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Your Image Is My Image: When Advertising Dedicates Trademarks to the Public Domain--With an Example from the Trademark Counterfeiting Act of 1984

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Trademark laws protect the mental association between the source of a product and the product itself. This protection allows consumers to locate merchandise of known quality, and motivates suppliers to produce better merchandise. The extent to which trademarks are property rights owned by the controller of the items they identify is controversial. These dual purposes of trademark protection are often phrased as if the objectives reinforce one another. Sometimes, however, the interests conflict. If the public's interests are not recognized they cannot be protected. This article suggests the existence of an ignored public ownership interest. Trademarks may become communicative symbols standing for something besides the source or sponsorship of the product in whose service they originated. When this happens, the public acquires an ownership interest in the communicative power of the trademark. The symbol's transmutation can be analyzed in traditional trademark terms as function, genericism, or non-trademark use.
Our adversarial system of justice n10 and the standing rules of the Lanham Act n11 cause trademark actions testing the validity of trademarks, [*1394] [*1395] or their infringement, to come before the courts n12 as disputes between commercial entities. n13 The interested party excluded from this process is the person who actually "owns" the entire communication system in which trademarks are embedded, the speaker of English. n14 Theoretically, the party attacking the validity of an established trademark acts on behalf of this missing party. Several trademark doctrines can help individual combatants protect the public domain, including narrower protection for nonfanciful marks, genericism, functionality, and nontrademark use. Because of this missing, but obviously affected party, I suggest the courts have a special duty to consider the public ramifications of private trademark quarrels. n15 [*1396]

To illustrate the reality of this threat to the public domain, I present an example from the Trademark Counterfeiting Act of 1984 n16 (the "Act") and the inferences which may be drawn from its judicial interpretation. Four circuits have recently read the language of the Act as a mandate for criminalizing sales of imitation merchandise to customers who knew the merchandise was "fake." n17 These decisions are based on problematic legal analyses. The Act does not speak of knowing purchasers of "fakes," and the legislative history of the Act does not clearly support such an interpretation. More importantly, analysis supporting these decisions radically shifts the property/consumer-protection balance. n18 Although the courts' immediate policy concerns are understandable, because these criminal plaintiffs may produce harm to our already shaky national economy, the courts have overlooked the greater harm which is caused by these decisions - shrinkage of the public domain. I contend that if the courts had considered the public's interest in maintaining the public domain, these decisions would not have been rendered.

In summary, this article assumes that the public "owns" the basic tool of communication - the entire system of signs and symbols. The factual assumptions here are that (1) the procedural organization [*1397] of the court system muted the public's attempt to protect its interest in these symbols, and (2) the trademark doctrines of, inter alia, functionality, genericism, and collateral use are used by courts to protect the silent public interest. This paper argues that life-style advertising may turn trademarks into communication symbols, which dedicates them to the public; the courts have interpreted the Trademark Counterfeiting Act (and the Lanham Act n19) without recognizing the broad communicative functions of trademarks; and the courts' reading of the Act is challengeable as a misreading of the statute itself, its legislative history, and existing case law.

I. Trademarks as Communication

The interaction between life-style advertising, trademarks, and human use of consumer objects has legal consequences, which may be discussed in terms of function, genericism, and collateral use. n20 A watch, for example, is no longer merely an object used to tell time; it is also an object used to make a statement about personal status. n21

A. Status and Self Definition

"Conspicuous consumption" was first defined and publicized by Thorstein Veblen in his classic work, The Theory of the Leisure Class. n22

"Conspicuous consumption" is the visible use of goods by a successful person and his household. A businessman publicly establishes and flaunts his own wealth and, therefore, his honorable status, by consuming expensive goods himself and by delegating to his wife, children, and servants the ability to demonstrate the extent of his wealth. n23 The choice of specific goods he and his household will consume is largely based on society's expectations for each class. n24 [*1398] Claiming respect through visible use of goods is more important in societies where people are not well known to each other: n25

The means of communication and the mobility of the population now expose the individual to the observation of many persons who have no other means of judging of his reputability than the display of goods (and perhaps of breeding) which he is able to make while he is under their direct observation. n26
Later scholarship accepts Veblen's basic concept, but takes a more expansive view of the messages people communicate through their choice of objects for public display: n27 [*1399]

Consumer goods have a significance that goes beyond their utilitarian character and commercial value. This significance consists largely in their ability to carry and communicate cultural meaning. In the last decade a diverse body of scholars has made the cultural significance of consumer goods the focus of renewed academic study. Their work has established a kind of subfield across the social sciences which now devotes itself with increasing clarity and thoroughness to the study of person-object relations. n28

Objects of material culture are accepted as a means of communication, n29 and consumers may attach to themselves the cultural meanings of consumer goods by acquiring and publicly using them. n30

The history of civilization can be traced through the history of objects. n31 "Man is not only homo sapiens or homo ludens, he is also homo faber, the maker and user of objects, his self to a large extent a reflection of things with which he interacts. Thus objects also make and use their makers and users." n32 The distinctive quality of industrial civilization is that persons are shaped more by the objects they use than by the objects they fashion - that is, they form a consumer society. n33

One of the glories of the American Way is that status categories [*1400] are fluid and largely self-selected. n34 This phenomenon is recognized by some who see the characteristic as less than glorious. n35 Lears, for example, posits a "fundamental cultural transformation, within the educated strata of Western capitalist nations" between 1880 and 1930. n36 The cultural model which vanished expected its leaders to practice "perpetual work, compulsive saving, civic responsibility, and a rigid morality of self-denial." n37 The new culture offered individuals more choice, but left them with a feeling of the unreality of life, which many perceived as an overwhelming illness of society and its constituent individuals. n38 The cure for this illness was self-realization, and the therapy was supplied by consumer goods. The value of these consumer goods and the meaning which they could supply to individuals' lives was defined by the burgeoning advertising industry: n39

The original location of the meaning that resides in goods is the [*1401] "culturally constituted world." This is the world of everyday experience in which the phenomenal world presents itself to the senses of the individual, fully shaped and constituted by the beliefs and assumptions of his or her culture. This world has been constituted by culture in two ways. Culture is the "lens" through which all phenomena are seen. It determines how these phenomena will be apprehended and assimilated. Second, culture is the "blueprint" of human activity. It determines the co-ordinates of social action and productive activity, specifying the behaviors and objects that issue from both. As a lens, culture determines how the world is seen. As a blueprint, it determines how the world will be fashioned by human effort. In short, culture constitutes the world by supplying it with meaning. n40

The ways in which meaning initially enters the world and how meaning is transmuted over time are well beyond the scope of this Article. What is relevant here is the method by which meaning moves from the culture in general to attach itself (or be attached) to specific consumer goods. McCracken identifies the fashion system and advertising as two prime manipulators of these migrations. n41 The fashion system includes such diverse persons as the designers of products available for consumption, acknowledged leaders of high status, marginal [*1402] groups (such as hippies or punks) who adopt radical object usages, and social observers who publicize the available choices. n42

The advertising director is a purposeful manipulator of cultural meanings. He chooses properties in the "culturally constituted world" which are desired by his targeted consumer group, n43 then uses advertising to create links between those values and the product he is touting. n44 If he is successful, the consumer will buy the offered object in order to capture this meaning for himself. n45 The consumer uses the goods in an "ongoing enterprise of self-creation," n46 which is largely [*1403] public and involves symbolic communication. n47
McCracken discusses four rituals which move the meaning from the consumer good to the consuming person: exchange, possession, grooming, and divestment. Exchange involves the choice and purchase of goods by one person for use of another person. The offered gifts are both the items and their symbolic properties. “The giver invites the recipient to define herself or himself in its terms.” Possession rituals involve both the owner's claiming the commonly accepted symbolic properties of the goods for herself and investing the goods with "meaning from the individual's own world." In addition to simple use of the items, possession rituals include "cleaning, discussing, comparing, reflecting, showing off, and photographing" the goods. Grooming is invoked to establish temporary possession of perishable symbolic property. The weakness of the link may arise either because the individual cannot maintain permanent ownership of the symbolic property, or because the object's hold on the symbolic property is precarious. Dressing for a gala occasion is an example of the former. The latter includes repeatedly washing or tuning up a car to be sure its powerful symbolism is fully available to its owner. Divestment rituals are used both to remove another's personal meanings from goods so that one can claim them for oneself (for example, by redecorating a newly purchased, formerly-owned house) and to remove oneself from goods before passing them to another owner. In short, McCracken posits that advertising helps attach meaning to consumer goods, and that consumers choose goods in part to obtain these added meanings.

Advertising executives purposely tie the goods they publicize to a quality or life-style desired by their targeted consumer group. They proclaim that one function of advertising is to imbue goods with “added values.” To simplify, an advertising campaign begins with a product. The advertising professional and the manufacturer decide which segment of society they wish to target as potential consumers of the product. The advertisement they create attempts to imbue their product with some quality of value to the targeted social group. A really successful advertisement strategy creates a cultural personality for a product: the product becomes the symbol of a specific life-style desired by their targeted consumer. For example, cigarette and liquor advertisements aimed at young people often concentrate on sex and "the good life": Beautiful couples are portrayed enjoying themselves in an expensive environment, while displaying obvious sensual enjoyment of each other's company.

In product categories where little product differentiation exists, "the advertising is the product.” Sex and success are commonly sold in advertisements, as are fun and youth. These are broadly defined dreams. Advertisements often target desires to position oneself more specifically. Fear of particularized social disapproval has been used to sell mouthwash, deodorant, and enlistment. Betty Crocker cake mixes failed when they were originally introduced because the consumer had only to add water and bake, and women believed that use of such a product proved they were lazy. Once the mix was changed so the baker had to add an egg, the mixes sold well, because the woman was portrayed as actively involved in making a treat for her family. A change in the product (which made the mix less "functional," as it reduced the product's ability to save bakers' time and effort) was forced by a need to redefine the users' image in the advertising. The symbolic function controlled the practical function. Consider Pillsbury's famous slogan, "Nothing says loving like something from the oven and Pillsbury says it best.”

An ad campaign can offer a specific identifying factor to the consumer as its added value. Often this specific pull is identification with a human celebrity. Many of the more lasting identifications are made with synthetic celebrities - characters created for the advertisements. The most famous, perhaps, is the Marlboro Man, who was created to reposition a women's filter cigarette to induce men to smoke it.

Life-style advertisements offer consumers a symbol with which they can reposition themselves in their lives. These advertising images are not necessarily related to the practical functions of the products they represent. They tie consumers to what the consumers want to be, or want to appear to be, not to what they actually are.
Most crucial is that they are clearly understood by other members of society. The tie between the product and the type of person who uses it in the fantasyland of advertisements is socially cognizable. Therefore, the product can be used to invoke - to communicate - the consumer's ownership, or his desire to own, the advertising dream. Even those critics of advertising who denigrate its power and insist on the primacy of the product's conventionally functional attributes agree that added values are partly created by advertising images.

How is this concept of advertising related to protection of trademarks? This type of advertisement creates new dimensions to the standard legal categories of functionality, genericism, and collateral use; the trademark becomes part of the product. The facts and theories discussed above may seem a trivial rehash of the obvious, but they have not been integrated into trademark decisions. The changes from such an integration would not be trivial.

B. Function

1. Functional Trademarks - The Thesis

Functional features cannot be protected by trademarks. "The Lanham Act does not protect essentially functional or utilitarian product features because such protection would constitute a grant of a perpetual monopoly over features that could not be patented." Functional features "connote other than a trade-mark purpose. If the particular feature is an important ingredient in the commercial success of the product, the interest in free competition permits its imitation in the absence of a patent or copyright." Functional features of a product are features which constitute the actual benefit that the consumer wishes to purchase, as distinguished from an assurance that a particular entity made, sponsored, or endorsed a product. "Even when the allegedly functional product feature is a trademark, the trademark owner may not enjoy a monopoly over the functional use of the mark." If the consumer purchases an item in order to obtain the added values created by advertisements, those added values are functional features. Status, membership in a group, sexual allure and the appearance of success are among the added values (the functional features) consumers buy when they choose a specific brand. Status communication should, therefore, be unprotectable even if it means reuse of the trademark or trade dress of an original brand. The undeceived consumer should be able to buy any item that provides him with the function of repositioning himself in his community, even if the item reuses the trademark symbol of a commercially-available product. The consumer should be allowed to use symbols to lie.

Phrased as the right to lie, this proposition suddenly sounds indefensible. Judge Jerome Frank saw it in this immoral light when he decided Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-Le Coultre Watches, Inc. Judge Frank held that a consumer who knowingly bought a less expensive clock which looked like the plaintiff's model harmed the plaintiff. "Plaintiff's wrong thus consisted of the fact that ... a visitor would be likely to assume that the clock was the plaintiff's brand clock." Judge Frank saw that the consumer was buying the clock "for the purpose of acquiring the prestige gained by displaying what many visitors would regard as a prestigious article." But he did not deny the plaintiff's claim to monopolize a functional feature - the prestige associated with his clock. Perhaps he simply did not make this connection. Certainly, none of the parties mentioned the possibility in their briefs on appeal. The manufacturer would clearly be harmed if such functionality arguments are accepted. The consumer's benefit is also obvious - he could acquire the status associated with the plaintiff's goods without paying full market price for them. If the consumer's action is immoral, we can label it as "against public policy." We would then be left with the unopposed interest of the manufacturer and Judge Frank's decision in his favor. If we call the consumer's interest a "right to lie" we are implying that his behavior is unattractive, and that society should discourage it, or fail to protect him when his action is opposed by the trademark proprietor. But the consumer is simply engaging in normal behavior which could easily be labeled self-definition, materializing goals, signalling self-worth, or communication of values.

In a more recent decision, the Ninth Circuit held that if the Vuittion mark increases consumer appeal only because of the quality associated with Vuittion goods, or because of
the prestige associated with owning a genuine Vuitton product, then the design is serving the legitimate function of a trademark; it is identifying the source of the product, and thus should be protected. n94

This holding skips an important step. Is the consumer trying to buy the prestige of owning something that comes from Vuitton, or is the [*1415] consumer just trying to buy prestige? n95 The court implies, but does not state, that the two questions are identical. But they are not. n96

Consider the following hypothetical n97 : Zoom Car Company manufactures the Zoomer. One of the Zoomer's available options is the Protector, an anti-theft system which costs $400. When the Protector is installed at the Zoom factory, a warning decal is attached to the car's window. The decal states: "This car is protected by the Protector anti-theft system, a product of Zoom Car Co." The Protector's control panel has a distinctive shape and is clearly visible from outside the car. Other types of anti-theft devices do not work on Zoomers. PROTECTOR and ZOOM are federally registered trademarks. The shape of the Protector's control panel is also registered. The Zoomer is a popular low-priced car, marketed to frugal family men. Cheap Car Care Company specializes in parts and maintenance for the Zoomer. They sell a Protector decal identical to Zoom's for one dollar. No anti-theft system comes with the decal, but customers can buy an additional decal which looks like the control panel for a Protector when viewed from outside the car's window. These decals lie to potential thieves to make them believe the car is protected by the Protector. Many frugal family men who buy Zoomers purchase decals from Cheap Car Company. They know they are not buying Protectors and that the decals are not manufactured by Zoom. Some thieves spot the new product and try to break into Zoomers with Protector decals hoping that the decals are only decoys. Sales of Protectors plummet. Zoom sues for trademark infringement. If lying to persons who see the products you buy is not a protectable interest, Zoom should win. But the court would probably accept Cheap Car Company's functionality defense. How is this different from Mastercrafters? Do we only have the right to "lie" to potential thieves? [*1416]

In another hypothetical scenario, Bob Brilliant, a graduating law student, applies for a job at a top New York law firm. He is first in his class and financially strapped by student loans. Brilliant reads a book on how to dress for success, n98 which says that interviewers will judge him partially on his appearance. The book advises him to look like the type of person firms want representing them to clients. The standard rich lawyer outfit is described as a black Brooks Brother's suit, a solid red or a yellow paisley Christian Dior tie, and a Rolex watch. Brilliant cannot afford these items, so he buys a real Christian Dior tie on sale from a discount house. He shops on the lower east side for a non-name-brand suit which looks exactly like this year's most popular Brooks Brothers model. From a street vendor, he buys a $27 replica of a Rolex, complete with Rolex trademark on the dial. Brilliant knows that Rolex did not make the watch. n99 At his interview, Brilliant does not mention his outfit. He does not tell the interviewer that he bought the tie on sale, that his suit is not a Brooks Brothers model, or that his watch is a cheap replica. Brilliant gets the job.

Did he do anything immoral? Is using a replica Rolex to impress an interviewer morally different from using a Christian Dior tie bought on sale? n100 Brilliant bought items which may be considered infringing; he bought them specifically for their function of impressing an interviewer. Brilliant could either be construed to be claiming the status of owning "real" luxury items, or of knowing what items others look for as signs of belonging to a certain status group. The fluidity of status (a person's chance to define his own) is a hallmark of the American Way of Life. [*1417] Do we want to limit it to persons who can afford luxury items at full price?

The key to opening the doctrinal door of trademark protection is the concept of dual product function. Rolex manufactures a watch which tells time as its primary function. The watch is of very high quality and lasts for years; it is beautiful and is made with expensive materials. The watch is identified by Rolex's trademark. For the watch's primary purpose of telling time, the trademark is nonfunctional. When a consumer selects a Rolex watch because she knows that locating that brand will identify a high-quality time-telling object, the trademark has performed its classic role and should be protected.

The Rolex watch, however, has a second use. Wearing a Rolex identifies a type of person. n102 Bob Brilliant, for example, wants to wear a Rolex watch to identify himself as a member of that group, or to make another statement
about his relationship to that group. n103 For this use of the watch, the trademark or trade dress is functional, and the watch's ability to keep time is nonfunctional. n104 Furthermore, the second use concept explains why we cannot dismiss the functionality of the trademark or trade dress as a protectable arbitrarily chosen detail of a functional feature n105 or a feature which is not essential to the competition's market position. n106

Products with two spheres of function in which different qualities are functional by trademark definition present three possible responses. First, we could deem "functional" (that is unprotectable through trademark) only those categories which are functional (utilitarian) for both purposes. No one supports this option. Second, we could deem "functional" (unprotectable) those details which are functional (utilitarian) for either purpose. I support this decision with certain limitations, discussed below. n107 Third, we could privilege only one use of the object; this is the courts’ choice in Vuitton and Mastercrafters’. n108 But this choice is unprincipled because we have not confronted the reasons for the choice. This article attempts to fill that gap.

Consider two recent cases: General Motors (“GM”) is threatening to sue Matchbox Toys, which sells miniature toy cars, complete with trademark insignia. GM wants Matchbox to pay royalties or cease using its trademarks. n109 Cars are strong symbols of status. Children in the United States and other consumer societies are aware of the cultural meanings of trademarks. n110 Children, in fact, are more apt to define themselves by obtaining objects of psychologically-weighted brands than are adults. n111 Adults, furthermore, give specific presents to children in an attempt to maneuver them into desired self-identifications. n112 The trademarks on toy cars are, therefore, functional. The toy would be missing an important part of its usefulness if it did not associate the child (and the gift giver, if any) with the cultural attributes claimed for the car by its manufacturer through an advertising campaign. n113

The second case is Philip Morris's suit against Sega Enterprises, the manufacturer of an arcade video game which uses the Marlboro cigarette logo. n114 Marlboro is internationally recognized as the cigarette of a specific type of person. n115 Part of the game's function is to allow its users to claim that personality as their own - without smoking Marlboro itself is a communication symbol. This statement can also be analyzed in terms of the legal doctrines of genericism and collateral use. n117

2. The Second Function - A Joint Work

Even if a design feature is functional, it is protectable under trademark if the exact formulation chosen is arbitrary. n118 This distinction assumes that an "arbitrary embellishment" chosen by the manufacturer before the product is marketed remains arbitrary after the product is marketed. Communicative meanings of products do not fit this model of product genesis.

The watch's usefulness as a timepiece is the exclusive creation of its manufacturer, however this is not true of the watch's usefulness as a cultural communication symbol. n119 Advertising is often created with the hope that such a use will develop, n120 but the public must create the mental link between the item and the advertiser's desired meaning - an obvious parallel to genericism. n121 The consumer's role in creating this status function is highlighted by the failure of certain high-quality products to achieve or retain this cachet. Gucci designs, for example, were worn by Grace Kelly, Sophia Loren, and Audrey Hepburn; "Gucci-owning was the sort of club one wanted to belong to.” n122 Today the product's quality is still high, but in terms of status, "the name of Gucci is at an all-time low.” n123 Consumer control is also shown by the number of highly-advertised products which fail. Remember the Edsel? n124 Consider the Cadillac. Will American tycoons "never give up their Cadillacs," n125 or do they see the BMW as the "ultimate driving machine" n126 and success symbol?

Manufacturers invest resources in choosing and advertising the connection between a culturally-valuable trait and their product. But the manufacturer is not the sole creator of this link - nor is he the creator of the cultural value he offers the public through his product. In many ways the manufacturer is an intentional deceiver; he ties his product to a cultural dream and purposely implies that a buyer acquires the elusive trait. n127 The marketer chooses a goal targeted by his chosen consumer group n128 and tries to link his product to that goal. n129 In this sense, he is just as much a
free-rider as the junior user of his trademark. If he ties his product to a group's cultural clout - whether they are jet
setters or neighborhood teenagers - one could argue that the group "owns" the prestige claimed by the trademark
proprietor. n130 At the very least, the public and the emulated group [*1421] are partially responsible for the resulting
status value of the product. Why then should the trademark proprietor be allowed to appropriate it as his sole property?
The emulated group and the general public should retain some proprietary right in the trademark, commensurate with
their roles in imparting status to the mark. In copyright law, congruently, any joint author can license a work. n131

The second product embodied in the watch does not exist when the manufacturer chooses the "arbitrary
embellishments" of trademark and trade dress. n132 The public did not attach meaning to the naked product, n133 it
attached meaning to the product as it was marketed - including the (perhaps originally arbitrary) mark. In the sense used
in the "arbitrary embellishment" cases, therefore, the communicatively functional mark is not arbitrary. At the time the
junior user enters the market as a cheap(er) source of the communication product, that product already includes the
senior user's mark.

If we deny others the right to sell (perhaps at a lower price) objects which fulfill this second function, we give the
original producer a monopoly on a product category (items which can be used to make a specific culturally-defined
statement about the user). If we instead require [*1422] clear disclaimers be displayed at the point of sale, the
consumer can choose to buy (at totally different prices) either an object which fulfills both functions of a Rolex, or an
object which fulfills only one function. If we believe in free enterprise and the right to spend one's money as one
chooses, why should we deny the consumer this option? n134 Denying this consumer option, in effect, creates a new
type of sumptuary law - which is a legal prohibition against structuring one's appearance in society as one wishes.

3. Trademark or Sumptuary Law?

Sumptuary laws have a long and varied history, going back at least as far as classical Rome. n135 England had
sumptuary laws from the fourteenth through sixteenth centuries. n136 These laws were based on three types of policies:
preservation of class distinctions, moral paternalism, and economic control. n137 Moral paternalism included desires to
control both the morals and the hygiene of the populace. n138 [*1423] Economic control involved limits on general
spending n139 and extreme limits on purchases of foreign goods. n140 Moral paternalism and economic control in
these senses are irrelevant to this discussion, n141 however, [*1424] preservation of class distinctions is germane.

Sumptuary laws were largely based on the belief that people had a set place in the social order, and that
movements out of that place were offensive to God.

Medieval society has been defined as "a democracy founded upon the principle of aristocracy." Each man's place was
appointed to him in a common scheme; he must, in general, be content to live in that state of life unto which it had
pleased God to call him at his birth. When the people of the Middle Ages rebelled against authority, it was against the
misuse of these fixed conditions, not with any hope of changing the conditions. Since each man's place in life was thus
fixed by social custom, it was heresy for him to attempt to rise above his class either in his manner of living or in his
dress. n142

Dress, furthermore, was an expected outward sign of one's place. n143 "Mediaeval society was far more dominated
with the idea of caste than the society with which we are familiar, and ... this caste, whether social or merely official,
was outwardly marked by a difference of costumes." n144 Not only should one dress appropriate to his station, he
should not dress in goods appropriate for his betters, and he should not dress in what could be mistaken for such goods.
n145 [*1425]

Preventing people from buying passable copies of an article which implies a relationship to a socially-defined
group is, in effect, a sumptuary law. Essentially, we are forbidding those who do not pay more than $1,000 for a watch
from appearing in public in a costume which will be perceived by others as including such a watch. This seems to imply
that some evil exists if persons use their dress to inaccurately signal that they belong to certain groups - such as the rich
lawyer's club in which Bob Brilliant coveted membership. n146

Viewed as a sumptuary law, the underlying assumptions become more obvious and more unacceptable. Our culture does not enshrine caste; the American Myth includes social mobility. Membership in private clubs which seek to exclude less privileged social groups is suspect. Furthermore, we do not forbid dress which apes inaccurate social status unrelated to the possession of money. For example, we do not bar persons from dressing in modes younger than their age, or in the style of ethnic groups to which they do not belong. Perhaps possessors of money occupy a specially privileged caste. On the other hand, we do not prevent persons from buying goods on sale, or wearing well-made fake fur, or paste diamonds. And what's more, this sumptuary law gives an economic benefit to the manufacturer of the desirable item, not to the government. n147 For a principled defense of this modern sumptuary law we would need reasons to single out the groups associated with these items for special consideration, and to assign the economic benefit of such protection to manufacturers of the object-signals chosen by the group. n148 I find such reasons lacking. [*1426]

Perhaps the closest we can come to a principled reason for such a rule is the fear that without protection of communicative trademarks, such goods will not be economically feasible to manufacture n149 and, therefore, persons who wish to buy a signalling item will be frustrated. n150 This argument is overly simplistic. Free competition means, at a minimum, that if a more efficient method of fulfilling a [*1427] function is discovered, its marketer is allowed to woo the market share of the original entrant. If Rolex, for example, cannot hold its market share because it is no longer the most efficient signalling device, it will succumb to normal competition. More basically, potential signalling devices are legion. An entire category of such devices - the education or taste symbols - would be totally immune from destruction through trademark replication.

The noted French sociologist, Pierre Bourdieu, has expanded Veblen's work by constructing the relationship between status and taste. n151 Bourdieu hypothesizes that people can be segregated by others into their appropriate social pigeonholes by either of two methods: control of money, or exhibited taste. Social groups, education, job experience, and other aspects of life history inculcate predilections for certain objects and behavior patterns. One can categorize a person by categorizing his choices. Advertising is one way we learn the "correct" categorization.

Taste and wealth are obviously interrelated, as different economic groups are taught and can afford different taste preferences. Bourdieu hypothesizes money and education as two interrelated forms of capital. Choosing items which can only be appreciated by the highly educated signals an exalted social position in the same way as does ownership of a Rolex. n152 Miller expands on this concept in his discussion of habitus, the surroundings in which people feel comfortable. Feeling at home with the same type of items signals a common group membership. n153 Note that the education needed to acquire a certain taste is not necessarily tied to money or formal education. Insiders of any group signal their membership by keeping track of the exact permutations of group style. n154 [*1428]

4. Pride and Prejudice

The viewpoint of the Vuitton and Mastercrafters' courts n155 appears to be grounded in a dislike of self-definition through objects. Various groups have criticized such identification for different reasons. Veblen's obvious distaste for the wasteful pretensions of the new rich and their conspicuous consumption n156 is an example of the dislike of the new mores by those raised in the Protestant work ethic which it displaced. n157 Marxists dislike self-definition through object consumption as they see it as another method of capitalist control of workers; the objects involved are creations of labor alienated from laborers: the production system (after removing the workers' legitimate method of self-definition through control of the products of their labor) compounds the alienation, by foisting on the wage slaves apparent self-definitions created by the capitalist class. n158 Romantics dislike consumer societies because they hypothesize the existence of a true human nature buried beneath the negative accretions of modern society. n159 [*1429]

Theoretically, if objects and advertising interact as I have described, the self-definition aspects of a product should be protected from trademark monopoly as functional, regardless of the emotional reaction of certain groups to the
existence of this object-identification link. Courts, however, are not value blind. n160 These judicial value judgments rest on misconceptions about objects' relationships to self-identification in general - my hypothesis is that the advertising-fueled extra value is one part of the modern cultural object - and on misconceptions about proper solutions to the "evil" of the consumer society itself. n161

The courts overlook three fundamental points. First, use of objects for self-definition is a normal part of each individual's ego creation. Second, self-definition through goals is a positive characteristic, not a form of immorality. Third, use of objects for public self-identification is not a modern blight; preindustrial societies share this behavior.

Ontogenesis, the child's development of a "self," is not a process usually carried on in a vacuum. n162 The importance of interaction with objects, not only with other people, is accepted by diverse [*1430] schools of psychology. For example, the cognitive psychologist Jean Piaget supports a constructivist position in which the child and the world interact. The child's world grows as she is able to understand and control the reactions of her environment. Play is an important ingredient of this self creation. n163 Melanie Klein observes self-definition from a psychoanalytic perspective, n164 viewing personality development as a cycle of interaction between subject and surrounding objects. The external forms, however, are not totally external. They are both physical objects and projections of the emerging self. n165

The courts' second value assumption is that self-definition through goal projection is a form of deceit and, therefore, immoral. n166 Even improbable goals, however, are celebrated as human necessities, almost to the point of cliche: "You got to have a dream, if you don't have a dream, how you gonna have a dream come true?" n167 "Ah, but a man's reach should exceed his grasp, Or what's a heaven for?" n168 The concept of self-fulfilled prophecies depends on the internalization of expressed expectations. For example, Marxist criticisms of consumerism depend on the possibility of one group forcing on another a false consciousness by controlling the physical objects they use. n169 This position assumes that one can become what one acts out through object choice. "The construction of myth does not imply [*1431] mere illusion. The projection of images of possible worlds and cosmologies has always been central to the development of social relations." n170 Miller, speaking as a philosophically-oriented anthropologist, sees this statement as so basic that it needs no support. Following the language of Charles Horton Cooley, our self image is largely how we think we appear to others, the "looking glass self." n171 This "misstatement" of ourselves that so disturbs some courts is the creation of a self, which is not a fake or a "lie" compared to a real physical self; the created self is the real self. n172 Consider also an analysis of gifts as offerings presenting possible identities to the recipient. n173 Neither the future nor the past are immutable. We reshape both to position ourselves comfortably in the world. The "traditional" Scottish tartan displaying a plaid belonging to a specific family is a creation of Queen Victoria's cult of the highlands; a royal whim well publicized by cloth manufacturers. n174 American colonial furniture was not born in the developing colonies. The style was created in the nineteenth century, and was used by Anglo-Saxon celebrants of the centennial to distance themselves from newer, more culturally-diverse immigrant groups. n175 [*1432]

Third, the courts' position assumes that the importance of self-defining objects is an evil created by the fall into industrial-consumer societies populated by alienated humans. This is a factual error. Objects, albeit different ones, are critically important for self-definition in non-industrial societies. n176 Consider, for example, the status of hero associated with jewelry in Beowulf. n177 Nor is this use of objects limited to Western non-industrial societies. The Kula Ring is a group of islands in the Pacific where ornamented canoes are sent to deliver symbolic shellbands in one direction and necklaces in the other. People express and obtain their status through their relationship with the canoes and the gifts they carry. n178

This third hidden assumption could be an outgrowth of the belief that "the love of money is the root of all evil." n179 Money, however, is in many ways a liberating force. Consider Georg Simmel's famous [*1433] thesis. n180 Societies without money bind their members into a complex web of detailed duties: Social relationships involve a specific individual's obligation to perform a described act for another known individual. The objects one owns are identifiable goods produced by identifiable people. Money allows obligations to be fungible. Money, therefore, creates the possibility of individual choices of labor, associates, and goods.
Next are the errors dealing with consumerism itself - the objections not to objects as identification, but to consumer objects as identification. These are errors of remedy. First, the courts by themselves simply lack power to change society from consumer into producer mode. Second, preserving greater property rights for trademark holders does not change consumers' mindsets. Hypothesize that Herbert Marcuse is right, that man of the welfare-warfare state is incapable of self-liberation because he has accepted the false-consciousness offered by the establishment, including advertising. But making the only available ROLEX one that costs several thousand dollars does not solve this problem. Such a solution does not remove the advertising which allegedly fuels the false consciousness - in fact it rewards the manufacturer of Rolex for having such advertising. If a trademark became unprotectable as soon as it developed into the communication symbol for a certain status statement, advertisers would be monetarily encouraged to use a different form of advertising.

This solution also serves to make the desired object less easily obtainable. Any parent whose child has dated an "unacceptable" person knows that familiarity is a better way to teach shortcomings. Unobtainability encourages unrealistic day dreams; obtainability and actual experience show the desired objects' shortcomings.

If the problem is to be addressed through a sumptuary law analog, should the "fine" go to the trademark holder? Policy implies that fines should be paid to a quasi-governmental organization to pay for counter-advertising. If the danger is sufficient, the best remedy may be to ban the advertisement. This remedy has been implemented in certain media for tobacco and alcohol advertisements.

If we wish to penalize "false consciousness," why should the penalty be legal? Legal penalties raise the Madisonian specter of majoritarian faction. People in the United States generally have the legal right to make fools of themselves by dressing inappropriately in social situations. But this legal right does not remove social penalties for the behavior. Perhaps Brilliant did not need a Brooks Brother's suit, Christian Dior tie, or a Rolex watch to receive a job offer, but it seems unlikely that he would have received one if he appeared in swim trunks, jeans, or a lady's ball gown for his interview. No one is legally penalized for selling him these items; why is it appropriate to use legal penalties to block one set of style choices but not another? This is the same question asked at the end of the section on sumptuary laws, since most misleading or inappropriate choices of dress are legal, why is this one different? Removing one possible outlet for "false" desires does not remove the desires; nor does it remove the myriad of other available outlets for these desires. In summary, if you wish to recreate a caste-based society (if only to more easily destroy the hidden caste-assumptions of our allegedly free society), empowering trademark holders is an illogical method.

C. Genericism

A second traditional trademark doctrine that may be used to disenfranchise a communicative mark is genericism. A generic word is one that is the "common descriptive name" of the item being purchased. Obviously, competition would be endangered if consumers did not know how to ask for a competing product. Generic words are not protectable as trademarks.

This approach, while valid, is oversimplified. Vocabulary grows with need - Eskimos have more words for snow than do Floridians. The ownership of the original name of a product by a trademark holder might create a naming problem for consumers who wish to purchase a similar product manufactured by a company other than the trademark holder for a short period, but a new word would soon be created to meet public need. The standard genericism rationale ignores this basic truth about language. I offer this clarification, not as a reason to discard genericism, but rather as proof that a more basic rationale supports this doctrine. Embedded in the refusal to protect generic "trademarks" is the assumption that speakers of the English language own it - that is, in accord with one of the traditional senses of ownership, English speakers have the "natural right" not to be excluded from use of their own property. This ownership is in common; language is in the public domain. If a manufacturer is given rights in a generic word, he is then allowed to charge the public rent for using something they already own. The public could coin a new word for each or all of the competing products, but they own the means of production of words, and,
therefore, have the right to decide what label applies to any product. n193 That a manufacturer may have coined or
publicized the word is irrelevant. n194 Furthermore, words [*1437] are more than labels for independently existing
objects. Words shape their user's vision of reality. n195 If we allow private groups to own language, we are agreeing to
a substantial transfer of power. n196 In the [*1438] case of consumer products, allowing one commercial interest to
own the single word designation for an item that could be manufactured by several companies might imply to
consumers that the trademark holder's product is the genuine article, and that all others are inferior. The monopolizer
of the product's word would have an unearned competitive edge. n197 Since this would be an implication, not a statement,
the public might not even recognize the manipulation involved. n198

A word becomes generic when it is used as the name of the category of objects to which the trademark holder's
product belongs. n199 Generic terms are nouns: aspirin, thermos, cellophane. n200 Trademarks are adjectives: Xerox
(brand) copiers, Kleenex (brand) tissues. A trademark is "lost" when it is transformed by common usage from an
adjective to a noun: "I have a bad cold, please give me a kleenex"; "Twelve people need to read the report by tomorrow,
please make xeroxes for them." n201 [*1439]

Consider the thesis advanced above that certain physical objects embody two products. n202 The Rolex watch is
both a time-telling mechanism and a statement of social position. The generic name for a time-telling mechanism worn
on the wrist is a "watch." "Watch" is a noun; the word easily fits our assumptions of the grammatical form of a generic
term unavailable for use as a trademark. What is the noun form for the second product in the object? If there is no such
noun, is there no problem of genericism? ROLEX is neither the generic term for a time-telling mechanism, nor a noun
referring to a specific social group. The second product exists; we merely lack a simple noun by which to refer to the
product. We could say: "the complex of social and economic qualities usually associated with the type of person who
wears a Rolex watch." This would state our shared understanding, but is obviously cumbersome for descriptive
purposes.

My suggestion differs from the typical genericism case because the product is not a simple object. (How else
would you name aspirins, shredded wheat, or a thermos?) But there is no principled reason why a product must be a
simple object. Consider services which are tied to service marks. ROLEX could be considered the generic mark for the
service of personal association with the social characteristics attributed to wearers of ROLEX watches. This service was
partially created by Rolex's advertising, even though Rolex's intended primary product was a physical object. There is
also no principled reason why generic nouns must be limited to simple objects which can be indicated to another by
pointing. Nouns are not so limited in natural language. Where would you point to define "corporation"? Perhaps we
only conceive of the characteristic as complex because we have no simple word for the secondary product - except for
the brand name ROLEX. Is a ROLEX-person more conceptually complex than a presidential person, corporate person,
or handicapped person?

ROLEX may be an adjective usable with other nouns (including, but not limited to, "watch") to describe that
object's relationship to this complex of characteristics; ROLEX in adjectival form may be generic. n203 One of the
aims of life-style advertising is the association of the mark with such a complex of characteristics. n204 No one should
[*1440] be surprised that success creates loss, not increase, of trademark protection. This is the classic pitfall of all
genericism cases.

Compare my suggested generic adjectives with existing generic phrases. "Blinded veterans" was held generic by
the Court of Appeals for the District of Columbia Circuit. n205 A generic phrase could be construed either as a subset
of those objects named by the noun, or as a subset of those objects described by the adjective. The phrase is the
intersection of the "noun" and "adjective" circles in a Venn diagram. Consider whether the circle for "blinded" is less
logically primary than the circle for "veteran." Furthermore, would the answer vary if the phrase used was "blindmen
and veterans association"? This phrase has two drawbacks. First, it suggests that the total contents of both circles are
included, not just the intersection. This ambiguity seems basic to English usage; we expect the intersection of two
qualities to be expressed by one adjective and one noun. If two nouns are combined, a longer construct is needed for
equivalent clarity, such as "the association of people who are both blindmen and veterans." Second, the phrase has less
expressive force - partially because it is longer, and partially because "blinded" implies a victim, someone who was made blind by an outside force, and, therefore, someone who deserves help. I would suggest that generic adjectives are a minor technical extension to existing law, and are necessitated by the basic policies of genericism.

Arguably, adjectives by definition are not capable of genericism, which is a characteristic of nouns alone. There are two responses to this argument. First, the distinction between noun and adjective is unimportant. Second, this objection merely changes the legal classification from genericism to collateral use, which results in the same outcome - loss of protection.

In order to base the legal category of genericism on the difference between nouns and adjectives, we must assume that the grammatical difference reflects a real difference. In such a construct, nouns refer to things, but adjectives merely describe them. This view of language is totally naive. Legal commentators have, moreover, cautioned against [*1441] basing legal conclusions on words in their usual setting, or even the same word in different legal settings. n206

As a simple demonstration of what the naive view entails, consider the phrase "the green square." Contrast it to "the square green." Each contains the same elements - a description of one object of sensation - but the adjective and noun positions have been reversed. "The square green" sounds odd in some way. We can easily think of more occasions on which "the green square" would be appropriate. But does this feeling mean that "green" is less noun-like or less descriptive of a res than "square"? What is probably meant is that we categorize objects by shape more commonly than we do by color. We do use "green" as a noun. If we were discussing a painter, Piet Mondrian, for example, who painted rectangles of primary color, the "square green" would be at home - an easy contrast with the "linear green" or "splotch green" of a different painter, for example Jackson Pollock. We would be considering a universe composed of colors that the painters are organizing into shapes - rather than the everyday view of the world as objects where specific references can be clarified by designating color. ("I want the green dress.")

Consider further the effect of language habits on our classification of colors into nouns. Color exists in a continuous spectrum. English has denominated one segment as corresponding to the word "green." But there are many segments of the spectrum for which we have no common English word. Paint chip displays, for example, contain color names outside most speakers' experience - and paint stores still find buyers for custom-mixed colors. n207 Is a segment of the spectrum any less a cognizable res than the segment we call "green" if we have no word for it? Not all natural languages label the same spectrum segments. Experiments, furthermore, show a direct relationship between a speaker's native language and his comfort with matching colors on different objects. n208

Philosophers, sociologists, linguists, and other academics interested in the relationship between language, thought, and objects believe that the English we know is not a "true" map of metaphysical [*1442] reality. Disenfranchising the adjective/noun distinction, as I have done, is acceptable to reputable, conflicting positions. n209

Modern linguistic skepticism is often discussed as originating with Sapir and Whorf. In their formulation:

Human beings do not live in the objective world alone, nor alone in the world of social activity as ordinarily understood, but are very much at the mercy of the particular language which has become the medium of expression for their society. It is quite an illusion to imagine that one adjusts to reality essentially without the use of language and that language is merely an incidental means of solving specific problems of communication or reflection. The fact of the matter is that the "real world" is to a large extent unconsciously built upon the language habits of the group... We see and hear and otherwise experience very largely as we do because the language habits of our community predispose certain choices of interpretation. n210

The extent to which this is true is subject to debate, but for purposes of my thesis, a relatively minor connection between language and thought's distance from reality is sufficient. To show the acceptance of the Sapir/Whorf hypothesis, at least in this limited form, consider an opponent of Whorf:
The exact role of language in thinking and logic is unknown... The frequent assertion that "if Aristotle had been a Mexican, our logic would have been different" seems to rest on dubious grounds. Serious questions may also arise in connection with the currently popular speculation about the extent to which language determines our world view. It seems reasonable to believe that the habitual patterns of the mother tongue have a strong effect upon the behavior of the individual; but it is also clear that language is not a straitjacket, and that beyond the formation of expressions dictated by linguistic tradition, new creation is constantly taking place - in poetry, in science, and in everyday usage. n211

This same anti-Whorfian noted the effect of language on color recognition, n212 and used that observation to support an assertion that "language influences the total psychological makeup of man." n213 I contend that even this anti-Whorfian would accept my limited thesis.

Within the controversy over the interrelationship of language, speaker, listener, and reality is a conflict about the function of grammar, the syntactical "bones" of language. Linguistics philosopher Noam Chomsky pioneered the concept of generative grammar and its relative, transformational grammar. Grammar is generative because it is a structural system which allows the creation and understanding of an infinite number of statements. n214 Transformational grammar discusses the different "surface" forms that could be generated from an underlying reality of some type. n215 Transformational grammar depends on a split between the form of the language as used and the world it purports to describe. Obviously, accepting a transformational grammar theory eases acceptance of the unimportance of the noun/adjective distinction. Choosing a "noun" instead of an "adjective" becomes an optional characterization. n217

Chomsky describes his opponents as believing that there is a "natural order of thoughts" that is mirrored by the order of words. Hence, the rules of sentence formation do not really belong to grammar but to some other subject in which the "order of thoughts" is studied... The same view appears in many forms and variants. To mention just one ... example, in an interesting essay devoted largely to the question of how the simultaneous and sequential array of ideas is reflected in the order of words, Diderot concludes that French is unique among languages in the degree to which the order of words corresponds to the natural order of thoughts and ideas. n218

A closer examination of Diderot's essay shows that it also supports my thesis. n219

For Diderot, languages are inaccurate to the degree that they include "inversion," or distortions of perception or thought by syntax. n220 French is the premier language for truthful communication largely because it has fewer of these inversions. n221 But while Diderot places French above other languages, he accepts Racine's observation: "Ah, how our understanding is modified by words, and how cold a copy of reality is the most vigorous utterance." n222 Diderot believes that our ability to properly analyze our perceptions is hindered by our language habits. n223 He argues that the need for succession in speech (since words are spoken one at a time) distorts the reality of perception. n224 He distinguishes between our view of reality and our speech before and after we study philosophy. n225

Diderot also expresses a view of the adjective/noun differentiation which directly supports my thesis on genericism. For Diderot, adjectives reflect the primary experience of reality, while nouns are a later mental construct:

Gradually men became accustomed to think all these names represented real things; and the sensible qualities were regarded as simple accidents, and thus the adjective was thought to be subordinate to the substantive noun, although the substantive does not really exist and the adjective is everything. If you are asked to describe an object, you answer that it is a body with a surface, impenetrable, shaped, colored, and movable. But subtract all these adjectives from your definition and what is left of that imaginary being you call a body? n226
To summarize, absence of a standard noun for describing the second product (communication of a specific complex of status characteristics) embodied in our object (a watch) should not limit our conclusion that the shortest descriptive term available for this product is generic. ROLEX, therefore, should not be protectable by trademark if an opponent could prove that it is the common descriptive term for a specific quality. n227 The test for a generic adjective, like the [*1446] test for a generic noun, should be public usage. n228 A generic adjective could be used to modify a noun other than "watch," even though it was first used with "watch." This point raises the issue of collateral use.

D. Collateral Use

Collateral use prevents a finding of infringement by classifying the junior user's behavior as exempt, rather than by downgrading the senior user's mark. Collateral use is the employment of a word which is a trademark for purposes other than describing the origin or sponsorship of a product. n229 Such collateral use may be challenged on [*1447] other grounds, such as misappropriation or dilution. n230 Limitations on collateral use raise serious First Amendment concerns. n231 One particularly controversial area is merchandising - the use of trademarks on unrelated goods (such as T-shirts) that can be used by companies for publicity. n232

The following hypothetical illustrates the relationship between publicity merchandise and communicative functions of trademarks: Vivian Vice-President is an unmarried thirty-five year-old choosing clothes for a singles' picnic. She sees herself as one of an invisible breed - educated, successful women who believe in traditional gender roles. She commands others during her workday, but wishes to find a husband who will appreciate her homemade bread, ability to listen, and willingness to compromise her career goals if they conflict with family needs. Vice-President's vision of what she is not (but is often mistaken for because of her job) is the woman targeted by Virginia Slims cigarettes' advertising. As far as she knows, no cigarette company has targeted her particular group. But she feels Coca Cola Classic represents a successful return to the old-fashioned, when the public was offered, and refused, a more up-to-date model. Vice-President believes her type of womanhood is in the same position as the original Coke before its return to the nation's shelves - something everyone wants, but no one is currently marketing. Vice-President, therefore, wears her self-identifying T-shirt to the picnic. The shirt has two red circles. One contains a Virginia Slims logo with a red bar - the international symbol for "not" or "stop" - across it. The second circle surrounds the logo of Coca Cola Classic, complete with the well known typeface. Vice-President hopes that her message will be understood. She does not care about cigarettes, soft drinks, or trademark infringement. Her actions are a variation on why people wear T-shirts or use other items marked with the manufacturer's logo.

My hypothetical is no longer hypothetical: The T-shirt with the [*1448] message has long been commonplace. n233 Recently, however, a commercial clothier introduced the "Trademarks" collection. Asking "Which one fits you best?," the advertisement suggested Johnson's Baby Powder for the caring and Campbell's Home Style Chicken Noodle Soup for the warm. n234 Such communicative use of trademark symbols should be considered when framing legal limitations on collateral use generally, and in particular, in merchandising.

II. The Trademark Counterfeiting Act of 1984

A. The Missing Party

The discussion above asserts that a share in "trademark properties" belongs to the public. The "evil" produced by ignoring the public's trademark entitlement is fleshed out in current interpretations of the Trademark Counterfeiting Act of 1984 (the "Act"). n235 Four circuits have held that a spurious mark that is likely to confuse a casual viewer of the item bearing it should be read in the Act's definition of a counterfeit trademark. n236 Since the Act incorporates the Lanham Act standard for "likelihood of confusion," these circuits have extended the trademark proprietors' rights in all marks, registered or not, n237 in both civil and criminal actions. n238 [*1449] The circuits' opinions are seriously flawed, revealing a view of the controversy as a two-sided fight between
commercial entities. In one corner is a legitimate business that has invested heavily in a quality product and a strong mark. In the other corner, there is a fly-by-night operator seeking to reap where others have sown - and incidentally undermine the American economy. The courts find it easy to hold against such unsympathetic defendants. But in these cases, the courts do not consider the unnamed, but quite real, third party - the public, which holds public domain rights in communication.

The courts have not ignored the public through malice. Our adversarial system expects that courts will sift arguments presented by competing parties. But the public - unlike Rolex did not file an amicus brief. None of the appellate briefs in these cases mentioned public domain rights; none suggested that life-style advertising produces legal consequences - including those discussed above in terms of the doctrines of functionality, genericism, or collateral use. If this argument had been presented to the courts and the interests of the public had been seriously considered, the outcome might have been different.

But all the circuits exhibit flawed reasoning: they misrepresent the legislative history, by presenting material incomplete almost to the point of error; they cite unimpressive cases for support. These decisions should be overruled even if my main thesis is incorrect.

B. The Terms of the Act

The Trademark Counterfeiting Act of 1984 criminalized "intentionally trafficking or attempting to traffic in goods or services and knowingly using a counterfeit mark on or in connection with such goods or services." As defined in the Act:

For the purposes of this section -

(1) the term "counterfeit mark" means -

(A) a spurious mark -

(i) that is used in connection with trafficking in goods or services;

(ii) that is identical with, or substantially indistinguishable from, a mark registered for those goods or services on the principal register in the United States Patent and Trademark Office and in use, whether or not the defendant knew such mark was so registered; and

(iii) the use of which is likely to cause confusion, to cause mistake, or to deceive.

Confusion lurks in the phrase "likely to cause confusion, to cause mistake, or to deceive." Unanswered are questions of whom, when, and where. The four circuits that have addressed this issue have decided that the requisite confusion is not limited to potential customers at the point and time of sale or advertising. To paraphrase the circuits, they agree that the Act criminalizes confusing any members of the general public who may encounter goods bearing spurious marks, even if the actual purchaser was not confused at the time of the transaction.

C. United States v. Torkington

In the first decision, United States v. Torkington, the Eleventh Circuit reversed the lower court's dismissal of charges against John Torkington, who sold watches bearing the Rolex "crown" trademark, and that were virtually indistinguishable from Rolex's own products. Torkington sold replica "Rolex" watches for approximately $27 each in his flea market booth; authentic Rolex watches sell for more than one thousand dollars. The sale covered by the indictment was to a Rolex undercover agent, Edward Little, who knew the watch was a fake. Torkington did not claim
the watches were genuine Rolex products. To the contrary, when asked about a warranty, he stated that the only coverage was his own willingness to make needed repairs. n248

The district court dismissed the indictment on grounds that such a sale did not meet the definition of "confusion" under the Act. First, a direct purchaser who bought a watch for $27 was unlikely to believe he was buying a Rolex. Second, "the likely confusion of members of the public who encounter the allegedly counterfeit watches in a post-sale context is irrelevant to the ... inquiry." n249 The Eleventh Circuit disagreed with both conclusions. n250

The first disagreement is uninteresting from a legal standpoint. [*1452] Does the likelihood of such confusion by the purchaser exist to the minimal extent needed to present the question to a finder of fact? Even if the court so held, other potential defendants could protect themselves by refining their point-of-sale techniques. For example, they could insert disclaimers on counter signs, on the watch packages, or in their sales talks.

But the second disagreement is legally explosive - both for its conclusion and for potential extensions of the circuit court's reasoning. The Eleventh Circuit's decision was based on several factors. First, plain meaning: The statute does not specifically restrict "its scope to the use of marks that would be likely to cause direct purchasers of the goods to be confused, mistaken or deceived." n251 This is a weak point; the text of the Act also does not expand its scope. This point is further weakened by the general rule that criminal statutes must be construed narrowly. n252 The court bolsters this "plain meaning" argument with a discussion of legislative history. The Act borrows the current language of the Lanham Act - "Likely to cause confusion, or to cause mistake, or to deceive" n253 - rather than its more restrictive former incarnation, "likely to cause confusion, or mistake or to deceive purchasers as to the source of origin of such goods or services." n254 To decide whether this change matters, we must look more closely at the legislative history and court interpretation of the change in the Lanham Act itself. The court, therefore, does not really make a pure "plain meaning" argument.

Second, the court claims that the cases decided under Lanham Act section 1114(1) use "confusion" to include that of "potential purchasers." n255 This argument could be read as emanating either from plain meaning or from precedent. A court that construes statutory provisions by reference to use of the same language in related statutes n256 would reach this point directly, by stating that since the Act amended the Lanham Act, creating the new crime of trafficking in [*1453] counterfeit trademarks, n257 the relevant definition of "confusion" would be the one created for the Lanham Act. To evaluate this argument, we must look at the relevant case law. n258

Third, the court relies on the goals of the Act as stated in its legislative history - to prevent United States businesses from losing sales to manufacturers of less expensive, and largely imported, imitations. n259 To evaluate this statement, we must check the goals of the Act for content as well as for competing goals that may imply a limitation on the protection intended under this goal.

D. Further Court Interpretation of the Act

The circuit cases following Torkington merely accept and elaborate upon the Eleventh Circuit's reasoning. n260 In United States v. Gantos, the Eighth Circuit found sufficient likelihood of confusion could exist, even if the accused seller had informed his customer directly that the item was not genuine, n261 since the Act was intended to prevent dilution of the marks as well as protect consumers. n262 [*1454]

In McEvoy v. United States. n263 the Eleventh Circuit reiterated its original position and further refused the defendant's contention that the statute is unconstitutionally vague for failure to warn potential violators of the criminal consequences of their actions. n264

In United States v. Yamin, n265 the Fifth Circuit relied on the Eleventh Circuit's explication of "confusion," n266 and allowed a jury instruction which stated that:

The prosecution is not required to prove that the defendant ever had an intent to deceive or defraud anyone. The
Government simply has to show that the use of the spurious trademark is likely in the future to cause either confusion, mistake, or deception of the public in general... The public in general includes persons who have no intent to purchase such as the recipient of a gift or the guest in the house who simply views goods as well as purchasers and potential purchasers. n267

The Second Circuit in United States v. Hon n268 stated its agreement with cases in the other circuits and followed the same general logic as Torkington. While discussing the different showings needed to prove confusion in disparate and identical merchandise cases, the court held "that the "likely to confuse" standard of 18 U.S.C. 2320 is not limited to purchasers or potential purchasers," and, therefore, Judge Sweet's jury instruction regarding confusion by non-purchasers was correct. n269 The court based its definition of confusion for purposes of the Act in part on its earlier definitions of confusion for the Lanham Act, n270 [*1455] claiming that Congress "no doubt ... wished to incorporate the Lanham Act's confusion requirement into 18 U.S.C. 2320 and did so." n271 As I have noted above, n272 these statements are dangerous precedents, as they might lead future courts to rule that the Lanham Act has been violated when the general public is confused, because the Act does so, and because the Lanham Act and the Act share a definition of "confusion." Such a holding would deny the public its rights in the marks, despite the existing trademark doctrines of functionality, genericism, and collateral use.

E. Errors in the Circuits' Arguments

1. Earlier Cases of "Confusion" Cited by the Circuits

Central to these circuit decisions is the assertion that "confusion" for Lanham Act purposes includes confusion of noncustomers in nonpurchasing and nonadvertising situations. n273 The five circuit cases I have described cite a total of sixteen earlier cases for the proposition that "confusion" for purposes of the Lanham Act is not limited to sales customers.

A general statement that the Lanham Act protects potential customers is misleading. Linguistically, "potential customer" could mean anyone anywhere on a probability-of-later-purchase continuum, from a person standing at a sales counter handing an item to a cashier who has not yet rung up the sale, to a person as yet unborn who might conceivably develop a need for the product. Any statement that the Lanham Act protects "potential purchasers" from "confusion" must be checked by the facts of an individual case in order to determine its placement on that continuum. n274 [*1456]

The earliest of these cites is G.H. Mumm Champagne v. Eastern [*1457] Wine. n275 While Judge Learned Hand protected the "property" rights held by champagne vintners in their trademarks, he hypothesized an unscrupulous restaurateur's serving mismarked wine to a diner after the diner's palate was blurred by earlier indulgence. This situation is not identical to ours. The diner is a customer in a sales context. A hypothetical that would parallel our case (which the judge did not reach) would concern a diner's arrangement with a restaurateur to have sparkling water poured into bottles that formerly contained wine, and to be charged for water accordingly. The customer's purpose - to make his friends believe he is imbibing with them - would thus be served. His friends, of course, would get, and would be charged for, their wine. This deception would not be considered an immoral act if it were performed by a recovering alcoholic entertaining persons unaware of his disease. The customer would not be confused - he would be attempting to confuse his non-customer guests. n276 In the Mumm case, Judge Hand named the "substance" of a cause of action for trademark infringement or for unfair competition as "the diversion of prospective buyers by misleading representation." n277

Mastercrafters Clock and Radio Co. v. Vacheron & Constantin-Le Coultre Watches, n278 however, is almost directly on point. Mastercrafters, an American company, began production in 1952 of the Model 308 clock which was a lesser-quality copy of the Swiss Atmos [*1458] distributed by Vacheron. n279 Mastercrafters' direct customers - retail stores - certainly knew which clocks they had purchased for resale. The trial court held that there had been no unfair
competition, because, inter alia, no evidence had been introduced showing that the public was concerned with the original source of the clock, and Model 308 was clearly marked and advertised as a Mastercrafters product. This judgement, however, was reversed by the Second Circuit, which explained that the

Plaintiff copied the design of the Atmos clock because plaintiff intended to, and did, attract purchasers who wanted a "luxury design" clock. This goes to show at least that some customers would buy plaintiff's cheaper clock for the purpose of acquiring the prestige gained by displaying what many visitors at the customers' homes would regard as a prestigious article. Plaintiff's wrong thus consisted of the fact that such a visitor would be likely to assume that the clock was an Atmos clock. n280

I must note here that this case does not discuss the Lanham Act itself, but merely restates the common law of unfair competition on which the statute is based. Furthermore, the briefs on appeal relied partly on New York State's anti-dilution statute n281 - a doctrine that has twice failed to pass into federal law. n282 Therefore, to the extent that the Mastercrafters court's conclusion was influenced by this aspect of New York law, it is inappropriate authority for deciding Lanham Act issues.

Syntex Laboratories, Inc. v. Norwich Pharmacal Co. n283 deals with prescription drugs - a class of merchandise with a "split" consumer. The prescribing physician chooses the product, the pharmacist fills the physician's prescription, and the patient pays for and uses the drug. The results of such drug cases should not, therefore, be carelessly generalized into other product sales arenas. Confusion of any of the three actors is, in effect, confusion of the consumer. In Syntex, a manufacturer was found to infringe the Lanham Act by marketing a product whose name, "Vagistrol," was similar to the federally-registered "Vagitrol." Both products were treatments for vaginitis, but [1459] one was potentially harmful to a patient who needed the other. n284 The Syntex court reasoned that the amendment of the Lanham Act n285 showed a "clear purpose to extend the coverage of the Lanham Act by outlawing the use of trademarks which are likely to cause confusion, mistake, or deception of any kind, not merely of purchasers nor simply as to source of origin." n286 But the court dealt solely with the physician's and pharmacist's confusion - and though they are part of the "consumer," they are not the intended "purchaser." Even if no confusion of source is involved, since none of them care who manufactures the necessary drug, there is confusion of product. The Syntex case is not parallel to our hypothetical. The parallel would be to a patient who knowingly buys a generic drug packaged in a familiarly-labelled bottle to impress a chance viewer of her medicine cabinet. n287

A.T. Cross Co. v. Jonathan Bradley Pens, Inc. n288 concerns sales of pens and mechanical pencils to customers who bought large quantities for gifts. Cross products, manufactured by A.T. Cross Co., are stamped CROSS, which is listed on the principal register of the United States Patent and Trademark Office, and has gained secondary meaning. n289 Bradley sold inexpensive similar items in boxes marked "LaCrosse" and "La Crosse by Bradley." Bradley's direct mail advertising stated: "The new La Crosse set. Sounds and looks like a more expensive set." n290 The Second Circuit disapproved of Bradley's obvious intent to motivate bulk purchasers to buy in the hope that "their donees would think they were receiving Cross pens." n291 Here, confusion of non-customer donees was sufficient to support liability. These were nonpurchaser users, not observers, and the merchandise was not a replica, although it was an obvious replacement for the original, meeting the Act's test for the type of goods for which the mark is [*1460] registered. n292 The court barred use of a possibly confusing mark on the same type of item - namely, pens and mechanical pencils sold in sets. This case was decided when comparison advertising was just gaining respectability. n293

Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons n294 again concerns confusion of similar products. The United States firm of Steinway disputed use of the GROTRIAN-STEINWEG trademark on its competitor's German pianos of similar quality and price n295 (the Grotrian-Steinweg is slightly less costly), n296 that were imported into the United States. Steinweg was the original surname of the German brothers who founded Steinway; Grotrian, Helfferich et al. was the successor-in-interest of another firm founded by the same family.

This case is clearly distinguishable from that of the $27 replica Rolex viewed on its owner's wrist. The possible confusion that motivated the Grotrian court's finding for Steinway was the confusion of persons buying pianos: "The
harm to Steinway ... is the likelihood that a consumer, hearing the "Grotrian-Steinweg' name and thinking it had some connection with 'Steinway,' would consider it on that basis." n297 Furthermore, evidence was accepted that the defendant attempted to confuse actual purchasers at the time of sale. n298 This case, therefore, does not parallel our hypothetical. Such a case would involve a finding of infringement because non-musical visitors who saw a Grotrian-Steinweg piano in another's home would think it was produced by Steinway.

Rolls-Royce Motors Ltd. v. A & A Fiberglass, Inc. n299 is more on point. Rolls-Royce sued the manufacturer of the "Elegant Beetle" [*1461] kit, which contained parts to modify the hood and radiator of a Volkswagen Beetle to look like the protected Rolls-Royce designs for nonfunctional parts. n300 The court found the Rolls-Royce "Classic Grill" and "Flying Lady" hood ornament to be valid trademarks showing sponsorship or manufacture by Rolls-Royce Motors. The grill-and-hood ornament kits produced by the defendant were confusingly similar, and, therefore, infringing.

The element missing from this decision is a clear statement of who is being deceived and at what point in time. The court recognized that the kits were not likely to cause confusion when sold in their manufacturer's packaging, n301 but it asserted that a purchaser may distinguish the uninstalled parts from actual Rolls-Royce components does not preclude confusion of the public upon seeing the kit installed. It cannot be said that the deception requirement in the statutes is so narrow as to permit this type of confusion resulting when the kit is put to its intended use. n302

The remaining question is whether a person who sees a VW bug with an apparent Rolls-Royce grill and hood ornament on the bug's front trunk would think that the car was made or sponsored by Rolls-Royce. The opinion does not supply a picture of an altered bug, but I rather doubt that such alterations would do so, and no evidence that it has done so was mentioned. n303 It is more likely that a viewer would see this as a joke on status car buyers - a reaction similar to that expected by the court in Girl Scouts of the United States of America v. Personality Posters Mfg. Co. n304 : here, in response to the use of the Girl Scout logo on a poster of a pregnant girl in Girl Scout uniform with the motto "Be Prepared," n305 the court said "the reputation of the [*1462] plaintiff is so secure against the wry assault of the defendant that no such damage has been demonstrated." n306 Furthermore, the A & A Fiberglass court only cites one case for its proposition that "confusion need not always be that of a potential purchaser but can exist where "the defendant duplicated the protected trademarks and sold them to the public knowing that the public would identify them as being the plaintiff's trademarks.' " n307 Its authority, Boston Professional Hockey Ass'n v. Dallas Cap & Emblem Mfg. Co. n308 has been severely criticized as overextending trademark protection. n309 The opinion itself states that it is a change in the balance of equities. n310 Furthermore, the Rolls-Royce court has taken the quote out of context.

The allegedly infringing goods in Boston Professional Hockey were clothing patches bearing team emblems. The lower court allowed continued marketing of the items if the defendant sold them with a disclaimer, but the appellate court granted an injunction against the sale itself. The Rolls-Royce court quoted from the following passage:

The fifth element of a cause of action for mark infringement under 15 U.S.C.A. 1114 is that the infringing use is likely to cause confusion, or to cause mistake or to deceive. The district court decided that there was no likelihood of confusion because the usual purchaser, a sports fan in his local sporting goods store, would not be likely to think that defendant's emblems were manufactured by or had some connection with plaintiffs the teams... The district court overlooked the fact that the act was amended to eliminate the source of origin as being the only focal point of confusion. The confusion question here is conceptually difficult. It can be said [*1463] that the public buyer knew that the emblems portrayed the teams' symbols. Thus, it can be argued, the buyer is not confused or deceived. This argument misplaces the purpose of the confusion requirement. The confusion or deceit requirement is met by the fact that the defendant duplicated the protected trademarks and sold them to the public knowing that the public would identify them as being the teams' trademarks. The certain knowledge of the buyer that the source and origin of the trademark symbols were in plaintiffs satisfies the requirement of the act. The argument that confusion must be as to the source of the
manufacture of the emblem itself is unpersuasive, where the trademark, originated by the team, is the triggering mechanism for the sale of the emblem. n311

This passage in Boston Professional Hockey expands protection to include confusion by purchasers as to sponsorship of the emblem, as opposed to protection limited to confusion about manufacturers. Seen in its entirety, the "public" whose confusion was considered in Boston Professional Hockey, consisted solely of the purchasers of the emblems, and did not include their friends who would see the patches on their jackets. The only contrary argument is based on the circuits' expansion of the remedy to allow an injunction against sale, rather than impose adding a disclaimer as a condition of sale. If this was the court's rationale, it did not clearly state so. Alternatively, the court may have expanded the remedy out of simple ire against such obvious free-riding, or from a belief that customers ignore disclaimers. Whatever the Fifth Circuit might have meant when it decided Boston Professional Hockey, by 1977 it no longer interpreted that case to create a broad "property" right in a mark. Instead, the circuit court stated that the case was one of confusion of sponsorship. n312

Amp Inc. v. Foy n313 concerns confusion of the source of services in fields related to merchandise manufactured by the senior user. The senior user had registered AMP as trademark for its electrical parts; the junior used AMP as a tradename for his services as an electrical contractor. The broadest statement of the confusion standard in this opinion is: "The test is not only the danger that defendant's use of the term "Amp" will confuse plaintiff's customers, but the likelihood of danger that such use will confuse the public in general, including plaintiff's customers, defendant's customers and other members of the public." n314 The appellate opinion in Foy does not mention any attempt by the defendant to inform his customers that he was not related to the plaintiff; the district court's analysis was flawed, according to the Fourth Circuit, by its failure to consider this obvious possibility of passing off. n315 Furthermore, the appellate opinion chides the court below for undervaluation of evidence of actual confusion. n316 The circuit did not state that even if none of plaintiff's or defendant's customers were confused, confusion by a visitor to one of their homes was important. While this case has language discussing confusion of the "general public," a valid reading of the case would limit it to inclusion of both plaintiff's and defendant's probable customers. Since the case discusses merchandise and services widely used by all sectors of the population, the distinction between "members of the public" and fairly probable "potential customers" is hard to draw. n317 Finally, as use of the product is largely invisible - visitors do not see the name on your junction box - the "general public" exposed to the confusion must be exposed at an advertising or possible-sales contact.

T & T Mfg. v. A.T. Cross Co. n318 adds nothing to the circuits' argument. This case involves use by several rival mechanical pencil manufacturers of a tip whose shape and contrasting color were claimed as a mark by A.T. Cross. Following extensive discussion as to whether the pencils as displayed to interested potential purchasers would be likely to cause confusion, and the weight to be placed on Bradley markings on the junior user's packages, the court found infringement. First the court discounted the clarifying nature of the packaging, because the viewing buyer might easily decide that the junior user "is licensed to sell Cross pens and pencils." n319 The court concluded that if immediately potential customers would "simply view the item rather than the outer trappings, the clue to the true identity remains hardly visible." n320 Only at this point did the court state in dicta that "the fact that the actual purchaser may become aware of the source does not preclude a finding of infringement ... if the public generally, and users and donees more specifically, would remain confused by the similarity of the products." n321 Cited as support for this proposition were Rolls-Royce Motors Ltd. v. A & A Fiberglass Inc., A.T. Cross Co. v. Jonathan Bradley Pens, Inc., and Syntex Laboratories Inc. v. Norwich Pharmacal Co., discussed above. n322

Levi Strauss & Co. v. Blue Bell, Inc. n323 deals with the ubiquitous blue jeans, a product for which the public-at-large are all reasonably "potential purchasers." Levi Strauss had used a folded ribbon sewn into the back seam of its rear patch pocket ("pocket tab") since 1936. Several pocket tab variations are federally registered trademarks. Blue Bell, the maker of Wrangler brand jeans, wanted to use a similarly-shaped pocket tab on a different seam of the same pocket. The court barred this use despite the prominent display of the "Wrangler" logo on the pants as packaged for sale. The court reasoned that the record did not show that "the mere presence of Wrangler's word mark avoids a
likelihood of confusion.” n324 This is the same argument used by the Cross court; despite the package marking, there was a factual question as to the label's effect on the viewer. The viewer could, for example, consider Wrangler to be related to Levi Strauss. Only as a secondary reason did the Strauss court state that:

Wrangler focuses upon the condition of its pants when sold and limits its argument to "point of sale" circumstances. However, billboards and other point of sale materials are removed by the purchaser and have no confusion-obviating effect when the pants are worn. Wrangler's use of its projecting label is likely to cause confusion among prospective purchasers who carry even an imperfect recollection of Strauss's mark and who observe Wrangler's projecting label after the point of sale. It is axiomatic in trademark law that "side-by-side" comparison is not the test. n325

The court might not have considered the second point sufficient to support a finding of likelihood of confusion if Wrangler had shown that its packaging did not confuse "point of sale" viewers, or if the disputed item were not one purchased by great numbers of the public. [*1466] The court itself cautions against any extension of its holding in this case by refusing to grant a "general definition of Strauss's trademark rights under various hypothetical circumstances." n326

In Koppers Co. v. Krupp-Koppers GmbH, n327 the term "public" was used less generally. The court spent several pages supporting the general propositions that the 1962 amendment of the Lanham Act, which changed section 1114(1), n328 "shows congressional intent that the persons whose confusion is relevant should not be restricted to purchasers," and that earlier cases had already considered non-purchasers. n329 But the Lanham Act dispute between the parties here was use of the surname Koppers (by the defendant, in the compound form, Krupp-Koppers) for certain industrial design services which are not of use to most members of the general public. The defendant wished to limit the court's consideration to the one specific service which had triggered the law suit - the design of coal-gasification plants. The court's discussion was prompted by its understanding that

the answer given depends on the question asked. If the Court views these factors with a rather restricted scope and looks only to coal gasification plants costing a billion dollars and coal gasification processes costing hundreds of millions of dollars and those who would purchase these products and services, there is a possibility of evaluating these factors and finding no likelihood of confusion. However, if the Court views the entire range of services offered by the parties, and takes a less restrictive view of the market and its workings, there is a greater possibility that an evaluation of the same factors would lead to a finding of a likelihood of [*1467] confusion. Given the facts and circumstances present in the matter sub judice, this Court finds it appropriate to adopt a less restrictive view. n330

The actual confusion pointed to by the plaintiff involved misstatements in the trade journals Energy News and Chemical Week n331 - publications not normally available on neighborhood newsstands.

The court makes two statements about the general public involved in this case. First, "plaintiff is listed on the New York Stock Exchange; plaintiff directs advertising to the public at large. n332 Second, the court found "a reasonable probability ... that investors in the plaintiff, the market to which plaintiff's advertising is directed, potential customers of the plaintiff, and others will be confused." n333 These statements are immediately followed by a discussion of the name Krupps and negative associations it may engender of World War II and the Nazi regime, which association the court reasons could seriously hurt the plaintiff's business, including its ability to obtain financing. This negative association is increased by substantial Iranian ownership of the defendant. n334 This opinion is not a final judgement of infringement; it merely grants a preliminary injunction. Despite the court's separate treatment of the issue of dilution, n335 the court here seemed to weigh the possibility of tarnishment as an equitable factor favoring temporary relief for the plaintiff. The negative connotations of association with the German defendant company were sufficiently serious to influence the second showing needed for a preliminary injunction: likelihood of irreparable injury to the moving party if it must wait for final judgement for all relief. n336 In this court's reasoning, the general public seems to be investors, movers in the finance community, and large industrial firms - judicial persons who are likely to have or be offered a business relationship with the plaintiff.
John H. Harland Co. v. Clarke Checks, Inc. n337 is cited by the Torkington court for a lower level of support than are the other cases. n338 Harland, as claimed in the parenthetical of its cite in Torkington, [*1468] supports the test for infringement as likelihood of confusion. But Harland contradicts Torkington's main point that the likelihood of confusion covers "the purchasing public," a larger class than "direct purchasers." n339 The Harland court adopts what it characterizes as "the rule courts usually apply" - that infringement involves "a likelihood of confusion in the minds of an appreciable number of "reasonably prudent buyers.' " n340 The "reasonably prudent buyers' it considers in this case are the ultimate buyers of checkbooks (checking account customers), bank employees who help them make their selections, and bank employees who decide which company's check catalog will be shown to the bank's depositors. No wide-ranging general public is involved. The court did not consider the possible confusion of another party who glimpses his friend's checks as the friend fills out a stub.

Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co. n341 does, however, support the relevance of the post-sale context to Lanham Act confusion analysis. Like Cross, n342 the Lois Sportswear court discounts the junior user's attempts to distinguish its products by labelling them for two reasons: the possibility that customers will conclude that one manufacturer is sponsored by or owned by the other, and labels' inabilities to dispel confusion in post-sales contexts. n343 Unlike Bradley, the court in Lois Sportswear states unequivocally that "it is equally clear that post-sale confusion as to source is actionable under the Lanham Act." n344 The court cites Steinway n345 to show the relevance of [*1469] pre-purchase confusion, and Syntex n346 for the relevance of post-sales confusion. As discussed above, these cases do not provide very strong support. More troubling is the court's reliance on Levi Strauss & Co. v. Blue Bell, Inc. n347 The general comments about jeans which were made in reference to Levi Strauss can also be made here. n348 Note, however, that the Lois Sportswear court's analysis offers an easy method for limiting its holding. The court begins by characterizing as a "threshold matter" the type of trademark involved, because the type of trademark determines its proper degree of protection. n349 The court concludes that the mark at issue - the stitching pattern on the back pocket of Levi jeans - deserves the highest possible level of protection because it is registered, incontestible, and fanciful, n350 encouraging future arguments that the relevance of non-buyer non-point-of-sale confusion is limited to such marks.

The last three cases relied on by the circuits to show Lanham Act relevance of more broadly-based confusion are not independent authority. All three are related to the Counterfeit Trademark Act of 1984. Rolex Watch U.S.A., Inc. v. Canner n351 is the civil case involving the same transactions as United States v. Torkington, under the amendment of the Lanham Act created by the same legislation. United States v. Infurnari n352 and United States v. Gonzalez n353 are criminal prosecutions under the Act. Relying on any of these to show that the Act includes non-customer or non-point-of-sale confusion because the Lanham Act did so would clearly be circular reasoning. None of these cases, furthermore, cites any new case support for the basic proposition. n354 [*1470]

In summary, the cases cited by the circuits allow a reading of section 1114(1) of the Lanham Act to include as relevant the likelihood of confusing non-customers beyond the point of sale or advertising, though they certainly do not compel such a reading. The limited number of cases that four interested circuits could find to support this proposition, and the relative weakness of the support they supply, by itself implies that the position they advance is not settled law. The circuits are extending existing law by slightly refocusing prior holdings. But though this is common practice, I believe that refocusing should be eliminated or substantially narrowed in these particular cases in order to prevent erosion of the public domain interests not addressed by the litigants or courts involved.

2. Opposing Cases

The circuits' weak case law argument is further undermined by opposing cases. A complete account of cases undermining the circuits' reading of "likelihood of confusion" is beyond the scope of this Article. Such cases, however, clearly exist. Consider, for example, the basic standards for likelihood of confusion under the Lanham Act, and the cases giving disclaimer as a remedy - judicial handling of both defining and remedying the wrong.

a. The Confusion Standard
The usual benchmark for finding sufficient likelihood of confusion, and therefore infringement, under the Lanham Act is "the reasonable prudent buyer." Some courts have specifically stated that "random sampling of the public at large" is irrelevant. The Hon court reiterated those factors used in the Second Circuit to test for likelihood of confusion. They are those factors articulated in Polaroid: strength of the prior owner's mark, similarity between the marks, similarity of the products, probability that the senior user will bridge the gap between the products, incidents of actual confusion, relative quality of the defendant's and plaintiff's products, defendant's intent, and sophistication of the buyers. The last, at a minimum, implies a market situation. The Hon court stated, however, that these factors are only relevant if the products are different, even though the Second Circuit had recently held these factors relevant for both competing and noncompeting goods. This change seems driven by a policy statement: "Because the purposes of the trademark laws include protection of the integrity of the mark itself, as well as consumer fraud, we hold that the 'likely to confuse' standard of 18 U.S.C. 2320 is not limited to purchasers or potential purchasers." As discussed above, I believe this is an oversimplification of the policies of the Lanham Act and the Trademark Counterfeiting Act which protect the integrity of a mark, but only to the extent limited by countervailing concerns. The Second Circuit does not address the implications of Congress's recent consideration and refusal of a federal dilution statute.

When deciding on likelihood of confusion under the Lanham Act, other circuits consider several additional factors that make sense only if the courts believe in the centrality of the purchase scenario. In the language of the First Circuit, basic considerations include the "relationship between the parties' channels of trade ... the relationship between the parties' advertising ... and the classes of prospective purchasers." The Fourth Circuit considers the "similarity of the facilities the two parties use in their businesses and the similarity of the advertising used by the two parties." "Identity of retail outlets and purchasers, identity of advertising media and the degree of care exercised by purchasers" are considered by the Fifth Circuit. The Sixth Circuit lists "marketing channels used." Identity of retail outlets, advertising media, and purchasers are also considered by the Seventh Circuit. The Ninth Circuit looks at marketing channels. The Eleventh Circuit considers similarity of retail outlets, customers, and advertising media. To summarize, the courts' basic standards for deciding Lanham Act "likelihood of confusion" imply a purchase scenario.

Even more striking is the Federal Circuit's recent discussion of "relevant persons" for considering "likelihood of confusion" in a registration case. The Federal Circuit has special expertise in this area of law because it hears all appeals from the Trademark Trial and Appeal Board ("TTAB"). The TTAB had refused to register Electronic Design's mark for power supplies and batteries, which was opposed by a firm holding an Electronic Design service mark for computer services. Both parties sold to firms in the medical, automotive, merchandising, and communications fields, and their customer lists overlapped. However, the Federal Circuit found that in this fact situation the persons who might be confused were irrelevant.

A trademark may be refused registration only if it consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

The factors considered for this decision were similar to those used in infringement cases: similarity of the marks, similarity of the products, similarity of trade channels, usual conditions of sale, fame of prior mark, existence of similar marks on similar goods, actual confusion, variety of goods on which the mark is used, market interface between applicant and owner of the prior mark, applicant's right to exclude others from use of the mark on its goods, extent of potential confusion, and any other factor probative of effect of actual use.

This standard had previously referred to confusion of "purchasers." The Federal Circuit opined that the congressional intent in this amendment was to clarify that potential purchasers should also be considered.
We do not construe this deletion to suggest, much less compel, that purchaser confusion is no longer the primary focus of the inquiry. Instead, we believe that, at least in the case of goods and services that are sold, the inquiry generally will turn on whether actual or potential "purchasers" are confused. n377

[*1474] The Circuit refused to consider as one unit all persons who were part of a corporation or other institutional purchaser - only persons who affected the decision to purchase were relevant to the confusion analysis. n378 While non-purchasers who influence purchasers are relevant, the court stated such influence had to be probable, not merely possible. n379

The Federal Circuit agreed that the Lanham Act was partially intended to protect commercial entities from unfair competition. It considered that a relevant factor, however, solely in determining standing. n380

The opinion is opaque on when dilution is relevant outside decisions on standing: "Although consideration of damage to a prior mark holder's business reputation might be a useful test in some cases, it certainly cannot supplant the statutory test of "likely ... to cause confusion, or to cause mistake, or to deceive.' " n381

b. Disclaimers

The "first in the field ... may put later comers to the trouble of taking such reasonable precautions as are commercially practicable to prevent their lawful names and advertisements from deceitfully diverting the plaintiff's custom." n382 The limited injunction - which allows potentially confusing uses of protected material if the second comers warn viewers - implies that the judicially cognizable harm to the plaintiff is sufficiently limited when likely beholders of the disclaimer are not confused. If a disclaimer is not visible when the defendant's product is in use, the court that ordered the injunction is clearly holding that likely confusion of casual viewers is irrelevant. Relevant to my argument is not the disclaimers' contents, but their audience. n383 [*1475]

The Federal Circuit has held that a correct designation of origin on a removable label and on packaging materials is sufficient to destroy Lanham Act culpability for sales of a product whose shape would otherwise infringe the trade dress of a directly competing product. n384

The Eighth Circuit agreed with the Federal Circuit regarding products specifically designed and marketed to be lower-priced reproductions of expensive ones. Calvin Klein Cosmetics created and continues to manufacture OBSESSION; Parfums de Coeur, Ltd. created an imitation it called CONFESS. The District Court denied a preliminary injunction, allowing Parfums de Coeur to sell an allegedly infringing perfume, provided a disclaimer sticker was "securely and prominently affixed to the container body." n385 The circuit affirmed, and did not require that the sticker be nonremovable. n386 A removable sticker assures the purchaser she is buying an imitation, but allows the purchaser to confuse the recipient of a gift or the visitor to her home as to the perfume's cost and origin.

A related issue is the absence of a legal duty to attach disclaimers to used merchandise in order to protect the original manufacturer's reputation. Used merchandise is consistently sold without removing the trademark: "We would not suppose that one could be enjoined from selling a car whose valves had been reground and whose piston rings had been replaced unless he removed the name Ford or Chevrolet." n387 Moreover, the consumer has no duty to inform his neighbors that he bought his "new" car used or on sale. n388

To summarize, some remedies imply that the Lanham Act tries [*1476] to eliminate "likelihood of confusion" in circumstances of purchase, not use.

3. Legislative History

a. The Circuits' Arguments
The four circuits at issue have based their results in part on the legislative history of the Act. Their logic has two branches: one grows out of the general purpose of the Act, the other arises from the precise language of the Act. The general purpose argument says that Congress intended to protect property interests of trademark owners as well as consumers. The wording argument claims that by choosing the language of the current version of the Lanham Act, rather than the earlier wording, Congress deliberately chose to protect against general public confusion by spurious trademarks. Both arguments are specious because they focus on a few trees in a large and varied forest. Once again, there is no reference to the public domain interests discussed in my thesis.

i. The Purpose of the Act

The Act definitely includes protection of the rights of trademark owners, which are, perhaps, property rights. The Act also protects consumers from confusion. The circuits overlook the reality that the two purposes of the Act are in potential conflict, and, therefore, limit one another, unless Congress subordinates one to the other. Such subordination is not clearly shown.

The enacting statute does not state a purpose for this section of the legislation. n389 The most contemporaneous report n390 mentions the needs of both consumers and trademark owners, discussing them as functionally linked:

The primary purpose of the bill is to provide increased sanctions for the counterfeiting of certain registered trademarks...

... Trademarks play an important role in our society, by enabling businesses to identify themselves to their customers and to link that identity to their reputations for quality goods and service. In turn, trademarks permit consumers to readily identify certain [*1477] products and services and to patronize those businesses with an expectation of quality.

Trademark counterfeiting has a detrimental effect on these legitimate expectations. When articles bearing trademarks are copied exactly, or substantially so, buyers of those goods are deluded into believing that they have purchased the genuine article.

... Businesses are unjustly criticized for having sold substandard products, when in fact the products are fake. n391

This language is not authorization to criminalize sales of fake merchandise if the buyers are not "deluded into believing that they have purchased the genuine article." n392 One could read the passage more broadly by construing "buyers" to mean anyone in the chain of distribution, rather than the immediate purchaser of the sale which is scrutinized, however, this reading seems strained. n393 Furthermore, the report lists several specific occurrences that the bill does not cover (even though reserving comment on whether some are violations of civil law), n394 and specifies that criminal coverage is to be limited to "the most egregious conduct." n395

This statement of purpose sidesteps the question of the extent to which consumers are hurt by trademark protection - a question almost buried in the original hearings. n396 Senator Mathias's opening statement included both purposes without discussing any potential conflict. n397 The Anti-Trust Division of the Attorney General's Office [*1478] also linked the two purposes. n398 The New York City Department of Consumer Affairs considered consumers and businesses to have a common interest in the bill because "both are anxious to make sure that shoppers get their money's worth and receive the goods as represented to them." n399 However, the Consumer Affairs Commissioner testified that at least one name-brand manufacturer refused to help consumers by publicizing the differences between their items and their counterfeit counterparts. The manufacturer suggested that the only way a consumer could be sure of getting authentic merchandise was to "buy from a well-known merchant and pay top dollar," eschewing not only street vendors, but legitimate cut-rate retailers. n400 Primary opposition to the bill came from discount retailers who were afraid that the bill, especially its ex parte seizure provisions, would be used to help manufacturers control prices. n401
The second set of hearings provided no more clear government statement of purpose than did the first. Senator Mathias's opening statement once again mixed the interests of consumers and businesses. Testimony against the bill remained focused on possible harm to legitimate discount retailers. One of the additional statements, however, recognized a potential conflict with the needs of consumers, as opposed to the related conflicts with discounters, and noted the bill's lack of precision on those issues. Mr. Blynn raises the exact issue grappled with by the circuits: "What about goods which are sold expressly as counterfeits?"

In summary, Congress did not clearly indicate to what extent it intended to protect trademark owners when this protection limits consumer choices.

ii. The Argument From 15 U.S.C. 1114(1)

The circuits contend that by choosing the new language of 15 U.S.C. 1114(1) as part of the Act's definition of a counterfeit mark, Congress showed an intent to criminalize actions that would lead to confusion of the general public. This contention includes two legislative history assertions: first, that Congress considered both versions of section 1114(1) in wording the Act; and second, that the change in section 1114(1) itself indicates such a broadened coverage of the Lanham Act. Both are weak contentions.

First, none of the courts points to anything in the legislative history of the Act which shows that Congress considered using the old language of section 1114(1). The legislative history shows several changes in wording for the relevant definitions in the Act, which are discussed below.

Second, the legislative history and judicial interpretations of 15 U.S.C. 1114(1) do not support the circuits' interpretation of that change in language within the Lanham Act. The circuits cite two cases to support the conclusion that earlier courts have interpreted the change in section 1114(1) to include protection when the general public is confused: Syntex Laboratories Inc. v. Norwich Pharmaceutical and Rolls-Royce Motors Ltd. v. A & A Fiberglass, Inc. The limits of these cases have been discussed earlier in this article. Syntex simply does not support this contention, and though A & A Fiberglass is supportive, it is merely a district court decision. The absence of more citable cases to support the importance of a statutory change which occurred in 1962 is itself suspicious.

The legislative history of this 1962 change does not mandate the circuits' conclusion. The stated purpose of the statute involved was general and largely administrative. The reports' analyses of the language change in section 1114(1) merely cross reference to the comment on the parallel change in section 2(d), which deals with registration of a mark, not with standards for infringement. According to the Senate report the first clause of section 2(d) of the act provides that a mark is to be refused registration if it so resembles a mark registered in the Patent Office or a mark previously used by another, as to be likely when applied to the goods of the applicant, "to cause confusion or mistake or to deceive purchasers." The bill proposes to revise the quoted expression to read "to cause confusion or mistake, or to deceive purchasers." The purpose of the proposed change is to coordinate the language here with that used elsewhere and to omit the word "purchasers", since the provision actually relates to potential purchasers as well as to actual purchasers. The word "purchasers" is eliminated so as to avoid the possibility of misconstruction of the present language of the statute.

Glaringly, this passage does not specify how far away from purchase the "potential purchaser" may be, and still remain relevant. Equally glaring is that the primary change intended was in the standard for registering trademarks - not in the standard for finding infringement. A mark which cannot be registered may still be noninfringing when used - even on the goods for which registration was denied. Having a defensible quasi-property right is not equivalent to a finding that that right has been violated.

The absence of a specific discussion in the reports implies strongly that Congress did not view this change to be a
The committee characterized the bill as "in large part a housekeeping measure, making minimal substantive changes in the trademark law," and, therefore, declined to consider a proposal forwarded by the Federal Trade Commission. This narrow reading of the report's ambiguous language is supported by its careful omission of the broader statements made by several witnesses at the hearings.

Two hearings are relevant to this discussion: the 1961 hearings on the final bill ("1961 hearings"), and the 1954 hearings on an earlier version ("1954 hearings"). Two aspects of these hearings are illuminating: the discussion of whether or not to strike "purchasers," and the decision against recommending a new cause of action against persons who use a registered mark in ways likely to cause genericism. The latter, I believe, illuminates the committee members' (as opposed to the witnesses') reading of the former.

The proposed bill discussed at the 1954 hearings included the following new protection for trademark owners:

"Any person who shall, without the consent of the registrant ... (c) employ a registered mark in commerce otherwise than as a trade or service mark in such manner as to be likely to cause the mark to lose its significance as a mark... shall be liable in a civil action by the registrant." This provision views a mark as a property right, as does the most broad reading of the Act. This new civil cause of action was hotly attacked as an unwarranted limitation on speech and communicative media. The provision was also attacked as ignoring the real "culprit" in genericism, the public, whose use of the mark was partly induced by the trademark owner's advertising. Congress refused to pass another proposed antidilution measure as part of the 1988 Trademark Revision Act. The change between the 1954 and 1961 hearings shows a definite decision by the legislators to limit the pure property right associated with marks. By refusing to pass antidilution legislation in 1988, Congress showed the courts that it is not yet willing to enforce such rights.

The bill versions discussed at the 1954 hearings included removing "purchasers" from several sections of the Lanham Act, among them section 1114(1). Several witnesses called this suggestion controversial - not "mere housekeeping," as implied by the later reports. Opponents of the change argued that it would either have no effect or too great an effect. They noted that no case had been wrongly decided because of the statutory language; that the degree of similarity likely to confuse purchasers would also confuse "ordinary potential purchasers," and that the change implied some lesser standard for likelihood of confusion, without supplying any clear guidance. The opponents' ambiguity mirrors the muddiness of the arguments they attempted to counter; their fear of too great an effect seems prescient of the cases which have now come before the courts.

Proponents of the change claimed that the Lanham Act was originally intended to codify the common law; that this change would not be a substantive departure from common law; and that the change was necessary to prevent courts from using the statutory language to narrow available protections. No detailed list of horribles was presented; a list of cases allegedly wrongly decided because of the statutory language was also missing.

The 1961 hearings add a new point to the proponents' argument: case law under the Lanham Act already protects against confusion of nonpurchasers. This changes their characterization of the proposal from a widening of common law, narrowed inadvertently by statute, to a clearer restatement of how courts had already been interpreting the statute. The courts were merely protected from the possibility of future error, however, no cases yet existed where the courts had fallen into this alleged trap for the unwary.

During the 1961 hearings, the proponents also specified some of the situations they wanted clearly included to fall under Lanham Act protection: television advertisements, prizes in giveaway shows, premiums for the redemption of trading or gift stamps, exhibits at industrial fairs and trade shows, leased goods, goods processed as a service to the owner, patients' medications handled by hospital personnel, doctors, and pharmacists, and broadcasters' identification when viewed by the audience.
"potential purchasers," n442 most of these are very close to a sale. The stamp redemption scenario can easily be characterized as an actual sale. The medication possibility is recalled in the discussion of multiparty [*1486] consumers in Syntex Laboratories. n443 The stamp and prize scenarios recall A. T. Cross Co. v. Jonathan Bradley Pens, Inc.. n444 None of these scenarios approaches that of the random viewer of a watch on another's wrist. The SIXTY-FOUR THOUSAND DOLLAR QUESTION, to use an advertising slogan, n445 is this: How far did Congress intend to endorse these proponents' viewpoints. The limited language in the reports, coupled with repeated statements of the minimally substantial nature of the recommended legislation, n446 implies that Congress merely intended to clarify what it thought was already law. n447 Any coverage beyond the "ordinary potential purchaser" must, therefore, be founded on clear case holdings. The limitation of such holdings has already been noted. n448

b. The Legislative History Ignored by the Circuits

The meaning of the precise language in the Act can better be understood by reviewing the revisions that actually were made. n449 The original draft read:

As used in this section -

(1) "counterfeit mark" means any mark that is counterfeit as defined in section 45 of the Lanham Act ... and that is used or is intended to be used on or in connection with goods or services for which the genuine mark is registered on the principal register in the United States Patent and Trademark Office. n450

[*1487] The Lanham Act then as now defined a "counterfeit" mark as "a spurious mark which is identical with, or substantially indistinguishable from, a registered mark." n451 This original formulation of the Act (the "1982 Definition") has no requirement that the goods involved be confusing - just that the mark be difficult to distinguish from the "genuine" mark, and that it be used for the type of goods for which that mark is registered. Any watch with a spurious ROLEX trademark would be covered, even a watch made of plastic with a Mickey Mouse dial.

The second suggested draft read:

(a) Whoever in the foreign or domestic commerce of the United States traffics or attempts to traffic in a counterfeit mark with intent to deceive or defraud, or to assist in deceiving or defrauding, directly or indirectly, any other person ... 

(b) As used in this section -

(1) "counterfeit mark" means a spurious mark that is identical with or substantially indistinguishable from

(A) a genuine mark registered on the principle register in the United States Patent and Trademark Office and that is used or is intended to be used on or in connection with goods or services for which the genuine mark is so registered and is in use ... 

... 

(c) In determining the existence of a defendant's intent to deceive or defraud, the trier of fact shall consider among other pertinent factors, the likelihood that the goods or services on or in connection with which the counterfeit mark is used or intended to be used will be mistaken for goods or services for which the genuine mark is registered and is in use. n452

This language ("1983 Definition A") is even more broad than the 1982 Definition. "Directly or indirectly," especially coupled with the future tense, "will be mistaken," in subsection (c), can be argued to be an unclear draft of our fact situation included in the coverage of the Act. While Senator Mathias did not discuss this in the hearings, n453 a supporter of the bill clearly advocated this construction: n454
Mr. Blynn ... asks "What about goods which are sold expressly as counterfeits?" Clearly, if everyone in the
distributional chain down to the ultimate consumer is expressly informed that the [*1488] goods are counterfeits, there
cannot have been any intent to deceive or defraud, and no liability would attach under S. 875. On the other hand, if one
sells goods as counterfeits to some middleman with knowledge that the middleman will then resell them to consumers
as genuine, one is just as clearly assisting "in deceiving or defrauding, directly or indirectly, any other person" and will
be liable under S. 875. n455

Mr. Torkington, of course, would allege that his replicas were sold to persons at the intended end of the distribution
chain. n456 But would Torkington be liable because his customers might have bought the replicas as gifts? The circuits'
opinions go further than this version of the Act, as they consider the confusion of persons who merely see the watch in
another's possession. n457 The circuits, of course, cannot rely on this construction. Statements made at hearings,
especially those by partisans, are weak legislative history. Much more importantly, this language was not enacted. By
eschewing this version of the bill, Congress indicated clearly that they did not intend to create such sweeping criminal
liability.

In fact, Senator Mathias circulated a mild version ("1983 Definition B") which was also discussed at the 1983
Hearings. n458

(a) Whoever willfully ... traffics, attempts to traffic or induces another to traffic in counterfeit goods or services
using on or in connection with such goods or services a mark known by the offender to be spurious ...

... 

(2) "counterfeit goods or services" means - 

(A) goods or services on or in connection with which a spurious mark is used or intended to be used, which is
identical to or substantially indistinguishable from the genuine mark and - 

(i) which goods or services for which the genuine mark is registered on the principal register ... and is in use; or 

(ii) which goods or services - 

(I) are reasonably related to those for which the genuine mark is registered and is in use; and [*1489]

(II) bear a direct relationship to the health or safety of any person; or 

(B) goods or services on or in connection with which a designation that is specifically protected ... from use without
the consent of the United States Olympic Committee.

(c) In determining the existence of a defendant's willfulness, the trier of fact shall consider pertinent factors
including the likelihood that the goods or services ... are likely to be mistaken for goods or services for which the
genuine mark is registered and in use.

(d)(1) The criminal penalties and treble damages ... shall not apply to a defendant who establishes by a
preponderance of evidence that he provided adequate labeling on the goods or services and adequate notice to the
registrant of the genuine mark. n459

Missing from this version was criminalization of indirect assistance in deception. The court was told to consider as a
factor in intent the likelihood that the goods are, present tense, likely to confuse. Wider coverage was provided for
goods with a "direct relationship to the health or safety of any person," than for jeans or watches. Labeling to prevent
immediate customer confusion, if coupled with notice to the trademark owner, would be a defense. This version clearly
would not support the circuits' opinions. This version too was not enacted.

The Torkington court relied on the last piece of the Act's legislative history, the Joint Statement entered into the Congressional Record of October 10, 1984 by sponsors of the bill, who declared it to be "the final and authoritative explanation of the legislative intent of this act." While statements in floor debate by committee members and sponsors are often given the same weight as official committee reports, the Torkington court's analysis ignored important parts of the Joint Statement, which, I believe, mandate the opposite result.

The Torkington court states that:

The legislative history does not suggest that Congress intended for 2320(d)(1)(A)(iii) the requirement for likelihood of confusion in the Act to serve a purpose other than that of linking the test for a criminal trademark violation to the test used in the civil context. There certainly is no indication that Congress intended for the 2320(d)(1)(A)(iii) test to be more restrictive than is the test under the Lanham Act. The court then cites the aforementioned Joint Statement and emphasizes the following: "As a practical matter, however, this element likelihood of confusion should be easily satisfied if the other elements of a "counterfeit mark" have been proven - since a counterfeit mark is the most egregious example of a mark that is "likely to cause confusion." Oddly, although the court quotes the above, it seems to overlook the import of the sentence which immediately precedes it: "This likelihood of causing confusion is the key phrase in the remedial section of the Lanham Act, 15 U.S.C. 1114, and its inclusion here is intended to ensure that no conduct will be criminalized by this act that does not constitute trademark infringement under the Lanham Act." This overlooked sentence clearly implies that the coverage of the Act is no greater than that of the Lanham Act; it would allow the Act to be either coextensive or more restricted than the Lanham Act. Actually, the Act is definitely narrower, as it does not cover, inter alia, use of the mark on goods for which it is not registered on the principle register, or trade dress infringement, even if confusion is likely. Furthermore, after providing that the Lanham Act should be followed, the Joint Statement adds that in case of doubt when allocating burdens of proof, the burden should be placed on the government. As the court acknowledged, the Act was only intended to reach the "most egregious" conduct. Selling a copy to a customer who believes he is receiving the real thing is clearly more egregious than selling a copy to someone who wants and pays for a copy.

The Torkington court entirely overlooks another section of the Joint Statement that clearly mandates the reversal of their broad holding. The Senate version of the bill included a formal "safe harbor" provision that was not included in the final version. The statement clearly points out that a party could escape a finding of intent to traffic in counterfeit goods if he informally followed these unenacted provisions, by notifying the trademark owner and "conspicuously labeling its goods and related materials so as to alert the public to the fact that the goods or services are not offered by the owner of the registered trademark ... to prevent consumer deception." The Joint Statement relates these actions to destroying the possibility of proving intent. However, they indicate as well that preventing confusion at the point of sale to immediate potential customers is relevant. Since the general rules of statutory construction include the axioms that the latest statement of the sovereign governs, and that the specific governs the general, I conclude that even if, arguendo, the Lanham Act confusion standard were held to include confusion of the general public, the Act does not.

III. Proposal

I have presented a dual thesis. The narrower contention is that the courts have misconstrued the Trademark Counterfeiting Act by misreading the Lanham Act. The underlying thesis is that this error was fueled by a two-sided vision of a three-sided controversy. The courts have made a major and incorrect decision without considering the public's right to purchase products for their communicative function. Nor have the courts considered the related issues of genericism and collateral use created by this function of a mark.

My general proposal is that the courts consider these interests. While the adversarial system and the Lanham Act's
The standing rules do not make this easy. It is, nevertheless, possible. Courts could request additional briefing of these issues from the parties or from court-appointed experts. After such consideration, I hope the property rights of the trademark proprietors will shrink to accommodate the interests of the public.

For the narrower problem, I do not suggest a complete denial of all quasi-property rights of trademark owners, merely that those rights be brought into a more equitable balance. Since this thesis is novel, I am not prepared to offer a polished solution. The following is tendered as an outline of two possible alternative accommodations. Note that these solutions allow trademark holders some rights in "generic" or "functional" indicia of origin.

One solution would allow marketing of replicas if the item itself was marked with a disclaimer visible to a buyer or donee, even if not to a casual observer. For example, a replica Rolex watch could have stamped into the metal back of the watch body, "Not manufactured by or associated with Rolex." This solution is supported by cases dealing with injunctions to protect amalgams of functional and nonfunctional features which have acquired secondary meaning: for example, the trade dress and "tummy graphics" of Care Bears. In such cases, the junior user, where choice of alternative nonfunctional features will not dispel the confusion, is only required to use "clear labelling disclosing source or other reasonable steps to minimize the risk of confusion." Even when the functional feature copied includes the mark, only a reasonable attempt to notify users is required.

Alternatively, "likelihood of confusion" for the Lanham Act could be construed to include different observers, depending on the similarity of the products. Any actual replica of a product - using my earlier definition of a replica as an item crafted to be indistinguishable from the trademark owner's own products - would be protected from confusion of the public in general. This would allow criminal penalties under the Act for sellers, retail or wholesale, of exact copies of Rolex watches. I suggest this because the exact similarity raises the possibility of a user, not the purchaser, concluding that his malfunctioning watch is a Rolex and, therefore, blaming Rolex. Here I would limit the public's rights, because with actual replicas, the possibility of tarnishment and the mark holder's difficulty in proving all the elements of commercial defamation are too great.

Mere colorable imitations or items of the same type for which the mark is registered would be held "likely to cause confusion" only if a reasonably prudent purchaser, or a person in a situation where purchase is seriously considered or suggested (for example, by advertising), would be deceived. Obviously bad imitations would not be actionable. Good but not identical imitations would not be actionable, if clear disclaimers were used.

These suggestions do not bar the trademark holder from suing under copyright or commercial defamation theories. State statutory and common law claims of dilution, unfair competition, and trademark infringement are more complex issues. I believe they should be limited by the policy considerations discussed above, and that preemption is a consideration in defining their scope. That discussion, however, is beyond the scope of this article.

Conclusion

Trademark law suffers from a withering of the public domain because our adversarial system casts trademark cases as battles between two commercial entities. While the public may not be an official party to a trademark suit, the public's interests should be carefully considered. Existing trademark doctrines of functionality, genericism, and collateral use should be used aggressively on the public's behalf. The world reflected in these doctrines should be the real world, a world with status-signals, advertising as cultural background, and people who describe themselves through their object choices. In this real world, many "strong" marks are over-protected functional components of communicative symbols.

Legal Topics:

For related research and practice materials, see the following legal topics:
FOOTNOTES:

n4. Protection is extended to the source, even if the name of the source is unknown. 15 U.S.C. 1127 (1988) (definitions of "trademark" and "service mark"). This article will use "mark" and "trademark" to include service marks, certification marks, and trade dress unless the context shows otherwise.


n7. "The infringer deprives the owner of the good will which he spent energy, time, and money to obtain ... At the same time ... depriving consumers of their ability to distinguish among the goods of competing manufacturers." Inwood Labs. v. Ives Labs., 456 U.S. 844, 854 n.14 (1982).

n8. See, e.g., Lee B. Burgunder, An Economic Approach to Trademark Genericism, 23 Am. Bus. L.J. 391, 397-402 (monopolizing a generic mark would be an economic benefit to a manufacturer but harmful to the public).

n9. Note that this article suggests three separate theories which can block a finding of infringement because of the same circumstances: Genericism and functionality bar infringement because no protectable trademark exists; collateral use is a policy decision to immunize the allegedly infringing action.

This Article only addresses federal trademark law, and not state statutes or common law on repackaging, dilution, defamation, or related issues. The complex argument on the extent to which these state doctrines are or should be limited by related concerns or federal preemption is unfortunately beyond the scope of this Article. Dilution is commonly limited to strong marks, 2 J. Thomas McCarthy, Trademarks and Unfair Competition 24:14 (2d ed. 1984), however, a generic or functional "mark" is not an actual mark. Functionality may bar protection by trademark, dilution, and unfair competition theories. See e.g., Damn I'm Good v. Sakowitz, Inc., 514 F. Supp. 1357, 1363 (S.D.N.Y. 1981); see generally, Milton W. Handler, Are the State Antidilution Laws Compatible with the National Protection of Trademarks?, 75 Trademark Rep. 269 (1985) (arguing for preemption of state antidilution statutes by the Lanham Act while reporting that courts are split on the issue).

n10. See, e.g., U.S. Const. art. III, 2, cl. 1 (cases and controversy clause).

n11. A "speaker of English," see infra notes 14, 15 and accompanying text, who tried to sue under the Lanham Act would face two different problems of standing. First, widely diffused injuries may not meet federal
court standing requirements. See, e.g., *Lujan v. Nat'l Wildlife Fed'n*, 110 S. Ct. 3177 (1990) (affidavits alleging loss of aesthetic and recreational enjoyment of land in the vicinity of that affected by a government agency decision is insufficient to create standing to contest the decision); *United States v. Richardson*, 418 U.S. 166 (1974) (barring taxpayer's suit against the CIA); *Sierra Club v. Morton*, 405 U.S. 727 (1972) (conservation group whose members do not allege use lacks standing to ask court to stop building project in national park). But see *United States v. SCRAP*, 412 U.S. 669 (1973) (environmental group may sue Interstate Commerce Commission over a railroad freight policy which encouraged the use of disposable goods). A suit by a speaker of English under the Lanham Act has both this generalized problem and an additional problem created by court interpretation of that statute.

The Lanham Act's most generalized standing provision, section 43(a), allows suits by "any person who believes that he or she is or is likely to be damaged by such act." Trademark Law Revision Act of 1988, Pub. L. No. 100-667, 102 Stat. 3935 (codified at 15 U.S.C. 1125(a) (1988)). Before the 1988 revision, the language read "by any person doing business in the locality falsely indicated as that of origin or in the region in which such locality is situated, or by any person who believes that he is or is likely to be damaged by the use of any such false description or representation." Id. Although the cases discussed below construe the old wording, the new version is unlikely to be treated differently. The report which accompanied the Revision Act of 1988, stated that one of the changes to the bill before its enactment "restored the Act's existing language with respect to standing to bring an action under Section 43(a)." S. Rep. No. 515, 100th Cong., 2d Sess. 41 (1988), reprinted in 1988 U.S.C.C.A.N. 5577, 5603. The proposal which was not passed would have provided consumers with standing to sue under section 43(a). 135 Cong. Rec. H1219 (1989) (correction to the Congressional Record of Oct. 19, 1988) (remarks of Representative Fish).

While the plain meaning of either version of section 43(a) suggests that a consumer who is misled into buying an inferior item could sue under this statute, the courts hold otherwise. The first federal decision on this point is *Colligan v. Activities Club of N.Y.*, 442 F.2d 686 (2d Cir.) (class action by high school students who were deceived into paying for a low quality ski tour and by those who might be so deceived), cert. denied, 404 U.S. 1004 (1971). After considering its clouded legislative history, the absence of consumer protection groups at the time the statute was enacted, the existence of state remedies, the flood of litigation that could be expected to overwhelm federal courts if an opposite decision were reached, and the statement of policy at the beginning of the statute, the Colligan court concluded that section 43(a) only reached commercial plaintiffs. See also, e.g., In re "Agent Orange" Prod. Liab. Litig., 475 F. Supp. 928, 934 (E.D.N.Y. 1979) (referring to 15 U.S.C. 1125(a), the court stated: "This provision creates a remedy for members of a commercial class, but not for consumers or members of the general public victimized by unscrupulous commercial conduct.")., rev'd on other grounds, 635 F.2d 987 (2d Cir. 1980), cert. denied, 454 U.S. 1128 (1981). While direct competition is not necessary, attenuated commercial injuries have been held insufficient for standing under section 43(a). Compare *Camel Hair & Cashmere Inst. of Am. v. Associated Dry Goods*, 799 F.2d 6 (1st Cir. 1986) (nonprofit association of five commercial manufacturers of camel hair and cashmere fiber and garments had standing to sue its members' competitors) and *Thorn v. Reliance Van*, 736 F.2d 929 (3d Cir. 1984) (investor in a bankrupt firm allegedly damaged by a competitor's violation of the Lanham Act had standing to sue the competitor) with *Shonac Corp. v. AMKO Int'l*, 763 F. Supp. 919 (S.D. Ohio 1991) (retailer and wholesaler of discount shoes lacks standing to sue jobber who sold it items bearing counterfeit marks); *Dovermuehle v. Gilldorn Mortgage Midwest*, 871 F.2d 697 (7th Cir. 1989) (since they are not engaged in any commercial activity, members of a family who had sold a business that used the family surname as a tradename have no standing under the Lanham Act to sue a later user of that name); *Practice Perfect v. Hamilton County Pharmaceutical Ass'n*, 732 F. Supp. 798, 804 (S.D. Ohio 1989) (corporation which "never got off the ground because of its own shortcomings" lacks standing to sue for damages under the Lanham Act as it cannot show any actual injury was sustained); *Berni v. International Gourmet Restaurants of Am.*, 838 F.2d 642 (2d Cir. 1988) (since they are not currently engaged in and do not currently intend to engage in future commercial activity, former stockholders in an Italian restaurant have no Lanham Act standing to sue for misuse of that restaurant's mark); and *Monkelis v. Scientific Sys. Servs.*, 653 F.

It is more likely that the public could appear as an amicus, but it may not recognize a potential for injury in sufficient time to join a pending suit.

n12. Government agencies have some ability to represent the public - for example, the Patent and Trademark Office can deny a requested registration; the Federal Trade Commission ("FTC") could petition for cancellation of a mark which has become generic, 15 U.S.C. 1064 (1988) - but government funds are limited. The FTC, furthermore, can only challenge marks on genericism grounds; it cannot raise functionality issues. In a few cases other government agencies have appeared as parties before the Patent and Trademark Office, but only to represent their own interests in the terms. See, e.g., FBI v. Societe: "M. Bril & Co.," 172 U.S.P.Q. (BNA) 310, 311 (TTAB 1971) (FBI has standing to bring an opposition to a registration of FBI FABRICATION BRIL INTERNATIONAL as a mark for clothing because FBI agents often wear clothing conspicuously marked "FBI"; FBI lost on other grounds), aff'd, 187 U.S.P.Q. (BNA) 685 (D.D.C. 1971); Department of Transp., Fed. Aviation Admin. v. Scanwell Labs., 170 U.S.P.Q. (BNA) 174 (TTAB 1975) (FAA which uses term in bid contracts has standing to file petition to cancel registration of a descriptive term that the item's manufacturer developed for the FAA under a contract barring use of restrictive markings; registration cancelled), aff'd, 484 F.2d 1385 (C.C.P.A. 1973).

n13. In cases of genericism, competitors may hesitate to bring suits because of free-rider problems. Other competitors will also be allowed to use the former mark without paying for the lawsuit. Ralph H. Folsom & Larry L. Teply, Trademarked Generic Words, 89 Yale L.J. 1323, 1338-39 (1980). The same problem occurs in functionality suits.


n14. Language is by its nature in the public domain. See, e.g., Jessica Litman, The Public Domain, 39 Emory L.J. 965, 1013-14 (1990) ("Language is sufficiently crucial that we insist on unrestricted access to words, even new words... To the extent that individual commands or keystrokes in popular user interfaces are understood by users as individual words, they must belong to the public domain simply because they are elements of language.").


The author does not argue that the First Amendment forces the courts to take her position. The conception that language is a publicly-owned resource is so basic, it is not expressly listed in the Constitution. Several First Amendment doctrines, furthermore, could easily undermine a challenge by owners of the public domain. First, commercial speech has been held less protectable than other communications. Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council, 425 U.S. 748, 771 n.24 (1976). While advertisers are commercial entities and not the public, the speech involved may be so characterized. Second, to be speech a communication
must have a clear message aimed at a "listener." *Spence v. Washington*, 418 U.S. 405, 415 (1973) (per curiam) ("his message was direct and likely to be understood"); placing removable peace symbol on publicly displayed flag is protected by the First Amendment; *United States v. O'Brien*, 391 U.S. 367, 376 (1968) ("We cannot accept the view that an apparently limitless variety of conduct can be labeled "speech" whenever the person engaged in the conduct intends thereby to express an idea.") In this case, the Court held that public burning of a draft card was not protected by the First Amendment; Melville B. Nimmer, The Meaning of Symbolic Speech under the First Amendment, 21 UCLA L. Rev. 29, 36 (1973) ("An irreducible minimum for protection of action as speech is a communication that implies ... a communicator ... a communicatee and an intention to convey a meaning."). Many statements made by the public using advertisers' marks are arguably vague and aimed at no particular listener. See infra notes 77, 95 and accompanying text. The First Amendment reflects a concern that all people have speech and communication rights - but claiming that the specific erosions of the public domain suggested here are barred by the First Amendment would reduce this argument to absurdity. Obviously, we limit speech rights in the interests of other concerns. No one should be allowed to falsely shout "Fire!" in a crowded theater, *Schenck v. United States*, 249 U.S. 47, 52 (1919), or use advertising which bilks customers by fraudulent misrepresentations, *Virginia State Board*, 425 U.S. at 771 ("Untruthful speech, commercial or otherwise, has never been protected for its own sake."). The First Amendment, however, is evidence of the importance of speech and of access to the means (press) and processes (assembly, petition) of speech. The First Amendment is at least evidence that the courts and legislatures have a duty to consider the unarticulated interests of all potential speakers, when advertisers fight each other for exclusive rights to communication symbols. If an allegedly infringing T-shirt is a communication symbol, my right to wear it should imply someone's right to manufacture and sell it. See hypothetical infra section I.D.


n17. See cases discussed infra sections II.C.-D.

n18. See generally McCarthy, supra note 9, 2:1 (policy reasons for trademark protection).


n20. This article concentrates on the issue of functionality. Genericism and collateral use analyses are noted, but a full discussion of these theories is beyond the scope of this work.

n21. "Status categories" in this article are not limited to levels in the power and respect hierarchy, the type of status considered by Thorstein Veblen. See infra notes 22-26 and accompanying text. A status category is any group of persons seen as sharing typical qualities. Such categories include those divided by economic levels, age, and gender. The "grinds" at a high school are a status class.


n23. Id. at 68-101.
n24. Id. at 115-66.

The code of reputability in matters of dress decides what shapes, colours, materials, and general effects in human apparel are for the time to be accepted as suitable; and departures from the code are offensive to our taste, supposedly as being departures from aesthetic truth. The approval with which we look upon fashionable attire is by no means to be accounted pure make-believe. We readily, and for the most part with utter sincerity, find those things pleasing that are in vogue.

Id. at 131.

n25. The use of objects to sign one's status to other members of society is not modern. Apprentices in Shakespeare's England wore the "sign of their profession":

Flavius: Hence! home, you idle creatures, get you home:

   Is this a holiday? what! know you not,

   Being a mechanical a workingman, you ought not walk

   Upon a labouring day without the sign tools and working clothes

   Of your profession? - Speak, what trade art thou?

First Citizen: Why, sir, a carpenter.

Marullus: Where is thy leather apron and thy rule?


n26. Veblen, supra note 22, at 86.

n27. Grant McCracken, Culture and Consumption: New Approaches to the Symbolic Character of Consumer Goods and Activities 89 (1988). The division between words and objects is attacked from both sides. To some wordsmiths, the ultimate communicative ability of words is, or should be, that of objects. Consider the merger desired by American poet Archibald MacLeish:

A poem should be palpable and mute

   As a globed fruit,

   Dumb

   As old medallions to the thumb,

   Silent as the sleeve-worn stone

   Of casement ledges where the moss has grown -

   A poem should be wordless
As the flight of birds.

'Of casement ledges wh' *
A poem should be motionless in time

As the moon climbs,
Leaving, as the moon releases
Twig by twig the night-entangled trees,
Leaving, as the moon behind the winter leaves,
Memory by memory the mind -
A poem should be motionless in time

As the moon climbs.

'Of casement ledges wh' *
A poem should be equal to:

Not true.

For all the history of grief
An empty doorway and a maple leaf.

For love
The leaning grasses and two lights above the sea -

A poem should not mean
But be.


n28. McCracken, supra note 27, at 71 (citations omitted).

n29. "That consumer goods are the locus of cultural meaning is too well established a fact to need elaborate demonstration here." McCracken, supra note 27, at 83. See, for example, the work of Douglas, Isherwood, Sahlin, Arnould, Wilk, Baudrillard, Belk, Bronner, Felson, Furby, Graumann, Hirschman, Holman, Krampen, Leiss, Leby, Prown, Quimby, Rodman, Philibert, Schlereth, Sellerberg, and Solomon that are listed as examples of this type of scholarship in McCracken. Id. at 71.

n30. Id. at 71-75.

n31. Mihaly Csikszentmihalyi & Eugene Rochberg-Halton, Meaning of Things: Domestic Symbols and the Self ix (1981). "The evolution of humankind thus tends to be measured not by gains in intellect, morality, and
wisdom; the benchmarks of progress have to do with our ability to fashion things of ever greater complexity in increasing numbers." Id.

n32. Id. at 1.

n33. Id. at 48-49, 93.

n34. A ... characteristic of cultural categories in modern North America is their apparent "elective" quality. Devoted as it is to the freedom of the individual, this society permits its members to declare at their discretion the cultural categories they presently occupy. Exercising this freedom, teenagers declare themselves adults, members of a working class declare themselves members of a middle class, the old declare themselves young and so on. Category membership, which in most cultures is more strictly specified and policed, is in our own much more a matter of individual choice. In this culture, individuals are to a great extent what they claim to be, even when these claims are, by some sober sociological reckoning, implausible.

McCracken, supra note 27, at 73-74.

n35. See generally Richard W. Fox & T.J. Jackson Lears, Introduction (overview concluding that "images of autonomy obscured its eclipse"), in The Culture of Consumption: Critical Essays in American History, 1880-1980, at ix-xvii (Richard W. Fox & T.J. Jackson Lears eds., 1983) hereinafter Culture of Consumption. "Few people at the beginning of the nineteenth century needed an adman to tell them what they wanted." The MacMillan Book of Business and Economic Quotations 5 (Michael Jackman ed., 1984) (quoting John Kenneth Galbraith). "We grew up founding our dreams on the infinite promise of American advertising." Id. at 4 (quoting Zelda Fitzgerald). "Advertising promotes the divine discontent which makes people strive to improve their economic status." Id. (quoting Ralph Starr Butler). "The motion picture industry has provided a window on the world, and the colonized nations have looked through that window and have seen the things of which they have been deprived. It is perhaps not generally realized that a refrigerator can be a revolutionary symbol - to a people who have no refrigerators." Id. at 5 (quoting Achmend Sukarno).


n37. Id.

n38. Id. at 6-17. Similarly, Csikszentmihalyi and Rochberg-Halton note that symbols can be used both to socialize the self and to differentiate the self from its society. Either extreme position is psychologically unhealthy. During periods when the social norm shifts drastically on the individual-communal spectrum, the result is a lack of usable symbols with a concomitant loss of meaning available to individuals, and, therefore, a high suicide rate. Csikszentmihalyi & Rochberg-Halton, supra note 31, at 38-43.

n39. Lears, supra note 36, at 17-38. Note that Lears does not see all advertising executives as cynical manipulators. Id. at 17.

n40. McCracken, supra note 27, at 72-73.
n41. Id. at 77. McCracken considers his thesis on the method by which meaning moves from the world, into the object, and then is appropriated by the consumer to be his contribution to the field. Id. at 89.

Interestingly, Charles Horton Cooley, one of the pioneers of modern sociology, mentioned some similar mechanisms in his assessment of the creation of "pecuniary valuation." Charles Horton Cooley, Social Process 293-348 (1966). To Cooley, an individual's value for a specific object is generated by a largely subconscious mental process, id. at 290, which advertising takes advantage of, attempting to manipulate choices without grappling with victims' conscious contemplations.

This trait of the growth of values is of course well understood in the art of advertising, which aims, first of all, to give an idea weight in the subconscious processes, to familiarize it by repetition, to accredit it by pleasing or imposing associations, to insinuate it somehow into the current of thought without giving choice a chance to pass upon it at all.

Id. at 290-91. Pecuniary value, the amount of money which a person would pay for an item, is largely a creation of institutions, of society as an interactive process, rather than of needs basic to human nature. Id. at 295-96. The wealthier social class has a disproportionate impact on society's pecuniary valuations because they have more spending power; opportunity as a managerial class to control administration of the business system; and the prestige to impel others to copy their taste decisions. Id. at 302-04; see discussion of McCracken's fashion system infra note 42 and accompanying text.

On a more simplistic level, advertising affects meaning by supplying words. For example, "athlete's foot" came from advertising copywriter Obie Winters, who coined the phrase while searching for a polite term for ringworm - in order to promote an equine linament, Absorbine, for human use. Eric Clark, The Want Makers: How They Make You Want to Buy 54 (1989).

n42. McCracken, supra note 27, at 79-83. The dynamics of the fashion system are beyond the scope of this article. Note, however, that advertising uses and reinforces the fashion system: Product designers use advertising to publicize their decisions, often through celebrity endorsements.

n43. Id. at 77. Advertising campaigns are based on extensive research of meanings desired by the targeted group. Clark, supra note 41, at 23-124 (advertising research). For example, now that consumers are worried about pollution and engine maintenance, gaslines are advertised by highlighting their cleansing properties. Stuart Elliot, Cleanliness is Next to Carburetors, N.Y. Times, Apr. 16, 1992, at D21. Now that Eastern Europe has emerged as a possible market, western-style pre-advertising studies are dissecting the attitudes of Russians. Stuart Elliot, Sampling Tastes of a Changing Russia, N.Y. Times, Apr. 1, 1992, at D1.

n44. McCracken, supra note 27, at 77.

n45. Id. at 77-79. The consumer obtains control of this meaning by performing rituals of possession, exchange, grooming, and divestment. Id. at 83-88. See infra notes 48-55 and accompanying text.

n46. McCracken, supra note 27, at 88. Consider also the work of Csikszentmihalyi and Rochberg-Halton, who concentrate on the symbolic meaning of objects in persons' homes. Csikszentmihalyi & Rochberg-Halton, supra note 31. They note that each person has a limited supply of psychic activity which he expends by choosing the objects of his attention. Id. at 4-6. Socialization is the process by which the group structures the individual's attention choices and the person changes the group by joining it. Id. at 7-8. Things are not totally separate from
persons. The Cartesian dichotomy, "I think therefore I am," is a misleading fiction that personhood exists separate from the self in contemplation of objects. But to contemplate oneself, one must already have conceived of the difference between object and subject. Id. at 3-4. Csikszentmihalyi and Rochberg-Halton suggest a more accurate philosophical definition is "to be is to have," Id. at xi (citing George Gusdorf). Consider the exclamation of one frustrated working parent, when faced with her child's identity crisis: "I wanted long hair and money and a Ford Taurus." Celia W. Drupper, Tiny Incomes, Little Help for Single Mothers, N.Y. Times, Mar. 3, 1992, at A1, B8. Since one has only a limited supply of attention, one's basic life choice is the investment of that attention. By choosing one object, one loses the chance to choose another. The object chosen becomes the carrier of one's psychic energy, a part of one's being. Csikszentmihalyi & Rochberg-Halton, supra, note 31, at 5-8. (This tie between the person and the object allows others to expropriate your being by acquiring the object. This underlies Marx's attack on capitalists expropriating the creations of workers' labor. Id. at 8-9.) Objects are signs which interact with persons as definitions of the self chosen, mediators of internal conflicts, models of one's goals, and symbols of social integration. Id. at 20-37. Man-made objects are especially rich symbolically because they are signs both of the persons who created them and the persons who use them. Id. at 14. Csikszentmihalyi and Rochberg-Halton go further than seeing the objects as signs. They see the objects as actual parts of the person. Id. at 15.

The things one uses are in fact part of one's self; not in any mystical or metaphorical sense but in cold, concrete actuality. My old living-room chair with its worn velvet fabric, musty smell, creaking springs, and warm support has often shaped signs in my awareness. These signs are part of what organizes my consciousness, and because my self is inseparable from the sign process that constitutes consciousness, that chair is as much a part of my self as anything can possibly be.

Id. at 15.

n47. Goods' status as a form of symbolic communication is far from controversial. See supra note 29 and accompanying text.

n48. Symbolic action, or "ritual," as it is more conventionally called, is a kind of social action devoted to the manipulation of the cultural meaning for purposes of collective and individual communication and categorization. Ritual is an opportunity to affirm, evoke, assign, or revise the conventional symbols and meanings of the cultural order. Ritual is to this extent a powerful and versatile tool for the manipulation of cultural meaning. In the form of a classic "rite of passage" it is used to move an individual from one cultural category of person to another, so that one set of symbolic properties can be given up (e.g., those of a "child") and another taken on (e.g., those of an "adult").

McCracken, supra note 27, at 84 (citations omitted). Any American woman who came of age during the 1950s or 1960s will remember the importance of being allowed to buy her first lipstick. British males used to attach similar importance to purchasing and wearing long, as opposed to short, trousers:

What he did not tell Crosby was that he knew the shop well. It was in Postlewaite and Grimshaw's shop that he, Christopher Denis Sloan, had his first pair of long trousers bought for him. In Sloan's childhood "going into longs" had almost had the quality of a rite of passage. As the police car swept down the Sabbath-deserted High Street he wondered what symbolic rite among growing boys had succeeded it to make the transition stage between boyhood and youth manifest to the world.

n49. McCracken, supra note 27, at 84. Other critics have accepted and discussed these consumer rituals. Id. at 84-89.

n50. Id. at 84.

Thus, for instance, the woman who receives a particular kind of dress is also made the recipient of a particular concept of herself as a woman... Similarly, many of the continual gifts that flow between parent and children are motivated in precisely these terms. The gifts to the child contain symbolic properties that the parent would have the child absorb.

Id. (citations omitted). McCracken is drawing on an extensive literature on the social meaning of gifts, including the work of Caplow, Cheal, Schwartz, Furby, Davis, Mauss, and Sahlins. Id. at 84-85. See also Csikszentmihalyi & Rochberg-Halton, supra note 31, at 37 (gifts create bonds between persons because the object presented is part of the giver's self).

n51. McCracken, supra note 27, at 85.

n52. Id. at 85-86. McCracken considers the housewarming party an elaborate ritual of this type. Id. at 85. A bridal shower would be both a possession and exchange ritual preceding a major status change.

Csikszentmihalyi and Rochberg-Halton describe the activity which moves meaning between the person and the object as "cultivation." Csikszentmihalyi & Rochberg-Halton, supra note 31, at 13. Cultivation of the person is also performed by the object. Id. at 16-17.

n53. McCracken, supra note 27, at 86-87.

n54. Id. McCracken's sources include Myers, Rook, Levy, Kehret-Ward, and Golden. Id. Note that this use of objects is not limited to industrial societies. Spears are used in some cultures the way Americans use cars - as outward symbols of virility. In place of washing or tuning up cars, men constantly toss, sharpen, and twirl their spears. Csikszentmihalyi & Rochberg-Halton, supra note 31, at 25-27.

n55. McCracken, supra note 27, at 87. The first owner of an object may fear a merger of his identity with that of the new owner. Id.

n56. Consider also the work of feminist writer Diane Barthel. See Diane Barthel, Putting on Appearances: Gender and Advertising (1988). Barthel theorizes that advertising inculcates certain unwholesome gender stereotypes, not by creating these concepts but rather by reiterating existing cultural perceptions; that the effects of advertising are increased because it is accepted as background noise; and that we should not muzzle advertising in order to rectify gender stereotyping, but we should loudly answer it with counter advertising. Id. at 185-91. As a student of the First Amendment would say: "the remedy to be applied is more speech, not enforced silence." Whitney v. California, 274 U.S. 357, 377 (1927) (Brandeis, J. concurring). Barthel's work is interesting because she proceeds from assumptions close to those McCracken tries to prove:

Advertising is about appearances. It is also about information, but what interests us, what excites us in and about advertising is how objects, or products, become ideas, how they become gifted with appearances: how they make appearances and help us make appearances. This does not happen through magic. It happens through the
The object gains an appearance whose own magic and content it promises to pour onto its consumers. Advertising is not just about the object's appearance but about personal appearances: how we look to others, how we think of ourselves. Advertisers know that the critical issue is "what will it do for me?" We seldom tire of ourselves, not when we can find constant renewal through the purchase of new products. Advertising, then, is about creating a relationship between subjects and objects. The identity, the appearance, of each is critical, as are the economic, social, and cultural ties that bind object to subject.


n57. See generally, Clark, supra note 41 (discussion of advertising by an academician); John Philip Jones, What's in a Name: Advertising and the Concept of Brands (1986) (discussion of advertising by an advertising executive). These overviews disagree on the relative importance of actual differences between touted products. Jones disagrees with what he labels as three accepted dogmas about modern American-style advertising: that competitive brands are functionally indistinguishable; that the decline phase of the brand life cycle is inevitable and irreversible; and that advertising is a powerful force in overcoming resistance to a product. Id. at 1-15. Clark believes that brand identification is more important than the product, and that "the real difference between competing products is frequently no longer significant." Clark, supra note 41, at 61. These sources represent alternate views of advertising as a help to self-motivated consumers, and as an evil force which manipulates mindless masses. The famous statement of Clark's position is in Vance Packard's The Hidden Persuaders. Vance Packard, The Hidden Persuaders (1957). Proponents of each side of the advertising controversy agree on those aspects of advertising which are required for my thesis.

Other formulations of these outlooks are legion: "Advertisements contain the only truths to be relied on in a newspaper." The MacMillan Book of Business and Economic Quotations 3 (Michael Jackman ed., 1984) (quoting Thomas Jefferson). "Many a small thing has been made large by the right kind of advertising." Id. (quoting Mark Twain). "Advertising may be described as the science of arresting the human intelligence long enough to get money from it." Id. (quoting Stephen Leacock). "The product that will not sell without advertising, will not sell profitably with advertising." Id. at 4 (quoting Albert Lasker). "Advertising is legalized lying." Id. (quoting H.G. Wells). "Advertising is a racket ... its constructive contribution to humanity is exactly minus zero." Id. (quoting F. Scott Fitzgerald). "Advertising is the rattling of a stick inside a swill bucket." Id. (quoting George Orwell). "Advertising is a valuable economic factor because it is the cheapest way of selling goods, particularly if the goods are worthless." Id. (quoting Sinclair Lewis). "When the producers want to know what the public wants, they graph it as curves. When they want to tell the public what to get, they say it in curves... The modern Little Red Riding Hood, reared on singing commercials, has no objection to being eaten by the wolf." Id. (quoting Marshall McLuhan). "Advertising is 85% confusion and 15% commission." Id. (quoting Fred Allen). "Doing business without advertising is like winking at a girl in the dark. You know what you are doing, but nobody else does." Id. at 5 (quoting Stuart H. Britt). "The consumer is not a moron. She is your wife." Id. (quoting David Ogilvy). "Publicity is stronger than sanity: given the right PR, armpit hair on female singers could become a national fetish." Id. (quoting Lenny Bruce). "The conscious and intelligent manipulation of the organized habits and opinions of the masses is an important element in a democratic society. Those who manipulate this unseen mechanism of society constitute an invisible government which is the true ruling power of our country." Id. at 6 (quoting Edward L. Bernays). "Hype makes no critical judgements. The thing or person to be sold may be good quality or trash. Hype works on the theory that Americans will put their money where the noise is." Id. (quoting Russell Baker). "If I were asked to name the deadliest subversive force within capitalism - the single greatest source of its waning morality - I would without hesitation name advertising." Id. (quoting Robert L. Heilbroner). "Quite clearly, it makes no sense to build a better mousetrap and then keep it a
secret. Advertising has emerged and evolved as the most efficient way to tell or to find out about products and services." Id. (quoting Edward N. Ney).

Advertising may not be as powerful as the above seems to assume. A recent statistical study of sales and advertising undermines the importance of advertising as a barrier to entry. Robert E. McAuliffe, Advertising, Competition, and Public Policy: Theories and New Evidence 72-73 (1987). "It is more difficult to deter entry with advertising than previous research has indicated, despite the brand loyalty and first-moving advantages enjoyed by the established firms." Id. at 19. But cf., e.g., Stuart Elliot, Advertisers Urged to Battle Practice of Trade Promotion, N.Y. Times, Apr. 10, 1992, at D18 (citing statistics that tie cuts in advertising budgets to loss of market share).


The market reality of added values is demonstrated by matched product tests. When test groups are given unmarked samples of two products and other groups are offered regularly-packaged samples, the preference levels change. In one breakfast cereal test, "the proportion of people preferring the leading brand was ... 47 percent blind and 59 percent named, a difference of twelve percentage points which can only have come from the added values in the brand that were not in the product alone." Jones, supra note 57, at 32.

n59. The targeted segment may be demographically outlined (young, two-income families, living in large urban areas) or may be the repeat consumers of an opposing brand. Jones, supra note 57, at 174-75.

n60. Clark, supra note 41, at 53.

n61. Id. at 163-201.

The ads are rich in thematic imagery and portray the desirability of smoking by associating it with the latest trends in lifestyle, fashion and entertainment, as well as associating smoking with youthful vigor, social, sexual and professional success, intelligence, beauty, sophistication, independence, masculinity and femininity. The ads are filled with exceptionally attractive, healthy looking, vigorous young people who are both worthy of emulation and free of any concerns relating to health and who are living energetic lives filled with sexual, social, and financial success and achievement.


n62. Clark, supra note 41, at 264.

n63. Id. at 264-66.
n64. Id. at 265. Opponents of such advertisements credit them with the power to affect statistics on teenage drunk drivers. Stuart Elliot, A Rising Tide of Rhetoric Over Warnings on Alcohol, N.Y. Times, Apr. 18, 1992, at D18.


n66. The specificity of a projected image will be of great practical importance in deciding cases under the theory I have proposed. A tie between a specific trademark and a broad cultural value, such as luxury, or sexual allure, is not harmful to the public. For example, a recent advertisement showed an amorphous well-dressed man seated in front of an amorphous expensively-panelled wall and labeled "Bergdorf Goodman Men." N.Y. Times, Aug. 25, 1991, 1, at 27. Many competing signals are available to a person who wants to communicate his relationship to these values, therefore, deleting one from the public domain does not, absent other factors, hurt the public, or hobble competitors. If, however, a trademark is the only effective method (or one of few) for signalling a relationship to a specifically delineated value (such as a unique complex of characteristics associated with the advertising-dream hypothetical users of one brand), protection of that mark hurts the public as well as the competing brands. I recommend an analysis congruent to the copyright link between merger doctrine and thin copyright protection - if there are few ways of saying something, decreased protection will be afforded the copyright holder.

n67. Clark, supra note 41, at 111-13. The United Kingdom's World War I recruitment advertisements were largely based on individuals' fears of social ostracism as a shirker. Two successful ads posed questions addressed respectively to the men and women of England:

Five Questions to men who have not enlisted.

1. If you are physically fit and between 19 and 38 years of age, are you really satisfied with what you are doing today?

2. Do you feel happy as you walk along the streets and see other men wearing the King's uniform?

3. What will you say in years to come when people ask you - "Where did you serve in the Great War?"

4. What will you answer when your children grow up and say, "Father, why weren't you a soldier too?"

5. What would happen to the Empire if every man stayed at home like you?

And
To the YOUNG WOMEN OF LONDON.

Is your "Best Boy" wearing Khaki? If not, don't YOU THINK he should be?

If he does not think that you and your country are worth fighting for - do you think he is WORTHY of you? Don't pity the girl who is alone - her young man is probably a soldier - fighting for her and her country - and for YOU.

Id. at 112.

n68. Jones, supra note 57, at 78.

n69. 1965 Pillsbury (ad campaign by Leo Burnett USA).


n71. Clark, supra note 41, at 244-45. Consider also the lonely Maytag repairman (born in 1967), Tony the Tiger (eating Sugar Frosted Flakes since 1951), and the 7-Up Spot (introduced in 1987). Stuart Elliot, Loneliness in a Long-Running Pitch, N.Y. Times, May 15, 1992, at D1. Fictional characters created outside advertising may be invoked in ads. Vogue may be sued for trying to co-opt Tarzan and Jane. Bruce Weber, Tarzan and Vogue Go To Court, N.Y. Times, Apr. 24, 1992, at B3. One of the earliest advertising mascots was the Brownie from Palmer Cox's children's books. The creature is probably better remembered as the name of Kodak's box camera. Phil Patton, From Little Boxes, Fond Memories, N.Y. Times, June 18, 1992, at C1.

n72. "Repositioning" means changing the consumer's image of the product's added values to appeal to a different demographic target group. Beer manufacturers approached women by linking light beer with dieting. Clark, supra note 41, at 275. Some manufacturers suggest a new use for an existing product or even an old use for a new type of product. Crisco, a solid vegetable shortening, was publicized in 1912 by Procter and Gamble as a newly "discovered" wonder food. Actually, the shortening was a Procter and Gamble product created to increase the company's cottonseed oil consumption and thereby increase its control over its soap oil suppliers. Susan Strasser, Satisfaction Guaranteed: The Making of the American Mass Market 3-5 (1989).

n73. Clark, supra note 41, at 245. The competing Camel man was a rugged individualist shown trail-blazing in exotic locals; "He rafts a Landrover across a jungle river... He perches atop a propeller-driven aircraft surrounded by forest. It is real male fantasy material." Id. In 1986 Camel began to phase in a younger, smoother image. Id. The current cartoon Camel-man has been vigorously protested as successfully targeting children. Paul Fisher et al., Brand Logo Recognition by Children Aged 3 to 6 Years, 266 JAMA 3145 (1991); Joseph DiFranza

n74. Status categories are fluid and often self-chosen in the United States. See supra notes 34-39 and accompanying text.

An image can be used as part of the gift ritual discussed supra note 50 and accompanying text. Quaker Oats's Sugar Puffs, a children's cereal, tested an ad campaign featuring a furry monster who was very loud and rude. The mothers in the test group reacted negatively. They saw giving the cereal to their children as a statement that the loud rude behavior was acceptable. The monster was, therefore, transmuted into a clumsy and playful one. Clark, supra note 41, at 85-86.

n75. Cigarettes are often sold by implicitly promising health and physical strength. Clark, supra note 41, at 242. Senator Thurmond backed a bill to control alcoholic beverages advertising, because "alcohol advertising links advertising with precisely those attributes and qualities - happiness, success, sexual prowess, athletic ability - that alcohol can dim and destroy." Elliot, supra note 64. Nissan proclaims of the Infiniti, that "It's not a car. It's an aphrodisiac." N.Y. Times, Apr. 12, 1992, 6 (Magazine), at 6 (advertisement).

n76. Marlboro sells itself as the smoke of a rugged outdoorsman even in urban cultures.

The advertisements are not designed for people who are like the Marlboro man but for those who would like to be like him. Marlboro advertising is perhaps the most blatantly escapist of all cigarette advertising. It offers transformation of the harried, rushed, and crowded urban man to the open spaces, freshness, and the elemental toughness and simplicity of Marlboro country.

Clark, supra note 41, at 244-45 (quoting Barry Day, creative director of the McCann-Erickson advertising agency).

The growing market power of the elderly has led advertisers to repackage the image of the senior citizen. "Whatever the reality of their own lives, older customers wanted to see people in promotion pictures jogging and gardening, not baking and knitting." Id. at 180. Research also shows that most older people think of themselves as acting ten years younger than their age. Ads aimed at fifty-five year old women, therefore, use forty-five year old models. Id. A recent advertisement for Modern Maturity magazine featured a cartoon of a young-looking man driving a car with oversized tires (Big Foot). The license plate read, "RE-TIRED." N.Y. Times, Mar. 31, 1992, at D19.

Names evoking the myth of Native Americans, not their reality, litter advertising. For example Crazy Horse Malt Liquor's logo focuses on the headdress, not the face; it's pomp without circumstance, form without content. Wear the hat, the illustration seems to offer, and in the process fantasize yourself more interesting (or potent or tough or noble) than you really are. Play at being a "warrior" from the "land that truly speaks of the spirit that is America."

And if some humorless Indians object, just set them straight. Remind them what an honor it is to be used.

Michael Dorris, Noble Savages? We'll Drink To That, N.Y. Times, Apr. 21, 1992, at A23.

n77. "The Marlboro man is almost a cliche of the power of advertising." Clark, supra note 41, at 244.

Ralph Lauren, for example, "is an orchestrator of images." Witold Rybczynski, Home: A Short History of an Idea 2 (1987). Looking at one of his early clothing designs "you just know that the gentleman wearing it belongs to a private club and drives a Rolls-Royce (or at least wants to give that impression)." Id. at 8 (quoting N.Y. Times, Apr. 17, 1973, at 46). Lauren designs and markets such diverse items as clothing, cosmetics, luggage, eyeglasses, and home furnishings. Id. His ads appeal to known and resonant images which evoke myths about "romantic" eras of American history. Id. He offers you a chance to "be part of the ad" by wearing Lauren clothing and living among Lauren furnishings. Id. at 5.

Executives use cars to publicly claim their chosen self-image. Anne Thompson, Honk If You Love My New Wheels, N.Y. Times, Apr. 12, 1992, 3 (Business), at 27.

n78. Playwright Wendy Wasserstein uses brand name objects to convey character in "The Sisters Rosensweig," which opened in New York's Lincoln Center in December 1992. "The play ... demonstrates ... how material culture and consumer products are used (and abused) for self-definition, for character judgments and as currency in interpersonal relationships." Joan Kron, All-Consuming Art: A Wasserstein Play Explores How What We Buy Defines Who We Are, N.Y. Times, Dec. 6, 1992, 2 (Arts & Leisure), at 12.

Research shows that even school children can act out the correct characteristics of smokers of different cigarette brands. "The Marlboro smoking style ... is full of determination, facial grimacing and suggests that a drag from a Marlboro is not child's play... It is a tough smoke for tough men." Clark, supra note 41, at 244. Advertisements are created by choosing the image buyers will want to project. Randall Rothenberg, Seducing These Men: How Ad Agencies Vied for Subaru's $ 70 Million, N.Y. Times, Oct. 20, 1991, 6 (Magazine), at 30 (different images offered by competing agencies).

n79. One of the positive contributions of objects to personality creation is the symbolization of goals - clarifying the person one desires to become. Csikszentmihalyi & Rochberg-Halton, supra note 31, at 27-28. Owning the object - the sign of the future goal desired - may actually help reach it. Id.
n80. For example, Jones distinguishes between a product and a brand: "A product is something with a functional purpose. A brand offers something in addition to its functional purpose. All brands are products ... but not all products are brands... A brand is a product that provides functional benefits plus added values that some consumers value enough to buy." Jones, supra note 57, at 29. Jones considers the brand name alone to be almost worthless for providing added value. New products launched under a brand name from another product category, "umbrella" devices, do not demonstrate large success rates. Id. at 31-32. But his list of added value factors includes several which relate to advertising strategy. Jones lists added values that come from consumer experience with the brand, the sort of people known or perceived to use the brand, a belief that the brand is effective, and the brand's appearance. Id. at 31. A consumer's experience with the brand could be independent of advertising, though arguably expectation affects experience - and the advertisement can suggest which outcome should be considered valuable. The sort of people known or perceived to use the brand is clearly a creation of advertising. As for effectiveness and appearance, advertising spreads a belief in the item's effectiveness; the brand's appearance is created to interact with its advertising image.

n81. "Reproduction of a functional attribute is legitimate competitive activity." Inwood Labs. v. Ives Labs., 456 U.S. 844, 863 (1982) (White, J., concurring); McCarthy, supra note 9, 7:26. Even functional features which consumers use to identify a product's origin are unprotectable. Id. 7:26(B) at 237 & n.5. But see, Jessica Litman, Note, The Problem of Functional Features: Trade Dress Infringement Under Section 43(a) of the Lanham Act, 82 Colum. L. Rev. 77 (1982) (arguing that functionality should limit, not bar, relief in section 43(a) trade dress suits).

n82. Sega Enters. v. Accolade, Inc., 979 F.2d 1510, 1531 (9th Cir. 1992) (citation omitted) (initialization code allowing use of game cartridges with Genesis III system, sold by Sega, is functional even though it triggers display of Sega's trademark).

n83. Pagliero v. Wallace China Co., 198 F.2d 339, 343 (9th Cir. 1952) (pattern on china is functional).

The quoted definition comes from the case which created the doctrine of "aesthetic functionality." This doctrine has been extensively criticized. McCarthy, supra note 9, 7:26(D). McCarthy attacks the expansion of functionality to cover any "important ingredient in the commercial success of the product" as "negating protection for all trademarks." Id. 7:26(E) at 247. The consumer's choice of a symbol of membership in, or approval of, some status group does not denote "aesthetic functionality." The communicative function of the symbols would allow courts to refuse protection to sports teams' patches, association jewelry, and other similar items without resorting to an "aesthetic functionality" argument. I suggest that a different rationale may have informed the court's decision in International Order of Job's Daughters v. Lindeburg & Co., 633 F.2d 912 (9th Cir. 1980) (emblem of a fraternal organization cannot be protected by trademark absent confusion of customers), one that can counter the contrary decision in Boston Professional Hockey Ass'n v. Dallas Cap & Emblem Mfg., 510 F.2d 1004 (5th Cir. 1975) (disclaimer is not sufficient remedy for copying of team emblems onto clothing patches), cert. denied, 423 U.S. 868 (1975). The possibility of communicative functionality destroying trademark protection was raised in Damn I'm Good v. Sakowitz, Inc., 514 F. Supp. 1357 (S.D.N.Y. 1981). That court recognized the "ego-boosting" function of a bracelet inscribed DAMN I'M GOOD, and held that this function undercut the protectability of the motto as a mark. Id. at 1362. The case, however, does not accept my full thesis. The court based its holding largely on plaintiff's failure to use the phrase to identify the product's source until competitors had entered the market. Id. at 1360-62. Furthermore, the court carefully distinguished cases where recognized trademarks were used communicatively on merchandising products such as T-shirts. Id. at 1363 n.21. See also supra note 3.

n84. Sega Enters., 979 F.2d at 1531.
n85. Id. (citing Job's Daughters, 633 F.2d at 918-19).

n86. The consumer may not actually be lying. The consumer could be attempting to communicate any of the following:

1. I am a member of the group which wears this symbol.
2. I am a person who would like to be a member of that group.
3. I am a person who supports that group.
4. I am a person who laughs at the pretensions of that group (or its supporters).
5. I am a person who laughs at those who choose people because they belong to that group.

The First Amendment may perhaps require more precision of meaning than present here to protect this as symbolic speech. See supra note 15.


n88. Mastercrafters, 221 F.2d at 466.

n89. Id.

n90. If what the plaintiff wants is to be associated with the manufacturer of the clock, the status is not functional, even if the plaintiff does not know the name of the manufacturer. See 15 U.S.C. 1127 (definition of "trade-mark" and "service-mark").

n91. See Brief for Defendant-Counterclaimant-Appellant and Intervenor-Counterclaimant-Appellant, Mastercrafters Clock & Radio v. Vacheron Constantin-Le Coultre Watches, 221 F.2d 464 (2d Cir. 1955), cert. denied, 350 U.S. 832 (1955) hereinafter Vacheron First Brief; Brief for Plaintiff-Appellant, id.; Reply Brief and Answering Brief for Defendant-Counterclaimant-Appellant and Intervenor-Counterclaimant-Appellant, id. hereinafter Vacheron Second Brief; Plaintiff's Brief in Opposition to Defendant's Motion for Clarification of This Court's Order of March 31, 1955 and Plaintiff's Petition for Rehearing, id.; Counterclaimants' Memorandum in Answer to Plaintiff's Petition for Rehearing, id.

n92. He may lose customers to the cheaper brand. The manufacturer also runs the risk of tarnishment - that persons who see the poor quality of the imitation might decide that the real product is of poor quality - and the risk of dilution of his mark. This author does not propose total abandonment of protection for these interests. Acknowledging the counter interests of consumers should, however, limit our support of these antithetical manufacturer concerns. My balancing solution is presented infra in section III, Proposal.

n93. See infra section I.B.4., Pride and Prejudice, for discussion of the morality and normality of such behavior.

n95. Consumers could also desire to buy the prestige associated with a third party, for example the social elite, which Vuitton's ads claim can be obtained by purchasing its products. Vuitton submitted an affidavit from Ann B. Kaser, "an expert regarding the luggage and handbag industry," stating that persons choose luggage with the Vuitton initial and stylized flower design "because the design associates the products with Vuitton," and not because the design is aesthetically pleasing. *Brief of Plaintiff-Appellant at 13, Vuitton et Fils, S.A. v. J. Young Enters.*, 644 F.2d 769 (No. 80-5468) (9th Cir. 1980). Consistent with this affidavit, Vuitton might be trying to sell as its own a prestige it appropriated from a (perhaps mythical) social group.

n96. The opposing parties each briefed the issue of functionality, but only aesthetic functionality, as endorsed in *Pagliero v. Wallace China Co.*, 198 F.2d 339 (9th Cir. 1952). Neither side mentioned communication of self-definition as a functional, and, therefore, unprotectable quality of the trademark. *Appellees' Brief at 11-25, Vuitton et Fils, S.A. v. J. Young Enters.*, 644 F.2d 769 (No. 80-5468) (9th Cir. 1980); Appellant's Brief at 7-12, Vuitton (No. 80-5468).

n97. This hypothetical is based on an exam question created by the late Professor John D. Appel of Benjamin N. Cardozo School of Law.


n99. See the fact patterns of circuit cases brought under the Act, infra sections II.C.-D. This sale of a replica Rolex has been held criminal under the Act.

n100. Manufacturers of quality merchandise often try to prevent sales of their merchandise at prices below suggested retail. United States law does not generally support their desire. The legislative history of the Act includes many changes which prevent manufacturers from using the statute's provisions to enforce price fixing. See infra section II.E.3., Legislative History, for a detailed discussion of the legislative history of the Act.

n101. See supra notes 34-39 and accompanying text.

n102. Note that Rolex is used as an example here because it is prominent among trademark counterfeiting cases discussed below. See infra sections II.C., United States v. Torkington, and II.D., Further Court Interpretation of the Act. The author does not posit that the specific trademark ROLEX has actually reached this functional position.
n103. Bob could alternatively be saying that:

1. He knows the identifying signs of the group.

2. He wants/intends to become part of the group.

3. He respects that group.

4. He considers the use of this specific group membership signal an insult to what should be the identifying characteristics of the group.

5. He laughs at the values of anyone who decides another's worth according to the membership signal of the group.

n104. This statement is limited by the necessity for the watch at least to appear to be working.

n105. See infra section I.B.2., The Second Function - A Joint Work, for discussion of the relationship between this second function and the arbitrary embellishment doctrine.

n106. In order to be unprotectable by trademark, a functional aspect of the product must be "essential to the use or purpose of the article or ... affect the cost or quality of the article." Inwood Labs. v. Ives Labs., 456 U.S. 844, 850 n.10 (1982).

n107. See infra section III, Proposal.

n108. See discussion supra notes 87-96 and accompanying text.

n109. Krystal Miller, To the Small World of Model Cars, GM Becomes a Big Bully, Wall St. J., Feb. 15, 1991, at A1 (Eastern ed.). Matchbox has been doing this for years. Perhaps they would win a suit based on a defense of laches.

n110. Clark, supra note 41, at 185-201. For articles on Camel's campaign, see supra note 73.

n111. The president of the New York firm, Children's Market Research, claims that children "are aware of brands and status items even before they can read." A market study in England concluded that children are "obsessed by consumption and bought more because they saw brands as an expression of who they are." Clark, supra note 41, at 186.

n112. See supra note 50 and accompanying text.

n113. But see Warner Bros. v. Gay Toys, 513 F. Supp. 1066 (S.D.N.Y.), rev'd, 658 F.2d 76 (2d Cir. 1981), on remand, 553 F. Supp. 1018 (S.D.N.Y.), aff'd, 724 F.2d 327 (2d Cir. 1983) (affirming permanent injunction against unlicensed manufacturer of a toy car duplicating the General Lee in The Dukes of Hazzard television show over a functionality defense claiming the reproduced symbols were needed for children to play at being Dukes of Hazzard).

n115. See supra notes 71-73 and accompanying text.

n116. The game's manufacturer, however, signed an agreement not to use Marlboro's logo. Philip Morris, supra note 114. It may lose on contract grounds.

n117. See infra sections I.C., Genericism, and I.D., Collateral Use.

n118. For example, clothing is functional, but the color and design of a specific cheerleader costume is not. Dallas Cowboys Cheerleaders v. Pussycat Cinema, 604 F.2d 200 (2d Cir. 1979). This same concept can be phrased as a requirement that to be unprotectable, the particular choice of how to deal with a functional aspect of the product must be "essential to the use or purpose of the article or ... affect the cost or quality of the article." Inwood Labs. v. Ives Labs., 456 U.S. 844, 850 n.10 (1982).

n119. People may not buy the timepiece if they do not know it functions well, but their lack of knowledge does not make the watch any less accurate. To be a communication symbol, however, it must communicate - speakers and listeners must agree on a meaning. The limits of private language, speech used to talk only to oneself, may be an interesting philosophical or psychological problem, but it is irrelevant to advertising.

n120. See supra notes 57-80 and accompanying text.

n121. Note that in genericism it is the consumers' decisions about word use that control - not the desire of the manufacturer - regardless of how much he spent on advertising. See, e.g., Kellogg Co. v. National Biscuit, 305 U.S. 111, 119 (1938) ($ 17,000,000 spent by plaintiff to advertise its brand name is "without legal significance").


n123. Van Der Post, supra note 122.

n124. Most new marketing ventures fail. Jones, supra note 57, at 56. Obviously advertising errors are only one cause for this phenomenon, but product failure includes public refusal of an offered communication symbol.

n125. 1987 Cadillac Tri-Statesman (ad campaign by Biederman, Kelly & Shaffer, NY).


n127. For persons objecting to this behavior as immoral, see the negative characterizations of advertising,
n128. For a discussion of the genesis of advertising, see supra notes 43-45 and accompanying text.

n129. Even when the manufacturer produces a new product or publicizes a new use for an old one, he is commonly manipulating a cultural desire he did not create. Crisco, for example, was the first (or at least the first widely advertised) vegetable shortening for home use. Proctor and Gamble advertised it as a new wonder food, but it rocketed to success on advertisements tying it to the public's existing desire for health. *Strasser, supra* note 72, at 3-5.

n130. A manufacturer could argue that when he uses a real celebrity, he pays the celebrity for the endorsement. This could be seen as an implied in fact contract that the advertiser has purchased a limited license in the status of the celebrity. This is perhaps true, but begs the question of exactly what the celebrity owned to sell. While the celebrity has the legal right to prevent certain imitations, he does not have the legal right to prevent private individuals from, for example, wearing the style of clothes he favors. Furthermore, the manufacturer would say that when he invokes the status of a group, the group is a mirage - at least legally - because there are no identifiable group members with whom the advertiser could contract to license the status, and the advertisement does not copy an existing delineated group, but merely expresses something comparable to the popular image of a member of that group. The latter ignores the central thrust of my argument: The advertiser has no one with whom to contract, because everyone "owns" the status-image which is in the public domain, and therefore is freely available to commercial competitors. What property rights are firms claiming when they declare themselves to be "the official home for family fun" (Holiday Inn) or "the official sponsor of summer" (Borden ice cream)? Stuart Elliot, Advertising: In the Realm of Pitchdom, Things May Be Getting Too "Official," *N.Y. Times*, July 24, 1992, at D4. The former ignores the reality that slavish copying of a high-status item often destroys its status; to retain status one may have to change the details slightly. Consider, for example, Tolstoy's character, Countess Vera Rostov Berg, who was portrayed as grotesque for slavishly imitating the details, not the outlines, of fashionable Moscovites:

Both husband and wife felt with satisfaction that ... their soiree had begun very well and was as like as two drops of water to every other soiree, with the same conversation, tea, and lighted candles.

... Everything was identically the same as it was everywhere else ... The elderly gathered near the elderly, the young people sat with the young, the hostess at the tea-table on which there were exactly the same kind of cakes in a silver cake-basket as the Panins had at their party. Everything was just as it was everywhere else.


n132. Whether the public's adoption of manifestations as signs of particular meanings is arbitrary is a topic well beyond the scope of this article. Manufacturers who spend millions of dollars on advertising do not seem to
think so. See Stephen L. Carter, The Trouble with Trademark, 99 Yale L.J. 759 (1990) (Lanham Act is based on
the doubtful factual premise that all marks are fungible). Accord Adam Bryant, Advertising: Ultimately, Nissan Calls Car "Altima," N.Y. Times, June 24, 1992, at D17 (name is important trigger of car's emotional appeal).

n133. The public may never have seen the naked product.

n134. Objections to this point of view could be created on economic analyses: If, for example, we deny Rolex the ability to restrict the class of persons who are seen by others to wear "Rolex" watches, Rolex will lack economic incentives to uphold its mark and the quality of its product. This hypothetical attack is simplistic. First, it ignores the value judgment involved - the propriety of allowing the desires of Rolex and its rich users to limit the product options of other consumers and manufacturers. Second, it ignores that Rolex will have the incentive to create a high quality product and a known mark because we will carefully prevent confusion by actual purchasers. Cf. Ran-Dav's County Kosher v. New Jersey, 608 A.2d 1353 (N.J. 1992) (invalidating regulations on kosher food, but not changing regulations that "require the full and accurate disclosure of the basis on which they advertise and sell their products as kosher."), cert. denied, 61 U.S.L.W. 3584 (Feb. 22, 1993).

Obviously, tarnishment is a problem. Possible buyers of Rolex watches could observe the inadequate performance of replica Rolex watches and presume they indicate the quality of real Rolex watches. I, therefore, suggest a limited protection of communicatively functional indicia of origin. See infra section III, Proposal. By protecting Rolex, we are not protecting the public's right to buy signalling-goods; other objects and methods are available for signalling. See infra notes 149-54 and accompanying text.


n136. The laws existed from the reign of Edward III to that of James I. Frances E. Baldwin, Sumptuary Legislation and Personal Regulation in England 274 (1926).

n137. Id. at 10. Another motive was nationalism - the preservation of local forms of dress. Vincent, supra note 135, at 131-32. Persons entering the Swiss cantons were often given limited periods of time to conform to local costume. Id. at 43. Lingering behind other motives was a general dislike of new fashions. Id. at 42. The fashions usually won, as evidenced by the chronological changes in the prohibitions. "Absolute prohibition of a garment or form ... is later modified by an amendment which permits the use of it provided the shape or material is made to follow the directions then and there provided." Id. at 132-33.

n138. Baldwin, supra note 136, at 136. A Basel ordinance of 1637 began its section on clothing as follows:

Therefore, (alas) it is sufficiently well known how in many men and women, young and old, high rank and low and their children, both luxuriousness and ostentation in clothing have so taken root and increased that not only is honor repressed and no condition or rank can be recognized, but experience shows that when such useless, excessive ostentation and cost is not remedied and suppressed in good time, the Almighty God (to whom such a thing is most highly offensive and who punishes it every time, as we have examples enough in the holy scripture) will be still more violently angered and may bring upon us all heavier and harder punishments and distress.

Vincent, supra note 135, at 141.
n139. Economic determinists might see as crucial that sumptuary laws in England began at approximately the same period as the feudal system of paying rents in goods or services began to be supplanted by payments in money. Baldwin, supra note 136, at 25-26. The laws could be seen as a way of saving coinage for the King’s taxes. The contemporaneous statements speak more generally of the evil of wasting one's resources on clothing:

Since many necessaries within the kingdom have been greatly increased in price because divers people of divers conditions use divers apparel not pertaining to their estate; that is to say, laborers (yeomen) use the apparel of craftsmen, and craftsmen the apparel of valets, and valets the apparel of squires, and squires the apparel of knights; ... poor women and others the apparel of ladies, poor clerks fur like the king and other lords; therefore the below-mentioned merchandise sells at greater prices than it was accustomed to and the wealth of the kingdom is destroyed, to the great damage of the Lords and Commons. For which they pray a remedy.

Id. at 46 (quoting Parliament's petition to Edward III in 1362) (citations omitted).

"Forasmuche as the greate and costly array and apparell used wythin this realme ... hath be the occasion of grete impoverishing to divers of the Kings subjects and provoked many of them to robb and to doo extortion and other unlawful dedes to maynteyene therby ther costeley array."Id. at 141 (quoting a sumptuary statute of 1510).

Swiss statutes have similar prefaces: "Many are suffering in household and business while wife and child are spending so much on superfluity and costliness in clothing." Vincent, supra note 135, at 139 (quoting preliminary statement on ostentation in 1628 Zurich ordinance). "Through seductive, pernicious and excessive ostentation and pride many persons have suffered decrease and loss of food, yea, at last fallen into extreme poverty and want." Id. at 141 (quoting introduction to section on clothing in a Basel ordinance of 1637).

The death of sumptuary laws in England coincided with an increase of scholars who theorized that "high living is advantageous to a nation ... since it thus encourages domestic manufactures and commerce." 2 W. Cunningham, The Growth of English Industry and Commerce 392 (5th ed. 1912) (paraphrased in Baldwin, supra note 136, at 247).

n140. Baldwin, supra note 136, at 53, 246. The dominant economic philosophy of the time was mercantilism. Id. at 246. In 1581, William Stafford advocated prohibiting "bringing in and selling of so many trifles ... brought us from beyond the sea, and that nothing made beyond the sea of our own commodities should be sold here." Id. (citation omitted).

n141. Our economic model is closer to that of Huxley's Brave New World where the fear is that people will not consume enough. "Imagine the folly of allowing people to play elaborate games which do nothing whatever to increase consumption. It's madness. Nowadays the Controllers won't approve of any new game unless it can be shown that it requires at least as much apparatus as the most complicated of existing games." Aldous Huxley, Brave New World 30 (Perennial Library 1989) (1932).

Our notion of government does not include such detailed invasion of daily life as to limit what fabrics we can wear and how many courses we can serve at a wedding. See generally Vincent, supra note 135, at 31-41 (regulations on wedding celebrations) and at 42-95 (clothing limitations). Nor do the majority of our population believe God will send an earthquake if we wear gaudy clothing. The government of the Swiss cantons saw "the extravagances of luxury as displeasing in the sight of God. To them the wrath of God was clearly to be seen in earthquakes, the desolations of war, or the failure of crops, and to obtain relief the people must give heed to their ordinances." Id. at 2-3. Some sects, such as the Amish, believe in extreme simplicity of dress, but they have hardly attempted to foist their beliefs on others through statute. If they did, opponents would probably cite the
Constitution's anti-establishment clause. U.S. Const. amend. I.

n142. Baldwin, supra note 136, at 23 (citation omitted).

Since the Most Noble, Forsighted and Mostwise Council of the City of Nuremberg of the Holy Roman Empire with displeasure is obligated to observe and learn by experience to what extent the salutory clothing ordinance renewed in the year 1657 is almost frivolously and contumaciously forgotten by the majority of citizens, and in these troublesome times with the lack of food are addicted to excessive costly display, to the no small vexation of virtue-loving persons, so that one can hardly distinguish one class from another, whereby observing foreigners of high or low degree in travelling through are often annoyed, not to mention that GOD the Almighty Creator and Preserver of mankind for these and their other sins often threatens to plunge whole cities and lands into ruin, wherefore they have made a better clothing ordinance which shall go into effect at the coming Easter.

Vincent, supra note 135, at 144 (quoting a Nuremberg clothing ordinance of 1693).

n143. "Every costume was to some extent a uniform revealing the rank and conditions of its wearer. The sumptuary ordinances ... strove to preserve and accentuate these natural differences in dress and thus to bolster up the class distinctions on which they were founded." Baldwin, supra note 136, at 53 (citation omitted). See, for example, the Basel ordinance of 1637 quoted supra note 138; Parliament's petition to Edward III quoted supra note 139.

n144. Baldwin, supra note 136, at 53 (citation omitted).

n145. Consider, for example, rules about hat cords in the 1693 clothing ordinance of Nuremberg. Those of the first rank were "allowed to wear hat cords of solid and spun gold, but these must not exceed 20 to 25 gulden in value. On the other hand for them to wear hat cords set with costly precious stones was forbidden." Vincent, supra note 135, at 144. The second rank was prohibited from wearing anything forbidden those of the first: "They may ... wear hat-cords of silver only, or mixed with some gold, the value of which is not over six gulden." Id. at 147. The third rank were "forbidden to wear gold, good or bad, or anything that looks like it. They may wear hat cords of silver costing not more than three or four gulden." Id. at 149 (emphasis added). The fourth rank could not wear hats with hat cords, but were limited to caps. Id. at 151.

An English statute during the reign of Edward IV forbade most persons below the rank of knight from wearing "any figured velvet, or satin, any silk fabric made in imitation of the same, any material "wrought like to' figured (branched) velvet or satin, or any ermine." Baldwin, supra note 136, at 103 (emphasis added) (citation omitted).

n146. See supra notes 98-99 and accompanying text for relevant hypothetical. Of course, status during the medieval era was not tied to a brand name, but this is not a critical distinction. Brand names used today are "part" of an object in approximately the same way, for example, that gold applied to objects was "part" of those objects in times before advertising. See supra section I.B.2.

n147. In England, the common punishment for violation of sumptuary regulations was payment of a fine. See, e.g., Baldwin, supra note 136, at 106 (fines for violation of the 1463 statute were used to defray the costs of the King's household).
n148. This may be distinguished from laws intended to support national industry, such as a sixteenth century English law that forced large groups of persons to wear, and therefore buy, domestically-produced wool caps: "thicked and dressed in England, made within this realm, and only dressed and finished by some of the trade of cappers." Id. at 211. This excerpt is from a 1571 statute which attempted to remedy "the evils arising from the decay of the trade of capmaking." Id. at 211-13. Such laws do not reward individual manufacturers, they support the national economy by underwriting an entire industry. This parallels the United States's attempts to discourage foreign cars imports through tariffs and trade agreements. See, e.g., Steven Greenhouse, Trade Curbs: Do They Do The Job?, N.Y. Times, Apr. 16, 1992, at D1, D10.

n149. Consumers will not be confused. Manufacturers will retain the purpose for and ability to distinguish their products by producing quality goods. Consumers will be able to use marks to quickly locate brands they have already tried. Consumers will not, however, be able to rely on others' experiences of brands, because other consumers may knowingly use "fakes." Of course, consumers could never completely rely on others' evaluations. The person relied on might be an inaccurate observer or reporter for many reasons - including a desire to impress.

n150. Several articles approach but do not grapple with this problem from an economic perspective. Most recent is William M. Landes & Richard A. Posner, Trademark Law: An Economic Perspective, 30 J.L. & Econ. 265 (1987), which discusses the doctrines of functionality and genericism, but never reaches the issue of two products with different functions residing in a single item. Richard S. Higgins & Paul H. Rubin, Counterfeit Goods, 29 J.L. & Econ. 211 (1986), however, does specifically mention the additional function performed by trademarks when "persons purchase branded goods for the purpose of demonstrating to others that they are consumers of the particular good." Id. They correctly demonstrate that allowing counterfeiters to sell replicas may destroy the "club aspect" of a trademark. The authentic item will be bought by high-income snobs, the replica by low-income snobs. Id. at 213-17. "Rational high-income snobs will lower their demand price because of the counterfeiting that is expected to occur, and the value of trademarks will be reduced. To protect the value of trademarks, counterfeiting is legally prohibited." Id. at 217. This discussion begs several questions. Why should we value the high-income snobs' ability to signal each other over the low-income snobs' desire to join the conversation? Why should we assume trademarks are the only way to so signal? See infra notes 151-54 and accompanying text for a discussion of alternative signalling devices. Why should we allow the manufacturer an added price for his product which is not based on its primary, as opposed to signalling, function? But the manufacturer participated in the "creation" of this signalling function. For the limitations of this pro-advertiser view, see supra section I.B.2., The Second Function - A Joint Work. Peter E. Mims, Note, Promotional Goods and the Functionality Doctrine: An Economic Model of Trademarks, 63 Tex. L. Rev. 639 (1984), discusses "expressive functionality." Id. at 664. The analysis is somewhat muddy, and the conclusion - that if the junior user's product "disparages" the senior user's, it should be prohibited - ignores First Amendment concerns. Id. at 669. James M. Buchanan, An Economic Theory of Clubs, 35 Economica 1 (1965) (cited in Higgins & Rubin, supra, at 216 n.10), is not on point. Buchanan's discussion is limited to clubs which are "consumption ownership-membership arrangements," id. at 1, entered into to save economic costs, id. at 2 n.1, and where the "individual remains indifferent as to which of his neighbours or fellow citizens join" the club, id. at 13 n.1. His paradigm is that of the shared swimming pool. Id. at 1. This model does not fit the transaction at issue, and misses the complexity of the two-purpose product.


n152. For a general discussion of Bourdieu's thesis see Daniel Miller, Material Culture and Mass Consumption 147-57 (1987).
n153. Id.


n155. See supra notes 87-96 and infra notes 278-82 and accompanying text.

n156. See supra notes 22-26 and accompanying text for discussion of Veblen's thesis.


n158. See, e.g., id. at 34-49 (discussion of Marx's view of objectification as a rupture between worker and society); id. at 162-63 (criticism of Marxian view that a dominant group forces identity on another through the manipulation of meaningful objects). For an American Marxist view, see Herbert Marcuse, One-Dimensional Man: Studies in the Ideology of Advanced Industrial Society 22-34 (1964).

Research, however, may not support this Marxian view. Apparently powerless classes are able to manipulate capitalist producers into manufacturing desired products. Consider the difference between candy purchased by British adults for their children, and the treats the children buy for themselves. Children often choose sweets which symbolically represent an inversion of adult values, for example, such apparently "inedible" objects as white chocolate corpses, which "bleed" red liquid when devoured. See Miller, supra note 152, at 168 (citing Allison James, Confections, Concoctions, and Conceptions, 10 J. Anthro. Soc. of Oxford 83 (1979)). Consider the symbolic charge of housing styles. Id. at 159-61 (relying on the work of Muthesius, King, Oliver, and others). Great Britain's government-sponsored low-income housing estates of very modern design were created from the aesthetic perceptions of the professional middle class - a group which reflects its own aspirations by living in suburban housing which reflects an ambivalent position in relation to town and country, an expression of individualism ... a concern with compromise and a rejection of extremes, all set within statements about tradition and nationalism... In stark opposition to the values of suburbia are the images projected by the council estate, which appears on the landscape as a powerful expression of the ideals of communality, of technological supremacy over the slum, and of modernist statements on the possibilities of present and future society.

Id. at 159. The residents of these estates, however, refused to define themselves in the image imposed on them by the middle class planners. Id. at 161.

n159. Miller, supra note 152, at 3-4. The conception of man as more natural if he is outside society, or before he uses manufactured goods, is a chosen viewpoint, not a description of history. The view that man's "basic" nature is brutal - all fighting all - is attributed to Hobbes. But he also says that man only exists in societies that have chosen to eliminate such conflict. One could say, therefore, that man's basic nature is to eschew conflict. See Thomas Hobbes, Leviathan: Or the Matter, Forme and Power of a Commonwealth
Western societies also view as natural a person's face devoid of cosmetics, while New Guinean highlanders believe the undecorated face is relatively arbitrary; they see no reason why the fact that they are the equivalent of freckled or blond, pockmarked or conventionally handsome should be a direct representation of their real selves. It is only when the face is something worked upon, through elaborate cosmetic preparations which provide an expression of the self constructed by the self, that they appear in their true guise to the observer.

Miller, supra note 152, at 193-94 (citation omitted).

n160. Nor does this author suggest that courts, or law, should be value blind - merely that courts should be value conscious, that is, they should recognize the value assumptions that underlie their decisions, so that they can evaluate their own values. When courts decide whether or not an advertisement communicates an implied falsehood, they review surveys which evidence consumers' actual understanding of the advertisement. Johnson & Johnson * Merck Consumer Pharmaceuticals v. Smithkline Beecham Corp., 960 F.2d 294, 297-98 (2d Cir. 1992). I suggest that a similar check on reality be applied to decisions about functionality.

n161. A complete discussion of any of these alleged errors is beyond the scope of this article; the following paragraphs are merely intended as outlines of opposing viewpoints which should be considered before assuming the courts' prejudices are correct.


n163. Miller, supra note 152, at 87-90 (construing Jean Piaget, Play, Dreams, and Imitation in Childhood (1962)). Miller rejects the opposing behaviorist school, which he interprets as correctly positing the centrality of the environment, but incorrectly dismissing the importance of the person's actions on his surroundings. Id. at 87. Parents and toymakers also accept the importance of child-object interaction. See, e.g., CityKids, N.Y. Times, Apr. 12, 1992, special advertising section, at 6 (recommending toys that allow children to obtain different responses from the largest number of actions).

n164. Miller, supra note 152, at 87.

n165. Id. at 90-93 (construing several works, especially Melanie Klein, Notes on Some Schizoid Mechanisms, in Envy and Gratitude and Other Works 1 (1975)).

n166. Distinguish our discussion from the distinct subject of using currently incorrect "projections" to knowingly mislead others to their harm. Society can decide that any specific misleading projection is a legally barred imposition on others, without insisting that all such possibly misleading actions should be stopped. Impersonating a doctor, and, thereby, influencing others to allow you to perform an operation, is clearly objectionable behavior. See, e.g., Doc-who-isn't Held in Impersonation, N.Y. Times, Apr. 15, 1992, at B6. Wearing a replica Rolex when asking a bank official for a loan is quite different from misleading that same bank official with an inaccurate balance sheet. Some statuses, for example, that of police officer, are so important or...
powerful that we are willing to criminalize impersonators. See, e.g., *18 U.S.C. 912-13* (1988) (criminalizing the impersonation of a federal officer in order to obtain money, conduct a search, or make an arrest).

n167. Richard Rodgers & Oscar Hammerstein, South Pacific act 2, sc. 2. (original libretto, on file at the Billy Rose Theater Collection of the New York Public Library for the Performing Arts).


n172. As Sherlock Holmes said, "six persons take part in every conversation between John and Thomas: 1. The real John, known only to his Maker. 2. John’s ideal John, never the real one and often very unlike him. 3. Thomas’ ideal John. And, of course, three Thomases." Barthel, supra note 56, at 3 (quoting Cooley, supra note 171, at 200). But Holmes was oversimplifying. Id.

Consider the quote at the beginning of this article. According to Judge Learned Hand, "reputation, like a face, is the symbol of its possessor and creator, and another can use it only as a mask." *Yale Elec. Corp. v. Robertson*, 26 F.2d 972, 974 (2d Cir. 1928). Our situation does not quite fit Learned Hand’s paradigm; we are discussing a symbol for reputation, which is the mutual creation of the trademark proprietor and the public. See supra notes section I.B.2., The Second Function - A Joint Work. More basically, Learned Hand assumes a mask is the opposite of a face; one is the truth of the individual, the other, his lie. But consider the etymology behind the statement. Eryotymology is always relevant because "language is ... a cemetery of dead metaphors." John Lotz, Linguistics: Symbols Make Man, in Psycholinguistics: A Book of Readings 11 (Sol Saporta ed., 1961). "The English word person which expresses individuality as such to us, goes back to the Latin persona which referred to the mask worn by an actor in a play.” Id. Judge Learned Hand’s opposites are close relatives.

n173. See supra note 50 and accompanying text.

n174. Rybczynski, supra note 77, at n.7.

n175. Id. at 10.
n176. Miller, supra note 152, at 1, 11.

n177. The immorality of wearing apparel inappropriate to your status, which is the basic tenet of sumptuary laws, is clearly reflected in the statement of the Danish lookout to Beowulf: "no commoner carries such weapons, unless his appearance, and his beauty are both lies." Beowulf 30-31 (lines 249-51, Burton Raffel trans., New American Library 1963) hereinafter Raffel trans. Beowulf was the Geatish hero who destroyed the monster Grendel in the early English epic of the same name. Introduction to Beowulf 28-30 in 1 The Norton Anthology of English Literature (M.H. Abrams et al. eds., Major Authors ed. 1962) hereinafter Norton Beowulf. Jewelry, as well as the more functional horses, weapons and armor, were presented by thanes to warriors who had bravely served their people. Rulers were commonly referred to as ”ring givers.” See, e.g., Beowulf, lines 35, 1685, 3034, Raffel trans., at 24, 76, 117. Such gifts given without the supporting acts were considered shameful.

Then the son of Healfdene bestowed on Beowulf as the meed of victory a gilded ensign, a decorated battle-banner, a helmet, and a corselet; many saw the jeweled sword of honor borne before the hero. Beowulf drank of the cup in hall; no need had he to be ashamed of the costly gifts before the warriors.

Norton Beowulf, at 47. Wiglaf, in contrast, reproaches the warriors who fled when a dragon overpowered Beowulf, who was an aged King at this point in the epic.

I say what anyone who speaks the truth
   Must say. Your lord gave you gifts,
   ... War
   Came and you ran like cowards ...
   And now the giving of swords, of golden
   Rings and rich estates, is over,
   Ended for you and everyone who shares
   Your blood: when the brave Geats hear
   How you bolted and ran none of your race
   Will have anything left but their lives. And death
   Would be better for them all, and for you, than the kind
   Of life you can lead, branded with disgrace!

Beowulf, lines 2864-91, Raffel trans., at 111-12. We still use objects to communicate status, but we are more generous in allowing people to choose their own groupings and, therefore, the status objects they display.

n178. Miller, supra note 152, at 60-63 (relying on the works of Malinowski, Campbell, Damon, Firth, Acoditti, and Munn).
n179. 1 Timothy 6:10.


n181. Marcuse, supra note 158, at 242-46.

n182. Id. at 245-46 ("the absence of all advertising and indoctrination media would plunge the individual into a traumatic void where he would have the chance to wonder and to think, to know himself"). For an analytical discussion of circumstances that might justify government interference with private preferences and the accompanying dangers, see Cass R. Sunstein, Legal Interference with Private Preferences, 53 U. Chi. L. Rev. 1129 (1986).

n183. For example, the state of Minnesota is running anti-smoking advertising specifically aimed at women. In one version, a billboard model in a tobacco ad comes to life and stubs her cigarette out on the bald head of the male advertising executive who created her to manipulate women into smoking. Anti-Smoking Ads Warn Women of Exploitation, Wash. Post, Sept. 8, 1992, at A5.

n184. See, e.g., Zane, supra note 73 (despite First Amendment concerns agency is banning cigarette advertisements to protect the public, especially children, from a deadly product).

n185. See supra notes 98-99 and accompanying text for hypothetical. Dodging these questions by distinguishing a legal penalty aimed at Brilliant from one aimed at the retailer of his outfit is unresponsive. If no one can sell him the outfit, he cannot easily wear it.

n186. Genericism is a totally distinct theory from functionality. They overlap here because I am positing a communicative function.

n187. Former language of 15 U.S.C. 1064(c) (amended 1984 & 1988) (revised in Trademark Clarification Act of 1984, 98 Stat. 3335 102, and revised again in 1988 Trademark Revision Act, Pub. L. No. 100-667, 102 Stat. 3935, 3941). In 1988, the term "generic" was substituted for "common descriptive name of." The old terminology was confusing because "descriptive" has different meanings in other sections of the statute. The 1984 change was as a direct result of general displeasure with the decision in Anti-Monopoly v. General Mills Fun Group, 684 F.2d 1316 (9th Cir. 1981), cert. denied, 459 U.S. 1227 (1982). The Ninth Circuit, faced with the unusual case of a unique product, created a new test for genericism. They ignored a consumer survey which attempted to discover the usual dispositive fact - the primary significance of the mark to the consumer - and instead, decided in light of a motivation survey. Did the consumer ask for Monopoly in a store because she liked Parker Brother's products, or because she wanted to play Monopoly, regardless of its manufacturer? Id. at 1324-26. The statute was intended to clarify that the old test was correct. S. Rep. 627, 98th Cong., 2nd Sess., 1 (1984), reprinted in 1984 U.S.C.C.A.N. 5718, 5718. Neither of these changes are relevant to my point.

n188. Since during the life of the patents "Shredded Wheat" was the general designation of the patented product, there passed to the public upon the expiration of the patent, not only the right to make the article as it was made during the patent period, but also the right to apply thereto the name by which it had become known.
... "To say otherwise would be to deny to the public the designated name which was essentially necessary to vest the public with the full enjoyment of that which had become theirs by the disappearance of the monopoly."

*Kellogg Co. v. National Biscuit Co., 305 U.S. 111, 118 (1938)* (citation omitted). See also *Aloe Creme Labs. v. Milson, Inc.*, 423 F.2d 845, 849 (5th Cir. 1970) ("the recognition of property rights in the common name of the article could be tantamount to granting a monopoly in that commodity"), cert. denied, 398 U.S. 928 (1970).

n189. "All languages seem to have unlimited potentialities of expression, but they show differences in the degree to which they actually cover the total range of human culture." Lotz, supra note 172, at 2.

n190. All languages show an abundance of terms relating to areas of experience which are of particular concern to the members of the culture: like the extensive terminology in Lappish for the reindeer, in Classical Arabic for the camel, and in Eskimo for snow - and in our culture, the vocabulary of the sailor and the automobile mechanic.

Id. at 12.

n191. One such example is the word photocopy, which has entered the lexicon as a generic alternative to Xerox, which essentially became a generic term for photocopy, prior to a boom in copier manufacturing. The Hungarian language acquired 10,000 new words in a few decades at the beginning of the nineteenth century, as part of a drive to enlarge the vocabulary sufficiently so that it could be the official language of Hungary in place of German or Latin. Similar rapid additions occurred in Hebrew. Id. at 3.

n192. In Mel Brooks's movie, *Blazing Saddles*, Blazing Saddles (Warner Bros. 1974), the bad guys are slowed down in the middle of the desert by a toll booth. That toll booth, in the public domain desert, is the equivalent of a legal entitlement in a generic term. Ownership terminology was used by the Supreme Court in the *Shredded Wheat* case. *Kellogg*, 305 U.S. at 117; cf., *University of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372 (Fed. Cir. 1983) (University cannot bar registration of NOTRE DAME for cheese, because it does not have a right to NOTRE DAME in gross).

n193. Consider two other problems of allowing a firm to own a word: First, insisting that the public use a long descriptive phrase in order to name an object without recourse to a trademark forces the loss of expressive power. Consider Hemingway's writing style. He used short phrases or single words because they have more impact on their listeners than do long circumnambulations. Compare the following statements for ease of understanding: (1) "Counterfeit trademarks are illegal." (2) "Anyone who intentionally uses designations that are confusingly similar to marks registered on the federal Patent and Trademark Office's principle register and are used in interstate commerce, under the widest definition allowed by the Constitution's Commerce Clause, (that is, purposely engages in actions whether or not he knows that these actions are illegal or involve registered trademarks), in connection with the same type of goods as those for which the marks are registered, are subject to criminal and civil penalties." In the editorial voice of Russell Baker, "note that while all America pines for an end to governmental waste, it's impossible to stop our best-educated waste-haters from bloating an efficient one-syllable word like "waste" into a four-syllable monster like "redundancy." Russell Baker, *Monkey Business, Anyone?*, N.Y. Times, Apr. 14, 1992, at A25. Posner expresses a related point in economic terms. He objects to the cost of using the longer phrase. Landes & Posner, supra note 150, at 268-69.

Second, each word is irreplaceable, in the sense that no two words are fully synonymous theoretically.
William P. Alston, Philosophy of Language 44-47 (1964). Incomplete synonymy involves (a) words being interchangeable in some but not all sentences, (b) words being acceptable in different social situations, (c) words having different emotive force, (d) words invoking different associations, and (e) words being vague in different respects. Id. at 44-47, 93-96 (citation omitted).

Many battles over commercial terminology are really about association, not clarity. Consider Gallo's petition to the Bureau of Alcohol, Tobacco, and Firearms for permission to label sparkling wine made in vats with "Charmat Method," after its creator, rather than with its meaning, the verbally down-market designation, "bulk process." Importers objected that customers would confuse "Charmat Method" with the classic and expensive "me'thode champenoise." Howard G. Goldberg, Makers of Sparkling Wines in a Label Fight, N.Y. Times, Apr. 1, 1992, at C9. In the early days of the race for 1992's Democratic party presidential nomination, Paul Tsongas invoked the image of a panda bear to represent Bill Clinton's alleged pandering to the voters. Panda is not etymologically related to pander. The latter is derived from the medieval view of Pandarus, who obtained the favors of his niece Cressida for the Trojan hero Troilus. William Safire, Campaign Trailese, N.Y. Times, Apr. 12, 1992, 6 (Magazine), at 14, 15.

n194. Others contributed to the acceptance of the offered word as part of the common system of communication. See supra section I.B.2., The Second Function - A Joint Work, for a discussion of others' input into an advertising-promoted meaning. Many people who are not advertisers coin words in which they receive no property rights. Consider, for example, politicians, reporters, novelists, scientists, explorers. The meaning of "seven-year itch" was metamorphosed from a physical malady to the desire for sexual excitement seven years into a marriage by George Axelrod's use of the phrase in his 1952 Broadway hit. William Safire, The Seven-Year Itch, N.Y. Times, Mar. 29, 1992, 6 (Magazine) at 16. One could counter that these word-coiners derive personal benefits from the words they coin without "owning" them. This is true where an individual names something after himself and earns publicity from the term's use. But a reporter may coin a phrase which does not contain his name and others may reuse it without knowing the term's provenance. Consider too the mayhem that results if the offering side of a bargain has complete control; the paradigm of such a system is Newspeak, which was created by Big Brother in Orwell's 1984. See George Orwell, 1984 (1949).

n195. The extent to which the world, language, and people's understanding of the world are interdependent is an area of complex disagreement. But the most Cartesian of modern philosophers of language would agree that the term or grammatical structure used to describe the "object" influences the "subject's" understanding of its, perhaps independent, nature to some extent. This minimalist position is sufficient to support my legal conclusions. A more interdependent view increases the force of my argument. For a more detailed discussion, see infra notes 210-26 and accompanying text.

To illustrate with a classic semantic example: Judge Cardozo's opinion in Hynes v. New York Cent. R.R. Co., 131 N.E. 898, 898 (1921) (railroad responsible in tort for death of swimmer who jumped into the public river from a plank extending from the railroad's privately owned bulkhead) opened with the phrase, a "lad of sixteen." From that phrase alone, the reader could tell which way Cardozo would rule. If he had begun by saying "one member of a teenage gang," the reader would have made an opposite assumption. Category membership invokes many characteristics. By placing Harry Hynes in a linguistic category, Cardozo offered the reader a social category for the referent, and manipulated (allowed) his readers to assume that Hynes shared all the qualities of the invoked group. For a longer discussion of Cardozo's language choices in Hynes, see Richard Weisberg, When Lawyers Write 1.2 (1987).

Consider the name chosen by a lobbying group that opposes Senator Thurmond's suggested health warnings on advertisements for alcoholic beverages, the euphemistically named Freedom to Advertise Coalition, which is not a subset of the American Civil Liberties Union. Its primary members are the straightforwardly
named American Advertising Federation and the Distilled Spirits Council of The United States. Elliot, supra note 64. Consider too the difference in perception accorded a free newsletter, sent to dentists for patient distribution by the Princeton Dental Resource Center, after the Center's funding - 90% by M&M/Mars, the biggest candy manufacturer in the United States - was publicized. The newsletter stated: "So the next time, you snack on your favorite chocolate bar or bowl of peanuts ... remember - if enjoyed in moderation they can be good-tasting and might even inhibit cavities." Barry Meier, Dubious Theory: Chocolate A Cavity Fighter, N.Y. Times, Apr. 15, 1992, at A1.

n196. The vision of words as conferring power over thought is a common theme in literature. See, e.g., Orwell, supra note 194 (Newspeak created to prevent political disaffection); T.H. White, The Book of Merlyn 68-71 (1977) (ants' language lacked words for many things, which prevented them from asking philosophical questions). For a more technical discussion, see, e.g., Roger Fowler et al., Language and Control (1979) (variation in language reflects and interacts with social organization); Gunther Kress & Robert Hodge, Language as Ideology (1979) (relationship between control of the reader's thoughts and syntactical choices of the writer discussed in terms of transformational grammar theory). Many feminists agree with this theory: Consider Catharine MacKinnon's view of the power of pornographic literature to shape sexual stereotypes and behavior, and critiques of her position. See, e.g., American Booksellers Ass'n v. Hudnut, 771 F.2d 323 (7th Cir. 1985) (finding an anti-obscenity law authored by MacKinnon to be unconstitutional), aff'd, 475 U.S. 1001 (mem.), reh'g denied, 475 U.S. 1132 (1986); Drucilla Cornell, Sexual Difference, The Feminine, and Equivalency: A Critique of MacKinnon's "Toward A Feminist Theory of the State", 100 Yale L.J. 2247 (1991) (book review); Cass R. Sunstein, Feminism and Legal Theory, 101 Harv. L. Rev. 826 (1988) (book review of Catharine MacKinnon, Feminism Unmodified). MacKinnon sees sexuality as a social construct fueled by, inter alia, pornography, which she defines as literature showing violence against or suppression of women. Id. at 847.


n197. Even if the consumer realized the implied statement, he might buy the product with the generic trademark because he was not sure that other items without that word on the box were in fact functionally equivalent. Burgunder, supra note 8, at 400 (using the example that if "detergent" was a trademark, consumers might not be sure of the equivalence of goods labeled "laundry soap" or "clothes suds"). Theoretically, no two words are totally synonymous. See supra note 193.

n198. See, e.g., Barthel, supra note 56, at 39-40 (authoritative force of advertising is increased by failure to name the authority speaking); Clark, supra note 41, at 373-74 (children do not recognize the implied statements in advertisements but can be taught to recognize them); Fowler, supra note 196, at 3 (control exerted through language choices is more powerful because it is generally unnoticed by both speaker and hearer).

n199. But see Burgunder, supra note 8, at 396-401 (arguing that marks that become generic should only be canceled if this linguistic change actually lessens competition, which should be decided by evidence on the
elasticity of the demand curve).

n200. See, e.g., Anti-Monopoly v. General Mills Fun Group, 684 F.2d 1316 (Monopoly); Donald F.
Duncan, Inc. v. Royal Tops Mfg., 343 F.2d 655 (7th Cir. 1965) (yo-yo).


n203. MARLBORO may be a generic adjective. A Marlboro man is the type of man who smokes Marlboro
cigarettes. "The astronauts were space-age "Marlboro men." " Fox & Lears, supra note 35, at xvii. Please note
that I am not concluding that either ROLEX or MARLBORO have actually become generic adjectives, I am
simply using them to illustrate my theory of generic adjectives.

n204. See supra notes 57-80 and accompanying text. One commentator stated of Ralph Lauren that he had
earned the "ultimate accolade" of having his name become an adjective. Paul Goldberger, 25 Years of

This is a short modern step past metonymy, the figure of speech which refers to one item by using the name
of a closely associated object. "I've been lied to by suits all my life." Using suit to mean the type of person who
wears suits, that is, "formal, stiff, conventional." William Safire, Whacking the Suits, N.Y. Times, Apr. 26,
1992, 6 (Magazine), at 16. How much further are we going if we say, "I've been lied to by Brooks Brothers all
my life?"


n206. Walter Cook, The Logical and Legal Bases of the Conflict of Laws 167 (1942); Moffatt Hancock,

n207. Moore Paint's advertisements capitalize on this with references to the 1948 film Mr. Blandings Builds
His Dream House. Mr. Blandings Builds His Dream House (RCA Radio Pictures 1948). Mrs. Blandings wants
"the living room to be a soft green ... not as blue green as a robin's egg ... but not as yellow green as daffodil
buds. However, the only sample she could get was a little too yellow." Stuart Elliot, More Scenes From the Past

n208. Lotz, supra note 172, at 12.

n209. Many of the citations in this section are to relatively old works because the controversy has moved on
to more complex issues. Ray Jackendorff, for instance, is engaged in an analysis of human cognition based on
the model of the mind as a "biological information-processing device." Ray Jackendorff, Consciousness and the
Computational Mind, at xi (1987). But Jackendorff's disagreements with earlier linguists, id. at xi-xii, do not
include a belief that the mental image of reality reflected in language matches some objective physical reality.
Id. at 151.
n210. E. Sapir, Language: An Introduction to the Study of Speech (1921), quoted in Kress & Hodge, supra note 196, at 62 (Kress & Hodge reprinted the Sapir quote from Language, Thought and Reality: Selected Writings of Benjamin Lee Whorf 134 (J.B. Carroll ed., 1956)). As an illustration of this point, consider the effect of English syntax on a speaker's view of causation as discussed by Hodge and Kress:

The chain of translation from visual to linguistic entails a massive reinterpretation. The most significant effect or consequence of the reinterpretation is the introduction and imposition of a causal interpretation of events.

... The boy hit the ball... In English, the linear direction of the syntax, the word order, gives a conventional representation of the direction of the causal process, of what is acting on what. A relation of the two entities to the action is recorded. The subject is seen clearly as the initiator of the action, the first-mover as far as the action is concerned. (The ball hit the boy relates the same entities in a different causal sequence.)

Kress & Hodge, supra note 196, at 39-40. They clarify this by supplying pairs of sentences that could be used to describe the same observation using alternative forms they label "transactive" and "non-transactive":

"non-transactive: The rain fell on the seeds. transactive: The rain (water) moistened the seeds. non-transactive: The sun shone down on them. transactive: The sun warmed the soil." Id. at 49.

n211. Lotz, supra note 172, at 12-13.

n212. See supra note 208 and accompanying text. Lotz also mentions variations between languages in their treatment of what are expressed in English as pairs of opposites, for example, good-bad, beautiful-ugly. Some languages use one word for the entire dimension, for example, Latin's altus for "deep" or "high." Others use one English opposite as the base, and express the other as its negation, for example, Eskimo dialects express "beautiful" as "not-ugly." Lotz, supra note 172, at 11.

Kress and Hodge examine at length how speakers of the language manipulate categories to influence listeners. Kress & Hodge, supra note 196, at 62-82. This position, of course, assumes that language categories influence thought, and that the categories inherent in the common tongue are not a "straitjacket." Note, however, that many of the speaker's choices are creations of socialization and, therefore, "largely automatic." Fowler, supra note 196, at 185-86. Kress and Hodge focus on the speaker's choices. One could also focus on the text itself, or on the listeners' input. This, of course, is the debate fueling Deconstructionism. See, e.g., Stanley Fish, Introduction, or How I Stopped Worrying and Learned to Love Interpretation, in Is There a Text in This Class? 1 (1980). Reviewing his own change in position, Fish concludes that

Whereas I had once agreed with my predecessors on the need to control interpretation lest it overwhelm and obscure texts, facts, authors, and intentions, I now believe that interpretation is the source of texts, facts, authors, and intentions. Or to put it another way, the entities that were once seen as competing for the right to constrain interpretation (text, reader, author) are now all seen to be the products of interpretation.

Id. at 16. But see, e.g., Richard Weisberg, Legal Rhetoric Under Stress: The Example of Vichy, 12 Cardozo L. Rev. 1371 (1991) (using the example of anti-Semitism in Vichy France to argue that leaving texts completely malleable by the interpretive community has morally unacceptable outcomes in the real world). My limited thesis is supportable by any of these variations.

n213. Lotz, supra note 172, at 12.

n215. Id. at 15-18.

n216. The additional controversy as to whether or to what extent one should study real or ideal users of language is beyond the scope of this article. Chomsky uses ideal speakers, id.; Kress & Hodge, supra note 196, at 35 ("Chomsky wavered between adopting a "realist' position on syntax ... and a non-realist position."). While Fowler samples real language - actual spoken or written texts. Fowler, supra note 196, at 3.

n217. The power of such transformations of categories is the main thesis of Kress & Hodge, supra note 196. The book does not, however, specifically address the adjective/noun distinction.


n219. Diderot, supra note 218.

n220. Id. at 161-63, 214.

n221. Id. at 190-91, 215-16.

n222. Id. at 188 (quoting Racine, Phedre, act 5, sc. 6).

n223. Id. at 166.

n224. Id. at 187.

n225. Id. at 161-62. Sounding vaguely Whorfian, Diderot concludes that the syntax of various languages makes them more suitable for different purposes. Id. at 190-91. "French should be the language of society and of the schools of philosophy; Greek, Latin, and English, the language of our lecture-halls, pulpits, and theatres." Id. at 191.

n226. Id. at 161.

n227. A recent case approached, but did not reach, the existence of a generic adjective usable with multiple nouns. See Quality Inns Int'l v. McDonald's Corp., 695 F. Supp. 198 (D. Md. 1988) (totally enjoining the use of "McSleep Inn" as a tradename for motels by a firm not associated with McDonald's). McDonald's has a family of registered marks whose members are generic nouns with the prefix "Mc." Id. at 203. The defendant, Quality Inns Int'l contended that this prefix - similar to but not quite a free-standing adjective - had itself become generic, id. at 202, and therefore, any otherwise generic noun with this prefix attached is in the public domain. Id. at 215. Current third party use of "Mc" by the public was used as evidence, id. at 212-14, to support a suggested generic definition - "basic, convenient, inexpensive, and standardized." Id. at 216. The court rejected this argument with a logical ellipsis similar to that of the Vuitton court, supra notes 94-96 and accompanying text: "There was no single independent meaning of "Mc" understood in the language and its uses have been
created to convey any one of several attributes that the author makes to McDonald's. Quality Inns, 695 F. Supp. at 216. Furthermore, the court found that the defendant had acted in bad faith. Id. at 221. The fear of a finding of bad faith permeates the expert testimony on the generic meaning of "Mc." The "generic" meaning of "Mc" is "the type of product we expect from a McDonald's, i.e., basic, convenient, inexpensive, and standardized."

When Guide to Healthy Eating magazine sponsored a contest for the best vegetarian burger recipe, the New York Times dubbed it a "McVeggie." Toward the McVeggie?, N.Y. Times, Mar. 25, 1992, at C7. A historian's objections to the concept of education espoused by Whittle Communications and the former president of Harvard scoffed at "McSchools." Russell Jacoby, These Campus CEO's, N.Y. Times, June 1, 1992, at A17. (op. ed.). "Mc" may also be a synonym for the ubiquitous, like a McDonald's restaurant. Consider this sentence from a recent article on cancer research: The myc pronounced mick "gene is so frequently disturbed in cancer tissue, and in its normal guise it bears so many trademarks of being critical to the life and upkeep of all body cells, that researchers cannot help but call it McGene: everywhere they look, there is, the myc gene." Natalie Angier, A Pivotal Gene Commands Cells to Grow or Die, N.Y. Times, May 15, 1992, at C1.

The derivation of a generic meaning through reference to a commercial entity does not deprive the public of rights to that otherwise generic meaning, but consumers should be protected from confusion. The court properly decided to prevent the use entirely because survey-based factual findings showed that consumers would be confused, and no practicable method of disclaimer would prevent this confusion. Quality Inns, 695 F. Supp. at 222.


n229. This is also called the "fair use defense." McCarthy, supra note 9, 11:17 ("A junior user is always entitled to use a descriptive term in good faith in its primary descriptive sense."). "The Lanham Act ... under certain circumstances permits the nontrademark use of descriptive terms contained even in an incontestable mark." Park "N Fly v. Dollar Park and Fly, 469 U.S. 189, 201 (1985).

n230. See, e.g., Smith v. Chanel, Inc., 402 F.2d 562 (9th Cir. 1968) (allowing comparative advertising of perfume referring to Chanel No. 5 as a legitimate collateral use despite misappropriation and dilution claims). On remand the competitor was found to have violated Lanham Act section 43(a) by misrepresenting the extent and method of its duplication of Chanel’s scent. Chanel, Inc. v. Smith, 178 U.S.P.Q. (BNA) 630 (N.D. Cal. 1973).

n231. See, e.g., Robert C. Denicola, Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols, 1982 Wis. L. Rev. 158, 158-60 (extending protection of marks to non-confusing situations involves first amendment problems). But cf. Peter W. Smith, Note, Trademarks,

n232. See sources cited supra note 6.

n233. See, e.g., Lena Williams, Preaching the Gospel With the Shirt on Your Back, N.Y. Times, Mar. 29, 1992, 1, at 40 (spreading a message with lighthearted spiritual T-shirts such as, "Angels can fly, because they take themselves lightly.").


n236. They are the Second, Fifth, Eighth, and Eleventh Circuits. See cases cited infra sections II.C., United States v. Torkington, and II.D., Further Court Interpretation of the Act.

n237. Section 43(a) of the Lanham Act protects unregistered trademarks. See, e.g., Smith v. Montoro, 648 F.2d 602, 605 & n.3 (9th Cir. 1981).

n238. Good trademark lawyers will take full advantage of this for their clients, who do not include the general public. As Rolex stated, "Moreover, because of the apparent identity in substance of the definitions of 'counterfeit mark' in the criminal code and the Lanham Act ... the Court's resolution of the issues presented in this criminal appeal may have a profound impact on countless civil actions now pending." Brief of Amicus Curiae Rolex Watch U.S.A., Inc. in Support of the United States of America at v. United States v. Torkington, 812 F.2d 1347 (11th Cir. 1987) (No. 86-5155) hereinafter Rolex Brief. Several courts dealing with civil infringement suits have cited counterfeiting cases on the relevance of general or post-sale confusion. Educational Testing Serv. v. Touchstone Applied Science Assoc., 739 F. Supp. 847, 853 (S.D.N.Y. 1990) (United States v. Hom, 904 F.2d 803 (2d Cir. 1990)) (cited by court deciding an infringement, not a counterfeiting case, for the proposition that "confusion analysis includes confusion to non-purchasing public.")., cert. denied, 111 S. Ct. 789 (1991). Educational Testing referred to post-sale confusion on the part of student users of an educational product purchased for their use by teachers or school administrators. Torkington was cited in the infringement suit Louis Vuitton, S.A. v. After Dark Boutique, 680 F. Supp. 1507, 1511 (N.D. Fla. 1988) as a case where a criminal indictment was sustained even though the customers knew the merchandise was fake. The After Dark court did not expressly rely on that proposition. In some of the sales at issue the defendant had told her customers that the merchandise was genuine. Id. at 1509. Torkington, however, was relied on for the importance of post-sale confusion in Nabisco Brands v. Conusa Corp., 722 F. Supp. 1287, 1292 (M.D.N.C. 1989) (granting preliminary injunction against competing candy in same shape as Lifesavers). However, the post-sale confusion at issue in Nabisco was not confusion of casual viewers of the candy packages. It was confusion of candy eaters, who may or may not have been the actual purchasers. Id. at 1291, 1293. Nabisco cites two other cases in support of the importance of post-sale confusion: Polo Fashions v. Craftex, 816 F.2d 145 (4th Cir. 1987), and American Home Prods. v. Barr Labs, 834 F.2d 368, 371 (3rd Cir. 1987). See discussion infra notes 287, 344.

n239. Rolex Brief, supra note 238.
n240. Brief for Appellant Nam Ping Hon, United States v. Hon, 904 F.2d 803 (2d Cir. 1990) (No. 89-1424), cert. denied, 111 S. Ct. 789 (1991) hereinafter Hon Brief; Brief for the United States of America, Hon, 904 F.2d 803 hereinafter Anti-Hon Brief; Reply Brief for Appellant Nam Ping Hon, Hon, 904 F.2d 803 hereinafter Hon Reply; Petition for Rehearing on Behalf of Nam Ping Hon with a Suggestion for Rehearing En Banc, Hon, 904 F.2d 803 hereinafter Hon Petition; Brief for the Defendant-Appellant Firouz Yamin, United States v. Yamin, 868 F.2d 130 (5th Cir.) (No. 86-1581), cert. denied, 492 U.S. 924 (1989) hereinafter Yamin Brief; Brief for the United States of America, Yamin, 868 F.2d 130 hereinafter Anti-Yamin Brief; Brief of the Appellant Laura McEvoy, United States v. McEvoy, 820 F.2d 1170 (11th Cir.) (No. 86-5542), cert. denied, 484 U.S. 902 (1987) hereinafter McEvoy Brief; Brief of the Appellants Ross Lichen and Tropical Watch Company Inc., McEvoy, 820 F.2d 1170 hereinafter Lichen Brief; Brief for the United States, McEvoy, 820 F.2d 1170 hereinafter Anti-McEvoy Brief; Reply Brief of the Appellant Laura McEvoy, McEvoy, 820 F.2d 1170 hereinafter McEvoy Reply; Appellant's Brief, United States v. Gantos, 817 F.2d 41 (8th Cir.) (No. 86-1685), cert. denied, 484 U.S. 860 (1987) hereinafter Gantos Brief; Brief for Appellee, Gantos, 817 F.2d 41 hereinafter Anti-Gantos Brief; Brief for the United States, United States v. Torkington, 812 F.2d 1347 (11th Cir. 1987) (No. 86-5155) hereinafter Anti-Torkington Brief; Rolex Brief, supra note 238; Appellee's Brief, Torkington, 812 F.2d 1347 hereinafter Torkington Brief.

n241. At least one of the courts involved expressed some hesitation because of the public interest, even though that interest was not properly briefed. In conference with opposing counsel about proposed jury instructions, the Hon trial judge said he wished 18 U.S.C. 2320 could be invalidated, because "it is not in the public interest but, rather, in the interest of Mr. Rolex and Mr. Gucci... If you can figure out in any way on a setting aside basis ... I would be pleased to hear it, but I couldn't figure it out." Hon Brief, supra note 240, at 18.


n243. 1502, 98 Stat. at 2179. The definition continues: "or (B) a spurious designation that is identical with, or substantially indistinguishable from, a designation as to which the remedies of the Lanham Act are made available by reason of section 110 of the Olympic Charter Act." Id.


n245. The Second, Fifth, Eighth, and Eleventh circuits. See cases cited infra sections II.C., United States v. Torkington, and II.D., Further Court Interpretation of the Act.

n246. 812 F.2d 1347 (11th Cir. 1987).

n247. "Replica" will be used throughout this article to refer to merchandise crafted to be indistinguishable from the trademark owner's own products. This is not the exact terminology of the Act, which deals with merchandise or services for which the mark is registered on the principle register. 18 U.S.C. 2320(d)(1)(A)(ii). A mark registered for watches, for example, would be covered by the Act if it were reproduced without permission on watches obviously different in design from any model produced by the trademark owner, provided that the requisite "likelihood of confusion" exists. Such a "counterfeit" watch would not be a replica.
n248. Torkington, 812 F.2d at 1349. The Torkington briefs are especially interesting. The government and Rolex frame the issue as a choice between actual confusion of a direct purchaser and likelihood of confusion of the general public. Anti-Torkington Brief, supra note 240, at 7-8; Rolex Brief, supra note 238, at 6-7. The missing alternative is likelihood of confusion of actual or fairly likely purchasers, as pointed out by the defendant, Torkington Brief, supra note 240, at 2-3, and employed by the district court.

n249. Torkington, 812 F.2d at 1350.

n250. Id. at 1350. The disagreement was so deep that the circuit later remanded the case to another district judge. The original judge on the first remand had stated from the bench that the prosecution was "silly," a "vendetta" by Rolex, and "a waste of the taxpayers' money." While refusing to state that the district judge had actually dismissed the case at the first opportunity because he disagreed with the circuit's construction of the Act, the circuit, while reversing this dismissal, remanded to a different judge on the basis that such statements coupled with the legal decision they were reversing gave an "appearance of lack of neutrality." Id. at 1447.

n251. Id. at 1351.

n252. See, e.g., McBoyle v. United States, 283 U.S. 25, 27 (1931) (court should not construe federal statute intended to decrease automobile thefts to include airplane thefts).


n255. Torkington, 812 F.2d at 1352.


n258. The next most closely related statute is 19 U.S.C. 1526 (1988), which bars importation of certain merchandise bearing a trademark registered in the United States. This section deals inter alia with "counterfeit marks":

(e) Any such merchandise bearing a counterfeit mark (within the meaning of section 1127 of Title 15) the Lanham Act imported into the United States in violation of the provisions of section 1124 of Title 15, shall be seized and, in the absence of the written consent of the trademark owner, forfeited for violations of the customs laws.
Id. at 1526(e). Note that the word confusion is not used. "Counterfeit mark" is defined only by reference to the Lanham Act.

The forfeiture provisions of this section were last amended by the Customs Procedure Reform And Simplification Act of 1978, Pub. L. No. 95-410, Title II, 211(a), (c), 92 Stat. 903 (1978). The rejected procedure had allowed Customs to immediately sell seized goods with offending spurious marks still attached. This procedure was considered an ineffective sanction because it "put ... the counterfeit goods in competition with legitimate trademark goods." S.R. Rep. No. 778, 95th Cong., 2d Sess. 34 (1978), reprinted in 1978 U.S.C.C.A.N. 2211, 2245. While showing a congressional distaste for such competition, this language hardly qualifies as a gloss on the extent to which Congress, even in 1978, intended to criminalize the sale of goods bearing counterfeit marks. This same statute limited the items excluded by allowing entry of "articles accompanying any person arriving in the United States when such articles are inter alia for his personal use and not for sale." 15 U.S.C. 1526(d).

n259. Torkington, 812 F.2d at 1352-53.

n260. Id. at 1347.

n261. 817 F.2d 41 (8th Cir. 1987) (sale of replica Rolex watches is illegal even when purchaser is told the watches are not made by Rolex).

n262. Id. at 43. This point is especially interesting since Congress removed a proposed anti-dilution provision before passing the 1988 Trademark Revision Act. See discussion infra note 427 and accompanying text.

n263. 820 F.2d 1170, 1172 (11th Cir. 1987) (per curiam) (affirming a jury verdict against persons who sold watches spurious marked ROLEX, PIAGET, and GUCCI; unclear if actual customers were confused, government witnesses testified that "consumers frequently confuse these type of replica watches with their genuine counterparts."). The defense claimed that the actual watches sold were obviously junk and would deceive no one, even if well-made "counterfeits" were deceptive. McEvoy Brief, supra note 240, at 17-18.

n264. McEvoy, 820 F.2d at 1172-73.


n266. Id. at 133 (citing United States v. Torkington, 812 F.2d 1347, 1353 (11th Cir. 1987)).

n267. Id. at 132 (emphasis added). Note that the court used the plain-error standard of review because the defendant had not objected to the instruction when given. Id. The court said evidence that persons continually brought counterfeits in for repair by Rolex showed this was not plain error, since the "evidence was ... sufficient to permit the jury to find that the watches sold had the potential to deceive or to cause confusion or mistake." Id. at 133. This statement does not necessarily go as far as the jury instruction; it does not mention visitors or recipients of gifts. However, the circuit court also stated that the defendant "interprets "post-sale confusion' too narrowly." Id. Perhaps the circuit court fully agrees with the challenged jury instruction.

n269. Id. at 808, 805 n.1 (asking the jury to consider possible confusion by “persons who have no intention of purchasing a watch, such as the recipient of a gift or someone who simply views the watch.”).

n270. Id. at 807.

n271. Id. at 805.


n273. One could also state the latter point as this: all situations are advertising situations, since potential customers might be viewing the actions of an owner of “counterfeit” merchandise at any time.

n274. Several additional cases are cited in the briefs. None provides strong support for the thesis that general public confusion is relevant to the Lanham Act. Dallas Cowboy Cheerleaders v. Pussycat Cinema, 604 F.2d 200 (2d Cir. 1979) (cited in Anti-Hon Brief, supra note 240, at 13, 15), involved protecting the reputation of the Cheerleaders from tarnishment with those who saw the offending movie (Debbie Does Dallas, which features a girl occasionally clad in the uniform of the Cheerleaders, engaging in explicit sexual acts) or advertisements for it - all of whom might become customers of the movie, if not of the Cheerleaders. Harold F. Ritchie, Inc. v. Cheseborough-Pond’s, Inc., 281 F.2d 755, 761 (2d Cir. 1960) (BRYLCREEM for hair grooming aid versus VALRCREAM for directly competing product), and E. Remy Martin & Co. v. Shaw-Ross Int’l Imports, 756 F.2d 1525, 1529 (11th Cir. 1985) (REMY or REMY MARTIN for French cognac versus F. REMY for French wines), are cited for the proposition that actual confusion is not necessary to find infringement. Rolex Brief, supra note 238, at 19 & n.25. This statement of law is not disputed, what is disputed is whose likely confusion is relevant. Ritchie works against Rolex: the court discussed the likelihood of confusion of probable buyers of competing hair creams, and never considered confusion of persons who might see a tube of hair cream at another’s house. The majority implied that if “Brylcreem had ... acquired such a generic meaning in the public eye as to necessitate imitation of its name by a newcomer in the field” such copying, even if confusing to purchasers, would be allowable. Ritchie, 281 F.2d at 758 n.4. Similarly, the Remy court discussed the likelihood of confusion of alcoholic beverage purchasers - not viewers of the purchasers’ liquor cabinets. The court stated: “The question ... is not whether the purchasing public can readily distinguish wine from cognac but whether the products are the kind the public attributes to a single source.” Remy, 756 F.2d at 1530 (discussing the similarity of the products, one of the factors used to weigh likelihood of confusion). Rolex also argued that “reverse passing off cases” show the relevance of post-sale likelihood of confusion. Rolex brief, supra note 238, at 26 n.33 (citing Smith v. Montoro, 648 F.2d 602 (9th Cir. 1981); By-Rite Distributing v. Coca-Cola, 577 F. Supp. 530, 541 (D. Utah 1983)). Smith does not support Rolex’s position: In Smith, the defendant had removed the plaintiff’s name from the credits of a movie and substituted the name of another actor. The court considered it likely that this would confuse “the ultimate purchaser (or viewer) ... the movie-goer.” Smith, 648 F.2d at 607. “Viewer” here, is obviously the "viewer of the movie," that is, the ultimate purchaser of the entertainment service. By-Rite gives Rolex some support. By-Rite sold soda dispensing machines, Carb-A-Drink Self-Service Beverage Stations, to retailers who placed them where retail consumers themselves used the machines to refill their own plastic bottles. The machines offered a choice of many brands of soda; each spigot was marked with the appropriate trademark. By-Rite also sold bottles for use with the machine. By-Rite asked the court to force
certain producers of soda-syrups to sell it their products. The syrup would be mixed by the Carb-A-Drink machines and bottled by the consumers themselves. The producers counterclaimed for, inter alia, trademark infringement, and successfully asked for preliminary injunctions. The court found that By-Rite was likely to be held a trademark infringer for two reasons, By-Rite, 577 F. Supp. at 540-41; only the second is relevant to Rolex's argument. First, soda-syrup manufacturers have two distinct types of products that are different in carbonation, sweetness, etcetera. One syrup is sold to fountains, which mix it with other ingredients and sell the resulting soda for immediate consumption. The other is sold to licensed bottlers who mix and package it for resale in cans and bottles. Bottling is done only under strict quality standards which are necessary to preserve the quality of the final beverage since it is stored for long periods before consumption. Id. at 535-36. The machines sold by By-Rite did not employ such quality control. A consumer who bought Coca-Cola, for example, from such a machine would use the product at a later date and find it well below Coca-Cola's own bottling standards. Id. at 536-37. Then, too, the person who fills the bottle might use a bottle with one trademark for the soda of another manufacturer; the ultimate consumer of this liquid might be a different person who does not realize that the beverage he drinks does not match the brand on the bottle. Id. at 535. This is post-sale confusion of a nonpurchaser as relevant to reverse passing off. But note several points that undermine Rolex's use of this case: First, it is one prong of a two-prong holding; the court may not have made the same decision without the other prong. Second, the confused person is still a user of the soda, not a mere viewer of the soda bottle. Third, this behavior is unacceptable, not only because it tarnishes the reputation of Coca-Cola (which would be similar to Rolex's claim), but because it uses the goods of Coca-Cola to help another's reputation. ("To the extent that they the final drinkers of the mis-marked soda are satisfied with the product, only Carb-A-Drink By-Rite's machine will benefit." Id. at 541.) Rolex's final authority is a preliminary injunction in a later case. Rolex Watch U.S.A. v. Turner, (No. 86-6441) (S.D. Fla. July 10, 1986) (order granting preliminary injunction, included as item 1 in Appendix to Rolex Brief) hereinafter Turner Injunction (cited in Rolex Brief, supra note 238, at 2-3). The same trial judge who dismissed the charges against Torkington granted a preliminary injunction against another alleged dealer in counterfeit watches, despite his finding of fact that the watch sales at issue were "likely to cause confusion, to cause mistake, and/or deceive the public but not the individual purchaser." Id. at 4 (finding of fact No. 12). This is, of course, only indirectly a finding about the Lanham Act, but it shows a clear change of opinion about the Counterfeit Trademark Act by this judge. His reasons, however, are not shown by this order, nor is there any indication that his decision relied on any information presented on the public's behalf. In this instance, the opposing party did not even appear. Id. at 1, 8.

n275. G.H. Mumm Champagne v. Eastern Wine, 142 F.2d 499 (2d Cir. 1944), cited in Hon, 904 F.2d at 807. None of the briefs on appeal mentioned functionality, genericism, or collateral use. Brief for the Defendant-Appellant, Mumm, 142 F.2d (No. 19088) hereinafter Eastern Wine Brief; Brief for Plaintiffs-Appellees, Mumm, 142 F.2d (No. 19088) hereinafter Mumm Brief; Reply Brief for the Defendant-Appellant, Mumm, 142 F.2d (No. 19088) hereinafter Eastern Wine Reply Brief. The only congruent argument was the claim that third parties' use of red stripes or ribbons on liquor bottles placed such markings in the public domain. See Mumm Brief, supra, at 19-24 (rebutting this argument allegedly made by Eastern Wine). Eastern Wine, however, claimed Mumm was rebutting the wrong allegation. See Eastern Wine Reply Brief, supra, at 11-12 (only word mark CORDON ROUGE is at issue).

n276. An intermediate scenario would involve the customer's collusion with the restauranteur to serve the entire table cheap champagne in bottles of a high-priced brand at an appropriately reduced price.

n277. Mumm, 142 F.2d at 501-02 (emphasis added).

n278. 221 F.2d 464 (2d Cir. 1955) (reasoning based on unfair competition rather than statute), cert. denied,
350 U.S. 832 (1955), cited in Hon, 904 F.2d at 807.

n279. The similarity was not as close as that objected to by Rolex in the cases under the Act. First, the Model 308 was marked "Mastercrafters," not "Vacheron." Second, only the Model 308 had an electric cord. Id. at 467. One could argue that this case was wrongly decided due to these differences between the products.

n280. Id. at 466.


n282. See infra notes 423-27 and accompanying text.

n283. 437 F.2d 566 (2d Cir. 1971), cert. denied, 111 S. Ct. 789 (1991), cited in Hon, 904 F.2d at 807; *United States v. Torkington*, 812 F.2d 1347, 1351 (11th Cir. 1987).

n284. Syntex, 437 F.2d at 568 n.1.

n285. In 1962, Congress deleted "purchasers as to the source of origin of such goods or services" from the federal infringement section of 15 U.S.C. 1114(1). Id. at 568.

n286. Id.

n287. Somewhat similar is the over-the-counter drug case, *American Home Prods. v. Barr Labs.*, 834 F.2d 368 (3d Cir. 1987), cited in *Nabisco Brands v. Conusa Corp.*, 722 F. Supp. 1287, 1292 (M.D.N.C. 1989), for the proposition that post-sale confusion is relevant in the Lanham Act, see supra text note 238). The trial court denied injunctive relief to a manufacturer of ibuprofen tablets, finding that neither the defendant's packages nor their tablets were likely to confuse viewers. The court of appeals affirmed these findings as not clearly erroneous. The American Home court considered the distinctive features of the tablets relevant to post-sale confusion, and implied that persons whose confusion should be considered were swallowers of the tablets.


n289. *Cross*, 470 F.2d at 690.

n290. Id. at 691.

n291. Id. at 692.

n293. Comparative advertising, while not actually illegal, was simply not done through the late 1960s. Only in the 1970s did explicit references to one's competitors proliferate. 3 George E. Rosden & Peter E. Rosden, Law of Advertising 31:01 (1992).

n294. 523 F.2d 1331 (2d Cir. 1975), cited in United States v. Torkington, 812 F.2d 1347, 1353 (11th Cir. 1987).

n295. Grotrian, 523 F.2d at 1336 n.8. ("It is undisputed that the parties are in direct competition in terms of price range, type of instrument and quality.").

n296. Id. at 1341 (quoting the lower court).

n297. Id. at 1342. The court used "hearing" purposely; while the names looked different, they were pronounced almost identically when the distributor's instructions were followed. The advertising brochure stated that "the name should be pronounced as shown phonetically thus GRO-TREE-AN SHTYNE-VAKE: the final letter K being soft or voiceless." Id. at 1338.

n298. Id. (defendant's instructions to their dealers increased the likelihood of confusion).


n300. The grill and statue were functional on earlier models. Rolls-Royce, 428 F. Supp. at 691.

n301. Id. at 694 n.10.

n302. Id.

n303. The circuit court failed to cite another Rolls-Royce case that provides clearer support for their position, Rolls-Royce Motors v. Custom Cloud Motors, 190 U.S.P.Q. (BNA) 80 (S.D.N.Y. 1976) (infringement was found where a firm made customizing kits for Chevrolet Monte Carlo automobiles). The court mentions a survey of one hundred persons stopped at random in midtown Manhattan which demonstrated that a majority of them mistakenly identified a picture of a customized Monte Carlo as a Rolls-Royce product. It is worth noting here that the $ 3,000 kit in this case, id. at 80, is closer in price to a real Rolls-Royce grill than the $ 500 to $ 900 for an A & A kit, A & A Fiberglass, 428 F. Supp. at 691 n.5. In addition, the defendant used the designation, "Custom Cloud," which was held to be confusing with the Rolls-Royce "Silver Cloud" mark. Custom Cloud, 190 U.S.P.Q. (BNA) at 81; see also Esercizio v. Roberts, 944 F.2d 1235 (6th Cir. 1991) (replica of Ferrari infringes original; perception of "public" is relevant to finding of confusion), cert. denied, 112 S. Ct. 3028 (1992).


n305. Id. at 1235.
n306. *Id.* at 1235-36.


n308. *Boston Professional Hockey*, 510 F.2d at 1004. Because of Rolls-Royce's precedential dependence on *Boston Professional Hockey*, the latter case will be discussed here out of chronological order. *Boston Professional Hockey* is cited in *United States v. Torkington, 812 F.2d 1347, 1352 (11th Cir. 1987).*

n309. See, e.g., *International Order of Job's Daughters v. Lindeburg and Co.*, 633 F.2d 912, 918 (9th Cir. 1980) ("We reject the reasoning of *Boston Hockey*... Our reading of the Lanham Act and its legislative history reveals no congressional design to bestow such broad property rights on trademark owners."), cert. denied, 452 U.S. 941 (1981); *University of Pittsburgh v. Champion Prods.*, 566 F. Supp. 711, 719 (W.D. Pa. 1983) ("We believe that it is not the province of the courts to create a property right in gross out of legislation intended solely to protect the consuming public and ethical businessmen... We do not believe that *Boston Hockey* is good law."); *General Mills v. Henry Regnery Co.*, 421 F. Supp. 359, 362 n.2 (N.D. Ill. 1976) ("A broad reading of the *Boston Pro Hockey* decision would change the focus of the trademark laws from the protection of the public to the protection of the trademark owner's business interest... This court declines to follow.").

n310. *Boston Professional Hockey*, 510 F.2d at 1011.

n311. *Id.* at 1012.

n312. *Kentucky Fried Chicken v. Diversified Packing*, 549 F.2d 368, 389 (5th Cir. 1977). The court clarified its basic position by stating: "Our cases demonstrate unbroken insistence upon likelihood of confusion, and by doing so they reject any notion that a trademark is an owner's 'property' to be protected irrespective of its role in the operation of our markets." *Id.* at 388-89.

n313. 540 F.2d 1181 (4th Cir. 1976), cited in *United States v. Hon, 904 F.2d 903, 908 (2d Cir. 1990)*, cert. denied, 111 S. Ct. 789 (1991); *United States v. Torkington, 812 F.2d 1347, 1352 (11th Cir. 1987).*

n314. Foy, 540 F.2d at 1183.

n315. *Id.* at 1185.

n316. *Id.* at 1187.

n317. Rolex watches, however, are luxury items whose likely purchasers are a severely limited class.

n319. T & T Mfg., 449 F. Supp. at 822. Addition of distinguishing matter to an allegedly confusing mark may help or hurt the junior user. The cases are very fact-specific. See generally McCarthy, supra note 9, 32:15(H) (defendant's addition of clarifying matter).


n321. Id.

n322. See supra notes 283-93, 299-310 and accompanying text.

n323. 632 F.2d 817 (9th Cir. 1980), cited in United States v. Torkington, 812 F.2d 1347, 1352 (11th Cir. 1987).

n324. Strauss, 632 F.2d at 822.

n325. Id. at 822.

n326. Id. at 822 n.7. The same circuit sitting en banc refused to expand this protection when Levi Strauss complained of Wrangler's use of projecting tab labels on shirts. Levi Strauss & Co. v. Blue Bell, Inc., 778 F.2d 1352 (9th Cir. 1985). This later Strauss case does not clearly support my point. Protection was not granted for the tab on shirts, however, in dicta, the court implied that the opinions of persons who might see the tab on clothes worn by others was relevant to the confusion decision. Id. at 1361 ("Further, the possibility that the surveys of purchasers of both companies' products were artificial or unreflective of the views of persons who simply notice Blue Bell shirts during casual street encounters was diminished by the use of shirt tabs by both parties over several years and their substantial presence in the shirt market."). The dissent formulates the confusion standard, apparently in favor of my thesis, as how the mark is perceived in "the marketplace," id. at 1365 (Nelson, J., concurring in part and dissenting in part), though apparently defining "marketplace" as somehow larger than "the point of sale." Id. The dissent also makes a strong argument for protection based on the "related goods" doctrine. Id. at 1362-63.


n328. For discussion of the legislative history of section 1114(1), see infra section II.E.3.a.ii., The Argument From 15 U.S.C. 1114(1).


n330. Id. at 843.

n331. Id. at 842.
n332. Id. at 844.

n333. Id.

n334. Id. at 844-45.

n335. The court granted a preliminary injunction, but not on the basis of the state law dilution claims. Id. at 848-49.

n336. Id. at 840 (citing Oburn v. Shapp, 521 F.2d 142 (3d Cir. 1975)).

n337. 711 F.2d 966 (11th Cir. 1983), cited in United States v. Torkington, 812 F.2d 1347, 1352 (11th Cir. 1987).

n338. It is signalled by "see also." Torkington, 812 F.2d at 1352.

n339. Id.

n340. Harland, 711 F.2d at 979 n.22 (citing McCarthy, supra note 9, 23:27).

n341. 799 F.2d 867 (2d Cir. 1986), cited in Torkington, 812 F.2d at 1352 (post-sale context relevant to confusion analysis).

n342. A.T. Cross Co. v. Jonathan Bradley Pens, 470 F.2d 689 (2d Cir. 1972); for discussion of case see supra notes 288-93 and accompanying text.

n343. Lois Sportswear, 799 F.2d at 870-71.

n344. Id. at 872. Polo Fashions v. Craftex, 816 F.2d 145 (4th Cir. 1987), is somewhat similar to Lois Sportswear. Polo Fashions concerns a manufacturer of knit shirts who used a breast pocket symbol which closely resembled Ralph Lauren's registered polo player. The inside neckband of the shirts bore the totally dissimilar mark, KNIGHT OF ARMOR. The Polo court, however, affirmed a finding of infringement. Evidence had been presented that customers questioned retailers as to the shirts' origin. The court reasoned that customers could believe Ralph Lauren had started a new KNIGHT OF ARMOR line. The court stated an additional reason: that someone who

in the after sale context, saw the shirt being worn by its owner, would not see the label on the back of the neck. Seeing the polo player symbol, it is likely that the observer would identify the shirt with the plaintiff, and the plaintiff's reputation would suffer damage if the shirt appeared to be of poor quality.

Polo Fashions, 816 F.2d at 148 (citing Lois Sportswear, 799 F.2d at 867). Note that the Polo court used dilution logic. This is not appropriate in construing the limitations of the Lanham Act. See discussion infra notes 422-27 and accompanying text. Polo Fashions was cited by Nabisco Brands v. Conusa Corp., 722 F. Supp. 1287, 1291.
(M.D.N.C. 1989), which also cites United States v. Torkington, 812 F.2d 1347 (11th Cir. 1987).

n345. Lois Sportswear, 799 F.2d at 873 (citing Grotrian, Helfferich, Shultz, Th. Steinway Nachf. v. Steinway & Sons, 523 F.2d 1331, 1342 (2d Cir. 1975); for a discussion of that case, see supra notes 294-98 and accompanying text).

n346. Lois Sportswear, 799 F.2d at 872-73 (citing Syntex Labs. v. Norwich Pharmacal Co., 437 F.2d 566, 568 (2d Cir. 1971); for discussion of that case, see supra notes 283-87 and accompanying text).

n347. Lois Sportswear, 799 F.2d at 972-73 (citing Levi Strauss & Co. v. Blue Bell, 632 F.2d 817 (9th Cir. 1980); for discussion of that case see supra notes 323-26 and accompanying text).

n348. See supra note 326 and accompanying text.

n349. Lois Sportswear, 799 F.2d at 871.

n350. Id.


n354. Canner, the civil case, makes one additional argument that was not repeated by any of the circuits. The Canner court found that the requisite confusion to find trademark infringement as defined by section 32(1) of the Lanham Act, 15 U.S.C. 1114(1), is created by introducing "counterfeit goods ... into "commerce or' ... the interchange of goods in the market place" Canner, 645 F. Supp. at 487-88. The Lanham Act's definition of a counterfeit is "a spurious mark which is identical with, or substantially indistinguishable from, a registered mark." 15 U.S.C. 1127 (1988). For purposes of ex parte seizure of goods bearing counterfeit marks, the Trademark Counterfeiting Act of 1984, Pub. L. No. 98-473, 1503(1)D, 98 Stat. 2178, 2180 gave the Lanham Act a new definition for "counterfeit mark":

(i) a counterfeit of a mark that is registered on the principal register in the United States Patent and Trademark Office for such goods or services sold, offered for sale, or distributed and that is in use, whether or not the person against whom relief is sought knew such mark was so registered; or

(ii) a spurious designation that is identical with, or substantially indistinguishable from, a designation as to which the remedies of this Act are made available by reason of section 110 of the Act entitled "An Act to incorporate the United States Olympic Association," approved September 21, 1950 (36 U.S.C. 380).

Trademark Counterfeiting Act of 1984, Pub. L. No. 98-473, 1503(1)D, 98 Stat. 2178, 2180 (codified as amended at 15 U.S.C. 1116 (1988)). This definition does not require a showing that anyone would confuse the products involved with those handled or sponsored by the complainant. But this definition is only for the purposes of ex
parte seizure orders; it is irrelevant to infringement. The Canner court used the ex parte seizure provision to expand "likelihood of confusion" to any imaginable use of a product - even in infringement cases when a specific use situation exists.


n358. Id. at 803. The animus against infringers central to the Hon court's distortion of the Second Circuit's usual standard is highlighted by later Second Circuit cases, which return to the older rhetoric. See, e.g., Johnson & Johnson * Merck Pharmaceuticals Co. v. Smith-Kline Beecham Corp., 960 F.2d 294, 297-98 (2d Cir. 1992) ("The question in such cases is - what does the person to whom the advertisement is addressed find to be the message? ... That is, what does the public perceive the message to be?" (citation, internal quotations, emphasis omitted)) (note that the public here equals the targets of the advertising); Lang v. Retirement Living Publishing Co., 949 F.2d 576, 579 (2d Cir. 1991) (central issue is likelihood of confusion of "ordinary prudent purchasers").


n360. Hon, 904 F.2d at 808. Note that one could focus on the court's mention of 18 U.S.C. 2320 to keep this standard separate from that of the Lanham Act, but that seems a strained interpretation, after the court's declaration that "Congress wished to incorporate the Lanham Act's confusion requirement into 18 U.S.C. 2320 and did so." Id. at 805.

n361. See infra section II.E.3.a.i., The Purpose of the Act.

n362. See infra note 427.


n367. Schwinn Bicycle v. Ross Bicycles, 870 F.2d 1176, 1185 (7th Cir. 1989).

n368. Eclipse Assocs. v. Data General, 894 F.2d 1114, 1117 & nn.2-4 (9th Cir. 1990); see also Intel v. Advanced Micro Devices, 756 F. Supp. 1292, 1293-95 (N.D. Cal. 1991) (when considering confusion and genericism of designation for a microprocessor, the relevant persons are its knowing purchasers - the manufacturers who buy it for incorporation into their products).


n372. Electronic Design, 954 F.2d at 714.

n373. Id. at 715.


n376. Id.; see infra section II.E.3. Legislative History.

n377. Electronic Design, 954 F.2d at 716. Compare these cases relied on by Electronic Design: Astra Pharmaceutical Prods. v. Beckman Instruments, 718 F.2d 1201, 1206 (1st Cir. 1983) ("If likelihood of confusion exists, it must be based on the confusion of some relevant person; i.e., a customer or purchaser."); affirming summary judgment that ASTRA on blood analyzer does not infringe ASTRA on pharmaceuticals even though both may be ordered by same purchasing agent) with Ferrari S.P.A. Esercizio Fabriche Automobili E Corse v. Roberts, 944 F.2d 1235, 1245 (6th Cir. 1991) (replicas of Ferraris infringe the trade dress shape of the originals because the public cares who makes the car), cert. denied, 112 S. Ct. 3028 (1992).

The Electronic Design court explained that for non-commercial mark-holders, such as the American Red Cross, relevant persons would be those who would know of the mark-holders services and then become purchasers of the goods or services of others. Electronic Design, 954 F.2d at 716.

n379. Id. at 718-19; see also Carter-Wallace, Inc. v. Procter & Gamble, 434 F.2d 794, 804 (9th Cir. 1970) (only probable not possible confusion is relevant) (cited in Electronic Design, 954 F.2d at 719); Witco Chem. v. Whitfield Chem., 418 F.2d 1403, 1405-06 (1969) (consider only "practical likelihood ... not theoretical possibility of confusion," taking into account "the actual and potential purchasers" who are going to do the distinguishing when purchasing the item) (cited in Electronic Design, 954 F.2d at 717).

n380. Id. at 719. See discussion of standing, supra note 11.

n381. Electronic Design, 954 F.2d at 719 (quoting 15 U.S.C. 1052(d)).

n382. American Waltham Watch v. United States Watch, 53 N.E. 141, 142 (1899) (common law unfair competition case requiring second watch manufacturer in Waltham, Mass. to use disclaimer to prevent customer confusion with the first company).

n383. The Second Circuit's recent tightening of the showing to allow such a limited injunction is, therefore, irrelevant, Home Box Office v. Showtime/Movie Channel, 832 F.2d 1311, 1316 (2d Cir. 1987) (affirmative burden on infringer to show that disclaimer would reduce confusion), as is the debate over whether viewers notice disclaimers. See, e.g., Jacob Jacoby & Robert L. Raskopf, Disclaimers in Trademark Infringement Litigation: More Trouble Than They Are Worth?, 76 Trademark Rep. 35 (1986) (studies show disclaimers do not prevent consumer confusion about product source); Mitchell E. Radin, Disclaimers as a Remedy for Trademark Infringement: Inadequacies and Alternatives, 76 Trademark Rep. 59 (1986) (disclaimers of source are not the most effective form of limited injunctive relief). Cases allowing disclaimers which are visible to later observers of the product do not prove that such visibility is necessary to the use of a disclaimer. A court that allows a removable disclaimer is, however, supporting my point. The Second Circuit places the burden of showing the usefulness of the disclaimer on the infringer, but it does allow disclaimers. Home Box Office, 832 F.2d at 1315.

n384. Interpart Corp. v. Italia, 777 F.2d 678, 682-84 (Fed. Cir. 1985) (rearview mirror for automobiles does not infringe under Lanham Act section 43(a) because it is usually sold in a box that specifies the manufacturer, and is always sold with a silver and black mylar label; this holding is the Federal Circuit's nonbinding opinion of law in the Ninth Circuit).

n385. Calvin Klein Cosmetics Corp. v. Parfums de Coeur, 824 F.2d 665, 669 (8th Cir. 1987).

n386. Id. at 671-72.


n388. Of course, if the used or rebuilt merchandise is repackaged in a way that could confuse the purchaser, a disclaimer will be ordered. See, e.g., id. at 130 (with a sufficient disclaimer, rebuilt Champion spark plugs may be sold without removing the trademark from each plug).

beginning of Chapter XV on Trademark Counterfeiting. Id. at 98 Stat. 2178.

n390. H.R. Rep. No. 997, 98th Cong., 2d Sess. 4-7 (1984) which accompanied a different version of the bill than the one actually enacted. See discussion of changes in bill language supra section II.E.3.b., The Legislative History Ignored by the Circuits.


n392. Id. at 5.

n393. "Buyer" means primarily "one who buys, a purchaser." 2 Oxford English Dictionary 722 (2d ed. 1989). This meaning, with variations in spelling, dates back at least as far as the fourteenth century. Id. The secondary, more specialized meaning, is "one employed by a mercantile house to conduct the purchase of goods." Id.


n395. Id. at 6. Note also that the report was accompanied by "Additional Views of Robert W. Kastenmeier on H.R. 6071." Id. at 35-36. Representative Robert W. Kastenmeier (Democrat, Wis.) gave approval to the bill because of the subcommittee chairman's "sustained effort ... to draw a delicate balance between the competing interests involved in the legislation." Id. at 36. However, he expressed strong doubts that criminal sanctions were appropriate for trademark problems, id. at 35, and then only in "the narrowest circumstances." Id.


n397. Legitimate businesses suffer the losses of billions of dollars every year to counterfeiters, and I am interested to note that the problem extends to all types of manufacturing activity. The victims of counterfeiting are not limited merely to the disappointed consumers of luxury goods. It actually goes to equipment machinery which is capable of resulting in fatal accidents.

Id. at 1 (opening statement of Senator Mathias).

n398. Id. at 11-13 (statement of William F. Baxter, Assistant Attorney General, Antitrust Division).

n399. Id. at 22 (statement of Simon P. Gourdine, Commissioner, N.Y.C. Dept of Consumer Affairs).

n400. Id. at 26 (discussing Izod; paraphrase of Izod's response by Mr. Gourdine).

n401. See, e.g., id. at 85-98 (testimony of David R. Haarz, Esq., Attorney for Trademarks and Bankruptcy, K Mart Corp., on behalf of the Association of General Merchandise Chains).

n403. "Clearly, something must be done to help businesses fight the debilitating economic effects of counterfeiting and to protect the consumer from shoddy and life threatening products." Id. at 2.


n405. Id. at 106-11 (statement of Guy M. Blynn). Mr. Blynn points out that:

There has been no express recognition that actions to enforce rights in trademarks find their underpinnings in one, or the other, or both, of at least two different - and unrelated - philosophies: the desire to prevent confusion among those encountering a trademark and the desire to protect an owner's rights in property against (mis)appropriation by another, whether or not confusion is likely to be caused thereby. The differing interests to be protected might dictate differing answers to the question of whether someone should be imprisoned or penalized heavily for a particular activity.

Id. at 108.


n407. The Torkington court says the legislative history of the Act shows reliance on Lanham Act section 1114(1), United States v. Torkington, 812 F.2d 1347, 1351 n.4 (11th Cir. 1987), and is obviously correct. What is not obviously correct is that Congress chose the current language of the Lanham Act for any reason other than its currency.

n408. See infra section II.E.3.b., The Legislative History Ignored by the Circuits.

n409. 437 F.2d 566, 568 (2d Cir. 1971).


n411. See supra notes 283-87, 299-310 and accompanying text.

n413. The general purpose statement in the House and Senate reports that recommended passage of the bill are identical.

The purpose of this legislation is to make a number of miscellaneous changes in the Trademark Act of 1946 so as to clarify the meaning of several of its provisions. The provisions of the bill affect details of registration, administrative and court procedure, internal organization of the Patent Office regarding trademark matters, and refinements in language that experience has shown to be desirable. It also corrects typographical errors in the Trademark Act of 1946.


n414. The Senate report states:

Section 17 of the bill proposes to rewrite section 32(1) 15 U.S.C. 1114(1), making several changes and rearranging the language.

One change is the omission of the underlined words from the following quotation from clause (a):

"on or in connection with which such use is likely to cause confusion or mistake or to deceive purchasers as to the source of origin of such goods or services" This change is parallel to a similar change made in section 2(d) of the act.


Section 1 of the bill proposes to amend, in several respects, section 1(a)(1) of the act, which relates to the statements required of an applicant for registration of a trademark.

The first amendment proposes to amend the phrase which now reads: "that no other person ... has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as might be calculated to deceive" by cancelling the underscored words and substituting "as to be likely, when applied to the goods of such other person, to cause confusion, or to cause mistake, or to deceive." The purpose of this amendment is to make the required allegation of the applicant more nearly complete and more accurate.


n416. See discussion supra notes 273-74 and accompanying text.

1977) (court finding that MUSHROOM for women's apparel does not infringe MUSHROOMS for women's shoes, even though the Patent and Trademark Office had refused registration due to likelihood of confusion), aff'd, 580 F.2d 44 (2d Cir. 1978). Such a refusal is evidence weighing against the alleged infringer. See generally McCarthy, supra note 9, 23:24(B) (effect of Trademark Office's section 2(d) decision in later litigation).

n418. "Purchasers" was also removed from the definition of "colorable imitation" in line with the amendment to section 2(d) of the act. S. Rep. No. 2107, at 8, 1962 U.S.C.C.A.N., at 2851. See also H. Rep. No. 1108, at 8.


n422. 1954 Hearings, supra note 421, at 5 (text of section 22 of proposed S. 2540, amending section 32 of the Lanham Act).

n423. Id. at 54 (language includes newspapers) (remarks of Wallace R. Martin, acting chairman of the Subcommittee on Trademarks of the Committee on Patents of the Nat'l Assoc. of Mfrs.); id. at 96 (language includes books and dictionaries) (written remarks of Thurston B. Murton); id. at 100 (includes dictionaries and the broadcast media) (written remarks of Louis Robertson).

n424. Id. at 55 (discussion between Senator Wiley and Mr. Martin).

n425. Id. at 53 (free speech problem) (remark of Senator Wiley); id. at 85 (interfering with international trade by preventing distribution of dictionaries and other literature) (written remarks of Thurston B. Murton); id. at 99-101 (harassment of publishers and broadcasters) (written remarks of Louis Robertson).

n426. We should not overlook the fact that it is extremely rare for publishers or broadcasters to do much worse along this line than to reflect the already existing state of the public mind. Furthermore, it is rare that this state of the public mind exists without a great deal of fault on the part of the trade-mark owner.

Id. at 100 (written remarks of Louis Robertson).
n427. The proposed version included a new section 43(c), creating a federal cause of action for dilution of famous marks (therefore, not all marks) listed on the principal register. S. Rep. No. 515, 100th Cong., 2d Sess. 41-43 (1988), reprinted in 1988 U.S.C.C.A.N. 5577, 5604-06. This version was not passed. Representative Kastenmeier told the House that "the committee's decision not to include proposed provisions relating to dilution ... is carried forward. By this decision, current law remains in effect." 135 Cong. Rec. H1217 (1989) (correction of Cong. Rec. of Oct. 19, 1988) (statement of Representative Kastenmeier). Senator DiConcini stated that the failure to enact this provision should not be viewed as a total rejection of the principle of dilution law in general. 134 Cong. Rec. S16,972 (1988). The legal effect of such statements is debatable.

n428. Two different versions of the pending bill are printed with the 1954 hearings. 1954 Hearings, supra note 421, at 1 (proposed S. 2540); Id. at 6 (Amendment on the Nature of a Substitute). The differences are not germane to this article.


n430. 1954 Hearings, supra note 421, at 80 (written remarks of Louis Robertson).

n431. Id. at 19 (change needed to prevent misconstruction) (written report of the Patent Office); id. at 37 (Lanham Act was intended to codify common law at time it was written but use of word "purchasers" has resulted in an interpretation narrower than intended. No cases are cited to support the latter contention.) (written remarks of John T. Love); id. at 63 (proposed change merely clarifies standard originally intended, which was a restatement of the common law) (written remarks of Steward W. Richards).

n432. 1961 Hearings, supra note 420, at 27 (catalog of 2800 cases developed for the American Law Institute's revision of the Restatement of Torts shows protection includes potential purchasers and the public; no cases cited) (remark of Daphne Leeds, United States Trademark Ass'n); id. at 41-42 (listing cases protecting the public from confusion under both the Lanham Act and the common law of trademarks) (statement of James F. Hoge, United States Trademark Ass'n). But see id. at 8-9 (cases under the Lanham Act and the common law consider likelihood of confusion of "the ordinary purchaser": no cases cited) (remar ks of Francois N. Palmatier, attorney opposing the change).

Since neither Palmatier nor Leeds support their assertions with case citations, we cannot readily evaluate their testimony. Hoge produced a list of cites - all registration cases - but none support his point. A mark may not be registrable and yet not infringe an existing registration. Some of the courts' language includes mention of the public, but conversely, some of it discusses potential purchasers. Since these are not infringement cases, none of the courts holds when confusion of the "general public" becomes infringement. Furthermore, these courts do consider the context in which the products are sold when deciding if confusion is likely to bar registration. Merritt Corp. v. Sterling Drug, 47 C.C.P.A. 939, 125 U.S.P.Q. (BNA) 584 (C.C.P.A. 1960) (sustaining opposition by holder of mark SUPRARENIN for synthetic epinephrine against registration of SUPERIN for an aspirin suppository, the issue was framed as "whether one mark so resembles the other as, when applied to the goods of respective parties, to cause confusion or mistake or to deceive purchasers" the court considered channels of distribution and possible confusion of medical personnel or pharmacists); Lucky Heart Labs. v. Neumann, 154 F.2d 519 (C.C.P.A. 1946) (sustaining opposition to registration for a mark on cosmetics by a holder of a similar mark for cosmetics, the court used the phrase "confusion in the mind of the public": but it considered the public to whom the goods were being advertised and sold by mail order); Application of Laskin Bros., Inc., 146 F.2d 308 (C.C.P.A. 1944) (refusing registration of CARESS because a
registration for the same mark for related goods preexisted; consent of the holder of registered mark is not sufficient to allow registration, since the policy of the trademark statute is to "prevent confusion or mistake in the mind of the public or the deception of purchasers"); Universal Paper Products Co. v. Bemis Bros. Bag Co., 116 F.2d 294 (C.C.P.A. 1941) (refusing registration of VEE-TUX for bags intended for foodstuffs due to opposition of holder of mark VEE CUP for paper cups, where appellant contended that "simultaneous use of the marks by the parties is likely to cause confusion in the minds of the purchasing public"); court stated the standard for determining whether goods are of the "same descriptive properties" was "whether or not the goods are similar to the extent that confusion, deception, or mistake will result to the public or to purchasers" (citation omitted, emphasis in original); Mont-O-Min Sales Corp. v. Wyeth Inc., 92 F. Supp. 150 (W.D. Mo. 1950) (dismissing petition for a declaratory judgement that plaintiff is entitled to a registration refused by the Patent Office on technical grounds that the plaintiff now requests it for goods different from those described in its application, court states both that "it is the purpose of the trademark law ... to protect ... the public from being deceived" and that the standard for refusing registrations is whether resemblance of goods and marks is "likely to give rise to confusion in trade or deception to purchasers"); R. J. Strasenburgh Co. v. Kenwood Labs., 106 U.S.P.Q. (BNA) 379 (Commissioner of Patents 1955) (sustains opposition by holder of mark TRIACID for anti-acid tablet against registration of TRISED for a sedative tablet, both products sold only by prescription, the court discusses method of sale and considers likelihood of confusion by pharmacists handling doctors' telephone orders and possibly illegible prescription forms, settlement between the two parties not determinative as "protection of the public is of paramount importance"); Hiss Pharmacal v. Chas. Pfizer & Co., 122 U.S.P.Q. (BNA) 219 (Patent Office Trial and Appeal Board 1959) (sustains opposition of Hiss Pharmacal, holder of mark THERAFORTE for medicinal preparations including nutritional supplements, against application by Chas. Pfizer & Co. to register TERRAFORTE for a therapeutic nutritional preparation; the legal issue is whether the mark is likely "to cause confusion or mistake of purchasers," and the court considered possible mistakes by dispensing pharmacists who misheard doctors); G & G Pharmacal v. Warren-Teed Prods., 120 U.S.P.Q. (BNA) 536 (Patent Office Trademark Trial and Appeal Board 1959) (refuses registration of MYOTAL for a prescription drug for humans because of prior existence of identical mark for a veterinary drug, the standard quoted was whether the use of marks on disparate products "would be likely to cause confusion or mistake or deception of purchasers," and included an analysis of the confusion of pharmacists and drug wholesalers who would be intermediate purchasers, discounting the fact that the veterinary drug in question was only sold direct to veterinarians, since it might be sold through middlemen in the future).

n433. 1961 Hearings, supra note 420, at 21 (discussion between Representative John Lindsay and James Hoge).

n434. Id. at 27 (statement of Mrs. Leeds).

n435. Id.

n436. Id. at 27, 45 (testimony of Gerrit P. Groen).

n437. Id. at 41 (statement of James F. Hoge); id. at 45 (testimony of Gerrit P. Groen); id. at 47 (statement of Andrew R. Klein).

n438. Id. at 41 (statement of James F. Hoge); id. at 47 (statement of Andrew R. Klein).

n439. Id. at 41 (statement of James F. Hoge); id. at 47 (textile finishers) (statement of Andrew R. Klein).
n440. Id. at 41 (statement of James F. Hoge).

n441. Id. at 77 (the CBS eye is a registered service mark seen by viewers who never buy air time) (letter from Dayton R. Stemple, Jr.).

n442. See supra notes 273-74 and accompanying text.


n444. *470 F.2d 689 (2d Cir. 1972)*. See discussion of that case supra notes 288-93 and accompanying text.

n445. This phrase may be an abandoned or genericised slogan. The $64,000 Question was a television game show that aired from June 7, 1955 through Nov. 2, 1958. David Schwartz, Steve Ryan & Fred Wostbrock, Encyclopedia of TV Game Shows 410 (1987). The slogan is not listed in Gale Research Co.'s current reference manual. Slogans (Laurence Urdang ed., 1984).

n446. The 1961 Hearings' subcommittee spokesperson also characterized the proposed bill as largely nonsubstantive. 1961 Hearings, supra note 420, at 7 (opening statement of Rep. John V. Lindsay).

n447. The Patent Office's official memo to the hearings declared that "purchasers" already included "potential purchasers." The change was intended to forestall any future misconstruction by a plain meaning approach. Id. at 57 (memorandum from Edwin L. Reynolds, Acting Commissioner of Patents, Dep't of Commerce).

n448. See supra section II.E.1., Earlier Cases of "Confusion" Cited by the Circuits.


n450. Senate bill 2428 as discussed in the 1982 Hearings, supra note 396, at 4, the language of the bill as introduced by Senator Mathias on Apr. 22, 1982 (legislative day, Apr. 13, 1982). Id. at 3.


n452. 1983 Hearings, supra note 402, at 4-6, reprinting bill as introduced by Mr. Mathias on Mar. 22, 1983 (legislative day, Mar. 20, 1983) (emphasis added).

n453. See id.

n455. Id.

n456. The plaintiff who sold replica Rolex watches at a flea market to individual customers who, he alleged, knew they were fakes. United States v. Torkington, 812 F.2d 1347, 1349 (11th Cir. 1987). For a detailed discussion of the case see supra, section II.C.

n457. "The public in general includes persons ... such as ... the guest in the house who simply views goods ...." United States v. Yamin, 868 F.2d 130 (5th Cir.), cert. denied, 492 U.S. 924 (1989).

n458. 1983 Hearings, supra note 402, at 106 (statement of Guy M. Blynn, the August draft).


n461. Singer, supra note 449, 48.14, 48.15.

n462. Torkington, 812 F.2d at 1351 n.4 (emphasis added).

n463. Id. (quoting 130 Cong. Rec. 32,675 (1984)) (emphasis omitted).


n465. Id. at 31,676.

n466. Id.

n467. Of course, the facts in the case might conceivably have supported conviction under this standard.


"(d) (1) The criminal penalties and treble damages provided for in this section shall not apply to a defendant who establishes by a preponderance of the evidence that he provided adequate labeling on the goods or services and adequate notice to the registrant of the genuine mark."

August version of S. 875, supra note 458.
Thus, a party planning to use a particular mark could provide ample advance written notice to the owner of an existing mark about the party's plans to use a similar mark. The party could also conspicuously label its goods so as to alert the public to the fact that the goods or services are not offered by the owner of the registered trademark.

If a party takes these steps in good faith, it would be virtually impossible to establish, in either a civil or a criminal case, that he or she "knowingly" used a counterfeit mark. Such a painstaking effort to provide advance notice to the trademark owner and to prevent consumer deception would ordinarily preclude any liability under this act. Of course, if a party were to attempt to take these steps in bad faith, as part of an effort to immunize its trafficking in marks it knew to be counterfeit, these procedures would not prevent that party from being found liable under this act.

A party's failure to use this informal notice and labeling procedure is not evidence that he or she dealt in particular marks knowing that they were counterfeit. Indeed, if one believes in good faith that one has a right to use a particular mark, one will not have acted with "knowledge" that the mark was counterfeit, and will not incur any liability under this act.

A person's use of the informal notice and labeling procedures here described does not exempt that person from liability under the Lanham Act or other Federal, State, or local laws.

Id. at 31,674-75.

n470. Id.

n471. J.G. Sutherland, Statutes and Statutory Construction 159, 160 (1891).

n472. I do not believe that the Lanham Act's confusion standard is so broad.

n473. See supra notes 10-11 and accompanying text.

n474. Courts already acknowledge that genericism fades into descriptiveness. See, e.g., Banff, Ltd. v. Federated Dep't Stores, 841 F.2d 486, 489 (2d Cir. 1988); see also Note, supra note 81, (arguing that functionality should limit, not bar, relief in 43(a) trade dress suits).


n476. Id. at 1144; see also id. at 1145-46, n.4 (distinctive packaging may be one solution).

n477. Sega Enterprises v. Accolade, Inc., 979 F.2d 1510, 1530 n.10 (9th Cir. 1992) (copier of functional, source-identifying feature is only required to take reasonable measures to dispel confusion of source, not the "most effective measures reasonably available"; a disclaimer on packaging is sufficient).

n478. The Second Circuit asserted the difference in factors used to decide confusion depending on the

n479. Existing Rolex watches, not possible Rolex watches. If no such exact Rolex model exists at the time of the imitation, the imitation is not a replica.

n480. This compromise slightly diminishes the public’s ability to use trademarks to lower product search costs, because it will no longer be able to trust all uses of trademarked objects by others. This limitation, however, is minor because one could never be sure that other persons accurately reported the quality of items they possessed. (Do you agree with all theatre critics?) One usually has clues that another person may not have the “real” article. Persons panhandling on the Bowery, or employed as menials, for example, are not likely to own genuine Rolex watches. The cognoscenti will know that the item is not a Rolex because it is not identical to any existing Rolex model. This privileges knowledge as a status-signalling device. See supra notes 149-54 and accompanying text.

n481. The Dukes of Hazzard car case might have been argued and won on copyright grounds, as toy cars are copyrightable. See Meyer, supra note 6, at 634 (discussion of misapplication of Lanham Act).

n482. Commercial defamation would be appropriate if, for example, a person knowingly wearing an imitation Rolex injured the watch while telling observers: “See how shoddy my Rolex watch actually is. Rolex should not market such junk at such prices.” A person who accidentally and silently injured such a fake would not be committing defamation as he does not exhibit actual malice or a reckless disregard for the truth. At most the accidental injurer negligently risked others believing that a real Rolex was of poor quality. Since Rolex purposely advertises the extraordinary quality of their watches, they should be considered a public figure for this limited purpose. The watch wearer could also claim he was not making any factual statement about Rolex, and that he cannot control the assumptions of others.