

IN THE UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

No. 03-20787

TEST MASTERS EDUCATIONAL SERVICES, INC. and VIVEK ISRANI,
Plaintiffs-Appellees,
v.
ROBIN SINGH d/b/a TESTMASTERS,
Defendant-Appellant.

No. 04-20861

ROBIN SINGH EDUCATIONAL SERVICES, INC. d/b/a TESTMASTERS,
Plaintiff-Appellant,
v.
TEST MASTERS EDUCATIONAL SERVICES, INC. and VIVEK ISRANI,
Defendants-Appellees.

On Appeal from the United States District Court
for the Southern District of Texas, Houston Division

**BRIEF OF AMICUS CURIAE
INTERNATIONAL TRADEMARK ASSOCIATION
IN PARTIAL SUPPORT OF APPELLANTS ROBIN SINGH AND ROBIN
SINGH EDUCATIONAL SERVICES, INC. AND FOR REVERSAL**

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SUPPLEMENTAL CERTIFICATE OF INTERESTED
PERSONS AND CORPORATE DISCLOSURE
STATEMENT

Pursuant to Rule 26.1 of the Federal Rules of Appellate Procedure and Fifth Circuit Rules 26.1, 28.1 and 29.2, amicus curiae The International Trademark Association states that it has no corporate parent and there are no parties that own 10% or more of its stock.

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INTRODUCTION

The International Trademark Association (INTA) files this brief as amicus curiae.¹ INTA submits that the district court below improperly granted an injunction permanently barring a putative service mark owner from applying to register his mark with the United States Patent and Trademark Office (USPTO) and permanently barring a party interested in the service mark application or registration of another from communicating with the USPTO about that application or registration. Because it has not had access to the factual record on which the district court based its opinions, INTA takes no position as to a) whether either mark at issue in this case is a valid one, b) whether either mark at issue is entitled to registration with the USPTO, or c) the litigation tactics employed by the parties.

STATEMENT OF INTEREST OF THE AMICUS CURIAE

INTA is a not-for-profit organization of over 4,600 members, including trademark owners, law firms, advertising agencies, packaging companies and professional associations from the United States and 180 other countries. All share goals of emphasizing the importance of trademarks, and of promoting an understanding of the role marks play in informed consumer decisions, effective com-

¹ This brief was not authored, in whole or in part, by counsel to a party and no contribution to its preparation or submission was made by any person or entity other than INTA or its counsel. The law firm representing Test Masters Educational Services, Inc. and Vivek Israni is an associate member of INTA, but attorneys affiliated with that law firm have not participated in the decision to submit this brief, in its preparation, or in its submission.

merce, and fair competition. INTA members frequently participate in trademark litigation, and are thus interested in the development of clear principles of trademark law. INTA has substantial expertise in trademark law and has participated as amicus curiae in numerous cases involving important trademark issues.² The officers of INTA frequently testify before Congress on matters concerning the USPTO and management of the trademark system in the United States.³

INTA and its members have a particular interest in certain legal issues present in this case because trademark owners rely upon the ability of the trademark system to acknowledge and protect marks that have acquired secondary meaning over time and upon the effective operation of a registration process that depends in major part on the input of interested parties to assist the USPTO in its evaluation of applications to register marks.

² Cases in which INTA has filed amicus briefs include: *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003); *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003); *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001); *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000); *College Sav. Bank v. Fla. Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. 666 (1999); *Dickinson v. Zurko*, 527 U.S. 150 (1999); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992); *K Mart Corp. v. Cartier, Inc.*, 486 U.S. 281 (1988); *WarnerVision Entertainment Inc. v. Empire of Carolina, Inc.*, 101 F.3d 259 (2d Cir. 1996); *Preferred Risk Mut. Ins. Co. v. United States*, 86 F.3d 789 (8th Cir. 1996); and *Conopco, Inc. v. May Dep't Stores Co.*, 46 F.3d 1556 (Fed. Cir. 1994).

³ E.g., *U.S. Patent and Trademark Office: Fee Schedule Adjustment and Agency Reform, Hearing Before the Subcomm. on Courts, the Internet, and Intellectual Property of the House Comm. on the Judiciary*, 107th Cong. 25 (2002) (statement of Kathryn Barrett Park, Executive Vice President, INTA).

SUMMARY OF ARGUMENT

It is a fundamental precept of trademark law in the United States that trademark rights change over time. A descriptive mark may acquire secondary meaning as consumers increasingly associate that mark with a particular source of goods or services. A fanciful mark may become generic as consumers increasingly associate that mark with a type of product instead of with the source of a product. And a mark may, over time, become famous and entitled to protection against dilution, as consumers come to recognize that distinctive mark and associate it always with one particular source of goods or services, no matter the context in which they encounter the famous mark.

Therefore, the proper functioning of the trademark system, both for the private interests of mark owners and the public interests of consumers, depends upon the ability of the trademark system generally, and the USPTO in particular, to recognize and address the changes that can take place in how the consuming public perceives individual marks. The USPTO relies to a large degree upon applicants – and others, whose rights may be affected by applications – to inform the USPTO of the facts concerning how marks are perceived in the marketplace and the validity of applications for federal registration. By permanently denying a mark owner both the ability to pursue registration of a mark and the ability to contest a competitor's attempt to register a similar mark, the district court ignored the possibility

that the public's perception of the marks at issue might change over time and impaired the necessary ability of the USPTO to evaluate properly the applications and registrations before it. Moreover, it also failed to take into account that the grounds for a challenge to an application or a registration extend beyond those controlled by the factual findings it had made.

ARGUMENT

I. THE INJUNCTION ENTERED BY THE DISTRICT COURT IS OVERBROAD TO THE EXTENT THAT IT PERMANENTLY ENJOINS APPELLANT FROM PURSUING REGISTRATION OF HIS MARK IN THE USPTO.

Robin Singh is the proprietor of a test preparation business offering services under the name TestMasters in California, Colorado, Illinois, New York and the District of Columbia. Test Masters Educational Services ("TES") also offers test preparation services, but does so exclusively in Texas. Before the District Court for the Southern District of Texas, Singh claimed that TES infringed his federally registered trademark, TESTMASTERS. TES sought a declaratory judgment of non-infringement and claimed that Singh's mark was invalid "for being descriptive without a secondary meaning." *Test Masters Educ. Servs., Inc. v. Singh*, No. 01-20659, slip op. at 4 (5th Cir. July 24, 2002). After a jury trial and an appeal, the district court held that Singh's mark was descriptive, that he had failed to show that the mark had acquired secondary meaning, and that his federal registration must be

cancelled. In this context, the district court issued an order on July 14, 2003, that, among other things, permanently enjoined Singh from pursuing a federal registration of his mark and prohibited him from “interfering with or opposing” the efforts of TES to register its own marks. Singh appeals from that order in Appeal No. 03-20787. On June 23, 2003, Singh commenced a new action in the Central District of California, alleging that TES was infringing Singh’s trademarks. TES moved to dismiss that action on the basis of *res judicata*. The California action was transferred to Southern District of Texas and the district court granted the motion to dismiss, holding that Singh’s claims were barred “not only because of the doctrine of *res judicata* but also because secondary meaning is not ripe for relitigation” after the passage of “approximately sixteen months.” *Robin Singh Educ. Servs., Inc., v. Test Masters Educ. Servs., Inc.*, No. H-03-3348, slip op. at 26 (S.D. Tex. Sept. 17, 2004). Singh appeals from that order in Appeal No. 04-20861.

The proper functioning of the trademark system for both the public interest and private parties requires that trademark rights and obligations change as marketplace circumstances evolve. Even if a party is unable to demonstrate in a court of law or before the USPTO that a mark has acquired secondary meaning at a particular point in time, the perception of that mark in the marketplace might change over time and thus enable a later showing that the mark had acquired the secondary meaning that was previously absent. By permanently enjoining Singh from seek-

ing to register his mark – a mark that he continues to use and promote in commerce – the district court has ignored this basic reality of trademark rights.

This Court has recognized clearly the mutable nature of trademark rights in *Continental Motors Corp. v. Continental Aviation Corp.*, 375 F.2d 857 (5th Cir. 1967), in which a prior determination that a mark incorporating a descriptive term was “inherently incapable of being appropriated either as a trade mark or as a trade name” did not preclude a finding of secondary meaning when, some years later, the owner of the same mark made another attempt to assert a protectible interest in that mark. The Court explained that a word is entitled to protection as a trademark when:

because of association with a particular product or firm over a period of time, the word has in the mind of the public come to stand as a name or identification for that product or firm. Protection is warranted on what it has come to signify regardless of any original weakness, actual or supposed. . . . Time, tide, and the relentless movement of the copywriter's pen makes what we once said no longer controlling, not so much from change in the law, but from change in economic fact. . . . And it is here that modern, intense advertising creates the “image” upon which the public depends or may depend.

Id. at 861-862; accord *Am. Heritage Life Ins. Co. v. Heritage Life Ins. Co.*, 494 F.2d 3, 15 (5th Cir. 1974) (rejecting claims of secondary meaning, but noting “[a]lthough . . . today neither party can claim the required distinctiveness, tomorrow the word may grow in individuality”). Thus, as this Court properly explained at an earlier stage of this litigation, “because TES never did business anywhere be-

sides Texas, TES's having used its Test Masters mark first does not prevent Singh's mark from establishing a secondary meaning in California." *Test Masters Educ. Servs., Inc. v. Singh*, No. 01-20659, slip op. at 9 (5th Cir. July 24, 2002).

The injunction issued by the district court would make permanent the "original weakness" that afflicted Singh in his first attempt to claim rights in his mark, denying the economic reality that this Court has recognized in *Continental, American Heritage*, and in its opinion in the instant case only two years ago: a trademark owner may overcome the original weakness of his mark through marketing efforts and lengthy use, and the legal system must recognize that change. *See Pebble Beach Co. v. Tour 18 I Ltd*, 155 F.3d 526, 541 (5th Cir. 1998) (identifying "length and manner of use" as relevant considerations in secondary meaning inquiry).

The district court's permanent injunction appears to be grounded solely on Singh's failure to prove secondary meaning at the time of trial. Basing a permanent injunction on this failure alone ignores the fact that the public's perception of the mark at issue could change over time and that Singh may establish secondary meaning at some future date in the very mark the court found to be merely descriptive at a particular point in the past. *Compare Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169 (1896) (holding that "Singer" a generic term for sewing machines) *with Singer Mfg. Co. v. Briley*, 207 F.2d 519 (5th Cir. 1953) (holding that "by the constant and exclusive use of the name 'Singer' in designating sewing machines

and other articles manufactured and sold by it and in advertising the same continuously and widely – [plaintiff] recaptured from the public domain the name ‘Singer’. . . [which] has thus become a valid trade-mark . . . and is entitled to protection as such”). If, as this Court recognized in *Singer*, it is possible to reclaim from the public domain even a mark held generic by the Supreme Court – a substantially more restrictive outcome in a considerably more “final” decision than that here – a prior finding that secondary meaning does not exist cannot preclude a later conclusion that it does.

A permanent injunction like that entered by the district court may be modified under Rule 60(b) of the Federal Rules of Civil Procedure. The possibility of modification under Rule 60(b), however, does not resolve the difficulties created by the permanent injunction issued by the district court.⁴ First, modification under Rule 60(b) is extraordinary relief and requires a showing of extraordinary circumstances.

“Modification is only cautiously to be granted; . . . some change is not enough; . . . the dangers which the decree was meant to foreclose must almost have disappeared; . . . hardship and oppression, extreme and unexpected, are significant; and . . . the movants’ task is to provide close to an unanswerable case. *To repeat: caution, substantial change, unforeseenness, oppressive hardship, and a clear showing are the requirements.*”

⁴ Singh moved for reconsideration of the district court’s order below and that motion was summarily denied.

Transgo, Inc. v. Ajac Transmission Parts Corp., 911 F.2d 363, 365 (9th Cir. 1990) (emphasis in original) (quoting *Humble Oil & Refining Co. v. Am. Oil Co.*, 405 F.2d 803, 813 (8th Cir. 1969)). In the context of the proof of secondary meaning, the bar imposed by Rule 60(b) is certainly higher than that required to show that a descriptive mark has become protectible in the ordinary course. See, e.g., *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786 (5th Cir. 1983). Second, “consideration of 60(b)(5) motions ‘does not allow relitigation of issues which have been resolved by the judgment.’” *Transgo*, 911 F.2d at 365 (quoting *Money Store, Inc. v. Harriscorp Fin., Inc.*, 885 F.2d 369, 372 (7th Cir. 1989)). A too restrictive application of this rule might prevent a mark owner from proving that the mark at issue had acquired secondary meaning since the time the original judgment was entered.

There is therefore no justification for permanently barring a trademark owner from attempting to prove that his mark has acquired secondary meaning or for requiring him to meet a far higher standard of proof (extraordinary circumstances) simply because he failed to establish secondary meaning at some point in the past. Moreover, not only does this principle limit the extent to which a party may be enjoined from alleging secondary meaning, it also restricts application of the doctrine of *res judicata*. As the Trademark Trial and Appeal Board has explained in the registration context, “[t]here is nothing to preclude an applicant from

attempting a second time . . . to register a particular mark if conditions and circumstances have changed since the rendering of the adverse final decision in the first application.” *In re Oscar Mayer & Co.*, 171 U.S.P.Q. (BNA) 571, 573 (T.T.A.B. 1971); accord *In Re Honeywell Inc.*, 8 U.S.P.Q.2d (BNA) 1600 (T.T.A.B. 1988). Thus, *res judicata* should not automatically prevent relitigation of a claim of secondary meaning. See, e.g., *Flowers Indus. v. Interstate Brands Corp.*, 5 U.S.P.Q.2d (BNA) 1580, 1584 (T.T.A.B. 1987). Rather, properly phrased, “[t]he question generally in the second proceeding is, of course, whether changes in facts and circumstances do exist and, if so, whether they can support the [renewed claim of trademark rights].” *Oscar Mayer*, 171 U.S.P.Q. at 573. Therefore, without taking a position on whether Singh’s mark has acquired secondary meaning, INTA submits that the district court erred in permanently barring Singh from seeking registration on the basis of secondary meaning, and its order should therefore be reversed.

II. THE DISTRICT COURT’S ORDER IMPROPERLY ENJOINS AN INTERESTED PARTY FROM COMMUNICATING WITH THE USPTO CONCERNING A PENDING APPLICATION FOR REGISTRATION OF A MARK.

The district court permanently enjoined Singh “from interfering with or opposing Test Master Education Services Inc.’s registration of the TESTMASTERS

or TEST MASTERS marks in the United States Patent and Trademark Office.” Docket No. 241, at 1. A permanent injunction barring an interested party from communicating with the USPTO concerning a pending application is not authorized by any provision of the Lanham Act and is in conflict with the interests of the general public and the interests of trademark owners in the fair and efficient management of the trademark system.

Once the USPTO examining attorney assigned to an application has approved it, the application will be “published” in the USPTO’s *Official Gazette*. At that time, “[a]ny person who believes that he would be damaged by the registration of a mark upon the principal register . . . may, upon payment of the prescribed fee, file a notice of opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication . . . of the mark sought to be registered.” 15 U.S.C. § 1063. The grounds on which an opposition may be based are set forth in section 2 of the Act, and include the allegation in section 2(d) that the opposer has priority of rights to valid mark that is confusingly similar to the mark for which registration is sought. *See* 15 U.S.C. § 1052(d). They also include the allegation that the challenged mark is merely descriptive and without secondary meaning. *See id.* § 1052(e).

Even if it were proper to give perpetual effect to the District Court’s finding that Singh’s mark was not valid because it had not achieved secondary meaning,

such a finding would be relevant only to an attempt by Singh to oppose TES's application under section 2(d) of the Act. In particular, it would not have any bearing on the other grounds for opposition set forth in section 2, including section 2(e)'s authorization of an opposition against the application on the basis that *TES's* mark (as opposed to that of Singh) is descriptive and lacks secondary meaning.

The district court's order barring Singh from asserting *any* challenge to TES's application is of no small consequence. Once a mark has been registered on the USPTO's Principal Register for five years, and provided that the registrant complies with certain statutory formalities, the mark and registration can become "incontestable." *See* 15 U.S.C. §§ 1065, 1115(b). "Incontestability" in turn bars defendants in any litigation to protect the mark from arguing that the mark is descriptive and lacks secondary meaning. *See Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 205 (1985). As the Supreme Court has recognized, the potentially deleterious effect of restricting the access of other industry participants to competitively necessary descriptive terms makes the availability of opposition proceedings a critical aspect of the balance established by Congress in passing the Act. *See id.* at 202.⁵

⁵ Although not directly implicated by the parties' claims in this case, there are a number of other bases for a challenge to a published application that allow interested parties to vindicate the public interest in free and fair competition, including, *inter alia*, that the challenged mark is deceptive, deceptively misdescriptive, primarily geographically deceptively misdescriptive, or functional or that it falsely suggests an association with other persons and institutions. 15 U.S.C. § 1052.

In particular, the USPTO’s interest in assessing questions of federal registration in the first instance, based on a complete evidentiary record, outweighs any interest that might be served by a permanent injunction barring an interested party from interfering with or opposing a registration. By prohibiting an interested party from participating in the trademark application process – in particular when that interested party is likely to have a stronger interest in the process than any party other than the applicant – the district court’s injunction threatens the effective operation of the trademark system and compromises the public interest in a fair and thorough trademark registration process.

Against the statutory framework expressly authorizing oppositions, the district court’s injunction cannot rest on its equitable powers of relief under section 34 of the Lanham Act, 15 U.S.C. § 1116(a), or on its ability to “rectify the register” under section 37 of the Act, *id.* § 1119. For example, in *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189 (1985), the Supreme Court rejected the contention that section 34’s reference to “the principles of equity,” authorized a defense to the incontestable status of a mark not specifically authorized by section 33(b) of the Act.⁶ The Court also rejected any expansive reading of section 37 that would undermine the more specific provisions of the Lanham Act:

⁶ Section 33(b) of the Lanham Act enumerates nine specific defenses to the incontestability of a registered mark as granted by section 33(a). 15 U.S.C. § 1115(b).

Whatever the precise boundaries of the courts' equitable power, we do not believe that it encompasses a substantive challenge to the validity of an incontestable mark on the grounds that it lacks secondary meaning. To conclude otherwise would expand the meaning of "equity" to the point of vitiating the more specific provisions of the Lanham Act. Similarly, the power of the courts to cancel registrations and "to otherwise rectify the register," § 37, 15 U.S.C. § 1119, must be subject to the specific provisions concerning incontestability. In effect, both respondent and the dissent argue that these provisions offer insufficient protection against improper registration of a merely descriptive mark, and therefore the validity of petitioner's mark may be challenged notwithstanding its incontestable status. Our responsibility, however, is not to evaluate the wisdom of the legislative determinations reflected in the statute, but instead to construe and apply the provisions that Congress enacted.

469 U.S. at 203. Because no specific provision of the Act authorizes the district court permanently to enjoin an interested party from opposing or interfering with a pending application, *Park 'N Fly* leads to the conclusion that the district court erred in entering just such an injunction.

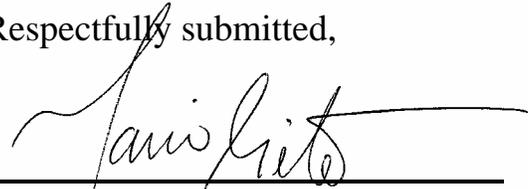
CONCLUSION

By permanently enjoining a trademark owner from pursuing registration of his marks in the USPTO, the district court ignored this Court's prior holdings that trademark rights depend upon the public's perception of the meaning of the words and symbols used as marks. As public perception changes, trademark rights also change. A failure to establish secondary meaning in a descriptive mark at a particular point in time does not prohibit a trademark owner from continuing to invest

in and develop his mark, and should not prohibit the trademark owner from seeking registration for his trademark at some date in the future when he can prove secondary meaning. Moreover, by permanently enjoining an interested party from opposing or interfering with an application to register a mark, the district court acted without authority and contrary to the registration system created by the Lanham Act.

Therefore, INTA urges this court to reverse or modify the order of the district court and remand with instructions to delete Paragraphs 1 and 2 thereof or to modify those paragraphs accordingly.

Respectfully submitted,



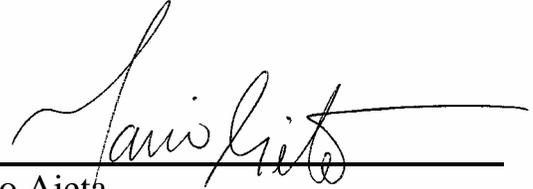
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CERTIFICATE OF COMPLIANCE

Pursuant to Rule 32(a)(7)(C) of the Federal Rules of Appellate Procedure, the undersigned certifies that the relevant portions of this brief contain 3379 words as determined by the word processing system used to generate the brief.

A handwritten signature in black ink, appearing to read "Mario Aieta", written over a horizontal line.

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