



# Trademarks

Class 10

# Incontestability & Fair Use

## VALIDITY - REGISTRATION - OWNERSHIP

- Incontestability = no one else will be able to come along and contest the owner's use of the mark provided that the plaintiff can show the following:
  1. The mark - still in use - is registered on the primary register and has been in continuous use for 5 consecutive years following registration;
  2. There is no pending case involving the mark (other than the case at issue) and there's been no prior ruling adverse to the owner's right to use the mark;
  3. The filing requirement in §1065(3) was met; and
  4. The mark is not a generic name.
- (In other words, the mark cannot be contested.)
- However, there are defenses to incontestability!  
[§1115(b)]

# Incontestability & Fair Use

- The defense is not “I didn’t infringe” but rather that “plaintiff’s mark is not necessarily incontestable.”
  1. Either the registration or the incontestability status was fraudulently obtained.
  2. The registrant abandoned the mark.
  3. The registrant, or others, used the mark in a way that constitutes misrepresentation.
  4. The term is a party’s name, a descriptive term, or a geographic term.
  5. Defendant used the mark without knowledge of plaintiff’s use prior to plaintiff’s registration or other date of constructive notice of use.
  6. Defendant used the mark before plaintiff’s registration and hasn’t abandoned the mark. (Allows only continued use by defendant, not new use.)
  7. Protecting the registrant’s use of the mark would violate antitrust law.
  8. The mark is functional.
  9. Other equitable principles (estoppel, laches, etc.)

# Incontestability & Fair Use

## Fair Use

- Where defendant - in good faith - uses the term to *describe* goods as opposed to using the term to identify the origin of the goods.
- Must determine:
  - whether or not the term is being used descriptively
  - whether or not the term is being used in good faith
- Other lawful unauthorized uses of a mark
  - Promotional Products
  - Comparative Advertising
  - Parody & Speech

# Trademark Licensing & Assignment Agreements

- A trademark, which is property, can be conveyed in a number of ways:
  1. Assign all the rights in the mark to another party (outright sale).
  2. Assign some rights in the mark to another party (partial assignment).
  3. Grant another entity the right to use the mark for certain purposes for a particular period of time (license).

# Trademark Licensing & Assignment Agreements

## Trademark Assignment

- Outright assignment usually involves 4 separate rights:
  1. The registration rights.
  2. The right to prepare derivative works.
  3. The income, royalties, and claims related to the mark that are due or payable on or after the assignment date.
  4. The goodwill related to the mark (reputation).

# Trademark Licensing & Assignment Agreements

## Trademark Licensing

- How do you maintain the value of a licensed mark?
  1. Clearly state, in a strong licensing agreement, the mark owner's rights, the licensee's obligations, and the limits of the licensed use.
  2. The owner of the mark must be continually vigilant in ensuring that the licensee is using the mark according to the terms of the licensing agreement.
  3. Unlike a sale, a license creates an ongoing relationship between the mark owner and the person who was given a license.



# The Internet & International Trademark

- The Internet

- Cybersquatters
- "Cyberspace provision" → can be liable for the bad faith registration of a mark as a domain name.

- International Trademark

- The Madrid Protocol - international protection of trademarks (Remember: The Berne Convention for the international protection of copyrights)
- Place a valuable mark on the international registry (in accordance with The Madrid Protocol)