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GIVING THE WRONG IMPRESSION: SECTION 2(a)'S FALSE SUGGESTION OF A CONNECTION*

*By Anne Gilson LaLonde***

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* Adapted and reprinted from *Gilson on Trademarks* with permission.

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I. INTRODUCTION

In 1938, the Commissioner of Patents implored the drafters of the Lanham Act to block certain trademark registrations that would surely outrage the American people: What if someone tried to register DUCHESS OF WINDSOR lingerie, KNUTE ROCKNE whisky, or even (gasp) NOTRE DAME gin?[1] Something had to be done.

Their solution was an intriguing little pocket of the Lanham Act in Section 2(a), nestled beside deceptiveness, geographical indications of wines or spirits, and the now-disempowered "scandalous" and "disparaging" bars.[2] Section 2(a) provides for a federal right that bears a strong resemblance to a right of publicity that protects against offending registrations. It arguably has a lower bar for fame than the federal dilution provisions. Oh, and no trademark rights? No use in commerce? No likelihood of confusion? No problem.

Perhaps you represent a celebrity who hasn't used her name as a source indicator but wants to stop others from using it to sell makeup, apparel, or sparkly accessories. Or a foreign company that wants to protect its well-known mark in the United States but the company is not using its mark there. Maybe a university or other institution that's gained a nickname from its fans and wants to stop others from profiting off of it.

Well, the false suggestion of a connection ground for refusal in Section 2(a) just might win the day for you.

Under that provision, a mark can never be registered if it "[c]onsists of or comprises . . . matter which may . . . falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols."[3] It casts a broad net of protection, foreign and domestic, from renowned individuals to companies, groups, and government agencies.

And this claim is powerful. A registration can be cancelled *at any time* if the trademark suggested a false connection at the time of registration, even if the right to use that mark is incontestable. Compare that to challenges to a registration based on likelihood of

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1 Hearings on H.R. 9041 Before the Subcommittee on Trademarks of the Committee on Patents of the United States House of Representatives, 75th Cong., 3d Sess. 79-80 (1938) (testimony of Commissioner of Patents Conway P. Coe) ("[T]o me those attempts [would] shock my sense of propriety as an American citizen, in addition to my official capacity. I think the present law should be broadened to enable the Patent Office to prevent such outrages of the sensibilities of the American people.").

2 15 U.S.C. § 1052(a). *See* Iancu v. Brunetti, 139 S. Ct. 2294 (2019) (prohibition on registering "scandalous" marks unconstitutional); Matal v. Tam, 137 S. Ct. 1744 (2017) (prohibition on registering "disparaging" marks unconstitutional).

3 15 U.S.C. § 1052(a).

confusion, which are barred five years after the registration issues.[4] (Some have characterized Section 2(a) as merely a "backdoor" to Section 2(d),[5] though as this article explains, the claims are hardly interchangeable.)

This article will investigate the quirks of the false suggestion of a connection refusal and its often-colorful case law. It audits the possibilities and limits of the claim. Read on for a wide-ranging treatment of NOTRE DAME cheese (sadly not gin), the NAFTA treaty, a houndstooth pattern, World War II pin-up girls, and RIT-Z toilet seats.

II. TRADEMARK PROTECTION WITHOUT TRADEMARK RIGHTS OR CONSUMER CONFUSION

It's a veritable brainteaser: trademark-esque protection without trademark rights or the traditional requirement of consumer confusion. Under Section 2(a), the Lanham Act protects people and institutions from another party's registration of a trademark that falsely suggests a connection with them, *whether or not they have used the material in the mark as a trademark or even used it at all.* Registration of a mark that exploits their name, nickname, identity, portrait, symbol, or signature could be barred if it evokes that person or institution, *whether or not consumers are likely to be confused* as to source or sponsorship.

A. No Trademark Rights Needed

No trademark rights are needed to support a claim of false suggestion of a connection.[6] As the United States Patent and

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4 Under 15 U.S.C. § 1064, a petition to cancel a registration pursuant to Section 2(d) may be filed "[w]ithin five years from the date of the registration of the mark."

5 Christopher A. Mull, Note, *Public Interest over Private Prejudice?: The Public Interest Exception to the Defense of Laches and the Fourth Circuit's Clean Slate*, 81 Brook. L. Rev. 1717, 1728 (2016) ("This procedural quirk is called a backdoor because challengers can base a petition to cancel on a 2(a) claim without having to worry about a mark's incontestability (i.e., one may not challenge the likelihood of confusion of a mark registered for over five years).").

6 *See, e.g.*, University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 703 F.2d 1372, 1375 (Fed. Cir. 1983) ("[T]he drafters [of 15 U.S.C. § 1052(a)] were concerned with protecting the name of an individual or institution which was not a technical 'trademark' or 'trade name' upon which an objection could be made under § 2(d)."); Boston Ath. Ass'n v. Velocity, LLC, 117 U.S.P.Q.2d 1492, 1495 n.10 (T.T.A.B. 2015) (holding that "an opposer may prevail on the false suggestion of a connection ground 'even if the name claimed to be appropriated was never commercially exploited by the opposer as a trademark or in a manner analogous to trademark use'") (citation omitted); *In re* Pedersen, 109 U.S.P.Q.2d 1185, 1194 (T.T.A.B. 2013) (unnecessary for examining attorney to show that a party claiming false suggestion of a connection has the power to authorize the use of the institution's name as a trademark); *In re* White, 73 U.S.P.Q.2d 1713, 1718 (T.T.A.B. 2004) ("Section 2(a) was intended by its drafters to preclude registration of a mark which conflicts with another's rights, even if such rights were not

Trademark Office's ("USPTO") Trademark Trial and Appeal Board ("TTAB" or "Board") has noted, "it is possible for a plaintiff to prevail under Section 2(a) even if the name claimed to be appropriated has never been commercially exploited as a trademark by the plaintiff."[7] Thus, someone can challenge an application or registration without having made any use in commerce of their name or identity as a source indicator. There doesn't even need to be "use analogous" to trademark use.[8] In fact, so long as the material sufficiently evokes an identity or persona, the offending trademark doesn't need to include a name, likeness, or nickname the plaintiff has actually used.[9] On the flip side, asserting trademark rights does not mean a win in a false suggestion of a connection case because use of a mark is not necessarily the equivalent of an assertion of rights in a persona or identity.[10]

Of course, in the United States, trademark law protection without use in commerce is typically unavailable. Two well-known commentators call it a "jurisprudential paradox" and note the "conventional view (under US practice, at least): . . . no trade, no trademark."[11] In general, in order for a trademark owner to enforce its mark in the United States under the Lanham Act, it must make actual use of its mark on products or for services in the United States.[12] This goes for U.S. as well as foreign entities.

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technical trademark or trade name rights that could be the basis for a Section 2(d) claim.").

7 Board of Trustees of Univ. of Ala. v. BAMA-Werke Curt Baumann, 231 U.S.P.Q. 408, 410 (T.T.A.B. 1986).

8 "Use analogous" to trademark use—display of a mark in advertising or promotion, say—may give priority rights under certain circumstances if it leads the public to identify the designation with the mark owner. *See* Anne Gilson LaLonde, Gilson on Trademarks (hereinafter "Gilson on Trademarks") § 3.04[4].

9 *See infra* Part V.B. This article will use both "claimant" and "plaintiff" to refer to the entity asserting a false suggestion of a connection with its identity. Examining attorneys also serve as claimants on behalf of those entities in TTAB proceedings when defending refusals issued by the USPTO.

10 *See In re* McGroder, 2001 TTAB LEXIS 256, at *9-10 (T.T.A.B. 2001) (not citable as precedent) ("Although it is common knowledge that PONTIAC is a brand name for an automobile which has been around for many years, and that American consumers are likely to know about this brand, we cannot conclude based on this record that this trademark functions as the persona of registrant. That is to say, there is nothing in the record to demonstrate that PONTIAC is a persona of General Motors Corporation.").

11 Martin B. Schwimmer & John L. Welch, *US law inches towards protecting trademark reputation without use*, 81 World Trademark Rev. 78, 78 (Oct./Nov. 2019).

12 A minority view holds that trademarks *can* be protected in the United States without use. To the surprise of many, the Fourth Circuit held that a plaintiff need not "possess or have used a trademark in U.S. commerce as an element of the cause of action" of a trademark infringement claim under Section 43(a). Belmora LLC v. Bayer Consumer Care AG, 819 F.3d 697, 706 (4th Cir. 2016). The Ninth Circuit held that when foreign use of a mark brings it fame in the United States, that user may have priority there without use in the United States. Grupo Gigante S.A. de C.V. v. Dallo & Co., 391 F.3d 1088, 1093 (9th Cir. 2004) ("We hold . . . that there is a famous mark exception to the territoriality principle."). But those views have not been followed elsewhere. *See*, *e.g.*,

Despite the consternation in the U.S. trademark community about protecting marks not used in the United States, the false suggestion of a connection section of the Lanham Act may, in fact, protect material in the United States that might not be used there.[13] In one case before the TTAB, the respondent, Intermix S.A., owned a U.S. registration for PEMEX for various goods and services, including fuel and oil refining.[14] In its petition to cancel Intermix S.A.'s registration, Petroleos Mexicanos alleged that it had used the PEMEX mark in Mexico for decades for identical goods and services, basing the petition in part on the ground that the mark made a false suggestion of a connection. In response, Intermix S.A. moved to dismiss the proceeding for lack of standing on the ground that Petroleos Mexicanos had never made trademark use in the United States nor did it plead any protectable trademark rights that were cognizable there.

Assuming those allegations were true and Petroleos Mexicanos had not, in fact, used its mark in the United States, the TTAB still denied the respondent's motion to dismiss. It held that a petitioner "is not required to allege proprietary rights in its name for standing purposes" where it makes a false suggestion of a connection claim.[15] Petroleos Mexicanos had standing to petition for cancellation because it had "a personal interest in the outcome of this proceeding beyond that of the general public"[16] and it had sufficiently pleaded a claim under Section 2(a).[17] The TTAB did not rely on a well-known marks analysis.

The TTAB found false suggestion protection in another case without use. There, fashion model Twiggy was found to have abandoned trademark rights in her name in the United States for a period of several years, allowing the respondent to have priority.[18] This abandonment doomed her likelihood of confusion and dilution claims, but she succeeded with her claim of false suggestion of a

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ITC Ltd. v. Punchgini, Inc., 482 F.3d 135, 165 (2d Cir. 2007). Nor has the USPTO consistently adopted the doctrine of protecting marks that are well known outside the U.S. but not used there. See Gilson on Trademarks, *supra* note 8, § 3.02 for more on the use in commerce requirement in the U.S.

13 Petroleos Mexicanos v. Intermix S.A., 97 U.S.P.Q.2d 1403 (T.T.A.B. 2010).

14 *Id.*

15 *Id.* at 1405 (citing Estate of Biro v. Bic Corp., 18 U.S.P.Q.2d 1382, 1385 (T.T.A.B. 1991)).

16 *Id.* at 1406 (citing Ritchie v. Simpson, 170 F.3d 1092 (Fed. Cir. 1999)).

17 *Id.* ("In particular, petitioner specifically pleaded that it is the actual institution with which consumers will presume a false suggestion of a connection when confronted with respondent's identical PEMEX mark, and which is allegedly implicated by that false suggestion."). The registration for PEMEX (U.S. Reg. No. 368366) was ultimately cancelled in the TTAB proceeding (Canc. No. 92052292) when the petitioner's motion for discovery sanctions in that proceeding was granted as conceded.

18 Hornby v. TJX Companies Inc., 87 U.S.P.Q.2d 1411 (T.T.A.B. 2008).

connection.[19] Noting that Twiggy did not need to own a "technical trademark" in her name in order to succeed, the TTAB found that her continued renown in the United States at the time the respondent's registration issued enabled her to claim that the respondent's mark would create a false suggestion of a connection.[20] She succeeded, then, in spite of having abandoned her traditional trademark rights.

But without trademark rights, the claimant must have *some* basis on which to allege an interest in a name or other material that constitutes its "identity." As the TTAB has stated: "While a party's interest in its identity does not depend for its existence on the adoption of and use of a technical trademark, a party must nevertheless have a protectible interest in a name (or its equivalent)."[21]

Similar provisions in the Lanham Act also protect personal rights that are not source-identifying in the trademark sense. Section 2(c) refuses registration to trademarks that include "a name, portrait, or signature identifying a particular living individual" without the written consent of that individual.[22] The same section extends protection to the name, portrait, or signature of a deceased president of the United States through the life of his widow.[23] In addition, Section 43(a) supports a claim of false endorsement, when a defendant uses a name or likeness in a way that is likely to confuse consumers into believing that the entity sponsors or approves of the defendant's goods or services.[24] Plaintiffs in false endorsement cases, who are typically celebrities,

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19 *Id.* at 1422.

20 *Id.* at 1424-27 (citing the "technical trademark" concept articulated in University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc., 703 F.2d 1372, 1375 (Fed. Cir. 1983)).

21 NASA v. Bully Hill Vineyards, Inc., 3 U.S.P.Q.2d 1671, 1676 (T.T.A.B. 1987). *See also* Board of Trustees of Univ. of Ala. v. Pitts, 107 U.S.P.Q.2d 2001, 2026 (T.T.A.B. 2013) (noting that "there clearly must be some public use or promotion of the asserted identity in a manner that provides a means of identifying the plaintiff"), *vacated due to settlement*, Opp. No. 91187103 (T.T.A.B. 2016) (not citable as precedent).

22 15 U.S.C. § 1052(c); Trademark Manual of Examining Procedure (hereinafter "TMEP") (8th ed. October 2018) §§ 813, 1206. For Section 2(c), a name in a mark identifies a particular living individual if that person will be associated with the mark as used on the goods or services because "the person is so well known that the public would reasonably assume a connection between the person and the goods or services" or the person is publicly connected with the industry in which the mark is used. *In re* Nieves & Nieves LLC, 113 U.S.P.Q.2d 1639, 1650 (T.T.A.B. 2015) (hereinafter "*Nieves II*"). *See generally* Gilson on Trademarks, *supra* note 8, § 3.08[3][c]. For a discussion of federal registration of personal names, see *id.* at § 2.03[4][d].

23 15 U.S.C. § 1052(c); TMEP § 1206.04. Add "his widow" to the list of potential amendments to the Lanham Act in the 21st Century.

24 See Gilson on Trademarks, *supra* note 8, § 2B.03[2][a] and § 7.02[5][c], for further discussion of Lanham Act false endorsement claims.

generally challenge advertisements rather than trademark registrations.

B. Likely Consumer Confusion Not Needed

Trademark owners filing a Section 2(d) action, claiming that a mark in an application or registration is likely to be confused with their own mark, often assert a false suggestion of a connection claim as well. But the standards for confusion and suggestion of a connection differ in important ways.

Likelihood of consumer source or sponsorship confusion is *not* an element of a false suggestion of a connection claim.[25] In order to show a false suggestion of a connection, a juristic entity "must allege, and prove, a connection with it as an organization and not merely the use of confusingly similar marks."[26] Pleading source confusion when alleging a false suggestion of a connection is, in sum, unnecessary.[27]

Of course, there is evident overlap between a false suggestion and a 2(d) likelihood of confusion claim. Confused consumers in infringement or 2(d) cases certainly see a false connection *of sorts* between two similar marks on the same or related goods. And success in a claim of false suggestion of a connection requires that consumers presume a connection between the claimant and the trademark owner that is not there.[28] Thus, the defendant's trademark must be similar enough to the claimant's identity to trigger a connection between the two.[29]

So . . . how is false suggestion of a connection different from likelihood of confusion?

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25 *See, e.g.*, Kelman v. Hardin, 2017 TTAB LEXIS 120, at *5 (T.T.A.B. 2017) (not citable as precedent) ("Opposer's allegation that Applicant's use of her mark 'is likely to falsely suggest a relationship between Applicant's product and Opposer's products' is legally insufficient to support a false suggestion of a connection claim under Section 2(a)."); Societe Nationale des Chemins de Fer Francais v. Hoffman, 2009 TTAB LEXIS 241, at *9-10 (T.T.A.B. 2009) (not citable as precedent) (finding that claims of likelihood of confusion did not put applicant on notice that opposers were pursuing false suggestion of a connection claim); TMEP § 1203.03 ("Section 2(a) is distinctly different from §2(d) . . . for which the relevant test is likelihood of confusion.").

26 McDonnell Douglas Corp. v. Nat'l Data Corp., 228 U.S.P.Q. 45, 48 (T.T.A.B. 1985).

27 University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 703 F.2d 1372, 1376 (Fed. Cir. 1983) (holding that Section 2(a) false suggestion of a connection claim is not predicated on likelihood of confusion); TMEP § 1203.03(c)(i) (listing elements of a false suggestion of a connection refusal, which do not include likelihood of confusion). For comparison, pleading a claim of trademark infringement requires the plaintiff to show that its mark is valid and protectable and the defendant's use of its own mark in commerce is likely to confuse consumers as to source or sponsorship. *See, e.g.*, OTR Wheel Eng'g, Inc. v. West Worldwide Servs., 897 F.3d 1008, 1022 (9th Cir. 2018); Streamline Prod. Sys. v. Streamline Mfg., 851 F.3d 440, 450 (5th Cir. 2017).

28 See *infra* Part VII.B for more on the type of association needed.

29 See *infra* Part V.C for more on the requirement of a "close approximation."

It's admittedly a fine line, but it's tangible. In a false suggestion of a connection case, the relevant consumer might not think that the two entities are in business together or have any relationship. Instead, they may assume that the trademark owner is just using the other party's identity to get attention in a crowded marketplace, express appreciation or wave the flag of fandom for the entity, evoke a certain level of quality depending on the entity's reputation, or simply make a humorous allusion.

In contrast, the likelihood of confusion provisions in the Lanham Act focus on whether a mark causes confusion, causes mistake, or deceives as to source, sponsorship, or affiliation.[30] But for a false suggestion of a connection, the consumer need not be deceived at all. Rather, the consumer may understand that the mark *refers to* the entity, that the material *brings to mind* the entity, but without any commercial relationship between the entity and the trademark owner.[31]

Let's consider an example:[32]

An examining attorney with the USPTO refused registration of an application for the above mark for "utility knives" on the false suggestion of a connection ground, as well as the ground that the mark identifies a living individual without his consent.[33] The

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30 15 U.S.C. § 1052(d) (blocks subsequent registrations where the mark resembles another mark so "as to be likely, when used on or in connection with the goods of the applicant, *to cause confusion, or to cause mistake, or to deceive*") (emphasis added); 15 U.S.C. § 1114(1)(a) (makes an entity liable for using a mark where such use "is likely *to cause confusion, or to cause mistake, or to deceive*") (emphasis added); 15 U.S.C. § 1125(a)(1)(A) (provides liability for use of a mark that is "*likely . . . to deceive as to the affiliation, connection, or association* of such person with another person") (emphasis added).

31 Note that federal dilution law in the U.S. also doesn't require confusion and involves bringing to mind a famous mark combined with likely blurring or tarnishment. More on that in a later section describing what type of "association" is relevant to a claim of false suggestion of a connection. *See infra* Part VII.B.

32 U.S. Ser. No. 87545258. The mark appears in red and blue on a white background in the application.

33 *See also* U.S. Ser. No. 87241266 (HE WAS NOT MY #1 BUT HE IS OUR #45 for hats and t-shirts rejected for false suggestion of a connection, abandoned); U.S. Ser. No.

applicant appealed, and in response to the false suggestion of a connection refusal, it proclaimed in its brief:

> [C]onsumers will understand that "Making America Great" by analogy to "Making Package Opening Great" is a pun and play of words and a desire by the applicant to associate with President Donald J. Trump's theme of "Making American [sic] Great Again" to "making packing [sic] opening great." . . . This applied for mark is word-play and image-play and here the applicant having the best package openers on the market desires to sell for both amusement, political expression, and utility. . . . This cute, creative, and clever logo implies and shows a play on words and play on images between President Donald J. Trump and the analogy of Trump's high quality to also the high quality of the applicant's package opener sold under the applied for mark.[34]

Whether or not one agrees with the applicant's opinion of Donald Trump, this mark may not actually deceive or mislead consumers into believing that Donald Trump has entered into a licensing agreement with the applicant. It is true that Donald Trump promotes the TRUMP brand in a wide variety of ways. It's not impossible that he would let a utility knife manufacturer license it. Nonetheless, the mark's exaggerated treatment of President Trump's name, hairstyle, and political motto may militate against a finding of likely consumer confusion. Even so, likely confusion is not a requirement for a finding of a false suggestion of a connection.

The TTAB went on to find, in a 2020 opinion, that the applicant's mark had, in fact, falsely suggested a connection between his goods and Donald Trump.[35] In a rare precedential (and presidential) opinion, the TTAB found that the mark closely approximated Donald Trump's persona, it pointed uniquely and unmistakably to Donald Trump, and consumers would presume a connection with Donald Trump because of his fame.[36] To satisfy the "false" element of false suggestion of a connection, the TTAB also found that there was no connection between the applicant's utility knives and President Trump.[37]

87413097 (TRUMP 45 for firearms, same outcome); U.S. Ser. No. 87335573 (TRUMPMOJI for downloadable computer game programs, same outcome). Most refusals of TRUMP-related marks, however, are solely on the ground that they name a particular living individual without his consent in violation of 15 U.S.C. § 1052(c).

34 *In re* ADCO Indus.-Techs., LP, Supplemental Brief (filed in the TTAB on October 3, 2018, in Appeal No. 87545258).

35 *In re* ADCO Indus.-Techs., L.P., 2020 U.S.P.Q.2d 53786, at *20 (T.T.A.B. 2020).

36 *Id.*

37 *Id.*

Given that likely confusion is not an element of this claim, however, the TRUMP-IT opinion veered uncomfortably close to suggesting that it was a significant consideration. When asking whether the marks as used pointed "uniquely and unmistakably" to Donald Trump, the TTAB concluded that consumers will believe that the applicant's utility knives are "just one more product for which Donald Trump has licensed the use of his name." In other words, they will believe the goods to be officially licensed and be confused as to their source or sponsorship, a different question than whether the marks point directly to the president. The TTAB also cited three opinions from its reviewing court for the proposition that consumers are more likely to be confused by a junior use if the senior user sells a wide variety of goods under its mark.[38] Finally, the TTAB stated directly that the false suggestion of a connection provision not only recognizes private rights but also "protects the public by targeting marks that may mislead the public into thinking that the source of the marks is connected with a particular person."[39]

In fact, protection of the public is not the purpose of the Section 2(a) false suggestion provision. Rather, the provision is designed to protect entities and people, such as President Trump, from unauthorized commercial exploitation of their names and identities. While avoiding consumer confusion may be a sometime consequence of the provision's protection of privacy and publicity rights, indicating that the provision protects the public by targeting potentially confusing marks is unhelpful. While likelihood of confusion is not incompatible with a false suggestion of a connection, the unwarranted emphasis by the TTAB in this case muddies the key distinction between source confusion and connection. The public need not be misled into thinking that the source of the applicant's utility knives is President Trump or that he has licensed them in order for the USPTO to refuse registration on the false suggestion of a connection ground.

III. PUBLICITY AND PRIVACY RIGHTS, NOT LIKELIHOOD OF CONFUSION

A Section 2(a) claim of false suggestion of a connection "is not a surrogate claim to a claim under Section 2(d) for likelihood of confusion."[40] Rather, the interwoven rights of publicity and privacy

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38 Philip Morris, Inc. v. K2 Corp., 555 F.2d 815, 816 (C.C.P.A. 1977); *In re* E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973); Owens-Illinois Glass Co. v. Clevite Corp., 324 F.2d 1010, 1011 (C.C.P.A. 1963).

39 *In re ADCO Indus.-Techs., L.P.*, 2020 U.S.P.Q.2d 53786, at *28.

40 LeMans Corp. v. LeMar Xavier Lewis, 2016 TTAB LEXIS 617, *6 n.10 (T.T.A.B. 2016) (not citable as precedent). *See also, e.g.*, Embarcadero Techs., Inc. v. Delphix Corp., 117 U.S.P.Q.2d 1518, 1523 (T.T.A.B. 2016) ("The claim of false suggestion of a connection is not a variation on a likelihood of confusion claim."); AAI Motorsports Co. v. Express Auto

are at the fore of a Section 2(a) claim. But that has not always been the case.

A. Evolution of Today's Standard

In cases decided before 1983, the Federal Circuit's predecessor court assumed that false suggestion of a connection in Section 2(a) was essentially the same claim as likelihood of confusion in Section 2(d).[41] Relying on that interpretation, the USPTO long required a false suggestion of connection claimant to establish (1) superior trademark rights, (2) likelihood of confusion, *and* (3) intent to trade on goodwill.[42] Essentially likelihood of confusion *plus*—a difficult standard to meet.

Then came the 1983 *Notre Dame* opinion from the Federal Circuit.[43] The University of Notre Dame filed an opposition proceeding against an importer over the use of the following mark for cheese:

Options, Inc., 2006 TTAB LEXIS 456, *6 (T.T.A.B. 2006) (not citable as precedent) ("A Section 2(a) false suggestion of a connection claim is not merely an alternative likelihood of confusion claim."); Miller Brewing Co. v. Anheuser Busch Inc., 27 U.S.P.Q.2d 1711, 1713 (T.T.A.B. 1993) ("When a plaintiff's allegation is that consumers are 'deceived into' buying defendant's goods under the mistaken belief that they originate from the same source as plaintiff's, or vice versa, the sort of deception at issue is the basis for a Section 2(d), not a Section 2(a), claim.").

41 Frederick Gash, Inc. v. Mayo Clinic & Mayo Found., 461 F.2d 1395, 1397 (C.C.P.A. 1972); Morehouse Mfg. Corp. v. J. Strickland & Co., 407 F.2d 881, 888-89 (C.C.P.A. 1969) (stating that, in order for there to be a false suggestion of a connection between the registrant's mark and the petitioner, "there would have to exist, at the very least, the same likelihood of confusion . . . under section 2(d). . . . We can therefore discuss these two questions together."). *See also* Lucien Picard Watch Corp. v. Since 1868 Crescent Corp., 314 F. Supp. 329, 331 (S.D.N.Y. 1970) (rejecting Section 2(a) claim and reasoning that use of the mark DaVINCI for jewelry and giftware "is scarcely likely to mislead any substantial number of purchasers into believing that Leonardo DaVinci was in any way responsible for the design or production of the goods").

42 *See* Paula T. Hairston, *Pleading and Proving a Claim of False Suggestion of a Connection with Persons and Institutions*, 82 TMR 253, 254 (1992) ("[D]ecisions of the Board before *Notre Dame* generally required that a plaintiff asserting a claim of false suggestion of a connection not only establish rights in the mark superior to those of the defendant, and the existence of a Section 2(d) likelihood of confusion, but an intent, implied or actual, on the part of defendant to trade on the good will possessed by the plaintiff in the mark.").

43 University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 703 F.2d 1372, 1375 (Fed. Cir. 1983).

The TTAB found the mark registrable, rejecting the University's claims of likelihood of confusion under Section 2(d) and false suggestion of a connection under Section 2(a). The Federal Circuit affirmed, holding on the Section 2(a) claim that cheese packaged with a sketch of the Notre Dame Cathedral in Paris did not create a false suggestion of a connection with the University.[44]

In assessing the false suggestion of a connection claim, the Federal Circuit noted earlier case law in which it had held that, for a successful false suggestion claim, "there would have to exist, at the very least, the same likelihood of confusion with appellant's . . . marks . . . under § 2(d)."[45] Instead of reflexively relying on this precedent, it laudably took a step back "to consider the statute as a whole and the interrelationship of its various provisions."[46]

The language of the Lanham Act, the court pointed out, treats Section 2(a) and Section 2(d) differently in an important respect: A petition to cancel a registration based on Section 2(d) is only allowed in the five-year period following registration, while a petition based on Section 2(a) may be filed "at any time."[47] As the court reasoned in *Notre Dame*, "Clearly the same standard cannot be adopted for § 2(a) as for § 2(d). To do so would nullify the deliberate omission of § 2(d) from § 14."[48]

The Federal Circuit went on to point to legislative history indicating that "§ 2(a) was intended to preclude registration of a mark which conflicted with another's rights, even though not founded on the familiar test of likelihood of confusion."[49] If not

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44 *Id.* at 1377. It also agreed there was no likelihood of confusion, given the difference in goods and services between the parties. *Id.* at 1374.

45 *Id.* at 1375 (*quoting Morehouse Mfg.*, 407 F.2d at 888-89).

46 *Id.* at 1376.

47 15 U.S.C. § 1064.

48 *University of Notre Dame*, 703 F.2d at 1376. Section 14 lays out the different time frames for making certain substantive claims to cancel a registration. 15 U.S.C. § 1064.

49 *University of Notre Dame*, 703 F.2d at 1376. *See also In re* Hsieh, 2008 TTAB LEXIS 186, *4 n.4 (T.T.A.B. 2008) (not citable as precedent) ("Applicant's assertion, . . . that

protection from consumer confusion, what other right was the section intended to protect? "Although not articulated as such," said the court, "it appears that the drafters sought by § 2(a) to embrace concepts of the right to privacy, an area of the law then in an embryonic state."[50] In other words, "a right to control the use of one's identity."[51] The court emphasized that "the elements of a claim of invasion of one's privacy have emerged as distinctly different from those of trademark or trade name infringement. There may be no likelihood of such confusion as to the source of goods even under a theory of 'sponsorship' or 'endorsement,' and, nevertheless, one's right of privacy, or the related right of publicity, may be violated."[52]

The "initial and critical requirement" for protecting that right from a third party's false suggestion of a connection, according to the court in *Notre Dame*, "is that the name (or an equivalent thereof) claimed to be appropriated by another must be unmistakably associated with a particular personality or 'persona.'" Thus, to establish that the mark refers to its persona, the claimant has to show that the mark "point[s] uniquely" to it, not that there is merely some possibility of identification with the claimant or that the name is famous.[53]

In that case, the words "NOTRE DAME" were not solely associated with the University, meaning that the term did not point uniquely to it. Besides being identified with the University, the term also identifies a well-known religious figure and is used in the names of many churches. In fact, the Cathedral of Notre Dame in Paris is depicted in the mark itself. The court also found that consumers would not be likely to presume a connection between the University and the applicant's cheese. The mark was registered.[54]

The TTAB acknowledged the Federal Circuit's evolution of the standard in one of its own cases, stating firmly in 1985 that likelihood of confusion was *not* necessary to prevail with a false suggestion of a connection claim.[55] There, the TTAB found that a singer could block a third party's registration for a mark that consisted of the title of his signature song, even where he had not

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likelihood of confusion is a condition precedent to finding a false suggestion of a connection, was rejected by the Federal Circuit in *University of Notre Dame* . . . .").

50 *University of Notre Dame*, 703 F.2d at 1376. Section 2(a) includes other bars on registration that do not relate to source confusion, such as the former bars on scandalous and disparaging marks, but this reference in *Notre Dame* to a right of privacy seems limited to the false suggestion of a connection bar. 15 U.S.C. § 1052(a).

51 *University of Notre Dame*, 703 F.2d at 1376.

52 *Id.*

53 *Id.* at 1377.

54 The registration at issue (U.S. Reg. No. 1265154), was cancelled May 21, 1990, for failure to file an acceptable declaration under Section 8.

55 Buffett v. Chi-Chi's, Inc., 226 U.S.P.Q. 428, 429 (T.T.A.B. 1985).

used that title as a source indicator and even where consumers would not think he licensed or endorsed the third party's use.[56]

In 1982, restaurant chain Chi-Chi's, Inc. applied to register the following mark for restaurant services:

Margaritaville

Singer Jimmy Buffett opposed the application, claiming a false suggestion of a connection based on his well-known song of that name from 1977 celebrating the effects of the frozen alcoholic concoction. Buffett had not used MARGARITAVILLE as a trademark, but nonetheless succeeded in convincing the TTAB to deny the applicant's motion for summary judgment on the false suggestion of a connection claim.[57] The TTAB declared that, "though there may be no likelihood of confusion as to the source of the goods, even under a theory of sponsorship or endorsement, nevertheless an opposer's right to control the use of its identity may be violated."[58] It soberly and emphatically recognized that the elements of a false suggestion of a connection claim "have emerged as distinctly different from the elements of a claim of trademark or trade name infringement."[59]

B. Rights of Publicity and Privacy

We recognize today that the provision is intended to protect individuals and institutions from being exploited commercially without authorization.[60] The protections found in the false

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[56] *Id. See also* Mark Traphagen & Robert D. Litowitz, *The Song Remains the Same – But Not Necessarily the Name*, 39 Am. U.L. Rev. 975, 995 (1990) ("The trademark, publicity, and service mark rights potentially available to performers in musical groups are not merely limited to their names and likenesses. Protection may even extend to the title of a song that a performer has popularized and by which he or she is uniquely identified. For example, in *Buffett v. Chi-Chi's, Inc.,* the Trademark Trial and Appeal Board recognized that a musician may enjoy rights analogous to trademark rights in a popular song title.").

[57] The opposition was withdrawn in 1988 and the registration was eventually assigned to Jimmy Buffett in 2004 when Chi-Chi's declared bankruptcy in the United States. The registration (U.S. Reg. No. 1530199) was cancelled in 2010 for failure to file a Section 8 declaration of use.

[58] *Buffett*, 226 U.S.P.Q. at 429.

[59] *Id.*

[60] Bridgestone/Firestone Research Inc. v. Auto. Club de l'Ouest de la France, 245 F.3d 1359, 1363 (Fed. Cir. 2001) ("[T]he rights protected under the § 2(a) false suggestion provision are not designed primarily to protect the public, but to protect persons and institutions from exploitation of their persona.").

suggestion of a connection provision of Section 2(a) are an amalgam of the right of publicity and the related right to privacy.[61]

The right of publicity is a person's right to control the commercial use of his or her name, nickname, likeness, voice, or other personal characteristic.[62] It is a construct of state law, in some states through common law and in others by statute.[63] Although the modern legal view is that every person, even a non-celebrity, has a right of publicity in their name, image, likeness, and other indicia of identity, with respect to celebrity, one has to recognize that celebrities have generally invested time, work, and money to generate their fame, resulting in a property right in their own renown. Thus, it would be unjust enrichment for an unauthorized third party to profit from this fame.[64] A celebrity could also suffer a harm similar to dilution by blurring if the market is flooded with his or her image on any number of products, rendering that image less valuable even without source confusion.[65] Generally, state-based laws recognize a right of *privacy* that is similar to the right of publicity, protecting those who have been harmed from unwanted use of their name or likeness, including those who are not public figures or celebrities.[66]

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61 *See, e.g.*, *University of Notre Dame*, 703 F.2d at 1376 ("[I]t appears that the drafters sought by § 2(a) to embrace concepts of the right to privacy."); Creel Abogados, S.C. v. Creel, García-Cuéllar, Aiza y Enríquez, S.C., 2015 TTAB LEXIS 217, at *10 (T.T.A.B. 2015) (not citable as precedent) ("The rationale for the statutory prohibition is that the person identified in the mark loses the right to control her identity.").

62 For further analysis of the right of publicity, see Gilson on Trademarks, *supra* note 8, § 2B.01. The different types of symbols a celebrity can protect are discussed at *id.* § 2B.02. *See generally* Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562 (1977).

63 *See* Gilson on Trademarks, *supra* note 8, § 2B.03[1]. Professor Jennifer Rothman's Roadmap to the Right of Publicity is an excellent resource in this area. *See* https://www.rightofpublicityroadmap.com/.

64 *E.g.*, Hart v. Electronic Arts, Inc., 717 F.3d 141, 151 (3d Cir. 2013) ("[T]he goal of maintaining a right of publicity is to protect the property interest that an individual gains and enjoys in his identity through his labor and effort."); *Nieves II*, 113 U.S.P.Q.2d at 1644 ("The right of publicity has developed to protect the commercial interest of celebrities in their identities. Under this right, the celebrity has an interest that may be protected from the unauthorized commercial exploitation of that identity. If the celebrity's identity is commercially exploited without the consent of the celebrity, there has been an invasion of his/her right, regardless of whether his/her 'name or likeness' is used."); Lee B. Burgunder, *Can the PTO Find Its Way With Jesus?*, 19 Marq. Intell. Prop. L. Rev. 63, 68 n.9 (2015) ("The basic purpose of publicity rights is to protect the economic interests that famous individuals create through their personal achievements. Thus, the right is intended to prevent members of the public from obtaining unjust enrichment by appropriating the commercial value of a person's identity.") (citations omitted).

65 See Gilson on Trademarks, *supra* note 8, § 5A.01[5] for a discussion of dilution by blurring. See *infra* Part VII.B for a discussion of the difference between dilution and false suggestion of a connection.

66 *See* Gilson on Trademarks, *supra* note 8, § 2B.07. For an in-depth treatment of the historical scope of the rights of publicity and privacy and how they differ, see Jennifer E. Rothman, *The Right of Publicity's Intellectual Property Turn*, 42 Colum. J.L. & Arts 278 (2019).

The Federal Circuit has said that the false suggestion of a connection provision was "designed primarily . . . to protect persons and institutions from exploitation of their persona."[67] The TTAB went even further, holding that a prior court ruling finding a violation of talk show host Johnny Carson's right of publicity was *legally equivalent* to a ruling on his claim of false suggestion of connection for res judicata purposes: "A claim of false suggestion of a connection under Section 2(a) of the Trademark Act is merely a codification of a claim of violation of the right of publicity."[68] Because the false suggestion of a connection provision is so intertwined with the common law doctrine of right of publicity, case law on right of publicity is quite relevant in false suggestion cases.

In sum, the claim in Section 2(a) is in essence a federal right of publicity. It is, however, both broader and more limited than the parallel state right. Corporations are typically not covered by state statutes and common law publicity doctrines, so in that way the Section 2(a) claim is broader than state law rights of publicity. The false suggestion of a connection refusal has barred registration where a mark suggested a connection to such entities as the U.S. Postal Service, Indian tribes, and the Swiss armed forces.[69] Still, even these juristic entities must possess a certain amount of "fame or reputation" akin to celebrity.[70] And, of course, the Lanham Act claim has one serious limitation compared with state publicity rights: Section 2(a) is limited to barring *registration* of offending marks and does not prevent their use.[71]

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67 *Bridgestone/Firestone Research*, 245 F.3d at 1363. *See, e.g.*, William McGeveran, *Trademark Law Institute for Intellectual Property & Information Law Symposium: Selfmarks*, 56 Hous. L. Rev. 333, 357 (2018) ("The Federal Circuit has concluded that the drafters of the Lanham Act intended with this section for the trademark registration process to mirror still nascent privacy rights against appropriation.").

68 John W. Carson Found. v. Toilets.com, Inc., 94 U.S.P.Q.2d 1942, 1947 (T.T.A.B. 2010), *following* Carson v. Here's Johnny Portable Toilets, Inc., 810 F.2d 104 (6th Cir. 1987) *and* Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983). Those cases barred the unauthorized use of Carson's famous introduction, "Here's Johnny," as a name for portable toilets on the ground that it violated Carson's right of publicity.

69 See *infra* Part V.A for more on which entities are covered by the false suggestion of a connection claim.

70 See *infra* Part VII.A for more on "fame or reputation."

71 *See, e.g.*, Sari Sharoni, *The Mark of a Culture: The Efficacy and Propriety of Using Trademark Law to Deter Cultural Appropriation*, 26 Fed. Cir. B.J. 407, 442 (2016-17) (Communities concerned with cultural appropriation "have come to view cancellation proceedings under Lanham Act section 2(a) as a tool to prevent individuals and organizations . . . who appropriate stereotypes or cultural symbols from source communities, from using marks that . . . falsely suggest a connection to the source community. In practice, however, cancellation proceedings do not prevent appropriators from using . . . falsely-connecting marks in commerce: removal from the register merely relegates the mark to common law protection. . . .") (footnote omitted).

C. Private Right, Not Public Interest

As we have seen, the prohibition on registering trademarks that create a false suggestion of a connection is not meant to protect consumers or competitors from a likelihood of consumer confusion. What it does is protect private individuals and entities from unwanted commercial exploitation.[72] The USPTO's Trademark Manual of Examining Procedure ("TMEP") provides: "Section 2(a) protection is intended to prevent the unauthorized use of the persona of a person or institution and not to protect the public."[73] And, as described below, the equitable defenses of laches and unclean hands are available in cases of false suggestion of a connection because the claims are private and not of public interest.[74]

Certainly, in the sense that any inaccurate imitation by a trademark goes against the public interest, false suggestion of a connection claims are in the public interest in a general sense. Nonetheless, the gravamen of the claim is protection of persons and institutions from unauthorized use of their names, likenesses, and personas.[75]

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72 *E.g.*, *In re* Pedersen, 109 U.S.P.Q.2d 1185, 1196 (T.T.A.B. 2013) ("The concern in § 2(a) cases involving a false suggestion of a connection, unlike cases under § 2(d) which are concerned with protection of the public from confusion, is protection of persons and institutions from unauthorized exploitation of their personas."); John L. Welch & John Carl Zwisler, *Not So Fast on MARATHON MONDAY: Trademark Board Rejects Boston Athletic Association's Bid to Prevent Clothier from Registering the Term*, 60 B.B.J. 4, 4 (2016) ("In contrast to Section 2(d), which is meant to prevent consumer confusion as to the source of goods or services, Section 2(a) is primarily intended to protect the person or institution from unauthorized use of its identity, independent of source confusion.").

73 TMEP § 1203.03.

74 See *infra* Part IV.D for more on these defenses and how they apply in false suggestion of a connection cases.

75 The TTAB, in its 2020 TRUMP-IT opinion, did declare that "protection of consumers is one of the bases of" the false suggestion of a connection provision. *In re* ADCO Indus.-Techs., 2020 U.S.P.Q.2d 53786, at *9 (T.T.A.B. 2020). The TTAB went on to say that the provision "protects the public by targeting marks that may mislead the public into thinking that the source of the marks is connected with a particular person" and "directly furthers the goal of prevention of consumer deception in source-identifiers." *Id.* at *28-29.

The TTAB made these statements in response to the applicant's argument that the false suggestion of a connection basis for refusal was invalid as an unwarranted restriction on free speech. In that context, it was positioning the provision as a means of preventing deception of the public. Such laws are much harder to invalidate under the First Amendment. Nevertheless, while these declarations may put up a blockade against First Amendment challenge, they are not well grounded in precedent, which makes clear that preventing consumer deception is not the goal of the false suggestion of a connection provision and that likely confusion is not an element of the claim. See *infra* Part IV.E for more on the First Amendment and the false suggestion of a connection claim.

IV. CURRENT FALSE SUGGESTION OF A CONNECTION STANDARD

With that background, we turn to the mechanics of a false suggestion of a connection claim.

A. The Standard Itself

To bar a trademark from registration based on Section 2(a)'s false suggestion provision, an opposer, cancellation petitioner, examining attorney, or plaintiff in litigation must make four showings, each treated more fully in later sections:[76]

- The applicant's mark must be "the same as or a close approximation of the name or identity of a particular person other than the applicant."
- The mark must point uniquely and unmistakably to the entity at issue.
- The person or institution must be so well known that, when the mark is used in conjunction with the applicant's goods or services, a connection would be presumed.
- The presumed connection must be false, meaning that the entity is not, in fact, connected with the goods or services.

This list is *not* a balancing test. The proponent must prove *each factor* to show a false suggestion of a connection.[77] And the burden to show false suggestion in an ex parte proceeding is on the examining attorney.[78]

The language of the statute refers to matter that "*may* . . . falsely suggest a connection."[79] According to the TTAB, that phrase does *not* mean matter that "*might possibly* falsely suggest a connection," one plausible interpretation of "may."[80] The TTAB has refused to read the relevant precedent "as endorsing the idea that the mere possibility of a perceived connection would give rise to a cause of

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76 TMEP § 1203.03(c)(i); Buffett v. Chi-Chi's, Inc., 226 U.S.P.Q. 428, 429 (T.T.A.B. 1985).

77 *E.g.*, Shirley Plantation, LLC v. Stillhouse Vineyards, LLC, 2018 TTAB LEXIS 483, at *89 (T.T.A.B. 2018) (not citable as precedent) (because "failure to prove any of these elements is fatal to [opposer's] claim," finding failure to establish first element doomed claim and negated need to reach the others); Terry v. Newman, 2013 TTAB LEXIS 372, at *2 (T.T.A.B. 2013) (not citable as precedent) ("The Board's four-factor test is not a balancing test whereby a successful showing of one factor may cancel out the failure to show one or more of the other factors. Rather, each of the four factors of the test is a required element . . . ."), *aff'd*, 556 Fed. Appx. 964 (Fed. Cir. 2014) (unpublished) (per curiam).

78 *E.g.*, *In re* Pedersen, 109 U.S.P.Q.2d 1185 (T.T.A.B. 2013); *In re* White, 73 U.S.P.Q.2d 1713 (T.T.A.B. 2014).

79 15 U.S.C. § 1052(a) (emphasis added).

80 *Terry*, 2013 TTAB LEXIS 206, at *11-12.

action."[81] Nor does the standard require a plaintiff "to demonstrate with 'certainty' that a false connection with Petitioner actually is perceived."[82]

B. The Role of Intent

Not included in the official list of factors but still seen as relevant: *intent*. A successful false suggestion claim does not require a showing that the applicant intended to establish a connection and exploit another entity's name. The TTAB has made clear that a plaintiff pleading a false suggestion of a connection need not allege that the defendant intended to trade on the plaintiff's goodwill.[83] Nonetheless, proof of such an intent is seen as evidence that the public would make a false connection.[84]

In the pivotal *Notre Dame* opinion described above, the Federal Circuit found that NOTRE DAME was not solely associated with opposer University of Notre Dame, as there were other possible references for that term.[85] Nonetheless, the court noted that it could have found otherwise if there had been evidence that the applicant "intended to identify the University."[86] It opined that the existence of such (hypothetical) evidence would be "highly persuasive that the public will make the intended false association," concluding that any "defense that the result intended was not achieved would be hollow indeed."[87] Fortunately for the applicant, there was no such evidence—in fact, the depiction of the *cathedral* in the mark rather than a reference to the *university* showed a lack of such intent—and the court refused to infer that there had been an effort to trade on the University's goodwill.

The TTAB did draw such an inference in later decisions when faced with different facts. In one, the applicant had used the name of a composer in its mark without authorization, included his image on its website, and planned to sell musical instruments under the mark.[88] The TTAB concluded, surely reasonably, that the applicant had intended to suggest a connection with the composer and found

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81 *Id.* at *13.

82 *Id.*

83 Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd., 228 U.S.P.Q. 752 (T.T.A.B. 1985).

84 *See* TMEP § 1203.03(c)(i) ("Intent to identify a party or trade on its goodwill is not a required element of a §2(a) claim of false suggestion of an association with such party. However, evidence of such an intent could be highly persuasive that the public would make the intended false association.") (citations omitted).

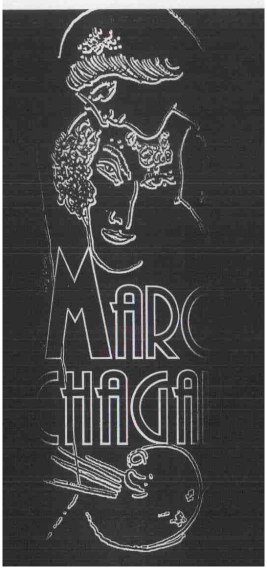
85 University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 703 F.2d 1372, 1377 (Fed. Cir. 1983).

86 *Id.*

87 *Id.*

88 *In re* Hsieh, 2008 TTAB LEXIS 186 (T.T.A.B. 2008).

a false suggestion of a connection.[89] In another, the TTAB took into account what it saw as the applicant's intent to associate his product with painter Marc Chagall by using MARC CHAGALL as a trademark for vodka.[90] The evidence before the TTAB of the painter's fame was substantial and the applicant did not show that the mark had any other significance beyond a connection with the painter.[91] In fact, the specimen of use contained what the TTAB said "appears to be a portrait of the painter" along with an artist's palette:



The TTAB observed: "Indeed, this is just the type of case where the respondent's intent is clear. . . . We infer from the evidence . . . that respondent regarded the name of Marc Chagall as one of significant reputation which would generate good will in the sale of respondent's vodka."[92]

Still, it was quite unnecessary to have invoked the applicant's intent in these cases. Take the MARC CHAGALL case. The applicant was plainly invoking famous artist Marc Chagall as he used the artist's name on his label. Presumably the applicant thought the name would help him sell vodka—that's why he used it. But neither one of those facts about the applicant's state of mind

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89 *Id.* at *9.

90 Association Pour La Defense et La Promotion de l'Oeuvre de Marc Chagall Dite Comite Marc Chagall v. Bondarchuk, 82 U.S.P.Q.2d 1838 (T.T.A.B. 2007). *See also In re* Sloppy Joe's Int'l, Inc., 43 U.S.P.Q.2d 1350, 1354 (T.T.A.B. 1997) (finding evidence of intent "highly persuasive").

91 *Association Pour La Defense*, 82 U.S.P.Q.2d at 1843.

92 *Id.*

makes it more or less likely that a consumer would associate the name on the label with the artist.[93]

Particularly where the mark does not use the exact name of the person or institution, *even an admission that the applicant intentionally referred to that entity* may not mandate a finding of a false suggestion of a connection.[94] The use by fans of the University of Alabama football team of the following mark on shirts and hats was meant to evoke the houndstooth pattern of Coach Paul "Bear" Bryant's oft-worn fedora:

Coach Bryant's son and the University both opposed registration. But despite the applicants' admitted intent to invoke Bryant, the reference is relatively obscure—"applicants' mark is not the name or image of Coach Bryant, with his patterned fedora, nor does it contain his patterned fedora *per* se"—and the TTAB reasoned that it did not approximate Bryant's identity or that of the University.[95]

C. Standing and Zombies

The party challenging the registration must, of course, have standing to make that claim. Any person "who believes that he is or will be damaged" by a registration can oppose and any person "who believes that he would be damaged" by a registration can petition to cancel.[96] A plaintiff must show a "real interest" in the proceeding and a reasonable basis for the belief that the challenged mark has caused or will cause damage to it.[97]

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93 *Cf.* Anne Gilson LaLonde & Jerome Gilson, *What Were They Thinking? The Role of Intent in Trademark Law*, 85 (LexisNexis 2019) (urging a "fresh look at the courts' questionable practice of including the defendant's intent in the boilerplate test for likelihood of confusion" because a "defendant's thought processes are utterly irrelevant to real-world impressions and purchasing decisions").

94 Board of Trustees of Univ. of Ala. v. Pitts, 107 U.S.P.Q.2d 2001 (T.T.A.B. 2013).

95 *Id.* at 2027-28.

96 15 U.S.C. §§ 1063, 1064.

97 Ritchie v. Simpson, 170 F.3d 1092, 1095 (Fed. Cir. 1999); Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 309.03(b).

As a general rule, the party making the claim must be the party that is the target of the false suggestion of a connection.[98] In one case, a party seeking to cancel a registration in federal court tried to argue that the mark's design could falsely suggest a connection with the U.S. Congress because the Capitol was depicted in the mark.[99] Not being or representing the U.S. Congress, its claim was denied, with the court holding that, "to raise a claim that a mark falsely suggests a connection with an institution under Section 2(a), the challenger must be the institution itself."[100]

In another case, the TTAB held that Nike, Inc. had standing to bring an opposition *for likely confusion* between its mark (on the left) and a mark used by Palm Beach Crossfit, Inc.: [101]

Standing for that ground automatically provided standing for Nike to aver its other claims as well, including a false suggestion of a connection.[102] However, the Section 2(a) claim failed because Nike was alleging that the applicant's mark falsely suggested a connection with a third party—athlete Michael Jordan—rather

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98 *E.g.*, Mankind Research Found., Inc. v. Essiac Prods. Servs., Inc., 2000 TTAB LEXIS 934, at *16 (T.T.A.B. 2000) (not citable as precedent) (holding that, because the false suggestion of a connection ground is "essentially a statutory implementation of the rights of privacy and publicity, . . . the ground is personal to the person or institution named in the mark, and may only be asserted by that person or institution"); Arrow Trading Group, Inc. v. Swiss Army Brands, Ltd., 1996 TTAB LEXIS 463, at *4 n.1 (T.T.A.B. 1996) (not citable as precedent) (While the petitioner watchmaker was a competitor of the applicant, it was unable to bring a claim on behalf of the Swiss Army against the application for SWISS ARMY for watches.) ("Petitioner manifestly is not the Swiss Army, and has not pleaded facts which would establish its right to bring this action on behalf of the Swiss Army."); Estate of Biro v. Bic Corp., 18 U.S.P.Q.2d 1382, 1385 (T.T.A.B. 1991) ("Standing, in the context of a Section 2(a) claim, does not rise or fall on the basis of a plaintiff's proprietary rights in a term; rather, a Section 2(a) plaintiff has standing by virtue of who the plaintiff is, that is, the plaintiff's personality or 'persona.'").

99 Heroes Inc. v. Boomer Esiason Hero's Found., Inc., 43 U.S.P.Q.2d 1193 (D.D.C. 1997).

100 *Id.* at 1197.

101 Nike, Inc. v. Palm Beach Crossfit, Inc., 116 U.S.P.Q.2d 1025 (T.T.A.B. 2015).

102 *Id.* at 1029.

than with Nike itself.[103] Because the opposer was *not* the same as the person allegedly referenced in the mark, the TTAB found its claim insufficient.[104] It is unlikely Nike would have had standing to bring *just* the false suggestion of a connection claim.[105]

It is nonetheless *possible* for a party to have a legally cognizable stake in the outcome of a false suggestion of a connection case even if it is not the person or institution referred to in the mark. An opposer may make such a claim on behalf of others rather than on behalf of itself under limited circumstances. A nonprofit trade association representing suppliers, wholesalers, distributors, and retail sellers of diamonds and diamond jewelry was able to oppose registration of a mark for diamonds that incorporated the name of an entity that controlled around 85 percent of the diamonds coming to market annually.[106] In a later opinion in that case, the Federal Circuit found confusion likely and did not go on to address the Section 2(a) ground for opposition, but noted that "the trade association convincingly established that it was not a mere intermeddler in asserting a claim predicated on a third party's name and had sound reasons for fearing damage to itself and its members if [the] mark were registered."[107]

To have standing to make a false suggestion of a connection claim, as we know, the right being asserted need not be a trademark right. But the plaintiff must have *some* protectable interest to assert.[108] Heirs have been permitted to claim a false suggestion of a connection where they have inherited rights in an identity. In allowing the heirs of Dr. Martin Luther King, Jr. to oppose registration of WE HAVE A DREAM for "promoting sports competitions and/or events of others," the TTAB reasoned that the heirs must have a sufficient interest in the proceeding where the right of publicity is heritable.[109]

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103 *Id.* at 1031-32.

104 *Id.* at 1032.

105 *Id.* at 1029 ("Where a plaintiff has alleged standing as to at least one properly pleaded ground, its allegation of standing satisfies the standing requirement for any other legally sufficient ground."). *See also* Bridgewater Candle Co., LLC v. Elephant Design Ltd., 2002 TTAB LEXIS 121 (T.T.A.B. 2002) (not citable as precedent) (rejecting corporate petitioner's claim for false suggestion of a connection where it was attempting to assert a claim on behalf of its founder; granting summary judgment for respondent on the claim).

106 Jewelers Vigilance Comm., Inc. v. Ullenberg Corp., 823 F.2d 490, 491 (Fed. Cir. 1987).

107 Jewelers Vigilance Comm., Inc. v. Ullenberg Corp., 853 F.2d 888, 892 (Fed. Cir. 1988).

108 *E.g.*, NASA v. Bully Hill Vineyards, Inc., 3 U.S.P.Q.2d 1671, 1676 (T.T.A.B. 1987) ("While a party's interest in its identity does not depend for its existence on the adoption of and use of a technical trademark, a party must nevertheless have a protectible interest in a name (or its equivalent).").

109 King v. Trace Publ'g Co., 1999 TTAB LEXIS 338 (T.T.A.B. 1999) (not citable as precedent). *See also*, *e.g.*, Association Pour La Defense et La Promotion de l'Oeuvre de Marc Chagall Dite Comite Marc Chagall v. Bondarchuk, 82 U.S.P.Q.2d 1838 (T.T.A.B.

The party asserting the identity or persona does not have to be legally capable of licensing or otherwise approving use of the name commercially in order to have standing.[110] In one ex parte case, the TTAB denied registration to the mark LAKOTA for herbal remedies as falsely suggesting a connection to the Lakota tribe.[111] The examining attorney had failed to prove that the tribe had the authority to license, assign, or transfer rights to that name. Still, the Section 2(a) ground for refusal remained valid: What mattered was that the tribe's right to control use of its own identity was violated, "even if the name claimed to be appropriated was never commercially exploited as a trademark or in a manner analogous to trademark use."[112]

Once a mark is abandoned, say because of a company's closure or move to a new brand name, another party may take up that mark and use it. Those are known as zombie marks, resurrected from the brand graveyard.[113] Zombie marks do not run afoul of the false suggestion of a connection provision. If the mark falsely suggests a connection to an entity *but no one currently maintains rights in the entity's identity or persona*, the Section 2(a) bar does not apply. This is true whether the entity is a corporation or an individual.[114] Certainly, under the language of the statute, the names of deceased individuals are protected, but only to the extent someone claims rights in those names, such as an heir or successor.

No Section 2(a) claim is available on behalf of a nonoperational company, at least "when there is no apparent person or business entity who or which could claim to be the successor in interest to the prior business."[115] An examining attorney had rejected an application for DIAMOND T for trucks, truck parts and accessories,

2007) (member of petitioner committee was a granddaughter of Marc Chagall; purpose of the committee was to defend the deceased painter's rights and work; standing found).

110 TMEP § 1203.03(c)(i) ("A false suggestion of a connection may be found when the party's right to control the use of its identity is violated, even if there is no juristic entity having the authority to authorize use of the mark.").

111 *In re* Pedersen, 109 U.S.P.Q.2d 1185 (T.T.A.B. 2013).

112 *Id.*

113 *See generally* Anne Gilson LaLonde & Jerome Gilson, *The Zombie Trademark: A Windfall and a Pitfall*, 98 TMR 1280 (2008); Gilson on Trademarks, *supra* note 8, § 3.10[8].

114 Pierce-Arrow Soc'y v. Spintek Filtration, Inc., 2019 U.S.P.Q.2d 471774 (T.T.A.B. 2019) (no successor to rights in defunct company existed that could have passed rights along to opposer fan organization); *In re* MC S.r.l., 88 U.S.P.Q.2d 1378 (T.T.A.B. 2008) (finding that the examining attorney had not met its burden of showing that anyone had current rights in the name MARIA CALLAS; no Section 2(a) bar); *In re* Wielinski, 49 U.S.P.Q.2d 1754, 1758 (T.T.A.B. 1998) ("A natural person's right to the use of a designation which points uniquely to his or her persona may not be protected under Section 2(a) after his or her death unless heirs or other successors are entitled to assert that right.") (no false suggestion of connection with defunct company), *overruled on other grounds*, *In re* WNBA Enters. LLC, 70 U.S.P.Q.2d 1153 (T.T.A.B. 2003).

115 *In re Wielinski*, 49 U.S.P.Q.2d at 1758.

magazines, and t-shirts because it falsely suggested a connection with "the now-defunct former owner of the trademark."[116] The former owner had not used the marks since the early 1960s and its registration expired in 1988; the applicant filed its applications in 1993. The TTAB responded sternly:

> Rather than demonstrating that a basis exists for refusing registration to applicant under Section 2(a), what the Examining Attorney has essentially done is assert that applicant's trademarks are likely to cause confusion with the mark that was abandoned more than thirty years ago by the truck company that no longer exists. This is not a proper basis for refusing registration.[117]

And it reversed the refusal. While a new company may well be falsely suggesting to consumers that it is connected to the former company in the loose sense of those words, an entity that is no longer in existence has no rights to assert.

The DIAMOND T examining attorney made the creative argument that the reference to "persons, living or dead" in the statute meant that "dead" *juristic* persons must be protected by the statutory language. The TTAB, however, explained that the Lanham Act explicitly limits juristic persons to those "capable of suing and being sued in a court of law"[118] and defunct companies are unable to participate in litigation.[119] Even though "the former business was a juristic person, it no longer exists," said the TTAB, "and we have no basis for concluding that anyone else is entitled to assert the right of that defunct business."[120]

D. Defenses

It is true that "[i]n all inter partes proceedings equitable principles of laches, estoppel, and acquiescence, where applicable, may be considered and applied."[121] Despite this statutory prompt, the TTAB applies these principles sparingly. It has, on policy grounds, often rejected an equitable defense to claims such as genericness, functionality, and likelihood of confusion.[122] Whether or not the trademark owner delayed in asserting its rights, there is a public interest in allowing use of certain names or configurations and in avoiding use of a confusingly similar mark.

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116 *Id.* at 1756.

117 *Id.* at 1758.

118 15 U.S.C. § 1127.

119 *In re Wielinski*, 49 U.S.P.Q.2d at 1758.

120 *Id.*

121 15 U.S.C. § 1069.

122 TBMP § 311.02(b).

Notwithstanding that general inclination, the TTAB has made clear that laches and acquiescence *are* valid affirmative defenses when it comes to a false suggestion of connection claim.[123] The claim is a personal one, designed to protect an individual or institution from unwanted commercial exploitation.[124] It does not have a significant element of public interest that must be guarded regardless of a party's delay in bringing the case. Success in barring a false suggestion of a connection will not protect the public from deception or enable monopolization of generic names or functional configurations.

Where a cancellation petitioner had initiated a false suggestion of a connection proceeding twenty-seven years after the respondent's registration had issued, the Federal Circuit overruled the TTAB and found the claim barred by laches.[125] Citing *Notre Dame*, the court differentiated between Section 2(a) and Section 2(d) claims and ruled that "the equitable defenses of laches and estoppel are not barred in § 2(a) false suggestion cases, absent misrepresentation or deceit."[126]

Similarly, a defense of unclean hands may also apply when a false suggestion of a connection claim is asserted. The TTAB has found that, because "the prevailing interest implicated by the defense to [such a claim] is that of the individual, not the public, the defense of unclean hands is applicable. . . ."[127]

E. First Amendment Implications

In-depth discussion of First Amendment jurisprudence is beyond the scope of this article, but one point should be made on the subject: While other Section 2(a) prohibitions have recently fallen as a result of the First Amendment,[128] the false suggestion of a connection claim appears unlikely to go that route.

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123 *E.g.*, Hornby v. TJX Cos., 87 U.S.P.Q.2d 1411, 1419 (T.T.A.B. 2008) ("[L]aches will not lie against the ground of fraud. However, it will lie against the other pleaded grounds [including false suggestion of a connection].").

124 *Id.* ("The distinction lies in the fact that it is in the public interest to prohibit registrations procured or maintained by fraud, but the defense of laches is available when the rights asserted by a petitioner are personal in nature."); Treadwell's Drifters, Inc. v. Marshak, 18 U.S.P.Q.2d 1318, 1321 (T.T.A.B. 1990) ("In view of the personal nature of petitioner's claim, we see no overriding public policy that would preclude equitable defenses against such a claim. Accordingly, the equitable defenses are available to respondent against that portion of the petition grounded on false suggestion of a connection under Section 2(a)."). See also *supra* Part III.C for further discussion of this private/public distinction.

125 Bridgestone/Firestone Research Inc. v. Auto. Club de l'Ouest de la France, 245 F.3d 1359 (Fed. Cir. 2001).

126 *Id.* at 1363.

127 Creel Abogados, S.C. v. Creel, García-Cuéllar, Aiza y Enríquez, S.C., 2015 TTAB LEXIS 217, at *11 (T.T.A.B. 2015).

128 Iancu v. Brunetti, 139 S. Ct. 2294 (2019); Matal v. Tam, 137 S. Ct. 1744 (2017).

Despite its lack of an explicit connection to likelihood of confusion and its emphasis on private rights rather than the public interest, the false suggestion of a connection provision of Section 2(a) does prevent "false" speech.[129] Material that suggests a connection where there is none is inaccurate, to the detriment of those whose names and identities are used without authorization. Restrictions on regulating deceptive commercial speech do not trigger heightened scrutiny under the First Amendment.[130] The TTAB has noted, too, that the false suggestion of a connection provision is viewpoint neutral, which would insulate it from the specific holdings of *Tam* and *Brunetti*.[131]

One commentator has pointed out that the Supreme Court upheld a right of publicity claim involving the broadcast of a human cannonball act and did not find such a claim barred by the First Amendment.[132] He went on to opine that the Court's ruling "would suggest that the general right of a person to prevent appropriation of their name or other identifiers for commercial/trademark purposes would be upheld against a First Amendment challenge," finding the false suggestion of a connection refusal "broad, but

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129 *In re* Tam, 808 F.3d 1321, 1329 (Fed. Cir. 2015) ("Section 2(a) contains proscriptions against deceptive speech, for example, the prohibition on deceptive matter or the prohibition on falsely suggesting a connection with a person or institution."), *aff'd sub. nom* Matal v. Tam, 137 S. Ct. 1744 (2017). *See also* Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TMR 661, 666 n.14 (1993) (Of the bars to registration in Section 2(a), "only the registration prohibitions concerning deceptive and false connection trademarks appear to facilitate the goal of preventing confusion and deception in the market place.").

130 *See, e.g.*, Theodore H. Davis, Jr. & John L. Welch, *United States Annual Review: The Seventieth Year of Administration of the Lanham Act of 1946*, 108 TMR 1, 2 (2018) ("[M]any prohibitions on registration address false or misleading commercial speech and therefore should not trigger heightened scrutiny under the First Amendment," including the bar on marks "falsely suggesting an association with a person or entity."); Lisa Ramsey, *Trademark Law Institute for Intellectual Property & Information Law Symposium: Free Speech Challenges to Trademark Law after* Matal v. Tam, 56 Hous. L. Rev. 401, 431 (2018) (stating that "viewpoint-neutral trademark laws" regulating obscenity, fraud, and misleading commercial speech "should be consistent with the First Amendment after *Tam*," including the false suggestion of a connection provision); Alex Weidner, Note, *Examining the Impact of* In re Brunetti *on § 2(a) of the Lanham Act*, 83 Mo. L. Rev. 1153, 1167-68 (2018) (declaring that the bar on marks that falsely suggest a connection "can withstand strict scrutiny and [is] safe from a First Amendment challenge"); Drew Wilson, *Slants Rule*, 41 Los Angeles Lawyer 30, 34 (2018) (finding that "there is not a concern that the prohibition against . . . marks that 'falsely suggest a connection with persons' might run afoul of the First Amendment" because false commercial speech is not entitled to such protection).

131 *In re* ADCO Indus.-Techs., 2020 U.S.P.Q.2d 53786, *28 (T.T.A.B. 2020). See Gilson on Trademarks, *supra* note 8, §§ 3.08[10][b] and 3.08[11][b] for more on the *Tam* and *Brunetti* holdings.

132 Gary Myers, *Trademarks & The First Amendment After* Matal v. Tam, 26 J. Intell. Prop. L. 67, 92 (2019) (hereinafter "Myers"); Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562 (1977).

arguably permissible as a way to protect the right of publicity and reputation of individuals."[133]

V. FACTOR ONE: SAME AS OR CLOSELY APPROXIMATING CLAIMANT'S PREVIOUSLY USED NAME, IDENTITY, OR PERSONA

This factor includes two primary elements. First, the claimant must be asserting rights in "persons, living or dead, institutions, beliefs, or national symbols."[134] Second, the claimant must allege that the mark it is challenging is the same as or a close approximation of that identity or persona. In other words, not only must there be similarity but the claimant also must be defending its *identity or persona*, not its trademark or other material somehow associated with it.

A. Persons, Living or Dead, Institutions, Beliefs, or National Symbols

As a preliminary matter, the entity invoked by the mark must fall within the statutory language of "persons, living or dead, institutions, beliefs, or national symbols."[135] These are extremely broad categories.[136]

The term *persons* is defined expansively in the Lanham Act.[137] It includes individuals and groups of people,[138] including racial and ethnic groups.[139] Professional names, too, may constitute an

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133 Myers, *supra* note 132, at 92.

134 15 U.S.C. § 1052(a).

135 *Id.* This is the same list of entities that could not be *disparaged* in a trademark, a ground for rejection before the Supreme Court removed that barrier, citing the First Amendment. Matal v. Tam, 137 S. Ct. 1744 (2017). Case law on disparagement is relevant in false suggestion cases in how it interpreted "persons, living or dead, institutions, beliefs, or national symbols."

136 *See*, *e.g.*, *In re* N. Am. Free Trade Ass'n, 43 U.S.P.Q.2d 1282, 1285 (T.T.A.B. 1997) ("[W]e are mindful of the legislative history which indicates that the reference to an 'institution' in Section 2(a) was designed to have an expansive scope.").

137 "Person" includes "a juristic person as well as a natural person." A "juristic person" includes "a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law." The term "person" also includes "the United States, any agency or instrumentality thereof, or any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States." In addition, "person" includes "any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity." 15 U.S.C. § 1127.

138 TMEP § 1203.03(a)(i). Note that fictional characters are not covered, presumably because they lack a cognizable right in their fictional reputations.

139 *Matal*, 137 S. Ct. at 1755-56 (rejecting argument that "persons" does not include racial and ethnic groups).

individual's "name or identity."[140] These actual human persons are protected whether they are alive or dead.[141] The word also covers *juristic* persons, meaning entities like corporations.[142] The scope also encompasses nicknames, both personal and corporate.[143]

The appropriated term does not have to be the individual or institution's actual legal name, and it can even be a name that entity does not itself use, if the public knows it by that name.[144] For example, the TTAB found a false suggestion of a connection between PRINCESS KATE and ROYAL KATE and Kate Middleton, Duchess of Cambridge, though Middleton never used those terms as her name.[145] Donald Trump was never known as TRUMP-IT, yet he was

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140 Young v. Burch, 2018 TTAB LEXIS 154 (T.T.A.B. 2018) (not citable as precedent).

141 *E.g.*, *In re* Sloppy Joe's Int'l, Inc., 43 U.S.P.Q.2d 1350, 1352 (T.T.A.B. 1997) ("[T]he Section 2(a) false suggestion of a connection refusal is not improper here simply because it has been asserted with respect to a deceased individual, Ernest Hemingway.").

If the individual is dead, there must be a person or entity entitled to assert that individual's rights for a Section 2(a) claim to succeed. For more on standing to assert a false suggestion of a connection claim, see *supra* Part IV.C.

142 *See*, *e.g.*, Morehouse Mfg. Corp. v. J. Strickland & Co., 407 F.2d 881, 888 (C.C.P.A. 1969); Popular Merch. Co. v. "21" Club, Inc., 343 F.2d 1011, 1015 (C.C.P.A. 1965) (finding error in Board holding that corporate entity could not qualify as "persons, living or dead"); *In re* White, 73 U.S.P.Q.2d 1713, 1717 (T.T.A.B. 2014) ("Section 2(a) has been held to apply to commercial, juristic persons, as well as natural persons.").

The TTAB does not differentiate between "institutions" and juristic persons in 2(a) cases. *See* Cavern City Tours Ltd. v. Hard Rock Cafe Int'l, Inc., 2011 TTAB LEXIS 337 (T.T.A.B. 2011) (not citable as precedent).

143 Hornby v. TJX Companies Inc., 87 U.S.P.Q.2d 1411 (T.T.A.B. 2008) (finding false suggestion of a connection between the mark TWIGGY for clothing and petitioner where petitioner's nickname was Twiggy); *In re* Sauer, 27 U.S.P.Q.2d 1073 (T.T.A.B. 1993) (holding BO BALL unregistrable for falsely suggesting a connection with baseball and football star Vincent Edward Jackson, commonly known as Bo). *Cf.* Hirsch v. S.C. Johnson & Son, Inc., 280 N.W.2d 129 (Wis. 1979) (barring the use of a football player's nickname, "Crazylegs," as a name for shaving gel under state right of publicity law).

144 *See In re* West L.A. Corp. d/b/a/ California Beemers, Ser. No. 87354651 (T.T.A.B. Sep. 19, 2019) (not citable as precedent) (upholding a false suggestion of a connection claim between CALIFORNIA BEEMERS and BMW where "beemer" was shown to be an informal nickname for cars made by BMW and was BMW's identity "even if BMW does not use the term BEEMER itself"); Boston Ath. Ass'n v. Velocity, LLC, 117 U.S.P.Q.2d 1492, 1496 (T.T.A.B. 2015) ("A nickname or an informal reference, even one created by the public, can qualify as an entity's 'identity,' thereby giving rise to a protectable interest."); *In re* Pedersen, 109 U.S.P.Q.2d 1185, 1193 (T.T.A.B. 2013) ("The term . . . need not be the legal name of the party falsely associated with applicant's mark to preclude registration by applicant."); TMEP § 1203.03 ("A mark does not have to comprise a person's full or correct name to be unregistrable; a nickname or other designation by which a person is known by the public may be unregistrable under this provision of the Act.").

145 *In re* Nieves & Nieves, LLC, 113 U.S.P.Q.2d 1629 (T.T.A.B. 2015) (hereinafter "*Nieves I*") (PRINCESS KATE); *Nieves II,* 113 U.S.P.Q.2d at 1644 (ROYAL KATE) ("A term may be considered the identity of a person even if his or her name or likeness is not used. All that is required is that the mark sought to be registered clearly identifies a specific person . . . .").

protected under this section.[146] And an application for "attorney services" for the mark U.S. CUSTOMS SERVICE plus design was refused as a false suggestion of a connection with United States Customs and Border Protection even though that agency had not been officially called the "U.S. Customs Service" for several years.[147]

The legislative history of Section 2(a) suggests that the term *institution* was intended to refer to "fraternal societies and organizations."[148] However, the USPTO has not limited itself to this interpretation[149] and the term encompasses other entities, including government agencies and instrumentalities.[150] Institutions outside the United States are protected as well.[151]

Several Native American tribal names have been protected under the false suggestion heading.[152] In one case, for example, the

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146 *In re* ADCO Indus.-Techs., 2020 U.S.P.Q.2d 53786 (T.T.A.B. 2020). *See supra* Part II.B.

147 *In re* Peter S. Herrick P.A., 91 U.S.P.Q.2d 1505 (T.T.A.B. 2009).

148 University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 703 F.2d 1372, 1380 (Fed. Cir. 1983) (legislative history excerpt focusing on fraternal organizations and clubs in discussion of Section 2(a)).

149 *In re* N. Am. Free Trade Ass'n, 43 U.S.P.Q.2d 1282, n.7 (T.T.A.B. 1997) ("[A]lthough a treaty such as NAFTA was not specifically mentioned during [the legislative history], it is our view that the term 'institution' was included so that Section 2(a) would have an expansive scope."). *See also In re* Urbano, 51 U.S.P.Q.2d 1776, 1779 (T.T.A.B. 1999) (OLYMPIC GAMES is an "institution" under 2(a)) ("While we do not consider the Olympic Games, *per se*, to be an 'institution,' it is only common sense that an event of such magnitude, which occurs on a regular and ongoing basis, requires a substantial organizational structure to support and organize it.").

150 TMEP § 1203.03(c)(ii). *See also*, *e.g.*, U.S. Marine Corps v. Healy, 2017 TTAB LEXIS 148, at *32 (T.T.A.B. 2017) (not citable as precedent) (holding that "the common names, acronyms and initialisms for the government or its agencies or instrumentalities can be relevant to false suggestion of connection claims"); U.S. Postal Serv. v. Lost Key Rewards, Inc., 102 U.S.P.Q.2d 1595, 1602 (T.T.A.B. 2010) (not citable as precedent) ("Section 2(a) refers to a false suggestion of a connection with a person or institution, which includes government agencies.") ("no question" that the U.S. Postal Service is an institution under the statute); *In re Peter S. Herrick, P.A.*, 91 U.S.P.Q.2d at 1506 ("Institutions, as used in Section 2(a), include government agencies."). Trademarks containing the names of U.S. government programs, military projects and quasi-governmental organizations like the Smithsonian Institution also fall under this section, as do acronyms for those terms. *See In re* Stecki, 2019 TTAB LEXIS 23 (T.T.A.B. 2019) (not citable as precedent) (finding TSA, the acronym for the Transportation Security Administration, to be an institution under the statute).

151 *See In re* Prec. Imps. Corp., 2000 TTAB LEXIS 404 (T.T.A.B. 2000) (not citable as precedent) (refusing registration to SWISS MILITARY under Section 2(a)).

152 To facilitate USPTO examining attorneys' identification of marks that suggest false connections with tribes, the USPTO established a database of the insignia of federally recognized Native American tribes. *Establishment of a Database Containing the Official Insignia of Federally Recognized Native American Tribes*, 66 Fed. Reg. 44603 (Aug. 24, 2001), *available a*t https://www.uspto.gov/trademark/laws-regulations/native-american-tribal-insignia. As of November 2020, there were just 63 live entries in the tribal insignia database. *See* Stephanie B. Turner, *The Case of the Zia: Looking Beyond Trademark Law to Protect Sacred Symbols*, 11 Chi.-Kent J. Intell. Prop. 116, 137-38 (2012) ("In fact, the database has had little effect in practice. . . . [T]he small participation size does suggest that Native American tribes do not see the database as a particularly helpful tool. . . .

Federal Circuit found that the Shinnecock Indian Nation, a "self-governing Indian nation," was an institution under the statutory language.[153] LAKOTA, APACHE, and MOJAVE have also been protected under Section 2(a) as groups of persons or as institutions.[154]

A district court in 1960 assumed that the Statue of Liberty was a national symbol within the meaning of Section 2(a), suggesting that "considerations of patriotism and of good taste might suggest that there should be no commercialization of the Statue."[155] But it found that the plaintiff's depiction of the statue in its trademark was "dignified" and that each party was in "a legitimate and dignified business," namely insurance.[156] Further, the plaintiff's mark would not "convey to a reasonable and rational mind any idea of any connection between Liberty Mutual Insurance Company on the one hand, and the Statue of Liberty or the United States Government on the other."[157] The registration was found valid.

What of *beliefs*? No cases appear to even gesture toward what it would mean to suggest a false connection with a belief or set of beliefs. Instead, that term appears to have been exclusively relied upon in cases involving the disparagement clause, neighbor to false suggestion of a connection in Section 2(a). In that context, the Supreme Court clarified that "beliefs" applied to "the members of any group whose members share particular 'beliefs,' such as political, ideological, and religious groups."[158] In earlier cases, the TTAB found the name of the holy text of Islam as a mark for alcohol disparaged Muslims' beliefs[159] and a trademark application for BUDDHA BEACHWEAR and design disparaged Buddhists'

Alternatively, tribes may not want to publicize their sacred symbols specifically because they are sacred.").

153 *In re* Shinnecock Smoke Shop, 571 F.3d 1171, 1173-74 (Fed. Cir. 2009).

154 *See In re* Pedersen, 109 U.S.P.Q.2d 1185, 1192 (T.T.A.B. 2013) (LAKOTA recognized as signifying a Native American people and an institution under Section 2(a) even though it is not a federally recognized tribe; "[P]ersons and institutions as contemplated in § 2(a) may include groups of persons and individual members of a group such as the members of an Indian tribe having a common heritage and/or speaking a common language."); *In re* G&R Brands, LLC, 2008 TTAB LEXIS 158 (T.T.A.B. 2008) (not citable as precedent) (refusing to register MOJAVE for use in connection with cigarettes and related goods because of a false suggestion of a connection); *In re* White, 73 U.S.P.Q.2d 1713 (T.T.A.B. 2014) (refusing to register APACHE for use in connection with cigarettes because the name falsely suggested a connection with Apache tribes). Compare *In re* WM Distribution, Inc., 2005 TTAB LEXIS 452 (T.T.A.B. 2005) (not citable as precedent) (overruling refusal to register SANDIA for cigarettes because term does not name a particular tribe).

155 Liberty Mut. Ins. Co. v. Liberty Ins. Co., 185 F. Supp. 895, 908 (E.D. Ark. 1960).

156 *Id.*

157 *Id.*

158 Matal v. Tam, 137 S. Ct. 1744, 1764 (2017).

159 *In re* Lebanese Arak Corp., 94 U.S.P.Q.2d 1215 (T.T.A.B. 2010).

beliefs.[160] The Federal Circuit even found that a "belief in a loving and nurturing relationship between husband and wife" was protected from disparagement under Section 2(a).[161] Perhaps an examining attorney could refuse registration where the mark falsely suggested a connection with a particular religious group, though it is much more intriguing to wonder how a mark could falsely suggest a connection with a belief in a good marriage.

B. Name, Identity, or Persona

This factor asks whether the challenged mark is the same as or a close approximation of the claimant's previously used name, identity, or persona. The mark at issue must (1) closely approximate (2) the name, identity, or persona of the claimant.

Those two considerations blur together somewhat but ask different questions. When the content of the mark differs from the asserted name or identity, the TTAB engages in a two-step process.[162] In one case, for example, an examining attorney refused registration to SUPER CHEVY SHOW for automobile racing events on the ground that the mark falsely suggested a connection with General Motors.[163] First, the TTAB asked whether CHEVY was a name or identity of General Motors. Second, it asked whether SUPER CHEVY SHOW was a close approximation of that name or identity. It answered yes to both questions, affirming the rejection of the application.[164]

The TTAB has called it a "key factor": What the plaintiff is trying to protect must be equivalent to its name, identity, or persona.[165] The applicant's trademark must falsely suggest a connection with another party's *persona*, not with one of that party's *trademarks*.[166]

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160 *In re* Hines, 1994 TTAB LEXIS 46 (T.T.A.B. 1994), *vacated on other grounds*, 32 U.S.P.Q.2d 1376 (T.T.A.B. 1994).

161 Ritchie v. Simpson, 170 F.3d 1092, 1097 (Fed. Cir. 1999) (finding standing where opposer alleged that the trademarks O.J. Simpson applied to register were synonymous with "wife-beater" and "wife-murderer" and disparaged the opposer's belief in a loving marriage).

162 *See* Shirley Plantation, LLC v. Stillhouse Vineyards, 2018 TTAB LEXIS 483, at *90 (T.T.A.B. 2018) (not citable as precedent) (opposers had to show that their coat of arms was their persona and *then* that applicant's coat of arms trademark was a close approximation of that persona; they failed to do so and the mark registered); Boston Ath. Ass'n v. Velocity, LLC, 117 U.S.P.Q.2d 1492, 1495 (T.T.A.B. 2018) (mark at issue was MARATHON MONDAY and in "two-step approach," opposer had to show that BOSTON MARATHON was its persona *and* that MARATHON MONDAY was a close approximation of BOSTON MARATHON; it failed to do so and the mark registered).

163 *In re* SCSW, Inc., 2016 TTAB LEXIS 603 (T.T.A.B. 2016) (not citable as precedent).

164 *Id.* at *15.

165 Board of Trustees of Univ. of Ala. v. Pitts, 107 U.S.P.Q.2d 2001, 2025 (T.T.A.B. 2013).

166 *E.g.*, Haritatos v. Hasbro, Inc., 2005 TTAB LEXIS 285, at *7 (T.T.A.B. 2005) (not citable as precedent) (finding opposer's claim of false suggestion of a connection insufficiently pleaded and stating that "applicant must assert that opposer's pleaded mark falsely

A claim that simultaneous use of the parties' trademarks on their goods or services will result in source confusion is a likelihood of confusion claim and *not* a claim under Section 2(a).[167]

But the required identity or persona has some similarity to trademark protection—it must be distinctive. Where the primary significance of a term is merely descriptive or generic in context, that term cannot be a particular entity's *identity*. For instance, the TTAB found SPACE SHUTTLE to be generic for "a reusable space transportation vehicle that carries humans and cargo to space and back to Earth"; thus, there was no false suggestion of a connection with NASA where an applicant used that term in a mark for its wine.[168] Such a mark "by its very nature does not falsely suggest a connection."[169]

Claims of a "name, identity, or persona" can go far beyond a simple name or likeness. A motto, slogan, or catchphrase *may* be so closely associated with an individual that it can be denied registration under the false suggestion of connection ground. The TTAB found that I HAVE A DREAM was the equivalent of the identity of Dr. Martin Luther King, Jr.[170] In addition, as described above, the TTAB prohibited registration of a trademark identical to the title of a song so closely associated with singer Jimmy Buffett that the mark suggested a false connection.[171]

While many quotations or catchphrases are rejected on the ground that they fail to function as a source indicator, some are also refused for falsely suggesting a connection with a third party. Eric Garner was choked to death by a police officer and his final words, "I can't breathe," became a rallying cry for those protesting police

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suggests a connection with applicant's persona, not with one of applicant's registered marks") (opposer had to allege that CANDY LAND was its name or persona and not just one of its marks); Time Warner Entm't Co. v. Jones, 65 U.S.P.Q.2d 1650, 1663-64 (T.T.A.B. 2002) ("Opposer has not presented evidence sufficient to establish . . . that applicant's ROADRUNNER MAPS and design mark is the same as or a close approximation of opposer's name or identity. . . . Opposer owns ROAD RUNNER trademarks, but neither applicant's ROADRUNNER MAPS and design mark, nor even opposer's ROAD RUNNER mark or cartoon character, constitutes opposer's name or identity.").

167 Springs Industries, Inc. v. Bumblebee Di. Stefano Ottina & C.S.A.S., 222 U.S.P.Q. 512 (T.T.A.B. 1984).

168 NASA v. Bully Hill Vineyards, Inc., 3 U.S.P.Q.2d 1671, 1675 (T.T.A.B. 1987).

169 *Id. See also* CottageCare, Inc. v. Ranelli, 2007 TTAB LEXIS 677, at *40 (T.T.A.B. 2007) (not citable as precedent) ("[W]hen the term COTTAGE CARE CONSTRUCTION is used in connection with construction services, the primary significance of that term is its descriptive significance. It cannot, therefore, be said that the only meaning of the term COTTAGE CARE CONSTRUCTION is opposer's identity.").

170 King v. Trace Publ'g Co., 1999 TTAB LEXIS 338 (T.T.A.B. 1999) (not citable as precedent).

171 Buffett v. Chi-Chi's, Inc., 226 U.S.P.Q. 428 (T.T.A.B. 1985).

brutality.[172] An examining attorney refused registration of I CAN'T BREATHE for hoodies and t-shirts in part on the basis of a false suggestion of a connection with Garner and in part for failure to function as a mark.[173] Another application for #ICANTBREATHE for shirts was refused on the same grounds.[174]

Todd Beamer famously called out "Let's roll!" as passengers stormed the cockpit of Flight 93 on September 11, 2001.[175] The Todd M. Beamer Memorial Foundation opposed an application for that phrase and the applicant moved to dismiss. The TTAB did not get the opportunity to rule on whether "Let's roll" for t-shirts violated Section 2(a) because it decided the motion on other grounds.[176] But it's difficult to argue with one commentator's conclusion that the application would properly have been refused as a false suggestion of a connection.[177]

Catchphrases and cases such as Dr. King and "I have a dream"; Eric Garner and "I can't breathe"; and Jimmy Buffett and "Margaritaville" highlight one of the limits of this factor. Those cases may have been correctly decided under the statute as false suggestions of a connection, but the USPTO had to engage in a bit of sleight of hand to get there. Those words or phrases are not *really* the plaintiff's *name or identity or persona*. Though inextricably linked with Dr. King, the memorable line "I have a dream" is neither his *identity* nor his *persona*. Still, the proposed mark WE HAVE A DREAM arguably pointed unmistakably to him. "I can't breathe" is similarly not Eric Garner's identity or persona, though use of the phrase as a mark likely did create a false suggestion of a connection with him. And MARGARITAVILLE was certainly not Jimmy Buffett's name, nor could it honestly be said to be his identity or persona. The USPTO had to indulge in some legal fiction to fit these facts into its rubric.

Hashtags generated by the public based on nicknames, slogans, or catchphrases may also be refused as falsely suggesting a

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172 *See, e.g.*, Peniel E. Joseph, *'I can't breathe': Why Eric Garner protests are gaining momentum*, Reuters (Dec. 5, 2014), at http://blogs.reuters.com/great-debate/2014/12/05/i-cant-breathe-why-eric-garner-protests-are-gaining-momentum/.

173 U.S. Ser. No. 86479784. *See generally* Shontavia Jackson Johnson, *Memetic Theory, Trademarks & The Viral Meme Mark*, 13 J. Marshall Rev. Intel. Prop. L. 96 (2013) (discussing viral meme mark applications for words or catchphrases and the variable results of such applications at the USPTO).

174 U.S. Ser. No. 86485865 (filed Dec. 19, 2014).

175 *See, e.g.*, Ed Vulliamy, *'Let's Roll . . . ,'* The Guardian (Dec. 1, 2001), at https://www.theguardian.com/world/2001/dec/02/september11.terrorism1.

176 The Todd M. Beamer Memorial Foundation, Inc. v. Abdallah, Opp. No. 91125330 (T.T.A.B. Sept. 20, 2005).

177 Noah B. Bleicher, Comment, *Trademarking Tragedy: The Fight for Exclusive Rights to "Let's Roll,"* 52 Emory L.J. 1847, 1870-74 (2003) (hereinafter "Bleicher").

connection.[178] In fact, "false association is one of the registrability issues most likely to plague consumer-generated tagmarks. By definition, hashtags in that category reference existing brands, people, or institutions by name or nickname."[179] An application for #peace4trayvon for decorative refrigerator magnets, for example, was refused for falsely suggesting a connection with Trayvon Martin, the teenage victim of a fatal shooting in Florida.[180]

Section 2(a) has even been applied to a *treaty*. The TTAB affirmed refusal of registration of the following mark as a close approximation of the North American Free Trade Agreement:[181]

More specifically, the TTAB found that NAFTA was not just the treaty but also supplemental agreements and "the various commissions, committees, offices, etc. which are established by those documents."[182]

The TTAB found that the following symbol is an "identity" of the U.S. Postal Service:[183]

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178 Alexandra J. Roberts, *Tagmarks*, 105 Calif. L. Rev. 599, 644 (2017) ("Tagmarks are . . . particularly prone to false association problems under Lanham Act Sections 2(a), 2(c), and 2(d).").

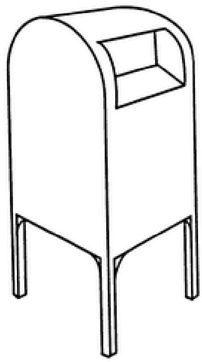
179 *Id.* at 646.

180 *Id.* at 644-45 (citing U.S. Ser. No. 86014534).

181 *In re* N. Am. Free Trade Ass'n, 43 U.S.P.Q.2d 1282 (T.T.A.B. 1997).

182 *Id.* at 1285.

183 United States Postal Serv. v. Lost Key Rewards, Inc., 102 U.S.P.Q.2d 1595, 1602 (T.T.A.B. 2010).



In a separate case, however, it found that (R)EGISTERED E-MAIL and REGISTERED E-MAIL were *not* the equivalent of an identity of the USPS.[184] Those trademarks were the names of its services, but they were not its *identity*.

Others have been unsuccessful in showing a false suggestion of a connection where the matter went far beyond a name or recognizable likeness. For instance, the TTAB struck down a claim of false suggestion of a connection where the Trustees of the University of Arkansas failed to allege that the mark WOOO PIG SOOIE was its identity or persona.[185] Nor, sadly, did it allege that its sensory mark consisting of a crowd cheering "Woooooooo. Pig. Sooie! Woooooooo. Pig. Sooie! Woooooooo. Pig. Sooie! Razorbacks!" was its identity or persona.[186]

One examining attorney had refused registration for several marks as false suggestions of a connection on the basis that their "overall look" was "a close approximation of" the work of two artists, Alberto Vargas and Gil Elvgren.[187] The marks, such as the following, were drawings of pin-up girls that had been painted on airplane fuselages by U.S. servicemen during World War II:

184 United States Postal Serv. v. RPost Int'l Ltd., 2013 TTAB LEXIS 322 (T.T.A.B. 2013) (not citable as precedent).

185 Board of Trustees of Univ. of Ark. v. B & J's, Inc., 2015 TTAB LEXIS 380 (T.T.A.B. 2015) (not citable as precedent).

186 *Id.* at *1. The sensory mark (U.S. Reg. No. 4558864) was registered for "providing collegiate athletic and sporting events" on July 1, 2014, with an alleged first date of use in commerce of December 31, 1929.

187 *In re* Am. Airpower Heritage Museum, 2004 TTAB LEXIS 667, at *9 (T.T.A.B. 2004) (not citable as precedent).

The evidence did indicate that Vargas and Elvgren were successful artists who painted "pin-up girls" and had each created specific paintings that were similar to the applied-for marks.[188] However, the original paintings did not, the TTAB found, rise to the level of being the artists' *name or identity* in consumers' minds.[189] In addition, the TTAB found that the original paintings were not so famous that the public would presume a connection.[190]

C. Same or Close Approximation

A "close approximation" means that the material being protected must be sufficiently similar to the mark, the level of similarity "akin to that required for a likelihood of confusion under § 2(d)."[191] The mark must do more than "simply bring . . . to mind" the claimant for it to be a close approximation.[192] Where the mark would be too dissimilar to the plaintiff's persona or identity to cause likelihood of confusion, the plaintiff will likely be unable to prove the first element of a false suggestion of a connection claim.[193]

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188 *Id.* at *14.

189 *Id.* at *16.

190 *Id.* at *16-17.

191 Boston Ath. Ass'n v. Velocity, LLC, 117 U.S.P.Q.2d 1492, 1497 (T.T.A.B. 2015).

192 Young v. Burch, 2018 TTAB LEXIS 154, at *62 (T.T.A.B. 2018); Board of Trustees of Univ. of Ala. v. Pitts, 107 U.S.P.Q.2d 2001 (T.T.A.B. 2013).

193 Sigma-Tau Industrie Farmaceutiche Riunite S.p.A. v. SigmaPharm Labs., LLC, 2015 TTAB LEXIS 42, at *94 (T.T.A.B. 2015) (not citable as precedent) ("For the same reasons we found that Applicant's marks are not similar to Opposer's marks for purposes of the likelihood of confusion analysis, we find here that Applicant's marks are not a close approximation of Opposer's identity and, therefore, it cannot be 'unmistakably associated' with Opposer's identity, nor do they point uniquely to Opposer."); Red Bull GmbH v. Biane, 2014 TTAB LEXIS 587, at *10-11 (T.T.A.B. 2014) (not citable as precedent) ("As the marks are too dissimilar to find a likelihood of confusion, opposer cannot prove the first element of the false suggestion of a connection claim, and the ground of false suggestion of a connection also fails."); Boston Red Sox Baseball Club Ltd. P'ship v. Sherman, 88 U.S.P.Q.2d 1581, 1593 (T.T.A.B. 2008) (finding that two marks are insufficiently similar to show likely confusion leads to finding that "applicant's mark is not a close approximation of opposer's identity").

There may be sufficient similarity where the mark and the entity's name *sound* very much alike. The TTAB affirmed refusal of FRANKS ANATRA for catering services as a "close approximation" because of its phonetic identity with the name of icon Frank Sinatra.[194] It ruled against the applicant despite his very creative testimony that "[t]he name of my business is Franks Anatra. Franks as in frankfurter, Anatra as in the People's Republic of Anatra," a disappointingly fictional "independent island nation" that is "all about the hot dogs."[195]

Addition of a design element or generic terms to the plaintiff's name or identity are unlikely to avoid a finding of false suggestion of a connection and may make such a finding *more* likely if the extra matter reinforces the link.[196] The additional flourish of a treble clef on the name of composer P. Mauriat in this mark for musical instruments helped enable the TTAB to find that consumers would assume a connection:[197]

The swirl of hair on the TRUMP-IT mark depicted earlier in this article similarly called to mind Donald Trump and his "renowned hair wave," the TTAB found, and the connection was reinforced by the slogan "Make Opening Packages Great."[198] The TTAB found that DR. DRAI and the following design mark were close

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194 Frank Sinatra Enters., LLC v. Loizon, 2012 TTAB LEXIS 355, at *10-11 (T.T.A.B. 2012) (not citable as precedent) ("[W]e do not understand how applicant's mark engenders the commercial impression relating to anything other than a play on the Frank Sinatra name.").

195 *Id.* at *12.

196 *E.g.*, *In re* Stecki, 2019 TTAB LEXIS 23 (T.T.A.B. 2019) (TSA-KIT is a close approximation of TSA); *In re* N. Am. Free Trade Ass'n, 43 U.S.P.Q.2d 1282, 1285 (T.T.A.B. 1997) ("One cannot overcome a refusal based on a false suggestion of a connection merely by adding a design element to an entity or institution's identity," particularly where "the design which applicant has adopted reinforces that the mark will be identified with" the plaintiff.).

197 *In re* Hsieh, 2008 TTAB LEXIS 186 (T.T.A.B. 2008). *See also In re* Jackson Int'l Trading Co., 103 U.S.P.Q.2d 1417 (T.T.A.B. 2012) (BENNY GOODMAN COLLECTION THE FINEST QUALITY (stylized) is a close approximation of name Benny Goodman).

198 *In re* ADCO Indus.-Techs., 2020 U.S.P.Q.2d 53786, at *11 (T.T.A.B. 2020). *See supra* Part II.B.

approximations of opposer's professional name as a rapper, Dr. Dre:[199]

DOCTOR
DRAI
OBGYN & MEDIA PERSONALITY

But the TTAB did find that OLYMPIC CHAMPION was not a close enough approximation of OLYMPIC to falsely suggest a connection[200] and MARATHON MONDAY was not sufficiently similar to BOSTON MARATHON to be a close approximation.[201]

In deciding that the TRUMP-IT mark was a close approximation of Donald Trump's identity, the TTAB curiously suggested that "the fact that Donald Trump is associated with numerous goods and services further supports a finding that consumers would view the applicant's marks as a close approximation of his name or identity."[202] In fact, Trump's extensive licensing efforts do not logically relate to whether the mark at hand closely approximated his identity. Rather, the fact that the American public would encounter many TRUMP-branded goods and services is relevant to another false association factor: the fact that his fame or reputation would cause consumers to presume a connection between him and the TRUMP-IT mark.[203]

D. Previously Used

While a plaintiff does not need trademark rights to succeed in a false suggestion of a connection claim, it must prove prior use of the persona or institutional identity it seeks to protect.[204] In other words, if the applicant used the mark before the plaintiff or another

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199 Young v. Burch, 2018 TTAB LEXIS 154 (T.T.A.B. 2018). However, relying on another factor, the Board ultimately found that the public would not presume a connection and allowed registration. *See* § VII.A.

200 *In re* Kayser-Roth Corp., 29 U.S.P.Q.2d 1379, 1385 (T.T.A.B. 1993). *See also*, *e.g.*, U.S. Marine Corps v. Healy, 2017 TTAB LEXIS 148 (T.T.A.B. 2017) (MARINE ONE DOWN not close approximation of UNITED STATES MARINE CORPS or MARINES).

201 Boston Ath. Ass'n v. Velocity, LLC, 117 U.S.P.Q.2d 1492 (T.T.A.B. 2015).

202 *In re ADCO Indus.-Techs.*, 2020 U.S.P.Q.2d 53786, at *16.

203 *Id.* at *20. See *supra* Part II.B for more on this case.

204 *In re* Nuclear Research Corp., 16 U.S.P.Q.2d 1316 (T.T.A.B. 1990).

entity "used" the plaintiff's identity, then the claim of false suggestion of a connection will collapse.[205]

Still, "the requirements for establishing prior use under section 2(a) are not as stringent as those for determining priority of a mark."[206] Use of a mark on letterhead and on a brochure that the USPTO would not have accepted as proof of use in commerce as specimens were sufficient to show prior use for purposes of Section 2(a).[207] And the "prior use" certainly need not be trademark use.[208]

VI. FACTOR TWO: MARK POINTS UNIQUELY AND UNMISTAKABLY TO CLAIMANT

Another element of the claim is that the mark must point uniquely and unmistakably to the entity at issue.[209] This is a "very high standard."[210] It is not enough if the term is "predominantly" used to refer to the claimant or is "more prominently or more often associated with one entity . . . than another. . . ."[211] If consumers would see the mark as having a significance other than the entity challenging the mark, one that either points to another entity or doesn't point to *any* entity other than the applicant, the claim fails.[212]

The USPTO will look at the context of the goods or services to determine whether the mark would point uniquely and unmistakably to the claimant. For example, LITTLE TIGER pointed uniquely to Tiger Woods where the goods were "golf equipment for children."[213] The following mark for charitable

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205 *See, e.g.*, Hoganas AB v. Konica Minolta Printing Solutions USA, Inc., 2006 TTAB LEXIS 798, at *10 (T.T.A.B. 2006) (not citable as precedent) ("Given applicant's prior use, opposer's Section 2(a) claim must fail.").

206 Bleicher, *supra* note 177, at 1871.

207 *In re* Nuclear Research Corp., 16 U.S.P.Q.2d 1316 (T.T.A.B. 1990).

208 TMEP § 1203.03(c)(i) ("A refusal on this basis requires, by implication, that the person or institution with which a connection is falsely suggested must be the prior user. However, it is not necessary that the prior user ever commercially exploit the name as a trademark or in a manner analogous to trademark use.") (citations omitted).

209 *See, e.g.*, Board of Trustees of Univ. of Ark. v. B & J's Inc., 2015 TTAB LEXIS 380, at *11 (T.T.A.B. 2015) ("Fundamental to a pleading of false suggestion of a connection under Trademark Act § 2(a) is the 'initial and critical requirement' that the identity being appropriated is unmistakably associated with the plaintiff.").

210 Terry v. Newman, 2013 TTAB LEXIS 206, at *11 (T.T.A.B. 2013).

211 *In re* Parisi, 2004 TTAB LEXIS 367 (T.T.A.B. 2004) (not citable as precedent).

212 TMEP § 1203.03(c)(i) (In a false suggestion of a connection case, "the question is whether, as used on the goods or services in question, consumers would view the mark as pointing uniquely to petitioner, or whether they would perceive it to have a different meaning.").

213 *In re* The Junior Golf Co., 2000 TTAB LEXIS 602, at *5-6 (T.T.A.B. 2000) (not citable as precedent) ("Clearly, in determining whether a mark points uniquely to a particular person or persons, the context of the use of the mark and the nature and extent of the person's fame is of utmost relevance."). The Board also affirmed a refusal to register based on Section 2(c) of the Act in that case because the mark comprised a name

services did not falsely suggest a connection with the United States Congress because the U.S. government does not provide charitable services.[214]

And the application for U.S. CUSTOMS SERVICE for legal services mentioned previously pointed unmistakably to the U.S. Customs and Border Protection agency where the applicant's website proclaimed his concentration on U.S. Customs law.[215]

The USPTO has refused registration under Section 2(a) for many marks that pointed uniquely to an entity, including the following:

- A shotgun and rifle company was not allowed to register WESTPOINT for firearms where the word pointed uniquely to the military academy;[216]
- An individual member of the St. Regis Band of Mohawk Indians of New York was blocked from using MOHAWK for cigarettes because the mark uniquely pointed to the tribe;[217]

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identifying a particular living individual without his written consent. *Id.* (citing 15 U.S.C. § 1052(c)). *See also* Young v. Burch, 2018 TTAB LEXIS 154, at *44 (T.T.A.B. 2018) ("[W]e determine whether Opposer has shown a false suggestion of a connection with respect to each class of goods and services . . . ."); NASA v. Record Chem. Co., 185 U.S.P.Q. 563, 568 (T.T.A.B. 1975) ("The question of registrability of a mark under this section . . . is determined in each case by the nature of the goods or services in connection with which the mark is used and the impact of such use on the purchasers of goods or services of this type."); TMEP § 1203.03(c)(ii) ("[T]he identified goods or services must be scrutinized in the context of the current marketplace to determine whether they are of the type to be offered by United States government agencies and instrumentalities.").

214 Heroes Inc. v. Boomer Esiason Hero's Found., Inc, 43 U.S.P.Q.2d 1193 (D.D.C. 1997).

215 *In re* Peter S. Herrick, P.A., 91 U.S.P.Q.2d 1505 (T.T.A.B. 2009).

216 *In re* Cotter & Co., 228 U.S.P.Q. 202 (T.T.A.B. 1985).

217 *In re* White, 80 U.S.P.Q.2d 1654 (T.T.A.B. 2006). The Board was unpersuaded by the use of MOHAWK by third parties on other products and services, tracing each back to the tribe.

- SWISS MILITARY uniquely connotes the Swiss armed forces even though there is no institution formally named "the Swiss military";[218] and
- Encountering the mark depicted below

  Benny Goodman
  Collection
  THE FINEST QUALITY

  on fragrances and cosmetics would lead consumers to associate the mark with the bandleader, composer, and clarinetist, even though the name Benny Goodman was not a unique one.[219]

In many other cases, of course, the plaintiff has been less successful in showing the mark pointed "uniquely and unmistakably" to itself. Ritz Hotel failed to establish that the following mark for toilet seats

Ritz

pointed uniquely to the hotel.[220] The Federal Circuit held: "We do not think that the Mayo Clinic would come to the mind of the average purchaser confronted with a packaged food product bearing the [following] stylized mark":[221]

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218 *In re* Precise Imports Corp., 2000 TTAB LEXIS 404 (T.T.A.B. 2000) (not citable as precedent).

219 *In re* Jackson Int'l Trading Co., 103 U.S.P.Q.2d 1417, 1420 (T.T.A.B. 2012) ("If applicant wished to show that there are numerous individuals known as Benny Goodman, or that the renown of Benny Goodman, the bandleader, composer and clarinetist, has faded to the point that the applied for mark does not point uniquely and unmistakably to him, then applicant was obligated to introduce such evidence to rebut the evidence submitted by the examining attorney.").

220 Ritz Hotel Ltd. v. Ritz Closet Seat Corp., 17 U.S.P.Q.2d 1466 (T.T.A.B. 1990).

221 Frederick Gash, Inc. v. Mayo Clinic & Mayo Found., 461 F.2d 1395, 1398 (C.C.P.A. 1972) (low-fat mayonnaise).

Where "Whitehouse" was used as a surname, a trademark for a fruit product company, and the name of a Russian government building, the mark WHITEHOUSE did not point unmistakably to either the White House in Washington, D.C. or the executive branch of the U.S. government.[222] CALVIN did not point uniquely to Calvin Klein.[223] And the mark OLYMPIC CHAMPION did not point "uniquely and unmistakably" to the United States Olympic Committee because it could just as easily have referred to an athlete representing a country other than the United States in the Olympic Games.[224]

If the mark points to *more than one* person or institution, it does not point *uniquely* to one and thus does not falsely suggest a connection.[225] But the mark does not need to be a fanciful, one-of-a-kind term in order to point uniquely to the claimant.[226] 1960s model and celebrity Twiggy retained sufficient fame in the year 2000 for consumers to uniquely associate her with the mark TWIGGY used

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222 *In re* Parisi, 2004 TTAB LEXIS 367 (T.T.A.B. 2004).

223 Calvin Klein Indus., Inc. v. Calvins Pharms., Inc., 8 U.S.P.Q.2d 1269 (T.T.A.B. 1988).

224 *In re* Kayser-Roth Corp., 29 U.S.P.Q.2d 1379, 1385 (T.T.A.B. 1993).

225 *E.g.*, Univ. of S.C. v. Univ. of S. Cal., 367 Fed. Appx. 129, 136 (Fed. Cir.) (unpublished) (affirming TTAB's decision to grant summary judgment against plaintiff where mark SC refers to many entities; "[E]vidence showing that the initials 'SC' could refer to the State of South Carolina does not create a genuine issue on whether the initials uniquely point to the State."), *cert. denied*, 562 U.S. 829 (2010); Board of Trustees of Univ. of Ala. v. Diaz, 2017 TTAB LEXIS 272, at *56 (T.T.A.B. 2017) (not citable as precedent) ("Petitioners contend that the mark as a whole 'points uniquely' to each of two distinct persons . . . . This approach is logically untenable."); *In re* Luppen Holdings, Inc., 2004 TTAB LEXIS 644, at *10 (T.T.A.B. 2004) (not citable as precedent) (finding that PERSONAL POST OFFICE does not falsely suggest a connection with the U.S. Postal Service because the applicant submitted "substantial evidence that clearly establishes that entities not connected with the U.S. Postal Service have made use of the term 'Post Office'"); *In re* Nuzzolo, 2001 TTAB LEXIS 47, at *5 (T.T.A.B. 2001) (not citable as precedent) (THE SALVADOR DALI SOCIETY may point to the artist, a museum in Florida, or a museum or foundation in Spain, so it does not falsely suggest a connection with the artist).

226 TMEP § 1203.03(c)(i) ("The requirement that the proposed mark would be recognized as pointing uniquely and unmistakably to the person or institution does not mean that the term itself must be unique.").

on children's clothing, even though the word "twiggy" appeared in the dictionary.[227]

In addition to showing fame or reputation, discussed in the next section, those claiming false suggestion of a connection must show that the public has been exposed to the term as exclusively as possible as being associated with the claimant.[228] And the applicant or registrant must locate as many other entities using that name as possible; showing numerous third-party uses of the name may strengthen their claim. News articles and other media attention are vital because what matters is exposure of the term to the public. Note that the TTAB has said: "We do not find the case law to preclude a false suggestion of a connection merely because there may be some obscure individual or entity with the same name or mark, but the case law clearly requires more than that the use of the name or mark is most often associated with a particular individual or entity."[229]

The fact that material serves as a source-identifying trademark surprisingly does *not* mean that it points uniquely to the trademark owner in the context of a false suggestion of a connection claim.[230] In other words, even if a trademark identifies a particular source in consumers' minds, it may not point uniquely to that source in the relevant sense. In one case, the applicant had applied to register MESSAGE IN A BOTTLE for novelty bottles containing "messages and greetings, invitations, promotional materials of others, and advertising materials of others" and similar goods.[231] The opposer had registered the same mark for "receiving communications from others, recording such communications in written or printed form, and transmitting such communications to others."[232] The TTAB found confusion likely under Section 2(d) but dismissed the false suggestion of a connection claim and reasoned that the opposer did not show that MESSAGE IN A BOTTLE, its trademark, also pointed uniquely to its persona or identity.[233] "There is a distinction," said the TTAB, "between a term being perceived as a company's trademark and being a company's persona."[234]

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227 Hornby v. TJX Cos. Inc., 87 U.S.P.Q.2d 1411 (T.T.A.B. 2008).

228 *E.g.*, *In re* Depaul Int'l, 2014 TTAB LEXIS 261, at *18 (T.T.A.B. 2014) (not citable as precedent) (finding DEPAUL uniquely refers to DePaul University because "applicant has not submitted evidence to support the assertion in its brief regarding other entities adopting the term DEPAUL (or 'DePaul') in the names of their organizations").

229 *In re* Parisi, 2004 TTAB LEXIS 367, at *9-10 (T.T.A.B. 2004).

230 See *supra* Part II.A for more on the difference between trademark rights and rights for showing a false suggestion of a connection.

231 Message in a Bottle, Inc. v. Cangiarella, 2010 TTAB LEXIS 251 (T.T.A.B. 2010) (not citable as precedent).

232 *Id*. at *2.

233 *Id*. at *34-39.

234 *Id*. at *37.

VII. FACTOR THREE: CLAIMANT'S FAME OR REPUTATION WOULD CAUSE CONSUMERS TO PRESUME A CONNECTION

The claimant must show that the fame or reputation of the appropriated name or identity would cause purchasers to "mistakenly presume that a commercial connection exists between the named person or institution and the applicant" when the mark is used in connection with the applicant or registrant's goods or services.[235] There must be a showing of fame or reputation *and* a finding that purchasers would erroneously assume a connection when the mark was used with certain goods or services. A showing of fame or reputation alone is not sufficient.[236]

A. Standard for Fame or Reputation

The person or institution at issue need not introduce a survey, consumer testimony, or expert opinion to show "fame or reputation" in order to demonstrate a false suggestion of a connection.[237] Still, the claimant must allege fame or reputation[238] and there must be specific evidence of public awareness.[239] As the TTAB has said, "although the Internet is a wonderful tool for retrieving information, the simple fact that such information can be retrieved does not mean that the information would be known by the general public in the United States."[240] And the TTAB will not take judicial notice of an entity's fame.[241]

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235 Young v. Burch, 2018 TTAB LEXIS 154, at *65 (T.T.A.B. 2018).

236 *See* Cavern City Tours Ltd. v. Hard Rock Cafe Int'l, Inc., 2011 TTAB LEXIS 337, at *29 n.7 (T.T.A.B. 2011) ("Petitioner must establish that [the mark] is petitioner's identity or persona; simply owning a famous mark is insufficient.").

237 Association Pour La Defense et La Promotion de l'Oeuvre de Marc Chagall Dite Comite Marc Chagall v. Bondarchuk, 82 U.S.P.Q.2d 1838, 1843-44 (T.T.A.B. 2007).

238 784 8th Street Corp. v. Ruggiero, 2018 TTAB LEXIS 416, at *3 n.9 (T.T.A.B. 2018) (not citable as precedent) ("Inasmuch as Opposer has not alleged [its] mark is famous, Opposer has not sufficiently pleaded a claim of false suggestion of a connection.").

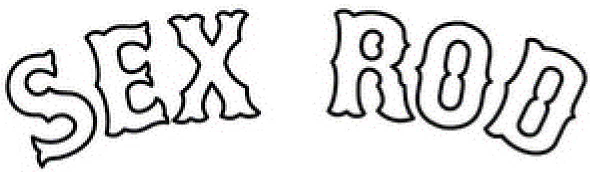
239 *See* Pierce-Arrow Soc'y v. Spintek Filtration, Inc., 2019 U.S.P.Q.2d 471774 (T.T.A.B. 2019) (automobile enthusiast society with around 1000 members and limited advertising lacked fame or reputation, though likely confusion found); U.S. Postal Serv. v. RPost Int'l Ltd., 2013 TTAB LEXIS 322 (T.T.A.B. 2013) (USPS's REGISTERED MAIL mark famous in false suggestion of connection context); *In re* Diversified Gestao E Investimentos Lda., 2003 TTAB LEXIS 547 (T.T.A.B. 2003) (not citable as precedent) (Italian church Trinita dei Monti not a well-known tourist attraction and insufficiently famous to American consumers).

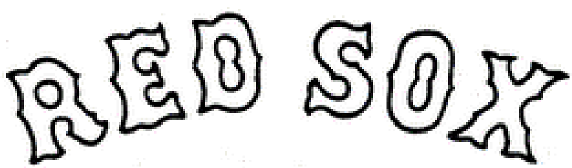
240 *Id.* at *18.

241 *In re* Marcon, 2008 TTAB LEXIS 272, at *7 (T.T.A.B. 2008) (not citable as precedent). In that case, the examining attorney had refused registration for HEINEKEN for "meat juices" as suggesting a false connection with the Heineken brewery, but submitted scant evidence of the brewery's fame. The TTAB noted: "At the risk of stating the obvious, certainly a different result might have been possible on this Section 2(a) ground, had we been privy to a fuller record." *Id.* at *10.

Fame in the context of a false suggestion of a connection is not the same as fame in likelihood of confusion or dilution analysis. The question is whether the name or identity as used in the mark would have enough notoriety for the public to associate that mark with the claimant *in that context*.[242] For example, though it was not a household name, the TTAB found the Schiedmayer surname to be sufficiently famous as used by that family to sell "keyboard musical instruments" for centuries so that, when it was used by a third party to sell the same products, the public would presume a connection.[243]

Where the nature of the mark or the goods is such that consumers would not believe the plaintiff was associated with the defendant, the false suggestion of a connection claim loses no matter what the fame or reputation of the claimant.[244] While the TTAB found the SEX ROD mark both scandalous and disparaging of the Boston Red Sox, it denied the baseball club's claims of likelihood of confusion and false suggestion of a connection.[245]





Taking into account "the inherent nature of applicant's mark, and the fact that the mark is disparaging to opposer," the TTAB concluded that "the public would not reasonably believe that opposer, a famous and reputable organization, would be associated with a mark that disparages itself."[246]

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[242] Schiedmayer Celesta GmbH v. Piano Factory Group, Inc., 2019 U.S.P.Q.2d 341894, at *24-25 (T.T.A.B. 2019) ("The inquiry under this Section 2(a) factor differs from the traditional likelihood of confusion or dilution analyses of fame in that 'the key is whether the name per se ... as *used* would point uniquely to the person or institution.'") (emphasis in original) (*quoting In re* White, 73 U.S.P.Q.2d 1713, 1718 (T.T.A.B. 2004)).

[243] *Id.* at *4-5.

[244] *See* Rebecca Tushnet, *The First Amendment Walks into a Bar: Trademark Registration and Free Speech*, 92 Notre Dame L. Rev. 381, 420 (2016) ("If a mark disparages, it probably doesn't cause a false connection . . . .").

[245] Boston Red Sox Baseball Club Ltd. P'ship v. Sherman, 88 U.S.P.Q.2d 1581 (T.T.A.B. 2008).

[246] *Id.* at 1593.

Still, the TTAB did find a false suggestion of a connection between BASEBALLS EVIL EMPIRE [sic] and the New York Yankees.[247] The Yankees successfully argued that the phrase EVIL EMPIRE "has come to identify [its] baseball entertainment services, and by extension, the source of [its] wide variety of merchandise."[248] The TTAB found that the mark was a sufficiently close approximation of the Yankees' identity, that the public would see it as pointing to the baseball club, and that EVIL EMPIRE had sufficient fame or renown so that BASEBALLS EVIL EMPIRE would falsely suggest a connection with the Yankees.[249] The difference? The Yankees had embraced the epithet and thus were able to protect it.

As noted above, the claimant must show that a connection would be presumed with respect to the applicant's goods or services.[250] The claimant need not be known for the *specific* goods or services listed in the application, but instead the question is whether, when the mark is used in connection with those goods or services, consumers will presume a connection with the person.[251] For example, Kate Middleton (a.k.a. Catherine, Duchess of Cambridge) was not known for shower gel, key fobs of precious metals, handbags for men, pillow shams, or flip-flops, which were among the many goods in the identification in an application for ROYAL KATE.[252] But her reputation as a "fashion trendsetter," according to the TTAB, was such that consumers would assume a connection between her and clothing, jewelry, bedding, and other accessories.[253]

Despite the contextual requirement, one would hope that the USPTO would find a false suggestion of a connection even where the goods and services are relatively far afield where the celebrity or institution at issue is very famous. The TTAB has acknowledged that "it is commonplace for performers and owners of well-known marks to expand their product lines to incorporate a diverse set of goods to capitalize on the renown of their names and brands."[254] As

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247 New York Yankees P'ship v. Evil Enters., Inc., 2013 TTAB LEXIS 72 (T.T.A.B. 2013) (not citable as precedent).

248 *Id.* at *2.

249 *Id.* at *15-16.

250 Young v. Burch, 2018 TTAB LEXIS 154, *67 n.70 (T.T.A.B. 2018) ("Just as in the case of likelihood of confusion, we determine whether Opposer has shown a false suggestion of a connection with respect to each class of goods and services . . . .").

251 *Nieves I,* 113 U.S.P.Q.2d at 1637.

252 *Id.*

253 *Id.*

254 Frank Sinatra Enters., LLC v. Loizon, 2012 TTAB LEXIS 355, at *13 (T.T.A.B. 2012). *See also* King v. Trace Publ'g Co., 1999 TTAB LEXIS 338, at *13 (T.T.A.B. 1999) ("[I]t is common knowledge that in the United States today licensing is widespread and the names and likenesses of celebrities, both living and dead, are frequently used in connection with the advertising and sale of goods and services.").

described above, the TTAB barred registration of FRANKS ANATRA for catering services based on a false suggestion of a connection though Sinatra is not immediately associated with the sale of food.[255] Registration of WE HAVE A DREAM was rejected based on a false suggestion of a connection with Dr. Martin Luther King, Jr. for the promotion of sports competitions,[256] decidedly unrelated to Dr. King and his legacy.

But there are limits. Well-known rapper Dr. Dre opposed registration of the mark DR. DRAI and image[257] for services including motivational speaking and health care consulting in the fields of osteopathic medicine, obstetrics, and gynecology.[258] The musician was unable to show that consumers of the applicant's services would think only of him upon seeing the applicant's mark in connection with those services.[259] The TTAB found no evidence that it was commonplace for celebrities to license their names for use on such services and no evidence that the opposer's "reputation in the recording or entertainment industry is of such a nature that a connection (sponsorship, approval, support or the like) with the applicant's educational and motivational speaking services or its medical and health care products and services would be presumed when Applicant's DR. DRAI marks are used on such goods and services."[260]

B. What Type of Association Is Needed?

What precisely does it mean for a consumer to "mistakenly presume that a commercial connection exists"? We know that it need not be source or sponsorship confusion. It appears to mean that the mark would cause the consumer to bring to mind the person or institution, as in, "I get it, Frank Sinatra hot dogs" or "Oh, Marc Chagall vodka, like the artist." The entity is so well known and the mark is so similar to the persona that a consumer would make the mental link when encountering the mark. Then, the consumer has presumed a connection under the statute and this factor is satisfied.

It would be easy to conflate the considerations of whether the disputed mark points uniquely to the opposer and whether a connection would be presumed. One might simply assume that if the mark points uniquely to the opposer, consumers would presume that there is a connection. But whether or not the mark points uniquely to the entity is considered in a separate factor, factor two.

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255 *Frank Sinatra Enters., LLC*, 2012 TTAB LEXIS 355.

256 *King*, 1999 TTAB LEXIS 338.

257 See *supra* Part V.C for a depiction of the mark.

258 Young v. Burch, 2018 TTAB LEXIS 154 (T.T.A.B. 2018).

259 *Id.* at *73.

260 *Id.* at *70.

There is surely an overlap, but the test requires analyzing them separately. This third factor asks whether the plaintiff is sufficiently famous that enough people would recognize the connection rather than whether the mark refers directly to the plaintiff. For example, your cousin with a unique nickname may be able to argue convincingly that that name points uniquely and unmistakably to her, but the USPTO would also require a showing of celebrity and widespread awareness under the "fame or reputation" factor.[261]

The mental trigger of presuming a connection sounds a great deal like dilution protection. In federal dilution law, the association of a junior mark with a famous mark harms the famous mark without a showing of likely confusion. GUCCI frozen peas or GOOGLE athlete's foot treatment or COCA-COLA private prison services are not harmful to the big brands because there's consumer confusion. They're harmful because the distinctiveness of the famous marks is whittled away, bit by bit, if such uses are allowed.[262]

But there are two major differences. First, a mental association between the junior mark and the famous senior mark is not enough to establish dilution under the federal statute.[263] Dilution by blurring is an "association arising from the similarity between a mark or trade name and a famous mark *that impairs the distinctiveness of the famous mark*."[264] Dilution by tarnishment is the same association but that instead "*harms the reputation of the famous mark*."[265] The Supreme Court held under the superseded Federal Trademark Dilution Act that mental association between two marks does not alone establish dilution,[266] and that

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261 *E.g.*, Schiedmayer Celesta GmbH v. Piano Factory Group, Inc., 2019 U.S.P.Q.2d 341894, at *24-25 (T.T.A.B. 2019) (assessing the entity's fame in the United States); Pierce-Arrow Soc'y v. Spintek Filtration, Inc, 2019 U.S.P.Q.2d 471774 (T.T.A.B. 2019) (failure to establish fame caused false suggestion of a connection claim to be dismissed); *In re* Jackson Int'l Trading Co., 103 U.S.P.Q.2d 1417, 1420 (T.T.A.B. 2012) (finding that bandleader remained a celebrity after his death and that fact supported a false suggestion of a connection finding).

262 Frank Schechter, *The Rational Basis of Trademark Protection*, 40 Harv. L. Rev. 813, 825 (1927), *reprinted at* 60 TMR 334 (1970) ("It is the gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name.").

263 *See* Gilson on Trademarks, *supra* note 8, § 5A.01[5][a]; *see also* Barton Beebe et al., *Testing for Trademark Dilution in Court and the Lab*, 86 U. Chi. L. Rev. 611, 615-16 (2019) (hereinafter "Beebe") ("[A] majority of courts have held that to establish blurring, a plaintiff need show only that consumers associate the defendant's mark with the plaintiff's famous mark. . . . A minority of courts have held that the plaintiff must show *both* consumer association *and* that this consumer association impairs the senior mark's distinctiveness of its preexisting associations. . . . [T]he statutory language appears clearly to call for the association plus impairment approach.") (emphases in original).

264 15 U.S.C. § 1125(c)(2)(B) (emphasis added).

265 15 U.S.C. § 1125(c)(2)(C) (emphasis added).

266 Moseley v. V Secret Catalogue, Inc., 537 U.S. 418, 433 (2003).

interpretation remains accurate under the current federal dilution statute. Second, the alleged harm is different. A false suggestion of a connection need not impair the distinctiveness or harm the reputation of a persona or identity. The harm is instead in the loss of a right to control the commercial use of one's name, nickname, likeness, voice, or other personal characteristic.

Finally, if a false suggestion of a connection claim is no more than a claim that the mark will remind consumers of a particular person or institution, the specter of rights in gross arises.[267] An alarmist could argue that a very famous celebrity with a unique name—say, Beyoncé or Oprah—could prevent registration of that name for essentially any good or service under the false suggestion of a connection ground.[268] But the TTAB allowed registration for ob-gyn health care consulting services to a mark that was a soundalike for the name of a famous rapper.[269] There are limits to the connections consumers will make and proving a false suggestion of a connection is a high bar.

And if the USPTO *would* refuse registration to, say, BEYONCÉ for liquid spot remover or OPRAH for vape pens as false suggestions of a connection, it would probably be correct to do so. Even if consumers wouldn't be confused, those celebrities would have lost the right to control the commercial use of their names if those marks could be registered.

VIII. FACTOR FOUR: CLAIMANT IS NOT CONNECTED WITH MARK OWNER

A claimant may be able to prove that consumers would see a connection but must also be able to prove that the suggested connection is *false*. If there is, in fact, a connection between the parties, there can be no *false suggestion of a connection*. The applicant must be an interloper trading on the other party's identity.[270]

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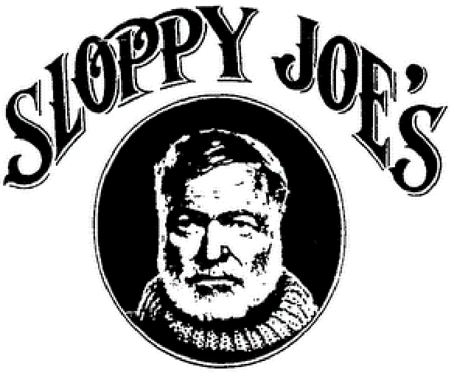
[267] *Cf.* Beebe, *supra* note 263, at 614 ("The concept of trademark dilution is as controversial as it is vague. Trademark scholars are overwhelmingly critical of anti-dilution protection, which appears to grant in gross rights to owners of qualifying marks. . . .").

[268] Note that it is *registration* and not *use* that is at stake under Section 2(a), though of course, a denial of federal registration may well lead a trademark owner to rebrand rather than lose those advantages.

[269] Young v. Burch, 2018 TTAB LEXIS 154 (T.T.A.B. 2018).

[270] *See In re* L.A. Police Revolver and Ath. Club, Inc., 69 U.S.P.Q.2d 1630, 1633 (T.T.A.B. 2003) (no false suggestion of a connection where evidence indicated "that there is a substantial commercial connection between applicant and the LAPD . . . . Clearly, applicant is no interloper trading on LAPD's slogan."); *In re* Spanky's Inc., 2003 TTAB LEXIS 362, at *7-8 (T.T.A.B. 2003) (not citable as precedent) (Where "the record raises more questions than it answers about who or what entity owns the rights" to the "Our Gang" comedies, the examining attorney did not show that the applicant was not connected with the rightsholder.); Bridgewater Candle Co., LLC v. Elephant Design Ltd., 2002 TTAB LEXIS 121, at *6 (T.T.A.B. 2002) (finding that false suggestion claim fails

The question under this prong, according to the TTAB, is whether the applicant or registrant has established some sort of commercial connection with the opposer, such as "an ownership interest or commercial endorsement or sponsorship of applicant's [or registrant's goods] or services."[271] In the main case on this point, the TTAB affirmed a refusal of registration for the mark below for bar and restaurant services based on the false suggestion of a connection with writer Ernest Hemingway:[272]



When a Key West bar and restaurant once frequented by Hemingway tried to register this mark containing his portrait, the TTAB reasoned that prospective purchasers would presume a commercial connection, such as an ownership interest in the applicant's bar and restaurant services.[273] The restaurant owner claimed that the suggestion of a connection was *true* because the writer had been a longtime patron of the restaurant, did much of his writing there, and even modeled a character after the restaurant's original owner.[274] But the TTAB sided with the examining attorney who reasoned that "spending a great deal of time in one's favorite bar is not a legally sufficient 'connection' to allow an establishment to secure trademark rights in its famous patron's likeness."[275]

"because the undisputed evidence of record . . . establishes that [the petitioner] is the assignee of [the founder of the registrant], and the successor-in-interest to her rights in the name depicted in the registered mark").

271 *Young*, 2018 TTAB LEXIS 154, at *64 (*quoting In re* Sloppy Joe's Int'l, Inc., 43 U.S.P.Q.2d 1350). *See also In re* Pedersen, 109 U.S.P.Q.2d 1185, 1192 (T.T.A.B. 2013) (charitable donations made by applicant's licensee to organizations related to institution insufficient to show commercial connection between applicant and institution).

272 *In re Sloppy Joe's Int'l, Inc.*, 43 U.S.P.Q.2d 1350.

273 *Id.* Note that Section 2(c) of the Lanham Act, which expressly bars registration of marks that incorporate portraits without authorization, only applies to living persons and so it was not relevant in this case. 15 U.S.C. § 1052(c). *See* M/S R.M. Dhariwal (HUF) 100% EOU v. Zarda King Ltd., 2019 TTAB LEXIS 95 (T.T.A.B. 2019) (dismissing claim under 2(c) where living individual cited had died during prosecution of the case).

274 *In re Sloppy Joe's Int'l, Inc.*, 43 U.S.P.Q.2d at 1353.

275 *Id.*

IX. CONCLUSION

The Lanham Act is full of surprises. A short phrase in its Section 2(a) ventures beyond protection of trademark rights to extend protection for terms or phrases a plaintiff may have never used and that do not confuse consumers as to source. The speculative trademark owner may be invoking these identities as a fan, to make a joke, or just to get people to look twice, or it might be trying more fiendishly to free ride off of another's reputation. No matter the intent, this provision has barred the registration of many such marks. The phrase has variously shielded British royalty, four words from a famous speech by Dr. Martin Luther King, Jr., and the U.S. Transportation Security Administration, among many others. While some barriers to registration in Section 2(a) have recently been extinguished by the powerful pen of the U.S. Supreme Court, claims of false suggestions of a connection live to fight another day.

AWARDING SOME PROFITS AGAINST UNINTENTIONAL INFRINGERS*

*By Tony Bortolin***

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I. INTRODUCTION

A recent U.S. Supreme Court case has thrust to the forefront the issue of whether defendants can be ordered to disgorge some of their profits in cases of unintentional trademark infringement or passing off (unfair competition).

In *Romag Fasteners, Inc. v. Fossil, Inc.*[1] the U.S. Supreme Court unanimously ruled that willfulness is not a precondition to the court's ability to award an infringer's profits under 15 U.S.C. § 1117(a) for statutory claims of unfair competition (passing off, certain trademark infringement, false or misleading use of marks, etc.) under 15 U.S.C. § 1125(a) (Sections 35(a) and 43(a) the federal *Lanham Act*, respectively).[2] The Court ruled that such violators are exposed to the possibility of having to account for profits even if they did not commit the violation willfully.

This article agrees that the courts have this authority (except as may be modified by statute),[3] but also provides a reminder of the sometimes-forgotten option of exercising that authority by awarding a percentage of those profits (rather than simply awarding all or none) taking that lack of intention into consideration as one of the factors.[4]

Such issues are important to the resolution of countless trademark conflicts that occur every day, even though few of them reach the court system, and even fewer reach trial. Such issues are also important for the purposes of discouraging trademark conflicts in the first place as countless new trademarks are decided upon every day.

As to the primary issue of whether the courts have this authority, many learned justices and commentators, in the United States and abroad, have disagreed for some 200 years. At one extreme, there has been a line of cases indicating that willfulness (intention, *mens rea*, bad faith, fraudulent intent, advertence) of the infringer (violator, defendant) need not be established and is completely irrelevant in such cases, and the author in 2016 showed some of the problems with that line of cases.[5] At the other extreme, consistent with *Romag*, this article shows the problems with an opposing line of cases attempting to hold that willfulness is, not just relevant, but an absolute precondition to the awarding of monetary relief in the form of infringer's profits. This article agrees that

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1 Romag Fasteners, Inc. v. Fossil, Inc., 140 S. Ct. 1492 (2020).

2 United States Trademark Act of 1946, as amended, Section 43(a), 15 U.S.C. § 1125(a) (also known as the "Lanham Act").

3 Part II.

4 Part III.

5 Tony Bortolin, *Intention: Is It Truly Irrelevant to the Awarding of Damages or Profits in Canada and Abroad?*, 106 TMR 1037 (2016) [hereinafter *Intention: Is It Truly Irrelevant?*].

intention is relevant but somewhere between those two extremes. The ruling in *Romag* is sound[6] and has a wide-reaching effect.[7]

The issue is somewhat complex in that trademark law is not a single cause of action; there are different types of claims (such as between infringement, passing off, commonplace false advertising) and thus the issue of whether willfulness is required for an award of profits may be different as between them. Similarly, it is understood that these causes of action are governed differently as between statutory law and judge-made common law (where applicable), and governed differently as between jurisdictions, even as between federal law and individual state or provincial law (where applicable). Further, there are distinctions between awarding profits as opposed to damages, plus a distinction between awarding all profits rather than just some. This article and some of the reasoning within *Romag* may be of interest across all these distinctions.

II. THE SOUNDNESS OF THE PRINCIPLE IN *ROMAG*

A. Scenarios to Consider

To help analyze the matter, different scenarios should be kept in mind that depend on the different degrees of honorable or dishonorable conduct of the infringer (violator, defendant) and of the trademark owner (plaintiff, complainant, victim of unfair competition).

One purpose of this is to support the position that willfulness should not be a precondition for the court to have authority to award profits. This is by drawing attention to the fact that certain non-willful infringers have not necessarily acted entirely honorably and blamelessly, but somewhat carelessly. Otherwise, some lawmakers and other readers may continue to unduly resist the availability of that authority by having only the honorable blameless infringer in mind.

Cases fall across a spectrum from non-careless violations toward careless ones and can also take into account the plaintiff's misconduct. At one extreme is the scenario where the non-willful infringer has acted carefully and honorably, coupled with dishonorable conduct by the plaintiff, such as delay of the legal action or by having committed its own misrepresentation. For example, consider where the defendant has adopted a mark without having known of the plaintiff's mark despite having conducted a detailed search and received professional advice that its mark was clear. The defendant has invested earnestly in its own marketing and in developing a good quality product under a brand that it

6 *See infra* Part II.

7 *See infra* Part II.B.

thought was available for use. It might even be in an entirely different geographical area or line of business from that of the plaintiff. As another possible example, the defendant may have understood that the mark was deemed to be an unprotectable generic term. Imagine also that the plaintiff was aware of the defendant's transgressions but purposely waited a couple of years for the defendant to build up its sales and profits. The plaintiff may have also acted with unclean hands or committed its own misrepresentations, such as improperly specifying its goods or services in its registration or prematurely displaying its mark as being "Registered." In such scenarios, it is understandable that there has been a line of cases where an accounting has been denied (but this is not to suggest such monetary relief should be denied as an absolute rule).

Moving across the spectrum, consider the scenario where the defendant conducted searches and thought that the owner of the plaintiff's mark was bankrupt but without knowing that the rights in the mark had somehow survived or been revived. Consider also if the defendant is successful at trial, and continues using its own mark, only to have the decision reversed on appeal. Again, the violation is non-willful but perhaps not entirely blameless as the defendant took a chance.

Consider next the scenario where a good-sized infringer may have stumbled along and adopted an infringing mark without being aware of the advisability of conducting a search beforehand, or perhaps it was aware of the plaintiff's mark but negligently thought that plaintiff's rights had expired or that there should be no risk of confusion due to the differences between the marks, the lines of business or the geographical areas. It is again understandable that profits have occasionally been denied but also that it should not be denied as an absolute rule, meaning that courts and lawmakers should not require willfulness as a precondition.

Consider an even more blameful scenario where the non-willful infringing conduct has been deviously suspicious. The defendant was aware of the practice of conducting searches before adopting its mark but curiously did not search the mark in issue, or the results of such searches are mysteriously gone. The defendant may have even refrained from conducting that search apparently for the very purpose of being able to claim the benefit of the line of cases requiring willfulness. That is, the defendant may have been aware of those pre-*Romag* decisions stating that it could keep all its profits if its willfulness could not be proven and seemingly took advantage of those decisions. That line of cases would have allowed this practice to continue without any profits being disgorged under the accounting of profits remedy—although again this is not to suggest that, as between careless and non-careless infringers, only the careless should be exposed to having to pay profits.[8] As submitted herein, the discretionary authority is the same (except as may be modified by statute),[9] although the courts are certainly invited to exercise that authority by awarding less than 100 percent.[10]

B. Some Foundational Support for the Ability to Award Monetary Relief Against Non-willful Infringers, and the Wide-Reaching Effect of Romag *in That Regard*

1. One of the Rationales in *Romag* Is Sound and Has the Widest-Reaching Effect

The ruling in *Romag*[11] is not only sound but should be binding where applicable and otherwise have significant influence on courts and lawmakers in various jurisdictions and in respect of various trademark causes of action regarding the judicial discretion to award monetary relief, at least in the form of profits, as against a non-willful infringer. This flows from one of the grounds of the ruling. It could have been mentioned more clearly,[12] but, simply stated, the court cannot fetter its equitable jurisdiction.

To explain, it will be recalled that the decision expressly focuses on the availability of an accounting of profits under § 1117(a) for violations of § 1125(a) regarding statutory passing off (and other forms of unfair competition). Much of the decision was an exercise in statutory interpretation as to whether Congress had implicitly intended that profits cannot be recovered as against non-willful defendants under such legislation. The Court concluded Congress had not so intended. In short, the Lanham Act uses mental states within certain provisions but not in § 1117.

More significantly for present purposes, § 1117(a) provides that the plaintiff shall be entitled to recover the defendant's profits "subject to the principles of equity"—meaning the case law pursuant to the court's discretionary authority as inherited from the courts of

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8 As a matter of interest, the scenario in *Romag* was that the defendant designed and marketed handbags and made a deal with the plaintiff to use the plaintiff's magnetic snap fasteners. But then the plaintiff discovered that the factories in China hired by the defendant to put together the products were using counterfeit fasteners. The Court noted that the defendant "was doing little to guard against the practice" and that the jury found that the defendant had acted "in callous disregard" of the plaintiff's rights, albeit without having acted "willfully." 140 S. Ct. 1495. As discussed in this article, at least some of the Court's rationale nevertheless focused more generally on the authority to be able to award profits as against any non-willful infringers. Also, nothing in this article is intended to criticize or condone either party's overall conduct in *Romag*.

9 *See infra* Parts II.

10 *See infra* Part III.B.

11 *See infra* text accompanying note 1.

12 *Id.* at 1495–1496.

equity. The appellant's final ground of appeal was that those principles called for willfulness as a precondition to such relief, but the Court rejected this.[13] Despite the line of cases favoring that precondition, the Court held that the principles of equity do not absolutely call for it.

To explain further, any judicial decision attempting to stipulate willfulness as a precondition to an accounting of profits would have constituted an improper self-restriction of the court's equitable authority. That is, the ruling in *Romag* is sound in that there should be no inflexible preconditions or limitations to the court's jurisdiction to grant equitable relief (except as may be legislated). In particular, the Court referred to its decision in *eBay Inc. v. MercExchange* (2006).[14] In that case, the Court had vacated the ruling below on the basis that:

> [The Court of Appeals had] articulated a "general rule," unique to patent disputes, "that a permanent injunction will issue once infringement and validity have been adjudged.". . . [But j]ust as the District Court erred in its categorical denial of injunctive relief, the Court of Appeals erred in its categorical grant of such relief.[15]

So, in the same way there should be no categorical grant or denial of equitable relief in the form of injunctive relief, there should be no categorical grant or denial of equitable relief in the form of an accounting of profits. The Court in *Romag* acknowledged that the accounting remedy against innocent infringers has often been denied, but this tendency should not be treated as a categorical rule. This would be an improper self-restraint on the courts' jurisdiction to grant equitable relief. While the courts should certainly develop guiding principles regarding equitable relief in the interests of consistency and predictability, the courts should not restrain their own ability to take into consideration all the relevant factors as may be established in the case at hand.[16]

The significance of this rationale is that it carries over to other fields of law and other jurisdictions where the granting of an accounting of profits is again a matter of the court's equitable jurisdiction, which may be the case whether the cause of action is pursuant to common law or pursuant to a provision that

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13 This was effectively unanimous because all of the justices rejected the appeal, and thus rejected this ground of appeal.

14 547 U.S. 388 (2006) ("*eBay 2006*").

15 *Id*. at 393–94 (2006).

16 Consistent with this principle, note how all of the justices in *eBay 2006* carefully referred to the test for deciding whether to grant injunctive relief as a "four-*factor* test" (rather than a "four-*part* test"). The Court was seemingly careful to not itself restrict the discretionary ability to grant or deny injunctions.

incorporates equity.[17] This is valuable in that, as discussed further below, other common-law jurisdictions have similarly struggled with the issue of whether willfulness should be required or not for such monetary relief.[18] While the decision of the U.S. Supreme Court is obviously not binding in other jurisdictions, it is hard to see how courts in these other jurisdictions (having equitable authority) can take the view that willfulness is a precondition upon understanding that this would be an improper self-restraint of that authority. Willfulness should not be an absolute precondition for an accounting of profits, except, of course, where willfulness is expressly required as an element of the cause of action or otherwise by the applicable legislation.[19]

Within the United States, the decision should be binding in respect of state causes of action (whether under the state trademark legislation or the state common law). Again, it is hard to see how the U.S. Supreme Court could rule as it did in *Romag* but then turn around on an appeal from a state matter one day and rule that the courts can restrain that jurisdiction such that willfulness is a precondition.

It is also submitted that willfulness should not be a precondition (to the ability to award of profits) in other jurisdictions and in other fields of trademark law taking into account the jurisprudence[20] and certain policy concerns.[21] This applies to judge-made rules of equity and to legislators when drafting or amending legislation.

2. Extended Effect Especially in Respect of U.S. Federal Cases

The ruling should especially have certain extended effect in the United States even separate from the above rationale of not being able to self-restrain equitable jurisdiction. This flows from the fact that § 1117(a) is a general remedy provision that expressly applies to any "violation of any right of the registrant of a mark registered in the Patent and Trademark Office." Thus, in having ruled that the "principles of equity" do not include a precondition of willfulness in order to recover profits, that ruling inherently applies to violations

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[17] For example, the Canadian trademark statute contains a general civil remedy provision in respect of any act contrary to that statute (including trademark infringement, statutory passing off, certain false advertising, trade libel, etc.) by which "the court may make *any order that it considers appropriate in the circumstances*, including an order providing for relief by way of injunction and the recovery of damages or profits"; s. 53.2 of the Canadian Trademarks Act, R.S.C. 1985, c. T-13 as amended (emphasis added).

[18] *Infra.*

[19] As mentioned in *Romag* itself, willfulness is expressly stipulated, for example, as a condition in the U.S. statutory claim for dilution, whether for profits or damages; § 1125(c)(5)(B). Romag Fasteners, Inc. v. Fossil, Inc., 140 S. Ct. 1492, 1493 (2020).

[20] *See infra* Part II.C.

[21] *See infra* Part II.D.

of registered marks under the U.S. federal statute including § 1114(1).

That is, even though the opinions in *Romag* expressly addressed violations of "§ 1125(a)" (which focuses on passing off and the like), *Romag* equally applies to violations of registered marks contrary to § 1114(1). This also flows from the fact that the Court recognized that the jury found both "trademark infringement" and passing off. Further, the defendant was actually found liable at trial for violating not just § 1125(a), but also § 1114(1), as the plaintiff's mark was registered.[22] Still further, when the Court discussed cases that did or did not require a showing of willfulness for the purposes of an accounting, the Court did not distinguish between those involving such different types of violations as if rule should be different between them. *Romag* thus effectively ruled that willfulness is not required for the purposes of an accounting of profits, whether for statutory passing off or infringement of trademarks, under the U.S. trademark statute.

Similarly, § 1117(a) expressly applies to any "violation under section 1125(a)" and that provision in turn includes, not just statutory passing off (and other forms of unfair competition) under § 1125(a)(1)(A), but also the civil claim for false advertising under § 1125(a)(1)(B). Thus, *Romag* also should apply to those U.S. federal civil claims for false advertising.

3. Willfulness Is a Relevant Factor, Perhaps Even Regarding Damages

Another effect of *Romag* is that it inherently overruled the line of authorities that suggested willfulness is completely irrelevant.[23] While *Romag* did not expressly refer to all those authorities (let alone to the multiple mix-ups within those authorities[24]), it implicitly disagreed with them by not adopting them as part of its ruling that willfulness is not required for the purposes of awarding an accounting; the Court did not say willfulness is not required for that remedy on the basis that willfulness is completely irrelevant in such causes of action. To the contrary, even though it ruled that willfulness is not *required* for an award of profits, the Court stated "a trademark defendant's mental state is *a highly important consideration* in determining *whether* an award of profits is

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22 Romag Fasteners, Inc. v. Fossil, Inc., 29 F. Supp. 3d 85, 90 (D. Conn. June 27, 2014), *vacated in part by* 686 F. App'x 889 (Fed. Cir. 2017). The decision opens by stating that the jury found the defendants liable "for trademark infringement, false designation of origin, state common law unfair competition, and violation of the Connecticut Unfair Trade Practices Act ('CUTPA')." 29 F. Supp. 3d 90.

23 Some of such cases suggesting that willfulness is irrelevant are discussed *infra*, and also in *Intention: Is It Truly Irrelevant?*, *supra* note 5, at 1038-45.

24 These mix-ups are discussed in *Intention: Is It Truly Irrelevant?*, *supra* note 5.

appropriate."[25] "[A] defendant's mental state is relevant to assigning an appropriate remedy."[26] So, intention is obviously not completely irrelevant in such causes of action; it has this intermediate role. And, again, *Romag* may persuade other jurisdictions to take or maintain the same view in this respect as well.

Romag implicitly has another effect: even apart from stating that willfulness is not required for an accounting of profits, the decision suggests that willfulness is not required for *damages*. This is another issue where the law has been less than clear—again depending upon the jurisdiction, cause of action, and time period[27]—and thus the decision appears to be significant in this respect as well.

Romag has this effect in that the general remedy provision discussed in the decision, § 1117(a), expressly provides that the "principles of equity" apply not just to the recovery of "defendant's profits," but also "any damages sustained by the plaintiff."[28] Therefore, in having interpreted the judge-made "principles of equity" in such a way that an accounting of profits can be awarded as against non-willful infringers, the Court has confirmed or otherwise indicated that damages can also be awarded in such cases.

This too is derived from the above-mentioned understanding that the court should not restrain its equitable authority. The Court would be hard-pressed to rule one day that willfulness is a precondition for damages under the principles of equity, having ruled in *Romag* that it is not a precondition under those principles for the purposes of an accounting.[29]

From a practical matter, it is entirely reasonable that willfulness should not be a precondition (albeit a factor) for the purposes of either form of monetary relief. This flows from the simple fact that both forms of relief constitute an award of money. While the two forms of monetary relief have different origins (and a plaintiff is not entitled to both forms of relief in the same case), the concepts obviously overlap to the extent a certain amount of money would be awarded under either form.

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25 Romag, 140 S. Ct. at 1497 (emphasis added). Even in the concurring opinion of Justice Alito, it was stated "The relevant authorities, particularly pre-Lanham Act case law, show that willfulness is a highly important consideration in awarding profits under § 1117(a), but not an absolute precondition." *Id.*

26 *Id.*

27 *See* some cases on point *infra* Part II.C.

28 "[T]he plaintiff shall be entitled . . . subject to the principles of equity, to recover (1) defendant's profits, (2) *any damages sustained by the plaintiff*, and (3) the costs of the action" 25 U.S.C. § 1117(a) (emphasis added).

29 For at least a couple of cases noting that the principle ought to be handled similarly as between damages or profits, *see infra* text accompanying notes 68, 82, 84.

As such, at least a certain amount of money should be available under either rubric—otherwise the principles under one or the other would not be just. Coincidently, those principles have already been converging whereby the monetary gap has substantially decreased. For example, damages are not always limited to the plaintiff's lost profits on sales diverted by the defendant; they sometimes include a reasonable, hypothetical royalty (nominated by the court[30]) and the cost of corrective (responsive, remedial) advertising (such as to address the damage to the reputation, signification, or goodwill of the plaintiff's business or trademark[31]).

So, if an accounting of profits is available in the applicable jurisdiction as against a non-willful infringer, damages should also be available, at least for an amount of money comparable as would otherwise be available by way of an accounting of profits; and if damages are available in another jurisdiction against a non-willful infringer, an accounting of profits should be available, at least for an amount of money comparable as would otherwise be available by way of damages.

4. Willfulness Not an Element of Liability

As another aside, the ruling in *Romag* effectively indicated that willfulness is not a required element of liability. The issue of liability is often conflated with the issue of monetary relief; the issues overlap but are not identical. Obviously, monetary relief might be denied while the court might still award injunctive relief or declaratory relief, etc.

This effect of *Romag* may have been unintended, but it inherently flows from the ruling, and it would be difficult for the Court to go back one day and say intention is an element of liability. To explain, in reversing the court below and ruling that willfulness is not required for the purposes of obtaining a disgorgement of profits, the Court effectively indicated that willfulness is not required for the purposes of liability. After all, if willfulness was a required element, the Court would not have reversed the court below; it would have simply stated that the specific issue in *Romag* was moot on the basis that willfulness is a required element of liability. It would have been moot because, if willfulness were required for liability to start, then willfulness would already be established whenever the court reaches the issue of remedies. This

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30 *See, e.g.*, Order Denying in Part and Granting in Part Plaintiff's Motion for Partial Summary Judgment, and Denying Defendant's Motion for Partial Summary Judgment, QS Wholesale, Inc. v. World Mktg., Inc. (C.D. Cal. May. 9, 2013); Sands, Taylor & Wood Co. v. Quaker Oats Co., 978 F. 2d 947, 963 & n.19 (7th Cir. 1992); Irvine & Ors. v. TalkSport Ltd., [2003] EWCA Civ 423 (England and Wales CA) at paras. 97–108.

31 *See, e.g.*, Bracco Diagnostics, Inc. v. Amersham Health, Inc., 627 F. Supp. 2d 384, 491–492 (D.N.J. 2009).

interpretation of *Romag* is further supported by the above-mentioned indication in the decision that willfulness should be taken into consideration, as a factor, in deciding whether to award the accounting remedy;[32] taking it into consideration as a factor for that remedy would have been meaningless if the Court believed that willfulness should already be established for the purposes of liability.

The soundness of the ruling in *Romag* is discussed next, especially in terms of jurisprudential support.

C. Jurisprudential Support for the Ability to Award Monetary Relief Against Non-willful Infringers

1. Introduction

The ruling in *Romag*—that willfulness is not an inflexible precondition to the possibility of an accounting of profits[33]—is sound on a number of grounds. This section focuses on some additional support for the ruling, and some weaknesses in the case law to the contrary.

The discussion is complex in view of the above-mentioned distinctions and similarities as between different causes of action, different jurisdictions, different time periods and also the different forms of monetary relief. This discussion is also lengthy in terms of favoring decisions that support *Romag* to help offset the impression that the weight of authority was against it.[34]

2. Some General Support and Background

As mentioned above,[35] in having ruled, as it did, that equitable relief in the form of an accounting can be awarded despite non-willfulness, the Court in *Romag,* perhaps unknowingly, stepped into a debate dating back to the 1800s as to whether the causes of action in the field are better handled as traditional torts (founded in the courts "at law" and otherwise typically requiring specific intent, especially as in the tort of deceit, and with monetary relief being awarded as damages)[36] or as a form of property (founded in the courts "of equity" and typically not requiring intention, with monetary relief being in the form of an accounting of profits).

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32 *See supra* text accompanying notes 25–26.

33 *See supra* text accompanying notes 25–26.

34 This impression of the weight of authority was expressed, for example, by Sotomayor J. in her concurring judgment in *Romag*, 140 S. Ct. at 1498.

35 *See supra* Part II.B.

36 For example, in 1889, Lord Esher said: "If you were asking for damages . . . *you have to prove he had intended it*. You would have to prove that what he was doing was fraudulent. *That is clear*. . . ." Turton v. Turton (1889), 42 Ch D 128, 137–39 (CA) (emphasis added).

Nevertheless, the law generally evolved, both in the United Kingdom and the United States, so as to justify monetary relief for infringing conduct (despite non-willfulness) on other grounds, such as treating trademark rights and business goodwill as property or quasi-property, as somewhat discussed below. In justifying such relief as against such wrongdoers, analogies have also been made to laws or principles of patents, copyright, restitution, unjust enrichment, and awarding monetary relief for someone inadvertently working your mine or cutting your trees for timber.[37]

Many may still emphasize that passing off is based on the tort of deceit, which requires willfulness (*mens rea*), and thus that passing-off laws have evolved inappropriately in treating such rights as property and thereby permitting substantial monetary relief even for unintentional harm. But, in simplified terms, consider that even the laws of tort in general have evolved so as to award monetary relief for unintentional harm, including the cause of action for negligent misstatement.[38] It is thus understandable that defendants can be held to pay monetary relief for harm caused to another trader by their negligent misrepresentations to the public regarding quality or source of their goods, or by using the other trader's mark (as covered by the causes of action against infringement, passing off, unfair competition).

For example, in *Hamilton-Brown Shoe Co. v. Wolf Brothers & Co.* (1916), the Court stated that trademark rights constitute a kind of property and thus principles of equity apply, analogous to that which charges a trustee with the profits acquired by wrongful use of the property.[39] In particular, Pitney J. said:

> The right to use a trademark is recognized <u>as a kind of property</u> . . . The infringer is required in equity to account for and yield up his gains to the true owner, <u>upon a principle analogous to that which charges a trustee with the profits acquired by wrongful use of the property</u> of the <u>*cestui que trust*</u>. Not that equity assumes jurisdiction upon the ground that a trust exists. As pointed out in *Root v. Railway*, 105 U.S. 189, 105 U.S. 214, and *Tilghman v. Proctor*, 125 U.S. 136, 125 U.S. 148 (patent cases), the jurisdiction must be rested upon some other equitable ground —in ordinary cases, as in the present, the right to an injunction—but the court of equity, having acquired jurisdiction upon such a ground, retains it for the purpose of administering complete relief,

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37 *See, e.g.*, Roulo v. Russ Berrie & Co., Inc., 886 F.2d 931, 941 (7th Cir. 1989): "Profits are awarded under different rationales including unjust enrichment, deterrence and compensation." Some other cases are mentioned *infra*.

38 As derived from the famous judicial comments in *Hedley Byrne & Co Ltd. v. Heller & Partners Ltd.*, [1963] UKHL 4.

39 240 U.S. 251, 259 (1916). (Issued on February 21, the same day as *Straus v. Notaseme*, which is discussed *infra* in text accompanying notes 89–96, 143.)

> rather than send the injured party to a court of law for his damages. And profits are then allowed as an equitable measure of compensation, on the theory of a trust *ex maleficio*.[40]

Whether it was a coincidence or not, trademark rights were prominently treated as a form of property just one year earlier by Lord Parker in the decision of the House of Lords in *Spalding v. Gamage* (1915).[41] It is still cited for this principle[42] and the case is discussed further below.[43]

Even prior to *Gamage*, this basis of entitlement was recognized, albeit reluctantly, by Kekewich J. in *Saxlehner v. Apollinaris Co.* (1897).[44] The exclusive right to use a common law trademark was treated as "a species of property carrying with it all the rights and remedies incidental to property, *and that, therefore, the account of profits follows the injunction as a matter of course, as it does when a successful Plaintiff asks it in a patent case*."[45]

The above-mentioned theory of a trust *ex maleficio*[46] was reiterated in at least one of the cases cited in *Romag*, namely, the passing off case of *L.P. Larson, Jr., Co. v. Wm. Wrigley, Jr., Co.* (1928).[47] Justice Oliver Wendell Holmes explained: "To call the infringer an agent or trustee is not to state a fact, but merely to indicate a mode of approach and an imperfect analogy by which the wrongdoer will be made to hand over the proceeds of his wrong."[48]

The ruling in *Romag* was thus sound in view of the above.

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40 *Id.* (emphasis added).

41 A.G. Spalding & Bros. v. A.W. Gamage Ltd. (1915), [1914-15] All ER Rep 147.

42 For example, in *Glaxo Wellcome UK Ltd. & Anor v. Sandoz Ltd. & Ors.,* EWHC 2545 (Ch) (2019), the court stated: "Although the action for passing off evolved from the tort of deceit, it is not a necessary ingredient of passing off that the misrepresentation was deliberate. It is established by the highest authority that the misrepresentation may be an innocent one: see, e.g., *A G Spalding & Bros v A W Gamage Ltd* (1915) 32 R.P.C. 273 at 283 (Lord Parker of Waddington)." [2019] EWHC 2545 (Ch) at para. 182.

43 *See infra* text accompanying note 84 *et seq*.

44 (1897), 14 R.P.C. 645, 656–7.

45 *Id.* (emphasis added). To be specific, no accounting was awarded in that case under the cause of action for passing off (in the classical sense, in that no sales had been diverted by the defendant because it had used the plaintiff's mark with distinguishing markings). But an accounting was nevertheless awarded under the cause of action for trademark infringement at common law.

46 *See supra* text accompanying note 40.

47 277 U.S. 97, 99–100 (1928).

48 *Id.* While the defendant was not innocent in that case, the principle was discussed as being applicable nevertheless, although the quantum may be lesser in cases of innocence, as mentioned in Part III.B.

3. Weaknesses of the Reliance Upon *Siegel-Cooper*

Romag was also sound when considering the weaknesses of some of the cases that required willfulness for an accounting. The majority in *Romag* cited two such cases.[49] Of those two, the more prominent was *Saxlehner v. Siegel-Cooper Co.* (1900).[50] It is discussed next while the lesser known 1931 case is better discussed below in the context of policy.[51]

Saxlehner v. Siegel Cooper Co. was the lead decision in the defendant's brief[52] and in the amicus brief supporting the requirement of willfulness for an accounting.[53] But when properly read, *Siegel-Cooper* did not expressly state any rule that willfulness was a precondition to an order for an accounting of profits. Brown J., in delivering that opinion, simply indicated that, taking into account the lack of willfulness, an accounting was not justified in that case. If the Court had intended to declare a rule that willfulness should be a precondition, the Court would have said so (and, even if it had, it would have been unsound for the other reasons discussed in this article, including the fact that the courts can hardly fetter that discretion).

Further, the decision below was reversed regarding the denial of injunctive relief. In that regard, Brown J. stated: "We think that an injunction should issue against all these defendants . . ."[54] "The fact that the Siegel-Cooper Company acted innocently does not exonerate it from the charge of infringement."[55] Then, as to the issue of profits, he stated, "as the Siegel-Cooper Company appears to have acted in good faith and the sales of the others were small, they should not be required to account for gains and profits."[56] This narrow wording hardly supports an absolute rule forever constraining the court's equitable jurisdiction to award an accounting of profits. Again, the Court was simply exercising its discretion based upon the specific circumstances of the case.

This interpretation of *Siegel-Cooper* is further supported by the fact that the decision was delivered in conjunction with two other

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49 140 S. Ct. 1492 at 1496 (citing Horlick's Malted Milk Corp. v. Horluck's, Inc., 51 F.2d 357, 359 (W.D. Wash. 1931) and Saxlehner v. Siegel-Cooper Co., 179 U.S. 42, 42-43, 21 S. Ct. 16, 45 L. Ed. 77 (1900)).

50 179 U.S. 42 (1900).

51 *Infra* Part II.D.

52 Fossil's Brief in Part II.C.1 (available at https://www.supremecourt.gov/DocketPDF/18/18-1233/100713/20190522164830590_01145334.PDF).

53 IPO's amicus brief, Part II, (available at https://www.supremecourt.gov/DocketPDF/18/18-1233/116499/20190920124951722_18-1233_Romag Fasteners Inc. v. Fossil Inc. et al._IPO Amicus Brief.pdf).

54 179 U.S. at 42.

55 *Id.* at 43.

56 *Id.* at 42–3 (emphasis added).

trademark decisions involving the same plaintiff. One of those was *Saxlehner v. Eisner & Mendelson Co.* (1900),[57] and Brown J., again speaking for the Court, concluded in that case:

> *While this label may have been adopted in good faith*, we do not think its employment would prevent the casual customer from purchasing this water as that of the plaintiff, and that the injunction should also go against its use and that *plaintiff should recover her damages therefor*.[58]

Thus, damages were awarded by the U.S. Supreme Court despite good faith. And recall the above-mentioned submission that, if the laws of damages can justify a certain quantum of monetary relief, it would inherently be just and equitable (subject only to the particular circumstances) that a similar quantum be available by way of profits.[59] *Eisner & Mendelson* thus supports the availability of substantial monetary relief despite good faith.

The above is not intended to go so far as to say that, as suggested in *Eisner & Mendelson*, substantial monetary relief should always be awarded despite good faith. The above is simply to negate the long-standing interpretation of *Siegel-Cooper* as if substantial monetary relief cannot be awarded in such cases. This is because it is unlikely that the Court would issue conflicting decisions on the very same day. This proper understanding of *Siegel-Cooper* is important in that subsequent cases and authorities may have mischaracterized it as if it had declared a rule, and then other cases and authorities simply applied the so-called rule, snowballing into a line of authorities.

4. Weaknesses of Some Other Cases Purportedly Requiring Willfulness for Monetary Relief

While not mentioned in *Romag*, another decision that has been cited in support of the willfulness requirement for an accounting is *Lawrence Manufacturing Co. v. Tennessee Manufacturing Co.* (1891).[60] It was described in a 1903 article as having been "repeatedly cited as authority for the doctrine that fraud is an indispensable element of unfair competition."[61] The author then explains that *Lawrence Manufacturing* should not have been cited as such because the comments along those lines within the decision were misread or superfluous.[62]

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57 179 U.S. 19 (1900).

58 *Id.* at 41 (emphasis added).

59 *See supra* Part II.B.3.

60 138 U.S. 537 (1891) (*per* Fuller C.J.).

61 ER Coffin, *Fraud as an Element of Unfair Competition,* 16 Harv. L. Rev. 272, 282 (1903).

62 *Id.* at 281–82. Simply put, while the decision implied intention is required, the Court did not actually say so. It was established that the plaintiff did not have a valid exclusive

Reliance upon *Lawrence Manufacturing* can be further questioned as the Court in that case relied upon its prior decision in *McLean v. Fleming* (1877),[63] which was itself weak on that point. Justice Clifford, speaking for the Court in *McLean v. Fleming*, stated that an accounting of profits "is constantly refused [where there is a] want of fraudulent intent."[64] Obviously, in saying "constantly" refused, the Clifford J. could have simply been observing a trend in such cases, just as he had observed regarding the refusal of such relief in cases of acquiescence, delay, or cessation after being notified of the infringement—all as mentioned within the same passage. As such, *McLean v. Fleming* does not appear to have been an attempt to forever restrain equitable authority to grant any profits in all such scenarios.

In addition, Clifford J. made the above observation (regarding profits being "constantly" refused) by citing half a dozen U.K. common-law decisions.[65] But, as mentioned above[66] and below, that common-law jurisprudence evolved, and the rules of equity permitted monetary relief to be awarded where money was earned unjustly. Of those cases, the most prominent was *Edelsten v. Edelsten* (1863).[67] So, in terms of following authority in the United States and the United Kingdom, the line of cases calling for willfulness as a precondition to awarding profits seems to trace back to that decision. Significantly, Lord Westbury in *Edelsten* commented:

> [I]t is well founded in reason, and also settled by decision, that if A. has acquired property in a trade mark which is afterwards adopted and used by B. in ignorance of A.'s right, A. is entitled to an injunction; *yet he is not entitled to any account of profits or compensation, except in respect of any user by B. after he became aware of the prior ownership.*[68]

The second principle in the quoted text (herein the "*Edelsten* dictum") indicates that a violator is not liable for profits or compensation during the time that it is not aware of the plaintiff's

right in its mark, plus the defendant's mark was sufficiently different as to avoid confusion, and the plaintiff still claimed relief on the basis of the defendant's mere fraudulent intention to deceive. As such, the decision did not really support the subsequent cases that required intention, especially for monetary liability within the field. The court's comments in denying a claim based on fraudulent intention alone may have implied fraudulent intention was required, but the Court was simply trying to indicate that *misrepresentation (deceit, confusion)* was required. *Lawrence Mfg.*, 138 U.S. at 551 (It "must be made out or be clearly inferable from the circumstances.").

63 96 U.S. 245 (1877).

64 *Id.* at 257.

65 *Id.*

66 *See supra* text accompanying notes 37–48.

67 1 De Gex J & Sm 185, 46 ER 72; 7 LT (Ch) 768.

68 1 De Gex J & Sm 185, 199 (emphasis added).

rights. This seemingly represents the point at which the defendant is considered to no longer be acting non-willfully, and otherwise not exposed "to any account of profits or compensation." It is this dictum that can be understood (as it was in *McLean v. Fleming*) as having been the authoritative foundation of the line of cases calling for willfulness as a precondition.[69] While much has already been written regarding the *Edelsten* dictum, the following are some additional comments.

In stating the *Edelsten* dictum, Lord Westbury may have had in mind the judicial comments of the same effect as found in in *Crawshay v. Thompson* (1842).[70] But that was one of the early cases in the courts at law, meaning intention was required for the purposes of liability and for a full award of damages.

The overall quote from *Edelsten* is also reminiscent of *Millington v. Fox* (1838).[71] The defendant in that case had ceased infringing after being advised of the plaintiff's rights, and no profits were awarded. But profits were not awarded in *Millington* pursuant to any absolute rule; instead, profits were not awarded because that relief was "of so infinitely minute importance" that the plaintiffs "very discreetly" abandoned its request for profits.[72] The court would not have provided such explanations if the court was of the view that profits should, as a rule, be denied as against innocent violators. And the decision was in a court of equity, meaning it should have been well aware of not restraining its own authority.[73]

Consider also that, despite the *Edelsten* dictum, some judges have not awarded monetary relief for infringing activities after the point of notice. That is, while the dictum indicates the plaintiff "is not entitled to any account of profits or compensation" prior to becoming "aware of the [plaintiff's] prior ownership" of the mark, the dictum also indicates the plaintiff "is . . . entitled to [an] account of profits or compensation . . . after [the infringer] became aware of

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69 The *Edelsten* dictum was also seemingly followed in the drafting of the defense in § 1111 of the Lanham Act, which is discussed *infra* in the text accompanying note 137.

70 134 ER 146. Justice Maule said "It is argued that, supposing the defendants marked their iron in a way calculated to deceive other parties, although they had no intention of doing so, *yet <u>if they were told that such was the effect</u> of using the mark*, and they still continued to do so, they are *<u>liable to an action</u>* [at law]. But I cannot quite accede to that position. If a party is *merely told* that by continuing to do a certain thing he may deceive others, and he continues to do the thing without any intention to produce that effect, I do not think that an action will lie against him—at any rate, certainly not in this form of declaration [meaning for damages at law in a case where the marks were not admittedly or obviously confusing]." *Id.* at 157 (emphasis added). Justice Cresswell expressed the same thought in the same case where he said: "The notice here . . . cannot alter the legal rights of the parties. . . . [S]uch a notice [by the plaintiff] is *not equivalent to knowledge*; as the defendants might dispute the resemblance." *Id.* at 158 (emphasis added).

71 3 Myl & Cr 338, 40 ER 956 (Ch) per LC Cottenham (acting in first instance).

72 *Id.*

73 Such reluctance or inability is discussed *supra* in Part II.B.1.

the prior ownership." But even the latter tenet has not been followed as an absolute rule. That is, it is hard to see how one tenet in the *Edelsten* dictum should be treated as an inflexible rule (a fixed restraint on the court's discretion) while the other is treated as a mere guideline. An example is the case of *N.K. Fairbank Co. v. Windsor* (1903).[74] It may appear to be another case in favor of the precondition of willfulness. The Second Circuit appeared to rule that damages and profits are not available in cases of good-faith passing off (unfair competition).[75] But the court simply ruled against the submission that such relief should be automatically granted after the defendant had notice of the plaintiff's rights. It denied such relief, and this was based on the facts of that case, meaning upon the court's discretion. The court was confronted with the awkward situation where the unlawful sales had occurred between the trial decision (where it was decided that the defendant's predecessor was not committing unfair competition because the packaging was not sufficiently similar) and the appeal decision (where that trial decision was reversed). The court may thus have been so concerned about absolving the defendant in that particular case that the court expressed its reluctance (to award monetary relief) too strongly. It is also notable that the court happened to confirm that the authority to award such monetary relief was based in equity (which did not require intention) rather than the traditional laws of intentional tort.[76] In view of all the above, the *Edelsten* dictum does not define any hard rules as to when to award or deny monetary relief as otherwise evolved in the line of cases calling for willfulness.[77]

Still further, the simple fact is that the *Edelsten* dictum was superfluous commentary as the defendant had been aware of the prior rights and had acted with fraudulent intent.[78] It was not a case where the court had to analyze whether monetary relief should be awarded or denied as against a non-willful infringer, let alone whether such relief should be denied as a rule, as if the court had no authority to award it. In fact, it is difficult to find any case in that era where monetary relief was denied despite the infringer having acted carelessly or suspiciously (and that fully considered all of the reasons for such authority as discussed in this article). And if the courts had equitable authority to award monetary relief against

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74 124 F. 200 (2d Cir. 1903).

75 *Id.* at 201–02. (*E.g.*, "[T]here can be no recovery unless the court is satisfied that there has been an intent on the part of defendants to palm off their goods as plaintiff's").

76 The court needed to do so because the defendant had not appealed the order for profits, but the court wanted to reverse. It was thus inconsistent to confirm the equitable nature of the relief for that purpose, while saying the cause of action of unfair competition requires intention.

77 *See also infra* text accompanying notes 89–96.

78 1 De Gex J & Sm 185, 201–202, 202, 203.

careless or suspicious non-willful infringers, they had that authority as against non-careless non-willful infringers.

About one year after *Edelsten*, the dictum in that case was applied in *Moet v. Couston* (1864).[79] The defendant had purchased a batch of products from a supplier without knowing they were counterfeit.[80] No monetary relief was awarded. Sir Romilly, M.R. said, if a defendant "buys goods from a third party, believing them to be genuine, while in fact they are spurious, it is not until he has been told that they are so that he can be . . . liable to render any account."[81] But again, there was no analysis of all of the reasons in support of the authority to possibly award that relief.

The same can be said regarding *Slazenger v. Spalding* (1910) where Neville J. applied the *Edelsten* dictum and said it "is binding," even in cases for infringement of registered marks.[82] Profits were denied as against an infringer insofar as it acted non-willfully, and Neville J. said the rule should also apply to the availability of damages: "I think that nowadays there is no distinction between an account of profits and an inquiry as to damages" in the sense that a successful plaintiff may elect either form of relief (subject to *Edelsten*).[83]

But the *Edelsten* dictum was soundly treated as a mere guideline (and as applying to damages as well as profits) in the prominent 1915 decision of the House of Lords in *Spalding v. Gamage*.[84] Lord Parker reworded the dictum as follows:

> [The misrepresentation need not] be fraudulently made. It is enough that it has in fact been made, whether fraudulently or otherwise, and that *damages* may probably ensue, *though the complete innocence* of the party making it *may* be a reason for *limiting* the *account of profits* to the period subsequent to the date at which he becomes aware of the true facts. [Regardless of innocence t]he representation is in fact treated as *the invasion of a right* giving rise *at any rate* to nominal damages, the inquiry being granted at the plaintiff's risk if he might probably have suffered more than nominal damages."[85]

This passage (referred to herein simply as *Gamage*) has been interpreted in contradictory ways. It has strangely been interpreted by some as requiring willfulness, while others have more soundly

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79 33 Beav. 578; 55 ER 493; 10 LT Rep (NS) 395 (Sir Romilly, M.R.).

80 This fact situation was handled differently recently as discussed at the end of this Part.

81 10 LT Rep (NS) 395, 396.

82 27 R.P.C. 20, 24.

83 *Id.*

84 A.G. Spalding & Bros. v. A.W. Gamage Ltd. (1915), [1914-15] All ER Rep 147.

85 *Id.* at 149.

understood it as a mere dictum (in the sense of a superfluous, nonbinding comment that was not necessarily argued), meaning willfulness is not required for monetary relief as against unintentional violators.

It has been interpreted as requiring willfulness, for example, by Windeyer J. of the High Court of Australia in *Colbeam Palmer Ltd. v. Stock Affiliates Pty. Ltd.* (1968).[86] But Lord Parker within the *Gamage* dictum had carefully said that such innocence "may" be a reason for limiting the recovery. This careful wording is understandable in view of the above-mentioned concerns that the courts should not, and probably cannot, restrict their own equitable jurisdiction, and that there may be cases where the infringer should nevertheless be exposed to monetary relief despite non-willfulness. This interpretation of *Gamage* also flows from Lord Parker's emphasis elsewhere in the decision on the idea that the cause of action constitutes an "invasion of a right," which is in essence a claim of absolute liability based on property rather than the laws of tort traditionally requiring intention. Similarly, Lord Parker had said: "It is sufficient to say that the misrepresentation being established, and being in its nature calculated to produce damage, the plaintiffs are *prima facie* entitled both to an injunction *and to an inquiry as to damage* . . . ."[87] These statements support the interpretation that monetary relief is available despite good faith. It is thus understandable that *Gamage* has, in turn, been seen as authorizing monetary relief in such cases at least in the form of damages (especially as *Gamage* itself was a case of relief in the form of damages).[88]

About one year later followed the decision of Justice Holmes in the passing off case of *Straus v. Notaseme Co.* (1916).[89] Some cite this decision as if it supports the call for willfulness as a precondition because it was a case where the Court lifted the award for profits against an innocent infringer. But this is not a proper reading. It was an instance of the court simply exercising its discretion. Justice Holmes' decision is instead consistent with the latter interpretation of *Gamage*, and two aspects of the ruling in *Romag*, namely, that intention is not a precondition for an award of

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86 [1972] R.P.C. 303 (Aus HC). He favored the willfulness requirement for an accounting even in a case of infringement of a mark that is registered, and said, "it lies upon a plaintiff who seeks an account of profits to establish the profits were made by the defendant *knowing* that he was transgressing the plaintiff's rights." *Id.* at 310 (emphasis added).

87 [1914-15] All ER Rep 147 at 152, at 287 of R.P.C. (emphasis added).

88 *See, e.g.*, *Gillette UK Ltd. v. Edenwest Ltd.*, [1994] R.P.C. 279 (HCJ–Ch). Blackburne J. reviewed a number of authorities and ruled that substantial monetary relief in the form of *damages* could be ordered, despite non-willfulness, in respect of both passing off and trademark infringement in the United Kingdom.

89 240 U.S. 179 (February 21, 1916). (Issued on February 21, the same day as *Hamilton-Brown Shoe Co.*, which is discussed *infra* in text accompanying notes 39–40, 149.)

profits,[90] and yet that intention is not irrelevant either as it is still a factor in assessing relief.[91] Regarding the first aspect, albeit implicitly, Holmes J. contradicted any notion of profits not being available in respect of innocent infringement. While he did reverse the decision below by lifting the award for profits, he did not do so on the basis of any such absolute precondition. Instead, he took several paragraphs to justify the denial based on the circumstances of the case.[92] This understanding of his ruling is supported by the fact it was released just one year after the U.K. ruling in *Gamage* and also on the same day as the ruling in *Hamilton-Brown Shoe*, both of which helped to justify the court's jurisdiction on principles of equity and property, rather than intentional tort.[93]

Regarding the second aspect of *Romag* supported by this decision, Holmes J. expressly contradicted the notion that good faith is completely irrelevant in such proceedings.[94] Even though the activity in issue is improper (and is to be enjoined), he stated "it does not follow that the defendants are chargeable with profits *as a matter of course*."[95] He took good faith into account, as a factor, as to whether to award the monetary relief.

Another aspect of *Straus* further contradicts any strict reading of (or reliance upon) the *Edelsten* dictum as establishing any absolute rules. Holmes J. lifted the order for profits, not just for the time period prior to receiving notice of the plaintiff's rights and the similarity of the marks, but even for the time period after that notice, as the defendants had continued the impugned activities after notice in good faith.[96] This was thus another case like *N.K. Fairbank*, which did not follow the portion of the *Edelsten* dictum calling for monetary relief to be awarded after notice.[97] Such courts treated the issue of monetary relief as a matter of discretion, whether before or after the violator receives notice, with the courts taking good faith into account as a factor.

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[90] *See supra* text accompanying note 2, and Part II.B.

[91] *See supra* text accompanying notes 23–26.

[92] *Id.* at 181–83.

[93] As just discussed above.

[94] As discussed above. This aspect of this case in particular is discussed in *Intention: Is It Truly Irrelevant?*, *supra* note 5, at 1059, 1090.

[95] 240 U.S., at 181 (emphasis added).

[96] The confusion in that case was not blatant, and Holmes J. said that the "natural interpretation" of the continuation by the defendants' sales was not that they wanted to steal the plaintiff's goodwill, "but that they wished to preserve their own," and they took their chances at trial. *Id.* at 183. He also took into account that "it cannot be assumed in all cases that the defendant's sales were due to [the unfair competition] alone." *Id.* at 181. Coincidently, the latter point may have been better handled as a ground for apportioning profits rather than eliminating them, as discussed *infra* in Part III.B.

[97] *See supra* text accompanying notes 74–77.

Admittedly, as discussed in *Romag*, there have been a variety of decisions supporting the precondition of willfulness. But again, there was little or no discussion on the matter. They hardly considered all of the cases and other arguments discussed in this article, and that line of cases has effectively been reversed as discussed herein.

5. Some Subsequent Supportive Decisions

Subsequent to *Straus*, there is an authoritative U.K. decision issued in the mid-1900s which has rarely, if ever, been noticed as supporting the availability of monetary relief as against non-willful infringers. This is the case of *Saville Perfumery Ltd. v. June Perfect Ltd. and Woolworth & Co. Ltd.* (1941).[98] The plaintiff was awarded, on appeal, an election as between damages or an accounting (in a case involving both passing off and trademark infringement) despite the finding by the trial judge that the defendant had acted good faith.[99] On appeal to the House of Lords, the injunctive relief was modified, but without any modification of the entitlement to elect damages or profits. While the issue of being entitled to that monetary relief despite good faith was not discussed in the reasons, the decision stands.

Moreover, the issue was certainly in the minds of the Court of Appeal judges as they were in the process of commenting on the issue in another case, *Draper v. Trist*,[100] which overlapped with the proceedings in *Saville Perfumery*.[101] In particular, in *Draper*, Green M.R. famously commented:

> There is one matter which I can get rid of at once, and that is the suggestion, which was discussed to some extent in argument, that, in a claim for damages based on passing off, it is essential to establish a fraudulent intent—which is the same, of course, as a dishonest intent—on the part of the defendant. I should be prepared myself to hold, if it were necessary to do so, that now, both in claiming damages and in claiming purely equitable relief, whether by way of

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98 58 R.P.C. 147 (HCJ, CA and HL).

99 The trial judge had stated he was "satisfied that Mrs. Coakley is an honest trader." *Id.* at 157. She had actually used the subject mark first, albeit for a different product.

100 *Draper v. Trist & Trisbestos Brake Linings Ltd.* (1939), 56 R.P.C. 429 (CA) 442 (CA).

101 Two of the three judges, namely, Sir Green M.R. and Goddard L.J., were the same as between the two proceedings at the court of appeal level. In addition, those judges had heard *Saville* after having heard *Draper* and about one month before they had delivered the decision in *Draper* (all in 1939). The hearing in the House of Lords in *Saville Perfumery* was about a year after the decision had been delivered in *Draper*, so the House was well aware of that decision even though it had not been cited within any of the decisions in *Saville Perfumery*.

> injunction or by way of account of profits, or both, fraud is not a necessary element in the transaction.[102]

On its own, this can be seen as a superfluous comment given that the defendants had consented to the order for damages. But the principle that dishonest intent is not required was applied by that court in *Saville Perfumery*.

The other two justices in *Draper* had expressed doubt on the issue,[103] especially Goddard L.J. who said that he had "considerable doubt" as to whether

"it is the law that damages can be claimed for an innocent passing off." But this doubt was gone in *Saville* (where he concurred with the above-mentioned judgment of Greene M.R.). In view of all the above, *Saville Perfumery* is a strong component of the line of cases permitting the availability of monetary relief despite non-willfulness.

Mishawaka Rubber & Woolen Manufacturing Co. v. S. S. Kresge Co. (1942)[104] is another decision of the U.S. Supreme Court supporting the position that intention is not required for monetary relief, even in the form of an accounting, especially when the majority decision is read in comparison to the dissent.[105] This interpretation is even stronger considering it was delivered shortly after *Draper* and *Saville Perfumery*.

Gamage was expressly interpreted in 1948 as *supporting* the availability of not just damages, but an accounting of profits, despite non-willfulness. This was the U.K. passing off case of *Edward Young & Co. Ltd. V. S.S. Holt* (1948).[106] Wynn Parry J. paraphrased Lord Parker's dictum in that a defendant should only be saved from substantial monetary relief for the period from which the defendant had "known *or could have been in a position to have known*" of the plaintiff's rights.[107] Based on the facts of that case, it could be distinguished as a case of willful blindness (and thus effectively as a case of willfulness). But the judge nevertheless used language encompassing negligent non-willfulness.

Jumping ahead to a quick sample of a more recent case, in *General Electric Company v. Speicher* (1989), the Seventh Circuit emphatically said good faith is not a precondition for damages to be awarded.[108] Some may wish to soften this by mentioning that the

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102 *Id.* at 441, 443.

103 *Id.* at 443.

104 316 U.S. 203 (1942).

105 Danielle Conway-Jones, *Remedying Trademark Infringement: The Role of Bad Faith in Awarding an Accounting of Defendant's Profits*, 42 Santa Clara L. Rev. 863 at 864, 876–78 (2002).

106 (1948), 65 R.P.C. 25.

107 *Id.* at 26.

108 877 F. 2d 531, 535 (7th Cir. 1989).

trial judge had felt otherwise, or distinguish it on the basis the court on appeal had felt the defendant had acted in bad faith. But that court had nevertheless recognized the concern that, even when acting in good faith, an infringer may be acting negligently, and should be exposed to the possibility of having to pay damages for the plaintiff's losses.[109]

The evolution of the law is demonstrated by contrasting the above-mentioned decision in *Moet v. Couston* (1864), where monetary relief was denied against the good-faith defendant that purchased products in bulk not knowing they were spurious,[110] with the decision about 130 years later in *Gillette UK Limited v. Edenwest Limited* (1994)[111] where, in a similar fact situation, damages were awarded. In other words, monetary relief was awarded despite non-willfulness (pursuant to both passing off and trademark infringement). The contrast between these rulings demonstrates the dichotomy between the two lines of authority, with the more recent trend being in favor of the courts having at least the authority to award some monetary relief.

A number of other U.K. authorities, going to one extreme or the other, are conveniently mentioned in that *Gillette* case. Some others are mentioned in the author's earlier article on the subject.[112] But again, it is hard to find any decision denying monetary relief as against non-willful infringers that acted carelessly, at least not with a discussion of all of the contrary points covered in this article. The ruling in *Romag* was also sound even in terms of policy as discussed next.

D. Policy Support for the Ability to Award Monetary Relief Against Non-willful Infringers

Romag acknowledged that, in trying to decide whether willfulness should be a precondition to an award for profits for cases of trademark infringement, there are "competing and incommensurable policy goals."[113]

Perhaps the strongest of the concerns in support of the precondition is the theory that the plaintiff will otherwise receive a windfall. In particular, Fossil, the defendant in *Romag*, submitted that "an award of Fossil's profits would be *a windfall far beyond any notion of compensation*, and would *punish* Fossil . . ."[114] Similarly,

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109 *Id.*

110 *See supra* text accompanying notes 79–81.

111 *See supra* note 88.

112 *See supra* note 5.

113 140 S. Ct. 1492 at 1497.

114 Fossil's Brief in Part II B. (emphasis added) available at https://www.supremecourt.gov/DocketPDF/18/18-1233/100713/20190522164830590_01145334.PDF).

the following was submitted to the Court within the amicus brief supporting the rule requiring a finding of willfulness for an accounting of profits to be available:

> As the Federal Circuit explained in *Romag* [meaning, in its decision under appeal] by citing Second Circuit case law, requiring a finding of willfulness "is necessary to avoid the *conceivably draconian impact* that a profits remedy might have in some cases. While *damages* directly measure the plaintiff's loss, defendant's profits measure the defendant's gain. Thus, an accounting *may overcompensate* for a plaintiff's actual injury and create *a windfall judgment* at the defendant's expense." *Romag*, 817 F.3d at 785–86.[115]

The same concern was also the reasoning behind the second of the two cases cited by the majority in *Romag* as having supported the willfulness requirement,[116] namely, *Horlick's Malted Milk Corp. v. Horluck's, Inc.*[117] Cushman J. for that court expressly indicated willfulness was required as a rule but there was no discussion of the above-mentioned concerns that equitable jurisdiction should not be fettered, that devious or negligent infringement should not be condoned, or that there were weaknesses in the jurisprudence that had supposedly required willfulness as a rule.[118]

As to policy, while Cushman J. accepted that civil relief in the form of injunctions and *damages* for diverted sales can be awarded, he otherwise said: "To decree plaintiff the defendant's *profits would be to punish defendant* and *not to compensate the plaintiff*."[119] So, a further criticism of the call for willfulness in *Horlick's* is that it disregards the fact that at least some profits would not be punitive insofar as they would equate to the amount available by way of damages.[120] Still further, Cushman J. in *Horlick's* went so far as to state (as quoted by the majority in *Romag*) that a plaintiff "cannot recover defendant's profits unless it has been shown *beyond a reasonable doubt* that defendant was *guilty* of willful fraud in the use of the enjoined trade-name."[121] Such call for proof "beyond a reasonable doubt" is easily recognized as being on par with the stringent requirement for criminal liability and appears to reflect a

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115 IPO's amicus brief, Part II (emphasis added) (available at https://www.supremecourt.gov/DocketPDF/18/18-1233/116499/20190920124951722_18-1233_Romag%20Fasteners%20Inc.%20v.%20Fossil%20Inc.%20et%20al._IPO%20Amicus%20Brief.pdf).

116 *See supra* text accompanying note 49.

117 51 F. 2d 357 (W.D. Wash. 1931). This aspect of the decision was affirmed on appeal, 59 F.2d 13 (9th Cir. 1932).

118 Parts II.C. and II.D.

119 51 F.2d 357, 358 (emphases added).

120 *See supra* Part II.B.3.

121 51 F. 2d 357, 359 (emphasis added).

higher standard that may not be appropriate in civil contexts. His interpretation of the accounting remedy as being an absolute penalty is confirmed where, in colorful terms, he added:

> Under such circumstances, the sword of equity is free to lop off the objectionable practice [i.e., enjoin it] and to enforce the restoration of damages suffered by the earlier user of the trade-name in question, *but it will not touch his shoulder and bid him rise up a knight errant to avenge, for in such a case it is not equity to create a private prosecutor*, for his sense of duty is also likely to be distorted when he receives a reward in proportion to the punishment he inflicts.[122]

Substantially the same concern was expressed by Windeyer J. of the High Court of Australia in *Colbeam Palmer Ltd. v. Stock Affiliates Pty. Ltd.* (1968).[123] In favoring willfulness as a precondition for awarding profits in trademark cases, he explained that the focus of this particular form of monetary relief is to strip a defendant of profits as to which it would be "*unconscionable* that he retain."[124] "*These* are profits made by him dishonestly, *that is* by his *knowingly* infringing the rights of the proprietor of the trade mark."[125]

So, there you have it: awarding profits supposedly constitutes a draconian, unconscionable windfall, and thus a penalty. This concern, or combination of concerns, should not be dismissed entirely, but it should certainly not go to the extent of justifying the absolute precondition.

First, even an innocent infringer may gain some profits, by virtue of consumers mistakenly believing its products are those of, or affiliated with, the plaintiff. That is, even if a defendant did not intend to cause confusion, consumers of the defendant's products may have nevertheless been confused and/or mistakenly believed they were purchasing products sold by or affiliated with the plaintiff—thus generating profits for the defendant that would not have otherwise been generated, but for its use of the plaintiff's mark. It is thus entirely understandable that the court have the authority to award monetary relief, and that it exercise that authority by occasionally awarding a portion of those ill-gotten gains (taking the non-willfulness into account as a factor).

There may also not be a windfall insofar as the defendant's unlawful profits may exceed the plaintiff's damages. The defendant may have a higher profit margin because it has been selling a cheaper product at a price comparable to that of the plaintiff's

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122 *Id.* at 358 (emphasis added).

123 [1972] R.P.C. 303 (Aus HC). *See supra* note 86.

124 [1972] R.P.C. 303 (Aus HC) (emphasis added).

125 *Id.* (emphasis added).

product. The plaintiff could have itself earned those profits by starting to supply a less-expensive product.

Similarly, some of the defendant's unlawful sales would involve profits that could be stripped pursuant to the laws of damages. So, if the laws of damages would justify monetary relief, there is again no true "windfall" in awarding the payment of money, whether under the label of damages or an accounting of profits. There is no reason for denying profits at least insofar as they would equate to the amount entitled by way of damages.[126] An accounting to that extent would obviously not constitute a windfall to the plaintiff. So, again, disgorging at least some of such profits would not be unconscionable for that reason alone.

Also, if the defendant is permitted to keep any of its profits, this could just as well constitute a windfall albeit to the credit of the defendant instead of the plaintiff. This concern has already been recognized, for example, by the U.S. Supreme Court in *Mishawaka Rubber & Woolen Manufacturing Co. v. S. S. Kresge Co.* (1942).[127] In deciding whether to award profits where it was impossible to isolate those profits attributable to the use of the infringing mark, the Court stated:

> There may well be a windfall to the trademark owner where it is impossible to isolate the profits which are attributable to the use of the infringing mark. But to hold otherwise would give the windfall *to the wrongdoer*.[128]

In a similar vein, willfulness is hardly an absolute precondition to the recovery of profits in every other field of law. For example, in the patent case of *Root v. Railway Co.* (1881),[129] Justice Matthews for the U.S. Supreme Court reviewed a number of decisions in other fields and approved such principles as: "'[an accounting] compensates one party and punishes the other. . . . The controlling consideration is that [the wrong doer] *shall not profit by his wrong*. A more favorable rule *would offer a premium to dishonesty and invite to aggression*.'"[130] The latter sentence is precisely the point that allowing a defendant to keep all of its profits would encourage devious infringement and fail to deter negligent infringement. The courts should not condone and encourage negligent or highly suspicious infringement. If the Court had endorsed the rule that no profits at all could be awarded against a non-willful defendant, this would have encouraged devious infringers (and failed to discourage

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126 *See supra* text accompanying notes 27–31.

127 *Id.*

128 *Id.* at 207 (emphasis added).

129 105 U.S. 189 (1881).

130 *Id.* at 197 (citation omitted).

careless or negligent infringers) by sending the message that courts allow infringement to be a profitable endeavor.

Consider also that the U.S. trademark statute expressly permits plaintiffs to be awarded significantly more than their lost profits or damages. In cases of "counterfeit" marks, § 1117(b) authorizes "three times" the profits or damages.[131] Even in cases *not* involving counterfeit marks, the very remedy in issue in *Romag*, § 1117(a), provides:

> In assessing *damages* the court may enter judgment, according to the circumstances of the case, *for any sum above the amount found as actual damages, not exceeding three times such amount*. If the court shall find that the amount of the recovery based on *profits* is either *inadequate* or excessive the court may in its discretion *enter judgment for such sum as the court shall find to be just*, according to the circumstances of the case. Such sum in either of the above circumstances shall constitute compensation and not a penalty. . . .

If the law permits treble profits, then an award of a single amount of profits hardly seems draconian. A single amount of profits should be within the realm of what is just and equitable and should thus lie within the court's discretion even in cases not covered by the above-mentioned U.S. statutory remedies.

Another policy consideration that supports of the willfulness requirement was expressed in an amicus brief in *Romag* as follows: "Permitting the disgorgement of a defendant's profits only upon a showing of bad faith or willfulness *also discourages vexatious trademark litigation*."[132] This is another concern that should not be discounted entirely, but which does not justify denying profits in all non-willful infringement trademark cases. It does not fully negate the opposing policy concerns discussed above.[133]

In addition, vexatious litigation is a concern under any cause of action, and thus this concern, carried to its conclusion, could just as well lead to the result that all monetary remedies in any field of law should be removed—no monetary remedies at the risk of encouraging vexatious litigation. This would be an extreme result.[134]

So, on one hand, in view of the above, it should be clear that the Court's ruling in *Romag* was sound; the courts have, and must

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131 Triple damages are also available under the U.S. patent statute, 35 U.S.C. § 284.

132 IPO's amicus brief, Part II (available at https://www.supremecourt.gov/DocketPDF/18/18-1233/116499/20190920124951722_18-1233_Romag%20Fasteners%20Inc.%20v.%20Fossil%20Inc.%20et%20al._IPO%20Amicus%20Brief.pdf) (emphasis added).

133 *See supra* text accompanying notes 113–125.

134 Vexatious litigation in any field should be discouraged, but probably by other means, such as by awarding double or treble costs against such plaintiffs.

retain, equitable jurisdiction to possibly award damages or profits as against non-willful infringers (except as may, or should be, amended by statute). However, in view of the cases and policy concerns to the contrary, there is still the question of how the court should exercise that discretion. That is, just because *Romag* permits an accounting to be ordered in non-willful scenarios,[135] it may be unjust to award it in some of those scenarios, or at least unjust to award the entirety of the defendant's profits. A couple of possible answers to this challenging issue are discussed next.

III. POSSIBLE ANSWERS TO THE ROLE OF INTENTION VIZ MONETARY RELIEF

There are at least two possible answers regarding the question of how to reconcile the competing policy goals as to the role of willfulness as to the availability of monetary relief for trademark infringement or unfair competition

A. Leaving It to the Legislators

The first possible answer is that the policymakers have already attempted to reconcile the competing policy goals, at least to a certain extent, and at least regarding violations of registered marks in the United States.

As mentioned in *Romag*,[136] Section 29 of the Lanham Act (§ 1111) already provides a certain precondition for obtaining profits or damages for infringement of registered marks. And the limitations of § 1111 are incorporated by reference into § 1117. It basically provides that no *profits or damages* shall be recovered in respect of infringement of a registered mark *unless* it has been displayed by the owner as being "Registered…," or the defendant otherwise had actual notice of the registration.[137] So, no damages or profits unless the mark has been properly displayed as registered or the defendant otherwise has notice of the plaintiff's registered rights.[138]

But this provision obviously reads very much like the common law rule that was indicated in the *Edelsten* dictum,[139] which has evolved or otherwise been contradicted, including by the Court in

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135 The scenarios are defined *supra* in Part II.A.

136 *Romag*, 140 S. Ct. at 1495.

137 15 U.S.C. § 1111.

138 *See also* 25 U.S.C. § 1114(1)(b). For the purposes of claims against parties that merely manufacture or copy infringing labels and the like, it provides a precondition against the recovery of "*profits or damages* unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive." *Id.* (emphasis added).

139 *See supra* text accompanying notes 95–96, 70.

Romag.[140] Thus, the provision should not be extended to cover other causes of action, and should instead perhaps be narrowly construed on the same logic.

A particular concern with § 1111, as with the *Edelsten* dictum and most any other objective rule, is that it protects certain violators who should instead be exposed to an accounting. That is, perhaps the plaintiff has not marked its brand as "Registered…" and cannot prove the defendant was otherwise aware of that registration, but perhaps the defendant was well aware of the plaintiff's mark without being aware of the registration and deviously or carelessly avoided conducting a search of the registry. It may have even targeted the plaintiff in having noticed the plaintiff's failure to identify its mark as being registered, and purposely did not retain any records of the search. The provision could very well be amended so that such violators as well would be exposed to the possibility of an accounting or damages, in the same way they are exposed to such relief under claims not governed by § 1111.

Consider also that the rule is so stark in protecting certain infringers (or stages of their infringement) based on their lack of knowledge of the plaintiff's registered rights but fails to provide any protection to infringers that have acted (or continued to act) in good faith even after becoming aware of those rights. Along the lines of some of the non-willful scenarios,[141] the infringer may have acted on advice that the owner had gone bankrupt, or that the registration was invalid (such as for not being a proper mark, or having been filed on a false statement). The registration may have also been marked on the registry as "Dead" only to be revived later. Or perhaps defendant was advised that its mark was sufficiently different as to avoid causing confusion with the plaintiff's mark. The defendant might also have a good faith claim to the ownership of the registration such as by assignment. While the author agrees that such infringers should nevertheless be exposed to paying some monetary relief (in accordance with *Romag*), the court should seriously consider whether they should have to pay the same amount as a willful infringer, perhaps as discussed next.[142]

In addition, regardless of whether § 1111 is maintained, or even extended to apply to other U.S. statutory causes of action, it does not apply to the availability of monetary relief pursuant to judge-made (common-law) causes of action such as for passing off or unfair competition. Thus, the difficult issue will continue to subsist at least for those causes of action. Again, a further answer may be needed as discussed next.

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140 Parts I and II.

141 *See supra* in Part II.A.

142 Part II.B.

B. Apportioning Profits, Especially Taking Intention into Account

The second and preferred answer is to simply award a portion (or percentage) of the defendant's profits by taking into account, as a factor, the degree of the parties' culpable or dishonorable conduct. This would go one step further than simply taking into account such conduct for the purposes of deciding whether to award either 0 or 100 percent of those profits.

This would help to find a balance between the conflicting policy concerns. In particular, it would help to deter careless or devious trademark violations. It avoids the pre-*Romag* oversimplified practice of not awarding any profits against any defendants where the plaintiff has failed to establish that the violations were willful. It helps to avoid the notion that infringers can act carelessly or hide their willfulness and still keep their profits.

It also helps to prevent, at the other extreme, some oversimplified notion of awarding all the profits from an infringer that acted completely in good faith. It avoids the above-mentioned concern of plaintiffs being "overcompensated" in such cases and receiving a "windfall," or the good-faith infringer being "punished."

Still further, while the court might struggle with the precise percentage to be awarded, the court would nevertheless be saved from the more-difficult decision of awarding all or none of those profits. For example, in *Straus*,[143] the decision to lift the award of profits was a split decision; two judges had dissented. If such learned justices could not agree within the circumstances of that case as to whether it would be just to award all or nothing, surely awarding a portion of the defendant's profits would have been an even better form of justice.

Awarding only a portion of profits respects both sides of the foundational debate of whether the causes of action are justified on the basis of intentional damage or on mere trespass upon the complainant's quasi-property rights (in its trademark, in its trademark registration, or in the goodwill of its business).

It also avoids labelling the infringer as a fraudster whenever the court finds that the infringement or passing off was willful. Such harsh labelling can otherwise occur given the historical characterization of trademark infringement (and deceiving of the public) as a form of fraud and even piracy. Such labelling could obviously impact the infringer's ability to conduct other business. A finding of fraudulent intention could also jeopardize the infringer's trademark liability insurance because intentional acts are often excluded in the business advertising clause of a commercial general

143 *See supra* text accompanying notes 89–96.

liability insurance policy.[144] A finding of fraud should only be declared cautiously. This can be accommodated by apportioning profits by taking into account, as a factor, the degree of blame in the parties' conduct.

The subjective nature of nominating a percentage might also allow the court, in appropriate cases, to proceed one step further and nominate a lump sum award rather than having the parties and the court go through the complexities of an assessment. The designation of a percentage in non-willful cases is merely approximate in view of the wide dichotomy between those who resist awarding any profits against unintentional infringers and those calling for full profits. Without a larger body of case law as to appropriate percentages, one judge in the particular scenario could award only 25 percent of the infringer's profits while another might just as rationally award 75 percent. With such a wide range of approximation, the revenues and expenses can similarly be approximated. That is, in such cases, there may be little point in arguing whether the expenses should be two percent higher or lower when the percentage of profits to be awarded ranges by a greater percentage. Without putting it too highly, a lump sum award can be just as close to a fair amount of monetary relief as may be determined by a formal assessment, again speaking only to cases where profits are to be apportioned when taking into account such a subjective element as the degree of the parties' careless conduct.

In any event, the primary suggestion here is to consider the option of occasionally awarding a percentage of the defendant's profits taking into account the conduct of the parties. Even if the particular percentage awarded is not perfect, it still advances trademark law, as it reduces the above-mentioned concerns of merely choosing to award 0 percent (which would fail to discourage careless or devious violations) or 100 percent (which would punish pure good-faith infringers that acted carefully).

There is support for the courts' authority to pursue this option. Firstly, the courts already have the authority to apportion monetary relief on other grounds, such as on the degree to which the infringing component contributed to the defendant's sales. The trial decision in *Romag* was such a case; it involved an order for an apportionment or percentage of the defendant's profits,[145] and there was a court order within the *Romag* proceedings[146] that cited the U.S. Supreme

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144 The issue is not so clear because, in some jurisdictions, certain insurance issues are governed by the wording of the complaint, such as when solely alleging that the infringement was intentional. *See, e.g.*, ABC Distributing, Inc. v. Lumbermens Mutual Insurance Co., 646 F. 2d 207 (5th Cir 1981).

145 29 F. Supp. 3d 85 (D. Conn. June 27, 2014).

146 *Id*; *see also* 2014 WL 3895905 (Aug. 8, 2014) also available at: https://www.scotusblog.com/wp-content/uploads/2016/10/16-202-BIO.pdf).

Court decision in *Mishawaka Rubber*[147] regarding the principle of apportioning profits. In that 1942 case, the Court stated, for example, "The plaintiff of course is not entitled to profits demonstrably not attributable to the unlawful use of his mark."[148] So, while courts too often consider the awarding of defendant's profits as an all-or-nothing proposition, case law clearly supports awarding *a portion of* defendant's profits that are attributable to infringement.

Mishawaka Rubber effectively overruled *Hamilton-Brown Shoe Co. v. Wolf Bros. & Co.* (1916),[149] insofar as that earlier case had resisted apportioning profits on such basis. The Court in that earlier case had stated that the plaintiff in passing off and trademark cases (at common law) is automatically entitled to *all* of the defendant's profits—no apportionment as in patent cases.[150] But this statement should not be relied upon as necessarily denying the authority to possibly award a portion of profits in trademark cases based on the degree of the defendant's carelessness as that was not before the Court. The Court only refused to apply the concept of apportioning to trademark cases because the Court was concerned that it lacked any concrete accounting method for determining the proportional role of the mark—something that it thought to be "inherently impossible" for a plaintiff to satisfy in trademark cases,[151] and thus, with the rule going unsatisfied, it was concerned that infringers (at least willful infringers as in that case[152]) would escape without having to hand over any profits at all.[153] In addition, the Court did not consider any of the other rationales for supporting the ability to apportion relief, even as against willful infringers.[154]

Still further, in cases governed by § 1117(a), that provision confirms that authority as the provision includes the following wording: "If the court shall find that the amount of the recovery

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147 *See supra* text accompanying notes 104 and 127.

148 Mishawaka Rubber & Woolen Mfg. Co. v. SS Kresge Co., 316 U.S. 203, 206–07 (1942) ("If it can be shown that the infringement had no relation to profits made by the defendant, that some purchasers bought goods bearing the infringing mark because of the defendant's recommendation or his reputation or for any reason other than a response to the diffused appeal of the plaintiff's symbol, the burden of showing this is upon the poacher. The plaintiff of course is not entitled to profits demonstrably not attributable to the unlawful use of his mark." (citations omitted)).

149 240 U.S. 251 (Feb. 21, 1916).

150 *Id.* at 259–262.

151 *Id.* at 261–62. The Court approved the comment of the Supreme Court of California in *Graham v. Plate*, 40 Cal. 593, 598 (1871), which court equally refused to apply the patent rule of apportionment as it stood: "In sales made under a simulated trademark, it is impossible to decide how much of the profit resulted from the intrinsic value of the commodity in the market and how much from the credit given to it by the trademark."

152 *Id.* at 261, 262.

153 *Id.* at 256, 259–62.

154 *E.g., see infra* text accompanying note 163.

based on profits is *either inadequate or excessive* the court may in its discretion enter judgment *for such sum as the court shall find to be just, according to the circumstances of the case*." (Emphasis added.) And that provision provides that both damages and profits be governed by the principles of equity.[155]

The ability to apportion profits in trademark cases was also approved by the Australian High Court in *Colbeam Palmer Ltd. v. Stock Affiliates Pty. Ltd.* (1968).[156] In that case, the apportioning was based on the notional amount of profit attributed to the violation,[157] rather than the good faith or bad faith of the defendant, but the court nevertheless apportioned profits.

In so ruling, the decision discusses some authorities from the United States, the United Kingdom, and Canada. In particular, it cites and applies[158] *Cartier v. Carlile* (1862).[159] It was one of the decisions upon which the 1863 *Edelsten* dictum was likely based. Profits were deemed to be available for passing off or trademark infringement at common law for the time period after which the defendant was aware (or deemed to be aware as a matter of willful blindness) that the defendant was employing a mark that belonged to someone else. While that aspect of *Cartier* became relatively famous by means of *Edelsten*, another aspect of *Cartier* has received much less attention. Sir John Romilly M.R. in *Cartier* said, in assessing the account, he would "consider how much of the profits are properly attributable to the user of the Plaintiff's trade mark."[160] This was quoted and applied some 100 years later in the Canadian case of *Dubiner v. Cheerio Toys & Games Ltd.* (1966).[161]

Despite the dearth of authorities apportioning profits in trademark cases (even apart from the degree of good faith or carelessness), Noel J. in *Dubiner* explained some of the logic, by first explaining the situation as follows:

> The difficulty the [assessment officer in the decision under appeal] had to deal with in respect of determining the profit of the defendant was due to the fact that the total net profit of the defendant was composed of that derived from the sale of merchandise bearing one or more of the plaintiff's trade marks, some of which were infringing and others of which were not (CHEERIO and BEGINNERS could be used by the

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155 *See supra* note 28.

156 [1972] R.P.C. 303 (Aus HC).

157 *Id.* at 318.

158 *Id.* at 315.

159 (also spelled as "*Carlisle*" in the sidenote of the report but spelled as "*Carlile*" in the body of the report) 31 Beav. 292, 298 (Mar. 7, 1862).

160 *Id.* at 434.

161 1966 CanLII 481 (FC) (http://canlii.ca/t/gwfcv), 55 D.L.R. (2d) 420 at 434-5, 40 C.P.R. 155 at 174-5.

> defendant whereas PRO, YO-YO, BOLO, 99 and TOURNAMENT could not and were infringements) or of merchandise otherwise sold in association with those trade marks and the sale of non-infringing merchandise. The plaintiff here takes the position that he is entitled to all of the profits made by the defendant during the accounting period, because it is the goodwill of the trade marks that the defendant has obtained and that he has traded upon, whereas the latter maintains that the plaintiff is only entitled to that portion of such profits directly attributable to the use of the plaintiff's trade marks.[162]

Then Noel J. stated:

> To accept the submission of counsel for the plaintiff that, if an infringer is using infringing marks as well as other marks, the whole of the profits in an accounting of profits goes to the person whose rights he has been infringing even if some of the profits are attributable to the use of a trade mark which does not belong to such person would, in my view, lead to unconscionable results *particularly in a case where use is made of several trade marks belonging to different owners*. Indeed, one might ask whether, *if the trade marks used together belonged to different people, the defendant should be compelled to pay an amount equal to all of his profits to each of the individual owners. To reach such a result would indeed be most unreasonable and would lead to unjustifiable abuses*.[163]

Consider also that *damages* have occasionally been awarded in the form of reasonable, hypothetical royalties.[164] Nominating a percentage of the defendant's sales is similar to nominating a percentage of the defendant's profits; in both cases, the percentage is a reasonable guess as to an appropriate portion, rather than simply awarding 0 or 100 percent. And if the court has such authority pursuant to the court-made laws of damages, surely such principle is just and equitable so as to fall within the court's equitable authority.[165]

Also, Lord Parker's dictum in *Gamage* provides that, for the period of innocence, at least nominal damages are available.[166]

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162 *Id.* at 298.

163 *Id.* at 435. In this case, the court awarded 20 percent of the defendant's profits, taking into account those factors and others. *Id.*

164 *See supra* text accompanying note 30.

165 *See supra* text accompanying note 27 *et seq.*

166 *See supra* text accompanying notes 84–87.

Assuming that this principle is just and equitable, at least a similar quantum should be available by way of an accounting of profits.[167]

Similarly, Lord Parker said, in such cases of misrepresentation to the public in the course of competing with others, the plaintiffs are "*prima facie*" entitled to an inquiry as to damage.[168] His careful use of the term *prima facie* seems to recognize—and otherwise allows for—the court's discretionary authority to nevertheless do what is just in the circumstances of the case.

Some cases support apportionment precisely on the basis of the degree of honorable or dishonorable conduct of the defendant. In the patent case of *Root v. Railway Co.* (1881),[169] Justice Matthews approved the principle: the "*the severity of the decree* [of monetary relief] *may be increased or mitigated according to the complexion of the conduct of the offender*."[170] Similarly, Justice Matthews referred to the principle in property cases where the defendant has improperly mined their neighbor's coal, "a different principle is applicable when the coal is taken inadvertently, or under a *bona fide* belief of title, and when it is taken fraudulently, with knowledge of the wrong" *the amount* of profits is different.[171] The same reasoning appeared in some of the cases cited in *Romag*, such as the timber case of *E.E. Wooden-Ware Co. v. United States* (1882)[172] and the passing off case of *Larson, Jr., Co. v. Wm. Wrigley, Jr., Co.* (1928).[173]

Another decision that treats the wrongdoer's conduct as a factor regarding the quantum of monetary relief is that of the Supreme Court of Canada in *S. & S. Industries Inc. v. Rowell* (1966).[174] The decision dealt with statutory trade libel, which is treated in the Canadian trademark statute as another form of unfair competition, and within the same section as statutory passing off.[175] The issue on appeal was whether there was a requirement that false or misleading (trade libel) statements be made with knowledge of their falsity (or that they be made maliciously). The Court ruled that it was not an element (at least not with respect to injunctive relief and pursuant to the statutory form) but that it was still relevant as a factor as to quantum. In particular, Justice Martland for the

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167 *See supra* text accompanying notes 27 *et seq*.

168 *See supra* text accompanying note 87.

169 105 U.S. 189 (1881).

170 *Id*. at 197.

171 *Id*. at 209.

172 106 U.S. 432, 433–434 (1882). Monetary relief was, at least in that era, reduced in cases of cutting someone else's timber inadvertently as opposed to advertently.

173 277 U.S. 97, 99–100 (1928). Again, a willful wrongdoer cannot deduct the same type of expenses as can be deducted by the innocent wrongdoer: "Circumstances will affect the conclusion [of what can be deducted, and how much the wrongdoer will have to pay], including in them the knowledge and the conduct of the party charged." *Id.*

174 [1966] S.C.R. 419.

175 Namely, in s. 7 of the Canadian Trademarks Act.

majority said: "In my opinion, the natural meaning of s. 7(a) [namely, the subsection in issue] is to give a cause of action, in the specified circumstances, in respect of statements which are, in fact, false, and the presence or absence of malice would only have relevance in relation to *the assessment* of damages."[176]

Awarding at least some monetary relief helps redress the wrong that the defendant has, albeit innocently, trespassed upon the plaintiff's exclusive rights. To otherwise deny any monetary relief is to effectively grant competitors a license to use those rights; not only is the license imposed against the will of the owner, but it would be imposed on a royalty-free basis. Such practice would also fail to discourage the practice being repeated or copied by others.

IV. CLOSING

Whether expressly or implicitly, the U.S. Supreme Court in *Romag* ruled that willfulness is a factor, but not an absolute precondition, regarding the availability of an award of profits as against both innocent and careless defendants in cases of trademark infringement or passing off, whether under the U.S. trademark statute or at common law.[177]

This ruling is sound in terms of foundational and jurisprudential support.[178] Some of the decisions calling for the precondition have been misread or overruled, or did not consider all of the decisions and rationales to the contrary.[179]

Unless constrained by legislation,[180] the courts should, and inherently must, retain their equitable authority to award damages or profits under the specific facts and circumstances of each case, regardless of whether the defendant acted with any degree of ill intent.[181]

The ruling is also sound as a matter of policy.[182] Innocent or not, the fact remains that at least some of the violator's profits were likely to be earned unlawfully.

In the same way that the laws of negligence have encouraged manufacturers, vehicle drivers, homeowners, etc. to act with a greater degree of care and diligence, the court in cases of trademarks and unfair competition should exercise their discretion and award, at least occasionally, some monetary relief so as to

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176 [1966] S.C.R. 419, 429 (emphasis added).

177 *See supra* Part II.B.

178 *See supra* Parts II.B and II.C.

179 *See supra* Parts II.C and II.D.

180 Such as § 1111 for certain causes of action under the U.S. trademark statute as discussed in Part III.A.

181 *See supra* Part II.C.

182 *See supra* Part II.D.

encourage traders to act more diligently when selecting a mark or otherwise making representations in the course of trade.

Having authority to award relief as against innocent or careless infringers does not mean the courts are constrained to always award 100 percent of damages or profits.[183] Awarding an intermediate amount, at least occasionally, as against innocent or careless infringers, helps to accommodate the concerns and weight of the authorities on both sides of the 200-year debate on the issue.

In particular, courts can already take into account all of the circumstances so as to apportion profits on other grounds, such as on the basis of the extent to which the violation contributed to the defendant's profits,[184] and whether the defendant was in direct competition with the plaintiff (and thus diverted sales) or merely infringed the plaintiff's registered rights in some remote area where the plaintiff had no established recognition (but still had registered rights). In addition to considering the defendant's carelessness, the court can consider the degree of the plaintiff's own misconduct if any, including as described in the above-mentioned spectrum of scenarios.[185]

The percentage can be assessed differently for different stages of carelessness, such as (as may be applicable in the particular case): the period prior to becoming aware of the plaintiff's rights; and the period after becoming aware but having a defense (as may be deemed acceptable for the purposes of reducing monetary relief).

On occasion, the percentage might be reduced if there is a concern of encouraging vexatious litigation, although this may be offset by the call for a larger amount of relief as a deterrence against careless or devious violations.

Overall, justice would be better served.

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183 *See supra* Part III.B.

184 The infringing product might only be a component of the product as sold, or the infringing mark might only be one of several marks or other inducements to purchase the product which did not all violate the rights of the particular plaintiff. *See, e.g., supra* text accompanying note 163.

185 A range of scenarios are discussed *supra* Part II.A.

BOOK REVIEW

By Désirée Fields*

The Confusion Test in European Trade Mark Law. Ilanah Fhima and Dev S. Gangjee. 2019. Pp. 320. £125 (hardback); electronic version available. Oxford University Press, Great Clarendon Street, Oxford, England, OX2 6DP, UK.

In the context of most trademark disputes, a finding of trademark infringement will heavily depend on the outcome of any likelihood of confusion analysis. This analysis is often simplified or short-circuited by focusing heavily on the comparison of the marks concerned and the goods and services that they cover. In reality, however, this area of the law is much more complex. A comprehensive likelihood of confusion analysis involves a much more nuanced approach and requires consideration of a number of additional factors, such as the level of distinctiveness of a mark, whether the marks at issue are complex or composite marks, and the role that factors such as trade channels and perceptions of consumers in particular sectors may play (among many others).

Voted IPKat Best Book on Trade Mark Law 2019, *The Confusion Test in European Trade Mark Law* by Ilanah Fhima and Dev S. Gangjee provides a clear and comprehensive overview of the likelihood of confusion analysis under European trademark law, touching on all aspects and nuances of the law without delving into too much detail. The authors provide case examples with references to source materials, enabling the reader to dive deeper into any areas that could be relevant in the context of a particular infringement assessment. The book primarily considers how the likelihood of confusion test is applied by the European Union Intellectual Property Office ("EUIPO") and the Court of Justice of the European Union ("CJEU"). Written by authors based in the United Kingdom ("UK"), the book includes numerous cases from England and Wales. Where appropriate, the authors also refer to case law of the European Union ("EU") Member States. Indeed, the book includes a significant number of references to German jurisprudence, especially where nontraditional trademarks are concerned. The authors invite readers to contact them with suggestions of relevant case law in EU Member States for inclusion in subsequent editions of this book.

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The Confusion Test in European Trade Mark Law is divided into eight chapters. After a clear introduction to the concept of the likelihood of confusion in Chapter 1, seven further chapters deal with the multifactor assessment that needs to be adopted in carrying out a confusion analysis. The authors contend that while there appears to be some contradiction between some of the factors, an analysis of the relevant case law in this area leads to the conclusion that it is nonetheless possible "to articulate a clear set of rules that are being consistently applied by European courts and tribunals in order to analyse the differen[t] forms of similarity and confusion overall."

Chapter 2 discusses the various tests in relation to the similarity of marks and, in particular, the visual, aural, and conceptual similarity tests. As the authors note, the test of the similarity of two marks has changed very little since it was first laid down by the CJEU in *SABEL BV v. Puma AG*,[1] where the court held that a "global appreciation of the visual, aural or conceptual similarity of the marks in question[ ] must be based on the overall impression created by the marks, bearing in mind, in particular, their distinctive and most dominant components," with a view to determining whether the signs in question are similar enough to lead to a likelihood of confusion in the minds of the average consumer of the goods and services concerned. Referencing a large number of actual cases where marks have been found to be similar or dissimilar, the authors cover a variety of hot topics, such as whether visual, aural, or conceptual similarity should be given most weight in the analysis, whether the beginning of the mark is more important than the ending, and what role families of marks may play in the assessment. Although these general principles are, of course, well known to the seasoned trademark practitioner, there are several useful refreshers and nuances to the analysis that may ordinarily not be given so much weight when carrying out a quick relative grounds or infringement assessment. There are also some case examples with somewhat surprising outcomes that may be useful to refer to in complex assessments. Particularly helpful are the illustrations of junior and senior marks. Disappointingly, some of the analysis in the chapter is, perhaps, short. By way of example, the authors devote a lot of analysis to examples of cases where two marks coincide in the senior mark at the beginning and end in a different suffix. There is, however, no detailed analysis of the converse situation, where the senior mark constitutes the second element of the junior mark. Rather, the authors comment only briefly that in such cases similarity is less often found, highlighting a couple of cases in the footnotes. Overall, however, despite the

1 Case C-251/95, *SABEL BV v. Puma AG, Rudolf Dassler Sport* (CJEU) EU:C:1997:528, [23].

importance of some of the nuances highlighted by the authors, it is true that a comparison of marks should not be an overly complex and evidence-intensive process. The important point is to try to apply an objective benchmark while bearing in mind, to some degree, the reality of consumer perception.

Chapter 3 grapples with the subject of complex or composite marks. While such marks have not been clearly defined in jurisprudence or scholarship, these marks are commonly understood to be those that include word and figurative elements. Such marks give rise to interesting questions, such as whether it is the words or the image that should be afforded greater weight. Particularly challenging are those situations in which one of the aspects of the composite mark is similar (for example, where the logo element in each case is that of a crocodile), while the word elements differ. As such, there are many variables that need to be factored into a likelihood of confusion analysis. While reference to previous case law can be of assistance to some extent, unfortunately a one-size-fits-all approach does not work in this complex area. The authors provide a helpful toolkit, setting out all the aspects that need to be considered. They distill the essence of how courts, such as the CJEU, try to achieve the difficult balance of identifying the elements of a mark that consumers would pay most attention to and consider to be dominant—those that have independent distinctive character and can lead to consumer confusion where they are similar in the junior and the senior mark, and those that are more negligible in the assessment of similarity and can therefore be ignored for the purposes of comparing signs. While there are degrees of variation in each individual case, the authors nicely draw out common threads and themes, again helpfully supported with illustrations.

While it is generally quite straightforward to identify when goods are considered to be identical, the similarity analysis can be much more complicated. Chapter 4 is devoted to analyzing the relevant factors when assessing the similarity of goods and services, focusing on how to demonstrate the similarity of goods and analyzing those factors that tend to be considered most frequently by the CJEU and other administrative bodies in their assessments. While this analysis is generally more straightforward than the assessment of the similarity between two marks, the authors explain, again with reference to ample examples, how this involves an assessment and balancing of numerous factors that may lead to contradictory outcomes. The case examples provided are fascinating, in particular, where the authors highlight discrepancies between outcomes of the assessment of the similarity or complementary nature of goods and show how the outcome often depends on the particular sector concerned and the level of sophistication of the relevant consumer in that field. This makes

Chapter 4 one of the most illuminating and interesting chapters of *The Confusion Test in European Trade Mark Law*, starkly reminding trademark practitioners to treat classification in the same Nice class with caution when carrying out a similarity assessment, and not to succumb to the temptation to state that goods or services are similar or complementary without providing more detailed arguments and analysis in support. The authors also provide readers with practical tips, such as the availability of the EUIPO's "Similarity Tool" by which users can, and examiners must, conduct a similarity search.

Chapter 5 feels more academic and analytical than the rest of the book. It evaluates the least understood aspect of the likelihood of confusion analysis, namely, the extent to which the distinctiveness or strength of the senior mark influences the assessment. In doing so, the authors provide a useful checklist of the factors to be considered in assessing the level of distinctiveness of the mark. Interestingly, their analysis of case law shows that distinctiveness has relatively little impact on the likelihood of confusion analysis in the EU. In the vast majority of cases, distinctiveness is treated as a second-class factor and is not considered at all or is discounted. The authors' analysis shows that inherent distinctiveness is not mentioned in 68 percent of cases and acquired distinctiveness is not mentioned in 82 percent of cases. This is in sharp contrast to the United States, where, in 90 percent of the cases in which confusion was found to exist, the strength of the senior mark was a factor. The authors therefore conclude that "distinctiveness is an enigma of likelihood of confusion": too important to be ignored, yet often downplayed in importance.

In Chapter 6, the authors identify the various additional factors that are relevant in assessing whether confusion is causatively likely to flow from those similarities. It starts by revisiting and building upon some of the concepts from earlier chapters in carrying out a global assessment, before considering the different types of confusion that are recognized, the nature of the hypothetical average consumer, and the extent to which proof of actual confusion is relevant. The analysis also addresses evidentiary questions, such as the value of survey evidence and the differences in assessment that may come into play when carrying out a relative grounds assessment and an infringement assessment, respectively. Other points that the authors address here are the role that families of marks can play in finding a likelihood of confusion and the scope of protection of marks that are weakly distinctive.

Chapter 7 considers the impact of timing on confusion, and, in particular, two variations of the traditional point-of-sale confusion, namely, initial interest (or pre-sale) confusion and post-sale confusion. Conducting an in-depth analysis of the doctrine and jurisprudence in this field, the authors argue that the label of the type of confusion should not matter, but that the focus should be on the materiality of the confusion and whether the defendant's conduct causes material harm to the trademark owner in the marketplace. Surprisingly, there is no guidance from the CJEU in this controversial area, so the authors focus on the status of the doctrine in the UK and draw comparisons to U.S. jurisprudence to illuminate the issues. The authors conclude that to base infringement solely on initial interest or post-sale confusion goes too far and that, to the extent that such confusion influences, or is likely to influence, a consumer's transactional decision, it should be recognized within the likelihood of confusion test.

Drawing heavily on examples from CJEU and German jurisprudence, Chapter 8 assesses the extent to which the conventional likelihood of confusion test is modified and applied in relation to conflicts between nontraditional trademarks, such as colors and shapes. Despite relatively recent reforms to EU trademark law, which should, in theory, make it easier to register such trademarks, the number of such registrations is still very modest due to the uphill struggles that such marks face during the registration process to meet the requisite hurdle of distinctiveness. Once registered, the scope of protection of such marks is relatively underdeveloped. Several questions arise in relation to the likelihood of confusion assessment, such as whether colors can, in fact, serve as trademarks or are instead merely decorative, and whether consumers can distinguish between two shades of the same color and how to assess their similarity. Product shape marks face similar challenges with questions as to whether two product shapes can be sufficiently similar visually to satisfy the test, even where there are prominent and dissimilar elements on the product. It is clear the conventional likelihood of confusion test, as detailed in the preceding chapters of the book, applies. However, some adaptations may be necessary. For example, visual similarity is more important in the context of pure shape marks, as aural and conceptual similarities cannot be assessed for such marks.

The authors conclude Chapter 8 and *The Confusion Test in European Trade Mark Law* by reminding readers that nontraditional marks are especially susceptible to invalidation challenges on the grounds of lack of distinctiveness or on the basis of policy exclusions, but without providing a proper conclusion on the aspects of the likelihood of confusion test in this area. This gives the book a somewhat abrupt ending. Perhaps a future edition would benefit either from a conclusion to this chapter or from the addition of a final, concluding chapter, drawing together all the threads explored in the previous chapters.

That said, given the thorough and clear introduction, the absence of a clear conclusion does not detract from the fact that *The Confusion Test in European Trade Mark Law* constitutes an excellent authority on the likelihood of confusion analysis in the EU, and has something to offer to everyone interested in this particular field. Written in clear and accessible language, and well balanced between academic analysis and practical guidance, it provides a good introduction to this area for more junior trademark practitioners who may choose to read the book cover to cover. With its clear headings and structure, it is also a good reference tool for the experienced trademark practitioner wishing to explore certain nuances of the likelihood of confusion analysis in more detail when carrying out brand clearances or when advising on trademark infringement and opposition matters. The wealth of references to source materials that may be explored for a deeper dive analysis is invaluable in that regard, as an exploration of these nuances may well assist a practitioner in nudging the outcome of a case in the desired direction when a trademark examiner or tribunal might be sitting on the fence.

BOOK REVIEW

By Stuart Green[*]

The Great Catapult: How Integrated IP Management Will Shoot Your Brand to Success. Zeeger Vink with James Nurton. 2020. Pp. 294. $22.45 (paperback); $7.95 (e-book). Frangipani.

The inherent value of brands, trademarks, and related intellectual property ("IP") as business assets may well be assumed knowledge for in-house IP counsel and branding specialists in private practice. The same cannot always be said for many of the C-suite executives, those top-level managers and boards at whose behest we often ply our trade, and who set or significantly influence the parameters within which we operate. There are those C-suite executives who are quick to "get it," who become ardent advocates for IP; and there are those who are resistant to the essential investment required to establish an effective IP strategy. Then there are those who, once provided with evidence, are pragmatically open to persuasion. Where misunderstanding and mischaracterization persist, it can often be an arduous and thankless task to find available, accessible tools and resources to efficiently and effectively facilitate the "skilling-up" of these key decision makers. Enter *The Great Catapult*: *How Integrated IP Management Will Shoot Your Brand to Success*.

Not so much a companion piece or text for an IP/trademarks course, but more a management reference resource for the C-suite, Zeeger Vink's *The Great Catapult* fills this gap in the market. Drawing on experience gained over the course of a distinguished career advising some of the world's most recognizable brands, Vink expertly navigates the fundamental issues. Vink provides practical, strategic, and operational insight into how companies can, with the right scaffolding and structure, "let IP play its role as a strategic value generator." He makes a clear case for positioning IP at the heart of strategy in a brand-orientated company and adopting the integrated approach to IP management that he advocates.

The Great Catapult is divided into two parts. Part I, "Analysis," provides an introduction to IP, its economic contribution, its function, and the necessity of integrated management as part and parcel of company strategy. Part II, "In Practice," is where *The Great Catapult* reveals its inherent value: providing practical and

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pragmatic commercial insights into the essential role of IP in marketing, business finance, communication, and the way companies can tactically integrate IP into their broader business strategy.

All readers will find value in Vink's example-laden narrative. Experienced trademark practitioners, however, will revel in revisiting, and having reaffirmed, many of the lessons learned working at the coalface of brand protection. The case studies contributed by experienced IP journalist James Nurton, traversing LACOSTE, MICROSOFT, NBA, NETFLIX, and PYRATES, provide critical lessons. These are sure to resonate with the target C-suite: some of these lessons relate to the evolution of strategy, commercial acumen, accrual of a knowledge base, and organizational awareness. Others show the significance of working with an experienced team, early engagement of IP counsel, coordinated approaches to enforcement, and—at its core—the importance of registered trademark rights.

A comprehensive, practical, and accessible work, designed to empower, *The Great Catapult* is destined to find a place on the bookshelf of all forward-looking executives and all those practitioners who take seriously their responsibility to provide clients with easily understandable, holistic advice.

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