

“S.O.S.”: SAVE OUR SERVICE MARKS

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Soldiers join the Army to become part of a values and tradition based culture. While the Army Values help deepen existing personal values, such as family bonds, work ethic, and integrity, it is tradition that ties Soldiers and their families into military culture. Unit history is an important factor for that bonding, since Soldiers want to belong to organizations with distinguished service records. Unit names, such as the Big Red One, Old Ironsides, All Americans, and Spearhead carry an extensive history. To sustain tradition, leaders must teach Soldiers the history that surrounds unit crests, military greetings, awards, decorations, and badges. Through leading by example, teaching, and upholding traditions, leaders ensure that the Army's culture becomes an integral part of every member of the Army team and adds purpose to their lives.¹

I. Introduction

Since September 11th, 2001, domestic support for the U.S. Army has been overwhelming.² This public support ranges from messages to

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¹ U.S. DEP'T OF ARMY, FIELD MANUAL 6-22, ARMY LEADERSHIP: COMPETENT, CONFIDENT, AND AGILE § 8-8 (Oct. 2006).

² ERIC V. LARSON & BOGDAN SAVYCH, AMERICAN PUBLIC SUPPORT FOR U.S. MILITARY OPERATIONS FROM MOGADISHU TO BAGHDAD 92–93 (Rand 2005).

troops from private citizens³ to free goods and services from corporations.⁴ Visible signs of support are more pervasive in cities near U.S. Army installations. In these cities, you cannot travel five minutes without seeing a yellow ribbon magnet on a vehicle with the phrase “support our troops.” You cannot walk through a gym without seeing a local unit’s t-shirt with some motivational motto.⁵ Finally, you cannot pass through an installation without seeing a hat with some kind of military symbol.⁶ This significant display of public support contributes to the morale of Soldiers everywhere. However, the public’s support of our Soldiers may actually harm the U.S. Army by endangering its marks.⁷

³ See, e.g., U.S. Dep’t of Defense, Message Submit Form, <http://www.americasupportsyou.mil/americasupportsyou/Message.aspx?SectionID=5> (last visited Jan. 7, 2009). For example, the America Supports You website allows people to send servicemembers support messages. *Id.*

⁴ See, e.g., Walt Disney World, News Rumors Photos Reviews Discussion Forum, <http://www.wdwmagic.com/Resorts/Walt-Disney-World-Resorts-information/News/05Jan2009-Disney’s-Armed-Forces-Salute-2009---Complimentary-5-Day-tickets.htm> (last visited Jan. 7, 2009). Walt Disney World offers complimentary five-day passes to active duty and retired servicemembers. *Id.*

⁵ The 2d Battalion, 3d Special Forces Group (Airborne) motto is “WE DO BAD THINGS TO BAD PEOPLE.” Prince Harry of England wore a hat stitched with this motto while he served in Afghanistan. Posting of Debarshi to Huh?, <http://persophile.blogspot.com/2008/03/prince-harry-does-bad-things-to-bad.html> (Mar. 3, 2008, 16:07 EST).

⁶ Many military retirees wear baseball hats with the unit patch of their former unit.

⁷ “The term ‘mark’ includes any trademark, service mark, collective mark, or certification mark.” Lanham Act, 15 U.S.C. § 1127 (2006). A service mark is

any word, name, symbol, or device, or any combination thereof—

- (1) used by a person, or
- (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act,

to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.

Id. A collective mark is

a trademark or service mark—

- (1) used by the members of a cooperative, an association, or other collective group or organization, or
- (2) which such cooperative, association, or other collective group

United States Army phrases, unit patches, mottos, and symbols displayed on merchandise are marks that represent U.S. Army units individually and the U.S. Army as a whole.⁸ Consequently, the U.S. Army has an interest in protecting its marks.⁹ When used to identify the origin and goodwill of the U.S. Army, these phrases, unit patches, mottos, and symbols function as trademarks.¹⁰ Trademark law protects the connection between a particular mark and its origin.¹¹ Nevertheless,

or organization has a bona fide intention to use in commerce and applies to register on the principal register established by this Act, and includes marks indicating membership in a union, an association, or other organization.

Id. A certification mark is

any word, name, symbol, or device, or any combination thereof—

- (1) used by a person other than its owner, or
- (2) which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by this Act, to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.

Id.

⁸ Memorandum from Ronald J. James, Assistant Sec'y of the Army (Manpower and Reserve Affairs), to Admin. Assistant to the Sec'y of the Army et al., subject: Army Trademark Licensing Program (13 Jan. 2009) [hereinafter James Memo]. In addition to phrases and symbols, a mark can include any word, name, or device or any combination. 15 U.S.C. § 1127. However, this article will only focus on U.S. Army phrases and symbols as a complete discussion of every type of mark and the law governing it would be too lengthy and too unwieldy for the scope of this article.

⁹ See U.S. DEP'T OF ARMY, REG. 672-8, MANUFACTURE, SALE, WEAR, AND QUALITY CONTROL OF HERALDIC ITEMS para. 2-5 (5 Apr. 1996) [hereinafter AR 672-8].

¹⁰ James Memo, *supra* note 8. The Lanham Act defines a trademark as

any word, name, symbol, or device, or any combination thereof—

- (1) used by a person, or
- (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

15 U.S.C. § 1127.

¹¹ *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 412 (1916). For example, when you see a blue oval with script lettering on an automobile, you may think of Ford Motor Company. When you hear “all the news that's fit to print,” you may think of the *New*

that connection can be broken if the originator of the mark loses control of its mark, resulting in the potential abandonment of trademark rights.¹²

The U.S. Army has been developing marks to specifically identify and distinguish different units, specialties, and installations within the U.S. Army for the past 200 years.¹³ One example is the U.S. Special Operations Command (USSOCOM); their mission is to “[p]rovide fully capable Special Operations Forces to defend the United States and its interests.”¹⁴ The Shoulder Sleeve Insignia (SSI) distinguishing their unit is the following:

York Times. The symbol and phrase are trademarks of their respective companies. Similarly for the U.S. Army, when Soldiers see a black patch with an eagle, they immediately think of the symbol representing the 101st Airborne Division. In 1981, N.W. Ayer & Son, the first advertising agency in the United States, created “Be all you can be,” a catchy phrase the U.S. Army used to recruit people. Scripophily, N.W. Ayer & Sons (First advertising agency in the United States), <http://www.scripophily.net/naysonde19.html> (last visited Mar. 2, 2009).

¹² *First Interstate Bancorp v. Stenquist*, 1990 U.S. Dist. LEXIS 19426, at *7 (N.D. Cal. July 13, 1990). For example, if civilians change the designs of U.S. Army marks and the U.S. Army does not intervene, the U.S. Army may lose trademark rights in those marks. Loss of control of a mark, a common law doctrine, is one method of losing trademark rights and can occur through naked licensing, failure to police, or dilution. See *infra* notes 128, 208, 220 and accompanying text (explaining the doctrine of loss of control of a mark).

¹³ E-mail from J. Scott Chafin, Trademark and Copyright Attorney, USALSA, to author (8 Jan. 2009, 07:39 EST) [hereinafter Chafin e-mail] (on file with author). However, “unit insignia did not really become widespread in use even remotely like it is today until the Civil War, when the large-scale movement of many units on a personnel-dense battlefield required that commanders know which soldiers belonged with which unit.” *Id.* Mr. Scott Chafin holds the position of Trademark and Copyright Attorney in the Regulatory Law and Intellectual Property Division, U.S. Army Legal Services Agency (USALSA), a field operating agency of The Judge Advocate General of the Army. Mr. Chafin is primarily responsible for trademark and copyright law matters, with trademark protection, enforcement, and licensing occupying the bulk of his practice. In that capacity, he files applications to register trademarks with the U.S. Patent and Trademark Office and maintains existing registrations. Currently, he manages over 200 federal trademark registrations and pending applications. In addition, by direction of the Secretary of the Army, Mr. Chafin’s office is responsible for providing legal services to the U.S. Army Trademark Licensing Program. Mr. Chafin received a Bachelor of Science degree from Stephen F. Austin State University, Nacogdoches, Texas, in 1971, and a Juris Doctor degree from the University of Texas at Austin in 1975. Mr. Chafin is a member of the State Bar of Texas and the American Intellectual Property Law Association and is also a registered patent attorney, U.S. Patent and Trademark Office.

¹⁴ Headquarters, U.S. Special Operations Command Home Page, <http://www.socom.mil/> (last visited Jan. 16, 2009).



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Although traditional trademark law is but one method of protecting the U.S. Army's marks, the U.S. Army may inadvertently lose claim to exclusive ownership and control of its marks with its increased commercial popularity under traditional trademark law. Private companies targeting the military population often attempt to capitalize on the U.S. Army marks. SOCOM GEAR¹⁶ is an example of such a company; it sells tactical gear and weapons online. Their logo is the following:



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¹⁵ This patch is the official SSI of USSOCOM. Google, Google Image Search, <http://images.google.com/imghp?hl=en&tab=wi> (search for "ussocom patch," follow www.globalspecialoperations.com hyperlink) (last visited Jan. 16, 2009).

¹⁶ SOCOM GEAR Home Page, <http://www.socomgear.com/english/> (last visited Jan. 16, 2009) [hereinafter SOCOM GEAR].

¹⁷ This is SOCOM GEAR's logo. *Id.*

The striking similarities between both graphics may mislead and deceive the public into believing the U.S. Army endorses SOCOM GEAR.¹⁸ As The U.S. Army could even lose its rights to the USSOCOM mark due to the demanding requirements of trademark protection, requirements that the U.S. Army's marks are not always able to meet.¹⁹ If the U.S. Army loses exclusive rights in its marks to a company, the loss could result in that company charging the U.S. Army for use of the marks in commercials,²⁰ preventing Soldiers from using the term "Hooah!,"²¹ or altering the appearance of current U.S. Army marks. To prevent these problems, Congress should pass a special statute that supplements traditional trademark law ensuring the U.S. Army maintains exclusive ownership rights in its marks and thereby preserves its significantly rich military history.

Part II of this article explains the fundamental principles of trademark law. With a rudimentary understanding of these principles, Part III next introduces how trademarks function in the commercial world. Part IV explains how phrases and symbols uniquely function in the military, especially Army settings, and notes how, in recognizing these important functions, the U.S. Army's senior leadership has called for additional protections. As an increasing number of Army phrases and symbols have been licensed, the leadership has increasingly scrutinized

¹⁸ *United States Navy Weekly Inc. v. Fed. Trade Comm'n*, 207 F.2d 17, 18 (D.C. Cir. 1953) (affirming that United States Navy Weekly misled and deceived the public into believing that the U.S. Navy endorsed the company). *See, e.g.*, *Fed. Trade Comm'n v. Army and Navy Trading Co.*, 88 F.2d 776, 777 (D.C. Cir. 1937) (upholding an order to eliminate the words "Army and Navy" from a private company's trade name on the basis that "their use was to the injury of competitors and the public"). In this case, in fact, the threat of public confusion was so great, that the court rejected the use of qualifiers on the basis that they were nevertheless contradictory with the single theme represented in the name. *Id.* at 779–80 (rejecting the following disclaimers "Not Connected with the Army and Navy," "Not Connected with the Government," "Not a Government Store," "Not Affiliated with the United States Government," and "We Do Not Handle Exclusively Army and Navy Goods").

¹⁹ *See infra* Part V.C and accompanying text (explaining the doctrine of loss of control of a mark).

²⁰ *See* Captain Robert F. Altherr, Jr., *Patents, Copyrights, and Trademarks Note: Be All You Can Be (R) and the Army Mule*, *ARMY LAW.*, Dec. 1986, at 52, 52 (providing an example where a company attempted to register the Army Mule, which could have complicated licensing efforts by West Point).

²¹ "Hooah!" refers "to or mean[s] anything and everything except 'no.'" Hooah, <http://www.cavhooah.com/hooah.htm> (last visited Jan. 19, 2009).

the U.S. Army's trademark program,²² uncovering many of the Lanham Act's deficiencies in protecting U.S. Army marks.²³

Part V builds upon the deficiencies identified in Part IV and provides specific scenarios where the U.S. Army could lose exclusive rights in its phrases and symbols, demonstrating the shortcomings of traditional trademark law. These shortcomings of the Lanham Act reveal the need for complementary protection to adequately preserve U.S. Army phrases and symbols. Part VI supports the adoption of a special statute, similar to statutes already protecting both the U.S. Marine Corps and U.S. Coast Guard,²⁴ that Congress should pass augmenting phrase and symbol²⁵ protection under current trademark law. With these necessary interventions, the U.S. Army can finally enjoy complete protection of its marks.

II. Fundamental Principles of Trademark Law

Enacted in 1946, the Lanham Act has the objective of protecting "legitimate business and the consumers of the country" and does this by providing a set of federal legal rights and remedies for trademark owners.²⁶ Before identifying the problems with the Lanham Act,²⁷ this

²² Telephone Interview with J. Scott Chafin, Trademark and Copyright Attorney, in Arlington, Va. (Jan. 16, 2009) [hereinafter Chafin Interview]; see U.S. DEP'T OF DEF., DIR. 5535.09, DOD BRANDING AND TRADEMARK LICENSING PROGRAM 3 (19 Dec. 2007) [hereinafter DoDD 5535.09]; see also James Memo, *supra* note 8.

²³ Chafin Interview, *supra* note 22.

²⁴ See Marine Corps, 10 U.S.C. § 7881 (2006) (protecting Marine Corps marks); Coast Guard [and other names] 14 U.S.C. § 639 (2006) (protecting Coast Guard marks). See also *infra* notes 303–08 and accompanying text (discussing statutory protection for a host of other governmental and organizational marks)

²⁵ I will refer to U.S. Army identifiers as "phrases and symbols" in the special statute as opposed to "marks" under the Lanham Act. A "mark" is a term of art that has achieved protection under the Lanham Act. Although some U.S. Army "symbols" are capable of becoming "marks" under the Lanham Act, many fail to meet the requirements.

²⁶ *Two Pesos v. Taco Cabana*, 505 U.S. 763, 781–82 (1992) (Stevens, J., concurring).

The basic purpose of the Federal Trademark Act is twofold: One is to protect the public so it may be confident in purchasing a product bearing a particular trademark which it favorably knows, it will get the product in which it asks for and wants to get. Second, where the owner of a trademark has spent energy, time and money in presenting to the public the product, he is expected in his investment from its misappropriation by pirates and cheats.

part begins with a basic understanding of the background and principles of trademark law, including the earliest goals of trademark law and the reasons why commercial companies, consumers, and Congress had an interest in protecting the origin of any product. Further, this part examines the development of protective procedures that culminated in the Lanham Act.

A. Objectives of Trademark Protection

The goal of trademark law is to link a mark to the origin of a particular product.²⁸ Trademark law protects this link by guarding an organization's²⁹ investment in goodwill³⁰ and a consumer's investment in an authentic product.³¹ Governmental organizations, including military agencies, are eligible for trademark protection even if their business is not predicated on commercial ventures. For ease of reference, this article uses the term "company" broadly to include military and nonprofit agencies. United States trademark law stems from the Lanham Act,³² which seeks to shield companies from unfair competition.³³ The Lanham Act preserves a company's investment in developing a mark and prevents third parties from using the mark to confuse consumers.³⁴ Decision makers at companies understand the importance of safeguarding their companies' marks and consequently spend large

S. REP. NO. 1333, at 8137.

²⁷ 15 U.S.C. §§ 1051–1141 (2006).

²⁸ *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 412 (1916).

²⁹ Many other entities such as non-profit organizations and governmental agencies may own trademark rights as well. Chafin e-mail, *supra* note 13.

³⁰ For example, NBC's marks of the NBC chime and the rainbow peacock are associated with NBC's services. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995).

³¹ *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1360 (C.C.P.A. 1973) (quoting S. REP. NO. 1333, 79th Cong., 2d Sess. (1946), *in* U.S.C.C.A.N., 79th Cong., 2d Sess. at 1274–8 (1946)). Domestic trademark law protects consumers when they purchase authentic Nike shoes with the swoosh mark in the United States. Other countries often fail to provide the same protections. For example, Shoemanchina Trading Company sells "Niike" Air Max Plus shoes, cheap reproductions of the authentic Nike shoes. Ecplaza Global, Niike Shoes, Air Max Plus-4, Shoemanchina Trading Co., Ltd., http://www.ecplaza.net/product/85040_221812/niike_shoes_air_max_plus4.html (last visited May 16, 2009).

³² Lanham Act, 15 U.S.C. §§ 1051–1141 (2006).

³³ *See* *Ames Pub. Co. v. Walker-Davis Publ'ns, Inc.*, 372 F. Supp. 1, 11 (E.D. Pa. 1974) (defining the intent of the Lanham Act).

³⁴ *See id.* (explaining the purpose of the Lanham Act).

amounts of money to protect them.³⁵ Still, companies' efforts do not always deter infringers, who often ignore trademark laws, and often have to pay millions in damages when pursued in courts.³⁶

Congress designed the Lanham Act to protect companies in their development of marks and to prevent consumer confusion as to the origin of marks.³⁷

The intent of this [Lanham] Act is to regulate commerce³⁸ within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce; to protect registered marks used in such commerce from interference by State, or territorial legislation; to protect persons engaged in such commerce against unfair competition; to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks; and to provide rights and remedies stipulated by treaties and conventions respecting trademarks, trade names, and unfair

³⁵ See *McNeil Consumer Brands v. United States Dentek Corp.*, 116 F. Supp. 2d 604, 606 (E.D. Pa. 2000) (finding McNeil spent over \$220 million a year in developing the Tylenol mark); see also *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 559 F. Supp. 2d 472, 477 (S.D.N.Y. 2008) (finding that Starbucks spent over \$136 million in developing the Starbucks mark over three years); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 7 (2d Cir. 1976) (discussing the large sums of money Abercrombie and Fitch spent to develop its Safari mark).

³⁶ See Posting of Kalyan C. Kankanala to Sinapse, <http://brainleague.blogspot.com/2008/05/adidas-wins-305-million-dollars-as.html> (May 7, 2008, 16:07 EST) (reporting the \$305 million damages awarded to Adidas for Collective Brands' infringement of Adidas' three stripe mark).

³⁷ *Ames Pub. Co., Inc.*, 372 F. Supp. at 11.

³⁸ See *infra* note 97 defining use in commerce under the Lanham Act. "The term 'use in commerce' means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark." 15 U.S.C. § 1127 (2006). McDonalds clearly uses their slogan "I'm lovin' it" in commerce. See McDonald's Home Page, McDonald's Internet Site Terms and Conditions, <http://www.mcdonalds.com/terms.html> (last visited Mar. 1, 2009) (listing all of McDonald's trademarks). McDonald's uses the slogan in television commercials, prints it on their cups, and displays it on the side of their trucks. In contrast, many, U.S. Army marks, such as unit crests, are not used in the same manner. *But cf.* U.S. Trademark No. 2272122 (filed June 19, 1998) (providing the registration for The Judge Advocate General's Legal Center and School's crest as a service mark with the words *Reverentia Legum*). Altherr, *supra* note 20, at 52.

competition entered into between the United States and foreign nations.³⁹

Despite over sixty years since its enactment, these objectives have remained virtually unchanged.

B. Basis of the Lanham Act

Lawmakers initially experienced difficulty in passing the Lanham Act as it treated trademarks like copyrights⁴⁰ and patents.⁴¹ Similar treatment seemed logical to lawmakers as copyrights, patents, and trademarks form the three major intellectual property rights.⁴² Like the Patent Act⁴³ and the Copyright Act,⁴⁴ early trademark law found its constitutional roots in the Patents and Copyrights clause.⁴⁵ However, the *Trade-mark Cases* in 1879 invalidated this constitutional basis for the 1870 Trademark Act.⁴⁶ The Supreme Court held that because trademarks did not relate to an invention or a creative work, the Patents and Copyrights clause of the Constitution did not apply.⁴⁷ Instead, the Court held that trademarks

³⁹ 15 U.S.C. § 1127.

⁴⁰ Copyrights protect “literary, artistic, and scientific works.” Patrick H. Hu, “*Mickey Mouse*” in *China: Legal and Cultural Implications in Protecting U.S. Copyrights*, 14 B.U. INT’L L.J. 81, 81 n.29 (1996).

⁴¹ Patent law protects “functional” inventions. Dennis S. Karjala, *Copyright Protection of Computer Documents, Reverse Engineering, and Professor Miller*, 19 DAYTON L. REV. 975, 976–77 (1994). “A work is ‘functional’ if it performs some utilitarian task other than to inform, entertain, or portray an appearance to human beings.” *Id.* at 977. Some examples of functional inventions include the laser, nicotine patches, and software encryption. Peacock Myers, P.C., Patents, http://www.peacocklaw.com/Spec_Patents.html (last visited Jan. 8, 2009).

⁴² Elizabeth Ferrill, *Clearing the Swamp for Intellectual Property Harmonization: Understanding and Appreciating the Barriers to Full TRIPS Compliance for Industrializing and Non-industrialized Countries*, 15 U. BALT. INTELL. PROP. L.J. 137, 147 (2007). Trade secret is the other area of intellectual property law. *Id.*

⁴³ The U.S. Patent Act, 35 U.S.C. §§ 1–376 (2006).

⁴⁴ 17 U.S.C. §§ 1301–1332 (2006).

⁴⁵ Congress has the power “[t]o promote the progress of science and useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries.” U.S. CONST. art. I, § 8, cl. 8.

⁴⁶ See *Trade-Mark Cases*, 100 U.S. 82, 93 (1879) (invalidating the 1870 and 1876 Trademark Acts, because they were enacted beyond congressional power).

⁴⁷ *Id.* at 94.

identify a particular class or quality of goods as the manufacture, produce, or property of the person who puts them in the general market for sale; that the sale of the article so distinguished is commerce; that the trademark is, therefore, a useful and valuable aid or instrument of commerce, and its regulation by virtue of the clause belongs to Congress, and that the act in question is a lawful exercise of this power.⁴⁸

The Supreme Court, in dicta, commented that the Commerce Clause⁴⁹ would not authorize the 1870 and 1876 Trademark Acts.⁵⁰ Later, in 1946, however, Congress limited the Lanham Act to “in the use of commerce” and thus secured a constitutional basis for regulating marks in the Commerce Clause.⁵¹ Without the “in the use of commerce” prong or some other constitutional tie-in, Congress would exceed its power by creating the Lanham Act.⁵²

This part introduced the goals of traditional trademark law—preserving a company’s investment in goodwill and protecting consumers from counterfeit products.⁵³ Congress considered both and attempted to protect those interests by creating the Trademark Acts. This proved to be a daunting task of trial and error. However, by the middle of the twentieth century, Congress succeeded in codifying trademark law in the Lanham Act.

III. Trademarks in the Commercial World

This part explores the challenges presented by the interpretation of the Lanham Act and the practical aspects of its provisions on companies.

⁴⁸ *Id.* at 95.

⁴⁹ Congress has the power “[t]o regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes.” U.S. CONST. art. I, § 8, cl. 3.

⁵⁰ See *Trade-Mark*, 100 U.S. at 97–98 (finding no language in the Acts to restrict trademark to use in commerce).

⁵¹ Mathias Strasser, *The Rational Basis of Trademark Protection Revisited: Putting the Dilution Doctrine into Context*, 10 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 375, 427 (2000). Congress has the power “[t]o regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes.” U.S. CONST. art. I, § 8, cl. 3.

⁵² *Trade-Mark*, 100 U.S. at 96–97.

⁵³ *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1360 (C.C.P.A. 1973) (quoting S. REP. NO. 1333, 79th Cong., 2d Sess. (1946), in U.S.C.C.A.N., 79th Cong., 2d Sess. at 1274-8 (1946)).

It begins with a discussion about the subject matter requirements of trademark protections; how companies establish rights in their marks; and how they register their marks with the U.S. Patent and Trademark Office (USPTO).⁵⁴ It also outlines the many protections, remedies, and defenses under the Lanham Act.

A. Subject Matter of Trademarks

Almost anything that can distinctly connect a mark to the origin of its source is eligible for trademark protection.⁵⁵ Most people are familiar with the common categories of trademarks such as phrases⁵⁶ and symbols.⁵⁷ However, trademark law protects numerous other categories. For example, in 1995, the Supreme Court found that trademark law protects the color green when related to dry cleaning pads.⁵⁸ In *Qualitex*, a company that made green dry cleaning pads, sued Jacobson, a rival company, for selling dry cleaning pads with the same green color Qualitex already registered with the USPTO.⁵⁹ Going beyond the color issue, the Court also cited other unusual examples capable of trademark protection such as: “a particular shape (of a Coca-Cola bottle), a particular sound (of NBC’s three chimes), and even a particular scent (of plumeria blossoms on sewing thread).”⁶⁰ The Supreme Court even extended trademark protection in the design and motif of a restaurant.⁶¹

⁵⁴ The USPTO “process[es] patent and trademark applications and disseminat[es] patent and trademark information.” United States Patent and Trademark Office, Introduction, <http://www.uspto.gov/web/menu/intro.html> (last visited Mar. 2, 2009).

⁵⁵ Richard Chappo, *You Can Trademark a Lot More Than You Think*, EZINE, Feb. 13, 2007, available at <http://ezinearticles.com/?You-Can-Trademark-a-Lot-More-Than-YouThink&id=453370>.

⁵⁶ For example, M&M’s trademarked phrase is “melts in your mouth, not in your hands.” M&M’s, M&M’s About M&Ms: History, <http://www.m-ms.com/us/about/mmshistory/> (last visited Jan. 8, 2009). Taco Bell urges you to “think outside the bun.” Taco Bell Home Page, <http://www.tacobell.com/> (last visited Jan. 8, 2009). Burger King assures you that you can “have it your way.” Burger King Home Page, <http://www.burgerking.com/bkglobal/> (last visited Jan. 8, 2009).

⁵⁷ Nike’s well-recognized symbol is the swoosh. Nike, NikeStore: Customer Service: Privacy/Security, <http://www.nike.com/renov/nikestore/us/v1/us/en/info/privacy.jsp?item=terms&sitesrc=USLP> (last visited Jan. 8, 2009). Adidas distinguishes its shoes with the 3-stripes device on the sides of its shoes. Adidas, Adidas—Legal, <http://www.adidas.com/us/shared/legal.asp> (last visited Jan. 8, 2009).

⁵⁸ *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 166 (1995).

⁵⁹ *Id.* at 161.

⁶⁰ *Id.* at 162.

⁶¹ See *Two Pesos v. Taco Cabana*, 505 U.S. 763, 776 (1992) (holding inherently distinctive trade dress does not require secondary meaning for trademark protection).

B. Distinctiveness⁶²

In addition to proper subject matter, trademark law also requires a potential mark achieve distinctiveness.⁶³ The more distinctive a mark, the more protection trademark law provides.⁶⁴ Courts often group marks into three broad categories with varying levels of protection, depending on their strength: 1) inherently distinctive marks (fanciful, arbitrary, and suggestive marks) receive automatic protection; 2) potentially distinctive marks (descriptive marks) frequently receive protection; and 3) non-distinctive marks (generic marks) never receive protection.⁶⁵ Each of these marks and their level of protection are discussed separately below. These categorical distinctions place a value on original and creative ideas that easily distinguish products or services.

1. *Inherently Distinctive Marks*

Within the inherently distinctive category, there are three types of marks, each receiving a different level of protection under trademark law. The first group of inherently distinctive marks consists of marks that are fanciful.⁶⁶ These marks enjoy absolute protection, because they are totally invented words that have no meaning on their own.⁶⁷ A great example of a fanciful mark in the U.S. Army is the term “Hooah!,” discussed later in this article.⁶⁸ Trademark law provides marks that are arbitrary with the second highest degree of protection.⁶⁹ Arbitrary marks

Many other companies also have buildings that serve as marks such as Pizza Hut and its distinctive red roof. Pizza Hut, PizzaHut.com—Terms of Use, <http://www.pizzahut.com/TermsOfUse.aspx> (last visited Jan. 8, 2009).

⁶² Distinctiveness is the characteristic of a symbol that distinguishes the source of a product from another source. Lanham Act, 15 U.S.C. § 1052 (2006). A discussion of this is necessary to demonstrate how much time and expense a special statue will save.

⁶³ 1-2 JEROME GILSON, GILSON ON TRADEMARKS 2.01 (2008).

⁶⁴ See generally *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976) (providing a thorough explanation of distinctiveness).

⁶⁵ *Id.* at 9.

⁶⁶ *Id.*

⁶⁷ *Id.* at 11 n.12. Examples include the names “Kodak” and “Exxon.” Kodak, History of Kodak, <http://www.kodak.com/global/en/corp/historyOfKodak/historyIntro.jhtml?pq-path=2687> (last visited Mar. 2, 2009) (displaying the development of the Kodak logo); posting of Kevlou to Everything 2, <http://www.everything2.net/title/Exxon> (Aug. 30, 2002, 0:27:03 EST) (explaining how Exxon developed its name).

⁶⁸ See *infra* notes 224–30 and accompanying text (explaining the problems the U.S. Army has with its fanciful mark).

⁶⁹ *Abercrombie*, 537 F.2d at 9.

are actual words, but they are words used in an unusual way that do not describe the product.⁷⁰ The last group of inherently distinctive marks, suggestive marks, requires imagination to connect the mark with the source.⁷¹

2. Potentially Distinctive Marks

Descriptive marks are similar to suggestive marks, but there is no leap required to associate the mark with the source; these marks tell something about the actual product.⁷² Descriptive marks enjoy trademark protection as distinctive marks unless they are merely descriptive.⁷³

A mark is merely descriptive if it immediately conveys to one seeing or hearing it knowledge of the ingredients, qualities, or characteristics of the goods or services with which it is used; whereas, a mark is suggestive if imagination, thought, or perception is required to reach a conclusion on the nature of the goods or services.⁷⁴

Trademark law, however, protects merely descriptive marks that acquire secondary meaning.⁷⁵ “Secondary meaning will be acquired when most

⁷⁰ *Id.* at 11 n.12. Examples include Sun for microcomputers and Apple for home computers.

⁷¹ *Id.* at 11 (citing *Stix Prods., Inc. v. United Merchs. & Mfrs. Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968)). An example of a suggestive mark is Amazon.com. Amazon.com does not sell items associated with the Amazon River instead, the name suggests that the selection on Amazon.com is as large as the river. The logo reinforces this idea as an arrow under the Amazon.com logo points from the “A” to the “Z” meaning the website has everything from “A” to “Z.” Amazon.com Home Page, <http://www.amazon.com/> (last visited May 18, 2009).

⁷² *Id.* at 10. For example, “Holiday Inn” describes a hotel; “All Bran” describes a cereal; and “Vision Center” describes an eyeglass shop. Harvard Law Sch., Overview of Trademark Law, <http://cyber.law.harvard.edu/metaschool/fisher/domain/tm.htm> (last visited Jan. 8, 2009). Trademark law protects these descriptive marks.

⁷³ Lanham Act, 15 U.S.C. § 1052 (2006). Merely descriptive examples include “Fast Baud” for modems, “104 Key” for keyboards and “Light” for laptops. Daniel A. Tysver, *Strength of Trademarks*, Bit Law, <http://www.bitlaw.com/trademark/degrees.html> (last visited Jan. 8, 2009).

⁷⁴ *In re Application of Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 525 (C.C.P.A. 1980) (quoting *In re Abcor Dev. Corp.*, 588 F.2d 811, 813–14 (C.C.P.A. 1978)).

⁷⁵ *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976). Examples of descriptive marks that have attained secondary meaning include “Kool” for

consumers think of a word not as descriptive but as the name of the product. Advertising, sales, and use will tend to establish secondary meaning.”⁷⁶ The test to gain protection is whether consumers mentally link the mark with the source of the product.⁷⁷

West Point provides a perfect example of the transformation from a descriptive mark that has attained secondary meaning.⁷⁸ The military referred to the west bank of the Hudson River as West Point during the Revolutionary War.⁷⁹ Consequently, West Point referred to its geographical location and was thus descriptive. However, over the past 200 years, West Point has come to identify the source of the product rather than the location.⁸⁰

3. *Non-distinctive Marks*

A mark is generic and thus non-distinctive “if the primary significance of the trademark is to describe the type of product rather than the producer”⁸¹ Trademark law does not protect generic marks.⁸² An example of a generic term is shredded wheat, where the term describes the product and not the source.⁸³

A mark that once enjoyed trademark protection as an inherently distinctive mark or as a potentially distinctive mark can eventually become generic.⁸⁴ This genericide⁸⁵ occurs when consumers relate a

menthol cigarettes and “Chap Stick” for lip balm. Free Advice, Secondary Meaning—What is it?, http://law.freeadvice.com/intellectual_property/trademark_law/secondary_meanings.htm (last visited May 18, 2009).

⁷⁶ *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 795 (5th Cir. 1983).

⁷⁷ *Id.* at 794 (citing *Coca-Cola Co. v. Koke Co. of Am.*, 254 U.S. 143, 145 (1920)). Courts use survey evidence to prove whether the link exists. *Id.* at 795 (citing *Vision Ctr. v. Opticks, Inc.*, 596 F.2d 111, 119 (5th Cir. 1979)).

⁷⁸ U.S. Trademark No. 2320987 (filed Nov. 25, 1998).

⁷⁹ United States Military Acad., USMA Bicentennial, <http://www.usma.edu/bicentennial/history/> (last visited Jan. 22, 2010).

⁸⁰ See U.S. Trademark No. 2320987 (filed 25 Nov. 25 1998) (identifying the eight categories the West Point trademark is registered).

⁸¹ *Filipino Yellow Pages, Inc. v. Asian Journal Publ'ns., Inc.*, 198 F.3d 1143, 1147 (9th Cir. 1999) (quoting *Anti-Monopoly, Inc. v. Gen. Mills Fun Group*, 611 F.2d 296, 304 (9th Cir. 1979) (emphasis added)).

⁸² *Id.*

⁸³ *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 116 (1938).

⁸⁴ *King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577, 579 (2d Cir. 1963).

mark to the product rather than to the source of the product.⁸⁶ Companies must balance the risk of their mark becoming so well-known that it no longer serves as a source identifier with the desire to enhance the marketability of the product through consumer knowledge of the mark.⁸⁷ This also occurs in the U.S. Army. Later, this article will explain and discuss how the M4 mark became generic for carbine rifles.⁸⁸

C. Functionality

After determining that a mark is the proper subject matter of trademark law and that it is distinctive, companies have to ensure that it is not functional.⁸⁹ Functional marks are not subject to trademark protection.⁹⁰ A “functional feature” is something critical to the usability of a product; it is a design feature necessary for the item to work.⁹¹ The U.S. Army’s digital pattern on the Army Combat Uniform (ACU) is an example of a functional feature.⁹² When used on the ACU, the digital pattern serves as camouflage for a Soldier and is thus functional.

⁸⁵ Genericide is “the deterioration of a trademark into a generic name.” 1-2 GILSON, *supra* note 63, at 2.02. Examples include “[y]o-yo, thermos, aspirin, cellophane, [and] escalator.” *Id.*

⁸⁶ *King-Seeley*, 321 F.2d at 578.

⁸⁷ Current examples of this include Federal Express and Google. Federal Express does not want “FedEx it” to generically mean ship something fast, but they still want people to think of their company when they want to ship something, enhancing their business. Similarly, Google does not want “Google it” to mean generally do an Internet search. Both companies want their marks to represent the sources of their services.

⁸⁸ *See infra* Part V.C and accompanying text (explaining the evolution from M4 as a registered trademark to its genericide demise).

⁸⁹ There are two types of functionality. De jure functionality occurs when a mark is essential to the operation of the product and you cannot make it another way “without either lessening the efficiency or materially increasing expense.” *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1339 (C.C.P.A. 1982) (quoting *Luminous Unit Co. v. R. Williamson & Co.*, 241 F. 265, 269 (D. Ill. 1917)) (holding that the shape of a spray bottle is not functional). Aesthetic functionality, on the other hand, occurs when a feature “would significantly hinder competitors by limiting the range of adequate alternative designs.” *See Wallace Int’l Silversmiths, Inc. v. Godinger Silver Art Co.*, 916 F.2d 76, 82 (2d Cir. 1990) (holding that ornate Baroque patterning on silverware is aesthetically functional).

⁹⁰ *Morton*, 671 F.2d at 1343. *See supra* note 41 (explaining patent law protecting “functional” inventions).

⁹¹ *See Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32 (2001) (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995)).

⁹² Chafin e-mail on 8 Jan. 2009, *supra* note 13.

However, when the Army Cadets used the digital pattern on their helmets at the 2008 Army/Navy football game, it was decorative and capable of trademark protection to connect the mark with the U.S. Army.⁹³

D. Establishment of Rights: Use it or Lose it

A company must use the distinctive, non-functional mark in commerce to acquire trademark rights.⁹⁴ For example, the U.S. Army spent millions of dollars developing its current motto: “Army Strong.”⁹⁵ Additionally, use in commerce determines priority if two similar marks conflict.⁹⁶

Actual use⁹⁷ establishes trademark rights and provides a priority date⁹⁸ under the Lanham Act.⁹⁹ Actual use provides a fixed date that

⁹³ In fact, the digital pattern provided little *function* for Army in its loss to Navy with a score of 38 to 0. U.S. Naval Academy, Army-Navy Scores, <http://www.usna.edu/Lib/Exhibits/Archives/Armynavy/Scores.htm> (last visited Feb. 22, 2009).

⁹⁴ Lanham Act, 15 U.S.C. § 1127 (2006).

⁹⁵ Telephone Interview with J. Scott Chafin, Trademark and Copyright Att’y, in Arlington, Va. (Jan. 30, 2010) [hereinafter Chafin Interview]. Prior to “Army Strong,” the U.S. Army’s motto was “Army of One.” U.S. Trademark No. 2536272 (filed Feb. 6, 2001). This mark was later canceled. U.S. Trademark No. 2536272 (canceled Nov. 8, 2008).

⁹⁶ *Navistar Int’l Transp. Corp. v. Freightliner Corp.*, 1998 U.S. Dist. LEXIS 20284 (D. Ill. 1998) (citing *Zazu Designs v. L’Oreal, S.A.*, 979 F.2d 499, 503 (7th Cir. 1992)).

⁹⁷ Congress added the “use in commerce” language in the Lanham Act to fix the problems with the 1870 and 1876 Trademark Acts.

The term “use in commerce” means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this Act, a mark shall be deemed to be in use in commerce—

(1) on goods when—

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and

(B) the goods are sold or transported in commerce, and

(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

serves to provide the world with notice of who used a mark first when two companies dispute whose mark came first.¹⁰⁰ The test for actual use is to balance the totality of the circumstances to determine if a mark has crossed the threshold.¹⁰¹ For example, pre-sale activities using a mark can amount to actual use when the public has an opportunity to associate the mark with the source.¹⁰² When a mark crosses the threshold of actual use, it is finally worthy of trademark protection.

E. Registration

After a mark qualifies for trademark protection, the next step is to register the mark with the USPTO. Continuing with the “Army Strong” example, Mr. J. Scott Chafin filed for registration of this mark on 12 October 2006, and the USPTO ultimately registered the mark on 1 July 2008.¹⁰³ Registration offers many benefits to the trademark owner.

1. Searches

Prior to registering or developing a new mark, a company should search prior trademark registrations to determine whether any potential conflicts exist.¹⁰⁴ The Trademark Electronic Search System provides free access to registered, pending, and abandoned applications.¹⁰⁵ After conducting a search, a company should check the Trademark Applications and Registrations Retrieval database to determine if the

Lanham Act, 15 U.S.C. § 1127.

⁹⁸ The Lanham Act, section 44 allows registration of marks in the United States without actual use in the United States, as long as the mark is registered in a foreign country and a company has a bona fide intent to use the mark in the United States. *Id.* § 1126. This foreign registration date also gives the company a priority date in conflict situations. *Id.*

⁹⁹ *Id.* § 1127.

¹⁰⁰ *Id.* § 1126.

¹⁰¹ *See Chance v. Pac-Tel Teletrac Inc.*, 242 F.3d 1151, *passim* (9th Cir. 2001) (holding that a public relations campaign using the mark, sending brochures with the mark in them, engaging in interviews discussing the mark, and marketing the product to potential large purchasers through slide presentations were enough pre-sale activities to establish actual use).

¹⁰² *Id.* at 1159.

¹⁰³ U.S. Trademark No. 3458664 (filed Oct. 12, 2006).

¹⁰⁴ 37 C.F.R. § 2.83 (2009).

¹⁰⁵ U.S. PATENT AND TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE 104 (5th ed. 2007) [hereinafter TMEP].

mark is still an active mark.¹⁰⁶ For example, if a company wanted to name a new soda product with the term “cola” in it, the company should conduct a search to identify other existing similar marks and active registrations.¹⁰⁷ A search for “Army Strong” revealed no conflicts.¹⁰⁸ A thorough search may prevent costly litigation expenses in an infringement suit and save money in developing a mark similar to an existing mark.¹⁰⁹

2. Registration and Application

Once a company has identified a mark ready for registration, the next step is to select a single or combined application.¹¹⁰ If a company applies for registration of its mark in only one class, the application is a single-class application.¹¹¹ However, if the company applies for more than one class, the application is a combined or multiple-class application.¹¹² The Trademark Manual of Examining Procedure includes over forty-five classes of marks.¹¹³ Mr. Chafin registered “Army Strong” in five classes.¹¹⁴ Nike also registers its marks in multiple classes, to include its swoosh mark in class 25, clothes, and class 28, sporting goods, among other classes.¹¹⁵

¹⁰⁶ *Id.* at 102.

¹⁰⁷ U.S. Patent and Trademark Office, Trademark Electronic Search System (TESS), <http://tess2.uspto.gov/bin/gate.exe?f=searchss&state=91ukce.1.1> (search for “cola”) (last visited Jan. 14, 2009). A search of “cola” produced 878 records containing names such as Crazy Cola and Kiddie Health Cola. *Id.*

¹⁰⁸ The author inquired with Mr. Chafin whether any conflict issues existed in creating “Army Strong” vis-à-vis “Livestrong,” Lance Armstrong’s mark. First, Lance Armstrong’s company color is yellow (also one of the colors of the U.S. Army logo), as evidenced by its ubiquitous yellow wristbands. Wristbands, <http://www.store-laf.org/wristbands.html> (last visited Jan. 31, 2010). Second, both marks were developed around the same time frame. U.S. Trademark No. 3360223 (filed Sept. 20, 2006). Finally, if you merge Army with Strong and delete the “y,” you are left with ArmStrong. In Mr. Chafin’s view, these factors did not amount to a conflict.

¹⁰⁹ 1-3 GILSON, *supra* note 63, at 3.01(2).

¹¹⁰ TMEP, *supra* note 105, at 801.01(a).

¹¹¹ *Id.* at 801.01(a).

¹¹² *Id.* at 801.01(b).

¹¹³ *Id.* at 1401.02(a).

¹¹⁴ Chafin Interview, *supra* note 95.

¹¹⁵ Nike, Nike Help, http://nike-eu.custhelp.com/cgi-bin/nike_ed.cfg/php/enduser/std_adp.php?p_faqid=6 (last visited Jan. 19, 2009).

The USPTO's website offers an easy-to-use, web-based application to register a mark.¹¹⁶ The Trademark Electronic Application System allows users to file an application for as little as \$275.¹¹⁷

3. Examination

Once an applicant files for registration, an examining attorney with the USPTO examines the application to determine whether it meets the criteria for federal registration.¹¹⁸ The examining attorney searches registered, pending, and abandoned marks that may conflict with the applicant's mark.¹¹⁹ If the application conflicts with an existing mark or has other problems, the examiner issues a letter to the applicant explaining the deficiency.¹²⁰ Otherwise, the examining attorney will continue the examination and evaluate the application on its merits.¹²¹ After all objections are resolved, the USPTO will publish the mark in the Official Gazette.¹²² If the application is based on actual use, the USPTO will issue a notice of allowance, registering the mark.¹²³ Once a mark is registered through the USPTO, the mark owner can use the ® symbol with the mark, providing notice to others that the mark is officially registered.¹²⁴

¹¹⁶ TMEP, *supra* note 105, at 301.

¹¹⁷ 37 C.F.R. § 2.207 (2009).

¹¹⁸ *Id.* § 2.61(a).

¹¹⁹ TMEP, *supra* note 105, at 104. "A complete examination includes a search for conflicting marks and an examination of the written application, the drawing and any specimen(s), to determine whether the mark is eligible for the type of registration requested, whether amendment is necessary, and whether all required fees have been paid." 37 C.F.R. § 2.61 (a) (2008).

¹²⁰ TMEP, *supra* note 105, at 705. An example of a problem would be not having enough information to conduct the search properly.

¹²¹ *Id.*

¹²² 37 C.F.R. § 2.80. *The Official Gazette* is the USPTO's weekly publication. U.S. Patent and Trademark Office, What Happens After I File My Application?, <http://www.uspto.gov/web/offices/tac/doc/basic/afterapp.htm#legal> (last visited 14 Jan. 2009).

¹²³ Lanham Act, 15 U.S.C. § 1063(b)(2) (2006). "The notice of allowance will list the serial number of the application, the name of the applicant, the correspondence address, the mark, the identification of goods/services, and the date of issuance of the notice of allowance." 37 C.F.R. § 2.81(b).

¹²⁴ TMEP, *supra* note 105, at 906.

The registration symbol should be used only on or in connection with the goods or services that are listed in the registration.

This lengthy process involves a great deal of communication between the lawyers seeking registration and the USPTO. However, once the USPTO grants registration, the owner of the trademark benefit greatly under the Lanham Act.

4. *Advantages of Registration*

A registered mark will become part of the principal register, providing many advantages.¹²⁵ “[R]egistered trademarks are presumed to be distinctive and [are] afforded the utmost protection.”¹²⁶ Registration also allows the mark owner to exclusively use the registered mark in commerce.¹²⁷ Use of the ® symbol after a mark provides notice to the rest of the world that the mark belongs to the owner and that the owner has exclusive use rights.¹²⁸ Registration also provides the owner a date of constructive use¹²⁹ and the right to sue an infringer in federal court.¹³⁰ Lastly, unlike copyrights¹³¹ and patents, which can only last for limited times,¹³² trademark protection can last forever.¹³³

The federal registration symbol may not be used with marks that are not actually registered in the United States Patent and Trademark Office. Even if an application is pending, the registration symbol may not be used until the mark is registered.

Id. However, “[a] party may use terms such as ‘trademark,’ ‘trademark applied for,’ ‘TM’ and ‘SM’ regardless of whether a mark is registered. These are not official or statutory symbols of federal registration.” *Id.*

¹²⁵ *Id.* at 801.02(a).

¹²⁶ *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 871 (2d Cir. 1986) (citing *Vibrant Sales, Inc. v. New Body Boutique, Inc.*, 652 F.2d 299, 304 (2d Cir. 1981)).

¹²⁷ Lanham Act, 15 U.S.C. § 1057(b) (2006).

¹²⁸ *Id.* § 1072.

¹²⁹ *Id.* § 1057(b), (c). The date of constructive use becomes important in determining priority when two marks dispute, which came first. *Id.*

¹³⁰ *Id.* § 1121. See *infra* notes 142 and 149 and accompanying text (explaining injunctions and damages).

¹³¹ “Copyright in a work created on or after January 1, 1978, subsists from its creation and, except as provided by the following subsections, endures for a term consisting of the life of the author and 70 years after the author’s death.” 17 U.S.C. § 302 (2006).

¹³² “Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States” The U.S. Patent Act, 35 U.S.C. § 154 (2006).

¹³³ Congress has the power “[t]o promote the progress of science and useful arts, by securing for *limited times*, to authors and inventors, the exclusive right to their respective

F. Protections of Trademark Law

In addition to the advantages mentioned in the previous section, the Lanham Act also provides broad protection against infringing uses. The Lanham Act guards against the likelihood of confusion between similar marks and dilution from one mark to another. These two protections are explained below.

1. Likelihood of Confusion

The Lanham Act protects against the likelihood of confusion.¹³⁴ Likelihood of confusion occurs when consumers confuse the origin of a mark.¹³⁵ The confusion allows the infringer to capitalize on the situation and ultimately steal business and goodwill.¹³⁶ Likelihood of confusion with another mark is the test for trademark infringement.¹³⁷ In 1973, the Court of Appeals for the Federal Circuit, in the *DuPont* case, established factors to consider in determining the likelihood of confusion.¹³⁸ The appellant, DuPont, appealed the Trademark Trial and Appeal Board's¹³⁹ refusal to register the mark for its cleaning product, Rally, "a

writings and discoveries." U.S. CONST. art. I, § 8, cl. 8. Although trademark protection can last forever, the Lanham Act provides as follows:

(a) Each registration shall remain in force for 10 years, except that the registration of any mark shall be canceled by the Director for failure to comply with the provisions of subsection (b) of this section, upon the expiration of the following time periods, as applicable:

(1) For registrations issued pursuant to the provisions of this Act, at the end of 6 years following the date of registration.

(2) For registrations published under the provisions of section 12(c) [15 USCS § 1062(c)], at the end of 6 years following the date of publication under such section.

(3) For all registrations, at the end of each successive 10-year period following the date of registration.

15 U.S.C. § 1058 (2006). Coke and Nike are long-standing trademarks.

¹³⁴ *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 871 (2d Cir. 1986).

¹³⁵ 15 U.S.C. § 1125(a)(1).

¹³⁶ *Id.* (preventing a "false designation of origin").

¹³⁷ *Tisch Hotels, Inc. v. Americana Inn, Inc.*, 350 F.2d 609, 611 (7th Cir. 1965).

¹³⁸ *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973).

¹³⁹ Companies appeal final denial decisions of examiners to the Trademark Trial and Appeal Board. 15 U.S.C. § 1070. State and federal courts handle infringement disputes. 2-7 GILSON, *supra* note 63, at 704 (federal trademark law does not pre-empt state trademark law).

combination polishing, glazing and cleaning agent for use on automobiles” because of the “likelihood of confusion under section 2(d) of the Lanham Act.”¹⁴⁰ To decide the case, the Court utilized the factors, now known as the “*Du Pont* factors,” in determining if a likelihood of confusion exists with another mark.¹⁴¹ Courts have also used various combinations of the thirteen factors in their decisions.¹⁴²

¹⁴⁰ *Du Pont*, 476 F.2d at 1359.

¹⁴¹ The thirteen *Du Pont* factors are:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels.
- (4) The conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing.
- (5) The fame of the prior mark (sales, advertising, length of use).
- (6) The number and nature of similar marks in use on similar goods.
- (7) The nature and extent of any actual confusion.
- (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
- (9) The variety of goods on which a mark is or is not used (house mark, “family” mark, product mark).
- (10) The market interface between applicant and the owner of a prior mark:
 - (a) a mere “consent” to register or use.
 - (b) agreement provisions designed to preclude confusion, i.e. limitations on continued use of the marks by each party.
 - (c) assignment of mark, application, registration and good will of the related business.
 - (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.
- (11) The extent to which applicant has a right to exclude others from use of its mark on its goods.
- (12) The extent of potential confusion, i.e., whether de minimis or substantial.
- (13) Any other established fact probative of the effect of use.

Id. at 1361.

¹⁴² *In re Dixie Rests.*, 105 F.3d 1405, 1406–07 (Fed. Cir. 1997) (quoting *Opryland USA Inc. v. Great Am. Music Show*, 970 F.2d 847, 850 (Fed. Cir. 1992)). See *infra* Appendix A (listing of the various tests other jurisdictions use to determine likelihood of confusion).

2. Dilution

Dilution is a second cause of action, often unrelated to infringement by likelihood of confusion.¹⁴³ Unlike trademark infringement, dilution does not require confusion or economic injury, rather the two forms of dilution require the mark to have once been famous.¹⁴⁴ Generally, dilution occurs when a third-party uses a mark in such a way that it weakens the connection between that mark and the mark's owner.¹⁴⁵ Specifically, dilution occurs by blurring or tarnishment, but both have the same weakening effect on a mark.¹⁴⁶

Dilution has a significant role vis-à-vis U.S. Army trademarks in that the Army could lose the rights to its marks through the doctrine of dilution. This article will discuss later how this doctrine applies to U.S. Army marks.¹⁴⁷ Dilution by blurring impairs or reduces the distinctiveness of a famous mark.¹⁴⁸ For example, in *McNeil Consumer Brands v. United States Dentek Corp.*, the maker of Tylenol sued the maker of Tempanol.¹⁴⁹ The *McNeil* court found that Tylenol was a

¹⁴³ *Autozone, Inc. v. Strick*, 466 F. Supp. 2d 1034, 1045 (N.D. Ill. 2006). The Trademark Dilution Revision Act of 2006 adds a likelihood of dilution cause of action to actual dilution. *Id.* at 1044–45.

¹⁴⁴ Lanham Act, 15 U.S.C. § 1125(c)(1) (2006). Famous, under this section, means that the mark has inherent distinctiveness. *N.Y. Stock Exch., Inc. v. N.Y., N.Y. Hotel, LLC*, 293 F.3d 550, 556 (2d Cir. 2002).

¹⁴⁵ *Mattel, Inc. v. MCA Records*, 296 F.3d 894, 903 (9th Cir. 2002) (quoting *Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 50 (1st Cir. 1998)).

¹⁴⁶ *Deborah Heart & Lung Ctr. v. Children of the World Found., Ltd.*, 99 F. Supp. 2d 481, 492 (D. N.J. 2000).

¹⁴⁷ See *infra* Part V.D.2 and accompanying text.

¹⁴⁸ 15 U.S.C. § 1125(c)(2)(B). In determining dilution by blurring, courts consider the following factors:

- (i) The degree of similarity between the mark or trade name and the famous mark.
- (ii) The degree of inherent or acquired distinctiveness of the famous mark.
- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
- (iv) The degree of recognition of the famous mark.
- (v) Whether the user of the mark or trade name intended to create an association with the famous mark.
- (vi) Any actual association between the mark or trade name and the famous mark.

Id.

¹⁴⁹ *McNeil Consumer Brands v. United States Dentek Corp.*, 116 F. Supp. 2d 604, 605

famous mark known across the United States for decades.¹⁵⁰ The court analyzed all the dilution factors, but focused mainly on the degree of similarity between the two marks, finding that both Tylenol and Tempanol sounded alike, started with the letter “T,” had three syllables, and ended in “-ol.”¹⁵¹ Additionally, both products were over-the-counter pain relievers, Tempanol for dental pain and Tylenol for general pain.¹⁵² The court held that the use of the Tempanol name blurred the Tylenol mark by making it “vague and less distinctive.”¹⁵³ Other examples of dilution by blurring include the use of “DuPont [for] shoes, Buick [for] aspirin, Kodak [for] pianos, and Bulova [for] dresses.”¹⁵⁴

By contrast, dilution by tarnishment is when a third party uses a mark, similar to a famous mark, that results in harm to “the reputation of the famous mark.”¹⁵⁵ In *Grey v. Campbell Soup Co.*,¹⁵⁶ Cynthia Grey sold dog biscuits under the name “Dogiva.” Upon learning of this, Campbell Soup, owner of Godiva chocolates, sued Grey based on dilution of the name Godiva.¹⁵⁷ The Ninth Circuit found Godiva to be inherently distinctive and worthy of dilution protection.¹⁵⁸ The Ninth Circuit also found that the use of Dogiva would “whittl[e] away the distinctiveness” of Godiva and held that the use of Dogiva would likely dilute Godiva’s mark as being inherently distinctive.¹⁵⁹

Thus far, the two forms of infringement and examples of each have been identified—likelihood of confusion and dilution. Once an infringer violates the Lanham Act, the owner has several options to address the infringer.

(E.D. Pa. 2000).

¹⁵⁰ *Id.* at 606–07.

¹⁵¹ *Id.* at 607–08.

¹⁵² *Id.* at 608.

¹⁵³ *Id.* at 609. *But see* *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 268–69 (4th Cir. 2007) (holding that Chewy Vuiton, a line of dog toys, was a parody of and did not dilute Louis Vuitton, a line of expensive handbags).

¹⁵⁴ *Trademark Law Advisory: Ending the Confusion about Dilution*, Husch Blackwell Sanders LLP, Jan. 1, 2007, <http://www.welshkatz.com/?t=11&1a=42&format=xml&p=822>.

¹⁵⁵ Lanham Act, 15 U.S.C. § 1125(c)(2)(C) (2006).

¹⁵⁶ 650 F. Supp. 1166, 1168 (C.D. Cal. 1986).

¹⁵⁷ *Id.*

¹⁵⁸ *Id.* at 1175.

¹⁵⁹ *Id.*

G. Remedies for Infringement

Inevitably, companies often find themselves victims of infringement by likelihood of confusion or dilution. In such situations, the Lanham Act provides two major remedies. The first major remedy utilized is an injunction to immediately cease the infringing use. In the second major remedy, a company sues for monetary recovery from loss of goodwill.

1. Injunction

The Lanham Act allows courts to grant injunctions to protect marks registered with the USPTO against any violation of the Act.¹⁶⁰ The Fifth Circuit Court of Appeals, in *Vision Ctr. v. Opticks, Inc.*, outlined the criteria, used by the majority of courts today, to determine whether an injunction is necessary in a trademark dispute.¹⁶¹ The criteria include:

- (1) a substantial likelihood that the movant will ultimately prevail on the merits;
- (2) a showing that the movant will suffer irreparable injury unless the injunction issues;
- (3) proof that the threatened injury to the movant outweighs whatever damage the proposed injunction may cause the opposing party;
- and (4) a showing that the injunction, if issued, would not be adverse to the public interest.¹⁶²

The criteria do not require actual injury, only a likelihood of injury.¹⁶³ Even if an infringer has ceased infringing, an injunction is appropriate when the future acts of the infringer are uncertain.¹⁶⁴ However, threat of infringement alone is enough to satisfy injunction requirements.¹⁶⁵ If a court finds actual trademark infringement under the criteria, the intent of

¹⁶⁰ 15 U.S.C. § 1116(a). *See id.* § 1125 (outlining the various civil actions).

¹⁶¹ *Vision Ctr. v. Opticks, Inc.*, 596 F.2d 111, 114 (5th Cir. 1979) (quoting *State of Texas v. Seatrain Int'l, S.A.*, 518 F.2d 175, 179 (5th Cir. 1975)).

¹⁶² *Id.* A minority of circuits have similar criteria in issuing an injunction. *See I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 33 (1st Cir. 1998) (citing *TEC Eng'g Corp. v. Budget Molders Supply*, 82 F.3d 542, 544 (1st Cir. 1996)) (outlining the four elements for the First Circuit); *see also TCPIP Holding Co. v. Haar Communs.*, 244 F.3d 88, 92 (2d Cir. 2001) (citing *Fed. Express Corp. v. Fed. Espresso, Inc.*, 201 F.3d 168, 173 (2d Cir. 2000)) (outlining the two elements for the Second Circuit).

¹⁶³ *Pure Foods, Inc. v. Minute Maid Corp.*, 214 F.2d 792, 797 (5th Cir. 1954).

¹⁶⁴ *Heaton Distrib. Co. v. Union Tank Car Co.*, 387 F.2d 477, 486 (8th Cir. 1967).

¹⁶⁵ *Chemical Corp. of Am. v. Anheuser-Busch, Inc.*, 306 F.2d 433, 439 (5th Cir. 1962).

the infringer is irrelevant and an injunction is appropriate.¹⁶⁶ The U.S. Army would be capable of requesting such relief and has obtained such orders in at least two instances.¹⁶⁷

Recently, the Department of Justice filed an injunction against a company infringing the AFIP mark.¹⁶⁸ AFIP stands for the Armed Forces Institute of Pathology and provides “[w]orld-class, life-saving diagnostic consultations on pathologic specimens from military, veterans, and civilian medical, dental and veterinary sources.”¹⁶⁹ “Ask AFIP” is a registered service mark providing Internet support to the field of medicine.¹⁷⁰ In 2005, the Defense Base Closure and Realignment and Closure (BRAC) Commission recommended “disestablish[ing] all elements of the Armed Forces Institute of Pathology”¹⁷¹ As a result, “the Department [of Defense] will rely on the civilian market for second opinion pathology consults and initial diagnosis when the local pathology labs capabilities are exceeded.”¹⁷² Subsequent to this announcement, AFIP Laboratories, a private company, emerged looking to capitalize on this new opportunity.¹⁷³ The Department of Justice sought an injunction against AFIP Laboratories citing that the company attempted to use the fame and goodwill of the Armed Forces Institute of Pathology.¹⁷⁴ Although ultimately successful, the injunction came at great time and expense.¹⁷⁵

¹⁶⁶ *Coty, Inc. v. Parfums De Grande Luxe, Inc.*, 298 F. 865, 869 (2d Cir. 1924).

¹⁶⁷ Chafin Interview, *supra* note 95. Conversely, no company has ever received an injunction against the U.S. Army. *Id.* The primary reason is that if a U.S. Army use ever amounted to infringement, the U.S. Army would cease the use prior to a company filing for an injunction. *Id.*

¹⁶⁸ *Id.*

¹⁶⁹ Armed Forces Institute of Pathology Home Page, <http://www.afip.org/> (last visited Jan. 30, 2010).

¹⁷⁰ U.S. Trademark No. 3206308 (filed May 30, 2006).

¹⁷¹ U.S. DEP’T OF DEF., 2005 DEFENSE BASE CLOSURE AND REALIGNMENT COMM’N, FINAL REP. 257 (Sept. 2005), available at <http://www.brac.gov/docs/final/Volume1BRACReport.pdf>.

¹⁷² *Id.* at 258.

¹⁷³ *Newly-Formed AFIP Laboratories Fills Critical Void Left by Scheduled Closure of Walter Reed Army Medical Center*, EARTH TIMES, Aug. 7, 2009, <http://www.eathtimes.org/articles/show/newly-formed-afip-laboratories-fills-critical,920449.shtml>.

¹⁷⁴ Chafin Interview, *supra* note 95.

¹⁷⁵ *Id.* The URL cited in the AFIP Laboratories article, <http://www.afiplaboratories.com>, no longer links to the company. See <http://www.afiplaboratories.com> (last visited Jan. 31, 2010).

2. Monetary Recovery

The Lanham Act also allows a plaintiff to recover damages, the defendant's profits, and the costs of the suit.¹⁷⁶ Courts award damages to compensate the trademark owner for violations by the infringer.¹⁷⁷ The Lanham Act, though, does not provide for punitive damages.¹⁷⁸ It does provide, however, for recovery of a defendant's profits.¹⁷⁹ Such recovery compensates the trademark owner for lost sales, prevents unjust enrichment, and deters infringement.¹⁸⁰ Additionally, courts may also award attorney fees in "exceptional cases."¹⁸¹

An injunction and monetary recovery provide deterrence and recourse for an aggrieved party.¹⁸² However, just because a likelihood of confusion or dilution exists, defenses often provide shelter to companies that use others' marks.

H. Defenses

An alleged infringer is not left helpless under the Lanham Act. Registration of a mark under the Lanham Act provides conclusive evidence that the registrant owns the valid mark and that the registrant has the "exclusive right to use the mark in commerce"¹⁸³ The Lanham Act enumerates nine defenses to this conclusive evidence.¹⁸⁴ Of

¹⁷⁶ Lanham Act, 15 U.S.C. § 1117(a) (2006). *See id.* § 1125 (outlining the violations under the Lanham Act).

¹⁷⁷ *Caesars World, Inc. v. Venus Lounge, Inc.*, 520 F.2d 269, 274 (3d Cir. 1975) (quoting *Elecs. Corp. of Am. v. Honeywell, Inc.*, 358 F. Supp. 1230, 1232 (D. Mass. 1973)).

¹⁷⁸ *Dial One of the Mid-South, Inc. v. BellSouth Telcomms., Inc.*, 269 F.3d 523, 527 (5th Cir. 2001).

¹⁷⁹ 15 U.S.C. § 1117(a).

¹⁸⁰ *Maltina Corp. v. Cawy Bottling Co.*, 613 F.2d 582, 584–85 (5th Cir. 1980).

¹⁸¹ 15 U.S.C. § 1117(a). *See Taco Cabana Int'l, Inc. v. Two Pesos, Inc.*, 932 F.2d 1113, 1117 (5th Cir. 1991) (awarding \$937,550 in attorney's fees).

¹⁸² The U.S. Army is primarily concerned with ceasing any unauthorized uses, not making money from damages. Chafin Interview, *supra* note 95. To date, the U.S. Army has not received damages from any infringing use. *Id.* Ultimately, if a company has infringed on a U.S. Army mark, the company has either ceased the infringing activity or become a licensee of the U.S. Army. *Id.*

¹⁸³ 15 U.S.C. § 1115(b).

¹⁸⁴ *Id.* The defenses include the following:

- (1) That the registration or the incontestable right to use the mark was obtained fraudulently; or

the nine, the most relevant to the U.S. Army is the defense of abandonment.¹⁸⁵

The defenses for patents and copyrights are very similar to trademarks.¹⁸⁶ Under the Lanham Act, a mark is abandoned when the owner stops using its mark and intends to discontinue the use of its mark or when the mark becomes generic.¹⁸⁷ Courts have created other similar doctrines that operate in the same manner as abandonment. For example,

-
- (2) That the mark has been abandoned by the registrant; or
 - (3) That the registered mark is being used, by or with the permission of the registrant or a person in privity with the registrant, so as to misrepresent the source of the goods or services on or in connection with which the mark is used; or
 - (4) That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin; or
 - (5) That the mark whose use by a party is charged as an infringement was adopted without knowledge of the registrant's prior use and has been continuously used by such party or those in privity with him from a date prior to (A) the date of constructive use of the mark established pursuant to section 7(c) [15 USCS § 1057(c)], (B) the registration of the mark under this Act if the application for registration is filed before the effective date of the Trademark Law Revision Act of 1988, or (C) publication of the registered mark under subsection (c) of section 12 of this Act [15 USCS § 1062(c)]: *Provided, however,* That this defense or defect shall apply only for the area in which such continuous prior use is proved; or
 - (6) That the mark whose use is charged as an infringement was registered and used prior to the registration under this Act or publication under subsection (c) of section 12 of this Act [15 USCS § 1062(c)] of the registered mark of the registrant, and not abandoned: *Provided, however,* That this defense or defect shall apply only for the area in which the mark was used prior to such registration or such publication of the registrant's mark; or
 - (7) That the mark has been or is being used to violate the antitrust laws of the United States; or
 - (8) That the mark is functional; or
 - (9) That equitable principles, including laches, estoppel, and acquiescence, are applicable.

Id.

¹⁸⁵ Chafin Interview, *supra* note 22.

¹⁸⁶ The Copyright Act, 17 U.S.C. §§ 107–112 (2006); The U.S. Patent Act, 35 U.S.C. §§ 273, 282 (2006).

¹⁸⁷ 15 U.S.C. § 1127.

naked licensing of a mark, in which a mark owner fails to provide quality control of its product, results in abandonment.¹⁸⁸ Failing to police a mark also results in abandonment.¹⁸⁹ Both of these doctrines and examples will be discussed below.¹⁹⁰

Keeping in mind the background of basic trademarks, how they function in the commercial world, and defenses to trademark infringement claims, the following sections will explore the current state of trademarks in the U.S. Army.

IV. Current State of Trademarks in the U.S. Army

Primarily because of the unique nature of the U.S. Army, its marks are quite different from those in the commercial world. After all, the U.S. Army is in the business of providing for the nation's defense.¹⁹¹

To build the nation's defense, the U.S. Army must recruit individuals.¹⁹² In its mission, the U.S. Army uses its phrases and symbols to attract recruits and retain Soldiers.¹⁹³ "The many symbols, names, insignia and logos of the Army represent the time-honored qualities of the Army and its service to the Nation. They operate as legally-recognized marks and are invested with goodwill deserving of protection."¹⁹⁴ The U.S. Army recruits Soldiers and protects its goodwill by licensing its phrases and symbols.¹⁹⁵ A goal of the licensing program is to "[e]nhanc[e] the name, reputation and public goodwill of the DoD Components through a broad brand promotion and licensing program that provides quality branded products and services at reasonable

¹⁸⁸ *Westco Group, Inc. v. K.B. & Assocs.*, 128 F. Supp. 2d 1082, 1088 (N.D. Ohio 2001) (citing *Gorenstein Enters. v. Quality Care-USA*, 874 F.2d 431, 435 (7th Cir. 1989)). See *infra* note 250 and accompanying text (explaining naked licenses).

¹⁸⁹ *Margaret Wendt Found. Holdings, Inc. v. Roycroft Assocs.*, 2007 U.S. Dist. LEXIS 76429 (W.D.N.Y. Oct. 11, 2007) (quoting *Hermes Int'l v. Lederer de Paris Fifth Ave., Inc.*, 219 F.3d 104, 110 (2d Cir. 2000)). See *infra* Part V.D.1 and accompanying text (explaining failure to police).

¹⁹⁰ See *infra* note 250 and accompanying text (explaining naked licenses). See *infra* Part V.D.1 and accompanying text (explaining failure to police).

¹⁹¹ U.S. Army, *GoArmy.com*, About the Army, Overview, <http://www.goarmy.com/about/index.jsp> (last visited Jan. 25, 2009).

¹⁹² See generally U.S. Army Recruiting Command Home Page, <http://www.usarec.army.mil/> (last visited Jan. 25, 2009) (providing a background in U.S. Army recruiting).

¹⁹³ DoDD 5535.09, *supra* note 22, at 3.

¹⁹⁴ James Memo, *supra* note 8.

¹⁹⁵ DoDD 5535.09, *supra* note 22, at 3.

prices.”¹⁹⁶ The licensing program also “[s]trengthen[s] the marks of the DoD Components through licensing and by expanding the number of registered trademarks they own both in the United States and abroad.”¹⁹⁷ Recent legislation permits the military to retain income from licensing.¹⁹⁸ This licensing produced over \$2 million in retained income for fiscal year 2008.¹⁹⁹ It also led senior U.S. Army leaders to inquire into the protections afforded to U.S. Army’s phrases and symbols.²⁰⁰ Although there is great potential for further income, the following part will explore a number of limitations affecting the Army.

V. Why Trademark Law Does Not Protect all of the U.S. Army’s Marks

Increased scrutiny of U.S. Army trademark protections has revealed that trademark law is too cumbersome a process to protect all U.S. Army marks. Gaining protection under the Lanham Act requires using a mark in commerce, registering the mark with the USPTO, paying fees, and enforcing any infringement.²⁰¹ However, the Lanham Act adequately protects at least some well-known U.S. Army marks.²⁰² Less famous phrases and symbols require additional protection as discussed below.

A. Use in Commerce

The Lanham Act protects U.S. Army phrases and symbols²⁰³ used “in commerce.”²⁰⁴ “The term ‘use in commerce’ means the bona fide use of a mark in the ordinary course of trade”²⁰⁵ Widely-known phrases

¹⁹⁶ *Id.*

¹⁹⁷ *Id.*

¹⁹⁸ Disbursements Out of Available Advances for Obligations Chargeable to Appropriations of Other Departments/Agencies, 10 U.S.C. § 2206 (2006).

¹⁹⁹ Chafin Interview, *supra* note 22. See generally Marine Corps Licensing, <https://author.marines.mil/unit/divpa/tmlo/Pages/welcome.aspx> (last visited Feb. 1, 2010).

²⁰⁰ *Id.* See also James Memo, *supra* note 8.

²⁰¹ 15 U.S.C. §§ 1113, 1114, 1115, 1127.

²⁰² James Memo, *supra* note 8 (noting specifically the U.S. Army’s symbol (black and gold star)).

²⁰³ From this point on, this article uses the terms “phrases” and “symbols” instead of marks to signify that not all U.S. Army phrases and symbols are marks afforded protection under the Lanham Act.

²⁰⁴ Strasser, *supra* note 51, at 427.

²⁰⁵ 15 U.S.C. § 1127.

protected by the Lanham Act include “BE ALL YOU CAN BE”²⁰⁶ and “ARMY STRONG.”²⁰⁷ Other widely-known U.S. Army symbols receiving protection include the U.S. Army logo²⁰⁸ and the U.S. Army Reserve logo.²⁰⁹ Used in television commercials, on recruiting t-shirts, and even on bumper stickers, the Lanham Act adequately protects these famous phrases and symbols because the U.S. Army uses them as traditional trademarks.

Now imagine if the well-known motto “BE ALL YOU CAN BE” identified laundry starch or if West Point’s mascot, the Army Mule, identified an Alabama sporting goods and military surplus store.²¹⁰ Despite the protections offered to some of the U.S. Army’s famous phrases and symbols by the Lanham Act, many lesser-known phrases and symbols have never been on television, on recruiting t-shirts, or on bumper stickers. For example, very few unit crests, badges,²¹¹ and tabs²¹² have been on television or advertised in outlets such as Wal-Mart.²¹³ Consequently, if these symbols are not considered used in the traditional sense of commerce, the Lanham Act does not attach protections. Something more is needed to fill this gap in protection.

²⁰⁶ U.S. Trademark No. 78888832 (filed May 22, 2006). *See supra* note 11 (explaining the origin of the phrase).

²⁰⁷ U.S. Trademark No. 3458664 (filed Oct. 12, 2006). *See infra* note 352 and accompanying text.

²⁰⁸ U.S. Trademark No. 2908608 (filed Oct. 24, 2003).

²⁰⁹ U.S. Trademark No. 2676969 (filed Sept. 27, 2001).

²¹⁰ Altherr, *supra* note 20, at 52.

²¹¹ Examples include: Airborne, Air Assault, and Diver.

²¹² Examples include: Ranger, Sapper, Airborne, Mountain, and Special Forces.

²¹³ *See Sears Announces Launch of All American Army Brand First Infantry Collection*, REUTERS, Sept. 2, 2008, available at <http://www.reuters.com/article/pressRelease/idUS162201+02-Sep-2008+PRN20080902>. For the first time, the U.S. Army licensed one of its division patches for use on commercial clothes. *Id.* *See also* Sears, US Army 1st Infantry Division Quilted Fleece—Model M0551 at Sears.com, http://www.sears.com/shc/s/p_10153_12605_041M0551000P?yNames=Clothing&cName=Men%27s&sName=Shirts (last visited Feb. 26, 2009) (displaying one of the jackets with the First Infantry patch).

B. Ownership

In addition to the U.S. Army's unconventional use of phrases and symbols in commerce, many issues arise as to actual ownership of those phrases and symbols.²¹⁴

The Army has numerous symbols such as unit patches (e.g., Screaming Eagles patch as popularized in *Band of Brothers*),²¹⁵ special skill badges (e.g., Airborne wings),²¹⁶ and rank (e.g., officer rank insignia),²¹⁷ and the collection continues to grow.²¹⁸ In fact, with the new BRAC recommendations, the need arises for new symbols.²¹⁹ Under BRAC, many Armor units from Fort Knox, Kentucky, will relocate and join the Infantry units at Fort Benning, Georgia, becoming the Maneuver Center of Excellence.²²⁰ By necessity, a new installation patch for Fort Benning was created to unite the branches.²²¹ The increase in U.S. Army symbols results in additional registrations, fees, and time to gain protection under the Lanham Act.²²²

The U.S. Army also has ownership problems with its existing, famous marks.²²³ In 1998, the U.S. Army filed and received two registrations for the term "Hooah!"²²⁴ for energy bars included in U.S.

²¹⁴ Telephone Interview with J. Scott Chafin, Trademark and Copyright Att'y, in Arlington, Va. (Sept. 12, 2008) [hereinafter Chafin Interview].

²¹⁵ See HBO: Band of Brothers: Homepage, <http://www.hbo.com/band-of-brothers/index.html> (last visited Jan. 29, 2010) (providing an image of a squad wearing the 101st Airborne Division's Screaming Eagles patch).

²¹⁶ See U.S. DEP'T OF ARMY, REG. 670-1, WEAR AND APPEARANCE OF ARMY UNIFORMS AND INSIGNIA para. 29-17 (3 Feb. 2005) (depicting special skill badges).

²¹⁷ *Id.* para. 28-6 (depicting rank insignias).

²¹⁸ Chafin Interview, *supra* note 214.

²¹⁹ Global Security, Fort Benning, <http://www.globalsecurity.org/military/facility/fortbenning.htm> (last visited Jan. 14, 2009).

²²⁰ *Id.*

²²¹ Cheryl Rodewig, *MCOE Patch Represents Both Armor and Infantry*, BAYONET, Mar. 14, 2008, available at http://www.thebayonet.com/articles/2008/03/14/news/top_stories/top03.txt. See *infra* Appendix B for the patches of the Armor School, Infantry School, and Maneuver Center of Excellence.

²²² Using a mark in commerce while building its fame takes time.

²²³ Chafin Interview, *supra* note 214.

²²⁴ E-mail from J. Scott Chafin, Trademark and Copyright Att'y, USALSA, to author (27 Aug. 2008, 14:22 EST) [hereinafter Chafin e-mail] (on file with author). The design included Hooah! in a camouflage pattern. U.S. Trademark No. 2139165 (filed 14 Mar. 1997). The second design included only Hooah!. U.S. Trademark No. 2139166 (filed 14 Mar. 1997).

Army meal packages.²²⁵ The energy bars enjoyed initial success in early 2004, and as a result, the U.S. Army entered into an agreement with D'Andrea Brothers LLC to license "Hooah!" for a commercial version of the energy bar.²²⁶ Based on its initial license for energy bars, D'Andrea Brothers LLC, attempted to expand the scope of its license by registering the phrase with the USPTO in the clothing class.²²⁷ Prior to this registration, the U.S. Army already licensed the phrase "Hooah!" to Lone Star Special Tees for clothing.²²⁸ Due to the conflicting use, Lone Star Special Tees filed a civil action against D'Andrea Brothers LLC challenging their "Hooah!" registration.²²⁹ The U.S. Army may have caused this ownership problem by not previously using "Hooah!" in commerce. This example typifies how the U.S. Army's lack of exclusive ownership of military-centric phrases provides other companies with the opportunity to use and exploit these phrases. Moreover, the lack of a clear mark owner in U.S. Army phrases demonstrates the gaps in traditional trademark protection.

Yet another example of an ownership problem is when a contractor received a trademark registration for the name of a local military installation's newspaper.²³⁰ Many military installations have newspapers that serve the local interests and have a name that references the installation.²³¹ For example, the U.S. Army Infantry Center's local military newspaper is *The Bayonet*.²³² This references the bayonet contained in the former SSI for Fort Benning and depicted below.

²²⁵ Chafin e-mail, *supra* note 224.

²²⁶ *Id.* The commercial version of the energy bar is still available. Amazon.com, Amazon.com: hooah energy – Health & Personal Care: Health & Personal Care, <http://www.amazon.com/s?ie=UTF8&keywords=hooah%20energy&search-type=best&tag=coffeeresearch33746-20&index=hpc-index&link%5Fcode=qs> (last visited Mar. 11, 2009). From 1998 to 2004, the U.S. Army did not use the phrase "Hooah!" in commerce and consequently other companies attempted to register the very similar, "Hooah!," in classes other than food. Chafin e-mail, *supra* note 224. One class included duffel bags, t-shirts and baseball caps. U.S. Trademark No. 2704976 (filed Sept. 30, 1999). Another class included sports drinks. U.S. Trademark No. 78440017 (filed June 23, 2004).

²²⁷ Chafin e-mail, *supra* note 224. D'Andrea Brothers LLC also registered "Hooah!" for computer services. U.S. Trademark No. 3222600 (filed May 23, 2006).

²²⁸ Chafin e-mail, *supra* note 224.

²²⁹ *Id.*

²³⁰ Altherr, *supra* note 20, at 53.

²³¹ *Id.*

²³² The Bayonet.com, <http://www.ledger-enquirer.com/bayonet/> (last visited Jan. 30, 2010). U.S. Trademark No. 1727534 (filed Oct. 27, 1992).



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Normally, there are no issues with a private company owning a newspaper bearing the name that has significance in the community. However, in one such instance, the newspaper company registered the name of the newspaper with the USPTO.²³⁴ This proved problematic when the installation decided to award the newspaper contract to another company.²³⁵ The federal registration prevented the new contract awardee from using the registered name.²³⁶

Supplemental protection will fill those gaps and prevent ownership issues such as the likelihood of confusion and endorsement. Private companies attempt to use phrases and symbols similar to those of the U.S. Army for gain. As mentioned previously, the USSOCOM's mission is to "[p]rovide fully capable Special Operations Forces to defend the United States and its interests."²³⁷ To accomplish this mission, members of USSOCOM use a variety of weapons and equipment, but do not endorse the companies supplying their weapons and equipment. SOCOM GEAR²³⁸ is an online company that sells tactical gear and weapons. SOCOM GEAR's website includes a logo (included earlier in the article²³⁹) displaying a tip of a spear with three rings around the shaft;

²³³ US Military Stuff, <http://www.usmilitarystuff.com/images/Infantry%20School%20Color.jpg> (last visited Jan. 14, 2009).

²³⁴ Altherr, *supra* note 20, at 53.

²³⁵ *Id.*

²³⁶ *Id.*

²³⁷ Headquarters, U.S. Special Operations Command Home Page, <http://www.socom.mil/> (last visited Jan. 16, 2009).

²³⁸ SOCOM GEAR, *supra* note 16.

²³⁹ *See infra.*

two concentric ovals surround the spear; the next outer layer displays SOCOM GEAR; and another concentric oval surrounds that layer.²⁴⁰ Similarly, USSOCOM's combatant command patch displays a tip of a spear with three rings around the shaft; two concentric ovals also surround the spear; "United States Special Operations Command" fills the next outer layer; and another concentric oval surrounds that layer.²⁴¹ In addition to the symbols' similarity in appearance, the name SOCOM GEAR sounds like USSOCOM.²⁴² Together, SOCOM GEAR's name and symbol may cause confusion with USSOCOM's name and symbol. Moreover, the total package appearance of SOCOM GEAR's name, symbol, and display of specialty military gear displayed on its website could lead a reasonable person to believe that USSOCOM endorses it.²⁴³ This could be a reason why the SOCOM GEAR has changed its logo to the following:



In this example, a simple license from the U.S. Army to SOCOM GEAR would allow the use of USSOCOM's marks.

C. Licensing

The Lanham Act allows an owner of a trademark to license its mark to another company, which presents another problem for the U.S. Army.²⁴⁵ In licensing, an owner contracts with a related company²⁴⁶ to

²⁴⁰ *Id.*

²⁴¹ *Id.*

²⁴² See *supra* notes 15 and 17 for a comparison.

²⁴³ SOCOM GEAR, *supra* note 16.

²⁴⁴ When I visited the SOCOM GEAR website on January 30, 2009, I found a different logo. SOCOM GEAR still displayed the other logo with the spear in different sections. SOCOM GEAR, *supra* note 16.

²⁴⁵ Lanham Act, 15 U.S.C. § 1055 (2006).

use the mark without infringing on the owner's trademark rights.²⁴⁷ However, one of the goals of the Lanham Act is to protect a company's investment in goodwill and a consumer's investment in an authentic product.²⁴⁸ When allowing another company to use its marks, the trademark owner must still exercise control over the mark to ensure the quality of the good.²⁴⁹

Losing control of a mark in a licensing agreement can lead to naked licensing, a type of abandonment.²⁵⁰ The Lanham Act maintains protection while still providing for licenses by requiring an owner to control the quality of its mark.²⁵¹ Maintaining control may mean quality checks of the products that bear its marks.²⁵² Without quality control measures in a license, the owner of a trademark creates a naked license, which does not comply with the intent of trademark law resulting in abandonment.²⁵³

Naked licensing examples may already exist in the U.S. Army. "Department of Army (DA) policy restricts the use of military designs

²⁴⁶ The term "related company" means any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used. *Id.* § 1127.

²⁴⁷ 1-2 GILSON, *supra* note 63, at 6.01(2).

²⁴⁸ *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1360 (C.C.P.A. 1973) (quoting S. REP. NO. 1333, 79th Cong., 2d Sess. (1946), *in* U.S.C.C.A.N., 79th Cong., 2d Sess. at 1274-8 (1946)).

²⁴⁹ 1-2 GILSON, *supra* note 63, at 6.01(2).

²⁵⁰ *Westco Group, Inc. v. K.B. & Assocs.*, 128 F. Supp. 2d 1082, 1088 (N.D. Ohio 2001) (citing *Gorenstein Enters. v. Quality Care-USA*, 874 F.2d 431, 435 (7th Cir. 1989)).

A completely uncontrolled or "naked" trademark license constitutes an abandonment of the licensor's rights in the mark. Naked licenses deceive customers, who are entitled to rely on the mark as signifying consistency and predictability. If the licensor does not hold its licensees to a certain standard, the public will be misled by the use of the mark, whether or not the products are in fact of good quality.

2-6 GILSON, *supra* note 63, at 6.01(6)(e).

²⁵¹ 15 U.S.C. § 1055 (2006). *Westco*, 128 F. Supp. 2d at 1088 (quoting J. MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 18:42 (4th ed. 1997)).

²⁵² The U.S. Department of Agriculture maintains rigorous standards when licensing the Smokey Bear symbol. *See* Smokey Bear Style Guide, http://www.smokeybear.com/resources/Style_Guide.pdf (last visited Jan. 30, 2010).

²⁵³ *Id.* (quoting *Exxon Corp. v. Oxxford Clothes, Inc.*, 109 F.3d 1070, 1074 (5th Cir. 1997)). *Id.* (quoting *Gorenstein Enters. v. Quality Care-USA*, 874 F.2d 431, 435 (7th Cir. Ill. 1989)).

for the needs or the benefit of Army personnel.”²⁵⁴ However, DA policy allows certain U.S. Army symbols to be incorporated into products.²⁵⁵

The Institute of Heraldry (TIOH) is responsible for granting permission for the incorporation of certain Army designs in articles manufactured for sale. Commanders of units authorized a shoulder sleeve insignia (SSI) or a distinctive unit insignia (DUI) may authorize the reproduction of the SSI or DUI on commercial articles such as shirts, tie tacks, cups, or plaques²⁵⁶

With these relaxed rules, many commanders²⁵⁷ have their unit’s SSI and DUI printed on car magnets, t-shirts, hats, coffee mugs, and almost anything else one can imagine.²⁵⁸ Often, when commanders tell the staff to make unit coins, bumper stickers, or flags with their unit’s SSI or DUI, they do not create a license for their symbols.²⁵⁹ Further, the commanders often do not check on the quality of the products.²⁶⁰ Moreover, TIOH rarely learns of the authorizations, because AR 672-8 does not require notification.²⁶¹ As most commanders are not attorneys specializing in trademark law, they tend to overlook the full impact their actions have on U.S. Army symbols. Consequently, the authorization afforded by AR 672-8 could amount to a naked license and result in abandonment of the symbols used under the Lanham Act.

Larger problems also exist outside of the U.S. Army where companies try to capitalize on U.S. Army marks.

²⁵⁴ AR 672-8, *supra* note 9, para. 2-5.

²⁵⁵ *Id.* para. 2-5(a).

²⁵⁶ *Id.* para. 2-5(b).

²⁵⁷ Commanders authorized a SSI or DUI usually command a brigade or larger organization. However, many brigade’s SSI and DUI appear on merchandise without proper authority under AR 672-8. Zazzle.com, 793rd Military Police Battalion – DUI – Mug from Zazzle.com, http://www.zazzle.com/793rd_military_police_battalion_dui_mug-168968789331478008 (last visited May 16, 2009).

²⁵⁸ See Military Magnets Home Page, <http://www.militarymagnets.com/> (last visited May 16, 2009).

²⁵⁹ From the author’s experience, commanders do not consider trademark law when using their unit’s SSI or DUI.

²⁶⁰ From the author’s experience, commanders do not perform quality checks on the items they order.

²⁶¹ AR 672-8, *supra* note 9. Without notification and some quality control measures, this regulation invites commanders to create naked licenses.

D. Enforcement

The mere act of registering a mark hardly absolves a mark owner of further responsibilities.²⁶² For example, in order to maintain trademark rights, owners must continuously, but not absolutely, monitor use of its marks.²⁶³ Owners police their marks by preventing the unauthorized use of its marks by others.²⁶⁴ Dilution can weaken the strength of a particular mark.²⁶⁵ However, genericide, which occurs when a mark no longer identifies its source, can take a symbol outside the reaches of trademark protection.²⁶⁶ Collectively and independently, doctrines such as failure to police, dilution, and genericide can all lead to loss of any rights in a mark.

1. Failure to Police

The following example, from the U.S. Military Academy, reveals the necessity to police marks and the dangers of continued unauthorized use.

During the first Saturday of every year, the U.S. Military Academy plays the U.S. Naval Academy in football.²⁶⁷ This game, referred to as the “Army/Navy Game,” attracts thousands of people every year, providing vendors opportunities to sell Army and Navy merchandise.²⁶⁸

²⁶² Lanham Act, 15 U.S.C. § 1127 (2006) (citing the responsibility to use the mark in commerce). *See also* U.S. CONST. art. I, § 8, cl. 3.

²⁶³ Engineered Mech. Serv., Inc. v. Applied Mech. Tech., Inc., 584 F.Supp. 1149, 1160 (1984).

²⁶⁴ Janet M. Garetto, *Preventing Loss of Federal Trademark and Service Mark Rights*, INTELL. PROP. TODAY, Sept. 2002, available at <http://library.findlaw.com/2002/Nov/14/132391.pdf>.

²⁶⁵ Autozone, Inc. v. Strick, 466 F. Supp. 2d 1034, 1045 (N.D. Ill. 2006). The Trademark Dilution Revision Act of 2006 adds a likelihood of dilution cause of action to actual dilution. *Id.* at 1044–45.

²⁶⁶ 1-2 GILSON, *supra* note 63, at 2.02.

²⁶⁷ *See generally* John Fischer, *Philadelphia Offers Free Public Events to Celebrate the Army/Navy Game*, About.com, http://philadelphia.about.com/cs/collegesports/a/army_navy_game_2.htm (last visited Jan. 15, 2009) (providing history and facts about the rivalry game).

²⁶⁸ *Id.* In 2006, there were over 50,000 visitors. *Id.* *See* Go Army Sports, 2008 Army/Navy Game Day Replica Jersey, https://www.nmnathletics.com/sellnew/ViewItem.dbml?_IN_STORE_=YES&DB_OEM_ID=11100&ITMID=48138 (last visited May 16, 2009); *see also* Hat Junkies, Undefeated “Army vs Navy” New Era Fitted Hat, <http://www.hatjunkies.com/820/undefeated-army-vs-navy-new-era-fitted-hat/> (last visited May 16, 2009).

Each year, a few unauthorized vendors attempt to sell clothing and memorabilia bearing unlicensed versions of West Point's symbols in the parking lot of the football stadium.²⁶⁹ In response, Jim Flowers, licensing director for West Point, attends the game with Philadelphia Police Department (Licensing and Trademark Division) agents to police the infringers.²⁷⁰ Repeatedly since 1990, three groups with three to five people in each group have sold unlicensed merchandise bearing West Point's symbols.²⁷¹ Mr. Flowers and the Philadelphia Police Department have confiscated between \$75,000 to \$100,000 worth of unlicensed merchandise from these repeat offenders.²⁷² The Collegiate Licensing Company has then used the merchandise as evidence to take the vendors to court.²⁷³ Without the efforts of Mr. Flowers and the Philadelphia Police Department, the continued unauthorized use of West Point's symbols at the Army/Navy game and other locations²⁷⁴ could deteriorate the link between West Point's symbol and West Point. Consequently, West Point's policing actions prevent abandonment of its marks.²⁷⁵

²⁶⁹ The U.S. Military Academy is located at West Point, New York and is often referred to as West Point. See U.S. Military Acad. Home Page, <http://www.westpoint.edu/> (last visited Mar. 2, 2009). See *infra* Appendix C for a listing of West Point's symbols and marks. Telephone Interview with Jim Flowers, West Point Licensing Agent, in West Point, N.Y. (Sept. 25, 2008). Jim Flowers holds the position as licensing director for the U.S. Military Academy (USMA). Mr. Flowers is responsible for licensing USMA's collegiate marks.

²⁷⁰ *Id.*; see also MU Release, *MU To Patrol For Unlicensed Merchandise*, WSAZ, Sept. 6, 2007, <http://www.wsaz.com/news/headlines/9620482.html> (explaining a similar situation with Marshall University at the Friends of Coal Bowl).

²⁷¹ Telephone Interview with Jim Flowers, West Point Licensing Agent, in West Point, N.Y. (Mar. 1, 2009).

²⁷² *Id.*

²⁷³ Telephone Interview with Jim Flowers, West Point Licensing Agent, in West Point, N.Y. (Oct. 27, 2008). The Collegiate Licensing Company licenses West Point merchandise and prosecutes infringers. *Id.*

²⁷⁴ Military Creations, L.L.C. licenses the Army mule (West Point's mascot) without the permission of the U.S. Army or the U.S. Military Academy. Chafin Interview, *supra* note 214 (notifying this company of its infringement). Military Creations no longer has a functioning webpage. See My Military Creations, L.L.C. Home Page, <http://www.militarycreationsllc.com/> (last visited Feb. 28, 2009).

²⁷⁵ Garetto, *supra* note 264. However, policing actions like this are not practical at the U.S. Army level as only one intellectual property attorney works there. Chafin Interview, *supra* note 22.

2. Dilution by Tarnishment

Dilution by tarnishment occurs when the use of a mark similar to a famous mark “harms the reputation of its famous mark.”²⁷⁶ The U.S. Army, like many trademark owners, has a stake in protecting the reputation of its marks.²⁷⁷ The Assistant Secretary of the Army, the Honorable Ronald James, stated that the licensing of U.S. Army phrases and symbols helps recruit and retain Soldiers by “enhancing the Army’s image.”²⁷⁸ Accordingly, countless unauthorized uses of the U.S. Army’s symbols and phrases may detract from the U.S. Army’s humanitarian image. For instance, many T-shirts display a grim reaper with the U.S. Army paratrooper badge and a motto stating “death from above.”²⁷⁹ Another example includes a T-shirt with the U.S. Army Master Parachutist wings on the front and the following definition of a paratrooper on the back: “Highly trained [S]oldier who jumps from perfectly good airplanes, visits exotic places[,] meets interesting people and kills them.”²⁸⁰ Some may believe that these portrayals of paratroopers as ruthless killers conflicts with the U.S. Army’s development of professional Soldiers capable of operating across a diverse spectrum of operations.²⁸¹ However, popular businesses operating outside installations like Fort Bragg, North Carolina, sell these types of T-shirts.²⁸² Use of U.S. Army phrases and symbols on these T-shirts harms the reputation of the U.S. Army.²⁸³ This dilution by tarnishment may weaken the strength of the U.S. Army’s symbols and may ultimately lead to abandonment.²⁸⁴

²⁷⁶ Lanham Act, 15 U.S.C. § 1125(c)(2)(C) (2006); *supra* Part III.F.2 (describing dilution by tarnishment and contrasting it with dilution by blurring).

²⁷⁷ James Memo, *supra* note 8.

²⁷⁸ *Id.*

²⁷⁹ See *infra* Appendix D for pictures of these types of shirts.

²⁸⁰ The Trophy House, Inc., Definition of a Paratrooper, <http://thetrophyhouseinc.com/definition-of-a-paratrooper-p-593.html> (last visited 28 Feb. 2009).

²⁸¹ Having served as a U.S. Army Jumpmaster at the home of Special Operations Forces at Fort Bragg, N.C. and as a judge advocate at the home of Infantry at Fort Benning, Georgia, I do not necessarily share this view.

²⁸² See *id.*

²⁸³ This is probably one of the reasons the War Department changed its name to the Department of Defense. Globally, the U.S. Army wants a reputation of helping countries, not indiscriminately killing people. See DoD 101 An Introductory Overview of the Department of Defense, <http://www.defenselink.mil/pubs/dod101/> (last visited Oct.12, 2009).

²⁸⁴ *Hormel Foods Corp. v. Jim Henson Prods.*, 73 F.3d 497, 507 (2d Cir. 1996) (quoting *Deere & Co. v. MTD Prods.*, 41 F.3d 39, 42 (2d Cir. 1994)).

3. *Genericide*

Trademark law does not protect generic marks.²⁸⁵ A mark that once enjoyed trademark protection as an inherently distinctive mark or a potentially distinctive mark can eventually become generic.²⁸⁶ Genericide²⁸⁷ occurs when consumers relate a mark to the product rather than the source of the product.²⁸⁸

In *Colt Def. LLC v. Bushmaster Firearms, Inc.*, the weapons manufacturer Colt owned the M4 mark.²⁸⁹ Colt first used the term “M4” in commerce on May 28, 1993.²⁹⁰ In 1997, Bushmaster began to use the term M4 in advertising.²⁹¹ Four years later, on 7 November 2001, Colt filed an application with the USPTO for the term M4; the USPTO later approved the application.²⁹² In 2004, Colt sued Bushmaster for infringing Colt’s M4 mark by using M4 to refer to Bushmaster’s rifles.²⁹³ Bushmaster counterclaimed to cancel Colt’s M4 mark registration.²⁹⁴ At issue in the case was whether the term M4 was generic.²⁹⁵ The court found that many publications referred to the M4 as a type of carbine, not as the source of the producer.²⁹⁶ Survey evidence demonstrated that

²⁸⁵ *Filipino Yellow Pages, Inc. v. Asian Journal Publ’ns, Inc.* 198 F.3d 1143, 1147 (9th Cir. 1999)

²⁸⁶ *King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577, 579 (2d Cir. 1963). A mark is generic and thus non-distinctive “if the primary significance of the trademark is to describe the type of product rather than the producer” *Filipino*, 198 F.3d at 1147 (quoting *Anti-Monopoly, Inc. v. Gen. Mills Fun Group*, 611 F.2d 296, 304 (9th Cir. 1979) (emphases added)).

²⁸⁷ Genericide is “the deterioration of a trademark into a generic name” 1-2 GILSON, *supra* note 63, at 2.02. Examples include “[y]o-yo, thermos, aspirin, cellophane, [and] escalator” *Id.*

²⁸⁸ *King-Seeley*, 321 F.2d at 578.

²⁸⁹ *Colt Def. LLC v. Bushmaster Firearms, Inc.*, 486 F.3d 701, 704 (1st Cir. 2007). “The M4 is a lightweight, gas-operated, air-cooled, magazine-fed, selective-rate-of-fire carbine with a collapsible stock.” *Id.*

²⁹⁰ U.S. Patent and Trademark Office, Trademark Electronic Search System (TESS), <http://tess2.uspto.gov/bin/showfield?f=doc&state=4009:6a7li5.2.21> (last visited Feb. 28, 2009).

²⁹¹ *Colt*, 486 F.3d at 704.

²⁹² U.S. Patent and Trademark Office, Trademark Electronic Search System (TESS), <http://tess2.uspto.gov/bin/showfield?f=doc&state=4009:6a7li5.2.21> (last visited Feb. 28, 2009).

²⁹³ *Colt*, 486 F.3d at 704.

²⁹⁴ *Id.*

²⁹⁵ *Id.* at 706.

²⁹⁶ *Id.*

consumers saw the M4 in a similar way.²⁹⁷ The court found evidence of competitors using M4 in a generic manner.²⁹⁸ Colt even used the term M4 to refer to its weapons as opposed to source information.²⁹⁹ The court found that these long-term uses of the term M4 gradually deteriorated the link between M4 and Colt.³⁰⁰ The public, over time, associated the term M4 with the product rather than the producer.³⁰¹ Accordingly, the court affirmed the district court's ruling that the term M4 was generic.³⁰² The *Colt* case demonstrates that the Lanham Act protects nomenclature given to U.S. Army equipment when that nomenclature becomes linked to a producer. It also demonstrates that when long-term use of a nomenclature mark represents the equipment rather than the producer, that mark becomes generic and loses protection. Consequently, the M16, AT4, E-Tool, K-Bar, Jeep, and a host of other military marks may have already attained a generic status.

The previous scenarios highlight the shortcomings of the Lanham Act in protecting U.S. Army phrases and symbols. A more comprehensive solution is necessary to fill the gaps in protection and supplement the Lanham Act.

VI. Solution: Special Statute

With the goal of protecting U.S. Army phrases and symbols and recognizing the inadequacies of the Lanham Act in meeting that goal, the U.S. Army would certainly benefit from a special statutory enactment that provides complementary protection to the Lanham Act. This solution would provide the Department of Defense (DoD) and the U.S. Army with all ownership rights in U.S. Army phrases and symbols. Additionally, the statute would prevent the operation of many common law methods of losing trademark rights.

Many organizations have faced the same challenges as the U.S. Army when trying to protect their marks under the Lanham Act.³⁰³

²⁹⁷ *Id.* at 706–07.

²⁹⁸ *Id.* at 706.

²⁹⁹ *Id.* at 707.

³⁰⁰ *Id.* at 710.

³⁰¹ *Id.*

³⁰² *Id.* at 703. *See supra* note 81.

³⁰³ *See Smokey Bear*, 16 U.S.C. § 580p (2006) (providing the Department of Agriculture with exclusive rights in its name and the symbols of Smokey Bear and Woodsy Owl, and

These organizations have assisted in passing several laws that take protection of their marks outside the contours of traditional trademark protection.³⁰⁴

Congress has previously demonstrated a willingness to provide comprehensive protection to some governmental symbols.³⁰⁵ The Department of Agriculture's statute protects Smokey Bear and Woodsy Owl symbols by providing a comprehensive and enhanced package of trademark rights.³⁰⁶ The statute provides the definitions of Woodsy Owl and Smokey Bear.³⁰⁷ The statute also provides the most important right, the right to presumptive ownership in the names Woodsy Owl and

providing a cause of action for infringement and licensing rights); *see also* Marine Corps, 10 U.S.C. § 7881 (2006) (providing the U.S. Marine Corps with exclusive rights in its name and symbols and provides a civil action for infringement); Coast Guard [and other names], 14 U.S.C. § 639 (2006) (providing the U.S. Coast Guard with exclusive rights in its name and symbols); Boy Scouts of America, 36 U.S.C. § 30905 (2006) (providing the Boy Scouts of America with exclusive rights in its symbols); Girl Scouts of America, 36 U.S.C. § 80305 (2006) (providing the Girl Scouts of America with exclusive rights in its symbols); Little League; Little Leaguer, 36 U.S.C. § 130506 (2006) (providing the Little League with exclusive rights in its name and symbols); Olympic [and other names], 36 U.S.C. § 220506 (2006) (providing the U.S. Olympic Committee with exclusive rights in its name and symbols and provides a civil action for infringement).

³⁰⁴ TMEP, *supra* note 105, app. C (providing an exhaustive list of all special statutes that protect symbols).

³⁰⁵ *See* Central Intelligence Agency, 50 U.S.C. § 403m (2000) (CIA); *see also* Central Liquidity Facility, 18 U.S.C. § 709 (2006) (Dep't of Housing & Urban Dev., DEA, FBI, Secret Serv.); National Aeronautics and Space Administration [also flags, logo, seal], 42 U.S.C. § 2459b (2000) (NASA); Social Security [and other names, symbols and emblems], 42 U.S.C. § 1320b-10 (Social Security Admin.).

³⁰⁶ Smokey Bear, 16 U.S.C. § 580p (2006). “[T]he Smokey Bear trademark was removed from the public domain in 1952.” Pub. L. No. 82-359.

³⁰⁷ The statute defines Woodsy Owl and Smokey Bear as the following:

As used in this Act—

(1) the term “Woodsy Owl” means the name and representation of a fanciful owl, who wears slacks (forest green when colored), a belt (brown when colored), and a Robin Hood style hat (forest green when colored) with a feather (red when colored), and who furthers the slogan, “Give a Hoot, Don’t Pollute”, originated by the Forest Service of the United States Department of Agriculture;

(2) the term “Smokey Bear” means the name and character “Smokey Bear” originated by the Forest Service of the United States Department of Agriculture in cooperation with the Association of State Foresters and the Advertising Council.

Id.

Smokey Bear and the motto “Give a Hoot, Don’t Pollute.”³⁰⁸ The statute allows for an injunction for infringement upon the Department of Agriculture’s symbols or motto.³⁰⁹ Providing for more than the civil remedies available under the Lanham Act,³¹⁰ this statute also allows for criminal sanctions against infringers.³¹¹ Finally, the statute allows the Chief of Forest Services to license Smokey Bear products.³¹²

³⁰⁸ 16 U.S.C. § 580p-1. “The following are hereby declared the property of the United States: (1) The name and character ‘Smokey Bear.’ (2) The name and character ‘Woodsy Owl’ and the associated slogan, ‘Give a Hoot, Don’t Pollute.’” *Id.*

³⁰⁹ Both sections include the following:

(a) Whoever, except as provided by rules and regulations issued by the Secretary, manufactures, uses, or reproduces the character “Smokey Bear” or the name “Smokey Bear”, or a facsimile or simulation of such character or name in such a manner as suggests “Smokey Bear” may be enjoined from such manufacture, use, or reproduction at the suit of the Attorney General upon complaint by the Secretary.

(b) Whoever, except as provided by rules and regulations issued by the Secretary, manufactures, uses, or reproduces the character “Woodsy Owl”, the name “Woodsy Owl”, or the slogan “Give a Hoot, Don’t Pollute”, or a facsimile or simulation of such character, name, or slogan in such a manner as suggest “Woodsy Owl” may be enjoined from such manufacture, use, or reproduction at the suit of the Attorney General upon complaint by the Secretary.

Id. § 580p-4.

³¹⁰ 15 U.S.C. § 1117.

³¹¹ Criminal punishment includes:

Whoever, except as authorized under rules and regulations issued by the Secretary, knowingly and for profit manufactures, reproduces, or uses the character “Woodsy Owl”, the name “Woodsy Owl”, or the associated slogan, “Give a Hoot, Don’t Pollute” shall be fined under this title or imprisoned not more than six months, or both.

18 U.S.C. § 711a.

³¹² 36 C.F.R. § 271.4 (2010). The Chief of Forestry Services may authorize a license in Smokey Bear if the following conditions are met:

- (1) That the use to which the article or published material involving Smokey Bear is to be put shall contribute to public information concerning the prevention of forest fires.
- (2) That the proposed use is consistent with the status of Smokey Bear as the symbol of forest fire prevention and does not in any way detract from such status.
- (3) That a use or royalty charge which is reasonably related to the

Enacted in 1984, the special statute protecting U.S. Marine Corps symbols demonstrate Congress's willingness to provide supplementary protection to military symbols.³¹³ Similar to the Department of Agriculture's special statute, the U.S. Marine Corps's special statute provides exclusive ownership rights in the "seal, emblem, and initials of the United States Marine Corps."³¹⁴ Like the Department of Agriculture's special statute, this special statute also allows for licensing agreements.³¹⁵ Although, the statute allows for enforcement through a civil action or injunction, it does not allow criminal sanctions like the Department of Agriculture's statute.³¹⁶

commercial enterprise has been established.

(b) Such other conditions shall be included as the Chief deems necessary in particular cases.

Id.

³¹³ See Marine Corps, 10 U.S.C. § 7881 (2006); see also Coast Guard [and other names], 14 U.S.C. § 639 (2006) (providing protection to the U.S. Coast Guard's symbols). Enacted second in time, the Marine Corps statute was not based on the Coast Guard's 1950 statute. Chafin Interview, *supra* note 95.

³¹⁴ 16 U.S.C. § 580p-1; 10 U.S.C. § 7881(a).

³¹⁵ The statute states

No person may, except with the written permission of the Secretary of the Navy, use or imitate the seal, emblem, name, or initials of the United States Marine Corps in connection with any promotion, goods, services, or commercial activity in a manner reasonably tending to suggest that such use is approved, endorsed, or authorized by the Marine Corps or any other component of the Department of Defense.

Id. § 7881(b).

³¹⁶ *Id.* § 7881(c); 18 U.S.C. § 711a. The two remedies for infringement include

Whenever it appears to the Attorney General of the United States that any person is engaged or is about to engage in an act or practice which constitutes or will constitute conduct prohibited by subsection (b), the Attorney General may initiate a civil proceeding in a district court of the United States to enjoin such act or practice. Such court may, at any time before final determination, enter such restraining orders or prohibitions, or take such other action as is warranted, to prevent injury to the United States or to any person or class of persons for whose protection the action is brought.

10 U.S.C. § 7881(c). *But cf.* Coast Guard [and other names], 14 U.S.C. § 639 (2006) (providing for imprisonment).

With a 1950 special statute for the U.S. Coast Guard³¹⁷ and a 1984 special statute for the U.S. Marine Corps, one may wonder why Congress never extended these significant protections to the U.S. Army, U.S. Navy, and U.S. Air Force.³¹⁸ Clearly, the U.S. Army is as deserving as the U.S. Marine Corps in terms of protection. First, with over one million active, guard, and reserve Soldiers, the U.S. Army's force over triples the number of active and reserve Marines.³¹⁹ Second, the U.S. Marine Corps's statute provides protection for merely four marks: the "seal, emblem, name, [and] initials of the United States Marine Corps."³²⁰ However, the U.S. Army's SSIs and DUIs number in the hundreds.³²¹ Finally, the U.S. Army has more Soldiers in more locations around the world than the U.S. Marine Corps.³²²

³¹⁷ Compare the Marine Corp's special statute, 10 U.S.C. § 7881, with the Coast Guard's:

No individual, association, partnership, or corporation shall, without authority of the Commandant, use the combination of letters "USCG" or "USCGR", the words "Coast Guard," "United States Coast Guard," "Coast Guard Reserve," "United States Coast Guard Reserve," "Coast Guard Auxiliary," "United States Coast Guard Auxiliary," "Lighthouse Service," "Life Saving Service," or any combination or variation of such letters or words alone or with other letters or words, as the name under which he or it shall do business, for the purpose of trade, or by way of advertisement to induce the effect of leading the public to believe that any such individual, association, partnership, or corporation has any connection with the Coast Guard. No individual, association, partnership, or corporation shall falsely advertise, or otherwise represent falsely by any device whatsoever, that any project or business in which he or it is engaged, or product which he or it manufactures, deals in, or sells, has been in any way endorsed, authorized, or approved by the Coast Guard. Every person violating this section shall be fined not more than \$1,000, or imprisoned not more than one year, or both.

Coast Guard [and other names], 14 U.S.C. § 639 (2006).

³¹⁸ Mr. Chafin believes that U.S. Army trademarks were not a high-visibility issue to Army leadership at the times Congress enacted the other special statutes. Chafin Interview, *supra* note 95.

³¹⁹ Compare the U.S. Army's demographics, Army G-1 Human Resources, <http://www.armyg1.army.mil/hr/docs/demographics/FY08%20Army%20Profile.pdf> (last visited Jan. 31, 2010) (reporting 1,097,050 Soldiers as of September, 2008), with the U.S. Marine Corps' demographics, USMC Demographic Update, http://www.usmc-mccs.org/display_files/USMC_Demographics_Report_Dec2008.pdf (last visited Jan. 31, 2010) (reporting about 300,000 active and reserve Marines as of December, 2008).

³²⁰ Marine Corps, 10 U.S.C. § 7881(b).

³²¹ Chafin Interview, *supra* note 95.

³²² See generally Army Command Structure, <http://www.army.mil/info/organization/unitsandcommands/commandstructure/> (last visited Jan. 31, 2010).

The U.S. Army's needs a comprehensive special statute that protects its symbols with the same supplementary protections as those in existing special statutes. As demonstrated by the U.S. Marine Corps's and Department of Agriculture's statutes, Congress is willing to provide comprehensive protection to symbols of a governmental agency outside traditional trademark law as well as to branches of the U.S. Department of Defense. Mr. J. Scott Chafin, Trademark Attorney for the U.S. Army, proposes such a statute that protects all symbols of the U.S. Army concurrently with traditional trademark protection.³²³

A. Problems Alleviated by the Special Statute

Trademark law, under the Lanham Act, is too burdensome to protect all U.S. Army phrases and symbols. Protection requires that the mark be used in commerce, that the mark be registered with the USPTO that the fees be paid, and that enforcement actions have been taken.³²⁴ The proposed special statute would provide protection at a cheaper rate and enforce rights faster than trademark law. Furthermore, none of the common law pitfalls of trademark law would apply in protecting U.S. Army symbols.

Congress must pass a special statute that provides DoD and the U.S. Army exclusive ownership of all U.S. Army symbols.³²⁵ Mr. Chafin proposes the following amendment:

SEC. _____. Protection of Official Symbols, Unit Heraldry, Names, and Phrases Used by the Department of Defense and the Military Departments

(a) Subchapter II, Chapter 134, Part IV, Subtitle A, Title 10, United States Code is amended by adding the following section:

Sec. _____. Protection of Official Symbols, Unit Heraldry, Names, and Phrases.

³²³ 10 U.S.C. subch. II, ch. 134, pt. IV., subtit. A (2006) (proposed amendment).

³²⁴ 15 U.S.C. §§ 1113, 1114, 1115, 1127.

³²⁵ 10 U.S.C. subch. II, ch. 134, pt. IV., subtit. A (2006) (proposed amendment).

(a) Insignia.—The seals, emblems, official symbols, and unit heraldry prescribed by the Secretary of Defense or a Secretary of a Military Department are deemed to be insignia of the United States.

(b) Exclusive Rights.—

(1) The Department of Defense and the Military Departments shall have the exclusive rights to use:

(A) the official symbols and unit heraldry under their respective governance and control;

(B) the name “Department of Defense,” the names of all its components, and the names of all components of the Military Departments, including, but not limited to, “United States Army,” “U.S. Army,” “United States Navy,” “U.S. Navy,” “United States Marine Corps,” “U.S. Marine Corps,” “United States Air Force,” and “U.S. Air Force”;

(C) the names of the national military academies, preparatory schools, and other academic institutions governed by the Department of Defense or the Military Departments;

(D) the names of all active, reserve, or inactive military units and other components under the governance and control of the Military Departments, including the names of ships and other vessels when used in conjunction with the designation “United States Ship,” “U.S.S.,” or any variant thereof;

(E) the names historically used to identify special components under the governance and control of the Department of Defense and the Military Departments, including, but not limited to, “Green Berets,” “Special Forces,” “Delta Force,” and “Navy Seals”;

(F) recruiting and other slogans or phrases that were originated by or within the Department of Defense or the Military Departments, and have, by historical use, acquired special meaning to military personnel,

including, but not limited to, “Be All You Can Be,” “An Army of One,” “Army Strong,” “The Few, the Proud, the Marines,” and any phonetically-similar spelling of “HOOAH” and “OORAH”; and,

(G) the official and popular names of military equipment first designated by the Department of Defense or by a Military Department according to that department’s internal conventions, policies, or procedures.

(2) The exclusive rights granted under subsection (b)(1) of this section do not include the use of any of the seals, emblems, official symbols, unit heraldry, names, or phrases enumerated in subsection (a) for the purpose of:

(A) factual news reporting;

(B) other uses of a purely informational or factual nature when such uses do not suggest endorsement or approval of the Department of Defense or of a Military Department; or,

(C) a use within the performance of a theatrical or motion-picture production in a manner that does not suggest endorsement or approval of the Department of Defense or of a Military Department.

(3) All of the seals, emblems, official symbols, unit heraldry, names, and phrases described by subsection (b) may be licensed under the provisions of Section 2260 of this Title [10 U.S.C. § 2260].

(4) Nothing in this section shall be construed as a limitation upon the registration of any emblem, official symbol, unit heraldry, name, or phrase under the provisions of the Chapter 22, Title 15, United States Code (the “Trademark Act of 1946,” as amended) [15 U.S.C. §§ 1051-1141n].

(c) Protections.—(1) No person may, except with the written permission of the Secretary of Defense, the Secretary of the Military Department concerned, or their

designees, use or imitate any seal, emblem, official symbol, unit heraldry, name or phrase as described in subsection (a) and (b)(1) of this section in connection with any promotion, goods, services, domain name, or other activity, commercial or otherwise, in a manner tending to suggest that such use or imitation is approved, endorsed, or authorized by the Department of Defense or any of the Military Departments or their components.

(d) Enforcement.

(1) Whenever it appears to the Attorney General of the United States that any person is engaged in, or is about to engage in, an act or practice that constitutes or may constitute conduct prohibited by this section, the Attorney General may institute a civil proceeding in a district court in the United States to enjoin such act or practice. Such court may, at the time before final determination, enter such restraining orders or prohibitions, or take such other action as is warranted, to prevent the act, practice, or conduct.

(2) The Attorney General may impose a fine, not to exceed \$10,000 per offense, for any violation of this section.

(e) Prohibited importation.—The Secretary of Defense, the Secretary of a Military Department, or their authorized designees may register any seal, emblem, official symbol, unit heraldry, name or phrase with U.S. Customs and Border Protection for the purpose of prohibiting the importation of articles that infringe upon the exclusive rights granted under subsection (b).

(f) Definitions.—In this section: (1) “official symbol” means any flag, emblem, coat of arms, crest, logo, or other graphic device adopted by the Secretary of Defense or the Secretary of a Military Department and used to identify the Department of Defense, a Military Department, or any component under their governance; (2) “person” means any natural or juristic person; and (3) “unit heraldry” means any flag, emblem, coat of arms,

crest, insignia, or other graphic device, including any name or phrase associated therewith, as identifying any component or military unit under the governance of the Department of Defense or of a Military Department.”³²⁶

This special statute would provide supplementary protection to that offered by the Lanham Act.³²⁷ It would give the Attorney General of the United States authority to enforce the statute with a \$10,000 fine per offense.³²⁸ These additional protections would provide solutions to many of the U.S. Army’s problems in safeguarding its marks.

In gaining rights to a symbol, the U.S. Army would no longer have to conduct a search, work with the USPTO to register a symbol, wait for examination, or pay any fees.³²⁹ Although gaining rights in a single symbol can cost a few hundred dollars and can take a short as a few months, in the aggregate, hundreds of symbols can cost millions of dollars and take years to register.³³⁰ For example, “Arlington National Cemetery” only took a couple of hours to register, and the USPTO registered the mark a mere five months after filing.³³¹ Contrastingly, when the examining attorney raises a refusal or when a company files a notice to opposition, costs can skyrocket as both require considerable work.³³² The U.S. All-American Bowl, an annual all-star football game of high school seniors, provides an example where a company filed a notice to opposition.³³³ Mr. Chafin filed the following U.S. All-American Bowl symbol for registration:

³²⁶ *Id.*

³²⁷ *Id.* para. (c).

³²⁸ *Id.* para. (d).

³²⁹ For example, Woodsy Owl and Smokey Bear are trademarks registered with the USPTO, since the U.S. Code protects the symbols. 16 U.S.C. § 580p (2006).

³³⁰ Chafin Interview, *supra* note 95.

³³¹ *Id.* U.S. Trademark No. 3705316 (filed June 5, 2009).

³³² Chafin Interview, *supra* note 95.

³³³ U.S. Army All-American Bowl, http://www.usarmyallamericanbowl.com/view_press_releases.php?pressreleasesid=1852 (last visited Jan. 31, 2010).



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During opposition, the stars in the helmets garnered the attention of a certain professional football team, the Dallas Cowboys, as a potential problem.³³⁵ For those who do not follow professional football, the following is a photo of the Dallas Cowboys' helmet:



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The U.S. Army All-American Bowl symbol ultimately achieved registration status, but due to the opposition, it came at an additional expense.³³⁷

Because the special statute would not be based on the Commerce Clause, use of the symbol in commerce is no longer necessary to establish protection.³³⁸ Without the use in commerce requirement, the U.S. Army would never have to establish that it has priority in its hundreds of symbols.³³⁹ The U.S. Army would no longer have to

³³⁴ U.S. Trademark No. 3589919 (filed Jan. 15, 2008).

³³⁵ Chafin Interview, *supra* note 95.

³³⁶ Dallas Cowboys Riddell Pro Line Authentic NFL Helmet-Five Star Memorabilia, <http://www.fivestarmemorabilia.com/commerce/ccp16037-dallas-cowboys-riddell-pro-line-authentic-nfl-hel-riddadal.htm> (last visited Jan. 31, 2010).

³³⁷ Chafin Interview, *supra* note 95.

³³⁸ 15 U.S.C. § 1127 (2006).

³³⁹ To date, nobody has compiled an exhaustive list of U.S. Army symbols. Chafin Interview, *supra* note 95. However, as a conservative estimate, the Institute of Heraldry's website contains hundreds of U.S. Army symbols. *See generally* The Institute of Heraldry Home Page, http://www.tioh.hqda.pentagon.mil/DUI_SSI_

conduct the onerous steps above for every symbol. Lastly, if a new use for a symbol ever arose, the U.S. Army would not have to worry about protection, as presumptive ownership rights would cover every traditional classification.³⁴⁰

By having exclusive ownership rights in all of its symbols, the U.S. Army would not have the challenges like the “SOCOM” case. Unlike the “Hooah!” case, where issues arose when a mark changed classification,³⁴¹ under the special statute, this type of issue would never arise. The U.S. Army would own exclusive rights in the name no matter what the classification. Further, by supplementing traditional trademark law, a special statute would prevent the U.S. Army from having to prove likelihood of confusion as demonstrated in the “SOCOM” case. The U.S. Army would own all of its symbols and could immediately prevent infringing use by a third party.

Another benefit of the special statute is that it would prevent the many pitfalls of trademark law in common law doctrine. As demonstrated in the SSI and DUI examples, naked licensing could lead to abandonment of the U.S. Army’s symbols.³⁴² In the Army/Navy game example, failure to police infringement could weaken a symbol and cause abandonment.³⁴³ Dilution by tarnishment could reduce the strength of a symbol and could cause loss of ownership.³⁴⁴ Genericide could also result in loss of rights in a symbol as evidenced by the M4 case.³⁴⁵ None of these common law doctrines would apply to U.S. Army symbols as the doctrines only apply under traditional trademark law. Because the U.S. Army would never have to prove ownership or have to worry about losing the rights to its symbols, the special statute would reduce the expense and time of litigation.

COA_page.htm (last visited Jan. 30, 2010) (displaying hundreds of SSI, DUI, and other symbols).

³⁴⁰ For example, if the U.S. Army used “Army Strong” only as a motto, it could later use it on t-shirts without registering in another classification. The U.S. Army would own the motto and every conceivable use for the motto.

³⁴¹ In that case, the classification changed from an energy bar to apparel.

³⁴² *Westco Group, Inc. v. K.B. & Assocs.*, 128 F. Supp. 2d 1082, 1088 (D. Ohio 2001) (quoting *Gorenstein Enters. v. Quality Care-USA*, 874 F.2d 431, 435 (7th Cir. 1989)).

³⁴³ *Garetto*, *supra* note 264.

³⁴⁴ *Hormel Foods Corp. v. Jim Henson Prods.*, 73 F.3d 497, 507 (2d Cir. 1996) (quoting *Deere & Co. v. MTD Prods.*, 41 F.3d 39, 42 (2d Cir. 1994)).

³⁴⁵ *Colt Def. LLC v. Bushmaster Firearms, Inc.*, 486 F.3d 701, 703 (1st Cir. Me. 2007).

Along with the ownership provision, the special statute would allow for licensing³⁴⁶ and prevent unauthorized use.³⁴⁷ The special statute would also include an enforcement paragraph similar to the other U.S. Government special statutes.³⁴⁸ The special statute would allow fair use³⁴⁹ of the U.S. Army's symbols.³⁵⁰ The special statute would also provide concurrent protection to the U.S. Army's symbols with traditional trademark law by providing baseline protection to all U.S. Army phrases and symbols.³⁵¹ Then, trademark law would provide an additional layer of protection to well-known phrases and symbols that the U.S. Army uses in commerce, such as the "ARMY STRONG" motto.³⁵²

Ms. Christine Piper, intellectual property attorney for the U.S. Air Force, asserts that the proposed special statute, as applied across the whole Department of Defense, will make enforcement of rights easier.³⁵³

³⁴⁶ 10 U.S.C. subch. II, ch. 134, pt. IV., subtit. A (2006) (proposed amendment). "All of the seals, emblems, official symbols, unit heraldry, names, and phrases described by subsection (b) may be licensed under the provisions of Section 2260 of this Title [10 U.S.C. § 2260]" *Id.* The U.S. Army already uses a licensing agency, The Beanstalk Group. *See* Beanstalk Group, Beanstalk, Clients, Brand Licensing Case Studies, <http://www.beanstalk.com/ourclients/index.html> (last visited Jan. 19, 2009) (providing a list of clients).

³⁴⁷ 10 U.S.C. subch. II, ch. 134, pt. IV., subtit. A (proposed amendment).

³⁴⁸ *Id.*

³⁴⁹ Fair use is a defense under the Lanham Act that allows one to use another's mark without infringement. Lanham Act, 15 U.S.C. § 1115(b)(4) (2006).

³⁵⁰ 10 U.S.C. subch. II, ch. 134, pt. IV., subtit. A (2006) (proposed amendment).

³⁵¹ *Id.* "Nothing in this section shall be construed as a limitation upon the registration of any emblem, official symbol, unit heraldry, name, or phrase under the provisions of the Chapter 22, Title 15, United States Code (the "Trademark Act of 1946," as amended) [15 U.S.C. §§ 1051–1141n]." *Id.*

³⁵² The U.S. Army has five live registrations in the "Army Strong" motto ranging from apparel to wrist bands. U.S. Patent and Trademark Office, Trademark Electronic Search System (TESS), <http://tess2.uspto.gov/bin/gate.exe?f=searchss&state=91ukce.1.1> (search for "army strong," follow hyperlink) (last visited Jan. 17, 2009).

³⁵³ Telephone Interview with Christine Piper, Assoc. Gen. Counsel Att'y, in Chantilly, Va. (Feb. 22, 2009) [hereinafter Piper Interview on Feb. 22, 2009, in Chantilly, Va.]. Christine Piper holds the position of Associate General Counsel in the Acquisition Division, Air Force General Counsel's Office. Ms. Piper is primarily responsible for providing legal advice to Secretariat, Air Staff, Program Executive Officer and Major Command level clients concerning intellectual property and satellite system acquisition matters. She is responsible for trademark and patent licensing for the United States Air Force. Ms. Piper received a Bachelor of Arts degree from the University of Colorado, Boulder, Colorado, in 1993, a Juris Doctor degree from the University of Colorado School of Law, Boulder, Colorado, in 1996, and an Master of Laws degree from the George Washington University, Washington, D.C. in 2004. Ms. Piper previously served as an Air Force Judge Advocate from 1997 to 2008. After conferring with attorneys at the Intellectual Property Divisions of the U.S. Navy and U.S. Marine Corps, they were

Department of Defense agencies are not commercial entities focused on producing revenue.³⁵⁴ Therefore, when hundreds of companies use U.S. Air Force symbols without a license or authority, the U.S. Air Force has difficulty enforcing its rights.³⁵⁵ In enforcing its rights, U.S. Air Force intellectual property attorneys issue cease and desist letters to the infringing companies.³⁵⁶ Often, the letters do not deter the infringers, so the attorneys turn to the Department of Justice to seek an injunction against the infringing use.³⁵⁷ To date, the Department of Justice has not sought any injunctions against infringers primarily because the infringement causes no economic harm to the U.S. Air Force.³⁵⁸ However, Ms. Piper firmly believes that if a special statute protects U.S. Air Force symbols, the Department of Justice would be more enthusiastic in seeking injunctions.³⁵⁹

Ms. Piper also believes that the special statute will help U.S. Air Force attorneys police infringing uses.³⁶⁰ Without the need to register symbols, pay maintenance fees, and worry about ownership, U.S. Air Force attorneys have more time to police infringing uses of U.S. Air Force symbols.³⁶¹ When commencing a civil action, the special statute would no longer force attorneys to litigate ownership in symbols, saving time and money.³⁶² In the end, a special statute would complement common law and Lanham Act protections of Department of Defense symbols.

hesitant to make a comment on the success or make a specific opinion on the effectiveness of existing or proposed statutes. Telephone Interview with United States Navy Att’y, in Washington Navy Yard, D.C. (Feb. 22, 2009) [hereinafter Piper Interview on Feb. 22, 2009, in Wash. Navy Yard, D.C. on Feb. 22, 2009].

³⁵⁴ Piper Interview on Feb. 22, 2009, in Chantilly, Va.; Piper Interview on Feb. 22, 2009, in Wash. Navy Yard, D.C.

³⁵⁵ *Id.*

³⁵⁶ *Id.*

³⁵⁷ *Id.*

³⁵⁸ *Id.* The U.S. Air Force is primarily concerned with protecting the integrity of the U.S. Air Force’s symbols. *Id.* *But cf.* Chafin Interview, *supra* note 95 (stating that the Department of Justice has pursued two injunctions for the U.S. Army, but is weary of being inundated with countless injunctions by the DoD).

³⁵⁹ Piper Interview on Feb. 22, 2009, in Chantilly, Va., *supra* note 353; Piper Interview on Feb. 22, 2009, in Wash. Navy Yard, D.C. Piper Interview, *supra* note 353.

³⁶⁰ *Id.* The U.S. Air Force only has two intellectual property attorneys. *Id.*

³⁶¹ *Id.*

³⁶² *Id.*

B. Problems Not Alleviated by the Special Statute

The special statute would provide many solutions to the problems of trademark law; however, it is not a panacea and some challenges would still exist. The special statute would give the U.S. Army exclusive ownership rights in all of its symbols and streamline an infringement case, but would not totally eliminate litigation. No ownership issues or common law doctrines would arise, but an infringement suit that could not be settled, would still require litigation.

Along with streamlined litigation and a tougher posture from the Department of Justice towards infringers, the special statute would deter infringers. Inevitably, a determined infringer will ignore this special statute just as he would traditional trademark laws. In order to prevent unauthorized use, the U.S. Army would still have to conduct searches of infringing uses. The special statute would not prevent others from attempted infringement or innocent infringement. The U.S. Army would have to police the uses of its symbols, not to prevent loss of rights, but to enforce its rights given by the special statute. This would still require notification to cease the infringement use as well as involvement from the Department of Justice to litigate if the infringement did not cease.

Two other items need to be highlighted. Because the special statute would supplement traditional trademark law, famous U.S. Army marks would still operate under the Lanham Act. This means registration, fees, and time. Also, the special statute needs to clarify the fair use defense. It should mirror those fair use defenses already enumerated in copyright law.³⁶³ Particularly, it should allow the use for educational purposes. More importantly, for the U.S. Army, it should address use by Soldiers, especially in command briefs.³⁶⁴

VII. Conclusion

Phrases and symbols are as important to the U.S. Army as to any other corporation in America. In fact, symbols are especially important in the U.S. Army because they often communicate important

³⁶³ The Copyright Act, 17 U.S.C. §§ 107 (2006).

³⁶⁴ Many PowerPoint command briefs include unit insignia on one of the corners of the slides. From the author's experience, almost every PowerPoint command brief contains the unit's insignia.

information. On the ACU alone, a patch signifies to others what unit a Soldier deployed with; another patch signifies her current unit; another patch displays her military rank; and various badges highlight her special military skills. These symbols, combined with military-centric phrases such as “Hooah!,” shape the U.S. Army’s image to the public and heritage to the Soldiers. The phrases and symbols represent generations of time-honored traditions and values.³⁶⁵ These traditions and values are of such high importance that they require absolute protection and preservation.

Part V of this article illustrated many of the deficiencies in protecting U.S. Army phrases and symbols under the Lanham Act.³⁶⁶ While the Lanham Act provides adequate protection for marks of traditional companies, it falls woefully short of providing adequate protection to the U.S. Army’s phrases and symbols.³⁶⁷ The disparity arises from the use of the U.S. Army’s symbols as well as the goals of the U.S. Army. Although the U.S. Army is not in the business to generate profits from its phrases and symbols, it is interested in preserving its history and values through its phrases and symbols.³⁶⁸

Various cases demonstrate the problems of trying to use the Lanham Act to protect U.S. Army phrases and symbols. Most importantly, ownership problems like the ones in the “Hooah!” case demonstrate how companies have tried to claim ownership in a clearly military phrase, and, in the process, upset existing licenses.³⁶⁹ Other companies have tried to manipulate U.S. Army phrases and symbols to make the company appear to be endorsed by the U.S. Army such as SOCOM GEAR.³⁷⁰ At the most extreme end, many untested common law doctrines such as naked licensing, failure to police, dilution, and genericide could result in the U.S. Army losing control and ownership of many of its phrases and symbols all together.³⁷¹

³⁶⁵ James Memo, *supra* note 8.

³⁶⁶ *See supra* Part V and accompanying text.

³⁶⁷ *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1360 (C.C.P.A. 1973) (quoting S. REP. NO. 1333, 79th Cong., 2d Sess. (1946), *in* U.S.C.C.A.N., 79th Cong., 2d Sess. at 1274-8 (1946)).

³⁶⁸ Chafin Interview, *supra* note 214.

³⁶⁹ *See supra* Part IV and accompanying text.

³⁷⁰ *See supra* notes 239-44 and accompanying text.

³⁷¹ *See supra* Part V.C-D and accompanying text.

The U.S. Army's interest in protecting and preserving its phrases and symbols coupled with the inadequate protection under the Lanham Act require immediate supplemental protection. With the advent of computer technology, the U.S. Army needs this protection now more than ever. Digital morphing technology, for example, allows users to change military symbols. The Internet also allows businesses to mass market unlicensed products bearing U.S. Army phrases and symbols. Finally, Internet blogs allow users to improperly use U.S. Army phrases and symbols.

The obvious solution to the shortage of protection is a special statute that supplements Lanham Act protection of U.S. Army phrases and symbols. Congress has already provided supplemental protection for many governmental departments' phrases and symbols. However, nobody to date has had the opportunity, time, or support to compel Congress to pass a special statute for the U.S. Army. Now that the need for additional protection is imminent and Mr. J. Scott Chafin has proposed a special statute, Congress must pass it.

The U.S. Army does not need this protection to generate revenue; it needs this protection to preserve the U.S. Army's rich history and control its national image. A special statute will not only stop current infringers, but it will also deter future infringers. It will give total control of all past, present, or future marks to the U.S. Army and DoD. The statute may also provide an impetus for the Department of Justice to prosecute those who infringe upon the U.S. Army's exclusive rights to its phrases and symbols. Although the U.S. Army has never lost ownership in one of its phrases or symbols to a common law doctrine, the special statute will ensure that these untested doctrines never become tested. In the end, a comprehensive special statute will not only save our service marks, it will also ensure that patriotic support by Americans, in the form of yellow ribbon magnets, unit T-shirts, and military hats, will never endanger the protection of the U.S. Army's phrases and symbols.

Appendix A

This appendix reprints legal summaries from Gilson's noted trademarks, which are useful for illustrating the various common law factors used by circuits to evaluate whether one mark may be confused with another. Without a statute in place, the Army could be forced to address any one of these tests in establishing its intellectual property interests. Materials reproduced from *Gilson on Trademarks* with the permission of Matthew Bender & Company, Inc., a member of the LexisNexis group of companies.

[a] First Circuit. This court has identified eight factors to be weighed in determining likelihood of confusion:

- (1) the similarity of the marks;
- (2) the similarity of the goods;
- (3) the relationship between the parties' channels of trade;
- (4) the relationship between the parties' advertising;
- (5) the classes of prospective purchasers;
- (6) evidence of actual confusion;
- (7) the defendant's intent in adopting its mark; and
- (8) the strength of the plaintiff's mark

. . . .

. . . [b] Second Circuit — The *Polaroid* Factors. In a landmark decision, *Polaroid Corporation v. Polarad Electronics Corporation*, the Second Circuit set forth the following factors to determine whether there is trademark infringement:

- (1) the strength of [plaintiff's] mark,
- (2) the degree of similarity between the two marks,
- (3) the proximity of the products,
- (4) the likelihood that the prior owner will bridge the gap,
- (5) actual confusion,
- (6) the reciprocal of defendant's good faith in adopting its own mark,
- (7) the quality of defendant's product,
- (8) and the sophistication of the buyers

....

... [c] Third Circuit — The *Lapp* or *Scott Paper* Factors. The likelihood of confusion analysis in the Third Circuit may include the evaluation of a number of factors, derived from the *Lapp* and *Scott Paper* decisions:

- (1) the degree of similarity between the owner's mark and the alleged infringing mark;
- (2) the strength of the owner's mark;
- (3) the price of the goods and other factors indicative of the care and attention expected of consumers when making a purchase;
- (4) the length of time defendant has used the mark without evidence of actual confusion arising;
- (5) the intent of the defendant in adopting the mark;
- (6) the evidence of actual confusion;
- (7) whether the goods, though not competing, are marketed through the same channels of trade and advertised through the same media;
- (8) the extent to which the targets of the parties' sales efforts are the same;
- (9) the relationship of the goods in the minds of the public because of the similarity of function;
- (10) other facts suggesting that the consuming public might expect the prior owner to expand into the defendant's market

....

... [d] Fourth Circuit — The *Pizzeria Uno* Factors. To determine whether there is a likelihood of confusion, the Fourth Circuit generally considers a number of factors:

- (1) the strength or distinctiveness of the mark;
- (2) the similarity of the two marks;
- (3) the similarity of the goods/services the marks identify;
- (4) the similarity of the facilities the two parties use in their businesses;
- (5) the similarity of the advertising used by the two parties;

(6) the defendant's intent;

(7) actual confusion.

Two later cases added the following factors:

(8) the proximity of the products as they are actually sold;

(9) the probability that the senior mark owner will "bridge the gap" by entering the defendant's market;

(10) the quality of the defendant's product in relationship to the quality of the senior mark owner's product; and

(11) the sophistication of the buyers

. . . .

. . . [e] Fifth Circuit. In determining whether a likelihood of confusion exists, the Fifth Circuit considers the following list of factors:

(1) the type of mark allegedly infringed,

(2) the similarity between the two marks,

(3) the similarity of the products or services,

(4) the identity of the retail outlets and purchasers,

(5) the identity of the advertising media used,

(6) the defendant's intent, and

(7) any evidence of actual confusion

. . . .

. . . [f] Sixth Circuit — The *Frisch* Factors. The Sixth Circuit has identified eight factors as informing the likelihood of confusion inquiry:

(1) strength of the plaintiff's mark,

(2) relatedness of the goods,

(3) similarity of the marks,

(4) evidence of actual confusion,

(5) marketing channels used,

(6) likely degree of purchaser care,

(7) defendant's intent in selecting the mark, and

(8) likelihood of expansion of the product lines

. . . .

. . . [g] Seventh Circuit. Seven factors comprise the likelihood of confusion analysis in the Seventh Circuit:

- (1) similarity between the marks in appearance and suggestion;
- (2) similarity of the products;
- (3) the area and manner of concurrent use;
- (4) the degree of care likely to be exercised by consumers;
- (5) the strength of the plaintiff's mark;
- (6) whether actual confusion exists; and
- (7) whether the defendant intended to "palm off" his product as that of the plaintiff

. . . .

. . . [h] Eighth Circuit — The *Squirtco* Factors. The Eighth Circuit examines factors including:

- (1) the strength of the owner's mark;
- (2) the similarity of the owner's mark to the alleged infringer's mark;
- (3) the degree to which the products compete with each other;
- (4) the alleged infringer's intent to "pass off" its goods as those of the trademark owner;
- (5) incidents of actual confusion; and
- (6) the type of product, its costs and conditions of purchase

. . . .

. . . [i] Ninth Circuit — The *Sleekcraft* Factors. In determining whether confusion between goods is likely, the Ninth Circuit currently looks to the following factors:

- (1) strength of the mark;
- (2) proximity of the goods;
- (3) similarity of the marks;
- (4) evidence of actual confusion;
- (5) marketing channels used;
- (6) type of goods and the degree of care likely to be exercised by the purchaser;

- (7) defendant's intent in selecting the mark; and
- (8) likelihood of expansion of the product lines

. . . .

. . . [j] Tenth Circuit. When determining whether there is a likelihood of confusion between two trademarks, the Tenth Circuit considers the following factors:

- (1) the degree of similarity between the marks;
- (2) the intent of the alleged infringer in adopting its mark;
- (3) the relation in use and the manner of marketing between the goods or services marketed by the competing parties;
- (4) the degree of care likely to be exercised by purchasers;
- (5) evidence of actual confusion; and
- (6) the strength or weakness of the marks

. . . .

. . . [k] Eleventh Circuit. Courts in this circuit may consider the following factors in assessing the likelihood of consumer confusion in Lanham Act trademark claims:

- (1) the strength of the plaintiff's mark;
- (2) the similarity between the plaintiff's mark and the allegedly infringing mark;
- (3) the similarity between the products and services offered by the plaintiff and defendant;
- (4) the similarity of the sales method;
- (5) the similarity of advertising methods;
- (6) the defendant's intent, *e.g.*, does the defendant hope to gain competitive advantage by associating his product with the plaintiff's established mark; and
- (7) actual confusion

. . . .

. . . [l] Federal Circuit — The *du Pont* Factors. When the Federal Circuit reviews a decision of the Trademark Trial and Appeal Board that involves likelihood of

confusion, it follows the *du Pont* factors laid out by its predecessor, the Court of Customs and Patent Appeals:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
- (3) The similarity or dissimilarity of established, likely to continue trade channels.
- (4) The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.
- (5) The fame of the prior mark (sales, advertising, length of use).
- (6) The number and nature of similar marks in use on similar goods.
- (7) The nature and extent of any actual confusion.
- (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
- (9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).
- (10) The market interface between applicant and the owner of a prior mark:
 - (a) a mere "consent" to register or use.
 - (b) agreement provisions designed to preclude confusion, i.e. limitations on continued use of the marks by each party.
 - (c) assignment of mark, application, registration and good will of the related business.
 - (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.
- (11) The extent to which applicant has a right to exclude others from use of its mark on its goods.
- (12) The extent of potential confusion, i.e., whether de minimis or substantial.
- (13) Any other established fact probative of the effect of use

....

... [m] District of Columbia Circuit. In a 1990 opinion, the District of Columbia Circuit noted that the Second Circuit's list of factors in the *Polaroid* case was "the standard test for mark infringement under the [Lanham] Act." Lower courts in the D.C. Circuit have followed this brief mention and use the *Polaroid* factors in analyzing likelihood of confusion. One district court has noted that "not all of these factors need be present in every case."

[n] Trademark Trial and Appeal Board. The T.T.A.B. and the USPTO's examining attorneys follow Federal Circuit precedent and consider the *du Pont* factors in determining likelihood of confusion.³⁷²

³⁷² 5-5 GILSON, *supra* note 63, at 5.02 (citations omitted). Materials reproduced from Gilson on Trademarks with the permission of Matthew Bender & Company, Inc., a member of the LexisNexis Group of companies.

Appendix B



The Armor School patch³⁷³



The Infantry School patch³⁷⁴

³⁷³ US Military Stuff, <http://www.usmilitarystuff.com/images/Armor%20School%20with%20tab%20Color.jpg> (last visited Jan. 14, 2009).

³⁷⁴ US Military Stuff, <http://www.usmilitarystuff.com/images/Infantry%20School%20Color.jpg> (last visited Jan. 14, 2009).



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The shape . . . is an inversion of the Follow Me shield. It represents a spearhead and is reminiscent of the triangular shape of the Armor patch

. . . .

. . . The lightning bolt, symbolizing the power and speed of the Armor branch, and the Infantry bayonet are crossed in the center of the patch

. . . .

. . . The five-sided section at the bottom of the patch signifies the Pentagon, from which the two branches project. It is red to symbolize sacrifice. A star at the top was added by The Institute of Heraldry to designate Fort Benning as a center of excellence.³⁷⁶

³⁷⁵ Rodewig, *supra* note 221.

³⁷⁶ *Id.*

Appendix C

West Point TM table³⁷⁷United States Military Academy
at West Point, New York
Trademark Management Program

The Institutional Names and Identifying Marks of the United States Military Academy (USMA) at West Point, which are registered with the United States Patent & Trademark Office and/or protected under common law, are the exclusive property of the United States Army. The logos, marks, and verbiage identified in this Appendix cannot be used without express, written permission from the Licensing Director and/or a licensing agreement with the Collegiate Licensing Company.

Institutional Names

- West Point®
- United States Military Academy®
- U.S. Military Academy™
- USMA®
- Army®
- United States Military Academy Preparatory School™
- West Point Association of Graduates™

Institutional Verbiage

- Duty, Honor, Country™
- Long Gray Line™
- All for the Corps™
- Black Knights®
- Army Black Knights®
- West Point Prep Black Knights™



"West Point Crest"



"Athena Helmet"



"Black Knight - Cape Man"



"Black Knight - Horseman"



"Black Knight - Helmets"



"Army Sword"



"Swiss A"



"Kicking Mule"

*Intercollegiate Athletics*

- Army/West Point Baseball™
- Army Basketball®
- West Point Basketball™
- Army/West Point Cross Country™
- Army Football®
- West Point Football™
- Army/West Point Golf™
- Army/West Point Gymnastics™
- Army/West Point Hockey™
- Army/West Point Lacrosse™
- Army/West Point Rifle™
- Army/West Point Rabble Rousers™
- Army/West Point Soccer™
- Army/West Point Softball™
- Army/West Point Sprint Football™
- Army/West Point Swimming™
- Army/West Point Tennis™
- Army/West Point Track & Field™
- Army/West Point Volleyball™
- Army/West Point Wrestling™

Colors

- Army Black (Pantone Process Black)
- Army Gold (Pantone 465)
- Army Gray (Pantone Cool Gray 5)

³⁷⁷ United States Military Academy, http://www.westpoint.edu/trademark/TM_Inst_Names_Marks.ppt (last visited Jan. 16, 2009).

Appendix D



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³⁷⁸ Sporty's Home Page, http://www.sportys-catalogs.com/acb/showdet1.cfm?&DID=99&CATID=1&Product_ID=2210&count=12&Pcount=36&DETAIL=1 (last visited Jan. 14, 2009).



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³⁷⁹ Army Surplus World, http://www.armysurplusworld.com/customs/photos/airborne_tshirtdeathfromabovebi.JPG (last visited Jan. 14, 2009).

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