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Mutating Marks: Refusing to Lose the Trademark Trail

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**Mutating Marks: Refusing to Lose the Trademark
Trail**

Robert W. Emerson & Katharine C. Collins



MUTATING MARKS: REFUSING TO LOSE THE TRADEMARK TRAIL

Robert W. Emerson & Katharine C. Collins***

ABSTRACT—This article examines and synthesizes several criticisms underlying the expansion of trademark rights, and the sometimes irrational results thereof. The abandonment of trademark law’s foundations, in particular categories of marks, is illustrated most saliently where marks have been allowed to encapsulate meaning and value in and of themselves, unattributable to any qualities or connections to product or source. This touches on, and bridges the gap, between areas which have received academic attention for their problematic evolutions, including naked licensing, strike suits, cultural and particularly sports-centric marks, and sensory marks. Trademark doctrines such as the consumer perception for confusion, and the spectrum of distinction, used to grant and organize marks, are discussed. 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, in order to explain where its boundaries belong. 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

¹ Sidney A. Diamond, *The Historical Development of Trademarks*, 73 TRADEMARK REP. 222, 222–24 (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.

trademark's informative value to 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 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

³ Ralph S. Brown, Jr., *Advertising and the Public Interest: Legal Protection of Trade Symbols*, 57 YALE L.J. 1165, 1184–87 (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, 206–07 (1991).

⁵ Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1705–10 (1999).

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.”).

⁷ WORLD INTELLECTUAL PROPERTY ORGANIZATION, WIPO PUB. NO. 450(E), WHAT IS INTELLECTUAL PROPERTY? 3 (2004), http://www.wipo.int/edocs/pubdocs/en/intproperty/450/wipo_pub_450.pdf (last visited Feb. 2, 2018) [hereinafter WIPO].

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 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,

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 WIPO, *supra* note 7, at 5–6.

¹⁰ *In re 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, 4 (2003).

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).

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 uncommon way” according to the Supreme Court.¹⁹ A common trait 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

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 a type of goods, as opposed to referring to a good

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

¹⁸ *Id.* at 943 n.6.

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> [https://perma.cc/AB8A-SC5E].

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. See 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> [https://perma.cc/B6M6-38Q2] (acquired distinctiveness or secondary meaning).

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).

coming from a single source.²⁷ In establishing the public's conception of the word's primary significance,²⁸ one can use a variety of sources, including dictionary definitions,²⁹ publications, and online search results. If the term is commonly used to refer to a class of products beyond the mark holder's good or service, the term may be generic. Even for registered marks, "genericide"³⁰ is a looming possibility, compelling mark holders to protect their marks by stopping third parties from misusing it.³¹ Even a formerly distinctive mark may become mentally reclassified to represent a whole genus of goods, which puts the mark 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.

II. GOODWILL

Goodwill has played a prominent role in the expansion of modern trademark law.³² However, the concept has only been acknowledged in a rather lopsided way, ignored and thus effectively stymied where unattributable to mark holders. Goodwill is "loyalty that a business earns from its customers."³³ Reputation-related advantage, the tendency of consumers to make repurchases,³⁴ 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,³⁵ so it is certainly a

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).

³² See Apostolos Chronopoulos, *Goodwill Appropriation as a Distinct Theory of Trademark Liability: A Study on the Misappropriation Rationale in Trademark and Unfair Competition Law*, 22 TEX. INTELL. PROP. L.J., 253 (2013).

³³ 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).

³⁴ *Id.* at 583.

³⁵ 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). [<https://perma.cc/YEM6-H5GG>].

monetary reality. In modern consumer research—both as an accounting concept and as a market reality—it is recognized that goodwill is of the utmost importance to protect, and it is often embodied by the trademarks a business owns.³⁶

A. Changing Nature

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 Aunt Jemima's trademark rights to protect brand goodwill beyond pancake mix to reach these closely related product categories.³⁷ The reasoning for this expansion, 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 the owners of Aunt Jemima might be interested in branching out and taking their reputation with them into other product categories where they already had specialized interest and experience.

Expansion of goodwill's power has come with the reciprocal rise of licensing trademarks.³⁸ These agreements 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; these other producers are, of course, not free to misrepresent that they are the originating source itself, but in theory producers must uphold the quality standards a mark represents. Where licensing departs from the intended information transmission function is where it becomes "naked." Naked licensing is licensing of a mark without any quality control over the associated products, 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 an objective rooted in trademark's source-designating or consumer-protecting justifications.³⁹

³⁶ Posner, *supra* note 23. For criticism of how this priority arose, see Lemley, *supra* note 5.

³⁷ Aunt Jemima Mills Co. v. Rigney & Co., 247 F. 407, 409–10 (2d Cir. 1917).

³⁸ See Irene Calboli, *The Case for a Limited Protection of Trademark Merchandising*, 2011 U. ILL. L. REV. 865, 879 (2011).

³⁹ 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, 365 (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

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 a nebulous idea.⁴⁰ 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"⁴¹ to profit off of goodwill, which has since been conflated as a wholesale justification of trademarks' existence. In advancing goodwill-protection as a rationale for trademarks, it is often argued that the markholder invested in the mark, creating the goodwill it expresses, and that others shall not "reap what they have not sown." This belies the distinguishing feature of trademark from other intellectual property—that no act of creativity is accounted for in the balance of trademark protection.

B. *Inherent Goodwill*

Circumstances exist where the intrinsic value of a mark predates its use as one, where nothing is being "sown" at all, or at least it is unclear to whom such "sowing" should be attributed. Minor statutory restrictions can be seen to reflect acknowledgement of this concept of "inherent goodwill," or the value that marks might convey apart from a designation of any source. For instance, 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."⁴² While this may serve to avoid incorrect source-designation, in effect, it also ropes off official public icons from private use or control. This intuitively makes

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,'* L. A. TIMES (May 10, 2016, 7:59 PM), <http://www.latimes.com/business/la-fi-budweiser-america-trademark-20160510-snap-htlstory.html> [<http://perma.cc/3ZTA-TZPC>].

⁴⁰ 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).

⁴¹ 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 40) as an example, the focus would then be more Facebook's property interest than consumers' protection from misinformation.

⁴² 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).

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 protect their cultural representations and totems.⁴³ 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.⁴⁴ However, this statute reflects cultural protection, which is broader than the official seals of a nation, though theoretical boundaries are unarticulated.

The way some marks are now commercialized requires consideration for this fundamental concept: inherent goodwill.⁴⁵ Some marks carry with them pre-existing value. If courts are to accept goodwill protection-function as a freestanding justification for trademark law, and people should not “reap what they have not sown,”⁴⁶ then who is the rightful beneficiary when none have demonstrable proof of value “sown?” The recognition of levels of distinction in granting marks implicitly acknowledge that, in language, “no term is an island,” because it must be considered in light of the particular product and audience, and because meanings are not monolithic. Assuming secondary meaning for fanciful marks is practical as they lack pre-established linguistic tethers. Suggestive marks⁴⁷ capitalize on pre-existing meanings of the word(s) in question, with an often minute but meaningful distinction rising above plain descriptiveness. For the descriptive marks already obviously tied to their subject matter, requiring proof of secondary meaning is a sound constraint on the power of trademark law. In light of the reality of modern commerce areas where trademark law would benefit greatly from a more contextual and functional consideration of predominant mark meanings that might be equally strong as a dictionary definition, especially for relevant consumers.⁴⁸

⁴³ Brian Zark, *Use of Native American Tribal Names as Marks*, 3 AM. INDIAN L.J. 537, 538–43 (2015).

⁴⁴ *WHAT'S IN A NAME? CAN NATIVE AMERICANS CONTROL OUTSIDERS' USE OF THEIR TRIBAL NAMES?*, CULTURAL SURVIVAL (September 1994), <https://www.culturalsurvival.org/publications/cultural-survival-quarterly/whats-name-can-native-americans-control-outsidere-use> [<https://perma.cc/D3GU-C79Q>].

⁴⁵ See Bone, *supra* note 33, 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.”).

⁴⁶ 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).

⁴⁷ As delineated by the spectrum of distinctiveness, *supra* I. C. Spectrum of Distinctiveness.

⁴⁸ 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>.

C. Idioms and Atmospherics

Trademarks may come pre-loaded with a wealth of associations in the public's mind. This is clear from the recognition that certain non-descriptive terms are "arbitrary" in relation to a particular subject, while others are more closely related and thus "suggestive." However, there are many examples in which accurately perceiving a term's well-established connotation or perhaps even its actual definition requires substantial consideration of the cultural context in which it exists.

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.⁴⁹ 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.⁵⁰ It was said to be a responsive catchphrase for World War II fighter pilots⁵¹ before turning to a sports cheer⁵² 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 Marching In" in a video with the NFL players.⁵³ 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 his song, "A Milli" in 2008.⁵⁴

⁴⁹ *Idiom*, MERRIAM WEBSTER, <http://www.merriam-webster.com/dictionary/idiom> [<https://perma.cc/NG87-GB43>].

⁵⁰ 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 [<http://perma.cc/JFS6-S7JK>].

⁵¹ Erin Z. Bass, *Who is Who Dat?*, DEEP SOUTH MAGAZINE (Jan. 28, 2010), <http://deepsouthmag.com/2010/01/who-is-who-dat/> [<https://perma.cc/KTD4-GUV4>].

⁵² 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> [<https://perma.cc/2YZK-XSZL>].

⁵³ 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.").

⁵⁴ LIL' WAYNE, *A MILLI* (Cash Money Records 2008) (saying "who dat" at 2:25, unlikely in reference to the Saints, given Wayne's public statements of support for the Green Bay Packers NFL football team, as opposed to the Saints, in interviews available at <https://www.youtube.com/watch?v=C6mNpVzuerw>).

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 “who dat” as exclusive property of the NFL.⁵⁵ 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.⁵⁶ The response was loud public indignation ranging from bipartisan retorts by Louisiana public officials⁵⁷ to outcries that the NFL engaged in opportunistic cultural profiteering,⁵⁸ among many other complaints.⁵⁹ These criticisms demanded the NFL respect a concept quite similar to copyright’s “public domain,” which in a classical sense would not be a concern of trademark law. While originality of the mark itself is unnecessary, originality of its meaning—or at least the lack of a pre-existing associative link—is allegedly the foundation of a trademark holder’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.⁶⁰ That Louisiana resident fans logically linked it to yet another hometown football team⁶¹

⁵⁵ Associated Press, *NFL Claims Trademark Infringement*, ESPN (Jan. 30, 2010), <http://sports.espn.go.com/nfl/playoffs/2009/news/story?id=4871697> [https://perma.cc/X44K-DQPV]. (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).

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> [https://perma.cc/2AXK-S4FC].

⁵⁷ Associated Press, *NFL Claims Trademark Infringement*, ESPN (Jan. 30, 2010), <http://sports.espn.go.com/nfl/playoffs/2009/news/story?id=4871697> [https://perma.cc/X44K-DQPV]. (“Please either drop your present ridiculous position or sue me.”).

⁵⁸ 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> [https://perma.cc/2AXK-S4FC] (illustrating the cultural significance of the phrase: “The NFL, they contend, never cared about the quirky chant when the 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.”).

⁵⁹ *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’”).

⁶⁰ 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 [https://perma.cc/K2FQ-GVEL] (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).

⁶¹ Davidson, *supra* note 52 (referring to earlier use by two local high schools).

through music⁶² 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.⁶³

Another historically rich example is “Derby Pie.”⁶⁴ 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.⁶⁵ In 1988, *Bon Appetit* magazine won a summary judgment motion⁶⁶ on a genericism suit by presenting magazines, cookbooks, and menus from across the country, all containing 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.⁶⁷

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 kings⁶⁸—or, alternatively, in Ralph Lauren’s view to a distinctly American lifestyle brand in 1967.⁶⁹ 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),⁷⁰ when the magazine attempted to expand from a sports-only publication to the lifestyle associated with it. Given the

⁶² Dbg53, *supra* note 53.

⁶³ For more on the structural troubles of outside parties attempting to rein in marks, *see infra* Section IV. A. Anti-Competitive Incentives.

⁶⁴ 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> [<https://perma.cc/3N8N-BUSX>].

⁶⁵ Brett Barrouquere, *Derby Pie maker, restaurant end trademark dispute*, HUFFINGTON POST, http://www.huffingtonpost.ca/2013/10/02/a-pie-by-any-other-name-_n_4030728.html [<https://perma.cc/9BD4-NE9T>] (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.*

⁶⁶ *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”).

⁶⁷ *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).

⁶⁸ *See* Richard C. Latham, *Polo*, BRITANNICA, <http://www.britannica.com/sports/polo> [<https://perma.cc/2Y99-T79L>].

⁶⁹ *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658 (5th Cir. 2000).

⁷⁰ *Id.*

prominence of Polo Ralph Lauren and connotations of high-class athletics it had adopted, courts found the magazine's expansion created 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."⁷¹ 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.⁷² 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.⁷³ The use of "rugby" by anyone other than Ralph Lauren when printed on clothing, or even alongside other words, was met with cease-and-desist letters from PRL. Again, a suit was filed against organizers of the 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.⁷⁴ In the Polo trial, USPA lawyers attempted to establish Ralph Lauren's pattern of claiming a very broad scope of marks by noting the company's disregard for the sport of rugby before the second suit was even filed.⁷⁵ While groups from both sports ultimately retained reasonable ability to use the words, neither result set a precedent for protecting the logical mark users from this type of costly legal action. In addition to the structural impediments to preventing a privatization of these

⁷¹ *Id.* at 673.

⁷² *Id.* at 675 (noting, "The appropriate remedy may be may be 'not less speech, but more.'").

⁷³ 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> [https://perma.cc/69GK-CU35].

⁷⁴ *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).

⁷⁵ *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 fact that Ralph Lauren had a chain of stores named "Rugby," with Lauren having no significant ties to or even apparent interest in the sport, Rugby, while he long had a beloved dog with that very name, Rugby. Compare this to another dog name "Who Dat," which was taken as evidence of public interest in a mark. *See* Levitz, *supra* note 58. 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).

culturally-created mark-meanings, the aforementioned examples also illustrate the problem of attribution of such value.

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,"⁷⁶ 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.⁷⁷

With the rise of "intent to use" applications, mark holders can begin to stake their claims without evidence of any actual use,⁷⁸ 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 beyond assessing distinctiveness, pre-existing appeal is assumed to evaporate the moment the mark is registered. The impressions a mark gives to 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.⁷⁹ This is well-expressed by Graeme W. Austin:

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.⁸⁰

⁷⁶ See Dreyfuss, *supra* note 46.

⁷⁷ See Nat'l. Pork Bd. v. Supreme Lobster & Seafood Co., 96 U.S.P.Q.2d (BNA) 1479, (T.T.A.B. 2010).

⁷⁸ 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).

⁷⁹ 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.

⁸⁰ Graeme W. Austin, *Trademarks and the Burdened Imagination*, 69 BROOK. L. REV. 827, 901 (2004).

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 artifacts⁸¹ or in preserving existing cultural artifacts from being converted into marks,⁸² 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, by the Trademark Law Revision Act of 1988,⁸³ created mark approval without any proof of any investment, requiring only a sworn statement of the applicant's intent to use and good faith, which goes unscrutinized. This establishes a date of mark ownership if proof of commercial use is provided within a timeframe of up to 36 months. Once this is granted, a high assumption of mark validity is given. Removing the need to prove commercial use without commensurately reducing the assumptive power of the mark's registration has thrown the trademark system off-balance.⁸⁴

Certainly intellectual property free-riding extends beyond the trademark domain. A window for opportunistic⁸⁵ 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 which have been investigated by Congress.⁸⁶ Domain squatting, or "cyber-piracy,"⁸⁷ has been defeated by famed businesses in court.⁸⁸ Similarly, "celebrity squatting" often delves into remedies through a right to publicity,⁸⁹ 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

⁸¹ See Dreyfuss, *supra* note 46.

⁸² 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).

⁸³ 15 U.S.C. §§ 1051–1128 (1988); Hellwig, *supra* note 78, at 291–292.

⁸⁴ 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).

⁸⁵ Lee B. Burgunder, *Opportunistic Trademarking of Slogans: It's No Clown Issue, Bro*, 31 CARDOZO ARTS & ENT. L.J. 769 (2013).

⁸⁶ 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/> [<https://perma.cc/92AL-RP8Q>].

⁸⁷ 15 U.S.C. § 1125(d).

⁸⁸ Nike, Inc. v. Circle Group Internet, Inc., 318 F. Supp. 2d 688 (N.D. Ill. 2004).

⁸⁹ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995).

prominent catchphrase,⁹⁰ and Trademark Trial and Appeal Board (TTAB) precedent coming to respect commercial linkage⁹¹ as well as the mark's being "almost a nickname."⁹²

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,"⁹³ 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. Though it became endowed with powerful meaning, this was clearly not the sort of informational function trademark law intended to protect, as no producer reputation was conveyed though circumstances established intrinsic goodwill.⁹⁴ 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.⁹⁵

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.⁹⁶ 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

⁹⁰ See *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).

⁹¹ Robert D. Litowitz & Mark Traphagen, *The Song Remains the Same*, 18 TEX. PARALEGAL J. (2000), https://txpd.org/tpj/18/song_same.htm [<https://perma.cc/396A-ZKM3>].

⁹² *Id.* ("affidavits of several members of the music industry stating that 'Margaritaville' was almost a nickname of Jimmy Buffet").

⁹³ U.S. Trademark Application Serial No. 76316210 (filed Sept. 22, 2001); See also Noah Bleicher, *Trademarking Tragedy: The Fight for Exclusive Rights to 'Let's Roll'*, 52 EMORY L.J. 1847 (2003).

⁹⁴ Bleicher, *supra* note 93, at 1865.

⁹⁵ Bleicher, *supra* note 93, at 1874–75.

⁹⁶ 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/> [<https://perma.cc/PZ6P-EP4W>].

brewer, and even “beer” itself, occurred with frequencies of zero and four percent, respectively.⁹⁷

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 better articulate the value a mark does (or does not) contain in commerce, then its primary functions must be examined in several dimensions.

III. PRIMARY PURPOSE

In the light of protecting information transmission and consumer interests,⁹⁸ understanding the potentially multidimensional purposes of a mark is critical. The reality that a mark interacts with and affects the product at hand, and the normative choice to deny mark-based non-reputational advantages to one competitor, are reflected by the doctrine of functionality, including aesthetic functionality. Marks may be valuable for their own communicative strength. Some desirable non-source messages—including, without any controversy, plain product-description and the extension thereto to personal expression by consumers—are not meant for commoditization via 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.”⁹⁹ This delineates the boundary from patent law, which is meant to reward functional advances and inventions. 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.¹⁰⁰ 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.¹⁰¹

⁹⁷ GOOGLE TRENDS, <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> (last visited Feb. 4, 2018) [<https://perma.cc/VBP6-QNGW>].

⁹⁸ See *supra* Section I. A. Justifications.

⁹⁹ *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850–51 n.10 (1982).

¹⁰⁰ *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995).

¹⁰¹ Vincent N. Palladino, *Trade Dress Functionality After TrafFix: The Lower Courts Divide Again*, 93 TRADEMARK REP. 1219, 1224–25 (2003).

Utile functions are features directly contributing to the product purpose as intended by the producer.¹⁰² However, intended function is not necessarily espoused in good faith on all trademark registrations. This can be illustrated by the controversy surrounding Boise State University's trademark on its abnormal blue-turf football field.¹⁰³ Its trademark registration details an entertainment purpose, through intercollegiate sports played in the stadium and shown through media.¹⁰⁴ First, it could and has been argued that a colorful field qualitatively affects those purposes. Telegenic benefits are touted by owners of similarly vibrant sports fields¹⁰⁵ and are a prized factor for media broadcasters.¹⁰⁶ Complaints of competitive advantage in those intercollegiate sports, by way of camouflage, emerged when Boise's football team adopted turf-matching blue uniforms.¹⁰⁷ The scientific merits of this asserted advantage has not been studied, but complaints appear to be bolstered by the football team's uncharacteristically strong home win record correlating with the use of such uniforms.¹⁰⁸ Additionally, any source-identifying purpose is dubious in context. The turf is physically fixed within the campus grounds, surrounded by Boise State signage, and during game broadcasts, students and fans.¹⁰⁹ In broadcasts, primarily of college football games, the scoreboard, uniforms, traditional field markings, and presentation by announcers all clearly identify the host team.¹¹⁰ These potential advantages for Boise State, even only in its stated purposes of sporting events and of securing lucrative broadcasts, outweigh whatever incremental, source-identifying objective is available.

¹⁰² *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001).

¹⁰³ 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).

¹⁰⁴ BLUE TURF, Registration No. 3,707,623.

¹⁰⁵ 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/> [<https://perma.cc/9UFB-KFFY>].

¹⁰⁶ *Sportvision, Inc. v. Sportsmedia Tech. Corp.*, WL 408634, at *7-8 (N.D. Cal Feb. 17, 2006).

¹⁰⁷ See Gallagher, *supra* note 103.

¹⁰⁸ 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. While traditional "home field advantage" can explain some of the discrepancy, it is at least a remarkable pattern. Statistics from cfbdatawarehouse.com.

¹⁰⁹ 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/ncaaf/boise-state-mounts-a-paper-defense-of-its-home-turf.html?_r=0 [<https://perma.cc/4ME9-J62A>].

¹¹⁰ *Id.*

Aesthetic functionality¹¹¹ is described in the *Pagliero* case as ornamentation serving “an important ingredient in the commercial success.”¹¹² The court determined that consumers interpreted a decorative pattern on china as a desirable quality in and of itself, and not primarily as a source indicator: “the design sells the china.”¹¹³ There are two significant implications of this doctrine, which established that when a design performs a function more so than identifies 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.¹¹⁴ Even if rationality were possible, to consumers, aesthetics are a valid function,¹¹⁵ 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, as much legal scholarship has discussed.¹¹⁶ Many “communications” touch upon the desires of consumers versus producers, but others are purely informative statements¹¹⁷ that a layman might assume belong in a “public domain.” For instance, a 32-year-old man was granted several trademarks in the mid-1990s for the standard

¹¹¹ Margot E. Parmenter, *Louboutins and Legal Loopholes: Aesthetic Functionality and Fashion*, 40 PEPP. L. REV. 4 (2013).

¹¹² *Pagliero v. Wallace China Co.*, 198 F.2d 339, 343 (9th Cir. 1952).

¹¹³ *Id.* at 343–44.

¹¹⁴ 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.”).

¹¹⁵ *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)).

¹¹⁶ 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).

¹¹⁷ *In re Volvo Cars of North America Inc.*, 46 U.S.P.Q.2d 1455 (TTAB 1998) (rejecting “drive safely”).

character mark, “Class of 2000,”¹¹⁸ for a range of product categories from tee shirts to teddy bears. When this story hit the news about 16 months before that academic “class” would generally graduate, he already had over 30 licensees who had each agreed to 8 to 10 percent royalty fees to use the term.¹¹⁹ Where copyright law prohibits registering non-original facts or phrases, trademark law does not.¹²⁰ Instead of carrying information about source or even qualities associated with source, communicative marks may themselves constitute the information itself. No consistent litmus test is applied to determine the mark’s primary meaning or possibly protected functions before granting functionally 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 can fulfill to attract consumers by way of trademarks.¹²¹ Goods may serve as “billboards,” communicative tools in the hands of consumers to express themselves.¹²²

¹¹⁸ Associated Press, ‘Class of 2000’ Trademarked for Merchandise in Retailers, TOLEDO BLADE, Oct. 7, 1998, <https://news.google.com/newspapers?id=Yg8wAAAAIBAJ&sjid=6gMEAAAAIBAJ&pg=3896%2C2418085> [<https://perma.cc/3PPS-25PZ>].

¹¹⁹ 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 would rationally believe this mark is invalid. That 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. Alternatively, it may 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, or are risk-adverse. If a mark holder did not believe its registration’s ability to hold up in court, this could be quite a profitable alternative to problematic litigation. In this particular case, the mark holder was bold enough to publicize his opportunistic tactics and lack of intent to pursue them, *supra* note 118. This particular mark holder’s behavior could be addressed by more robust importation estoppel, described *infra* Section V. B. Eye on the Ball.

¹²⁰ See the idea-expression dichotomy, *supra* Section I. B. Uniqueness among Intellectual Property.

¹²¹ 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).

¹²² For a thorough and very fun study of billboard products and slogan trademarking, see Burgunder, *supra* note 85.

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 that give off the illustrious impression that their possessors are, for example, wealthy and stylish enough to own an Audi,¹²³ does not grant the right to produce and sell disingenuous key chains. In that 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.¹²⁴ 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 note that key chains marked with a car logo are reasonably related product categories, where this implied association is clear.

But when the actual benefit of a mark is its implication, it does not necessarily mean the mark holder personally created that implication. For instance, the *Jobs Daughters*¹²⁵ case found on appeal that a fraternal name and emblem were functionally aesthetic and not serving as marks. The court 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 parties for ornamental use, there should be reciprocal consideration when pre-existing meanings are being mined by the original mark holders.¹²⁶

There are numerous other trademark cases in relation to the insignia of fraternal or "Greek" organizations for parallel consideration. The district court in *Pure Country*¹²⁷ rejected outright the *Jobs Daughter's* logic regarding aesthetic functionality, but left other logical gaps in protecting marks used for personal expression. Charges against mark holders for abandonment through naked licensing¹²⁸ were rejected by the court "because the consumers are the members of the trademark-holding organizations. . . . There is no issue of consumer deceit."¹²⁹ However, there is some circular

¹²³ *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1071 (9th Cir. 2006).

¹²⁴ *Id.*

¹²⁵ *Int'l Order of Job's Daughters v. Lindeburg & Co.*, 727 F.2d 1087 (Fed. Cir. 1984).

¹²⁶ This is arguably the case in circumstances such as those mentioned *supra*, *D. Free Riders*.

¹²⁷ *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).

¹²⁸ *See supra*, Section II. A. Changing Nature.

¹²⁹ *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.*

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 mark holder control are deemed *harmless*, in service of an interpretation that tamps out a similar uncontrolled use for causing *harm*. This is one of many illustrations of consumer competence being determined inconsistently, at the will of mark holder 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*¹³⁰ abandonment occurs only when a mark loses all significance as an indication of origin *as to the mark itself*.¹³¹

This is an underwhelming standard when combined with the negligible state of “quality control” standards required to avoid a finding that a mark has been “abandoned”.¹³² What instead may be protected is language and symbolism captured by a mark, without meaningful limitations on where it came from.

C. *Of the Purchase*

Aside from considering what function consumers may intend a mark to have, it also must be analyzed according to what purpose the mark-bearing goods themselves serve. Take, for example, the retail of licensed collegiate apparel. There, some courts have utilized the functionality test of equally-effective alternatives¹³³ in 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. 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

¹³⁰ Referencing *Sweetheart Plastics, Inc. v. Detroit Forming, Inc.*, 743 F.2d 1039 (4th Cir. 1984).

¹³¹ *Bd. of Gov. of Univ. of N.C. v. Helpingstine*, 714 F. Supp. 167, 173 (M.D.N.C. 1989) (emphasis in original).

¹³² See *infra* Section IV.B.2. Diminishing Expectations of Control.

¹³³ *TraFFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 32–34 (2001).

insignia soft goods market. We know of no legal theory which would countenance such a result.¹³⁴

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."¹³⁵ 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."¹³⁶ Yet Collegiate Licensing Company (CLC), which now represents both of these aforementioned schools in licensing matters, itself values the collegiate merchandise retail market at \$4.6 billion.¹³⁷ 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.

The market for collegiate apparel is a distinct one. The CLC also offers some arguments for marks' effects upon cost, quality, and product function in their own company promotional materials, stating that "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."¹³⁸ 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?¹³⁹ In a choice between relevant market definitions, the *Pitt* approach, extending established functionality standards to capture retail realities, is far more in line with confining trademarks to their intended purpose.

¹³⁴ Univ. of Pittsburgh v. Champion Prods., Inc., 566 F. Supp. 711, 722 (W.D. Pa. 1983).

¹³⁵ Tex. Tech Univ. v. Spiegelberg, 461 F. Supp. 2d 510, 527 n.2 (N.D. Tex. 2006).

¹³⁶ 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 114.

¹³⁷ *About CLC*, COLLEGIATE LICENSING COMPANY, <https://www.clc.com/About-CLC.aspx> [<https://perma.cc/G3KC-NGBL>] (last visited Feb. 28, 2017).

¹³⁸ *Id.*

¹³⁹ 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 making exclusive 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").

*Damn I'm Good, Inc. v. Sakowitz, Inc.*¹⁴⁰ is another 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.¹⁴¹ 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 colors have meaning independent of commercial attribution. For example, floral arrangements in black vases are commonly used for Halloween, bereavement, or the color's luxurious appeal.¹⁴²

D. Scale of Specificity

To normalize these discussions, what must be agreed upon is at what scale of detail the consumer purchase decision determinations should be analyzed. *A.J. Canfield Co. v. Honickman*¹⁴³ 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 sole source of diet chocolate fudge flavored soda in the market, this was ruled to be a generic term describing the product.¹⁴⁴ Beverages are not interchangeable; and even soda flavors are not freely substituted. There were even clashes pertaining to the distinctiveness of "chocolate" versus "fudge" as descriptors.¹⁴⁵

However, the term "honey baked ham" was found to be an acceptable mark.¹⁴⁶ Calling back the genus analogy for determining genericism (where a product lies within a category, as a species lies within a genus),¹⁴⁷ the court found honey *prepared* ham to be the category within which "honey baked"

¹⁴⁰ 514 F. Supp. 1357 (S.D.N.Y. 1981).

¹⁴¹ *Id.* at 1360.

¹⁴² *In re Florists' Transworld Delivery, Inc.*, Serial No. 77590475 (TTAB Mar. 28, 2013).

¹⁴³ *A.J. Canfield Co. v. Honickman*, 808 F.2d 291 (3d Cir. 1986).

¹⁴⁴ *Id.* at 298.

¹⁴⁵ 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> [<https://perma.cc/8THZ-22KH>].

¹⁴⁶ *Schmidt v. Quigg*, 609 F. Supp. 227, 231 (E.D. Mich. 1985).

¹⁴⁷ *Pierce*, *supra* note 25; *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90 (Fed. Cir. 1986).

resided.¹⁴⁸ These differences seem small, but at least have sound logical backing. “Honey baking” could result in the same product as honey preparing, smothering, infusing, or any of several other compound verbs, but “diet chocolate fudge soda” invokes only a flavor, leaving no breathing room for interpretation, and thus for competition.

Ring pops¹⁴⁹ illustrate the complexity of genus determination, where courts have endeavored to undertake it. According to the court, the genus was lollipop candy.¹⁵⁰ However, whether the relevant consumer class is interpreted to be the children or the parents they are pressuring for the candy,¹⁵¹ both can likely distinguish between the distinct types of lollipop proffered under the trademarks 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.¹⁵² There can be many other levels of specificity available for determining genus. For instance, the particular ring shape could have been a defensible categorical division, as could “lollipop that functions as a toy,” “wearable lollipop,” or “lollipop in 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.¹⁵³ Will a Dum Dum equally placate a child demanding candy accessories? 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 trademark jurisprudence often naïvely ignores this fragmentation’s consequences.¹⁵⁴

¹⁴⁸ *Schmidt*, 609 F. Supp. at 229.

¹⁴⁹ *Topps Co. v. Gerrit J. Verburg Co.*, No. 96 CIV. 7302 (RWS), 1996 WL 719381, at *1 (S.D.N.Y. Dec. 13, 1996).

¹⁵⁰ *See id.* at 2–3.

¹⁵¹ *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> [<https://perma.cc/YC3T-B68V>].

¹⁵² *Topps Co.*, 1996 WL 719381.

¹⁵³ 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 possibility for a mark-conferred competitive advantage is much stronger. Shifting conceptions of consumers are discussed *supra* Section III. 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 Goodwill*, 47 U. LOUISVILLE L. REV. 167 (2008) (for an instance of functionalism based on individual circumstances); *see also* Pierce, *supra* note 25.

¹⁵⁴ *See* Desai, *supra* note 114, at 992.

The breadth of genus determination can be, and has been, equated to market definition.¹⁵⁵ Given that both the functionality and aesthetic functionality doctrines discuss preventing unfair disadvantages among competitors, logically those competitors must be identified. Similar cases, *University of Pittsburgh v. Champion Products, Inc.*¹⁵⁶ and *Texas Tech University v. Spiegelberg*,¹⁵⁷ still vary greatly in their standards for defining and interpreting the competitive market, which vary across time and jurisdictions. However, there is no identifiable trend 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.¹⁵⁸ The law is due for not a complete reset, but reform. 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”¹⁵⁹ 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 mark¹⁶⁰ 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” championship to claim at that point, but intent to use had recently been incorporated into law,¹⁶¹ and it was perfectly valid to preemptively protect

¹⁵⁵ 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 Antitrust law).

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

¹⁵⁷ 461 F. Supp. 2d 510, 524 n.2 (N.D. Tex. 2006).

¹⁵⁸ 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).

¹⁵⁹ 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).

¹⁶⁰ Scott Ostler, *Champions Entering a New Phrase as Riley Impels by Word of Mouth*, L.A. TIMES (June 6, 1989), at C1.

¹⁶¹ 15 U.S.C. §§ 1051–1128 (1988).

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.¹⁶² "Three-peat" as a mark did not die out with the Lakers' hopes; three-in-a-row 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 within the NBA alone.¹⁶³ Eventually the Lakers did get a three-peat of championship wins from 2000-2002; 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 the mark holder Riley hedges his success by 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.¹⁶⁴ The term is commonly used to indicate any three consecutive sports championships, often by media, third parties, and publicly by Riley himself.¹⁶⁵ 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 1980,¹⁶⁶ 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 petition for cancellation,¹⁶⁷ or invest the time and monetary risk of defending an infringement suit and attempting to rebut a mark's high presumption of validity.¹⁶⁸ Most problematic for private efforts to cancel a mark is the lackluster resulting incentives, commonly known as the "tragedy of commons." If a term is determined to be generic, the mark holder does lose

¹⁶² Tony Kornheiser, *Anybody Need a 3-Peat Slogan?*, L.A. TIMES (June 18, 1989), at C15; see also Ostler, *supra* note 160.

¹⁶³ 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 [<https://perma.cc/MT5F-5STT>].

¹⁶⁴ See, e.g., *Remington Prods., Inc. v. N. Am. Philips Corp.*, 892 F.2d 1576, 1580 (Fed. Cir. 1990).

¹⁶⁵ Kantorczyk, *supra* note 159.

¹⁶⁶ FTC Improvements Act of 1980, Pub. L. No. 96-252, 94 Stat. 374 (1980).

¹⁶⁷ See 15 U.S.C. §1064, also preserving the ability to petition on the grounds of functionality, and somewhat mitigating the issue by providing that the FTC may petition for mark cancellation.

¹⁶⁸ *Reese Publ'g Co. v. Hampton Int'l Comme'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.").

exclusive right to control that mark's use, and the mark is now free for everyone to use. However, the complainant alone absorbs the costs of such petition, or worse, the costs of defending an infringement action upon such grounds. As a practical matter, use of the generic term at hand must be highly or uniquely valuable to encourage such a proceeding.¹⁶⁹

Situational matters can compound this lack of incentives.¹⁷⁰ 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 justify Pat Riley extracting rents upon their 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,¹⁷¹ so one should consider its reality in light of the justifications for trademark rights. Certainly no old-fashioned product 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

¹⁶⁹ Infringement actions always may be defended on the basis of a mark's genericism, or threats economic competition severe enough to infringe antitrust law under Section 33(b)(7) of the Lanham Act. After five consecutive years of use, marks become incontestable, eliminating related defenses such as asserting a mark to be purely descriptive cannot be raised. *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).

¹⁷⁰ Kantorezyk, *supra* note 159.

¹⁷¹ Though 15 U.S.C. §1064(3) allows for the petition for cancellation on grounds of genericism and functionality, in addition to the situational factors that make this particularly unlikely in this case, it is not clear that these grounds would lead to the mark's cancellation in absence of some embrace of the communicative functionality and consumer-focused reframing of the product definition discussed *supra*.

the loosening of trademark standards, but consumer confusion caused by this counterintuitive mark has not been considered when tightening standards.¹⁷²

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”¹⁷³ in 2008. This was filed as the team neared a 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 2015.¹⁷⁴ 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 intervening 7.5 years, the Patriots held hostage the public’s ability to sell an array of goods bearing that record, which someday the Patriots may actually earn.¹⁷⁵

B. Quality Standards

Quality control of marks 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 the courts have approached in several cases surrounding a particular cultural phenomenon: boybands.¹⁷⁶ A test¹⁷⁷ was

¹⁷² This contributes to and reflects the influence of mark holders in shaping trademark law, *see infra* Section IV C.11. Circularly Setting Perceptions.

¹⁷³ 19-0, Registration No. 77374670.

¹⁷⁴ 19-0 - *Trademark Details*, JUSTIA, available at <https://trademarks.justia.com/773/74/19-0-77374670.html> [<https://perma.cc/YX3E-B4G7>].

¹⁷⁵ 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 207.

¹⁷⁶ McGuffey, *supra* note 153, at 191.

¹⁷⁷ *Bell v. Streetwise Records, Ltd.*, 640 F. Supp. 575 (D. Mass. 1986).

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 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.¹⁷⁸

The notable exception is a publicly-recognized concept group, a la the “Menudo Model.”¹⁷⁹ 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.¹⁸⁰ 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 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.¹⁸¹

¹⁷⁸ *Id.* at 582.

¹⁷⁹ *Supra* note 176, at 191.

¹⁸⁰ *Infra* note 353.

¹⁸¹ Ari Wasserman, *An ‘Epidemic’ of Fake Ohio State Jerseys: Why Buckeyes Fans Are Buying Them and What it Means for the Program*, CLEVELAND.COM (last updated Apr. 21, 2016, 4:14 PM), http://www.cleveland.com/osu/index.ssf/2015/11/an_epidemic_of_fake_ohio_state.html [https://perma.cc/894S-BVGX] (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.

2. *Diminishing Expectations of Control*

The judiciary's tone on concern for trademark quality control has consistently diminished with time.¹⁸² In common law prior to the Lanham Act, an actual source's indication was required for a mark to be considered valid.¹⁸³ As licensing informally appeared in the business world, the early cases condemned those who did not exclusively use their trademarks under strict controls, exacting uniformity.¹⁸⁴ Usage by "related companies" was formally introduced by the Lanham Act,¹⁸⁵ defined in section 45: "The term 'related company' means any person who legitimately controls or is controlled by the 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."¹⁸⁶

Legitimate or adequate, control was never explicitly defined, but *exercising* it in some capacity was mandatory, as wholly-uncontrolled marks were found invalid.¹⁸⁷ 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."¹⁸⁸

Standards then were also interpreted to require "actual" control. Basically, standards in practice had to be maintained, though specifics no longer need to be formally stated.¹⁸⁹ Yet other courts accepted expressly stated controls, declining to find abandonment even when those standards were not actually enforced.¹⁹⁰ The standard benchmark of "adequate" controls shifted to "sufficient" and then to "minimal" controls.¹⁹¹ Several cases from the mid-century onward overlooked a lack of any affirmative control, so long as the products did not deceive¹⁹² the public. A structural

¹⁸² See Irene Calboli, *The Sunset of "Quality Control" In Modern Trademark Licensing*, 57 AM. U. L. REV. 341, 351–52 (2007).

¹⁸³ See, e.g., *Macmahon Pharmacal Co. v. Denver Chem. Mfg. Co.*, 113 F. 468, 474–75 (8th Cir. 1901).

¹⁸⁴ *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).

¹⁸⁵ Lanham Act, 15 U.S.C. §§ 1051–1127 (1964).

¹⁸⁶ *Id.* § 1127.

¹⁸⁷ See *Sterling Drug, Inc. v. Lincoln Laboratories, Inc.*, 322 F.2d 968 (7th Cir. 1963).

¹⁸⁸ *Dawn Donut Co. v. Hart's Food Stores, Inc.*, 267 F.2d 358 (2d Cir. 1959).

¹⁸⁹ *Embedded Moments, Inc. v. Int'l Silver Co.*, 648 F. Supp. 187, 194 (E.D.N.Y. 1986).

¹⁹⁰ *Pike v. Ruby Foo's Den, Inc.*, 232 F.2d 683, 685–86 (D.C. Cir. 1956).

¹⁹¹ *Kentucky Fried Chicken Corp. v. Diversified Packaging Corp.*, 549 F.2d 368, 387 (5th Cir. 1977).

¹⁹² See *Land O'Lakes Creameries, Inc. v. Oconomowoc Canning Co.*, 330 F.2d 667, 669 (7th Cir. 1964); *Transgo, Inc. v. Ajac Transmission Parts Corp.*, 768 F.2d 1001, 1022 (9th Cir. 1985); *Taco Cabana*

impediment to enforcing quality control standards is posed by the doctrine of licensee estoppel, preventing those who have been licensed to use a mark—likely those with the best information on the existence of such controls—from challenging the mark’s validity.¹⁹³

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 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 privatizing non-mark attributes.

Association construction has caught the ire of trademark holders in the circumstances of “ambush marketing.”¹⁹⁴ This is when outsider businesses craft unsanctioned paths to consumers, reaching them in some channel where 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 or mentioning teams’ home cities in commercials aired during game broadcasts without entering into an official relationship with the league.¹⁹⁵ However, all of Pepsi’s content explained its lack of affiliation with the NHL, which Canadian courts found 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 Fédération Internationale de Football Association (FIFA) World Cup.¹⁹⁶ Bavaria Beer gave away about 120,000 bright-orange and branded lederhosen to enraged Dutch fans at 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

Int’l, Inc. v. Two Pesos, Inc., 932 F.2d 1113 (5th Cir. 1991), *aff’d*, 505 U.S. 763, 780 (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, despite a lack of controls, such standards were maintained.

¹⁹³ See Fair Isaac Corp. v. Experian Info. Sols., 650 F. 3d 1150 (8th Cir. 2011) (discussing the doctrine though limiting it to direct licensees, not licensee affiliates).

¹⁹⁴ 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).

¹⁹⁵ Nat’l Hockey League. v. Pepsi-Cola Can. Ltd. (1992), 70 B. C. L. R. 2d 27 (Can. B.C. S.C.).

¹⁹⁶ Mark A. Lemley & Mark McKenna, *Irrelevant Confusion*, 62 STAN. L. REV. 413 (2010).

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?¹⁹⁷

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 Beats international attention without the cost of an official partnership.¹⁹⁸ Athletes and celebrities alike are given numerous free products for the potential value of their exposure as advertisement (if not endorsement).¹⁹⁹ 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.²⁰⁰ 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 a mark.

¹⁹⁷ This falls into the concerns discussed *supra* Section B. Inherent Goodwill.

¹⁹⁸ Andrew Hamp, *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> [<https://perma.cc/NSF9-C8HC>].

¹⁹⁹ Interview with Heather Lounsbury, Producer of product "placements" mentioned during the telecast of the Academy of Motion Picture Arts and Sciences Oscar Awards, in College Park, Md. (Aug. 29, 2016).

²⁰⁰ See, e.g., *supra* note 118.

“Refuse to lose” is both a catchy rhyme²⁰¹ and a trademarked phrase. In a February 20, 2017 Google search, the first page of over sixteen million results includes songs by “Brotha Lynch Hung,”²⁰² “Dead Prez,”²⁰³ and Jarekus Singleton,²⁰⁴ an anti-gang task force in Lakeland, Florida²⁰⁵ and one reference to a book authored by John Calipari. Calipari personally applied for registration of the phrase as a trademark in 1994²⁰⁶ after using it motivationally as a third-year head coach for the University of Massachusetts men’s basketball team. The school was familiar with the motto, popularized by a shirt made by senior players about their successful 1990 men’s football team.²⁰⁷ But UMass’ use was not unique, since initial mark registration was actually sought out by the coach for women’s tennis at Duke University.²⁰⁸

To understand claims of attribution, it should be acknowledged that John Calipari is undoubtedly as savvy a marketer²⁰⁹ as he is a coach (and he is a quite successful coach).²¹⁰ He negotiated ESPN airtime by accepting a midnight “madness” game and continually praised the fan base, which then rose to meet his expectations.²¹¹ 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”

²⁰¹ Pagliero, *supra* note 112, (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); Hughes, *supra* note 14, at 1251, (linguistic advantages are potential examples of embedded psychological or cognitive functions a mark may be capable of serving).

²⁰² Brotha Lynch Hung, *Refuse to Lose*, YOUTUBE (Apr. 11, 2010), <https://www.youtube.com/watch?v=T91I7581Jb4>.

²⁰³ Dead Prez, *Refuse to Lose*, YOUTUBE (July 5, 2009), <https://www.youtube.com/watch?v=frFCbUoQcVU>.

²⁰⁴ <http://www.amazon.com/Refuse-To-Lose-Jarekus-Singleton/dp/B00ITNG4P0>.

²⁰⁵ *Refuse to Lose Make the Pledge*, CITY OF LAKELAND, <https://www.lakelandgov.net/departments/lakeland-police-department/refuse-to-lose/> [<https://perma.cc/5YY5-45D5>].

²⁰⁶ REFUSE TO LOSE, Registration No. 2,048,577.

²⁰⁷ *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.”) [<https://perma.cc/FK6X-P2BV>].

²⁰⁸ *Calipari Refuses to Lose Any Money Over Trademarked Slogan*, BOSTON GLOBE (Jul. 19, 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> [<https://perma.cc/2W4X-2BJU>].

²⁰⁹ MARK A. MCDONALD & GEORGE R. MILNE, *CASES IN SPORTS MARKETING* 296–304 (1999).

²¹⁰ 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> [<https://perma.cc/3CP5-ALG9>].

²¹¹ *Id.*

branded—as well as general—school merchandise, so both Calipari and the university benefitted.²¹² 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,”²¹³ which would plainly indicate that at least those school authorities believe a commercial attribution to the coach is legitimate.²¹⁴

Still, as with “three-peat,”²¹⁵ 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 Mariners²¹⁶ Major League Baseball team, and Jeff Gordon²¹⁷ 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.²¹⁸ 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,²¹⁹ 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.

²¹² *Id.*

²¹³ Michael Powell, *Violations by John Calipari’s Teams? Don’t Look at Him*, N.Y. TIMES (Mar. 25, 2015), <https://www.nytimes.com/2015/03/26/sports/ncbaabasketball/coach-caliparis-wonderful-life-begin-the-disclaimers.html> [<https://perma.cc/ZX3P-CW7F>].

²¹⁴ *Id.* 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, 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.

²¹⁵ See Kantorczyk, *supra* note 159.

²¹⁶ 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> [<https://perma.cc/D3FC-CQ8F>].

²¹⁷ 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> [<https://perma.cc/9MED-RVJP>].

²¹⁸ See *supra* Section III. B.

²¹⁹ 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,²²⁰ a rational response to situations such as the relatedness of products found in Aunt Jemima.²²¹ Confusion expanded from actually misleading consumers to include causing momentary confusion, even when overcome before a purchase is made.²²² “Likelihood” originally implied a probability of confusion, but some have interpreted the standard more broadly, instead imposing liability for a mere possibility of confusion.²²³

Semantic stretching deforms the meaning of “confusion” and “consumers” as well. In *Boston Professional Hockey Association, Inc. v. Dallas Cap & Emblem Manufacturing, Inc.*,²²⁴ 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.”²²⁵ 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

²²⁰ See, e.g., *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979); *Polaroid Corp. v. Polarad Elect. 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).

²²¹ See *supra* text accompanying note 37.

²²² See Jennifer E. Rothman, *Initial Interest Confusion: Standing at the Crossroads of Trademark Law*, 27 *CARDOZO L. REV.* 105 (2005).

²²³ See, e.g., *Versa Prods. Co., Inc. v. Bifold Co. Ltd.*, 50 F.3d 189, 200 (3d Cir. 1995) (The 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.); *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.”). *Versa Prods. Co.*, 50 F.3d at 200.

²²⁴ *Boston Prof’l Hockey Ass’n, Inc. v. Dallas Cap & Emblem Mfg., Inc.*, 510 F.2d 1004 (5th Cir. 1975).

²²⁵ *Id.* at 1012.

confusion that did not, in any common sense, actually exist.²²⁶ It has effectively conflated causing associative thought with confusion.

In many cases dealing with potentially real consumer confusion, courts 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 Georgia²²⁷ 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.²²⁸ As a secondary mark for further identification of official items, it also—by effect and design—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.²²⁹

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,”²³⁰ baseless cease-and-desist threats and filings often intended to broaden mark holder rights by deterring legitimate market entrees.²³¹ Some baseless trademark-based cases are less sinister, if only because their purpose is more challenging to parse. For example, Louis Vuitton²³² 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.²³³ Clearly, that flyer's “consumers” were an audience discussing the very law at hand, rendering perhaps the lowest

²²⁶ Criticized roundly, *e.g.*, *supra* note 116.

²²⁷ *Univ. of Ga. Athletic Ass'n v. Laite*, 756 F.2d 1535, 1547 (11th Cir. 1985).

²²⁸ *FAQs: Consumer - How do I know that a product is licensed and approved by an institution?*, COLLEGIATE LICENSING COMPANY (“CLC”), <http://www.clc.com/Resources/FAQs.aspx#CatLink7e6f57f5-d209-4b9f-9bd0-a631b670def0> (last visited Feb. 28, 2017) (advising customers to “look for the Officially Licensed Collegiate Product (OLCP) hologram label,” which all of the CLC's approximately 200 member institutions (colleges, universities, and affiliated organizations such as athletic conferences) mandate for the sale of their products) [<https://perma.cc/5Q7A-QJBC>].

²²⁹ *See supra* Section I. A.

²³⁰ *See* Port, *supra* note 31, at 589.

²³¹ *See* discussion of dynamic compounds *supra* Section IV.A.

²³² *See also* *Louis Vuitton Malletier v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007).

²³³ Michael Risch, *Really, Louis Vuitton? Really?*, MADISONIAN.NET (Mar. 4, 2012), <http://madisonian.net/2012/03/04/really-louis-vuitton/> [<https://perma.cc/U3RZ-GNYJ>] (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)).

likelihood of confusion conceivable.²³⁴ In critiquing this action, the law community raised arguments of 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."²³⁵ 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.²³⁶ 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.²³⁷ These two mutations stem from misplaced fealty to producer interests.

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,²³⁸ 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.²³⁹ However, structural limitations are often ignored, including consideration of effects under reader-response theory,²⁴⁰ observer effect, and

²³⁴ Charles Colman, *Louis Vuitton Sends Absurd Cease-and-Desist Letter to Penn Law*, LAW OF FASHION (Mar. 3, 2012), <http://lawoffashion.com/blog/story/03/03/2012/121> [<https://perma.cc/D8TW-EWLN>].

²³⁵ *Id.*

²³⁶ See Austin, *supra* note 80; see also *Hiram Walker & Sons, Inc. v. Penn-Maryland Corp.*, 79 F.2d 836, 839 (2d Cir. 1935) (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.'").

²³⁷ See Lemley, *supra* note 196, Rothman, *supra* note 222.

²³⁸ McGuffey, *supra* note 153.

²³⁹ See 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).

²⁴⁰ 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'

other concepts.²⁴¹ 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.²⁴² In addition to that questionable phrasing, the court accepted 10% consumer agreement with that statement as a sufficient level to find confusion. Other cases have rejected survey findings at levels of 14% to 31% confusion.²⁴³ 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.²⁴⁴ 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 courts then bar 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,²⁴⁵ 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”

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.”)

²⁴¹ Bird, *supra* note 239.

²⁴² 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.*

²⁴³ Prudential Ins. Co. v. Gibraltar Fin. Corp., 694 F.2d 1150, 1155–56 (9th Cir. 1982).

²⁴⁴ Voortman, *supra* note 139.

²⁴⁵ Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 7 (2d Cir. 1976).

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 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 consumers' 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"),²⁴⁶ 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.²⁴⁷ Congress responded by passing the Trademark Dilution Revision Act of 2006 ("TDRA").²⁴⁸ It clarified the definition of the "famous marks,"²⁴⁹ lowered the standard to a "likelihood" of dilution, and explained its two forms: tarnishment²⁵⁰ and blurring.²⁵¹ 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,²⁵² though a strong dissent criticized the other justices for accepting a "possibility" instead of true "likelihood."²⁵³ 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."²⁵⁴ 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

²⁴⁶ Pub. L. No. 104-98, § 3, 109 Stat. 985 (1996) (codified at 15 U.S.C. § 1125(c) (2006)).

²⁴⁷ *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 432-34 (2003).

²⁴⁸ Pub. L. No. 109-312, 120 Stat. 1730 (codified as amended 15 U.S.C. § 1125(c) (2006)).

²⁴⁹ 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. 1 (2017) (discussing, *inter alia*, famous marks and international trademark registration).

²⁵⁰ 15 U.S.C. § 1125(c)(2)(C) (2012).

²⁵¹ 15 U.S.C. § 1125(c)(2)(B) (2012).

²⁵² *V Secret Catalogue, Inc. v. Moseley*, 605 F.3d 382, 390 (6th Cir. 2010), *cert. denied*, 131 S. Ct. 1003 (2011).

²⁵³ *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).

²⁵⁴ *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 218 (2d Cir. 1999).

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.²⁵⁵ 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.²⁵⁶ While Coach, Inc. was established in 1941,²⁵⁷ the word pre-dated the brand with established meanings in other contexts dating back to the 1500s.²⁵⁸ 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.²⁵⁹ 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.²⁶⁰ 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 International Service Assn. v. JSL Corp.*,²⁶¹ the court denied a multilingual education service's defense that it was using the common meanings of the word "visa,"²⁶² stating that the service had instead created a

²⁵⁵ *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).

²⁵⁶ See *supra*, Section I. C. Spectrum of Distinctiveness.

²⁵⁷ *Company Profile*, COACH, <http://www.coach.com/company-information.html> [<https://web.archive.org/web/20160316143537/www.coach.com/company-information.html>].

²⁵⁸ *Coach*, ONLINE ETYMOLOGY DICTIONARY, <http://www.etymonline.com/index.php?term=coach> [<https://perma.cc/HPR2-2D4A>].

²⁵⁹ 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.'").

²⁶⁰ Emerson & Willis, *supra* note 249, at 13–14 ("A mark is considered well-known or famous if it is widely recognized by the general consuming public of the United States as a designation of the source of goods or services of the mark's owner.").

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

²⁶² *Id.* at 1089.

“novel meaning” wrongfully²⁶³ competing with Visa credit cards, regardless of “allusions to the dictionary definition.” The court addressed the senior mark’s interaction with dictionary definition: “The 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 comprehending multiple meanings without issue. 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.²⁶⁴ This is when a chronologically senior mark user claims that a subsequent junior mark usage is so extensive that it erodes the senior mark’s value, causing consumers to mistakenly believe the more common junior mark is the original owner.²⁶⁵ In response this “takeover,” the junior mark holders respond with a defense by way of the mark’s capability for dual meanings.

An illuminating example comes from the case of *Illinois High School Association v. GTE Vantage Inc.*²⁶⁶ The phrase “March Madness” can be traced back to a basketball-themed volume of essays and poems by Henry Porter, a pioneer of the sport.²⁶⁷ The Illinois High School Association dubbed

²⁶³ Eric Goldman, *Puzzling 9th Circuit Dilution Opinion over eVisa.com—Visa v. JSL*, TECH. & MARKETING L. BLOG (Jul. 6, 2010), http://blog.ericgoldman.org/archives/2010/07/puzzling_9th_ci.htm [<https://perma.cc/EER5-3369>] (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.”).

²⁶⁴ Anthony L. Fletcher, *The Curious Doctrine of Reverse Confusion—Getting It Right in Reverse*, 95 TRADEMARK REP. 1273 (2005).

²⁶⁵ J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:10 (4th ed. 2004).

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

²⁶⁷ 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> [<https://perma.cc/5TGZ-GHZH>] (Porter also connected “midnight madness” to the sport, and designed fan-shaped backboards).

its playoff basketball tournament “March Madness” in 1939 and officially merchandised it as such in 1973.²⁶⁸ Nine years later, CBS anchor Brent Musburger first identified the NCAA college basketball tournament as “March Madness” on air.²⁶⁹ A decade later, CBS registered the mark in relation to the televised NCAA tournament.²⁷⁰ The power of broadcasting in appropriating the word’s meaning was acknowledged by the Seventh Circuit:

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 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.²⁷¹

The First Amendment does protect the press’ right to speak a trademarked word or phrase, even if it does so in a transformative manner.²⁷² 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.²⁷³ 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”²⁷⁴ 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 the court acknowledges would be unenforceable.²⁷⁵

²⁶⁸ *March Madness History*, ILLINOIS HIGH SCHOOL ASSOCIATION, <http://www.ihsa.org/SportsActivities/MarchMadnessExperience/MarchMadnessHistory.aspx> (last accessed Sept. 15, 2015) [<https://perma.cc/9KGA-956Z>]

²⁶⁹ 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 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.

²⁷⁰ *Illinois High School Ass’n*, 99 F.3d at 245.

²⁷¹ *Id.* at 244.

²⁷² *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 31 (1st Cir. 1987).

²⁷³ *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992).

²⁷⁴ *Illinois High School Ass’n*, 99 F.3d at 244.

²⁷⁵ *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

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, genericized terms cannot be resurrected,²⁷⁶ regardless of preventative conduct taken.²⁷⁷ 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.”²⁷⁸ The impulse here is to limit trademark rights, which ironically has opened the door for the NCAA to proceed with its use and notably aggressive defense of “March Madness” as their mark.²⁷⁹

In another basketball case, *Dream Team Collectibles, Inc. v. NBA Properties Inc.*,²⁸⁰ the mark “Dream Team” was first utilized on sports trading cards, and the NBA subsequently began using the same term in reference to a 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

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?

²⁷⁶ *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).

²⁷⁷ *W.T. Rogers Co. v. Keene*, 778 F.2d 334, 347 (7th Cir. 1985).

²⁷⁸ *Illinois High School Ass’n*, 99 F.3d at 244.

²⁷⁹ 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*, CHI. SUN-TIMES (Mar. 21, 2015, 9:00 AM), <https://chicago.suntimes.com/sports/chicago-lawyer-tracks-down-march-madness-trademark-violators/> [https://perma.cc/A8S5-EL85]; 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> [https://perma.cc/TJP2-UAKA]; 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> [https://perma.cc/9M2W-KFME]; 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> [https://perma.cc/8CMT-3374]; Shaun Powell, *The Father of Midnight Madness*, NCAA (Oct. 14, 2011 10:06 AM), <http://www.ncaa.com/news/basketball-men/article/2011-10-01/father-midnight-madness> [https://perma.cc/Q2DX-6W2Q] (“He only has one regret when he looks in the rearview 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.’”).

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

in violation the Lanham Act.²⁸¹ 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.²⁸² This illustrates the possibility of lopsided protection more established mark holders can perpetuate, even as junior mark users. 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

I. 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,²⁸³ the PTO should still scrutinize applications that lean in that direction. Instead, the PTO, in some instances, effectively encourages bad faith applications. *Damn I’m Good*²⁸⁴ 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 displayed²⁸⁵ slogan.²⁸⁶ Without altering or eliminating these primary functions, but with the simple addition of a second, conceivably source-indicating format²⁸⁷ 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.²⁸⁸ The PTO gives credit to usages that “may be likely to create the commercial impression of a trademark,”²⁸⁹ but does not appear to balance this against uses that leave distinctly non-mark impressions. While secondary meaning

²⁸¹ *Id.* at 1403.

²⁸² *Id.* at 1411.

²⁸³ Federal Trade Commission Improvements Act of 1980, *supra* note 166.

²⁸⁴ *Damn I’m Good, Inc., v. Sakowitz, Inc.*, 514 F. Supp. 1357 (S.D.N.Y. 1981).

²⁸⁵ T.M.E.P. § 1202.03(a) (2007) (stating a prominently featured word may be perceived as ornamental).

²⁸⁶ T.M.E.P. § 1202.03(f)(i) (2007) (stating a prominently depicted slogan may be perceived as expressive rather than source-indicatory).

²⁸⁷ T.M.E.P. § 1202.03(a) (2007) (describing subtler word usage as more evocative of trademarks’ source-indicatory impression).

²⁸⁸ *Damn I’m Good, Inc.*, 514 F. Supp. at 1361.

²⁸⁹ T.M.E.P. § 1202.03(a) (2007).

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 some minimal standards as evidence that a would-be mark primarily functions as such before approval.²⁹⁰ Absence of or inconsistency in these standards allows marks to slip through the cracks, interfering with the operation of language in markets and beyond.

Take for example, the term “frugalista,” a finalist for New Oxford American Dictionary’s word of the year in 2008.²⁹¹ Eight days after that announcement, the standard character mark was registered²⁹² to a blogger who quickly set to work petitioning the dozens²⁹³ of other bloggers, who were 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 authors or topics of all of the blogs at hand. Some rather abstract modern products, such as blogs, may be challenging to conceptualize within traditional distinctiveness analysis. In particular, identifying the requisite “mental leap” that distinguishes permissible suggestive marks from generally unacceptable descriptive marks may prove tough. But in this example 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.²⁹⁴ It was not the first blog to do so, and in fact only launched after the term had risen to fame.

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

²⁹⁰ Suggested *infra* Section V. D. Making the Calls.

²⁹¹ *Oxford Word of the Year 2008: Hypermiling*, OXFORD UNIVERSITY PRESS BLOG (Nov. 10, 2008), <http://blog.oup.com/2008/11/hypermiling/> [<https://perma.cc/P3DA-M3CH>] (“A person who leads a frugal lifestyle, but stays fashionable and healthy by swapping clothes, buying second-hand, growing own produce, etc.”).

²⁹² FRUGALISTA, Registration No. 3532912.

²⁹³ 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> [<https://perma.cc/9FUD-XBQT>].

²⁹⁴ This could be addressed by remedy of estoppel proposed *infra* Section V. A. Eligibility – Phantom Marks.

instability.²⁹⁵ For example, that a mark may share a common word with many others, such as “cola” in both Pepsi-Cola²⁹⁶ and Coca-Cola,²⁹⁷ is acceptable given that consumers will look to the unique mark aspects for identity instead of the common portion.²⁹⁸ In this vein, the word “Jesus”²⁹⁹ was registered to a clothing company after an initial denial due to prior marks³⁰⁰ including the word.³⁰¹ 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.”³⁰²

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 S.R.L. by the time proof of the mark’s commercial use was required,³⁰³ 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.³⁰⁴ In a brief opposing another trademark registration, “Jesus Surfed,” the “Jesus Jeans” owner claims³⁰⁵ to have successfully enjoined over sixteen other uses, including “Jesus” on clothing. Those would-be partial uses had the distinguishing elements that the

²⁹⁵ 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.

²⁹⁶ PEPSI-COLA, Registration No. 0824151.

²⁹⁷ COCA-COLA, Registration No. 1752201.

²⁹⁸ 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.”).

²⁹⁹ 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 enjoinder of “conjured mental association” sans actual confusion *supra* note 254, 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, A. Anti-Competitive Incentives.

³⁰⁰ 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.”).

³⁰¹ U.S. Trademark Application Serial No. 75866210 (filed Dec. 7, 1999).

³⁰² Basic Trademark S.A., Supplemental Response to Office Action, Serial No. 75866210 (Aug. 13, 2004).

³⁰³ Lanham Act, 15 U.S.C. § 1058(a) (2006) (detailing a five-year window after registration).

³⁰⁴ 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).

³⁰⁵ 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>.

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.³⁰⁶ It is also not independent of the fact that Jesus' desirability and flexibility as a mark is derived from cultural goodwill.³⁰⁷ The consumers' right to wear articles portraying the term is a protectable matter of their free speech. Alternatively, if merchandising³⁰⁸ 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 may conceivably constitute primary function of the mark in the eyes of consumers – and in context both would be illegitimate to the purpose of trademarks. Recently, the mark, “What Would Jesus Do?”³⁰⁹—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 past³¹⁰ 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.³¹¹ Sloganeering has blossomed in trademark law,³¹² 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.³¹³ 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

³⁰⁶ Remedy proposed *infra* Section V. B. Eye on the Ball.

³⁰⁷ *Supra* Section II. B. Inherent Goodwill.

³⁰⁸ Grimes & Battersby, *supra* note 41.

³⁰⁹ WHAT WOULD JESUS DO?, Registration No. 3748123.

³¹⁰ Instances of this phrase can be found as early as 1896. *See, e.g.*, CHARLES MONROE SHELDON, IN HIS STEPS (1897).

³¹¹ 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> [<https://perma.cc/9ME6-QRWX>] (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).

³¹² *See* Burgunder, *supra* note 85, at 80.

³¹³ *See* Jerome Gilson & Anne Gilson LaLonde, *Cinnamon Buns, Marching Ducks and Cherry-Scented Racecar Exhaust: Protecting Nontraditional Trademarks*, 95 TRADEMARK REP. 773 (2005).

consistently imbued with meaning, may be a protectable mark.³¹⁴ The opinion referenced well-established source-indicators, including the shape of a Coca-Cola bottle and the sound of the National Broadcasting Company's three chimes.³¹⁵ 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.³¹⁶

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 system³¹⁷ 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 black³¹⁸ being a practically useful color for consumers to standardize or minimize machinery, as in one case dealing with a boat motor.³¹⁹ The evolution of color marks has been closely watched and well-reasoned.³²⁰

Specificity in defining other non-traditional marks may pose a challenge.³²¹ Sound-marks are featured on the USPTO website in MP3 format with written descriptions.³²² Some descriptions include words and the particular identity of a perceived speaker,³²³ others state technical details

³¹⁴ *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).

³¹⁵ *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. *Id.* (citing *In re Clarke*, 17U. S. P. Q. 2d 1238, 1240 (T.T.A.B. 1990)).

³¹⁶ *In re N.V. Organon*, 79 U.S.P.Q.2d 1639 (T.T.A.B. 2006).

³¹⁷ See PANTONE, <http://www.pantone.com/pages/pantone/index.aspx> [https://perma.cc/BAF5-GA84].

³¹⁸ Black was also granted aesthetic functionality for its appropriateness for Halloween and bereavement floral arrangements, *supra* note 142.

³¹⁹ *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527 (Fed. Cir. 1994).

³²⁰ See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995) (discussed *supra* notes 314–315 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).

³²¹ Amanda E. Compton, *Acquiring a Flavor For Trademarks: There's No Common Taste in the World*, 8 NW. J. TECH. & INTELL. PROP. 340 (2010), available at <http://scholarly.law.northwestern.edu/njtip/vol8/iss3/1>.

³²² See, e.g., *Trademark "Sound Mark" Examples*, UNITED STATES TRADEMARK AND PATENT OFFICE, <http://www.uspto.gov/trademark/soundmarks/trademark-sound-mark-examples>.

³²³ *Id.* (76280750 Twentieth Century Fox—entertainment—"D'OH" (Homer Simpson character), playable at <http://www.uspto.gov/trademarks/soundmarks/76163189.mp3> for Registration No. 3411881).

such as “B flat clarinet,”³²⁴ and a few may be simply descriptive, for example, “roaring lion.”³²⁵ 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.³²⁶ 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.³²⁷

The issue of faithfully capturing consumer perception³²⁸ will only face more trials in determining functionality for new pairs of sensory marks and diverse product types.³²⁹ For instance, while courts have deemed a medicine’s taste to be an untrademarkable functional aspect,³³⁰ the TTAB granted a mark for scented sewing thread.³³¹ 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,³³² and scented candles might have initially been synonymous with that one innovative candle maker as a source.³³³

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

³²⁴ *Id.* (76575743 Infone—Concierge arrangements—B flat clarinet playable at <http://www.uspto.gov/trademarks/soundmarks/76575743.mp3> for Registration No. 3014502).

³²⁵ *Id.* (73553567 MGM – Entertainment – Roaring Lion playable at <http://www.uspto.gov/trademarks/soundmarks/73553567.mp3> for Registration No. 1395550).

³²⁶ Compton, *supra* note 321, at 354.

³²⁷ *Id.* at 357.

³²⁸ *Supra*, Section III. Primary Purpose.

³²⁹ See Jay M. Burgett, *Hmm, What’s That Smell? Scent Trademarks—A United States Perspective*, 64 INTA BULL. 5 (2009).

³³⁰ *Supra* note 316. Not all medicines have this function; even otherwise identical products will vary in taste or lack thereof.

³³¹ *In re Celia, d/b/a Clarke’s Osewez*, 17 U.S.P.Q.2d 1238 (TTAB 1990).

³³² *Id.* The board considered that the applicants had added scent as a feature, that it was not naturally occurring, to be in their favor.

³³³ *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.

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 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, by avoiding a determination or prediction 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,³³⁴ the specific “floral scent” of sewing thread was found to be acceptably arbitrary.³³⁵ 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.³³⁶

Determining what is “normal” is left to the judgment of the PTO and TTAB. At some point in time, scented candles became normal.³³⁷ 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

³³⁴ See Leib, *supra* note 145.

³³⁵ 17 U.S.P.Q.2d at 1239.

³³⁶ WORLD INTELLECTUAL PROP. ORG., STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS (March 30, 2007), http://www.wipo.int/edocs/mdocs/sct/en/sct_17/sct_17_3.pdf [<https://perma.cc/TTG2-KW3J>] (the United States is one among 73 member states).

³³⁷ *Facts & Figures*, NATIONAL CANDLE ASS.N, <http://candles.org/facts-figures-2/> [<http://perma.cc/9886-LWJM>] (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.”).

benefits other scents may carry across different products. Vanilla's commonality among food products does not directly explain its present role perfuming pencils, erasers, phone cases, teddy bears, trash bags, valve oil, drawer-liners, or pacifiers.³³⁸ 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 some inherently desirable nature it has,³³⁹ which should be protected from the limitations of trademarking.

Non-traditional marks have also developed for buildings.³⁴⁰ Some building designs have been considered distinctive enough to be granted protection against structural mimicry,³⁴¹ and courts have gone both ways on protecting buildings' depiction through other media.³⁴² 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 trademark³⁴³ of the Chrysler Building spire.³⁴⁴ The New York Times reported on the shop

³³⁸ See <http://www.amazon.com/Original-Smencils-Gourmet-Scented-Pencils/dp/B0073RLMX2>; [<http://perma.cc/6XLK-7LL6>]; <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/B005Y7QR70> [<http://perma.cc/R3M8-KBA8>]; http://scentdeals.com/index.php?main_page=product_info&products_id=1871 [<http://perma.cc/GN5C-TDVW>]; 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://perma.cc/Y3GJ-ULLA>]; <http://www.zajamusic.com/oil.htm> [<http://perma.cc/6K9N-6C87>]; <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> [<http://perma.cc/RLA8-M9Y3>].

³³⁹ See *supra* Section II.B. Inherent Goodwill; Hughes, *supra* note 14.

³⁴⁰ 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).

³⁴¹ *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).

³⁴² *Rock and Roll Hall of Fame v. Gentile Prods.*, 134 F.3d 749, 755 (6th Cir. 1998) (overturning district court ruling for the Hall of Fame as an "accessible, public, well-known landmark").

³⁴³ Registration No. 1126888.

³⁴⁴ 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> [<http://perma.cc/QZ68-VQ3J>].

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. Leaving off the Chrysler Building would be like leaving off the World Trade Center."³⁴⁵ 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."³⁴⁶ 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—a salient example of culturally created meaning which one does not attribute to the Port Authority.³⁴⁷ 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.*³⁴⁸ The U.S. Court of Appeals for the Eleventh Circuit found that inclusion of the trademarked Alabama uniforms was artistically relevant to portraying famous school football moments,³⁴⁹ and that artist Daniel Moore's First Amendment right to capture that moment overrode the need to even consider possible consumer confusion (so long as it was not explicitly misleading).³⁵⁰ 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.³⁵¹ Moore's high-quality paintings were protected, even

³⁴⁵ *Id.*

³⁴⁶ 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).

³⁴⁷ As does the "Let's Roll," examined *supra* note 93. 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.

³⁴⁸ *Univ. of Ala. Bd. of Tr. v. New Life Art, Inc.*, 683 F.3d 1266, 1276 (11th Cir. 2012).

³⁴⁹ *Id.* at 24–25.

³⁵⁰ *Id.* at 25.

³⁵¹ 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 [<https://perma.cc/2F7M-QXEF>]; The University of Alabama also owns the standard character word mark, "Alabama," even though it is a state name (*see supra* note 42 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 137).

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 University of Alabama football 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 investment³⁵² 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 in creating the "meaning" of a school.³⁵³ While fans may be happy to see third parties pay for the use of marks, institutions that turn on 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.³⁵⁴ If the primary quality implied by a school's trademark, to relevant buyers, were student comradery, students might logically be the "controllers" of that quality. Very little has been said about pinpointing a conveyed quality of a mark, 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 institution 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.³⁵⁵ Then, a parody, "Barack, Chalk, Jayhawk" was printed on shirts by a student group leading up to the presidential election. Initially the school granted permission, but later revoked it (despite the usage touching upon parody, political speech's high First Amendment regard, as well as non-commercial, free distribution of the shirts).³⁵⁶ 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

³⁵² See Section II. B. Inherent Goodwill.

³⁵³ 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 105, 116, 134, 181, 227 & 351, and accompanying text.

³⁵⁴ *Supra* note 178.

³⁵⁵ *Univ. of Kan. v. Sinks*, 644 F. Supp. 2d 1287, 1296 (D. Kan. 2008).

³⁵⁶ *Obama T-shirt Concerns KU*, TOPEKA CAPITAL-JOURNAL, July 22, 2008, at 1.

the field[.] One person shouldn't be able to be a Longhorn more than another."³⁵⁷

3. *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.³⁵⁸ 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?³⁵⁹ 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 that disadvantages 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.³⁶⁰ The amount of 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-confusion³⁶¹ should be more common and perhaps easier to prove. However, if more senior, but smaller

³⁵⁷ 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>.

³⁵⁸ E.g., "Dream Team" owned by IHSA. *Supra* note 274.

³⁵⁹ *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 . . .").

³⁶⁰ 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 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).

³⁶¹ See *supra* notes 264–265 and accompanying text.

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 commercially and expressively 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.

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.”³⁶² 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”³⁶³ 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 trademarked blue Boise State turf.³⁶⁴ Aside from the numerous functional advantages, the school effectively mandates naked licensing by compelling “users” to disclaim their lack of

³⁶² *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).

³⁶³ See *supra* Section II. A. Changing Nature.

³⁶⁴ Gallagher, *supra* note 103.

association to Boise State.³⁶⁵ 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.’”³⁶⁶ These licensing agreements are, in fact, intentionally bereft of trademark meaning. However, it is difficult to hold the school blameworthy, as it may well be responding rationally to the present landscape rewarding and even demanding assiduous mark protectionism.

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, 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.”³⁶⁷ However, Boise State has licensed turfs in red, and it claims to the public and the press the rights to any non-green turf.³⁶⁸ 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.³⁶⁹ It is hard to imagine these schools could pose much of a threat to Boise State’s telecasting prospects in global communications networks, either.³⁷⁰

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 a greater incorporation of estoppel into trademark law.³⁷¹ 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

³⁶⁵ 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.”).

³⁶⁶ *Id.*

³⁶⁷ Registration No. 3707623.

³⁶⁸ Gallagher, *supra* note 103.

³⁶⁹ Cripe, *supra* note 365.

³⁷⁰ *Id.*

³⁷¹ 15 U.S.C. §1115(b)(9) mentions equitable principles including estoppel as applying to the affirmative defenses against an infringement suit. The doctrine has primarily been enforced against mark holders who have acquiesced to would-be infringers, however, not been applied to cabin the mark to its registration’s bounds.

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 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,³⁷² 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.³⁷³ 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.³⁷⁴

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 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 could have great normative impact throughout the body of law. In *Freedom Card Inc. v. JP Morgan Chase & Co.*, the Third Circuit left open this possibility, combining the statements made in a mark’s registration

³⁷² *Probable Cause*, BLACK’S LAW DICTIONARY (10th ed. 2014) (noting how the standard has been applied at the outset of tort cases).

³⁷³ *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).

³⁷⁴ Discussion of the fleeting, rare, and unpredictable time window of value, and free rider conundrum of petitioning for genericism. Kantorzcyk, *supra* note 159.

with evidence that plaintiff presented of a term's widespread popularity as dispositive of an alleged infringer creating consumer confusion.³⁷⁵ This is a rational avenue for cabining undisciplined expansionism, similar to the well-established patent prosecution estoppel,³⁷⁶ though far less developed in trademark jurisprudence.

B. Eye on the Ball

A general lack of consideration is granted to the nature of marks themselves, which allows 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. For example, the National Pork Board's (NPB's) right to the term, "the other white meat,"³⁷⁷ invokes a comparison to "the white meat" of chicken or fish.³⁷⁸ The NPB objected to similar analogies by several other meat producers. In 1997, after bringing suit against the Maine Lobster Promotional Council, the NPB settled out of court for the firm's use of the slogan, "The Ultimate White Meat."³⁷⁹ Cease-and-desist 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,"³⁸⁰ and the other, a humorous bumper sticker reading, "Muskrat: The new off-white meat."³⁸¹

³⁷⁵ 432 F.3d 463, 476 (3d Cir. 2005) ("Whether we view . . . prior representations about the commercial viability of marks containing the word 'freedom' as judicial estoppel, an admission, waiver, or simply hoisting [the mark] by its own petard . . ."); *see also* Atl. Nat'l Bank v. Atl. Southern Bank, 2010 U.S. Dist. LEXIS 133665, 13-14 (S.D. Ga. 2010) (looking to admissions of mark limitations in registration).

³⁷⁶ *See* T. Whitley Chandler, *Prosecution History Estoppel, the Doctrine of Equivalents, and the Scope of Patents*, 13 HARV. J. L. & TECH. 465 (2001).

³⁷⁷ THE OTHER WHITE MEAT, Registration No. 1486548.

³⁷⁸ While the National Pork Board did not clarify which meat pork was being compared to, the United States Department of Agriculture (USDA) can offer guidance. USDA classifies red and white meats based on 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/ffsis/topics/food-safety-education/get-answers/food-safety-fact-sheets/meat-preparation/fresh-pork-from-farm-to-table/CT_Index [<https://perma.cc/XA4D-9T4M>] ("Pork is classified a 'red' meat because it contains more myoglobin than chicken or fish.").

³⁷⁹ *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-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").

³⁸⁰ 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 [<https://perma.cc/69BE-JY8N>].

³⁸¹ *The National Pork Board Beats Up on Muskrats*, IRREGULAR TIMES, <http://www.irregulartimes.com/otherwhitemeat.html> [<https://perma.cc/5ECD-ZBG8>].

The NPB's mark was likely initially suggestive, with the addition of "other" distinguishing it from "white meat," a merely descriptive phrase.³⁸² Secondary meaning was established, and the mark is now inherently distinctive. 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 to "new." There is no reason to believe the distinctive mark's meaning destroys or alters "white meat['s]" merely descriptive nature or negates the right of others to access it.³⁸³ 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 the Maine Lobster Promotional Council felt the subsequent settlement was a victory.³⁸⁴ 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 2010.³⁸⁵

Famousness controversially elevates a mark above concerns of consumer confusion, an element that was likely not created by these subsequent somewhat similar marks. The National Pork Council provided convincing evidence of fame through extensive commercialization of its mark and recognition of its mark in the public mind.³⁸⁶ Responses to a survey asking "Thinking about the slogan you just heard [THE OTHER RED MEAT], do any other advertising slogans or phrases come to mind?"³⁸⁷

³⁸² As a term of classification used by government regulators *see supra* note 378, 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.").

³⁸³ *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).

³⁸⁴ 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/> [<https://perma.cc/W42T-M9PM>] ("[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.'")

³⁸⁵ *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 *see supra* note 384, 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.").

³⁸⁶ *Id.* at 1490.

³⁸⁷ *Id.*

supported a claim of dilution.³⁸⁸ In response to the survey, the salmon applicant charged that this query improperly suggested another slogan *should* come to mind, but the court deemed the survey was properly phrased for the “precise question” the survey intended to answer.³⁸⁹

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 dominate or should dominate all other potential meanings prioritizes those famous marks automatically. Establishing a mark’s primary purpose in the consumer’s mind³⁹⁰ is necessary to both consumer-protection and information-transmission trademark justifications. These justifications are abandoned when investigation of the conception is left incomplete or is distorted by a purely commercial point of view.³⁹¹

Where a court deems the marks to be highly similar, its own reading of facts could be interpreted to support the alternate conclusion if consumer interpretation was prioritized. Colors of meat being of “precious few from which to choose” buttresses the mutually exclusive reality in this particular case; 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, despite the fact that each color implies distinctly different nutritional properties. Thus, 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 analogy within each category is not necessarily a common message of marks, but it is a valuable tool of language and communication, which is being foreclosed.³⁹²

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, a reason is not provided for why a mark’s behavior is not considered in aggregate by the TTAB. An overbroad mark can push forward unnoticed—which is not in the best interest of the interconnected trademark system. 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

³⁸⁸ *Id.* at 1497–98 (interpreting the fact that 35% of respondents thought of the other slogan indicates a high degree of likely association).

³⁸⁹ *Id.* at 1490–91.

³⁹⁰ See *supra* Section III. A. Of the Mark.

³⁹¹ See Brown, *supra* note 6.

³⁹² See *supra* note 116.

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 into its argument for there being a mark, subsequent marks mentioning Jesus would have been allowed entry into the "robust field of Jesus marks already peacefully coexisting."³⁹³ However, a more realistic consideration of several such marks might find their purposes to be non-trademark expression. Communication is a valid function of many goods.³⁹⁴ Owners can and should be allowed to construct a highly protected, famous trademark by imbuing meaning persistently. It is hard to understand how these valid acknowledgements can justifiably be 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 patent and copyright law,³⁹⁵ 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,³⁹⁶ objectively egregious marks such as "three-peat"³⁹⁷ will no longer "refuse to lose."³⁹⁸ Further balance will be achieved whenever the doctrinal underpinning of protecting consumer expectations is applied more comprehensively to capture their perceptions, even when they lack a brand-enhancing tinge. This is possible in many avenues, including expecting higher standards of consumer surveys, requiring 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.

³⁹³ *Supra* note 302.

³⁹⁴ See *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062 (9th Cir. 2006).

³⁹⁵ World Intell *supra* note 9 and accompanying text.

³⁹⁶ *Supra* note 166.

³⁹⁷ Kantorczyk, *supra* note 159.

³⁹⁸ *Supra* note 206.

As established, there is no shortage of words with deeply embedded meaning,³⁹⁹ occasionally with inherent and cultural goodwill and inferences more significant than their standard dictionary definition.⁴⁰⁰ This is not to say that all marks must be culturally bland. Consumer segmentation is no mystery to brands heavily involved in trademark law.⁴⁰¹ *Texas Tech Univ. v. Spiegelberg* found robust meaning in a college town as cause for more stringent trademark protection locally.⁴⁰² 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 is 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 deep in Louisiana. Depictions of city skylines⁴⁰³ and football plays⁴⁰⁴ 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.⁴⁰⁵ The PTO, through its guidance in the Trademark Manual of Examining Procedure,⁴⁰⁶ draws upon common consumer interpretations; essentially, these interpretations are cognitive functions,⁴⁰⁷ 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,⁴⁰⁸ or the absence of any trademark or meaning thereof from the color of a vase of flowers,⁴⁰⁹ many other psychological reactions should be preserved for their functionality.

³⁹⁹ See, e.g., Sections II. B. Inherent Goodwill; II. C. Idioms and Atmospheric.

⁴⁰⁰ See, e.g., *supra* notes 50-52 (discussing “who dat” in historical and colloquial cultural depths as opposed to any formal dictionary entries).

⁴⁰¹ See Desai, *supra* note 114.

⁴⁰² 461 F. Supp. 2d 510, 524 n.2 (N.D. Tex. 2006) (“This is so because trademark rights are territorial in nature [quoting McCarthy, *supra* note 265, 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.”).

⁴⁰³ Dunlap, *supra* note 344.

⁴⁰⁴ See *New Life Art*, 683 F.3d at 1276.

⁴⁰⁵ The T.M.E.P., *supra* note 24, offers guidelines for a common perception of different mark depictions. *Supra* notes 285–287.

⁴⁰⁶ The T.M.E.P., *supra* note 24.

⁴⁰⁷ See Hughes, *supra* note 14.

⁴⁰⁸ *Supra* note 287 (T.M.E.P. acknowledging connotation of mark placement to consumer).

⁴⁰⁹ *Supra* note 142.

Commitment to consumer perceptions would follow Vanessa Pierce's suggestion to integrate consideration of functionality, that is, realism, when determining genus and, therefore, genericity.⁴¹⁰ Likewise, the need for considering actual consumers, as well as a precise articulation of quality control detailed in McGuffey's *Boybands*,⁴¹¹ would serve the doctrine well by realigning theory in conformity with practical considerations. Heightened scrutiny in granting marks that touch these bounds of inherent meaning 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.⁴¹² 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 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" of existing usages of marks in applications for registration. While Section 13 of the Lanham Act allows for opposition to registration by any person who believes they would be damaged by it,⁴¹³ as this article has illustrated, marks have been tending to expand on multiple fronts, not all of which are obvious from their registration. Putting the onus on the party receiving the property right of a mark to explain exactly what bounds it claims, within reason, seems like a rational allocation facilitating a functioning system.

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

⁴¹⁰ See Pierce, *supra* note 25.

⁴¹¹ See, e.g., McGuffey, *supra* note 153.

⁴¹² See, e.g., "frugalista," *supra* notes 291-293.

⁴¹³ 15 U.S.C. §1063.

Airlines, both conceivably famous, strong marks, have likely addressed their nominal overlap, but could have conceivably come to an impasse.⁴¹⁴ If, instead, a survey of similar marks currently being used in substantial commerce 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 briefly to lend a small level of credence to the mark's viability. Perhaps *frugalista*⁴¹⁵ 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.⁴¹⁶ One page of Google results would have been dominated by the unrelated publicity "Let's Roll" was imbued with at the time of application.⁴¹⁷ Whether an Internet search divulges a long history of "derby pie,"⁴¹⁸ several enthusiastic, different user groups convey a mantra's significance,⁴¹⁹ or a consumer survey answers "who dat" with "New Orleans,"⁴²⁰ 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."⁴²¹

As the range of marks available for registration and their commercial applications expand, serious efforts to standardize them should go beyond broadly worded descriptions. Why not, for example, make the Pantone number⁴²² mandatory for colors to be deemed susceptible to distinction?

⁴¹⁴ 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.

⁴¹⁵ United States Patent and Trademark Office, *supra* note 292.

⁴¹⁶ 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, 195–208 (2010).

⁴¹⁷ Bleicher, *supra* note 93 at 1874.

⁴¹⁸ Kern's Kitchen, 669 F. Supp. at 790 (assuming the search results outweigh the rejected "anecdotal" offerings).

⁴¹⁹ Kantorczyk, *supra* note 159 at 207–08.

⁴²⁰ Davidson, *supra* note 52.

⁴²¹ Bilton, *supra* note 380.

⁴²² Pantone, *supra* note 317 and accompanying text.

CONCLUSION

Trademarks are simply not what they used to be.⁴²³ 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, expressive uses, 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—who's 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 guarantees of dominance, and should meet a high burden to do so. With great power comes great responsibilityTM.⁴²⁴

⁴²³ See generally Thomas D. Drescher, *The Transformation and Evolution of Trademarks—From Signals to Symbols to Myth*, 82 TRADEMARK REP. 301 (1992).

⁴²⁴ WITH GREAT POWER COMES GREAT RESPONSIBILITY, Registration No. 85365090.