

University of San Diego

## Digital USD

---

University of San Diego Law and Economics  
Research Paper Series

Law Faculty Scholarship

---

May 2005

## Descriptive Trademarks and the First Amendment

Lisa P. Ramsey

*University of San Diego School of Law*, lramsey@sandiego.edu

Follow this and additional works at: [https://digital.sandiego.edu/lwps\\_econ](https://digital.sandiego.edu/lwps_econ)



Part of the [Law and Economics Commons](#)

---

### Digital USD Citation

Ramsey, Lisa P., "Descriptive Trademarks and the First Amendment" (2005). *University of San Diego Law and Economics Research Paper Series*. 9.

[https://digital.sandiego.edu/lwps\\_econ/art9](https://digital.sandiego.edu/lwps_econ/art9)

This Article is brought to you for free and open access by the Law Faculty Scholarship at Digital USD. It has been accepted for inclusion in University of San Diego Law and Economics Research Paper Series by an authorized administrator of Digital USD. For more information, please contact [digital@sandiego.edu](mailto:digital@sandiego.edu).

## DESCRIPTIVE TRADEMARKS AND THE FIRST AMENDMENT

LISA P. RAMSEY\*

### *Table of Contents*

I. INTRODUCTION .....	1096
II. THE LAW OF TRADEMARKS .....	1102
A. <i>The Objectives of Federal Trademark Law</i> .....	1104
B. <i>The Trademark Continuum: What Marks are Eligible for     Protection?</i> .....	1106
1. Inherently Distinctive Marks: Fanciful, Arbitrary, and Suggestive Marks .....	1108
2. Descriptive Marks .....	1110
a. Evolution of Trademark Protection for Descriptive Terms .....	1113
b. Secondary Meaning .....	1118
3. Generic Terms .....	1121
C. <i>Enforcement of Federal Trademark Rights Under the     Lanham Act</i> .....	1124
1. Federal Trademark Infringement and Unfair Competition .....	1124
2. Federal Trademark Dilution Act .....	1127
3. Anticybersquatting Consumer Protection Act .....	1129
III. FIRST AMENDMENT PROTECTION OF COMMERCIAL SPEECH .....	1130
A. <i>Evolution of First Amendment Protection of Commercial     Speech</i> .....	1130
B. <i>The Central Hudson Test for Evaluating the Constitutionality     of Commercial Speech Regulations</i> .....	1134
IV. FIRST AMENDMENT LIMITATIONS ON THE ENFORCEMENT OF TRADEMARK RIGHTS .....	1137
A. <i>Governmental Restrictions on the Commercial Use     of Trademarks</i> .....	1138
B. <i>Governmental Restrictions on the Use of Trademarks to     Communicate Ideas</i> .....	1143

---

\* Lisa Pondrom Ramsey is an intellectual property and appellate attorney in San Diego, California. Thanks to Tom W. Bell, Michael Ramsey, Susan Tiefenbrun, and the faculties of Hofstra University School of Law, the UCLA School of Law, the University of Cincinnati College of Law, and the University of San Diego School of Law for their comments on this Article.

V. TRADEMARK LAWS THAT GRANT AND ENFORCE EXCLUSIVE RIGHTS IN DESCRIPTIVE TERMS VIOLATE THE FIRST AMENDMENT RIGHT OF FREE EXPRESSION . . . . .	1146
<i>A. Analysis of the Constitutionality of Descriptive Trademark Laws     Under Central Hudson . . . . .</i>	1147
1. Descriptive Terms Used as Marks Concern a Lawful Activity and Are Not Misleading . . . . .	1148
2. The Government Has a Substantial Interest in Protecting the Ability of Consumers to Identify and Distinguish Among the Products of Competing Sources . . . . .	1152
3. Granting and Protecting Exclusive Rights in Descriptive Marks Does Not Directly and Materially Advance the Asserted Governmental Interest . . . . .	1156
4. Trademark Laws Enforcing Rights in Descriptive Terms are More Extensive Than Necessary to Serve the Asserted Governmental Interest . . . . .	1159
a. The Government Suppresses More Speech Than Necessary When It Protects Rights in Marks That Inherently Convey Product Information . . . . .	1159
b. The Incontestability Doctrine . . . . .	1164
c. The Use of Trademark Symbols (® and ™) . . . . .	1166
d. The Fair Use Defense . . . . .	1167
<i>B. Descriptive Terms Should be Eliminated from Protection     as Trademarks . . . . .</i>	1169
1. Reliance on Current Trademark Protection . . . . .	1170
2. The Critical and Difficult Line Between Suggestive and Descriptive Marks . . . . .	1171
3. Uniformity of International Trademark Law . . . . .	1174
VI. CONCLUSION . . . . .	1174

#### I. INTRODUCTION

First Amendment challenges to trademark laws are increasingly common. Scholars have generally expressed concern that the “propertization” of trademark law<sup>1</sup>—the increasing tendency to treat trademarks as property—may

---

1. See Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 EMORY L.J. 367, 371-420 (1999); Margaret Jane Radin & R. Polk Wagner, *The Myth of Private Ordering: Rediscovering Legal Realism in Cyberspace*, 73 CHI.-KENT L. REV. 1295, 1305 n.29 (1998) (“Modern trademark law is moving . . . towards a . . . property rights regime.”); see also Stephen L. Carter, *Does It Matter Whether Intellectual Property is Property?*, 68 CHI.-KENT L. REV. 715, 720-23 (1993) (discussing the property rationale as applied to trademark law); David J. Franklyn, *Owning Words in Cyberspace: The Accidental Trademark Regime*, 2001 WIS. L. REV. 1251, 1256-63 (2001) (summarizing the history of the propertization of trademark law).

stifle speech in various respects.<sup>2</sup> Commentators question whether trademark actions based on a theory of dilution violate the First Amendment's right of free expression.<sup>3</sup> Defendants contend their use of another's distinctive mark as part of a parody or film title is constitutionally protected expression rather than infringement or dilution.<sup>4</sup> Yet, no one has raised or addressed the basic question of whether the protection of exclusive rights in descriptive trademarks is an unconstitutional restriction of speech under the First Amendment.<sup>5</sup>

A descriptive mark is a word, name, or symbol used to indicate a brand of product or service that also describes the qualities or characteristics of the product or service sold under that mark. The Federal Trademark Act of 1946,<sup>6</sup> more commonly known as the Lanham Act, presently allows applicants to register marks that are "distinctive" of the applicant's goods or services in commerce, including descriptive marks that have "become distinctive."<sup>7</sup> For example, the Patent and Trademark Office (PTO) has allowed Fox News Network to register the descriptive phrase "Fair & Balanced" for news-reporting services.<sup>8</sup> The Lanham Act also grants exclusive rights in distinctive marks and permits broad enforcement of these rights against domain name

2. See, e.g., Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1687-88, 1693-97, 1710-15 (1999).

3. See, e.g., Richard B. Biagi, *The Intersection of First Amendment Commercial Speech Analysis and the Federal Trademark Dilution Act: A Jurisprudential Roadmap*, 91 TRADEMARK REP. 867, 875-87 (2001); Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protections of Trade Symbols*, 1982 WIS. L. REV. 158, 158-60, 190-207 (1982) (analyzing the constitutionality of misappropriation and dilution rationales); Megan E. Gray, *Defending Against a Dilution Claim: A Practitioner's Guide*, 4 TEX. INTELL. PROP. L.J. 205, 225-27 (1996); Robert N. Kravitz, *Trademarks, Speech and the Gay Olympics Case*, 69 B.U. L. REV. 131, 138-43 (1989) (discussing the misappropriation, dilution, and tarnishment theories); Kenneth L. Port, *The "Unnatural" Expansion of Trademark Rights: Is a Federal Dilution Statute Necessary?*, 18 SETON HALL LEGIS. J. 433, 446 (1994); Simone A. Rose, *Will Atlas Shrug? Dilution Protection for "Famous" Trademarks: Anti-Competitive "Monopoly" or Earned "Property" Right?*, 47 FLA. L. REV. 653, 739-40 (1995).

4. See *infra* Subpart IV.B.

5. The last challenge to the protection of descriptive marks was made in 1946, during debate over language in the current federal trademark statute. At that time, "[t]he Conference Committee rejected an amendment that would have denied registration to any descriptive mark, and instead retained the provisions allowing registration of a merely descriptive mark that has acquired secondary meaning." *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 197 (1985) (citing H.R. CONF. REP. NO. 79-2322, at 4 (1946) (explanatory statement of House managers)).

6. Federal Trademark Act, 15 U.S.C. §§ 1051-1127 (2000).

7. 15 U.S.C. §§ 1052(e)(1), (f), 1053.

8. Reg. No. 2,213,427 (registered Dec. 22, 1998) (registration of "FAIR & BALANCED" by Fox News Network on the principal register for "entertainment services in the nature of production and distribution of television news programs").

registrants, competitors, and others who use the same descriptive term as a mark to advertise and sell their own goods or services.<sup>9</sup> Thus, news organizations like CNN or MSNBC may not use the phrase “Fair & Balanced” as a mark in advertisements under current trademark law. This Article concludes that the First Amendment does not allow the government to grant and enforce exclusive rights in descriptive marks.<sup>10</sup>

Today, United States trademark law protects fanciful marks (e.g., “Kodak” film), arbitrary marks (e.g., “Apple” computers), suggestive marks (e.g., “Tide” laundry detergent), and, if they have “become distinctive,” descriptive marks (e.g., “Park ’N Fly” long-term parking lot services near airports). On the other hand, generic marks (e.g., “Shredded Wheat” breakfast cereal)—the common name for a class of products or services—are never considered worthy of trademark protection.<sup>11</sup> If the “primary significance of the term in the minds of the consuming public” is the product, rather than the producer, the mark is not capable of protection under the trademark laws.<sup>12</sup>

Courts and scholars agree that protecting exclusive rights in generic terms would inhibit free expression in the marketplace and harm competition.<sup>13</sup> A single business should not have a monopoly on the use of common words that consumers use to refer generally to a product.<sup>14</sup> A business with an exclusive

9. See 15 U.S.C. § 1115(a) (stating that registration on the principal register is “prima facie evidence of . . . the registrant’s exclusive right to use the registered mark”); 15 U.S.C. § 1125(d)(1) (imposing civil liability for cyberpiracy); 15 U.S.C. § 1114(1) (prohibiting infringement of a registered mark); 15 U.S.C. § 1125(a) (protecting unregistered marks from infringement). The Act also protects marks from dilution if the mark is famous. 15 U.S.C. § 1125(c)(1).

The phrase “use . . . as a mark” used in this Article refers not to the Lanham Act’s definition of a trademark, see *infra* note 25, but rather to the courts’ interpretation of this phrase when applying the fair use defense: “use . . . as a mark” includes use of the term in a brand name, domain name, or attention-getting slogan. See *infra* Subsection V.A.4.d.

10. The First Amendment provides that “Congress shall make no law . . . abridging the freedom of speech, or of the press. . . .” U.S. CONST. amend. I. “Although the text of the First Amendment states that ‘Congress shall make no law . . . abridging the freedom of speech, or of the press,’ the Amendment applies to the States under the Due Process Clause of the Fourteenth Amendment.” 44 *Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 489 n.1 (1996) (emphasis added). When private parties invoke federal or state statutes in court to prevent speech, this constitutes sufficient government action to trigger First Amendment scrutiny. *New York Times Co. v. Sullivan*, 376 U.S. 254, 265 (1964) (holding that the plaintiff’s use of state libel law in a civil case was sufficient state action to trigger First Amendment scrutiny).

11. The five different categories of marks—fanciful, arbitrary, suggestive, descriptive, and generic—are discussed in detail in Subpart II.B. of this Article.

12. *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 118 (1938) (rejecting the plaintiff’s contention that it was entitled to exclusive use of the generic term “shredded wheat”).

13. See *infra* Subsection V.A.4.a.

14. For the sake of brevity, and because the distinction between trademarks (for goods) and service marks (for services) is irrelevant for purposes of this Article, this Article uses the word “goods” or “products” to refer to both goods and services, and “trademarks” or “marks”

right to use a generic term as a mark has an unfair advantage if competitors cannot use the same term to communicate regarding their own products.

For these same reasons, this Article argues that descriptive marks should also be eliminated from trademark protection. The First Amendment does not allow the government to set aside descriptive words in the linguistic commons for exclusive use by one business as a trademark. This is because descriptive terms, like generic terms, inherently provide information regarding the product sold under the mark. Descriptive marks do not identify the origin or source of a product as well as a mark that is fanciful, arbitrary, or suggestive because, unlike these three “inherently distinctive” marks,<sup>15</sup> descriptive terms retain their original descriptive meaning.<sup>16</sup> Even if the public associates the descriptive phrase “Fair & Balanced” with Fox News, the slogan “Fair & Balanced” also advertises to consumers that the news organization using that term will provide fair and balanced news. Descriptive terms used as marks do not automatically or immediately signal a brand (unlike inherently distinctive marks) because they also function to describe the attributes of the product. For this reason, protecting exclusive rights in descriptive marks does not directly and materially further trademark law’s goal of helping consumers identify and distinguish among the products of competing manufacturers.

Furthermore, current trademark law stifles the free flow of commercial information more than necessary when it protects exclusive rights both in inherently distinctive marks *and* descriptive marks. There is no significant First Amendment injury when competitors of Kodak are prohibited from using the word “Kodak” as a mark on product packaging for their own film, because “Kodak” does not provide information about the attributes of the film. Free speech interests are harmed, however, when competitors of Fox News cannot use the descriptive phrase “Fair & Balanced” as part of a slogan or domain name. As this phrase provides information about the attributes of the news services regardless of whether the public associates the term with Fox News, trademark restrictions on use of the term “Fair & Balanced” suppress expression that is relevant to consumers. Like generic terms, such as “News,” descriptive terms should be available for use by everyone in a particular industry. Commercial expression is suppressed more than necessary when our trademark laws allow one company to register the descriptive term “Park ’N

---

to refer to both trademarks and service marks. All Lanham Act provisions governing trademarks are applicable to service marks. 15 U.S.C. § 1053; *Park ’N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 191 n.1 (1985) (noting that the Lanham Act “generally applies the same principles concerning registration and protection to both trade and service marks”).

15. Fanciful, arbitrary, or suggestive marks “almost *automatically* tell a customer that [the term] refer[s] to a brand” and “immediately . . . signal a brand or a product ‘source.’” *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162-63 (1995), *quoted in Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 212-13 (2000). “Consumers are therefore predisposed to regard those symbols as indication of the producer.” *Wal-Mart*, 529 U.S. at 212.

16. *See infra* Section V.A.3.

Fly” for airport parking lot services, and enjoin competitors, such as “Dollar Park and Fly,” from using “Park and Fly” as part of their brand name to inform customers that they can park and fly at this particular airport parking lot.<sup>17</sup> As companies can use inherently distinctive marks to identify and distinguish their products, trademark laws harm speech more than necessary when they grant exclusive rights in marks that are not inherently distinctive.

Current federal trademark law also unnecessarily harms speech in other ways relating to the use of descriptive terms. The Lanham Act allows rights in descriptive marks to become incontestable, or immune from legal challenge on distinctiveness grounds, even when the PTO errs and registers a descriptive term that has not acquired distinctiveness. Another problem is that companies can use trademark symbols (® and ™) with descriptive terms that are not distinctive to discourage use of those terms by competitors. Finally, the Lanham Act’s fair use defense is limited and does not adequately protect the right of competitors to describe the attributes of their goods. Many of these problems could be solved by eliminating trademark rights in descriptive terms.

Businesses do not need exclusive rights in descriptive marks to compete effectively in the marketplace. When selecting a mark, they can either coin a new word or choose a random word or combination of words from the dictionary that have nothing to do with the product. For example, the trademarks “Kodak,” “Apple,” and “Tide” are all strong, distinctive marks, but they do not describe photographic equipment, computers, and laundry detergent, respectively. Due to extensive advertising and product sales under these distinctive marks, these words now identify a single source of photographic equipment, computers, and laundry detergent. Trademark law should encourage companies to use inherently distinctive marks because these marks instantaneously tell a customer that the term refers to a brand name, not a product attribute. Instead, current law creates an incentive to use descriptive marks because the “senior user”<sup>18</sup> of a descriptive term as a mark can obtain exclusive rights in that term *and* use the mark to quickly and cheaply provide consumers with information regarding the attributes of the product.

When Congress enacted the current federal trademark law in 1946, commercial speech was not protected by the First Amendment. That is not the case today. Although the commercial speech doctrine has developed independently of the Lanham Act since the 1970s, it is applicable to trademark

---

17. These are the facts from *Park 'N Fly, Inc. v. Dollar Park & Fly*, 469 U.S. 189 (1985). After finding that the plaintiff had incontestable rights in the mark “Park 'N Fly” for airport parking lot services and the defendant’s use of “Dollar Park and Fly” was likely to cause confusion, the district court “permanently enjoined [defendant] from using the words ‘Park and Fly’ and any other mark confusingly similar to ‘Park 'N Fly.’” *Id.* at 192.

18. The “senior user” of a mark is the first business to use the word as a mark. This Article will use the terms “senior user,” “mark-holder,” or “plaintiff” to indicate the first business that uses the word as a mark, and “junior user,” “competitor,” or “defendant” to indicate companies that thereafter use the word as a mark.

laws that prohibit a competitor from using trademarked descriptive words to sell a product. Such laws are unconstitutional because they fail to satisfy the test for evaluating the constitutionality of regulations of commercial expression set forth by the Supreme Court in *Central Hudson Gas & Electric Corp. v. Public Service Commission*.<sup>19</sup>

The essence of the *Central Hudson* test is that “[a] restriction on nonmisleading commercial speech may be justified if the government’s interest in the restriction is substantial, [and the law] directly advances the government’s asserted interest, and is no more extensive than necessary to serve the interest.”<sup>20</sup> The use of a descriptive term to accurately describe a product is not misleading expression regardless of whether another business claims trademark rights in that term.<sup>21</sup> Although the government has a substantial interest in protecting the ability of consumers to identify and distinguish among the products of a business and its competitors, descriptive trademark laws do not directly advance this interest and are more extensive than necessary.<sup>22</sup>

While no scholar to date has argued that descriptive trademark laws fail First Amendment scrutiny under the *Central Hudson* test, this conclusion directly follows from an analysis of the trademark and First Amendment laws. Part II of this Article provides background information regarding trademarks and the types of legal actions available to a mark-holder based on the unauthorized use of its distinctive mark. Part III explains how First Amendment doctrine has evolved to protect commercial speech and sets forth *Central Hudson*’s four-factor test for determining whether governmental restrictions on commercial speech are constitutional. Part IV discusses the current relationship between trademark laws and the First Amendment and the applicable level of constitutional scrutiny in trademark cases. Part V applies the *Central Hudson* test to descriptive trademark laws and concludes that it is unconstitutional for the government to grant and enforce exclusive rights in descriptive trademarks. Ultimately, this Article suggests that the First Amendment requires federal and state governments to refuse to register descriptive marks, prohibit trademark actions based on rights in descriptive marks, and cancel any current registrations of descriptive marks.<sup>23</sup>

---

19. 447 U.S. 557 (1980).

20. *S.F. Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522, 537 n.16 (1987) (citing *Central Hudson*, 447 U.S. at 566).

21. *See infra* Section V.A.1.

22. *See infra* Sections V.A.2-4.

23. Although private entities also enforce trademark rights in descriptive marks against domain name registrants under policies such as the Uniform Domain Name Dispute Resolution Policy, the constitutionality of this practice is beyond the scope of this Article. For a discussion of how the policies of the Internet Corporation for Assigned Names and Numbers fail to protect free expression, see generally Dawn C. Nunziato, *Freedom of Expression, Democratic Norms, and Internet Governance*, 52 EMORY L.J. 187 (2003).

## II. THE LAW OF TRADEMARKS

Trademarks have been used to indicate the source or origin of products for thousands of years.<sup>24</sup> A trademark is “any word, name, symbol, or device, or any combination thereof” used by a business to identify itself as the source of certain goods and distinguish its goods from those manufactured or sold by competitors.<sup>25</sup> Examples of words used as trademarks include “Starbucks” coffee and “Banana Republic” clothing. A service mark is similar to a trademark, but it identifies and distinguishes the services of a business, rather

24. See 5 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 5:1 (4th ed. 2003). According to Professor McCarthy,

In surveying history, it appears that humans have used symbols to identify ownership or origin of articles for thousands of years. Probably the earliest form of marking was the branding of cattle and other animals. Wall paintings of ancient Egypt show cattle being branded by field workers. The English word “brand” is derived from an Anglo-Saxon word meaning “to burn.” Quarry marks and stonecutters’ signs have been found in Egypt in structures estimated to have been erected as early as 4000 B.C. Roman signboards were found in the ruins of Pompeii. In fifteenth century England, sword makers and armorers were required to use identifying marks so that defective weapons could be traced back to the maker. . . . Some of the medieval guilds required the use of marks to identify merchandise. At about the same time during the feudal period in Japan, trademarks were widely used.

*Id.* (footnotes omitted). With regard to American trademark law, McCarthy notes that [i]n 1791 sailcloth-maker Samuel Breck and others petitioned Thomas Jefferson, then Secretary of State, for the exclusive privilege of using particular marks for designating the “cloth of their manufacture.” Jefferson replied that it would, in his opinion, “contribute to fidelity in the execution of manufacturers, to secure to every manufactory, an exclusive right to mark its wares.”

*Id.* (quoting 3 WRITINGS OF THOMAS JEFFERSON 157 (A. E. Bergh ed., 1907)).

25. 15 U.S.C. § 1127 (2000); see *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 209 (2000) (quoting 15 U.S.C. § 1127); see also *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 170-71 (1995) (“In 1878, this Court described the common-law definition of trademark rather broadly to ‘consist of a name, symbol, figure, letter, form, or device, if adopted and used by a manufacturer or merchant in order to designate the goods he manufactures or sells to distinguish the same from those manufactured or sold by another.’”) (quoting *McLean v. Fleming*, 96 U.S. 245, 254 (1877)). The Lanham Act provides the following definition of “trademark”:

The term “trademark” includes any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

15 U.S.C. § 1127.

than its goods.<sup>26</sup> Examples of service marks include “Wells Fargo” banking services and “Delta Air Lines” air transportation services. Slogans can also be used as trademarks; examples include “We Try Harder” for Avis rental car services and “Get a Piece of the Rock” for Prudential’s insurance and investment services. Moreover, trademarks are not limited to words; particular sounds (e.g., NBC’s three chimes), scents (e.g., plumeria blossoms on sewing thread), colors (e.g., green-gold on dry cleaning press pads), and trade dress (e.g., product packaging or design of a product, such as a Coca Cola bottle or bedroom furniture) can act as a symbol or device to distinguish one business’s goods from those of a competitor.<sup>27</sup>

In the United States, distinctive trademarks currently receive protection under both federal and state laws.<sup>28</sup> Congressional authority to draft laws granting and enforcing exclusive rights in trademarks derives from the federal legislature’s power to regulate interstate commerce, not from any specific provision in the Constitution.<sup>29</sup> The current federal trademark statute, the

26. According to the Lanham Act,

The term “service mark” means any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown.

15 U.S.C. § 1127.

27. See *Wal-Mart*, 529 U.S. at 209-10; *Qualitex*, 514 U.S. at 162; *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 773 (1992).

28. In 1879 the Supreme Court explained that trademark rights existed in the common law and some state statutes long before Congress enacted the first federal trademark law:

The right to adopt and use a symbol or a device to distinguish the goods or property made or sold by the person whose mark it is, to the exclusion of use [of that symbol] by all other persons, has been long recognized by the common law and the chancery courts of England and of this country, and by the statutes of some of the States. It is a property right for the violation of which damages may be recovered in an action at law, and the continued violation of it will be enjoined by a court of equity, with compensation for past infringement. This exclusive right was not created by the act of Congress, and does not now depend upon it for its enforcement. The whole system of trade-mark property and the civil remedies for its protection existed long anterior to that act, and have remained in full force since its passage.

Trade-Mark Cases, 100 U.S. 82, 92 (1879).

29. 5 MCCARTHY, *supra* note 24, § 5:3 (“The power of the federal government to provide for trademark registration comes only under its ‘Commerce Power’. That is, the power to ‘regulate commerce with foreign Nations, and among the several states, and with the Indian Tribes.’”) (quoting U.S. CONST. art. I, § 8, cl. 3). While the United States Constitution grants Congress the specific power to protect exclusive rights in the writings of authors (under copyright law) and the discoveries of inventors (under patent law), it does not grant any such

Lanham Act, provides for the national registration of distinctive marks used in commerce and for the enforcement of rights in distinctive marks regardless of registration.<sup>30</sup> Although states have similar trademark registration statutes for marks used within their borders,<sup>31</sup> for the sake of brevity and simplicity, the discussion below focuses only on the Lanham Act.

*A. The Objectives of Federal Trademark Law*

Congress enacted the Lanham Act to “mak[e] actionable the deceptive and misleading use of marks” and to “protect persons engaged in . . . commerce against unfair competition. . . .”<sup>32</sup> The United States Supreme Court has explained that federal trademark law has two objectives: (1) protection of the ability of consumers to identify and distinguish among the goods of competing manufacturers, and (2) protection of business goodwill symbolized by a mark.<sup>33</sup> According to the Court, federal trademark law does not exist to reward product innovation and “has no necessary relation to invention or discovery.”<sup>34</sup>

---

specific power with regard to trademarks. *See* U.S. CONST. art. I, § 8, cl. 8 (granting Congress the power “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries”); *Trade-Mark Cases*, 100 U.S. at 93-94 (stating that trademarks are “simply founded on priority of appropriation” and cannot be equated with inventions, discoveries, or the writings of authors); 5 MCCARTHY, *supra* note 24, § 5:3.

30. *See* Federal Trademark Act, 15 U.S.C. §§ 1051-1127 (2000); *see also infra* Subparts II.B-C.

31. *See e.g.*, CAL. BUS. & PROF. CODE §§ 14200-14242 (West 1987); N.Y. GEN. BUS. LAW §§ 360 to 368-e (McKinney 1996); TEX. BUS. & COM. CODE ANN. §§ 16.08-21 (Vernon 2002).

32. 15 U.S.C. § 1127; *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 123 S. Ct. 2041, 2045 (2003) (quoting this portion of the text of 15 U.S.C. § 1127).

33. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985) (“The Lanham Act provides national protection of trademarks in order to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers.”); *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 854 n.14 (1982) (noting that an infringer subverts the two goals of the Lanham Act by depriving a trademark “owner of the goodwill which he spent energy, time, and money to obtain” and depriving “consumers of their ability to distinguish among the goods of competing manufacturers”).

34. *Dastar*, 123 S. Ct. at 2045 (quoting *Trade-Mark Cases*, 100 U.S. at 94). In *Dastar*, the Supreme Court explained:

The Lanham Act . . . “does not exist to reward manufacturers for their innovation in creating a particular device;” . . . Federal trademark law “has no necessary relation to invention or discovery,” . . . but rather, by preventing competitors from copying a “source-identifying mark,” “reduce[s] the customer’s costs of shopping and making purchasing decisions,” and “helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product.”

*Id.* at 2048 (quoting *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 34 (2001));

By prohibiting competitors from copying a source-identifying mark, trademark law aids consumers who use trademarks in the marketplace to quickly and easily identify a product they liked or disliked in the past; trademarks help consumers distinguish among competing manufacturers of a product.<sup>35</sup> “The fundamental purpose of a trademark is to reduce consumer search costs by providing a concise and unequivocal identifier of the particular source of particular goods.”<sup>36</sup> Trademarks “signify to consumers that all goods bearing the trademark come from the same source and are of an equal level of quality.”<sup>37</sup> Thus, trademark laws protect consumer “expectations by excluding others from using a particular mark and making consumers confident that they can purchase brands without being confused or misled.”<sup>38</sup>

In addition, “[t]rademarks . . . serve as the objective symbol of a business’s good will and are a prime instrument in advertising and selling goods.”<sup>39</sup> By prohibiting misappropriation of this symbol of goodwill, the Lanham Act protects the mark-holder’s investment of time, energy, and money in advertising and selling a quality product under a source-identifying mark.<sup>40</sup>

---

*Trade-Mark Cases*, 100 U.S. at 94; *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163-64 (1995)).

35. *Qualitex Co.*, 514 U.S. at 163-64 (“In principle, trademark law, by preventing others from copying a source-identifying mark, ‘reduce[s] the customer’s costs of shopping and making purchasing decisions,’ for it quickly and easily assures a potential customer that *this* item—the item with this mark—is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past.” (citation omitted)); *Park ‘N Fly*, 469 U.S. at 198 (“The Lanham Act . . . protect[s] the ability of consumers to distinguish among competing producers.”); *Inwood Labs.*, 456 U.S. at 854 n.14 (stating that the Lanham Act ensures consumers of their “ability to distinguish among the goods of competing manufacturers”); *Tamko Roofing Prods., Inc. v. Ideal Roofing Co.*, 282 F.3d 23, 38 (1st Cir. 2002) (recognizing that one purpose of the Lanham Act “is to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get”) (quoting S. REP. NO. 79-1333, at 1 (1946)).

36. *Ty Inc. v. Perryman*, 306 F.3d 509, 510 (7th Cir. 2002); see *Brookfield Communications, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1051 (9th Cir. 1999) (“The purpose of a trademark is to help consumers identify the source . . . .”); *Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc.*, 781 F.2d 604, 609 (7th Cir. 1986) (“The goal of trademark protection is to allow a firm to affix an identifying mark to its product (or service) offering that will, because it is distinctive and no competitor may use a confusingly similar designation, enable the consumer to discover in the least possible amount of time and with the least possible amount of head-scratching whether a particular brand is that firm’s brand or a competitor’s brand.”).

37. *Dakota Indus., Inc. v. Ever Best Ltd.*, 944 F.2d 438, 440 (8th Cir. 1991).

38. *Davidoff & CIE, S.A. v. PLD Int’l Corp.*, 263 F.3d 1297, 1301 (11th Cir. 2001).

39. *Dakota*, 944 F.2d at 440.

40. *Park ‘N Fly*, 469 U.S. at 198 (stating that federal trademark laws “secure to the owner of the mark the goodwill of his business”); *Inwood Labs.*, 456 U.S. at 854 n.14 (noting that one goal of the Lanham Act is to protect the trademark owner’s “goodwill which he spent energy, time, and money to obtain”); *Tamko Roofing*, 282 F.3d at 38 (discussing legislative history of the Lanham Act: “[W]here the owner of a trade-mark has spent energy, time, and money in

According to the Supreme Court, “National protection of trademarks is desirable . . . because trademarks foster competition and the maintenance of quality by securing to the producer the benefits of good reputation.”<sup>41</sup>

*B. The Trademark Continuum: What Marks are Eligible for Protection?*

“It is the source-distinguishing ability of a mark—not its ontological status as color, shape, fragrance, word, or sign—that permits it to serve the[] basic purposes” of trademark law.<sup>42</sup> Thus, a word, name, symbol, or device is protectable as a trademark only if it is distinctive—if the alleged mark, in fact, functions to identify a source of goods and distinguish those goods from the goods of competitors.<sup>43</sup> A trademark may be federally registered with the PTO

---

presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats”) (quoting S. REP. NO. 79-1333, at 1 (1946)); *Davidoff & CIE*, 263 F.3d at 1301 (“The Lanham Act also protects trademark owners. A trademark owner has spent time, energy and money in presenting a product to the public and building a reputation for that product.” (citation omitted)).

41. *Park 'N Fly*, 469 U.S. at 198, *quoted in* S.F. Arts & Athletics, Inc. v. United States Olympic Comm., 483 U.S. 522, 531 (1987). As explained by the Supreme Court:

In principle, trademark law, by preventing others from copying a source-identifying mark, . . . helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product. The law thereby “encourage[s] the production of quality products,” and simultaneously discourages those who hope to sell inferior products by capitalizing on a consumer’s inability quickly to evaluate the quality of an item offered for sale.

*Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163-64 (1995) (citations omitted); *see also* *Davidoff & CIE*, 263 F.3d at 1301 (“The [Lanham] Act prevents another vendor from acquiring a product that has a different set of characteristics and passing it off as the trademark owner’s product. This would potentially confuse consumers about the quality and nature of the trademarked product and erode consumer goodwill.” (citation omitted)).

42. *Qualitex*, 514 U.S. at 164; *EMI Catalogue P’ship v. Hill, Holliday, Connors, Cosmopulos Inc.*, 228 F.3d 56, 62 (2d Cir. 2000) (“A mark’s source-distinguishing ability allows it to serve those basic purposes that gave birth to trademark law in the first place; that is, to ensure that a product’s maker reaps the rewards of the reputation it has built, and to enable consumers to recognize and repurchase goods with which they have previously been satisfied.”).

43. 15 U.S.C. § 1127 (2000) (stating that a trademark must “identify and distinguish [one’s] goods, including a unique product, from those manufactured or sold by others and . . . indicate the source of the goods, even if that source is unknown”); 15 U.S.C. § 1052 (allowing the registration of any mark “by which the goods of the applicant may be distinguished from the goods of others” subject to certain exceptions), *quoted in* *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 211 (2000); 15 U.S.C. § 1052(f) (“[N]othing . . . shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce.”); *Vision Sports, Inc. v. Melville Corp.*, 888 F.2d 609, 612-13 (9th Cir. 1989) (“Because of the very nature of trademark protection, ‘its emphasis and thrust . . . is in the direction of deciding whether an alleged symbol in fact functions to identify and distinguish

on the principal register only if the mark is “distinctive of the applicant’s goods in commerce”<sup>44</sup> and does not fall within one of the exceptions to registration set forth in § 1052 of the Lanham Act.<sup>45</sup> Moreover, “the general principles qualifying a mark for registration under [§ 1052] are for the most part applicable in determining whether an unregistered mark is entitled to federal trademark protection.”<sup>46</sup> Although distinctiveness is a prerequisite to registration on the federal principal register and protection of exclusive trademark rights, the word “distinctive” is not defined anywhere in the Lanham Act.<sup>47</sup>

To conceptualize distinctiveness, Judge Friendly in 1976 proposed using the following categories of trademarks: generic, descriptive, suggestive, arbitrary, and fanciful.<sup>48</sup> Generic terms receive no trademark protection, descriptive terms may be protected if they acquire “secondary meaning,” and the last three categories of “inherently distinctive” marks are always eligible for registration and protection under trademark law.<sup>49</sup> Put another way, “[t]he

---

the goods and services of one seller . . . .” (quoting 1 MCCARTHY, *supra* note 24, § 2.2 (2d ed. 1984)); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 cmt. a (1995) (“[A] designation is protectable as a trademark . . . only if [it] is ‘distinctive’ . . . . A designation is distinctive only if it functions as a symbol of identification. To be eligible for protection as a trademark . . . , the designation must identify the goods, services, or business of the person asserting rights in the designation.”).

44. 15 U.S.C. § 1052(f); see *Qualitex*, 514 U.S. at 162 (noting that § 1052 “gives a seller or producer the exclusive right to ‘register’ a trademark”).

45. See 15 U.S.C. § 1052.

46. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992).

47. See generally Federal Trademark Act, 15 U.S.C. §§ 1051-1127 (2000).

48. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9-11 (2d Cir. 1976); see *Wal-Mart*, 529 U.S. at 210-11 (noting that Judge Friendly first formulated the “now-classic test” for determining whether word marks are inherently distinctive); *Two Pesos*, 505 U.S. at 768 (discussing Judge Friendly’s “classic formulation” of the five trademark “categories of generally increasing distinctiveness”); *Japan Telecom, Inc. v. Japan Telecom Am. Inc.*, 287 F.3d 866, 872 (9th Cir. 2002); *Abercrombie & Fitch Stores, Inc. v. Am. Eagle Outfitters, Inc.*, 280 F.3d 619, 635-36 (6th Cir. 2002); *TCPIP Holding Co. v. Haar Communications Inc.*, 244 F.3d 88, 93 (2d Cir. 2001); *Hunt Masters, Inc. v. Landry’s Seafood Rest., Inc.*, 240 F.3d 251, 253-54 (4th Cir. 2001); *A & H Sportswear, Inc. v. Victoria’s Secret Stores, Inc.*, 237 F.3d 198, 221-22 (3d Cir. 2000). According to the Seventh Circuit, “Judge Friendly proposed the continuum of generic, descriptive, suggestive, arbitrary, and fanciful marks as a heuristic, a means to guide thought rather than to replace the statutory requirements” of the Lanham Act. *Bliss Salon Day Spa v. Bliss World LLC*, 268 F.3d 494, 496 (7th Cir. 2001).

49. *Two Pesos*, 505 U.S. at 768-69; *A & H Sportswear*, 237 F.3d at 222 (“In order to qualify for Lanham Act protection, a mark must either be suggestive, arbitrary, or fanciful, or must be descriptive with a demonstration of secondary meaning.”). The Sixth Circuit recently explained the rules regarding trademark protection of words as follows:

The so-called *Abercrombie & Fitch* taxonomy deems word marks inherently distinctive when they are arbitrary (“Lucky Strike” cigarettes), fanciful (“Kodak” film), or suggestive (“Tide” laundry detergent). By contrast, descriptive (“Soft Soap”) or generic (“soap”)

general rule regarding distinctiveness is clear: An identifying mark is distinctive and capable of being protected if it *either* (1) is inherently distinctive *or* (2) has acquired distinctiveness through secondary meaning.<sup>50</sup> Although the lines of demarcation between the five categories of marks “are not always bright”<sup>51</sup> and the labels are “frequently difficult to apply,”<sup>52</sup> courts usually classify a mark somewhere along this trademark continuum because the distinctiveness or strength of the mark is a critical issue in trademark law.<sup>53</sup>

### 1. Inherently Distinctive Marks: Fanciful, Arbitrary, and Suggestive Marks

Trademark laws protect fanciful, arbitrary, and suggestive marks “because their intrinsic nature serves to identify a particular source of a product.”<sup>54</sup> These marks “immediately . . . signal a brand or a product ‘source.’”<sup>55</sup>

---

terms do not inherently distinguish a good as coming from a particular source. . . . While not inherently distinctive, descriptive marks can identify a source and acquire distinctiveness if secondary meaning has attached to the term, such that consumers recognize “Soft Soap” as a product of a certain manufacturer. “Generic marks . . . are not registrable as trademarks.”

*Abercrombie & Fitch Stores*, 280 F.3d at 635-36 (citations omitted) (citing *Abercrombie & Fitch Co.*, 537 F.2d at 9-11) (quoting *Two Pesos*, 505 U.S. at 768).

50. *Two Pesos*, 505 U.S. at 769; see *Wal-Mart*, 529 U.S. at 210-11.

51. *Abercrombie & Fitch Co.*, 537 F.2d at 9.

52. *Union Nat’l Bank of Tex., Laredo, Tex. v. Union Nat’l Bank of Tex., Austin, Tex.*, 909 F.2d 839, 846 (5th Cir. 1990) (“Although meant as pigeon-holes, these useful labels are instead central tones in a spectrum; they tend to merge at their edges and are frequently difficult to apply.”).

53. Classification of a mark is important because only distinctive marks are entitled to trademark protection, and the “strength” of the mark is one of several relevant factors in the likelihood of confusion analysis for a trademark infringement claim. See *infra* Section II.C.1. “The strength of a mark is determined by (1) the distinctiveness or conceptual strength of the mark and (2) its commercial strength or marketplace recognition.” *Checkpoint Sys., Inc. v. Check Point Software Techs., Inc.*, 269 F.3d 270, 282 (3d Cir. 2001). It is important to remember that trademark classifications are completely dependent upon the relationship between the mark and the product. For example, “the word “apple” would be arbitrary when used on personal computers, suggestive when used in “Apple-A-Day” on vitamin tablets, descriptive when used in “Tomapple” for combination tomato-apple juice and generic when used on apples.” *Bristol-Meyers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1041 (2d Cir. 1992) (quoting 1 MCCARTHY, *supra* note 24, § 11:22); see also *Abercrombie & Fitch Stores*, 280 F.3d at 636 (“Context is important in distinguishing among categories . . . .”); *Abercrombie & Fitch Co.*, 537 F.2d at 9 & n.6 (noting that “a term that is in one category for a particular product may be in quite a different one for another”; for example, “Ivory” is generic when used in connection with the sale of elephant tusks, but is arbitrary for soap).

54. *Two Pesos*, 505 U.S. at 768, quoted in *Wal-Mart*, 529 U.S. at 210.

55. *Wal-Mart*, 529 U.S. at 212-13 (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163 (1995)).

Fanciful marks are coined, or made-up, words “invented solely to function as a trademark.”<sup>56</sup> Examples of fanciful marks include “Kodak” film<sup>57</sup> and “Clorox” bleach.<sup>58</sup> Arbitrary marks consist of common words in our language that have nothing to do with the goods sold under the mark.<sup>59</sup> Examples of arbitrary marks include “Camel” cigarettes<sup>60</sup> and “Black and White” scotch whisky.<sup>61</sup> Suggestive marks suggest something about the product, such as its qualities or characteristics, but require the consumer to exercise some imagination, thought, or perception to determine the type of product sold under that mark.<sup>62</sup> Examples of suggestive marks include “Tide” laundry

---

56. *Official Airline Guides, Inc. v. Goss*, 6 F.3d 1385, 1390 (9th Cir. 1993); *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1141 n.2 (9th Cir. 2002); *Brookfield Communications, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1058 n.19 (9th Cir. 1999) (stating that fanciful marks “are wholly made-up terms”).

57. *Wal-Mart*, 529 U.S. at 210 (using “Kodak” as an example of a fanciful mark for film).

58. *Clorox Chem. Co. v. Chlorit Mfg. Corp.*, 25 F. Supp. 702, 705 (E.D.N.Y. 1938), *cited in Brookfield*, 174 F.3d at 1058 n.19.

59. *Checkpoint Sys., Inc. v. Check Point Software Techs., Inc.*, 269 F.3d 270, 282 (3d Cir. 2001); *Brookfield*, 174 F.3d at 1058 n.19 (noting that arbitrary marks “consist[] of words commonly used in the English language”); *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 292 n.18 (3d Cir. 1991) (“Arbitrary marks are ‘those words, symbols, pictures, etc., which are in common linguistic use but which, when used with the goods or services in issue, neither suggest nor describe any ingredient, quality or characteristic of those goods or services.’” (quoting *1 MCCARTHY*, *supra* note 24, at § 11:3)); *see also Entrepreneur Media*, 279 F.3d at 1141 n.2 (“An arbitrary mark is a common word that is ‘non-descriptive of any quality of the goods or services.’” (quoting *Official Airlines Guides*, 6 F.3d at 1390)).

60. *Wal-Mart*, 529 U.S. at 210 (using “Camel” as an example of an arbitrary mark for cigarettes).

61. *Fleischmann Distilling Corp. v. Maier Brewing Co.*, 314 F.2d 149, 154 (9th Cir. 1963), *cited in Brookfield*, 174 F.3d at 1058 n.19.

62. *Hunt Masters, Inc. v. Landry’s Seafood Rest., Inc.*, 240 F.3d 251, 254 (4th Cir. 2001) (“A suggestive mark suggests a characteristic of a product, permitting a consumer to infer something about the product from the mark.”); *Checkpoint Sys.*, 269 F.3d at 282 (“Suggestive marks are virtually indistinguishable from arbitrary marks, but have been defined as marks which suggest a quality or ingredient of goods . . . .” (quoting *Ford Motor Co.*, 930 F.2d at 292 n.18)); *A & H Sportswear, Inc. v. Victoria’s Secret Stores, Inc.*, 237 F.3d 198, 221-22 (3d Cir. 2000) (“Suggestive marks require consumer ‘imagination, thought or perception’ to determine what the product is.” (quoting *A.J. Cranfield Co. v. Honickman*, 808 F.2d 291, 297 (3d Cir. 1986))); *Brookfield*, 174 F.3d at 1058 n.19 (“A suggestive mark conveys an impression of a good but requires the exercise of some imagination and perception to reach a conclusion as to the product’s nature.”).

detergent,<sup>63</sup> “Roach Motel” insect trap,<sup>64</sup> “Citibank” banking services,<sup>65</sup> “Contact” self-adhesive shelf paper,<sup>66</sup> and “Playboy” magazine.<sup>67</sup> Although all three of these inherently distinctive marks are eligible for registration and protection under the trademark laws, fanciful and arbitrary marks are more distinctive than suggestive marks—they are the strongest types of marks—because there is no relationship or connection between a fanciful or arbitrary term and the actual qualities or characteristics of the product sold under the mark.<sup>68</sup>

## 2. Descriptive Marks

Unlike inherently distinctive marks, descriptive marks directly and immediately convey something about the product sold under the mark to the relevant purchasing public, such as the qualities, characteristics, or ingredients of the product;<sup>69</sup> the subject matter,<sup>70</sup> purpose, function, use, size, merit,

63. *Wal-Mart*, 529 U.S. at 212 (using “Tide” as an example of a suggestive mark for laundry detergent); *Bliss Salon Day Spa v. Bliss World LLC*, 268 F.3d 494, 497 (7th Cir. 2001) (“‘Tide’ detergent is linguistically suggestive (it suggests the cleansing action of water), but this mark is and remains *legally* suggestive only because it has retained distinctiveness as a product identifier.”).

64. *Am. Home Prods. Corp. v. Johnson Chem. Co.*, 589 F.2d 103, 106 (2d Cir. 1978).

65. *Citibank, N.A. v. Citibanc Group, Inc.*, 724 F.2d 1540, 1545 (11th Cir. 1984).

66. *Stix Prods., Inc. v. United Merchs. & Mfrs., Inc.*, 295 F. Supp. 479, 488-491 (S.D.N.Y. 1968).

67. *Playboy Enters., Inc. v. Chuckleberry Publ’g, Inc.*, 486 F. Supp. 414, 420 (S.D.N.Y. 1981).

68. *Hunt Masters, Inc. v. Landry’s Seafood Rest., Inc.*, 240 F.3d 251, 254 (4th Cir. 2001) (“Both arbitrary and fanciful marks are totally unrelated to the product.”); *A & H Sportswear, Inc. v. Victoria’s Secret Stores, Inc.*, 237 F.3d 198, 221 (3d Cir. 2000) (“Arbitrary or fanciful marks use terms that neither describe nor suggest anything about the product; they ‘bear no logical or suggestive relation to the actual characteristics of the goods.’” (quoting *A.J. Cranfield Co. v. Honickman*, 808 F.2d 291, 296 (3d Cir. 1986))); *Brookfield Communications, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1058 n.19 (9th Cir. 1999) (“Arbitrary and fanciful marks have no intrinsic connection to the product with which the mark is used . . .”).

69. *Park ’N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985) (“A ‘merely descriptive’ mark . . . describes the qualities or characteristics of a good or service . . .” (quoting 15 U.S.C. § 1052(e)(1))); *In re Nett Designs, Inc.*, 236 F.3d 1339, 1341 (Fed. Cir. 2001) (“A mark is merely descriptive if it immediately conveys qualities or characteristics of the goods.”); *A & H Sportswear*, 237 F.3d at 222 (“Descriptive terms ‘forthwith convey[] an immediate idea of the ingredients, qualities or characteristics of the goods.’” (quoting *A.J. Canfield*, 808 F.2d at 297)); *Brookfield*, 174 F.3d at 1058 n.19 (“Descriptive terms directly describe the quality of the features or product.”); *Gruner + Jahr USA Publ’g v. Meredith Corp.*, 991 F.2d 1072, 1076 (2d Cir. 1993) (noting that a descriptive “mark is one that tells something about a product, its qualities, ingredients or characteristics”); *Transgo, Inc. v. Ajac Transmission Parts Corp.*, 768 F.2d 1001, 1014 (9th Cir. 1985) (“A descriptive term identifies a characteristic or ingredient of an article or service.”); *Abercrombie & Fitch Co. v. Hunting*

quantity, capacity, or class of intended purchasers of the product; or the end effect of the product upon the user.<sup>71</sup> Descriptive marks require no exercise of imagination to be understood by consumers.<sup>72</sup> Examples of descriptive marks include “Park ’N Fly” long-term parking lot services near airports,<sup>73</sup> “Therma-Scan” diagnostic thermal imaging examinations,<sup>74</sup> “Entrepreneur” magazine, computer programs, and manuals for entrepreneurs,<sup>75</sup> “Bliss” hair salon,<sup>76</sup> “The Sporting News” weekly sports publication,<sup>77</sup> “Washington Speakers Bureau” lecture-booking agency,<sup>78</sup> “Self-realization” books and yoga

World, Inc., 537 F.2d 4, 11 (2d Cir. 1976) (“A term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods.” (quoting *Stix Prods.*, 295 F. Supp. at 488)).

70. *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1142 (9th Cir. 2002) (holding that the word “Entrepreneur” in the plaintiff’s magazine title is a descriptive mark because it “describes both the subject matter and the intended audience of the magazine and programs so that an entirely unimaginative, literal-minded person would understand the significance of the reference”); *see id.* at 1142-43 n.4 (noting that other descriptive magazine titles include “Science,” “Alaska,” “Sport,” “Time,” “Travel,” “Parent,” “College Humor,” and “Photoplay”).

71. *Gruner + Jahr*, 991 F.2d at 1076 (stating that a descriptive mark “may point to a product’s intended purpose, its function or intended use, its size, or its merit”); *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 292 n.18 (3rd Cir. 1991) (“A mark is considered descriptive if it describes the intended purpose, function, or use of the goods; of the size of the goods, of the class of users of the goods, or of the end effect upon the user.” (quoting 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:3-5, 20 (4th ed. 2000))), *quoted in* *Checkpoint Sys., Inc. v. Check Point Software Techs., Inc.*, 269 F.3d 270, 282 (3d Cir. 2001); *Papercutter, Inc. v. Fay’s Drug Co.*, 900 F.2d 558, 563 (2d Cir. 1990) (“Examples of descriptive terms are terms conveying the characteristics of the goods, services, or business, or indicating the purpose, functions, size, quantity, capacity, or merits of a product, the effects of its use, or the class of intended purchasers.”); *see, e.g.*, *Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, 59 F.3d 902, 910-11 (9th Cir. 1995) (holding that “self-realization” is a descriptive mark for the plaintiff’s products and services because “products like ‘Self-realization books’ and services like ‘Self-realization Yoga classes’ are products and services with the purpose of helping the purchaser achieve the state of Self-realization”).

72. *Entrepreneur Media*, 279 F.3d at 1141-42 (“Descriptive marks define qualities or characteristics of a product in a straightforward way that requires no exercise of the imagination to be understood.” (quoting *Kendall-Jackson Winery, Ltd. v. E. & J. Gallo Winery*, 150 F.3d 1042, 1047 n.8 (9th Cir. 1998))).

73. *Park ’N Fly*, 469 U.S. at 191 (noting that the trademark “Park ’N Fly” was registered on the principal register in 1971); *id.* at 206 (Stevens, J., dissenting) (stating that “[t]he mark ‘Park ’N Fly’ is at best merely descriptive in the context of airport parking”).

74. *Therma-Scan, Inc. v. Thermoscan, Inc.*, 295 F.3d 623, 632 (6th Cir. 2002).

75. *Entrepreneur Media*, 279 F.3d at 1142.

76. *Bliss Salon Day Spa v. Bliss World LLC*, 268 F.3d 494, 497 (7th Cir. 2001) (holding that “Bliss” was descriptive rather than suggestive for a hair salon).

77. *Times Mirror Magazines, Inc. v. Las Vegas Sports News, L.L.C.*, 212 F.3d 157, 165 (3d Cir. 2000), *cert. denied*, 531 U.S. 1071 (2001).

78. *Wash. Speakers Bureau, Inc. v. Leading Auths., Inc.*, 35 F. Supp. 2d 488, 495 (E.D.

classes,<sup>79</sup> “Shift Kit” valve body kits,<sup>80</sup> “Security Center” business with private storage units,<sup>81</sup> “Fish-Fri” batter mix,<sup>82</sup> “Gasbadge” badge which detects gaseous pollutants,<sup>83</sup> “Rich ’N Chips” chocolate chip cookies,<sup>84</sup> “Trim” fingernail clippers,<sup>85</sup> and “U-Build-It” model airplanes.<sup>86</sup>

Laudatory terms that describe the alleged merit of the product, such as “The Ultimate Bike Rack,”<sup>87</sup> “The Best Beer in America,”<sup>88</sup> and “Platinum” mortgage services,<sup>89</sup> are also descriptive marks “because they simply describe the characteristics or quality of the goods in a condensed form.”<sup>90</sup> In addition, descriptive marks can describe the geographic origin of the product, such as “Georgia” peaches,<sup>91</sup> or an ethnic community related to the product, such as “Japan” Telecom.<sup>92</sup>

Although trade dress and marks consisting of product designs, colors, and personal names do not describe the attributes of a product, they are analogized to descriptive words and given protection under the Lanham Act upon a showing of secondary meaning.<sup>93</sup> As used in this Article, the phrase

Va. 1999), *aff'd*, 217 F.3d 843 (4th Cir. 2000).

79. Self-Realization Fellowship Church v. Ananda Church of Self-Realization, 59 F.3d 902, 910 (9th Cir. 1995).

80. Transgo, Inc. v. Ajac Transmission Parts Corp., 768 F.2d 1001, 1015 (9th Cir. 1985).

81. Sec. Ctr., Ltd. v. First Nat’l Sec. Ctrs., 750 F.2d 1295, 1300 (5th Cir. 1985).

82. Zatarains, Inc. v. Oak Grove Smokehouse, Inc., 698 F.2d 786, 792-93 (5th Cir. 1983).

83. *In re* Abcor Dev. Corp., 588 F.2d 811, 814-15 (C.C.P.A. 1978).

84. *In re* Keebler Co., 479 F.2d 1405, 1406-07 (C.C.P.A. 1973).

85. W. E. Bassett Co. v. Revlon, Inc., 354 F.2d 868, 871 (2d Cir. 1966).

86. Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 171 (1995) (using “U-Build-It” as an example of a descriptive mark for model airplanes).

87. *In re* Nett Designs, Inc., 236 F.3d 1339, 1342 (Fed. Cir. 2001) (finding that the “Ultimate Bike Rack” is “a laudatory descriptive phrase that touts the superiority of Nett Designs’ bike racks”).

88. *In re* Boston Beer Co., 198 F.3d 1370, 1373-74 (Fed. Cir. 1999) (holding that “The Best Beer in America” mark was “highly laudatory and descriptive of the qualities of [the applicant’s] product”).

89. Platinum Home Mortgage Corp. v. Platinum Fin. Group, Inc., 149 F.3d 722, 728 (7th Cir. 1998) (holding that “Platinum” was a descriptive, self-laudatory term for mortgage services, not a suggestive mark, because “it describes the quality of plaintiff’s mortgage services and suggests that it provides a superior service”).

90. *Nett Designs*, 236 F.3d at 1341.

91. Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205, 213 (2000) (using “Georgia” peaches as an example of a geographically descriptive mark).

92. Japan Telecom, Inc. v. Japan Telecom Am. Inc., 287 F.3d 866, 871-72 (9th Cir. 2002) (noting that, on motion for summary judgment, the trial court erred by ignoring evidence that the plaintiff’s “Japan Telecom” mark could be understood by consumers “as referring to a specific ethnic community” within California, rather than as a “geographically deceptive[] misdescripti[on]”).

93. See *Wal-Mart*, 529 U.S. at 209-16 (analogizing product design to color marks and extending protection only upon a showing of secondary meaning); *Qualitex Co. v. Jacobson*

“descriptive marks” means only those descriptive terms or symbols that describe the attributes or geographic origin of a product; it does not mean all trade dress or marks that require proof of acquired distinctiveness. This Article does not address whether the government should protect trademark rights in product designs, colors, or personal names.

The government has not always protected descriptive marks under trademark law, but today companies can obtain the exclusive right to use a descriptive mark if they can establish that mark has acquired distinctiveness or secondary meaning.

#### a. Evolution of Trademark Protection for Descriptive Terms

Under the common law of trademarks, descriptive terms could not become valid trademarks.<sup>94</sup> Descriptive terms were not protected as marks because

the function of a trade-mark is to point distinctively, either by its own meaning or by association, to the origin or ownership of the wares to which it is applied, and words merely descriptive of qualities, ingredients or characteristics, when used alone, do not do this. Other like goods, equal to them in all respects, may be manufactured or dealt in by others, who, with equal truth, may use, and must be left free to use, the same language of description in placing their goods before the public.<sup>95</sup>

Although Congress did not consider descriptive terms worthy of trademark protection when it enacted the first federal trademark statute in 1870,<sup>96</sup> it has

---

Prods. Co., 514 U.S. 159, 163 (1995) (stating that a product’s color may “come to identify and distinguish the good[] . . . much in the way that descriptive words” do); *Japan Telecom*, 287 F.3d at 872 (noting that descriptive marks can describe a person) (citing *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 306 (9th Cir. 1992)).

94. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (“At common law neither those terms which were generic nor those which were merely descriptive could become valid trademarks.”), *quoted in* *TCPIP Holding Co., v. Haar Communications Inc.*, 244 F.3d 88, 94 (2d Cir. 2001); *William R. Warner & Co. v. Eli Lilly & Co.*, 265 U.S. 526, 528 (1924); *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 543 (1920); *Canal Co. v. Clark*, 80 U.S. (13 Wall.) 311, 323 (1872).

95. *Estate of P.D. Beckwith*, 252 U.S. at 543-44.

96. See Act of July 8, 1870, ch. 230, §§ 77-84, 16 Stat. 198, 210-12 (declared unconstitutional for exceeding Congress’s authority under the commerce clause in *Trade-Mark Cases*, 100 U.S. 82, 96-99 (1879)). The 1870 Act allowed registration of lawful trade-marks but provided that: “The commissioner of patents shall not receive and record any proposed trade-mark which is not and cannot become a lawful trade-mark, or which is merely the name of a person, firm, or corporation only, unaccompanied by a mark sufficient to distinguish it from the same name when used by other persons . . .” *Id.* § 79, 16 Stat. at 211. The 1870 Act was found unconstitutional by the Supreme Court in 1879 because Congress purported to regulate both intrastate and interstate use of trademarks in the Act. *Trade-Mark Cases*, 100 U.S. 82, 96-99 (1879); see also 5 MCCARTHY, *supra* note 24, § 5.3 n.2 (noting that *Trade-Mark Cases*

increasingly protected such marks in revisions to the federal trademark laws. In the Act of 1905, Congress generally prohibited federal registration for any mark

which consists merely in the name of an individual, firm, corporation, or association, not written, printed, impressed, or woven in some particular or distinctive manner or in association with a portrait of the individual, or *merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term . . .*<sup>97</sup>

But Congress allowed applicants to register descriptive marks if they could prove exclusive use of the mark in interstate commerce for at least ten years prior to “passage of [the 1905] Act.”<sup>98</sup>

Fifteen years later, Congress allowed descriptive marks to be placed on a separate register created by section 1(b) of the Act of 1920 to make it easier for American citizens to register their descriptive marks in foreign countries.<sup>99</sup> “Although registration under the Act of 1920 gave the registrant no substantive rights, it did entitle him to proceed in the federal courts to protect whatever common-law rights he might have in the mark.”<sup>100</sup> For example, in

---

involved criminal prosecutions for violations of an 1876 Act “prohibiting the fraudulent use, sale, and counterfeiting of trademarks registered under the Act of 1870”).

97. Act of Feb. 20, 1905, ch. 592, § 5(b), 33 Stat. 724, 726 (repealed 1946) (emphasis added).

98. *Id.*; see also *Developments in the Law Trade-Marks and Unfair Competition*, 68 HARV. L. REV. 814, 825-26 (1955) [hereinafter *Developments*] (“The Act of 1905 denied registration to marks ‘descriptive of the goods . . . or of the character or quality of such goods.’ . . . However, registration of these [descriptive marks] was allowed upon a showing of exclusive use throughout the ten years prior to 1905.” (quoting Act of Feb. 20, 1905, ch. 592, § 5(b), 33 Stat. at 726); *Abercrombie & Fitch Co.*, 537 F.2d at 9 (citing *Standard Paint Co. v. Trinidad Asphalt Mfg. Co.*, 220 U.S. 446 (1911)); 5 MCCARTHY, *supra* note 24, § 5:3 (explaining that descriptive marks, geographical terms, and personal names could not be registered under the 1905 Act unless they fell under the “10-year clause,” which allowed registration of marks “that had been in actual and exclusive use for ten years preceding February 20, 1905”).

99. Act of Mar. 19, 1920, ch. 104, § 1(b), 41 Stat. 533, 533-34 (repealed 1946); *Clairol Inc. v. Gillette Co.*, 389 F.2d 264, 267 (2d Cir. 1968) (“The Act of 1920 was for the purpose of enabling persons in this country to register trademarks so that they might obtain registration under the laws of foreign countries.” (citing *Kellogg Co. v. Nat’l Biscuit Co.*, 71 F.2d 662, 666 (2d Cir. 1934))). According to Professor McCarthy, the Act of 1920 was a “major amendment” to the 1905 Act which was designed “to correct the problem of American citizens registering marks in foreign countries.” 5 MCCARTHY, *supra* note 24, § 5:3. However, “the 1920 Act went further, to allow registration of nontechnical marks, e.g., descriptive marks,” among other things. *Id.* § 5:3 n.16. The current supplemental register, codified at § 1091 of the Lanham Act, is “a continuation of the register provided for in section 1(b) of the Trademark Act of March 19, 1920.” *Clairol*, 389 F.2d at 267; see *infra* notes 116-20 and accompanying text.

100. *Clairol*, 389 F.2d at 267.

*Armstrong Paint & Varnish Works v. Nu-Enamel Corp.*,<sup>101</sup> the Supreme Court held that descriptive terms with “secondary meaning” were entitled to protection in federal court under the common law of unfair competition.<sup>102</sup>

In 1938, Congressman Lanham introduced the first version of the current federal trademark statute.<sup>103</sup> The proposed statute, which later became known as the Lanham Act, included new provisions granting substantive rights in descriptive marks that had “become distinctive” and allowed such marks to become incontestable, or immune from legal challenge on distinctiveness grounds.<sup>104</sup> Despite opposition to these provisions, including a proposed amendment to the Act that would have denied registration for all descriptive marks, Congress retained these provisions in the final version of the Lanham Act enacted in 1946.<sup>105</sup> Thus, under current federal trademark law, merely descriptive marks that have “become distinctive” can be registered on the

---

101. 305 U.S. 315 (1938).

102. *Id.* at 335-36 (holding that the descriptive term “Nu-Enamel” has acquired secondary meaning and “[t]his establishes . . . the common law right of the Nu-Enamel Corporation to be free from the competitive use of these words as a trade-mark or trade name . . .”); *see also Abercrombie & Fitch Co.*, 537 F.2d 4, 9 n.10 (2d Cir. 1976) (“Some protection to descriptive marks which had acquired secondary meaning [and were registered under the 1920 Act] was given by the law of unfair competition.”). According to the Supreme Court, “[t]he essence of the wrong from the violation of this right [to be free from unfair competition] is the sale of the goods of one manufacturer for those of another.” *Armstrong*, 305 U.S. at 336.

103. 1 MCCARTHY, *supra* note 24, § 5:4 (noting that the Lanham Act was introduced in its original form in 1938, enacted into law in 1946, and took effect on July 5, 1947).

104. *See* H.R. 9041, 75th Cong. § 14 (3d Sess. 1938).

105. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 197 (1985) (“The Conference Committee rejected an amendment that would have denied registration to any descriptive mark, and instead retained the provisions allowing registration of a merely descriptive mark that has acquired secondary meaning.” (citing H.R. CONF. REP. NO. 79-2322, at 4 (2d Sess. 1946) (explanatory statement of House managers))); *see id.* at 200 (discussing opposition to the incontestability provisions by the U.S. Department of Justice). *See generally* H.R. 1654, 79th Cong. (2d Sess. 1946), *reprinted in* 1946 U.S.C.C.A.N. 412 (original version of the Lanham Act enacted into law in 1946).

federal principal register,<sup>106</sup> and, once registered, can become incontestable with proof of “continuous use [of the mark] for five consecutive years.”<sup>107</sup>

Today, when submitting an application for registration of a descriptive mark on the federal principal register, the applicant can obtain a presumption of distinctiveness by submitting proof that its use of the mark on goods in commerce was “substantially exclusive and continuous” for the past five years.<sup>108</sup> Once a mark is registered on the federal principal register, registration is “prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark” on or with those particular goods.<sup>109</sup> A defendant in a trademark action can challenge these presumptions with evidence that the registrant’s mark lacks distinctiveness,<sup>110</sup>

---

106. 15 U.S.C. § 1052(e)(1), (f) (2000). Section 1052(e)(1) provides:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

....

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive . . . of them . . . .

Section 1052(f), however, states in pertinent part: “Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce.” 15 U.S.C. § 1052(f). Thus, § 1052(f) provides that the PTO can register merely descriptive marks on the principal register if they become distinctive because these marks are included in § 1052(e)(1). *See Park ‘N Fly*, 469 U.S. at 194. This same rule also applies to primarily geographically descriptive marks that have become distinctive. 15 U.S.C. § 1052(e)(2), (f).

107. 15 U.S.C. § 1065.

108. 15 U.S.C. § 1052(f) (“The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant’s goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.”).

109. 15 U.S.C. § 1115(a); *see also* *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 209 (2000); *Brookfield Communications, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1047 (9th Cir. 1999) (“[R]egistration of the mark on the Principal Register . . . constitutes prima facie evidence of the validity of the registered mark and of [the registrant’s] exclusive right to use the mark on the goods and services specified in the registration.”); *Gruner + Jahr USA Publ’g v. Meredith Corp.*, 991 F.2d 1072, 1076 (2d Cir. 1993) (“The Lanham Act . . . provides that a [registered] mark . . . shall be *prima facie* evidence of the registrant’s exclusive right to use the mark in commerce on the product, without precluding an opposing party from proving any defense that might have been asserted had the mark not been registered.”).

110. *See Gruner + Jahr*, 991 F.2d at 1076 (citing 15 U.S.C. § 1115(a)).

among other things,<sup>111</sup> unless the registrant's rights in the mark have become incontestable.<sup>112</sup>

A registrant of a descriptive mark may notify others that its "mark is registered by displaying with the mark the words 'Registered in U.S. Patent and Trademark Office' or 'Reg. U.S. Pat. & Tm. Off.' or the letter R enclosed within a circle, thus ®."<sup>113</sup> If a registrant fails "to give such notice of registration," it cannot recover profits or damages in a suit for infringement of the mark under the Lanham Act "unless the defendant had actual notice of the registration."<sup>114</sup> These Lanham Act provisions allowing registration of descriptive terms on the principal register and permitting rights in descriptive marks to become incontestable "significantly changed and liberalized the common law" of trademarks.<sup>115</sup>

If the PTO determines that a descriptive mark has not yet become sufficiently distinctive to justify registration on the principal register, but is nevertheless "capable" of becoming distinctive, the mark can be registered on the supplemental register.<sup>116</sup> While descriptive marks on the supplemental register do not receive the same substantive protections as marks on the principal register,<sup>117</sup> registration on the supplemental register does have benefits. The holder of a descriptive mark registered on the supplemental register has the right to use the trademark registration symbol (®) to notify

111. See 15 U.S.C. § 1115(a) (stating that registration "shall not preclude another person from proving any legal or equitable defense or defect, including those set forth in subsection (b) of this section, which might have been asserted if such mark had not been registered"); see, e.g., *Brookfield*, 174 F.3d at 1047 (noting that defendants can rebut the statutory presumption of validity by proving they are the "senior" user of the mark in commerce with those goods).

112. 15 U.S.C. § 1065; *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 196 (1985) (holding that the defendant could not challenge the distinctiveness, and thus the validity, of the plaintiff's descriptive mark because the plaintiff's rights in the mark were incontestable); *Gruner + Jahr*, 991 F.2d at 1076-77 (stating "that a defendant in an infringement suit—where plaintiff has an incontestable mark because of five years' registration—may not succeed in a defense that declares the mark is entitled to no protection because it is descriptive").

113. 15 U.S.C. § 1111.

114. *Id.*

115. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 171 (1995).

116. 15 U.S.C. § 1091(a). Section 1091(a) provides:

All marks capable of distinguishing applicant's goods or services and not registrable on the principal register provided in this chapter, except those declared to be unregistrable under subsections (a), (b), (c), (d), and (e)(3) of section 1052 of this title, which are in lawful use in commerce by the owner thereof, on or in connection with any goods or services may be registered on the supplemental register . . . .

*Id.* Therefore, the PTO may register a "merely" descriptive mark on the supplemental register upon receiving proof that the mark is capable of becoming distinctive. See *id.* §§ 1052(e)(1), 1091.

117. See 15 U.S.C. § 1115(a) (listing benefits for marks registered on the principal register). There is no comparable provision in the Lanham Act for marks registered on the supplemental register. See 15 U.S.C. §§ 1051-1127.

others of the registration,<sup>118</sup> and thereby discourage use of the descriptive term claimed as a trademark. Registration of the mark on the supplemental register also makes it easier for the mark-holder to register the mark in foreign countries offering reciprocal trademark rights.<sup>119</sup> Finally, if the trademark registration symbol is displayed with the mark, the mark-holder can recover damages and profits in a successful trademark infringement action without having to prove actual notice of the registration.<sup>120</sup>

#### b. Secondary Meaning

“The phrase ‘secondary meaning’ originally arose in the context of [descriptive] word marks, where it served to distinguish the source-identifying meaning from the ordinary, or ‘primary,’ meaning of the word.”<sup>121</sup> Although this phrase does not appear in the Lanham Act, courts use “secondary meaning” as a synonym for the phrase “has become distinctive” in § 1052(f) of the Act.<sup>122</sup> If a business claiming exclusive trademark rights in a descriptive

118. 15 U.S.C. § 1111.

119. *Developments, supra* note 98, at 821 & n.37 (stating that the supplemental register is “oriented towards [the] protection [of descriptive marks] in foreign countries”). “Foreign countries may require federal registration [in the United States] before extending protection to the mark of a United States owner.” *Id.* at 827.

120. *See* 15 U.S.C. § 1111.

121. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 211 n.\* (2000). According to the Sixth Circuit in 1912, the theory of secondary meaning

contemplates that a word or phrase originally, and in that sense primarily, incapable of exclusive appropriation with reference to an article on the market, because geographically or otherwise descriptive, might nevertheless have been used so long and so exclusively by one producer with reference to his article that, in that trade and to that branch of the purchasing public, the word or phrase had come to mean that the article was his product; in other words, had come to be, to them, his trade-mark. So it was said that the word had come to have a secondary meaning, although this phrase, “secondary meaning,” seems not happily chosen, because, in the limited field, this new meaning is primary rather than secondary; that is to say, it is, in that field, the natural meaning.

*G. & C. Merriam Co. v. Saalfield*, 198 F. 369, 373 (6th Cir. 1912).

122. *See, e.g., Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 171 (1995) (noting that § 1052(f) extends protection to a mark that “‘has become distinctive’ . . . [and] permits an ordinary word, normally used for a nontrademark purpose (*e.g.*, description) to act as a trademark where it has gained ‘secondary meaning’”); *Park ’N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985) (“A ‘merely descriptive’ mark . . . may be registered only if the registrant shows that it has acquired secondary meaning, *i.e.*, it ‘has become distinctive of the applicant’s goods in commerce.’” (quoting 15 U.S.C. § 1052(f))); *TCPIP Holding Co. v. Haar Communications, Inc.*, 244 F.3d 88, 94 (2d Cir. 2001) (“In contrast to prior law, the Lanham Act accorded registrability to a descriptive mark if the public had come to associate the mark with the goods or services of the user—in trademark parlance, if the mark had acquired ‘secondary meaning.’”); *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1347 (Fed. Cir. 2001) (“A descriptive mark can be registered on the Principal Register only if it has acquired

term can establish that the mark has acquired secondary meaning in the minds of consumers, the trademark is valid and entitled to protection.<sup>123</sup>

Courts have declared that secondary meaning is established upon proof that the “primary significance” of the descriptive term, “in the minds of the [consuming] public, . . . is to identify the source of the product, rather than the product itself.”<sup>124</sup> Courts evaluate a variety of factors when determining whether a descriptive mark has acquired secondary meaning, including: (1) an association in the minds of consumers between the descriptive term and a single source of the product,<sup>125</sup> (2) the amount and manner of advertising under the mark,<sup>126</sup> (3) the length of use of the mark,<sup>127</sup> (4) the exclusivity of use of

secondary meaning.”); *see also In re Deister Concentrator Co.*, 289 F.2d 496, 499-500 (C.C.P.A. 1961) (discussing the relationship between secondary meaning and distinctiveness).

123. *See Japan Telecom, Inc. v. Japan Telecom Am. Inc.*, 287 F.3d 866, 872 (9th Cir. 2002) (“[A] descriptive term can become protectable ‘provided that it has acquired ‘secondary meaning’ in the minds of consumers, i.e., it has become distinctive of the trademark applicant’s goods in commerce.” (quoting *Filipino Yellow Pages, Inc. v. Asian Journal Publ’ns, Inc.*, 198 F.3d 1143, 1147 (9th Cir. 1999))); *Hunt Masters, Inc. v. Landry’s Seafood Rest., Inc.*, 240 F.3d 251, 254 (4th Cir. 2001) (“A descriptive mark . . . can be protected if it has acquired a secondary meaning.”); *Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, 59 F.3d 902, 910 (9th Cir. 1995) (“A trademark that is descriptive and lacks secondary meaning is invalid.”). “[R]ights in descriptive marks should only be granted to those users [of a descriptive term] who have, through advertising and sales, acquired distinctiveness through consumer recognition in that term in a secondary sense—‘secondary meaning.’” 1 MCCARTHY, *supra* note 24, § 11:18.

124. *E.g.*, *Inwood Labs., Inc. v. Ives Labs., Inc.* 456 U.S. 844, 851 n.11 (1982), *quoted in Wal-Mart*, 529 U.S. at 211; *Dial-A-Mattress*, 240 F.3d at 1347; *cf. Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 118 (1938) (stating that to establish a valid trademark the mark-holder “must show that the primary significance of the term in the minds of the consuming public is not the product but the producer”).

125. *See, e.g., Japan Telecom*, 287 F.3d at 873 (stating that one factor used in evaluating evidence of secondary meaning is “whether actual purchasers of the product bearing the claimed trademark associate the trademark with the producer”); *Checkpoint Sys., Inc. v. Check Point Software Techs., Inc.*, 269 F.3d 270, 283 n.10 (3d Cir. 2001). According to the Seventh Circuit,

Secondary meaning is “a *mental association* in buyers’ minds between the alleged mark and a single source of the product.” A mark acquires secondary meaning when it has been used so long and so exclusively by one company in association with its goods or services that the word or phrase has come to mean that those goods or services are the company’s trademark.

*Packman v. Chi. Tribune Co.*, 267 F.3d 628, 641 (7th Cir. 2001) (quoting 2 MCCARTHY, *supra* note 24, § 15:5).

126. *E.g.*, *U.S. Search, LLC v. U.S. Search.com Inc.*, 300 F.3d 517, 525 (4th Cir. 2002); *Japan Telecom*, 287 F.3d at 873; *Packman*, 267 F.3d at 641; *Times Mirror Magazines, Inc. v. Las Vegas Sports News, L.L.C.*, 212 F.3d 157, 165 (3d Cir. 2000), *cert. denied*, 531 U.S. 1071 (2001); *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 292 (3d Cir. 1991); *Am. Scientific Chem., Inc. v. Am. Hosp. Supply Corp.*, 690 F.2d 791, 793 (9th Cir. 1982).

127. *E.g.*, *U.S. Search*, 300 F.3d at 525; *Japan Telecom*, 287 F.3d at 873; *Packman*, 267

the mark,<sup>128</sup> (5) sales of the product under the mark,<sup>129</sup> (6) the size or prominence of the business,<sup>130</sup> (7) whether the mark-holder has an established place in the market,<sup>131</sup> (8) its number of customers,<sup>132</sup> (9) deliberate copying or attempts to plagiarize the mark by others,<sup>133</sup> (10) actual consumer confusion caused by unauthorized use of the mark,<sup>134</sup> and (11) use of the mark in the media and trade journals.<sup>135</sup> This list is non-exclusive,<sup>136</sup> and no single secondary meaning factor is determinative.<sup>137</sup>

For example, courts have held that the following descriptive marks have acquired secondary meaning: “The Sporting News,”<sup>138</sup> “Washington Speakers Bureau,”<sup>139</sup> “Shift Kit,”<sup>140</sup> “Fish-Fri,”<sup>141</sup> and “Postal Service.”<sup>142</sup> On the other

F.3d at 641; *Times Mirror*, 212 F.3d at 165; *Ford Motor Co.*, 930 F.2d at 292; *Am. Scientific*, 690 F.2d at 793.

128. *E.g.*, *U.S. Search*, 300 F.3d at 525; *Japan Telecom*, 287 F.3d at 873; *Times Mirror*, 212 F.3d at 165; *Ford Motor Co.*, 930 F.2d at 292. If the term “is an oft-used one with no special characteristics or distinctiveness of its own[,] . . . such third-party usage is relevant to disprove the existence of trade-mark rights in the plaintiff.” *Carter-Wallace, Inc. v. Procter & Gamble Co.*, 434 F.2d 794, 802-03 (9th Cir. 1970); *see, e.g.*, *In re Boston Beer Co.*, 198 F.3d 1370, 1373-74 (Fed. Cir. 1999) (holding the PTO correctly refused to register the slogan “The Best Beer in America” because the mark lacked secondary meaning and could no longer indicate origin after other companies had used the mark as a descriptive and laudatory phrase).

129. *E.g.*, *U.S. Search*, 300 F.3d at 525; *Packman*, 267 F.3d at 641; *Int’l Jensen, Inc. v. Metrosound U.S.A., Inc.*, 4 F.3d 819, 824 (9th Cir. 1993); *Ford Motor Co.*, 930 F.2d at 292; *Am. Scientific*, 690 F.2d at 793.

130. *E.g.*, *Times Mirror*, 212 F.3d at 165; *Ford Motor Co.*, 930 F.2d at 292; *Am. Scientific*, 690 F.2d at 793.

131. *E.g.*, *Packman*, 267 F.3d at 641; *Times Mirror*, 212 F.3d at 165.

132. *E.g.*, *Ford Motor Co.*, 930 F.2d at 292; *Am. Scientific*, 690 F.2d at 793.

133. *E.g.*, *U.S. Search*, 300 F.3d at 525; *Packman*, 267 F.3d at 641; *Times Mirror*, 212 F.3d at 165; *Ford Motor Co.*, 930 F.2d at 292; *Vision Sports, Inc. v. Melville Corp.*, 888 F.2d 609, 615 (9th Cir. 1989); *Transgo, Inc. v. Ajac Transmission Parts Corp.*, 768 F.2d 1001, 1016 (9th Cir. 1985).

134. *E.g.*, *Adray v. Adry-Mart, Inc.*, 76 F.3d 984, 987 (9th Cir. 1995); *Ford Motor Co.*, 930 F.2d at 292; *Am. Scientific*, 690 F.2d at 793.

135. *E.g.*, *U.S. Search*, 300 F.3d at 525; *Ford Motor Co.*, 930 F.2d at 292; *Am. Scientific*, 690 F.2d at 793.

136. *Ford Motor Co.*, 930 F.2d at 292.

137. *U.S. Search*, 300 F.3d at 525.

138. *Times Mirror*, 212 F.3d at 166 (holding that the mark, “The Sporting News,” had acquired secondary meaning, and was famous and distinctive in the sports periodicals market, “because it has been used in commerce since 1886 and because [the plaintiff] has [spent] millions of dollars in advertising and promoting [its] mark through various media outlets”).

139. *Wash. Speakers Bureau, Inc. v. Leading Auths., Inc.*, 33 F. Supp. 2d 488, 496-97 (E.D. Va. 1999), *aff’d*, 217 F.3d 843 (4th Cir. 2000) (holding that the plaintiff lecture-booking agency established secondary meaning in its “Washington Speakers Bureau” mark).

140. *Transgo, Inc. v. Ajac Transmission Parts Corp.*, 768 F.2d 1001, 1016 (9th Cir. 1985) (finding that plaintiff proved “Shift Kit” for its valve body kits had secondary meaning).

141. *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 793-96 (5th Cir. 1983)

hand, courts did not find secondary meaning in the descriptive marks “Japan Telecom,”<sup>143</sup> “Self-realization,”<sup>144</sup> and “The Best Beer in America.”<sup>145</sup> If a descriptive term is found to have secondary meaning, courts assume that the term now identifies a single source of the product sold under that descriptive mark.<sup>146</sup>

### 3. Generic Terms

Unlike the other four categories of marks in the trademark continuum, generic terms—the common name for a class or genus of products<sup>147</sup>—are never capable of registration or protection under trademark law.<sup>148</sup> A term is

---

(holding that the plaintiff’s “Fish-Fri” mark for its batter mix had acquired secondary meaning in the New Orleans area).

142. *Zipee Corp. v. United States Postal Service*, 140 F. Supp. 2d 1084, 1087 (D. Or. 2000) (holding that “Postal Service” mark has acquired secondary meaning for the services of the U.S. Postal Service).

143. *Japan Telecom, Inc. v. Japan Telecom Am. Inc.*, 287 F.3d 866, 873-875 (9th Cir. 2002) (finding no secondary meaning in “Japan Telecom” for a business that sells and installs telephone and computer networking equipment and caters these services to Japanese-speaking customers).

144. *Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, 59 F.3d 902, 911-12 (9th Cir. 1995) (holding that no secondary meaning exists in “Self-realization” for books and yoga classes).

145. *In re Boston Beer Co.*, 198 F.3d 1370, 1373-74 (Fed. Cir. 1999).

146. *See, e.g., Abercrombie & Fitch Stores, Inc. v. Am. Eagle Outfitters, Inc.*, 280 F.3d 619, 636 (6th Cir. 2002) (“While not inherently distinctive, descriptive marks can identify a source and acquire distinctiveness if secondary meaning has attached to the term, such that consumers recognize [the mark] as a product of a certain manufacturer.”); *Blinded Veterans Ass’n v. Blinded Am. Veterans Found.*, 872 F.2d 1035, 1040 (D.C. Cir. 1989) (“Because descriptive terms are . . . not inherently distinctive, they acquire trademark protection only upon proof of secondary meaning—*i.e.*, upon proof that the public recognizes only one source of the product or service.”).

147. *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1141 n.2 (9th Cir. 2002) (“Generic marks give the general name of the product; they embrace an entire class of products.” (quoting *Kendall-Jackson Winery, Ltd. v. E. & J. Gallo Winery*, 150 F.3d 1042, 1047 n.8 (9th Cir. 1998))); *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1344 (Fed. Cir. 2001) (“Generic terms are common names that the relevant purchasing public understands primarily as describing the genus of goods or services being sold.”); *Self-Realization*, 59 F.3d at 909 (“A term is a generic name, not a trade name, if it ‘merely identifies the genus of which the particular [business] is a species.’” (quoting *Liquid Controls Corp. v. Liquid Control Corp.*, 802 F.2d 934, 936 (7th Cir. 1986) (alteration in original))). “One accepted way to define genus is to determine the relevant product market[, which] . . . is one in which the commodities are ‘reasonably interchangeable by consumers for the same purposes.’” *Riggs Mktg. Inc. v. Mitchell*, 993 F. Supp. 1301, 1306 n.13 (D. Nev. 1997) (citation omitted) (quoting *United States v. E.I. duPont de Nemours & Co.*, 351 U.S. 377, 395 (1956)).

148. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992); *S.F. Arts &*

generic if the public uses that term to refer generally to a product rather than exclusively to a particular brand of that product.<sup>149</sup> By definition, generic names are “incapable of indicating a particular source” or origin of a product.<sup>150</sup>

A term can be classified as generic in two different ways.<sup>151</sup> First, a term is generic if the public commonly used the term “prior to its association with the [specific] products” of a business that later asserts trademark rights in that term.<sup>152</sup> Examples of this type of generic term include: “Shredded Wheat”

---

*Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522, 531 n.7 (1987) (“Because a generic name by definition does not *distinguish* the identity of a particular product, it cannot be registered as a trademark under the Lanham Act.”); *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985) (“A generic term is one that refers to the genus of which the particular product is a species. Generic terms are not registrable, and a registered mark may be canceled at any time on the grounds that it has become generic.” (citation omitted)); *U.S. Search, LLC v. U.S. Search.com, Inc.*, 300 F.3d 517, 523 (4th Cir. 2002) (“If a term is generic (the common name for a product or service), it is ineligible for protection.”); *Abercrombie & Fitch Stores*, 280 F.3d at 636; *Am. Online, Inc. v. AT & T Corp.*, 243 F.3d 812, 820 (4th Cir. 2001) (“[W]hen words are used in a context that suggests only their common meaning, they are generic and may not be appropriated as exclusive property.”); *Hunt Masters, Inc. v. Landry’s Seafood Rest., Inc.*, 240 F.3d 251, 254 (4th Cir. 2001) (“A generic mark refers to the genus or class of which a particular product is a member, and thus can never be protected.”); *A & H Sportswear, Inc. v. Victoria’s Secret Stores, Inc.*, 237 F.3d 198, 222 (3d Cir. 2000) (“Generic marks receive no protection; indeed, they are not ‘trademarks’ at all.”).

149. *Japan Telecom, Inc. v. Japan Telecom Am. Inc.*, 287 F.3d 866, 872 (9th Cir. 2002) (“Generic terms do not ‘relate exclusively to the trademark owner’s product’ because they are common words or phrases that ‘describe a class of goods rather than an individual product.’” (quoting *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 306 (9th Cir. 1992))); *Brookfield Communications, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1058 n.19 (9th Cir. 1999) (“Generic terms are those used by the public to refer generally to the product rather than a particular brand of the product.”); see *Kendall-Jackson*, 150 F.3d at 1047 n.8 (noting that generic terms “simply state what the product is”).

150. *Dial-A-Mattress*, 240 F.3d at 1344; see *S.F. Arts & Athletics*, 483 U.S. at 531 n.7. “Because an indication of origin is the key to a non-generic mark, a general rule of thumb is that a generic mark answers the question ‘what are you,’ while a non-generic mark answers the question ‘who are you?’” *Riggs Mktg.*, 993 F. Supp. at 1306 (noting that “Aspirin,” “Cola,” “Light Beer,” and “Super Glue” are generic, but “Coke,” “Levis,” “Polaroid,” and “Trivial Pursuit” are not generic); *Official Airline Guides, Inc. v. Churchfield Publ’ns, Inc.*, 6 F.3d 1385, 1391 (9th Cir. 1993).

151. *Hunt Masters*, 240 F.3d at 255 (“[T]here are two distinct ways in which terms may be classified as generic: (1) where the term began life as a ‘coined term’; and (2) where the term was commonly used prior to its association with the products at issue.”).

152. *Id.* Symbols or designs can also be generic marks. See, e.g., *Kendall-Jackson*, 150 F.3d at 1048 (“Grape-leaf designs have become generic emblems for wine.”).

breakfast cereal,<sup>153</sup> “Crab House” restaurants that serve crab,<sup>154</sup> the “Self-Realization” spiritual organization,<sup>155</sup> the “Blinded Veterans” charitable organization,<sup>156</sup> “Light” beer or “Lite” beer,<sup>157</sup> and “Chocolate Fudge Soda.”<sup>158</sup> Second, a distinctive term can become generic through common use if the public begins to use that term to refer to a class of products rather than to a particular brand of that product.<sup>159</sup> The Fourth Circuit notes that this disappearance of distinctiveness is called “genericide.”<sup>160</sup> Examples of marks that were distinctive but are now generic include: “Thermos,” “Aspirin,” “Teflon,” “Cellophane,” and “Escalator.”<sup>161</sup> If a mark registered on the federal principal register “becomes the generic name for the goods or services, or a portion thereof, for which it is registered,” the PTO may cancel the registration of that mark.<sup>162</sup>

---

153. *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 116-17 (1938) (holding that “shredded wheat” is a generic term when used for pillow-shaped biscuits made of baked shreds of previously boiled wheat).

154. *Hunt Masters*, 240 F.3d at 254-55 (holding that “crab house,” like “ale house,” is a generic term referring to “a class of restaurant that serve crabs”).

155. *Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, 59 F.3d 902, 909 (9th Cir. 1995) (“‘Self-realization’ is generic in the context of the name of a spiritual organization if the term identifies a general class of spiritual organizations, instead of a single, unique organization.”). It is important to note that “a term may be in one category when used as a trade name but quite another for a trade mark.” *Id.* at 908. For example, “Self-realization” is generic for a spiritual organization but the term is descriptive for books and yoga classes. *Id.* at 909. The reason for this apparent conflict is that “[a] trademark represents the mark holder on ‘the vendible commodity to which it is affixed,’ while a trade name symbolizes ‘a business and its goodwill.’” *Id.* at 908 (quoting *Am. Steel Foundries v. Robertson*, 269 U.S. 372, 380 (1926)).

156. *Blinded Veterans Ass’n v. Blinded Am. Veterans Found.*, 872 F.2d 1035, 1041 (D.C. Cir. 1989) (holding that the term “Blinded Veterans” was generic for charitable organizations that promote the interests of blinded former military personnel and, therefore, was not entitled to trademark protection).

157. *Miller Brewing Co. v. G. Heileman Brewing Co., Inc.*, 561 F.2d 75, 77 (7th Cir. 1977) (reversing a preliminary injunction order that prohibited defendant from using the word “Lite” for beer, the court held that because “‘light’ is a generic or common descriptive word when applied to beer, neither that word nor its phonetic equivalent may be appropriated as a trademark for beer”).

158. *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 293 (3d Cir. 1986).

159. *Hunt Masters*, 240 F.3d at 255; see *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 & n.7 (2d Cir. 1976) (stating that “a term may shift from one category to another in light of differences in usage through time,” such as when a fanciful or arbitrary word becomes generic like “the coined word ‘Escalator’”).

160. *Am. Online, Inc. v. AT & T Corp.*, 243 F.3d 812, 821 (4th Cir. 2001).

161. *Id.* (providing examples of words that have become generic); *Hunt Masters*, 240 F.3d at 255.

162. 15 U.S.C. § 1064(3) (2000). “The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the

In sum, categorization of a mark is extremely important in trademark law. Marks that are inherently distinctive or descriptive with secondary meaning may be placed on the federal principal register and obtain all of the benefits of trademark registration, including a presumption of validity and the right to exclusive use of the mark with those particular goods. Terms that are generic or descriptive without secondary meaning are not eligible for registration as a trademark on the principal register and are available for use by anyone.

### *C. Enforcement of Federal Trademark Rights Under the Lanham Act*

Regardless of whether a trademark is registered, the Lanham Act permits the senior user of a distinctive mark to enforce exclusive rights in that mark against junior users of an identical or confusingly similar mark. Remedies under the Lanham Act include injunctive relief, damages, lost profits, costs of the action, and, in exceptional cases, attorneys' fees.<sup>163</sup>

#### 1. Federal Trademark Infringement and Unfair Competition

Under the Lanham Act, the senior user of a distinctive mark may sue for infringement by filing a claim either under the Act's trademark infringement provision—15 U.S.C. § 1114(1)(a)—if the mark is registered, or under the Act's unfair competition provision—15 U.S.C. § 1125(a)(1)(A)—if the mark is not registered. Section 1114(1)(a) provides a cause of action for federal trademark infringement against anyone who uses a mark that is identical or similar to a mark registered on the principal register, when such unauthorized “use is likely to cause confusion, or to cause mistake, or to deceive.”<sup>164</sup>

---

registered mark has become the generic name of goods or services on or in connection with which it has been used.” *Id.*

163. 15 U.S.C. §§ 1114(2), 1117.

164. 15 U.S.C. § 1114(1)(a); *see* Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205, 209 (2000) (stating that a mark-holder may sue infringers under 15 U.S.C. § 1114 once the mark is registered under 15 U.S.C. § 1052); S.F. Arts & Athletics, Inc. v. United States Olympic Comm., 483 U.S. 522, 531 (1987). Section 1114(1) of the Lanham Act provides:

Any person who shall, without the consent of the registrant—

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive shall be liable in a civil action by the registrant for the remedies hereinafter provided.

Section 1125(a)(1)(A)<sup>165</sup> authorizes claims for infringement of “qualifying unregistered trademarks” (distinctive marks) and trade dress, as well as claims for other conduct that constitutes unfair competition,<sup>166</sup> such as false advertising. Thus, unauthorized use in commerce of the unregistered yet distinctive mark first used by another is actionable under §1125(a)(1)(A) if such conduct “is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . . .”<sup>167</sup>

To prove trademark infringement under § 1114(1) or § 1125(a)(1)(A), the plaintiff must establish it owns a “valid and legally protectable mark”—a *distinctive* mark—and the defendant’s use of an identical or similar mark is likely to cause consumer confusion.<sup>168</sup> The following factors are relevant to the court’s analysis of whether a likelihood of confusion exists due to defendant’s conduct: (1) “strength of the mark,” (2) relatedness or “proximity of the goods,” (3) “similarity of the marks,” (4) “evidence of actual confusion,” (5) “marketing channels used,” (6) “the degree of care likely to be exercised by the purchaser,” (7) “defendant’s intent in selecting the mark,” and (8) “likelihood of expansion of the product lines.”<sup>169</sup> This eight-factor list for

15 U.S.C. § 1114(1)(a)-(b).

165. Section 1125(a)(1)(A) provides:

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading misrepresentation of fact, which . . . is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125(a)(1)(A).

166. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 767-68 (1992).

167. 15 U.S.C. § 1125(a)(1)(A).

168. *Checkpoint Sys., Inc. v. Check Point Software Techs., Inc.*, 269 F.3d 270, 279 (3d Cir. 2001); *see also A & H Sportswear, Inc. v. Victoria’s Secret Stores, Inc.*, 237 F.3d 198, 210 (3d Cir. 2000) (“To prove either form of Lanham Act violation, a plaintiff must demonstrate that (1) it has a valid and legally protectable mark; (2) it owns the mark; and (3) the defendant’s use of the mark to identify goods or services causes a likelihood of confusion.”); *Brookfield Communications, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1046 (9th Cir. 1999) (“To establish a trademark infringement claim under section [1114] of the Lanham Act or an unfair competition claim under section [1125(a)] of the Lanham Act, Brookfield must establish that West Coast is using a mark confusingly similar to a valid, protectable trademark of Brookfield’s.”) Under either type of action, the plaintiff bears the burden of proof. *A & H Sportswear*, 237 F.3d at 210-11.

169. *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979), *quoted in Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1150 n.7 (9th Cir. 2002); *Abercrombie & Fitch Stores, Inc. v. Am. Eagle Outfitters, Inc.*, 280 F.3d 619, 646-47 (6th Cir. 2000). The test for likelihood

evaluating likelihood of confusion is not exhaustive.<sup>170</sup>

Even if the mark-holder can prove all of the elements of an infringement claim, the Lanham Act contains several statutory defenses.<sup>171</sup> One such defense is the fair use defense, a common law defense codified in § 1115(b)(4) of the Act.<sup>172</sup> To prevail under the fair use defense, the defendant must prove that (1) its use of the trademarked term “is a use, otherwise than as a mark,” (2) the term is “used fairly and in good faith,” and (3) the use is “only to describe the goods or services of [the defendant], or their geographic origin.”<sup>173</sup> Thus, trademark law allows a defendant to use another’s trademarked term to describe its own goods, as long as the defendant uses the “words in their primary descriptive and non-trademark sense.”<sup>174</sup> The fair use

---

of confusion was originally set forth in *Polaroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492, 495 (2d Cir. 1961), and refined in subsequent cases such as *Sleekcraft*.

170. *Cairns*, 292 F.3d at 1150 n.7 (stating that the *Sleekcraft* factors are “non-exhaustive”); *Brookfield*, 174 F.3d at 1054 (noting this eight-factor “list does not purport to be exhaustive, and non-listed variables may often be quite important”).

171. See 15 U.S.C. § 1115(b); see also *S.F. Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522, 531 (1987) (noting that § 1115 “grants several statutory defenses to an alleged trademark infringer”).

172. *Cairns*, 292 F.3d at 1150-51; 2 MCCARTHY, *supra* note 24, § 11:49 (noting that § 1115(b)(4) “can be viewed as a ‘statutory restatement of the corresponding common law defense’”) (quoting *Venetianaire Corp. of Am. v. A & P Import Co.*, 429 F.2d 1079, 1081 (2d Cir. 1970)). As codified in § 1115(b)(4), the fair use defense requires defendant to prove:

[t]hat the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party’s individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin . . . .

15 U.S.C. § 1115(b)(4); *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 306 (9th Cir. 1992) (“[T]rademark law recognizes a [fair use] defense where the mark is used only ‘to describe the goods or services of [a] party . . . .’” (quoting 15 U.S.C. § 1115(b)(4))).

173. 15 U.S.C. § 1115(b)(4); see *Cairns*, 292 F.3d at 1151; 2 MCCARTHY, *supra* note 24, § 11:49.

174. *United States Shoe Corp. v. Brown Group, Inc.*, 740 F. Supp. 196, 198 (S.D.N.Y. 1990), *aff’d*, 923 F.2d 844 (2d Cir. 1990); see *Cairns*, 292 F.2d at 1150-51; *Venetianaire*, 429 F.2d at 1082 (recognizing that the fair use defense applies when the defendant uses “a common term to . . . fairly describe a characteristic of [its] goods”); 2 MCCARTHY, *supra* note 24, § 11:45 (“A junior user is always entitled to use a descriptive term in good faith in its primary, descriptive sense other than as a trademark.”); see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 28, cmt. a (1995) (“The defense of fair use under the law of trademarks is limited to use of the original descriptive or personal name significance of a term.”). Courts have applied the fair use defense where the use is descriptive and not as a mark. *E.g.*, *Cosmetically Sealed Indus., Inc. v. Chesebrough-Pond’s USA Co.*, 125 F.3d 28, 30 (2d Cir. 1997) (holding that the defendant cosmetic manufacture’s use of the phrase “Seal it with a Kiss!” was fair use of the mark “Sealed with a Kiss” when used “to describe an action that the defendants hope consumers will take, using their product”); *Car-Freshner Corp. v. S.C. Johnson*

defense can apply regardless of whether the plaintiff's mark is descriptive, suggestive, arbitrary, or fanciful, because the focus of the fair use inquiry is whether the defendant—not the plaintiff—is using the word or phrase in a descriptive manner and not as a mark.<sup>175</sup> The limitations of the fair use defense are discussed in Subsection V.A.4.d.

## 2. Federal Trademark Dilution Act

Not only does the Lanham Act protect distinctive marks from infringement and unfair competition, but it also protects famous marks from dilution caused by unauthorized commercial use of the mark. Dilution is “the lessening of the capacity of a famous mark to identify and distinguish goods or services,

---

& Son, Inc., 70 F.3d 267, 270 (2d Cir. 1995) (finding that the defendant's use of a pine-tree shaped air freshener to describe the qualities of its product was a fair use); *Sunmark, Inc. v. Ocean Spray Cranberries, Inc.*, 64 F.3d 1055, 1059-60 (7th Cir. 1995) (holding that the defendant's use of the term “sweet-tart” was to describe the taste of its cranberry juice rather than to identify its origin, and, therefore, was a fair use); *In re Dual-Deck Video Cassette Recorder Antitrust Litig.*, 11 F.3d 1460, 1467 (9th Cir. 1993) (stating that it was fair use for the defendant electronic manufacturers to use the terms “VCR 1” and “VCR 2” on their receivers, even though the plaintiff had registered the trademark “VCR-2,” because “the uses were descriptive, and there is no evidence from which an inference of bad faith could be drawn”); *M.B.H. Enters., Inc. v. WOKY, Inc.*, 633 F.2d 50, 55 (7th Cir. 1980) (holding that a radio station's use of the slogan “WOKY Loves Milwaukee” was fair use of the plaintiff's registered “I Love You” slogan because it was descriptive of the station's services and civic involvement); *Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 1187 (5th Cir. 1980) (finding fair use of the term “Larvacide” to describe larvae-killing properties of the defendant's product); *Ideal Indus., Inc. v. Gardner Bender, Inc.*, 612 F.2d 1018, 1027 (7th Cir. 1979) (holding that the use of size designations was fair use if placed adjacent to word “size”); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 12-13 (2d Cir. 1976) (holding that the defendant's use of “Safari” in “Camel Safari,” “Hippo Safari,” and “Safari Chukka” was a fair use because it was “purely descriptive” of its boots imported from Africa). The Ninth Circuit noted that a descriptive term may only be used in a metatag in the way it is routinely used in the English language. *Brookfield*, 174 F.3d at 1066. The *Brookfield* court held that ““Movie Buff” is a descriptive term routinely used in the English language” for the “motion picture enthusiast”—it is a term anyone “certainly can use.” *Id.* However, the court stated that ““MovieBuff” is not such a descriptive term. Even though it differs from ‘Movie Buff’ by a single space, that difference is pivotal.” *Id.*

175. *Car-Freshner Corp.*, 70 F.3d at 269 (“But it should make no difference whether the plaintiff's mark is to be classed on the descriptive tier of the trademark ladder . . . . What matters is whether the *defendant* is using the protected word or image descriptively, and not as a mark.”); *Sunmark*, 64 F.3d at 1058 (stating that it was irrelevant whether plaintiff's “SweetTarts” mark was arbitrary or descriptive; instead, the issue was whether the defendant's use of the terms “sweet” and “tart” was a descriptive use); 2 MCCARTHY, *supra* note 24, § 11:45 (noting that “the better view is that one can make a non-infringing descriptive ‘fair use’ even if the [mark-holder] is not using the term in a descriptive sense with its goods and services”).

regardless of the presence or absence of—(1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake, or deception.”<sup>176</sup> In 1995, Congress enacted the Federal Trademark Dilution Act (FTDA) to allow federal actions based on trademark dilution.<sup>177</sup> Under § 1125(c)(1) of the FTDA, the owner of a famous mark can prevent others from using the mark in commerce in a manner that “causes dilution of the distinctive quality of the mark.”<sup>178</sup> The FTDA also provides that a dilution claim may not be based on (a) fair use of the mark “in comparative commercial advertising,” (b) “[n]oncommercial use of [the] mark,” or (c) use of the mark in news reports or commentary.<sup>179</sup> While some courts hold that descriptive marks are not sufficiently distinctive and famous to come within the protection of the FTDA,<sup>180</sup> others disagree and allow dilution actions based on rights in descriptive marks that have become distinctive.<sup>181</sup>

---

176. 15 U.S.C. § 1127.

177. Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat. 985, 985-86 (1996) (codified at 15 U.S.C. § 1125(c) (2000)). When the FTDA was enacted in 1995, several states had already enacted antidilution statutes, beginning with Massachusetts in 1947. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 25 cmt. b (1995). The concept of dilution was introduced in the United States by Frank Schechter, who wrote that trademarks should be protected from the “gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name. . . .” Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 825 (1927).

178. 15 U.S.C. § 1125(c)(1). Section 1125(c)(1) provides that:

The owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person’s commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark, and to obtain such other relief as is provided in this subsection.

*Id.*

179. 15 U.S.C. § 1125(c)(4).

180. *E.g.*, TCPIP Holding Co., v. Haar Communications Inc., 244 F.3d 88, 93 (2d Cir. 2001) (“In considering the precise terms of the [FTDA], its fit with the general trademark law as set forth in the Lanham Act, the policies underlying trademark law, and the legislative history of the [FTDA], we conclude that a descriptive mark does not come within the protection of the [FTDA].”), followed by *N.Y. Stock Exch. v. N.Y., N.Y. Hotel, L.L.C.*, 293 F.3d 550, 556-57 (2d Cir. 2002) (in an action against a Nevada casino by the New York Stock Exchange for trademark infringement and dilution, holding that dilution protection under the Lanham Act does not extend to marks that are not inherently distinctive even though they have acquired secondary meaning).

181. *E.g.*, *Times Mirror Magazines, Inc. v. Las Vegas Sports News, L.L.C.*, 212 F.3d 157, 164-68 (3d Cir. 2000), *cert. denied*, 531 U.S. 1071 (2001) (holding that the plaintiff’s descriptive mark was entitled to protection against dilution since the mark had acquired distinctiveness through secondary meaning and was famous in its niche market and that the FTDA did not require an additional test of distinctiveness).

### 3. Anticybersquatting Consumer Protection Act

As in the FTDA, the parties need not be competitors for a mark-holder to invoke the Anticybersquatting Consumer Protection Act (ACPA)<sup>182</sup> against the registrant of a domain name that incorporates its mark.<sup>183</sup> Among other things, § 1125(d)(1) of the ACPA provides a cause of action against “cyberpirates” or “cybersquatters” who, with “a bad faith intent to profit,” register or use a domain name that “is identical or confusingly similar to” another’s distinctive or famous mark.<sup>184</sup> The mark-holder cannot prevail unless it establishes that its mark was distinctive or famous at the time the defendant registered the domain name.<sup>185</sup> Additional remedies available under the ACPA include forfeiture, cancellation, and transfer of the domain name.<sup>186</sup>

\* \* \*

In conclusion, current federal trademark law allows one business in a particular industry to register a descriptive term as a mark upon proof of acquired distinctiveness. Regardless of whether the mark is registered, the Lanham Act also allows the senior user of a descriptive mark that has become distinctive to obtain injunctive relief, damages, and other remedies based upon the unauthorized use of an identical or confusingly similar descriptive mark. Part V of this Article discusses the constitutionality of such descriptive trademark laws.

---

182. Act of Nov. 29, 1999, Pub. L. No. 106-113, div. B, § 1000 (a)(9), 113 Stat. 1501, 1536 (enacted as Title III of the Intellectual Property and Communications Omnibus and Reform Act of 1999) (codified at 15 U.S.C. § 1125(d)).

183. 15 U.S.C. § 1125(d)(1)(A) (stating that the ACPA applies “without regard to the goods or services of the parties”).

184. 15 U.S.C. § 1125(d)(1)(A)(i)-(ii) (stating that a mark-holder may obtain relief against anyone who, with “bad faith intent to profit from that mark, . . . registers, traffics in, or uses a domain name” that (1) is “identical or confusingly similar to that mark” if it was distinctive when the domain name was registered or (2) is “identical or confusingly similar to or dilutive of that mark” if it was famous when the domain name was registered). The ACPA contains a list of nonexclusive factors for courts to consider in determining whether a domain name registrant has a “bad faith intent” to profit from registration or use of a domain name. 15 U.S.C. § 1125(d)(1)(B)(i). These bad faith factors include, among other things, whether the registrant has any “trademark or other intellectual property rights [in the words that comprise] the domain name,” whether “the mark incorporated in[to] the [registrant’s] domain name . . . is . . . distinctive and famous,” and the registrant’s “bona fide noncommercial or fair use of the mark in a site accessible under the domain name.” *Id.* In addition, the ACPA provides that “[b]ad faith intent . . . shall not be found in any case in which the court determines that the person believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful.” 15 U.S.C. § 1125(d)(1)(B)(ii).

185. 15 U.S.C. § 1125(d)(1)(A)(ii)(I)-(II).

186. 15 U.S.C. § 1125(d)(1)(C).

## III. FIRST AMENDMENT PROTECTION OF COMMERCIAL SPEECH

When Congress enacted the Lanham Act in 1946, government suppression of commercial speech was not a concern because commercial expression was not considered worthy of protection under the First Amendment. Since the 1970s, however, the United States Supreme Court has recognized that truthful and nonmisleading commercial speech serves an important purpose in our society by providing consumers with information relevant to their purchase of goods in the marketplace. As a result, federal and state government regulations of commercial speech are now subject at least to an intermediate level of First Amendment scrutiny.

A. *Evolution of First Amendment Protection of Commercial Speech*

Commercial speech does “no more than propose a commercial transaction.”<sup>187</sup> It usually consists of speech that advertises a product or service either for profit or for other business purposes.<sup>188</sup> Before the 1970s the Supreme Court did not consider commercial advertising to be within the scope of First Amendment protection.<sup>189</sup> The Court changed its position in 1976. That year, in *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council, Inc.*,<sup>190</sup> the Court explicitly held for the first time that the First Amendment protects commercial speech.<sup>191</sup>

---

187. *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 762 (1976) (quoting *Pittsburgh Press Co. v. Pittsburgh Comm’n on Human Relations*, 413 U.S. 376, 385 (1973)); *see also* *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 422 (1993); *Bd. of Trs. of State Univ. of N.Y. v. Fox*, 492 U.S. 469, 482 (1989) (emphasizing that the proper test for identifying commercial speech was not whether it “consist[s] of speech for profit,” but whether it “proposes a commercial transaction”); *Bolger v. Young Drug Prods. Corp.*, 463 U.S. 60, 66 (1983).

188. *Cardtoons. L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 970 (10th Cir. 1996) (“[C]ommercial speech is best understood as speech that merely advertises a product or service for business purposes.”); *cf.* *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n*, 447 U.S. 557, 561 (1980) (explaining that commercial speech consists of “expression related solely to the economic interests of the speaker and its audience”).

189. *Valentine v. Chrestensen*, 316 U.S. 52, 53-55 (1942) (upholding a city ordinance that prohibited the distribution of all handbills except those “solely devoted to ‘information or a public protest’” because “the Constitution imposes no . . . restraint on government as respects purely commercial advertising”), *cited in* *Greater New Orleans Broad. Ass’n, Inc. v. United States*, 527 U.S. 173, 176 (1999) (noting the “Court’s earlier view that commercial advertising was unprotected by the First Amendment”).

190. 425 U.S. 748 (1976) (deciding a First Amendment challenge to a state statute that sanctioned pharmacists for advertising prescription drug prices).

191. *Id.* at 749-50, 762-65; *see* *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 553 (2001) (“For over 25 years, the Court has recognized that commercial speech does not fall outside the purview of the First Amendment.”). Although *Virginia State Board of Pharmacy* was the first

According to the *Virginia State Board of Pharmacy* Court, commercial expression is constitutionally protected because

[a]dvertising, however tasteless and excessive it sometimes may seem, is nonetheless dissemination of information as to who is producing and selling what product, for what reason, and at what price. So long as we preserve a predominantly free enterprise economy, the allocation of our resources in large measure will be made through numerous private economic decisions. It is a matter of public interest that those decisions, in the aggregate, be intelligent and well informed. To this end, the free flow of commercial information is indispensable.<sup>192</sup>

In subsequent decisions involving governmental restrictions on commercial expression, the Court has continued to hold that the First Amendment protects commercial speech due to the public's right to receive information relevant to its purchasing decisions.<sup>193</sup>

Although commercial speech is currently protected by the First Amendment, it receives a lesser degree of protection than traditional types of

---

case in which the Court explicitly held that commercial speech receives protection under the First Amendment, it is clear the Court was heading in this direction during the previous year when it stated: "The fact that [an abortion services] advertisement . . . had commercial aspects or reflected the advertiser's commercial interest did not negate all First Amendment guarantees." *Bigelow v. Virginia*, 421 U.S. 809, 818 (1975) (invalidating a Virginia statute that made it a misdemeanor for anyone to circulate advertisements encouraging abortion services). See generally Alex Kozinski & Stuart Banner, *The Anti-History and Pre-History of Commercial Speech*, 71 TEX. L. REV. 747 (1993) (discussing the historical background which led to the modern distinction between "commercial" and "noncommercial" speech).

192. *Va. State Bd. of Pharmacy*, 425 U.S. at 765. The Court also noted that a "particular consumer's interest in the free flow of commercial information . . . may be as keen, if not keener by far, than his interest in the day's most urgent political debate." *Id.* at 763.

193. See, e.g., *Edenfield v. Fane*, 507 U.S. 761, 766 (1993) (declaring that protection of commercial expression safeguards the interest of consumers "in broad access to complete and accurate commercial information"); *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557, 563 (1980) ("The First Amendment's concern for commercial speech is based on the informational function of advertising."); *First Nat'l Bank of Boston v. Bellotti*, 435 U.S. 765, 783 (1978) ("A commercial advertisement is constitutionally protected not so much because it pertains to the seller's business as because it furthers the societal interest in the 'free flow of commercial information.'" (quoting *Va. State Bd. of Pharmacy*, 425 U.S. at 764)). In *Edenfield*, the Court explained,

The commercial marketplace, like other spheres of our social and cultural life, provides a forum where ideas and information flourish. Some of the ideas and information are vital, some of slight worth. But the general rule is that the speaker and the audience, not the government, assess the value of the information presented. Thus, even a communication that does no more than propose a commercial transaction is entitled to the coverage of the First Amendment.

*Edenfield*, 507 U.S. at 767.

constitutionally guaranteed expression, such as political speech, newspapers, and books.<sup>194</sup> In 1980, the Court set forth an intermediate-scrutiny test for evaluating the constitutionality of commercial speech restrictions in *Central Hudson*.<sup>195</sup> During the next decade, the Court was not very protective of First Amendment interests in commercial speech cases,<sup>196</sup> but in cases decided in 1993 and thereafter, the Court provided more protection for commercial expression.<sup>197</sup>

In recent years, scholars<sup>198</sup> and some Supreme Court Justices “have advocated repudiation of the *Central Hudson* standard and implementation of a more straightforward and stringent test for assessing the validity of

194. See *United States v. Edge Broad. Co.*, 509 U.S. 418, 426 (1993) (“The Constitution therefore affords a lesser protection to commercial speech than to other constitutionally guaranteed expression.”); *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 422 (1993) (“[S]peech proposing a commercial transaction is entitled to lesser protection than other constitutionally guaranteed expression.”); *S.F. Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522, 535 (1987) (“Commercial speech ‘receives a limited form of First Amendment protection.’” (quoting *Posadas de P.R. Assocs. v. Tourism Co.*, 478 U.S. 328, 340 (1986))); *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 970 (10th Cir. 1996) (“[C]ommercial speech may receive something less than the strict review afforded other types of speech.”).

195. *Central Hudson*, 447 U.S. at 566. The *Central Hudson* test is an intermediate-scrutiny test. See *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 572 (2001) (Thomas, J., concurring in part and concurring in judgment) (noting that the majority correctly determined that “the regulations [at issue] fail even the intermediate scrutiny of *Central Hudson*”). The test is discussed *infra* Subpart III.B.

196. See *e.g.*, *Bd. of Trs. of State Univ. N.Y. v. Fox*, 492 U.S. 469 (1989); *S.F. Arts & Athletics, Inc. v. United States Olympic Committee*, 483 U.S. 522 (1987); *Posadas de P.R. Assocs. v. Tourism Co.*, 478 U.S. 328 (1986).

197. See *e.g.*, *Thompson v. W. States Med. Ctr.*, 535 U.S. 357 (2002); *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525 (2001); *Greater New Orleans Broad. Ass’n, Inc. v. United States*, 527 U.S. 173 (1999); *44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484 (1996); *Rubin v. Coors Brewing Co.*, 514 U.S. 476 (1995); *Edenfield v. Fane*, 507 U.S. 761 (1993); *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410 (1993).

198. Some scholars suggest eliminating the distinction between commercial and noncommercial speech. See, *e.g.*, Alex Kozinski & Stuart Banner, *Who’s Afraid of Commercial Speech?*, 76 VA. L. REV. 627, 651-53 (1990). If this distinction is eliminated, Judge Kozinski and Professor Banner claim a “standard content-neutral analysis” applies to governmental restrictions of advertising. *Id.* at 651. However, trademark laws (like copyright and right of publicity laws) are not content-neutral “time, place or manner restrictions” on expression. See Eugene Volokh, *Freedom of Speech and Intellectual Property: Some Thoughts After Eldred*, 44 LIQUORMART, and Bartnicki, 40 HOUSTON L. REV. 697, 702-12 (2003). Professor Volokh convincingly argues that trademark laws are content-based because they define the speech they prohibit based on the content of the defendant’s expression and contain a content-based defense: the fair use defense. *Id.* Unless a content-based regulation of speech fits within another First Amendment exception, it cannot withstand constitutional scrutiny unless the government shows that regulation “is necessary to serve a compelling state interest and is narrowly drawn to achieve that end.” *Ark. Writers’ Project, Inc. v. Ragland*, 481 U.S. 221, 230-31 (1987).

governmental restrictions on commercial speech.”<sup>199</sup> For example, in *Lorillard Tobacco Co. v. Reilly*,<sup>200</sup> Justice Thomas stated that he “believe[s] that when the government seeks to restrict truthful speech in order to suppress the ideas it conveys, strict scrutiny is appropriate, whether or not the speech in question may be characterized as ‘commercial.’”<sup>201</sup> In that same case, Justice Kennedy noted “continuing concerns that the *Central Hudson* test gives insufficient protection to truthful, nonmisleading commercial speech.”<sup>202</sup> In an earlier case, *44 Liquormart*, Justice Thomas stated that the *Central Hudson* test should not be applied in commercial speech cases when the “government’s asserted interest is to keep legal users of a product or service ignorant in order to manipulate their choices in the marketplace” because “such an ‘interest’ is *per se* illegitimate and can no more justify regulation of ‘commercial speech’ than it can justify regulation of ‘noncommercial speech.’”<sup>203</sup> Justice Scalia said that he “share[d] Justice Thomas’s discomfort with the *Central Hudson* test, which seem[ed] to . . . have nothing more than policy intuition to support it.”<sup>204</sup> Nonetheless, the Court continues to apply the *Central Hudson* analysis to governmental regulations of commercial speech.<sup>205</sup>

This Article assumes that *Central Hudson*’s intermediate level of First Amendment scrutiny applies to commercial speech regulations. If the Court should later determine that such regulations are instead subject to a strict level of scrutiny, this change in commercial speech doctrine will only strengthen

199. *Greater New Orleans*, 527 U.S. at 184; *Thompson*, 535 U.S. at 367 (noting that “several Members of the Court have expressed doubts about the *Central Hudson* analysis and whether it should apply in particular cases”).

200. 533 U.S. 525 (2001).

201. *Lorillard*, 533 U.S. at 572 (Thomas, J., concurring in part and concurring in judgment); see also *Thompson*, 535 U.S. at 377 (Thomas, J., concurring) (stating that the majority opinion properly applied the *Central Hudson* test, but continuing “to adhere to [his] view that cases such as this should not be analyzed under the *Central Hudson* test”); *Greater New Orleans*, 527 U.S. at 197 (Thomas, J., concurring in judgment).

202. *Lorillard*, 533 U.S. at 571-72 (Kennedy, J., concurring in part and concurring in judgment). Justice Scalia joined in Justice Kennedy’s concurrence.

203. *44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 518 (Thomas, J., concurring in part and concurring in judgment).

204. *Id.* at 517 (Scalia, J., concurring in part and concurring in judgment).

205. See, e.g., *Thompson*, 535 U.S. at 367-68; *Lorillard*, 533 U.S. at 554-55; *Greater New Orleans*, 527 U.S. at 184. Although the Supreme Court has recognized that “reasonable judges may disagree about the merits of . . . proposals” to renounce the *Central Hudson* analysis in favor of a more “stringent test,” the Court has nonetheless stated:

It is . . . an established part of our constitutional jurisprudence that we do not ordinarily reach out to make novel or unnecessarily broad pronouncements on constitutional issues when a case can be fully resolved on a narrower ground. . . . [T]here is no need to break new ground. *Central Hudson*, as applied in our more recent commercial speech cases, provides an adequate basis for decision.

*Greater New Orleans*, 527 U.S. at 184.

this Article's contention that descriptive trademark laws violate the First Amendment.

*B. The Central Hudson Test for Evaluating  
the Constitutionality of Commercial Speech Regulations*

The current test for evaluating the constitutionality of governmental regulations of commercial speech is set forth in *Central Hudson*.<sup>206</sup> The *Central Hudson* test has four factors. First, the court must determine whether the speech concerns "lawful activity" and is not "misleading."<sup>207</sup> If the speech relates to a lawful activity and is not misleading, regulation of that speech violates the First Amendment unless "the asserted governmental interest is substantial," "the regulation directly advances the governmental interest," and the regulation "is not more extensive than is necessary to serve that interest."<sup>208</sup> The government "bears the burden of identifying a substantial interest and justifying the challenged restriction" under the remaining factors.<sup>209</sup>

Under the first factor of the *Central Hudson* test, the court determines whether the expression at issue is worthy of any constitutional protection.<sup>210</sup> The government can prohibit dissemination of false or misleading information, regardless of whether the expression is commercial.<sup>211</sup> For commercial speech

206. See *Central Hudson*, 447 U.S. at 566; see also *Greater New Orleans*, 527 U.S. at 183 (noting that the four-part *Central Hudson* test is used to evaluate the constitutionality of "restrictions on speech that is 'commercial' in nature").

207. *Central Hudson*, 447 U.S. at 566; see also *Thompson v. W. States Med. Ctr.*, 535 U.S. 357, 367 (2002) (discussing and applying the *Central Hudson* test).

208. *Central Hudson*, 447 U.S. at 566; see *Thompson*, 535 U.S. at 367 ("Each of these latter three inquiries must be answered in the affirmative for the regulation to be found constitutional."); *Edenfield*, 507 U.S. at 768-69 ("[W]here . . . truthful and nonmisleading expression will be snared along with fraudulent or deceptive commercial speech, the State must satisfy the remainder of the *Central Hudson* test . . .").

209. *Greater New Orleans*, 527 U.S. at 183; see *Rubin v. Coors Brewing Co.*, 514 U.S. 476, 487 (1995) ("[T]he Government carries the burden of showing that the challenged regulation advances the Government's interest 'in a direct and material way.'" (quoting *Edenfield*, 507 U.S. at 767)); see also *Edenfield*, 507 U.S. at 770 ("It is well established that '[t]he party seeking to uphold a restriction on commercial speech carries the burden of justifying it.'" (quoting *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 71 n.20 (1983))).

210. *Central Hudson*, 447 U.S. at 566 ("At the outset, we must determine whether the expression is protected by the First Amendment. For commercial speech to come within that provision, it at least must concern lawful activity and not be misleading."); see also *Thompson*, 535 U.S. at 367 ("Under [the *Central Hudson*] test we ask as a threshold matter whether the commercial speech concerns unlawful activity or is misleading. If so, then the speech is not protected by the First Amendment.").

211. *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 771-72 (1976) ("Untruthful speech, commercial or otherwise, has never been protected for its own sake. . . . The First Amendment, as we construe it today, does not prohibit the State from insuring that the stream of commercial information flow[s] cleanly as well as freely."); see S.F.

to come within the scope of the First Amendment, “it at least must concern lawful activity and not be misleading.”<sup>212</sup> Thus, “[t]ruthful advertising related to lawful activities is entitled to the protections of the First Amendment,” but “[m]isleading advertising may be prohibited entirely.”<sup>213</sup> If the speech concerns a lawful activity and is not misleading, the speech regulation is unconstitutional unless each of the remaining three factors of the *Central Hudson* test are satisfied.

The second factor of the *Central Hudson* test requires the government to prove that a substantial governmental interest exists for regulating the commercial speech at issue.<sup>214</sup> The government’s interest in protecting the public from “commercial harms . . . is . . . the typical reason why commercial speech can be subject to greater governmental regulation than noncommercial speech.”<sup>215</sup> For example, the Supreme Court has stated that “there is no question that [the government’s] interest in ensuring the accuracy of commercial information in the marketplace is substantial.”<sup>216</sup>

Once the government proves it has a substantial interest in regulating this speech, the third factor in the *Central Hudson* test requires the court to consider “whether the speech restriction directly and materially advances [that] interest.”<sup>217</sup> This step “concerns the relationship between the harm that underlies the State’s interest and the means identified by the State to advance that interest.”<sup>218</sup> Unless the government can prove that its asserted interest is advanced by the regulation “‘in a direct and material way,’” the regulation is unconstitutional.<sup>219</sup> The government cannot satisfy its burden “by mere speculation or conjecture; rather, a governmental body seeking to sustain a restriction on commercial speech must demonstrate that the harms it recites are real and that its restriction will in fact alleviate them to a material degree.”<sup>220</sup> This third factor of the *Central Hudson* test is “critical; otherwise, ‘a

---

Arts & Athletics, Inc. v. United States Olympic Comm., 483 U.S. 522, 535 n.12 (1987) (“The Government constitutionally may regulate ‘deceptive or misleading’ commercial speech.”); *Bolger*, 463 U.S. at 69 (“The State may deal effectively with false, deceptive, or misleading sales techniques.”); *Castrol Inc. v. Pennzoil Co.*, 987 F.2d 939, 949 (3d Cir. 1993) (holding that “commercial speech that is false when uttered does not enjoy the protection of the First Amendment”).

212. *Central Hudson*, 447 U.S. at 566.

213. *In re R.M.J.*, 455 U.S. 191, 203 (1982).

214. *Central Hudson*, 447 U.S. at 564 (“The State must assert a substantial interest . . .”).

215. *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 426 (1993).

216. *Edenfield v. Fane*, 507 U.S. 761, 769 (1993).

217. *Greater New Orleans Broad. Ass’n, Inc. v. United States*, 527 U.S. 173, 188 (1999); see *Central Hudson*, 447 U.S. at 566.

218. *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 555 (2001).

219. *Rubin v. Coors Brewing Co.*, 514 U.S. 476, 487 (1995) (“[T]he Government carries the burden of showing that the challenged regulation advances the Government’s interest ‘in a direct and material way.’” (quoting *Edenfield*, 507 U.S. at 767)).

220. *Edenfield*, 507 U.S. at 770-71, quoted in *Lorillard*, 533 U.S. at 555.

[government] could with ease restrict commercial speech in the service of other objectives that could not themselves justify a burden on commercial expression.”<sup>221</sup> Where a speech regulation “provides only ineffective or remote support” for the interests asserted by the government, it cannot survive First Amendment scrutiny.<sup>222</sup>

The fourth factor of the *Central Hudson* test “complements” the third factor and asks “whether the speech restriction is not more extensive than necessary to serve the interests that support it.”<sup>223</sup> While the government need not establish that the regulation employs the least restrictive means available to advance its goals,<sup>224</sup> there must be a “reasonable fit between the means and ends of the regulatory scheme.”<sup>225</sup> In other words, the regulation must be “narrowly tailored to achieve” the asserted governmental interests.<sup>226</sup> The regulation must show the government “‘carefully calculated’ the costs and benefits associated with the burden on speech imposed by its prohibition.”<sup>227</sup> “[I]f the Government could achieve its interests in a manner that does not restrict speech, or that restricts less speech, [it] must do so.”<sup>228</sup> Therefore,

221. *Rubin*, 514 U.S. at 487 (quoting *Edenfield*, 507 U.S. at 771).

222. *Central Hudson*, 447 U.S. at 564, quoted in *Edenfield*, 507 U.S. at 770 (“The penultimate prong of the *Central Hudson* test requires that a regulation impinging upon commercial expression ‘directly advance the state interest involved; the regulation may not be sustained if it provides only ineffective or remote support for the government’s purpose.’”).

223. *Greater New Orleans Broad. Ass’n, Inc. v. United States*, 527 U.S. 173, 188 (1999).

224. *Lorillard*, 533 U.S. at 556 (“We have made it clear that ‘the least restrictive means’ is not the standard . . . .” (quoting *Bd. of Trs. of State Univ. of N.Y. v. Fox*, 492 U.S. 469, 480 (1989) (clarifying for the first time that a governmental regulation of commercial speech need not be “the least restrictive means” in order to satisfy the fourth prong of the *Central Hudson* test))); *Greater New Orleans*, 527 U.S. at 188 (“The Government is not required to employ the least restrictive means conceivable, but it must demonstrate narrow tailoring of the challenged regulation to the asserted interest . . . .”).

225. *Lorillard*, 533 U.S. at 561; *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 416 (1993) (requiring a “reasonable fit” between the governmental interest and the means selected to achieve it); *Fox*, 492 U.S. at 480 (stating that the government must show “a fit that is not necessarily perfect, but reasonable; that represents not necessarily the single best disposition but one whose scope is ‘in proportion to the interest served’”) (quoting *In re R.M.J.*, 455 U.S. 191, 203 (1982))).

226. *Fox*, 492 U.S. at 480, quoted in *Lorillard*, 533 U.S. at 556; see *Greater New Orleans*, 527 U.S. at 188; cf. *Edenfield*, 507 U.S. at 767 (“[L]aws restricting commercial speech, unlike laws burdening other forms of protected expression, need only be tailored in a reasonable manner to serve a substantial state interest in order to survive First Amendment scrutiny.”).

227. *City of Cincinnati*, 507 U.S. at 417.

228. *Thompson v. W. States Med. Ctr.*, 535 U.S. 357, 371 (2002); *Rubin v. Coors Brewing Co.*, 514 U.S. 476, 490-91 (1995) (declaring unconstitutional a federal law that prohibited beer labels from displaying alcohol content in part because of the availability of “alternatives, such as directly limiting the alcohol content of beers, prohibiting marketing efforts emphasizing high alcohol strength . . . , or limiting the labeling ban only to malt liquors”). In *Thompson*, a federal act allowed pharmacists to sell compounded drugs without first complying with drug safety and

where alternative regulations “could advance the Government’s asserted interest in a manner less intrusive to . . . First Amendment rights,” the contested regulation is “more extensive than necessary” and violates the First Amendment.<sup>229</sup>

#### IV. FIRST AMENDMENT LIMITATIONS ON THE ENFORCEMENT OF TRADEMARK RIGHTS

As judicial enforcement of private trademark rights restricts the use of the trademarked words by others, application of federal and state trademark laws is subject to scrutiny under the First Amendment.<sup>230</sup> When a business uses a word or symbol to identify itself as the source of a product, this is a form of commercial speech because it is “speech which proposes (directly or indirectly) a commercial transaction.”<sup>231</sup> The mark, like an advertisement,

---

efficacy regulations so long as the providers did not advertise these drugs. *Thompson*, 535 U.S. at 370. Although the government asserted that this restriction on commercial speech was necessary in the interest of public safety to force large-scale drug manufacturers to first seek FDA approval, the Court found the regulation unconstitutional in light of “[s]everal non-speech-related [alternative] means.” *Id.* at 372.

229. *Rubin*, 514 U.S. at 490-91, *quoted in Thompson*, 535 U.S. at 371-72.

230. *See* *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 968 (10th Cir. 1996) (“Although this is a civil action between private parties, it involves application of a state statute that [the plaintiff] claims imposes restrictions on its right of free expression. Application of that statute thus satisfies the state action requirement of [the plaintiff’s] First Amendment claim.”); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 30 n.2 (1st Cir. 1987) (“When judicial enforcement of private personal rights touching forms of communication restricts freedom of speech, state action is implicated.”); *Denicola*, *supra* note 3, at 192 n.146; *Kravitz*, *supra* note 3, at 145, 165 n.166; *see also* *S.F. Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522, 537 n.16 (1987) (applying both the *Central Hudson* test and the test for time, place, or manner restrictions on speech to section 110 of the Amateur Sports Act and thereby assuming that the enforcement of private trademark rights under section 110 constitutes governmental action subject to First Amendment analysis). Some courts decline to address a First Amendment defense to trademark infringement when they are able to resolve the case in favor of the defendant on trademark law grounds. *See e.g.*, *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 305 (9th Cir. 1992) (affirming the trial court’s decision on grounds other than the First Amendment and noting that “where we are able to resolve the case on nonconstitutional grounds, we ordinarily must avoid reaching the constitutional issue”); *M.B.H. Enters., Inc. v. WOKY, Inc.*, 633 F.2d 50, 56 (7th Cir. 1980) (“Because we base our decision on the fair use defense, we have no occasion to consider the First Amendment issue also presented in this case.”).

231. Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 *DUKE L.J.* 147, 219 (1998). In discussing the inherently commercial nature of trademarks, Professor Denicola has explained that:

The adoption of a symbol as a trademark is a form of commercial speech. The trademark ordinarily communicates information concerning source or quality. If the symbol has already been employed by another, the subsequent use may also evoke the

provides information as to “who is producing and selling what product.”<sup>232</sup> Although commercial speech is entitled to First Amendment protection, courts usually hold that injunctions in trademark infringement cases are constitutional because the defendant’s use of the plaintiff’s mark is “misleading” commercial speech.<sup>233</sup>

Although trademarks are used to identify the source of a product for sale, not all uses of trademarks constitute commercial speech. For example, well-known marks are often used without authorization in parodies, artistic expression, and even on T-shirts to convey a political, social, or humorous message. Here, the trademark is “used as the subject of speech,” rather than to propose a commercial transaction, and thus is “traditional speech entitled to full protection” under the First Amendment.<sup>234</sup> Unfortunately, courts have declined to apply strict scrutiny analysis to injunctions prohibiting such trademark uses, and have instead applied a time, place, or manner analysis,<sup>235</sup> or a test that balances the public interest in avoiding consumer confusion with the public interest in free expression.<sup>236</sup> This Article discusses each of these different First Amendment analyses of the trademark laws below.

#### A. Governmental Restrictions on the Commercial Use of Trademarks

As noted by Professors Lemley and Volokh, “[t]he strongest constitutional justification for trademark laws is that, properly construed, they prevent only commercial speech that is likely to cause confusion, and that false or misleading speech can be restricted.”<sup>237</sup> In *Friedman v. Rogers*,<sup>238</sup> the

---

image of the senior user or his product, but this does not alter the commercial nature of the speech. The purpose remains to attract prospective consumers, and the use thus serves as “part of a proposal of a commercial transaction.”

Denicola, *supra* note 3, at 193 (footnote omitted) (quoting *Friedman v. Rogers*, 440 U.S. 1, 10 n.9 (1979)); see 5 MCCARTHY, *supra* note 24, § 31:139 (“It would appear clear that a firm’s trademark is the most important element of commercial speech which is communicated to customers. All other elements of advertising revolve around, relate to and are symbolized by the trademark.” (footnote omitted)); see also *Friedman v. Rogers*, 440 U.S. 1, 11 (1979) (“The use of trade names in connection with optometrical practice, then, is a form of commercial speech and nothing more.”).

232. *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 765 (1976) (noting that advertising, which “disseminat[es] . . . information as to who is producing and selling what product,” is a form of commercial speech entitled to First Amendment protection).

233. See *infra* Subpart IV.A.

234. Lemley & Volokh, *supra* note 231, at 219-20; see *infra* notes 257-59 and accompanying text.

235. See *infra* notes 255, 261-62 and accompanying text.

236. See *infra* notes 265-70 and accompanying text.

237. Lemley & Volokh, *supra* note 231, at 221. Professor Denicola agrees that:

Reliance on the confusion rationale as the primary basis of liability has effectively

Supreme Court took this view when it held that a Texas statute prohibiting the practice of optometry under a trade name did not violate the First Amendment because the state had a “substantial and well demonstrated” interest “in protecting the public from . . . deceptive and misleading” practices.<sup>239</sup> Likewise, in *San Francisco Arts & Athletics Inc. v. United State Olympic Committee*,<sup>240</sup> the Court said trademark laws that “regulat[e] confusing uses” of marks are constitutional because the government “may regulate ‘deceptive or misleading’ commercial speech.”<sup>241</sup>

Trademark law may be “substantively constitutional” if “it is linked to evidence that the defendant’s mark is in fact misleading” and “the defendant’s speech is really commercial.”<sup>242</sup> Using the rationale that trademark infringement is misleading commercial speech, some federal courts have rejected First Amendment challenges in infringement actions under the Lanham Act by holding that the defendant’s use of the mark constitutes commercial speech that fails to satisfy the first factor of the *Central Hudson* test. With only a cursory analysis, these courts have declared that a defendant’s infringing use of a mark is not protected by the First Amendment because it is false or misleading to use a mark in a manner that is likely to cause confusion.<sup>243</sup> Some scholars and commentators have arrived at the same

---

insulated traditional trademark doctrine from constitutional attack. The necessity of establishing that the challenged use generates a likelihood of confusion restricts judicial intervention to instances in which the mark is used to misrepresent the source or sponsorship of goods or services. The regulation of such deceptive or misleading commercial speech presents no constitutional difficulties . . .

Denicola, *supra* note 3, at 165; *see also* Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc., 425 U.S. 748, 771-72 (1976) (“We foresee no obstacle to a State’s dealing effectively with [the] problem [of deceptive or misleading commercial speech]. The First Amendment, as we construe it today, does not prohibit the State from insuring that the stream of commercial information flow[s] cleanly as well as freely.” (footnote omitted)). The Lanham Act explicitly states that one of its goals “is to regulate commerce . . . by making actionable the deceptive and misleading use of marks.” 15 U.S.C. § 1127 (2000).

238. 440 U.S. 1 (1979).

239. *Id.* at 15.

240. 483 U.S. 522 (1987).

241. *Id.* at 535 n.12. Infringement actions based on the unauthorized use of a protected mark require proof that the defendant’s use of the mark is likely to confuse consumers. *See supra* Section II.C.1.

242. Lemley & Volokh, *supra* note 231, at 221.

243. *See, e.g.*, E. & J. Gallo Winery v. Gallo Cattle Co., 967 F.2d 1280, 1297 (9th Cir. 1992) (rejecting the defendant’s argument that an injunction violated the First Amendment “because misleading commercial speech can be restricted”); Transgo, Inc. v. Ajac Transmission Parts Corp., 768 F.2d 1001, 1022 (9th Cir. 1985) (holding that the infringer’s First Amendment defense to a trademark injunction “lack[ed] merit” because “[c]ommercial speech may be regulated when its content is otherwise false or misleading”); Kelley Blue Book v. Car-Smarts, Inc., 802 F. Supp. 278, 291 (C.D. Cal. 1992) (rejecting the defendants’ claim of protection under the First Amendment because evidence indicated that the “defendants’ use of . . .

conclusion.<sup>244</sup>

While traditional trademark infringement laws may be insulated from constitutional attack where the defendant's commercial use of the mark is misleading, current trademark laws restrict more than false or misleading speech. For example, trademark dilution laws do not require proof that the defendant's use of a trademarked term is likely to cause confusion.<sup>245</sup> Thus, the "argument that false or misleading speech is unprotected . . . offers no [constitutional] support for dilution statutes."<sup>246</sup> As trademark dilution laws do not regulate misleading speech, the last three factors of the *Central Hudson* test are relevant when determining whether dilution laws are constitutional restrictions of commercial speech.<sup>247</sup>

---

designations [incorporating terms from the plaintiff's mark] is misleading in that it is likely to cause confusion among consumers").

244. See e.g., Denicola, *supra* note 3, at 165; Gray, *supra* note 3, at 225 ("[S]peech in a trademark infringement case is not protected by the First Amendment because the Lanham Act only prohibits misleading or deceptive speech (i.e., speech that is likely to cause confusion in the minds of consumers).").

245. See *supra* Section II.C.2. There is also no likelihood of confusion requirement in the Anticybersquatting Consumer Protection Act. See *supra* Section II.C.3.

246. Lemley & Volokh, *supra* note 231, at 221 n.325.

247. Scholars and commentators disagree regarding the constitutionality of the trademark dilution laws under *Central Hudson*. Compare Denicola, *supra* note 3, at 194-95 (concluding that trademark dilution laws are constitutional under *Central Hudson*), and Kravitz, *supra* note 3, at 147-48 (same), with Gray, *supra* note 3, at 225-227 (concluding that trademark dilution laws are unconstitutional under *Central Hudson*). According to Professor Denicola,

A prohibition against the adoption of a trademark already associated with another directly advances the objective of preventing trademark misappropriation and dilution, and in light of that goal, does not appear unnecessarily broad. In view of the uncertain economic underpinnings of the misappropriation and dilution rationales, however, the "substantialness" of this regulatory interest might well be questioned when the use causes no deception. Such a judgment must surely depend in part upon the extent to which speech interests are in fact being sacrificed to attain the desired end. The United States Supreme Court [in *Friedman*] has itself recognized that the use of a symbol as a trademark is only tangentially related to free speech rights. . . . Because of the marginal interference with freedom of speech, the state interest in prohibiting even the non-deceptive use of another's symbol as a trademark appears sufficient to survive constitutional analysis. Thus the misappropriation and dilution rationales, when applied merely to interdict the unauthorized adoption of a symbol as a trademark, do not appear to impinge on constitutionally protected rights.

Denicola, *supra* note 3, at 194-95 (footnote omitted). In contrast, Megan Gray has stated that "application of the *Central Hudson* test results in the conclusion that the dilution laws are unconstitutional." Gray, *supra* note 3, at 225. In her view, the second factor of *Central Hudson* "is not met because the only governmental interest involved in dilution statutes is an interest in protecting a trademark owner's intangible property from the unauthorized use by another . . . [, and] the Supreme Court has decided that there is no property right in a trademark." *Id.* Gray also believes dilution laws fail the fourth factor of *Central Hudson*

Another way the government regulates the nonmisleading use of trademarks in commerce is when it enacts a special statute that grants a private entity the exclusive right to use a word regardless of whether unauthorized use of that word tends to cause confusion. For example, Congress has granted the United States Olympic Committee (USOC) “the right to prohibit certain commercial and promotional uses of the word ‘Olympic’ and various Olympic symbols.”<sup>248</sup>

In *San Francisco Arts & Athletics*, the USOC filed suit under section 110 of the Amateur Sports Act to enjoin the defendant from using the word “Olympic” and related symbols to promote its sports competition as the “Gay Olympic Games.”<sup>249</sup> Although the Court acknowledged that generic terms cannot be registered or protected under the Lanham Act,<sup>250</sup> it rejected the defendant’s argument that the First Amendment prohibits Congress from granting a private entity trademark rights in the word “Olympic.”<sup>251</sup> Without expressly deciding whether the word “Olympic” was generic or descriptive,<sup>252</sup> the Court held that Congress was “within constitutional bounds” when it granted “the USOC a limited property right in the word ‘Olympic’” because Congress could reasonably conclude the word “acquired what in trademark law is known as secondary meaning” due to the USOC’s efforts.<sup>253</sup> The Court

---

because they are overbroad. *Id.* at 226. An analysis of the constitutionality of the trademark dilution laws is beyond the scope of this Article.

248. *S.F. Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522, 526 (1987). In 1987, the relevant statute which granted USOC this right was section 110 of the Amateur Sports Act, 36 U.S.C. § 380. *Id.* The statute was renumbered in 1998 under the Olympic Symbol Act and is now codified at 36 U.S.C. § 220506.

249. *S.F. Arts & Athletics*, 483 U.S. at 525-27.

250. *Id.* at 531 n.7.

251. *Id.* at 532-35.

252. The Court never referred to the word “Olympic” as a “descriptive” word, nor did it state whether it agreed with the defendant’s characterization of the word “Olympic” as “generic” for this type of sports competition. Although the Court did state that “[t]he history of the origins and associations of the word ‘Olympic’ demonstrates the meritlessness of the SFAA’s contention that Congress simply plucked a generic word out of the English vocabulary and granted its exclusive use to the USOC,” it is not clear that the Court rejected the defendant’s argument that “Olympic” is a generic word in this language. *Id.* at 534. Rather, here and elsewhere in the opinion, the Court deferred to Congress’s conclusion that the commercial and promotional value of the word “Olympic” is due to the USOC’s efforts, and entitles the USOC to trademark rights in the word “Olympic.” *Id.* at 532-34.

253. *Id.* at 534-35. According to the Court,

Congress reasonably could find that since 1896, the word “Olympic” has acquired what in trademark law is known as secondary meaning . . . . Because Congress reasonably could conclude that the USOC has distinguished the word “Olympic” through its own efforts, Congress’ decision to grant the USOC a limited property right in the word “Olympic” falls within the scope of trademark law protections, and thus certainly within constitutional bounds.

*Id.* (citations omitted).

also rejected the defendant's argument "that the First Amendment prohibits Congress from granting exclusive use of [the word "Olympic"] absent a requirement that the authorized user prove that an unauthorized use is likely to cause confusion."<sup>254</sup> After applying the four-factor *Central Hudson* test, the Court held that section 110 was a constitutional restriction of nonmisleading commercial speech when it prohibited the defendant and others from commercially using the word "Olympic."<sup>255</sup> Commentators have criticized the Court's analysis and conclusion in this case.<sup>256</sup> *San Francisco Arts & Athletics* is the most recent Supreme Court case that applies the *Central Hudson* test to governmental restrictions on the nonmisleading use of a trademark for commercial purposes.

Although scholars and courts have analyzed the constitutionality of injunctions in certain trademark infringement actions, dilution laws, and sui generis trademark statutes under *Central Hudson*, no one has analyzed whether the Lanham Act's restrictions on the use of descriptive terms as marks withstand First Amendment scrutiny. This Article sets forth such an analysis in Part V.

---

254. *Id.* at 532.

255. *Id.* at 535, 537 n.16, 537-41. The Court noted that commercial speech was implicated "[t]o the extent that § 110 applies to uses 'for the purpose of trade [or] to induce the sale of any goods or services.'" *Id.* at 535 (citation omitted). In *San Francisco Arts & Athletics*, the defendant also argued that section 110 suppresses political speech because "its use of the word 'Olympic' was intended to convey a political statement about the status of homosexuals in society." *Id.* at 535. In response to this argument, the Court said, "Section 110 restricts only the manner in which the SFAA may convey its message," *id.* at 536, and thus the "appropriate inquiry" was whether section 110's restrictions on noncommercial speech satisfied the test for content-neutral time, place, or manner restrictions set forth in *United States v. O'Brien*, 391 U.S. 367, 377 (1968). *Id.* at 537. The Court held section 110 was also constitutional under the test in *O'Brien*. *Id.* at 537-41.

256. See e.g., Kravitz, *supra* note 3, at 166-84; Volokh, *supra* note 198, at 736-39 (discussing the constitutional problems with this case and noting the Court engaged in reasoning contrary to *Cohen v. California*, 403 U.S. 15 (1971)). Robert Kravitz concludes that the Court's analysis is "flawed" in *San Francisco Arts & Athletics*: "[T]he Court understated the expressive value of [the defendant's] use of the word 'Olympic' while overvaluing what it termed the USOC's 'property right.' The Court also distorted the analysis of what constitutes commercial speech and misapplied basic concepts of trademark law." Kravitz, *supra* note 3, at 166-67. Specifically, the Court "misappl[ied] secondary meaning analysis to the issue of genericness" because generic words are not entitled to trademark protection. *Id.* at 167. In addition, the Court's decision to analyze section 110 of the Amateur Sports Act under *O'Brien*'s time, place, or manner test was improper because the statute was content-based, rather than simply a restriction of the manner of speech. *Id.* at 176. "Section 110 restricts not only the manner in which [the defendant] can express its message, but the very words it can use to express that message." *Id.*

*B. Governmental Restrictions on the  
Use of Trademarks to Communicate Ideas*

In cases involving the use of a mark to communicate ideas, rather than to propose a commercial transaction, courts and scholars disagree regarding the proper constitutional analysis for evaluating a First Amendment challenge to a trademark law. When trademark cases involve “certain parodies of trademarks, political or socially-directed advertisements, the use of the plaintiff’s marks outside of advertisements to truthfully refer to the plaintiff’s product (so-called ‘non-trademark use’), product reviews, uses in fiction, commentary or film, and the merchandising of a trademark as a good in itself,”<sup>257</sup> Professors Lemley and Volokh correctly note that these trademark uses are “traditional speech entitled to full protection.”<sup>258</sup> As explained by Judge Kozinski:

[T]rademarks play a significant role in our public discourse. They often provide some of our most vivid metaphors, as well as the most compelling imagery in political campaigns. Some ideas—‘it’s the Rolls Royce of its class,’ for example—are difficult to express any other way. . . . Where trademarks come to carry so much communicative freight, allowing the trademark holder to restrict their use implicates our collective interest in free and open communication.<sup>259</sup>

While some courts recognize that an “editorial or artistic” use of another’s mark is entitled to First Amendment protection,<sup>260</sup> many courts do not adequately protect the expression conveyed by the unauthorized use of another’s mark.

Some courts state that restrictions on the use of a mark to communicate

257. Lemley & Volokh, *supra* note 231, at 219-20.

258. *Id.* at 219; *see* Denicola, *supra* note 3, at 190-207 (suggesting that although free speech interests are not harmed by trademark infringement laws that regulate confusing uses of marks or by the misappropriation and dilution rationales when directed only at trademark uses of another’s mark, these laws may be unconstitutional when used to prohibit the use of trademarks to communicate ideas).

259. Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 972-73 (1993); Lemley, *supra* note 2, at 1710-13; *cf.* Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 400-02 (1990) (recognizing that trademarks have different functions in modern language as illustrated by the word “Barbie,” which may be used to “signal” that Mattel is the manufacturer of the doll, to “express” that a woman is being “treated like a beautiful but empty-headed accessory,” or to demonstrate that a person attaches “surplus value” to that word in excess of its function as a signal about toys).

260. *See, e.g.,* L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26, 32-33 (1st Cir. 1987) (holding that the defendant’s parody of the L.L. Bean catalogue was protected under the First Amendment because it was “an editorial or artistic, rather than a commercial use of the plaintiff’s mark”).

ideas are merely content-neutral time, place, or manner restrictions of speech subject to the standard of review set forth in *Lloyd Corp. v. Tanner*.<sup>261</sup> These courts hold that injunctions prohibiting the defendant from using the plaintiff's mark do not violate the First Amendment because alternative avenues of expression exist for the defendant to communicate its views without using the plaintiff's mark.<sup>262</sup> But standards of review for content-neutral time, place, or manner restrictions of speech are not appropriate in trademark actions because trademark laws regulate the content, and thus the communicative impact, of speech.<sup>263</sup> As noted by the Tenth Circuit, *Lloyd's* "no adequate alternative avenues" test is inappropriate in trademark cases because "[r]estrictions on the words or images that may be used by a speaker . . . are quite different than restrictions on the time, place, or manner of speech."<sup>264</sup>

Other courts in trademark actions involving artistic expression apply a balancing test that was first articulated in *Rogers v. Grimaldi*,<sup>265</sup> which involved a Lanham Act action brought by Ginger Rogers to enjoin the defendant's use of the movie title "Ginger & Fred."<sup>266</sup> Under the *Rogers*

261. 407 U.S. 551, 567-68 (1972) (upholding the authority of a private shopping center to prohibit the distribution of handbills on its premises under an "adequate alternative avenues of communication" standard for time, place, or manner restrictions on speech). The Supreme Court also applied a time, place, or manner test in *San Francisco Arts & Athletics* to the defendant's noncommercial use of the word "Olympic," but in that case the Court used the test set forth in *O'Brien. S.F. Arts & Athletics*, 483 U.S. at 536-41 (holding that "Section 110 restricts only the manner in which the SFAA may convey its message," and "[t]he appropriate inquiry is thus whether the incidental restrictions on First Amendment freedoms are greater than necessary to further a substantial government interest") (citing *United States v. O'Brien*, 391 U.S. 367, 377 (1968)).

262. See, e.g., *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987) (rejecting a First Amendment defense when defendant used the phrase "Mutant of Omaha" on anti-nuclear arms T-shirts, because "[o]ther avenues for [the defendant] to express his views [on nuclear war] exist and are unrestricted by the injunction"); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979) ("Because there are numerous ways in which defendants may comment on 'sexuality in athletics' without infringing plaintiff's trademark, the [trial] court did not encroach upon their first amendment rights in granting a preliminary injunction."); *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727, 734-35 (D. Minn. 1998) (enjoining the defendant's use of the movie title "Dairy Queens" despite First Amendment concerns because "alternative avenues for expressing the idea exist").

263. *Kravitz*, *supra* note 3, at 145-46 ("[I]n trademark cases, . . . the law establishing the private right at issue impinges directly on speech—that is, the restrictions enforcing the private right are aimed directly at controlling the *communicative impact* of speech."); *Volokh*, *supra* note 198, at 702-12; see also *supra* note 198 (discussing Professor Volokh's position on this issue).

264. *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 971 (10th Cir. 1996).

265. 875 F.2d 994 (2d Cir. 1989).

266. *Rogers*, 875 F.2d at 996. The *Rogers* court expressly rejected application of *Lloyd's* "no alternative" standard after distinguishing "a restriction on the *location* of a speech . . . from

balancing test, the court must determine whether “the public interest in avoiding consumer confusion outweighs the public interest in free expression.”<sup>267</sup> In order to trump the interest in free speech, there must be a compelling showing of likelihood of confusion.<sup>268</sup> In this balancing test, the First Amendment prevails over the Lanham Act “unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.”<sup>269</sup> While this test may protect First Amendment interests in cases involving the use of trademarks in artistic works, it may not adequately protect all uses of trademarks to convey ideas.<sup>270</sup>

Although courts and commentators do not always evaluate the constitutionality of trademark laws in a consistent manner, one thing is certain: First Amendment interests in trademark cases cannot be ignored.<sup>271</sup>

Regardless of whether a mark is used to propose a commercial transaction or to communicate ideas, restrictions on trademark use are subject to at least intermediate constitutional scrutiny because trademark laws abridge the right of free expression.

---

a restriction on the *words* the speaker may use.” *Id.* at 999 (finding that “the ‘no alternative avenues [of communication]’ test does not sufficiently accommodate the public’s interest in free expression” in actions based on the title of an artistic work); *see also Cardtoons*, 95 F.3d at 971 (“[I]n the context of intellectual property, *Lloyd’s* ‘no adequate alternative avenues’ test does not sufficiently accommodate the public’s interest in free expression.”). Accordingly, “the *Rogers* balancing approach is generally applicable to Lanham Act claims against works of artistic expression . . .” *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Group, Inc.*, 886 F.2d 490, 495 (2d Cir. 1989); *see, e.g., Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002) (agreeing with the Second Circuit’s analysis in *Rogers* and applying the *Rogers* balancing test in a trademark action to enjoin a rock band’s use of the name “Barbie” in its song lyrics and title); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 671-73 (5th Cir. 2000) (refusing to accept the trial court’s injunction, which was based on the availability of “alternative avenues,” because the publisher’s use of “Polo” as a title for its magazine was artistic speech entitled to more First Amendment protection) (citing *Rogers*, 875 F.2d at 998).

267. *Rogers*, 875 F.2d at 999.

268. *Westchester Media*, 214 F.3d at 664, 667-68.

269. *Rogers*, 875 F.2d at 999.

270. *See Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769, 776 (8th Cir. 1994) (holding that the public interest in protecting the defendant’s parody was outweighed by “the public interest in avoiding consumer confusion” when defendant used the phrase “Michelob Oily” in a magazine to convey a message about water pollution).

271. *See Lemley, supra* note 2, at 1715 (“[T]he First Amendment stands (or should stand) as a bulwark against the increasingly common effort to use trademark law to suppress speech.”).

V. TRADEMARK LAWS THAT GRANT AND ENFORCE EXCLUSIVE RIGHTS  
IN DESCRIPTIVE TERMS VIOLATE THE FIRST AMENDMENT RIGHT  
OF FREE EXPRESSION

The government uses trademark law to grant and enforce exclusive rights in marks that are inherently distinctive or that have acquired distinctiveness.<sup>272</sup> When Congress enacted the Lanham Act, which “significantly changed and liberalized the common law” by allowing the registration and substantive protection of descriptive marks that have “become distinctive,”<sup>273</sup> commercial speech was not yet considered to be within the protection of the First Amendment. Today, the First Amendment shelters commercial expression from governmental regulations that do not satisfy the *Central Hudson* test.<sup>274</sup> Trademarks are a form of commercial speech when they are used to advertise and sell a product.<sup>275</sup> For this reason, laws regulating the use of trademarks are at least subject to an intermediate level of constitutional scrutiny under the *Central Hudson* test.<sup>276</sup>

Descriptive terms used as marks are commercial speech for two different reasons. First, descriptive marks, by definition, describe the attributes of the product for sale under that mark. By conveying information about the qualities, characteristics, or geographic origin of a product, descriptive marks may encourage a member of the public to purchase that product. In this way, descriptive marks serve as mini-advertisements for the product and constitute commercial speech. Second, once a descriptive term becomes a distinctive mark, that mark also disseminates information as to who is producing or selling that product. The source-identifying information conveyed by a distinctive mark is also commercial speech. As the use of a descriptive term to describe a product for sale or to identify the source of that product constitutes commercial speech, both uses of descriptive marks are entitled to First Amendment protection.

When the government grants and enforces exclusive rights in descriptive marks that have become distinctive, it simultaneously prohibits the use of identical or confusingly similar descriptive terms as marks in other brand names, product packaging, advertisements, and domain names. For this reason, governmental restrictions on the use of trademarked descriptive terms are subject to constitutional scrutiny under *Central Hudson*.

---

272. See *supra* Part II.

273. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 171 (1995).

274. See *supra* Part III.

275. See *supra* Part IV.

276. See *supra* Part IV.

*A. Analysis of the Constitutionality of  
Descriptive Trademark Laws Under Central Hudson*

Where commercial speech concerns lawful activity and is not misleading, regulation of such speech is not constitutionally permissible under *Central Hudson* if the governmental interest is not substantial, if the regulation does not directly advance the asserted governmental interest in a material way, or if the regulation is more extensive than necessary to serve that interest.<sup>277</sup> As this Article explains below, use of a descriptive term as a mark concerns lawful activity and is not misleading as long as the product described is legal and the description of that product is accurate. Thus, the government must establish that trademark restrictions on the use of descriptive marks satisfy the last three factors of the *Central Hudson* test.

Although the government has a substantial interest in protecting the ability of consumers to identify and distinguish among the products of competing manufacturers,<sup>278</sup> trademark laws restricting the use of descriptive marks fail the third and fourth factors of the *Central Hudson* test. The third factor of this test—whether the regulation directly and materially advances the asserted governmental interest—is not met because of one critical difference between descriptive and inherently distinctive marks. Unlike fanciful, arbitrary, or suggestive terms, descriptive terms used as marks do not immediately signal a brand of a product because they do not lose their original or “primary” descriptive meaning when used as a mark. For this reason, trademark laws granting and enforcing exclusive rights in descriptive marks do not directly or materially aid consumers in identifying or distinguishing among the products of competing sources.<sup>279</sup>

Descriptive trademark laws are also unconstitutional because the fourth *Central Hudson* factor—whether the regulation is no more extensive than necessary—is not satisfied.<sup>280</sup> When the government restricts the use of a trademarked descriptive term, this harms expression because competitors of the mark-holder cannot use that term as a mark to describe their own products in advertising, domain names, or product-packaging. Current trademark laws stifle the free flow of information when they grant exclusive rights in descriptive words relevant to a particular industry. This harm to speech is unnecessary because the government can further the goals of trademark by only protecting inherently distinctive marks and refusing to protect marks that directly and immediately convey information about the product.<sup>281</sup>

There are additional reasons, however, why current laws regulating the use of descriptive terms as marks suppresses more speech than necessary. Under

---

277. See *supra* note 208 and accompanying text.

278. See discussion *infra* Section V.A.2.

279. See discussion *infra* Section V.A.3.

280. See discussion *infra* Section V.A.4.

281. See discussion *infra* Subsection V.A.4.a.

the incontestability doctrine,<sup>282</sup> trademark law protects incontestable rights in some descriptive marks that are not actually distinctive. Also, the federal government allows the senior user of a descriptive mark to use trademark symbols with the mark to discourage others from using that mark even though it is not yet distinctive.<sup>283</sup> Finally, the fair use defense is limited and does not adequately protect all legitimate uses of descriptive terms by competitors.<sup>284</sup> For all of these reasons, which are discussed in detail below, descriptive trademark laws are unconstitutional because they fail First Amendment scrutiny under *Central Hudson*.

### 1. Descriptive Terms Used as Marks Concern a Lawful Activity and Are Not Misleading

The threshold factor of the *Central Hudson* test—whether the speech concerns lawful activity and is not misleading—is satisfied when descriptive terms are used as marks. A descriptive trademark concerns lawful activity as long as it is used to advertise and sell lawful products or services.<sup>285</sup> In addition, it is not misleading to use a descriptive term as a mark to truthfully describe something about a product, such as its qualities or characteristics (e.g., “roasted honey nut” for nuts roasted in honey).<sup>286</sup> Nor is it misleading to use laudatory descriptive terms (e.g., “ultimate,” “best,” or “reliable”) or geographically descriptive terms (e.g., “California” avocados) as part of a brand name or slogan. As long as the description is not inaccurate, it is not misleading.

As noted above, it is assumed that the unauthorized use of another’s distinctive mark is always misleading, and thus properly subject to governmental restrictions, if the court finds the defendant’s use of an identical or similar mark is likely to cause confusion.<sup>287</sup> For example, Professor Denicola has stated that “[t]he necessity of establishing that the challenged use

282. See discussion *infra* Subsection V.A.4.b.

283. See discussion *infra* Subsection V.A.4.c.

284. See discussion *infra* Subsection V.A.4.d.

285. See *Bad Frog Brewery, Inc. v. N.Y. State Liquor Auth.*, 134 F.3d 87, 98 (2d Cir. 1998) (noting that the defendant’s offensive beer label did not concern unlawful activity because the consumption of beer by adults is legal); *A & M Records, Inc. v. Heilman*, 142 Cal. Rptr. 390, 399 (Ct. App. 1977) (stating that an injunction forbidding the defendant from advertising the sale of phonographic records containing illegally pirated sound recordings did not trigger First Amendment concerns because the speech proposed an illegal transaction and, thus, did not involve a restriction on the “dissemination of truthful and legitimate commercial information”).

286. The Lanham Act prohibits registration and protection of marks that are “deceptively misdescriptive” of a product sold under the mark. 15 U.S.C. § 1052(e) (2000). Deceptively misdescriptive marks are, by definition, deceptive and misdescriptive and therefore fail the first factor of the *Central Hudson* test because they are misleading.

287. See *supra* notes 237-44 and accompanying text.

generates a likelihood of confusion restricts judicial intervention to instances in which the mark is used to misrepresent the source or sponsorship of goods or services.”<sup>288</sup> While this point may be valid in cases involving inherently distinctive marks, it does not apply when a competitor is sued for using a descriptive mark in which another business has obtained trademark rights.

First, it is not misleading to accurately describe a product. A descriptive mark, such as “Park ’N Fly,” always provides information regarding the qualities or characteristics of the product or service, regardless of whether one business first used, and is currently using, that term as a mark or has registered the term as a trademark. When a competitor uses a trademarked descriptive term in a brand name, product packaging, advertisement, or domain name, that descriptive term describes the product; it does not immediately signal a brand of the product like an inherently distinctive mark, such as “Kodak.”

Even if a descriptive mark has acquired distinctiveness, the court cannot be certain whether the defendant is using the descriptive term simply to describe its wares or to misrepresent the source of its products.<sup>289</sup> A

288. Denicola, *supra* note 3, at 165. Because it is misleading to use a mark to misrepresent a source, scholars and courts believe the likelihood of confusion requirement in infringement actions “has effectively insulated traditional trademark doctrine from constitutional attack.” *Id.*; see also *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 970 (10th Cir. 1996) (describing trademark law’s likelihood of confusion requirement as a “built-in mechanism[] that serve[s] to avoid First Amendment concerns”); Kozinski, *supra* note 259, at 973 (“So long as trademark law limits itself to its traditional role of avoiding confusion in the marketplace, there’s little likelihood that free expression will be hindered.”); cf. Kravitz, *supra* note 3, at 138 (noting that “built-in buffers of trademark law [, such as the likelihood of confusion test,] generally prevent it from unconstitutionally invading first amendment protections” but cautioning that “enforcement under . . . expansive theories [of trademark doctrine] runs a much greater risk of impinging unacceptably on first amendment values”).

289. See *Park ’N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 214 (1985) (Stevens, J., dissenting) (“[I]t is reasonable to infer that the operators of parking lots in the vicinity of airports may make use of the words ‘park and fly’ simply because those words provide a ready description of their businesses, rather than because of any desire to exploit [the plaintiff’s] goodwill.”). In support of his contention that competitors may use the words to describe their business rather than to exploit another’s goodwill, Justice Stevens pointed to language from the 1983 PTO handbook:

Matter which merely describes the goods or services to which it is applied is prohibited from being registered on the Principal Register. First, to permit one person to appropriate exclusively a mark which is merely the ordinary language to describe the goods or services involved would obviously be detrimental to others who deal in the same goods or services by hindering their use of normal language in association with their goods or services. Second, there would be no assurance that a mark which merely describes would in fact be a mark indicating origin, since the purchasing public would be likely to recognize only the descriptive meaning of the matter as it would be to accord to it any significance as indicating a single source of origin of the goods or services.

*Id.* at 214 n.20 (Stevens, J., dissenting) (quoting PATENT & TRADEMARK OFFICE, U.S. DEP’T OF COMMERCE, TRADEMARK MANUAL OF EXAMINING PROCEDURE 144 (1st ed. 1983)).

competitor's use of "Kodak" as a mark misrepresents source and is misleading because the word signifies a brand name rather than a description. In contrast, Starbucks' use of its rival's registered "Ice Blended" mark<sup>290</sup> as part of its brand name "Frappuccino Ice Blended Beverage" for a specialty coffee drink is not misleading because the words inform the public that the beverage contains ingredients blended with ice. The Supreme Court was correct when it stated in 1924 that "[t]he use of a similar name by another to truthfully describe his own product does not constitute a legal or moral wrong, even if its effect be to cause the public to mistake the origin or ownership of the product."<sup>291</sup> Thus, the likelihood of confusion test does not restrict judicial intervention to instances in which the mark is used to misrepresent a product source or exploit another's goodwill when this test is applied in cases involving trademarked descriptive terms.

Second, circular reasoning underlies the argument that confusing use of a descriptive term as a mark is misleading and can therefore be restricted to protect consumers. By granting and enforcing exclusive rights in descriptive marks, the government helps to make those marks source-identifying, which leads to the possibility of consumer confusion in the first place.<sup>292</sup> Because descriptive terms are eligible for protection under current trademark law and directly convey information regarding a product's qualities or characteristics, the government encourages the selection and use of descriptive marks. Descriptive terms are probably selected as marks because merchants "wish to interject into the name of their goods some intimation of excellence, and are willing to incur the risk" of having to prove that these marks have acquired secondary meaning.<sup>293</sup> Moreover, by allowing companies to use trademark symbols (® and ™) with marks that are not currently distinctive,<sup>294</sup> the law provides mark-holders with the means to stake their claim in common words related to a particular industry.

The presence of trademark symbols with a descriptive mark and the threat of litigation will likely discourage risk-adverse competitors from using an

290. Reg. No. 1,920,010 (registered Sept. 19, 1995) (the mark "ICE BLENDED" for "coffee and chocolate shakes and mixes for making the same" is registered on the principal register by International Coffee & Tea, Inc.).

291. *William R. Warner & Co. v. Eli Lilly & Co.*, 265 U.S. 526, 529 (1924).

292. *See* Denicola, *supra* note 3, at 170 (noting the circularity of the argument and stating that the public will associate the use of a mark with "its owner only as long as the law maintains such an exclusive right").

293. *Franklin Knitting Mills, Inc. v. Fashionit Sweater Mills, Inc.*, 297 F. 247, 248 (1923); *see also* 2 MCCARTHY, *supra* note 24, § 11:23 ("Businesspeople wish a mark to suggest or describe something about the product. They want the mark to help sell and advertise the goods. From an advertising point of view, a descriptive mark is probably the best since it impresses some quality of the product in the consumer's mind."); *cf.* *Aloe Creme Labs., Inc. v. Milson, Inc.*, 423 F.2d 845, 848 (5th Cir. 1970) ("Apparently entrepreneurs can not resist the temptation to tie the name of their product to some disabling quality of description, geography, or vanity.")

294. *See* discussion *infra* Subsection V.A.4.c.

identical or similar descriptive term in an advertisement or domain name, or as part of their own brand name.<sup>295</sup> If competitors stop using, or never start using, this descriptive term as a mark, the mark-holder's use of the mark will become exclusive. Evidence of exclusive use is an important factor in the secondary meaning analysis<sup>296</sup> and may lead a court to find the plaintiff's mark has become source-identifying and protectable. As mark-holders can use trademark symbols to discourage competitive, but lawful, use of a descriptive term as a mark before the mark has become distinctive, it is not surprising that some descriptive marks eventually become distinctive and identify a particular source.

Even generic terms could eventually identify a single source if the government decided to grant exclusive rights in such terms and prohibit others from using them. For example, assume that Congress revised the Lanham Act to allow registration of generic words that have acquired distinctiveness and enforcement of trademark rights in generic marks. Internet service provider America Online (AOL) could obtain a registration on the principal register for the generic phrase "You Have Mail"<sup>297</sup> for an email notification service with proof of secondary meaning in the mark, and its rights in the mark could become incontestable in five years. If the courts enforced AOL's exclusive right to use the mark "You Have Mail" for an e-mail notification service, and enjoined competitors from using this generic phrase as a mark, eventually "You Have Mail" would identify only AOL's email notification service. The public's identification of "You Have Mail" only with AOL's services would be due at least in part to the government's protection of generic marks,<sup>298</sup> regardless of the capital or effort invested by AOL in its email services. As courts currently refuse to enforce trademark rights in generic words and phrases, such as "You Have Mail," competitors use these same generic terms and they do not serve to identify a single source in a particular industry.

If the government allows only one entity to use a generic or descriptive word as a mark in connection with the sale of a product, then of course that common word will identify a single source because no other source can use

295. See *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 277 (1964) ("The fear of damage awards . . . may be markedly more inhibiting than the fear of prosecution under a criminal statute."); cf. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 214 (2000) ("Competition is deterred . . . not merely by successful suit but by the plausible threat of successful suit . . .").

296. See *supra* text accompanying note 128.

297. In *America Online, Inc. v. AT & T Corp.*, 243 F.3d 812 (4th Cir. 2001), AOL claimed it had exclusive trademark rights in the phrase "You Have Mail" to inform AOL subscribers that they have an e-mail. Despite AOL's "survey evidence," which it claimed "indicates an association in the public's eye between 'You Have Mail' and AOL," *id.* at 822, the Fourth Circuit affirmed the district court's holding that "You Have Mail" was generic and not enforceable as a trademark regardless of any evidence of secondary meaning. *Id.* at 818-23.

298. Cf. *Kravitz, supra* note 3, at 168 n.181 ("If 'Olympic' has come to be identified solely with the USOC's Olympics, it is due at least in part to the protection afforded by trademark law and [section] 110 [of the Amateur Sports Act].").

that word as a mark. If a new entrant to the market later attempts to use that generic or descriptive term as a mark in its brand name, product packaging, advertisement, or domain name, it is foreseeable that consumers will be confused regarding the product source. Because any confusion caused by the use of a descriptive mark may be due to the government's current protection of exclusive rights in such marks, it is improper to conclude that the confusing use of another's trademarked descriptive term constitutes misleading speech incapable of First Amendment protection.

Because a descriptive mark concerns lawful activity if the product for sale is lawful and because the use of a descriptive term as a mark is not misleading if the description is accurate, descriptive marks are capable of protection under the First Amendment. As a result, governmental restrictions on the use of descriptive marks are subject to constitutional scrutiny under the remainder of the *Central Hudson* test.<sup>299</sup>

## 2. The Government Has a Substantial Interest in Protecting the Ability of Consumers to Identify and Distinguish Among the Products of Competing Sources

As noted in Part III, the government's interest in protecting the public from "commercial harms . . . [is] the typical reason why commercial speech can be subject to greater governmental regulation than noncommercial speech."<sup>300</sup> Moreover, the government "must demonstrate that the harms it recites are real."<sup>301</sup> The government should only be allowed to reduce the amount of descriptive words available for use in the marketplace if consumers receive a real benefit from such a restriction on speech. If there is no corresponding public benefit, the alleged governmental interest in protecting trademarks is not substantial.

There is a benefit to the public when the government protects the ability of consumers to identify and distinguish the products of a business and its competitors.<sup>302</sup> The Supreme Court has explained how trademarks effectively reduce consumer-search costs:

In principle, trademark law, by preventing others from copying a source-identifying mark, 'reduce[s] the customer's costs of shopping and making purchasing decisions,' for it quickly and easily assures a potential customer that *this* item—the item with this mark—is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past.<sup>303</sup>

---

299. See *supra* note 208 and accompanying text.

300. *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 426 (1993).

301. *Edenfield v. Fane*, 507 U.S. 761, 770-71 (1993).

302. This is one of the traditional objectives of the Lanham Act. See *supra* Subpart II.A.

303. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163-64 (1995) (quoting 1 MCCARTHY, *supra* note 24, § 2.01 (3d ed. 1994)); see also *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 123 S. Ct. 2041, 2045 (2003).

By enabling the public to associate a mark with a particular source, trademark law encourages businesses to manufacture products of high and uniform quality. As noted by the Seventh Circuit,

The consumer who knows at a glance whose brand he is being asked to buy knows whom to hold responsible if the brand disappoints and whose product to buy in the future if the brand pleases. This in turn gives producers an incentive to maintain high and uniform quality, since otherwise the investment in their trademark may be lost as customers turn away in disappointment from the brand.<sup>304</sup>

In addition, by protecting the ability of consumers to use marks as a means of identifying and distinguishing among competing product sources, trademark law also fosters competition. Because competitors cannot attract customers for their inferior products by selling them under the mark of a successful producer, they must instead build and maintain a loyal customer base by manufacturing, selling, and advertising desirable products under a different mark. Therefore, the government has a substantial interest in protecting the public's ability to identify and distinguish among the products of competing producers.

By prohibiting competitors from copying a source-identifying mark, trademark law not only reduces consumer-search costs, but it also protects a mark-holder's goodwill symbolized by its mark from misappropriation.<sup>305</sup> Trademark law "helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product."<sup>306</sup> Although trademark law does benefit mark-holders, the question here is whether the government has an *independent* substantial government interest in protecting a limited property right in a trademark when that mark acquires value due to an investment of time, money, and energy in advertising and selling a quality product under that mark. Some courts, scholars, and commentators disapprove of protecting property rights in trademarks without regard to consumer interests.<sup>307</sup> A detailed analysis of the

304. Ty Inc. v. Perryman, 306 F.3d 509, 510 (7th Cir. 2002).

305. This is the other traditional objective of the Lanham Act. See *supra* Subpart II.A.

306. *Dastar*, 123 S. Ct. at 2048 (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163-64 (1995)).

307. See, e.g., *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev.*, 170 F.3d 449, 459 (4th Cir. 1999) (rejecting the theory that trademark laws "create property rights in gross . . . even in 'famous' trademarks"); *Int'l Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 918 (9th Cir. 1980) (rejecting the view "that a trademark's owner has a complete monopoly over its [commercial] use," and noting instead that the "scope [of the Lanham Act] is much narrower: to protect consumers against deceptive designations of the origin of goods and, conversely, to enable producers to differentiate their products from those of others"); *id.* at 919 ("A trademark owner has a property right only insofar as is necessary to prevent consumer confusion as to who produced the goods and to facilitate differentiation of the trademark owner's goods."); *Ky. Fried Chicken Corp. v. Diversified*

trademarks-as-property debate is beyond the scope of this Article. For descriptive trademarks, however, the government cannot establish a substantial interest in protecting a property right in a descriptive term used as a mark.<sup>308</sup> The alleged “owner” of a descriptive mark can never prove that its mark is commercially valuable solely because of its own efforts rather than because of any informational value inherent in the descriptive term.

A word or phrase has value as a trademark once it becomes “source-identifying” due to an investment of time, money, and energy in advertising and selling a desirable product under that mark.<sup>309</sup> But a term is also valuable as a mark if it is “attribute-identifying”—if the mark contains words that communicate the attributes of the product to the consumer.

When a business selects an arbitrary mark for its new product, that mark is immediately distinctive, but it does not become *valuable* until consumers link the mark with a particular source of a desirable product after advertising

---

Packaging Corp., 549 F.2d 368, 388-89 (5th Cir. 1977) (noting that previous cases “insist[] upon likelihood of confusion, and . . . reject any notion that a trademark is an owner’s ‘property’ to be protected irrespective of its role in the operation of our markets”); Gray, *supra* note 3, at 225 & n.91 (stating that there is no legitimate or substantial governmental interest in protecting a property right in a trademark); *see also* Lemley, *supra* note 2, at 1710-14 (criticizing propertization of trademark laws); Lunney, *supra* note 1, at 371-73 (explaining that a property-based protection scheme is “presumptively anticompetitive” and leads to “inappropriate market power”); Kenneth L. Port, *The Illegitimacy of Trademark Incontestability*, 26 IND. L. REV. 519, 552-68 (1993) (discussing the reasons why trademarks should not be treated as property); *cf.* *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 157 (1989) (“The law of unfair competition . . . is [concerned] with protecting *consumers* from confusion as to source. While that concern may result in the creation of ‘quasi-property rights’ in communicative symbols, the focus is on the protection of consumers, not the protection of producers as an incentive to product innovation.”).

308. For a discussion of why protection of property rights in descriptive marks cannot be justified under an economic or first possession theory of property, see Suman Naresh, *Incontestability and Rights in Descriptive Trademarks*, 53 U. CHI. L. REV. 953, 986-90 (1986).

309. *See* *S.F. Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522, 532 (1987) (“[W]hen a word acquires value ‘as the result of organization and the expenditure of labor, skill, and money’ by an entity, that entity constitutionally may obtain a limited property right in the word.” (quoting *Int’l News Serv. v. Associated Press*, 248 U.S. 215, 239 (1918))). In *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203 (1942), the Supreme Court explained,

The protection of trade-marks is the law's recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them. . . . The owner of a mark exploits this human propensity by making every effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol. Whatever the means employed, the aim is the same—to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears. Once this is attained, the trade-mark owner has something of value.

*Id.* at 205, *quoted in* *Blockbuster Videos, Inc. v. City of Tempe*, 141 F.3d 1295, 1300 (9th Cir. 1998).

and sales of the product under that mark. Once the mark becomes source-identifying, consumers can use that mark to identify that same product and distinguish it from other products sold by competing producers. In contrast, when a descriptive term is first used as a mark, that mark is not yet distinctive, but it is valuable instantly—before any advertising or sales—because the term is attribute-identifying and provides information about the qualities and characteristics of the product.<sup>310</sup> A business that selects and uses a descriptive term as a mark on its product is, in effect, free-riding off the attribute-identifying value of the descriptive term. The government should not protect exclusive rights in a trademark when some or all of the value of that mark is due to the ordinary meaning of the words that make up the mark.

The difference between source-identifying and attribute-identifying value of a mark can be demonstrated by an example involving two fruit businesses that just entered the apple market. Assume that one business decided to use the mark “Alligator,” an arbitrary mark, as its brand of apples, and the second selected the brand “Tasty Crisp,” a descriptive mark. From the beginning, the second business has an advantage because the mark “Tasty Crisp” provides valuable information to consumers regarding the quality of the apples—the name itself helps to advertise and sell the product because it informs consumers that the apples are tasty and crisp. In contrast, the “Alligator” mark will mean nothing to consumers until the business first invests time, money, and energy in advertising and selling its own apples under that mark. Eventually, this investment will generate goodwill symbolized by the “Alligator” mark. Satisfied customers will learn that the word “alligator,” when used on apples, is not a swamp creature, but a single business that sells apples they like.

Although the business with the “Tasty Crisp” mark may also invest time, money, and energy in advertising and selling its own apples under the “Tasty Crisp” mark,<sup>311</sup> part or all of the total value of the mark derives from the fact

---

310. See Naresh, *supra* note 308, at 962 (“A mark’s capacity to convey direct information can be realized quickly and cheaply, simply by exploiting its natural meaning; its capacity to convey information indirectly, on the other hand, cannot be realized until the seller invests time and resources in achieving buyer recognition.”). Professor Naresh explains that “[a] trademark conveys information directly by virtue of its natural meaning or descriptiveness, and indirectly by enabling buyers to link the labeled goods with a stock of information associated with the mark as a result of how it has been used.” *Id.* at 959.

311. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 10 (2d Cir. 1976) (noting that by allowing for the registration of merely descriptive marks that have become distinctive, the Lanham Act recognizes the interest of an “owner who, having invested money and energy to endow a word with the good will adhering to his enterprise, would be deprived of the fruits of his efforts”); see also *TCPIP Holding Co. v. Haar Communications Inc.*, 244 F.3d 88, 94 (2d Cir. 2001) (noting the “minimum” protection given to descriptive marks under the Lanham Act “due to equitable concerns about the unfairness of depriving those who have invested in a mark of the goodwill they have thereby developed and depriving the public of the ability to rely on a mark it has come to recognize as an emblem of quality”).

the mark is, and will always remain, attribute-identifying. Moreover, if a third apple seller later enters the market and uses the descriptive phrase “Tasty Crisp” as part of a brand name (“Snake’s Tasty Crisp” apples), as part of its advertising slogan (“Tasty Crisp Apples For You!”), or in the domain name address for its website (tastycrispapples.com),<sup>312</sup> it is not clear whether this competitor is simply describing the attributes of its own product or free-riding off the goodwill created by the senior user of the “Tasty Crisp” mark. On the other hand, if the new competitor uses the arbitrary term “Alligator” as a mark for its apples, the competitor is probably trying to benefit unfairly from the senior user’s goodwill symbolized by its source-identifying mark. Any current or new apple business should be able to use a descriptive term relevant to its product, including “tasty” and “crisp,” in any way, including as part of a brand name, advertising slogan, or domain name address, regardless of whether another apple business used that attribute-identifying term first or created a secondary meaning in that term. A business should not obtain a property right in descriptive words relating to a particular industry, such as the words “tasty” or “crisp” in the apple business, where that business did not create all of the commercial value in those words.

In sum, there is no public benefit, and thus no substantial governmental interest, in encouraging companies to select and use descriptive trademarks or in enforcing property rights in such marks. As a result, the only substantial governmental interest relevant in the remainder of this *Central Hudson* analysis is protecting consumers’ ability to identify and distinguish among the products of competing manufacturers.

### 3. Granting and Protecting Exclusive Rights in Descriptive Marks Does Not Directly and Materially Advance the Asserted Governmental Interest

The only significant governmental interest identified above—protecting the ability of consumers to identify and distinguish among the products of competing sources—is not directly and materially advanced by granting and enforcing exclusive rights in descriptive marks. Under *Central Hudson* and its progeny, the government must establish that the restriction on speech directly alleviates the harm at issue to a material degree and does not simply provide ineffective or remote support for the asserted governmental interests.<sup>313</sup> The government cannot satisfy this third *Central Hudson* factor because of the differences between inherently distinctive and descriptive marks.

According to the Supreme Court, a term properly functions as a trademark if “the primary significance of the term in the minds of the consuming public

---

312. The fair use defense may not apply to such uses of “Tasty Crisp” because use of a mark in a brand name, as an attention-getting symbol, or in a domain name is considered to be use of the term “as a mark.” See *infra* Subsection V.A.4.d.

313. See *supra* notes 220-22 and accompanying text.

is not the product but the producer.”<sup>314</sup> For example, the primary significance of the words “kodak” in “Kodak” film, “apple” in “Apple” computers, and “tide” in “Tide” laundry detergent, when used as marks with those products, is the brand of the product.<sup>315</sup> Although “apple” and “tide” are common words that already exist in the English language, they do not describe the goods for sale.<sup>316</sup> These words now primarily function to identify source when they are used in connection with the advertising and sale of computers and laundry detergent, respectively, because consumers disregard the underlying meaning of the words “apple” and “tide.”

Unlike an arbitrary or suggestive term, a descriptive term never loses its original meaning when it is used as a trademark. A descriptive brand name directly and immediately informs consumers of the qualities or characteristics of the product. This unique quality of descriptive marks diminishes their ability to function as an identifier of source.<sup>317</sup> If a product with a descriptive name becomes popular, consumers may associate that descriptive term with a single manufacturer of the product. Once there is proof of an association between a descriptive term and a single source, that term has acquired secondary meaning and becomes legally protectable.<sup>318</sup> But secondary meaning in a descriptive term does not replace the original descriptive meaning of that term, nor does it mean that consumers forget the descriptive meaning of the word when they use it as a mark.<sup>319</sup> Rather, a descriptive mark

314. *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 118 (1938); *cf. In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1347 (Fed. Cir. 2001) (“To establish secondary meaning or ‘acquired distinctiveness,’ an applicant must show that ‘in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.’” (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.* 456 U.S. 844, 851 n.11 (1982))).

315. *See Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 212-13 (2000) (“Consumers are . . . predisposed to regard [inherently distinctive marks] as indication of the producer” because these symbols “‘immediately . . . signal a brand or a product ‘source.’” (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162-63 (1995))).

316. While a suggestive mark does suggest the qualities or characteristics of the product, it does not provide direct and immediate information about a product’s attributes—consumers must use imagination, thought, or perception to determine the type of product sold under that mark. *See supra* notes 62-63 and accompanying text.

317. *See Naresh, supra* note 308, at 961 (“The greater a mark’s natural descriptiveness, the less likely it is that buyers will be able to associate it with only a small range of products coming from a single source . . .”).

318. *Transgo, Inc. v. Ajac Transmission Parts Corp.*, 768 F.2d 1001, 1015 (9th Cir. 1985) (“Secondary meaning is achieved by an association between a name and a source. When this mental recognition occurs among purchasers, the name becomes legally protectable as an identification symbol.”); *Carter-Wallace, Inc. v. Procter & Gamble Co.*, 434 F.2d 794, 802 (9th Cir. 1970) (“Secondary meaning has been defined as *association*, nothing more. . . . [T]he chief inquiry is directed towards the consumer’s attitude about the mark in question: does it denote to him ‘a single thing coming from a single source?’” (citation omitted) (quoting *Aloe Creme Labs., Inc. v. Milsan, Inc.*, 423 F.2d 845, 849 (5th Cir. 1970))).

319. *But cf. WILLIAM M. LANDES & RICHARD A. POSNER, THE ECONOMIC STRUCTURE OF*

with secondary meaning signifies *both* a description of the product *and* a single source of the product.<sup>320</sup>

A descriptive term may primarily identify one business in a particular industry due to extensive advertising and product sales under that mark, but the brand name still provides consumers with information about the product's attributes. The mark "All Bran" may come to mean a particular brand of all-bran cereal, but the term still informs the consuming public that the product for sale is an all-bran cereal. Most people may recognize that Fox News is the only news organization to use the phrase "Fair & Balanced" as a trademark, but the slogan "Fair & Balanced" used by any news organization also communicates that the news broadcast will be fair and balanced. In contrast, "Apple" used as a mark to sell a computer does not signify a single computer manufacturer *and* describe the qualities of the computer; the fruit and its qualities—the color, taste, and crispness of the fruit—do not provide any information about the computer. The arbitrary word "Apple" on a computer only signifies a brand, whereas the descriptive words "All-Bran" or "Fair & Balanced" could be a brand *or* a description when used to sell cereal or news services.

As descriptive marks retain their original descriptive meaning regardless of the existence of secondary meaning, they do not help consumers identify and distinguish the products of competing sources as well as fanciful, arbitrary, and suggestive marks. Moreover, many descriptive terms, including those registered on the supplemental register, are not currently distinctive but

---

INTELLECTUAL PROPERTY LAW 189 (2003) (stating that "the descriptive meaning of a word may be largely forgotten" once a descriptive brand name identifies a single producer). Professor Landes and Judge Posner also state that "normal language drift [may] cause[] substitution of another term to describe the product as a whole" if the descriptive term comes to signify the most popular brand. *Id.* If this is true, it is due at least in part to current government protection of trademark rights in descriptive terms. If the government did not allow registration and enforcement of exclusive rights in descriptive terms, this "language drift" would not occur because competitors would not be forced to use other words to inform customers of the attributes of their brands.

320. Courts do not claim that the secondary meaning in a descriptive mark replaces the original descriptive meaning of the term; instead, courts find secondary meaning adds to that original meaning such that consumers associate words in a descriptive mark with both a description of the product *and* the source of the product. *E.g.*, *Checkpoint Sys., Inc. v. Check Point Software Techs., Inc.*, 269 F.3d 270, 283 n.10 (3d Cir. 2001) ("A mark is descriptive with a secondary meaning when the mark 'is interpreted by the consuming public to be not only an identification of the product [or] services, but also a representation of the origin of those products or services.'" (quoting *Commerce Nat'l Ins. Servs., Inc. v. Commerce Ins. Agency, Inc.*, 214 F.3d 432, 438 (3d Cir. 2000))); *Gruner + Jahr USA Publ'g v. Meredith Corp.*, 991 F.2d 1072, 1076 (2d Cir. 1993) ("[A] descriptive mark [gains protection] only upon its acquiring secondary meaning . . . because a descriptive mark by definition simply describes a product . . . . But upon proof of secondary meaning, a product with a descriptive mark then has become identified—as well as being described—as originating from a single source.").

are still claimed as trademarks. As protection of exclusive rights in descriptive marks provides only ineffective or remote support for the asserted governmental interest and does not directly further this interest in a material way, it is unconstitutional for the government to grant and enforce rights in descriptive marks.

#### 4. Trademark Laws Enforcing Rights in Descriptive Terms are More Extensive Than Necessary to Serve the Asserted Governmental Interest

Current trademark law is also unconstitutional under the fourth *Central Hudson* factor because it is more extensive than necessary to serve the asserted government interest. The law harms speech more than necessary because it (a) grants and enforces exclusive rights in terms that provide descriptive information about the product for sale, (b) allows the registrant of a descriptive mark to obtain incontestable trademark rights, (c) permits the use of trademark symbols (® or ™) with non-distinctive marks, and (d) has a limited fair use defense.

##### a. The Government Suppresses More Speech Than Necessary When It Protects Rights in Marks That Inherently Convey Product Information

The government can restrict less speech, yet still further the asserted governmental interest, by limiting its trademark protection to inherently distinctive marks. Restrictions on the infringing use of another's inherently distinctive mark do not harm speech more than necessary because inherently distinctive marks do not convey direct and immediate information regarding a product. There is no significant First Amendment injury when competitors of Kodak, such as Fuji, are prohibited from using the word "Kodak" as a mark. There is an unnecessary restriction on expression, however, when courts enforce exclusive trademark rights in descriptive terms, such as "Park 'N Fly" or "Fair & Balanced," because competitors cannot use relevant terms that describe their products as part of a brand name, slogan, or domain name.<sup>321</sup> A competitor cannot call itself "Dollar Park and Fly" or use the slogan "CNN is Fair and Balanced News," even though these words describe the services for sale. As descriptive terms convey information regarding a product just like generic terms, the government should refuse to restrict their use for the same reasons it refuses to protect trademark rights in generic terms.

Courts agree that granting one business the sole right to use a generic term as a trademark will harm competition and suppress free expression in the marketplace. As the Seventh Circuit has noted: "To allow a firm to use as a

---

321. Even when a competitor is using a descriptive term in its "primary descriptive" sense, courts have held that use of a descriptive term as part of an attention-getting slogan or domain name is use of the descriptive term "as a mark" that does not qualify for the fair use defense. See *infra* Subsection V.A.4.d.

trademark a generic word . . . would make it difficult for competitors to market their own brands of the same product.”<sup>322</sup> Similarly, the Fourth Circuit has said that while trademark law “protect[s] the goodwill represented by marks,” it also “protects for the public use those commonly used words and phrases that the public has adopted, denying to any one competitor a right to corner those words and phrases by expropriating them from the public ‘linguistic commons.’”<sup>323</sup> Although some generic terms can achieve secondary meaning through extensive advertising and sales under a generic brand name,<sup>324</sup> proof of acquired distinctiveness does not justify depriving “competing manufacturers of the product of the right to call an article by its name.”<sup>325</sup> According to the Third Circuit, “Generic terms are denied trademark protection because granting one firm their exclusive use would place competitors at a serious disadvantage.”<sup>326</sup>

Scholars also believe there are problems with protecting trademark rights in generic terms. Professors Folsom and Teply have explained that granting exclusive rights in a generic word would prevent a competitor from “inform[ing] consumers effectively that a product is within the same product-category as [a] trademarked generic” product and may cause consumers to question whether the competitor’s product is actually a substitute.<sup>327</sup> According to Professor McCarthy, “To grant an exclusive right to one firm of use of the generic name of a product would be equivalent to creating a monopoly in that particular product, something that the trademark laws were never intended to accomplish.”<sup>328</sup> Moreover, Professor Port has said,

---

322. *Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc.*, 781 F.2d 604, 609 (7th Cir. 1986).

323. *Am. Online, Inc. v. AT&T Corp.*, 243 F.3d 812, 821 (4th Cir. 2001) (noting the “line-drawing problems” created by the two goals of trademark law and holding “as a matter of law that AOL’s usage of [‘You Have Mail’] falls within the heartland of common meaning and usage and therefore that AOL may not exclude others from using the same words in connection with their e-mail service”). The Fourth Circuit has also concluded that “[t]he public has an inherent right to call a product or service by its generic name.” *U.S. Search, LLC v. US Search.com Inc.*, 300 F.3d 517, 523 (4th Cir. 2002).

324. *See, e.g., Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 118 (1938) (noting that the public had come to associate the term “Shredded Wheat” with a single manufacturer, but refusing to attach any legal significance to this fact); *Am. Online, Inc. v. AT & T Corp.*, 64 F. Supp. 2d 549, 561 (E.D. Va. 1999) (“[E]ven if a producer or provider has achieved secondary meaning in its generic mark through promotion and advertising, the generic mark is still not entitled to protection because to allow protection would ‘deprive competing manufacturers of the product of the right to call an article by its name.’” (quoting *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976)), *vacated on other grounds*, 243 F.3d 812 (4th Cir. 2001).

325. *Abercrombie & Fitch Co.*, 537 F.2d at 9; *Am. Online*, 64 F. Supp. 2d at 561.

326. *Dranoff-Perlstein Assocs. v. Sklar*, 967 F.2d 852, 857 (3d Cir. 1992).

327. Ralph H. Folsom & Larry L. Teply, *Trademarked Generic Words*, 89 *YALE L.J.* 1323, 1340-46 (1980).

328. 2 MCCARTHY, *supra* note 24, § 12:2; *see also In re Dial-A-Mattress Operating Corp.*,

“Allowing a monopoly on the use of a commonly used [generic] term would be ludicrous. No individual should be able to appropriate existing terms in the language for their own commercial advantage when to do so would prevent competitors from using that term to describe their competing products.”<sup>329</sup>

The Ninth Circuit has admitted that descriptive terms “suffer from the same problem as generic terms [in that] they tend to consist of common words that might be the only way to describe a category of goods.”<sup>330</sup> If competitors have an inherent right to refer to a product by its generic name, it follows that they have the same right to use descriptive words to describe the attributes of their products.<sup>331</sup> In every industry, there are a limited number of words available to describe a product’s qualities, characteristics, or true geographical origin. Moreover, “[a] given product has only so many attributes that interest buyers.”<sup>332</sup> If the government grants one business the exclusive right to use, as a mark, a word that describes a positive attribute of a product, that business gains an unfair economic advantage. It is more expensive for competitors to inform consumers that their products possess that same attribute if they cannot use the descriptive word as a mark in a brand name, product packaging,

240 F.3d 1341, 1344 (Fed. Cir. 2001) (noting that generic terms cannot be registered because “doing so ‘would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are’” (quoting *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1569 (Fed. Cir. 1987))); *Abercrombie & Fitch Co.*, 537 F.2d at 10 (“[A]ny claim to an exclusive right [in a generic mark] must be denied since this in effect would confer a monopoly not only of the mark but of the product by rendering a competitor unable effectively to name what it was endeavoring to sell.”).

329. Kenneth L. Port, *Foreword: Symposium on Intellectual Property Law Theory*, 68 CHI.-KENT L. REV. 585, 597 (1993).

330. *Japan Telecom, Inc. v. Japan Telecom Am. Inc.*, 287 F.3d 866, 872 (9th Cir. 2002). In evaluating whether a mark is generic, “[t]he existence of synonyms for a term does not mean the term is not generic”; instead, courts determine “whether the term/phrase is generic under the primary significance test.” *Am. Online*, 64 F. Supp. 2d at 561, 563 (“[T]he court’s primary concern should not be the availability of alternative terms.”); *Blinded Veterans Ass’n v. Blinded Am. Veterans Found.*, 872 F.2d 1035, 1041 (D.C. Cir. 1989) (“A term need not be the sole designation of an article in order to be generic.”).

331. *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 543-44 (1920) (holding that companies “must be left free to use[] the same language of description in placing their goods before the public”); *In re Colonial Stores Inc.*, 394 F.2d 549, 551 (C.C.P.A. 1968) (“[F]or policy reasons, *descriptive words* must be left free for public use.”); *Charcoal Steak House of Charlotte, Inc. v. Staley*, 139 S.E.2d 185, 187 (N.C. 1964) (“[G]eneric, or generally descriptive words . . . are the common property and heritage of all who speak the English language; they are *publici juris*. If the words reasonably indicate and describe the business or the article to which they are applied, they may not be monopolized.”); *see also Telechron, Inc. v. Telicon Corp.*, 198 F.2d 903, 906 (3d Cir. 1952) (noting the “danger of depleting the general vocabulary available to all for description and denomination of articles of commerce”); *Warner Publ’n, Inc. v. Popular Publ’ns, Inc.*, 87 F.2d 913, 915 (2d Cir. 1937) (“The defendant has as good a right to a descriptive title as has the plaintiff.”).

332. LANDES & POSNER, *supra* note 319, at 189.

advertising, or domain name.<sup>333</sup> When competitors are unable to use a certain, favorable description of their product, they are at a “competitive disadvantage.”<sup>334</sup> Therefore, trademark laws restricting use of descriptive words “prevent effective competition in the market.”<sup>335</sup> Simply because the PTO or a court finds acquired distinctiveness or secondary meaning in a descriptive term does not lessen the need of market participants to use that descriptive term in a slogan or as part of a brand name to convey information regarding their products.

Not only does current trademark law put rivals of descriptive trademark holders at a competitive disadvantage, but granting exclusive rights in descriptive marks also impedes the free flow of information relevant to the purchasing decisions of consumers. “[O]ne can[not] forbid particular words without also running a substantial risk of suppressing ideas in the process.”<sup>336</sup> Where competitors are unable to fully communicate regarding all of the qualities or characteristics of their products, consumer knowledge is imperfect. A consumer cannot determine if certain products are substitutes, and therefore base a purchasing decision on price, if competitors are limited in the words they can use to describe their products.<sup>337</sup> There is no public benefit in allowing one business “to impoverish the language of commerce by [using trademark law to prevent] his fellows from fairly describing their own goods.”<sup>338</sup> Although a competitor can use a protected descriptive mark in a

333. As Professor Landes and Judge Posner have noted:

If one producer is allowed to appropriate the word that describes a key attribute, he will obtain rents measured by the higher price he receives for his branded product because he will have made it more costly for his rivals to inform their customers of the attributes of their brands without using the same descriptive word.

*Id.*

334. See *Abercrombie & Fitch Stores, Inc., v. Am. Eagle Outfitters, Inc.*, 280 F.3d 619, 643 (6th Cir. 2002). Abercrombie claimed trade dress rights in its clothing designs, which included the words “performance,” “authentic,” “genuine brand,” “trademark,” “since 1892,” “outdoor,” and “field jersey” on labels, and advertising and promotional material. *Id.* at 642 n.19. In concluding that these terms were not capable of protection as part of Abercrombie’s trade dress, the court stated:

Were the law to grant Abercrombie protection of these features, the paucity of comparable alternative features that competitors could use to compete in the market for casual clothing would leave competitors at a significant non-reputational competitive disadvantage and would, therefore, prevent effective competition in the market.

Giving Abercrombie a monopoly on the words it claims form part of its trade dress would hamstring any competitor’s ability to convey the reliability of its own brand. The English language currently contains a limited list of synonyms for reliable and other words that convey a product’s integrity.

*Id.* at 643.

335. *Id.*

336. *Cohen v. California*, 403 U.S. 15, 26 (1971).

337. Naresh, *supra* note 308, at 967.

338. *Bada Co. v. Montgomery Ward & Co.*, 426 F.2d 8, 11 (9th Cir. 1970).

sentence to describe its own goods under the fair use doctrine, it is often more effective to use a descriptive term as part of a brand name, in an attention-grabbing slogan, or in a domain name. Under current trademark law, the fair use defense would not apply to such uses of a descriptive term.<sup>339</sup>

Commercial expression is stifled when the government allows registration of descriptive terms on the federal principal register. Examples of descriptive terms currently registered on the principal register include “America’s Favorite Fries” for french fries,<sup>340</sup> “Guaranteed to Keep You Dry” for clothing,<sup>341</sup> and, as noted before, “Fair & Balanced” for news-reporting services.<sup>342</sup> In addition, Fry’s Electronics has registered the slogan “Home of Fast, Friendly, Courteous Service” for an electronics store,<sup>343</sup> and Chase Manhattan has registered “The Right Relationship is Everything” for banking and financial services on the principal register.<sup>344</sup> As a registrant is presumed to have the exclusive right to use a registered descriptive term to sell a certain product or service, competitors will likely refrain from using these descriptive terms to avoid a trademark infringement lawsuit. If a competitor uses one of its rival’s marks registered on the principal register because it believes the mark is generic or descriptive without secondary meaning, it may have to spend time and money defending a trademark action. For example, International Coffee & Tea, registrant of the mark “Ice Blended” on the principal register,<sup>345</sup> filed a trademark infringement action to stop Starbucks from using its trademarked phrase “Ice Blended” in the name of Starbucks’ specialty coffee drink “Frapuccino Ice Blended Beverage.”<sup>346</sup> Risk-adverse competitors may self-

339. See discussion *infra* Subsection V.A.4.d.

340. Reg. No. 2,360,994 (registered June 27, 2000) (the mark “AMERICA’S FAVORITE FRIES” for “French fried potatoes for consumption on and of [sic] the premises” is registered by McDonald’s Corp.).

341. Reg. No. 2,040,706 (registered Feb. 26, 1997) (the mark “GUARANTEED TO KEEP YOU DRY” for “clothing, namely, gloves and footwear” is registered by W.L. Gore & Associates, Inc. (Goretex)).

342. Reg. No. 2,213,427 (registered Dec. 22, 1998) (the mark “FAIR & BALANCED” for “entertainment services in the nature of production and distribution of television news programs” is registered by Fox News Network).

343. Reg. No. 1,870,136 (registered Dec. 27, 1994) (the mark “HOME OF FAST, FRIENDLY, COURTEOUS SERVICE” for “retail and wholesale stores featuring electronics” is registered by Fry’s Electronics, Inc.).

344. Reg. No. 2,203,139 (registered Nov. 10, 1998) (the mark “THE RIGHT RELATIONSHIP IS EVERYTHING” for “banking services and a full line of financial services” is registered by Chase Manhattan Corp.).

345. Reg. No. 1,920,010 (registered Sept. 19, 1995) (the mark “ICE BLENDED” for “coffee and chocolate shakes and mixes for making the same” is registered by International Coffee & Tea, Inc.).

346. On December 16, 2003, Judge Real of the U.S. District Court for the Central District of California dismissed this trademark infringement suit. *Suit Against Starbucks Dismissed*, L.A. TIMES, Dec. 17, 2003, at B2.

ensor their commercial expression rather than risk such a lawsuit.

In sum, allowing competitors to use descriptive terms without restriction would increase the amount of truthful information passed between producers and consumers, and would enable consumers to make well-informed decisions about whether to purchase a particular product from a particular producer. Trademark restrictions on the use of descriptive terms as marks harm speech more than necessary because companies can select and use inherently distinctive marks if they want exclusive rights in a word or phrase. By protecting rights in descriptive marks in addition to inherently distinctive marks, current trademark laws hinder the free flow of information and, thus, are more extensive than necessary.

#### b. The Incontestability Doctrine

Another problem with the trademark laws is that exclusive trademark rights in descriptive words can become incontestable, or immune from legal challenge on distinctiveness grounds.<sup>347</sup> Rights in a mark registered on the principal register can become incontestable if the registrant submits an affidavit alleging continuous use of the mark in commerce for at least five consecutive years after registering the mark on the principal register.<sup>348</sup> When rights in a descriptive mark become incontestable, a defendant cannot defend a trademark action on the ground that the plaintiff's mark is descriptive and lacks secondary meaning.<sup>349</sup> Thus, even if a court believes the plaintiff's descriptive mark is not distinctive, and was erroneously registered on the principal register, the court must find that the mark is valid and protectable.<sup>350</sup>

---

347. Because of the problems with protecting incontestable rights in descriptive marks, Alexandri "advocate[s] abolishing protection for descriptive marks altogether—regardless of whether they have or can show secondary meaning—in exchange for a limited outright property right in suggestive, fanciful, and arbitrary marks." Maya Alexandri, *The International News Quasi-Property Paradigm and Trademark Incontestability: A Call for Rewriting the Lanham Act*, 13 HARV. J.L. & TECH. 303, 310 (2000). On the other hand, Professor Port argues that incontestability should be abolished "primarily because it is a congressional attempt to grant property status to a trademark itself." Port, *supra* note 307, at 552. Finally, Professor Naresh believes, "Incontestability under the Lanham Act should . . . be circumscribed so that a seller's right to register, use, or exclude others from using a mark may always be challenged on the ground that the mark is not currently distinctive." Naresh, *supra* note 308, at 992.

348. 15 U.S.C. § 1065(3) (2000); *see* *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 191-92 (1985); *Gruner + Jahr USA Publ'g v. Meredith Corp.*, 991 F.2d 1072, 1076 (2d Cir. 1993). A registrant cannot obtain an incontestable right in a generic term. 15 U.S.C. § 1065(4).

349. *Park 'N Fly, Inc. v. Dollar Park & Fly*, 469 U.S. 189, 205 (1985).

350. *Id.*; *cf. Gruner + Jahr*, 991 F.2d at 1076-77 (concluding that incontestability made a registered descriptive trademark "strong for purposes of protectability" but "did not confer an exclusive right . . . on variations of the word 'parent,' such term being more generic than descriptive"). In *Park 'N Fly*, Justice Stevens dissented because he believed that rights in descriptive marks should not become incontestable. He explained,

While rights in a descriptive mark can only become incontestable if the mark has secondary meaning and is registered, the PTO occasionally errs and adds a mark to the principal register that is not distinctive.<sup>351</sup> According to Professor McCarthy, the PTO resolves doubt over whether a mark is distinctive “in favor of the applicant on the assumption that competitors have the opportunity to oppose the registration once published and to present evidence that is usually not present in *ex parte* examination.”<sup>352</sup> Moreover, when deciding whether to register a descriptive mark, the PTO can presume a descriptive mark is distinctive if the applicant provides the PTO with “proof of substantially exclusive and continuous use” of the descriptive term “as a mark” on the applicant’s goods “in commerce for the five years before the date on which the claim of distinctiveness is made.”<sup>353</sup> If no competitor opposes the trademark application, the applicant’s “self-serving and unconfirmed” affidavit<sup>354</sup> could be the only evidence before the PTO when it decides whether the descriptive term has become distinctive.

Although competitors have five years to challenge a registered descriptive mark before it can become incontestable, time and money are required to monitor trademark registrations and file opposition proceedings with the PTO. It is even more unlikely that general members of the public and possible future competitors will monitor PTO registrations to ensure that descriptive words remain available for use by everyone in a particular industry. If no one contests the registration during the five-year period, the registrant’s rights in that descriptive term could become incontestable. Once rights in the mark are incontestable, all current and future competitors of the registrant who use that

---

A mark must perform the function of distinguishing the producer or provider of a good or service in order to have any legitimate claim to protection. A merely descriptive mark that has not acquired secondary meaning does not perform that function because it simply “describes the qualities or characteristics of a good or service.” No legislative purpose is served by granting anyone a monopoly in the use of such a mark.

*Park 'N Fly*, 469 U.S. at 207 (Stevens, J., dissenting) (citation omitted) (quoting majority opinion at 194). The *Park 'N Fly* majority decision does not contain any analysis regarding the constitutionality of the Lanham Act’s incontestability provision under the First Amendment. *See id.* at 191 (“In this case we consider whether an action to enjoin the infringement of an incontestable trade or service mark may be defended on the grounds that the mark is merely descriptive. We conclude that neither the language of the relevant statutes nor the legislative history supports such a defense.”).

351. Alexandri, *supra* note 347, at 327 & n.94; *see, e.g., Park 'N Fly*, 469 U.S. at 207 (Stevens, J., dissenting).

352. 2 MCCARTHY, *supra* note 24, § 11:51 (noting the often “nebulous” line between descriptive and suggestive terms).

353. 15 U.S.C. § 1052(f) (2000).

354. Alexandri, *supra* note 347, at 305; *see also* Naresh, *supra* note 308, at 976 n.96 (“Note that there is no procedure for the PTO to verify the truth of the statements made in a[n] affidavit [submitted for purposes of incontestability], nor for its publication, nor for any opposition to it.”).

term as a mark will not be able to defend a trademark action based on the argument that the mark is descriptive and not distinctive. By allowing non-distinctive descriptive marks to become incontestable, trademark laws harm speech more than necessary.

c. The Use of Trademark Symbols (® and ™)

The trademark laws further chill protected commercial speech by providing businesses with the means—trademark symbols—to stake their claim in descriptive terms that are not yet distinctive. As noted above, the supplemental register contains descriptive marks that the PTO has determined are not distinctive, but which are nevertheless capable of becoming distinctive.<sup>355</sup> If a trademark is registered on the supplemental register, the registrant may use the trademark registration symbol (®) with its mark to discourage others from using that mark.<sup>356</sup> Accordingly, this symbol can be used with a mark even after the PTO has actually determined that a mark is *not yet distinctive*. A non-distinctive descriptive term is available for use as a mark by anyone. Examples of descriptive terms currently registered on the supplemental register that the Author has seen used in advertisements with a trademark registration symbol (®) include “We Don’t Make It ‘Til You Order It” for Jack in the Box’s fast-food restaurant services,<sup>357</sup> and “San Diego’s Business Lawyers” for Blanchard, Krasner & French’s legal services.<sup>358</sup>

Furthermore, although the trademark symbol (™) has no legal significance, federal trademark law allows a business to use this symbol after an unregistered descriptive mark to inform others that this term is being used as a mark.<sup>359</sup> For example, Round Table Pizza currently uses a trademark symbol (™) with the following descriptive words in advertisements for its specialty pizzas: “Italian Garlic Supreme,” “Chicken & Garlic Gourmet,” and “Gourmet Veggie.”<sup>360</sup> In its advertisements for automobiles, Hyundai is currently using the trademark symbol with the descriptive phrase “America’s

---

355. 15 U.S.C. § 1091(a), (c) (2000); *see supra* note 116 and accompanying text.

356. 15 U.S.C. § 1111; *see supra* note 118 and accompanying text.

357. Reg. No. 2,355,424 (registered June 6, 2000) (the mark “WE DON’T MAKE IT ‘TIL YOU ORDER IT” for “Restaurant services” is registered by Foodmaker, Inc. (Jack in the Box)).

358. Reg. No. 2,464,735 (registered June 26, 2001) (the mark “SAN DIEGO’S BUSINESS LAWYERS” for “Legal Services” is registered by San Diego firm Blanchard, Krasner & French, PC).

359. *See* 3 MCCARTHY, *supra* note 24, § 19:148 (providing general information regarding notice of trademark registration).

360. *See* Brochure from Round Table Pizza (on file with the Tennessee Law Review).

Best Warranty.”<sup>361</sup> Nothing in federal trademark law prevents a business from using this trademark symbol with a non-distinctive descriptive term.

The federal government should not allow use of the trademark registration symbol (®) or trademark symbol (™) with a descriptive term that is not distinctive because most people (except trademark lawyers or those who have consulted them) probably believe these symbols indicate protectable trademark rights in the descriptive term preceding the symbol. As a result, competitors will likely be deterred from using any descriptive term that is accompanied by either of the trademark symbols. By allowing mark-holders to use these symbols with non-distinctive descriptive terms, current trademark law harms speech more than necessary because it encourages self-censorship by competitors.

#### d. The Fair Use Defense

Another way the current trademark laws harm speech more than necessary is by providing only a limited fair use defense. As explained in Section II.C.1, use of a descriptive term is not a fair use unless the defendant can prove: (1) the defendant’s use of the trademarked term “is a use, otherwise than as a mark;” (2) the term is “used fairly and in good faith;” and (3) the use is “only to describe the goods or services of [the defendant], or their geographic origin.”<sup>362</sup> Courts have stated that “[t]he ‘fair-use’ defense, in essence, forbids a trademark registrant to appropriate a descriptive term for his exclusive use and so prevent others from accurately describing a characteristic of their goods.”<sup>363</sup> But this concise summary of fair use law omits one extremely important point: The fair use defense does not allow use of the descriptive term “as a mark,”<sup>364</sup> even if the term describes the defendant’s goods or services. Moreover, courts interpret the statutory phrase “use, otherwise than

---

361. Hyundai Motor America Corp. sought a registration on the principal register for “America’s Best Warranty” for “Providing extended warranty contracts for automobiles,” but the PTO has not yet registered this mark. See Ser. No. 76,442,521 (filed Aug. 22, 2002) (as of November 25, 2003, “no final determination as to the registrability of the mark has been made”).

362. 15 U.S.C. § 1115(b)(4); see also 2 MCCARTHY, *supra* note 24, § 11:49.

363. *Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 1185 (5th Cir. 1980), *quoted in* *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 306 (9th Cir. 1992).

364. 15 U.S.C. § 1115(b)(4); 2 MCCARTHY, *supra* note 24, § 11:45 (“A junior user is always entitled to use a descriptive term in good faith in its primary, descriptive sense other than as a trademark.”); see also *United States Shoe Corp. v. Brown Group, Inc.*, 740 F. Supp. 196, 198 (S.D.N.Y. 1990) (“When the plaintiff chooses a mark with descriptive qualities, the fair use doctrine recognizes that ‘he cannot altogether exclude some kinds of competing uses,’ particularly those which use words in their primary descriptive and non-trademark sense.” (quoting *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 12 (2d Cir. 1976))), *aff’d*, 923 F.2d 844 (2d Cir. 1990).

as a mark”<sup>365</sup> narrowly.<sup>366</sup> For example, courts have held that the use of a descriptive term in an Internet domain name<sup>367</sup> or as an “attention-getting symbol”<sup>368</sup> is not considered a fair use because it constitutes use of the term “as a mark.”

While a defendant’s use of a descriptive term in a sentence is ordinarily considered a fair use,<sup>369</sup> it is not entirely clear when other uses of a descriptive term will qualify for the fair use defense. Relevant factors for determining whether a use is a trademark or descriptive use include the size, style, location, and prominence of the descriptive term in comparison to the defendant’s use of its own trademark or other descriptive matter in advertising or product packaging.<sup>370</sup> However, Professor McCarthy correctly notes that “emphasis of a descriptive term on a label, packaging or advertising does not necessarily mean that the term is being used in a trademark sense.”<sup>371</sup> Although companies prominently display the word “sale” in advertising to attract customers, often in a larger font size than their own brand name, they are not using this word in a trademark sense. Just because a word or phrase is memorable or attention-grabbing, or is part of a brand name or domain name

365. 15 U.S.C. § 1115(b)(4).

366. See Alexandri, *supra* note 347, at 367 (“[F]air use rights are not given a particularly broad scope now.”).

367. TCPIP Holding Co. v. Haar Communications, Inc., 244 F.3d 88, 104 (2d Cir. 2001) (holding that the defendant’s website domain name address (thechildrensplace.com) was “not simply an adjectival use,” and thus not a fair use, because it was used “as a mark”); see 2 MCCARTHY, *supra* note 24, § 11:46.

368. Sands, Taylor & Wood Co. v. Quaker Oats Co., 978 F.2d 947, 954 (7th Cir. 1992) (rejecting the defendant’s fair use argument after concluding that the defendant’s use of the trademarked phrase “Thirst Aid” in an advertising slogan for its Gatorade product was “as a trademark” because the phrase was not used “in a sentence describing Gatorade” and instead appeared “prominently” as part of a “memorable slogan”); see 2 MCCARTHY, *supra* note 24, § 11:46; cf. Packman v. Chi. Tribune Co., 267 F.3d 628, 639-41 (7th Cir. 2001) (holding that the defendant’s use of the trademarked phrase “the joy of six” to publicize the Chicago Bulls’ sixth NBA championship was a “non-trademark” use rather than an “attention-getting symbol” because its “wide and varied” use negated any unique association to the defendant and because it was not used “as part of a ‘memorable slogan’”).

369. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 28 cmt. c (1995) (“Use of a descriptive term in textual commentary or instructions, for example, may be unlikely as a practical matter to create a likelihood of confusion, but in any event it is ordinarily a fair use. More prominent use of a descriptive term can also qualify as a fair use.”).

370. *Id.* (stating that “the presence of the defendant’s own trademark in conjunction with the descriptive term” and the “physical nature of the use in terms of size, location, and other characteristics in comparison with the appearance of other descriptive matter or other trademarks [are] also relevant to the fairness of the use.”); see also 2 MCCARTHY, *supra* note 24, § 11:46 (“Other evidentiary factors relevant to whether defendant’s use is as a trademark are the lettering, type style, size and visual placement and prominence of the challenged words.”).

371. 2 MCCARTHY, *supra* note 24, § 11:46.

rather than a sentence, does not mean that the defendant is using the descriptive term to identify the senior user as the source of those goods. The public understands that descriptive terms are often used in their ordinary and primary descriptive sense as part of a brand name or in an advertisement, even if another business has trademark rights in that word.

With such a limited and uncertain fair use defense, competitors will likely self-censor their commercial expression rather than risk the cost and inconvenience of having to defend a trademark infringement action. Thus, the trademark laws harm speech more than necessary when all descriptive uses of descriptive terms do not qualify for the fair use defense.

*B. Descriptive Terms Should be Eliminated from Protection as Trademarks*

The First Amendment does not allow the government to grant and enforce exclusive rights in descriptive marks because they inherently convey information regarding the attributes of a product. Every business should have the right to use terms that describe the attributes of a product.<sup>372</sup> Federal and state governments should eliminate protection for descriptive marks from their trademark laws so that competitors can use descriptive terms in any way, and in any medium, to truthfully describe their own products, services, or activities. Specifically, legislatures should revise their trademark laws to (1) prohibit registration of descriptive marks; (2) prohibit trademark actions based on rights in descriptive marks, including but not limited to actions for infringement, unfair competition, dilution, and cybersquatting; and (3) require cancellation of registered descriptive marks. Procedurally, it would not be difficult to make these revisions to the trademark laws because similar provisions already exist for generic marks. In addition, no one should be allowed to use a trademark symbol with a descriptive or generic word or phrase.

If governments make these changes to the trademark laws, First Amendment free speech interests and the public will benefit. No business will ever have a monopoly on the use of a descriptive term in a particular industry. Therefore, any incentive to stake or defend a claim in a descriptive term, lest another competitor do so, will be removed. Competitors will have full use of all the terms available in our language to describe their products. As a result, the public will receive complete information regarding products in the

---

372. The term “attributes” should be interpreted broadly to include a product’s qualities, characteristics, ingredients, subject matter, purpose, function, use, size, merit, quantity, capacity, class of intended purchasers, or the end effect of the product upon the user, and laudatory and geographically descriptive terms. As noted in Section II.B.2, this Article does not address whether trademark protection should be eliminated for trade dress or marks that do not describe or provide information regarding the attributes of a product, but which require proof of distinctiveness or secondary meaning for trademark protection, such as product designs, colors, and personal names. *See supra* note 93 and accompanying text.

marketplace and can use this information when deciding which one of several competing products to purchase. Companies can use inherently distinctive marks to differentiate their products from the products of others, and consumers can rely on inherently distinctive brands to identify a product they liked or disliked in the past. Of course, any business that wants to convey information regarding its product by using a descriptive or generic term in its brand name may continue to do so, but that business should no longer be able to prevent others from doing the same thing.

In addition to increasing the free flow of information regarding products sold in the marketplace, eliminating descriptive marks from trademark registration and protection will provide other benefits. If descriptive terms cannot be registered, no business can obtain incontestable rights in a descriptive term or use a trademark registration symbol to stake a claim in a descriptive term. If no one can enforce trademark rights in a descriptive term, courts will no longer need to determine whether a descriptive term has acquired secondary meaning.<sup>373</sup> Finally, the difference between generic and descriptive marks will no longer be relevant because neither will be capable of registration or protection.

Admittedly, removing descriptive marks from the umbrella of trademark protection is a drastic proposal. Advocates of the status quo may offer the following arguments: (1) this proposed change to the trademark laws is unfair because companies who use descriptive terms as marks have relied on current trademark protection of descriptive marks; (2) categorization of a mark as descriptive or suggestive is difficult but will become critical in the trademark analysis; or (3) refusing to protect descriptive marks conflicts with international law. These potential criticisms are addressed in turn.

#### 1. Reliance on Current Trademark Protection

Critics may argue that the proposal set forth in this Article is unfair to those businesses who selected and used descriptive terms as marks in reliance on the Lanham Act's current descriptive trademark provisions. Some companies selected their descriptive marks long ago and have spent a lot of time and money advertising and selling their products under those marks. Such marks, they may claim, are source-identifying, and thus consumers will be confused if competitors are now allowed to use the same descriptive mark when selling their own products.

First, this reliance argument fails because the selection and use of a descriptive term as a mark already entails a risk that the mark will not be registered or protected.<sup>374</sup> Descriptive marks are weak and are only protected

---

373. However, proof of secondary meaning will still be required in cases involving alleged trademark rights in product designs, colors, and personal names. *See supra* note 93.

374. *Alpha Indus., Inc. v. Alpha Steel Tube & Shapes, Inc.*, 616 F.2d 440, 445 (9th Cir. 1980) (“[S]election of a mark with a common word . . . ‘naturally entails a risk of some

with proof of secondary meaning. Unless a business has incontestable rights in a descriptive mark, a court could deny protection or the PTO could cancel a trademark registration on the grounds that the mark is not distinctive. Moreover, reliance on current trademark protection is irrelevant if an inherently distinctive mark becomes generic. Regardless of extensive advertising and sales of a product under an inherently distinctive mark, the PTO can cancel that mark if it becomes generic for the goods for which it was registered on the principal register.<sup>375</sup>

Second, any confusion caused by not protecting exclusive rights in descriptive marks will likely be de minimus because descriptive terms still retain their original descriptive meaning. Although consumers may recall that one company first used a descriptive term as a mark in advertising, they will understand that a competitor's use of that descriptive term is to describe and not to identify source. Television viewers will understand that CNN's use of the slogan "Fair & Balanced" describes CNN's news services even if they formerly associated that phrase solely with Fox's news services. Trademark law should encourage companies to select and use the most distinctive type of mark, not a weak trademark that communicates information about the qualities or characteristics of the product. As inherently distinctive marks properly function to identify a product source, companies should use these strong marks if they want trademark protection.

## 2. The Critical and Difficult Line Between Suggestive and Descriptive Marks

Critics of the proposed revision to the trademark laws may also correctly note that it is frequently difficult for courts to draw the line between suggestive and descriptive marks. If descriptive marks are not protected, categorization of a mark as descriptive or suggestive will become a matter of life (protection) or death (no protection) for the mark-holder. This point, while valid, does not justify continued protection of descriptive marks because the difference between descriptive and suggestive marks is currently important and courts already draw this difficult line.<sup>376</sup>

---

uncertainty and the law will not assure absolute protection.” (quoting *Scott Paper Co. v. Scott's Liquid Gold, Inc.*, 589 F.2d 1225, 1231 (3d Cir. 1978)); 2 MCCARTHY, *supra* note 24, § 11:23 (noting that by selecting a descriptive mark, “businesspeople, either knowingly or unwittingly, take the risk that the mark will be held descriptive, with the attendant difficulty of proving secondary meaning in order to get judicial protection and registration”).

375. 15 U.S.C. § 1064(3) (2000).

376. *E.g.*, *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1142 n.3 (9th Cir. 2002) (“[W]hether a mark is descriptive or suggestive can be a hotly disputed issue.”); *Franklin Knitting Mills, Inc. v. Fashionit Sweater Mills, Inc.*, 297 F. 247, 248 (S.D.N.Y. 1923) (“It is quite impossible to get any rule out of the cases beyond this: That the validity of the mark ends where suggestion ends and description begins.”), *aff'd per curiam*, 4 F.2d 1018 (2d Cir. 1925); *Le Blume Imp. Co. v. Coty*, 293 F. 344, 351 (2d Cir. 1923) (“The line of demarcation [between

First, as set forth in Part II of this Article, a mark is only eligible for protection if it is distinctive. Suggestive marks are inherently distinctive and automatically considered worthy of trademark protection. On the other hand, descriptive marks are ineligible for protection unless the mark-holder can prove secondary meaning—a daunting task.<sup>377</sup> Unless the parties stipulate that the mark is suggestive, the court will have to categorize the mark and, if it is descriptive, determine if the mark has a secondary meaning. Thus, courts often have to determine whether a mark is suggestive or descriptive.

Another reason the difference between descriptive and suggestive marks is already important in trademark actions is because courts are more likely to find infringement or dilution where the plaintiff's mark is stronger (i.e., more distinctive). In trademark infringement actions, strength of the mark is one of the factors the court uses to determine whether a defendant's use of an identical or confusingly similar mark is likely to cause confusion.<sup>378</sup> “[S]tronger marks receiv[e] greater protection than weak ones. . . . because . . . it is more likely that consumers will be confused by another's use of the same or similar mark.”<sup>379</sup> If plaintiff's mark is suggestive, the court is more likely to find a likelihood of confusion (and infringement) than if the mark is descriptive. Strength of the mark is also important in dilution actions; some courts refuse to find dilution of plaintiff's mark if the mark is only descriptive with secondary meaning. Therefore, whether a plaintiff's mark is suggestive or descriptive is already a critical and hotly-contested issue in trademark law that is both considered and resolved by the courts.

Noting that “the distinction between descriptive and suggestive marks may be inarticulable,” the Ninth Circuit nevertheless offered the following guidance in this determination: “The primary criterion is ‘the imaginativeness involved in the suggestion,’ that is, how immediate and direct is the thought process from the mark to the particular product.”<sup>380</sup> “If the mental leap between the word and the product's attribute is not almost instantaneous, this strongly indicates suggestiveness, not direct descriptiveness.”<sup>381</sup> In other

---

descriptive and suggestive marks] may not be easy to draw but it exists.”). Acknowledging the line-drawing problems inherent in categorizing marks, the Federal Circuit has stated:

In the complex world of etymology, connotation, syntax, and meaning, a term may possess elements of suggestiveness and descriptiveness at the same time. No clean boundaries separate these legal categories. Rather, a term may slide along the continuum between suggestiveness and descriptiveness depending on usage, context, and other factors that affect the relevant public's perception of the term.

*In re Nett Designs, Inc.*, 236 F.3d 1339, 1341 (Fed. Cir. 2001).

377. See *supra* Subsection II.B.2.b.

378. See *supra* note 169 and accompanying text.

379. *Entrepreneur Media*, 279 F.3d at 1141.

380. *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 349 (9th Cir. 1979) (citation omitted) (quoting RESTATEMENT (FIRST) OF TORTS § 721 cmt. a (1938)).

381. 2 MCCARTHY, *supra* note 24, § 11.67, *quoted with approval in* Self-Realization

words, “[i]f a consumer must use imagination or any type of multistage reasoning to understand the mark’s significance, then the mark does not *describe* the product’s features, but *suggests* them.”<sup>382</sup> When deciding whether a mark is suggestive or descriptive, some courts consider dictionary definitions,<sup>383</sup> widespread use of the word,<sup>384</sup> and whether synonyms exist—whether competitors need to use the term at issue.<sup>385</sup> Because tools are currently available for evaluating whether a mark is suggestive or descriptive, and because courts already make this determination in trademark cases, eliminating descriptive marks from protection under the trademark laws will not create any additional burden on courts and parties litigating this issue.

---

*Fellowship Church v. Ananda Church of Self-Realization*, 59 F.3d 902, 911 (9th Cir. 1995) (holding that the plaintiff’s “Self-realization” mark is not suggestive because “[no] mental leap is required to conclude that a ‘Self-realization book’ is a book designed to help readers achieve higher consciousness”). On two subsequent occasions, the Ninth Circuit has applied the “mental leap” test to differentiate between descriptive and suggestive marks. *Compare* *Japan Telecom, Inc. v. Japan Telecom Am. Inc.*, 287 F.3d 866, 873 (9th Cir. 2002) (concluding that “‘Japan Telecom’ . . . is descriptive, not suggestive,” because even unfamiliar “[c]onsumers . . . will still not need to make any mental leap between Japan Telecom’s name and what it does”), *with* *Brookfield Communications, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1058 (9th Cir. 1999) (concluding that the plaintiff’s “Movie Buff” trademark “is suggestive—and thus strong enough to warrant trademark protection—because it requires a mental leap from the mark to the product”).

382. *Kendall-Jackson Winery, Ltd. v. E. & J. Gallo Winery*, 150 F.3d 1042, 1047 n.8 (9th Cir. 1998), *quoted in* *Entrepreneur Media*, 279 F.3d at 1142; *see also* *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 792-93 (5th Cir. 1983) (applying the “imagination test”); 2 MCCARTHY, *supra* note 24, § 11:67-71 (discussing various tests for distinguishing between descriptive and suggestive marks).

383. *E.g., Brookfield*, 174 F.3d at 1066 (finding that the “difference [of only a single space] is pivotal” between the terms “MovieBuff,” a suggestive mark, and “Movie Buff,” a descriptive mark, because the latter “is routinely used in the English language to describe a movie devotee,” while the former “is not in the dictionary”); *Zatarains*, 698 F.2d at 792 (beginning its analysis by considering dictionary definitions).

384. *E.g., Entrepreneur Media*, 279 F.3d at 1143 (“Widespread use of a word by others may serve as confirmation of the need to use that word.”); *Zatarains*, 698 F.2d at 793 (examining the extent to which competitors actually use a term); *see* *Bliss Salon Day Spa v. Bliss World LLC*, 268 F.3d 494, 497 (7th Cir. 2001) (“BLISS marks are a glut on the market in hair styling and beauty care. They are not distinctive, so the word does not belong in the ‘suggestive’ cubbyhole.”).

385. The fact that competitors need to use the term to describe their products confirms that the mark is descriptive. *E.g., Entrepreneur Media*, 279 F.3d at 1143 (“[I]f there are numerous synonyms for a common trademarked word, others will have less need to use the trademarked term. . . . Furthermore, ‘although English is a language rich in imagery, we need not belabor the point that some words, phrases or symbols better convey their intended meanings than others.’” (quoting *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 306 (9th Cir. 1992))); *Zatarains*, 698 F.2d at 793 (applying the competitors’ need test).

## 3. Uniformity of International Trademark Law

Finally, critics may note that refusing to protect descriptive marks conflicts with the trademark laws of other countries. The Lanham Act states that it intends, among other things, “to provide rights and remedies stipulated by treaties and conventions respecting trademarks, trade names, and unfair competition entered into between the United States and foreign nations.”<sup>386</sup> While United States trademark holders who sell their products in foreign countries may prefer that all nations have uniform trademark laws, the rest of the world does not have such a strong history of protecting free speech. One commentator has noted that “German trademark law is not so much concerned about the word monopoly as is U.S. law”; unlike United States trademark law, German trademark law allows for the registration of generic marks that have acquired secondary meaning.<sup>387</sup> Protection of the First Amendment rights of United States citizens should not depend on the trademark laws of nations that do not have equivalent protections for the right of free expression, commercial or otherwise.

## VI. CONCLUSION

When Congress enacted the modern federal trademark law in 1946, it was generally accepted that the First Amendment did not protect commercial speech. First Amendment law has changed during the last thirty years, and the trademark laws must be reevaluated. Specifically, the constitutionality of protecting exclusive rights in descriptive trademarks must be challenged in light of increasing recognition that trademarks are protected commercial speech. Trademark laws that restrict the commercial use of a mark are subject to at least an intermediate level of scrutiny under the First Amendment. As set forth above, laws granting and enforcing exclusive rights in descriptive marks do not survive such scrutiny under *Central Hudson*'s four-factor test.

The first factor of this test asks whether the commercial speech at issue concerns a lawful activity and is not misleading. This first inquiry is a threshold factor; if the expression concerns unlawful activity or is misleading, it is not entitled to any First Amendment protection. The use of a trademarked descriptive term to sell a product is not misleading if the words accurately describe the attributes of the product sold under the mark. Therefore, *Central Hudson* provides that the government cannot prohibit the use of descriptive terms as marks by competitors unless the remaining three factors of the test are satisfied.

---

386. 15 U.S.C. § 1127 (2000).

387. Rudolf Rayle, *The Trend Towards Enhancing Trademark Owners' Rights—A Comparative Study of U.S. and German Trademark Law*, 7 J. INTELL. PROP. L. 227, 274 n.285 (2000) (“[A]ccording to German Trademark Act § 8(3), genericness can be overcome through the acquisition of secondary meaning.”).

The second factor of the *Central Hudson* test requires the government to prove that its interest in the speech regulation is substantial. There is a substantial governmental interest in protecting the ability of consumers to identify the source of a product and distinguish among the products of a business and its competitors. There is no such interest, however, in granting and enforcing exclusive property rights in descriptive words because this harms expression without providing any corresponding benefit to the public. Descriptive words are valuable because they communicate information regarding the attributes of a product. A business that has not created this value in a descriptive term should not obtain exclusive rights to use the term as a mark, regardless of any investment of time, energy, or money in advertising or selling the product under that descriptive mark.

The third factor of the *Central Hudson* test—whether a particular regulation of commercial speech directly and materially advances the substantial governmental interest—is not satisfied for descriptive trademark laws. Because the original descriptive meaning remains with a descriptive term regardless of whether one business has established secondary meaning in that term, descriptive marks do not identify the source of a product as well as inherently distinctive marks. Descriptive marks with secondary meaning function both to identify source and identify a product’s attributes, and thus they do not immediately signal a brand. For this reason, the ability of consumers to identify and distinguish among competing sources of a product is neither directly nor materially advanced by protecting trademark rights in descriptive terms.

An independent reason the descriptive trademark laws are unconstitutional is because the government cannot satisfy the fourth *Central Hudson* factor—whether the regulation of commercial speech is no more extensive than necessary to serve the asserted governmental interest. Because descriptive marks, unlike inherently distinctive marks, retain their original descriptive meaning, expression is suppressed more than necessary when the government protects trademark rights in descriptive terms. A grant to one business of exclusive rights in a descriptive mark harms expression because it restricts the words competitors can use to describe their products and hinders the free flow of information in the marketplace. A business with exclusive rights in a descriptive mark has an unfair disadvantage because competitors must spend more to communicate the same information without using the same descriptive words. If products are substitutes, but competitors cannot use certain descriptive words to communicate this fact, consumers cannot base their decisions solely on price. Because descriptive terms communicate product information and businesses can instead use fanciful, arbitrary, or suggestive marks to identify and distinguish their products, trademark law is broader than necessary when it grants and enforces exclusive rights in descriptive marks in addition to protecting trademark rights in inherently distinctive marks.

Current descriptive trademark laws also restrict more speech than

necessary when they protect rights in marks that are not distinctive and that are used fairly and in good faith by others. Descriptive marks that are erroneously registered on the federal principal trademark register can become incontestable even if a court subsequently agrees that the mark is not source-identifying. In addition, the Lanham Act allows mark-holders to use trademark symbols to discourage the lawful use of descriptive terms by others even though the PTO has not evaluated the distinctiveness of the descriptive mark or has concluded that the mark is not sufficiently distinctive for placement on the principal register. Finally, the fair use defense does not adequately protect the right of competitors to use descriptive terms in various ways in connection with the sale of their goods. For each of these reasons, trademark laws that restrict the use of descriptive words violate the First Amendment because they suppress speech more than necessary.

Under the current trademark system, competitors cannot adequately predict the outcome of a threatened infringement action based on contested rights in a descriptive mark. Therefore, there is a significant risk that competitors will simply refrain from using descriptive terms after another business claims exclusive trademark rights in them via a trademark registration, trademark symbols, a strongly-worded cease and desist letter, or a complaint. Defending a trademark lawsuit is expensive and time consuming. Competitors who cannot afford to litigate will be forced to give up their right to use descriptive words in the public domain because there is a chance, however slight, that one business has exclusive rights to a descriptive term under current trademark law.

By protecting trademark rights only in inherently distinctive marks, the government can further the consumer-oriented goals of trademark law. As inherently distinctive marks do not directly or immediately convey information about a product or service, restrictions on the misleading commercial use of such marks do not suppress speech more than necessary. Granting and protecting exclusive rights in descriptive marks, however, does not further these goals of trademark law and unnecessarily harms both expression and competition. No business in a particular industry should have a language monopoly in a descriptive or generic term. As descriptive trademark laws do not survive First Amendment scrutiny under the *Central Hudson* test, they are unconstitutional regulations of commercial speech. The First Amendment requires the government to revise the trademark laws to prevent registration and enforcement of exclusive rights in descriptive terms.