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**COMMENT: WHO'S AFRAID OF THE BIG, FRIENDLY
NONPROFIT? SABER RATTLING AND THE SAD STATE OF
AFFAIRS FOR SMALL CHARITABLE NONPROFITS AND
TRADEMARK LAW**

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INTRODUCTION

“The Court struggles to understand how two charitable organizations, that exist solely to provide benefit to others, [have] permitted such a result that contradicts their underlying purpose Although the Court does not believe that this ruling achieves justice, this ruling follows the law.”¹

When charitable nonprofits are forced into trademark² fights, they are at risk of no longer being able to help their respective causes. For example, the phrases “Congenital Diaphragmatic Hernia Awareness,”³ and “Congenital Diaphragmatic Hernia Awareness

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¹ Lutheran Ass’n of Missionaries & Pilots, Inc. v. Lutheran Ass’n of Missionaries & Pilots, Inc., 2004 WL 2730104 at *14-15 (D. Minn. 2004).

² “Trademarks” are used in connection with goods while “service marks” are used in connection with services. Both trademarks and services marks will be referred to hereinafter as either “marks” or “trademarks.”

³ CONGENITAL DIAPHRAGMATIC HERNIA AWARENESS, Registration No. 3,503,325 (hereinafter the “CDH Awareness Mark”). When Breath of Hope, Inc. asserted this registered mark against a group known as “CHERUBS,” CHERUBS petitioned the Trademark Trial and Appeal Board of the United States Patent and Trademark Office (“TTAB”) to cancel the registration. The TTAB ruled

Day”⁴ were registered as marks by Breath of Hope, Inc. between September 2008 and May 2009. Congenital Diaphragmatic Hernia (CDH) is a condition that affects one in every 2500 children born around the world, yet it is hardly researched and carries a fifty-percent mortality rate.⁵ Raising awareness of a condition many laypeople have not heard of is a noble goal with a steep uphill climb. Using and registering a mark to prevent others from diluting the organization’s message are appropriate measures and common practice among nonprofit organizations.

Of course, the need to raise awareness and protect one’s ideas does not give an organization the ability to use and register whatever mark it wants. Breath of Hope, Inc.’s CDH Awareness Mark might not have survived scrutiny standing alone; however, the mark’s potential for protection was made even more unlikely in light of the more established CDH awareness and support group named CHERUBS. Both organizations are nonprofits operating on shoestring budgets, but CHERUBS was formed in 1995 and has been using the phrase “CDH Awareness” in its literature since 2000.⁶

And so the curtain opens for discussion of a widespread problem. Legal rhetoric and theory certainly carry their weight before a judge or in law journals, but sound arguments only go so far for small nonprofit organizations that work within tiny budgets to provide the greatest good for those in need. Over time, a well-nurtured grassroots organization can become an international juggernaut.⁷ However, organizations like CHERUBS and Breath of Hope are fragile and can be toppled with the slightest pressure or the words “cease-and-desist.” When Breath of Hope began its saber rattling by asserting its CDH Awareness Mark,⁸ CHERUBS faced the real, dire possibility of having to shut their doors. Breath of Hope represented itself *pro se* defending CHERUBS’ petition to cancel the registration

in favor of CHERUBS, and the Commissioner of Trademarks cancelled the registration on June 22, 2010.

⁴ CONGENITAL DIAPHRAGMATIC HERNIA AWARENESS DAY, Registration No. 3,624,962.

⁵ *Congenital Diaphragmatic Hernia: What is CDH?*, CHERUBS - THE ASS’N OF CONGENITAL DIAPHRAGMATIC HERNIA RESEARCH, AWARENESS & SUPPORT, <http://www.cdhsupport.org/cdh.php> (last visited Nov. 1, 2010).

⁶ *CHERUBS-Congenital Diaphragmatic Hernia (CDH): April 19, 2010 – “CDH Awareness Day,”* CHERUBS - THE ASS’N OF CONGENITAL DIAPHRAGMATIC HERNIA RESEARCH, AWARENESS AND SUPPORT (Apr. 19, 2010), <http://cdhsupport.blogspot.com/2010/04/april-19-2010-cdh-awareness-day.html> [hereinafter *CDH Awareness Day*].

⁷ See *infra* notes 16–24.

⁸ See *CDH Awareness Day*, *supra* note 6.

for the CDH Awareness Mark, but Breath of Hope spent over a third of its annual budget only to abandon the mark after its motion to dismiss CHERUB's petition was denied.⁹ Even if smaller charitable nonprofits have a legitimate claim against another company's mark, in the current environment there is one specter that keeps them out of court: the cost of drawn out litigation.¹⁰

This Comment explores the reality facing many small nonprofits: they are one cease-and-desist letter or lawsuit away from no longer being able to help people. Many organizations settle in the face of impossible legal fees, and as a result there is almost no case law analysis where larger organizations sue small nonprofits. Many entities, including corporations and large nonprofits, protect their marks fiercely and can crush smaller organizations by merely threatening the word "enjoin."¹¹ What could CHERUBS do if it had to face a larger organization with a war chest specifically reserved for trademark litigation? What if Breath of Hope had lawyers who would not file defective pleadings and hamstring its motion to dismiss? The CDH Awareness dispute might have had radically different results—even if CHERUBS was in the right.

In order to explore the threat to smaller organizations, Section I of this Comment first examines the competing interests of the Lanham Act and the First Amendment and how the existing dichotomy is affected by the purpose of 26 U.S.C. § 501(c)(3). It further asserts how nonprofit trademark disputes should be examined in light of First Amendment protection of charitable speech.¹² Section II discusses the common rationales and claims used in trademark law and how they have grown to favor larger organizations instead of smaller nonprofits that cannot afford to go to court. Specifically, the Section examines recent trademark actions by the Susan G. Komen for the Cure organization and evaluates hypothetical claims Komen could raise for likelihood of confusion, dilution, and color marks to illustrate the imbalance of power between larger and smaller nonprofits.¹³ Section III examines available trademark defenses and how they apply to charitable nonprofits. Furthermore, this Section proposes a new balancing of trademark interests that will allow all sizes of organizations to continue to do good work, increase judicial

⁹ *Id.* Breath of Hope's CDH Awareness Day mark is still active.

¹⁰ William McGeeveran, *Rethinking Trademark Fair Use*, 94 IOWA L. REV. 49, 51–52 (2008).

¹¹ *Id.*

¹² See *infra* notes 16–44.

¹³ See *infra* notes 45–139.

efficiency, and reduce attendant court costs.¹⁴ Finally, Section IV proposes ways to improve trademark litigation efficiency and accessibility. The current regime places unnecessary burdens on smaller nonprofits and does little to dissuade larger organizations from over-protecting their marks against small charitable nonprofits.¹⁵

I. HOW CHARITABLE INVOLVEMENT CHANGES TRADEMARK ANALYSIS

The Lanham Act, 15 U.S.C. § 1051 *et. seq.*, has been hailed as the legislation that greatly broadened the realm of trademark law. Both the idea of what can be trademarked and how it can be trademarked have changed significantly from the common law, and the Supreme Court has held that the law is inclusive as to what may be trademarked, as opposed to acting as a deterrent.¹⁶ As it currently stands, any word, symbol, name, or device capable of carrying meaning can be protected by a trademark.¹⁷ However, mark holders do not have limitless power under the Lanham Act to pursue other mark users. For example, the Act protects parodies and product comparisons from infringement liability.¹⁸ The rationale supporting this exception is widely accepted: some types of speech are so important that trademark law, which restricts speech, should not apply.¹⁹ Until the 1990s, courts almost always declined to use First Amendment protection for speech that arose in trademark disputes.²⁰ The rationale given by earlier courts was that as long as there are alternative avenues for expression in order to advertise and attract customers, the First Amendment is not a valid defense.²¹

However, as the new millennium approached, courts began to recognize the interplay of the First Amendment and trademark

¹⁴ See *infra* notes 140–79.

¹⁵ See *infra* notes 180–94.

¹⁶ See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162–63 (1995).

¹⁷ *Id.* at 162 (quoting 15 U.S.C. § 1127).

¹⁸ See 15 U.S.C. § 1125(c)(3) (2006); *but see also* Richard D. Salgado, *Piracy and Chaos in the Marketplace of Ideas: Why Money Cannot Be Everything When Assessing Initial-Interest Confusion and Nonprofit Trademark Holders*, 61 ARK. L. REV. 241, 265–66 (2008) (discussing how “People Eating Tasty Animals” was not a parody of “People for the Ethical Treatment of Animals”).

¹⁹ See McGeveran, *supra* note 10, at 76.

²⁰ See Robert N. Kravitz, *Trademarks, Speech, and the Gay Olympics Case*, 69 B.U.L. REV. 131, 145–46 (1989).

²¹ *Id.*

rights.²² Although courts tend to limit their rulings so that the First Amendment is not directly used,²³ courts have reaffirmed that freedom of expression is a tenant of American law. Trademarks can be renewed indefinitely,²⁴ and a court's ability to take words, images, and colors out of the marketplace for others to use must be handled with care.

Of course, the freedom of expression provided by the First Amendment is not universal. For example, the Amendment does not protect speech inducing fraud or illegal commercial transactions.²⁵ Furthermore, speech can be regulated if the regulation is content neutral, the government has an interest unrelated to restricting the speech, and the restriction is narrowly tailored towards that interest.²⁶ Most importantly to trademark law, commercial speech is not given the full weight of First Amendment protection.²⁷ According to the Supreme Court, commercial speech is any speech which "propose[s] a commercial transaction" and is devoid of any other ideas.²⁸ Examples of commercial speech include leaflets as well as print and television advertisements.²⁹ As long as the commercial speech does not propose anything illegal, it is afforded qualified—though not complete—First Amendment protection.³⁰

The idea of commercial speech is important because trademark law is a valid extension of older common law and unfair competition claims. Traditionally, a mark holder seeks to use and register a mark to serve two purposes. First, marks allow consumers to quickly identify the source of products and services. Market identification is a key component in many trademark disputes when courts examine whether or not use of a mark creates a likelihood of confusion.³¹ Second, allowing entities to register trademarks encourages them to

²² See generally William McGeeveran, *Four Free Speech Goals for Trademark Law*, 18 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1205, 1209–11 (2008).

²³ See McGeeveran, *supra* note 10, at 98.

²⁴ See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164–65 (1995) (citing *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 119–20 (1938)).

²⁵ See Kravitz, *supra* note 20, at 134 (citing *Vill. of Hoffman Estates v. Flipside, Hoffman Estates, Inc.*, 455 U.S. 489, 496 (1982)).

²⁶ See *id.* (summarizing the *Central Hudson* and *O'Brien* tests).

²⁷ See McGeeveran, *supra* note 10, at 97.

²⁸ See *Va. State Bd. of Pharm. v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 762 (1976) (quoting *Pittsburgh Press Co. v. Pittsburgh Comm'n on Human Relations*, 413 U.S. 376, 385 (1973)).

²⁹ See *id.* at 758–59, 789.

³⁰ *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 68 (1983).

³¹ See Noah B. Bleicher, *Trademarking Tragedy: The Fight for Exclusive Rights to "Let's Roll,"* 52 EMORY L.J. 1847, 1870 (2003).

work harder and give consumers a positive association with the mark and the entity.³² While this would seem to create more of a property interest in the words because it is part of the entity's brand, modern courts tend to err on the side of protecting speech when assessing the mark.³³ However, the idea of a mark as a property interest is alive and codified in the Lanham Act's dilution section. Under this section, a famous mark holder can, barring some restrictions, file a claim against a competing party whose mark might either tarnish the famous mark's reputation or blur its meaning.³⁴ With these two purposes combined, courts tend to say that the most important goal of trademark law is to protect customers from "bad" uses of trademarks.³⁵ Ironically, when courts rule based on consumer interests the two parties arguing are not consumers. The mark holder and the party attempting to cancel the mark are present to protect their interests, but no one is there to argue for the public consumer.

When assessing the balance between trademark interests and First Amendment rights in a commercial nonprofit setting, the analysis is adjusted slightly. Unlike other commercial activity, charitable solicitation has been held by the Supreme Court to receive full protection under the First Amendment.³⁶ In *Vill*, the Court recognized that there are commercial elements to charitable work, including seeking donations and competing with other charities for consumer interest and dollars in the marketplace.³⁷ However, the Court offered full First Amendment protection to a charity's work because the commercial elements are too strongly intertwined with other compelling interests.³⁸ Charities are aimed towards helping people and serving the public good, not making a profit. Thus, a charitable solicitation in the marketplace is not commercial speech because it does far more than suggest a commercial transaction.³⁹ The *Vill* decision is vital to charitable nonprofits in a trademark setting. Although courts shape their trademark rulings to avoid implicating the

³² See Jessica Litman, *Breakfast with Batman: The Public Interest in the Advertising Age*, 108 YALE L.J. 1717, 1722–23 (1999).

³³ See McGeeveran, *supra* note 10, at 59–60.

³⁴ 15 U.S.C. § 1125(c).

³⁵ See McGeeveran, *supra* note 10, at 66.

³⁶ See *Vill. of Schaumburg v. Citizens for a Better Env't*, 444 U.S. 620, 632 (1980) (“[C]haritable appeals for funds, on the street or door to door, involve a variety of speech interests—communication of information, the dissemination of a propagation of views and ideas, and the advocacy of causes—that are within the protection of the First Amendment.”) (hereinafter “*Vill*”).

³⁷ See *id.* at 632, 636.

³⁸ See *id.* at 632.

³⁹ See *id.* at 632.

First Amendment,⁴⁰ *Vill* illustrates that First Amendment protection is a key component to a charitable nonprofit's speech. The trademark protection-free expression balance must be shifted in the charitable nonprofit's favor.

This view is bolstered by the fact that charitable nonprofits must follow very specific guidelines in order to be considered nonprofit organizations. As a creature of the tax code in 21 U.S.C. 501(c), charitable nonprofits are required to serve the public good instead of themselves. They rely on the giving of others and are rewarded with a favorable tax status.⁴¹ Of course, not all individual charities are created equal—some serve the “good” more than others—⁴² but despite their contribution to the public good they are far less of a commercial enterprise than two clothing manufacturers fighting over a mark used on articles of clothing.⁴³ Solicitation for donations, advertising, and publicity are all means to an end of helping others, not means to attain a profit. Courts often get bogged down in very fact-specific inquires when determining trademark cases,⁴⁴ but there is one overarching fact that cannot be ignored: Charitable nonprofits are required to act in accordance with section 501(c)(3), or they risk losing their nonprofit status. Therefore, these charitable nonprofits' humanitarian motives and nonprofit methods must be part of the trademark analysis.

In the tug-of-war between competing speech protection and consumer protection interests, charitable nonprofits stand on different footing than their commercial counterparts. Courts should be more open to allowing free expression when analyzing a charitable nonprofit's use of a mark. However, as the next Section shows, courts tend to turn to other very time consuming questions that both prolong litigation and give the advantage to larger charitable nonprofits.

⁴⁰ *Universal Commc'n Sys., Inc. v. Lycos, Inc.*, 478 F.3d 413, 425 (1st Cir. 2007); see *McGeeran*, *supra* note 10, at 98 (citing *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 36 (2003)).

⁴¹ 26 U.S.C. § 501(c)(3) (2010).

⁴² Kyle Waide, *Charities, Donors, and the First Amendment*, CHARITY NAVIGATOR, (Mar. 22, 2003), <http://www.charitynavigator.org/index.cfm?bay=content.view&cpid=118>.

⁴³ See generally *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465 (5th Cir. 2008) *cert. denied*, 129 S. Ct. 2759 (2009) (discussed further in notes 120–31).

⁴⁴ See *McGeeran*, *supra* note 10, at 66–69.

II. THE NOT-SO-FRIENDLY SIDE OF NONPROFIT WORK: TRADEMARK CLAIMS

Asserting marks in order to protect one's brand makes as much sense to nonprofit organizations as it does to private corporations or other entities: plenty. But the ugly side of asserting marks is that nonprofits also are pulled into court either to assert them or to defend them. For example, two organizations, "Sunshine Kids Foundation" and "Sunshine Kids Club of California," ended up in court due to donors unintentionally sending money to the California organization instead of the Foundation in Texas.⁴⁵ The California Club helps children with and without disabilities, while the Texas Foundation helps children with cancer. The California Club was forced to change its name to "Sunshine Connection" after being blindsided by the lawsuit, and the legal battle drained the Connection's resources and caused them to suspend programs.⁴⁶ How much can litigation cost nonprofits? As of this writing, two organizations supporting wounded veterans, Wounded Warriors, Inc. and Wounded Warrior Project, are locked in a court battle over the domain name woundedwarriors.org and have amassed over \$2.2 million in litigation costs.⁴⁷ Donations given to help support these organization's causes are being siphoned into the litigation machine all in the name of trademark protection.

Probably the most interesting, or terrifying, turf war in the current nonprofit trademark landscape involves the Susan G. Komen Breast Cancer Foundation, Inc. ("Komen"). The organization, founded in 1982, has grown into a worldwide organization synonymous with breast cancer awareness and research.⁴⁸ As of 2010, Komen has raised over \$1.5 billion for breast cancer research while building a strong community to help people with and affected by breast cancer.⁴⁹ However, Komen has taken steps to protect its brand by filing hundreds of federal trademark registration applications and going after organizations using the color pink or various constructions

⁴⁵ Meredith J. Cooper, *Lawsuit Leads to Name Change*, CHICO NEWS & REV., Oct. 21, 2010, <http://www.newsreview.com/chico/content?oid=1861771>.

⁴⁶ *Id.*

⁴⁷ Clifford M. Marks, *Charity Brawl: Nonprofits Aren't So Generous When a Name's at Stake*, WALL ST. J., Aug. 5, 2010, <http://online.wsj.com/article/SB10001424052748703700904575390950178142586.html> (hereinafter "Marks").

⁴⁸ *Help & FAQs*, SUSAN G. KOMEN FOR THE CURE, <http://ww5.komen.org/HelpFAQ/HelpFAQs.html> (last visited Nov. 1, 2010).

⁴⁹ Karen McDonald, *U.S. House Honors Nancy Brinker*, PJSTAR.COM (Jan. 20, 2010, 8:35 PM), <http://www.pjstar.com/news/x1685418888/U-S-House-honors-Nancy-Brinker>.

of “for the cure.”⁵⁰ Many of the target organizations are small and do not have the means to stand up to Komen.⁵¹ But, “Uniting Against Lung Cancer” made headlines by refusing to acquiesce to Komen’s demands to not use pink or rename its “Kites for a Cure” event in order to help raise funds for lung cancer awareness and research.⁵² The sides eventually agreed to limit “Kites for a Cure” to lung cancer activities, which, incidentally, was what the event was all about.⁵³ However, other groups and events, such as “Kayak for a Cure,” “Juggling for a Cure,” “Bark for the Cure,” and “Blondes for the Cure,” received the same cease-and-desist letter from the Komen organization.⁵⁴ Suddenly, small organizations who tried to hold an event or create an organization in order to help find a “Cure” faced the peril of an international nonprofit like Komen claiming its turf.

The purpose of this Section is twofold. First, it examines Komen’s current trademark registration filings⁵⁵ and assesses how Komen could assert and protect its trademarks. This serves as a model for exploring the current use of the Lanham Act’s protections in a nonprofit context. Second, this Section compares Komen’s potential trademark disputes to the conflict between CHERUBS and Breath of Hope.

A. *Susan G. Komen for the Cure’s Marks and the Big Bad Lanham Act*

The best place to start is Komen’s signature trademark that appears all over its website and promotional materials—the word mark for “Susan G. Komen for the Cure.” There is both a standard character mark⁵⁶ and a mark for the internationally recognized Komen insignia complete with a ribbon depicting a person running.⁵⁷ Registration applications for both marks were filed on February 26,

⁵⁰ Brett Trout, *Susan G. Komen Directing Funds to Trademark Fights*, BLAWGIT (Aug. 6, 2010), <http://blawgit.com/2010/08/06/susan-g-komen-directing-funds-to-trademark-fights/>.

⁵¹ *Id.*

⁵² See Marks, *supra* note 47.

⁵³ See Sheila Shayon, *In the Pink: Non-Profits Tussle . . . for the Cure*, BRANDCHANNEL (Aug. 6, 2010, 2:00 PM), <http://www.brandchannel.com/home/post/2010/08/06/Susan-GKomen-Protects-for-the-Cure.aspx>.

⁵⁴ See Marks, *supra* note 47.

⁵⁵ The filings were found at the US Patent and Trademark Office trademark site at www.uspto.gov via a “Word and/or Design Mark Structured Search” using “Komen” as mark owner AND “for the Cure” with ALL. Two hundred ninety six records were returned as of Nov. 23, 2010.

⁵⁶ SUSAN G. KOMEN FOR THE CURE, Registration No. 3,309,531.

⁵⁷ SUSAN G. KOMEN FOR THE CURE & Design, Registration No. 3,309,532.

2006, and the marks were registered with the United States Patent and Trademark Office on October 9, 2007. The marks were first used in commerce on January 22, 2007.⁵⁸ There is also a third mark that was issued on the same day depicting “Susan G. Komen Race for the Cure” with a similar partially shaded ribbon to the left of the wording.⁵⁹

Although none of these marks have been active long enough to trigger the incontestability rule,⁶⁰ there are two very significant details in each of the filings. First, color is not claimed as any part of the registered marks.⁶¹ This makes sense, as it keeps the marks’ protection broad and allows Komen the flexibility to use different colors in its materials. Second, none of the words in the marks is disclaimed, including the phrase “for the Cure.”⁶² The Komen marks tend to show a rebranding of the organization from its older 1985 logo which used a silhouette of a woman encircled by the words “Susan G. Komen Foundation.” The 1985 mark is still active, and its corresponding registration was renewed April 28, 2006.⁶³ Hypothetically, to assert its marks, Komen would rely upon the provisions in the Lanham Act protecting a mark from consumer confusion⁶⁴ and market dilution.⁶⁵ Komen would also likely use the Act to claim it is entitled to a mark on the color pink.⁶⁶ Should these claims be challenged by a competing mark holder, the court would apply the standard likelihood of confusion analysis unique to its jurisdiction.

B. Likelihood of Confusion

A potential Komen claim for likelihood of confusion would be similar to the situation between CHERUBS and Breath of Hope. Like Komen, these CDH organizations use specific language to solicit donations for their causes: an example is “for the Cure” for breast

⁵⁸ See *supra* notes 56–57.

⁵⁹ SUSAN G. KOMEN RACE FOR THE CURE, Registration No. 3,424,712.

⁶⁰ See generally 15 U.S.C. § 1065 (2010) (a trademark in use that has been registered and undisputed for five years is presumed to have secondary meaning and is deemed incontestable, which bars any attacks on its distinctiveness).

⁶¹ See *supra* notes 56–57, 59.

⁶² *Id.*

⁶³ SUSAN G. KOMEN – FOUNDATION & Design, Registration No. 1,955,572.

⁶⁴ See *infra* notes 67–92.

⁶⁵ See *infra* notes 93–99.

⁶⁶ See *infra* notes 100–138.

cancer and “CDH Awareness” for CDH. If the CDH conflict had gone to trial, a court would have examined the likelihood of confusion between the two marks just like it would with anyone attempting to use Komen’s “for the Cure” marks. And although the “CDH Awareness” dispute in the introduction and the disputes around Komen’s trademark portfolio are wide apart in scale, a court would apply the same likelihood of confusion test when examining each use of the marks.

Because there is a vast number of charitable organizations using similar names or fighting for similar causes, claims of consumer confusion are very common in the nonprofit context. Many courts have had little trouble finding consumer confusion when nonprofit word and design marks are involved.⁶⁷ The prevailing theory worries that if consumers are confused as a result of a misused trademark, they might unintentionally donate their money to the wrong organization, and as a result the original mark holder is damaged.⁶⁸

However, many legal scholars have pointed out that courts have depicted consumers as virtually incapable of sorting between different marks on their own.⁶⁹ According to these courts, easy access to resources like print advertising and the Internet have only added to consumer confusion.⁷⁰ In some nonprofit cases there have already been incorrect donations, and in those cases the likelihood of confusion was not questioned by the court.⁷¹ Of course, a showing of actual confusion has never been required to show consumer confusion.⁷² Unfortunately, when the facts do not show actual confusion, the “incapable consumer” concept has been so ingrained in case law that consumer confusion analysis turns on a series of factors that strongly favor the mark holder.

Under the Lanham Act, different circuits have created multifactor tests to determine whether or not there is a likelihood of confusion.⁷³ And while there are different tests floating around, they

⁶⁷ See *Rd. Dawgs Motorcycle Club of the U.S., Inc. v. “Cuse” Rd. Dawgs, Inc.*, 679 F. Supp. 2d 259, 291 (N.D.N.Y. 2009).

⁶⁸ See *WWP, Inc. v. Wounded Warriors, Inc.*, 566 F. Supp. 2d 970, 975 (D. Neb. 2008).

⁶⁹ Deborah R. Gerhardt, *Consumer Investment in Trademarks*, 88 N.C. L. REV. 427, 438–440 (2010).

⁷⁰ *Id.*

⁷¹ *WWP, Inc.*, 566 F. Supp. 2d at 975.

⁷² *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 875 (2d Cir. 1986).

⁷³ *Compare Reed-Union Corp. v. Turtle Wax, Inc.*, 869 F. Supp. 1304, 1307 (N.D. Ill. 1994), *aff’d* 77 F.3d 909 (7th Cir. 1996), *with Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (proposing a seven factor test in *Reed* and an eight factor test in *Polaroid*. *Reed*’s seven factor test looks for (1) similarity

do share some traits in common. For example, no single factor is dispositive.⁷⁴ Furthermore, the importance of each factor is weighed on a case-by-case basis, and there is little uniformity from circuit-to-circuit as to how each factor should be applied.⁷⁵ However, two of the more significant factors for nonprofits to consider are “similarity of product” and “area and manner of concurrent use.”⁷⁶ Ideally, similar trademarks, words, phrases, or brands should not interfere with each other if they are used in different market areas for different purposes. However, courts have found similar use of language in products geared towards different end users to be trademark infringement.⁷⁷ Courts have also found confusion when very different products are in competition with each other.⁷⁸ When both factors are met, such as between two nonprofit charities looking for cures of a disease by raising funds for research and awareness, courts tend to require a substantially lower showing to find a likelihood of confusion.⁷⁹ The remaining question facing Komen’s attempt to protect the “for the Cure” portion of its mark is whether a smaller challenged organization needs to be raising funds to cure breast cancer in order for there to be a likelihood of confusion.

One instructive conflict arose between the “Cancer Research Institute” and the “Cancer Research Society.” The defendant’s original name was “United Cancer Research Society,” but the Institute did not dispute the Society’s name until the Society dropped the word “United” from its name.⁸⁰ The Institute successfully stopped the Society from infringing its trademark in part because there was a great

of appearance, (2) similarity of products, (3) how they are used concurrently, (4) how careful a consumer will be, (5) strength of mark, (6) actual confusion, and (7) intent by defendant to take advantage of plaintiff’s mark. *Polaroid* is different in that it looks at customer sophistication, quality of the goods or services defendant provides, and whether the mark holder would be likely to move into the defendant’s market territory in the near future.)

⁷⁴ See *Buying for the Home, LLC v. Humble Adobe, LLC*, 459 F. Supp. 2d 310, 330 (D.N.J. 2006).

⁷⁵ *Id.*

⁷⁶ *Reed-Union*, 869 F. Supp. at 1307.

⁷⁷ *Marathon Mfg. Co. v. Enerlite Prods. Corp.*, 767 F.2d 214, 218–20 (5th Cir. 1985) (a dispute over MARATHON and MARATHON 10 batteries, although the batteries were for very different purposes).

⁷⁸ *Florence Mfg. Co. v. J.C. Dowd & Co.*, 178 F. 73, 75 (2d Cir. 1910) (conflict between “Keep-clean” brushes and “Sta-Kleen” toothbrushes).

⁷⁹ See *Rd. Dawgs Motorcycle Club of the U.S., Inc. v. “Cuse” Rd. Dawgs, Inc.*, 679 F. Supp. 2d 259, 285 (N.D.N.Y. 2009).

⁸⁰ *Cancer Research Inst., Inc. v. Cancer Research Soc., Inc.*, 694 F. Supp. 1051, 1052–53 (S.D.N.Y. 1988).

likelihood of confusion.⁸¹ Not only were the names similar, both nonprofits were fundraising for cancer research. Their purposes were aligned, and that was enough to show confusion.⁸² However, having similar language, standing alone, is not enough. The similar language must also be presented in a way where it would likely to cause confusion among potential consumers as to the source of the respective goods or services.⁸³

Some courts have also been willing to consider how consumers would spread the reputation of the mark holder by word of mouth.⁸⁴ These courts found an increased likelihood of confusion when one mark was famous.⁸⁵ For example, when a mark is famous, consumers are far more likely to associate similar usage to the famous mark's holder.⁸⁶ The words do not have to be the exact same,⁸⁷ so substituting "a" for "the" does not save another organization from infringement. Komen, if it chose to assert its trademark, would argue that as a national organization, potential donors who recognize its mark would see "Kites for a Cure" or "Blondes for the Cure" and assume the events are associated with Komen and its "Race for the Cure" trademark.⁸⁸ As a result, Komen would assert that there is a strong enough likelihood of confusion to warrant a finding of trademark infringement in the broadest market sense possible.

However, the multi-factor tests also address the relationship in the marketplace,⁸⁹ and courts would likely not turn a blind eye to "Kites for a Cure" raising money for lung cancer research. Since the diseases are different, there is a possibility that Kites' usage might not infringe on Komen's mark depending on how the court chooses to weigh the factors. However, small organizations trying to raise money and awareness, and provide support for fighting breast cancer, would be in much greater peril—especially if the organization was aware of Komen.⁹⁰ Not only would they share a number of characteristics with

⁸¹ *Id.* at 1056.

⁸² *Id.*

⁸³ *Rd. Dawgs*, 679 F. Supp. 2d at 286–87.

⁸⁴ *Virgin Enters., Ltd. v. Newab*, 335 F.3d 141, 149 (2d Cir. 2003).

⁸⁵ *Id.*

⁸⁶ *Id.*; however, others might see this argument as one for dilution, not confusion.

⁸⁷ *Rd. Dawgs*, 679 F. Supp. 2d at 286–87.

⁸⁸ And with the amount of donations Komen receives every year, there is a good possibility it could find donors who accidentally gave to the wrong "for the Cure" group and be able to show actual confusion in some cases.

⁸⁹ See generally *supra* note 74.

⁹⁰ See Marks, *supra* note 47 ("Some charities, such as 'Juggling for a Cure,' say they weren't aware Komen used a similar slogan. Others, including 'Kayak for a Cure,' say they were aware of Komen's name.')

Komen, but they would also be competing for the exact same space in the marketplace. And because Komen is a well-known international organization, the likelihood of confusion only increases.⁹¹

A similar analysis applies to the dispute involving the CDH Awareness Mark. Although CHERUBS and Breath of Hope are smaller organizations, a likelihood of confusion analysis focused on the CDH Awareness Mark could also be applied to the dispute and each would litigate on a number of factors. Both organizations are competing in the same marketplace, looking for the same donors, and have a similar level of notoriety. When each organization uses the CDH Awareness Mark or any mark similar thereto, it is looking to build awareness of the CDH condition. Because of these similarities, CHERUBS would be in a similar position to Cancer Research Institute as the first organization to use a mark similar to the asserted mark at issue. This would favor CHERUBS' attempt to remove Breath of Hope's trademark. Furthermore, both organizations will use the word mark in a similar way and for a similar purpose.⁹² Both CHERUBS and Breath of Hope use marks including the term "CDH Awareness" to raise awareness through fliers, rallies, outreach, and other solicitation for families and individuals affected by CDH.

Most significantly in this dispute, a court would need to pay special attention to how a consumer would perceive either organization's use of the term "CDH Awareness." As charitable nonprofits, neither organization is out to sell consumers a product. Instead, the organizations are reaching out to people in need of help in a time of crisis after a devastating diagnosis or child loss. A consumer is unlikely to investigate multiple CDH charities after seeing the word mark. Instead, the person affected by CDH would likely be thankful that someone recognizes and understands what he or she is going through. Thus, a consumer might see the term "CDH Awareness" and not investigate the service organization using the mark. This favors CHERUBS in a likelihood of confusion analysis, but they must prove it in court.

In fact, other factors like actual confusion, the strength of the word mark, and the defendant's intent would require a more substantive investigation than what is available on record for the dispute at the dismissal stage. If the case had proceeded further, a

⁹¹ *Virgin*, 335 F.3d at 149.

⁹² *See Rd. Dawgs Motorcycle Club of the U.S., Inc. v. "Cuse" Rd. Dawgs, Inc.*, 679 F. Supp. 2d 259 (N.D.N.Y. 2009) (infringement found when one organization used "Road Dawgs" to attract bikers in the same geographic location as a nonprofit biker organization with a similar name, lettering, and logo).

court or a jury would likely see a number of factors that weigh in CHERUBS' favor. However, the court or jury would have discretion to weigh different likelihood of confusion factors according to the facts of the dispute.

Meanwhile, a larger charitable nonprofit like Komen could seek to enjoin other organizations from using "for the Cure." Komen was not required to disclaim the words "for the Cure," and therefore was permitted by the trademark office to claim the phrase as part of a mark instead of keeping it open to the public.⁹³ Because Komen is a well-known international organization, it may have staked out its space as the sole organization that can raise money and provide awareness and support for breast cancer. That said, just because Komen could be successful on defending its mark on one claim under current law does not mean it might not try to bolster their case with other methods. Another theory Komen would try to use is market dilution.

C. Market Dilution

One of the goals of Komen's constant presence in the marketplace is to have people associate its name, its symbols, and the color pink with breast cancer awareness and the Komen organization. However, Komen would look to the Lanham Act to stake out as much marketing territory as possible in order to prevent smaller organizations from chipping away, or diluting, the brand it has spent millions to build. Dilution claims under the federal trademark dilution statute, 15 U.S.C. § 1125(c), are commonplace for national and international organizations of Komen's size and notoriety. The rule is meant to protect larger entities that have put time and effort into building their brand from others trying to free ride by wrongfully using an established, highly recognizable trademark.⁹⁴ Thus, this rule would not likely apply to smaller organizations like CHERUBS or Breath of Hope.

If a sufficient number of smaller entities were able to chip away at a mark owned by a larger entity, eventually the mark's value could be harmed beyond repair.⁹⁵ However, scholars have criticized the rule as being overinclusive because even the smallest potential dilutions can be attacked by section 1125.⁹⁶ Furthermore, just because someone else uses words similar to those of an established trademark

⁹³ Horlick's Malted Milk Co. v. Borden Co., 295 F. 232, 234 (D.C. Cir. 1924).

⁹⁴ See Gerhardt, *supra* note 69, at 443–44.

⁹⁵ *Id.* at 444.

⁹⁶ *Id.*

does not mean smaller organizations or later users are lazy or are trying to exploit the original trademark's goodwill.⁹⁷

Although section 1125 allows for injunctions against people making malicious or false use of trademarks, the more significant question is how far mark dilution can reach. There is one significant difficulty in enforcing dilution in a charitable nonprofit context: Section 1125(c) of the Lanham Act states that a dilution claim can only be brought in a commercial setting.⁹⁸

Charitable nonprofit work is not the kind of work that only contemplates a commercial transaction,⁹⁹ and as a result courts would be unlikely to allow an organization like Komen to pursue a federal dilution claim against smaller nonprofits because it operates outside the commercial setting.¹⁰⁰ Thus, even if Komen felt its mark was being chipped away by smaller groups like CHERUBS, Breath of Hope, or events like Kites for a Cure, Komen would be forced to pursue other means to stop smaller nonprofits from encroaching on its marks.

D. Prior Use in Market & the Color Pink

A final, important question for Komen, if it were asserting its trademark, would be whether it could prevent other organizations from using pink by asserting that use by Komen of the color pink in connection with its business constitutes use as a mark. Although it may seem like an extreme step, there are plenty of examples of colors being used and registered as marks throughout industry.¹⁰¹ While many nonprofit cases have involved similar designs and use of color and lettering,¹⁰² Komen's goal is distinguishable because it would only wish to use one single color as an identifying mark. The Supreme Court has weighed in on whether a color by itself can be trademarked

⁹⁷ *Id.* at 444–45.

⁹⁸ 15 U.S.C. § 1125(c)(1) (2006) (“[T]he owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.”).

⁹⁹ *See supra* notes 35–42.

¹⁰⁰ *See* McGeveran, *supra* note 10, at 105–06 (discussing *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 905–07 (9th Cir. 2002)).

¹⁰¹ *See* *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 161 (1995).

¹⁰² *See* *Rd. Dawgs Motorcycle Club*, *supra* note 91, at 285 (N.D.N.Y. 2009).

in the famous and controversial *Qualitex* case.¹⁰³ In the case, Qualitex used a special green-gold color for its laundry press pads, and a competitor was attempting to use the same color for its own press pads.¹⁰⁴

The Court allowed registration of the mark at issue in *Qualitex* because the Lanham Act broadened the common law definition of what marks could be registered.¹⁰⁵ However, the Court held that if a color was aesthetically functional, it could not be registered because removing it from the marketplace would be too damaging.¹⁰⁶ In so holding, the Court also rejected a number of counterarguments, including the idea that there is a limited amount of colors available, and also that uncertainty in the law is created by allowing color trademarks because the same shade changes appearance in different light.¹⁰⁷ In the end, the Court found two major hurdles that a color has to overcome in order to get registered: it must not be functional so that production would limit competition, and it must have acquired a secondary meaning.¹⁰⁸

Komen might have trouble with the non-functional requirement of its pink mark. Courts have repeatedly held that a functional color is one whose removal from the market would keep others from competing with the mark holder.¹⁰⁹ The danger of allowing a functional color to be registered is that, unlike patents and copyrights, a trademark can be renewed *ad infinitum*. Thus, the color would be removed from the marketplace entirely, as long as the registrant continued using that mark in interstate commerce in connection with the corresponding goods or services. For example, in *Brunswick Corp. v. British Seagull*, there was a dispute about whether Mercury could register the color black for its motorboat engines when other companies used the same color.¹¹⁰ Although Brunswick was willing to limit the trademark to a very narrow, specific color of black, the court did not allow the mark to be registered.¹¹¹ The court held black to be aesthetically functional because many people want their motorboat to have an engine that compliments the color of the boat. If black were unavailable, then other competitors would be at a serious

¹⁰³ See *Qualitex*, 514 U.S. 159.

¹⁰⁴ *Id.* at 161.

¹⁰⁵ *Id.* at 162–63.

¹⁰⁶ See *id.* at 170.

¹⁰⁷ See *id.* at 167–74.

¹⁰⁸ *Id.* at 166–68.

¹⁰⁹ See *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1532 (Fed. Cir. 1994) (citing *In re R.M. Smith, Inc.*, 734 F.2d 1482 (Fed. Cir. 1984)).

¹¹⁰ *Brunswick*, 35 F.3d at 1529.

¹¹¹ *Id.* at 1533.

disadvantage in the motorboat industry.¹¹² Thus, because the color black served a specific function, registration of the trademark was denied.¹¹³

Conversely, a color can be registered when the color has no functional aspect and would not block other competition. In *In re Owens-Corning*, a registration for the color mark pink was allowed for a company's insulation because other customers had come to recognize the pink insulation with the Owens-Corning brand.¹¹⁴ The court determined that dyeing the insulation pink served no functional purpose, aesthetic or otherwise, but instead only distinguished the product in the marketplace.¹¹⁵ Furthermore, the pink insulation did not inhibit competition in the insulation industry.¹¹⁶ As a result, the mark was upheld because the color was both non-functional and source identifying.¹¹⁷

What is clear from the cases and commentary is that the non-functional requirement is directly intertwined with economic and market competition considerations. Third parties can oppose the trademark, as was the case in *Brunswick*, but the more likely scenario is that a number of affected third parties will not be informed of any color trademark until the mark is asserted against them. From there, an organization is faced with a choice: reevaluate, and change its entire marketing scheme, or plow forward and challenge the trademark. Charitable nonprofits, many of which work on small budgets, would face a harsh economic loss either way because color is a major source of promotion, marketing, and brand recognition. An organization challenging Komen could argue that pink is associated with women, and denying the use of pink takes a highly associated and recognized color out of the marketplace. Unfortunately, Komen could probably successfully persuade many organizations to use a color other than pink by sending each of them a cease-and-desist letter.¹¹⁸

Of course, there is another requirement Komen would need to hurdle: pink must have acquired secondary meaning.¹¹⁹ Like words, logos, and other items subject to trademark protection, a color gains

¹¹² *Id.*

¹¹³ *Id.*

¹¹⁴ See *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1118 (Fed. Cir. 1985), *abrogated on other grounds by In re Haruna*, 249 F.3d 1327 (Fed. Cir. 2001).

¹¹⁵ *Id.* at 1122–23.

¹¹⁶ *Id.* at 1121.

¹¹⁷ *Id.* at 1128.

¹¹⁸ See Marks, *supra* note 47.

¹¹⁹ *Owens-Corning*, 774 F.2d at 1118.

secondary meaning when, in the mind of the consumer, the color is directly associated with the mark holder as the source of the related goods or services.¹²⁰ A secondary meaning that only refers to an underlying idea or industry is not enough—the secondary meaning must refer to the product producer or service provider.¹²¹ Thus, in order for Komen to show that its use of pink has acquired a secondary meaning, Komen must show that people associate the color with the Susan G. Komen organization. Only evoking “breast cancer awareness” or “curing a disease” is not enough.

One recent relevant example is the dispute between a number of universities and Smack Apparel.¹²² In the *Smack* case, a clothing designer created shirts indicating famous games in college football history and used the colors of the school, such as gold and crimson for the University of Southern California, and a phrase referring to the game itself.¹²³ At no point were the schools mentioned by name, but the products were sold in the same stores where officially licensed university apparel was sold.¹²⁴ The court agreed with the universities that they had a very strong claim on their unregistered color combinations due to their use of the colors for over one hundred years.¹²⁵ This, combined with Smack’s admission that it intentionally used the universities’ colors to improve sales of its product, led the court to find infringement.¹²⁶ While there is little surprise in the Fifth Circuit’s decision based on Smack’s admission, the court’s discussion of color trademarks and market competition provides a glimpse of how a court would evaluate Komen’s color trademark.

A secondary meaning analysis would run slightly differently in Komen’s case because Komen is only registering pink and the universities were asserting a trademark for color combinations.¹²⁷ Still, a number of factors that influenced the *Smack* court would be in play for Komen. First, the court referenced the *Qualitex* decision and explained that the scope of what may be registered is very broad under

¹²⁰ See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9–10 (2d Cir. 1976).

¹²¹ *Id.*

¹²² *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465 (5th Cir. 2008), *cert. denied*, 129 S. Ct. 2759 (2009) (hereinafter “*Smack*”).

¹²³ *Id.* at 471–74.

¹²⁴ *Id.*

¹²⁵ *Id.* at 479.

¹²⁶ *Id.* at 482; see also *id.* at 487–88 (rejecting the concept of aesthetic functionality).

¹²⁷ *Id.* at 472.

the Lanham Act.¹²⁸ Thus, the court moved immediately to whether the colors acquired secondary meaning by using a multi-factor test.¹²⁹ The court used evidence of advertising of the colors, used since the late 1800s, and gave weight to how prominently the colors were used in merchandise.¹³⁰ In addition, the court viewed Smack's admission of using the colors to indicate the universities as evidence that even Smack believed the colors had secondary meaning.¹³¹

When Smack presented evidence showing local businesses also used the universities' colors, the Fifth Circuit rejected the argument that the businesses were also violating the trademarks because they were not competing in the same business space by selling shirts.¹³² Thus, there was secondary meaning in the colors and the court moved to a likelihood of confusion analysis to determine whether there was infringement by Smack.¹³³

If a court analyzing Komen were to go through an analysis similar to that used by the *Smack* court, it would not have the advantage of over a century of using the color pink. However, the other factors outlined by the *Smack* court would weigh in Komen's favor. Komen uses pink in its logo and in its ribbon in advertisements around the world.¹³⁴ The Komen organization receives millions of dollars in donations every year and uses the color pink to help solicit those donations.¹³⁵ Furthermore, the Komen organization receives a lot of unsolicited press coverage of its events and its use of pink is further sent out to the public. As the factors are applied in *Smack*, Komen would have a strong case for claiming its use of pink has acquired secondary meaning.

Unfortunately for smaller charitable nonprofit organizations, the Fifth Circuit's analysis outlines a broader problem courts confront in determining secondary meaning. Courts readily admit that determining secondary meaning is not a perfect science, but when there is consumer testimony, both sides are faced with a battle of the experts to show whose data is more credible.¹³⁶ Thus, smaller

¹²⁸ *Id.* at 476.

¹²⁹ *Id.* at 478–84.

¹³⁰ *Id.* at 476–78.

¹³¹ *Id.* at 478.

¹³² *Id.* at 479.

¹³³ *Id.* at 478.

¹³⁴ Karen McDonald, *U.S. House Honors Nancy Brinker*, PJSTAR.COM, Jan. 20, 2010, <http://www.pjstar.com/news/x1685418888/U-S-House-honors-Nancy-Brinker>.

¹³⁵ *Id.*

¹³⁶ See McGeeveran, *supra* note 10, at 70 (discussing Indianapolis Colts, Inc. v. Metro. Balt. Football Club Ltd. P'ship, 34 F.3d 410, 414–16 (7th Cir. 1994)).

nonprofits are dragged into an expensive fight by necessity to prove a number of fact intensive factors. Furthermore, the test for secondary meaning, at least in *Smack*, is very similar to the test the court uses for consumer confusion.¹³⁷ If the larger organization has spent a lot of time and energy marketing its color, then courts tend to use the same factors to find the mark distinctive and the infringement confusing to customers. The one saving grace for smaller organizations is that the *Smack* holding limits the color infringement to use in the specific industry.

In a nonprofit charity universe where organizations are scrambling for donors' dollars, the definition of competition in the marketplace could arguably be far broader than in *Smack*. Instead of simply selling similar items in the same sporting good stores, a larger organization like Komen could attempt to block other organizations from not only using pink to solicit donations for breast cancer, but also to stop them from using pink to help find cures for diseases in general. The fight between a larger and smaller organization would be about the scope of the marketplace. Unfortunately for Komen, courts tend to limit color trademarks as narrowly as possible.¹³⁸ Thus, Komen could possibly get protection from other organizations using pink to raise money for breast cancer, but its reach could not likely extend to other charitable causes.

Even if the law is on a small charitable nonprofit's side, Komen is not prevented from sending cease-and-desist letters to other organizations to bully them into not using pink.¹³⁹ If a letter is ineffective, Komen could always attempt to drag an "uncooperative" organization into a trademark infringement suit over color. Even if the smaller charitable nonprofit could win under the law, it would still be crushed by the slow, inefficient, costly, and fact-intensive structure of modern trademark litigation. This was the risk organizations like CHERUBS and Sunshine Connection faced, even when they were only facing a similarly situated charitable nonprofit. As the next Section shows, the current structure of trademark law—especially in the likelihood of confusion context—makes it difficult for a small nonprofit to defend its trademark rights without incurring crippling costs.

¹³⁷ *Bd. of Supervisors*, 550 F.3d at 475–76 (using similarity of the colors, use in the marketplace, and consumer opinion on what the colors represent to determine source identification).

¹³⁸ *See, e.g., Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1533 (Fed. Cir. 1994).

¹³⁹ *See Marks*, *supra* note 47.

III. THE FUNCTION OF TRADEMARK DEFENSES IN A NONPROFIT CONTEXT

In order to examine the trademark defenses in a nonprofit context, it is important to reemphasize some of the principal problems in applying the Lanham Act. Obviously, there is just as much potential for disparity in financial resources in charitable nonprofit trademark disputes as in a commercial setting. Some nonprofits operate on miniscule contributions, while others receive millions in donations each year. Oftentimes, a simple cease-and-desist letter is sufficient to get the smaller organization to cave in to the larger organization's interest, even when the law would side with the smaller entity.¹⁴⁰ Even if both parties pursue litigation, the result is a long, expensive conflict riddled with multi-factor tests. Furthermore, trademark protection is caught in constant tension with the First Amendment. While courts structure their rulings to avoid directly using the First Amendment, courts accept the reality that the First Amendment is part of the trademark equation.¹⁴¹ In a charitable nonprofit conflict, the competing interests are balanced a little differently because charitable speech is not considered commercial speech under the First Amendment.¹⁴² But while the speech is intertwined with charitable interests of serving the public good, courts also examine how trademarks influence charities' ability to solicit donations and function in the marketplace.

In other words, charitable nonprofits find themselves in just as murky a quagmire as other parties staving off infringement claims. Two of the most problematic defenses for charitable nonprofits to assert and sustain are fair use and genericism. These defenses are not problematic because trademark defendants cannot win with them.¹⁴³ Instead, they are problematic because they are inefficient and contribute to the problem of charitable nonprofits being ground to mincemeat by the trademark litigation machine. This Section first explores issues surrounding the implementation of a fair use defense. While many smaller nonprofits use of others' trademarks may qualify for the fair use defense, nonprofits cannot afford to assert the defense because jurisdictions require the organization to first disprove likelihood of confusion. Next, this Section discusses how trademarks can become generic. Genericide is a huge problem because it forces

¹⁴⁰ See McGeveran, *supra* note 10, at 62–63.

¹⁴¹ See generally *id.* at 98–104.

¹⁴² *Vill. of Schaumburg v. Citizens for a Better Env't*, 444 U.S. 620, 632 (1980).

¹⁴³ See McGeveran, *supra* note 10, at 59.

larger organizations like Komen to divert donations to actively defending their marks.

A. Fair Use

It does not seem entirely fair to allow one organization, Breath of Hope, to use the phrase “CDH Awareness” and prevent another organization, CHERUBS, from using the same phrase when it is necessary to both of their missions. Yet every day, many small nonprofits face trademark litigation because other organizations stake their claim on snippets of language. One defense available to charitable nonprofits in this context is fair use.

There are multiple avenues for reaching some kind of fair use, but until the *KP Permanent Make-Up* decision, many trademark defendants were required to fight all the way through the consumer confusion test before asserting a fair use defense.¹⁴⁴ In *KP Permanent Make-Up*, two companies were in conflict over the terms “microcolors” and “Micro Colors” in reference to permanent make-up. They were in close competition because their respective permanent make-up products were targeted towards persons looking to cover up injuries or skin maladies.¹⁴⁵ The Ninth Circuit held the defendant needed to show there was no consumer confusion before it could raise a fair use defense.¹⁴⁶ In its landmark ruling, the Supreme Court unanimously reversed the decision and held a fair use defense could succeed even when there was some confusion present.¹⁴⁷ Thus, more charitable nonprofits have a chance at defeating a trademark infringement claim by fair use because there is no longer a requirement to show that consumer confusion is not likely.

The classic first step in examining a fair use defense is the structure under section 33(b)(4) of the Lanham Act.¹⁴⁸ Scholars have pointed to the Seventh Circuit as having the clearest judicial articulation for the statutory language by parsing it down to a three part test: non-trademark use, descriptiveness, and good faith.¹⁴⁹ To use the Komen hypothetical again, a defendant might first show a non-trademark use of “for the Cure” or “for a Cure” by alleging the mark is not being used as a trademark, but as a description of the planned

¹⁴⁴ *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 124 (2004).

¹⁴⁵ *Id.* at 114–15.

¹⁴⁶ *Id.* at 116.

¹⁴⁷ *Id.* at 118–19.

¹⁴⁸ 15 U.S.C. § 1115(b)(4)(2011).

¹⁴⁹ See McGeeveran, *supra* note 10, at 82 (citing Sands, Taylor & Wood Co. v. Quaker Oats Co., 978 F.2d 947, 951 (7th Cir. 1992)).

event, such as “Kites for a Cure,” or the purpose of the group. The same would apply to Kites’ use of pink and CHERUBS’ use of the phrase “CDH Awareness” as simply a description of what the organization is trying to raise.

In order to determine the second requirement, descriptiveness, it is important to first answer whether the use in question is expressive or not. As a general premise, an expressive mark does not identify its source, and as a result does not carry any secondary meaning. Instead, it expresses its own idea.¹⁵⁰ A defendant would claim its use of “for the Cure” and the color pink are merely expressive, and a nonprofit would make a similar argument regarding a word mark like “CDH Awareness.” Each phrase is allowed to carry its own meaning, and the scales should be tipped more towards free expression than language control in a nonprofit setting. After all, “for the Cure” implies the goal is to cure an illness, and the illness is not limited to breast cancer. “CDH Awareness” only refers to awareness of the condition, not the Breath of Hope organization.

However, if a court were inclined to find pink is source-identifying due to the work Komen has done to place it in advertising, a court would very likely limit the color’s trademark to narrow circumstances: raising money for breast cancer awareness, outreach, and research.¹⁵¹ Furthermore, a court might find pink to be functionally aesthetic because of its association with femininity. Blocking others from using it in tandem with diseases that affect women would be too limiting to other charitable nonprofits.¹⁵²

The final good faith requirement is especially important because it deters defendants from inappropriately using marks. However, the reach might not extend far as necessary in any hypothetical Komen litigation. No doubt, some groups using “for the cure” language or using the color pink were already aware of Komen’s use of the phrase and color.¹⁵³ However, these groups are not going to capitalize on the marks like corporate groups would in a commercial setting. Instead, they are raising money to help causes. This is an especially important consideration with CHERUBS. So few people know what CDH is that the phrase “CDH Awareness” is vital to

¹⁵⁰ McGeveran, *supra* note 10, at 82.

¹⁵¹ *See generally* Brunswick Corp. v. British Seagull Ltd., 35 F.3d 1527, 1533 (Fed. Cir. 1994). It is worth mentioning that the Federal Circuit decided the *Qualitex* case, allowing color trademarks, and then has rejected many color trademark claims. One reason is because the trademark needs to be narrow in order to allow competition.

¹⁵² *Id.*

¹⁵³ *See* Marks, *supra* note 47.

outreach. CHERUBS is not trying to ride the coattails of Breath of Hope or any other organization by using the phrase.

While some courts worry about potential for donor confusion, the Supreme Court has spoken in *KP Permanent Make-Up* and ruled some confusion is permissible.¹⁵⁴ Unlike other charitable nonprofit cases, “for the Cure” is used both by Komen and other organizations in conjunction with another idea like a race or kite flying. It does not stand on its own, but instead is short and to-the-point. The same idea applies to the phrase “CDH Awareness.” The language itself only points to the condition and awareness, not Breath of Hope or CHERUBS specifically. Unlike the mid-80s and early-90s, courts today do not require trademark defendants to find alternate language.¹⁵⁵ In a charitable nonprofit setting, a court would be more likely to let the expressive language “for the Cure” and “CDH Awareness” stand if the defendant or petitioner acted in good faith.

Of course, the “classic” Lanham Act defense is not always the best one available. Another example is the nominative fair use doctrine created in the *New Kids on the Block* case and subsequently codified in the Lanham Act.¹⁵⁶ In *New Kids*, two national print publications opened contests to allow people to vote for their favorite member of New Kids on the Block.¹⁵⁷ In striking down a trademark infringement claim, the Ninth Circuit held there was fair use because the use of the group’s name was necessary to describe and conduct the contests.¹⁵⁸ The doctrine has been expanded to include words that are necessary to be used in descriptions, even if they are registered marks. Thus, while a group like Komen might attempt to block smaller nonprofits from using “for the Cure” or “for a Cure,” there would be a valid nominative fair use defense. There is no source identification of the mark holder—Susan G. Komen for the Cure—when an event like “Kites for a Cure” takes place. Instead, the language is necessary to demonstrate that individuals will be flying kites for curing lung cancer. Once again, the analysis extends to CHERUBS’ use of “CDH Awareness.” The use only applies to CDH itself, and in no way points to Breath of Hope.

Finally, it is worth mentioning that there are other statutory exceptions in the Lanham Act that would greatly aid charitable

¹⁵⁴ *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 124 (2004).

¹⁵⁵ Kravitz, *supra* note 20, at 145–46.

¹⁵⁶ 15 U.S.C. §§ 1051-1141 (2006).

¹⁵⁷ *New Kids on the Block v. News Am. Pub., Inc.*, 971 F.2d 302, 304 (9th Cir. 1992).

¹⁵⁸ *Id.* at 309–10.

nonprofits. Although some courts have found tarnishment in charitable trademark disputes,¹⁵⁹ such a finding is inappropriate based on courts' strict construction of the statute. Under the federal dilution statute recently added to the Lanham Act, it is required that any diluting act be a "commercial" use.¹⁶⁰ Courts have found commercial use in soliciting donations, but according to case law charitable solicitation is non-commercial.¹⁶¹ There are elements of commerce present, but charity is too intertwined with the public interest to give the speech anything other than full First Amendment protection.¹⁶²

Thus, any dilution claims Komen could bring against smaller organizations for using "for the Cure" or the color pink would best be fought under the plain language of the statute itself. Because the speech is not commercial, the states' interest in limiting speech to protect the mark holder is not strong enough to prevent others from potentially chipping away at the mark's meaning.¹⁶³ Furthermore, groups using similar marks are typically not going to tarnish the mark because they are working toward a similar goal. Thus, unless there is some bad faith in naming an event or organization, a court would likely not find dilution or tarnishment in a charitable nonprofit setting for use of the color pink or "for the Cure." Dilution would not apply to Breath of Hope and "CDH Awareness" because the organization is too small for national dilution to be an issue. That said, larger organizations are in danger of having their mark diluted or tarnished if left unattended to in the commercial marketplace. That is not the only possible consequence though: if the mark becomes too ingrained in everyday speech it could be found generic.

B. Genericness of Trademarks

The greatest danger in allowing organizations to use colors like pink or phrases like "for the Cure" or "CDH Awareness" is that they could lose all trademark protection by becoming generic. The potential for genericide of trademarks has created a catch-22 for larger organizations like Komen. Although Komen is an international organization receiving millions of dollars each year, it also must actively assert and protect its trademarks. If it fails to challenge

¹⁵⁹ *Rd. Dawgs Motorcycle Club of the U.S., Inc. v. Cuse Rd. Dawgs, Inc.*, 679 F. Supp. 2d 259, 290 (N.D.N.Y. 2009).

¹⁶⁰ 15 U.S.C. § 1125(c)(1).

¹⁶¹ *See generally supra* notes 36–43.

¹⁶² *See generally id.*

¹⁶³ Although some state dilution statutes do not have the same commerce requirement.

others' use of them, it runs the risk of the mark becoming generic.¹⁶⁴ However, try as it might, a defendant may have a much stronger case for claiming "for the Cure" is generic because of the way Komen has phrased and attempted to use the mark. The same can be said about Breath of Hope's "CDH Awareness" mark.

A generic term is not eligible for trademark protection.¹⁶⁵ Taking a generic word out of the marketplace leaves competitors out in the cold. Komen's worry is that its trademark, "for the Cure" will become generic if it does not act to protect it. One of the first significant disputes where a court ruled a previously trademarked term generic was "aspirin."¹⁶⁶ Bayer had never described its headache medicine as anything other than "aspirin," and as a result the word lost all of its significance as a source identifier.¹⁶⁷ Aspirin was synonymous with headache medicine, not Bayer, and as a result the trademark protection was lifted.

A similar ruling doomed Kellogg and the term "shredded wheat."¹⁶⁸ In that case, Kellogg only advertised with the words "shredded wheat."¹⁶⁹ Although many people still identified shredded wheat with the manufacturer, Kellogg, the court found the term generic by creating a distinction between primary significance and subordinate meaning.¹⁷⁰ Even though some of the consuming public associated the mark with its source, the meaning of the words themselves still primarily identified themselves with the product.¹⁷¹ Because Kellogg had only used the term "shredded wheat" to describe the type of food, as opposed to Lego toys, an Apple computer, or a Xerox copier, the term was no longer able to be trademarked.¹⁷²

Unfortunately, this line of cases looks more at the dictionary meaning of the words than the words' impact on the marketplace.¹⁷³ As a result, mark holders push hard to advocate for the dictionary definition of their marked words instead of how the trademark is used in the context of print advertising or charitable solicitations. Organizations like Komen could go after individuals who use the

¹⁶⁴ This is especially a problem for Komen because many of its "for the Cure" marks are less than five years old. See 15 U.S.C. § 1065 (2010).

¹⁶⁵ Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 412 (1990).

¹⁶⁶ See *Bayer Co. v. United Drug Co.*, 272 F. 505 (S.D.N.Y. 1921).

¹⁶⁷ *Id.* at 510–11.

¹⁶⁸ *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 113 (1938).

¹⁶⁹ *Id.* at 113–14.

¹⁷⁰ *Id.* at 118–20.

¹⁷¹ *Id.*

¹⁷² *Id.*

¹⁷³ Dreyfuss, *supra* note 165, at 421–22.

trademarked term in a way that would make it generic, just to protect its denotative meaning.¹⁷⁴ However, the law as it currently stands may still protect smaller organizations using “for the Cure.” True, unlike Kellogg and Bayer, Komen does use the term “for the Cure” in conjunction with other words like “pitch,”¹⁷⁵ “nurses,”¹⁷⁶ and “crunch.”¹⁷⁷ Furthermore, none of Komen’s marks disclaims the phrase “for the Cure.”¹⁷⁸ However, defending “for the Cure” by itself is a much more difficult task because the meaning is more strongly linked to finding a cure for a disease than to the Susan G. Komen organization.

Yes, some people will link “for the Cure” with Komen, but the *Kellogg* case would still allow an examination of how others use the term.¹⁷⁹ In a charitable nonprofit view, “for the Cure,” can be a reference to many different kinds of cures, and the attached meaning is entirely up to the person participating in the event or organization. Like the term “shredded wheat” in the *Kellogg* case, “for the Cure” is more of a description of what is being provided. Even though Komen is still fighting for the meaning of the word and filing new “for the Cure” trademarks, Komen may have already lost the war. The phrase could be found generic because of how ubiquitously it describes the goal of the organization.

Breath of Hope’s “CDH Awareness” mark would likely fail under a similar *Kellogg* analysis. By itself, the language only refers to the condition “Congenital Diaphragmatic Hernia” and awareness of the condition. The use of the phrase does not point to Breath of Hope any more than it does to CHERUBS, but instead directs the reader to a condition they are both attempting to raise awareness for. By only describing a goal of the organization, and especially in First Amendment balancing in charitable commercial speech, Breath of Hope’s trademark is generic. Allowing the mark to stand would do too much damage to any other organization looking to serve the public good by raising awareness of CDH. Unfortunately, saber rattling, cease-and-desist letters, and the threat of litigation by organizations like Breath of Hope and Komen prevent many organizations from helping the public good. Below are some suggestions to move the balance of power back towards smaller nonprofits with high aspirations but no budget to litigate trademarks.

¹⁷⁴ See McGeveran, *supra* note 10, at 58.

¹⁷⁵ PITCH FOR THE CURE, Registration No. 3,236,109.

¹⁷⁶ NURSES FOR THE CURE, Registration No. 3,109,295.

¹⁷⁷ CRUNCH FOR THE CURE, Registration No. 3,107,181.

¹⁷⁸ See *supra* notes 56–57, 59, and 175–77.

¹⁷⁹ *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 120 (1938).

IV. HOW TO EASE THE BURDENS OF NONPROFIT TRADEMARK LITIGATION

An outside observer may not see much of a problem with the current trademark system. Organizations can claim marks to protect their charitable interests, and smaller organizations have a series of defenses to work with if larger organizations attempt to go after them or overreach. However, while the law has recently begun to favor smaller organizations by giving greater weight to the First Amendment in trademark cases,¹⁸⁰ there is still a large problem. Trademark cases are expensive. Many courts require proof of a number of multi-factor tests, especially likelihood of confusion.¹⁸¹ This generally requires substantial outside data and expert testimony. Of course, when one side hires an expert, the other side is at a disadvantage if it does not.¹⁸² Furthermore, a national organization can put a smaller organization on its heels by forum shopping for circuits with favorable law.¹⁸³ The result is that even if a smaller organization wants to fight, it would be choosing to dump its donor money into legal fees instead of the cause it received donations for initially. On the other hand, the organization may do irreparable harm to itself by attempting to rebrand itself in order to avoid trademark litigation

There is no easy fix to this kind of expense and disparity, and it is unrealistic to expect that smaller organizations will have the legal prowess of larger organizations. However, below are a few suggestions that would help smaller organizations by increasing legal predictability. As a result, smaller organizations would be able to react to cease-and-desist letters from larger organizations.

First, the *KP Permanent Make-Up* standard needs to be applied in all Circuits.¹⁸⁴ The Supreme Court did a great deal to help smaller organizations because they no longer have a burden to disprove likelihood of confusion before moving on to fair use. The Ninth Circuit's dismantling of the case on remand by paying lip service to the Supreme Court is inadequate because the Circuit merely reestablished its old likelihood of confusion before fair use rule.¹⁸⁵

¹⁸⁰ See McGeveran, *supra* note 10, at 59–60.

¹⁸¹ *Id.* at 113–14.

¹⁸² *Id.* at 70.

¹⁸³ See, e.g., *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 487–88 (5th Cir. 2008) (Fifth Circuit refusing to acknowledge the aesthetic functionality doctrine); see also *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.* 543 U.S. 111, 115–16 (2004) (Ninth Circuit not allowing Fair Use unless likelihood of confusion is disproven).

¹⁸⁴ See *supra* notes 144–147.

¹⁸⁵ See McGeveran, *supra* note 10, at 114.

Instead, the Fourth Circuit has the right idea: allow the fair use defense to be brought up when it applies—when there is a potential for likelihood of confusion.¹⁸⁶ If there was none, then there would be no need for a fair use defense. If the *KP Permanent Make-Up* standard is enforced, there will be less need to spend extra money on outside research, experts, and expensive fact-based inquiries. As a result, small nonprofits like CHERUBS might be able to establish fair use and win in a summary hearing instead of being bogged down in court.

Second, the likelihood of confusion factors are different both in wording and implementation across the country.¹⁸⁷ Some Circuits weigh some factors more than others, while other Circuits leave out factors entirely. The correct solution, for the legislature, not the judiciary, is to write a likelihood of confusion multifactor test into the Lanham Act to create national uniformity in application. The legislature has already done this by adding a blurring test to section 1125, so there is precedent supporting the creation of statutory factors.¹⁸⁸ That way, courts would be applying the same factors, no matter the Circuit. Ideally, the legislature would also either give some factors more weight, or allow weight to be given based on the circumstances. This would also allow for more summary adjudications and increase efficiency because courts would not be busy trying to justify their own tests to accommodate problematic fact situations.

Third, the way courts adjudicate genericism needs to change so that larger organizations are not constantly trying to fight smaller organizations or individuals over the use of the marks. As of now, the law allows for an examination of the meaning of the words without examining the context of how they are used in the market.¹⁸⁹ This leaves larger organizations like Komen at a disadvantage because, through national marketing, they could be contributing to degrading their own marks as generic. Instead, courts should look at how the term is used in a market context. True, charitable nonprofit solicitation is not commercial speech, but different organizations are still working within the same marketplace to solicit donations from a limited pool of potential donors. In that sense, the need to avoid consumer confusion for marks that identify their source is strong.

¹⁸⁶ See *Shakespeare Co. v. Silstar Corp. of Am., Inc.*, 110 F.3d 234, 243 (4th Cir. 1997) (“[I]t defies logic to argue that a defense may not be asserted in the only situation where it even becomes relevant.”).

¹⁸⁷ See, e.g., *supra* note 72.

¹⁸⁸ 15 U.S.C. § 1125(c)(2)(B)(i-vi).

¹⁸⁹ See Deven R. Desai & Sandra L. Rierson, *Confronting the Genericism Conundrum*, 28 CARDOZO L. REV. 1789, 1791 (2007).

One very useful proposal by Deven R. Desai and Sandra L. Rierson is to have courts use a two-step process for determining whether a mark is generic.¹⁹⁰ First, the court must determine whether the mark is source-identifying. This is similar to the requirement used for descriptive marks.¹⁹¹ Then, if the mark is source-identifying, the court must examine whether removing the mark would be too damaging to potential competition. In the case of nonprofits, this means determining if denying the mark to other users hinders them from soliciting funds. If so, then the mark is generic even if it is source-identifying.¹⁹² By this standard, Breath of Hope's mark on "CDH Awareness" would be generic because it does not refer solely to Breath of Hope and removing it would severely hinder CHERUBS and other organizations from raising CDH awareness.

This streamlined test protects both the mark holder and the potential defendant by allowing the court to examine how the mark is used in the marketplace. Instead of wrangling over what the words mean and what is of "primary significance," both sides can focus on how they already use the words in question.¹⁹³ The use should be narrow in scope and focus on the type of charitable organization, not whether the organization is a charity. An international organization like Komen should not be able to block any charity from raising funds for curing a disease with its "for the Cure" trademark. Hopefully, this narrow focus would reduce the amount of cease-and-desist notices sent to organizations that are not in the same market.

Finally, in order to deter mark holders from frivolously or maliciously attacking innocent charitable nonprofits, the court should be broader in its implementation of section 1117 of the Lanham Act. The Act currently provides for attorneys fees to be awarded to the defendant in the case of extraordinary circumstances, and as equity requires.¹⁹⁴ As shown above, charities using donor dollars to go after other charities is a drain on money that could be better serving the public good. By allowing a broader recovery mechanism in charitable nonprofit cases, courts would deter organizations from starting fights that could cost them in the long run. If the question is close, then there may be a legitimate dispute. However, a defendant, who has just as much of a right to attorneys' fees as a plaintiff, should not have to carry the cost when a frivolous suit is brought against it. Of course, the largest organizations, like Komen, may be able to absorb the cost,

¹⁹⁰ *Id.* at 1846–51.

¹⁹¹ *Id.* at 1846–48.

¹⁹² *Id.* at 1850–51.

¹⁹³ *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 118 (1938).

¹⁹⁴ 15 U.S.C. § 1117(a).

but siphoning more funds from donor dollars to absorb added litigation costs would be very bad press. Meanwhile, the risk of being hit with attorneys' fees would deter many smaller organizations like Breath of Hope from filing illegitimate, deficient trademark claims. Because the First Amendment's protection on expression has more weight in charitable nonprofit trademarks, the best method for protecting expression might be to have parties not go to court at all.

V. CONCLUSION

In an ideal world, charitable organizations would look over their shoulder and be happy that other organizations are working towards similar goals and helping the same cause. Unfortunately, charitable nonprofit work can also be a big business with a lot at stake, not just for recipients of services, but for service providers themselves. Like other commercial organizations, they spend money promoting their causes and soliciting donations. However, these donations are only meant to support the growth of the nonprofit and help the public interest.

Thus, trademark disputes for charitable entities have higher stakes because the groups survive only by the generosity of those who believe their donations will be used for charitable work. While a small charitable nonprofit may have a legitimate defense against a trademark claim, the inefficiency of trademark litigation greatly hinders either what organizations can do to stave off trademark claims or devote resources to helping others.

Unfortunately, smaller nonprofits like CHERUBS are left in dire straits whether they are faced with a deficient trademark infringement action by Breath of Hope or if they receive a cease-and-desist from a mega-nonprofit like Komen. In order to survive, small nonprofits must either fight a battle they cannot afford to fight or cave to the zealous claimant. Although one goal of trademark law is to protect ideas in the commercial marketplace, the tension created by trademark suits against charitable nonprofits is unjustified. Any commercial trademark protection must be balanced against a nonprofit's charitable goals and First Amendment rights. This balance must be weighed in the favor of the smaller nonprofit's use, at least at the start of litigation, because charitable speech is not commercial speech. It receives full First Amendment protection.

In the end, smaller nonprofits like CHERUBS are a vital part grassroots community outreach, and the law must save them from being crushed by the expense of fighting meritless cease-and-desist letters and faulty trademark claims. CHERUBS helps families facing CDH and works to raise public awareness of the condition. The public

interest is best served by allowing CHERUBS to use the phrase “CDH Awareness” despite Breath of Hope’s trademark in the same way Komen should not be allowed to block other organizations from using phrases like “for a Cure” or “for the Cure.” Courts need to recognize that charitable expression is entitled to greater protection than commercial speech and Congress needs to reshape trademark law to keep smaller nonprofits from being at such a distinct disadvantage to larger organizations. Although nonprofits like CHERUBS and Komen may never be on equal financial footing, hopefully one day both sides of trademark disputes will have a more equal footing in court.

