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TRADE MARK LAW AS A NORMATIVE PROJECT

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Trade mark law is motivated in part by the goal of protecting certain consumer understandings. But courts typically treat such consumer understanding as a pre-determined, relatively fixed, fact to which the template of trade mark law can be applied and from which answers to the relevant legal questions thus inevitably flow. Prof Dinwoodie challenges this approach as descriptively incomplete and prescriptively harmful. He argues that trade mark law should be less fixated on ascertaining, acting upon, and declaring, empirical realities of consumer association and confusion. Instead, courts need more openly – and more fully – to understand trade mark law as a normative project. In this climate, efforts to enhance the quality of factual input to particular trade mark disputes should be a lower priority for trade mark law. And, if over-emphasised in ways that downplay the normative character of trade mark law, such well-intentioned efforts at improved empiricism may even be counterproductive.

Trade mark law is becoming overly concerned with discerning, and validating, the detailed reality of consumer understandings – often without contemplating, or even at the expense of, competing normative concerns. The US Supreme Court's recent decision to uphold the registration of the mark "BOOKING.COM" for travel reservation services because the court refused to discount evidence of actual consumer perception has served to illustrate this problem.[1] But the phenomenon, which I will

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[1] *US Patent and Trademark Office v Booking.com BV* 140 S Ct 2298 (2020) [*Booking.com*].

label as an "empirical" approach to trade mark law,[2] long pre-dates the *Booking.com* decision.[3]

In this Lecture, I want to express some caution about this fetish of empiricism.[4] I will argue that trade mark law should be less fixated on ascertaining, acting upon, and declaring empirical realities of consumer association and confusion. Instead, courts need more openly – and more fully – to understand trade mark as a normative project. Here, I use the term "normative" to encompass approaches that seek not simply to reflect consumer understanding, but also in part to shape it or to achieve policy goals beyond validating that understanding (such as promoting competition or freedom of expression, enhancing consumer choice, or upholding commercial ethics).[5]

Some trade mark doctrines do acknowledge and take explicit account of broader normative concerns. But too often that feature of trade mark law is hidden from view, with attendant costs on the proper development of well-rounded legal principles. The nature of this concealment affects the precise costs that are incurred. When the normative concern is unstated, a lack of transparency ensues; when it is entirely unaddressed, the development of a body of law applicable to an increasingly broad suite of social and commercial activities is impoverished.[6] Thus, a priority of contemporary trade mark law should be to elevate and highlight its normative aspect, a course quite at odds with the approach of the Supreme Court in *Booking.com*. And in this climate, efforts to enhance the quality of factual input to particular trade mark disputes ought to be a lesser priority. Indeed, if over-emphasised in ways that

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2 See Barton Beebe *et al*, "Consumer Uncertainty in Trademark Law: An Experimental Investigation" (2023) 72 Emory LJ 489 at 491 [Beebe *et al*, "Consumer Uncertainty"] ("What do consumers believe? That is the deceptively simple question on which nearly every important issue in trademark litigation turns."). The preservation of existing consumer understanding might be viewed as the core *normative* concern of trade mark law. See Senate Report No 1333, 79th Congress, 2d Session 3 (1946) [S Rep No 1333]. At the very least, pursuing that objective reflects some normative choices. See text accompanying notes 46–69, 76–83. But as I will discuss below, it is often presented as normatively neutral, requiring courts to undertake an entirely empirical mission.

3 *Cf* Felix S Cohen, "Transcendental Nonsense and the Functional Approach" (1935) 35(6) Colum L Rev 809 at 816 (critiquing the "theory that judicial decisions in the field of unfair competition law are merely recognitions of a supernatural Something that is immanent in certain trade names and symbols …").

4 *Cf Libman Co v Vining Industries, Inc* 69 F 3d 1360 (7th Cir, 1995) ("We do not want to make a fetish of testimony …") (Posner J).

5 Beyond the confines of North American legal scholarship, the label "normative" is used sometimes to mean both *establishing* a norm and *deriving from* a norm. See, *eg*, Google Oxford Languages ("*normative*: *adj.* establishing, relating to, or deriving from a standard or norm, especially of behavior"). For purposes of this Article, I lean towards the former meaning, which overlaps to some extent with the "proactive" concept discussed in my prior work. See Graeme B Dinwoodie, "Trademarks and Territory: Detaching Trademark Law from the Nation State" (2004) 41(3) Hous L Rev 885 at 889–890 [Dinwoodie, "Trademarks and Territory"] (distinguishing between rules that are "proactive" in establishing norms, and those that are "reactive" to existing patterns of behavior, and describing as "proactive" an approach to trade mark law which "proactively seek[s] to shape the ways in which consumers shop and producers sell or seek to acquire rights, thus shaping how the economy functions"). But a normative approach to trade mark law could also validate existing norms, albeit a range broader than the unqualified preservation of consumer understanding.

6 See text accompanying notes 139–145 and 171–182.

downplay the normative character of trade mark law, such well-intentioned efforts at improved empiricism may even be counterproductive.

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In a scene in *The Invention of Love*, the wonderful play by Sir Tom Stoppard, the play's protagonist, the poet (and former Patent Office clerk) AE Houseman is regaling Oscar Wilde with the story of a young man shooting himself dead in the wake of Wilde's infamous trial for gross indecency. Houseman explains that he had read the disquieting details of the suicide in a report in the *Evening Standard* about the inquest into the young man's death. Wilde retorts "Oh, thank goodness! That explains why I never believed a word of it." Houseman protests to Wilde: "But it's all true", to which Wilde responds "On the contrary, it's only fact. Truth is quite another thing and is the work of the imagination."[7]

Empirically demonstrated reality about consumer understanding provides some of the facts on which trade mark law must operate, but it does not supply us with the whole truth (or a complete set of possible truths) about trade marks. That is the work of a normative project. And there is a risk that supposed facts can crowd out the truth.

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Of course, I could not seriously suggest that trade mark law have no regard for reality. The dominant justification for trade mark law is firmly grounded in certain core empirical assessments. Trade mark law is largely motivated by the goal of protecting understandings that consumers have developed regarding the source or quality of goods or services.[8] In effectuating that goal, it becomes crucial to determine the associations that consumers develop with respect to symbols for which trade mark protection is claimed, as well as consumer reaction to unauthorised uses of those or similar symbols by third parties.

Unless the claimed mark functions (or will function) for consumers to identify the source of goods or services of one trader and distinguish them from those of other traders, there is no consumer understanding or meaning to protect.[9] To put it another way, in such circumstances, there is no mark. That fact crucially matters.

Likewise, even if a mark exists, unless any challenged third-party uses are likely to disturb the consumer understandings represented by the mark, those third-party uses should be permitted because they do not implicate the purposes of trade mark law. That fact, traditionally determined by whether the defendant's use causes a likelihood of confusion, also critically matters.[10]

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7 Tom Stoppard, *The Invention of Love* (London: Faber and Faber, 1997) at 95–96.

8 S Rep No 1333, *supra* note 2 at 3.

9 See Graeme B Dinwoodie, "Reconceptualizing the Inherent Distinctiveness of Product Design Trade Dress" (1997) 75(2) NCL Rev 471 at 483 [Dinwoodie, "Reconceptualizing Inherent Distinctiveness"] ("For [the] basic concerns of trademark law to be aroused, consumers must first associate the mark with a specific source").

10 The availability of federal protection against dilution, which is not a confusion-based claim, does not alter the basic proposition that only third-party uses that are likely to disturb consumer understandings warrant interdiction. Blurring turns on a diminution in the distinctiveness of a mark, see

This is a rather simple, if conventional, account of trade mark law. In fact, regulation of trade marks implicates a far more complex set of concerns than the protection of consumer understanding.[11] But even this simple statement of the purpose and remit of trade mark law begs many questions, which only become more difficult as we move beyond core cases.

These questions fall into two basic groups. First, because trade mark law does not seek to prevent all forms of confusion, the consumer protection rationale presents a series of essentially normative questions regarding the nature and level of confusion that should be actionable, along with questions about the forms of consumer understanding that are properly protected against such confusion.[12]

Once those normative choices are made, trade mark law confronts a second set of questions. On their face, these are more positivistic dilemmas: how to determine consumer reaction to a symbol used purportedly to mark goods (the question of protectability, or distinctiveness) and how to determine the effect of unauthorised third-party use of that symbol (the question of infringement, classically involving assessment of the likelihood of confusion).

These latter inquiries have the appearance of purely empirical assessments. Courts in trade mark cases devote substantial time developing detailed doctrinal rules (and evidentiary and procedural devices) designed to facilitate this second set of empirical inquiries. For example, how do you establish that a mark is distinctive?[13] What evidence circumstantially supports a claim of acquired distinctiveness?[14] How do

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15 USC § 1125(c)(2)(B) (1999), and tarnishment, while definitionally tied to reputational harm, see 15 USC § 1125(c)(2)(C), can be conceptualised as a subset of blurring. See *Ty Inc v Perryman* 306 F 3d 509 at 511 (7th Cir, 2002) (Posner J) [*Ty v Perryman*].

[11] See generally Michael S Mireles Jr, "Towards Recognizing and Reconciling the Multiplicity of Values and Interests in Trademark Law" (2011) 44(2) Ind L Rev 427; see text accompanying notes 171–182.

[12] See text accompanying notes 17–20, 76–83.

[13] See, *eg*, *Abercrombie & Fitch Co v Hunting World, Inc* 537 F 2d 4 (2nd Cir, 1976) [*Abercrombie*] (developing spectrum based on history of word mark cases); *Amazing Spaces, Inc v Metro Mini Storage* 608 F 3d 225 (5th Cir, 2010) (logo marks separately assessed under *Seabrook* test); *Wal-Mart Stores, Inc v Samara Bros* 529 US 205 (2000) [*Samara*] (limiting means of proving distinctiveness of product design – by requiring secondary meaning – but not imposing same rules on packaging or *tertium quid*); *In re Forney Industries, Inc* 955 F 3d 940 (Fed Cir, 2020) (multi-color mark on packaging was capable of being inherently distinctive and not subject to *Samara* or *Qualitex* constraints); *In re Chippendales USA, Inc* 96 USPQ2d 1681 at 1687 (Fed Cir, 2010) (*service* trade dress *can* be inherently distinctive, applying alternative *Seabrook* test); see also Mark A Lemley & Mark P McKenna, "Trademark Spaces and Trademark Law's Hidden Step Zero" (2023) 75 Stan L Rev 1 [Lemley & McKenna, "Trademark Spaces"] (proposing further doctrinal refinements post-*Samara* to reflect PTO practices and take into account whether the mark is found in "trademark spaces" where consumers are likely to expect a mark).

[14] See generally Jeanne C Fromer, "Against Secondary Meaning" (2022) 98 Notre Dame L Rev 211 [Fromer, "Against Secondary Meaning"]; see also *Booking.com BV v Matal* 278 F Supp 3d 891 (ED Va, 2017) (taking account of social media statistics) [*Booking.com* district court]; *In re Steelbuilding.com* 415 F 3d 1293 (Fed Cir, 2005) (Linn J, concurring in part and dissenting in part) (discussing role of number of distinct users accessing webpages); Restatement (Third) of Unfair Competition (US: American Law Institute, 1995) at § 13, Comment (e) [Restatement of Unfair Competition] (discussing relevance of intentional copying to secondary meaning assessment).

you show likely confusion?[15] In what circumstances will a survey of consumers be permitted or required to make out such a claim?[16]

Courts more rarely discuss the antecedent and underlying normative questions upon which the empirical inquiries are based. For example, to what extent should trade marks offer control of markets into which mark owners might, but have not yet, expanded?[17] Should that answer vary as between new product markets and new geographic markets?[18] Should we adopt rules that discourage use of product design (rather than word marks) to differentiate products in the marketplace?[19] About what associations between two products must consumers be confused before trade mark law needs to intervene?[20]

It is virtually impossible to engage intelligently with the core empirical questions that drive trade mark law, and to develop doctrine designed to answer those questions, without prior consideration of the normative underpinnings. You need to know *what* you are measuring – and *why* – before you devise rules for doing so. And judicial silence about the antecedent normative questions means that the courts' unavoidable normative choices are wrapped up – and sometimes hidden – in the rules that are designed to facilitate supposedly empirical determinations.

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Of course, courts framing trade mark law to focus on ostensibly empirical questions might, to some extent, simply reflect judicial deference to the role and authority of legislators.[21] But this account should have less explanatory force in US trade mark

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[15] See generally Barton Beebe, "An Empirical Study of the Multifactor Tests for Trademark Infringement" (2006) 94 Cal L Rev 1581 [Beebe, "Empirical Study of Multifactor Tests"].

[16] Compare *Libman Co v Vining Industries, Inc* 69 F 3d 1360 at 1363 (7th Cir, 1995) (survey is best evidence of actual confusion) with *Wreal, LLC v Amazon.com, Inc* 38 F 4th 114 at 140 (11th Cir, 2022) ["*Wreal*"] ("in our circuit, survey evidence in trademark actions has always been viewed with a skeptical eye"); see also Beebe, "Empirical Study of Multifactor Tests", *supra* note 15 at 1622 ("survey evidence, thought by many to be highly influential, is in practice of little importance").

[17] Mark A Lemley & Mark P McKenna, "Owning Mark(et)s" (2010) 109 Mich L Rev 137; see also *Scarves by Vera, Inc v Todo Imports Ltd* 544 F 2d 1167 (2nd Cir, 1976) ("bridging the gap" factor relevant to scope). For example, the purposes for which related markets are preserved to a mark owner affects the evidence that would be relevant to a confusion claim against an unauthorised junior user in the related market. *Cf Westchester Media v PRL USA Holdings, Inc* 214 F 3d 658 (5th Cir, 2000) (consumer perception versus producer intent).

[18] See generally Derek Bambauer & Robert W Woods, "Tea and Donuts" (2023) 107 Minn L Rev 1875; *cf Weiner King, Inc v Wiener King Corp* 615 F 2d 512 (CCPA, 1980) (affording junior user concurrent user registration for most of the US where there is long period of non-expansion by senior user).

[19] Mark P McKenna & Caitlin P Canahai, "The Case Against Product Configuration Trade Dress" in Graeme B Dinwoodie & Mark D Janis, eds, *Trademark Law and Theory: Reform of Trademark Law* (UK: Edward Elgar Publishing, 2021) 137; *cf Samara*, *supra* note 13 at 214; *Qualitex Co v Jacobson Products Co* 514 US 159 at 173 (1995) [*Qualitex*] (noting difficulties of relying on word or logo mark).

[20] Stacey L Dogan & Mark A Lemley, "The Merchandising Right: Fragile Theory or Fait Accompli?" (2005) 54(1) Emory LJ 461 [Dogan & Lemley, "The Merchandising Right"]. *Cf Pennsylvania State University v Vintage Brand, LLC* 614 F Supp 3d 101 at 111 (MD Pa, 2022) (in college sports merchandising case, suggesting important contrast between "whether consumers tie the symbol to the trademark holder [and] whether they tie the product to the trademark holder").

[21] At the very least, one might expect a more or less explicitly normative approach from courts, legislators, scholars and administrative offices (such as the Patent and Trademark Office or "PTO") respectively.

law. The Lanham Act[22] is commonly understood as a form of delegating statute, where legislatures recognise that they function together with courts in a lawmaking partnership.[23] This perception of lawmaking authority allows US courts substantial latitude for ongoing recalibration of trade mark law.[24]

Yet, in several respects US courts purport to develop trade mark law and decide trade mark cases in the "reactive" manner I have just described.[25] They often treat consumer understanding as a relatively fixed – and empirically determinable – fact to which a neutral template of trade mark law can be applied and from which answers to the core legal questions of consumer association and likely confusion ineluctably flow.

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In this Lecture, I will argue that this conception of trade mark law is descriptively incomplete and the approach that it fosters in courts is prescriptively harmful. Portraying decision-making as nothing more than empirical assessments can mask important normative choices that courts are making about trade mark law.[26] And this form of trade mark decision-making limits proper and necessary debate about the nature and scope of trade mark law, resulting in sub-optimal outcomes.

There are some contexts in which US trade mark law already allows account to be taken of normative concerns along with empirical reality.[27] There should be more explicit and more extensive engagement with these normative concerns.[28] In

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Each plays a different role in the development and operation of the trade mark system. Each is subject to varied pressures of legitimacy and efficiency, and each institution also has as its disposal distinct capacity and resources to make empirical assessments and weigh normative concerns.

22 15 USC §§ 1051–1141n.

23 Pierre N Leval, "Trademark: Champion of Free Speech" (2004) 27(2) Colum J L & Arts 187 at 198.

24 Some scholars have suggested that broader changes in judicial methodologies may undermine the role of federal courts in such a trade mark "law-making" partnership. See Michael Grynberg, "Things Are Worse Than We Think: Trademark Defenses in a Formalist Age" (2009) 24(2) BTLJ 897. Certainly, the approach of the current majority of the US Supreme Court (at times encouraged by advocates alert to the court's mindset) might narrow latitude for judicial lawmaking, or at least frame the ways in which judicial innovation can occur. For example, the court's recent decision in *Jack Daniel's Properties, Inc v VIP Products LLC* 143 S Ct 1578 (2023) [*Jack Daniel's*], appeared in advance to be in substance a referendum on the *Rogers* test developed by the lower courts to mediate the uses of marks in artistic or expressive contexts. See text accompanying notes 183–189. But the briefs filed by the parties and several *amici* appeared to recognise that the outcome of that question might turn to some extent on whether the Lanham Act is seen a comprehensive statutory text whose language dictates the applicable test or whether it leaves room for judicial innovations to ensure an appropriate balance of competing interests. The court decided the case narrowly. See *infra* text accompanying notes 190–198. But this latter question bubbled beneath the surface in the opinions handed down by the court. See *Jack Daniel's* at 1594 (Gorsuch J, concurring) ("we necessarily leave much about *Rogers* unaddressed. For example, it is not entirely clear where the *Rogers* test comes from—is it commanded by the First Amendment, or is it merely gloss on the Lanham Act, perhaps inspired by constitutional-avoidance doctrine?").

25 Dinwoodie, "Trademarks and Territory", *supra* note 5 at 889–890 (coining the term "reactive" to describe an approach to trade mark law that purports simply to protect whatever consumer understandings or producer goodwill develops).

26 See text accompanying notes 46–48, 76–82.

27 See text accompanying notes 46–69.

28 See text accompanying notes 162–189.

this regard, the Supreme Court decision in *Booking.com* is unhelpful because it purports to make the entire question of protectability a purely empirical assessment.[29] Despite this, I will conclude more optimistically by suggesting some developments that may provide room for a more normative approach to trade mark law.[30]

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My discussion will focus on *US* trade mark law. Some of what I will describe is arguably driven by the commitment of the US system to use-based rights. In theory, the US trade mark system can be described as a formalised system of common law passing off protection legislatively overlaid with national acquisition and enforcement mechanisms.[31] And in countries where the common law passing off claim still co-exists with now-dominant trade mark registration models, the passing off cause of action will typically be the claim more grounded in empirical reality.[32]

Of course, in practice, some modern US doctrines display an ambivalence towards the theoretical model I have just depicted.[33] But the US system contains sufficient important remnants of that model to make it closer to a use-based regime than one will see in other common law countries such as the UK (or Singapore) where registration now structures trade mark rights.

In a registration-based system, analysis of distinctiveness and likely confusion is more likely to be notional. It has to be thus, because marks often have not been used and so there is no (or less) reality to be interrogated.[34] Notional assessments can be viewed simply as forward-looking predictions, grounded in the realities of the broader marketplace even if they cannot have regard to the specific, *demonstrated* realities of *the particular* marks.[35] But that type of analysis gives more space for normative judgments because such judgments are less apt to be crowded out by the rhetorical weight of specific empirical reality.

So, one might ask whether there is any universality to the features of US trade mark law I will describe.[36] There is far more commonality to systems throughout

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29 See text accompanying notes 122–139.

30 See text accompanying notes 199–219.

31 Robert C Denicola, "Some Thoughts on the Dynamics of Federal Trademark Legislation and the Trademark Dilution Act of 1995" (1996) 59(2) Law & Contemp Probs 75 at 79–80 ("Putting aside statutory innovations directly linked to the public notice provided by the Act's registration system, the Lanham Act codifie[d] the basic common law principles governing both the subject matter and scope of protection"); *Inwood Laboratories, Inc v Ives Laboratories, Inc* 456 US 844 at 861 n 2 (1982) (White J, concurring) (noting that the purpose of the Lanham Act was "to codify and unify the common law of unfair competition and trademark protection").

32 Graeme B Dinwoodie & Dev S Gangjee, "The Image of the Consumer in European Trade Mark Law" in Dorota Leczykiewicz & Stephen Weatherill, eds, *The Image(s) of the Consumer in EU Law: Legislation, Free Movement and Competition Law* (Oxford: Hart Publishing, 2015) 339 at 362–363 (discussing UK law). For Singapore, see *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 [*Staywell*]; *Novelty Pte Ltd v Amanresorts Ltd* [2009] 3 SLR(R) 216.

33 Rebecca Tushnet, "Registering Disagreement: Registration in Modern American Trademark Law" (2017) 130(3) Harv L Rev at 867 [Tushnet, "Registering Disagreement"].

34 *Reed Executive v Reed Business Information* [2004] EWCA Civ 159.

35 Dinwoodie & Gangjee, *supra* note 32 at 347, 358; see also *Staywell*, *supra* note 32 at [56], [60]–[62].

36 The phenomenon is also relevant beyond the US but may play out differently in different systems, in part because of the character of the trade mark regime and in part due to the national judicial culture.

the world than is often assumed from the labels we attach to supposedly divergent regimes. As Sir Robin Jacob observed while sitting as a High Court judge a quarter century ago in *Philips v Remington Consumer Products*, "some matters are basic to any rational law of trade marks".[37] But that is a question for another day.[38]

I. The Core Doctrinal Enquiries: Hidden Normative Choices

Let me turn now to two fundamental doctrinal enquiries of trade mark law: distinctiveness and likely confusion. Although these are commonly framed as empirical inquiries, normative choices are often present in the way courts approach those assessments.[39] This is inevitable and appropriate.

A. *Distinctiveness*

For almost a half century, US courts have employed the so-called *Abercrombie* spectrum to determine the inherent distinctiveness of marks.[40] Under *Abercrombie*, a mark will be regarded as inherently distinctive if it is "arbitrary", "fanciful" or "suggestive" in relation to the goods upon which it is affixed. No empirical proof of actual consumer association is demanded of inherently distinctive marks. Think "NIKE" for athletic shoes or "OMEGA" for watches: these marks are clearly inherently distinctive.

Marks classified as "descriptive" of the goods are not inherently distinctive and can be protected only upon proof that they have actually acquired distinctiveness (or secondary meaning) in the minds of consumers.[41] That is, as a result of use of the mark, consumers must have come to associate the term with a specific source.[42]

Generic terms can never be protected as trade marks.[43] In trade mark law, a generic term identifies the type of product on which it is used rather than the producer of the product.[44] Imagine an attempt to register "glasses" for the product commonly worn to improve eyesight, or "mask" for the ubiquitous products covering everyone's nose and mouth to ward off germs since 2020. Both of these terms would be unprotectable as marks for the products in question because they are generic.

See Dinwoodie & Gangjee, *supra* note 32 (discussing EU law); see also *supra* note 24.

37 [1998] ETMR 124 (Jacob J).

38 *Cf* Graeme B Dinwoodie, "Ensuring Consumers 'Get What They Want': The Role of Trade Mark Law" 82 Cambridge LJ (forthcoming, 2023).

39 See text accompanying notes 46–82.

40 *Abercrombie*, *supra* note 13.

41 Sidney A Diamond, "Untangling the Confusion in Trademark Terminology" (1983) 73 Trademark Rep 290 at 293 ("[T]o 'acquire a secondary meaning' is the same as to 'become distinctive'"); see also 15 USC § 1052(f).

42 Restatement of Unfair Competition, *supra* note 14 at § 13, Comment (e).

43 Jake Linford, "A Linguistic Justification for Protecting 'Generic' Trademarks" (2015) 17 Yale JL & Tech 110 at 120 [Linford, "Linguistic Justification"] ("The generic term can never acquire trademark protection, even if consumers have come to identify the mark with a specific brand or product").

44 *Filipino Yellow Pages, Inc v Asian Journal Publishers, Inc* 198 F 3d 1143 (9th Cir, 1999) [*Filipino Yellow Pages*]; 15 USC § 1064(3).

In US law, the distinctiveness requirement flows from the statutory definition of a "mark": any symbol used by a trader to identify and distinguish her goods from those manufactured or sold by others and to indicate the source of the goods.[45] Whether the claimed mark "identifies and distinguishes goods from those manufactured by others and indicates the source of the goods" is on its face an empirical question.

However, case law suggests that the distinctiveness inquiry attempts to gauge *both* the likely reaction of prospective purchasers (an empirical calculation) *and* the potential competitive impact on other sellers (a more normative assessment).[46] A fuller explanation of the treatment of descriptive terms exemplifies these different considerations. A word that merely conveys the nature or characteristics of the product on which it appears is more likely to be viewed by consumers not as an identifier of source but as a mere description of the product.[47] Similarly, preventing competitors from using such a word to describe their products impedes their ability to communicate relevant and accurate information about those products.[48]

As an example, consider an attempt to register the mark "FROSTY TREATS" for frozen desserts. This would be classified as descriptive, whether assessed by reference to likely consumer association or to the potential impact on competitors of the term being reserved for exclusive use by a single trader. Because consumers would see the phrase "FROSTY TREATS" as describing the features of the product, they would not regard the phrase as pointing to a single source. And likewise other frozen desserts manufacturers might need to use that term to describe their products and hence compete. So, the term will not be protected absent proof that consumers in fact have come to associate that term with a specific source, that is, that the mark has acquired secondary meaning.

Secondary meaning can be proved through the introduction of consumer surveys, as well as direct testimony from consumers. But courts also rely on categories of circumstantial evidence that are treated as proxies for secondary meaning.[49] This includes: the length and manner of use of the mark, the volume of sales of the product, the amount and manner of advertising using the mark, the nature of the use of the mark in newspapers and magazines, and the defendant's intent in copying the mark. In more recent case law, courts have also begun to place weight on the size of a producer's social media following, as measured by the number of "likes" on Facebook and "follows" on Twitter.[50]

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[45] 15 USC § 1127; Dinwoodie, "Reconceptualizing Inherent Distinctiveness", *supra* note 9 at 483–484.

[46] Restatement of Unfair Competition, *supra* note 14 at § 13, Comment (c).

[47] *Beckwith's Estate v Commissioner of Patents* 252 US 538 at 543 (1920) ("The function of a trade-mark is to point distinctively, either by its own meaning or by association, to the origin or ownership of the wares to which it is applied, and words merely descriptive of qualities, ingredients or characteristics, when used alone, do not do this.").

[48] *KP Permanent Make-Up, Inc v Lasting Impression I, Inc* 543 US 111 at 122 (2004) [*KP Permanent*]; *Park 'N Fly, Inc v Dollar Park and Fly, Inc* 469 US 189 at 201 (1985) [*Park 'N Fly*].

[49] See generally Fromer, "Against Secondary Meaning", *supra* note 14.

[50] See, *eg*, *Booking.com* district court, *supra* note 14.

It can be seen from this brief summary that courts in fact approach the distinctiveness question as part-empirical, part-normative.[51] Assessments of secondary meaning are mostly empirical in character. I say "mostly" empirical because, for example, there is a long-established but not well-understood doctrine called "de facto secondary meaning" that I will discuss below.[52] That doctrine discounts empirically demonstrated secondary meaning to privilege countervailing normative concerns.[53]

The empiricism of the secondary meaning inquiry, as currently conducted, is regarded by some scholars as unsatisfactory.[54] The particular proxies used by courts as circumstantial evidence allow a business with substantial resources to spend enough on advertising to manufacture a finding of secondary meaning for their otherwise unprotectable marks, arguably undermining the normative basis for the treatment of descriptive terms.[55]

Indeed, in a recent article, Prof Jeanne Fromer queries whether the way we assess secondary meaning can truly even be called "empirical" because of the imperfect proxies we use to sustain the supposedly empirical assessment.[56] I take Fromer's argument to be more a critique of the current modes of empiricism than the nature of the purported inquiry. Secondary meaning inquiries do involve empirical assessments, closely tied to the particular marks involved. But the proxies we use might be less than adequate to do the job. And those proxies are easily engineered by well-heeled producers.

These points are well taken. But Prof Fromer thinks that the weaknesses she identifies are so endemic to the empirical assessment of secondary meaning that we should not allow protection of marks based upon secondary meaning.[57] She would thus de-emphasise the empirical endeavour and approach the question of distinctiveness from a much more normative angle, adopting rules that incentivise producers to adopt inherently distinctive marks that work optimally to differentiate products and create minimal communicative impediments to competitors.[58]

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Inherent distinctiveness analysis – for words, the placement of a mark on the *Abercrombie* spectrum – might be thought of as a more open mix of empirical and normative judgements. In truth, the mode of evaluation defies easy labeling. Inherently distinctive marks are protected upon the basis that they *are likely* to act as

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51 See also *infra* note 63.

52 See text accompanying notes 137–138. Likewise, the extent of consumer association regarded as both necessary and sufficient to result in trade mark rights based on secondary meaning suggests a normative judgment about some levels of consumer understanding with which trade mark law is unconcerned.

53 See text accompanying note 138.

54 Fromer, "Against Secondary Meaning", *supra* note 14.

55 Of course, the normative concerns underlying the initial reluctance to grant protection to descriptive terms also find expression (after the acquisition of secondary meaning) in other parts of the statute, most notably the fair use defence. See *KP Permanent*, *supra* note 48 at 122; *Park 'N Fly*, *supra* note 48 at 201.

56 Fromer, "Against Secondary Meaning", *supra* note 14 at 230–234.

57 *Ibid* at 255.

58 *Cf KP Permanent*, *supra* note 48 at 122 (describing the inability of mark owners to enjoin the unauthorised descriptive fair use of registered marks by third parties as the price paid for selecting a descriptive mark).

source-identifiers.[59] 25 years ago, I labeled that assessment a "predictive" inquiry, which I still find a useful description.[60] The inquiry *does* take account of the present *realities* of the meaning of words. It is an educated guess about what reality will be when the mark is used.[61] But I suspect that rigorous social scientists would have definitional problems with the notions of forward-looking empiricism.

The second lens through which the inherent distinctiveness question is assessed is, as suggested above, more clearly normative, evincing a concern for the ability of rivals to compete if exclusive rights were given to a single trader in a word that efficiently conveyed the nature of the traders' goods (and which thus could not be used by others).

And the doctrine that has been developed to police the distinction between suggestive and descriptive marks – one of the front lines in the distinctiveness battle – reflects this normative concern. Thus, in *Zatarain's, Inc v Oak Grove Smokehouse, Inc*, the Fifth Circuit identified several considerations that bore on the classification of a term as descriptive or suggestive.[62] Many were empirical, such as the dictionary meaning of the term or the extent of third-party uses. But one was more explicitly normative: whether competitors needed the term in order to compete.[63]

Likewise, when courts assess whether a term is generic, their analysis has typically been informed by both empirical and normative considerations. Consider, for example, the case of *Filipino Yellow Pages* where the Ninth Circuit found the term "FILIPINO YELLOW PAGES" generic for consumer directories.[64] The court had regard to a number of empirical measures including dictionary definitions and usage in newspapers. But it also took into account the normative concern that recognising trade mark rights would grant the plaintiff a monopoly in the market and thus impede competition.[65]

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[59] J Thomas McCarthy, *Trademarks and Unfair Competition*, 5th ed (US: West Publishing, 2022) at § 8.02[4].

[60] Dinwoodie, "Reconceptualizing Inherent Distinctiveness", *supra* note 9 at 480–481, 487.

[61] Some commentators have criticised the prevailing *Abercrombie* test as an outdated means of making such predictions given scholarly work in the marketing and consumer psychology fields. See Rebecca Tushnet, "Looking at the Lanham Act: Images in Trademark and Advertising Law" (2011) 48(4) Hous L Rev 861 at 869–872; see also Thomas R Lee, Eric D DeRosia & Glenn L Christensen, "An Empirical and Consumer Psychology Analysis of Trademark Distinctiveness" (2009) 41(4) Ariz St LJ 1033 at 1037–1038 [Lee *et al*, "Distinctiveness"]. And obviously it is less helpful with non-word marks. See Dinwoodie, "Reconceptualizing Inherent Distinctiveness", *supra* note 9 at 509–512.

[62] 698 F 2d 786 at 788 (5th Cir, 1983).

[63] *Ibid*. Most trade mark analyses contain a blend of empirical and normative assessments. And we might quibble about the labels attached to particular analyses. For example, I have framed as normative the concern that granting protection to a particular term might create anticompetitive consequences for competitors who might need to use the term. But making that determination can be informed by crucial empirical assessments unconnected to measures of consumer association. *Cf Mil-Mar Shoe Co, Inc v Shonac Corp* 75 F 3d 1153 at 1155 (7th Cir, 1996) (taking into account the number of other retail stores with the same word in their name). Despite this, courts tend to make assessments unrelated to consumer perception (such as effect on competition) without as close attention to available data. See also *infra* note 107.

[64] *Filipino Yellow Pages*, *supra* note 44.

[65] *Ibid* at 1151.

Even beyond these dual lenses that apply in all distinctiveness analyses and highlight the normative drivers of a question that might on its face seem clearly empirical, courts have allowed assessment of distinctiveness to be informed by other normative concerns. For example, in *Kellogg Co v National Biscuit Co*, the US Supreme Court considered whether Nabisco could use trade mark law to obtain relief that might effectively extend rights it held under expired patents.[66] For several years Nabisco had been the exclusive manufacturer of pillow-shaped wheat biscuits known as "SHREDDED WHEAT" because it held design patents on the shape of the biscuits as well as utility patents on the product and the machinery with which the biscuits were made.

Upon expiry or invalidation of the patents, a rival manufacturer (Kellogg) wished to sell goods of the same shape under the name "SHREDDED WHEAT". The Supreme Court held that Nabisco could not enjoin the manufacture of pillow-shaped biscuits because to do so would interfere with the important policy of patent law that once a patent has expired the public has the right to practice that invention. Moreover, the court suggested that the shape had become generic, having become "primarily associated with the article rather than a particular producer".[67] The court held that Kellogg could also use the term "SHREDDED WHEAT" because either the term was generic or because "as Kellogg had the right to make the article it also had the right to use the term by which the public knows it".[68]

It is important to note that with respect to the protection of both the shape and the term, the court offered one explanation that is based on an "empirical" view of trade mark law and one that assumed a much more "normative" approach. Statements by the court that the shape and the term were generic appear to reflect consumer understanding; trade mark protection follows naturally (and reactively) from social meaning.[69] In contrast, when the court invokes the right to copy the shape of a product covered by the expired patent, and a concomitant right to use the name by which the patented article was known, the court is elevating competing policy values over the value of consumer association. Trade mark law, in this latter analysis, is not subservient to the value of protecting consumer association; instead, it is consciously over-riding any empirically determined consumer association in order to preserve the integrity of the patent system.

B. *Likelihood of Confusion*

Even more so than with distinctiveness, courts tend to frame the infringement test as nothing more than an empirical enquiry about whether consumers would likely be confused by the defendant's behavior.[70] Courts in the different circuits apply similar

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66 305 US 111 (1938) [*Kellogg*].

67 *Ibid* at 120. The court also hinted that the shape was functional because the cost would be increased and quality lessened by the use of a different form. *Ibid* at 122.

68 *Ibid* at 117.

69 Dinwoodie, "Trademarks and Territory", *supra* note 5 at 889–890 (describing as "reactive" the approach that "trademark law [should] be structured reactively to protect whatever consumer understandings or producer goodwill develops").

70 Barton Beebe, "Search and Persuasion in Trademark Law" (2005) 103(8) Mich L Rev 2020 at 2068 [Beebe, "Search and Persuasion"] ("As currently understood, trademark law is a primarily descriptive

multifactor tests to assess likely confusion.[71] For example, in the Second Circuit under the well-established *Polaroid* test, courts will consider a non-exhaustive list of factors. These include: the strength of the mark, the degree of similarity between the two marks, the proximity of the products, the likelihood that the prior owner will bridge the gap, actual confusion, the defendant's good faith in adopting its own mark, the quality of the defendant's product, and the sophistication of the buyers.[72] And because, with only few exceptions, trade mark rights in the US depend upon use, there is normally a healthy dose of reality to be had.[73]

But there is some dissatisfaction with the multifactor test. In a scathing article a decade ago, Prof Bob Bone argued:

> The test is a mess. It produces bad results, is doctrinally incoherent, and lacks a sensible normative foundation. It chills socially valuable uses and facilitates excessively broad expansions of trademark law, and it includes factors that make no sense as predictors of likely confusion.[74]

There is a lot in that quote with which to contend. But for our purposes the crucial aspect of Bone's analysis is the test's lack of a secure normative foundation for the empirical assessment. He demonstrated that what appeared to be a mechanism for making empirical assessments of infringing conduct was in fact an effort to mediate different judicial views about the proper scope of protection against noncompeting uses.[75]

Even without Bone's historical corroboration, on its face the characterisation of the likely-confusion inquiry as empirical obscures unavoidable antecedent normative questions.[76] Many common law jurisdictions have adopted (or effectively endorsed) the pithy statement that courts need not be so paternalistic as to protect a "moron in a hurry".[77] But just who exactly is this "moron", and how much of a

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enterprise, one which seeks simply to insure that market information is accurately conveyed and comprehended. This is especially the case in the context of the consumer confusion inquiry."). Of course, infringement liability turns on *likely* confusion. See 15 USC §§ 1114, 1125(a). But proof of likely confusion is aided by evidence of actual confusion. See *Virgin Enterprises Ltd v Nawab* 335 F 3d 141 at 151 (2nd Cir, 2003) [*Virgin Enterprises*]; *cf* 15 USC § 1125(c)(2)(B)(vi) (factors for assessing likely dilution by blurring include *actual* association). Thus, such assessments tend to be empirically grounded, even if they are to some extent forward-looking.

71 Graeme B Dinwoodie & Mark D Janis, *Trademark and Unfair Competition: Law and Policy*, 6th ed (US: Aspen Publishing, 2022) at 583–585 (listing illustrative tests).

72 *Polaroid Corp v Polarad Electronics Corp* 287 F 2d 492 (2nd Cir, 1961).

73 *Cf Lodestar Anstalt v Bacardi & Co Ltd* 31 F 4th 1228 at 1253 (9th Cir, 2022) (noting that US implementation of the Madrid Protocol "grants registration, and rights of priority, to foreign registrants … without the need to first show actual use in the U.S." but stressing that success on an infringement claim requires proof of likely confusion under the typical test including "evidence of actual confusion").

74 Robert G Bone, "Taking the Confusion Out of 'Likelihood of Confusion': Toward A More Sensible Approach to Trademark Infringement" (2012) 106(3) Nw UL Rev 1307 at 1307.

75 *Ibid* at 1332–1333.

76 *Cf* Beebe, "Search and Persuasion", *supra* note 70 at 2062 ("One's theory of trademark law … is a species of one's theory of politics.").

77 See, *eg*, *Morning Star Cooperative Society Ltd v Express Newspapers Ltd* [1979] FSR 113 (Foster J) (UK); *Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd* [1991] 1 SLR(R) 903 at [24] (Singapore); *cf Mattel, Inc v 3894207 Canada Inc* [2006] 1 SCR 772 at [56] (Canada).

hurry is he or she in?[78] What level of confusion is troubling?[79] At what point in time do we consider their state of confusion?[80] About what must they be confused?[81] Is the actionable harm merely diversion of sales, or does it encompass reputational harms, or loss of market opportunities?[82]

These are but a few of the questions embedded in the confusion analysis. There is thus a lot going on when courts determine whether the defendant's conduct would "likely confuse an appreciable number of ordinarily prudent purchasers".[83] Courts are essentially establishing a *level of regulation* (ideally) designed to take account of the *many* policy concerns at play in trade mark law, some of which are relevant to the efficient operation of the market (such as reduction of search costs by protecting consumer understanding, and preservation of competition) and some of which reflect exogenous values (such as free speech or public health).[84]

If normative choices are inevitably built into courts' thinking, why not make interrogation of them more explicit? As noted above, such considerations *are* more visible in many distinctiveness analyses. Perhaps presenting trade mark adjudication as nothing more than an exercise in empirical measurement is valuable as a tool of judicial decision-making because it offers the appearance of objectivity and judicial modesty. Proceeding under the cover of empirically grounded claims of confusion often seems to provide an intellectual immunity to what a court might

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78 See, *eg*, *Atomic Energy of Canada, Ltd v Areva NP Canada Ltd* (2009) FC 980 ("the fact that Homer Simpson may be confused is insufficient to find confusion").

79 See, *eg*, *Exxon Corp v Texas Motor Exch, Inc* 628 F 2d 500 (5th Cir, 1980) (15% confusion strongly indicative of likely confusion); see also Michael Grynberg, "Trademark Litigation as Consumer Conflict" (2008) 83(1) NYUL Rev 60 at 77–82 (framing the infringement test as a battle between the interests of confused and non-confused consumers); Daniel Gervais & Julie M Latsko, "Who Cares About the 85 Percent? Reconsidering Survey Evidence of Online Confusion in Trademark Cases" (2014) 96(3) J Pat & Trademark Off Soc'y 265.

80 See Mark P McKenna, "A Consumer Decision-Making Theory of Trademark Law" (2012) 98(1) Va L Rev 67 at 100–101 ("beneath the language about confusion, initial interest confusion is most often simply a manifestation of an anti-free-riding impulse"); Kal Raustiala & Christopher J Sprigman, "Rethinking Post-Sale Confusion" (2018) 108 Trademark Rep 881.

81 See James Gibson, "Risk Aversion and Rights Accretion in Intellectual Property Law" (2007) 116(5) Yale LJ 882 at 909–910.

82 See, *eg*, Jeremy N Sheff, "Veblen Brands" (2012) 96(3) Minn L Rev 769 [Sheff, "Veblen Brands"] (articulating various theories of injury that arise under the label of "post-sale confusion"); William McGeveran & Mark P McKenna, "Confusion Isn't Everything" (2013) 89 Notre Dame L Rev 253 at 271 (categorising injuries).

83 *Mushroom Makers, Inc v RG Barry Corp* 580 F 2d 44 at 47 (2nd Cir, 1978) [*Mushroom Makers*] ("The crucial issue in an action for trademark infringement … is whether there is any likelihood that an appreciable number of ordinarily prudent purchasers are likely to be misled, or indeed simply confused, as to the source of the goods in question.").

84 It is a persistent quest of many scholars to identify and defend a single or dominant normative goal of trade mark protection, whether it be reduction of search costs or a broader facilitation of competitive markets. See W Landes & R Posner, "Trademark Law: An Economic Perspective" (1987) 30 JL & Econ 265 (search costs); Christopher Buccafusco, Jonathan S Masur & Mark P McKenna, "Competition and Congestion in Trademark Law" 102 Tex L Rev (forthcoming, 2023) ("Trademark law should be attuned to these competition concerns. Indeed, these are the *principal* concerns to which trademark law should be attuned. Trademark law exists to promote fair competition, which ultimately benefits consumers." [emphasis in original]). Despite this monotheistic impulse, the most contested trade mark disputes can implicate any number of values, the weighing of which varies from case to case. See text accompanying notes 172–182.

decide according to more contested metrics. But that is not always healthy, even if courts find it comforting.

This problem is only exacerbated by the role of surveys. Survey evidence is routinely characterised by US courts as the best evidence of likely confusion.[85] To be sure, properly constructed surveys may be useful devices by which to immunise courts against whatever biases and preconceptions might arise from spending one's professional life adjudicating trade mark cases.[86] And I don't want to suggest that we need to remove the ability of courts to be *informed* by reality.

But, as has come to be understood by appellate courts in many other countries such as the UK, Canada or Australia, surveys of likely confusion might, at best, be unhelpful for any number of reasons.[87] They increase the costs of litigation, which creates its own distortions of the ability to establish and defend rights. And because of the feedback loop in trade mark law, decisions rendered based upon unhelpful surveys might bake in unfortunate norms in our regulation of the market.[88] Finally, to the extent they purport to reveal outcome-determinative facts they may have an undue influence on judges.[89]

So, we should not make a fetish of empiricism. This is especially true when the empiricism is often unreliable.[90] And it will be, not just because of imperfect evidentiary methods, but because resolution of the empirical questions needs to be made according to an agreed-upon metric. There are many reasons to adopt a more normative approach to trade mark law.[91] But one is that we need normative transparency just to make the empirical exercises more workable. The value of making enhanced empirical efforts, some of which I will canvass below, would be more obvious if there was consensus on underlying normative questions.

A good illustration of this need for a normative baseline comes from Europe. Prior to Brexit, there was an intriguing back and forth between the UK courts and the Court of Justice of the European Union on whether secondary meaning requires consumers to "rely" on the claimed mark rather than simply "recognising" it or

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85 Beebe, "Empirical Study of Multifactor Tests", *supra* note 15 at 1641.

86 *Triangle Publications, Inc v Rohrlich* 167 F 2d 969 at 976 (2nd Cir, 1948) (Frank J, dissenting); *cf* William E Gallagher & Ronald C Goodstein, "Inference Versus Speculation in Trademark Infringement Litigation: Abandoning the Fiction of the Vulcan Mind Meld" (2004) 94(6) Trademark Rep 1229 at 1232.

87 See, *eg, Masterpiece Inc v Alavida Lifestyles Inc* [2011] 2 SCR 387 (Supreme Court of Canada); *Australian Postal Corporation v Digital Post Australia* [2013] FCAFC 153 (Federal Court of Australia); *Marks & Spencer plc v Interflora Inc* [2012] EWCA Civ 1501 (UK). In Singapore, the Court of Appeal noted that survey evidence may be relevant but it should not be conclusive in assessing likely confusion. See *Sarika Connoisseur Café Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 at [64].

88 See, *eg*, *Anheuser-Busch, Inc v Balducci Pubs* 28 F 3d 769 (8th Cir, 1994) (surveys on the need for permission of trade mark owner to make use of its mark); see also Robert C Denicola, "Freedom to Copy" (1999) 108(7) Yale LJ 1661 at 1668 (circularity of liability for merchandising uses); Gibson, *supra* note 81 (discussing phenomenon generally).

89 Dinwoodie & Gangjee, *supra* note 32 at 370 (the "purportedly scientific character of a survey may be instinctively harder for some judges to dismiss and thus reconcile with the exercise of judgment").

90 For critiques of confusion surveys and efforts to improve methodology, see, *eg,* John P Liefeld, "How Surveys Overestimate the Likelihood of Consumer Confusion" (2003) 93(4) Trademark Rep 939; Jerre B Swann, "*Eveready* and *Squirt*—Cognitively Updated" (2016) 106(4) Trademark Rep 727; Beebe *et al*, "Consumer Uncertainty", *supra* note 2.

91 See text accompanying notes 162–189.

"associating" it with the mark owner.[92] The vague compromise standard of "perception", on which the UK and EU courts settled only with some degree of cognitive dissonance, meant that those two systems reached different conclusions about the acquired distinctiveness of the same "FOUR FINGER KIT KAT" shape, largely because their normative disagreement caused them to give different weight to the same empirical survey evidence (of "recognition" or "association") developed by the litigants.[93]

Moreover, a studied focus on empiricism alone can effectively advance quite contested normative agendas. The reach of exclusivity guaranteed by US trade mark law has expanded in large part as a result of accepting empirical claims about the reaction of consumers to third-party behavior ever more remote from the core competitive battles that defined trade mark law in the mid-twentieth century.[94] Given the imperfect nature of surveys and the weaknesses of the multifactor test as it has become mechanised by courts, those empirical claims may be wrong.[95] But they quickly can get hardened into legal doctrine, into rules of law that purport to generate further empirical determinations. For example, is unauthorised use of a strong mark really more likely to cause confusion than unauthorised use of a weak mark?[96] Such a rule might be normatively justified, but it surely is not *always* the case empirically.[97] We would make better judgments about the circumstances under

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[92] *Société des Produits Nestlé SA v Cadbury UK Ltd* (C-215/14) [2015] ETMR 50 (CJEU); *Société des Produits Nestlé SA v Cadbury UK Ltd* [2017] EWCA Civ 358 (UK) [*Nestlé v Cadbury* (UK)].

[93] The decision of the Court of Appeal validated the decision of the UK Office to ignore survey evidence of secondary meaning in the UK. Compare O-257-13, Trade Mark Application No 2552692 by *Société des Produits Nestlé SA* at [38] (June 20, 2013) (UK Registrar) and *Nestlé v Cadbury* (UK), *supra* note 92 at [34] (Kitchin LJ) ("The heart of the hearing officer's reasoning [was that it had] been shown only that consumers recognised and associated the shape of the four-finger Kit Kat with Nestlé.") with Joined Cases *Société des Produits Nestlé SA v Mondelez* (C-84/17 P), *Mondelez UK Holdings & Services Ltd v EUIPO* (C-85/17 P), and *EUIPO v Mondelez UK Holdings & Services Ltd* (C-95/17 P) [2018] EU:C:2018:596 (CJEU) (noting that the EU Intellectual Property Office credited the same survey evidence from the UK when it determined whether to grant an EU trade mark registration, but remanding to the Office to reconsider secondary meaning in other national markets); see generally Luis H Porangaba, "Acquired Distinctiveness in the European Union: When Nontraditional Marks Meet a (Fragmented) Single Market" (2019) 109 Trademark Rep 619 at 620.

[94] Compare *Boston Professional Hockey Association, Inc v Dallas Cap & Emblem Manufacturing, Inc* 510 F 2d 1004 (5th Cir, 1975) [*Boston Hockey*] (candidly explaining three reasons unrelated to consumer confusion for protecting against unauthorised merchandising and thus "slightly tilt[ing] the trademark laws from the purpose of protecting the public to the protection of the business interests of plaintiffs") with *Board of Supervisors for Louisiana State University Agricultural & Mechanical College v Smack Apparel Co* 550 F 3d 465 (5th Cir, 2008) (upholding liability in merchandising context by reference to consumer association and confusion).

[95] Bone, *supra* note 74 at 1340–1347 (doctrinal incoherence of the multifactor likely-confusion test).

[96] *Virgin Enterprises*, *supra* note 70.

[97] Jeanne C Fromer, "The Role of Creativity in Trademark Law" (2011) 86 Notre Dame L Rev 1885 at 1910–1911 (offering explanation for stronger protection for arbitrary and fanciful marks under US law without regard to empirical questions of likely confusion); Bone, *supra* note 74 at 1346 (explaining the continued significance of acquired strength in setting a scope of protection determined by likely confusion); see also *Self Care IP Holdings v Allergan Australia* [2023] HCA 8 (reputation should not play a role in the assessment of the likelihood of confusion).

which we might depart from that rule if we recognised that it combined normative and empirical assessments.[98]

And, crucially, parties pushing an empirical narrative can achieve expanded exclusivity silently without airing of the broader normative choices that are being made.[99] For example, infringement claims based upon confusion occurring only in the post-sale context have been litigated largely as contests of confusion narratives.[100] But such causes of action are motivated by maintenance of premium brand exclusivity that implicates broader questions of social policy that have been debated at least since the time of Thorstein Veblen.[101] These causes of action help create the artificial scarcity that allows for rationed access to luxury consumption.[102] Is this socially desirable or does it tug unnecessarily at the social fabric?

Indeed, post-sale confusion claims advanced before 1995 were challenged by judges resisting such claims as nothing more than judicial construction of a dilution cause of action at a time when Congress had proved unable to legislate a federal statute.[103] Dilution actions are consciously aimed at preserving producers' interest in the selling power of the mark itself and do not require consumer confusion.[104] Because protection against dilution is not required to safeguard consumers, it is a more controversial cause of action.[105] But the post-sale confusion claim obviates that normative controversy by devising a more consumer-centred claim advanced by empirical assertions.

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Thus, to recount: empirical assessments are entirely appropriate in trade mark law. In fact, they are essential. Whether there is consumer association and whether there

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98 Barton Beebe & C Scott Hemphill, "The Scope of Strong Marks: Should Trademark Law Protect the Strong More Than the Weak?" (2017) 92(5) NYUL Rev 1339.

99 Despite the historical analysis here that illustrates the role of undue empiricism in the *expansion* of trade mark rights, "normative" analysis is not a code word for contraction of trade mark rights. In the current climate, it is likely in many cases to have that effect (and thus might be what attracts some scholars to the project). But that is not an essential feature of elevating normative concerns. See text accompanying note 97 (discussing greater protection for strong marks); see also Dinwoodie, "Trademarks and Territory", *supra* note 5 at 897, 965 (discussing goals of nationwide constructive notice flowing from registration).

100 See, *eg*, *Ferrari SPA Esercizio v Roberts* 944 F 2d 1235 (6th Cir, 1991) (Ryan J); compare *Libman Co v Vining Industries, Inc* 69 F 3d 1360 at 1362 (7th Cir, 1995) (Posner J) with *ibid* at 1367–1368 (Coffey J, dissenting) (criticising majority's assessment of a consumer confusion narrative on ground that it was internally inconsistent and retried factual issues determined by the lower court, undermining the legitimacy of trial courts in the eyes of litigants, a concern that applied "with particular force in the area of trademark infringement, which is highly fact-specific").

101 Thorstein Veblen, *The Theory of the Leisure Class* (US: Macmillan Publishers, 1899).

102 Sheff, "Veblen Brands", *supra* note 82 at 775. Some courts have recognised this. See *Hermès International v Lederer de Paris Fifth Avenue, Inc* 219 F 3d 104 at 108 (2nd Cir, 2000).

103 *Ferrari SPA Esercizio v Roberts* 944 F 2d 1235 at 1248 (6th Cir, 1991) (Kennedy J, dissenting).

104 *Moseley v V Secret Catalogue, Inc* 537 US 418 at 429 (2003) [*Moseley*] ("Unlike traditional infringement law, the prohibitions against trademark dilution are not the product of common-law development, and are not motivated by an interest in protecting consumers") (Stevens J).

105 Clarisa Long, "Dilution" (2006) 106(5) Colum L Rev 1029.

is likely confusion do help to determine whether there are any affirmative reasons to trigger trade mark protection or enjoin unauthorised uses. But these empirical measures are only starting points for judicial analysis. They provide input data to the judicial calculation.

In fact, as seen above, even questions that are often presented as empirically grounded involve normative considerations. Some of those normative considerations are made visible by courts in doctrine, but others are left unstated. Thus, a purely empirical mindset fails adequately to describe what underlies trade mark law. On other occasions, important normative matters are left entirely unaddressed. Each dimension of this empirical fixation precludes transparent or complete consideration of contested issues of trade mark law.

II. Push for Greater Empiricism

A. *Trends in Scholarship*

One response of legal scholars – and some courts – to the weakness of current doctrinal mechanisms for assessing consumer understanding has been to argue that there are many tools available (from a number of scholarly disciplines) that could improve the accuracy of our empirical assessments.

To give one recent example, in a series of articles, Prof Jake Linford has argued that we should use lessons from linguistics to reconfigure the *Abercrombie* spectrum in a number of ways.[106] This included the suggestion that courts should account for "sound symbolism" when assessing the validity and scope of a fanciful mark. Thus, because "the 'S' of SWIFFER, a mark for a mop with a disposable head, sounds fast and easy treating it as a fanciful mark might afford greater competitive advantages than current doctrine admits, a lesson that perhaps warrants providing less expansive exclusivity to SWIFFER.[107]

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[106] Jake Linford, "Are Trademarks Ever Fanciful? (2017) 105 Geo LJ 731 [Linford, "Are Trademarks Ever Fanciful"]; see also Jake Linford, "The False Dichotomy Between Suggestive and Descriptive Trademarks" (2015) 76(6) Ohio St LJ 1367 at 1415 (arguing that linguistic analysis reveals an inconsistency between how trade mark doctrine treats suggestive and descriptive trade marks and how consumers likely process them and that as a result a suggestive mark should be protected only upon a showing of secondary meaning); Linford, "Linguistic Justification", *supra* note 43 at 113–114 (because "the synchronicity between theories of semantic shift and the legal reality of trademark acquisition breaks down when we reach the treatment of 'generic' trademarks", it should be possible to protect marks once generic when meaning shifts); Jake Linford & Kyra Nelson, "Trademark Fame and Corpus Linguistics" (2022) 45(2) Colum J L & Arts 171 (arguing that "corpus linguistic analysis can provide evidence of whether a mark is sufficiently prominent and singular to qualify for anti-dilution protection"). Prof Linford submitted an amicus brief in the *Booking.com* case discussed below, and the Supreme Court arguably came to the same conclusion that Linford offers in Linford, "Linguistic Justification", *supra* note 43, albeit without citing the scholarship or the brief.

[107] Linford, "Are Trademarks Ever Fanciful", *supra* note 106 at 753. This example shows that although most of the "empirical" assessments in this Article relate to consumer perceptions of source-identification or confusion, one could also use actual consumer reactions to inform other relevant metrics, such as effect on competition. There are several points in existing trade mark doctrine where courts engage in assessments of competitive effects that might benefit from empirical input. Most notably, functionality determinations grounded on whether conferring protection would confer a "substantial non-reputation

These kinds of studies fit with broader trends in legal scholarship. For some years, legal scholars have made greater use of empirical work and have sought to deploy interdisciplinary research to produce greater insights about the operation of legal doctrine.[108] And empirical scholarship has real value as input data to normative policy debate.[109]

But some commentators also claim that these perspectives can improve empirical assessments in litigation. This process has been encouraged by prominent judges. In *Kraft Foods Group Brands LLC v Cracker Barrel Old Country Store, Inc*, Judge Richard Posner declined to place weight on a conventional survey presented in an infringement case by an experienced survey researcher because the context of the survey submitted to the court was too different from shopping with one's own money.[110] However, Judge Posner suggested that "an attractive alternative to a survey might be the use of statistical data to determine the effect of the allegedly infringing logo" and he proceeded to offer a hypothesis that such data might test.[111] Indeed, he went on to say he could "imagine other types of expert testimony that might be illuminating in a case such as this—testimony by experts on retail food products about the buying habits and psychology of consumers of inexpensive food products".[112]

In keeping with the sentiment expressed by Judge Posner, a number of scholars have urged greater reliance on empirical work (from a variety of disciplines) in trade mark litigation.[113] For example, Prof Lisa Ouellette has argued that a study of con-

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related advantage", *Qualitex*, *supra* note 19 at 165, and identification of the relevant category of goods by reference to which genericness determinations are made, would lend themselves to the sort of expert evidence adduced, for example, in antitrust litigation. See also *supra* note 63. But trade mark law has never viewed the benefits of *that* empiricism as worth the costs of developing the relevant evidence.

108 Shari Seidman Diamond, "Empirical Legal Scholarship: Observations on Moving Forward" (2019) 113(5) Nw UL Rev 1229.

109 For a recent example, the debate surrounding some of the reforms in the US Trademark Modernization Act 2020 was informed not only by traditional scholarly work reimagining the registration process by Prof Rebecca Tushnet, see Tushnet, "Registering Disagreement", *supra* note 33, but also by empirical work published by Profs Barton Beebe and Jeanne Fromer challenging the conventional wisdom that the supply of marks is infinite and quantifying the rate of fraudulent specimens. See Barton Beebe & Jeanne C Fromer, "Are We Running Out of Trademarks? An Empirical Study of Trademark Depletion and Congestion" (2018) 131(4) Harv L Rev 945; Barton Beebe & Jeanne C Fromer, "Fake Trademark Specimens: An Empirical Analysis" (2020) 120(7) Colum L Rev Forum 217; United States, Senate Committee on the Judiciary, Subcommittee on Intellectual Property, *Fraudulent Trademarks: How They Undermine the Trademark System and Harm American Consumers and Businesses* (subcommittee hearing) [3 December 2019] (Witnesses: Profs Barton Beebe and Jeanne Fromer).

110 735 F 3d 735 at 742 (7th Cir, 2013). A similar sentiment informed Justice Sotomayor's critique of surveys in the recent *Jack Daniel's* case. See *infra* note 129.

111 *Ibid* at 742. Judge Posner suggested that an expert could examine the "lift" (greater sales) that the defendant's products obtained by proximity to the plaintiff's label and thus estimate the extent of consumer confusion caused by the defendant's use, theorising that "[t]he greater the lift (and hence the greater the confusion) the greater the likelihood of a consumer's blaming [the plaintiff] as the supposed maker of the [defendant's products] if the consumer has a bad experience with [those products]."

112 *Ibid* at 743.

113 See, *eg,* Graeme W Austin, "Trademarks and the Burdened Imagination" (2004) 69(3) Brook L Rev 827 at 917 (arguing that "greater use might be made in trademark cases of the insights of cognitive science"); Sandra M Virtue & Darren S Cahr, "Trademarks and the Brain: Neuroscience and the Processing of Non-literal Language" (2022) 112(4) Trademark Rep 695 at 705 ("The deference (or lack of deference) given to trademark protectability depending on abstract classifications of its distinctiveness is disconnected from the measurable impact of a trademark on the brain of a relevant consumer. If brands are like

temporaneous Google search results can provide courts with accurate assessments of both consumer association (distinctiveness) and likely confusion. Courts have generally given online search results little weight in offline trade mark disputes. But Prof Ouellette suggested that the key factual questions in these cases depend on the wisdom of the crowds, making Google's "algorithmic authority" highly probative.[114]

Prof Ouellette is not alone in thinking that we might employ enhanced empirical methods in deciding particular disputes. In Singapore, Profs David Tan and Benjamin Foo have argued that the fields of cognitive and consumer psychology have much to offer those interested in trade mark law.[115] Similar sentiments can be found in US legal scholarship. Most notably, borrowing from scholarly literature in marketing and consumer psychology, Prof Tom Lee and his co-authors developed a model to inform application of the "consumer care" factor in the multifactor likely-confusion analysis.[116] And they sought to facilitate the evolution of case law consistent with that model.

In a similar vein, *pre-existing* scholarship in the marketing field has been deployed to bolster theories of trade mark liability. Thus, for example, marketing scholars have conducted neuroscientific experiments exposing consumers to hypothetical adverts that were not confusing, but arguably dilutive. That is to say, participants were shown ads using the identical protected mark on very different products (such as "HEINEKEN" for popcorn).[117] The researchers found that this exposure slowed consumers accuracy and response time in associating some existing brands with product categories and attributes.[118]

On the surface, these findings meshed well with a suggestion by Judge Posner in a different case, *Ty v Perryman*, that the harm targeted by dilution claims is an

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poems … then neuroscience will play an important role in providing a more solid empirical basis for the future of trademark law"); *cf* Swann, *supra* note 90 (suggesting adaptation of traditional *Eveready* and *Squirt* surveys for different contexts based upon lessons from cognitive studies); see generally Mark Bartholomew, *Intellectual Property and the Brain: How Neuroscience Will Reshape Legal Protection for Creations of the Mind* (Cambridge: Cambridge University Press, 2022).

[114] Lisa Larrimore Ouellette, "The Google Shortcut to Trademark Law" (2014) 102(2) Cal L Rev 351 at 395, 399 (arguing that courts should give more weight to Google search evidence in trade mark disputes but advising "practitioners submitting search-engine results in actual cases [to] use multiple search engines on multiple dates with multiple location settings").

[115] David Tan & Benjamin Foo, "The Extraneous Factors Rule in Trademark Law: Avoiding Confusion or Simply Confusing?" (2016) Sing JLS 118 at 121 (citing Thomas R Lee, Glenn L Christensen & Eric D DeRosia, "Trademarks, Consumer Psychology, and the Sophisticated Consumer" (2008) 57(3) Emory LJ 575 [Lee *et al*, "Trademarks, Consumer Psychology"]). For parallel scholarship from Europe, see Martin Senftleben & Femke van Horen, "The Siren Song of The Subtle Copycat—Revisiting Trademark Law With Insights From Consumer Research" (2021) 111(4) Trademark Rep 739.

[116] Lee *et al*, "Trademarks, Consumer Psychology", *supra* note 115; see also Lee *et al*, "Distinctiveness", *supra* note 61; Thomas R Lee, Eric D DeRosia & Glenn L Christensen, "Sophistication, Bridging the Gap, and the Likelihood of Confusion: An Empirical and Theoretical Analysis" (2008) 98(4) Trademark Rep 913.

[117] These particular studies are discussed in detail and their relevance to trade mark protection extensively (and persuasively) critiqued in Rebecca Tushnet, "Gone in Sixty Milliseconds: Trademark Law and Cognitive Science" (2008) 86(3) Tex L Rev 507 [Tushnet, "Gone in Sixty Milliseconds"].

[118] Maureen Morrin & Jacob Jacoby, "Trademark Dilution: Empirical Measures for an Elusive Concept" (2000) 19(2) J Pub Pol'y & Marketing 265 at 267 (discussed in Tushnet, "Gone in Sixty Milliseconds", *supra* note 117 at 521–522).

increase in mental search costs for consumers.[119] Perhaps encouraged by Judge Posner's musings, interested parties presented the academic studies in question to courts as an empirical justification for dilution protection.[120] As Prof Rebecca Tushnet commented (critically) "the link from psychology to economics to law [was] complete".[121]

The underlying message in all this work appears to be that trade mark law will be improved if we can keep improving our forms of empirical assessment.

B. *Booking.com*

The 2020 decision of the US Supreme Court in *Booking.com* has arguably encouraged this elevation of empirical "facts" without sufficient regard to contested normative concerns.[122]

Booking.com is a travel-reservation website by the same name. It sought to register the mark "Booking.com" but the US Patent and Trademark Office ("PTO") refused the application on the basis that the mark was generic. The PTO took the position that the addition of ".com" to a generic term did not change the status of that term, and thus denied registration, regardless of any empirical evidence of secondary meaning. In an 8-1 judgment, the court rejected the proposed approach of the PTO because an "unyielding legal rule that entirely disregarded consumer perception" would be inconsistent with the Lanham Act.[123]

Justice Breyer was the sole dissenter. He reached his contrary conclusion in part because the registration threatened "serious anticompetitive consequences in the online marketplace".[124] He argued that protection would move the online market away from "the competitive multifirm marketplace that our basic economic laws seek to achieve".[125] Justice Breyer saw the acquisition of trade mark rights in this instance as a means of "chilling others from using variants on the … mark and privileg[ing] established firms over new entrants to the market".[126] He argued that owners of short, generic domain names already enjoyed a series of market advantages irrespective of trade mark laws. Because of these concerns, Justice Breyer was willing to discount any consumer association that existed between the mark and the travel site.[127]

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[119] *Ty v Perryman*, *supra* note 10 at 511 (explaining protection against blurring on the basis that "consumers will have to think harder—incur as it were a higher imagination cost—to recognize the name as the name of the store").

[120] Tushnet, "Gone in Sixty Milliseconds", *supra* note 117 at 525 (citing the amicus brief filed by the International Trademark Association before the US Supreme Court in *Moseley*, *supra* note 104).

[121] *Ibid* at 525.

[122] *Booking.com, supra* note 1.

[123] *Ibid* at 2306.

[124] *Ibid* at 2314 (Breyer J dissenting).

[125] *Ibid* at 2315 (Breyer J dissenting).

[126] *Ibid.*

[127] In any event, Justice Breyer had great doubts about relying on surveys as proof of consumer association when making an initial assessment of where a mark placed on the distinctiveness spectrum. In this, he endorsed a minority approach in the lower courts that refused to consider surveys in such a context. See *ibid* at 2313 (Breyer J dissenting); see, *eg*, *Schwan's IP, LLC v Kraft Pizza Co* 460 F 3d 971 at 976 (8th

Instead, the majority of the court held (in an opinion by Justice Ginsburg) that a so-called "generic.com" term is a generic name for a class of goods or services *only* if the term has that meaning to consumers.[128] The majority thus exalted the role of empirical measures of consumer association (principally, though not exclusively, in the form of surveys) over the normative concerns about anticompetitive monopolies that have long informed doctrine on generic terms and which had prompted the PTO's proposed approach.[129] Because a survey had shown that 74.8% of participants thought that "Booking.com" was a trade mark,[130] the PTO did not contest the lower court finding that the term "Booking.com" had secondary meaning. Thus, the mark could be registered.

Booking.com may have effected several doctrinal shifts in US trade mark law.[131] For purposes of this Lecture, however, what is important is that Justice Ginsburg

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Cir, 2006) (survey evidence was irrelevant because the term at issue was regularly used as a generic term before the plaintiff sought trade mark protection). The minority approach has much to commend it and fits more easily with the overall logic of distinctiveness analysis than the (now standard) resort to so-called *Thermos* or *Teflon* surveys. See *EI DuPont de Nemours & Co v Yoshida International, Inc* 393 F Supp 502 (EDNY, 1975) (*Teflon* survey); *American Thermos Products Co v Aladdin Industries, Inc* 207 F Supp 9 (D Conn, 1962) (*Thermos* survey); see also *ET Browne Drug Co v Cococare Products, Inc* 538 F 3d 185 at 195–197 (3rd Cir, 2008) (describing *Thermos* and *Teflon* surveys). In particular, with respect to descriptive marks, surveys are introduced only to prove a *secondary* meaning acquired by a descriptive term. Determining the primary meaning of a term by situating it on the *Abercrombie* spectrum is done without resort to surveys. The use of surveys to determine whether a term is generic or descriptive is at odds with that approach. *Teflon* and *Thermos* were cases testing whether marks once protected as pointing to a single source had become generic. The concerns at play in assessing terms that are generic *ab initio* differ from when a mark with prior trade mark significance may have become generic. See *Gimix, Inc v JS & A Group, Inc* 699 F 2d 901 at 905 (7th Cir, 1983); *Miller Brewing Co v Jos Schlitz Brewing Co* 605 F 2d 990 (7th Cir, 1979).

128 *Booking.com*, *supra* note 1 at 2301 (Ginsburg J).

129 See text accompanying notes 64–65 (concerns at play in generic cases); see also *Booking.com*, *supra* note 1 at 2307 n 6 (Ginsburg J) (listing sources of evidence). In a concurring opinion, Justice Sotomayor expressed some skepticism about placing undue weight on consumer surveys, noting that she did "not read the Court's opinion to suggest that surveys are the be-all and end-all" and that other evidence including dictionaries and usage by consumers and competitors might inform whether a mark is generic or descriptive. See *ibid* at 2309 (Sotomayor J, concurring). This view of surveys appears to be a consistent theme of Justice Sotomayor's recent trade mark jurisprudence. See *Jack Daniel's*, *supra* note 24 at 1593 ("I write separately to emphasize that in the context of parodies and potentially other uses implicating First Amendment concerns, courts should treat the results of surveys with particular caution") (Sotomayor J, concurring). Justice Sotomayor's doubts about surveys in *Jack Daniel's* appears to stem largely from a concern that surveys would provide inadequate empirical assessments. See *ibid* at 1593–1594 (noting that surveys might measure confusion "that would not have arisen organically out in the world" and suggesting that doctrinal confusion factors other than surveys "may more accurately track the experiences of actual consumers in the marketplace. Courts should also be attentive to ways in which surveys may artificially prompt such confusion about the law or fail to sufficiently control for it."). But she also hints that allowing surveys to drive infringement analysis might flatten normative complexity. See *ibid* at 1593 (undue attention to surveys might "upset the Lanham Act's careful balancing of 'the needs of merchants for identification as the provider of goods with the needs of society for free communication and discussion.'") (citing Leval, *supra* note 23).

130 *Booking.com, supra* note 1 at 2313–2314 (Breyer J, dissenting) (74.8% of survey participants thought that "Booking.com" was a brand name, whereas 23.8% believed it was a generic name).

131 *Cf Snyder's Lance, Inc v Frito-Lay North America, Inc* 542 F Supp 3d 371 at 397 (WDNC, 2021), appeal dismissed, No 21-1758 (4th Cir, 2021) [*Synder's Lance*] ("Pursuant to the Supreme Court's directive in *Booking.com* … the Court also considers—*cautiously*—the survey evidence presented …" [emphasis added]).

viewed the genericness question largely through the empirical lens of consumer association. To be sure, Justice Ginsburg did engage with some of the normative arguments about competition that Justice Breyer advanced. But she did so by highlighting how downstream doctrines such as the scope of protection and the fair use defence made the competition concerns raised by Justice Breyer less urgent.[132] Regardless of whether one accepts the robustness of those doctrines to sufficiently further competitive values, those doctrines have not typically been considered in denying generic status to a mark that would offer competitive control over a product or service to a single producer.[133] Justice Ginsburg engaged with the normative competitiveness concerns only at a higher level of abstraction and only in so far as necessary to articulate a rule of law that *going forward* will allow mere empirical assessment of consumer perception to prevail.

Moreover, the dueling opinions in the Supreme Court highlight that the line between descriptive and generic terms is far from clear. Arguably, the majority opinion erases the line by casting doubt upon the rule that a generic term can never be protected as a trade mark regardless of secondary meaning.[134] But assuming that that radical revision of doctrine was not effected,[135] what are we to make of the

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[132] *Booking.com*, *supra* note 1 at 2307–2308 (Ginsburg J).

[133] Analogues to the rhetorical approach adopted by Justice Ginsburg to rebut Justice Breyer's fears of over-protection can be found in earlier Supreme Court opinions. See *Park 'N Fly*, *supra* note 48 at 200–202 (O'Connor J) (responding to concerns of the dissent that inability to challenge an incontestable registration on the ground of descriptiveness would give rise to anticompetitive concerns by noting the role of the scope of protection and defences such as fair use); *Qualitex*, *supra* note 19 at 168 (Breyer J) (endorsing possible registration of marks consisting of color *per se* because competitive concerns would be dealt with through the functionality doctrine).

[134] Critics have charged with some basis that the majority opinion casts doubt upon the rule that a generic term can never be protected as a trade mark regardless of secondary meaning. The court formally dodged that critique by holding that the term "booking.com" was not generic for a travel reservation service in the first place. Thus, protecting it did not do violence to the "once generic, always generic" rule. Instead, the court classified the term "booking.com" as a descriptive term. This was because, as Justice Ginsburg put it, consumers don't identify similar travel reservations services such as Travelocity as "booking.coms". See *Booking.com*, *supra* note 1 at 2304–2305 (Ginsburg J). Thus, as a descriptive term, existing doctrine would allow protection upon proof of secondary meaning, and the survey and other circumstantial empirical evidence demonstrated such secondary meaning. But Justice Ginsburg's reasoning adopts a crabbed view of what we would treat as a generic term. As Justice Breyer argued perusasively in dissent, while "few would call Travelocity a 'Booking.com.' … literal use is not dispositive." See *Booking*.com, *supra* note 1 at 2313 (Breyer J, dissenting). He suggested that while "consumers do not use the term 'Wine, Incs.' to refer to purveyors of wine … the term 'Wine, Inc.' [would be] generic because it signifies only a company incorporated for that purpose". Justice Ginsburg's argument would have been stronger had the applicant not conceded that booking was generic for travel reservation services. That concession means that the court's conclusion regarding the composite mark "Booking.com" also rests heavily upon the anti-dissection principle, which requires courts to look at marks as a whole.

[135] In the wake of *Booking.com*, some lower courts have taken pains to deny this result. See *Snyder's Lance*, *supra* note 131 at 381 n 9 (approvingly quoting the statement by Judge Friendly in *Abercrombie*, *supra* note 13, to the effect that "no matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise and what success it has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name", and noting that "the Supreme Court recently confirmed this principle [in *Booking.com*]").

increasingly murky line between descriptive and generic terms?[136] One response to its murkiness would be to soften the difference in consequence that attaches to a claimed mark falling on one or other side of the line. Indeed, current doctrine does so in ways that the court sidestepped in *Booking.com*. Although – at least pre-*Booking.com* – generic terms could not be protected as trade marks even with secondary meaning, in some cases courts have granted unfair competition relief – that is, labeling relief short of wholly enjoining a defendant's use – to generic terms if they possessed what has been called "de facto secondary meaning".[137]

The courts have never satisfyingly defined "de facto secondary meaning". But I would describe it as empirically established distinctiveness that for countervailing normative reasons we are unwilling to recognise *de jure* as establishing trade mark rights. For example, in *Kellogg*, the court acknowledged that Nabisco had demonstrated some consumer association in fact, even if the competing policy values of the patent system mandated that the court could not recognise it as legally protectable via trade mark law.[138]

This doctrine allows courts to treat empirical assessments, which might in any event be less than robust by reason of the inadequacy of secondary-meaning evidence discussed earlier, as *informing rather than dictating* the outcome. It allows courts to take account of empirical findings – but interpret them in light of normative commitments. It recognises that descriptive and generic terms differ in degree, not in kind. It makes the regulation of market behaviour turn more explicitly on the reasonableness of competitor behavior, reflecting normative considerations that scholars in the field (and, in candid private moments, experienced trade mark judges) see as appropriately at play in many of these cases. It recognises the normative multivalence of trade mark law, and the conceptual location of trade mark law within the broader body of unfair competition law (which historically has provided sometimes narrower relief in a broader array of circumstances).[139]

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[136] Recent case law in the Federal Circuit has not helped draw this line more clearly. See, *eg*, *Royal Crown Co, Inc v The Coca-Cola Co* 892 F 3d 1358 (Fed Cir, 2018) (a term can be generic for a genus of goods or services if the relevant public understands the term to refer to a "key aspect of that genus", quoting *In re Cordua Rests, Inc* 823 F 3d 594 at 603 (Fed Cir, 2016)); *cf Abercrombie*, *supra* note 13 at 10 n 11 (suggesting that although "Deep Bowl" identifies a significant characteristic of a deep bowl spoon, "deep bowl" would be descriptive while "spoon" would be generic). But the case law does highlight that the "literal use" test endorsed by Justice Ginsburg, see *supra* note 134, is unduly narrow.

[137] See, *eg*, *Blinded Veterans Association v Blinded American Veterans Foundation* 872 F 2d 1035 at 1045 (DC Cir, 1989) (Ginsburg J); see also *Murphy Door Bed Co, Inc v Interior Sleep Systems, Inc* 874 F 2d 95 (2nd Cir, 1989); *Forschner Group, Inc v Arrow Trading Co* 30 F 3d 348 at 358–359 (2nd Cir, 1994).

[138] *Kellogg*, *supra* note 66 at 118–119; Graeme B Dinwoodie, "The Story of Kellogg Co v National Biscuit Co: Breakfast with Brandeis" in Jane C Ginsburg & Rochelle Cooper Dreyfuss, eds, *Intellectual Property Stories* (US: Foundation Press, 2005) 220 at 232–233 [Dinwoodie, "Story of Kellogg"] ("The [*Kellogg*] Court's overall analysis of distinctiveness is stretched and conclusory because it was seeking to sustain as an empirical conclusion what was in truth a legal policy choice driven by concerns about competition").

[139] See Zechariah Chafee, Jr, "Unfair Competition" (1940) 53 Harv L Rev 1289 at 1291–1301 (discussing historical differences between trade mark infringement and cause of action for unfair competition or palming off); Mark P McKenna, "Property and Equity in Trademark Law" (2019) 23 Marq Intell Prop L Rev 117 at 120–121.

III. Dangers of Elevating Empirics and Suppressing the Normative

Thus far, I have suggested that apparently empirical assessments in trade mark law are in fact often informed by normative thinking. And I have mentioned some problems that arise from a failure to engage with the normative dimension of trade mark law and from turning matters over (at least nominally) to *purely* empirical assessments.

The problems that flow from this empirical fixation can in large part be subsumed under two broad headings. First, when courts dress up policy-driven outcomes as empirical determinations, this destroys transparency and precludes direct engagement with doctrinal applications that might produce results that are normatively wrong-headed. Second, when normative awareness is simply missing from judicial calculations, doctrine is applied with no regard for the increasingly varied policy objectives implicated by trade mark law.

Although both types of problem emanate from the pre-occupation with empiricism in trade mark law, solving each problem arguably presents different difficulties. Calling for transparency when normative analysis is already at play is a relatively less controversial demand.[140] The open articulation of the normative underpinnings allows for an evolution and application of doctrine over time in line with its purposes.[141] In contrast, injecting broader normative thinking into areas currently lacking that dimension demands more sensitive handling. It will prompt greater judicial discussion of the sometimes competing policy goals of trade mark law, and draw courts more fully into contested areas of trade mark policy. In particular, weighing a more diverse set of concerns that might be implicated by trade mark law raises questions of commensurability. This is seen by some as undermining the legitimacy of judges, although one might retort (persuasively, to my mind) that this is the essence of judging.[142]

Importantly, as regards both these sets of problems, this suggestion for greater normative engagement is not a plea for untrammeled judicial activism. Certainty and efficiency demand restraint and, more generally, deployment of the normal tools of responsible adjudication. Explicit attention to the normative bases of rules does not require constant resort to first principles. Doctrinal mechanisms can develop over time that streamline the inquiry and afford greater certainty.[143] And the extent to which (and circumstances in which) courts ought to view empirical questions in light of broader normative concerns is surely informed by the nature of the trade

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[140] *Cf* text accompanying notes 83–85 (discussing judicial comfort with appearance of objectivity).

[141] See *Peaceable Planet, Inc v Ty, Inc* 362 F 3d 986 at 990 (7th Cir, 2004) (Posner J) (finding exception to personal name rule in trade mark cases because "one way of going astray in legal analysis is to focus on the semantics of a rule rather than its purpose").

[142] Compare *Nat'l Pork Producers Council v Ross* 143 S Ct 1142 at 1159–1160 (2023) (Gorsuch J) (noting difficulty of courts neutrally weighing incommensurable values, some economic and others noneconomic) with *ibid* at 1168 ("sometimes there is no avoiding the need to weigh seemingly incommensurable values") (Roberts CJ, concurring).

[143] See Graeme B Dinwoodie, "Lewis & Clark Law School Ninth Distinguished IP Lecture: Developing Defenses in Trademark Law" (2009) 13 Lewis & Clark L Rev 99 at 148–151 [Dinwoodie, "Developing Defenses"] (discussing *Rogers*).

mark statute and a broader understanding of the judicial role.[144] Finally, there may be other prudential considerations that would guide courts in reaching the right mix of empirical and normative. For example, if the empirical assessment on which courts might base liability is itself a circular assessment that turns in part upon normative assumptions, the empirical calculation is surely entitled to less weight.[145] Likewise, if the empirical determinations are unreliable, courts ought to be guided more easily by normative concerns.

In this concluding part, I briefly consider whether these issues are ameliorated by efforts to improve empirical assessments of the type described above in Part II. I will also discuss a recent article on the protection of designs and packaging post-*Samara* that illustrates the consequences of courts not transparently engaging with normative questions. And I will conclude by setting out the benefits of embracing trade mark law as a normative project and (after briefly considering the effect of the very recent Supreme Court decision in *Jack Daniel's*) suggesting some developments that may provide room for a more normative approach to trade mark law.

A. *Empirical Enhancements*

At first blush, one might think there can be no harm to courts being enabled to make better empirical findings. This depends in part on whether the development and interrogation of such evidence increases the cost of litigation. Efficiency calculations may suggest that trade mark law operate with a less calibrated view of reality.[146]

This consideration clearly informed the growing hostility to the use of surveys in the UK.[147] And although the US courts have exhibited little restraint in admitting surveys in trade mark litigation, some current doctrinal rules are consciously structured to prevent a party from using expensive and time-consuming litigation to chill either competition or speech. The secondary requirement for product-design cases announced in *Samara* was motivated in large part by these concerns.[148]

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[144] See text accompanying notes 21–24; see also Graeme B Dinwoodie, "The Common Law and Trade Marks in an Age of Statutes" in Catherine W Ng, Lionel Bently & Giuseppina D'Agostino, eds, *The Common Law of Intellectual Property: Essays in Honour of Professor David Vaver* (Oxford: Hart Publishing, 2010) 331 at 331.

[145] *Cf Am Geophysical Union v Texaco Inc* 60 F 3d 913 at 930–931 (2nd Cir, 1994) (Leval J) (discussing the "vice of circular reasoning" in copyright fair use cases where the existence of market harm depended on the legal assumptions being tested in the case).

[146] Graeme B Dinwoodie, "What Linguistics Can Do for Trademark Law" in Lionel Bently, Jennifer Davis & Jane C Ginsburg, eds, *Interdisciplinary Perspectives on Trade Marks* (Cambridge: Cambridge University Press, 2008) 140 at 153.

[147] Dinwoodie & Gangjee, *supra* note 32 at 372.

[148] *Samara*, *supra* note 13 at 214 ("Competition is deterred, however, not merely by successful suit but by the plausible threat of successful suit, and given the unlikelihood of inherently source-identifying design, the game of allowing suit based upon alleged inherent distinctiveness seems to us not worth the candle").

Likewise, the *Rogers* defence developed to permit expressive uses of marks without full-blown confusion analyses.[149] Under *Rogers*, use of a mark in an artistic work will not give rise to liability "unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work".[150] As the Supreme Court recently noted, "the *Rogers* test … offers an escape from the likelihood-of-confusion inquiry and a shortcut to dismissal".[151] *Rogers* recognised that even where a court might make the correct empirical assessment, the time and cost involved in doing so might be sufficient to undermine the competing speech value. Thus, the success of a *Rogers* defence will not turn on mere consumer perception.[152] Indeed, a survey showing consumer confusion was adduced in *Rogers* itself to no effect.[153]

There is also a risk that if courts accept that new empirical methods can perfectly determine consumer association or likely confusion, they will relinquish their own policing of trade mark policy. The claim of factual certainty can be seductive. Courts must recognise that such factual findings remain only inputs to legal determinations. This arguably becomes harder when the empirical findings are touted as "truth", and not just "facts", to quote Stoppard's Wilde. The risk that an elevated view of facts can crowd out normative analysis is surely highlighted by *Booking.com*.

B. *Downsides of Dressing Normative as Empirical*

I have suggested above that concealing normative policy choices as empirical findings creates risks. Let me offer a further illustration, drawing from an article recently published by Profs Mark Lemley and Mark McKenna.

In *Samara*, the US Supreme Court held that product designs could not be inherently distinctive and thus could only be protected upon proof of secondary meaning because consumers were not likely to regard designs as source-identifiers.[154] This proposition had no empirical support in the record (although it probably correlates generally with our intuitions). In other parts of his *Samara* opinion, Justice Scalia offered alternative explanations grounded in broader normative concerns for why a more pro-defendant rule was attractive. Most notably, the court feared that permitting design plaintiffs to plead inherent distinctiveness would deter competition by inviting strike suits that would be hard to dismiss summarily.[155] But the doctrine by which the court implemented these concerns was rooted firmly in consumer

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[149] *Rogers v Grimaldi* 875 F 2d 994 (2nd Cir, 1989) [*Rogers*]; see also *Stouffer v National Geographic Partners, LLC* 400 F Supp 3d 1161 at 1177–1178 (D Colo, 2019). This concern has been more robustly validated in the Ninth Circuit, where there has been a consistent refusal to subject defendants invoking *Rogers* to an assessment of likely confusion. Ironically, given the provenance of the *Rogers* test in the Second Circuit, case law there is more ambivalent on whether the standard confusion analysis remains relevant to liability for use of a mark in an expressive work. See *infra* note 185.

[150] *Rogers, supra* note 149 at 999.

[151] *Jack Daniel's*, supra note 24 at 1589.

[152] See *Brown v Elec Arts, Inc* 724 F 3d 1235 at 1246 (9th Cir, 2013).

[153] *Rogers, supra* note 149 at 1101.

[154] *Samara*, *supra* note 13.

[155] *Ibid* at 214.

association: consumers don't ordinarily regard product designs as distinctive, and thus we should impose a secondary meaning requirement.[156]

The problem of embedding an untested (but generally true and said-by-the-courts-to-be true) empirical proposition as a rule of law for (purportedly empirical but actually) normative reasons is seen in the reaction to *Samara* over the last couple of years. In a recent article, Profs Lemley and McKenna argue that, despite *Samara*, courts and the PTO frequently evaluate the inherent distinctiveness of certain marks that Profs Lemley and McKenna regard as "design marks" and thus covered by *Samara*.[157] In a step that is never formally articulated, courts and trade mark examiners make their own judgment about whether they believe consumers are likely to regard those features as trade marks. Profs Lemley and McKenna show that this process is most closely driven by the mark being placed on what they call "trademark spaces": locations where consumers expect to see trade marks. Think, for example, of the breast of a T-shirt, or the side panel of an athletic shoe, or the back pocket of jeans.[158]

As Profs Lemley and McKenna explain, these developments are fully consistent with experiments discussed by Prof Tom Lee in the studies mentioned above.[159] Those showed that consumers may treat as a brand whatever word you put in the central branding position on a package of cookies – even if the word is descriptive or generic.[160]

Courts are thus allowing these empirical realities to overcome constraints that were imposed by the Supreme Court for broader normative reasons. As Profs Lemley and McKenna note, there is little in these lower court opinions that purports to explain this departure from *Samara.* But the easiest way to circumvent the *Samara* rule would surely be to distinguish it on the ground that the empirical premise on which Justice Scalia sought to build his normatively-inspired rule of law did not pertain in these cases.[161] It may be that consumers *are* predisposed to see certain design features *at particular places* on certain products as source-identifiers. The lesson for courts: if a rule is normatively-driven, declare it to be so.

C. *A More Normative Project*

There are a number of reasons for making the normative character of trade mark law more explicit and for embracing trade mark law as a normative project, in addition

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[156] *Ibid* at 213.

[157] Lemley & McKenna, "Trademark Spaces", *supra* note 13.

[158] See, *eg, Lois Sportswear USA v Levi, Strauss & Co* 799 F 2d 867 (2nd Cir, 1986) (holding that the pocket stitching on Levi's jeans was a trade mark).

[159] Lee *et al*, "Distinctiveness", *supra* note 61.

[160] *Ibid* at 1076–1078, 1089–1090.

[161] Of course, one might support these deviations on the ground that the uses in questions do not implicate the normative concerns that drove the *Samara* rule. But that only highlights the importance of engagement with the normative underpinnings of a rule. (A formalist might deduce the scope of *Samara* and *Qualitex* by definition of "design" or "color *per se*", but that has proven unhelpful, see *In re Forney Industries, Inc* 955 F 3d 940 (Fed Cir, 2020), despite guidance from Justice Scalia designed to limit difficult issues of classification).

(as discussed above) to improving how we make important empirical assessments or ensuring the resilience of a normative preference.

First, we might want to have to a normative debate transparently because we want trade mark law to be a norm entrepreneur, as Stacey Dogan and Mark Lemley describe it,[162] or to engage proactively, as I have described it, to shape consumer behavior and the nature of the market.[163] Some have questioned whether trade mark law *can* shape consumer behaviour. Consumers tend not to respond directly to technical legal developments. And consumer preferences are probably too variable and too dynamic for trade mark law to target changes in consumers' purchasing behaviour with any guarantee of success.

But there is no doubt that trade mark law does shape consumer behaviour.[164] It just may do so more indirectly through the reactions of producers to the legal rules developed. Producers, as much as consumers, shape the way that shopping takes place. Thus, if we wish to pursue a more normative vision of trade mark law and shape the market, doctrines designed to encourage desirable *producer* behaviour may be more effective. Indeed, the Supreme Court hinted at this in *KP Permanent*, when it described vulnerability to the descriptive fair use defence as a price to be paid for adopting a descriptive mark.[165] Likewise, one of the motivations behind Prof Fromer's proposal on secondary meaning is to encourage the adoption and use of marks that better advance trade mark law's goals, namely, highly distinctive marks that create stronger product differentiation.[166]

Second, we might embrace a more normative view of trade mark law because we wish trade mark law *explicitly* to accommodate and recognise a number of concerns clearly at work within it. As a purely descriptive matter, in a variety of contexts, courts already effectively discount the existence of consumer association or the possibility of consumer confusion in order to effectuate broader objectives of trade mark and unfair competition law. For example, under the functionality doctrine, in order to protect competition, if a mark is functional it will be unprotected by trade mark law notwithstanding that it might have meaning for some consumers as a source-identifier.[167] And to ensure the ability to communicate truthful information about a product, the US Supreme Court in *KP Permanent* interpreted the fair use defence to allow a competitor to make a descriptive use of a mark even if such a use might confuse consumers.[168] Explicitly recognising the competitive values at play in these instances affords them a resonance that renders them more resilient in the face of changing empirical realities.[169] Compare what happens when those values

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[162] Stacey L Dogan & Mark A Lemley, "Parody as Brand" (2015) 105 Trademark Rep 1177 at 1212 n 150.

[163] Dinwoodie, "Trademarks and Territory", *supra* note 5 at 889–890 (describing as "proactive" an approach to trade mark law whereby "it proactively seek to shape the ways in which consumers shop and producers sell or seek to acquire rights, thus shaping how the economy functions").

[164] *Cf* Dogan & Lemley, "The Merchandising Right", *supra* note 20 at 487–488 (arguing that merchandising is a case in which the law should act as a norms creator).

[165] *KP Permanent*, *supra* note 48 at 122.

[166] Fromer, "Against Secondary Meaning", *supra* note 14 at 255.

[167] See, *eg*, *Wallace International Silversmiths, Inc v Godinger Silver Art Co, Inc* 916 F 2d 76 (2nd Cir, 1990).

[168] *KP Permanent*, *supra* note 48 at 122.

[169] This dynamic (which can also be detected in the growth of defensive doctrines) is one that supports the creation of affirmative defences. See Dinwoodie, "Developing Defenses", *supra* note 143 at [108].

are not raised to the surface of analysis. Consider infringement. Courts avoid excessive paternalism and allow competition when *implicitly* over-riding (some levels of) confusion by confining liability under classic trade mark infringement to uses that would confuse an "appreciable number of ordinarily prudent purchasers".[170] But values that might have affected determining that level of paternalism are often left unstated, impeding their fuller development and leaving those values more vulnerable to being overwhelmed by revised or more persuasive empirical assessments in later cases.

Third, relatedly, the incompleteness of a purely empirical mindset causes us to fail to recognise the *multiple and varied* interests at stake in trade mark disputes.[171] Many of the examples I have used in this Lecture have involved weighing protection of consumer understanding against competition. But the range of potentially conflicting normative concerns extends beyond competition and may reach past what we would think of as conventional trade mark matters: free speech,[172] integrity of the patent system,[173] expressions of personal identity,[174] public health concerns,[175] enabling artistic creativity,[176] comparative advertising,[177] a climate of certainty for innovators,[178] offering consumers choice,[179] avoiding the chill of abuse of rights in litigation,[180] respecting commercial ethics.[181] If one digs into case law, one can find these values, and many more, in trade mark history, with varying levels of judicial enthusiasm at different times.[182] But often, these are insufficiently considered as relevant values. Instead, they are cloaked in analyses of association or confusion, and it is not always clear that empirically framed doctrine offers enough breathing room for the proper contemplation of these values.

As seen with these last two rationales for making the normative character of trade mark law more explicit, identifying and isolating normative values is crucial to prevent the doctrinal mechanisms formally designed to advance empirical

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[170] *Mushroom Makers*, *supra* note 83 at 47.

[171] Or it might be regarded as normative myopia, because the empirical mindset might simply be a refusal to look beyond the normative goal of protecting consumer understanding. See *supra* note 2.

[172] See, *eg*, *Radiance Foundation, Inc v National Association for the Advancement of Colored People* 786 F 3d 316 (4th Cir, 2015) (political speech).

[173] See, *eg*, *Qualitex*, *supra* note 19 at 165 (circumvention of patent law).

[174] See, *eg*, *Matal v Tam* 137 S Ct 1744 at 1751 (2017) [*Tam*].

[175] See, *eg*, *Qualitex*, *supra* note 19 at 169 (discussing drug colour cases); *Shire US Inc v Barr Labs, Inc* 329 F 3d 348 at 355 (3rd Cir, 2003).

[176] See, *eg*, *Rogers*, *supra* note 149.

[177] See, *eg*, *Smith v Chanel, Inc* 402 F 2d 562 at 565 (9th Cir, 1968).

[178] See, *eg*, *Vornado Air Circulation Systems, Inc v Duracraft Corp* 58 F 3d 1498 at 1508 (10th Cir, 1995).

[179] See, *eg*, *Network Automation, Inc v Advanced Systems Concepts, Inc* 638 F 3d 1137 at 1145 (9th Cir, 2011).

[180] See, *eg*, *Samara*, *supra* note 13 at 214.

[181] See, *eg*, *Boston Hockey*, *supra* note 94 at 1011 (taking account of negotiations to authorise similar uses); *Oliveira v Frito-Lay, Inc* 251 F 3d 56 at 63 (2nd Cir, 2001) (reluctance to upset reasonable commercial expectations); *cf McDonald's Corp v Druck & Gerner, DDS, PC* 814 F Supp 1127 at 1135 (NDNY, 1993) (implausible denial of awareness).

[182] This is not meant to be an exhaustive list of relevant values. And some scholars have argued for a further-widened lens. See David E Adelman & Graeme W Austin, "Trademarks and Private Environmental Governance" (2017) 93(2) Notre Dame L Rev 709 (arguing that normative ends of private environmental governance should factor into trade mark policy).

assessments from becoming too dominant. The risk appears to have been most acute in infringement analysis. Thus, in some contexts, courts faced with an infringement claim implicating a broader suite of values have recognised the dilemma and have declined to slip into the rote mechanics of the empirical multifactor test. Instead, these courts have understood that this range of normative concerns requires the deployment of different doctrinal mechanisms.[183] This is another explanation for the *Rogers* defence. This defence has facilitated the unauthorised use of marks in expressive works such as movies, books, songs, and video games.[184] And it has done so by *replacing* the typical confusion assessment with a standard that finds infringement only with a much more troubling set of conduct by a defendant and is more amenable to summary resolution.[185]

It is *possible* that courts might have reached the right result in these cases by purely empirical assessments.[186] Most uses of marks in artistic works are not likely to cause confusion. But some courts struggle to understand the multifactor test as simply a heuristic designed to assist the ultimate inquiry.[187] Adopting a different (more normatively-driven) test helps to avoid that analytical straitjacket.[188] Sometimes the standard empirical mindset will simply fail adequately to recognise the different normative claim. The more complex normative equation required to resolve the diverse collection of contemporary trade mark disputes now presented to courts thus requires rules that are not tied exclusively to the empirical question of

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[183] This also partially explains the approach of the Ninth Circuit to nominative uses. See *Toyota Motor Sales, USA, Inc v Tabari* 610 F 3d 1171 at 1176 (9th Cir, 2010) [*Toyota*]; *cf Century 21 Real Estate Corp v Lendingtree, Inc* 425 F 3d 211 at 222 (3rd Cir, 2005) (revising traditional likelihood-of-confusion test to apply to nominative fair use cases and then framing supplementary defence).

[184] See, *eg*, *Twentieth Century Fox Television v Empire Distribution, Inc* 875 F 3d 1192 (9th Cir, 2017) (use on TV show and promotional music products); *Cliffs Notes, Inc v Bantam Doubleday Dell Publishing Group* 886 F 2d 490 (2nd Cir, 1989) (study books that imitated plaintiff's trade marked black and yellow covers); *ESS Entertainment 2000, Inc v Rock Star Videos, Inc* 547 F 3d 1095 (9th Cir, 2008) (video game); *Mattel, Inc v MCA Records, Inc* 296 F 3d 894 at 902 (9th Cir, 2002) (popular musical recording).

[185] This is particularly clear in the Ninth Circuit. See *Toyota*, *supra* note 183 at 1182. The Second Circuit still has regard to its multifactor confusion test in assessing whether a defendant's use is explicitly misleading under *Rogers*, see *Hermes International v Rothschild* 603 F Supp 3d 98 at 103 (SDNY, 2022) (collecting case law), which undermines some of the capacity of a *Rogers*-type defence to avoid chilling expression.

[186] See, *eg*, *Louis Vuitton Malletier SA v Haute Diggity Dog, LLC* 507 F 3d 252 at 263 (4th Cir, 2007) [*Louis Vuitton*] (recognising that the multifactor test is only a proxy for the ultimate statutory test and that, once the parodic nature of the defendant's use was taken into account, the factors counseled in favor of a different outcome).

[187] *Cf Network Automation, Inc v Advanced Systems Concepts, Inc* 638 F 3d 1137 at 1145 (9th Cir, 2011) ("the *Sleekcraft* factors are intended as an adaptable proxy for consumer confusion, not a rote checklist").

[188] Another instinct in some unusual confusion contexts has been to tweak the existing empirical framework. For example, several courts have reformulated their standard multifactor confusion test when the plaintiff alleges so-called reverse confusion. See *A & H Sportswear, Inc v Victoria's Secret Stores, Inc* 237 F 3d 198 (3rd Cir, 2000); *Wreal, supra* note 16 at 121. In reverse-confusion cases, the plaintiff is usually a commercially smaller, but senior, user of the mark at issue. The alleged harm in such cases is not that the defendant is free riding on the plaintiff's goodwill; rather the harm is the plaintiff's loss of control over its goodwill when the market is swamped by the larger junior user. See Jeremy N Sheff, "Reverse Confusion and the Justification of Trademark Protection" (2022) 30 Geo Mason L Rev 123 at 127.

consumer association or confusion.[189] In short, for a number of reasons, adopting a less empirical approach creates more room for the competing concerns to be given full weight.

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The Supreme Court in *Jack Daniel's* has, in ways as yet unclear, recently limited the scope of *Rogers*. And, given that *Rogers* exemplified so well a more normative approach to trade mark law, the court might also have spoken indirectly on the viability of such an approach. Thus, before offering a more optimistic conclusion, it is worth a brief review of *Jack Daniel's*.

The decision is quite enigmatic and may well affect a number of structural aspects of trade mark law. However, for current purposes, the court clearly has endorsed continued attention to the confusion metric (rather than applying *Rogers*) in cases where the defendant had engaged in a so-called "trademark use".[190] The court even declined to decide whether *Rogers* applied as a threshold question in other cases (presumably, infringement based upon non-trade mark use by a defendant).[191]

It will take some time for the full implications of the court's decision to become clear. But the formal scope of the *Rogers* defence has obviously been cabined in part by "trademark use", a concept lacking much clarity and not well defined by the *Jack*

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[189] *Rogers*, *supra* note 149 at 999–1000 (articulating new test as a balancing inquiry to limit liability to "where the public interest in avoiding consumer confusion outweighs the public interest in free expression" and thus "[accommodate] consumer and artistic interests").

[190] *Jack Daniel's*, *supra* note 24 at 159 (noting this to be the approach except "potentially in rare situations", although giving no guidance on what those situations might be).

[191] According to some scholars, this might be a small (and perhaps non-existent) subset of uses as a result of another recent Supreme Court decision, *Abitron Austria GmbH v Hetronic Int'l, Inc* 216 L Ed 2d 1013 (2023) [*Abitron*]. *Abitron* strictly addressed only the territorial reach of the Lanham Act. But in concluding that the statute did not apply to conduct abroad, the court held that "the infringing 'use in commerce' of a trademark provides the dividing line between foreign and domestic applications of these provisions". *Ibid* at *9 (Alito J). The court then blended the statutory definitions of "use in commerce" and "trademark" and explained that "under the Act, the "term 'use in commerce' means the bona fide use of a mark in the ordinary course of trade", where the mark serves to "identify and distinguish [the mark user's] goods … and to indicate the source of the goods." *Ibid*. Some have suggested that in drawing the dividing line between foreign and domestic applications of these provisions, the court also demarcated the substantive reach of the statute. See Margaret Chon & Christine Haight Farley, "Trademark Extraterritoriality: Abitron v. Hetronic Doesn't Go the Distance", *Technology and Marketing Law Blog* <https://blog.ericgoldman.org/archives/2023/07/trademark-extraterritoriality-abitron-v-hetronic-doesnt-go-the-distance-guest-blog-post.htm> (17 July 2023) ("henceforth 'use in commerce' means use in commerce as a trademark … The *Abitron* Court appears to have overruled the Second Circuit on this point and may have—without realizing it—reopened the trademark use debate."). Both decisions (issued within three weeks of each other) suggest that the court regards whether a defendant has made "trademark use" as relevant to liability. But whereas *Jack Daniel's* proceeds on the premise that non-trade mark uses might give rise to liability under the Lanham Act, the language cited by Chon and Farley would preclude that possibility. The Second Circuit has previously explained why the tortured text of the statute supports the entirely clear legislative history that trade mark use is not a precondition to liability. See *Rescuecom Corp v Google Inc* 562 F 3d 123 (2nd Cir, 2009) [*Rescuecom*]. But as the issue of "trademark use" was not briefed in *Abitron* (unlike *Rescuecom*) it may not be a surprise that none of the textualists on the court got the point. In any event, if *Abitron* is seen as having significance for other domestic purposes, reconciling the two cases will require a complicated reading of the Lanham Act.

Daniel's court.[192] Lower courts will now be tasked with articulating the concept of "trademark use" to help define at least the application of the *Rogers* defence (just as they have had to do, with little determinacy, in delineating the scope of the fair use defence applicable to uses "otherwise than as a mark").[193] This might have the appearance of an empirical inquiry not entirely separate from the confusion question, which is one of the weaknesses of a trade mark use doctrine if its purpose is to facilitate summary dismissal.[194] But it will also implicate normative matters tied to the contested concept of "trademark use". For example, is a use that causes confusion as to affliation or endorsement a trade mark use?[195]

Jack Daniel's might be thought to exacerbate the empirical fixation by making the multifactor test of likely confusion the sole vehicle for determining infringement in cases where the defendant has made use of the plaintiff's mark as a mark. But it is unclear how lower courts might adapt the confusion test to validate expressive concerns.[196] Lower courts will be under pressure to implement the policy purposes underlying *Rogers* in the application of the confusion test to an infringement case involving a defendant's use of the plaintiff's mark as a source-identifier. The result might be a move to a far more normative assessment of likely confusion.[197] If this is the case, more explicit articulation of the normative values will be crucial if those cases are to jumpstart the inductive process that we have seen previously seen in the development of helpful defences.[198]

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[192] See *Jack Daniel's*, *supra* note 24 at 1587 (Kagan J) ("Without deciding whether *Rogers* has merit in other contexts, we hold that it does not when an alleged infringer uses a trademark in the way the Lanham Act most cares about: as a designation of source for the infringer's own goods"); Graeme B Dinwoodie & Mark D Janis, "Confusion Over Use: Contextualism in Trademark Law" (2007) 92 Iowa L Rev 1597 at 1641–1650 [Dinwoodie & Janis, "Confusion Over Use"] (exploring ambiguities of "trademark use"); *Jack Daniel's*, *supra* note 24 at 1591 (Kagan J) ("VIP's conduct is its own admission that it is using the Bad Spaniels (née Jack Daniel's) trademarks as trademarks, to identify product source").

[193] See, *eg*, *Kelly-Brown v Winfrey*, 717 F 3d 295 (2nd Cir, 2013); *Fortune Dynamic, Inc v Victoria's Secret Stores Brand Mgmt, Inc* 618 F 3d 1025 at 1041 (9th Cir, 2010).

[194] See Dinwoodie & Janis, "Confusion Over Use", *supra* note 192 at 1648; Mark P McKenna, "Trademark Use and the Problem of Source" (2009) U Ill L Rev 773.

[195] See Dinwoodie & Janis, "Confusion Over Use", *supra* note 192 at 1653–1655.

[196] *Jack Daniel's*, *supra* note 24 at 15891–15892 (Kagan J) ("But a trademark's expressive message—particularly a parodic one, as VIP asserts—may properly figure in assessing the likelihood of confusion … Yet to succeed, the parody must also create contrasts, so that its message of ridicule or pointed humor comes clear. And once that is done (if that is done), a parody is not often likely to create confusion. Self-deprecation is one thing; self-mockery far less ordinary. So although VIP's effort to ridicule Jack Daniel's does not justify use of the *Rogers* test, it may make a difference in the standard trademark analysis.").

[197] *Cf ibid* at 1587 (Kagan J) (noting that the confusion inquiry "is not blind to the expressive aspect of the Bad Spaniels toy" but apparently grounding this in the lesser *factual* likelihood of confusion); *Louis Vuitton*, *supra* note 186.

[198] A number of other issues pending in the lower courts will also present courts and litigants the option of falling back on empiricism or grappling more openly with hard normative choices. As three examples, consider the attack on merchandising rights of colleges and cultural institutions; see *Pennsylvania State University v Vintage Brand, LLC* 614 F Supp 3d 101 (MD Pa, 2022); efforts by sneakers manufacturers to stop customisation of shoes, see *Vans, Inc v MSCHF Prod Studio, Inc* 602 F Supp 3d 358 at 364 (EDNY, 2022); and whether a rejection of a registration based on "failure to function" can be overcome by proof of secondary meaming, see *In re Lizzo LLC* 23 USPQ 2d 139 (TTAB, 2023) (reversing refusal of an application by the singer Lizzo to register "100% THAT BITCH" for T-shirts).

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Finally, let me conclude with three developments that might prompt more normative engagement by US courts. Each of these developments might on its own generate opportunity for courts to do so. And, more dynamically, one might even foresee cross-pollination between the case law arising in all three contexts as each may induce judicial articulation and balancing of the interests and harms implicated by trade mark law.

First, almost a decade ago, the US Supreme Court in *Lexmark International, Inc v Static Control Components, Inc* set out when a plaintiff had standing to bring a false advertising case under § 43(a)(1)(B) of the Lanham Act.[199] Some courts have extended that same standard to actions under § 43(a)(1)(A) for unfair competition or infringement of unregistered trade marks.[200]

According to *Lexmark*, standing to bring a claim will require analysis of the "zone of interests" protected by the Lanham Act as well as demonstrating the causal nexus between a defendant's conduct and injury to the plaintiff.[201] This may well precipitate analysis by courts of what harms have been suffered by plaintiffs in particular cases, raising to the surface normative questions presently buried in mechanical assessments of confusion under the multifactor test.[202] Indeed, in the one appellate decision to date that has pursued this argument in detail, the Fourth Circuit endorsed a cause of action for unfair competition that is broader than trade mark law, but limited by proof of causation and harm – and which might contemplate a different array of remedies than typical in a trade mark infringement case.[203] Intriguingly,

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199 572 US 118 at 129–131 (2014) [*Lexmark*].

200 See, *eg, Belmora LLC v Bayer Consumer Care AG* 819 F 3d 697 at 708 (4th Cir, 2016) [*Belmora*]; *cf Meenaxi Enter, Inc v Coca-Cola Co* 38 F 4th 1067 at 1069 (Fed Cir, 2022) (applying *Lexmark* standard in cancellation proceeding).

201 *Lexmark*, *supra* note 199 at 129–131.

202 The Supreme Court has since emphasised outside the context of the Lanham Act that formal Article III standing requires "concrete harm". See *TransUnion LLC v Ramirez* 141 S Ct 2190 at 2204 (2021) [*TransUnion*]. The defendant in *Lexmark* conceded that the plaintiff alleged harm sufficient to confer Article III standing (the issue later addressed in *TransUnion*) and instead based its argument on the doctrine of "prudential standing". Although the *Lexmark* court formally disowned that concept, the court largely replicated the dictates of prudential standing through interpretation of the statutory authorisation of a cause of action in § 43(a) to "any person who believes that he or she is likely to be damaged". *Lexmark*, *supra* note 199 at 128–129. Some of the analysis that might be provoked by invocation of *Lexmark* might also be triggered by arguments under *TransUnion*. See Note: "Trademark Injury in Law and Fact: A Standing Defense to Modern Infringement" (2021) 135(2) Harv L Rev 667 (arguing that the "modern conception of likely confusion flunks the concrete-harm test" announced in *TransUnion*).

203 *Belmora*, *supra* note 200 at 708. *Belmora* has not been without its critics. See, *eg,* Christine H Farley, "No Trademark, No Problem" (2017) 23(2) BUJ Sci & Tech L 304. But these critiques have focused more on whether the Fourth Circuit's application of *Lexmark* properly took account of the principle of territoriality than questioning the relevance of *Lexmark*. See *ibid* at 313. Indeed, these criticisms serve only to accentuate the space that *Lexmark* opened up for judicial consideration of competing values; the territoriality of trade mark law is not as simple a proposition as it might first seem. See Dinwoodie, "Trademarks and Territory", *supra* note 5 at 892–893 (arguing that "the principle of territoriality is a vessel for a variety of related propositions"); see also Graeme B Dinwoodie, "Developing A Private International Intellectual Property Law: The Demise of Territoriality?" (2009) 51 Wm & Mary L Rev 711.

this is the type of doctrinal structure seen in *Kellogg*, which more openly allows for a blend of the descriptive and the normative.[204]

Second, litigants continue to press challenges to provisions of the Lanham Act under the First Amendment in the wake of the US Supreme Court decisions in *Tam* and *Brunetti*.[205] In those cases, the court struck down provisions prohibiting registration of marks that were disparaging to groups of persons (*Tam*) or scandalous and immoral (*Brunetti*).[206] And the Supreme Court has just agreed to hear the appeal of a Federal Circuit decision upholding a challenge to § 2(c) of the Lanham Act, which prohibits registration of a mark that "[c]onsists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent".[207]

These cases to date have not elicited a clear answer from the court on the test it will apply to subsequent First Amendment challenges to trade mark laws.[208] The relevant metric for assessing the compatibility of trade mark protection with the First Amendment was potentially at issue in *Jack Daniel's*, but the court avoided the core First Amendment question in language reminiscent of the "traditional contours" passage found in the court's *Eldred* copyright opinion.[209] In that respect, and indeed in many others, the Supreme Court opinions in *Tam*, *Brunetti* and *Jack Daniel's* were thoroughly unsatisfying.[210] But the success of the free speech claims

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[204] Dinwoodie, "Story of Kellogg", *supra* note 138 at 231–233.

[205] 139 S Ct 2294 (2019) [*Brunetti*].

[206] *Tam*, *supra* note 174; *Brunetti*, *supra* note 205.

[207] *In re Elster* 26 F 4th 1328 (Fed Cir, 2022) (upholding as-applied challenge to denial of registration of "TRUMP TOO SMALL" for T-shirts by person not named Trump), petition for *certiorari* granted *sub nom Vidal v Elster* 91 USLW 3316 (2023).

[208] *Tam*, *supra* note 174 at 1764 n 17 (Alito J) (leaving open the question of the appropriate test for deciding free speech challenges to provisions of the Lanham Act); *ibid* at 1768 (Kennedy J, concurring) ("This case does not present the question of how other provisions of the Lanham Act should be analyzed under the First Amendment. It is well settled, for instance, that to the extent a trademark is confusing or misleading the law can protect consumers and trademark owners").

[209] See *Jack Daniel's*, *supra* note 24 at 1590–1591 (Kagan J) ("when 'another's trademark (or a confusingly similar mark) is used without permission' as a means of 'source identification' … the First Amendment does not demand a threshold inquiry like the *Rogers* test. When a mark is used as a mark (except, potentially, in rare situations), the likelihood-of-confusion inquiry does enough work to account for the interest in free expression."). It might be that we are approaching a moment of inflection in the relationship between trade mark and the First Amendment not unlike that presented to the court in a pair of copyright cases starting two decades ago. See *Eldred v Ashcroft* 537 US 186 at 221 (2003) (Ginsburg J) ("To the extent such assertions raise First Amendment concerns, copyright's built-in free speech safeguards are generally adequate to address them. [The] D.C. Circuit spoke too broadly when it declared copyrights 'categorically immune from challenges under the First Amendment.' But when, as in this case, Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary"); *Golan v Holder* 565 US 302 at 329 (2012) (rejecting call for heightened review when traditional speech-protective contours of copyright preserved). The only somewhat analogous treatment of the issue by the court in the trade mark context, see *San Francisco Arts & Athletics, Inc v US Olympic Committee* 483 US 522 (1987) (upholding statute conferring on US Olympic Committee the exclusive use of the word "Olympic" against even non-confusing uses did not violate the First Amendment), occurred in an era where First Amendment jurisprudence was quite different.

[210] Compare, *eg*, *Tam*, *supra* note 174 at 1752–1753 (Alito J, joined by Roberts CJ) (First Amendment implicated despite potential ability to bring action under § 43(a) because of benefits of registration) with *Brunetti*, *supra* note 205 at 2303 (Roberts CJ, concurring in part and dissenting in part) (refusing

in those cases will likely fuel a challenge to, among other things, the trade mark dilution provision.[211] Dilution protection does not turn on the the likelihood-of-confusion inquiry that Justice Kagan in *Jack Daniel's* thought "does enough work to account for the interest in free expression".[212] Thus, the court will not be able to avoid articulating a test. Almost regardless of the test on which the court settles for assessment of the constitutionality of trade mark laws, defending such a challenge should force the trade mark owner and the federal government to articulate the purpose of protection and defend the nexus between the harm at issue and the relief provided.[213] This form of analysis inevitably will require normative framings.

Third, the reinterpretation of the effect of the Supreme Court decision in *eBay Inc v MercExchange, LLC*[214] after the statutory reintroduction of the presumption of irreparable injury in trade mark cases is an area where we might expect ongoing normative contestation.[215] Prior to the Trademark Modernization Act 2020,[216] there was a period of just over a decade after *eBay* where courts had begun to demand more of trade mark owners in order to secure injunctive relief.[217] The full effects of

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registration to obscene marks does not offend the First Amendment because "whether such marks can be registered does not affect the extent to which their owners may use them in commerce to identify goods. No speech is being restricted; no one is being punished. The owners of such marks are merely denied certain additional benefits associated with federal trademark registration.").

211 See Lisa P Ramsey, "Free Speech Challenges to Trademark Law After *Matal v. Tam*" (2018) 56 Hous L Rev 401 at 461 (discussing challenge to dilution).

212 See *Jack Daniel's*, *supra* note 24, at 1590–1591 (Kagan J); Dinwoodie, "Developing Defenses", *supra* note 143 at 108, 144 (commenting that "the sense that the proscription of trademark law does [] totalizing work [in protecting a range of values] pervades judicial decisions" but warning that "relying on judicial interpretation of the proscription to establish limits on protection is dependent on the elements of the prima facie claim capturing accurately, capturing coherently, and capturing all of, the social policy objectives implicated by third party uses of marks. If that premise is wrong, then even a purposive statement of the prima facie cause of action cannot ameliorate the need for affirmative defenses in trademark and unfair competition law").

213 Given the issues at stake in *Tam* and *Brunetti*, the interests canvassed by the court were tied to the purposes behind (denial of) registration; the same will be true in *Elster*. Future cases will surely require consideration of the purposes of substantive trade mark protection. This came up only obliquely in *Tam* and *Brunetti* and the court largely avoided the question in *Jack Daniel's.* See *Jack Daniel's*, *supra* note 24 at 1590–1591 (Kagan J). Likewise, the nexus between those objectives and the form of scope of protection will be key. *Cf Brunetti*, *supra* note 205 at 2306 (Breyer J concurring in part and dissenting in part) ("[T]he trademark statute does not clearly fit within any of the existing outcome-determinative categories. Why, then, should we rigidly adhere to these categories? Rather than puzzling over categorization, I believe we should focus on the interests the First Amendment protects and ask a more basic proportionality question: Does 'the regulation at issue wor[k] harm to First Amendment interests that is disproportionate in light of the relevant regulatory objectives'").

214 547 US 388 (2006) [*eBay*].

215 *Ibid* (rejecting the "categorical" approach of the Court of Appeals for the Federal Circuit that as a "general rule courts will issue permanent injunctions against patent infringement absent exceptional circumstances" and instead stressing that the Patent Act indicates "that injunctive relief 'may' issue only after consideration of: (1) whether the plaintiff has suffered an irreparable injury; (2) whether remedies at law, such as monetary damages, are inadequate to compensate; (3) whether considering the balance of hardships between the plaintiff and defendant, a remedy in equity is warranted; and (4) whether the public interest would not be disserved by a permanent injunction").

216 Pub L No 116–260, §§ 221–228, 134 Stat 1182 (2020).

217 The precise effect of e*Bay* in trade mark cases was not clear. But a number of courts extended *eBay* in some form to the trade mark context. The effect was dramatic for the grant of injunctions in some circuits. See, *eg*, *Herb Reed Enterprises, LLC v Florida Entertainment Management, Inc* 736 F 3d 1239

eBay (as received into trade mark law) have been modified by the 2020 legislation. Congress amended § 34 of the Lanham Act to reincorporate a rebuttable presumption of irreparable harm. Thus, § 34 now provides that a plaintiff seeking injunctive relief is entitled to a rebuttable presumption of irreparable harm upon a finding of a Lanham Act violation (in the case of a permanent injunction) or upon a finding of a likelihood of success on the merits (in the case of a preliminary injunction or temporary restraining order).[218] But it remains to be seen whether a decade of truly considering the open-ended standards of balance of hardships and public interest as elements of injunctive relief analysis will have stimulated courts to make more open normative assessments when defendants argue that they have rebutted the reinstalled presumption of irreparable harm.[219]

IV. Conclusion

My identification of these entry points where trade mark courts might find the room to think harder about trade mark law as a normative project is, of course, somewhat speculative. And in light of the Supreme Court decision in *Booking.com*, they may be unduly hopeful.

But, to return for a moment to Tom Stoppard and the *Invention of Love*, I do hope that courts exhibit some of Wilde's skepticism of so-called facts – and not just because they are to be found in the *Evening Standard*. Our search for a better trade mark law will require instead that we continue to imagine openly a more normative regime. I'm not sure I can really claim that the result will be a "truth". Because trade mark law is not really about truth. At the very least, it's surely about more than a single truth. And it is certainly about so much more than mere facts.

(9th Cir, 2013) (although "evidence of loss of control over business reputation and damage to goodwill could constitute irreparable harm" proof of likely confusion might not be sufficient proof of irreparable harm). See generally Mark A Lemley, "Did eBay Irreparably Injure Trademark Law?" (2017) 92 Notre Dame L Rev 1795.

[218] The Act also includes a "rule of construction" stating that the amendment to § 34(a) "shall not be construed to mean that a plaintiff seeking an injunction was not entitled to a presumption of irreparable harm before the date of enactment of this Act".

[219] Early post-amendment case law tentatively suggests that the legislative fix has not fully reinstalled the pre-*eBay* position in trade mark cases. See, *eg*, *Nichino Am, Inc v Valent USA LLC* 44 F 4th 180 (3rd Cir, 2022).