

1999

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Recommended Citation

Joseph E. Washington, *The Impact of Public and Media Use on Trademark Rights: An Analysis of Illinois High School Ass'n v. GTE Vantage Inc. and "Dual-Use" Terms*, 48 Cath. U. L. Rev. 605 (1999).

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THE IMPACT OF PUBLIC AND MEDIA USE ON TRADEMARK RIGHTS: AN ANALYSIS OF *ILLINOIS HIGH SCHOOL ASS'N v. GTE VANTAGE INC.* AND "DUAL-USE" TERMS

Joseph E. Washington[†]

I. INTRODUCTION

Trademark owners must be cautious when dealing with public and media use of their trademarks.¹ The more popular a trademark becomes, the more often individuals use it in ordinary discourse.² While the popularity of a trademark is generally positive for a trademark owner,³

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1. See *infra* Parts V.C.1 to V.C.3 (discussing trademark owner concerns with public and media use of their trademarks); see also 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:28, at 12-67 (West Group 4th ed. 1998) (1996) (discussing the difficulties in policing public and media use of trademarks).

2. See 5 MCCARTHY, *supra* note 1, § 31:146, at 31-213 (stating that "[t]rademarks form an important part of the public dialog on economic and social issues"); see also Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 397-98 (1990) (describing trademarks as an emerging "lingua franca"). For instance, through public discourse, a new dictionary meaning may develop in a word or phrase apart from its meaning as a trademark. See *Lucasfilm Ltd. v. High Frontier*, 622 F. Supp. 931, 935 (D.D.C. 1985) (refusing to enjoin public interest groups from referring to the Strategic Defense Initiative as "Star Wars" because a new meaning had attached to the term outside of its trademark meaning); 1 MCCARTHY, *supra* note 1, § 3:2, at 3-4 (discussing *Lucasfilm* and the changing meaning of words). For example, the trademark "SPAM" for the processed lunch meat manufactured by Hormel Foods Corp., has taken on a new meaning in ordinary discourse as a term referring to unsolicited or "junk" electronic mail. See *Hormel Objects to Cyber Promotions' Use of 'SPAM' Mark*, 1997 COMPUTER & ONLINE INDUSTRY LITIG. REP., 24,432, 24,432.

3. See 1 MCCARTHY, *supra* note 1, § 3:12, at 3-25 (noting that trademarks are a prime advertising tool which generate increased sales). Now, trademarks are often commodities in and of themselves. See Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 961 (1993) (describing how trademarks are often as valuable as the products to which they are attached). Merchandising and character licensing has become big business, as trademark owners often license their trademarks for use on different products. See GREGORY J. BATTERSBY & CHARLES W. GRIMES, *THE LAW OF MERCHANDISE AND CHARACTER LICENSING* § 1.02 (1998) (discussing, for example, how the recreational vehicle manufacturer Winnebago Industries has licensed its trademark "Winnebago" for use on sleeping bags, tents, and other outdoor gear in order to expand its sales base). It is not uncommon to see items such as t-shirts and baseball caps bearing famous trademarks. See Kozinski, *supra*, at 961-62 (citing as an example beer trademarks used on t-shirts). Some

the frequent use of its trademark by the media or by individuals in public discourse can influence how others interpret a particular trademark.⁴ For example, if the public begins to use a trademark to identify a particular type of product and not as the brand name, the mark will become the generic name of that product.⁵ Generic names, however, will not be protected as trademarks.⁶

The primary purpose of a trademark is to identify the source of the goods to which the mark is attached.⁷ If for some reason the trademark loses its ability to point to a particular source, it will cease to function as a trademark; as a result, the courts will label it a generic term and will not protect it.⁸ Therefore, trademark owners want their mark to act as a psychological symbol pointing to a particular source of the goods or services.⁹

people may wear these items in order to express their brand loyalties, while others wear these items to make a statement about themselves. See Dreyfuss, *supra* note 2, at 402 (discussing the “surplus value” of a trademark apart from its value as a source identifier); Malla Pollack, *Your Image Is My Image: When Advertising Dedicates Trademarks to the Public Domain—With an Example from the Trademark Counterfeiting Act of 1984*, 14 CARDOZO L. REV. 1391, 1397 (1993) (discussing trademarks as status symbols).

4. See 1 MCCARTHY, *supra* note 1, § 3:2, at 3-4 (stating that often the meaning of a word changes according to its use); see also *Towne v. Eisner*, 245 U.S. 418, 425 (1918) (stating that “[a] word is not a crystal, transparent and unchanged, it is the skin of living thought and may vary greatly in color and content according to the circumstances and the time in which it is used”) (citation omitted).

5. See *infra* Part II.A.

6. See *King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577, 579-80 (2d Cir. 1963) (holding that “thermos” had become generic because of the company’s widespread generic usage of its mark and its failure to stop misuse by others), *modified*, 320 F. Supp. 1156 (D. Conn. 1970); *infra* Part II.A (discussing generic terms). But see *infra* note 327 and accompanying text (stating that owners of marks held to be generic may be entitled to injunctive relief designed to minimize possible confusion caused by the defendant’s use of the generic mark). A trademark is not an absolute property right like a patent or copyright because trademark rights require positive action on the part of the trademark owner to keep the trademark rights in force. See *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368 (1924) (holding that a trademark does not confer an absolute ownership right to “the word or words” that are protected). Patents require actions of a technical manner on the part of their owners in order to keep their rights in force. See 35 U.S.C. § 41(b) (1996) (stating that a patent will expire if certain requirements are not met). For example, the payment of three maintenance fees due at three and a half years, seven and a half years, and eleven and a half years from the grant date of the patent are required to keep the patent in force. See *id.*

7. See *Johnson & Johnson v. E. I. du Pont de Nemours & Co.*, 181 U.S.P.Q. (BNA) 790, 791 (T.T.A.B. 1974) (stating that “the function of a trademark is to identify a single, albeit anonymous source”).

8. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (stating that generic terms are not protectable trademarks).

9. See *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942) (stating that trademarks act as a psychological symbol for the consumer).

Currently, there are few trademark cases that focus on the effects of public and media use of trademarks outside of the generic terms context. There are however, several cases that recognize trademark-like rights resulting from public and media use of identifying terms.¹⁰ Courts have granted protection to abbreviated forms of well-known trademarks and consumer coined nicknames for products and services, even though the trademark owner never used the abbreviation or nickname on its goods or services.¹¹ Typically, trademark rights are acquired by an owner only after actual use in commerce of the mark on goods or services.¹² On occasion, however, courts have protected both a trademark owner's goodwill and a consumer's perceptions by preventing a potential user from confusing consumers who had come to associate the contested mark with the owner; this is true even if the owner never used the purported mark on its goods or to identify its services.¹³

Cases centering on the subject of public and media use of trademarks illustrate how courts recognize and protect consumer perceptions.¹⁴ In 1996, the United States Court of Appeals for the Seventh Circuit recognized the role of consumer perceptions in *Illinois High School Ass'n v. GTE Vantage Inc.*;¹⁵ the court declared that it was protecting effective communication by introducing the "dual-use" rights concept into trademark law.¹⁶ The plaintiff, Illinois High School Association (IHSA), had used the trademark "March Madness" since the early 1940s in connection with its high school basketball tournament.¹⁷ The defendant, GTE

10. See *infra* Parts II.B.1 and II.B.2 (discussing public association cases). In these cases, the public had modified or created a term to identify the trademark owners' goods or services. See *Coca-Cola Co. v. Busch*, 44 F. Supp. 405, 410 (E.D. Pa. 1942) (granting trademark rights to Coca-Cola in the term "Koke" due to public association); *Volkswagenwerk Aktiengesellschaft v. Thermo-Chem Corp.*, 185 U.S.P.Q. (BNA) 561, 562 (T.T.A.B. 1975) (granting trademark rights to Volkswagen in the term "BUG" due to public association).

11. See *infra* Parts II.B.1 & II.B.2 (discussing the trademark protections afforded abbreviations and nicknames for trademarks created by the public or media).

12. See *Paramount Pictures Corp. v. White*, 31 U.S.P.Q.2d (BNA) 1768, 1772 (T.T.A.B. 1994) (holding that a trademark must be used in connection with goods to establish trademark rights).

13. See *infra* Parts II.B.1 & II.B.2 (discussing the trademark protection afforded abbreviations and nicknames of trademarks adopted by the public).

14. See *infra* Parts II.B.1 & II.B.2 (discussing trademark protection afforded abbreviations and nicknames for trademarks). Consumer perceptions are protected most often in the generic terms context. See *infra* Part II.A (discussing public perceptions and generic terms).

15. 99 F.3d 244 (7th Cir. 1996), *cert. denied*, 117 S. Ct. 1083 (1997).

16. See *Illinois High Sch. Ass'n*, 99 F.3d at 247.

17. See *id.* at 245; see also *infra* Part IV (discussing in detail the facts of *Illinois High Sch. Ass'n* and the Seventh Circuit's opinion).

Vantage, used "March Madness" under a license from the National Collegiate Athletic Association (NCAA) in connection with a CD-ROM game dealing with NCAA college basketball.¹⁸ The Seventh Circuit upheld the denial of IHSA's request for an injunction forbidding GTE Vantage from using the term.¹⁹ The Court held that IHSA had no trademark rights to protect against GTE Vantage's use because, through widespread media usage, the public had come to associate the term "March Madness" almost exclusively with the NCAA basketball tournament televised nationally each year.²⁰

Judge Posner held that IHSA's mark no longer served to exclusively identify its high school basketball tournament and, in effect, declared that it was generic.²¹ The term "March Madness" however, cannot be called generic in a true sense because it is not a synonym for all basketball tournaments held in March.²²

To confuse matters further, Judge Posner concluded his opinion by stating, "[w]e do not opine on the scope of the trademark rights that either IHSA or NCAA has, beyond ruling that IHSA's rights do not extend to the NCAA tournament and to merchandise such as Vantage's game that is sold in connection with that tournament."²³ If "March Madness" is truly a generic term, then this statement makes little sense; neither IHSA nor the NCAA could have any trademark rights in a generic term because such terms are not protectable as trademarks.²⁴ Based on Judge Posner's closing statement, the Seventh Circuit did not completely foreclose legal protection of the term "March Madness."²⁵

One interpretation of the Seventh Circuit's holding is that IHSA simply did not have sufficient rights to stop the use of "March Madness" as licensed by the NCAA to GTE Vantage.²⁶ Another view, which the par-

18. See *Illinois High Sch. Ass'n*, 99 F.3d at 245.

19. See *id.* at 247.

20. See *id.*

21. See *id.*

22. See *id.*

23. *Id.* at 248.

24. See *infra* Part II.A (discussing generic terms).

25. See Richard E. Stanley, Jr., Comment, *Reverse Confusion as Applied in Dream Team Collectibles, Harlem Wizards Entertainment Basketball, and Illinois High School Association*, 50 BAYLOR L. R. 1007, 1025 (1998) (arguing that IHSA and the NCAA retained trademark rights to the term "March Madness" to enforce against others, but not against each other); Bart A. Lazar & Thomas A. Volz, *Owners Must Police Marks Diligently*, NAT'L L. J., May 12, 1997, at C5 (stating that the Seventh Circuit acknowledged that "the mark was not devoid of any value to either the NCAA or the IHSA.").

26. See *Richards v. Cable News Network, Inc.*, 15 F. Supp.2d 683, 694 (E.D. Pa. 1998) (stating that the Seventh Circuit found "March Madness" to be generic). Other views

ties addressed in their post-Seventh Circuit briefs before the Supreme Court and which the district court incorporated in its opinion, was that the NCAA had acquired common law trademark rights through media and public use of the term.²⁷ In this author's view, the Seventh Circuit did not declare that "March Madness" was not entitled to any legal protection. It held merely that IHSA could not stop the NCAA, through its licensor, the GTE Advantage, from using "March Madness" in connection with the NCAA Tournament.²⁸ Presumably, IHSA and the NCAA still are entitled to stop others from using "March Madness" in connection with goods and services related to their respective tournaments.²⁹

Viewed from any of these perspectives, the Seventh Circuit allowed both entities to continue using the mark.³⁰ It therefore could be said that the court created a "dual-use" mark, one which both IHSA and NCAA could use for their respective tournaments.³¹ This result is not attractive as most trademark owners do not want to lose or share trademark rights.³² The decision suggests, therefore, that trademark owners should be diligent in policing the use of their trademarks by others or risk losing protection of their trademark rights.³³

As a result of the Seventh Circuit's creation of "dual-use" rights, two

have been expressed on the meaning of the *Illinois High School Ass'n* decision. See 3 MCCARTHY, *supra* note 1, § 24:94, at 24-161 n.3 (discussing the Seventh Circuit's decision in terms of "dilution by blurring," which is described as "a proliferation of borrowings that . . . deprive the mark of its distinctiveness" and, therefore, its strength); Anthony L. Fletcher & David J. Kera, *United States: The Fiftieth Year of Administration of the Lanham Trademark Act of 1946*, 87 TRADEMARK REP. 741, 797 (1997) (stating that the outcome turned on the issue of abandonment).

27. See *Illinois High Sch. Ass'n v. GTE Vantage Inc.*, No. 96-1119, at 104 (C.D. Ill. March 20, 1996) (hearing on motion for preliminary injunction); Respondent's Brief in Opposition at 8-9, *Illinois High Sch. Ass'n v. GTE Vantage Inc.*, 99 F.3d 244 (7th Cir. 1996) (No. 96-1981) [hereinafter Respondent's Brief]; Petition for a Writ of Certiorari at 9-10, *Illinois High Sch. Ass'n v. GTE Vantage Inc.*, 99 F.3d 244 (7th Cir. 1996) (No. 96-1981) [hereinafter Petition for a Writ of Certiorari].

28. See *Illinois High Sch. Ass'n*, 99 F.3d at 248.

29. See *Lazar & Volz*, *supra* note 25, at C5.

30. See *Illinois High Sch. Ass'n*, 99 F.3d at 248 (refusing both to enjoin GTE Vantage and to opine on the scope of the trademark rights of IHSA and the NCAA); Petition for a Writ of Certiorari, *supra* note 27, at 8-9 (stating that the Seventh Circuit created a "joint tenancy" of the mark by IHSA and the NCAA).

31. See *Illinois High Sch. Ass'n*, 99 F.3d at 247; Petition for a Writ of Certiorari, *supra* note 27, at 8-9.

32. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (stating that generic terms are not protectable trademarks); Petition for a Writ of Certiorari, *supra* note 27, at 8-9 (stating that a "joint tenancy" will destroy the source denoting function of trademarks and, as a result, will cause consumer confusion).

33. See *Illinois High Sch. Ass'n*, 99 F.3d at 246. The opinion cautions trademark owners that they must be "assiduous" in protecting their marks. See *id.*

entirely separate trademark owners now may have rights to use the same trademark, if the public associates the mark with more than one owner.³⁴ In deciding this way, the Seventh Circuit's holding clashed with established trademark principles, most obviously with the time-tested principle that trademarks designate only a single source.³⁵

Moreover, because trademark owners should police the use of their own trademarks diligently to retain full protection, they now have to fear not only generic usage of their marks, but also media and public usage that may compromise the owner's rights in favor of others.³⁶ Prior to *Illinois High School Ass'n*, trademark owners had less to fear regarding non-commercial uses of their trademarks.³⁷ Now, in addition to addressing generic issues, the cautious trademark owner should address and challenge non-commercial uses of its mark to guard against another acquiring "dual-use" trademark rights.³⁸ At present, however, there is uncertainty as to what actions a trademark owner must take to protect its mark from becoming a "dual-use" term.³⁹

34. See *id.* at 247.

35. See *Shredded Wheat Co. v. Humphrey Cornell Co.*, 250 F. 960, 963 (2d Cir. 1918) (a trademark must point to a "single, though anonymous, maker"); 1 MCCARTHY, *supra* note 1, § 3:9, at 3-17 to 3-18 (discussing the principle that trademarks designate a single source). Presently, Congress does permit concurrent use trademark rights, but these rights may be granted only for separate regions and only when confusion is unlikely. See 15 U.S.C. § 1052(d) (1994) (detailing the requirements for concurrent registrations); 3 MCCARTHY, *supra* note 1, § 20:82, at 20-129 (discussing concurrent use registrations). The Seventh Circuit opinion did not address concurrent use rights, however, and held that two separate entities were allowed to use the same mark in overlapping territories. See *Illinois High Sch. Ass'n*, 99 F.3d at 247-48.

36. See *id.* at 246-47; see also *Petition for a Writ of Certiorari*, *supra* note 27, at 8.

37. See *Petition for a Writ of Certiorari*, *supra* note 27, at 12 (stating that trademark owners traditionally have not feared non-commercial use); see also *Lucasfilm Ltd. v. High Frontier*, 622 F. Supp. 931, 935 (D.D.C. 1985) (stating that the media's use of "STAR WARS" to denote the Strategic Defense Initiative did not affect the plaintiff's exclusive trademark rights in "STAR WARS" within the entertainment field).

38. See *Illinois High Sch. Ass'n*, 99 F.3d at 246; see also *Petition for a Writ of Certiorari*, *supra* note 27 at 10-13. In *Illinois High School Association*, the IHSA waited a long time to challenge the media's use of "March Madness" in connection with the NCAA tournament. See *Illinois High Sch. Ass'n*, 99 F.3d at 246; see also *Illinois High Sch. Ass'n v. GTE Vantage Inc.*, No. 96-1119, at 98, 100 (C.D. Ill. March 20, 1996) (hearing on motion for preliminary injunction). The district court and Seventh Circuit weighed this fact heavily in considering whether to deny the injunction. See *Illinois High Sch. Ass'n*, 99 F.3d at 246-47 (admonishing IHSA for not being "assiduous" in protecting its rights); see also *Illinois High Sch. Ass'n*, No. 96-1119, at 98, 100 (hearing on motion for preliminary injunction).

39. See *Brief of Plaintiff-Appellant Illinois High School Association* at 12, *Illinois High Sch. Ass'n v. GTE Vantage Inc.*, 99 F.3d 244 (7th Cir. 1996) (No. 96-1981) [hereinafter *Brief of Illinois High School Association*] (stating that the First Amendment limits the actions a trademark holder can take against the media). This is also the case with generic

In holding that “March Madness” was a “dual-use” term, the Seventh Circuit also recognized the importance that public association plays in trademark protection.⁴⁰ The interests of effective public communication could be furthered only by refusing to enjoin GTE Vantage and, thereby, recognizing that the NCAA also had rights to use the mark because a clear majority of the public associated “March Madness” with the NCAA tournament.⁴¹ In future cases where similar issues arise, courts will need to formulate an appropriate balancing test to decide whether the interests of effective communication will support the labeling of a term as “dual-use.”⁴²

The Seventh Circuit’s opinion has been criticized for “turn[ing] trademark law on its head.”⁴³ Perhaps the most disturbing aspect of the decision is the scant treatment that the Seventh Circuit gave to existing

terms. See 2 MCCARTHY, *supra* note 1, § 12:28, at 12-67 (stating that there is “no sure legal remedy” against the media in the generic terms and dilution contexts). *But see* Stuart I. Graff, *Could Mark Owners Sue Media for Generic Use?*, NAT’L L. J., Oct. 19, 1998, at C6 (stating that in some circumstances, trademark owners could maintain actions against the media for generic usage or dilution).

40. See *Illinois High Sch. Ass’n*, 99 F.3d at 247. A trademark owner cannot “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.” *Id.*

41. See *id.*; see also *Murphy Door Bed Co. v. Interior Sleeping Sys., Inc.*, 874 F.2d 95, 101 (2d Cir. 1989) (implying that public perception should not be ignored once public association has occurred). It was easy for the court to decide *Illinois High School Ass’n* on this theory because public association so strongly favored the NCAA, even though IHSA had used the mark to some degree for a long period of time prior to the NCAA’s adoption of the term. Cf. *Illinois High Sch. Ass’n*, 99 F.3d at 246-48. It is interesting to note that “March Madness” was not alleged to be a “descriptive” mark. See generally *id.*; *infra* notes 57-60 (discussing descriptive terms and secondary meaning). Typically, courts measure only the amount of public association when deciding whether, for a descriptive mark, the trademark owner has proven secondary meaning—consumers’ association of a particular mark with a particular source. See *infra* notes 58-62 and accompanying text (discussing secondary meaning). Outside of the secondary meaning context, this aspect of the case is novel, as no court appears ever to have used the strength of public association as a determinative factor in a trademark dispute. See *Illinois High Sch. Ass’n*, 99 F.3d at 247 (stating that this case involved a novel issue of trademark law in the Seventh Circuit); *Wallpaper Mfgs., Ltd. v. Crown Wallcovering Corp.*, 680 F.2d 755, 762 (C.C.P.A. 1982) (stating that “[t]rademark rights are neither acquired nor lost on the basis of comparative popularity”); Jason R. Wolfersberger, *Recent Developments, Illinois High School Association v. GTE Vantage, Inc.: Dual-Use Classification Threatens the Extinction of America’s Small Trademark Holder*, 32 GA. L. REV. 363, 383 (1997) (arguing that “the Seventh Circuit bypassed the traditional analysis” in deciding issues of trademark protection).

42. See *infra* Part VI.A-B (arguing that future courts should balance the need for effective communication in conducting their analyses).

43. Petition for a Writ of Certiorari, *supra* note 27, at 13; see also Wolfersberger, *supra* note 41, at 389-90 (arguing that the *Illinois High School Association* decision “circumvented traditional trademark analysis” and is unsupported by legal precedent).

trademark precedent.⁴⁴ The court was quick to strike down the rights of a small trademark holder in the face of a more powerful entity,⁴⁵ this facet of the case struck a chord with those who see the decision as hampering or even destroying the rights of small trademark owners.⁴⁶

The purpose of this Comment is not to dismiss *Illinois High School Ass'n* as a mere aberration or to argue that the case was decided wrongly. Rather, this Comment's sole objective is to explore the underlying rationale of the decision and to develop a framework for addressing future "dual-use" cases. This Comment first discusses the relevance of public association, strength of trademarks, and other principles of trademark law necessary for an analysis of the decision in *Illinois High School Ass'n*. This Comment then outlines court decisions involving media and public use of trademarks to provide a framework for analyzing the decision. Next, this Comment examines the decision in *Illinois High School Ass'n* by analyzing the nature of "dual-use" classification as announced by the Seventh Circuit. This Comment then attempts to reconcile the decision with existing trademark precedent and focuses on Judge Posner's creation of the novel "dual-use" categorization and his "assimilation" of those terms to previously existing generic terms. This Comment then discusses some of the issues involved with recognizing trademark rights in users of "dual-use" terms, including the rights of each "dual-user" and free speech concerns. Finally, this Comment argues that future courts should analyze the likelihood of confusion before fashioning appropriate relief.

II. TRADEMARK RIGHTS AND PRINCIPLES OF PUBLIC ASSOCIATION

The Lanham Act of 1946⁴⁷ governs federal trademark law and provides for the federal protection and registration of trademarks.⁴⁸ It also provides legal remedies for the infringement of federally registered trade

44. See Wolfersberger, *supra* note 41, at 383-89; see also *infra* Part V.B (discussing the difficulties with the "dual-use" classification).

45. See Wolfersberger, *supra* note 41, at 389-91.

46. See *id.* The decision also can be viewed as a classic example of "outcome-based judicial reasoning." See *id.* at 389; see also *Illinois High Sch. Ass'n*, 99 F.3d at 248 (stating that the suit appeared to lack any merit).

47. 15 U.S.C. § 1051 (1994).

48. See *id.* §§ 1051, 1114, 1125.

marks,⁴⁹ as well as unregistered trademarks.⁵⁰ Trademark rights also can arise under state common law⁵¹ and statutes providing for state registration.⁵²

The primary purpose of a trademark is to serve as a designator of a source of goods or services.⁵³ Certain types of words are better suited for this purpose and, therefore, the selection and maintenance of words or symbols to serve as trademarks bears heavily on the protection that a

49. *See id.* § 1114. Federally registered trademarks are protected against infringement by section 32 of the Lanham Act, which provides:

(1) Any person who shall, without the consent of the registrant—(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or (b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive, shall be liable in a civil action by the registrant for the remedies hereinafter provided. Under subsection (b) hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive.

Id.

50. *See id.* § 1125(a). Unregistered trademarks are protected against infringement by section 43(a)(1) of the Lanham Act, which provides:

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

Id.

51. *See, e.g.,* *Elgin Nat'l Watch Co. v. Illinois Watch Case Co.*, 179 U.S. 665, 674 (1901) (recognizing common law trademark rights).

52. *See* 3 MCCARTHY, *supra* note 1, § 22:1, at 22-2 to 22-6 (discussing state registration of trademarks). State trademark law exists to protect marks used only within a particular state. *See id.*

53. *See Johnson & Johnson v. E. I. du Pont de Nemours & Co.*, 181 U.S.P.Q. (BNA) 790, 791 (T.T.A.B. 1974) (stating that the function of a trademark is to identify "a single, albeit anonymous, source").

court will afford an owner in a trademark infringement action.⁵⁴

Trademarks are grouped into two categories: “inherently distinctive” and “non-inherently distinctive” trademarks.⁵⁵ The first category, “inherently distinctive” trademarks, includes “suggestive, arbitrary and fanciful” marks which, by definition, serve to identify the source without more.⁵⁶ The second category, “non-inherently distinctive” trademarks, includes descriptive marks, which are words that describe the “qualities, ingredients, or characteristics of [the] product” to which the mark is applied.⁵⁷ Descriptive marks are deemed “non-inherently distinctive” because they cannot function immediately as an identifier of source; therefore, descriptive marks require proof of “secondary meaning” to be protected as a mark.⁵⁸ Secondary meaning is an association in the minds of the public that leads them to believe the primary significance of the term is as a reference to the source of the product instead of merely describing a feature of the product or the product itself.⁵⁹ Thus, to establish

54. See 2 MCCARTHY, *supra* note 1, § 11:2, at 11-5 to 11-7. All word marks fit on a spectrum of distinctiveness which determines the mark's inherent strength. See *id.* Trademark protection is relative to strength. See *id.* § 11:73, at 11-128 to 11-129; see also *infra* notes 55-58 and accompanying text (discussing the spectrum of distinctiveness of trademarks).

55. See 2 MCCARTHY, *supra* note 1, § 11:2, at 11-5 to 11-7.

56. See *id.* Fanciful marks are newly invented words that have been created to serve as a trademark. See *id.* § 11:5, at 11-11; see also *id.* § 11:8, at 11-13 to 11-14 (citing CLOROX and KODAK as examples). Arbitrary marks are common dictionary words that, when used to designate goods and services, “neither suggest nor describe any [attribute] of [the] goods or services.” *Id.* § 11:11, at 11-15 to 11-16; see also *id.* § 11:13, at 11-17 (citing ARROW for liqueurs and CONGRESS for spring water as examples).

57. See 2 MCCARTHY, *supra* note 1, § 11:15, at 11-19.

58. See *id.*; see also *id.* § 11:24, at 11-30 to 11-31 (using BEER NUTS for salted nuts and BUFFERIN for buffered aspirin as examples). See generally *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (identifying generic, descriptive, suggestive, arbitrary, and fanciful trademarks and their eligibility for trademark protection).

59. See *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.11 (1982). Typically, proof of secondary meaning requires the use of the trademark on or in connection with goods and services. See 15 U.S.C. § 1052(f) (1994) (stating that “[t]he Commissioner may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce”). Some courts, however, have held that pre-release or pre-sales publicity can establish secondary meaning. See *New West Corp. v. NYM Co. of Cal.*, 595 F.2d 1194, 1200 (9th Cir. 1979) (holding that pre-sales publicity for magazine “New West” was sufficient to establish trademark rights); *Walt Disney Prods. v. Kusan, Inc.*, 204 U.S.P.Q. (BNA) 284, 287 (C.D. Cal. 1979) (holding that pre-release publicity for the movie “The Black Hole” was sufficient to establish trademark rights). The court in *Illinois High School Association* did not label “March Madness” a descriptive term, therefore, secondary meaning arguably should not be a consideration. See generally *Illinois High Sch. Ass'n v. GTE Vantage Inc.*, 99 F.3d 244, 247 (7th Cir. 1996), *cert. denied*, 117 S. Ct. 1083 (1997); see also *Wolfersberger*, *supra* note 41, at 376-77

secondary meaning, the trademark owner must establish that the public associates the mark with a particular source.⁶⁰ In addition, in deciding the ownership priority⁶¹ of a trademark that requires secondary meaning, courts must determine whether the plaintiff had acquired secondary meaning in its mark at the time and in the market where the defendant commenced use of the mark.⁶²

Underlying these classifications is the public's interest in effective communication.⁶³ For example, when a mark becomes the generic name of a product, a trademark owner's continued monopoly on the right to use the term disadvantages competitors in that they are prohibited from using the true name of their product in describing it to consumers.⁶⁴ The same can be said for protecting descriptive marks, in that granting exclusive rights to these marks hampers trademark owners from describing features of the product to consumers.⁶⁵ Descriptive terms merely inform consumers of certain qualities of a product and, because many other products will have similar qualities, the use of a descriptive term as a trademark will not aid the consumer in distinguishing products of different sellers.⁶⁶ These terms often either praise or merely inform the consumer about the nature of the product.⁶⁷ Likewise, if third parties use the

(arguing that IHSA's mark was inherently distinctive and that secondary meaning should not apply). Instead, the court applied the related concept of public association to reach a similar result with respect to "March Madness," which is arguably an inherently distinctive trademark. See *Illinois High Sch. Ass'n*, 99 F.3d at 247; Wolfersberger, *supra* note 41, at 376.

60. See *Carter-Wallace, Inc. v. Procter & Gamble Co.*, 434 F.2d 794, 802 (9th Cir. 1970) (holding that the trademark owner must establish secondary meaning in a descriptive mark before it can prove infringement). In determining whether the trademark owner has established secondary meaning, courts often measure "the effectiveness of the effort to create it." *Id.*

61. See *infra* Part III.B (discussing the relevance of priority of use in trademark law).

62. See *Scott Paper Co. v. Scott's Liquid Gold, Inc.*, 589 F.2d 1225, 1231 (3d Cir. 1978) (holding that the plaintiff must demonstrate that it acquired secondary meaning in the defendant's market first); *National Color Labs, Inc. v. Philip's Foto Co.*, 273 F. Supp. 1002, 1003 (S.D.N.Y. 1967) (holding that mere priority of use does not give the plaintiff rights to a mark).

63. See *infra* Part II.A (discussing the policy reasons against trademark protection of generic terms).

64. See *infra* Part II.A (discussing why generic terms are not protected as trademarks).

65. Cf. *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 543-45 (1920) (holding that other trademark owners must be allowed to use descriptive terms to describe their products).

66. See *Devcon Corp. v. Woodhill Chem. Sales Corp.*, 455 F.2d 830, 832 (1st Cir. 1972).

67. See, e.g., *id.*; see also 2 MCCARTHY, *supra* note 1, § 11:18, at 11-23.

same mark on similar goods, the mark will not be very distinctive.⁶⁸ The use of the same mark by many is unlikely to confuse because consumers may learn to differentiate, carefully picking one product from the other.⁶⁹ Therefore, if there is enough third party use, courts will hold that the mark has ceased to function as a trademark.⁷⁰

The courts and the Trademark Trial and Appeal Board (TTAB) consider evidence of third party use in determining whether there is a likelihood of confusion between competing marks.⁷¹ If such evidence shows that third parties are using trademarks containing a common term, courts hold that such evidence is sufficient to suggest that purchasers have been conditioned to look to the other elements of the marks in order to distinguish the source of goods or services.⁷²

A. Public and Media Use: The Generic Terms and Dilution Context

News commentators, book publishers, and other “lexicographically influential” people have the ability to affect the consumer’s perception of what a trademark means.⁷³ In determining whether a trademark designates a source, a court asks “[w]hat do the buyers understand by the word for whose use the parties are contending?”⁷⁴ “If [the term] does not relate exclusively to the trademark owner’s product,”⁷⁵ such as when consumers view the term as the name of the product itself, the mark will be labeled as a generic term.⁷⁶ For example, a generic product name like the

68. See 2 MCCARTHY, *supra* note 1, § 11:85, at 11-144 to 11-145 (discussing the relationship between strength and third party use).

69. See *id.* § 11:85, at 11-144.

70. See *id.* § 11:85, at 11-144 to 11-145.

71. See *Lloyd’s Food Prods. Inc. v. Eli’s, Inc.*, 987 F.2d 766, 768 (Fed. Cir. 1993) (holding that trademark use search reports, telephone directory listings, and advertisements may be considered in determining the strength of a service mark); *In re Broadway Chicken, Inc.*, 38 U.S.P.Q.2d (BNA) 1559, 1564-65 (T.T.A.B. 1996) (holding that trademark use search reports and telephone directories were competent to show third party use of a common term).

72. See *Broadway Chicken*, 38 U.S.P.Q.2d at 1565-66 (holding that evidence of widespread third party use of term “Broadway” as a common element in numerous marks used in connection with restaurant services established an unlikelihood of consumer confusion).

73. *Illinois High Sch. Ass’n. v. GTE Vantage, Inc.*, 99 F.3d 244, 246 (7th Cir. 1996), *cert. denied*, 117 S. Ct. 1083 (1997); see also *infra* Part V.C.1-3 (discussing the free speech issues involved with state trademarks).

74. *Bayer Co. v. United Drug Co.*, 272 F. 505, 509 (S.D.N.Y. 1921). Judge Learned Hand posed this famous question in *Bayer* and it soon became the test for determining whether a mark was generic. See *id.*; 2 MCCARTHY, *supra* note 1, § 12:4, at 12-9.

75. *New Kids On The Block v. News America Publ’g, Inc.*, 971 F.2d 302, 306 (9th Cir. 1992).

76. See 2 MCCARTHY, *supra* note 1, § 12:1, at 12-4.

word “car” can never function as a trademark for an automobile, because the word “car” is a name for the product itself and it does not identify the source of the automobile.⁷⁷ A generic term can never function as a trademark because public policy dictates that these terms belong to the public domain.⁷⁸ If not, competitors would be put at a disadvantage because they could not use the generic name of the product to describe their goods to consumers.⁷⁹ Denying trademark protection to such terms “allays fears that [companies] will [appropriate all] useful words” and attempt to “assert[] exclusive rights [to] them.”⁸⁰ There are numerous cases where courts have denied protection because a mark was generic.⁸¹

A trademark also can lose its ability to denote its source through dilu-

77. *See id.* § 12:2, at 12-6 to 12-8. Often times, such cases dealing with generic terms relate to newer products where the producer failed to create both a name for the product itself and a brand name for the product. *See id.* § 12:25, at 12-60 to 12-62. Thus, when a producer selects only a trademark for the product, the public will have nothing other than the trademark itself to identify the product. *See id.* Such a trademark is likely to become generic. *See, e.g.* Kellogg Co. v. National Biscuit Co., 305 U.S. 111, 116-17 (1938) (holding “Shredded Wheat” to be the generic name of the type of cereal); DuPont Cellophane Co. v. Waxed Prods. Co., 85 F.2d 75, 82 (2d Cir. 1936) (holding that “Cellophane” was the generic name of the product).

78. *See* 2 MCCARTHY, *supra* note 1, § 12:2, at 12-5 (stating that “generic terms are free for all to use”); Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 10 (2d Cir. 1976) (stating that affording protection to a generic term would grant a monopoly on a word in the English language).

79. *See* 2 MCCARTHY, *supra* note 1, § 12:2, at 12-6 to 12-7 (discussing the public policy concerns in denying protection to generic terms). A generic term will not be protected regardless of how much money was spent on promoting the product. *See Abercrombie & Fitch*, 537 F.2d at 9. The money and effort are irrelevant because competing manufacturers have a right to call their product by its name. *See id.*

80. *New Kids On The Block*, 971 F.2d at 306 (stating “the primary cost of recognizing property rights in trademarks is the removal of words from (or perhaps non-entrance into) our language”).

81. *See* Reese Publ'g Co. v. Hampton Int'l Communications, Inc., 620 F.2d 7, 10-11 (2d Cir. 1980) (holding “Video Buyer’s Guide” to be generic for television related magazines); *Alchemy II, Inc. v. Yes! Entertainment Corp.*, 844 F. Supp. 560, 569 (C.D. Cal. 1994) (holding “Teddy” to be generic for teddy bears); *Nissen Trampoline Co. v. American Trampoline Co.*, 193 F. Supp. 745, 749 (S.D. Iowa 1961) (holding “trampoline” to be generic for a piece of gymnastic equipment); *see also generally* 2 MCCARTHY, *supra* note 1, § 12:18, at 12-35 to 12-45 (providing an illustrative list of trademarks held to be generic). A trademark can, however, be generic in one context and a valid trademark in another. For instance, in *Bayer Co. v. United Drug Co.*, 272 F. 505 (S.D.N.Y. 1921), a United States federal district court held the term “ASPIRIN” to be generic with respect to the general public, yet a valid trademark with respect to pharmacists. *See id.* at 510. The court reasoned that, to the pharmacists, the term “ASPIRIN” still meant the plaintiff’s brand. *See id.* The court said that giving Bayer a monopoly on the word “ASPIRIN” would deprive the trade of “the right effectually to dispose of the drug by the only description which will be understood.” *Id.* at 514.

tion.⁸² When a trademark no longer signifies anything unique or particular, but rather refers to various things from various sources, dilution has occurred.⁸³ Improper use of a trademark by third parties can cause the dilution of that mark.⁸⁴ State dilution statutes have existed for some time⁸⁵ and, in 1995, Congress enacted a federal dilution statute.⁸⁶ There is, however, no cause of action under the new federal anti-dilution statute against non-commercial uses of trademarks.⁸⁷ Thus, trademark owners must take other action against trademark misuse by the public and the media to protect themselves against any loss of rights due to generic usage and dilution.⁸⁸ It is relatively uncertain, however, just what legal actions a trademark owner may utilize to stop such trademark misuse.⁸⁹

A trademark owner's ability to stop use that may cause a mark to become generic or diluted depends on who is using the trademark and in what manner.⁹⁰ A trademark owner will have a cause of action under

82. See *Tiffany & Co. v. Boston Club, Inc.*, 231 F. Supp. 836, 844 (D. Mass. 1964) (enjoining the defendant from using "Tiffany's" for its restaurant services); see also 3 MCCARTHY, *supra* note 1, § 24:71, at 24-121 to 24-122 (discussing how dilution occurs). In *Tiffany & Co.*, the Massachusetts federal court described the type of injury caused by dilution as follows: "The risk of detracting may be a risk of an erosion of the public's identification of this very strong mark with the plaintiff alone, thus diminishing its distinctiveness, uniqueness, effectiveness, and prestigious connotations . . ." *Tiffany & Co.*, 231 F. Supp. at 844.

83. See *Tiffany & Co.*, 231 F. Supp. at 844; 3 MCCARTHY, *supra* note 1, § 24:71, at 24-121 to 24-122; see also Beverly W. Pattishall, *Dawning Acceptance of the Dilution Rationale for Trademark-Trade Identity Protection*, 74 TRADEMARK REP. 289, 308 (1984) (explaining the dilution process). This form of dilution is known as dilution by "blurring." See *Sally Gee, Inc. v. Myra Hogan, Inc.*, 699 F.2d 621, 625-26 (2d Cir. 1983). Dilution also can occur by "tarnishment," where the effect of the defendant's conduct is to tarnish or degrade the plaintiff's mark. Cf. *Deere & Co. v. MTD Prods., Inc.*, 41 F.3d 39, 41 (2d Cir. 1994) (finding plaintiff's mark tarnished by defendant's humorous depiction in comparative advertisement).

84. See 3 MCCARTHY, *supra* note 1, § 24:76, at 24-128.

85. See, e.g., CAL. BUS. & PROF. CODE § 14330 (Deering 1992); MASS. GEN. LAWS ANN., ch. 110B, §12 (West 1990). See generally Jerome Gilson, *A Federal Dilution Statute: Is It Time?*, 83 TRADEMARK REP. 108, 109-10 (1993) (discussing state dilution laws).

86. See 15 U.S.C. § 1125(c) (Supp. II 1997). The plaintiff's mark must be "famous" to receive protection under this section of the Lanham Act. See *id.*

87. See *id.* § 1125(c)(4)(b) (Supp. II 1997). This subsection expressly excludes the following: (1) fair use of a trademark in comparative advertising; (2) non-commercial use and; (3) all forms of news reporting and news commentary from a cause of action under the federal anti-dilution statute. See *id.*; see also Cyd B. Wolf, *Trademark Dilution: The Need for Reform*, 74 TRADEMARK REP. 311, 321 (1984) (arguing that anti-dilution law should be adapted to provide a basis for a cause of action for the generic misuse of trademarks).

88. See *infra* Part V.C.2 (discussing free speech issues and generic terms).

89. See *infra* Part V.C.2 (discussing remedies against the media).

90. See *infra* notes 91-96 and accompanying text.

sections 32 and 43(a) of the Lanham Act against one that uses its mark in a commercial manner.⁹¹ These two provisions of the federal trademark statute preserve the primary function of trademark law: preventing confusion in the marketplace.⁹² In the usual case, a court can order an injunction or possibly monetary damages to stop the infringing commercial use before any real harm is done to the mark's ability to designate a source.⁹³ Thus, trademark owners have an effective tool to stop commercial use of their marks that might affect the mark's distinctiveness or ability to denote its source.⁹⁴

Unfortunately for the trademark owner, non-commercial use can be just as damaging to a mark's ability to denote its source as commercial use.⁹⁵ For example, when the public or the media uses the mark in a non-commercial way, such as part of a communicative message, the trademark owner is often powerless to prevent the use.⁹⁶

91. See 15 U.S.C. § 1114 (1994) (requiring infringing activity to be "in commerce"); 15 U.S.C. § 1125 (Supp. II 1997) (requiring infringing activity to be "in commerce"); see also *supra* notes 49-50 (quoting the relevant statutory language).

92. See *International Ass'n of Mach. & Aerospace Workers v. Winship Green Nursing Ctr.*, 103 F.3d 196, 200 (1st Cir. 1996) (stating that "[t]rademark . . . laws exist largely to protect the public from confusion").

93. See 15 U.S.C. §§ 1116, 1117 (1994) (outlining remedies for trademark infringement).

94. See *id.*

95. See *infra* Part V.C.2 (discussing the effects of public and media use on trademarks).

96. See 5 MCCARTHY, *supra* note 1, § 31:147, at 31-213 to 31-215 (discussing limitation on trademark owners' ability to prevent non-commercial use of their marks when that use is labeled pure speech as opposed to commercial speech). This powerlessness is due to the free speech protection afforded by the First Amendment. See generally *Yankee Publ'g Inc. v. News America Publ'g, Inc.*, 809 F. Supp. 267, 275-76 (S.D.N.Y. 1992) (holding that the First Amendment is implicated when one uses another's mark as part of a communicative message and not as a source identifier). A court will construe the Lanham Act narrowly when the unauthorized use of the trademark is for the purpose of a communicative message, rather than as an indication of its source. See *id.* at 276. Aside from being protected by the First Amendment, non-commercial use of another's trademark usually is not within the scope of the Lanham Act. See generally *Lucasfilm Ltd. v. High Frontier*, 622 F. Supp. 931, 934-35 (D.D.C. 1985) (holding use of "STAR WARS" mark in conjunction with messages about SDI to be non-actionable under the Lanham Act). *But cf.* *MGM-Pathé Communications Co. v. Pink Panther Patrol*, 774 F. Supp. 869, 877 (S.D.N.Y. 1991) (granting a preliminary injunction, despite a First Amendment defense, against a gay activist organization that barred them from using the mark "Pink Panther Patrol" due to a likelihood of confusion). If the law did not protect communicative messages, the result would be the recognition of an absolute property right in the trademark, thereby effectively causing the removal of a word from our language. See *New Kids On The Block v. News America Publ'g, Inc.*, 971 F.2d 302, 306 (9th Cir. 1992) (emphasizing that "[a] trademark is a limited property right in a . . . word, phrase or symbol").

B. Judicial Recognition of Trademark Rights Through Media and Public Use

Media and public use of the term "March Madness" in favor of the NCAA played a major role in the outcome of *Illinois High School Ass'n*.⁹⁷ Looking at a number of trademark cases involving public and media use outside of the generic terms context, support can be gleaned for the proposition that public and media use can create trademark rights as it did in *Illinois High School Ass'n*.⁹⁸

At common law, merchants established trademark rights through the use of symbols to identify their goods or services, thereby distinguishing their goods or services from those of other merchants.⁹⁹ Many courts began to recognize that an entity could acquire trademark rights through the public's identification of terms with a company or its products, even though the entity had never actually used that trademark.¹⁰⁰ This phenomenon arose from the judiciary's realization that many Americans were prone to abbreviate common trademarks and, to some extent, to

97. See *infra* Part IV (discussing the decision in detail).

98. See *Johnny Blastoff Inc. v. Los Angeles Rams Football Co.*, 48 U.S.P.Q.2d (BNA) 1385, 1396-97 (W.D. Wis. 1998) (finding trademark rights in "St. Louis Rams" through public association); *infra* Parts III.B.1 and III.B.2.

99. See 2 MCCARTHY, *supra* note 1, § 16:1, at 16-3 (discussing common law trademark ownership). At common law, courts held that trademark rights began to accrue when the mark was "affixe[d]" to the seller's goods. See *Rolley, Inc. v. Younghusband*, 204 F.2d 209, 212 (9th Cir. 1953) (holding that ownership depends on time of fixation); *Waldes v. International Mfgs. Agency, Inc.*, 237 F. 502, 506 (S.D.N.Y. 1916) (stating that registration alone confers no trademark rights). The mark was affixed "when [the] product bearing the symbol first confronted [buyers] in the marketplace." 2 MCCARTHY, *supra* note 1, § 16:23, at 16-31. This old rule has been liberalized and now pre-sales solicitation and advertising, as long as it creates an association between the symbol and the producer's goods, can establish trademark significance in a term. See *id.* § 16:24, at 16-32. Mere advertising, however, does not constitute statutory trademark use. See *id.* § 16:28, at 16-36.

100. See *National Cable Television Ass'n v. American Cinema Editors, Inc.*, 937 F.2d 1572, 1577-78 (Fed. Cir. 1991) (stating that public use of a trade name could create rights in the name); *Coca-Cola Co. v. Busch*, 44 F. Supp. 405, 408 (E.D. Pa. 1942) (finding "Coke" to be a protected nickname because of public use); *Norac Co. v. Occidental Petroleum Corp.*, 197 U.S.P.Q. (BNA) 306, 315 (T.T.A.B. 1977) (stating that public use of a term can create rights in the company that produces the named product). For public use to be analogous to trademark use, such use must be an open or public use directed to the segment of industry or purchasing public for whom the party's goods or services are intended and be in a manner calculated to attract the attention of the viewer and thereby create an association of said term with such goods or services.

American Stock Exch., Inc. v. American Express Co., 207 U.S.P.Q. (BNA) 356, 364 (T.T.A.B. 1980).

use nicknames when referring to certain goods or services.¹⁰¹ Courts held that such public use conferred protectable rights in the abbreviation or nickname that the public had created.¹⁰² As a result, competitors were prevented from capitalizing on the trademark owner's goodwill and were forbidden from causing confusion by using marks that the public had come to associate with the trademark owners.¹⁰³ Abbreviations and nicknames for common trademarks thus gained trademark protection, on par with actual trademarks, solely through public association.¹⁰⁴ They have been protected since that time through unfair competition law.¹⁰⁵ A federal registration of the mark is not required for this type of cause of action.¹⁰⁶

101. See, e.g. *Coca-Cola Co.*, 44 F. Supp. at 408 (stating that "there is a marked tendency among American youth . . . [to] abbreviate"); see also 1 MCCARTHY, *supra* note 1, § 7:18, at 17-24.10 to 17-24.11 (listing protected abbreviations and nicknames for trademarks). For example, before "Coke" became a registered trademark of the Coca-Cola Company, members of the purchasing public began to abbreviate the company's trademark from "Coca-Cola" to "Coke" when asking for the soft drink. See *Coca-Cola Co. v. Christopher*, 48 U.S.P.Q. (BNA) 353, 354 (E.D. Mich. 1941); see also *Coca-Cola Co. v. Los Angeles Brewing Co.*, 44 U.S.P.Q. (BNA) 190, 192 (S.D. Cal. 1939) (finding "Coke" to be synonymous with the term "Coca-Cola").

102. See *National Cable Television Ass'n*, 937 F.2d at 1577-78; *Coca-Cola Co.*, 44 F. Supp. at 408; 1 MCCARTHY, *supra* note 1, § 7:18, at 7-24.10 to 7-24.11. One court went so far as to hold that use by the public can "inure[] to the claimant's benefit" resulting in the conclusion that such public use is trademark use by the claimant. *National Cable Television Ass'n*, 937 F.2d at 1577-78.

103. See *Johnny Blastoff Inc.*, 48 U.S.P.Q.2d at 1396-97 (holding that failing to recognize superior rights in the mark "St. Louis Rams" in favor of the defendant football team through public association would lead to consumer confusion); *infra* Parts II.B.1. and II.B.2. The fact that the public has come to refer to a seller's goods by a nickname or abbreviation must be supported by actual evidence; thus, mere assertions are insufficient. See *Londontown Mfg. Co. v. Cable Raincoat Co.*, 371 F. Supp. 1114, 1117 (S.D.N.Y. 1974) (holding evidence insufficient to support assertion that public understood the term "The Fog" to mean London Fog's raincoats); *Caterpillar Tractor Co. v. Katrak Vehicle Co.*, 172 U.S.P.Q. (BNA) 409, 410 n.2 (T.T.A.B. 1971) (finding evidence insufficient to support the assertion that the public and the trade members referred to the Caterpillar Tractor Company as "CAT").

104. See 1 MCCARTHY, *supra* note 1, § 7:18, at 7-24.10 to 7-24.11, 7-25 to 7-27 (citing cases illustrating that public usage of abbreviations and nicknames of well-known trademarks may confer protectable trademark rights); *infra* Parts II.B.1 & II.B.2 (discussing trademark protection afforded abbreviations and nicknames for trademarks).

105. See, e.g., *Johnny Blastoff Inc.*, 48 U.S.P.Q.2d at 1396-97; *Coca-Cola Co.*, 44 F. Supp. at 410 (using unfair competition law to enjoin the user of the mark "Koke-Up"); *Arthur Guinness, Son & Co. v. Oscar Von Bernuth*, 14 F. Supp. 210, 211-12 (S.D.N.Y. 1923).

106. See 1 CHARLES E. MCKENNEY & GEORGE F. LONG, III, FEDERAL UNFAIR COMPETITION: LANHAM ACT § 43(A), § 3.01, at 3-22 n.60 (West Group 1998) (1989) (citing cases holding same). Rights recognized under section 43(a) and those recognized under a federal trademark registration differ in one significant manner. Actual use of the

1. *The Unfair Competition Cases*

The courts' recognition of trademark rights in abbreviated forms of well-known trademarks began as early as 1942.¹⁰⁷ For example, in *Coca-Cola Co. v. Busch*,¹⁰⁸ the District Court for the Eastern District of Pennsylvania held that the defendant unfairly competed with Coca-Cola in adopting the mark "Koke-Up" on cola beverages.¹⁰⁹ Coca-Cola had not used "Coke" or "Koke" on its goods and, therefore, the court said that it could not recover on a common law trademark infringement theory.¹¹⁰ The court, however, turned to the broader field of unfair competition to find support for Coca-Cola's position.¹¹¹ It found that the abbreviation of the "Coca-Cola" trademark to "Koke," as used by the public to designate Coca-Cola's product, was "equally as much to be protected as the trademark itself."¹¹²

Courts also recognize trademark rights in nicknames or other terms that the public associates with a particular company's goods or services.¹¹³ For example, in *Arthur Guinness, Son & Co. v. Oscar Von Bernuth*,¹¹⁴ a

mark in commerce is required for a trademark registration. See 3 MCCARTHY, *supra* note 1, § 19:10, at 19-20 to 19-21 (discussing the eligibility requirements for trademarks to be entitled to federal registration). The Lanham Act defines "use in commerce" as:

the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this chapter, a mark shall be deemed to be in use in commerce—(1) on goods when—(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and (B) the goods are sold or transported in commerce, and (2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

15 U.S.C. § 1127 (1994).

107. See *Coca-Cola Co.*, 44 F. Supp. at 410.

108. 44 F. Supp. 405 (E.D. Pa. 1942).

109. See *id.* at 410.

110. See *id.* at 407. The court stated that "a strict construction of the authorities on common law trade infringement would seem to hold that there could be no infringement." *Id.*

111. See *id.* at 410.

112. *Id.* The court found that the evidence established that the defendant chose the trademark "'Koke-Up' solely for the [deliberate] purpose of taking advantage of the good will and reputation of ['Coca-Cola'] . . . to his [sole] benefit [and] to the deception of the public." *Id.*

113. See *Arthur Guinness, Son & Co. v. Oscar Von Bernuth*, 14 F. Supp. 210, 211-12 (S.D.N.Y. 1923).

114. 14 F. Supp. 210 (S.D.N.Y. 1923).

United States federal district court granted an injunction against the defendant Bernuth's use of the mark "Dublin Stout XXX."¹¹⁵ The evidence showed that consumers associated "Dublin Stout" with Guinness, even though Guinness never actually used the mark on its beer.¹¹⁶ The court reasoned that the fact that the term "Dublin Stout" was first used by the public, and not created by Guinness, was unimportant.¹¹⁷ The court determined that the public had, for a considerable period of time, equated Guinness's beer with that name and, as a result, the use of that mark by another would mislead the public.¹¹⁸ The court, therefore, granted Guinness's request for an injunction.¹¹⁹

2. *Trademark Trial and Appeal Board Cases*

The TTAB also has recognized that use by the media and public can create trademark rights.¹²⁰ For example, in *Pieper v. Playboy Enterprises, Inc.*,¹²¹ the TTAB refused to cancel Playboy's registration of the mark "Bunny Club," even though Pieper had used the same mark for restaurant services prior to Playboy's use.¹²² The TTAB found that long prior to Pieper's use of the mark, Playboy used a bunny symbol in connection with many of its goods and services.¹²³ In addition, Playboy referred to the cocktail waitresses employed at its Playboy clubs as "bunnies."¹²⁴ Due to the direct association between Playboy's bunny motif and the term "Bunny Club," the TTAB concluded that consumers would associate the mark "Bunny Club" with Playboy's clubs, not with Pieper's restaurant services.¹²⁵ Further, because the media and the public had used

115. *See id.* at 211-12.

116. *See id.* at 211. Guinness's labels did contain the words "Guinness's Extra Stout Dublin." *Id.*

117. *See id.*

118. *See id.*

119. *See id.* at 212.

120. *See infra* Part II.B.2 (discussing the TTAB's protection for abbreviations and nicknames for trademarks). The TTAB has stated

[i]t has been held that where the public has come to associate a term with a particular company and/or its goods or services as a result, for example, of use of the term in the trade and by the news media, that company has a protectable property right in the term even if the company itself has made no use of the term.

American Stock Exch., Inc. v. American Express Co., 207 U.S.P.Q. (BNA) 356, 364 (T.T.A.B. 1980).

121. 179 U.S.P.Q. (BNA) 318 (T.T.A.B. 1973).

122. *See id.* at 320.

123. *See id.*

124. *See id.*

125. *See id.* The TTAB stated that there was a direct association between the bunny symbol and bunny costumes, with the term "Bunny Club," when it was used to designate a

the term "Bunny Club" to refer to Playboy's services long before the petitioner began using the term for restaurant services, the TTAB decided that the goodwill associated with the mark rested with Playboy.¹²⁶

Similarly, years later in *National Cable Television Ass'n v. American Cinema Editors, Inc.*,¹²⁷ the United States Court of Appeals for the Federal Circuit upheld the TTAB's cancellation of the trademark "ACE" as used by the National Cable Television Association (NCTA) for its television awards ceremony.¹²⁸ The NCTA argued that American Cinema Editors, Inc. did not have standing to seek trademark cancellation because American Cinema had not used "ACE" as its trade name or as its service mark for its awards ceremony.¹²⁹ Therefore, NCTA argued that its trademark registration for "ACE" could not damage American Cinema.¹³⁰ The court disagreed, holding that American Cinema's use of "ACE" in its publications, articles, and correspondence was sufficient as a trade name and as a service mark.¹³¹ Furthermore, evidence consisting of newspaper articles and third party correspondence showed that American Cinema had been known publicly as "ACE."¹³² The court reasoned that precedent had established that public use could give rise to protectable rights, even in the absence of actual use by the party seeking protection (e.g., American Cinema).¹³³ The court elaborated further, stating that such use by the public inured to the party seeking protection's benefit; thus, it was as if the party *had* used the mark.¹³⁴ The court held that NCTA acted at its own peril when it adopted "ACE" as a trademark, regardless of the amount of money it spent to popularize its own award show and regardless of the fact that its award show had become better known than American Cinema's name.¹³⁵

night club. *See id.*

126. *See id.*; cf. *Harley-Davidson Motor Co. v. Pierce Foods Corp.*, 231 U.S.P.Q. (BNA) 857, 860, 864 (T.T.A.B. 1986) (sustaining an opposition against the registration of the mark "Harley-Hog" for pork products because the good will associated with the term "Hog" belonged to the manufacturer of Harley-Davidson motorcycles, despite the fact that the manufacturer had not made use of the mark).

127. 937 F.2d 1572 (Fed. Cir. 1991).

128. *See id.* at 1582.

129. *See id.* at 1578 n.5.

130. *See id.* at 1579.

131. *See id.* at 1577-78.

132. *See id.* at 1577.

133. *See id.*

134. *See id.* at 1577-78. The court stated that "[s]uch public use by others inures to the claimant's benefit and, where this occurs, public use can reasonably be deemed use 'by' that party in the sense of a use on its behalf." *Id.*

135. *See id.* at 1582. The court held that "a late-comer acts at its peril in [adopting] and investing in a [trade]mark [that infringes] on the rights of another." *Id.*

The TTAB has considered public use and association in deciding who used the mark first for priority purposes.¹³⁶ In *Norac Co. v. Occidental Petroleum Corp.*,¹³⁷ the TTAB refused to cancel Occidental's trademark "OXY," despite the fact that Norac had used the mark "OXY" in connection with fertilizer prior to Occidental's first use.¹³⁸ The TTAB reasoned that, because the public associated the use of the term "OXY" with Occidental's oil and gas trade prior to Norac's use of the term in connection with its fertilizer business, Occidental was able to tack on the time of this prior use and public association for priority purposes when it expanded its business to fertilizer.¹³⁹

Other TTAB decisions place similar significance on the public's use and association of product nicknames.¹⁴⁰ For example, in *Volkswagenwerk Aktiengesellschaft v. Thermo-Chem Corp.*,¹⁴¹ the TTAB sustained Volkswagen's opposition to Thermo-Chem's attempt to register "BUG COOLER" as a trademark for an engine oil cooling system.¹⁴² The TTAB held that Volkswagen had acquired a right in the term "BUG" in the automotive field because of the general public's and Volkswagen dealers' long use of the term "BUG" to describe Volkswagen's small automobile.¹⁴³

Despite these decisions, not all claims heard by the TTAB regarding rights acquired through public use and association have been successful.¹⁴⁴ For example, in *Big Blue Products Inc. v. International Business Machines Corp.*,¹⁴⁵ the TTAB denied IBM's motion for summary judgment on the issue of prior rights to the term "Big Blue."¹⁴⁶ IBM offered evidence showing that the public referred to IBM as "Big Blue" long be-

136. See *Norac Co. v. Occidental Petroleum Corp.*, 197 U.S.P.Q. (BNA) 306, 317 (T.T.A.B. 1977).

137. 197 U.S.P.Q. (BNA) 306 (T.T.A.B. 1977).

138. See *id.* at 317.

139. See *id.* at 315-17.

140. See *Volkswagenwerk Aktiengesellschaft v. Thermo-Chem Corp.*, 185 U.S.P.Q. (BNA) 561, 562 (T.T.A.B. 1975).

141. 185 U.S.P.Q. (BNA) 561 (T.T.A.B. 1975).

142. See *id.* at 561-62.

143. See *id.* at 562. The TTAB remarked that a survey of people had established that the association between the term "BUG" and Volkswagen was very strong. See *id.* For instance, the term "BUG" was used to indicate Volkswagen's cars in the Disney movie, "Love Bug," as well as in numerous magazines. See *id.*

144. See *Big Blue Prods. Inc. v. Int'l Bus. Mach. Corp.*, 19 U.S.P.Q.2d (BNA) 1072 (T.T.A.B. 1991).

145. 19 U.S.P.Q.2d (BNA) 1072 (T.T.A.B. 1991).

146. See *id.* at 1073-74.

fore the opposer began using the term on typewriter ribbons.¹⁴⁷ Despite this, the TTAB concluded that IBM was not entitled to summary judgment, as it had failed to establish that the public viewed "Big Blue" as a trademark for any particular goods or services coming from IBM.¹⁴⁸ The TTAB viewed the public's use of the term "Big Blue" as a reference to IBM itself, not its products.¹⁴⁹

In the cases discussed above, the TTAB's ultimate goal was to protect consumers from confusion as to source or sponsorship.¹⁵⁰ The courts protected the nicknames or abbreviations used by the public even though the trademark owner actually never had used them on goods or services.¹⁵¹ The use of the term by the public and media inured to the benefit of the trademark owner.¹⁵² Such cases, however, are rare.¹⁵³

III. OTHER IMPORTANT TRADEMARK CONCEPTS: CONFUSION, PRIORITY OF USE, AND "REVERSE CONFUSION"

A. Confusion

In the typical trademark infringement suit, the traditional concepts of likelihood of confusion, priority of use, and in certain cases reverse confusion, will be applied.¹⁵⁴ A discussion of these more typical concepts is necessary for an understanding of *Illinois High School Ass'n*. The test for infringement under sections 32 and 43(a) of the Lanham Act is whether there is likelihood of confusion between the plaintiff's and defendant's marks.¹⁵⁵ Confusion between two marks may cause injury to the trademark owner by diverting sales, jeopardizing goodwill, or by limiting expansion.¹⁵⁶ Accordingly, courts apply a likelihood of confusion analysis in cases where two competing entities use the same mark on

147. See *id.* (IBM submitted over 500 articles to show that "Big Blue" was associated with IBM).

148. See *id.* at 1074.

149. See *id.*

150. See *supra* Part II.B (discussing the rationale involved in the public association cases).

151. See *supra* Part II.B.1 and II.B.2.

152. See *National Cable Television Ass'n v. American Cinema Editors, Inc.*, 937 F.2d 1572, 1577-78 (Fed. Cir. 1991).

153. See *Big Blue*, 19 U.S.P.Q.2d at 1074 (stating that the TTAB has held that public association can create trademark rights in rare cases).

154. See *infra* Part III (discussing confusion, priority of use, and reverse confusion).

155. See 15 U.S.C. §§ 1114, 1125(a) (1994); see also *supra* notes 49-50 (quoting the language of the sections 32 and 43(a) of the Lanham Act).

156. See Richard L. Kirkpatrick, LIKELIHOOD OF CONFUSION IN TRADEMARK LAW § 1.2, at 1-6 (Practicing Law Institute 1995).

competing goods.¹⁵⁷ Courts take numerous factors into consideration in determining whether two marks can exist without confusing customers, including but not limited to the (1) similarity of the marks; (2) similarity of the goods; (3) area and manner of concurrent use; (4) degree of care exercised by the consumers; (5) strength of the plaintiff's mark; (6) evidence of actual confusion; and (7) intent of the defendant to pass off its goods as those of the plaintiff.¹⁵⁸ The likelihood of confusion is a question of fact and the weight accorded to each element of the analysis depends on the facts of each individual case.¹⁵⁹

B. Priority of Use

In a trademark infringement suit, the entity that used the mark first is called the "senior user" and any entity that begins use of the same mark at a subsequent time is called the "junior user."¹⁶⁰ In battles between marks of equal strength, the deciding factor typically will be who used the mark first in the geographic region in question.¹⁶¹ There is no consumer recognition or goodwill associated with mere adoption of a word as a trademark.¹⁶² The early rationale for priority of use revolved around

157. See *International Ass'n of Mach. & Aerospace Workers v. Winship Green Nursing Ctr.*, 103 F.3d 196, 200 (1st Cir. 1996); *WCVB-TV v. Boston Athletic Ass'n*, 926 F.2d 42, 44 (1st Cir. 1991); 3 MCCARTHY, *supra* note 1, § 23:1, at 23-7 to 23-8. Likelihood of confusion analysis is the keystone of common law and statutory trademark infringement. See *id.* § 23:1, at 23-8.

158. See 3 MCCARTHY, *supra* note 1, § 23:19, at 23-47 to 23-49. Each circuit has its own set of factors to be used in determining the likelihood of confusion. See, e.g., *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979) (listing the factors used in the Ninth Circuit). These factors apply equally to competitive and non-competitive goods. See 3 MCCARTHY, *supra* note 1, § 23:19, at 23-48.

159. See *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361-62 (C.C.P.A. 1973) (citing a list of factors for determining likelihood of confusion).

160. See 2 MCCARTHY, *supra* note 1, § 16:4, at 16-5.

161. See, e.g., *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 415 (1916) (priority of appropriation settles the question when both parties compete under the same mark in the same market); see also 2 MCCARTHY, *supra* note 1, § 16:4, at 16-5 (citing cases holding priority of use to be the determining factor). There are many cases on this subject. See, e.g., *United States v. Emil Steffens*, 100 U.S. 82, 94 (1879) (holding that trademark rights are "founded on priority of appropriation"); *Western Stove Co. v. Geo. D. Roper Corp.*, 82 F. Supp. 206, 213 (S.D. Cal. 1949) (stating that a trademark owner will prevail against subsequent owners).

162. See 1 JEROME GILSON & JEFFREY M. SAMUELS, *TRADEMARK PROTECTION AND PRACTICE* § 3.03(2)(d), at 3-70 to 3-72 (1998) (explaining that trademark rights hinge on the actual use of a mark). Good will is defined as "a business value that reflects the basic human propensity to continue doing business with a seller who has offered goods and services that the customer likes and has found adequate to fulfill his needs." 1 MCCARTHY, *supra* note 1, § 2:17, at 2-37.

the idea that others were attempting to “pass off”¹⁶³ their goods as those of the trademark owner.¹⁶⁴

In the aforementioned cases, courts at times recognized publicly created associations in favor of one party, but only when such public associations developed *prior* to the use of that same term by the other party.¹⁶⁵ The rationale involved in upholding trademark rights created by public association is that the infringer should not be able to take advantage of the goodwill created by that public association.¹⁶⁶ Taking advantage of the goodwill of another generates confusion as to source or sponsorship.¹⁶⁷

C. “Reverse Confusion”

Traditional trademark infringement cases often involve “forward confusion”—where consumers mistakenly believe that the goods of “junior” users emanate from the “senior” user’s source.¹⁶⁸ In this scenario, a consumer who seeks to purchase the senior user’s goods, might mistakenly purchase the junior user’s instead.¹⁶⁹ In a “reverse confusion” case, however, consumers mistakenly believe that the senior user’s goods come from the junior user.¹⁷⁰ This usually occurs after a junior user has conducted a widespread advertising and promotion campaign whereby it overpowered the senior user’s reputation in the market.¹⁷¹ The result is that consumers may think that the senior user is the infringer and is taking advantage of the reputation of the junior user.¹⁷² Reverse confusion

163. 3 MCCARTHY, *supra* note 1, § 25:1, at 25-4. The term “passing off” has been used by courts to describe situations where a seller substitutes one brand for another unbeknownst to the buyer or to situations when a defendant intends to defraud and confuse buyers. *See id.*; *Developments in the Law: Competitive Torts*, 77 HARV. L. REV. 888, 908 (1964) [hereinafter *Competitive Torts*] (describing the different meanings of “passing off”). In an 1842 British case, Lord Langdale wrote of “passing off”: “[a] man is not to sell his own goods under the pretense that they are the goods of another man.” 3 MCCARTHY, *supra* note 1, § 25:1, at 25-4 (quoting *Percy v. Trueffit*, 6 Beav. 66 (Eng. 1842)).

164. *See Competitive Torts*, *supra* note 163, at 908 (describing different meanings of “passing off”).

165. *See supra* Part II.B.1-2 (discussing trademark protection afforded abbreviations and nicknames for trademarks).

166. *See Pieper v. Playboy Enter., Inc.*, 179 U.S.P.Q. (BNA) 318, 320 (T.T.A.B. 1973) (explaining that Pieper’s use of “BUNNY CLUB” was likely to deceive the public).

167. *See id.* (stating that the use of the mark by Pieper could cause consumers to believe that it was associated with Playboy).

168. *See* 3 MCCARTHY, *supra* note 1, § 23:10, at 23-25.

169. *See id.*

170. *See id.*

171. *See id.*

172. *See id.* at 23-26.

has been held to be actionable under the Lanham Act.¹⁷³

Generally, a finding of reverse confusion will entail culpable conduct on part of the junior user.¹⁷⁴ What happens, however, when a non-culpable third party such as the media, not the junior user, causes the reverse confusion? Until 1996, this issue had not been addressed fully.¹⁷⁵ In *Illinois High School Ass'n*, the Seventh Circuit addressed this question and implicitly held that culpable conduct on the part of the junior user is required before that junior user can be held liable.¹⁷⁶ It now appears that when a non-culpable media causes reverse confusion, and the junior user does not engage in any culpable conduct, there is no infringer to sue and trademark owners will be powerless to stop this reverse confusion from happening.¹⁷⁷

IV. ILLINOIS HIGH SCHOOL ASS'N V. GTE VANTAGE INC.: TRADEMARK RIGHTS CREATED IN A JUNIOR USER THROUGH PUBLIC ASSOCIATION

The sport of basketball is extremely popular today, and thus receives a lot of media attention. This attention is especially intense each March when the NCAA holds its national championship collegiate bas-

173. See, e.g. *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 958 (7th Cir. 1992) (holding "reverse confusion" to be actionable because it invoked the same policies as a typical infringement suit: preventing customer confusion), *cert. denied*, 507 U.S. 1042 (1993), *aff'd in part, rev'd in part*, 34 F.3d 1340 (7th Cir. 1994).

174. See *Illinois High Sch. Ass'n v. GTE Vantage, Inc.*, 99 F.3d 244, 247 (7th Cir. 1996) (finding culpable conduct necessary for finding of "reverse confusion"), *cert. denied*, 117 S. Ct. 1083 (1997); *Quaker Oats*, 978 F.2d at 961. In *Quaker Oats*, a small Vermont-based company, the plaintiff, had used the mark "Thirst-Aid" for about sixty years in connection with soda fountain syrups and maltless soft drinks. See *id.* at 949-50. Thereafter, the defendant, Quaker Oats, launched a major advertising campaign for its Gatorade brand isotonic beverage using the slogan "Gatorade is Thirst Aid." See *id.* at 950-51. The plaintiff filed suit on a "reverse confusion" theory. See *id.* at 951, 957. The Seventh Circuit found Quaker Oats liable for infringement based on this theory. See *id.* at 957-61.

175. See *Illinois High Sch. Ass'n*, 99 F.3d at 245-46 (stating that the case was one of first impression).

176. See *id.* at 246-47 (holding that neither IHSA nor the NCAA were culpable). The distinction between *Illinois High School Ass'n* and the average reverse confusion case is that the NCAA, the source of the rights of GTE Vantage, was not using the mark and did not itself do anything outside of acquiescence to allow "March Madness" to become primarily associated with its tournament. See *id.* (stating that if the NCAA was responsible for eliminating the exclusive association of "March Madness" with IHSA, IHSA may have had a remedy).

177. See *id.* (no cause of action because the NCAA was not culpable); see also *infra* notes 205-07 and accompanying text (discussing reverse confusion in *Illinois High School Ass'n*). There are situations where the media could be found culpable, such as if CBS used "March Madness" to promote its broadcasts of the NCAA tournament. See *Illinois High Sch. Ass'n*, 99 F.3d at 246.

ketball tournament. Many people know the annual NCAA basketball tournament by the term "March Madness," but few realize that the term did not originate with the NCAA.

In the 1940s, IHSA coined the phrase "March Madness" to denote its annual state high school basketball tournament.¹⁷⁸ Since then, the IHSA tournament has become one of the premier high school tournaments in the country, and sometimes is televised nationally.¹⁷⁹ IHSA sells goods bearing the mark "March Madness" at its tournament site and elsewhere.¹⁸⁰ IHSA also has authorized the use of the name to other high school associations in different parts of the country,¹⁸¹ and even has licensed the use of the name to Wilson Sporting Goods, Pepsi, and the Chicago Tribune.¹⁸²

Sportscaster Brent Musburger covered the Illinois tournament as a local high school reporter in the 1970s.¹⁸³ When he joined CBS as a sports commentator, he began referring to the NCAA Men's Basketball tournament as "March Madness."¹⁸⁴ That term gained widespread recognition and, as a result, it is now common to refer to the NCAA tournament as "March Madness."¹⁸⁵

IHSA knew that sports commentators were using "March Madness" during national telecasts to refer to the NCAA tournament, but it took

178. See *id.* at 245. The origins of IHSA's use of "March Madness" can be traced to a 1942 poem by H.V. Porter. See Brief of Defendant/Appellee GTE Vantage Inc. at 2-3, *Illinois High Sch. Ass'n v. GTE Vantage Inc.*, 99 F.3d 244 (7th Cir. 1996) (No. 96-1981) [hereinafter Brief of GTE Vantage]. Porter wrote of the IHSA tournament: "A sharp-shooting mite is king tonight / *The Madness of March* is running." George Vecsey, *The March Madness Has Already Begun*, N.Y. TIMES, March 5, 1995, § 8 (Sports), at 7 (emphasis added). This poem has been credited with sparking the phrase. See Brief of GTE Vantage, *supra*, at 2. IHSA used the phrase in its tournament souvenir programs, as well as in a 1977 book entitled MARCH MADNESS: THE HISTORY OF HIGH SCHOOL BASKETBALL IN ILLINOIS. See *id.* at 3. In the early 1980s, IHSA also began using "March Madness" on various souvenir merchandise sold at the tournament sites and at retail stores in Illinois. See *id.* at 7-8.

179. See *Illinois High Sch. Ass'n*, 99 F.3d at 245.

180. See *id.*; see also *infra* note 182 (discussing the merchandising of the mark "March Madness").

181. See Brief of Illinois High School Association, *supra* note 39, at 4.

182. See *id.* at 4-5. IHSA had licensed the use of "March Madness" to Pepsi for use on in-store displays and on Pepsi cans, to Wilson Sporting Goods for use on basketballs, and to the Chicago Tribune for use on its Web-site. See *id.*

183. See Vecsey, *supra* note 178, at 7.

184. See *id.* Musburger said in an interview that he was certain that he got the phrase "March Madness" from his days of covering the IHSA tournament. See *id.*

185. See *Illinois High Sch. Ass'n*, 99 F.3d at 245. See generally Brief of GTE Vantage, *supra* note 178, at 4-7 (providing illustrative examples of media uses of "March Madness" in reference to the NCAA basketball tournament).

no action against either the media or the NCAA to enforce its prior trademark rights to the expression.¹⁸⁶ When it finally did act, IHSA's choice of action itself was limited. Until it began licensing "March Madness" in 1993, the NCAA neither used the mark on goods nor used it in advertising connected with the collegiate tournament.¹⁸⁷ The sports commentators had been using "March Madness" to describe the NCAA tournament.¹⁸⁸ Also, the general public had begun to use the term "March Madness" to refer to the NCAA tournament.¹⁸⁹ As a result, IHSA was essentially powerless to stop the media and public usage of the phrase due to the First Amendment protections afforded to members of the press and the public.¹⁹⁰

IHSA finally acted after the NCAA licensed the use of "March Madness" to the video game manufacturer, GTE Vantage, for its use in connection with a basketball CD-ROM game.¹⁹¹ Motivated by the thought of losing valuable royalties, IHSA brought an action in the United States District Court for the Central District of Illinois seeking to enjoin GTE Vantage from using its mark.¹⁹² The district court denied the injunction, holding first that IHSA's rights were limited to its tournament and second, that its attempts to expand had come after widespread media use in favor of the NCAA, which, in turn, gave the NCAA common law trademark rights with respect to its own tournament.¹⁹³ The district court also held that IHSA had not established a likelihood of confusion as a result

186. See *Illinois High Sch. Ass'n*, 99 F.3d at 245-46. At the district court level, IHSA had stated that it was not concerned about non-commercial uses of the mark by the NCAA or anyone else. See *Illinois High Sch. Ass'n v. GTE Vantage Inc.*, No. 96-1119, at 49-50 (C.D. Ill. March 20, 1996) (hearing on motion for preliminary injunction).

187. See *Illinois High Sch. Ass'n*, 99 F.3d at 245 (stating that the NCAA began licensing "March Madness" in 1993 or 1994); see also *Petition for a Writ of Certiorari*, *supra* note 27, at 6 (stating that IHSA had not used the "March Madness" mark).

188. See generally *Brief of Illinois High School Association*, *supra* note 39, at 18 (citing examples of use of "March Madness" in print media). The Seventh Circuit did acknowledge, however, that IHSA may have had a cause of action against CBS had the network used "March Madness" to promote its broadcasts of the NCAA tournament. See *Illinois High Sch. Ass'n*, 99 F.3d at 246. The court, however, refused to speculate on the merits of such a suit. See *id.*

189. See *Illinois High Sch. Ass'n*, 99 F.3d at 245.

190. See *id.* at 246.

191. See *Brief of GTE Vantage*, *supra* note 178, at 13. GTE Vantage was using "March Madness" on its web page, in magazine advertisements, and on one of the computer screens appearing in the game. See *id.*

192. See *id.* IHSA in fact demanded that GTE Vantage cease using "March Madness" or negotiate a license to use the term with IHSA. See *id.*

193. See *Illinois High Sch. Ass'n v. GTE Vantage, Inc.*, No. 96-1119, at 100, 104 (C.D. Ill. Mar. 20, 1996).

of GTE Vantage's licensed use.¹⁹⁴ The district court made this determination despite the fact that the marks were identical and both were used in connection with basketball.¹⁹⁵ It found the competing marks to be dissimilar, in that one clearly pointed to products related to high school basketball and the other pointed to products related to college basketball.¹⁹⁶ The area and manner of concurrent use also was different—IHSA's use was primarily regional, while the NCAA's use was national in scope.¹⁹⁷ Furthermore, the district court held that consumers were not likely to purchase a video game dealing with high school basketball when they were looking specifically for one dealing with college basketball.¹⁹⁸ Moreover, the district court believed that the widespread media use had severely weakened IHSA's mark.¹⁹⁹ As such, the court deemed the license given by the NCAA to GTE Vantage, for the use of "March Madness" in connection with a CD-ROM game based on the NCAA basketball tournament, to be non-actionable by IHSA.²⁰⁰

IHSA appealed to the United States Court of Appeals for the Seventh Circuit, arguing that media use could not divest a trademark owner of its prior rights by transferring those rights to another who technically had not used the trademark.²⁰¹ Without directly addressing this argument, the Seventh Circuit found that "March Madness" had, in the minds of the public, come to mean the NCAA tournament as well as the IHSA tour-

194. See *id.* at 103-04; see also Respondent's Brief, *supra* note 27, at 2.

195. See *Illinois High Sch. Ass'n*, No. 96-1119, at 100-01 (hearing on motion for preliminary injunction).

196. See *id.* at 101. The modern test for the similarity of goods is the "related goods" test. See 3 MCCARTHY, *supra* note 1, § 24:6, at 24-13 to 24-14. A closely related product is one "which would reasonably be thought by the buying public to come from the same source, or thought to be affiliated with, connected with, or sponsored by, the trademark owner." *Id.* at 24-12 to 24-13; see also *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 958 (7th Cir. 1992) (relying on the "related goods" test to determine the likelihood of confusion), *cert. denied*, 507 U.S. 1042 (1993), *aff'd in part, rev'd in part*, 34 F.3d 1340 (7th Cir. 1994).

197. See *Illinois High Sch. Ass'n*, No. 96-1119, at 102 (hearing on motion for preliminary injunction). Trademark rights often depend on the geographic scope of use, because there is no protection where an entity has not used its trademark. See *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 98 (1918) (holding that trademark rights extend only as far as where the mark has been used).

198. See *Illinois High Sch. Ass'n*, No. 96-1119, at 102 (hearing on motion for preliminary injunction).

199. See *id.* at 100, 103.

200. See *id.* at 104.

201. See *Illinois High Sch. Ass'n v. GTE Vantage, Inc.*, 99 F.3d 244, 245 (7th Cir. 1996), *cert. denied*, 117 S. Ct. 1083 (1997); Brief of Illinois High School Association, *supra* note 39, at 12-20. Actual trademark use is use of a mark on or in connection with goods or services in commerce. See 15 U.S.C. § 1127 (1994) (defining use in commerce).

nement.²⁰² For that reason, the Seventh Circuit refused to enjoin GTE Vantage.²⁰³

In making this determination, the Seventh Circuit created a new classification of trademark, a “dual-use” mark, which allowed both the NCAA and IHSA to use “March Madness” in connection with their respective basketball tournaments.²⁰⁴ IHSA argued that a “dual-use” of the term “March Madness” would cause reverse confusion because consumers would think that the NCAA sponsored both IHSA’s tournament and the IHSA-licensed merchandise affixed with the trademark “March Madness.”²⁰⁵ In essence, IHSA asserted that, to consumers, IHSA would appear to be the trademark infringer.²⁰⁶

The Seventh Circuit rejected IHSA’s reverse confusion argument.²⁰⁷ The court held that a court need not resolve the issue of likelihood of confusion unless “the plaintiff has a trademark that the law will protect.”²⁰⁸ The court reasoned that because the public had come to associate the term “March Madness” with the NCAA tournament, and not only the IHSA tournament, IHSA did not have any rights to the term that would bar GTE Vantage’s licensed use.²⁰⁹

IHSA also argued “that it [was] unfair [for] its [trademark] rights [to] depend on the whims of the media,” because neither IHSA nor a court could have stopped the media from using the term “March Madness” due to First Amendment concerns.²¹⁰ In response to this argument, the

202. See *Illinois High Sch. Ass’n*, 99 F.3d at 246-47.

203. See *id.* at 248.

204. See *id.* at 247; Fletcher & Kera, *supra* note 26, at 797 (stating that “dual-use” terms are “another category of trademark”).

205. See *Illinois High Sch. Ass’n*, 99 F.3d at 246. The court did not consider the issue of reverse confusion because the issue of confusion arises only when “the plaintiff has a trademark that the law will protect.” *Id.* The Seventh Circuit held that IHSA did not have such a trademark. See *id.*

206. See *id.*

207. See *id.* at 246-47. The court stated that had the NCAA itself been responsible for the weakening of the association of “March Madness” with IHSA, IHSA might have a remedy on a theory of reverse confusion. See *id.* The court stated further, however, that it probably would not be an injunctive remedy because that would promote even more confusion among consumers. See *id.* Therefore, if an injunction was not appropriate, the court probably would award damages. See *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 961-63 (7th Cir. 1992) (awarding large damages including profits, attorney’s fees, and prejudgment interest in a reverse confusion case), *cert. denied*, 507 U.S. 1042 (1993), *aff’d in part, rev’d in part*, 34 F.3d 1340 (7th Cir. 1994).

208. See *Illinois High Sch. Ass’n*, 99 F.3d at 246. The court determined that IHSA’s mark was not protectable with respect to the NCAA basketball tournament. See *id.*

209. See *id.*

210. See *id.*

court admonished IHSA for its belated efforts to protect its mark, and emphasized that trademark owners must take steps to protect the strength of their trademarks by endeavoring to convince the media and others to avoid using their marks in reference to anything other than the trademarked goods.²¹¹ The court found that “IHSA was not assiduous” enough in protecting its mark because IHSA had allowed the media to use the term for a long time without ever taking action to halt that use.²¹² The Seventh Circuit also explained that, because a trademark is primarily a designation of its source, the trademark “dies” when the designation of its source ceases to exist, as long as the potential defendant is not responsible for the trademark’s inability to denote its source.²¹³

Here, because neither the NCAA nor GTE Vantage were responsible for the weakening of IHSA’s mark, the court refused to enjoin GTE Vantage’s licensed use of the mark.²¹⁴ The Seventh Circuit analogized IHSA’s situation to previous cases discussing generic marks.²¹⁵ The court explained that principles of effective communication mandated a denial of trademark rights in this case, as is the normal case with generic terms.²¹⁶ IHSA argued, however, that “March Madness” was not a generic term for basketball tournaments in general nor “any other set of events, that occur in March.”²¹⁷ The court responded that, whether or not “March Madness” was a generic term, legal principles prevented trademark owners from removing words “from the public domain . . . that the public [uses] to [identify] someone else’s good[s] or service[s].”²¹⁸ Such a situation would “leav[e] that someone and his customers speechless.”²¹⁹ Thus, for purposes of promoting effective communication, the court would not allow IHSA to enjoin GTE Vantage from using the term.²²⁰ Further, the court held that the mark “March Madness” was a

211. *See id.*

212. *See id.*

213. *See id.* The court said “[w]hat matters is that a trademark is not nearly so secure an entitlement as a property right.” *Id.* The court elaborated further in stating that even an anti-dilution statute will not save a trademark that has lost its source denoting capability. *See id.* at 247.

214. *See id.* at 246-47.

215. *See id.*; *see also infra* Part V.C.2 (discussing generic terms and the importance of effective communication).

216. *See Illinois High Sch. Ass’n*, 99 F.3d at 247.

217. *See id.*

218. *See id.*

219. *See id.*

220. *See id.* The court stated that “for the sake of protecting effective communication it should be resolved against trademark protection, thus assimilating dual-use or multiple-use terms to generic terms.” *Id.*

“dual-use term,” one that identified both the NCAA tournament and the IHSA tournament, thus permitting IHSA and the NCAA to use the term concurrently.²²¹

IHSA also argued that media use cannot divest a trademark owner of its exclusive rights to a mark and urged the court to rely on *Lucasfilm Ltd. v. High Frontier*,²²² a case where a federal district court refused to enjoin various public interest groups from referring to the Strategic Defense Initiative (SDI) as “Star Wars.”²²³ The *Lucasfilm* court noted that its holding would not hamper Lucasfilm’s exclusive rights to use “Star Wars” in connection with sales of its goods and services.²²⁴ After explaining that *Lucasfilm* was not on point, the Seventh Circuit presented an interesting hypothetical: “If someone bought rights to the SDI from the U.S. government and sold the anti-missile program to another country under the name ‘Star Wars,’ nothing in the *Lucasfilm* opinion or . . . trademark law would entitle Lucasfilm to enjoin that use of the name” because “[t]he name would have become attached by the public to another product as well as to the movies, just as happened here.”²²⁵ Therefore, the Seventh Circuit refused to accept IHSA’s interpretation of *Lucasfilm*; namely, that trademark owners have nothing to fear from communicative uses of trademarks.²²⁶

Lastly, the Seventh Circuit declined to “opine on the scope of the trademark rights that either IHSA or [the] NCAA” had beyond those related to GTE Vantage’s video game or the NCAA tournament.²²⁷ The IHSA sought review by the United States Supreme Court.²²⁸ In its petition for a writ of certiorari, IHSA argued that allowing public and media use to usurp its prior exclusive rights in “March Madness” was not in accord with trademark precedent and would upset the balance between trademark protection and the First Amendment.²²⁹ GTE Vantage countered that public and media use gave the NCAA trademark rights to use

221. *See id.*

222. 622 F. Supp. 931 (D.D.C. 1985).

223. *See id.* at 935.

224. *See id.* (stating that “[t]he new meaning of the phrase in the political or scientific context does not affect the distinct, and still strong secondary meaning of “STAR WARS” in trade and entertainment”).

225. *Illinois High Sch. Ass’n*, 99 F.3d at 247-48.

226. *See id.*; *see also* Petition for a Writ of Certiorari, *supra* note 27, at 12 (stating that “[t]raditionally, trademark owners have had nothing to fear from communicative, non-commercial uses of their marks”).

227. *Illinois High Sch. Ass’n*, 99 F.3d at 248.

228. *See generally* Petition for a Writ of Certiorari, *supra* note 27, at 1.

229. *See id.* at 7-13.

the term in connection with its tournament.²³⁰ The Supreme Court eventually denied IHSA's petition without comment.²³¹

V. JUDICIAL CREATION OF "DUAL-USE" TERMS IN *ILLINOIS HIGH SCHOOL ASS'N V. GTE VANTAGE INC.*

The Seventh Circuit held that, for the sake of effective communication, the NCAA should be able to continue using the term "March Madness" because a clear majority of the public identified that term with the NCAA, not IHSA.²³² Implicitly, the Seventh Circuit held that media and public use had created common law trademark rights in the NCAA to use the mark exclusively in connection with its tournament.²³³ That same widespread media use essentially weakened IHSA's exclusive rights in the mark "March Madness."²³⁴ Consequently, both the NCAA and IHSA were allowed to continue using the term "March Madness" for their respective basketball tournaments.²³⁵ No case before had ever held that public association could compromise exclusive trademark rights of a prior user in favor of a third party who technically never had used the trademark.²³⁶ The court labeled this unique trademark a "dual-use" term.²³⁷

In creating "dual-use" marks, the Seventh Circuit recognized what could be seen as forced co-ownership of a trademark among unrelated

230. See Respondent's Brief, *supra* note 27, at 9.

231. See *Illinois High School Ass'n v. GTE Vantage Inc.*, 117 S. Ct. 1083 (1997).

232. See *Illinois High Sch. Ass'n*, 99 F.3d at 247.

233. See *id.* at 246-47. Although the Seventh Circuit did not explicitly state this, it was the decision of the district court. See *Illinois High Sch. Ass'n v. GTE Vantage Inc.*, No. 96-1119, at 100 (C.D. Ill. March 20, 1996) (hearing on motion for preliminary injunction) (denying injunction based upon NCAA's rights obtained through public and media use).

234. See *Illinois High Sch. Ass'n*, 99 F.3d at 247; see also *Illinois High Sch. Ass'n v. GTE Vantage Inc.*, No. 96-1119, at 103 (C.D. Ill. March 20, 1996) (hearing on motion for preliminary injunction) (discussing how the media's extensive use weakened IHSA's exclusive rights in the mark).

235. See *Illinois High Sch. Ass'n*, 99 F.3d at 247-48.

236. See *id.* at 247; see also Petition for a Writ of Certiorari, *supra* note 27, at 8. The court said that the case raised a "novel issue of trademark law." See *Illinois High Sch. Ass'n*, 99 F.3d at 245. Prior cases had recognized that public association could vest one with trademark rights. See *supra* Part II.B.1-2 (discussing trademark protection afforded abbreviations and nicknames for trademarks). Those cases, however, involved a plaintiff whose public association was created before the defendant had begun using the mark. See *supra* Part II.B.1-2.

237. See *Illinois High Sch. Ass'n*, 99 F.3d at 247. A few cases recognized terms with a dual usage in the generic terms context. See *supra* note 81 and accompanying text (discussing *Bayer Co. v. United Drug Co.*, 272 F. 505 (S.D.N.Y. 1921)).

entities.²³⁸ What the court created, or perhaps simply endorsed, was a type of trademark that multiple parties could use.²³⁹ Now, when one segment of consumers comes to associate a mark with one source and another segment of consumers eventually comes to associate the mark with an entirely different source, a “dual-use” mark may exist.²⁴⁰ How often “dual-use” terms will arise in future trademark cases remains uncertain, however, because “dual-use” rights appear to be derived only from public or media use.²⁴¹

A. *The Validity of “Dual-Use” Terms*

1. *The NCAA Had Acquired Common Law Trademark Rights in “March Madness” Through Public and Media Use*

In some respects, the Seventh Circuit’s creation of “dual-use” rights in favor of IHSA and the NCAA seems contrary to basic principles of trademark law.²⁴² Trademark rights traditionally arise out of actual use in

238. See generally *Illinois High Sch. Ass’n*, 99 F.3d at 247; Petition for a Writ of Certiorari, *supra* note 27, at 4. The joint ownership of trademarks has been approved judicially; in addition the United States Patent and Trademark Office will accept an application by joint applicants for a trademark in “appropriate circumstances.” See *In re Diamond Walnut Growers, Inc.*, 204 U.S.P.Q. (BNA) 507, 509-10 (T.T.A.B. 1979); *Ex parte Edward Taylor*, 18 U.S.P.Q. (BNA) 292, 293 (Comm’r Pats. 1933); 2 MCCARTHY, *supra* note 1, §§ 16:40-16:45, at 16-51 to 16-62 (discussing problems with joint ownership of trademarks). However, courts and commentators often look on joint ownership of trademarks with disfavor. See 2 MCCARTHY, *supra* note 1, §§ 16:40-16:45, at 16-51 to 16-62; see also J. Thomas McCarthy, *Joint Ownership of a Trademark*, 73 TRADEMARK REP. 1 (1983) (arguing that there are problems with multiple owners of a single mark).

239. See *Illinois High Sch. Ass’n*, 99 F.3d at 247; Petition for a Writ of Certiorari, *supra* note 27, at 4. In its reply brief to IHSA’s Petition for a Writ of Certiorari, GTE Vantage argued that “the Seventh Circuit did not ‘create a new ‘dual-use’ trademark,’” and that the concept of “dual-use” of trademarks was “hardly novel.” Respondent’s Brief, *supra* note 27, at 15.

240. See *Illinois High Sch. Ass’n*, 99 F.3d at 247.

241. See generally *id.* at 246. The issue presented in *Illinois High School Ass’n* arose recently in *Dream Team Collectibles, Inc. v. NBA Properties, Inc.*, 958 F. Supp. 1401 (E.D. Mo. 1997), when NBA Properties sought summary judgment against a prior user of the mark based on NBA Properties’ superior right to the term “Dream Team” acquired through public association. See *id.* at 1411. The court declined to apply *Illinois High School Ass’n* under the facts of the case because the NBA and U.S.A. Olympic Basketball, for the most part, were responsible for the public association. See *id.* at 1410. The court in this case noted that this situation differed from *Illinois High School Ass’n* because in that case, the media was solely responsible for creating the public association. See *id.* In April 1997, the parties reportedly settled and the NBA acquired rights to use “Dream Team” for an undisclosed sum. See Fred Faust, *Trademarks: Little Guy Fights Back*, NAT’L L.J., May 19, 1997, at B1-B2.

242. See Petition for a Writ of Certiorari, *supra* note 27, at 7-9.

commerce, not by mere adoption.²⁴³ The mere invention or appropriation of a word or phrase generally has not been enough to acquire trademark rights.²⁴⁴ Yet even the law prior to *Illinois High School Ass'n* recognized the acquisition of trademark rights through public and media use alone.²⁴⁵ One court suggested that use by the public or media could inure to the benefit of the trademark owner.²⁴⁶ Other cases focused on preventing entities from capitalizing on the association created by public and media use that had already been established in favor of the party claiming trademark rights.²⁴⁷ For example, in *Coca-Cola v. Busch*,²⁴⁸ where the defendant was using the mark "Koke-Up" and, therefore, exploiting the goodwill that Coca-Cola had acquired in the mark "Coke," the court enjoined Busch's use, despite the fact that only the public had made use of the mark "Coke," not the Coca-Cola Company itself.²⁴⁹

In *Illinois High School Ass'n*, the court enforced the NCAA's rights in a similar fashion to the public association cases.²⁵⁰ The good will associated with the use of the mark "March Madness" in conjunction with GTE Vantage's game, NCAA Championship Basketball, belonged almost entirely to the NCAA.²⁵¹ As such, the court reasoned that it would be unfair for IHSA to be allowed to control the use of the mark "March Madness" in connection with the NCAA tournament.²⁵² What IHSA apparently wanted, GTE Vantage argued, was to receive a windfall by controlling the licensing of the mark "March Madness" in connection with

243. See *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918) (stating that a trademark must be used "in connection with an existing business").

244. See *id.*

245. See *supra* Part II.B.1-2 (analyzing cases that recognized trademark rights through public association).

246. See *National Cable Television Ass'n v. American Cinema Editors, Inc.*, 937 F.2d 1572, 1577-78 (Fed. Cir. 1991).

247. See, e.g. *Pieper v. Playboy Enter., Inc.*, 179 U.S.P.Q. (BNA) 318, 320 (T.T.A.B. 1973) (finding Playboy's use of bunnies to preclude Pieper's use of the term "BUNNY CLUB" because of the public's association of bunnies with Playboy); *Coca-Cola Co. v. Busch*, 44 F. Supp. 405, 410 (E.D. Pa. 1942) (using the doctrine of unfair competition to protect against the use of an abbreviated version of the mark).

248. 44 F. Supp. 405 (E.D. Pa. 1942).

249. See *id.* at 410; see also *Pieper*, 179 U.S.P.Q. at 320.

250. See *Illinois High Sch. Ass'n v. GTE Vantage Inc.*, 99 F.3d 244, 247-48 (7th Cir. 1996), *cert. denied*, 117 S. Ct. 1083 (1997). The court reasoned that IHSA did not have a strong enough trademark to assert against GTE Vantage's use in connection with the NCAA tournament. See *id.*

251. See *id.* at 245-46.

252. See *id.* at 247; see also *Boston Athletic Ass'n v. Sullivan*, 867 F.2d 22, 32 (1st Cir. 1989) (holding that the Boston Athletic Association (BAA) was entitled to control the merchandise surrounding the Boston Marathon because of the public's association of the marathon with BAA).

the NCAA tournament.²⁵³ In cases dealing with merchandise relating to an event however, precedent indicates that it is the event sponsor who generally has the right to control the merchandise related to the event.²⁵⁴ Moreover, it was clearly the NCAA, through CBS, who made the term "March Madness" famous.²⁵⁵ Granting IHSA exclusive licensing rights to the mark "March Madness" in connection with the NCAA tournament would have allowed it "to reap where it had not sown."²⁵⁶ Thus, the court held that only the NCAA should be allowed to license the mark in connection with the NCAA tournament.²⁵⁷

2. *The Seventh Circuit Assimilated "Dual-Use" Terms to Generic Terms*

The Seventh Circuit based its decision in part on the need to protect effective communication in the marketplace.²⁵⁸ It recognized the common tendency of people to call something by the name that most quickly comes to mind.²⁵⁹ If the media referred to the NCAA tournament as "March Madness," then that is the name the public would invoke when referring to the NCAA tournament.²⁶⁰ The court analogized "dual-use" terms to generic terms, because this pattern involving a "dual-use" term was similar to that in cases involving generic terms.²⁶¹ In both situations, the court reasoned, the law should protect effective communication, even to the detriment of trademark rights.²⁶²

The focus in generic cases is on what consumers understand the term

253. See Brief of GTE Vantage, *supra* note 178, at 34.

254. See *Boston Athletic Ass'n*, 867 F.2d at 32, 34 (holding that the sponsor of Boston Marathon had right to control promotional merchandise); *Brockum Co. v. Blaylock*, 729 F. Supp. 438, 444 (E.D. Pa. 1990) (holding that defendant was not entitled to take a "free ride" at the plaintiff's expense by selling unauthorized t-shirts at a Rolling Stones' concert).

255. See Respondent's Brief, *supra* note 27, at 3.

256. *International News Serv. v. The Assoc. Press*, 248 U.S. 215, 239 (1918) (holding that it was an unfair practice for the defendant to sell news gathered by the plaintiff); see also *Illinois High Sch. Ass'n*, 99 F.3d at 246-47.

257. See *Illinois High Sch. Ass'n*, 99 F.3d at 248.

258. See *id.* at 247. The court chose to protect communication rather than a trademark, so as not to leave sports fans "speechless." See *id.*

259. See *id.* at 246; see also *supra* Part II.B.1-2 (citing cases recognizing trademark rights in abbreviations of common trademarks and nicknames).

260. See *Illinois High Sch. Ass'n*, 99 F.3d at 246. The court commented that the public refers to the NCAA tournament as "March Madness" because most people gain their college basketball knowledge from the media. See *id.*

261. See *id.* at 247.

262. See *id.*

to mean.²⁶³ For example, if the public knows the pain reliever acetyl salicylic acid only as “ASPIRIN,” then the public will call it “ASPIRIN.”²⁶⁴ The public likely would continue to call all acetyl salicylic acid tablets “ASPIRIN,” regardless of the steps the trademark owner took to prevent the generic use.²⁶⁵ Similar issues were present with the term “March Madness.”²⁶⁶

The public policy behind denying trademark protection to generic terms is that one should not have a monopoly on a term that competitors need to describe their products.²⁶⁷ With respect to “dual-use” terms, similar public policy concerns are present; that is, it would be unfair for IHSA to have a monopoly on the term “March Madness” when the majority of the public is using the term to refer to the NCAA tournament.²⁶⁸ Based on a generic terms analogy, the public should be allowed to continue to denote and understand the NCAA tournament as “March Madness,” because, as in the generic terms cases, the public has used the term “March Madness” to mean something other than IHSA trademarked goods and services.²⁶⁹ Therefore, the court’s utilization of “March Madness” as a “dual-use” term is a natural expansion of the generic terms doctrine, at least in terms of the rationale employed to justify them.²⁷⁰

3. “Dual-Use” Marks Can Designate More Than One Source

One of the most notable aspects emerging from the *Illinois High School Ass’n* decision is the apparent conflict of the court’s recognition of “dual-use” terms with the important principle that a trademark acts as an indicator of origin, serving to designate a single source of goods, whether or not the source is anonymous.²⁷¹ Following this new “dual-

263. See *supra* note 74 and accompanying text. If a court determines that the mark has become the name of the product itself, the court must withdraw the mark from trademark protection and allow it to move into the public domain in order to foster effective communication in the marketplace. See *supra* Part II.A (discussing generic terms).

264. See *Bayer Co. v. United Drug Co.*, 272 F. 505, 509 (S.D.N.Y. 1921) (holding “ASPIRIN” to be a generic term).

265. See *id.*

266. See *Illinois High Sch. Ass’n*, 99 F.3d at 247 (assimilating “dual-use” terms to generic terms).

267. See 2 MCCARTHY, *supra* note 1, § 12:2, at 12-6 to 12-7 (quoting Judge Posner’s example of how trademark protection of the word “car” would impact negatively the automobile sales industry).

268. See *Illinois High Sch. Ass’n*, 99 F.3d at 247; 2 MCCARTHY, *supra* note 1, § 12:2, at 12-6 to 12-7.

269. See *Illinois High Sch. Ass’n*, 99 F.3d at 247.

270. See *id.* (holding that “dual-use” terms should be assimilated with generic terms).

271. See *Petition for a Writ of Certiorari*, *supra* note 27, at 8; see also *Illinois High Sch.*

use” rubric, a trademark may now identify more than one source for a particular type of good or service.²⁷² IHSA argued that allowing two separate parties to use the same mark on similar goods cuts against the very foundation upon which trademark law rests—protecting consumers from confusion.²⁷³ The Seventh Circuit’s opinion however, did not address the issue of confusion arising from “dual-use” of the term.²⁷⁴ Moreover, the opinion was silent on the issue of concurrent use rights.²⁷⁵ The Seventh Circuit’s lack of guidance on these issues leaves questions regarding consumer confusion and “dual-use” rights unanswered.

B. Quantifying the Rights of Each Dual-User: A Potential Trouble Spot with “Dual-Use” Terms as Set Forth in Illinois High School Ass’n

In its decision, the Seventh Circuit declined to “opine on the scope of the trademark rights that [both] IHSA [and] NCAA” possessed beyond those in connection with the license to GTE Vantage and those associated with the NCAA tournament.²⁷⁶ Logically, it would seem that the NCAA should have rights only to use “March Madness” in connection with goods relating to its tournament, whereas the IHSA should have rights appurtenant only to its tournament. The court stated however, that “March Madness” had a strong association primarily with the NCAA Tournament;²⁷⁷ therefore it is possible that the NCAA’s rights in

Ass’n, 99 F.3d at 247.

272. See *Illinois High Sch. Ass’n*, 99 F.3d at 247; see also *Petition for a Writ of Certiorari*, *supra* note 27, at 8.

273. See *Illinois High Sch. Ass’n*, 99 F.3d at 246; *Petition for a Writ of Certiorari*, *supra* note 27, at 8. When a consumer confronts goods bearing identical trademarks which, unbeknownst to the consumer, emanate from two separate sources, the consumer cannot rely on the trademark to identify the particular good that he or she has enjoyed in the past. See 1 MCCARTHY, *supra* note 1, § 2:4, at 2-5 (arguing that “image differentiation” aids consumers in rewarding high quality producers through repeat purchases) (quoting F.M. SCHERER, *INDUSTRIAL MARKET STRUCTURE AND ECONOMIC PERFORMANCE* 378 (2d ed. 1980)). Additionally, the consumer will not be able to buy consistently goods of the same expected level of quality. See 1 MCCARTHY, *supra* note 1, § 2:5, at 2-8.

274. See *Illinois High Sch. Ass’n*, 99 F.3d at 246 (holding that the “issue of likelihood of confusion does not arise . . . until it is determined that the plaintiff has a trademark that the law will protect”); *Petition for a Writ of Certiorari*, *supra* note 27, at 9 (arguing that “dual-use” of “March Madness” by IHSA and the NCAA will “cloud” each party’s duties and obligations).

275. See *supra* note 35 (discussing concurrent use rights).

276. See *Illinois High Sch. Ass’n*, 99 F.3d at 248.

277. See *id.* at 247. The Seventh Circuit reasoned that IHSA’s mark had been weakened by the widespread media use. See *id.* at 246. “All trademarks are not equal,” as strong marks are given more protection over a broad range of goods and services, and weak marks are given less protection and over a more narrow range. See 2 MCCARTHY, *supra* note 1, § 11:73, at 11-128.

"March Madness" might extend well beyond goods relating to its basketball tournament, such as to other basketball-related goods.²⁷⁸ Consequently, it is unclear to whom another high school association should turn for a license if it wants to use the term "March Madness."²⁷⁹ The court's holding has left uncertain the trademark licensing activities of both IHSA and the NCAA with respect to the mark, "March Madness."²⁸⁰

If a court grants "dual-use" rights to two parties, questions may arise as to who will have the right and obligation to police use of the mark by others.²⁸¹ Each party's exercise or failure to exercise its rights may have an effect on the strength of the mark and, as a result, the other party's rights.²⁸² For example, one party's failure to take action against a third-party use may undermine the strength of the "dual-use" mark.²⁸³ Furthermore, one party's failure to prevent generic use of the "dual-use" mark may cause the mark to lose all trademark significance for both parties.²⁸⁴ Using the same reasoning, it is uncertain whether one party's proper policing efforts will protect both users of the "dual-use" mark or just one of them.²⁸⁵

278. See Petition for Certiorari, *supra* note 27, at 9 (stating that there is uncertainty as to who must police the marks on goods like basketballs).

279. See *id.* To date, the NCAA has filed three trademark applications to register "March Madness." Search of LEXIS, TRDMRK Library, ALLTM File (Feb. 8, 1999). Two of these applications are limited to goods and services related to college basketball. See *id.* The third application is simply for sporting goods, namely basketballs and backboards. See *id.* All three applications currently are suspended. See *id.*

IHSA, on the other hand, has three registrations for "America's Original March Madness." See *id.* It also has three applications for "March Madness" that currently are suspended. See *id.* The IHSA also has one registration for "March Madness" which it purchased from Intersport. See *id.*; see also Brief of GTE Vantage, *supra* note 178, at 9-11 (discussing the circumstances surrounding the Intersport registration).

280. See Glen Elsasser, *No Advantage for IHSA in "March Madness"; Supreme Court Stays Out of Trademark Battle*, CHI. TRIB., Feb. 25, 1997, § 4, at 2 (discussing the licensing activities of IHSA before the suit).

281. See Petition for a Writ of Certiorari, *supra* note 27, at 9.

282. See *id.*

283. See *id.*; see also 2 MCCARTHY, *supra* note 1, § 11:85, at 11-144 (discussing the relationship between strength and third party use).

284. See Petition for a Writ of Certiorari, *supra* note 27, at 9; *infra* Part V.C.2 (discussing generic terms issues).

285. See Petition for a Writ of Certiorari, *supra* note 27, at 9.

C. *The Strength of Trademarks and Free Speech Concerns with “Dual-Use” Terms*

1. *The First Amendment and Trademarks*

Sections 32 and 43(a) of the Lanham Act give trademark owners a cause of action against infringers.²⁸⁶ To be considered an infringer under the Lanham Act, the defendant must have *used the mark in connection with goods or services*.²⁸⁷ The Lanham Act does not address situations where one uses a mark communicatively by expressing an idea or conveying a message and, consequently, not using the term “in commerce” in connection with advertising goods and services.²⁸⁸

First Amendment protection is afforded to those using trademarks to convey messages and not to those who merely sell products.²⁸⁹ The protections exist because “[t]rademarks [often] form an important part of the public dialog on economic and social issues.”²⁹⁰ Allowing the law to restrict the use of trademarks that are used solely in a communicative manner, would have a chilling effect on such dialog.²⁹¹ Consequently, a trademark owner has no cause of action against public and non-commercial use of its mark.²⁹²

2. *Free Speech and Generic Terms*

As evidenced by cases discussing generic terms, trademark owners must be cautious when dealing with the media, book and dictionary publishers, and other non-commercial users that possess the ability to alter

286. See 15 U.S.C §§ 1114, 1125 (1994). Trademarks also often are protected by state common law. See 1 MCCARTHY *supra* note 1, § 2:7, at 2-12.

287. See 15 U.S.C. §§ 1114, 1125(a); see also *supra* notes 49-50 (quoting the language of the statute).

288. See 15 U.S.C. §§ 1114, 1125(a). There is also a broadcast exception to section 32(2) of the Lanham Act, which limits the ability of trademark owners to bring actions against newspaper and magazine publishers, and other electronic communicators, in connection with those entities' advertisements containing alleged trademark infringements. See *id.* § 1114(2).

289. See *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 27, 29 (1st Cir. 1987) (refusing to enjoin defendant's use of plaintiff's mark in a two page magazine article entitled “L.L. Bean's Back-To-School-Sex-Catalog”); see also 5 MCCARTHY, *supra* note 1, § 31:147, at 31-213 (stating that commercial speech receives less First Amendment protection than “political” or “social” speech). *But see Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1183, 1192-93 (E.D.N.Y. 1972) (enjoining defendant's use of slogan “Enjoy Cocaine” on posters bearing logo similar to Coca-Cola's logo).

290. 5 MCCARTHY, *supra* note 1, § 31:146, at 31-213.

291. See *id.*

292. See *infra* Part V.C.3 (discussing free speech concerns with trademarks).

the nature or strength of their trademark.²⁹³ There does not appear to be any sure legal recourse, however, against these entities.²⁹⁴ Therefore, trademark owners are forced to devise other means of convincing the media and public to treat their trademarks properly.²⁹⁵ To prevent a mark from becoming generic, a trademark owner should ensure that its mark is always used as an adjective and never as a noun or verb.²⁹⁶ To accomplish this, trademark holders have trademark awareness campaigns, aimed at consumers and the trade, designed to prevent these popular misuses of their marks.²⁹⁷

3. Free Speech and "Dual-Use" Trademarks

Prior to *Illinois High School Ass'n*, a trademark owner's only fear was that public use might dilute its mark or transform its trademark into a generic term.²⁹⁸ Now, in light of the Seventh Circuit's decision, trademark owners also must be concerned with media or public use compromising its exclusive trademark rights in favor of other parties.²⁹⁹ The court cautioned trademark owners to supplicate editors, journalists, sportscasters, and the like from using their trademark to denote some-

293. See *Murphy Door Bed Co. v. Interior Sleep Sys., Inc.*, 874 F.2d 95, 101 (2d Cir. 1989) (holding that dictionaries, newspapers, and magazine articles can contain evidence of generic usage); *Loctite Corp. v. National Starch & Chem. Corp.*, 516 F. Supp. 190, 200 (S.D.N.Y. 1981) (stating that press releases could evidence generic use). The presence of a trademark in a dictionary is relevant, but not conclusive evidence of the genericness of the term. See 2 MCCARTHY, *supra* note 1, § 12:13, at 12-28. Evidence of generic usage in trade journals and magazines can be obtained from the NEXIS database service. See *id.* at 12-28 to 12-29.

294. See 2 MCCARTHY, *supra* note 1, § 12:28, at 12-67.

295. See *id.* (giving examples of how a trademark owner can seek to restrain media use of its mark; such as letters to the editor, etc.).

296. See JANE C. GINSBURG ET AL., TRADEMARK AND UNFAIR COMPETITION LAW, CASES AND MATERIALS 360 (2d ed. 1996).

297. See *id.* at 349-360. For example, Xerox Corporation sponsored a large advertising campaign to advise people that "Xerox" was not a noun or verb. See *id.* at 354. The International Trademark Association ("INTA") distributes an editorial package designed to assist "authors, writers, journalists/editors, proofreaders, and fact checkers" with correct use and spelling of trademarks. See *INTA Trademark Checklist* (last visited Feb. 9, 1999) <<http://plaza.interport.net/inta/tmchklist.htm>>. The package contains a trademark checklist containing almost "4,000 trademarks and service marks with their generic terms and indicates capitalization and punctuation." *Id.*

298. See *supra* Part II.A (discussing generic terms and dilution).

299. See *Illinois High Sch. Ass'n v. GTE Vantage Inc.*, 99 F.3d 244, 247-48 (7th Cir. 1996) (denying injunction because media use had weakened the mark), *cert. denied*, 117 S. Ct. 1083 (1997); Petition for a Writ of Certiorari, *supra* note 27, at 10-13. The Seventh Circuit emphasized that the "IHSA was not assiduous" in convincing CBS to stop referring to the NCAA tournament as "March Madness." See *Illinois High Sch. Ass'n*, 99 F.3d at 246.

thing else.³⁰⁰ The court, however, did not consider whether supplicating the media and public was feasible.³⁰¹

Trademarks are not secure property rights like patents or copyrights.³⁰² Trademarks will lose their protection when the marks cease to function as the identifiers of source.³⁰³ This may occur for any reason except “the culpable conduct of the defendant.”³⁰⁴ Non-commercial media and public use of a trademark will not be considered culpable; therefore, the trademark owner is virtually powerless to prevent the media from using its mark in a non-commercial manner.³⁰⁵ As a result, regardless of how “assiduous” the trademark owner is, its protected trademark rights ultimately may “depend on the whims of the media.”³⁰⁶

IHSA argued that the Seventh Circuit’s decision “upsets the balance between the protection afforded trademarks and . . . [that] afforded to non-commercial speech” under the First Amendment.³⁰⁷ IHSA also argued that prior to the Seventh Circuit’s opinion in *Illinois High School Ass’n*, trademark owners “had [little] to fear from communicative, non-commercial uses of their marks.”³⁰⁸ For instance, in *Lucasfilm*, the District Court for the District of Columbia recognized that a trademark could develop a new meaning outside of its function as a trademark.³⁰⁹ As long as the mark still functioned in the commercial context to identify a source, the court would protect an owner from a confusingly similar commercial use.³¹⁰ The Seventh Circuit, however, used *Lucasfilm* to il-

300. *See id.*

301. *See Illinois High Sch. Ass’n*, 99 F.3d at 246 (refusing to speculate as to the merits of a suit against CBS).

302. *See id.* (stating that property rights receive more protection than trademark rights); *see also* *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368 (1924) (explaining that a trademark “is not a copyright”).

303. *See Illinois High Sch. Ass’n*, 99 F.3d at 246; *see also supra* Part II.A (discussing the importance of the source identifying function of trademarks).

304. *See Illinois High Sch. Ass’n*, 99 F.3d at 246 (stating that if the NCAA was responsible for the weakening of IHSA’s mark, IHSA might have a remedy).

305. *See* 2 MCCARTHY, *supra* note 1, § 12:28, at 12-67 (citing to *Illinois High School Ass’n*). What is commercial and non-commercial use often will not be easy to determine. *See* Graff, *supra* note 39, at C6 (stating that “[o]ften, trademarks are used in a manner that has aspects of both commercial and noncommercial speech”).

306. *See Illinois High Sch. Ass’n*, 99 F.3d at 246.

307. *See* Petition for a Writ of Certiorari, *supra* note 27, at 10.

308. *See id.* at 12.

309. *See Lucasfilm Ltd. v. High Frontier*, 622 F. Supp. 931, 935 (D.D.C. 1985); *see also* 5 MCCARTHY, *supra* note 1, § 31:150, at 31-218 (discussing *Lucasfilm*).

310. *See Lucasfilm*, 622 F. Supp. at 935; 5 MCCARTHY, *supra* note 1, § 31:150, at 31-218. The court said that even though the plaintiff, Lucasfilm, could not enjoin the public interest groups’ non-commercial media use of “STAR WARS,” “it would be equally un-

lustrate that if this new meaning contained significance as a trademark in favor of another entity, a court would not protect the plaintiff's mark against the other entity's use.³¹¹ IHSA argued that the result compels trademark owners to challenge all non-commercial use of their marks, whether by economic influence or threat of suit.³¹² The feasibility of such challenges remains to be seen because the law of "reverse confusion" and dilution presently offers no sure remedy.³¹³ Additionally, this state of affairs places a heavy burden on small trademark holders who may be unable to wage a series of costly battles.³¹⁴

VI. THE PROPER STANDARD TO BE APPLIED TO "DUAL-USE" TRADEMARKS

In one respect, "dual-use" terms, as defined in *Illinois High School Ass'n*, are not novel at all.³¹⁵ When there is no confusion, the plaintiff and defendant are always allowed to co-exist, resulting in "dual use" of a trademark.³¹⁶ The Seventh Circuit opinion did not address the issue of consumer confusion, however, despite the fact that "dual-use" was al-

realistic and unfair to take from the lawful owner of a strong trademark his continued right to its commercial use because others, beyond his control . . . used the words of the trademark as part of an on-going international political debate." *Lucasfilm*, 622 F. Supp. at 935.

311. See *Illinois High Sch. Ass'n*, 99 F.3d at 247-48.

312. See Petition for a Writ of Certiorari, *supra* note 27, at 11. GTE Vantage responded by stating that the case was not about the First Amendment, and that under IHSA's theory, "ASPIRIN" may be revived as a trademark because "the public had a First Amendment right to call all pain-relievers 'ASPIRIN.'" See Respondent's Brief, *supra* note 27, at 18-19.

313. See Graff, *supra* note 39, at C6 (arguing that trademark owners may be able to sue the media for generic use and dilution); *supra* Part II. (discussing dilution); see also *supra* notes 168-74 and accompanying text (discussing reverse confusion).

314. See Wolfersberger, *supra* note 41, at 389 (arguing that IHSA could never protect its mark under the Seventh Circuit formulation because it lacked the resources to fight the national media).

315. See Respondent's Brief, *supra* note 27, at 15 (arguing that "dual-use" trademarks are not novel).

316. See Respondent's Brief, *supra* note 27, at 16-17 (citing examples of "dual-uses" of trademarks such as "RAMS" for pickups and St. Louis football players, and "AMEX" for the American Stock Exchange and American Express). Support for this premise can be found in the district court's opinion, where the court determined that there was no real likelihood of confusion present. See *Illinois High Sch. Ass'n v. GTE Vantage Inc.*, No. 96-1119, at 100-03 (C.D. Ill. March 20, 1996) (hearing on motion for preliminary injunction). See also *supra* notes 193-200 and accompanying text (discussing the district court's likelihood of confusion analysis). The rights of the IHSA and the NCAA to co-exist were simply a by-product of the NCAA winning on the issue of likelihood of confusion. See generally Respondent's Brief, *supra* note 27, at 16-17.

lowed.³¹⁷

A. The Seventh Circuit Would Have Created Clearer Precedent Had it Decided Illinois High School Ass'n on Likelihood of Confusion Grounds

The Seventh Circuit's opinion leaves many questions unanswered because the court did not provide any guidelines for other courts when confusion likely would result from a grant of "dual-use" rights.³¹⁸ In lieu of discussing the likelihood of confusion, the court put a premium on protecting effective communication by holding that the IHSA did not have a trademark to protect against use by GTE Vantage.³¹⁹ In this regard, two questions remain: (1) did the Seventh Circuit intend to hold that a likelihood of confusion was irrelevant in the "dual-use" situation; and (2) was a lack of confusion presupposed when one party had acquired superior recognition through public association?³²⁰ The court announced that it would decide against trademark protection and assimilate "dual-use" terms to generic terms.³²¹ Generic terms are not protected as trademarks,³²² but arguably, "dual-use" trademarks, as created in *Illinois High School Ass'n*, remain protected trademarks and, therefore, should be protected from use that causes consumer confusion.³²³ Thus, any future

317. See *infra* Part VI.A (discussing the Seventh Circuit opinion's omission of analysis regarding the likelihood of confusion).

318. See *Illinois High Sch. Ass'n*, 99 F.3d at 246-48. The likelihood of confusion issue was not before the court and furthermore, the court declined to "opine on the scope of the trademark rights that either IHSA or NCAA ha[d]" to the mark "March Madness" beyond the rights of the parties to the basketball CD-ROM game that is sold in connection with the NCAA basketball tournament, and to the NCAA tournament itself. See *id.*

319. See *id.* at 247.

320. See generally *id.* at 246 (stating that the issue of likelihood of confusion presumes a trademark that the law will protect); see also Fletcher & Kera, *supra* note 26, at 797 n.122 (stating that being termed "dual-use" "depend[s] on the factors [i.e., lack of confusion] that resulted in that classification").

321. See *Illinois High Sch. Ass'n*, 99 F.3d at 247.

322. See 2 MCCARTHY, *supra* note 1, § 12:2, at 12-7 (stating that public policy dictates that generic terms are part of the public domain and are not protected as trademarks).

323. See *Illinois High Sch. Ass'n*, 99 F.3d at 246-48 (implying that IHSA still may have a protectable right in some circumstances). The court held only that the IHSA did not have a trademark to protect against use in connection with the NCAA tournament. See *id.* Arguably, the term "March Madness" could be labeled generic with respect to basketball tournaments and neither IHSA nor the NCAA would have any protectable rights in the mark. See *id.* at 247 (stating that IHSA could not remove "March Madness" from the "public domain;" thereby indicating that the term was free for all to use); Richards v. Cable News Network, Inc., 15 F. Supp.2d 683, 694 (E.D. Pa. 1998) (stating that Judge Posner labeled "March Madness" as a generic term). However, this author and other commentators disagree with this proposition. See Fletcher & Kera, *supra* note 26, at 797 (classifying "dual-use" as a type of valid trademark); Lazar & Volz, *supra* note 25, at C5 (stating that the Seventh Circuit "acknowledge[d] that the mark ["March Madness"] was not devoid of

case characterizing a mark as a “dual-use” term needs to address the issue of likelihood of confusion.³²⁴

In future “dual-use” terms cases, courts must strike a careful balance between protecting effective communication and the likelihood of confusion that might result if both marks are allowed to coexist.³²⁵ The first step always should be a determination of whether the mark is a “dual-use” term or a generic term.³²⁶ If the mark is generic, the inquiry ends

value to either the NCAA or the IHSA”); Stanley, *supra*, note 25, at 1025 (arguing that IHSA and the NCAA had retained trademark rights to “March Madness”). Also, based on their briefs before the Supreme Court, it appears that the parties believed that both IHSA and the NCAA had some protectable rights in the “March Madness” mark. See Petition for a Writ of Certiorari, *supra* note 27, at 7-9 (arguing that IHSA must now share its trademark rights with the NCAA); Respondent’s Brief, *supra* note 27, at 9 (arguing that the public association created rights in “March Madness” in favor of the NCAA). Additionally, one case, *Dream Team Collectibles, Inc. v. NBA Properties, Inc.*, 985 F. Supp. 1401, 1409, 1410 (E.D. Mo. 1997), seemed to accept that trademark rights could be acquired through media and public resulting in a “dual-use” mark. In *Dream Team*, the defendant attempted to argue that it had rights to the mark “Dream Team” via public association. See *id.* at 1409. However, the court held that *Illinois High School Association* was not applicable because the defendants in *Dream Team* were responsible for the the public association along with the media. See *id.* at 1410.

324. See *infra* notes 325-29 and accompanying text (discussing the importance of the likelihood of confusion analysis in future “dual-use” terms cases); *infra* Part VI.B (discussing what courts must do in future “dual-use” cases).

325. See generally *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573-75 (1977) (recognizing that conflicts between ownership rights in intellectual property and interests in free expression must be resolved by balancing the competing interests involved); Robert J. Shaughnessy, Note, *Trademark Parody: A Fair Use and First Amendment Analysis*, 72 VA. L. REV. 1079, 1112-16 (1986) (discussing *Zacchini* and formulating a balancing test to be used with trademark parody issues).

Courts also should balance the equities involved. A court should look at the manner in which the defendant acquired its public association: whether it was active in creating the public association, and therefore culpable; or whether it did not have any part in creating the public association. See *Illinois High Sch. Ass’n*, 99 F.3d at 246-47. If the defendant was culpable, the doctrine of reverse confusion should apply, and no “dual-use” rights should be granted. See *id.* Courts also must look at the plaintiff’s conduct to determine whether it took steps to prevent its mark from being associated with another entity. See *id.* at 246. A court might be less sympathetic if the plaintiff took no action and failed to ask the defendant or the public and media to stop misusing its mark. See *id.* (chastising IHSA for not being “assiduous” in protecting its mark).

326. Cf. *Illinois High Sch. Ass’n*, 99 F.3d at 246. The court stated that the issue of likelihood of confusion does not arise until it is determined that the plaintiff has a trademark that the law will protect. See *id.* A generic term cannot be protected as a trademark. See 2 MCCARTHY, *supra* note 1, § 12:2, at 12-7 to 12-8 (discussing the public policy reasons for not protecting generic terms as trademarks); see also 2 MCCARTHY, *supra* note 1, § 12:30, at 12-68 (discussing the difficulty of reclaiming generic terms from the public domain). But see *Singer Mfg. Co. v. Briley*, 207 F.2d 519, 520 n.3 (5th Cir. 1953) (holding that, although “Singer” had previously been held to be a generic designation for a certain class of sewing machines, it had been recaptured as a trademark by continuous and exclusive use and through advertising).

and the mark cannot be protected.³²⁷ However, in determining whether the mark is a “dual-use” term, courts should consider whether the party advancing “dual-use” rights was culpable. Prior conduct that is culpable in nature, such as actually using another’s mark in commerce without legal authority, should not form the basis for “dual-use” rights;³²⁸ it should form the basis of a finding of infringement by “reverse confusion.”³²⁹

B. What Courts Should Do if There Is a Substantial Likelihood of Confusion Between “Dual-Use” Marks of Equal Strength

Once the court has determined that “dual-use” rights have been established, the court should apply the likelihood of confusion factors to determine the possible extent of confusion that “dual-use” might entail.³³⁰ If there is a substantial likelihood of confusion in balancing the equities involved, a court should grant “dual-use” rights and provide a judicial order tailored to each individual case.³³¹ Such an order must detail how each dual user may use the mark to prevent or minimize any possible confusion in the marketplace.³³² For example, a court may order that a house mark or logo be prominently displayed along with the mark in question.³³³ A court also could require a defendant to use a disclaimer of

327. *But see* 2 MCCARTHY, *supra* note 1, § 12:51, at 12-99 (stating that some injunctive relief may be appropriate even with generic terms). Sometimes a mark that is held to be primarily generic may be recognized by some as a trademark. *See id.* at 12-98 to 12-99 (stating that, although “ASPIRIN” was generic to the public, it was not to pharmacists). In these situations, courts may approve an injunction that recognizes the dual nature of the mark by requiring the defendant always to use its mark along with the generic term. *See, e.g.,* King-Seeley Thermos Co. v. Aladdin Ind., Inc., 321 F.2d 577, 581 (2d Cir. 1963), *decree modified by* 320 F. Supp. 1156 (D. Conn. 1970).

328. *See Illinois High Sch. Ass’n*, 99 F.3d at 246-47 (stating that culpable conduct on the part of the defendant is required for liability for reverse confusion).

329. *See id.*

330. *See Fletcher & Kera*, *supra* note 26, at 797 n.122 (stating “that to categorize a mark [as a ‘dual-use’ term] produces no readily identifiable consequences,” because “[t]he consequences of being a ‘dual use’ term depend on the factors that led to the classification”); *see also supra* notes 155-59 and accompanying text (discussing the likelihood of confusion factors).

331. *See, e.g.,* AMF Inc. v. Sleekcraft Boats, 599 F.2d 341, 354 (9th Cir. 1979) (balancing the conflicting interests of both the plaintiff and defendant in the continued use of their marks and the need for the public to be free from confusion, before concluding to issue a limited mandatory injunction); *see also* 5 MCCARTHY, *supra* note 1, § 30:3, at 30-8 (discussing balancing the equities by way of a qualified injunction tailored to each individual case).

332. *See* 5 MCCARTHY, *supra* note 1, § 30:3, at 30-8 to 30-9.

333. *See, e.g.,* AMF, Inc., 599 F.2d at 354-55 (requiring that the defendant’s logo be present on “all advertisements, signs, and promotional materials” to alleviate any possible confusion).

association, stating that the defendant is not in any way associated with the plaintiff.³³⁴

Although these methods often are criticized as being ineffective in alleviating confusion,³³⁵ they are perhaps the only way courts can address the need for effective communication to prevent consumer confusion. In fact, courts have issued similar injunctions in cases involving generic marks where, because the term had at least some remaining trademark significance, confusion might have ensued without such relief.³³⁶ Even if "dual-use" marks are equated with generic marks and, thus, not entitled to protection, arguably a similar injunction should issue if, for instance, another party attempted to use "March Madness" for basketball-related goods or services. In this regard, a court can promote effective communication by allowing both parties to use the mark, and it also can prevent any confusion through the use of an appropriate judicial order similar to the qualified injunction.³³⁷

VII. CONCLUSION

Public association plays a major role in the acquisition and loss of trademark rights. Public and media use of trademarks can result in the

334. See, e.g., *Mushroom Makers, Inc. v. R.G. Barry Corp.*, 441 F. Supp. 1220, 1234 (S.D.N.Y. 1977) (holding that the plaintiff must use a disclaimer on its goods stating that it does not manufacture or sell footwear and "that it is not associated with the makers of MUSHROOMS footwear"), *aff'd*, 580 F.2d 44 (2d Cir. 1978).

335. See *Banff, Ltd. v. Federated Dep't Stores, Inc.*, 638 F. Supp. 652, 656 (S.D.N.Y. 1986) (holding that use of defendant's trade name might increase confusion because consumers might think that there was a licensing agreement between the parties); *T & T Mfg. Co. v. A.T. Cross Co.*, 449 F. Supp. 813, 822 (D.R.I. 1978) (holding that adding a house mark may only confuse consumers into thinking that the infringer is selling with the authorization of the owner of the mark), *aff'd*, 587 F.2d 533 (1st Cir. 1978); see also Martin J. Beran, *Likelihood of Confusion: Will That "House Mark" Get You "Home-Free"?*, 83 TRADEMARK REP. 336, 361-63 (1993) (listing several guidelines to determine the weight to be accorded to the presence of a house mark in the likelihood of confusion analysis).

The use of disclaimers also has been criticized. See *Paramount Pictures Corp. v. Worldwide Entertainment Corp.*, 195 U.S.P.Q. (BNA) 539, 541-42 (S.D.N.Y. 1977) (holding that a disclaimer helped prove likelihood of confusion rather than dispel confusion); *Marquis Who's Who, Inc. v. North Am. Adver. Assocs., Inc.*, 426 F. Supp. 139, 141, 143 (D.D.C. 1976) (holding a disclaimer insufficient), *aff'd*, 574 F.2d 637 (D.C. Cir. 1978); *Jacob Jacoby & Robert Lloyd Raskopf, Disclaimers in Trademark Infringement Litigation: More Trouble Than They Are Worth?*, 76 TRADEMARK REP. 35, 54 (1986) (arguing that consumer studies show that disclaimers are ineffective to protect against confusion).

336. See *supra* note 327 and accompanying text (detailing circumstances when a court might issue an injunction in a case involving a generic mark with at least some trademark significance).

337. See 5 MCCARTHY, *supra* note 1, § 30:3, at 30-8 to 30-9 (discussing balancing the equities by way of a qualified injunction tailored to each individual case).

trademark becoming diluted or generic. Such use can also result in courts granting trademark rights in abbreviations and nicknames for trademarks. Public and media use in favor of a third party can compromise the trademark rights of a trademark owner and result in “dual-use” rights. Such “dual-use” rights are in accordance with trademark precedent; however, there are issues that will need to be dealt with in future cases. The nature of a “dual-use” mark implies that it is used by more than one unrelated entity. Therefore, courts must be cognizant of the possibility of consumer confusion and the need for effective communication. In this regard, courts must balance these competing concerns by framing an appropriate equitable judicial order. A court could mandate that a “dual-use” mark always must be accompanied by a house mark, logo, or disclaimer of association. In the end, it is possible to protect effective communication by recognizing “dual-use” rights while still favoring trademark protection and preventing confusion.

