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**REVISITING PARK ‘N FLY: IN PURSUIT OF CONSTRAINTS  
ON TRADEMARK BULLIES**

**Kenneth L. Port<sup>†</sup>**

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<sup>†</sup> Professor Law, William Mitchell College of Law. The author thanks Molly Littman ('16) and Sarah Braman ('18) for their research and editing assistance.

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## I. INTRODUCTION

In 1985, the United States Supreme Court breathed life into the “incontestability” doctrine of trademark jurisprudence in *Park ‘N Fly, Inc. v. Dollar Park and Fly, Inc.*<sup>1</sup> This case stands for the proposition that the holder of a descriptive mark may use it offensively to enjoin other users of the trademark if the mark is registered and if that registration has become incontestable under the Lanham Act.<sup>2</sup> Descriptive marks are usually not enforceable as “merely descriptive” marks that do not possess secondary meaning and, therefore, fail to identify a source.<sup>3</sup> In order to be enforceable, a descriptive mark either has to have secondary meaning or, after *Park ‘N Fly*, must be the subject of an incontestable registration.<sup>4</sup>

In 1993, I wrote an article where I argued that incontestability was inconsistent with the traditional trademark jurisprudence and, as such, was illegitimate.<sup>5</sup> Since the notion of incontestability is inconsistent with the very common law of trademarks that the Lanham Act purports to codify, it is illegitimate, I argued, and should be abolished.<sup>6</sup> Courts, I argued, were very uncomfortable with the notion of incontestability because it was a distinct departure from the common law of trademarks as it existed in 1947 (the year the Lanham Act took effect) and, therefore, had not come to a nationwide, consistent conclusion about its true meaning and significance.<sup>7</sup>

In 2004, the Supreme Court held in *KP Permanent Make-Up, Inc. v. Lasting Impressions I, Inc.* that a descriptive mark that is used descriptively is subject to the fair use defense even if it is subject to a registration that is incontestable.<sup>8</sup> The Court did not take on the incontestability doctrine squarely;<sup>9</sup> however, the Court’s holding has had and will continue to have major ramifications for the doctrine and policy behind incontestability. In fact, although it took twenty years, the Supreme Court has apparently finally agreed with me: The effect of *KP Permanent Make-Up* is to eviscerate incontestability (or so severely

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<sup>1</sup> *Park ‘N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 205 (1985) (holding that an incontestable but descriptive mark is valid and enforceable).

<sup>2</sup> *Id.* at 189.

<sup>3</sup> *Id.* at 196.

<sup>4</sup> *Id.* at 205.

<sup>5</sup> Kenneth L. Port, *The Illegitimacy of Trademark Incontestability*, 26 IND. L. REV. 519 (1993).

<sup>6</sup> *Id.* at 569.

<sup>7</sup> *Id.* at 566.

<sup>8</sup> *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 124 (2004) (holding that a descriptive mark used descriptively is fair use and an injunction is inappropriate even if the mark is incontestable).

<sup>9</sup> *See id.*

restrict the concept of incontestability that it may as well be abolished).

This article juxtaposes the trademark jurisprudence of the *Park 'N Fly* decision (the *Park 'N Fly* doctrine) with that of the *KP Permanent Make-Up* jurisprudence (the *KP Permanent Make-Up* doctrine). It concludes that the *KP Permanent Make-Up* doctrine so eviscerated the *Park 'N Fly* doctrine that it should be seen as having overruled *Park 'N Fly* by implication.

Taken alone, *KP Permanent Make-Up* appears to be doctrinally troubling in light of *Park 'N Fly*. After *KP Permanent Make-Up*, one has to wonder what might be the value of an incontestable registration of a descriptive mark. In *Park 'N Fly*, the answer to that question was easy: an incontestable but descriptive trademark registration was as good as any other registration.<sup>10</sup> However, *KP Permanent Make-Up* eviscerated that concept. *KP Permanent Make-Up* has overruled *Park 'N Fly*, *sub silentio*.<sup>11</sup>

However, *KP Permanent Make-Up* is consistent with the long term Supreme Court trend post-*Park 'N Fly* to progressively restrict trademark rights. It appears that the Supreme Court gave with the hand called *Park 'N Fly* and has taken back with the hand called *KP Permanent Make-Up*. The Court ought to be intellectually honest and expressly overrule *Park 'N Fly*.

The effect of this jurisprudence will be a far more restrictive trademark right compared to the trademark right after *Park 'N Fly*. Incontestability was one incentive to encourage people to file trademark applications with the federal government under the Lanham Act and produce a nationwide, searchable record.<sup>12</sup> The United States system of trademark registration is a voluntary one.<sup>13</sup> Trademark rights in the United States inure to the user of the mark upon use of a mark, not upon registration of the mark.<sup>14</sup> The primary objective of incontestability in 1947, when the Lanham Act was passed, was to encourage entities to register their trademarks.<sup>15</sup> Maintaining incentives to registration is a

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<sup>10</sup> See *Park 'N Fly*, 469 U.S. 189.

<sup>11</sup> See *KP Permanent Make-Up*, 543 U.S. 111.

<sup>12</sup> See 15 U.S.C. § 1065 (2012) (“Subject to the conditions above specified in this section, the incontestable right with reference to a mark registered under this chapter shall apply to a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905, upon the filing of the required affidavit . . .”).

<sup>13</sup> 15 U.S.C. § 1051(a)(1) (2012) (“The owner of a trademark used in commerce may request registration of its trademark on the principal register . . .”).

<sup>14</sup> *In re Trade-Mark Cases*, 100 U.S. 82, 94 (1879) (“[The trademark right] requires no fancy or imagination, no genius, no laborious thought. It is simply founded on priority of appropriation.”).

<sup>15</sup> S. REP. NO. 79-1333, at 4 (1946) (“Trade-marks encourage the maintenance of quality by securing to the producer the benefit of the good reputation which excellence

principal concern when attempting to maintain a healthy trademark registration system that gives notice to all as to specific claims to trademarks and the scope of those trademarks.<sup>16</sup> As trademark registration has become an ingrained notion in the protection of trademarks in America, it is arguable that such incentives are no longer needed.

Most importantly, this means that all of the people who argued after *Park 'N Fly* and after the Lanham Act took effect that the incontestability provisions meant trademarks were subject to property ownership were simply wrong.<sup>17</sup>

When *KP Permanent Make-Up* overruled, *sub silentio*, the *Park 'N Fly* decision and all that it stood for, the trademark registration system was undermined but, at the same time, the Supreme Court minimized and clarified the scope of the trademark right. It is quite clear that the current Supreme Court is uncomfortable with the broad trademark right the Court created in 1993 with *Park 'N Fly* and that the Court today sees the trademark right much more narrowly than the Court did in 1993.

This is an appropriate redrawing of the scope of the trademark right. In a time when the trademark right has grown to the point that “trademark bullying” becomes possible, attempts to constrain trademark bullying will have a positive effect on small and medium sized business entities.<sup>18</sup> Of course, the Court has to walk a fine balance. Although *Park 'N Fly* drew the scope of the trademark right too broadly, the Court must be cognizant of a trademark right which is too narrowly construed. A trademark right that is drawn too narrowly will stifle economic competition and stifle the United States’ economy.<sup>19</sup> It appears that with *KP Permanent Make-Up* and its progeny, the Court is finding its center. This is good and appropriate,

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creates. To protect trade-marks . . . is to protect the public from deceit, [and] to foster fair competition . . . . This is the end to which this bill is directed.”).

<sup>16</sup> See *In the Matter of Certain Alkaline Batteries*, Inv. No. 337-TA-165, USITC Pub. 1616 (Nov. 1984) (“If there was no return from having a recognizable trademark, companies would have no incentive to develop trademarks, and without trademarks that allowed customers to recognize manufacturers and reward their quality with continued purchases, manufacturers would have no incentive to develop quality goods.”).

<sup>17</sup> S. REP. NO. 1333-79, at 3–4 (1946) (“There is no essential difference between trade-mark infringement and what is loosely called unfair competition.”).

<sup>18</sup> See Kenneth L. Port, *Trademark Extortion Revisited*, 14 CHI.-KENT J. INTELL. PROP. 217 (2015) (demonstrating that 5.5% of all reported cases are likely trademark bullying cases). Trademark bullying is the use of a non-famous mark to attempt to enforce trademark rights against a non-competitor.

<sup>19</sup> S. REP. NO. 1333-79, at 3 (1946) (“[P]rotecting trade-marks and making infringement and piracy unprofitable . . . can be done without any misgivings and without the fear of fostering hateful monopolies . . . .”).

and we should recognize and celebrate that fact. However, to be sure, *KP Permanent Make-Up* eviscerates the concept of incontestability.<sup>20</sup> In order to sustain the outcome in *KP Permanent Make-Up* and this new conception of fair use, we must accept the fact that; to do so, the *Park 'N Fly* doctrine and incontestability no longer plays the role in American trademark jurisprudence that it once did. It is no longer a strong right granted to trademark holders to encourage them to register their marks. It now can be easily obviated by claiming that a defendant is using a descriptive (and incontestable) mark descriptively and thereby obviating the harsh consequences of *Park 'N Fly*.

## II. CONTEXT

Trademark incontestability is a significant component of the registration system in the United States.<sup>21</sup> Under the Lanham Act, a registration becomes incontestable when it has been used continuously

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<sup>20</sup> See *supra* text accompanying notes 8–9.

<sup>21</sup> 15 U.S.C. § 1065 (2012). In fact, it has been the source of an impressive body of legal scholarship. See Maya Alexandri, *The International News Quasi-Property Paradigm and Trademark Incontestability: A Call for Rewriting the Lanham Act*, 13 HARV. J.L. & TECH. 303, 373 (2000) (“The consumptive function of trademarks pushes trademarks toward full-fledged property and favors incontestability.”); Maury Audet, *Functionality Unanimously Trumps Incontestability after Trademark Law Treaty Act and Wilhelm Pudenz v. Littlefuse, Inc.: Next Replace Misnomer “Incontestable” with “Conclusive,”* 40 IDEA 473, 492 (2000) (“[W]ithout a functionality defense, upholding a trademark with functional features because of the mark’s incontestable status would amount to an unconstitutional extension of the patent clause.”); Joni Borzcek, *Trademark Rights and Their Implementation: Cancellation of Generic Incontestable Marks*, 19 J. CONTEMP. LEGAL ISSUES 185, 185 (2010) (“The Lanham Act invites petitions ‘at any time’ to cancel the registration of marks that have become ‘generic.’ ‘At any time’ applies to marks that the Act acknowledges as ‘incontestable.’”); Vishal Budhwa, *Incontestability: The Mark as Property, Trademarks*, 12 J. CONTEMP. LEGAL ISSUES 164, 167 (2000) (coming to the mistaken conclusion that incontestability makes trademarks themselves subject to property protection); Bradley Haas, *Trademark Protection and Acquiring the Status of Incontestability*, 12 J. CONTEMP. LEGAL ISSUES 159, 163 (1998) (“[A] registrant would be foolish—and the registrant’s trademark attorney at risk for malpractice—not to comply with the requirements and takes the steps necessary toward acquiring incontestability for a registered mark.”); Jason K. Levine, *Contesting the Incontestable: Reforming Trademark’s Descriptive Mark Protection Scheme*, 41 GONZ. L. REV. 29, 79 (2006) (“[P]rotecting descriptive marks in their current fashion is anti-competitive . . . . Furthermore, the evidence that descriptive marks are not needed for success today is all around us . . . .”); Suman Naresh, *Incontestability and Rights in Descriptive Trademarks*, 53 U. CHI. L. REV. 953, 991–92 (1986) (“[I]ncontestability provisions of the Lanham Act permit a seller to monopolize a descriptive trademark . . . [and] increase the incentive for sellers to choose descriptive marks for their goods . . . .”).

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for five years or in connection with the goods or services named in the Identification of Goods and Services and the Registrant files a Section 15 Affidavit with the United States Patent and Trademark Office (USPTO).<sup>22</sup> Although technically not “incontestable” in the sense that reasons to contest the mark remain even after five years of continuous use, one very important reason to object to a registration is extinguished.<sup>23</sup> That is, once incontestable, the otherwise valid challenge to a registered trademark that the mark is or has become merely descriptive is eliminated.<sup>24</sup>

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<sup>22</sup> 15 U.S.C. § 1065 (2012).

<sup>23</sup> 15 U.S.C. § 1064(3) (2012) (detailing that trademark registration is subject to cancellation “[a]t any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently . . .”).

<sup>24</sup> Generally, one can contest a trademark as merely descriptive under 15 U.S.C. § 1052(e); however, the only defenses available to oppose an incontestable registration include:

That the registration or the incontestable right to use the mark was obtained fraudulently; or

That the mark has been abandoned by the registrant; or

That the registered mark is being used by or with the permission of the registrant or a person in privity with the registrant, so as to misrepresent the source of the goods or services on or in connection with which the mark is used; or

That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party’s individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin; or

That the mark whose use by a party is charged as an infringement was adopted without knowledge of the registrant’s prior use and has been continuously used by such party or those in privity with him from a date prior to (A) the date of constructive notice of the mark established pursuant to section 1057(c) of this title, (B) the registration of the mark under this chapter if the application for registration is filed before the effective date of the Trademark Law Revision Act of 1988, or (C) publication of the registered mark under subsection (c) of section 1062 of this title: *Provided, however*, that this defense or defect shall apply only for the area in which such continuous prior use is proved; or

That the mark whose use is charged as an infringement was registered and used prior to the registration under this chapter or publication under subsection (c) of subsection 1062 of this title of the registered mark of the registrant, and not abandoned: *Provided, however*, that this defense or defect shall apply only for the area in which the mark was used prior to such registration or such publication of the registrant’s mark; or

That the mark has been or is being used to violate the antitrust laws of the United States; or

That the mark is functional; or

That equitable principles, including laches, estoppel, and acquiescence, are applicable.

*continued . . .*



Using a very simple filing procedure with the USPTO that does not get the attention of an Examiner, but only a filing clerk, a holder of a subsisting registration can file a Section 15 Affidavit.<sup>25</sup> This affidavit is reviewed for form only, not substance.<sup>26</sup> On this form, the registrant claims that it has been using the mark in commerce for five years and it has done so continuously.<sup>27</sup> If signed by the proper authority of the registrant, is appropriately dated, and other simple and technical formalities are followed, it is “acknowledged” by the USPTO.<sup>28</sup> Once it is accepted, the trademark registration is deemed to be incontestable.<sup>29</sup>

Originally, this was seen as an important incentive to encourage trademark holders to register their trademarks with the USPTO.<sup>30</sup> Unless registration occurred, searching to determine availability and priority on a national basis was frustrated.<sup>31</sup> As registration proceeded voluntarily in the United States,<sup>32</sup> Congress felt that it needed to provide incentives to encourage registration.<sup>33</sup> Today, of course, it is all computerized; but in 1947, the effective date of the Lanham Act, searching was all done manually. Therefore, it was essential to a functioning national trademark system to have one location to search

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15 U.S.C. § 1115(b)(1)-(9) (2012) (emphasis in original). Additionally, unrelated reasons to cancel an incontestable registration are provided for in 15 U.S.C. § 1064(3), (4), and (5). Most important of these reasons is that the mark becomes generic.

<sup>25</sup> TMEP § 1065 (8th ed. July 2015) (“the USPTO reviews the affidavit or declaration to determine whether it is consistent with the requirements of the statute and rules”).

<sup>26</sup> TMEP § 1065 (8th ed. July 2015).

<sup>27</sup> 15 U.S.C. § 1065(3) (2012).

<sup>28</sup> 15 U.S.C. § 1065 (2012) (“The Director shall notify any registrant who files the above-prescribed affidavit of the filing thereof.”).

<sup>29</sup> TMEP § 1065 (8th ed. July 2015).

<sup>30</sup> See *Park ‘N Fly*, 469 U.S. at 198; David W. Barnes & Teresa A. Laky, *Classic Fair Use of Trademarks: Confusion About Defenses*, 20 SANTA CLARA COMPUTER & HIGH TECH. L.J. 833, 881 (2003).

<sup>31</sup> Jon R. Cavicchi, *Trademark Searching Tools and Strategies: Questions for the New Millennium*, 46 IDEA 649, 651 (2006) (highlighting Glenn A. Gundersen’s observation that “[in] the not-too-distant past, conducting a search to determine the availability of a proposed trademark was a relatively simple process. Trademark lawyers relied for the most part on outside professional search organizations, which provided reports focusing primarily on marks registered with the U.S. Patent and Trademark Office . . .”).

<sup>32</sup> 15 U.S.C. § 1051(a)(1) (2012) (“The owner of a trademark used in commerce may request registration of its trademark on the principal register . . .”) (emphasis added).

<sup>33</sup> See *Hearing on H.R. 82 Before the Subcomm. of the S. Comm. on Patents*, 78th Cong., 2d Sess. 21 (1944) (testimony of Daphne Robert, ABA Committee on Trade Mark Legislation) (“This bill will bring about . . . an incentive to register because it provides in section 15 . . . an incontestable right.”).

for competing trademarks. The Principal Register of the USPTO,<sup>34</sup> where all trademarks become registered and listed, serves as that one point for searching purposes, but it is only effective if holders of trademarks register their rights with the USPTO.<sup>35</sup> Without registration, and prior to the advent of computer search engines such as Google, Bing, Yahoo, etc., effective searching was nearly impossible. Therefore, Congress provided the incentive of incontestability to encourage compliance in a voluntary system.<sup>36</sup>

Perhaps the most important incentive is in the form of a statutory presumption. Section 33(b) of the Lanham Act states as follows:

To the extent that the right to use the registered mark has become incontestable under section 15, the registration shall be *conclusive evidence* of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce.<sup>37</sup>

Under Section 33(a), a trademark registration prior to becoming incontestable is merely "*prima facie*" evidence of the validity of the trademark.<sup>38</sup> Under Section 33(b), this *prima facie* evidence language becomes "conclusive evidence" of the validity of the registration once

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<sup>34</sup> TMEP § 801.02 (8th ed. July 2015) ("When a mark has been registered on the Principal Register, the mark is entitled to all the rights provided by the [Lanham] Act.").

<sup>35</sup> *Id.*

<sup>36</sup> See *Hearing on H.R. 82, supra* note 33, at 128 (statement of Earl H. Thomson) ("[A] trade-mark adopter, when he has registered his trade-mark, wants to feel that after a period of time, certainly he will know that he owns that trade-mark and can maintain his right."); Sylvester J. Liddy, *The Lanham Act—An Analysis*, 37 TRADEMARK REP. 87, 94 (1947) (quoting Casper W. Ooms, the Commissioner of Patents, who said that incontestability would give businesses the "assurance that [their marks] will not forever remain an object of attack" by other businesses using similar marks at the Annual Meeting of the A.N.A. at Atlantic City on September 30, 1946); Casper W. Ooms & George E. Frost, *Incontestability*, 14 LAW & CONTEMP. PROBS. 220, 232–33 (1949); F.T. Alexandra Mahaney, Comment, *Incontestability; The Park 'N Fly Decision*, 33 UCLA L. REV. 1149, 1186 (1986) (recognizing that incontestability provides security and stability for mark owners).

<sup>37</sup> 15 U.S.C. § 1115(b) (2012).

<sup>38</sup> 15 U.S.C. § 1115(a) (2012) ("[A] mark registered on the principal register provided by this chapter . . . shall be *prima facie* evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark . . . but shall not preclude another person from proving any legal or equitable defense or defect . . . which might have been asserted if such mark had not been registered.").



incontestable.<sup>39</sup> Historically, this statutory presumption has been given weight (but in inconsistent amounts) by lower courts when adjudicating incontestable trademarks.<sup>40</sup>

*KP Permanent Make-Up* acts to undermine this statutory presumption. It does this by focusing on a part of Section 33.<sup>41</sup> In Section 33(b)(4), the Lanham Act states as follows:

That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin . . . .<sup>42</sup>

This language has been interpreted as standing for the notion of “fair use” in trademark law.<sup>43</sup> Of course, fair use is a term of art in copyright law where some otherwise infringing uses are forgiven.<sup>44</sup> Fair use in copyright doctrine began long before its inclusion into the Copyright Act of 1976.<sup>45</sup> Fair use in copyright law is an affirmative defense that only arises after the plaintiff makes a convincing showing in his case-in-chief that an infringement has occurred.<sup>46</sup> The defense then argues that the infringing conduct should be forgiven because there has been some market failure and the defendant could not obtain a license to use the work even if it wanted to.<sup>47</sup>

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<sup>39</sup> 15 U.S.C. § 1115(b) (2012) (“To the extent that the right to use the registered mark has become incontestable under section 1065 of this title, the registration shall be conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark . . . .”).

<sup>40</sup> See Port, *supra* note 5.

<sup>41</sup> *KP Permanent Make-Up*, 543 U.S. at 118.

<sup>42</sup> 15 U.S.C. § 1115(b)(4) (2012).

<sup>43</sup> *KP Permanent Make-Up*, 543 U.S. at 121.

<sup>44</sup> Reproduction of copyrighted works for select purposes such as commentary, news, scholarship, or research, is fair use and not an infringement of copyright. *See* 17 U.S.C. § 107 (2012).

<sup>45</sup> H.R. REP. NO. 94-1476, at 65 (1976); H.R. REP. NO. 94-1733, at 7 (1976).

<sup>46</sup> Ned Snow, *The Forgotten Right of Fair Use*, 62 CASE W. RES. L. REV. 135, 168 (2011) (the Supreme Court in *Harper* claimed that the fair use was an affirmative defense and it has been treated as such by subsequent courts but there is no legislative history that supports that conclusion).

<sup>47</sup> 17 U.S.C. § 107 (2014) (Fair use includes consideration of, “the effect of the use upon the potential market for or value of the copyrighted work.”). *But cf.*, *Lenz v. Universal Music Corp.*, Nos. 13-16106, 13-16107, 2015 WL 5315388 (9th Cir. Sept. 14, 2015) (holding that copyright fair use in the context of the Digital Millennium Copyright Act’s take down procedures is a proscriptive right).

It is interesting and, frankly, quite troubling that fair use under *KP Permanent Make-Up* is not an affirmative defense but an absolute defense. We will return to this point below.

The Lanham Act was a codification statute.<sup>48</sup> This is significant because the Lanham Act itself, in the Legislative History, says that the Lanham Act is a codification of the common law and creates no new rights.<sup>49</sup> However, one searches state trademark law prior to 1947 in vain to find a state with an existing incontestability provision in their state law prior to the enactment of the Lanham Act.<sup>50</sup> In fact, Congress borrowed the notion of incontestability from the British and imposed it onto the American trademark system and labeled it part of the common law of trademarks in 1947.<sup>51</sup> The fact is that incontestability was seen as so necessary to encourage a healthy registration system that Congress reached to the United Kingdom and applied it to the Lanham Act<sup>52</sup> and, at the same time, claimed that the Lanham Act was a codification of the Common Law.<sup>53</sup> This is accurate if we presume that by “common law” we include judge made law in the United States and the laws of the United Kingdom, another common law jurisdiction. This was done seamlessly at the time and no one then or now has challenged whose “common law” we were codifying with the Lanham Act.

That is, incontestability was an integral part of making a voluntary trademark registration system work. If there were not incentives to registration, it is likely that the Lanham Act would have been ignored just like the Trademark Act of 1905.

### III. PARK ‘N FLY V. DOLLAR PARK AND FLY

Until the Supreme Court released its opinion in the *Park ‘N Fly* case

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<sup>48</sup> S. REP. NO. 1333-79, at 4–5 (1946) (“There are many statutes dealing with trade-marks which are widely scattered. . . . It seems desirable to collect these various statutes and have them in a single enactment . . . This bill effects this necessary codification and coordination.”).

<sup>49</sup> S. REP. NO. 1333-79, at 5 (1946) (“The Federal Trade-Mark Act has been in operation for over 40 years. . . .The present bill preserves the things which have demonstrated their usefulness.”).

<sup>50</sup> In 1946, prior to effectuation of the Lanham Act, scholars noted that incontestability endowed new administration of law on trade-marks, and a deniable distinction between incontestability and exclusive property rights. Rudolph Callmann, *The New Trade-Mark Act of July 5, 1946*, 46 COLUM. L. REV. 929, 940–41 (1946).

<sup>51</sup> Trade Marks Registration Act 1875, 38 & 39 Vict., ch. 91, § 3 (Eng., Scot., & Ir.). Whether that was an appropriate or legitimate legislative action is beyond the scope of this article.

<sup>52</sup> *Id.*

<sup>53</sup> *Id.*

in 1985,<sup>54</sup> there was much uncertainty about what incontestability in the Lanham Act actually meant.<sup>55</sup> The heading in Section 33(b) for the section regarding incontestability is labeled as follows: “Incontestability; defenses.”<sup>56</sup> That is, on the very surface of the Lanham Act, it appears that Section 33(b) will provide a list of defenses one might assert when one’s trademark registration is challenged, but it is not clear when those rights ought to be asserted. Would it be appropriate to assert those rights in an infringement setting of an incontestable mark<sup>57</sup> or are these exclusively defenses to a claim that the trademark is invalid and should be either canceled or opposed before the USPTO?<sup>58</sup>

At the same time, some claimed that the word “defenses” in the Lanham Act did not mean defenses at all or, at least, it was not limiting language in any way.<sup>59</sup> Headings as statutory language, are arguably not part of the Lanham Act at all or certainly not controlling.<sup>60</sup>

On appeal to the Ninth Circuit, the court there held that one may not use an incontestable registration in an offensive manner.<sup>61</sup> In effect, the Ninth Circuit agreed that the title of “defenses” meant that Section 33(b) could only be used in a defensive manner against challenges of a trademark registration’s validity.<sup>62</sup>

In what certainly proved to be incontestability’s high water mark, the Supreme Court overruled the Ninth Circuit and held that, in fact, a

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<sup>54</sup> *Park ‘N Fly*, 469 U.S. 189 (holding that the incontestable status of a trademark can be used offensively and cannot be contested on the descriptive nature of the mark).

<sup>55</sup> See Ooms & Frost, *supra* note 36, at 232. In 1949, three years before an incontestability case for a descriptive mark could be heard, courts both invalidated registration of descriptive marks and gave little weight to presuming validity of trademarks based on registration.

<sup>56</sup> 15 U.S.C § 1115(b) (2012).

<sup>57</sup> *Id.* Section 1115 does not endorse or prevent offensive use of incontestable registrations. (“To the extent . . . the registered mark has become incontestable . . . the registration shall be conclusive evidence of the validity of the registered mark . . . . Such conclusive evidence of the right to use the registered mark shall be subject to proof of infringement”).

<sup>58</sup> *Prudential Ins. Co. v. Gibraltar Fin. Corp.*, 694 F.2d 1150, 1153 (9th Cir. 1982).

<sup>59</sup> *Park ‘N Fly*, 469 U.S. at 196 (commenting that the Lanham Act does not make an offensive/defensive distinction in the use of incontestable marks).

<sup>60</sup> *Whitman v. Am. Trucking Assoc.*, 531 U.S. 457, 482 (2001) (stating that the interpretive role of a statute title may only be used to clarify an ambiguous word or phrase, and that the interpretive role of a title can be eliminated).

<sup>61</sup> *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 718 F.2d 327, 331 (9th Cir. 1983) (“[A] registrant can use the incontestable status of its mark defensively, as a shield . . . but not offensively, as a sword to enjoin another’s use.”).

<sup>62</sup> *Id.* (The court here decided an incontestable mark should not be used offensively, as the mark “would not be entitled to continued registration but for its incontestable status.”).

descriptive but incontestable trademark registration could be the foundation of an enforcement action.<sup>63</sup> That is, without incontestability, all enforceable trademarks need to have secondary meaning or be inherently distinctive.<sup>64</sup> Merely descriptive marks are not trademarks at all and are unenforceable.<sup>65</sup> Incontestability has the effect of saving descriptive marks.<sup>66</sup> In Justice O'Connor's terms, it can be used "offensively" as well as "defensively."<sup>67</sup>

In so doing, Justice O'Connor elevated the status of incontestability from a mere administrative procedure within the USPTO to respond to motions to cancel or oppose a registration, to a right in an Article III style court that could be used as the sole basis of an enforcement action.<sup>68</sup> Most interestingly, the trademark at issue in the *Park 'N Fly* case was "PARK 'N FLY" for airport shuttle services giving rides to passengers to and from their cars and the airport.<sup>69</sup> That is, it was a remarkably descriptive mark. Never mind that absolute fact, Justice O'Connor opined, the mark was incontestable and, as such, reached a new level of significance under the Lanham Act.<sup>70</sup>

As stated above, the Lanham Act is a statute that codified the common law of trademarks.<sup>71</sup> The Lanham Act is constitutional because it codifies the common law and does not grant new rights.<sup>72</sup> Yet, clearly, here Justice O'Connor's opinion in *Park 'N Fly* operates to create new rights in trademark registration holders of descriptive marks.<sup>73</sup> With incontestability, a descriptive mark is elevated from the dust bin of trademark jurisprudence to an enforceable right that can be commodified and enforced.<sup>74</sup> This is a very good outcome for a registrant who is smart enough to file a simple Section 15 Affidavit with the USPTO.

Although the opinion was authored by Justice O'Connor, Chief Justice Burger, and Justices Brennan, White, Marshall, Blackmun, Powell, and Rehnquist joined her.<sup>75</sup> Only Justice Stevens dissented.<sup>76</sup>

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<sup>63</sup> *Park 'N Fly*, 469 U.S. at 196 ("The statute nowhere distinguishes between a registrant's offensive and defensive use of an incontestable mark.").

<sup>64</sup> *Id.* at 194.

<sup>65</sup> *Id.* at 193-94.

<sup>66</sup> *Id.* at 196.

<sup>67</sup> *Id.*

<sup>68</sup> *Id.* at 205.

<sup>69</sup> *Id.* at 191.

<sup>70</sup> *Id.* at 196 (an incontestable mark may be used to enjoin infringement by others).

<sup>71</sup> See S. REP. NO. 79-1333, at 5 (1946).

<sup>72</sup> *Id.*

<sup>73</sup> *Park 'N Fly*, 469 U.S. at 205.

<sup>74</sup> *Id.*

<sup>75</sup> *Id.* at 190.

<sup>76</sup> *Id.*

In his dissent, Justice Stevens pointed out the obvious. Justice Stevens claimed that the mark “PARK ‘N FLY” was descriptive and therefore was not subject to statutory protection.<sup>77</sup> To bolster his claim, Justice Stevens cited extensively from the legislative history of the Lanham Act.<sup>78</sup> Justice Stevens quoted a lengthy statement by Dr. Karl Pohl<sup>79</sup> who claimed that it would be extremely difficult to get descriptive marks registered by the USPTO.<sup>80</sup> In fact, he stated on the record as follows:

They have very carefully circumscribed procedure for getting these [descriptive] marks on the register. It will by no means be easy, Mr. Chairman and gentlemen of the committee, it will be exceedingly difficult to get these descriptive words on the register. The Patent Office will, in the first place, reject them, and you will have to submit a substantial body of evidence that these words by long-continued usage, have acquired a secondary meaning, and by that long-continued usage have acquired that special status which entitles them to be protected in their secondary meaning sense.<sup>81</sup>

Justice Stevens is clearly perturbed by these representations because, even though Dr. Pohl claimed it would be nearly impossible to register a descriptive mark, in *Park ‘N Fly*, the justices were facing a descriptive mark without secondary meaning.<sup>82</sup> In fact, Justice Stevens points out, Dr. Pohl’s testimony was “misleading” as the “PARK ‘N FLY” mark likely issued with no showing of objective secondary meaning to the USPTO.<sup>83</sup> The registration then subsisted for the requisite five years and the result was an incontestable registration that, in the opinion of the majority, could now be used offensively to enjoin

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<sup>77</sup> *Id.* at 207 (Stevens, J., dissenting) (stating, Park ‘N Fly is at best merely descriptive . . . [and] the registration plainly violated the Act.).

<sup>78</sup> *Id.* at 207.

<sup>79</sup> Dr. Karl Pohl was a mere member of the precursor to the International Trademark Association. Then and now it strongly advocates for trademark holders.

<sup>80</sup> *Park ‘N Fly*, 469 U.S. at 210–11 (Stevens, J., dissenting).

<sup>81</sup> *Id.*

<sup>82</sup> *Id.* at 211.

<sup>83</sup> Dr. Pohl’s testimony indicates that to achieve incontestability, a substantial body of evidence must show the term has acquired secondary meaning, and therefore is entitled to protection. However, Justice Stevens points out Dr. Pohl’s remarks are misleading, “for the ‘Park N’ Fly’ mark issued without any evidence of secondary meaning,” regardless that Congress did not intend “that incontestability should preserve a merely descriptive trademark from challenge when the statutory procedure for establishing secondary meaning was not followed and when the record still contains no evidence that the mark has ever acquired a secondary meaning.” *Id.*

subsequent uses of the same or similar marks on the same or similar products.<sup>84</sup>

This is a very clear judicial expansion of the trademark right using a statute that was meant to codify the common law of trademarks, not grant new rights, and ignores the existing legislative history.

#### IV. BETWEEN PARK ‘N FLY IN 1984 AND KP PERMANENT MAKE-UP IN 2004

In the intervening 20 years between *Park ‘N Fly* and *KP Permanent Make-Up*, there were several significant trademark cases adjudicated by the Supreme Court. When looking at these numerous cases together, it becomes apparent that the Supreme Court went through a period of expanding trademark rights and has since contracted trademark rights. *Park ‘N Fly* and *KP Permanent Makeup* operate as bookends to this trend by the Court. *Park ‘N Fly* acted to vastly expand trademark rights via the incontestability doctrine and *KP Permanent Make-Up* operated to drastically constrict trademark rights.<sup>85</sup>

*KP Permanent Make-Up* is appropriately most often cited for the proposition that when a descriptive mark is used descriptively, this amounts to the fair use of a trademark;<sup>86</sup> however, it is important to realize that, at bottom, the mark in *KP Permanent Make-Up* was an incontestable registration.<sup>87</sup> If incontestability was given the weight that *Park ‘N Fly* seems to dictate, *Park ‘N Fly* should teach away from the final result reached in *KP Permanent Make-Up*. Stated another way, with *Park ‘N Fly* as Supreme Court precedent, the Court in *KP Permanent Make-Up* should have reached a different result than it did. If the mark at issue in *KP Permanent Make-Up* was given the weight that *Park ‘N Fly* dictates, it seems that the Court should have reached a different result regarding the mark’s validity in *KP Permanent Makeup*. Perhaps the Court would have still reached the same result that Lasting’s mark infringed KP Permanent Make-Up’s mark, but if *Park ‘N Fly* weight was given to it, it would have found KP Permanent Make-

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<sup>84</sup> *Id.* at 205 (O’Connor, J., majority) (“[T]he holder of a registered mark may rely on incontestability to enjoin infringement and that such an action may not be defended on the ground that the mark is merely descriptive.”).

<sup>85</sup> *Compare* *Park ‘N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 205 (1985) with *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 124 (2004).

<sup>86</sup> *KP Permanent Make-Up*, 543 U.S. at 122 (“This right to describe is the reason that descriptive terms qualify for registration as trademarks only after taking on secondary meaning . . .”).

<sup>87</sup> Lasting registered the trademark “Micro Colors” in 1993, which achieved incontestable status in 1999. *Id.* at 115.



Up's mark valid and subsisting rather than dismissing it without reaching an infringement analysis.

By dismissing KP Permanent Makeup's mark as unenforceable under the fair use doctrine, the Court, as a matter of law, significantly circumscribed KP Permanent Make-Up's mark and prevented them from reaching a jury verdict on confusion.<sup>88</sup> It is conceivable that, in the *KP Permanent Make-Up* case, if a jury was asked to balance all appropriate infringement factors, a reasonable jury could have found that KP Permanent Make-Up's mark was infringed by Lasting.<sup>89</sup> When the Court interrupted this with its finding that KP Permanent Make-Up's mark, as a matter of law, was unenforceable, the Court curtailed KP Permanent Make-Up's trademark rights to a significant degree.<sup>90</sup> From a Court that pledged to not be an activist Court,<sup>91</sup> this is a clear case of judicial activism making law, rather than applying law.

This begs the question of how we got to this point. In order to understand that, a brief explication of the intervening cases is necessary.<sup>92</sup>

### A. Qualitex

*Qualitex Co. v. Jacobson Prods. Co., Inc.* has the dubious distinction of being one of the Court's, as of yet, uncorrected recent cases regarding trademark law.<sup>93</sup> Uncorrected in the sense that it drastically expanded trademark protection and, unlike others, no subsequent Supreme Court opinion has come along to curtail what was granted here. *Qualitex* expands trademark rights to non-traditional trademarks<sup>94</sup> and it has not yet been curtailed or restricted.

*Qualitex* expanded the notion of trademark jurisprudence. In Justice Breyer's opinion for a unanimous Court, he claimed that the word "any" in the statute meant "any."<sup>95</sup> This is remarkable because so many times

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<sup>88</sup> *Id.* at 124.

<sup>89</sup> *KP Permanent Make-Up* was tried in the 9th Circuit, which applied the *Sleekcraft* factors for trademark infringement. *See* *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979), *abrogated by* *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003).

<sup>90</sup> *KP Permanent Make-Up*, 543 U.S. at 124.

<sup>91</sup> A. E. Dick Howard, *Now We Are Six: The Emerging Roberts Court*, 98 VA. L. REV. IN BRIEF 1, 4 (2012).

<sup>92</sup> For a more thorough treatment of this issue in the context of a Supreme Court constricting trademark jurisprudence, *see* David S. Welkowitz, *The Supreme Court and Trademark Law in the New Millennium*, 30 WM. MITCHELL L. REV. 1659 (2004).

<sup>93</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995).

<sup>94</sup> *Id.* at 161 (stating color alone can operate as a trademark if it identifies source).

<sup>95</sup> "[T]he language 'any word, name symbol, or device' . . . had come to include color." *Id.* at 172.

the Court has defined “any” (or synonymous terms) as meaning something other than “any.”<sup>96</sup> Justice Breyer relied on the specific language of the Lanham Act to say that a trademark consisted of any word, name, symbol or device that operated to identify the source or origin of some good or service.<sup>97</sup> As such, there was no technical reason why color alone could not be the appropriate subject of trademark protection.<sup>98</sup> The Court, therefore, held that a green gold press pad used in the laundry business acted to identify the source of the press pads.<sup>99</sup> The Court clearly said that this holding applied to just the color of the product, not the product itself.<sup>100</sup>

Justice Breyer wrote as follows: “We conclude that, sometimes, a color will meet ordinary legal trademark requirements. And, when it does so, no special legal rule prevents color alone from serving as a trademark.”<sup>101</sup>

Justice Breyer’s opinion is relied on by the USPTO when examining trade dress marks for registration for the proposition that trade dress (specifically in the form of color) must contain secondary meaning to be registered.<sup>102</sup> If Justice Thomas is correct and all trademark doctrine should apply to trade dress seamlessly,<sup>103</sup> it would be possible to have inherently distinctive trade dress and therefore protect appellations of source like color devoid of secondary meaning. Justice Breyer clearly disagreed with this view because he said that a “product’s color is unlike ‘fanciful,’ ‘arbitrary,’ or ‘suggestive’ words or designs, which almost automatically tell a customer that they refer to a brand.”<sup>104</sup> One ponders what Justice Breyer meant by “almost automatically” operates as a trademark as that is the definition of the inherently distinctive

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<sup>96</sup> *Util. Air Regulatory Grp. v. EPA*, 134 S. Ct. 2427, 2442 (2014) (determining that the Clean Air Act usage of “‘any air pollutant’ . . . encompasses only pollutants emitted in quantities that enable them to be sensibly regulated at the statutory thresholds, and to exclude those atypical pollutants . . .”).

<sup>97</sup> Justice Breyer asserts that when Congress reenacted the terms “word, name, symbol, or device” the topic of color was open for reevaluation by the courts against previous precedent restricting the use of color alone as a trademark. *See Qualitex*, 514 U.S. at 173.

<sup>98</sup> *See id.*

<sup>99</sup> *Id.* at 166.

<sup>100</sup> *Id.* at 161.

<sup>101</sup> *Id.*

<sup>102</sup> *See generally* TMEP § 1202.02 (July 2015) (citing and discussing *Qualitex* in the context of color and the registration of trade dress).

<sup>103</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 787 (1992) (Thomas, J., concurring) (“A particular trade dress, then, is now considered as fully capable as a particular trademark of serving as a ‘representation or designation’ of source under § 43(a) [of the Lanham Act].”).

<sup>104</sup> *Qualitex*, 514 U.S. at 162–63 (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9–10 (2d Cir. 1976)).

trademarks from which he was distinguishing.<sup>105</sup> That is, an inherently distinctive trademark operates to identify source inherently or automatically without a showing of secondary meaning.<sup>106</sup> It is certainly not clear what he meant by “almost automatically.” It implies that there is some other way to obtain trademark status for an identifier of source other than by characterizing the mark as inherently distinctive or by showing secondary meaning.

*Qualitex* did not clarify this other than to make the normative pronouncement that color was not like inherently distinctive marks.<sup>107</sup> Silence allowed litigants to fill the void and so people further claimed that *Qualitex* stood for the notion that trademark rights were even further expanded with the *Qualitex* case.<sup>108</sup> *Qualitex* proved to be a significant moment for nontraditional trademarks as the market for trademarks came to believe that “any” really meant “any” and the Supreme Court was going to back this up.<sup>109</sup> In fact, it became so significant that in the forty-eight years prior to *Qualitex*, nontraditional trademarks were the subject of only ninety-three trademark applications to the USPTO.<sup>110</sup> Between 1995 and 2011 (sixteen years), nontraditional trademarks were the subject of 688 trademark applications.<sup>111</sup> *Qualitex* had a major impact on an entity’s claims for non-traditional trademarks. After *Qualitex*, people and corporations began to claim things such as the motion of a spray of water ejected out of the back of a personal watercraft,<sup>112</sup> or the vertically opening motion

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<sup>105</sup> *Qualitex*, 514 U.S. at 162. Justice Breyer commented that “if trademark law permits a descriptive word with secondary meaning to act as a mark, why would it not permit color, under similar circumstance, to do the same?” *Id.* at 163.

<sup>106</sup> *See id.* at 163 (emphasis added) (arguing that a color can identify a source of products similar to descriptive words).

<sup>107</sup> *See id.* at 162–63. Oddly, Justice Breyer even cites *Taco Cabana* for this proposition. It is unclear how *Taco Cabana* supports this proposition and Justice Breyer offers none.

<sup>108</sup> In *Qualitex*, the Court decided that colors that acquired secondary meaning served as a symbol to identify a product and therefore colors are eligible for trademark protection. *Id.* at 166. This led to an amazing increase in interest in “non-traditional trademarks” and spurred the growth of registration and claiming such marks. *See generally* Kenneth L. Port, *On Nontraditional Trademarks*, 38 N. KY. L. REV. 1 (2011).

<sup>109</sup> *Qualitex*, 514 U.S. at 172 (Congress, having retained “the language ‘any word, name, symbol, or device,’ 15 U.S.C. § 1127,” strongly suggests that the statute “had come to include color.”).

<sup>110</sup> Port, *supra* note 108, at 2–3.

<sup>111</sup> *Id.* at 3.

<sup>112</sup> U.S. Patent No. 1,946,170 (filed Jan. 9, 1996) (“The mark is comprised of a three dimensional spray of water issuing from the rear of a jet propelled watercraft and is generated during the operation of the watercraft.”).

of an automobile car door.<sup>113</sup> Even a hologram defined as follows was claimed:

The mark consists of a hologram device which is applied to the goods, trading cards. The mark is discrete from and does not constitute a part of the subject matter of the trading card. Neither the size nor the shape of the hologram device, nor any content which may be represented within the hologram device, nor the positioning of the hologram device on the trading card are claimed as features of the mark.<sup>114</sup>

*Qualitex* is now cited worldwide for the proposition that the scope of trademarks in many countries should be expanded.<sup>115</sup> It is safe to say that *Qualitex* has left a significant and “lasting impression”<sup>116</sup> worldwide regarding what the appropriate scope of trademark protection ought to be. However, did Justice Breyer in *Qualitex* mean to be so expansive? To do so, he had to stretch and re-envision the language of the Lanham Act. To conclude that color and any nontraditional trademark is within the purview of the Lanham Act, it is required that we accept Justice Breyer’s conceptualization of the terms “symbol or device.”<sup>117</sup> However, as I have pointed out elsewhere,<sup>118</sup> the original concept of “symbol or device” appears to be referring to design trademarks as used, for example, as part of an entity’s signage, not the spray that emanates from the rear of a personal water craft that bears the appellation of source of Jet Ski®.<sup>119</sup>

Justice Breyer could have stopped at the point where he found that *Qualitex*’s press pads had acquired secondary meaning and, therefore, amounted to a protectable trademark, but he did not.<sup>120</sup> Justice Breyer takes on the previous objections to finding color alone as appropriate subject matter and even says that he apparently looked and could not “find in the basic objectives of trademark law any obvious theoretical

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<sup>113</sup> AUTOMOBILE LAMBORGHINI HOLDING S.P.A., Registration No. 2,793,439 (“The mark consists of the unique motion in which the door of a vehicle is opened. The doors move parallel to the body of the vehicle but are gradually raised above the vehicle to a parallel position.”).

<sup>114</sup> *In re The Upper Deck Co.*, 59 U.S.P.Q.2d (BNA) 1688, 1689 (T.T.A.B. 2001).

<sup>115</sup> See Glenda Labadie-Jackson, *Through the Looking Hole of the Multi-Sensory Trademark Rainbow: Trademark Protection of Color Per Se Across Jurisdictions: The United States, Spain and the European Union*, 7 RICH. J. GLOBAL L. & BUS. 91, 106 (2008) (omitting the word “device” from the quoted section of the Lanham Act).

<sup>116</sup> Pun intended.

<sup>117</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 172-73 (1995).

<sup>118</sup> Port, *supra* note 108, at 2.

<sup>119</sup> *Id.*

<sup>120</sup> *Qualitex*, 514 U.S. at 159.

objection to the use of color alone as a trademark.”<sup>121</sup> According to *Qualitex*, color alone is not necessarily functional;<sup>122</sup> there are not normatively objectionable reasons to exclude color alone as a trademark based on “shade confusion,”<sup>123</sup> and there are no reasons based on “color depletion” to absolutely exclude color alone as possible subject matter of trademarks.<sup>124</sup>

Therefore, according to *Qualitex*, color alone “sometimes” (presumably only when secondary meaning can be demonstrated) can act as a trademark.<sup>125</sup> Of course, this has led applicants to presume that color alone “always” acts to identify source and, based on the notion that this is reliant on the words “symbol or device” that appear in the Lanham Act, has led applicants to claim that this applies seamlessly to all nontraditional trademarks no matter where their imaginations might lead us.<sup>126</sup>

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<sup>121</sup> *Id.* at 163.

<sup>122</sup> While color often has functional aspects, it can also meet requirements of a trademark and act as a symbol to distinguish goods. See *Qualitex*, 514 U.S. at 165. *But see* *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29 (2001) (holding the exact opposite proposition that a functional mark never operates to identify source). Once again, the Supreme Court’s pronouncements on a basic trademark doctrine are not consistent.

<sup>123</sup> *Qualitex*, 514 U.S. at 167 (noting that courts frequently are charged with making decisions that are the rhetorical equivalent of “shade confusion” arguments and succeed in making fine distinctions nevertheless).

<sup>124</sup> *Id.* at 169 (An occasional problem should not lead to blanket prohibitions. “Moreover . . . the trademark doctrine of ‘functionality’ normally would seem available to prevent the anticompetitive consequences . . .”).

<sup>125</sup> *Id.* at 174.

<sup>126</sup> In fact, one applicant was lead to believe that even his own DNA sequence was the appropriate subject matter of trademarks. Frank Ogden, or Dr. Tomorrow, filed this trademark in 2004. His trademark application claimed its identification of goods as follows: “DNA GENE SEQUENCE TO PRODUCT [sic] FRANK OGDEN OR OTHER PROSPECTIVE HUMANS, CLONES, SURVIVAL MACHINES, OR FUTURISTIC ANIMALS THAT ARE USED TO CREATE IDEAS.” U.S. Patent Serial No. 76,016,924 (filed Apr. 3, 2000) (abandoned Jan. 21, 2002). Frank Ogden maintains a website at <http://www.dr tomorrow.com>. Mr. Ogden’s registered trademark for DR. TOMORROW was cancelled in 2004. See U.S. Patent Serial No. 74,274,318 (filed May 11, 1992) (cancelled June 12, 2004). When asked, Mr. Ogden responded that the reason he attempted to register his own DNA sequence was because “I THOUGHT THAT JUST THE LOOKING AT A PERSON AND BE WILLING TO PENETRATE THEIR DNA WOULD REMOVE A LOT OF CONTROL OVER ANY TAXPAYER. I WANTED TO GET THERE BEFORE SOME BUREAUCRAT GOT A BILL PASSED FOR THAT CONTROL.” E-mail from Frank Ogden to author (July 29, 2009) (on file with author) (capital letters from original).

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## B. Taco Cabana

In *Two Pesos, Inc. v. Taco Cabana, Inc.*, the Supreme Court continued to expand trademark rights.<sup>127</sup> *Taco Cabana* stands for the proposition that trade dress can be inherently distinctive and therefore, need not have secondary meaning.<sup>128</sup> As Justice Stevens summarized the issue before the Court in *Taco Cabana*: “[S]econdary meaning is not required to establish a trade dress violation under § 43(a) once inherent distinctiveness has been established.”<sup>129</sup>

The Court was so enamored with the trade dress at issue in *Taco Cabana* that it even upheld a specific jury finding that the mark lacked secondary meaning and that the trade dress was inherently distinctive and, *therefore*, a protectable trademark.<sup>130</sup>

The Court did so even though the trade dress at issue was not the subject of a trademark registration.<sup>131</sup> Therefore, the various statutory presumptions, like incontestability, would not apply to the *Taco Cabana* mark.<sup>132</sup>

The trade dress at issue in *Taco Cabana* is extremely challenging to define. The Court said that the mark consisted of the “overall business impression.”<sup>133</sup> In gratuitous language describing the mark, the Court adopted the lower court’s definition of the mark as follows:

[A] festive eating atmosphere having interior dining and patio areas decorated with artifacts, bright colors, paintings and murals. The patio includes interior and exterior areas with the interior patio capable of being sealed off from the outside patio by overhead garage doors. The stepped exterior of the building is a festive

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<sup>127</sup> *Taco Cabana*, 505 U.S. at 770 (noting that the inherently distinctive trade dress is protectable under the Lanham Act without evidence of secondary meaning.).

<sup>128</sup> *Id.* at 784.

<sup>129</sup> *Id.* at 775–76 (“[P]rotecting an inherently distinctive trade dress from its inception may be critical to new entrants to the market and that withholding protection until secondary meaning has been established would be contrary to . . . the Lanham Act. . . . We agree with the Court of Appeals that proof of secondary meaning is not required . . . where the trade dress at issue is inherently distinctive . . .”).

<sup>130</sup> *Id.* at 776 (despite being unregistered, *Taco Cabana* had an inherently distinctive trade dress).

<sup>131</sup> *Id.* at 768.

<sup>132</sup> 15 U.S.C. § 1065 (2012) (incontestability applies only to registered marks).

<sup>133</sup> *Taco Cabana*, 505 U.S. at 765 (agreeing with the District Court that “‘trade dress’ is the total image of the business.”).



and vivid color scheme using top border paint and neon stripes. Bright awnings and umbrellas continue the theme.<sup>134</sup>

Accepting the notion that a “festive eating atmosphere” can be an inherently distinctive trade dress threw the doors to trademark protection wide open.<sup>135</sup> If a “festive eating atmosphere” could be protected as one’s trade dress, it is difficult to comprehend what would fail the Court’s definition of a trade dress.

Justice Thomas went so far in his concurrence to claim that the Lanham Act itself was responsible for treating trade dress as a trademark and, therefore, all trademark doctrine should apply to trade dress questions seamlessly.<sup>136</sup> Justice Thomas said as follows in *Taco Cabana*:

A particular trade dress, then, is now considered as fully capable as a particular trademark of serving as a "representation or designation" of source under § 43(a). As a result, the first user of an arbitrary package, like the first user of an arbitrary word, should be entitled to the presumption that his package represents him without having to show that it does so in fact. This rule follows, in my view, from the language of § 43(a), and this rule applies under that section without regard to the rules that apply under the sections of the Lanham Act that deal with registration.<sup>137</sup>

Justice White’s majority opinion and both Justice Thomas’ and Justice Stevens’ concurrences support the simple fact that unregistered but inherently distinctive trade dress is protectable without secondary meaning the same as inherently distinctive trademarks.<sup>138</sup> This, again, acts to expand the notion of trademark protection. All three of these Justices recognized the fact that there was a “consensus” among the circuit courts to accept the trend that trademark law was expanding.<sup>139</sup>

Of course, this “consensus” sounds like an abdication. The Supreme Court is not bound by the circuit courts.<sup>140</sup> Justice Stevens’ concurrence

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<sup>134</sup> *Id.* (citing *Taco Cabana Int’l, Inc. v. Two Pesos, Inc.*, 932 F.2d 1113, 1117 (5th Cir. 1991)).

<sup>135</sup> *Id.*

<sup>136</sup> *Taco Cabana*, 505 U.S. at 787 (Thomas, J., concurring).

<sup>137</sup> *Id.*

<sup>138</sup> *Id.*

<sup>139</sup> *Id.* at 777–85 (Stevens, J., concurring).

<sup>140</sup> Justin Marceau, *Plurality Decisions: Upward-Flowing Precedent and Acoustic Separation*, 45 CONN. L. REV. 933, 964 (2013).

reads like he is a passive pawn in this endeavor and, if the lower courts wanted it, they should get it. If the Supreme Court found this expansion of trademark protection, treating trade dress as if it were a trademark, to be inappropriate, one would expect it to express its opinion, not operate as a passive entity dictated to by the circuit courts. Justice Stevens goes so far as to say that “*stare decisis* concerns persuade me to join the Court's conclusion . . . .”<sup>141</sup> To what Justice Stevens is referring boggles the imagination. The Supreme Court has never shied away from telling the circuit courts when the Court thought the circuit courts got it wrong.<sup>142</sup> Why, all of a sudden, is Justice Stevens worried about a notion of *stare decisis* which is irrelevant and inappropriate?

*Taco Cabana* and *Qualitex* compete with *Park 'N Fly* for the high point of broad trademark protection in the United States. The result of this (*Taco Cabana*, *Qualitex* and *Park 'N Fly*) was that trademark discourse was greatly expanded and invigorated.<sup>143</sup> At this point in the development of the Supreme Court's trademark jurisprudence, one could have enforceable trademark rights if an Examiner was asleep at the wheel and registered a descriptive mark and it became incontestable through a very simple form before the USPTO or one used the metaphorical equivalent of a “festive eating atmosphere” before anyone else did, even if they failed to register it or intentionally think of it as their trademark.<sup>144</sup>

### C. Traffix

*Traffix Devices, Inc. v. Mktg. Displays, Inc.* begins the restrictive period of trademark jurisprudence for the Court.<sup>145</sup> In *Traffix*, the Court found that an expired utility patent for the feature for which trade

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<sup>141</sup> *Taco Cabana*, 505 U.S. at 784.

<sup>142</sup> See, e.g., *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2017, 2115 (2013) (reversing Federal Circuit Court in part, isolated DNA is not patent eligible as it is a product of nature, and affirming in part, cDNA cannot be isolated in nature and is therefore patent eligible); *Mayo Collaboration Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293 (2012) (reversing Federal Circuit Court, math equations that express laws of nature are not themselves patent eligible as they effectively claim the underlying laws of nature); *Quanta Computer, Inc. v. LG Elecs., Inc.* 553 U.S. 617, 638 (2008) (reversing Federal Circuit Court, where the article has embodied the patent, patent exhaustion applies to method patents and prevents the patent holder from invoking patent law to control post-sale use of the article).

<sup>143</sup> *Taco Cabana*, 505 U.S. at 765 (trade dress can be inherently distinctive without any showing secondary meaning has been acquired).

<sup>144</sup> *Id.* (citing *Taco Cabana Int'l, Inc. v. Two Pesos, Inc.*, 932 F.2d 1113, 1117 (5th Cir. 1991)).

<sup>145</sup> *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001).

dress is claimed is “strong evidence” that the feature is functional.<sup>146</sup> The facts of *Traffix* are not difficult. Marketing Displays, Inc. (MDI) created a sign base for road side signs warning of various hazards.<sup>147</sup> These signs tend to tip over in the wind.<sup>148</sup> Some construction companies simply use an inverted “T” design for the legs of the sign and weigh them down with sand bags.<sup>149</sup> MDI’s (the Respondent before the Supreme Court but the Plaintiff below) genius was to put the legs of these signs on springs. When the wind blew, as it most certainly would, the sign would tilt and remain in place.<sup>150</sup>

Robert Sarkisian secured two utility patents for this dual spring sign base design—the ‘696 patent<sup>151</sup> and the ‘482 patent.<sup>152</sup> In the 1970’s MDI had engaged in a “long-running intellectual property battle” with Winn-Proof in which the court ultimately decided that Winn-Proof had infringed MDI’s patents under the doctrine of equivalents.<sup>153</sup> This litigation against Traffix followed after the patents expired and Traffix, a competitor of MDI, began selling sign stands with a “visible spring mechanism that looked like MDI’s.”<sup>154</sup>

Prior to *Traffix*, there had been a split in the circuit courts regarding

<sup>146</sup> *Id.* at 29 (previously held utility patent for dual-spring design is strong evidence that dual-spring features are functional, and precludes trademark protection for the same).

<sup>147</sup> *Id.* at 25.

<sup>148</sup> *Id.* at 31.

<sup>149</sup> *Id.* at 29 (“Trade dress protection must subsist with the recognition that in many instances there is no prohibition against copying goods and products.”).

<sup>150</sup> The dual-springs “are necessary to the operation of the device.” As documented in the patent specifications, the dual-spring design (as opposed to a single-spring) prevents the twisting and tipping of the sign and is an “important part of this combination.” *Id.* at 30–31.

<sup>151</sup> U.S. Patent No. 3,646,696. “Key aspects . . . as defined by its claims,” include: “Generally parallel ‘ground engaging members’ (to provide a stable base); Spaced apart coil springs (to prevent twisting of the sign frame); An upstanding frame-type sign structure (to hold large advertisements); and An initial compression between the coils of the springs (in order to prevent the sign from fluttering in light winds).”

Brief for Respondent, *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001) (No. 99-1571), 2000 WL 1521620, at \*2–3.

<sup>152</sup> U.S. Patent No. 3,662,482. “The ‘482 patent was a continuation-in-part of the ‘696 patent and had the following key features recited in the claims:

A geometric relationship—defined mathematically in the claims as  $Wf(Da-Db) < WbDb$ —between the center of gravity of the sign and the length of the legs which allowed the frame structure to bend over in high winds without the sign stand tipping over or sliding along the ground; and

‘Spring means’ connected at two spaced apart locations.”

*Id.* at \*3.

<sup>153</sup> *Traffix Devices, Inc.*, 532 U.S. at 30.

<sup>154</sup> *Id.* at 26.

the weight to give an expired patent in a subsequent trade dress claim. In *Sunbeam Products, Inc. v. West Bend Co.*, the court held that trade dress protection is not foreclosed even when it is the subject of a previous and expired utility patent.<sup>155</sup> On the other hand, *Vornado Air Circulation Systems, Inc. v. Duracraft Corp.*, concluded that “[w]here a product configuration is a significant inventive component of an invention covered by a utility patent . . . it cannot receive trade dress protection.”<sup>156</sup> The Supreme Court granted certiorari to resolve this conflict.<sup>157</sup>

However, the so-called split is more nuanced than Justice Kennedy realized. There is an important difference between something disclosed in a patent application and something claimed in a patent application.<sup>158</sup> Patent infringement is limited to those things expressly claimed in a patent application.<sup>159</sup> Disclosures or specifications are simply background matter that the Patent Examiner and the public needs to know to put the invention in context and make it make sense. The disclosure is an exchange for giving the patentee monopoly rights.<sup>160</sup> That is, the subject matter of an enforceable patent right extends exclusively to those things claimed in the application.<sup>161</sup>

One justification for not protecting trade dress that was subject to a previous patent is that this would allow the patentee/trade dress owners

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<sup>155</sup> *Sunbeam Prods., Inc. v. W. Bend Co.*, 123 F.3d 246, 256 (5th Cir. 1997); *see also* *Midwest Indus., Inc. v. Karavan Trailers, Inc.*, 175 F.3d 1356, 1363–64 (Fed. Cir. 1999) (portion of invention disclosed but not claimed in patent application is appropriate subject of trademark law); *Thomas & Betts Corp. v. Panduit Corp.*, 138 F.3d 277, 290–91 (7th Cir. 1998) (a disclosed feature of the claimed wire tie was part of the specification but not the claim and, as such, was not precluded from trade dress protection).

<sup>156</sup> *Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, 58 F.3d 1498, 1500 (10th Cir. 1995).

<sup>157</sup> *TraFFix Devices, Inc.*, 532 U.S. at 23.

<sup>158</sup> *See e.g.*, *PSC Computer Prods., Inc. v. Foxconn Int’l, Inc.*, 355 F.3d 1353, 1356 (Fed. Cir. 2004) (noting anything disclosed, but not claimed is donated to the public).

<sup>159</sup> *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 374 (1996) (“Victory in an infringement suit requires a finding that the patent claim covers the alleged infringer’s product or process, which in turn necessitates a determination of what the words in the claim mean.”) (internal quotations omitted).

<sup>160</sup> *See id.* at 373 (the patent system gives inventors “the right to exclude others from making, using, offering for sale, selling, or importing the patented invention, in exchange for full disclosure of an invention.”).

<sup>161</sup> *See e.g.*, *Playtex Prods., Inc. v. Procter & Gamble Co.*, 400 F.3d 901, 905–06 (Fed. Cir. 2005) (“A determination of patent infringement consists of two steps: (1) the court must first interpret the claim, and (2) it must then compare the properly construed claims to the allegedly infringing device. . . . To prove infringement, the patentee must show that the accused device meets each claim limitations, either literally or under the doctrine of equivalents.”).

to have two bites at the apple.<sup>162</sup> However, since the scope of the enforceable patent is limited to the express claims, the disclosures or specifications for that patent are not typically within the scope of any patent and, therefore, not enforceable.<sup>163</sup> As a trade dress, they become enforceable for the first time.<sup>164</sup>

That is, it does not make sense to exclude trade dress protection for any inventive step when that inventive step is not specifically claimed. The *Vornado* court got this right as follows: “Where a product configuration is a significant inventive component of an invention covered by a utility patent . . . it cannot receive trade dress protection.”<sup>165</sup>

By “inventive component,” the *Vornado* court was referring to items or features specifically claimed by the inventor.<sup>166</sup> This is a perfectly appropriate, although highly nuanced, way to give full faith and credit to patent law and policy and still allow an entity to use the policies behind trademark law to reduce transaction costs for consumers.<sup>167</sup> The *Vornado* court found the correct balance that Justice Kennedy could not quite name in *TrafFix*.

That is, there was, actually, no split in the circuits. The courts that allowed for trade dress protection to be considered regarding something that previously was the subject of patent protection allowed the trade dress claim to continue when it was disclosed or specified in the patent application, but not specifically claimed.<sup>168</sup> The courts that held trade dress protection was precluded were courts that faced a very different set of operative facts.<sup>169</sup> In those cases, the claimed trade dress was the subject of one or more specific claims in the patent.<sup>170</sup> As such, giving

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<sup>162</sup> The United States Constitution limits exclusive rights for a limited period of time. See U.S. CONST. art. I, § 8, cl. 8.

<sup>163</sup> *PSC Computer*, 355 F.3d at 1356.

<sup>164</sup> *Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, 58 F.3d 1498, 1500 (10th Cir. 1995).

<sup>165</sup> *Id.*

<sup>166</sup> *Id.*

<sup>167</sup> William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 268–71 (1987).

<sup>168</sup> *Sunbeam Prods., Inc. v. West Bend Co.*, 123 F.3d 246, 256–57 n. 20 (5th Cir. 1997) (“[A utility patent must be examined] in detail to determine whether the disclosed configuration is really primarily functional . . . .”) (citing J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:89 (4th ed. 1997)).

<sup>169</sup> *Vornado*, 58 F.3d at 1510 (“[A]fter the first patent issued and Vornado subsequently found evidence that other grill structures worked as well as or better than the spiral grill, Vornado did not repudiate or disclaim in any way the grill element of its patent. Instead, Vornado sought and received a reissue patent that expanded its claims with respect to the grill.”).

<sup>170</sup> See *id.* at 1500–02.

trade dress protection for something otherwise claimed in a patent would, for sure, be allowing the patentee to have two bites at the apple; however, allowing trade dress protection for mere specifications or disclosures would not.<sup>171</sup>

Although the Court could have apparently given some *stare decisis* weight to the counter authority as Justice Stevens demanded in *Taco Cabana*,<sup>172</sup> here, the Court summarily dismissed the rulings in *Sunbeam*, *Thomas & Betts*, and *Midwest Industries*, and sided with *Vornado*.<sup>173</sup> The Court's hesitancy to grant what would amount to a back door to a perpetual patent is understandable. If the Court recognized MDI's trade dress, others could construe it as a way to get perpetual protection for something once patented. This would, of course, violate the patent policy of granting an expansive monopoly to the patentee for twenty years in exchange for the patentee's disclosure of the invention.<sup>174</sup>

However, this is not what the Court did in *TrafFix*. Perhaps this was in the back of Justice Kennedy's mind when he penned the opinion, but he did not expressly say that he was worried about a potential overlap with patent policy should the trade dress survive scrutiny.<sup>175</sup> Telling is the fact that Justice Kennedy never even seriously inquired if MDI's trade dress had secondary meaning. To do that, he should have been looking for survey evidence or some other indication that consumers identified MDI's springs as indicating source rather than the product. In fact, the Court held that secondary meaning was irrelevant because they found the trade dress functional.<sup>176</sup>

This sets up an interesting logical problem. To show a mark is worthy of protection, a claimant has to show that the mark has secondary meaning;<sup>177</sup> however, the Court says we should not consider secondary meaning if the mark is functional.<sup>178</sup> However, the Court said that one way to show a mark is not functional is to show it has

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<sup>171</sup> *Id.*

<sup>172</sup> *Taco Cabana*, 505 U.S. at 784 (Stevens, J., concurring).

<sup>173</sup> *TrafFix Devices, Inc.*, 532 U.S. at 29–30.

<sup>174</sup> See *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996) (explaining that the patent system gives inventors “the right to exclude others from making, using, offering for sale, selling, or importing the patented invention, in exchange for full disclosure of an invention.”).

<sup>175</sup> See *TrafFix Devices, Inc.*, 532 U.S. at 35 (failing to address or express any concerns about situations in which the “trade dress becomes the practical equivalent of an expired utility patent.”).

<sup>176</sup> *TrafFix Devices, Inc.*, 532 U.S. at 33 (“Functionality having been established, whether MDI's dual spring design has acquired secondary meaning need not be considered.”).

<sup>177</sup> *Qualitex*, 514 U.S. at 171–72.

<sup>178</sup> *TrafFix Devices, Inc.*, 532 U.S. at 33.



secondary meaning, but, at the same time, precluded a claimant of a feared functional mark from showing the exact secondary meaning that would save it.<sup>179</sup>

This presumes that we can normatively know, and agree, on what is a functional mark. Of course, the problem here is that it is taken in conjunction with the fact that there was an expired utility patent for the very springs MDI was claiming.<sup>180</sup> This circular problem gets us back to where the Court started: Does the existence of a utility patent preclude subsequent claims that that design feature previously the subject of a patent now identifies source and, therefore, is operating as a trademark?

The Court said that the existence of such an expired patent is “strong evidence” that the mark is functional.<sup>181</sup> The Court, again, did not explain its reasoning, but, presumably, that is because a utility patent to be patentable at all must have “utility” or be functional.<sup>182</sup> However, the Court ignored the fact (and the reasoning used by the appellate courts that held differently) that this is a bald conclusion without support.<sup>183</sup>

Why should we presume that once a design feature is claimed to have utility under the patent act, it NEVER can act to identify source? One argument, stated above, is that this would interfere with the patent policy and give potential backdoors to permanent patents.<sup>184</sup> However, a trade dress is not a patent; the parameters of the right are extremely different from and much more narrow than a patent.<sup>185</sup> For example, to be actionable, the subsequent use of a same or similar trade dress must

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<sup>179</sup> *Id.*

<sup>180</sup> *Id.* at 29 (“A prior patent, we conclude, has vital significance in resolving the trade dress claim.”).

<sup>181</sup> *Id.*

<sup>182</sup> 35 U.S.C. § 101 (2012) (providing that patentable subject matter is limited to any “new and *useful* process, machine, manufacture, or composition of matter, or any new and *useful* improvement thereof . . .”) (emphasis added).

<sup>183</sup> *TrafFix Devices, Inc.*, 532 U.S. at 33, 35.

<sup>184</sup> Margreth Barrett, *Consolidating the Diffuse Paths to Trade Dress Functionality: Encountering TrafFix on the Way to Sears*, 61 WASH & LEE L. REV. 79, 146–47 (2004).

<sup>185</sup> See 35 U.S.C. § 271(a) (2012). Trade dress protection “secure[s] to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers,” by allowing the mark holder to bring an infringement action against the alleged infringer if the alleged infringing mark is likely to cause confusion among consumers as to whom the mark belongs. *Taco Cabana*, 505 U.S. at 774 (quoting *Park ‘N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 190 (1985)). Patent protection on the other hand is the right to exclude others from “mak[ing], us[ing], offer[ing] to sell, or sell[ing] any patented invention,” without permission. 35 U.S.C. § 271(a).

confuse consumers.<sup>186</sup> There is no confusion requirement in patent law.<sup>187</sup> The mere use (working) of the design feature would amount to an infringement even if it was accidental, unintended, and no one would be confused by the two uses.<sup>188</sup>

That is, patent policy and trade dress policy are already quite distinct entities. We need further justification than simply to say the design feature was subject to a utility patent and that alone is “strong evidence” that the trade dress is now (perhaps many years later) functional and, if it is functional, the claimant is precluded from showing that the trade dress has secondary meaning to defeat the precise functionality that is precluding recovery.

Most commentators have just accepted the rationale that trademark policy should not interfere with patent policy.<sup>189</sup> If the claimed trade dress is identifying source, there is no patent policy to interfere with except if the trade dress was subject to a prior utility patent.<sup>190</sup> If we allow a prior patentee to ever gain trade dress protection, it might not be the worst thing, as the Court implies.<sup>191</sup>

Of course, if we flesh out the Court’s opinion, we might think about a situation where trade dress was allotted protection even though it had been the subject of a prior utility patent. In those circumstances, one could see and maybe expect, that an intelligent user of such a patent would work during the term of the patent to create secondary meaning in the patented invention. Then, when the patent expired, the patentee could change their hat and say, “now I am claiming that the design feature identifies source and the functional aspect of that design feature has been exterminated.” During this lead-up time to secondary meaning, the patentee would be enjoying the broad patent monopoly and have an easier time creating exclusive use and therefore secondary meaning.

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<sup>186</sup> *Taco Cabana*, 505 U.S. at 769 (“It is of course, also undisputed that liability under § 43(a) requires proof of the likelihood of confusion.”).

<sup>187</sup> *See* 35 U.S.C. § 271 (2012).

<sup>188</sup> *See, e.g., Global Appliances, Inc. v. SEB S.A.*, 131 S.Ct. 2060, 2065 n. 2 (2011) (“Direct infringement has long been understood to require no more than the unauthorized use of a patent invention. Thus, a direct infringer’s knowledge or intent is irrelevant.”).

<sup>189</sup> *E.g., Lee B. Burgunder, Can the PTO Find Its Way with Jesus?*, 19 MARQ. INTELL. PROP. L. REV. 63, 88 (2015) (“The root of functionality is to ensure that trademarks do not interfere with patent policies by protecting unpatented product features that the patent laws should be free for all to use.”); Christopher R. Leslie, *Antitrust and Patent Law as Component Part of Innovation Policy*, 34 J. CORP. L. 1259, 1265 (2009) (explaining that antitrust enforcement need not interfere with patent policy).

<sup>190</sup> *TraFFix Devices, Inc.*, 532 U.S. at 29, 32.

<sup>191</sup> *See id.* at 34–35.

One can easily see how that situation would be possible. But, would it be so likely that we should preclude (giving nomenclatures like “strong evidence”) a trade dress claimant who had an expired utility patent for the same design feature from recovery?

This is all to state one simple fact: With *TrafFix*, the Supreme Court made the concept of a trademark narrower than it had been.<sup>192</sup> If the Court is afraid of broad trademark rights, it begs the question of why? What is there about broad trademark rights the Court knows that is anti-competitive or monopolistic or something that encourages the Court to restrain them? Also, if broad trademark rights are so dangerous, why doesn’t the Court tell us what those dangers are?

I am not advocating for broad trademark rights. I think the institution of broad trademark rights in the form of *Park ‘N Fly*, *Qualitex*, and the like has encouraged trademark owners to engage in speculative conduct. This speculative conduct could be why trademark bullying found its footing.<sup>193</sup> If an otherwise descriptive and worthless trademark (like “PARK ‘N FLY”) or the silly design of an obvious Mexican restaurant is appropriate trademark subject matter, it seems that all limitations to trademark protection have ended. That is, if the Supreme Court of the United States accepts as trade dress a “festive eating atmosphere,”<sup>194</sup> why would others not claim anything they can think of?

*TrafFix* acts as an initial break to this trend. The Court is recognizing the challenges that its expansive rulings in trademark law have created and has, with *TrafFix*, started to rein trademark law back in.<sup>195</sup> After all, in *TrafFix*, Justice Kennedy could easily have stated a bright line distinction. If one’s trade dress was ever subject to a specific claim in a patent application, it would be barred from trademark protection; if one’s trade dress was merely part of the specification or disclosure in a patent application, it would be free to claim it as their trade dress, subject, of course, to proving a likelihood of confusion. He did not take the bright line.<sup>196</sup> Instead, Justice Kennedy, in fact, takes the opposite tract:

In a case where a manufacturer seeks to protect

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<sup>192</sup> *Id.* at 29–30.

<sup>193</sup> “Trademark bullying” is variously defined, but the best definition is that it occurs when a holder of a non-famous trademark attempts to assert the mark against non-competitors. Kenneth L. Port, *Trademark Extortion Revisited: A Response to Vogel and Schachter*, 14 CHI.-KENT J. INTELL. PROP. 1, 217 (2014) (demonstrating that trademark bullying is present in 5.5% of the reported cases).

<sup>194</sup> *Taco Cabana, Inc.*, 505 U.S. at 765.

<sup>195</sup> *See TrafFix Devices, Inc.*, 532 U.S. at 29–30.

<sup>196</sup> *Id.* at 34.

arbitrary, incidental, or ornamental aspects of features of a product found in the patent claims, such as arbitrary curves in the legs or an ornamental pattern painted on the springs, a different result might obtain. There, the manufacturer could perhaps prove that those aspects do not serve a purpose within the terms of the utility patent.<sup>197</sup>

That is, Justice Kennedy provides the opportunity to claim trade dress protection even when the trade dress is specifically named in a utility patent's claims. This provides almost no direction to would-be claimants of trade dress protection. As the principle case on trade dress protection does not use easy bright line distinctions that it could have, Justice Kennedy seems to be both encouraging and discouraging trade dress claims at the same time.

Therefore, *TrafFix* does not act as complete brake to the expansion of trademark law, but rather, an easing of the brake. In 2001, the Court recognized with *TrafFix* that expansive trademark rights may not be the best thing, yet left open the possibility of using a claim in an expired utility patent as possible appropriate subject matter for trademark protection.<sup>198</sup>

#### D. Wal-Mart v. Samara

In *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, the Court thoroughly applied the brakes to trademark expansion.<sup>199</sup> That is, after the decision in *Taco Cabana* in 1992, pressure was growing on the Court to explain what inherently distinctive trade dress was and how it could be defined, registered and litigated.<sup>200</sup> In *Wal-Mart*, the Court determined that no matter how hard an alleged infringer tried to copy the plaintiff's unregistered trade dress, if that plaintiff's trade dress lacked secondary meaning, trademark protection would not survive and otherwise infringing entities could slavishly copy the product.<sup>201</sup>

Wal-Mart tried and succeeded in copying Samara's children's

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<sup>197</sup> *Id.*

<sup>198</sup> *Id.* at 35.

<sup>199</sup> *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205 (2000).

<sup>200</sup> See Karina K. Terakura, Comment, *Insufficiency of Trade Dress Protection: Lack of Guidance for Trade Dress Infringement Litigation in the Fashion Design Industry*, 22 HAW. L. REV. 569, 592–93 (2000).

<sup>201</sup> *Wal-Mart*, 529 U.S. at 216 (“We hold that in an action for infringement of unregistered trade dress under § 43(a) of the Lanham Act, a product’s design is distinctive, and therefore protectable, only upon a showing of secondary meaning.”). *Wal-Mart* actually came before *TrafFix* in time but they are so close to each other it is not relevant.

pajamas.<sup>202</sup> Wal-Mart sent pictures of the pajamas to designers in the Philippines and asked them to design pajamas that looked just like Samara's goods.<sup>203</sup> In some photos, Samara's label bearing its trademark was even visible.<sup>204</sup> The final product looked just like Samara's goods.<sup>205</sup> Wal-Mart succeeded in producing a close replica of Samara's goods and sold them for far less than Samara was selling them.<sup>206</sup>

Never mind how bad Wal-Mart acted, the Court held.<sup>207</sup> They did not hold and did not cite *International News Service v. Associated Press*,<sup>208</sup> but this is clearly not like a "hot news" exception where the alleged infringer's conduct was so bad that, as a matter of natural rights, infringement would be found. Rather, the Court held that even slavish copying as here is not only permitted but encouraged in our American society if the claimant of trademark rights cannot show that the object of protection possessed secondary meaning.<sup>209</sup>

That is, "any" does not mean "any" anymore. The first restriction was that a trade dress may not be functional and be worthy of trademark protection. The second restriction was that all trade dress must possess secondary meaning.

Most troubling in the *Wal-Mart* case was that the Supreme Court certified as the question presented to the Court a simple clarification of, in light of *Taco Cabana*, when trade dress was inherently distinctive.<sup>210</sup> In Justice Scalia's remarkably short opinion of a mere fourteen pages, he completely changed the law as we knew it of when trade dress was protectable at all.<sup>211</sup> In *Taco Cabana*, Justice Thomas' concurrence claimed that trade dress was trademark and the two should not be doctrinally distinguished.<sup>212</sup> In *Wal-Mart*, Justice Scalia presented a much different view. Trade dress, he determined, can be separated into three types.<sup>213</sup>

The first type is product packaging that can be inherently distinctive.<sup>214</sup> When and what evidence would be used to establish that is not clear from the opinion. Second, product design or product

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<sup>202</sup> *Id.* at 207–08.

<sup>203</sup> *Id.*

<sup>204</sup> See Brief for Respondent, *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000) (No. 99-150), 1999 WL 1249422, at \*5.

<sup>205</sup> *Wal-Mart*, 529 U.S. at 208.

<sup>206</sup> *Id.* at 207–08.

<sup>207</sup> See *id.* at 216.

<sup>208</sup> *Int'l News Serv. v. Assoc. Press*, 248 U.S. 215 (1918).

<sup>209</sup> *Wal-Mart*, 529 U.S. at 214.

<sup>210</sup> See *id.* at 207.

<sup>211</sup> *Id.* at 211.

<sup>212</sup> *Taco Cabana*, 505 U.S. at 787 (Thomas, J., concurring).

<sup>213</sup> *Wal-Mart*, 529 U.S. at 212.

<sup>214</sup> *Id.* at 210.

configuration, like in *Wal-Mart*, may never be inherently distinctive and must always possess secondary meaning to be protectable.<sup>215</sup> What are we to make of *Taco Cabana* in these circumstances? Rather than answer the question presented, Justice Scalia dismissed *Taco Cabana* as a “*tertium quid*,” some third thing with which he will not be bothered.<sup>216</sup>

Not only did Justice Scalia abdicate his responsibility to answer the question presented, he specifically engaged in judicial activism to restrain the growth of trademark law.<sup>217</sup> So important was this effort, he apparently believed, that he should go against his well-stated principles of what the Court’s job was and how inappropriate judicial activism was for our American society.<sup>218</sup> Rather, Justice Scalia threw all that to the wind and set out on his own to reshape the landscape of trade dress protection and invent these three types of trade dress.<sup>219</sup>

In fact, Justice Scalia expressly disagreed with his conservative brother, Justice Thomas, from his concurrence in *Taco Cabana*.<sup>220</sup> There, Justice Thomas said that the text of Section 43(a) allowed for the protection of the “festive eating atmosphere.”<sup>221</sup> Justice Thomas concluded that trade dress protection, through Section 43(a), should be protected as a trademark with no conceptual problems.<sup>222</sup>

Justice Scalia disagreed: “The text of § 43(a) provides little guidance as to the circumstances under which unregistered trade dress may be protected.”<sup>223</sup>

After *Wal-Mart*, *Taco Cabana*, *Qualitex*, and *TrafFix*, one is left wondering where the actual parameters are for trademark/trade dress protection. After all, Justice Scalia could have, but did not, overrule *Taco Cabana*. As such, *Taco Cabana* is good law, even if it is a

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<sup>215</sup> *Id.* at 215.

<sup>216</sup> *Id.*

<sup>217</sup> See generally *Wal-Mart*, 529 U.S. 205.

<sup>218</sup> See Bob Ward, *In Snowmass, Justice Antonin Scalia Says Judges Should Not Be Policymakers*, THE ASPEN TIMES, <http://www.aspentimes.com/news/7382102-113/scalia-judges-society-court> (last visited Aug. 14, 2015).

<sup>219</sup> For this proposition, Justice Scalia states as follows: “Competition is deterred, however, not merely by successful suit but by the plausible threat of successful suit, and given the unlikelihood of inherently source-identifying design, the game of allowing suit based upon alleged inherent distinctiveness seems to us not worth the candle.” *Wal-Mart*, 529 U.S. at 214.

<sup>220</sup> Compare *id.* at 210 (reasoning that the statutory text does not offer guidance as to when unregistered trade dress may be protected), with *Taco Cabana*, 505 U.S. at 786–87 (Thomas, J., concurring), *reh’g denied*, 505 U.S. 1244 (1992) (concluding statutory text allows for trade dress protection through use of a trademark).

<sup>221</sup> *Taco Cabana*, 505 U.S. at 786–87.

<sup>222</sup> *Id.* at 787.

<sup>223</sup> *Wal-Mart*, 529 U.S. at 210.



“*tertium quid.*”<sup>224</sup> It most certainly is inconsistent with *Wal-Mart* in spirit, if not in doctrine. In *Taco Cabana*, the Court was expanding trademark rights; in *Wal-Mart*, the Court clearly restrained trademark rights.<sup>225</sup> That, of course, begs the question of what did they become afraid of?

The Court clearly became afraid of mixing and matching one’s intellectual property claims to suit the individual plaintiff’s needs and fancy. That is, something for which a design patent should have been obtained but was not, should not be saved by trade dress protection, which would, in essence, give the claimant a perpetual patent in the design. If the object of protection had secondary meaning, the claimed appellation would be outside of the realm of patent protection,<sup>226</sup> and in the world of trademark protection, therefore protectable. If it did not have secondary meaning, and was not the subject of a design patent, the claimant was out of luck.<sup>227</sup>

Product packaging does not have the same capacity to interfere with the policy behind patent protection, Justice Scalia would have us believe, therefore, it does not raise the same concerns.

## E. Dastar

The final nail in the coffin, or, keeping with the lame analogy from above, the application of the emergency brake to the expansion of trademark law, came in the form of *Dastar Corp. v. Twentieth Century Fox Film Corp.*<sup>228</sup> In *Dastar*, the claimant, Fox, tried to assert trademark protection to protect the material in a documentary that might have been protected using copyright law, but the copyright to that material had expired and was not renewed.<sup>229</sup> Fox argued that the footage identified it as the source or origin of the movie and therefore, if “any” meant “any,” it had trademark-like rights in the material for which copyright protection had expired.<sup>230</sup>

Although this seems like a logical argument given the expanding notion of trademark law in *Park ‘N Fly*, *Taco Cabana*, and *Qualitex* by this time, post-*Wal-Mart*, this argument was dead on arrival. As the

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<sup>224</sup> *Id.* at 215.

<sup>225</sup> *See Taco Cabana*, 505 U.S. at 767; *Wal-Mart*, 529 U.S. at 216.

<sup>226</sup> *See generally* *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989).

<sup>227</sup> *Wal-Mart*, 529 U.S. at 216.

<sup>228</sup> *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003).

<sup>229</sup> *Id.* at 25–28.

<sup>230</sup> *Id.* at 27 (alleging that *Dastar*’s sale of the documentary “without proper credit” to the *Crusade* television series constitutes “reverse passing off” in violation of § 43(a) of the Lanham Act).

Supreme Court has gone into a mode of curtailing trademark rights rather than expanding them, the creative use of trademark law in *Dastar* would not be allowed.<sup>231</sup>

#### F. *Moseley v. V Secret Catalogue, Inc.*

The *Moseley v. V Secret Catalogue, Inc.* case attracted wide attention because of its extremely entertaining facts. Substantively, it has been said that it “may be the most significant new millennium trademark case.”<sup>232</sup> The facts, entertaining as they are, can be briefly stated. Victor and Cathy Moseley opened an adult novelty store titled “Victor’s Secret” and later “Victor’s Little Secret.”<sup>233</sup> It was opened near an Army base near Elizabethtown, Kentucky.<sup>234</sup> The Moseleys advertised and sold such interesting items as lingerie and “Adult Novelties/Gifts.”<sup>235</sup> The Moseley’s trademark appeared as follows:



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Almost as entertaining as the basic facts of the case, an Army colonel, offended by the roadside attraction, saw this store advertising its wares in a newspaper and subsequently informed Victoria’s

<sup>231</sup> *Id.* at 38 (“For merely saying it is the producer of the video, however, no Lanham Act liability attaches to *Dastar*.”).

<sup>232</sup> Welkowitz, *supra* note 92, at 1681 (2004).

<sup>233</sup> *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 423 (2003).

<sup>234</sup> *Id.*

<sup>235</sup> *Id.*

<sup>236</sup> Brian Wassom, *Rule 34 and Trademark Dilution*, WASSOM.COM (Sept. 19, 2014), <http://www.wassom.com/rule-34-trademark-dilution.html>.

Secret.<sup>237</sup> After all, we could never imagine an Army colonel to debase himself in order to frequent such an establishment.

Victoria's Secret soon filed suit; however, its trademark infringement claim was dismissed and they did not appeal that claim.<sup>238</sup> Victoria's Secret did, however, prevail on its trademark dilution claim, which had also been dismissed at trial.<sup>239</sup> Trademark dilution is a cause of action that holders of famous marks can bring against any use, competitive or not, of their famous and distinctive trademarks.<sup>240</sup>

Although the facts are entertaining and the manner that Victoria's Secret learned of the alleged infringing or dilutive conduct is comical, *Moseley* was litigated and adjudicated consistently with trademark doctrine.

Victoria's Secret did not prevail on its claim of infringement in district court, and it did not appeal that verdict.<sup>241</sup> In a world where trademark litigants sometimes ignore or minimize trademark doctrine in order to prevail in a certain case, it is remarkable that Victoria's Secret followed trademark doctrine in such a close manner. That is, trademark infringement, as stated above, is a cause of action that is to be brought by an entity against a competitor. Traditionally, if there is no competition between the parties, there, by definition, can be no infringement.

That is, Victoria's Secret apparently knew that, in order to prevail on appeal on the trademark infringement claim, they would have to emphasize the competition between Victoria's Secret (a high-end and self-determined classy lingerie empire) and Victor's Little Secret (a low-end, roadside attraction selling sex toys and the like). Said in very crude terms, the soft-porn manufacturer would have to admit to be in competition with the hard-porn manufacturer. Victoria's Secret did the very wise thing and did not enter this debate by not appealing the finding that there was no trademark infringement.

Victoria's Secret did appeal the dilution verdict against it.<sup>242</sup> This

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<sup>237</sup> *Moseley*, 537 U.S. at 423.

<sup>238</sup> *V Secret Catalogue Inc. v. Moseley*, No. 3:98CV-395-S, 2000 WL 370525, at \*4 (W.D. Ky. Feb. 9, 2000).

<sup>239</sup> *Id.* at \*6, *aff'd*, 259 F.3d 464, 477 (6th Cir. 2001) (upholding grant of summary judgment for plaintiffs).

<sup>240</sup> *Moseley*, 537 U.S. at 420–21 (“In 1995 Congress amended § 43 of the Trademark Act of 1946, 15 U.S.C. § 1125, to provide a remedy for the ‘dilution of famous marks.’ 109 Stat. 985-86. That amendment, known as the Federal Trademark Dilution Act (FTDA), describes the factors that determine whether a mark is ‘distinctive and famous,’ and defines the term ‘dilution’ as ‘the lessening of the capacity of a famous mark to identify and distinguish goods or services.’”).

<sup>241</sup> *V Secret Catalogue*, 2000 WL 370525, at \*4.

<sup>242</sup> *V Secret Catalogue*, 259 F.3d at 477.

appeal and the Supreme Court's holding on dilution in this case fits perfectly with the thesis of this piece that the Supreme Court has, as of late, been engaged in restricting the trademark right after decades of expanding it. It "contains many echoes of *Wal-Mart* and *TrafFix*"<sup>243</sup> as the Supreme Court constricts the trademark right.

In *Moseley*, the Supreme Court looked at two inconsistent phrases in the dilution provisions of the Lanham Act and elected to take the more restrictive course.<sup>244</sup> Specifically before the court was the question of whether the correct test for dilution was that the plaintiff had to show a "likelihood of dilution" (which mirrors the trademark infringement test of "likelihood of confusion") or if the correct test was something different and required an actual showing of dilution.<sup>245</sup>

More specifically, the Lanham Act defines dilution as "the lessening of the capacity of a famous mark to identify and distinguish goods and services."<sup>246</sup> However, in another place, the Lanham Act states that relief is authorized if a junior mark "causes dilution of the distinctive quality of the [senior] mark."<sup>247</sup>

That is, is the right test a "likelihood," as Section 1127 seems to provide by using words "lessening of the capacity" or is actual dilution required because Section 1125(c)(1) references "causes" dilution?<sup>248</sup> It is easy to see the significance of the difference. If a mere likelihood is required, it would be much easier for plaintiffs to make out a case of dilution; if actual dilution is required, this has the potential of completely extinguishing the cause of action. A likelihood of confusion can be shown using surveys and other enumerated factors to say if it is more likely than not that a consumer is to be confused as to the source of a good or service (trademark infringement).<sup>249</sup> The evidence needed for a showing of actual dilution is onerous.<sup>250</sup> It is impossible to collect evidence that establishes, in any specific case, that a defendant's conduct causes the trademark at issue to lessen the capacity to distinguish itself.<sup>251</sup>

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<sup>243</sup> Welkowitz, *supra* note 92, at 1682–83.

<sup>244</sup> *Id.* at 1683–85.

<sup>245</sup> *Moseley*, 537 U.S. at 423–24.

<sup>246</sup> *Id.* at 423 (citing 15 U.S.C. § 1127 (2000)).

<sup>247</sup> *Id.* at 432.

<sup>248</sup> *Id.* at 420, 432. *See also* 15 U.S.C. § 1125(c)(1) (2012); 15 U.S.C. § 1127 (2012).

<sup>249</sup> *See generally Moseley*, 537 U.S. at 435 (describing the types of evidence that can show a likelihood of confusion).

<sup>250</sup> *See generally id.* (explaining that it is difficult to establish actual dilution because of the expense and unreliable nature of consumer data).

<sup>251</sup> *See generally id.* (recognizing that despite consumer surveys and circumstantial evidence, actual dilution is a difficult burden to carry in trademark disputes).

The Supreme Court took the position that actual dilution was needed to establish trademark dilution and, thereby, nearly extinguished the cause of action.<sup>252</sup> By 2005, there was only one case in all of America where trademark dilution was the focus of the case and that plaintiff lost in making a dilution claim.<sup>253</sup> *Moseley* had the effect of nearly extinguishing the dilution cause of action.

Some have claimed that “*Moseley* is not an example of judicial craftsmanship.”<sup>254</sup> However, to me, it is a masterful attempt to rein in a trademark doctrine that had been giving courts<sup>255</sup> and commentators<sup>256</sup> significant consternation ever since its enactment in

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<sup>252</sup> *Id.* at 432. By 2004, just one year after the final Supreme Court judgment, there was only one reported pure dilution case in all of America: *DeGidio v. West Group Corp.*, 355 F.3d 506 (6th Cir. 2004). For an empirical explication of the demise of the dilution doctrine, see *The Mitchell Study on Trademark Litigation*, WILLIAM MITCHELL COLL. OF LAW, <http://web.wmitchell.edu/intellectual-property/the-mitchell-study-on-trademark-litigation/> (last visited Oct. 14, 2015).

<sup>253</sup> *Bell v. Starbucks U.S. Brands Corp.*, 389 F.Supp.2d 766, 780 (S.D. Tex. 2005). See *Trademark Litigation Search Results*, MITCHELL INTELLECTUAL PROP. INST., <http://app.wmitchell.edu/Trademark/Home/TrdResults?Term=&ddlYear=All+Years&ddlCourt=All+Courts&ddl> (last visited Oct. 12, 2015) (searchable database of all reported trademark cases from July 5, 1947, the effectiveness date of the Lanham Act through and including 2011).

<sup>254</sup> Welkowitz, *supra* note 92, at 1682.

<sup>255</sup> Although prior to the federal enactment of a dilution statute, this judicial consternation is, perhaps, nowhere more clearer than in *Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1031–32 (2d Cir. 1989) (showing that in order to avoid applying the New York State dilution statute, the court claimed that Lexis and Lexus are not similar).

<sup>256</sup> Robert N. Klieger, *Trademark Dilution: The Whittling Away of the Rational Basis for Trademark Protection*, 58 U. PITT. L. REV. 789, 795 (1997) (warning that dilution protections “pose an anticompetitive threat to market efficiency and consumer welfare”); Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1713 (1999) (arguing for judicial vigilance in protecting trademark theory); Kenneth L. Port, *The “Unnatural” Expansion of Trademark Rights: Is a Federal Dilution Statute Necessary?*, 18 SETON HALL LEGIS. J. 433, 434–35 (1994) (arguing against the, at that time, proposed federal dilution act); Simone A. Rose, *Will Atlas Shrug? Dilution Protection for “Famous” Trademarks: Anti-Competitive “Monopoly” or Earned “Property” Right?*, 47 FLA. L. REV. 653, 740 (1995) (stating that “Atlas will no longer shrug, but welcome the addition of these earned property rights”); David S. Welkowitz, *Reexamining Trademark Dilution*, 44 VAND. L. REV. 531, 533 (1991) (contending that state d that state antidilution statutes provide overly broad trademark protection); Lori Krafte-Jacobs, Comment, *Judicial Interpretation of the Federal Trademark Dilution Act of 1995*, 66 U. CIN. L. REV. 659, 696 (1998). That comment concludes that:

One of the primary motivations for enactment of a federal dilution law was to provide a single, nationwide solution to the problems of patchwork protection against the gradual erosion of a mark's distinctiveness. Because dilution is difficult to pin down and impossible to measure, the FTDA necessarily suffers from some vagueness.

1996.<sup>257</sup> If viewed from a broad perspective, *Moseley* stands for the proposition that trademark dilution cause of action needs some clear parameters.<sup>258</sup> If something called “dilution” actually is possible and actually does happen in the marketplace, the Supreme Court’s view is that it should be demonstrated.<sup>259</sup> There should be no presumption of dilution that a “likelihood” standard would allow.<sup>260</sup> If a mark is diluted, the Supreme Court is saying, then prove it.<sup>261</sup>

In other words, this may be the most careful act of restraining the trademark right that we have considered in this article. Although Congress disagreed and revised the Lanham Act to make the test for trademark dilution a “likelihood of dilution,”<sup>262</sup> the Supreme Court’s view on the topic is clear. In keeping with *TrafFix* and *Wal-Mart*, the trademark right ought to be a more limited right.<sup>263</sup>

Perhaps in part because Congress overruled the Supreme Court in *Moseley*, the stage was set for a broad pronouncement that would limit the trademark right even if there were apparently disagreeable statutory references or even a prior Supreme Court case that the Court no longer entirely endorsed.

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This in turn makes a uniform, nationwide solution unlikely, at least until a significant FTDA case reaches the Supreme Court.

William Marroletti, Note, *Dilution, Confusion, or Delusion? The Need For a Clear International Standard to Determine Trademark Dilution*, 25 BROOK. J. INT’L L. 659, 692 (1999). That note posits that:

Dilution protection is a largely unnecessary and costly safeguard that can undermine the objectives of trademark law by producing anti-competitive results. A likelihood of dilution determination is conceptually difficult to apply and as a result courts rely on it unnecessarily. In addition, the injury is speculative and difficult to measure.

<sup>257</sup> Federal Trademark Dilution Act of 1995, H.R. 1295, 104th Cong. (1996).

<sup>258</sup> Welkowitz, *supra* note 92, at 1684.

<sup>259</sup> See Kenneth L. Port, *The Unnatural Expansion of Trademark Rights: Is a Federal Dilution Statute Necessary?*, 18 SETON HALL LEGIS. J. 433, 447–48 (1994).

<sup>260</sup> *Moseley*, 537 U.S. at 433.

<sup>261</sup> *Id.* at 434.

<sup>262</sup> Trademark Dilution Revision Act of 2006, 15 U.S.C. § 1125(c) (2006).

<sup>263</sup> *TrafFix Devices, Inc.*, 532 U.S. at 29.



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**V. OVERRULING BY IMPLICATION: KP PERMANENT MAKE-UP**

The final (for the time being) word from the Supreme Court on the scope of trademark protection is the, essentially, unanimous<sup>264</sup> opinion of *KP Permanent Make-Up*.<sup>265</sup> In *KP Permanent Make-Up*, it is appropriate to see a Court that was clearly worried about the expansion of trademark rights and was laboring to restrict them.<sup>266</sup> As such, in *KP Permanent Make-Up*, the Court held that a descriptive mark used descriptively would constitute trademark fair use and therefore not an infringement.<sup>267</sup> Although this case is couched in the terms of whether or not a plaintiff has the burden of proof of showing confusion even in the light of fair use,<sup>268</sup> the result is a complete curtailing of the *Park 'N Fly* doctrine.

In *Park 'N Fly*, the Court held that a descriptive mark could be an enforceable mark if it was incontestable.<sup>269</sup> In *KP Permanent Make-Up*, the Court held that even in light of the fact that KP Permanent Make-Up's mark was incontestable, the fact that it was descriptive gave competitors a right to use it.<sup>270</sup> These two statements should be seen as inconsistent because they are.

In *Taco Cabana*, Justice Stevens concurred and claimed that lower court precedent bound him to the broad interpretation of trademark

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<sup>264</sup> *KP Permanent Make-Up*, 543 U.S. at 113 (heading) (“Souter, J., delivered the opinion of the Court, in which Rehnquist, C.J., and Stevens, O’Connor, Kennedy, Thomas, and Ginsburg, JJ., joined, in which Scalia, J., joined as to all but footnotes 4 and 5, and in which Breyer, J., joined as to all but footnote 6.”).

<sup>265</sup> *Id.* Of course, *B&B Hardware Inc. v. Hargis Industries Inc.*, 135 S. Ct. 1293 (2015) might be seen as expanding the reach of the TTAB but, as it is not an opinion regarding substantive trademark law, it is excluded from this analysis.

<sup>266</sup> See generally Michael J. Gerhardt, *The Role of Precedent in Constitutional Decisionmaking and Theory*, 60 GEO. WASH. L. REV. 68 (1991).

<sup>267</sup> *KP Permanent Make-Up*, 543 U.S. at 124.

<sup>268</sup> *Id.* (concluding that “in sum, a plaintiff claiming infringement of an incontestable mark must show likelihood of consumer confusion as part of the prima facie case, while the defendant has no independent burden to negate the likelihood of any confusion in raising the affirmative defense that a term is use descriptively, not as a mark, fairly, and in good faith.”).

<sup>269</sup> *Park 'N Fly*, 469 U.S. at 205 (concluding “that the holder of a registered mark may rely on incontestability to enjoin infringement and that such an action may not be defended on the grounds that the mark is merely descriptive.”).

<sup>270</sup> *KP Permanent Make-Up*, 543 U.S. at 122 (stating that “the common law’s tolerance of a certain degree of confusion on the part of consumers followed from the very fact that in cases like this one an originally descriptive term was selected to be used as a mark, not to mention the undesirability of allowing anyone to obtain a complete monopoly on use of a descriptive term simply by grabbing it first. The Lanham Act adopts a similar leniency . . .”).

rights in that case.<sup>271</sup> In *KP Permanent Make-Up*, the Court ignored existing Supreme Court precedent in the form of *Park 'N Fly* and eviscerated the incontestability doctrine.<sup>272</sup> If the Court allowed for the expansive reading in *Park 'N Fly*, one wonders why it does not allow the same expansive reading in *KP Permanent Make-Up*. If the Court is concerned with the expansion of trademark rights, it should do the intellectually honest thing and overrule *Park 'N Fly*. With *KP Permanent Make-Up*, the Court has rendered *Park 'N Fly* useless. Every alleged infringer of a descriptive but incontestable mark should simply now argue that the mark is descriptive and that the defendant is using the mark descriptively. That is, the *Park 'N Fly* doctrine gave holders of descriptive trademark rights the ability to enforce them; the *KP Permanent Make-Up* case took that right away.

Not only does *KP Permanent Make-Up* render *Park 'N Fly* useless, it guts the value of the incontestability doctrine. As I have argued elsewhere,<sup>273</sup> incontestability is a troubling concept in our common law system, but it is the law that we have relied upon for nearly seventy years.<sup>274</sup> To eviscerate incontestability with the *KP Permanent Make-Up* decision is a clear form of judicial activism that this conservative Supreme Court pretends to abhor.<sup>275</sup>

Of what is the conservative Supreme Court afraid? Conservatives believe that property rights are absolute.<sup>276</sup> It seems that this basic principle would teach away from extending “fair use.”

## VI. SECTION 33(B)(4)

The apparent first time in reported judicial history where Section 33(b)(4) was specifically labeled as a “fair use” defense occurred in 1981.<sup>277</sup> This language appears to be derived from the language in

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<sup>271</sup> *Taco Cabana*, 505 U.S. at 785 (Thomas, J., concurring) (citing to Stevens’ concurrence).

<sup>272</sup> See *KP Permanent Make-Up*, 543 U.S. at 122.

<sup>273</sup> See generally Port, *supra* note 5.

<sup>274</sup> *Id.*

<sup>275</sup> THOMAS M. KECK, *THE MOST ACTIVIST SUPREME COURT IN HISTORY: THE ROAD TO MODERN JUDICIAL CONSERVATISM I* (2004).

<sup>276</sup> Robert G. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86 B.U. L. REV. 547, 565–68 & n.99 (2006) (“The typical argument was purely circular: It reasoned that deception was conclusively presumed because a trademark was an absolute property right and therefore supported liability without proof of deception.”).

<sup>277</sup> *In re Schmid Labs. v. Youngs Drug Prods. Corp.*, 482 F. Supp. 14, 20–21 (D.N.J. 1979). Numerous times, the Court has described something akin to our current day understanding of “fair use” but they did not use that term to describe it. See, e.g., *Del. & Hudson Canal Co. v. Clark*, 80 U.S. 311, 324 (1871).

Section 33(b)(4) that states that otherwise infringing ought to be forgiven if it is "used fairly and in good faith only to describe to users the goods . . . of [a] party."<sup>278</sup> The copyright statute uses the same "fair use" language to describe a right that is significantly disparate from the trademark fair use.<sup>279</sup>

The copyright fair use defense is an affirmative defense that is only reached after the plaintiff shows, or the defendant concedes, that illicit copying happened in any given case.<sup>280</sup> That is, it is only referenced after liability is established and forgives that otherwise infringing conduct.<sup>281</sup> In trademark law, the so-called fair use defense is an absolute defense that prevents the court from considering whether the plaintiff's mark and the defendant's mark are confusingly similar.<sup>282</sup> That is, trademark fair use is referenced before liability is established. In trademark law, if fair use is found, the case is terminated and no showing of infringement is made.<sup>283</sup> This is the holding in the *KP Permanent Make-Up* case.<sup>284</sup>

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<sup>278</sup> Lanham Act § 33(b), 15 U.S.C. § 1115(b)(4) (2015).

<sup>279</sup> *Compare* 17 U.S.C. § 107 (2012), with 15 U.S.C. § 1115(b)(4) (2012) ("That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, . . . of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party . . .").

<sup>280</sup> *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 590 (1994); 4 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 10:9 (2015) ("[F]air use is an affirmative defense, and as such comes into play only if and after the plaintiff has made out a prima facie case.").

<sup>281</sup> *Campbell*, 510 U.S. at 574 ("It is uncontested here that 2 Live Crew's song would be an infringement of Acuff-Rose's rights in 'Oh, Pretty Woman,' under the Copyright Act of 1976, but for a finding of fair use through parody.").

<sup>282</sup> *EMI Catalogue P'ship v. Hill, Holliday, Connors, Cosmopolulos, Inc.*, 228 F.3d 56, 64 (2d Cir. 2000) (describing fair use as an absolute defense to a Lanham act claim). Therefore, as an absolute defense in trademark law, fair use should operate as a defense up front to trademark bullying. The Ninth Circuit has recently taken this approach to fair use in copyright takedown proceedings under the Copyright Digital Millennium Act. *Lenz v. Universal Music Corp.*, Nos. 13-16106, 13-16107, 2015 WL 5315388, at \*4-5 (9th Cir. Sept. 14, 2015) (holding that copyright fair use in the context of the Digital Millennium Copyright Act's take down procedures is a barrier to infringement claims).

<sup>283</sup> *KP Permanent Make-Up*, 543 U.S. at 116-18 (reversing the 9th Circuit's holding that it was error for the district court to have addressed the fair use defense without delving into the likelihood of confusion analysis).

<sup>284</sup> *Id.*

Additionally, historically, Section 33(b)(4) was not a general “fair use” notion. The fair use doctrine was typically invoked in comparative advertising cases where use of another's mark was necessary to describe truthfully a characteristic of the defendant's product.<sup>285</sup> In a 1979 case where the term “fair use” was used, two competing companies used the term “ribbed” on their packages for condoms.<sup>286</sup> The plaintiff had a registration for “SENSI-RIBBED.”<sup>287</sup> The defendant used “ribbed” on its packaging to describe an attribute of its condoms.<sup>288</sup>

The court held that the term “ribbed” was used by defendant as something other than an identifier of source and in a fair and good faith manner to describe its products.<sup>289</sup> That is, this so-called “fair use defense” was originally conceived of as a defense in comparative advertising cases.<sup>290</sup> It is, therefore, not surprising that KP Permanent Make-Up and Lastings were competitors. As any trademark infringement claim has to be between competitors before it is actionable, there is no normative fair use defense in trademark infringement. This defense would be better labeled the “fair use between competitors defense” to be conceptually consistent with trademark doctrine.

This is another reason why claiming trademark rights are absolute and not an extremely nuanced and context-specific right is very dangerous. Trademark rights (as opposed to dilution rights<sup>291</sup>) subsist only between competitors.<sup>292</sup> Even this so-called fair use defense is

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<sup>285</sup> See *Societe Comptoir De L'Industrie Cotonniere Etablissements Boussac v. Alexander's Dep't Stores, Inc.*, 299 F.2d 33, 36 (2d Cir. 1962); *Herbert Prods., Inc. v. S & H Indus., Inc.*, 200 U.S.P.Q. 247, 250 (E.D.N.Y. 1977).

<sup>286</sup> *In re Schmid Labs*, 482 F. Supp. at 20.

<sup>287</sup> *Id.* at 16.

<sup>288</sup> *Id.* at 17.

<sup>289</sup> *Id.* at 20–21.

<sup>290</sup> *Frederick Warne & Co., Inc. v. Book Sales Inc.*, 481 F. Supp. 1191, 1198 (S.D.N.Y. 1979) (stating that “the fair use doctrine is typically invoked in comparative advertising cases.”).

<sup>291</sup> The owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, is 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 tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury. 98 AM. JUR. 3D *Proof of Facts* § 313 (2015).

<sup>292</sup> See, e.g., *Interspace Corp. v. Lapp, Inc.*, 721 F.2d 460, 462 (3d Cir. 1983) (“The closer the relationship between the products, and the more similar their sales contexts, the greater the likelihood of confusion.”); J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:1 (4th ed. 2015). I do not intend here to enter the debate about “related goods.” The related goods doctrine is not part of traditional trademark jurisprudence and not evenly applied by the courts.

only applicable between competitors.<sup>293</sup> Therefore, there is no fair use defense to a trademark dilution claim. This is yet another advantage to marks which become famous. Once famous, such marks become protected by the trademark dilution statute and, accordingly, cannot be subject to the fair use defense.<sup>294</sup> First, such marks are not “descriptive” marks, such marks are famous marks and, therefore, very strong.<sup>295</sup> Second, dilution, by definition, is supposed to apply “regardless” of competition between the parties.<sup>296</sup> Trademark infringement is only actionable when there is competition between the parties.<sup>297</sup> Therefore, famous marks are enforced against non-competitors and, as such, the defense of fair use based on Section 33(b)(4) of the Lanham Act, therefore, is inappropriate.<sup>298</sup>

*KP Permanent Make-Up* so undermined *Park ‘N Fly* that it should be said to have overruled it by implication or *sub silentio*. This is a very dangerous and unsettling reality of the United States Supreme Court’s trademark jurisprudence. The fact remains that the last thirty years have seen the Court switch from being extremely generous to trademark holders to being quite restrictive. Further, the Court’s view of overruling by implication is also troubling; “[i]f a precedent of this Court has direct application in a case, yet appears to rest on reasons rejected in some other line of decisions, the Court of Appeals should

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Some famous treatise writers seem to endorse the view, but, one way or another, it is not part of the conceptual justification of trademark jurisprudence in the United States and, in fact, may be entirely distinguishable.

<sup>293</sup> See, e.g., *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1151 (9th Cir. 2002) (explaining prior to *KP Permanent Make-Up* that the classic fair use defense complements the likelihood of consumer confusion analysis—this may be a better normative result but the Court in *KP Permanent Make-Up* did not adopt this view).

<sup>294</sup> 98 AM. JUR. 3D *Proof of Facts* § 313 (2015).

<sup>295</sup> 15 U.S.C. § 1125(c)(2)(A) (2012) (“[A] mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner.”). A famous mark is a distinctive mark and a distinctive mark is a strong mark.

<sup>296</sup> *Id.* at §1125(c)(1) (explaining that the owner of a distinctive famous mark is entitled to an injunction for dilution of a famous mark “regardless of the presence or absence of . . . competition . . .”).

<sup>297</sup> See, e.g., *Interspace*, 721 F.2d at 462 (“The closer the relationship between the products, and the more similar their sales contexts, the greater the likelihood of confusion.”).

<sup>298</sup> See 15 U.S.C. § 1125(c)(3)(A) (“The following shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection: (A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person *other than as a designation of source for the person’s own goods or service*, including use in connection with—(i) advertising or promotion that permits consumers to compare goods or services; or (ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.”) (emphasis added).



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follow the case which directly controls, leaving to this Court the prerogative of overruling its own decisions.”<sup>299</sup>

That is, in trademark jurisprudence, the Court is ordering lower courts to apply *Park ‘N Fly* as if *KP Permanent Make-Up* does not exist. That begs the obvious question: Are descriptive but incontestable trademarks worthy of protection or not? *Park ‘N Fly* says yes; *KP Permanent Make-Up* says no. The only thing an otherwise infringer of an incontestable mark needs to do to avoid liability is to argue that it used the descriptive mark descriptively.<sup>300</sup> If it does, *Park ‘N Fly* has no weight and is eviscerated by *KP Permanent Make-Up*.

The Court in *Rodriguez de Quijas v. Shearson/Am. Express Inc.* claims authority to overrule its own decisions. It commands lower courts to follow whichever of its decisions “directly control.”<sup>301</sup> The only time *Park ‘N Fly* will directly control and *KP Permanent Make-Up* can be avoided is when a descriptive and incontestable mark is used in a non-descriptive manner.<sup>302</sup> That non-descriptive manner would be most likely be in an arbitrary manner. Therefore, if someone had been able to register “CREAM CHEESE” and it had become incontestable, *KP Permanent Make-Up* would not allow the use of “CREAM CHEESE” on items related to or including cream cheese. It would find actionable the use of “CREAM CHEESE” on automobiles, for example.

Taking the *Park ‘N Fly* and *KP Permanent Make-Up* duo at face value and presuming they are both good law, the result in the “CREAM CHEESE” example is that arbitrary (non-descriptive) uses would not be forgiven (relying on *KP Permanent Make-Up*); however, arbitrary uses would fall beyond the scope of the trademark (*Park ‘N Fly*) and, therefore, *Park ‘N Fly* would never come into play. There are no circumstances where a plaintiff could enlist the *Park ‘N Fly* doctrine for a positive result and not run afoul of the *KP Permanent Make-Up* doctrine.

As such, *Park ‘N Fly* has been overruled by implication. Of course, in order to accept this fact, one would also have to accept the traditional notion of trademark jurisprudence as articulated by the Supreme Court<sup>303</sup> and dismiss exaggerated notions that property-based rhetoric

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<sup>299</sup> *Rodriguez de Quijas v. Shearson/Am. Express, Inc.*, 490 U.S. 477, 484 (1989).

<sup>300</sup> *KP Permanent Make-Up*, 543 U.S. at 124.

<sup>301</sup> *Rodriguez*, 490 U.S. at 484.

<sup>302</sup> *Park ‘N Fly*, 469 U.S. at 201.

<sup>303</sup> *See, e.g., United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918) (“There is no such thing as property in a trade-mark except as a right appurtenant to an established business or trade in connection with which the mark is employed.”); *Trade-Mark Cases*, 100 U.S. 82, 94 (1879) (“[The trademark right] is simply founded on priority of appropriation.”).



has any place in analyzing trademark jurisprudence.<sup>304</sup>

That is, the Supreme Court has stated many times that there is no property right in a trademark itself.<sup>305</sup> According to the Supreme Court, the scope of a trademark is confined by its use.<sup>306</sup> Additionally, trademark law is a subset of unfair competition law.<sup>307</sup> As such, without competition, there, by definition, can be no confusion and therefore no infringement.<sup>308</sup>

Some academics would have us believe that the scope of the trademark is something more than that.<sup>309</sup> Some assert that the trademark right is absolute and draw property-like analogies to trademark jurisprudence.<sup>310</sup> They become confused into believing intellectual property's own rhetoric. After all, how can trademarks not be property if they are part of a world known as "intellectual property?"<sup>311</sup>

However, this rhetoric is confused and misplaced. A trademark has never operated as property in the American system. Trademarks do not, and never have, satisfied Honore's incidents of ownership.<sup>312</sup> As I have argued before,<sup>313</sup> according to Honore, if something is to be characterized as "property," it should manifest certain "incidents."<sup>314</sup> Most relevant here, as it was in 1993, is "the right to possess."<sup>315</sup> In Honore's terms, this means that the holder has the exclusive right to

<sup>304</sup> See MCCARTHY, *supra* note 292 at § 32:142 (comparing incontestability to the modern system of recording title to real estate). See also DAPHNE ROBERT, *THE NEW TRADEMARK MANUAL* 133 (1947) ("On its face, it would appear [incontestability] means that at some time the title to the property right in the mark is quieted and the rights of the registrant are forever secure"); Glyn S. Lunney, Jr., *Trademark Monopolies*, 48 EMORY L. J. 363 (1999) (providing the best critique of this position).

<sup>305</sup> See, e.g., *United Drug*, 248 U.S. at 97 ("There is no such thing as property in a trade-mark . . .").

<sup>306</sup> *Id.* ("[T]he right to a particular mark grows out of its use, not its mere adoption . . .").

<sup>307</sup> *Id.* ("The law of trade-marks is but a part of the broader law of unfair competition . . .").

<sup>308</sup> *Interspace Corp. v. Lapp, Inc.*, 721 F.2d 460, 462 (3d Cir. 1983) ("The closer the relationship between the products, and the more similar their sales contexts, the greater the likelihood of confusion.").

<sup>309</sup> See Lunney, *supra* note 304, at 370–72 (critiquing this claim).

<sup>310</sup> See, e.g., Landes & Posner, *supra* note 167, at 265 (comparing the economics of trademark law to that of property rights).

<sup>311</sup> *Id.* at 265–68 ("Since intellectual property is a particularly costly form of property . . .").

<sup>312</sup> See generally A. M. Honore, *Ownership*, in OXFORD ESSAYS IN JURISPRUDENCE 107 (A. G. Guest ed., 1961) (listing eleven standard incidents of ownership).

<sup>313</sup> Port, *supra* note 5, at 554–55.

<sup>314</sup> Honore, *supra* note 312, at 112–13.

<sup>315</sup> *Id.* at 113.

control a thing and the right to remain in control.<sup>316</sup> As anyone who has heard of Delta Airlines and Delta faucets, as well as the myriad number of more current, similar examples, trademark rights are not absolute.<sup>317</sup> The metaphorical Delta Airlines of the world may prevent the use of the same or similar marks on the same or similar goods.<sup>318</sup> It may not prevent the use of its trademark by any entity whatsoever on unrelated goods or services.<sup>319</sup> Trademarks have never been perceived as such broad grant and the Supreme Court, numerous times, has said that a trademark itself is not subject to property ownership.<sup>320</sup>

Traditional trademark jurisprudence, as opposed to dilution jurisprudence, is a form of encouraging and motivating fair competition.<sup>321</sup> To those ends, competition is necessary before trademark infringement can occur.

Therefore, if someone registers the mark “PARK ‘N FLY” for use on services of parking cars and then assisting people to the airport where they will fly, traditional trademark jurisprudence requires an alleged infringer to be in competition with the entity that holds the “PARK ‘N

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<sup>316</sup> *Id.*

<sup>317</sup> See 145 CONG. REC. 163, 14,713 (1999) (“[T]here may be concurring uses of the same name that are noninfringing, such as the use of the “Delta” mark for both air travel and sink faucets . . .”). See also *Trademark Basics*, BROWN LEGAL, <http://www.brownlegal.com/pages/Trademark%20Basics.pdf> (last visited Oct. 12, 2015) (“[I]f the public can distinguish between two trademarks, the two may co-exist, such as Delta (airlines) and Delta (faucets) . . .”).

<sup>318</sup> See Port, *supra* note 5, at 556–58. This presumes the dilution doctrine is either illegitimate or does not apply in any of these given circumstances.

<sup>319</sup> A similarity of the goods examination is mentioned in every circuit’s “likelihood of confusion” analysis. See *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 487 (1st Cir. 1981); *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961); *Scott Paper Co. v. Scott’s Liquid Gold, Inc.*, 589 F.2d 1225, 1229 (3d Cir. 1978), *superseded by rule*, Fed. R. Civ. P. 52(a), *as stated in Shire US Inc. v. Barr Labs., Inc.*, 329 F.3d 348, 352–53 (3d Cir. filed 2003); *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1527 (4th Cir. 1984); *Roto-Rooter Corp. v. O’Neal*, 513 F.2d 44, 45 (5th Cir. 1975); *Frisch’s Rests., Inc. v. Elby’s Big Boy of Steubenville, Inc.*, 670 F.2d 642, 648 (6th Cir. 1982); *Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366, 381–82 (7th Cir. 1976), *superseded by statute*, Fed. R. Civ. P. 52(a), *as stated in Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1429 (7th Cir. 1985); *SquirtCo. v. Seven-Up Co.*, 628 F.2d 1086, 1091 (8th Cir. 1980); *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979), *abrogated by Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 810 (9th Cir. 2003); *Beer Nuts, Inc. v. Clover Club Foods Co.*, 805 F.2d 920, 925–26 (10th Cir. 1986); *Safeway Stores, Inc. v. Safeway Disc. Drugs, Inc.*, 675 F.2d 1160, 1164 (11th Cir. 1982) (quoting *Roto-Rooter*, 513 F.2d at 45).

<sup>320</sup> See *United Drug*, 248 U.S. at 97 (“There is no such thing as property in a trademark . . .”).

<sup>321</sup> *Id.* at 97–98 (discussing that trademark law is a part of the law of unfair competition and is not to be used as a monopoly).

FLY” mark before an injunction is appropriate.<sup>322</sup> In the *Park ‘N Fly* case, the defendant was arguably in competition with the plaintiff as they both advertised and sold the service of parking your car at an airport and getting a ride to the terminal.<sup>323</sup> Therefore, both traditional trademark jurisprudence and Section 33(b)(4) would apply if we can get over the fact that Park ‘N Fly’s mark was descriptive. The Supreme Court held in that case that incontestability allowed the court to ignore the fact that the mark was descriptive and therefore otherwise unenforceable and issue the injunction.<sup>324</sup>

However, with the holding in *KP Permanent Make-Up*, such a mark as “PARK ‘N FLY” is descriptive even though it is incontestable and therefore, its descriptive use by others should be forgiven.

The only time this trap is avoided is when the putative “PARK ‘N FLY”-like descriptive mark is not used descriptively. As such, “PARK ‘N FLY” brand cream cheese would be a non-descriptive use of a descriptive but incontestable mark. However, under traditional trademark jurisprudence where competition is necessary, “PARK ‘N FLY” cream cheese could not be enjoined by the plaintiff/holder of the incontestable “PARK ‘N FLY” registered trademark because it is outside the scope of the use of parking and flying services.

Dilution law would not save such a plaintiff either because, at the time of the litigation, there was no evidence that “PARK ‘N FLY” was a famous or distinctive mark.<sup>325</sup>

Therefore, the *KP Permanent Make-Up* case eviscerated the *Park ‘N Fly* doctrine, rendering it completely useless.<sup>326</sup> In light of *KP Permanent Make-Up* and traditional trademark jurisprudence, there is no circumstance in which the *Park ‘N Fly* doctrine would logically apply today. To make it apply, one has to make various contortions about the scope of the trademark that the Supreme Court has never agreed with and pretend that the trademark is more than it is.

## VII. CONCLUSION

The scope of trademark law has expanded and contracted over time. The Supreme Court, the principal arbiter in making this determination, first began expanding the scope of the trademark right with the *Park ‘N*

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<sup>322</sup> *eBay Inc. v. MercExchange, LLC.*, 547 U.S. 388, 391 (2006) (stating that “a plaintiff seeking a permanent injunctive relief must satisfy [the] four-factor test” that is set forth in *eBay*).

<sup>323</sup> *Park ‘N Fly*, 469 U.S. at 191–192.

<sup>324</sup> *Id.* at 205.

<sup>325</sup> 15 U.S.C. § 1125(c) (2012).

<sup>326</sup> Bradley Scott Shannon, *Overruled by Implication*, 33 SEATTLE U. L. REV. 151, 152 (2009).

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*Fly* decision in 1985. Through a series of Supreme Court cases, that right was at first further expanded with the *Taco Cabana* case and the *Qualitex* case, and then constricted with the *Wal-Mart* case and, most recently, with the *KP Permanent Make-Up* case.

The *KP Permanent Make-Up* case is most often cited for the proposition that a descriptive mark used descriptively amounts to fair use and such use should be forgiven. However, when juxtaposed against the *Park 'N Fly* doctrine, it appears that incontestability in the United States has been eviscerated. With *KP Permanent Make-Up*, there are no longer any instances when a descriptive mark should be relied upon to seek an injunction against another (the *Park 'N Fly* doctrine) because every such instance should be met with a claim that the descriptive mark is being used descriptively and, therefore, fair (the *KP Permanent Make-Up* doctrine).

There is a logical inconsistency between *Park 'N Fly* and *KP Permanent Make-Up*. It is not clear that the Supreme Court understood what they were doing in *KP Permanent Make-Up*, but the result was that the *Park 'N Fly* doctrine was so constricted that it can be said to no longer exist. As such, the *Park 'N Fly* decision was overruled by implication and we ought to recognize that fact. The effect of this determination should be that trademark bullies should be reined in by one notch. Trademark bullies should no longer be able to attempt to enforce descriptive marks (even if incontestable) because every such claim should be met with the absolute defense of trademark fair use.