

FIFTY YEARS OF TRADEMARK LAW
WHERE WE STAND AND WHAT WE SAW

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I.	THE SCOTUS CASES — AN INTRODUCTION.....	1
II.	SECONDARY LIABILITY FOR INFRINGEMENT; FUNCTIONALITY	3
III.	SECONDARY MEANING; INCONTESTABILITY	4
IV.	U.S.O.C. SPECIAL LEGISLATION PRECLUDES GAY OLYMPICS	5
V.	PARALLEL IMPORTS PROTECTION AXES TARIFF ACT PROVISION.....	6
VI.	UNITARY COLOR PROTECTED; REGISTRABLE.....	7
VII.	SOVEREIGN IMMUNITY	8
VIII.	DILUTION DECISION LEADS TO NEW STATUTE	9
IX.	NOT DEFENDANT’S BURDEN TO SHOW DESCRIPTIVE USE IS NOT CONFUSING; FAIR USE CONTEMPLATES SOME SOURCE CONFUSION	10
X.	“TACKING” IS A JURY QUESTION.....	11
XI.	SCOTUS RECOGNIZES ISSUE PRECLUSION FROM T.T.A.B. DECISIONS.....	12
XII.	PTO VIOLATED FIRST AMENDMENT WITH PROHIBITION AGAINST REGISTERING DISPARAGING MARKS	13
XIII.	PTO VIOLATED FIRST AMENDMENT WITH PROHIBITION AGAINST REGISTERING “IMMORAL OR SCANDALOUS” MARKS	14
XIV.	NON-BREACHING PARTY CONTINUES TO EXERCISE RIGHTS UNDER TRADEMARK LICENSE, DESPITE BANKRUPTCY	15
XV.	NO “DEFENSE PRECLUSION”	16
XVI.	NO NEED TO SHOW WILLFULNESS TO RECOVER PROFITS.....	17
XVII.	NO <i>PER SE</i> RULE AGAINST REGISTERING A “GENERIC.COM” TERM	18
XVIII.	STATUTORY AMENDMENTS	19
XIX.	U.S. JOINS MADRID PROTOCOL 2003; DO WE LIKE IT YET?.....	21
XX.	TRADEMARK MODERNIZATION ACT (“TMA”) 2020	23
XXI.	OTHER CASE LAW DEVELOPMENTS, SOME OLD — STILL THRIVING	24
XXII.	COURTS EXTEND SCOTUS PATENT RULE IN OCTANE TO TRADEMARKS TO ALLOW FEE SHIFTING IN EXCEPTIONAL CASES.....	30
XXIII.	PARODY	31
XXIV.	FAILURE TO FUNCTION — A T.T.A.B. DOCTRINE, INCREASINGLY APPLIED TO REFUSE REGISTRATION TO UBIQUITOUS TERMS.....	32
XXV.	STOP PRESS! THE T.T.A.B. FINDS FRAUD AGAIN.....	34

XXVI. PTO CAN'T REGISTER MARKS FOR GOODS THE FEDERAL LAW PROHIBITS;
 FARM BILL'S HEMP PROVISIONS YIELD TO FDA ON EDIBLES PER PTO.....35

XXVII. FEDERAL CIRCUIT'S NEW SIX-FACTOR TEST FOR SECONDARY MEANING
 AROSE FROM ITC CASE.....37

XXVIII. THIRD CIRCUIT GOES LITERAL ON FUNCTIONALITY IN COOKIE CASE38

XXIX. EXTRA-TERRITORIALITY GROWS EXTRA COMPLICATED: CERT. GRANTED 39

XXX. THE *ROGERS V. GRIMALDI* DOCTRINE MORE ROBUST THAN EVER: CERT.
 GRANTED.....41

XXXI. FICTIONAL ELEMENTS PROTECTED FROM OTHERS' COMMERCIAL
 EXPLOITATION (THE "OPPOSITE" OF A *ROGERS V. GRIMALDI* FACT
 PATTERN).....42

XXXII. NINTH CIRCUIT ALLOWS PTO DIRECTOR TO SERVE DISTRICT COURT CASE ON
 FOREIGN REGISTRANT43

XXXIII. EVOLUTION BUT NOT THE END.....44

ADDENDUM45

XXXIV. SCOTUS UPHOLDS *ROGERS V. GRIMALDI*, FOR NOW45

XXXV. SCOTUS UPHOLDS THE PRESUMPTION AGAINST EXTRATERRITORIALITY45

XXXVI. SCOTUS TAKES CERT: DOES REFUSAL TO REGISTER UNDER 15 U.S.C.
 § 1052(C)46

I. THE SCOTUS CASES—AN INTRODUCTION

Fifty years of trademark law, developments in rhyme
SCOTUS gave us many cases, some of them sublime

The SCOTUS topics run the gamut
Shapes and colors, Slants and Fuct
With deference to David Mamet
Let's see what play we can construct

As its trade dress was distinctive, thus inherent from the start
SCOTUS found protection in a restaurant, whose art
And theme were so distinctive that they functioned as a mark
Two Pesos changed the law on this, igniting quite a spark¹

But behold configurations! They require a good deal more
Namely, secondary meaning (lucky for the Wal-Mart store)²

If it's packaging it's easier to stake a trade dress bid
Two Pesos taught the trademark bar
The phrase "*tertium quid.*"

Yet shapes continued to confound
Does the thing work better round?

Or is it cheaper to build square?
For functionality — compare

Alternatives, or is that just
For special trade dress, where we must?
Where functionality's aesthetic
Colliding cases, so frenetic

Where the public comes to recognize
A product from exclusive use
Protected from all other guys
By patent, it would be abuse

To grant a trade dress on the look
Once patented for function

This SCOTUS simply would not brook
With any legal unctio

II. SECONDARY LIABILITY FOR INFRINGEMENT; FUNCTIONALITY

Two often-cited principles we find in *Inwood/Ives*³

A SCOTUS trade dress ruling, decades old but still it thrives

Infringement liability extends beyond mis-labelers
To entities in chains of sale who've acted as enablers

Inducing others to infringe the plaintiff's valid marks
Contributes to infringement and ignites judicial sparks

The doctrine's been extended to "blind" landlords who don't care⁴
And swap meet operators who must surely know what's there⁵

The other doctrine in this case arose from footnote 10
Defining functionality, but not explaining when
To look at it, what kind of facts, and several courts ignore it
Or blend it with some other tests; some scholars thus abhor it

III. SECONDARY MEANING; INCONTESTABILITY

The things we take for granted now derive from older cases
The lessons taught in *Park 'N Fly* once put us through our paces⁶

A registration's not a shield when marks become generic
Petitioning to cancel them is hardly esoteric

If a mark describes the qualities or attributes of what
The mark is for, we don't ignore the rules to make the cut

But "secondary meaning?" Well, by now we understand
What satisfies the screening for this status in our land

When a mark is incontestable it does enjoy a shield
A challenge to distinctiveness is barred, no need to yield

Yet "weakness" is a good defense despite the Sec. 15
To show a crowded field and such, the courts know what you mean.

IV. U.S.O.C. SPECIAL LEGISLATION PRECLUDES GAY OLYMPICS

OLYMPICS is a special word
That Congress did bestow⁷

And granted rights, you must have heard
Where others may not go

It doesn't matter if your use
Would not confuse a soul
No such excuse
For gymnasts or a
vaulter with a pole

Or, to the point, another group, combining it with GAY
Had no defense, couldn't scale the fence
Was not their lucky day.

The First Amendment was no bar to what the Congress passed
No GAY OLYMPICS name survived the SCOTUS treatment's blast.

V. PARALLEL IMPORTS PROTECTION AXES TARIFF ACT PROVISION

Call it parallel imports or gray goods, whichever
A trademark legit in a country not ours

May violate rights here, not once but forever
A Customs reg blessed what the Tariff Act bars

The Court struck the reg as the conflict collided
With language in Tariff Act's five-twenty-six

A long-applied section that's always provided
Protection for registered marks here, affixed⁸

VI. UNITARY COLOR PROTECTED; REGISTRABLE

A dry clean press pad widely sold
Was found to indicate one source
So its color, greenish-gold,
Could be a trademark to enforce

SCOTUS said, and we'll take heed,
For single colors you will need
To show a secondary meaning
SCOTUS, ruling on dry cleaning⁹

But wait — that case had plenty more
To teach us, so let's know the score:

If a feature is essential
To its purpose or its use
That alone kills its potential
As a trademark, it's cut loose.

A long phrase in that case has led
To chaos, and it still abounds
"Can't significantly disadvantage competitors" they said
"On non-reputational grounds."¹⁰
Is that for *every* trade dress claim?
Or just aesthetic appearance?
The outcome may not be the same
In trials (or in clearance).

VII. SOVEREIGN IMMUNITY

A Lanham Act's amendment sought to clarify the goal
That a state can't dodge infringement suits by pointing to its role

As a governmental body, with immunity from suit
By a five-to-four decision, SCOTUS gave this law the boot.

State sovereign immunity, not waved or abrogated
Cannot be tanked by Congress, though the Justices debated

And when the case was final, the minority checkmated
The College's misconduct could continue, unabated.¹¹

VIII. DILUTION DECISION LEADS TO NEW STATUTE

When SCOTUS said the law was plain
To prove dilution, you must show
Actual dilution — pain!¹²
Till Congress fixed the law, you know¹³

And now the test is “likelihood” and that can be adduced
With less than “actuality.” For plaintiffs, that’s a boost.

Dilution by blurring, and tarnishment too
Appear in the statute by name

Along with defenses
And how high the fence is

For parties to prove what they claim.

**IX. NOT DEFENDANT'S BURDEN TO SHOW DESCRIPTIVE USE IS NOT
CONFUSING; FAIR USE CONTEMPLATES SOME SOURCE CONFUSION**

If you want to have "makeup" tattooed on your face
And read law about it, then this is the place.

If you use another's mark to describe your business stuff
Like a feature of your product, then the plaintiff has it rough

You no longer have the burden to show your use is not confusing
That's the lesson of this case; if fair use, you'll not be losing.

A surprise that SCOTUS brought us in this tattoo makeup match
Some confusion re the source of goods won't flush you down the hatch
As long as your use is fair, as described in umpteen pages
You'll have wiggle room in there, that will guide you through the ages.¹⁴

X. "TACKING" IS A JURY QUESTION

Sometimes we think that SCOTUS has squandered
A chance to weigh in on an issue that's key

In *Hana Financial* some think that they wandered
To lay down some law no one cared much to see

The ruling was *juries* determined when tacking
occurred to give one side "priority one."

But most in our practice were left, frankly, racking
Our brains for the last time we needed this done.¹⁵

XI. SCOTUS RECOGNIZES ISSUE PRECLUSION FROM T.T.A.B. DECISIONS

In *B & B Hardware*,¹⁶ where SCOTUS decided
That issue preclusion could sometimes pertain

To full Board decisions, few courts have applied it
The issues? Too different — at least in the main.

**XII. PTO VIOLATED FIRST AMENDMENT WITH PROHIBITION AGAINST
REGISTERING DISPARAGING MARKS**

Simon Tam applied for
THE SLANTS¹⁷ for his musical group

The PTO denied for
2(a) but he jumped through each hoop

If it's government speech
Regulation can reach
And curtail what the message promotes
But that wasn't found here
Every Justice was clear
When they tallied their 8-0 votes

The disparagement clause
SCOTUS found without pause
Wasn't neutral in its point of view
And therefore, such flaws
Have no place in our laws
First Amendment applied, as you knew

Tam said the SLANTS name
Would serve to reclaim
A slur (none should have to endure it)

Did the Court understand
A word owned by one band
Doesn't enter the parlance to cure it?

XIII. PTO VIOLATED FIRST AMENDMENT WITH PROHIBITION AGAINST REGISTERING "IMMORAL OR SCANDALOUS" MARKS

After *Tam*, t'was no surprise the Court pitched out another
Section of 2(a), applied with tendencies to smother

Viewpoints spreading hate and bias
On topics applicants more pious

Were allowed without rejection
The record disclosed a collection

The section thrown out here precluded
"immoral or scandalous matter"
Applicant's FUCT was so lewd it
was barred by the former and latter

Provisions permitting selection
Of marks based on their points of view
And picking out those for rejection
That might offend me, them or you?

1A is offended
The statute, upended
And SCOTUS said that's it, we're through.

But in dicta it then was suggested
If Congress passed some kind of laws
To spell out just what was detested
That could fly without grasping at straws.¹⁸

**XIV. NON-BREACHING PARTY CONTINUES TO EXERCISE RIGHTS UNDER
TRADEMARK LICENSE, DESPITE BANKRUPTCY**

Trademarks in bankruptcy come with a twist
That some courts have looked at while other courts missed
The number of issues could make a long list
But here's a fact pattern 8 Justices kissed¹⁹

Good news for the non-breaching party (perhaps)
A rejection by licensor doesn't destroy
The licensee's right to continue, no lapse
But an unresolved issue remains to annoy

The SCOTUS result solved a split in the circuits
When a debtor goes bankrupt now how does its mark work, its
Good will is controlled by – well, we cannot tell that!
What becomes of a mark with no one to compel that?

XV. NO "DEFENSE PRECLUSION"

Since claim preclusion's long been a thing
Does "defense preclusion" grab a brass ring?²⁰

Is it a doctrine that should be applied
Preclusive effect — must it take just one side?
Or is plaintiff's new theory too bumpy a ride?
The Justices didn't exactly decide

Instead the Court narrowed its sites and it saw
A way to decide without making new law

No res judicata
The court found there was not a

Similar source of operative fact
No common nucleus put forth, intact

The timing was different, the marks differed some
Though both featured LUCKY they weren't in plumb

If luck be a lady
This wasn't her heyday
Lucky Brands tried but couldn't succeed in its run

XVI. NO NEED TO SHOW WILLFULNESS TO RECOVER PROFITS

In a 9-to-0 opinion, handbag hardware's trademark skillfully

Was infringed by Fossil, not a doubt, but not exactly willfully

Some jurisdictions said no profits thus could be awarded

While others said of course they can, in case law that's reported

In a short opinion SCOTUS ruled there was no need for showing

That infringing acts were willful, to grant profits that were owing²¹

XVII. NO PER SE RULE AGAINST REGISTERING A "GENERIC.COM" TERM

Is this a mark? Well now we know²²
Justice Breyer dissented though
While Covid meant they couldn't be near
We listened on the phone and so

Some of us might shed a tear —
Generic-dot-com, there's a fear
The PTO will have a stake
In registering "brew" for beer

Here was Justice Ginsburg's take:
The users won't make a mistake
It's not generic to consumers
Booking.com takes the cake

Why isn't this like "something, INC."
A precedent to make us think
Because we know (it's not just rumors)
The "one address" part is the link.

No per se registration rule
Can stand, and eight said that was cool
It's not like what we learned in school
It's not like what we learned in school

XVIII. STATUTORY AMENDMENTS

TRADEMARK COUNTERFEITING ACT OF 1984 (“TCA”)

The Trademark Counterfeiting Act of 1984
Codified *ex parte* seizures, difficult before

The Act made clear no notice was required for a seizure
But put protective rules in play, we can’t act at our leisure

The seizure is for counterfeits of marks that are the same
As plaintiffs’ registrations, both in goods and in the name
Or design if it’s a trade dress—know there isn’t room for sorta
So read the rules and follow them, just the way you oughta

Upon an affidavit and the posting of a bond
And evidence—the judge ain’t here to wave a magic wand
You’ll get to enter premises, computers, even drawers
To grab things per court order, although none of it is yours

The remedy is drastic
You can see the problem here
It is harsh, it’s inelastic
An odd part of our career.²³

TRADEMARK LAW REVISION ACT 1988 (“TLRA”)

In ‘88, with impact great
The TLRA came ‘round²⁴

To file without first proving use
No “token” shipments fast and loose
The benefits—how we effuse
Continue to astound

No need for investing
And big market testing
While hoping your mark is allowed
Instead we can file
And wait for awhile
Not cowering under a cloud

But three decades passed
And abuses amassed

Not just ITUs but from sections in treaties
Some filed in good faith from abroad by real sweeties
But others left Congress aghast

And so a new law has been passed²⁵

We'll tell you about it but first an example
Of problems we see as we search clients' choices
The junk that is crowding
Had some lawyers shouting
To Congress in frustrated loud outdoor voices:

**Disparate goods, the class fees spent
To claim the sun, the moon, the stars
And poisons to kill cockroaches, and parts for motorcars
And dentists' tools and costume gowns
To dance at every ball
Suggest the absence of intent
To use the mark at all²⁶**

XIX. U.S. JOINS MADRID PROTOCOL 2003; DO WE LIKE IT YET?

In 2003, the U.S. first joined
The Madrid Protocol, though we were behind²⁷

In coming aboard as the issues it posed
Were problems for us, that have never been closed

The concept's attractive — file once and you're done
Not too interactive — it felt like we'd won

A cheap and efficient system to file
For trademark protection sans spending a pile

But many have come to ignore it or hate it
The benefits seen in real life aren't great it

Has downsides arising from our unique system
Too many to mention, but I'll start to list 'em

In the U.S. we only have rights if we use
We cannot claim broadly for scissors and booze

If our use will be only for instrument cases
We cannot claim marks for sunblock for our faces

Our Madrid applications must follow our filing
Not claim broader goods and that's why we're not smiling

If we skip Madrid filing, retain local firms
We can claim with no use (or intent) on their terms

In countries of interest to file right there
For all goods in a class — their laws call that fair

What's next on the list of the things good to know
Before you give this kind of filing a go?

If your U.S. application's refused — or it issues
But is cancelled here? Curtains, the screen fades to black.

Your Madrid-filed marks will die too — get the tissues
That's what we call the collateral attack

You can re-file by country preserving your date
While the fees roil your stomach — like spoiled fish you ate

So if anyone asks if you want to commit
to filing next time per Madrid Protocol

Read up on the issues and ponder a bit
Before you set forth until you know it all.

XX. TRADEMARK MODERNIZATION ACT (“TMA”) 2020

THREE NEW WAYS TO CANCEL REGISTRATIONS FOR NON-USE²⁸

Congress gave us ways to clear the register of dross
By anonymous proceeding, do it right and you can toss
A registration not in use no standing is required
You must provide more than a hunch, real evidence, desired
If the mark you want to cancel was never used (how brash!)
You’ll seek “expungement,” ousting it, to kick it to the trash.
But if the mark is in use *now* though not at the right time
A “*re-examination’s*” what you’ll file to cancel for that “crime.”

REBUTTABLE PRESUMPTION OF IRREPARABLE INJURY RESTORED

A crown jewel in the TMA—the statute that’s providing
A presumption once the law but snatched away
In the Lanham Act residing
It’s rebuttable—though guiding
When infringement’s found
The plaintiff gets to say:
“Your honor, read the statute, now you must enjoin that fool
The harm he’s caused can’t be repaired with dough,
And the TMA’s your tool
Make this happen, don’t be cruel”
Now the courts apply this, everywhere you go.

The courts are happy with this law, it gives them the discretion
To enjoin the bad behavior with no extra proof or question

What rebuttal is persuasive?
The answer is delay
If the plaintiff seems evasive
That’s a point the courts will weigh.

XXI. OTHER CASE LAW DEVELOPMENTS, SOME OLD—STILL THRIVING

SURVEY SAYS: SAME LAW NOW AS “EVER”

Surveys changed the way we show a mark is likely to confuse
And if it’s famous or diluted, tractors, boats or running shoes

The tests don’t change for different kinds
Of goods, brands in consumers’ minds

Are what the tests purport to show
Although it’s difficult to know

So experts guide the courts’ reliance
Act as if this all were science

“Universe” they say and “noise”
“Creating marketplace conditions”
Wrong control group, other ploys
Methodology, suspicions

The experts’ jargon,
Oh the prattle
Cost? No bargain
In this battle

Two types of surveys, be on alert
For “EverReady,”²⁹ also “Squirt”³⁰

Their use depends in part on fame
Would buyers recognize the name
Of plaintiff’s brand, a market heavy
The experts point to *EverReady*

Otherwise, if an array
Is helpful to assess the hurt
The plaintiffs suffer (so they say)
The survey used is likely *Squirt*

And if the survey’s like a tale

A story penned by G. Flaubert
On motion, cite the holy grail,
The kiss of death we call *Daubert*³¹

WHEN GOLIATH COPIES DAVID: REVERSE CONFUSION

David and Goliath, can you guess who copied whom?
Reverse confusion's what it's called when many folks assume³²

The smaller one is trading on Goliath's mighty name
But there's a cause of action when Goliath is to blame

More damage from infringement is that Goliath's growing brand
Subsumes our David's luster so that David can't expand

If Dave sells perfumed candle gifts he cannot bridge the gap
Past Goliath's blocking potpourri and other scented crap

To add to this consumers think that Dave ripped off Goliath
Though Dave was first, the buyers snort: "How loudly Dave denieth"

They never think the mighty one could be the junior user
And that's reverse confusion, where the big one's the abuser.

FATAL ATTRACTION: INITIAL INTEREST CONFUSION

I knew where I was once I got there, Babe,
But I only went 'cause of you³³

I saw your name in lights
Aglow and like a moth I flew

I didn't understand
You weren't my favorite brand
Till I got there and saw that thing you do

Yeah, I knew where I was once I got there, Sugar
But I only went 'cause of you

I could turn tail and try to find the stuff I'd intended to
Buy before I tripped across your Brand X — as you knew
You're a cheatin' one, maybe I'm the fool
Are you on the run? Honey, that ain't cool —
The law's against you — it's infringement, too

Why the heck should I be hopping
To the real site when I'm shopping
It's just easier to give you all my dough
Though I'm not confused no more
I won't knock on one more door
That is why this stunt's illegal — cuz it's low

I knew where I was once I got there, Toots
But you still broke the law
Initially I was confused by the signage that I saw

It's a numbers game
some'll stay because they came
That's the nature of the claim, no win or draw

If you tried this by design
On the highway or on line

You'll get sued, and you're to blame, your fatal flaw

I knew where I was once I got there, Bae
Though I set out for a different store
With a name you stole to trick me, hey —
But I'm not really sore
I'll buy from you or maybe not
Depends on if I think you're hot
In some jurisdictions plaintiffs still have a shot
They'll nail you to the floor

AFTER PURCHASE: POST SALE CONFUSION

Another cause of action
That didn't exist before

Is confusion by third parties
Doesn't happen at the store

Doesn't happen on the internet
Or billboards or in ads

There's no party to the purchase
In the malls or on iPads

Instead the plaintiff must allege
A stranger to transactions

Will see a knockoff somewhere
It's a lawsuit of abstractions

It was meant to help brand owners
Where the buyer won't confuse

For ten bucks she sure understands
They're not THE red-soled shoes

The counterfeit "Armani"
No buyers really think

They're buying leather briefcases
For a twenty, with a wink

The concept is that passers by
Who see these items on display

On the knowing buyers' person
Will be confused and likely say

"I guess that brand is slipping —
It doesn't look too grand"

That "Rolex" on a stranger's wrist
"Bulgari" on each hand

There's an element of tarnishment
Some say you're quite the snob

To sue because somebody sees
Your brand—faked—on a slob

Try proving this — "the survey says"
A difficult arena

Because no buyer's in the chain
Of commerce to subpoena³⁴

**XXII. COURTS EXTEND SCOTUS PATENT RULE IN OCTANE TO
TRADEMARKS TO ALLOW FEE SHIFTING IN EXCEPTIONAL CASES**

What other developments worthy of mention
Has the trademark bar seen in our practice and toils?

Exceptional cases and fees get attention
The money awarded, the litigant's spoils

SCOTUS decided a patent case, that
Some circuits extended to trademark law actions

Some rushed to cite *Octane*. While others just sat.
Leading to frustrating forum-based factions.³⁵

So what is the test that fee shifters like best
To rely on if given their druthers?

To deal with abusers, the bully, the pest
Such a case must "stand out from the others"

An "exceptional case" is the standard to shift
The fees to the party who won.

For this definition there isn't a rift.
Circuits applied it; the 9th did, in *Sun*.³⁶

XXIII. PARODY

A defense to infringement and also dilution
Developing law has produced a solution

In *Chewy Vuitton*³⁷ and in *My Other Bag*³⁸
The Courts recognized the hilarity

Of these commentaries, the humorous gag
Sheltered each one, protected as parody

It's been hard to get courts to apply this to goods
Merchandise? Rarely "expressive."

But there have been paths leading out of these woods
With some courts being fairly progressive

A case of first impression featured LARDASH jeans (yes, merch)
There the Court acknowledged that the joke did not besmirch³⁹

The Jordache brand, despite the gag to glorify big rears
But afterwards, no product case for 35 more years

Till Tommy HoleDigger⁴⁰ prevailed, parodic pet cologne
No First Amendment product, but the SDNY's tone
Said Hilfiger should suck it up, and ruled as much with clarity
Allowing merchandise to riff another's mark as parody

Referencing the plaintiff's brand is vital to a parody
While making sure it's not the same — the humor's in disparity
While poking fun at plaintiff's one, with satire, in polarity
Gives tension in how close to come, success can be a rarity

**XXIV. FAILURE TO FUNCTION—A T.T.A.B. DOCTRINE, INCREASINGLY
APPLIED TO REFUSE REGISTRATION TO UBIQUITOUS TERMS**

SCOTUS told the PTO it was against the law
To withhold registrations based on points of view they saw

After The SLANTS, you probably heard
An Applicant company filed for a word

An N-word, for clothing, claiming the right
When the mark was refused, it continued the fight⁴¹

The grounds to refuse were “failure to function,”
When terms are widespread the Board lacks a compunction
To register them; they can’t indicate source
They’re routinely refused as a matter of course.

No viewpoint on content exists, so preclusions
For “failure to function” are fine as exclusions
The test — “is this term used all over the place?”
Like COVFEFE,⁴² Team Jesus,⁴³ and some words for race

The Board looked at evidence, more than enough
To prove the N-word was ubiquitous, sadly
Exhibits in suit were important, but rough
The Applicant lost, and it lost pretty badly.

The Board declined a registration⁴⁴
As it did the year before⁴⁵

With no diss or abrogation
For a word that some abhor

SCOTUS ruled that Sec. 2(a)
Was invalid based on viewpoint

But the Board had a good way
To reject here, with a new point

E. Brunetti won a case

SCOTUS struck the law before it
As offending on its face
The First Amendment (can't ignore it)

Erik filed again, as FUCK
The Board ruled it "failed to function"
As a mark. No love or luck
Would get his new term past this junction.

XXV. STOP PRESS! THE T.T.A.B. FINDS FRAUD AGAIN

After the Federal Circuit imposed⁴⁶
A fraud standard to overturn *Medinol*⁴⁷

The Board found no fraud, thought its options were closed

Wrote Opinions to mess with your head 'n' all

After a frustrating years-long hiatus⁴⁸
The Board's now found fraud in a couple of cases⁴⁹

Not feckless, just hard
"Reckless disregard"

Was its way out of irons, good choice
The Board reconciled *Bose*
By a new test it chose
And like Ariel, regained its voice.⁵⁰

**XXVI. PTO CAN'T REGISTER MARKS FOR GOODS THE FEDERAL LAW
PROHIBITS; FARM BILL'S HEMP PROVISIONS YIELD TO FDA ON EDIBLES
PER PTO**

The Lanham Act has many rules
But one of them does not

Confer a registration's jewels
On trademark words for pot

No brand for vaping dope, no bong
No product used by Cheech or Chong

Yet applicants keep getting wrong
The law on this—a lot!

The feds still ban each leaf and joint
But Applicants just miss the point!

They argue that so many states
Allow the sale of weed

And thus their registration fates
Are covered, stem and seed

They try to hide what they are claiming
"Herbs," perhaps they state

They file appeals, they're mad and blaming
But they'll have to wait

Until the feds bless sales of dope
The PTO holds out no hope.

So file away, the answer's NOPE.
No matter how inflaming.⁵¹

But what about the Farm Bill? As amended it's ok
To sell some hemp derivatives but wait—the FDA
Prohibits use of CBDs as additives, comestible

The PTO gives guidelines as to what is still contestable⁵²
The 9th Circuit found that delta-8, a kind of THC
Found in some vaping products is as legal as can be

Though not a registration case it's likely to inspire
More Applicants with names for goods that get the public higher.⁵³

**XXVII. FEDERAL CIRCUIT'S NEW SIX-FACTOR TEST FOR SECONDARY
MEANING AROSE FROM ITC CASE**

A bumper with diamonds and bars
Combined with two lines on a shoe
The "Chuck Taylor" trade dress (no stars)
In the ITC — then appealed too —

The Federal Circuit's Opinion
In the words of that document (long)
Said in writing from their dominion
The ITC got some things wrong.⁵⁴

Secondary meaning
Must exist in advance of the claim
In the cause that commenced our convening
A process to dish out the blame

They established a test of six factors
To probe if a mark is distinctive
The test has both fans and detractors
So read it—it isn't instinctive.

XXVIII. THIRD CIRCUIT GOES LITERAL ON FUNCTIONALITY IN COOKIE CASE

Speaking of the trade dress cases
Brought in every jurisdiction
Rules to put us through our paces
Functionality and friction

The tests can vary by the circuit
Sometimes seemingly by quirk it
Can be hard to give advice
It sometimes feels like rolling dice

Look at Pocky stick-shaped cookies, chocolate tipped to hold and share
Third Circuit found this “useful” —said there was no trade dress there⁵⁵

There’s more to analyze than that, so many of us cried
Despite amici (written peachy) *Cert.* here was denied

**XXIX. EXTRA-TERRITORIALITY GROWS EXTRA COMPLICATED: CERT.
GRANTED**

A 50 year look at our history
Requires no atlas or chart
To confront international mystery
When rights are asserted apart

From the places where owners are based
May they sue or be sued without borders?
Not a question to answer in haste
Say the courts in conflicting court Orders

We start with a bedrock foundation
Territorial rights are the norm
In the U.S., where use in our nation
Is required for trademarks to form

The exceptions pop up but not often
Their facts are compelling and strange

Causing courts looking at them to soften
Enforcing outside of the range

In a case that you know called *Gigante*⁵⁶
Concerning two grocery chains
The parties were worried *ex ante*
With the impact of cross-border lanes

The 9th Circuit made an exception
And reached 'cross the border in aid
Of preventing some public deception
By two neighbors engaged in close trade

Although there's no room to explore a
Long path to the outcome of sorts
That Bayer, when sued by Belmora
Defended in several courts
Could a mark not used here
Keep the Register clear

Follow this? It's like betting on sports⁵⁷

The weirdest we know
Enjoined Pirate Joe⁵⁸
Who bought TJ's products in Washington State

To resell he'd go
In disguise to lay low
Buying more than could fit on a platter or plate

He took it to Canada, reselling there
Trader Joe's sued him here and they won
Though the sales were all foreign
The 9th Circuit didn't care
About that or "first sale," and it's done.

There have been other cases with varying tests
To suss out the impact within the U.S.⁵⁹

A notion that started with *Steele versus Bulova*⁶⁰
SCOTUS will look at a new case that's fullofa
Misunderstanding or fatally flawed

Abitron v. Hetric -- fair or disaster?⁶¹
The 10th Circuit blessed a humongous award
For sales never made here — if you're a forecaster

Which party's position will SCOTUS reward?

**XXX. THE ROGERS V. GRIMALDI DOCTRINE MORE ROBUST THAN EVER:
CERT. GRANTED**

In the last 50 years, of the doctrines we've seen,
Here is one that is beating the band
It's *Rogers/Grimaldi*,⁶² grown much more routine
In its balance of speech versus brand.

Where our work is expressive then 1A protects
Our inclusion of marks we don't own⁶³

Though the plaintiff objects
Greater free speech respects

Funny marks on a dog's chew-toy bone⁶⁴

When his trademark appears in her song, film or card
Or their artwork or video-game
As a title or in it
The defendants will win it
If they clear 2 tests (not very hard)

Does the use by defendant have an artsy connection
With the plaintiff (must be more than zero)⁶⁵

If so, and it isn't "expressly misleading," defendant emerges the hero.
But wait! Will this change
In its scope or its range?
That's what SCOTUS took cert to determine
In the *Bad Spaniels* case
Does a toy in bad taste
Get protection? For now, some are squirmin'

XXXI. FICTIONAL ELEMENTS PROTECTED FROM OTHERS' COMMERCIAL EXPLOITATION (THE "OPPOSITE" OF A *ROGERS V. GRIMALDI* FACT PATTERN)

Conan⁶⁶ and Kryptonite,⁶⁷ General Lee⁶⁸
And Krusty Krab Restaurant too⁶⁹
Why were some folks enjoined
And their acts called "purloined"?
There's a logic you'll see, running through.

In *Rogers*,⁷⁰ it's typically ok to use
In a song or a film or whatever
Another guy's trademarks (the law will excuse)
If your work is expressive and clever

Note the difference when someone attempts to exploit
A fictional motif that's strong
For a business that builds on this feature (adroit?)
That's infringement; the law says it's wrong.

While *Rogers/Grimaldi* protects free expression
Allowing creative works great latitude
To use others' marks at the artists' discretion
The law won't accept the inverse attitude

You can't make a business from taking the heart
Of a comic book, movie or series
Well known to consumers in whole or in part
That's the difference between these two theories.

**XXXII. NINTH CIRCUIT ALLOWS PTO DIRECTOR TO SERVE DISTRICT COURT
CASE ON FOREIGN REGISTRANT**

There's a section of the law
Not interpreted before

Can the PTO serve process on a party way offshore?

Does the statutory section
Give a plaintiff the election

Is the language as it's written clear with no words to ignore?

Yes it is, the 9th declared, it's ok to skip the Hague
When you're suing for infringement, no, the language isn't vague

Section 1051(e)
of the Lanham act, you see

Isn't limited to matters at the Board

(As defendant's lawyer urged
To get the proof of service purged)

You can use it for injunction and award⁷¹

XXXIII. EVOLUTION BUT NOT THE END

Sales and use of metadata
As infringements, they still matter?

How “yesterday” to sue for keywords⁷²
Now we sue for NFT words⁷³

Or will they, like crypto, fall aside
There’s always something new

In trademark law, can’t be denied
Our work is never through.

ADDENDUM

XXXIV. SCOTUS UPHOLDS ROGERS V. GRIMALDI, FOR NOW

If you use someone's mark as a parody, and
It's "expression," then Rogers kicks in

Unless you are claiming your spoof as a brand
Then the test will not help you to win.⁷⁴

XXXV. SCOTUS UPHOLDS THE PRESUMPTION AGAINST EXTRATERRITORIALITY

The Lanham Act's protections
Are restricted to our borders
The "don't-infringe-us" sections
Can't cross foreign lands or waters

Trademark rights, though golden here,
Do not jump to other nations
File your registrations there
Then go visit on vacations.⁷⁵

ADDENDUM (Continued)

XXXVI. SCOTUS TAKES CERT: DOES REFUSAL TO REGISTER UNDER 15 U.S.C. § 1052(c)

VIOLATE FREE SPEECH WHEN THE MARK CRITICIZES A GOVERNMENT
OFFICIAL OR PUBLIC FIGURE?

Eighteen eyes
On penis size
The Justices took cert.
Can TRUMP TOO SMALL
Be registered? (A brand name for a shirt)

Normally, we cannot claim
The rights in someone else's name
Sans their agreement to the same
Are public figures, though, fair game?
Is free speech really hurt?⁷⁶

* © 2022 Jane Shay Wald. Ms. Wald is Partner *Emeritus*, Irell & Manella LLP, and chairs the firm's trademark practice group. The author thanks her husband, Dr. Charles Kreuter. He's supportive, smart, and kind – three good words that come to mind.

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⁷ S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm., 483 U.S. 522 (1987).

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- ¹¹ Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Expense Bd., 527 U.S. 666 (1999).
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- ¹³ 15 U.S.C. § 1125(c).
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- ¹⁵ Hana Fin., Inc. v. Hana Bank, 574 U.S. 418 (2015).
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- ²¹ Romag Fasteners, Inc. v. Fossil, Inc., 140 S. Ct. 1492 (2020).
- ²² U.S. Pat. & Trademark Off. v. Booking.com B.V., 140 S. Ct. 2298 (2020).
- ²³ 15 U.S.C. § 1116(d).
- ²⁴ Trademark Law Revision Act of 1988, Pub. L. No. 100-667, 102 Stat. 3935.
- ²⁵ Trademark Modernization Act of 2020, 15 U.S.C. § 1116(d).
- ²⁶ Wald & Tezyan, *A Look at the Trademark Modernization Act – Part 2*, 46 NEW MATTER 12 (2021).
- ²⁷ The Madrid Protocol Implementation Act (MPIA) of 2002, Pub. L. No. 107-273, 116 Stat. 1758, 1913–21.
- ²⁸ 15 U.S.C. § 1116(a).
- ²⁹ Union Carbide Corp. v. Ever-Ready, Inc., 531 F.2d 366 (7th Cir. 1976).
- ³⁰ SquirtCo. v. Seven-Up Co., 628 F.2d 1086 (8th Cir. 1980).
- ³¹ Daubert v. Merrell Dow Pharms., Inc., 509 U.S. 579 (1993).
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