Contesting the Incontestable: Reforming Trademark’s Descriptive Mark Protection Scheme

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I. INTRODUCTION

I have always been at a loss to know why so many marks are adopted which have an aura, or more, of description about them. With the whole field of possible coinage before them, it is strange that merchants insist upon adopting marks that are so nearly descriptive. Possibly they wish to interject into the name of their goods some intimation of excellence, and are willing to incur the risk.

—Franklin Knitting Mills, Inc. v. Fashion Sweater Mills, Inc.¹

Federal trademark law² in the United States is designed to help consumers, protect business owners, and promote investment while removing no more from the public domain than is absolutely necessary.³ Courts addressing trademark questions divide the universe of possible marks⁴ into four categories: arbitrary or fanciful, suggestive, descriptive, and generic.⁵ This article focuses on descriptive trademarks. It argues that the current level of protection afforded these marks fails to meet the goals of this federal doctrine in all respects, and must be reformed to provide better protection for small business owners, consumers, and the public domain.

4. Throughout this article the terms “trademark,” “service mark,” and “mark” will be used interchangeably.
A variety of problems plague the present method by which descriptive marks are regulated. Consider the following scenario: under the existing schema, descriptive marks may essentially be warehoused with the United States Patent and Trademark Office ("PTO") for five or more years before registration on the Principal Register. Furthermore, descriptive marks may display the ® symbol despite only being "capable" of receiving the protection the ® generally symbolizes. Accordingly, these marks give the impression of having received stronger protection than they have actually been afforded. Additionally, descriptive marks can prevent other marks from being registered on the Principal Register, despite never acquiring "secondary meaning." In other words, the first applicant to successfully register a descriptive mark on the Supplemental Register finds her mark elevated to a position that has become increasingly difficult for competitors to reach, despite failing to be inherently distinctive. Thus, the current scheme appears to have adopted the notion that first to register, not necessarily first to use a descriptive mark, deserves the most protection.

While these dangers appear, on the surface, to strike exclusively at either uninformed consumers or the public domain, the current system poses dangers to commerce as well. For example, because of the widespread use of the internet as a business tool, a single mark holder may soon be able to remove the use of a descriptive term from all other businesses across all industries via the use of a domain name. Moreover, smaller businesses are slowly being squeezed out of the market for these marks. Soon, only large firms will be able to afford the descriptive marks that will likely have shorter lifespans than non-descriptive marks. Furthermore, many small businesses struggle to survive on a daily basis; few are in a position to continually police their mark throughout the entire nation.

6. Though trademarks take many forms, (words, colors, images) this article address marks as words exclusively.
10. See Part II.E infra (discussing the creation of the Supplemental Register and the benefits that accrue to a mark registered on the Supplemental Register).
12. Legislators from both political parties and at both state and federal levels have recently attempted to highlight the hardships of modern day small business owners. See Allentown Clerk's Firing Sparks Change in Jobless-Claim Hearings; Ruling Requires Employers to Engage a Lawyer; THE MORNING CALL, Mar. 22, 2005, at D6 (explaining ruling from the Pennsylvania Department of Labor and Industries requiring an attorney perform all unemployment filings on behalf of employers "could pose a hardship to small business that cannot afford to retain an attorney"); Sen. Kennedy Fights to Protect Americans from Flawed Bankruptcy Bill, US FED NEWS, Feb. 17, 2005 (detailing Senator Kennedy arguing the proposed bankruptcy bill did nothing for small businesses facing economic hardship due to the many reservists and national guard troops called to active duty); Sen. Harkin Seeks Energy Cost Relief for Small Businesses, Farmers, US FED NEWS, Feb. 2, 2005 ("The rise in energy costs over the past several years has threatened the viability and survival of many small businesses and farms."); The Governor's Budget Proposal—Governor Unveils 2006 Budget—The
Accordingly, this article suggests a means to preserve descriptive trademarks yet rebalance the playing field in favor of the public domain, enhanced competition, the smaller mark owner, and the average consumer. By removing some of the mechanisms that have evolved, through legislation and litigation, that over-protect descriptive marks before they have achieved secondary meaning, a new level of fair play can be achieved. This article is not a polemic claiming that descriptive trademarks will somehow destroy the English language and, therefore, should be proclaimed free for all to use. On the contrary, it is a call to reform a system that threatens to skew too far in favor of the interests of the largest, most powerful businesses, thereby removing from the public a valuable tool in making the myriad of product choices that are integral to our daily lives.

Part II lays out the underlying trademark law necessary for the discussion that follows, including an explanation of all four types of marks, the differences between the Principal and Supplemental Registers, and intent-to-use applications. Additionally, this part will review how a mark establishes secondary meaning, the significance of a mark achieving incontestable status, and trademark’s fair use doctrine. Part III assesses the ways the current protections of descriptive marks pose danger to the public domain and linguistic commons.13

Part IV examines the impact of the existing system on fair competition and the free market, particularly in light of the concurrent use doctrine and the new judicial outlook regarding the Dawn Donut14 doctrine. In addition to addressing the possible dangers posed by two recent decisions regarding trademarks and the internet, Part V explores how even applicants that secure registration for their descriptive mark may face continued challenges to the validity or exclusive use of their mark. Finally, Part VI offers a few methods to allow the continued use of descriptive marks while simultaneously reversing the trend of restricting their availability to only those select few organizations that can risk losing a mark in which they have invested goodwill.

II. CURRENT LAW REGARDING DESCRIPTIVE TRADEMARKS

A. Trademark Law Generally

To protect consumers, the Trademark Act holds that one may not “cause confusion . . . mistake, or . . . deceive [a person] as to the origin, sponsorship, or Impact, THE PROVIDENCE JOURNAL, Jan. 28, 2005, at A13 (detailing Governor Carcieri’s proposal cigarette taxes be paid in advance: “Store owners said the pre-payment would be a hardship on small businesses.”).

13. See Steven Wilf, Who Authors Trademarks?, 17 CARDOZO ARTS & ENT. L.J. 1, 10 (1999) (“All language consists of words and a linguistic market which informs how those words are defined.”).

approval of . . . goods, services, or commercial activities.\textsuperscript{15} Trademark law looks first to "use, not registration."\textsuperscript{16} Nevertheless, for the protection of both consumers and mark holders, as well as for administrative ease, a registration system was created by statute to be administered by the PTO.\textsuperscript{17} On the whole, the Act is concerned with "prevent[ing] customer confusion . . . and protect[ing] the value of identifying symbols, [but] not . . . encourag[ing] invention by providing a period of exclusive rights."\textsuperscript{18}

Trademark law, as with all intellectual property doctrines, concurrently serves multiple masters. As J. Thomas McCarthy has explained, the underlying policy rationale is that of "consumer protection, property rights, economic efficiencies and universal concepts of justice. . . . [T]hese policies are sometimes conflicting and must be weighed and sifted by court[s]."\textsuperscript{19} Central to understanding the purpose of trademark law is its foundation in the realm of commerce—not science or art.\textsuperscript{20} Accordingly, it is appropriate that the authority of "Congress to provide for the registration of marks which are used in commerce stems from . . . the commerce clause of the Constitution."\textsuperscript{21} The Supreme Court has required Congress to find justification for the regulation of marks in the commerce clause alone.\textsuperscript{22} By so doing, the Court not only prevented an overreaching of the federal government, it also commented on how trademarks fit into the larger economic picture: "The trade-mark is, therefore, a useful and valuable aid or instrument of commerce."\textsuperscript{23}

\textsuperscript{16} KANE, supra note 3, at § 5.1. Kane states that many other countries ground their protection in registration. \textit{Id.} Registration of a mark does not "create" the mark, only interstate use of the mark does: "[T]rademark ownership and attendant rights are acquired in the marketplace by use." \textit{In re ECCS, Inc.}, 94 F.3d 1578, 1579 (Fed. Cir. 1996). \textit{See also} David S. Barrett, \textit{The Future of the Concurrent Use of Trademarks Doctrine in the Information Age}, 23 HASTINGS COMM. & ENT. L.J. 687, 691 (2001) (explaining the United States contrasts most of the rest of the world's "first to register" trademark systems by employing a "first to use" system).
\textsuperscript{17} See Parts II.C & II.E infra. In sum, while marks may be used without registration, the types of marks discussed herein are those that are used by businesses interested in the benefits of trademark registration. \textit{See generally} KANE, supra note 3, at § 6.1 (discussing the myriad of benefits from registering a mark).
\textsuperscript{19} MCCARTHY, supra note 18, at § 2.2.
\textsuperscript{20} Trade-Mark Cases, 100 U.S. 82, 94-95 (1879) ("The ordinary trade-mark has no necessary relation to invention or discovery."). The Court's holding rejected the argument that Congress could regulate trademarks under Article I, Section 8, Clause 8 of the Constitution, which allows Congress to "[p]romote the [p]rogress of [s]cience and the useful [a]rts." \textit{Id.} at 93-99; U.S. CONST.; art. I, § 8, cl. 8.
\textsuperscript{21} Trademark Manual of Examining Procedure ("TMEP") at 1 (2d ed. 1997).
\textsuperscript{22} Trade-Mark Cases, 100 U.S. at 97.
\textsuperscript{23} \textit{Id.} at 95 (emphasis added).
B. The Four Categories of Protectable Marks

1. Generic, Suggestive, Arbitrary Marks

The Supreme Court has recognized that there are four basic types of marks: generic, arbitrary or fanciful, suggestive, and descriptive.\(^{24}\) Generic marks are "the common name for the kind of product [and] can never be a trademark."\(^ {25}\) A term is considered generic if it tells the "buyer what the product is, not where it came from."\(^ {26}\) Some examples of marks held to be generic are "ALL NEWS CHANNEL,"\(^ {27}\) "BABY OIL,"\(^ {28}\) and "CONSUMER ELECTRONICS MONTHLY."\(^ {29}\)

The Third Circuit has created a two part test for distinguishing between a generic and descriptive mark: "First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?"\(^ {30}\)

Unlike generic marks, arbitrary or fanciful, and suggestive marks possess inherent distinctiveness and are deserving of protection.\(^ {31}\) Arbitrary or fanciful marks are generally regarded as "strong" marks that need not demonstrate secondary meaning.\(^ {32}\) Fanciful marks are "words that have been invented or selected for the sole purpose of functioning as a trademark."\(^ {33}\) A few recognizable fanciful marks

\(^ {25}\) KANE, supra note 3, at § 2:1.
\(^ {26}\) MCCARTHY, supra note 18, at § 12:1.
\(^ {29}\) CES Publ’g Corp. v. St. Regis Publ’n, 531 F.2d 11, 13 (2d Cir. 1975) (holding no infringement despite use of same name for competing magazine because the mark was generic, despite any secondary meaning that had accrued).

Arbitrary marks can also become generic because their use has become synonymous with the product in question. This process is sometimes known as "genericide." See e.g. Bayer Co. v. United Drug Co., 272 F. 505, 505 (S.D.N.Y. 1921) (finding “ASPIRIN” generic for chemical compound otherwise known as “acetyl salicylic acid”).

\(^ {30}\) H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, 782 F.2d 987, 990 (Fed. Cir. 1986) (holding title FIRE CHIEF for a magazine devoted to the profession of fire fighting was not generic and was at most descriptive).

\(^ {31}\) Two Pesos, 505 U.S. at 769.
\(^ {32}\) MCCARTHY, supra note 18, at § 11:4.

\(^ {33}\) Id. at § 11:5. Professor McCarthy notes: "Although fanciful marks receive the strongest judicial protection, they are often unacceptable from a business and merchandising point of view. [T]he business person and the advertising agency want a mark that, by itself, helps to 'sell' the
are: "EXXON,"34 "KODAK,"35 and "GOOGLE."36 Marks that are termed "arbitrary" are those that are words with no particular connection to the good or service they represent. Examples include "CAMEL" for cigarettes and "IVORY" for soap.37

Suggestive marks are easy to protect, yet unlike arbitrary or fanciful marks, these marks give the buyer a hint of what good or service the mark represents. Suggestive marks "require imagination, thought and perception to reach a conclusion as to the nature of the goods."38 Once a mark has been determined to be suggestive it no longer must prove secondary meaning, and is accorded the same level of protection as an arbitrary or fanciful mark.39 A few examples of suggestive marks include: "HEARTWISE" for healthy food,40 "Q-TIPS" for cotton swabs,41 and "ROACH MOTEL" for insect traps.42

There is, however, no significant objective difference between suggestive and descriptive marks. One commentator has noted that "Line drawing between the descriptive and the suggestive categories is a very subjective process. A mark that immediately describes the goods to one person may only subtly suggest something about the goods to another."43 McCarthy refers to the line between the two as "hazy," and writes that at the border, descriptive marks "almost imperceptibly shade over . . . into the suggestive domain."44

37. Kane, supra note 3, at § 2:1 (citing Abercrombie & Fitch Co, 537 F.2d at 9 n.6).
43. Kane, supra note 3, at § 2:2.2.
44. McCarthy, supra note 18, at § 11:66. The line drawing that courts undertake to separate suggestive marks from descriptive is beyond the scope of this article. For more on this issue see Robert G. Bone, Enforcement Costs and Trademark Puzzles, 90 VA. L. REV. 2099, 2132 (2004) (noting because plaintiffs only have to present secondary meaning evidence if their mark is found descriptive the distinction is economically significant in litigation); WillaJeanne F. McLean, The Birth, Death, and Renaissance of the Doctrine of Secondary Meaning in the Making, 42 AM. U. L. REV. 737, 746 n.53 (1993) (describing the various tests courts have employed to make the suggestive-descriptive distinction).
2. Descriptive Marks

Descriptive marks are those marks that describe "the intended . . . use of the goods[,] the size of the goods[,] the provider of the goods . . . [,] the nature of the goods . . . [,] the class of users of the goods . . . [,] a desirable characteristic of the goods . . . [,] or] the end effect upon the user." Generally these marks are not protectable. The Supreme Court explained:

Marks which are merely descriptive of a product are not inherently distinctive. When used to describe a product, they do not inherently identify a particular source, and hence cannot be protected. However, descriptive marks may acquire the distinctiveness which will allow them to be protected under the Act.

Examples of marks held to be descriptive of goods or services include: "ARTHRITICARE," for a gel to care for arthritis symptoms; "HOMEMAKERS," for housekeeping services; and "THE ULTIMATE BIKE RACK," for a bike rack.

Descriptive marks can acquire distinctiveness and achieve protection if they come to represent not simply a description of a given good or service, but a single source of that good or service. This transformation is known as "acquired distinctiveness" or "secondary meaning." Moreover, as long as consumers identify the mark with a single source, regardless of consumers' ability to identify the source, a descriptive mark can be found to have acquired secondary meaning. The Second Circuit aptly noted:

[The true inquiry is whether the primary function of a particular design is other than referential, leading to association in the public mind with no one or nothing.

45. McCARTHY, supra note 18, at § 11:16.
46. Two Pesos, 505 U.S. at 769. The acquired distinctiveness is also known as secondary meaning. See infra Part II.B.2.a.
48. Homemakers Home & Health Care Servs., Inc. v. Chicago Home for the Friendless, 484 F.2d 625, 629 (7th Cir. 1973) (could not demonstrate secondary meaning).
49. In re Nett Designs, 236 F.3d 1339, 1342 (Fed. Cir. 2001) (mark was descriptive in a laudatory manner).
50. Two Pesos, 505 U.S. at 769.
51. Id. at 769. The term "secondary" refers to this meaning remaining junior to the word's "primary" descriptive significance. See KANE, supra note 3, at § 2:1.2(A) (defining "primary meaning [as] the ordinary English language meaning conveyed by the term.").
52. KANE, supra note 3, at § 2:1.2(A) ("It is not necessary that purchasers know the name of the manufacturer to establish secondary meaning.").
or, by virtue of its distinctiveness, it is designed to create an association with a single source.  

Whether a mark has reached the threshold of secondary meaning is a question of fact "to be determined from relevant evidence probative of probable customer reaction." This evidence can be demonstrated by a variety of methods. Such methods include consumer survey, the extent and reach of advertising, and the quantity of sales of the particular good or service. For example, a local newspaper demonstrated the mark "THE FREDERICK GAZETTE," though descriptive, had acquired secondary meaning. The paper was thus able to prevent a competitor (also a Frederick, Maryland based newspaper) from adopting the mark. Central to the court's holding was the fact that both consumers and advertisers had "come to associate 'GAZETTE' with the plaintiff's papers."

Not surprisingly, the level of descriptiveness of a term will dictate what level of proof of secondary meaning courts require. McCarthy calls attention to this rule: "Some terms are only slightly descriptive and need only a minimum quantum of evidence of secondary meaning. Other terms are highly descriptive and may need a massive quantity and quality of secondary meaning to become a trademark." An applicant can demonstrate that a descriptive mark has acquired secondary meaning at the time of registration on the Principal Register either through showing "appropriate evidence tending to show that the mark distinguishes such goods[,,]" or by demonstrating a "substantially exclusive and continuous use in commerce... for the five years before the date on which the claim of distinctiveness [was] made."

C. Process of Registering a Mark

As mentioned previously, mark holders do not need to register a mark in order to receive common law protection of their mark "because it is use, not registration, that creates the underlying exclusive right to a mark." Nonetheless, there are a great many benefits to registering a mark on the Principal Register. Some of these benefits

54. MCCARTHY, supra note 18, at § 11:25.
57. Id. at 694.
58. MCCARTHY, supra note 18, at § 11:25.
60. The registration process discussed in this section and throughout this article is based on federal registration of a mark. While each state allows registration, unless the user only wants intrastate protection, federal registration is the more common and worthwhile protection. See KANE, supra note 3, at § 6:1.2.
61. MCCARTHY, supra note 18, at § 19:3; see also supra note 16 and accompanying text.
include: prima facie evidence of the validity of the registered mark and the exclusive right to use the mark in commerce in connection with the named goods or services; nationwide constructive notice of the date of first "use" of the mark, constructive notice of an ownership stake in the mark, incontestability five years after registration along with proof of continuous use, the ability to bring an infringement action in federal court regardless of diversity or amount in controversy requirements; statutory remedies otherwise unavailable including treble damages and the ability to prevent importation of products bearing an infringing mark into the United States; and under international agreements, priority of a right to register the mark in foreign countries based on the registration in the United States.

With all the benefits available to marks registered on the Principal Register, it is not surprising that thousands of trademark applications are filed every year. However, not all marks can be registered on the Principal Register. To begin with, registrants must either demonstrate a "bona fide intention to use" the mark in question, or show the mark has been used for goods transported or services rendered in commerce. Moreover, before a mark can be registered, it must be able, at a minimum, to distinguish the goods or services of the applicant from all others. The need to distinguish the goods or services the mark represents prevents descriptive marks from immediate registration on the Principal Register, and necessitates the need to initially register these marks on the Supplemental Register.

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72. 15 U.S.C. § 1052(e) (2005). See generally KANE, supra note 3, at § 6:3 (discussing the requirements of federal registration of a mark and what types of marks may not be registered, including those that are generic, immoral, scandalous, functional, deceptively misdescriptive or a surname lacking in secondary meaning).
73. See infra Part II.E.
While there are a number of procedural grounds for rejection of an application to the Principal Register, one of the most common statutory grounds is a finding by the Trademark Examiner that the mark is descriptive but lacks secondary meaning. Because the level of protection for marks is significantly greater on the Principal Register than the Supplemental Register, applicants are often advised to attempt to have their mark registered as quickly as possible on the Principal Register. This is particularly prudent advice for the holders of descriptive marks because the protection of incontestability prevents a challenge on the grounds that the mark is descriptive and should not be protectable. If there is no opposition to a registration, only a Trademark Examiner stands between the registrant and the registration of a descriptive mark on the Principal Register. A single Trademark Examiner examines the mark along a continuum and determines whether the mark is “merely descriptive” or has “acquired distinctiveness.”

If an applicant has already used the mark he wishes to register in commerce, the procedure for registering the mark on either Register is the same: one must show the mark has been used, it does not conflict with any other mark, and if it is to be on the Principal Register, one must publish the mark for opposition. A mark that is capable of becoming a mark but was initially rejected for registration on the Principal Register may apply immediately for registration on the Supplemental Register.

On the other hand, if the applicant has not yet used the mark, but has a bona fide intention to use the mark, she may attempt to register the mark on the Principal Register via an “intent-to-use” (“ITU”) application. One may not, however, use an ITU application to register a mark on the Supplemental Register, and accordingly, if there is no opposition to a registration, only a Trademark Examiner stands between the registrant and the registration of a descriptive mark on the Principal Register. A single Trademark Examiner examines the mark along a continuum and determines whether the mark is “merely descriptive” or has “acquired distinctiveness.”

74. Kane, supra note 3, at § 6:5.2.
75. Id. at § 6:5.3(B).
76. See MCCARTHY, supra note 18, at § 19:11 (“Registration on the Principal Register should be attempted if it is at all possible . . . . [A]pplicant’s attorney should not concede any more weaknesses in the mark than is absolutely necessary. The object is to get the mark on the Principal Register as soon as possible, one way or another.”).
78. 15 U.S.C. §§ 1062, 1063 (2005). Section 1062 requires publication in the “Official Gazette,” while section 1063 allows any person that believes they would be “damaged” by the registration to oppose the registration.
79. TMEP at § 1209.01; see Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc., 469 U.S. 189, 212 (1985) (Stevens, J., dissenting) (“No matter how dedicated and how competent administrators may be, the possibility of error is always present, especially in adversary proceedings.”) Justice Stevens cites Congressional testimony admitting that as of 1983 up to seven percent of documents filed with the PTO had gone missing. Id. at 212 n.12.
80. KANE, supra note 3, at § 6:3:2.
one may not register a descriptive mark with an ITU application. Yet under § 1051(c), an applicant may amend an ITU application at any time based on the use of the mark in commerce.

In practice, ITU applications allow applicants up to thirty-six months to actually use their mark in commerce. This time is designed to encourage the investing in and building of goodwill in a new mark while insuring firms that they will not have their mark stolen out from under them just before bringing it to market. It has been suggested though, that the three-and-a-half years available by statute can lead to the warehousing of a mark in order to keep it away from competitors.

There is, however, a significant exception to the rule that marks must have been used in commerce prior to filing an ITU application. Normally, if a mark has not been used in commerce, it cannot demonstrate secondary meaning and does not qualify for an ITU application; but, an applicant that has used a mark on one set of goods may file an ITU application on the Principal Register for that same mark to be used on a different set of goods, without ever having used the mark in commerce on the goods in question. The benefit of such an exception only accrues to those with more than one mark on multiple products in use at the time the ITU application is filed.

D. Incontestability

Any mark registered on the Principal Register and used continuously for five years, that is not generic, becomes “incontestable.” Reaching incontestable status means that no competitor may defend a charge of infringement by claiming the

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84. Id.
86. 15 U.S.C. § 1051(d). Applicants have six months to demonstrate use, however an applicant may be granted up to six extensions of six months each upon a showing of cause as to the need for an extension.
87. PHILLIP H. SMITH, INTENT-TO-USE TRADEMARK PRACTICE 2-3 (1992) (describing how ITU applications prevent the need for token use and allow businesses to be more confident in their mark development).
88. See Carter, supra note 3, at 799 (noting the ITU system could “in the proper circumstances, be prima-facie evidence of what might be called an intent-to-warehouse”).
89. TMEP § 1212.09 (1997).
90. Id. at § 1212.09(a) (An ITU application may be filed for the mark if the applicant “can establish that, as a result of the applicant’s use of the mark on other goods . . . the mark has become distinctive of those other goods . . . and . . . this previously created distinctiveness will transfer to the goods . . . specified in the application when the mark is used on . . . them.”) (emphasis added).
91. 15 U.S.C. § 1065 (2005). Applicants must also file an affidavit stating the mark has been in continuous use. The mark cannot have become generic in the interim. Id. Further application for incontestability must occur between the fifth and sixth years of continuous use. Incontestability is not available after the sixth year. Id.
registered mark is descriptive and thereby lacks secondary meaning.\textsuperscript{92} As Professor McCarthy has explained, by achieving incontestability "it is conclusively presumed either that the mark is non-descriptive, or if descriptive it has acquired secondary meaning."\textsuperscript{93} Understandably, incontestable status is a significant protection for descriptive mark holders.\textsuperscript{94}

The seminal incontestability decision is the 1985 \textit{Park 'N Fly} decision.\textsuperscript{95} The Supreme Court held that because the mark "PARK 'N FLY" for "long-term parking lots near airports" had achieved incontestable status, the respondent, who operated similar lots under the mark "DOLLAR PARK AND FLY," could not challenge the appellant's mark based on its descriptiveness.\textsuperscript{96} The Court interpreted the statute literally, finding that once a mark achieved the requirements for incontestability, there was no language allowing "an incontestable mark [to] be challenged as merely descriptive."\textsuperscript{97} Moreover, the Court explained that an opposing party may always challenge a mark before it achieves incontestable status and therefore § 1115(b) serves as "conclusive evidence of the registrant's exclusive right to use the mark."\textsuperscript{98} One commentator has noted that the "incontestability doctrine entitles the mark's owner to a conclusive presumption in favor of the mark's validity and of the mark holder's right to exclusive use of the mark."\textsuperscript{99}

The Circuit Courts of Appeals are split as to whether achieving incontestability means a mark will be considered "strong" when examined under a likelihood of confusion test.\textsuperscript{100} One district court explained that "[A]lthough an incontestable mark is not subject to invalidity based solely on its descriptiveness, the mark may be found

\begin{itemize}
\item \textsuperscript{92} Park 'N Fly, Inc. v. Dollar Park & Fly, Inc., 469 U.S. 189, 196 (1985). The mark holder cannot be challenged on ownership grounds or on the grounds that another user had the mark first. 15 U.S.C. § 1115(b) (2005).
\item \textsuperscript{93} MCCARTHY, supra note 18, at § 11:44 (citing 15 U.S.C. § 1115(b)).
\item \textsuperscript{94} Incontestability does not mean invulnerable to attack. Section 1115(b) lists nine separate "defenses or defects" that can defeat incontestability, including registration obtained by fraud, abandonment of the mark, functionality of the mark, and equitable principles including laches and estoppel. 15 U.S.C. § 1115(b). A fair use of the mark is also acceptable. See Wonder Labs, Inc. v. Procter & Gamble Co., 728 F. Supp. 1058, 1062 (S.D.N.Y 1990) ("The fair use defense is available even when the plaintiff's mark has become incontestable.").
\item \textsuperscript{95} Park 'N Fly v. Dollar Park and Fly, Inc., 469 U.S. 189 (1985).
\item \textsuperscript{96} Id. at 191-92.
\item \textsuperscript{97} Id. at 196.
\item \textsuperscript{98} Id. A significant difference in process between the Registers is that marks on the Supplemental Register are not published for opposition. 15 U.S.C. § 1092 (2005). Thus, the ability to cancel a mark is constrained to those who are aware the mark exists. Yet, unlike marks on the Principal Register, marks that have been registered on the Supplemental Register can be cancelled even after they are registered. Id.
\item \textsuperscript{100} See MCCARTHY, supra note 18, at § 11:44. See also Part II.G.
\end{itemize}
weak to the point of enabling the owner only to assert rights to the use of the exact mark." 101 Yet the Second Circuit has held that a mark's incontestability should be seen as a factor contributing to its strength. 102 At the same time, the Ninth Circuit has held the opposite—finding that despite incontestability, "MISS WORLD" was a weak mark warranting no action for injunction against "MRS. OF THE WORLD." 103

E. The Supplemental Register

Historically, one could not protect a descriptive trademark at all. As the Supreme Court explained in 1920:

The function of a trade-mark is to point distinctively, either by its own meaning or by association, to the origin or ownership of the wares to which it is applied, and words merely descriptive of qualities, ingredients or characteristics, when used alone, do not do this. Other like goods, equal to them in all respects, may be manufactured . . . by others, who, with equal truth, may use, and must be left free to use, the same language of description in placing their goods before the public. 104

Today, however, any descriptive mark that is used in commerce, and can eventually attain secondary meaning, may be immediately registered on the Supplemental Register. 105

While the Supplemental Register does not provide the same level of protection as the Principal Register, it does allow a certain measure of protection for the registrant, including the use of the ® symbol. 106 When a mark holder on the Principal Register uses this symbol, it gives notice that there may be damages due if

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103. Miss World (UK), Ltd. v. Mrs. America Pageants, Inc., 856 F.2d 1445, 1449 (9th Cir. 1988) (explaining "an incontestable status does not alone establish a strong mark").


106. See 15 U.S.C. § 1094 (2005). The ® symbol is only the most common method of registrants notifying the public that their mark has been registered. Mark holders may also "display the mark with the words: 'Registered in U.S. Patent and Trademark Office' or 'Reg. U.S. Pat. & Tm. Off.'" 15 U.S.C. § 1111 (2005).

Registration on the Supplemental Register also allows for all actions to be brought in federal court, places the mark on the Register for all to find, and allows for the use of the registration to be used by an Examiner ex parte against any marks in the future that are confusingly similar. McCarthy, supra note 18, at § 19:37(1)–(3).
another user attempts to infringe the mark; however, when a registrant on the Supplemental Register uses the ® symbol, its use can act as a powerful deterrent against any attempted registration or use of her term. This can be a potent tool of dissuasion to other potential users of marks which were found to be descriptive and lacking secondary meaning and thereby not placed on the Principal Register. Professor McCarthy has commented: "The mere presence of the mark on the Supplemental Register may deter others from using confusingly similar marks." 

Another advantage granted to registrants on the Supplemental Register is that, despite the mark being descriptive, the registration itself will act as a bar against another mark that would be likely to cause confusion. This odd result was the holding of Clorox, a case where the mark "ERASER" for a laundry soil and stain remover was denied registration on the Principal Register because the mark "STAIN ERASER" on a stain remover already existed on the Supplemental Register. Professor McCarthy has explained that the Clorox holding resulted "in the phenomenon of a Supplemental Registration of a 'non-mark' being used to prevent Principal Registration of a 'real mark' to another party." 

F. Trademark's Fair Use Doctrine

Despite, or perhaps because of, the high level of protection afforded to marks via the use of a trademark, it is important to recognize that both courts and statutes have created a vibrant fair use doctrine. The doctrine is specifically designed to allow a mark to be used in its non-trademark descriptive function. Accordingly, as long as

108. KANE, supra note 3, at § 6:1.1.
109. MCCARTHY, supra note 18, at § 19:37.
110. KANE, supra note 3, at § 19:4.6(B).
111. It should be noted registration on the Supplemental Register is not "an admission that the mark has not acquired distinctiveness." 15 U.S.C. § 1095. Yet, it is unlikely that a descriptive mark with acquired distinctiveness would register on the Supplemental Register.
112. MCCARTHY, supra note 18, at § 19:37 ("[This] result is somewhat bizarre.").
114. McCarthy refers to terms on the Supplemental Register as "non-marks" because they are only terms capable of becoming marks. MCCARTHY, supra note 18, at § 19:37. Yet, as the Lanham Act refers to terms on the Supplemental Register as "marks," so will this author.
117. There is another type of "fair use" generally known as "nominative fair use." This is when a competitor's mark is used in an advertisement to identify the competitor's goods. This use is fair as long as no likelihood of confusion develops. See MCCARTHY, supra note 18, at § 23:11.
the use is "other[] than . . . a mark," it serves as an allowed use, no matter how famous the mark. Put another way, trademark allows the fair use of a mark to be invoked as an affirmative defense because there is a "public interest in allowing competitors to make free use of the English language to describe their goods." Professor McCarthy notes that "The original, descriptive primary meaning [of a term] is always available for use by others to describe their goods, in the interest of free competition." The Supreme Court has long held that "to truthfully describe [one's] own product does not constitute a legal or moral wrong," even if some slight confusion ensues. The Court recently explained that the Lanham Act does not attempt to prevent all confusion on the part of consumers. It stated that there is "no indication that the statute was meant to deprive commercial speakers of the ordinary utility of descriptive words." Nevertheless, trademark law exists to prevent consumer confusion; thus a "junior user's use should be deemed 'fair' only if it is non-confusing." To illustrate this distinction, one need look no further than a manufacturer of cotton-swabs enjoined from calling its product "cotton-tips." The Third Circuit granted the injunction because it deemed the name confusingly similar to the registered mark "Q-Tips," and because the junior user changed its mark after the success of the senior user's mark. The court did not see such use as "fair."

G. Likelihood of Confusion

The Trademark Act states that all registered mark holders may defend their marks against another's use if that use is in commerce and "is likely to cause confusion, or to cause mistake, or to deceive." The Act does not, however,
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specifically define "confusion," thus giving rise to a series of judicial tests to determine if one mark is similar enough to another to create the necessary level of confusion to allow legal relief.\footnote{129} To begin with, courts generally agree that "likelihood" means probable confusion.\footnote{130} Still, a somewhat subjective factual inquiry is needed for courts to determine the level of confusion engendered by one mark to another. To accomplish this, courts employ the classic \textit{Polaroid} factors originally laid out by the Second Circuit in 1961.\footnote{131} The \textit{Polaroid} factors are designed to be nonexclusive, and no one factor carries any more weight than another.\footnote{132} Professor McCarthy has summarized the eight factors as:

1. The degree of resemblance between the conflicting designations;
2. The similarity of the marketing methods and channels of distribution;
3. The characteristics of the prospective purchasers and the degree of care they exercise;
4. The degree of distinctiveness of the senior user's mark;
5. Where the goods or services are not competitive, the likelihood that prospective buyers would expect the senior user to expand into the field of the junior user;
6. Where the goods or services are sold in different territories, the extent to which the senior user's designation is known in the junior user's territory;
7. The intent of the junior user; and
8. Evidence of actual confusion.\footnote{133}

The Supreme Court recently held that, according to statute, the burden of demonstrating a likelihood of consumer confusion falls to the plaintiff asserting an alleged infringement of an incontestable mark.\footnote{134} Furthermore, under \S 115(b)(4), the defendant "has no independent burden to negate the likelihood of any confusion in raising the affirmative defense that a term is used descriptively, not as mark, fairly, right to use the registered mark in commerce," a mark holder's claim of confusion is still subject to "proof of infringement as defined in section 1114." 15 U.S.C. \S 1115(b).\footnote{129} See \textit{McCarthy, supra} note 18, at \S 23:19.\footnote{139} Estee Lauder Inc. v. The Gap, Inc., 108 F.3d 1503, 1510 (2d Cir. 1997); Rodeo Collection, Ltd. v. W. Seventh, 812 F.2d 1215, 1217 (9th Cir. 1987).\footnote{130} Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492, 495 (2d Cir. 1961). It is worth noting that each circuit has adopted its own slight variation of the list. \textit{McCarthy, supra} note 18, at \S 23:19.\footnote{131} See \textit{Kane, supra} note 3, at \S 8:1.3 (quoting Homeowners Group, Inc. v. Home Mktg. Specialists, Inc., 931 F.2d 1100, 1107 (6th Cir. 1991) ("Not every factor may be helpful to the court in every case. 'The ultimate question remains whether relevant consumers are likely to believe that the products or services offered by the parties are affiliated in some way.'")).\footnote{132} McCARTHY, \textit{supra} note 18, at \S 23:19.\footnote{133} KP Permanent Make-Up, Inc. v Lasting Impression I, Inc., 125 S. Ct 542 (U.S. 2004).\footnote{134}
and in good faith." Accordingly, despite a descriptive mark achieving incontestable status, the successful defense of a mark will always be an uphill battle. The mark holder will need to demonstrate not only a probable likelihood of confusion, but also that such use was either not a fair use, or that the use was undertaken in bad faith.

H. How a Descriptive Mark Can Attain Incontestability

The registrant of a descriptive mark who wishes to achieve incontestability must eventually register her mark on the Principal Register. Yet this cannot be accomplished until secondary meaning has been demonstrated. Accordingly, once the mark holder uses her mark in commerce, she may apply for registration on the Supplemental Register. By acquiring registration on the Supplemental Register, the mark holder may use the ® symbol on the mark to build up goodwill in her mark and deter others from using her mark.

A few years later, after she has acquired distinctiveness in her mark, she may then apply for registration of her previously descriptive mark on the Principal Register—possibly without ever being challenged by another user as to her use either because no other mark holder wanted to make such a challenge or even knew that she was using the mark. While her registration on the Principal Register will result in publication of the mark, by then she will have had a significant period of time to establish rights in the mark. Even if an opposition were to be brought, a district court could hold the mark’s previous registration on the Supplemental Register as indicative of the mark’s strength in a likelihood of confusion analysis. Thus, five years after receiving registration on the Principal Register, if she has used the mark continuously and makes out an affidavit swearing to such continuous use, the mark will become incontestable, despite perhaps having only been contested by a single Trademark Examiner.

135. Id. at 551.
136. See supra Part II.D.
137. Id.
138. See supra Part II.E.
139. Id.
140. See supra note 109 and accompanying text (discussing the deterrence factor of registering marks on the Supplemental Register).
141. See supra note 98 (discussing lack of publication of mark on Supplemental Register).
142. See supra note 109 and accompanying text (discussing Second Circuit’s holding that registration on the Supplemental Register indicates strength).
III. CURRENT PROTECTIONS ARE DETRIMENTAL TO THE PUBLIC DOMAIN AND LINGUISTIC COMMONS

"Language, even in a commercial context, properly belongs to the public."143

One argument for a lesser level of protection for trademarks, as opposed to copyright or patent, is that by allowing a particular individual or company to “own” a word or phrase for the purpose of commercial exploitation, we remove that word or phrase from the common lexicon.144 As the Fifth Circuit explained:

[Trademark] differs substantially from a copyright, in both its legal genesis and its scope of federal protection. The legal cornerstone for the protection of copyrights is Article I, section 8, clause 8 of the Constitution. In the case of a copyright, an individual creates a unique design and, because the Constitutional fathers saw fit to encourage creativity, he can secure a copyright for his creation . . . After the expiration of the copyright, his creation becomes part of the public domain. In the case of a trademark, however, the process is reversed. An individual selects a word or design that might otherwise be in the public domain to represent his business or product. If that word or design comes to symbolize his product or business in the public mind, the individual acquires a property right in the mark. The acquisition of such a right through use represents the passage of a word or design out of the public domain into the protective ambits of trademark law.145

There is, admittedly, a certain level of hyperbole in the contention that the registration of a mark literally removes a phrase from the English language in the same way that copyrighting removes the expression of an idea, or patent removes an invention from the public domain.146 Despite the registration of a mark, it may always be used in its ordinary and non-mark sense, particularly in the case of a descriptive mark.147 As the Seventh Circuit has explained, the mark holder “cannot appropriate [a] phrase to herself and thereby prevent others from using the phrase in a

143. Park 'N Fly, Inc., 469 U.S. at 215 (Stevens, J., dissenting).
144. See Carter, supra note 3, at 769 (noting that “[t]rademark protection matters because it allows a firm to remove a word from the market language, in the sense that it allows the firm to prevent others from using the word or anything confusingly similar to it”); see also Mark A. Lemley, The Modern Lanham Act and the Death of Common Sense, 108 YALE L.J. 1687, 1696 (1999) (“Our language and our culture are impoverished when we cannot use the most familiar words to discuss – or make fun of, or criticize – the products and companies that are the basis of our economy.”).
145. Boston Prof. Hockey Ass'n v. Dallas Cap & Emblem Mfg., 510 F.2d 1004, 1014 (5th Cir. 1975).
146. The law of copyright and patent grants authors a variable level of monopoly for a limited period of time. U.S. Const., Art. I, § 8, cl. 8. See also McCarthy, supra note 18, at § 6:3 (comparing patent, copyright, and trademark).
147. See supra note 116 (discussing the fair use doctrine).
Furthermore, "A junior user is always entitled to use a descriptive term in good faith in its primary descriptive sense." On the other hand, a certain danger exists when representative terms are assigned to individuals for commercial purposes. The types of words and phrases that this article is focused on have a harder time achieving secondary meaning than arbitrary or suggestive terms. As a result, applicants desire the protection of incontestability, regardless of whether they have established distinctiveness. Yet by allowing these marks protection and removing them from the public domain, even if only for commercial use, trademark policy weakens the language at large and the balance of competition, by placing smaller business owners at a distinct disadvantage.

The Supreme Court of North Carolina has held:

[D]escriptive words and phrases... may not be appropriated by any business enterprise either as a tradename or as a trademark. Such words are the common property and heritage of all who speak the English Language; they are publici juris. Put another way, "it has been argued that descriptive marks are placed in the public domain to keep them freely available for use by all producers of the goods that they describe." If true, it follows that there must be some justification for the removal of descriptive terms from the linguistic commons. In exchange for the words, source identifiers are created and consumer search costs are reduced.

When the law allows a firm to appropriate a mark, the size of the set of words available to the next firm is reduced. But if the consuming public is... able to

148. Packman v. Chicago Tribune Co., 267 F.3d 628, 639-41 (7th Cir. 2001) (holding the defendant newspaper made a “fair use” of the plaintiffs’ descriptive mark “THE JOY OF SIX” in reporting on the Chicago Bulls’ sixth NBA championship, and reproducing the front page of the newspaper, using the mark, on t-shirts).
149. McCARTHY, supra note 18, at § 11:45.
150. See discussion infra sections III and IV.
153. See Jeremy Waldron, From Authors to Copiers: Individual Rights and Social Values in Intellectual Property, 68 CHI-KENT L. REV. 841, 887 (1993) (“[A]n institution like intellectual property is not self-justifying; we owe a justification to anyone who finds that he can move less freely than he would in the absence of the institution.”).
use the mark as an information-economizing device, the benefits of the removal almost certainly will outweigh the costs.\textsuperscript{155}

Conversely, some have argued that secondary meaning can only be imparted into descriptive terms by the public. Professor Steven Wilf has written that all trademarks are essentially authored by the public.\textsuperscript{156} With regard to descriptive trademarks, Professor Wilf's theory dovetails with his description of the Lockean perspective on these marks, noting that "[I]f language is a symbolic representation of an idea, then descriptive trademarks do not take language but draw upon it for marketing."\textsuperscript{157}

Even if the public creates secondary meaning in marks, under trademark law only one mark holder is allowed to establish a connection between a particular descriptive term and a specific product in the public consciousness. The struggle to be the first to obtain the "right" word, particularly if it is a descriptive one, goes beyond ease of identification. Influential commentators William Landes and Richard Posner suggest it is a question of economics: "[I]f one firm is given exclusive rights to words that define or describe a product, this will reduce the productivity of the trademarks of other firms that make the same product and thus will increase the search costs of those firms' consumers."\textsuperscript{158}

Essentially, the motivation for the mark holder and the danger to the public at large work hand in hand. When competitors are locked out of using the best term for their product they must choose a less effective mark, which will make competition more difficult, benefiting the mark holder to the detriment of the competition. Furthermore, as all but one competitor will have to use non-descriptive marks for their products, consumers will have to associate a greater variety of arbitrary and suggestive marks with the product in question, making it harder to find the products they seek.

This risk to both the free market and the linguistic commons has produced serious concern among scholars. One observed that "we live . . . in a cultural environment whose elements . . . are in danger of being appropriated—'gobbled up' by the corporations of the entertainment industry, like 'a game of conceptual Pac Man.'"\textsuperscript{159} Maya Alexandri sees the dilemma even more starkly, positing that the

\textsuperscript{155} Id. at 763; see also Robert C. Denicola, Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols 1982 WIS. L. REV. 158, 195-96 (1982) ("Famous trademarks offer a particularly powerful means of conjuring up the image of their owners, and thus become an important, perhaps at times indispensable, part of the public vocabulary.").

\textsuperscript{156} Wilf, supra note 13, at 36 ("Descriptive marks borrow heavily from the linguistic commons and require public recognition through secondary meaning before warranting commercial protection.").

\textsuperscript{157} Id. at 34.


\textsuperscript{159} Waldron, supra note 152, at 885 (quoting David Lange, Recognizing the Public
exchange of words for identifiers is inherently unbalanced, and that the public is being hurt instead of benefited: "A monopoly in a descriptive term is a depletion of the public domain; and . . . the ramifications of depleting the public domain are concrete and immediate: such exclusive use eradicates the very boon trademarks have always offered—the exclusive use raises consumer search costs." Alexandri argues that the scales have been tipped away from the public.

The Justice Department’s public stance on the Lanham Act when it was first presented to Congress reveals the fear that marks will be overprotected. The Department "asserted that trademarks are monopolistic; that statutory recognition and protection of trademarks favor big business . . . and that Congress should not establish a register of trademarks that are no more than psychological sensations and social reactions to symbols." That the Justice Department could not predict the American public would so thoroughly take to trademarks in their modern form is not relevant here. Yet the Justice Department was prescient, at least regarding descriptive marks, when it argued that the bargain being struck was not a fair one for the public. Sixty years later, when one analyzes the effect of allowing the protection of descriptive marks, particularly before they have demonstrated acquired distinctiveness, it appears that the public receives less source identification and information-economization than it bargained for.

IV. CURRENT PROTECTIONS ARE ANTI-COMPETITIVE AND DETRIMENTAL TO SMALL MARK HOLDERS

A. Why Would Anyone Want a Descriptive Trademark?

The previous section explained the reasons that descriptive marks may damage the public domain and linguistic commons. As for business owners, one treatise notes that competitors of descriptive mark holders "may [use descriptive marks] freely in their primary sense, if not deceptive or untruthful, in advertising or other forms of communication." Despite being able to register one’s descriptive mark, there is no way to prevent the use of the mark by others in the free market, even after achieving secondary meaning. Accordingly, why would any prospective mark holder, desirous of distinguishing her goods or services in the marketplace, choose a mark that may be freely used in certain circumstances by her competitors?

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Domain, 44 LAW & CONTEMP. PROBS. 147, 156 (1981).
160. Alexandri, supra note 99, at 329; see also Lemley, supra note 144, at 1696 ("[P]ropertizing trademarks comes at a rather significant cost to society. Sometimes that cost takes the form of lost opportunities: Important political and social commentary and works of art may be suppressed entirely.").
161. MCCARTHY, supra note 18, at § 5:4.
162. JEROME GILSON, TRADEMARK PROTECTION AND PRACTICE § 2.03(1) (2004).
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The answer is surprisingly simple. Descriptive marks, despite their pitfalls, describe the goods in question and function as free advertising. One does not have to explain that the mark ENTREPRENEUR\textsuperscript{163} is a magazine for and about entrepreneurs, in the manner one must explain KODAK is a mark for film. It has been noted that “Sellers tend to borrow words and images that already have some meaning to the purchasing public.”\textsuperscript{164} Landes and Posner explain the advantages this way: “[S]uch a mark conveys additional information to the consumer—to wit, information about the attributes as well as just the source of the good—and is thus a partial substitute for advertising.”\textsuperscript{165}

Additionally, because a descriptive mark can convey information immediately and inexpensively, “simply by exploiting its natural meaning,” the descriptive mark holder need not be concerned early on about creating source identification through the mark.\textsuperscript{166} This added bonus of description supplied by the mark allows for the building of secondary meaning in the mark while using the mark in commerce. At the same time, the current registration system allows the first registrant to, essentially, scare off the competition until the secondary meaning necessary to place the mark on the Principal Register has accrued.\textsuperscript{167} Perhaps the Ninth Circuit provided the best reason for choosing a descriptive mark, explaining that these marks “define qualities or characteristics of a product in a straightforward way that requires no exercise of the imagination to be understood. Thus, ‘Honey Baked Ham’ is a descriptive term for a ham that has been baked with honey.”\textsuperscript{168}

\begin{itemize}
\item\textsuperscript{163} See Entrepreneur Media, Inc. v. Smith, 279 F.3d 1135, 1141-42 (9th Cir. 2002).
\item\textsuperscript{164} John T. Cross, Language and the Law: The Special Role of Trademarks, Trade Names, and Other Trade Emblems, 76 Neb. L. Rev. 95, 106 (1997) (explaining further that the “tendency to borrow existing words is not due to a lack of creativity. . . . These emblems provide information about the good or service under consideration. When the marks relay such information, these signals operate as a form of advertising.”).
\item\textsuperscript{165} Landes & Posner, supra note 158, at 294 (citations omitted); see also DAVID A. BURGE, PATENT AND TRADEMARK TACTICS AND PRACTICE § 14-4, at 126 (2d ed. 1984) (“Suggestive and descriptive marks tend to be preferred by advertising people because these marks are thought to enhance initial product salability.”).
\item\textsuperscript{166} See Alexandri, supra note 99, at 328 (quoting Naresh, supra note 152, at 962, who further notes that a descriptive mark’s “capacity to convey information indirectly . . . cannot be realized until after the seller invests time and resources in achieving buyer recognition.”). See also Naresh, supra note 152, at 961 (“The greater a mark’s natural descriptiveness, the less likely it is that buyers will be able to associate it with only a small range of products coming from a single source.”).
\item\textsuperscript{167} See 15 U.S.C. §§ 1094, 1111 (2005); see also supra note 106 and accompanying text.
\item\textsuperscript{168} Kendall-Jackson Winery v. E. & J. Gallo Winery, 150 F.3d 1042, 1047 n.8 (9th Cir. 1998) (citations omitted).
\end{itemize}
B. Large Descriptive Mark Holders Gain a Competitive Advantage

The savings realized by adopting a mark that describes the good or service the mark holder sells are multiplied by the distinct commercial advantage gained over competitors. Professor Naresh writes: "If there are many sellers of a product, all of whom wish to use a certain descriptive mark, allowing one of them to monopolize that mark . . . create[s] an informational barrier between buyers and other sellers."169 The effects of this informational barrier on competition can be dramatic. "[I]f some sellers can spend less because they are conveying certain information for ‘free,’ then they have a competitive advantage that will be compounded (sometimes negatively or unfairly) by the exclusive use of the word."170 Although the seller that creates a product first, rushes it to market, and registers the mark earliest deserves some credit for that effort, it appears that the competitive advantage gained is disproportionate to the gain enjoyed by consumers.171 Landes and Posner observed:

[T]he grant of legal protection to [a non-distinctive] mark might prevent the other producers from continuing to use words that they require to compete effectively . . . . Since by definition [descriptive] words [are] common to all or most brands, and since they are descriptive rather than arbitrary, their availability is limited. Letting a producer appropriate a non-distinctive mark would enable him to obtain, in effect, exclusive rights to such words.172

Accordingly, the advantages of obtaining a descriptive mark go beyond simple product identification and can often be detrimental to competitors.

Creating a suggestive or arbitrary mark is clearly a costly and time consuming experience; and the desire to avoid such a process may play some role in sellers selecting a descriptive mark.173 Importantly, however, once a competitor has chosen the most descriptive mark for a good or service, it can become more burdensome for producers of similar goods or services to work around that descriptive mark in a way that insures non-infringement than to simply create a suggestive or fanciful mark.174 Not only does the descriptive mark holder gain a competitive advantage through the

169. Naresh, supra note 152, at 967.
172. Id. at 286-87. The authors, however, do not believe this to be the case. Id.
173. See Todd Pack, Delta's New Tune, Airline Gets Ready to Strike a Chord with Frugal Fliers, ORLANDO SENTINEL, Apr. 13, 2003, at H1 (describing the process of Delta Airlines choosing the arbitrary mark "Song" for its new low cost airline); Joff Wild, A Trademark Minefield Out There, FIN. TIMES, July 22, 2002, at 15 (noting the process to select a new mark can be "painstaking and costly" and if done incorrectly it can cost "millions").
174. Lemley, supra note 144, at 1696 n.40 (explaining that “[c]reating circumlocutions to avoid trademarks is costly”) (citing Ralph Folsom & Larry L. Teply, Trademarked Generic Words, 89 YALE L.J. 1323, 1340-42 (1980)).
use of the mark, the mark holders’ competitors are almost automatically disadvantaged.\textsuperscript{175} Furthermore, as one commentator has noted, some courts will grant significant leeway to the interests of those who have registered a mark, no matter how it is being used:

Deference to big business interests led one court to hold that ‘there is no excuse for even approaching the well-known trademark of a competitor . . . all doubt as to . . . confusion, mistake, or deception is likely to be resolved against the newcomer, especially where the established mark is . . . famous.’\textsuperscript{176}

C. Descriptive Marks’ Harm to Consumers

Another side effect of the registration of descriptive marks is the possibility of damage to consumers. “Scholars . . . have long argued that monopolies in descriptive marks can lead to increased start-up or marketing costs, endow one firm with an unfair competitive advantage, and, in extreme cases, enable a firm to engage in predatory pricing.”\textsuperscript{177} The risk of predatory pricing or other less obvious dangers to consumer options should not be underestimated. Actions detrimental to competition will often result in a negative impact not only on small business but on the individual consumer.\textsuperscript{178}

Professor Naresh describes the result: “[M]onopolization of descriptive marks by particular sellers would seriously disadvantage their competitors by creating formidable informational barriers between the competitors and their potential customers.”\textsuperscript{179} Furthermore, she argues that the incontestability that accrues to descriptive marks only “increases the incentives for sellers to choose descriptive marks for their goods, and to get their chosen marks registered.”\textsuperscript{180} After all, if a mark achieves incontestability, the seller can prevent its competitors from using the term, and she stands essentially immune to challenges from competitors—a circumstance that can directly affect consumers. The result is “[B]uyers experience greater difficulty and incur higher costs in obtaining the information necessary to make optimal purchasing decisions among similar products.”\textsuperscript{181}

\textsuperscript{175} See generally Alexandri, supra note 99, at 327-28.


\textsuperscript{177} Alexandri, supra note 99, at 327-28.

\textsuperscript{178} Folsom and Temply, supra note 174, at 1340-42.

\textsuperscript{179} Naresh, supra note 152, at 982.

\textsuperscript{180} Id. at 992.

\textsuperscript{181} Id. This scenario of course is not one contemplating a fair non-trademark use of the mark. See supra Part II.F.
One practitioner argues that even if descriptive marks can achieve secondary meaning, the original explanatory purpose of the word or phrase does not disappear, and the use of the mark can produce conflicting or at the very least confusing messages to consumers: “[P]rotecting exclusive rights in descriptive marks does not directly and materially further trademark law’s goal of helping consumers identify and distinguish among the products of competing manufacturers.”  

Landes and Posner propose another possible insidious effect of the assignment of descriptive marks to individual producers:

We have assumed that a trademark induces its owner to invest in maintaining uniform product quality; but another interpretation is that it induces the owner to spend money on creating, through advertising and promotion, a spurious image of high quality that enables monopoly rents to be obtained by deflecting consumers from lower-price substitutes of equal or even higher quality. In the case of products that are produced according to an identical formula, such as aspirin or household liquid bleach, the ability of name-brand goods . . . to command higher prices than generic (nonbranded) goods has seemed to some economists and lawyers an example of the power of brand advertising to bamboozle the public and thereby promote monopoly, and brand advertising presupposes trademarks—they are what enable a producer to readily identify his brand to the consumer. Besides the possibility of creating monopoly rents, trademarks may transform rents into costs as one firm’s expenditure on promoting its mark cancels out that of another firm. Although no monopoly profits are created, consumers may pay higher prices, and resources may be wasted in a sterile competition.

As previously discussed, registering a descriptive mark on the Supplemental Register grants the ability to use the ® symbol, deters competitors, and creates goodwill in a descriptive mark. Accordingly, not only does the current process allow for a considerable period of time to build secondary meaning in a descriptive mark.
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mark (and most likely prevent competitors from doing so), the scheme can also have
the dramatic side effect of being detrimental to consumer choice instead of benefiting
the population at large.

D. Why Are Descriptive Mark Holders Ignoring Good Legal Advice?

The decision by firms to use descriptive marks, though popular, appears to
contrast with the consistent advice against doing so by their legal counsel. Stephen
Carter notes that: "The unhappy truth is that firms try consistently (often against their
attorneys' advice) to find marks that, while perhaps not generic are a long way from
being fanciful."\(^{185}\) Professor Carter attributes this trend to "people who market
products for a living belie[ing] that even in the absence of goodwill, some marks are
better than others, in the sense that start-up costs of gaining consumer confidence and
the long-run costs of maintaining it are both lower.\(^{186}\) This analysis is supported by
Phillip Smith in his book on working with intent-to-use trademark applications:

Trademark lawyers often discourage the adoption of highly suggestive or
descriptive marks because of the generally weaker nature and/or narrow range of
protection accorded such marks, as well as the probable increased legal expense
involved in protecting and possibly litigating such marks. However, business
persons and marketing managers sometimes prefer the adoption of suggestive or
descriptive marks [thinking] such marks are easier to promote and advertise and
will be of more help in establishing a new market as compared to highly
distinctive or coined marks.\(^{187}\)

All of those trademark attorneys, however, are advising against the adoption of
descriptive marks with the long term interests of their clients in mind. While some
larger companies may be able to write off the extra cost of defending their descriptive
marks against second comers, smaller businesses are unlikely to shoulder this added
burden. Accordingly, savvy small businesses are likely to surrender the field of
descriptive marks to larger firms, putting them behind the competition from the very
beginning. It is unlikely that small firms can afford to take the chance of
unsuccesfully attaching secondary meaning to a descriptive mark. At the same time,
larger organizations with both legal acumen and large advertising budgets are likely
to be in a better position to create a whole new mark and attach goodwill to it if the
first or second attempt fails.\(^{188}\) Marshall Leaffer explained this phenomenon in his
discussion of the inherent advantages that the Madrid Protocol provides larger firms:

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185. Carter, supra note 3, at 774.
186. Id.
187. SMITH, supra note 87, at § 7.5.
188. Judy DeHaven, Atlantic City Bets on Just the Right Words to Pull In the Tourists, THE
SAN DIEGO UNION-TRIBUNE, Sept 14, 2003, at 16 (detailing Atlantic City's century of failed slogans
Large companies, equipped with permanent legal and administrative staffs, have the resources to engage in the worldwide filing of trademark applications and to make use of facilitating mechanisms as provided by the Madrid Protocol and Trademark Law Treaty. Therefore, one may encounter instances in which large companies take advantage of their economies of scale and know-how in such matters, when local businesses are only beginning to gravitate toward introducing their trademarks nationally.\textsuperscript{189}

Leaffer's analysis applies as much to domestic descriptive marks as it does to international competition. Larger firms have the resources and the ability to risk having a descriptive mark declared generic, while smaller firms often will neither have the resources nor the ability to contest seemingly generic terms being classified as descriptive, regardless of secondary meaning.\textsuperscript{190} Professor Roger E. Schechter, commenting on the case of Entrepreneur Magazine,\textsuperscript{191} noted that "[P]rotection [can be granted] to marks that shouldn't have been protected. Small businesses are at a disadvantage when this happens because litigation is expensive, risky and takes an owner's mind off the business."\textsuperscript{192}

Landes and Posner theorize that firms choosing descriptive marks must trade off the "partial substitute for advertising" that it provides for "the increased risk of losing the mark should it become generic (as well as against its lesser distinctiveness, and, hence, lesser value as source identification compared to a fanciful or arbitrary mark)."\textsuperscript{193} The authors do not suggest what type of firm would be able take such a risk. They do, however, make clear what type of firm can afford these risks when they predict that "[T]he shorter the expected life of a brand, the more likely the producer is to use a suggestive mark," and that "[D]escriptive mark[s] will generally only be used on brands with a long expected life, since it takes time to acquire secondary meaning, a prerequisite to obtaining trademark protection for such a mark."\textsuperscript{194} Therefore, producers who can wait the longest, relying on already existing

\begin{itemize}
  \item including: "The New Atlantic City—We’re Betting a Billion On It!," "Turn the A.C.,” and “America’s Favorite Playground.”)
  \item The last slogan was registered as a service mark on the Supplemental Register in 1998. See http://tess2.uspto.gov/ (new user search “America’s Favorite Playground”) (last visited September 16, 2005). Five years later the city tried another service mark, this time on the Principal Register, “Always Turned On.” See http://tess2.uspto.gov/bin/ (new user search “Always Turned On”) (last visited September 17, 2005).
  \item 190. \textit{See} note 188 \textit{supra} and accompanying text.
  \item 191. Entrepreneur Media v. Smith, 279 F.3d 1135 (9th Cir. 2002).
  \item 193. Landes & Posner, \textit{supra} note 158, at 294.
  \item 194. \textit{Id.}
\end{itemize}
marks and other sources of income, stand in better positions to build secondary meaning in their marks or risk having their descriptive marks being held generic.\textsuperscript{195}

Paradoxically, Landes and Posner point out that "Courts may not be doing a very good job of determining when trademarks have become generic,"\textsuperscript{196} providing yet another boost to those who can afford to take a chance. The authors discuss a series of words that had been held generic by courts—finding that almost half did "not appear in the most recent unabridged dictionary," in the sense that the mark holder was using the term.\textsuperscript{197} Furthermore, they examine seventeen marks that had been held to not be generic and found a recent dictionary used exactly those terms being listed "with the rejected generic meaning."\textsuperscript{198} They conclude that "[A]lthough words held to be generic are more likely to show up in the dictionary than those held not to be generic, the difference in probability is small—fifty four percent versus forty one percent."\textsuperscript{199}

Roger Shuy, in his book \textit{Linguistic Battles in Trademark Disputes}, discusses some of the sources that experts examine when asked to determine if a mark is generic, descriptive, or suggestive.\textsuperscript{200} First, he explains that "[H]ow words and expressions are defined is not limited to dictionaries.\textsuperscript{201} Linguists, however, do use dictionaries. Shuy writes that dictionaries are not impervious to the influence of trademark attorneys.\textsuperscript{202} This is a contention that, if accurate, questions the very idea of looking to these sources as an objective location to determine what a word "means." While lexicographers have a primary obligation to readers of dictionaries, these obligations can, and have been, overridden by zealous trademark holders.\textsuperscript{203} Shuy cites such examples as "Kleenex," "Band-Aid," and "Xerox" being "defined as trademarked products . . . [with] no accompanying citation for the generic use of these words. In these instances, at least, the trademark attorneys have won. They have used the threat of law to quash the obligation of lexicography to report the actual usage by the public."\textsuperscript{204}

\begin{itemize}
\item \textsuperscript{195} \textit{Id.}
\item \textsuperscript{196} \textit{Id.}
\item \textsuperscript{197} \textit{Id.}
\item \textsuperscript{198} Landes & Posner, supra note 158, at 294.
\item \textsuperscript{199} \textit{Id.}
\item \textsuperscript{200} ROGER SHUY, \textit{LINGUISTIC BATTLES IN TRADEMARK DISPUTES} (2002). The author is a linguist often called to testify in trademark disputes.
\item \textsuperscript{201} \textit{Id.} at 52.
\item \textsuperscript{202} \textit{Id.} at 55.
\item \textsuperscript{203} \textit{Id.}
\item \textsuperscript{204} \textit{Id.} The "threat of law" Shuy is referring to are successful requests by trademark owners that "ask the dictionary makers to omit such generic citations from their dictionaries, since they believe the words are trademarked and not generic." \textit{Id.}
\end{itemize}
Judge Posner has argued "assiduous" mark holders may be able to police their marks with the type of vigor decried by Shuy; however, such mark holders are unlikely to be small businesses with only a few marks to their name. Furthermore, the fact that these marks may be protected does not address the implications behind such protection. It is hard to see the policy advantage of protecting any mark that has reached generic status, regardless of its original classification. As the Second Circuit explained when the makers of "Chiclets" brought an infringement action for an imitation of their box design:

It is reasonable to believe that the fabulous sum—$11,000,000—that has been spent in 'publicizing'... 'Chiclets' has... to some degree destroyed it as a trade-mark. That is a peril to which all advertising is subject; its very success may prove its failure.

Additionally, Shuy's trial experiences highlight another danger of electing to use a descriptive mark for firms of all sizes: the risk that if a finder of fact holds a term is generic, the mark holder will never have the opportunity to present evidence establishing secondary meaning in the mark, because for obvious reasons, the issue is moot. This is yet another risk that firms with deeper pockets are going to be able to take sooner than those on a tight budget.

Indeed, some descriptive trademarks do achieve registration without any investigation on the part of the PTO; and if not challenged, these marks have the opportunity to be protected by incontestability from all competitors on the grounds of descriptiveness. Furthermore, a number of circuits hold as a presumption that "[T]he decision of the [PTO] to register a mark without requiring proof of secondary meaning affords a rebuttable presumption that the mark is more than merely descriptive."

205. See infra note 214.
206. American Chiclet Co. v. Topps Chewing Gum, Inc., 208 F.2d 560, 562 (2d Cir. 1953). See also Waldron, supra note 153, at 883 (arguing that once marks "become household words... it becomes ludicrous to continue insisting on the original proprietor's right to control their use.").
207. SHUY, supra note 200, at 53. Some have argued the PTO and courts mislabel other types of marks as descriptive, creating the possibility of genericide of "laudatory marks." See Greg J. Sosinsky, Note: Laudatory Terms in Trademark Law: Square Pegs in Round Holes, 9 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 725, 728-29 (1999).
208. See supra notes 76 and 79 and accompanying text.
209. McGregor-Doniger, Inc. v. Drizzle, Inc., 599 F.2d 1126, 1132 (2d Cir. 1979) (citing Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 11 (2d Cir. 1976); West & Co. v. Arica Institute, Inc., 557 F.2d 338, 342 (2d Cir. 1977)). Accord RFE Indus., Inc. v. SPM Corp., 105 F.3d 923, 926 (4th Cir. 1997) (holding PTO's registration without "requiring proof of secondary meaning" is "powerful evidence that the registered mark is suggestive and not merely descriptive."); Americana Trading Inc. v. Russ Berrie & Co., 966 F.2d 1284, 1287 (9th Cir. 1992) (reversing summary judgment finding a mark descriptive because the district court gave too little weight to the "presumptive effect" of the registration). But see Investacorp, Inc. v. Arabian Investment Banking
It has been observed that the PTO failing to “undertake any investigation when a mark holder moves for incontestable status . . . means running the risk of firms monopolizing descriptive marks.” Most disturbingly, the procedure allows the possibility of a mark that should have been deemed “merely descriptive” to be not only registered, but to have that error forever locked into law. “Such an outcome is particularly problematic because a mark that is undeserving of trademark protection in the first place is obviously an unusually weak candidate for incontestable trademark protection.”

Like all of us, Trademark Examiners and judges are fallible. It follows, however, that if larger firms stand in better positions to take risks on descriptive marks to begin with, and if the threat of descriptive marks being declared generic is somewhat less than it objectively should be, the anti-competitive advantages received by these larger companies will be even greater. Hence, if Landes and Posner are correct when they theorize that “[g]eneric status is achieved gradually,” that time period is a boon only to those who possess the descriptive mark. While there are many examples of mark holders failing to police or use their marks appropriately, making their marks generic, the process to reach such a decision is neither quick nor automatic.

One treatise, despite noting the “deterioration of a trademark into a generic name . . . is ordinarily the result of many factors,” advises that “a mark will be deemed abandoned under the Lanham Act if its owner permits it to become a generic term,” and suggests methods of preventing such a deterioration by the owner. These

Corp., 931 F.2d 1519, 1524 (11th Cir. 1991) cert. denied 502 U.S. 1005 (1991) (declining to defer to PTO registration as a prima facie showing of a lack of descriptiveness, “we will not defer to an ethereal determination that is not affirmatively stated by the administrative agency.”).

210. Alexandri, supra note 99, at 327 (citing Naresh, supra note 152, at 976 n.96 (explaining the incontestability application process and noting that there is no “procedure for the PTO to verify the truth of the statements made in a § 15 affidavit, nor for its publication, nor for any opposition to it”)).

211. Id. at 306 (emphasis in original).

212. Landes & Posner, supra note 158, at 292; see also Waldron, supra note 153, at 884 (noting that “short of a legal determination that [a mark has become generic] there are still an enormous number of images, icons and phrases that exist in a sort of grey area, still subject to intellectual property constraints, yet increasingly part of the ordinary furniture of our world”).

213. KANE, supra note 3, at § 5.2. Examples of marks losing their protection include “ASPIRIN,” “Y0-Y0,” “RAISING BRAND,” “ESCALATOR,” and “CELLOPHANE.” Id.

214. GILSON, supra note 162, at § 2.02(4) (emphasis added). Judge Posner admonished a plaintiff in an infringement suit: “A serious trademark holder is assiduous in endeavoring to convince dictionary editors, magazine and newspaper editors, journalists and columnists, judges, and other lexicographically influential persons to avoid using his trademark to denote anything other than the trademarked good or service. These efforts sometimes succeed. IHSA was not assiduous.” Illinois High School Association (IHSA) v. GTE Vantage Inc., 99 F.3d 244, 246 (7th Cir. 1996). One must query whether it is feasible or desirable for a high school athletic association to be spending its time and energy attempting to convince “lexicographically influential persons” not to use its mark incorrectly.
methods, however, are time and capital intensive—extending far beyond correct use of the mark by the mark owner to active persuasion and challenging of "the public, the industry, the media, the [PTO], trade and consumer publications, and others." Few small businesses could hope to undertake such activities.

E. Concurrent Use Doctrine

As discussed earlier, the current process for protecting descriptive marks has the potential to discriminate against smaller mark holders. Furthermore, the concurrent use doctrine, which controls whenever two sellers have both used the same unregistered mark, has lately been applied in a manner that favors the larger mark holder. Put simply, the concurrent use doctrine "governs territorial rights in unregistered trademarks." Codified in the original Lanham Act, these rules developed from two pre-Lanham decisions in an effort to prevent the inherent confusion between two users attaching the same mark to their similar goods or services.

As Professor McCarthy explained: "When several persons claim ownership of the same mark for the same goods sold in the same territory, the situation is ripe for litigation to determine the true, single owner." While the statute applies to all protectable marks, be they arbitrary or descriptive, because of the need to establish secondary meaning for a descriptive mark before it receives registration on the Principal Register, the application of the concurrent use doctrine is particularly relevant here.

The doctrine dictates that if two parties are using the same unregistered mark in separate geographic territories, the mark may be registered by either one of the users. As one practitioner explained, "Registration freezes the nonregistered concurrent user to the markets in which it is doing business at the time of the registration application, and it only extends exclusive use nationwide to goods and services indicated in the registration certificate." In other words, the user that files first will likely receive exclusive nationwide rights in the mark, except for the

215. GILSON, supra note 162, at § 2.02(6).
216. See IHSA, 99 F.3d at 248.
220. See MCCARTHY, supra note 18, at § 16:40 ("If more than one unrelated person is selling goods under the same mark, such multiple, fragmented use can lead to customer confusion and deception.").
221. KANE, supra note 3, at § 19.5.1.
geographic areas that are occupied by the other user, as long as consumers are not confused.\textsuperscript{223} The Second Circuit laid out the rule that controls these determinations in \textit{Dawn Donut Co. v. Hart's Food Stores, Inc.}\textsuperscript{224} The general formulation is that “Under the \textit{Dawn Donut} rule, while a senior federal registrant has superior priority, there is no likely confusion for a court to enjoin unless and until the senior user shows a likelihood of entry into the junior user’s trade territory.”\textsuperscript{225} Yet application of the standard had begun to show signs of dissent. Courts in two different circuits have held the concurrent use doctrine and the \textit{Dawn Donut} rule should be seen as only one of the many factors analyzed in the likelihood of confusion test.\textsuperscript{226}

Whether the \textit{Dawn Donut} rule should be seen as a separate standard or just one part of a multifactored test is beyond the scope of this article.\textsuperscript{227} Nevertheless, the decisions made by the Court of Appeals for the Sixth Circuit and a district court in the Third Circuit are significant to the instant issue. In \textit{Circuit City}, the Sixth Circuit held in favor of a federal registrant, despite the mark holder never establishing any “expansion plans, budgets, or expansion progress reports” for the area where the junior user operated.\textsuperscript{228} The district court’s decision in \textit{Members First} was remarkably similar.\textsuperscript{229} The court refused to use a “geographic distance test to determine service mark infringement.”\textsuperscript{230} Instead, the court relied on the \textit{Scott Paper}\textsuperscript{231} test—a ten factor likelihood of confusion test that does not require a geographic overlap of markets where the opposite parties use their mark for a likelihood of confusion to exist.\textsuperscript{232} One practitioner sees these decisions as calling into question the “viability” of the \textit{Dawn Donut} rule.\textsuperscript{233} He may be correct.

\begin{itemize}
  \item \textsuperscript{223} \textit{Id.} at 692.
  \item \textsuperscript{224} 267 F.2d 358 (2d Cir. 1959).
  \item \textsuperscript{225} MCCARTHY, \textit{supra} note 18, at § 26:33 (emphasis added).
  \item \textsuperscript{226} See \textit{Circuit City Stores, Inc. v. CarMax, Inc.}, 165 F.3d 1047, 1057 (6th Cir. 1999); Members First Federal Credit Union v. Members 1st Federal Credit Union, 54 F. Supp. 2d 393 (M.D. Pa. 1999). See also Barrett, \textit{supra} note 16 (urging the elimination of the geographic element of the concurrent use doctrine because of the constructive notice provided by modern technology.)
  \item \textsuperscript{227} See Thomas L. Casagrande, \textit{The “Dawn Donut Rule:” Still Standing (Article III, That Is) Even With the Rise of the Internet}, 90 TMR 723 (2000) (arguing the rule at heart is a standing doctrine that should continue to require courts to conduct factual inquiries into the immediate threat of irreparable harm to senior users).
  \item \textsuperscript{228} \textit{Circuit City}, 165 F.3d at 1052. The court held that a “likelihood of entry” was sufficient for injunctive relief. \textit{Id.} at 1056. The plaintiff had testified that it “projected” it would expand into the defendants’ area. \textit{Id.} at 1052.
  \item \textsuperscript{229} \textit{Members First}, 54 F. Supp. 2d at 402.
  \item \textsuperscript{230} \textit{Id.}
  \item \textsuperscript{231} Scott Paper Co. v. Scott’s Liquid Gold, Inc. 589 F.2d 1225, 1229 (3d Cir. 1978).
  \item \textsuperscript{232} \textit{Members First}, 54 F. Supp. 2d at 402.
  \item \textsuperscript{233} Casagrande, \textit{supra} note 227, at 735.
\end{itemize}
Why does the plethora of available information not work both ways? Just as some courts may find it difficult to side with a junior user when so much information is readily and cheaply available, the reverse should also be true. A concurrent user that only seeks to maintain his mark in a limited geographic area can make a valid argument that it is no harder for a larger user, intending to register its mark, to find the concurrent user than it is for the smaller user to know about the larger user. Therefore, the registrant to be (the large user) should know there might be an area of the country ruled off limits to its mark, despite federal registration. However, because some courts do not seem to realize that information flows from smaller markets to larger markets and vice versa, federal registrants continue to hold the upper hand.234

Accordingly, when a large user registers its mark, it will usually be willing and able to go to court to force the smaller concurrent user to stop using the mark entirely.235 Some courts disregard for the *Dawn Donuts* compromise (which allowed for non-infringing concurrent use) serves as another example of how the existing descriptive mark regime works against the interests of the smaller mark holder.236 Finally, a quote from Professor Carter sums up the status of the current system and its possible long term effect on small descriptive mark holders and consumers:

> [A]s firms adopt the more easily marketed suggestive and descriptive marks, the number of better marks in the available market language will decrease. Gradually, the point may be reached when competitors who wish to enter the market will be forced to choose a less effective mark, that is, one that will raise the costs of market entry because of the greater cost associated with the use of the mark.237

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234. See *IHSA*, 99 F.3d at 247-48; *Park 'N Fly, Inc.*, 469 U.S. at 204.

235. See *Circuit City*, 165 F.3d at 1048. This is exactly what Circuit City did when a smaller, concurrent user of the mark “CarMax” appeared in Northeast Ohio. *Id.*

236. Similarly, the Seventh Circuit’s decision in *IHSA* struck a blow against the smaller mark holder. *IHSA*, 99 F.3d 244 (7th Cir. 1996). When the senior user of the mark “March Madness” attempted to enjoin the junior user’s licensing of the mark to a third party, the court held that because the media referred to the junior user in connection with the term, “that is what the public will call it, or know it as.” *Id.* at 246. The court adopted a “dual-use” trademark analysis whereby both users could use the mark in overlapping geographic territories, and those users could use the mark to the exclusion of all others, yet the senior user had no claim against the junior user. *Id.* One commentator has argued that this decision “[f]avoring wealth and power over creativity and a need to protect consumers from confusion . . . represents a departure from traditional trademark policy and threatens the survival of small trademark holders.” Jason R. Wolfsberger, *Recent Developments: Illinois High School Association v. GTE Vantage, Inc: Dual Use Classification Threatens the Extinction of America’s Small Trademark Holder, 32 GA. L. REV. 363 (1997).*

V. CURRENT PROTECTIONS MAY SOON BE DETRIMENTAL EVEN FOR LARGE MARK HOLDERS

The two previous sections have addressed some of the dangers to the public domain and small mark holders built into the current process of registering and protecting descriptive trademarks. The beneficiaries of many of these circumstances appear to be the large companies that already hold, or seek to register, descriptive marks. This section explores an element of the current landscape that favors individual mark holders over all others, thereby endangering the exclusive rights of all descriptive mark holders, be they large or small.

The possibility of descriptive marks being used as internet domain names becoming eligible for trademark protection is likely to become a reality sooner rather than later. Just as any business can attempt to claim rights in any descriptive mark in the "real" world, the same is true in the "virtual" world. Naturally, many of the competitive advantages available to large businesses with regard to descriptive marks offline redound to their benefit online as well. There is, however, no concurrent use doctrine in the realm of internet domain names. The fact that only one user can have "companyname.com" raises a series of issues.

Additionally, a brief exploration of the impact of the fair use doctrine on descriptive marks will be undertaken in this section, demonstrating that for any size business these marks are not nearly as protectable as arbitrary or suggestive marks. Accordingly, both the possibility of the fair use of descriptive marks and their use as domain names demonstrates that the exploitation of descriptive marks should be generally discouraged—except for those few instances where owners can consistently establish secondary meaning in their mark.

A. Internet Domain Names

With at least one recent estimate placing the level of annual internet commerce at over two trillion dollars, there is no longer a question of whether the internet will have a lasting impact on the world of commerce. Yet trademark law continues to wrestle with how to regulate domain names, both for the advertising of goods and services, as well as providing source identification. For example, which of the forty-

238. David McGuire, Firms Bid to Control .net Addresses; ICAAN to Select Registrar of 5 Million Dollars Names, WASH. POST, Jan. 20, 2005, at E5.
239. See supra Part IV.
240. Of course there are other Top Level Domain indicators ("TLD") such as ".org," ".net," etc., but only one individual may possess the ".com" domain name at a time.
241. McGuire, supra note 238 (noting that the "current .net registrar . . . estimates that $700 billion annually in Internet commerce—nearly 30 percent of the total—travels through the domain.").
three live marks "UNITED"\textsuperscript{242} are entitled to www.united.com? As the Ninth Circuit recently noted, "Web users often assume as a rule of thumb that the domain name of a particular company will be company name followed by `\texttt{.com}'\textsuperscript{243} Nevertheless, even if consumers might expect to find "United Van Lines at www.united.com [they will not, because] United Airlines happens to own that domain name."\textsuperscript{244}

Specifically relevant here is the issue of how descriptive marks used as domain names should be handled. As the UNITED example demonstrates, only one mark holder may lay claim to the "\texttt{.com}" website for a company named "United." While this is clearly an important problem in the realm of arbitrary and suggestive marks, it is an even more vital one in the area of descriptive and generic marks.\textsuperscript{245} The danger to the user that does not receive the right to use the mark as a "\texttt{.com}" is readily apparent. As one practitioner describes: "The domain name system allows for the precise situation that trademark law seeks to prohibit, in that one manufacturer is allowed monopolistic control over a generic or descriptive term."\textsuperscript{246}

Furthermore, it has been posited that when the PTO, acting on behalf of society at large, grants a protectable right in any mark to a user, such a transfer may been seen as "the public fully transfer[ing] a word from the storehouse of common language to a private party for the purpose of trade . . . . [However, this] is troubling because it assumes a substantial permanent alienation of part of the public's linguistic-symbolic heritage."\textsuperscript{247} Similarly, once a single producer is granted rights in a domain name for her descriptive mark, it will be almost impossible for that user not to demonstrate secondary meaning, due to the increased level of exposure and aura of legitimacy denoted by having "\texttt{.com}" attached after one's descriptive mark.\textsuperscript{248}

\textsuperscript{242} Search undertaken on the Trademark Electronic Search System, (TESS) at http://tess2.uspto.gov/ (user search "United") (last visited Sept. 28, 2005).

\textsuperscript{243} Interstellar Starship Services, Ltd. v. Epix, Inc., 304 F.3d 936, 944-45 (9th Cir. 2002) (quoting Brookfield Communications v. West Coast Entm't, 174 F.3d 1036, 1044-45 (9th Cir. 1999)).

\textsuperscript{244} Id.


\textsuperscript{247} Wif, supra note 13, at 34.

\textsuperscript{248} McCarthy has commented on this phenomenon, writing: Somehow, Internet folklore has created the mis-impression among some users that once one obtains an "officially registered" domain name from a local registrar, then that name can thereafter be used in any way without legal consequences. This is an unfortunate bit of misinformation. A domain name registrar that reserves domain names cannot license a domain name user to commit the tort of trademark infringement or unfair competition. Thus, a "first-come-first-served" policy of a registrar "cannot trump federal [trademark]
When Professor Carter wrote: "Under the Act, a firm cannot register a descriptive mark until it is able to show consumers actually recognize the mark as distinguishing the firm's goods," it was implicit that the firm would have to go out into the marketplace and demonstrate secondary meaning. Accordingly, if there were a second or third firm that used a similar descriptive mark on a similar good or service, it should have the same opportunity as the first firm to demonstrate secondary meaning in its use of the descriptive mark in the interim. Yet, as previously explained, by registering a mark on the Supplemental Register some courts hold that registrants have established an essential hold on that mark until they develop secondary meaning. Moreover, as large firms register descriptive marks not only on the Supplemental Register but as domain names as well, it will become more difficult for smaller users to successfully build up the necessary secondary meaning in the same mark prior to any registration. In the alternative, the hurdle will be set so high for smaller firms to defeat the larger firms' registration that it will become pointless to challenge the mark.

The possibility of this type of prejudice was increased by a 2001 decision regarding the registration of a mnemonic mechanism for a phone number. The Federal Circuit overturned the Trademark Trial and Appeal Board's ("TTAB") denial of registration of the mark "1-888-M-A-T-R-E-S-S" in Dial-A-Mattress Operating Corp. The court held that the "mark is descriptive of the relevant services, and has law." MCCARTHY, supra note 18, at § 25:73.3 (quoting Cardservice Int'l, Inc. v. McGee 950 F. Supp. 737, 740 (E.D. Va. 1997), aff'd without opinion, 129 F.3d 1258 (4th Cir. 1997)).

249. Carter, supra note 3, at 776. The author is mindful of supra note 210, and accompanying text discussing the presumption by several circuits that the PTO, by granting registration of a mark, has made a determination that secondary meaning exists. However, that courts have determined that the burden shall be placed on the challenger of the descriptiveness of the mark, does not automatically amount to a factual presumption that the PTO always performs a secondary meaning analysis at the time of registration. See supra note 79 discussing the likelihood of mistake by the PTO.

250. The current system makes this perhaps more difficult than necessary. As one practitioner has noted: [T]he PTO can presume a descriptive mark is distinctive if the applicant provides the PTO with "proof of substantially exclusive and continuous use" of the descriptive term "as a mark" on the applicant's goods "in commerce for the five years before the date on which the claim of distinctiveness is made." If no competitor opposes the trademark application, the applicant's affidavit could be only evidence before the PTO when it decides whether the descriptive term has become distinctive. Ramsey, supra note 182, at 1165 (quoting 15 U.S.C. § 1052(f)). See also supra note 193, and accompanying text.

251. See supra note 108 and accompanying text.

252. Who generally will have less time or resources to pursue the domain name for the descriptive mark, or perhaps have less of a need for an immediate internet presence.

253. 240 F.3d 1341 (Fed. Cir. 2001). It should be noted that at least one circuit disagrees with
acquired prima facie distinctiveness." The court further explained that the mark was not generic, and just like the "title 'Fire Chief' for a magazine in the field of fire fighting, a phone number is not literally a genus or a class name, but is at most descriptive of the class." Because the company had a variety of other registered marks, the court determined that the mnemonic device had acquired distinctiveness "as the legal equivalent of one of Dial-A-Mattress' previously registered marks."

The court also held that the mark holder's ITU application was "based on the premise that the [previous] mark [had] acquired distinctiveness." The court accepted that one of the applicants' previous marks, "(212) M-A-T-R-E-S-S," was a descriptive mark that had achieved secondary meaning. The result of this holding was that a merely descriptive mark did not have to demonstrate secondary meaning in order to survive a rejection by the TTAB simply because of similar marks previously being registered by the mark holder. Furthermore, and certainly relevant here, both courts and commentators continue to see parallels between "vanity" phone numbers and domain names.

A 2004 Federal Circuit decision brought descriptive marks even closer to being registered as domain names. In Oppedahl, although the court affirmed a PTO decision that "patents.com" was a merely descriptive mark that had not acquired distinctiveness, it explicitly held that it did "not read the PTO's policy to include an absolute prohibition that adding a TLD to a descriptive term could operate to create a distinctive term." The court noted that ".com" "immediately suggest[s] a
relationship with the internet," and therefore creates more of a commercial expression than simply "corp." or "inc.," suggesting that commercial impression may help to create secondary meaning.\textsuperscript{261} The court provided the example of "amazon.com" representing book sales, as opposed to "amazon" by itself being more denotative of either the famous river or mythical "fierce female warrior[s]."\textsuperscript{262} "[T]he entire mark Amazon.com changes the impression to invoke an online retailer."\textsuperscript{263}

This line of reasoning opens up the possibility of marks, previously held to be merely descriptive, finding new life by creating the commercial impression of being online retailers. Hence, while "ARTHRTICARE" was held to be merely descriptive and lacking in secondary meaning,\textsuperscript{264} perhaps "ARTHRTICARE.COM" would engender enough of a commercial impression to receive protection. Accordingly, it was not the court's holding against the applicant, but its reference to its previous Dial-A-Mattress decision and its statement that in "exceptional circumstances, a TLD may render an otherwise descriptive term sufficiently distinctive for trademark registration,"\textsuperscript{265} that foretells it is only a matter of time until descriptive marks appear as protected domain names.

Not surprisingly, when an applicant attempted to register BLINDSANDDRAPERY.COM on the Principal Register, the applicant relied on Oppedahl to argue that the TLD combined with the mark created an inherently

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\textsuperscript{261} Oppedhal, 373 F.3d at 1175.
\textsuperscript{262} Id.
\textsuperscript{263} Id. at 1175-76.
\textsuperscript{264} Bernard v. Commerce Drug Co., 964 F.2d 1338, 1342 (2d Cir. 1992).
\textsuperscript{265} Oppedahl, 373 F.3d at 1177. Again, the court does not so hold in Oppedahl. In fact, it explicitly holds that:

this court declines to adopt a per se rule that would extend trademark protection to all Internet domain names regardless of their use. Trademark law requires evaluation of a proposed mark to ascertain the commercial impression conveyed in light of the goods or services associated with the mark, not a simple check for ownership of an Internet address.

\textit{Id.} Although it is comforting the court did not hold a mark such as "dogs.com" could be registered as a trademark simply because someone had purchased the rights to the domain name, that distinction is only in keeping with the statutory provisions of the Lanham Act and no more. \textit{See id.} Moreover, that the court seems willing to allow the possible registration of an internet domain name that is a descriptive mark similar to 1-888-M-A-T-T-R-E-S-S, is distressing.
distinctive mark. Although both the Trademark Examiner and the TTAB rejected this contention, the TTAB explained that Oppedahl signified that "the Federal Circuit has anticipated situations whereby the coupling of an otherwise unregistrable term and a TLD create a whole greater than the sum of its parts." Fortunately, the TTAB saw things much differently:

[Unlike a mnemonic device for a phone number,] the precise generic term and TLD combination employed by applicant can be incorporated into other domain names. A 'blinds and drapery' concern should not be precluded from combining its name with the generic compound term BLINDSANDDRAPERY.COM to create thereby a different domain name from that of [the] applicant.

It is exactly this type of situation that should continue to be prevented, even if a new regime regarding domain names specifically or descriptive marks generally is required.

There is hope, however, that descriptive marks will not become the latest casualty to overly rapacious business owners in their quest for market dominance. That hope springs not from any notion of paternalism, but from the experience of the marketplace itself. As one observer noted, in the late 1990s when domain name speculation was at its peak, the names that actually "survived the early dot com era all followed traditional branding theory and were arbitrary or suggestive."

B. Fair Use and Descriptive Marks

While all trademarks are subject to fair use, descriptive mark owners are, by necessity, going to find themselves more often the victims of others using their marks. "By choosing a descriptive term, the trademark owner must live with the result that everyone else in the marketplace remains free to use the term in its original 'primary' or descriptive sense." In other words, it is the very quality that makes a descriptive mark attractive to the first mark holder that is its Achilles heel in terms of exclusive use. Thus, no matter how successful the mark holder is at establishing his mark as the product that consumers associate with the descriptive term, "[C]onsumers [do not] forget the descriptive meaning of the word when they use it as a mark." Courts

267. *Id.* The Board also held, "We do not believe applicant's combination of terms yields such a result." *Id.*
268. *Id.* (citing *In re* Cyberfinancial, 65 U.S.P.Q. 2d 1782, 1792 (T.T.A.B. 2002)).
269. SCHWIMMER, *supra* note 246, at 10 (noting examples such as Amazon, Yahoo!, Google, and Ebay).
have taken a variety of stances when addressing alleged infringement of descriptive marks. Some have laid the blame entirely on the mark holder, while others have theorized that because a term "resides in the public domain," the likelihood of consumers believing "the mark came from a particular single source" would be lowered. Perhaps the best barometer of how trademark's fair use doctrine and descriptive marks truly interact would be to examine an illustration of one descriptive mark's experience.

Entrepreneur Media ("EMI") is the owner of the mark "ENTREPRENEUR," and uses it in connection with its "Entrepreneur magazine." EMI registered the mark in 1987, and it has since reached incontestable status. EMI polices its mark by taking alleged infringers to court. For example, in 2002, the Ninth Circuit affirmed EMI's action against a defendant for using the mark in connection with the defendant's public relations company—resulting in a $1.4 million judgment against the defendant. This type of success has scared off other potential users of the mark, including the domain name owners of "entrepreneurs.com" and "entrepreneur.net," and Carnegie Mellon University.

Not all fair users, however, will be scared off by threats of litigation. EMI discovered this when it tried to prevent "Ernst & Young from publishing the Ernst &
Young Entrepreneur of the Year Magazine.\textsuperscript{281} The firm held its ground and Entrepreneur Media backed off.\textsuperscript{282} Although most small business do not have the resources or access to legal counsel that a company the size of Ernst & Young might, the above example demonstrates fair use can be a powerful tool to prevent overly litigious descriptive mark holders, even if only in the hands of the powerful.

Unfortunately, if a major private university is unwilling to stand up for its right to use the English language, the hopes of much smaller firms and individuals are slim. While EMI’s practice is both accepted and wise for a large mark holder, it operates against the underlying foundation of trademark law and the free market. As Professor McCarthy has detailed:

The policies of free competition and free use of language dictate that trademark law cannot forbid the commercial use of terms in their descriptive sense: “The principle is of great importance because it protects the right of society at large to use words or images in their primary descriptive sense, as against the claims of a trademark owner to exclusivity.”\textsuperscript{283}

\begin{enumerate}
\item[281.] See Rubin, \textit{supra} note 279.
\item[282.] \textit{Id.}
\item[283.] McCarthy, \textit{supra} note 18, § 11:45 (quoting Car-Freshner Corp. v. S.C. Johnson & Son, Inc., 70 F.3d 267, 269 (2d Cir. 1995)). It should be noted all mark holders are susceptible to damage of their mark via dilution, but only famous marks are eligible for protection under the Federal Trademark Dilution Act (FTDA), codified at 15 U.S.C. § 1125(c)(1) (2005). While descriptive marks can achieve “famous” status, (i.e. COCA-COLA), once this distinctiveness has been acquired, they shall be analyzed as a famous mark and not a descriptive one, and therefore reach beyond the scope of this article. In fact, the recent Supreme Court holding on mark dilution \textit{Moseley v. V. Secret Catalogue, Inc.}, 537 U.S. 418 (2003), did not clarify the split among the circuits on whether a mark that has acquired distinctiveness is covered under the FTDA. Compare Times Mirror Magazines, Inc. v. Las Vegas Sports News, L.L.C., 212 F.3d 157 (3d Cir. 2000) (not requiring inherent distinctiveness) \textit{with} Nabisco, Inc. v. PF Brands, Inc., 191 F.3d 208 (2d Cir. 1999) (requiring inherent distinctiveness). Kane notes “the Second Circuit requirement of inherent distinctiveness strips federal dilution protection from a host of famous marks that were initially descriptive, for example, COCA-COLA.” Kane, \textit{supra} note 3, at § 9:5.2. For a more in depth discussion of dilution after \textit{Moseley}, see J. Thomas McCarthy, \textit{Trademark in Transition: Institute for Intellectual Property \& Information Law Symposium: Proving a Trademark has been Diluted: Theories or Facts?}, 41 Hous. L. Rev. 713 (2004); Jonathan Moskin, \textit{Victoria’s Big Secret: Whither Dilution Under the Federal Dilution Act?}, 93 Trademark Rep. 842 (2003). Lastly, on Apr. 19 2005, the House passed H.R. 683, the “Trademark Dilution Revision Act of 2005” by a vote of 411-8. The Act changes the “actual dilution” standard delineated in \textit{Moseley} to one of “likely dilution.” The proposed legislation holds that dilution protection does not require inherent distinctiveness. H.R. 683, 109th Cong. (2005), 151 Cong. Rec. H2121, 21-23 (2005).
VI. POSSIBLE SOLUTIONS FOR REFORMING THE CURRENT PROTECTION SYSTEM

Having laid out the dangers for the public domain and the smaller business owner with regard to descriptive trademarks, this last section suggests a few easily implemented, inexpensive methods for leveling this area of the trademark playing field. While each of these ideas could be enacted individually, they are designed to work in concert, and should therefore be considered as an interactive whole.

A. Clarify and Raise the Burden for Demonstrating Secondary Meaning

Professor Stephen Carter has argued for a return to the regulation of trademarks under the common law, as opposed to the current federal scheme. Part of his reasoning is grounded in sound economic analysis:

[There] is an important theoretical nexus between ... passing off\textsuperscript{284} ... and the economic argument for the protection of trademarks. The common law action for passing off creates an incentive for a successful firm to find ways of marking its goods to distinguish them from the goods of other makers.\textsuperscript{285}

In other words, protecting marks that have differentiated themselves from their competitors in order to allow consumers to reduce the time and costs spent looking for products with which they are familiar, is a social good worthy of protection. After all, if the primary goal was to provide incentives to distinguish one's mark over all others, terms such as “ENTREPRENEUR” would not be available at all for protection for a magazine about business, let alone be eligible for permanent incontestable standing.\textsuperscript{286}

Accordingly, it is vital that marks claiming to have acquired distinctiveness demonstrate that the mark has risen to the level where “[T]he primary meaning of the

\textsuperscript{284} Passing off being defined as a junior user “passing off” his product as being that of the senior user.

\textsuperscript{285} Carter, supra note 3, at 766.

\textsuperscript{286} This author and Professor Carter part ways here. Carter argues that “trademark law may be described as indifferent to the creation of marks ... [a]ll that is needed is a different mark for each producer. ... The charming, attractive mark not yet associated with any goodwill simply does not carry any information, and, consequently, cannot possibly economize it.” Id. at 768. As discussed above, the more distinctive the mark, the more easily distinguishable and registerable it is. Inherently distinctive marks are less likely to be held generic, especially when properly used by their owners. Thus, while the creation of a mark may not always be artistic, there is unquestionably a strong economic incentive to create a distinguishable mark for one’s goods.
When a descriptive mark applies for registration on the Principal Register, it should never be enough that consumers merely acknowledge a particular merchant sells a product with that word attached to it. In other words, the PTO, the TTAB, and the courts must hold marks to the high standard first envisioned when the concept of allowing the protection of descriptive marks was endorsed; they must ask, Does this mark identify the source of the good or service?

Currently, it is slightly unclear as to which party carries the burden to demonstrate a mark does not possess secondary meaning. Although the Federal Circuit has held that "[t]he burden of proving secondary meaning is on the party asserting it, whether he is the plaintiff in an infringement action or the applicant for federal trademark registration," there are at least two TTAB holdings that contradict this seemingly logical procedure. In Aid Labs., the question was whether "PEST PRUF," for animal shampoo and insect repellant, was a descriptive or suggestive mark. By holding that it was "not merely descriptive," the Board conceded that "[T]he determination of whether a particular term falls on the 'suggestive' or 'merely descriptive' side of the line is highly subjective in nature, and resolves any doubt in favor of the applicant." Similarly, a registration for the mark "THE LONG ONE" (for bread) was resolved in favor of the applicant because "[A]ny person who believes he would be damaged by the registration [had] an opportunity . . . to oppose the registration of the mark and to present evidence, usually not present in the ex parte application, [that the mark lacks distinctiveness]." Thus, despite the clear language of Yamaha, the Federal Circuit has cited both Aid Labs., and Gourmet Bakers approvingly when discussing the burden to show whether a mark was merely descriptive.

The presumption must be made clear and unequivocal; the burden should be high and placed on the shoulders of the mark holder. As one practitioner argues:

'Time and money are required to monitor trademark registrations and file opposition proceedings . . . . It is even more unlikely that general members of the public and possible future competitors will monitor PTO

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290. Aid Labs., 221 U.S.P.Q. at 1215-16.
291. Id. at 1216.
registrations to ensure that descriptive words remain available for use by everyone in a particular industry.\textsuperscript{294}

The "ENTREPRENEUR"\textsuperscript{295} example demonstrates the impact on mark holders and the public at large of descriptive marks being found to have attained secondary meaning, thereby becoming eligible for incontestability. Asking applicants to meet a higher standard in order to show either inherent or acquired distinctiveness is not overly oppressive. Clarifying and raising this burden prevents the PTO from abdicating its responsibility to ensure that descriptive marks are not mistakenly placed on the Principal Register.\textsuperscript{296}

\textbf{B. Remove Incontestability Protection for Descriptive Marks}

There are a myriad of recent decisions demonstrating that descriptive mark owners can prove their term has acquired secondary meaning and do not need the added protection of incontestability. Thus far, however, the best argument against incontestability remains Justice Stevens’ impassioned dissent in Park ‘N Fly:

\begin{quote}
[I]t is apparent that Congress could not have intended that incontestability should preserve a merely descriptive trademark from challenge when the statutory procedure for establishing secondary meaning was not followed and when the record still contains no evidence that the mark has ever acquired a secondary meaning. . . . [I]f no proof of secondary meaning is ever presented, either to the [PTO] or to a court, there is simply no rational basis for leaping to the conclusion that the passage of time has transformed an inherently defective mark into an incontestable mark.\textsuperscript{297}
\end{quote}

Although the \textit{Entrepreneur Media v. Smith} action is discussed at length above,\textsuperscript{298} it is worth mentioning again briefly. The mark holder’s victory in this instance was almost in spite of incontestability rather than because of it. The court held:

\begin{quote}
[Despite having used the mark since 1978 and having over two million monthly readers,] EMI has not demonstrated that it has so strengthened its mark as to weigh this factor in favor of finding likely confusion. [For the
\end{quote}

\begin{footnotes}
\textsuperscript{294} Ramsey, \textit{supra} note 182, at 1165. This problem is only exacerbated by the shield of incontestability that is reached in five years by the applicant. As Ramsey notes: "If no one contests the registration during the five-year period, the registrant’s rights in that descriptive term could become incontestable. . . . By allowing non-distinctive descriptive marks to become incontestable, trademark laws harm speech more than necessary." \textit{Id.} at 1165-66.
\textsuperscript{295} See \textit{supra} note 277 and accompanying text.
\textsuperscript{296} See \textit{supra} note 79 and accompanying text.
\textsuperscript{297} \textit{Park ‘N Fly}, 469 U.S. at 211-12 (Stevens, J., dissenting).
\textsuperscript{298} See \textit{supra} note 277 and accompanying text.
\end{footnotes}
purposes of summary judgment] we credit the ‘ENTREPRENEUR’ mark with only descriptive strength, because on this record EMI has demonstrated no more. 299

Even though EMI’s mark had achieved incontestable status, this did not automatically confer acquired distinctiveness, (hence the reference to it as “only descriptive”) and it would have to prove confusion elsewhere. 300 Accordingly, incontestability was not determinative.

Consider Bancorp v. SBM. 301 In Bancorp, the owners of an unregistered descriptive mark prevailed over infringers of their mark by demonstrating secondary meaning in the mark. 302 SBM has owned and operated the Casino de Monte Carlo in Monaco since 1863. At the time of the action, SBM had a New York office and was spending over one million dollars a year in promotions in the United States. 303 Bancorp created websites using the mark that SBM had registered in Monaco, but not in the United States. 304

The Fourth Circuit explained that unregistered, foreign marks are not entitled to protection under the Lanham Act; however, as long as the mark is distinctive among United States consumers, it can be protected. 305 In this instance, Bancorp argued the mark was merely geographically descriptive. 306 The court noted that, while the mark may be geographically distinctive, geographic descriptiveness does not “foreclose the mark’s distinctiveness.” 307 Furthermore, the court held that “SBM met its burden of proving secondary meaning... because it had established that the plaintiff companies directly and intentionally copied the ‘Casino de Monte Carlo’ mark.” 308 Bancorp was held to have violated the Lanham Act, despite SBM’s failure to register the mark. 309

299. Entrepreneur Media, 279 F.3d at 1144. The Ninth Circuit took pains to state that even though EMI has the “exclusive right to use its trademark in printed publications pertaining to business opportunities, the common and necessary uses of the word... provide strong evidence that EMI cannot have the exclusive right to use the word ‘entrepreneur’ in any mark identifying a printed publication addressing subjects related to entrepreneurship.” Id. at 1143-44.

300. Id. at 1153. EMI successfully proved confusion elsewhere. Id. at 1138.


302. Id. at 372.

303. Id. at 361.

304. Id. Some examples: casinodemontecarlo.com, casinodemontecarlo.net, casinomontecarlo.com, casinomontecarlo.net, etc. The websites had a picture of a casino that appeared very similar to the actual Casino de Monte Carlo. Id.

305. Int’l Bancorp, 329 F.3d at 370.

306. Id.

307. Id.

308. Id. at 371.

Conversely, a plaintiff registered the term “Woodroast” in connection with his restaurant and alleged infringement against a rival restaurant for using the mark on its menus. The defendant argued that the mark was generic, while the plaintiff claimed incontestability and that the mark was strong. The defendant failed to show that the mark was generic, which resulted in a finding that there “was a material fact dispute as to whether the ‘woodroast’ mark is suggestive, descriptive, or generic.” Because of this factual question, despite the mark having achieved incontestability, the court did not make a determination on the status of the mark with regard to its genericness, and simply rejected the defendants’ summary judgment motion. In other words, the fact that the mark had reached incontestability carried no significant weight with the court as to its making a generic or descriptive mark distinction.

The larger problem that must be addressed is that incontestability weakens the last line of defense for both the marketplace and the linguistic commons—the judiciary. As Lisa Ramsey has commented when decrying the immunity granted to descriptive marks, “[E]ven if a court believes the plaintiff’s descriptive mark is not distinctive, and was erroneously registered on the principal register, the court must find that the mark is valid and protected.” One scholar has noted that once a descriptive mark attains incontestability there can be no challenge of any kind that is not based on the challenger being a prior user of the mark. The recent move away from the Dawn Donut rule, along with the rise of internet domain names playing a larger role in mark identification highlights the importance to prior users of preventing descriptive marks from achieving incontestability. After all, preventing such a classification serves as small prior users’ only hope of being able to continue to use their mark in commerce.

Professor Naresh states: “The usual justification for incontestability is that it is necessary to quiet the registrant’s title to the mark.” While there are long held

311. Id. at 909-10.
312. Id. at 913. The author questions outside of incontestability, what the mark “woodroast” is, if not descriptive, as it was adopted by the plaintiff because of its “woodroast cooking style.” Id. at 912.
313. Woodroast Systems, 793 F. Supp. at 916. Furthermore, it granted the preliminary injunction requested by the plaintiff because of questions regarding the likelihood of confusion based on defendants’ actions. Id. at 919.
314. Ramsey, supra note 182, at 1164 (citing Park ‘N Fly, 969 U.S. at 205).
315. Naresh, supra note 152, at 978 (making the mark holder “impervious to attack”).
316. See supra Part IV.E.
317. See supra Part V.A.
318. Naresh, supra note 152, at 982 (citing Ooms & Frost, Incontestability, 14 LAW & CONTEMP. PROBS. 220, 223 (1949)). Naresh argues that such an idea “suggests that the considerations supporting incontestability are analogous to those permitting acquisition of title to real
justifications for the ability of real property owners to quiet title in their land, there are no convincing analogous rationales for allowing mark owners to use descriptive terms to hold a permanent advantage over their competitors. Granting descriptive marks incontestability is harmful from both a public domain and consumer benefit point of view: "[B]uyers experience greater difficulty and incur higher costs in obtaining the information necessary to make optimal purchasing decisions among similar products," as a result of only one producer having the right to use the descriptive mark on its product.

The Park 'N Fly majority held, however, that the statute not only provided for descriptive marks achieving incontestability, but "[T]he incontestability provisions would be utterly frustrated if the holder of an incontestable mark could not enjoin infringement by others so long as they established that the mark would not be registerable but for its incontestable status." While the intent of Congress is certainly due an appropriate level of deference, arguing that taking away the almost invincible shield of incontestability should not be done, even if the mark never should have reached the Principal Register, is an unusual way of making the case for incontestability for future marks.

The need of incontestability for descriptive marks is overstated and was likely granted to descriptive marks without foreseeing the possible damage it could cause. Section 1065 must be revised to prevent descriptive marks from achieving incontestability. If a challenger believes a mark holder has not achieved secondary meaning, the challenger should be allowed to take the mark holder to court. In the three situations presented above a challenger would have a 50/50 chance against EMI, would likely lose against Bancorp, and would face a factual question in Woodroast. In other words, the question should always be whether there is secondary meaning, not, how long has the mark been on the Principal Register?

property by some period of adverse possession. . . . Careful examination suggests that incontestability cannot be rationalized on this basis." Id. at 982.

319. See Smith v. Cretors, 164 N.W. 338, 340-41 (Iowa 1917) (citations omitted) "The object of a suit to quiet title is not merely to settle particular claims. Its very object is to determine all conflicting claims and to remove all clouds from the title of the complainant. . . . Its purpose is to put all litigation at rest as to the titles involved." Id (citations omitted).

320. Naresh, supra note 152, at 982.

321. Id. at 992.

322. Park 'N Fly, 469 U.S. at 198.

323. Id. at 202.

324. If secondary meaning can be demonstrated let the challenger bear the burden of the attorney's fees and face a stiff monetary penalty if a court finds the plaintiff brought a frivolous action. See also Naresh, supra note 152, at 992 (arguing a mark holder's incontestability rights should always be able to be "challenged on the ground that the mark is not currently distinctive").
CONTESTING THE INCONTESTABLE

C. Disallow the Use of® for Marks on the Supplemental Register

The ability of a mark holder to use the ® symbol for a mark on the Supplemental Register is not only anti-competitive,325 but it also perpetuates a disincentive to create more distinct marks. If mark holders were prevented from using the symbol, they would be unable (or certainly unwilling) to warehouse marks on the Supplemental Register because there would be a greater chance that a competitor seeing the mark in commerce without the ® would think the mark was available. Thus, stripped of the crutch of undeserved protection on the Supplemental Register, all mark holders would have an incentive to create secondary meaning in their descriptive marks immediately, which is also a public good. Furthermore, this need to rush to achieve secondary meaning would encourage the use of more non-descriptive marks thus benefiting competition, another public good.326

Changing this provision of the Lanham Act is not an idea that originates here. Professor McCarthy reports that the Trademark Review Commission in 1987 "considered but rejected a proposal for a different type of notice for Supplemental Register marks," because of a concern that the change would "conceal information from the public."327 As the intervening years have shown, such a change would result in the exact opposite of the Commission’s fear; it would make clear to the public that the term was not a mark but simply a term that had been applied for that was capable of becoming a mark. As one commentator has noted, the ability to use the symbol "to notify others of the registration . . . discourage[s] use of the descriptive term claimed as a trademark."328 The only beneficiaries of allowing the use of the symbol are those companies that can afford to be unable to acquire distinctiveness in a mark, or can risk having the mark declared generic.

D. Eliminate the ITU Exception for Descriptive Marks

Currently, an exception exists by which descriptive marks can use ITU applications in order to reach the Principal Register without having to establish secondary meaning.329 As demonstrated by the 1-888-MATTRESS decision,330 this exception allows large mark holders to transfer their goodwill from one mark being used on a product to a slightly different mark not yet used on a product in commerce,

325. See supra Parts II.E & IV.B.
326. Moreover, if the ability to use the symbol were restricted to only those marks on the Principal Register, there might even be less of a need for the Supplemental Register which could lower administrative costs for PTO. See also supra note 287, and accompanying text (discussing why the use of more suggestive, arbitrary and fanciful marks would be a positive occurrence).
327. MCCARTHY, supra note 18, § 19:37 n.11 (citation omitted).
328. Ramsey, supra note 182, at 1117-18 (citations omitted).
329. See supra notes 89 & 257 and accompanying text.
330. See supra notes 257-60 and accompanying text.
and submit an ITU application. This exception can result in warehousing as well as descriptive marks reaching incontestable status. Wisely, Congress has not allowed ITU applications for descriptive marks.\textsuperscript{331} The proposal here simply encourages that the original intent of Congress be upheld.

E. Uphold the Concurrent Use Doctrine & Deny Priority for Descriptive Marks

Marks on the Supplemental Register must not be able to use their registration as a bar against other marks. The holding of \textit{Clorox}\textsuperscript{332} essentially allows the Supplemental Register to act as a launching pad for the first registrant of a descriptive mark and an obstacle course for all second comers.\textsuperscript{333} Yet, the first registrant of a descriptive mark has not demonstrated any acquired distinctiveness in her mark. The first registrant has, in fact, done little more than pay a few hundred dollars and demonstrated that his mark is not generic.\textsuperscript{334} Therefore, this article proposes that until a mark demonstrates secondary meaning, and legitimately moves to the Principal Register, it should not have any priority over another descriptive mark, even a substantially identical one.\textsuperscript{335} In other words, this portion of the \textit{Clorox} holding should be reversed.

The current PTO interpretation allows for marks that may cause confusion to other marks on the Supplemental Register to be prevented from receiving the protection of the Supplemental or the Principal Register, even if other users are concurrent users. Instead of allowing the market to compete in order to bring source identification to the public, the policy almost encourages warehousing descriptive marks. Allowing this practice almost endorses a complete overturning of the \textit{Dawn Donuts} concurrent use doctrine.\textsuperscript{336} As much as it is anti-competitive to allow descriptive marks that have not demonstrated secondary meaning to reach incontestability, a reversal of the concurrent use doctrine would allow the first registrant, not the most successful user, to monopolize a descriptive mark. Descriptive marks may not be registered via an ITU application, and, accordingly, the Supplemental Register should not be allowed to serve as a supplemental ITU application. If, in good faith, a competitor can demonstrate that it was simultaneously using the same or a substantially similar mark as a registrant on the Supplemental

\begin{itemize}
  \item \textsuperscript{331} 15 U.S.C. § 1091(a) (2005).
  \item \textsuperscript{332} \textit{In re Clorox}, Co., 578 F.2d 305 (C.C.P.A. 1978). \textit{See supra} note 114 and accompanying text.
  \item \textsuperscript{333} \textit{See supra} note 114 and accompanying text.
  \item \textsuperscript{335} \textit{See} MCCARTHY, \textit{supra} note 18, § 19:37 (noting the PTO application of this policy appears to focus most on those marks that are substantially identical).
  \item \textsuperscript{336} \textit{See supra} Part IV.E.
\end{itemize}
Register, (and can show acquired distinctiveness) that junior user should have the
same ability to apply for registration on the Principal Register.337

VII. CONCLUSION

In conclusion, beyond the anti-competitive concerns engendered by the current
protection scheme, there are simple issues of coexistence in our modern society
implicated by the over protection of these terms:

Lacking direct, telepathic contact, we must address one another using, not only
the resource of a common language and vocabulary, but, in a larger sense,
whatever images and catch-phrases there are in the world, to provide points of
mutual understanding and orientation, and to give as much color and richness as
possible to our cultural moves and counter-moves.338

Waldon’s argument effectively makes the case for preventing descriptive words
and terms from being withdrawn from the linguistic commons without good cause.
Furthermore, the above sections establish the multitude of means by which protecting
descriptive marks in their current fashion is anti-competitive. There is yet another
important reason for limiting the protection of these marks: the promotion of more
creative, more imaginative marks by which our producers may distinguish their
goods. As one scholar has suggested in her study of the history of the British
trademark system: “The aim was to foster the generation of ideal trade marks, words
or phrases whose creativity was sufficient to take them out of the common pool and
avoid any risk of destruction of the natural language.”339

Trademark law should once again reach for this ideal. Furthermore, the evidence
that descriptive marks are not needed for success today is all around us; some of the
newest and most well known marks of the Twenty First century are non-
descriptive.340 In sum, descriptive terms should be allowed to be used by all for their
natural purpose—to describe. If a producer can demonstrate that it has tied that mark
distinctively to its product, no one will object to granting that producer protection.

337. But see Books on Tape, Inc. v. Booktape Corp., 836 F.2d 519, 520 (Fed. Cir. 1987)
(“The statute does not require the anomalous result that a junior user is entitled to keep its
Supplemental Registration for a descriptive term in which it has not established secondary meaning
(as evidenced by registration on the Supplemental Register) because a prior user cannot show
secondary meaning in that term either.”). See McCarthy, supra note 18, at § 19:37 (noting this
observation was dicta).
338. Waldron, supra note 153, at 885-86.
340. See supra note 270 and accompanying text discussing Google. See also John Leo,
Googling the Future, U.S. NEWS & WORLD REPORT, May 16, 2005, at 60 (“Google and Yahoo! will
take in as much ad money this year as the prime-time revenues of the three major networks
combined.”).
Yet the producer should have to *earn* that protection and be able to defend its alleged connection to the mark, over and over again.