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The Expansion Trajectory: Trademark Jurisprudence in the Modern Age

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Abstract
American trademark law is expanding. The expansion began with the adoption of the Lanham Act in 1947. At that time and ever since, commentators and lawmakers alike referred to the Lanham Act as a codification of the existing common law. In fact, this codification was a selection and expansion of the common law. The United States has continued to expand trademark jurisprudence: from incontestability, to cybersquatting, to dilution - the notion of what it means to protect a trademark has continued to expand. During this time, the Commerce Clause on which American federal trademark protection is based has not changed.

The result of this inextricable expansion is that trademark jurisprudence in the United States is becoming muddled. Originally, trademark protection was justified as a right of exclusion that was granted to the user of a sign for their exclusive use for as long as they used it and to the extent they used it. Now, the trademark right has come to resemble the moral right of attribution and/or integrity of civil law copyright systems.

This may be appropriate if the nation had a purposeful debate or discussion on turning the United States trademark system into a system of moral rights. However, no such discussion has taken place. Rather, Congress has enlarged the trademark right at the behest of special interests without paying attention to the consequences. One consequence is that trademark jurisprudence now has a striking resemblance to that of the protection offered by moral rights in civil law countries.

Keywords
trademark dilution, moral right, right of exclusion

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I. Introduction
In 1994, I predicted that a federal statute protecting trademarks from dilution was a dangerous notion as follows:

A federal statute protecting "super trademarks" from dilution would create a copyright in the mark itself, as well as in the abstract idea of the mark in the minds of the consumer and manufacturers.... Under dilution theory, the trademark holder not only controls each expression of the mark, but also attempts to control the manner in which consumers or other manufacturers perceive of the mark. In this matter, dilution theory attempts a monopolization of the idea of the work even outside of any use. In that respect, dilution theory violates the idea/expression dichotomy.¹

In 2000, I described and analyzed the expansion of American trademark jurisprudence and claimed that the United States had inadvertently created a Civil Law of trademarks, rather than remaining honest to our common law origins.²

In the interim, this predicted expansion has continued unabated. Trademark jurisprudence in the United States has inextricably expanded since the inception of the Lanham Act in 1947.³ This article presents several examples of this expansion. Incontestability, a doctrine created with the Lanham Act, was the first step.⁴

Trademark jurisprudence settled into a groove until 1989 when Congress created the intent-to-use (ITU) system.⁵ In 1996, Congress enacted the Federal Trademark Dilution Act (FTDA).⁶ In 2000, the Anti-cybersquatting Consumer Protection Act (ACPA) was enacted.⁷ Throughout the history of the Lanham Act, Section 43(a) has gradually been expanding. However, it received a huge jolt in 1995 when the Supreme Court held that color alone could act as a trademark.⁸

The result of this inextricable expansion is that trademark jurisprudence in the United States is becoming muddled. Originally, trademark protection was justified as a right of exclusion that was granted to the user of a sign for their exclusive use for as long as they used it and to the extent that they used it. Now, the trademark right has come to resemble the moral right of attribution and/or integrity of civil law copyright systems.

This may be appropriate if the nation had a purposeful debate or discussion on turning the United States trademark system into a system of moral rights. However, no such discussion has taken place. Rather, Congress has enlarged the trademark right at the behest of special interests without paying attention to the consequences: one consequence being that trademark jurisprudence now has a striking resemblance to that of the protection offered by moral rights in civil law countries.

Although some American scholars have made a career out of lobbying for moral rights,1 others have questioned either the necessity2 or the desirability3 of adopting a moral right scheme. Regardless of how one might come down on this issue, American trademark rights today have come to resemble the moral rights of attribution and integrity. Congress has done this with no discussion or conversation about whether or not this is a good idea. Worse yet, when the Supreme Court has attempted to reign in this expansion, Congress has simply overruled the Court.4

Congress seems serious about affecting this expansion. Congress has been pushing this expansion most strongly in the last decade. Congress has been confronted in this expansion by the Supreme Court but to no real effect.5 This conspiracy of expansion has gone on with no debate or discussion with the American people to decide if society wants an expanded trademark system.

Rather, this conspiracy of expansion has resulted in small to medium-sized corporations feeling exerted by large corporations over trademark rights.6 Therefore, this problem is not merely jurisprudential. In fact, it is quite real.

As trademark rights expand to resemble the moral rights of attribution and integrity, they become stronger and broader in scope. When they become stronger and broader in scope, they are asserted more aggressively against competitors. This results in competitors changing their trademarks to avoid conflict. We know this is happening.7 This article tells the story of how, legislatively, this is done.

Section II presents each major expansion in American trademark history since the Lanham Act was created. Section III portrays the moral rights of attribution and integrity and how trademark protection has come to resemble them. Section IV discusses the tension that has been created between the Supreme Court and

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1 See, e.g., ROBERTA ROSENTHAL KWALL, THE SOUL OF CREATIVITY: FORGING A MORAL RIGHTS LAW FOR THE UNITED STATES (2010).

2 See Rebecca Stuart, A Work of Heart: A proposal for a revision of the Visual Artists Rights Act of 1990 to bring the United States closer to International Standards, 87 SANTA CLARA L. REV. 645, 676-79 (2007) (The right of divulgation has not proven to be a very important right in the international community.”); Kimberly Y.W. Holst, A Case of Bad Credit?: The United States and the Protection of Moral Rights in Intellectual Property Law, 3 BUFF. INT’L L.J. 105, 128-30 (2000) (stating that the rights of disclosure and withdrawal do not need to be protected under the Berne Convention, because common law already protects these rights by contrast protection for attribution and integrity have not had the same support from the courts. See also MEYVLE B. NICHES & DAVID NICHES, NICHES ON COPYRIGHT: A TREATISE ON THE LAW OF LITERARY, MUSICAL AND ARTISTIC PROPERTY, AND THE PROTECTION OF IDEAS (1991) (“Note that a divulgation right may exist in Berne by implication.”), SAM ROBINSON, THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS, 1886-1986, 476 (1987) (“There is no reference to [the right of disclosure] in article 4B(4), but it is possible to argue that such a right is required to be protected, by implication.”).


7 Id.
Congress over the appropriate scope of trademark protection. Section V presents some normative conclusions that this problem manifests.

II. Doctrinal Expansion
The trademark right in the United States has been on an inextricable course of expansion since (and including) the inception of the Lanham Act. The United States Congress has known only one direction in trademark law: expansion. However, the trademark law can expand only so much until it begins to resemble some other law such as the moral right. When it resembles a moral right, the basic theoretical justification for that trademark protection changes. Where it once used to be a right of exclusion limited to the extent of use and the duration of use, its justification has now changed to protection for protection's sake, which is not the original intent of trademark protection.16

A. The Lanham Act
The Lanham Act went through a tortured history before it was finally passed in the days following World War II. There were multiple attempts between 1938 and 1946, when it was finally passed.17 The legislative history of the Lanham Act tells us that this is a codification statute—no new substantive law was created with the Lanham Act. It merely codified the existing common law with the intention of operating as a registration statute.18 As we shall see, this legislative history has not been realized. Many new substantive rights have been granted. The first is the notion of "incontestability."19 A trademark registration can become incontestable anytime after five years of consecutive use of mark on the identified goods or services.20


17 The Lanham Act's purpose is to protect the relevant consumer and ensure fair competition; it does not confer any property right in a trademark alone. See United Drug Co. v. Theodore Rectanus Co., 248 U.S. 90, 97 (1918) ("There is no such thing as property in a trade-mark...") When protection begins to extend beyond simply indicating the source or origin of a product or service, trademark law is no longer serving its originally intended purpose. Id.

18 One example of this is the "Intent to Use" provisions, which have the effect of creating rights in trademarks prior to their actual use. See 15 U.S.C. § 1051(b) (2006). Creation of rights before actual use is not an uncommon trait of civil law trademark jurisdictions, but is generally inconsistent with common law jurisdictions, especially the United States where trademark rights are based on the Commerce Clause of the Constitution, which requires "incontestable commerce" or actual use. See U.S. Const. art. I, § 8, cl. 3; 15 U.S.C. § 1127 (2006).

19 While the act was originally introduced in 1938, the intervening events of World War II caused the passage of the Lanham Act to be delayed until after the war came to an end. J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 5:4 (4th ed. 2007). See also Frank H. Foster & Robert L. Shook, PATENTS, COPYRIGHTS, AND TRADEMARKS 23 (6th ed. 1993).

20 See 15 U.S.C. §1127 (2008); J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:49 at 11-105 (4th ed. 1996) (stating that the act has been recognized as a statutory restriction of the corresponding common law). In passing this act Congress also hoped to bring American law into conformity with the more liberal principles of a number of foreign countries, standards to which the United States had pledged adherence by treaty and convention. S. REP. NO. 79-1333, at 3 (1946), reprinted in 1946 U.S.C.C.A.N. 1274, 1277. See also, Kohler Co. v. Moer, Inc., 12 F.3d 632, 617 (7th Cir. 1993) (Cady, J., dissenting) (when the two conflict, patent law should displace trademark law because patent law is recognized in the Constitution while trademark law is a more codification of the common law).


Given the advantages offered to an incontestable mark, it is remarkably simple to obtain incontestable status. An applicant merely needs to file a Section 15 Affidavit and pay the proscribed fee to obtain an incontestable mark. There is no substantive evaluation of the mark or the claimed use. The PTO merely has a filing clerk check to make sure that the correct people have signed the Section 15 Affidavit and other very simply formalistic requirements. After that, the mark is incontestable.

An incontestable mark has many statutorily created advantages over a non-incontestable mark. Merely descriptive marks that have become incontestable are protected from a motion to cancel the registration. The Supreme Court went along with this expansion in Park N' Fly v. Dollar Park and Fly. There, the Supreme Court held that an incontestable mark could be used offensively, as well as to defend against a motion for cancellation.

Therefore, Park N' Fly was allowed to use the fact that its mark had become incontestable as a basis to sue Dollar Park and Fly for trademark infringement, even though its mark was descriptive and therefore unenforceable. That is, save for the statutorily created notion of incontestability, Park N' Fly would have lost this case and we would likely have many “park and fly” providers at airports around the country. However, because of this statutory gift, Park N' Fly prevailed. Therefore, there is only one provider of off-airport parking services under that name.

Another advantage of incontestability is the fact that Section 33(b) of the Lanham Act states that for an incontestable mark, “registration shall be conclusive evidence of the validity . . . of the registrant’s exclusive right to use the registered mark in commerce . . . and shall be subject [only] to the following [nine] defenses.”

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24 “The USPTO neither examines the merits of §15 Declarations nor accepts §15 Declarations. However, the USPTO will review a §15 Declaration to determine whether it complies with statutory requirements.” USPTO, Trademark Process, Maintain/Review a Registration, http://www.uspto.gov/trademarks/process/maintain/prfaq.jsp (last visited Sept. 10, 2010).

25 15 U.S.C. § 1115 (2006) (”registration shall be conclusive evidence of the validity . . . of the registrant’s exclusive right to use the registered mark in commerce . . . and shall be subject [only] to the following [nine] defenses.”).


27 Id. at 205, see also id. at 204 (citing that “(t)he decision below is in direct conflict with the decision of the Court of Appeals for the Seventh Circuit in Union Carbide Corp. v. Ever-Ready, Inc., 531 F.2d 366, cert. denied, 429 U.S. 830 (1976) . . . we now reverse,” thereby clarifying the split that developed in the circuit courts regarding offensive use of incontestability).

28 Id. at 205 (“The holder of a registered mark may rely on incontestability to enjoin infringement and that such an action may not be defeated on the grounds that the mark is merely descriptive.”).

29 Because use of the word combination “park and fly” was banned, “Dollar Park and Fly” was forced to change their name to “Park Shuttle N Fly.” See http://www.hoovers.com/company/DollarPark_and_Fly_ban/factfinder-1.html (last visited Sept. 10, 2010); www.parkshuttlefly.com (last visited Sept. 10, 2010) (showing “Dollar Park and Fly’s” current address in Portland, Oregon, as the same as “Park Shuttle N Fly’s”). Despite losing the legal battle, the word “Shuttle” in “Park Shuttle N Fly’s” logo appears so small that the logo actually appears as “Park N Fly.” Id. See also their sister company’s website, boldly named “Seattle Park N Fly,” available at http://www.parkshuttlefly.com/. The company filed a similar version of this logo with the USPTO in 1999, but failed to see it through to registration. See Registration No. 7564046 (Filed on Feb. 12, 1999). Holding several trademarks of their own, there is also a “Park Shuttle and Fly” http://www.parkshuttlefly.com/ (last visited Sept. 10, 2010), located in Boston; no affiliation with “Park Shuttle N Fly.” See their website, available at http://www.parkshuttlefly.com. Other competitors include “Park, Sleep, Fly,” available at http://www.parksleepfly.com (last visited Sept. 10, 2008); “Park, Ride, Fly,” available at http://www.parksleepflyusa.com (last visited Sept. 10, 2010); and “Park, While U Fly,” available at http://www.parkwhileufly.com (last visited Sept. 10, 2010).

for the statute, a trademark owner could never claim that its mark was “conclusive evidence” of anything. A claimant would have to prove each and every element of its cause of action. Therefore, the right of incontestability is quite strong.

If the Lanham Act is a codification of the common law of trademarks, one would naturally wonder where this notion came from. Which state in 1946 had a judicarily created notion that would resemble incontestability? Of course, no such state existed. The best record we have of the origin of the notion of incontestability is that it was once fixed in the United Kingdom Trademark Act. In a loose sort of a way, the US common law incorporated the UK common law, but that ended by 1946.

Therefore, Congress made choices in 1946 when it included the notion of incontestability in the Lanham Act. The only

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22 Particularly in the Sixth and Eleventh Circuits where incontestable marks have been held as presumptively strong, even when they are descriptive. See Dier C. v. B & H Indus., 800 F.2d 322, 325 (11th Cir. 1986); Wynn Oil Co., 789 F.2d 1183, 1187 (6th Cir. 1986). However, admittedly they are in the minority. See Houses & Land Affiliates, LLC v. Homes & Loans Magazine, LLC, 589 F. Supp. 2d 1248, 1264 n. 12 (M.D. Fla. 2007) (“Other circuits conclude that an otherwise weak mark is not made strong for the purposes of the likelihood-of-confusion analysis because of its incontestable status. See Creek Corp. v. U.S. Floor Sys., Inc., 803 F.2d 166, 171 (5th Cir. 1986) (“Incontestable status does not make a weak mark.”); See also Lone Star Steakhouse & Saloon, Inc. v. Alpha of Va., 43 F.3d 922, 935 (4th Cir. 1995) (stating that “incontestability affects the validity of the trademark but does not establish the likelihood of confusion necessary to warrant protection from infringement”); Cruzer – Jay USA Pub’g v. Meredith Corp., 499 F.3d 1072, 1077-78 (2d Cir. 1993) (emphasizing that the marketplace strength of an incontestable mark may be challenged); Munters Corp. v. Matsui Am, Inc., 509 F.3d 250, 252 (7th Cir. 1993) (incontestable status does not preclude consideration of a mark’s strength”).
24 In 1875 and 1883 Great Britain enacted statutes which essentially provided that registration of a mark would become conclusive evidence of the registrant’s right to the exclusive use of the mark after five years after initial registration. Although these statutes never use the word “incontestable,” they are otherwise strikingly similar to the relevant provisions of the current Lanham Act. See Act to Establish a Register of Trade Marks, 39 & 39 Vict., ch. 9, § 3 (1875) reprinted in Roger W. Wallace & John B. Williamson, The Law and Practice Related to Letters Patent for Inventions 612 (1908); An Act to Amend and Consolidate the Law Relating to Patents for Inventions, Registration of Designs, and of Trade Marks, 46 & 47 Vict., ch. 57, § 76 (1883) discussed in Gwendolyn D. Brinckerhoff & Mark D. Janis, Trademark Law and Theory: An Introduction to Contemporary Research 29 (2009).
25 Trademarks have been officially recognized by English common law as early as 1618. See Southern v. Howe, Popham’s Reports 143, 144 (1618); 79 Eng. Rep. 1243, 1244 (K.B. 1907). Keith M. Stolte, How Early Did Anglo-American Trademark Law Begin? An Ancestor to Schecter’s Construction, 8 FORESTRY INT’L. PROD. MEDIA & ENT. L. 505, 517 (1998). In 1767, following the American Revolution, the newly independent states enacted “reception statutes” enabling courts to react and develop the British Common Law they had previously adhered to while colonies. Charles A. Beam, From helt and Marshfield to Story and Lummis and Hirschbein: The Progressive Development of Commercial Law, 57 U. MICH. L. REV. 351, 363 (1959). By guaranteeing that judicial proceedings would follow the course of established common law, the Northwest Ordinance, approved by Congress in 1787, furthered this notion for the advancing territories. Peter L. Strauss, Federal Courts and the Common Law, 53 Ala. L. Rev. 891, 910 n.96 (2002). In this way, Anglo-Saxon based common law was eventually incorporated in all the newly created states (except Louisiana, who adopted a bijurisdictional system based on the Napoleonic Code of 1804). Washington Legal Foundation v. Legal Foundation of Washington, 271 F.3d 838, 852 (9th Cir. 2001); Guy Cavnish, French Civil Law Between Past and Present, 28 Conn. J. Int’l L. 111, 118-20 (2004). As the reception statutes became obsolete, the states eventually enacted new laws. New York was the first to enact a state trademark law in 1865. Edward S. Rogers, Good Will, Trade-Marks and Unfair Trading 48 n.12 (1919). Despite only 62 trademark cases having been decided in the United States by 1870 (40 of which were in New York), the first Federal Trademark law was enacted. Act of July 7, 1870, c. 206, 16 Stat. 196; Anne Gisele Larriva et al., Glisson on Trademarks § 1.01[2] (Lexis 2013). Unfortunately, under Supreme Court review in Trade-Mark Cases, 100 U.S. 82 (1879), the 1870 trademark law did not meet constitutional muster. Pressured by the international demand from commerce treaties with several civil law countries (Russia, Belgium and France between 1888 and 1889), Congress had to go further to ground the law in the commerce clause as Thomas Jefferson’s had suggested in 1791. William Henry Brown, A Treatise on the Law of Trademarks 297 (5th ed. 1885); Edward S. Rogers, Good Will, Trade-Marks and Unfair Trading 48 (1919). The first significant attempt at a federal trademark registration came with the Act of 1905. Act of Feb. 20, 1905, c. 952, 33 Stat. 724. England the same year: The Trademark Act, 1905: 7 Edw. VII. Ch. 15. Both American and English versions went through various amendments, until a new English Act was eventually passed in 1938. Trade Marks Act 1938: 1938 c. 22 1, 2 Geo. 6. This Act fundamentally changed the English system by permitting registration based on intent-to-use, creating an examination-based process, and creating an application publication system. England’s new act greatly influenced Fritz G. Langham, who the same year first introduced to Congress the American version. Steven Chen, Overview of Japanese Trademark Law (6d ed. 1999). See also Moyseley v. V United States, 537 U.S. 418, 428 (2003) ("The United States took the trademark and unfair competition law of England as its own") (quoting B. Patithall, D. Hilliard, & J. Welch, Trademarks and Unfair Competition 2 (4th ed. 2000) (alteration in original)). This Act was finally passed in 1946, and took effect one year later.
source or jurisdiction that included a notion of incontestability was the UK. Congress elected to ignore the common law of the rest of the United States and embrace the UK version of incontestability. Therefore, more appropriately, the Lanham Act should be said to be a "codification (of the laws we liked) statute."

Incontestability was a serious expansion of the trademark law as it existed in the United States in 1946. To be sure, it is a valuable encouragement for firms to register trademarks. Given the incontestability provisions, along with its conclusive evidence provisions, it would seem a violation of corporate fiduciary duties to not claim incontestability after five years of continuous use. However, this is only one of example of many to follow of Congress expanding the trademark right way past any notion of what the Common Law of trademarks had been prior to 1946.

B. Intent To Use

The so-called Intent-to-Use ("ITU") system is yet another expansion of the American notion of trademark protection. Passed in the Trademark Revision Act of 1988, the ITU system allows a trademark claimant to register its intended use of the mark with the PTO. Although section 7(c) of the Lanham Act requires that any effect of the ITU system is "contingent upon registration of the mark," in reality the ITU system does grant several important rights that are not contingent upon registration of the mark. By making "registration of the mark" a requirement, Congress attempted to make ITU rights contingent upon use of the mark in commerce, thereby preserving the constitutionality of the ITU system. However, under the ITU system, before the mark is used in commerce, an actual trademark application is filed with the PTO and thereby a record of this application is created. This application will be disclosed in all subsequent and relevant trademark searches. This gives notice to all subsequent actual users of that mark that some entity has claimed priority to that mark. Therefore, although not a part of the statute, an ITU application has a great sig-

36 Contrary to the Supreme Court's interpretation, English judges refused to recognize a registrant's right to the exclusive use if a showing was made that the mark had never been properly registered in the first place. See Park N' Fly v. Dollar Park and Fly, 469 U.S. 189, 209 n.8 (1984) (Stevens, J., dissenting).
38 JONATHAN REEVE, MANAGING BUSINESS RISK: A PRACTICAL GUIDE TO PROTECTING YOUR BUSINESS 159 (2005) (stating that not only is it necessary to register a trademark, but it is also imperative that a company monitor the marketplace for infringing competition and take action when necessary).
39 The reasons cited for instituting the intent-to-use system were to eliminate foreign advantage in U.S. trademark registration, to increase overall value of the U.S. trademark system, and to bring the U.S. trademark system up to speed on current business practices around the world. S. Rep. No. 103-515, at 5 (1988), as reprinted in 1988 U.S.C.C.A.N. 5577, 5581. The intent-to-use notion was proposed multiple times throughout the 20th century but had been held unconstitutional in United States v. Stiffkey, 100 U.S. 82 (1879) due to the lacking "use in interstate commerce" requirement. See Sheldon Klein, Trademark Law Bill Signed Improves Protection in Registration Rules, 11 LEGAL NEWS, May 30, 1988, at 16.
42 Unlike patent and copyright protection which are expressly provided for in the Constitution, U.S. trademark protection is derived from the Constitution's commerce clause. U.S. Const. art. I, § 8 cl. 3.
significant deterrent effect for the ITU claimant. As firms are naturally conflict adverse, once a mark with prior ITU rights is discovered in a trademark search, firms will work around such an ITU application, even if no use is ever made. Because the ITU registration gives the applicant three years in which to use the mark, during that three year time period, a third party will not know if actual use will ever occur. As such, that third party would likely steer in a different direction, even if use of the ITU applicant was never to be realized. That is, to risk adverse firms, the ITU system has a real and specific effect, even if all statutory rights are subject to use in actual commerce.

Through the ITU system, trademark rights in the United States have expanded. Without recognizing it as such, the United States has taken a large step toward harmonizing how trademark rights are created. Most Civil Law systems create trademark rights upon registration, not upon use. In fact, the ITU system is largely in line with all civil law nations, as use is not required in civil law countries prior to or as a “contingent” of registration. Even though harmonization was not a stated goal for the ITU system when debated by Congress, it does result in a serious expansion of the trademark right and continues the inextricable trend of expansion.

C. Dilution

In 1996, the Federal Trademark Dilution Act (FTDA) was signed into law by then President Clinton. This law did more to expand American trademark law than any other act of Congress. The FTDA allows a holder of a famous mark the ability to enjoin the use of the same or similar mark on completely unrelated goods or services. Under traditional trademark jurisprudence, before a cause of action for trademark infringement will lie, the defendant has to be in competition with the plaintiff.

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44 See CHIN, supra note 43, at 37 (stating that a trademark search is “appropriate, and possibly necessary” to avoid costly and time consuming conflicts with other potential mark holders); 3 MCGARRY ON TRADEMARKS AND UNFAIR COMPETITION § 156 (4th ed. 2010) (advising companies to “obtain a preliminary determination as to possible conflict with previously used but unregistered marks, applied-for marks, and registered marks”).
45 Although six months is the initial prescribed time period in which to use the mark in commerce an additional thirty months of extension may be granted to the mark holder for a mere showing of good cause and payment of the requisite fees. 15 U.S.C. § 1051(h)(2008). Additionally, even in the event of inappropriate extension request protocol, a mark holder may still redeem him or herself by simply showing that the delay was unintentional. 15 U.S.C. § 1051(d)(4)(2008).
46 Shokaichi [Japanese Trademark Act] Law No. 127 of 1957, art. 18. “A trademark right shall subsist upon its registration.” (Translation by author)
47 See e.g., Clark W. Lackert, Global Trademark/Copyrights Practice Protection and Enforcement Issues in Patents, Copyrights, Trademarks, and Literary Property Course Handbook Series, 171, 201 (1997). Examples of Civil Law countries that determine trademark rights by registration instead of use include Germany, Japan, France, Spain, Italy, Korea, China, and Latin America. Id. Although registration is not contingent upon use in these countries under specific limited circumstances trademark rights can be acquired through use alone. Thomas J. Hoffmann, Advanced Seminar on Trademark Law in Patents, in COPYRIGHTS, TRADEMARKS, AND LITERARY PROPERTY COURSE HANDBOOK SERIES, 253 (1995)(noting that in Japan a party seeking trademark rights through use must show a major portion of the public must be aware of the mark and in Germany more than 50% of the public must be aware). See also, Article 5, Algerian Ordinance relating to Trademarks, No. 66-57 March 19, 1966, Article 18 Japanese Trademark Law No. 127 Apr. 13, 1958; Article 59, Brazilian Trademark Law No. 5772 Dec. 21, 1971.
49 15 U.S.C. § 1125(c) (2008). The FTDA allows the holder of a famous mark injunctive relief when an unauthorized use of the mark causes dilution by either “blurring” or “tarnishment.” Id. The FTDA, however, limits the action to marks which are famous. A famous trademark is one that is “widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner.” 15 U.S.C.A. § 1125(c)(2)(A) (2008).
or within the natural zone of expansion of the plaintiff.\textsuperscript{50}

For example, although Kodak brand pianos do not infringe the KODAK mark, it does dilute the KODAK mark.\textsuperscript{51} Dilution, we are told, is defined as the lessening of the capacity of a mark to distinguish itself.\textsuperscript{52} That is, the mere existence of another KODAK mark in the world reduces the famous Kodak Company’s ability to distinguish itself. Therefore, it is actionable, even though there is demonstratively no confusion possible.\textsuperscript{53}

Some have claimed that dilution makes the trademark subject to property ownership.\textsuperscript{54} Some have argued that it makes the trademark subject to copyright-like protection.\textsuperscript{55} Some argue that it is necessary as marks evolve and become famous they must be protected them from freeloaders so that firms will continue to make the investment in the marks.\textsuperscript{56} No one argues however that this was part of the original common law of trademarks. Everyone agrees that it is an expansion of the United States trademark right.

\section*{D. ACPA}

The Anticybersquatting Consumer Protection Act (ACPA) also expanded American trademark jurisprudence. The ACPA was enacted to prevent cybersquatting, the act of using someone else’s trademark as a domain name.\textsuperscript{57} The ACPA’s protection was intended to provide a cause of action for the registering someone else’s trademark as a domain name in bad faith.\textsuperscript{58}

The ACPA also created in \textit{rem} jurisdiction. This allows a harmed trademark owner to sue the domain name itself in the event the domain name registrant provides the relevant Registrar with a false name or address.\textsuperscript{59}

\begin{thebibliography}{9}
\item See Lynda J. Oswald, \textit{Article: "Tarnishment" and "Blurring" Under the Federal Trademark Dilution Act of 1995}, 36 Am. Bus. L.J. 255, 259 (1999) ("The traditional cause of action under trademark law is for infringement, which has its basis in the past of common law torts. Trademark infringement occurs when one party (the junior user) uses a trademark (the senior mark) that is identical or substantially similar to the existing mark (the senior mark) of another user (the senior user) on competing goods, such that prospective purchasers are likely to be confused, mistaken, or deceived as to the identity or source of the goods involved.").
\item See Federal Trademark Dilution Act (TDA), Pub. L. No. 104-98, §§ 3(a), 4, 119 Stat. 985, 985-86 (codified as amended at 15 U.S.C. §§ 1125, 1127 (2008). The TDA defines dilution as "the lessening of the capacity of a famous mark to identify and distinguish goods or 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." Id.
\item See Lynda J. Oswald, \textit{Article: "Tarnishment" and "Blurring" Under the Federal Trademark Dilution Act of 1995}, 36 Am. Bus. L.J. 255, 262 (1999) (comparing dilution to the tort of trespass; like trespass, dilution is based upon an injury to the trademark holder and the unjust enrichment of the party diluting the mark).
\item See H.R. Rep No. 104-374 (1995), reprinted in 1995 U.S.C.C.A.N. 1029, 1033 (stating that TFDA was created by Congress in part to "encourage trademark holders to invest in their marks to achieve the famous mark status and to recognize the investments that mark holders have made in making their marks famous."); JEREMIE GILSON, \textit{TRADEMARK PROTECTION AND PRACTICE}, § 5A.01[4] (4th ed., Matthew Bender ed., 4th ed., 2004). "The abundant goodwill and consumer loyalty inspired by a well-known mark is "the essence of many a successful business" and federal dilution laws protect the substantial investment necessary to advertise and promote the mark." Id.
\item Id.
\end{thebibliography}
In expanding trademark law in such a way, Congress has made the possibility of legitimate concurrent uses much less likely and consequently given more control to the holder of the trademark. This control which permeates cyberspace is similar to the general concept of moral rights which instill an enduring element of control in the creator of a work over their creation.

E. Expansion of 43(a)

The expansion of Section 43(a) claims under the Lanham Act are rather notorious. Section 43(a) was first used to protect the shape of the Coke Cola glass bottle. It has since been used to protect everything from the inside of a Mexican restaurant and its "festive eating atmosphere," to the green-gold color of press pads in the laundry industry, to the NBC chimes, to the vertically opening motion of a Lamborghini car door.

In Qualitex v. Jacobson Prods., the Supreme Court held that "any" name, symbol, or device that denotified the source or origin of some good or service could be a trademark. The court relied on the word "device" to conclude that even the smell or color of a product could be a trademark if it indicated the source of that good. Of course, relying on the word "device" for these purposes is historically inaccurate. Originally, the word "device" meant a design mark, not anything under the sun.

There is no doubt that Section 43(a) has resulted in an expansion of trademark protection in the United States. In 1947, there were few so-called nontraditional trademarks which relied on Section 43(a) for their existence. Since Qualitex in 1995, states were

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63 Registration No. 1057884 (Feb. 1, 1977), previously 0696147 (Apr. 12, 1980).

64 Taco Cabana Inl'l., Inc. v. Two Peso, Inc., 932 F.2d 1113, 1117 (5th Cir. 1991), aff'd, 505 U.S. 763 (1992).

65 Registration No. 3637711. See also Qualitex Co. v. Jacobson Prod. Co., 514 U.S. 159 (1995) (resolving a disagreement among the courts of appeal as to wherether a color alone may be recognized as a valid trademark).

66 Registration No. 69/6522.


69 "Since human beings might use a "symbol" or "device" almost anything at all that is capable of carrying meaning, this language, read literally, is not restrictive... It a shape, a sound, and a fragrance can act as symbols why, one might ask, can a color not do the same?" Id. at 162.


71 Specifically the Trademark Revision Act of 1988's use of the words "symbol and device," which an accompanying Senate Report states were employed "so as not to preclude the registration of colors, shapes, sounds or configurations where they function as trademarks." S. Rep. No. 100-515, at 41 (1988), available at http://www.cipmall.info/hosted_resources/fta/trademarks/PrnclhmanAct.697.SR.100-515.pdf. "The definition of 'trademark' is broadened to reflect contemporary marketing practices..." Id.

there have been 688 trademark applications for nontraditional trademarks (excluding product configuration or product packaging, the original justification for Section 43(a)). Of course, relying on the word "device" for these purposes is historically inaccurate. It has reached such a bizarre extent that one person was even encouraged to apply to register his own DNA sequence.

III. Moral rights

Much is made of the moral right in the world of copyright. Much more is made of whether the United States should or does comply with its treaty obligations under the Berne Convention that mandates the protection of some moral rights. The protection of moral rights as such fundamentally sets the Civil Law apart from the Common Law of copyright. Moral rights include rights of attribution, integrity, divulgation and withdrawal.

In countries that recognize moral rights, for example, it is a violation of the moral right of integrity to colorize motion pictures if the original author objects. One way of expressing this difference is that the Civil Law recognizes the personality of a work, while the Common Law only recognizes an economic interest in the work.

Although the moral right was originally saved for individuals and not corporations, some countries, such as Japan, consider a corporation a juridical person and, as such, recognize a corporation's ability to maintain and enforce moral rights. As such, it is not inconsistent to express a corporation as an owner of the moral right of trademark.

This distinction in copyright between Civil Law nations such as France and Japan compared to the United States is quite remarkable. It leads to many international disputes regarding the appropriate scope of the copyright.

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72 See id. at Appendix E. After Qualities Co. v. Jacobson Prod., Co., 514 U.S. 159 (1995), the average nontraditional trademark registrations went from less than 2 per year to nearly 50 per year. Despite this increase, nontraditional trademarks still only comprise less than 2/100th of a percent of the total trademark applications. See id. at 4. See also Nick DiSpigny, Note, Post-Dilloway-Futurist Let's Call it Whole Thing Off: Trademark Protection of Product Sounds, 60 COmL. REV. 797, 803 n.20 (2003) (showing that the percent of nontraditional trademarks that cannot be perceived visually was 0.0027%).

74 Registration No. 76019624 (filed Apr. 3, 2003; abandoned Jan. 21, 2002). See also Frank "Dr. Future" Ogden's website available at http://www.drumorenow.com/feature/atnightsgoods.html (last visited Sept. 15, 2010) (stating his belief that registering his DNA gene sequence as a trademark is necessary to prevent "reproduction including the production of humans, clones, survival machines, or futuristic animals").


78 MELVILLE B. NISSEK & DAVID NISSEK, NISSEK ON COPYRIGHT, § 8D/01.

79 I do not intend nor do I think it necessary to take sides in the debate regarding whether the moral right should be protected separately from the copyright laws of any jurisdiction (monist view) or whether they should or any best conceived of as part of the copyright regime of any jurisdiction (dualist view). I am merely making the general claim that moral rights protect the personality of a work and that trademarks in the United States have taken on a personality that Congress at least seems to think is worthy of protection. See generally, Cyrill P. Rigamonti, The Conceptual Transformation of Moral Rights, 55 ASU. J. COMM. L. 67, 73-76 (2007).


A similar distinction exists in trademark between Civil Law countries and the United States. The trademark right in Civil Law countries is usually justified as a property right. It is accepted that the trademark is subject to property ownership. Conversely, in the United States, the trademark jurisprudence heretofore has been recognized as a right of exclusion based merely on priority of appropriation. One owns the right to exclude others from marks which one has priority to, but does not own the mark itself.

As I predicted it would in 1994, the concept of dilution has driven a major sea-change in American trademark jurisprudence. The trademark right in the United States has slowly come to be far more similar to the nature and extent of moral right protection, rather than the mere right to exclude. Now, the United States recognizes the personality of a trademark and the Civil Law nations continue to recognize it as an economic right. The significance is that, once again, the Civil Law and the United States do not share an understanding of what a trademark right confers. Therefore, the basis jurisprudence of American trademark law and that of the Civil Law remains disparate.

The moral rights doctrine is a very broad idea that is said to protect the “personality” of a work. This doctrine gives the author the right to claim authorship of a work (right of attribution or right of paternity); the right to object to changes, modifications, or bastardizations of the work (right of integrity); the right share or not share a work with the public (right of divulgation); and the right to remove a work from the public after publication (right of withdrawal). Moral rights protect the “personal, intellectual, and spiritual interests of the author.” The notion is that the author merges him or herself with the work and as such the work becomes part of their personality. As such, just as one may not sell part of your body, one cannot alienate a moral or personal right in a work. My contention here is that as the trademark grows in strength and stature, lower courts and the United States Congress have come to protect the mark as a personality worthy of protection as it were a work of the creator.

As the United States trademark right expands in scope, this notion can apply to describe the functioning of the United States trademark right. Although the moral right is inalienable in most coun-

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83 The Trademark Cases, 100 U.S. 92, 94 (1879): “At common law the exclusive right to it grows out of its use, and not its mere adoption. By the act of Congress this exclusive right attaches upon registration. But in neither case does it depend upon novelty, invention, discovery, or any work of the brain. It requires no fancy or imagination, no genius, no laborious thought. It is simply founded on priority of appropriation.” For an excellent review of this debate, see Simone A. Ross, Will Aliens Strong? Dilution Protection for “Famous” Trademarks: Anti-Competitive “Monopoly” or Earned “Property” Right?, 47 B.U. L. Rev. 653 (1997). See also, David S. Weisbrot, Reexamining Trademark Dilution, 44 Vand. L. Rev. 531 (1991); Milton W. Handler, Art State Antidilution Laws: Not Compatible with the National Protection of Trademarks, 75 Trademark Rep. 269, 271 (1985).
84 United Drug Co. v. Theodore Rectanus Co., 246 U.S. 90, 97 (1918): “There is no such thing as property in a trade-mark except as a right appertaining to an established business or trade in connection with which the mark is employed. The law of trade-marks is but a part of the broader law of unfair competition; the right to a particular mark grows out of its use, not its mere adoption; its function is simply to designate the goods as the product of a particular trader and to protect his good will against the sale of another’s product as his, and it is not the subject of property except in connection with an existing business.”
85 That a trademark dilution statute would create a copyright in trademarks that protect even the idea of a trademark, is precisely what has happened.
86 “Work” is the term for the object of copyright protection.
tries that recognize the moral right and, of course, the United States trademark is completely alienable, moral rights actually do describe the United States trademark right as to the immediate holder of that right, whether an original creator or an assignee.

A member of the Berne Convention is mandated to provide protection for two of these moral rights (attribution and integrity) and most Civil Law countries do. There is great debate about whether or not the United States in compliance with this requirement even though it ratified the Berne convention in 1989.

The phrase droit moral ("moral right") was first used as a legal term of art by the prominent French jurist André Morillot in 1878. In Cinquin c. Leocq before the Cour de Cassation, Morillot asserted that the property rights of an artistic work under copyright was not community property between spouses, but rather belonged solely to the creator. This concept grew out of the philosophy of individualism that thrived in France following the French Revolution. Although the court disagreed, the court did recognize that the artist-husband alone possessed distinct moral rights over his creation.

Following this acknowledgment, European courts struggled over which two German philosophies to adopt: Immanuel Kant's monist system or Georg Wilhelm Freidrich Hegel's dualist system. Kant's model revolved around the concept that a work of art is not merely an external object, but rather is an expression of the creator's personality. Hegel's conception differed in his belief that the work itself is necessary for the manifestation of the artist's personality; therefore the artistic work is property to which the artist's personality is inseparably attached. In the early 1900's, German Jurist Joseph Kohler further developed Hegel's theories defining how an economic right in the artistic creation may simultaneously co-exist with

93 Civ., June 25, 1902, D.P. 1903.15.
99 Id. at 371.
the personal rights in its creator. Morilpot argued under the dualist concept, and after court's decision in Cinquin Lecocq, this notion prevailed in France.

Some moral rights scholars would dismiss the argument that trademarks in the United States have become subject to protection akin to moral rights out of hand. However, those who dismiss are talking about what trademark jurisprudence formerly was or what it ought to be, not what it has become.

A. Attribution

The moral right of attribution is "perhaps the most important moral right." The right of attribution allows an author to claim a work as their own. This claim gives an author the ability to object, essentially, to a likelihood of confusion over the source of a work. In Europe, this is known as the right of paternity. It allows an author to claim or not claim that he/she is the author of any given work.

This is most analogous to the source denoting function in trademarks. The source denoting function tells a purchaser from where a product emanates. In fact, "[i]t is the source-denoting function that trademark laws protect, and nothing more." As we shall see, the American trademark right has come to protect far more than the mere source denoting capacity of the trademark.

The right of attribution first had roots in ancient Rome, which recognized the growing problem of plagiarism. To provide relief to the angry authors, a cause of action known as plagium, meaning "the crime of stealing a human being" was created in the first century A.D. As the Roman Empire declined and Europe plunged into the dark ages, these concepts bowed to the authority of the Catholic Church, which gave little or no attribution to individual artists. It wasn't until the Renaissance era when these rights began to reappear. In 1498 Michelangelo Buonarroti was commissioned by a French cardinal to create La Piatà, depicting the body of Jesus on the lap of his mother Mary after the Crucifixion, as a tomb monument in the chapel of St. Maria della Febbre in St.

100 Id. at 372.
102 ROBERTA ROSENTHAL KWALL, THE SOUL OF CREATIVITY: FORGING A MORAL RIGHTS LAW FOR THE UNITED STATES 88-89 (2010) ("Trademark law is concerned with preventing consumer confusion, a concept totally unrelated to the authorial interests encompassed by moral rights.").
107 Bird, supra note 102, at 413.
Peter’s Basilica. The work was instantly recognized as one of the greatest sculptures ever created, but when a group of locals crowded in admiration, Michelangelo overheard one of them credit the work to Cristoforo Solari, another sculptor. That night, under the cover of darkness, Michelangelo crept back into the church and asserted his right of attribution by carving MICHAELANGELO BONAROTUS FLORENTINUS FACIEBAT (“Michelangelo Buonarroti, Florentine, made this”) on the sash running across Mary’s chest. This was the only work he ever signed.

The trademark right of source denoting has become analogous to the moral right of attribution. Today, when trademark users apply their marks to their goods or services, trademark jurisprudence supports their claim as if it were carved in stone. Source denoting has become much more significant than merely letting consumers know from where a product emanates. Now, a famous mark can exclude all uses of noncompeting marks that do not confuse. Now, a holder of a trademark can prevent its registration as a domain name even if there is no confusion. Since the inception of incontestability, the holder of an incontestable mark may prevent others from using it even if it merely descriptive and therefore no trademark at all. In this way, holders of trademarks have come to hold something that seems akin to the moral right of attribution for their marks.

B. Integrity

The moral right of integrity protects a copyrighted work from change or mutilation. This gives authors the exclusive right to display their work in the original form and protects against any distortion of that original expression. “To deform his work is to present him to the public as the creator of a work not his own, and thus makes him subject to criticism for work he has not done.”

The best example of the right of integrity in operation is the battle over the colorization of movies. When a French television station, La Cinq, gained purported rights (from an assignee of the copyrights) to colorize John Huston’s The Asphalt Jungle, his heirs filed suit claiming a violation of their father’s moral right of integrity. Although Huston’s heirs lost the case at the lower court because the court found that the television company did not colorize the original copy of the movie, the French Supreme Court reversed and found Huston’s right of integrity infringed because Huston had created the movie. The Court ordered some
$100,000 in damages to be paid to the Huston heirs and that the colorized film be destroyed.  

The right of integrity is very analogous to the dilution prevention right in trademark law. For example, a Paris District Court prohibited a director from putting on the play, Waiting for Godot, casting all actresses because it interfered with the playwright’s intention that the roles be played by men. The court’s decision was grounded in the desire to protect the playwright’s moral right of integrity which would have been violated had the director tainted the nature of the play by using all actresses.

Also, an Indian court found that the destruction of a publically recognized sculpture amounted to mutilation of the sculptural work and consequently a violation of his moral right of integrity regardless of the location at which the destruction took place.

The right of integrity is very analogous to the dilution right in the United States. Now, selling Kodak brand pianos violates the integrity of the famous Kodak brand. The mere fact that another Kodak is on the market lessens the capacity of Kodak to distinguish itself in the minds of potential consumers, just as a moral right artist has the right to protect the integrity of his/her work. Buick brand aspirin, we are told in the legislative history, dilutes the famous mark for an automobile. If Buick can prevent a third party from naming their aspirin “BUICK”, far more is going on than the right of exclusion. Here, it is only theoretically justified if one accepts that the automobile manufacturer’s right of integrity is being violated. That is, the very integrity of the aura surrounding the mark BUICK is destroyed. When the association is made with aspirin, the former distinctiveness of the mark BUICK is lessened (or destroyed). To allow the owner of BUICK to prevent this destruction allows that entity the right to prevent damage to the integrity of the mark.

As such, the trademark BUICK is now protected as if it were appropriate subject matter of the moral right of integrity.

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119 The Huston heirs were awarded $74,000 from Turner Entertainment and $37,000 from France’s Channel 5. Firm Fixed for Colorizing ‘Jungle’, ROCKET MUS. NEWS, Dec. 29, 1994 at 16D.

120 Bird, supra note 102, at 439.


122 Although this action was brought by the estate of playwright Samuel Beckett, during his lifetime he denied all requests for permission to deviate from the all male cast except one. The only exception was for Frau Osterkamp who wanted to use a female cast for a production at the 1988 Berlin Festival. Beckett’s authorization was conditioned on the audience’s understanding of his complete disapproval of the modification. Later in 1988, a Dutch theater produced the play with a female cast and without Beckett’s permission. When Beckett pursued legal action in the Netherlands, the judge ruled in favor of mixed gender casting and found the play to be too true to its original form despite including women. Outraged at this result, Beckett banned production of all of his plays in the Netherlands and amended his contracts with other countries to disallow any modifications to the play or the stage directions. See William Hutchings, Samuel Beckett’s Waiting for Godot: A Reference Guide 93 (Prager Publishers 2005).

123 In addition to the artist’s moral right of integrity, the court held that mutilation of the sculpture violated the integrity of the piece in relation to Indian culture because the sculpture had become a public emblem of Indian heritage. Sehgal v. Union of India (2010) 36 P&F 350 (2005).
IV. Tension between the Courts and the Congress on Trademark Jurisprudence

A. Dilution

Primarily at the Supreme Court level, there has been much tension between the Court and Congress as to the scope of the trademark. The best example of this is the Victoria's Secret case. In that case, the Supreme Court held that a claimant of dilution had to show that its mark was "actually diluted," a "likelihood of dilution" was not enough. Without saying what precisely (other than a presumption that absolute identical marks would be enough) constituted "actual dilution," the Court changed the analysis of when a trademark right was harmed. Up to that point, the test had always been a "likelihood of infringement." To change this to a requirement that the claimant had to show evidence of actual harm, when the alleged harm from dilution is remarkably speculative at best, was to nearly extinguish the cause of action. In the reported cases, after the Victoria Secret case, the number of cases plummeted.

However, Congress, at the behest of Limited Brands, Inc., Victoria's Secret PAC and Jack Valenti, the most influential lobbyist in the 2006 election year, expressly overruled the Supreme Court in the Trademark Dilution Revision Act (TDRA) of 2006. According to the TDRA, the appropriate standard of when a mark is diluted is now a "likelihood of dilution." Not surprisingly, the number of cases based on a dilution claim has rebounded.

124 Moseley v. V Secret Catalogue, 537 U.S. 418 (2003). In the opinion the court went out of its way to hint that "expansion of trademark law beyond its usual boundaries was not the product of a careful legislative process that considered its effect on other intellectual property regimes." David S. Wallbank, The Supreme Court and Trademark Law in the New Millennium, 20 WM. MITCHELL L. REV. 1639, 1766 (2004). See Moseley, 537 U.S. at 429 ("Unlike traditional infringement law, the prohibitions against trademark dilution are not the product of common law development, and are not motivated by an interest in protecting consumers."). The opinion goes on to discuss how dilution was first considered in 1985, but was deleted for concerns of non-compatibility with the First Amendment. When the dilution was finally added in 1995, the hearing was limited to a single day and no opposition to the bill was raised. Id. at 431.

125 Id. at 433 (stating that ambiguity within 15 U.S.C. §§ 1125(c)(1), 1127 confirmed the (Supreme Court's) conclusion that actual dilution must be established.").

126 See Marc L. DeHoffe, Sarah Silbert, Christopher Hillison, Article: Life After Mosely: The Trademark Dilution Revision Act, 16 Tax.

127 See Marc L. DeHoffe, Sarah Silbert, Christopher Hillison, Article: Life After Mosely: The Trademark Dilution Revision Act, 16 Tax.


130 Louis Varlot-Mollier et al. v. Haute Diggity Dog, LLC, 517 F.3d 252, 264 n.2 (6th Cir. 2007) ("Congress amended the TRDA principally to overrule Moseley and to require that only a likelihood of dilution need be proved."). See also V Sector Catalogue, Inc. v. Moseley, 605 F.3d 392 (6th Cir. 2010) (affirming summary judgment for Victoria's Secret; after twelve years in the legal system, finally the case is closed). "The provisions of the Trademark Dilution Revision Act of 2006, 15 U.S.C.S. § 1125(c), change the test for dilution by tarnishment from an "actual" to only a likelihood of harm to the "reputation" of the senior mark." Id. at 385 n.1.

131 By 2007 the number of federal dilution lawsuits nearly tripled, going from an average of 8-5 cases to twenty-one cases per year. See The William Mitchell Study on Trademark Litigation, available at http://www.wmitchell.edu/intellectual-property/Mitchell-Study-on-Trademark-Litigation/.
B. Fair Use
In KP Permanent Makeup v. Lasting Impressions I, Inc., the Supreme Court attempted to further restrict the expansion of the trademark right. There, the Court held that fair use (and therefore a finding of non-infringement) consisted of conduct where a third party used a descriptive mark descriptively. If this happened, there would be no infringement and the defendant would not be required to make a showing of a lack of confusion.

The fair use doctrine is yet to be countered by Congress. Perhaps they agree; perhaps there are more important issues on their plate. Regardless, the fair use doctrine may operate to provide the brake to the expansion of trademark jurisprudence that is required if we are to maintain balance between trademark holders and consumers.

C. Courts Resist; Congress Favors
Historically, lower courts were hesitant to expand trademark jurisprudence in the United States to the extent that Congress seemed to require.

In Mead Data Central, Inc. v. Toyota Motor Sales, U.S.A., Inc., the Second Circuit overturned a finding of dilution because the marks LEXUS and LEXIS were not similar enough. In Fruit of the Loom, Inc. v. Girouard, the Ninth Circuit refused to find a violation of the dilution act because FRUIT OF THE LOOM was not famous enough.

Over the 60 history of the Lanham Act, the total number cases that were reported peaked in 2002 at 101 cases. By 2006, this number had dropped to 53. The amounts of total damages and total attorney fees awarded has continued to decline since 2000 even though the total number

133 Although Lasting Impression I, Inc. had obtained incontestability on its trademark consisting of the words “Micro Colors,” relying on 15 U.S.C. § 1115(b)(4), KP Permanent Make-Up, Inc. (“KP”) maintained that their use of the same words in an advertisement did not constitute infringement because the words were necessary to accurately describe their product. The Supreme Court agreed with KP, ruling that such a use is fair. Id. at 114-15. See Sue Ann Mota, Article: KP Permanent Make-Up v. Lasting Impression—The Satisfying Defense of Fair Use Is Available in Trademark Infringement Cases Without Negating the Likelihood of Consumer Confusion, According to the Supreme Court, 30 Va. U.L. Rev. 327, 335 (2004) (“The Lanham Act was not meant to deprive commercial speakers of the ordinary use of descriptive words.”).
134 “[A]l plaintiff claiming infringement of an incontestable mark must show likelihood of consumer confusion as part of the prima facie case . . . the defendant has no independent burden to negate the likelihood of any confusion in raising the affirmative defense that a term is used descriptively, not as a mark, fairly, and in good faith . . . .” KP Permanent Make-Up, 543 U.S. at 124. Naturally, it is only after the plaintiff has made a prima facie showing that a defendant has a need for an affirmative defense. Id. at 125. Requiring the defendant to prove that the plaintiff cannot prove a required element prior to qualifying for the affirmative defense is no defense at all, and simply “would make no sense.” Id. Therefore, the court reasoned that there was no other logical way to interpret 15 U.S.C. § 1115(b)(4).
135 David S. Welkowitz, The Supreme Court and Trademark Law in the New Millennium, 30 WM. MITCHELL L. REV. 1659, 1700 (2004) (“The Court may be signaling that there are limits to Congress’s power to regulate these areas under the Commerce Clause, as opposed to the Patent and Copyright Clause.”).
136 879 F.2d 1026 (2d Cir. 1989).
137 See id. at 1031 (“Dilution theory presumes some kind of mental association in the reasonable buyer’s mind between the two parties’ uses of the mark . . . .” However, if a mark circulates only in a limited market, it is unlikely to be associated generally with the mark for a dissimilar product circulating elsewhere.) (quoting 2 J. McCarthy, TRADEMARKS AND UNFAIR COMPETITION § 24.13 at 213-14).
138 594 F.2d 1359, 1363 (9th Cir.1979).
139 Id. (finding that the Defendant's things and "beauties" adorned with plastic fruit and whimsically named "fruit laps" and "fruit cups" did not dilute the "Fruit of the Loom" mark). The generic term "fruit" alone is not famous enough to warrant protection. "Fruit of the Loom" gets its special force from the combination of the words "fruit" and "loom" used together. Id. at 1362.
141 Id.
of cases filed continues to increase.\footnote{\textsuperscript{153}} Although I have posited that the reason for this precipitous decline may be the fact that trademark owners are being over aggressive in filing lawsuits and thereby leading to many settlements,\footnote{\textsuperscript{144}} it may also be that the plaintiffs are settling the claims because they lack confidence in a litigated outcome. One way or the other, the data indicates that most cases end in a settlement. Only 1.3\% of all filed cases end in a trial on the merits.\footnote{\textsuperscript{140}} Perhaps the reason for such a high volume of filed claims and a low volume of fully litigated claims is uncertainty by both sides regarding what the precise parameters are of American trademark jurisprudence.

Of course, the tension between the Supreme Court and Congress regarding trademark jurisprudence is rather obvious. There have been many cases from Supreme Court in the last two decades. After culminating in the high water mark of Two Pesos, Inc. v. Taco Cabana, Inc.\footnote{\textsuperscript{148}} in 1992 and Qualitex Co. v. Jacobson Products Co. Inc.\footnote{\textsuperscript{152}} in 1995, there has been a clear retrenchment of the expansion of trademark rights by the Supreme Court.\footnote{\textsuperscript{146}}

First, in Wal-Mart Stores, Inc. v. Samara Brothers, Inc.\footnote{\textsuperscript{150}} in 2000, Wal-mart had intentionally and specifically usurped Samara’s design for children’s clothing. Wal-mart sent pictures of Samara’s clothing to its designer in the Philippines with instructions to copy it.\footnote{\textsuperscript{159}} In many of the pictures, Samara’s label was visible and Samara’s trademark was apparent.\footnote{\textsuperscript{151}} Yet, the Court found that the Lanham Act was not infringed because Samara’s clothing had not attained a secondary meaning in the market place.\footnote{\textsuperscript{157}} The Court dismissed Samara’s claim in a short, 11 page opinion and created new categories for trade dress protection. They determined that there were three types of trade dress: product design, product packaging, and a tertium quid.\footnote{\textsuperscript{160}} As Samara’s claim was categorized as product design, they were required to show secondary meaning where product packaging is protected without secondary
meaning. The tertium quid doesn't stand up to any sophisticated analysis.

Next, in TraffFix Devices Inc v. Marketing Displays Inc., in 2001, the Supreme Court held that road-side signs with spring loaded legs so they would stand up in the wind were functional and therefore not protectable trade dress. The Court held that the claimed trade dress was function because it was "essential to the use or purpose of the article." Through the functionality doctrine, the Supreme Court greatly restricted the expansion of the trademark right.

In Dastar Corp. v. Twentieth Century Fox Film Corp., the Court found that Section 43(a) of the Lanham Act could not operate as an alternative to copyright protection even though the plaintiff could establish that it was the successor in interest to the actual source of the video.

In Moseley v. Secret Catalogue, Inc., also in 2003, the Supreme Court held that the appropriate standard for a finding of trademark dilution was "actual dilution" rather than the far lesser standard of a "likelihood" of dilution. The Court resolved a debate regarding interpretation of the Lanham Act and whether the standard for dilution should be the same as the standard for infringement. The Court elected to use the higher standard and require actual harm to be show whether than a merely likelihood, the standard for infringement.

Finally, in 2004, in KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., the Court again restricted the trademark right at issue and determined that a registered trademark that was descriptive had to endure other fair uses of that mark so long as they amounted to a descriptive mark being used descriptively.

Therefore, put in this light, it is clear that the Supreme Court in the last decade has been attempting to reign in the trademark right.

In the mean time, Congress continues to expand trademark jurisprudence. Congress passed first the ITU statute, where a party's mere intent to use a mark can be preserved for three years. Congress passed the original dilution statute and then the Trademark Dilution Revision Act which expressly overruled the Victoria's Secret case.

Congress created the ACPA, allowing, for the first time in American history,

134 Id. at 216. See also id. at 213. "In the case of product design... we think consumer predisposition to equate the feature with the source does not exist... Consumers should not be deprived of the benefits of competition with regard to the utilitarian and esthetic purposes that product design ordinarily serves..."


156 Id. at 32 (quoting Inwood Laboratories, Inc. v. Ives Laboratories, Inc., 456 U.S. 844, 850, n.10 (1982)).


158 See id. at 37 (explaining that if the Lanham Act were interpreted to include protection of the originators of the video, rather than just those who produce reproductions of it for sale, § 43(a) would allow perpetual patents and copyrights—which is prohibited by Congress).


jurisdiction for a trademark cause of action to be found in rem.\textsuperscript{166} Additionally, the new act also contains provisions for statutory damages.\textsuperscript{167} Never before in the history of the United States had in rem jurisdiction for any trademark related cause of action been recognized. Never before in the history of the United States has statutory damages been recognized in a trademark case.

Therefore, it is safe to say that the Supreme Court and the United States Congress do not agree on the appropriate scope of trademark protection or, more generally, on precisely what the parameters of trademark jurisprudence are.

V. Normative Result: The US Protects the Personality of a Trademark

Therefore, the result of this is that the lower courts have been forced by Congress to recognize a new breed of trademark jurisprudence. This new breed of trademark jurisprudence is not set upon the trademark right being a right of exclusion where the claimant is allowed to enforce a mark to the extent that they use it and as long as they use it. This used to be called the Law and Prophets of trademark jurisprudence.\textsuperscript{166}

Instead, today, the personality of the trademark is protected. The source denoting function of trademark protection has been usurped by Congress. That right is now better described as the right of attribution. Trademark owners are no longer the owner of just a right to exclude others to the extent they use the mark and for as long as they use the mark. Now, the source denoting function of a mark has become a moral right of attribution: a personal right of the holder of the trademark.

When a famous mark is used on unrelated goods today, Congress and the lower courts claim that the mark as been diluted. However, there is no conceptual justification under the original trademark jurisprudence in the United States to support the notion of trademark dilution.\textsuperscript{169} It is fully supported if one accepts the moral right of integrity of a mark. Under this notion, any subsequent use by anyone on unrelated goods operates just like the moral right of integrity. The trademark owner has the absolute right to protect the integrity (Congress this the protection of distinctiveness)\textsuperscript{168} of its mark.

Therefore, the nature of trademark jurisprudence in America has changed. In the times of Learned Hand, it was a mere tort where harm in the form of confusion had to be alleged and proved before

\begin{itemize}
  \item \textsuperscript{168} Yale Elect. Corp. v. Robertson, 26 F.2d 972, 973 (2d Cir. 1928) ("The law of unfair trade comes down very nearly to this-as judges have repeated again and again that one merchant shall not divert customers from another by representing what he sells as emanating from the second. This has been, and perhaps even more now is, the whole Law and the Prophets on the subject though it assumes many guises.").
  \item \textsuperscript{169} Mosley v. V Secret Catalogue, Inc., 537 U.S. 418, 429 (2003) ("Unlike traditional infringement law, the prohibitions against trademark dilution are not the product of common-law development, and are not motivated an interest in protecting the consumers."); see also, Delflaque supra note 126, at 126 (citing the 1927 Harvard Law Review article written by Frank I. Schecter on which the foundation of our modern trademark theory lies).
  \item \textsuperscript{168} The Trademark Dilution Revision Act of 2006 explicitly provides protection for marks which are either inherently distinctive or those which have acquired distinctiveness, from dilution or diminishment of that distinctive quality. 15 U.S.C. § 1125(c) (Lanham Act § 42). Likewise, the moral right of integrity serves the sole purpose of protecting that same distinctive quality by limiting the public's ability to alter a given work. BLACK'S LAW DICTIONARY 675 (8th ed. 2010).
\end{itemize}
recovery could be had. Today, the personality of the mark is protected. The trademark holder’s personality (in the form of reputation) has merged with the expression of its trademark.

The primary problem with this is that the Constitution upon which the federal trademark right is based\(^\text{173}\) has not changed while the trademark right has gone through this metamorphosis. The Commerce Clause, has not changed. Therefore, actual commerce is still constitutionally required before federal trademark protection is authorized. Although the Lanham Act was selectively amended to make this metamorphosis possible, neither the legislative history nor the fundamental aspects of the Lanham Act have changed.

If the a trademark metamorphosis was desired, our society ought to go through some thought and introspection regarding the appropriate scope of trademark protection. The Lanham Act should not be changed to simply be responsive to some lobbyist’s demands\(^\text{172}\) or some specific company or industry’s concerns.\(^\text{173}\) The appropriate scope of trademark protection affects us all.\(^\text{174}\) As such, we all ought to be involved in the discussion, not just some Congresspeople who become convinced that some element of the Lanham Act needs tweaking. Over the last 20 years, this tweaking has transformed trademark jurisprudence in the United States from a tort in the form of a right of exclusion to an inalienable moral right where the personality of the trademark has an existence and that existence is ascribed to the holder of the mark and is protected as such.

The net result of the various amendments and the various lower court opinions is that the trademark right has been transformed. The lower courts have plenty of direction from the Supreme Court that the expansion of trademark jurisprudence should be slowed down. However, the lower courts seem to be embracing the notion of expansion of trademark rights focusing, instead, on the will of Congress even beyond what is literally required by the Lanham Act.\(^\text{175}\)

\(^{171}\) U.S. CONST. art. I, § 8, cl. 3.

\(^{172}\) The reasons suggested by manufacturers for extending protection of their famous marks were "(1) they had invested time and effort in cultivating these famous mark and thus deserved legal protection; and (2) other countries already had such prohibition and it was important that the United States not lag behind any nation in the strength of its intellectual property protections." William W. Fisher III, Geistiges Eigentum ein ausserordentlicher Rechtsbereich: Die Geschichte des Ideenschutzes in den Vereinigten Staaten in Eigentum im internationalen Vergleich [The Growth of Intellectual Property: A History of the Ownership of Ideas in the United States], VANDENHOECK & RUPRECHT 265, 283 (1999) (F.R.G); see H.R. Rep. No. 104-574, at 3 (1996), reprinted in 1996 U.S.C.C.A.N. 1029, 1030 (outing the ‘substantial investment’ made by various famous mark holders as a reason for the legislation).


\(^{174}\) How and to what end the scope of trademark protection affects all individuals of society is debatable yet the fact that it does is undeniable. Compare Deborah R. Garwood, Consumer Investment in Trademarks, 88 N.C. L. Rev. 427 (2010) (arguing that the public interest deserves more consideration when deciding trademark matters for the investment made by consumer through brand loyalty), and Kristen Fraboni, Does Dilution Make Trademarks into Unconstitutional Patents?, 12 J. Commerce: Legal Issues 180, 181 (stating that the PTDA authorizes a legal monopoly on a mark and impairs others ability to invoke use of that mark), with Mathew Stresen, The Rational Basis of Trademark Protection Revisited: Putting the Dilution Doctrine into Context, 13 FORDHAM INTELL. PROP., MEDIA & ENT. L.J. 375, 425 (2000) (arguing that for trademarks to continue to fulfill their economic purpose, protection against dilution is essential despite the potential anti-competitive result).

VII. Conclusion

Trademark rights in the United States continue to expand. The incontestability provisions of the original Lanham Act were an expansion not known to the common law. The ITU provisions, where an applicant can register his/her intent to use a trademark without actually doing so, changes the nature of the trademark system in the United States which, for over 200 years, has required actual commerce prior to Congressional action to provide federal trademark protection. Dilution law further extends the trademark right and allows trademark holders to prevent use of their mark by noncompetitors on noncompeting goods. Section 43(a) has gradually expanded over the entire life of the Lanham Act to now not only protect color alone as a trademark but even such things as the opening motion of a Lamborghini car door.

The result of this expansion is that American trademark jurisprudence has come to resemble the moral rights of attribution and integrity of the Civil Law world. This means that the trademark right is far stronger than it was in previous decades. This also means that it operates as a more effective sword in the world of corporate competition.

This entire expansion trajectory has happened slowly but inextricably behind closed doors. Congress has made incremental changes over the years that add up to the creation of a new trademark jurisprudence, one that resembles the moral rights of attribution and integrity rather than one honest to the historical roots of trademark jurisprudence. If the United States is to so fundamentally change our trademark jurisprudence, a broader debate is required.