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Lessons From the Trademark Use Debate (with M. Janis)

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In their thoughtful article,¹ Professors Dogan and Lemley discard more all-encompassing versions of the trademark use requirement (in which every infringement allegation would be subjected to a threshold inquiry into whether defendant's use constituted a use as a mark). Instead, they seek to delineate and defend a "more surgical form" of trademark use doctrine,² meaning one that is intended only to protect defendants that are employing marks for something other than the branding of their own products or services.³ Thus, as Dogan and Lemley now say, trademark use should *not* be viewed as "a panacea, a silver bullet, or a wonder theory."⁴ We applaud Dogan and Lemley for seeking to advance the trademark use debate by narrowing it and for attempting to stuff the trademark use genie partly back into its bottle. But we remain unconvinced that the trademark use doctrine will serve the goals of the trademark system, regardless of whether the doctrine can be cabined successfully in accord with the Dogan and Lemley reformulation.

Although our analysis diverges from that of Dogan and Lemley in many respects, we have selected two general points of disagreement on which to focus in this brief Article. First, Dogan and Lemley's latest arguments haven't altered our views as to the correct interpretation of the Lanham Act, as detailed below in Part I. We still aren't persuaded that the language of the Lanham Act imposes a trademark use requirement, even when that requirement is defined "surgically" and sections 32 and 43(a) are read "fluidly," as Dogan and Lemley suggest. Moreover, this more nuanced interpretation still renders section 33(b)(4) redundant and unduly limits appropriate common law development of trademark law.⁵

Second, as we discuss in Part II, we are unmoved by Dogan and Lemley's additional normative arguments for deploying trademark use to shield defendants from even *potential* liability for various commercial uses of marks, especially in connection with online contextual advertising. Dogan and Lemley would minimize direct liability for search engines by applying the trademark use doctrine but would reintroduce some marginal amount of regulation by leaving the threat of contributory infringement liability. We

1. Stacey L. Dogan & Mark A. Lemley, *Grounding Trademark Law Through Trademark Use*, 92 IOWA L. REV. 1669 (2007) (responding to Graeme B. Dinwoodie & Mark D. Janis, *Confusion Over Use: Contextualism in Trademark Law*, 92 IOWA L. REV. 1597 (2007)).

2. Dogan & Lemley, *supra* note 1, at 1696 (conceding that some of the concerns expressed in *Confusion Over Use* "may argue against an expansive approach to trademark use" but asserting that "none of them justifies rejection of the more surgical form of the doctrine" that Dogan and Lemley discuss).

3. Dogan & Lemley, *supra* note 1, at 1685 & n.69.

4. *Id.* at 1673 (conceding that the doctrine "has significant limitations that curtail its efficacy" but claiming that those limitations only arise in "marginal cases").

5. Dogan and Lemley's critique implicates important questions about the extent to which the Lanham Act leaves judges free to develop common law defenses, as we discuss in Part I herein. See also Dinwoodie & Janis, *supra* note 1, at 1615 & nn. 79–80, 1616 & nn.82.

still believe that this would fail to create sufficient oversight of either the presentation of search results or advertising sales practices.⁶ In addition, we disagree that marginalizing trademark law will best encourage intermediaries to structure their business arrangements in ways that promote reliable information flow to consumers while balancing the rights of trademark owners and their competitors.⁷ In fact, the opposite is true: in the shadow of the threat of *potential* liability, some search engines have begun to restructure their business practices, undertaking what we perceive are good faith efforts to respect trademark rights. Lastly, we disagree with Dogan and Lemley that offline analogies should necessarily direct the outcomes of trademark disputes over online practices.⁸ In particular, we don't think that the practice of grocery stores placing rival products in close proximity to one another on store shelves tells us much about whether Internet search engines should be liable for keyword sales, and we worry that the rhetorical potency of grocery store metaphors (and the like) will lure courts into assimilating online and offline conduct without carefully assessing the differences in online and offline contexts.

Our disagreements on these points also highlight broader differences about methodological approaches to trademark law, some of which we identified in *Confusion Over Use*,⁹ others of which we discuss throughout this Article. In particular, our distaste for limiting the *potential* scope of the Lanham Act reveals our greater willingness to see trademark and unfair competition law as a market regulator. Relatedly, we are more firmly committed to *judicial* development of *both* potential liability and potential defenses; Dogan and Lemley want courts to focus only on the latter. Our view is supported both by the theory of the Lanham Act as a common law system operating within a statutory framework and by our faith in the institutional benefits of common law lawmaking at a time of political tumult in intellectual property law.

Indeed, the insights to be gained from this broader methodological debate may prove to be the most useful byproduct of the trademark use controversy. They may provide lessons for trademark law that will be valuable long after the current spate of litigation over online contextual advertising has subsided.

6. See *infra* Part II.A.

7. See *infra* Part II.B.

8. See *infra* Part II.C.

9. See, e.g., Dinwoodie & Janis, *supra* note 1, at 1603–05 & nn.25–36, 1635–39 & nn.178–89, 1652–53 & nn.256–61, 1654–56 & nn.268–86, 1658 & nn.290–93.

I. TRADEMARK USE AND THE LANHAM ACT'S RAGGED EDGES

A. ABUSE OF THE "USE IN COMMERCE" DEFINITION

As we outlined in *Confusion Over Use*,¹⁰ trademark use proponents have invoked (1) section 45's definition of "use in commerce" (a phrase that also appears in sections 32 and 43(a)), and (2) the "in connection with" clauses in sections 32 and 43(a), in their efforts to establish Lanham Act grounding for their notions of trademark use. Dogan and Lemley provide a particularly nuanced analysis that only partially endorses these prior interpretations while also exposing numerous problems with them.¹¹ Ultimately, they prove more about the Lanham Act's imperfections than about trademark use.¹²

On the appropriateness of relying on section 45's "use in commerce" definition, Dogan and Lemley's Article yields significant ground. Dogan and Lemley concede that use concepts appearing in different parts of the Lanham Act need not have "complete consistency in meaning,"¹³ that the differences in meaning "turn[] on the context,"¹⁴ and that "the scope of use sufficient to establish a trademark as a source-identifier in the minds of the public is [different] than the scope of use sufficient to tamper with that role and thus commit infringement."¹⁵ Yet Dogan and Lemley attempt to salvage something from the inclusion of the phrase "use in commerce" in the infringement

10. *Id.* at 1608–15.

11. Dogan and Lemley also argue that the existence of the doctrine of contributory infringement provides implicit support for a trademark use requirement. We respond to that claim separately. *See infra* Part II.

12. The Lanham Act is replete with drafting inconsistencies. *See, e.g.,* *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002), *cert. denied*, 537 U.S. 1171 (2003) (discussing 1995 dilution laws); Robert A. Christensen, *Trademark Incontestability—Time for the Next Step*, 18 STAN. L. REV. 1196, 1196 (1966) (discussing incontestability provisions); Graeme B. Dinwoodie & Mark D. Janis, *Dilution's (Still) Uncertain Future*, 105 MICH. L. REV. FIRST IMPRESSIONS 98–102 (2006) (discussing inconsistencies relating to the 2006 revision of the law of dilution).

13. Dogan & Lemley, *supra* note 1, at 1688; *accord* Dinwoodie & Janis, *supra* note 1, at 1610–11. As we pointed out in *Confusion Over Use*, the legislative history indicates that the "use in commerce" definition relates to the establishment of trademark rights, not to infringement. *See* Dinwoodie & Janis, *supra* note 1, at 1611 n.62.

14. Dogan & Lemley, *supra* note 1, at 1688; *accord* Dinwoodie & Janis, *supra* note 1, at 1611–14.

15. Dogan & Lemley, *supra* note 1, at 1688. Given Dogan and Lemley's claim that this proposition is in accord with *Confusion Over Use*, we assume they mean to argue that the range of uses that can interfere with consumer understanding is greater than the range of uses that can create it. *See id.* at 1676, 1687–88 (suggesting this reading); *see also* Dinwoodie & Janis, *supra* note 1, at 1612, 1624–25. However, in one passage of their article, Dogan and Lemley note that "the scope of use sufficient to establish a trademark as a source-identifier in the minds of the public is greater than the scope of use sufficient to tamper with that role and thus commit infringement." Dogan & Lemley, *supra* note 1, at 1688. If that (inverted) proposition is in fact what Dogan and Lemley intended to assert, then we remain in disagreement; but the balance of references in their Article leads us to believe that we are, as they suggest, in agreement on this point.

provisions. Under their approach, the “strict definition” in section 45 would be “inapplicable to infringement” determinations.¹⁶ However, courts deciding infringement could take a “more fluid approach” to the language of the section 45 definition in order to give it some relevance in infringement determinations.¹⁷

This selective fidelity to statutory text may validate the very interpretation that Dogan and Lemley repudiate. In a number of keyword-advertising cases, courts grappling with the trademark use doctrine have cited the section 45 definition and have included language in their opinions suggesting that they are accepting uncritically the proposition that the use required to establish rights is the same as that required to infringe rights.¹⁸ For example, courts have attempted to analyze whether selling or buying a keyword is an act of “placing” a mark on goods or an act of “displaying” a mark in connection with services.¹⁹ Thus, some courts appear to be leaning towards treating use as a monolithic concept—the very conclusion that Dogan and Lemley themselves now disown.²⁰ This illustrates what might

16. Dogan & Lemley, *supra* note 1, at 1676.

17. *Id.*

18. The Second Circuit’s *1-800 Contacts* opinion encourages such an analysis. *See* 1-800 Contacts v. WhenU.com, Inc., 414 F.3d 400, 407–08 (2d Cir. 2005) (reciting the section 45 definition); *id.* at 410 (asserting that “[t]he fatal flaw with [the lower court’s] holding is that WhenU’s pop-up ads do *not* display the 1-800 trademark”).

19. *See, e.g.,* Site Pro-1, Inc. v. Better Metal, LLC, 82 U.S.P.Q.2d (BNA) 1697, 1700 (E.D.N.Y. 2007) (“The key question is whether defendant placed plaintiff’s trademark on any goods, displays, containers, or advertisements, or used plaintiff’s trademarks in any way that indicates source or origin.”); Rescue.com Corp. v. Google, Inc., 456 F. Supp. 2d 393, 403 (N.D.N.Y. 2006) (“Defendant’s internal use of plaintiff’s trademark to trigger sponsored links is not a use of a trademark within the meaning of the Lanham Act, either because there is no allegation that defendant places plaintiff’s trademark on any goods, containers, displays, or advertisements, or that its internal use is visible to the public.”); Hamzik v. Zale Corp./Delaware, No. 3:06-cv-1300, 2007 WL 1174863, at *3 (N.D.N.Y. Apr. 19, 2007) (reciting the “display” language but finding trademark use). Other courts that make less of the section 45 definition have instead tended to focus on whether the defendant’s activities were commercial in nature. *See, e.g.,* Buying for the Home, LLC v. Humble Abode, LLC, 459 F. Supp. 2d 310, 323 (D.N.J. 2006) (finding trademark use); 800-JR Cigar, Inc. v. Goto.com, Inc., 437 F. Supp. 2d 273, 285 (D.N.J. 2006) (finding trademark use).

20. Dogan and Lemley also have argued that the “use in commerce” phrase additionally should be read to inform the “in connection with” requirement such that, when read together, the phrases support recognition of a Dogan and Lemley trademark use requirement. Dogan & Lemley, *supra* note 1, at 1676. But that complex interpretation doesn’t comport with clear language in the statute. *See* Dinwoodie & Janis, *supra* note 1, at 1610–14. For example, the “in connection with” clause doesn’t mesh well with the section 45 definition, at least as to goods. *See id.* at 1610; *see also* Dogan & Lemley, *supra* note 1, at 1675–76 (acknowledging that the infringement provisions encompass a defendant’s “advertising” but designating such an activity as a section 45 use in commerce would arguably stretch the definition of use in commerce). Moreover, section 43(a)(1) imposes liability on “[a]ny person who, on or in connection with any goods or services . . . , uses in commerce any word . . . which is likely to cause confusion” 15 U.S.C. § 1125(a)(1)(A) (2000) (emphasis added). The Dogan and Lemley definition of

happen when courts embrace the so-called “fluid” approach to interpreting the infringement provisions.

B. *THE SECTION 33(b)(4) DEFENSE*

Even setting these problems aside, the Dogan and Lemley reformulation for trademark use still doesn't square with section 33(b)(4).²¹ Given the fact that section 33(b)(4) *expressly* preserves a defense for *some* non-trademark uses,²² interpreting the infringement provisions as *impliedly* filtering out *all* non-trademark uses would render the defense superfluous.²³ This conflict occurs whether trademark use is defined broadly or surgically; it's no answer to claim, as Dogan and Lemley do, that by defining trademark use restrictively, their trademark use doctrine doesn't “tread into the territory” of the section 33(b)(4) defense.²⁴

C. *THE ROLE FOR COMMON LAW DEVELOPMENT OF TRADEMARK LAW*

This debate about the relationship between trademark use doctrines and the language of section 33(b)(4) implicates broader concerns about the extent to which the Lanham Act allows for further common law development of trademark doctrines.²⁵ Dogan and Lemley say that the fact that Congress has codified a specific defense (such as the section 33(b)(4) defense) should not preclude courts from developing others²⁶ and that we must be rejecting this proposition (i.e., that we must be arguing that section 33(b) freezes the development of the common law) because we favor interpreting the Lanham Act so as to give some meaning to section 33(b)(4). However, as we pointed out in *Confusion Over Use*, our contextual approach contemplates that courts will continue to develop defenses as they are called upon to balance confusion-avoidance values against other values

trademark use would limit the statute to only a defendant's use of a term to promote its *own* goods and services.

21. 15 U.S.C. §1115(b)(4) (preserving the defense “[t]hat the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark . . . of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services” of the party alleged to infringe).

22. Namely, those non-trademark uses (uses “otherwise than as a mark”) that are undertaken in good faith.

23. See Dinwoodie & Janis, *supra* note 1, at 1615–16; cf. Dogan & Lemley, *supra* note 1, at 1684 (disagreeing). Dogan and Lemley do make an important concession in this regard, however. They admit that “[i]f the trademark use doctrine became a standard inquiry in every trademark case, including those involving defendants that sell their own products under the mark, then the trademark use doctrine might swallow subsidiary doctrines, including descriptive fair use.” Dogan & Lemley, *supra* note 1, at 1684 n. 66.

24. Dogan & Lemley, *supra* note 1, at 1684 n.66.

25. *Id.* at 1684–86.

26. *Id.*

in new contexts.²⁷ And we believe that the trademark statute provides them plenty of room to do so.²⁸

We do recognize that section 33(b) may limit judicial capacity to develop new defenses *as to incontestable marks*.²⁹ Dogan and Lemley argue that to accept this proposition is to conclude that there could be no nominative fair use defense after incontestability.³⁰ But we agree with the Third Circuit that the line between descriptive and nominative fair use is a fine one and that the language of section 33(b)(4) could accommodate many applications of the nominative fair use doctrine.³¹ Courts would simply have to accept that many so-called nominative uses also *do* describe the characteristics of the products or services offered by a defendant, even if they do so by reference to the plaintiff's product or services.³²

27. See Dinwoodie & Janis, *supra* note 1, at 1656–58. Moreover, as we explained in *Confusion Over Use*, we favor analyzing permitted uses within the scope of the fair use defense, rather than under a threshold assessment of trademark use, because this allows the testing of the defendant's good faith and enables us to differentiate between good and bad actors. See *id.* at 1616 n.85, 1631–33. Section 33(b)(4), like many of the defenses that courts have developed to permit unauthorized third party uses, contains seeds of the unfair competition and commercial ethics motivation that historically had driven American trademark law. See Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1830, 1848, 1860 (2007). The skepticism that Dogan and Lemley exhibit toward analysis of free riding and commercial ethics, see Dogan and Lemley, *supra* note 1, at 1692–93, merely highlights the narrowness of law and economics as the lodestar of trademark law. They imply that analysis of search costs is objective but that any concern for commercial ethics reflected in notions of inappropriate free riding will dissolve into unpredictable subjectivity. See *id.* Yet, courts are able to make decisions about commercial ethics. They did so historically in the development of trademark and unfair competition law. See McKenna, *supra*, at 1848, 1860. Foreign courts do likewise. And perhaps American courts are doing something similar when they assess good faith in determining whether a fair use defense has been made out. Developing a “normative baseline” for commercial ethics is not radically harder than definitively determining the search costs involved in the new use of trademarks in a commercial environment that we do not yet fully understand.

28. See Dinwoodie & Janis, *supra* note 1, at 1615, 1658.

29. See *Shakespeare Co. v. Silstar Corp. of Am., Inc.*, 9 F.3d 1091, 1099 (4th Cir. 1993), *cert. denied*, 511 U.S. 1127 (1994). And, of course, given the purpose of incontestability, this is appropriate. See *Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189 (1985).

30. Dogan & Lemley, *supra* note 1, at 1685. Although Dogan and Lemley make the assertion without express reference to incontestability, it is only in the context of alleged infringement of incontestable marks that their assertion raises any substantial issue. In the context of infringement generally, courts have always developed defenses as a matter of common law and still have broad latitude to do so. See *supra* text accompanying notes 27–28.

31. See *Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 239 (3d Cir. 2005) (noting the affinity between descriptive and nominative fair use). Moreover, some scholars have speculated that the broad language of the fair use provision in the new dilution law might provide a basis for judicial expansion of the fair use defense in trademark law more generally. See Jane C. Ginsburg, *Of Mutant Copyrights, Mangled Trademarks, and Barbie's Beneficence: The Influence of Copyright on Trademark Law*, in *TRADEMARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH* (Graeme B. Dinwoodie & Mark D. Janis eds., 2008) (forthcoming).

32. See *Century 21 Real Estate Corp.*, 425 F.3d at 239. An alternative way to deal with a concern that defenses might be limited unduly after incontestability is to adapt the likelihood

Thus, our approach to section 33(b)(4) does not preclude appropriate judicial development of common law defenses. We simply rely on the language of section 33 of the statute to inform our interpretation of the meaning of other provisions of the statute, and, as we explained in *Confusion Over Use*, those interpretations comport with teleological understandings of trademark law, as well as the legislative history of the Lanham Act.

Moreover, Dogan and Lemley's affection for common law development is selective. They stoutly defend the authority of courts to develop common law defenses to trademark claims, but they resist the proposition that courts should also have authority to adapt trademark law to cover new commercial uses of trademarks that were not previously litigated because the technology and commercial practices were unknown until recently. We do not find common law evolution of trademark principles either revolutionary or unique. Unlike Dogan and Lemley, we endorse the common law development of trademark law *both* with regard to potentially infringing acts and potentially permitted uses.

Even with the enactment of the Lanham Act, federal trademark and unfair competition law has retained its common law character.³³ Trademarks *exist* as a matter of common law; the Lanham Act is primarily a device by which to facilitate federal registration and federal enforcement of rights recognized at common law. Of course, Congress has, on occasion, explicitly prompted further expansion of rights,³⁴ but on the whole, Congress has been comfortable in allowing courts to develop the basic contours of trademark protection consistent with its purpose, codifying (or implicitly endorsing by silence) those developments where necessary.³⁵

of confusion factors to enable certain permitted uses. Likely confusion has to be proved even with respect to an incontestable mark. This may, to some extent, explain the Ninth Circuit's original formulation of the nominative fair use test, where the court found that the nominative fair use test replaced or complemented the likelihood of confusion factors in a typical infringement case. *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1150 (9th Cir. 2002); *see also Playboy Enters., Inc. v. Welles*, 279 F.3d 796, 801 (9th Cir. 2002) (explaining that a likelihood-of-confusion test would tend to lead to the incorrect conclusion that "virtually all nominative uses are confusing" because when a defendant uses a trademark nominally, a defendant can be expected to use a plaintiff's identical mark). Although there are costs to explaining what is in truth a balance of competing values in terms of mere confusion, *see Graeme B. Dinwoodie, Trademark Law and Social Norms* 24 (Sept. 5, 2006) (unpublished manuscript, on file with the Iowa Law Review), these cases also show that, in contexts where the standard tests of confusion do not operate well, courts have been willing to adapt them to effectuate the basic purposes of trademark law. *See Century 21 Real Estate Corp.*, 425 F.3d at 239; *see also Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

33. *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 428 (2003) ("Traditional trademark infringement law is a part of the broader law of unfair competition . . . that has its sources in English common law, and was largely codified in the Trademark Act of 1946.") (citations omitted).

34. *See, e.g., Federal Trademark Dilution Protection Act of 1995*, Pub. L. No. 104-98, 109 Stat. 985 (codified at 15 U.S.C. § 1125(c) (1996)).

35. *See generally Qualitex Co. v. Jacobson Prods.*, 514 U.S. 159 (1995) (discussing 1988

The trademark system thus stands in contrast to copyright law, to which Dogan and Lemley analogize in arguing that the courts should await congressional intervention prior to regulating online advertising.³⁶ There is no such thing as a federal common law copyright in the United States.³⁷ Copyright is a statutory grant. Although courts have always been important in developing defenses in copyright law,³⁸ the grant of rights to control new forms of exploitation of copyrighted works is, in theory, the province of Congress.³⁹

Moreover, the fair use doctrine contained in section 107 of the Copyright Act was an explicit attempt by Congress to codify judicial developments without preventing that doctrine's further development by the courts.⁴⁰ Section 33(b) of the Lanham Act is of a different character. As we suggested above, Section 33(b) need not wholly curb judicial innovation. It was, however, expressly intended to provide greater certainty for trademark owners by limiting defenses after incontestability.⁴¹ Of course, Congress might on occasion need to step in where the language of the enumerated defenses leaves insufficient scope for judicial endorsement of socially desired uses.⁴²

Thus, we do not preclude the courts from developing common law defenses; indeed, our approach encourages them to do so. But we *do* reject the idea that courts might not also have a role to play in ensuring the effectuation of the purposes of trademark law in new commercial settings, both social and economic.

reforms); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 784 (1992) (Stevens J., concurring) (discussing trade dress protection).

36. See Dogan and Lemley, *supra* note 1, at 1685–87.

37. See *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834).

38. See *Folsom v. Marsh*, 9 F. Cas. 342, 344–45 (Cir. Ct. Mass. 1841).

39. See *Teleprompter Corp. v. Columbia Broad. Sys., Inc.*, 415 U.S. 394 (1974); *Fortnightly Corp. v. United Artists Television, Inc.*, 392 U.S. 390 (1968); *White-Smith Music Pub. Co. v. Apollo Co.*, 209 U.S. 1 (1908). As successive revisions of the Copyright Act have defined the scope of the statute in more general, conceptual terms, see, e.g., 17 U.S.C. § 102(a) (2006) (providing that copyright shall subsist in “original works of authorship”), the statutory language has in practice allowed the courts to adapt copyright protection to new technological forms of exploitation.

40. See H.R. REP. NO. 64-1476, at 66 (1976).

41. See *Park ‘N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189 (1985) (interpreting incontestability provisions).

42. If developments over time reveal that a particular range of desired conduct cannot be accommodated within the defenses listed in section 33(b), cf. *Shakespeare Co. v. Silstar Corp.*, 110 F.3d 234, 237 (4th Cir. 1997) (discussing treatment of functionality within language of section 33(b)(4)), Congress has acted to affirm the legality of such third party uses. See Trademark Law Treaty Implementation Act, Pub. L. No. 105-330, §201, 112 Stat. 3064 (1998) (adding functionality as a preserved defense).

D. TURNING GENERALIZATIONS INTO PREMISES

Ultimately, Dogan and Lemley's Lanham Act interpretation isn't tied very closely to the statutory language. Instead, their interpretation rests heavily on the argument that because most confusion cases involve a defendant promoting its own goods and services, all confusion cases should be deemed to require it, even though the Lanham Act does not impose such a requirement in express terms. Judge Posner explained the dangers of a similar methodological approach in *Peaceable Planet, Inc. v. Ty, Inc.*:

The scope of a rule is often . . . here limited by its rationale. Or, to make the same point differently, one way of going astray in legal analysis is to focus on the semantics of a rule rather than its purpose. Case 1 might say that a personal name could not be trademarked in the circumstances of that case without proof of secondary meaning. Case 2 might say that personal names cannot be trademarked without proof of secondary meaning but might leave off the qualifications implicit in the circumstances of the case. And then in Case 3 the court might just ask, is the trademark at issue a personal name? As we observed in *AM Int'l, Inc. v. Graphic Management Associates, Inc.*, 44 F.3d 572, 575 (7th Cir. 1995), rules of law are rarely as clean and strict as statements of them make them seem. So varied and unpredictable are the circumstances in which they are applied that more often than not the summary statement of a rule—the terse formula that judges employ as a necessary shorthand to prevent judicial opinions from turning into treatises—is better regarded as a generalization than as the premise of a syllogism.⁴³

Our disagreement with Dogan and Lemley here thus reflects a basic methodological difference. They would define the parameters of potential trademark liability by reference to the typical case; that is to say, starting with the acts of infringement that constitute 90% of trademark cases, they would impose a legal rule that makes those cases, by definition, the entire 100%. We're uncomfortable with such a methodology, especially at this point in time.⁴⁴

43. *Peaceable Planet, Inc. v. Ty, Inc.*, 362 F.3d 986, 989–90 (7th Cir. 2004).

44. Of course, for prudential reasons, courts may decide that it's not worthwhile to tease out a rule that covers ten percent of the cases if the error or enforcement costs of doing so are high. See Dinwoodie & Janis, *supra* note 1, at 1634 & n.169. While not labeled as such, such prudential concerns appear to inform Dogan and Lemley's latest arguments. Thus, although they first argued that non-trademark uses could not increase search costs, their justification for the doctrine now (1) recognizes that non-trademark uses (i.e., uses that would not be sufficient to establish rights) may confuse, see Dogan & Lemley, *supra* note 1, at 1687–88 (“If a defendant is using a trademark in a deceptive product advertisement, that use can confuse consumers as to source or affiliation even if the defendant has never shipped a product bearing the mark.”); (2) explicitly incorporates a balancing of costs, see *id.* at 1695 (“Preventing intermediaries from

E. THE CONTINUING DEFINITIONAL PROBLEM

As Dogan and Lemley concede, “neither judges nor scholars have yet articulated a satisfying definition of trademark use.”⁴⁵ At bottom, Dogan and Lemley’s effort to formulate a surgical form of trademark use is likewise unsatisfying because it doesn’t resolve a fundamental problem with trademark use doctrine: no one can settle on what “trademark use” means.⁴⁶ Indeed, Dogan and Lemley are careful not to make much of their own formulation. They expect that trademark use doctrine “can develop inductively, building from clear cases in which the defendant does not use the plaintiff’s mark to identify or brand its goods or services,” and they decline to specify the doctrine’s outer limits, saying that this must be left to litigation.⁴⁷

That’s a surprising approach that seems incompatible with the goals that trademark use doctrine is supposed to achieve. According to its proponents, trademark use doctrine is designed to deliberately short-circuit claims of trademark infringement by avoiding the messiness of the confusion analysis⁴⁸—particularly its fact-specificity, which is said to make confusion analysis “ill-suited to early resolution of lawsuits”⁴⁹ and subject to manipulation by trademark owners that seek to extract rents from risk averse defendants.⁵⁰ But that means that trademark use doctrine *can’t be* measured, flexible, or sensitive to context. It *can’t be* an open-ended doctrine that

communicating accurate information to consumers interested in that information . . . does sufficient harm to a free market that we think society should be willing to tolerate even a substantial amount of confusion rather than countenance that harm.”); *id.* at 1688 (“The trademark use doctrine in the infringement context serves a quite different objective: it avoids a chill on the speech and commercial activities of parties whose relationship to trademark infringement is, at best, indirect”); and (3) incorporates references to error costs. *See id.* at 1682. The Supreme Court has, to some extent, adopted a prudential approach to limit the scope of product design trade dress. *See Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 214 (2000). However, the Court reached its conclusion in *Wal-Mart* after substantial experience with litigation over product-design trade dress claims. No such similar experience yet exists for online consumer search practices and trademark litigation regarding those practices.

45. Dogan & Lemley, *supra* note 1, at 1673; *see also* Dinwoodie & Janis, *supra* note 1, at 1647–49.

46. For example, Dogan and Lemley argue that “if some unauthorized party sells shirts or shoes emblazoned with the Nike swoosh or the JUST DO IT logo, she is engaged in both trademark use and infringement: she has used Nike’s trademark as a device to sell her own product and has done so in a way that is likely to confuse the relevant public.” Dogan & Lemley, *supra* note 1, at 1696. But judges advancing the trademark use theory in other countries might disagree about whether unauthorized merchandizing activity will always amount to trademark use. *See Arsenal Football Club v. Reed*, (2001) 25 R.P.C. 922, 922–23 (Ch.), *later proceeding*, Case C-206/01, *Arsenal Football Club v. Reed*, 2002 E.C.R. I-10273, at 604 (ECJ) (EU).

47. Dogan & Lemley, *supra* note 1, at 1682.

48. *Id.* at 1693 (arguing in favor of “[c]reating a doctrine that can be applied pretrial to short-circuit” claims of trademark infringement that are deemed dubious).

49. *Id.*

50. *Id.*

develops inductively on a case-specific basis. If it is, then trademark use doctrine won't be a reliable tool for short-circuiting claims. Worse, at least for those who seek bright-line rules, it could become a largely redundant quasi-confusion analysis,⁵¹ also confirming our argument that use is a proxy for other values, including confusion.⁵²

This dissonance between policy goals and doctrinal implementation leaves us deeply skeptical of the whole enterprise of creating a trademark use doctrine. The trademark use doctrine is simply not an effective surgical tool for defining the "normative boundaries within which the likelihood-of-confusion doctrine can operate,"⁵³ but is instead a clumsy stratagem for rendering a priori judgments without the benefit of a contextual inquiry. While we agree with Dogan and Lemley that trademark law needs effective doctrines that balance the value of confusion-avoidance against other values such as free speech,⁵⁴ courts should continue to develop established doctrines such as the fair use defenses (which call for explicit, contextual balancing of those values), rather than constructing a trademark use requirement (which precludes courts from considering the confusion-avoidance side of the equation).

II. NORMATIVE CONSIDERATIONS: THE PROBLEM OF IMMUNIZING INTERMEDIARIES

In *Confusion Over Use*, we laid out the normative case against the trademark use doctrine.⁵⁵ Dogan and Lemley have offered a number of arguments in response. Below, we address three of those arguments, showing how each reaffirms our conclusion that adopting a trademark use doctrine would be bad trademark policy.

51. As Dogan and Lemley acknowledge, "[s]ometimes it is impossible to determine whether a defendant is using a mark to indicate its products' source or sponsorship without resorting to the type of consumer-perception analysis that sits at the core of the likelihood-of-confusion test." Dogan & Lemley, *supra* note 1, at 1673. We wholeheartedly agree; indeed, as we pointed out in *Confusion Over Use*, a comparative analysis shows that courts confronted with having to assess trademark use have struggled to make that assessment without conducting an inquiry into consumer perception. See Dinwoodie & Janis, *supra* note 1, at 1643–45 & nn.212–22.

52. Dogan & Lemley, *supra* note 1, at 1697 ("The key question in trademark use cases is whether defendants have used the mark in a way that suggests something about the source or sponsorship of their own products or services.")

53. Dogan & Lemley, *supra* note 1, at 1696.

54. *Id.* at 1674 (referring to "the historical balance of trademark law, which aims to prevent specific instances of harmful confusion without casting the net so wide as to inhibit truthful, information-enhancing speech"); accord Dinwoodie & Janis, *supra* note 1, at 1656.

55. Dinwoodie & Janis, *supra* note 1, at Part III.

LESSONS FROM THE TRADEMARK USE DEBATE

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A. THE CONTRIBUTORY INFRINGEMENT ARGUMENT

According to Dogan and Lemley, the contributory infringement doctrine answers many of the objections that we raise in *Confusion Over Use*. The contributory infringement argument operates on at least two levels: first, it is said to provide the missing historical support for the existence of the trademark use doctrine;⁵⁶ second, it is supposed to provide appropriate policing of Internet intermediaries involved in keyword advertising disputes.⁵⁷ While the contributory infringement argument is intriguing, it falls apart upon scrutiny.

The argument that contributory infringement supplies historical support for the existence of a trademark use doctrine goes something like this: in a few cases, some involving pre-Lanham Act claims of unfair competition, courts imposed liability on those who facilitated acts of unfair competition by others, adopting a theory of indirect or contributory liability. The fact that courts found the facilitators indirectly liable is said to signify that (1) courts must have been applying a rule that direct liability always requires a showing of a trademark use, and (2) the facilitators' activities must not have constituted trademark use, leaving the court only indirect liability as a viable theory. If courts had not been implicitly observing a trademark use requirement, they simply would have found that the facilitator was a direct infringer, according to Dogan and Lemley's analysis. This, say Dogan and Lemley, is the "most compelling evidence" for the existence of an (implicit) trademark use requirement.⁵⁸

Given the paucity of historical support for the existence of a trademark use doctrine, that may be true, but the contributory infringement cases really aren't terribly compelling for the proposition that Dogan and Lemley advance. The contributory infringement cases don't mention trademark use, and, as far as we're aware, no one at the time or any time since (until Dogan and Lemley) suggested that indirect liability emerged because it was the only way to work around the constraints of the (implicit) trademark use doctrine.⁵⁹ Dogan and Lemley are entitled to their inferences, but the cases yield many other inferences that are equally (or more) plausible. For example, we think it's entirely plausible that courts invoked indirect liability not because they thought they had no other choice, but because it was handy and familiar. In a case like *William R. Warner*,⁶⁰ the Court didn't need to ask the question about whether the defendant was a direct infringer

56. Dogan & Lemley, *supra* note 1, at 1678–81.

57. *Id.* at 1689–91.

58. *Id.* at 1678.

59. The argument also appears in an amicus brief co-authored by Professor Dogan and filed by a group of law professors in the *Rescue.com* case. See Brief for Intellectual Property Law Faculty as Amici Curiae in Support of Affirmance, *Rescue.com Corp. v. Google, Inc.*, Appeal No. 06-4881-CV.

60. *William R. Warner & Co. v. Eli Lilly & Co.*, 265 U.S. 526, 529–30 (1924).

because the Court was persuaded that the defendant was facilitating infringement, and imposing indirect liability on a facilitator was a routine application of tort principles; the tort of unfair competition was no different from other torts. Perhaps this explains why the Court tossed off its indirect liability rule without substantial discussion.⁶¹

Nonetheless, the contributory infringement doctrine is terrifically important to the Dogan and Lemley normative vision of trademark law, at least as it applies to keyword advertising cases. In that vision, search engines may be potentially liable for indirect infringement for the sale of keywords (and, thus, their business practices might be subject to some degree of oversight).⁶² Thus, courts can freely adopt a (surgical) trademark use doctrine to immunize those intermediaries from exposure to *direct* trademark infringement liability.

But any oversight provided by this scheme is illusory and inadequate. Contributory infringement requires evidence of an underlying direct infringement.⁶³ Many of the arguments proffered to insulate Internet intermediaries from direct liability under a trademark use doctrine would also apply to insulate their customers—the purchasers of keywords—and there would thus be no direct liability to which the intermediaries could be contributing.⁶⁴ Moreover, indirect infringement generally requires intent or knowledge, which is hard to prove. Thus, to say that Internet intermediaries face the risk of only indirect trademark liability is to say that intermediaries will likely face no liability in all but the rather extreme cases.⁶⁵

61. *Id.* at 530–31 (devoting two brief sentences to the recitation of the legal rules).

62. Dogan & Lemley, *supra* note 1, at 1689–91.

63. The principle is well-settled—for example, in the law of patent infringement, which has influenced indirect infringement rules in other areas of intellectual property law. *See, e.g.*, *Novartis Pharms. Corp. v. Eon Labs Mfg., Inc.*, 363 F.3d 1306, 1308 (Fed. Cir. 2004) (“When indirect infringement is at issue, it is well settled that there can be no inducement or contributory infringement absent an underlying direct infringement.”).

64. Indeed, recent case law bears this out. *See, e.g.*, *Merck & Co. v. Mediplan Health Consulting, Inc.*, 425 F. Supp. 2d 402, 415–16 (S.D.N.Y. 2006) (concluding that the purchase of a keyword was not an act of trademark use). And, to the extent that *some* indirect liability for search engines might flow from the purchaser’s direct liability, this too would (under the trademark use theory) only cover a sliver of the conduct that might create confusion for consumers, namely where the defendant’s online advertising itself amounted to trademark infringement. This fails to address possible confusion created by search engine conduct that is independent of advertiser conduct. *See infra* text accompanying notes 66–67.

65. Nor is it likely that the Lanham Act’s false advertising provisions would provide a robust alternative for finding liability for search engines. *Cf.* Stacey L. Dogan & Mark A. Lemley, *Trademark and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777, 821 (2004) [hereinafter Dogan & Lemley, *Search Costs*] (asserting that keyword purchasers might be liable for false advertising under some circumstances). Indeed, a closer reading of the false advertising provision merely confirms the folly of reading “use in commerce” identically in every place that it appears in the Lanham Act. *See supra* Part I. Section 43(a)(1)(B) provides liability where one person misrepresents the nature of another person’s goods or services in commercial advertising. But that misrepresentation also must, under the argument advanced by

Finally, the contributory infringement argument makes too little of the fact that intermediaries might not only be facilitating harms caused by others, but might also be perpetrating a separate harm themselves. Theoretically, contributory infringement is the doctrine aimed at expanding the pool of persons responsible for a single act that causes harm; this is why facilitation only attracts liability when direct infringement later occurs. But the sale of keyword-triggered advertising and the manner of presentation of search results potentially create independent trademark-related harm, thus making it an appropriate subject of direct liability.⁶⁶ Whether consumers are confused in an actionable way by the form in which a search engine presents results on a web page does not turn on the “context of the advertiser’s statements and status.”⁶⁷

Of course, experience with the online provision of information may ultimately demonstrate that offering broad immunity to search engines or other intermediaries is sound trademark policy. It might also reveal that the type of confusion, if any, induced by the presentation of results by search engines is not the type of confusion against which the Lanham Act guards. But the record is currently too thin to decide that matter a priori for all future cases. That is the nub of the problem with injecting trademark use into the legal framework for trademark keyword cases: trademark use doctrine is too presumptuous, cutting off the contextual analysis on the basis that we already know how it will (or should) come out.

B. INCENTIVIZING A MARKET RESPONSE THROUGH POTENTIAL LIABILITY

Another point on which our normative analysis differs from that of Dogan and Lemley concerns the disciplining effect of *potential* trademark liability. Dogan and Lemley frame the normative debate over trademark use as a choice between imposing limits on trademark holder rights or, on the other hand, allowing trademark holders to “assert a new and unprecedented form of trademark infringement.”⁶⁸ But our approach neither ensures that trademark owners will obtain control over new types of uses of their marks nor guarantees parties or intermediaries that they can make particular uses

trademark use theorists, qualify as a “use in commerce” because that phrase appears in the preamble of section 43(a)(1). *But cf.* Dogan & Lemley, *Search Costs*, *supra*, at 836 (claiming that “[e]ven if the advertiser manages to mislead without making a trademark use, other doctrines, such as false advertising, may prevent such conduct”). To limit use in commerce in this context to only a defendant’s promotion of its own goods or services would nullify the express language of section 43(a)(1)(B), extending liability to misrepresentations about *another’s* goods. *See* U.S. Healthcare, Inc. v. Blue Cross of Greater Phila., 898 F.2d 914, 921 (3d Cir. 1990) (noting the 1988 statutory revision to ensure that statements about one’s own goods or the goods of another could be actionable).

66. Of course, if the advertising practices facilitate trademark infringement by the advertisers, then contributory infringement liability might be appropriate.

67. Dogan & Lemley, *supra* note 1, at 1690.

68. *Id.* at 1670.

of marks. Instead, our basic point is that it is inconsistent with the basic purposes of trademark and unfair competition law to treat entire sections of commercial activity as beyond the reach of the Lanham Act. Our argument simply insists that those who, without authorization, use marks in commerce in connection with the sale of goods or provision of services, are *potentially* subject to liability if those uses cause effects that come within the scope of trademark and unfair competition law.

Dogan and Lemley decry the “waste and inefficiency” that allegedly would result from potential trademark liability, claiming that “manufacturers would either overspend on enforcement, redesign their products in suboptimal ways, or curtail the scope of their sales to avoid the risk of strict liability.”⁶⁹ In fact, experience shows that search engines have made, on the whole, good faith efforts to revise their selling practices and redesign the presentation of search results in ways that take account of trademark rights.⁷⁰ We do not doubt that in some circumstances there is over-enforcement, just as in other cases there is under-enforcement. However, the response of search engines to potential liability under the Lanham Act in redesigning their sales policies shows the value of not excluding whole categories of uses of marks from the scope of potential liability.⁷¹

Furthermore, advocates of the trademark use theory as applied to search engines overstate the consequences of liability, if that is found. In particular, courts would be unlikely to halt the use of contextual online advertising. Instead, consistent with the remedial approach of courts in trademark and unfair competition law in a number of cases where there are competing values at stake, courts would likely require search engines to present results in ways that minimize the likelihood of confusion and to sell advertising in ways that are similarly motivated.⁷²

69. *Id.* at 1691.

70. See Peter W. Becker et al., *Muddy Waters: Evolving Law and Policy in Internet Advertising* 28 (Paper Presented at Annual Meeting of the International Trademark Association, May 2007) (on file with the Iowa Law Review).

71. Recent experience also tends to refute the exaggerated fears of commercial caution that Dogan and Lemley invoked, suggesting that potential trademark liability has not, in fact, produced a “world in which intermediaries, for fear of liability, fail to use consumer-generated trademark signals at all in designing their business models.” Dogan & Lemley, *supra* note 1, at 1672. We think that this is because, as indicated above, many have in good faith structured their business models to minimize the possibility of confusion. Assessing that conduct as a matter of a defense that includes a good-faith component allows trademark law to encourage such behavior. On the other hand, under a legal regime in which sales of keywords never constitute trademark use, trademark law would provide no impetus to search engines to develop best practices regarding online advertising. And good faith in seeking to avoid confusion would be irrelevant to such analysis. See Dinwoodie & Janis, *supra* note 1, at 1654–56.

72. Cf. *FragranceNet.com, Inc. v. FragranceX.com, Inc.*, No. 06-CV-225 (JFB) (AKT), 2007 WL 1821153, at *5 n.9 (E.D.N.Y. June 12, 2007) (rejecting plaintiff request to impose a “negative matching” obligation on the defendant purchaser of keywords linked to the plaintiff’s

One might argue that market forces alone will move search engines toward more transparency in the way that they present search results. After all, search engines are in the business of delivering useful information efficiently and can be assumed to be highly sensitive to consumer preferences about Internet search results. So, if consumers find it problematic to deal with a search results page that intermingles paid results with organic results, they will (eventually) shift to other competing search engines whose results present paid and organic links more straightforwardly. Economically rational search engines, responding to (presumably) economically rational consumers, will discipline themselves, and trademark law, the argument goes, will need to play no significant role.

It's difficult to take this argument seriously, despite its superficial appeal. Experience militates against the pure laissez-faire approach. Even if the market ultimately punishes producers that mislead their customers, search engines evidently can present increasingly indistinct organic and paid results and still capture short-term gains. Were it otherwise, of course, one might question whether there was any need for trademark and unfair competition law.

C. OFFLINE ANALOGIES AND THE PROXIMATE PLACEMENT ARGUMENT

As we argued in *Confusion Over Use*, we see the trademark use doctrine (as defined by scholars) as a newly-minted doctrine created for the purpose of resolving keyword cases but having (perhaps unforeseen) implications that transcend those cases.⁷³ Dogan and Lemley see the trademark infringement allegations against keyword sales as a new and unwelcome extension of trademark rights.⁷⁴ To bolster this claim, Dogan and Lemley invoke a clever (albeit well-worn) offline analogy: an Internet search engine's sale of COKE as a keyword to trigger advertisements for Joe's Cola is analogous to a grocery store's sale of shelf space to allow bottles of Joe's Cola to be placed adjacent to bottles of COKE. According to this argument, just as the law doesn't impose trademark liability on grocery stores for proximate placement, the law shouldn't impose such liability on Internet intermediaries. And, importantly, the decision to shield proximate placement of grocery products is a consequence of the trademark use doctrine; the grocery store isn't liable because it isn't engaging in a trademark use.⁷⁵

That's an attractive narrative—one that some courts have already found compelling.⁷⁶ But we have several problems with it. First, even if the online

trademark).

73. Dinwoodie & Janis, *supra* note 1, at Part III.C.

74. Dogan & Lemley, *supra* note 1, at 1670–71.

75. *Id.* at 1692–93.

76. See, e.g., 1-800 Contacts v. WhenU.com, Inc., 414 F.3d 400, 411 (2d Cir. 2005); cf. Google Inc. v. Am. Blind & Wallpaper Factory, Inc., No. 1159950, 2007 WL 1159950, at *6 (N.D.

and offline practices are analogous such that the outcomes in both scenarios should be the same, trademark use doctrine isn't inevitably the most normatively desirable vehicle for achieving those outcomes. We might just as plausibly say that when grocery stores first engaged in proximate placement, a contextual inquiry that considered a balance of values (the risk of confusion, the benefits of providing truthful comparative information to consumers) might have led to the conclusion that a particular practice simply wasn't confusing or should be deemed a fair use. Experience over time (with multiple opportunities for contextual balancing of various proximate placement activities) may have reinforced these conclusions and eventually established norms of proximate placement activity that carried minimal risk of trademark liability.⁷⁷ Whether this is what actually occurred is beside the point; the point is that trademark law's well-established contextual analysis possesses the capacity for dealing with the proximate placement scenario without the invocation of a trademark use doctrine.

So, what if our version of the narrative isn't quite right, and some court, somewhere, rejects the trademark use doctrine, engages in a contextual analysis, and finds that some particular grocery store's proximate placement practice gives rise to likely confusion?⁷⁸ The implication that we take from Dogan and Lemley's work is that they predict that grocery stores would dramatically change their sales practices—for example, by rearranging their stores so that rivals' respective products were never offered for sale on adjacent shelves. But again, this overstates the power of trademark rights and the probable scope of any injunctive relief. A court could tailor injunctive relief narrowly to match the modest harm—for example, by requiring simple labeling on store shelves (or, online, by requiring that sponsored search results be segregated from organic search results and plainly labeled as such).

Moreover, the all-too-ready resort to offline analogies to justify outcomes in Internet trademark cases gives us pause. Courts should not automatically assume that proximity in the online environment and proximity in the offline environment have the same effects. The context is different, and there are great risks in taking analogies too seriously. The

Cal. Apr. 18, 2007) (rejecting Google's trademark use argument but asserting that "Google's analogies to trademark infringements outside the digital realm are attractive").

77. We suspect that this parallels, in many respects, the debate that took place in the context of private label goods.

78. The possibility that consumer and commercial practices might build up around rogue decisions is, however, a fair general concern that trademark law need to address. *See* Dinwoodie, Trademark Law and Social Norms, *supra* note 32, at 21. Dogan and Lemley fear not only this outcome, but also worry about a ripple effect. *See* Dogan & Lemley, *supra* note 1, at 1672 (worrying that Amazon.com would hesitate to recommend alternative products to shoppers on its website, that critics would be stifled because they would decline to risk using a firm's marks in criticizing that firm, that writers would expunge references to trademarks from their works, and so on).

effects and economic function of contextual advertising may be radically different from side-by-side placement of goods in grocery stores, notwithstanding that, under some form of formalistic common law reasoning, these activities share the characteristic of placing marks in proximity to each other.⁷⁹

III. CONCLUSION

Trademark law is capable of playing a constructive role in facilitating commercial discourse and in accommodating the interests of competitors, as well as consumers. The trademark use doctrine as articulated by Dogan and Lemley strives to “ground” trademark law by banishing it from certain areas of endeavor without inquiring about contextual factors that are central to the confusion analysis. Notwithstanding the arguments of accomplished scholars such as Dogan and Lemley, we continue to think that trademark law and the values that it seeks to promote, would be worse off for such a grounding. But the debate about trademark use might at least offer lessons about methodology that will be valuable for trademark law in a broader range of contexts than the keyword advertising disputes where the debate is currently playing out.

79. See Dinwoodie & Janis, *supra* note 1, at 1635 & nn.176–77.