



9-1-2011

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Jeanne C. Fromer, *The Role of Creativity in Trademark Law*, 86 Notre Dame L. Rev. 1885 (2011).

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THE ROLE OF CREATIVITY IN TRADEMARK LAW

Jeanne C. Fromer*

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INTRODUCTION

From her outré fashion—such as a dress of bubbles and a lobster headpiece¹—to her music, Lady Gaga is frequently touted as a creative force in contemporary pop culture.² Just who created her moniker, however, is the centerpiece of a 2010 lawsuit filed against her

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* Associate Professor, Fordham Law School. I thank Arnaud Ajdler, Barton Beebe, Christopher Buccafusco, Wendy Gordon, Sonia Katyal, Mark McKenna, and Rebecca Tushnet, as well as participants in this *Notre Dame Law Review* symposium on “Creativity and the Law,” for distinctive comments and suggestions.

1 See Triveni Bakshi, *Whackiest Lady Gaga Costumes*, STYLEGURU (Aug. 18, 2010), <http://www.styleguru.com/entry/whackiest-lady-gaga-costumes> (displaying many of Lady Gaga’s outfits).

2 See, e.g., Chuck Eddy, *Myth No. 3: Lady Gaga Is All Style, No Substance*, SPIN (Nov. 9, 2009, 4:53 PM), <http://www.spin.com/articles/myth-no-3-lady-gaga-all-style-no-substance>; Daniel Kreps, “Alejandro” Director Breaks Down Lady Gaga’s *Racy* Video, ROLLING STONE (June 8, 2010, 1:30 PM), <http://www.rollingstone.com/music/news/17386/111856>. Adulation of Lady Gaga is far from universal. See, e.g., Camille Paglia, *Lady Gaga and the Death of Sex*, SUNDAY TIMES MAG. (Sept. 12, 2010), <http://www.thesundaytimes.co.uk/sto/public/magazine/article389697.ece> (deriding Lady Gaga as an “asexual copycat” of Madonna and others); Kelsey Paine, *Hot Beef: M.I.A. Disses Lady Gaga*, SPIN (Apr. 8, 2010, 11:12 AM), <http://www.spin.com/articles/hot-beef-mia-disses-lady-gaga> (quoting musician M.I.A. as deriding Lady Gaga’s music for not being creative or progressive).

(which has since settled on confidential terms).³ Her ex-boyfriend and music producer Rob Fusari sued her to recover a percentage of her revenues, alleging a breach of contract pursuant to which Fusari had helped Lady Gaga craft some of the songs on her debut album and introduced her to key music executives.⁴ Particularly interesting is the tale Fusari tells in his complaint to build his case. A significant part of his claim rests on the allegation that he created the “Lady Gaga” name. According to Fusari, he crafted the name when he sent Stefani Germanotta (Lady Gaga’s birth name)⁵ a text message from his cell phone containing the Queen song title, “Radio Ga Ga,” which his phone’s spell checking program changed to “Lady Gaga.”⁶ According to Fusari, “Germanotta loved it and ‘Lady Gaga’ was born.”⁷ Lady Gaga sings a different tune. As she tells it, she came up with the name following Fusari’s repeated singing to her of “Radio Ga Ga” as a joke, due to some Queen-like harmonies in her recordings.⁸

From the vantage point of trademark law, this dispute is fascinating. The disagreement centers on who originated Lady Gaga’s brand name: surely a bona fide trademark for her musical services, products, and the like.⁹ Nonetheless, nowhere to be found in Fusari’s complaint or Lady Gaga’s subsequent counter-complaint is any claim that Fusari is the proper owner of the “Lady Gaga” trademark.¹⁰

This Article situates this lawsuit in trademark law by exploring the role of creativity in trademark law. Trademark law—unlike patent and copyright law, its intellectual property cousins—is not structured

3 See Caroline Black, *Lady Gaga, Ex Rob Fusari Make Legal Peace; Multi-Million \$ Lawsuits Dropped*, CBS NEWS (Sept. 13, 2010, 1:21 PM), http://www.cbsnews.com/8301-504083_162-20016216-504083.html.

4 See Daniel Kreps, *Lady Gaga Sued for \$30 Million by Producer/Ex-Boyfriend Rob Fusari*, ROLLING STONE (Mar. 19, 2010, 9:07 AM), <http://www.rollingstone.com/music/news/13316/67321>.

5 Brad Larosa, *How Stefani Germanotta Became Lady Gaga*, ABC NEWS (Jan. 21, 2010), <http://abcnews.go.com/2020/lady-gaga-tells-barbara-walters-felt-freak/story?id=9612835>.

6 Kreps, *supra* note 4.

7 *Id.*

8 See Brian Hiatt, *Lady Gaga: New York Doll*, ROLLING STONE, June 11, 2009, at 56, 58.

9 See LADY GAGA, Registration No. 3,695,038; LADY GAGA, Registration No. 3,695,129.

10 See Christopher John Farley, *Lady Gaga Vs. Rob Fusari: Inside Her Countersuit*, WALL ST. J. SPEAKEASY (Mar. 22, 2010, 5:00 PM), <http://blogs.wsj.com/speakeasy/2010/03/22/lady-gaga-vs-rob-fusari-inside-her-countersuit>.

to reward creators for producing particular content.¹¹ That is unsurprising because trademark law and theory—as described in Part I—is significantly different than that of patent and copyright. As the Supreme Court recently remarked, trademark law was “not designed to protect originality or creativity,” while patent and copyright law were.¹² Nonetheless, as Part II analyzes, there are critical ways in which trademark law, like patent and copyright law, seeks to encourage creative activity, even without directly rewarding marks’ creators. This underappreciated current of incentive to be creative courses through trademark law in ways that complement trademark law’s basic purposes. At the same time, however, trademark law’s drive to reward creativity has also likely helped justify its expansion in ways unmoored from core trademark theory.

I. TRADEMARK LAW

As a springboard for analysis of the role of creativity in trademark law, this Part recounts fundamental aspects of trademark law, starting with its current implementation and followed by a discussion of the principles understood to be animating the law.

A. Implementation

Words, symbols, logos, and sometimes a product’s design or packaging may be protected under trademark law.¹³ According to the Lanham Act, these are protectable under federal law so long as they are “used by a person” in commerce in a distinctive way “to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods, even if that source is

11 See generally Jeanne C. Fromer, *A Psychology of Intellectual Property*, 104 Nw. U. L. Rev. 1441 (2010) (exploring the central role of creativity in patent and copyright law).

12 *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37 (2003) (emphasis omitted).

13 See 15 U.S.C. § 1127 (2006) (defining trademarks to include certain “word[s], name[s], symbol[s], or device[s], or any combination thereof”); *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 209–16 (2000) (holding that product design or packaging might constitute a protectable trademark). Also potentially protectable are sounds, scents, and colors. See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162, 174 (1995). Although much of what I discuss in this Article applies to trade dress—a product’s design or packaging—I focus explicitly on words, symbols, and logos. Moreover, state laws frequently protect trademarks as well, see, e.g., Joe Cole, *Trademark Terms Under the Lanham Act and State Law*, 19 J. CONTEMP. LEGAL ISSUES 70, 70–72 (2010), but I do not discuss that avenue of protection herein.

unknown.”¹⁴ Federal law similarly protects marks that designate services.¹⁵

There are two ways in which a mark can qualify as distinctive. First, certain marks are inherently distinctive, in that at the moment of first use in conjunction with a good or service, they are already capable of identifying a unique source of that good or service.¹⁶ Marks are considered to be inherently distinctive if they are arbitrary, fanciful, or suggestive.¹⁷ As the Fifth Circuit explained, “[a]rbitrary or fanciful terms bear no relationship to the products or services to which they are applied.”¹⁸ While fanciful terms—like “Kodak” for photographic goods—are new coinages, arbitrary terms—such as “Apple” for computers—are not.¹⁹ A suggestive mark, such as “Polar” to signify air conditioners, “requires imagination, thought and perception to reach a conclusion as to the nature of goods.”²⁰ Although one of its senses connotes coldness, it is not a mere description of air conditioners or one of their qualities.²¹

Alternatively, marks that are not inherently distinctive, but are descriptive of the particular good or service, can become distinctive if there is proof of secondary meaning.²² A descriptive term, such as “Vision Center” for a store offering eyeglasses, directly “‘identifies a characteristic or quality of an article or service,’ such as its color, odor, function, dimensions, or ingredients.”²³ Secondary meaning arises once “the primary significance of the term in the minds of the con-

14 15 U.S.C. § 1127. Likewise, under a more recent addition to the law, they are protectable if a person has a “bona fide intention to use [them] in commerce and applies to register [them] on the principal register established by [federal law].” *Id.*

15 *See id.*

16 *See* Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 671 (2004).

17 *See* *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 791 (5th Cir. 1983).

18 *Id.* (emphasis omitted).

19 *See* *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11 n.12 (2d Cir. 1976) (distinguishing arbitrary from fanciful marks).

20 *Id.* at 11 (quoting *Stix Prods., Inc. v. United Merchs. & Mfrs., Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968)).

21 A suggestive mark lies on the distinctiveness spectrum between descriptive on the one hand and arbitrary or fanciful on the other. *See id.*

22 *See* 15 U.S.C. § 1052(f) (2006); *Zatarains*, 698 F.2d at 790. Under the common law and until the Lanham Act’s enactment, descriptive marks were not protectable even in the presence of significant secondary meaning. *See Abercrombie & Fitch Co.*, 537 F.2d at 9.

23 *Zatarains*, 698 F.2d at 790 (quoting *Vision Ctr. v. Opticks, Inc.*, 596 F.2d 111, 115 (5th Cir. 1979) and citing *Am. Heritage Life Ins. Co. v. Heritage Life Ins. Co.*, 494 F.2d 3, 11 (5th Cir. 1974)); *accord Abercrombie & Fitch Co.*, 537 F.2d at 11.

suming public is not the product but the [particular] producer” of it.²⁴ When registering a mark, the Patent and Trademark Office (PTO) “may accept as prima facie evidence that the mark has become distinctive . . . proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.”²⁵

Terms that are (or become) generic—which can happen by “nam[ing] . . . a particular genus or class of which an individual article or service is but a member,”²⁶ such as “computer” as a mark for computers or “aspirin” for the pain relief medication—cannot receive trademark protection, even if secondary meaning is established.²⁷

Distinctive marks used in commerce are protectable, either via registration and enforcement,²⁸ or through a provision allowing enforcement of unregistered marks.²⁹ Federal law protects trademark registrants against another’s

use in commerce [of] any reproduction, counterfeit, copy, or colorable imitation of [their] registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive.³⁰

Unregistered marks are similarly protected.³¹ In judging the likelihood of consumer confusion between two marks, courts typically look to the following factors: the strength of the plaintiff’s mark, the proximity of the goods with which the marks are associated, the marks’ similarity, evidence of actual confusion, the marketing channels used with each mark, the type of goods at issue (including how much care a purchaser would typically use before buying), the defendant’s intent in using the mark, and the likelihood of expansion into other products.³²

24 *Zatarains*, 698 F.2d at 791 (quoting *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 118 (1938)).

25 15 U.S.C. § 1052(f).

26 *Zatarains*, 698 F.2d at 790 (quoting *Vision Ctr.*, 596 F.2d at 115).

27 *See id.* at 790–91.

28 *See* 15 U.S.C. §§ 1052, 1114.

29 *See id.* § 1125(a)(1).

30 *Id.* § 1114(1)(a).

31 *See id.* § 1125(a)(1).

32 *See* *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979). One court of appeals states that a defendant’s bad intent is principally irrelevant to trademark infringement. *See* *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 875 (2d Cir. 1986). Other appellate courts indicate that the intent factor is one of the most important. *E.g.*, *Amstar Corp. v. Domino’s Pizza, Inc.*, 615 F.2d 252, 263 (5th Cir. 1980). Empirical work by Barton Beebe suggests that “a finding of bad faith

Even though protection against infringement is provided whether or not the mark is registered, there are significant advantages to registration. If an entity succeeds in demonstrating to the PTO that a mark it uses is entitled to trademark registration (including that an identical or sufficiently similar mark is not already in use in a way that would confuse consumers),³³ that entity benefits in multiple ways. Among the advantages conferred are nationwide constructive use conferring priority over most users of the same or similar marks,³⁴ enhanced remedies in federal court,³⁵ and the possibility of the mark becoming incontestable in many ways after five years.³⁶ Conversely, there are disadvantages for the owner of an unregistered mark. For that owner, an infringement action might lie only if the unregistered user has priority, typically due to an allegedly infringing use in a geographic area where the marked products or services were already being sold or advertised or where the mark's reputation has been established.³⁷

With this primer on the contours of current trademark law, it is instructive to turn to the law's theoretical foundations.

B. Theory

Trademark law originated to protect indications of an article's source, but only in the strictest sense. As Beverly Pattishall explains of nineteenth-century trademark law, "Even though an article may have become well-known under an arbitrary mark, if that mark did not directly denote the article's source, another was free to use it."³⁸ This rule stemmed from two historical uses of marks: the proprietary mark affixed by owners so that they would be able to identify and retrieve their own goods after shipping,³⁹ and the regulatory production mark required by law or guilds to be affixed to certain goods so that defec-

intent creates, if not in doctrine, then at least in practice, a nearly un-rebuttable presumption of a likelihood of confusion." Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CALIF. L. REV. 1581, 1628 (2006).

33 See 15 U.S.C. § 1052(d) (describing the grounds on which marks can be refused registration).

34 See *id.* §§ 1057(c), 1072.

35 See *id.* § 1117(b).

36 See *id.* § 1065.

37 See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 30 cmt. a (1995).

38 Beverly W. Pattishall, *Two Hundred Years of American Trademark Law*, 68 TRADEMARK REP. 121, 128 (1978).

39 See Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 814 (1927); see also Sidney A. Diamond, *The Historical Development of Trademarks*, 65 TRADEMARK REP. 265, 270 (1975) (tracing the use of proprietary marks to before the Common Era).

tive or illegal work might be traced to the goods' originator for varied punishments.⁴⁰ Rights in these marks focused primarily on protecting producers from competitors' illegitimate interference with their trade rather than on the consumer.⁴¹

As suggested by current trademark law,⁴² the law has broadened beyond these narrow, early purposes. Trademark law came to emphasize protecting consumers from confusion to foster fair competition and to justify a more extensive right.⁴³ The increased production capacity for goods ushered in by the industrial revolution boosted instances of advertising to the public to distinguish between these goods, which popularized trademarks as identifiers of the source of goods.⁴⁴ As time marched on, consumers began to know less and less about the specific source of particular goods.⁴⁵ Nonetheless, a trademark affixed to goods would help consumers know that those goods originated from the same source, whatever that source was.⁴⁶ Relatedly, a trademark would distinguish a product from others with different marks.⁴⁷

Trademark theory also suggests that, despite no longer signifying a specific source, trademarks bolster trade by "identify[ing] a product as satisfactory and thereby . . . stimulat[ing] further purchases by the consuming public."⁴⁸ Scholars theorize that producers of trademarked goods will have the incentive to invest in the goods' quality.⁴⁹ They suggest that this investment ought to occur because consumers will likely use the trademark as a way to identify a desirable good only if their past experiences reliably forecast the good's worth.⁵⁰ Protect-

40 See Schechter, *supra* note 39, at 814.

41 See Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1841 (2007); Schechter, *supra* note 39, at 819. McKenna explains that judicial trademark decisions in this period sometimes focused on consumer deception because it indicated competitors' prohibited trade diversions. See McKenna, *supra*, at 1841.

42 See *supra* Part I.A.

43 See *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985); McKenna, *supra* note 41, at 1843. See generally Schechter, *supra* note 39, at 814–19 (tracing the development of trademark law from its original purposes to broadened modern aims).

44 See Diamond, *supra* note 39, at 280–81.

45 See Schechter, *supra* note 39, at 814–15.

46 See *id.* at 817.

47 See Beebe, *supra* note 16, at 677, 682.

48 Schechter, *supra* note 39, at 818.

49 E.g., William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 269–70 (1987).

50 See William M. Landes & Richard A. Posner, *The Economics of Trademark Law*, 78 TRADEMARK REP. 267, 271 (1988) ("[T]rademarks have a self-enforcing feature. They

ing against trademark infringement, from this vantage point, thus prevents others from trading on the goodwill that is represented by the trademark.⁵¹ Producers might then leverage the goodwill engendered by consumers' association of a particular mark for their goods or services with positive value and meaning by using the mark for an ever wider range of products and services.⁵²

In all of these ways, trademarks reduce consumers' search costs—the expenditures they must make to discern important qualities of goods or services, which are frequently hard to measure.⁵³ Trademarks, then, ought to promote trade and enable consumer decision-making. Therefore, trademark protection guards against use of a too similar mark that causes consumer confusion as to goods' or services' origin.⁵⁴

Rochelle Dreyfuss observes that, in recent years, trademarks have begun to serve an additional purpose, of “becom[ing] products in their own right, valued as indicators of the status, preferences, and aspirations of those who use them.”⁵⁵ To take one heavily litigated

are valuable because they denote consistent quality, and a firm has an incentive to develop a trademark only if it is able to maintain consistent quality.”). There has been a good deal of debate among trademark scholars about whether the law ought to view the consumer as a free individual making a choice to pay more for intangible values conveyed through advertising or as a person to be protected from the irrational encouragement that advertising and trademarks provide, beyond the underlying goods' quality. See generally Ralph S. Brown, Jr., *Advertising and the Public Interest: Legal Protection of Trade Symbols*, 57 YALE L.J. 1165 (1948) (describing this debate).

51 See Robert G. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86 B.U. L. REV. 547, 549 (2006).

52 See McKenna, *supra* note 41, at 1843.

53 See Beebe, *supra* note 16, at 623.

54 See Graeme B. Dinwoodie, *The Death of Ontology: A Teleological Approach to Trademark Law*, 84 IOWA L. REV. 611, 614 (1999).

55 Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 397 (1990); accord Beebe, *supra* note 16, at 624, 656; Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 961 (1993). Jessica Litman goes one step further, positing that some products, like promotional materials, are created in the first place to advance a trademark. See Jessica Litman, *Breakfast with Batman: The Public Interest in the Advertising Age*, 108 YALE L.J. 1717, 1726 (1999) (“The use of trademarks on promotional products has evolved from an advertising device for the underlying product line to an independent justification for bringing a so-called underlying product to market. . . . The worth of such valuable trade symbols [like Batman] lies less in their designation of product source than in their power to imbue a product line with desirable atmospherics.”). More extreme yet is the practice Barton Beebe notes of “floating signifiers” (for example, the Hello Kitty trademark in Japan) that refer to nothing other than their own relative distinction from other such signifiers.” Barton Beebe, *Intellectual Property Law and the Sumptuary Code*, 123 HARV. L. REV. 809, 884 (2010) (footnotes omitted).

instance, a band sings a song entitled *Barbie Girl* to offer commentary on the values a Barbie doll represents: “I’m a blond bimbo girl, in a fantasy world/Dress me up, make it tight, I’m your dolly.”⁵⁶ As Judge Kozinski puts it:

Some trademarks enter our public discourse and become an integral part of our vocabulary. How else do you say that something’s “the Rolls Royce of its class”? What else is a quick fix, but a Band-Aid? Does the average consumer know to ask for aspirin as “acetyl salicylic acid”? Trademarks often fill in gaps in our vocabulary and add a contemporary flavor to our expressions. Once imbued with such expressive value, the trademark becomes a word in our language and assumes a role outside the bounds of trademark law.⁵⁷

In light of this shift in the use of trademarks, scholars suggest circumscribing trademark law’s reach to prevent it from reaching communicative uses, which enrich society’s conversations.⁵⁸

In sum, these theories show that trademarks are useful in more expansive ways than in their earliest incarnations, to lower consumer search costs, encourage quality in the underlying goods or services, foster trade, and as status and communicative indicators. I now turn to the more specific question of the role of creativity in trademark law.

II. THE CREATOR AND CREATIVITY

Most people take it as a given that patent and copyright law—trademark’s cousins—have the encouragement of creative activity as a central motivator of their laws.⁵⁹ That much seems to follow from the Constitution, which seeks to “promote the Progress of Science and useful Arts” by providing Congress with the power to “secur[e] for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”⁶⁰

56 *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 901 (9th Cir. 2002) (quoting Aqua’s song, “Barbie Girl”).

57 *Id.* at 900 (citation omitted).

58 See Dreyfuss, *supra* note 55, at 418 (“If the mark is found to be rhetorically unique within its context, it would be considered expressively—but not necessarily competitively—generic, and the trademark owner would not be permitted to suppress its utilization in that context.”); Kozinski, *supra* note 55, at 962–63 (“When trademarks are used in this way, they acquire certain functional characteristics that are different from—and sometimes inconsistent with—their traditional role as identifiers of source. . . . This trend raises questions about whether—and to what extent—the law should protect trademarks when they are pressed into service as separate products.”).

59 See, e.g., *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37 (2003); Fromer, *supra* note 11, at 1457–59.

60 U.S. CONST. art. I, § 8, cl. 8.

Yet trademark law, which falls with patent and copyright law under the rubric of intellectual property,⁶¹ has been treated differently. In 1879, the Supreme Court ruled that Congress could not enact a trademark law under the same constitutional power as for patent and copyright law, suggesting instead that any federal trademark law would have to be passed under the power of the Commerce Clause.⁶² The Supreme Court, in that decision, reasoned that “[t]he ordinary trade-mark has no necessary relation to invention or discovery,” especially because it need not be original.⁶³ Instead, the Supreme Court reasoned, “The trade-mark may be, and generally is, the adoption of something already in existence as the distinctive symbol of the party using it.”⁶⁴

This Part explores whether these differences between trademark law on the one hand and patent and copyright law on the other hand are as vast as suggested by this ruling and the subsequent reenactment of federal trademark laws under the Commerce Clause. In particular, it focuses on the role of creativity in trademark law, arguing that it is more central to this body of law than has been commonly appreciated. While subpart A addresses trademark law’s lack of concern with a mark’s creator, subpart B discusses how creativity is nonetheless encouraged in significant ways in trademark law. Subpart B concludes by showing that this encouragement is central to trademark theory, but it has likely helped drive the expansion of trademark protection in recent years in ways only weakly connected to trademark law’s fundamental goals.

A. *The Mark’s Creator*

This subpart demonstrates a significant way in which trademark law differs from patent and copyright law in terms of rewarding creativity. As discussed herein, with limited exception, patent and copyright law each grants rights directly to the creator of the content it protects. By contrast, trademark law awards rights to the first entity to

61 See Sonia K. Katyal, *Trademark Intersectionality*, 57 UCLA L. REV. 1601, 1602 (2010) (grouping the three). Although trademark law is grounded in different theory than are copyright and patent laws, see *supra* Part I.B, they have been grouped together in the field of intellectual property, see BRAD SHERMAN & LIONEL BENTLY, *THE MAKING OF MODERN INTELLECTUAL PROPERTY LAW* 168 (1999). There are a number of reasons for this grouping, principally “shared professional bodies (patents and trade mark agents), the nature and form of international treaties, . . . the logic of industrial property,” and “similar subject matter.” *Id.* at 169 (footnotes omitted).

62 See Trade-Mark Cases, 100 U.S. 82, 92–97 (1879).

63 *Id.* at 94.

64 *Id.*

use a mark in commerce distinctively for goods or services. Trademark law does not aim to reward originators of marks; rather, it seeks to reward originators of using marks to signify particular goods or services (and, sometimes concomitantly, their source).

Patent and copyright laws dwell on reward to the creator of a work within their respective purviews. So long as an invention meets various patentability criteria, such as novelty, nonobviousness, and utility, patent law authorizes the award of a utility patent to the invention's inventor or discoverer.⁶⁵ Patent law does not authorize (or require) the patent holder to make or commercialize the invention; instead, the patent right provides only the power to exclude others from making and using the invention.⁶⁶ Similarly, copyright law awards protection to an original work's author.⁶⁷ Although the work must be "fixed in any tangible medium of expression" to be protectable,⁶⁸ it need not be published or otherwise commercialized to be copyrightable.⁶⁹ Copyright law does not always reward the creator of a work of authorship. It vests copyright in works made for hire—principally "work[s] prepared by an employee within the scope of his or her employment" and certain commissioned works⁷⁰—in the employer, labeling the employer as the work's author.⁷¹ But even in this exceptional situation, copyright law treats the employer as the work's author, transforming the employer constructively into a creator of sorts.⁷² All in all, then, patent and copyright laws directly reward works' creators and do not require these works to be used publicly.

Trademark law takes a different approach. As addressed in the previous section, trademark law historically focused on rights for

65 See 35 U.S.C. §§ 101–103 (2006).

66 See *id.* § 154(a). In a recent article, Ted Sichelman proposes that rights ought to be awarded to those who commercialize patented inventions. Ted Sichelman, *Commercializing Patents*, 62 STAN. L. REV. 341 (2010) (proposing a new "commercialization" patent for those willing to make and sell their product); cf. Oren Bar-Gill & Gideon Parchomovsky, *A Marketplace for Ideas?*, 84 TEX. L. REV. 395, 398–99 (2005) (suggesting that limited rights might be granted in ideas to separate that function from development and commercialization of patented inventions).

67 See 17 U.S.C. §§ 102, 201(a) (2006).

68 See *id.* § 102(a).

69 See generally R. Anthony Reese, *Public but Private: Copyright's New Unpublished Public Domain*, 85 TEX. L. REV. 585 (2007) (discussing the effects of a change to copyright law, which before 1976 had protected works only once they were published).

70 17 U.S.C. § 101.

71 See *id.* § 201(b). For a discussion of the sensibility of treating works made for hire differently and an analysis of the differing structures of copyright duration for works made for hire and other works, see Jeanne C. Fromer, *Expressive Incentives in Intellectual Property*, 98 VA. L. REV. (forthcoming 2012).

72 See *id.* (discussing why the law might have labeled the employer as an author).

those using a mark to indicate an article's source.⁷³ It is therefore unsurprising that trademark law did not develop with any solicitude for trademark creators in and of themselves, as there was no requirement that it be the creator of a mark—rather than someone else—that uses it to indicate a good's source.⁷⁴ In fact, the Supreme Court has said that “[t]here is no property in a trade-mark apart from the business or trade in connection with which it is employed.”⁷⁵ Commentators, stretching back to at least the nineteenth century, make much the same point.⁷⁶ Mark creation has no legal cognizance in trademark law.⁷⁷ Rather, it is the use of the mark with goods or services in a way that establishes a link between the two that matters.⁷⁸

73 See *supra* text accompanying note 38.

74 Cf. SHERMAN & BENTLY, *supra* note 61, at 171 (“[W]hereas copyright, patents and designs were primarily concerned with the creation and protection of property, trade marks were more concerned with forgery or fraud.”).

75 *Am. Steel Foundries v. Robertson*, 269 U.S. 372, 380 (1926).

76 See FRANCIS H. UPTON, A TREATISE ON THE LAW OF TRADE MARKS, WITH A DIGEST AND REVIEW OF THE ENGLISH AND AMERICAN AUTHORITIES 22 (1860) (indicating that trademark protection “is not the abstract right to the exclusive use of a certain name, letters, mark, device or symbols, which can be acquired and possessed”). *But cf.* Stephen L. Carter, *Does It Matter Whether Intellectual Property Is Property?*, 68 CHI.-KENT L. REV. 715, 720 (1993) (“Certainly, one may conceptualize trademarks as property in the Lockean sense, in the same way that one may conceptualize copyrights and patents in that way: they protect the creator’s right to the intellectual products of the mind. Put otherwise, the bare fact that the creator has brought the *res* into existence is the reason for its protection.”).

77 See, e.g., *Arvelo v. Am. Int’l Ins. Co.*, 875 F. Supp. 95, 101 (D.P.R. 1995) (“Rights in a trademark . . . cannot be obtained through discovery or invention alone. Some actual use of the trademark, such as affixing a label to a good which is sold in commerce, is necessary to establish use. Neither conception of an idea for a mark, nor solicitation of advertising business constitute use of the trademark sufficient to acquire proprietary rights in the mark.” (citation omitted)); Graeme B. Dinwoodie & Mark D. Janis, *Confusion over Use: Contextualism in Trademark Law*, 92 IOWA L. REV. 1597, 1610 (2007) (“[A] firm must use a mark (not merely conceive of it) in order to assert rights”); cf. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 32 (2003) (“[A]s used in the Lanham Act, the phrase ‘origin of goods’ is . . . incapable of connoting the person or entity that originated the ideas or communications that ‘goods’ embody or contain.”); Keith Aoki, *Authors, Inventors and Trademark Owners: Private Intellectual Property and the Public Domain, Part II*, 18 COLUM.-VLA J.L. & ARTS 191, 242 (1994) (“[T]raditionally there has been no authorial, inventive figure in trademark to justify the grant of intellectual property rights”).

78 See *Trade-Mark Cases*, 100 U.S. 82, 94 (1879); *Am. Express Co. v. Goetz*, 515 F.3d 156, 159 (2d Cir. 2008) (per curiam) (“[A] mark that does not perform the role of identifying a source is not a trademark.”); Carter, *supra* note 76, at 720 (“At common law and, for the most part, in federal statutory trademark law as well, rights in a mark are said to flow from its use, not from its existence.”).

A corollary of this fundamental tenet of trademark law is trademark's common-law priority system. According to priority rules, "a trademark or tradename is only coextensive with its use and may be used by different firms in different localities."⁷⁹ That is, even the entity that has used a particular mark in conjunction with goods or services in one location frequently cannot claim ownership of it in another location. The reasons for this rule seem to be precisely that the entity that used the mark in one locale has not established a link between the mark and its goods or services in another locale. Just because an entity has created a mark makes no difference in trademark's common law where the mark has not been used.

A stronger focus on marks' creators is too much of a hard sell in trademark law. Not only does it seem to be out of step with trademark law's central purpose of use in commerce to distinguish one's goods or services, but also many marks are not new to the world when applied to particular goods or services.⁸⁰ Of course, some marks will be fanciful, and thus entirely new.⁸¹ Many, however, will not be, nor do they need to be to distinguish the goods and services they signify.⁸²

It was the rare moment when the creator's role in crafting a mark was even acknowledged. As one of a handful of examples, in 1878, while discussing how "[t]he basis of a trade mark right is primarily the encouragement of trade," a federal court stated that "[a] trade mark has been very well defined as one's commercial signature to his goods,"⁸³ perhaps acknowledging a trademark's reflection of the creator's personality.⁸⁴

In fact, this lack of appreciation of the creator might stem from, or at least parallel, the Supreme Court's 1879 ruling invalidating the first federal trademark law, as beyond Congress's powers under the

79 Schechter, *supra* note 39, at 824; accord Mark P. McKenna, *Trademark Use and the Problem of Source*, 2009 U. ILL. L. REV. 773, 779; *supra* text accompanying note 37.

80 See SHERMAN & BENTLY, *supra* note 61, at 170–71; Mark A. Lemley & Mark P. McKenna, *Owning Mark(et)s*, 109 MICH. L. REV. 137, 167 (2010).

81 See *supra* text accompanying notes 18–19.

82 See *infra* Part II.B (discussing how trademark law, nonetheless, provides the incentive to be creative in choosing a mark).

83 *Leidersdorf v. Flint*, 15 F. Cas. 260, 261 (C.C.E.D. Wis. 1878) (No. 8,219).

84 Cf. 1 WILLIAM BLACKSTONE, COMMENTARIES *754 n.1 (noting a view that trademark "is somewhat analogous to literary copyright, and though partially founded on the notion of protecting the public from fraud, is an example of a right much more evidently arising out of occupancy"); SHERMAN & BENTLY, *supra* note 61, at 168–69 (discussing an 1862 report to the British government that insinuated that "a trade mark, like a work subject to copyright and design right, embodied the personality of its creator").

Constitution's Intellectual Property Clause.⁸⁵ The focus in that Clause is on rewarding "Authors and Inventors" for "their respective Writings and Discoveries."⁸⁶ Following this decision and the subsequent re-enactment of a trademark law under Congress's Commerce Clause authority, any emphasis on the mark's creator might seem like an unseemly link back in trademark law to the forbidden Intellectual Property Clause.

Despite the lack of focus on trademark rights for a mark's creator, the Lanham Act appears to draw attention to it in stating who may apply to register a trademark. The Act specifies that "[t]he owner of a trademark used in commerce may request registration of its trademark."⁸⁷ In addition to specifying the applicant's first use of the mark in commerce, an applicant seeking to register a mark must verify that he or she owns the mark.⁸⁸ In so doing, the statute separates the requirement of use in commerce from a mark's ownership. Although the provision does not define ownership, its intuitive understanding might seem connected to mark creation.

Nonetheless, it does not seem that the ownership requirement is understood to refer to the mark's creator. Commentators and courts dismiss the salience of ownership as a separate requirement, emphasizing that the first user of a mark to distinguish goods' or services' sources is the mark's owner.⁸⁹ The PTO, in its *Trademark Manual of Examining Procedure*, states that "[n]ormally the owner of a mark is the person who applies the mark to goods that he or she produces, or uses the mark in the sale or advertising of services that he or she performs."⁹⁰ Despite its intimation that there are exceptions to this gen-

85 See Trade-Mark Cases, 100 U.S. 82, 92–99 (1879).

86 U.S. CONST. art. I, § 8, cl. 8.

87 15 U.S.C. § 1051(a)(1) (2006).

88 See *id.* § 1051(a)(2)–(3).

89 See, e.g., *Blue Bell, Inc. v. Farah Mfg. Co.*, 508 F.2d 1260, 1264–65 (5th Cir. 1975) ("Ownership of a mark requires a combination of both appropriation and use in trade."); 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 16:35 (4th ed. 2010) ("Trademark ownership inures to the legal entity who is in fact using the mark as a symbol of origin."); *id.* § 16:36 ("Where an individual adopts and uses a mark and later orally licenses its use to a corporation of which he or she is the president, the individual, not the corporation, is the owner of the mark and the proper party to apply for registration." (citing *In re Briggs*, 229 U.S.P.Q. (BNA) 76 (T.T.A.B. 1986))); cf. *Intrawest Fin. Corp. v. W. Nat'l Bank of Denver*, 610 F. Supp. 950, 956 (D. Colo. 1985) ("[A] trademark has no existence apart from the good will of the product or service it symbolizes.").

90 PATENT & TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 803.01 (7th ed. 2010) [hereinafter TRADEMARK MANUAL]; cf. *In re Admark, Inc.*, 214 U.S.P.Q. (BNA) 302, 303 (T.T.A.B. 1982) ("[T]he mark or slogan that is the focus of

eral rule, the manual does not give any hint as to when the owner is someone else.⁹¹ Tom McCarthy cites case law to conclude that

Ownership as between employer and employee will depend upon who first used the term as a mark and who the mark identifies. If an employee designs a mark in the course of employment and the employer uses it, it would seem clear that the employer is the 'owner' of the mark.⁹²

Moreover, excepting certain atypical situations,⁹³ advertising agencies hold no trademark rights in the brands they originate for clients because they do not use the mark to signify goods or services.⁹⁴ In discussing this issue recently, the Second Circuit stated that this sort of mark has two roles: "[T]he slogan is part of the advertising agency's creative work, but it may become a source identifier when used by the client."⁹⁵ As Judge Friendly once noted, "the right to exclusive use of a trademark derives from its appropriation and subsequent use in the marketplace."⁹⁶ At worst, by construing ownership to mean first use in commerce, this provision places us in the absurd position of interpreting the ownership language as a nullity as a matter of statutory construction.⁹⁷ At best, the language is a convoluted and awkward way

an advertising campaign for a client's goods or services cannot be said to function as a service mark for the licensor's—applicant's—advertising agency services.").

91 See TRADEMARK MANUAL, *supra* note 90, § 1201 (discussing ownership in terms of a mark's use).

92 2 McCARTHY, *supra* note 89, § 16:36 (citing *Scranton Plastic Laminating, Inc. v. Mason*, 187 U.S.P.Q. (BNA) 335 (T.T.A.B. 1975)).

93 See, e.g., *In re Adver. & Mktg. Dev., Inc.*, 821 F.2d 614, 621 (Fed. Cir. 1987) (holding that an advertising agency that originated a mark for banks to signify their financial services might have trademark rights in it, given that it was using the mark to signify the sales promotion services it was selling to banks).

94 See *Am. Express Co. v. Goetz*, 515 F.3d 156, 159–60 (2d Cir. 2008) (*per curiam*); *Gordon Bennett & Assocs. v. Volkswagen of Am., Inc.*, 186 U.S.P.Q. (BNA) 271, 272–73 (N.D. Cal. 1975); 2 McCARTHY, *supra* note 89, § 16:39.

95 *Am. Express Co.*, 515 F.3d at 160.

96 *La Societe Anonyme des Parfums le Galion v. Jean Patou, Inc.*, 495 F.2d 1265, 1271 (2d Cir. 1974).

97 See WILLIAM D. POPKIN, A DICTIONARY OF STATUTORY INTERPRETATION 198 (2007) (describing the general rule that legislatures are not presumed to include superfluous language in statutes). This separate requirement of ownership seems not to be a nullity in a minute number of scenarios: when two entities that once used to work together and used a mark are now working separately and fighting over which one has true rights to the mark. As a practical matter, this issue tends to come up with regard to ownership of a mark in a musical group (such as when the members shift) and in a manufacturer-distributor relationship. See 2 McCARTHY, *supra* note 89, § 16:44–45; Pamela S. Chestek, *Who Owns the Mark? A Single Framework for Resolving Trademark Ownership Disputes*, 96 TRADEMARK REP. 681, 682–83 (2006); *infra* note 98. McCarthy notes that in deciding who among multiple contenders owns a trademark,

for Congress to indicate that there must be a connection between the mark—possibly through use that might not be in interstate commerce—and the entity that used it.

As a policy matter, this construction—as well as the elevation over creation of use of a mark to signify goods or services in a distinctive way—seems to have two justifications. First, there is the importance of using a mark as a signifier of source. If a mark's originator is not using it as such, that person ought not to receive trademark rights because he or she is not directly promoting the purposes of trademark law, at least as the mark's user is. Second, there is significant value in having there be only one entity with rights to a trademark. If the basic purpose of a trademark is to identify and distinguish a seller's products or services, granting rights in multiple entities—here, a mark's creator and a separate user of the mark—would seem to undermine trademark law's purposes of signaling a single source to consumers and reducing consumers' search costs.⁹⁸ Furthermore, awarding the right to a mark's user rather than its separate creator falls better in line with these fundamental theories.⁹⁹

In spite of the foregoing analysis that trademark law overlooks marks' creators, there is nonetheless a strong emphasis in trademark law on rewarding creators. In a recent account of trademark law's foundations, Mark McKenna shows that the primary focus of trademark law has been to protect and promote the underlying business with which a mark is associated.¹⁰⁰ That is, trademark rights did not directly protect the word or symbol used as a mark; rather, “[p]roperty rights arose out of particular uses of words or symbols in

trademark law ought to balance two competing interests at stake in addressing joint ownership of trademarks: protection of consumers and contractual expectations when the parties agreed to joint trademark ownership. See 2 McCARTHY, *supra* note 89, § 16:40. For an attempt to offer a unified framework for resolving trademark ownership, see Chestek, *supra*, at 698–723.

98 See 2 McCARTHY, *supra* note 89, § 16:40. Surely there will be many times in which a mark's creator is distinct from its user in commerce. Frequently enough, as with branding or advertising agencies creating marks for clients who will use them in commerce, the user will pay the creator. Despite not receiving trademark protection, then, the creator is nonetheless compensated for mark creation, possibly also receiving reputational benefit for the creation.

99 Relatedly, in resolving trademark ownership disputes, courts look to many factors, none of which are a party's creation of a mark apart from use of it to identify goods or services. See Chestek, *supra* note 97, at 695–97 (distilling the factors to which courts look).

100 McKenna, *supra* note 41, at 1884–85; accord UPTON, *supra* note 76, at 22 (“[T]he exclusive right to the trade mark, can exist in him only, who, in some form, and to some extent, possesses an exclusive right to the property to which it is appended.”).

connection with a business, which was the ultimate object of protection.”¹⁰¹ This creation of a link between a word or symbol and a business would later oftentimes be referred to as goodwill.¹⁰² It is just this type of goodwill that trademark law protects by giving rights in a trademark, that is, this linkage between signifier and business. This creator, then, is not the conventional one found in patent and copyright law. Rather, this creator is the one who first makes a link between a mark and a set of goods and services in a distinctive way. Trademark law rewards the creator of that link with exclusive rights.

To be sure, there are a limited number of situations in which individuals or entities originate a mark for particular goods or services which they themselves do not provide. In those cases, the goods or services provider is entitled to trademark protection.¹⁰³ For example, just that happened when the media and the public at large began using the term “Bunny Club” to refer to Playboy’s clubs.¹⁰⁴ In that case, the Trademark Trial and Appeal Board granted Playboy trademark rights in that term against an alleged prior user because of the yet earlier use of the term to signify the clubs by the media and public.¹⁰⁵ In this situation, Playboy reaps the trademark reward sown by the public. The public is the creator, both of the mark itself and of the link between the mark and the underlying goods or services, but Playboy benefits from trademark protection as a result.¹⁰⁶ This excep-

101 McKenna, *supra* note 41, at 1885.

102 *See id.* at 1886.

103 This situation is one of the few in which the rightsholder does not have to use the mark personally to secure rights. Use of the mark by others to signify the provider’s goods or services is sufficient. *See* McKenna, *supra* note 79 at 780.

104 *See* Pieper v. Playboy Enters., Inc., 179 U.S.P.Q. (BNA) 318, 320 (T.T.A.B. 1973).

105 *See id.*

106 *Cf.* Ill. High Sch. Ass’n v. GTE Vantage Inc., 99 F.3d 244, 245 (7th Cir. 1996) (acknowledging rights in a mark when a television broadcaster and then the public at large began using the term “March Madness” to refer to the National Collegiate Athletic Association’s “Final Four” basketball championship, played annually in March); Nat’l Cable Television Ass’n v. Am. Cinema Editors, Inc., 937 F.2d 1572, 1577–78 (Fed. Cir. 1991) (“[E]ven without use directly by the claimant of the rights, the courts and the [Trademark] Board generally have recognized that abbreviations and nicknames of trademarks or names used *only* by the public give rise to protectable rights in the owners of the trade name or mark which the public modified. Such public use by others inures to the claimant’s benefit and, where this occurs, public use can reasonably be deemed use ‘by’ that party in the sense of a use on its behalf.” (footnote omitted)); Arthur Guinness, Son & Co. v. Oscar Von Bernuth, Inc., 14 F. Supp. 210, 211–12 (S.D.N.Y. 1923) (finding trademark infringement in the defendant’s use of the mark “Dublin Stout XXX” because consumers associated the mark “Dublin Stout” with the plaintiff’s beer even though the plaintiff never used the mark on its beer).

tional scenario underscores how trademark law is only inadvertently concerned with the creator of a new link between a mark and goods or services. The law's typical solicitude of the creator is not because of the creator's status as creator, but because that creator tends to be the provider of the goods and services to which the mark is linked. But in the cases in which third parties create a mark for particular goods or services, those third parties do not receive trademark protection.

In sum, trademark law has no official solicitude for marks' creators, as compared with patent and copyright laws' occupation with rewarding the creators of protected content. Instead, trademark law's emphasis is on rewarding the entity that is usually the creator of the link between a mark and the goods or services signified by the mark in a distinctive way. In fact, if we are to understand a trademark as this link—or as Robert Bone calls it, a “repositor[y] or symbol[] of . . . goodwill”¹⁰⁷—rather than a symbol of some sort, the creator is precisely the party that trademark law almost always rewards.

B. Creativity's Role in Trademark Law

Having explored the role that marks' creators play in trademark protection, I now turn to the role that creativity itself plays, dissociated from any particular actor. Unlike creators, who receive no special cognizance under trademark law, creativity itself is strongly encouraged. In fact, in spite of Supreme Court and other pronouncements to the contrary,¹⁰⁸ encouraging creativity lies at the heart of trademark law and theory.

In previous work, I explore the role that creativity plays in patent and copyright law, through the lens of their differing protectability standards.¹⁰⁹ I explain how the creative process “includes as important steps both ‘problem finding’ (formulating and constraining a problem) and ‘problem solving’ (achieving a goal by removing any obstacles in the way).”¹¹⁰ I find that “the general structure of the creative process looks similar for scientists and engineers ultimately protected by patent and for artists ultimately protected by copyright.”¹¹¹ That said, society values different aspects of the creative process for scientific works and artistic works:

For scientific and technological inventions, society emphasizes problem solving over problem finding, while for artistic works, it

107 Bone, *supra* note 51, at 549.

108 See *supra* text accompanying note 12.

109 See Fromer, *supra* note 11, at 1445–56.

110 *Id.* at 1444.

111 *Id.*

stresses problem finding over problem solving. Moreover, while it is often acceptable for scientific and technological inventions to be more groundbreaking, it is psychologically preferable that artistic works be new, but not be too new.¹¹²

I suggest that these differences mostly parallel the different protectability standards in patent and copyright law. The protectability standards of patent law—which principally protects scientific and technological inventions—emphasize how well the inventor solved a particular problem, as well as establish a high threshold for qualification.¹¹³ By contrast, the protectability standards of copyright law—which mainly grant rights with regard to artistic works—dwell on an author’s finding of a problem, as well as set a low threshold for qualification, thereby encouraging the creation of works that are not too new.¹¹⁴

Creativity is something central that patent and copyright law each seeks to encourage, which is why it is vital to ensure that these laws actually encourage creative work in their respective purviews.¹¹⁵ With patent and copyright, the law seeks to encourage the creator to craft something valuable. According to Rochelle Dreyfuss, “Exclusivity is therefore necessary to assure the creator freedom from those who did not make the creative effort and thus would undercut the price at which the creator could profitably sell the work.”¹¹⁶

Trademark law is different to Dreyfuss, in that “the owner of a trademark is [primarily] in the business of selling a *different* product,” the product with which the mark is associated.¹¹⁷ In this regard, creativity does not seem to be the sine qua non of trademark law. Rather, well-established theory suggests that trademark law is designed to promote trade, by protecting consumers from source confusion, so as to minimize unfair competition, reduce consumer search costs, and promote quality in goods and services.¹¹⁸ This subpart seeks to establish, nonetheless, that creativity is something central that trademark law

112 *Id.* (footnote omitted).

113 *See id.* at 1484–92.

114 *See id.* at 1492–98.

115 *See id.* at 1457–59.

116 Dreyfuss, *supra* note 55, at 408.

117 *Id.* Rochelle Dreyfuss therefore worries about awarding strong rights to a mark’s owner when “the public . . . enjoy[s] the expressive dimensions of [the] trademark more than it values the underlying product.” *Id.*

118 *See supra* Part I.B; *cf.* *Am. Express Co. v. Goetz*, 515 F.3d 156, 159 (2d Cir. 2008) (per curiam) (“While copyright law protects the content of a creative work itself, it is trademark law that protects those symbols, elements or devices which identify the work in the marketplace and prevent confusion as to its source.” (citations omitted)).

seeks to encourage and this encouragement is desirable to promoting trademark's fundamental goals.¹¹⁹ I focus on how trademark law subtly encourages creativity in choosing distinctive marks. (Other than in passing, I do not, however, address the well-explored terrain of the converse situation: of society—such as everyday speakers and makers of parodies, commentaries, and comparative advertising—using already existing marks for creative purposes beyond signifying goods or services.)¹²⁰ Nonetheless, the important role of creativity in trademark law has perhaps also promoted trademark's expansion in ways only tenuously linked to trademark law's underlying goals.

Creativity made its way into trademark law once trademark law moved from protecting significations of a single known source to marks signaling a single, but typically unknown, source.¹²¹ As Frank Schechter observes, this shift “brings out . . . the creative and not merely symbolic nature of the modern trademark.”¹²² With this change, a mark no longer needs to identify a specified provider but (typically) a single provider. Therefore, it must be sufficiently linked—frequently via creativity, although sometimes via repetition—to the underlying good or service to stick in consumers' minds.

119 *But cf.* Stephen L. Carter, *The Trouble with Trademark*, 99 YALE L.J. 759, 768 (1990) (“Trademark law . . . provides no incentive to create new marks. A firm might well develop an idea for a mark that has some special charm and seems to be appealing, but its appeal has nothing to do with the reason that marks receive protection. Indeed, trademark law may be described as indifferent to the creation of marks, in the sense that the number of marks makes no difference. One might conceive of an optimal supply of copyrighted works or patented inventions . . .”).

120 *See, e.g., id.* at 763 (“[N]o matter how influential the mark might become, no matter how strong its reputation, there are no additional market language costs. The size of the set of appropriate marks is still reduced by the same amount—one mark. Thus, as a mark becomes stronger, the case for permitting its removal from the market language becomes easier to make. As long as the legal system allows only marks that actually represent goodwill to be removed from the available market language, the gains are clear.” (footnote omitted)); Wendy J. Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 YALE L.J. 1533, 1585 (1993) (“When the courts have to choose between depriving the trademark owners of some of the ‘fruits of their labor,’ on the one hand, or depriving the public and competing manufacturers of the ability to communicate simply and accurately on the other, the courts opt to sacrifice the creators’ reward in favor of securing the public’s liberty of communication.” (footnote omitted)); Sonia K. Katyal, *Semiotic Disobedience*, 84 WASH. U. L. REV. 489, 498, 554–68 (2006) (addressing how certain people valuably appropriate trademarks to “demonstrate the expressive value of transgressing [the law’s] limits”); *supra* notes 55–58 and accompanying text (discussing this shift in use of trademarks).

121 *See supra* text accompanying notes 38–47.

122 Schechter, *supra* note 39, at 817.

As Mark McKenna shows in his account of trademark law, the structure of trademark law indicates that it is protecting this linkage between signifier and business, not just the signifier on its own.¹²³ Most importantly, trademark rights arise only when a mark is used to signify a good or service.¹²⁴ Moreover, historically, the scope of trademark protection was keyed to the particular goods or services to which a mark was linked.¹²⁵

Although our intuitive understanding of creativity typically emphasizes the works protected by copyright and patent law (such as novels and pharmaceuticals), establishing that link is also an exercise of creativity. In addition to the prototypical forms of creativity in the arts and sciences, “[c]reativity courses through so many different domains, . . . [including] everyday activities—whether writing in a journal or figuring out an ingenious way to attain an object beyond one’s reach.”¹²⁶ According to psychologists, creativity is “a process that generates a product or idea and possesses two qualities: newness and appropriateness—appropriate in the sense that some community recognizes it as socially valuable.”¹²⁷ Trademark creation fits this schema of creativity. The creator here is, by definition, building something new: a link between a mark and goods and services that has not previously existed. In the abstract, this link creation is socially appropriate, in that trademark law seeks to benefit consumers and trade in innumerable ways.¹²⁸ Furthermore, trademark creators strive, as a practical matter, for social appropriateness. Trademark

123 See *supra* text accompanying notes 100–102; cf. Katyal, *supra* note 120, at 522 (“Since a product, at least initially, has no ‘meaning,’ it must acquire value through an association with a person or object that already has some meaning to the consumer. To protect this association, then, advertising uses intellectual property—trademarks, copyrighted works, and the like—as a visual vehicle or code to evoke common threads of emotions and thereby connect consumers to the psychological essence at hand.” (footnote omitted)).

124 See McKenna, *supra* note 41, at 1887; *supra* text accompanying notes 13–15.

125 See McKenna, *supra* note 41, at 1888. Traditionally, one could license or assign a mark to a third party only if the underlying business was sold to the third party as well. See *id.* at 1893–94. Over time, however, reflecting the notion that trademarks are repositories of goodwill, the courts began to allow trademarks to be licensed “as long as the mark owner ensured a consistent level of quality in the products or services offered under its mark.” *Id.* at 1910–11.

126 Fromer, *supra* note 11, at 1461; see also Richard E. Ripple, *Ordinary Creativity*, 14 CONTEMP. EDUC. PSYCHOL. 189, 189 (1989) (“Ordinary creative thinking is proposed as a point of view in which creativity results from ordinary people thinking in identifiably unique ways when they meet everyday problems in real-life situations.”).

127 Fromer, *supra* note 11, at 1459–60 (footnote omitted) (expanding on this psychological understanding of creativity).

128 See *supra* Part I.B.

creation typically involves extensive market research to determine how best to appeal to consumers through branding.¹²⁹ By seeking to appeal to a relevant community—the intended consumers of a product or service—trademark creation is occupied with selecting or creating a mark that is socially appropriate. Once a mark is selected and used, society will find it either helpful and it will be a successful—and thus appropriate—mark or unhelpful as a source indicator. In the latter case, as discussed below, trademark law frequently steps in to deny protection for the link.

In a fundamental way, then, trademark law rewards those providers of goods or services who have established a sufficiently strong link between a mark and their goods or services.¹³⁰ In trademark parlance, this sufficiently strong link comes about by employing a mark that is distinctive.¹³¹ As this subpart elaborates, developing this distinctiveness—this strong link—typically requires much creativity. (I focus primarily on the ways in which trademark law encourages the newness component of creativity, because it is natural, regardless of trademark law, for trademark creators to seek social appropriateness.¹³²) As such, even though encouragement of creativity is not asserted as a basis for trademark law, it is typically central to accomplishing trademark law's principal goals.

Foundational work by Frank Schechter in trademark theory suggests that distinctiveness is a goal for which trademark originators should strive, in that more distinctive marks have “more effective . . . selling power” than less distinctive ones.¹³³ In his view, the desirability of distinctive marks hinges on their typically strong impact on consumers¹³⁴:

[A] firm of fruitgrowers has recently popularized as its mark another animal of no well known or commonplace characteristics, the “blue goose.” When the public hears or sees the phrase “Blue Goose” it thinks, not of “a North American wild goose having a grayish plumage resembling that of the young snow goose found chiefly during its migrations in the Mississippi Valley,” but of oranges or

129 See, e.g., A. Samuel Oddi, *Product Simulation: From Tort to Intellectual Property*, 88 TRADEMARK REP. 101, 120 (1998).

130 See UPTON, *supra* note 76, at 23; Dinwoodie & Janis, *supra* note 77, at 1612–13; Stacey L. Dogan & Mark A. Lemley, *Grounding Trademark Law Through Trademark Use*, 92 IOWA L. REV. 1669, 1689 (2007).

131 See *supra* text accompanying notes 14–27.

132 See *supra* text accompanying notes 128–29.

133 Schechter, *supra* note 39, at 819.

134 See *id.* at 825.

grapefruit with a certain trademark and certain meritorious qualities.¹³⁵

Distinctive marks, therefore, arguably deserve greater protection against appropriation by sellers of other goods and services, to guard against “los[ing their] arresting uniqueness and hence . . . selling power.”¹³⁶ Schechter goes so far as to say that preserving a mark’s uniqueness is the only rational reason to protect it.¹³⁷

In this sense, the benefit of protecting a distinctive mark is high. The cost of protecting it as against a confusing commercial use is typically low. As William Landes and Richard Posner observe, “[t]hese costs [of legally enforceable trademarks] are modest, at least in the simple care [sic] of the ‘fanciful’ mark, such as ‘Exxon’ and ‘Kodak,’ which has no information content except to denote a specific producer or brand.”¹³⁸ Giving rights in fanciful marks, then, will not typically hurt trade—that which trademark law seeks to promote—because there was and is no need for competitors to use these marks to describe or even promote their competing products or services. Similarly, using an arbitrary mark like “Blue Goose” to signify fruit products will not usually be harmful to trade, because “Blue Goose” and other arbitrary marks are not necessary for competing fruit producers to use to promote their products. (The cost-benefit analysis is the opposite for marks that are not distinctive, in that their informational content beyond their use as a mark for one particular source of goods or services is strong, therefore suggesting that the cost of protecting these marks is high and the benefit is low.)

Trademark law grasps the high benefit and low cost of distinctiveness by awarding valuable protection, without much more, to those marks that are inherently distinctive.¹³⁹ Doing so provides an incentive to be creative in choosing trademarks, by coining new words or associating known words in an unexpected way with a good or service to gain trademark protection easily.¹⁴⁰ That is, to refer to one’s com-

135 *Id.* at 830.

136 *Id.* (defending trademarks against dilution by suggesting that the mark “Blue Goose,” associated with citrus fruit, should not be used on “pianos, shaving cream, and fountain pens”).

137 *See id.* at 831.

138 Landes & Posner, *supra* note 49, at 273.

139 *See supra* text accompanying notes 14–19.

140 *Cf.* Beebe, *supra* note 16, at 673–74 (“One reason why trademark law has traditionally granted broader protection to inherently distinctive marks is to provide an incentive to trademark producers to generate new words rather than appropriate from the language preexisting words for commercial purposes.”). Stephen Carter disputes that trademark law provides an incentive to be creative in choosing a mark. *See* Carter, *supra* note 119, at 768 (“[T]rademark law has never provided incentives to be

puter products, rather than choosing the unsurprising “Computer Company”—which would never receive trademark protection because it is generic—or “Digital Company”—which, as a descriptive mark, would not receive trademark protection unless secondary meaning was established—trademark law offers the incentive of easier protection by choosing a suggestive, arbitrary, or fanciful term like “Apple” for computer products.¹⁴¹

Standing alone, this foregoing analysis would suggest that trademark law gives an incentive to be ever creative in choosing trademarks that are inherently distinctive, to the redounding benefit of trademark law’s goals.¹⁴² But this picture is not complete. As discussed above, in the eyes of trademark law, suggestive marks are as inherently protectable as arbitrary and fanciful ones, even though they are characteristically less distinctive.¹⁴³ As examples, consider the following marks

clever in selecting a mark. Instead, the law encourages the development of goodwill and the association of that goodwill with a mark. The charming, attractive mark not yet associated with any goodwill simply does not carry any information, and, consequently, cannot possibly economize on it.” (footnote omitted).

141 According to lore, the etymology of Apple Computers is co-founder Steve Jobs’s earlier work in orchards. *Video: Steve Wozniak Explains Apple Company Name*, OBAMA PACMAN (Nov. 21, 2010), <http://obamapacman.com/2010/11/video-steve-wozniak-explains-apple-company-name>.

142 In this light, it is interesting to consider the Supreme Court’s approval of protection for inherently distinctive trade dress without secondary meaning:

[A]dding a secondary meaning requirement could have anticompetitive effects, creating particular burdens on the startup of small companies. It would present special difficulties for a business . . . that seeks to start a new product in a limited area and then expand into new markets. Denying protection for inherently distinctive nonfunctional trade dress until after secondary meaning has been established would allow a competitor, which has not adopted a distinctive trade dress of its own, to appropriate the originator’s dress in other markets and to deter the originator from expanding into and competing in these areas.

Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 775 (1992). In this reasoning, there seems to be a whiff of encouraging companies to create trade dress that is sufficiently creative, even when there is no current consumer association of the trade dress with its source. *Cf. Willajeanne F. McLean, The Birth, Death, and Renaissance of the Doctrine of Secondary Meaning in the Making*, 42 AM. U. L. REV. 737, 771 (1993) (suggesting the reasoning for this rule is that “some protection should exist for a producer who has spent and is spending money in an effort to create good will and consumer association, but whose product has not yet acquired secondary meaning”). If secondary meaning is likely incipient—given that inherent distinctiveness seems to be a proxy for consumer association of a mark with its source—this analysis seems defensible in light of trademark law’s goals. *Cf. id.* at 773 (“[T]he Supreme Court appears to have placed the notion of a legitimate proprietary interest ahead of consumer association.”).

143 See *supra* text accompanying notes 20–21.

that courts or administrative agencies have found to be suggestive, and thus inherently distinctive and protectable as trademarks: “Citibank” for urban banks,¹⁴⁴ “Dial-A-Mattress” for telephonic mattress sales,¹⁴⁵ “Wet/Dry Broom” for electric vacuum cleaners,¹⁴⁶ and “Spray ’N Vac” for aerosol rug cleaners.¹⁴⁷

On one view, originating suggestive marks generally entails less creativity than for more distinctive marks like “Apple” for computer products, “Blue Goose” for fruits, and “Exxon” for oil products. The reason is simply that there is—by definition—a relatively close and direct link between these marks that were found to be suggestive and the underlying goods and services they signify than between arbitrary or fanciful marks and their signified goods and services. In fact, psychologists regularly find that one of the most important features of creativity is the ability to make connections between remote concepts.¹⁴⁸ That is precisely what users of arbitrary or fanciful marks are doing, but users of suggestive marks are doing to a lesser extent, if at all, given the very close connections between marks like “Dial-A-Mattress” and the service of mattress sales over the telephone.¹⁴⁹

In the context of criticizing some trademark decisions for elevating the importance of inherent distinctiveness over a mark’s actual fame, Barton Beebe suggests that there is no incentive in trademark law to produce marks that are more distinctive than suggestive because they pass the threshold for trademark protection just as arbitrary and fanciful marks do.¹⁵⁰ If Beebe is correct, trademark law encourages creativity in crafting distinctive marks but only up to a

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

145 See *Dial-A-Mattress Operating Corp. v. Mattress Madness, Inc.*, 841 F. Supp. 1339, 1347–48 (E.D.N.Y. 1994).

146 See *In re Shop-Vac Corp.*, 219 U.S.P.Q. (BNA) 470, 471–72 (T.T.A.B. 1983).

147 See *Glamorene Prods. Corp. v. Boyle-Midway, Inc.*, 188 U.S.P.Q. (BNA) 145, 164–65 (S.D.N.Y. 1975).

148 See Fromer, *supra* note 11, at 1462 (citing psychological research).

149 On another view, suggestive marks might be seen as more creative than arbitrary or fanciful ones. Suggestive marks, it might be argued, walk the fine line between invoking the underlying good or service to which it is linked, yet without describing or naming it. As such, it might prove to be very memorable to consumers of the relevant good or service. I am grateful to Wendy Gordon for this insight. If this view is correct, it still supports the conclusion that trademark law seeks to promote creativity, by encouraging the adoption of inherently distinctive marks. Nonetheless, trademark law encourages the adoption of arbitrary or fanciful marks over suggestive ones. See *infra* text accompanying notes 151–64.

150 See Beebe, *supra* note 16, at 673–74; accord *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11 n.12 (2d Cir. 1976) (“As terms of art, the distinctions between suggestive terms and fanciful or arbitrary terms may seem needlessly artificial.”).

much less minimal point than that required to create arbitrary or fanciful marks.

Beebe, however, is likely incorrect, in that trademark law gives sufficient incentive to use arbitrary or fanciful marks over suggestive ones in two ways, one with regard to infringement and another with regard to protectability. For one thing, a trademark holder will generally be entitled to a wider scope of protection against infringement when its mark is arbitrary or fanciful than when it is suggestive.¹⁵¹ Recall that courts balance together multiple factors to determine whether a trademark has been infringed.¹⁵² Two of these factors are more likely to weigh in a trademark holder's favor when the mark is arbitrary or fanciful than when it is suggestive. First, courts are more willing to find trademark infringement when a mark is strong,¹⁵³ which courts frequently measure by its distinctiveness.¹⁵⁴ As one court put it, more distinctive marks are "afforded the widest ambit of protection from infringing uses," with arbitrary or fanciful marks being favored in this way over suggestive marks.¹⁵⁵ There might be many reasons for this factor's weight, such as rewarding producers who choose marks that are unlikely to interfere with competitors' needs to describe their products and are directly helpful, by being distinctive, to consumers. This factor thus provides an incentive to users of marks

151 Barton Beebe offers the insight that there are two relevant types of distinctiveness in trademark law: source distinctiveness and differential distinctiveness. *See* Beebe, *supra* note 16, at 625. Source distinctiveness "describes the extent to which a trademark's signifier is distinctive of its signified." *Id.* (emphasis omitted). For example, using the term "Apple" to signify computer products is distinctive in this way, while using the term "Cool" to signify air conditioning products is much less so. By contrast, differential distinctiveness "describes the extent to which a trademark's signifier is distinctive from other signifiers in the trademark system." *Id.* (emphasis omitted). As an example, this notion measures how distinct "Apple" is from other marks signifying computer products, like "Dell" and "Gateway." Beebe suggests that source distinctiveness is useful for determining whether a mark is eligible for trademark protection, while differential distinctiveness helps assess how much protection a mark should have against infringement. *See id.* While these different purposes for the two types of distinctiveness Beebe describes generally hold, my analysis suggests that source distinctiveness is also useful in significant ways for measuring a trademark's scope of protection against infringement.

152 *See supra* text accompanying note 32.

153 *See* AMF Inc. v. Sleekcraft Boats, 599 F.2d 341, 349–50 (9th Cir. 1979).

154 *See* McGregor-Doniger Inc. v. Drizzle Inc., 599 F.2d 1126, 1131 (2d Cir. 1979). Trademark strength is also related to its strength in consumers' minds. *See* Kenner Parker Toys Inc. v. Rose Art Indus., Inc., 963 F.2d 350, 353 (Fed. Cir. 1992).

155 *Sleekcraft Boats*, 599 F.2d at 349–50.

in commerce to choose arbitrary or fanciful ones over suggestive ones.¹⁵⁶

A second factor weighing in favor of trademark infringement is a defendant's bad intent in using the mark.¹⁵⁷ Courts reason that the presence of bad intent indicates infringement because "[w]hen the alleged infringer knowingly adopts a mark similar to another's, reviewing courts presume that the defendant can accomplish his purpose: that is, that the public will be deceived."¹⁵⁸ Evaluating this factor in conjunction with the one measuring the mark's strength is helpful. When a mark is very distinctive—arbitrary or fanciful—a competitor has no need to use the same or a very similar mark other than to benefit from consumer confusion by free-riding on the goodwill associated with the mark. Intentional use of a very distinctive mark is thus suggestive of trademark infringement. When a mark is less distinctive—whether suggestive or descriptive—it is easier to see how a competitor would intentionally use the mark without hoping to cause or actually causing consumer confusion. The competitor's use might merely be descriptive or suggestive of the competitor's goods or services without sufficiently confusing consumers. Seen in this light, more distinctive marks ought to be more widely protected against intentional use by competitors than less distinctive ones.

In light of these two factors, trademark infringement is more likely to be found for arbitrary or fanciful marks than for suggestive ones.¹⁵⁹ Thus, even though all three categories of marks are inherently distinctive and deserving of trademark protection, the doctrine of trademark infringement ought to encourage producers to adopt arbitrary or fanciful trademarks over suggestive ones.

In addition, an incentive to choose arbitrary or fanciful trademarks over suggestive ones lies in trademark's protectability scheme.

156 Considering this factor in isolation, there is some oddness of finding trademark infringement more readily when the computer company plaintiff is, say, Apple Computers than when it is Computer Company, in that the plaintiff's mark creativity does not tell us anything if the defendant is using Apple for, say, its travel company. This rule makes more sense when looking at the multiple factors that together inform the infringement analysis, particularly the factor weighing in favor of infringement the more proximate the plaintiff's and defendant's goods are. *See supra* text accompanying note 32.

157 *See Sleekcraft Boats*, 599 F.2d at 354.

158 *Id.*

159 *See Beebe*, *supra* note 32, at 1637 ("[I]n the ninety dispositive opinions in which the court placed the plaintiff's mark in one of the five [distinctiveness] categories, the plaintiff multifactor test win rate steadily declined with the inherent strength of its mark: fanciful marks enjoyed the highest win rate, followed by arbitrary marks, suggestive marks, descriptive marks, and then generic marks.").

On the distinctiveness spectrum, the class of suggestive marks neighbors the class of descriptive ones.¹⁶⁰ In fact, it is widely thought that the borderline between suggestive marks, which are inherently distinctive, and descriptive ones, which require secondary meaning to be protectable,¹⁶¹ is especially fuzzy.¹⁶² Learned Hand went so far as to state that “[i]t is quite impossible to get any rule out of the cases beyond this: That the validity of the mark ends where suggestion ends and description begins.”¹⁶³ In his treatise on trademark law, Tom McCarthy notes that the “exact location in any given situation [between descriptive and suggestive marks] is hazy and only subjectively definable.”¹⁶⁴

It is thus unsurprising to find very similar—if not identical—marks for the same goods or services classified by one court as suggestive and by another as descriptive.¹⁶⁵ Examples abound. One court determined that “L.A.” as a mark for low alcohol beer was suggestive of it,¹⁶⁶ while another held that the same mark was descriptive of the beer’s quality.¹⁶⁷ And while a court held that “Family Market” as a

160 Cf. 2 McCARTHY, *supra* note 89, § 11:63 (defining suggestive marks as those that are “subtly ‘descriptive’”).

161 See *supra* text accompanying notes 22–25.

162 See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976); *Le Blume Import Co. v. Coty*, 293 F. 344, 351 (2d Cir. 1923); 2 McCARTHY, *supra* note 89, § 11:64. The Second Circuit also notes that classifying marks’ distinctiveness is made harder because

a term that is in one category for a particular product may be in quite a different one for another, because a term may shift from one category to another in light of differences in usage through time, because a term may have one meaning to one group of users and a different one to others, and because the same term may be put to different uses with respect to a single product.

Abercrombie & Fitch Co., 537 F.2d at 9 (footnotes omitted).

163 *Franklin Knitting Mills, Inc. v. Fashionit Sweater Mills, Inc.*, 297 F. 247, 248 (S.D.N.Y. 1923).

164 2 McCARTHY, *supra* note 89, § 11:66. Courts tend to use some combination of four possible tests to distinguish suggestive from descriptive marks: dictionary definition, whether imagination must be exercised to make a connection between the mark and the underlying goods or services, competitors’ need to use the mark to describe their goods or services, and competitors’ actual use of the mark to describe their goods or services. See *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 792–93 (5th Cir. 1983). See generally 2 McCARTHY, *supra* note 89, §§ 11:67–69 (describing these tests).

165 See 2 McCARTHY, *supra* note 89, § 11:70 (citing illustrative cases).

166 See *Anheuser-Busch Inc. v. Stroh Brewery Co.*, 750 F.2d 631, 633 (8th Cir. 1984).

167 See *G. Heileman Brewing Co. v. Anheuser-Busch, Inc.*, 873 F.2d 985, 1000 (7th Cir. 1989).

mark for a retail store was suggestive,¹⁶⁸ other courts found “Shoppers Fair” and “Food Fair” to be descriptive marks for retail stores.¹⁶⁹

The fuzziness of the boundary between suggestive and descriptive marks implies that producers of goods and services would typically prefer to avoid suggestive marks entirely, instead using arbitrary or fanciful marks. If a mark that seems plausibly suggestive is chosen, a court or administrative agency might nonetheless also reasonably decide that the mark is descriptive. As such, the mark would be protectable only if secondary meaning is shown. The uncertainty, combined with a possible necessity of showing secondary meaning—which might not be possible in a significant number of cases—ought to deter people from using suggestive marks in favor of arbitrary or fanciful marks. Moreover, even cautious types might not want to use a mark likely—but not certain—to be found to be suggestive, because they might have to invest significant sums and time in developing secondary meaning out of risk aversion.¹⁷⁰

Just as trademark law pushes people away from suggestive marks in favor of arbitrary or fanciful marks, it grants significant incentive to people not to use descriptive marks when they might use a more distinctive mark. For one thing, due to the same two factors discussed above, trademark infringement is more likely to be found for suggestive marks than for descriptive ones.¹⁷¹ Moreover, as Tom McCarthy describes, the borderline between descriptive and generic marks is just as fuzzy as that between suggestive and descriptive marks.¹⁷² Although descriptive marks are protectable as trademarks so long as secondary meaning has been established, generic marks are never protectable under trademark law.¹⁷³ Just as there are numerous cases at the suggestive-descriptive border, there are many at the descriptive-generic boundary. For example, while the Seventh Circuit held that

168 See *Tradewell Stores, Inc. v. T.B. & M., Inc.*, 500 P.2d 1290, 1294 (Wash. Ct. App. 1972).

169 See *Shoppers Fair of Ark., Inc. v. Sanders Co.*, 328 F.2d 496, 499 (8th Cir. 1964); *Food Fair Stores, Inc. v. Lakeland Grocery Corp.*, 301 F.2d 156, 160–61 (4th Cir. 1962).

170 Cf. *Dreyfus Fund Inc. v. Royal Bank of Can.*, 525 F. Supp. 1108, 1115 (S.D.N.Y. 1981) (“One of the benefits of a strong mark—and an aspect of its value—is the owner’s well-earned capacity to achieve a high degree of consumer recognition (and response) with less costly forms of advertising than had been necessary to establish the mark’s strength.”).

171 See *supra* text accompanying notes 151–158.

172 See 2 MCCARTHY, *supra* note 89, § 12:20; see also *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1569 (Fed. Cir. 1987).

173 See *supra* text accompanying notes 22–27.

“Alo” for cream of the aloe vera plant was generic,¹⁷⁴ the Fifth Circuit held that the same mark for the same product was descriptive.¹⁷⁵ Similarly, one court held “First National Bank” to be a generic mark for the first national bank in a certain geographic area,¹⁷⁶ while another held “First Federal” to be merely descriptive of the first federally chartered savings and loan organization in a specific geographic region.¹⁷⁷ A reasonable person would avoid descriptive terms, as courts and administrative agencies might label them generic and consequently unprotectable—a harsh result.

Even if a mark is squarely descriptive—or a user is willing to take a risk on what a court or administrative agency might conclude—the user must invest significant labor in establishing secondary meaning for the mark for it to be protectable.¹⁷⁸ In many cases, the expense and time that labor entails ought to push users toward more distinctive marks. The user must develop a context in which enough consumers establish a link between the descriptive mark and only the user’s goods or services, rather than the class of goods or services with which consumers would otherwise associate the mark.¹⁷⁹

This push toward ever more distinctiveness—away from generic, descriptive, and suggestive marks and in favor of arbitrary or fanciful ones—is beneficial for society and consumers.¹⁸⁰ Under this push,

174 See *Am. Aloe Corp. v. Aloe Creme Labs., Inc.*, 420 F.2d 1248, 1256 (7th Cir. 1970).

175 See *Aloe Creme Labs., Inc. v. Milsan, Inc.*, 423 F.2d 845, 849–50 (5th Cir. 1970).

176 See *First Nat’l Bank & Trust Co. v. First Nationwide Bank*, 15 U.S.P.Q.2d (BNA) 1457, 1461 (W.D. Mo. 1990).

177 See *First Fed. Sav. & Loan Ass’n of Council Bluffs v. First Fed. Sav. & Loan Ass’n of Lincoln*, 929 F.2d 382, 384 (8th Cir. 1991).

178 See Aoki, *supra* note 77, at 241; Lemley & McKenna, *supra* note 80, at 173.

179 See McKenna, *supra* note 41, at 1891–92; McKenna, *supra* note 78, at 783; cf. Dinwoodie, *supra* note 54, at 613 (“[T]rademark law must recognize the limitless sources of meaning; it must confront the postmodern reality that meaning arises from context and experience rather than from the intrinsic essence of matter.”).

180 Recent empirical work suggests that “descriptive marks are no less source-indicating than suggestive, arbitrary, and fanciful marks,” in that “the non-lexical cues of typical trademark use (e.g., the location and size of the mark) . . . cause consumers to find descriptive marks to be source-indicating.” Thomas R. Lee, Eric D. DeRosia & Glenn L. Christensen, *An Empirical and Consumer Psychology Analysis of Trademark Distinctiveness*, 41 ARIZ. ST. L.J. 1033, 1038 (2009) (footnote omitted). Intriguing as these results are, the static nature of the study ignores the intuitively likely possibility that these results hold only for first-time associations of marks with goods or services. That is, once a consumer learns of a mark, its distinctiveness likely becomes more salient and relevant to consumers’ associations with the associated good or service. In that light, trademark law discourages the use of descriptive marks and encourages the use of ever inherently distinctive marks for good reason: to get trademark users to avoid

existing words tend not to be removed from circulation in trade—via trademark law’s protections—unless they have nothing to do with the underlying goods or services being offered.¹⁸¹ Society, consumers, and competitors can readily absorb this loss. In particular, competitors are left free to describe their goods in intuitive ways and to originate and use their own highly distinctive marks to distinguish their goods and services, in ways that ultimately benefit consumers.¹⁸² As the Second Circuit put it, “The English language has a wealth of synonyms and related words with which to describe the qualities which manufacturers may wish to claim for their products and the ingenuity of the public relations profession supplies new words and slogans as they are needed.”¹⁸³

This analysis also provides a useful framework through which to analyze the role of goodwill in trademark law. Robert Bone criticizes goodwill’s place in trademark law. He asserts that “the information transmission model aims to prevent misleading representations, while the [goodwill] misappropriation model aims to prevent unauthorized appropriations.”¹⁸⁴ It is the former, he insists, that we ought to protect in light of trademark’s goals of protecting against consumer confusion.¹⁸⁵ Seen through the lens of creativity’s role in trademark law, however, the two models are more in step than Bone views them to be. Protection against trademark infringement when there is consumer confusion is a way of maintaining a trademark’s goodwill. Essentially, protection against run-of-the-mill trademark infringement by a competitor protects the goodwill situated in a mark—in other words, the link between the mark and the underlying product or good. In this

marks that impose excessive costs on society—withdrawal of useful words from significant commercial uses by competitors—without an offsetting benefit. *See supra* text accompanying note 138.

181 *See supra* text accompanying notes 133–138.

182 Of course, not all words—even arbitrary or fanciful ones—are equal. *See* Felix S. Cohen, *Transcendental Nonsense and the Functional Approach*, 35 COLUM. L. REV. 809, 815–16 (1935). Either “peculiar emotional contexts give one word more sales appeal than any other word suitable for the same product” from the moment it is first used for that product, or “all words are originally alike in commercial potentiality, but become differentiated by advertising and other forms of commercial exploitation.” *Id.* at 817 (expressing suspicion with awarding legal rights to the first person to take advantage of an already attractive word, while also conveying skepticism in the case of exploiting the consumer by making products more appealing via branding).

183 *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11 (2d Cir. 1976) (quoting *Aluminum Fabricating Co. of Pittsburgh v. Season-All Window Corp.*, 259 F.2d 314, 317 (2d Cir. 1958)).

184 Bone, *supra* note 51, at 550.

185 *See id.* at 549.

way, trademark law protects a mark's distinctiveness from being eroded by competitors' use as a source indicator. Given that trademark law encourages creativity to achieve distinctiveness, guarding a trademark's distinctiveness by imposing liability for trademark infringement frequently also provides shelter for the creativity trademark law encourages.

Despite the significant benefit to trademark law's fundamental purposes of promoting creativity in choosing ever distinctive marks, there is reason to suspect that rewarding creativity might also have helped fuel trademark's ever expansive reach. As Keith Aoki puts it, "Traces of authorship have been ascribed to the trademark owner who has invested her 'sweat of the brow' to 'create' value in a mark, so that she is looked upon as being legally entitled and justified in 'reaping what she has sown.'"¹⁸⁶ Encouraging creativity in choosing a distinctive mark to link with an underlying good or service might incline the law to give robust rights to the user who has made this link,¹⁸⁷ just as patent and copyright law give vigorous rights to reward creativity.¹⁸⁸

Trademark protection has grown over time, from protecting against competitive uses of a trademark holder's signifier to shielding holders from many non-competitive uses of it.¹⁸⁹ Numerous scholars are skeptical of this development, in part because the marketing literature does not demonstrate that consumers derive information about the quality of a product from the use of a mark associated with a non-competitive product.¹⁹⁰

186 Aoki, *supra* note 77, at 242.

187 *Cf. id.* at 235 (critiquing "the recent trend towards conceiving of trademarks as property-equivalents coupled with the growth of state anti-dilution . . . [which] suggest[s] that trademark owners have been reconceived as quasi-authors, who by creating a set of meanings in the minds of consumers, are rewarded with judicial recognition of increasingly exclusive rights to prevent others from 'misappropriating' this quasi-property" (footnote omitted)).

188 *See generally* Fromer, *supra* note 11 (examining creativity in the patent and copyright arenas); *supra* text accompanying notes 109–116 (recounting the central role of creativity in intellectual property law).

189 *See* Mark P. McKenna, *Testing Modern Trademark Law's Theory of Harm*, 95 IOWA L. REV. 63, 67–68 (2009); *see also* Greg Lastowka, *Google's Law*, 73 BROOK. L. REV. 1327, 1367–71 (2008) (describing how trademark dilution and the doctrine of initial interest confusion have grown); Lisa P. Ramsey, *Free Speech and International Obligations to Protect Trademarks*, 35 YALE J. INT'L L. 405, 407 (2010) (discussing how trademark law has been applied to prohibit some forms of noncommercial speech, as well as commercial speech that is not misleading).

190 *See* McKenna, *supra* note 189, at 70–71. The same critique might be leveled against the Lanham Act's constructive protection of marks nationwide, even if they are used in a limited subset of the United States. *See* Carter, *supra* note 119, at 760 ("Under the Lanham Act, a firm that obtains registration of a mark suddenly becomes

Others have already delved into these expansions. Without conclusively commenting on these expansions' desirability, I touch upon some of them—anti-dilution, doctrine of initial interest confusion, rights against noncommercial speech, and rights for the mere possibility of market expansion—to note how rewarding creativity in trademark law might have contributed to this growth in protective scope, often in ways beyond the traditional justifications of trademark law.

Trademark anti-dilution allows certain trademark holders to guard against use of their mark to protect a mark's distinctiveness even when there is no consumer confusion.¹⁹¹ Some states began protecting against dilution in the mid-twentieth century, and Congress passed an anti-dilution law in 1996.¹⁹² The federal law currently protects marks that are sufficiently famous against dilution by blurring—such as how a car marked as “Coca-Cola” might blur the soft drink's mark—and by tarnishment—such as a Coca-Cola-style logo, “Enjoy Cocaine.”¹⁹³ As Frank Schechter noted long ago, permitting dilution diminishes a mark's distinctiveness.¹⁹⁴ For holders of sufficiently famous marks, then, dilution laws guard those marks even when consumers do not think that the Coca-Cola Company offered up a “Coca-Cola” car or an “Enjoy Cocaine” logo. Some commentators criticize anti-dilution laws as thereby being unmoored from trademark law's basic purpose of promoting trade by protecting against consumer confusion.¹⁹⁵ As such, the underpinning notion of protecting creativity in

the mark's proprietor in markets that the firm has never entered and might indeed have no interest in entering. In other words, common law ownership of a mark in one part of the country can, through registration, become effective ownership of the mark in every part of the country. The effect of this approach is to give the mark's owner the benefit of more than has been invested, by treating the mark as carrying significance in markets where it has none.”).

191 See Lastowka, *supra* note 189, at 1367.

192 See *id.* (citing Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, § 3(a), 109 Stat. 985, 985–96 (codified at 15 U.S.C. § 1125(c))). Congress revised the law in 2006. See Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, 120 Stat. 1730 (codified as amended at 15 U.S.C. §§ 1052, 1063, 1064, 1092, 1125, 1127 (2006)).

193 See 15 U.S.C. § 1125(c)(2)(B)–(C) (2006) (defining dilution by blurring as an “association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark,” and dilution by tarnishment as an “association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark”). The second Coca-Cola example derives from *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1188 (E.D.N.Y. 1972).

194 See Schechter, *supra* note 39, at 829–30.

195 See, e.g., Lastowka, *supra* note 189, at 1369; Rebecca Tushnet, *Gone in Sixty Milliseconds: Trademark Law and Cognitive Science*, 86 TEX. L. REV. 507, 508–11 (2008). *But*

choosing distinctive marks might have, in part, motivated anti-dilution laws' aim of guarding distinctiveness standing alone. This goal, however, is only weakly connected to the essential role of promoting creativity in trademark law, so as to ensure a strong link between a chosen mark and the actual goods or services the mark signifies.

Another aspect of trademark law that has been thought to have expanded is the range of actionable consumer confusion to find trademark infringement. Frequently noted is the doctrine of initial interest confusion, by which consumers who were at some point confused by a mark's source are no longer confused by the time of purchase.¹⁹⁶ For example, this doctrine might be employed to find trademark infringement when a goods provider puts on a highway a billboard advertising a competitor's store at a particular exit, when only the first provider has a store there.¹⁹⁷ Any consumer who goes to the store will not be confused as to the goods' source by the time of purchase, but yet the Ninth Circuit has stated that this scenario constitutes trademark infringement.¹⁹⁸ A similar—and more common situation—is when consumers searching on the Internet for a particular mark are misdirected to a competitor's; any consumer confusion is usually dispelled upon reaching the competitor's site.¹⁹⁹ As with dilution law, given the lack of consumer confusion at any critical juncture—here, the point of sale—this doctrine arguably extends beyond the fundamental purposes of trademark law.²⁰⁰ The promotion of creativity in trademark law might again have played a role in this expansion of actionable confusion, by trying to protect the goodwill developed in linking distinctive marks to goods and services. Just as with dilution law, however, this protection has a tenuous connection to the creativity that trademark law seeks to foster between linking marks to goods or services to promote trade.

Similar analysis might be made of courts' findings of trademark infringement for use of a mark in noncommercial speech. In one

cf. Barton Beebe, *A Defense of the New Federal Trademark Antidilution Law*, 16 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1143, 1174 (2006) (arguing that the current federal law is relatively narrower than dilution theory); Clarisa Long, *Dilution*, 106 COLUM. L. REV. 1029, 1029–33 (2006) (sifting through judicial decisions on federal dilution, and finding that dilution is narrowly interpreted and not easily found).

196 See Lastowka, *supra* note 189, at 1369–71; Jennifer E. Rothman, *Initial Interest Confusion: Standing at the Crossroads of Trademark Law*, 27 CARDOZO L. REV. 105, 106–14 (2005).

197 See *Brookfield Commc'ns, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1064 (9th Cir. 1999).

198 See *id.*

199 See Rothman, *supra* note 196, at 106–10.

200 See *id.* at 106–14.

notorious case, People for the Ethical Treatment of Animals (PETA) sued a person who had registered the website *peta.org* and hosted there a parody about “People Eating Tasty Animals.”²⁰¹ In that case, the Fourth Circuit rejected a parody defense²⁰² and found trademark infringement because the operation of *peta.org* “prevented users from obtaining or using PETA’s goods or services” and “provide[d] links to more than 30 commercial operations offering goods and services.”²⁰³ Putting aside that this case might also be an application of the doctrine of initial interest confusion, it seems to be imposing a prohibition on many forms of noncommercial speech. Again, by rewarding creativity in choosing distinctive marks, trademark doctrine might be making a leap toward the propertization of these marks, even when the allegedly infringing use is not in commerce.

Finally, Mark Lemley and Mark McKenna express skepticism with protecting the possibility of market expansion via trademark law. They discuss the practice of finding trademark infringement as to a class of goods or services in which the trademark holder is not currently engaged on the basis that the holder might expand their market.²⁰⁴ They reason that:

[I]t’s not clear why we would give ownership of the term (“Exxon” as applied to gloves, for example) to the first user of that mark in a different market (Exxon Oil company) rather than the first user in the new market (the company that had first used the term for gloves). Indeed, trademark law has always assumed the opposite: trademark rights are awarded on the basis of first use of a mark in a particular geographic and product market.²⁰⁵

A basis to shield trademark holders from non-competitive uses by others may be to protect their opportunities for market expansion down the road and against free-riding.²⁰⁶ Assuming some marks for particular goods or services are more attractive intrinsically than others, then, as Stephen Carter states in another context, “allowing protection of marks devoid of market significance may raise substantial barriers to entry by competitors,” precisely contrary to trademark law’s purposes.²⁰⁷ Again, rewarding creativity in choosing distinctive marks to link to one’s goods or services might cause courts to award rights in the distinctive marks unlinked from those goods or services.

201 See *PETA v. Doughney*, 263 F.3d 359, 362–63 (4th Cir. 2001).

202 See *id.* at 366–67.

203 *Id.* at 365–66.

204 See Lemley & McKenna, *supra* note 80, at 179.

205 *Id.*

206 See *id.* at 187.

207 Carter, *supra* note 119, at 760.

The important role of creativity in trademark law stems from building up a link between a mark and a particular set of goods and services.²⁰⁸ Rewarding creativity in choosing a distinctive mark divorced from that particular set of goods and services or from trademark law's fundamental goals seems to move away from the precise (and derivative) role of creativity in trademark law in the first place. There is good reason to think that the narrow role of creativity in trademark law ought to inform trademark law's scope.²⁰⁹

CONCLUSION

With this exploration of the role of creativity in trademark law, it ought to be apparent why Lady Gaga's ex-boyfriend and producer made no claim to trademark ownership of the "Lady Gaga" mark. Even if he was correct in claiming that he originated the term, he did not claim to have used it in commerce to signify her as a singer or in another way. Regardless whether he acted creatively in originating the term "Lady Gaga," it was Stefani Germanotta who used it to signify her musical services, products, and the like. She was the one that acted creatively—at least within the judgment of trademark law—by building a link between the mark and her goods and services. Moreover, she did just what trademark law encourages her to do—use a mark that is highly distinctive of her goods and services—thereby promoting the role of creativity in trademark law to advance the goals of trade, reduction of consumer confusion, and promotion of quality in underlying goods and services. In this way, the role of creativity is essential to trademark law's goals. However, trademark law should be wary of rewarding creativity in choosing distinctive marks in and of themselves, unmoored from their use on particular goods or services in commerce.

208 Cf. Aoki, *supra* note 77, at 241 ("Anti-dilution and misappropriation law to the contrary, it does not necessarily follow that property in a set of meanings that extend beyond a mark's signalling function should be allocated exclusively to the trademark owner."); Lemley & McKenna, *supra* note 80, at 172 ("Whether or not we need to allocate additional markets to authors and playwrights in order to motivate them to create books and plays, it seems implausible to think that we need to award rights in words themselves in order to motivate the creation and use of new trademarks.").

209 Cf. Aoki, *supra* note 77, at 247 ("Anti-dilution theory, however, is all the more curious because of the complete absence of an explicit authorial figure in trademark law, whose personal (as opposed to economic) interests would be served by protecting a mark from 'unauthorized' downstream modifications by non-competing users.").