Question 1. Bobalat versus Prince for TM infringement of marks “Saber,” “It IS Rocket Science” and Trade Dress.

I. Distinctiveness

To qualify for protection, a trademark must be distinctive. Courts have established the “Abercrombie spectrum” to determine if a mark is distinctive, which includes four categories of marks: (a) generic, for which no protection is available; (b) descriptive, for which protection is available if the mark has secondary meaning (i.e. consumers recognize the mark as serving to identify the source of the good and not merely to describe the good); (c) suggestive marks, which are inherently distinctive and thus always eligible for protection; and (d) arbitrary or fanciful marks, which also are inherently distinctive. In Zatarain’s, the court looked at dictionary meanings to determine if the term exists in the dictionary and, if so, what definitions are given for the word and if the trademark is used in this sense.

Scimitar. Here, Babolat’s TM is Scimitar. The definition is a saber having a curved blade with the edge on the convex side and used chiefly by Arabs and Turks. Babolat is using the term to describe a tennis racket, so the term is being used in a different sense than the dictionary definition. The Zatarain’s court also used the imagination test to determine if a mark is descriptive or suggestive. If consumers have to make a mental leap between the mark and the good, then the mark is more likely to be suggestive. Here, consumers do have to make a mental leap to go from a word that means a sword used in the Middle East to a tennis racket. Courts also look at competitors’ need to use the word and actual use by others to determine if a mark is descriptive or suggestive. Here, Prince actually used a word with a similar meaning, but there is no evidence that any other company used the word Scimitar to describe tennis rackets. There are
many ways that competitors can describe tennis rackets. SCIMITAR is suggestive, and thus eligible for TM protection. Proof of secondary meaning is not required.

Additionally, the mark Scimitar may be considered arbitrary because it is questionable whether a term meaning a type of saber has any connection to tennis at all. A person wanted to argue that the mark is suggestive might say that tennis players could be argued to be using a racket as a “weapon” on the “battlefield” of the tennis court, so the mark is suggestive of tennis. However, really tennis has little to do with Middle Eastern sabers, so the mark could be considered arbitrary. If the mark is arbitrary, it will also be entitled to protection regardless of secondary meaning.

*Racket Science!* The RACKET SCIENCE! mark is arguably descriptive – it merely tells what is involved with this product. This mark, however, is incontestable. Prince, therefore, cannot challenge the mark on the basis of descriptiveness. *Park ’n Fly.* Prince might be able to assert that the term is generic, but RACKET SCIENCE! is not describing what the good is. It is describing aspects or qualities involved with the racket. As such, its does not seem to be generic.

*Trade dress lattice.* The Supreme Court in *Samara Bros.* concluded that only product packaging, and not product design, can be inherently distinctive. Thus, the court will first have to determine whether B’s triangles are packaging or design. If it is design, then Babolat will have to show secondary meaning in order for the design to be protectable. Although the line between packaging and design is not bright, B’s triangles are design because they are part of the design of the product itself and not just the way the product is contained (like a label or wrapper would be). Additionally, under *Samara*, the court said that if there is any question, courts should err on the side of design and require secondary meaning. So here, the design cannot be protected unless there is secondary meaning.
Under *Yankee Candle*, courts look at the following factors to assess whether a design has achieved secondary meaning – survey evidence, length and manner of use, nature and extent of advertising and promotion, efforts made to promote conscious connection between the trade dress and the product’s source (such as “look for” advertising), the products established place in the market, and intentional copying.

As to survey evidence, none is presented although there is anecdotal evidence of secondary meaning: consumers have asked for the racket with the triangles or lattice, suggesting that consumers identify the design of the racket with a particular producer.

As to length and manner, Babolat has been using this trade dress for its rackets since 1990, a considerable length of time. Moreover, the triangles are quite visible as they are a part of the racket.

B has extensively advertised on a national level the racket, including ads in Time and Newsweek, reaching a broad audience. None of these ads, however, promote a connection between the dress and the product source, as none seem to be “look for” advertising.

The racket is pervasive in the market, as it is offered in all sorts of department and sporting good stores. As discussed below, however, any evidence of copying of the design is weak.

Overall, the lattice design would appear to have achieved secondary meaning.

II. Priority

The only issue of priority relates to Babolat’s “Racket Science!” mark. B registered the RACKET SCIENCE! Mark in 1998. But, Prince began its use of “It IS Rocket Science” in 1997, presumably giving Prince priority. Babolat, however, had used variations of its RACKET SCIENCE! Mark before Prince and may, via tacking, be able to maintain priority.
If a producer has changed its mark over time, it can attempt to tack back to the earlier use date by showing that the marks are so similar that consumers regard the marks as the same.

Under *Brookfield*, the standard for tacking is very stringent. In the *Hess* case, Hess was allowed to tack from HESS’S BROTHERS because consumers were already associating its store with Hess’s before the change. In contrast, *Brookfield* denied tacking from MOVIE BUFF to moviebuff.com.

This case is slightly different than *Brookfield* in that the marks slowly evolved through slow truncation of the mark. The commercial impression – the play on rocket versus racket – remained intact throughout the various uses of the mark. Tacking from the original “It’s Not Rocket Science…” to “Not Rocket Science…” seems likely. The shift, then, to RACKET SCIENCE! seems like a natural progression that consumers would grab onto, thus thinking the marks are in essence the same. Babolat would be able to tack and thus maintain priority.

It is important to note that Babolat has abandoned its earlier two marks. Under § 45 of the Lanham Act, a mark is considered abandoned if the TM owner discontinues use with intent not to resume use. Failure to use the mark for 3 years presumptively means the mark has been abandoned. Thus, Babolat can assert infringement of only its RACKET SCIENCE! Mark and not its former, IT’S NOT ROCKET SCIENCE, IT’S RACKET SCIENCE or NOT ROCKET SCIENCE. RACKET SCIENCE! marks.

III. Likelihood of confusion

The facts state that suit will be filed in the Northern District of Illinois, which is the 7th Circuit, so the court will use the 7th Circuit factors to assess likelihood of confusion.

1. *Similarity between the marks in appearance and suggestion*

   This factor will differ for the different marks being asserted.
(a) *Saber v. Scimitar.* To assess the similarity of word marks, courts will look to phonetic similarity, similarity of meaning, and similarity of the look of the mark. The marks do not sound the same, so there is little phonetic similarity. The meaning of the marks, however are very similar – both are a type of sword. Indeed, scimitar is defined as a type of saber. Consumers may be confused because two words meaning “sword” are being used to identify an identical product – tennis rackets (in fact, tennis rackets with a lattice structure). This factor favors infringement as to the SCIMITAR mark.

(b) *RACKET SCIENCE.* The marks only change one letter, so the marks sound fairly similar. The marks also look similar in that both use an exclamation point. Prince will argue, however, that the suggestion is different because its mark suggests its space age material. By adding “IS” in capital letters, this may show that the suggestion is different and serves to distinguish its mark from Babolat’s for consumers. Given the overall similarity of the marks, however, this factor favors Babolat slightly.

(c) *Trade dress.* For non-verbal marks, this generally only applies to the look of the mark. Here B is using triangles and Prince is using trapezoids, suggesting a dissimilar appearance. Both designs, though, create a lattice appearance. Indeed, as noted below, consumers are recognizing the lattice, not necessarily the component shapes of that lattice, in requesting the racket. This factor favors Babolat as to the trade dress.

2. *Similarity of the products.*

The products on which all of the alleged marks are used are tennis rackets, favoring infringement. The differences between the markets for the rackets will be discussed in later factors.

3. *Area and manner of concurrent use.*
This factor measures how closely marketed the goods are. It appears similar to the “channel of trade” factor used by other circuits. Here, the SABER and SCIMITAR rackets are marketed differently. The SCIMITAR racket is “lower end,” targeted to your every-day tennis player, and it is sold in department stores like Walmart. In contrast, the SABER racket is higher end and only sold in specialty tennis stores. Generally, this distinction would favor a finding of non-infringement, but both rackets are marketed on-line. As such, consumers on the internet are equally likely to encounter the goods. This factor therefore favors infringement.

4. **Degree of care likely to be exercised by consumers**

The degree of care exercised by consumers is important because for items, such as luxury items, customers are more likely to investigate the product before purchasing it. Thus, more sophisticated consumers will be better informed and, thus, less apt towards confusion. Price is often used as a proxy for the degree of care. Here, Babolat’s racket costs $70, whereas the accused infringing racket costs $199. We thus encounter a potential mixed consumer market, where Prince’s customers are likely more sophisticated than those purchasing the Babolat racket. Courts are split as to how to deal with mixed consumer markets, but one approach is to use the lowest level of sophistication. As such, even though Prince’s customers likely are sophisticated, the every-day purchasers like those of the Babolat racket may be confused. This factor may be close, but given the lowest level of sophistication, it slightly favors Babolat and, thus, infringement.

5. **Strength of the complainant’s mark**

The strength of a mark is broken into two components – distinctiveness and fame. Distinctiveness is the same as the validity considerations – whether the mark has acquired distinctiveness or is inherently distinctive, with the latter receiving broader protection. Fame is
the how well the mark is known in the market. Again, this factor will vary for the three marks at issue.

*Scimitar.* The inherent distinctiveness of this mark is discussed in the validity section. As being inherently distinctive (either suggestive or arbitrary), this aspect favors Babolat. As to fame, Babolat advertises in Newsweek and Time, and the rackets are sold in Wal-Mart. The word mark, however, seems less famous than the design, as people are asking for “the racket with triangles” or “the lattice” racket,” although people anecdotally were also asking for the “sword” racket. They didn’t ask, however, for the SCIMITAR or the SABER by name. This may suggest the mark itself has not achieved fame, but the relationship to a sword has. This factor is close but seems to favor Babolat.

*Rocket science.* As an incontestable mark, it will be viewed as distinctive. As to fame, there is not much evidence that consumers strongly associate this logo with Babolat. Given incontestability, this factor slightly favors Babolat.

*Trade dress.* As discussed above, as trade dress, there is no inherent distinctiveness. Secondary meaning likely will be shown, but generally courts seem opposed to viewing design as terribly distinctive. As to fame, the anecdotal evidence discussed below does suggest some association between consumers and the lattice design.

6. **Actual confusion**

Actual confusion is strong evidence of consumer confusion. Preferably it is demonstrated by consumer surveys, but anecdotal evidence of confusion is also admissible to prove this factor. In this case, there is anecdotal evidence of actual confusion because Prince received emails asking for the racket named after a sword with a lattice design. These
consumers expressed surprise at the cost, which suggests that consumers thought that Prince’s rackets were actually Babolat’s lower priced ones.

Also, evidence of initial interest confusion would be relevant here. Prince registered the domain name racketscience.com and rocketscience.com. When consumers search for B’s satalog racketscience, they likely will click to Prince’s web page, thinking it is Babolat’s. Although consumers might no longer be confused at the point of sale because of the higher price and/or the disclaimer, there still would be confusion. The adequacy of Prince’s disclaimer is also suspect given that it distinguishes itself based on the name Babolat and not the TM Scimitar. Consumers may not (and do not have to be aware) that Babolat makes the SCIMITAR racket.

7. **Intent of the defendant to palm-off his product as that of another**

The intent of the defendant to palm-off his product can show a likelihood of confusion because, by inference, if that was the intent of the defendant, then they likely anticipated that consumers would be confused by his action. This factor is mixed. It would seem odd that Prince would innocently choose to also name its racket after a sword; but as Prince is selling a higher quality racket, it is likely that Prince did not want people to think that its racket actually was B’s, Prince is selling a higher quality racket which is sold to professionals. Prince’s registration of the racketscience.com domain name also suggests there may be intent on their part. Prince would not want professionals to think that its racket was actually a lower quality racket such as the one sold by B.

As to the ROCKET SCIENCE mark, however it’s a close call. Prince clearly knew of Babolat’s mark and, indeed, was intentionally playing off of that logo. In some ways, though, that word play may serve to *lessen* the likelihood of confusion – the intent was not to confuse but instead to distinguish. Intent, therefore, seems to cut against Babolat.
The majority of the marks, and the weight given to those factors, favor a finding of likelihood of confusion in this case.

IV. Functionality of Trade Dress

Prince will argue that trade dress protection should not be available to Babolat’s lattice design because it is functional. Functionality doctrine under *Traffix* precludes a design from functioning as a trademark if the trade dress is essential to the use or purpose of the article or if it affects the cost or quality of the article. Also under *Traffix*, the existence of an expired utility patent is strong evidence that a product feature is functional. If the trade dress from the expired utility patent is merely ornamental, incidental, or arbitrary, then the trade mark owner may still be afforded trade dress protection.

Here, the utility patent is related to lacrosse sticks and not tennis rackets. The utility patent does not covered the asserted trade dress; therefore, it is unlikely that a maker of tennis rackets would have infringed this patent. Since one of the policy reasons for using expired utility patents as evidence of functionality is to allow things to go into the public domain (in contrast to the potential, perpetual protection of TM law), this may suggest that this utility patent should not be used as evidence of functionality. However, Prince will argue that this doesn’t really matter because the triangular openings are covered under the claims of the expired patent and these openings serve the same purpose in the tennis racket that they did in the lacrosse racket: reducing weight and increasing the racket speed (in lacrosse, this allows the player to throw the ball faster). Therefore, Prince would argue that this expired utility patent shows that the design is functional. Additionally, the triangular openings are not merely incidental, they serve a purpose of lowering the weight of the racket and allow greater speed. Further, under the traditional
*Traffix* test, the openings affect the quality of the article, so this would also show that the openings are functional.

Babolat might argue that the court should consider this as aesthetic functionality, because the triangular shape of the openings does not affect the quality of the good. It would argue that the court should use the 5th Cir.’s *Abercrombie* test where the court looked at comparable alternatives and the effective competition test. Here, there are a variety of alternative shapes that could be used, such as a solid frame, circles, or other shapes. Therefore its design should be seen as nonfunctional under the aesthetic functionality test. Prince could respond under a theory of “shape depeletion,” that there are only so many shapes that could be used – similar to the “color depletion” argument made in *Qualitex*. This argument seems weak, though, as there would seem to be innumerable shapes that could be used.

But, as the *Traffix* court noted, consideration of alternative designs is not relevant when there is a clear case of functionality, which is the case here. Babolat would not be able to assert a claim of infringement for the SCIMITAR’s trade dress.

V. Cancellation of the Domain Names

Babolat could try to stop Prince from using the domain names under three scenarios – dilution, the UDRP, and the ACPA.

Dilution protection allows a TM owner to protect the whittling away of the distinctive character of its mark, regardless of consumer confusion. Before the UDRP and the ACPA, this was the sole way owners could protect themselves against cybersquatters. Dilution at the federal level, however, is limited to famous marks, and courts have generally required significant, non-niche fame. Here, the RACKET SCIENCE! mark is at best famous only in the niche market of tennis rackets. Dilution protection is probably not available to BAbolat.
Babolat also could use the private dispute resolution proceeding UDRP, which is mandatory for registrants of domain names. A third party can obtain the right to a domain name it can show (1) the domain name is identical or confusingly similar to the TM in which the complainant has rights, (2) the registrant has no legitimate interest in the domain name and (3) the registered domain name is being used in bad faith.

As discussed above, the domain names are identical or confusingly similar to Babolat’s trademark. Prince will argue, however, that factor (2) is not satisfied because they have a legitimate interest in the domain name due to their “It IS Rocket Science!” mark. Prince likely will win with respect to the rocketscience.com domain name, but Prince has no interest in the racketscience.com domain name.

Prince will also argue that it lacks bad faith. It is not a classic cyber squatter – they have not tried to extort money from Babolat to get the domain names back. Prince has not engaged in a pattern of bad faith by registering lots of domain names – it has only registered two. It may have registered the domain name to disrupt Babolat or to prevent Babolat from selling on-line, but there is no evidence of this. Prince may have adopted the “racketscience.com” domain name to create confusion and attract people to its web page. Indeed, its use of the disclaimer suggests it was well aware of this possibility. Prince also had constructive notice of the RACKET SCIENCE! mark because it registered the domain name after Babolat registered its mark at the PTO.

Babolat likely could obtain the right to use the racketscience.com domain name, but not the rocketscience.com name. Babolat could also use the ACPA in federal district court. Babolat would only be able to pursue an in personam cause of action, and not the arguably more potent in rem jurisdiction, because it
likely can get personal jurisdiction over Prince because Prince is in the US. Under the ACPA, a TM owner must show that (1) defendant had a bad faith intent to profit from the mark, (2) defendant has registered, trafficked, or used a domain name that (a) if distinctive is identical or confusingly similar or (b) if famous, is identical, confusingly similar, or dilutive.

As discussed above, it seems unlikely Babolat’s RACKET SCIENCE! mark would be considered famous for these purposes, so it would have to show that the domain name is identical or confusingly similar. The likelihood of confusion analysis above confirms that, in fact, the domain name is confusingly similar. The bad faith factor would be similar to the analysis under the UDRP, and likely Babolat would only win as to racketscience.com.

**Question 2.**

B would have standing to bring a false advertising claim because B is a direct competitor of Prince. This is because competitors are more likely to monitor ads. But, B would have to show some sort of harm such as lost sales. Its difficult to see how the misrepresentation of the racket would impact Babolat’s sales – consumers probably still want Lleyton’s racket. Consumers do not have standing to bring such an action, however.

To prove false advertising under the Lanham Act, the plaintiff must show:

(a) a false statement of fact by the defendant in a commercial advertisement about its own or another product;

(b) the statement actually deceived or has the tendency to deceive a substantial segment of the audience;

(c) materiality

(d) the defendant cause the false statement to enter interstate commerce;
(e) the plaintiff has been or is likely to be injured as a result of the false statement by a
diversion of sales or loss of goodwill.

Prince clearly satisfies requirement (a) because it engaged in commercial advertising by
making these claims in ads which are (1) commercial speech used to sell Prince’s products; (2)
by a defendant who is in commercial competition with plaintiff, (3) Prince used this to influence
consumers to buy its goods, and (4) this is disseminated sufficiently to the relevant public as ads.
Therefore, there is commercial advertising.

There are two types of false statements of fact: literally false and implicitly false. Here
the ad makes the statement that Hewitt uses the 2003 Saber, either by showing Hewitt playing
with the racket or saying he grabs it or that it’s his choice. This is literally false because Hewitt
actually plays with the 2001 Saber. Also, even if the ad just showed Hewitt playing with the
racket, it would be literally false by necessary implication.

Under the “roach bait” case, if a statement is literally false, then there is a presumption
that consumers were deceived. This presumption also applies if Prince had an intent to deceive.
Prince likely had such intent because Prince probably knew that Hewitt painted his racket.
Whether this presumption is conclusive or rebuttable is the subject of a circuit split. However,
there is no evidence that Prince can rebut, so the second element is satisfied.

Materiality also must be shown, i.e. that the deception is material in the purchaser’s
decision to buy the good. Babolat will argue that this deception is material because consumers
of sporting equipment are often influenced by celebrity endorsements. People might choose a
different racket if they that the racket Hewitt actually used was not for sale any longer. Of
course, generally materiality and the falsehood deals with some aspect of the quality of the good,
not simply which good is being endorsed. See, e.g.,Cashmere case. There is no deception about
the quality of the good. To say that endorsement alone makes the deception material would seem to create a bright line rule – all celebrity endorsements are per se material. Perhaps endorsement should not be enough to be considered material – we may not want to encourage protection of such advertising in all cases. But, in the absence of case law to the contrary, materiality likely is satisfied.

Element (d) is easily satisfied, but Babolat could have difficulty with element (3) because Babolat and Prince are not in the same market. If consumers forego the Saber, they will purchase another high-end racket.

**False endorsement.** There could be some argument that this is false endorsement, although the falsity is a bit different. Typical false endorsement arises when an ad suggests a product is endorsed by someone who actually does not endorse it. Frito-Lay, Tom Waits examples. Here, Hewitt *does* endorse Prince (they are definitely paying him), but the falsehood involves which racket. As such, a true false endorsement claim likely does not lie.

**False ad for MORE POWER. MORE STABILITY. MORE TROPHIES.** This is likely non-actionable puffery. *Cf.* Pizza Hut v. Papa John’s. No one would believe that buying a racket would guarantee more trophies – its more akin to an opinion that a statement of fact.
Section II

Question I.

From the perspective of the triumvirat, surrogate use can be argued for and against. Using the example of Coca-Cola, from the perspective of consumers, consumers have already associated the use of Coke with Coca-Cola. Allowing someone else to have priority would potentially create consumer confusion. Therefore, consumers are best protected by allowing the surrogate use to give priority to the later user.

From the perspective of the original producer, surrogate use is a good thing because it can be used to prevent people from free-riding off of a variant of the producer’s mark. This encourages producers to invest in their marks because they know that if the public commonly refers to the producer via a nickname, the producer will also get the benefit of that name. Of course, if the nickname becomes the name for a product generally, and not the producer’s specific product, the producer does risk the mark becoming generic.

From the perspective of competitors, surrogate use is undesirable. Surrogate use forecloses competitors from using a mark that they were actually the first to adopt. Additionally, up until the producer’s mark becomes generic, this may force the competitor to use a mark that is very different than what consumers may use to refer to a class of goods. There, surrogate use is anticompetitive because it allows a producer to claim rights in a mark that the producer was not the first to use and in which they invested potentially no resources. Competitors may be forced, therefore, to steer widely around a well-known producer’s mark in adopting competitive marks.

Finally, “surrogate use” also begs the question of whether this is a use under the Lanham Act at all. The Lanham Act technically requires a use in commerce, which for goods requires a mark be attached to a good generally. In surrogate use cases, there may have been no such use
(e.g. Coke being used as a nickname) yet trademark rights arise. It would seem that surrogate use potentially lies outside the scope of the Lanham Act.

**Question 2.**

The role of design patents is similar to trade dress protection. Design patents do not give protection to functional aspects of the design and instead only protect ornamental features, which are the type of features that Traffix said would not be considered evidence of functionality when considering the existence of an expired utility patent.

Additionally, the ordinary observer test for infringement of a design patent seems similar to the test for infringement of trade dress. The ordinary observer test seems to be the test for direct confusion. The purchasers of the infringer’s goods think they are purchasing the goods of the person with the design patent (similar to passing off).

However, design patents and trade dress protection are different. Design patent protection is for a limited time whereas trade dress protection can conceivably last forever. Additionally, design patents focus on confusion between the products as opposed to confusion over the source of the products. Further, the point of novelty test essentially requires dissection of the design to look at the features of the design that make it distinct from previous designs. Trade dress protection looks at the trade dress as a whole (anti-dissection) to determine if there is confusion.

Design patent protection should preclude trade dress protection otherwise the distinction between the two would essentially be meaningless. When a person applies for a design patent, they are exchanging the exclusive period of 14 years for the right to exclude others from using that design. The design patent holder would be getting around this bargain if he could resurrect essentially the same protection using trade dress. After a design patent expires, the covered
material should go into the public domain. This is similar to *Vornado*, where the court found that, even though the dress was not functional, the existence of the expired patent suggested strongly that the device enter the public domain. This encourages competition and the development of designs because others will then be free to use the design to sell their own products. The producer will be disadvantaged because others will not be able to free ride off the goodwill that the producer has established in the design. However, the producer is free to continue using its design or to modify its design to include new elements and get another design patent. The negative is that refusing to allow trade dress protection after design patent protection may discourage people from applying for design patents or may discourage people with design patents from investing heavily in their trade dress. However, 14 years is a long time in the marketing world, so a producer may need to change its design to keep up with the times anyway.

This policy may increase consumer confusion however because consumers may now associate the design with the design patent holder. If consumers associate the design with the design patent holder and then others are allowed to enter with the same design after 14 years, then consumers will likely be confused. However, prohibiting trade dress protection after an expired design patent might benefit consumers because they may eventually see more and better (and cheaper) designs because competitors will be more likely to build off of the design that entered the public domain. Indeed, even for utility patents, we accept consumer confusion under functionality – simply because it is functional does not mean that the design has not achieved secondary meaning. Consumers may be confused, but we consider other concerns (the patent quid pro quo) to outweigh that confusion.