

MUTATING MARKS: REFUSING TO LOSE THE TRADEMARK TRAIL

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ABSTRACT

This article examines and synthesizes several criticisms underlying the expansion of trademark rights. The spectrum of distinction used to grant and organize marks is discussed, and the abandonment of trademark law's foundations is illustrated. This allows us to consider how to reinvigorate commitment to essential trademark jurisprudence.

The first Section reviews a few fundamental concepts underlying and organizing the trademark system. Sections II and III detail different considerations that emerged in step with the expansion of a trademark's purpose far beyond that of a source signifier. They address matters, such as inherent goodwill, that have been largely ignored to the detriment of the public interest, and others, such as functionality, that have not been applied to their full, logical extent.

Section IV discusses the influence mark holders have had in shaping this progression—one of lowering requirements and escalating powers—and it considers the unreasonable consequences thereof. Finally, Section V indicates how courts and regulatory agencies may bring a significant portion of the trademarks, which have gone awry, back into the fold. Estoppel and a reconstituting of stronger evidentiary standards can help to ensure powerful mark holders seeking legal support for their market dominance actually meet high burdens to do so. The current trademark law framework leaves too much power in some mark holders' hands, but it contains the seeds for innovative parties and lawyers to create more sensible trademark policies.

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I. TRADEMARK BACKGROUND

Trademarks have a long past, rooted in product association with makers and owners, as – for example – ancient artists signed their pottery and early ranchers wielded their cattle prods.¹ The law of trademarks naturally aligns with business, and one could argue that marketing (specifically, branding) and trademarks are inseparable.

A. Justifications

The trademark’s purpose always has been to indicate the origin or source of commercial goods.² Protection in American law is based upon a trademark’s informative value to

¹ Sidney A. Diamond, *The Historical Development of Trademarks*, 73 TRADEMARK REP. 222, 222 (1983); see TONY MARTINO, TRADEMARK DILUTION 18-22 (1996) (discussing the origins of proprietary marks in practice and law from ancient times through the Middle Ages).

² Diamond, *supra* note 1, at 222.

consumers.³ Previously, such marks represented a consistent source of goods, expressed the quality conveyed to consumers, and protected consumers from being misled. As the implied “expressive content” that these marks contained grew, theories justifying their existence expanded to include the marks’ ability to reduce consumers’ search costs with their symbolic information. This greater economic efficiency meets two worthy objectives of legislation by benefiting both consumers and the free market as a whole.⁴

Businesses were also empowered by mark rights, which served as useful tools allowing them both to build reputations and to expand through the mark’s growing influence. As a consequence, advantages also accrued to the market, as better-informed consumers could more easily recognize high-quality producers. However, much of trademark expansion has been driven by the incorrect notion that trademark rights are intended to serve the producer’s interest, disembodied from concerns of the consumer and thus of society and markets overall.⁵ Especially as businesses are, overwhelmingly, the main participants in doctrine-shaping activity, their interests frequently have come to overshadow the basic goals of trademark law.⁶

B. Uniqueness among Intellectual Property

The original purpose of trademarks is unique among the three major domains of intellectual property: trademark, copyright, and patent law. Those domains have been justified by

³ Ralph S. Brown, Jr., *Advertising and the Public Interest Legal Protection of Trade Symbols*, 57 YALE L.J. 1165 (1948), reprinted in 108 YALE L.J. 1619 (1999).

⁴ William P. Kratzke, *Normative Economic Analysis of Trademark Law*, 21 MEMPHIS ST. U. L. REV. 199 (1991).

⁵ Mark A. Lemley, *The Death of Common Sense*, 108 YALE L.J. 1687 (1998).

⁶ See Brown, *supra* note 3, at 1167 (“[W]hat appear to be private disputes among hucksters almost invariably touch the public welfare. We shall therefore be concerned to ask, when courts protect trade symbols, whether their decisions further public as well as private goals.”).

incentivizing a social benefit. Patented inventions and copyrighted expressions of creative work are thought to enrich society *prima facie*. Granting limited, exclusive rights to inventors and creators offers the possibility of profit, which encourages contributions to society.⁷ Trademark value does not stand alone in this way. However, only the informational link implied by the mark is meant to be protected by law. In this context, it is unsurprising that trademarks are the only form of intellectual property granted an unlimited lifespan of protection. There is no inherent value being kept from the rest of society since these marks are simply transmitting source information.⁸ For copyright and patent law, ownership is finite and put to rest after fair compensation, which allows work to subsequently enter the public domain, for free use by all.⁹

This difference of purpose also leads to other distinguishing features of trademark law among intellectual property. In the *Trade-Mark Cases*, referring to copyright standards, the Supreme Court ruled that “originality is required.”¹⁰ Even more bluntly, the patent statute¹¹ states that non-obviousness is a pre-requisite for protection. However, trademarks lack a similar condition of originality. An idea–expression dichotomy also defines forms of intellectual property except trademark.¹² Copyright law stipulates protections as limited to a fixed expression of the creative work, and patents take the form of precisely detailed instructions for making and

⁷ World Intell. Prop. Org., *What is Intellectual Property?*, WIPO PUBLICATION NO. 450(E) (2004).

⁸ For an argument on such a public interest given the modern relationship between trademarks and the public, see Jessica Litman, *Breakfast with Batman: The Public Interest in the Advertising Age*, 108 YALE L.J. 1717 (1999).

⁹ World Intell. Prop. Org., *supra* note 7.

¹⁰ *Trade-Mark Cases*, 100 U.S. 82, 94 (1879).

¹¹ 35 U.S.C. § 103 (2011).

¹² Abraham Drassinower, *A Rights-Based View on the Idea/Expressions Dichotomy in Copyright Law*, 16 CANADIAN J. L. & JURIS. 3 (2013).

using the physical invention. No intellectual property rights are granted to an idea alone. Though trademark applications require a mark's physical nature to be fully described, from design and placement, there is a lack of verbatim restrictions to a singular form of the mark. Indeed, "standard character" marks may encompass ownership of a word or phrase "without claim to any particular font style, size, or color."¹³

These distinctions from the other breeds of intellectual property all stem from trademark's nature as a conduit of information rather than a creation itself. However, as marks have largely become treated as valuable objects themselves,¹⁴ the lack of borders for these protected expressions has allowed trademarks to escape the bounds of their legal justification.

C. Spectrum of Distinctiveness

In granting trademarks, a spectrum of distinctiveness is applied.¹⁵ This determination is to be made in specific context of the goods at hand.¹⁶ At the top of the spectrum, and thus immediately registrable, are fanciful marks, original words or symbols, such as "Kodak."¹⁷ The next "inherently distinctive" and thus immediately registrable marks are arbitrary, where consideration of the context of use applies.¹⁸ These are "a known word used in an unexpected or

¹³ 37 C.F.R. § 2.52(a) (2016).

¹⁴ Justin Hughes, *Cognitive and Aesthetic Functionality in Trademark Law*, 36 CARDOZO L. REV. 1227, 1256 (2014).

¹⁵ *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (defining the categories of distinctiveness).

¹⁶ *Remington Prods., Inc. v. N. Am. Philips Corp.*, 892 F.2d 1576, 1580 (Fed. Cir. 1990).

¹⁷ *Interstellar Starship Servs., Ltd. v. Epix, Inc.*, 304 F.3d 936, 943 n.6 (9th Cir. 2002).

¹⁸ *Id.*

uncommon way” according to the Supreme Court.¹⁹ A common example of an arbitrary mark, such as Apple Computer,²⁰ is that it essentially creates a new homophone.

Finally, the last inherently distinctive class is the suggestive mark. Suggestive marks are not immediately descriptive of the product, but are at least a small “mental leap” beyond obviousness. There are other linguistic details that may negate registration, such as “the best beer in America” being held too broadly laudatory to effectively distinguish the product.²¹ A fine, but critical, line lies at the determination between suggestive and the non-inherently distinctive, merely descriptive marks.²² Trademark law has been clear—marks should not be a tool to silence competition in the marketplace.²³ Adjectives plainly describing a good’s nature must be available to all competitors to inform consumers about goods. Thus, descriptive marks are not registrable without proof of “acquired distinctiveness” in the public’s mind.²⁴

¹⁹ *Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 1340 (Fed. Cir. 2004) (citing *Interstellar Starship*, 304 F.3d at 943 n.6).

²⁰ See *Apple Trademark List*, APPLE (Dec. 15, 2016), <http://www.apple.com/legal/intellectual-property/trademark/appletmlist.html>.

²¹ *Boston Beer Co. Ltd. P’ ship*, 198 F.3d 1370, 1373-74 (Fed. Cir. 1999).

²² *Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 1340 (Fed. Cir. 2004).

²³ In fact, beyond the competitive values to be upheld by barring purely descriptive terms, in other commentary or cases outside the scope of this article, the use of trademark in creating an extremely strong, almost generic, brand name may be considered a factor in evaluating whether there is an unfair, monopolistic business practices. Richard A. Posner, *Intellectual Property: The Law and Economics Approach*, 19 J. ECON. PERSP. 57, 68 (Spr. 2005).

²⁴ 15 U.S.C. § 1052(f) (2015); U.S. PATENT & TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1212 (2017) ((hereinafter, “T.M.E.P.”), available at <http://www.uspto.gov/trademark/guides-and-manuals/tmep-archives>. (acquired distinctiveness or secondary meaning).

Outside this spectrum are generic terms²⁵ which are never registrable.²⁶ The test of genericism is if the relevant purchasing public understands the word as the genus of the goods.²⁷ In establishing the public's conception of the word's primary significance,²⁸ one can use a variety of sources, with dictionary definitions,²⁹ publications, and online search results among them. "Genericide"³⁰ is a looming possibility for all mark holders, which compels thorough protection of its mark usage by stopping third parties misusing it.³¹ Even a formerly distinct mark may become mentally reclassified to represent a whole genus of goods and put in peril of cancellation. This is why mark holders, to prevent meaning of a term from being altered, pursue perceived infringers. Even non-interested parties including the media are often reprimanded for "misuse" of a trademark that erodes its meaning, and holders themselves should be wary of destroying their rights by using their marks meaninglessly.

²⁵ See Vanessa Bowman Pierce, *If It Walks Like a Duck and Quacks Like a Duck, Shouldn't It Be a Duck?: How a "Functional" Approach Ameliorates the Discontinuity Between the "Primary Significance" Tests for Genericness and Secondary Meaning*, 37 N.M. L. REV. 147, 185 (2007) (arguing for integration of primary significance determination with genus determination for a more functional perspective).

²⁶ *Interstellar Starship Servs., Ltd. v. Epix, Inc.*, 304 F.3d 936, 943 n.6 (9th Cir. 2002).

²⁷ *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 990 (Fed. Cir. 1986).

²⁸ *In re Murphy Door Bed Co.*, 223 U.S.P.Q. (BNA) 1030, 1033 (T.T.A.B. 1984)("[T]he test of whether or not a word has a generic connotation is the primary significance that term has to the purchasing public.").

²⁹ See *In re Murphy Door Bed Co.*, 223 U.S.P.Q. (BNA) at 1031-32 (stating dictionaries "are credible evidence going to the perception of the term by the public").

³⁰ See Pierce, *supra* note 25.

³¹ See Kenneth L. Port, *Trademark Extortion: The End of Trademark Law*, 65 WASH. & LEE L. REV. 585, 589 (2008).

II. GOODWILL

Goodwill is “loyalty that a business earns from its customers.”³² Reputation-related advantage, the tendency of consumers to make repurchases,³³ and other hard-to-quantify definitions are all used in an effort to characterize goodwill. Goodwill is accounted for in financial statements at staggering amounts by some businesses,³⁴ so it is certainly a monetary reality. In modern consumer research—both as an accounting concept and as a consumer market reality—goodwill is of the utmost importance to protect.³⁵

A. Changing Nature

Goodwill has played a prominent role in the expansion of modern trademark law. While trademarks and implied goodwill were initially confined to a specific product only, trouble arose from misleading associative links. Aunt Jemima’s pancake mix became popular around 1900; by 1922 the name and jolly image had been co-opted by other companies to sell highly similar products, from flour to syrup. The judiciary set precedent by expanding Jemima’s trademark rights to protect “brand goodwill” beyond pancake mix to reach these closely related product

³² Robert W. Emerson, *Franchise Goodwill: Take a Sad Song and Make It Better*, 46 U. MICH. J.L. REFORM 349, 352 (2013) (citing court opinions and legal and business texts). For a more elaborate articulation, see Robert G. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86 B.U. L. REV. 547 (2005).

³³ *Id.* at 583.

³⁴ See generally *Financial reporting developments: Intangibles—Goodwill and other*, ERNST & YOUNG (2009), [http://www.ey.com/Publication/vwLUAssets/FinancialReportingDevelopments_BB1499_GoodwillIntangible_November_2009/\\$FILE/FinancialReportingDevelopments_BB1499_GoodwillIntangible_November%202009.pdf](http://www.ey.com/Publication/vwLUAssets/FinancialReportingDevelopments_BB1499_GoodwillIntangible_November_2009/$FILE/FinancialReportingDevelopments_BB1499_GoodwillIntangible_November%202009.pdf) (analyzing accounting standards for measuring goodwill on a company balance sheet).

³⁵ Posner, *supra* note 23. For criticism of how this priority arose, see Lemley, *supra* note 5.

categories.³⁶ The reasoning that these offerings were similar enough that consumers may be confused as to the source, or rely on Aunt Jemima's reputation in their decision-making, is convincing. It was also recognized that Aunt Jemima owners might be interested in branching out and taking their reputation with them into other business categories where they already had specialized interest and experience.

Expansion of goodwill's power has come with the reciprocal rise of licensing trademarks.³⁷ These agreements—sometimes called “naked licensing”—allow a third-party to utilize the mark in question, originally for identical products where the consumer's concern likely is not the product's literal source but its adherence to uniform quality standards; other producers are, of course, not free to misrepresent that they are the originating source itself, but these producers may be able to meet quality standards. What makes “naked licensing” naked, though, is the lack of any quality control by the trademark owner. If owners do not ensure anything about a product bearing their marks, the marks are essentially meaningless and are not serving a legitimate objective.³⁸

³⁶ Aunt Jemima Mills Co. v. Rigney & Co., 247 F. 407, 412 (2d. Cir 1917).

³⁷ See Irene Calboli, *The Case for a Limited Protection of Trademark Merchandising*, 2011 U. ILL. L. REV. 865 (2011).

³⁸ Rudolph J. Kuss, *The Naked Licensing Doctrine Exposed: How the Courts Interpret the Lanham Act to Require Licensors to Police Their Licensees & Why this Requirement Conflicts with Modern Licensing Realities and the Goals of Trademark Law*, 9 MARQ. INTELL. PROP. L. REV 361 (2005). Recently, this rather remote trademark restriction gained press coverage when Belgian-owned Budweiser temporarily “renamed” its flagship beer “America,” for the summer of 2016. Company representatives outright acknowledge this as a means to capitalize on patriotic contemporary events, from an Olympic games to a presidential election. While the packaging replaced its trademark with the word, no attempt was made to file for trademark protection. See Jessica Roy, *There's no law against Budweiser calling its beer 'America,'* LOS ANGELES TIMES (May 10, 2016, 7:59 PM), <http://www.latimes.com/business/la-fi-budweiser-america-trademark-20160510-snap-htlstory.html>.

Merchandising flipped the dynamics of licensing by utilizing the goodwill embodied in a mark to sell unrelated and promotional goods. Goodwill began to be treated as a property in its own right, as opposed to nebulous ideas.³⁹ The intent of protecting consumers from being misled by goodwill misappropriation took a backseat as goodwill's power was recognized. This transformed into a "right"⁴⁰ to profit off of goodwill, which was then conflated as a wholesale justification of trademarks' existence.

B. Inherent Goodwill

Minor statutory restrictions support a broader concept of goodwill. There is a prohibition on a mark which "consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof."⁴¹ This prohibition, in effect, ropes off official public icons from private use or control. This intuitively makes sense for public imagery, but also begs the question where the limits of this respect are drawn. Native Americans are granted a detailed system of trademark restrictions to

³⁹ See Jennifer E. Rothman, *Initial Interest Confusion: Standing at the Crossroads of Trademark Law*, 27 *Cardozo L. Rev.* 105 (2005). The mark holder's goodwill interests are often a paramount concern of courts ruling against trademark infringers. In *Facebook, Inc. v. Teachbook.com, LLC*, 819 F.Supp.2d 764 (N.D. Ill. 2011), the court upheld an infringement claim due to the defendant's misleading domain name: "one can imagine teachers searching the internet for www.facebook.com and hitting upon www.teachbook.com. And even though these same teachers might also read Teachbook's attempt to define itself as an alternative to Facebook, the initial interest stems from the *goodwill* associated with Facebook, not Teachbook." *Id.* at 783 (emphasis added).

⁴⁰ See Charles W. Grimes & Gregory J. Battersby, *The Protection of Merchandising Properties*, 69 *TRADEMARK REP.* 431, 432 (1979). To use *the Facebook, Inc. v. Teachbook.com, LLC* case (*supra* note 39) as an example, the focus would then be more Facebook's property interest than consumer's protection from misinformation.

⁴¹ 15 U.S.C. § 1052(b); see also *In re William Connors Paint Mfg. Co.*, 27 App. D.C. 389 (1906); LA. STAT. ANN. § 33:21 (2015) (regarding the official seal, insignia, symbol, emblem, coat of arms, or logo).

protect their cultural representations and totems.⁴² This is certainly not to say that such a system has been foolproof or effective: issues of the commercialization of meaningful terms into brands such as Jeep Cherokee, Mohawk Paper Company, and Crazy Horse Malt Liquor have been raised.⁴³ However, the statute reflects cultural protection, which is broader than the official seals of a nation, but theoretical boundaries are unarticulated.

This commercialization leads to the fundamental concept: inherent goodwill.⁴⁴ Some marks carry with them pre-existing value. If courts are to suspend disbelief and accept a goodwill protection-function of trademark law, and people should not “reap what they have not sown,”⁴⁵ then who is the rightful beneficiary when none have demonstrable proof of value “sown?” Levels of distinction implicitly acknowledge that, in language, “no term is an island,” since it must be considered in light of the particular product and audience, and because meanings are not monolithic. Suggestive marks⁴⁶ capitalize on pre-existing meanings of the word(s) in question, with an often minute but meaningful distinction rising above plain descriptiveness. A realistic

⁴² Brian Zark, *Use of Native American Tribal Names as Marks*, 3 AM. INDIAN L.J. 537 (2015).

⁴³ *WHAT’S IN A NAME? CAN NATIVE AMERICANS CONTROL OUTSIDERS’ USE OF THEIR TRIBAL NAMES?*, CULTURAL SURVIVAL (September 1994), <http://www.culturalsurvival.org/publications/cultural-survival-quarterly/united-states/whats-name-can-native-americans-control-outsiders-use>.

⁴⁴ See Bone, *supra* note 32, at 598 (“Inherent goodwill includes the public meanings associated with the mark itself, independent of the product to which it is connected and independent of any particular brand or firm.”).

⁴⁵ See Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV 397, 404 (1990) (discussing trademark law’s adoption of the “reap where one has not sown” concept for consumers claiming ownership of value in the marks).

⁴⁶As delineated by the spectrum of distinctiveness, *supra* I. C. Spectrum of Distinctiveness.

approach to trademarks would allow consideration of predominant mark meanings that might be equally strong as a dictionary definition, especially for relevant consumers.⁴⁷

C. Idioms and Atmospherics

An idiom, summarized from definitions given by Merriam Webster, is a grammatically peculiar expression, characteristic to the type of art, person, class, community, or area, with a separate meaning of its own, not contained in the separate words.⁴⁸ One that attracted national attention in the context of trademarks is “who dat.” First usage of this phrase dates back to late 1800s minstrel shows and poems, sticking around for the turn of the century to appear alongside jazz culture and, reflexively, blackface.⁴⁹ It was said to be a responsive catchphrase for World War II fighter pilots⁵⁰ before turning to a sports cheer⁵¹ at historically African-American high schools and colleges around Louisiana. In line with its musical origins, the phrase’s first documented association with the New Orleans Saints (a team in the National Football League (NFL)) came in 1983, when a New Orleans singer blended it alongside “When the Saints Go

⁴⁷ For a thoughtful look at how to interpret an audience’s interpretation of a mark, see Laura A. Heymann, *The Reasonable Person in Trademark Law*, WILLIAM & MARY LAW SCHOOL SCHOLARSHIP REPOSITORY (2008), <http://scholarship.law.wm.edu/facpubs/194>.

⁴⁸ *Idiom*, MERRIAM WEBSTER, <http://www.merriam-webster.com/dictionary/idiom>.

⁴⁹ Dave Walker, ‘Who Dat?’ Popularized by New Orleans Saints Fans When ‘Everybody was Looking for the Sign’, NOLA TIMES-PICAYUNE (Jan. 13, 2010, 7:16 AM), http://www.nola.com/saints/index.ssf/2010/01/who_dat_popularized_when_every.html.

⁵⁰ Erin Z. Bass, *Who is Who Dat?*, DEEP SOUTH MAGAZINE (Jan. 28, 2010), <http://deepsouthmag.com/2010/01/who-is-who-dat/>.

⁵¹ Amy Davidson, *The Strange Case of Who Dat*, NEW YORKER (Feb. 9, 2010), <http://www.newyorker.com/news/amy-davidson/the-strange-case-of-who-dat>.

Marching In” in a video with the NFL players.⁵² The term continues to bloom in African-American music, sans sports references. Among many others, it was rapped by a native of New Orleans, Lil Wayne, in “A Milli” in 2008.⁵³

The New Orleans Saints earned their first bid to the Super Bowl in 2010. That, in turn, led to a flurry of cease-and-desist letters—from the NFL to numerous Louisiana businesses—claiming the phrase as exclusive property of the NFL.⁵⁴ The league held those rights in Florida, where the championship game was to be held. “If ‘who dat’ is used in a manner to refer to Saints football, then the Saints own the rights” was the position of NFL spokespersons, extrapolating ownership to include a fleur-de-lis symbol or black and gold color scheme as well. The response was loud public indignation, ranging from bipartisan retorts by Louisiana public officials⁵⁵ to outcries against an NFL engaged in opportunistic cultural profiteering,⁵⁶ among many other

⁵² Dbg53, *Who Dat featuring Aaron Neville & the TopCats*, YOUTUBE (Dec. 20, 2009), <https://www.youtube.com/watch?v=WfEjZunhEvY> (documenting players’ excellent dancing and acknowledging the cheer as a “unique blend of New Orleans dialect,” as well as the Saints General Manager discussing genesis of the chant by fans) (“Every place we went last fall we’d see ‘who dat’ signs, we would hear the ‘who dat’ chant. Our players enjoyed it, and we thought ‘why not?’ And I think this will grow into something real big.”).

⁵³ LIL’ WAYNE, *A MILLI* (Cash Money Records 2008) (saying “who dat” at 2:25, despite Wayne’s public statements of support for the Green Bay Packers, not the Saints football team, in interviews available at <https://www.youtube.com/watch?v=C6mNpVzuerw>).

⁵⁴ Associated Press, *NFL Claims Trademark Infringement*, ESPN (Jan. 30, 2010), <http://sports.espn.go.com/nfl/playoffs/2009/news/story?id=4871697> (threatening production of “who dat say we can’t print who dat?” tee shirts in an open letter to NFL commissioner Roger Goodell from Senator David Vitter).

⁵⁵ *Id.* (“Please either drop your present ridiculous position or sue me.”).

⁵⁶ Jennifer Levitz, *Who Owns ‘Who Dat’? Dats Us Sez da NFL*, WALL ST. J. (Jan. 29, 2010, 12:01 AM), <http://www.wsj.com/articles/SB10001424052748703389004575033504283711006> (illustrating the cultural significance of the phrase; “The NFL, they contend, never cared about the quirky chant when the

complaints.⁵⁷ This argument pertained in some respect to the public domain, which in a classical sense would not be a concern of trademark law. While originality of the mark itself is unnecessary, originality—or at least the lack of a pre-existing associative link—is allegedly the foundation of a trademark’s right. If the relevant purchasing public consists of New Orleans or even Louisiana residents, “who dat” is inextricably linked to their community and culture. Beyond its constant link to southern Louisiana geographically, the term closely follows African-American masculinity, history, culture, and identity.⁵⁸ That they, as fans, logically linked it to yet another hometown football team⁵⁹ through music⁶⁰ in the 1980s should not be interpreted as forfeiting “who dat” to NFL commissioner Roger Goodell or anyone else’s control. The questions raised by the “who dat” controversy remain largely unanswered due to settlements and prohibitive court costs.⁶¹

football team was dubbed the 'Aints a few decades ago, or after it was ousted from its home stadium in 2005 by Hurricane Katrina and finished 3-13.”).

⁵⁷ *Id.* (providing evidence for the overwhelming roots of the phrase to locals includes a reference to “a woman who said her dog is named ‘Who Dat’”).

⁵⁸ Kathleen Flynn, *Saints Call ‘Who Dat’ Black-and-Gold Casket a Trademark Violation*, NOLA TIMES-PICAYUNE, http://www.nola.com/business/index.ssf/2014/02/nfl_says_who_dat_casket_a_trad.html (showing that even in 2014 clashes continued, here against a local casket builder using ‘who dat’ and related iconography, an extreme which begs the question of if purchasers could conceivably be confused as to the NFL as a source or quality control over their final resting place, as opposed to broader cultural messaging).

⁵⁹ DAVIDSON, *supra* note 51.

⁶⁰ DBG53, *supra* note 52.

⁶¹ For more on the structural troubles of outside parties attempting to rein in marks, *see infra* Section IV. A. Anti-Competitive Incentives.

Another historically rich example is “Derby Pie.”⁶² To most, bourbon, pecans, and chocolate, alongside Kentucky Derby iconography, characterize the traditional dessert. A different recipe, sans bourbon and pecans with the attached moniker of Kern’s Kitchen, is sold by “Derby Pie” mark holders. Since 1968, the Derby Pie “owners” have rigorously defended it in court.⁶³ In 1988, *Bon Appetit* magazine won a summary judgment⁶⁴ on a genericism suit by presenting magazines, cookbooks, and menus across the country, all different recipes of the pie and all independent of Kern’s, only to have it overturned as insufficient evidence on appeal and settled out of court.⁶⁵

Ralph Lauren, an American clothing brand, offers several instances of capitalization on pre-existing mark meaning. Associations of polo, a sport of horseback riding and mallets, with the cultural upper crust of society dates back to first century Persian kings⁶⁶—or, alternatively, to

⁶² Nina Feldman, *What’s Inside a ‘Derby Pie’? Maybe a Lawsuit Waiting to Happen*, NPR THE SALT (May 1, 2015, 9:39 AM), <http://www.npr.org/sections/thesalt/2015/05/01/399842082/whats-inside-a-derby-pie-maybe-a-lawsuit-waiting-to-happen>.

⁶³ Brett Barrouquere, *Derby Pie maker, restaurant end trademark dispute*, HUFFINGTON POST, http://www.huffingtonpost.com/huff-wires/20131002/us-derby-pie-dispute/?utm_hp_ref=green&ir=green (Last updated: October 2, 2013, 12:59 PM). The Claudia Sanders Dinner House was on the receiving end of one particular suit, based only on how diners and servers would refer to the pie, despite official menus granting it another uncontested name. *Id.*

⁶⁴ *Kern’s Kitchen, Inc. v. Bon Appetit*, 669 F. Supp. 786 (W.D. Ky. 1987) (providing evidence of generic uses including “some 20 restaurants, stores and shops in 8 states” as well as “132 cookbooks, 23 newspapers and 10 magazine articles”).

⁶⁵ *Kern’s Kitchen, Inc. v. Bon Appetit*, 850 F.2d 692 (6th Cir. 1988) (indicating that a lack of consumer surveys is “not necessarily fatal to defendant’s argument at trial” but rules it insufficient to rely on “anecdotal” evidence).

⁶⁶ See Richard C. Latham, *Polo*, BRITANNICA, <http://www.britannica.com/sports/polo>.

a distinctly American lifestyle brand in 1967.⁶⁷ Polo Ralph Lauren, a subset of the clothing company, brought a suit against *Polo Magazine*, a periodical backed by the sport's governing body, the United States Polo Association (USPA),⁶⁸ when the magazine attempted to expand from a sports-only publication to the lifestyle associated with it. Given the prominence of Polo Ralph Lauren and connotations of high-class athletics it had adopted, courts found the magazine's expansion a risk of confusing the public. The court also addressed the case's irony: "PRL [Polo Ralph Lauren] products became famous by basking in the reflected glow of an elegant sport. PRL now asserts that it, not the sport, is the source of the glow. In a sense, PRL is biting the hand that fed it."⁶⁹ However, the court treated the magazine as a combination of artistic and commercial expression, and remanded the case to establish less burdensome relief, such as disclaimers, to prevent possible confusion.⁷⁰ Purely commercial speech from the same source, though, may have been silenced.

Ralph Lauren did not confine its glow-basking to one sport. Rugby rose to popularity in 1850s Britain or, in mark form, from a 2004 Ralph Lauren brand extension. Here, not only were the atmospheric connotations of the sport seized, but so, too, was the term itself.⁷¹ The use of "rugby" by anyone other than Ralph Lauren, printed on clothing, even alongside other words, was met with cease-and-desist letters from PRL. Again, a suit was filed against organizers of the

⁶⁷ *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658 (5th Cir. 2000).

⁶⁸ *Id.*

⁶⁹ *Id.* at 673.

⁷⁰ *Id.* at 675 (noting, "the appropriate remedy may be may be 'not less speech, but more.'").

⁷¹ Alex Goff, *Perseverance Sees Rugby Company Win Legal Battle with Polo Ralph Lauren*, RUGBY TODAY (Jan. 13, 2011), <http://www.rugbytoday.com/rugby-news-around-america/perseverance-sees-rugby-company-win-legal-battle-polo-ralph-lauren>.

actual sport being described, a body called Rugby America. Unlike the Polo suit, Rugby had never intruded into the “lifestyle” commerce Ralph Lauren often stakes; it simply used the word in its description of the Rugby America organization printed on clothing. Rugby America succeeded, but only by a legal technicality which persuaded Ralph Lauren to back down.⁷² In the Polo trial, USPA lawyers had actually attempted to establish Ralph Lauren’s pattern of claiming a very broad value for its mark, by noting the company’s disregard for the sport of rugby before the second suit was even filed.⁷³ While groups from both sports ultimately retained reasonable ability to use the words, neither result set precedent for protecting the logical mark users.

D. Free Riders

As protection of a producer’s goodwill has been elevated to a primary justification for trademark rights, producers have been allowed to expand their spheres of control. When mark holders balk that infringers “reap what they have not sown,”⁷⁴ they are asserting exclusive ownership of whatever value there is to be reaped. In dilution cases, the mark holder’s investment in a mark is quantified using metrics such as advertising spending.⁷⁵

⁷² *Id.* (filing a countersuit for fraudulent PTO filings by Ralph Lauren for products Ralph Lauren lacked intent to produce is what Rugby America representatives claim led to the suit being dropped with prejudice).

⁷³ *U.S. Polo Ass’n, Inc. v. PRL USA Holdings, Inc.*, 800 F. Supp. 2d 515 (S.D.N.Y. 2011). An odd parallel stands out when comparing the anecdote that Ralph Lauren named a chain of stores “Rugby” because that was the name of his dog. That, apparently, was the extent of his interest in the sport, Rugby. Compare to another dog name – “Who Dat” (*supra* note 57). There, the name was taken to be evidence of public interest in a mark, while, in contrast, Lauren’s naming of his dog could be evidence that the term’s public connotations were meaningless to Lauren. Buzz McClain, *Ralph Lauren vs Rugby?*, RUGBY MAGAZINE (Apr. 15, 2006).

⁷⁴ *See Dreyfuss, supra* note 45.

⁷⁵ *See Nat’l. Pork Bd. v. Supreme Lobster & Seafood Co.*, 96 U.S.P.Q.2d (BNA) 1479, (T.T.A.B. 2010).

For more common marks, registration no longer even requires proof of use,⁷⁶ much less evidence that the mark's appeal to consumers should be contributed to the registrant. If common interpretations of the mark's meaning are to be considered at all, pre-existing appeal is assumed to evaporate the moment of registration. The thoughts of what the law would deem a typical consumer are distilled from a compilation of assumptions, almost all of which are put forth by parties vested in commercial potential.⁷⁷ This is well-expressed in a paper by Austin W. Graeme:

There is of course an important normative preference for one set of consumers over others that is close to the surface of these neutrally-expressed “presumptions.” As a result, the ordinarily prudent consumer gets constructed as somebody who is concerned with whether goods are officially sponsored, and not as somebody who values the brand for its affiliative symbolism alone. It is not prudent, apparently, for consumers to want promotional goods simply for their own sake, and possibly to pay cheaper prices, with little concern with the actual origin of the goods.⁷⁸

There are many conceivable interests of the consumer that have been left behind in trademark law. Self-expression, either freedom to use trademarks as cultural artifacts⁷⁹ or in preserving

⁷⁶ Frank Z. Hellwig, *The Trademark Law Revision Act of 1988: The 100th Congress Leaves Its Mark*, 79 TRADEMARK REP. 287, 291–292 (1989). The statute only requires a bona fide intent to use the mark, not actual proof of use. 15 U.S.C. §§ 1051–1128 (1988).

⁷⁷ Challenges and criticism of the inconsistencies in and inadequate methodology of measuring consumer sentiment are included *infra*, Sections III. B. Of the Consumer, and IV. C. Creation of Commercial Association. Almost without exception, tests lack a “negative” approach that would attempt to measure consumer sentiment which could lead to an outcome without financial beneficiaries. This follows logically from the costly nature of consumer research, and the incentives and lack thereof in the current trademark system.

⁷⁸ Graeme W. Austin, *Trademarks and the Burdened Imagination*, 69 BROOK. L. REV. 827, 901 (2004).

⁷⁹ See Dreyfuss, *supra* note 45.

existing cultural artifacts from being converted into marks,⁸⁰ are two such valuable interests when considering marks with pre-existing value.

A deeper problem emerges when skewed value-attribution is overlaid with the loosening of requirements to register a trademark. The allowance of intent-to-use in mark registrations, instead of proof of commercial use, allowed by the Trademark Law Revision Act of 1988,⁸¹ has eliminated proof of any real investment a registrant must have demonstrated to be granted a mark. Once granted, a high assumption of mark validity is given. Removing this benchmark of effort without commensurately reducing the assumptive power of the mark's registration has thrown the trademark system off-balance.⁸²

Certainly intellectual property free-riding extends beyond the trademark domain. A window for opportunistic⁸³ behavior is not isolated to trademark law; “patent trolls” abusing ambiguous bad-faith patents have become a newsworthy subject rampant in the technology sector and are being investigated by Congress.⁸⁴ Domain squatting, or “cyber-piracy,”⁸⁵ has been

⁸⁰ Wendy J. Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 YALE L. J. 1533, 1569 (1993).

⁸¹ 15 U.S.C. §§ 1051–1128 (1988); Hellwig, *supra* note 76, at 291–292.

⁸² J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION §19.08[1][a] (3d ed. 1995); United States Trademark Association, Trademark Review Commission, *Report and Recommendation to USTA Present and Board Members*, 77 TRADEMARK REP. 375, 392–393 (1987).

⁸³ Lee B. Burgunder, *Opportunistic Trademarking of Slogans: It's No Clown Issue, Bro*, 31 CARDOZO ARTS & ENT. L.J. 769 (2013).

⁸⁴ Econostats at George Mason University, *Who Are Patent Trolls and What Will We Do about Them?*, FORBES (May 29, 2015, 4:20 PM), <http://www.forbes.com/sites/econostats/2015/05/29/who-are-patent-trolls-and-what-will-h-r-9-do-about-them/>.

⁸⁵ 15 U.S.C. § 1125(d).

defeated by famed businesses in court.⁸⁶ Similarly, “celebrity squatting” often delves into remedies through a right to publicity,⁸⁷ but illustrates this issue of culture and technology blurring the standards for attribution. One does not have to be invoking a name to infringe on rights to publicity, with the seminal case protecting a celebrity’s rights through a prominent catchphrase,⁸⁸ and Trademark Trial and Appeal Board (TTAB) precedent coming to respect commercial linkage⁸⁹ as well as the mark’s being “almost a nickname.”⁹⁰

Even modern “fame” does not easily lead to clear attributions of investment in creating mark value. As technology and mass media have borne the concept of ‘going viral’ almost instantaneously, it becomes harder to trace the rise of a mark’s notoriety. One jarring example is the case of “Let’s roll,”⁹¹ a colloquialism that became imbued with new communal and individual meanings within hours of being uttered by a passenger on a crashing plane during the September 11th attacks. The term rapidly gained a massive well-known set of associations attached to it. The term was rapidly endowed with powerful meaning, which did not take an extensive effort to build, as circumstances instead did the heavy lifting to establish the

⁸⁶ Nike, Inc. v. Circle Group Internet, Inc., 318 F. Supp. 2d 688 (N.D. Ill. 2004).

⁸⁷ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995).

⁸⁸ Carson v. Here’s Johnny Portable Toilets, Inc., 698 F.2d 831(6th Cir. 1983) (showing how at this point in trademark law, it was important that this phrase included Johnny’s name, had a two-decade consistency in the public eye, and was repeated nightly on broadcast television).

⁸⁹ Robert D. Litowitz & Mark Traphagen, *The Song Remains the Same*, 18 TEX. PARALEGAL J. (2000), https://txpd.org/tpj/18/song_same.htm.

⁹⁰ *Id.* (“affidavits of several members of the music industry stating that ‘Margaritaville’ was almost a nickname of Jimmy Buffet”).

⁹¹ U.S. Trademark Application Serial No. 76316210 (filed Sept. 22, 2001); See Noah Bleicher, *Trademarking Tragedy: The Fight for Exclusive Rights to ‘Let’s Roll’*, 52 EMORY L.J. 1847 (2003).

goodwill.⁹² There are no advertising expenditures any particular party can point to as its investment in creating the mark. Nevertheless, an unrelated individual was able to take ownership over the phrase through trademark, without any questions asked.⁹³

Another historic event, the Brexit (British exit) from the European Union (EU), has been the subject of trademark petitions. The makers of Samuel Adams Boston Lager filed an application to trademark the term with intent-to-use for hard cider on June 24, 2016, the day of the referendum's announced results favoring the United Kingdom's leaving the EU.⁹⁴ The pro-Brexit vote was so momentous that it resulted in British Prime Minister David Cameron's resignation and in the British pound's value dropping to a three-decade low for that national currency. Google Trends show that in comparison to searches that day for the term "Brexit," searches for this brewer, and even "beer" itself, occurred with frequencies of zero and four percent, respectively.⁹⁵

Under these circumstances, it seems that mark holders are the ones "free riding" or "reaping where they have not sown." If efforts are to be made to articulate better the value a mark does (or does not) contain in business, then its primary functions must be examined in several dimensions.

⁹² Bleicher, *supra* note 91, at 1865.

⁹³ *Id.* at 1874–75.

⁹⁴ Jacob Gershman, *Sam Adams Brewer Seeks to Trademark 'Brexit,'* WALL ST. J. (June 29, 2016 11:55 AM), <http://blogs.wsj.com/law/2016/06/29/sam-adams-brewer-seeks-to-trademark-brexit/>.

⁹⁵ Available at <https://www.google.com/trends/explore#q=brexit%2C%20%2Fm%2F05hm41r%2C%20%2Fm%2F01599&date=today%201-m&cmpt=q&tz=Etc%2FGMT%2B4>

III. PRIMARY PURPOSE

In the light of protecting information transmission and consumer interests,⁹⁶ understanding the multidimensional purpose of a mark is critical. A mark interacts with and affects the product at hand and cannot offer non-reputational advantages to one competitor, controlled by way of functionality or aesthetic functionality. Marks may be valuable for their own communicative strength. Desirable non-source messages, such as the personal expression by consumers, are not meant for commoditization by trademark. Investigating the perception of consumers at the point of purchase, as well as the primary appeal or use the product serves for them, facilitates the most realistic grasp on a possible mark's nature.

A. Of the Mark

The functionality doctrine restricts trademarks on aspects of the product which are “essential to the use or purpose of the article or if it affects the cost or quality of the article.”⁹⁷ This delineates the boundary from patent law, meant to reward functional advances. It also protects meaningful competition for the benefit of the market. Features have been defined as functional if restricting them would cause “significant, non-reputational disadvantages” to competitors.⁹⁸ Essential product functions may be classified in a variety of ways; thus, we will borrow from literature segmenting functions of utile, aesthetic, and commutative purposes.⁹⁹

⁹⁶ *Supra* Section I. A. Justifications.

⁹⁷ *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850-51 n.10 (1982).

⁹⁸ *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 161 (1995).

⁹⁹ Vincent N. Palladino, *Trade Dress Functionality After TrafFix: The Lower Courts Divide Again*, 93 TRADEMARK REP. 1219, 1224-225 (2003).

Utile functions are features directly contributing to the product purpose as intended by the producer.¹⁰⁰ However, intended function is not necessarily espoused in good faith on all trademark registrations. This can be illustrated by Boise State University's trademark on its blue-turf football field.¹⁰¹ Its trademark registration details an entertainment purpose, through intercollegiate sports played in the stadium and shown through media.¹⁰² It could be argued that the colorful field qualitatively affects these intentions. Telegenic benefits are touted by owners of similarly vibrant sports fields¹⁰³ and are a prized factor for media broadcasters.¹⁰⁴ Complaints of competitive advantage, by way of camouflage, emerged when Boise's football team adopted turf-matching blue uniforms.¹⁰⁵ Scientific advantage has not been studied, but complaints appear to be bolstered by the football team's uncharacteristically strong home win record since the inception of such uniforms.¹⁰⁶ Additionally, a source-identifying purpose is dubious. The turf is

¹⁰⁰ *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001).

¹⁰¹ For a comprehensive examination, see Michelle Gallagher, *'Who Owns Blue? An Examination of the Functionality Doctrine in University Sports Color'*, 104 TRADEMARK REP. 765 (2014).

¹⁰² BLUE TURF, Registration No. 3,707,623.

¹⁰³ Clare Lochary, *For Field Hockey, a New, Blue View*, N.Y. TIMES (Jul 6, 2012, 8:48 AM), <http://london2012.blogs.nytimes.com/2012/07/06/for-field-hockey-a-new-blue-view/>.

¹⁰⁴ *Sportvision, Inc. v. Sportsmedia Tech. Corp.*, No. C 04-03115 JW, 2006 WL 408634, at *7-8 (N.D. Cal. Feb. 17, 2006), available at <http://www.jurisnotes.com/Cases/sportvision.pdf>.

¹⁰⁵ See Gallagher, *supra* note 101.

¹⁰⁶ Boise State's home record from 1980 until field implementation was 28-10 (73.7%) with an away record of 19-13 (59.4%). The colored field was implemented at the beginning of the 1986 season, when Boise State went 4-2 at home and 1-5 away. From the field's implementation through October 24, 2015 Boise State went 166-33 (83.4%) at home and 104-75 (58%) away. Since the 1999 season, the team has only lost 4 out of 104 home games, the best home field record in all of college football by win percentage. Even then, three of those losses came with Boise State wore non-blue uniforms. Statistics from cfbdatawarehouse.com.

physically fixed within the campus grounds, surrounded by Boise State signage and students.¹⁰⁷ In broadcasts, primarily of college football games, the scoreboard, uniforms, traditional field markings, and presentation by announcers all clearly identify the host team.¹⁰⁸ These advantages for Boise State in its stated purposes of sporting events and of securing lucrative broadcasts outweigh whatever incremental, source-identifying objective is available.

Aesthetic functionality¹⁰⁹ is described in the *Pagliero* case as ornamentation serving “an important ingredient in the commercial success.”¹¹⁰ The court determined that consumers interpreted a decorative pattern on china as a desirable quality, and not primarily as a source indicator: “the design sells the china.”¹¹¹ There are two significant implications of this doctrine that since the design performed a function more than the design identified a source, it should not receive protection under trademark law. The first is a priority for consumer interests. No matter the legitimacy of efforts undertaken by the mark holder, purchaser perceptions are of greater concern. The second is the judiciary’s realistic conception of this purchasing public. The perfectly rational, as in utilitarian, consumer is a myth.¹¹² Even if rationality were possible, to

¹⁰⁷ See Sam Fortier, *Boise State Mounts a Paper Defense of Its Home Turf*, N.Y. TIMES (Sept. 10, 2016), http://www.nytimes.com/2016/09/11/sports/ncaafotball/boise-state-mounts-a-paper-defense-of-its-home-turf.html?_r=0.

¹⁰⁸ *Id.*

¹⁰⁹ Margot E. Parmenter, *Louboutins and Legal Loopholes: Aesthetic Functionality and Fashion*, 40 PEPP. L. REV. 4 (2013).

¹¹⁰ *Pagliero v. Wallace China Co.*, 198 F.2d 339, 343 (9th Cir. 1952).

¹¹¹ *Id.* at 343–44.

¹¹² Devin R. Desai, *From Trademarks to Brands*, 64 FLA. L. REV. 981, 1029 (2012) (“Mired in the world of the fully rational consumer, trademark law claims that trademarks are information resources for the consumer to use as part of the purchasing process. Whether this rational creature exists is questionable, and empirical work to support the view is missing.”).

consumers, aesthetics are a valid function,¹¹³ and if that value is significant enough, then it is not meant to be swept up into trademark protection. To discuss ingredients in commercial success acknowledges a multitude of forces at work in decision-making. Aesthetic functionality is respected when consumer interests are evaluated realistically and comprehensively.

Communicative function is the category most often ignored and threatened by modern trademark practices.¹¹⁴ Many “communications” touch upon the desires of consumers versus producers, but others are purely informative statements¹¹⁵ that one would assume belong in the public domain. A 32-year-old man was granted several trademarks in the mid-1990s for the standard character mark, “Class of 2000,”¹¹⁶ for a range of product categories from tee shirts to teddy bears. When this story hit the news about 16 months before that “class” would generally graduate, he already had over 30 licensees who had each agreed to 8 to 10 percent royalty fees to

¹¹³ *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 170 (1995) (“[S]atisfy the noble instinct for giving the right touch of beauty to common and necessary things.”) (quoting G. Chesterton, *Simplicity and Tolstoy* 61 (1912)).

¹¹⁴ See, e.g., Joseph P. Lui, Sports Merchandising, Publicity Rights, and the Missing Role of the Sports Fan, 11 B.C. L. REV. 421, 448 (2011); Stephanie Frank, Showing Your School Spirit: Why University Color Schemes and Indicia Do Not Deserve Trademark Protection, 92 B.U. L. REV. 329, 364 (2012); Gerald T. Tschura, Likelihood of Confusion and Expressive Functionality: A Fresh Look at the Ornamental Use of Institutional Colors, Names and Emblems on Apparel and Other Goods, 53 WAYNE L. REV. 873, 884-87 (2007).

¹¹⁵ *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455 (TTAB 1998) (rejecting “drive safely”).

¹¹⁶ Associated Press, ‘Class of 2000’ Trademarked for Merchandise in Retailers, TOLEDO BLADE (Oct. 7, 1998), available at <https://news.google.com/newspapers?id=Yg8wAAAAIIBAJ&sjid=6gMEAAAIAIBAJ&pg=3896%2C2418085>.

use his mark.¹¹⁷ Where copyright law prohibits registering non-original facts or phrases, trademark law does not.¹¹⁸ Instead of carrying information about source or even qualities associated with source, communicative marks may themselves be the entirety of information. No consistent litmus test is applied to determine the mark's primary meaning or possibly protected functions before granting powerful trademark rights.

B. Of the Consumer

The consumer's motivations in purchase decisions are also evaluated and ranked in trademark disputes. Consumers may be simply utilitarian and rely only on a product's reputation, or they may be swayed by emotion and beauty. There are many psychological needs that brands

¹¹⁷ The judiciary, of course, is not blind or indifferent to the stark clashes of common sense with statute. This is one such mark that would likely be struck down by any court which seriously evaluated consumer interpretation or the content of the mark. However, a combination of "the tragedy of the commons" and "the path of least resistance" allows marks in the style of "Class of 2000" to exist profitably. Users who believe they have a clear legal right to these words would also simultaneously believe that the mark holder's legal threats would be unsuccessful, and that this mark is invalid. The latter belief can be pursued by an expensive legal case petitioning for generification, opening up the mark to all users by the efforts and expenditures of one. The former beliefs can be pursued simply ignoring legal threats and continuing about one's business, at no cost. If the mark holder truly believes in the mark's legitimacy, then he or she may move forward with threats and the court will rule, putting this legitimacy at the risk of the court's evaluation. However, as long as the mark holder does not carry through with legal action against "infringers," there is hardly any risk of cancellation. Merely notifying users of the mark registration allows for the possibility of licensing payments from those who take the threat seriously. If a holder did not believe its registration to be one that would hold up in court, this could be quite a profitable alternative to problematic litigation, let alone doing nothing at all. In this particular case, the mark holder was bold enough to publicize his opportunistic tactics and lack of intent to pursue them, *supra* note 116. This behavior could be addressed by proposed estoppel, described *infra* Section V. B. Eye on the Ball.

¹¹⁸ See the idea-expression dichotomy, *supra* Section I. B. Uniqueness among Intellectual Property.

can fulfill to attract consumers by way of trademarks.¹¹⁹ Goods may be “billboards,” communicative tools in the hands of consumers to express themselves.¹²⁰

Certainly, there is a limit to how much a consumer’s desire for expressive use should be valued through protection from trademarking. Just because there is demand for goods giving off the illustrious impression that their consumers are wealthy and stylish enough to own, for example, an Audi,¹²¹ does not grant the right to produce and sell disingenuous key chains. In this case, defendants claimed car logos were the “actual benefit” consumers desired and thus they were a functional feature. The court disagreed, finding the benefit of the logo-indicated company’s goodwill was the real motivator for sale.¹²² The desirability of displaying a well-known car logo comes from poaching the connotations the mark holder built into it. It is not merely the design of an Audi symbol, but the inferred luxury and financial standing it carries because of the association to high-status cars. It is also important to distinguish that key chains marked with a car logo are reasonably related product categories, where implied association is clear.

When the actual benefit of a mark is its implication, it does not mean the mark holder personally created that implication. For instance, the *Jobs Daughters*¹²³ case found on appeal that a fraternal name and emblem were functionally aesthetic and not serving as marks. The court

¹¹⁹ WILLIAM J. MCEWEN, MARRIED TO THE BRAND: WHY CONSUMERS BOND WITH SOME BRANDS FOR LIFE 32–33 (2005) (detailing five distinct ways brands may carry personal meaning: prestige, representing personal qualities, membership, memory triggers, and self-completion).

¹²⁰ For a thorough and very fun study of billboard products and slogan trademarking, see Burgunder, *supra* note 83.

¹²¹ *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1071 (9th Cir. 2006).

¹²² *Id.*

¹²³ *Int’l Order of Job's Daughters v. Lindeburg & Co.*, 727 F.2d 1087 (Fed. Cir. 1984).

cited a lack of evidence that consumers would interpret the mark as source-identifying. Consumers were, in fact, purchasing bracelets displaying this emblem for the symbol's own value. If the *Au-tomotive* use was unacceptable because the owner's meaning was misappropriated by third-party use for ornamentation, there should be reciprocal consideration when pre-existing meanings are being mined by mark holders.¹²⁴

There are numerous other trademark cases in relation to the insignia of fraternal or "Greek" organizations for parallel consideration. The *Pure Country*¹²⁵ opinion rejects outright the *Jobs Daughter's* ruling as precedent for aesthetic functionality, but creates other logical gaps in protecting marks used for personal expression. Charges against mark holders for abandonment through naked licensing¹²⁶ were rejected by the court "because the consumers are the members of the trademark-holding organizations There is no issue of consumer deceit."¹²⁷ However, there is some circular logic at work. Firstly, this dismisses evidence of broad, uncontrolled mark use as irrelevant, because consumers have pre-existing relationship with the mark. Intentional interaction with unsanctioned uses could in fact reveal that the "relationships" are either not with or irrelevant of the trademark in its intended sense. Instead, lapses in control are deemed *harmless*, in service of an interpretation that tamps out a similar uncontrolled use for causing

¹²⁴ This is arguably the case in circumstances such as those mentioned *supra*, at D. Free Riders.

¹²⁵ Alpha Tau Omega Fraternity, Inc. v. Pure Country, Inc., No. IP 01-1054-C-B/F, 2004 WL 3391781 at *6 (S.D. Ind. Oct. 26, 2004).

¹²⁶ See *supra*, Section II. A. Changing Nature.

¹²⁷ *Pure Country*, 2004 WL 3391781 at 11. However, because the defendant here was a lapsed former licensee, estoppel established their recognition of the mark's owners, as well as sacrificed potential arguments for a lack of confusion to those same buyers. *Id.*

harm. This is one of many illustrations of consumer competence being determined inconsistently, at the will of corporate interests.

In relation to the lack of source-information conveyed by a mark, one opinion stated: [D]efendants' contention that UNC-CH's marks have lost significance as indication of origin because the public can no longer point to a single source of the origin of *goods* bearing the marks does not establish abandonment, for under *Sweetheart*¹²⁸ abandonment occurs only when a mark loses all significance as an indication of origin *as to the mark itself*.¹²⁹

This is an underwhelming standard when combined with the negligible state of quality control standards.¹³⁰ What instead may be protected is symbolism and language without meaningful limitations.

C. Of the Purchase

Aside from considering what consumers may intend to do with a mark, it also must be analyzed according to what purpose the mark-bearing goods themselves serve. Take, for example, a case of licensed collegiate apparel. There, the court utilized the test of equally-effective alternatives¹³¹ when establishing whether or not a university had the exclusive right to products bearing its name:

We do not believe that anyone could seriously argue that the soft goods at issue here are, in any realistic way, in competition with similar, unadorned soft goods.

¹²⁸ Referencing *Sweetheart Plastics, Inc. v. Detroit Forming, Inc.*, 743 F.2d 1039 (4th Cir. 1984).

¹²⁹ *Bd. of Gov. of Univ. of N.C. v. Helpingstine*, 714 F. Supp. 167, 173 (M.D.N.C. 1989) (emphasis in original).

¹³⁰ *See infra* Section IV.B.2. Diminishing Expectations of Control.

¹³¹ *TraFFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 32–34 (2001).

The relevant product market for the consumer in this case is soft goods which allow the consumer to show his or her allegiance to Pitt Because the Pitt insignia on soft goods serve a functional purpose and largely define a sub market [sic] of some size, granting Pitt the relief it seeks would give Pitt a perpetual monopoly over that sub market, precluding any competition in the Pitt insignia soft goods market. We know of no legal theory which would countenance such a result.¹³²

Compare that reasoning to a Texas court's rudimentary analysis of functionality, holding that "[t]he fact that a knit cap is scarlet and black or bears a 'Double T' does not affect the quality of the cap or its ability to keep one's head warm."¹³³ As such there was "no evidence that the use of the Texas Tech color scheme could affect the cost or quality of the products or are the reason the products work."¹³⁴ The Collegiate Licensing Company (CLC), which now represents both of these schools in licensing matters, values the collegiate merchandise retail market at \$4.6 billion.¹³⁵ Just as *Pitt* found, it is not mere chance or a collegiate-affinity for superior clothing and knick-knack production which creates this robust market, with branded products that are on equal footing as any unadorned knit cap.

¹³² *Univ. of Pittsburgh v. Champion Prods., Inc.*, 566 F. Supp. 711, 722 (W.D. Pa. 1983).

¹³³ *Tex. Tech Univ. v. Spiegelberg*, 461 F. Supp. 2d 510, 527 n.2 (N.D. Tex. 2006).

¹³⁴ As the court found the red-and-black color scheme to have secondary meaning, which required probing into perception, this statement is not a result of naivety. It is an instance of willingness to alternately invoke and ignore consumer sentiment to the end result of avoiding consumer protection. For discussion of the wealth of branding literature acknowledging mark power and influence over product purpose and cost, *see* Desai, *supra* note 112.

¹³⁵ *About CLC*, COLLEGIATE LICENSING COMPANY, <https://www.clc.com/About-CLC.aspx> (last visited Feb. 28, 2017).

The market for collegiate apparel is a distinct one. The CLC also offers some argument for marks affecting cost, quality, and product function when it states, “colleges and universities have some of the most loyal and passionate fans in the world. They love to show their team spirit on their shirts, on their cars, at the game, and in their home.”¹³⁶ If fans’ desire to show their passionate spirit is indeed “the reason the products work,” should they only be able to (do so) through licensed goods?¹³⁷

*Damn I’m Good, Inc. v. Sakowitz, Inc.*¹³⁸ is a case where an aesthetic functional feature was found to be instrumental to the goods’ purpose. “Damn I’m Good” was among several cheeky phrases printed on gold bangles. The fact that the bracelets were not offered un-inscribed contributed to the court finding that the phrase was the fundamental product being sold, hence not a valid trademark.¹³⁹ Thus, the purchase is driven by the tagline, making the mark itself a commodity, instead of the underlying bracelet. If that is the case, a sizable market may be swept up in a single mark, adorning a variety of vessels.

One cannot expect uniformity on a relatively subjective matter. The TTAB and judiciary cannot sidestep product and attribute appraisal when evaluating marks. Words, symbols, and

¹³⁶ *Id.*

¹³⁷ See John J. Voortman, *Trademark Licensing of Names, Insignia, Characters and Designs: The Current Status of the Boston Pro Hockey Per Se Infringement Rule*, 22 J. MARSHALL L. REV. 567, 575 (1989) (arguing that exclusivizing the right to sell these desirable goods creates property “fundamentally different from traditional trademark rights”); Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 964 (1993) (suggesting four criteria for analyzing commoditized marks upon, “moral claims, utilitarian considerations, the potential for negative goodwill flowing from unlicensed uses, and society’s interest in free and open communication”).

¹³⁸ *Damn I’m Good v. Sakowitz, Inc.*, 514 F. Supp. 1357 (S.D.N.Y. 1981).

¹³⁹ *Id.* at 1360.

colors have meaning independent of commercial attribution, such as floral arrangements in black vases commonly used for Halloween, bereavement, or the color's luxurious appeal.¹⁴⁰

D. Scale of Specificity

To normalize these discussions, what must be agreed upon is at what scale the consumer purchase decision determinations will be made. *A.J. Canfield Co. v. Honickman*¹⁴¹ was generous in the level of detail granted to analysis of consumer preference. Although the company was known by consumers at the time as the only source of diet chocolate fudge flavored soda, this was ruled to be a generic term describing the product.¹⁴² Beverages are not interchangeable; soda flavors are not freely substituted. There were even suits pertaining to the distinctiveness of “chocolate” versus “fudge” as descriptors.¹⁴³

However, “honey baked ham” was found to be an acceptable mark.¹⁴⁴ Calling back the genus analogy of determining genericism (where a product lies within a category, as a species lies within a genus),¹⁴⁵ the court found honey *prepared* ham to be the category within which “honey baked” resided.¹⁴⁶ These differences seem small, but have sound logical backing. “Honey baking” could result in the same product as honey preparing, smothering, infusing, or any of

¹⁴⁰ *In re Florists' Transworld Delivery, Inc.*, Serial No. 77590475 (TTAB Mar. 28, 2013).

¹⁴¹ *A.J. Canfield Co. v. Honickman*, 808 F.2d 291 (3d Cir. 1986).

¹⁴² *Id.* at 298.

¹⁴³ Jeffrey A. Leib, *In Soda Rivalry, Chocolate Is In*, N.Y. TIMES (Sept. 4, 1985), <http://www.nytimes.com/1985/09/04/garden/in-soda-rivalry-chocolate-is-in.html>.

¹⁴⁴ *Schmidt v. Quigg*, 609 F. Supp. 227, 231 (E.D. Mich. 1985).

¹⁴⁵ *Supra* notes 25 & 27.

¹⁴⁶ *Schmidt*, 609 F. Supp. at 229.

several other compound verbs, but “diet chocolate fudge soda” invokes only a flavor, leaving no breathing room for interpretation, and thus for competition.

Ring pops¹⁴⁷ illustrate complications in genus determination. According to the court, the genus was “lollipop candy.”¹⁴⁸ However, whether the relevant consumer class is interpreted to be the children or the parents they are pressuring for the candy,¹⁴⁹ both can likely distinguish between a Blow Pop, Tootsie Pop, Ring Pop, Push Pop, Baby Bottle Pop, or Dum Dum. The ring shape was deemed a “search attribute” that children were after, but not of primary importance to the function.¹⁵⁰ There can be many other levels of specificity available for determining genus. For instance, the ring shape could have been described in different accurate self-motivating categorical divisions, such as “lollipop that functions as a toy,” “wearable lollipop,” “lollipop in ring shape,” or “lollipop in diamond ring shape.” These descriptions are presented in descending level of detail, and choosing between these levels should be guided by the considerations of relevant consumers.¹⁵¹ Will a Dum Dum equally placate a child demanding candy accessories?

¹⁴⁷ *Topps Co. v. Gerrit J. Verburg Co.*, 41 U.S.P.Q.2d (BNA) 1412, 1413 (S.D.N.Y. 1996).

¹⁴⁸ *Id.* at 2–3.

¹⁴⁹ *The Nag Factor: Children and Unhealthy Foods*, JOHNS HOPKINS BLOOMBERG SCHOOL OF PUBLIC HEALTH (Aug. 15, 2011), <http://www.jhsph.edu/news/news-releases/2011/borzekowski-nag-factor.html>.

¹⁵⁰ *Topps Co.*, 41 U.S.P.Q.2d (BNA) 1413.

¹⁵¹ As the level of investment in consumption choices are considered in the multi-factor test for infringement, it is necessary to examine how courts define “relevant consumer” for a given product. If children are the relevant consumers here, not only is their investment in candy likely much greater than that of their parents, but the case for a competitive advantage is much stronger. Shifting conceptions of consumers are discussed *supra* Section V. B. Of the Consumer. Here it is worth noting that a candy is likely to be campaigned for by children, and the (presumably high) impact frivolous attributes have on them specifically should affect the weight of competitive protections given to such attributes as marks. See Julia Riehm McGuffey, *The New Edition of New Edition: Boybands, Trademarks, and Shifting*

Would any youth be concerned with the exact jewel shape being replicated? Consumer research heralds the effectiveness of market differentiation in creating consumer demand, while much of trademark law naïvely ignores this fragmentation's consequences.¹⁵²

The breadth of genus determination can be, and has been, equated to market definition.¹⁵³ Given that both the functionality and aesthetic functionality doctrines discuss preventing unfair disadvantages among competitors, those competitors must be identified. Similar cases, *University of Pittsburgh v. Champion Products, Inc.*¹⁵⁴ and *Texas Tech University v. Spiegelberg*,¹⁵⁵ still vary greatly in their standards for defining and interpreting the competitive market, which vary across time and jurisdictions. The current trend is unfortunately not moving toward a more realistic assessment of actual market conditions.

IV. HOW TRADEMARK TURNED ON ITSELF

As the business and legal concepts associated with intellectual property have grown in importance and complexity, some developments in the law and practice of trademark appear inordinate if not outright byzantine.¹⁵⁶ The law is due for not a complete reset, but reform.

Goodwill, 47 U. LOUISVILLE L. REV. 167 (2008) (for an instance of functionalism based on individual circumstances); *see also* Pierce, *supra* note 25.

¹⁵² *See* Desai, *supra* note 112, at 992.

¹⁵³ Anna F. Kingsbury, *Market Definition in Intellectual Property Law: Should Intellectual Property Courts Use an Antitrust Approach to Market Definition?*, 8 MARQ. INTELL. PROP. L. REV. 63, 68–70 (2004) (proposing the implementation of a consistent standard for market determination as in Anti-Trust law).

¹⁵⁴ 566 F. Supp. 711, 722 (W.D. Pa. 1983).

¹⁵⁵ 461 F. Supp. 2d 510, 527 n.2 (N.D. Tex. 2006).

¹⁵⁶ Some commentators fear that a formalistic legal climate preserves unnecessary, counter-productive codification of trademark law expansion. Michael Grynberg, *Things Are Worse Than We Think: Trademark Defenses in a "Formalist" Age*, 24 BERKELEY TECH. L.J. 897 (2009).

Without some significant change, a formalistic legal climate for branding may run roughshod over business creativity and innovation.

A. Anti-Competitive Incentives

The trademark for the term “three-peat”¹⁵⁷ is a useful study of how shifting of trademark law has allowed some marks to become unmoored from the intent of serving the market or consumers. National Basketball Association (NBA) coach Pat Riley registered this mark¹⁵⁸ after allegedly overhearing a player use it aspirationally following the Lakers’ second-in-a-row NBA Championship in 1989. Naturally, the team had no three-peat to claim at that point, but intent-to-use had recently been incorporated into law,¹⁵⁹ and it was perfectly valid to pre-emptively protect actual commercial sales that would follow a possible third win. The term came into tension with the spirit of trademark law when the Lakers’ failed to win that third championship, yet Riley maintained ownership of the term.¹⁶⁰ “Three-peat” as a mark did not die out with the Lakers hopes; multiple championships of all types have been won since—even within the NBA, by the Chicago Bulls, twice. Riley is said to have collected at least \$1 million from licensing the term

¹⁵⁷ For an in-depth analysis of this particular mark, see Todd D. Kantorczyk, *How to Stop the Fast Break: An Evaluation of the “Three-Peat” Trademark and the FTC’s Role in Trademark Law Enforcement*, 2 UCLA ENT. L. REV. 195 (1995) (calling for cancellation; unfortunately, in the intervening 20 years, the mark has grown stronger, and the applicable law has expanded further).

¹⁵⁸ Scott Ostler, *Champions Entering a New Phrase as Riley Impels by Word of Mouth*, L.A. TIMES (June 6, 1989), at C1.

¹⁵⁹ *Supra* note 81.

¹⁶⁰ Tony Kornheiser, *Anybody Need a 3-Peat Slogan?*, L.A. TIMES (June 18, 1989), at C15.

within the NBA alone.¹⁶¹ Eventually the Lakers did get a three-peat of championship wins; however, Riley would collect the spoils while coaching the Lakers' competitor, the Miami Heat. Later, coming off back-to-back Heat championship victories in 2014, Riley filed for mark extension to bed linens and cell phone cases, before failing to cinch the achievement once again.

Beyond the fact that Riley hedges his success by directly profiting off of his team's competitors (and thus, profits from his team's losses), all aspects of this term's usage fail to meet typical court standards of non-genericism.¹⁶² The term is commonly used to indicate any three consecutive sports championships, often by media, third parties, and publicly by Riley himself.¹⁶³ It is included in dictionaries and an abundance of Internet search results with no mark relation. The fact that this mark still legally stands, and protections have in fact continued to expand, can be attributed to several recent shifts in trademark law.

The first is the Trademark Improvement Act of 1980,¹⁶⁴ which eradicated the Patent and Trademark Office's authority to petition for the cancellation of trademarks based on genericism. Effectively, this shifts the burden of proving genericism to outside parties who are willing and able to invest the time and monetary risk of bringing an infringement suit and attempting to rebut a mark's high presumption of validity.¹⁶⁵ Most critically, that change carries a problem with

¹⁶¹ Doreen Hemlock, *Win or Lose, Riley Makes Royalties on 'Three-Peats,'* SUN SENTINEL (June 9, 2014), available at http://articles.sun-sentinel.com/2014-06-09/sports/fl-heat-finals-threepeat-pat-riley-20140608_1_pat-riley-royalties-three-peats.

¹⁶² *Supra* note 16.

¹⁶³ *Supra* note 157.

¹⁶⁴ FTC Improvements Act of 1980, Pub. L. No. 96-252, 94 Stat. 391 (1980).

¹⁶⁵ *Reese Publ'g Co. v. Hampton Int'l Commc'ns, Inc.*, 620 F.2d 7, 11 (2d Cir. 1980) ("If a mark has been registered with the United States Patent and Trademark Office, the defendants in an infringement action do bear the burden of overcoming the presumption that the mark is not generic.").

incentives commonly known as the “tragedy of commons.” If a term is determined to be generic, the mark holder does lose exclusive right to control that mark’s use, and the mark is now free for everyone to use. However, the complainant alone absorbs the cost and risk of bringing that suit. As a practical matter, use of the generic term at hand must be highly or uniquely valuable to encourage such a proceeding.¹⁶⁶

Situational matters compound this lack of incentives.¹⁶⁷ First, the profitable window of opportunity surrounding, for example, any “three-peat,” is short lived. Championing the term is useless without a third big win on the horizon, and one misses the prime celebratory rush of enthusiasm if action is taken too late. These events also are profitable directly in relation to their rarity. While the biggest three-peats may touch mainstream pop culture and garner national attention, many others may have niche commercial appeal. The majority of sports teams have only a regional following, and few championships attract the same level of attention as the NBA. While this should not render their three-peats irrelevant, or underserving of proclamation on celebratory knick-knacks, it is not a cost-effective game for the average complainant to play. It is unreasonable that obviously valid commercial uses by other sports champions must face another challenge: that of an NBA *legal* team.

There is no clear path to how “three-peat” would be cancelled, so we will consider its reality in light of the justifications for trademark rights. Certainly no old-fashioned product

¹⁶⁶ The Lanham Act could be challenged at any time “if it becomes generic,” and any threat to economic competition could be challenged under the trademark misuse provision of Section 33(b)(7) of the Lanham Act. *Park N’ Fly Inc. v. Dollar Park and Fly, Inc.* 469 U.S. 189, 201 (1985). Although the Court justified its results in terms of the economic benefits of trademarks, the Court’s Park ‘N Fly opinion has been criticized as going beyond the economic rationale for trademark protection. *See Suman Naresh, Incontestability and Rights in Descriptive Trademarks*, 53 U. CHI. L. REV. 953, 986–87 (1986).

¹⁶⁷ *Supra* note 157.

source information is being relayed. Even expanding mark purpose to include “suggestion of affiliation or sponsorship” offers lackluster support for Riley’s ownership, considering users are entirely different sports or direct competitors. In the latter circumstance of in-league three-peats especially, no desirable quality is implied by the “mark” of a coach, whose team has, by the mark’s definition, been defeated at least thrice. Consumer sentiment is consistently invoked in the loosening of trademark standards, but consumer confusion caused by this counterintuitive mark has not been considered when tightening standards.¹⁶⁸

As discussed in Section II. B. Inherent Goodwill, marks are not merely information conduits, but often contain information themselves. Thus far, there are no preventative measures for marks providing false information unless they are directly impersonating another person or entity as a source. To see the issue presented, contemplate another mark filed in anticipation: the New England Patriots registration of “19-0”¹⁶⁹ in 2008. This was filed as the team neared an historic, second-ever perfect season in the NFL. However, the team ultimately fell short of this record, going 18-1. Representatives of the Patriots have continued to exhaust extensions of the mark’s protection, submitting proof of commercial use as recently as May 2015.¹⁷⁰ It seems inexplicably bizarre to imagine that the Patriots have continuously used a football statistic in commerce, despite never actually achieving it. What could the team possibly be selling? In the

¹⁶⁸ This contributes to and reflects the influence of mark holders in shaping trademark law, *see infra* Section C.11. Circularly Setting Perceptions.

¹⁶⁹ 19-0, Registration No. 77374670.

¹⁷⁰ 19-0 - Trademark Details, JUSTIA, available at <https://trademarks.justia.com/773/74/19-0-77374670.html>.

intervening 7.5 years, the public's ability to sell an array of goods bearing that record, which someday the Patriots may actually hold, was taken hostage.¹⁷¹

B. Quality Standards

Quality control is conceptually challenging in the modern market. When fewer products are physical goods, the standards of a use justifying trademark protection become harder to define. With the boom of promotional merchandising, the question of functionality is answered resoundingly by producers stating brand-enhancement is the goal and consumers are expected, if not assumed, to concur.

1. Source of Quality

Which fundamental quality is under control, and who enforces that control, are questions that a court approached in several cases surrounding a particular cultural phenomenon: boybands.¹⁷² A test¹⁷³ was determined to establish ownership: identifying the marks' "distinctive quality" according to the relevant public, and then determining the controller of that quality. Here, the court treated the conception of the relevant public with realism.

The relevant market for teen heartthrobs—pre-teen and younger teenage girls—is not primarily concerned with the physical goods of a CD or even the quality of the music that it

¹⁷¹ Although many more games are played in NCAA Basketball—and thus 19-0 does not hold the allure of indicating a lossless season—in this time period, this is one prominent sport where records of 19-0 have been achieved (and surpassed), by Wichita State in 2014 and the University of Kentucky in 2015. Perhaps one of these teams would have been interested in possessing mark rights to this record for its iconic implications. The latter team's coach, John Calipari, evidences an appreciation for trademark registration as documented *infra*, note 202.

¹⁷² McGuffey, *supra* note 151.

¹⁷³ Bell v. Streetwise Records, Ltd., 640 F. Supp. 575 (D. Mass. 1986).

plays. It is instead the band *associated* with the music—the band linked to the music by its image and personality—that draws fans in:

They were individual persons that the public came to know as such. While defendants would have us believe this is only the result of their successful promoting, I find that it was personality, not marketing, that led to the public's intimacy with plaintiffs. The “magic” that sold New Edition, and which “New Edition” has come to signify, is these five young men.¹⁷⁴

The notable exception is a publicly-recognized concept group, a la the “Menudo Model.”¹⁷⁵ It was widely publicized that “Menudo” was, and would perpetually remain, a group of under-16-year-old Latino boys. Thus, the controller of the group as a whole was understood to be the constant source of Menudo-ness, not the interchangeable members themselves.

Sports teams have the parallel of a (hopefully) consistent coach, tasked with quality: controlling a team. However, if public conception truly drives attribution, one may find that an essential quality of a team may be affiliated with the athletic director, school, or student body.¹⁷⁶ As has been argued in proceedings against the National Collegiate Athletic Association (NCAA) for profiting off athlete likeness, individuals have at least a marginally demonstrative effect on

¹⁷⁴ *Id.* at 582.

¹⁷⁵ *Supra* note 172, at 191.

¹⁷⁶ *Infra* note 348.

merchandise sales and contributions to a team's essence. Some products, a specific player's jersey for instance, are fairly obvious reflections of individual value and quality contributions.¹⁷⁷

2. Diminishing Expectations of Control

The court's tone on concern for trademark quality control has consistently diminished with time.¹⁷⁸ In common law prior to the Lanham Act, an actual source's indication was required for a mark to be considered valid.¹⁷⁹ As licensing informally appeared in the business world, the judiciary disclaimed those who did not exclusively use their trademarks under strict controls, exacting uniformity.¹⁸⁰ Usage by "related companies" was formally introduced by the Lanham Act,¹⁸¹ defined in section 45: "The term 'related company' means any person who legitimately controls or is controlled by the

¹⁷⁷ Ari Wasserman, *An 'Epidemic' of Fake Ohio State Jerseys: Why Buckeyes Fans Are Buying Them and What it Means for the Program*, CLEVELAND.COM (Nov. 11, 2015, 8:00 AM; last updated Apr. 21, 2016, 4:14 PM), http://www.cleveland.com/osu/index.ssf/2015/11/an_epidemic_of_fake_ohio_state.html (discussing the popularity of non-licensed jerseys replicating Ohio State University's jerseys and purchased due to the cost-prohibitive price point of official merchandise as well as a desire to acquire specific player names and numbers). Interestingly enough, jerseys of specific players were recently pulled from official offerings because of player lawsuits for non-compensation for their likeness in these sales. This trend is, ironically, evidence to the players' point against the NCAA, but the result still leaves them uncompensated.

¹⁷⁸ See Irene Calboli, *The Sunset of "Quality Control" In Modern Trademark Licensing*, 57 AM. U. L. REV. 341, 351–52 (2007).

¹⁷⁹ *Macmahan Pharmacal Co. v. Denver Chem. Mfg. Co.*, 113 F. 468, 474-75 (8th Cir. 1901).

¹⁸⁰ *Broeg v. Duchaine*, 67 N.E.2d 466, 468 (Mass. 1946) (stating that the license at issue was not valid because it was not subject to any requirement that the licensee's products conform to fixed standards).

¹⁸¹ Lanham Act, 15 U.S.C. §§ 1051-1127 (1964).

registrant or applicant for registration in respect to the nature and quality of the goods or services in connection with which the mark is used.”¹⁸²

Legitimate or adequate, control was never explicitly defined, but *exercising* it in some capacity was mandatory, as wholly-uncontrolled marks were found invalid.¹⁸³ Quality control rationalized the extension into licensing, as the mark’s inferred quality to consumers was ensured when “the plaintiff sufficiently policed and inspected its licensees’ operations to guarantee the quality of the products they sold under its trademarks to the public.”¹⁸⁴

Control standards then were interpreted as “actual.” Basically, standards in practice had to be maintained, though specifics no longer need to be formally stated.¹⁸⁵ But others accepted expressly stated controls, even if they were not actually enforced.¹⁸⁶ The standard benchmark of “adequate” controls shifted to “sufficient” and then to “minimal” controls.¹⁸⁷ Several cases from the mid-century onward overlooked a lack of any affirmative control, so long as the products did not deceive¹⁸⁸ the public in effect.

¹⁸² *Id.* § 1127.

¹⁸³ *Sterling Drug, Inc. v. Lincoln Laboratories, Inc.*, 322 F.2d 968 (7th Cir. 1963).

¹⁸⁴ *Dawn Donut Co. v. Hart's Food Stores, Inc.*, 267 F.2d 358 (2d Cir. 1959).

¹⁸⁵ *Embedded Moments, Inc. v. Int’l Silver Co.*, 648 F. Supp. 187, 194 (E.D.N.Y. 1986).

¹⁸⁶ *Pike v. Ruby Foo’s Den, Inc.*, 232 F.2d 683, 685–86 (D.C. Cir. 1956).

¹⁸⁷ *Kentucky Fried Chicken Corp. v. Diversified Packaging Corp.*, 549 F.2d 368, 387 (5th Cir. 1977).

¹⁸⁸ *See Land O’Lakes Creameries, Inc. v. Oconomowoc Canning Co.*, 330 F.2d 667 (7th Cir. 1964); *Transgo, Inc. v. Ajac Transmission Parts Corp.*, 768 F.2d 1001 (9th Cir. 1985); *Taco Cabana Int’l, Inc. v. Two Pesos, Inc.*, 932 F.2d 1113 (5th Cir. 1991), *aff’d*, 505 U.S. 763 (1992). Notably the facts of all these cases included a long-standing close working relationships in which the assumption of standards being met was reasonably solid, and none actually failed to do so.

C. Creation of Commercial Association

In expanding trademark rights past source-attribution, courts have accepted the “creation of a commercial association” as both something that may not be wrongfully implied by non-mark holders and as evidence of mark ownership by the rightful ones. Thus, this expansion may be used as a double-edged sword in trademark law. Commercial association has been described in terms of expenditures, advertising, timelines and breadth of use, and distinctiveness of use. Importantly, this association building is a common route for non-mark attributes to become privatized.

Association construction has caught the ire of trademark holders in the circumstances of “ambush marketing.”¹⁸⁹ This is when outsider businesses craft unsanctioned paths to consumers, reaching them in some channel to which mark holders feel they have an exclusive claim. For instance, the National Hockey League (NHL) attempted to enjoin Pepsi from referring to “pro-hockey” teams and mentioning teams’ home cities in commercials aired during game broadcasts, without entering into an official relationship with the league.¹⁹⁰ However, all of Pepsi’s content explained the lack of affiliation with the NHL, which Canadian courts found to have effectively eliminated whatever minimal possibility of confusion might have been created, so the action failed.

A famed “ambush marketing” incident, which never made it to court, centers on the 2010

¹⁸⁹ See Edward Vassallo, Kristin Blemaster & Patricia Werner, *An International Look at Ambush Marketing*, 95 TRADEMARK REP., 1338 (2005) (including a thorough discussion of international treatments of ambush marketing, which is largely unaddressed in the United States judiciary as of yet).

¹⁹⁰ *National Hockey League et al. v. Pepsi-Cola Canada Ltd.* (1992), 70 B. C. L. R. 2d 27 (Can. B.C. S.C.).

Fédération Internationale de Football Association (FIFA) World Cup.¹⁹¹ Bavaria Beer gave away about 120,000 bright-orange and branded lederhosen to enraged Dutch fans to a match-up, without sponsorship by the governing body, FIFA. Attention-grabbing use of team colors attracted fans, and so many of them showed up in the sponsored gear that FIFA officials took notice. FIFA officials reacted by requiring many fans to strip the lederhosen off before entering the stadium, leaving stands full of Dutch spectators dressed only in their underpants. Ostensibly, the incorrect commercial association Bavaria was forging with FIFA was under attack here. However, the game attendees could hardly be confused as to the singular official beer sponsor, as Budweiser was the only brew available for sale in the stadium. Perhaps the Bavaria logo would be displayed in broadcasts, but limiting exposure via camera operation seems an easier remedy. By the time fans entering a stadium are being asked to disrobe, personal expression is being quelled for misappropriation of FIFA's marketing power. Curious also is the unexamined commercial association at play. Are fans choosing to attend or watch the match because of their reverence for the controversial FIFA brand, or their own love of the sport, team, or national pride, which happens to be embodied by the color orange?¹⁹²

It is now commonplace to hear about brands forging back-alley "ambush marketing" associations through tangential sponsorship. Beats headphones distributed to and worn by Olympic stars gained them international attention without the cost of an official partnership.¹⁹³

¹⁹¹ Mark A. Lemley & Mark McKenna, *Irrelevant Confusion*, 62 STAN. L. REV. 413 (2010).

¹⁹² This falls into the concerns discussed *supra* Section B. Inherent Goodwill.

¹⁹³ Andrew Hammp, *How Beats By Dre Got Their Headphones On Olympians' Ears (Despite Violating IOC Policy)*, BILLBOARD, (July 31, 2012, 4:30 PM), <http://www.billboard.com/biz/articles/news/branding/1084390/how-beats-by-dre-got-their-headphones-on-olympians-ears-despite>.

Athletes and celebrities alike are given numerous free products for the potential value of their exposure as advertisement (if not endorsement).¹⁹⁴ If brands can take advantage of this publicity for their own marks, how can they stop others from doing the same? Rationalizing an exclusive right to control all possible commercial connotations effectively freezes that event or product right where the owner wants it, untouchable to anyone else's interpretation or use—including consumers.

Authorship of a commercial link is largely assumed at mark registration without inquiry. Absent proof of commercial use has led to the “race to register” terms, including some of the opportunistic instances previously outlined.¹⁹⁵ Determining to whom the mark rights should go is often solved by the fiduciary nature of many agency relationships in business, but it is less clear when institutions and individuals may have various stakes to mark.

“Refuse to lose” is both a catchy rhyme¹⁹⁶ and a trademarked phrase. In a February 20, 2017 Google search, the first page of over 16 million results includes songs by “Brotha Lynch

¹⁹⁴ Interview with Heather Lounsbury, Producer of product “placements” mentioned during the telecast of the Academy of Motion Picture Arts and Sciences Oscar Awards (College Park, Maryland, Aug. 29, 2016).

¹⁹⁵ See, e.g., *supra* note 116.

¹⁹⁶ As *Pagliari* found, *supra* note 110, a distinctive pattern could be artistic and desirable in a printed design. The intrinsic pleasantness of a linguistic pattern, such as rhyme, has yet to be considered for its non-reputational advantages over less aesthetically appealing use of language. Linguistic advantages are potential examples of embedded psychological or cognitive functions a mark may be capable of serving as detailed in Hughes, *supra* note 14, at 1251.

Hung,¹⁹⁷ “Dead Prez,”¹⁹⁸ Jarekus Singleton,¹⁹⁹ an anti-gang task force²⁰⁰ in Lakeland, Florida, and one reference to a book by John Calipari. Calipari personally applied for registration of the phrase as a trademark in 1994²⁰¹ after using it motivationally as a third-year head coach for the University of Massachusetts men’s basketball team. The motto was familiar to the school, popularized by a shirt made by senior players about their successful 1990 men’s football team.²⁰² But UMass’ use was not unique, since initial mark registration was actually sought out by the coach for women’s tennis at Duke University.²⁰³

¹⁹⁷ Brotha Lynch Hung, *Refuse to Lose*, YOUTUBE (Apr. 11, 2010), <https://www.youtube.com/watch?v=T9117581Jb4>.

¹⁹⁸ Dead Prez, *Refuse to Lose*, YOUTUBE (July 5, 2009), <https://www.youtube.com/watch?v=frFCbUoQcVU>.

¹⁹⁹ <http://www.amazon.com/Refuse-To-Lose-Jarekus-Singleton/dp/B00ITNG4P0>.

²⁰⁰ *Refuse to Lose Make the Pledge*, CITY OF LAKE LAND, <http://www.lakelandgov.net/refuse-to-lose>.

²⁰¹ REFUSE TO LOSE, Registration No. 2048577.

²⁰² *Former UMass Coach Seeks Trademark on Slogan*, AP NEWS ARCHIVE (Jul. 18, 1996, 6:57 AM), <http://www.apnewsarchive.com/1996/Former-UMass-Coach-Seeks-Trademark-on-Slogan/id-321a3e72dc1c0e0e34e466699e059847> (““That slogan was meant for the football team and any other program at the university. It was not meant to make one individual wealthy,’ Paul Mayberry, a co-captain and All America on the 1990 football team, told the Globe.”).

²⁰³ *Calipari Refuses to Lose Any Money Over Trademarked Slogan*, BOSTON GLOBE (Jul. 18, 1996), available at <http://www.sportsbusinessdaily.com/Daily/Issues/1996/07/19/Sponsorships-Advertising-Marketing/CALIPARI-REFUSES-TO-LOSE-ANY-MONEY-OVER-TRADEMARKED-SLOGAN.aspx?hl=Marketing%20and%20Sponsorship&sc=0>.

To understand claims of attribution, it should be acknowledged that John Calipari is undoubtedly as savvy a marketer²⁰⁴ as he is a coach (and he is a quite successful coach).²⁰⁵ He negotiated ESPN airtime by accepting a midnight “madness” game and continually praised the fan base, which then rose to meet his expectations.²⁰⁶ Publicity bred athletic recruiting, which bred success that benefitted UMass as a whole. Calipari had “refuse to lose” embroidered on the team’s warm-up outfits, which were now more and more frequently televised. Sponsorship deals followed for “refuse to lose” branded—as well as general—school merchandise, so both Calipari and the university benefitted.²⁰⁷ It is no wonder that UMass did not protest when Calipari took rights to the school motto with him to a short-lived NBA coaching job in 1996, promising to allow UMass continued free usage, but collecting all outside licensing fees for himself. The school has credited him with “catapulting” them to “national prominence,”²⁰⁸ which would plainly indicate that at least those school authorities believe a commercial attribution to the coach is legitimate.²⁰⁹

²⁰⁴ MARK A. McDONALD & GEORGE R. MILNE, *CASES IN SPORTS MARKETING* 296–304 (1999).

²⁰⁵ Seth Davis, *Appreciating all that John Calipari has achieved en route to the Hall of Fame*, *SPORTS ILLUSTRATED* (Sep. 10, 2014), <http://www.si.com/college-basketball/2015/09/10/john-calipari-kentucky-wildcats-basketball-hall-fame>.

²⁰⁶ *Id.*

²⁰⁷ *Id.*

²⁰⁸ Michael Powell, *Violations by John Calipari’s Teams? Don’t Look at Him*, *N.Y. TIMES* (Mar. 25, 2015), <http://www.nytimes.com/2015/03/26/sports/ncaabasketball/coach-caliparis-wonderful-life-begin-the-disclaimers.html>.

²⁰⁹ UMass basketball’s highest nationally recognized achievement is still a Final Four appearance in Calipari’s final coaching term. Ironically, given the NCAA’s publicity and legal trouble, *id.*, surrounding profits made off of unpaid student-athletes, that peak appearance was vacated for NCAA violations shortly after his departure. Still, it has not altered the university’s sentimental affections.

Still, as with “three-peat,”²¹⁰ this evolves into a coach taking credit and compensation for a phrase popularized by his team, then continuing to benefit later on as a direct competitor of that team. Consider the institution’s possible claim to mark rights. While Calipari was an impactful coach at UMass, he was also the university’s employee (and a state employee at that), with a fiduciary duty to put the institution’s commercial interests ahead of his own. One may assume that does not include promoting his money-making mark’s notoriety via university broadcasts and mandated team apparel. “Refuse to lose” now holds licensing deals with teams and athletes such as the Seattle Mariners²¹¹ Major League Baseball team, and Jeff Gordon²¹² of NASCAR. This raises issues since both are hard to conceive as related to an NCAA basketball coach, as well as firmly entrenched with different meanings for relevant consumers.²¹³ Those two other groups of fans may all want wins—to “refuse to lose” them in fact—in each respective sport; and the “qualities” necessary for this achievement vary greatly. If not due to its inherently pleasing cadence and rhyme,²¹⁴ or its status as a laudatory phrase, the mark’s genericism and lack of relevant consumer association should void the mark, if it were ever contested in court.

²¹⁰ See Kantorczyk, *supra* note 157.

²¹¹ Matthew Halverson, *Crazy Freaking Castoffs*, SEATTLEMET (Sept. 23, 2015, 11:39 AM), <http://www.seattlemet.com/articles/2015/9/23/crazy-freaking-castoffs-mariners-1995>.

²¹² Sports People: Basketball; ‘Refuse to Lose’ and Pay Calipari, N.Y. TIMES (July 19, 1996), <http://www.nytimes.com/1996/07/19/sports/sports-people-basketball-refuse-to-lose-and-pay-calipari.html>.

²¹³ See *supra* Section III. B. Of the Consumer.

²¹⁴ See Hughes, *supra* note 14 (discussing cognitive preference for some marks inherently over other).

1. *Circularly Setting Perceptions*

While establishing commercial association presents normative issues, so does the tangential subject of “consumer confusion” surrounding those associations. Initially, courts punished users who created doubt in consumer minds as to whether or not there was a trademark link on a product being sold. At its purest form, outright deceptiveness would lead to proof that actual consumers were misled, easily justifying this protection. However, the definition has broadened in tandem with mark holder rights. Thoroughness in considerations contributed to developing multifactor tests for confusion,²¹⁵ a rational response to situations such as the relatedness of products found in Aunt Jemima.²¹⁶ Confusion expanded from actually misleading consumers to include causing momentary confusion, even when overcome before a purchase is made.²¹⁷ “Likelihood” originally implied a probability of confusion, but some have interpreted the standard more broadly as, instead, a mere possibility.²¹⁸

²¹⁵ See, e.g., *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979); *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (explaining how the multiple factors considered in determining consumer confusion are elaborated as: (1) the strength of the mark; (2) the proximity of the goods; (3) the similarity of the marks; (4) evidence of actual confusion; (5) the similarity of marketing channels used; (6) the degree of caution exercised by the typical purchaser; and (7) the defendant's intent).

²¹⁶ *Supra* para. in text accompanying note 36.

²¹⁷ See Jennifer E. Rothman, *Initial Interest Confusion: Standing at the Crossroads of Trademark Law*, 27 *CARDOZO L. REV.* 105 (2005).

²¹⁸ *Versa Prods. Co. v. Bifold Co.*, 50 F.3d 189, 200 (3d Cir.1995) (citing *Merchant & Evans, Inc. v. Roosevelt Bldg. Prods.*, 963 F.2d 628, 637–38 (3rd Cir. 1992); *Country Floors, Inc. v. A Partnership Composed of Gepner & Ford*, 930 F.2d 1056, 1065 (3rd Cir. 1991); *Telechron, Inc. v. Telicon Corp.*, 198 F.2d 903, 908–09 (3rd Cir. 1952); (“Although this usual formulation of trade dress infringement requires a showing of a likelihood or probability of confusion, this standard has been relaxed in some cases. Where an alleged infringer was new to an area and the plaintiff was well-established, this court has at times replaced the ‘likelihood of confusion’ requirement with a lower ‘possibility of confusion’ standard.”) The

Semantic stretching deforms the meaning of “confusion” and “consumers” as well. In *Boston Professional Hockey Association, Inc. v. Dallas Cap & Emblem Manufacturing, Inc.*,²¹⁹ the court found that, despite consumers’ correct knowledge and impression about the origin of a product, conjuring a mental association with another mark holder qualified as “confusion.”²²⁰ This finding overlooked the products at hand being distantly removed from the mark holder’s sphere of interests, distinguishing the case from the *Au-Tomotive* precedent. This was a major leap in prohibiting confusion that did not, in any common sense, actually exist.²²¹ It has effectively conflated causing associative thought with confusion.

In many cases dealing with potentially real consumer confusion, judges have declared that disclaimers are adequately clarifying and useful to balance rights and freedoms of speech. However, this protection does not always apply. The University of Georgia²²² succeeded in an infringement case, rejecting disclaimers as capable of protecting marks from third parties. The Collegiate Licensing Company (CLC) represents Georgia, among many universities around the country, in licensing matters. All official member merchandise bears a mandatory hologram tag, which represents the authenticity of licensed products.²²³ As a secondary mark for further

court found that, at least in trade dress, the lower standard of possible confusion was only appropriate as a contribution to a multifactor analysis of a likelihood of confusion, and could not hold its own. *Id.*

²¹⁹ 510 F.2d 1004 (5th Cir. 1975).

²²⁰ *Id.* at 1012.

²²¹ Criticized roundly, *e.g.*, *supra* note 114.

²²² *University of Ga. Athletic Ass’n v. Laite*, 756 F.2d 1535 (11th Cir. 1985).

²²³ *FAQs: Consumer - How do I know that a product is licensed and approved by an institution?*, COLLEGIATE LICENSING COMPANY (“CLC”), (last visited Feb. 28, 2017), <http://www.clc.com/Resources/FAQs.aspx#CatLink7e6f57f5-d209-4b9f-9bd0-a631b670def0> (advising customers to “look for the Officially Licensed Collegiate Product (OLCP) hologram label,” which all of

identification of official items, it also—by definition—demonstrates which goods are unofficial. The business-minded state of trademark law does not acknowledge this state of affairs. Even when confusion is nearly impossible, consumers’ possible interest in purchasing the unofficial form is quashed. The reality is stark when compared to the information-transmission or consumer-interest foundations on which trademarks lie.²²⁴

There are instances of boldfaced denial or intentional obtuseness by mark holders, in regard to consumer perceptions, as well as to their own legal standing. These are “strike suits,”²²⁵ baseless cease-and-desist threats and filings often intended to broaden mark holder rights by deterring legitimate market entrees.²²⁶ Some baseless trademark-based cases are less sinister, if only because their purpose is more challenging to parse. For example, Louis Vuitton sent to a Penn Law fashion intellectual property symposium a cease-and-desist letter, regarding a flyer that featured a twist on the Louis Vuitton monogram pattern.²²⁷ Clearly, that flyer’s “consumers” were an audience discussing the very law at hand, rendering perhaps the lowest likelihood of confusion conceivable.²²⁸ In critiquing this action, the law community raised arguments of

the CLC’s approximately 200 member institutions (colleges, universities, and affiliated organizations such as athletic conferences) mandate for the sale of their products.

²²⁴ *Supra* Section I. A. Justifications.

²²⁵ *See* Port, *supra* note 31, at 589.

²²⁶ This dynamic compounds issues discussed *supra*, Section IV. A. Anti-Competitive Incentives.

²²⁷ Michael Risch, *Really, Louis Vuitton? Really?*, MADISONIAN.NET (Mar. 4, 2012), <http://madisonian.net/2012/03/04/really-louis-vuitton/> (The cease-and-desist letter even journeys into their take on consumer confusion, accusing the IP professors of misleading consumers to think this was legal use because they “must be experts” when in fact the only issue was whether the flyer conveyed a true perception to the viewer (the public)).

²²⁸ Charles Colman, *Louis Vuitton Sends Absurd Cease-and-Desist Letter to Penn Law*, LAW OF FASHION (Mar. 3rd, 2012), <http://lawoffashion.com/blog/story/03/03/2012/121>.

parody, fair use, and a lack of commercial use in promoting a free educational symposium, as well as a flyer's clear distinction from handbags. To quote one legal blog's analysis, "Louis Vuitton either has a very finely tuned sense of irony, or none at all."²²⁹ This was a rather brash example of a mark holder stepping confidently outside the scope of reasonable protections its mark is afforded, in order to threaten legal action. Most troubling, with an even slightly less sophisticated (or financially and legally armed) letter recipient, this type of trademark bullying likely creates ever more confusion concerning which types of mark use are legally permissible, and threatens to chill free speech.

The interpretation of "consumer" in "consumer confusion" has been equally untenable. An "average consumer" is imagined to have widely ranging capability and discernment.²³⁰ Controversially, confusion also expands to include post-purchase, meaning the confusion of some third-party onlooker, other than the consumer. It abandons the intention of facilitating a market's information transmission, and punishes an accurate one. Instead, this crystallizes one mark's meaning beyond the point-of-sale, into an entity to be preserved in everyday life and not to be encroached upon by non-commercial activity of everyday people. The doctrine of initial interest confusion, too, runs against the market-facilitating grain.²³¹ These two mutations stem from misplaced fealty to producer interests.

²²⁹ *Id.*

²³⁰ *See* Greame, *supra* note 78 (emphasizing that "the public must be credited with a minimum capacity for discrimination," but also noting, that recently "ordinarily prudent consumers have also been characterized as 'credulous,' 'inexperienced,' and 'gullible.'" (footnote omitted) (quoting *Hiram Walker & Sons, Inc. v. Penn-Maryland Corp.*, 79 F.2d 836, 839 (2d Cir. 1935)).

²³¹ *Supra* notes 191 & 217.

If the bounds of confusion are, well, confusing, the standards of proof in applying them are as well. The definition of a relevant-consumer market is largely unstable,²³² and thus, interpreting people's conception of a mark is, also. Consumer surveys are often cited as the most persuasive form of proof for the court.²³³ However, structural limitations are often ignored, including consideration of effects under reader-response theory,²³⁴ observer effect, and other concepts.²³⁵ Inconsistencies in applying consumer studies to cases by the court are more troublesome. The distinct meaning of specific words is crucial to drawing accurate mark boundaries, yet the delicateness of language is often eschewed. For example, one case accepted proof of infringement from a study that asked if one term "goes along with" another.²³⁶ In addition to that questionable phrasing, the court accepted ten percent consumer agreement with that statement as a sufficient level to find confusion. Other cases have rejected survey findings at

²³² *Supra* note 151.

²³³ *See, e.g.,* Robert C. Bird & Joel H. Steckel, *The Role of Consumer Surveys in Trademark Infringement: Empirical Evidence from the Federal Courts*, 14 U. PA. J. BUS. L. 1013, 1017 (2012).

²³⁴ Linda M. Scott, *The Bridge from Text to Mind: Adapting Reader-Response Theory to Consumer Research*, 21 J. CONSUMER RES. 461, 474 (1994)("[R]esearchers regularly try to match respondents' interpretations to a single correct meaning or answer as articulated in a questionnaire Then we treat the variation from the preconceived correct meaning as a form of error.").

²³⁵ *Supra* note 233.

²³⁶ *Mutual of Omaha Ins. Co. v. Novak*, 648 F. Supp. 905 (D. Neb. 1986), *aff'd*, 836 F.2d 397 (8th Cir. 1987). "Goes along with" could be interpreted to establish a relationship quite distinct from confusion, conceivably. If a poll were conducted to measure if a brand of peanut butter, for example, "goes along with" a brand of jelly, response rates would likely be far above the 10% threshold that was found to be sufficient here, though obviously these two products are complimentary and quite distinct from one another. *Id.*

levels of 14 to 31 percent confusion.²³⁷ It is not just the meaning of confusion or consumers or standards of proof that are unpredictable, but all of the above.

These changes unilaterally favor the strengthening of mark protections. Mark holder influence in shaping trademark law is strong, even beyond one's potential influence as the party most aligned with legal precedent. Indeed, the way that trademarks are utilized in commerce informs consumer expectations of what is proper and legally necessary. This is how the *Boston Hockey* ruling of confusion originated.²³⁸ It does not matter that the usage was known to be unofficial and that mark holders factually, at that time, lacked the legal basis to impede it. These and similar mark holders behave as if they have rights to all expressions of their trademarks in their commercial and legal activity. The fact that *this* misleads consumers is then bizarrely legitimized when the court bars a third-party's conduct, although normally lawful, in order to eliminate such confusion. So, the mark holder has created the circumstances that sow the confusion which redounds to the mark holder's own benefit: truly a circular path to mark holder victory through manipulated perceptions.

2. Double Meaning of Word and Law

In determining where a trademark is classified on the spectrum of distinctiveness,²³⁹ the denotations and connotations of each word are important issues of fact. The difference between an inherently distinctive suggestive mark and a descriptive mark is one of a "minimal mental leap" made by consumers, which is challenging to measure objectively; one may consider it to be the amount of imagination consumers require to connect the mark to the product's image or

²³⁷ *Prudential Ins. Co. v. Gibraltar Fin. Corp.*, 694 F.2d 1150, 1155–56 (9th Cir. 1982).

²³⁸ *Supra* note 137.

²³⁹ *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 7 (2d Cir. 1976).

shape. The critical standard is that establishing the mark should not unjustly interfere with competitors' right to accurately characterize their own wares. Further up the distinctive scale, valid arbitrary marks rely on consumer's ability to deal with homophones as they add a new meaning to an existing word. However, in cases of dilution, mark holders essentially argue that when consumers use that same mental capacity, which allows for a secondary meaning forged by arbitrary marks, this offends their mark's legitimacy and value.

Dilution was first established by the Federal Trademark Dilution Act of 1995 ("FTDA"),²⁴⁰ protecting famous marks from non-confusing uses that would water down the original mark in consumers' minds. The Supreme Court interpreted this in 2003 to mean that a mark holder must be able to prove that actual dilution and harm was taking place.²⁴¹ Congress responded by passing the Trademark Dilution Revision Act of 2006 ("TDRA").²⁴² It clarified the definition of the "famous marks,"²⁴³ lowered the standard to a "likelihood" of dilution, and explained its two forms: tarnishment²⁴⁴ and blurring.²⁴⁵ On remand, in light of the TDRA, the facts from the original 2003 Supreme Court case, *Moseley v. V Secret Catalogue, Inc.*, were found to be a dilution,²⁴⁶ though a strong dissent criticized the other justices for accepting a

²⁴⁰ Pub. L. No. 104-98, § 3, 109 Stat. 985 (1996) (codified at 15 U.S.C. § 1125(c) (2006)).

²⁴¹ *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003).

²⁴² Pub. L. No. 109-312, 120 Stat. 1730 (codified as amended 15 U.S.C. § 1125(c) (2006)).

²⁴³ 15 U.S.C. § 1125(c)(2)(A) (2012). See Robert W. Emerson & Catherine R. Willis, "International Franchise Trademark Registration: Legal Regimes, Costs and Consequences," 52 WAKE FOREST L. REV. (March 2017) (forthcoming) (discussing, *inter alia*, famous marks and international trademark registration).

²⁴⁴ 15 U.S.C. § 1125(c)(2)(C) (2012).

²⁴⁵ 15 U.S.C. § 1125(c)(2)(B) (2012).

²⁴⁶ 605 F.3d 382, 390 (6th Cir. 2010), *cert. denied*, 131 S. Ct. 1003 (2011).

“possibility” instead of true “likelihood.”²⁴⁷ In summary, since inception, dilution has slid the way much of trademark law in general has: into leniency in favor of mark holder rights.

Dilution is triggered where, “in the mind of the consumer, the junior mark will conjure an association with the senior.”²⁴⁸ There is no confusion, which would be traditional infringement, but the courts have established dilution occurs when consumers who fully understand the sources of all respective goods are led to even think of a commonly known famous mark. This attempt to control mark connotations, absent confusion, lacks logical bounds, especially given the interconnected nature of the language that necessarily comprises all words used for speech, writing, and trademarks.

For example, Coach, the handbag and leather-goods brand, sued an academic tutor coaching service.²⁴⁹ Coach lost its case due to a failure to submit adequate proof of the mark’s fame. While the court mentioned the academic service had “distinct meanings and commercial impressions,” that would not necessarily have bearing, given the dilution statute. Marks carrying separate commercial impressions could still conjure thoughts of the senior one, and indeed, that is what the lack of confusion necessary for dilution implies.

“Coach,” when applied to leather goods, was likely an arbitrary mark.²⁵⁰ While Coach, Inc. was established in 1941,²⁵¹ the word pre-dated the brand with established meanings in other

²⁴⁷ *Id.* at 394 (mirroring the stretching of consumer confusion from a standard of actuality to a standard likelihood and then to something less than that).

²⁴⁸ *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 218 (2d Cir. 1999).

²⁴⁹ *Coach Servs., Inc. v. Triumph Learning LLC*, 96 U.S.P.Q.2d (BNA) 1600 (T.T.A.B. 2010), *aff’d*, No. 2011-1129, 2012 WL 540069 (Fed. Cir. Feb. 21, 2012).

²⁵⁰ *See supra*, Section I. C. Spectrum of Distinctiveness.

²⁵¹ *Company Profile, COACH*, <http://www.coach.com/company-information.html>.

contexts dating back to the 1500s.²⁵² Academic tutors, as well as motivational sports trainers or transportation services, all have a plainly descriptive use for the term. Many other businesses may have reasonable suggestive uses, too.²⁵³ For instance, a sports bar name including the word “Coach” would be implying a sports-centric meaning, far removed from the purse company’s interests, in a way that would otherwise be inherently distinctive. The definition of famous marks indicates perception among the general public as a source of goods.²⁵⁴ However, that does not necessarily mean that is the mark’s sole or even most prominent meaning, in every circumstance, to every consumer.

In *Visa Int’l Serv. Assn. v. JSL Corp.*,²⁵⁵ the court denied a multilingual education service’s defense that it was using the common meanings of the word “visa,”²⁵⁶ stating that the service had instead created a “novel meaning” wrongfully²⁵⁷ competing with Visa credit cards, regardless of “allusions to the dictionary definition.” The court addressed the senior mark’s

²⁵² *Coach*, ONLINE ETYMOLOGY DICTIONARY, <http://www.etymonline.com/index.php?term=coach>.

²⁵³ Ann Bartow, *Likelihood of Confusion*, 41 SAN DIEGO L. REV. 721, 743 (2004) (“The word ‘ice’ is generic for cubes of frozen water, but was held to be a suggestive and therefore protectable mark with respect to chewing gum. ‘Ice’ also has been used as a trademark for beer, and in one lawsuit was asserted to be generic by one litigant, while the mark holder claimed that the relationship between ice and beer was ‘either arbitrary, fanciful or suggestive.’”).

²⁵⁴ *Supra* note **Error! Bookmark not defined.**

²⁵⁵ 610 F.3d 1088, 1090 (9th Cir. 2010).

²⁵⁶ *Id.* at 1089.

²⁵⁷ Eric Goldman, *Puzzling 9th Circuit Dilution Opinion over eVisa.com—Visa v. JSL*, TECHNOLOGY & MARKETING LAW BLOG (Jul. 6, 2010), http://blog.ericgoldman.org/archives/2010/07/puzzling_9th_ci.htm (criticizing this ruling for also interpreting the standard of “likelihood of confusion” without any proof, and, instead, simply by the “characteristics of the marks at issue.”).

interaction with dictionary definition: “[t]he Visa mark draws on positive mental associations with travel visas, which make potentially difficult transactions relatively simple and facilitate new opportunities and experiences. Those are good attributes for a credit card.” Those same mental associations and attributes are equally beneficial to a language-learning service, regardless of credit cards that boast similar ideals. Notably, although the court stated that Visa “draws on” these presumably inherent mental associations, credit is not given for creating them. However, the dilution doctrine crystallizes the word’s meaning; it may only either narrowly describe a literal visa or describe closely related qualities exclusively for the Visa credit card. Privatizing all the word’s connotations silences much more expression than trademark’s justifications can support.

Granting these sweeping rights to only one class—famous marks—may be rationalized as protecting dominant consumer interpretations, but is unfair to other marks if we deem the public capable of multiple meanings. The more famous mark is not necessarily the original one, creating a situation where an older and legitimately strong mark, may be attacked for “diluting” one that gains non-confusing fame, which it had no recourse to prevent. It is similar to the impropriety addressed by the uncommon doctrine of reverse-confusion.²⁵⁸ This is when a chronologically senior user claims that a junior’s mark usage is so extensive that it erodes the senior mark’s value, causing consumers to mistakenly believe the more common mark is the original owner.²⁵⁹ With this “takeover,” the latter mark holders respond with a defense by way of the mark’s capability for dual meanings.

²⁵⁸ Anthony L. Fletcher, *The Curious Doctrine of Reverse Confusion—Getting it Right in Reverse*, 95 TRADEMARK REP. 1273 (2005).

²⁵⁹ J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:10 (4th ed. 2004).

An illuminating example comes from the case of *Illinois High School Association v. GTE Vantage Inc.*²⁶⁰ The phrase “March Madness” was included in a basketball-themed volume of essays and poems by Henry Porter, a pioneer of the sport.²⁶¹ The Illinois High School Association dubbed its playoff basketball tournament “March Madness” in 1939 and officially merchandised it as such in 1973.²⁶² Nine years later, CBS anchor Brent Musburger first identified the NCAA college basketball tournament as “March Madness” on air.²⁶³ A decade later, CBS registered the mark in relation to the televised NCAA tournament.²⁶⁴ The power of broadcasting in appropriating the word’s meaning was acknowledged by the court:

Most people know what they know about college basketball from the media. If the media call the NCAA tournament “March Madness,” that is what the public will call it, or know it as. IHSA argues that it is unfair to make its rights depend on the whims of the media. Because a court could not, without violating the free-speech clause of the First Amendment, have enjoined (or used other legal remedies to

²⁶⁰ 99 F.3d 244 (7th Cir. 1996), *cert. denied*, 117 S. Ct. 1083 (1997).

²⁶¹ Nathan Fenno, *Heart of Madness*, L.A. TIMES (Mar. 20, 2014), <http://articles.latimes.com/2014/mar/20/sports/la-sp-march-madness-illinois-20140320> (Porter also connected “midnight madness” to the sport, and designed fan-shaped backboards).

²⁶² *March Madness History*, ILLINOIS HIGH SCHOOL ASSOCIATION, <http://www.ihsa.org/SportsActivities/MarchMadnessExperience/MarchMadnessHistory.aspx> (last accessed Sept. 15, 2015).

²⁶³ Musburger was a sportswriter and broadcaster in the Chicago area in the early 1970s and frequently covered IHSA’s “March Madness” tournament. Although he did not mention the high school original in the broadcast, he was exposed to the term in its original source. *See* Wes Smith, *IHSA Jumping Through Hoops to Keep “March Madness” from NCAA*, CHI. TRIB., May 12, 1996, at C7.

²⁶⁴ *Supra* 260 at 245.

prevent or deter) the media from calling the NCAA tournament “March Madness,” IHSA was helpless to prevent its trademark from being transformed into the name of another product. Its property right should not, it argues, depend on events over which it has no control.²⁶⁵

The first amendment does protect the press’ right to speak a trademarked word or phrase, even if it does so in a transformative manner.²⁶⁶ When CBS used “March Madness” solely in its broadcasts, it was fine. Marks may also be used referentially, even in purely commercial speech such as advertisements.²⁶⁷ So when the CBS broadcast–use turned the tide of the term’s meaning, it was then acceptable to advertise the CBS coverage by using the term. The court mentioned that the IHSA chose not to police the line where the media’s use extended beyond merely identifying the tournament, nor did IHSA strive to convince “lexicographically influential persons”²⁶⁸ of its mark’s meaning. However, there is no rationale to compel a mark holder to attempt such activity; mark holders have no such authority over broadcasters, so it is odd to critique a mark holder for not making demands that would be unenforceable.²⁶⁹

²⁶⁵ *Illinois High School Ass’n.*, 99 F.3d at 244.

²⁶⁶ *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir. 1987).

²⁶⁷ *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992).

²⁶⁸ *Illinois High School Ass’n.*, 99 F.3d at 244.

²⁶⁹ *See id.* The court acknowledged that the likelihood of success in these endeavors was not strong given precedent, and conceded that if the public current conception of the word formed despite them, their legal determination would stand. *Id.* The IHSA was essentially scolded for not attempting assiduous persuasion through the press. *Id.* No legal defensive actions were overlooked however, and the court offered none. *Id.* This all goes to the point of an unfair advantage that large and well-financed corporations have in guiding trademark law: why should a court expect a high school association to have the financial resources to engage in what may even appear to be a fruitless effort?

The decisive fact is that because the public is assumed to now believe that the mark refers to the NCAA tournament, original mark holders lack the injunctive right to compel them to now think otherwise. Similarly, generified terms cannot be resurrected,²⁷⁰ regardless of preventative conduct taken.²⁷¹ The IHSA decision takes a consequential new step of assimilating dual or multiple-use marks to these generic restrictions: “A trademark owner is not allowed to withdraw from the public domain a name that the public is using to denote someone else’s good or service, leaving that someone and his customers speechless.”²⁷² The impulse here is to limit trademark rights, which ironically has opened the door for the NCAA to proceed with its notably aggressive mark defense of “March Madness.”²⁷³

²⁷⁰ *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 957-58 (7th Cir. 1992). Even in anti-dilution territory, once distinctive nature is gone, so is protection. *See* 15 U.S.C. § 1125(c)(1) (2012); *see also* *McGraw-Edison Co. v. Walt Disney Prods.*, 787 F.2d 1163, 1174 (7th Cir. 1986).

²⁷¹ *Rogers Co. v. Keene*, 778 F.2d 334, 347 (7th Cir. 1985).

²⁷² *Illinois High School Ass’n*, 99 F.3d at 244.

²⁷³ Enforcement stretches to “march mania” and “march mayhem” claiming both words are synonyms for madness, tweaks including “live the madness” and “midnight radness,” as well as “The Big Dance,” “Final Four,” “Elite Eight,” and “Sweet Sixteen” in relation to basketball or possible endorsement. “Midnight Madness” is an egregious inclusion, if not because none of the NCAA March tournament is held at midnight, then because the NCAA itself documents the term’s origination by Maryland coach Lefty Driesell. *See, e.g.*, Sandra Guy, *Chicago Lawyer Tracks Down ‘March Madness’ Trademark Violators*, CHICAGO SUN-TIMES (Mar. 21, 2015, 9:00 AM), <http://chicago.suntimes.com/news/7/71/457694/chicago-lawyer-tracks-march-madness-trademark-violators>; Melissa Block, *NCAA Tries to Limit Use of March Madness*, NPR (Apr. 03, 2009 3:44 PM), <http://www.npr.org/templates/story/story.php?storyId=102726881>; Tim Bannon, *The Illinois Man Who Coined ‘March Madness,’* CHICAGO TRIBUNE (Mar. 14, 2015 10:15 AM), <http://www.chicagotribune.com/sports/college/ct-flashback-march-madness-spt-0315-20150314-story.html>; Christopher Zara, *Having a ‘March Madness’ Party? Be Careful What You Call It*, I.B. TIMES (Mar. 18, 2014 3:06 PM), <http://www.ibtimes.com/having-march-madness-party-be-careful-what-you-call-it-1562145>; Shaun Powell, *The Father of Midnight Madness*, NCAA (Oct. 14, 2011 10:06 AM),

In another basketball case, *Dream Team Collectibles, Inc. v. NBA Props., Inc.*,²⁷⁴ the mark “Dream Team” was utilized on sports trading cards, and the NBA subsequently began using the same term in reference to the men's Olympic basketball team. The card company sued and alleged unauthorized use of the mark created reverse confusion, constituted trademark infringement, unfair competition, false advertising, and dilution in violation the Lanham Act.²⁷⁵ The court rejected the NBA’s defense of a media-created meaning, citing a press release by the defendant as evidence of its propagation of association—using the media as a tool to take the trademark.²⁷⁶ An explicit paper trail is not always going to be available when a mark is co-opted, and even if it were there to be discovered, many small businesses would be unable to mount the expensive legal battle necessary against a behemoth the size of the NBA.

D. USPTO Drops the Ball

1. *Scrutiny in Granting Marks*

Registered marks carry a lofty presumption of validity, yet the standards of registration have been gradually eroded, with the United States Patent and Trademark Office (“PTO”) contributing to these woes. While its responsibility to petition for generification has been eliminated,²⁷⁷ the PTO should still scrutinize applications that lean in that direction. Instead, the

<http://www.ncaa.com/news/basketball-men/article/2011-10-01/father-midnight-madness> (“He only has one regret when he looks in the rear view mirror. ‘I should’ve trademarked the name Midnight Madness,’ he said. Another laugh. ‘Nowadays they have stores that conduct a Midnight Madness when they hold a sale. I could’ve made a lot of money.’”).

²⁷⁴ 958 F. Supp. 1401 (E.D. Mo. 1997).

²⁷⁵ *Id.* at 1403.

²⁷⁶ *Id.* at 1411.

²⁷⁷ *Supra* note 164.

PTO, in some instances, effectively encourages bad faith applications. *Damn I'm Good*²⁷⁸ was initially rejected as a mark because it did not serve as a source-identifier, as the words were featured in the manner of a prominently displayed²⁷⁹ slogan.²⁸⁰ Without altering or eliminating these primary functions, but with the simple addition of a second, conceivably source-indicating format²⁸¹ of the mark, the registration was granted. In this case, the PTO advised registrants to add a removable tag featuring the mark. *Damn I'm Good* was later invalidated in court for the same reason it was initially rejected: not actually serving mark purpose in the customer's mind.²⁸² The PTO gives credit to usages that "may be likely to create the commercial impression of a trademark,"²⁸³ not for uses that leave distinctly non-mark impressions. While secondary meaning is not necessary to register most marks, when a distinct primary goal other than source-identification is clear, feigning ignorance will not do either.

In the aforementioned case, the primary objective was clear to the PTO from its own analysis of the initial application. In a broader context, appraisals would do well to implement minimal investigatory standards for applications.²⁸⁴ Absence of or inconsistency in these standards allows marks to slip through the cracks.

²⁷⁸ *Damn I'm Good v. Sakowitz, Inc.*, 514 F. Supp. 1357 (S.D.N.Y. 1981).

²⁷⁹ T.M.E.P. § 1202.03(a) (2007) (stating a prominently featured word may be perceived as ornamental).

²⁸⁰ T.M.E.P. § 1202.03(f)(i) (2007) (stating a prominently depicted slogan may be perceived as expressive rather than source-indicatory).

²⁸¹ T.M.E.P. § 1202.03(a) (2007) (describing subtler word usage as more evocative of trademarks' source-indicatory impression).

²⁸² 514 F. Supp. at 1361–62 (S.D.N.Y. 1981).

²⁸³ T.M.E.P. § 1202.03(a) (2007).

²⁸⁴ Suggested *infra* Section V. D. Making the Calls.

The term “Frugalista” was a finalist for New Oxford American Dictionary’s word of the year in 2008.²⁸⁵ Eight days after that announcement, the standard character mark was registered²⁸⁶ to a blogger who quickly set to work petitioning the dozens²⁸⁷ of other bloggers, using the term self-referentially, to cease. The PTO does not explain its position on a mark’s level of distinctiveness, but, from this word’s dictionary definition, it would appear to be plainly descriptive of the blogs at hand. The fact that the word has a rather precise denotation precludes a fanciful classification; from that dictionary definition, the term could be seen to plainly describe someone knowledgeable of consumer information and financial advice, as the registrant’s blog advertised itself.²⁸⁸

The board’s willingness to accept an applicant’s justificatory arguments for a mark without binding the applicant to its contentions undermines the scrutiny of trademark applications and tarnishes the board’s approval process for marks. That mark holders can and do renege on their arguments asserting validity once they hold the rights is a cause of unpredictability and instability.²⁸⁹ For example, that a mark may share a common word with

²⁸⁵ *Oxford Word of the Year 2008: Hypermiling*, OXFORD UNIVERSITY PRESS BLOG (Nov. 10, 2008), <http://blog.oup.com/2008/11/hypermiling/> (“A person who leads a frugal lifestyle, but stays fashionable and healthy by swapping clothes, buying second-hand, growing own produce, etc.”).

²⁸⁶ FRUGALISTA, Registration No. 3532912.

²⁸⁷ Kimberly Palmer, “*Frugalista*” Debate: One Blogger Stakes Claim, U.S. NEWS, PERSONAL FINANCE (Sept. 18, 2009 11:24 AM), <http://money.usnews.com/money/blogs/alpha-consumer/2009/09/18/frugalista-debate-one-blogger-stakes-claim>.

²⁸⁸ This could be addressed by remedy of estoppel proposed *infra* Section V. A. Eligibility – Phantom Marks.

²⁸⁹ See Lee B. Burgunder, *Can the PTO Find Its Way with Jesus?*, 19 MARQ. INTELL. PROP. L. REV. 63 (2015). For proposed relief, see *infra* Section V. A. Eligibility – Phantom Marks.

many others, such as “cola” in both Pepsi-Cola²⁹⁰ and Coca-Cola,²⁹¹ is acceptable given that consumers will look to the unique mark aspects for identity instead of the common portion.²⁹² In this vein, the word “Jesus”²⁹³ was registered to a clothing company after an initial denial due to prior marks²⁹⁴ including the word.²⁹⁵ The PTO accepted the applicant’s argument that the mark would be a “satisfactory addition to the already robust field of Jesus marks already peacefully coexisting in the clothing field.”²⁹⁶

That the board was swayed by this image of peaceful coexistence in a competitive field did not tether JesusTM to maintaining that outlook. The mark was transferred to Jesus Jeans

²⁹⁰ PEPSI-COLA, Registration No. 0824151.

²⁹¹ COCA-COLA, Registration No. 1752201.

²⁹² T.M.E.P. §1207.01(d)(iii) (2007) (“Third-party registrations may be relevant to show that the mark or a portion of the mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services.”).

²⁹³ As with other historic and widely recognized names as marks, a likelihood of confusion as to any endorsement by the individual known as Jesus, or his right to publicity, is not a critique by the PTO. However, in light of modern dilution law’s enjoinment of “conjured mental association” sans actual confusion *supra* note 248, one could argue against this mark for dilution of “Jesus” by blurring. The question of allowing for rightful incentives arises, because there is, of course, no complainant party available to argue for the protection of this particular word. *Supra* Section IV. How Trademark Turned on Itself, 1. Anti-Competitive Incentives.

²⁹⁴ Taking “Jesus” alone without a more distinctive element is an abstraction that ends in circular reasoning. The PTO misappropriated statute by accepting this basic logic: the mark does not convey source, therefore it is not confusing, therefore it may be used to convey source. T.M.E.P. §1207(b)(iii) (2007) (“Additions to marks may be sufficient to avoid a likelihood of confusion if the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.”).

²⁹⁵ U.S. Trademark Application Serial No. 75866210 (filed Dec. 7, 1999).

²⁹⁶ Basic Trademark S.A., Supplemental Response to Office Action, Serial No. 75866210 (Aug.13, 2004).

S.R.L. by the time proof of the mark’s commercial use was required,²⁹⁷ even though in the intervening time, those two words, “Jesus Jeans,” had been granted as a trademark to a different company for the same products.²⁹⁸ In a brief opposing another trademark registration, “Jesus Surfed,” the “Jesus Jeans” owner claims²⁹⁹ to have successfully enjoined over sixteen other uses, including “Jesus” on clothing. Those would-be partial uses had the distinguishing elements that the objecting mark holder once relied upon in arguing for its own registration; but these claims nonetheless were all squashed.

This chaos stems from granting powerful marks without thorough evaluation of possible consequences.³⁰⁰ It is also not independent of the fact that Jesus’ desirability and flexibility as a mark is derived from cultural goodwill.³⁰¹ The consumers’ right to wear products emblazoned with the term is a protectable matter of their free speech (and also possibly of religion through expressive clothing).³⁰² Alternatively, if merchandising³⁰³ is a legitimate goal for brands, could consumers also not wish to bask in promotional products celebrating the value of cultural icons? Either of these concepts - if the primary function of the mark in the eyes of consumers - is illegitimate to the purpose of trademarks. Recently, the mark, “What Would Jesus Do?”³⁰⁴—

²⁹⁷ Lanham Act, 15 U.S.C. § 1058(a) (2006) (detailing a five-year window after registration).

²⁹⁸ JESUS JEANS, Registration No. 3379848 (following the same initial rejection and subsequent success based on the “vast field” of similar marks, as did the first).

²⁹⁹ Notice of Opposition, *Jesus Jeans S.R.L. v. Anton* at 2–3, (T.T.A.B. Feb. 20, 2013) available at <http://ttabvue.uspto.gov/ttabvue/v?pno=91209383&pty=OPP&eno=1>.

³⁰⁰ Remedy proposed *infra* Section V. B. Eye on the Ball.

³⁰¹ *Supra* Section II. B. Inherent Goodwill.

³⁰² *Supra* Section III. B. Of the Consumer.

³⁰³ *Supra* note 40.

³⁰⁴ WHAT WOULD JESUS DO?, Registration No. 3748123.

originally was owned for entertainment services by an aspiring Christian TV star; then it was successfully cancelled and overtaken by celebrity producer Tyler Perry. This is despite the phrase's historical past³⁰⁵ and contemporary primary association in the general public's mind with trendy bracelets of the 1990s, as well as the fact that this action is, most likely, not what Jesus would do.³⁰⁶ Sloganeering has blossomed in trademark law,³⁰⁷ yet secondary meaning is only utilized in the affirmative of creating trademarks, even if it may count as an overwhelmingly positive force for preserving a non-mark, expressive status.

2. Expansion of the Mark Definition and Form

Trademarks are no longer limited to symbolic words and images. Registrations have been attempted and granted for marks in forms evoking any one of the senses, from sound to smell to taste.³⁰⁸ The Supreme Court has said that “almost anything at all that is capable of carrying meaning” may be able to serve a trademark function, when it established that a single color, if consistently imbued with meaning, may be a protectable mark.³⁰⁹ The opinion referenced well-

³⁰⁵ Instances of this phrase can be found as early as, for example, CHARLES MONROE SHELDON, *IN HIS STEPS* (1896).

³⁰⁶ Phillip P. Mann, *Tyler Perry Snatches 'What Would Jesus Do' Mark*, IP LITIG. BLOG (Jul. 8, 2014), <http://www.iplitigationblog.com/2014/07/articles/blogroll/tyler-perry-snatches-what-would-jesus-do-mark> (discussing previous owner's allegations that she approached Tyler Perry's production company pitching this title for a reality show, which he rejected before subsequently submitting his own application for the mark).

³⁰⁷ See Burgunder, *supra* note 83.

³⁰⁸ See Jerome Gilson & Anne Gilson LaLonde, *Cinnamon Buns, Marching Ducks and Cherry-Scented Racecar Exhaust: Protecting Nontraditional Trademarks*, 95 TRADEMARK REP. 773 (2005).

³⁰⁹ *Supra* note 98. In *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995), the Supreme Court held that color alone could be registered as a trademark, provided it had acquired distinctiveness through secondary meaning.

established source-indicators, including the shape of a Coca-Cola bottle and the sound of the National Broadcasting Company's three chimes.³¹⁰ That chime certainly serves a strong objective in trademark, and is not perceived as a product feature, which many other non-traditional qualities have been ruled to be.³¹¹

However, the broadening realm of possible marks carries with it new, detail-oriented questions. For color marks, meaningful boundaries have been suggested. Standardization methods such as the shade-specifying Pantone color system³¹² have been offered in response to the possibility of a finite range of colors that could be quickly depleted. *De facto* color functionality has been respected, such as black³¹³ being a practically useful color for consumers to standardize or minimize machinery, such as a boat motor.³¹⁴ The evolution of color marks has been closely watched and well-reasoned.³¹⁵

³¹⁰ *Id.* at 162 (citing Registration No. 696,147 (Apr. 12, 1960) for the shape and Registration Nos. 523,616 (Apr. 4, 1950) and 916,522 (July 13, 1971) for the sounds). The Court also even referenced a trademarked scent of plumeria blossoms on sewing thread. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. at 162 (citing *In re Clarke*, 17U. S. P. Q. 2d 1238, 1240 (TTAB 1990)).

³¹¹ *In re N.V. Organon*, 79 U.S.P.Q.2d (BNA) 1639 (T.T.A.B. 2006).

³¹² See PANTONE, <http://www.pantone.com/pages/pantone/index.aspx>.

³¹³ Black was also granted aesthetic functionality for its appropriateness for Halloween and bereavement floral arrangements, *supra* note 140.

³¹⁴ *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527 (Fed. Cir. 1994).

³¹⁵ See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995) (discussed *supra* notes 309-310 and accompanying text); *Christian Louboutin v. Yves Saint Laurent America Holding, Inc.*, 696 F.3d 206 (2d Cir. 2012) (holding that Louboutin's lacquered red sole on footwear is indeed a protected mark, but it only has distinctiveness when it contrasts with the color of the shoe upper); Craig Summerfield, *Color as a Trademark and the Mere Color Rule: The Circuit Split for Color Alone*, 68 CHI.-KENT. L. REV. 973 (1992) (analyzing case law leading toward the *Qualitex* ruling).

Specificity in defining other non-traditional marks may pose a challenge.³¹⁶ Sound-marks are featured on the USPTO website in MP3 format with written descriptions.³¹⁷ Some descriptions include words and the identity of a perceived speaker,³¹⁸ others state technical details such as “B flat clarinet,”³¹⁹ and a few may simply say, for existence, “roaring lion.”³²⁰ If this level of distinction varies in description, the scope of protections for different marks would logically follow. Does MGM hold the rights to even a gentle lion “roar,” or the higher-pitched cry of a lion cub, or a child imitating a lion’s roar?

Currently, there are no standard formats for submission of taste, smell, or other non-traditional marks. The validity of any written description as it is translated among widely varying consumer sensory capabilities is hard to access, and thus to harness as a trademark registration and enforcement tool.³²¹ Nonetheless, for the sake of registrants, descriptive standardization is a necessity, lest we expect them to seek out and independently compare their own perception of each existing mark to their own registration.³²²

³¹⁶ Amanda E. Compton, *Acquiring a Flavor For Trademarks: There's No Common Taste in the World*, 8 NW. J. TECH. & INTELL. PROP. 340 (2010), <http://scholarly.law.northwestern.edu/njtip/vol8/iss3/1>.

³¹⁷ See, e.g., *Trademark "Sound Mark" Examples*, UNITED STATES TRADEMARK AND PATENT OFFICE, <http://www.uspto.gov/trademark/soundmarks/trademark-sound-mark-examples>.

³¹⁸ *Id.* at 76280750 Twentieth Century Fox—entertainment—“D’OH” (Homer Simpson character), playable at <http://www.uspto.gov/trademarks/soundmarks/76163189.mp3> for Registration No. 3411881.

³¹⁹ *Id.* at 76575743 Infone—Concierge arrangements—B flat clarinet playable at <http://www.uspto.gov/trademarks/soundmarks/76575743.mp3> for Registration No. 3014502.

³²⁰ *Id.* at 73553567 MGM – Entertainment – Roaring Lion playable at <http://www.uspto.gov/trademarks/soundmarks/73553567.mp3> for Registration No. 1395550.

³²¹ Compton, *supra* note 316, at 354.

³²² *Id.* at 357.

The issue of faithfully capturing consumer perception³²³ will only face more trials in determining functionality for new pairs of sensory marks and diverse product types.³²⁴ For instance, while courts have deemed a medicine's taste to be a protected functional aspect,³²⁵ the TTAB granted a mark for scented sewing thread.³²⁶ Here is a thought experiment to illustrate the important crossover point between the two: initially, the primary function of candles was to provide light. Whoever first added scent to the wax created a unique, recognizable product,³²⁷ and scented candles might have initially been synonymous with that one innovative candle maker as a source.³²⁸

If the first scented candle company would have desired to receive protection for its introduction of scent to the candle, what would it have had for options? If a robust mental link to the source is formed by this addition of scent, should that innovation be preserved by a scent trademark? Of course, this could have introduced profound implications to the candle industry. Perhaps that first scent mark would have influenced each candle maker to produce only a certain scented candle, with each scent trademarked to its producer to differentiate itself from others. However, this would have made the trademarked scent of the candle serve a purpose, by

³²³ *Supra*, Section III. Primary Purpose.

³²⁴ See Jay M. Burgett, *Hmm, What's That Smell? Scent Trademarks—A United States Perspective*, 64 INTA BULL. 5 (2009).

³²⁵ *Supra* note 311. Not all medicines have this function; even otherwise identical products will vary in taste or lack thereof.

³²⁶ *In re Celia, d/b/a Clarke's Osewez*, 17 U.S.P.Q.2d (BNA) 1238 (TTAB 1990).

³²⁷ *Id.* The board considered that the applicants had added scent as a feature, that it was not naturally occurring, to be in their favor.

³²⁸ *Id.* The board also found in the applicant's favor his being the sole marketer of this product feature. Additionally, there was proof of the consumers' understanding of the scent as source.

inducing consumers to purchase a particular candle from a particular company because of its scent. So it seems, at least in this line of reasoning, the court might not hinder competition with a scent trademark, as determining or predicting consumers would place more value on the scent for its own sake, rather than as a mark of distinctiveness (as an indication of source).

The benchmark of distinctiveness varies with each new attribute–product pairing as well. Where soda flavor was held to intensely detailed genres of generic demand,³²⁹ the specific “floral scent” of sewing thread was found to be acceptably arbitrary.³³⁰ Some circumstantial considerations have been developed. The World Intellectual Property Organization addresses some of these for olfactory marks specifically:

Scents which are the natural odor of a product or are otherwise common for the type of goods applied for are likely to be needed by other traders and are difficult to register, e.g., the scent of “vanilla”—a normal ingredient in many food products, would not be registrable for “confectionery.” Scents normally applied as masking agents in products are also lacking in distinctiveness e.g., the scent of “pine” in relation to disinfectants and the scent of “lemon” in relation to “dishwashing liquid.” However, the application of a scent to a product not normally scented would have considerably more potential to be registrable.³³¹

³²⁹ See Leib, *supra* note 143.

³³⁰ 17 U.S.P.Q.2d (BNA) at 1239.

³³¹ World Intellectual Property Organization, *Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications* (March 30, 2007), available at http://www.wipo.int/edocs/mdocs/sct/en/sct_17/sct_17_3.pdf (the United States is one among 73 member states).

Determining what is “normal” is left to the judgment of the PTO and TTAB. At some point in time, scented candles became normal.³³² Vanilla, pine, and lemon scented candles all individually became normal as well, even though they were not “masking” another unpleasant scent, or common ingredients, initially. While this standard respects scents used commonly as masking agents, it does not go as far as acknowledging potentially inherent benefits other scents may carry across different products. Vanilla’s commonality among food products does not directly explain its role perfuming pencils, erasers, phone cases, teddy bears, trash bags, valve oil, drawer-liners, or pacifiers.³³³ It is not an established norm within these industries to add a masking scent, and those objects are not typically valued for their odor. However, the possibility that such disparate manufacturers all choose vanilla has not been considered as an indication of

³³² *Facts & Figures*, NATIONAL CANDLE ASSOCIATION, <http://candles.org/facts-figures-2/> (estimating the American candle industry at \$2 billion yearly, before accessories) (“Fragrance is by far the most important characteristic impacting candle purchases today, with three-fourths of candle buyers saying it is ‘extremely important’ or ‘very important’ in their selection of a candle.”).

³³³ See <http://www.amazon.com/Original-Smencils-Gourmet-Scented-Pencils/dp/B0073RLMX2>;
<http://www.barnesandnoble.com/w/home-gift-macarons-vanilla-scented-erasers-set-of-6/28862205>;
<http://www.amazon.co.uk/Jelly-Belly-Scented-Case-iPhone-Vanilla/dp/B005Y7QR7O>;
http://scentdeals.com/index.php?main_page=product_info&products_id=1871;
http://www.amazon.com/Glad-OdorShield-Kitchen-Drawstring-Vanilla/dp/B005GSYXL8/ref=sr_1_3?s=home-garden&ie=UTF8&qid=1448841047&sr=1-3&keywords=vanilla+scented+trash+bags;
<http://www.zajamusic.com/oil.htm>;
<http://www.amazon.com/Scented-Embossed-The-Lavender-Home/dp/B017GB3G6U>;
<http://www.toysrus.com/buy/cups/philips-avent-bpa-free-soothie-pacifier-vanilla-scented-green-0-3-months-2-pk-scf190-07-17371186>.

some inherently desirable nature it has,³³⁴ which should be protected from the limitations of trademarking.

Non-traditional marks have also developed for buildings.³³⁵ Some building designs have been considered distinctive enough to be granted protection against structural mimicry,³³⁶ and courts have gone both ways on protecting buildings' depiction through other media.³³⁷ It is most theoretically troubling when depictions of buildings from the public perspective, such as a view from a street corner, are threatened. These turn common sights into private property. A shop in New York City called "Fishes Eddy" has been on the receiving end of two such mark defenses. In 1998, the shop was ordered to cease and desist selling a china pattern that featured a silhouette of the city skyline, due to the newly established trademark³³⁸ of the Chrysler Building spire.³³⁹ The New York Times reported on the shop owner's refusal: "How can they say we can't use the Chrysler Building?" she asked. "We wanted to do a plate that represented New York City.

³³⁴ See *supra* Section II.B. Inherent Goodwill; Hughes, *supra* note 14.

³³⁵ See, e.g., Keri Christ, *Edifice Complex: Protecting Landmark Buildings as Intellectual Property- A Critique of Available Protections and a Proposal*, 92 TRADEMARK REP. 1041 (2002).

³³⁶ *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 541 (5th Cir. 1998) (enjoining golf course company from re-creating an iconic hole of the Sea Pines golf course as a part of its re-creation of iconic locations. The relevant consumers in this case would be interested in patronizing a collection of famous courses and therefore also potentially discriminating enough to appreciate the symbolism. Presumably these golfers would also then be aware they were, in fact, not at the mark "source," and would not be confused).

³³⁷ *Rock and Roll Hall of Fame v. Gentile Prods.*, 134 F.3d. 749, 755 (6th Cir. 1998) (overturning district ruling for the Hall of Fame as an "accessible, public, well-known landmark").

³³⁸ Registration No. 1126888.

³³⁹ David W. Dunlap, *What's Next? A Fee for Looking?*, N.Y. TIMES, DESIGN NOTEBOOK (Aug. 27, 1998), <http://www.nytimes.com/1998/08/27/garden/design-notebook-what-next-a-fee-for-looking.html>.

Leaving off the Chrysler Building would be like leaving off the World Trade Center.”³⁴⁰ Sixteen years later, in a new cease-and-desist letter, the New York Port Authority demanded Fishs Eddy do just that, claiming the same china pattern would wrongfully “evoke thoughts of the Port Authority, the twin towers, W.T.C. and the September 11th terrorist attacks.”³⁴¹ This claim was despite the china pattern predating September 11th attacks, or construction of the W.T.C. It also illustrates the issue of granting mark holders such broad rights that they would assert ownership over the ability to evoke thought on a national tragedy.³⁴² No motions have been filed, though they could prove interesting in addressing a public domain for stylization of famous marks.

Freedom to depict artistically the real world was recently confronted in *University of Alabama Board of Trustees v. New Life Art, Inc.*³⁴³ The U.S. Court of Appeals for the 11th Circuit found that inclusion of the trademarked Alabama uniforms was artistically relevant to portraying famous school football moments,³⁴⁴ and that artist Daniel Moore’s first amendment right to capture that moment overrode the need to even consider possible consumer confusion (so

³⁴⁰ *Id.*

³⁴¹ David W. Dunlap, *Port Agency Tells Store to Drop 9/11 Items*, N.Y. TIMES (Jul. 28, 2014), http://www.nytimes.com/2014/07/29/nyregion/port-authority-of-new-york-and-new-jersey-tells-store-to-drop-9-11-items-.html?_r=1 (The irony of the original quote foreshadowing a complaint from the World Trade Center was likely not lost here, as same journalist wrote both pieces sixteen years apart).

³⁴² As does the “Let’s Roll,” examined *supra* note 91. If it seems peculiar the frequency with which serious events become the subject of these disputes, it is helpful to keep in mind the problematic incentives that have propelled “trademark bullying” as a means to assert mark rights (*see supra* Section IV. A. Anti-Competitive Incentives) Mark rights claimed on issues of sensitive nature could logically less likely to be “let go” by the other users.

³⁴³ *Univ. of Ala. Bd. of Tr. v. New Life Art, Inc.*, 683 F.3d 1266, 1276 (11th Cir. 2012).

³⁴⁴ *Id.* at 24-25.

long as it was not explicitly misleading).³⁴⁵ Media harshly criticized the University of Alabama for the vigor with which it pursued art and even seemingly minor “infringements” such as hand-decorated cookies.³⁴⁶ Moore’s high-quality paintings were protected, even when sold commercially, as expressive art in a traditional format. There are many similarly motivated, but less classically artistic, mark uses that will find achieving protection to be more challenging.

The uniforms are only marks because they have acquired distinction and meaning via the university and fans’ support of a high-profile football team. Expansion has affected not only the type of marks available, but also conceptions of the owners of them. Cultural investment³⁴⁷ in a mark is hard to define, no matter the scale (e.g., communal, geographical, jurisdictional) used, but universities are a helpful microcosm where much of the community is clearly delineated and where employees, enrollees, and alumni are all claimed as essential members of a school.³⁴⁸

While fans may be happy to see third parties pay for the use of marks, institutions that turn on

³⁴⁵ *Id.* at 25.

³⁴⁶ Jon Solomon, *University of Alabama Aggressively Defends Trademarks. How Far is Too Far?*, AL (Nov. 17, 2013 7:00 AM), http://www.al.com/sports/index.ssf/2013/11/university_of_alabama_aggressi.html; The University of Alabama also owns the standard character word mark, “Alabama,” even though it is a state name (*see supra* note 41 regarding state insignia) it is not protected for any inherent goodwill (*supra* Section II. B. Inherent Goodwill) or communicative or informational value, (*supra* Section III. A. Of the Mark), and is apparently distinctive in and of itself. In fact, its athletic director, Bill Battle, leads a substantial portion of the entire collegiate sports protectionist wave as founder of the Collegiate Licensing Company mentioned *supra* note 135).

³⁴⁷ *See* Section II. B. Inherent Goodwill.

³⁴⁸ Perhaps the undeniable community of stakeholders invested in a university explains the proliferation of cases and scholarship focusing on institutions of higher learning in regards to trademarks overstepping their bounds. *See supra* notes 103, 114, 132, 177, 222 & 346, and accompanying text.

their own alumni, and even current students, may find them asking, “whose identity is it, anyway?”

Theory grants mark ownership to the controller of the quality a mark conveys.³⁴⁹ If the primary quality implied by a school’s trademark, to relevant buyers, were student comradery, students would be in control of that quality. Very little has been said about pinpointing a conveyed quality, but, if marks were recognized for inherent meanings, the results may help align law with public conception. It is especially curious when school marks extend past name and official mascots to the likes of student-originated chants and nicknames. Courts have ruled against third-party shirt makers emblazoning their sporty chemises with “Rock, Chalk, Jayhawk,” thus establishing the catchphrase as property of the University of Kansas.³⁵⁰ Then, a parody, “Barack, Chalk, Jayhawk” was printed on shirts by a student group. Initially the school granted permission, but later revoked it (despite the blend with more protected political speech as well as non-commercial, free distribution of the shirts).³⁵¹ Student groups at the University of Texas in Austin were upset by similarly selective permission to use school symbols, which they regarded as an “identity and an identifier for everyone who goes to school here, on or off the field[.] One person shouldn’t be able to be a Longhorn more than another.”³⁵²

³⁴⁹ *Supra* note 174.

³⁵⁰ *Univ. of Kan. v. Sinks*, 644 F. Supp. 2d 1287, 1296 (D. Kan. 2008).

³⁵¹ *Obama T-shirt Concerns KU*, TOPEKA CAPITAL-JOURNAL, July 22, 2008, at 1.

³⁵² Lauren Reinlie, *Longhorn Logo Policy under Review*, DAILY TEXAN (UNIV. TEX.-AUSTIN) via U-Wire, Sept. 26, 2002, <http://www.dailytexanonline.com/2.8480/longhorn-logo-policyunder-review-1.1261255>.

2. Expansion of the Infringement Definition

The globalization of markets has effects beyond distancing product source. Market definitions' initial bounds respected the regional nature of business. However, 21st Century competition must be re-evaluated, as gradually more brands are able to make the whole world their market.

Whereas marks previously coexisted, a completely valid mark may be bowled over through no fault of its own, but by the gravitational pull of a larger brand expanding.³⁵³ Who should take precedence? Should it be the first user, the first filer, or whichever party is the more effective user of a mark? With the introduction of dilution law, is fame now the legally dominant factor?³⁵⁴ Continuing forward in this new environment, when a lack of “assiduousness” has been held against mark holders in court, it seems the expectations of aggressive defense expand along with the concomitant possibilities of direct competition. This puts small mark holders in a precarious situation. Not only do they have little defense from being “swamped” by a more dominant mark, but they also may be obliged to police marks stringently in ways they would not have expected, out of their region, and out of pocket. That is a large burden disadvantaging smaller mark holders.

Hitching the trademark wagon to consumer perception has pulled it into the intersection of a new societal force, escalating mass media and information technology.³⁵⁵ The amount of

³⁵³ *E.g.*, “Dream Team” owned by IHSA. *Supra* note 268.

³⁵⁴ *Wallpaper Mfrs. Ltd. v. Crown Wallcovering Corp.*, 680 F.2d 755, 762 (C.C.P.A. 1982) (precedent to the contrary) (“Trademark rights are neither acquired nor lost on the basis of comparative popularity . . .”).

³⁵⁵ *See, e.g.*, Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 973 (1993) (“Trademarks are often selected for their effervescent qualities, and then injected into the stream of communication with the pressure of a firehose by means of mass media campaigns. Where trademarks come to carry so much communicative freight, allowing the trademark holder to restrict their use implicates our collective

commercial content an average U.S. consumer is exposed to daily is staggering. Large brands can use this access as a means for rewriting consumer impressions, consequently taking control of marks. Certainly, instances of reverse-confusion³⁵⁶ should be more common and perhaps easier to prove; however, if more senior, but smaller mark holders are able to make that case, courts may not intervene on the older mark's behalf, given current precedent.

V. THE COMEBACK

Rapid expansion of trademarks, and the public's understanding of them, reflects the modern world where brands hold very real power. Many certainly carry a wealth of cultural information, which will not be erased any time soon—nor should that be the goal of reform. The power of a Starbucks trademark to sell merchandised mugs, for example, is a valorization unintended by the foundations of trademark law, but now part of a legal and business evolution: a transformation of what reputational advantage can encompass. Many significant diversions from trademark intent are harmless, even economically beneficial, and could not have arisen without a liberal approach to trademarks.

However, as the potential contained in marks has magnified, minimal attention has been paid to the costs of encouraging these possibilities. Most expansions emerged via reasonable circumstances, but left the door open to often flawed and counter-productive applications. There is good news, though: while the fundamentals underlying trademark law cannot fully explain the current universe of marks, they do retain the power to rein in such contradictions.

interest in free and open communication.”); *see also* Margreth Barrett, *Domain Names, Trademarks and the First Amendment: Searching for Meaningful Boundaries*, 39 CONN. L. REV. 973, 979–81 (2007).

³⁵⁶ *Supra* notes 258-259 and accompanying text.

A. Eligibility – Phantom Marks, Evidence and Estoppel

The constant tug of trademark law toward less restriction has empowered what were previously known as “phantom marks.”³⁵⁷ Such marks are defined loosely and broadly enough to assert control over more rights or property interests than any mark holder could justifiably claim. So these *spectral* intellectual properties are, in a sense, very real. Their effects are magnified when “naked licensing”³⁵⁸ of the amorphous mark takes place. Combining the two creates a mark that means almost nothing—and can expand to stake claim over almost anything.

To illustrate, we reexamine the blue Boise State turf.³⁵⁹ Aside from the numerous functional advantages, the school effectively mandates naked licensing by compelling “users” to disclaim their lack of association to Boise State.³⁶⁰ The university admits there is no form of quality control, stating, “We just say, ‘[d]on’t imply that you’re related to Boise State, but good luck with your football program.’”³⁶¹ These licensing agreements are, in fact, intentionally bereft of trademark meaning.

Beyond severing the link of association, Boise has overreached its mark’s registration in these licenses. The mark registration includes an objective of “entertainment services, namely,

³⁵⁷ *In re Int’l Flavors & Fragrances Inc.*, 183 F.3d 1361 (Fed. Cir. 1999) (rejecting mark for having too many permutations to fulfill purpose of registration creating constructive notice third parties may comprehensively search through).

³⁵⁸ *See supra*, Section II. A. Changing Nature.

³⁵⁹ Gallagher, *supra* note 101.

³⁶⁰ Chadd Cripe, *Here's How Boise State Protects its Trademark on the Blue Turf*, IDAHO STATESMAN: BRONCO BEAT (Sept. 23, 2011, 9:35 AM, updated on Sept. 24, 2011, 5:20 PM), <http://archive.today/Z4yma>. (“We have agreements that they won’t liken themselves to Boise State so there’s no confusion.”).

³⁶¹ *Id.*

the presentation of intercollegiate sporting events and sports exhibitions rendered in a stadium, and through the media of radio and television broadcasts and the global communications network,” and includes a description of “the color blue used on the artificial turf in the stadium.”³⁶² However, Boise State has licensed turfs in red, and it claims to the public and the press the rights to any non-green turf.³⁶³ No intercollegiate sporting events are played at several of the high school and even elementary school fields that have been granted a license by Boise.³⁶⁴ It is hard to imagine these schools could pose much of a threat to Boise State’s telecasting prospects in global communications networks, either.³⁶⁵

Boise State’s apparent liberty from each tenet of its mark’s registration is troubling. The PTO limits applicants to one individual mark per registration, and though there are justifiable expansions as marks evolve, this one seizes an irrational scope of control. Poorly enforced limitations negate constructive notice, foster uncertainty and legal conflict, and oppose the public interest in free expression. Phantom marks are one of several issues that may be curtailed by the incorporation of estoppel into trademark law. If the mark described is a blue field, the owner has no proprietary right to every other color in the rainbow. One would hope that the PTO’s scrutiny would rise to the level of rejecting an application that read “any turf of any color, anywhere.” Judicial interpretation of marks may remedy these overreaches, but a great deal of mark activity only reaches the judiciary at the will of the mark’s owners. Outside circumstances, such as

³⁶² Registration No. 3707623.

³⁶³ Gallagher, *supra* note 101.

³⁶⁴ Cripe, *supra* note 360.

³⁶⁵ *Id.*

market positions, financial and political power, and sheer luck, may have more to do with a mark's legal boundaries than litigated or regulatory determinations.

Mark holders should retain the ability to petition for expansion of their mark's definition, but should also shoulder the burden of affirmatively justifying those expansions before acting upon them, perhaps with some minimal standards analogous to probable cause,³⁶⁶ including the claimant's meeting an initial threshold of documentation and attestation. When one or both of these characteristics are present – (1) a mark's scope now allegedly extends to an area beyond its original, core coverage, and (2) the mark is a junior mark - then that mark holder should be expected to introduce evidence, both registration and usage as well as, when relevant, consumer surveys, expert or eyewitness testimony of likely or actual consumer confusion, and documentary support showing or refuting specific infringement claims.³⁶⁷ This would discourage “strike suits” used as a tool to carve out greater mark territory, leveraging the power of a registered mark. Many will listen to even the emptiest of threats from a multinational corporation, and those who wisely ignore them do not set legal precedent. When they do, predatorily protracted litigation costs also favor the party of greater means, especially when balanced with the possibly fleeting value to junior users.³⁶⁸

As noted previously, even a basic, unlegislated or unregulated answer to wrongful intellectual property assertions may rest successfully in the weeds of several hundred years of

³⁶⁶ BLACK'S LAW DICTIONARY 1395 (10th ed. 2014) (noting how the standard has been applied at the outset of tort cases).

³⁶⁷ *Garden of Life, Inc. v. Letzer*, 318 F. Supp. 2d 946, 966 (C.D.Ca. 2004) (both e-mail and website link evidence indicating both that the defendant sought to induce consumer confusion and that there was, indeed, actual consumer confusion).

³⁶⁸ Discussion of the fleeting, rare, and unpredictable time window of value, and free rider conundrum of petitioning for genericism. Kantorczyk, *supra* note 157.

Anglo-American law: Estoppel. Assertion of unapproved rights will garner less acquiescence out of intimidation if uncertainty is reduced where the opportunity arises. Estoppel clarifies boundaries and aids in slowing the creeping expansion of marks rights, and the consequences thereof. Expectations of trademark necessity staked out by this protectionism are too late to roll back, but this halts continual amassing of advantage. Applicability of estoppel is not limited to the text of registrations and would have great normative impact throughout the body of law.

B. Eye on the Ball

A general lack of consideration is granted to the nature of marks themselves, allowing registration and fame to supplant logical robustness and commitment to consumer protection. Attempts at protecting broad iterations of marks may actually be attempts to claim ownership of the mark's underlying nature, with tenuous ties to trademark law's purpose. On point is the National Pork Board's (NPB's) right to the term, "the other white meat,"³⁶⁹ a phrase that invokes a comparison to chicken or fish.³⁷⁰ The NPB objected to similar analogies by several others. Back in 1997, the NPB settled out of court after bringing a suit against the Maine Lobster Promotional Council for using the slogan, "The Ultimate White Meat."³⁷¹ Cease-and-desist

³⁶⁹ THE OTHER WHITE MEAT, Registration No. 1486548.

³⁷⁰ While the National Pork Board did not clarify which meat pork was being compared to, the United States Department of Agriculture can offer guidance. USDA classifies red and white meats based upon concentrations of myoglobin; ironically they view pork as a red meat. *See Fresh Pork from Farm to Table*, UNITED STATES DEPARTMENT OF AGRICULTURE, http://www.fsis.usda.gov/wps/portal/fsis/topics/food-safety-education/get-answers/food-safety-fact-sheets/meat-preparation/fresh-pork-from-farm-to-table/CT_Index ("Pork is classified a 'red' meat because it contains more myoglobin than chicken or fish.").

³⁷¹ *Briefing: Another 'White' Meat, Pork Industry Settle*, PHILLY.COM (Dec. 18, 1997), http://articles.philly.com/1997-12-18/business/25555073_1_consumer-prices-cyber-patrol-business-

letters were sent to other users, one of which was a faux-advertisement on April Fool’s Day for canned unicorn meat dubbed “the new white meat,”³⁷² and the other, a humorous bumper sticker reading “Muskrat: the new off-white meat.”³⁷³

The NPB’s mark was initially suggestive, with the addition of “other” distinguishing it from “white meat,” which is likely merely descriptive.³⁷⁴ Secondary meaning was established and is now inherently distinctive.³⁷⁵ With this new distinctive mark came an attempt to assert control over the phrase from which it originated. The implications of “other” are neither equivalent to “ultimate,” nor “new.” There is no reason to believe the distinctive mark’s meaning

software-alliance (“It’s always been our position that the pork producers couldn’t hog the term ‘white meat,’” said Susan Barber, adding her group was “as happy as pigs in mud”).

³⁷² Nick Bilton, *Unicorns. They’re Not the Other White Meat.*, N.Y. TIMES (Jun. 22nd, 2010 11:04 AM), http://bits.blogs.nytimes.com/2010/06/22/unicorns-theyre-not-the-other-white-meat/?_r=0.

³⁷³ *The National Pork Board Beats Up on Muskrats*, IRREGULAR TIMES, <http://www.irregulartimes.com/otherwhitemeat.html>

³⁷⁴ As a term of classification used by government regulators *supra* note 370, as well as the *prima facie* implications of plainly indicating a naturally occurring color of goods, the term would likely meet the definition of merely descriptive. T.M.E.P. §1207.01(d)(iii) (2007) (“[I]t is enough if the term describes one significant function, attribute, or property.”).

³⁷⁵ Of course, the phrase “white meat” alone would likely be merely descriptive.

destroys or alters “white meat[’s]” merely descriptive nature or negates the right of others to access it.³⁷⁶ That is the effective result of efforts when considered in aggregate.

The Maine Lobster Promotional Council raised arguments of descriptiveness and a lack of consumer confusion, and felt the subsequent settlement was a victory.³⁷⁷ Dilution, not legally vulnerable to those same defenses, was the argument accepted by the TTAB in prohibiting the salmon industry from using the slogan, “the other red meat,” on grounds of blurring the NPB mark in 2010.³⁷⁸

Famousness controversially elevates a mark above concerns of consumer confusion, an element that was likely missing. The National Pork Council provided convincing evidence of fame through extensive commercialization of its mark and recognition in the public mind.³⁷⁹ Responses to a survey asking “Thinking about the slogan you just heard [THE OTHER RED

³⁷⁶ See Lisa P. Ramsey, *Descriptive Trademarks and the First Amendment*, 70 TENN. L. REV. 1095, 1101 (2003) (criticizing the protection of descriptive marks as an unjustified restriction on commercial speech, given the context of proven secondary meaning applied by the PTO—though this partial-mark example is “white meat” being effectively, though not legally, restrained).

³⁷⁷ Carole Sugarman, *Pork vs. Lobster: A Fight Over White*, WASH. POST (Jul. 16, 1997), <https://www.washingtonpost.com/archive/lifestyle/food/1997/07/16/pork-vs-lobster-a-fight-over-white/7b026241-5bb3-4a71-acfa-504f1c8e2a35/> (“[The] dictionary definition of ‘white meat’ includes any light-colored meat, such as pork, veal and the breast of poultry. ‘That means white meat is a generic term for pork,’ he said. ‘That means that the pork producers can’t get an exclusive right to it.’ What’s more, the lobster council’s ads were clear about who was promoting what, Keller said. ‘There wasn’t anybody reading this stuff who would confuse a lobster with a pig.’”).

³⁷⁸ Nat’l. Pork Bd. v. Supreme Lobster & Seafood Co., 96 U.S.P.Q.2d (BNA) 1479 (T.T.A.B. 2010). For clarity, this case was about salmon, as marketed by the Supreme Lobster & Seafood Co., while the former case, discussed *supra* note 377, concerned lobster marketed by the unrelated Maine Lobster Promotion Council. *Id.* (“It’s an interesting question of trademark and First Amendment law. And we love lobsters.”).

³⁷⁹ *Id.* at 1490.

MEAT], do any other advertising slogans or phrases come to mind?”³⁸⁰ supported a claim of dilution.³⁸¹ In response, the salmon applicant’s charge that this query improperly suggested another slogan *should* come to mind, the court deemed it necessary for the “precise question” the survey intended to answer.³⁸²

The possibility that the closest advertising slogan associated with “the other red meat” could be insignificant to the overall effect of the mark was not considered. Accepting the premise that famous associations either do or should dominate all other potential meanings prioritizes those famous marks automatically. Establishing a mark’s primary purpose in the consumer mind³⁸³ is necessary to both consumer-protection and information-transmission justifications of trademark. These justifications are abandoned when investigation of the conception is left incomplete, if not distorted by a purely commercial point of view.³⁸⁴

Where a court deems the marks to be highly similar, its own reading of facts could be interpreted to the alternate conclusion if consumer interpretation was prioritized. Colors of meat being of “precious few from which to choose” buttresses the mutually exclusive reality; one product cannot be “the other white meat” and “the other red meat” at the same time. That both parties intended to express healthy attributes follows, although each color implies distinctly different nutritional properties. So, a mark not only conveys its own positive attributes, but may bring to mind that from which it is distinguishing itself. The “mental processing” of using an

³⁸⁰ *Id.*

³⁸¹ *Id.* at 1497-98 (interpreting the fact that 35% of respondents thought of the other slogan indicates a high degree of likely association).

³⁸² *Id.* at 1490-91.

³⁸³ *See* Section III. A. Of the Mark.

³⁸⁴ *See* Brown, *supra* note 6.

analogy within the each category is not necessarily a common message of marks, but it is a valuable tool of language and communication.³⁸⁵

Attempts to seize an underlying descriptor in, or to deal with blindness to, the mark's own nature illustrate some pitfalls of the cognitive dissonance between modern practice and theoretical underpinnings. The solution is to compel more faithful representation on both sides. First, no reason is given why a mark's behavior cannot be considered in aggregate by the TTAB. An overbroad mark can push forward unnoticed, which is not in the best interest of an interconnected system such as trademark. The most accurate conception of a mark's nature comes from a complete picture of its actions. Second, dilution, as it violates the fundamental, public interest in facilitating consumer perception, can be countered by opposition: mark holders trying to contradict a diluter's interests. The drawing of distinctions, the use of communicative tools, and the right to a merely descriptive term are all being harmed through the ungrounded "logic" of dilution. Finally, while it is challenging to keep in mind the differences between two separate arenas of competing business interests, consumer perception is not equivalent to consumer *commercial* perceptions.

C. Out of Bounds

In *Jesus Jeans*, had the PTO incorporated estoppel in its argument for there being a mark, subsequent marks mentioning Jesus would, too, have been allowed entry into the "robust field of Jesus marks already peacefully coexisting."³⁸⁶ However, a more realistic consideration of several such marks might find purposes to be non-trademark expression. Communication is a valid function of many goods, acknowledged in defending those communication of value created by

³⁸⁵ See *supra* note 114.

³⁸⁶ *Supra* note 296.

mark holders.³⁸⁷ Owners may construct a highly protected, famous trademark by imbuing meaning persistently. It is hard to understand how these valid acknowledgements are reconciled with the almost complete doctrinal annexation of the public domain.

Though a public domain is unacknowledged by the foundations of trademark law, so are scent marks and many other developments. The public domain, though, besides a cherished “remainderman” of intellectual property rights expressly provided in the patent and copyright laws,³⁸⁸ epitomizes the idea of the general commons, a vigorously protected public space, and the expressive rights of all people, whether to create, to transmit, or to receive. Defending this terrain provides a benefit for society generally. Presuming that the TTAB reestablishes its responsibility to steward generification,³⁸⁹ objectively egregious marks such as “three-peat”³⁹⁰ will no longer “refuse to lose.”³⁹¹ Further balance will be achieved whenever comprehensive consumer perspective is applied. This is possible in many avenues, including higher standards expected of consumer surveys, tighter pleading and proof for a prima facie case of dilution, and more scrutiny of a trademark’s early dates, original meanings, and geographical scope during the initial mark registration process.

As established, there is no shortage of words with deeply embedded meaning,³⁹² occasionally with inherent and cultural goodwill and inferences more significant than their

³⁸⁷ See *Au-Tomotive*, *supra* note 121.

³⁸⁸ *Supra* note 9 and accompanying text.

³⁸⁹ *Supra* note 164.

³⁹⁰ *Kantorczyk*, *supra* note 157.

³⁹¹ *Supra* note 201.

³⁹² See, e.g., Sections II. B. Inherent Goodwill, II. C. Idioms and Atmospherics.

standard dictionary definition.³⁹³ This is not to say that all marks must be culturally bland. Consumer segmentation is no mystery to brands heavily involved in trademark law.³⁹⁴ *Texas Tech Univ. v. Spiegelberg* found robust meaning in a college town as cause for more stringent trademark protection locally.³⁹⁵ The opposite reaction is to allow those vested in a community to freely enjoy and nourish their connection to a mark. Evaluated in regard to preserving competition, a place such as Lubbock, Texas, the home of Texas Tech University, is virtually the only place where the primary purpose of many purchases are to express identity as a Red Raider and where the request for red and black apparel is a ubiquitous demand. Similarly, “who dat” is free to become commercially associated with the Saints in the majority of the country; there is little harm in respecting the authors of its antecedent appeal. Depictions of city skylines³⁹⁶ and football plays³⁹⁷ carry their own intrinsic appeal.

If proving acquired distinctiveness can be mandated for descriptive marks, perhaps trademark law should apply a similar burden to potential marks especially prone to other non-mark interpretations.³⁹⁸ The PTO, through its standards in the Trademark Manual of Examining

³⁹³ See, e.g., *supra* notes 49-51 (discussing “who dat” in historical and colloquial cultural depths as opposed to any formal dictionary entries).

³⁹⁴ See Desai, *supra* note 112.

³⁹⁵ 461 F. Supp. 2d 510, 527 n.2 (N.D. Tex. 2006) (“This is so because trademark rights are territorial in nature [quoting 4 McCarthy, *supra* note 259, at § 26.27]. Therefore, the relevant territory which the court must consider in determining distinctiveness of the scarlet and black color scheme is not national, but local to Texas Tech. In this university town, a display of the scarlet and black color scheme on a game day (or any other day) is almost certainly a show of support for Texas Tech.”).

³⁹⁶ Dunlap, *supra* note 339.

³⁹⁷ *Supra* note 343.

³⁹⁸ The T.M.E.P., *supra* note 24, offers guidelines for a common perception of different mark depictions. *Supra* notes 279-281.

Procedure,³⁹⁹ draws upon common consumer interpretations; essentially, these interpretations are cognitive functions,⁴⁰⁰ organizing marks at large. As the public has been conditioned to infer the presence and meaning of a trademark from a small logo on the pocket area of a shirt,⁴⁰¹ or the absence of any trademark or meaning thereof from the color of a vase of flowers,⁴⁰² many other psychological reactions should be preserved for their functionality.

Commitment to consumer perceptions would follow Vanessa Pierce's suggestion to integrate consideration of functionality, that is, realism, when determining genus and, therefore, genericity.⁴⁰³ Likewise, the need for specific consumers, as well as a precise articulation of quality control detailed in McGuffey's *Boybands*,⁴⁰⁴ would serve the doctrine well by realigning theory in conformity with practical considerations. Heightened scrutiny in granting marks is preferable to the functional advantages simply given to marks such as the Boise State field.

D. Making the Calls

As trademarks have bloomed and markets have fragmented, the abundance of “reasonable” product categories has complicated the task of analyzing mark applications. Further complications arise when attempting to determine what is “in the mind of” more specialized consumers.⁴⁰⁵ Especially as potential marks expand to non-traditional forms, and as mark holder influence looms larger than ever, the standards of registration cannot relax. To reboot the

³⁹⁹ The T.M.E.P., *supra* note 24.

⁴⁰⁰ *See* Hughes, *supra* note 14.

⁴⁰¹ *Supra* note 281 (T.M.E.P. acknowledging connotation of mark placement to consumer).

⁴⁰² *Supra* note 140.

⁴⁰³ *See* Pierce, *supra* note 25.

⁴⁰⁴ *See, e.g.*, McGuffey, *supra* note 151.

⁴⁰⁵ *See, e.g.*, “frugalista,” *supra* notes 285-287.

influence of consumer and informational intent upon trademark practice, the burden of better facilitating transparent trademarks could be in part placed on the applicants' shoulders. A simple step in this direction would be implementing a brief "environmental scan" in applications and registrations.

If this sounds burdensome, it is only commensurate with the newly granted ability to register without proof of commercial use, among many other fading restrictions. It also carries benefits even the most propertization-right inclined registrant will recognize. Geographic boundaries to commerce are quickly becoming obsolete. Peaceful coexistence of similar marks is threatened, if not by others expanding into their territory, then by assiduousness or the pressure to act assiduously out of fear for their own sovereignty, and thus, the trademark's validity. Dilution law aggravates potential unrest with its lack of consumer confusion. Delta faucets and Delta Airlines—both conceivably famous, strong marks—have likely addressed their nominal overlap, but could have conceivably come to an impasse.⁴⁰⁶ If, instead, a survey of similar marks were necessitated, then statements about the potential mark's distinctiveness could be proffered, as could agreements avoiding an overlap in category or territory or committing to avoid litigation.

This type of pragmatism in applications is not limited to registered marks. Much of the criteria typically used in determining genericism and second meaning can be touched upon

⁴⁰⁶ See Transcript of Oral Argument, *Moseley*, 537 U.S. 418, 2002 WL 31643067 (hereinafter "Moseley Oral Argument"). In trying to understand the harm against which dilution law seeks to protect, Justice Ginsburg posed the hypothetical of Kodak entering a small market to sell monkey wrenches. *Id.* In particular, Justice Ginsburg questioned the existence of injury where there was no tarnishment to the trademark of "KODAK." See *id.* Later in the argument, the example of "Delta" was used to understand the scope of protection where there existed a Delta Airlines, Delta Faucets, and Delta Peanuts. See generally, *id.* at 22–23.

briefly to lend a small level of credence to the mark's viability. Perhaps *frugalista*⁴⁰⁷ was granted on the assumption that it was frivolous as a relatively new portmanteau; the definition may have been unknown to the PTO, but certainly not the registrant.

Effectively, this could compel registrants to formally acknowledge a public domain.⁴⁰⁸ One page of Google results would have been dominated by the unrelated publicity "Let's Roll" was imbued with at the time of application.⁴⁰⁹ Whether an Internet search divulges a long history of Derby Pie,⁴¹⁰ several enthusiastic, different user groups convey a mantra's significance,⁴¹¹ or a consumer survey answers "who dat" with "New Orleans,"⁴¹² a mental leap to register a word or phrase as suggestive may separate the words from their dictionary definition, where they are synonymous with the product in the consumer's mind. Descriptive partial marks protection should be restored, unlike the case of "white meat."⁴¹³

As the range of marks available for registration expand, serious efforts to standardize them should go beyond broadly worded descriptions. Why not, for example, make the Pantone number⁴¹⁴ mandatory for colors to be deemed susceptible to distinction?

⁴⁰⁷ *Supra* note 286.

⁴⁰⁸ A similar theory has been put forth in articles such as Susan M. Richey, *The Second Kind of Sin: Making the Case for a Duty to Disclose Facts Related to Genericism and Functionality in the Trademark Office*, 67 Wash. & Lee L. Rev. 137 (2010).

⁴⁰⁹ *Supra* note 91.

⁴¹⁰ *Supra* note 64 (assuming the search results outweigh the rejected "anecdotal" offerings).

⁴¹¹ Kantorczyk, *supra* note 157.

⁴¹² *Supra* note 51.

⁴¹³ *Supra* note 369.

⁴¹⁴ *Supra* note 312 and accompanying text.

CONCLUSION

Trademarks are simply not what they used to be.⁴¹⁵ Expansion of the trademark's reach has transformed this basic, intellectual property concept beyond its original, comparatively limited business purpose and effect. The relative ease of obtaining a trademark, coupled with the often-exorbitant costs of battling an established mark holder, often deters even those with legitimate claims of use from challenging these famous—and therefore feared—mark holders. Given the difficulty and the small chance for success that non-mark holders or poorer, lesser known mark holders may face, the mutated mark holder opposing such persons is very likely able to defeat them: channeling its commercial influence and discouraging others engaged in innovation as well as, perhaps, competition. Moreover, the broad extension of existing marks comes at a great cost to society, not just those whose private branding and marketing – whose would-be uses of an expression – are stifled. Instead, the public policy fundamentals of consumer protection and market efficiency can be revived through critical analysis of a mark's depth and breadth.

Reform is in the offing. The regulatory and judicial understanding of the marketplace must be adjusted to the contemporary business reality of intense, disruptive, and rapid brand evolution. The answer to legal inconsistencies and overreaching marks is not backpedaling or more regulation, but to demand “inoculation” from a mark's mutation: shifting the affirmative burden of justification to the mark holder. When a mark holder seeks broad expressive property protection, the holder demands expansive legal rights and economic clout. The holder seeks

⁴¹⁵ Thomas D. Drescher, *The Transformation and Evolution of Trademarks—From Signals to Symbols to Myth*, 82 TRADEMARK REP. 301 (1992).

guarantees of dominance, and should meet a high burden to do so. With great power must come great responsibilityTM.⁴¹⁶

⁴¹⁶ WITH GREAT POWER COMES GREAT RESPONSIBILITY, Registration No. 85365090.