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Article

***843** TEACHING TRADEMARK THEORY THROUGH THE LENS OF DISTINCTIVENESS

Mark P. McKenna [FNa1]

Introduction

Trademark law is a theoretically rich field, and courses covering the area are now staple offerings in law schools. [FN1] But in my experience, trademark law can be difficult to teach because many intellectual property casebooks organize trademark-related materials ineffectively. This is particularly a problem with many of the survey casebooks, [FN2] which tend to approach trademark law the same way they approach patent and copyright law, systematically marching through statutory requirements. This makes trademark law difficult for many students because trademark law has a different texture than other areas of intellectual property, and it springs from a wider variety of sources.

Patent rights are creatures of federal statute, [FN3] and cases interpreting the Patent Act overwhelmingly are governed by precedent from one federal court of appeals--the Federal Circuit. [FN4] While there is no analogous single appellate ***844** court for copyright cases, copyright claims, like patent claims, are litigated exclusively in federal courts. [FN5] Copyright law also derives predominantly from federal statute, particularly since Congress enacted the Copyright Act of 1976. [FN6] Under the previous Copyright Act of 1909, [FN7] federal copyright protection was available only for works that had been published, [FN8] and publication generally required distribution of copies to the public. [FN9] Because a good deal of creative content remained unpublished under this definition, federal copyright protection was available for only a fraction of the works produced prior to the 1976 Act's effective date. Unpublished works were left to state law, which therefore played a more significant role in the copyright scheme. The 1976 Act, however, dramatically expanded the role of federal law, at the expense of state law, by introducing federal copyright protection upon fixation of a work in tangible form. [FN10] As a result of this expansion, state law protection is valid with respect to works created under the 1976 Act only when the works are unfixed or where the state law rights are not “equivalent” to any of the exclusive rights of copyright. [FN11] Modern copyright law therefore focuses overwhelmingly, and increasingly, on federal statutory law.

Federal statutory law is much less significant in trademark law. There is a federal statute--the Lanham Act [FN12]--that broadly regulates the use of trademarks, but the statute does relatively little conceptual work in defining the nature and scope of trademark rights. Many of the foundational concepts of trademark law were developed by courts before the Lanham Act was enacted, [FN13] and Congress intended the Lanham Act to codify much of this earlier common ***845** law. [FN14] Consequently, early trademark decisions have continuing relev-

ance, even in cases involving registered trademarks, and whether those cases were decided as a matter of statutory or common law.

Some casebook authors have failed to appreciate the relative insignificance of the Lanham Act, however, because they have focused on another trend in trademark law. What these authors notice is that state law has played relatively little substantive role in modern trademark law, aside from the dilution context. While courts generally have not deemed state law preempted by the Lanham Act, at least where state law does not conflict with federal law, [FN15] courts frequently have interpreted state law under the same substantive standards as federal law. [FN16] Moreover, because courts have interpreted § 43(a) ***846** of the Lanham Act to allow protection of unregistered trademarks and trade dress, [FN17] parties can assert rights under the federal statute irrespective of registration status. These developments suggest to some increasing federalization of trademark law, and on some level that narrative is accurate. But this federalization is a fairly superficial one, and focusing too much on the statute overstates its conceptual significance.

Because the Lanham Act plays such a different role in trademark law than the relevant federal statutes do in patent and copyright law, trademark courses ought to be organized differently than other intellectual property courses. In particular, trademark courses should not initially focus on statutory requirements for registrability. For one thing, trademark registration confers few substantive advantages. Unlike patent rights, trademark rights are a function of use rather than registration, [FN18] and registered and unregistered trademarks receive mostly identical protection. [FN19] Moreover, while some validity inquiries are idiosyncratic to the registration system--the bar on registration of scandalous and immoral matter, for example [FN20]--many of the requirements for registrability echo the common law standards of protectability.

Consequently, trademark courses should begin with foundational principles rather than particular statutory provisions. Specifically, trademark classes should begin with the concept of distinctiveness, perhaps the most foundational of all trademark concepts. Distinctiveness has obvious doctrinal significance in its own right as the basis for distinguishing protectable trademarks from other matter. [FN21] The concept of distinctiveness also overlaps significantly with that of trademark strength, which is one of the factors that ***847** determines the scope of a party's rights. [FN22] Pedagogically, distinctiveness makes sense as a starting point because it is the perfect vehicle through which to teach trademark theory.

Trademark law has long struggled to balance the interests of consumers and producers. Sometimes the interests of both groups coincide such that protection in a particular context benefits both. But these interests coincide much less often than courts and commentators often pretend. In fact, a variety of doctrines can be examined from the different perspectives of consumers and producers, and many of them make more or less sense depending on the perspective one takes. The concept of distinctiveness is susceptible to evaluation from either perspective, and while the interests of consumers and producers tend to converge on this issue, forcing students to articulate both perspectives proves remarkably helpful down the road.

I. What is Distinctiveness?

The concept of distinctiveness plays a critical doctrinal role in trademark law because it differentiates designations that warrant trademark protection from those that do not. Distinctiveness in this context refers to the extent to which a claimed designation conveys to consumers information about the source of products or services as opposed to merely conveying product-related information. Protectable trademarks tell consumers something about who stands behind a product or service--they are distinctive of the source of the relevant products or ser-

vices. [FN23]

Courts traditionally have evaluated the distinctiveness of word marks by determining the meaning of the term at issue in the context in which it is used ***848** and placing it in one of four categories, in ascending order of distinctiveness: (1) generic, (2) descriptive, (3) suggestive, or (4) arbitrary or fanciful. [FN24] An arbitrary term is one with an understood meaning but which is used in an unfamiliar way--IVORY as applied to soap, for example. [FN25] Fanciful terms, sometimes called coined terms, are made up terms like XEROX or KODAK that have no ordinary, non-trademark meaning. [FN26] Arbitrary and fanciful terms are deemed inherently distinctive and protectable without need of evidence of actual consumer understanding, as are terms that are merely suggestive of a product's features or characteristics. [FN27]

A descriptive term, one that describes a product or its features, is not inherently distinctive, but it may become distinctive if it acquires "secondary meaning." [FN28] "Secondary meaning exists only if a significant number of prospective purchasers understand the term, when used in connection with a particular kind of good, service or business, not merely in its lexicographic sense, but also as an indication of association with a particular, even if anonymous, entity." [FN29] A generic term can never serve as a trademark because it is the generally recognized name of a product or service (car, for example) and therefore does not signify a particular source. [FN30]

This categorical approach works well with word marks because words have generally recognized meanings and it is relatively easy for courts to determine whether and how those meanings relate to the products or services with which they are used. But product design and packaging features rarely have such generally understood meanings, and as a result, the traditional framework is less helpful in determining whether trade dress features are sufficiently distinctive to warrant protection. [FN31] Nevertheless, as a conceptual matter, the task is the same with respect to trade dress as it is with word marks--even if doing so requires different tools, a court must determine ***849** whether claimed features signify source, because source signification is what makes something a trademark.

II. Why Does Distinctiveness Matter?

Source designation--distinctiveness--is the defining characteristic of protectable trademarks because trademark law's most fundamental goal is to preserve the integrity of source indicators. But stating the issue this way only begs a further question: why is it important for courts to intervene in commercial activities to preserve the meaning of words or other designations? As it turns out, the answer to that question depends to some extent on the perspective from which one views trademark law, and courts have long struggled to balance two sometimes competing perspectives.

A. Distinctiveness from the Search Costs Perspective

Courts and commentators now regularly claim that the goal of trademark law is to improve the quality of information in the marketplace and thereby reduce consumer search costs. [FN32] Trademarks, on this theory, are means by which consumers organize information about products or services. By preserving the integrity of these symbols, trademark law protects consumers from being deceived into buying products they do not want and allows consumers to rely on source indicators generally to reduce their costs of searching for products in the market. [FN33] Proponents of this view sometimes describe as a second purpose of trademark law protection of

producers' goodwill. When they do, however, they tend to describe this secondary goal in market efficiency terms, arguing that trademark law seeks to protect producer goodwill in order to encourage investment in product quality, [FN34] which ultimately benefits consumers.

***850** From this consumer-based perspective, limiting trademark protection to distinctive terms makes sense because search costs are reduced only when consumers can consistently match products or services with their source. When a designation indicates to consumers the source of the products or services with which it is used, consumers know who to credit with positive experiences and who to blame for bad experiences. When they later encounter other products or services that employ the same mark, consumers can use their past experiences--or those of others from whom they have learned--to evaluate the new products or services. This ability to use a mark as a shortcut evaluative tool is particularly valuable, as many have noted, when the new product or service at issue has qualities that are not directly observable. [FN35] In those cases, consumers can evaluate the product or service by proxy by transferring the knowledge they have about the source to the new product or service. [FN36]

This type of information transfer can only occur when a designation consistently refers to the same source across encounters. If a term never indicates to consumers the source of a product, or if it indicates different sources at different times or to different consumers, consumers will not be able to rely on past experiences to give them information about the quality or reliability of the product or service they encounter. The requirement that terms be distinctive of source therefore can be understood as an attempt to ensure that claimed designations receive protection only when consumers can use those designations to reduce their search costs. [FN37]

***851** B. The Producer Perspective

Trademark law traditionally limited protection to what are now called distinctive marks for a different reason. As nineteenth and early twentieth century courts repeatedly made clear, the original purpose of trademark law was to protect a party from illegitimate attempts to divert its trade. [FN38] When a plaintiff brought a trademark infringement claim, "'[t]he gist of the complaint . . . [was] that the defendant, by placing the complainant's trade-mark on goods not manufactured by the plaintiff, ha[d] induced persons to purchase them, relying on the trade-mark as proving them to be of plaintiff's manufacture."' [FN39]

From the point of view of a producer, terms that indicate source can be used as a calling card. When consumers associate a designation with a particular producer, those consumers can seek out a trusted producer by looking for the known designation in the marketplace. [FN40] Consumers cannot, however, use as a calling card terms that they do not associate with particular producers. And if consumers do not rely on a designation to indicate source, junior users who employ the same or similar designations cannot deceive consumers into buying their goods in place of the senior user's.

Consequently, from a producer perspective, the requirement of distinctiveness can be understood as an attempt to identify terms that might be used by competitors to pass off their products as those of another. Indeed, that was the original purpose of limiting protection to distinctive designations. But the requirement of distinctiveness makes sense even from a broader producer perspective that would encompass concerns about reputational damage that might result from consumer confusion about the source of non-competitive goods. For consumers to hold a mark owner responsible for the quality of another's goods, they must have some reason to suspect there is a relationship between the parties. If a claimed designation does not indicate source, there will be no reason for consumers to rely on the designation to attribute blame.

***852** C. The Consumer and Producer Perspectives in Trademark Law Generally

It may not seem particularly important to articulate both of these perspectives in the context of distinctiveness, since they seem generally to suggest the same rules. But distinctiveness is a useful vehicle for fleshing out the consumer and producer perspectives because they are relatively easy to understand in this context. And thinking about trademark law from both perspectives is important since a variety of other doctrines make more sense from one perspective or the other.

From a consumer protection perspective, for example, dilution seems a striking departure from traditional trademark principles. Dilution claims allow certain trademark owners--the owners of "famous" [FN41] trademarks--to assert claims in situations when no consumers are confused about the defendant's use. [FN42] It does so despite the fact that trademark theory focuses predominantly on preventing consumer confusion in order to reduce search costs. [FN43] But while dilution claims vindicate a different producer interest than confusion-based claims, particularly confusion-based claims focused on trade diversion, these claims seem less radical from the producer perspective. [FN44]

Dilution is not the only doctrine that might look different depending on one's perspective. Some modern confusion doctrines like post-sale confusion and initial interest confusion can seem difficult to explain from a consumer perspective. [FN45] Confusion of those who encounter a product in contexts ***853** removed from the time or space in which purchasing decisions are made is much less directly related to search costs. Decisions recognizing such confusion as actionable clearly seem more concerned with a producer interest in exclusive use of an attractive mark. In fact, though McCarthy initially attempts to characterize post-sale confusion in consumer search terms, he ultimately concedes that the real concern is that "consumers could acquire the prestige value of the senior user's product by buying the copier's cheap imitation." [FN46] The producer interests in these cases unquestionably is a different one than courts have traditionally recognized, but these decisions can at least be discussed intelligently (and honestly) in terms of the producer interests at stake.

These are but a few examples of situations in which perspective matters in trademark law. Students can engage in much richer discussion of these and other situations having articulated and considered both perspectives, and distinctiveness is an effective context in which to introduce these perspectives. Thus, in addition to its doctrinal significance, distinctiveness provides a solid theoretical foundation for a trademark course.

[FNa1]. Assistant Professor of Law, Saint Louis University.

[FN1]. Kenneth L. Port, Intellectual Property Curricula in the United States, 46 IDEA 165, 170 (2005) (documenting courses in trademark law at 106 schools as of 2005).

[FN2]. By "survey casebooks" I mean books that purport to cover the intellectual property waterfront (with sections covering at least patent, copyright, and trademark) as opposed to books focused particularly on trademark law.

[FN3]. The Patent Act contains no express preemption clause, but the Supreme Court has held state laws that afforded patent-like protection preempted under the Supremacy Clause. See Bonito Boats v. Thunder Craft Boats,

Inc., 489 U.S. 141, 168 (1989).

[FN4]. Since it was created in 1982, the Court of Appeals for the Federal Circuit has had exclusive appellate jurisdiction over appeals arising under the patent laws. Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, 96 Stat. 25 (1982) (establishing the Federal Circuit); 28 U.S.C. § 1295 (2000). There is one small exception to the Federal Circuit's hegemony; the Federal Circuit does not have appellate jurisdiction over cases in which the patent issues arise only by way of counterclaim. See Holmes Group, Inc. v. Vornado Air Circulation Sys., Inc., 535 U.S. 826 (2002) (holding that Federal Circuit does not have appellate jurisdiction over case in which complaint did not state patent law claim but answer contained patent law counterclaim).

[FN5]. 28 U.S.C. § 1338(a) (2000).

[FN6]. 17 U.S.C. §§ 101-805 (2000).

[FN7]. Act of Mar. 4, 1909, ch. 320, 35 Stat. 1075, repealed by Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (codified as amended at 17 U.S.C. §§ 101-805 (2000)).

[FN8]. Copyright Act of 1909, ch. 320, § 9, 35 Stat. 1075, 1077 (repealed 1976) ("[A]ny person entitled thereto by this Act may secure copyright for his work by publication thereof with notice of copyright ....").

[FN9]. For this reason, public performance of a work is not sufficient to claim rights under the Copyright Act of 1909. See Estate of of Martin Luther King, Jr. v. CBS, Inc., 194 F.3d 1211, 1217 (11th Cir. 1999) ("A performance, no matter how broad the audience, is not a publication....").

[FN10]. 17 U.S.C. § 102(a) ("Copyright protection subsists ... in original works of authorship fixed in any tangible medium of expression ....").

[FN11]. See 17 U.S.C. §§ 301(b)(1), (3). The Copyright Act also expressly preempts state law that provides protection "equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright." 17 U.S.C. § 301(a).

[FN12]. 15 U.S.C. §§ 1051-1141 (2000).

[FN13]. See Mark P. McKenna, The Normative Foundations of Trademark Law, 82 Notre Dame L. Rev. 1839, 1887-96 (2007).

[FN14]. See. Robert. C. Denicola, Some Thoughts on the Dynamics of Federal Trademark Legislation and the Trademark Dilution Act of 1995, 59 Law & Contemp. Probs. 75, 79-80 (1996) ("Putting aside statutory innovations directly linked to the public notice provided by the Act's registration system, the Lanham Act codifie[d] the basic common law principles governing both the subject matter and the scope of protection.")

[FN15]. See Colonial Penn Group, Inc. v. Colonial Deposit Co., 834 F.2d 229, 234 n.3 (1st Cir. 1987) ("It cannot be argued that the Lanham Act has completely preempted state common law service mark protection."); Spartan Food Sys., Inc. v. HFS Corp., 813 F.2d 1279, 1284 (4th Cir. 1987) ("The Lanham Act does not preempt all state law pertaining to trademarks."); Keebler Co. v. Rovira Biscuit Corp., 624 F.2d 366, 372 n.3 (1st Cir. 1980) ("The Lanham Act does not preempt the states' ability to recognize and protect trademark rights .... The Supremacy Clause bars only state statutes or doctrine that would permit the sort of confusing or deceptive prac-

tices the draftsman of the Lanham Act sought to prevent."). To the extent they have focused on conflicting state and federal law, courts have been more concerned about state laws that appear to narrow federal rights. See Davidoff Extension S.A. v. Davidoff Comercio E Industria Ltda., 747 F. Supp. 122, 126-27 (D.P.R. 1990) (holding principle that state trademark law cannot defeat the rights of a federal registrant applies with respect to Puerto Rican law); American Auto. Ass'n v. AAA Ins. Agency, Inc., 618 F. Supp. 787, 798 (W.D. Tex. 1985) (articulating rule that state law cannot defeat or limit protection given to federally registered marks).

[FN16]. The United States Trademark Association drafted the first Model State Trademark Bill in 1949, which it patterned after the Lanham Act in most substantive respects. See 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 22:5 (4th ed. 2007). By 1992, when the Model Bill was redrafted, forty-six states had used the Model Trademark Bill as the basis for their state trademark legislation. See id.; Model State Trademark Bill (1992), reprinted in McCarthy supra, § 22:9. Courts, therefore, often rely on federal case law in interpreting state laws based on the Model State Trademark Bill. See, e.g., Rolls-Royce Motors, Ltd. v. A & A Fiberglass, Inc., 428 F. Supp. 689, 693-94 (N.D. Ga. 1977); Tio Pepe, Inc. v. El Tio Pepe de Miami Restaurant, Inc., 523 So. 2d 1158, 1159-60 n.6 (Fla. Dist. Ct. App. 1988) (holding that case law applying the federal Lanham Act should be regarded as persuasive authority for interpreting and construing the state statute). At the same time, federal courts often lump their analysis of state law claims into their discussion of federal law claims, noting the overlapping standards. See, e.g., Louis Vuitton Malletier v. Dooney & Burke, Inc., 454 F.3d 108, 119 (2d Cir. 2006) ("We analyze claims under New York's unfair competition statute in a similar fashion to how we analyze claims under the Lanham Act."). Some greater variation may exist between federal and state dilution laws, in large part because there was no federal dilution protection before 1996. See Moseley v. V Secret Catalogue, Inc., 537 U.S. 418, 430-32 (2003) (contrasting language of the Federal Trademark Dilution Act of 1996 with that of state statutes that required only likelihood of dilution). Since Congress enacted the Trademark Dilution Revision Act in 2006, however, the extent to which state and federal dilution law now diverge is a bit unclear. See Pub. L. No. 109-312, 120 Stat. 1730 (codified at 15 U.S.C. § 1125(c) (2006)).

[FN17]. Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 768 (1992) (stating that "it is common ground that § 43(a) protects qualifying unregistered trademarks and that the general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a)").

[FN18]. While copyright protection technically attaches at the moment an author fixes her work in a tangible medium of expression, registration is a prerequisite to filing suit under the Copyright Act for all works created in the U.S. See 17 U.S.C. § 411 (2000).

[FN19]. The one notable substantive advantage of federal registration is the opportunity to achieve incontestable status, which limits the grounds on which a defendant can challenge the validity of one's trademark rights. See 15 U.S.C. § 1115.

[FN20]. 15 U.S.C. § 1052(a).

[FN21]. See Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9-11 (2d Cir. 1976) (setting out classic spectrum of distinctiveness).

[FN22]. Trademark strength is one of the factors courts generally consider in the likelihood of confusion analysis. See, e.g., Polaroid Corp. v. Polrad Elecs. Corp., 287 F.2d 492, 495 (2d Cir. 1961). Strength refers both to a term's inherent distinctiveness and to its actual distinctiveness in the commercial marketplace, and courts regu-

larly note that strong marks are entitled to a broader scope of protection. See, e.g., Freedom Card, Inc. v. JPMorgan Chase & Co., 432 F.3d 463, 472 (3d Cir. 2005) (“In evaluating the strength of the mark ..., we examine: (1) the mark's distinctiveness or conceptual strength (the inherent features of the mark) and (2) its commercial strength (factual evidence of marketplace recognition).”) (internal citation omitted); Exxon Corp. v. Texas Motor Exch. of Houston, Inc., 628 F.2d 500, 504 (5th Cir. 1980) (“In short, the more distinctive a trademark, the greater its ‘strength.’ The strength of a trademark is important in determining the scope of protection that is granted.”); AMF Inc. v. Sleekcraft Boats, 599 F.2d 341, 349 (9th Cir. 1979) (“A strong mark is inherently distinctive, for example, an arbitrary or fanciful mark; it will be afforded the widest ambit of protection from infringing uses.”).

[FN23]. In the language of the statute, a mark is distinctive when it “identif[ies] and distinguish[es] [a party's] goods ... from those manufactured or sold by others” and “indicate[s] the source of the goods.” 15 U.S.C. § 1127. Under modern law, consumers need not be able to name the source of a product or service; it is sufficient that consumers expect all goods with the same mark to emanate from a single, if anonymous, source. See id. (requiring indication of source, “even if that source is unknown”); see also McCarthy, supra note 16, § 3:9.

[FN24]. Abercrombie & Fitch, 537 F.2d at 9.

[FN25]. See Zatarains, Inc. v. Oak Grove Smokehouse, Inc., 698 F.2d 786, 791 (5th Cir. 1983).

[FN26]. See id.

[FN27]. Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 768 (1992); Abercrombie & Fitch, 537 F.2d at 11.

[FN28]. Two Pesos, 505 U.S. at 769.

[FN29]. Restatement (Third) of unfair competition § 13 cmt. e (1995).

[FN30]. Two Pesos, 505 U.S. at 768.

[FN31]. For this reason, and because of the potential for trade dress protection to conflict with patent protection of design features, courts have created additional considerations in this context. First, the Supreme Court has distinguished between product design and product packaging and declared that, with respect to product design features, parties may not rely on presumptions of source significance but must demonstrate it by providing evidence of secondary meaning. Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 212-15 (2000). Second, courts have long held, and the Lanham Act now explicitly states, that functional product features, even those with source significance, are ineligible for trademark protection. See 15 U.S.C. §§ 1052(e)(5), 1125(a)(3).

[FN32]. See, e.g., Qualitex Co. v. Jacobsen Prods. Co., 514 U.S. 159, 163-64 (stating that trademark law “‘reduce[s] the customer's costs of shopping and making purchasing decisions,”’ and “helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product”); William M. Landes & Richard A. Posner, The Economic Structure of Intellectual Property Law 166-68 (2003); Stacey L. Dogan & Mark A. Lemley, Trademarks and Consumer Search Costs on the Internet, 41 Hous. L. Rev. 777, 778 (2004) (arguing that the normative goal of trademark law is to foster the flow of information in markets, thereby reducing search costs for consumers).

[FN33]. See Landes & Posner, supra note 32, at 166-68; Glynn S. Lunney, Jr., Trademark Monopolies, 48 Emory L.J. 367, 417 (1999) (arguing that trademark “[o]wnership [is] assigned to the person who adopt[s] the

mark for her trade, not because she ... created it or its favorable associations, but because such person [is] conveniently placed and strongly motivated to vindicate the broader public interest in a mark's ability to identify accurately the source of the goods to which it [is] attached").

[FN34]. See Qualitex, 514 U.S. at 163-64 (stating that trademark law "'reduce[s] the customer's costs of shopping and making purchasing decisions,"' and "helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product") (internal citation omitted); Union Nat'l Bank of Tex., Laredo, Tex. v. Union Nat'l Bank of Tex., Austin, Tex., 909 F.2d 839, 844 (5th Cir. 1990) ("The idea is that trademarks are 'distinguishing' features which lower consumer search costs and encourage higher quality production by discouraging free-riders."); Eric Goldman, Deregulating Relevancy in Internet Trademark Law, 54 Emory L.J. 507, 554-55 (2005) (arguing that trademark law serves dual purposes: protecting consumers from confusion when making purchasing decisions and protecting producers' investments in quality that creates consumer goodwill towards them).

[FN35]. See, e.g., Ann Bartow, Likelihood of Confusion, 41 San Diego L. Rev. 721, 729 (2004) ("[T]rademarks serve the interests of consumers by reducing search costs and allowing buyers to 'make rational purchasing and repurchasing decisions with speed and assurance,' while simultaneously 'creat [ing] incentives for firms to create and market products of desirable qualities, particularly when these qualities are not observable before purchase."' (quoting Marshall A. Leaffer, The New World of International Trademark Law, 2 Marq. Intell. Prop. L. Rev. 1, 5-6 (1998))).

[FN36]. This assumes, of course, that the fact that a particular entity stands behind products over a period of time is a reliable indicator of consistent quality.

[FN37]. More specifically, the rule that certain terms can be deemed inherently distinctive and protectable without evidence of secondary meaning might be seen as incentive for producers to adopt as their trademarks designations that are particularly likely to help consumers reduce their search costs.

[FN38]. See, e.g., Canal Co. v. Clark, 80 U.S. 311, 322-23 (1871) ("[I]n all cases where rights to the exclusive use of a trade-mark are invaded, it is invariably held that the essence of the wrong consists in the sale of the goods of one manufacturer or vendor as those of another; and that it is only when this false representation is directly or indirectly made that the party who appeals to the court of equity can have relief. This is the doctrine of all the authorities."); Coats v. Holbrook, 7 N.Y. Ch. Ann. 713, 717 (1845) (holding that a person is not allowed to imitate the product of another and "thereby attract to himself the patronage that without such deceptive use of such names ... would have inured to the benefit of that other person").

[FN39]. Am. Washboard Co. v. Saginaw Mfg. Co., 103 F. 281, 284 (6th Cir. 1900) (quoting Lord Cranworth in Leather Cloth Co. v. Am. Leather Cloth Co., (1865) 11 H.L.C. 523, 536, 11 Eng. Rep. 1435, 1441 (H.L.) (appeal taken from Eng.)).

[FN40]. See Landes & Posner, supra note 32, at 167.

[FN41]. Fame is an explicit requirement for federal dilution protection, although some state dilution provisions do not, on their face, limit protection to famous marks. See 15 U.S.C. § 1125(c)(1) (2000).

[FN42]. See 15 U.S.C.A. § 1125(c)(1) (West 2007) ("the owner of a famous mark that is distinctive ... shall be entitled to an injunction against another person who ... commences use of a mark or trade name in commerce

that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury"). The concept of dilution is generally attributed to Frank Schechter and his article The Rational Basis of Trademark Protection, 40 Harv. L. Rev. 813 (1927). Schechter focused on distinctive marks that had been "added to rather than withdrawn from the human vocabulary ... and have, from the very beginning, been associated in the public mind with a particular product, not with a variety of products, and have created in the public consciousness an impression or symbol of the excellence of the particular product in question." Id. at 829. He argued that the owners of such marks should be entitled to preserve the distinctiveness or "selling power" of their marks by asserting claims against others who would associate the mark with a second producer. See id. at 830-33. Dilution developed sporadically through the twentieth century, initially adopted by a number of states, but resisted by courts, and only recognized at the federal level in 1996. See McCarthy, supra note 16, § 24:67.

[FN43]. See supra notes 32-36 and accompanying text.

[FN44]. I am not suggesting here that dilution claims necessarily vindicate producer interests that deserve protection, only that the policy discussion has a different texture when the producer perspective is recognized.

[FN45]. Post-sale confusion cases focus on the possible confusion of individuals who encounter a product after it has been purchased, ostensibly on the theory that those viewers might be confused about the origin of the product they see. See, e.g., Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-Le Coultre Watches, Inc., 221 F.2d 464, 466 (2d Cir. 1955). Initial interest confusion cases focus on uses of a trademark to gain the attention of consumers initially, even if any confusion about a possible relationship between the trademark owner and the other party is dispelled before purchase. See, e.g., Brookfield Commc'ns v. West Coast Entm't Corp., 174 F.3d 1036, 1062 (9th Cir. 1999).

[FN46]. McCarthy, supra note 16, § 23:7, at 23-37.
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