

TRADEMARK LAW AND GENDERED CONFUSION

By Ann Bartow¹

Introduction

Familiarizing oneself with a broad range of federal court opinions in trademark cases raises a series of somewhat unexpected and perhaps inherently unanswerable questions: Why, in trademark litigation decisions, do judges so often write about representative members of the public as if we are astoundingly naïve, and frankly stupid? Do jurists truly believe that consumers are complete idiots? Or is this ostensible conviction merely pretextual, a populace-debasing but analytically efficient normative platform from which to reach trademark-strengthening outcomes that seem correct, and are at least outwardly doctrinally acceptable? What is it about trademark law that seems to elicit from courts such offensive and humiliating views of the citizenry?

In pondering these queries, one notices that many of the most demeaning conceptions of consumers, and of their intelligence and discriminatory powers (or lack thereof) tend to be articulated in trademark cases in which the underlying goods and services are primarily designed for, marketed to, or purchased by women. Women are perceived to do most of the shopping, and this perception is accurate.² While court made trademark law often presumes that all consumers of a

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² See e.g. Chain Drug Review, July 2, 2001, SECTION: No. 11, Vol. 23; Pg. 37 ; ISSN: 0164-9914 (Copyright 2001 Racher Press, Inc.) IAC-ACC-NO: 76586949 (“Supermarket shoppers are overwhelmingly female, 77%, according to the 2001 edition of Chain Drug Review's "Where Consumers Shop -- and Why" survey. Average shoppers range in age from 35 to 65, with 75% matching that profile, and they visit a supermarket once a week.”); Journal of Retailing, March 22, 2001 SECTION: No. 1, Vol. 77; Pg. 111 ; ISSN: 0022-4359, IAC-ACC-NO: 74034731 Copyright 2001 JAI Press, Inc. (“Long associated with the domestic sphere, shopping primarily has been regarded as a feminine activity. Witkowski (1999) observes that "as early as 200 years ago, American society already had begun to concede that the acquisition and use of domestic goods was within a woman's sphere of responsibility" (p. 112). Nava (1997) notes that when department stores opened in the early 20th century, it was women who patronized them and "decoded and encoded the changing images of class" symbolized in store merchandise (p. 66). Reekie (1992, p. 177) argues that even on the more "sexually ambiguous" floors of early department stores, women constituted the majority of customers.”); *Shopping Center World November 2002* Copyright 2002 by PRIMEDIA Business Magazines & Media Inc., November 2002 SECTION: ;ISSN: 0049-0393; Pg. 11 (“According to a January 2001 study by MarketResearch.com, women's footwear and sports apparel sales will hit \$39 billion by 2005. And, because women buy athletic wear for boyfriends, husbands and kids, as well as for themselves, they account for 81% of all athletic apparel purchases, according to the Sporting Goods Manufacturers Association.”); Entrepreneur, March 1, 2002 SECTION: No. 3, Vol. 30; Pg. 93; ISSN: 0163-3341 (“Women control America’s purse strings. In fact, nine out of 10 women identify themselves as the primary shopper for their household, and that includes purchasing or influencing sales of more than half of all consumer electronics

particular class of goods or services require “protection” from deceptive or confusing trademarks,³ it is when the consumers are likely to be female that paternalistic intervention, supposedly on the consumers' behalf, is often considered most necessary and appropriate.

Admittedly, one can never decipher with any certainty what views, notions or biases lead a jurist to adopt a particular analytic approach, or ground a given court's legal conclusions. And, one can certainly pick and choose cases out of the fairly robust trademark law jurisprudence to support or refute any number of conflicting theories. The primary objective of this article is to raise the possibility that judges perceive female consumers as especially easily confused, and trademark holders intentionally or unconsciously exploit this bias when litigating trademark infringement and trademark dilution disputes. In consequence, the proof required to support an allegation that a trademark usage creates a likelihood of confusion is lessened in all cases, making trademarks stronger and ever easier to “protect” for mark holders. Whether consumers realistically benefit from this, in terms of avoiding future confusion, seems highly questionable, especially if they were never actually bewildered or fooled in the first place.

I. U.S. Trademark Law: The Lanham Act and the Federal Courts

A trademark is a word, short phrase, symbol, picture, design, or other feature that is used in trade in conjunction with specific goods or services, to indicate the source of the goods or services and distinguish them from the commercial offerings of competitors.⁴ Trademarks are intended to

and 75 percent of all over-the-counter drugs, as well as 80 percent of overall consumer goods, including vehicle purchases.”);see generally Hine, Thomas, I WANT THAT!: How We All Became Shoppers (HarperCollins Dec. 2002);

³ The original justification for recognizing enforceable rights in trademarks was premised on the idea that trademarks could simultaneously profit both consumers and producers of goods and services. See e.g. Marshall A. Leaffer, *The New World of International Trademark Law*, 2 Marq. Intell. Prop. L. Rev. 1, 5-6 (1998). (“A reliable, stable, and efficiently structured trademark system benefits consumer and business interests alike. Trademarks serve the interests of consumers because they reduce search costs and allow buyers to make rational purchasing and repurchasing decisions with speed and assurance. Just as important, a strong trademark system creates incentives for firms to create and market products of desirable qualities, particularly when these qualities are not observable before purchase.”)

⁴ Lanham Act Section 1127. Marks that identify the source of services (such as the name of a travel agency or dry cleaner) are most correctly denominated “service marks,” but are treated virtually identically to trademarks as a matter of law. 15 U.S.C. section 1053. Trademarks usually appear on a product or on product packaging, while service marks appear in promotional material for services. However, service marks are commonly incorporated within the general “trademark” rubric, and therefore “trademark” or “mark” will be used to denote both trademarks and service marks here, in conformity with common practice.

perform a source identifying function with respect to goods or services in commerce,⁵ but trademark rights are not doctrinally intended to provide any right of exclusivity with respect to the underlying products and services that are identified by the marks.⁶ Though popularly referred to as a form of intellectual property, there is very little that is “intellectual” about trademarks in the sense that protectable marks, unlike copyrighted works or patented inventions, are not required to reflect any innovation or creativity whatsoever. Patent owners receive a finite term of limited monopolistic control over their inventions to reward them for inventing (or investing in the invention) of new, useful and nonobvious products and processes and making the innovative knowledge underlying the inventions available to the public.⁷ Copyright owners also receive a finite term of monopolistic control over copyrighted works, though a copyright is enforceable far longer than a patent, and the nature of a copyright monopoly is somewhat different and narrower than the exclusivity conferred by a patent.⁸ Copyright owners are given their bundle of exclusive rights to reward them for creating original works of authorship.⁹ By contrast, trademark owners can assert and retain ownership of their marks in perpetuity (as long as they remain in commercial use),¹⁰ and are not even theoretically obliged to provide a marked product or service that is creative, unique, or of value to the public.¹¹

⁵ See 15 U.S.C. section 1052.

⁶ See e.g. *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205 (2000).

⁷ See generally Patent Act.

⁸ See generally Copyright Act of 1976.

⁹ E.g. Ann Bartow, *Educational Fair Use In Copyright: Reclaiming The Right To Photocopy Freely*, 60 U. Pitt. L. Rev. 149, 154-55 (Fall 1998) (“The Copyright Act does not bestow absolute exclusive rights upon a copyright owner, but rather confers a limited monopoly with respect to use of the copyrighted work. A copyright is intangible (or “intellectual”) property that is vested with a public interest, intended to achieve an “important public purpose.” There is a societal bargain implicit in the copyright law. Copyright owners are given tools in the form of exclusive rights with which to exploit creative endeavors financially, but this gift is conditioned upon an understanding that the ultimate goal of copyrights is to maximize the number of creative works available to the public, and not to benefit individual copyright owners. Alternatively expressed, “copyright is a bargain between the public and publishers, in which the public consents to restrict its rights as a kind of bribe to publishers.” To effectuate this bargain, copyrights should be no more restrictive than is necessary to create incentives for the promotion of knowledge and learning. Where public interests conflict with those of copyright owners, the public interests should prevail.”)(Citations omitted).

¹⁰ See Lanham Act Sections 1058 and 1059.

¹¹ Trademark rights are obtained by either using the mark in commerce (and perhaps subsequently registering the mark with the Patent and Trademark Office, or “PTO”) or by filing an application to register the mark with the PTO and asserting (in the application) a bona fide intention to use the mark in commerce. See 15 U.S.C. section 1051. Federal registration is not required to begin use of a mark, nor necessary to acquire rights in a mark, but it provides trademark owners with a host of significant advantages. Holders of federally registered marks are the presumptive owners of the marks on a nationwide basis, and can use the machinery of the federal court system to defend their trademark rights.

Trademark laws do not materialize from the so-called Intellectual Property Clause of U.S. Constitution, which gives Congress the enumerated power: "To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."¹² Rather, Congressional power to federally regulate trademarks comes from the Commerce Clause.¹³

Statutory U.S. trademark law has been expansively altered in recent years.¹⁴ When amendments to the Lanham Act made it possible for entities to obtain trademark rights by simply asserting that they "intended to use" a trademark in commerce,¹⁵ the U.S. moved closer in some respects to harmonization with the laws of countries in which trademarks belong to the first entity to register them, rather than vesting trademark rights through commercial use.¹⁶ However, nations with

The term of a federal trademark registration is 10 years, with the ability to renew for a potentially unlimited number of subsequent ten-year terms. 15 U.S.C. section 1053.

¹² Patents and copyrights are alluded to in Article 1, Section 8 of the Constitution, which is known as the Enumerated Powers Clause. This Constitutional gives Congress the power to enact laws for certain purposes, such as the creation of money and to "promote the progress of science and the useful arts." See also Trademark Cases, 100 U.S. 82 (1879); *Buti v. Impresa Perosa S.R.L.*, 139 F.3d 98 (2d Cir. 1998) ("...commerce," for purposes of delimiting "use in commerce" under the Lanham Act, is expressly defined by Section 45 to be "all commerce which may lawfully be regulated by Congress." 15 U.S.C. § 1127. We recently affirmed that the "history and text of the Lanham Act show that 'use in commerce' reflects Congress's intent to legislate to the limits of its authority under the Commerce Clause." *United We Stand America, Inc. v. United We Stand, America New York, Inc.*, 128 F.3d 86, 92 (2d Cir. 1997). See also 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 19:117 & n.2 (4th ed. 1997) (citing *Trade-Mark Cases*, 100 U.S. 82, 25 L. Ed. 550 (1879), for proposition that "the power of Congress to register marks stems only from the 'Commerce Clause' of the U.S. Constitution," U.S. Const., Art. I, § 8, cl. 3). The Supreme Court, moreover, has made clear that Congress's authority under the Commerce Clause extends to activity that "substantially affects" interstate commerce. See *United States v. Lopez*, 514 U.S. 549, 559, 131 L. Ed. 2d 626, 115 S. Ct. 1624 (1995).")

¹³ E.g. 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* Section 5.3

¹⁴ E.g. Kenneth L. Port, *The Congressional Expansion of American Trademark Law: A Civil Law System In The Making*, 35 *Wake Forest L. Rev.* 827 (Winter 2000) ("Three major developments have happened in roughly the last decade. First, in 1988, section 1051 of the Lanham Act was amended to provide for the reservation of marks which claimants intend to use in commerce. In 1996, Congress passed the Federal Dilution statute, which was expanded in 1999 to include dilution as grounds for cancellation or opposition proceedings before the Trademark Trial and Appeal Board ("TTAB"). Also, but certainly not finally, in 1999 Congress further amended the Lanham Act to add a new section 43(d), which provides for statutory damages and in rem jurisdiction when a cybersquatter registers another's trademark as its domain name with the intent to traffic in the domain name. This trend drastically expands the boundaries of what the common law had long settled as the scope of American trademark right. None of the existing social, economic, or legal justifications supporting American trademark law encourage, let alone tolerate, such expansion."); see also <http://www.inta.org/about/lanham.shtml>

¹⁵ Lanham Act Section 1051. The intent-to-use application allows federal clearance and approval for registration of a trademark (the entire examination and clearance procedure of federal registration) without a showing of actual use of the mark in commerce. After an intent-to-use application has successfully made its way through the Trademark Office is a Notice of Allowance, rather than a certificate of registration. Actual use of the mark in commerce must be made before the mark can be registered. The Notice of Allowance operates to assure registration once actual use in commerce has begun and the additional filing requirements have been met.

¹⁶ Port, 35 *Wake Forest L. Rev.* at 831-32; see also e.g. <http://www.france-law.com/pages/intelec3.htm> (French trademark law generally, unlike U.S. law, provides protection based upon registration, regardless of prior use.);

strong trademark protections generally made trademark registrations far more difficult to obtain than the United States does.¹⁷

The original justification for recognizing enforceable rights in trademarks was premised on the idea that trademarks could simultaneously benefit both consumers and producers of goods and services. The classic description of the dual advantages of the trademark system is that trademarks serve the interests of consumers by reducing search costs and allowing buyers to “make rational purchasing and repurchasing decisions with speed and assurance,” while simultaneously “creating incentives for firms to create and market products of desirable qualities, particularly when these qualities are not observable before purchase.”¹⁸ That is a succinct articulation of the views contained in an influential and oft cited law review article written by William Landes and Richard Posner in 1987, which purports to explain the economics of trademarks, and endorses an expansive view of trademark strength and protectability.¹⁹

A. Consumers

Intended to both justify and reinforce court effectuated trademark protection of broad scope, the Landes and Posner analysis conceptualizes trademarks as devices that reduce information gathering and transaction costs to consumers, by allowing them to approximate the nature and quality of goods and services emanating from recognized sources. According to Landes and Posner, “...[A] trademark conveys information that allows the consumer to say to himself, “I need not investigate the attributes of the brand I am about to purchase because the trademark is a shorthand way of telling me that the attributes are the same as that of the brand I enjoyed earlier.”²⁰

One commentator provided this illustration:

http://www.ladas.com/BULLETINS/1994/1194Bulletin/UK_NewTMAct.html (“...the United Kingdom has to a large extent moved to a first-to-file system, thus making it highly advisable for trademark owners to try and avoid a difficult and costly opposition based on prior use against a similar mark, by registering their marks before they are anticipated by others.”)

¹⁷ Port, 35 Wake Forest L. Rev at 831-32.

¹⁸ Marshall A. Leaffer, The New World of International Trademark Law, 2 Marq. Intell. Prop. L. Rev. 1, 5-6 (1998)(citing Landes & Posner at fn 17).

¹⁹ William M. Landes & Richard A. Posner, Trademark Law: An Economic Perspective, XXX J. L. & Econ. 265 (1987).

²⁰ William M. Landes & Richard A. Posner, Trademark Law: An Economic Perspective, XXX J. L. & Econ. 265, 268-70 (1987).

Take laundry detergent for example. Hypothetically, let us presume that Tidy brand detergent is desirable because it gets Emily's clothes clean while Aller brand detergent is not because although it gets Emily's clothes clean, it also makes her break out in a rash if she wears clothes washed in Aller brand detergent. The economic function of trademarks in this setting is realized because Emily can make a quick and inexpensive choice between Tidy and Aller in the grocery store. Although she knows they each share the quality function of getting her clothes clean, they also do not share the quality function because one makes her break out in a rash and the other does not. As such, Emily can rely on the trademarks to identify one consistent product emanating from one consistent source, even if that source is not specifically known by Emily.

On the other hand, if Emily cannot rely on the source and quality functions of trademarks, she will be forced to research the chemical compositions of Tidy and Aller and determine precisely which chemical or combination of chemicals irritate her skin. She will then be required to read each package of detergent and study the ingredients to determine which box of detergent contains the undesirable characteristics. Consequently, Emily will incur a significantly higher total cost in purchasing the box of detergent if she cannot rely on trademarks to identify the information she desires about laundry detergent.²¹

Trademarks certainly convey information. The obvious flaw in the above analysis, however, is the implicit (and stunningly incorrect) assumption that trademarks play a role in either restricting Tidy's ability to alter its chemical composition to include the ingredient that irritates Emily's skin, or in imposing a duty on Tidy to at least inform consumers like Emily when it changes its constitutive formulation. The manufacturer may tout a "new and improved formula" when it modifies a product's components, or it may choose not to draw attention to such adjustments. Unless Emily continually monitors the small print on the Tidy label for changes, she may find her dermis red and itchy, lured by the Tidy trademark into a false sense of freedom from rashes.

Theoretically, because a particular company is the only entity allowed to use trademarked words and logos on particular goods or services in the stream of commerce, consumers can be confident that when they buy a product bearing the company's marks, it will comport with the company's standards (whatever they are perceived to be). In addition, there may be a belief that consumers can locate and contact the responsible party if they have questions about, or experience problems with, a product or service associated with that company's mark. The reality, however, is

²¹ Port, 35 Wake Forest L. Rev. at 889.

that trademarks do not impose any actual obligation upon a mark holder to include any particular features, to maintain any particular level of quality, or even to disclose the identity or location of the actual decision-makers that orchestrate the production and distribution of the marked goods and services.²² Consider the fact that the catalog clothing company Land's End is now owned by Sears Roebuck & Co., which hopes to use the Land's End mark, associated by some consumers with "quality," to lure affluent college-educated shoppers who are conditioned to paying "full price" to the clothing departments of Sears' retail stores.²³ Sears apparently believes that the Land's End mark connotes better products than its own "Sears" marks suggest, but Sears is now the actual, factual source of goods distributed bearing Land's End labels. One might say that in this instance trademark usage is intended to confuse consumers, rather than protect or inform them.

B. Producers

Concurrently it is argued that companies benefit from trademark protection to the extent that the products or services associated with their marks enjoy a good reputation with consumers.²⁴ Corporate interests often view protected trademarks as mechanisms for insuring that they receive the full benefits of their investments in producing quality goods and services, and as tools to strengthen the ability of commercial advertising to promote brand identification.²⁵

Arguably, effective advertisements can substitute for investments in quality: Research has demonstrated that consumers often prefer one brand of a product over another (even though the

²² But see Gerard N. Magliocca. One and Inseparable: Dilution and Infringement in Trademark Law, 85 Minn. L. Rev. 949 (April 2001) ("In a world with marks...consumers can easily gauge a product's quality based on advertising or on the prior performance of items that bore the same mark.").

²³ See e.g. *Milwaukee Journal Sentinel* October 28, 2002 Monday October 28, 2002 Monday FINAL EDITION SECTION: BUSINESS; Pg. 01D HEADLINE: Lands' End in stores; Sears hopes shoppers bite as it begins brand rollout; *Chicago Sun-Times* September 9, 2002 Monday SECTION: FINANCIAL; Pg. 45 HEADLINE: SEARS CHANGES LOOK BYLINE: Sandra Guy.

²⁴ E.g. Landes & Posner, *supra*; see also e.g. *United States v. Torkington*, 812 F.2d 1347, 1353 n.6 (11th Cir. 1987) ("It . . . is important to recognize that the enforcement of trademark laws benefits consumers even in cases where there is no possibility that consumers will be defrauded. For, to the extent that trademarks [**10] provide a means for the public to distinguish between manufacturers, they also provide incentives for manufacturers to provide quality goods. Traffickers of these counterfeit goods, however, attract some customers who would otherwise purchase the authentic goods. Trademark holders' returns to their investments in quality are thereby reduced. This reduction in profits may cause trademark holders to decrease their investments in quality below what they would spend were there no counterfeit goods. This in turn harms those consumers who wish to purchase higher quality goods.")

²⁵ *Id.*

underlying products are identical) based on their subjective feelings about a trademark.²⁶ For example, consumers have long paid premium prices for Wisk laundry detergent even though comparable, less expensive products are readily accessible, due to the success of the “Ring Around the Collar” advertising campaign.²⁷ They attribute superlative cleansing properties to Wisk they do not impute to products bearing less well-regarded trademarks, even though minimal experimentation might demonstrate that collar grime could be more economically eliminated through judicious use of alternate detergents (or perhaps by more effectively washing one’s neck).²⁸ The premium prices paid for particular “elite” brands of bottled water also illustrates the market power of certain trademarks.²⁹ Consumers are undoubtedly attracted to certain trademarks for a variety of reasons besides prior experience with the marked products or services.

Judicious abstention of the use of certain trademarks can help an entity escape the repercussions of a bad reputation, as well as reap the benefits from the positive meanings a trademark represents. Referencing the prior example of Sears, while this company hopes to benefit from the quality associations that the Land’s End mark evokes due to business practices that occurred before Sears assumed ownership and control of the company, it simultaneously intends to avoid any negative connotations the Sears mark carries in connection with clothing by not appending the Sears mark to Land’s End labels or tags, even though Sears is now the authentic source of the goods.

The producers of commercial goods and services are arguably the true targeted and intended beneficiaries of the statutory, administrative and legal trademark infrastructures. That trademark usage accrues to the benefit of consumers at all is really just a coincidental byproduct of a labeling and identification system that mark holders are free to manipulate to their greatest commercial

²⁶ E.g. Jessica Litman, Breakfast With Batman: The Public Interest in the Advertising Age, 108 Yale L.J. 1717 (May 1999); see also e.g. http://www.comingofage.com/Articles/articledocs/Product_segmentation-Using_The_Customers_Mind.pdf; <http://www.positiveaging.com/articles/article3.html>;

²⁷ <http://www.bartleby.com/63/83/2483.html>; http://www.water.com/who_we_are/swg1520_bra.asp;
<http://www.bottledwaterweb.com/indus.html>

²⁸ Landes and Posner assert that consumers will knowingly pay more for a product that can be found in cheaper, identical iterations, because of the “assurance” that a particular trademark provides them.

²⁹ cites e.g. http://www.bottledwaterweb.com/news/nw_061600.html

advantage. Manufacturers and service providers can manipulate trademark usage to provide source identification to consumers when it is useful, or obfuscate information when doing that appears beneficial. If consumer associations with a trademark are positive in nature, the mark holder can continue to invest in the mark, commercially exploit the positive associations as profitably as is feasible, and "protect" the mark from use by competitors. If a mark acquires negative associations, the mark holder can attempt to change the perception of the marked products or services by improving quality, or by lowering prices, or through aggressive and creative advertising. Alternatively, the mark can simply be jettisoned and replaced, providing the underlying product or service with a clean associative slate, and a fresh start in the marketplace. Producers are not burdened by trademark law with any legal obligation to inform the public about trademark changes that are made to goods and services that continue to be offered or manufactured by the same entity. A consumer who contracts food poisoning from a commercially purchased prepared food can certainly steer clear of products bearing the trademarks of the product that sickened her. She cannot, however, avoid goods from the same source that bear different, unrelated trademarks, such as those that might adopted in the wake of bad publicity, at least not by relying on the "information" provided by trademarks alone.

Over the past few years the corporation long known as Philip Morris Companies, Inc. received widespread criticism and censure for disingenuousness and dishonesty about the addictive properties and deleterious health effects of cigarettes and other tobacco products.³⁰ Apparently to escape lingering negative associations in the future, the entity has decided to change its name to Altria Group, Inc.³¹ The company currently avoids negative associations in the present by marketing many of its products under other rubrics, such as the Kraft Foods umbrella, which in turn utilizes hundreds of other trademarks across a broad range of products, including Sanka, Yuban, General Foods International Coffees, Maxim and Maxwell House for coffee; a long list of Post breakfast

³⁰ cites to "tobacco litigation" verdicts and coverage

³¹ See http://www.philipmorris.com/about_pm/history/time_2000.asp and <http://www.philipmorris.com/home.asp>

cereals,³² Good Seasons and Seven Seas for salad dressings; and Athenos, Churny, Di Giorno, Hoffman's, and Polly-O for cheeses.³³ A grocery shopper has a pretty formidable task in terms of self-education and selective shopping if she affirmatively undertakes to avoid enriching Philip Morris, Inc. by eschewing the corporation's brands.

1. Follow The Bouncing Pickle

Adding to the difficulty of linking sources to products due to the mutability of trademarks (which can be changed at will) is that fact that trademarks can be transferred to other entities. That the same trademark appears on a product over time does not even remotely guarantee that the same source was producing it during that interval. For example, the Philip Morris website listed Claussen pickles as one of its trademarked products at the time this sentence was written.³⁴ However, a Federal Trade Commission (FTC) action in October of 2002³⁵ pertained to the possible acquisition of the Claussen mark by another entity. The FTC's description of the "parties to the transaction" is instructive with respect to the manner in which the sources of trademarked goods can change:

Vlasic, which makes and sells shelf-stable and refrigerated pickles, was spun off by Campbell Soup Company as Vlasic Food International in 1998, after which it was purchased by Hicks, Muse in May 2001. Hicks, Muse is a Dallas-based private investment firm that owns Pinnacle Food Corporation (Pinnacle), the firm that now operates the Vlasic business and which is the nation's largest pickle producer. Pinnacle produces Vlasic pickles at its plants in Imlay, Michigan and Millsboro, Delaware.

Claussen, which makes and sells primarily refrigerated pickles, is a business operated by Kraft's Oscar Mayer Foods division. Oscar Mayer bought the Claussen Pickle Company in 1970, before being acquired by Kraft, which is owned by Philip Morris. Philip Morris is a Virginia corporation with its principle place of business in New York. In addition to owning Kraft, it is a prominent producer of cigarettes, beer, and

³² These include Alpha-Bits, Banana Nut Crunch, Blueberry Morning, Cinna-Cluster Raisin Bran, Cranberry Almond Crunch, Frosted Shredded Wheat, Fruit & Fibre, Golden Crisp, Grape-Nuts, Grape-Nuts O's, Great Grains, Honey Bunches Of Oats, Honeycombs, Honey Nut Shredded Wheat, Natural Bran Flakes, Oreo O's, Pebbles, Raisin Bran Shredded Wheat, Shredded Wheat 'N Bran, Spoon Size Shredded Wheat, Toasties, Waffle Crisp, and 100% Bran), see http://www.philipmorris.com/about_pm/brands/kraft_dom_brands.asp and http://www.philipmorris.com/about_pm/brands/brands_products.asp

³³ See http://www.philipmorris.com/about_pm/brands/kraft_dom_brands.asp and http://www.philipmorris.com/about_pm/brands/brands_products.asp

³⁴ http://www.philipmorris.com/about_pm/brands/kraft_dom_brands.asp visited on November 17, 2002.

³⁵ See Federal Trade Commission Votes to Challenge Hicks, Muse's Proposed Acquisition of Claussen Pickle Company, October 22, 2002, accessed at <http://www.ftc.gov/opa/2002/10/vlasic.htm>

food, including Post cereal, Maxwell House coffee, Jell-O desserts, and Altoids mints.

On May 4, 2002, Pinnacle and Kraft entered into an agreement under which Pinnacle would acquire Claussen's pickle business, including relish, sauerkraut, and pickled tomatoes. The Claussen assets being sold include the brand trademark, as well as a Kraft production facility in Woodstock, Illinois used to make dill pickles.³⁶

Thus nothing permanently definitive about the source of the pickles is established by the Claussen mark. The actual source of the pickles has changed repeatedly and may do so again, without notice to consumers. The content and quality of the pickles may change as well, there is nothing in trademark law that prevents or even impedes this. Consider a more ominous example: Television networks NBC and MSNBC are owned by General Electric,³⁷ one of the largest defense contractors on earth.³⁸ General Electric stands to make incredible profits from weapons build-ups and war. Trademark law does not require General Electric to remind you that it is the source of NBC and MSNBC news. Instead, trademarks affirmatively hamper the ability of consumers to keep the "source" of the information in mind when General Electric's subsidiary media outlets are reporting the news, enabling GE to rely on the shield of alternative trademarks to aid and abet any consumer confusion this corporation finds useful. Reflection on the ways in which trademarks are actually deployed and employed by commercial interest makes the assertion that trademarks "protect consumers from being confused, mistaken, or deceived in their purchasing decisions"³⁹ almost

³⁶ See <http://www.ftc.gov/opa/2002/10/vlasic.htm> (visited November 17, 2002).

³⁷ See http://www.ge.com/en/company/businesses/ge_nbc.htm

³⁸ http://www.ge.com/en/company/businesses/ge_aircraft_engines.htm; See also. Top Ten Conspiracy Theories of 2002, By Mike Ward, PopMatters, January 2, 2003 (Examine this question for even a minute and you will stumble onto a proven, card-carrying evil conspiracy: It's called the U.S. Congress, and conclusive evidence links them to a truly terrifying document known as the Telecommunications Act of 1996. This legislation is relevant post-9/11 because it allowed the megamergers of media conglomerates to become ultra-monstermergers. As a result, today a handful of multinationals control most of what is said in the U.S. about military actions overseas and the reasons for them. At least one of these companies – General Electric – has financial stakes in the weapons racket as well, but this blatant conflict of interest gets as much coverage as the Telecommunications Act originally got when it was on the floor of Congress: next to none. Some media observers and academics, like MIT's Noam Chomsky and Norman Solomon of Fairness and Accuracy in Reporting, have doggedly pointed out that the bloated media emperor has no clothes. Too bad they stand little chance of appearing regularly on *Face the Nation*.”).

³⁹ E.g., McCarthy on Trademarks and Unfair Competition Section 2.01

laughable, and the contention that broadly protecting trademarks "permits consumers to rely on trademarks as accurate source indicators"⁴⁰ bizarre indeed.

II. Context Is Everything

In most applications of U.S. trademark law, context is everything. For example, whether a word can even function as a protectable trademark can only be determined in the context of the good or service that it is used in conjunction with. The trademark taxonomy is generally deemed to contain four categories: “generic,” “descriptive,” “suggestive,” and “arbitrary or fanciful.”⁴¹

A. Trademark Categories

1. Generic

Words that are generic with respect to the associated product or service can never be protected as trademarks, because this would be unfair to competitors:⁴² To allow one company a monopoly on the words “ice cream” when the product is ice cream would force another entity marketing the same substance to call its product something along the lines of “sweet frosty dairy confection.” If that second company obtained an enforceable trademark on “sweet frosty dairy confection,” a third competitor might have to resort to the somewhat unappealing appellation “frozen flavored high fat milk solids” to communicate the nature of the goods it was selling to consumers. A fourth competitor, if sufficiently cowed by the threat of a trademark infringement suit, might forgo entering the ice cream marketplace altogether, freezing out the presumptive benefits in terms of quality, price and selection that consumers might otherwise milk from commercial competition.

⁴⁰ E.g., McCarthy on Trademarks and Unfair Competition Section 2.01

⁴¹ These are often referred to as the “Abercrombie & Fitch” categories because they were first specifically enunciated in *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 - 11 (2d Cir. 1976).

⁴² E.g. *Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 1183 (5th Cir. 1980). Trademarks can also become unprotectable over time if the “commit genericide” – that is, become used as the generic term for a product or service. See e.g. <http://www.inta.org/basics/aspirinbrand.shtml> and http://www.inta.org/press/news2002_10.shtml or <http://www.cblawfirm.com/?wpage=32&aid=17>

2. Descriptive

A descriptive term references a quality or characteristic of the underlying good or service, such as "Arthriticare," for a topical heat analgesic designed to provide arthritis relief,⁴³ "Pet Pals" for a program that promotes the well-being of pets,⁴⁴ and "Skinvisible" when applied to medical and surgical tapes through which the skin of the user is visible.⁴⁵ A descriptive term can only function as a valid trademark if it acquires "secondary meaning," which means the mark is recognized by the consuming public as referencing a particular product from a unitary source.⁴⁶ For example, all businesses in which eyeglasses and contact lenses are available for purchase may be referred to as "vision centers" but one specific enterprise cannot obtain a valid trademark in the descriptive words "Vision Center" unless it can demonstrate that the public distinctly associates the term "Vision Center" with its particular optical merchandise establishment.⁴⁷

3. Suggestive

A suggestive term is one that suggests, rather than describes, an attribute of the marked good or service, and requires imagination to cognitively link the trademark to the exact nature of the product.⁴⁸ The term "Pizza Rolls" was held to be suggestive when "used in association with party

⁴³ Bernard v. Commerce Drug Co., 964 F.2d 1338 (2d Cir. 1992).

⁴⁴ P.A.W. Safety Charities v. Petco Animal Supplies, Inc., 2000 U.S. Dist. LEXIS 3110 (N.D. Tex. 2000) ("The concept of descriptiveness is broadly construed. A mark need not convey every relevant piece of information about the nature of a product to be characterized as descriptive. Rather, it must only "immediately convey[] an important attribute of plaintiffs' products." The noun "pet" commonly refers to "a domesticated animal kept for pleasure rather than utility." MERRIAM WEBSTER'S COLLEGIATE DICTIONARY at 868 (10th ed. 1993). The dictionary defines "pal" as "a close friend." MERRIAM WEBSTER'S COLLEGIATE DICTIONARY at 835. Thus, the literal interpretation of "pet pal" is one who is a friend to his or her pet. It is a common and distinctive quality of friendship to care for and seek the well-being of one's friend. Thus, it takes no imagination or perception to conclude that a program called "Pet Pals" is one that promotes the well-being of pets. The mark describes the essence of plaintiff's program, even though it does not specifically spell out all the associated services.")

⁴⁵ Minnesota Mining & Mfg. Co. v. Johnson & Johnson, 454 F.2d 1179 (C.C.P.A. 1972).

⁴⁶ Lanham Act Section 2(e)(1); see also e.g. Bernard v. Commerce Drug Co., 774 F. Supp. 103 (E.D.N.Y. 1991) (Where the issue in a trademark infringement action becomes one of establishing secondary meaning, the relevant inquiry focuses upon whether the mark, although not inherently distinctive, comes through use to be uniquely associated with a single source, that is, whether the public is moved in any degree to buy an article because of its source. Moreover, the burden of proof rests upon the party claiming rights in the mark, and entails vigorous evidentiary requirements. Direct or circumstantial evidence may establish secondary meaning, including the use of survey evidence by a representative sample of consumers. The extent of public exposure to the mark as determined by the sales volume, length of time of use, and promotional efforts may also be utilized to establish secondary meaning.)

⁴⁷ See Vision Center v. Opticks, Inc. 596 F.2d 111 (5th Cir. 1980).

⁴⁸ Soweco, 617 F.2d at 1184.

snacks consisting of pillow shaped egg batter crusts filled with various food products to obtain different flavors.”⁴⁹ The court concluded:

The term PIZZA ROLLS could suggest a number of items, including small pizzas, pizza rolled up, pizza flavored candy, or a bread dough roll filled with pizza flavoring. It takes imagination and thought to perceive the nature, quality, characteristics or ingredients of plaintiff's products based upon the mark PIZZA ROLLS, all of which clearly indicate that the term is suggestive.⁵⁰

Other marks that have been deemed to be suggestive include "psychocalisthenics," for a combination of various yoga systems, dance and calisthenics designed to produce specific mental, emotional and spiritual results,⁵¹ “brown-in-bag” for transparent plastic film bags in which foods could be cooked,⁵² and “The Money Store” for money lending services.⁵³

Trademarks held to be suggestive are deemed "inherently distinctive" and therefore valid and enforceable without proof of secondary meaning.⁵⁴ This makes the distinction between “descriptive” and “suggestive” very important to the mark holder,⁵⁵ but where the taxonomic division between the two categories is situated can be difficult to ascertain. According to one court:

In the 1930s two courts split on the question of whether the trademark "Chicken of the Sea" for tuna was descriptive or suggestive. The indirectness of the association between "Chicken of the Sea" and tuna may thus be taken as a rough indicator of where the borderline between descriptive and suggestive marks lies.⁵⁶

⁴⁹ *Jeno's Inc., v. Comm. of Patents & Trademarks of the U.S.*, 227 U.S.P.Q. (BNA) 227, 231 (D. Minn.1985).

⁵⁰ *Jeno's Inc., v. Comm. of Patents & Trademarks of the United States*, 227 U.S.P.Q. (BNA) 227, 231 (D. Minn. 1985).

⁵¹ *West & Co. v. Arica Institute, Inc.*, 557 F.2d 338, 343 (2d Cir. 1977) (“While "psychocalisthenics," as noted, bears some relationship to the physical exercises conducted by Arica, this would be expected of any suggestive mark, and, in fact, would be one of the purposes of the mark. But we cannot say that "psychocalisthenics" merely describes "a combination of various yoga systems, dance and calisthenics" which require continual motion and are designed to produce specific mental, emotional and spiritual results. We think the term does "require imagination, thought and perception to reach a conclusion as to the nature of [the services].”).

⁵² *Application of Reynolds Metals Co.*, 480 F.2d 902 (C.C.P.A. 1973).

⁵³ *The Money Store v. Harriscorp Finance, Inc.* 689 F.2d 666 (7th Cir. 1982).

⁵⁴ *E.g. Zatarain's, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786 (5th Cir. 1983).

⁵⁵ *E.g. West & Co. v. Arica Institute, Inc.*, 557 F.2d 338 (2d Cir. 1977) (“In the broad middle ground where most of the trademark battles are fought are the terms which are primarily descriptive and those which are only suggestive. The distinction, while not always readily apparent, is important, because those which are descriptive may obtain registration only if they have acquired secondary meaning, while suggestive terms are entitled to registration without such proof.”) see also *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976); *W.E. Bassett Co. v. Revlon*, 435 F.2d 656, 661 (2d Cir. 1970).

⁵⁶ *Lewis Management Co. v. Corel Corp.*, 1995 U.S. Dist. LEXIS 18704 (S.D.N.Y. 1995).

Another court observed: “The line between descriptive and suggestive terms is often blurred, and the categorization of a name as ‘descriptive’ or ‘suggestive’ is frequently ‘made on intuitive basis’ rather than as a result of a logical analysis susceptible of articulation.”⁵⁷

4. Arbitrary and Fanciful

“Arbitrary” trademarks are usually defined as those that adapt a common word to an unfamiliar circumstance, such as “automobile” as a mark for a brand of paper napkins, or for a line of plumbing supplies, or any other good or service not even remotely associated with motorized transportation.⁵⁸ The “fanciful” appellation is generally reserved for words and symbols that are “invented solely for their use as trademarks”⁵⁹ such as Kodak or Xerox, or “the word ‘CHAMS’ on the top side of a curved, inverted almost-equilateral triangle with a triple-bar wing-like design and a heavy letter ‘C’ superimposed in the center of the shield,” embroidered on garments.⁶⁰

5. Categorization and Context

The word "apple" is the generic word for a particular tree-growing fruit, so "apple" can't be a valid trademark for apples. It is, however, an arbitrary or fanciful trademark for computers, or for musical sound recordings, hence Apple Computers⁶¹ and Apple Records.⁶² Similarly, "popcorn" is generic when it references eponymous kernels of snack food drenched in butter and salt, but was found suggestive when pertaining to a line of oddly shaped silver anodes.⁶³

The word "ice" is generic for cubes of frozen water, but was held to be a suggestive and therefore protectable mark with respect to chewing gum.⁶⁴ “Ice” also has been used as a trademark for beer, and in one lawsuit was asserted to be generic by one litigant, while the mark holder claimed

⁵⁷ Calamari Fisheries Inc. v. The Village Catch. Inc., 698 F. Supp. 994, 1008 (D. Mass. 1988).

⁵⁸ Abercromie & Fitch Co. v. Hunting World, Inc. 537 F.2d 4, fn 12 (2d Cir. 1976); see also McKee Baking Co. v. Interstate Brands Corp., 738 (F. Supp. 1272, 1274 (E.D. Mo. 1990) (Fanciful marks are coined terms with no dictionary meaning. Arbitrary marks are common words applied in an unfamiliar way, in a way that is non-descriptive.”).

⁵⁹ Abercromie & Fitch Co. v. Hunting World, Inc. 537 F.2d 4, fn 12 (2d Cir. 1976).

⁶⁰ CHAMS De BARON LTD. v. H. COTLER CO., 1984 U.S. Dist. LEXIS 18993 (S.D.N.Y. 1984).

⁶¹ U.S. Trademark No. 78170383, see <http://www.apple.com/>

⁶² U.S. Trademark No. 74693839, see e.g. <http://www.schomakers.com/>

⁶³ RFE Indus. v. SPM Corp., 105 F.3d 923 (4th Cir. 1997).

⁶⁴ Nabisco v. Warner-Lambert, 32 F. Supp.2d 690 (S.D.N.Y. 1999) (trademark "ice" for mint flavored chewing gum was suggestive).

that the relationship between “ice” and beer was “either arbitrary, fanciful or suggestive.”⁶⁵ The keys to correctly categorizing the mark, the court held, are consumer understanding, and common usage of the term at the time the issue is presented to a court.⁶⁶

B. Confusion in Context

Legal protections for trademarks are doctrinally justified by the need to prevent consumer confusion, which potentially disadvantages both individuals who are tricked by confusing or deceptive trademarks into purchasing goods and services other than those they intended to procure, and the providers of goods and services who lose sales when consumers are so confused or deceived.⁶⁷ Alternatively phrased, trademark infringement occurs when one party adopts a trademark that is the same as or is so similar to an existing mark that, when it is applied to the second user's goods or services, the purchasing public is likely to be confused, mistaken, or deceived about the source goods or services themselves, or about the relationship between the parties that make the goods or provide the services.⁶⁸ This "likelihood of confusion" is the touchstone of trademark infringement liability.⁶⁹

A trademark can be infringed by the unauthorized use of exact replicas of the mark on the same products (where the act might be characterized as counterfeiting), or on related goods.⁷⁰ Trademarks can also be infringed by the non-permissive use of “colorable imitations” of the mark.⁷¹ Whether a mark accused of infringing another mark is similar enough to constitute an actionable “colorable imitation” is a subjective decision that courts make, and is usually articulated as a

⁶⁵ Anheuser-Busch, Inc. v. John Labatt Ltd., 1995 U.S. Dist. LEXIS 5341 (E.D. Mo. 1995) (“A-B argues that the “ice” marks are generic while Labatt argues that they are either arbitrary, fanciful or suggestive.”).

⁶⁶ Anheuser-Busch, Inc. v. John Labatt Ltd., 1995 U.S. Dist. LEXIS 5341 (E.D. Mo. 1995)

⁶⁷ Marshall A. Leaffer, *The New World of International Trademark Law*, 2 *Marq. Intell. Prop. L. Rev.* 1, 5-6 (1998) (“A reliable, stable, and efficiently structured trademark system benefits consumer and business interests alike. Trademarks serve the interests of consumers because they reduce search costs and allow buyers to make rational purchasing and repurchasing decisions with speed and assurance. Just as important, a strong trademark system creates incentives for firms to create and market products of desirable qualities, particularly when these qualities are not observable before purchase”).

⁶⁸ See 15 U.S.C. 1114(1).

⁶⁹ See 15 U.S.C. 1114(1)(a).

⁷⁰ cite Lanham Act

⁷¹ cite Lanham Act

judgment about whether the contemporaneous co-existence of the marks underlying the dispute is likely to cause consumer confusion.⁷²

When trademark holders attempt to convince a court that the trademark related activities of another entity should be enjoined, they argue overtly or by implication that consumers are easily confused, because this helps them prevail in both infringement and dilution actions, which in turn broadens the scope of, and increases the strength of, their trademarks. Strong, broadly enforceable trademarks are desirable because they may discourage competitors from using otherwise attractive and advantageous trademarks of their own that are even mildly similar, and simultaneously frighten away those who might otherwise make non-competing or even arguably noncommercial uses of the mark.

A fairly extensive examination of written opinions in trademark cases suggests to this author that judges will more readily find sufficient consumer confusion likely where the underlying product or service that bears the allegedly infringed mark is female oriented in some manner. As a consequence, trademark holders seeking broad protections may be more willing to litigate infringement cases involving goods and services with feminine aspects as straightforward "confusion" issues since they would have a greater expectation of success in convincing a court that female consumers are more likely to be confused by allegedly similar trademarks.

Where the product or service is more male identified, a review of numerous written decisions suggests trademark holders will often either adopt a more attenuated or nuanced theory of confusion (e.g. initial interest confusion, or the possibility of confusion) or strategically focus their energies on trademark dilution claims, which can be supported by, but do not require proof (or even argument) that the challenged mark or use creates confusion among consumers.

C. Trademark Infringement and Confusion

Accusations of trademark infringement are generally raised when one entity makes use of a mark that is the same or similar to a mark that is "owned" by another. In this context the term

⁷² E.g. *Washington Speakers Bureau, Inc. v. Leading Authorities, Inc.*, 33 F. Supp. 2d 488 (E.D. Va., Feb. 2, 1999);

"ownership" connotes the holding of trademark rights, often (but not always) by virtue of use of the mark in commerce,⁷³ and by federal registration of the mark obtained through the U.S. Patent & Trademark Office. If a competitor makes unauthorized use of another's exact trademark in a clearly deceptive manner, that rival may be accused of criminal counterfeiting⁷⁴ as well as trademark infringement.⁷⁵

While there is fairly universal agreement that unauthorized uses of confusingly similar trademarks by competitors is unfair and should be prevented, a meaningful explanation of what "confusingly similar" means eludes even a careful reader of the Lanham Act, the federal statute underpinning trademark law. The Lanham Act defines infringement as the "use in commerce of any reproduction, counterfeit, copy or colorable imitation of a registered mark" in commerce in a manner "likely to cause confusion, or to cause mistake, or to deceive,"⁷⁶ and then rather circularly and unhelpfully defines "colorable imitation" as a term that "includes any mark which so resembles a registered mark as to be likely to cause confusion or mistake or to deceive."⁷⁷ This means that for all practical purposes a confusingly similar mark is statutorily defined as: a mark likely to cause confusion or mistake or to deceive that is used in a manner likely to cause confusion, or to cause

⁷³ See Lanham Act Section 45

⁷⁴ See e.g. http://www.usdoj.gov/usao/eousa/foia_reading_room/usam/title9/crm01701.htm ("The Trademark Counterfeiting Act of 1984, Pub. L. No. 98-473, Tit. II, § 1502(a), 98 Stat. 2178 (1984), and the Anticounterfeiting Consumer Protection Act of 1996, Pub.L. No. 104-153, 110 Stat. 1386 (1996), address the growing problem of trafficking in counterfeit trademark goods, which has primarily involved the clandestine manufacture and distribution of imitations of well-known trademarked merchandise. The 1984 Act created an offense, codified at 18 U.S.C. § 2320, which provides that "(w)hoever intentionally traffics or attempts to traffic in goods and services and knowingly uses a counterfeit mark on or in connection with such goods or services" shall be guilty of a felony. 18 U.S.C. § 2320(a). Section 2320(b) enables the United States to obtain an order for the destruction of articles in the possession of a defendant in a prosecution under this section upon a determination by the preponderance of the evidence that such articles bear counterfeit marks. These Acts also amend the Lanham Act, 15 U.S.C. § 1501 *et seq.*, to create stronger remedies in civil cases involving the intentional use of a counterfeit trademark. They provide mechanisms for obtaining statutory damages, treble damages and attorney's fees. 15 U.S.C. § 1117. The Lanham Act also provides for ex parte application by a trademark owner for a court order to seize counterfeit materials and instrumentalities where it can be shown that the defendant is likely to conceal or transfer the materials. *Id.* § 1116(d). New amendments permit the seizure order to be served and executed either by federal law enforcement officers or by state or local law enforcement officers. *Id.* § 1116(d)(9). The Lanham Act also requires applicants to file a notice of application for an ex parte seizure order with the United States Attorney, who may participate in such proceedings if they appear to affect evidence of a federal crime.").

⁷⁵ "Counterfeit" is defined in Section 1127 of the Lanham Act as "a spurious mark which is identical with, or substantially indistinguishable from, a registered mark."

⁷⁶ Lanham Act Section 1114.

⁷⁷ Lanham Act Section 1127.

mistake, or to deceive. This certainly provides a powerful conceptual illustration of the word “confusing,” but gives little guidance to courts about when a competing mark accusing of being infringing is “confusingly similar.” As a result, federal judges give meaning to the term on a case-by-case basis as they issue verdicts and opinions in the context of trademark litigation.

Actual confusion of consumers need not be demonstrated to prevail in an infringement action, merely likelihood thereof.⁷⁸ If the judges assume the average shopper is rather guileless and simpleminded, than anything that is even arguably mildly perplexing can supportably be presumed to meet this low threshold. Once it is met, the jurist’s task is essentially complete, because likelihood of confusion connotes likelihood of success on a trademark infringement claim, and irreparable injury to the mark holder is then presumed.⁷⁹ Judges who enjoin infringers conveniently escape the difficult task of precisely articulating how likely confusion has to be before “likelihood of confusion” is found. Nor do they typically elucidate any theory of causation, neither explaining how likelihood of confusion in a given context leads to harm, nor specifying how to measure the amount of confusion that is likely to be generated by a particular usage or substantiality of similarity.

Even the very nature of the inquiry is ambiguous. The Restatement (Third) of Unfair Competition characterizes the conclusion that “likelihood of confusion [is] a question of fact subject to the clearly erroneous rule” as “the better view, adopted by the majority of courts.”⁸⁰ The Court of

⁷⁸ E.g. *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867 (2d Cir. 1986) (“Of course, it is black letter law that actual confusion need not be shown to prevail under the Lanham Act, since actual confusion is very difficult to prove and the Act requires only a likelihood of confusion as to source.”); see also e.g. *Scarves by Vera, Inc. v. Todo Imports Ltd., Inc.*, 544 F.2d 1167, 1175 (2d Cir. 1976) (“a showing of actual confusion is not necessary and is very difficult to demonstrate with reliable proof.”); Lisa Kobiak, *Not Likely, but Possible: A Lesser Standard for Trademark Infringement in Versa Products Co. v. Bifold Co.* 31 U.S.F.L. Rev. 477 (Winter 1997) (“The “likelihood of confusion” standard is a happy medium between a “possibility of confusion” standard and an “actual confusion” standard. Demonstrating a possibility of confusion is quite easy. On the other hand, proof of actual confusion is difficult, if not impossible, to establish. However, evidence of actual confusion is only one of several factors employed to make a likelihood of confusion determination. Any proof of actual confusion is persuasive evidence that there is a likelihood of confusion, but a lack of actual confusion is not dispositive.”) (citations omitted).

⁷⁹ E.g. *Id.*

⁸⁰ See The Restatement (Third) of Unfair Competition (1993) (comment to section 21, “Proof of Likelihood of Confusion – Market Factors).

Appeals for the Federal Circuit, however, views likelihood of confusion as a question of law,⁸¹ while the Second and Sixth Circuits assert that it is a mixed question of law and fact.⁸² The authors of one of the leading trademark law textbooks have written: “Predictably, the diverging viewpoints in this area have produced a muddled body of case law, characterized by such inconsistency among and within the circuits that it has become difficult to predict how a court will deal with a particular case.”⁸³

Trademark holders of textual trademarks do not “own” the words that their trademarks are comprised of for all communicative purposes.⁸⁴ They don’t even hold a monopoly over all uses of

⁸¹ See e.g. *Giant Foods, Inc. v. Nation’s Foodservice, Inc.* 710 F.2d 1565, 1569 (Fed. Cir. 1983). (“Some circuit courts hold that the question of likelihood of confusion is one of fact and is subject to the “clearly erroneous” standard of Fed. R. Civ. P. 52(a). However, other courts hold that it is a conclusion of law. Our predecessor court, the Court of Customs and Patent Appeals, recognized in *Du Pont* that the question of likelihood of confusion “has been termed a question of fact” by other courts, but did It went on to say that “if labeled a mixed question or one of law, it is necessarily drawn from the probative facts in evidence.” *Id.* Subsequently in the case of *Interstate Brands v. Celestial Seasonings*, 576 F.2d 926 (CCPA 1978), Chief Judge Markey . . . stated for the majority that the question of likelihood of confusion “is a legal conclusion” and cannot be “admitted” as a fact. However the ultimate issue of likelihood of confusion is characterized, it is clear that our predecessor court did not apply the “clearly erroneous” standard of review to the issue. In *Du Pont*, Chief Judge Markey wrote that “. . . it is the duty of the examiner, the board, and this court (emphasis added) . . .” to determine the ultimate issue of likelihood of confusion. A review of cases in which the CCPA reversed the decision of the TTAB on this issue will demonstrate that our predecessor court did not consider itself bound by a narrow standard of review of the question. We have held that the decisions of the Court of Customs and Patent Appeals are binding upon us. Therefore, we hold that the issue of likelihood of confusion is the ultimate conclusion of law to be decided by the court, and that the clearly erroneous rule is not applicable.”)

⁸² See e.g. *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1043 (2d Cir. 1992) (“In this Circuit, a district court’s determination of the individual *Polaroid* factors are subject to review as findings of fact, subject to reversal only if clearly erroneous, while the ultimate balancing of all the *Polaroid* factors to determine the likelihood of confusion in any given case is done *de novo* by this Court.”); *Wynn Oil Co. v. Thomas*, 839 F.2d 1183, 1186 (6th Cir. 1988) (“This Circuit considers the question of whether there is a likelihood of confusion a mixed question of fact and law. When reviewing a lower court’s decision in these cases, we apply a clearly erroneous standard to findings of fact supporting the likelihood of confusion factors, but review *de novo* the legal question whether, given the foundational facts as found by the lower court, those facts constitute a “likelihood of confusion.””).

⁸³ Jane C. Ginsburg, Jessica Litman, and Mary Kevlin, *Trademark and Unfair Competition Law* (Foundation Press 3d Ed. 2001) at 419.

⁸⁴ See e.g. Stephen L. Carter, *Does It Matter Whether Intellectual Property is Property?*, 68 CHI.-KENT L. REV. 715, 720 (1993) (“Certainly, one may conceptualize trademarks as property in the Lockean sense In American law, of course, it is axiomatic that trademarks are not property in this sense.”) Megan E. Gray, *Defending Against A Dilution Claim: A Practitioner’s Guide*, 4 Tex. Intell. Prop. L.J. 205, 209-10 (Winter 1996) (“The trademark right is an exclusionary right, not a property right in the word itself. To be more specific, trademark owners do not actually own the underlying mark at issue -- they only possess a right to exclude others from using the mark in a manner that would harm consumers. A pure ownership right in a mark has not been granted, nor is it likely to be granted, because of the potential monopolization of language to which this could lead. Dilution statutes obviously grant broader protection than traditional trademark law since a dilution cause of action allows a trademark owner to exclude those who use the mark in a non-confusing manner. However, dilution statutes only grant a quasi-property right in a mark.”); cf. Maya Alexandri, *The International News Quasi-Property Paradigm and Trademark Incontestability: A Call for Rewriting the Lanham Act*, 13 Harv. J. Law & Tec 303 (Winter 2000) (“Trademarks are not -- or at least, were not -- property prior to the passage of the Lanham Act; incontestability . . . raises a serious question, descriptively speaking, as to whether trademarks now are property.”).

these words for trademark purposes.⁸⁵ If two products or markets are sufficiently unrelated, two entities can use the same words as trademarks without triggering legally actionable consumer confusion. As one court put it:

...[T]wo marks that serve to identify products in two unrelated markets may very well coexist without confusion in the public's eye. Thus *Notre Dame* brand imported French cheese has been permitted to coexist with *Notre Dame* University; *Bulova* watches with *Bulova* shoes; *Alligator* raincoats with *Alligator* cigarettes; "This Bud's for you" in beer commercials with the same phrase used by a florist; *White House* tea and coffee with *White House* milk; *Blue Shield* medical care plan with *Blue Shield* mattresses; *Family Circle* magazine with *Family Circle* department store; *Ole'* cigars with *Ole'* tequila; and *Sunkist* fruits with *Sunkist* bakery products.⁸⁶

Two parties may have legitimate, discrete national trademark rights that conflict only when they operate conterminously in a specific marketplace using the same or similar trademarks on the same or similar products or services. This is what might be described as a classic "innocent" trademark dispute in the sense that there is no indication either party has chosen their mark with any nefarious "free riding" or "palming off" motivation, but cognizable numbers of consumers could plausibly be confused, to the detriment of both mark holders. The mark holders would not fully reap the benefits of their "good reputations" and "desirable product features" and might be forced to invest in communicative advertising simply to distinguish its goods or services from those offered by competitors. They may alternatively feel compelled to change their trademarks, or to use whatever legal mechanisms are available to try to get a competitor to stop using a mark, or both. These cases can arise when companies expand into new geographic regions,⁸⁷ when two companies begin using the same or similar marks contemporaneously,⁸⁸ or when an entity adopts a mark unaware that another business has been using it, or when a mark is adopted with knowledge of prior use, but with

⁸⁵ Trademarks deemed "famous" receive very broad protections under the Lanham Act, 15 USC Sections 1125© and 1127. The statute lists 8 factors for determining whether a mark is famous, but application of these factors by the courts has been varied. See e.g. Xuan-Thao N. Nguyen, A Circus Among the Circuits: Would the Truly Famous and Diluted Performer Please Stand up? The Federal Trademark Dilution Act and Its Challenges, 1 J. Intell. Prop. 158 (Spring 2000).

⁸⁶ *Quality Inn International v. McDonald's Corp.*, 695 F.Supp. 198, 210 (D.Md. 1988)

⁸⁷ E.g. *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90 (1918); *Dawn Donut Co. v. Hart's Food Stores, Inc.*, 267 F.2d 358 (2d Cir. 1959); *Thrifty Rent-A-Car System v. Thrift Cars, Inc.* 831 F.2d 1177 (1st Cir. 1987).

⁸⁸ E.g. *Blue Bell, Inc. v. Farah Manufacturing Co.*, 508 F.2d 1260 (5th Cir. 1975); *Shalom Children's Wear, Inc. v. In-Wear A/S*, 26 U.S.P.Q.2d 1516 (T.T.A.B. 1993); *Lucent Information Management, Inc. v. Lucent Technologies, Inc.*, 986 F.Supp. 253 (D. Del. 1997).

the assumption that either the pre-existing marks or the underlying goods and services are sufficiently dissimilar such that the adoption and use of a particular mark will not be viewed as a problem.⁸⁹

D. Judicial Subjectivity and Confusion

A federal court will consider both allegedly conflicting trademarks in the contexts in which they are used, and make a determination about whether the dual usages create a “likelihood of confusion.” If so, the mark holder with inferior rights to the disputed mark (usually because usage commenced later in time) may be restricted to using the mark in a limited geographic area, or may be ordered to stop using it in commerce altogether.

As a general policy matter when the goods produced by the alleged infringer compete for sales with those of the trademark owner, infringement usually will be found if the marks are deemed sufficiently similar that confusion can be expected.⁹⁰ For example, an attempt to launch a line of “Levy” denim jeans would almost certainly be met with a trademark suit, and would likely be found to infringe the “Levi’s” trademark even if “Levy” was the surname of the individual behind this doomed entrepreneurial effort.

When the goods are related, but not competitive, several other factors are added to the calculus including strength of the plaintiff mark, proximity of the goods or services, similarity of the marks, evidence of actual confusion, marketing channels used, type of goods or services and the degree of care likely to be exercised by the purchaser, defendant’s intent in selecting the mark, and the likelihood of expansion of the product lines.⁹¹ The mark “Ben’s Bread” was deemed confusingly similar to the Uncle Ben’s mark for rice products, premised in part on the observation that: “While there are some obvious differences between the marks UNCLE BEN’S and BEN’S BREAD, they

⁸⁹ E.g. *International Kennel Club of Chicago, Inc. v. Mighty Star, Inc.* 846 F.2d 1079 (7th Cir. 1988); *Procter & Gamble Company v. Johnson & Johnson, Inc.*, 485 F. Supp. 1185 (S.D.N.Y.), aff’d 636 F.2d 1203 (2d Cir. 1980).

⁹⁰ *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979).

⁹¹ *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979).

both contain the possessive form of the name 'BEN'.⁹² That both products were sold in grocery stores, and that Uncle Ben's also used its mark on stuffing mix, were also deemed important.⁹³ In a similar vein, the Trademark Trial and Appeal Board held that artificial sweetener and salt are "closely related, complimentary products,"⁹⁴ and concluded:

We think it quite likely that purchasers familiar with the NUTRASWEET product, either as an ingredient in EQUAL artificial sweetener or as an ingredient in various other food products, would, upon viewing NUTRA SALT salt with trace minerals, be likely to believe that this was a new product line put out by the same producer as the NUTRASWEET producer or that the salt product was somehow associated with or sponsored by the people producing the NUTRASWEET product.⁹⁵

If the goods are totally unrelated, as a doctrinal matter an infringement action should not be supportable because confusion is unlikely.⁹⁶ For this reason, Smith Brothers Auto Repairs and Smith Brothers Cough Drops can independently co-exist without unleashing trademark infringement litigation. (Trademark dilution, however is another matter, as is discussed below.)

In assessing whether confusion is likely, judges are relatively free to base their findings on purely subjective reactions. As one judicial opinion proclaimed: "The determinative test cannot focus on how close or related the industries or products are, but rather by whether confusion is created so that an appreciable number of typical consumers will likely be confused."⁹⁷ Note that the test is not premised on proof that an appreciable consumers have been confused, only that in the court's estimation, they are likely to be confused. Though evidence of actual confusion is helpful to trademark holders, the absence of any actual confusion does not usually affect them at all, as courts embrace the idea that a showing of actual confusion would be very difficult to demonstrate with

⁹² Uncle Ben's, Inc. v. Stubenberg International, Inc., 1998 TTAB LEXIS 118, *, 47 U.S.P.Q.2D (BNA) 1310.

⁹³ Id.

⁹⁴ The NutraSweet Company by change of name from G.D. Searle & Co. v. K & S Foods, Inc., 1987 TTAB LEXIS 19; 4 U.S.P.Q.2D (BNA) 1964 ("While artificial sweeteners and salt with trace minerals are obviously different products, we think it likely that they would be sold in the same sections of grocery stores and supermarkets and would appear side by side in restaurants and on kitchen tabletops of ordinary consumers. We further note that the respective products are low-cost impulse type items where the purchasing decision is not likely to be as careful as it would be with a higher-priced product. In short, we conclude that the artificial sweetener and salt products are closely related, complementary products and that the use of the same or of a similar mark in connection with these products would likely result in confusion as to source or sponsorship.")

⁹⁵ The NutraSweet Company by change of name from G.D. Searle & Co. v. K & S Foods, Inc., 1987 TTAB LEXIS 19; 4 U.S.P.Q.2D (BNA) 1964.

⁹⁶ AMF Inc. v. Sleekcraft Boats, 599 F.2d 341, 348 (9th Cir. 1979).

⁹⁷ Quality Inn International v. McDonald's Corp., 695 F.Supp. 198, 210 (D. Md. 1988).

reliable proof.⁹⁸ In consequence, mark holders don't have to prove much of anything to prevail, they simply have to persuade a judge that some consumers could be confused some of the time.

Where a large corporation uses the same mark on a diverse variety of products, some courts perceive a presumptive right on the part of the entity to be the only user of the mark in any commercial context on the grounds that multiple users of a mark will cause consumer confusion.⁹⁹ For example, the fact that Virgin Enterprises Limited and its related companies (collectively, the "Virgin Group") operated various worldwide businesses that included an airline, a travel-related company, a limousine service, a soft drink bottler and distributor, and a chain of retail stores selling CDs, books, and clothing all using the Virgin trademark and service mark gave it the right to prevent an unrelated retail gasoline establishment from calling itself "Virgin Petroleum."¹⁰⁰ This despite the fact that the Virgin Group was not in the fuel business at all, nor were gasoline stations within the corporation's planned or likely zones of expansion.¹⁰¹

Similarly, the use of the name PHONES-R-US by a business that sold retail phones, accessories and answering machines was found both infringing and dilutive, "likely 'to cause confusion, or to cause mistake or to deceive' consumers into believing some sponsorship, association, affiliation, connection or endorsement exists" between the toy store chain Toys "R" Us and the defendant.¹⁰² The court explicitly noted that: "the category of a buyer protected by trademark law against this confusion includes not only the careful or discriminating buyer, but also the ignorant, the inexperienced, and the gullible."¹⁰³

⁹⁸ E.g. *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867 (2d Cir. 1986) ("Of course, it is black letter law that actual confusion need not be shown to prevail under the Lanham Act, since actual confusion is very difficult to prove and the Act requires only a likelihood of confusion as to source."); see also e.g. *Scarves by Vera, Inc. v. Todo Imports Ltd., Inc.*, 544 F.2d 1167, 1175 (2d Cir. 1976) ("a showing of actual confusion is not necessary and is very difficult to demonstrate with reliable proof."); *American Home Products v. Chattem*, 1986 U.S. Dist. LEXIS 25051 (S.D.N.Y. 1986);

⁹⁹ This right is doctrinally available only to famous marks under dilution principles, see *infra* and *supra*.

¹⁰⁰ *Virgin Enters., Ltd. v. Virgin Petroleum, Inc.*, 2000 U.S. Dist. LEXIS 8100 (C.D. Calif. 2000).

¹⁰¹ Explain "likely zones of expansion" analysis.

¹⁰² *Geoffrey, Inc. v. Stratton*, 1990 U.S. Dist. LEXIS 19504, 16 U.S.P.Q.2D (BNA) 1691 (C.D. Calif. 1990).

¹⁰³ *Geoffrey, Inc. v. Stratton*, 1990 U.S. Dist. LEXIS 19504, 16 U.S.P.Q.2D (BNA) 1691 (C.D. Calif. 1990).

Confusion can be found sufficient to result in a finding of trademark infringement even when it is anticipated that consumers will resolve or overcome any actual confusion well before reaching the “point of sale.” Mark holders can win infringement suits simply by proving “initial interest” confusion, which is what piano consumers were deemed likely to experience when they were drawn to Grotrian-Steinweg pianos, though it was clear to the court that no one would actually purchase a Grotrian-Steinweg piano believing it to be a product of the Steinway & Sons company.¹⁰⁴ One somewhat stunning articulation of the adequacy of initial interest confusion to support an infringement finding occurred in a dispute between the Blockbuster chain and an upstart competitor that called itself Video Busters. That even stupid consumers would quickly figure out that Video Busters was a different entity was deemed “unimportant” and “irrelevant” by a court that held:

[T]he issue in this case is the degree of likelihood that the name “Video Busters” would attract potential customers based on the reputation built by Blockbuster. That a customer would recognize that Video Busters is not connected to Blockbuster after entry into a Video Busters store and viewing the Video Busters membership application, brochure, video cassette jacket, and store layout is unimportant. The critical issue is the degree to which Video Busters might attract potential customers based on the similarity to the Blockbuster name. The court finds that Video Busters might attract some potential customers based on the similarity to the Blockbuster name. Because the names are so similar and the products sold are identical, some unwitting customers might enter a Video Busters store thinking it is somehow connected to Blockbuster. Those customers probably will realize shortly that Video Busters is not related to Blockbuster, but... that is irrelevant.¹⁰⁵

The implication that a mark holder only has to convince a court that consumers are likely to be confused momentarily suggests the burden of proof on this issue can be feather-light indeed.

¹⁰⁴ Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons, 523 F.2d 1331 (2d Cir. 1975) (“The issue here is not the possibility that a purchaser would buy a Grotrian-Steinweg thinking it was actually a Steinway or that Grotrian had some connection with Steinway and Sons. The harm to Steinway, rather, is the likelihood that a consumer, hearing the “Grotrian-Steinweg” name and thinking it had some connection with “Steinway”, would consider it on that basis. The “Grotrian-Steinweg” name therefore would attract potential customers based on the reputation built up by Steinway in this country for many years. The harm to Steinway in short is the likelihood that potential piano purchasers will think that there is some connection between the Grotrian-Steinweg and Steinway pianos.”).

¹⁰⁵ Blockbuster Entertainment Group v. Laylco, Inc., 869 F.Supp. 505 (E.D. Mich. 1994).

E. Trademark Dilution and Even More Confusion

In the United States, holders of “famous” trademarks¹⁰⁶ can assert a statutory right to prevent others from “diluting” their marks.¹⁰⁷ Dilution as defined by the Lanham Act “means the lessening of the capacity of a famous mark to identify and distinguish goods and services, regardless of the presence or absence of competition between the owner of the famous mark and other parties, or the likelihood of confusion, mistake or deception.”¹⁰⁸ Trademark dilution is thus the use of a mark (or similar mark) by an unauthorized entity that does not fit traditional notions of infringing conduct because there is little risk that consumers will be confused or misled by the use.¹⁰⁹ A mark holder could argue that unauthorized use of a trademark on a dissimilar, non-competing good or service diluted the mark, undermining the mark’s uniqueness and unfairly usurping the goodwill associated with the mark that the mark holder had worked hard to generate. The nationwide right to enjoin trademark dilution is a fairly recent development, as it was codified in the federal trademark statute in 1996, though many states had antidilution laws previously.¹¹⁰

By giving famous mark owners the ability to prevent “dilution” in addition to infringement, some critics assert that these mark holders are given improperly expansive property rights (sometimes called “trademarks in gross”) in words and symbols.¹¹¹ Customarily, a mark could not

¹⁰⁶ Definition of famous in Lanham Act and in case law, e.g. TCPIP Holding Co. v. Haar Communications, Inc. 244 F.3d 88 (2d Cir. 2001); Avery Dennison Corp. v. Sumpton, 52 USPQ 2d 1920 (9th Cir. 1999); Str Markets LTd v. Texaco, 950 F. Supp. 1030 (D. Hawaii 1996); Gazette Newspapers v. New Paper, Inc. 934 F. Supp. 688 (D. Md. 1996); Times Mirror Magazines Inc. v. Las Vegas Sports News LLC, 212 F.3d 157 (3d Cir. 2000); see also e.g. Edward E. Vassallo and Maryanne Dickey, Protection in the United States for “Famous Marks”: The Federal Trademark Dilution Act Revisited, 9 Fordham Intell. Prop. Media & Ent. L.J. 503 (Winter 1999).

¹⁰⁷ 15 U.S.C. section 1125.

¹⁰⁸ 15 U.S.C. section 1127 (definition of the term dilution).

¹⁰⁹ String cites, but see Nabisco Inc. v. PF Brands, Inc. 191 F.3d 208 (2d Cir. 1999) (Goldfish cracker case)

¹¹⁰ See e.g. Megan E. Gray, Defending Against A Dilution Claim: A Practitioner’s Guide, 4 Tex. Intell. Prop. L.J. 205, 207-08 (Winter 1996) (“Dilution statutes are a relatively new phenomenon in the trademark protection field. The first dilution law was passed in Massachusetts in 1947.⁹ Since then, approximately twenty-five states have adopted dilution laws of their own. Three states include dilution as part of their common law. In fact, one court has recently noted that a dilution claim is practically boilerplate in trademark actions. The vast majority of states with dilution laws have adopted statutes that are much the same as section 12 of the Model State Trademark Bill. Despite this similarity in language, courts have been wildly inconsistent in their interpretations of dilution statutes.”)

¹¹¹ String cites; but see Paul J. Heald, Trademarks and Geographical Indications: Exploring the Contours of the TRIPS Agreement, 29 Vand. J. Transnat’l L. 635, 642-43 (May 1996) (“Article 16 of TRIPS requires that a dissimilar use ‘indicate a connection between [the infringing] goods or services and the owner of the registered trademark.’ The requirement of a mistaken belief in a ‘connection between those goods’ seems much closer to the traditional Lanham Act false sponsorship cause of action than to a cause of action for dilution.”).

be registered unless it was in use, or the registration applicant asserted an intention to begin using the mark in commerce shortly. Warehousing of trademarks for future uses is discouraged.¹¹² Under antidilution principles, however, famous mark owners gain the ability to “reserve” pre-existing marks for a wide variety future uses, even if they have no intention of ever utilizing the marks in alternative ways. For example, the General Motors Corporation may have no interest in making or marketing Chevrolet® ice cream, but can bring a trademark dilution suit against any dairy company that attempts it. As one commentator explained:

Trademark dilution is based not on the notion of protecting consumers from deception, but on protecting mark owners from a possible diminution in the value of their marks. The theory of dilution...is that a second use of a well-known mark, even where the second use does not confuse consumers, gradually erodes the unique symbolism of that mark. Over time, many such uses erode the unique connection between a well-known mark and goods produced by the mark's owner. Once that connection is partially severed by the presence of other (usually non-competing or non-similar) goods with the same brand name, the value of the trademark as a marketing device is eroded. Dilution proponents have cited these as potential examples of diluting uses of a mark: Buick candy bars, Kodak laundry detergent, and the like. In contrast to ordinary trademark infringement, dilution is not predicated on any showing of likelihood of confusion. The injury is the reduced marketing value of the mark, rather than confusion in the marketplace.¹¹³

Thus dilution was intended to be a cause of action for famous mark holders who objected to uses of the same or similar marks in commerce that did not confuse consumers, such as on unrelated goods or services. Consumer confusion plays no overt role in dilution analysis where the interloper uses the exact same mark as the famous one. Judicial confusion is often apparent when U.S. courts attempt to articulate what it means to “lessen distinctiveness,”¹¹⁴ but whether consumers are

¹¹² E.g. *Procter & Gamble Company v. Johnson & Johnson, Inc.* 485 F. Supp. 1185 (S.D.N.Y.), *aff'd* 636 F.2d 1203 (2d Cir. 1980); see also *Buti v. Impresa Perosa, S.A.*, 139 F.3d 98 (2d Cir.), cert. denied 525 U.S. 826 (1998); see also Michael B. Landau, PROBLEMS ARISING OUT OF THE USE OF “WWW.TRADEMARK.COM”: THE APPLICATION OF PRINCIPLES OF TRADEMARK LAW TO INTERNET DOMAIN NAME DISPUTES, 13 Ga. St. U.L. Rev. 455, 467 (February 1997) (“One cannot simply create “catchy” marks, not use them and then assert them against the users. In order to maintain rights in a mark, the trademark owner must maintain the mark's usage in connection with goods and/or services.”).

¹¹³ David S. Welkowitz, Protection Against Trademark Dilution in the U.K. and Canada: Inexorable Trend or Will Tradition Triumph? 24 *Hastings Int'l & Comp. L. Rev.* 63, 67-8 (Fall 2000).

¹¹⁴ E.g. Port, 35 *Wake Forest L. Rev.* at 831 (“Part IV of this Article analyzes section 43(c) of the Lanham Act and concludes that this congressional expansion of the trademark right in the United States has created a state where circuit courts have no real idea of what a likelihood of dilution means and therefore, conclude, in most instances, that a famous mark is a diluted mark without any real justification for this conclusion.”); see also Gerard N. Magliocca. One and Inseparable: Dilution and Infringement in Trademark Law, 85 *Minn. L. Rev.* 949 (April 2001) (“Courts repeatedly throw

perplexed or deceived by the use of a pre-existing mark on unrelated goods is, at least according to some courts, doctrinally irrelevant.¹¹⁵ However, dilution claims are not limited to exact copying. Famous marks are also protected from dilution by similar marks, and deciding whether an accused mark is similar enough to trigger dilution concerns requires a determination of whether or not it is similar enough to be confused with the famous mark. In the context of claims of dilution by similar marks, some courts have even required proof of consumer confusion.¹¹⁶ Though consumer confusion in the dilution context is theoretically a somewhat different construct, the reasoning used by many courts in making this subjective determination often substantially parallels the analyses applied when ascertaining whether consumer confusion is likely in trademark infringement disputes. For example, one of the first dilution cases was brought by a company that owned the mark WAWA for convenience stores, against an entity that began using the mark HAHA for its own convenience stores.¹¹⁷ WAWA submitted a marketing survey in support of its dilution claim, and the court found the survey persuasive, writing: "plaintiff buttresses its position by introducing evidence of a marketing survey which concludes that persons in HAHA's neighborhood who were interviewed about Defendant's market tended, in 29% of the cases, to associate Defendant's market with a WAWA market."¹¹⁸ How this "tendency to associate" differed from a likelihood of confusion was not articulated, and is difficult to distill from the wildly varying case law that has developed

up their hands in frustration when asked "to identify the legal interest sought to be protected from 'dilution,' [and] hence the legal harm sought to be prevented." Since any concurrent use of a mark diminishes that mark's distinctiveness in some sense, separating unauthorized uses that dilute from those that do not has proven quite difficult. Unless dilution is read to prohibit virtually all unauthorized uses of a given mark, the doctrine can begin "to lose its coherence as a legally enforceable norm.")

¹¹⁵ *Panavision Int'l v. Toeppen*, 141 F.3d 1316 (9th Cir. 1998) ("trademark dilution laws protect 'distinctive' or 'famous' trademarks from certain unauthorized uses of the marks regardless of a showing of competition or likelihood of confusion.").

¹¹⁶ *E.g. Mead Data Cent., Inc. v. Toyota Motor Sales, Inc.*, 875 F.2d 1026 (2d Cir. 1989) ("Indeed, some courts have gone so far as to hold that, although violation of an antidilution statute does not require confusion of product or source, the marks in question must be sufficiently similar that confusion may be created as between the marks themselves. We need not go that far. We hold only that the marks must be "very" or "substantially" similar and that, absent such similarity, there can be no viable claim of dilution.") (citations omitted).

¹¹⁷ *Wawa, Inc. v. Haaf*, 40 U.S.P.Q.2D (BNA) 1629 (E.D. Pa. 1996).

¹¹⁸ *Wawa, Inc. v. Haaf*, 40 U.S.P.Q.2D (BNA) 1629 (E.D. Pa. 1996).

subsequent to this decision.¹¹⁹ Several courts have overtly adopted aspects trademark infringement analysis pertaining to consumer confusion for use in deciding trademark dilution cases.¹²⁰

One observer wrote: “[T]he harm that dilution seeks to address might best be described as a loss of consumer attention due to the proliferation of similar or identical symbols of trade.”¹²¹ What causes consumers to lose attention, and how to quantify attendant damages is generally not addressed by judges. In fact, U.S. courts do not consistently require evidence of any actual harm to substantiate claims of trademark dilution. In one case the court stated that requiring proof of lost revenue “seem[ed] inappropriate,”¹²² as did setting forth any specific definition of, or test for trademark dilution. Instead the judge wrote that “courts would do better to feel their way from case to case, setting forth in each those factors that seem to bear on the resolution of that case....”¹²³ This can’t help but create great uncertainty among any entity that is considering adopting a new mark.

There is some possibility that the Supreme Court’s decision in opinion in *Moseley v. Victoria's Secret Catalogue*¹²⁴ will bring some clarity to the meaning and correct application of the trademark dilution statute. The Court heard oral argument in this case on November 12, 2002, and courtroom

¹¹⁹ Criticism of the inconsistent ways in which courts apply antidilution laws come from a variety of normative viewpoints. See e.g. W. Whitaker Rayner, In Search of A Dilution Solution: Implementation of the Federal Trademark Dilution Act, 20 Miss. C. L. Rev. 93, 94 (Fall 1999) (“...federal courts have struggled with the development of a body of case law interpreting the FTDA. As more fully described below, the various circuits have, on occasion, reached diametrically opposed conclusions as to the interpretation of certain provisions of the FTDA.”); Terry Ahearn, COMMENTS: DILUTION BY BLURRING UNDER THE FEDERAL TRADEMARK DILUTION ACT OF 1995: WHAT IS IT AND HOW IS IT SHOWN? 41 Santa Clara L. Rev. 893, 893-4 (2001) (“The FTDA was designed to provide uniform national protection to the value of trademarks and replace the “patch quilt system” of state laws that had produced inconsistent and unenforceable results. However, dilution theory has never been unanimously accepted as a viable extension of traditional trademark protection, and as previous failed legislation and state court experience has shown, the application of dilution theory is intensely debated and begrudgingly applied.”); Xuan-Thao N. Nguyen, A Circus Among the Circuits: Would the Truly Famous and Diluted Performer Please Stand up? The Federal Trademark Dilution Act and Its Challenges, 1 J. Intell. Prop. 158 (Spring 2000). (“Each of the circuit courts that has had the opportunity to address the Act has its own idea about dilution and fame, the meaning of dilution, how to establish fame, and how to prove dilution. With the conflicting rulings from these circuits, there is a circus among the circuits. Each performer at the circus is carrying its own act leaving trademark owners a federal anti-dilution system that is almost as chaotic as the original patchwork system of more than twenty-five state statutes.”).

¹²⁰ E.g. *Mead Data Central, Inc. v. Toyota Motor Sales USA, Inc.* 875 F.2d 1026 (2d Cir. 1989); *Nabisco Inc. v. PF Brands, Inc.* 191 F.3d 208 (2d Cir. 1999); *Eli Lilly & Co. v. Natural Answers Inc.*, 233 F.3d 456 (7 Cir. 2000); *Times Mirror Magazines v. Los Vegas Sports News*, 212 F.3d 157 (3d Cir. 2001); *V Secret Catalogue, Inc. v. Moseley*, 259 F.3d 464 (6 Cir. 2001), cert. granted, 122 S. Ct. 1536 (2002).

¹²¹ *Merges, Menell & Lemley, Intellectual Property in the New Technological Age* (2d ed. 2001 Aspen Publishers) at 713.

¹²² *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208 (2d Cir. 1999).

¹²³ *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208 (2d Cir. 1999).

¹²⁴ *Moseley v. V Secret Catalogue, Inc.*, 123 Sup. Ct. 1115 (2003).

observers opined that the lawyers on both sides had a hard time articulating a consistent definition of trademark dilution, and the Justices seemed quite frustrated by the exercise.¹²⁵ Ultimately the Court concluded that under the Federal Trademark Dilution Act mark holders were required to show actual dilution to prevail. The Court stopped short of requiring proof of the consequences of dilution, such as actual loss of sales or profits, but held: “[A]t least where the marks at issue are not identical, the mere fact that consumers mentally associate the junior user’s mark with a famous mark is not sufficient to establish actionable dilution.”¹²⁶ How a mark holder might adequately demonstrate a reduction in the capacity of a famous mark to identify the goods of its owners was not spelled out, though the opinion suggested that establishing that the defendant’s mark caused consumers to “form a different impression” of the plaintiff’s mark was necessary.¹²⁷ The Court did not appear to define trademark dilution in a manner that is straightforward enough to allow for consistent application across a broad range of factual situations. At present, it is clear that “likelihood of confusion” or a similar concept has played a role in judicial analysis of most dilution claims. As a result, even “pure dilution” causes of action are vulnerable to gender bias.

F. Trademarks and the Gendered Construct of the Confused Consumer

1. Female Consumers Are Presumed to Be Exceptionally Easily Confused

The “reasonable person” construct in tort law historically was (and some would argue still is) masculine, both conceptually and linguistically the “reasonable man.”¹²⁸ The gender of “reasonably

¹²⁵ E.g. Dahlia Lithwick, “Thong of the South,” posted to slate.com, accessed at <http://slate.msn.com/?id=2073884> (“The case end[ed] on the same confused note on which it began. There is a trademark dilution statute that is supposed to protect more than traditional trademark law, but no one is quite sure how much more or how to prove it. It’s not at all clear to me, or the court, that Victoria’s Secret cat litter or aluminum siding really tarnishes the image of the lingerie giant. Nor is it clear why the cat litter people would choose that name unless they intended to unfairly profit from Victoria’s Secret’s success. The court will need to decide how much copycatting is acceptable, and how much more trademark protection to afford the famous, merely because they’re famous.”);

http://www.usatoday.com/news/washington/2002-11-12-victor-usat_x.htm; Tony Mauro, Victoria’s Trademark May Carry the Day, Legal Times November 18, 2002, COURT WATCH; Pg. 06 ; Bill Adair, Victor v. Victoria, St. Petersburg Times November 17, 2002 Sunday 0 South Pinellas Edition, NATIONAL; Pg. 1A

¹²⁶ Moseley v. V Secret Catalogue, Inc., 123 Sup. Ct. 1115 (2003).

¹²⁷ Moseley v. V Secret Catalogue, Inc., 123 Sup. Ct. 1115 (2003).

¹²⁸ See e.g. Caroline Forell, ESSENTIALISM, EMPATHY, AND THE REASONABLE WOMAN, 1994 U. Ill. L. Rev. 769 (1994) “Until the late 1970s the law’s measure of reasonableness was openly and exclusively male. For example, the still influential American Law Institute’s Restatement (Second) of Torts, published in 1965, refers to the negligence standard of care as that of “the reasonable man.” While in recent years “the reasonable person” has, for the most part,

prudent consumer,"¹²⁹ however, is perceptually tied to the products or services with which disputed trademarks are associated. Where the good or service is intuitively linked to women as primary purchasers and consumers, a trademark holder's burden of convincing the court that another mark is likely to cause confusion (and is therefore infringing, or dilutive, or possibly both) empirically seems to be an easier one to meet in many cases.¹³⁰ This watered down standard is, however, articulated in a putatively gender neutral way, so that it creates puddles in the jurisprudence that sometimes splash and dampen standards in trademark litigation concerning even "male" goods and services.¹³¹

replaced the reasonable man as the standard by which the law and its players measure conduct, I will show that the reasonableness standard continues to be male."); Naomi R. Cahn, *THE LOOSENESS OF LEGAL LANGUAGE: THE REASONABLE WOMAN STANDARD IN THEORY AND IN PRACTICE*, 77 *Cornell L. Rev.* 1398, 1404 (September 1992) ("The reasonable man standard remains an entrenched and pervasive standard by which courts measure potentially illegal conduct. Tort law, criminal law, and employment discrimination law all employ this standard to determine whether conduct is appropriate. That conduct is acceptable if it is "reasonable" is one of those "neutral" principles with which everyone can agree. As one critique points out, "[t]he notion that reason is divorced from 'merely contingent' existence still predominates in contemporary Western thought. . . ." The standard actually incorporates two different, although interrelated, requirements: first, that conduct be "reasonable," and second, that conduct be that expected of a "man." By "reasonable man," of course, the standard purports to be universal, to include all "mankind," and in practice courts have applied it to women as well as men. ").

¹²⁹ This phrase has been used in trademark cases such as *Brookfield Communications, Inc. v. West Coast Entertainment Corporation*, 174 F.3d 1036 (9th Cir. 1999). *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135 (9th Cir. 2001) ("The test for likelihood of confusion is whether a 'reasonably prudent consumer' in the marketplace is likely to be confused as to the origin of the good or service bearing one of the marks.") (citing *Dreamwerks Production Group, Inc. v. SKG Studio*, 142 F.3d 1127, 1129 (9th Cir. 1998)).

¹³⁰ Dianne Klein asserted a similar gender based analytic disparity in the context of tort law, writing:

While a first-year law student and the mother of a young son and daughter, I was constantly struck by the frequent appearance in the torts casebook of boys suffering injuries as the result of their own or another boy's seeming foolhardiness. Both through their own negligence, and that of others, boys seemed continuously to find themselves in harm's way. I naturally wondered if this phenomenon simply reflected the truth of the proverb that "boys will be boys" and, therefore, engage in more risky and dangerous play, or whether there was a more complicated relationship between boys' exposure to risk, consequent litigation, and tort law negligence concepts.

A closer look reveals that the current understanding of "the reasonable man [or person] standard," a central device of tort law, includes an uneasy incorporation of the economists' notion of "risk aversion," a deviation from ideally rational "risk neutrality," that both reflects and reproduces structures of gender hierarchy and stereotyping. Exceptions to uniform rules regarding the standard of care reflect the same gendered understanding, including protection or even subsidy for the risk-seeking or foolhardy behavior of boys. Inefficiencies are tolerated when they support modes of behavior in which men believe themselves to have an interest. Yet the systematic risk-aversion of women, which is well-established and may have far more pervasive consequences for both the efficiency and equity goals of tort law, is not acknowledged. In domains where men are known to be risk-averse, however, reasonableness is identified with risk aversion.

Diane Klein, *Distorted Reasoning: Gender, Risk-Aversion and Negligence Law*, 30 *Suffolk U. L. Rev.* 629 (1997).

¹³¹ Some judges link likelihood of confusion to the cost of the marked good or services, e.g. *Versa Prods. Co. v. Bifold Co.*, 50 F.3d 189 (3d Cir. 1995) ("Much as courts are required to police the boundaries of similarity within which a jury may be permitted to find a likelihood of confusion under the Lanham Act, courts must also establish the perimeters of ordinary care that constrain likelihood of confusion. The following non-exhaustive considerations should guide a court's

The very first time a court decided to expand trademark rights such that they could be enforced against related but non-competing goods (rather than just against the same or similar products), it was in the context of breakfast foods in 1917, and is still referred to as the “Aunt Jemima Doctrine.”¹³² The court concluded that buyers of pancake batter would likely become confused by the use of the same trademark on pancake syrup, and erroneously assume that the goods came from the same source.¹³³ “Perhaps they might not do so, if [Aunt Jemima] were used for flatirons,”¹³⁴ the court observed, signaling quite clearly that they believed that the likely confused pancake batter and syrup purchasers were also consumers of flatirons, which is to say, female.¹³⁵

A contemporary court might be willing to overlook seemingly very similar trademarks on virtually identical products if the packaging of the products (the context in which the marks appear) is quite different. When Nabisco alleged that their “Cream of Wheat” cereal mark was infringed by Quaker Oat’s use of “Creamy Wheat” on a very similar rival foodstuff, a court concluded it was

determination of the standard of ordinary care for a particular product. Inexpensive goods require consumers to exercise less care in their selection than expensive ones. The more important the use of a product, the more care that must be exercised in its selection. In addition, “the degree of caution used . . . depends on the relevant buying class. That is, some buyer classes, for example, professional buyers . . . will be held to a higher standard of care than others. Where the buyer class consists of both professional buyers and consumers, . . . the standard of care to be exercised by the reasonably prudent purchaser will be equal to that of the least sophisticated consumer in the class.”(citations omitted); see also *BigStar Entertainment, Inc. v. Next Big Star, Inc.*, 105 F. Supp. 2d 185, 251-16 (S.D.N.Y. 2000) (“In conducting this analysis, this Court notes the distinction case law recognizes regarding the likelihood of confusion involving expensive versus inexpensive goods. The ordinary, reasonably prudent and reasonably informed customer is expected to be more discerning and less likely to be confused in inverse proportion to the price of the product. Thus greater likelihood of confusion is presumed in the case where relatively inexpensive items are purchased. The price of the products here in contention may not be great, but seems sufficiently high to reduce the buyers’ clicking impulse and to serve to define more narrowly one segment of the relevant web market to the more interested, probable purchasers of the parties’ products. Defendants’ registration fee for each entrant is \$ 19.95. The unit price of plaintiff’s videocassettes, DVDs and merchandise, though it not entirely clear from the record, could be under \$ 20.00 per item.”); *Uncle Ben’s, Inc. v. Stubenberg International, Inc.*, 1998 TTAB LEXIS 118, *, 47 U.S.P.Q.2D (BNA) 1310. (“Further, the fact that we are here dealing with relatively inexpensive food products means that the average purchaser may exercise less care in the purchasing decision.”); *The NutraSweet Company by change of name from G.D. Searle & Co. v. K & S Foods, Inc.*, 1987 TTAB LEXIS 19; 4 U.S.P.Q.2D (BNA) 1964 (“We further note that the respective products are low-cost impulse type items where the purchasing decision is not likely to be as careful as it would be with a higher-priced product.”).

¹³² E.g. *Quality Inn International v. McDonald’s Corp.*, 695 F.Supp. 198, 211 (D. Md. 1988).

¹³³ *Aunt Jemima Mills Co. v. Rigney & Co.*, 247 F. 407, 409-10 (2d Cir. 1917).

¹³⁴ *Aunt Jemima Mills Co. v. Rigney & Co.*, 247 F. 407, 410 (2d Cir. 1917).

¹³⁵ Judge Learned Hand concurred in the Aunt Jemima case, and then used the freshly baked “Aunt Jemima doctrine” in the context of consumers arguably more likely to be male, holding that the Yale trademark that identified the source of locks, could not be used by a competitor on flashlights. However, he did so with little enthusiasm, writing: “[T]he fact that flash-lights and locks are made of metal does not appear to us to give them the same descriptive properties, except as the trade has so classed them. But we regard what the trade thinks as the critical consideration, and we think the statute meant to make it the test, despite the language used,” thus blaming the confusion conclusion he reluctantly endorsed on “the trade.” *Yale Electric Corp. v. Robertson*, 26 F.2d 972 (2d Cir. 1928).

unlikely that Nabisco would be able to demonstrate that consumer confusion was likely, because even though Nabisco and Quaker Oat were competing for the same consumers, the differences between the product packages were more significant than their similarities, and therefore consumers probably would not buy Creamy Wheat believing that it was Cream of Wheat.¹³⁶ Similarly, another court concluded that consumers could successfully differentiate between the "TALLIA" and "ITALIA" trademarks even though both were associated with clothing.¹³⁷

However, it is unusual for courts to presume that consumers are observant and shrewd enough to distinguish between two disparate cereal boxes or clothing retailers. In many trademark infringement cases the theory of consumer-as-idiot prevails, often seeming glaringly pretextual, invoked only to comport with the doctrinal requirements necessary to reach the outcome that the trademark holder desires and the court apparently endorses. Where the benchmark consumer is likely to be perceived as female, this predisposition seems to be exacerbated. Illustrations include a determination that consumers can't distinguish between the "Nailtiques" and "Pro-Techniques" marks on bottles of nail polish,¹³⁸ or between an over-the-counter drug called "Premesyn PMS," intended to relieve premenstrual syndrome symptoms, and a prescription drug, "Premarin" used in estrogen replacement therapy to treat the symptoms of menopause.¹³⁹

In a recent case in which the relevant consumers were "shoppers," the court upheld a jury verdict finding that the MySimon Internet-based comparison shopping service infringed a trademark held by the Simon Property Group, which used the name "Simon" in connection with its real space mall development, mall management, and retail shopping services.¹⁴⁰ This verdict was affirmed despite the fact that the only survey evidence in the case "tend[ed] to show virtually no threat of

¹³⁶ Nabisco Brands, Inc. v. Quaker Oats Co., 547 F. Supp. 692 (D. N.J. 1982); another decision that is very respectful of consumer intelligence and discretionary powers is BigStar Entertainment, Inc. v. Next Big Star, Inc., 105 F. Supp. 2d 185 (S.D.N.Y. 2000).

¹³⁷ Hartz & Co. v. Italia, Inc., 1998 U.S. Dist. LEXIS 3716 (S.D.N.Y. 1998); see also Avon Shoe Co. v. David Crystal, Inc., 171 F. Supp. 293 (S.D.N.Y. 1959) (Plaintiffs' trademark was not infringed by non-competing products in adjacent markets because there was no likelihood of confusion, defendants' use was in good faith and reasonable, and plaintiffs were not injured.)

¹³⁸ Nailtiques Cosmetic Corp. v. Salon Sciences Corp., 41 U.S.P.Q.2D (BNA) 1995 (S.D. Florida 1997).

¹³⁹ American Home Products v. Chattem, 1986 U.S. Dist. LEXIS 25051 (S.D.N.Y. 1986).

¹⁴⁰ Simon Prop. Group, L.P. v. Mysimon, Inc., 2001 U.S. Dist. LEXIS 852 (S.D. Indiana 2001).

actual confusion between the two companies....a 'completely negligible' likelihood of confusion with under 2 percent of respondents indicating relevant confusion."¹⁴¹

In another well-known case, one jeans maker was enjoined from using a stitching pattern on the back pockets of the "designer" denim pants it marketed, because the configuration was held to be substantially similar to Levi's trademark stitching pattern, "a fanciful pattern of interconnected arcs."¹⁴² The court announced that similar back pocket stitching on defendant's wares would confuse consumers, despite the fact that the defendant's jeans were designer jeans and therefore sold to a different market segment than Levi's jeans, and the designer jeans bore very disparate, exceeding dissimilar labels, hang tags and product features.¹⁴³ This conclusion was premised upon the stated concern that an individual's eyes might sweep the backside of another who was wearing a pair of the defendant's jeans, notice the back pocket stitching design, and erroneously conclude, "the fanciful pattern of interconnected arcs indicates a connection between the source of those designer jeans with the Lois labels and the makers of Levi's."¹⁴⁴ Framed as "post-sale confusion as to source," the court assumed this allegedly anticipated harm was of adequate magnitude to support

¹⁴¹ Simon Prop. Group, L.P. v. Mysimon, Inc., 2001 U.S. Dist. LEXIS 852 (S.D. Indiana 2001).

¹⁴² Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co., 799 F.2d 867 (2d Cir. 1986).

¹⁴³ Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co., 799 F.2d 867, 877-78 (2d Cir. 1986). (C.J. Miner, dissenting) ("the evidence is clear that Lois employs a variety of temporary and permanent labels distinguishing its jeans from those of Levi. For instance, Lois jeans are sold with "hang tags" displaying the Lois brand name and the trade symbol of a bull. There are two stitched-on cardboard tags, one measuring approximately five inches by three inches and the other measuring approximately one inch by three inches. Both tags display the Lois brand name and bull symbol as well as the legend "imported from Europe" in conspicuous print. Affixed permanently to Lois jeans are various identifying features: a two inch by one inch leather tag attached to the left rear pocket bearing the brand name and bull symbol; a sizing and care tag stitched to the inner waist seam bearing the Lois brand name and indicating that both the fabric and product are made in Spain; a brass button on the waistband bearing the Lois brand name; and a quarter circle leather on fabric patch, stitched to the right front pocket, bearing the bull symbol..").

¹⁴⁴ Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co., 799 F.2d 867, 874 (2d Cir. 1986). ("We are trying to determine if it is likely that consumers mistakenly will assume either that appellants' jeans somehow are associated with appellee or are made by appellee. The fact that appellants' jeans arguably are in a different market segment makes this type of confusion *more likely*. Certainly a consumer observing appellee's striking stitching pattern on appellants' designer jeans might assume that appellee had chosen to enter that market segment using a subsidiary corporation, or that appellee had allowed appellants' designers to use appellee's trademark as a means of reaping some profits from the designer jeans fad without a full commitment to that market segment. Likewise, in the post-sale context a consumer seeing appellants' jeans on a passer-by might think that the jeans were appellee's long-awaited entry into the designer jeans market segment. Motivated by this mistaken notion -- appellee's goodwill -- the consumer might then buy appellants' jeans even after discovering his error. After all, the way the jeans look is a primary consideration to most designer jeans buyers.").

injunctive relief.¹⁴⁵ The court's qualitative view of the purchasers of the defendants' designer jeans can be surmised from the following: While the text of the opinion states that "The district court found, and the parties do not dispute, that the typical buyer of "designer" jeans is sophisticated with respect to jeans buying,"¹⁴⁶ an appended footnote acerbically notes "It is quite possible of course to draw the opposite inference from the fact that these buyers are willing to pay almost \$100 for a pair of jeans."¹⁴⁷

On occasion, adult shoppers are explicitly presumed to be less perceptive and discerning than their young children. One of the most startling cases in this regard involved fish shaped snack crackers.¹⁴⁸ Pepperidge Farms, makers of Goldfish crackers, objected to the presence of fish shaped crackers in packages of "Catdog" crackers produced by Nabisco to exploit the popularity of the Nickelodeon network cartoon by the same name.¹⁴⁹ Nabisco had developed a CatDog snack that consisted of small orange crackers in three shapes: half the crackers in a package were in the shape of the two-headed CatDog character, one-quarter in the shape of a bone, and one-quarter in the shape of a fish.¹⁵⁰ In concluding that the fish crackers would improperly "lessen the distinctiveness" of

¹⁴⁵ *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 871 (2d Cir. 1986). ("We agree with the district court, however, that the two principle areas of confusion raised by appellants' use of appellee's stitching pattern are: (1) the likelihood that jeans consumers will be confused as to the relationship between appellants and appellee; and (2) the likelihood that consumers will be confused as to the source of appellants' jeans when the jeans are observed in the post-sale context. We hold that the Lanham Act, 15 U.S.C. §§ 1051-1127 (1982), as interpreted by our Court, was meant to prevent such likely confusion.").

¹⁴⁶ *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 875 (2d Cir. 1986).

¹⁴⁷ *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 875 n.5 (2d Cir. 1986).

¹⁴⁸ *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208 (2d Cir. 1999)("In spring 1998, Nickelodeon Television Network approached Nabisco to explore a possible joint promotion for Nickelodeon's new cartoon program, "CatDog." In August 1998, Nabisco and Nickelodeon entered a Joint Promotion Agreement ("JPA"), giving Nabisco the right to produce cheese crackers in shapes based on the CatDog cartoon. The agreement required Nabisco to print on its packages that "CatDog and related titles, logos and characters are trademarks of" Nickelodeon's parent, Viacom International, Inc. Nabisco's CatDog product was intended to compete with other animal-shaped cheese crackers marketed to children. The star of the CatDog cartoon program is the CatDog--a two-headed creature that is half cat and half dog. Each half of the CatDog has a distinct personality. The fish is the favorite food and the symbol for the cat half; the bone is the preferred meal and emblem for the dog half. Other characters that are featured on the cartoon include a mouse, a rabbit, a squirrel, and several dogs. In its first three months, the CatDog show garnered a 3.9 Nielsen rating, making it close to the most widely watched program for children. Pursuant to its agreement with Nickelodeon, Nabisco developed a CatDog snack that consists of small orange crackers in three shapes: half the crackers in a package are in the shape of the two-headed CatDog character, one-quarter in the shape of a bone, and one-quarter in the shape of a fish. The fish-shaped cracker closely resembles Pepperidge Farm's Goldfish cracker in color, shape, and size, and taste, although the CatDog fish is somewhat larger and flatter, and has markings on one side. The CatDog product was to be sold in boxes featuring the CatDog and showing fish and bones in the background.").

¹⁴⁹ *Id.*

¹⁵⁰ *Id.*

Pepperidge Farm's product, the court acknowledged that the children at whom the Nabisco crackers were pitched would likely know the difference, but asserted that their parents would be markedly less astute, writing:

Nabisco argues that ... children will have no difficulty recognizing the Nabisco product as a reference to the CatDog and will thus keep the two marks separate and distinct. Even if Nabisco is correct in that surmise, it seems to us to have only moderate importance, for two reasons. First, while children may be the primary ultimate consumers of the crackers, they are generally not the purchasers. Adult purchasers of crackers may be less sophisticated than children in recognizing the differences between the two fish. Even if, in the minds of children, the addition of Nabisco's CatDog family to the cheese cracker landscape does not lessen the distinctiveness of Pepperidge Farm's mark in its Goldfish, it is likely to do so among adults who will have less awareness of Nickelodeon's CatDog and of the differences between the two competing crackers.¹⁵¹

This conclusion contrasts dramatically with the much more typical (and intuitive) assumption that children are more easily confused than adults.¹⁵² It was, however, necessary to justify the outcome of

¹⁵¹ *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 220-21 (2d Cir. 1999). The Court further noted, "Nabisco claims some protection from the fact that its fish shape is not arbitrary but acts as a reference to the fish in Nickelodeon's CatDog story. The weakness in its argument lies in the fact that when the Nabisco crackers are served in a bowl, consumers who are not familiar with the Nickelodeon entertainment and its cross licensing with Nabisco will see simply crackers very similar to Pepperidge Farm's fish (together with other shapes) and will not know that it celebrates Nickelodeon's CatDog entertainment." *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208 at 221-22.

¹⁵² See e.g. *Lyons Pshp., L.P. v. Morris Costumes, Inc.*, 243 F.3d 789 (4th Cir. 2001) ("As we noted above, the principal at an elementary school testified that when she wore the Duffy costume at a school rally, the children shouted "Barney. Barney. Barney," and parents testified that when they rented the Duffy costume for their children's birthday parties, the children believed that the person dressed as Duffy was in fact Barney. In addition, Lyons offered newspaper clippings that evidenced actual confusion between Duffy and Barney, not only by the children who were the subject of the articles, but by the reporters themselves, who erroneously described Duffy as "Barney."); *Mattel, Inc. v. MCA Records*, 1998 U.S. Dist. LEXIS 7310, 46 U.S.P.Q.2D (BNA) 1407 (C.D. Calif. 1998) ("The Court must also consider the type of goods and the degree of care likely to be exercised by the purchaser. Under this analysis, adults would presumably be less prone to confusion than young children."); *Lyons Pshp., L.P. v. Giannoulas*, 14 F. Supp. 2d 947 (N.D. Tex. 1998) ("Finally, the fact that small children, incapable of reasoning, may have been confused by the Chicken's act, does not amount to actual confusion."); *Harlem Wizards Entertainment Basketball v. NBA Props.*, 952 F. Supp. 1084 (D.N.J. 1997) ("Actual confusion is not the same as clear mistake or misidentification on the part of consumers, many of whom it turns out were children. Moreover, there is no evidence that these purported instances of actual confusion could have any effect on consumer purchasing decisions."); *Three Blind Mice Designs Co. v. Cyrk, Inc.*, 892 F. Supp. 303 (D. Mass. 1995) ("Stewart has also been asked to autograph defendant's goods on several occasions, including once by a group of children on a golf course. Stewart has presented six examples of actual confusion."); *Geoffrey, Inc. v. Stratton*, 1990 U.S. Dist. LEXIS 19504, 16 U.S.P.Q.2D (BNA) 1691 (C.D. Calif. 1990) ("The category of a buyer protected by trademark law against this confusion includes not only the careful or discriminating buyer, but also the ignorant, the inexperienced, and the gullible.... In this case, it is not only children, but also adults who may be confused."); *Original Appalachian Artworks v. Topps Chewing Gum*, 642 F. Supp. 1031 (N.D. Georgia 1986) ("While there are differences in the parties' products and retail outlets, the purchasers of the parties' items are often substantially similar. The evidence also suggests that young children were more likely to be confused than others."); *Blake Publishing Corp. v. O'Quinn Studios, Inc.*, 202 USPQ 848, 858 (S.D.N.Y. 1979) ("The nature of the market to which the two magazines appeal further enhances the likelihood of confusion. Children under 16, who comprise a substantial portion of plaintiff's readership, are not likely to bring a great deal of care and sophistication to their purchasing decisions."); *Bulk Mfg. Co. v. Schoenbach Products Co.*, 1980 U.S. Dist. LEXIS 16488, 208 U.S.P.Q. (BNA) 664 (S.D.N.Y. 1980) ("Court does not find that the manufacturer's name is prominently displayed so that prospective purchasers of the machine would be alerted to the

the case, as the lower court had previously ascertained that Pepperidge Farm had "failed to show a likelihood that its target consumers, children in the 6-12 year-old age group, will be confused by the Nabisco product."¹⁵³

Concerns about "post sale confusion" also lead to a finding of trademark confusion in *Hermes Int'l v. Lederer de Paris Fifth Ave., Inc.*¹⁵⁴ The court found that because the defendants did not use the name "Hermes" on their products and openly acknowledged to customers that their products were Hermes copies, they had not deceptively attempted to "pass off" or "palm off" their products as genuine Hermes.¹⁵⁵ However, the defendants had still "attempted to encourage consumer confusion in the post-sale context" and were therefore guilty of trademark infringement.¹⁵⁶ Trademark law therefore protects unwary observers from mistakenly assuming, based on a cursory inspection, that a handbag carried by another person was Hermes if she was actually toting a less expensive or elite pocketbook. The court held: "[A] loss occurs when a sophisticated buyer purchases a knockoff and passes it off to the public as the genuine article, thereby confusing the viewing public and achieving the status of owning the genuine article at a knockoff price."¹⁵⁷ The post-sale confusion doctrine thus facilitates trademark actions against "goods that offer consumers a cheap knockoff copy of the original manufacturer's more expensive product," illegitimately allowing a buyer to acquire the prestige of owning what appears to be the more expensive product.¹⁵⁸

different origin, especially in view of the almost identical appearance of the machines. Second, the designation of the manufacturer could not prevent confusion among children who purchase the "eggs" dispensed from the vending machines, and who could hardly be expected to place any significance on the designation, even if they could read it."); *General Foods Corp. v. Mellis*, 1979 U.S. Dist. LEXIS 13091, 203 U.S.P.Q. (BNA) 261 (S.D.N.Y. 1979) ("The sophistication of the buyers of these products cannot be considered high; the consuming universe to which the products are directed is that of children.").

¹⁵³ *Nabisco, Inc. v. PF Brands, Inc.*, 50 F. Supp. 2d 188, 211 (S.D.N.Y. 1999).

¹⁵⁴ *Hermes Int'l v. Lederer de Paris Fifth Ave., Inc.*, 219 F.3d 104 (2d Cir. 2000).

¹⁵⁵ *Hermes Int'l v. Lederer de Paris Fifth Ave., Inc.*, 219 F.3d 104, 107 (2d Cir. 2000).

¹⁵⁶ *Hermes Int'l v. Lederer de Paris Fifth Ave., Inc.*, 219 F.3d 104, 107 (2d Cir. 2000).

¹⁵⁷ *Hermes Int'l v. Lederer de Paris Fifth Ave., Inc.*, 219 F.3d 104, 109 (2d Cir. 2000).

¹⁵⁸ *Hermes Int'l v. Lederer de Paris Fifth Ave., Inc.*, 219 F.3d 104, 108 (2d Cir. 2000); see also Anne M. McCarthy, Note, *The Post-Sale Confusion Doctrine: Why The General Public Should Be Included In The Likelihood Of Confusion Inquiry*, 67 *Fordham L. Rev.* 3337 ("argues that, in light of the dual aim of trademark law to protect the interests of both the public and the trademark owner, the use of a trademark likely to cause confusion among the general public in a post-sale context should be actionable under federal trademark law.")

In a dispute between the producers of Tylenol and a competitor marketing a dental analgesic it labeled Tempanol, the court stated that to prove trademark dilution, "the plaintiff must simply show that there is a mental association by the reasonable consumer between the two names." The judge decided that the "reasonable consumer" was likely to make this detrimental and actionable association because "[b]oth marks in issue begin with the letter 'T', both have three syllables with the accent on the first syllable, and the last syllable of both is 'nol.'"¹⁵⁹ He further explicitly noted that he believed consumers were likely to purchase pain relievers in an unsophisticated manner, without any significant time or thought.¹⁶⁰ In describing the "great renown" of the Tylenol mark, he wrote: "The name even found its way into the script of the 1980 popular movie "Airplane," when the traffic controller, in describing the endangered passenger plane, announced, 'Well, it's a big pretty white plane with a red stripe, curtains at the windows, wheels, and it just looks like a big Tylenol.'"¹⁶¹

While trademark jurisprudence on the whole does not present a very optimistic view of the intelligence or gullibility of consumers, many opinions implicitly suggest the typical female shopper is especially easily fooled and lacking in powers of discernment. In another context a colleague has labeled this phenomenon, sometimes encountered during the course of her professional life, as the "Some Dumb Girl Syndrome," as in, "we shouldn't expect much from her because she is just some dumb girl." While it bears repeating that courts often express low opinions about the intelligence, discretion, and observational powers of shoppers even where the context seems wholly gender neutral, it appears to this author that some judges reserve their lowest expectations for presumptively female consumers, who are apparently assumed to be a cohort of easily confused dumb girls.

When female consumers are also assumed to be racial minorities, a variety of conjectures may influence judgments about likelihood of consumer confusion. In one case, despite the fact that there was no evidence of actual confusion caused by the coexistence of Sheer Essence pantyhose and

¹⁵⁹ McNeil Consumer Brands v. United States Dentek Corp., 116 F. Supp. 2d 604, 608 (E.D. Pa 2000).

¹⁶⁰ McNeil Consumer Brands v. United States Dentek Corp., 116 F. Supp. 2d 604, 608 (E.D. Pa 2000).

¹⁶¹ McNeil Consumer Brands v. United States Dentek Corp., 116 F. Supp. 2d 604 (E.D. Pa 2000).

Essence magazine, and notwithstanding a determination by the Patent & Trademark Office that there was no likelihood of confusion between the two marks,¹⁶² a court decided that confusion in the marketplace was likely, apparently premised on that fact that both products were targeted to black women.¹⁶³

Assumptions about female shoppers surface even when an underlying product is targeted at males, if a judge believes that the goods will be purchased for men by women. In *Tailor Tee v. Steadman Manufacturing* the court wrote:

With reference to the marketing of the product although there is evidence that appellant's goods are sold in women's specialty shops, the record also reveals that the products of both parties are sold in department stores although in different departments of the stores. A more significant factor in this connection is the fact that women not only buy for themselves but, according to the record, they purchase a substantial percentage of the underwear for the adult male members of their families and between 90 and 95% of the undergarments of their male youngsters. Obviously under these circumstances, a female purchaser of tee shirts could very easily become confused as to the origin of these garments when one manufacturer uses the trademark Tailor-Tee and the other, TAILORED T.¹⁶⁴

2. Ungendered or Male Consumers and Assumptions of Astuteness

In the context of competing or related goods or services, the threshold at which courts are willing to assume “ungendered” or even predominantly male consumers are likely to be confused may be a low one. For example, one wholesale oil company, Pegasus Petroleum, was forced to change its moniker simply because it was named for the mythological creature that happened to be used in picture form as a logo by Mobil, which uses a red “flying horse” symbol in conjunction with

¹⁶² *Ithaca Industries, Inc. v. Essence Communications, Inc.*, 706 F. Supp. 1195, 1200 (W.D.N.C. 1986) (“The record shows that the United States Patent and Trademark Office determined that there was no likelihood of confusion between the mark SHEER ESSENCE, used on pantyhose, and any other registered mark, except Bancroft's ESSENCE registration for pantyhose, which developed to have been cancelled and passed Ithaca's application for publication on June 21, 1983. At the time this determination was made there was of record Defendants' Registration ('774) for ESSENCE for a magazine and ('615) for ESSENCE for T-Shirts.”).

¹⁶³ *Ithaca Industries, Inc. v. Essence Communications, Inc.*, 706 F. Supp. 1195, 1209 (W.D.N.C. 1986) (“...the Court finds and concludes that in view of the present use by ECI of its mark '615 ESSENCE "for clothing -- namely, T-shirts" and its mark '902 ESSENCE STYLE "for a retail mail order service for women's clothing and accessories" there is a likelihood of confusion in the marketplace. ECI is now actually engaged in selling by mail order women's apparel and accessories and these goods, like Ithaca's pantyhose, are directed specifically to the black woman's market. It would be easy for customers to assume that sheer pantyhose sold under the name SHEER ESSENCE and other apparel and accessories sold under the name of ESSENCE STYLE, all for black women, were made and sold by the same company. Ithaca will be enjoined from the use of the word essence in the sale of its pantyhose.”).

¹⁶⁴ *Tailor Tee v. Steadman Manufacturing, Inc.*, 286 F.2d 612, 614 (C.C.P.A. 1960).

its retail gasoline sales.¹⁶⁵ To reach its conclusion that consumer confusion was likely if the marks continued to coexisted, the court accepted Mobil's assertion that seeing the textual words "Pegasus Petroleum" made observers think "that entity must be related to Mobil Oil because Mobil sometimes uses a graphic red flying horse logo," but did not require Mobil to proffer any evidence demonstrating how frequently this might occur, if at all.

However, there are many examples of courts having a much higher estimation of consumer discretionary abilities when the marked good or service is directed at a male target audience. When Terri Welles wanted to (accurately) describe herself on a website as a former "Playmate of the Year," she was found to have a right to do so despite the objections of Playboy Enterprises, Inc., which claims "Playmate of the Year" as a trademark. The court wrote:

... one might refer to 'the professional basketball team from Chicago,' but it's far simpler (and more likely to be understood) to refer to the Chicago Bulls." Likewise, given that Ms. Welles is the "Playmate of the Year 1981," there is no other way that Ms. Welles can identify or describe herself and her services without venturing into absurd descriptive phrases. To describe herself as the "nude model selected by Mr. Hefner's magazine as its number-one prototypical woman for the year 1981" would be impractical as well as ineffectual in identifying Terri Welles to the public.¹⁶⁶

Note that the illustrative example the court employs in the opinion references a male basketball team. While Welles certainly appears to be a woman, her goods and services are clearly assumed to be marketed to men.

Mead Data Central, the company that (then) owned Lexis, the computerized legal research service, and held "Lexis" as a registered trademark, sued Toyota for trademark dilution when Toyota launched a line of luxury cars under the Lexus trademark. Exhibiting a level of respect for attorneys not always observed among federal judges, the court concluded that the "recognized knowledgeable sophistication of attorneys"¹⁶⁷ meant that they would probably be able to distinguish between Lexus an expensive car, and Lexis, an online legal research database. As a result, Mead lost its dilution

¹⁶⁵ Mobil Oil Corp. v. Pegasus Petroleum Corp., 818 F.2d 254 (2d Cir. 1987) (likelihood of confusion between Mobil's "flying horse" symbol and Pegasus Petroleum's use of the word "Pegasus" as a mark).

¹⁶⁶ Playboy Enters. v. Terri Welles, Inc., 78 F. Supp. 2d 1066, 1079 (S.D. Cal.), aff'd 279 F.3d 796 (9th Cir. 2002).

¹⁶⁷ E.g. Mead Data Cent., Inc. v. Toyota Motor Sales, Inc., 875 F.2d 1026, 1032 (2d Cir. 1989)

claim. Similarly, in *PPG Industries v. Clinical Data*,¹⁶⁸ the plaintiff was deemed to have failed to prove dilution because it did not establish the likelihood of consumer confusion, or that its good will and reputation had been detracted from, or that the uniqueness and individuality of the "PPG" mark had diminished, as a result of defendant's use on medical diagnostic equipment.¹⁶⁹ The court's implicit assumption that "medical professionals familiar with this sophisticated technology" could easily tell the difference between medical devices, and the industrial coatings and finishes manufactured by the plaintiff.

In a trademark case involving a domain name dispute, the mark holder, Opryland USA, Inc. had registered "TNN" as a service mark for The Nashville Network, a cable network that broadcasts country music and country lifestyle programs. The defendant domain name holder, The Network Network, maintained a website at "tnn.com" related to consulting and training information technology professionals about the establishment and maintenance of computer networks. The judge observed that both parties had devoted to a lot of time to the issue of "whether intrepid Internet explorers, in search of information about Nashville's programming, are potentially confused when they alight, inadvertently, on Network's website."¹⁷⁰ After considering the parties' arguments, the court very sensibly concluded: "There is a difference between inadvertently landing on a website and being confused." This judge's perception of the gender of the inadvertent but not confused web surfer can be surmised from the following passage from the written opinion:

The Court can conceive of few, if any, circumstances in which a person of average intelligence, seeking information on NASCAR racing schedules, would be seriously confused upon reaching Network's website which, by its terms, offers "Strategic Planning, design, implementation, and management of Broadband Voice/Data/Video Networks."¹⁷¹

The judge sarcastically but no doubt accurately concluded: "Unlikely indeed is the hapless Internet searcher who, unable to find information on the schedule of upcoming NASCAR broadcasts or

¹⁶⁸ *PPG Industries, Inc. v. Clinical Data, Inc.* 620 F. Supp. 604 (D. Mass. 1985).

¹⁶⁹ *PPG Industries, Inc. v. Clinical Data, Inc.* 620 F. Supp. 604 (D. Mass. 1985).

¹⁷⁰ *The Network Network v. CBS, Inc.*, 54 U.S.P.Q.2d 1150, 1164 (C.D. Cal. 2000).

¹⁷¹ *The Network Network v. CBS, Inc.*, 54 U.S.P.Q.2d 1150, 1166 (C.D. Cal. 2000).

"Dukes of Hazzard" reruns, decides to give up and purchase a computer network maintenance seminar instead."¹⁷²

When the owner of an upscale restaurant called Jake's brought suit against the proprietors of Jake and Oliver's House of Brews, a court concluded that while customers for both establishments came from the greater Philadelphia area, a "restaurant goer" could easily recognize the differences between the two eateries, noting:

Jake's is considered to be a fine dining establishment where one might go for a special occasion such as a graduation celebration, an engagement or something of that nature.... Jake And Oliver's, on the other hand, is a more casual dining experience which customers attend for the variety of beers that it has on tap, as well as the food it serves.¹⁷³

Where two trade associations, the Self-Insurance Institute of America, Inc. and the Software and Information Industry Association used similar trademarks, the fact that both used trademarks that incorporated the letters "SIIA" was not found likely to cause consumer confusion.¹⁷⁴ In a suit brought against the creators and distributors of a movie entitled "Starballz"¹⁷⁵ the court decided that Lucasfilm's trademark infringement claims were weak because it was unlikely that the public would confuse the wildly successful "Star Wars" cinematic series with the defendants' animated pornographic film. In still another case, consumers were deemed unlikely to confuse the mark "New York – New York \$lot Exchange" used as the name of a players club by a Las Vegas casino with the New York Stock Exchange.¹⁷⁶

All of the outcomes described in this section seem intuitively correct, but contrast dramatically with decisions such as those referenced previously, in which consumers are deemed effortlessly duped, bewildered and befuddled. Comparing these cases suggests courts consider

¹⁷² The Network Network v. CBS, Inc., 54 U.S.P.Q.2d 1150, 1180 (C.D. Cal. 2000).

¹⁷³ Cooper v. Dearhearts, Inc., 1997 U.S. Dist. LEXIS 8163 (E.D. Pa. 1997).

¹⁷⁴ Self-Insurance Inst. of Am. v. Software & Info. Indus. Ass'n, 208 F. Supp. 2d 1058 (C.D. California 2000) (Self-Insurance Institute of America, Inc. and defendant, Software and Information Industry Association, are trade associations. According to the trademark registration, plaintiff's registered mark was a composite mark that included "SIIA" and the eagle design. Defendant uses a composite mark that included "SIIA," "Software and Information Industry Association" and a circle design.)

¹⁷⁵ Lucasfilm, Ltd. v. Media Mkt. Group, Ltd., 182 F. Supp. 2d 897 (N.D. Cal. 2002)

¹⁷⁶ N.Y. Stock Exch., Inc. v. N.Y., N.Y. Hotel, LLC, 293 F.3d 550 (2d Cir. 2002).

people who wear finger nail polish, grocery store patrons, handbag carriers, analgesic buyers, mall shoppers, and designer jeans purchasers much more easily confused than people who access Internet pornography, buy luxury cars, work with industrial coatings, follow NASCAR racing, maintain computer networks, eat out at a "House of Brews," or review mailings from trade associations. While both men and women can and undoubtedly do engage in all of these pursuits, the former are more stereotypically female, while the latter activities perceptually skew toward males.

III. Confusion and Free Speech

Neither noncommercial use of a trademark, nor commercial use of a mark in a descriptive (rather than trademark) sense can infringe upon or dilute traditional trademark rights. Unauthorized entities are free to speak about the trademarks of others in noncommercial or commercial-but-non-trademark ways, as least doctrinally, under the Lanham Act. For example, a published novel in which a character specifically drinks Coca-cola® rather than simply soda, or wears Lee Jeans® rather than generic pants as part of the narrative, is not infringing the trademark rights of the pertinent mark holders. As one commentator articulated:

What trademark law gets you is the exclusive right to make trademark use of a word on the products you sell in those markets in which you have actually done business. Dell Computers has an exclusive right to use the mark Dell as a trademark for computer hardware in connection with the sale of Dell-brand computer hardware. It can't stop Dell publishing from using the mark "Dell" on books, even books about computing. It can't stop Compaq computers from advertising that its machines are a better value than Dell's. It can't stop New Line Cinema from making a movie in which the bad guy is a pornographer who uses a Dell Computer as the server for his x-rated web site. What it can do is stop anyone from making commercial use of the word "Dell," or a word similar to Dell, in a way that is likely to confuse or deceive consumers.¹⁷⁷

Similarly, she noted, "Procter and Gamble's registered trademark gives it no right to prevent anyone from discussing 'Tide' the mark, 'Tide' the detergent, or tide, the lunar phenomenon."¹⁷⁸ However, trademark laws can be used to inhibit speech any time protecting a trademark (or shielding

¹⁷⁷ Jessica Litman, *The DNS Wars: Trademarks and the Internet Domain Name System*, 4 J. Small & Emerging Bus. L. 149, 153-54 (2000).

¹⁷⁸ Jessica Litman, *Breakfast With Batman*, 108 Yale L.J. 1717, 1721 (May 1999).

consumers from confusion) strikes a court as being more important than a conflicting interest in unrestrained expression¹⁷⁹

Traditional trademark law averted collision with free speech interests by authorizing judicial intervention only in contexts in which consumers were likely to be confused. Anti-dilution statutes protect trademarks from the "likelihood of injury to business reputation or of dilution of the distinctive quality of a mark" absent even arguable or pretextual confusion as to the source of goods or services.¹⁸⁰ Dilution has interpreted to create a cause of action when there is "blurring" of a trademark's positive connotations by dissonant or unfavorable usage, and dilution can be found to occur when the affirmative associations of a mark are "tarnished" through unwholesome or unsavory mental associations. Therefore, as one commentator articulated: "The underlying premise of anti-dilution law is that the primary value of a trademark lies in its ability to convey positive meaning to the public."¹⁸¹ As is explained below, numerous courts have explicitly held that parody of a mark constitutes trademark infringement or dilution,¹⁸² while others have elevated free speech rights over trademark interests.¹⁸³

¹⁷⁹ Mark Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 *Yale L.J.* 1687 (May 1999) ("Trademark laws have been used to preclude artists from painting in the same style as another, to prevent an author from using the term "Godzilla" in the title of his book about Godzilla, to prevent a comic book from featuring a character known as Hell's Angel, to prevent a satirical political advertisement from using the "Michelob" trademark to [*1712] help make its point, to prevent a tractor manufacturer from making fun of its competitor's logo in an advertisement, to prevent a movie about a Minnesota beauty pageant from using the title "Dairy Queens," to prevent a political satire of the O.J. Simpson case called "The Cat NOT in the Hat!" to prevent individuals from setting up web pages critical of a company or product, and to prevent a theme bar from calling itself "The Velvet Elvis.") (citations omitted).

¹⁸⁰ Lanham Act Section 43???

¹⁸¹ Keith Aoki, *How The World Dreams Itself to be American: Reflections on the Relationship Between the Expanding Scope of Trademark Protection and Free Speech Norms*, 17 *Loy. L.A. Ent. L.J.* 523, 532-33 (1997).

¹⁸² E.g. *Wawa, Inc. v. Haaf*, 40 U.S.P.Q.2D (BNA) 1629 (E.D. Pa. 1996) ("Plaintiff has established that its mark will be diluted either through blurring or parody. Therefore, Plaintiff has shown actual success on the merits."); See also *Anheuser-Busch, Inc. v. Andy's Sportswear, Inc.*, 40 U.S.P.Q.2d (BNA) 1542, 1543 (N.D. Cal. 1996) (issuance of a temporary restraining order in favor of Anheuser-Busch Inc. against a defendant who wanted to distribute T-shirts marked with the word "Buttwiser"); *Pillsbury Co. v. Milky Way Prods., Inc.*, 215 U.S.P.Q. (BNA) 124 (N.D. Ga. 1981) (a picture of figures resembling the plaintiff's trade characters "Poppin" Fresh and "Poppie Fresh" engaged in sexual intercourse and fellatio violated state antidilution statute, because despite the lack of actual damages, likelihood that the defendants' presentation could injure the business reputation of the plaintiff or dilute the distinctive quality of its trademarks); *Coca-Cola*, 346 F. Supp. at 1192-93, discussed *infra*.

¹⁸³ E.g. *Mattel, Inc. v. MCA Records*, 46 U.S.P.Q.2d 1407 (C.D. Cal. 1998); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir. 1987); *Lucasfilm Ltd. v. High Frontier*, 622 F. Supp. at 933-35; *Lucasfilm, Ltd. v. Media Mkt. Group, Ltd.*, 182 F. Supp. 2d 897 (N.D. Cal. 2002); *Hormel Foods Corp. v. Jim Henson Prods.*, 73 F.3d 497 (2d Cir. 1996); *Lyons Pshp., L.P. v. Giannoulas*, 14 F. Supp. 2d 947 (N.D. Tex. 1998) ("A good-faith intent to parody is not an intent to confuse.").

A. Barbie Dolls, Girl Scouts, and Full-Figured Women

It was argued above that trademarks on products and services pitched at women obtain enhanced protections by invoking the specter of the very easily confused female consumer, who is deemed likely to be fooled by competitors if a court does not intervene. Once speech concerns enter a trademark dispute, however, almost the opposite effect can be detected. When the plaintiff trademark is associated with something unequivocally feminine, some courts actually seem less willing to offer the sweeping “confusion prevention” and “positive meaning” protections that other masculine or ungendered trademarks enjoy. These jurists seem to hold the view that while female oriented products should be protected from confusing behaviors by competitors, they should not be shielded from use in communicative acts, regardless of how disparaging the use is in nature or effect. Quite the contrary: Speech mocking and maligning some female trademarked symbols seems to warrant strong First Amendment protections.¹⁸⁴

1. Barbie

Barbie®,¹⁸⁵ for example, is typically invoked to convey negative sentiments.¹⁸⁶ Frequently attacked as a symbol of superficiality and materialism,¹⁸⁷ the doll has been accused of promoting

¹⁸⁴ Again, the author agrees with this determination, it is the disparities in treatment of various trademarks that is the subject of concern. A pithy encapsulation of the normative claims of this article is: All consumers should be treated like men, and all trademarks like Barbie.

¹⁸⁵ *Mattel, Inc. v. Adventure Apparel* 2001 U.S. Dist. LEXIS 13885, (S.D.N.Y. 2001) (“Mattel is the world’s largest manufacturer of toys, games and playthings. One of Mattel’s most successful products is the Barbie doll which is one of the most popular toys in existence. Mattel has caused numerous Barbie related trademarks to be registered in the in the United States Patent and Trademark Office on the Principal Register.”)

¹⁸⁶ See e.g. Alyson Lewis, *Playing Around With Barbie TM: Expanding Fair Use for Cultural Icons*, 1 J. Intell. Prop. 61 (Spring, 1999) (“When people see Barbie, some see an economic powerhouse marketed by Mattel, others see a social icon that programs young girl’s into thinking that Barbie is the perfect woman. Feminist and cultural scholars alike have critiqued Barbie for promulgating an impossible feminine mystique. True, she is plastic. However, even Mattel admits that she is marketed more as a person than as a doll.”).

¹⁸⁷ “Exploring the role society and the media play in the development of an Eating Disorder” <http://www.something-fishy.org/prevention/society.php> (“Barbie-type dolls have often been blamed on playing a role in the development of body-image problems and Eating Disorders. Not only do these dolls have fictionally proportioned, small body sizes, but they lean towards escalating the belief that materialistic possessions, beauty and thinness equate happiness. Barbie has more accessories available to purchase than can be believed, including Ken, her attractive boyfriend. She has an assortment of jobs including: Potty-training her sister Kelly, princess and more recently, Dentist (in which she wears a mini-skirt and has enough hair that her patients would choke). While I personally do NOT believe every girl that has a Barbie-type doll is at risk of disordered eating, I do believe it helps to perpetuate an ideal of materialism, beauty, and being thin as important elements to happiness in one’s life.”); http://www.aauw-il.org/wwfg/archive/Spr2_3.htm;

negative body images in girls¹⁸⁸ and being "an insta-symbol of everything that's wrong with our culture's well-worn images of femininity and beauty."¹⁸⁹ In a biography, Joan Kennedy referred to Barbie¹⁹⁰ "in order to indicate that she was treated like a beautiful but empty-headed accessory."¹⁹¹ In an episode of the sitcom *Ally McBeal*, being called Barbie was portrayed as a gross insult to professional women.¹⁹² The way Barbie effects the psyches of women or young girls is well beyond the scope of this article, but her designation and impact as a cultural icon, and how trademark law intersects with non-permissive communicative uses of the Barbie trademark, are worth considering.

In March of 1997 a Danish musical group called Aqua released a song entitled "Barbie Girl," in which female and male vocalists pose as Barbie® and Ken®, the two popular dolls produced by Mattel. The singers refer to Barbie as a "blond bimbo girl," who loves to party and whose "life is plastic." During the course of the musical work, Aqua sings lyrics that include phrases such as: "you can brush my hair, undress me everywhere," "I'm a blond bimbo girl, in a fantasy world," "you can touch, you can play, if you say 'I'm always yours'," and "make me walk, make me talk, do whatever you please, I can act like a star, I can beg on my knees." Ken sings lyrics such as: "kiss me here, touch me there, hanky panky," and "come jump in, bimbo friend, let us go do it again, hit the town, fool around, let's go party."¹⁹³

¹⁸⁸ Kate Leary, "Barbie's Legacy: Body Image and Eating Disorders, Johns Hopkins News-Letter, accessed at http://www.jhu.edu/~newslett/11-15-96/Features/Barbie's_Legacy_Body_Image_and_Eating_Disorders.html ; http://more.abcnews.go.com/sections/gma/goodmorningamerica/gma011219young_anorexics.html ; <http://www.mirror-mirror.org/child.htm>, Alyson Lewis, Playing Around With Barbie TM: Expanding Fair Use for Cultural Icons, 1 J. Intell. Prop. 61 (Spring, 1999) ("Whether Mattel likes it or not, people see this 12" plastic doll as a reflection of society's problem with body image.")

¹⁸⁹ See e.g. Ophira Edut, "Barbie Girls Rule?" accessed at http://www.adiosbarbie.com/bology/bology_barbiead.html

¹⁹⁰ "When I campaign alone I'm approachable. Women talk to me, complain, but when I'm with Ted I'm a Barbie doll," M. CHELLIS, *THE JOAN KENNEDY STORY: LIVING WITH THE KENNEDYS* 191 (Jove ed. 1986), quoted in Rochelle Cooper Dreyfus, *EXPRESSIVE GENERICITY: Trademarks As Language In The Pepsi Generation*, 65 *Notre Dame L. Rev.* 397 (1990).

¹⁹¹ Rochelle Cooper Dreyfus, *EXPRESSIVE GENERICITY: Trademarks As Language In The Pepsi Generation*, 65 *Notre Dame L. Rev.* 397, 400 (1990).

¹⁹² See Alyson Lewis, Playing Around With Barbie TM: Expanding Fair Use for Cultural Icons, 1 J. Intell. Prop. 61, 77 (Spring, 1999) and accompanying notes.

¹⁹³ The full text of the lyrics is reportedly as follows: "Barbie Girl" by Aqua:

-Hiya Barbie!
 -Hi Ken!
 -You wanna go for a ride?
 -Sure, Ken!
 -Jump in!

The song was commercially released, and heavily promoted. The album containing the song sold 1.4 million copies in the United States alone.¹⁹⁴ In response, trademark holder Mattel brought suit, alleging among other causes of action that its Barbie trademark was infringed by use of the word "Barbie" in the song "Barbie Girl" and its accompanying video.¹⁹⁵ Mattel claimed that this unauthorized use of its mark would lead to confusion among consumers and harm to the Barbie product line itself, because Aqua's song associated its doll with "antisocial themes such as promiscuity, lewdness, and the stereotyping and ridiculing of young women."

The defendant band successfully argued that Barbie is a powerful symbol in contemporary American civilization, and that their use of the trademark in their song to invoke her social meaning was protected by the First Amendment. The district court specifically held: "...[T]he First Amendment concerns raised by prohibiting a parody of a popular consumer product weigh against granting a preliminary injunction. Presumably, some consumer confusion is inevitable when a few

-Ha ha ha ha!
 I'm a Barbie girl, in my Barbie world
 Life in plastic, it's fantastic
 You can brush my hair, undress me everywhere
 Imagination, life is your creation
 Come on Barbie, let's go party!
 I'm a blonde bimbo girl, in a fantasy world
 Dress me up, make it tight, I'm your dolly
 You're my doll, rock and roll, feel the glamour in pink
 Kiss me here, touch me there, hanky-panky
 You can touch, you can play
 If you say "I'm always yours," ooh ooh
 Come on, Barbie, let's go party, ah ah ah yeah
 Come on, Barbie, let's go party, ooh ooh, ooh ooh
 Come on, Barbie, let's go party, ah ah ah yeah
 Come on, Barbie, let's go party, ooh ooh, ooh ooh
 Make me walk, make me talk, do whatever you please
 I can act like a star, I can beg on my knees
 Come jump in, be my friend, let us do it again
 Hit the town, fool around, let's go party
 You can touch, you can play
 You can say "I'm always yours"
 You can touch, you can play
 You can say "I'm always yours"
 -Oh, I'm having so much fun!
 -Well, Barbie, we're just getting started!
 -Oh, I love you Ken!

Mattel, Inc. v. MCA Records, 296 F.3d 894, 900 (9th Cir. 2002). (appendix)

¹⁹⁴ Mattel, Inc. v. MCA Records, 46 U.S.P.Q.2d 1407, 1446 (C.D. Cal. 1998).

¹⁹⁵ Mattel actually featured a song about Barbie by Brian Wilson, "Living Doll," for the purpose of promoting "California Dream" Barbie. See e.g. <http://www.cabinessence.com/brian/boots/bws.shtml>; <http://members.tripod.com/~beachwilson/>; <http://www.wfmu.org/MACrec/barbie.html>

people fail to realize that one product is parodying another. This fact should not be used to censor criticism of or social comments on icons in our popular culture...¹⁹⁶

Many people would strongly agree with this outcome, and the fact that it is appropriately anchored by freedom of speech considerations, this author most emphatically included. The question that it raises, however, is why there appears to be a broader right to invoke the social meaning of Barbie in a commercial context without authorization by the mark holder¹⁹⁷ than for other trademarks.¹⁹⁸ After Mattel appealed this decision to the Ninth Circuit, the affirming opinion cogently elucidated the reason that First Amendment values trump trademark holders' interest in controlling their marks¹⁹⁹, but after gratuitously mentioning Barbie's origins as "a doll that

¹⁹⁶ Mattel, Inc. v. MCA Records, 46 U.S.P.Q.2d 1407 (C.D. Cal. 1998).

¹⁹⁷ The only context in which this does not necessarily appear to be true is that of Internet web sites and domain names: see Mattel, Inc. v. Jcom, Inc., 48 U.S.P.Q.2D (BNA) 1467 (S.D.N.Y. 1998 (defendants' use of the term Barbie's Playhouse using the font and color most commonly associated with the Barbie trademark, plus the use of a doll-like figure similar to the form of a Barbie doll on the bottom of the web site, diluted plaintiff's trademark.); Mattel Inc. v. Internet Dimensions, 2000 U.S. Dist. LEXIS 9747, (S.D.N.Y. 2000) (court concluded that 'barbiesplaypen.com' was confusingly similar to the mark 'Barbie' because: "1) both contain the name 'barbie'; 2) the name 'Barbie' on the front page of the web site and the logo BARBIE both have approximately the same font, slant, size, etc.; 3) both BARBIE and 'barbiesplaypen.com' are inextricably associated with the verb 'play,' in the broad sense of the term."); Mattel's success with Internet trademark litigation is often linked to its ability to scare web site operators rather than persuade judges. See Rosemary Coombe and Andrew Herman. TRADEMARKS, PROPERTY, AND PROPRIETY: THE MORAL ECONOMY OF CONSUMER POLITICS AND CORPORATE ACCOUNTABILITY ON THE WORLD WIDE WEB, 50 DePaul L. Rev. 597, 602-04 ("...Barbie Doll Benson, former Miss Nude Canada, used the Barbie Doll stage name for sixteen years, but it was only when she produced a Web page that Mattel complained. ¹In another example, a cultural critic who dedicated his site to the Barbie icon's semiotics and deconstruction, was threatened by the corporation and removed his imagery. His "Distorted Barbie" however was widely reduplicated in mirror sites designed to subvert Mattel's legal action. Barbie doll collectors have dozens of Websites as well as on-line Barbie auctions. ² Mattel has tried to shut down dozens of these sites and attempted to usurp the collectors' community by creating a commercial alternative that offers officially licensed "nostalgia dolls" and other paraphernalia.")

¹⁹⁸ Cases in which trademark rights have been held subsidiary to speech rights generally involve what the courts define as noncommercial uses, e.g. L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26 (1st Cir. 1987) (*High Society* magazine's two-page article entitled "L.L. Bean's Back-To-School-Sex-Catalog," which displayed a facsimile of LL. Bean's trademark and featured pictures of nude models in sexually explicit positions using products held to be "use of plaintiff's mark solely for noncommercial purposes...an editorial or artistic, rather than a commercial, use of plaintiff's mark."); Lucasfilm Ltd. v. High Frontier, 622 F. Supp. at 933-35. (the owners of the trademark "Star Wars" alleged injury from public interest groups that used the term in advertisements presenting their views on President Reagan's Strategic Defense Initiative, but the court denied the claim, stressing that the sweep of a trademark owner's rights extends only to injurious, unauthorized commercial uses of the mark by another and since the defendants did not affix plaintiff's trademark to any goods or services for sale, and were not in competition with plaintiff, there was no infringement.); Lucasfilm, Ltd. v. Media Mkt. Group, Ltd., 182 F. Supp. 2d 897 (N.D. Cal. 2002) (court held that although the defendants' film tarnished the plaintiffs' family of marks, trademark dilution did not apply to non-commercial use of a mark such as a parody or satire and, as such, the plaintiffs were not likely to prevail on their trademark dilution claim)..

¹⁹⁹ Mattel, Inc. v. MCA Records, 296 F.3d 894, 900 (9th Cir. 2002) ("Simply put, the trademark owner does not have the right to control public discourse whenever the public imbues his mark with a meaning beyond its source-identifying function.").

resembled a ‘German street walker’”²⁰⁰ the court’s analysis relied heavily on the fact that Barbie is “a cultural icon.”²⁰¹ One gets the distinct impression from the opinion that the freedom to speak about a trademark is linked to the particular mark’s cultural importance and societal visibility.²⁰² The conflict between trademarks and speech rights was specifically articulated by the court as follows:

The problem arises when trademarks transcend their identifying purpose. Some trademarks enter our public discourse and become an integral part of our vocabulary. How else do you say that something's "the Rolls Royce of its class?" What else is a quick fix, but a Band-Aid? Does the average consumer know to ask for aspirin as "acetyl salicylic acid?" Trademarks often fill in gaps in our vocabulary and add a contemporary flavor to our expressions. Once imbued with such expressive value, the trademark becomes a word in our language and assumes a role outside the bounds of trademark law.²⁰³

The difficulty with this exposition is that it gives no guidance about how to ascertain when any given trademark has transcended its identifying purpose, entered our public discourse, become an integral part of our vocabulary, filled gaps in our vocabulary, and/or added a contemporary flavor to our expressions. The “when” appears critical because it seems clear from the text of the decision that only when these thresholds of cultural permeation are reached by a particular mark that it is “imbued with expressive value,” “assumes a role outside the bounds of trademark law” and is an available part of the lexicon beyond the control of the mark holder. In other words, one reading of the freedom of speech analysis articulated here is that only well know, iconic trademarks must yield to the public's expressive interests. The opinion further states: “Were we to ignore the expressive value that some marks assume, trademark rights would grow to encroach upon the zone protected by the First Amendment.”²⁰⁴ Yet which marks are “some marks,” and how a speaker determines which

²⁰⁰ *Mattel, Inc. v. MCA Records*, 296 F.3d 894, 898 (9th Cir. 2002).

²⁰¹ *Mattel, Inc. v. MCA Records*, 296 F.3d 894, 898 (9th Cir. 2002) (“She remains a symbol of American girlhood, a public figure who graces the aisles of toy stores throughout the country and beyond. With Barbie, Mattel created not just a toy but a cultural icon.”)

²⁰² A “literary expert” in this case later published an essay which used Barbie as a dramatic foil because she was asserted to be “the perfect example of the struggle to own the cultural conversation,” see Richard A. Lanham, COMMENTARY: *Barbie* and the Teacher of Righteousness: Two Lessons in the Economics of Attention 38 *Hous. L. Rev.* 499, 511 (Summer 2001)

²⁰³ *Mattel, Inc. v. MCA Records*, 296 F.3d 894, 900 (9th Cir. 2002).

²⁰⁴ *Mattel, Inc. v. MCA Records*, 296 F.3d 894, 900 (9th Cir. 2002).

marks have entered this First Amendment “zone” is never explained. Nor is a logical basis offered for differentiating between marks, or a doctrinal justification for attributing expressive values only to some of them. The court does not seem to believe that First Amendment limitations adhere equally to all trademarks, but offers no information about how to assess whether a particular mark is susceptible to free speech. If Aqua had song about Raggedy Ann (“I’ve got looped yarn hair and triangle nose, and a tattoo heart beneath my clothes”) would the outcome of the case have been the same? What about Chatty Cathy, also a Mattel product²⁰⁵, or Mrs. Beasley²⁰⁶ the doll made popular thirty years ago by the Buffy character on the television show Family Affair but now largely faded from the public consciousness?

In a law review note arguing “that the commercial use of social icons, or symbols, should be allowed as a means by which our culture necessarily communicates,”²⁰⁷ one legal scholar focused on Barbie as an iconic example of the problematic effect of intellectual property protections on social critiques made in the form of commercial speech.²⁰⁸ While her observations about the chilling effects that threats of copyright and trademark litigation can have on such speech were astute and well taken, the author clearly neither felt nor anticipated any restrictions on her ability to invoke the semiotic power of Barbie.

2. The Girl Scouts

The Girl Scouts have also had their trademark non-permissively utilized for free speech purposes, despite attempts to use trademark law to “protect” the Scouts’ image. In *Girl Scouts of United States v. Personality Posters Mfg. Co.*²⁰⁹, the defendant was sued for distributing a poster that consisted of a smiling girl dressed in the well-known green uniform of the Junior Girl Scouts, with her hands clasped above her protruding, clearly pregnant abdomen. The caveat “BE PREPARED”

²⁰⁵ See e.g. <http://www.tinet.com/chattycathy/>

²⁰⁶ See e.g. <http://www.seniors-place.com/shopping/speccolcollectdolls.html>, <http://tvtoys.com/library/beasley/>

²⁰⁷ Alyson Lewis, *Playing Around With Barbie TM: Expanding Fair Use for Cultural Icons*, 1 J. Intell. Prop. 61 (Spring, 1999)

²⁰⁸ Alyson Lewis, *Playing Around With Barbie TM: Expanding Fair Use for Cultural Icons*, 1 J. Intell. Prop. 61, (Spring, 1999).

²⁰⁹ *Girl Scouts of United States v. Personality Posters Mfg. Co.*, 304 F. Supp. 1228 (S.D.N.Y. 1969).

appeared next to her hands. In a well reasoned and arguably courageous opinion the court held that the Girl Scouts has failed utterly to establish the requisite element of customer confusion, writing:

Even if we hypothesize that some viewers might at first blush believe that the subject of the poster is actually a pregnant Girl Scout, it is highly doubtful that any such impression would be more than momentary or that any viewer would conclude that the Girl Scouts had printed or distributed the poster. But it is the role of the court to rule on evidence, not on hypothesis; and of evidence not a scintilla has been presented supporting the allegation of confusion or its likelihood....Plaintiff's affidavit goes no further than to state that "Plaintiff has received telephone calls from members of the public expressing their indignation concerning defendant's said poster"; but indignation is not confusion. To the contrary, the indignation of those who have called would appear to make it clear that they feel that the Girl Scouts are being unfairly put upon, not that the Girl Scouts are the manufacturers or distributors of the object of indignation.²¹⁰

The Girl Scouts' trademark rights have been found subsidiary to First Amendment considerations in other commercial contexts as well,²¹¹ despite the fact that (unlike Barbie) Congress provided the Girl Scouts' "emblems, badges, marks, and words" with special statutory protections.²¹² This contrasts fairly dramatically with another statutorily protected mark, "Olympics," which has been treated quite differently.²¹³ In the "Gay Olympics" case the U.S. Supreme Court concluded that the fact that an athletic association claimed an expressive, as opposed to a purely commercial, purpose in using the word "Olympic" did not give it a First Amendment right to use the word contrary to the wishes of the United States Olympic Committee.²¹⁴

²¹⁰ *Girl Scouts of United States v. Personality Posters Mfg. Co.*, 304 F. Supp. 1228, 1231 (S.D.N.Y. 1969).

²¹¹ *Girl Scouts of United States v. Bantam Doubleday Dell Publishing*, 808 F. Supp. 1112 (S.D.N.Y. 1992) ("this Court is unable to find that there is a likelihood of confusion between Plaintiffs' protected trademarks and Defendants' children's books sufficient to overcome the First Amendment value of protecting creative works such as Defendants' books.")

²¹² 36 USCS § 80305 is entitled "Exclusive right to emblems, badges, marks, and words" and states "The corporation has the exclusive right to use all emblems and badges, descriptive or designating marks, and words or phrases the corporation adopts, including the badge of the Girl Scouts, Incorporated, referred to in the Act of August 12, 1937 (ch. 590, 50 Stat. 623) [unclassified], and to authorize their use, during the life of the corporation, in connection with the manufacture, advertisement, and sale of equipment and merchandise. This section does not affect any vested rights.

²¹³ But see *Stop the Olympic Prison v. United States Olympic Committee*, 489 F. Supp. 1112 (S.D.N.Y. 1980) (nonprofit organization's distribution of posters featuring the word "Olympic" and Olympic symbols as a means of soliciting contributions for its cause, the opposition to plans to convert the Olympic Village in Lake Placid into a prison after the 1980 Winter Games, not a commercial use of "Olympics" and therefore not violation of Section 110 of the Amateur Sports Act.).

²¹⁴ In *San Francisco Arts & Athletics v. United States Olympic Committee*, 483 U.S. 522 (1987) the Court interpreted the Amateur Sports Act, 36 U.S.C. § 220506, in a manner that gave the USOC exclusive rights in the word "Olympic." The Court held that unlike normal trademark holders, the USOC did not have to prove that an unauthorized use was confusing, and that alleged infringers were not permitted to assert the fair use defense. See also Kellie L. Pendras COMMENT: Revisiting *San Francisco Arts & Athletics v. United States Olympic Committee*: Why It Is Time to Narrow

3. Full-Figured Women

Trademarks linked to jeans designed for larger proportioned women were also required to yield to parody. In *Jordache Enterprises v. Hogg Wyld, Ltd.*²¹⁵ (and given the name of the defendant, the reader can already see where this is going), JORDACHE mark and horse appliqué marks placed on the right rear pocket to provide source identification for plus size denim jeans were found not to be infringed by a competitor's use of the name LARDASHE in similar script lettering stitched into the right rear pocket of their plus size jeans, together with a pig appliqué.²¹⁶

B. I'm Pink, Therefore I'm Spam

While there are “ungendered” cases in which arguably commercial uses of trademarks were held noninfringing or nondilutive, there are clear analytic difference in the way the results were reached. For example, in *Hormel Foods Corp. v. Jim Henson Productions*, the court refused to enjoin the use of a character named Spa'am in the movie *Muppets Treasure Island*, despite Hormel's allegations concerning its Spam trademark for luncheon meat.²¹⁷ The court seemed to hold little regard for Hormel's product, referring to it as a “processed, gelatinous block,” and asserting that Hormel should be inured to ridicule, sarcastically noting:

Although SPAM is in fact made from pork shoulder and ham meat, and the name itself supposedly is a portmanteau word for spiced ham, countless jokes have played off the public's unfounded suspicion that SPAM is a product of less than savory ingredients. For example, in one episode of the television cartoon *Duckman*, Duckman is shown discovering "the secret ingredient to SPAM" as he looks on at "Murray's Incontinent Camel Farm." In a recent newspaper column it was noted that "In one little can, Spam contains the five major food groups: Snouts. Ears. Feet. Tails. Brains." In view of the more or less humorous takeoffs such as these, one might think Hormel would welcome the association with a genuine source of pork.²¹⁸

Protection of the Word "Olympic" 24 *Hawaii L. Rev.* 729 (Summer 2002); Kelly Browne, CASE NOTE: A SAD TIME FOR THE GAY OLYMPICS: *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee* 107 S. Ct. 2971 (1987). Smell a rat? More recently use of term “Rat Olympics” by a "Behavioral Learning Principles" course Nebraska Wesleyan University was objected to by the U.S. Olympic Committee. See “Ratted Out” by Will Potter in the 2/14/2003 *Chronicle for Higher Education*, accessed at <http://chronicle.com/cgi2-bin/printable.cgi?article=http://chronicle.com/weekly/v49/i23/23a00902.htm>

²¹⁵ *Jordache Enters. v. Hogg Wyld, Ltd.*, 625 F. Supp. 48 (D.N.M. 1985).

²¹⁶ *Jordache Enters. v. Hogg Wyld, Ltd.*, 625 F. Supp. 48, 55 (D.N.M. 1985). (“There is an additional aspect to the Lardashe name and mark which compels the conclusion that its use does not infringe upon the Jordache name and marks: the aspect of parody.”)

²¹⁷ *Hormel Foods Corp. v. Jim Henson Prods.*, 73 F.3d 497 (2d Cir. 1996).

²¹⁸ *Hormel Foods Corp. v. Jim Henson Prods.*, 73 F.3d 497, 501 (2d Cir. 1996) (citations omitted).

However, one clearly articulated basis for the holding was the court's belief that, though perhaps Hormel was too pigheaded to realize it, the Henson invocation of the Spam trademark and related associations was actually constructive in nature,²¹⁹ because Spa'am was a positive character, he was not portrayed as unhygienic, and that a simple comic reference to the fact that SPAM was made from pork would not, in the court's estimation, damage its image.²²⁰ This contrasts dramatically with the "Barbie Girl" court's disregard for the unsavory depiction of Barbie characteristics in the disputed song. The Spam jurists sought to reassure Hormel that the contested Spa'am character didn't reflect negatively on its product," while the "Barbie Girl" court straightforwardly concluded that the First Amendment includes the right to bash Barbie.

The typical case in which an unauthorized use of a trademark is protected by the First Amendment is one in which the use is fairly unambiguously noncommercial. For example, in the "Bally sucks" case a disgruntled former health club member was held to have a First Amendment right to post negative consumer commentary about Bally Total Fitness on a website posted at www.ballysucks.com because it was a completely noncommercial venture.²²¹ Had the defendant attempted to sell posters or tee shirts proclaiming that Bally sucked, there is some suggestion in the opinion that the court might have been more protective of the Bally trademark.²²² In a case

²¹⁹ The court wrote:

Spa'am, however, is not the boarish Beelzebub that Hormel seems to fear. The district court credited and relied upon the testimony of Anne Devereaux Jordan, an expert in children's literature, to find that Spa'am is a positive figure in the context of the movie as a whole -- even if he is not "classically handsome." *Hormel Foods Corp. v. Jim Henson Productions, Inc.*, 1995 U.S. Dist. LEXIS 13886, *5, No. 95 Civ. 5473 (S.D.N.Y. Sept. 22, 1995). Indeed, Spa'am is a comic character who "seems childish rather than evil." *Id.* at *7. Although he is humorously threatening in his first appearance, he comes to befriend the Muppets and helps them escape from the film's villain, Long John Silver. By film's end, "Spa'am is shown sailing away with the other Muppets as good humor and camaraderie reign." *Id.* at *5.

Hormel Foods Corp. v. Jim Henson Prods., 73 F.3d 497, 501 (2d Cir. 1996).

²²⁰ *Hormel Foods Corp. v. Jim Henson Prods.*, 73 F.3d 497, 504 (2d Cir. 1996).

²²¹ *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161 (C.D. Calif. 1998).

²²² *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161, 1167 (C.D. Calif. 1998) ("none of the cases that Bally cites involve consumer commentary. In *Coca-Cola*, the court enjoined the defendant's publication of a poster stating "Enjoy Cocaine" in the same script as Coca-Cola's trademark. Likewise, in *Mutual of Omaha*, the court prohibited the use of the words "Mutant of Omaha" with a picture of an emaciated human head resembling the Mutual of Omaha's logo on a variety of products as a means of protesting the arms race. Here, however, Faber is using Bally's mark in the context of a consumer commentary to say that Bally engages in business practices which Faber finds distasteful or unsatisfactory. This is speech protected by the First Amendment.").

involving publication of a parody of the Dr. Seuss book "The Cat in The Hat," the court explicated held that the claim of parody is no defense "where the purpose of the similarity is to capitalize on a famous mark's popularity for defendant's own commercial use."²²³

C. Sex, Drugs and Beer

When courts find parodies, satire, and other nonpermissive uses of trademarks objectionable for content-based reasons, they are very likely to find trademark infringement, trademark dilution, or both. Examples of cases in which courts enjoined unauthorized commercial uses or invocations of trademarks include sex and drug references, and anything found to be "unwholesome."

In the *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema*,²²⁴ a trademark was found to be damaged by the unauthorized use of a "strikingly similar" mark in a pornographic film entitled "Debbie Does Dallas." The plaintiff was described as "the Dallas Cowboys Cheerleaders, Inc., a wholly owned subsidiary of the Dallas Cowboys Football Club, Inc.,"²²⁵ and thus characterized the cheerleaders as a commercial entertainment service owned by, and aimed at, men. The court rather scathingly characterized the disputed use of the mark as follows:

In November 1978 the Pussycat Cinema began to show "Debbie Does Dallas," a gross and revolting sex film whose plot, to the extent that there is one, involves a cheerleader at a fictional high school, Debbie, who has been selected to become a "Texas Cowgirl." In order to raise enough money to send Debbie, and eventually the entire squad, to Dallas, the cheerleaders perform sexual services for a fee. The movie consists largely of a series of scenes graphically depicting the sexual escapades of the "actors." In the movie's final scene Debbie dons a uniform strikingly similar to that worn by the Dallas Cowboys Cheerleaders and for approximately twelve minutes of film footage engages in various sex acts while clad or partially clad in the uniform.²²⁶

The court noted with apparent horror that "Defendants advertised the movie with marquee posters depicting Debbie in the allegedly infringing uniform and containing such captions as 'Starring Ex

²²³ *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1405-06 (9th Cir. 1997) ("In a traditional trademark infringement suit founded on the likelihood of confusion rationale, the claim of parody is not really a separate "defense" as such, but merely a way of phrasing the traditional response that customers are not likely to be confused as to the source, sponsorship or approval.... The claim of parody is no defense "where the purpose of the similarity is to capitalize on a famous mark's popularity for defendant's own commercial use."")

²²⁴ *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 202 (2d Cir. 1979).

²²⁵ *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 202 (2d Cir. 1979).

²²⁶ *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 202-03 (2d Cir. 1979).

Dallas Cowgirl Cheerleader Bambi Woods"²²⁷ despite the fact that "Bambi Woods, the woman who played the role of Debbie, is not now and never has been a Dallas Cowboys Cheerleader."²²⁸ Clearly appalled by the film, and perhaps feeling protective and paternal toward the Dallas Cowboy Cheerleaders' image in commerce, the court articulated the trademark confusion standard very broadly, holding:

In order to be confused, a consumer need not believe that the owner of the mark actually produced the item and placed it on the market. The public's belief that the mark's owner sponsored or otherwise approved the use of the trademark satisfies the confusion requirement. In the instant case, the uniform depicted in "Debbie Does Dallas" unquestionably brings to mind the Dallas Cowboys Cheerleaders. Indeed, it is hard to believe that anyone who had seen defendants' sexually depraved film could ever thereafter disassociate it from plaintiff's cheerleaders. This association results in confusion which has "a tendency to impugn (plaintiff's services) and injure plaintiff's business reputation."²²⁹

Concluding that "trademark laws are designed not only to prevent consumer confusion but also to protect 'the synonymous right of a trademark owner to control his product's reputation,'"²³⁰ the court affirmed the Dallas Cowboy's Football Club's right to control the reputation of its product, the cheerleaders, in commerce, though one might conclude the reputation of true concern had more to do with sexuality than trademarks.

In *General Electric Co. v. Alumpa Coal Co.*,²³¹ General Electric objected to the defendant's use of a humorous but ribald "Genital Electric" monogram on underpants and T-shirts that it marketed. The court found "actionable infringement" after rather remarkably concluding that "there is great probability of confusion among the general public of plaintiff's trademarks and defendant's imitation."²³² Alternatively, in *Pillsbury Doughboy v. Milky Way Productions, Inc.*, the court found consumer confusion was unlikely, but still enjoined the defendant's publication of a parody in which the Pillsbury Doughboy participated in sexually explicit satirical drawing captioned "Lovin' From

²²⁷ *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd*, 604 F.2d 200, 203 (2d Cir. 1979).

²²⁸ *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd*, 604 F.2d 200, 203 n.2 (2d Cir. 1979).

²²⁹ *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd*, 604 F.2d 200, 204-05 (2d Cir. 1979).

²³⁰ *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd*, 604 F.2d 200, 205 (2d Cir. 1979).

²³¹ *General Electric Co. v. Alumpa Coal Co.* 205 U.S.P.Q. (BNA) 1036 (D. Mass. 1979)

²³² *General Electric Co. v. Alumpa Coal Co.* 205 U.S.P.Q. (BNA) 1036 (D. Mass. 1979).

The Oven."²³³ The court held that the cartoon diluted the distinctive value of Pillsbury's all-American iconic value and injured the Company's business reputation.²³⁴

When New Line Cinema produced a feature film satirizing beauty contests in rural Minnesota that portrayed them as filled with backbiting and jealousy, suggested the participants tend to suffer from eating disorders, and contained "off-color humor and content," it was enjoined from calling the movie "Dairy Queens."²³⁵ The dairy treat retailer that holds the "Dairy Queen" trademark successfully argued that the title "Dairy Queens" would cause the public to associate its trademarked name with the unwholesome content of the film, an association that would create negative impressions and confuse its customers, thereby demeaning and disparaging its mark.²³⁶

A different sort of purity was at issue in *Chemical Corp. of America v. Anheuser-Busch, Inc.*, in which the slogan for a floor wax containing insecticide, "Where there's life, there's bugs," was held to infringe a beer marketing slogan, "Where there's life, there's Bud."²³⁷ The court held that "the use of the 'bugs' slogan would cause confusion in the minds of the public as to the source of the floor wax product and would damage the 'public image' of Anheuser-Busch by associating in the minds of the public the idea of bugs with a food product."²³⁸

In *Coca-Cola Co. v. Gemini Rising, Inc.*, a court enjoined the defendant's merchandising of posters that partially reproduced a "familiar 'Coca-Cola' trademark and distinctive format" except for the substitution of the script letters 'ine' for 'Cola', so that the poster read 'Enjoy Cocaine'.²³⁹ The court wrote:

²³³ *Pillsbury Doughboy v. Milky Way Productions, Inc.*, 215 U.S.P.Q. (BNA) 124, 135-36 (N.D. Ga. 1981).

²³⁴ *Pillsbury Doughboy v. Milky Way Productions, Inc.*, 215 U.S.P.Q. (BNA) 124, 135-36 (N.D. Ga. 1981).

²³⁵ *American Dairy Queen Corp. v. New Line Prods.*, 35 F. Supp. 2d 727 (D. Minn. 1998).

²³⁶ *American Dairy Queen Corp. v. New Line Prods.*, 35 F. Supp. 2d 727 (D. Minn. 1998).

²³⁷ *Chemical Corp. of America v. Anheuser-Busch, Inc.*, 306 F.2d 433 (5th Cir. 1962), *cert. denied*, 372 U.S. 965, 83 S. Ct. 1089, 10 L. Ed. 2d 129, 137 U.S.P.Q. (BNA) 913 (1963).

²³⁸ *Chemical Corp. of America v. Anheuser-Busch, Inc.*, 306 F.2d 433, 436 (5th Cir. 1962), *cert. denied*, 372 U.S. 965, 83 S. Ct. 1089, 10 L. Ed. 2d 129, 137 U.S.P.Q. (BNA) 913 (1963). This case apparently made an impression on Justice Breyer, who asked during a recent oral argument in a trademark dilution case before the Supreme Court whether a necessary element of dilution is "tarnishment" of reputation, giving the example of "Bugweiser" bug spray, which might not lead Budweiser consumers to believe that their beer has Deet in it, but which might nevertheless lead them to think, according to Breyer: "Budweiser. Yuck." Dahlia Lithwick, "Thong of the South," posted to slate.com, accessed at <http://slate.msn.com/?id=2073884>

²³⁹ *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183 (E.D.N.Y. 1972).

Although it contends that the word "Coca-Cola" as such does not appear anywhere on the poster one would have to be a visitor from another planet not to recognize immediately the familiar "Coca" in its stylized script and accompanying words, colors and design. Indeed, defendant's assertion that "the poster was intended to be a spoof, satirical, funny, and to have a meaning exactly the opposite of the word content" would be meaningless except in the context of an immediately recognizable association with the "Coca-Cola" trademark. This is buttressed by the only change made in the new poster, *i.e.*, "Raid-Mark" in place of "Trade-Mark" -- a clear indication of defendant's predatory intent, however humorous defendant considers it.²⁴⁰

The court further opined: "To associate such a noxious substance as cocaine with plaintiff's wholesome beverage as symbolized by its "Coca-Cola" trademark and format would clearly have a tendency to impugn that product and injure plaintiff's business reputation..."²⁴¹

In fairness it must be noted that trademark holders sometimes triumph over speech interests even when the message is not prurient in nature. Where a company commercially produced and distributed religious tract cards and window display stickers which closely resembled Master Charge credit cards, and bore the legend "Give Christ charge of your life," the court found trademark infringement and dilution and admonished the defendant to "utilize numerous means of conveying their commendable religious message without the apparent appropriation of the plaintiff's marks."²⁴²

D. Men Only Clubs

Given the fluid and subjective nature of trademark infringement determinations, a court could take the opportunity to advance its vision of social justice when resolving trademark disputes. This occurred in 1979 when a federal district court found a limited right for the Philadelphia Jaycees

²⁴⁰ Coca-Cola Co. v. Gemini Rising, Inc., 346 F. Supp. 1183, 1187 (E.D.N.Y. 1972).

²⁴¹ Similarly, in *Deere & Co. v. MTD Products*, 41 F.3d 39 (2d Cir. 1994), a television commercial for a competing lawnmower tractor that humorously invoked the famous Deere trademark ("a proud, majestic deer"), in the form of a cartoon deer that was cowardly and afraid, was held to be violation of the New York anti-dilution statute because "alterations of that sort, accomplished for the sole purpose of promoting a competing product . . . risk the possibility that consumers will come to attribute unfavorable characteristics to a mark and ultimately associate the mark with inferior goods and services." See also *Original Appalachian Artworks, Inc. v. Topps Chewing Gum Original*, 642 F. Supp. 1031 (N.D. Ga. 1986) (merchandiser of "Garbage Pail Kids" stickers and products injured owner of Cabbage Patch Kids mark because of likelihood of confusion as to origin, approval, endorsement, or other association of defendant's products and mark with plaintiff's); and *D.C. Comics, Inc. v. Unlimited Monkey Business*, 598 F. Supp. 110 (N.D. Ga. 1984) (holder of Superman and Wonder Woman trademarks damaged by use of similar marks by singing telegram franchisor as defendant violated the Lanham Act, 15 U.S.C.S. § 1114(1), by using costumes similar to those used by characters in plaintiff's comic books); *Gucci Shops, Inc. v. R.H. Macy & Co.*, 446 F. Supp. 838 (S.D.N.Y. 1977)(defendant's diaper bag labeled "Gucchi Goo" held to injure Gucci's mark).

²⁴² *Interbank Card Assoc. v. Simms*, 431 F. Supp. 131 (M.D. N.C. 1977).

to continue to call themselves the “Jaycees” even after the national organization revoked its charter because it had begun admitting women as members, as long as the prefix “Philadelphia” was always used, and the group made clear in the printed material that it disseminated that it was not affiliated with the national Jaycees.²⁴³ However, after referencing “the halcyon days of the 1920s” in which “the United States Jaycees limited membership to young men,” the Third Circuit Court of Appeals reversed, concluding:

This case...centers on the infringement of trademark rights. The exclusion of women is wholly independent of the protection provided by the Lanham Act to trademarks. The action terminating the Philadelphia charter for admitting women to membership was not dependent on the Lanham Act. Nor would a decision in this Lanham Act case favorable to the Philadelphia Jaycees alter the fact of the discrimination; it would not restore the Philadelphia chapter's affiliation or change the National's membership policy..²⁴⁴

The appellate court appeared ignorant of, though probably affirmatively chose to ignore, the impact that allowing the Philadelphia club to continue calling itself Jaycees might have had on the national organization’s willingness to compromise on the membership issue.

In 1986 a similar trademark dispute arose involving the Kiwanis, provoking a federal district court judge to write:

It is somewhat astonishing in the year 1985 to hear an officer of a well-known international organization (boasting more than 300,000 members) say that it is fine for women "to help make the pancakes" but not for them to be members of the organization sponsoring the sale of those pancakes. The issue squarely presented by this case is whether such a blatant and admitted sexist attitude, and the discriminatory membership policy arising from it, are entitled to the protection of a United States District Court. For Kiwanis International asks this court to enjoin a local chapter from using the Kiwanis name and logo *solely* because that local has admitted a woman into its ranks.²⁴⁵

The Kiwanis Ridgewood had accepted a female member and despite pointed instructions by the national organization, refused to revoke her membership. Kiwanis International then filed suit in federal court under the Lanham Act, claiming that Kiwanis Ridgewood had forfeited its license to

²⁴³ United States Jaycees v. Philadelphia Jaycees, 490 F. Supp. 688 (E.D.Pa.1979); see also United States Jaycees v. Philadelphia Jaycees, 639 F.2d 134 (3d Cir. 1981).

²⁴⁴ United States Jaycees v. Philadelphia Jaycees, 639 F.2d 134, 145 (3d Cir. 1981).

²⁴⁵ Kiwanis Int'l v. Ridgewood Kiwanis Club, 627 F. Supp. 1381, 1382 (D.N.J. 1986).

use the Kiwanis marks, and sought preliminary and permanent injunctions prohibiting Ridgewood's continued use of the mark. In response, Kiwanis Ridgewood filed suit in New Jersey Superior Court seeking an injunction against International's license revocation, and a declaration that the woman at issue was a bona fide member of the Ridgewood club. Kiwanis Ridgewood asserted in its complaint that the revocation would violate the New Jersey Law Against Discrimination. After removal to federal court, the district court held that Kiwanis Ridgewood was a place of public accommodation and therefore prohibited from restricting membership on the basis of sex under the New Jersey Law Against Discrimination. The court further held that Kiwanis International was precluded from enforcing its illegal discriminatory membership restrictions against Ridgewood, concluding:

To suggest that this case involves solely the right of Kiwanis to protect its name and logo because of a violation of its constitution or bylaws is to ignore reality. What is truly at issue here is whether Kiwanis can, directly or indirectly, enforce its policy of discrimination against women with the imprimatur of this court. This opinion concludes that it cannot. Kiwanis' trademark rights are subject to the right of women to be free of discrimination, as indeed they should be.²⁴⁶

However, as with the district court opinion in the Jaycees case, this too was reversed by an appellate court, in this case on the grounds that Kiwanis Ridgewood did not constitute a place of public accommodation.²⁴⁷

Thus amalgams of trademark infringement and trademark dilution theory may be used by courts to impede or silence parodies or speech related uses of trademarks that are commercial in any respect, but not to effectuate gender integration. Where the unauthorized use implicates something a court finds unsavory, such as sex, drugs or bugs, trademark law is readily invoked to "protect" the images and reputations of the marked goods and services. Where a court feels perhaps that a product such as Barbie or Spam deserves by its very nature to be satirized, or simply values a broad construction of the First Amendment, marks can be parodied or otherwise used for speech purposes even in commercial contexts.

²⁴⁶ *Kiwanis Int'l v. Ridgewood Kiwanis Club*, 627 F. Supp. 1381, 1395 (D.N.J. 1986).

²⁴⁷ *Kiwanis International v. Ridgewood Kiwanis Club*, 806 F.2d 468 (3d Cir. 1986).

Conclusion

Both free speech rights and efficient commerce would be best served if courts entertained trademark infringement claims only where either identical or exceedingly similar marks are used commercially, in a trademark sense, on directly competing or closely related goods and services, and dilution claims perhaps not at all. As an interim measure, however, courts should reject the specter of the gullible, harried, ignorant and stupid consumer as a standard by which to measure likelihood of confusion and instead embrace something along the lines of the “reasonably careful purchaser,” a creature far more intelligent and discerning than the consumers currently manifest in trademark jurisprudence. In sum, the courts should be a little less eager to find confusion likely simply because confusion somewhere, somehow, on someone’s part is arguably possible. If, however, judges are going insist upon constructing broad (or even narrow) penumbras of intangible commercial property rights that swirl protectively around enforceable trademarks, these rights ought to be attaching consistently and predictably to all trademarks within a particular mark class or strength category, rather than allowing gender assumptions to impact the scope of the source-identifying trademark.