHTS

—Cont’d

Laches and delay, **17:17, 31:27**
Licensing of mark, uncontrolled, **17:6**
Limited territorial area, abandonment in, **17:22**
Loss of all rights, abandonment by, **17:6 to 17:8**
Material alteration rule, **17:26**
Modernization of marks, **17:28**
Nature of goods sold, change in, **17:24**
Non-use of mark, generally, **17:9 to 17:22**
Objective evidence can outweigh self-serving testimony, **17:13**
Persisting recognition, **17:15**
Presumption of abandonment after three years, **17:18**
Presumption of abandonment after three years, burden to rebut, **17:21**
Prima facie evidence, **17:21**
Priority, changes in usage, **17:25**
Procedural contexts, **17:4**
Products, change in use of mark to different, **17:23**
Rebutting inference, **17:11**
Re-cycling unused trademarks, **17:2**
Resumption of use after abandonment, **17:3**
Sale of
 closed business, **17:14**
 mark, **17:14**
Stopping use, abandonment through nonuse, **17:9**
Tacking-on older to newer version, **17:25 to 17:28**
Temporary suspension of use of mark due to outside causes, **17:16**
Trademark rights in others after abandonment, **17:2**
Updating marks, **17:28**

ABBREVIATIONS

Generally, **7:18**
Descriptive marks, **11:32**

ABBREVIATIONS—Cont'd

Generic terms, **12:37**
 Personal names as marks, **13:20**

ABROAD

Infringement, extraterritorial reach of the Lanham Act, **25:58**

ABUSE OF PROCESS

Strength of marks, enforcement, **11:93**

**ACCELERATED CASE
 RESOLUTION PROCEDURE
 (ACR)**

Inter partes proceedings, summary of trial procedure, **20:102**

ACCOUNTING

Jury trial, **32:124**
 Monetary Recovery (this index)

ACQUIESCENCE

Generally, **31:41, 31:42**
 Cancellation proceedings, failure to object to use of mark, **20:74 to 20:77**
 Consent (this index)
 Defense distinct from laches, **31:41**
 Estoppel, **32:105**
 Inter partes proceedings, failure to object to use of mark, **20:32 to 20:38**
 Types, **31:42**

ACQUISITION AND PRIORITY OF RIGHTS

Generally, **16:1 to 16:34**
 Advertising not a use for federal registration, **16:29**
 Affixation of mark
 generally, **16:22 to 16:23**
 common law, **16:22, 16:22.50**
 Lanham Act rule for registration, **16:23**
 Analogous use, **16:14**
 Assignments, **18:16.50, 18:18**
 Assignment to acquire priority, **16:9.50**
 Bad faith and add-on use, inherently distinctive marks, **16:10**
 Beta testing, **16:7**
 Bona fide transactions, inherently distinctive marks, **16:7**
 Burden of proof of priority, **16:20**
 Catalog uses, federal registration, **16:32**

ACQUISITION AND PRIORITY OF RIGHTS—Cont'd

Changes in usage, **17:25**
 Common law
 generally, **16:1**
 archaic rule, **16:22**
 modern rule, **16:22.50**
 Constructive use
 generally, **16:15 to 16:18.50**
 federal registration, **16:16, 16:18, 16:18.50**
 intent to use application, **16:16**
 pre-existing common law rights, federal registration does not cut off, **16:18.50**
 statutory provisions, **16:15**
 Displays associated with goods, use on, **16:30 to 16:32.30**
 Domain names, **16:7**
 Employee sales, **16:7**
 Evidence of priority
 burden of proof, **16:20**
 federal registration, **16:19**
 Federal
 constructive use priority, **16:2**
 registration
 generally, **16:27 to 16:33**
 advertising not a use, **16:29**
 catalog uses, **16:32**
 constructive use, **16:16, 16:18.50**
 displays associated with goods, use on, **16:30 to 16:32.30**
 evidence of priority, **16:19**
 inherently distinctive marks, **16:8**
 Internet website use, **16:32.70**
 Lanham Act, affixation of trademark, **16:23**
 methods of use, **16:28**
 proper use on goods, **16:27**
 service marks, **16:33**
 television infomercial uses, **16:32.30**
 trade show uses, **16:31**
 First use, inherently distinctive marks, **16:4**
 Idea for trademark, **16:11**
 Inherently distinctive marks
 generally, **16:3 to 16:10.50**
 acquisition of ownership by priority of use, **16:4**
 bad faith and add-on use, **16:10**

INDEX

ACQUISITION AND PRIORITY OF RIGHTS—Cont'd

Inherently distinctive marks—Cont'd
bona fide transactions, **16:7**
federal registration, **16:8**
first use, **16:4**
governance of ownership by priority of use, **16:5**
making and breaking chain of priority, **16:5**
prior and continuing use, **16:9**
quantity and quality of use necessary to achieve priority, **16:6 to 16:8**
small scale transactions, **16:6**
unlawful use, **16:10.50**
Intent to use application, constructive use, **16:16**
Internet website use, affixation—federal registration, **16:32.70**
Inter partes proceedings, **20:17**
Inventions, **16:11**
Lanham Act rule for registration, **16:23**
Literary, artistic and entertainment rights, **10:4**
Pre-existing common law rights, federal registration does not cut off, **16:18.50**
Preparatory steps, **16:12**
Preparing to do business, use of mark in, **16:12 to 16:14**
Prior and continuing use, inherently distinctive marks, **16:9**
Priority in secondary meaning, **16:34**
Quantity and quality of use necessary to achieve priority, inherently distinctive marks, **16:6 to 16:8**
Registration, **16:1.50, 16:18**
Secondary meaning, **16:34**
Service marks, federal registration, **16:33**
Small scale transactions, inherently distinctive marks, **16:6**
SNOB precedent, **16:6**
Statutory provisions, constructive use, **16:15**
Sufficient pre-sales activity, preparing to do business, **16:13**
Teletrak, **16:13, 16:14**
Television infomercial uses, federal registration, **16:32.30**
Trademark maintenance, **16:6**

ACQUISITION AND PRIORITY OF RIGHTS—Cont'd

Trade name, priority of use as, **9:2**
Trade show uses, federal registration, **16:31**
Traditional rule, preparing to do business not sufficient, **16:12**
United States vis-a-vis world priority, **16:21**
Unlawful use, inherently distinctive marks, **16:10.50**
Use, **16:1.50, 16:18**
World priority, **16:21**

ACTIVITY

Level of, abandonment of rights, **17:14**

ACTUAL CONTROVERSY REQUIREMENT

Declaratory judgments, **32:51 to 32:52**

ADJECTIVES

Generic terms, adjective-noun debate, **12:10**

ADMISSIONS, REQUESTS FOR

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

ADVERTISING

Generally, **3:13**
Acquisition and priority of rights, federal registration, **16:29**
Ambush advertising, **27:66**
Commercial advertising or promotion, **27:95**
Copyrights (this index)
Cyberspace, Infringement in (this index)
Disparagement law limited to commercial advertising or promotion, **27:95**
fact representation, not opinion, **27:96**
Fact representation, not opinion, **27:96**
False Advertising (this index)
Federal registration, use of United States flag prohibited, **19:79**
Geographic terms, common law remedies for false advertising, **14:24**
Infringement (this index)
Injunctions, **30:6**
Insurance (this index)
Monetary recovery, **30:80 to 30:84**
Periodicals, **10:6**

ADVERTISING—Cont'd

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**

Appellate review jury verdict, **32:133**

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**

INDEX

APPEAL AND REVIEW—Cont'd

- Ex parte appeal, **19:127**
- Geographic terms, deceptive usage, three part test, **14:32.50**
- Inter partes proceedings, **20:100, 20:106, 21:24**
- Judicial power, **21:23**
- 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 consent, **18:5**
 - establishment of business, assignment prior to, **18:6**
 - 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**
 - 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**

INDEX

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

—Cont'd

Equitable defenses—Cont'd
 laches or acquiescence by failure to object to use of mark, **20:74 to 20:77**
 similar registration, acquiescence by failure to oppose, **20:78**
 supplemental registration, cancellation of, **20:80**
 Estoppel, **20:79**
 Evidence. Pleading and proof, below
 Exceptions to laches, **20:77**
 Ex parte
 grounds, cancellation on, **20:69**
 inter partes matters, **4:18**
 Federal Trade Commission, **20:63**
 Filing petition to cancel, **20:72**
 Five years
 registration for less than, **20:52 to 20:54**
 registration for more than, **20:55 to 20:64**
 Fraud, **20:58, 31:80**
 Functionality, standing, **20:50**
 Functional mark, **20:56.50**
 Generic, designation is or has become, **20:56**
 Genericness, standing, **20:50**
 Grounds, generally, **20:52 to 20:64**
 Immoral, standing required to petition to cancel on grounds of, **20:50.50**
 Intent to use applications, **20:45**
 Laches by failure to object to use of mark, **20:74 to 20:77**
 Lanham Act
 Section 2(a), (b) or (c) or 4 as ground, **20:59**
 Section 2(d) as ground, **20:53**
 Section 43(c) as ground, **20:53.50**
 Likelihood of damage, standing, **20:46, 20:49**
 Misrepresentation of source of goods or services, **20:60**
 Morality, standing required to petition to cancel on grounds of, **20:50.50**
 No consumer standing in the trademark trial
 and appeal Board, **20:9**
 Partial cancellation, **20:44**
 Petition to cancel, **20:46, 20:49, 20:72**

CANCELLATION PROCEEDINGS

—Cont'd

Pleading and proof
 generally, **20:41, 20:43, 20:65 to 20:72**
 attack on validity of registration, **20:65**
 burden of proof, **20:64**
 collateral cancellation, **20:70.50**
 compulsory counterclaims, **20:66**
 ex parte grounds, cancellation on, **20:69**
 filing petition to cancel, **20:72**
 proof, **20:41**
 tolling of the statutory limit for cancellation counterclaim in opposition proceedings, **20:67**
 use of mark, proof of, **20:71**
 withdrawal of petition, **20:70**
 Previously registered marks not republished, **20:62**
 Procedure, **20:43**
 Purpose, **20:40**
 Rectifying the register, **20:44**
 Scandalous matter, standing required to petition to cancel, **20:50.50**
 Similar registration, acquiescence by failure to oppose, **20:78**
 Standing
 generally, **20:46 to 20:51**
 counterclaim, opposition proceeding, **20:51**
 descriptiveness, **20:50**
 functionality, **20:50**
 genericness, **20:50**
 immoral or scandalous, standing required to petition to cancel on grounds of, **20:50.50**
 likelihood of damage, **20:46, 20:49**
 petition to cancel, **20:46, 20:49**
 Statutory limit for cancellation counterclaim in opposition proceedings, tolling of, **20:67**
 Supplemental registration, cancellation of, **19:41, 20:80**
 Time to file petition, **20:42**
 Tolling of statutory limit for cancellation counterclaim in opposition proceedings, **20:67**
 Use of mark, proof of, **20:71**
 Withdrawal of petition, **20:70**

INDEX

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

- Generally, **11:5 to 11:9**
- Definitions, **11:5**
- Examples, **11:8**
- Generic terms, **11:9, 12:17.50**
- Inherent strength, **11:6**
- Legal vs. merchandising conflicts, **11:7**

COLLATERAL CANCELLATION

- Pleading and proof, **20:70.50**

COLLATERAL ESTOPPEL

- Res Judicata and Collateral Estoppel (this index)

COLLECTIVE MARKS

- Generally, **4:9, 19:98 to 19:101**
- Anti-use by owner rule, **19:100**
- Collective membership marks, **19:101**
- Definitions, **4:9**
- Geographic terms, regional certification marks and collective marks, **14:21**
- Identification of goods and services of members, **19:99**

COLOR

- Generally, **7:39 to 7:52**
- Building designs, color in combination with, **7:48**
- Business vehicles, color in combination with, **7:48**
- Coding system, **7:52**
- Commonplace vs. distinctive, **7:45**
- Defined designs, color combinations and color in, **7:40, 7:45**
- Definition of color, defining and narrowing in registration, **7:45.30**
- Depletion, **7:40, 7:44**
- Descriptive indication, **7:52, 11:41**
- Distinctive vs. commonplace, **7:45**
- Drug capsule colors, **7:50, 7:51**
- Flavor, **7:52**
- Functionality, **7:40, 7:49, 7:88**
- Generic or descriptive indication, **7:52**
- Judicial power, definition of color, **7:45.30**
- Likelihood of confusion, **23:52**
- Liquid products, color of, **7:47**
- Non-specified color, design of, **7:46**
- Registration
 - defining and narrowing definition in, **7:45.30**

COLOR—Cont'd

- Registration—Cont'd
 - Qualitex rule, **7:44**
 - single color registrations, examples, **7:44.50**
 - strategy, including color in registration, **7:45.30**
- Scope of rights in color mark, **7:45.70**
- Secondary meaning, **7:44**
- “Shade confusion,” **7:44, 7:45.70**
- Single color
 - generally, **7:40**
 - anti-single color, antiquated rule, **7:40, 7:41, 7:42**
 - registrations, examples, **7:44.50**
 - service marks, **7:40**
- Strategy, including color in registration, **7:45.30**
- Type or size, **7:52**

“COLORABLE IMITATION”

- Counterfeiting, distinguished from, **25:15.50**

COMBINED MARKS

- Co-branding, **7:8**

COMMERCE

- Infringement
 - generally, **25:53 to 25:56**
 - definition of interstate commerce, mark in “commerce,” **25:55**
 - Federal Question Jurisdiction (this index)
 - foreign commerce, **25:53**
 - internet, infringing use on, **25:54.50**
 - interstate commerce, **25:53**
- Lanham Act
 - internet, infringing use on, **25:54.50**
 - local and intrastate infringement, **25:56**
 - must be in “commerce,” **25:54**
 - mark in “commerce,” definition of interstate commerce, **25:55**
- Use in Commerce (this index)

COMMERCIAL ACTIVITY

- Advertising or promotion, **27:71**
- Disparagement law limited to, **27:95, 27:96**
- Fact representation, not opinion, **27:96**

INDEX

COMMERCIAL ACTIVITY—Cont'd

- 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**
- Generic terms, **12:39**
- Geographic terms, descriptiveness, **14:11**

COMPOSITE MARKS—Cont'd

- 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**
 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**

INDEX

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**
- Overlap with trademark, **6:14, 6:17.50**
- Pictures, **6:18**

COPYRIGHTS—Cont'd

- Policy, **6:3**
- Price lists, copyright in, **6:30**
- Registration of claim to copyright, **6:28**
- Regulations, **6:20**
- Scope of exclusivity, **6:14**
- Single words, **6:19**
- Slang, **6:19**
- Slogans, **6:19**
- State preemption
 - generally, **6:15.50**
- Statutes, **6:20**
- Style, artistic, **6:14, 10:40.50**
- Trademarks and labels
 - generally, **6:17 to 6:24**
 - advertising, **6:22**
 - copying as essential for infringement, **6:24**
 - copyrightable work, trademarks in, **6:17.50**
 - copyrights, compared, **6:3**
 - infringement, **6:23, 6:24**
 - labels, **6:19, 6:21**
 - patents, compared, **6:3**
 - pictures and designs, **6:18**
 - slogans and words, **6:19**
 - statute and regulations, **6:20**
 - trademark in copyrightable work, **6:17.50**
- Warnings, product, **6:19**
- Words, **6:19**
- Works out of copyright, trademark protection in, **6:31**

CORPORATE, BUSINESS AND PROFESSIONAL TRADE NAMES

- Generally, **9:1 to 9:17**
- Archaic meaning, **4:4, 4:5**
- Bank names, **9:10**
- Charitable and nonprofit organizations, **9:5**
- Common law, **9:1 to 9:4, 9:12**
- Designation only, **4:5, 9:13**
- Distinctiveness, **9:2**
- Dual trade name
 - service mark usage, **9:15**
 - trademark usage, **9:16**
- Education institutions, **9:7**
- Eleemosynary organizations, **9:5**
- Federal
 - protection, **9:1 to 9:4**

CORPORATE, BUSINESS AND PROFESSIONAL TRADE NAMES—Cont'd

- Federal—Cont'd
 - registration
 - generally, **9:13 to 9:17**
 - definition of “trade name,” **9:13**
 - dual trade name and service mark usage, **9:15**
 - dual trade name and trademark usage, **9:16**
 - use to prevent registration to another, **9:17**
 - Fictitious name certificates, **9:9**
 - Fraternal groups, **9:6**
 - Government marks, **9:7.75**
 - Infringement, incorporation as, **9:3, 9:8**
 - Laches as a defense, **9:5**
 - Multiple uses, **9:14**
 - Nonprofit organizations, **9:5**
 - Political groups, **9:6**
 - Priority of use as trade name, **9:2**
 - Professional groups, **9:6**
 - Public exposure, **9:3**
 - Religious Freedom Information Act, **9:7.50**
 - Religious organizations, **9:7.50**
 - Senior users, **9:6**
 - Service marks, **4:7, 9:12**
 - State incorporation or registration
 - generally, **9:8 to 9:11**
 - bank names, **9:10**
 - corporate charter, forfeiture of, **9:11**
 - failure to
 - obtain license, **9:11**
 - register to do business in state, **9:11**
 - tax payments, **9:11**
 - fictitious name certificates, **9:9**
 - junior user’s corporate charter is no defense, **9:8**
 - Unregistered trade names, **9:4**
 - Use to prevent registration to another, **9:17**
 - Validity, **9:2**

COSTS

- Buyers, trademark protection, **2:5**
- Court costs, **30:107**
- Deductions to arrive at profits, **30:68**
- Search costs reduction, **2:5**

INDEX

COUNSEL FEES

Attorney Fees (this index)

COUNTERCLAIMS

Compulsory Counterclaims (this index)

COUNTERFEITING

Generally, **25:10 to 25:16.50**

Anti-counterfeiting amendments,
25:16.50

Anti-Counterfeiting Trade Agreement
(ACTA), **29:33.50**

Appeals, preliminary injunctions, **30:41**

Attachment of property, preliminary
injunctions, **30:40**

“Colorable imitation” distinguished
from, **25:15.50**

Computer programs, **25:12**

Criminal penalties

generally, **30:114 to 30:120**

anti-counterfeiting, **25:14**

Criminal Counterfeiting Act, gener-
ally, **30:115 to 30:120**

definition of counterfeit mark, **30:117**

elements of crime, **30:118**

procedure, **30:119**

safe harbor, **30:120**

Defined, **25:10**

Destruction of goods, preliminary
injunctions, **30:42**

Federal Counterfeiting Act, **25:13 to**
25:16.50

Freezing assets, preliminary injunctions,
30:40

Imported goods, **29:45**

Infringement compared to, **25:15.50**

Insurance coverage for infringement
claims, **33:6**

Monetary recovery, **30:94, 30:95**

Motion pictures, **25:12**

Phonorecords, **25:12**

Post-seizure hearing, preliminary injunc-
tions, **30:43**

Preliminary injunctions

generally, **30:34 to 30:44**

appeal, **30:41**

coverage of statute, **30:37**

destruction of goods, **30:42**

freezing assets and attaching property,
30:40

1984 statute, special federal seizure
remedies, **30:35**

COUNTERFEITING—Cont’d

Preliminary injunctions—Cont’d

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

procedure, **30:38**

purpose of statute, **30:36**

seizure of goods and records, **30:39**

special federal seizure remedies,
30:35 to 30:44

wrongful seizure, remedies for, **30:44**

Remedies

criminal penalties, above

preliminary injunctions, above

Safe harbor, **25:16, 30:120**

Seizure of goods and records, prelimi-
nary injunctions, **30:39**

Similarity, **25:15.50**

Special civil remedies, **25:15**

“Substantially indistinguishable” test,
25:15.50

Tariff Act

elements, **25:45**

remedies against imported goods,
25:11

Wrongful seizure, remedies for, **30:44**

COURT OF APPEALS FOR FEDERAL CIRCUIT

Generally, **21:10 to 21:19**

Choice, **21:10**

Diversion, trademark appeals, **21:14**

Final decisions, **21:19**

History, **21:11 to 21:13**

Jurisdiction over PTO appeals, **21:13**

Patent claims, trademark infringement
issues joined with, **21:11**

Precedents, CCPA decisions as, **21:12**

Procedure, **21:16 to 21:19**

Standard of review, **21:18**

Status, **21:11 to 21:13**

COVENANT NOT TO SUE

Federal jurisdiction, **32:2.50**

CRIMINAL PENALTIES

Counterfeiting (this index)

CROSS-EXAMINATION

Survey evidence, hearsay objection,
32:167

CYBER-GRIPING

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**
- Confusion, advertising, **25A:7**
- Contributory infringement of Internet site, **25:20.50**
- 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-gripping. Gripe Sites (this index)
- Cybersquatting (this index)
- Cyber-stuffing, **25A:3**
- 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**

INDEX

CYBERSPACE, INFRINGEMENT IN

—Cont'd

- Federal immunity, communications decency act (cda), trademark infringement, **25A:42.50**
- Forum, in rem jurisdiction, federal Anti-Cybersquatting Act, **25A:73**
- Framing and linking, **25A:4**
- Good faith. Bad faith, above
- Gripe sites
 - ICANN Uniform Dispute Resolution Policy (UDRP), **25A:33**
 - Lanham Act, **25A:45**
- Hawaii anti-cybersquatting law, **25A:86**
- Hidden code, **25A:3**
- ICANN (Internet Corporation for Assigned Names and Numbers), **25A:12**
- ICANN Uniform Dispute Resolution Policy (UDRP), **25A:21 et seq.**
 - acquired prior to trademark rights, **25A:30**
 - bad faith use, **25A:27**
 - choice of law, **25A:26**
 - complainant's trademark rights, **25A:23**
 - confusingly similar, **25A:24**
 - dealer's and distributor's use, **25A:32**
 - defaults, **25A:35**
 - defenses, **25A:29**
 - fan sites, **25A:31**
 - gripe sites, **25A:33**
 - judicial review, **25A:37**
 - legitimate rights, **25A:25**
 - passive holding rule, **25A:28**
 - personal names, **25A:31**
 - precedential weight, **25A:36**
 - procedural issues, **25A:34**
 - successful challenge, elements, **25A:22**
 - Text, **25A:39**
 - Text of rules, **25A:40**
- Initial interest confusion, Lanham Act, **25A:44**
- Injunctions, Anti-Cybersquatting Consumer Protection Act (ACPA), **25A:65**
- In rem jurisdiction, federal Anti-Cybersquatting Act, **25A:70 to 25A:78**

CYBERSPACE, INFRINGEMENT IN

—Cont'd

- Intent to divert, bad faith, Anti-Cybersquatting Consumer Protection Act (ACPA), **25A:58**
- Internet
 - domain names, **25A:10 et seq.**
 - hashtags, **25A:4.50**
 - nonfungible tokens (NFTs), Use and misuse of trademarks, **25A:4.70**
- Judicial review, ICANN Uniform Dispute Resolution Policy (UDRP), **25A:37**
- Key words, sales of, **25A:6**
- Lanham Act, **25A:41 to 25A:47**
- Legitimate rights, ICANN Uniform Dispute Resolution Policy (UDRP), **25A:25**
- Liability, Anti-Cybersquatting Consumer Protection Act (ACPA), **25A:52**
- Linking and framing, **25A:4**
- Louisiana anti-cybersquatting law, **25A:86**
- Meta tags, **25A:3**
- Misleading false contact information, bad faith, Anti-Cybersquatting Consumer Protection Act (ACPA), **25A:60**
- Multiple similar names, bad faith, Anti-Cybersquatting Consumer Protection Act (ACPA), **25A:61**
- New York Anti-cybersquatting Act, **25A:85**
- Non-commercial or fair use, bad faith, Anti-Cybersquatting Consumer Protection Act (ACPA), **25A:57**
- Notice, in rem jurisdiction, federal Anti-Cybersquatting Act, **25A:77**
- Open framework for new top level domains, **25A:15**
- Passive holding rule, ICANN Uniform Dispute Resolution Policy (UDRP), **25A:28**
- Personal e-mail web sites, Lanham Act, **25A:47**
- Personal jurisdiction, Anti-Cybersquatting Consumer Protection Act (ACPA), **25A:68**
- Personal names
 - bad faith, Anti-Cybersquatting 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 Protec-
tion 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 Protec-
tion Act (ACPA), **25A:66**
- Infringement, prima facie case require-
ment, **30:2.50**
- Monetary Recovery (this index)

DASTAR

- Copyright infringement, **6:27**
- Literary, artistic and entertainment
rights, 2003 Supreme Court deci-
sion 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**

INDEX

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 by the DJ defendant, **32:56**
- Nature of suit threatened, jurisdiction, **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 (this index)

DEFENSES—Cont'd

- Freedom of speech and press. Publicity (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

- Trade name, **4:1 et seq., 4:4, 4:5**
- Unfair
 - competition, **4:6**
 - trade practices, **4:1 et seq.**
- Well-known, **4:16**
- Words (this index)

DEMAND FOR JURY TRIAL

- Generally, **32:128**

DE NOVO TRIAL

- Generally, **21:21**

DEPOSITIONS

- Inter partes proceedings, **20:101, 20:108**

DESCRIPTIVE MARKS

- Generally, **11:15 to 11:49**
- Abbreviations, **11:32**
- Anti-dissection rule, composite marks, **11:27**
- Arbitrary and deceptive usage, distinguished, **11:60**
- Blank slate view, **11:21**
- Cancellation proceedings, **20:50**
- Challenges to applications for federal registration, **11:51.50**
- Change of form, **11:29**
- Color, **7:52, 11:36, 11:41**
- Combination of descriptive terms, **11:26**
- Commonplace objects, **7:36**
- Competitive need test v. imagination test, **11:68**
- Composite marks
 - generally, **11:26 to 11:28.25**
 - anti-dissection rule, **11:27**
 - combination of descriptive terms, **11:26**
 - repetition of descriptive or generic term, **11:28.50**
 - size superlatives, **11:28**
 - “smart” descriptive or composite marks, **11:28.25**
- Composites, **7:36**
- Consumer perception, evidence of, **11:82**
- Container shapes, **11:51**
- Contestable registration, **11:43, 11:44**
- Deceptive and deceptively misdescriptive marks
 - generally, **11:54 to 11:61**

DESCRIPTIVE MARKS—Cont'd

- Deceptive and deceptively misdescriptive marks—Cont'd
 - arbitrary and deceptive usage, distinguished, **11:60**
 - examples, **11:59**
 - gullibility of reasonably prudent purchaser, **11:61**
 - legal status variations, **11:55**
 - materiality, **11:58**
- Defined, **11:16**
- Descriptive/suggestive battle line, **11:22**
- Designs, **7:35 to 7:37, 11:48**
- Direct information about product or service, **11:19**
- Disclaimer, admission of descriptiveness, **11:52**
- Distinctively shaped goods, **7:36**
- Double entendre, **11:19**
- Evidence, **11:20, 11:38, 11:81**
- Expert testimony, **11:20**
- Fair use
 - generally, **11:45 to 11:49**
 - affirmative defense, **11:49**
 - classic fair use, **11:45 et seq.**
 - confusion, fair use can co-exist with some degree of, **11:47**
 - examples of fair use defense rejected, **11:48.50**
 - federal law, **11:49**
 - former employers, **11:48**
 - illustrative examples, **11:48**
 - microcolor, **11:47**
 - other than as trademark, use as, **11:46**
 - primary descriptive meaning, use in, **11:45**
 - prize or awards, **11:48**
 - technological, **11:48**
 - used fairly and in good faith, **11:49**
- False advertising, **11:59**
- Fanciful representations, **7:36**
- Federal registration
 - generally, **11:50 to 11:61**
 - challenges to applications, **11:51.50**
 - container shapes, **11:51**
 - contestable registration, **11:43, 11:44**
 - deceptive and deceptively misdescriptive marks, below
 - disclaimers, **11:52, 19:65**
 - merely descriptive marks, **11:50 to 11:53**

INDEX

DESCRIPTIVE MARKS—Cont'd

Federal registration—Cont'd
secondary meaning, registration upon
proof of, **11:53**
Flavor, **11:41**
Foreign equivalents doctrine, **11:34**,
11:35
Foreign web sites evidence, **11:51**
Former employer, **11:48**
Geographic Terms (this index)
Google searches, **11:20**
Grade designations. Style and grade
designations, below
Gullibility of reasonably prudent
purchaser, deceptive and
deceptively misdescriptive marks,
11:61
Illustrative examples, **11:24**
Image of goods offered, **7:36**
Imagination test v. competitive need
test, **11:68**
Inter partes proceedings, standing,
opposition, **20:11**
Knowledge of reasonable customer,
11:21
Languages, **11:34**
Legal protection, narrow, **11:23.50**
Lettering, distinctive display of, **11:30**
Literary, artistic and entertainment
rights—descriptive series titles,
10:7.10
Materiality, deceptive and deceptively
misdescriptive marks, **11:58**
Metaphor, **11:19**
Mini size, size superlative composites,
11:28
Misspelling, **11:31**
Obscure terms, **11:33**
Opposition proceedings, standing, **20:11**
Owner, narrow legal protection,
11:23.50
Pictures, **7:35 to 7:37**
Puffery, **11:17**
Quantity, **11:36**
Rationale for rule, **11:18**
Reasonably informed buyer, **11:21**
Repetition of descriptive term, **11:28.50**
Retail sales services, **11:16**
Right to inform consumers, **11:15**, **11:18**
Scent, **11:36**

DESCRIPTIVE MARKS—Cont'd

Secondary meaning, **11:15**, **11:25**,
11:38, **11:53**
Self-laudatory terms, **11:17**
Simile, **11:19**
Size, **11:36**
“Smart” descriptive or composite
marks, **11:28.25**
Sophisticated buyers, **11:16**
Status, **11:15 to 11:18**
Strength of Marks (this index)
Style and grade designations
generally, **11:36 to 11:41**
color designations, **11:41**
secondary meaning, **11:38**
Stylized representations, **7:36**
Suggestive Marks (this index)
Super size, size superlative composites,
11:28
Survey evidence, **11:51**
Symbols, **7:35 to 7:37**
non-word, **11:16.50**
Technological fair use, **11:48**
Telescoped terms, **11:26**
Terms used as trademarks, **11:23**
Tests of descriptiveness, **11:19 to 11:25**
Trade dress, **11:16.50**
“Trademark bullies,” **11:92**
Used fairly and in good faith, **11:49**
Validity, presumption of, **11:43**
Variations in legal status, deceptive and
deceptively misdescriptive marks,
11:55

DESIGNATIONS

Federal registration, **4:5**, **19:78.50**

DESIGNS

Background Designs, Shapes and
Symbols (this index)
Copyrights, **6:18**
Descriptive marks, **7:35 to 7:37**, **11:48**
Functionality (this index)
Images of goods, **7:36**
Likelihood of confusion, **23:47**
Packaging design, inherently distinctive,
8:13.50
Seabrook test, **8:13.50**
Secondary meaning, **7:29**, **15:23**
Separate commercial impression test,
7:27

DESIGNS—Cont'd

- Test for background designs, **7:28**
- TM symbol, **3:6**
- Trade dress, **6:11**
- Trademarks, claiming too many designs, **3:6**
- Unfair competition, **1:24**

DESTRUCTION ORDERS

- Injunctions, **30:9**

DETERIORATED GOODS

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

DICTIONARIES

- Generic terms, **12:28**
- Suggestive marks, use by dictionaries, **11:69**

DILUTION OF TRADEMARKS

- 1996 Federal Act and the 2003 Victoria's Secret decision, **24:112**
- Generally, **24:67 to 24:134**
- Anti-Dilution Act 1996
 - famous marks, **24:108**
 - non-famous marks, **24:110**
- Anti-Dilution Act 2006
 - famous marks, **24:107**
 - non-famous marks, **24:109**
- Anti-dilution statutes, **24:116**
- Appeal, state, **24:83**
- Association, likelihood of, **24:116**
- Association requirements, **24:117**
- Background of federal anti-dilution statute, **24:95, 24:96**
- Blurring
 - generally, **24:69, 24:113 to 24:115**
 - non-trademark use, **24:122**
 - state laws, **24:84**
- Causation, **24:121**
- Choice of law, **24:83**
- Commentary as defense, **24:126, 24:127**
- Common law, **24:76**
- Comparative advertising defense, **24:125**
- Competitive goods and services, **24:74**
- Contributory and vicarious liability, **25:21.75**
- Criticism, **24:126**
- Defective goods, tarnishment, **24:91**

DILUTION OF TRADEMARKS

—Cont'd

- Defenses, **24:83, 24:123 to 24:130, 24:134**
- Defined, **24:73**
- Degree of similarity of conflicting marks, **24:83**
- Deteriorated goods, tarnishment, **24:91**
- Dissonant usage, tarnishment, **24:91**
- Distinctiveness, **24:118**
- Evidence of likelihood of injury to famous mark, **24:119, 24:121**
- Fair use, **24:124 to 24:126**
- Famous marks, **24:104 to 24:110**
- Federal
 - anti-dilution statute, **24:93 et seq. prior to 1996, 24:94**
 - law, generally, **24:89 to 24:134**
 - preemption of state law, **24:80**
 - registration defense, **24:83**
- Federal Anti-Dilution Revision Act, **24:115**
- Free riding v. impairment of distinctiveness, **24:68**
- Free speech and parody, **24:90, 24:126**
- Generic usage of valid trademarks, **24:75**
- Historic structures, names of, **24:134**
- Injunction, territorial scope of, **24:82**
- Injury to famous mark, proving, **24:119**
- Inter partes proceedings, **20:20.50, 24:100**
- Laches, **24:83, 24:130**
- Lanham Act section 43(c), contributory and vicarious liability, **25:21.75**
- LEXIS vs. LEXUS, **24:85**
- Likelihood of
 - association, **24:116**
 - confusion, distinguished, **24:72, 24:73**
- Multi-factor test, **24:119**
- Negative setting, alteration in, **24:92**
- News reporting as defense, **24:127**
- New York, **24:85**
- Niche fame, **24:105**
- Noncommercial use statutory defense, **24:128**
- Non-trademark use, **24:122**
- Over-enforcement, anti-dilution law, **24:70**
- Parody and free speech, **24:90, 24:126**

INDEX

DILUTION OF TRADEMARKS

—Cont'd

- Prima facie case, **24:99**
- Procedure
 - generally, **24:133**
 - state law, **24:83**
- Remedies, **24:81, 24:82, 24:132**
- Repaired products, tarnishment, **24:91**
- Retroactivity, **24:131**
- Small segments, niche fame, **24:105**
- Standing, dilution by blurring argument, **24:121.50**
- State law
 - generally, **22:3, 24:76 to 24:88**
 - anti-dilution statutes, **24:77 to 24:79.50**
 - blurring, **24:84, 24:86**
 - common law, **24:76**
 - federal preemption, **24:80**
 - injunction, territorial scope of, **24:82**
 - LEXIS vs. LEXUS, **24:85**
 - New York, **24:85**
 - procedure, **24:83**
 - remedies, **24:81**
 - strength of mark, **24:87, 24:88**
 - substantive aspects, **24:83**
- Statute of limitations, **24:130**
- Statutory factors, **24:120**
- Strength of marks
 - generally, **24:87, 24:88**
 - likelihood of impairment, **24:118**
 - niche fame, **24:105**
- Substantive aspects, state law, **24:83**
- Tarnishment
 - generally, **24:89 et seq.**
 - defective goods, **24:91**
 - deteriorated goods, **24:91**
 - dissonant usage, **24:91**
 - negative setting, alteration in, **24:92**
 - parody and free speech, **24:90**
- Territorial scope of injunction, **24:82**
- Timing of acquisition of fame, **24:103**
- Trade dress, **24:83, 24:102**
- Trademark Dilution Revision Act, factors, **24:120**
- Vicarious liability, **25:21.75**

DIRECTOR OF PATENTS AND TRADEMARKS

- Generally, **21:5 to 21:7**
- Invoking the supervisory power, **21:7**

DIRECTOR OF PATENTS AND TRADEMARKS—Cont'd

- Review of a requirement of the examiner in an ex parte examination, **21:6**
- Trademark petitions, **21:5 to 21:7**

DISCLAIMERS

- Descriptive marks, **11:52**
- Federal Registration (this index)
- Likelihood of confusion, **23:51**

DISCLOSURE, INTER PARTES PROCEEDINGS

- Pretrial disclosure, **20:115.50**
- Trademark Trial and Appeal Board discovery, **20:112**

DISCOVERY

- Inter Partes Proceedings (this index)

DISMISSAL

- Summary judgment, failure to state a claim, **32:121.75**

DISPARAGEMENT OF PRODUCTS

- Trade Libel and Product Disparagement (this index)

DISPARAGING MARKS

- Bar to registration of, **19:77.25**

DISPUTE RESOLUTION

- ICANN Uniform Dispute Resolution Procedure (UDRP). Cyberspace, infringement in (this index)

DISSONANT USAGE

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

DISTINCTIVELY SHAPED GOODS

- Descriptive marks, **7:36**

DISTINCTIVENESS

- Generally, **4:13, 11:1 to 11:93**
- Acquired, **4:14**
- Arbitrary Marks (this index)
- Coined Word Marks (this index)
- Comparison, strength and secondary meaning, **4:15**
- Corporate, business and professional trade names, **9:2**
- Definitions, **4:13, 4:15**
- Descriptive Marks (this index)
- Dilution of trademarks, **24:118**

DISTINCTIVENESS—Cont'd

- False advertising, **11:59**
- Inherently distinctive marks, **4:13, 11:4**
- Placement of candidates on spectrum, **11:2, 11:3**
- Proving, **4:13**
- Secondary Meaning (this index)
- Strength of Marks (this index)
- 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**

DOMAIN NAMES—Cont'd

- 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

- USPTO electronic applications and communications, **19:46**

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**

INDEX

ESTOPPEL—Cont'd

- 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**
- 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**

EXPRESSIVE WORKS—Cont'd

- 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**
 - unfair competition, **10:42**
- Coincidental use of personal name in fictional works, **27:87**
- Commercially valuable data misappropriation, **10:57**
- Commercial marks, goods and services
 - generally, **10:18 to 10:23**
 - art works, use of commercial marks in, **10:23**
 - character names, **10:20**
 - entertainment free speech, **31:149**
 - expressive works, **10:22, 31:149**
 - false endorsement, **10:22**
 - infringement, **10:22**
 - media, commercial marks used in, generally, **10:22, 10:23**
 - Media and magazine titles without permission on, **10:19**
 - media titles used on commercial goods and services, **10:18 to 10:20**
 - movies, **10:22**
 - negative connotations, **10:22**
 - parodies, **10:22**
 - radio, television, and movie titles and character names, **10:20**
 - Rock and Roll Hall of Fame, **10:23**
 - Rogers test, **10:22**
 - sponsorship and affiliation, confusion of, **10:18**
 - television, **10:22**
 - Tiger Woods painting, **10:23**
 - video games, **10:22**
- Cooper precedent, **10:4**
- Copyright law, **10:34, 10:41, 10:44**
- Cover illustrations, **10:4**
- Dastar, 2003 Supreme Court decision in, **6:27, 27:78, 27:78.30**
- Deceased person, use of name of, **10:26**

EXPRESSIVE WORKS—Cont'd

- Descriptive series titles, **10:6, 10:7.10**
- Design patents, **6:11**
- Exclusive rights in titles, **10:1**
- Expressive media other than titles and characters, **10:42.50**
- Expressive works, commercial marks used in, **10:22, 31:149**
- Fair use, **10:14**
- False
 - advertising
 - generally, **27:77 to 27:90**
 - coincidental use of personal name in fictional works, **27:87**
 - copyright, false use of name on work that infringes, **27:81 to 27:83**
 - copyright notice, false matter in, **27:79**
 - Dastar, 2003 Supreme Court decision in, **6:27, 27:78.30**
 - false endorsement, **27:88**
 - imitator's claim of being creator of work, **27:81**
 - motion pictures and television programs, distinctive features of, **27:89**
 - name, unauthorized use, **27:83**
 - name of artist, author, or performer, false use of, **27:85**
 - over-representation of artist's, author's or performer's contribution or currency of performance, **27:84**
 - personal name, use in title or content of another's work, **27:86**
 - unauthorized editing of creative work, **27:83**
 - unauthorized use of copyrighted work, **27:82**
 - endorsement, **27:88**
 - representation of being creator of idea or invention, **27:78**
 - use of name of artist, author, or performer
 - generally, **27:85**
 - another's use of work, **10:30**
- Federal
 - preemption, **10:35, 10:46**
 - protection, **10:38 to 10:40**

INDEX

EXPRESSIVE WORKS—Cont'd

- Federal—Cont'd
 - registration, **10:38**
- Freedom of speech, unpermitted use in expressive works, **31:149**
- Generic series titles, **10:9**
- House marks, **10:15**
- Identification of single source, **10:10**
- Insurance coverage for intellectual property, **33:18 to 33:22**
- 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, **10:4.10**
 - registration of titles, USPTO, **10:4**
 - secondary meaning required, **10:2**
 - USPTO register, **10:4**
- Media, generally. Commercial marks, goods and services, above
- Misappropriation
 - generally, **10:47 to 10:57**
 - commercially valuable data, **10:57**
 - creation of doctrine, **10:48**
 - history of doctrine, **10:51**
 - limitations on doctrine, **10:55**
 - preemption provisions, **10:52 to 10:54**
 - prima facie case, **10:49**
 - sporting events, **10:56**
 - trademark, generally, **10:50**
- Mockbusters, **10:12**
- Movies
 - books, based on, **10:12**
 - commercial goods and services, **10:20, 10:22**
 - entertainment free speech, use of commercial mark, **31:149**
 - Lanham Act section 43(a), **27:89**
- Music as trademark, **6:17.50**

EXPRESSIVE WORKS—Cont'd

- Name of artist, author, or performer
 - editing, unauthorized use, **27:83**
 - false use of
 - generally, **27:85**
 - another's use of work, **10:30**
 - use on a work, **10:30**
- Names of characters
 - commercial goods and services, **10:20**
 - personal names, below
- 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**
 - biography of author, **10:44**
 - deceased person, use of name of, **10:26**
 - false representation of being creator of idea or invention, **27:78**
 - public domain work, use of name of author of, **10:26**
 - title or content of work, use in, **27:86**
 - truthful and false use of name on work, **10:26 to 10:30**
 - use of names in connection with works, **10:26 to 10:30**
 - Visual Artist's Rights Act, **10:29**
- Pictures, single source, identifying, **3:8**
- Pre-release publicity and recognition, **10:12**
- Priority rights, **10:4**
- Protection from one medium to another, **10:17**
- Public domain work, use of name of author of, **10:26**
- Radio titles, **10:20**
- Rock and Roll Hall of Fame, **10:23**
- Sears-Compco defense, **10:35**
- Secondary meaning
 - generally, **10:10 to 10:14, 15:21**
 - fair use, **10:14**

EXPRESSIVE WORKS—Cont'd

- Secondary meaning—Cont'd
 - identification of single source, **10:10**
 - pre-release publicity and recognition, **10:12**
 - relevant evidence, **10:13**
 - series of literary works, **10:7**
 - single literary works, **10:2**
 - tests of secondary meaning, **10:10**
- Song titles, **10:15**
- Sponsorship, confusion of, **10:18**
- 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 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**

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)
- 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**

INDEX

FALSE ADVERTISING—Cont'd

- 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**
- Elements of prima facie case, **27:24**
- Evidence, **27:42 to 27:44, 27:53 to 27:58**
- Examples, **27:72 to 27:76**
- Factual support for comparative advertising, **27:61**
- Failure to disclose facts, **27:65**
- False comparative advertising, standing, **27:30**
- Federal question jurisdiction, **27:45, 32:10**
- Federal Trade Commission, power to prohibit, **27:118**
- Final injunctions, standing, **27:36, 27:37**
- Food, Drug & Cosmetic Act, Lanham Act claims, **27:65.50**
- Formatting, deceptive, **27:66.70**
- Free speech
 - generally, **27:67 to 27:71**
 - commercial advertising or promotion, false statements, **27:71**
 - commercial speech, **27:67 to 26:69**
 - media liability, **27:70**
 - remedies that impact on commercial speech, **27:69**
- Generic terms, **12:26, 12:48**
- Geographic
 - false designation, **14:23**
 - origin, false designation of, **27:49**
 - source, false representation of, **27:5**
- Good faith, false claim of infringement, **27:66.40**
- Gray market, imported goods, **29:53**
- Growth of section 43(a), **27:8**
- Imported goods, gray market, **29:53**
- Infringement (this index)
- Infringement of patent, false claim, **27:66.40**
- Inherent quality or characteristic, **27:64**

FALSE ADVERTISING—Cont'd

- Injunctions, standing, **27:27 to 27:33, 27:36, 27:37**
- Intent, **27:51, 27:58**
- Interstate commerce, jurisdiction, **27:47**
- Jurisdiction
 - generally, **27:45 to 27:48**
 - federal question, **27:45**
 - interstate commerce, effect on, **27:47**
 - Laches and statute of limitations in & section 43(a) cases, **27:48**
 - state courts, **27:46**
- Laches and statute of limitations in & section 43(a) cases, jurisdiction, **27:48**
- Lanham Act, **27:6 to 27:112.10**
- Legislative intent, **27:25**
- Libel. Trade Libel and Product Disparagement (this index)
- Likelihood of damage, standing, **27:31**
- Literally false or misleading, two part test, **27:53 to 27:55**
- Literary, Artistic and Entertainment Rights (this index)
- Material misrepresentation, standing, **27:35**
- Measures of recovery, monetary remedies, **27:43**
- Media liability, free speech, **27:70**
- Methods of proof, **27:56 to 27:58**
- Misleading statements or literally false, two part test, **27:53 to 27:55**
- Monetary remedies
 - generally, **27:40 to 27:44**
 - actual deception or confusion, proving damages, **27:42**
 - antitrust analogies, proving damages, **27:44**
 - causation, **27:41**
 - diverted customers, proving damages, **27:42**
 - measures of recovery, **27:43**
- Native advertising, **27:66.70**
- Nature of goods, false representations as to, **27:50 to 27:66**
- Necessary implication, **27:54.50**
- New York statutes, **27:116**
- Non-competitors, **1:8, 1:11, 27:32**
- Number of people deceived, **27:57**
- Opinion statements, **27:67**
- Parties liable, **27:52**

FALSE ADVERTISING—Cont'd

- Patent protection, false claim, **27:66.40**
- Picture of plaintiff's product, use to sell defendant's different product, **27:74**
- Preliminary injunctions, standing, **27:36, 27:37**
- Prima facie case, elements of, **27:24**
- Product disparagement. Trade Libel and Product Disparagement (this index)
- Protection under trademark, false claim, **27:66.20**
- Proving false representation, **27:34 to 27:38**
- Puffing defense, standing, **27:38**
- Qualities of goods, false representations as to, **27:50 to 27:66**
- Registration, false claim, **27:66.20**
- Retailer liability, **27:34.50**
- Retroactivity of amendments to section 43(a), **27:10**
- Single source exception, common law, **27:4, 27:26**
- Standing
 - generally, **27:27 to 27:39**
 - actual deception not necessary, **27:36**
 - common law, **27:1**
 - consumer and noncommercial standing, **27:39**
 - false comparative advertising, **27:30**
 - injunctions, **27:27 to 27:33, 27:36, 27:37**
 - likelihood of damage, proof of, **27:31**
 - material misrepresentation, **27:35**
 - non-competitors, **27:32**
 - preliminary and final injunctions, **27:36, 27:37**
 - proving false representation, **27:34 to 27:38**
 - puffing defense, **27:38**
- State courts, jurisdiction, **27:46**
- Survey evidence, significance of results, **32:193**
- Text of section 43(a), **27:6 to 27:11**
- Trade Libel and Product Disparagement (this index)
- Trademark Law Revision Act, **27:10**
- Trademarks and trade dress, examples, **27:73**
- Two part test, literally false or misleading, **27:53 to 27:55**

FALSE ADVERTISING—Cont'd

- Types of false advertising, **27:63**
- Unclean hands, **31:54**
- Vicarious avenger of consumer interests, competitor as, **27:2**

FALSE ENDORSEMENTS

- Publicity (this index)

FAMILY NAME

- Personal names, **13:9.50**

FAMILY OF MARKS RULE

- Likelihood of confusion, **23:61**

FAMOUS MARKS

- Definitions, **4:16**
- Dilution of trademarks, **24:104 to 24:110, 24:119**
- Doctrine, **29:61 et seq.**
- International aspects
 - generally, **29:61 to 29:64**
 - description of doctrine, **29:61**
 - NAFTA and GATT TRIPs use of doctrine, **29:63**
 - Paris Convention and Well-Known Marks Doctrine, **29:62**
 - spill over of fame between nations, **29:64**
- Marks Doctrine, **29:62**
- NAFTA and GATT TRIPs use of doctrine, **29:63**
- Paris Convention, **29:62**
- Strength of marks, **11:78**
- TRIPs, **29:63**
- Well-known Marks doctrine, **29:61 et seq.**
- Well-known works doctrine, **29:63**

FANCIFUL REPRESENTATIONS

- Descriptive marks, **7:36**

FASTENER QUALITY ACT

- PTO registration of insignias, **19:149**

FEDERAL ANTI-DILUTION REVISION ACT

- Dilution of trademarks, **24:115**

FEDERAL DIVERSITY JURISDICTION

- Generally, **32:32 to 32:34**
- Amount in controversy, **32:34**
- Complete diversity, **32:33**

INDEX

FEDERAL JURISDICTION

Article III standing trademark infringement, **32:3.20**

FEDERAL PREEMPTION

Copyrights, **6:5, 6:15**
Dilution of trademarks, **24:80**
Literary, artistic and entertainment rights, **10:35, 10:46**
Product designs, Sears-Compco. Product and Container Shapes (this index)
Trade dress, **6:15**
Trademarks, **6:15**
Unfair competition, **1:18**

FEDERAL QUESTION JURISDICTION

Generally, **32:2 to 32:19**
Bankruptcy proceedings, **32:8**
Covenant not to sue, **32:2.50**
False advertising, **27:45, 32:10**
False or fraudulent registration, damages from, **32:9**
Foreign commerce, infringement must affect, **32:5**
Infringement in interstate or foreign commerce
generally, **32:3 to 32:8**
bankruptcy proceedings, **32:8**
basis of suit must be infringement, **32:4**
foreign commerce, infringement must affect, **32:5**
interstate commerce, infringement must affect, **32:5**
standing to sue, registrant only, **32:3**
suit filed in state court and removed to federal court, **32:7**
Interstate commerce, infringement must affect, **32:5**
Lanham Act, **32:11**
Licensee standing to sue, **32:18**
Non-owner of mark, standing, **32:12**
Patent and Trademark Office decision, review in federal court, **32:14**
Registered mark, infringement of, **32:18**
Standing (this index)
State court action and removal, **32:13**
Suit filed in state court and removed to federal court, **32:7**
Unfair competition claims, **32:15**

FEDERAL QUESTION

JURISDICTION—Cont'd

Unregistered marks, infringement of, **32:11 to 32:13**
Venue (this index)

FEDERAL REGISTRATION

Generally, **19:1 to 19:149**
Abandoned application, petition to revive, **19:125.50**
Access to pending applications, **19:7**
Accuracy of information, applications, **19:51**
Acquisition and Priority of Rights (this index)
Actions after registrations, generally, **19:134**
Advantages of registration in Principal Register, **19:9**
Advertising, use of United States flag in, **19:79**
Allowance of registration, **19:132**
Alternative bases, **19:1**
Amendments
applications, **19:49, 19:58.50, 19:131**
disclaimers, **19:70**
intent to use applications, **19:18 to 19:21**
registrations, **19:133**
Supplemental Register, Trademark Law Revision Act, **19:35**
Appeal and Review (this index)
Applications
generally, **19:45.25 to 19:61.50**
accuracy of information, **19:51**
amendment and response after rejection of application, **19:131**
amendment of definition of goods and services, **19:49**
amendment to drawing of mark in application, **19:58.50**
classification of goods and services, registration in Principal Register, **19:56**
defining goods and services, **19:48, 19:49**
disclaimers, below
division of application, **19:57**
drawing of mark in application, below elements, **19:45.25 to 19:54**
examination of application, below

FEDERAL REGISTRATION—Cont'd

- Applications—Cont'd
 - federal court litigation, pending applications, **30:113.50**
 - fraud, risks of charge of, **19:51**
 - Madrid Protocol (this index)
 - multiple classifications, application for goods and services falling in, **19:56.50**
 - one mark per registration, **19:60.50**
 - owner of trademark, application must be made by, **19:53**
 - phantom registrations, **19:61**
 - Principal Register, registration in, **19:56, 19:56.50**
 - specification of goods and services, **19:48, 19:49**
 - specimens of mark, **19:61.50**
 - Trademark Law Treaty changes, **19:45.25**
 - USPTO electronic applications and communications, **19:46**
- Approval of government, registration does not connote, **19:3.50**
- Attack on interstate use, **19:119**
- Attorney, U.S.-based required for foreign domiciled applicants, registrant and parties, **19:50**
- Author's comment, **19:60**
- Bars to registration
 - generally, **19:75 to 19:79**
 - advertising, use of United States flag in, **19:79**
 - certification marks, **19:95**
 - disparaging marks, **19:77.25**
 - flag, coat of arms or insignia of United States, state, municipality or foreign nation, marks that comprise, **19:78, 19:79**
 - foreign nations and nationals, **29:13**
 - immoral or scandalous marks, **19:77**
 - names and symbols, special legislation protecting, **19:78.50**
 - persons, institutions, beliefs or national symbols, marks that falsely suggest connection with, **19:76**
 - service marks, **19:82**
 - standing to challenge registration, **19:77.75**
 - Supplemental Register, **19:40**

FEDERAL REGISTRATION—Cont'd

- Beliefs, marks that falsely suggest connection with, **19:76**
- Blackout period, intent to use applications, **19:19**
- Bona fide contingent intent to use, **19:17**
- Bona fide intention to use, **19:14 to 19:16**
- Buildings, **7:101**
 - trademark or service mark, **7:101**
- Calendar priority and balancing equities, intent to use applications, **19:30**
- Cancellation petitions, Supplemental Register, **19:41**
- Cancellation Proceedings (this index)
- Certification Marks (this index)
- Classification of goods and services, registration in Principal Register, **19:56**
- Clear error rule, **19:24**
- Coat of arms of United States, state, municipality or foreign nation, marks that comprise, **19:78, 19:79**
- Collective Marks (this index)
- Commerce, use necessary to support registration, **19:83, 19:123, 19:124**
- Common law rights not condition precedent to registration, **19:8**
- Composite marks, disclaimers, **19:66**
- Concurrent cancellations pending in court and trademark board, **30:111**
- Contingent injunctions, intent to use applications, **19:26**
- Corporate, Business and Professional Trade Names (this index)
- Country of origin of foreign applicant, **29:19**
- DATCEL precedent, **19:31**
- Defining goods and services, applications, **19:48, 19:49**
- Definitions, **4:12**
- Dena precedent, **19:66**
- Depletion of word marks, **19:2.50**
- Descriptive Marks (this index)
- Direct association test, **19:81**
- Disclaimers
 - generally, **19:62 to 19:72**
 - amendment does not eliminate disclaimer, **19:70**
 - confusion, likelihood of, **19:72**
 - Dena precedent, **19:66**

INDEX

FEDERAL REGISTRATION—Cont'd

Disclaimers—Cont'd
descriptiveness, concession of, **19:65**
form, **19:71**
ground for a petition to cancel, **19:69**
incontestable registrations, **19:68**
purpose, **19:63**
unitary and composite marks, **19:66**
unregistrable matter, **19:64**
voluntary disclaimers, **19:67**

Disparaging marks, bars to registration, **19:77.25**

Division of
application, **19:57**
registration, **19:57.50**

Documentary evidence, lack of, **19:14**

Drawing of mark in application
material alteration rule, **19:58.50**
standard character and special format
word marks, **19:58**
variance between drawing and speci-
men, amendment to drawing,
19:58.50

Duration of sales, filing Section 8
affidavits, **19:139**

Eligibility for Principal Register, **19:10**

Equality and uniformity of examination
of application under Lanham Act,
19:126.50

Examination of application
generally, **19:125 to 19:132**
abandoned application, petition to
revive, **19:125.50**
ex parte appeal, **19:127**
final rejection, **19:127**
protest letter, **19:130**
response to examining attorney,
19:128
special, petition to make, **19:126**
Trademark Manual of Examining Pro-
cedure, **19:129**
uniformity and equality of examina-
tion under Lanham Act,
19:126.50

Ex parte appeal, **19:127**

Exportation, **19:118**

Extension of time to file statement of
use, intent to use applications,
19:25

Failure to function as a trademark,
19:4.50

FEDERAL REGISTRATION—Cont'd

False claims, **27:66.20**

Fastener Quality Act, registration of
insignias with PTO, **19:149**

Federal court litigation
generally, **30:108 to 30:113.50**
cancellation of registrations, **30:109**
concurrent cancellations pending in
court and trademark board,
30:111

criteria for cancellation by court,
30:112

order to register mark, **30:113**
pending applications, **30:113.50**
sole basis of action, cancellation can-
not be, **30:110**

Final rejection of application, **19:127**

Flag of United States, state, municipality
or foreign nation, **19:78, 19:79,**
29:24

Foreign domiciled applicants, registrant
and parties require U.S.-based
attorney, **19:50**

Foreign nations and nationals
generally, **29:9.25 to 29:24**
bars to registration, **29:13**

country of origin of foreign applicant,
29:19

export or import trade, **29:9.25**

foreign flags, **29:24**

foreign symbols, **29:23**

inter partes challenges to validity of
country of origin registration,
29:16

legal effects of registered marks,
29:20, 29:21

Madrid Protocol (this index)

multiple grounds for application and
registration, **29:15**

notice regarding trademark in nations
other than U.S., **19:146.50**

Patent and Trademark Office, Madrid
Protocol protection. Madrid
Protocol (this index)

predicate foreign registration, rela-
tionship of U.S. registration to,
29:12

priority in U.S. based on priority in
foreign nation, **29:17, 29:18**

registrations issued to foreign nation-
als, **19:73, 19:74**

FEDERAL REGISTRATION—Cont'd

- Foreign nations and nationals—Cont'd
 - unregistrable foreign marks, **29:23, 29:24**
 - use in United States, **29:11**
- Foreign symbols, **29:23**
- Fraud (this index)
- Generic Terms (this index)
- Geographic Terms (this index)
- Immoral marks, bars to registration, **19:77**
- “In commerce,” sale or transportation of goods in, **19:117**
- Incontestable registrations, disclaimers, **19:68**
- Infringement (this index)
- Initial sales, nature of, **19:115**
- Insignias
 - Fastener Quality Act, registration with PTO, **19:149**
 - United States, state, municipality or foreign nation, marks that comprise insignias of, **19:78, 19:79**
- Institutions, marks that falsely suggest connection with, **19:76**
- Intent to use applications
 - generally, **19:12 to 19:31.10**
 - advantages of amendment to allege use, **19:20**
 - amendment to allege use, **19:18 to 19:21**
 - blackout period, **19:19**
 - bona fide
 - contingent intention to use, **19:17**
 - intention to use, **19:14 to 19:16**
 - calendar priority and balancing equities, **19:30**
 - contingent injunctions, **19:26**
 - defendant, applicant as, **19:29, 19:31**
 - extension of time to file statement of use, **19:25**
 - inter partes disputes, **19:31, 19:31.10**
 - more than one mark for same goods or services, **19:15**
 - objective test of bona fide/good faith, **19:14**
 - plaintiff, applicant as, **19:26, 19:31.10**
 - procedure for registration, **19:13**
 - requirements of
 - amendment to allege use, **19:21**

FEDERAL REGISTRATION—Cont'd

- Intent to use applications—Cont'd
 - requirements of—Cont'd
 - statement of use, **19:23**
 - rights of applicant, **19:26 to 19:31.10**
 - second stage examination, statement of use, **19:24**
 - statement of use, **19:22 to 19:25**
 - Supplemental Register, **19:34**
 - use, registration after, **19:28**
- Inter Partes Proceedings (this index)
- Issuance of registration, **19:132**
- Joint ownership of trademarks, **16:41**
- Kind of sale or transportation necessary, **19:111**
- Laches and delay, **31:33 to 31:34**
- Late and defective filings, Section 8 affidavits, **19:137**
- Licenses (this index)
- Likelihood of Confusion (this index)
- Literary, artistic and entertainment rights, **10:38**
- Location of designated mark, **19:104, 19:108.50**
- Madrid Protocol (this index)
- Marketplace, register reflects, **19:2**
- Misuse of notice, **19:146, 19:147**
- Monetary Recovery (this index)
- Multiple classifications, application for goods and services falling in, **19:56.50**
- Mutilation registration of part of trademark, **19:59**
- Names and symbols, special legislation protecting, **19:78.50**
- National symbols, marks that falsely suggest connection with, **19:76**
- Nonuse of mark, Section 8 affidavits, **19:136**
- Notice
 - generally, **19:144 to 19:148**
 - foreign nations (nations other than U.S.), **19:146.50**
 - misuse of notice, **19:146, 19:147**
 - reasonable efforts to prevent misuse of notice, **19:147**
 - “TM” or “Trademark” on labels, use of, author’s comment, **19:148**
 - use of notice, **19:145**
- Objective test of bona fide/good faith, intent to use applications, **19:14**

INDEX

FEDERAL REGISTRATION—Cont'd

- One mark per registration, **19:60.50**
- One-year period of incubation, Supplemental Register, **19:39**
- Paris Convention, **19:74**
- Patent and Trademark Office (this index)
- Personal Names (this index)
- Persons, marks that falsely suggest connection with, **19:76**
- Phantom registrations, **19:61**
- Presumptions (this index)
- Principal Register
 - generally, **19:9 to 19:11, 19:56**
 - multiple classifications, application for goods and services falling in, **19:56.50**
 - Supplemental Register, compared and distinguished, **19:36, 19:42**
- Principal register, defined, **4:12**
- Product and Container Shapes (this index)
- Product different from that intended, use of mark on, **19:122**
- Protest letter, examination of application, **19:130**
- Quantum of use necessary, **19:109 to 19:115**
- Related Goods or Services (this index)
- Remedies. Federal court litigation, above
- Renewal
 - generally, **19:142 to 19:142.75**
 - duration of sales, filing Section 8 affidavits, **19:139**
 - post-1999 procedure, **19:142.25**
 - variance between registered mark and mark as used at time of renewal, **19:142.75**
- Response to examining attorney, **19:128**
- “Sale,” transportation in commerce without, **19:118**
- Scandalous marks, bars to registration, **19:77**
- Search of marks preparatory to application or selection, **19:6**
- Secondary Meaning (this index)
- Second stage examination, statement of use, **19:24**
- Section 8 affidavits
 - generally, **19:135 to 19:138**
 - affidavit of nonuse of mark, **19:136**

FEDERAL REGISTRATION—Cont'd

- Section 8 affidavits—Cont'd
 - duration of sales, renewal of registration, **19:139**
 - late and defective filings, **19:137**
 - post 1999 practice for late and defective filings, **19:137**
 - renewal of registration, **19:139**
 - six years, filing before end of, **19:135**
 - ten years, filing every, **19:135**
 - time to file, **19:135 to 19:138**
 - variance between mark as registered and as used, **19:138**
- Section 15 affidavits, **19:140**
- Service marks, **4:7**
- Service Marks (this index)
- Six years, filing Section 8 affidavit before end of, **19:135**
- Specification of goods and services, applications, **19:48, 19:49**
- Specific designations, legislation prohibiting registration and use, **19:78.50**
- Specimens of mark
 - applications, **19:61.50**
 - variance between drawing and specimen, **19:58.50**
- Standing to challenge registration, **19:77.75**
- State-federal relationship, **19:8**
- Statement of use, intent to use applications, **19:22 to 19:25**
- Status registrations 1881 and 1905 acts, **19:45**
- Supplemental Register
 - generally, **19:32 to 19:43**
 - amendments, Trademark Law Revision Act, **19:35**
 - cancellation petitions, **19:41**
 - challenges, **19:41**
 - cited, later applications, **19:37**
 - designation need only be capable of trademark significance, **19:38**
 - intent to use applications, **19:34**
 - inter partes challenges, **19:41**
 - inter parties cases, **19:37**
 - likelihood of confusion test, strictness, **19:37**
 - nature, **19:33 to 19:37**
 - one-year period of incubation, **19:39**

FEDERAL REGISTRATION—Cont'd

- Supplemental Register—Cont'd
 - Principal Register, compared and distinguished, **19:36, 19:42**
 - 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**

FEDERAL REGISTRATION—Cont'd

- Use necessary to support registration
 - Cont'd
 - legislative history, **19:110**
 - 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**

INDEX

FIFTH AMENDMENT

Summary judgment, **32:121.25**

FILE WRAPPER ESTOPPEL

Generally, **32:111**

FIRST AMENDMENT

Freedom of Speech (this index)

FIRST SALE RULE

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

FLAGS

Federal registration, **19:78, 19:79, 29:24**

FLAVOR MARKS

Generally, **7:107**

Color indicating flavor, **7:52**

FLEA MARKETS

Liability of landlord, **25:20**

FOOD

Cheese, **14:18.50**

Flavor marks, **7:107**

Product disparagement, **27:112.10**

Related goods or services, **24:48**

FOREIGN COURT

Issue preclusion, **32:93**

FOREIGN NATIONS AND NATIONALS

Descriptive marks, foreign equivalents doctrine, **11:34, 11:35**

Federal Registration (this index)

Infringement (this index)

International Ownership (this index)

Inter partes proceedings, **20:114, 20:117.50**

Likelihood of Confusion (this index)

Phenomenon of trademarks, **2:6**

FOREIGN TRADE

Extraterritorial reach of the Lanham Act, **25:58**

FORMAT

Likelihood of confusion, **23:52**

FORUM NON CONVENIENS

Generally, **32:76**

FOUNDATION

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

FRAGRANCE MARKS

Generally, **7:106**

FRAMING

Cyberspace, infringement in, **25A:4**

FRANCHISES

Generally, **18:65 to 18:78**

Agency, tort liability, **18:75**

Code of Ethics, **18:69**

Contributory infringement, **25:21**

Defined, **18:66**

Franchisor/franchisee relations, **18:67**

Investment rules, generally, **18:70**

Negligence, **18:76**

State law controls, **18:68**

Strict liability, **18:78**

Tort liability

generally, **18:74 to 18:78**

agency, **18:75**

negligence, **18:76**

strict liability, **18:78**

warranty, **18:77**

Warranty, tort liability, **18:77**

FRATERNAL GROUPS

Trade names, **9:6**

FRAUD

Generally, **31:59 to 31:89**

Attorney fees, civil liability, **31:87**

Bona fide intention to use and fraud, **31:78**

Burden of proof, **31:68**

Cancellation proceedings, **20:58, 31:80**

Causation, civil liability, **31:86**

Civil liability

generally, **31:85 to 31:89**

attorney fees, **31:87**

causation, **31:86**

false registration, **31:85 to 31:89**

substantive liability, **31:88**

Commercial activities, misrepresentation as to, **27:64.50**

Consumer protection, **2:23**

Damages resulting from false registration under Lanham Act, **31:85 to 31:87**

Deceptive Usage (this index)

Defects in use of mark, **31:72, 31:73**

Descriptive nature of mark, fraud as to the generic or descriptive status or

FRAUD—Cont'd

- functionality of the mark, **31:69**
- Elements, **31:61 to 31:68**
- False advertising, **14:24, 27:1 to 27:121**
- 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 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**

FRAUD—Cont'd

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

INDEX

FREEDOM OF SPEECH—Cont'd

- Literary works, unpermitted use of trademark, **31:149**
- Medium, significance, **31:152**
- New meaning of trademarked words, **31:150**
- Nominative fair use, **31:156.50**
- Parody
 - affirmative defense, **31:153**
 - copyright analogy, **31:156**
 - infringement, **31:154**
 - non-infringement, **31:155**
- Publicity (this index)
- Putting limits Rogers test, Jack Daniel's case, **31:144.20**
- Rogers test
 - procedural aspects, **31:144.70**
 - putting limits, Jack Daniel's case, **31:144.20**
- Significance of medium, **31:152**
- Supreme court constitutional cases on free speech and trademark law, **31:138**
- Trade libel and product disparagement, **27:105 to 27:108**
- Trademark
 - property right, **31:144**
 - third person, owned by, use to convey message, **31:145**
- T-shirts as medium, **31:152**
- Unauthorized communicative uses of trademark, **31:146 to 31:150**

FREEZING ASSETS

- Counterfeiting, preliminary injunctions, **30:40**

FUNCTIONALITY

- Generally, **3:1 to 3:7, 7:63 to 7:93**
- Aesthetic functionality
 - generally, **7:79 to 7:83**
 - defense, **7:82**
 - 1938 Restatement and Pagliero case, **7:79**
 - uneven use in modern courts, **7:80**
 - words that are the product, **7:83**
- Available alternative designs, **7:65**
- Bar of, color secondary meaning, **7:44**
- Burden of proof, utilitarian functionality, **7:72**
- Cancellation proceedings, **20:50, 20:56.50**

FUNCTIONALITY—Cont'd

- Color, **7:44, 7:49, 7:88**
- Competition, **7:65**
- Court definition survey, **7:69**
- De facto secondary meaning for functional features, **7:66**
- Defensive functionality
 - generally, **7:77.50**
 - aesthetic, **7:82**
 - Job's Daughters precedent, **7:82**
- Design patents
 - generally, **6:11, 7:90 to 7:93**
 - dual design patent and trademark protection, **7:91**
 - evidence of non-functionality, **7:93**
 - nature, **7:90**
 - Shredded Wheat case, **7:92**
- Dual design patent and trademark protection, **7:91**
- Evidence, **7:74, 7:75, 7:93**
- Evidentiary weight of utility patent, **7:89.30**
- Fact issue, functionality as, **7:71**
- Fair competition, utilitarian functionality, **7:78**
- Fan loyalty, **7:82**
- Functional use of mark and "defensive" functionality, **7:77.50**
- Illustrative lists, **7:85, 7:86**
- Images, **7:83**
- Incontestable registration, **7:84**
- Instruction to jury, defining functionality, **7:69.50**
- Jury instruction, defining functionality, **7:69.50**
- New meanings for trademarked words, **3:3**
- Norton-Norwich Four Factors analysis, **7:73**
- Packaging materials, **7:87**
- Patent-like rights of exclusion, **7:64**
- Patents, **6:10**
- Pictures, **7:37**
- Policy, **7:63 to 7:65**
- Registration, effect of, **7:84**
- Repeating marks, **7:32**
- Rule against trademark protection, **7:63**
- Shapes and designs
 - de facto secondary meaning, **15:23**
 - trade dress protection, **6:10**
- Trade dress, packaging, **6:10**

FUNCTIONALITY—Cont'd

- Traffix case, **7:89, 7:89.30**
- Two-dimensional functional designs, **7:77**
- Utilitarian functionality
 - generally, **7:67 to 7:78**
 - alternative designs available, **7:75**
 - burden of proof, **7:72**
 - combination of functional and non-functional features, **7:76**
 - defendant's functional use of mark and "defensive" functionality, **7:77.50**
 - "defensive" functionality, **7:77.50**
 - definitions, **7:67 to 7:69.50**
 - evidence, **7:74**
 - fact issue, functionality as, **7:71**
 - fair competition, **7:78**
 - jury instruction, defining functionality, **7:69.50**
 - look to functionality of claimed feature or features, **7:70**
 - promotion touting utilitarian advantages, **7:74**
 - two basic policies, **7:68**
 - two-dimensional functional designs, **7:77**
- Utility patents, **7:89 to 7:89.70**
- Vornado analysis, **7:68**
- Web pages, **3:3**
- Words, new meanings, **3:3, 4:1**
- Words that are the product, aesthetic functionality, **7:83**

GATT

- Generally, **29:36**
- Abandonment of rights, **17:19**
- Geographic terms deceptive usage, **14:22, 14:32, 14:40**

GENERIC TERMS

- Generally, **12:1 to 12:60**
- Abandonment of rights, **17:8**
- Abbreviations, **12:37**
- Absolute bar, **12:22**
- Adjective-noun debate, product attribute, **12:10**
- Appropriation of previously generic term, **12:11**
- Burden of proof, **12:12**
- Buyer understanding test, **12:11**
- Cancellation proceedings, **20:50, 20:56**

GENERIC TERMS—Cont'd

- Class of buyers, meaning to, **12:4**
- Closely related goods or services, **12:24**
- Coined words, **11:9, 12:17.50**
- Color, **7:52**
- Combination of descriptive terms, **11:26**
- "Common descriptive name" changed to "generic name," statutory change, 1989, **12:21**
- Composite marks, **11:28.50, 12:39**
- Consumer surveys, **12:14 to 12:17**
- De facto secondary meaning
 - generally, **12:47 to 12:51, 15:24**
 - evidence of association with generic name, **12:47**
 - generic name to some, trademark to others, **12:51**
 - protection to generic names, **12:48**
 - single source of product, **12:49**
 - unique product or service, **12:50**
- Dictionaries, prevention of generic use in, **12:28**
- Dictionary definitions, **12:13**
- Dilution of trademarks, **24:75**
- Domain name generic and top level combinations, **12:39.50**
- Domestic industries, government protection, **12:32.50**
- Dropping the generic name in common usage, **12:8**
- Enforcing a mark, prevent genericness, **12:29**
- Evidence, **12:12, 12:13**
- False advertising, **12:26, 12:48**
- Federal registration
 - generally, **12:56 to 12:60**
 - Principal Register, **12:58**
 - status of registration, **12:60**
 - statutory provisions, **12:56**
 - Supplemental Register, **12:59**
- Foreign generic terms, **12:44**
 - generally, **12:41 to 12:45**
 - adoption as generic names in American usage, **12:44.50**
 - another English-speaking nation, **12:43**
 - doctrine of foreign equivalents, **12:41**
 - foreign prefixes, **12:42**
 - illustrative examples, **12:45**
 - list of non-english language words held to be generic names in the

INDEX

GENERIC TERMS—Cont'd

- Foreign generic terms, **12:44**—Cont'd
 - United States, **12:45**
 - spelling variants or phonetic equivalents, **12:44**
- Fraud, **31:69, 31:99**
- Game, name of, **12:35**
- Generic name to some, trademark to others, **12:51**
- Generic trade dress, **8:6.50, 12:36.50**
- Genus of products, **12:23**
- Geographic Terms (this index)
- Highly descriptive
 - category, Trademark Board, **12:22**
 - terms, distinguished
 - generally, **12:20 to 12:22**
 - category, Trademark Board, **12:22**
 - “Common descriptive name”
 - changed to “generic name,”
 - statutory change, 1989, **12:21**
 - describing versus naming, **12:20**
 - naming versus describing, **12:20**
- Illustration of product, **12:34**
- Illustrative examples, **12:18, 12:19**
- Ingredients, **12:23**
- Inter partes proceedings, standing, opposition, **20:11**
- Irrelevance of surveys, minority view, **12:17.25**
- Languages, **12:41**
- Likelihood of confusion, **23:49**
- Literary, artistic and entertainment rights, series titles, **10:9**
- Logo registrations, **12:40**
- Majority use controls, **12:6**
- Media, prevention of generic use in, **12:28**
- Media use of evidence, **12:13**
- Misspellings, **12:38**
- Monopolies and restraints of trade, **31:99**
- Multiple generic names for same product, **12:9**
- New products and services, **12:25**
- Non-trademark remedies for misuse, **12:2**
- Nonword symbols, **12:36.50**
- Opposition proceedings, standing, **20:11**
- Part of country, generic in, **12:8.50**

GENERIC TERMS—Cont'd

- Patent, expiration of
 - Supreme Court cases, reconciling, **12:53**
 - trademark does not automatically become generic, **12:52**
- Personal names, **12:33, 12:34**
- Phonetic equivalents, foreign generic terms, **12:44**
- Pictures, **7:37**
- Plant varietal names, **12:36**
- Precautions to prevent generic use
 - generally, **12:26 to 12:29**
 - enforcing a mark, prevent genericness, **12:29**
 - media and dictionaries, prevention of generic use in, **12:28**
 - product and brand, creation of, **12:26**
 - trademark, use of generic name with, **12:27**
- Primary significance test, **12:6, 12:7**
- Principal generic significance, **12:6 to 12:8**
- Principal Register, **12:58**
- Product and brand, creation of, **12:26**
- Product attribute, **12:10**
- Professional buyers, meaning to, **12:5**
- Public policy, **12:2**
- Purchaser motivation test, **12:7**
- Raising generic terms from public domain, **12:30 to 12:32.50**
- Relevant public, **12:5**
- Seats decision and rule, **12:22**
- Secondary meaning
 - de facto secondary meaning, above
- Single source
 - cases, consumer survey, **12:17**
 - product, de facto secondary meaning, **12:49**
- Spelling variations, **12:38**
- Statutory provisions, federal registration, **12:56**
- Steelbuilding decision, **12:39.50**
- Supplemental Register, **12:59, 19:38**
- Survey evidence, **12:14 to 12:17.25, 32:192**
- Surveys, generally, **12:17.50**
- Teflon consumer survey, **12:16**
- Terms held to be a generic name, not a trademark, **12:18**

GENERIC TERMS—Cont'd

- Terms that were challenged as being a generic name, but found not to be generic, **12:19**
- Test for genericness, generally, **12:4 to 12:19**
- Testimony of persons in trade, **12:13**
- Thermos consumer survey, **12:15**
- Timing
 - generally, **12:17.50**
 - critical date for genericness survey, **12:17.75**
 - evidence, **12:13**
- Types of generic use, **12:33 to 12:36.50**
- Unique product or service, de facto secondary meaning, **12:50**
- Use of evidence by competitor and plaintiff, **12:13**
- Who are you - what are you test, **12:2**
- Windows case, **12:30**

GEOGRAPHICALLY REMOTE USE

- Territorial Extent of Rights (this index)

GEOGRAPHIC TERMS

- Generally, **14:1 to 14:40**
- Absolute injunctions, fair use, **14:15**
- Appeal and review, three part test, deceptive usage, **14:32.50**
- Cheese types, **14:18.50**
- Collective marks, regional certification marks and, **14:21**
- Commercially named locations, fair use, **14:16**
- Common law remedies for false advertising of geographic origin, **14:24**
- Composite geographic marks, descriptiveness, **14:11**
- CONTINENTAL, vague geographical indication, **14:6**
- Deceptive usage
 - generally, **14:22 to 14:25, 14:30 to 14:40**
 - appeal and review, three part test, **14:32.50**
 - common law remedies, **14:24**
 - false designation of geographic origin, **14:23**
 - federal registration, generally, **14:30 to 14:39**

GEOGRAPHIC TERMS—Cont'd

- Deceptive usage—Cont'd
 - GATT provisions, **14:22, 14:32, 14:40**
 - material goods-place association test, **14:33**
 - materiality, **14:39**
 - misdescriptive marks, **14:30 to 14:36**
 - multi-step test, **14:34**
 - NAFTA Amendments, **14:31**
 - registration, **14:25**
 - service-place association test, **14:33.50**
 - suggestive names and prestige locations, **14:36**
 - three part test, **14:32.50**
 - wine and liquor, misleading geographic indications of, **14:40**
- Descriptiveness
 - generally, **14:2 to 14:11**
 - composite geographic marks, **14:11**
 - CONTINENTAL, **14:6**
 - earth, locations on, **14:3**
 - earthly origins, indications of, **14:4**
 - illustrative examples, **14:6.50, 14:8**
 - NATIONAL, **14:6**
 - non-descriptive and arbitrary usage, **14:7**
 - non-earthly origins, indications of, **14:5**
 - registered geographic names validity, **14:10**
 - secondary meaning, **14:9**
 - value indications, **14:6**
- Earth, locations on, **14:3**
- Earthly origins, indications of, **14:4**
- Fair use
 - generally, **14:12 to 14:17**
 - absolute injunctions, **14:15**
 - balancing rights of users, **14:13**
 - commercially named locations, **14:16**
 - defense elements geographic, **14:17**
 - defense to indicate geographic location, **14:12**
 - qualified injunctions, **14:14**
- False advertising, **14:24, 27:5, 27:49**
- False designation of geographic origin, **14:23**
- Federal registration
 - generally, **14:26 to 14:40**
 - deceptive usage, **14:30 to 14:39**

INDEX

GEOGRAPHIC TERMS—Cont'd

Federal registration—Cont'd
geographic marks, **14:26**
interpretation of statute, **14:28**
misleading, **14:30**
primarily geographically descriptive marks, **14:27 to 14:29**
test for geographical descriptiveness, **14:29**

GATT provisions, deceptive usage, **14:22, 14:32, 14:40**

Generic designations
generally, **12:33**
geographic descriptive, but not generic, **14:20**
regional certification marks and collective marks, **14:21**
United States Appellations of Origin for Wine, **14:19.50**
wine and liquor, **14:19, 14:19.50**

Generic name
generally, **14:18 to 14:21**
type of product, **14:18**

Geographical indications, **14:1.50**
Geographic descriptive, but not generic, **14:20**

Goods-place association test, deceptive usage, **14:33**

Indications, geographical, **14:1.50**

Injunctions, fair use, **14:14, 14:15**

Liquor. Wine and liquor, below

Lisbon Agreement, **14:1.50**

Material goods-place association test, deceptive usage, **14:33**

Materiality, deceptive usage, **14:39**

Misleading, federal registration, **14:30**

NAFTA Amendments, deceptive usage, **14:31**

NATIONAL, vague geographical indication, **14:6**

Non-earthly origins, indications of, **14:5**

Paris Convention, **14:1.50**

Prestige locations, deceptive usage, **14:36**

Qualified injunctions, fair use, **14:14**

Regional certification marks and collective marks, generic designations, **14:21**

Registration, deceptive usage, **14:25**

Relevant goods test, **14:33**

GEOGRAPHIC TERMS—Cont'd

Secondary meaning, descriptiveness, **14:9**

Service-place association test, deceptive usage, **14:33.50**

Suggestive names, deceptive usage, **14:36**

Swiss Army Knife precedent, **14:23**

Three part test, deceptive usage, appeal and review, **14:32.50**

2003 Le Marais Rule, **14:33.50**

United States compared to E.U., **14:1.50**

United States Appellations of Origin for Wine, generic designations, **14:19.50**

Value indications, descriptiveness, **14:6**

Waltham Watch, key precedent, **14:13**

Wine and liquor

generic designations, **14:19, 14:19.50**

misleading geographic indications, **14:40**

GEOMETRIC SHAPES AND SYMBOLS

Generally, **7:33, 7:34**

GLOBAL REALITY

Generally, **2:6**

GOOD FAITH

Acquisition and priority of rights, bad faith and add-on use, **16:10**

Cyberspace, infringement in (this index)

Failure to conduct trademark search, **23:117.50**

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

Fraud (this index)

Infringement suits, **31:102**

Personal Names (this index)

Territorial Extent of Rights (this index)

Unfair competition, **1:8, 1:11**

GOODS IN TRADE REJECTION

Service marks, sale of incidental goods, **19:87**

GOOD WILL

Generally, **2:15 to 2:21**

Abandonment of rights, **17:14**

Assignments, **18:2**

Buying habits, **2:18**

Continued business, **2:16, 2:17**

GOOD WILL—Cont'd

- Defined, **2:17**
- Methods of valuation, **2:21**
- Symbol of, **3:2**
- Tax valuation, **2:21**
- Valuation of trademark, **2:20**
- Value of business beyond tangible 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 ACT

- Infringement in cyberspace, **25A:86**

HEARINGS

- Contempt, attack on injunction at contempt hearing, **30:18**
- Preliminary injunctions generally, **30:54**

HEARINGS—Cont'd

- Preliminary injunctions—Cont'd
 - 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**

INDEX

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**
- Gray market
 - generally, **29:46**
 - antitrust questions, **29:52**
 - deception and confusion, **29:51**
 - disclosure, **29:47**
 - early attempts to deal with gray market goods, **29:51.25**
 - false representations, **29:53**
 - legal sources for prohibition, **29:48**
 - Lever-Rule, **29:50.50**
 - likelihood of confusion, **29:46**
 - material differences rule, **29:51.75**
 - Tariff Act, **29:49**
 - territoriality principle, **29:51**
 - trademark infringements, “material differences” rule, **29:51.75**
- Identification of foreign manufacturing source or domestic importer of gray goods, **29:51.25**
- Infringements, importation into United States, **29:56**
- International Trade Commission proceedings, **29:55**
- Lanham Act
 - Lever Rule, **29:50.50**
- Legal sources for prohibition, gray market, **29:48**
- Lever-Rule, gray market, **29:50.50**
- Likelihood of confusion, gray market, **29:46**
- Material differences between genuine goods and gray goods, **29:51.75**
- Monopolies and restraints of trade, gray market goods, **29:52**
- Parallel imports of genuine goods, **29:46**
- Recordation of registered mark with U.S. Customs Service, **29:38**
- Recordation of trade names with U.S. Customs, **29:41**
- Seizure, **29:45**

IMPORTED GOODS—Cont’d

- Seizure, infringing or counterfeit mark, **29:37**
- Seizure procedures, **29:42**
- Tariff Act, gray market, **29:49**
- Territoriality principle, gray market, **29:51**

INCIDENTAL GOODS

- Service marks, **19:87**

INCIDENTAL USE

- Publicity, **28:7.50**

INCOME TAXES

- Monetary recovery deductions to arrive at profits, **30:67**

INCONTESTABLE REGISTRATIONS

- Descriptiveness challenge preclusion under Park ‘N Fly, **32:145**
- Status
 - challenge to strength of mark, **32:155**
 - effect of exception, **32:153**
 - equitable defenses, **32:151**
 - exceptions to incontestability, **32:147**
 - foreclosed challenges to validity, **32:148**
 - nine statutory exceptions, **32:149**
 - proof of likelihood of confusion, **32:154**
 - scope of goods, services, and mark format, **32:152**

INCONVENIENCE

- Venue (this index)

INDEMNITY

- Insurance for infringement claims, duty to indemnify, **33:3**
- Monetary recovery, **30:78**

INDIAN TRIBES

- Infringement of official insignia, **25:67.50**

INEQUITABLE CONDUCT

- Pleading fraud in USPTO, **31:84**

INFOMERCIALS

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

INFORMATIONAL WORDS AND SLOGANS

- Generally, **3:5**

INFRINGEMENT

- Generally, **25:1 to 25:67.50**
- Abandonment of rights, failure to prosecute infringers, **17:17**
- Acquiescence (this index)
- Advertising
 - comparative advertising, **25:52**
 - false claim of patent infringement, **27:66.40**
 - Insurance (this index)
 - the sale of goods and services bearing an infringing mark, **25:27**
 - trademarked products, advertising goods to fit or use with, **25:51, 25:51.50**
- Assignments, bankrupt company, **18:64.50**
- Burden of proof, plaintiff, **1:2**
- Certification marks, **19:92.50**
- Changes in Goods and Labels (this index)
- Clipart and logos, collections of, **25:52.50**
- Collections of logos and clipart, **25:52.50**
- Commerce
 - generally, **25:53 to 25:56**
 - definition of interstate commerce, mark in “commerce,” **25:55**
 - Federal Question Jurisdiction (this index)
 - foreign commerce, **25:53**
 - internet, infringing use on, **25:54.50**
 - interstate commerce, **25:53**
 - Lanham Act
 - internet, infringing use on, **25:54.50**
 - local and intrastate infringement, **25:56**
 - must be in “commerce,” **25:54**
 - mark in “commerce,” definition of interstate commerce, **25:55**
- Commercial marks, goods and services, **10:22**
- Comparative advertising, **25:52**
- Computer products, advertising as compatible, **25:51.50**
- Contributory Infringement (this index)
- Copyrights, **6:23, 6:24, 6:27**
- Counterfeiting (this index)
- Counterfeiting compared to, **25:15.50**

INFRINGEMENT—Cont’d

- Cyberspace, Infringement in
- Dealers. Distributors and Dealers (this index)
- Defenses
 - generally, **31:1 to 31:160**
 - Acquiescence (this index)
 - cyberspace, infringement in, **25A:17**
 - delay. Laches and Delay (this index)
 - Fraud (this index)
 - Freedom of Speech (this index)
 - Jus Tertii (this index)
 - Laches and Delay (this index)
 - Monopolies and Restraints of Trade (this index)
 - restraints of trade. Monopolies and Restraints of Trade (this index)
 - Section 43(a) of Lanham Act, **27:19**
 - Unclean Hands (this index)
- Definition of interstate commerce, mark in “commerce,” **25:55**
- Delay. Laches and Delay (this index)
- Design patents, **6:11**
- Dilution of Trademarks (this index)
- Distributors and Dealers (this index)
- Elements of trade dress claim, **7:59, 8:1**
- Extraterritorial reach of the Lanham Act, **25:58**
- Federal CDA immunity, internet service provider
 - state claim, **22:4.50**
 - trademark infringement, **25A:42.50**
- Federally registered marks
 - generally, **25:26 to 25:29**
 - classification of goods and services, **19:56**
 - innocent infringement by printers, publishers, broadcasters and internet providers, **25:29**
 - liability, transport infringing goods, **25:27.50**
 - printers and labelers, **25:28**
 - sales and advertising, **25:26**
 - search engine liability for allowing searches of plaintiff ‘s trademark, **25:28.50**
- Federal Question Jurisdiction (this index)
- Foreign government, infringement by, **25:64**

INDEX

INFRINGEMENT—Cont'd

- Foreign infringement
 - generally, **29:55.25 to 29:60**
 - importation of infringements into United States, **29:56**
 - presumption against U.S. federal law extraterritoriality, **29:55.25**
 - reach of the Lanham Act, activities outside the United States, **29:57**
 - tests used by circuit courts, prior to Abitron decision, **29:59**
- Fraud (this index)
- Freedom of Speech (this index)
- Imported Goods (this index)
- Incorporation as, **9:3, 9:8**
- Indian tribes, infringement of official insignia of, **25:67.50**
- 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)
- Labels, 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 “commerce,” **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**

INFRINGEMENT—Cont'd

- Logos and clipart, collections of, **25:52.50**
- Mark in “commerce,” 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, Use of Mark on (this index)
- Numerical style and grade designations, **7:16**
- Olympic symbols, infringement of, **25:60 to 25:62**
- Palming Off (this index)
- Passing off, different meanings of, **25:1**
- Plaintiff, burden of proof, **1:2**
- Prima facie case, **2:24**
- Printers, federally registered marks, **25:28**
- Related Goods or Services (this index)
- Remedies (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**
- Section 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**
 - 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 trade dress and trade names, claim for infringement of, **27:15**

INFRINGEMENT—Cont'd

- 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**
- United States government, infringement by, **25:63**
- Use in commerce. Commerce, above

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**

INJUNCTIONS—Cont'd

- 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**
- 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

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

INDEX

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**
- Exclusions from coverage of traditional liability policies for infringement claims, **33:12 to 33:17**
- Indemnification duty, **33:3**
- Infringement
 - generally, **25:67**
 - advertising
 - causal nexus, **33:10**
 - misappropriation of advertising ideas, coverage under traditional liability policies, **33:5**
 - claim, guidelines in event of, **33:23**
 - defense of intellectual property, special coverage, **33:20**
 - intellectual property, special coverage for, **33:18 to 33:22**
 - traditional liability policies, coverage for infringement claims
 - generally, **33:1 et seq.**
 - breach of contract exclusion, **33:17**
 - counterfeiting, **33:6**
 - covered offense requirement, **33:4**
 - damages, **33:9**
 - exclusions, **33:12 to 33:17**
 - intellectual property exclusion, **33:14**
 - intentional injuries exclusion, **33:16**
 - key policy language, **33:2**
 - knowledge of falsity exclusion, **33:14.50**

INSURANCE—Cont'd

- Infringement—Cont'd
 - traditional liability policies, coverage for infringement claims—Cont'd
 - misappropriation of advertising ideas or style of doing business, **33:5**
 - offenses covered, **33:4**
 - policy language of exclusions, **33:13**
 - prior publication or prior acts exclusion, **33:15**
 - slogan infringement, **33:7**
 - title infringement, **33:16**
 - trade dress, **33:8**
 - trigger of coverage, **33:11**
 - willful violation of penal statute exclusion, **33:16**
- Intellectual property
 - coverage, **33:18 to 33:22**
 - exclusion, **33:14**
- Intentional injuries exclusion from coverage for infringement claims, **33:16**
- Introduction, **33:1**
- Key insurance policy language, **33:2**
- Knowledge of falsity coverage exclusion of traditional liability policies, infringement claims, **33:14.50**
- Language of policy, coverage of traditional liability policies for infringement claims, **33:2, 33:13**
- Misappropriation of advertising ideas or style of doing business, insurance coverage for, **33:5**
- Prior publication or prior acts coverage exclusion of traditional liability policies for infringement claims, **33:15**
- Purchasing and preserving insurance assets, **33:22, 33:23**
- Slogan infringement, coverage of traditional liability policies for infringement claims, **33:7**
- Title infringement, coverage of traditional liability policies for infringement claims, **33:7**
- Trade dress, coverage of traditional liability policies for infringement claims, **33:8**
- Using insurance assets, **33:22, 33:23**

INTENT

- Abandonment of rights, **17:11**
- Abandonment of rights, old rule, **17:10**
- False advertising, **27:51, 27:58**
- Fraud, bona fide intention to use and fraud, **31:78**
- Infringement, **23:106**
- Insurance for infringement claims, intentional injuries exclusion, **33:16**
- Intent to Use Applications (this index)
- Laches and delay, **31:9**
- Likelihood of Confusion (this index)
- Mens Rea (this index)
- Trade libel and product disparagement, **27:104**

INTENT TO USE APPLICATIONS

- Assignments, **18:13**
- Cancellation proceedings, **20:45**
- Federal Registration (this index)
- 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**

INTERNATIONAL OWNERSHIP

—Cont'd

- Foreign—Cont'd
 - 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**
- 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**

INDEX

INTERNET—Cont'd

- Service marks—Cont'd
 - 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**
- USPTO electronic applications and communications, **19:46**
- 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**
- Analogous use, **20:16**
- Appeals, **20:100, 20:106**
- Attack on validity of registration, **20:22**
- Briefs, **20:103**
- Cancellation, **4:18**
- Cancellation Proceedings (this index)
- Compulsory counterclaims, oppositions, **20:23**
- Concurrent Use Proceedings (this index)
- Conditional judgment for intent to use applicants, **20:27**
- Consenting to judgment, **20:120**
- Continuous use, proof of, **20:29**
- Correcting transcript, **20:118**
- Country of origin registration, challenges to validity of, **29:16**
- Damages, standing, **20:12**
- Declaratory judgments, **32:52**
- Default judgment, **20:130**
- Definitions, **4:18**
- Depositions, **20:101, 20:108**
- Descriptiveness, standing, opposition, **20:11**
- Dilution, **20:20.50, 24:100**
- Disclosure
 - pretrial disclosure, **20:115.50**
 - Trademark Trial and Appeal Board discovery, **20:112**

INTER PARTES PROCEEDINGS

—Cont'd

- Discovery
 - generally, **20:107 to 20:114**
 - depositions, **20:108**
 - foreign nations, discovery in, **20:114**
 - interrogatories, **20:111**
 - notice of reliance on results, **20:126**
 - production of documents, **20:110**
 - remedies for failure to co-operate, **20:113**
 - requests for admissions, **20:109**
 - required disclosure, **20:112**
 - T.T.A.B. discovery, **20:107 to 20:114**
- Disqualification of opposing attorney, motion for, **20:137**
- Earlier registration, laches from failure to object, **20:35.50**
- Equitable defenses
 - generally, **20:31 to 20:39**
 - estoppel, **20:39**
 - exceptions to laches defense, **20:36**
 - laches or acquiescence by failure to object to use of mark, **20:32 to 20:38**
 - opposition, **20:32 to 20:35, 20:39**
 - prior registration defense, **20:38**
- Estoppel, **20:39**
- Evidence and witnesses
 - generally, **20:115 to 20:128**
 - correcting transcript, **20:118**
 - discovery results, notice of reliance on, **20:126**
 - files of applications and registrations, **20:123**
 - filing transcript, **20:118**
 - Internet materials, **20:126.50**
 - issue tried by implied consent, **20:122.50**
 - matters not in evidence, **20:128**
 - notice of taking testimony, **20:116**
 - notices, **20:124 to 20:126**
 - pleading and proof, below pretrial disclosure, **20:115.50**
 - printed publications, notice of reliance on, **20:125**
 - reopening trial period, **20:119**
 - residence of witness outside United States, **20:117.50**
 - taking testimony, **20:115 to 20:119**
 - testimony, **20:115 to 20:119, 20:127**

INTER PARTES PROCEEDINGS

—Cont'd

- Evidence and witnesses—Cont'd
 - Trademark Trial and Appeal Board evidence rules, **20:122**
- Exceptions to laches defense, **20:36**
- Failure to state a claim, dismissal for, **20:133**
- Files of applications and registrations, **20:123**
- Filing
 - opposition, time of, **20:5**
 - transcript, **20:118**
- Foreign nations, discovery in, **20:114**
- Genericness, standing, opposition, **20:11**
- Grounds, generally, **20:13 to 20:21.50**
- Improper grounds for opposition, **20:21.50**
- Intent to use applications, **19:31, 19:31.10**
- Interference Proceedings (this index)
- Internet materials as evidence, **20:126.50**
- Interrogatories, **20:111**
- Jurisdiction and procedure, Trademark Trial and Appeal Board, **20:99**
- Laches
 - failure to object to earlier registration, **20:35.50**
 - failure to object to use of mark, **20:32 to 20:38**
- Lanham Act
 - section 2(a) as grounds, **20:20**
 - section 2(d) as grounds, **20:14 to 20:18**
 - section 2(e) as grounds, **20:19**
 - section 13, opposition, **20:1**
- Likelihood of
 - confusion, **20:14, 20:15, 23:81**
 - damage, standing, **20:7**
- Litigation misconduct, motion for sanctions, **20:136**
- Motions
 - generally, **20:129 to 20:137**
 - amend, **20:135**
 - default judgment, **20:130**
 - disqualification of opposing attorney, **20:137**
 - failure to state a claim, dismissal for, **20:133**

INTER PARTES PROCEEDINGS

—Cont'd

- Motions—Cont'd
 - sanctions, litigation misconduct, **20:136**
 - setting aside judgment, **20:134**
 - strike, motion to, **20:135.50**
 - summary judgment, **20:132**
 - testimony, dismissal for failure to take, **20:131**
 - TTAB motions, generally, **20:129**
- Notice
 - evidence, **20:124 to 20:126**
 - taking testimony, **20:116**
- Official Gazette, search of, **20:4**
- Opposing attorney's disqualification, motion for, **20:137**
- Opposition
 - generally, **20:1 to 20:6**
 - equitable defenses, **20:32 to 20:35, 20:39**
 - grounds, **20:13 to 20:21.50**
 - pleading and proof, **20:22 to 20:30**
 - standing, **20:7 to 20:12**
 - time within which to file, **20:5**
- Oral argument, **20:104**
- Ownership, **20:18, 20:29**
- Pleading and proof
 - generally, **20:22 to 20:30**
 - attack on validity of registration, **20:22**
 - compulsory counterclaims, oppositions, **20:23**
 - conditional judgment for intent to use applicants, **20:27**
 - evidence and witnesses, opposition, **20:6, 20:22 to 20:30**
 - forms, **20:30**
 - issues raised in notice of opposition and in application, **20:24**
 - opposition, **20:3, 20:6, 20:22 to 20:30**
 - ownership and continuous use, proof of, **20:29**
 - prior use, proof of, **20:28**
 - rectifying the register, **20:26**
 - use of mark, **20:28, 20:29**
- Pretrial disclosure, **20:115.50**
- Printed publications, notice of reliance on, **20:125**
- Prior
 - registration defense, **20:38**

INDEX

INTER PARTES PROCEEDINGS

—Cont'd

- Prior—Cont'd
 - use, **20:16, 20:28**
- Priority of use, **20:17**
- Procedure
 - generally, **20:99 to 20:137**
 - opposition, **20:6**
- Production of documents, **20:110**
- Purpose, opposition proceedings, **20:2**
- Rectifying the register, **20:26**
- Reliance notice, **20:124 to 20:126**
- Remedies for failure to co-operate in discovery, **20:113**
- Reopening trial period, **20:119**
- Requests for admissions, **20:109**
- Residence of witness outside United States, **20:117.50**
- Res Judicata and Collateral Estoppel (this index)
- Review, Director of Patents and Trademarks is not party to, **21:24**
- Sanctions, **20:136**
- Secondary meaning, **15:73**
- Setting aside judgment, **20:134**
- Standing
 - damages, **20:12**
 - descriptiveness, opposition, **20:11**
 - entitlement, **20:7**
 - genericness, opposition, **20:11**
 - infringement suit against opposer, **20:12**
 - likelihood of damage, **20:7**
 - opposition, **20:7 to 20:12**
 - trade association cases, **20:8**
- Summary judgment, **20:132**
- Summary of trial procedure, **20:102**
- Supplemental Register, **19:41**
- Time to file opposition, **20:5**
- Trade association cases, standing, **20:8**
- Trademark Trial and Appeal Board
 - depositions, **20:108**
 - disclosure, **20:112**
 - discovery, generally, **20:107 to 20:114**
 - evidence and witnesses, above
 - foreign nations, discovery in, **20:114**
 - interrogatories, **20:111**
 - jurisdiction, **20:99**
 - motions, **20:129**

INTER PARTES PROCEEDINGS

—Cont'd

- Trademark Trial and Appeal Board
 - Cont'd
 - procedure, **20:99**
 - production of documents, **20:110**
 - remedies for failure to co-operate in discovery, **20:113**
 - request for admission, **20:109**
 - required disclosure, **20:112**
- Transcript, correcting and filing, **20:118**
- Trial briefs, **20:103**
- Trial procedure, **20:101 to 20:106**
- Use of mark, **20:28, 20:29**
- Witnesses. Evidence and witnesses, above

INTERPRETATION

- Licenses, **18:43**

INTERROGATORIES

- Inter partes proceedings, T.T.A.B. discovery, **20:111**

INVESTMENT RULES

- Franchises (this index)

IQBAL

- Summary judgment, motion to dismiss, failure to state a claim, **32:121.60**

IRREPARABLE INJURY

- Permanent injunctions, **30:2**
- Preliminary injunctions, **30:46 to 30:49, 31:32**
- Prima facie case, **30:2.50**
- Unfair competition, **1:14**

ISSUE PRECLUSION

- Res Judicata and Collateral Estoppel (this index)

JACK DANIEL'S CASE

- Supreme Court's decision, putting limits on Rogers' test, **31:144.20**

JOINT OWNERSHIP OF TRADEMARKS

- Generally, **16:40 to 16:45**
- Difficulties, **16:40, 16:41**
- Dissolution of entity, **16:42 to 16:45**
- Federal registration, **16:41**
- Performing group, dissolution of, **16:45**
- Typical cases, **16:42**

JOINT TORTFEASORS

Contributory infringement, **25:23**

JUDICIAL ESTOPPEL

Generally, **32:112**

JUDICIAL NOTICE

Secondary meaning, **15:31**

JUDICIAL REVIEW

Appeal and Review (this index)

JURISDICTION

Generally, **32:1 to 32:45.50**

Choice of law, **32:36**

Concurrent jurisdiction in federal and state courts, **32:1**

Court of Appeals for Federal Circuit, **21:13**

Covenant not to sue, federal jurisdiction, **32:2.50**

Declaratory judgments, **32:56 to 32:58**

Diversity jurisdiction. Federal Diversity Jurisdiction (this index)

False Advertising (this index)

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**

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**

JURY TRIAL—Cont'd

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, 31:11**

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**

INDEX

LACHES AND DELAY—Cont'd

- 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**
- Irreparable injury, preliminary injunctions, **31:32**
- Jurisdiction, statute of limitations in & section 43(a) cases, **27:48**
- Knew or should have known standard, notice, **31:38**
- Measurement of delay
 - generally, **31:23 to 31:30**
 - abandonment by infringer, **31:27**
 - examples, **31:28 to 31:30**
 - intermittent periods of infringement, **31:25**
 - non-infringement, periods of, **31:24**
 - statute of limitations and laches, **31:23**
 - tacking, **31:26**
- Monetary recovery, **31:4**
- Notice
 - knew or should have known standard, **31:38**
 - lack of, **31:17**
- Partnerships, imputation of notice, **31:39**
- Patent and Trademark Office proceedings, **31:37**
- Plus factors lead to denial of final injunction, **31:7**
- Prejudice, **31:2, 31:12, 31:13**

LACHES AND DELAY—Cont'd

- Preliminary injunctions, **31:31, 31:32**
- Public interest, balancing of, **31:10, 31:11**
- Reasons for delay
 - generally, **31:14 to 31:21**
 - challenged use, progressive encroachment and other changes in, **31:20**
 - encroachment or escalation of use by defendant, **31:19 to 31:21**
 - notice, lack of, **31:17**
 - other litigation, **31:16**
 - settlement negotiations, **31:15**
 - significant infringement, **31:19**
- Reliance, **31:13**
- Settlement negotiations, **31:15**
- Significant infringement, reasons for delay, **31:19**
- Statute of limitations, **31:33**
- Statute of limitations and laches, **31:23**
- Statutory constructive notice from registration, **31:40**
- Supreme Court precedent, **31:3**
- Tacking, measurement of delay, **31:26**
- Territorial extent of rights, federal registrant as junior user, **26:57**
- Waiver defense, existence of, **31:43**

LANDLORD AND TENANT

- Contributory infringement, **25:20**
- Ownership of trademarks, **16:38**

LANHAM ACT

- See also more specific topics throughout this index
- Generally, **1:18, 1:19, 3:11, 5:4 to 5:11**
- Acquisition and priority of rights, affixation of mark, **16:23**
- Amendments
 - 1947 to 1984, **5:6**
 - 1989 to 2000, **5:10**
 - 2000, since, **5:11**
- Cancellation Proceedings (this index)
- Commerce. Infringement (this index)
- Concurrent jurisdiction in federal and state courts, **32:1**
- Contributory and vicarious liability under Lanham Act section 43(c), **25:21.25, 25:21.75**
- Copyrights, **6:15**
- Defense, senior user, **26:53**
- Definitions, **4:1 et seq.**

LANHAM ACT—Cont'd

- Extraterritorial reach, infringement abroad, **25:58**
- False Advertising (this index)
- False advertising, class action, **27:34**
- False endorsements, **28:15**
- Federal
 - preemption, copyright, **19:126.50**
 - question jurisdiction, **32:11**
 - registration, examination of application, **19:126.50**
- Gray market goods
 - Lever Rule, **29:50.50**
- History, generally, **5:4 to 5:11**
- Interference proceedings, **20:89**
- Inter Partes Proceedings (this index)
- Licenses, **18:49**
- Likelihood of Confusion (this index)
- Movies, **27:89**
- Product and container shapes, **7:59**
- Retailer liability, **27:34.50**
- Search engine liability for allowing searches of plaintiff 's trademark, **25:28.50**
- Sears-Compco cases, **1:18, 1:19**
- Senior user's defense, **26:53**
- State law "federalized," **1:19.50**
- Trade libel and product disparagement, **27:91 to 27:112.10**
- Trademark, **4:1 et seq., 4:3**
- Trademark Clarification Act of 1984, **5:8**
- Trademark Counterfeiting Act of 1984, **5:7**
- Trademark Law Revision Act of 1984, **5:9**
- Trade name, **4:1 et seq., 4:4, 4:5**
- Unfair competition, **1:19, 1:19.50**

LEADING QUESTIONS

- Survey evidence, **32:172**

LEASES

- Landlord and Tenant (this index)

LETTER OF PROTEST

- Generally, **19:130**

LETTERS

- Generally, **7:9 to 7:13**
- As trademarks, **7:9**
- Broadcast station call letters, **7:12**

LETTERS—Cont'd

- Combinations, validity and strength, **7:11**
- Confusingly similar, **23:34, 23:35**
- Consent Letters (this index)
- Descriptive marks, **11:30**
- Likelihood of confusion, **23:33 to 23:35, 23:52**
- Protest letter, **19:130**
- Scope of protection, **7:10**
- Scope of protection of arbitrary letter combinations, **7:10**
- Strength, **7:11**
- Telephone number letter combinations, **7:13**
- Validity, **7:11**

LIBEL

- Trade Libel and Product Disparagement (this index)

LICENSE MERGER RULE

- Generally, **18:47**

LICENSES

- Generally, **3:8, 18:38 to 18:63**
- Abandonment of rights, **17:6**
- Antitrust laws, **18:62**
- Assignments, **18:5, 18:64**
- Benefit of trademark owner, licensee's use inures to, **18:45.50**
- Breach of exclusive license by licensor, **18:44.50**
- Contractual provision for quality control, **18:56**
- Controlled licensee, related company, **18:51**
- Delegation of quality control, **18:60**
- Development of law, **18:39 to 18:41**
- Duration, **18:43**
- Estoppel, **18:63, 32:107**
- Exclusive license, **18:44.50**
- Failure to obtain state, **9:11**
- Federal, foreign and state law compared, **18:54**
- Federally registered marks
 - generally, **18:49 to 18:54**
 - Lanham Act, **18:49**
- Formalities, **18:43**
- Franchising, **18:38, 18:40**
- Holding companies, **18:51**

INDEX

LICENSES—Cont'd

- Implied
 - license, **18:43.50**
 - obligations, **18:44**
- Infringement (this index)
- Interpretation, **18:43**
- Lear v. Adkins, **18:63**
- Legitimate control by licensor, **18:53**
- Market extension licensing, **18:40**
- Merger, **18:47**
- Modern rule, **18:42 to 18:47**
- Monetary Recovery (this index)
- Naked licensing, **18:48**
- Name of licensor, use not required, **18:45**
- Need quality control, **18:61**
- Overly strict control, **18:56**
- Owner of trademark, licensee's use inures to benefit of, **18:45.50**
- Publicity (this index)
- Quality control, **18:40, 18:42, 18:55 to 18:61**
- Related company
 - controlled licensee, **18:51**
 - rule, federally registered marks, **18:49**
- Reliance upon licensee's quality control, **18:57**
- Special relationships, reliance upon licensee's quality control, **18:57**
- Sub-license, **18:43**
- Summary of trademark licensing, **18:38**
- Three part test, quality control, **18:55**
- Trademark license merger rule, **18:47**
- Transfer, **18:43**
- Use
 - licensee inures to benefit of licensor, **18:52**
 - licensees, only by, **18:46**
 - licensor's name not required, **18:45**

LIFE STORIES

- Publicity, rights, **28:20**

LIKELIHOOD OF CONFUSION

- Generally, **23:1 to 23:124**
- Actual confusion
 - generally, **23:12 to 23:18**
 - evidence of likelihood of confusion, **23:13 to 23:18**
 - hearsay, **23:15**

LIKELIHOOD OF CONFUSION

—Cont'd

- Actual confusion—Cont'd
 - lack of evidence of actual confusion, **23:18**
 - necessity, **23:12**
 - questions and inquiries, **23:16**
 - survey evidence, **23:17**
 - weight of the evidence, **23:14**
- Addition of matter, **23:50**
- Affiliation, connection or sponsorship, confusion as to, **23:8**
- Anti-dissection rule, **23:41, 23:42**
- Appeals, questions of law or fact, **23:68 to 23:75**
- Appearance, similarity of, **23:25**
- Balancing public interest, inevitable confusion, **31:10**
- Call to mind is not confusion, **23:9**
- Cease and desist, continued use of mark after, **23:120**
- Circuit courts, survey of, **23:73**
- Color similarity, **7:45.70, 23:52**
- Commercial impression, similarity in marks, **23:21.50**
- Comparing marks, generally, **23:40.50 to 23:60**
- Competitive differences, degree of similarity needed varies with, **23:21**
- Composite marks, **23:41, 23:44, 23:47**
- Concurrent use proceedings, **20:85**
- “Confusingly similar”
 - likelihood of confusion, **23:4**
 - probability of confusion, **23:3**
- Confusion without competition, **24:1**
- Conjoint use rule, **23:61.25**
- Constructive notice, infringement of federally registered marks, **23:109**
- Context, **23:37**
- Copying, **23:121 to 23:123**
- Courtroom, recreation of marketplace in, **23:58, 23:59**
- Customer and potential customer confusion, **23:5 to 23:9**
- Deception, emphasis change, **23:104**
- Degree of buyer care varies with price of goods and services, **23:95**
- Design marks, dominant part of, **23:47**
- Dilution of trademarks, distinguished, **24:72, 24:73**

LIKELIHOOD OF CONFUSION

—Cont'd

- Direct copying, **23:121 to 23:123**
 - copying to compete, **23:122**
- Disclaimers, **19:72, 23:51**
- Discriminating purchaser, **23:95 to 23:99**
- Dominant and subsidiary parts of competitor, consideration of, **23:42**
- Du Pont decision, informed consent to register, **23:86**
- Duty of newcomer to avoid confusion, **23:65**
- Emphasis change from deception to confusion, **23:104**
- Evidence, **23:2.75, 23:62, 23:63, 23:113 to 23:120**
- Expensive goods, purchases of, **23:96, 23:97**
- Expert testimony, **23:2.75**
- Factors leading to confusion, **23:19 to 23:32**
- Fair use
 - descriptiveness of mark, fair use can co-exist with some degree of confusion, **11:47**
 - microcolor, **11:47**
 - non-confusing nominative fair use, **23:11**
- Family of marks rule, **23:61**
- Federal law, test of infringement, **23:1.50**
- Federal registration
 - generally, **23:76 to 23:89**
 - “clothed” consent, **23:88**
 - determinative consents, **23:87**
 - Du Pont decision, informed consent, **23:86**
 - infringement, **23:76, 23:76.50**
 - inter partes proceeding, effect of, **23:81**
 - Lanham Act, refusal of federal registration, **23:77 to 23:83**
 - letters of consent, **23:85 to 23:89**
 - mutual consent agreement, sample, **23:89**
 - “naked” consent, **23:88**
 - refusal of federal registration, **23:77 to 23:84**
 - senior user, doubt resolved in favor of, **23:82**

LIKELIHOOD OF CONFUSION

—Cont'd

- Federal registration—Cont'd
 - service mark, **23:76.50**
 - subsequent litigation, effect of decision in, **23:84**
 - subsidiary of applicant, cited registration owned by, **23:83**
 - thirteen factors, refusal of registration, **23:79**
 - validity of cited registration, challenge on, **23:80**
- Foolish, reasonably prudent purchaser, **23:94**
- Foreign words
 - generally, **23:36 to 23:40**
 - conflicting non-English words, **23:40**
 - context, similarity of meaning in, **23:37**
 - inexact correspondence of meaning, **23:38**
- Format, similarity of, **23:52**
- “Former,” “formerly,” “formerly known as,” use of, **23:54**
- Foundational factors, **23:19**
- Generic element of marks, **23:49**
- Gray market, imported goods, **29:46**
- Hearsay, actual confusion, **23:15**
- House marks, use of, **23:43**
- Imported goods, gray market, **29:46**
- Indifferent, reasonably prudent purchaser, **23:94**
- Inevitable confusion, balancing public interest, **31:10**
- Inference of intent, **23:111, 23:115**
- Infringement
 - generally, **23:1 to 23:11.50**
 - intent, significance, **23:124**
 - mark, federally registered, **23:76**
 - service mark, registered, **23:76.50**
 - use as a “trademark,” **23:11.50**
- Initial interest confusion, **23:6**
- Inquiries, actual confusion, **23:16**
- Intent, **23:106**
 - generally, **23:104 to 23:124**
 - cease and desist, continued use of mark after, **23:120**
 - close similarity, **23:117**
 - constructive notice, infringement of federally registered marks, **23:109**

LIKELIHOOD OF CONFUSION**—Cont'd**

- Intent, **23:106**—Cont'd
 - duty to avoid confusion, **23:118**
 - emphasis change, **23:104**
 - evidence, **23:113 to 23:120**
 - knowledge of plaintiff's mark, adoption with, **23:115 to 23:118**
 - Lanham Act, infringement under, **23:107 to 23:109**
 - legal advice on how close to come, **23:117**
 - presumption or inference, **23:111, 23:115**
 - relevance, **23:110 to 23:112**
 - significance of, **23:124**
 - wrongful intent, **23:104 to 23:106**
- Inter partes proceedings, **20:15, 23:81**
- Judging other people's confusion, **23:90**
- Jury verdict, review of, **23:74**
- Keystone of infringement, **23:1 to 23:11.50**
- Knowledge of plaintiff's mark, adoption with, **23:115 to 23:118**
- Label, addition of, **23:53**
- Lanham Act
 - intent and infringement under Act, generally, **23:107 to 23:109**
 - refusal of federal registration, **23:77 to 23:83**
- Legal advice on how close to come, **23:117**
- Lettering, similarity of, **23:52**
- Letter marks, **23:33 to 23:35**
- Letters of consent, federal registration, **23:85 to 23:89**
- Literary, artistic and entertainment rights, **10:15**
- Meaning, similarity of, **23:26 to 23:30**
- Mens rea, **23:90**
- Methods of proving likelihood of confusion, **23:2.50**
- Newcomer rule, **23:65**
- Nominative fair use, non-confusing, **23:11**
- Non-customer confusion, **23:5 to 23:9**
- Number of buyers confused, **23:2**
- Overall impression, similarity of meaning, **23:26**
- Palming Off (this index)
- Phonetic similarity, **23:22 to 23:24**

LIKELIHOOD OF CONFUSION**—Cont'd**

- Picture-work equivalency, similarity of meaning, **23:27**
- Plural versions of words, **23:46.25**
- Post-sale confusion, **23:7**
- Prefix, similar, **23:55**
- Preliminary injunctions, irreparable injury, **30:47**
- Preponderance of evidence, **23:62**
- Presumptions, **23:111, 23:115, 32:154**
- Probability as synonymous with likelihood, **23:3**
- Professional buyers, **23:100 to 23:103**
- Protection of consumers, **2:1**
- Questions
 - actual confusion, **23:16**
 - law or fact
 - generally, **23:67 to 23:75**
 - appeal, **23:68 to 23:75**
 - fact issue, **23:67**
 - federal appeals, **23:68 to 23:74**
 - jury verdict, review of, **23:74**
 - law issue, **23:67**
 - split of authority, **23:71**
 - state appeals, **23:75**
 - Supreme Court, **23:72**
- Reasonably prudent purchaser
 - generally, **23:91 to 23:103**
 - degree of care of ordinary buyer, **23:95**
 - discriminating purchaser, **23:95 to 23:99**
 - expensive goods, purchases of, **23:96, 23:97**
 - hurried, **23:93**
 - inattentive, **23:93**
 - indifferent or foolish, **23:94**
 - judicial attempts at defining characteristics, **23:92**
 - non-expensive goods, discriminating purchaser, **23:99**
 - professional buyers, **23:100 to 23:103**
 - special buyer classes, **23:98**
- Refusal of federal registration, **23:77 to 23:84**
- Related goods or services, **24:1 to 24:3, 24:6, 24:7**
- Relevance, intent, **23:110 to 23:112**
- Reversal of parts of mark, **23:46**
- Reverse confusion, **23:10**

LIKELIHOOD OF CONFUSION

—Cont'd

- Rule of doubt, resolution in favor of senior use, **23:64**
- Scope of protection for stronger marks, **23:40.50**
- Secondary meaning, **15:11, 15:25**
- Senior user, resolution in favor of, **23:64, 23:65, 23:82**
- Service mark, **23:76.50**
- Significance of intent, **23:124**
- Similarity, confusing, **23:20, 23:20.50, 23:21.50**
- Singular versions of words, **23:46.25**
- Split of authority, questions of law or fact, **23:71**
- State law, test of infringement, **23:1.50**
- State of mind, **23:90**
- Stronger marks, **23:40.50**
- Subsequent litigation, effect of decision in, **23:84**
- Subsidiary of applicant, cited registration owned by, **23:83**
- Suffix, similar, **23:56**
- Summary judgment, **32:120, 32:121**
- Supplemental Register, when cited, **19:37**
- Supreme Court, questions of law or fact, **23:72**
- Survey
 - circuit courts, **23:73**
 - Eveready Format, **32:174**
 - evidence, **23:17, 32:174, 32:174.50, 32:184 to 32:189**
 - Squirt Format, **32:174.50**
- Territorial extent of rights, **26:33**
- Test of infringement, state and federal law, **23:1.50**
- The Dawn Donut Rule, **26:33**
- Trade Dress (this index)
- Unfair competition, **2:7**
- Use, infringing use as a “trademark,” **23:11.50**
- Validity of cited registration, challenge on, **23:80**
- Validity of trademark, expert testimony, **23:2.75**
- Weak element of marks, **23:48**
- Word marks, dominant part of, **23:45**
- Wrongful intent, **23:104 to 23:106**

LIMITATION OF ACTIONS

- Statutes of Limitation (this index)

LIMITATION OF DAMAGES

- Punitive damages., constitutional limits, **30:96.50**

LIMITED AREA DEFENSE

- Territorial Extent of Rights (this index)

LIMITS ON ROGERS TEST

- Jack Daniel’s case, free speech defense, **31:144.20**

LINKING

- Cyberspace, infringement in, **25A:4**

LIQUOR

- Geographic Terms (this index)

LISBON AGREEMENT

- Generally, **29:28**

LITERARY, ARTISTIC AND ENTERTAINMENT RIGHTS

- 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**
 - unfair competition, **10:42**
- Coincidental use of personal name in fictional works, **27:87**
- Commercially valuable data misappropriation, **10:57**

INDEX

LITERARY, ARTISTIC AND ENTERTAINMENT RIGHTS

—Cont'd

- Commercial marks, goods and services generally, **10:18 to 10:23**
 - art works, use of commercial marks in, **10:23**
 - character names, **10:20**
 - entertainment free speech, **31:149**
 - expressive works, **10:22, 31:149**
 - false endorsement, **10:22**
 - infringement, **10:22**
 - media, commercial marks used in, generally, **10:22, 10:23**
- Media and magazine titles without permission on, **10:19**
- media titles used on commercial goods and services, **10:18 to 10:20**
- movies, **10:22**
- negative connotations, **10:22**
- parodies, **10:22**
- radio, television, and movie titles and character names, **10:20**
- Rock and Roll Hall of Fame, **10:23**
- Rogers test, **10:22**
- sponsorship and affiliation, confusion of, **10:18**
- television, **10:22**
- Tiger Woods painting, **10:23**
- video games, **10:22**
- Cooper precedent, **10:4**
- Copyright law, **10:34, 10:41, 10:44**
- Cover illustrations, **10:4**
- Dastar, 2003 Supreme Court decision in, **6:27, 27:78, 27:78.30**
- Deceased person, use of name of, **10:26**
- Descriptive series titles, **10:6, 10:7.10**
- Design patents, **6:11**
- Exclusive rights in titles, **10:1**
- Expressive media other than titles and characters, **10:42.50**
- Expressive works, commercial marks used in, **10:22, 31:149**
- Fair use, **10:14**
- False
 - advertising
 - generally, **27:77 to 27:90**
 - coincidental use of personal name in fictional works, **27:87**

LITERARY, ARTISTIC AND ENTERTAINMENT RIGHTS

—Cont'd

- False—Cont'd
 - advertising—Cont'd
 - copyright, false use of name on work that infringes, **27:81 to 27:83**
 - copyright notice, false matter in, **27:79**
 - Dastar, 2003 Supreme Court decision in, **6:27, 27:78, 27:78.30**
 - false endorsement, **27:88**
 - imitator's claim of being creator of work, **27:81**
 - motion pictures and television programs, distinctive features of, **27:89**
 - name, unauthorized use, **27:83**
 - name of artist, author, or performer, false use of, **27:85**
 - over-representation of artist's, author's or performer's contribution or currency of performance, **27:84**
 - personal name, use in title or content of another's work, **27:86**
 - unauthorized editing of creative work, **27:83**
 - unauthorized use of copyrighted work, **27:82**
- endorsement, **27:88**
- representation of being creator of idea or invention, **27:78**
- use of name of artist, author, or performer
 - generally, **27:85**
 - another's use of work, **10:30**
- Federal
 - preemption, **10:35, 10:46**
 - protection, **10:38 to 10:40**
 - registration, **10:38**
- Freedom of speech, unpermitted use in expressive works, **31:149**
- Generic series titles, **10:9**
- House marks, **10:15**
- Insurance coverage for intellectual property, **33:18 to 33:22**
- Likelihood of confusion, **10:15**

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

- 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, **10:4.10**
 - registration of titles, USPTO, **10:4**
 - secondary meaning required, **10:2**
 - USPTO register, **10:4**
- Media, generally. Commercial marks, goods and services, above
- Misappropriation
 - generally, **10:47 to 10:57**
 - commercially valuable data, **10:57**
 - creation of doctrine, **10:48**
 - history of doctrine, **10:51**
 - limitations on doctrine, **10:55**
 - preemption provisions, **10:52 to 10:54**
 - prima facie case, **10:49**
 - sporting events, **10:56**
 - trademark, generally, **10:50**
- Mockbusters, **10:12**
- Movies
 - books, based on, **10:12**
 - commercial goods and services, **10:20, 10:22**
 - entertainment free speech, use of commercial mark, **31:149**
 - Lanham Act section 43(a), **27:89**
- Music as trademark, **6:17.50**
- Name of artist, author, or performer
 - editing, unauthorized use, **27:83**
 - false use of
 - generally, **27:85**
 - another's use of work, **10:30**
 - use on a work, **10:30**
- Names of characters
 - commercial goods and services, **10:20**

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

- Names of characters—Cont'd
 - personal names, below
- 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**
 - biography of author, **10:44**
 - deceased person, use of name of, **10:26**
 - false representation of being creator of idea or invention, **27:78**
 - public domain work, use of name of author of, **10:26**
 - title or content of work, use in, **27:86**
 - truthful and false use of name on work, **10:26 to 10:30**
 - use of names in connection with works, **10:26 to 10:30**
 - Visual Artist's Rights Act, **10:29**
- Pictures, single source, identifying, **3:8**
- Pre-release publicity and recognition, **10:12**
- Priority rights, **10:4**
- Protection from one medium to another, **10:17**
- Public domain work, use of name of author of, **10:26**
- Radio titles, **10:20**
- Rock and Roll Hall of Fame, **10:23**
- Sears-Compco defense, **10:35**
- Secondary meaning
 - generally, **10:10 to 10:14, 15:21**
 - fair use, **10:14**
 - identification of single source, **10:10**
 - pre-release publicity and recognition, **10:12**
 - relevant evidence, **10:13**
 - series of literary works, **10:7**

INDEX

LITERARY, ARTISTIC AND ENTERTAINMENT RIGHTS

—Cont'd

- Secondary meaning—Cont'd
 - single literary works, **10:2**
 - tests of secondary meaning, **10:10**
- Song titles, **10:15**
- Sponsorship, confusion of, **10:18**
- 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 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**
- 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 topic

MADRID PROTOCOL—Cont'd
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**
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 “commerce,” **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**

INDEX

MONETARY RECOVERY—Cont'd

- 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)
- Federal law
 - generally, **30:88 to 30:95**
 - Attorney Fees (this index)
 - compensation and not penalty, **30:91**
 - counterfeiting, **30:94, 30:95**
 - grounds for recovery, **30:89**
 - judicial power to adjust award, **30:90**
 - power to increase or adjust profits, **30:90 to 30:92**
 - prejudgment interest, **30:93**
 - punitive damages, **30:97**
 - special anti-counterfeiting remedies, **30:94**
- Franchisees, reasonable royalty, **30:86**
- Fraud, false registration, **31:85 to 31:87**
- Holdover licensees and franchisees, reasonable royalty, **30:86**
- Income taxes, deductions to arrive at profits, **30:67**
- Indemnity, **30:78**
- Insurance, coverage of traditional liability policies for infringement claims, **33:9**
- Intentional infringement, **30:75**
- Inter partes proceedings, standing, **20:12**
- Laches and delay, **31:4**
- Licensees
 - 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**

MONETARY RECOVERY—Cont'd

- Measure of damages—Cont'd
 - 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**
 - computation of profits from infringing sales, **30:65 to 30:71**
 - costs, deductions to arrive at profits, **30:68**
 - damages, recovery of, **30:79**
 - damages and profits, recovery of, **30:73**
 - deductions from gross sales to arrive at profits, **30:66 to 30:69**
 - equities, weighing, **30:61**
 - income taxes, deductions to arrive at profits, **30:67**
 - non-competitive relationships, **30:64**
 - referral of accounting to master or magistrate, **30:71**
 - weighing the equities, **30:61**
 - willful infringement, **30:62**
- Punitive damages, **30:96, 30:96.50, 30:97**
- Referral of accounting to master or magistrate, **30:71**
- Registration, fraud in obtaining, **31:85 to 31:87**
- Royalties, **30:85 to 30:87**
- Theory, **30:58**
- Tie-ins, franchisees, **31:132 to 31:134**
- Weighing the equities, recovery of profits, **30:61**
- Willful infringement, **30:62, 30:75**

MONOPOLIES AND RESTRAINTS 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**

**MONOPOLIES AND RESTRAINTS
OF TRADE—Cont'd**

Aggressive use or enforcement of trademarks—Cont'd
 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 courts and administrative tribunals, **31:105**
 Damages to franchisees, tie-ins, **31:132 to 31:134**
 Distribution of trademarked goods, restrictions on, **31:113, 31:114**
 Distribution or business format franchise, tie-ins, **31:129**
 Exclusive dealing restrictions, **31:135, 31:136**
 First Amendment defense under Noerr-Pennington, **31:104, 31:105**
 Franchise tie-ins, **31:128**
 Fraudulently obtained registration
 generally, **31:95 to 31:99**
 economic market, trademark does not define, **31:97**
 generic names, **31:99**
 incremental exclusionary effect of registration, **31:98**
 patent and trademark differences, **31:96**
 Free access to courts and administrative tribunals, constitutional right, **31:105**
 Free competition and fair competition, **1:20 to 1:22**
 Generic terms, **31:99**
 Health justification, vertical restrictions, **31:118**
 Historical fear of, **1:4**
 Image restrictions, **31:137**
 Imported goods, gray market, **29:52**
 Incontestable registrations, **31:92**
 Licenses, **18:62**

**MONOPOLIES AND RESTRAINTS
OF TRADE—Cont'd**

Monopolization, generally, **31:93 to 31:107**
 Non-approved products, bans on sale by licensee, **31:136**
 Non-price vertical restrictions, **31:116**
 Offset theory, damages to franchisees, **31:133**
 Over-aggressive enforcement of trademarks, **31:101**
 Over-lax enforcement of trademarks, **31:101**
 Parallel imports restrictions, **31:120**
 Patent-trademark tying, **31:131**
 Political power, **1:5**
 Product quality restrictions, **31:119**
 Quality control, tie-ins, **31:125**
 Relationship between antitrust law and trademark and unfair competition law, **31:90.50**
 Requirements of monopolization and attempts to monopolize, **31:94**
 Resale price control, **31:115**
 Restraints of trade, generally, **31:108 to 31:138**
 Safety justification, vertical restrictions, **31:118**
 Sham exception to Noerr-Pennington First Amendment defense, **31:105**
 Soft-drink bottlers act, vertical restrictions, **31:122**
 Standing to sue, restrictions on distribution of trademarked goods, **31:114**
 Tie-ins
 generally, **31:123 to 31:134**
 damages to franchisees, **31:132 to 31:134**
 defining two separate items, **31:126 to 31:131**
 distribution or business format franchise, **31:129**
 franchise tie-ins, **31:128**
 offset theory, damages to franchisees, **31:133**
 patent-trademark tying, **31:131**
 quality control, **31:125**
 sufficient economic power to impose, **31:124**
 test of separateness, **31:127**
 Trademark law, **31:90.50**

INDEX

MONOPOLIES AND RESTRAINTS OF TRADE—Cont'd

- Unclean hands, **31:91**
- Unfair Competition (this index)
- Vertical restrictions
 - generally, **31:116 to 31:122**
 - health and safety justification, **31:118**
 - non-price, **31:116**
 - non-sale trademark licenses, restrictions in, **31:121**
 - parallel imports restrictions, **31:120**
 - product quality restrictions, **31:119**
 - rule of reason, **31:117 to 31:121**
 - soft-drink bottlers act, exemption, **31:122**
 - Supreme Court's trilogy, **31:116**

MOOTNESS

- Injunctions, **30:11**

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 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 MARKS—Cont'd

- 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

- Registration of part of trademark, **19:59**

NAFTA

- Geographic terms deceptive usage, **14:31**

NAKED LICENSING

- Generally, **18:48**

NAMES

- Federal registration, **19:78.50**
- 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**

NOTICE AND KNOWLEDGE—Cont'd

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**

INDEX

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**

Foreign disputes, manufacturers and 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, **16:37**

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, **25:7**

reverse passing off, **25:8**

Intentional substitution, **25:3**

Likelihood of confusion, hyperbole for, **25:2**

Passing off

different meanings of, **25:1**

express, **25:5**

implied, **25:7**

PALMING OFF—Cont'd

Passing off—Cont'd

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**

PARALLEL IMPORTS

Imported Goods (this index)

Restraints of trade, **31:120**

PARENT AND SUBSIDIARY CORPORATIONS

Ownership of trademarks, **16:37**

PARIS CONVENTION

Generally, **29:25, 29:62**

Famous marks, **4:16**

Federal registration, **19:74**

PARK'N FLY CASE

Applications of bar on descriptiveness challenges, **32:146**

Bar on descriptiveness challenges, **32:145**

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

Laches and delay, imputation of notice, **31:39**

PASSING OFF

Different meanings of, **25:1**

Express, **25:5**

Implied, **25:7**

Reverse

express, **25:6**

implied, **25:8**

PATENT AND TRADEMARK OFFICE

Generally, **6:9**

PATENT AND TRADEMARK OFFICE

—Cont'd

- Concurrent use proceedings, **20:81 to 20:88**
- Director of Patents and Trademarks (this index)
- Electronic applications and communications, **19:46**
- 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)
- Survey evidence, **32:180**

PATENTS

- Generally, **6:1 to 6:12**
- “Back door” patents, trade dress, **8:5**
- Chart, **6:6**
- Common denominators, **6:4**
- Confusion in the legal world, **6:1**
- Constitutional basis, **6:2**
- Court of Appeals for Federal Circuit, **21:11**
- 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**

INDEX

PERSONAL NAMES—Cont'd

- 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**
- Federal Anti-cybersquatting Act, **25A:79 to 25A:83**
- Federal registration
 - generally, **13:27 to 13:39**
 - burden of proof, **13:33**
 - composite surname marks, **13:31**
 - consent, marks which comprise name, portrait or signature of living individual without, **13:37 to 13:39**
 - courtesy prefixes and suffixes to surnames, **13:32**
 - false suggestion of connection with persons living or dead, **13:35**
 - first amendment limitations, **13:37.50**
 - illustrative examples, **13:30.50**
 - incontestable surname registration, effect of, **13:36**
 - names of performers and sportspersons, **13:34**
 - primarily merely a surname, **13:29, 13:30**
 - professional prefixes and suffixes to surnames, **13:32**
 - publicity, right of, **13:39**
 - tests for determining whether term is primarily merely a surname, **13:30**

PERSONAL NAMES—Cont'd

- Findlay Brothers, **13:8**
- Freedom to use one's own name
 - generally, **13:6 to 13:13**
 - archaic right, **13:7**
 - bad faith use, **13:15**
 - business mark, absolute prohibition against use of own name as, **13:12**
 - classic fair use defense, **13:13**
 - limited injunctions against use of own name, **13:9**
 - modifications of one's personal name, **13:19**
 - modifications ordered to prevent confusion, **13:11**
 - qualified right, **13:8**
 - "sacred" right, **13:7**
 - sale of rights in name, use following, **13:10**
- Generic terms, **12:33, 13:24**
- Given names, abbreviations and nicknames, **13:20**
- Historical names, **13:25**
- Incontestable surname registration, effect of, **13:36**
- Limited injunctions against use of own name, **13:9**
- Literary, Artistic and Entertainment Rights (this index)
- Modifications of one's personal name, **13:19**
- Modifications ordered to prevent confusion, freedom to use one's own name, **13:11**
- Nicknames, **13:20**
- No one in defendant's organization with name in issue, **13:14**
- Professional prefixes and suffixes to surnames, federal registration, **13:32**
- Publicity, right of, **13:39**
- Qualified right to use one's own name, **13:8**
- "Sacred" right to use one's own name, **13:7, 13:8**
- Sale of rights in own name, use after, **13:10**
- Secondary meaning
 - generally, **13:2 to 13:5**
 - identification of source, **13:4**

PERSONAL NAMES—Cont'd

- Secondary meaning—Cont'd
- rationales, **13:3**
- requirement, **13:2**
- Tarantino's Restaurant, **13:8**
- Telephone directories, **13:30**
- Video games, **27:86**

PERSONAL SERVICE

- Personal jurisdiction, **32:38**

PETITIONS

- Cancellation proceedings, standing, **20:46, 20:49**
- Director of Patents and Trademarks, **21:5 to 21:7**

PHANTOM REGISTRATIONS

- Generally, **19:61**

PHISHING

- Generally, **25A:2**

PHONETIC SIMILARITY

- Generic terms, foreign, **12:44**
- Likelihood of confusion, **23:22 to 23:24**

PICTURES

- Commercial use, **6:18**
- Copyrights, **6:18**
- 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)
- Existence of secondary meaning, **32:202**
- Fraud, **31:84**
- Infringement and false advertising, **32:201**
- 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**

INDEX

PRELIMINARY INJUNCTIONS

—Cont'd

- 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

- Pharmaceuticals (this index)

PRESUMPTIONS

- Generally, **32:134 to 32:157**
- Abandonment of rights, presumption after three years, **17:18**
- Abandonment of rights, presumption after three years, burden to rebut, **17:21**
- Contestable registrations
 - generally, **32:134 to 32:139**
 - elements presumed, **32:136**
 - goods and format, **32:137**
 - mark may be challenged on any ground, **32:139**
 - prima facie evidentiary status, **32:134 to 32:139**
 - scope of presumption, **32:136, 32:137**
 - strength of presumption, **32:138**
 - Trademark Law Revision Act, **32:135**
- Equitable defenses, **32:150, 32:151**

PRESUMPTIONS—Cont'd

- Foreclosed challenges to validity, **32:148**
 - Format, contestable registrations, **32:137**
 - Goods, contestable registrations, **32:137**
 - Incontestable registrations
 - generally, **32:140 to 32:157**
 - defenses to incontestability, effect of, **32:157**
 - descriptiveness challenge preclusion under Park 'N Fly applications, **32:146**
 - equitable defenses, **32:150, 32:151**
 - exceptions to incontestability, **32:147 to 32:153**
 - likelihood of confusion, **32:154**
 - list of nine exceptions to incontestability, **32:149**
 - proof of exception, effect of, **32:153**
 - quieting title of mark, **32:142**
 - scope of presumption as to goods and format, **32:152**
 - status of incontestability, **32:141, 32:142**
 - strength of mark, challenge to, **32:155**
 - “swiss cheese” rule, **32:147**
 - Third Circuit, **32:156**
 - Trademark Law Revision Act, **32:140**
 - validity of mark, **32:142**
 - Likelihood of confusion
 - generally, **23:115, 32:154**
 - intent to confuse, **23:111**
 - Prima facie evidentiary status, **32:134 to 32:139**
 - Quieting title of mark, **32:142**
 - Scope of presumption, **32:136, 32:137, 32:152**
 - Strength of
 - mark, challenge to, **32:155**
 - presumption, **32:138**
 - Trademark Law Revision Act, **32:135, 32:140**
 - Validity
 - foreclosed challenges to, **32:148**
 - registration, **32:134 to 32:157**
- ### PRETRIAL DISCLOSURE
- Inter partes proceedings, **20:115.50**
- ### PRICE LISTS
- Copyright in, **6:30**

PRIMA FACIE CASE

Consumer protection, **2:24**

PRIMA FACIE EVIDENCE

False advertising, **27:24**
 Misappropriation, **10:49**
 Presumptions, **32:134 to 32:139**
 Publicity, **28:7**

**PRIMARILY GEOGRAPHICALLY
 DESCRIPTIVE MARKS**

Federal registration, **14:27 to 14:29**

PRINCIPAL REGISTER

Definition, **4:12**
 Federal Registration (this index)
 Generic terms, **12:58**
 Product and container shapes, **7:94**

PRIORITY OF RIGHTS

Acquisition and Priority of Rights (this index)

PRIVACY

Publicity, **28:3, 28:5, 28:6**
 Survey evidence, respondents, **32:183**

PRIVILEGE

Exempt, trade libel and product 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**

PRODUCT AND CONTAINER

SHAPES—Cont'd

Registration—Cont'd
 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**

INDEX

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 ser-
vices, **10:22**

Freedom of speech and press

generally, **28:18 to 28:21**

advertising protected works, **28:21**

balancing free speech and right of
publicity, **28:19**

balancing methods, **28:19**

commercial speech, **28:18**

defense to false endorsements, **28:16**

entertainment speech, **28:18**

football players, college, **28:19**

life story rights, **28:20**

past issues, media, **28:21**

Predominant Use Test, minority rule,
28:19

Rogers Test, **28:19**

Transformative Test, majority rule,
28:19

video games, **28:19**

Incidental use, **28:7.50**

Lanham Act, false endorsements, **28:15**

Licenses. Assignments and licenses,
above

PUBLICITY—Cont'd

Life story rights, **28:20**

Noncelebrity false endorsements, **28:17**

Origin of right, **28:3 to 28:5**

Personal names, **13:39, 28:17**

Predominant Use Test, minority rule,
28:19

Preliminary injunctions, **28:15**

Pre-release, **10:12**

Prima facie case, **28:7**

Prior exploitation, **28:11**

Privacy, right of, **28:2, 28:3, 28:5, 28:6**

Rogers Test, **28:16, 28:19**

Secondary meaning, **15:57**

Sources of right, **28:3 to 28:5**

State law, **28:2**

Test of infringement, **28:12**

Transfer rules, **28:13**

Transformative Test, **28:19**

PUERTO RICO

Generally, **22:10**

PUFFING

Descriptive marks, **11:17**

Examples, **27:38.50**

False advertising, **27:38**

PUNITIVE DAMAGES

Constitutional limits, **30:96.50**

Monetary recovery, **30:96, 30:96.50,**
30:97

QUALIFICATION OR DISQUALIFICATION

Inter partes proceedings, motion for
opposing attorney's disqualifica-
tion, **20:137**

QUALITY

Generally, **3:11**

Encouragement of quality, **2:4**

Licenses, **18:55 to 18:61**

Related goods or services, **24:15**

Source

control, **3:11**

theory, supplements, **3:11**

QUESTIONS OF LAW OR FACT

Likelihood of Confusion (this index)

QUIETING TITLE

Presumptions, **32:142**

REASONABLY INFORMED BUYER

Descriptive marks, **11:21**

REASONABLY PRUDENT PURCHASER

Likelihood of Confusion (this index)

RECALL OF PRODUCTS

Injunctions, **30:8**

REFUNDS

Injunctions, **30:8**

REGISTRATION

Generally. Federal Registration (this index)

Foreign courts, **29:5**

Foreign governments, **29:5**

Incontestable registration status, strength of marks, **11:84**

International aspects of trademark law, **29:5**

Priority, **16:1.50, 16:18**

Territorial extent of rights, **26:52.50**

REJECTION

Final rejection and ex parte appeal, **19:127**

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**

RELATED GOODS OR SERVICES

—Cont’d

Conflict between goods and services, **24:25**

Confusion without competition, **24:1**

Criticism of expanded merchandising rights, **24:12**

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**

Fourth Circuit, factors used by, **24:34**

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

History of infringement on noncompetitive goods, **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**

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**

INDEX

RELATED GOODS OR SERVICES

—Cont'd

- 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, 24:64**
- 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**
- 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**

RELIGIOUS ORGANIZATIONS

—Cont'd

- 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**
- 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 Trial 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**

Inter partes T.T.A.B. decisions

generally, **32:96 to 32:104**

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

customer differences, **32:101**

effect on later inter partes case, **32:104**

goods and services differences, **32:101**

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

marks differences, **32:102**

sameness of issues, **32:100**

Supreme Court precedent, **32:97, 32:98**

Trademark Trial and Appeal Board, generally, **32:96 to 32:104**

validity, **32:99**

Issue preclusion

generally, **32:83 to 32:88**

changes in the facts, **32:88**

court litigation, **32:96 to 32:102**

RES JUDICATA AND COLLATERAL ESTOPPEL—Cont'd

Issue preclusion—Cont'd

customer differences, **32:101**

elements required, **32:84**

goods and services differences, **32:101**

inconsistent prior decisions, **32:86**

inter partes decisions, T.T.A.B., **32:96 to 32:102**

litigated factual issues, **32:83**

marks differences, **32:102**

opportunity to litigate, **32:85**

sameness of issues, **32:100**

summary judgment, motion for, **32:87**

Supreme Court precedent, **32:97, 32:98**

Trademark Trial and Appeal Board, **32:94**

validity, **32:99**

waiver of defense, **32:87**

Litigated factual issues, **32:83**

Litigation opportunity, **32:85**

Marks differences, **32:102**

Merger and bar, **32:80**

Non-essential issues, **32:90**

Opportunity to litigate, **32:85**

Patent and Trademark Office, generally, **32:94 to 32:104**

Preliminary injunctions and equitable decrees, **32:92**

Sameness of issues, **32:100**

Secondary meaning, **15:29**

Splitting of cause of action, **32:80**

State-federal preclusion, **32:91**

Summary judgment, **32:87**

Supreme Court precedent, **32:97, 32:98**

Trademark board claim preclusion, **32:82**

Two lawsuits, **32:81**

Validity, issue preclusion, **32:99**

Waiver of defense, **32:87**

Weight given in courts, ex parte Patent and Trademark Office decisions, **32:95**

RESTATEMENTS

Generally, **1:17**

RESTRAINTS OF TRADE

Monopolies and Restraints of Trade (this index)

INDEX

RETAILERS

- Liability, false advertising, **27:34.50**
- Marks of, **16:46, 16:47**

RETROACTIVITY

- Dilution of trademarks, **24:131**
- False advertising, amendments to section 43(a), **27:10**

REVERSAL OF PARTS

- Likelihood of confusion, **23:46**

REVERSE CONFUSION

- Generally, **23:10**

REVERSE DOMAIN NAME HIJACKING

- Cyberspace, infringement in, **25A:38**

REVIEW

- Appeal and Review (this index)

ROCK AND ROLL HALL OF FAME

- Commercial marks, goods and services, **10:23**

ROGERS TEST

- Commercial marks, goods and services, **10:22**
- 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 Daniel's 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's 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**
 - 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**

SECONDARY MEANING—Cont'd

- 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**
- Employees of trademark owner, testimony of, **15:40**
- Evidence, generally, **15:1, 15:28 to 15:73**
- Evidence of acquired distinctiveness, **15:66**
- Evidence of extensive advertising and sales using the designation, **15:49**
- Fact question, **15:29**
- Federal registration
 - generally, **15:59 to 15:82**
 - actual evidence and the prima facie rules, **15:61 to 15:65**
 - admission that term is not inherently distinctive, Section 2(f) application, **15:68**
 - burden of proof, effect on, **15:34, 15:35**
 - composite marks, **15:67**
 - evidence of secondary meaning, **15:59 to 15:73**
 - filing date is not cutoff for evidence, **15:71**
 - five year use, **15:62**
 - form statements and questionnaires in applications, **15:74 to 15:82**
 - intent to use application, **15:65**
 - inter partes attack, **15:73**
 - ITU application, **15:65**
 - ownership of other registrations, **15:63**

SECONDARY MEANING—Cont'd

- Federal registration—Cont'd
 - quantum of evidence required, **15:66**
 - scope of secondary meaning necessary, **15:72**
 - Supplemental Register, **19:43**
 - text of Lanham Act, **15:59**
 - Trademark Rules, **15:70 to 15:73**
 - types of evidence, **15:61, 15:70**
- Filing date is not cutoff for evidence, federal registration, **15:71**
- Five year presumption, **15:54**
- Five year use, **15:62**
- Functional shapes and designs, de facto secondary meaning, **15:23**
- Generic Terms (this index)
- Geographic
 - location, **15:45**
- Identity of buyers, **15:46**
- Intentional palming off, **15:16**
- Intent to use application, **15:60, 15:65**
- Inter partes proceedings, **15:73**
- Judicial notice, **15:31**
- Lanham Act five year presumption, **15:54**
- Length of use, **15:53 to 15:56**
- Likelihood of confusion, **15:11, 15:25**
- Literary, Artistic and Entertainment Rights (this index)
- “Look for” promotion, **15:30**
- Misappropriation, **15:18**
- Necessity of secondary meaning, **15:1 to 15:4**
- New York Rule. Substitutes for secondary meaning, below
- Non-verbal symbols, **15:9**
- Number of buyers, **15:45**
- Old primary meaning and new secondary meaning, **15:6**
- Opinions of some buyers, **15:41**
- Palming off, **15:16**
- Penumbra analogy, **15:5**
- Perception
 - generally, **15:39 to 15:44**
 - dealers, testimony of, **15:39**
 - employees of trademark owner, testimony of, **15:40**
 - opinions of some buyers, **15:41**
 - survey evidence, **15:42**
- Personal Names (this index)
- Pleadings, **32:202**

INDEX

SECONDARY MEANING—Cont'd

- Pre-sales secondary meaning, **15:57, 15:58**
- Public domain, **15:1**
- Publicity creating pre-release secondary meaning, **15:57**
- Required, background designs, shapes and symbols, **7:29**
- Res judicata, **15:29**
- Secondary meaning “in the making,” **15:58**
- Single, albeit anonymous rule, **15:8**
- Single anonymous source, association with, **15:8**
- Strength of mark
 - generally, **11:82, 15:25 to 15:27**
 - third party use, **15:27**
- Substitutes for secondary meaning
 - generally, **15:12 to 15:18**
 - actual deception, **15:17**
 - conduct as substitute, **15:15 to 15:18**
 - intentional palming off, **15:16**
 - misappropriation, **15:18**
 - “New York Rule,” **15:12 to 15:18**
 - origin of rule, **15:13**
 - Santa’s Workshop, **15:13, 15:14**
- Suggestive marks, **11:62**
- Summary judgment, **15:33, 32:119**
- Survey evidence, **15:30, 15:42, 32:190, 32:191**
- Symbols that are not inherently distinctive, **15:1.50, 15:68**
- Synonyms for secondary meaning, **15:10**
- Territorial extent of rights, **26:25**
- Third party use, strength of mark, **15:27**
- Time of acquisition of secondary meaning, **15:4**
- Trade Dress (this index)
- Trademark Rules, **15:70 to 15:73**
- Use of form statements, **15:74**
- Weight of evidence, **15:33**

SECONDARY SOURCE

- Identifying, **3:8**

SECTION 8 AFFIDAVITS

- Federal Registration (this index)

SECTION 15 AFFIDAVITS

- Federal registration, **19:140**

SECURITY INTERESTS

- Assignments, **18:7**

SEIZURES

- Counterfeiting, preliminary injunctions, **30:39**
- Imported goods, **29:37, 29:42**
- Mongol Nation case, **18:20.50**
- U.S. government, trademarks, **18:20.50**

SELF-LAUDATORY TERMS

- Descriptive marks, **11:17**

SERIES OF LITERARY WORKS

- Literary, Artistic and Entertainment Rights (this index)

SERVICE MARKS

- Generally, **19:80 to 19:89, 19:103 to 19:106**
- Abroad, internet delivery of into U.S. commerce, **19:106**
- Acquisition and priority of rights, federal registration, **16:33**
- Ancillary services, **19:89**
- Assignments, **18:25**
- Bars to registration, **19:82**
- Changing conceptions of services rendered in commerce, **19:105**
- Civil Rights Act, **19:105**
- Collective Marks (this index)
- Common law, **19:80**
- Corporate, business and professional trade names, **9:12**
- Definitions, **4:7**
- Dual trade name and service mark usage, **9:15**
- Federal registration, **4:7**
- Foreign or interstate commerce use, **19:105**
- Gastown Decision, **19:105**
- Goods in trade rejection, **19:87**
- Identification and distinguishing of services rendered, **19:81**
- Incidental goods, sales of, **19:87**
- Infringement, **23:76.50**
- Internet delivery of marks abroad into U.S. commerce, **19:106**
- Likelihood of confusion, **23:76.50**
- Location of designated mark, **19:104**
- Retail sales service, **19:86**
- Scope of time of services rendered, **19:105**

SERVICE MARKS—Cont'd

- Services rendered abroad to U.S. citizens, **19:105**
- Trade name vis-a-vis service mark, **4:7, 19:88**
- Use in commerce to identify services, **19:83**
- Use necessary to support registration generally, **19:103 to 19:106**
 - abandonment charges, **19:123**
 - changing conceptions of services rendered in commerce, **19:105**
 - Civil Rights Act, **19:105**
 - commerce, **19:83, 19:123, 19:124**
 - Creagri Rule, **19:123**
 - foreign or interstate commerce, **19:105**
 - labeling laws, use in violation, **19:123**
 - 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**
- 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**

INDEX

SPORTING EVENTS

Misappropriation, **10:56**

STANDING

Cancellation Proceedings (this index)
Consumer,
 opposition or cancellation proceeding
 in the trademark trial and Appeal
 board, **20:9**
Dilution by blurring, **24:121.50**
Distribution of trademarked goods,
 restrictions on, **31:114**
False Advertising (this index)
Federal question jurisdiction
 licensee, **32:18**
 non-owner of mark, **32:12**
 registrant only, **32:3**
Federal registration, challenge to,
 19:77.75
Infringement, section 43(a) of Lanham
 Act, **27:20, 27:21**
Inter Partes Proceedings (this index)

STATE OF MIND

Mens Rea (this index)

STATE PREEMPTION

Copyrights, **6:15.50**

STATE PROTECTION AND REGISTRATION

Generally, **22:1 to 22:11**
Consistency, state statutory and common
 law, federal trademark law, **22:1.50**
Corporate, Business and Professional
 Trade Names (this index)
Dilution of Trademarks (this index)
Display of trademark, control over, **22:4**
Federal
 CDA immunity, internet service
 provider, **22:4.50**
 law, use to interpret state statutes,
 22:7
 preemption, **22:1, 22:2**
 rights, limitation of, **22:1, 22:2**
 state relationships, **22:1 to 22:4**
Internet service provider, federal CDA
 immunity, **22:4.50**
Likelihood of confusion test of infringe-
 ment, **23:1.50**
Limitation of federal rights, **22:1, 22:2**
Model State Trademark Act, **22:5 to**
 22:9.25

STATE PROTECTION AND REGISTRATION—Cont'd

Model State Trademark Bill
 comment, 1996 and 2007 versions,
 22:6.25
 1992 version of text, **22:8, 22:9**
 text, **24:79.50**
 2007 version of text, **22:9.25**
Peaceful co-existence, federal / state
 relationships, **22:1 to 22:4**
Publicity, **28:2**
Puerto Rico, **22:10**
Registration laws, **22:10**

STATUTES OF LIMITATION

Cancellation counterclaim in opposition
 proceedings, tolling of, **20:67**
Dilution of trademarks, **24:130**
False advertising, **27:48**
Federal, **31:33**
Laches and delay, **31:23, 31:33**
State, **31:33, 31:34**

STAY OF PROCEEDINGS

Generally, **32:46 to 32:48**
Court, actions pending in, **32:47, 32:48**
Settlement, vacating judgment after,
 32:112.50
Trademark Board, actions pending in,
 32:47, 32:48
Two courts, actions pending in, **32:46**
Vacating judgment after settlement,
 32:112.50

STRENGTH OF MARKS

Generally, **11:73 to 11:93**
Abuse of process, **11:93**
Arbitrary marks, **11:14**
Assertive enforcement, **11:93**
Attorney fees award, over-aggressive
 enforcement, **11:93**
Balanced program of trademark enforce-
 ment, **11:91**
Bullying, **11:92**
Coined word marks, **11:6**
Commercial strength, **11:80**
Common use, terms in, **11:86**
Common word fallacy, **11:87**
Comparison, distinctiveness and second-
 ary meaning, **4:15**
Conceptual strength, **11:80**
Consumer perception, **4:15**

STRENGTH OF MARKS—Cont'd

- Crowded trademark markets, third party use, **11:85**
- Definitions, **4:15**
- Determination of strength
 - generally, **11:80 to 11:84**
 - commercial strength, **11:80**
 - conceptual strength, **11:80**
 - incontestable registration status, **11:84**
 - placement on spectrum, **11:80**
 - secondary meaning, **11:82**
 - traditional approach, **11:80 to 11:82**
 - two-prong test, **11:80**
 - 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**
- Incontestable 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**

STRENGTH OF MARKS—Cont'd

- 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)
- 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-suggestive 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**

INDEX

SUGGESTIVE MARKS—Cont'd

Trade use test, **11:69**

SUMMARY JUDGMENT

Generally, **32:113 to 32:121.75**
Burden on moving party, **32:116**
Burden on responding party, **32:117**
Collateral estoppel, **32:87**
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**
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**
Secondary meaning, **15:33, 32:119**

SUPER SIZE

Descriptive marks, composites, **11:28**

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**

SURVEY EVIDENCE—Cont'd

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**
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**

SURVEY EVIDENCE—Cont'd

- 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**
 - 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 age, **26:1.50**
- Conclusive presumption, limited area defense, **26:47**
- Concurrent use proceedings, **20:83, 20:84**
- 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, **26:37**
 - exceptions, statutory, constructive use, **26:40**

TERRITORIAL EXTENT OF RIGHTS**—Cont'd**

- Federally registered marks—Cont'd
 - 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**
 - likelihood of entry, **26:39**
 - likelihood of entry into jr. user's territory, **26:34**
 - limited area defense, below nationwide
 - priority as of application, constructive use, **26:38**
 - protection of registered marks, **26:31**
 - secondary meaning
 - scope of rights requiring, **26:41**
 - territorial remoteness, federal registrant as junior user, **26:56**
- Geographically remote use
 - generally, **26:1 to 26:30**
 - critical date of good faith, **26:11**
 - defined, **26:1**
 - good faith use by remote junior user, **26:6 to 26:11**
 - knowledge destroys good faith, **26:9, 26:10**
 - preservation of rights of each party, **26:3**
 - senior user, finding, **26:5**
- Good faith
 - constructive notice, **26:32**
 - geographically remote use, **26:6 to 26:11**
- Guthrie Precedent, Second Circuit limits Dawn Donut, **26:35**
- Immediate decision on priority issue under Dawn Donut, procedural devices, **26:36**
- Internet usage establishing territory, **26:30.50**

TERRITORIAL EXTENT OF RIGHTS**—Cont'd**

- Junior user, federal registrant as, **26:53 to 26:57**
- Knowledge destroys good faith, geographically remote use, **26:9, 26:10**
- Laches, federal registrant as junior user, **26:57**
- Laying out the zones, **26:27**
- Likelihood of confusion, no remedy until, **26:33**
- Likelihood of entry, federally registered marks, **26:39**
- Likelihood of entry into jr. user's territory, federally registered marks, **26:34**
- Limited area defense
 - generally, **26:43 to 26:52.50**
 - advertising nationwide, **26:46**
 - application or rejection freezes junior user's area, **26:45, 26:46**
 - conclusive presumption, negation of, **26:47**
 - contestable registrations, **26:51**
 - intermediate junior user's defense, **26:43, 26:44**
 - missing remoteness requirement, **26:48**
 - prior registration, **26:52.50**
- Localized businesses, **26:29**
- Minimum sales volume, rights in unoccupied territory, **26:14**
- Nationwide
 - businesses, **26:30**
 - priority as of application, constructive use, **26:38**
 - protection of registered marks, **26:31**
- Natural expansion, zone of, **26:20, 26:22 to 26:24**
- Perambulating customers, rights by reputation, **26:17**
- Prior registration exception, **26:52.50**
- Registration exception, **26:52.50**
- Reputation, rights by, **26:16 to 26:19**
- Secondary meaning
 - generally, **26:25**
 - scope of rights requiring, **26:41**
- Shrinking senior user, **26:21**
- State lines, **26:28**
- Static senior user, **26:21**

**TERRITORIAL EXTENT OF RIGHTS
—Cont'd**

- Statutory exceptions, constructive use, **26:40**
- Territorial remoteness, federal registrant as junior user, **26:56**
- The Dawn Donut Rule, **26:33**
- Unoccupied territory, rights in, **26:13 to 26:15**

TIE-INS

- Monopolies and Restraints of Trade (this index)

TIGER WOODS

- Commercial marks, goods and services, **10:23**

TITLES

- Literary, artistic and entertainment rights, **10:4.10, 10:7.10, 10:9, 10:18 to 10:20, 10:37, 10:42.50**

TOP LEVEL DOMAINS

- Additional top level domain in the Twenty First century, **25A:14**
- Open framework, **25A:15**
- Pre 2000, NSI top level domain name dispute resolution, **25A:19**

TORTS

- Commercial torts, **1:8**
- Franchises (this index)
- Personal jurisdiction, long-arm statutes, **32:39**
- Strength of marks, enforcement, **11:93**
- Unfair competition, generally, **1:12**

TOY REPRODUCTIONS

- Related goods or services, **24:48.50**

TRADE DRESS

- Copyright, overlap, **6:17.50**
- Decorative design, **3:4**
- Descriptive trade dress, **11:16.50**
- Design of product, **8:5**
- Design or appearance of wearing apparel, **7:103**
- Design patents, **6:11**
- Dilution of trademarks, **24:102**
- Distinctiveness of marks, **11:16.50**
- Elements of trade dress
 - identification of, **8:3**
 - infringement claim, **7:59, 8:1**

TRADE DRESS—Cont'd

- Examples of, **8:4.50**
- Federal preemption
 - copyrights, **6:5**
- Federal protection, **8:7**
- Federal registration
 - trademark or service mark, **7:101**
- Functional
 - design, **6:10**
- Functional design barrier, **6:10**
- Generic, **8:6.50**
- Identification of elements, need for, **8:3**
- Imitation of trade dress, **24:48.50**
- Infringement claim, elements, **7:59, 8:1**
- Insurance for infringement claims, **33:8**
- Intentional
 - copying, **8:9**
 - imitation, **8:19**
- Likelihood of confusion
 - generally, **8:15 to 8:19, 23:52**
 - comparison of conflicting trade dresses, **8:15**
 - conflicting trade dress, illustrations, **8:17**
 - defendant's mark on look-alike, **8:16**
 - intentional imitation, **8:19**
 - secondary meaning, **8:8.50**
- Line of different products or packages, **8:5.50**
- Literary, artistic and entertainment rights, **10:15**
- Marketing theme, **8:6**
- Milstein Precedent, **8:6.50**
- Packaging, inherently distinctive, **8:13**
- Packaging design, inherently distinctive, **8:13.50**
- Product and container shapes, **1:24**
- Product design, **8:5**
- Registered, federal protection, **8:7**
- Seabrook test, **8:13.50**
- Secondary meaning
 - generally, **8:8 to 8:14**
 - copying as evidence, **8:9**
 - likelihood of confusion, **8:8.50**
 - modern rule, **8:11**
 - packaging, inherently distinctive, **8:13**
 - proof of secondary meaning old rule, **8:10**
 - proving, **8:8.50, 8:11.50**

INDEX

TRADE DRESS—Cont'd

- Secondary meaning—Cont'd
 - 2000 Wal-Mart decision, law after, **8:12**
 - Wal-Mart rule and its impact, **8:12**
 - when required for trade dress, **8:8**
 - word marks, marketing under differing, **8:14**
- Services, categorizing, **8:12**
- Source, indication of, **8:1**
- State trademarks, **24:83**
- Style of doing business, **8:6**
- Totality of elements, focus on, **8:2**
- Trademark or trade dress, **7:103**
- Trademarks, compared, **8:1 to 8:3**
- 2000 Wal-Mart decision, law after, **8:12**
- Unregistered, federal protection, **8:7**
- Utility patents, non-functional element preclusion, **7:89.70**
- Web
 - dress, **8:7.25**
 - site appearance, **8:7.25**
- Word marks, marketing under differing, **8:14**

TRADE DRESS LAW

- Product and container shapes, **7:55**

TRADE DRESS PROTECTION

- 2000 Wal-Mart decision, law after, **8:12**
- Generally, **8:8 to 8:14**
- Intentional copying, **8:9**
- Likelihood of confusion
 - secondary meaning, **8:8.50**
- Modern rule, **8:11**
- Packaging, inherently distinctive, **8:13**
- Packaging design, inherently distinctive, **8:13.50**
- Proof of secondary meaning old rule, **8:10**
- Proving, **8:8.50**
- Seabrook test, **8:13.50**
- Secondary meaning
 - copying as evidence, **8:9**
 - likelihood of confusion, **8:8.50**
 - packaging, inherently distinctive, **8:13**
 - when required for trade dress, **8:8**
 - word marks, marketing under differing, **8:14**
- Secondary meaning proving, **8:11.50**

TRADE DRESS PROTECTION

—Cont'd

- Services, categorizing, **8:12**
- Trade dress, **8:8.50**
- Trade dress, proving secondary meaning, **8:11.50**
- Wal-Mart rule and its impact, **8:12**
- Word marks, marketing under differing, **8:14**

TRADE LIBEL AND PRODUCT DISPARAGEMENT

- Generally, **27:91 to 27:112.10**
- Agricultural food disparagement statutes, **27:112.10**
- Amendments to statute
 - generally, **27:93 to 27:98**
 - law prior to amendment, **27:92**
- Commenting on litigation, exemption, **27:109.50**
- Commercial speech, **27:107**
- Constitutional constraints, free speech, **27:105**
- Corporate defamation, distinguished, **27:101**
- Deceptive endorsements and testimonials, Federal Trade Commission, **27:120**
- Defamation rules, free speech, **27:106**
- Disparagement law limited to
 - commercial speech or promotion, **27:95**
 - fact representation, not opinion, **27:96, 27:96.10**
- Elements of product disparagement, state claims, **27:99**
- Environmental marketing claims, Federal Trade Commission, **27:121**
- Fact representation, not opinion, **27:96, 27:96.10, 27:109**
- False or disparaging statement, **27:103**
- Federal claim, creation of by amendment, **27:94**
- Federal law
 - generally, **27:91 to 27:97**
 - amendments to statute
 - generally, **27:93 to 27:98**
 - law prior to amendment, **27:92**
 - claim, creation of by amendment, **27:94**

**TRADE LIBEL AND PRODUCT
DISPARAGEMENT—Cont'd**

- Federal law—Cont'd
 - disparagement law limited to
 - commercial speech or promotion, **27:95**
 - fact representation, not opinion, **27:96**
 - requirements and restrictions, **27:97**
- Federal registration, bars to, **19:77.25**
- Federal Trade Commission
 - generally, **27:118 to 27:121**
 - deceptive endorsements and testimonials, control over, **27:120**
 - environmental marketing claims, **27:121**
 - power to prohibit unfair competition and false advertising, **27:118**
 - private remedy, absence of, **27:119**
- Free speech, **27:105 to 27:108**
- Injunctions, **27:112**
- Intent to injure, **27:104**
- Knowledge of falsity, **27:104**
- Little Federal Trade Commission Acts, **27:114**
- Personal defamation, distinguished, **27:101**
- Privileges exempt, **27:110**
- Publication of statement, **27:102**
- Public interest, publications on matter of, **27:108**
- Remedies, **27:111, 27:112**
- Requirements and restrictions, **27:97**
- Special damages, **27:111**
- State law
 - generally, **27:91, 27:98 to 27:112.10**
 - agricultural food disparagement statutes, **27:112.10**
 - commenting on litigation, exemption, **27:109.50**
 - corporate defamation, distinguished, **27:101**
 - elements of product disparagement, **27:99**
 - fact representations, not opinions, **27:109**
 - false or disparaging statement, **27:103**
 - free speech
 - generally, **27:105 to 27:108**
 - commercial speech, **27:107**

**TRADE LIBEL AND PRODUCT
DISPARAGEMENT—Cont'd**

- State law—Cont'd
 - free speech—Cont'd
 - constitutional constraints, **27:105**
 - defamation rules, **27:106**
 - public interest, publications on matter of, **27:108**
 - injunctions, **27:112**
 - intent to injure, **27:104**
 - knowledge of falsity, **27:104**
 - personal defamation, distinguished, **27:101**
 - privileges exempt, **27:110**
 - publication of statement, **27:102**
 - remedies, **27:111, 27:112**
 - special damages, **27:111**
- State statutes, **27:113 to 27:116**

TRADEMARK FORMATS

- Buildings
 - federal registration, **7:101**
 - protection of building exterior and interior, **7:100**
 - trademark or service mark, **7:101**
- Design or appearance of wearing apparel, **7:103**
- Trademark or trade dress, **7:103**

TRADEMARK LAW REVISION ACT

- False advertising, **27:10**
- Federal registration, **19:5, 19:35**
- Presumptions, **32:135, 32:140**

TRADEMARK LAW TREATY

- Generally, **29:34**
- Federal registration, **19:45.25**

**TRADEMARK LICENSE MERGER
RULE**

- Generally, **18:47**

**TRADEMARK MANUAL OF
EXAMINING PROCEDURE**

- Federal registration, examination of application, **19:129**

**TRADEMARK REGISTRATION
TREATY**

- Generally, **29:27**

TRADEMARK RULES

- Secondary meaning, **15:70 to 15:73**

INDEX

TRADEMARK TRIAL AND APPEAL BOARD

- Generally, **21:1 to 21:4**
- Appeal process, **21:4**
- Cancellation proceedings, no consumer standing
 - to bring an opposition or cancellation proceeding, **20:47**
- Ex parte appeals, **19:127, 21:1, 21:2**
- Inter Partes Proceedings (this index)
- No consumer standing
 - to bring an opposition or cancellation proceeding, **20:9**
- Procedure on appeal, **21:2**
- Res Judicata and Collateral Estoppel (this index)

TRADE NAMES

- Corporate, Business and Professional Trade Names (this index)

TRADE SHOWS

- Acquisition and priority of rights, federal registration, **16:31**

TRAFFIX CASE

- Functionality, **7:89, 7:89.30**

TRANSCRIPT

- Inter partes proceedings, **20:118**

TRANSFORMATIVE TEST

- Publicity, **28:19**

TREATIES

- Generally, **29:25 to 29:36.50**
- Anti-Counterfeiting Trade Agreement (ACTA), **29:33.50**
- Bilateral trademark treaties, **29:26.50**
- European Union Trademark, **29:35**
- GATT TRIPs, **29:36**
- Hague convention, **29:36.50**
- Lisbon Agreement, **29:28**
- Madrid Protocol, **29:32**
- Madrid Registration of Marks Treaty, **29:31**
- Madrid Source of Goods Treaty, **29:30**
- Paris Convention, **19:74, 29:25**
- Regional trademark treaties
 - Pan-American Convention, **29:26**
- Self-execution of treaties, **29:33**
- Trademark Law Treaty, **29:34**
- Trademark Registration Treaty, **29:27**

TREATIES—Cont'd

- Uruguay Round Agreements Act, **29:36**

TRENDS

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

TRIPs

- Famous marks, **29:63**

T-SHIRTS

- Freedom of speech, significance of medium, **31:152**

T.T.A.B.

- Trademark Trial and Appeal Board (this index)

TWOMBLY

- Summary judgment, motion to dismiss, failure to state a claim, **32:121.60**

TYPES OF MARKS

- Generally, **7:9 to 7:38**
- Abbreviations, **7:18**
- Background Designs, Shapes and Symbols (this index)
- Buildings
 - protection of building exterior and interior, **7:100**
- Combined marks, **7:8**
- Decorative symbols and designs, **7:24**
- Descriptive symbols, pictures, and designs, **7:35 to 7:37**
- Design or appearance of wearing apparel, **7:103**
- Distinctive designs and symbols, **7:25**
- Federal registration
 - trademark or service mark, **7:101**
- Flavor marks, **7:107**
- Fragrance marks, **7:106**
- Functional pictures, **7:37**
- Generic pictures, **7:37**
- Geometric shapes and symbols, **7:33, 7:34**
- Internet
 - domain names, **7:17.50**
 - hashtags, **7:17.70**
- Letters (this index)
- Location of label, **7:38**
- “Look for” promotion, **7:29, 7:30**
- Motion marks, **7:109**
- Nicknames, **7:18**
- Non-marks, **4:12**

TYPES OF MARKS—Cont'd

- Non-traditional formats, **7:105**
- Numbers (this index)
- Ornamental symbols and designs, **7:24**
- Policy issues, non-traditional formats, **7:105**
- Repetition
 - mark, **7:31**
 - pattern covering product or packaging repeated, **7:32**
- Shape of label, **7:38**
- Slogans (this index)
- Sound marks, **7:104**
- Symbols and designs
 - decorative, **7:24**
 - descriptive, **7:35 to 7:37**
 - distinctive, **7:25**
- Tactile marks, **7:108**
- Trademark or trade dress, **7:103**
- Vehicles, **7:102**

UNCLEAN HANDS

- Generally, **31:44 to 31:58**
- Antitrust violation, **31:47**
- Balancing of parties' conduct, **31:52 to 31:55**
- Deceptive trademarks, relevant conduct, **31:50**
- Discontinued conduct, **31:55**
- Examples, **31:57, 31:58**
- False advertising by both parties, **31:54**
- Filing of infringement suit not basis for unclean hands, **31:51**
- Infringement cases, relevant conduct, **31:49**
- Injunctions
 - enforcing other rules by refusing, **31:52**
 - preliminary injunction hearing, **31:56**
- Misuse of trademark, **31:47**
- Monopolies and restraints of trade, **31:91**
- Public protection from confusion and deception, **31:53**
- Rejection of defense, **31:53**
- Relevant conduct, **31:48 to 31:51**
- Unlawful use of mark, defense, **31:58.50**

UNFAIR COMPETITION

- Generally, **1:1 to 1:26, 4:1 et seq., 4:6**
- Anti-trust laws, **1:20**
- California statutes, **27:115**

UNFAIR COMPETITION—Cont'd

- Capacity for development and growth of law, **1:15**
- Choice of law, **32:36**
- Commercial
 - ethics, **1:12**
 - torts, **1:8**
- Competitive injury, **1:14**
- Definitions, **1:8 to 1:11, 4:1 to 4:6**
- Designs, **1:24**
- Economic principles, **1:12 to 1:14**
- Economy, competition as basic premise of, **1:3**
- Efficiency, competition and, **1:6**
- Encouragement of imitation of public domain materials, **1:24**
- Enforcement, legal system as an instrument of, **1:3**
- Examples, **1:10**
- Fad in market, copying, **1:25**
- Failing competitor, **1:8**
- False advertising, **1:8**
- Federalization of law, **1:19, 1:19.50**
- Federal question jurisdiction, **32:15**
- Federal Trade Commission, power to prohibit, **27:118**
- Free competition, **1:1, 1:20**
- Free copying, **1:2**
- General rule is that of public domain, **1:2, 1:23**
- Good faith, **1:8, 1:11**
- Government owned trademarks, **1:7**
- Historical development, **1:15 to 1:19**
- Imitation, **1:24, 1:25**
- Infringement
 - non-competitor, **1:15**
 - patent, **1:8**
 - trademark law as, **2:7, 2:8**
 - unfounded charges, **1:11**
- Inherent judicial power, unfair competition law as, **1:16**
- Injury, **1:14**
- Judicial power, **1:16**
- Laissez Faire
 - Adam Smith, **1:4**
 - government control, **1:3**
 - Thomas Jefferson, **1:4**
- Lanham Act federalization, **1:19, 1:19.50**
- Literature, characters in, **10:42**

INDEX

UNFAIR COMPETITION—Cont'd

Modern growth and change in scope of law, **1:15 to 1:19**

Monopoly power

generally, **1:4, 1:5, 1:20 to 1:22, 31:90.50**

competition, **1:4**

dual policies, **1:20**

political power, **1:5**

relationship between antitrust law and trademark and unfair competition law, **31:90.50**

1938 Restatement, **1:17**

1995 Restatement, **1:17**

Non-competitors, **1:8**

Political power and monopoly power, **1:5**

Preemption of state law by federal law, **1:18**

Product design law, **1:18**

Public domain

generally, **1:2, 1:23 to 1:26, 6:5**

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 equal-

UNIFORMITY—Cont'd

ity 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 IN COMMERCE—Cont'd

- Use necessary to support registration
- Federal Registration (this index)
- Service Marks (this index)

USPTO

- Patent and Trademark Office (this index)

UTILITARIAN FUNCTIONALITY

- Functionality (this index)

UTILITY PATENTS

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

UTILITY PATENTS AND TRADEMARKS

- Functional design barrier, **6:10**
- 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**

VENUE—Cont'd

- 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)

INDEX

WINE

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**

WORDS—Cont'd

Generic Terms (this index)

Informational, **3:5**

Meanings, new, **3:3, 4:1**

New meanings, **3:3, 4:1**

Slogans, **3:5**

Slogans (this index)

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

Versions, singular and plural, **23:46.25**

WORLD-WIDE PHENOMENON

Generally, **2:6**