Trademark Owner as Adverse Possessor

Jake Linford
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There is an ongoing debate over whether or not a trademark is “property,” and what type of rights a trademark properly secures. Some scholars assert that rules and justifications developed to handle rights in real property are generally a poor fit for intellectual property regimes, and for trademark protection in particular. Others respond that a unified theory of property should be able to account for both real and intellectual property. This article takes the middle course and approaches the issue by mining the analogy between the acquisition of trademark protection and the doctrine of adverse possession.

Courts and scholars have compared the trademark owner’s defensive posture against infringers to the way the owner of real property must ward off adverse possessors. The manner in which a federal trademark registration becomes “incontestable” after five consecutive years of continuous use has also been compared to adverse possession. A closer look reveals that the trademark owner resembles the adverse possessor not merely as she waits for her registration to become incontestable, but at essentially every step in the process of acquiring trademark protection.

Comparing adverse possession to trademark acquisition provides several important insights. First, both doctrinal regimes manifest a purpose to provide notice through productive use to the public and competing claimants. Second, the analogy provides additional evidence that we should recognize property rights in the lexical commons that the public can exercise with regard to words from which trademarks have been acquired. In particular, the rights in the trademark commons are more active and more property-like than rights held in common over expired patents and copyrights. Third, the intersection of these regimes raises questions about whether either regime would benefit from increased clarity, or whether we should prefer their current ambiguity. More precisely, the inherent uncertainty in acquiring trademark distinctiveness and commercial strength may be both an intentional feature of trademark law, and one that is problematic not only for the trademark owner but for competitors and the public. The analogy also provides guidance regarding how to resolve the longstanding good-faith / bad-faith intent conundrum in adverse possession doctrine by rejecting the conundrum: neither good faith nor bad faith possessors are inherently deficient in the notice they provide to owners and the public, and neither should be favored or barred in an adverse possession regime.
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INTRODUCTION

In longstanding tradition, American courts have tended to understand trademark protection as analogous to protecting property rights developed at common law.\(^1\) The question of whether they should do so has recently preoccupied the legal academy,\(^2\) part of a larger debate about whether intellectual property can be properly viewed through a property lens, and whether comparing intellectual property regimes to real property regimes gets us anywhere. Mark Lemley has led the charge in arguing that intellectual property is *sui generis*, with unique characteristics that make it

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\(^1\) *See e.g.*, The Trade-mark Cases, 100 U.S. 82, 92 (1879) ("The right to adopt and use a symbol or a device to distinguish the goods or property made or sold by the person whose mark it is, to the exclusion of use by all other persons … is a property right for the violation of which damages may be recovered in an action at law.").

\(^2\) Mark A. Lemley, *Property, Intellectual Property, and Free Riding*, 83 TEX. L. REV. 1031, 1043 (2005) ("Trademark law, which was once limited to protecting against consumer confusion, has increasingly taken on the character of a property right, with the result that the trademark ‘owners’ now have the power to prevent various kinds of uses of their marks, regardless of whether consumers will be confused or search costs increased."); Jeremy Phillips & Ilanah Simon, *Introduction*, in *TRADE MARK USE* 3, 4 (Phillips & Simon, eds. 2005) ("[U]se justifies protection of trade marks – they are not property rights *per se*. They are only deemed worthy of protection as property rights in so far as some commercial use is made of them."); Uli Widmaier, *The Structure of Trademark Law*, 33 HOFSTRA L. REV. 603, 605-06 (2005) ("[A] symbol enjoys trademark protection only insofar as it possesses ‘commercial magnetism’ in the minds of consumers. This crucial limitation on trademark rights has been obliterated to a substantial degree by decisions … that treat trademarks very nearly as if they conveyed property rights in gross."). *But see* Mark McKenna, 82 NOTRE DAME L. REV. 1839, 1848 (2007) ("American courts from the very beginning protected producers from illegitimate diversions of their trade by recognizing property rights.").
unnecessary to “turn to some broader area of legal theory to seek legitimacy.”

3 Under this *sui generis* framework, it is useless to apply “inapposite economic analysis borrowed from the very different case of land” to intellectual property. 4 Scholars like John Duffy, by contrast, argue that identifying “[a] unified theory of property – one broad enough to account for the similarities and differences among species of property as diverse as Blackacre and patents – promises to increase rather than to diminish our understanding of property and intellectual property.”

This Article enters into this important conversation by mining the gap between the *sui generis* and unified theory camps and taking a close look at the analogy between adverse possession and trademark ownership. Briefly, the adverse possessor can secure title to property without purchase by openly occupying and using the property continuously and exclusively for the statutory period. The adverse possessor must also occupy under claim of right, *i.e.*, without permission from the record owner. 6 A trademark owner secures rights by using a word, symbol, or even product packaging or design in association with goods or services offered in commerce to indicate a source for those goods or services. Trademark rights cannot be secured without use in commerce, and for some types of marks, it is understood that use in commerce must occur over a period of time before rights are acquired.

To date, the analogy between trademark acquisition and adverse possession has manifested itself in three ways. First, courts have compared the defendant’s laches defense (*i.e.*, the plaintiff slept on his rights for too long and now cannot enforce them) to an adverse possession defense against an ejectment claim. This occurs where a trademark owner allows a “junior

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3 Lemley, *supra* note 2 at 1075.
4 *Id.* More specifically, Lemley has argued that if intellectual property is a coherent category, the trademark protection falls outside it. Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L. J. 1687, 1695-96 (1999) (“Even if one accepts [that patents and copyright are analogous to real property], it does not carry over to trademarks. The justifications for trademark law are different from those for other forms of intellectual property.”). *See also* The Trade-Mark Cases, 100 U.S. at 92 (holding that trademark protection could not be justified under the intellectual property clause because unlike patents or copyrights “[t]he ordinary trade-mark has no necessary relation to invention or discovery.”).
6 *See also infra* Part I.C.
7 *See also infra* Part I.A.
“user” to invest energy in an allegedly infringing mark for an extended period of time before taking action. Second, scholars have suggested in passing that the trademark owner takes a defensive posture against encroachment similar to that taken by a real property owner to forestall adverse possession. Similarly and finally, the acquisition of an incontestable registration, which can occur after five consecutive years of continuous use of a registered trademark, has also been likened to adverse possession. While these comparisons are apt to an extent, they miss the larger picture.

The method by which a trademark owner acquires rights initially in a mark is similar in important ways to the method by which an adverse possessor acquires title to real property, even for those inherently distinctive marks that appear to signify a source for goods and services from the moment of first adoption and use. This Article explains how that is the case, and why it matters.

Part I briefly summarizes how trademark rights are secured, litigated and protected, and how property rights are secured through adverse possession. Each element of the traditional adverse possession test points toward a tripartite goal: settling property rights, encouraging inefficient and inattentive owners to reengage with real property or lose rights to it, and measuring whether the adverse possessor is adding value to the property, or at least providing valuable notice to the public and other competing claimants about its claims. Likewise, the steps taken to secure trademark

8 See, e.g., Anheuser-Busch, Inc. v. Du Bois Brewing Co., 175 F.2d 370, 374 (3d Cir. 1949) (“If one deliberately trespassing on the land of another and openly claiming it to be his own property can gain title to that land over a specified period of time, we know of no compelling reason why [defendant], known … to be openly claiming ownership of the word in defiance of the [plaintiff’s] exclusive right …, may not likewise acquire an immunity to legal process … on that score.”).

9 See, e.g., Laura A. Heymann, The Grammar of Trademarks, 14 LEWIS & CLARK L. REV. 1313, 1318 (2010); Eric A. Prager, The Federal Trademark Dilution Act of 1995: Substantial Likelihood of Confusion, 7 FORDHAM INTELL. PROP., MEDIA & ENT. L.J. 121, 121 n.4 (1996) (arguing that the federal dilution protection elevates the mark so protected “all the way to property” but suggesting that the property interest in the famous mark may still be “limited or destroyed by external factors analogous to adverse possession or prescriptive easement.”), quoting Illinois High Sch. Ass’n v. GTE Vantage Inc., 99 F.3d 244, 247 (7th Cir. 1996) (Posner, C.J.).


rights are required in large part to ensure that the mark owner obtains no protection until potential competitors are on notice of her claims, and the public has reason to treat the mark as indicating a source for particular goods or services.

Part II looks briefly at the rationales supporting adverse possession and trademark law, and then details the analogy between trademark owner and adverse possessor, including tension points in analogizing the trademark owner’s acquisition of trademark rights to the requirements that the adverse possessor occupy the property under claim of right, exclusively and continuously. Scholars analyzing adverse possession have traditionally dwelt on the subjective hostility or adversity of the occupier, and different jurisdictions offer different standards for “bad faith” adverse possessors. The comparison to trademark law helps clarify instead that hostility or adversity are much less important than an objective assertion of ownership. It is that assertion which provides sufficient notice to the public and other potential claimants, regardless of the adverse possessor’s internal hostility. Adverse possession’s exclusivity requirement at first also seems ill-fitted to descriptive trademark acquisition, as the trademark owner acquires no absolute right in language. A closer look clarifies that the trademark owner occupies a particular language unit, a “trademark lexeme,” and like the adverse possessor, the trademark owner’s rights are circumscribed by her efforts to delineate and police the boundaries of her claim.

Both the trademark owner and the adverse possessor must use (the mark or the property) continuously to secure rights. But the regimes differ importantly in their clarity about how long it takes to secure those rights. While adverse possession is typically looked at as a “muddy” or imprecise standard as opposed to a “crystalline,” bright-line rule, in the sense first proposed by Carol Rose, the adverse possessor’s reliance on statutory required periods of possession before title vests is more certain, and thus more crystalline than trademark law’s secondary meaning inquiry, where

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13 See infra notes 25-32 and accompanying text.
there is almost no guidance regarding how long it takes to acquire commercial strength or secondary meaning.

This tension between muddy and crystalline trademark protection also manifests in the way that commercial or acquired trademark strength – the mark’s success in the marketplace – is swamping the more crystalline inherent conceptual strength of the trademark. The standard trademark story bases the strength of the mark on its inherent or conceptual quality. For example, a mark like TASTY for apples describes a characteristic of the goods sold, and is thus merely descriptive and unprotectable until the mark acquires secondary meaning, i.e., significance to consumers as a designation of the source of the apples sold under the TASTY mark. Applying a new meaning to a word, like APPLE for computers, is instead arbitrary (not related to existing meanings of the word) and thus inherently strong. Barton Beebe noticed in his groundbreaking empirical study that acquired or commercial strength tends to trump inherent strength when courts are determining the scope of the mark through litigation. The adverse possession analogy helps us better understand this phenomenon, because successful commercial use is the most valuable notice the trademark owner can provide to the public of her enforceable right.

Part III responds to some potential alternate accounts of how trademarks are acquired and defended. First, the Article considers and refutes the notion that a trademark owner’s acquisition of rights is more similar to a prescriptive easement than adverse possession. The Article then rebuts the standard assumption that the trademark owner’s defensive posture is analogous to the defensive posture of the real property against adverse possession by showing how neither the encroachment of an allegedly infringing junior user, nor uses of the mark by the public that threaten its viability, amount to attempts to adversely possess the mark in question. In the course of discussing language rights in the public domain, the Article


16 A junior user is one whose first use in commerce post-dates that of the mark owner. See also 5 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 26:1 (4th ed., updated Feb. 2012) (“‘Senior user’ … designate[s] the first seller to adopt and use a mark…. ‘Junior user’ … designate[s] the second seller to adopt the mark…”).

17 Professor McCarthy describes the public domain as follows: “‘public domain’ is the status of an invention, creative work, commercial symbol, or any other creation
highlights how rights in trademark’s public domain are, in part, active rights exercised by the public, instead of the somewhat passive permissions left to the public when a copyrighted work or patented invention fall into the public domain.

As I hope to demonstrate, the parallels between acquiring real property through adverse possession and acquiring rights to the exclusive use of trademarks highlight are substantial: both doctrinal regimes manifest a purpose to provide notice through productive use to the public and competing claimants. In addition, their intersection raises questions about whether either regime would benefit from increased clarity, or whether we should prefer their current ambiguity. From this follows several potential reforms essayed in Part IV. Whether or not to consider an adverse possessor’s subjective intent has devoured a great deal of intellectual oxygen. Adverse possession regimes that favor claimants under color of title with shorter periods of statutorily required possession are consistent with the notice framework. Regimes that require longer periods of occupation or bar adverse possession by bad faith possessors are instead misguided. Trademark law is more crystalline at registration and less so in its use and its litigation posture, but this lack of certainty may cause some problems for mark owners, their competitors and the public. Still, some of the muddiness in the trademark context is a feature of the system, because it incentivizes the mark owner to engage in continual use, instead of resting on an established property right.

This Article joins the larger debate about real property and intellectual property regimes by staking out a middle ground between the sui generis and unified theory camps. Broad rhetorical positions may generate heat, but close comparisons of real property and IP doctrines will hopefully shed more light. This is consistent with the spirit of other recent scholarship that has considered whether common law property doctrines can improve our understanding of intellectual property regimes. Critics of the broad scope that is not protected by any form of intellectual property. Public domain is the rule: intellectual property is the exception.” 1 Mccarthy, supra note 16, § 1.2.

18 See e.g., Joseph William Singer, Introduction to Property § 4.2.5 at 151 (2d ed. 2005) (“Of all the elements of adverse possession, the adversity requirement has given rise to the most confused and varied treatment.”).

19 See generally David Fagundes, Crystals in the Public Domain, 50 B.C.L. Rev. 139 (2009) (suggesting that clearer rules about the scope of copyright protection might better enable public domain uses) [hereinafter Fagundes, Crystals].

20 See, e.g., Thomas W. Merrill, Accession and Original Ownership, 1 J. Legal Analysis 459, 469 (2009) [hereinafter Merrill, Accession] (arguing that the
of intellectual property protection have frequently pointed to comparisons with real property as driving an expansion of intellectual property protection.\textsuperscript{21} Other scholars have argued that property doctrine correctly understood can help properly define narrower contours of intellectual property.\textsuperscript{22} As courts continue to analogize property doctrines to trademark protection,\textsuperscript{23} there is value in considering where the analogies are harmonious and dissonant. Whether or not that fit is perfect, there is much to be gained from better understanding of how trademark ownership is in harmony with and in conflict with property rights as we have come to define them.

I. PROPERTY RIGHTS ACQUIRED THROUGH POSSESSION AND USE

This Part briefly lays out the manner in which trademark rights are acquired, and how they are enforced. Trademark rights are acquired by using the mark to designate goods and services in commerce. The enforcement of trademark rights generally requires showing a court or trademark examiner that use of an identical or similar mark on identical or similar goods is likely to confuse consumers. Where confusion is likely, the junior use may be enjoined and damages ordered, or the confusing trademark application cancelled. Where confusion is not likely, the junior use or later application cannot be prevented, although the mark owner

common law doctrine of accession helps explain dilution protection for trademarks); David Fagundes, \textit{Accession and Copyright}, forthcoming (arguing that examining the overlap and mismatch between how accession and copyright “treat socially useful, but unpermitted, appropriations” provides important insights into both areas of the law).

\textsuperscript{21} See, generally, \textit{e.g.}, NEIL WEINSTEIN NETANEL, COPYRIGHT’S PARADOX.

\textsuperscript{22} See, \textit{e.g.}, Christopher M. Newman, \textit{Transformation in Property and Copyright}, 56 \textit{VILLANOVA L. REV.} 251, 256 (2011) (arguing that “traditional property doctrines actually contain precisely the kinds of internal limitations on the scope of [copyright] owners’ claims that Netanel and others would like to see”); David Fagundes, \textit{Property Rights in the Public Domain}, 94 Minn. L. Rev. 652, 657 (2010) [hereinafter Fagundes, \textit{Public Domain}] (asserting that property rhetoric can “explicitly present public entitlements in information as a subject of [collective or public] ownership” to “provide[ ] needed pushback against the powerful but overly broad claims of rights in information that are commonly made” regarding copyright).

\textsuperscript{23} College Savings Bank v. Florida Prepaid Postsecondary Education Expense Board, 527 U.S. 666, 673 (1999) (distinguishing the Lanham Act’s false advertising from its trademark infringement provisions on the ground that the trademarks “are the ‘property’ of the owner because he can exclude others from using them.”) (citing K-mart Corp. v. Cartier, Inc., 485 U.S. 176, 185-86 (1988)).
might be able to exercise rights against subsequent infringement. Establishing likelihood of confusion is critical to understanding the rights secured by the trademark owner, because the scope of protection is often fully defined only in litigation, or through the administrative processes before the United States Patent and Trademark Office ("PTO").

A. Acquiring Trademark Rights

A trademark is a curious thing. To oversimplify, a trademark is a symbol used in commerce to indicate that the goods or services offered to consumers come from a single (if anonymous) source, i.e., a symbol that signifies the source of the goods or services. This symbol can be a word, an image, the packing of the product, or even the appearance and design of the product itself. A trademark owner can invent or appropriate words or images to designate its goods or services, and once that symbol comes to signify a consistent source for those goods or services, the trademark owner has secured rights in the mark. In other words, STARBUCKS is protectable as a trademark for coffee once it has come to represent, in the minds of consumers, a consistent source or origin for coffee.

It is frequently said that the right to exclude is the essence of a property right. A trademark is thus property “of a sort,” but what sort? What uses of a symbol can the trademark owner exclude? The trademark owner acquires the exclusive right to use a symbol like STARBUCKS in commerce to designate her goods and services, and to prevent others from using the same or similar marks from using the same or similar goods,

24 See, e.g., Joseph P. Liu, Two-Factor Fair Use?, 31 Colum. J.L. Arts 571, 574-75 (2008) (presenting copyright law’s four factor fair use test and the multifactor likelihood of confusion test used to determine trademark infringement as two examples the challenges of multi-factor tests, including the difficulty of determining which if any factors are dispositive, and uncertainty regarding how to weigh the various factors). A right determined only through litigation is one of the elements identifying a “muddy” property right, as Carol Rose defines it. Rose, Crystals, supra note 14 at 591.

25 But see Eric. R. Claeys, Intellectual Usufructs: Trade Secrets, Hot News, and the Usufructuary Paradigm at Common Law, *1 in INTELLECTUAL PROPERTY AND THE COMMON LAW (Shyamkrishna Balganes, ed. 2012) [hereinafter Claeys, Intellectual Usufructs], draft version online at http://ssrn.com/abstract=1889231 (taking issue with the focus on the right to exclude as the prototypical property right and explaining that the right to exclude is one type of property right).

26 1 Gilson on Trademarks § 1.03 (Anne Gilson LaLonde & Karin Green, eds., 2011).
where that unauthorized, subsequent use would likely confuse consumers.\textsuperscript{27} As the Supreme Court has explained it, “[t]rademark law, like contract law, confers private rights, which are themselves rights of exclusion. It grants the trademark owner a bundle of such rights”.\textsuperscript{28} This is not an exclusive right to all uses of “star”, “bucks”, or even their compression into a single word, but an exclusive right to the use of the “trademark lexeme” STARBUCKS, by which I mean the word as it is used to designate those goods and services consumers can expect to find under the STARBUCKS brand.\textsuperscript{29}

Note that trademark law is premised in part on the notion that a given word or symbol can have multiple source signifying meanings, \textit{i.e.}, that a given word can serve as the foundation for more than one trademark lexeme. DELTA can designate a source for airline services as well as a different source for kitchen & bathroom sink faucets.\textsuperscript{30} The property right in the word “Delta” is held by different companies who invest the word with two different and homonymous meanings. Two different things are designated by the same word. Thus, just as there may be multiple meanings of the same word in the public lexicon, there may be multiple brands utilizing the same or similar words or symbols for disparate products and services.

Trademark is a first possession regime as well. The first to use a mark in commerce gains “priority” of use over subsequent or “junior” users.\textsuperscript{31} Unlike first possession in other regimes, like patent races or land rushes, the trademark owner’s right to control the trademark is only as strong as its

\textsuperscript{27} See, \textit{e.g.}, \textit{College Sav. Bank}, 527 U.S. at 673 (stating in dicta that trademarks are “constitutionally cognizable property interests” because the trademark owner has a right to exclude others from using her mark); \textit{Hanover Star Milling Co. v. Metcalf}, 240 U.S. 403, 413 (1915) (“[T]rade-marks, and the right to their exclusive use, are of course to be classed among property rights … but only in the same sense that a man’s right to the continued enjoyment of his trade reputation and the goodwill that flows from it, free from unwarranted interference by others, is a property right, for the protection of which damages may be recovered… and the continued violation of it will be enjoined”).

\textsuperscript{28} \textit{K Mart}, 485 U.S. at 185-86.

\textsuperscript{29} I discuss the notion of trademark lexemes, and the homonymous nature of trademark law in more detail in another article, \textit{Cognitive Linguistics and Trademark Transformation} (on file with author).

\textsuperscript{30} See 4 \textit{MCCARTHY}, \textit{supra} note 16 at §§ 23:11 & 24:11.

\textsuperscript{31} See \textit{supra} note 16.
current use of the mark. Adoption or selection of a mark prior to its
selection by potential competitors is not sufficient to secure property rights.
The mark owner must have used the mark in commerce before the
competitor, and continue to use it in commerce, lest the mark be lost,
falling back into the public domain for subsequent adoption.

The mark owner’s right to the mark, and the scope of the mark’s protection,
is dependent in part on the inherent strength of the symbol selected, but
also on the strength that the mark has acquired in commerce. The inherent
strength of the mark turns on how directly the mark relates to the goods or
services offered under the mark. In the widely adopted Abercrombie &
Fitch Co. v. Hunting World, Inc., the Second Circuit provided a hierarchy
of conceptual trademark strength – the first two lacking inherent
distinctiveness, and the last three each with increasing inherent
distinctiveness – for the following categories of word marks: (1) generic,
(2) descriptive, (3) suggestive, and (4) arbitrary, and (5) fanciful, or coined
marks.

The more inherently distinctive a mark is, the more readily it can bear
source significance. To acquire rights in any of the categories of words
eligible for trademark protection, the trademark owner must therefore
transform language. She may add a new term to the lexicon to create a
fanciful mark (like XEROX for photocopiers). She may add new meaning
to a word already known, creating an arbitrary mark (APPLE for
computers) or a suggestive mark (GLEEM for toothpaste). A suggestive
mark is a term that suggests but does not describe the qualities of the good
or service offered. Courts often talk about the difference as one of
imagination: a suggestive mark will not bring the product directly to mind,

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32 See generally 1 GILSON, supra note 26 at 3.02.
30 I discuss commercial strength in Part I.B.
35 537 F.2d 4 (2d Cir. 1976), cited favorably in Two Pesos, Inc. v. Taco Cabana,
36 Id. at 9. See also Beebe, Multifactor Tests, supra note 15 at 1634 (noting that
fanciful marks are considered to have the highest degree of inherent
distinctiveness).
37 See BigStar Entm’t, Inc. v. Next Big Star, Inc., 105 F. Supp. 2d 185, 198
(S.D.N.Y. 2000) (noting that XEROX is a fanciful mark for photocopiers).
38 Id. (noting APPLE was an arbitrary mark for computers).
39 B&B Hardware, Inc. v. Hargis Industries, Inc., 252 F.3d 1010 (8th Cir. 2001)
(affirming jury instructions identifying GLEEM as suggestive for toothpaste).
but a consumer can make the connection through a leap of imagination.\textsuperscript{40} She may even develop source signification for words that describe qualities of the product at issue (SEALTIGHT as descriptive for self-sealing fasteners).\textsuperscript{41} At all of these stages, the mark owner has the potential to transform a word into a trademark that may carry commercial magnetism and source significance. However, a term that a court concludes is \textit{ex ante} generic for the genus of goods or services (COMPUTER for computers) may never be transformed into a trademark, even if consumers should come to associate the generic terms with a particular good or service from a particular source.\textsuperscript{42} In addition, a mark can become generic if its primary significance to the public is to indicate the genus of goods or services, rather than signifying a source of particular goods or services.\textsuperscript{43}

In this way, the \textit{Abercrombie} hierarchy posits a binary world of descriptive and distinctive terms. Some marks are seen as inherently source signifying. These “inherently distinctive” marks come into being through the successful efforts of the trademark owner to transformed language, either by adding meanings to terms we know, or adding new fanciful terms to the lexicon. Because they are new, they are seen to be capable of bearing source significance from the outset. Descriptive marks do not initially signal source significance, so that significance, that “secondary meaning” or “acquired distinctiveness”, must be developed.\textsuperscript{44}

Federal registration provides a mechanism to assert rights in a trademark lexeme, but provides only prima facie evidence that the registrant has used the mark in commerce. While trademark owners can now file an application based on a bona fide intent to use a trademark in commerce, and that “ITU” application can give priority over a subsequent user, the applicant’s rights do not vest until the mark is actually used in commerce.\textsuperscript{45}

\begin{footnotesize}
\begin{enumerate}
\item Application of Quik-Print Copy Shops, Inc., 616 F.2d 523, 525, 205 U.S.P.Q. 505 (C.C.P.A. 1980) (“[A] mark is suggestive if imagination, thought, or perception is required to reach a conclusion on the nature of the goods or services.”).
\item Id. (affirming jury verdict for defendant that determined SEALTIGHT was merely descriptive).
\item The court in \textit{Abercrombie} referred to generic terms as those which “cannot [be] transformed into a subject for trademark.” 537 F.2d at 12 (emphasis added).
\item \textit{See} 2 \textit{McCarthy, supra} note 16 at § 15:10 (“Secondary Meaning’ is the same as ‘Acquired Distinctiveness’.”).
\end{enumerate}
\end{footnotesize}
Every registrant has an obligation to provide continuing evidence of use, or the registration will be cancelled. While trademark protection is grounded in use, there are certain advantages that stem from registration. Use of a registered mark continuously for five years without challenge to the owner’s claim of ownership of the mark or right to registration is sufficient to make the mark “incontestable.” Incontestable is a term of art that overstates its impact. Incontestability insulates a registration from some challenges, including a challenge that the mark registered is merely descriptive of the goods and services, and therefore unprotectable. Nevertheless, even an incontestable registration can be challenged on the grounds that the mark is generic designation of the goods or services for which it once designate source, was abandoned by the mark owner, or obtained fraudulently.

B. Protecting Trademark Rights

While use and registration secure rights in the mark, the scope of what is protected is determined only in comparison to the use engaged in by others. A trademark owner may successfully enjoin the use of the mark by a junior user, where the owner can establish the new use is likely to confuse consumers. Injunctive relief is common; damages less so. There are a multitude of factors that courts consider in determining whether confusion is likely, and each circuit has a list incorporating different factors. Every circuit considers the similarity of the marks (do the marks look and sound the similar, and/or do they convey the same or similar meanings?), the

49 See Park ‘n Fly, 469 U.S. at 196-97.
50 There are several other challenges that can be raised to an incontestable mark, itemized at 15 U.S.C. § 1115(b).
51 For example, while damages for past infringement are waived where the defendant raises a successful laches defense, injunctive relief will only be barred if the plaintiff is guilty of “gross laches.” Univ. of Pittsburgh v. Champion Prods., Inc., 686 F.2d 1040, 1044-45 (3d Cir. 1982).
52 See Beebe, supra note 15 at 1589-92.
proximity of the goods (complete identity or competitive overlap is not required, but the goods must be sufficiently related),\textsuperscript{53} evidence of actual consumer confusion, the strength of the plaintiff’s mark (both its inherent strength and its acquired or commercial strength),\textsuperscript{54} and the defendant’s intent in adopting the mark.

Each circuit considers its own unique mix of factors.\textsuperscript{55} For example, the Second Circuit’s test, from Polaroid Corp. v. Polarad Electronics Corp.,\textsuperscript{56} considers the likelihood that prior owner will bridge the gap and bring products like those sold by defendant to market, the quality of defendant’s product, and the sophistication of buyers, in addition to those listed above. No circuit’s list of factors is exhaustive and courts can consider other variables as appropriate. The Court of Customs and Patent Appeals – the predecessor to the Federal Circuit – has offered the most comprehensive list,\textsuperscript{57} and it is that list to which examiners in the PTO and the Trademark Trial and Appeal Board turn when trying to determine whether an applied-for or registered mark is likely to be confused with a mark that was previously registered or is already in use.

Recall that a descriptive mark cannot be protected until it acquires distinctiveness.\textsuperscript{58} Courts consider the same factors – consumer testimony; consumer surveys; the exclusivity, length and manner of the mark owner’s use; the amount and manner of advertising; the amount of sales and number of consumers; the mark’s established place in the market; and proof of

\textsuperscript{53} As the Third Circuit articulates the proximity test, courts consider whether the defendant’s goods are similarly enough to the plaintiff’s “that a customer would assume they were offered by the same source.” Checkpoint Sys., Inc. v. Check Point Software Techs., Inc., 269 F.3d 270, 286 (3d Cir. 2001). In addition, courts also consider whether “buyers and users of each party’s goods are likely to encounter the goods of the other, creating an assumption of common source affiliation or sponsorship.”\textit{Id.}

\textsuperscript{54} See supra notes 35-44 and accompanying text.

\textsuperscript{55} For example, compare Vitarroz Corp. v. Borden, Inc., 644 F.2d 960, 966 (2d Cir. 1981) (“Our cases demonstrate, moreover, that the likelihood of confusion, the ‘crucial’ issue in a case such as this, often depends on the similarity of the marks and the proximity of the products,”) (citation omitted)\textit{ with} Checkpoint Sys., Inc. v. Check Point Software Techs., Inc., 269 F.3d 270, 281 (3d Cir. 2001) (“The single most important factor in determining likelihood of confusion is mark similarity.”). See also Beebe, Multifactor Tests, supra note 15 at 1583, 1599.

\textsuperscript{56} 287 F.2d 492, 495 (2d Cir. 1961).

\textsuperscript{57} In re E. I. Du Pont de Nemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973).

\textsuperscript{58} See supra notes 41, 44 and accompanying text.
intentional copying\textsuperscript{59} – when trying to determine whether a mark has acquired distinctiveness and whether a mark that is source signifying (via either inherent or acquired distinctiveness) has commercial strength.\textsuperscript{60} As discussed in more detail in Part II.C.6, supra, commercial strength is as important as inherent strength – if not more important – for determining the scope of the mark’s protection.\textsuperscript{61}

C. Acquiring Property Through Adverse Possession

Adverse possession is also a means of acquiring a property right through use, and the right acquired is defined primarily by the scope of the use, with some exceptions. Adverse possession is a doctrine that allows one who occupies real property and uses it in a manner consistent with the character of the property to secure title to that property despite the presence of a superior title holder. As a matter of black letter law, there are five elements of a successful adverse possession claim. The possessor is required to engage in (1) actual entry, possession and use that is (2) open and notorious, (3) continuous for the statutory period, (4) under claim of right (\textit{i.e.}, without permission), and (5) exclusive.\textsuperscript{62}

In order to claim title through adverse possession, there must be actual entry. The adverse possessor can generally claim only that the property possessed and converted to use consistent with the use of that type of property in that location, that is to say, “the possessor must physically occupy the premises in some manner.”\textsuperscript{63} The use must be notorious, \textit{i.e.}, something the reasonably attentive landowner would notice if she were paying attention.\textsuperscript{64}

In the United States, each state prescribes by statute the amount of time for which the adverse possessor must continuously possess the property


\textsuperscript{60} See 2 McCarthy, supra note 16 § 11:82.

\textsuperscript{61} See Mark P. McKenna, \textit{Teaching Trademark Theory through the Lens of Distinctiveness}, 52 ST. LOUIS U. L.J. 843, 846-47 (2008) (“[T]rademark strength … is one of the factors that determines the scope of a party’s rights.”).

\textsuperscript{62} Singer, supra note 18 § 4.2 at 145.

\textsuperscript{63} Id. § 4.2.1 at 145.

\textsuperscript{64} 8-P6 Powell on \textit{Real Property} § P6.08 (as a matter of public policy, “the owner should not lose his or her land without some reasonable warning that should have made the owner aware that adverse possession was occurring.”).
without ejectment in order to secure title.\textsuperscript{65} The possession must be without permission, although courts and scholars are divided on whether we should inquire whether the adverse possessor knows she is occupying someone else’s property or intends only to use property she thinks she owns.\textsuperscript{66} In some jurisdictions, bad faith adverse possessor is barred.\textsuperscript{67} In several European countries, the bad faith adverse possessor merely faces a longer statutory window to perfect its title.\textsuperscript{68} This is, in a way, similar to the privity requirement for tacking. The adverse possessor in privity with (\textit{i.e.}, having purchased the property from) a prior adverse possessor may tack her possession to that of a prior possessor, while a non-purchasing adverse possessor cannot.\textsuperscript{69}

Other factors can lead to multiple statutory windows. In some jurisdictions, for example, the prescribed statutory period is shorter for the adverse possessor operating under color of title, \textit{i.e.}, flawed documentation that purports to transfer title in the property to the adverse possessor.\textsuperscript{70} In other jurisdictions, adverse possession cannot succeed without color of title.\textsuperscript{71}

Finally, the adverse possessor must engage in exclusive possession of the property. It is generally difficult to prevail in an action to quiet title or eject co-tenants where one’s title is grounded in adverse possession.\textsuperscript{72} Sharing

\textsuperscript{65} For example, Idaho has a five-year statutory period. \textit{see} IDAHO CODE ANN. § 5-203, while Iowa requires continuous possession for 40 years. IOWA CODE § 614.31.

\textsuperscript{66} \textit{See infra} Part II.C.3.


\textsuperscript{69} \textit{See} 16-91 POWELL, \textit{supra} note 64 § 91.10.

\textsuperscript{70} \textit{See e.g.}, WASH. REV. CODE § 7.28.070 (using seven-year for possession under color of title instead of 10-year period).


\textsuperscript{72} \textit{See, e.g.}, Wright v. Wright, 512 S.E. 618 (Ga. 1999).
the property with the title holder also bars acquisition of title through adverse possession.73

II. THE TRADEMARK OWNER IS TREATED LIKE A PERPETUAL ADVERSE POSSESSOR

To compare trademark rights to property rights acquired through adverse possession, it is necessary to posit a definition of the right in question. Trademark rights can be thought of as a limited property right in a language.74 The mark owner secures through use the right to substantially exclusive use of a particular word or symbol to designate the owner’s goods or services and to signify a consistent source for those goods or services,75 which elsewhere I have called a trademark lexeme.76 Unlike rights in real property, or intellectual property rights like copyright or patent protection, trademark rights are a property right dependent upon perpetual use of the mark in commerce to designate goods or services from a particular source. A failure to use the mark in commerce will result in the mark falling into the public domain, even in those cases where the mark owner created the mark from whole cloth.

This use requirement is reminiscent of the manner in which rights are secured through adverse possession. Under the doctrine of adverse possession, title to property is transferred from a “true,” or record owner to an adverse possessor, one who possesses property without permission, in those cases where the possession is actual, open and notorious, hostile (or without permission), exclusive and continuous for a statutory period (which varies from jurisdiction to jurisdiction).77 One rests control of property from the hands of the idle owner by putting the property to use (“cultivated or improved” the land) or protecting the property “by a substantial

73 See generally Singer, supra note 18 § 4.2.3 at 150.
74 A trademark is a property right in the sense that property is the right to determine exclusively the use of an asset, even if that right is subject to use or access rights. See Eric R. Claeys, Bundle-of-Sticks Notions in Legal and Economic Scholarship, 8 ECON. J. WATCH 205, 209 (2011).
75 Barton Beebe, The Semiotic Analysis of Trademark Law, 51 UCLA L. REV. 621, 624 (2004) (a trademark identifies or connects its “referent,” i.e., the goods or services referred to by the word or symbol constituting the mark, “with a specific source and that source’s goodwill.”) [hereinafter Beebe, Semiotic Analysis]. See also Rebecca Tushnet, Looking at the Lanham Act: Images in Trademark and Advertising, 48 HOUS. L. REV. 861, 863 (2011) (“[B]y definition, a trademark is an indicator of source.”).
76 See supra notes 28-30 and accompanying text.
77 See supra Part I.C.
inclosure.” This is, in a way, an extension of the Lockean labor theory – property becomes one’s possession when one mingles one’s labor or energy with the property.

Adverse possession also provides a notice function. Use must be open and notorious so the real owner knows the user has taken unauthorized possession can remedy it, if the owner is so inclined.

Part II.A discusses the rationales typically marshaled to justify adverse possession of real property. Part II.B then briefly summarizes the justifications for trademark ownership. Part 0 then explains in detail how the acquisition of real property through adverse possession most closely resembles the trademark owner. In that Part, the Article addresses the several potential objections to the analogy.

A. Rationales for Adverse Possession

Adverse possession of real property is generally justified for three interlocking reasons. First, there is a public policy that favors quieting title and putting stale claims to bed. Second, the owner of real property is seen to “demerit,” or deserve to lose the property, due to inattentiveness or

78 Van Valkenburgh v. Lutz, 304 N.Y. 95, 98 (1952) (citing N.Y. CIV. PRACTICE ACT § 40). See also id. at 102 (Fuld, J., dissenting) (“[W]e have often sustained findings [of adverse possession] based on evidence of actual occupation and improvement of the property in the manner that ‘owners are accustomed to possess and improve their estates.’ “).


80 Trademark use also fulfills a notice requirement. Zazú Designs v. L’Oréal, S.A., 979 F.2d 499, 503 (7th Cir. 1992) (“Only active use allows consumers to associate a mark with particular goods and notifies other firms that the mark is so associated.”). The court in Zazú goes on to suggest that “[L]iberality in registering marks is not problematic, because the registration gives notice to latecomers, which token use alone does not. Firms need only search the register before embarking on development.” Id. at 504.

81 Henry W. Ballantine, Title by Adverse Possession, 32 HARV. L. REV. 135, 135 (1918). Ballantine articulated three adverse possession rationales: (1) the demerit the dispossessed title owner; (2) the merit of the encroaching adverse possessor; and (3) a public policy interest in quieting titles, “providing proof of meritorious titles, and to correct errors in conveyancing.” Id.

82 “demerit v.”, OED ONLINE (“to fail to merit; to deserve to lose or be without”) (2d ed. 1989; online version Sept. 2011).
failure to put the property to productive use. Third, the adverse possessor is seen to merit the property, in part because she puts the property to productive use, or at least demarcates property boundaries in a way that discloses their existence to others who might be interested in the property. The first justification essentially follows the general preference for settled claims. The second and third justifications ground the actual transfer of title from the title holder to the adverse possessor.

1. Adverse possession helps settle claims.

There are several rationales for adverse possession can be grouped under the policy preference for settled claims. The law generally favors the alienability of property and so enables third parties to rely on the appearance of title secured via adverse possession after a certain point. Thomas Merrill posits that “[t]he institution of adverse possession is designed to reduce [the] drag on the market by extinguishing most of the older claims.” Richard Epstein likewise suggests that adverse possession exists primarily to minimize administrative and transaction costs by allowing purchasers and lenders to treat the current possessor as the record owner. Thomas Merrill concludes that without a mechanism for “eliminating old claims to property,” transaction cost problems can manifest even in a world of perfect recordation.

Adverse possession is also justified in part by a desire to prevent unfairness. Adverse possession may correct those situations where the title holder waits for improvements to be made by the adverse possessor and

84 Eric R. Claeys, Locke Unlocked, supra note 79 at 53 (Locke’s property theory is best described as a theory of property rights secured through productive labor).
85 Carol M. Rose, Possession as the Origin of Property, 52 U. CHI. L. REV. 73, 88 (1985) [hereinafter Rose, Possession].
88 Merrill, Adverse Possession, supra note 86 at 1129. See also Ballantine, supra note 81 at 143 (“If we had a scientific system for the registration of titles, adverse possession would be of far less importance…. But under our crude conveyancing and recording system this doctrine is indispensable as a protection to just titles.”).
then intervenes, taking control of the improvements. After the statutory period is met, the former title owner cannot seize the adverse possessor’s improvements.

The fairness rationale is nevertheless somewhat troubling inasmuch as it strips the record owner of title to the property. The next subpart discusses in more detail the potential demerit of the title owner which supports the transfer of the title. But assuming notice, there is no inherent unfairness in setting a time within which a claim for ejectment must be brought. It is true that there is a wide range of statutory periods in which an adverse possessor can secure title through exclusive and continuous occupation of the property, suggesting some arbitrariness in the time required. While the differences between a five-year window and a 40-year window appear fairly drastic, the state is rightly empowered to set that window. Differences in duration are likely keyed to different policy objectives regarding the ease with which an adverse possessor should be able to secure title to the property of another. And even if the differences between state statutory windows were arbitrary, it is not necessarily unfair to cut off the stale claims of the title owner at some point, even if that point is selected arbitrarily, so long as she is on notice of that statutory window.

In addition, adverse possession occurs over a period of years. Lior Strahilevitz has thus suggested that the knowing adverse possessor is unlikely to put the property to its highest value use for the entirety of the statutory period because she cannot be sure that the title owner will not claim the property along with any improvements made. For Strahilevitz, who suggests that adverse possession and abandonment regimes might be seen as functional substitutes, this militates in favor of an abandonment

89 Merrill, Adverse Possession, supra note 86 at 1128. (“Requiring that disputes be resolved promptly prevents the plaintiff from unfairly surprising the defendant with a claim that may be difficult or impossible to refute because evidence that would allow the defendant to defeat the claim no longer exist.”).
90 See supra Part II.A.2.
91 See supra note 65.
92 See generally J.M. Netter, P.L. Hersch & W.D. Manson, An Economic Analysis of Adverse Possession Statutes, 6 INT’L REV. L. ECON. 217 (1986) (arguing that states made an economically rational tradeoff in selecting between a shorter statutory period for adverse possession, which reduces uncertainty as to title in subsequent property transfers, and longer statutory periods which reduce the cost to property owners of protecting their property).
94 Id. at 415-16.
regime for real property,\textsuperscript{95} which would provide some security for the knowing adverse possessor to begin putting the property to its highest value use, instead of the level of use sufficient to constitute use typical for the type property in the community.\textsuperscript{96}

The danger of ambush is remedied by eventual adverse possession, much like the equitable defense of laches, which “prevent[s] deceptive or incredibly ignorant [parties] from unfairly benefitting by an eleventh-hour ambush of their unsuspecting opponents.”\textsuperscript{97} Note that the question of unfairness is not merely a question of settling claims at a certain point, but implicates the question of how to weigh the benefit provided by the adverse possessor against the demerit of the property owner, a question addressed in the next two subparts.

2. Adverse possession transfers property from undeserving original owners.

Embedded in the notion of fairness is the idea that the title owner might not be the highest value property owner, or might somehow otherwise fail to merit continued ownership of the property. Adverse possession effective strips title from the record owner who “sleeps on” her rights.\textsuperscript{98} Thomas Merrill groups the “sleeping owner” with the other rationales which explain why the claim of the title owner is cut off, arguing that the rationale fails to explain the creation of “a new root of title.”\textsuperscript{99} Removing property from the stewardship of the sleeping owner may nevertheless be justified in addition to, or in spite of any interest in settling claims. While Professor Merrill is right to remind that we generally do not require property owners to actively use their property, instead allowing them to hold the property and wait for an opportunity to arise to use, sell or otherwise exploit the property,\textsuperscript{100} an

\textsuperscript{95} Strahilevitz notes that many common law cases prohibit abandonment of real property, but argues they should be overruled. \textit{Id.} at 399-402, 418. \textit{See also SINGER, supra} note 18 § 4.3 at 163 n.95.

\textsuperscript{96} Strahilevitz, \textit{supra} note 93 at 417.

\textsuperscript{97} In re Williams, 124 B.R. 311, 316 (1991), \textit{superseded by statute as stated in} In re Gardner, 208 B.R. 698, 699-700 (1997). \textit{See also} Ellis v. Ashwood Realty LLC, 2001 Mass. LCR Lexis 120 (2011) (“Laches has been described as a method of defending against ‘legal ambush’ and as ‘an equitable defense consisting of unreasonable delay in instituting an action which results in some injury or prejudice to the defendant.’”) (quoting Yetman v. Cambridge, 7 Mass. App. Ct. 700, 707, 389 N.E.2d 1022 (1979)).

\textsuperscript{98} Merrill, \textit{Adverse Possession, supra} note 86 at 1130.

\textsuperscript{99} \textit{Id.} at 1133.

\textsuperscript{100} \textit{Id.} at 1130.
owner who fails to recognize adverse possession for longer than the required window of continuous use appears less likely to take any advantage of the property than a possessor who is actively engaged with, or at least willing to demarcate the boundaries of the property she possesses. Thus, the demerit justification is founded not only on the notion that the record owner is failing to use or exploit the property, but also failing even to monitor the property.

We might nevertheless worry that grounding transfer in the title holder’s non-use is problematic to the extent we are moving from a development to a conservation model of property ownership in the United States. The demerit justification may therefore be flawed, at least in those situations where the best use might be no use at all. For example, if the highest value use of a parcel of property is conserving it in its current state for future generations, then allowing an encroacher to take control of the property based on an ostensibly higher value use seems inherently incorrect. Perhaps the property owner should be able to rely upon the police power of the state and maintain ownership rights without aggressive self-help or personal policing. If so, the adverse possession doctrine might overreach to the extent it requires the property owner to engage in any self help at all.

This conservation critique of the demerit rationale is an oversimplification for two reasons. First, there are many areas in which we might correctly value self-help, in part because we want the rightsholder to engage in whatever monitoring she sees fit, but to actively engage in it. For example, Section 512 of the Copyright Act allows the copyright owner to insist that online service providers [“OSPs”] remove (access to) unauthorized copies of protected works from the internet, but the OSP is required to remove only those works that the copyright owner effectively identifies.

101 See also John G. Sprankling, An Environmental Critique of Adverse Possession, 79 CORNELL L. REV. 816, 857-62 (1994) (asserting that preservation of wild lands in their natural condition may be socially preferable to economic development by adverse possessors).

102 See, e.g., Epstein, supra note 87 at 692-93 (suggesting that adverse possession is “a problem solved” by a more efficient system to clear title and easier access to public force to protect property rights). But see Grantland M. Clapacs, Note, “When in Nome…..”: Custom, Culture and the Objective Standard in Alaskan Adverse Possession Law, 11 ALASKA L. REV. 301, 302-03 (1994) (suggesting in areas like the Alaskan wilderness where there might be limited law enforcement resources, “self-help and legal action may still be the primary methods for resolving property disputes”).

103 See 17 U.S.C. § 512(c)(3).
it is one thing to suggest that we value conservation in and of itself, and another to excuse any failure to monitor to ensure that the property is properly conserved. As discussed in more detail in the next subpart, a potential high value user might be at fault if she sleeps on her rights, fails to pay sufficient attention to the property, or fails to at least police the boundaries of her property. Inattentiveness might therefore also serve as a proxy for the value of use.\textsuperscript{104}

It cannot be the case, however, that the demerit of the property owner is the only justification for the transfer of title.\textsuperscript{105} If the law merely sought to dispossess inattentive record owners, an abandonment regime would work just as well.\textsuperscript{106} Such a regime could properly consider the evidence that the adverse possessor was failing to secure the property or otherwise put it to reasonably productive use in the community. Where the demerit of the record owner was significant, the property would fall back to the public domain, to be claimed again via auction, capture, or some other means of initial possession. We thus turn to the question of whether, and in what cases, the adverse possessor might also merit title.

3. Adverse possession transfers property to meritorious new users.

The English common law discounted the merit of the adverse possessor,\textsuperscript{107} and the merit rationale has strong critics. Henry Ballantine concludes that adverse possession has no goal of rewarding the diligent trespasser or penalizing the sleeping owner, but “the great purpose” is simply to quiet title, prove meritorious titles, and correct conveyancing errors.\textsuperscript{108} Thomas Merrill criticizes what he sees as the four major permutations of the reliance based merit rationale – preserving the peace;\textsuperscript{109} honoring the adverse possessor’s personal attachment to property as part of her

\textsuperscript{104}See infra notes 133-134.
\textsuperscript{105}Eric Claeys, however, sees the demerit rationale as fundamental to the productive labor theory undergirding John Locke’s view of property law. Claeys, \textit{Locke Unlocked}, \textit{supra} note 79 at 52.
\textsuperscript{106}Strahilevitz, \textit{supra} note 93 at 415-18.
\textsuperscript{107}Ballantine, \textit{supra} note 81 at 135. (“English lawyers regard not the \textit{merit} of the possessor, but the demerit of the one out of possession.”) (quoting Ames, \textit{LECTURES, LEGAL HISTORY} 197).
\textsuperscript{108}Ballantine, \textit{supra} note 81 at 135.
\textsuperscript{109}See e.g., Warsaw v. Chicago Metallic Ceilings, 676 P.2d 584, 590 (Cal. 1984).
identity;\textsuperscript{110} a sunk-cost or quasi-rents rationale grounded in forestalling holdout by the record owner who extracts extra rents from the adverse possessor who has invested in the property;\textsuperscript{111} and reliance of the public on the adverse possessor’s apparent ownership\textsuperscript{112} – because none of them actually justify transferring the property to the adverse possessor. They merely justify barring the record owner’s action for ejectment.\textsuperscript{113}

One might initially point to the ability of the adverse possessor to meet the required factors as providing evidence of meritorious use, but that should not be overstated. As Lior Strahilevitz notes, the use required of an adverse possessor is not necessarily high value, merely use consistent with the character of the property and its location.\textsuperscript{114} In addition, the requirements that possession be actual, open and continuous provides can all be justified in the desire to provide the record owner with sufficient notice of the threat to her property right, so that only the truly disinterested or inattentive property owner loses title, which helps the public discern which title owners might demerit the property. Even unproductive occupation could provide notice to the owner that someone hoped to obtain possession over the land, even if land in that neighborhood was typically put to other purposes.\textsuperscript{115} As commonly understood, however, both the actual use and open use factors do more than provide notice to the property owner. Indeed, adverse possession is driven in equal, if not greater parts by the value of the adverse possession.

In \textit{The Path of the Law}, Justice Holmes posits that “the foundation of the acquisition of rights” by adverse possession is to be found “in the position

\textsuperscript{110} See \textit{e.g.}, Oliver Wendell Holmes, \textit{The Path of the Law}, 10 HARV. L. REV. 457, 476-77 (1897).

\textsuperscript{111} \textit{But see} Strahilevitz, \textit{supra} note 93 at 417-18, arguing the savvy knowing adverse possessor will keep investments to a minimum until the statutory window closes.

\textsuperscript{112} See Merrill, \textit{Adverse Possession}, \textit{supra} note 86 at 1132.

\textsuperscript{113} \textit{Id.}

\textsuperscript{114} Strahilevitz, \textit{supra} note 93 at 417 (citing \textit{inter alia} Trask v. Nozisko, 134 P.3d 544, 549 (Colo. Ct. App. 2006) (holding that the adverse possessor sufficiently occupies by making ordinary use of the land)). \textit{Cf.} Merrill, \textit{Adverse Possession}, \textit{supra} note 86 at 1130-31 (all the record owner is required to do not to demerit the property is “periodically…assert his right to exclude others.”).

\textsuperscript{115} Larissa Katz notes, however, that under the inconsistent use test applied in Canadian law, it is the only the possessor who puts the property to different use than the owner who can secure through adverse possession. Larissa Katz, \textit{The Moral Paradox of Adverse Possession: Sovereignty and Revolution in Property Law}, 55 MCGILL L.J. 47, 65 (2010).
of the person who gains” rights.\textsuperscript{116} “A thing which you have enjoyed and used as your own for a long time,” opined Holmes, “takes root in your being and cannot be torn away without your resenting the act and trying to defend yourself, however you came by it.”\textsuperscript{117} Keith Hirowaka suggests that Justice Holmes was articulating a “care” rationale for adverse possession, positing that “as between an absentee title owner, who has a personal and identity interest in the title, and an occupant whose identity is tied closely to the land, the law favors the relationship, and is more reluctant to sever a physical and emotional attachment than a mere paper title.”\textsuperscript{118} We might also follow Joseph Singer in referring to this as a “justified expectation” rationale, where if the adverse possessor has been using the land, but the record owner has not, observing the legal title formality might upset settled expectations.\textsuperscript{119} Judge Richard Posner casts this reliance rationale as turning on the diminishing returns of the absentee owner and the increasing attachment of the adverse possessor.\textsuperscript{120}

Justice Holmes’ reliance rationale could instead be seen as related to the labor theory of property ownership proposed by John Locke,\textsuperscript{121} where adverse possession is justified to the extent that the adverse possessor is providing some positive value or productive use.\textsuperscript{122} Margaret Jane Radin argues that adverse possession is not Lockean, but perhaps should color how we look at squatters. Radin posits that if taking property from the common is justified by possession and use, we might also “sympathize

\begin{footnotesize}
\textsuperscript{116} Holmes, supra note 110 at 476-77.
\textsuperscript{117} Id. at 477.
\textsuperscript{118} Keith K. Hirowaka, Property as Capture and Care, 74 ALB. L. REV. 175, 188 (2010-2011).
\textsuperscript{119} See generally JOSEPH WILLIAM SINGER, ENTITLEMENT: THE PARADOXES OF PROPERTY (2000). See also SINGER, supra note 18 § 4.3 at 162. This rationale is also reminiscent of Thomas Merrill’s recent attempt to reinvigorate accession theory, a doctrine under which newly created resources are assigned to the owner of some other thing related to the resource. See generally Merrill, Accession, supra note 20.
\textsuperscript{120} RICHARD POSNER, ECONOMIC ANALYSIS OF LAW § 3.10, at 70 (3d ed. 1986).
\textsuperscript{121} JOHN LOCKE, TWO TREATISES OF GOVERNMENT.
\textsuperscript{122} Michael Carrier, Cabining Intellectual Property Through a Property Paradigm, 54 DUKE L.J. 1, page n.224 (2004) (“Adverse possession, for example, reflects not only a utilitarian conception of robust land development but also personhood and labor theories: an adverse possessor identifies more directly with the land than does its absentee owner (personhood) and has a Lockean claim based on development of the land (labor).”) (citing Holmes, supra note 110 at 476-77).
\end{footnotesize}
with someone who [takes and uses] owned but unused property”. 123 Larissa Katz argues along similar lines that “the morality of adverse possession is found… in its positivist strategy of ratifying the claims to authority of a squatter without regard to the substantive merits of her agenda or her personal virtue.” 124

We might also prefer to push all adverse possessors into the market by requiring title searches and at least an initial attempt to purchase the property through market channels. Lee Anne Fennell sees the bad faith (knowing) adverse possessor who attempts and fails to purchase the property as the only adverse possessor who actual merits transfer, because his is the only case where an actual market failure occurs. 125 The knowing adverse possessor who can document her awareness is the only potential adverse possessor for whom market transactions will fall short. 126

Carol Rose notes adverse possession might have another justification, in addition to rewarding “the useful laborer at the expense of the sluggard.” 127 The adverse possession factors are traditionally understood to inquire whether the adverse possessor provides a clear signal about her claim that an attentive record owner could not fail to appreciate. Successful adverse possession also provides an important signal to the public. For Rose, some of the value of adverse possession, like capture or initial possession, stems from its ability to communicate a claim of right to the public through a “clear act.” 128 Rose argues that possession is communicative, a “statement”


124 Katz, supra note 115 at 47.

125 Fennell, supra note 83 at 1064 (“As misguided as the ‘sleeping versus working’ rationale may seem, it gestures, however clumsily, in the direction of a much more legitimate social goal – that of moving scarce resources into the hands of those who place the highest value on them.”).

126 Id. at 1095 (arguing that “there is only one goal that adverse possession uniquely serves – facilitating certain classes of very efficient transfers where markets cannot do so.”).

127 Rose, Possession, supra note 85 at 79.

128 Id at 79 (adverse possession may be designed “to require the owner to assert her right publicly. It requires her to make clear that she, and not the trespasser, is the
providing “notice to the world through a clear act.”129 Rose thus sees the famous fox capture case, *Pierson v. Post*, as a case in which Lockean labor theory and Blackstone’s theory that possession is a communicative “clear act” merge.130 The capturing owner *both* adds value to or mixes labor with the captured property and signals to the public its claim to the property. Proper or “suitable” use provides notice to the public.131 Rose thus posits that failure to eject or locate the adverse possessor justifies the transfer of property because the record owner “fails to correct misleading appearances” while the adverse possessor “speaks loudly and clearly,” which allows the public to “rely upon their own reasonable perceptions.”132

Eduardo Peñalver and Sonia Katyal suggest that adverse possession is justified precisely because the adverse possessor’s willingness to possess in the face of possible dispossession before the end of the statutory period as well as criminal and civil sanctions signals that she highly values the property.”133 On the other hand, the record owner’s failure to take action against the adverse possessor within the statutory period signals the low value she places on the property.134 Thus, adverse possession provides signals the comparative value that record owner and adverse possessor place on the property. The record owner retains title by evicting the encroacher, sending a signal of its valuation. The adverse possessor must do more, engaging in some productive use. This use signals to the public not only that the adverse possessor values the property, but that society should value the use to which the adverse possessor puts the property. As the next section discusses, there are similar rationales animating trademark ownership.

### B. Rationales for Trademark Ownership

The dominant justification for trademark rights has been an economic rationale: trademark protection is arguably designed to reduce consumer
search costs and provide an incentive to the mark owner to provide goods and services of consistent quality. \(^{135}\) In addition to lowering search costs, trademark protection serves a correlative function of protecting the public from deceit or fraud by providing a remedy against confusing misappropriation of trademarks. \(^{136}\)

Mark owners are incentivized to maintain a certain quality of goods in part because they can rely on trademark law to help remedy some attempts to free ride on the goodwill that stems from providing quality goods. \(^{137}\) As a by-product, trademark protection also protects producer investment in developing source signification in the mark. \(^{138}\)

While Thomas Merrill has criticized the strong version of the demerit justification for adverse possession because it would require a real property owner to actively use her property to secure it from adverse possession, \(^{139}\) it is a better fit with the use required of the trademark owner. Adverse possession, as we have understood it, requires some type of transformation outside the control of the original owner – productive use of the real property, or at least an effort to fence the property off from unauthorized users. Likewise, courts require trademark owners to provide evidence that

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\(^{135}\) See Beebe, *Semiotic Analysis*, *supra* note 75 at 623-24 (concluding that the search cost account has become the “definitive theory of American trademark law.”). *But see* Mark McKenna, *Consumer Decision Theory*, 98 VA. L. REV. (forthcoming) (2012) (arguing that the “search costs theory distorts trademark law because neither confusion nor search costs are the right focus.”). Instead, McKenna suggests that consumer preferences should be treated as “exogenous to, the trademark system,” and thus trademark law should be limited to remedying those circumstances where “a use threatens to prevent a consumer from acting on [her] preferences.”).

\(^{136}\) Frank A. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 819 (1927) (arguing that trademark protection “originated as a police measure to prevent ‘the grievous deceit of the people.’”).

\(^{137}\) Union Nat’l Bank, Laredo v. Union Nat’l Bank, Austin, 909 F.2d 839, 844 (5th Cir. 1990) (“[T]rademarks … encourage higher quality production by discouraging free-riders.”).


\(^{139}\) Merrill, *Adverse Possession*, *supra* note 86 at 1130.
they are controlling the transformation of the trademark, both to initially secure rights in the mark, and to prevent its eventual dissolution.\footnote{See supra note 29.}

The trademark owner resembles the Lockean laborer reducing property to ownership to the extent she bends a preexisting word or symbol to use as a source signifier to distinguish her goods from those of her competitors. She initially resembles the adverse possessor even when she must engage in substantially exclusive and continuous use to acquire distinctiveness in a mark that is otherwise descriptive of some quality of her goods. She resembles the creative author or inventor imagined in the Intellectual Property clause of the Constitution\footnote{U.S. CONST., Art. I, § 8, cl. 8 (“The Congress shall have power….to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries”).} when she coins a new word or invents a fanciful variation on an existing word to identify her services. But in all these cases, the requirement of continual and continuous use pushes the trademark owner into a role similar to the adverse possessor of real property.

To the extent that adverse possession must be, or is best grounded in focusing on the merits of the encroaching party, it is the adverse possessor who may provide value to the public superior to that of the inattentive record owner. Unless she does, transfer should not be made. In the trademark litigation context, it is the mark owner who must engage in trademark use associated with the trademark lexeme, developing its capacity as a signifier of goods and services from a particular source, a lexical embodiment of the goodwill between producer and consumer.

The merit justification is the closest fit for the trademark owner as adverse possessor, because under the economic justification for trademark protection, the existence of trademarks lowers consumer search costs. The trademark owner’s security in its property is contingent on continued use. This is so in part because the demerit rationale does not appear to support the acquisition of trademark rights. The “public” does not necessarily demerit some claim to a given grammatical unit once it is pressed into service as a trademark.\footnote{But see infra Part III.C.} Public use of words or symbols may do little to establish source signification or reduce search costs, the economic rationale justifying trademark rights.\footnote{See supra note 135 and accompanying text.}

\footnotesize

\begin{itemize}
\item \textit{See supra} note 29.
\item \textit{U.S. Const.}, Art. I, § 8, cl. 8 (“The Congress shall have power….to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries”).
\item \textit{But see infra} Part III.C.
\item \textit{See supra} note 135 and accompanying text.
\end{itemize}
a search cost rationale for trademark ownership, it may be that the
trademark owner’s use is of “higher value” than some public uses.\footnote{But see, e.g., Jessica Litman, Breakfast with Batman, 108 Yale L.J. 1717, 1730 (1999) (“If producers have invested in their trade symbols…so have we. The argument that trade symbols acquire intrinsic value … derives from consumers’ investing those symbols with value for which they are willing to pay real money….”).}

The demerit rationale does ground many of the affirmative defenses raised in an action for trademark infringement. Abandonment, acquiescence, antitrust violations, trademark misuse, and unclean hands all turn on improprieties of the trademark owner, while dwelling little on the merit of the encroaching junior user. The junior user need not establish that it has secured its own trademark rights, merely that the prior user has, through inattentiveness, lost the ability to assert trademark rights, or allowed a problematic narrowing of her rights. Laches operates in a similar manner, although it includes some sense of balancing the value of the junior use against the inattentiveness and potential ambush of the senior user.

Courts and scholars, to the extent they have considered the potential overlap of trademark ownership and the acquisition of real property through adverse possession, have typically analogized the way a junior user displaces the senior user’s claim to the mark. In this literature, trademark owners are cast in the defensive role akin to an owner of real property striving to fend off an adverse possessor.\footnote{See supra notes 8-11 and accompanying text.} This means either the junior user or the public (or both) must be cast as the adverse possessor. This is at best incomplete. The adverse possessor’s slipper fits less comfortably on the junior user. The similarity is the strongest for the trademark owner who secures of ownership interest in a trademark through open and notorious use of a mark under claim of right, in substantially exclusivity and continuously prior to other users, much like an adverse possessor secures title to real property. Like adverse possession, trademark protection is geared to provide clear signals that enable efficient commercial transactions. And like adverse possession, trademark ownership is grounded in productive use.

C. Trademark Acquisition Through the Lens of Adverse Possession

Let us address a few obvious objections to the analogy between trademark acquisition and adverse possession at the outset. First, property held in
common for the public generally cannot be adversely possessed.\footnote{Compare Cinque Bambini Partnership v. State, 491 So. 2d 508, 521 (Miss. 1986) ("The State’s title may not be lost via adverse possession, limitations or laches.") with Mountain States Tel. & Tel. Co. v. Pueblo of Santa Ana, 472 U.S. 237, 244 (U.S. 1985) (noting that the Pueblo Lands Act of 1924 allowed non-Indian possessors of Pueblo grant lands to extinguish a Pueblo’s title, if the non-Indian had continuously, openly and notoriously adversely possessed the land and paid taxes). See also generally, 55 A.L.R.2d 554. But see Burgess v. Gilman, 475 F. Supp. 2d 1051, 1061-62 (D. Nev. 2007) (concluding that services marks seized by the government from the Mustang Ranch brothel were not abandoned by temporary misuse while in government hands, in part because of the general rule that government property cannot be adversely possessed).} Maya Alexandri argues that this general rule essentially derails any rationale for quieting title in language held by the government “in trust for the populace, [because] a firm cannot remove a word from the public domain simply by using it exclusively for five years.”\footnote{Maya Alexandri, The International News Quasi-Property Paradigm and Trademark Incontestability: A Call for Rewriting the Lanham Act, 13 Harv. J.L. Tech. 303, 320 (2000).} This could apply to any acquisition of trademark rights, because the morphemes and phonemes comprising every word mark are in the public domain, and the same can be said for the building blocks of design marks and trade dress.

Note, however, that the general rule against adversely possessing public property does not apply universally.\footnote{See, e.g., Richert v. San Diego, 293 P. 673 (1930).} In some jurisdictions adverse possession can occur when the property at issue is not used for public purposes but held by the state for private or community-specific purposes.\footnote{See, e.g., Chicago v. Middlebrooke, 32 N.E. 457, 143 Ill. 265 (1892) (vacant lot owned by the city but not held for public use was not exempt from the statute of limitations for real actions). But see, e.g., City of Gainesville v. Gilliland, 718 S.W.2d 553 (Mo. Ct. App. 1986).} Several states boast statutes which expressly adverse possession of state or municipal property.\footnote{State v. Harman, 50 S.E. 828 (W. Va. 1905) (holding that wild land not used in government administration was subject to adverse possession under the statute of limitations because state owned land was subject to the statute of limitations unless specifically exempted). See also generally 55 A.L.R.2d 554 ¶¶ 3, 31(a).} Trademarks, while drawn from the public domain, have been designated as subject to private ownership. The Lanham Act protects both registered and unregistered trademarks.\footnote{15 U.S.C. §§ 1114(1); 1125(a).} Most state legislatures have created both registration regimes and expressly
recognized common law rights in trademarks.\textsuperscript{152} As the both the federal and state governments have carved out statutory trademark protection, the objection that adverse possession cannot claim public property should not apply to trademarks.

Congress has, however, held one source material “in trust for the populace” that cannot be drawn out of public domain through trademark use: the generic term that functions only to designate the genus of the work. The registration of an \textit{ex ante} generic term is not allowed, because those marks are held in common for the public, to enable competitors to bring products to market or offer services identified in a way that allows consumers to find the products or service.\textsuperscript{153} Note that only \textit{ex ante} generic terms are restricted from trademark use in this way. Even marks that become generic through the mark owner’s misuse, like SINGER once became generic for the owner’s formerly patented sewing machines,\textsuperscript{154} can be rehabilitated through the efforts of the mark owner.\textsuperscript{155}

Second, trademark use is an affirmative and continuous obligation on the trademark owner, in a way that the title owner in not generally required to use real property. Trademarks may not be warehoused, but real property may be left idle in perpetuity, so long as the title holder meets its obligations to monitor the property against adverse possessors. It is, of course, this monitoring requirement that leads many reasonable scholars to

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\item \textsuperscript{152} See, e.g., Fla. Stat. § 495.161 (1967) (Florida registration regime does not preempt common law protection); Id. § 495.031 (establishing state trademark registration regime). \textit{See also generally} \textit{WEST: RENEWAL, ASSIGNMENT, AND CANCELLATION OF TRADEMARKS AND REGISTRATION OF TRADEMARKS} (2011).
\item \textsuperscript{153} Kellogg Co. v. National Biscuit Co. 305 U.S. 111, 116 (1938) (“Since the term [shredded wheat] is generic, the original maker of the product acquired no exclusive right to use it.”). \textit{See also} W.R. Grace & Co. v. Union Carbide Corp., 581 F. Supp. 148 (S.D. N.Y. 1983) (\textit{ex ante} generic words cannot be registered as marks). The Lanham Act uses “generic” to describe abandonment via \textit{ex post} genericness, 15 U.S.C. § 1127, “abandonment”, but does not explicitly discuss \textit{ex ante} genericness. Professor McCarthy suggests that while 15 U.S.C. § 1064(3) refers specifically to the cancellation of a mark on genericness grounds, it should also apply to the initial attempt to register a generic term. 2 \textit{McCarthy}, supra note 16 § 12:5, n.6.
\item \textsuperscript{155} Singer Mfg. Co. v. Briley, 207 F.2d 519, 520-21 n.3 (5th Cir. 1953) (holding that the mark owner had “by the constant and exclusive use of the name ‘Singer’ in designating sewing machines and other articles manufactured and sold by it and in advertising the same continuously and widely—recaptured from the public domain the same ‘Singer’”). \textit{See also supra} note 29 and accompanying text.
\end{itemize}
criticize the adverse possession regime. But in a way, adverse possession is one of many ways that Anglo-American property law has developed to enable the eventual expiration of property rights, or at least bar unreasonable restraints on alienation, even in the absence of an abandonment regime for real property. Likewise, the trademark use requirement and trademark’s abandonment regime keep marks from going stale in the hands of an owner who fails to put them to commercial use.

A third objection stems from the fact that real property is fixed in physical space in a way that a trademark cannot be. Adverse possession of chattels has been rejected by courts when they recognize that open and notorious use of a chattel “may not be sufficient to put the original owner on actual or constructive notice of the identity of the possessor.” If adverse possession is troubling as a means of securing property rights against the chattel owner, it is equally as troubling for the trademark owner. Like other non-rivalrous goods, including copyrights and patents, intellectual property protection allows the mark owner to recoup the marketing efforts that make the trademark function as a signal which reduces the search costs of consumers. And like those types of intellectual property, it can be difficult to detect trademark infringement. The owner of real property is assumed to be capable of detecting open and notorious encroachment of that property. The presumption isn’t the same for the trademark owner. In fact, as I discuss in Part III.B.1, supra, the way in which the junior user resembles an adverse possessor most is where the trademark owner commits the sin of laches, letting the junior user build her reliance on a

\footnote{156 See supra notes 100-101 and accompanying text.}

\footnote{157 See generally Strahilevitz, supra note 93.}


\footnote{159 David W. Barnes, A New Economics of Trademarks, 5 N.W. J. TECH. & INTELL. PROP. 22, 55-56 (2006) (arguing that trademarks are impure public goods with non-rivalrous characteristics, a conclusion reached as a “natural outgrowth of the search cost theory.”).}

\footnote{160 Id. at 58.}

mark when the trademark owner has *knowledge* of the use. Without knowledge of the use, the mark owner cannot lull the junior user into a false sense of security. On the other hand, it is the trademark owner who must put potential competitors and the public on effective notice of her claim to a given mark to secure rights in that mark.

In the end, the fact that the trademark owner and adverse possessor acquire somewhat different rights does not mean there are not important similarities in the way those differing rights are acquired. Detection and duration issues aside, it is in the acquisition of trademark rights where the parallel to adverse possession is most helpful. We start our examination of the analogy by considering the requirements of entry and possession faced by adverse possessor and trademark user alike.

1. Actual entry and possession.

In order to claim property through adverse possession, there must be actual entry, that is to say, “the possessor must physically occupy the premises in some manner.” Generally, courts look to the typical use to which property of that type is put. Fencing the property is usually treated as actual possession of the entire fenced portion. Likewise, taking the property under color of title is usually sufficient to establish use of the entire parcel designated in the faulty title, so long as the adverse possessor is using part of the property. Without evidence of either fencing or color of title, entry and possession turn on evidence of actual occupation and productive activity on a given parcel, and the adverse possessor is generally

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162 See infra note 317 and accompanying text.
163 Often, the best way to do so includes physical manifestations of ownership. See infra Part II.C.2.
164 SINGER, *supra* note 18 § 4.2.1 at 145.
successful in claiming title only to that portion of that property where actual possessory activity took place.\textsuperscript{168}

The trademark owner establishes her rights through the use of a given word or symbol to designate a source for goods or services, creating a trademark lexeme.\textsuperscript{169} Trademark ownership can only be secured through the use of the mark in commerce.\textsuperscript{170} Registration alone secures no rights.\textsuperscript{171} For inherently distinctive marks, trademark protection is granted automatically upon “the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.”\textsuperscript{172} On the other hand, use of a descriptive mark – like SEALTIGHT for self-sealing fasteners\textsuperscript{173} – obtains no priority over other users of identical or similar marks until SEALTIGHT acquires distinctiveness.\textsuperscript{174} For a descriptive mark, this process can resemble the labors of Hercules.\textsuperscript{175} But to maintain rights even an inherently distinctive mark, the mark owner must consistently and continually use the mark in commerce or the mark may be deemed effectively unenforceable, if not outright abandoned.\textsuperscript{176}

The use requirement in trademark law is surprisingly sticky. Even in those cases where Congress has created ostensible exceptions, the use requirement repeatedly reasserts itself. Under the Madrid Protocol, owners of foreign trademark registrations can secure a registration from the USPTO without using the mark, but that mark will subsequently be deemed

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\item \textsuperscript{168} Crowley v. Whitesell, 702 S.W.2d 127, 128 (Mo. Ct. App. 1985) (“As plaintiffs did not have color of title over the land, they must prove actual possession of the entire tract.”).
\item \textsuperscript{169} See supra notes 25-32 and accompanying text.
\item \textsuperscript{170} McCarthy, supra note 16 at 19:1.75 (“[R]egistration in the U.S. does not create the trademark, the owner creates the underlying right though use in the marketplace.”).
\item \textsuperscript{171} Am. Express Co. v. Goetz, 515 F.3d 156, 161 (2d Cir. 2008) (“[T]here can be no trademark absent goods sold and no service mark without services rendered.”).
\item \textsuperscript{172} 15 U.S.C. § 1127 (“Use in Commerce”). See also McCarthy, supra note 16 at § 16:8.
\item \textsuperscript{173} Professor McCarthy divides marks into those business symbols which are inherently distinctive and those that are not. He refers to the latter category as “secondary meaning marks.” See, e.g., McCarthy, supra note 16 at § 16:34.
\item \textsuperscript{175} See, e.g., Telmed Corp. v. Tel-Med, Inc., 588 F.2d 213, 220 (no secondary meaning despite expending $1 million on advertising).
\item \textsuperscript{176} See generally McCarthy, supra note 16 at 16:9.
\end{itemize}
abandoned if use in commerce never occurs.\textsuperscript{177} Hopeful mark owners may also file an application to register a mark based on a bona fide intent to use the mark in commerce. The holder of an ITU application cannot secure a certificate of registration until she can satisfy PTO that the mark has been used in commerce.\textsuperscript{178} And while the intent-to-use rules allow for repeated extensions to the deadline, courts see too frequent extension without actual use as indicating a lack of real intent to use the mark in commerce.\textsuperscript{179} An intent-to-use application may be filed, giving the holder of the registration some priority over subsequent actual users, in the end, trademark rights are created only when the prior claim is perfected through use.\textsuperscript{180} In a way, this is like the preferential treatment of adverse possessors operating under color of title, where the color of title is a plus factor, sometimes shortening the statute of limitations,\textsuperscript{181} but does not secure any rights without the associated productive use.

2. The notice function of open and notorious possession.

Adverse possession must not only be actual, but also open and notorious. Such use provides notice to the title holder sufficient to ascertain whether she values the property to the extent the possessor does.\textsuperscript{182} Possession “must be sufficiently visible and obvious to put a reasonable owner on notice that her property is being occupied by a non-owner with the intent of claiming possessory rights.”\textsuperscript{183} Actual knowledge on the part of the title holder is not required, because she is “charged with seeing what reasonable inspection would disclose.”\textsuperscript{184} The fencing of real property is usually

\textsuperscript{177} See, e.g., Rivard v. Linville, 133 F.3d 1446 (Fed. Cir. 1998).
\textsuperscript{178} See Hilliard, Deskbook, \textit{supra} note 43 § 3.06 at 62.
\textsuperscript{179} See, e.g., Salacuse v. Ginger Spirits, Inc., 44 U.S.P.Q.2d 1415 (T.T.A.B. 1997) (construing multiple and repeat filings on ITU applications as evidence that petitioner lacked the requisite bona fide intention to use the mark on the goods identified in the applications).
\textsuperscript{180} See Warnervision Entm’t Inc. v. Empire of Carolina, Inc., 101 F.3d 259 (2d Cir. 1996).
\textsuperscript{181} See \textit{supra} note 70 and accompanying text.
\textsuperscript{182} Rose, \textit{Possession}, \textit{supra} note 85 at 80-81, Peñalver \& Katyal, \textit{supra} note 134 at 129.
\textsuperscript{183} Singer, \textit{supra} note 18 § 4.2.2 at 148.
\textsuperscript{184} Rorebeck v. Criste, 398 P.2d 678, 681 (Ariz. Ct. App. 1965) (“[S]uch occupancy was open and notorious. The fence was an apparent separation of the property for all the world to see.”).
sufficient to establish open and notorious possession, and it is thus easy to see some overlap between actual possession and open and notorious possession.

Just as in the real property context, there is some overlap between actual possession and open and notorious possession. This is unsurprising, particularly in light of Professor Rose’s proposition that possession of real property “means a clear act, whereby all the world understands that the pursuer has ‘an unequivocal intention of appropriating [the property] to his individual use.’” In determining whether a trademark owner has secured rights in a mark, courts often refer to use in commerce as use that must be “open and notorious.” The obligation to use the mark in commerce is, in part, a requirement that the trademark owner’s attempted possession occur with sufficient visibility to put both potential competitors and the public on notice.

Open and notorious possession puts not only the record owner on notice, but the public as well. In considering whether a trademark owner should be allowed to develop an incontestable registration for a descriptive mark, Suman Naresh finds the visibility of the process by which the mark becomes incontestable as insufficient to support property rights, because he does not see unilateral activity as binding unless the public consents, and there is no well-placed public actor to oppose the incontestability process. Of course, it is the absence of the permission of a record owner that is a precondition of adverse possession, as discussed in more detail in the next subsection. Interestingly, lack of permission occurs whether or not there is a record owner, suggesting a link between what we think of as initial possession of the commons, and what we think of as adverse possession of owned property.

185 See e.g., Smith v. Tippett, 569 A.2d 1186 (D.C. Cir. 1990) (encircling the property within a wall is sufficiently open and notorious).
186 SINGER, supra note 18 § 4.2.2 at 148.
187 Rose, Possession, supra note 85 at 76 (quoting Pierson v. Post, 3 Cai. R. 175, 178 (N.Y. Sup. Ct. 1805)). See also Naresh, supra note 11 at 988-89.
189 See, e.g., Zazú, 979 F.2d at 503 (“Public sales let others know that they should not invest resources to develop a mark similar to one already used in trade.”).
190 See supra notes 48-50 and accompanying text.
191 Naresh, supra note 11 at 989.
192 See infra Part II.C.3.
In addition, when trying to determine whether a descriptive mark has acquired secondary meaning (or an inherently distinctive mark has amassed commercial strength), courts look to two overarching questions: whether the mark owner has made sufficient effort to establish the mark in the minds of consumers through advertising, sales volume, and length of use, and whether consumers have come to see the mark as source signifying, measured through consumer surveys and evidence of actual consumer confusion.\textsuperscript{193} Courts tend to give great weight to the efforts made by the mark owner to move the mark through commerce, including money spent on advertising, volume of product moved and sales of goods or services, and in the \textit{ex post} genericness context, efforts to educate consumers, lexicographers, and other language shapers regarding proper use of its marks.\textsuperscript{194}

Time in the market also provides prima facie evidence that the mark has acquired secondary meaning, which the PTO can choose to recognize.\textsuperscript{195} Registration itself provides its own form of open and notorious use, providing courts with “prima facie evidence of the validity of the registered mark...and of the owner’s exclusive right to use the registered mark in commerce.”\textsuperscript{196}

Open and notorious occupation of property signals to the public and the record owner that the occupier intends to claim the property. Open and notorious use of the mark in commerce puts the public and potential competitors on notice in the same way. In both cases, the occupier is asserting a claim of right – treating the property as her own – the next element under the traditional adverse possession test.

3. Under claim of right.

The adverse possessor must treat the property as her own, and hold the property without the permission of the title holder.\textsuperscript{197} Permitted use is not trespass and cannot lead to an action by the record owner against the occupier for ejectment.\textsuperscript{198} Therefore, to the extent the adverse possession window is merely a statute of limitations on an action for ejectment, the clock will not begin to run on such an action. This is so because the

\textsuperscript{193} See Union Carbide Corp. v. Ever-Ready, Inc., 531 F.2d 366 (2d Cir. 1976).
\textsuperscript{194} See also supra note 29 and accompanying text.
\textsuperscript{196} 15 U.S.C. § 1057(b). See also § 1115(a).
alternate rule would allow a permitted occupant to sandbag the owner and spring an adverse possession claim without notifying the owner of her intentions.

Courts and scholars nevertheless are in disagreement about whether an adverse possessor must also show a particular “intent,” either to innocently (“good faith”) or intentionally (“bad faith”) possess. Under the majority rule in the United States, intent with regard to the title holder is irrelevant. So long as the adverse possessor treats the property as her own, it matters not whether she knows it is not her property or intends to wrest it from the record owner via adverse possession. This standard fits easily with the notice rationale. It is “the visible and adverse possession, with an intent to possess,” one early court decision concluded, “that constitutes its adverse character, and not the remote view or belief of the possessor.”

A minority of courts instead apply a “claim of right” test, seeking to establish the possessor’s subjective state of mind via her objective acts. Knowledge of the original boundary line is not dispositive, but if an encroacher occupies land across the boundary without objective evidence of the intent to assert a claim of right, she is not an adverse possessor. In other words, if you don’t know you are on someone else’s property, it doesn’t matter if you intend to take the property from the title holder, but if you know, there must be objective evidence that you intended to assert a claim to the property.

Under an intentional dispossession rule, only the bad faith adverse possessor should prevail. Here, proof of intent to dispossess operates as an element of the claim. While the intentional dispossession rule has been roundly criticized, it has at least one champion in Lee Anne Fennell, who asserts it is the only efficient ground for an adverse

199 SINGER, supra note 18 § 4.2.5 at 151-52.
200 Id. § 4.2.5 at 153.
201 French v. Pearce, 8 Conn. 439, 444 (1831).
202 SINGER, supra note 18 § 4.2.5 at 154.
203 See e.g., Petsch v. Widger, 335 N.W.2d 254, 260 (Neb. 1983).
204 Also known as the Maine rule. See, e.g., Preble v. Maine Cent. R. Co., 27 A. 149 (Me. 1893).
205 SINGER, supra note 18 § 4.2 at 155.
206 See, e.g., Smith, 569 A.2d at 1191 (“To limit the doctrine of adverse possession to the latter type places a premium on intentional wrongdoing, contrary to fundamental justice and policy.”) (internal quotations omitted).
possession regime.\textsuperscript{207} Richard Helmholz instead concluded, after careful analysis, that whether or not courts are overtly recognizing it, they are favoring good faith adverse possessors.\textsuperscript{208} While Professor Helmholz’s argument is persuasive, it has not changed the formal test invoked by courts or on statutes in the majority of U.S. jurisdictions,\textsuperscript{209} although a handful of jurisdictions have enacted the mistaken possession rule.\textsuperscript{210}

A handful of states also require a shorter period of continuous use from the innocent adverse possessor,\textsuperscript{211} a model championed by Richard Epstein.\textsuperscript{212} Thomas Merrill argues instead that the innocent adverse possessor should acquire a property right, but the bad faith adverse possessor should acquire only a liability right, which would allow her to purchase from the record owner at market value.\textsuperscript{213} Other jurisdictions favor adverse possessors who operate under color of title, holding a faulty but ostensibly authentic title to the property in question.\textsuperscript{214}

The trademark owner signals her claim of right when she polices against infringement. Judge Richard Posner articulated a high standard for trademark owners who desire to retain their marks: “A serious trademark holder is assiduous in endeavoring to convince dictionary editors, magazine and newspaper editors, journalists and columnists, judges, and other

\textsuperscript{207} Fennell, \textit{supra} note 83 at 1039-41. Fennell’s proposal is actually somewhat stronger. It is only the knowing adverse possessor for whom a market mechanism failed that should be able to adversely possess, because that is the only case in which we can be certain that the adverse possessor values the property enough more than the record owner to justify the transfer. \textit{Id.}


\textsuperscript{209} See \textit{supra} note 200 and accompanying text.

\textsuperscript{210} See, \textit{e.g.}, N.M. STAT. § 37-1-22.

\textsuperscript{211} \textit{Compare, e.g.}, LA. CIV. CODE arts. 3473, 3475 (ten-year prescription period for good faith possessor) \textit{with} art. 2486 (30-year period for bad faith possessor). See also \textit{Singer, supra} note 18 § 4.2 at 157 n.71.

\textsuperscript{212} Epstein, \textit{supra} note 87 at 622.

\textsuperscript{213} Merrill, \textit{Adverse Possession, supra} note 86 at 1129.

\textsuperscript{214} See \textit{supra} notes 70-71 and accompanying text.
lexicographically influential persons to avoid using his trademark to denote anything other than the trademarked good or service.\textsuperscript{215}

For the trademark owner, acting like an owner is particularly critical in determining the scope of the mark’s protection, and whether potentially confusing junior use can be enjoined. Settling with a competitor who uses a similar or identical mark to sell similar goods or services can result in weak protection against third parties using the same mark on less similar goods and services. For example, when two competitors divided the rights between SUNKIST for fruits and SUN KIST for vegetables, respectively, the court denied their request to stop the use of SUNKIST as a mark for bread.\textsuperscript{216} More generally, crowding of a particular word or symbol with third party uses narrows the scope of any given mark created using that word or symbol.\textsuperscript{217}

We see a similar standard in the interaction between a trademark owner and her licensee(s). When the trademark owner engages in reasonable quality control measures, based in a contract provision, actual control efforts, or even a sufficiently close relationship between the mark owner and the licensee,\textsuperscript{218} the licensee cannot challenge the mark based on the mark owner’s own demerit during the license period.\textsuperscript{219} On the other hand, failure to control a licensee can weaken the mark sufficiently that the mark owner will be deemed to have abandoned the mark.\textsuperscript{220} The runaway licensee, however, gets nowhere in trademark law, unless the mark owner fails to control the licensee’s use of the mark.\textsuperscript{221} In that context, the

\textsuperscript{215} Ill. High Sch. Ass’n, 99 F.3d at 246.
\textsuperscript{216} California Fruit Growers Exchange v. Sunkist Baking Co., 166 F.3d 971 (7th Cir. 1947).
\textsuperscript{217} 2 MCCARTHY ON TRADEMARKS, supra note 16 at 11.85 (“A mark that is hemmed in on all sides by similar marks on similar goods or services cannot be very ‘distinctive.’”).
\textsuperscript{218} See Land O’Lakes Creameries, Inc. v. Oconomowoc Canning Co., 221 F. Supp. 576, 581 (E.D. Wis. 1963), aff’d 330 F.2d 667, 670 (7th Cir. 1964).
\textsuperscript{219} See Koolvent Metal Awning Corp. v. Bottom, 205 F.2d 209, 212 (8th Cir. 1953) (“A licensee may not appropriate his licensor’s property by adverse possession occurring during the license.”); Smith v. Dental Prod. Co., 140 F.2d 140 (7th Cir. 1944).
\textsuperscript{220} See Barcamura Int’l USA Trust v. Tyfield Importer, Inc., 289 F.3d 589, 596 (9th Cir. 2002);Stanfield v. Osborne Indus., 52 F.3d 867, 871 (10th Cir. 1995).
\textsuperscript{221} For a permissive use to become hostile, at least in some jurisdictions, requires “communicat[ion] to the owner [of] an interest, which is adverse to the owner’s... [A] distinct and positive assertion that would provide notice to the owner of the existence of a hostile claim.” Bd. of Managers of Soho Int’l Arts Condo. v. City of
trademark owner looks like the defending title owner. The licensee, like one who enters real property with permission, should not be able to abuse a position of trust where the trademark owner might be lulled into a false sense of security by underhanded dealing, unless the trademark owner hasn’t done enough to secure herself against underhanded dealing, either contractually or through actual monitoring. Exercising such control is consistent with the notion that the mark owner must operate under claim of right, as if the trademark belongs to her and she wishes it to remain that way.

One difficulty is that the trademark owner does not look like “adverse” or “hostile” possessor, particularly when claiming a word or symbol from the public lexicon to use as the base of a descriptive, suggestive or arbitrary mark, or coining a new grammatical term to use as a source-signifying lexeme. Traditionally, the public is not treated as a collective property owner, and property rights in the commons are frequently discounted. This is in part because the one thing lacking in a typical commons is a right on the part of any user of the commons to exclude any other entrant. This right to exclude is generally treated as the most fundamental property right. On the other hand, to the extent we accept the notion that trademark protection lowers consumer search costs by allowing the owner to preserve the unique signal the mark can send, there is reason to think that it is the public’s buy-in is what prevents a junior user from acquiring a mark confusingly similar to one already established. For example, Judge Posner stated that “[a] trademark owner is not allowed to withdraw from the public domain a name that the public is using to denote someone else’s good or service, leaving that someone and his customers speechless.” Under that construction, a mark can be claimed only when the public has not invested it with generic meaning, which suggests the property has active “property” rights in the potential trademark use of words. I discuss this more in Part III.C, infra.

It is also helpful to reflect on the early debate between property scholars on whether claim of right requires good faith possession, rejects bad faith possession, or ignores subjective intent. All of these scholars point, perhaps unintentionally, toward the same conclusion – in its abstract and


222 See Fagundes, Public Domain, supra note 22 at 700.

223 See College Sav. Bank, 527 U.S. at 673.

224 Ill. High Sch. Ass’n, 99 F.3d at 247.

225 See supra notes 199-214 and accompanying text.
doctrinal sense, adverse possession has not reached a resolution on how to think about bad faith adverse possession, but either intentional or unintentional possession of property belonging to another can be considered possession under claim of right. While the terms “adverse” and “hostile” suggest a head to head battle of sorts between an active user and a neglectful owner, adverse possession requires only that the adverse possessor not be a permitted occupier. The critical element is that to secure title in the property, the occupier must act like an owner. Whether or not the occupation is in good faith or bad faith, the occupation sends a signal which prevents ambush of the record owner and provides notice to the public.

4. Color of title as trademark registration

Courts typically fold color of title into the claim of right analysis, concluding that possessing under color of title evidences good faith occupation. Color of title has thus been received, “even under a void and worthless deed … as evidence that the person in possession claims for himself, and of course, adversely to all the world.” In some jurisdiction, the statutory period of exclusive possession required to secure title by adverse possession is shorter when the possession is under color of title. In other jurisdictions, the adverse possession statute expressly excludes a transfer of property unless the possession is accompanied by color of title.

For the trademark owner, registration resembles color of title. Registration provides, among other benefits, prima facie evidence of trademark use throughout the U.S., but it is actual use in commerce that secures those rights. In some jurisdictions, the existence of an incontestable registration is evidence of at least some level of commercial strength, even if the mark is merely descriptive. While use is required to secure

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226 See also Fennell, supra note 83 at 1083 (“Possessors who hold land under ‘color of title’ represent perhaps the most sympathetic ‘good faith’ claimants imaginable.”).
228 See supra note 70 and accompanying text.
229 See supra note 71 and accompanying text.
230 See supra note 47 and accompanying text.
231 See supra notes 170-171 and accompanying text.
protection, registration provides useful notice to potential competitors. Providing some commensurate benefits is reasonable for the same reason that it is reasonable to favor the adverse possessor who takes under color of title with a shorter statutory window – the faulty title and the registration both provide objective evidence of the scope of the claim to the public, especially potential competitors.

However, a trademark registration does not necessarily act like color of title in every sense. The adverse possessor of real property operating under color of title can lay claim to the entire parcel of property described in the deed although improving only a portion. The trademark owner, however, must provide proof on a regular basis (at least ten year intervals) that it is using the mark on all those goods or for those services identified in the registration. If the mark is no longer used for any of those goods or services, the registration can be cancelled for abandonment. Worse, the mark is likely to be deemed abandoned. Real property possessed via adverse possession does not directly face the challenge of abandonment for non-use, but in any regime where property can be secured via adverse possession, any title holder must defend against subsequent adverse possessors.

5. (Substantially) exclusive use.

In the adverse possession context, exclusive use means, generally, the type of exclusive possession that one expects from a title holder of land of this type. Traditionally, the adverse possessor is conceived as a sole claimant, who through the open, productive occupation of the land may wrest it from its current, inattentive owner. Perhaps unsurprisingly, the adverse possessor may not secure the title while sharing the property with the record owner.

Cir. 1995) (analyzing case law and rejecting the presumption that incontestable marks have acquired commercial strength).

233 See, e.g., Zazù, 979 F.2d at 503-04.
236 15 U.S.C. §§ 1064(3); 1119.
238 Smith, 569 A.2d at 1190. But see Nevells v. Carter, 122 Me. 81, 119 A. 62 (1922) (granting title to adverse possessor who took under color of title from former record owner, and then allowed former record owner to continue to reside on the property).
It is also difficult to prevail in adverse possession against co-tenants.239 Driving the exclusivity requirement is an interest in making sure that the record owner and potential joint owners are clear about the scope of the adverse possessor’s claim,240 as well as allowing the adverse possessor to stand out from other potential claimants and users of the property.241

There is nevertheless some play in the joints. If two adverse possessors occupy different portions of the same parcel of land, both can secure title to the portion occupied, so long as their occupation of the property is not with permission of the record owner.242 In some jurisdictions, where multiple encroachers claim they have adversely possessed a parcel, title is granted to the adverse possessor with the better color of title.243 Importantly, the adverse possessor’s claim is not invalidated by occasional entry by others, even the record owner.244 In addition, the exclusivity requirement can be met even when there are multiple unauthorized possessors, so long as the record owner failed to timely secure its possession against encroachment, and the possessor claiming adverse possession used the property as a reasonable owner would.245 Joint possessors may even adversely possess

\[\text{239 See Grant S. Nelson, William B. Stoebuck & Dale A. Whitman, Contemporary Property 118-19 (3d ed. 2008).} \]
\[\text{240 Peters v. Juneau-Douglas Girl Scout Council, 519 P.2d 826, 830 (Alaska 1974) ("An owner would have no reason to believe that a person was making a claim of ownership inconsistent with his own if that person’s possession was not exclusive, but in participation with the owner or with general public.").} \]
\[\text{241 See Weyerhaeuser Co. v. Brantley, 510 F.3d 1256, 1261-62 (10th Cir. 2007) (rejecting adverse possession defense because defendant “did not use [the property in question] to the exclusion of the record owner and other permissive users.”).} \]
\[\text{242 Id. (citing Macias v. Guymon Indus. Found., 595 P.2d 430, 434 n.8 (Okla. 1979)).} \]
\[\text{243 See Christopher H. Meredith, Note, Imputed Abandonment: A Fresh Perspective on Adverse Possession and a Defense of the Objective Standard, 29 Miss. Coll. L. Rev. 257, 261 (2010).} \]
\[\text{244 See, e.g., Smith v. Hayden, 772 P.2d 47, 52 (Colo. 1989).} \]
\[\text{245 Herbert Hovenkamp & Sheldon F. Kurtz, The Law of Property, An Introductory Survey 66 (5th ed. 2001) (citing Peters v. Juneau-Douglas Girl Scout Council, 519 P.2d 826, 830 (Alaska 1974) (occasional use by clam diggers and picnickers insufficient to destroy adverse possessor’s claim of exclusivity); Nevells, 119 A. at 62 (adverse possessor’s claim of exclusivity was not defeated by former owner’s continued residence on land, where residence was with permission of adverse possessor, and both thought adverse possessor owned the property and could deny permission)).} \]
and secure joint ownership rights against co-tenants in limited circumstances.\textsuperscript{246}

At first glance, this notion of exclusive possession is inconsistent with the homonymous nature of trademark protection.\textsuperscript{247} If trademark law is structured around the assumption that a given word can be put to work by multiple brand owners, we might reasonable question whether the mark owner can ever exercise exclusive ownership. The key is to recognize that it is not the word that is owned, but a “trademark lexeme,” \textit{i.e.}, the particular meaning of the word as used to designate that goods or services come from a single source.\textsuperscript{248}

Exclusivity is required of the trademark owner because failure to engage in substantially exclusive use narrows the scope of the mark.\textsuperscript{249} This dynamic is manifested in the split-market problem recognized by courts in the SUNKIST case.\textsuperscript{250} As crowding occurs, either with the mark owner’s permission or in the absence of the mark owner’s best efforts, the mark cannot \textit{mean} as broadly as it might have otherwise meant. In essence, by disclaiming conflicts with close neighbors, or failing to police existing conflicts, the mark owner disclaims conflicts with distant opponents or new entrants. The ultimate effect of failing to police the mark and prevent unauthorized third party use, \textit{i.e.}, failure to maintain exclusivity, is that the mark will lose its distinctiveness.\textsuperscript{251} In the adverse possession context, the exclusivity requirement allows transfer only when she does not take advantage of her silence to ambush a record owner or joint occupant, and when the public can recognize her as an owner, possessing under claim of right. Therein lays the critical similarity: failing to exclusively occupy property makes it difficult, if not impossible for the record owner or the public to detect the occupation. Failing to exclusive occupy a trademark lexeme makes it impossible for the mark to convey a singular source for goods and services to consumers. Likewise, for a crowded word, it is

\textsuperscript{246} For example, a claim can be settled against a co-tenant if the adverse possessor effectively ousts or dispossess co-tenants, provides express notice of such an intent to co-tenants, or retains exclusive possession after a demand by co-tenants. \textit{See e.g.}, Wright v. Wright, 512 S.E. at 618.
\textsuperscript{247} \textit{See supra} notes 29-31 and accompanying text.
\textsuperscript{248} \textit{See supra} notes 74-76 and accompanying text.
\textsuperscript{249} \textit{See supra} note 217 and accompanying text.
\textsuperscript{250} \textit{See supra} note 216 and accompanying text.
\textsuperscript{251} 3 \textsc{Callman on Unfair Competition, Trademark and Monopolies} \S\ 20:72 (4th ed., updated Dec. 2011) (“It has been repeatedly held that if there are several users of the mark, inevitably the mark will lose its distinctiveness.”).
difficult for the mark owner to signal information about the goods on which the mark is used, because of the use by others. Any rights secured would thus be narrow.

Exclusivity in the trademark context, like exclusivity of possession of real property, need not be absolute.252 When tasked with deciding whether a descriptive mark has acquired sufficient distinctiveness to qualify for registration, the PTO can accept “proof of substantially exclusive and continuous use” of the mark for five years as prima facie evidence of distinctiveness.253 The “substantially exclusive” standard allows the PTO to discount “inconsequential or infringing” use by others.254 In the registration context, at least, the existence of some infringing activity does not necessarily invalidate a claim of exclusive and continuous use, perhaps because it is only use that is tolerated for a significant amount of time or gives rise to a laches defense that should prevent the trademark owner from claiming exclusivity.255 The fact that other use occurs matters less than whether the adverse possessor takes timely action against that other use.

6. Continuous for the statutory period.

The adverse possessor must be in continuous possession for the statutory period, but “continuous” here is a term of art. Continuous adverse possession need not be literally continuous, but must be effectively continuous. For example, continuous can mean seasonal use, if that is reasonable for the location.256 Use by a seller who conveys to rights to a buyer under color of title can tack for the benefit of the buyer, in meeting the statutorily required period of exclusive possession.257

As noted earlier, in some jurisdictions, adverse possessors who occupy in good faith or under color of title face shorter statutory windows.258 More generally, the amount of time required to secure title varies from

252 See supra note 244 and accompanying text.
254 See, e.g., L.D. Kichler Co. v. Davoil, Inc., 192 F.3d 1349, 1352 (Fed. Cir. 1999) (citing Trademark Manual of Examination Procedure § 1212.05(b)) (8th ed. 2011) [hereinafter TMEP] (“This makes allowance for use … which therefore does not necessarily invalidate the applicant’s claim.”).
255 See supra Part III.B.1.
256 See, e.g., Howard, 477 P.2d at 213-14 (summer home).
258 See supra notes 69-70 and accompanying text.
jurisdiction to jurisdiction. While the differences between state statutory windows may appear arbitrary, at least one study by Jeffry Netter and his co-authors suggests that states likely made a rational tradeoff in deciding between longer and shorter statutory windows. A shorter statutory period increases certainty as to the validity of title of the current possessor for buyers in subsequent transfers, while a longer statutory period reduces the cost of protecting property from potential adverse possession.

Like adverse possession, the trademark regime appears to favor those marks in that are more likely to provide good notice to the public and competitors, and to require extra evidence for those marks that are less likely to be easily distinguishable. However, unlike adverse possession statutes, trademark law provides few clear temporal guidelines, of either a statutory or common law origin.

Acquiring rights in a descriptive mark most closely resembles adverse possession. A descriptive mark is not protected upon its first use in commerce. Instead, the mark must acquire distinctiveness or secondary meaning, i.e., consumers must come to recognize that the mark signifies a consistent, anonymous source for the goods or services. Likewise, the Lanham Act bars the registration of descriptive marks until they have acquired distinctiveness, or secondary meaning. Courts typically consider length of use in determining whether secondary meaning has been acquired, but there are no clear time frames to establish how long a mark must be used in commerce before it acquires secondary meaning. Courts have repeatedly opined that there is no per se minimum amount of time

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259 See supra note 65 and accompanying text.
260 Netter et al., supra note 92 at 217.
263 See, e.g., Union Carbide, 531 F.2d at 366.
264 See 2 McCarthy, supra note 16 at § 15:54. Likewise, there is no firm rule about how long a mark must be used in commerce before it becomes famous and qualifies for protection against dilution by tarnishment or blurring, even in the absence of an indication of likely confusion.
required to establish secondary meaning, and no maximum beyond which secondary meaning will automatically accrue.

The PTO has the option of treating five years of substantially exclusive and continuous use of a descriptive mark as *prima facie* evidence of secondary meaning, and granting a registration based on such an affidavit. This also resembles an adverse possession regime. While the PTO can treat every descriptive mark as registrable after five years of exclusive use, different types of trademarks actually receive different treatment. For example, five years use is generally enough for a mark based on a surname to acquire secondary meaning, but for trade dress that “does not inherently function as a mark because of its nature”, the statement of five year’s use alone is insufficient to establish secondary meaning. This is consistent with the notice account which underlying the acquisition of trademark protection. The PTO demonstrates an inclination to ensure a longer period of use for those marks that should require more time to establish secondary meaning. After the first five years of registration, and every ten years, the owner of a registered mark must file an affidavit of continuing use in order to maintain a trademark registration.

Any registration, including one for a descriptive mark that has acquired distinctiveness, can become “incontestable” after five consecutive years of continuous use, so long as the mark is still in use, and so long as the registration or the right in the mark have not been challenged. The five year window to acquire an incontestable registration thus also resembles an adverse possession regime, with elements of notice (via the registration system itself) and at least an inferred requirement that the mark is used

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265 *See, e.g.*, L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 1130 (Fed. Cir. 1993) (rejecting the argument that five months was insufficient time to acquire secondary meaning).

266 *ERBE Elektromedizin GmbH v. Canady Technology LLC*, 629 F.3d 1278 (Fed. Cir. 2010) (affirming summary judgment that trade dress was not protectable despite 30 years of use of color blue on medical instruments).


268 *TMEP* § 1202.05(a).

269 *Id.*


272 *See* 1-4 Gilson, *supra* note 26 § 4.03.

under claim of right and exclusively, in addition to the requirement of continuous use.274

The protection for inherently distinctive marks seems, in comparison, to bear little resemblance to adverse possession. Unlike a descriptive mark, an inherently distinctive mark is treated as source signifying on its first use in commerce, so long as that first use is followed by “continuous commercial utilization.”275 With that first use comes priority against other users of the same or similar marks for the same or similar services.276 There is also no requirement to show any particular duration of use in commerce before registering an inherently distinctive mark, so long as the mark has been used in commerce.277 Thus, for inherently distinctive marks, it appears that protection is automatic, and adverse possession might be a poor analogy.

Note, however, that the strength of a mark is a matter both of inherent strength (or lack thereof) and commercial strength, or acquired strength in the marketplace. Courts frequently reference the inherent strength hierarchy laid out in Abercrombie to guide determinations of whether trademark rights can be acquired, and what it takes to acquire the mark.278 Barton Beebe’s comprehensive study of likelihood of confusion cases in the federal district courts over a five year period indicates that there is also a correlation between the inherent strength of the mark and the final outcome in a likelihood of confusion contest,279 even though the district courts were both inconsistent and imprecise in their application of the Abercrombie factors.280 More interestingly, where the assessment of the mark’s inherent strength is at odds with the mark’s acquired strength, the finding of acquired strength trumps inherent strength.281 Beebe identified 27 cases

274 See supra note 11.
275 Blue Bell, Inc. v. Farah Mfg. Co., 508 F.2d 1260, 1265 (5th Cir. 1975) (“even a single use in trade may sustain trademark rights if followed by continuous commercial utilization.”).
276 Id.
278 See supra notes 35-43 and accompanying text.
279 Beebe, Multifactor Tests, supra note 15 at 1637 (“[T]he plaintiff multifactor test win rate steadily declined with the inherent strength of its mark: fanciful marks enjoyed the highest win rate, followed by arbitrary marks, suggestive marks, descriptive marks, and then generic marks.”).
280 Id. at 1635.
281 Id. at 1636. A follow up study confirmed this finding over fifteen years of cases from the Second Circuit. Kevin Blum et al., Consistency of Confusion? A Fifteen-Year Revisiting of Barton Beebe’s Empirical Analysis of Multifactor Tests for
where the inherently strong mark had not established commercial strength. In 24 of those cases (89%), the mark owner failed to establish that the allegedly infringing use would likely confuse consumers.\textsuperscript{282}

The tale typically told in the trademark analysis is that the descriptive mark may pull itself up by its bootstraps and acquire distinctiveness, but those fanciful, arbitrary and suggestive marks that are inherently distinctive are strong,\textsuperscript{283} and protectable perpetually and without question from first use.\textsuperscript{284} Beebe’s study calls that story into question. He suggests that district courts recognized that “acquired or ‘actual strength’ in the marketplace logically incorporates the effects of the mark’s inherent strength.”\textsuperscript{285}

Instead, I think the courts are recognizing that it is successful use in commerce, \textit{rather than} inherent strength, that provides the strongest indicator of trademark ownership. While many of the likelihood of confusion factors key into the conflict between the parties (similarity of marks and goods, proximity of services, likelihood that the plaintiff will bridge the gap) and the perception of consumers (evidence of actual confusion), strength of the mark is really about the extent to which the trademark owner has reduced the trademark to possession and the extent to which she is using the mark in commerce.

It is probably correct to say that marks starting from a position of inherent strength are more readily able to acquire strength in the market, perhaps because consumers more easily recognize inherently distinctive marks as source signifying.\textsuperscript{286} But the district courts analyzed in Beebe’s study seem

\begin{footnotesize}
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\item Beebe, \textit{Multifactor Tests, supra} note 15 at 1636.
\item Nutri/System, Inc. v. Con-\textsuperscript{Stan Industries, Inc., 809 F.2d 601, 605 (9th Cir. 1987) (“Arbitrary or fanciful marks (i.e., Kodak) are called ‘strong’ marks, whereas descriptive or suggestive marks are ‘weak.’ ”).}
\item \textit{Blue Bell}, 508 F.2d 1265. \textit{But see 2 McCarthy \textit{supra} note 16 at \S 11:83 (considering only inherent or conceptual strength is “incomplete”).}
\item \textit{Id.}
\item A detailed review of Beebe’s data set indicates that in 54 cases where the court concluded the mark was at least suggestive and also considered commercial strength, the court concluded that the mark was commercially strong in 34 cases (63%). Out of 36 cases where the mark was at least arbitrary and the court also considered commercial strength, the mark was commercially strong in 30 cases (83%). Of the six cases where the mark was clearly fanciful and commercial strength determined, the court concluded the mark was commercially strong 5
\end{enumerate}
\end{footnotesize}
to distinguish inherent strength from acquired commercial strength, to the
detriment of the mark owner when commercial strength is never acquired.
For example, in *We Media, Inc. v. General Electric Co.*, plaintiff’s marks
WE and WEMEDIA for magazines and newsletters promoting the disabled
community were found suggestive. The court presumed the suggestive
marks were strong, but that strength “must be reduced to reflect third-party
usage and [plaintiff]’s] own lack of usage.” Likewise, in *M2 Software,
Inc. v. M2 Communs., L.L.C.*, the court was clear that the M2 mark for
CDs and CD-ROMs was conceptually strong, but the inherent strength of
the mark was unrelated to its failure in the marketplace.

Trademark rights for descriptive marks are developed in a reverse of this
story. The initially weak descriptive mark acquires strength in the
marketplace, and thus becomes protectable and registrable. For example, in
*GTFM, Inc. v. Solid Clothing, Inc.*, plaintiff’s mark “05” for sportswear
was weak, and entitled to a narrow scope of protection because the
sportswear field was crowded with marks including the number 5. Nevertheless, the court concluded that the mark “achieved distinctiveness”
through its “explosion in sales” which attracted “a number of imitators,
including the defendant.” For every case like GTFM, there is another
where courts do a significant amount of hand waving at the border between
suggestive and descriptive marks, and turn to sales success and marketing
expenditures over time – or registration – as evidence of acquired
distinctiveness, eliding the arguably preliminary step of determining
whether such a showing is necessary. The end result is the same:
successful commercial use will develop secondary meaning for all but the
*ex ante* generic mark, and a conclusion that the mark is commercially

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287 *218 F. Supp. 2d 463 (S.D.N.Y. 2002).*
288 *Id. at 472.*
289 *Id. at 477.*
290 *281 F. Supp. 2d 1166 (C.D. Cal. 2003).*
291 *Id. at 1171.*
292 *215 F. Supp. 2d 273 (S.D.N.Y. 2002).*
293 *Id. at 295.*
294 *Id.*
weak, even if inherently strong, is virtually fatal to a claim of trademark infringement.296

Here, the subtle difference between trademark acquisition and adverse possession provides us with a rationale to understand this account. When an encroacher seeks to adverse possession, indications of notice like fencing or possessing under color of title will broaden actual possession. Thus, use of any portion of a parcel to constructive possession of the entire parcel.297 Without actual possession, holding a flawed document that provides the color of title itself cannot convey title to the property. In the trademark context, registration provides constructive use, but that constructive use does not overcome the requirement to continue using the mark. There remains both an affirmative duty to provide affidavits of continuing use and the risk that failure to use the mark in commerce will abandon the mark to the public domain. We might therefore analogize inherent strength to such plus factors in the adverse possession context. Inherent strength suggests that consumers will quickly, if not automatically, recognize the mark as source signifying, but the scope of the protection granted depends in fact on the mark’s commercial strength. Even though the time required to acquire commercial strength is not clearly delineated, length of use is a factor always considered, and in some cases, dispositive. For example, in *Marilyn Miglin Model Makeup, Inc. v. Jovan, Inc.*,298 the court concluded the paucity in length of use – less than four years – was brief enough that yearly sales of over $3 million and an advertising budget averaging more than $500,000 per year was not enough to establish secondary meaning.299

While both the adverse possession and the trademark owner must engage in continuous use to secure their respective rights, the analogy is complicated by the fact that the trademark owner never acquires title in fee simple, unlike the adverse possessor. It is true that the adverse possessor acquires a title in fee simple, but in any adverse possession regime, her title is only as good as her ability to prevent subsequent encroachment. Thus, in the real property context, any title in fee simple is subject to expiration, if the owner becomes inattentive, which is different from trademark right in degree, not in kind. And like title to real property in fee simple, the trademark owner who uses can control the mark perpetually, a key

296 According to Beebe’s data, in 74 cases where the court found the mark commercially weak, the plaintiff prevailed only 4 times (5%).
297 See *supra* notes 167-168, 185 and accompanying text.
299 *Id.* at 180-81.
difference between the trademark regime and the protection for limited times afforded to copyrights and trademarks.\textsuperscript{300}

7. Trademark acquisition as adverse possession

While trademark use keys on actual, open and notorious use of the mark in commerce,\textsuperscript{301} and registration acts much like color of title,\textsuperscript{302} the connection is somewhat more tenuous with regards to possession under claim of right and exclusivity. The previous discussion provides an answer for each. The connection between adverse possession and trademark acquisition becomes clear once we recognize that the mark owner must signal an ownership interest, not merely manifest hostility (or the lack thereof).\textsuperscript{303} Exclusivity is closely related, and requires an understanding the nature of the property right secured: not a right in language full stop, but an exclusive right to use a particular word to designate particular goods from a particular source.\textsuperscript{304} The trademark owner secures trademark protection commensurate with her effort to provide the purchasing public and competitors with notice of the claimed rights.

Continuous use presents a different problem.\textsuperscript{305} Like adverse possession, trademark use must be continuous, or the mark will be abandoned. Outside of the safe harbors identified, however, there is little clarity regarding how long it will take the mark owner to obtain secondary meaning, commercial strength, or fame in the market. This is different than the adverse possession regime, where each state selects its own statutory requirement for length of possession before the adverse possessor acquires title, but every state sets a clear window. As I discuss in Part IV, however, the uncertainty in the required duration of trademark ownership may be a feature, particularly with regard to descriptive marks, that helps solidify the lesson that a property right like adverse possession or trademark ownership, secured through productive use over time, can be transferred precisely because the regime sends signals through productive use about how the adverse possessor or trademark owner values the property or trademark lexeme.

\textsuperscript{301} See supra Parts II.C.1-II.C.2.
\textsuperscript{302} See supra Part II.C.4.
\textsuperscript{303} See supra Part II.C.3.
\textsuperscript{304} See supra Part II.C.5.
\textsuperscript{305} See supra Part II.C.6.
Part III addresses some alternate viewpoints. If the trademark owner is not an adverse possessor, perhaps she more resembles the holder of a prescriptive easement. The Article explores and refutes that idea in Part III.A. In Part III.B, the Article examines whether the junior user might possess a better analogical fit with the adverse possessor, but concludes the junior user in fact frequently benefits in circumstances where there is no claim to the mark owner’s trademark lexeme. Finally, in Part III.C, the Article addresses the possessory rights of the public, from whom the trademark owner must take possession as an adverse possessor, and whether the public itself might act as an adverse possessor, claiming a property-like interest in trademark lexemes.

III. OTHER RIGHTS AND OTHER RIGHTSHOLDERS

A. Trademark Rights as Prescriptive Easement

As the adverse possession analogy is imperfect, perhaps acquiring an easement by prescription is the better analogy for acquiring trademark rights. Instead of the trademark owner exclusively occupying a particular trademark lexeme as property, we might instead envision the trademark owner being one of several occupants of a particular word or symbol, with the word or symbol itself operating as the base unit of property.

A prescriptive easement is not an exclusive right to use the property in question, but is instead the right to use a particular (portion of a) parcel of real property for a particular purpose. The process for securing a prescriptive easement is similar to the process of securing title through adverse possession. For a prescriptive easement to vest, the easement holder must use the property in an open and notorious fashion without permission, continuously through the statutory period. Many jurisdictions do not require exclusivity. For those that do, the exclusivity is typically not exclusivity of possession against all comers, but exclusivity of the type of use on the property, so that the use is sufficient to provide the owner notice of a potential claim. In those jurisdictions, he putative easement holder must use the property for a different purpose than others on the property – i.e., an exclusive use.

306 7 THOMPSON ON REAL PROPERTY, supra note 1, § 60.03(b)(6)(i).
307 Id. at § 60.03(b)(6)(vi).
308 See, e.g., Neyland v. Hunter, 668 S.W.2d 530, 531 (Ark. 1984) (“Unlike adverse possession, prescriptive use need not be exclusive.”).
309 Weyerhaeuser, 510 F.3d at 1266.
A prescriptive easement “allows multiple individuals to make simultaneous claims to the same use of a property.”\textsuperscript{310} Were we to view the property to be secured as the word or symbol, rather than the trademark lexeme, the right acquired by the trademark owner would resemble a prescriptive easement. Each trademark owner would secure a prescriptive easement in the word or symbol. Instead of viewing DELTA for air transportation and DELTA for faucets as neighboring parcels of lexical property, we could treat them as separate prescriptive easements in the word “Delta”, rights to use the “property” – the word or symbol – to designate different sources for different goods and services.

The difficulty, of course, is that a prescriptive easement gives the holder of the easement no right to exclude others from the property.\textsuperscript{311} However we might define the property right granted the trademark owner, it is a right to exclude.\textsuperscript{312}

We might nevertheless envision potential encroachments by junior users or the public as attempts to secure prescriptive easements in the mark owner’s trademark lexeme. Some jurisdictions have expressly embraced the notion that the public can collectively acquire a prescriptive easement on private land.\textsuperscript{313} To the extent that neither the public nor the junior user need articulate exclusive use of a mark in order to respectively add new meaning(s) to a trademark lexeme or to avoid liability for trademark infringement, the prescriptive easement model to define public uses of marks might serve as a helpful analogy for their interaction with the mark.

In Part III.B, I consider to what extent the junior user resembles an adverse possessor, and then how the junior user’s defensive posture is often best served by disclaiming entry into or use of the mark owner’s lexical space. In Part III.C, I discuss how public use affects trademark ownership, as well

\textsuperscript{311} State v. Wilson, 42 Me. 9 (Me. 1856).
\textsuperscript{312} In re Deister Concentrator Co., 289 F.2d 496, 501 n.5 (C.C.P.A. 1961) (“If the law will not protect one’s claim of right to exclude others from using an alleged trademark, then he does not own a ‘trademark,’ for that which all are free to use cannot be a trademark.”).
\textsuperscript{313} T THOMPSON, supra note 306 at § 60.03(b)(6)(v) (\textit{citing, inter alia}, Stickney v. City of Saco, 770 A.2d 592, 601 (Me. 2001) (stating that the requirements for the creation of a public way “by prescriptive use parallel those for the creation of a prescriptive easement.”).
as how the adverse possession view of trademark acquisition supports the recognition of property rights in the public domain.

B. Junior User as Adverse Possessor

Courts have reasonably analogized instances of gross laches to adverse possession on demerit grounds. Likewise, the mark owner consistently prevails against the bad faith junior user in likelihood of confusion cases, but infrequently when the mark is adopted in good faith, or the junior user’s intent is not examined or irrelevant. In those cases where the defendant’s use is excused because of the plaintiff’s delay or where the junior user’s putative infringement is held not to infringe, the junior user does not strip the senior user of all trademark rights – although, discussed below, the senior user’s mark will be effectively narrowed through the loss. The right of the junior user to occupy the lexical space without the senior user’s permission thus resembles one who acquires an easement via prescription.

1. “Gross laches” as adverse possession grounded in demerit.

Laches, like adverse possession, settles claims and prevents ambush where the claimant might have lulled the defendant into a false sense of security about the ability to invest in the property. The junior user who relies to its detriment on the inaction of the mark owner can bring a successful laches defense where the mark owner knows the defendant is using its mark but delay taking action for an “inexcusable” period of time. Here, it seems appropriate to interpret “relies to its detriment” as “engages in use in commerce over time,” exactly what the junior user would need to do to secure trademark protection if there were no senior user. Thus it is said that laches in trademark law is “derived from the maxim that those who sleep on their rights, lose them.” This invocation of the laches defense turns on a demerit rationale, based either on the plaintiff’s inattentiveness or her

314 Anheuser-Busch, 175 F.2d at 374.

315 According to Barton Beebe’s dataset, the plaintiff establishes likelihood of confusion only 21% of those cases where the defendant’s adoption was in good faith or intent was not analyzed or factored into the decision. Beebe reports that the defendant lost in every case where the marks were similar and the court concluded the adoption was in bad faith. Beebe, Multifactor Tests, supra note 15 at 1628–29.

316 See supra Part III.A.

317 HILLIARD, DESKBOOK, supra note 43 § 7.01[4][a] at 225.

318 Chattanooga Mfg. Inc. v. Nike, Inc., 301 F.3d 789 (7th Cir. 2002).
inferior position to the defendant as to equity. Courts have thus reasonably
turned to adverse possession to explain why the plaintiff will not be
allowed to prevent the defendant’s further use of the mark.319

There are, however, differences between adverse possession of real
property, which secures title to the adverse possessor in fee simple (or even
the prescriptive easement, which bars subsequent ejectment), and laches in
the trademark context. While a successful laches defense typically prevents
the mark owner from recovering damages stemming from prior
infringement, it does not generally bar subsequent injunctive relief.320 On
the other hand, laches that amounts to “gross laches” will bar even
injunctive relief. 321

The adverse possession analogy is sharpened by recognizing that the
trademark owner can successfully rebut a laches defense if the defendant’s
use was not sufficient to put the plaintiff on notice, i.e., was not sufficient to
otherwise create a significant likelihood of confusion.322

In addition, laches cannot be raised as an equitable defense by one who acts
in bad faith. In the trademark context, bad faith requires a showing that the

319 See Anheuser-Busch, 175 F.2d at 374.
321 Compare Herman Miller, Inc. v. Palazzetti Imports & Exports, Inc., 270 F.3d
298 (6th Cir. 2001) (granting injunctive relief in trademark infringement suit but
denying pre-filing damages on laches grounds) with Prudential Ins. Co. v. Gibraltar
Fin. Corp., 694 F.2d 1150, 1152 (9th Cir. 1982) (28-year delay amounted to gross
laches and barred injunctive relief). The Third Circuit refers to “mere laches”
which only prevents an accounting of past gains, as delay, and “gross laches,”
which also prevents injunctive relief against the delaying mark owner, as laches.
Champion Prods., 686 F.2d at 1044-45.
322 See e.g., ProFitness Physical Therapy Ctr. v. Pro Fit Orthopedic & Sport
Physical Therapy, 314 F.3d 62, 68 (2d Cir. 2002) (plaintiff has no obligation to sue
“until the likelihood of confusion looms large”). See also Joint Stock Society v.
Society, the court asserted an adverse possession rationale for allowing an infringer
to eventually secure goodwill in a mark “by openly, notoriously, hostilely, and
continuously using a particular mark in commerce for an extraordinarily lengthy
period of time.” Id. at 721. This description of acquisition of trademark rights is
identical to the effort that any trademark owner must exert to establish rights in a
given mark, i.e., rights sufficient to put competitors and the public on notice.
junior user “inten[ded] to promote confusion or exploit [the senior user’s] good will or reputation.”

2. Bad faith adverse possession and bad faith trademark infringement.

The junior user’s intent is a factor in the likelihood of confusion test from every circuit, and that factor is given great weight. Generally, courts will infer an intent to confuse consumers from the bad faith or intentional copying of a trademark already in use in commerce. As reported by Barton Beebe from a study of preliminary injunction hearings and bench trials before the federal district courts over a five year period, in those cases where the court found that the junior user adopted a mark similar to that employed by the senior user in “bad faith,” the senior user won every time. This tendency is consistent with Richard Helmholz’s finding that courts favor adverse possessors who innocently possess (in “good faith”), and disfavor the claims of “bad faith” or knowing encroachers. Beebe’s study also indicates that the senior user prevailed in less than one quarter of the analyzed cases where the court concluded that the intent factor disfavored a finding of a likelihood of confusion.

There are two key differences for junior trademark users. As discussed in more detail in Part III.B.4 below, the junior user can effectively prevail on non-encroachment grounds. Thus, unlike successful good faith adverse possession, which leaves the encroacher holding title in fee simple to the possessed property, good faith trademark use does not result in a full appropriation of the senior user’s mark. A successful assertion of good faith adoption correlates with a finding that the subsequent use did not infringe. To the extent that the junior user’s mark is similar, or she is

323 Star Indus., Inc. v. Bacardi & Co., 412 F.3d 373, 388 (2d Cir. 2005).
325 Id. at 1610.
326 See e.g., My-T-Fine Corporation v. Samuels, 69 F.2d 76 (1934) (“[A] late comer who deliberately copies the dress of his competitors already in the field, must at least prove that his effort has been futile.”).
327 Beebe, Multifactor Tests, supra note 15 at 1610 (2006). There is a similar correlation where the court determines that the intent of the junior user does not favor bad faith. Id. at 1609, 1613. However, a finding of bad faith intent was not “necessary to trigger an overall finding of a likelihood of confusion.” Id. at 1610.
328 Helmholz, Adverse Possession, supra note 208 at 331-32.
330 See e.g., Med. Econ. Co. v. Prescribing Reference, Inc., 294 F. Supp. 2d 456, 465 (S.D.N.Y. 2003) (finding that plaintiff failed to show that defendant’s use was
selling similar goods, this effects a narrowing of the senior user’s rights in the senior user’s mark through crowding.\footnote{See supra note 217 and accompanying text.}

In addition, there is a critical difference in the posture of the bad faith trademark adopter and the bad faith property encroacher. The bad faith trademark adopter intends to take advantage of the goodwill accrued through the senior user’s productive use.\footnote{See, e.g., Kemp v. Bumble Bee Seafoods, Inc., 398 F.3d 1049, 1053 (2005) (concluding that the bad faith infringer “made clear his intention to take advantage of the good will and brand equity … built” by the senior users).} The bad faith possessor of real property intends to claim property owned by another, but as traditionally understood, this is property that the title holder is not putting to use, or at least not use that is as productive as the use engaged in by the encroachers.\footnote{See supra Part II.A.2.}

While the junior user bears some resemblance to an adverse possessor in the successful presentation of a laches defense, and in the way bad faith is taken into account, the analogy between junior user and adverse possessor of real property is a poor fit in other crucial ways.

3. Loss of the mark to the public domain.

Adverse possession can be the basis of a claim to quiet title, or a defense against an action for trespass or ejectment. If the adverse possessor prevails, from either an offensive or defensive posture, title in the property is take from the record owner and given to the adverse possessor. The real property does not first reenter the commons to be subsequently claimed.

If the trademark owner loses control of the mark, through \textit{ex post} genericness, abandonment, or some other failure to maintain essentially exclusive use of the mark in the public, the junior user does not obtain a property right in that mark, even though the junior user is most likely the party bringing the senior user’s failings to the attention of the court. Instead, the mark goes into the public domain, where one or multiple junior users can attempt to appropriate it for their own purposes, the same way that the senior user did.\footnote{likely to cause confusion and is thus, an infringement of PRI’s trademark” where plaintiff did not show, \textit{inter alia}, that defendant adopted its mark and selected product features in bad faith).} Adverse possession, on the other hand, “vests the
possessor with the complete title as effectively as if there had been a conveyance by the former owner."335

4. The non-possession defense.

One of the implications of the theory that trademark owners create trademark lexemes through their use of words or symbols to designate the source of goods and services (lexeme or symbol + source signification) is that infringement only occurs when the junior user trespasses the lexical property. Courts articulate that trespass through the likelihood of confusion factors to determine whether the alleged infringer has adopted a mark identical or similar to a mark that is already being used in commerce for the same or similar goods. As a result, a conclusion that there is no likelihood of confusion means, in effect, that the “junior” user is actually occupying a different lexical space than the plaintiff, and not encroaching on the plaintiff’s property at all.336 That is different from the laches defense, where the defendant escapes liability even though she has encroached the plaintiff’s lexical property because the plaintiff delayed too long, and the defendant’s valuable use swamps the plaintiff’s otherwise valid complaint.337

Nevertheless, in a case where the senior user clearly predates junior user, the junior user will prevail if the senior user fails to establish that the marks are confusingly similar. Several of the factors courts consider in analyzing likelihood of confusion turn on whether or not the junior user has actually entered the lexical space of the senior user. The court may conclude that the marks are not confusing because the word or symbol used as the basis for

334 See, e.g., Grocery Outlet Inc. v. Albertsons, Inc., 2008 U.S. Dist. LEXIS 101999 (N.D. Cal. 2008). (“When a mark is abandoned, it returns to the public domain and thus, a party who successfully shows that a trademark owner has abandoned a mark is free to use the mark without liability”); 3 MCCARTHY supra note 16 at § 17:1 (an abandoned mark “falls into the public domain and is free for all to use … paving the way for future possession and property in any other person.”).
335 Ballantine, supra note 81 at 142.
336 The Federal Circuit has suggested, with regard to trademark proceedings, that “nothing else matters if the parties’ marks are not similar.” John M. Murphy, Playing the Numbers: A Quantitative Look at Section 2(d) Cases Before the Trademark Trial and Appeal Board, 94 TRADEMARK REP. 800, 803 (2004), citing Kellogg Co. v. Pack’Em Enters., Inc., 951 F.2d 330, 333 (Fed. Cir. 1991).
337 See supra Part III.B.1.
the mark are not sufficiently similar or have different meanings, because the goods and/or services are sufficiently different, or because the senior user has not established the strength of its mark. In essence, the junior user wins by establishing that she made no entry into the trademark owner’s lexeme, and that her use did not transgress the lexical boundaries of the trademark. In terms of the rationales driving adverse possession, there is no need to consider whether the mark owner demerits or the junior user merits, because their respective rights are seen not to overlap.

5. Third-party use can narrow the senior user’s mark.

The junior user’s success in defending a claim of trademark infringement can also turn on whether the particular lexical space at issue is crowded. The junior user need not engage in exclusive use of a lexeme to prevail in an infringement suit or to oppose a trademark registration. To the extent a junior user can establish that he is merely the newest entrant in a crowded field, he can successfully establish that confusion is unlikely. Professor McCarthy suggests this is because, “[i]n such a crowd, customers will not likely be confused between any two of the crowd and may have learned to carefully pick out one from another.” Returning to the real property analogy, the argument here is that the parcels of lexical property are smaller than the mark owner might otherwise have thought she captured, either because she entered a previously crowded space, or because she allowed the crowding to occur. Thus, the junior user need not establish its own

338 In Professor Beebe’s study of district court preliminary injunction rulings and bench trials where the court considered the likelihood of confusion factors, establishing that the marks were similar was a threshold matter for the mark owner to establish that confusion was likely. Beebe, Multifactor Tests, supra note 15 at 1623-26.
339 In Beebe’s study, senior users established confusion in over 80% of cases where the court found that the goods or services were identical, and just over 2% of cases where the court found the goods and services were unrelated. Id. at 1632-33.
340 Beebe’s study showed that for cases where the senior user’s mark lacked commercial significance, even where the mark was inherently strong, likelihood of confusion was rarely established. Id. at 1636.
341 Hilliard, CASEBOOK, supra note 235 § 3.06[1] at 124 (“[I]t is not necessary that the opposer show exclusive use or exclusive right to use a word or term.”).
342 Beebe’s study indicated that in over half the cases that the court considered third party use of the same or similar marks, that use mitigated the strength of the plaintiff’s mark, and in 85% of those cases, the court found no likelihood of confusion. Beebe, Multifactor Tests, supra note 15 at 1636-37 n.226.
343 See McCarthy, supra note 16 at § 11:85.
344 See supra note 216 and accompanying text.
exclusive use to successfully defend against an action for trademark infringement. It merely need show that third party crowding makes confusion unlikely.

To summarize, any time the junior user prevails against the claim of infringement, the junior user more resembles the holder of a prescriptive easement, in that a trademark owner cannot evict her from the trademark lexeme, but may still retain property rights in the trademark lexeme and be able to seek remedies against other infringing uses. For the junior user, winning the infringement suit also won’t win the subsequent priority fight with other competitors down the line. At that point, the junior user still needs to establish its trademark use by effectively possessing the property.345

The mark owner also takes a defensive posture against the public to the extent that ex post or acquired genericness can strip trademark protection from an otherwise protected mark. This might indicate that the public exercises something akin to a property right in pulling a word back into the public domain. But there is another question that must be answered about the public, and which we take up in the next Part: if there are no property rights in the public domain, from who does the trademark owner adversely possess the mark?

C. Property in the Public Domain

Whether the mark owner is coining a mark from extant morphemes or phonemes,346 or pressing an existing symbol into service as a trademark, she is “claiming” something from the public domain and converting it to her own use. This complicates my account. Historically, courts have not

345 See California Cedar Products v. Pine Mountain Corp., 724 F.2d 827 (9th Cir. 1984) (user who adopts after abandoning owner’s official date of abandonment prevails over prior user who used the mark in “bad faith” prior to the abandonment). Cf. Stacey L. Dogan & Mark Lemley, Grounding Trademark Law Through Trademark Use, 92 IOWA L. REV. 1669, 1690 (2007) (concurring with Dinwoodie and Janis 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.”).

346 Morpheme and phoneme are fancy terms for the smallest analytical part of a written or spoken word. See “morpheme, n.”, OED ONLINE, Dec. 2011 (“A grammatical element, like a prefix, usually thought of as indivisible or incapable of being analyzed into smaller units.”) (2d ed. 1989; online version Dec. 2011); “phoneme, n.”, id. (“A unit of sound in a language that cannot be analysed into smaller linear units and that can distinguish one word from another.”).
thought of the public as having property rights in common. But this apparent difficulty highlights an important reality: there are property rights in the public lexicon, both in the sense of lexemes reserved for the public and lexemes that the public actively reclaims from trademark use.

1. Property rights in the public lexicon.

It seems an oversimplification to suggest that there is no such thing as public property. For example, the Supreme Court held that the navigable waters of Lake Michigan cannot be reduced to private ownership, and that private parties cannot obstruct or interfere with the rights of the public to “enjoy the navigation of the waters, carry on commerce over them, and have liberty of fishing therein”. The waters are held in “public trust.”

Richard Epstein instead argues this public trust doctrine should bar, on a constitutional reverse takings ground, legislation from extending copyright protection to existing copyrights, because doing so would take that intellectual property from the public trust. It is an argument that has not swayed the Supreme Court. When Congress made just such an extension, the Supreme Court deemed it constitutional. More recently, the Court in Golan v. Holder concluded that Congress has the power to pull from the public domain formerly copyrighted works that fell out of protection for a time because the owners failed to observe required formalities. In Golan, the Court espoused a fairly narrow view of the importance of the public domain to the Constitutional scheme for copyright protection. Still, every

347 College Sav. Bank, 527 U.S. at 673 (“That is why the right that we all possess to use the public lands is not the ‘property’ right of anyone – hence the sardonic maxim, explaining what economists call the ‘tragedy of the commons,’ res publica, res nullius.”).
349 Id. at 460.
350 Richard A. Epstein, The Dubious Constitutionality of the Copyright Term Extension Act, 36 Loyola L.A. L. Rev. 123, 156-58 (2002). Epstein also concludes that land and trademarks are different from copyright protection. The optimal length of ownership is infinite because like land, “trademarks … placed in the public domain … lose value.” Id. at 125. However, “individuals can acquire land, trade names, or trademarks of their own, so that their preclusive effects [of ownership] are minimal.” Id. at 125-26.
353 See id., 135 S. Ct. at 884 (“Petitioners find in [the Constitution’s grant to Congress to create copyright protection for limited times] an impenetrable barrier to the extension of copyright protection to authors whose writings, for whatever
copyrighted work and patented invention eventually falls into the public domain when its statutory term expires. This is often highlighted when a putative trademark owner tries and fails to exercise her exclusive trademark rights over a copyrighted work or patented invention after its protection under those regimes has expired. 354

In the Supreme Court’s view, the public domain is a commons where expressive works and inventions go to be used by all, regardless of potential public investment in those works. 355 In other words, it is a passive public domain. The plaintiffs in Golan argued that they had vested First Amendment rights because they had used the public domain works in creating their own expression. 356 The Supreme Court instead concluded that because the public domain was not an inviolable space, but one from which Congress could remove some copyrighted and patented works, the First Amendment argument was simply an alternate attempt to create an inviolable public domain. 357

Like the public domain for copyright and patents, where the public must wait for the work to enter the commons, the public domain from which commercial symbols are drawn has a passive element. Neither an ex ante generic mark 358 nor functional elements of trade dress 359 can be protected or registered. This is the case even if the public invests its energy to imbue the word or symbol with source significance. 360

reason, are in the public domain. We see no such barrier in the text of the Copyright Clause, historical practice, or our precedents.”). See also id. at 886 (“The First Congress … did not view the public domain as inviolate.”).
354 See, e.g., Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23, 33 (2003) (“The right to copy, and to copy without attribution, once a copyright has expired … ‘passes to the public.’”) (quoting Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, 230 (1964)); TrafFix Devices, Inc. v. Marketing Displays, Inc., 532 U.S. 23, 29 (2001) (“In general, unless an intellectual property right such as a patent or copyright protects an item, it will be subject to copying.”).
355 Golan, 135 S. Ct. at 892 (“Anyone has free access to the public domain, but no one, after the copyright term has expired, acquires ownership rights in the once-protected works.”).
357 U.S. CONST. Art I, § 8, cl. 8 (1776). See also Golan, 132 S. Ct. at 891-92.
358 See supra note 42 and accompanying text.
359 See 1 Mccarthy, supra note 16 at § 7:66.
360 Harley-Davidson, Inc. v. Grottanelli, 164 F.3d 806, 812 (2d Cir. 1999) (“The public has no more right than a manufacturer to withdraw from the language a
But this public lexicon also has an active component. At first glance, the public is rarely seen to take an active hand in the shaping of trademarks. In litigation, it is the competitor or junior user who typically stands as proxy for the public interest. Nevertheless, courts have found that consumer use can create trademark rights, as was the case when consumers started using “Coke” as a nickname for Coca-Cola. Eventually, the Coca-Cola Corporation secured rights in the nickname as well as its other trademarks.

In addition, consumers also have at least a collective voice as to whether a mark, incontestable or otherwise, falls back into the public domain via ex post genericness. Where courts are convinced that consumers have come to see a mark as primarily designating the genus of good or service in question, rather than the source of that good or service, the mark loses its source signification and enters the public domain.

For example, ASPIRIN was once a trademark designating acetylsalicylic acid sold in powder or pill form as a headache remedy from the Bayer Corporation, but consumers came to use the term as a generic designation generic term, already applicable to the relevant category of products, and accord it trademark significance, at least as long as the term retains some generic meaning”).

361 Margaret Chon, Marks of Rectitude, 77 FORDHAM L. REV. 2311, 2330 (2009) (“The underlying rationale of trademark protection is based upon a decentralized and privatized consumer protection scheme, where enforcement is provided by competitors, who act as proxies for the consumers.”). But see Michael Grynberg, Trademark Litigation as Consumer Conflict, 83 N.Y.U. L. REV. 60, 63 (2008) (arguing that the traditional narrative has the plaintiff as proxy of consumer interest through the prevention of confusion, and that courts should take into account nonconfused consumers who might have “a significant interest in the continuation of a defendant’s actions.”).


363 Suman Naresh considers the analogy between adverse possession and the acquisition of an incontestable registration to argue that descriptive marks that acquire secondary meaning and become incontestable would “but for the operation of incontestability, be (actively) held in common by the public and not merely (passively) unowned.” Naresh, supra note 11 at 988. [EIO] Naresh concludes therefore that the public holds active rights in those descriptive marks in the public lexicon. Id. See also Fagundes, Public Domain, supra note 20 at 657-58 (arguing that we can “explicitly present public entitlements in information as a subject of ownership, albeit a mutually owned possession that we are all entitled to access and use….to encourage respect for, and stewardship of, shared cultural resources.”).
for the powder or pills, and the mark lost its source significance. A mark typically begins to slip into generic usage when consumers start to use the adjectival brand name (like XEROX) as a noun (“Grab me that Xerox”) or a verb (“Go Xerox this document”). Mark owners seek to forestall this slide into genericity by educating the public, writers, and lexicographers about the correct usage of the mark. Courts are often sympathetic to those efforts. This process of resisting ex post genericness has also been compared in passing to defending against adverse possession.

The trademark owner thus takes a defensive posture against active public use that could strip a mark of its source significance. The reinvestment of a mark with generic meaning is an active process that can pull a protected mark into the public domain. As discussed above, the Supreme Court has not embraced this sort of activity with regard to the copyright regime. But is it possible that the public acts like an adverse possessor?

2. Adverse possession by the public.

For the public to re-occupy a trademark lexeme through ex ante genericness, the trademark must primarily come to represent a genus of goods or services, rather than goods or services from a particular source. When courts try to determine whether a mark has become generic, they often consider survey evidence. Assuming the validity of the sample

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365 See generally Shawn M. Clankie, Brand Name Use in Creative Writing: Genericide or Language Right?, in PERSPECTIVES ON PLAGIARISM AND INTELLECTUAL PROPERTY IN A POSTMODERN WORLD 253, 259 (Lisa Buranen & Alice M. Roy, eds., 1999) (criticizing Xerox’s trademark education efforts as “nothing more than mandated language use,” inconsistent with the constant process of change and the user-determined lexicon that exists at any given time).
367 See Shoshona Stern, Is Genericide a Matter of Fact or of Merit?, 2008 B.C. INTELL. PROP. & TECH. F. 032502 (2008) (suggesting that courts mistakenly and perhaps unconsciously analogize the effort of the owner to defend against ex post genericness to adverse possession). But see Abraham Bell & Gideon Parchomovsky, Pliability Rules, 101 MICH. L. REV. 1, 66-67 (2002) (suggesting that both adverse possession and ex post genericness are “pliability rules,” consisting of two distinct property regimes with an intervening trigger event, but different in that genericness is designed to discourage the accumulation of too much market power, while adverse possession discourages careless property ownership).
368 See supra notes 350-357 and accompanying text.
universe, if the majority of respondents identify the word or symbol as a designation of the genus of goods or services, this indicates that the mark has become generic.\textsuperscript{369} This suggests use by the public must be actual, open and notorious. While the trademark owner might have faced some historic difficulty in detecting potential generic uses, the Internet has likely increased the ability of trademark owners to detect public use of the word or symbol from which the trademark lexeme is crafted. Of course, this same ease allows a usage the mark owner does not like to move quickly throughout the language-speaking populace.\textsuperscript{370} If the principle significance of the mark is its generic sense, this also suggests generic usage has occurred continuously and for long enough to destabilize the source significance of the mark.\textsuperscript{371}

Treating generic use of the mark as use under a claim of right seems somewhat dissonant as well. Indeed, trademark rights are arguably irrelevant to public, generic use of a trademark. Lexicographers, a frequent target of cease and desist letters from trademark owners, arguably catalog use as they find it, and have neither the desire nor the intent to claim trademark rights.\textsuperscript{372} The public, through \textit{ex post} genericness, adds a meaning to the word or symbol used as the basis of the trademark lexeme. Here the meaning is generic, not source signifying. But if I am right in my earlier account that claim of right need not be hostile, or even recognize the right of record owner,\textsuperscript{373} the public can occupy a trademark lexeme under claim of right without consciously considering or intending to destroy the mark owner’s initial claim.

The analogy between adverse possession and public use that amounts to \textit{ex post} genericness breaks down when we consider exclusivity. Generic use opens up a commons: the mark, once protected, can now be used by every competitor. Every pharmaceutical company in the United States can refer to

\textsuperscript{369} See generally 2 McCarthy, \textit{supra} note 16 at § 12:6 (“The standard to be applied to determine whether a term is a generic name or is a mark is not whether the term has some significance to the public as the generic name of an article, but whether its generic meaning is its principal significance.”).

\textsuperscript{370} The process of trying to shift search results by generating outgoing links to the target site from sites highly-ranked by the search engine in question is frequently referred to as Google bombing or link bombing. ‘Google Bomb’ \textit{an Enemy}, WIRED HOW-TO WIKI, online at http://howto.wired.com/wiki/’Google_Bomb’_an_Enemy (viewed Feb. 4, 2012).

\textsuperscript{371} See \textit{supra} Part II.C.6.

\textsuperscript{372} See Clankie, \textit{supra} note 365 at 258-59.

\textsuperscript{373} See \textit{supra} Part II.C.3.
their tablets of acetylsalicylic acid as “aspirin” to indicate to consumers what those tablets contain. The public is rightly disinterested in engaging in substantially exclusive use of any sort. This suggests that prescriptive easement might be the better analogy for ex post genericness. While a prescriptive easement is generally available only to the individual uses property in a certain way over time, courts have recognized prescriptive easements claimed collectively by the public.\footnote{See supra note 313 and accompanying text.} Public use of a mark is active, but it is not exclusive in the way adverse possession must be.

What the adverse possession analogy helps tease out is that while the public does not necessarily engage of adverse possession of a mark when it pulls the mark into ex post genericness, there are both passive property rights in language protected by Congress as a commons, and active property rights that the public exercises with regards to the use of trademarks in language.

3. Public acquiescence in trademark ownership.

As mentioned above, trademark law is built around an assumption that consumer activity can swamp source significance. Consumers also contribute to the protection of trademarks. Secondary meaning surveys are often used to measure whether consumers see a given mark as source signifying, and today’s consumer-generated nicknames (like “Coke” for Coca-Cola) can become tomorrow’s trademarks.\footnote{See supra note 362 and accompanying text.} Indeed, as Jessica Litman has astutely observed, trademark owners build the source significance in their marks “with their customers’ money and active collaboration.”\footnote{See Litman, supra note 144 at 1730.}

Of course, if the public is acquiescing in or contributing to the use of the mark, then we might question whether the mark owner’s use of the mark is hostile or adverse at all. Recall, however, the claim of the adverse possessor who occupies with permission is denied because of the danger that she will ambush an unsuspecting record owner or co-tenant. To the extent that we worry the mark owner might trick the public into over-reliance on a descriptive mark, ex post genericness is the backstop that prevents the mark owner from acquiring troubling market power, or keeping from the public

\footnote{See supra note 313 and accompanying text.}
words it needs to collectively rely on to find the goods and services it requires from the mark owner’s competitors.\textsuperscript{377}

We might thus think of the relationship between the trademark owner and the public as operating in different phases. For ostensible marks that are \textit{ex ante} generic, courts deny any exclusive right in the mark, even where the public comes to see the mark as source signifying,\textsuperscript{378} a circumstance we refer to as \textit{de facto} secondary meaning.\textsuperscript{379} This is a space where the courts and Congress have simply barred any acquisition, the one instance of an impenetrable public domain, but only for the generic meaning of a given word.

For those marks that are inherently distinctive, courts are willing to presume that the mark can be source signifying even with a short window of use. This does not absolve the mark owner of engaging in proper subsequent use.\textsuperscript{380} In addition, to the extent Barton Beebe’s findings are generalizable, the commercial strength of the mark – its strength acquired through use over time – matters much more than its inherent strength.\textsuperscript{381}

In the middle area, we find words that are descriptive for a characteristic of the seller’s goods or services, a primary meaning that the mark owner must overcome with evidence of secondary meaning.\textsuperscript{382} In those cases, the mark owner looks most clearly like an adverse possessor, and takes on the same risk that the adverse possessor takes that protection may never vest.

Several scholars have challenged the protectability of descriptive marks, both in and outside of the context of an incontestable registration, because allowing the mark owner to control a term that describes a feature of her goods or services may deprive competitors of language necessary to compete by offering those same goods or services. Suman Naresh criticizes the presumption, under the Lanham Act, that descriptive marks can become

\textsuperscript{377} Justin Hughes points to the manner trademarks lose their property status via \textit{ex post} genericness as a “method of deprivitizing ideas,” to ensure that those trademarks which the owner has “lull[ed] the society” into depending on will fall back into the commons. Justin Hughes, \textit{The Philosophy of Intellectual Property,} 77 GEO. L.J. 287, 323 (1988). Hughes calls this “the permanent common”, but the Singer cases suggests otherwise. \textit{See supra} notes 153-155 and accompanying text.

\textsuperscript{378} \textit{Harley-Davidson, Inc.}, 164 F.3d at 812.

\textsuperscript{379} \textit{See, e.g.,} 1 McCARTHY, \textit{supra} note 16 at § 7:66.

\textsuperscript{380} \textit{See supra} notes 275-276 and accompanying text.

\textsuperscript{381} \textit{See supra} notes 281-296 and accompanying text.

\textsuperscript{382} \textit{See supra} notes 40-41 and accompanying text.
incontestable based merely on five years of continuous use.\textsuperscript{383} Naresh considers the possibility that incontestability might be justified by a desire to quiet title, one of the rationales identified earlier to support adverse possession, but concludes the public cannot consent to the acquisition of an incontestable mark through its collective inaction.\textsuperscript{384}

Lisa Ramsey argues that descriptive marks should be unprotectable as an unconstitutional restriction on commercial speech.\textsuperscript{385} Applying the Supreme Court’s \textit{Central Hudson} test,\textsuperscript{386} Ramsey concludes that allowing an owner to acquire rights in a descriptive word is a restriction on commercial speech that does not directly advance an asserted governmental interest.\textsuperscript{387} The protection of descriptive marks fails that test because at the point the mark owner begins to use the descriptive mark, it “does not immediately signal the brand of the product like an inherently distinctive mark.”\textsuperscript{388} Thus, granting and enforcing rights in the descriptive mark does not “directly or materially aid consumers in identifying or distinguishing among the products of competing sources.”\textsuperscript{389} Ramsey bases this assertion on the fact that while a descriptive mark can acquire secondary meaning, it never loses its primary descriptive meaning.\textsuperscript{390}

The adverse possession analogy makes clear that these concerns are somewhat overstated. The majority of the Circuit Courts to consider the question recognize that an incontestable descriptive mark is still descriptive, and thus weak – its scope of protection would likely not extend much beyond the use of an identical mark for identical goods or services, where the danger of free riding is the greatest.\textsuperscript{391} Incontestable descriptive marks may also be less of a problem than they initially appear. Barton Beebe’s study reported ten cases where an inherently weak mark had become incontestable, but in only one case did the mark owner prevail in

\textsuperscript{383} Naresh, \textit{supra} note 11 at 983-91.
\textsuperscript{384} Naresh, \textit{supra} note 11 at 988.
\textsuperscript{386} 447 U.S. 557 (1980).
\textsuperscript{387} Ramsey, \textit{supra} note 385 at 1157-59.
\textsuperscript{388} \textit{Id.} at 1149.
\textsuperscript{389} \textit{Id.} at 1147.
\textsuperscript{390} \textit{Id.} at 1157.
\textsuperscript{391} See \textit{supra} note 232 and accompanying text.
establishing likelihood of confusion, and in that case, the court found the mark ANIMERICA for anime magazines was suggestive.

Ramsey is correct in recognizing that secondary meaning does not strip a term of its original descriptive meaning, but neither does it grant any significant rights against other users, until the mark acquires distinctiveness, that is to say, until it has developed the capacity to “directly or materially aid consumers in identifying or distinguishing among the products of competing sources.” While use of exactly the same mark for exactly the same goods and services would be barred if the descriptive mark had acquired distinctiveness, there is no right to exclude and no priority until the mark acquires secondary meaning, just as the adverse possessor has no rights until her possession of the property has extended beyond the statutorily prescribed window. It is also worth noting that a recent study by Thomas Lee and his co-authors suggests that consumers more readily recognize descriptive marks as source signifying than we might have historically thought.

Here, Lee Anne Fennell’s goal of limiting adverse possession to those cases where there is a clear signal of greater value of the property in the hands of the adverse possessor, and Eduardo Peñalver and Sonia Katyal’s perceptive understanding how the uncertainty faced by the adverse

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392 See generally Beebe, Multifactor Tests, supra note 15.
393 That case, Viz Comms, Inc. v. Redsun, 2004 U.S. Dist. LEXIS 24481, *13 (N.D. Cal. Mar. 8, 2004). Note there is some disagreement under the courts as to whether suggestive marks are strong or weak. Compare AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341, 349 (9th Cir. 1979) (concluding that a suggestive mark is a “comparatively weak mark”) with Star Indus., 412 F.3d at 386 (“[S]uggestive marks are at best moderately strong.”) and Champions Golf Club v. Champions Golf Club, 78 F.3d 1111, 1116 (6th Cir. 1996) (“A suggestive term is considered stronger than one that is merely descriptive” but not as strong as an arbitrary or fanciful mark).
394 Id. at 1147.
395 Entrepreneur Media, Inc. v. Smith, 279 F.3d 1135 (9th Cir. 2002).
396 Thomas R. Lee, Eric D. DeRosia & Glenn L. Christensen, An Empirical and Consumer Psychology Analysis of Trademark Distinctiveness, 41 Ariz. St. L.J. 1033 (2009). Lee and his collaborators reported that when a descriptive mark is presented in context on product packaging as a trademark, survey participants recognized it as a trademark with roughly the same frequency as they did the traditional inherently distinctive marks, while generic marks were typically not perceived as trademarks.
397 See Fennell, supra note 83 at 1039-41.
possessor signals how much she values the property, work in harmony to clarify why protection might reasonably vest in descriptive marks.

The putative owner of a descriptive mark signals how much she values the mark by her willingness to take on such an uncertain proposition. In order for a descriptive mark to become incontestable, the mark owner must get past potential competitors. If she traverses the gauntlet outlined in Part II.C.3, it will occur in part because neither the public nor competitors see value in the mark for an extended period of time. There is some cost to competitors to follow trademark registrations, check publications, and watch for competition in the marketplace. The willingness of competitors to engage in such work is a signal that tells us how much, if at all, they value the putative mark, either as a source signifying signal or to describe their own products or services. Competitor interest in turn is a proxy for whether it is necessary to use the symbol to communicate with consumers, or whether there might be multiple ways to communicate with consumers.

In this light, incontestability for descriptive marks seems less problematic if a competitor who needs access to the descriptive term will encounter the mark early enough to thwart either the initial registration of a descriptive mark by either challenging the 2(f) affidavit of acquired secondary meaning, or challenging the mark prior to incontestability. Ten or more years of silence thus operate like an adverse possession window that not only settles the mark owner’s claim to the rights that come with incontestability, but send a signal about relative valuation. To the extent we wish to discourage the use of descriptive marks, the longer window and the uncertainty regarding when the mark acquires secondary meaning may give us a benefit that a bright line rule would not.


399 Jess Gupta suggests we should instead treat the action of the mark owner as indicating an assumption of risk that the mark cannot be protected, or is entitled to little protection. Jess Gupta, Comment, Descriptive Trademarks and the Assumption of Risk, 45 U.S.F. L. REV. 811 (2011) (“[A] person or business that chooses to affix a descriptive mark to goods or services assumes the risk of weaker protection for that mark”).


401 See supra notes 48-50, 273 and accompanying text.
If the putative mark owner of a descriptive mark manages to communicate with consumers for ten years without running afoul of competitors, it suggests competitors place little value on the descriptive mark as a competitive necessity. It may also suggest that consumers identify the mark as designating a source for the owner’s goods and services. The inattentiveness of the competition may signal their collective disinterest or demerit (not unlike the ambush prevention rationale for transfer in adverse possession), and thus militate in favor of greater stability that the incontestable registration affords the mark owner.

As I detail next in Part IV, these lessons coalesce to help us see what trademark acquisition can teach us about adverse possession, and what adverse possession teaches about trademark law.

IV. IMPLICATIONS AND RECOMMENDATIONS

A. Communication through Productive Use

At their core, trademark law and adverse possession are both communicative regimes, but they incentivize productive use by making that use the means of communicating with the public. The adverse possessor who operates under color of title or fences the property provides information about how she values the property and indicates that she has gone to some length in signaling that interest to the record owner and other competitors for the property. Initial steps like fencing lead to a title, however, only when the adverse possessor also engages in continuous and exclusive use over time. She must act like an owner, and persistently doing so leads the public to treat her like one. Bringing the property to productive, or at least open use, is also communicative in valuable ways because the use itself provides an indication for the boundaries of the property.

Adverse possession is also information forcing, as Carol Rose identified. By entering the property and subjecting it to use, the adverse possessor puts the record owner on notice that there are competing claims to the property, and the record owner should step in to clarify the boundaries of the property, or risk losing its claim.

402 Cf. Lee et al., supra note 396 and accompanying text.
403 See also Bell & Parchomovsky, supra note 367 at 57 (citing Rose, Possession, supra note 85 at 79) (“[T]he use of a title shifting pliability rule [like adverse possession] has desirable information forcing effects”).
Trademark use is also communicative and information forcing. Inherently distinctive marks possess secondary meaning at the moment of their first use in commerce because their primary meaning did not previously exist or did not previously occur to the public. A fanciful or coined mark, like XEROX for photocopying machines, is invented whole cloth and has no meaning prior to its use as a trademark. An arbitrary mark, like APPLE for computers, creates a whole new meaning for a term we are familiar with. While a suggestive mark is more closely related to the underlying goods or services, it still requires a conceptual leap to get from the mark to the product. All of these marks transform language and create new meaning in their inception and use. Trademark law is structured in accordance with the presumption that the entity who first coins a mark can form a direct relationship between the mark, the mark’s creator, and the creator’s goods and services with minimal effort because the word or symbol is something we’ve not encountered before, and thus is inherently distinctive.

On the other hand, a descriptive mark may not by its nature communicate information about source signification because the descriptive term has a primary meaning: it describes a feature of the good or service offered. The mark’s direct relationship to the designated good or service makes it difficult to determine where the description ends and the trademark begins. That is why use in commerce over a sufficient length of time is a critical step to establish secondary meaning. As the Beebe study highlights, however, such use is also critical for maintaining the strength of an inherently distinctive mark. In both cases, productive use over time is the signal that tells the public about the value of the mark to the mark owner and provides the signal that reduces search costs for consumers by identifying a consistent source for the mark-bearing goods and services.

B. Recommendations

1. Adverse possession: Stop worrying about bad faith.

Recognizing trademark ownership as adverse possession helps simplify some of the complexity that has been built up around the claim of right prong of the adverse possession test. As discussed in Part II.C.3 supra, there is a tendency to misapprehend what we mean by possession under claim of right. Courts use “hostility” as a short hand, and it is easy to draw differing conclusions about what the “adverse” in adverse possession really means. Scholars have thus questioned whether we should treat good faith

404 See supra notes 278-291 and accompanying text.
adverse possessors more preferentially than bad faith adverse possessors\textsuperscript{405} and whether courts actually favor good faith adverse possessors, regardless of what a given statute or judge-made test might say about the claim of right.\textsuperscript{406}

If I am correct in my assessment that the adverse possession and trademark acquisition are primarily focused on productive use that provides the public with notice, these questions may not be the ones we need to answer. We should favor good faith or bad faith possession only to the extent that one type of possession provides better notice to the record owner and the public. It seems more likely that intent is a placeholder for other issues. Good faith or innocent adverse possession is often attributed to border-adjusting encroachments between neighbors, but that encroachment looks the same to the world and to the record owner whether the adverse possessor is aware of the property lines or not. Likewise, occupying property that is not coterminous with the adverse possessor’s other parcels can quickly put the public and the sufficiently attentive record owner on notice, whether or not the adverse possessor knows or cares that there is another record holder.

In other words, we should stop worrying about good faith v. bad faith adverse possession, and stop setting different time periods for good faith and bad faith adverse possessors, because there is nothing inherently communicative about it. We might nevertheless value the possessor who occupies with color of title and records the title, not because she is a “good faith” purchaser but because the purchase, and the record of it, puts us on better notice of her claim.

2. Crystals and mud in trademark law

In considering the development of property rules over time, Carol Rose describes some rules as formal, hard-edged and occasionally merciless.\textsuperscript{407} These rules are “crystals,” providing certainty to property owners about

\textsuperscript{405} Compare Epstein, \textit{supra} note 87 at 622 (asserting that a good faith adverse possessor should be able to secure rights in a shorter time than the bad faith adverse possessor, a practice we see embodied in some jurisdictions) \textit{with} Fennell, \textit{supra} note 83 at 1039-41 (arguing that only those “bad faith” adverse possessors who can show they would have paid for the property in question, and thus are possessing only to correct an apparent market failure, should be allowed to adversely possess the property).

\textsuperscript{406} See \textit{supra} note 208 and accompanying text.

\textsuperscript{407} See Rose, \textit{Crystals, supra} note 14 at 577-78.
how to plan for the future.\textsuperscript{408} Providing the adverse possessor with a title grant commensurate with the bounds of her fence, or the property borders described in her color of title, is just such a crystalline rule. There, so long as real use occurs, the bright line of borders or documentation defines the property right.\textsuperscript{409}

On the other hand, the adverse possession regime generally has been referred to as a “muddy” property regime.\textsuperscript{410} Compared to trademark’s likelihood of confusion test, adverse possession is a model of clarity. Adverse possessors at least face a certain statutory period, even if there is uncertainty as to whether their possession will be sufficiently exclusive, continuous, or consistent with the character of use in the neighborhood. As discussed in detail above, trademark owners enjoy no such certainty.\textsuperscript{411} One of the characteristics of muddy property rules is that they provide more discretion to decision makers after the fact,\textsuperscript{412} and so for many muddy rules, we might not know the scope of an entitlement “until we litigate the issues.”\textsuperscript{413} The likelihood of confusion test is thus prototypically muddy. In fact, the apparent tendency of courts turn to commercial strength and tend to favor it over inherent strength exacerbates the problem.\textsuperscript{414}

This can be a problem not only for trademark owners, but also for competitors and the public. David Fagundes has argued persuasively that sometimes clear boundaries can help clearly delineate the public domain. For example, copyright fair use is a muddy defense.\textsuperscript{415} Creating clear safe harbors for fair use may aid in fair users by helping them know some things they can clearly do without the permission of the copyright owner.\textsuperscript{416}

What, then, can we do for our active public domain? We could get serious about crystals. If we think, as a matter of public policy, that more frequent

\textsuperscript{408} Id. at 595.
\textsuperscript{409} We err in exactly the other direction for assertion of trademark protection. It is not the goods defined in the registration that define the scope of protection, but the use that defines the scope of the registration. Where a mark owner fails to use goods, she will lose the registration, at least as to those goods and services. See supra notes 231-236 and accompanying text.
\textsuperscript{410} See Pessach, supra note 14 at 1285-86.
\textsuperscript{411} See supra Part II.C.6.
\textsuperscript{412} Rose, Crystals, supra note 14 at 591.
\textsuperscript{413} Id. at 581.
\textsuperscript{414} See supra notes 277-290 and accompanying text.
\textsuperscript{415} See Fagundes, Crystals, supra note 19 at 143.
\textsuperscript{416} Id. at 151-53.
abandonment of trademarks for non-use is in the public interest, we might stiffen the abandonment test outlined in § 45 of the Lanham Act.\textsuperscript{417} Currently, the presumption that the mark is abandoned after three years of non-use is easily overcome by evidence that the mark owner intends to resume use, a fairly low standard.\textsuperscript{418} Instead of treating three years of non-use as prima facie evidence of abandonment, we could treat it as conclusive evidence of abandonment.

Crystallizing the length of time required to acquire secondary meaning or commercial strength would provide some certainty for the mark owner, at least as to the amount of time she has to bring the mark up to a sufficient level of commercial productivity. It could also provide some certainty for the public and potential competitors.

It might be difficult to create a one-size fits all secondary meaning window, but consider the result if we treated the § 2(f) presumption that a descriptive mark acquires secondary meaning and can be registered after five years of substantially continuous and exclusive use as a hard floor for the amount of time required to secure secondary meaning in a descriptive mark.\textsuperscript{419} The public and competitors would know that the mark would need to be used for a minimum of five years before the mark could obtain priority against other users. This would disincentivize the adoption of descriptive marks for which the mark owner could otherwise establish secondary meaning in less than five years. But to the extent that we think the public benefits when competitors utilize descriptive terms without the permission of prior users, the harm to the trademark owner created by such


\textsuperscript{418} See, e.g., Zelinski v. Columbia 300, Inc. 335 F.3d 633 (7th Cir. 2003) (mark owner can rebut the presumption of abandonment by “demonstrating the lack on an intent not to resume use”, and did so by discussing the production of his branded bowling balls with two other companies) (quoting Sands, Taylor & Wood Co. v. Quaker Oats Co., 978 F.2d 947, 955 (7th Cir. 1992). \textsuperscript{419} My suspicion is that courts are actually currently using five years as a soft floor for secondary meaning. See, e.g., Miglin, 224 U.S.P.Q. at 181 (finding no secondary meaning and noting that the Seventh Circuit had denied the plaintiff’s claim of secondary meaning in Gimix because five years of use prior to the junior user’s introduction of a similar product was “so brief as to cast serious doubt upon the very possibility of having established a strong secondary meaning”) (quoting Gimix, Inc. v. JS&A Group, Inc., 699 F.2d 901, 907 (7th Cir. 1983)). See also notes 298-299 and accompanying text. This might suggest a tendency on the part of courts to crystallize muddy rules where they can. An empirical study like the one I propose in the conclusion might provide helpful clarity on this issue.
a floor might be offset by broadening the marks that effectively remain in the public domain for descriptive use.

We could also crystallize this same five year window in a way that favors mark owners if we treated it like a safe harbor for mark owners who adopt inherently distinctive marks. This would work like a soft abandonment window: for the first five year, courts would presume the inherently or conceptually strong mark was commercially strong. Thus, so long as the mark reaches a reasonable level of commercial strength within five years, the mark would be presumed strong, and likely to prevail more often in infringement suits. One potentially unpopular result of either crystallization is that courts would be required to determine whether a mark was descriptive or suggestive, which is notoriously difficult, because the five year floor would cut in favor of the inherently (moderately\(^{420}\)) strong suggestive mark but against the inherently weak distinctive mark.\(^{421}\)

Carol Rose posits that courts tend to muddy crystalline rules to prevent forfeiture and protect sympathetic negotiators from the consequences of their bargains,\(^{422}\) and it would not be surprising to see courts act in like manner when faced with a floor for the acquisition of secondary meaning, the loss of acquired strength, or a bright line abandonment rule.\(^{423}\)

It is not the case, however, that every crystallization will benefit the public. For example, the constructive nationwide first use from the time the § 1(a) application is filed also reserves space in a way that we might find discomfiting under the adverse possession model.\(^{424}\) Likewise, to the extent that use in commerce sends the most valuable signal to consumers and the public, we have moved far from it by allowing the mark owner to reserve her space for a time by filing an intent-to-use application.\(^{425}\) This is not much different, however, than using color of title or fencing to set

\(^{420}\) See supra note 393.
\(^{421}\) Compare Valmor Prods. Co. v. Standard Prods. Corp., 464 F. 200, 202 (1st Cir. 1972) (concluding that while a laudatory mark was likely suggestive, it didn’t matter because 45 years of advertising was sufficient to establish “a close connection between the trademark name and its products”).
\(^{422}\) Rose, Crystals, supra note 14 at 598.
\(^{423}\) We actually see such resistance to even the soft abandonment rule. See, e.g., Prudential Ins. Co. of Am. v. Gibraltar Fin. Corp. of Cal., 694 F.2d 1150, 1156 (9th Cir. 1982) (“Abandonment of a trademark, being in the nature of forfeiture, must be strictly proved.”)
constructive occupation sufficient to support adverse possession. And those intent-to-use application came in response to the prior muddying of the use rule which allowed registration based on token use, i.e., without genuine use in commerce.426

If there is some value in crystallization, it is undermined by the fact that the inherent distinctiveness factors are slowly being swamped by the acquisition of commercial strength,427 and by the fact that there are few periods of certainty for the mark owner to rely on in securing secondary meaning or commercial strength.428 As to the commercial strength factor, this tendency is less troubling when viewed through the adverse possession lens because we see that it is the consistent use over time, and not merely initial possession, that communicates to consumers the source significance of the mark. With regards to the absence of a clear duration window, the adverse possession parallel helps us recognize that trademark protection is a stepped process where extended periods of use bring more extensive rights. The temporal uncertainty of the length of use requirement to secure trademark rights is less troubling than it might first appear because it pushes us back toward recognizing use in commerce as the foundational principle. The certainty stems not from the duration but from the use, and that is as it should be.

If we value uncertainty with regard to commercial strength and secondary meaning as a way to keep the mark owner on her toes, commercially speaking, that benefit is also undermined by a tendency of courts to presume that registered descriptive marks have acquired secondary meaning,429 and that incontestable marks are inherently strong, based simply on registration status.430

For the reasons I outline above, I am not convinced that the registration of descriptive marks that acquire distinctiveness is at all problematic. But the noted tendency of most courts to weaken the presumption of strength for incontestable marks where there is an indication that the mark is in fact

426 Daniel R. Bereskin, Miles J. Alexander, & Nadine Jacobson, Bona Fide Intent to Use in the United States and Canada, 100 TRADEMARK REP. 709, 717 (2010) (reporting that the “bona fide” requirement in the intent-to-use standard is designed to eliminate “token use”).
427 See Beebe, Multifactor Tests, supra note 15 at 1636.
428 See supra notes 261-266 and accompanying text.
429 See supra Part II.C.6.
430 See supra note 232 and accompanying text.
commercially weak muddies the rule to the benefit of competition.\textsuperscript{431} Here, courts seem interested in getting right results where the bright line rule might wreak havoc or work an injustice. I see the same tendency in the guidance given examining attorneys at the PTO to consider the type of mark before applying the 2(f) presumption in favor of finding secondary meaning and registering a descriptive mark after five years of use.\textsuperscript{432}

CONCLUSION

In addition to the prescriptions for trademark law and adverse possession law that stem from the comparison of the two regimes,\textsuperscript{433} this Article offers two overarching directions for future research. First, comparing property regimes (by which I mean regimes with property-like features) can provide crucial insights, even when the analogies are not perfect. This Article has fleshed out important similarities, but it is also true that adverse possession cannot tell the whole story. It thus seems reasonable to consider what other property regimes can teach us about trademark ownership. I suggest two examples.

Lior Strahilevitz has compared the manner in which trademark rights expire to a usufructuary abandonment regime, like that governing use-based water rights in Western states.\textsuperscript{434} Eric Claeys has compared trade secret and hot news protection to usufructs.\textsuperscript{435} It is possible that the acquisition of trademark protection is inherently usufructuary in a similar way.

We might also gain important insights by considering whether trademark protection operates as an accession right. As articulated by Thomas Merrill, “[t]he principle of accession holds that ownership is established by assigning resources to the owner of some other thing that is already owned.”\textsuperscript{436} Professor Merrill has suggested that dilution protection reflects the principle of accession.\textsuperscript{437} Trademark dilution protection grants the owner of a famous mark – like KODAK for cameras – the right to prevent whittling away of the mark by its use on dissimilar products like pianos, or

\begin{footnotes}
\textsuperscript{431} See supra note 232 and accompanying text.
\textsuperscript{432} See supra notes 267-269 and accompanying text.
\textsuperscript{433} See supra Part IV.
\textsuperscript{434} See generally Strahilevitz, supra note 93.
\textsuperscript{435} See generally Claeys, Intellectual Usufructs, supra note 25.
\textsuperscript{436} Merrill, Accession, supra note 20 at 460. [EIO]
\textsuperscript{437} Id. at 469 (arguing that the common law doctrine of accession helps explain dilution protection for trademarks).
\end{footnotes}
products that might tarnish the reputation of the brand. Professor Merrill is correct, but did not discuss, in his first cut at the question, the full extent to which trademark more generally reflects the principles of accession, the protection granted against the use of the same mark on goods only proximately related to the mark owner’s goods, or which the mark owner might realistically sell under the mark in the near future.

Second, empirical studies of trademark case law provide important insights. One area where insight is needed is an examination of whether courts have already begun crystallizing the length of time required to acquire distinctiveness or commercial strength. To my knowledge, no such studies have yet been conducted. One might find indications that different types of marks acquire distinctiveness or commercial strength at different rates or that marks with different levels of inherent strength acquire fame at different frequencies. Such findings would indicate that courts and examiners are actually crystallizing instead of muddying the rules, but doing so in a way that favors a longer period of possession, slowing the acquisition of trademark protection, and leaving the mark owner’s rights less certain.

439 The Second Circuit refers to this as “bridging the gap.” The likelihood that the gap will be breached is one of the elements in the Polaroid likelihood of confusion test. 287 F.2d at 495.
440 See supra note 419.