

# The Trademark Reporter®



## The Law Journal of the International Trademark Association

Constitutional Avoidance and Standards of Proof in Trademark Infringement Litigation: A Comment on Post-*Jack Daniel's* Applications of the *Rogers* Test for Liability

*Theodore H. Davis Jr.*

Survey Methodologies to Overcome “Failure to Function” Refusals in the U.S. Patent and Trademark Office

*R. Charles Henn Jr.*

Book Review: *Intellectual Property and Sustainable Markets*. Ole-Andreas Rognstad and Inger B. Orstavik, eds.

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# The Trademark Reporter®

## CONSTITUTIONAL AVOIDANCE AND STANDARDS OF PROOF IN TRADEMARK INFRINGEMENT LITIGATION: A COMMENT ON POST-*JACK DANIEL'S* APPLICATIONS OF THE *ROGERS* TEST FOR LIABILITY

*By Theodore H. Davis Jr.\**

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The author acknowledges the substantive research contributions of Joseph K. Davis to this article. In the interest of full disclosure, he also notes his participation or that of his law firm in the following cases referenced below: *Jack Daniel's Properties, Inc. v. VIP Products LLC*, 599 U.S. 140 (2023) (post-appeal counsel for counterclaim plaintiff); *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003) (counsel for defendants); and *Belin v. Starz Entertainment, LLC*, 662 F. Supp. 3d 1092 (C.D. Cal. 2023) (counsel for defendants). Nevertheless, the views expressed in this article are those of the author alone and not Kilpatrick Townsend & Stockton or its clients.

## I. INTRODUCTION

In *Jack Daniel's Properties, Inc. v. VIP Products LLC*,<sup>1</sup> the Supreme Court resolved a split among the federal circuit courts of appeal—most pronounced where the Second and Ninth Circuits were concerned—as to whether the pro-defendant test for liability for trademark infringement and unfair competition first set forth in *Rogers v. Grimaldi*<sup>2</sup> applied in cases challenging uses by defendants that are source-identifying in nature. The Court answered that question in the negative, holding that “[w]hen a mark is used as a mark (except, potentially, in rare situations), the likelihood-of-confusion inquiry does enough work to account for the interest in free expression.”<sup>3</sup> In doing so, the Court expressly tempered its holding by observing that “[w]e do not decide whether the *Rogers* test is ever appropriate . . . . On infringement, we hold only that *Rogers* does not apply when the challenged use of a mark is as a mark.”<sup>4</sup> At the same time, a concurring three-Justice bloc led by Justice Gorsuch commented both that “it is not entirely clear where the *Rogers* test comes from,”<sup>5</sup> and “it is not obvious that *Rogers* is correct in all its particulars . . . .”<sup>6</sup>

*Jack Daniel's* therefore leaves open the question of *Rogers's* viability in cases involving artistic or expressive works in which allegedly infringing uses are *not* designations of source for defendants' own goods and services, a scenario underlying many (and possibly most) applications of *Rogers*. Moreover, to the extent the *Rogers* test *does* remain viable in that context, another critical circuit split exists between the Second Circuit and the Ninth Circuit regarding the proper application of *Rogers's* second prong, namely, the inquiry into whether a defendant's use is explicitly misleading. *Jack Daniel's* therefore cannot be read to resolve all outstanding *Rogers*-related issues.

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<sup>1</sup> 599 U.S. 140 (2023).

<sup>2</sup> 875 F.2d 994 (2d Cir. 1989).

<sup>3</sup> *Jack Daniel's*, 599 U.S. at 159.

The Court did not elaborate on its parenthetical qualifier, of which Professor Farley and Professor Ramsey have observed that:

The truthful use of a term for its dictionary meaning or another type of informational meaning should arguably constitute one of those rare situations where the First Amendment might demand a threshold inquiry like the *Rogers* test even though the mark was used by the accused infringer as a means of source identification.

Christine Haight Farley & Lisa P. Ramsey, *Raising the Threshold for Trademark Infringement to Protect Free Expression*, 72 Am. U. L. Rev. 1225, 1262 n.164 (2023).

<sup>4</sup> *Jack Daniel's*, 599 U.S. at 163.

<sup>5</sup> *Id.* at 165 (Gorsuch, J., concurring).

<sup>6</sup> *Id.* (Gorsuch, J., concurring).

This article addresses the proper application of the second prong of the *Rogers* test. It argues that the constitutional-avoidance doctrine, which requires interpretations of ambiguous statutes in a manner preventing conflicts with the Constitution,<sup>7</sup> allows courts to accommodate First Amendment considerations by requiring heightened showings of infringement and unfair competition as part of their consideration of that prong. The statutory causes of action for those torts found in Sections 32(1) and 43(a) of the Lanham Act<sup>8</sup> identify likely confusion as the test for liability,<sup>9</sup> and it is undisputed that plaintiffs asserting them bear the *burden* of proof regarding that circumstance. Neither statute, however, expressly requires application of a particular *standard* of proof. In other contexts, the Supreme Court has mandated use of the clear-and-convincing-evidence standard of proof to avoid difficult constitutional issues, and that mandate can and should apply with equal force in litigation under the Act. In addition, and as set forth below and suggested by Justice Gorsuch's concurring opinion in *Jack Daniel's*, the Act's unambiguous statutory text necessarily renders the Second Circuit's approach to constitutional avoidance in litigation under Sections 32(1) and 43(a) more appropriate than that of the Ninth Circuit.

## II. DIFFERING CONCEPTIONS OF *ROGERS* BY THE SECOND AND NINTH CIRCUITS

The origin and evolution of the *Rogers* test are well known,<sup>10</sup> and this article therefore addresses them only briefly. That test arose in

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<sup>7</sup> See generally *F.C.C. v. Fox Television Stations, Inc.*, 556 U.S. 502, 516 (2009) (“The so-called canon of constitutional avoidance is an interpretive tool, counseling that ambiguous statutory language be construed to avoid serious constitutional doubts.”).

<sup>8</sup> 15 U.S.C. §§ 1114(1), 1125(a) (2024).

<sup>9</sup> Because likely confusion is the test for liability for infringement under Section 32(1) and for unfair competition under Section 43(a), and consistent with the approach taken by the Court in *Jack Daniel's*, the remainder of this article does not distinguish between the two. Relatedly, the same torts under state law are typically coextensive with their federal law counterparts. See, e.g., *DaimlerChrysler AG v. Bloom*, 315 F.3d 932, 935 (8th Cir. 2003) (holding state and federal trademark infringement claims “coextensive” and subject to the same analysis, negating need to discuss state law claims independently). (Because it requires a showing of bad faith to support a common-law cause of action for unfair competition, and because proof of consumer injury or harm to the public interest is necessary in actions to vindicate statutory claims to similar effect, New York law is an exception. See *Focus Prods. Grp. Int'l, LLC v. Kartri Sales Co.*, 647 F. Supp. 3d 145, 228–29 (S.D.N.Y. 2022) (defining elements of common-law under common law); *Walker Wear LLC v. Off-White LLC*, 624 F. Supp. 3d 424, 432 (S.D.N.Y. 2022) (interpreting N.Y. Gen. Bus. Law §§ 349 and 350).) Although this article therefore also does not address statutory state-law likelihood-of-confusion-based causes of action separately, its arguments apply to them as well.

<sup>10</sup> See generally Taylor E. Green, *The Rogers Test Dances Between Trademark Protection Under the Lanham Act and Freedom of Speech Under the First Amendment*, 112 TMR 843 (2022); Zachary Shufro, *Based on a True Story: The Ever-Expanding Progeny of*

litigation brought by dancer and actor Ginger Rogers of “Fred and Ginger” fame against the producers of a motion picture titled *Ginger and Fred*, which depicted two aging Italian dancers, who, earlier in their careers, had imitated Rogers and her partner, Fred Astaire. Although “[t]he film received mixed reviews and played only briefly in its first run in the United States,”<sup>11</sup> it ran long enough to attract Rogers’s attention. She filed a lawsuit asserting, among other things, that the film’s title “creat[ed] the false impression that the film was about her or that she sponsored, endorsed, or was otherwise involved in the film,” thereby violating Section 43(a) of the Lanham Act and her common-law right of publicity;<sup>12</sup> she also claimed the title defamed her and violated her right of privacy.<sup>13</sup>

The district court granted a defense motion for summary judgment, reasoning that the movie’s title was not commercial speech.<sup>14</sup> The Second Circuit affirmed that finding of nonliability as a matter of law, but it did so for different reasons. “Though First Amendment concerns do not insulate titles of artistic works from all Lanham Act claims,” the appellate court observed, “such concerns must nonetheless inform our consideration of the scope of the Act as applied to claims involving such titles.”<sup>15</sup> The court then articulated the now-familiar test for liability named for the case in which it originated:

[I]n general[,] the Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression. In the context of allegedly misleading titles using a celebrity’s name, that balance will normally not support application of the Act unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.<sup>16</sup>

With some exceptions, post-*Rogers* courts have generally accepted the Second Circuit’s framework for resolving claims of infringement arising from alleged infringements of plaintiffs’ marks

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*Rogers v. Grimaldi*, 32 Fordham Intell. Prop. Media & Ent. L.J. 391 (2022); Kerry L. Timbers & Julia Huston, *The “Artistic Relevance Test” Just Became Relevant: The Increasing Strength of the First Amendment as a Defense to Trademark Infringement and Dilution*, 93 TMR 1278 (2003).

<sup>11</sup> *Rogers*, 875 F.2d at 997.

<sup>12</sup> *Id.*

<sup>13</sup> *Id.*

<sup>14</sup> *Rogers v. Grimaldi*, 695 F. Supp. 112, 124 (S.D.N.Y. 1988), *aff’d*, 875 F.2d 994 (2d Cir. 1989).

<sup>15</sup> *Rogers*, 875 F.2d at 998.

<sup>16</sup> *Id.* at 999.

in the context of artistic or expressive works.<sup>17</sup> Moreover, they also have taken the Ninth Circuit's lead in expanding *Rogers*'s scope beyond the titles of those works to the works' contents.<sup>18</sup> Thus, *Rogers* is routinely invoked in challenges to appearances of plaintiffs' marks or personas (or imitations of those marks and personas) in such works as videogames,<sup>19</sup> motion pictures,<sup>20</sup> television series,<sup>21</sup> photographs,<sup>22</sup> musical works,<sup>23</sup> theatrical plays,<sup>24</sup> greeting cards,<sup>25</sup> trading cards,<sup>26</sup> books,<sup>27</sup> and artistic prints featuring golfers.<sup>28</sup> Moreover, as a doctrine of federal constitutional law, *Rogers* has been applied to unfair competition claims brought under state law.<sup>29</sup>

Nevertheless, there historically have been two conspicuous circuit splits concerning when and how *Rogers* should be employed.

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<sup>17</sup> See Farley & Ramsey, *supra* note 3, at 1246 (“Over time, the *Rogers* test has become one of the dominant speech-protective doctrines that is invoked by accused infringers and applied by courts when alleged trademark infringement is defended as expression protected by the First Amendment.”).

One exception is the Seventh Circuit, which has declined to adopt or reject *Rogers* (albeit in opinions reaching findings of nonliability as a matter of law). See, e.g., *Eastland Music Grp. v. Lionsgate Ent., Inc.*, 707 F.3d 869, 871 (7th Cir. 2013) (“Nor need we decide whether to follow *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989), under which the title of an artistic work can infringe a trademark only if it is devoid of artistic significance or explicitly misleading about the work's source. *Rogers* treated that doctrine as an application of the first amendment rather than the Lanham Act, and courts should avoid unnecessary constitutional adjudication.”). Another is the District of Colorado, which, in the absence of relevant controlling authority from the Tenth Circuit, has eschewed *Rogers* in favor of a multifactor test aimed at determining whether the defendant had a genuine artistic motive. See *Stouffer v. Nat'l Geographic Partners, LLC*, 400 F. Supp. 3d 1161, 1179 (D. Colo.), *motion to dismiss granted*, 460 F. Supp. 3d 1133 (D. Colo. 2020).

<sup>18</sup> The Ninth Circuit undertook that expansion in *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095 (9th Cir. 2008), in which it applied *Rogers* to protect the alleged infringement of a plaintiff's mark in a videogame. See *id.* at 1099.

<sup>19</sup> See, e.g., *Romantics v. Activision Publ'g, Inc.*, 574 F. Supp. 2d 758, 769–70 (E.D. Mich. 2008).

<sup>20</sup> See *Louis Vuitton Malletier S.A. v. Warner Bros. Ent. Inc.*, 868 F. Supp. 2d 172, 177 (S.D.N.Y. 2012).

<sup>21</sup> See *Twentieth Century Fox Television v. Empire Distrib. Inc.*, 875 F.3d 1192, 1196–99 (9th Cir. 2017).

<sup>22</sup> See *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 806–07 (9th Cir. 2003).

<sup>23</sup> See *Caiz v. Roberts*, 382 F. Supp. 3d 942, 952 (C.D. Cal. 2019).

<sup>24</sup> See *Lombardo v. Dr. Seuss Enters.*, 279 F. Supp. 3d 497, 514 (S.D.N.Y. 2017), *aff'd*, 729 F. App'x 131 (2d Cir. 2018).

<sup>25</sup> See *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 264–71 (9th Cir. 2018).

<sup>26</sup> See *Chrysler Corp. v. Newfield Publ'ns, Inc.*, 880 F. Supp. 504, 512 (E.D. Mich. 1995).

<sup>27</sup> See *Volkswagen AG v. Dorling Kindersley Publ'g Inc.*, 614 F. Supp. 2d 793, 810–11 (E.D. Mich. 2009).

<sup>28</sup> See *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 936–38 (6th Cir. 2003).

<sup>29</sup> See, e.g., *Belin v. Starz Ent., LLC*, 662 F. Supp. 3d 1092, 1099 n.2 (C.D. Cal. 2023) (granting motion to dismiss on ground that “the [complaint's] trademark claims under the Lanham Act, state law, and federal common law are all precluded by *Rogers*”).



The first, and the only one resolved by *Jack Daniel's*, arose from disagreement over whether *Rogers* applied in cases in which defendants' alleged infringements were in the nature of trademark uses. The Second Circuit held it did not in an opinion that, as the Supreme Court pointed out in *Jack Daniel's*,<sup>30</sup> was authored by the same judge who had written *Rogers* itself.<sup>31</sup> In contrast, the Ninth Circuit adopted the contrary rule that *Rogers* can protect even trademark uses by defendants;<sup>32</sup> indeed, it doubled down on that proposition in a particularly ill-timed opinion between the Supreme Court's acceptance of *Jack Daniel's* for review and the Court's disposition of that case.<sup>33</sup>

The second split was, and remains, more subtle. In the Second Circuit, the likelihood-of-confusion inquiry and the second prong of the *Rogers* analysis are not entirely distinct from one another. Instead, as the Second Circuit held a mere four years after *Rogers* regarding the evaluation of whether a defendant's use was explicitly misleading:

The question . . . is whether the title is misleading in the sense that it induces members of the public to believe the [defendant's work] was prepared or otherwise authorized by [the plaintiff]. This determination must be made, in the first instance, by application of the venerable *Polaroid* [likelihood-of-confusion] factors. However, the finding of likelihood of confusion must be particularly compelling to outweigh the First Amendment interest recognized in *Rogers*.<sup>34</sup>

Under Second Circuit authority, uses likely to confuse, on the one hand, and explicitly misleading ones, on the other, therefore occupy different spaces on the same continuum,<sup>35</sup> with “explicitly misleads’

<sup>30</sup> See *Jack Daniel's*, 599 U.S. at 155.

<sup>31</sup> See *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 812–813 (2d Cir. 1999).

<sup>32</sup> See *Twentieth Century Fox Television v. Empire Distrib. Inc.*, 875 F.3d 1192, 1196–99 (9th Cir. 2017).

<sup>33</sup> See *Punchbowl, Inc. v. AJ Press, LLC*, 52 F.4th 1091, 1099 (9th Cir. 2022) (“[A]ttempting to distinguish between a brand and the body and titles of individual articles fails to appreciate the expressive connection between the publication’s title and brand and the reporting that appears under that heading. . . . Just because a mark is used as a brand . . . does not mean the use of the name is beyond *Rogers’s* coverage.”), *withdrawn*, 78 F.4th 1158 (9th Cir. 2023), *later opinion*, 90 F.4th 1022, 1031 (9th Cir. 2024) (“To the point that our precedents previously held that *Rogers* applies when an expressive mark is used as a mark—and that the only threshold for applying *Rogers* was an attempt to apply the Lanham Act to something expressive—the Supreme Court has now made clear that this is incorrect. In that specific respect, our prior precedents are no longer good law.”).

<sup>34</sup> *Twin Peaks Prods., Inc. v. Publ’ns Int’l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993) (footnote omitted).

<sup>35</sup> See, e.g., *Champion v. Moda Operandi, Inc.*, 561 F. Supp. 3d 419, 436 (S.D.N.Y. 2021) (“Although this determination [of whether a defendant’s use is explicitly misleading] is

. . . appear[ing] to be a more demanding and exacting version of the ‘likelihood of confusion’ standard for ordinary infringement.”<sup>36</sup> Thus, although the *Rogers* court itself declined to credit the plaintiffs proffered survey evidence of confusion,<sup>37</sup> other courts applying the Second Circuit’s formulation of the test have recognized the potential relevance of confusion survey evidence to it.<sup>38</sup>

Once again, however, the Ninth Circuit has taken a different approach by holding that the inquiry into whether a defendant’s use is explicitly misleading is wholly separate from that into likely confusion.<sup>39</sup> Thus, for example, that court has accused a plaintiff invoking the Second Circuit’s approach as “conflat[ing] the second prong of the *Rogers* test with the general . . . likelihood-of-confusion test, which applies outside the *Rogers* context of expressive works.”<sup>40</sup> So too has the court held survey evidence of actual or likely confusion irrelevant to that prong.<sup>41</sup> Indeed, some Ninth Circuit opinions have clarified that point by holding that *Rogers*’s second prong sets “a high bar that requires the use to be ‘an “explicit

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based on the same considerations as the likelihood of confusion factors for trademark infringement, only a ‘particularly compelling’ finding of likelihood of confusion can overcome the First Amendment interests.” (quoting *Twin Peaks Prods.*, 996 F.2d at 1379)).

Although neither it nor the federal district courts answering to it have applied the *Rogers* test with any frequency, the Fifth Circuit has adopted the Second Circuit’s view of explicitly misleading conduct as something to be established by particularly compelling evidence of likely confusion. See *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 665 (5th Cir. 2000); *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 269 & n.7 (5th Cir. 1999).

<sup>36</sup> J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 31:144.50 (5th ed.).

<sup>37</sup> 875 F.2d at 1001.

<sup>38</sup> See *Westchester Media*, 214 F.3d at 667–68 (affirming finding of liability in application of *Rogers* after considering survey evidence of confusion); *Hermès Int’l v. Rothschild*, 678 F. Supp. 3d 475, 486 (S.D.N.Y. 2023) (declining to disturb jury finding of liability under *Rogers* based in part on survey evidence of confusion proffered by plaintiff), *appeal docketed*, No. 23-1081 (2d Cir. July 24, 2023); *Simon & Schuster, Inc. v. Dove Audio, Inc.*, 970 F. Supp. 279, 299 (S.D.N.Y. 1997) (finding liability under *Rogers* after considering confusion survey evidence “to a very limited degree”).

<sup>39</sup> See *Gordon*, 909 F.3d at 265 (“If the plaintiff satisfies both elements [of *Rogers*], it still must prove that its trademark has been infringed by showing that the defendant’s use of the mark is likely to cause confusion.”); *accord Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 265 (9th Cir. 2018); see also *Stewart Surfboards, Inc v. Disney Book Grp.*, No. CV 10-2982 GAF (SSX), 2011 WL 12877019, at \*6–7 (C.D. Cal. May 11, 2011) (noting distinction between Second Circuit’s and Ninth Circuit’s approaches to *Rogers*).

<sup>40</sup> *Twentieth Century Fox Television v. Empire Distrib. Inc.*, 875 F.3d 1192, 1199 (9th Cir. 2017).

<sup>41</sup> See *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1245–46 (9th Cir. 2013) (“Adding survey evidence changes nothing. . . . Even if [the plaintiff] could offer a survey demonstrating that consumers of the [challenged videogame] series believed that [the plaintiff] endorsed the game, that would not support the claim that the use was explicitly misleading to consumers.”).

indication,” “overt claim,” or “explicit misstatement” about the source of the work.”<sup>42</sup> More recently, the court has identified “two primary considerations”—neither of them likely confusion—“in evaluating whether the junior use is explicitly misleading: ‘(1) the degree to which the junior user uses the mark in the same way as the senior user and (2) the extent to which the junior user has added his or her own expressive content to the work beyond the mark itself.’”<sup>43</sup> Whatever the precise test for explicitly misleading conduct might be, the Ninth Circuit therefore treats that test as a stand-alone one instead of tying it to the statutory likelihood-of-confusion standard for infringement under the Lanham Act.<sup>44</sup> It is thus

<sup>42</sup> *Dr. Seuss Enters. v. ComicMix LLC*, 983 F.3d 443, 462 (9th Cir. 2020) (quoting *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1245 (9th Cir. 2013)); see also *Novalogic, Inc. v. Activision Blizzard*, 41 F. Supp. 3d 885, 901 (C.D. Cal. 2013) (“To be ‘explicitly misleading,’ a defendant’s work must make some affirmative statement of the plaintiff’s sponsorship or endorsement, beyond the mere use of the plaintiff’s name or other characteristic.”).

<sup>43</sup> *Punchbowl, Inc. v. AJ Press, LLC*, 52 F.4th 1091, 1100 (9th Cir. 2022) (quoting *Dr. Seuss Enters.*, 983 F.3d at 462), *withdrawn on other grounds*, 78 F.4th 1158 (9th Cir. 2023), *later opinion*, 90 F.4th 1022 (9th Cir. 2024); accord *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 270–71 (9th Cir. 2018).

One commentator has characterized the Ninth Circuit’s additional guidance as comprising three, instead of two, considerations. See Yen-Shyang Tseng, *Protecting the First Amendment Rights of Video Games from Lanham Act and Right of Publicity Claims*, 48 Pepp. L. Rev. 425, 491 n.501 (2021) (“[T]he Ninth Circuit [has] identified three additional considerations in analyzing the explicitly misleading prong: whether consumers would view the mark alone as identifying the source of the expressive work, the degree to which the user and the mark owner use the marks in the same way, and the extent to which the user adds its own expressive content to the work beyond the mark itself.”).

<sup>44</sup> See *McCarthy*, *supra* note 36, § 31:144.50 (“The Ninth Circuit [has] warned that this ‘explicitly misleads’ test is definitely not the same as the ‘likelihood of confusion’ standard for ordinary infringement.”); Mark Bartholomew & John Tehrani, *An Interdisciplinary View of Intellectual Property and Free Speech*, 81 Geo. Wash. L. Rev. 1, 50 (2013) (“Although the Ninth Circuit has not adopted [the Second Circuit’s] ‘particularly compelling’ standard, it has set up its own inquiry that replaces the traditional multi-factor likelihood of confusion test with a judicial assessment tilted in the artist’s favor.”); see also *Saber Interactive Inc. v. Oovee, Ltd.*, No. 2:21-CV-01201-JHC, 2022 WL 5247190, at \*5 (W.D. Wash. Oct. 6, 2022) (“Evidence of consumer confusion does not necessarily make a use explicitly misleading.”); *CI Games S.A. v. Destination Films*, No. 2:16-CV-05719-SVW-JC, 2016 WL 9185391, at \*3 n.3 (C.D. Cal. Oct. 25, 2016) (“[A]lthough the Court must evaluate whether a title is ‘explicitly misleading[,]’ the analysis must be distinct from the likelihood of confusion test in order to protect the integrity of the second *Rogers* prong.”); *VIRAG, S.R.L. v. Sony Computer Ent. Am. LLC*, No. 3:15-CV-01729-LB, 2015 WL 5000102, at \*12 (N.D. Cal. Aug. 21, 2015) (“The mere use of a mark is not explicitly misleading, even if combined with consumer confusion.”), *aff’d*, 699 F. App’x 667 (9th Cir. 2017); *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 444 F. Supp. 2d 1012, 1045 (C.D. Cal. 2006) (“[W]hen First Amendment interests are implicated, the *Rogers* ‘explicitly misleading’ standard applies, not the traditional ‘likelihood of confusion’ test.” *aff’d*, 547 F.3d 1095 (9th Cir. 2008)).

The Sixth Circuit and Eleventh Circuit appear to have adopted the Ninth Circuit’s approach to *Rogers*’s second prong. See *Parks v. LaFace Recs.*, 329 F.3d 437, 459 (6th Cir. 2003) (vacating grant of defense motion for summary judgment under first prong of *Rogers* but observing with respect to second prong that “[i]n the present case, the title *Rosa Parks* ‘make[s] no explicit statement that the work is about that person in any

apparent that “there is no single ‘*Rogers* test’ that applies throughout the United States in all trademark disputes involving expressive works.”<sup>45</sup>

### III. STANDARDS OF PROOF AS MECHANISMS FOR CONSTITUTIONAL AVOIDANCE

Although sometimes conflated,<sup>46</sup> the burden of proof and the standard of proof applicable in particular cases are distinct concepts that serve different purposes. With respect to the former, the default common-law rule is that “[t]he burdens of pleading and proof with regard to most facts have been and should be assigned to the plaintiff who generally seeks to change the present state of affairs and who therefore naturally should be expected to bear the risk of failure of proof or persuasion.”<sup>47</sup> A party assigned the burden of proof must then establish the key elements of its case by satisfying an underlying standard of proof:

[T]he term “standard of proof” . . . refer[s] to the degree of certainty by which the factfinder must be persuaded of a factual conclusion to find in favor of the party bearing the burden of persuasion. In other words, the term “standard of proof” specifies how difficult it will be for the party bearing the burden of persuasion to convince the jury of the facts in its favor. Various standards of proof are familiar—beyond a reasonable doubt, by clear and convincing evidence, and by a preponderance of the evidence.<sup>48</sup>

“The function of a standard of proof . . . is to ‘instruct the factfinder concerning the degree of confidence our society thinks he should have in the correctness of factual conclusions for a particular type of adjudication.’”<sup>49</sup> Consequently, “[t]he standard serves to allocate

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direct sense.’ In other words, Defendants did not name the song, for example, *The True Life Story of Rosa Parks* or *Rosa Parks’ Favorite Rap*.’); *MGFB Props., Inc. v. Viacom Inc.*, 54 F.4th 670, 681–82 (11th Cir. 2022) (discounting survey evidence and holding that “[t]he relevant question is whether (1) the secondary user overtly ‘marketed’ the protected work ‘as “endorsed” or “sponsored”’ by the primary user or (2) ‘otherwise explicitly stated’ that the protected work was ‘affiliated’ with the primary user.” (quoting *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1279 (11th Cir. 2012))).

<sup>45</sup> Farley & Ramsey, *supra* note 3, at 1245.

<sup>46</sup> See, e.g., *Bockman v. Lucky Stores, Inc.*, No. CIV S 83-039 RAR, 1986 WL 10821, at \*8 (E.D. Cal. Aug. 11, 1986) (“The fact that the defendant employer would still bear the clear and convincing burden of proof would become meaningless since the lowest burden of proof will control.”), *aff’d*, 826 F.2d 1069 (9th Cir. 1987).

<sup>47</sup> 2 Robert P. Mosteller, Kenneth S. Broun, George E. Dix, Edward J. Imwinkelried David H. Kaye & Eleanor Swift, *McCormick on Evidence* § 337 (8th ed. July 2022).

<sup>48</sup> *Microsoft Corp. v. i4i Ltd. P’ship*, 564 U.S. 91, 100 n.4 (2011).

<sup>49</sup> *Addington v. Texas*, 441 U.S. 418, 423 (1979) (quoting *In re Winship*, 397 U.S. 358, 370 (1970) (Harlan, J., concurring)).

the risk of error between the litigants and to indicate the relative importance attached to the ultimate decision.”<sup>50</sup>

The Lanham Act does not expressly provide for a particular standard of proof. Nevertheless, consistent with the usual rules governing civil litigation,<sup>51</sup> courts have with apparent uniformity held that plaintiffs asserting likely confusion must establish its existence by a preponderance of the evidence and testimony.<sup>52</sup> Indeed, the Supreme Court apparently ratified that standard in *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*,<sup>53</sup> in which, while addressing Section 33(b)(4)’s descriptive fair use defense,<sup>54</sup> it held that “it is only when a plaintiff has shown likely confusion by a preponderance of the evidence that a defendant could have any need of an affirmative defense . . . .”<sup>55</sup> Moreover, to the extent the Ninth Circuit has addressed the standard of proof applicable to its conception of explicitly misleading conduct by a defendant as a stand-alone prerequisite for liability, it has referenced the same standard.<sup>56</sup>

Constitutional avoidance, or the practice of interpreting statutes to pretermit conflicts with the Constitution, has an equally well-established pedigree; indeed, it has been described as the

<sup>50</sup> *Id.*

<sup>51</sup> *See, e.g., Snyder v. City of Moab*, 354 F.3d 1179, 1188 (10th Cir. 2003) (“[A] preponderance of the evidence is the usual controlling standard in civil litigation.”); Kevin M. Clermont, *Procedure’s Magical Number Three: Psychological Bases for Standards of Decision*, 72 Cornell L. Rev. 1115, 1119 (1987) (“The standard of preponderance of the evidence translates into more-likely-than-not. It is the usual standard in civil litigation . . . .”).

<sup>52</sup> *See, e.g., Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 998 (Fed. Cir. 2020) (“In opposition proceedings, the opposer has the burden of proving a likelihood of confusion by a preponderance of the evidence.”); *Super Duper, Inc. v. Mattel, Inc.*, 382 F. App’x 308, 314 (4th Cir. 2010) (affirming district court’s instruction to jury that plaintiff had burden “of proving a likelihood of confusion by a preponderance of the evidence”); *Herman Miller, Inc. v. Palazzetti Imps. & Exps., Inc.*, 270 F.3d 298, 308 (6th Cir. 2001) (“To prove a claim of trade dress infringement under § 43(a) of the Lanham Act, [the plaintiff] must establish, by a preponderance of the evidence . . . that there is a likelihood of confusion . . . .”); *Am. Home Prods. Corp. v. Barr Lab’ys, Inc.*, 834 F.2d 368, 371 (3d Cir. 1987) (“In an action for unlawful imitation of product appearance, evidence of defendant’s intent does not relieve plaintiff of its burden of proving likelihood of confusion by a preponderance of the evidence.”); *Prime Home Care, LLC v. Pathways to Compassion, LLC*, 809 N.W.2d 751, 759 (Neb. 2012) (“In a case for trade name infringement, the plaintiff has the burden to prove by a preponderance of the evidence the existence of . . . a substantial similarity between the plaintiff’s and the defendant’s names, which would result in either actual or probable deception or confusion by ordinary persons dealing with ordinary caution.”); *see also* Mark A. Lemley & Mark P. McKenna, *SCOPE*, 57 Wm. & Mary L. Rev. 2197, 2222 (2016) (“Proving infringement is the IP owner’s burden, always by preponderance of the evidence . . . .”).

<sup>53</sup> 543 U.S. 111 (2004).

<sup>54</sup> 15 U.S.C. § 1115(b)(4) (2024).

<sup>55</sup> *KP Permanent Make-Up*, 543 U.S. at 120.

<sup>56</sup> *See Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 271 (9th Cir. 2018).

“preeminent canon of federal statutory construction.”<sup>57</sup> Under that doctrine’s modern iteration, “when deciding which of two plausible statutory constructions to adopt, a court must consider the necessary consequences of its choice. If one of them would raise a multitude of constitutional problems, the other should prevail—whether or not those constitutional problems pertain to the particular litigant before [a] [c]ourt.”<sup>58</sup> Thus, courts should “construe [a] statute to avoid [serious constitutional] problems unless such construction is plainly contrary to the intent of Congress”;<sup>59</sup> that qualifier means that the doctrine’s invocation is most—and possibly *only*—appropriate in cases in which in the text of the statute at issue is in some way ambiguous.<sup>60</sup> Whatever form

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<sup>57</sup> Adrian Vermeule, *Saving Constructions*, 85 Geo. L.J. 1945, 1948 (1997).

<sup>58</sup> *Clark v. Martinez*, 543 U.S. 371, 380–81 (2005); *see also Zadvydas v. Davis*, 533 U.S. 678, 689 (2001) (“[W]hen an Act of Congress raises ‘a serious doubt’ as to its constitutionality, [a] [c]ourt will first ascertain whether a construction of the statute is fairly possible by which the question may be avoided.” (quoting *Crowell v. Benson*, 285 U.S. 22, 62 (1932))); *Ryan D. Doerfler, How Clear Is “Clear”?*, 109 Va. L. Rev. 651, 686–87 (2023) (“In its ‘modern’ form, the canon of constitutional avoidance instructs courts to adopt a less natural but ‘fairly possible’ interpretation of a statute if giving that statute its ‘most natural’ interpretation would raise ‘substantial constitutional questions.’” (quoting *United States v. X-Citement Video, Inc.*, 513 U.S. 64, 68–69 (1994))).

Under an earlier, or “classical,” conception of the doctrine, constitutional avoidance meant that “as between two possible interpretations of a statute, by one of which it would be unconstitutional and by the other valid, [the Court’s] plain duty is to adopt that which will save the Act.” *Blodgett v. Holden*, 275 U.S. 142, 148 (1927) (Holmes, J., concurring). Professor Walker has explained the difference between that original conception and the one reflected in more modern decisions in the following terms:

[T]he classical version asks whether “the statute would be unconstitutional, while the [modern version] requires only a determination that one plausible reading might be unconstitutional.” Both are implicated only when the statute is ambiguous, but the classical version resolves the ambiguity by choosing a particular construction that is constitutional. The modern version, by contrast, construes the ambiguity to avoid even constitutional doubts without definitively resolving whether those doubts would make the statute unconstitutional.

Christopher J. Walker, *Avoiding Normative Canons in the Review of Administrative Interpretations of Law: A Brand X Doctrine of Constitutional Avoidance*, 64 Admin. L. Rev. 139, 148 (2012) (second alteration in original) (footnote omitted) (quoting Vermeule, *supra* note 57, at 1949).

<sup>59</sup> *Edward J. DeBartolo Corp. v. Fla. Gulf Coast Bldg. & Constr. Trades Council*, 485 U.S. 568, 575 (1988).

<sup>60</sup> *See, e.g., Dep’t of Hous. & Urb. Dev. v. Rucker*, 535 U.S. 125, 134 (2002) (stating that constitutional avoidance “has no application in the absence of statutory ambiguity” (quoting *United States v. Oakland Cannabis Buyers’ Coop.*, 532 U.S. 483, 494 (2001))); *Miller v. French*, 530 U.S. 327, 341 (2000) (declining to apply doctrine in light of perceived lack of ambiguity in statute at issue); *see also Joel S. Johnson, Vagueness Avoidance*, 110 Va. L. Rev. 71, 125 (2024) (“In ordinary constitutional avoidance cases, the [Supreme] Court relies on constitutional avoidance to resolve *ambiguity*—the choice between two or more discrete alternative understandings of semantic meaning—and it tends to do so only after first attempting to cure that ambiguity using other ordinary tools of statutory interpretation.”); *Richard H. Fallon, Jr., Facial Challenges, Saving Constructions, and Statutory Severability*, 99 Tex. L. Rev. 215, 250 (2020) (“Narrowing

it takes, *Rogers* therefore may be considered an example of constitutional avoidance, even if courts do not necessarily characterize it as one.<sup>61</sup>

Just as constitutional avoidance is a time-honored practice among courts, so too does the adoption of particular standards of proof as mechanisms for pretermittting constitutional issues appear in opinions from both state tribunals<sup>62</sup> and their federal counterparts.<sup>63</sup> Those include Supreme Court opinions addressing judicial review of actions taken by administrative agencies, which have applied a strong presumption that Congress intends to make review possible so as to comply with the requirements of due process. For example, in *Bowen v. Michigan Academy of Family Physicians*,<sup>64</sup> the Court rejected an argument by the Secretary of Health and Human Services and other government defendants that, when enacting Part B of the Medicare program,<sup>65</sup> Congress had barred judicial review of the Secretary's implementing regulations. Quoting the legislative history of the Administrative Procedure Act<sup>66</sup> (but not the APA itself), the Court held that:

The statutes of Congress are not merely advisory when they relate to administrative agencies, any more than in other

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constructions of federal statutes can occur only when statutes are genuinely ambiguous, with more than one plausible interpretation.”)

<sup>61</sup> Although courts applying *Rogers* frequently reference First Amendment considerations, e.g., *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664–65 (5th Cir. 2000), they do not expressly identify constitutional avoidance as a basis for doing so. Thus, as Justice Gorsuch observed in *Jack Daniel's*, “it is not entirely clear where the *Rogers* test comes from—is it commanded by the First Amendment, or is it merely gloss on the Lanham Act, perhaps inspired by constitutional-avoidance doctrine?” *Jack Daniel's Prods., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 165 (2023) (Gorsuch, J., concurring).

<sup>62</sup> See, e.g., *Nguyen v. State, Dep't of Health Med. Quality Assurance Comm'n*, 29 P.3d 689, 689 (Wash. 2001) (en banc) (“The issue here is whether the Due Process Clause of the United States Constitution requires proof by clear and convincing evidence in a medical disciplinary proceeding. We hold due process requires no less, reverse and remand.”); *Conservatorship of Wendland*, 28 P.3d 151, 170 (Cal. 2001) (adopting extrastatutory clear and convincing evidence standard of proof on ground that “to permit a conservator to withdraw artificial nutrition and hydration from a conscious conservatee based on a finding, by a mere preponderance of the evidence, that the conservatee would refuse treatment creates a serious risk that the law will be unconstitutionally applied in some cases, with grave injury to fundamental rights”); *Johnson v. Bd. of Governors of Registered Dentists of State of Okla.*, 913 P.2d 1339, 1345 (Okla. 1996) (“Because of the interest at stake in the loss of a license and the potential damage to a professional reputation resulting from disciplinary proceedings, this Court has recognized that the standard of proof in revocation proceedings against a person holding a professional license is a clear-and-convincing-evidence standard.”), *corrected* (May 2, 1996).

<sup>63</sup> See, e.g., *United States v. Ruiz-Gaxiola*, 623 F.3d 684, 692 (9th Cir. 2010) (requiring clear and convincing evidence in context of forcible medication of non-dangerous detainees).

<sup>64</sup> 476 U.S. 667 (1986).

<sup>65</sup> 42 U.S.C. §§ 1395j–1395w (2024).

<sup>66</sup> Pub. L. No. 79-404, 60 Stat. 237 (1946) (codified as amended at 5 U.S.C. §§ 551–559 (2024)).

cases. To preclude judicial review under this bill a statute, if not specific in withholding such review, must upon its face give clear and convincing evidence of an intent to withhold it. The mere failure to provide specially by statute for judicial review is certainly no evidence of intent to withhold review.<sup>67</sup>

As another court has explained of that and other holdings to similar effect, “[t]his ‘heightened showing’ of clear and convincing evidence is required ‘in part to avoid the “serious constitutional question” that would arise if a federal statute were construed to deny any judicial forum for a colorable constitutional claim.’”<sup>68</sup>

Judicial review of federal agency rulemaking is not the only context in which the Court has recognized an elevated standard of proof as an appropriate tool for avoiding potential constitutional complications. In *Santosky v. Kramer*,<sup>69</sup> New York law allowed the state to terminate, over parental objection, the rights of parents to their children upon findings by a “fair preponderance of the evidence” that the children were permanently neglected.<sup>70</sup> Evaluating that rule, the Court held that “while private parties may be interested intensely in a civil dispute over money damages, application of a ‘fair preponderance of the evidence’ standard indicates both society’s ‘minimal concern with the outcome,’ and a conclusion that the litigants should ‘share the risk of error in roughly equal fashion.’”<sup>71</sup> The interest at stake in that case, however, was something else altogether because “[i]n parental rights termination proceedings, the private interest affected is commanding; the risk of error from using a preponderance standard is substantial; and the countervailing governmental interest favoring that standard is comparatively slight.”<sup>72</sup> The clear-and-convincing-evidence standard of proof therefore was appropriate.<sup>73</sup>

These decisions and others like them turn on the constitutional requirement of due process,<sup>74</sup> but, of greater significance to *Rogers*

<sup>67</sup> *Bowen*, 476 U.S. at 671 (quoting H.R. Rep. No. 79-1980, at 4 (1946)).

<sup>68</sup> *Brigade Leveraged Cap. Structures Fund Ltd. v. Garcia-Padilla*, 201 F. Supp. 3d 223, 229 (D.P.R. 2016) (quoting *Webster v. Doe*, 486 U.S. 592, 603 (1988)).

<sup>69</sup> 455 U.S. 745 (1982).

<sup>70</sup> *Id.* at 747.

<sup>71</sup> *Id.* at 755 (quoting *Addington v. Texas*, 441 U.S. 418, 423 (1979)).

<sup>72</sup> *Id.* at 758.

<sup>73</sup> *Id.* at 769–70.

<sup>74</sup> See also *In re Winship*, 397 U.S. 358, 364 (1970) (holding, in the context of juveniles charged with violations of criminal law, that “[l]est there remain any doubt about the constitutional stature of the reasonable-doubt standard, we explicitly hold that the Due Process Clause protects the accused against conviction except upon proof beyond a reasonable doubt of every fact necessary to constitute the crime with which he is charged”); *Woodby v. Immigr. & Naturalization Serv.*, 385 U.S. 276, 277 (1966) (applying due process analysis to hold that “it is incumbent upon the Government in such



scenarios, the Court also has adopted an elevated standard of proof in the context of the First Amendment's right to free speech. It did so in *Gertz v. Robert Welch, Inc.*,<sup>75</sup> in which the Court clarified the test for libel it had set out ten years earlier in *New York Times Co. v. Sullivan*.<sup>76</sup> Although *New York Times* itself required public-figure plaintiffs to prove liability through proof of "convincing clarity,"<sup>77</sup> *Gertz* held that:

Those who, by reason of the notoriety of their achievements or the vigor and success with which they seek the public's attention, are properly classed as public figures and those who hold governmental office may recover for injury to reputation only on clear and convincing proof that the defamatory falsehood was made with knowledge of its falsity or with reckless disregard for the truth.<sup>78</sup>

In requiring a "particularly compelling" showing of likely confusion if a defendant's use occurs in the content or title of an artistic or expressive work, the Second Circuit's conception of explicitly misleading conduct under *Rogers*'s second prong as a mechanism for avoiding a conflict between trademark rights and the First Amendment is consistent with *Gertz* and with opinions invoking constitutional avoidance in the due process context. But what of the Ninth Circuit's practice of treating the inquiry into the possible explicitly misleading nature of a defendant's conduct as one separate from the likelihood of confusion between the parties' respective uses? Can it not be an equally acceptable application of the constitutional avoidance doctrine?

The answer lies in the following holding from the Supreme Court:

Under the constitutional-avoidance canon, when statutory language is susceptible of multiple interpretations, a court may shun an interpretation that raises serious constitutional doubts and instead may adopt an alternative that avoids those problems. But a court relying on that canon still must *interpret* the statute, not rewrite it.<sup>79</sup>

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proceedings to establish the facts supporting deportability by clear, unequivocal, and convincing evidence").

<sup>75</sup> 418 U.S. 323 (1974).

<sup>76</sup> 376 U.S. 254 (1964).

<sup>77</sup> *Id.* at 285–86.

<sup>78</sup> *Gertz*, 418 U.S. at 342.

<sup>79</sup> *Jennings v. Rodriguez*, 583 U.S. 281, 286 (2018); *see also id.* at 298 ("Spotting a constitutional issue does not give a court the authority to rewrite a statute as it pleases."); *Harris v. Garner*, 216 F.3d 970, 985 (11th Cir. 2000) ("Courts should not employ the canon of construction that ambiguous statutory language is to be construed to avoid constitutional questions as a pretext for rewriting clear statutory language.").

Simply put, when addressing an unambiguous statute, courts “cannot ignore [its] text and purpose . . . in order to save it,”<sup>80</sup> even when the statute at issue is the Lanham Act.<sup>81</sup> On the contrary, as one commentator has observed in the closely related context of severability, “[w]hen courts substantially rewrite statutes to save them, the resulting work is as much that of the judiciary as of the legislature. That makes it hard to hold the legislature accountable for the statute that the judiciary puts in place.”<sup>82</sup>

The Supreme Court has never defined the level of ambiguity in a statute’s text necessary to render constitutional avoidance appropriate.<sup>83</sup> Nevertheless, and although the line between ambiguity and unambiguity might be a fine one in other contexts,<sup>84</sup> both the text and purpose of the statutory causes of action found in Section 32(1) and Section 43(a) of the Lanham Act are wholly unambiguous: They target likely confusion and nothing more.<sup>85</sup> Thus, even if courts have adopted varying tests for that circumstance,<sup>86</sup> the ultimate inquiry under each remains the one

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<sup>80</sup> *Boumediene v. Bush*, 553 U.S. 723, 787 (2008); *see also* *Rubin v. United States*, 449 U.S. 424, 430 (1981) (“When we find the terms of a statute unambiguous, judicial inquiry is complete.”).

<sup>81</sup> *See* *Iancu v. Brunetti*, 588 U.S. 388, 397 (2019) (“This Court, of course, may interpret ‘ambiguous statutory language’ to ‘avoid serious constitutional doubts.’ But that canon of construction applies only when ambiguity exists.” (quoting *FCC v. Fox Television Stations, Inc.*, 556 U.S. 502, 516 (2009))).

<sup>82</sup> David H. Gans, *Severability as Judicial Lawmaking*, 76 *Geo. Wash. L. Rev.* 639, 644 (2008); *see also* Richard M. Re, *Narrowing Precedent in the Supreme Court*, 114 *Colum. L. Rev.* 1861, 1886–87 (2014) (“Nobody believes that courts have authority to rewrite crystal-clear legislative commands in order to salvage legislative policy from unconstitutionality.”); Eric Fish, *Judicial Amendment of Statutes*, 84 *Geo. Wash. L. Rev.* 563, 575 (2016) (“[A]s a constitutional remedy, avoidance can be used to actually change a statute’s meaning after a court has found it unconstitutional. This is no longer ‘avoidance’ in the conventional sense, as the court is in fact making a constitutional holding rather than ‘avoiding’ one. Rather, this is a mechanism for changing a statute’s meaning in order to render it constitutionally valid.”).

<sup>83</sup> *See* Brett M. Kavanaugh, *Fixing Statutory Interpretation Judging Statutes*, 129 *Harv. L. Rev.* 2118, 2147 (2016) (book review) (“A case of extraordinary magnitude [can] boil[] down to whether a key provision is clear or ambiguous, even though we have no idea how much ambiguity is enough to begin with, nor how to ascertain what level of ambiguity exists in a particular statute.”); Lisa A. Kloppenberg, *Avoiding Serious Constitutional Doubts: The Supreme Court’s Construction of Statutes Raising Free Speech Concerns*, 30 *U.C. Davis L. Rev.* 1, 12 (1996) (noting that Court “has neither determined how much ambiguity is required to apply the canon, nor has it suggested guidelines, factors or circumstances to include in an ambiguity analysis”).

<sup>84</sup> *See generally* Marco Bastile, *Ordinary Meaning and Plain Meaning*, 110 *Va. L. Rev.* 135 (2024); Jonathan H. Choi, *Measuring Clarity in Legal Text*, 91 *U. Chi. L. Rev.* 1 (2024); Doerfler, *supra* note 58; Lawrence M. Solan, *Pernicious Ambiguity in Contracts and Statutes*, 79 *Chi.-Kent L. Rev.* 859 (2004).

<sup>85</sup> 15 U.S.C. §§ 1114(1), 1125(a) (2024).

<sup>86</sup> In addition to the *Rogers* test, those include the standard multifactor test in conventional cases, e.g., *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961), the inquiry into whether there are material differences between diverted or altered goods resold by defendants and their authorized counterparts that have not been

expressly codified by those statutes.<sup>87</sup> In contrast, neither statute requires (or even implicitly contemplates) explicitly misleading conduct by a defendant as a stand-alone extrastatutory prerequisite for a finding of liability. The Ninth Circuit's adoption of just such a prerequisite therefore is in a wholly different category than the time-honored practice of requiring an elevated standard of proof if doing so will avoid a conflict between the cause of action at issue and the Constitution. Specifically, the employment of a particular standard of proof when interpreting statutes that are silent on the issue is one thing; the adoption of an additional test (or requirement) for liability under an unambiguous statute is another thing altogether.<sup>88</sup> As between the Second Circuit's conception of the test for explicitly misleading conduct by a defendant and that of the Ninth Circuit, the former therefore rests on sounder statutory and doctrinal moorings.<sup>89</sup>

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adequately disclosed, e.g., *Societe des Produits Nestle, S.A. v. Casa Helvetia, Inc.*, 982 F.2d 633, 638 (1st Cir. 1992), whether once-genuine goods have been so materially altered that no disclosure can cure the resulting likely confusion, e.g., *Cartier v. Aaron Faber, Inc.*, 396 F. Supp. 2d 356, 360 (S.D.N.Y. 2005), and the Second Circuit's and Ninth Circuit's competing tests in cases in which the nominative fair use doctrine is in play, e.g., *International Information Systems Security Certification Consortium, Inc. v. Security University, LLC*, 823 F.3d 153, 156 (2d Cir. 2016), and *New Kids on the Block v. News America Publishing, Inc.*, 971 F.2d 302, 307–08 (9th Cir. 1992).

<sup>87</sup> *Cf. B & B Hardware, Inc. v. Hargis Indus.*, 575 U.S. 138, 154–55 (2015) (holding that differing tests for likely confusion applied in infringement and registrability contexts address the same issue for issue-preclusion purposes).

<sup>88</sup> *See Jennings v. Rodriguez*, 583 U.S. 281, 296 (2018) (“The canon of constitutional avoidance ‘comes into play only when, after the application of ordinary textual analysis, the statute is found to be susceptible of more than one construction.’ In the absence of more than one plausible construction, the canon simply ‘has no application.’” (first quoting *Clark v. Martinez*, 543 U.S. 371, 385 (2005); and then quoting *Warger v. Shauers*, 574 U.S. 40, 50 (2014))); *Ileto v. Glock, Inc.*, 565 F.3d 1126, 1143 (9th Cir. 2009) (“[Constitutional avoidance] does not apply where, as here, congressional intent is clear from the text and purpose of the statute.”); *State v. Holle*, 379 P.3d 197, 207 (Ariz. 2016) (“It is one thing to interpret an ambiguous statute in a way that avoids a potential constitutional issue, but it is quite another to rewrite an unambiguous statute to avoid an alleged constitutional issue.”).

<sup>89</sup> It is no answer that the Court in *New York Times* invoked the First Amendment when requiring public figures to demonstrate actual malice as a condition for the recovery of actual damages in defamation actions. 376 U.S. at 279–80. To begin with, the Court noted in that case that the plaintiffs’ cause of action was grounded in “[the] common law only, though supplemented by statute.” *Id.* at 265. Likewise, in *Gertz*, the Court understood its earlier holding as establishing “a constitutional privilege intended to free criticism of public officials from the restraints imposed by the common law of defamation.” 418 U.S. at 334; *see also id.* at 342 (characterizing *New York Times* as “administer[ing] an extremely powerful antidote to the inducement to media self-censorship of the common-law rule of strict liability for libel and slander”). Finally, the Court did not identify any Alabama statutes providing for a presumption of malice upon a finding of falsity, and, indeed, then-extant Alabama common law provided that:

Where words are libelous per se . . . , the right to damages results as a consequence, because there is a tendency of such libel to injure the person libeled in his reputation, profession, trade or business, and proof of such pecuniary injury is not required, such injury being implied.

Of course, applications of the Second Circuit's approach to *Rogers*'s second prong are made no easier by that court's distinctly unhelpful failure to explain the precise nature of its elevated "particularly compelling" standard of proof.<sup>90</sup> Specifically, it has never defined the relationship of that standard to the preponderance-of-the-evidence, clear-and-convincing evidence, and beyond-a-reasonable-doubt triumvirate of alternatives.<sup>91</sup> Moreover, although the Supreme Court has articulated a three-factor test for evaluating whether particular standards of proof comply with due process,<sup>92</sup> it has not offered similar guidance for weighing those standards' compliance with the First Amendment in either *Gertz* or that decision's progeny.<sup>93</sup>

Nevertheless, particularly compelling evidence obviously is distinguishable from a preponderance of the evidence; otherwise, there would be little point to the *Rogers* exercise.<sup>94</sup> Likewise, unless

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Johnson Publ'g Co. v. Davis, 124 So. 2d 441, 450 (Ala. 1960). There thus is no apparent basis for the theory that the Court rewrote a statute (as opposed to adding a constitutional gloss to a common-law cause of action) to incorporate an extrastatutory prerequisite for monetary relief in pursuit of constitutional avoidance.

<sup>90</sup> To the extent courts applying that standard have sought to explain it, they have held that "the most important difference between the *Rogers* consumer confusion inquiry and the classic consumer confusion test is that consumer confusion under *Rogers* must be clear and unambiguous to override the weighty First Amendment interests at stake." *Hermès Int'l v. Rothschild*, 654 F. Supp. 3d 268, 281 (S.D.N.Y. 2023); *accord JTH Tax LLC v. AMC Networks Inc.*, No. 22 CIV. 6526 (PGG), 2023 WL 6215299, at \*5 (S.D.N.Y. Sept. 25, 2023).

<sup>91</sup> For a discussion of three additional standards of proof—substantial, credible evidence, strong basis in evidence, and clear, unequivocal, and convincing evidence—see Hillary Gaston Walsh, *Unequivocally Different: The Third Civil Standard of Proof*, 66 U. Kan. L. Rev. 565, 572–73 (2018). Although arguing for their broader application, however, that discussion characterizes those standards as "outliers." *Id.* at 572; *see also* Clermont, *supra* note 51, at 1120 ("[T]oday there seem to be only three feasible choices in the range stretching from preponderance of the evidence through proof beyond a reasonable doubt. The law did not always recognize this, but with time the law acknowledged that the conceivable spectrum of standards had coalesced irresistibly into three." (footnote omitted)).

<sup>92</sup> Those factors are the private interests affected by the proceeding, the risk of error created by government action at issue, and the countervailing governmental interest supporting use of the challenged procedure. *Mathews v. Eldridge*, 424 U.S. 319, 335 (1976).

<sup>93</sup> To the extent the Court in *Gertz* articulated a rationale for requiring clear and convincing evidence in cases arising from the alleged libel of public figures, it held only that its new gloss on the *New York Times* standard was not "justified solely by reference to the interest of the press and broadcast media in immunity from liability. Rather, we believe that the *New York Times* rule states an accommodation between this concern and the limited state interest present in the context of libel actions brought by public persons." 418 U.S. at 343.

<sup>94</sup> In a non-*Rogers* trademark case, the Second Circuit itself has distinguished between mere compelling evidence (but not *particularly* compelling evidence), on the one hand, and a preponderance of the evidence, on the other. *See Fed. Exp. Corp. v. Fed. Espresso, Inc.*, 201 F.3d 168, 177 (2d Cir. 2000) ("While the [district] court itself was unpersuaded that the marks were similar or that there was bad faith or predatory or freeloading intent—as was the court's prerogative as the preliminary factfinder in connection with

the rule is mandated by statute,<sup>95</sup> courts generally have not required proof beyond a reasonable doubt in civil litigation; instead, “[that] unique standard of proof, not prescribed or defined in the Constitution, is regarded as a critical part of the ‘moral force of the criminal law,’ and [courts] should hesitate to apply it too broadly or casually in noncriminal cases.”<sup>96</sup> That leaves clear and convincing evidence as the most appropriate point of comparison among the traditional three ones, and, indeed, interpretations of that standard are so divergent that they can easily encompass the one applied by the Second Circuit.<sup>97</sup>

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the preliminary injunction motion—these facts need be proven only by a preponderance of the evidence, not by compelling evidence . . .”).

- <sup>95</sup> See, e.g., Cal. Welf. & Inst. Code § 6604 (West) (providing that, in civil commitment proceedings, “[t]he court or jury shall determine whether, beyond a reasonable doubt, the person is a sexually violent predator”).
- <sup>96</sup> *Addington v. Texas*, 441 U.S. 418, 428 (1979) (quoting *In re Winship*, 397 U.S. 358, 364 (1970)); accord *California ex rel. Cooper v. Mitchell Bros.’ Santa Ana Theater*, 454 U.S. 90, 93 (1981); see also Stephen J. Moss, *Clear and Convincing Civility: Applying the Civil Commitment Standard of Proof to Civil Asset Forfeiture*, 68 Am. U. L. Rev. 2257, 2280 (2019) (“The reasonable doubt standard exists only in criminal cases because the specter of a conviction places immense risk on the defendant.”).
- <sup>97</sup> “Although the clear and convincing evidence standard has never been a model of clarity, it is nonetheless reasonably familiar to courts by virtue of its long use in defamation cases applying the actual malice standard.” Arlen W. Langvardt, *Section 43(a), Commercial Falsehood, and the First Amendment: A Proposed Framework*, 78 Minn. L. Rev. 309, 394 (1993). One court has observed that “[q]uantified, the probabilities might be in the order of above 70% [u]nder a clear and convincing evidence burden.” *United States v. Fatico*, 458 F. Supp. 388, 405 (E.D.N.Y. 1978), *aff’d*, 603 F.2d 1053 (2d Cir. 1979). In less empirical fashion, the Supreme Court suggested in 1984 that clear and convincing evidence should “place in the ultimate factfinder an abiding conviction that the truth of [the proffering party’s] factual contentions are ‘highly probable.’” *Colorado v. New Mexico*, 467 U.S. 310, 316 (1984) (quoting Charles T. McCormick, *Law of Evidence* § 320, at 679 (1954)). Six years later, it held that clear and convincing evidence is proof that “produces in the mind of the trier of fact a firm belief or conviction as to the truth of the allegations sought to be established, evidence so clear, direct and weighty and convincing as to enable [the factfinder] to come to a clear conviction, without hesitancy, of the truth of the precise facts at issue.” *Cruzan v. Dir., Missouri Dep’t of Health*, 497 U.S. 261, 285 n.11 (1990) (alteration in original) (quoting *In re Jobes*, 529 A.2d 434, 441 (N.J. 1987)). The flexibility of the standard is likewise reflected in the competing (but not necessarily inconsistent) definitions found in Fifth Circuit case law. *Compare* *Am. Cyanamid Co. v. Elec. Indus.*, 630 F.2d 1123, 1127 (5th Cir. 1980) (holding that clear and convincing evidence “requires that the existence of disputed facts be highly probable”) *with* *Shafer v. Army & Air Force Exch. Serv.*, 376 F.3d 386, 396 (5th Cir. 2004) (“Clear and convincing evidence is ‘that weight of proof which “produces in the mind of the trier of fact a firm belief or conviction as to the truth of the allegations sought to be established, evidence so clear, direct and weighty and convincing as to enable the fact finder to come to a clear conviction, without hesitancy, of the truth of the precise facts” of the case.” (quoting *In re Medrano*, 956 F.2d 101, 102 (5th Cir. 1992))), *opinion clarified*, No. 03-10074, 2004 WL 2107672 (5th Cir. Sept. 17, 2004).

## IV. CONCLUSION

The issue of whether the *Rogers* test remains viable in contexts other than that presented in *Jack Daniel's* is beyond the scope of this article, and the article therefore does not dispute that the First Amendment may well protect the incorporation of some nontrademark imitations of plaintiffs' marks into artistic or expressive works. Likewise, this article does not take a position on three related issues, namely, whether such an incorporation constitutes an actionable use in commerce for purposes of the Lanham Act's statutory causes of action,<sup>98</sup> whether the expressive nature of a good or service provided under a challenged mark is in and of itself a consideration weighing against a finding of liability,<sup>99</sup> and whether the Second Circuit's or the Ninth Circuit's approach to the second prong of *Rogers* is more difficult to satisfy.<sup>100</sup>

Nevertheless, if *Rogers*'s continued viability rests on the doctrine of constitutional avoidance, the Ninth Circuit's treatment of *Rogers*'s second prong as a stand-alone requirement independent of the likelihood-of-confusion analysis is fundamentally inconsistent with the unambiguous texts of the statutory causes of action it purports to apply. In contrast, the Second Circuit's adoption of a higher standard of proof for likely confusion in *Rogers* scenarios is compatible with the silence of the Lanham Act's causes of action on that issue, as well as the long-standing practice of the Supreme Court and other tribunals in analogous circumstances. It therefore is the better option.

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<sup>98</sup> 15 U.S.C. §§ 1114(1), 1125(a), 1125(c) (2024).

For an example of an opinion questioning whether the seven-second appearance of a cartoon character in a motion picture constituted an actionable use in commerce, see *Felix the Cat Productions Inc. v. New Line Cinema Corp.*, 54 U.S.P.Q.2d 1856, 1857–58 (C.D. Cal. 2000) (granting motion to dismiss).

<sup>99</sup> The Ninth Circuit has so suggested in a post-*Jack Daniel's* opinion. See *Punchbowl, Inc. v. AJ Press, LLC*, 90 F.4th 1022, 1032 (9th Cir. 2024) (“[T]he expressive nature of [the defendant’s] use of [its mark] . . . will certainly be relevant in the likelihood-of-confusion analysis.”).

<sup>100</sup> Plaintiffs clearly face challenges under both approaches even after *Jack Daniel's*. Compare *Hara v. Netflix, Inc.*, No. 2:23-CV-03456-RGK-AS, 2023 WL 6812769, at \*4 (C.D. Cal. Aug. 23, 2023) (granting post-*Jack Daniel's* *Rogers*-based motion to dismiss challenge to appearance of alleged imitation of plaintiff’s image in teaser for animated series on ground that “allegations regarding ‘the impact of the use’ are insufficient to show that a content creator explicitly misled consumers”) with *Down To Earth Organics, LLC v. Efron*, No. 22-CV-06218 (NSR), 2024 WL 1376532, at \*9 (S.D.N.Y. Mar. 31, 2024) (granting post-*Jack Daniel's* *Rogers*-based motion to dismiss challenge to television series title with explanation that “Plaintiff’s conclusory allegations are insufficient to state a plausible claim of likelihood of confusion, much less a ‘particularly compelling one’”).

**SURVEY METHODOLOGIES TO OVERCOME  
“FAILURE TO FUNCTION” REFUSALS IN THE U.S.  
PATENT AND TRADEMARK OFFICE**

*By R. Charles Henn Jr.\**

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## I. INTRODUCTION

Whether a word, design, or color scheme functions as a mark is an empirical question, based necessarily on how relevant consumers perceive it. As the United States Patent and Trademark Office (“USPTO”) continues to ratchet up the frequency of “failure to function” refusals, trademark owners have struggled to present evidence sufficiently compelling to convince examining attorneys to withdraw those refusals. And the stakes can be high: unlike mere descriptiveness refusals, a failure-to-function refusal cannot be overcome by amending the Supplemental Register or claiming acquired distinctiveness through length of use. This article thus offers practical advice on how to design surveys—including both tried-and-true methods and an entirely new approach—that can provide empirical evidence showing whether an applied-for term<sup>1</sup> functions as a mark.

## II. WHETHER A TERM FAILS TO FUNCTION AS A MARK IS AN EMPIRICAL QUESTION A SURVEY CAN ANSWER

The Lanham Act defines “trademark” as “any word, name, symbol, or device, or any combination thereof used . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”<sup>2</sup> The two primary features of a mark, therefore, are to *identify* and to *distinguish* the goods of one person from those of another person.

As the U.S. Supreme Court recently explained in *Jack Daniels Properties, Inc. v. VIP Products, LLC*:

Start at square 1, with what a trademark is and does. . . . The first part of [the Lanham Act’s] definition, identifying the kind of things covered, is broad: It encompasses words (think “Google”), graphic designs (Nike’s swoosh), and so-called trade dress, the overall appearance of a product and its packaging (a Hershey’s Kiss, in its silver wrapper). The second part of the definition describes every trademark’s “primary” function: “to identify the origin or ownership of the article to which it is affixed.” Trademarks can of course do other things: catch a consumer’s eye, appeal to his fancies, and convey every manner of message. But whatever else it may do, a trademark is not a trademark unless it identifies a product’s source (this is a Nike) and distinguishes that

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<sup>1</sup> I use “term” in this article for ease of reference, but the same principles apply equally to other material functioning as a mark (e.g., symbols, designs, and color schemes).

<sup>2</sup> 15 U.S.C. § 1127.



source from others (not any other sneaker brand). In other words, a mark tells the public who is responsible for a product.<sup>3</sup>

The USPTO has incorporated these concepts into the Trademark Manual of Examining Procedure (“TMEP”)—the set of rules that examining attorneys follow when considering applications to register marks. The TMEP states: “The USPTO will not register an applied-for designation unless it functions as a mark. . . . That is, the mark must serve as an indicator of the source of the goods or services, identifying and distinguishing them from those of others.”<sup>4</sup>

The TMEP also provides examining attorneys with guidance when evaluating specimens submitted by a service mark’s owner:

Factors that the examining attorney should consider in determining whether the asserted mark functions as a service mark include whether the wording claimed as a mark is physically separate from textual matter, whether such wording is displayed in capital letters or enclosed in quotation marks, and the manner in which such wording is used in relation to other material on the specimen.

While a service mark does not have to be displayed in any particular size or degree of prominence, it must be used in a way that makes a commercial impression separate and apart from the other elements of the advertising matter or other material upon which it is used, such that the designation will be recognized by prospective purchasers as a source identifier. The proposed mark must not blend so well with other matter on specimen that it is difficult or impossible to discern what the mark is.<sup>5</sup>

Although factors such as a physical separation of the term from other textual matter, capitalization, or other font differences may provide some guidance to examining attorneys, the ultimate question of whether a term functions as a mark is based on consumer perception. The TMEP readily acknowledges that “[i]t is the *perception of the relevant public* that determines whether the asserted mark functions as a service mark, not the applicant’s intent, hope, or expectation that it do so.”<sup>6</sup> Similarly, the Trademark

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<sup>3</sup> 599 U.S. 140, 145-46 (2023) (citations omitted) (quoting *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 412 (1916)).

<sup>4</sup> TMEP § 1202.17(c) (citing, *inter alia*, *In re Team Jesus LLC*, 2020 U.S.P.Q.2d 11489, at \*2 (T.T.A.B. 2020) and *In re Tex. With Love, LLC*, 2020 U.S.P.Q.2d 11290, at \*2-3 (T.T.A.B. 2020).)

<sup>5</sup> TMEP § 1301.02 (internal citations omitted); *see also* TMEP § 1202 (noting that the same focus on the specimen is applicable in the context of *trademarks*—“The issue of whether a designation functions as a mark usually is tied to the use of the mark, as evidenced by the specimen.”)

<sup>6</sup> TMEP § 1301.02 (citing, *inter alia*, *In re Standard Oil Co.*, 275 F.2d 945 (C.C.P.A. 1960)).

Trial and Appeal Board (“TTAB”) repeatedly has confirmed that “[t]he critical inquiry in determining whether a proposed mark functions as a trademark is *how the relevant public perceives it*.”<sup>7</sup>

In cases involving failure-to-function refusals, the TTAB emphasizes the importance of evidence reflecting consumer perception. For example, in *In re California Exotic Novelties, LLC*, the Board bolded the phrase “the evidence” when pointing out that “commonplace terms and expressions are properly found as failing to function as marks and cannot be registered [w]here **the evidence** suggests that the ordinary consumer would take the words at their ordinary meaning rather than read into them some special meaning distinguishing the goods and services from similar goods and services of others.”<sup>8</sup> The TTAB has further advised applicants that “[e]vidence of the public’s perception may be obtained from any competent source, *such as consumer surveys, dictionaries, newspapers and other publications*.”<sup>9</sup> And an applicant or registrant’s failure to submit survey evidence may be a consideration in the TTAB sustaining a failure-to-function refusal.<sup>10</sup>

It follows, therefore, that survey evidence can be important—if not dispositive—of the question of whether a term “functions as a mark.” So, then, what survey methodologies can answer that question?

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<sup>7</sup> *In re Calif. Exotic Novelties, LLC*, Serial No. 88629939, 2022 WL 4384865, \*4 (T.T.A.B. Aug. 31, 2022) (emphasis added); *see also* *Univ. of Ky. v. 40-0, LLC*, Opposition No. 91224310, 2021 WL839189, \*13 (T.T.A.B. Mar. 4, 2021) (“The critical inquiry in determining whether a proposed mark functions as a trademark is how the relevant public perceives the term sought to be registered.”); *In re Greenwood*, Serial No. 87168719, 2020 WL 7074687, \*2 (T.T.A.B. Dec. 1, 2020) (“The critical inquiry in determining whether a proposed mark functions as a trademark is how it would be perceived by the relevant public.”); *In re Vox Populi Registry Ltd.*, Serial Nos. 86700941 and 87187215, 2020 WL 6581862, \*5 (T.T.A.B. Oct. 29, 2020) (“[T]he determination whether the designation is capable of functioning as a mark focuses on consumer perception.”), *aff’d*, 25 F.4th 1348 (Fed. Cir. 2022); *In re The Ride, LLC*, Serial No. 86845550, 2020 WL 564792, \*7 (T.T.A.B. Feb. 3, 2020) (“The central question in determining whether Applicant’s proposed mark functions as a service mark is the commercial impression it makes on the relevant public (e.g., whether the term sought to be registered would be perceived as a mark identifying the source of the services).”).

<sup>8</sup> 2022 WL 4384865, \*10 (T.T.A.B. Aug. 31, 2022) (quoting *Greenwood*, 2020 WL 7074687, at \*6).

<sup>9</sup> *In re Black Card, LLC*, 2023 WL 8110301, \*5 (T.T.A.B. Nov. 21, 2023) (emphasis added) (reversing refusal to register FOLLOW THE LEADER on failure-to-function grounds); *see also In re Calif. Exotic Novelties, LLC*, Serial No. 88629939, 2022 WL 4384865, \*10 & n.24 (T.T.A.B. Aug. 31, 2022) (“Evidence of consumer perception can include consumer surveys....”).

<sup>10</sup> *Univ. of Ky. v. 40-0, LLC*, Opp. No. 91224310, 2021 WL839189, \*13 (T.T.A.B. Mar. 4, 2021) (noting “[n]either party has adduced direct evidence, such as a survey.”).

### III. EXISTING SURVEY METHODOLOGIES ASSESSING WHETHER A TERM FUNCTIONS AS A MARK

Before assuming an entirely new methodology needs to be developed to answer the question of whether a term functions as a mark (i.e., acts as an indicator of source), it is first worth considering the many existing (and court-approved) methodologies. This author is of the opinion that three existing methodologies provide empirical evidence of whether a term acts as a source identifier—genericness surveys, secondary meaning surveys, and *Eveready* confusion surveys. These formats are discussed in turn below, as well as a fourth methodology that was rejected by a district court but has not been tested by the TTAB.

#### A. *Genericness Surveys*

“Consumer surveys have become almost de rigeur in litigation over genericness.”<sup>11</sup> Genericness surveys assess whether the primary (or principal) significance of the term at issue is as a mark or as the common name of a good or service. In many ways, a failure-to-function refusal presents the same question.

For example, a *Teflon* survey, “the most widely used survey format to resolve a genericness challenge,”<sup>12</sup> first instructs respondents on the difference between a “brand name” and a “common name.” Although courts and the TTAB have accepted many variations of this instruction, some typical approaches appear below:

- “*Brand names* are names that companies use to identify *who* a product or service comes from. Brand names primarily let the consumer know that a product or service comes from a specific company . . . . *Common names* are words used to identify a *type* of product or service—in other words, *what* the product or service is, not who makes it. Common names primarily let the consumers know what type of product or service is being offered.”<sup>13</sup>
- “By brand or proprietary name, I mean a name like ‘Bank of America’ which is used by one company or organization; by a

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<sup>11</sup> J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* [hereinafter *McCarthy*], § 12:14 (5th ed. 2023).

<sup>12</sup> *Id.* § 12:16.

<sup>13</sup> This is the language Hal Poret used in the *Booking.com* survey implicitly relied on by the U.S. Supreme Court in *United States Patent & Trademark Office v. Booking.com*, 591 U.S. 549, 557 (2020) (“Consumers do not in fact perceive the term ‘Booking.com’ [as generic], the courts below determined. The PTO no longer disputes that determination.”); *Booking.com B.V. v. Matal*, 278 F. Supp. 3d 891, 918 (E.D. Va. 2017) (approving Poret’s methodology and accepting his conclusion); E.D. Va. Civ. No. 1:16-cv-425, Dkt. No. 64-1, Expert Report of Hal Poret at 10.

‘common name’ I mean a name like ‘safe deposit box’ which is used by a number of different companies or organizations.”<sup>14</sup>

- “A common or generic name refers to a type of [product] whereas a brand name refers to [products] from one company or source.”<sup>15</sup>

After being informed of the difference between brand names and common names, respondents in a *Teflon* genericness survey are then presented with a mini-test to confirm their understanding of the difference. Many mini-tests have been approved, but one typical version asks whether the term “Chevrolet” is a brand name or a common name, and whether the term “washing machine” is a brand name or a common name. Respondents who accurately identify “Chevrolet” as a brand name and “washing machine” as a common name “pass” the mini-test; others are excluded from continuing with the survey.

Respondents passing the mini-test are then presented with a series of terms—some actual brand names, some actual generic terms, and the one term being tested.<sup>16</sup> Respondents then indicate for each term whether it is a brand name or a common name. If a majority of respondents indicate the term being tested is a “brand name,” then the survey shows the term is perceived by relevant consumers as a mark. If, on the other hand, a majority of respondents indicate the term is a “common name,” the survey demonstrates that relevant consumers do not perceive the term as a mark.

The existing *Teflon* format therefore should provide a factfinder with evidence that a term does or does not function as a mark. Indeed, in the context of determining whether COUNTRY MUSIC ASSOCIATION could be registered, the TTAB used the results of a *Teflon genericness* survey to infer *acquired distinctiveness*. The TTAB held: “[A]lthough the consumer survey conducted by Dr. Ford was submitted in connection with the issue of genericness, the acquired distinctiveness of the term “COUNTRY MUSIC ASSOCIATION” among the relevant purchasing public can be

<sup>14</sup> *In re Country Music Ass’n, Inc.*, Ser. Nos. 789069000 and 78901341, 2011 WL 5600319, \*8-10 (T.T.A.B. Oct. 25, 2011) (approving Dr. Gerald L. Ford’s survey and relying on its results).

<sup>15</sup> E. Deborah Jay, *Genericness Surveys in Trademark Disputes: Under the Gavel* [hereinafter *Genericness Surveys*], in *Trademark & Deceptive Advertising Surveys: Law, Science, & Design* 107, 124 n.78 (Shari Seidman Diamond & Jerre B. Swann, eds., 2d ed. 2022) [hereinafter *Trademark Surveys* 2d Ed.]. The methodology for Dr. Jay’s survey, was “endorsed” by the court in *UGG Holdings, Inc. v. Severn*, No. CV04-1137-JFW, 2005 WL 5887187, \*5 (C.D. Cal. Feb. 23, 2005).

<sup>16</sup> Typically, an equal number of “brand” and “generic” terms are used in the *Teflon* test. See, e.g., Poret’s survey in *Booking.com*, cited *supra* at n.13, wherein seven terms were presented to respondents consisting of “Booking.com,” three brand names, and three generic terms.

inferred from the results. By categorizing the term . . . as a brand name, 85% of the respondents were saying, in effect, that they associated the term with the product or services of only one company.”<sup>17</sup> Associating a term with “only one company” is essentially determining that the term identifies and distinguishes the goods or services of one person from those of another person—the Lanham Act’s definition of “trademark.”

On the other hand, the TTAB has separately held that “Teflon surveys are only appropriate” in cases involving genericness of a “coined or arbitrary mark” and are “not relevant when a term is not inherently distinctive.”<sup>18</sup> Thus, and as discussed below in Part IV, the TTAB has suggested that some variation on a traditional *Teflon* survey may be necessary in the failure-to-function context.<sup>19</sup>

### B. Secondary Meaning Surveys

The question of whether an applied-for mark has acquired distinctiveness or secondary meaning is very similar, if not identical, to the question of whether a term functions as a mark. The TTAB has explained in the trade dress context that acquired distinctiveness requires a showing that “the product design sought to be registered is perceived by relevant consumers not just as the product (or a feature of the product), but as *identifying the producer or source* of the product.”<sup>20</sup> The TTAB recently held in the context of a failure-to-function refusal that

[N]ot every common term or phrase warrants refusal on failure to function grounds. The refusal is strictly dependent on the evidence presented to show how consumers would perceive the proposed mark. The totality of the evidence must be sufficient to show that the phrase sought to be registered is used in such a way that it cannot be attributed to a *single source* of the goods or services at issue.<sup>21</sup>

Courts and the TTAB have long acknowledged that properly conducted secondary meaning surveys can establish that relevant consumers perceive a term as identifying a single source of the goods or services at issue.<sup>22</sup> This is because a secondary meaning survey

<sup>17</sup> *Country Music Ass’n*, 2011 WL 5600319 at \*12.

<sup>18</sup> *Frito-Lay N. Am., Inc. v. Real Foods Pty. Ltd.*, Opp. No. 91212680, 2019 WL 5290196, \*5 (T.T.A.B. Sept. 24, 2019) (quoting *Frito-Lay N. Am., Inc. v. Princeton Vanguard, LLC*, Opp. No. 91195552, 124 U.S.P.Q.2d 1184, 1196 (T.T.A.B. 2017)).

<sup>19</sup> *The Ride, LLC*, 2020 WL 564792, \*8 (T.T.A.B. Feb. 3, 2020).

<sup>20</sup> *In re Snowizard, Inc.*, 2018 WL 6923620, at \*4 (T.T.A.B. Dec. 21, 2018) (emphasis added) (sustaining refusal to register because, inter alia, applicant did not provide sufficient evidence, including survey evidence).

<sup>21</sup> *Black Card, LLC*, 2023 WL 8110301, at \*4 (emphasis added).

<sup>22</sup> See *LVL XIII Brands, Inc. v. Louis Vuitton Malletier S.A.*, 209 F. Supp. 3d 612, 638 (S.D.N.Y. 2016) (“Because the primary element of secondary meaning is a mental

presents relevant consumers with the term at issue and asks questions designed to determine whether they associate that term with goods or services coming from *one* source (and, typically, whether they can accurately identify that source<sup>23</sup>) or *multiple* sources.

Because the TTAB has held that a failure-to-function refusal is appropriate only if the term “cannot be attributed to a single source,”<sup>24</sup> a secondary meaning survey should be admissible as evidence that a term functions as a mark in the minds of relevant consumers.

### *C. Modified Failure-to-Function Eveready Surveys*

To function as a mark, a term must serve as a source identifier. The TTAB explained: “[A] proposed trademark is registrable only if it functions as an identifier of the source of the applicant’s goods or services. Matter that does not operate to indicate the source or origin of the identified goods or services . . . does not meet the statutory definition of a trademark and may not be registered.”<sup>25</sup>

The question of whether a design identifies a particular source as applied to a particular good can be tested reliably using the well-established *Eveready* survey format with a control.<sup>26</sup> Participants in

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association in the buyers’ minds between the alleged mark and a single source of the product, the determination whether a mark or dress has acquired secondary meaning is primarily an empirical inquiry. Accordingly, courts have long held that consumer surveys are the most persuasive evidence of secondary meaning.” (citations omitted); *see also* *Converse, Inc. v. Int’l Trade Comm’n*, 909 F.3d 1110, 1120 (Fed. Cir. 2018) (listing as the first factor to be used when assessing acquired distinctiveness “association of the trade dress with a particular source by actual purchasers (typically measured by customer surveys),” but subsequently directing the ITC to accord Sarah Butler’s survey “little weight” because it was conducted ten years after the infringing use began); Susan S. McDonald, *Secondary Meaning Surveys in Trademark Surveys* 2d Ed. 79, 95-97 (collecting cases).

<sup>23</sup> The law does not require the additional exercise of naming the source, because of the “anonymous source rule,” which provides that a mark may have acquired distinctiveness or secondary meaning based on its ability to indicate a single, albeit anonymous source. *See* *Tone Bros. v. Sysco Corp.*, 28 F.3d 1192, 1203-04 & n.11 (Fed. Cir. 1994). Nevertheless, some secondary meaning surveys will ask participants if they can name the one source, because if they are able to name the mark’s owner, it may be interpreted as providing even stronger evidence of secondary meaning.

<sup>24</sup> *Black Card, LLC*, 2023 WL 8110301, at \*4.

<sup>25</sup> *Univ. of Ky. v. 40-0, LLC*, Opp. No. 91224310, 2021 WL839189, at \*13 (T.T.A.B. Mar. 4, 2021) (citations and internal quotation marks omitted); *see also In re Calif. Exotic Novelties, LLC*, Ser. No. 88629939, 2022 WL 4384865, \*4 (T.T.A.B. Aug. 31, 2022) (finding FUCK ME failed to function as a designation of source for vibrators).

<sup>26</sup> *Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366, 385-88 (7th Cir. 1976), *superseded by rule on other grounds as noted in Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1429 (7th Cir. 1985); *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 U.S.P.Q.2d 1816, 1828 (T.T.A.B. 2015) (referring to the *Eveready* model as a “widely used and well accepted format for . . . surveys”); *Starbucks U.S. Brands LLC v. Ruben*, 78 U.S.P.Q.2d 1741, 1753 (T.T.A.B. 2006) (approving use of an *Eveready* survey).

a traditional *Eveready* survey measuring likelihood of confusion are shown the allegedly infringing mark (on a product or in advertising for a service) and are asked a series of questions, including:

- Who, or what company, do you believe makes or puts out this product?
- Do you believe that this product is (or is not) being made or put out with the authorization or approval of any other companies or brands?
- If yes, what companies or brands?
- What other products, if any, are put out by the same company that puts out this product?<sup>27</sup>

In the context of likelihood of confusion, the term shown to respondents in an *Eveready* survey is the allegedly infringing one. The *Eveready* survey can be modified, however, to evaluate failure-to-function arguments because the questions posed to respondents ask about the *source* of goods or services offered under the term. In a modified failure-to-function *Eveready* survey, respondents would be shown the term accused of failing to function as a mark.<sup>28</sup> An appropriate control stimulus for a modified failure-to-function *Eveready* survey would be a term that does not function as a mark, such as a generic term in the same product category.<sup>29</sup>

Interestingly, in the Seventh Circuit decision first establishing the viability of the *Eveready* format, the appellate court criticized the lower court for not considering the confusion survey as evidence of secondary meaning. The Seventh Circuit held: “[I]n excess of 50% of those interviewed associated Carbide products, such as batteries and flashlights, with defendants’ mark. The only conclusion that can be drawn from these results is that an extremely significant portion of the population associates Carbide’s products with a single

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<sup>27</sup> This final question is useful in cases in which the plaintiff and defendant both use a mark that is “visually or aurally identical,” because otherwise it is difficult to differentiate between a response reflecting confusion as to source and a response correctly referencing the alleged infringer. See, e.g., Jerre B. Swann, *A History of the Evolution of Likelihood of Confusion Methodologies*, 113 TMR 724, 731 & n.46 (2023).

<sup>28</sup> Put another way, in an *Eveready* survey testing confusion, the junior user’s mark is shown to participants and the questions are designed to show whether participants mistakenly believe the *source* (or sponsorship/affiliation) of the junior user’s mark is the senior user. In the context of failure-to-function, there is no “junior user’s mark,” but these same questions can assess whether the senior user’s mark is acting as an indicator of *source* for the goods or services depicted.

<sup>29</sup> See Shari Seidman Diamond, *Reference Guide on Survey Research*, in Reference Manual on Scientific Evidence 398 (Fed. Judicial Center 3d ed. 2011) (“It is possible to adjust many survey designs so that causal inferences about the effect of a trademark or an allegedly deceptive commercial become clear and unambiguous. By adding one or more appropriate control groups, the survey expert can test directly the influence of the stimulus.”).

anonymous source.”<sup>30</sup> Similarly, if a meaningful proportion (net of noise measured in the control condition) of relevant consumers seeing the applied-for term can accurately name the applicant, the term necessarily is serving as a source identifier, i.e., it is functioning as a mark.

#### ***D. A Failed “Commercial Impression” Test***

In a recent case, *The Pennsylvania State University v. Vintage Brand LLC*,<sup>31</sup> the defendant argued that its use of certain Penn State trademarks on the front of T-shirts was merely ornamental. In response, Penn State offered a “commercial impression” survey that purported to measure whether customers perceived certain images on the front of the defendant’s T-shirts as trademarks. Thus, in many ways, the *Penn State* survey sought to answer the failure-to-function question.

In the survey, participants were first shown shirts that had Penn State design marks (e.g., the Pozniak Lion) or word marks (e.g., PENN STATE BASKETBALL).<sup>32</sup> They were then given the following definition of a trademark: “The term ‘trademark’ includes any word, name, symbol, device (e.g., a drawing or design), or any combination thereof, used by an entity to identify and distinguish its merchandise from merchandise manufactured or sold by others and to indicate the source of the merchandise.”<sup>33</sup> Then participants were asked whether the shirts “contained any trademarks” and, if so, to indicate from a provided list in which the features were trademarks.<sup>34</sup> Approximately 80% of survey participants identified at least one trademark on the shirts in the test condition, and 24% identified a trademark on the shirt in the control condition (a shirt depicting a football between the words “Game Day”).<sup>35</sup>

The district court granted Vintage Brand’s motion to exclude the survey on numerous grounds, including priming respondents to look for trademarks by mentioning Penn State in screening questions, not replicating marketplace conditions (by not showing the shirts on

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<sup>30</sup> *Union Carbide Corp.*, 531 F.2d at 381; *see also* *Ideal Toy Corp. v. Plawner Toy Mfg. Corp.*, 685 F.2d 78, 82 (3d Cir. 1982) (accepting 40% confusion rate among survey respondents as evidence of secondary meaning); *Audemars Piguet Holding SA v. Swiss Watch Int’l, Inc.*, 46 F. Supp. 3d 255, 277 (S.D.N.Y. 2014) (citing post-sale confusion survey to find evidence of secondary meaning), *rev’d in part on other grounds on reconsideration*, 2015 WL 150756 (S.D.N.Y. Jan. 12, 2015).

<sup>31</sup> --- F. Supp. 3d ---, 2024 WL 456139 (M.D. Pa. Feb. 6, 2024).

<sup>32</sup> *Id.* at \*4.

<sup>33</sup> According to the plaintiff’s expert, this was “adapted from the Lanham Act’s statutory definition.” *Id.* at \*9.

<sup>34</sup> *Id.* at \*4. The list provided to participants included options like “the image of the lion on the rock,” “the word Nittany,” and “the color of the shirt.” *Id.* n.50.

<sup>35</sup> *Id.* at \*4 and n.50.



the defendant's website), and using an improper control stimulus.<sup>36</sup> Most significantly, the court was "troubled" because the survey showed a definition of "trademark" without confirming participants' "ability to *apply* the definition."<sup>37</sup> Citing the *Teflon* methodology, the court noted that the "standard practice in trademark surveys" is to "first teach respondents the difference between a brand name and a common name and then test respondents' ability to apply this definition accurately to two terms, only allowing respondents who pass the test to proceed."<sup>38</sup>

#### IV. A NEW METHODOLOGY TO MEASURE FAILURE TO FUNCTION: THE *POUND LAW* CASE

As discussed in Part III above, many existing survey methods exist that can empirically show whether a term functions as a mark, and at least one recent effort was rejected because it did not hew closely enough to the *Teflon* methodology. The TTAB *in dicta* has also suggested that perhaps an entirely new methodology—based on a *Teflon* approach—would be appropriate to assess a failure-to-function refusal. In *In re The Ride, LLC*, the TTAB rejected the proffered survey<sup>39</sup> and stated:

To the extent we may consider a properly-conducted survey as evidence of consumer perception, we note that Mr. Kaiser does not appear to have conducted any sort of "mini-course" that would include a test of the understanding of the survey participants as to whether something functions as a mark. Given the non-traditional nature of Applicant's proposed motion mark, a survey intended to test consumer perception may warrant a unique survey methodology, but the methodology would have been aided by a mini-course.<sup>40</sup>

It does not appear that the TTAB or a court has yet been presented with a failure-to-function survey containing a "mini-course" as suggested by the TTAB in *The Ride*. Recently, however, this author worked with survey expert Dr. Basil Englis to design and field such a survey, and that methodology is described below.

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<sup>36</sup> *Id.* at \*11-13.

<sup>37</sup> *Id.* at \*12 (emphasis added).

<sup>38</sup> *Id.*

<sup>39</sup> The survey did not follow any of the accepted methodologies for measuring genericness, secondary meaning, or confusion, and it was criticized by the TTAB for numerous legitimate reasons, including that the universe was underinclusive and biased, that the questions were inappropriately leading, and, most significantly, that the survey did not actually test whether the applied-for mark served as a source identifier. *The Ride, LLC*, 2020 WL 564792, \*8 (T.T.A.B. Feb. 3, 2020).

<sup>40</sup> *Id.* (citing *Teflon* surveys as those containing a mini-course).

The national law firm of Morgan & Morgan (as a licensee of its related entity Pound Law LLC) has long used the mnemonic telephone number #LAW in connection with advertising its legal services. In 2022, the TTAB affirmed the USPTO's refusal to register #LAW on the ground that it failed to function as a mark for legal services.<sup>41</sup> In early 2023, Pound Law initiated a *de novo* appeal to the U.S. District Court for the Middle District of Florida<sup>42</sup> under Section 21(b) of the Lanham Act.<sup>43</sup> During discovery, counsel for Pound Law worked with Dr. Englis to design and implement a survey (including a “mini-course” on brand names versus common names) that would empirically measure whether relevant consumers perceive that #LAW functions as a mark for legal services.

After screening potential survey participants for individuals who had recently or were likely in the near future to need the type of legal services offered by Morgan & Morgan, Dr. Englis's survey began with a short “mini-course” describing what it means for a term to function as a mark. Survey participants were told the following:

A “trademark” is a word, phrase, or symbol (or any combination of those things) that is used by a company to identify its products or services and distinguish them from other companies' products or services.

There are lots of different words, phrases, and symbols that can function as trademarks. They do not have to be made up or well-known words like “Xerox.” Trademarks can be everyday words like “apple” or “staples.” Trademarks can even include things like phone numbers (like 1-800-FLOWERS), domain names (like Booking.com), street addresses (like 5th Avenue), and abbreviations (like AT&T).

Sometimes, a company will indicate its trademarks using symbols like “TM” or “®,” but that is *not* required. A word, phrase, or symbol (or any combination of those things) can still function as a trademark even without the symbols “TM” or “®.”

Ultimately, whether a particular word, phrase, design, or symbol *functions as a trademark* depends on the *context* in which it is used.<sup>44</sup>

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<sup>41</sup> *In re Pound Law, LLC*, 2022 WL 16960106 (T.T.A.B. Nov. 9, 2022).

<sup>42</sup> *Pound Law, LLC v. Vidal*, No. 6:23-cv-61-RMN (M.D. Fla. filed Jan. 11, 2023).

<sup>43</sup> 15 U.S.C. § 1071(b).

<sup>44</sup> The *Pound Law* survey did not have a second screen with a discussion of what is *not* a trademark, but it would not be improper to include such an additional component to the mini-course in an effort to avoid perceived asymmetry in the course. As discussed below, the examples provided in the *Pound Law* mini-course were balanced (symmetrical) to provide participants an explanation of what is—and what is not—functioning as a mark.

To help survey participants understand these instructions, several subsequent webpages provided practical examples of terms that could function as a mark—or not—depending on context. In each case, the survey used *registered* trademarks so there would be no dispute as to whether the term functioned as a mark. The four examples provided to participants were as follows:

- The word “Subway” functions as a trademark when it is used by one company to sell sandwiches. But “subway” does not function as a trademark when it refers to a train system that runs mostly underground.
- The phrase “Fifth Avenue” does not function as a trademark when it is the name of a street in a city. But “5th Avenue” functions as a trademark when it is used by one company to sell a candy bar.
- A phone number presented with numbers and capitalized letters in an advertisement for a florist, like “1-800-FLOWERS,” functions as a trademark. But the same phone number presented in the “Contact Us” section of a website as 1-800-356-9377, does not function as a trademark.
- The phrase “four roses” does not function as a trademark when used in a paragraph that describes a rose plant: “During the spring, you should expect at least four roses to bloom on this plant.” But the phrase “Four Roses” does function as a trademark when it is capitalized in a distinctive font on the label of a bottle of bourbon.

After the mini-course, the survey then tested whether participants understood what they had been taught. This is similar to the mini-test in a *Teflon* survey, which asks participants to categorize a couple of terms as a “brand name” or “common name” before permitting them to continue with the *actual* terms being tested.<sup>45</sup> In our survey, we showed participants the advertisement depicted below for a pharmaceutical product and asked “Looking at the advertisement shown here, what, if anything, functions as a trademark(s)? If you are thinking of more than one trademark, please enter each trademark in a separate box.”

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<sup>45</sup> This approach also addresses what “troubled” the court in *Penn State* because it confirms the survey participants’ “ability to apply the definition” of a trademark. See 2024 WL 456139 at \*12.



The Nexium advertisement was a helpful mini-test because it included so many different components functioning as marks.<sup>46</sup> Indeed, within this one advertisement, four elements are registered as marks with the USPTO: NEXIUM (Reg. No. 2483060), ASTRAZENECA (Reg. No. 2663581), PURPLEPILL.COM (Reg. No. 2941554), and the design of the pill itself (Reg. Nos. 2980749 & 3062072). Survey participants were required to identify at least *one* of these marks (but not all of them) to continue with the survey.<sup>47</sup> More than 99% of participants correctly identified at least one mark, which suggests the mini-course was effective.

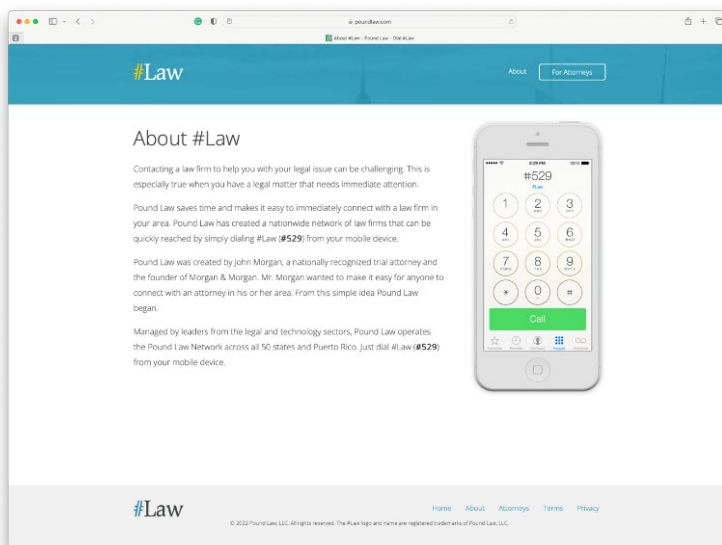
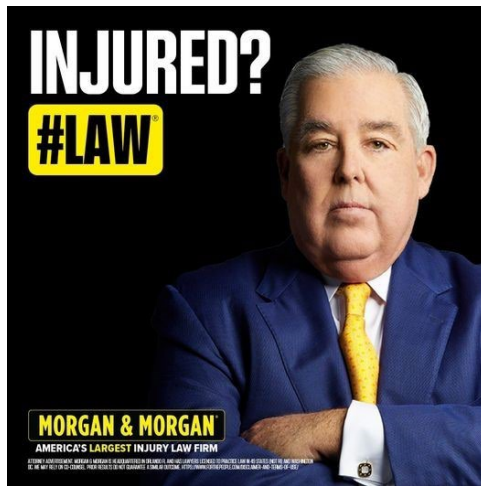
The survey then assigned individuals passing the mini-test to either a test or control group and permitted them to proceed with the survey involving the #LAW mnemonic. The test group was presented with three representative advertisements featuring #LAW (a screenshot from a TV ad, a billboard, and a page from the law firm’s website), including the webpage that Pound Law submitted to the USPTO as a specimen during prosecution of the application to register the mark.<sup>48</sup> The three test-group stimuli appear below:

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<sup>46</sup> Selecting an appropriate stimulus for the mini-test is always difficult, and there is no perfect stimulus. It is possible that a more well-known brand would have been more appropriate; it also is possible that a stimulus including more non-trademark words or phrases would have provided even more assurance that participants understood the instructions. On the other hand, the Nexium stimulus did appear to adequately “test” survey participants’ comprehension of the task, because the vast majority were able to identify at least one element functioning as a mark.

<sup>47</sup> It also would be appropriate to disqualify participants who improperly identified something that is *not* functioning as a mark in the stimulus (e.g., “For Many” in the Nexium ad). This is analogous to the *Teflon* mini-test, where a participant who improperly identifies “automobile” as a “brand name” is disqualified from continuing.

<sup>48</sup> The author is not suggesting that this methodology *requires* three (or any other number of) stimuli. In the #LAW case, the expert decided that providing representative examples of different types of media (rather than simply using one) was a more reasonable representation of the real-world marketplace.



*Teflon* surveys, which include a mini-course and ask participants to determine whether a term is a common (generic) name or a brand name, do not have external control groups. Instead, a *Teflon* survey employs an “internal” control in the sense that the other terms presented to the survey participants “are used to evaluate [their] ability to distinguish brand names from common names, and they also provide a measure of the amount of guessing or ‘noise’ in the survey.”<sup>49</sup> Because the stimuli in the *Pound Law* survey included other terms functioning as marks (e.g., MORGAN & MORGAN) and many terms not doing so, those “internal” controls existed. Nevertheless, the *Pound Law* survey also employed an external control group as an alternative method of controlling for guessing or noise.

It is widely understood that external control stimuli in a trademark survey should remove or alter the term being tested but (a) only as minimally necessary (e.g., enough to be non-infringing in a confusion survey or not to be associated with a single source in a secondary meaning survey); and (b) otherwise remain identical to the test stimuli.<sup>50</sup> A survey hewing to these principles can isolate the influence of the term being tested.<sup>51</sup> The *Pound Law* survey modified each test stimulus to remove the “#” symbol because the applicant acknowledged that it was the *combination* of that symbol and the word “LAW” that allowed the overall mark to function as one; and the applicant did not claim exclusive rights to the word “LAW” standing alone.<sup>52</sup> The stimuli seen by control-group participants appear below:

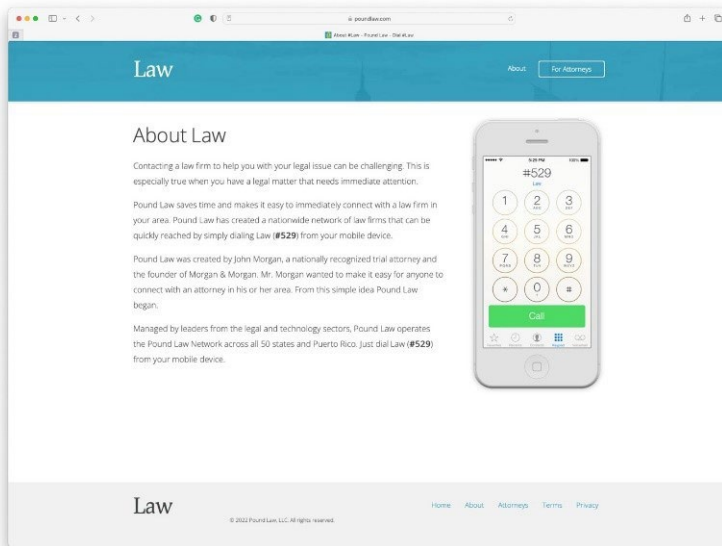
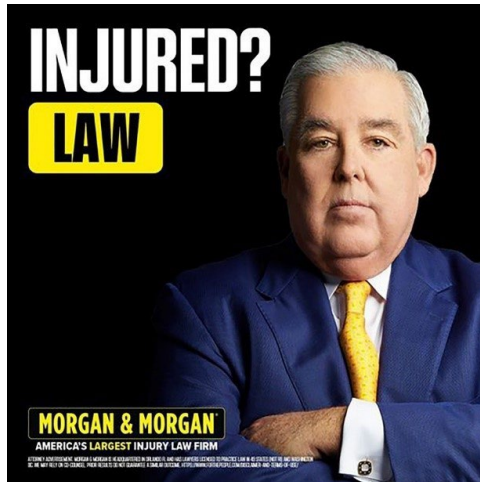


<sup>49</sup> Jay, *Genericness Surveys* at 131.

<sup>50</sup> Shari Seidman Diamond, *Control Foundations: Rationales and Approaches*, in *Trademark Surveys* 2d Ed. 239, 248.

<sup>51</sup> Shari Seidman Diamond, *Reference Guide on Survey Research*, in *Reference Manual on Scientific Evidence* 359, 398 (3d ed. 2011).

<sup>52</sup> The numeric corollary to “LAW” on a keypad is “529.” Where those numbers appeared (e.g., in the third test image), they remained unchanged in the corresponding control stimulus.



The survey asked participants in both the test and control groups the same questions regarding each stimulus they saw: “Looking at this advertisement, what, if anything, functions as a trademark(s)? If you are thinking of more than one trademark, please enter each trademark in a separate box.” They were also asked an additional probe question: “Is there anything else in this advertisement that functions as a trademark?”

Tabulation of the results revealed that survey participants did, in fact, perceive #LAW to function as a mark in these advertisements. In the test group, 63.5% of participants identified #LAW as something that “functions as a trademark.” Approximately 83% of participants accurately identified the internal control—MORGAN & MORGAN—as something that functions as a mark,

while only 16% said LAW functions as a mark and only 13% said #529 functions as a mark. Dr. Englis concluded that these results demonstrated that participants understood and could successfully identify terms functioning as trademarks.

Responses from the external control group provided similar results regarding the terms that had not changed from the test stimulus (85% accurately reported that MORGAN & MORGAN functions as a mark, while 16% reported that #529 functions as a mark). As to the term “LAW” in the control stimulus, a minority (40%) said that it functions as a mark—23.5% fewer than those who had identified #LAW as functioning as a mark in the test group. Dr. Englis concluded that whether one considered (a) the test result alone, where a majority (63.5%) identified that #LAW functions as a mark, (b) the percentage difference between test and control (63.5% less 40% for a net 23.5%), or (c) or a statistical test (the difference between test and control results as to #LAW was statistically significant), the survey results supported the conclusion that #LAW functions as a mark for legal services.

Counsel for Pound Law shared the survey results with the USPTO in discovery (along with other expert reports<sup>53</sup>), and shortly thereafter, the USPTO agreed to withdraw its prior failure-to-function refusal and to approve the application for publication. In the agreed order dismissing the *Pound Law* case, the USPTO did not mention the survey explicitly, but acknowledged that Pound Law had provided “additional probative evidence of how consumers would perceive uses of #LAW.” On that basis, the USPTO agreed to “take appropriate steps to approve [the application] for publication forthwith.”<sup>54</sup> So, while the district court did not have the opportunity to weigh in on the *Pound Law* survey (because the case settled before an expert report describing the survey was publicly filed), in this author’s view, the survey’s methodology and results may have persuaded the USPTO to reach a settlement with Pound Law. The applied-for mark #LAW was approved for publication and ultimately registered (Reg. No. 7307575) on February 20, 2024.

## V. HOW MUCH IS ENOUGH?

Part of the reason the expert’s conclusion in the *Pound Law* survey cited multiple approaches to viewing the data (i.e., majority vs. net percentage vs. statistical significance) is because no case law establishes the threshold net percentage of positive survey responses necessary to establish that the #LAW mnemonic

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<sup>53</sup> Pound Law also shared expert reports from Dr. Ronald Goodstein, a marketing expert, and Leslie Lott, Esq., an expert on USPTO practice and procedure.

<sup>54</sup> *Pound Law*, No. 6:23-cv-61-RMN, Dkt. No. 55, Agreed Order of Dismissal and Remand, at ¶¶ 3-4 (Sept. 11, 2023).



functions as a mark. By contrast, plenty of case law establishes various survey thresholds for other empirical questions.

The threshold in *Teflon* genericness surveys is 50% because the legal standard is whether the term's "principal" or "primary" significance is as a common term or as a mark.<sup>55</sup> If the expert properly codes 51% of responses as classifying the tested term as a "common name," the survey shows the term is generic; if 51% of those responses are properly coded as "brand name," the survey shows the term is not generic.

The threshold is less precise in the secondary meaning context, in part because "the applicant's burden of showing acquired distinctiveness increases with the level of descriptiveness; a more descriptive term requires more evidence of secondary meaning."<sup>56</sup> Professor McCarthy notes that "figures over 50% are regarded as clearly sufficient. However, figures of 46%, 37% and 31% have also been found sufficient."<sup>57</sup> Matt Ezell and Dr. Annabelle Sartore's chapter summarizing the case law in this area cites instances of courts both accepting and rejecting "one company" survey results as low as 22%.<sup>58</sup>

Courts considering the actual confusion factor (the factor under which survey evidence is considered) in likelihood-of-confusion inquiries generally require more than a *de minimis* showing,<sup>59</sup> and the mark owner must prove an *appreciable* number of consumers are likely to be confused.<sup>60</sup> For this reason, the survey threshold is not merely "above zero"; rather, net levels below 10% are considered evidence that confusion is *not* likely.<sup>61</sup> On the other hand, percentages in an *Eveready* survey in excess of 10% may be considered "probative" evidence while net percentages in excess of 20% are considered "significant evidence" of likely confusion.<sup>62</sup>

In the context of a failure-to-function refusal, the threshold likely should be lower than the thresholds for genericness,

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<sup>55</sup> See, e.g., McCarthy, *supra* note 11, § 12:6 (collecting cases and noting that some refer to "principal" and others refer to "primary" significance, but in any event, majority perception controls).

<sup>56</sup> *In re Steelbuilding.com*, 415 F.3d 1293, 1300 (Fed. Cir. 2005); see also *In re Greenliant Sys. Ltd.*, 2010 WL 5099659, \*8 (T.T.A.B. Nov. 29, 2010)

<sup>57</sup> McCarthy, *supra* note 11, § 32:190.

<sup>58</sup> Matthew G. Ezell & AnnaBelle Sartore, *Survey Percentages in Lanham Act Matters* [hereinafter *Survey Percentages*], in *Trademark Surveys* 2d Ed. 317, 323-25.

<sup>59</sup> See, e.g., *Jackpocket, Inc. v. Lottomatrix NY LLC*, 645 F. Supp. 3d 185, 260 (S.D.N.Y. 2022) ("As a legal matter, *de minimis* evidence of actual consumer confusion is at best weakly probative of the potential for actual consumer confusion in the marketplace.")

<sup>60</sup> See, e.g., *LVL XIII Brands*, 209 F. Supp. 3d at 638 (dismissing three instances of actual confusion as not "demonstrating that an appreciable number of ordinarily prudent purchasers" would be confused) (citation omitted) (internal quotation marks omitted).

<sup>61</sup> Ezell & Sartore, *Survey Percentages* 321.

<sup>62</sup> *Id.* at 320.

secondary meaning, or confusion. Indeed, the relevant threshold for failure-to-function surveys may merely be whether the test and control reflect significantly different statistical results.<sup>63</sup>

The basis for setting a lower threshold for failure-to-function surveys is the language of the TMEP itself. The TMEP sections providing guidance to examining attorneys regarding failure-to-function refusals, set a high threshold for sustaining such a refusal. For example, Section 904.07(b) instructs examining attorneys to allow substitute specimens of use except “in instances where the nature of the mark . . . indicates that consumers would *never* perceive the mark as source indicating, regardless of the manner of use.”<sup>64</sup> Similarly, Section 1301.02(a) states the following:

A term that is used *only* to identify a product, device, or instrument sold or used in the performance of a service rather than to identify the service itself does not function as a service mark . . . . [A] term that *only* identifies a process, style, method, or system used in rendering the services is not registrable as a service mark . . . . A term used *only* as a trade name is not registrable as a service mark . . . . If a service mark would be perceived *only* as decoration or ornamentation when used in connection with the identified services, it must be refused . . . .<sup>65</sup>

The references to “never” being perceived as source indicating or “only” identifying a product, process, trade name, or decoration suggest that *any* evidence that a term is, in fact, source identifying should suffice to overcome a failure-to-function refusal. The threshold clearly does not appear to be as high as in cases of genericness, where one must show the “primary” or “principal” significance of a term; nor does it contemplate an increasing evidentiary requirement depending on how descriptive the term is; nor does it require a “more than de minimis” showing as in the case of likely confusion. That said, it remains to be seen what threshold the TTAB (or courts) will require of a survey specifically testing whether a term fails to function as a mark.

## VI. CONCLUSION

As mark owners continue to face failure-to-function challenges from the USPTO, it is worth remembering that the ultimate question is how consumers perceive the applied-for mark. And the

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<sup>63</sup> It is worth noting that statistical significance can be impacted by sample size, so if the standard applied to a failure-to-function survey is merely statistical significance, attention should be paid to the number of participants who completed the test and control conditions in the survey.

<sup>64</sup> TMEP § 904.07(b) (emphasis added).

<sup>65</sup> *Id.* § 1301.

best evidence of consumer perception is a properly conducted survey of relevant consumers. Although several existing methodologies can provide evidence that a term is functioning as a mark, this article offers an alternative (and perhaps better) methodology—one that helped convince the USPTO to withdraw an earlier refusal to register the #LAW mark (because of a perceived failure-to-function) and approve Pound Law’s application for publication.

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## BOOK REVIEW

*By Gabriele R. Fougner\**

**Intellectual Property and Sustainable Markets.** Ole-Andreas Rognstad and Inger B. Orstavik, eds. 2021. Pp. 240. \$148 (hardback); from \$40.00 (eBook). Edward Elgar Publishing Limited, The Lypiatts, 15 Lansdown Road, Cheltenham Glos., GL50 2JA, UK; Edward Elgar Publishing, Inc., William Pratt House, 9 Dewey Court, Northampton, Massachusetts 01060, USA.

Sustainability and intellectual property (“IP”) seem like two discrete, unrelated concepts. Indeed, the average individual might ask how IP rights could play a part in “development that meets the needs of the present while safeguarding the Earth’s life-support system, on which the welfare of current and future generations depends.”<sup>1</sup>

In *Intellectual Property and Sustainable Markets*, IP scholars Ole-Andreas Rognstad and Inger B. Orstavik and a cross-disciplinary team of contributors offer a useful perspective on the ideal role IP rights should play in the United Nations’ global sustainable development goals (“SDGs”) since the SDGs rely so heavily on technology and technological developments yet barely address IP rights. Wherever innovation and development exist, so do IP rights, as the incentives for investment in innovation and creation. In *Intellectual Property and Sustainable Markets*, the contributors ask crucial questions regarding whether IP rights hinder sustainable development. They provide important lessons on how policymakers can cooperate on international, regional, and national levels to include sustainability in market-based regulations while addressing the problems that go along with seeking global solutions to the IP and sustainability interface.

The book is organized into ten chapters. Chapter 1 introduces the interplay between IP rights and sustainability. It discusses the foundational assumption of most IP systems—that awarding individuals exclusive rights to inventions or works of art or literature, etc. leads to new knowledge that benefits society—and the correlating assumption that innovation contributes to

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<sup>1</sup> David Griggs, *Redefining Sustainable Development*, Project Syndicate (March 19, 2023), <https://www.project-syndicate.org/commentary/redefining-sustainable-development-by-david-griggs> (last visited May 7, 2024).

sustainable development, enabling humans to make better, more sustainable choices. However, the chapter goes on to address the failings of this assumption: that for it to be true, IP rights must function in a manner that incentivizes sustainable choices. Unfortunately, this is not always the case. Indeed, our current era has seen numerous unnecessary and resource-depleting inventions as well as the exclusive right to sell and market—at whatever price point an IP holder desires—vital technologies necessary to survive in the modern age. The first chapter ends with the recognition that there might be a need to balance exclusivity and IP protection with global access.

Chapter 2 dives deeply into the absence of IP rights in the SDGs and offers five hypotheses on why this might be. To do so, it highlights overall perspectives on IP and development, including those of the least-developed countries, and how IP was considered leading up to the creation of the SDGs, as well as the SDGs' effect on international organizations such as the World Intellectual Property Organization, the World Health Organization, and the World Trade Organization (“WTO”). The chapter offers insight into the extent to which IP rights are shrinking development space, where technological improvements can be hindered by too many patents, and the extent to which IP rights are, seemingly, harming human rights, by legalizing controlled access and discouraging enhanced access to necessities. While chapter author Hans Morten Haugen believes there is no doubt that a well-functioning IP system is important for sustainable development, he argues that the SDGs' limited attention to IP rights creates problems for the world organizations that must act to implement the SDGs. Indeed, the chapter argues that the absence of IP rights in the SDGs has caused the related world organizations to “too passive[ly]” take ownership in determining which SDGs are relevant to them and has left uncertainty in how such organizations should act in balancing IP rights and human rights (such as access to medicines). Tying the charter up nicely, Mr. Haugen discusses which of his hypotheses on the absence of IP rights in the SDGs are strengthened by his arguments, concluding that complexity and compartmentalization are the main reasons for the lack of IP rights in the SDGs.

Chapter 3, written by Peter K. Yu, addresses the intersection between SDGs and the development of an IP system, arguing that a deeper understanding of this relationship is necessary when undertaking efforts to achieve the SDGs. It then analyzes the problems that the WTO's Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPS”) inflicts upon developing countries when implementing the SDGs, such as how the TRIPS Agreement promotes standards of highly developed countries and ignores the fact that what works well in one country may not necessarily work in another but may instead deplete resources that

could otherwise be used to achieve the SDGs. The chapter concludes by stating that the world can assist developing countries by realigning the TRIPS Agreement with the SDGs, offering six strategies for developing countries to deploy, and arguing that alignment of international IP negotiations with SDGs is critical to the development of sustainability.

In Chapter 4, Daniel J. Gervais discusses cultural sustainability and its relationship with the environment. The author argues that the definition of protecting an ecosystem should include cultural sustainability, explaining that there is an impact on environmental sustainability by the collapse of an environment distinct to one culture or the planning of how to use certain land—such as for a city development project that brings together communities of mixed race or mixed income. The chapter stresses that cultural sustainability is not about imposing one set of values but empowering communities to develop and propagate values, including through art and literature. The author focuses on two vehicles for human progress and creation—literacy/artistic creation and journalistic information. However, the chapter discusses how these vehicles of human progress are in serious peril since the advent of the digital era. The author argues that when the professional must compete with the amateur—especially when consumers have fewer financial responsibilities to the amateur and amateurs do not share the same social or journalistic responsibilities as professionals—cultural development and democratic systems both suffer. Since every individual is at once an author, the author argues, all are in the crosshairs of copyright. The chapter concludes with a suggestion to reform the Berne Convention—the most important copyright treaty—in a way that balances protection for authors and access for consumers based on the public interest rather than the desires of major commercial intermediaries—copyright-owning and dissemination entities such as media houses—that now make up only a small fraction of copyright holders.

Chapters 5 and 6 provide road maps for how to integrate sustainability into IP law, calling for repair and reuse of goods rather than overconsumption and waste and examining the space—or lack thereof—for flexibility in patent and trademark rights. Chapter 5 focuses on the doctrine of exhaustion and when trademark and patent law allow for recycling products and marks, arguing that a strong property rights approach to IP creates incentives for original manufacturers but fails in terms of creating sustainable business models. Chapter 5 offers two examples of strong property right impact on recycling efforts: (i) how patent owners dictate to the public their preferred “normal” lifespan of a product, rather than a longer, more sustainable lifespan that could include recycling or repairing the product; and (ii) how upcycling—

creating a different object from a used product but keeping the mark of the original product manufacturer—could be considered trademark dilution or tarnishment even though the goods differ. Chapter author Taina Pihlajarinne argues that such impacts put sustainability at a disadvantage, creating an exception dichotomy, and stresses that sustainability cannot be limited to the role of exception and limitation in IP but must be embedded into IP rights regulation as a general principle. Chapter 5 concludes with a suggestion for reform—to promote a “normal, sustainable lifespan for that particular category of product” and to remove from the scope of trademark rights any use of a trademark not depicted in the manner of a badge of origin.

Chapter 6 gives a current, real-life example of a strong property right system by analyzing a judgment from the Norwegian Supreme Court, where sustainability arguments were rejected in a case in which iPHONE screens were imported from Hong Kong to Norway for repair but had the APPLE logo removed before import. The Court held that the import infringed Apple’s trademark rights and that sustainability did not play a role in the case because the use at issue was that of the APPLE logo and not the repair of the screens. While the Court found that the import negatively affected trademark functions, chapter author Ole-Andreas Rognstad argues that the Court’s determination is not based on a real assessment of harm to the trademark and that a fact-based rather than postulated view of the matter might leave space for consideration of sustainability concerns. The chapter concludes with a salute to the approach of taking sustainability concerns into account in determining harm to a trademark and giving priority to trademark interests only if there is a concrete risk of harm to the trademark functions in the case at hand.

The final chapters—Chapters 7–10—recognize that innovation is paramount to the implementation of the SDGs and discuss the role of IP rights in innovation in the finance and energy industries. Chapter 7 discusses how, in the finance industry, there is a prominent role for IP rights because the development of climate change mitigation financing (green finance) and the persistence of ocean resilience financing (blue finance) depend on innovation. Chapter author Janice Denoncourt suggests that financial regulation should facilitate a financial market that is ready and able to finance innovative technologies for a better, more sustainable world. In this sense, registered IP rights would play a critical role in getting innovation financing as a loan security.

In Chapter 8, the conversation moves to the energy market and how the transition from fossil fuel to renewable energy—fulfilling SDG 7—is dependent upon innovation. Chapter author Inger Orstavik uses the solar photovoltaic industry as an example, arguing the need for a detailed approach to energy policy and

innovation policy. The question the chapter examines is whether the patent system should be tied to the goal of sustainability, discussing that while the patent system is technology-neutral, there is a need for some technologies to be made public to avoid duplication of innovative efforts, saving costs for society at large. The chapter argues for coherence between environmental policy and innovation policy and against the shortcomings of the patent system in prioritizing “green” technology over unsustainable technologies. It concludes not with a suggestion to overhaul the patent system, but to rid the system of technology neutrality and to introduce “soft” initiatives such as “green channels” to commercialize and incentivize sustainable technologies while still making these technologies public to avoid duplicative efforts.

Chapter 9 stays within the energy market but turns to the societal trend that the supply of electricity is no longer a one-sided supply but a multisided business. Chapter authors Joel B. Eisen and Kristen Jakobsen Osenga discuss the development of a “Smart Grid” that will use modern digital technologies that incorporate new resources to reduce carbon emissions and provide consumers with new options for generating, using, conserving, and transferring electricity. The chapter focuses on the development of standards for operability and the protection of IP rights in setting those standards, taking into consideration the balance between encouraging innovation and the dominance of individual firms to the exclusion of the public interest. The chapter authors conclude that while the processes of patenting and standard setting may seem contradictory, they are complementary and strike an appropriate balance due to standard-developing organizations requiring that a patentee disclose any patents necessary to set standards and provide a fair license for others.

In Chapter 10, the concept of open innovation in the energy sector is analyzed. Chapter author Catherine Banet explains how IP rights can still exist in an open innovation business model. Indeed, the chapter describes how the development of low-carbon technologies relies upon open innovation models to motivate further innovation and how clear agreements and rules around ownership of IP rights, such as the understanding of the ownership of the original IP and the ownership of co-created IP, stimulate knowledge sharing and innovation. The chapter concludes with a call to the energy industry to embrace open innovation models, with clear rules on IP ownership, and the joining forces of actors with different economic capabilities to accelerate innovation and benefits for society at large, balancing protection with global access.

*Intellectual Property and Sustainable Markets* offers unique and in-depth perspectives on how IP rights should be addressed in the SDGs for a better, more sustainable world, discussing many different industries and providing examples of how those industries



can assist in such an important goal. It is therefore eminently suited for non-lawyer businesspersons who wish to understand how two seemingly discrete and unrelated concepts interact and how they can address sustainability in their own business endeavors. However, it is also suited for policymakers around the globe, providing a valuable playbook for cooperation on international, regional, and national levels to include sustainability in market-based regulations. It is critical reading for those who understand the importance of development that meets the needs of the present while safeguarding the Earth's life-support system. But it is also useful for IP practitioners generally to better understand the effects IP rights have on sustainability and to gain insight on how to counsel sustainably minded clients.

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