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Giving the Wrong Impression: Section 2(a)'s False Suggestion of a Connection

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The Trademark Reporter®

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

*By Anne Gilson LaLonde***

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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

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

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.

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

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,

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 “TMPEP”) (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); TMPEP § 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?

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

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

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

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

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

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

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-Cuellar, Aiza y Enriquez, 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

⁶⁷ *Bridgestone/Firestone Research*, 245 F.3d at 1363. See, e.g., William McGeeveran, *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

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

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

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

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

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

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

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 protectable 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.

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.

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

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

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

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 interpretation¹⁴⁹ 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

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 at <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’ beliefs¹⁵⁹ 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

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

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

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

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).”).

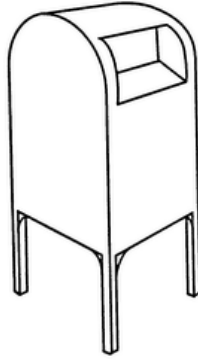
¹⁷⁹ *Id.* at 646.

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 “Woooooo. Pig. Sooie! Woooooo. Pig. Sooie! Woooooo. 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

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

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



But the TTAB did find that OLYMPIC CHAMPION was not a close enough approximation of OLYMPIC to falsely suggest a connection²⁰⁰ 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

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

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.”).

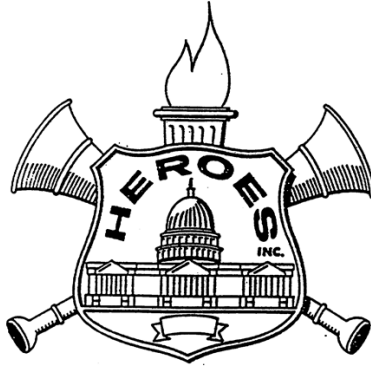
²¹⁰ *Terry v. Newman*, 2013 TTAB LEXIS 206, at *11 (T.T.A.B. 2013).

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

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



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

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

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

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 reputation²³⁸ 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

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 Ltda.*, 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

The image shows two hand-drawn marks in a bubbly, outlined font. The top mark reads 'SEX ROD' and the bottom mark reads 'RED SOX'. The letters are thick and irregular, with some overlapping and a slightly slanted, informal appearance.

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

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

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 image²⁵⁷ 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.

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

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

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.
