TRADEMARK LAW IN THE U.S.
UNIT THREE

3A. Registration and the Trademark Office

3.1 Prof. Grynberg on registration

by Michael Grynberg (credit/licensing note: MG-TL25-B, *infra*)

3.1.1 Trademark Registration Basics

Why register? Registration is not a prerequisite to protection for a mark. So why bother? Quoth the Trademark Office (http://www.uspto.gov/faq/trademarks.jsp):

> Owning a federal trademark registration on the Principal Register provides several advantages, including:
>
> Public notice of your claim of ownership of the mark;
>
> A legal presumption of your ownership of the mark and your exclusive right to use the mark nationwide on or in connection with the goods/services listed in the registration;
>
> The ability to bring an action concerning the mark in federal court;
>
> The use of the U.S. registration as a basis to obtain registration in foreign countries;
>
> The ability to record the U.S. registration with the U.S. Customs and Border Protection (CBP) Service to prevent importation of infringing foreign goods;

> The right to use the federal registration symbol ® and
>
> Listing in the United States Patent and Trademark Office's online databases.

Nationwide priority looms especially large˜.

Researching registrations. You can look for mark registrations online at https://tmsearch.uspto.gov/ .

The Sweetness of the ®. While anyone can slap a TM or SM designation on anything, only registrants may use the ®. One benefit of doing so is to eliminate the need of proving that a defendant had notice of a registration in an action that seeks to recover damages or a defendant's profits. 15 U.S.C. § 1111.

Filing details. The details of filing can get technical, so we won't go too far into the weeds. Some requirements include a/an:

> List of goods and services for which mark will be used;
>
> Drawing of mark where applicable;
>
> The legal basis on which you are filing (e.g. actual use in commerce, a bona fide intent to use the mark, a claim of priority based on earlier foreign application, registration in applicant's country of origin, or a filing under the Madrid Protocol); and
>
> Example of use

Trademark classes. Registration applications must designate a class or classes for the goods or services. The USPTO explains (https://www.uspto.gov/trademarks/basics/goods-and-services):

> Your application must include a list of the goods and services you use or have a bona fide intent to use with your trademark.
>
> . . .
>
> During the examination process, we will compare your descriptions to other trademark applications and registrations to determine whether there is a conflicting trademark. . . .
>
> Trademark classes are a way for us to organize the goods or services used in applications, assess fees, and aid in searching our database of registered and pending trademarks. All goods and services are "classified" or organized into broad categories

> of goods or services, as determined by international agreement. Each category of goods or services is assigned a number from 1 to 45, also known as an international class. There are many items listed in each class; however, goods and services are never in the same class.
>
> . . . . Your application filing fee is based on the total number of international classes in your application. . . .
>
> For example, you might have a clothing line of golf shirts, dress shirts, and t-shirts. These shirts all fall under the same international class, so your TEAS Plus filing fee would be $250 for the one class. However, if you also provide custom t-shirt printing services, you would have goods and services in two different international classes. In that case, your TEAS Plus filing fee would be $500 ($250 plus $250).

Good or Service? Registration is an area where the distinction between a trademark and service mark matters insofar as one must be specific about what one seeks to protect. For example, may the maker of computer software that assists with job placement claim a service mark as well as a trademark? The Federal Circuit ruled that it depends on consumer perception. "The question is whether a user would associate the mark with 'personnel placement and recruitment' services performed by JobDiva, even if JobDiva's software performs each of the steps of the service." *In re Jobdiva, Inc.*, 843 F.3d 936, 941 (Fed. Cir. 2016).

Oppositions and cancellations and Article III standing. 15 U.S.C. § 1063 provides that "[a]ny person who believes that he would be damaged by the registration of a mark upon the principal register . . . may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office." One may also challenge a mark after it has been registered by bringing a petition for cancellation. 15 U.S.C. § 1064.

As you may recall from earlier courses, the law of standing requires plaintiffs in federal cases to demonstrate an "injury in fact" before their claim can be heard. Determining which harms clear this hurdle is the subject of many precedents. In general, however, courts demand a stake greater than subjective concern. That is, an environmentalist cannot sue to enjoin the clear cutting of a forest located several states away. They must show a more direct personal harm (e.g., that the plaintiff hikes in the very patch of trees that will be cut).

Should the same requirement apply to trademark oppositions and cancellations? Article III, the purported source of the constitutional standing requirement, does not strictly require an injury in fact in trademark oppositions, as the proceeding is an administrative one (in other words, the adjudicator is an Article I agency, not an Article III court). In general, however, one filing a petition to cancel is expected to be more than a "mere intermeddler" and have "a real interest and reasonable belief of damage" from the registration. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 1376 (Fed. Cir. 2020).

The result of an opposition may be appealed to the Federal Circuit (or made the subject of a new federal action, *see* 15 U.S.C. § 1071), which *is* an Article III court. So though standing requirements may be looser for opposing a registration before the USPTO, Article III standing rules apply in full force if an opposer wishes to challenge an adverse outcome in a federal court. *Brooklyn Brewery Corp. v. Brooklyn Brew Shop*, 17 F.4th 129, 137 (Fed. Cir. 2021) ("[Federal statute] does not set forth the exclusive test for standing when a decision of an administrative agency is appealed in federal court. The appellant must also satisfy the requirements of Article III."); *id.* at 138-39 ("[A]n opposer must demonstrate a concrete and particularized risk of interference with the rights that flow to it from registration of its own mark, or some other Article III injury.").

The Article III bar aside, any opposer must also fall within the "zone of interests" of the Lanham Act as established by *Lexmark International, Inc. v. Static Control Components, Inc.*, 572 U.S. 118 (2014). This was too high a bar for an opposition filed by a consumer who alleged a registration would lead to monopolization and higher prices. *Curtin v. United Trademark Holdings, Inc.*, 137 F.4th 1359, 1370 (Fed. Cir. 2025) ("The Board's holding that only commercial actors affected by the mark's registration fall within the zone of interests to oppose the registration as generic, descriptive, or functional under § 1063 is not inconsistent with the Lanham Act's purpose of protecting consumers.").

The standard for allowing participation by those seeking to oppose and to cancel registrations is the same. *Id.* at 1365; 3 McCarthy § 20:7.

Narrowing grounds. If one moves to cancel five or more years after a registration the grounds for cancellation become more limited, but, per 15 U.S.C. § 1064, one may seek to cancel at any time if:

> the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 4 [15 U.S.C. § 1054] or of subsection (a), (b), or (c) of section 2 [15 U.S.C. § 1052] for a registration under this Act, or contrary to similar prohibitory provisions of such prior Acts for a registration under such Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.

Maintenance. Registrations are subject to renewal at ten-year intervals. 15 U.S.C. § 1059. Note the contrast with copyright, another long-lived IP right. Patent rights, which expire quicker, require maintenance payments during their term (as explained here: https://www.uspto.gov/patents/maintain). (N.B., copyright law used to require renewal, but no longer does so). Failure to renew a trademark registration does not cut off state or common law rights.

Registration bars. The various bars to registration set forth in section 2 of the Lanham Act are discussed in greater detail below. Some registration exclusions (being descriptive, deceptively misdescriptive, primarily geographically descriptive, or primarily merely a surname) may be overcome by showing secondary meaning. The others are absolute bars to registration.

In addition, the PTO will sometimes refuse registration if a mark fails to function as a mark. This reason for refusal is discussed in the notes following the *Brunetti* case.

3.2 Prof. Grimmelmann on trademark procedure, registration

by James Grimmelmann (credit/licensing note: JG-SM22M2-0, *infra*)

Trademark procedure is intermediate between patent's rigorous examination and copyright's minimal processing.

Registration

Many of the components of a trademark registration application are tedious (if necessary) paperwork, but a few are important enough to mention. Obviously, the applicant must identify the mark, which for a design mark requires an image of the mark. In addition, they must "specify the particular goods and/or services on or in connection with which the applicant uses, or has a bona fide intention to use, the mark in commerce." MTEP § 1402.01. It is important that the *specification* of goods or services be accurate. Too broad a specification can invalidate a registration. In addition, the USPTO requires that the goods or services be *classified* in terms of the precise, if idiosyncratic International Trademark Classes published by the World Intellectual Property Organization. MTEP § 1401.03. Specification and classification facilitate trademark searches. Note that the mark owner's rights are not strictly limited to the registered classes or the specific items they identify.

The applicant must substantiate their claims of use by providing *specimens* of the mark in use – one for each ITC class. The TMEP explains:

> "[T]he specimen must show the mark as used on or in connection with the goods in commerce. A trademark specimen should be a label, tag, or container for the goods, or a display associated with the goods. A photocopy or other reproduction of a specimen of the mark as used on or in connection with the goods is acceptable."

MTEP at § 904.03.

Some trademark attorneys have been tempted to cheat on their specimens by Photoshopping the mark on to stock photos of relevant goods. Please do not do this. It is fraud on the USPTO. It can lead to invalidation of your registrations and to severe disciplinary sanctions.

When an application is filed, it is referred to a trademark examiner who performs a substantive ***examination*** to confirm that the mark is distinctive, not confusingly similar to existing registrations, not subject to any other exclusions, is properly classified and specified, and so on. The process resembles patent examination, with correspondence flowing back-and-forth between applicant and examiner, but is substantially less rigorous. If the examiner rejects the application, the applicant can request reconsideration, in which case the file goes to another examiner. If they too reject the application, the applicant can appeal to the trademark equivalent of the PTAB, the Trademark Trial and Appeal Board. The TTAB's members are administrative judges and PTO officials. If the TTAB also rejects the application, the applicant can have the decision reviewed either by a federal district court or by the Federal Circuit. 15 U.S.C. § 1071.

When a trademark examiner agrees that a mark is "entitled to registration," the mark is published in the Trademark Official Gazette. Lanham Act § 12. New trademarks drop every Tuesday. If there is no opposition (more on this below) within 30 days, the USPTO will issue a registration certificate, and the applicant's federal trademark rights become effective.

The owner of a registered mark may provide ***notice*** of the registration. The full official form of notice is "Registered in United States Patent and Trademark Office," but everyone just uses the registered-trademark symbol ®. Don't put this notice on your products if the mark is not registered; it's a species of fraud. You *can* use the trademark symbol ™ or the term "trademark" on on their products whether or not you own a trademark registration. As my trademarks teacher, Stephen L. Carter, quipped one day in class, "™ means 'I hope you agree with me that I have rights in this mark.'" It signals to viewers that you are attempting to use the term as a trademark and that you purport to claim rights in it, but does not create any rights or put them on any kind of official notice.

Types of Marks

The USPTO distinguishes among four types of marks. So far we have been dealing with ***trade marks*** for goods and ***service marks***. The distinction matters for two reasons. One is precision; if you want to sound like a fancy-pants intellectual-property attorney, it helps to be able to throw around terms like "service mark" with confidence.*

> [FN*:] As a further persnickety distinction, I think it is most precise to use "trade mark" with a space when distinguishing trade marks from service marks, and "trademark" with no space when referring generally to trade marks and service marks together. Sadly, almost no one agrees with me.
>
> [*Note from EEJ:* Well, I agree with Prof. Grimmelmann here. That's very reasonable and it would avoid a lot of needless confusion that is Congress's own doing. Maybe an even better alternative to "trade mark" as distinguished from service mark would be "goods mark." But Congress passed any up opportunity for that back in 1946 when it passed the Lanham Act.]

The other [reason the distinction matters between trade marks and service marks] is ***affixation***. A trademark must be physically printed on the goods, or on their containers or packaging, or on labels or tags, or on clear point-of-sale displays. 37 C.F.R. §~2.56(b)(1). This kind of affixation is often not possible for service marks, because services themselves are intangible. Thus the rule is looser: the mark must be "used in the sale of the services, including use in the performance or rendering of the services, or in the advertising of the services." 37 C.F.R. § 2.56(b)(2).

The third type of mark is a ***collective mark***, which is used by the members of an association. Lanham Act § 45. The mark is *owned* by the collective entity but *used* by its members, which is the kind of distinction only a lawyer could love. In practice, there are two subtypes of collective marks:

> "A ***collective trademark*** or collective service mark is a mark adopted by a 'collective' (i.e., an association, union, cooperative, fraternal organization, or other organized collective group) for use only by its members, who in turn use the mark to identify their goods or services and distinguish them from those of nonmembers. The 'collective' itself neither sells goods nor performs services under a collective trademark or collective service mark, but the collective may

> advertise or otherwise promote the goods or services sold or rendered by its members under the mark. A collective membership mark is a mark adopted for the purpose of indicating membership in an organized collective group, such as a union, an association, or other organization. Neither the collective nor its members uses the collective membership mark to identify and distinguish goods or services; rather, the sole function of such a mark is to indicate that the person displaying the mark is a member of the organized collective group."

Aloe Creme Labs., Inc. v. Am. Soc'y for Aesthetic Plastic Surgery, Inc., 192 U.S.P.Q. 170 (TTAB 1976)

The fourth type of mark is a ***certification mark***[.]

The Lanham Act defines a "certification mark" as a mark "used [or intended to be used] by a person other than its owner … to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods or services or that the work or labor on the goods or services was performed by members of a union or other organization." Lanham Act § 45. The key point here is that a certification is used by people *other than the owner* on their goods and services.

> "A certification mark is a special creature created for a purpose uniquely different from that of an ordinary service mark or trademark That is, the purpose of a certification mark is to inform purchasers that the goods or services of a person possess certain characteristics or meet certain qualifications or standards established by another person. A certification mark does not indicate origin in a single commercial or proprietary source the way a trademark or service mark does. Rather, the same certification mark is used on the goods or services of many different producers.
>
> "The message conveyed by a certification mark is that the goods or services have been examined, tested, inspected, or in some way checked by a person who is not their producer, using methods determined by the certifier/owner. The placing of the mark on goods, or its use in connection with

> services, thus constitutes a certification by someone other than the producer that the prescribed characteristics or qualifications of the certifier for those goods or services have been met."

MTEP § 1306.01(b)

That is, a certification mark is *owned* like a trademark, but the mark itself designates *characteristics* of the goods, rather than designating source. This does not mean that a certification mark is descriptive; all of the usual trademark rules around distinctiveness apply. Rather, a certification mark must have a distinctive meaning to consumers, but the goodwill is directed into consumer knowledge that the goods have been certified, rather than that the goods come from a particular source.

The TMEP describes three kinds of certification marks: [Quote:]

> 1. *Geographic origin*. Certification marks may be used to certify that authorized users' goods or services originate in a specific geographic region (e.g., SUNSHINE TREE for citrus from Florida).
>
> 2. *Standards met with respect to quality, materials, or mode of manufacture*. Certification marks may be used to certify that authorized users' goods or services meet certain standards in relation to quality, materials, or mode of manufacture (e.g., approval by Underwriters Laboratories) (UL certifies, among other things, representative samplings of electrical equipment meeting certain safety standards).
>
> 3. *Work/labor performed by member or that worker meets certain standards*. Certification marks may also be used to certify that authorized users' work or labor on the products or services was performed by a member of a union or other organization, or that the performer meets certain standards.

MTEP § 1306.1

One can discuss geographic certifications within a broader context of geographic-indication law, and labor-standard certification marks overlap substantial with collective membership marks.

As an example, consider the FAIR TRADE certification. The standards applied by Fair Trade USA include minimum wages for all employees;

housing standards and safety; nondiscrimination on the basis of race, gender, sexual orientation, disability, etc.; and much much more. The standards are quite detailed in some places. For example, the packing-material costs that an exporter (rather than the producer) must cover include "up to 3 labels per banana hand."

In theory, the owner of a certification mark is required to act even-handedly in certifying others' goods. (Indeed, due to the obvious conflict of interest, the owner is *prohibited* from applying the mark to its own goods. If you want to put the mark on your own goods, just get a trademark instead.) But in practice, the owner controls both the wholesale definition of the certification standards and their retail application in particular cases, and oversight is rare. Jeanne Fromer:

> "What do a trendy kosher restaurant in SoHo, an independent movie about a serial killer, and a Swiss watchmaker have in common? Each has been excluded by a certifier from employing its legally protected certification mark in ways that seem to run counter to the certification mark's purposes of consumer protection and promotion of competition. Each of these businesses has either been disqualified by a certifier from getting a certification mark or been manipulated by a certifier into securing a certification mark: a kosher food certification withheld from the restaurant until it changed its name; an R movie rating withheld from the independent movie, whose producer claimed the rating was being given to far gorier—yet non-independent—movies; and a withheld geographical certification of SWISS MADE for the watchmaker located in Switzerland and much of whose watches' value—but not all—originates in Switzerland. The inability of each of these businesses to be certified as is—without any clear certification standard or procedural regularity—can have adverse, and sometimes catastrophic, consequences for the businesses, their consumers, and competition writ large.
>
> "Because the law allows certification standards to be vague, high-level, and underdeveloped, a certifier can choose to

> exclude certain businesses inconsistently or arbitrarily, even when these businesses' goods or services would seem to qualify for the certification mark (particularly to consumers). Moreover, certifiers can wield their marks anticompetitively, even when a certification standard is clear and complete. They can do so through redefinition – something certification mark law currently allows without oversight – to ensure that certain businesses' goods or services will not qualify for the mark. Both of these forms of certification mark manipulation undermine the goals of certification marks: (1) to protect consumers by providing them with succinct information—via the marks—on goods' or services' characteristics and (2) to promote competition by ensuring that any businesses' goods or services sharing certain characteristics salient to consumers qualify for a mark certifying those characteristics."

Jeanne C. Fromer, *The Unregulated Certification Mark(et)*, 69 STANFORD LAW REVIEW 121 (2017)

Exclusions

Section 2 of the Lanham Act excludes a variety of trademarks from being registrable.˜ **[Quoting from Lanham Act § 2; 15 U.S.C. § 1051:]**

> No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it –
>
> (a) Consists of or comprises
>
> > immoral, deceptive, or scandalous matter;
> >
> > or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute;
> >
> > or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods ...

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual [or deceased President during their surviving spouse's lifetime] except by [their] written consent ...

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: [Provided that concurrent registrations are allowed when no confusion is likely to result as a result of limitations imposed on "the mode or place of use of the marks or the goods," by consent, or by court order.]

(e) Consists of a mark which

> (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them,
>
> (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 1054 of this title,
>
> (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them,
>
> (4) is primarily merely a surname, or
>
> (5) comprises any matter that, as a whole, is functional.
>
> (f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark

> used by the applicant which has become distinctive of the applicant's goods in commerce. ...

Unfortunately, the language here is not arranged in an entirely logical order. Here is a quick reorganization:

- Sections (e)(1) and (f) restate the common-law doctrine of descriptive and generic trademarks. Section (e)(1) says that "merely" descriptive marks are not protectable, but section (f) adds that marks that have "become distinctive" (i.e. acquired secondary meaning) are. When you add in the trademark rule that generic marks are considered incapable of acquiring secondary meaning as a matter of law, you recover the common-law rules that descriptive marks are protectable when and only when they have secondary meaning, and that generic marks never are.
- Section (d) restates the basic rules of priority. Marks in actual or constructive use have priority over later-filed applications.
- Section (e)(5) excludes the registration of "functional" matter, i.e. that does something rather than communicating something.
- Sections (c) and e(4) put limitations on the use of names and individual identities as trademarks.
- Sections (a) ("deceptive") and (e)(1) ("deceptively misdescriptive") are false-advertising policies that prevent the registration of misleading trademarks.
- Sections (a) ("geographical indication" for wines or spirits), (e)(2), and (e)(3) deal with the special case of false advertising about the geographic origins of products.
- Sections (a) ("falsely suggest a connection") and (b) are a false-endorsement rules; a trademark cannot imply that they have been approved by or are affiliated with people or institutions where no such affiliation exists. The flag/coat of arms/insignia rule in (b) is an absolute prohibition in an important special case of the general rule in (a). In six decisions issued on the same day, the TTAB *affirmed* refusals to register NATO for flashlights, tents, and dog tags (nos. 87302892, 87302907, and 87302891 (TTAB 2021)) , but *reversed* refusals to register

NATO for pens, lip balm, and energy bars (nos. 87270077, 87418156, and 87418153 (TTAB 2021).˜

- Section (a) ("disparage .... or bring them into contempt, or disrepute") is a dead letter after *Matal v. Tam*, 137 S.Ct. 1744 (2017), in which the Supreme Court held that the exclusion was an unconstitutional restriction on speech. (The case involved a dance-rock band, The Slants, formed by Simon Tam and with an entirely Asian-American membership, who picked their name as a way of reappropriating a racial slur and campaigning for social justice. Other beneficiaries of the ruling in *Tam* included the Washington Football Team, whose former name – a offensive term for Native Americans – had been the subject of decades-long activism. (While the legal campaigns against the former name under section 2(a) failed in court, they helped lay the groundwork for the team's name change in 2020 following the George Floyd protests.)
- Section (a) ("immoral ... or scandalous") was held unconstitutional in *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019). That case involved a clothing line called FUCT, allegedly "pronounced as four letters, one after the other: F-U-C-T," but easily confused with a common profanity. *Brunetti* at 2297. The same applicant later attempted to register the same mark but with a K instead of a T for a variety of goods including cell-phone cases, jewelry, and backpacks. The application was rejected for failure to function as a mark.

Opposition

An important difference from patent procedure is that trademarks are subject to adversary proceedings at every stage. Following the initial publication of an application, any person "who believes that [they] would be damaged by the registration" – typically someone whose mark is similar to the proposed mark – can file an ***opposition*** within 30 days. Lanham Act § 13. In case of opposition, the TTAB conducts a mini-trial. The parties can conduct discovery, take deposition, and submit written filings. There is no live testimony, but there is oral argument on motions. The issue in a TTAB proceeding can be slightly different than the issue in trademark infringement litigation, because "contested registrations are often decided upon a comparison of the marks in the abstract and apart from their marketplace usage." *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 135 S.Ct. 1293 (2015) (Ginsburg, J. concurring) But in many cases, the TTAB's ruling will have effects beyond deciding whether the particular trademark should be registered. In *B&B Hardware, Inc. v. Hargis Industries, Inc.*, for example, the TTAB's conclusion that SEALTITE was confusingly similar to SEALTIGHT was conclusive of the issue in subsequent litigation between the same parties.

Even after a trademark registration issues, "any person who believes that he is or will be damaged by the registration" can file for ***cancellation*** of the registration. Lanham Act § 14. Cancellation petitions also result in mini-trials before the TTAB. Within the first five years, a cancellation petition can be filed for any reason that could have been a basis for refusing a registration in the first place. After that, as long as "the registered mark has been in continuous use," it becomes ***incontestable***. Lanham Act § 15. The term is a bit of misnomer because even an "incontestable" mark can still be cancelled if it is generic, functional, or abandoned, or obtained fraudulently. Lanham Act § 14.

The real work of incontestability has to do with descriptive marks. "Merely descriptive" marks (i.e., without secondary meaning) are not supposed to be registrable, but mere descriptiveness is not among the available grounds for cancellation. In effect, after five years of registration, if the applicant files the proper paperwork, the mark's secondary meaning is presumed as a matter of law. In *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189 (1985), the Supreme Court held that these parts of the Lanham Act mean what they say. The plaintiff held an incontestable registration for PARK'N FLY and sued a competitor calling itself Dollar Park and Fly. Although the dissent called the plaintiff "just another anonymous, indistinguishable parking lot," the Court's majority held that the mark's alleged lack of secondary meaning was not a basis on which the mark could be cancelled.

Term

Trademarks can have an indefinitely long term, as long as they are still being used. State common-law rights survive as long as the owner is using the mark and has goodwill. Federal registrations have a term of ten years, but they can be renewed indefinitely. The owner must file an affidavit of continuing use in the 6th and 10th year following registration, and then every 10th year thereafter. Lanham Act §§ 8,9

Trademark ***abandonment*** is an important way in which trademark rights can terminate. Almost any kind of property can be abandoned through a deliberate action. (Thus, for example, both patents and copyrights can be abandoned with an express dedication to the public domain.) But because trademark rights depend on use, they can also be lost through *inaction*.˜

The Lanham Act explicitly states that a mark is deemed abandoned "[w]hen its use has been discontinued with intent not to resume such use." Lanham Act § 45. Be careful to distinguish an intent to shut down the business at some point in the future (*not* abandonment) from actual cessation of use (abandonment). For example, a store that remains open for a liquidation sale, or a manufacturer that is selling off the remaining inventory from its warehouse, has *not* yet abandoned its marks. But when abandonment does occur, the loss of trademark rights is immediate, even though consumers may still have residual goodwill from the mark: Thus, one source of litigation over putatively abandoned marks is whether an owner whose business has ceased intends to restart it or not.

The Lanham Act adds, "Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment." It thus shifts the burden of establishing intent to resume to the mark owner after three years. In many cases, where there simply is no evidence one way or another on the owner's intent other than their self-interested testimony, this presumption can be conclusive.

A harder problem has to do with ***token uses*** made to reserve rights in a mark that the owner is not extensively exploiting. Because complete non-use results in loss of rights and registration, owners that anticipate perhaps someday revising the brand will try to keep a faint flame flickering to preserve their rights. The Lanham Act tries to deal with this situation by saying that for abandonment purposes, use "means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark." Lanham Act § 45.

These trademark maintenance programs vary. The Standard Oil of New Jersey Company mostly stopped using the ESSO mark when it renamed itself Exxon, but it still uses the ESSO brand on its diesel pumps to prevent abandonment. There is no serious question that this is sufficient. On the other hand, Procter & Gamble lost its rights in ASSURE for mouthwash and shampoo by parking them in a "Minor Brands Program" that involved ASSURE labels on other P&G products and shipping out 50 cases once a year. Total sales over a decade were $491.30 for the shampoo and $161.50 for the mouthwash. The court called this use "sporadic, nominal and intended solely for trademark maintenance." *Procter & Gamble Co. v. Johnson & Johnson Inc.*, 485 F.Supp. 1185 (S.D.N.Y. 1979).

Credit/licensing notes

MG-TL25-B, MICHAEL GRYNBERG

I am very grateful to Michael Grynberg for his generosity in sharing his excellent materials!

JG-SM22M2-0, JAMES GRIMMELMANN

This section was put together by Eric E. Johnson using explanatory text from *Patterns of Information Law* (2022 version) authored by **James Grimmelmann**. Some specific editing notes applicable here: Typography was changed. Some citations were re-worked. Various source citations were removed, and text edited, reworked, and/or re-worded in places where citations were removed. Quotes were added around blockquotes. Footnote and sidebar material was omitted or worked into the main text with punctuation added or changed to suit. Apparent typos were corrected. Any errors should be attributed to EEJ.

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