

UIC John Marshall Journal of Information Technology & Privacy Law

Volume 25
Issue 4 *Journal of Computer & Information Law*
- Symposium

Article 6

2008

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Recommended Citation

Sheldon Halpern, *The Supreme Court's Trademark Jurisprudence: Categorical Divergence In The Interest of Information Convergence*, 25 J. Marshall J. Computer & Info. L. 635 (2008)

<https://repository.law.uic.edu/jitpl/vol25/iss4/6>

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THE SUPREME COURT'S TRADEMARK JURISPRUDENCE: CATEGORICAL DIVERGENCE IN THE INTEREST OF INFORMATIONAL CONVERGENCE

SHELDON HALPERN*

Notwithstanding the rather pretentious title, perhaps a more appropriate subtitle for those who are familiar with trademark law, would be "The Labors of Job[s Daughters]". I have been struck by what has happened to trademark law and its influence on American life, if not universal life.

I started teaching trademark law a good number of years ago at Ohio State, only because no one was doing it and I felt it needed to be taught. I didn't really want to do it and I expected to be bored, but instead I found it to be very, very interesting, and over the years it's gone from being very interesting to perhaps vital. That sounds portentous, but let me back up a step. Portentous is something like what Bobbi[Kwall] is doing with moral rights because it implicates our view of the artistic person, integrity, creativity, all those very important things. Copyright law, which is really where I devote most of my energies, sets up the infrastructure of our society, of our culture. These are important things; they are issues that you might want to lose sleep over. Battle lines were drawn over the Sonny Bono Copyright Term Extension Act; blood was shed. Trademark law and the related issue of the right of publicity are just about money. That's all it is.

I was asked a few years ago to review a book by a Brit, actually a Welshman, which produced a dedication page that I couldn't understand

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because of all the “L’s” in it, about the right of publicity in the U.K. The book had all of these terribly, terribly heavy arguments, and I concluded the review by saying it’s a perfectly fine book, but I just wish he’d lighten up. The book is not *that* serious, and in many ways, it is fun, but some serious things have actually happened within trademark law.

One can go back to the founding of the Lanham Act, to the inclusion of Section 43(a), but for whatever reasons, we have had a continuing expansion in the scope of trademark law; a major shift, in many ways, from the basic concept of trademark rights as rights appurtenant. Trademark rights, not property rights, are rights appurtenant to other things. You don’t have an absolute, so that if you try simply to grant a blanket sale of a trademark, you lose the mark. You’ve committed this pornographic sin of conveying a naked license; that’s the traditional doctrine. Then there are all kinds of expansive cases, conclusions, doctrines – whatever you want to call them – that resulted in an expansive trademark law and Section 43(a) specifically became a vehicle for rights that were otherwise not necessarily recognized.

The first shot at recognizing something equivalent to moral right didn’t come from copyright; it came from some trademark cases. Thus the attribution right was elevated into a Section 43(a) claim. This expansion continued with very, very broad language from the United States Supreme Court culminating in the *Qualitex Co. v. Jacobson Products Co.* opinion.¹

Then into the mix came that wonderful acronym FTDA, the Federal Trademark Dilution Act which, if one overlooks the incredibly bad drafting of the International Trademark Association, was an attempt to create some kind of independent property right in trademark.² I’m a little heretical because I am among that handful of surviving academics who actually believe that copyright is a good thing, trademark law is a good thing, the right of publicity is a good thing, and that it is not evil to enforce these rights.

Nevertheless, something weird seemed to be happening. And of all things the United States Supreme Court, not this great font of wisdom with respect to intellectual property, in a series of cases, recognized that something wrong was happening. The Court recognized it first in the *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.* opinion, in which Justice Scalia does something that I suppose someone else wouldn’t have dared to do.³ In a very, very brief opinion, Justice Scalia simply says, in essence: “I’ve decided that a categorical rule is better than nothing; I want a new categorical rule. That categorical rule is: There is no such thing as

1. 514 U.S. 159 (1995).

2. 15 U.S.C. § 1125 (2006).

3. 529 U.S. 205 (2000).

inherently distinctive trade dress.”⁴ When he’s faced with Supreme Court precedent that said “yes there is,” he says: “Well that case wasn’t about trade dress” (the design of a Mexican restaurant).⁵ However, it was. Instead he says: “But anyway if it wasn’t trade dress, it was product packaging, and if it wasn’t that, it was some ‘tertium quid’ (which people might think is a three pound note), or something else.”⁶ He in effect was saying: Pull back, pull back, what are the risks? In other words, the risks of saying you can do it, of giving the trademark owner rights, far exceed the risks we have to the public, to the consumer by granting those rights.

We moved another step in the trade dress area, a step that was far more significant because of the conceptual underpinning. This is Justice Kennedy’s opinion in *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, which related to a trademark claim with respect to features of a product that had been included in the claims of an expired utility patent.⁷ The Court took the case in order to resolve a dispute in the circuits over whether the fact of the existence of a prior utility patent made it conclusive evidence of functionality, precluding protection, or had no effect at all, or did something with respect to the burden of proof of functionality. Essentially, the Court said: We have to be careful about the lines drawn between trademark and patent law and we really can’t let trademark law encroach on patent law - that’s why we have our Doctrine of Functionality in the first place.⁸ One would think the quote would then say: “Therefore, the fact that a claim was included in a utility patent is conclusive evidence of its functionality.” However, the Court doesn’t say that. Instead it says that: “It’s strong evidence, there is a heavy burden on the Plaintiff,” and then basically says one way to discharge that burden is to demonstrate that these features are purely ornamental.⁹ Well, that’s another way of saying the only way you can really avoid losing your trademark in these circumstances is to demonstrate that the patent never should have been granted. This is how the Supreme Court says something is wrong, while journeying through the *Qualitex* case and the cases before it and making sweeping determinations about the broad scope of trademark protection. We’re not sure, however, that’s right anymore.

Then came the really startling opinion in *Dastar Corp. v. Twentieth Century Fox Film Corp.*¹⁰ Again, Justice Scalia simply says: “I’ve got a

4. *Id.*

5. *Id.*

6. *Id.* at 214.

7. 532 U.S. 23 (2001).

8. *Id.*

9. *Id.*

10. 539 U.S. 23 (2003).

new rule; you want to tell me it's not a new rule, but I won't listen to you. It's a rule, it's a new rule, it's a good rule." He says: "My rule is that origin means the place the thing comes from, not the place its intellectual content comes from."¹¹ By having such a rule, we prevent trademark law from encroaching on copyright law; we're not going to let you use a trademark claim to give life to a bad copyright claim.¹² Just like we will not let you use a trademark claim to give life to a bad patent claim.¹³ Justice Scalia cites a couple of cases that seem at first glance to have nothing to do with any of this. He cites *Sears, Roebuck & Co. v. Stiffel Co.*¹⁴ and *Compco Corp. v. Day-Brite Lighting, Inc.*,¹⁵ as well as the preemption cases. However, in doing that, he's giving a message and saying we've got a constitutional underpinning requiring a limitation of trademark rights. True, this isn't a preemption case, but we meant it back then when we said there are different realms of intellectual property and if something really belongs in the realm of trademark it should be in trademark. If it really belongs in the realm of copyright then it should be in copyright, and it stands or falls in that realm. Patent is similar to this as well.

Dastar thus raises a whole slew of questions, including what happens to the older attribution cases, the so-called paternity cases, the quasi-moral right cases that were based on an interpretation of Section 43(a) that seem to have a totally different take on origin.

Finally, I want to return to my "Labors of Job's Daughters" reference. Because this leads to what, for me, is a heretical position which says: Rights such as trademark rights and correlative rights, such as the right of publicity, are rights appurtenant. No less, certainly, but no more than that.

More than twenty years ago I coined, not terribly creatively, a phrase describing the right of publicity and I called it, "associative," because it recognizes the "associative value" of a persona. Just as a trademark is a right appurtenant to certain goods or services, and not an independent thing that stands all by itself. Thus, if you don't have something that is *associating* the persona with goods or services, the right is not implicated.

The association need not necessarily be an endorsement, after all you don't need to endorse something to be associated with it. If you say that Madonna hates my product I'm still associating her personality, her persona, in connection with my product. Consider the distinction be-

11. *Id.*

12. *Id.*

13. *Id.*

14. 376 U.S. 225 (1964).

15. 376 U.S. 234 (1964).

tween having Tiger Woods' name on a set of golf clubs and selling a photograph or a painting of Tiger Woods. There is a distinction between a trademark on some goods and a logo, a patch, or the Job's Daughters ring standing alone, without the "goods." A long time ago the Ninth Circuit, in the *Job's Daughters* case, said it's not infringing the trademark to sell the mark itself (in the form of the ring) as opposed to associating it with goods or services. In doing so it disapproved sharply of the Fifth Circuit's opinion in *Boston Professional Hockey Association v. Dallas Cap & Emblem Manufacturing, Inc.*, which basically said: "Yeah, selling the mark itself implicates trademark rights, even though we have to stretch to determine what source or origin is."¹⁶ I'm suggesting that a rational look at trademark and the right of publicity both would indicate that we should not treat them as freestanding rights apart from their associative or appurtenant value. This should mean that while you cannot sell a Tiger Woods golf club without Tiger Woods' consent, you should be able to sell a picture of Tiger Woods, whether we're dealing with a trademark claim, a publicity claim, or any other kind of claim. It's an attempt to find a rational basis and some rational boundary for these rights.

The boundaries are difficult issues to rationalize, but the Supreme Court's constitutional line drawing helps, which is what Justice Scalia was doing in *Dastar* when he referred to the *Sears-Compco* cases. The boundaries arise in a constitutional context, and reflect what a couple of courts are now doing (I think not analytically correctly but nevertheless, doing) with the right of publicity on a constitutional First Amendment basis. Nevertheless, this provides us with some rational basis for first separating trademark claims from right of publicity claims, and at the same time, continuing to think in terms of both of these rights as appurtenant rather than absolute rights. That is, consider a right of publicity claim or a trademark claim as not enforcing independent property rights, but rights that involve other factors beyond the property itself. As such, I think we can then avoid an awful lot of the problems that appear to exist today.

16. 510 F.2d 1004 (5th Cir. 1975)

