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Finnegan's monthly review of essential decisions, key developments, evolving trends in trademark law, and more.

November 2009 Issue

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Civil Cases

***City of Carlsbad v. Shah,* 2009 WL 3398785 (S.D. Cal. Oct. 20, 2009)**

by Lynn M. Jordan

ABSTRACT

The Southern District of California found the absence of *objective* evidence of defendant's intent to use his marks in commerce at the time the applications were filed to be sufficient proof of a lack of a bona fide intent for a grant of summary judgment declaring the applications invalid and authorizing the PTO to deny registration to defendant.

CASE SUMMARY

FACTS

Plaintiff City of Carlsbad ("City") announced at a public meeting that it had selected the name THE CROSSINGS AT CARLSBAD for its new golf course. That same day, and in the following weeks and months, defendant Shah, who had attended the meeting but had no formal relationship with the City or experience in the golfing industry, registered domain names containing the mark and filed a series of intent-to-use applications for the marks THE CROSSINGS AT CARLSBAD and TCAC for clothing, golf balls, golf courses, golf clubs, and golf tees. After the City presented the official logo for the golf course at a subsequent public meeting, defendant filed an intent-to-use application for a nearly identical logo. The City subsequently filed its own applications for the marks.

The City sued Shah, alleging copyright infringement, cybersquatting, and unfair competition, and sought a declaratory judgment as to who holds trademark rights in the various marks at issue. Shah counterclaimed, seeking a declaration that his rights were superior to the City's and an injunction prohibiting the City from using the marks.

At issue before the court was the City's motion for partial summary judgment, contending that Shah's claim for relief for declaratory judgment regarding trademark rights presented no genuine issue of material fact.

ANALYSIS

In response to the City's motion for summary judgment, Shah, relying on prior TTAB and Federal Circuit cases, contended that the factual question of his intent was inappropriate for summary judgment. Shah

relied heavily on the TTAB's statement in *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1502 (T.T.A.B.1993) that "as a general rule, the factual question of intent is particularly unsuited to disposition on summary judgment." The court noted, however, that more recent TTAB cases indicated that summary judgment would be appropriate if an applicant fails to produce any documentary evidence of bona fide intent to use a mark. Specifically, the court held that Shah must produce either (1) objective documentary evidence of his intent to use the marks in commerce or (2) a valid explanation as to why no evidence was produced under a totality of the circumstances analysis.

Shah expressly acknowledged in his interrogatory answers that he had no evidence of his intent to use the marks other than the applications themselves. Instead, Shah directed the court to his own statements in those applications, declaring an intent to use the marks, as proof of such intent. The court was not persuaded, however, finding Shah's statements to be subjective, rather than objective, evidence of intent and thus not sufficient to defeat the motion for summary judgment.

The court was equally unmoved by Shah's proffer of facts explaining the lack of documentary evidence. Shah contended that he made a business decision not to proceed with commercial activities until a legal dispute over the mark had been resolved. The court noted that this did not explain the failure to have any such documentary evidence of his intent at the time the applications were filed.

Consequently, the court found Shah's failure to produce any documentary evidence of his intent to use the mark in commerce sufficient to grant summary judgment in favor of the City. The court ordered the PTO to deny registration to defendant's pending applications, declared plaintiff the rightful owner of the marks, and authorized the PTO to register the plaintiff's pending applications.

CONCLUSION

This decision highlights the importance of documenting activities taken in furtherance of an applicant's intention to use an applied-for mark in commerce. If challenged, mere testimony will not be sufficient. Objective evidence such as business plans, purchase orders, invoices, bank statements, and written correspondence should be preserved and maintained.

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Civil Cases

In re 1800MATTRESS.COM IP, L.L.C., 2009 WL 3681828 (Fed. Cir. Nov. 6, 2009)

*by Katherine L. Staba**

ABSTRACT

Applicant's attempt to register MATTRESS.COM on the Supplemental Register for online retail store services for mattresses, beds, and bedding was rejected by the TTAB. The TTAB found that MATTRESS.COM was generic, because the relevant public would understand the compound term to refer to the genus of Applicant's services, namely online mattress retailers. The Federal Circuit affirmed, finding that substantial evidence supported the TTAB's conclusion that the mark was generic for Applicant's services.

CASE SUMMARY

FACTS

Dial-A-Mattress, later substituted by 1800Mattress.com IP, L.L.C. ("Applicant"), applied to register the mark MATTRESS.COM on the Supplemental Register for "online retail store services in the field of mattresses, beds, and bedding." The Examining Attorney rejected the term as generic under Section 23 (c). On appeal, the TTAB affirmed the refusal to register, agreeing with all of the Examiner's conclusions except his identification of the genus of Applicant's services. The TTAB instead adopted Applicant's recitation of its genus—online retail store services in the field of mattresses, beds, and bedding, explaining that the relevant public would understand MATTRESS.COM to refer to this genus. Examining the component terms individually, the TTAB concluded that the term "mattress" identified a key focus of Applicant's services and thus was generic for its services. The TTAB also found that the addition of ".com" to "mattress" did not alter its generic nature "because it did not create any additional meaning." In reaching this conclusion, the TTAB relied on a dictionary definition of ".com" and competitors' internet addresses ending in "mattress.com," both indicating that consumers would recognize MATTRESS.COM as signifying a commercial website focusing on mattress retail services. The TTAB also agreed with the Examiner's rejection of Applicant's arguments that ".com" evoked the words "comfortable" or "comfort" and that MATTRESS.COM functioned as a mnemonic, creating a memorable way to reach Applicant's website. In response to the TTAB's holding, Applicant appealed to the Federal Circuit.

ANALYSIS

On appeal, Applicant argued that the TTAB's conclusion that MATTRESS.COM was generic was not

supported by substantial evidence. Contending that the correct generic term for online retail store services featuring mattresses was “online mattress stores,” Applicant argued that the TTAB did not show that the public refers to Applicant’s services as MATTRESS.COM. Applicant also argued that the TTAB ignored evidence that MATTRESS.COM was used in domain names for businesses selling mattresses in-person and thus outside the scope of the genus. Claiming that the TTAB only analyzed the component parts of the mark to find the mark was generic, Applicant reasoned that failing to look at the mark as a whole was in error. Finally, Applicant argued that the TTAB incorrectly disregarded Applicant’s contentions that MATTRESS.COM functioned as a mnemonic and as an indicator of comfort in mattresses.

The Federal Circuit affirmed the TTAB’s holding, finding that substantial evidence supported the decision. The critical issue in determining if an alleged mark is in fact generic, according to the court, is “whether members of the relevant public primarily *use or understand* the term sought to be protected to refer to the genus of goods or services in question.” The court recounted the TTAB’s inquiry into public understanding by reviewing the terms “mattress” and “.com” individually and in combination. As the generic nature of each component term was not disputed, the Federal Circuit reviewed the TTAB’s findings regarding the term as a whole. The court affirmed the TTAB’s finding that the combination MATTRESS.COM did not add any new meaning beyond those of its component terms. The Federal Circuit further affirmed the TTAB’s reliance on both the common meanings of the individual terms and the prevalence of MATTRESS.COM in internet addresses of other mattress retailers providing services similar to Applicant’s. In fact, the court commented that the TTAB’s reasoning tracked that of the Federal Circuit’s April 2009 decision in *In re Hotels.com*, 573 F.3d 1300 (Fed. Cir. 2009), in which the Federal Circuit gave controlling weight to third-party use of “hotel” with a “.com” suffix for similar services, and to common meanings and dictionary definitions of the component terms. Finally, Applicant’s contention that some websites containing “mattress.com” in their domain names do not actually sell mattresses was discounted by the court. The court reasoned that, even if such use occurs, “‘mattress.com’ is still *primarily* used to identify services in the same genus as [Applicant’s] services,” a commercial website featuring the retail sale of mattresses.

The Federal Circuit also disagreed with Applicant’s assertion that the public would not use the term MATTRESS.COM to refer to online mattress retailers. The court reiterated that the proper inquiry is not whether the term is *used*, but rather whether the public would immediately *understand* that MATTRESS.COM refers to online mattress retailers. Such understanding alone is sufficient to render the term generic. Moreover, the court rejected Applicant’s contention that there can only be one generic term for the services, and that the applicable term was already established to be “online mattress stores.” Again clarifying the test, the court closed the door to Applicant’s restrictive interpretation by stating that “any term that the relevant public understands to refer to the genus” is generic.

Finally, the Federal Circuit agreed with the TTAB’s conclusion that the “.com” in MATTRESS.COM does not evoke the comfortable quality of mattresses, nor does MATTRESS.COM function as a mnemonic memory device. The court noted that Applicant submitted no evidence to support either assertion. Accordingly, no evidence supported holding that “.com” suggested anything other than a commercial internet domain. However, the court left open the possibility that evidence could be presented to confer meaning to a top level domain indicator (“.com”) beyond merely as a commercial internet domain. The Federal Circuit affirmed the TTAB’s holding that MATTRESS.COM is generic for Applicant’s services.

CONCLUSION

This decision confirms the holding of *In re Hotels.com* that the relevant inquiry in determining whether a

mark is generic for its genus of services is not limited to whether the relevant public uses that term, but also considers whether the public understands the term to refer to the genus. This decision also highlights that, while adding a top level domain indicator (".com") does not necessarily transform a generic term into a nongeneric mark, evidence that ".com" evokes more than merely a commercial internet domain may, in fact, have such a transformative effect.

* *Katherine Staba is a Trademark Law Clerk with Finnegan.*

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Civil Cases

The Cold War Museum, Inc. v. Cold War Air Museum, Inc., 2009 WL 3644936 (Fed. Cir. Nov. 5, 2009)

by Linda K. McLeod and Stephanie H. Bald

ABSTRACT

Respondent obtained a registration under Section 2(f) for the mark THE COLD WAR MUSEUM. During the prosecution of that registration, Respondent had submitted a declaration stating that the mark had been in use for at least five years, as well as over two hundred pages of evidence to support his contention that the mark had acquired distinctiveness. Petitioner sought to cancel the registration on the ground that it was merely descriptive. The TTAB granted the petition to cancel finding that Petitioner had proven that the mark was descriptive and had not acquired distinctiveness, and that Respondent had failed to prove acquired distinctiveness on the record before the TTAB because, among other things, Respondent had failed during the cancellation proceeding to resubmit the evidence of acquired distinctiveness filed during the prosecution of the registration. The Federal Circuit reversed the TTAB's decision, finding that the entire PTO file for the subject registration was automatically of record during the cancellation, and Petitioner had not established a prima facie case that the mark had not acquired distinctiveness.

CASE SUMMARY

FACTS

Respondent The Cold War Museum, Inc. ("Respondent") applied to register the mark THE COLD WAR MUSEUM under Section 2(f). The Examining Attorney initially refused registration on the ground that the mark was merely descriptive. To overcome the refusal, Respondent filed a declaration stating that the mark had been in use for at least five years, as well as over two hundred pages of evidence in support of its claim of acquired distinctiveness. Based on this evidence, the Examining Attorney concluded that the mark had acquired distinctiveness and allowed the application to proceed to registration.

Three years later, Petitioner Cold War Air Museum, Inc. ("Petitioner") sought to cancel the registration for THE COLD WAR MUSEUM on the ground that it was merely descriptive. Petitioner alleged that the words "the cold war museum" were merely descriptive for museum services relating to the Cold War and submitted a list of search engine results allegedly evidencing the public's understanding of the term "cold war." Petitioner also submitted excerpts from the Respondent's website and brochure to show that the museum's contents and exhibits all related to the Cold War. Respondent countered that the PTO had

previously found that the mark had acquired distinctiveness, and the mark was presumed to be valid. Further, Respondent argued that Petitioner had presented no evidence showing that the mark should not have been allowed registration under Section 2(f). Respondent did not resubmit the evidence of distinctiveness that had been filed during the prosecution of the registration.

The TTAB granted the petition to cancel, finding that consumers viewing the mark would understand The Cold War Museum to contain artifacts and information relating to the Cold War, and that Petitioner had therefore proven that the mark was merely descriptive. The TTAB then shifted the burden to Respondent to overcome the descriptiveness finding and, although the TTAB recognized that Respondent had submitted evidence of the mark's distinctiveness during prosecution, held that it could not consider this evidence because Respondent did not resubmit it in the cancellation proceeding. The TTAB thus concluded that the Respondent had not proven acquired distinctiveness on the record and granted the petition to cancel.

ANALYSIS

On appeal, the Federal Circuit found that 37 CFR § 2.122(b) clearly and unambiguously provides that the record in a cancellation automatically includes the *entire* file of the registration at issue. 37 CFR § 2.122 (b) states:

(b) Application files. (1) The file . . . of the application against which a notice of opposition is filed, or of each registration against which a petition or counterclaim for cancellation is filed forms part of the record of the proceeding without any action by the parties and reference may be made to the file for any relevant and competent purpose.

This, according to the Federal Circuit, includes any evidence submitted by the applicant during prosecution. Accordingly, the Federal Circuit found that the TTAB had erred in refusing to consider the evidence of acquired distinctiveness submitted by Respondent during prosecution. In addition, the Federal Circuit found that the TTAB had erred in finding that Petitioner had established a prima facie case that the mark had not acquired distinctiveness. The Court explained that all of the evidence submitted by Petitioner related to the mark's descriptiveness; none of it related to the issue of acquired distinctiveness. Because Petitioner had not rebutted the registration's presumption of validity, the Court also found that the TTAB had erred as a matter of law in shifting the burden to Respondent to prove that the mark had acquired distinctiveness. Thus, the Federal Circuit reversed the TTAB's decision, which found that the mark THE COLD WAR MUSEUM had not acquired distinctiveness and had ordered the cancellation of the registration.

CONCLUSION

In TTAB proceedings, the entire file for the subject application or registration, including all evidence submitted during the prosecution of that application or registration, is automatically of record and need not be resubmitted.

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Univ. of Alabama Board of Trustees v. New Life Art Inc., CV 05-UNAS-PT-585-W (N.D. Ala. Nov. 2, 2009)

*by Dana M. Nicoletti**

ABSTRACT

The University of Alabama Board of Trustees sued a previously licensed painter for his use of the University football team's uniform colors in his paintings, claiming that the colors were protectable trade dress. The court held that the University did not have a protectable interest in the uniform colors and that the painter was permitted to use the colors in his artistic works to accurately depict historic football scenes. However, the painter could not use any of the University's trademarked logos or symbols in his paintings or reproduce his paintings onto any merchandise other than high-quality prints.

CASE SUMMARY

FACTS

Plaintiff University of Alabama Board of Trustees ("UA") is responsible for oversight of the University of Alabama ("the University"). Defendant New Life Art, Inc. ("New Life") represents the business interests of Daniel Moore ("Moore"), a successful sports artist who paints high-quality artistic renderings of notable University football team events. Moore's first such painting was sold in 1979, and he signed a licensing agreement with UA in 1991. The licensing agreement continued until 2000, when New Life and Moore decided that Moore's paintings did not require a license from UA. UA disagreed, arguing that the University's team uniform colors of crimson and white were its protectable trade dress, and Moore could not sell paintings depicting these uniform colors without a license. UA filed suit against New Life and Moore for trademark infringement, seeking royalties from more than twenty of Moore's paintings and demanding that Moore license any future paintings. Both parties filed motions for summary judgment.

ANALYSIS

The district court issued a memorandum opinion holding that UA did not have trademark rights in the football team colors, and thus New Life and Moore did not require a license to use the colors in Moore's paintings. The court examined the previous licensing agreements between the parties, which provided that "The University of Alabama is the owner of all rights, title and interest in and to the following Indicia which includes trademarks, service marks, trade names, designs, logos, seals, and symbols" and displayed images of various logos, seals, and symbols. The items "Verbiages" and "Colors: Crimson PMS 201 Gray PMS 429" were listed above the images. From this language, the court inferred that the

color restrictions only applied to any licensed use of the *listed* images, and could not be read as a prohibition on the use of those colors in other ways (i.e., in Moore's paintings). The court also rejected UA's position that its alleged trade dress comprised of the uniform colors was inherently distinctive and a strong mark, while noting that the trade dress may have acquired secondary meaning "in some quarters." The court noted that crimson is a common variation of the red color used by many sports teams and that the colors serve a functional purpose of distinguishing the team from its opponent.

The court then criticized UA's likelihood of confusion survey results as suggestive and misleading, and disagreed with UA's conclusion that consumers mistakenly believed that Moore's paintings were sponsored by the University. The court stated that people who buy Moore's paintings likely do so because of their loyalty to the University and its football team, but this does not create a reasonable inference that they buy the paintings because of the uniform colors or that they do not know that Moore is the "moving force" behind the paintings. The court went on to note Moore and New Life's evidence of good faith based on the use of their own marks to indicate the source of the paintings. The court reasoned it would be clear to any purchaser that the paintings were created by Moore and sold by New Life.

Further, the court made note of the First Amendment protections likely applicable to Moore and New Life's use of the colors, especially considering that UA is a public university and thus a "governmental entity." Even if there was some likelihood of confusion, the *Rogers v. Grimaldi* test mandates that the Lanham Act may only apply to artistic works when the public interest in avoiding confusion outweighs the public interest in free expression. Since the court did not find that consumers would likely be confused as to the source of Moore's paintings, the *Rogers* test favors Moore's artistic speech.

The court went on to clarify the implications of its holding, stating that Moore's use of the uniform colors in his artistic paintings did not violate the Lanham Act because the colors were used to correctly depict the chosen scene. However, the court cautioned that use of the colors on nonartistic products (e.g., mugs, T-shirts, posters, etc.) would not be allowed. The court stated that Moore and New Life are not permitted to reproduce the paintings on any non-artistic products or as smaller-sized paintings or prints of lesser quality. Further, the court's holding only extends to the use of the uniform *colors* in artistic paintings and prints; such works cannot incorporate any use of UA's logos, symbols, or seals without potentially infringing UA's trademark rights.

The court granted Moore and New Life's motion for summary judgment with regard to its artistic expression, First Amendment, and fair-use defenses. The parties were permitted to submit suggested final judgments consistent with the court's opinion.

CONCLUSION

This decision provides some guidance on the allowable uses of sports-team colors in unlicensed merchandise. The court here does not find team uniform colors to be strong or inherently distinctive trade dress and permits their use in situations where the correct colors are necessary to accurately depict the team at historical games. The court places a distinction between the permitted use of the colors on artistic works, in contrast to nonartistic merchandise, and also cautions against the use of trademarked logos or symbols in artistic works.

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Unregistrable

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by Robert D. Litowitz

Where do sharp-dressed, boozing, chain-smoking, womanizing, adulterous executives happily coexist with trademarks? In the fictional offices of Sterling Cooper in Matthew Weiner's delicious creation, the television series *Mad Men*, which just wrapped its third tour de force season on the cable network AMC. At Sterling Cooper, a team of Madison Avenue advertising men—Mad Men—along with one gifted woman copywriter who defies convention by going “toe-to-toe” with the boys, cooks up campaign after campaign for brands real and imagined in the heady days of early-1960's Manhattan. But unlike previous, happy depictions of New York office life from that era, such as *How To Succeed In Business Without Really Trying*, everything is decidedly darker in *Mad Men*. For one thing, Robert Morse, the eager young actor who portrayed the ladder-climbing Finch in *How To Succeed* is, fifty years later, cast as Sterling Cooper's eccentric, world-weary patriarch. And the darkest twist by far involves Don Draper, Sterling Cooper's enigmatic creative director, who is the living and breathing embodiment of the art and alchemy that is advertising. Repulsed by his own Dickensian past, and given the chance to assume a new identity when he and his battlefield buddy are both taken for dead, the character takes on his first and grandest ad campaign by literally rebranding himself.

But while *Mad Men's* richly layered characters and stories are surely responsible for most of the series' critical acclaim, trademarks have been supporting actors worthy of an Emmy® nomination. Over the course of three seasons, Sterling Cooper's creative team has launched campaigns for Lucky Strike® cigarettes, American Airlines®, London Fog® raincoats, Aqua Net® hairspray, Utz® potato chips, and even some bygone brands like Admiral® TV and Patio® cola. As one observer shrewdly notes, one brand that is probably glad it wasn't featured is John Deere®; a recent episode showed a rampaging lawn tractor severing the foot of an unctuous bean counter as the Sterling Cooper creative crew looks on in bemused horror.

Like any client-oriented service profession, Sterling Cooper's triumphs are tempered by some notable failures. After following the client's orders to mimic Ann Margaret's performance in *Bye Bye Birdie* for a musical ad for a new Pepsi® diet cola, and delivering a picture-perfect facsimile, Sterling Cooper loses the account when the fickle client changes its mind. And after relentlessly wooing Hilton® hotels by responding to its idiosyncratic founder Conrad Hilton's every beck and call, Don Draper loses the account by failing to take seriously “Connie” Hilton's demand for a campaign showing a Hilton on the moon.

It's almost as comforting to see that the legal profession doesn't have a monopoly on demanding clients

as it is to see trademarks take center stage on the small screen.

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