

# Using Failure to Function Doctrine to Protect Free Speech and Competition in Trademark Law

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I.	INTRODUCTION .....	71
II.	FAILURE TO FUNCTION DOCTRINE AND ITS RELATIONSHIP TO OTHER TRADEMARK LAWS.....	76
	A. ALMOST ANYTHING CAN QUALIFY AS PROTECTABLE TRADEMARK SUBJECT MATTER.....	76
	B. A TRADEMARK MUST BE DISTINCTIVE.....	77
	C. FUNCTIONAL MATTER CANNOT BE REGISTERED OR PROTECTED .....	80
	D. THIS MATTER MUST BE USED AND FUNCTION AS A TRADEMARK.....	81
III.	EXAMPLES OF HOW FAILURE TO FUNCTION DOCTRINE CAN PROTECT FREE SPEECH AND COMPETITION IN TRADEMARK LAW .....	86
	A. TRADEMARKS CLASSIFIED AS “INHERENTLY DISTINCTIVE”.....	87
	B. FICTIONAL CHARACTERS OR ELEMENTS FROM CREATIVE WORKS.....	95
	C. PRODUCT FEATURES AND OTHER NON-TRADITIONAL MARKS.....	99
IV.	USE AS A MARK SHOULD BE TREATED AS A SEPARATE REQUIREMENT FOR TRADEMARK REGISTRATION AND PROTECTION .....	100
V.	CONCLUSION .....	104

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## I. INTRODUCTION

Today news organizations often report about applications to register trademarks consisting of the latest trending meme, profanity, words commonly used in an industry, and other widely used messages. Examples include OK BOOMER for clothing and entertainment services; 100% THAT BITCH for a series of musical sound and video recordings, clothing, and entertainment services; DARK for a series of novels and other fiction works; TACO TUESDAY for online entertainment services, podcasting services, and similar products; and THE for T-shirts, hats, and other clothing.<sup>1</sup> An interesting issue raised by these applications is whether such words actually function as trademarks when used on or in connection with these products.

Trademarks identify the source of goods or services and help consumers distinguish products in the marketplace.<sup>2</sup> Words like COCA COLA and PEPSI displayed on cans or bottles provide information about the qualities of the cola beverages for sale. These words are registered and protected under trademark law because they are used as trademarks to designate the source of these products. Yet not all words displayed on a product's packaging function as trademarks. An example is the list of ingredients. These words usually appear in a less prominent place on the can or bottle and in a smaller size than the brand names displayed on the front of the packaging. Unlike the terms Coca-Cola or Pepsi, the ingredient list fails to function as a trademark

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1. There are several applications to register OK BOOMER, which is a phrase some younger people use in a dismissive way to respond to comments by the baby boomer generation. *See, e.g.*, OK BOOMER, U.S. Trademark Application Serial No. 88,675,174 (filed by Kevin Yen on Oct. 31, 2019); OK BOOMER, U.S. Trademark Application Serial No. 88,687,936 (filed by Fox Media LLC on Nov. 11, 2019); Derrick Bryson Taylor, *Trying to Trademark a Meme? OK Boomer*, N.Y. TIMES (Nov. 19, 2019), <https://www.nytimes.com/2019/11/19/style/ok-boomer-trademark.html> [<https://perma.cc/YKS6-YJLK>]. Singer, rapper, and songwriter Melissa Vivian Jefferson, known professionally as Lizzo, applied to register the phrase 100% THAT BITCH through her company Lizzo LLC. 100% THAT BITCH, U.S. Trademark Application Serial Nos. 88,466,246; 88,466,264; 88,466,281; 88,466,307 (all filed June 10, 2019); Arwa Mahdawi, *Lizzo is '100% that bitch' ... but can she trademark it?*, THE GUARDIAN (Sept. 4, 2019 01:00 EDT), <https://www.theguardian.com/lifeandstyle/2019/sep/04/lizzo-is-100-that-bitch-but-can-she-trademark-it> [<https://perma.cc/U2AN-843X>]. Author Christine Feehan applied to register the mark DARK, U.S. Trademark Application Serial No. 88,699,997 (filed Nov. 20, 2019); Cory Doctorow, *Writer Asks for an Exclusive Trademark on the Use of the Word "Dark" in "Series of Fiction Works, Namely, Novels and Books"*, BOINGBOING (Nov. 29, 2019 8:37 AM), <https://boingboing.net/2019/11/29/dark-trademarks.html> [<https://perma.cc/8GYU-NFPN>]. Professional basketball player LeBron James, through his company LBJ Trademarks, applied to register the mark TACO TUESDAY, U.S. Trademark Application Serial No. 88,579,771 (filed Aug. 15, 2019); *LeBron's 'Taco Tuesday' Trademark Filing Denied*, ESPN (Sept. 11, 2019), [https://www.espn.com/nba/story/\\_/id/27596576/lebron-taco-tuesday-trademark-filing-denied](https://www.espn.com/nba/story/_/id/27596576/lebron-taco-tuesday-trademark-filing-denied) [<https://perma.cc/VN5Q-BTSS>]. The Ohio State University applied to register the mark THE, U.S. Trademark Application Serial No. 88,571,984 (filed Aug. 8, 2019); Kristian Dyer, *Ohio State's Trademark Application for 'The' Still Has Life*, FOXBUSINESS (Sept. 12, 2019), <https://www.foxbusiness.com/features/ohio-states-trademark-application-for-the-still-has-life> [<https://perma.cc/28UY-XWXX>].

2. For information about the trademark laws in this Essay, see J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (5th ed. 2019).

because it is not used and perceived as a mark for the products of The Coca-Cola Company and PepsiCo.

These two companies also use slogans in connection with the advertising and sale of their soft-drinks and claim trademark rights in these words. Recent examples are The Coca-Cola Company's tagline TASTE THE FEELING<sup>3</sup> and PepsiCo's slogan LIVE FOR NOW.<sup>4</sup> Such phrases are not the common name or generic term for a cola beverage and they do not describe it. Thus these words would be classified as "inherently distinctive" marks for these products under trademark law's *Abercrombie* spectrum of distinctiveness, which is the test used to determine the distinctiveness of word marks.<sup>5</sup> If a phrase is deemed to be inherently distinctive, the company need not prove this mark has acquired distinctiveness or "secondary meaning" through use of the mark in connection with the goods or services.<sup>6</sup> Trademark law presumes that the inherently distinctive term is perceived by consumers as a mark that identifies and distinguishes the company's products as of the first date of use.<sup>7</sup> However, consumers may believe these words used in advertisements and social media posts are only expressing ideas and are not source-identifying trademarks of The Coca-Cola Company or PepsiCo. Thus, trademark law deems certain marks to be distinctive and eligible for registration and protection before they actually function as trademarks that identify and distinguish products.

Stylized words, logos, product packaging designs, restaurant décor, and the design and layout of a retail store can also be deemed inherently distinctive under trademark law,<sup>8</sup> but the determination of inherent distinctiveness for these types of marks is usually made using a different

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3. TASTE THE FEELING, Registration No. 5,053,231; *130 Years of Coke Taglines: From 'Delicious and Refreshing' to 'Taste the Feeling'*, ADAGE (Jan. 20, 2016), <https://adage.com/article/news/coke-taglines/302205> [<https://perma.cc/32MK-QB3W>].

4. LIVE FOR NOW, Registration No. 4,277,249; Lucy Handley, *Pepsi Has a New Ad Slogan. And It's Already Dividing Opinion*, CNBC (Jan. 10, 2019, 11:45 AM), <https://www.cnbc.com/2019/01/10/pepsi-has-a-new-ad-slogan-and-its-already-dividing-opinion.html> [<https://perma.cc/SY68-KG9A>].

5. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210–11 (2000); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9–10 (2d Cir. 1976). For details about the *Abercrombie* spectrum, see *infra* Section II.B.

6. *Wal-Mart*, 529 U.S. at 210–11; *Abercrombie*, 537 F.2d at 9–10; see generally MCCARTHY, *supra* note 2, §§ 11:1–72, 15:1–73 (explaining the difference between inherently distinctive marks and marks that require proof of acquired distinctiveness through use).

7. MCCARTHY, *supra* note 2, § 11:4. There is a high probability that inherently distinctive marks already have or will soon acquire secondary meaning—which can be expensive to prove—and thus Professor Bone argues that the conclusive presumption that such marks have secondary meaning after their first use in trade is justified in trademark law because it can save substantial litigation costs. Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099, 2130–32 (2004). Unfortunately, this "conclusive presumption does not always produce the correct result . . . [as] it is possible that consumers will reject an inherently distinctive mark as a source identifier." *Id.* at 2133.

8. *Wal-Mart*, 529 U.S. at 209–11; *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 765–76 (1992).

trademark doctrine called the *Seabrook* test.<sup>9</sup> Under this analysis, designs that are unique or unusual in an industry are more likely to be deemed inherently distinctive.<sup>10</sup> PepsiCo's red, white, and blue circle logo and The Coca-Cola Company's red and white product packaging design and distinctive bottle shape may be inherently distinctive under the *Seabrook* test. Regardless, these marks have acquired distinctiveness through extensive use in the marketplace. Contrast these distinctive designs with a recycling symbol displayed on the same can or bottle. This common symbol included on packaging for beverages sold by different companies would not be sufficiently unique to satisfy *Seabrook's* inherent distinctiveness test. Moreover, the recycling symbol is unlikely to acquire distinctiveness through use and fails to function as a mark because it is not used and perceived as a mark that identifies and distinguishes a single source of a product.<sup>11</sup>

Importantly, when a decision-maker classifies a word or symbol as inherently distinctive under trademark law, this determination should not automatically result in a finding that this subject matter functions as a mark.<sup>12</sup> For example, the phrase I LOVE YOU may be classified as inherently distinctive for jewelry under the *Abercrombie* test, as this term is not the generic or descriptive name for these goods, but consumers are unlikely to perceive the phrase as a trademark for this product. As explained by the Trademark Trial and Appeal Board ("TTAB")—an administrative body that functions like a court for trademark matters at the United States Patent and Trademark Office ("USPTO")—the term I LOVE YOU conveys an endearment and is merely ornamental when displayed on a bracelet.<sup>13</sup> "It does not identify and distinguish the source of the bracelet, especially where there is so much jewelry decorated with the term I LOVE YOU in the marketplace."<sup>14</sup>

Per the Trademark Manual of Examining Procedure ("TMEP") used by USPTO examining attorneys and the TTAB for guidance on trademark laws, matter that is not "used as a trademark" can be refused registration on failure to function grounds "due to its inherent nature or the manner in which it is

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9. See, e.g., *Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225, 240–47 (5th Cir. 2010) (discussing problems with applying the *Abercrombie* test to shapes and other non-word marks, and using the test set forth in *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 1344 (C.C.P.A. 1977)); MCCARTHY, *supra* note 2, §§ 8:8, 8:13, 11:2, 11:4.

10. *Seabrook Foods, Inc.*, 568 F.2d at 1344; MCCARTHY, *supra* note 2, § 8:13. For details about the *Seabrook* test, see *infra* Section II.B.

11. U.S. PATENT & TRADEMARK OFFICE, U.S. DEP'T OF COMMERCE, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1202.17 (Oct. 2018) [hereinafter TMEP], <https://tmepp.uspto.gov/RDMS/TMEP/current> [<https://perma.cc/R28N-M7PQ>].

12. *In re Aerospace Optics, Inc.*, 78 U.S.P.Q.2d 1861, 1862, 1864 (T.T.A.B. 2006) ("Even an inherently distinctive designation is not a trademark if it is not used in a trademark manner."); MCCARTHY, *supra* note 2, § 3.3.

13. *In re Peace Love World Live, LLC*, 127 U.S.P.Q.2d (BNA) 1400, 1403 (T.T.A.B. 2018).

14. *Id.*

used.”<sup>15</sup> Arguably the term I LOVE YOU inherently fails to function as a mark for jewelry regardless of whether this common phrase is displayed on the product or on tags or boxes for the jewelry. However, for other types of products, such as computers, I LOVE YOU might function as a mark if that term is used as a mark in a manner similar to how SAMSUNG, DELL, Apple’s logo, and other brand names and symbols are displayed on products or their packaging.

Courts may also conclude that an inherently distinctive phrase or design is not a valid mark when it is not used and perceived as a mark for the alleged trademark owner’s goods or services. For example, the Sixth Circuit Court of Appeals refused to protect trademark rights in the unique design of Cleveland’s Rock and Roll Hall of Fame and Museum after the court determined that the unregistered design was not being used as a mark and consumers did not perceive it as a mark for museum services.<sup>16</sup> Yet judicial use of failure to function doctrine is not common in trademark disputes today. Most courts fail to evaluate whether words or designs are actually used as a trademark by the party claiming trademark rights and instead focus on whether this mark is inherently distinctive or requires proof of acquired distinctiveness under the *Abercrombie* or *Seabrook* tests.<sup>17</sup>

This is a problem since the federal trademark statute—also known as the Lanham Act—requires a word, name, symbol, or device claimed as a mark to be *used as a trademark* to identify and distinguish goods or services and to indicate their source before it can be registered on the USPTO’s Principal Register and protected by courts under trademark law.<sup>18</sup> This rule promotes fair competition and trademark law’s other purposes by limiting the government’s grant of trademark rights to language, designs, and other communicative symbols that actually convey source-identifying product information.<sup>19</sup> As a registration provides notice of trademark rights and is usually cited in a demand letter or complaint alleging trademark violations, allowing matter not genuinely used and perceived as a mark to be registered is deceptive, harms competition, and can stifle commercial expression. Competitors and others may decide not to use this phrase, design, color, or

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15. TMEP, *supra* note 11, § 1202.

16. *Rock & Roll Hall of Fame & Museum, Inc. v. Gentile Prods.*, 134 F.3d 749, 753–56 (6th Cir. 1998).

17. Alexandra J. Roberts, *Trademark Failure to Function*, 104 IOWA L. REV. 1977, 1981–85, 2028–33 (2019).

18. TMEP, *supra* note 11, § 1202 (citing 15 U.S.C. §§ 1051–52, 1127 (2012)).

19. For information about the goals of federal trademark law, see 15 U.S.C. § 1127 (2012) (discussing the intent of the Lanham Act); *Matal v. Tam*, 137 S. Ct. 1744, 1751–52 (2017); *id.* at 1768 (Kennedy, J., concurring); *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 28 (2001); *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 214 (2000); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163–64 (1995); and Lisa P. Ramsey, *Free Speech Challenges to Trademark Law After Matal v. Tam*, 56 HOUS. L. REV. 401, 447–48 (2018).

other product attribute because of the registration.<sup>20</sup> As there is a statutory basis for the use as a trademark requirement and this rule furthers trademark law's goals and protects expressive values, one would expect failure to function doctrine to be discussed extensively in trademark scholarship. It is not. Professor Alexandra Roberts' excellent *Trademark Failure to Function* article fills this gap in the trademark literature.<sup>21</sup>

Professor Roberts correctly points out that courts, attorneys, and scholars should be paying more attention to whether matter claimed as a mark is actually used and perceived as a mark, and not just rely on distinctiveness doctrine to ensure that we are registering and protecting trademarks, and not just "mere words" or other matter that is not serving as a source-distinguishing mark.<sup>22</sup> She proposes that the USPTO and courts integrate their analysis of the distinctiveness of a mark with an evaluation of whether the word or symbol claimed as a mark is actually used as a mark, and refuse to protect matter that does not create a separate commercial impression.<sup>23</sup> Her identification of this important but underused requirement for trademark protection and detailed discussion of the difference between distinctiveness doctrine and failure to function doctrine is a significant contribution to the trademark field.

This Essay responds to Professor Roberts' paper by following her advice to focus more attention on whether matter claimed as a mark is actually used and perceived as a trademark that identifies and distinguishes products and indicates their source. I agree with her that failure to function doctrine should be used more frequently to protect free speech and competition in trademark law.<sup>24</sup> Below I explain in detail how the USPTO and courts can use this trademark doctrine to safeguard the public domain—the words and symbols companies can use in connection with the advertising and sale of their products—against efforts to claim trademark rights in memes, offensive terms

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20. See, e.g., Constance Grady, *How an Author Trademarking the Word "Cocky" Turned the Romance Novel Industry Inside Out*, VOX (July 24, 2018, 1:08 PM), <https://www.vox.com/culture/2018/5/15/17339578/cockygate-explained-romance-publishing-faleena-hopkins> [<https://perma.cc/6JBW-76PG>] (discussing how authors retitled their books and Amazon suspended sales of other books with "Cocky" in the title after one author claimed trademark rights in the word COCKY registered as a mark for a series of romance novels).

21. Roberts, *supra* note 17. Note that several scholars have argued there is or should be a requirement that the defendant use another's mark as a trademark for liability under trademark law. See Margreth Barrett, *Finding Trademark Use: The Historical Foundation for Limiting Infringement Liability to Uses "In the Manner of a Mark"*, 43 WAKE FOREST L. REV. 893, 894–901 (2008); Stacey L. Dogan & Mark A. Lemley, *Grounding Trademark Law Through Trademark Use*, 92 IOWA L. REV. 1669, 1670–82 (2007); Eric Goldman, *Deregulating Relevancy in Internet Trademark Law*, 54 EMORY L.J. 507, 593–95 (2005). Others disagree on descriptive and normative grounds, and correctly note there is no explicit trademark use requirement in the infringement statute. See Graeme B. Dinwoodie & Mark D. Janis, *Confusion Over Use: Contextualism in Trademark Law*, 92 IOWA L. REV. 1597, 1599–1661 (2007).

22. Roberts, *supra* note 17, at 1981–2016, 2024–33.

23. *Id.* at 2033–44.

24. *Id.* at 1987, 2044.

and symbols, words and designs commonly used in an industry, and other widely used messages and product features that were inherently valuable in the marketplace before people tried to register and protect them as trademarks.

Trademark law's requirement that marks be distinctive and non-functional promotes free speech, competition, and trademark law's other purposes, but Part II explains that the "use as a trademark" requirement for trademark protection is a separate doctrinal tool that can be used by the USPTO and courts to achieve these goals. In Part III, I argue that failure to function analysis will be especially useful when companies seek to obtain or enforce trademark rights in (1) words, designs, or décor that are not used and perceived as a trademark despite being classified as inherently distinctive under the *Abercrombie* or *Seabrook* tests; (2) the name or likeness of fictional characters and other elements from creative works not used as a mark for real-world products; and (3) product shapes, colors, scents, flavors, and other "non-traditional" trademark subject matter perceived as an attribute of a product.<sup>25</sup> Part IV contends that decision-makers should separately consider whether matter is used and perceived as a trademark and not combine failure to function analysis with the evaluation of a mark's distinctiveness.

## II. FAILURE TO FUNCTION DOCTRINE AND ITS RELATIONSHIP TO OTHER TRADEMARK LAWS

Almost any type of subject matter capable of conveying source-distinguishing meaning can qualify as a trademark in the United States, and thus the more important questions when determining the validity of a mark are whether that word, symbol, or other matter is distinctive, is not functional, and is used and perceived as a trademark. This Part introduces these requirements for trademark registration and protection to provide background for the discussion in Parts III and IV.

### A. ALMOST ANYTHING CAN QUALIFY AS PROTECTABLE TRADEMARK SUBJECT MATTER

As explained in Sections 1 and 2 of the Lanham Act, the owner of a trademark may register that mark on the Principal Register if the trademark applicant satisfies all of the requirements in the Lanham Act and no exception to registration of that mark applies.<sup>26</sup> Per Section 45 of the Lanham Act, which contains the definition of various terms in the federal trademark statute,

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<sup>25</sup> For general information about non-traditional trademarks, see generally THE PROTECTION OF NON-TRADITIONAL TRADEMARKS: CRITICAL PERSPECTIVES (Irene Calboli & Martin Senftleben eds., 2018).

<sup>26</sup> 15 U.S.C. §§ 1051-1052 (2012). For a detailed discussion about the process of registering trademarks in the United States, see MCCARTHY, *supra* note 2, §§ 19:1-122; and Rebecca Tushnet, *Registering Disagreement: Registration in Modern American Trademark Law*, 130 HARV. L. REV. 867, 873-81 (2017).

[t]he term “trademark” includes any word, name, symbol, or device, or any combination thereof—

- (1) used by a person, or
- (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.<sup>27</sup>

As explained by the U.S. Supreme Court in *Qualitex*, this statutory provision listing the types of subject matter eligible for registration and protection is quite broad.<sup>28</sup> “Since human beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of carrying meaning,” the Court said “this language, read literally, is not restrictive.”<sup>29</sup> Per the Court, “[i]t is the source-distinguishing ability of a mark—not its ontological status as color, shape, fragrance, word, or sign—that permits it to serve the[] basic purposes” of trademark law.<sup>30</sup> After *Qualitex* it is clear that companies can register marks consisting of a single color (such as magenta for T-Mobile’s wireless telecommunication services), three-dimensional shape (such as LEGO’s product configuration for its Minifigure toy figures), fragrance (such as Hasbro Inc.’s scent of its Play-Doh toy modeling compound), and other features or trade dress of goods and services.<sup>31</sup> As almost anything capable of carrying source-distinguishing meaning can qualify as a mark, examining attorneys and courts evaluating the validity of a proposed mark usually focus first on whether that subject matter is distinctive.

#### B. A TRADEMARK MUST BE DISTINCTIVE

A mark must be inherently distinctive or have acquired distinctiveness through use before it will be eligible for registration on the Principal Register and capable of protection in trademark litigation against third parties.<sup>32</sup> If a sign is not yet distinctive, but is capable of becoming distinctive through use

27. 15 U.S.C. § 1127.

28. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162–64 (1995); Jane C. Ginsburg, “*See Me, Feel Me, Touch Me, Hear Me*” (and *Maybe Smell and Taste Me Too*): *I Am a Trademark—A US Perspective*, in *TRADE MARKS AND BRANDS: AN INTERDISCIPLINARY CRITIQUE* 92, 93–97 (Lionel Bently, Jennifer Davis & Jane C. Ginsburg eds., 2008); Graeme B. Dinwoodie, *The Death of Ontology: A Teleological Approach to Trademark Law*, 84 IOWA L. REV. 611, 646–47 (1999).

29. *Qualitex*, 514 U.S. at 162.

30. *Id.* at 164.

31. Registration No. 3,263,625 (color); Registration No. 4,903,968 (shape); Registration No. 5,467,089 (scent).

32. 15 U.S.C. § 1052(f); *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 211 (2000); TMEP, *supra* note 11, § 1212.

of the mark, the USPTO may register the sign on the Supplemental Register instead of the Principal Register.<sup>33</sup> Courts determine whether a word mark is distinctive for certain goods or services using the *Abercrombie* test, which classifies that language as generic, descriptive, suggestive, arbitrary, or fanciful for that product.<sup>34</sup> If a term is a generic or common name for this type of product (such as FOOTLONG for sandwiches or ESCALATOR for a moving stairway), it cannot be registered or protected under trademark law regardless of whether some consumers associate that phrase with the company claiming trademark rights.

Descriptive words (such as 24 HOUR FITNESS for health club services) are eligible for registration and protection upon proof these terms have acquired distinctiveness through use in the marketplace. As explained by the Supreme Court, “a mark has acquired distinctiveness . . . if it has developed secondary meaning, which occurs when, ‘in the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself.’”<sup>35</sup> This may be established using surveys showing consumers associate the mark with its alleged trademark owner, and with evidence about the company’s extensive sales and advertising of products featuring the mark and its lengthy and substantially exclusive use of the mark.<sup>36</sup> Advertising which instructs consumers to “look for” the mark to identify the product’s source may also be helpful in establishing acquired distinctiveness and educate consumers to perceive this word as a trademark.<sup>37</sup> Proof of acquired distinctiveness is not required to register or protect marks that are suggestive (such as TIDE for laundry detergent), arbitrary (such as APPLE for computers), or fanciful (such as CLOROX for bleach, and other coined terms). Per the Supreme Court, these marks are deemed inherently distinctive because “their intrinsic nature serves to identify a particular source of a product.”<sup>38</sup>

For stylized words or letters, logos, product packaging designs, restaurant décor, and retail store designs or layouts, the USPTO and courts primarily use the *Seabrook* test to evaluate whether this matter is inherently distinctive or

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33. 15 U.S.C. § 1091. The Supplemental Register does not confer any substantive trademark rights, but it can help a company obtain registration of descriptive terms and other non-inherently-distinctive signs in foreign countries, among other things. MCCARTHY, *supra* note 2, §§ 4:12, 19:33.

34. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9–10 (2d Cir. 1976); MCCARTHY, *supra* note 2, § 11:2.

35. *Wal-Mart*, 529 U.S. at 211 (alteration in original) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.11 (1982)).

36. 37 C.F.R. § 2.41(a)(3) (2018); TMEP, *supra* note 11, §§ 1212.03, 1212.06; MCCARTHY, *supra* note 2, §§ 15:1–73 (discussing secondary meaning).

37. MCCARTHY, *supra* note 2, §§ 7:30, 15:30.

38. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992). *But see* *Bone*, *supra* note 7, at 2130 (“Source identification is not something intrinsic or natural to a symbol; it is an empirical property that results from the way a symbol actually operates in the marketplace.”).

instead requires proof of acquired distinctiveness for registration and protection.<sup>39</sup> The *Seabrook* test includes four factors to consider when evaluating whether an alleged mark is inherently distinctive: (1) is it a common basic shape or design? (2) is it unique or unusual in this particular field? (3) is it a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods? and (4) is it capable of creating a commercial impression distinct from any accompanying words?<sup>40</sup> Symbols, designs, and décor that are unique or unusual in an industry are more likely to be found inherently distinctive under this analysis, as will matter that creates a separate commercial impression apart from any brand names or other source-identifying words. If the alleged mark is not inherently distinctive under the *Seabrook* test and there is no evidence of acquired distinctiveness, this subject matter cannot qualify as a trademark.<sup>41</sup>

Other “symbols” or “devices” used as trademarks are never deemed inherently distinctive and must acquire distinctiveness through use before they will be registered and protected under trademark law. For example, the Supreme Court has held that marks consisting of a product design (such as the design of children’s clothing) or color (such as green-gold for dry cleaning press pads) always require proof of secondary meaning for trademark protection.<sup>42</sup> Per the Court, “consumer predisposition to equate the feature with the source does not exist” for such marks and “[c]onsumers are aware of the reality that, almost invariably, even the most unusual of product designs—such as a cocktail shaker shaped like a penguin—is intended not to identify the source, but to render the product itself more useful or more appealing.”<sup>43</sup> Scents, flavors, and other product features commonly perceived as attributes of the goods or services also cannot qualify as inherently distinctive marks and require a substantial showing of acquired distinctiveness before the USPTO will register them on the Principal Register.<sup>44</sup>

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39. *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 1344 (C.C.P.A. 1977); TMEP, *supra* note 11, §§ 1202.02(b)(ii), 1202.19(e)(i); MCCARTHY, *supra* note 2, § 8:13. *See also In re Chippendales USA, Inc.*, 622 F.3d 1346, 1351–52 (Fed. Cir. 2010) (applying *Seabrook* test to trade dress for exotic dancing services and finding it not inherently distinctive); *Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225, 243–47 (5th Cir. 2010) (holding star symbol was not inherently distinctive under the *Seabrook* test).

40. *Seabrook*, 568 F.2d at 1344.

41. *Id.*; MCCARTHY, *supra* note 2, § 8:13. Note that some courts have held that trade dress and nonword symbols can be “generic” for certain products and thus not protected as trademarks regardless of whether they have acquired secondary meaning. MCCARTHY, *supra* note 2, §§ 8:6.50, 12:36.50.

42. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 212 (2000); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162–63 (1995).

43. *Wal-Mart*, 529 U.S. at 213.

44. TMEP, *supra* note 11, §§ 1202.02(b), 1202.05(a), 1202.13. *See, e.g., In re Pohl-Boskamp GmbH & Co. KG*, 106 U.S.P.Q.2d (BNA) 1042, 1048–49 (T.T.A.B. 2013).

C. FUNCTIONAL MATTER CANNOT BE REGISTERED OR PROTECTED

Regardless of whether a word, name, symbol, or device is distinctive, the Lanham Act bans registration of “any matter that, as a whole, is functional.”<sup>45</sup> Moreover, if the mark is not registered on the Principal Register, a company asserting trade dress protection in a civil action for infringement must “prov[e] that the matter sought to be protected is not functional.”<sup>46</sup> As explained by the Supreme Court, “functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm’s reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature.”<sup>47</sup>

“[A] product feature is functional,[] and cannot serve as a trademark, ‘if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.’”<sup>48</sup> Examples of utilitarian product features deemed to be functional under trademark law are the design of a dual-spring mechanism that keeps road signs upright,<sup>49</sup> and the shape of the iPhone and design of that smart phone’s on-screen icons.<sup>50</sup> In addition, if granting exclusive trademark rights to a design, color, or other product feature desired by consumers for aesthetic reasons “would put competitors at a significant non-reputation-related disadvantage,” this trade dress may also be deemed functional under the Court’s separate competitive necessity test.<sup>51</sup> An example is the color black for floral packaging.<sup>52</sup> Allowing registration of this color would prevent competing flower shops from selling flowers with black packaging to consumers who prefer to purchase a product displaying this color inherently associated with bereavement, elegance, and Halloween.<sup>53</sup>

Functional product features may be refused trademark registration and protection on the separate ground that they are not used and perceived as a mark. For example, the TTAB affirmed an examining attorney’s refusal to register an orange flavor claimed as a mark for antidepressants in quick-dissolving tablets and other pharmaceuticals because the flavor was functional,<sup>54</sup> and failed to function as a mark.<sup>55</sup> Functionality doctrine focuses

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45. 15 U.S.C. § 1052(e)(5) (2012); TMEP, *supra* note 11, § 1202.02(a)(i).

46. 15 U.S.C. § 1125(a)(3).

47. *Qualitex*, 514 U.S. at 164.

48. *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32 (2001) (quoting *Qualitex*, 514 U.S. at 165).

49. *Traffix Devices*, 532 U.S. at 30–35.

50. *Apple Inc. v. Samsung Elecs. Co.*, 786 F.3d 983, 990–96 (Fed. Cir. 2015), *rev’d and remanded on other grounds*, 137 S. Ct. 429 (2016).

51. *Traffix Devices*, 532 U.S. at 32 (quoting *Qualitex*, 514 U.S. at 165).

52. *In re Florists’ Transworld Delivery, Inc.*, 106 U.S.P.Q.2d (BNA) 1784, 1786–92 (T.T.A.B. 2013).

53. *Id.* at 1789. For more information about functionality doctrine, see MCCARTHY, *supra* note 2, §§ 7:63–:93; and TMEP, *supra* note 11, § 1202.02(a)-(a) (viii).

54. *In re N.V. Organon*, 79 U.S.P.Q.2d (BNA) 1639, 1644–49 (T.T.A.B. 2006).

55. *Id.* at 1649–51.

on whether trademark protection of this product feature would provide an unfair competitive advantage for utilitarian or aesthetic reasons, while failure to function doctrine focuses on whether the matter actually functions as a trademark that identifies and distinguishes a product's source, as explained next.

*D. THIS MATTER MUST BE USED AND FUNCTION AS A TRADEMARK*

As noted previously, a trademark is a word, name, symbol, or device (or combination of these) that is used by a company “to identify and distinguish [its] goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods.”<sup>56</sup> The Lanham Act has a similar definition for a “service mark” in Section 45,<sup>57</sup> and Section 3 clarifies that the provisions relating to the registration of trademarks in Sections 1 and 2 generally apply to service marks.<sup>58</sup> If matter claimed as a mark does not actually identify and distinguish that company's products and indicate their source, it is not being used as a “trademark” or “service mark,” and it cannot be registered on the Principal Register per Sections 1, 2, 3, and 45 of the Lanham Act.<sup>59</sup>

These statutory provisions are cited by the USPTO in its TMEP provision which provides that the subject matter for which registration is sought must be “used as a trademark.”<sup>60</sup> While the statutory basis for refusing registration of a mark on the ground of lack of distinctiveness is the same,<sup>61</sup> failure to function is a separate ground for refusal of a registration.<sup>62</sup> As explained by the USPTO in the TMEP, “[n]ot everything that a party adopts and uses with the intent that it function as a trademark necessarily achieves this goal or is legally capable of doing so, and not everything that is recognized or associated with a party is necessarily a registrable trademark.”<sup>63</sup> Examining attorneys can

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56. 15 U.S.C. § 1127 (2012).

57. *Id.*

58. *Id.* § 1053.

59. *Id.* §§ 1051–1053, 1127; *In re Bose Corp.*, 546 F.2d 893, 896 (C.C.P.A. 1976).

60. TMEP, *supra* note 11, § 1202.

61. *Id.* § 1202.02(b) (citing 15 U.S.C. §§ 1051–1053, 1127).

62. *Id.* §§ 1202.04, 1202.17(c)(ii), 1212.02(i), 1301.02(a). *See, e.g., In re Yarnell Ice Cream LLC*, 2019 U.S.P.Q.2d (BNA) 265039, 2019 BL 265039, at \*4–18 (T.T.A.B. July 9, 2019) (affirming refusal to register SCOOP for frozen confections and ice cream on the separate grounds of mere descriptiveness and failure to function); *In re Wakefern Food Corp.*, 222 U.S.P.Q. (BNA) 76, 77–80 (T.T.A.B. 1984) (affirming examining attorney's refusal to register WHY PAY MORE! for supermarket services on the ground the slogan does not function as a mark, but reversing the second determination that the mark is merely descriptive after finding this phrase suggestive); *In re Niagara Frontier Servs., Inc.*, 221 U.S.P.Q. (BNA) 284, 284–85 (T.T.A.B. 1983) (affirming refusal to register WE MAKE IT, YOU BAKE IT! for supermarket services based on failure to function grounds, but holding the slogan was suggestive and not merely descriptive).

63. TMEP, *supra* note 11, § 1202. *See also id.* § 1301.02; *In re Keep A Breast Found.*, 123 U.S.P.Q.2d (BNA) 1869, 1879 (T.T.A.B. 2017) (finding a three dimensional design failed to function as a mark for services related to breast cancer awareness); *In re Aerospace Optics, Inc.*,

reject an application to register on the Principal Register any “subject matter that, due to its inherent nature or the manner in which it is used, does not function as a mark to identify and distinguish the applicant’s goods.”<sup>64</sup> Thus, subject matter can fail to function as a mark for a certain product (1) because of its inherent characteristics (such as flavors for food and widely used messages for apparel) or (2) because of how it is used (such as use of a phrase in a descriptive or informational manner or in a place on products or packaging where marks are usually not displayed).<sup>65</sup>

Per the TTAB, “[t]he critical question in determining whether [matter] functions as a trademark is the commercial impression it makes on the relevant public, *i.e.*, whether the term [or symbol] sought to be registered would be perceived as a mark identifying the source of the goods.”<sup>66</sup> Applicants for a trademark registration are required to submit a detailed “drawing” showing the mark sought to be registered and/or a description of the mark if the mark is not in standard characters (e.g., it is a product shape or scent rather than a phrase).<sup>67</sup> For use-based applications, they must also provide a “specimen” demonstrating how the mark is used in commerce, such as a photograph of the mark affixed to the product or its packaging.<sup>68</sup> The USPTO uses this information in the application and other evidence in the record (such as promotional materials) to determine if the matter claimed as a mark should be refused registration based on failure to function grounds or for other reasons set forth in the Lanham Act.<sup>69</sup> Examining attorneys are required to evaluate the meaning of the proposed mark and the commercial impression created by the context and manner of use of the mark with this product—*i.e.*, whether the phrase, symbol, or other matter is located in the more prominent “trademark spot” separate and different from surrounding words or designs, or is otherwise used in a “trademark way.”<sup>70</sup>

Examples of matter which may fail to function as a trademark include words and symbols that convey product information or which communicate a

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78 U.S.P.Q.2d (BNA) 1861, 1862, 1864 (T.T.A.B. 2006) (holding that SPECTRUM for illuminated pushbutton switches “fails to function as a mark not only because of the informational nature of the term, but also because of the way it appears on the specimen”).

64. TMEP, *supra* note 11, §§ 1202, 1202.17(c).

65. Professor Roberts’ paper focuses on the second type of failure to function refusal, Roberts, *supra* note 17, while this paper discusses both types. For an excellent summary of many of the TTAB decisions discussed in this paper, see generally John L. Welch, TTABLOG, <http://thettablog.blogspot.com> [<https://perma.cc/KJN3-VB3Z>].

66. *In re Peace Love World Live, LLC*, 127 U.S.P.Q.2d (BNA) 1400, 1403 (T.T.A.B. 2018).

67. TMEP, *supra* note 11, §§ 807, 808.

68. *Id.* § 904.

69. *Id.* § 1202. See, e.g., *In re Peace Love World Live*, 127 U.S.P.Q.2d at 1402–03.

70. TMEP, *supra* note 11, § 1202; Roberts, *supra* note 17, at 1981, 2005–06 & n.125, 2038–39, 2043 (citing Thomas R. Lee et al., *An Empirical and Consumer Psychology Analysis of Trademark Distinctiveness*, 41 ARIZ. ST. L.J. 1033, 1055–57 (2009)).

widely used message.<sup>71</sup> To determine the inherent significance of words or symbols, examining attorneys will consider “[a]ny evidence demonstrating that the public perception of the matter is merely to convey general information about the goods or services,” such as dictionary and encyclopedia entries, website pages, social media posts, product fact sheets, and other materials showing how this language is used in the marketplace.<sup>72</sup> Per the TTAB, “[t]he more commonly a phrase is used, the less likely that the public will use it to identify only one source and the less likely that it will be recognized by purchasers as a trademark.”<sup>73</sup> “[A]s a matter of competitive policy, it should be close to impossible for one competitor to achieve exclusive rights’ *in common phrases or slogans*” and prevent others from freely using familiar terms in an industry.<sup>74</sup> Thus, the TMEP instructs examining attorneys to not register “merely informational” phrases or designs that “convey ordinary or familiar concepts or sentiments, as well as social, political, religious, or similar informational messages that are in common use or are otherwise generally understood.”<sup>75</sup>

The USPTO has refused to register several proposed marks on the ground they are merely informational matter that fails to function as a mark, including SCOOP for frozen confections and ice cream,<sup>76</sup> WORLD’S BEST DOWN for pillows and other bedding containing down,<sup>77</sup> UNLIMITED CARRYOVER for telecommunication services,<sup>78</sup> INVESTING IN AMERICAN

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71. TMEP, *supra* note 11, § 1202.04. Universal symbols that convey non-source-identifying messages—such as the recycling or biohazard symbols—are commonly refused registration on failure to function grounds. *Id.* § 1202.17. Due to their inherent nature, some universal “symbols are so widely used and well known that they will have only non-trademark significance when used with almost any good or service in any context or field.” *Id.* § 1202.17(e).

72. *Id.* § 1202.04(a).

73. *In re* Peace Love World Live, LLC, 127 U.S.P.Q.2d (BNA) 1400, 1402, 1406 (T.T.A.B. 2018) (quoting *In re* Eagle Crest, Inc., 96 U.S.P.Q.2d (BNA) 1227, 1229 (T.T.A.B. 2010) (not precedential)) (finding “that I LOVE YOU used in connection with jewelry is such a commonly used term with a well-recognized meaning expressing the feelings of the purchaser or the person wearing the jewelry that consumers are conditioned to look for differences among trademarks consisting of or including I LOVE YOU for jewelry”).

74. *In re* Volvo Cars of N. Am. Inc., 46 U.S.P.Q.2d (BNA) 1455, 1459–61 (T.T.A.B. 1998) (emphasis in original) (quoting MCCARTHY, *supra* note 2, § 7:23). *See also In re* Schwauss, 217 U.S.P.Q. (BNA) 361, 362 (T.T.A.B. 1983) (allowing registration of FRAGILE for labels and bumper stickers would harm competition and “would achieve the absurd result of hampering others in their use of the common word ‘fragile’ on any label designed to be placed on any other object to indicate the fragility of said object”).

75. TMEP, *supra* note 11, § 1202.04(b).

76. *In re* Yarnell Ice Cream LLC, 2019 U.S.P.Q.2d (BNA) 265039, 2019 BL 265039, at \*16–18 (T.T.A.B. 2019).

77. *In re* Eddie Bauer Licensing Services LLC, No. 87471896, 2019 WL 4511580, at \*2–5 (T.T.A.B. 2019) (not precedential).

78. *In re* TracFone Wireless, Inc., 2019 U.S.P.Q.2d 222983, 2019 WL 2511861, at \*1 (T.T.A.B. 2019).

JOB'S for retail services,<sup>79</sup> I ♥ DC for clothing and other types of souvenirs,<sup>80</sup> ONCE A MARINE, ALWAYS A MARINE for clothing,<sup>81</sup> DRIVE SAFELY for automobiles,<sup>82</sup> THINK GREEN for weather stripping and other products advertised to be environmentally responsible,<sup>83</sup> WATCH THAT CHILD for crushed stone and other construction material,<sup>84</sup> PROUDLY MADE IN USA for electric shavers,<sup>85</sup> and a stylized version of the word FRAGILE for labels and bumper stickers.<sup>86</sup>

Certain language and symbols displayed prominently on apparel, fashion accessories, and household items may also be refused registration on the ground that this matter “is merely ornamentation” or a decorative feature of the product that does not function as a mark.<sup>87</sup> As explained by the USPTO in the TMEP, “[c]ommon expressions and symbols (e.g., the peace symbol, ‘smiley face,’ or the phrase ‘Have a Nice Day’) are normally not perceived as marks.”<sup>88</sup> Examples of words and designs found to be merely ornamental include I LOVE YOU for jewelry;<sup>89</sup> SUMO printed on T-shirts and hats;<sup>90</sup> an image of Uncle Sam (a popular symbol for the United States government featuring an older man dressed in red, white, and blue) for games, food, beer, and similar products;<sup>91</sup> and a repeating diamond pattern design applied to the lower third of electronic hookah cylinders.<sup>92</sup>

The TMEP instructs examining attorneys evaluating whether matter is merely ornamental to consider “the commercial impression of the proposed mark” and “the relevant practices of the trade”—an analysis similar to *Seabrook’s* factors for evaluating inherent distinctiveness—along with “evidence of distinctiveness,” among other things.<sup>93</sup> This evaluation would include consideration of the size, location, dominance, and significance of

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79. *In re Wal-Mart Stores, Inc.*, No. 86261962, 2019 WL 193990, at \*1–2 (T.T.A.B. 2019).

80. *D.C. One Wholesaler, Inc. v. Chien*, 120 U.S.P.Q.2d (BNA) 1710, 1716 (T.T.A.B. 2016) (not precedential).

81. *In re Eagle Crest, Inc.*, 96 U.S.P.Q.2d (BNA) 1227, 1229 (T.T.A.B. 2010) (not precedential).

82. *In re Volvo Cars of N. Am. Inc.*, 46 U.S.P.Q.2d (BNA) 1455, 1460–61 (T.T.A.B. 1998).

83. *In re Manco Inc.*, 24 U.S.P.Q.2d (BNA) 1938, 1942 (T.T.A.B. 1992).

84. *In re Tilcon Warren, Inc.*, 221 U.S.P.Q. (BNA) 86, 87–88 (T.T.A.B. 1984).

85. *In re Remington Prods. Inc.*, 3 U.S.P.Q.2d (BNA) 1714, 1715–16 (T.T.A.B. 1987).

86. *In re Schwauss*, 217 U.S.P.Q. (BNA) 361, 362–63 (T.T.A.B. 1983).

87. TMEP, *supra* note 11, § 1202.03.

88. *Id.* § 1202.03(a).

89. *In re Peace Love World Live, LLC*, 127 U.S.P.Q.2d (BNA) 1400, 1403–05 (T.T.A.B. 2018).

90. *In re Dimitri’s Inc.*, 9 U.S.P.Q.2d (BNA) 1666, 1667–68 (T.T.A.B. 1998).

91. *In re Uncle Sam GmbH*, No. 79187215, 2019 WL 4034453, at \*4–5 (T.T.A.B. 2019) (not precedential).

92. *In re Fantasia Distribution, Inc.*, 120 U.S.P.Q.2d (BNA) 1137, 1138–46 (T.T.A.B. 2016).

93. TMEP, *supra* note 11, §§ 1202.03–1202.03(d).

the proposed mark as it appears on the goods listed in the application.<sup>94</sup> For example, display of the word or symbol prominently on the front or back of T-shirts is less likely to function as a mark compared to use of it on a tag or label attached to the product.<sup>95</sup> Widespread decorative use of the phrase or design by others is evidence that suggests the matter would be perceived as mere ornamentation rather than as a source-identifying mark.<sup>96</sup> Matter that is determined to be “purely ornamental” cannot be registered because it is incapable of trademark significance, but ornamental matter can be registered if it serves a source-identifying function.<sup>97</sup>

The USPTO may also refuse registration of certain three-dimensional shapes, flavors, scents, and other non-traditional marks on failure to function grounds.<sup>98</sup> For example, the TTAB affirmed the examining attorney’s denial of an application to register a design comprising a “three-dimensional cylindrical cast of female breasts and torso” for associational, educational, and fund-raising services related to breast cancer awareness because that design “will be perceived as part of the services rather than as a mark designating the source of the services.”<sup>99</sup> The TTAB also agreed that registration should be refused on failure to function grounds for a peppermint scent and flavor for pharmaceutical formulations of nitroglycerin and other medicines because consumers would believe these things are product attributes and not source-distinguishing marks.<sup>100</sup>

Importantly, the “use as a trademark” requirement should not be confused with Lanham Act Section 1’s statement that the mark must be “used in commerce” on or in connection with the goods or services listed in the application before it can be registered.<sup>101</sup> Per Section 45 of the Lanham Act, “[t]he word ‘commerce’ means all commerce which may lawfully be regulated by Congress.”<sup>102</sup> In addition, “[t]he term ‘use in commerce’ means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.”<sup>103</sup> A word, symbol, or product feature may be used

94. *In re Peace Love World Live, LLC*, 127 U.S.P.Q.2d (BNA) 1400, 1403 (T.T.A.B. 2018). See also TMEP, *supra* note 11, § 1202.03(a).

95. TMEP, *supra* note 11, §§ 904.03(a), 1202.03(f)(i). If matter fails to function as a mark because it does not create the commercial impression of a source indicator due to its inherent nature, submission of a specimen showing use of the proposed mark on a hang tag or label is not sufficient to overcome a refusal on the ground this matter is merely informational. *Id.* § 1202.04(d).

96. *In re Peace Love World Live*, 127 U.S.P.Q.2d at 1402–03.

97. *Bobosky v. Adidas AG*, 843 F. Supp. 2d 1134, 1142–47 (D. Or. 2011); MCCARTHY, *supra* note 2, § 7:24; TMEP, *supra* note 11, §§ 1202.03–1202.03(a).

98. TMEP, *supra* note 11, §§ 1202.03, 1202.05, 1202.13, 1301.02(a).

99. *In re Keep A Breast Found.*, 123 U.S.P.Q.2d (BNA) 1869, 1871, 1879–85 (T.T.A.B. 2017).

100. *In re Pohl-Boskamp GmbH & Co. KG*, 106 U.S.P.Q.2d (BNA) 1042, 1048–52 (T.T.A.B. 2013).

101. 15 U.S.C. § 1051 (2012).

102. 15 U.S.C. § 1127.

103. *Id.* See MCCARTHY, *supra* note 2, §§ 19:103, 19:108.

by a company in the ordinary course of trade when it advertises and sells its products, and thus satisfy the “use in commerce” requirement for registration, but still fail to function as a “trademark” or “service mark” because that matter was not used to identify and distinguish the company’s products and to indicate their source.<sup>104</sup> An example is use of a descriptive phrase on packaging of products for sale (such as FARM TO TABLE on wine bottles)<sup>105</sup> or in advertising for services rendered in commerce (such as OUR LAYWERS ARE DOCTORS for legal services).<sup>106</sup> Such marks are used in commerce with goods or services, but they may be rejected for registration on the ground that they are merely descriptive under Section 2(e)(1) of the Lanham Act,<sup>107</sup> or for the separate reason that they fail to function as a trademark.<sup>108</sup>

As noted in Part I, some courts refuse to protect trademark rights in subject matter that is not used and perceived as a mark, such as the design of the Rock and Roll Hall of Fame and Museum.<sup>109</sup> But unfortunately other courts and some decision-makers at the USPTO ignore whether a phrase, design, or other matter claimed as a mark actually functions as a trademark and pay more attention to whether a word or symbol is distinctive.<sup>110</sup> I agree with Professor Roberts that this should change, and hope more people and companies accused of trademark violations raise failure to function objections to non-source-identifying marks in trademark litigation and in opposition or cancellation proceedings at the USPTO.

### III. EXAMPLES OF HOW FAILURE TO FUNCTION DOCTRINE CAN PROTECT FREE SPEECH AND COMPETITION IN TRADEMARK LAW

The USPTO and courts should always confirm that matter claimed as a mark is actually “used as a trademark”—and be willing to find it does not function as a mark—when this word, name, symbol, or other matter does not identify and distinguish products and indicate their source.<sup>111</sup> Rigorous

104. *In re TracFone Wireless, Inc.*, 2019 U.S.P.Q.2d 222983, 2019 WL 2511861, at \*1 (T.T.A.B. 2019); *In re Aerospace Optics, Inc.*, 78 U.S.P.Q.2d (BNA) 1861, 1862 (T.T.A.B. 2006).

105. *In re Fowles Wine Pty Ltd.*, No. 79157017, 2017 WL 4460470, at \*8 (T.T.A.B. Sept. 15, 2017) (not precedential) (noting this phrase “is an informational statement or slogan used in the food and wine industries to denote locally sourced products and related dining services”).

106. *In re Wilson*, No. 87240575, 2018 WL 5307352, at \*1, 5–8 (T.T.A.B. Oct. 19, 2018) (not precedential).

107. 15 U.S.C. § 1052(e)(1); TMEP, *supra* note 11, §§ 1202.17(d)(i), 1209–1209.01(b).

108. TMEP, *supra* note 11, § 1212.02(i).

109. *Rock & Roll Hall of Fame & Museum, Inc. v. Gentile Prods.*, 134 F.3d 749, 753–56 (6th Cir. 1998); *see also* *MicroStrategy Inc. v. Motorola, Inc.*, 245 F.3d 335, 341–43 (4th Cir. 2001) (holding the phrase INTELLIGENCE EVERYWHERE did not “perform []’ the trademark function of identifying the source of the merchandise to the customers” (alteration in original) (quoting *Rock & Roll Hall of Fame*, 134 F.3d at 753)); *Damn I’m Good Inc. v. Sakowitz, Inc.*, 514 F. Supp. 1357, 1361 (S.D.N.Y. 1981) (“[T]here is no evidence that customers perceived the phrase DAMN I’M GOOD to reflect the source of the bracelets.”).

110. Roberts, *supra* note 17, at 1981–85, 2028–33.

111. *Id.*

application of this requirement—along with the distinctiveness and non-functionality requirements—will better protect free speech and competition. As explained below, failure to function doctrine may be especially useful in circumstances where the alleged mark (1) is classified as “inherently distinctive,” (2) consists of the name or likeness of a fictional character or element from a creative work that is not used as a mark for real-world products, or (3) is a product feature or other non-traditional trademark subject matter that is not perceived as a mark.

A. TRADEMARKS CLASSIFIED AS “INHERENTLY DISTINCTIVE”

First, an accused infringer should argue that a phrase, design, décor, or other matter deemed inherently distinctive under the *Abercrombie* or *Seabrook* tests fails to function as a trademark when it is used by the complaining party in a merely informational or ornamental manner.<sup>112</sup> For example, certain terms or images may be classified as inherently distinctive when used on or in connection with clothing, hats, bags, jewelry, mugs, key chains, flags, wall art, stickers, blank writing journals, and other merchandise that is typically used to display non-source-identifying messages (hereinafter “expressive merchandise”), but fail to function as trademarks that identify the source of these products due to the inherent nature of these proposed marks. This includes (1) words associated with news events or social movements like #METOO (written as #MeToo), BLACK LIVES MATTER, I CAN’T BREATHE, OCCUPY WALL STREET, SEAL TEAM 6, SHOCK AND AWE, and LET’S ROLL; (2) political phrases like KEEP AMERICA GREAT and MAKE AMERICA AMERICA AGAIN; (3) religious phrases like JESUS and symbols like the Star of David; (4) culturally-significant phrases like DIA DE LOS MUERTOS or images like Uncle Sam; (5) positive or inspirational messages like BE GOOD TO PEOPLE and TRUST YOUR JOURNEY; (6) memes like THROWBACK THURSDAY and NEVERTHELESS, SHE PERSISTED; (7) common words like CAT, DOGS, and THE; (8) common symbols like a heart and the mathematical symbol pi; and (9) profanity, racial slurs, and hate symbols,<sup>113</sup> like the word FUCT displayed on athletic apparel

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112. See *id.* at 2033–44; TMEP, *supra* note 11, §§ 1202, 1202.03, 1202.03(f)(i), 1202.04–1204(c), 1202.17(e)(iv).

113. Several of these examples come from law review articles and blog posts questioning whether such phrases or symbols should be registered and protected as trademarks for certain products. See, e.g., Lisa P. Ramsey, *Reconciling Trademark Rights and Free Expression Locally and Globally*, in INTERNATIONAL INTELLECTUAL PROPERTY: A HANDBOOK OF CONTEMPORARY RESEARCH 341, 463–65 (Daniel J. Gervais ed., 2015); Shontavia Jackson Johnson, *Memetic Theory, Trademarks & the Viral Meme Mark*, 13 J. MARSHALL REV. INTELL. PROP. L. 96, 123–29 (2013); Roberts, *supra* note 17, at 2010–16; Alexandra J. Roberts, *Tagmarks*, 105 CALIF. L. REV. 599, 632–41 (2017); Ron Coleman, *Failure to ... Whatever*, LIKELIHOOD OF CONFUSION (Oct. 16, 2017), <http://www.likelihoodofconfusion.com/failure-to-whatever> [https://perma.cc/5KQV-FPUM]; Jon Jekel & Lisa Greenwald-Swire, *Branding Social Movements: Why Attempts to Trademark #MeToo, Black Lives Matter, and Other Movements are Likely to Fail and Could Harm Core Brands*, FISH & RICHARDSON:

sold by Erik Brunetti,<sup>114</sup> and the swastika design that Snowflake Enterprises, LLC recently attempted to register for “[f]abrics that may or may not have printed patterns and designs thereon for use in textile applications, namely, the manufacture of apparel, upholstery, signage, flags, banners and wallpaper.”<sup>115</sup>

To better promote free expression and fair competition, the USPTO and courts should presume these types of common words and symbols fail to function as a mark for apparel and other expressive merchandise and refuse to register or protect them under trademark law. At a minimum, such marks should only be registered and protected if there is substantial evidence that a majority of consumers believe the mark has acquired distinctiveness through use and identifies the source of the product. When these types of marks are displayed on expressive merchandise, they are more like the clothing designs in *Wal-Mart*—not word marks or logos—and should be subject to the rule requiring proof of secondary meaning for trademark rights in product designs.<sup>116</sup> When the proposed mark consists of a popular slogan, a meme, offensive language, or other words and designs commonly used in an industry or community, it is logical to assume that consumer predisposition to equate that term or image with the product’s source does not exist. Common sense dictates that this language is not automatically source-identifying and instead renders the product itself more appealing to consumers interested in that message. The government should require proof the proposed mark is source-identifying before it grants trademark rights in that expression.

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TRADEMARK & COPYRIGHT THOUGHTS BLOG (Feb. 5, 2018), <https://www.fr.com/fishTMCopyrightblog/branding-social-movements> [<https://perma.cc/F2EX-XDCQ>]; Roberto Ledesma, *Do Not File a Trademark Application for a Trending Rallying Cry*, EVERYTHINGTRADEMARKS.COM (Jan. 10, 2015), <https://everythingtrademarks.com/2015/01/10/do-not-file-a-trademark-application-for-a-trending-rallying-cry> [<https://perma.cc/H58H-G8YP>]; Roberto Ledesma, *Peace and Hate at the USPTO*, EVERYTHINGTRADEMARKS.COM (Jan. 28, 2018), <https://everythingtrademarks.com/2018/01/28/peace-and-hate-at-the-uspto> [<https://perma.cc/UGF8-22WA>].

114. FUCT, Registration No. 5,934,763. The USPTO initially refused to register Brunetti’s FUCT mark on the ground it was immoral and scandalous in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a) (2012). *Iancu v. Brunetti*, 139 S. Ct. 2294, 2297–98 (2019). On December 19, 2019, the USPTO registered the mark after the Supreme Court held that the government’s ban on registration of immoral or scandalous marks discriminates on the basis of viewpoint in violation of the First Amendment right to free speech. *Id.* at 2298–302; Registration No. 5,934,763. Two years earlier, the Supreme Court used similar reasoning when it held that Section 2(a)’s ban on registration of matter that may disparage others violated the First Amendment. *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017). In *Tam*, the USPTO cited the disparagement provision when it refused to register THE SLANTS as a mark for the entertainment services of a rock band with Asian-American members who sought to reclaim this term used by others as a racial slur. *Id.* In both cases, the Court did not discuss whether these marks should be refused registration on failure to function grounds or any other grounds.

115. U.S. Trademark Application Serial No. 87,503,998 (filed June 24, 2017) (swastika symbol). The examining attorney refused this application on failure to function grounds on September 19, 2019. *Id.*

116. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 212 (2000).

When considering whether the subject matter fails to function as a mark due to its inherent nature, the focus should primarily be on the meaning of the words or symbol, the context of the use (the specific goods or services), and whether this term or design is currently used by competitors or the public to convey non-source-identifying messages. Evidence that the mark is displayed on a tag or label should be irrelevant in these circumstances, and the USPTO can reject an intent-to-use application without a specimen of use, because the focus is on the intrinsic characteristics of the mark used for these goods or services. On the other hand, when the question is whether the matter functions as a mark due to the manner in which it is used, evidence about the location of the placement of the mark in the advertisement or on the product or packaging is also essential. In that situation, a decision-maker cannot determine whether the matter functions as a mark without also seeing how the word or symbol is used in the marketplace.

Allowing trademark registration and protection of puns, political and social messages, culturally important terms or images, and other common words or designs for expressive merchandise can chill and suppress the speech of competing manufacturers, print-on-demand companies, and others who want to display this language on products sold to people who desire these goods because of the ideas they convey.<sup>117</sup> The USPTO and courts can better protect expressive values and fair competition if they use failure to function doctrine to refuse to register and protect widely used messages and other informational or ornamental matter displayed on apparel and other communicative products regardless of whether the party claiming trademark rights also submits a specimen to the USPTO showing a source-identifying use of the mark on a tag or label. Companies have a free speech right to use these words and designs to communicate non-trademark messages, and consumers have a free speech right to receive that expression.<sup>118</sup>

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117. See Ramsey, *supra* note 19, at 409, 461–69; see, e.g., Joe Light, *On Amazon, T-Shirts With Slogans Expose Frivolous-Trademark Feud*, BLOOMBERG (Dec. 12, 2019 1:00 AM), <https://www.bloomberg.com/news/articles/2019-12-12/on-amazon-t-shirts-with-slogans-expose-frivolous-trademark-feud> [<https://perma.cc/C2PB-XA22>] (discussing the efforts of small business owners to stop frivolous applications to register common phrases for apparel and other expressive merchandise by filing letters of protest with the USPTO). For an excellent discussion of issues relating to trademark merchandising, see generally Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 EMORY L.J. 461 (2005); Irene Calboli, *The Case for a Limited Protection of Trademark Merchandising*, 2011 U. ILL. L. REV. 865.

118. Ramsey, *supra* note 19, at 461–69; cf. MCCARTHY, *supra* note 2, § 7:23 (stating that commonly-used phrases and slogans should either not be registered or should only be given a narrow scope of protection, as “it would be extraordinary for one company to advertise in such a manner as to achieve trademark significance in ordinary and commonly used phrases that are needed by all to effectively compete”). See generally Lisa P. Ramsey, *A Free Speech Right to Trademark Protection?*, 106 TRADEMARK REP. 797 (2016) (arguing we should consider the free speech rights of competitors and the public when deciding whether to allow registration of common words and designs, and not just the right of companies to obtain certain trademarks).

Failure to function doctrine should also play a bigger role when companies attempt to obtain trademark rights in the décor, layout, or design of a restaurant, retail store, website, and other real-world and online places that provide services. As this type of trade dress may be deemed inherently distinctive under the *Seabrook* test if it is unique or unusual, the USPTO and courts should independently determine whether the use as a trademark requirement is satisfied because that trade dress may not function as a mark. For example, in the case *Two Pesos, Inc. v. Taco Cabana, Inc.*, the jury found the “festive eating atmosphere” décor for a Mexican restaurant consisting of “interior dining and patio areas decorated with artifacts, bright colors, paintings and murals” should be classified as inherently distinctive but also determined that Taco Cabana’s trade dress lacked acquired distinctiveness.<sup>119</sup> Thus it is possible the décor failed to function as a mark, as it is unlikely that customers perceived the restaurant’s interior as a mark for a single source of restaurant services if they did not associate the décor only with Taco Cabana. Regardless, the jury and the Court did not consider the failure to function issue and the owner of this trade dress was able to prevent competitors from using a similar festive décor. Decision-makers should evaluate whether an “inherently distinctive” trade dress actually identifies and distinguishes a single source of goods or services and not just focus on whether it satisfies the distinctiveness requirement. The design or décor may be unique or create a separate commercial impression from the brand name of the company, but still not function as a trademark for the company’s services.

The USPTO is doing a better job refusing to register common words or symbols and other merely informational or ornamental matter on failure to function grounds.<sup>120</sup> Still, the public domain will be better protected if more examining attorneys and courts pay attention to whether matter functions as a trademark. The USPTO sometimes registers expression that should remain available for use by competitors and others. For example, several years ago the USPTO registered I ♥ NY for apparel and promoting New York as a tourist attraction;<sup>121</sup> LIFE IS GOOD for T-shirts, hats, and other sportswear;<sup>122</sup>

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119. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 765–76 (1992).

120. See *supra* Section II.D (discussing examples of proposed marks rejected on failure to function grounds). The USPTO issued new guidelines for merely informational matter in 2017. See USPTO, EXAMINATION GUIDE 2-17: MERELY INFORMATIONAL MATTER (2017), available at [https://www.uspto.gov/sites/default/files/documents/Merely\\_Informational\\_Matter\\_Exam\\_Guide\\_July\\_2017.doc](https://www.uspto.gov/sites/default/files/documents/Merely_Informational_Matter_Exam_Guide_July_2017.doc).

121. I ♥ NY, Registration No. 1,555,836 (registered Sept. 12, 1989 for apparel); I ♥ NY, Registration No. 1,558,379 (registered Sept. 26, 1989 for promoting New York as a tourist attraction). New York State Department of Economic Development owns these “I ♥ NY” registrations in addition to registrations for other products, and is willing to license use of the marks. See I ♥ NY, Registration No. 1,555,836; I ♥ NY, Registration No. 1,558,379; *Licensing Information*, I ♥ NY, <https://www.iloveny.com/licensee-info> [<https://perma.cc/H428-PFQG>].

122. LIFE IS GOOD, Registration No. 2,025,737 (registered on Dec. 24, 1996). This mark is owned by The Life is Good Company. *Id.*

DON'T MESS WITH TEXAS for magnets, jewelry, key chains, clothing, and other promotional goods;<sup>123</sup> and the phrase IF YOU SEE SOMETHING, SAY SOMETHING for promoting public awareness of public safety and security issues.<sup>124</sup> The owners of these registrations—three of which are government agencies—tried to stop expressive use of these phrases by third parties in a manner that harms competition and free expression.<sup>125</sup>

An accused infringer cannot petition to cancel these marks on failure to function grounds because the marks have been registered for more than five years and, after that time period, failure to function (like lack of distinctiveness) is not a ground for cancellation of a registration under Section 14 of the Lanham Act.<sup>126</sup> In addition, if the registrant's right to use the mark becomes incontestable per Section 15 of the Act, a party accused of trademark violations cannot argue in litigation that the trademark is invalid on failure to function grounds because failure to function (like lack of distinctiveness) is not a defense available under Section 33(b) of the Lanham

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123. DON'T MESS WITH TEXAS, Registration No. 2,619,887 (registered Sept. 17, 2002 for magnets, jewelry, and key chains); DON'T MESS WITH TEXAS, Registration No. 2,627,196 (registered Oct. 1, 2002 for printed matter, paper products, and promotional materials); DON'T MESS WITH TEXAS, Registration No. 3,924,369 (registered Mar. 1, 2011 for clothing). These and other registrations for the phrase DON'T MESS WITH TEXAS are owned by the Texas Department of Transportation. *See, e.g.*, DON'T MESS WITH TEXAS, Registration No. 2,619,887.

124. IF YOU SEE SOMETHING, SAY SOMETHING, Registration No. 3,217,091 (registered Mar. 13, 2007). This mark is owned by the Metropolitan Transportation Authority. *Id.*

125. *See* Complaint and Request for Temporary Restraining Order and Temporary and Permanent Injunction, Texas Dep't of Transp. v. Craig, No 1:11-cv-00726-SS (W.D. Tex. Aug. 19, 2011) (lawsuit against author and companies that helped publish and distribute her romance novel titled "Don't Mess with Texas"); Associated Press, *Don't Mess' with This Texas Slogan: State Agency Might Sue Over Use of Its Catchphrase*, NBCNEWS.COM (June 6, 2004, 7:49 PM), <http://www.nbcnews.com/id/5151681/ns/business/t/dont-mess-texas-slogan/#.TIPFHagS6uI> [<https://perma.cc/JG6W-SARg>] (providing details about the Texas Department of Transportation's enforcement of its DON'T MESS WITH TEXAS mark against others selling T-shirts displaying the phrase, including the University of Texas); Annie Karmi, *MTA Sees Something—Says Stop!*, N.Y. POST (Sept. 4, 2011, 4:00 AM), <https://nypost.com/2011/09/04/mta-sees-something-says-stop> [<https://perma.cc/V8RC-YLGK>] (detailing efforts by the Metropolitan Transportation Authority to stop others from using the phrase IF YOU SEE SOMETHING, SAY SOMETHING with various goods and services, including people who sell T-shirts displaying the phrase and Harvard University when it attempted to use the slogan to advertise a student-safety campaign on campus); Andy Newman, *A Cup Is at the Heart of a Trademark Dispute*, N.Y. TIMES (May 29, 2013), <https://www.nytimes.com/2013/05/30/nyregion/new-york-challenges-a-coffee-shop-logo.html> [<https://perma.cc/A62g-BXJg>] (discussing the New York government agency's claims that a coffee shop infringed its I ♥ NY mark by using a logo that substituted a coffee cup design for the heart—I [coffee cup symbol] NY—and noting the agency has gone after people selling "I ♥ Yoga" T-shirts and "I ♥ Paris" bumper stickers); Aaron Nicodemus, *Judge Asked to Settle Dispute*, TELEGRAM.COM (Apr. 29, 2009, 8:32 AM), <https://www.telegram.com/article/20090429/NEWS/904290359> [<https://perma.cc/99JP-JRCR>] (discussing allegations by owners of the LIFE IS GOOD mark that companies using the phrases "Life is nutz," "Life Sucks," "Life's Good," and "Life is Gay" for various products infringed its mark).

126. 15 U.S.C. § 1064 (2012).

Act.<sup>127</sup> Registered marks that are functional or generic for the goods or services are never immune from cancellation or being deemed invalid in litigation after the registration becomes incontestable,<sup>128</sup> and courts might deem certain informational or ornamental matter to be aesthetically functional or generic in an industry. However, these defenses are not sufficient to prevent all matter that fails to function as a mark from being registered and protected under trademark law. To address this problem (and the fact that the USPTO now registers single colors, product designs, and other non-traditional marks), Congress should amend the Lanham Act to allow petitions to cancel marks at any time based on failure to function or lack of distinctiveness, and add both of these grounds to the list of defenses to incontestability.<sup>129</sup>

Moreover, when applying failure to function doctrine, the USPTO and courts should interpret the law in a manner that promotes free expression and fair competition. Under current law, if the applicant owns trademark rights in this word or symbol used in a non-ornamental manner for other goods or services (such as the words NEW YORK UNIVERSITY for educational services), it may be able to overcome an ornamentation rejection for the same mark for clothing and other promotional goods under the “secondary source” doctrine.<sup>130</sup> This doctrine recognizes that trademark owners often display their source-identifying marks prominently on expressive merchandise to promote their brand and obtain additional revenue from merchandising. Per the TMEP, ornamental use of such marks on promotional goods serves a source-indicating function when the phrase or symbol indicates a “secondary source,” meaning that it signifies the entity that licensed or otherwise allowed its mark to be used in connection with the goods.<sup>131</sup> This Essay argues that the USPTO should refuse to allow registration of ornamental matter for expressive merchandise under the secondary source doctrine when the word or symbol claimed as a mark is a non-stylized common

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127. *Id.* §§ 1065, 1115(b); *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 191–94 (1985) (holding that an incontestable mark cannot be challenged on the ground it lacks distinctiveness).

128. 15 U.S.C. §§ 1064(3), 1065(4), 1115(b)(8).

129. For criticism of the doctrine of incontestability, see Kenneth L. Port, *The Illegitimacy of Trademark Incontestability*, 26 IND. L. REV. 519 (1993); Rebecca Tushnet, *Fixing Incontestability: The Next Frontier?*, 23 B.U.J. SCI. & TECH. L. 434 (2017); Ramsey, *supra* note 19, at 465, 468.

130. TMEP, *supra* note 11, §§ 1202.03, 1202.03(c).

131. *Id.*; see also MCCARTHY, *supra* note 2, § 7:24; Tyler Hall, *Guest Post: Ornamental? Or Trademark as a Product?*, LIKELIHOOD OF CONFUSION (Jan. 18, 2018), <http://www.likelihoodofconfusion.com/ornamental-trademark-as-product> [<https://perma.cc/2WF9-GECN>] (arguing that a failure to function objection to an ornamental use of a mark on clothing and other promotional goods is not appropriate where the trademark is the product and the word or design is used as a mark for other goods or services—such as Ferrari for automobiles or the NFL logo for football games—as the goal of those ornamental uses of the mark is “to further monetize and promote the markholder’s ‘real’ goods or services”).

term or widely used image. An example involving the word “Cat” can demonstrate the problem.

Caterpillar, Inc. owns registrations both for the word CAT and its black, yellow, and white CAT logo for clothing and other promotional goods in addition to its primary products: tractors and other construction equipment.<sup>132</sup> Caterpillar displays these marks on hats and T-shirts in a decorative or ornamental manner, but its non-clothing registrations can be used to prove the mark also functions as an indicator of secondary source. The CAT logo identifies Caterpillar, Inc. as the secondary source of the apparel (the licensor of the mark) in this context, but it is reasonable to assume that most consumers would perceive the non-stylized word CAT displayed alone on a T-shirt or hat as referring to a feline, not a construction equipment company. Yet Caterpillar cited its registration of the non-stylized word CAT for clothing when it petitioned to cancel the registered mark CAT & CLOUD owned by Cat & Cloud Coffee, LLC for clothing (in addition to coffee, tea, and coffee shop, café, and restaurant services) on the ground that the phrase CAT & CLOUD is likely to cause confusion with and dilute Caterpillar’s CAT mark.<sup>133</sup> Trademark law should not give Caterpillar or any company the exclusive right to display common words like CAT on apparel.<sup>134</sup> The USPTO should only allow secondary source doctrine to overcome a refusal on the basis of ornamentation if the proposed mark displayed on expressive merchandise is a source-identifying fanciful term, highly-stylized phrase or design, or unique design, and the trademark owner disclaims rights to any common words or well-known symbols that are part of the registered mark. Such a rule will better promote free speech and fair competition than granting exclusive trademark rights here.

In addition, once a mark is registered, courts should narrowly interpret the scope of the registrant’s trademark rights so that it does not cover use of

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132. CAT, Registration Nos. 0,564,272; 0,770,639; 1,298,364; 2,234,260.

133. CAT & CLOUD, Registration Nos. 4,976,835; 5,130,013; Petition for Cancellation, Caterpillar, Inc. v. Cat & Cloud Coffee, LLC, Cancellation No. 92069081 (T.T.A.B. Aug. 3, 2018) (citing Caterpillar’s Registration No. 1,298,364 for the word CAT and other registrations as the basis for the cancellation). A Notice of Default was entered against Cat & Cloud Coffee on September 24, 2019 with regard to its registration for the mark in Class 25 (apparel) after it failed to file an answer. Notice of Default, Caterpillar, Inc. v. Cat & Cloud Coffee, LLC, Cancellation No. 92069081 (T.T.A.B. Sept. 24, 2019). See also Elaine Ingalls, *Santa Cruz Coffee Shop Cat & Cloud Fights Caterpillar Inc. to Keep its Trademark*, MERCURY NEWS (June 5, 2019, 5:38 AM), <https://www.mercurynews.com/2019/06/05/cat-cloud-fights-caterpillar-inc-to-keep-its-trademark> [<https://perma.cc/V8NG-WDTW>].

134. Caterpillar has filed several petitions to cancel other marks for apparel that contain the word CAT, including the mark KEYBOARD CAT. See Dion Lim, *Battle Brewing Between Independent Coffee Shop & Construction Giant Heats Up*, ABC7NEWS (June 14, 2019), <https://abc7news.com/business/battle-brewing-between-independent-coffee-shop-and-construction-giant-heats-up/5347489> [<https://perma.cc/LP4Z-YW2F>] (“Caterpillar has filed 125 cancellation petitions . . .”).

the mark by third parties in an informational or ornamental manner.<sup>135</sup> Matter that fails to function as a mark cannot be registered, and thus a trademark owner should not be able to use the trademark registration to prevent others from using the mark in a non-trademark manner. An example of such a narrow interpretation of the scope of trademark rights is in the case *LTTB, LLC. v. Redbubble, Inc.*<sup>136</sup> In that dispute, the USPTO initially denied LTTB's application to register the pun LETTUCE TURNIP THE BEET on the ground that the phrase was merely ornamental when displayed prominently on clothing and other expressive merchandise.<sup>137</sup> LTTB overcame this rejection by submitting specimens of use showing the pun displayed on product labels and hangtags, and obtained four registrations of the phrase for various products (two of which became incontestable).<sup>138</sup> LTTB then sued the online marketplace Redbubble for infringement because its website sold T-shirts and other expressive merchandise decorated with the phrase "Lettuce Turnip the Beet."<sup>139</sup>

In *LTTB*, the accused infringer argued it was not liable because (1) decorative or ornamental features are not subject to trademark protection and (2) aesthetic functionality doctrine applies since the evidence shows that "consumers are interested in purchasing products displaying the pun" and are not "seek[ing] to purchase products based on LTTB's reputation."<sup>140</sup> The court noted that these two concepts "are related and overlap" and determined that regardless of "the precise nomenclature" for the rule, LTTB could not "rely on trademark law to obtain an exclusive right to sell products such as 'apparel, phone cases, stickers, bags, wall art and so on' displaying the pun."<sup>141</sup>

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135. See Roberts, *supra* note 17, at 2043 (suggesting some "radical proposal[s]," including allowing courts to "limit the scope of registered trademark or trade dress protection to the uses identified in specimens submitted to and accepted by the USPTO in connection with registration" and suggesting that "owners seeking to enforce rights based on use different from or broader than the type of use they demonstrated in their initial applications would be free to establish common law rights, but the presumptions that accompany registration would extend only to the use shown in the approved specimens"); cf. Dev S. Gangjee, *Paying the Price for Admission: Non-Traditional Marks Across Registration and Enforcement*, in *THE PROTECTION OF NON-TRADITIONAL TRADEMARKS*, *supra* note 25, at 59–60, 80–88 (arguing that courts should connect the scope of the mark as characterized for purposes of registration with its scope for purposes of infringement in a manner similar to prosecution history estoppel in patent law). This approach is similar to requiring a defendant to use another's mark as a trademark for liability under trademark law. See sources cited *supra* note 21 regarding trademark use of a mark.

136. *LTTB, LLC v. Redbubble, Inc.*, 385 F. Supp. 3d 916, 917 (N.D. Cal. 2019).

137. See *id.*

138. See *id.* at 917, 919.

139. *Id.* at 917–18.

140. *Id.* at 920.

141. *Id.* Among other things, the court noted that ornamental use of common phrases on clothing and similar products is very different than use of the Volkswagen logo or the Nike brand name on promotional goods, as the latter products are desired by consumers for reasons related to the reputation of the brand owners and not for any non-source-identifying message conveyed by that symbol or word. *Id.* at 920–22; see also Ramsey, *supra* note 19, at 461–68.

Redbubble was not liable because LTTB could not show a likelihood of confusion as to source based on “mere use of the pun on the face of various products,” but the court said LTTB could enforce its registered mark against third parties who cause a likelihood of source confusion by displaying the phrase on labels or hangtags.<sup>142</sup>

The *LTTB* case arguably creates a common law defense for ornamental or decorative use of puns and other words that convey non-source-identifying messages, but which are registered and protected under trademark law. This is a good result, as this defense helps reduce the conflict between trademark rights and the right to freedom of expression. Elsewhere I have argued that Congress should amend the Lanham Act to explicitly permit third party use of another’s mark in a functional, ornamental, or informational manner.<sup>143</sup> Regardless of whether the legislature enacts this reform, courts can create such common law defenses and other limitations on trademark rights to ensure trademark laws are consistent with the First Amendment.<sup>144</sup>

#### B. FICTIONAL CHARACTERS OR ELEMENTS FROM CREATIVE WORKS

Failure to function doctrine may also be useful to accused infringers in litigation involving claims to trademark rights in fictional characters or things from comic books, books, movies, television shows, and other creative works when these names, words, or designs are not used as a trademark for real-world products before the third party’s use of that expression.<sup>145</sup> As explained below, the federal trademark statute does not grant trademark rights in these circumstances, and it need not do so, because (1) copyright owners can sue for infringement of any designs or other expression protected by copyright law, (2) the USPTO can refuse third party registration of marks that falsely suggest a connection with the author or copyright owner, and (3) federal unfair competition law can be used to prevent misleading or deceptive uses of non-trademark words and symbols in connection with the sale or advertising of products.

Some courts have protected trademark rights in the name or likeness of characters and other fictional elements of creative works after finding these

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142. *LTTB*, 385 F. Supp. 3d at 917, 919 n.1, 921–22.

143. Ramsey, *supra* note 19, at 461–68.

144. Lisa P. Ramsey, *Increasing First Amendment Scrutiny of Trademark Law*, 61 SMU L. REV. 381, 447–50 (2008) (providing examples of common law defenses and other speech-protective interpretations of trademark law).

145. See Roberts, *supra* note 17, at 2031 (noting that courts usually ignore whether the fictional character name or other element of the creative work actually functions as a mark). Per the TMEP, “[m]arks that merely identify a character in a creative work, *whether used in a series or in a single work*, are not registrable.” TMEP, *supra* note 11, § 1202.10 (emphasis in original). On the other hand, the USPTO can register such marks if there is evidence that the character name (such as Harry Potter) does not merely identify the character in a work, such as by use of the name on the spine of the book, on displays associated with the goods, and in other ways that would be perceived as a mark. *Id.*; see also *id.* § 1301.02(b).

words or images to be distinctive trademarks when used as an “ingredient” within entertainment products or displayed in a decorative manner on expressive merchandise.<sup>146</sup> Examples include the name of the restaurant “The Krusty Krab” in the *Sponge Bob SquarePants* television series,<sup>147</sup> the name and appearance of the Batmobile car from the *Batman* television series and movies,<sup>148</sup> the physical appearance of the alien character E.T. featured in the *E.T.* movie,<sup>149</sup> the word “Hobbit” describing certain characters from J.R.R. Tolkien’s novels,<sup>150</sup> the design of the “General Lee” car from the television series *The Dukes of Hazzard*,<sup>151</sup> and the substance “Kryptonite” which is dangerous to the hero of the *Superman* comic books, television series, and movies.<sup>152</sup>

Consumers often associate fictional characters, places, and other elements of a creative work with its author or the owner of the copyright in the work (which may be the author, his or her heirs, a publisher, or a movie studio). However, such an association does not mean that the words or designs are functioning as trademarks for products in the real world.<sup>153</sup> As demonstrated by the recent lawsuit by Dr. Seuss Enterprises against ComicMix based on its mashup book *Oh, the Places You’ll Boldly Go!*, which combined elements from Theodor Geisel’s *Oh, the Places You’ll Go* children’s book with elements of the *Star Trek* television series and movies, consumers may associate something—such as a unique illustrative style or stylized typeface—with a certain author or copyright owner, but that does not mean these elements of the creative work qualify as protectable trademarks.<sup>154</sup> As noted by the USPTO

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146. MCCARTHY, *supra* note 2, §§ 10:38, 10:42–43, 27:89.

147. Viacom Int’l Inc. v. IJR Capital Invs., LLC, 242 F. Supp. 3d 563, 569 (S.D. Tex. 2017), *aff’d* 891 F.3d 178 (5th Cir. 2018).

148. DC Comics v. Towle, 802 F.3d 1012, 1026–27 (9th Cir. 2015).

149. Universal City Studios, Inc. v. J.A.R. Sales, Inc., No. 82-4892-AAH (Bx), 1982 WL 1279, at \*4 (C.D. Cal. Oct. 20, 1982).

150. Warner Bros. Entm’t v. Glob. Asylum, Inc., No. CV 12-9547 PSG (CWx), 2012 WL 6951315, at \*3–5 (C.D. Cal. Dec. 10, 2012), *subsequent determination* 2013 WL 12114836 (C.D. Cal. 2013), *aff’d* 544 F. App’x 683 (9th Cir. 2013).

151. Warner Bros., Inc. v. Gay Toys, Inc., 658 F.2d 76, 78 (2d Cir. 1981) (protecting trademark rights in the unregistered “General Lee symbols” which consist of a 1969 Dodge Charger with an orange color, a Confederate flag emblem, and certain numbers on the car door).

152. DC Comics v. Kryptonite Corp., 336 F. Supp. 2d 324, 331–32 (S.D.N.Y. 2004).

153. The unauthorized use of character names and images on commercial products can cause a likelihood of confusion about affiliation, connection, or licensing, and courts have held use of such elements of creative works by third parties can be trademark infringement. MCCARTHY, *supra* note 2, § 10:43. But character names cannot be registered trademarks if they are not “used in a trademark or service mark sense.” *Id.* § 10:38 & n.14 (citing *In re Caserta*, 46 U.S.P.Q.2d (BNA) 1088 (T.T.A.B. 1998) (holding that character name was not used as a mark on books and other publications)).

154. Dr. Seuss Enters., L.P. v. ComicMix LLC, 372 F. Supp. 3d 1101, 1126–28 (S.D. Cal. 2019) (holding that ComicMix prevailed on the copyright claims after earlier finding that it prevailed on the trademark claims); *see also* MCCARTHY, *supra* note 2, § 10:40.50 (stating that courts have almost uniformly said no trademark protection exists for an artistic style).

in the TMEP, “not everything that is recognized or associated with a party is necessarily a registrable trademark.”<sup>155</sup> The word or symbol must be used and perceived as a trademark that identifies and distinguishes products for sale and indicates their source.<sup>156</sup>

On the other hand, Lucasfilm used the name of the card game “Sabacc” featured in the *Star Wars* films, books, and comic books as a trademark for card games sold in the actual marketplace.<sup>157</sup> When Lucasfilm sued a U.K. company that used the word “Sabacc” in the name of its mobile game app called “Sabacc-The High Stakes Card Game” (along with images and quotes from the *Star Wars* universe), the court said that Lucasfilm was not claiming ownership of the word “as a source identifier for a fictional card game product.”<sup>158</sup> Instead, the court held that the word SABACC “functions as a mark for Lucasfilm and the *Star Wars* franchise, which are real entities that exist in commerce” and Lucasfilm used the mark “in order to sell entertainment products, including Sabacc card game products.”<sup>159</sup> As the word SABACC was displayed in a trademark manner on the packaging of a real-world card game,<sup>160</sup> I agree that this term is functioning as a trademark and indicates that Lucasfilm (or its licensee) is the source of that product. But if this word was only associated with Lucasfilm and the *Star Wars* franchise, and Lucasfilm had not used that word to identify and distinguish the source of non-fictional goods or services, then the word SABACC would fail to function as a trademark for a card game or other merchandise.

Unless the author or copyright owner is using the name, word, or design from a creative work as a trademark in connection with real-world goods and services, arguably this matter is not functioning as a trademark and a court should dismiss any trademark infringement or dilution claim based on unauthorized use of this expression. The copyright owner can still sue for copyright infringement if the defendant is using designs or other expression from the creative work protected by copyright law (such as images from the *Star Wars* movies) and prevail if the fair use defense or other defenses do not

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155. TMEP, *supra* note 11, § 1202; *see also id.* § 1301.02.

156. *Id.* §§ 1202, 1301.02.

157. Lucasfilm Ltd. LLC v. Ren Ventures Ltd., No. 17-civ-07249-RS, 2018 WL 2392963, at \*1–3 (N.D. Cal. Apr. 24, 2018).

158. *Id.* at \*3.

159. *Id.*

160. *Id.* at \*4. For example, a photograph in Lucasfilm’s Complaint shows the word “Sabacc” displayed in a trademark manner on packaging and instruction sheets for its card game sold in 1989. Complaint ¶ 19 at 7, Lucasfilm Ltd. LLC v. Ren Ventures Ltd., No. 17-civ-07249-RS (N.D. Cal. Dec. 21, 2017).

apply.<sup>161</sup> But since copyright law does not protect words and short phrases,<sup>162</sup> this law cannot be used to stop third party use of character names (Han Solo) or words for places (Tatooine) or things (the Millennium Falcon) from a creative work. Nor should trademark law unless this matter is used as a trademark for non-fictional goods or services.

Regardless of whether Lucasfilm owns trademark rights in certain elements of its *Star Wars* franchise, it could still challenge a third party's application to register SABACC, HAN SOLO, TATOOINE, or MILLENIUM FALCON as trademarks for goods or services on the ground that such marks falsely suggest a connection to Lucasfilm in violation of Section 2(a) of the Lanham Act.<sup>163</sup> Moreover, a plaintiff need not own a valid trademark to pursue a claim under Section 43(a) of the Lanham Act against a defendant who falsely represents that certain goods or services are affiliated with, connected to, or sponsored or approved by the plaintiff.<sup>164</sup> If a company or person has made false or misleading statements of fact about the origin of its goods or services, or made other misrepresentations that are likely to mislead or deceive about the author's or copyright owner's affiliation with or sponsorship of the products, then federal unfair competition law can provide a remedy where these statements damage or are likely to damage the complaining party.<sup>165</sup> Pursuing an unfair competition claim in this situation is best instead of asking the court to apply trademark law's likelihood of

161. See, e.g., *Lucasfilm Ltd. LLC v. Ren Ventures Ltd.*, No. 17-cv-07249-RS, 2018 WL 5310831, at \*6 (N.D. Cal. June 29, 2018) (granting summary judgment to Lucasfilm on its copyright infringement claims); MCCARTHY, *supra* note 2, § 10:43. For an excellent discussion of trademark and copyright issues that may arise with regard to fan-created works, see 3 JEROME GILSON & ANNE GILSON LALONDE, *GILSON ON TRADEMARKS* § 11.02[4][j] (2019); Stacey M. Lantagne, *The Copymark Creep: How the Normative Standards of Fan Communities Can Rescue Copyright*, 32 GA. ST. U. L. REV. 459 (2016); Jacqueline D. Lipton, *Copyright's Twilight Zone: Digital Copyright Lessons from the Vampire Blogosphere*, 70 MD. L. REV. 1 (2010); Elizabeth L. Rosenblatt, *The Adventure of the Shrinking Public Domain*, 86 U. COLO. L. REV. 561 (2015); Madhavi Sunder, *Intellectual Property in Experience*, 117 MICH. L. REV. 197 (2018); and Rebecca Tushnet, *Economies of Desire: Fair Use and Marketplace Assumptions*, 51 WM. & MARY L. REV. 513 (2009). See generally ANNE JAMISON, *FIC: WHY FANFICTION IS TAKING OVER THE WORLD* (2013) (providing background information about the history and culture of fanfiction and other fan-created works, including a section authored by Heidi Tandy about Harry Potter fandom and intellectual property law).

162. 37 C.F.R. § 202.1(a) (2019).

163. 15 U.S.C. § 1052(a) (2012); MCCARTHY, *supra* note 2, §§ 26:21–24.

164. 15 U.S.C. § 1125(a); *Belmora LLC v. Bayer Consumer Care AG*, 819 F.3d 697, 706 (4th Cir. 2016) (holding that “the plain language of [Section] 43(a) does not require that a plaintiff possess or have used a trademark in U.S. commerce as an element of the cause of action”; the focus is on “the defendant’s use in commerce—whether of an offending ‘word, term, symbol, or device’ or of a ‘false or misleading description [or representation] of fact’—that creates the injury under the terms of the statute” (second alteration in original)); MCCARTHY, *supra* note 2, § 27:13.

165. 15 U.S.C. § 1125(a)(1)(A). *But cf.* *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 27–38 (2003) (holding that the word “origin” in Section 43(a) of the Lanham Act refers to physical goods, and does not require attribution of expression or provide a Lanham Act claim against someone who copies a formerly copyright-protected creative work now in the public domain without identifying the actual producer of the work).

confusion factors, which focus on the strength of the plaintiff's mark, the similarity of the parties' marks, the similarity of their products, and other factors that are inapplicable where the plaintiff is not using this character name or other element from the creative work as a mark for actual goods or services.<sup>166</sup> If the plaintiff prevails on its unfair competition claim, the court can then enjoin further false or misleading statements by the defendant or require use of a disclaimer with the products to dispel any confusion.

If fans of a creative work do not do anything to falsely suggest their products are affiliated with or sponsored by the author or copyright owner, then they are unlikely to be liable for unfair competition (especially if they include a disclaimer) and they should not be liable for trademark violations when there is no trademark to protect. Such an approach will benefit people who want to use certain names or words associated with their favorite books, movies, or television shows when they create mashups, fan fiction, and other fan works and sell them for profit or at a price that allows them to recoup their costs. Refusing to recognize trademark rights in matter not used as a trademark will also promote freedom of commercial expression by allowing companies to use names or words associated with entertainment products in connection with the sale of their own commercial goods and services in a manner that does not violate unfair competition law.

### C. PRODUCT FEATURES AND OTHER NON-TRADITIONAL MARKS

Finally, the USPTO and courts should not hesitate to apply failure to function doctrine when someone is seeking trademark rights in product shapes, colors, sounds, scents, flavors, textures, and other types of non-traditional trademark subject matter.<sup>167</sup> These types of trade dress for goods and services usually require proof of acquired distinctiveness for registration and protection.<sup>168</sup> The reason is that this matter is often perceived as an attribute of the product rather than as a source-identifier.<sup>169</sup> Brands can try to

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166. For information about the likelihood of confusion factors, see MCCARTHY, *supra* note 2, §§ 23:19–30, 23:73.

167. Lisa P. Ramsey, *Protectable Trademark Subject Matter in Common Law Countries and the Problem with Flexibility*, in HANDBOOK ON INTERNATIONAL AND COMPARATIVE TRADEMARK LAW (Irene Calboli & Jane Ginsburg eds., forthcoming 2020) (draft on file with author). For a discussion of how registering or protecting product features and other non-traditional marks can harm the right to freedom of expression, see Lisa P. Ramsey, *Non-Traditional Trademarks and Inherently Valuable Expression*, in THE PROTECTION OF NON-TRADITIONAL TRADEMARKS, *supra* note 25, at 337, 357–60.

168. TMEP, *supra* note 11, §§ 1202.02, 1202.05, 1202.13; see also MCCARTHY, *supra* note 2, § 3:4.

169. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 213 (2000). See, e.g., *Malaco Leaf, AB v. Promotion in Motion, Inc.*, 287 F. Supp. 2d 355, 364 (S.D.N.Y. 2003) (“The fish-shaped animal design of the Swedish Fish [gummy candy] is a classic example of a design that is not used to identify source, but rather to render the product itself more appealing, especially to children.”); *In re Pohl-Boskamp GmbH & Co. KG*, 106 U.S.P.Q.2d (BNA) 1042, 1050–52 (T.T.A.B. 2013) (holding that consumers are more likely to perceive a peppermint flavor and scent for medicine as product attributes instead of indicators of source).

educate consumers that these product features are trademarks using “look for” the mark advertising (or advertising which tells consumers to listen for, smell for, taste for, or feel for the attribute claimed as a mark), but these efforts may not be successful. People may want the product features simply because of their utilitarian advantages or for aesthetic reasons.

If consumers do not rely on the product feature alone—the shape, color, sound, scent, flavor, or texture by itself without the brand name or logo—to actually identify and distinguish products and indicate their source, this matter is arguably not functioning as a *trademark* even if some consumers associate this feature with the party claiming trademark rights due to extensive use of it in the marketplace. For example, consumers may associate the unique, invented scent of Play-Doh with Hasbro Inc.’s toy modeling compound. But without evidence that members of the public rely on this scent as a source-identifier *by itself* when shopping and making purchasing decisions, it is difficult to conclude that the scent is—like the phrase “Play-Doh” or Hasbro’s product packaging—used and perceived as a “trademark” as that term is defined by Congress in the Lanham Act.<sup>170</sup> Companies can register and obtain trademark rights in more than one mark, but each symbol sought to be protected must independently function as a trademark, just like Nike, Inc.’s NIKE and swoosh logo marks.

#### IV. USE AS A MARK SHOULD BE TREATED AS A SEPARATE REQUIREMENT FOR TRADEMARK REGISTRATION AND PROTECTION

Courts interested in paying more attention to failure to function doctrine could combine their analysis of whether a proposed mark is distinctive and used as a trademark (the approach suggested by Professor Roberts and used by some courts),<sup>171</sup> or they could evaluate these requirements for registration

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170. Cf. Tushnet, *supra* note 26, at 923 (arguing that “the PTO should recognize the existence of limping marks—marks that are always accompanied by, and need the support of, other marks, rather than serving on their own to identify a particular brand, or to create a separate commercial impression”).

171. See, e.g., *Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225, 230, 247–50 (5th Cir. 2010) (holding that star symbol was not a legally protectable mark for self-storage services); *In re Pohl-Boskamp*, 106 U.S.P.Q.2d at 1051–52 (affirming refusal to register peppermint flavor and scent for medicine); *In re Lululemon Athletica Can. Inc.*, 105 U.S.P.Q.2d (BNA) 1684, 1691–92 (T.T.A.B. 2013) (affirming refusal to register wave design for clothing); see also MCCARTHY, *supra* note 2, § 7:24 (“While in theory, there are two separate issues of whether a decorative design is also a mark and whether a design mark is inherently distinctive, in practice, the two issues often compress into one.”).

Professor Roberts argues “that the relationship between use as a mark and distinctiveness is interdependent and inverse: the less distinctive a mark is, the greater indicators of trademark use are needed to ensure consumers will perceive it as a mark, and vice-versa.” Roberts, *supra* note 17, at 1987. I agree that descriptive and suggestive terms may need “greater indicators of trademark use” to satisfy the use as a mark requirement, but certain arbitrary terms such as I LOVE YOU for jewelry or ONCE A MARINE, ALWAYS A MARINE for clothing may also fail to function as marks despite the fact they would be classified as inherently distinctive under the

and protection separately. Either approach will protect competition and freedom of expression better than focusing only on the distinctiveness of a mark. Yet I believe the best way to promote trademark law's goals and expressive values is for courts to discuss and decide each issue separately, just like the USPTO does when it evaluates the distinctiveness of a mark separately from the issue of whether to refuse to register a phrase, design, or product feature on the ground that it fails to function as a mark.<sup>172</sup> This will help reviewing courts—and the rest of us—better determine why words, symbols, or other matter claimed as marks for certain goods or services are not protectable under trademark law, and may make it easier for courts to dispose of frivolous trademark claims.

If a word mark is deemed inherently distinctive under the *Abercrombie* test, courts should next ask whether this suggestive, arbitrary, or fanciful term also satisfies the separate use as a trademark requirement. If this term is a widely used phrase in an industry (such as popular slogans for apparel) or is ornamental for this product (such as I LOVE YOU for jewelry), then the court can use the evidence in the record and common sense to determine that this is not a valid mark because it is not used and perceived as a mark and is not distinctive in fact. This approach will be more systematic and more clear than combining the analysis of a mark's distinctiveness and ability to function as a mark since the *Abercrombie* test provides that an inherently distinctive mark is deemed distinctive in law even if it is not distinctive in fact. These same issues arise for logos, retail store designs, and restaurant décor since these nonverbal marks can be deemed inherently distinctive under the *Seabrook* test.

If the mark is not inherently distinctive under *Abercrombie*, such as the geographically descriptive term AMERICAN AIRLINES for airline travel services, but it has acquired distinctiveness, it would also be better to confirm in a separate analysis that this brand name also functions as a mark to indicate a single source of goods or services. Evidence of acquired distinctiveness will often also support the conclusion that the term functions as a trademark.<sup>173</sup> And evidence of a lack of acquired distinctiveness can also lead to a finding that this matter fails to function as a mark.<sup>174</sup> But this is not a reason to integrate the analysis of these two issues. In some cases, courts may determine that consumers associate this phrase or other matter with a single company or

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*Abercrombie* test. *Id.*; see *supra* Sections II.D & III.A. Thus, I suggest evaluating the issues of distinctiveness and failure to function separately, see *supra* Part IV, instead of merging or integrating the analysis of distinctiveness and use as a trademark. Roberts, *supra* note 17, at 2040–44. I agree with Professor Roberts' excellent point that a use as a trademark requirement may be outcome-determinative for "marks that primarily play some other non-trademark role, such as marks that serve as domain names, hashtags, celebrity nicknames, or ornamental matter." *Id.* at 1987–88.

172. See sources cited *supra* note 62.

173. TMEP, *supra* note 11, §§ 1202, 1202.02(b), 1202.03, 1202.04, 1202.05.

174. See, e.g., *In re Pohl-Boskamp*, 106 U.S.P.Q.2d at 1050–52.

individual, but separately conclude this matter does not function as a “trademark” that indicates a single source of goods or services, as required by the Lanham Act.<sup>175</sup> If lower courts do not consider these issues separately, it may be difficult for reviewing courts to determine whether the problem with an invalid mark is lack of distinctiveness, failure to function as a mark, or both.

A recent application to register a hand gesture as a trademark provides a good example of a symbol which may be associated by some people with an individual’s services but which fails to function as a trademark. On June 9, 2017, Gene Simmons—a member of the rock band Kiss—applied to register the devil’s horn hand gesture as a mark for entertainment services in the form of live musical performances and personal appearances by a musical artist.<sup>176</sup> He claimed his first date of use of this gesture was during the band’s 1974 Hotter Than Hell tour, and his evidence of use—his “specimen” submitted to the USPTO—was a photograph of Simmons using the hand gesture while standing next to Dave Grohl, the lead singer of the Foo Fighters.<sup>177</sup> However, a few days after he applied to register this mark, Simmons withdrew his application because fellow musicians complained that he was overreaching and trying to capitalize on a symbol that is part of rock culture.<sup>178</sup>

Registration is not required for trademark protection,<sup>179</sup> so Simmons could still send a demand letter or file a lawsuit alleging infringement by other musical artists who use this hand gesture in connection with their concerts or personal appearances. If Simmons does sue a competitor for trademark violations, he might submit a survey showing that Kiss fans and other people interested in music associate this hand gesture with Simmons, which—together with his evidence of use of the gesture since the 1970s—may be sufficient to establish acquired distinctiveness.<sup>180</sup> Despite such an association,

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175. See, e.g., *In re Volvo Cars of N. Am. Inc.*, 46 U.S.P.Q.2d (BNA) 1455, 1461 (T.T.A.B. 1998) (“In any event, to the extent that there is an association in purchasers’ minds of DRIVE SAFELY with applicant as a result of applicant’s extensive promotion, this is an association that is not entitled to legal recognition resulting in a trademark registration.”).

176. The mark consists of a hand gesture with the index and small fingers extended upward and the thumb extended perpendicular, U.S. Trademark Application Serial No. 87,482,739 (abandoned June 20, 2017).

177. *Id.* (see TEAS RF New Application document for specimen submitted); Ronald Abrams, *Gene Simmons Abandons Hand Gesture Trademark Application*, FORBES (June 21, 2017, 8:44 PM), <https://www.forbes.com/sites/legalentertainment/2017/06/21/breaking-gene-simmons-abandons-hand-gesture-trademark-application/#8c326fcaacf> [<https://perma.cc/WT6L-T5BW>]; Katie Scott, *Gene Simmons Responds to Claims He Can’t Trademark Rock Hand Gesture*, GLOBAL NEWS (Aug. 21, 2017, 1:18 PM), <https://globalnews.ca/news/3685185/gene-simmons-trademark-rock-hand-gesture> [<https://perma.cc/NF6P-LQCW>].

178. Abrams, *supra* note 177. This hand gesture also “means ‘I love you’ in [American] sign language.” *Id.*

179. 15 U.S.C. § 1125(a)(1)(A), 1125(a)(3), 1125(c) (2012); MCCARTHY, *supra* note 2, §§ 16:1–34.

180. The party claiming trademark rights need only establish that a substantial part or significant number of the buying class associates the mark with a single source; a majority of

a court could still determine that the devil's horn hand gesture is not functioning as a trademark because it is perceived as part of Simmons' performances and personal appearances rather than as a mark for those services.<sup>181</sup> It is unlikely a majority of the relevant public believes this hand gesture is a trademark that solely indicates Simmons' services and identifies and distinguishes his services from those of other musicians. Regardless of whether some people do, courts can better protect competition and free speech interests by finding the hand gesture fails to function as a mark for these services as a matter of law due to the inherent nature of this proposed mark.

Even if Simmons' competitors accused of infringement would win at summary judgment or trial, they may agree to stop using this communicative symbol to avoid the time and expense of litigation. Such self-censorship harms free expression and fair competition. Thus we need trademark doctrines that make it easier for courts to dismiss frivolous trademark lawsuits early in litigation. Failure to function doctrine is one option here. Like an examining attorney at the USPTO, courts may be able to determine whether the matter functions as a trademark to identify and distinguish goods or services and indicate their source based solely on the drawing or description of the mark in the complaint and any attached photographs, website screenshots, and other exhibits showing how the matter is purportedly used and perceived as a mark. Speech-protective trademark doctrines allowing early dismissal of meritless lawsuits benefit individuals, small businesses, and market leaders alike,<sup>182</sup> and thus courts should always confirm that the use as a trademark requirement is satisfied in trademark litigation.

Of course, failure to function doctrine requires the USPTO or court to consider whether consumers perceive the phrase, design, or other matter as a trademark. Thus, some courts may think that survey evidence about consumer perceptions relating to this specific trademark use must be obtained and considered before a decision can be made on whether to refuse to protect this proposed mark on failure to function grounds.<sup>183</sup> As noted by Professor McCarthy, such evidence may only be needed "in a borderline case where it is not at all obvious that the designation has been used as a mark."<sup>184</sup> In many cases, the court will be able to rely on the complaint, any attached

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potential purchasers is not required. MCCARTHY, *supra* note 2, § 15:45; *id.* § 32:190 (noting "figures over 50% are regarded as clearly sufficient," but some courts have found sufficient proof of secondary meaning where only 37% identified the mark with the company); TMEP, *supra* note 11, § 1212.06(d).

181. *Cf.* Abrams, *supra* note 177 ("Although images or stylized drawings of hand gestures can function and be registered as trademarks either by themselves or as part of a design mark, hand gestures in and of themselves cannot function as trademarks.").

182. *Cf.* Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 214 (2000).

183. *Cf.* Mark P. McKenna, *Trademark Use and the Problem of Source*, 2009 U. ILL. L. REV. 773, 775-76 (making this point in the context of trademark use by defendants).

184. MCCARTHY, *supra* note 2, § 3:4.

exhibits, and common sense to make this decision, just like examining attorneys and the TTAB rely on the trademark application, other evidence in the record, and common sense when they engage in this analysis.

Courts must interpret trademark laws in a speech-protective manner, as the Supreme Court held in *Matal v. Tam* and *Iancu v. Brunetti* that the First Amendment applies to laws regulating trademarks.<sup>185</sup> That means, among other things, that judges should apply trademark laws in ways that directly further their purposes, which include promoting fair competition and facilitating the communication of source-identifying product information.<sup>186</sup> They can do this by finding as a matter of law that certain types of subject matter fail to function as a mark due to their inherent nature or the manner in which they are used.

## V. CONCLUSION

The “use as a trademark” requirement for registration and protection of trademarks is an important, but often ignored, trademark doctrine. Professor Roberts has significantly contributed to trademark scholarship by highlighting this fact. Her *Trademark Failure to Function* article is likely to have an impact on future decisions by the USPTO and courts, and will be useful to attorneys challenging the validity of an opponent’s non-source-identifying mark and to scholars writing about trademark law. Like the distinctiveness and non-functionality requirements, the rule requiring subject matter claimed as a mark to actually function as a trademark can further trademark law’s goals and protect expressive values. It should be used to safeguard the free speech right of companies to use non-source-identifying words, symbols, and other matter to communicate about or decorate their products and fairly compete in the marketplace. Failure to function doctrine should also be used to protect the free speech right of consumers to receive that expression and pay less for it because of fair competition in the marketplace.

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185. *Iancu v. Brunetti*, 139 S. Ct. 2294, 2297 (2019); *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017). See Ramsey, *supra* note 19.

186. See sources cited *supra* note 19.