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WHAT TRADEMARK LAW COULD LEARN FROM EMPLOYMENT LAW

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ABSTRACT

Trademark litigation is as unpredictable as it is expensive. The Trademark Trial and Appeal Board ("Board") considers as many as thirteen different factors when evaluating whether a trademark causes a "likelihood of confusion." Federal courts use many of the same factors, though which factors are chosen differ by jurisdiction, and, do not necessarily overlap with the Board. Further, a party can litigate for a time before the Board, then in federal court, and then back before the Board. And, if this were not enough, the Board's decisions have little if any preclusive effect on the court, and, a court's decision is not necessarily binding on the Board. The natural consequences of this chaos are forum shifting, highly unpredictable outcomes, and inflated costs of litigation. What trademark law needs is a framework to provide structure, guidance and expedience, and to eliminate redundancy. This is precisely what employment law is predicated on.

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INTRODUCTION

Employment litigation runs like a well-oiled machine. Charges of discrimination are filed, mediated or conciliated, and investigated.[1] Some end up in court, but few actually go to trial.[2] And there is no bouncing back and forth between the administrative agency established by Congress to do the heavy lifting in employment cases, the Equal Employment Opportunity Commission, and a federal court with the jurisdiction and authority to decide charges on the merits.[3] Once in federal court, the machine runs particularly well: In the vast majority of cases, there is an order to the litigation that provides cadence and plenty of timing.[4] First, the plaintiff offers proof, which is followed by the defendant's rebuttal, and finally, the plaintiff gets one more chance to raise a genuine issue of material fact for trial.[5]

Contrast that to the chaos and disorder of the way trademark cases are litigated in the intellectual property world. An administrative board also exists to hear claims of likely confusion between marks,[6] which is termed "infringement" if the case lands

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[1] Equal Employment Opportunity Act of 1972, 42 U.S.C. § 2000e-5(b) (2012). As discussed in this article, the Equal Employment Opportunity Commission ("EEOC") does this work after the charge is filed. *Id.*

[2] Brill v. Lante Corp., 119 F.3d 1266, 1270 (7th Cir. 1997) (stating that more than 90% of employment cases are resolved before trial); *see also* STATISTICS DIV. OFFICE OF JUDGES PROGRAMS, ADMIN. OFFICE OF THE U.S. COURTS, 2011 ANNUAL REPORT OF THE DIRECTOR: JUDICIAL BUSINESS OF THE UNITED STATES COURTS 149 (2012), *available at* http://www.uscourts.gov/uscourts/Statistics/JudicialBusiness/2011/JudicialBusiness2011.pdf (displaying the percent of cases that go to trial during that fiscal year based on the nature of the suit filed).

[3] *See* Major Steven M. Ranieri, *"If At First You Don't Succeed . . . ": An Argument Giving Federal Agencies the Ability to Challenge Adverse Equal Employment Opportunity Commission Decisions in Federal Court*, ARMY LAW., Sept. 2008, at 23, 23 ("[T]he EEOC's determination is final, unless a complainant is dissatisfied with the decision and seeks a trial de novo in federal court.").

[4] McDonnell Douglas Corp. v. Green, 411 U.S. 792, 802–03 (1973) (explaining the process of establishing a prima facie case and the subsequent burden shifting that follows); *see also Brill*, 119 F.3d at 1270 (referring to the *McDonnell Douglas* "relay" that the courts often face in these cases and describing it as a "necessary schematic").

[5] *See McDonnell Douglas*, 411 U.S. at 802–03.

[6] U.S. PAT. & TRADEMARK OFFICE, U.S. DEP'T OF COMMERCE, TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE §§ 102.01, .02 (3d ed. Rev. 1, June 2012) [hereinafter TBMP] ("The Trademark Trial and Appeal Board is an administrative tribunal of the United States Patent and Trademark Office. . . . The Board has jurisdiction over four types of inter partes proceedings, namely, oppositions, cancellations, interferences, and concurrent use proceedings."); *see also* 37 C.F.R. § 2.127(c) (2012) ("Interlocutory motions, requests, and other matters . . . may be acted upon by a single Administrative Trademark Judge of the Trademark Trial and Appeal Board . . . . ").

in court,[7] and the agency exists in a parallel or alternative universe from courts. Plaintiffs can litigate in both worlds or in only one, in no particular sequence. Once in either the administrative world of the Trademark Trial and Appeal Board or a federal court, there is no equivalent well-running machine. Quite the opposite is true: Both parties operate at the mercy of a hodgepodge of decisive trademark factors that will decide the ultimate issue with no particular understanding as to what factors matter most and, indeed, how many there are in the first place.[8]

If the intellectual property world of lawyers, scholars and judges are willing, they could learn a lot from the way in which employment cases are litigated. That kind of interdisciplinary learning is not common in litigation practice, especially in these two highly specialized areas.[9] But intellectual property lawyers should be willing to ask whether they would benefit from the kind of machine that employment lawyers and judges, with considerable help from the Supreme Court,[10] have built and used for decades to advance and defend claims, decide cases, and hopefully, distribute justice.[11] The question is: Are these lawyers willing?

I. HOW EMPLOYMENT LITIGATION WORKS

An employee cannot simply march into federal court, or state court for that matter, once he concludes that he has experienced discrimination in the workplace.[12] In setting up the Equal Employment Opportunity Commission ("EEOC"), Congress also installed a set of well-defined procedures and gate-keeping mechanisms to use in

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[7] 15 U.S.C. §§ 1114(1), 1125(a) (2012). The core issue in a trademark infringement case is whether the alleged infringer's mark so resembles the plaintiff's mark that it is "likely to cause confusion, or to cause mistake, or to deceive" consumers. *Id.* § 1114(1).

[8] *See infra* Part III.

[9] *See infra* Part V. But it does not have to be that way. *Id.*

[10] *See* McDonnell Douglas Corp. v. Green, 411 U.S. 792, 805 (1973). The Supreme Court has created a mature federal common law of employment discrimination practice, from outlining appropriate methods of proof in garden-variety discrimination cases, *see id.*, to creating an entire landscape of sexual harassment law, a term that appears nowhere in any federal statute. *See* Meritor Savings Bank v. Vinson, 477 U.S. 57, 64–66 (1986) (following the lead of the EEOC's 1980 Sexual Harassment Guidelines and other federal courts and concluding that "[w]ithout question, when a supervisor sexually harasses a subordinate because of the subordinate's sex, that supervisor 'discriminate[s]' on the basis of sex.") (alteration in original).

[11] One of the problems might well be that lawyers use these kinds of modifiers to describe their practice: "intellectual property" and "employment law." But the terms also may provide a pecking order of sorts within law firms and the bar in general. Intellectual property law is often seen as complex, but as discussed in this article, when it comes to the chief issue in most infringement cases ("likelihood of confusion"), the law is better described as simply disorganized. *See, e.g.*, Smith v. Wal-Mart Stores, Inc., 537 F. Supp. 2d 1302, 1316 (N.D. Ga. 2008) ("The court must balance the factors *according to its own* judgment based on the facts in the case before it.") (emphasis added); 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:2.50 (4th ed. 2012) ("There is a split of authority among the federal circuits as to whether the issue of likelihood of confusion is an issue of fact reviewed on appeal under the 'clearly erroneous' standard or whether it is an issue of law reviewed de novo.").

[12] *See* 42 U.S.C. § 2000e-5 (2012) (granting power to the EEOC to prevent unlawful employment practices by requiring the Commission to investigate the validity of claims upon the filing of a charge).

these cases.[13] Under those procedures, filing a charge of discrimination with the EEOC or a similar state agency is a jurisdictional prerequisite to suing.[14] The EEOC has many purposes, but foremost among them is the conciliation and settlement of meritorious charges of discrimination,[15] and it is hard to argue with that charge.[16] Under the EEOC's procedures, employment-based civil rights cases can be resolved at the administrative level, thereby sparing parties the costs and lengthy timelines associated with full-blown litigation.[17]

Indeed, a charging party usually cannot sue in court until the EEOC has issued a "right to sue" letter allowing the party to do so.[18] According to federal regulation, the letter comes after mediation or investigation of the charge,[19] though in some cases charging parties and their attorneys seek permission to sue before the EEOC has completed its work.[20] For the most part, however, the "right to sue" framework sends the right messages to prospective plaintiffs: slow down, show your cards, and settle if possible.[21] The message is only slightly undermined by something out of the EEOC's control: By statute, it is ultimately powerless to do anything, other than sue in its own right, about civil rights violations proven by charging parties at the administrative level.[22]

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[13] *Id.*

[14] *See id.* § 2000e-5(f)(1).

[15] *See id.* § 2000e-5(b) ("If the Commission determines after such investigation that there is reasonable cause to believe that the charge is true, the Commission shall endeavor to eliminate any such alleged unlawful employment practice by informal methods of conference, conciliation, and persuasion.").

[16] The Federal Rules of Civil Procedure themselves make plain Congress' preference for "the just, speedy, and inexpensive determination of every action and proceeding." FED. R. CIV. P. 1.

[17] *See All Statutes: FY 1997 – FY 2011*, U.S. EQUAL EMP. OPPORTUNITY COMMISSION, www.eeoc.gov/eeoc/statistics/enforcement/all.cfm (last visited Oct. 3, 2012). The EEOC reports that in Fiscal Year 2010, and again in Fiscal Year 2011, it caused the settlement or conciliated over 10,000 charges of discrimination, which represented over ten percent of all charges filed. *Id.*

[18] *See* Forehand v. Fla. State Hosp. at Chattahoochee, 89 F.3d 1562, 1569–70 (11th Cir. 1996) ("It is clear . . . that receipt of a right-to-sue letter is not a jurisdictional prerequisite to suit, but rather, is a statutory precondition which is subject to equitable modification.").

[19] 42 U.S.C. § 2000e-5(f)(1) (2012) (explaining that, under the statute, the EEOC has 180 days to investigate and possibly conciliate the charge before a private right of action arises); *see also* Occidental Life Ins. Co. v. Equal Emp't Opportunity Comm'n, 432 U.S. 355, 360–61 (1977) (quoting the relevant section of the statute).

[20] 29 C.F.R. § 1601.28(a)(2) (2012). In 1977, the EEOC issued a regulation allowing charging parties to receive right-to-sue notices upon request, that is, before the 180 days has elapsed, "provided . . . it is probable that the Commission will be unable to complete its administrative processing of the charge within 180 days from the filing of the charge and has attached a written certificate to that effect." *Id.*; Walker v. United Parcel Serv., Inc., 240 F.3d 1268, 1270–71 (10th Cir. 2001).

[21] *See* Sims v. Trus Joist MacMillan, 22 F.3d 1059, 1063 (11th Cir. 1994) (explaining that the reason for making a party wait for a right to sue letter, or for 180 days to pass, before filing suit is because "[t]he purpose of the statutory provision is to encourage conciliation in accordance with the congressional belief that voluntary settlement, rather than litigation, is the preferred mechanism for resolving these types of disputes."). But the reality of issuing so-called early right to sue notices is that this message is often not sent to charging parties.

[22] *See* 42 U.S.C. § 2000e-5(f)(1).

But it would be in error to believe that what happens at the administrative level matters little if a case ends up actually being litigated in court. It matters greatly.[23] For example, the theory of discrimination pursued by the employee before the EEOC is a decision of great consequence. An employee who believes that he suffered intentional, "disparate treatment" discrimination at the hands of his employer may not later be heard in court changing his theory to the unintentional, "disparate impact" variety.[24] Likewise, a party who files his charge after the proscribed administrative timelines—180 or 300 days after a violation, depending on whether a state has its own civil rights investigative agency[25]—may not later sue in court.[26] In these cases, the federal "statute of limitations" is as short as six months,[27] certainly one of the shortest in any area of law,[28] and federal courts enforce the limitations period with consistency.[29]

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[23] *See* T. Scott Belden, Annotation, *Judicial Estoppel in Civil Action Arising from Representation or Conduct in Prior Administrative Proceeding*, 99 A.L.R. 5th 65 (2002) (stating that judicial estoppel may bar "positions inconsistent with statements or conduct" in administrative proceedings in subsequent civil actions). At a minimum the administrative proceedings provide a party with a chance to size up the other side and to obtain what amounts to free discovery. For example, how would an opponent likely perform as a witness at trial or in a deposition? Attending an administrative hearing or fact-finding conference would likely answer that question.

[24] *Compare* Lynch v. Freeman, 817 F.2d 380, 383 (6th Cir. 1987) (suing under the disparate impact theory based on a lack of sanitary restrooms at work and winning the employment discrimination case), *with* DeClue v. Cent. Ill. Light Co., 223 F.3d 434, 437 (7th Cir. 2000) (suing under a hostile work environment theory for a lack of any restrooms at work and losing the employment discrimination case). Consider the cases brought by Eileen Lynch and Audrey Jo DeClue. Lynch worked as a carpenter apprentice for the Tennessee Valley Authority. *Lynch*, 817 F.2d at 381. DeClue worked as the only female linesman for the Central Illinois Light Company. *DeClue*, 223 F.3d at 436. Lynch had no sanitary portable bathroom to use. *Lynch*, 817 F.2d at 381–82. The lack of a toilet caused her to get urinary tract infections and tremendous discomfort. *Id.* at 382. DeClue had no portable bathroom to use at all, and her employer told her to relieve herself in the open just like her male counterparts did. *DeClue*, 223 F.3d at 436. A federal appellate court affirmed the dismissal of DeClue's hostile environment claim, while a different federal appellate court sided with Lynch. There was a reason for the discrepancy: Lynch had sued under disparate impact theory while DeClue had not. *See DeClue*, 223 F.3d at 437.

[25] Adams v. Cal-Ark Int'l, Inc., 159 F. Supp. 2d 402, 406 (E.D. Tex. 2001) (stating that the general statute of limitations for unlawful employment practices is 180 days, but "in a state that provides a state or local administrative mechanism to address complaints of employment discrimination, a Title VII plaintiff must file a charge of discrimination with the state or local agency within 300 days after learning of the discriminatory conduct"); *see also* 42 U.S.C. § 2000e-5(e)(1) (2012) (explaining that whether the plaintiff has 180 or 300 days to file a charge depends on whether the aggrieved person initiated the proceedings in a qualified state or local agency). If a state has such an agency and further has a so-called "worksharing agreement" with the EEOC, then the timeline is also extended to 300 days. 29 C.F.R. § 1626.10(c) (2012). For a description of how typical worksharing agreements operate, *see* Hong v. Children's Mem'l Hosp., 936 F.2d 967, 969 (7th Cir. 1991); 29 C.F.R. §§ 1601.13(a)(4), (b)(1).

[26] Nat'l R.R. Passenger Corp. v. Morgan, 536 U.S. 101, 109 (2002) ("A claim is time barred if it is not filed within these [statutory] time limits.").

[27] *Id.* at 118.

[28] Monica E. McFadden, *But Is It Harassment? Evaluating the Sexual Harassment Case*, 34 TRIAL 48, 50 (1998) ("Employment law has among the shortest statutes of limitations."); Betsy F. Walits, *Equal Employment Opportunity Commission Procedures*, AVVO.COM,

If a charge is timely filed, then in many cases the parties have the option of immediately pursuing mediation or preferring that the EEOC begin its investigation.[30] Mediation is informal and optional—either party can opt out—and may result in a case having a particularly short life, at least in legal terms.[31] The investigation is orderly: Typically, an employer is asked to file a position statement in response to the charge and an investigator often follows up with the parties by seeking additional information or documentary evidence.[32] The EEOC's fact-finding process may also include an on-site visit to an employer and witness interviews.[33] The EEOC's investigation is informal: Parties are not under oath when giving testimony, and position statements are not verified by stating their truthfulness.[34] It is also possible at this stage for the parties to determine that they can settle the matter. That certainly remains true after the investigator issues her "reasonable cause," finding that discrimination probably or probably did not occur.[35] Even with a finding in his favor, the charging party has proven nothing in a court of law: A cause determination may be admissible in court, but it is not controlling on a court's decision.[36]

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http://www.avvo.com/legal-guides/ugc/equal-employment-opportunity-commission-procedures (last visited September 15, 2012) ("EEOC complaints have among the shortest statues of limitations in the law.").

[29] *See, e.g.*, Leo v. Garmin Int'l, Inc., 431 F. App'x 702, 704 (10th Cir. 2011) (refusing to toll the 300 day deadline where there was no evidence of active deception); Tompkins v. AlliedBarton Sec. Servs., 424 F. App'x 42, 43 (2d Cir. 2011) (admitting that the timelines are subject to equitable tolling as "rare and exceptional" remedy, but refusing to allow Tompkins leave to amend her complaint because it was not timely); Nagle v. Vill. of Calumet Park, 554 F.3d 1106, 1121 (7th Cir. 2009) (finding that a suspension from work that the plaintiff never served was not a reason for failing to timely file a complaint of employment discrimination); Davis v. Polk City Sherriff's Office, 170 F. App'x 598, 600 (11th Cir. 2005) (upholding the district court's dismissal of the case for failing to timely file the employment discrimination suit within 300 days).

[30] *Mediation*, U.S. EQUAL EMP. OPPORTUNITY COMMISSION, http://www.eeoc.gov/employees/mediation.cfm (last visited September 12, 2012).

[31] *See id.* According to the EEOC, the average processing time for mediation is less than three months, while it can take six months or more to process an EEOC investigation. *Id.*

[32] *See The Charge Handling Process*, U.S. EQUAL EMP. OPPORTUNITY COMMISSION, http://www.eeoc.gov/employees/process.cfm (last visited September 15, 2012).

[33] *Id.*

[34] *See, e.g.*, U.S. Equal Emp't Opportunity Comm'n v. Custom Cos., Nos. 02 C 3768, 03 C 2293, 2007 U.S. Dist. LEXIS 45116, at *14–15 (N.D. Ill. June 21, 2007).

[35] *The Charge Handling Process*, U.S. EQUAL EMP. OPPORTUNITY COMMISSION, http://www.eeoc.gov/employees/process.cfm (last visited September 15, 2012). If the EEOC determines that there is reasonable cause to believe that discrimination occurred, both parties are issued a "Letter of Determination" to that effect and the agency will attempt to resolve the charge through conciliation. *Id.* If the EEOC determines that there is no reasonable cause to believe that discrimination occurred, the charging party is issued a "Dismissal and Notice of Rights" letter. *Id.* In that case, the charging party is instructed that she has the right to file a lawsuit in federal court within 90 days from the date of the receipt of the letter. *Id.*

[36] Silverman v. Bd. of Ed. of City of Chi., 637 F.3d 729, 732 (7th Cir. 2011). As the Seventh Circuit has observed, a district judge has "great discretion" in the treatment of EEOC reasonable cause determinations, but ultimately must make its own "de novo decision on the plaintiff's claims." *Id.* The safe approach for a district court concerned about the probative value of a cause determination and prejudice or confusion in a case is to exclude it. *See, e.g.*, Lewis v. City of Chi. Police Dep't, 590 F.3d 427, 442 (7th Cir. 2009) (concluding the district court did not abuse its

If a party does end up in court, it hardly means that the administrative system failed. Instead, it is highly likely that the parties seriously considered the prospect of settlement, gained important insight into the other's theory of the case, and understood going forward that they had crossed an important threshold. On the other side of the threshold lay steep attorney's fees and a much slower timeline. That alone is information all parties should intuitively appreciate prior to embarking on litigation. No windfall awaits the plaintiff in court, either, as damage caps in these cases are fairly low and have not been adjusted upward since they were first set by Congress twenty years ago.[37] There is an incentive for the plaintiff's lawyer, though, as the Civil Rights Act is one of the few federal statutes that provides for the recovery of attorney's fees for the prevailing party.[38]

Once in court, the plaintiff has a well-defined and Supreme Court-dictated burden and method of proof. Most employment cases are litigated under what is termed the "indirect method,"[39] simply meaning that the plaintiff lacks the kind of direct discriminatory evidence that would make short work of the ultimate matter and that most employers stopped providing long ago, such as "you're being fired because you are too old."[40] An indirect case involves a three-step dance in which the plaintiff has important burdens in the first and third steps.[41] First, he must establish each element of a prima facie case of discrimination, which in most cases involves four elements: (1) membership in a protected class; (2) proof that he was meeting his employer's legitimate job expectations prior to the adverse decision; (3) evidence that similarly situated employees were treated more favorably by the employer; and (4) evidence of an adverse employment decision, such as a firing.[42] Establishing a prima facie case is not necessarily light lifting, and many cases die at this state even before the employer is required to carry its burden in step two.[43]

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discretion by excluding the EEOC's reasonable cause determination because the district court judge feared that admitting prior investigations into evidence would cause the jury to adopted the previous findings); Young v. James Green Mgmt, Inc., 327 F.3d 616, 622–24 (7th Cir. 2003) (affirming the decision to exclude the EEOC's finding of discrimination from evidence in a jury trial because there was plenty of other evidence presented and the EEOC files were generally unreliable).

[37] *See* 42 U.S.C. § 1981a(b)(3) (2012) (setting caps for damages in intentional discrimination cases by employer size, but in no circumstances allowing awards for compensatory and punitive damages to exceed $300,000 in the aggregate).

[38] *See* 42 U.S.C. § 1988(b).

[39] *See* McDonnell Douglas Corp. v. Green, 411 U.S. 792, 802–05 (1973) (setting forth a four-factor framework that would come to be known as the "indirect method" of proof in employment discrimination cases).

[40] *See* Bass v. Bd. of Cnty. Comm'rs, 256 F.3d 1095, 1105 (11th Cir. 2001) ("[O]nly the most blatant remarks, whose intent could be nothing other than to discriminate . . . constitute direct evidence of discrimination.") (quoting Damon v. Fleming Supermkt. of Fla., Inc., 196 F.3d 1354, 1359 (11th Cir. 1999)). In *Damon*, the court provides an example of direct evidence by citing a management memorandum stating, "Fire Early—he is too old." *Damon*, 196 F.3d at 1359; *see also* Hasham v. Cal. State Bd. of Equalization, 200 F.3d 1035, 1044 (7th Cir. 2000) (giving, as an example of direct evidence, the statement, "I did not promote you because of your national origin").

[41] *See* Brill v. Lante, 119 F.3d 1266, 1270 (7th Cir. 1997) (describing the *McDonnell Douglas* three-step process).

[42] *Id*.

[43] *See, e.g.*, Dickerson v. Bd. of Trs. of Cmty. Coll. Dist. No. 522, 657 F.3d 595, 602–03 (7th Cir. 2011) (failing to move on to the second stage because the plaintiff was not meeting the employer's legitimate job expectations).

If the plaintiff can establish a prima facie case, then it is the employer's job to do the equivalent of drawing a breath: It simply must advance a non-discriminatory reason as the reason it took the action challenged by the plaintiff.[44] This should not be difficult, e.g., the plaintiff was fired because he was insubordinate, consistently tardy or absent, or his job was eliminated, but sometimes it proves too difficult anyway. An employer may have actually fired an employee because of his personality, but may later feel embarrassed by that reason. So it offers up a falsehood in step two, such as job elimination, which undoubtedly is not provable under oath and probably does not match any documentation anyway. But, assuming that the employer can meet what should be a relatively low burden here, the ball shifts to the employee's court, step three, to raise enough doubt about the truthfulness of the employer's articulated reason to justify a trial.[45] Is the employer lying about its reason?[46] If so, then a jury may be free to conclude that the real reason for the employer's decision is the discriminatory one advanced by the plaintiff in the first place.[47]

The orderly nature of the case means that it is usually clear whether the plaintiff has enough to prove the ultimate fact—discrimination—at the moment discovery ends. While intentional discrimination implies mind reading or, as the Supreme Court has indicated, looking into the heart of the decision-maker at the moment of the decision,[48] the proof process is not nearly so mystical. Either the plaintiff has enough to raise a genuine issue on the motive behind his firing or he does not. Without proof of pretext, or that the employer is lying, he cannot satisfy this burden.[49] The result is summary judgment,[50] and, given the relative burdens here, it should be no surprise that such a result has become fairly routine in employment cases.[51] Indeed, the three-step, *McDonnell Douglas* paradigm was undoubtedly established to make it easier for plaintiffs to make their cases, but does the opposite in practice. Instead, it is usually the reason their cases fail before ever seeing the inside of a courtroom.[52]

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[44] *McDonnell Douglas*, 411 U.S. at 802 ("The burden then must shift to the employer to articulate some legitimate, nondiscriminatory reason for the employee's rejection.").

[45] *Brill*, 119 F.3d at 1270; *see also*, Russell v. Acme-Evans Co., 51F.3d 64, 68 (7th Cir. 1995) (explaining that, while there was no basis to say that the employer was being truthful about its reasons for firing Russell, Russell did not presented enough evidence to prove it was not the true reason).

[46] *See Russell*, 51 F.3d at 68.

[47] *See* Azimi v. Jordan's Meats, Inc., 456 F.3d 228, 247 (1st Cir. 2006).

[48] Price Waterhouse v. Hopkins, 490 U.S. 228, 241 (1989) ("The critical inquiry . . . is whether gender was a factor in the employment decision *at the moment it was made*.") (emphasis in original).

[49] *See Brill*, 119 F.3d at 1270.

[50] *Id.* at 1275 (upholding the employer's motion for summary judgment because the plaintiff did not come forward with sufficient evidence to prove the defendant was lying about the reasons for firing the plaintiff).

[51] *See id.* ("This is the relay confronting district courts each time they face a discrimination lawsuit brought under the *McDonnell Douglas* framework. Because more than 90 percent of employment cases are resolved before trial, they face it often, and so do we.").

[52] *See* Gordon v. United Airlines, Inc., 246 F.3d 878, 893 (7th Cir. 2001) (Easterbrook, J., dissenting). An argument can be made that the paradigm is unnecessarily complicated and simply confuses the only issue that matters in employment discrimination cases at any stage of a case:

There are other factors working against plaintiffs, to be sure. Courts have developed strong, and sensible, presumptions in these cases that tend to put an end to them at the summary judgment stage.[53] It is unlikely that the supervisor who hired the plaintiff would be the same one to fire her for belonging to a protected class, such as her sex or race,[54] just as it is unlikely that an employer who has fired an employee and replaced her with someone less than ten years younger has done so on account of her age.[55] In both cases, the presumptions work against a finding of discrimination, though other evidence can rebut those presumptions.[56] But here, the point is not whether the presumptions are necessarily fair or, for that matter, whether the administrative scheme and the *McDonnell Douglas* method always work in the way that they were first intended. The point is that they fill a litigation space that otherwise would be filled by chaos or at least disorder. There would be no gatekeeping mechanism preventing, or nearly preventing, the frivolous case from being litigated,[57] no proof-formula like the indirect method that has been used thousands of times over decades and that by now is well understood and accessible to parties, and no inexorable, if not tangible, pull towards conciliation and settlement in advance of outright litigation. In other words, employment litigation would be expensive and largely directionless or very similar to the way parties litigate over their trademarks.

II. HOW TRADEMARK LITIGATION WORKS

Trademark litigation exists in an alternate, or shadow, universe, and that is where the problems begin. The core issue in a trademark case is whether one mark so resembles another mark "as to be likely . . . to cause confusion, or to cause mistake, or to deceive."[58] The test is known simply as "likelihood of confusion."[59] If a likelihood of confusion exists, then generally, the mark that was used or registered with the United States Trademark Office first receives priority and the later mark is restricted.[60] Confusion may be measured by examining the marks on paper or how

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whether a plaintiff can point to sufficient evidence to establish that her age, race, or some other protected characteristic motivated the challenged employment decision. *Id.*

[53] *See* Chiaramonte v. Fashion Bed Grp., Inc., 129 F.3d 391, 399 (7th Cir. 1997) ("We have previously held that when an employee is hired and fired by the same decision-maker in a relatively short time span, a presumption, or inference, of nondiscrimination arises.").

[54] *See* Rand v. CF Indus., Inc., 42 F.3d 1139, 1147 (7th Cir. 1994) (finding an inference of nondiscrimination where the plaintiff "was hired while in the protected class, and fired by the same person who hired him after a relatively short period of time").

[55] Hartley v. Wis. Bell, 123 F.3d 887, 893 (7th Cir. 1997).

[56] *See id.*

[57] Brill v. Lante, 119 F.3d 1266, 1270 (7th Cir. 1997) ("But [the *McDonnell Douglas* framework] is a necessary schematic if the real cases of discrimination are to emerge from the 'spurious ones.'").

[58] *See* 15 U.S.C. § 1052(d) (2012).

[59] *See* TBMP, *supra* note 6, § 309.03(c); *In re* E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973).

[60] *See* TBMP, *supra* note 6, § 309.03(c) ("A plaintiff must plead (and later prove) priority of use."); Media Online, Inc. v. El Clasificado, Inc., 88 U.S.P.Q.2d (BNA) 1285, 1288 (T.T.A.B. 2008) (stating that priority is a required element of a likelihood of confusion claim under the Trademark

they are actually used in the marketplace. The Trademark Office, which handles petitions to register trademarks, examines the marks in a near-laboratory setting or exactly how the registrant presents the mark on paper.[61] Courts that hear trademark infringement cases examine the marks in use.[62] In other words, it would be no defense in a trademark infringement case for a defendant to argue that the Trademark Office had approved the registration of its mark if the mark in dispute in court is different from the mark examined in Washington.[63]

The difference between how a mark appears on paper and how it is used in commerce is an important one, but it does not have to be that way. There is no reason, for example, that the Trademark Office cannot also examine a mark in commerce. After all, it requires evidence that the mark is either used in commerce,[64] or intended to be used in the near term,[65] before it will expend its staff resources and actually conduct an examination. In either case, whether the mark is subject to a registration petition, an "opposition" proceeding with the Trademark Trial and Appeal Board, or a trademark infringement lawsuit in court, the core issue remains the same: Are consumers likely to be confused if they confront the mark in the marketplace?[66] Will they mistake it for another mark?[67]

If the owner of a registered trademark contests the registration of another mark, it typically does so on the grounds of likely confusion and files an "opposition" with the litigation branch of the trademark office:[68] the Trademark Trial and Appeal Board.[69] Litigation before the Board proceeds much like federal court litigation.[70] Indeed, while the Board has voluminously detailed procedures governing everything from motion practice to discovery,[71] it also incorporates by reference the Federal

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Act); Kohler Co. v. Baldwin Hardware Corp., 82 U.S.P.Q.2d (BNA) 1100, 1108 (T.T.A.B. 2007) (finding priority established by proof of prior use).

[61] *See* Mattel, Inc. v. Funline Merch. Co., 81 U.S.P.Q.2d (BNA) 1372, 1374 (T.T.A.B. 2006); Carefirst of Md. v. Firsthealth of the Carolinas, 77 U.S.P.Q.2d (BNA) 1492, 1508 (T.T.A.B. 2005).

[62] Jim Beam Brands Co. v. Beamish & Crawford Ltd., 937 F.2d 729, 735 (2d Cir. 1991) ("In contrast [to the Board in a registration case], in determining the similarity of marks in an infringement action, a court must examine the visual appearance of each mark in the context of its use.").

[63] 6 MCCARTHY, *supra* note 11, § 32:101 ("In an opposition, likelihood of confusion is determined only as to the registrability of the applicant's mark exactly as shown in the application and only as to the goods listed, regardless of actual usage.").

[64] 15 U.S.C. § 1051(a)(3)(C) (2012).

[65] 15 U.S.C. § 1051(b)(3)(B).

[66] *See* 3 MCCARTHY, *supra* note 11, § 20:15 ("In many oppositions, the merits will revolve around the issue of the likelihood of confusion between opposer's prior mark and applicant's mark. The test of likelihood of confusion is identical to that applied in ex parte determinations under § 2(d) and in infringement actions."); *id.* § 32:94 ("[A] court decision on likelihood of confusion is res judicata and binding on the Patent and Trademark Office on an issue of likelihood of confusion arising under Lanham Act § 2(d)").

[67] *See id.* § 24:72 ("[T]raditional trademark law rests primarily on a policy of protection of customers from mistake and deception . . . . ").

[68] 37 C.F.R. § 2.101(b) (2012).

[69] *Id.*

[70] *See* TBMP, *supra* note 6, § 102.03 ("An inter partes proceeding before the Board is similar to a civil action in a federal district court.").

[71] TBMP, *supra* note 6, at Introduction ("The manual is devoted primarily to opposition and cancellation proceedings, the two most common types of inter partes proceedings before the Board.

Rules of Civil Procedure.[72] As they do in federal court, the parties must conduct an initial discovery and settlement conference and exchange initial disclosures.[73] Thereafter, they have the ability to conduct both written and oral discovery.[74] They can file for summary judgment.[75] One difference stands out: While there is a trial,[76] all testimony is submitted on paper.[77] There is no live testimony and, of course, no jury.[78] The Board decides the case, and the likelihood of confusion issue, based on the written record.[79]

The Board does not use any particular metric or calculus in reaching its decisions.[80] There certainly is no proof-shifting paradigm similar to the *McDonnell Douglas* method used in employment cases. Instead, the Board consults as many as thirteen different factors that were first articulated by its supervising court, the Federal Circuit, almost forty years ago.[81] Those "likelihood of confusion" factors range from the similarity of the marks[82] to the relative degree of care that a consumer exhibits in shopping for the type of product or service in question.[83] No one factor necessarily means more than another,[84] though in practice the similarity of the marks (in terms of appearance, sound, and impression) means the most.[85] But the

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Nonetheless, the manual includes a chapter of general information . . . and chapters on interference proceedings, concurrent use proceedings, and ex parte appeals to the Board.").

[72] 37 C.F.R. § 2.116(a) ("Except as otherwise provided, and wherever applicable and appropriate, procedure and practice in inter partes proceedings shall be governed by the Federal Rules of Civil Procedure.").

[73] *Id.* § 2.120(a); TBMP, *supra* note 6, § 401.

[74] TBMP, *supra* note 6 § 401 (discussing the range of "discovery devices" available to a litigant before the Board, including "discovery depositions, interrogatories, requests for production of documents and things, and requests for admission").

[75] *Id.* § 528; FED. R. CIV. P. 56.

[76] *See generally* TBMP, *supra* note 6, ch. 700 (discussing trial procedures and the introduction of evidence before the Board).

[77] *Id*. § 102.03 ("The principal difference [between a civil action in a federal district court and a Board proceeding] is that proceedings before the Board are conducted in writing, and the Board's actions in a particular case are based upon the written record therein.").

[78] *See id.* ("[A]ll testimony is taken out of the presence of the Board during the assigned testimony periods . . . . ").

[79] *See id.*

[80] *See* E.I. DuPont de Nemours & Co., 476 F.2d 1357, 1361–62 (C.C.P.A. 1973).

[81] *Id.* at 1361 (listing thirteen factors, including this one: "[a]ny other established fact probative of the effect of use").

[82] *Id.* Or, more precisely, the "dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression." *Id.*

[83] *Id.* In particular, the issue is whether a customer is driven by "impulse" or can be considered "careful" or "sophisticated." *Id*.

[84] *Id.* at 1361–62. (stating that a single factor may "play a dominant role"); *see also* Shen Mfg. Co. v. Ritz Hotel Ltd., 393 F.3d 1238, 1241 (Fed. Cir. 2004) ("Neither we nor the board, however, need consider every *DuPont* factor.").

[85] Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CAL. L. REV. 1581, 1623 (2006) (stating that dissimilarity of the marks is "by far" the most important factor and can even be dispositive); *see also* Odom's Tenn. Pride Sausage, Inc. v. FF Acquisition, LLC, 600 F.3d 1343, 1346–47 (Fed. Cir. 2010) (finding that the Board did not err in basing its decision on dissimilarity of the marks alone); Kellogg Co. v. Pack'em Enters., Inc., 951 F.2d 330, 333 (Fed. Cir. 1991) (affirming summary judgment on the first *DuPont* factor—dissimilarity— in a case involving FROOT LOOPS and FROOTEE ICE marks); Bos. Red Sox

Board has consistently resisted any urge to refine the factors, or narrow them, or even acknowledge that balancing thirteen factors is a hopelessly, and maybe even ridiculously, directionless calculus.[86]

Courts deciding trademark infringement cases confront the same "likelihood of confusion" issue and also employ multi-factor tests. On the plus side, the tests usually involve fewer than thirteen factors. The Seventh Circuit's test in these cases includes seven factors.[87] But balancing seven and balancing thirteen factors is only a difference in number. Without some decision-making mechanism, such as which factors are the most important[88] or, at least, which ones might be deal-breakers for one of the parties, they provide little more guidance than the Board's approach.

The real problem is not necessarily the number of factors that courts or the Board employs to determine likelihood of confusion, but rather their respective roles. A party seeking registration of a mark with the Trademark Office may learn that its mark has been opposed and find itself in full-scale litigation before the Board.[89] If it does, the result of the Board's decision, such as denying the opposition and granting the registration, will generally not preclude the same plaintiff from filing a trademark infringement lawsuit in federal court.[90] It will avoid both issue and claim preclusion by simply arguing that the defendant's actual use of the mark in commerce departs enough from the mark it registered to require successive litigation on the likelihood of confusion issue.[91] Similarly, a plaintiff (or opposer) may initiate an opposition before the Board, litigate a case through discovery, and then ask the Board to suspend the case so that it can file a federal trademark infringement suit in federal court, thereby restarting the case and beginning discovery all over again in a different forum.[92] The Board's policy in that circumstance is to suspend the case in

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Baseball Club LP v. Sherman, 88 U.S.P.Q.2d (BNA) 1581, 1590 (T.T.A.B. 2008) (holding that the dissimilarity of the marks was dispositive); Mattel, Inc. v. Funline Merch. Co., 81 U.S.P.Q.2d (BNA) 1372, 1374 (T.T.A.B. 2006) (stating that the key considerations are similarities between the marks appearing in the parties' registrations and similarities between the goods or services); Truescents LLC v. Ride Skin Care LLC, 81 U.S.P.Q.2d (BNA) 1334, 1342 (T.T.A.B. 2006) (basing decision on dissimilarity of the marks alone, regardless of whether the marks were used on identical goods or not).

[86] TBMP, *supra* note 6, § 309.03(c) ("The relevance and weight to be given the various factors may differ from case to case and a single [*DuPont*] factor may be dispositive in certain cases.").

[87] AutoZone, Inc. v. Strick, 543 F.3d 923, 929 (7th Cir. 2008).

[88] *Id.*; *see also* Packman v. Chi. Tribune Co., 267 F.3d 628, 643 (7th Cir. 2001) (indicating that three factors carry particular importance: the similarity of the marks, evidence of actual confusion, and any intent to confuse on the defendant's part).

[89] *See* TBMP, *supra* note 6, § 102.03.

[90] *See id.* (stating that the Board is "empowered to determine only the right to register" and "is not authorized to determine the right to use, nor may it decide broader questions of infringement or unfair competition.")

[91] *See In re* Infinity Broad. Corp. of Dall., 60 U.S.P.Q.2d (BNA) 1214, 1218 (T.T.A.B. 2001). The Board makes its finding on the likelihood of confusion issue after examining only the marks themselves (as they appear in the parties' registrations), without concern as to how a party displays a mark in the marketplace. *Id.* ("[I]n Board proceedings, likelihood of confusion is determined independent of the context of actual usage. In an infringement action, on the other hand, the context of use of the marks is relevant.").

[92] *See* TBMP, *supra* note 6, § 510.02(a) ("Whenever it comes to the attention of the Board that a party or parties to a case pending before it are involved in a civil action which may have a bearing

order to avoid concurrent litigation,[93] as, at least in theory, the district court's decision holds the promise of being binding on the Board.[94] But in practice, the Board may end up not deferring to the court's decision after all if the court took into account a single factor, such as the actual use of the mark in commerce, that does not show up in its own list of thirteen factors.[95] The result is Groundhog Day[96] for the defendant: It may have won judgment in federal court only to find itself in litigation over basically the same issue all over again. Or consider one more possibility (though there are many more): an opposer successfully objects to a mark's registration, thereby ruling out the nationwide registration of the mark, but finds itself unable to collect any damages from a court in a trademark infringement lawsuit because a court has determined that, in commerce, the marks are not confusingly similar after all.[97]

If damages are sought, the game is played in federal court, not at the Board, which is powerless to award damages[98] and is basically limited to the equivalent of issuing equitable relief.[99] There are no concrete timelines that operate here, either.[100] Because a party's use of its mark in commerce is continuing, a plaintiff can file a

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on the Board case, proceedings before the Board may be suspended until final determination of the civil action.").

[93] *Id.* ("Ordinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding may have a bearing on the issues before the Board.").

[94] *See* Ziebart Int'l Corp. v. Z Tech Rustproofing, LLC, 2009 WL 129481, at *5 (T.T.A.B. 2009) (holding that the Board was bound by the district court's conclusion that the parties' marks were dissimilar, which meant that there could be no likelihood of confusion); TBMP, *supra* note 6, § 510.02(a) ("To the extent that a civil action in a federal district court involves issues in common with those in a proceeding before the Board, the decision of the federal district court is often binding upon the Board, while a decision of the Board is not binding upon the court."). *But see* Am. Hygienic Labs., Inc., v. Tiffany & Co., 228 U.S.P.Q. (BNA) 855, 857 (T.T.A.B. 1986) (deciding that the use of one mark does not constitute infringement on another mark and a decision by the court may not end up binding the Board "because a claim of infringement before the court and a claim of priority and likelihood of confusion before this Board are different claims"); 6 MCCARTHY, *supra* note 11, § 32:82 ("[A]n opposer would not necessarily be barred by the rule of claim preclusion when it lost a previous infringement claim in court.").

[95] *See In re Infinity Broad.*, 60 U.S.P.Q.2d (BNA) at 1218 (stating that "infringement cases in which no likelihood of confusion has been found because the marks are used in different geographical areas are not helpful to our analysis" because registration confers an exclusive right to nationwide use of the registered mark).

[96] GROUNDHOG DAY (Columbia Pictures 1993) (depicting a main character who replays the same day over and over again with a chance to change his actions and the outcomes of his actions each day; wherein the day just so happens to be Groundhog Day).

[97] *See In re Infinity Broad.*, 60 U.S.P.Q.2d (BNA) at 1218. It might happen if the mark is used differently in commerce compared to its depiction in the registration papers, but in general, the Board's findings should not be ignored by a court. *See* Torres v. Cantine Mezzacorona, 108 F. App'x. 816, 820 (4th Cir. 2004) (holding that the Board's determinations "should be considered 'powerful *evidence*' of the presence (or lack thereof) of one or more of the factors that must be considered in an infringement action") (emphasis in original).

[98] TBMP, *supra* note 6, § 502.05.

[99] *See id.*

[100] *See* 15 U.S.C. § 1051 (2012) (failing to place a statute of limitations on the time to apply for trademark registrations); Audi AG v. D'Amato, 469 F.3d 534, 545 (6th Cir. 2006) ("[T]he Lanham Act does not contain a statute of limitations.").

federal lawsuit at any time.[101] Nor is there any need to tie a federal lawsuit to a theory pursued at the administrative or the Board level.[102] (Recall that once she lands in court, an employment plaintiff is bound by the discrimination theory she advanced with the EEOC.) There is no need to litigate at the administrative level in the first place.[103]

Against this backdrop of shadow litigation are these realities. Unlike the EEOC in the employment law world, the Board is not a gatekeeper of any sort. A party need not file a claim of likely confusion with the Board, in response to a proposed registration, prior to pursuing a full-blown, expensive infringement claim in federal court.[104] Similarly, a party can, in effect, ping-pong back and forth between the Board and a federal court pursuing highly related, but not completely overlapping, claims. A party may litigate for a time before the Board, then in federal court, and then back before the Board.[105] The Board itself is not a mediator or conciliator.[106] It conducts no investigation prior to setting the parties loose in litigation over the mark that its sister agency, the Trademark Office, approved for registration.[107] And it offers no sense of finality, nor can it: A party who wins registration of a mark after litigation before the Board may just as easily find itself sued the next day for infringement in federal court. Finally, there are no settlement conferences,[108] typically no hearings or oral arguments before the Board,[109] and no court to show up to alongside an opposing counsel.[110] The paper process seems to minimize any possible prospect of inter-party communication and dialogue.[111]

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[101] *Audi AG*, 469 F.3d at 545. But a court may use the doctrine of laches to determine whether a suit should be barred. *Id.*

[102] *See* DeClue v. Cent. Ill. Light Co., 223 F.3d 434, 437 (7th Cir. 2000).

[103] *See* 15 U.S.C. § 1119 (explaining that a district court can decide both infringement and registration issues).

[104] *Cf.* 42 U.S.C. § 2000e-5(f)(1) (explaining the gatekeeping function of the EEOC in employment discrimination cases before going to court that is missing from the function of the Board in trademark litigation).

[105] *See* 6 MCCARTHY, *supra* note 11, § 32:82 ("[A]n opposer would not necessarily be barred by the rule of claim preclusion when it lost a previous infringement claim in court"). This situation could happen if a party first files an opposition to a registration with the Board, then later files a civil action and suspends the Board proceeding, only later to return to the Board to argue that the result in the civil action is not controlling.

[106] *See* TBMP, *supra* note 6, § 102.03. The Board is an administrative tribunal with a similar role to that of federal courts, rather than a mediator or conciliator. *Id.*

[107] Marcus H.H. Luepke & B. Brett Heavner, *Avoiding Trademark Pitfalls in the "Land of the Unlimited Possibilities*,
http://www.finnegan.com/resources/articles/articlesdetail.aspx?news=72244da2-f0ae-432f-80a8-2f88a8b2bd0c (last visited Oct. 19, 2012).

[108] Trademark Trial and Appeal Board Participation in Settlement Discussions, 76 Fed. Reg. 22678, 22679 (Apr. 22, 2011) ("There is no routine Board involvement in settlement discussions in cases in which the Board is not invited into the discovery conference or, for cases in which the Board is so invited, after the completion of the discovery conference.").

[109] TBMP, *supra* note 6, § 102.03 ("Indeed, a party to a proceeding before the Board need never come to the offices of the Board at all . . . unless the party wishes to argue its case at oral hearing (an oral hearing is held only if requested by a party to the proceeding).").

[110] *Id.*

[111] *See id.* § 401.01. In fact, a mandatory discovery conference is the only required communication between parties at the Board, just as it is in federal court. *Id.*; *see also* FED. R. CIV.

In a nutshell, if attorney's fees and purgatory are appealing to a party, then trademark litigation is where it wants to be. An administrative level exists, but its purpose is neither to rule out some cases nor assist the parties in ending their disputes.[112] The administrative level is armed with judges, but their orders are not binding on federal courts[113] nor are a court's orders necessarily binding on them.[114] A party need not pick its poison in opposing a registration and suing for trademark infringement. It can do one or the other, or both, in no particular order.[115] In short, trademark litigation is very nearly the mirror opposite of employment litigation, where deadlines, preclusion, and finality prevail, and where there is both a prerequisite purpose to the administrative agency, the EEOC, and a statutory framework heavily tilted toward resolving disputes prior to outright litigation.[116] Trademark litigation does not lie in any happy medium and appears happily driven to excess. If the core principle of the rules by which parties pursue litigation is the fast and efficient resolution of disputes (and it is),[117] then trademark litigation violates the very first rule.

III. HOW TRADEMARK LAW MIGHT WORK BETTER BY BORROWING FROM EMPLOYMENT LAW

An immediate improvement to trademark litigation, which is one of the most expensive forms of litigation,[118] is easy to imagine: Simply change the charge of the Patent and Trademark Office (and perhaps the Trademark Trial and Appeal Board) from one of supervising registrations and oppositions to investigating the basis of those oppositions. One of the reasons that employment litigation works is that the government role in discrimination claims is largely investigative and conciliatory. In other words, it is tilted toward preventing litigation.[119] The Trademark Office's role is strangely disassociated from the basis of the claims of confusion that it processes before the Board and from the chance, because of its unique role and stature as an

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P. 26(f)(2). But the reality of most discovery conferences in the federal system is that they are routine and boilerplate. *See* FED. R. CIV. P. 26(f)(2).

[112] *See supra* note 106 and accompanying text.

[113] *See* TBMP, *supra* note 6, § 906.01. In fact, a party that loses a case before the Board may appeal that decision directly to either the Federal Circuit or a federal district court. *Id.* Both appeals come with de novo review, but appealing to a federal district court is really the start of a new civil action because in that circumstance the parties are allowed to submit new evidence and even raise new claims. *Id.*

[114] *See* sources cited *supra* note 94.

[115] *See supra* note 105 and accompanying text; TBMP, *supra* note 6, § 102.01.

[116] *See supra* Part I.

[117] *See* FED. R. CIV. P. 1.

[118] AM. INTELL. PROP. L. ASS'N, 2009 REPORT OF THE ECONOMIC SURVEY I-135 (2009) [hereinafter AIPLA ECONOMIC REPORT]. Even in minor trademark infringement cases (with less than $1 million at stake), a party can expect to spend nearly $500,000 in litigation costs. In major infringement cases (with more than $25 million at stake), a party spends on average almost four times that amount.

[119] *See supra* Part I.

arm of the government, that it might resolve confusion claims just as easily as it presently speeds them along the litigation path in the form of oppositions.[120]

How would the Trademark Office's new role work? Simple. As it stands, once a trademark registration is published for opposition, opposers from across the country have the chance to derail the path to registration,[121] a delay which is both tremendously expensive and time-consuming.[122] Once an opposer files an opposition to the proposed registration, the Trademark Office washes its hands of the registration matter and passes the nascent litigation to the Board.[123] In other words, all of the power lies in the hands of the opposer, who single handedly (and with little adverse consequence) can call into question the legitimacy of a mark that not even the trademark examiner, an attorney who approved the mark for publication, thought was a source of confusion.[124]

A much better system would involve the Trademark Office as more than a pass-through to the litigation-supervising Board. Instead, an opposition should be passed through only after it was investigated by the Trademark Office and these same lawyer-trademark examiners, and determined that it is supported by probable cause. In other words, the Trademark Office would assume a role that the EEOC has perfected: receiving claims or charges of discrimination and investigating them before even issuing a "right to sue" to the charging party.[125] Imagine the number of frivolous claims that would be wrung out of the system if the Trademark Office assumed this new role, and imagine the signals that it would send to all parties: namely, that oppositions to registration are not tactical devices to forestall the registrations of legitimate businesses, and that the purpose of the Trademark Office is not merely to facilitate litigation. The purpose is to play the role of gate-keeper, too.

In addition to the clear advantage of sending all the right signals to litigating parties, the Trademark Office has the added advantage of already *existing*. No new administrative agency would need to be created in order to support the Trademark Office's new role. The Trademark Office would be taking on an important new investigative and gate-keeping responsibility, but trademark lawyers and, indeed, legislators would not have to propose an entirely new administrative scheme or

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[120] *See* Trademark Trial and Appeal Board Participation in Settlement Discussions, 76 Fed. Reg. 22678, 22678–79 (Apr. 22, 2011). While the Board asked for public comments in 2011 on whether it should be more active in settling and conciliating *inter partes* claims of confusion, it did nothing after it received those comments (which were mostly negative). *See id.*

[121] *See* 15 U.S.C. § 1063(a) (2012). Anybody may sue. *Id.*; *see also* Enbridge, Inc. v. Excelerate Energy Ltd. P'ship, 92 U.S.P.Q.2d (BNA) 1537, 1540 n.10 (T.T.A.B. 2009) (explaining that a plaintiff does not have to prove claims or actual damage to establish standing).

[122] *TTAB New Filings and Performance Measures: Fiscal Year 2012*, U.S. PAT. & TRADEMARK OFF., http://www.uspto.gov/trademarks/process/appeal/TTAB_New_Filings_and_Performance_Measures.jsp (last modified July 6, 2012). In 2011 the average total pendency of the Board's *inter partes* trial proceedings was over four years (213weeks). *Id*.

[123] *See* TBMP, *supra* note 6, § 302.

[124] *See id.* § 303.01. There is also no requirement that a plaintiff plead damages—or even ultimately prove damages—in order to establish standing or prevail in an opposition proceeding. *Id.* § 303.03.

[125] *See supra* Part I.

bureaucracy. Rather, these same lawyers and legislators should be demanding that the intellectual property community get more out of an agency that already exists, and, indeed, that it is expert in the area of trademarks.

Some complaints of infringement (or, technically, a likelihood of confusion) will wash away under the bright lights of the Trademark Office's investigation. That happens in the employment law world once the EEOC issues a ruling that it finds no probable cause in support of a discrimination charge. Other trademark charges will have to be conciliated and settled, perhaps because they present closer cases, or there is, in fact, an investigative decision in favor of the party claiming confusion. The Trademark Office should embrace this second, equally important conciliatory purpose, just as the EEOC does. Settling a case at this stage of the process frees the courts to handle cases where the parties present tougher issues less subject to settlement or at least cases where the parties have consciously decided, rather than had it decided for them, that they are willing to bear the high costs of trademark litigation.[126] In all events, parties amenable to settlement are assisted in their efforts and given the tools and mechanism they need to avoid the uncertainty and costs associated with going to court.

Like the new investigatory role, the conciliatory role described here would not require either inventing a new government agency or creating an expertise that does not already exist. The Trademark Office, armed with lawyer-trademark -examiners, is already expert in the field. Certainly, it would require additional resources and these same experts would also have to be trained in conciliation and settlement, but any chance to settle these cases should be too alluring to pass up. The Trademark Office already has access to the parties once an opposition is filed and already enjoys the stature necessary to fill the conciliatory role. This is precisely the role that the EEOC plays, and in recent years, courts (both district and appellate) have gone beyond mandatory case management or settlement conferences to formalize dispute resolution processes.[127] They have left the trademark bar behind, which is an incredible, lost opportunity given the existence, size, and access to the parties already enjoyed by the Trademark Office.

Leaving aside the new investigatory and conciliatory role for the Trademark Office, trademark law could borrow from employment law and improve in three important ways: (1) by eliminating forum shopping or the bouncing that parties can do between the Board and federal courts;[128] (2) by adopting a simplified proof method that resembles the *McDonnell Douglas* method[129] and installs consistency and predictability in trademark cases; and (3) by distinguishing between intentional and unintentional infringement cases, just as Congress has distinguished between intentional and unintentional discrimination cases and provided very different remedies for each.[130]

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[126] *See* AIPLA ECONOMIC REPORT, *supra* note 118, at I-132–35 (listing the average costs of trademark litigation).

[127] *See, e.g.*, *Lanham Act Mediation Program,* U.S. DISTRICT CT. FOR THE N. DISTRICT OF ILL., http://www.ilnd.uscourts.gov/LEGAL/LanhamAct/LanhamActprg.htm (last visited Oct. 19, 2012).

[128] *See supra* note 105 and accompanying text.

[129] *See supra* Part I.

[130] *See* 42 U.S.C. § 1981a (2012) (providing for no compensatory or punitive damages in disparate impact cases).

As it stands, a party can actually invoke the processes of the Trademark Trial and Appeal Board and set sail down the litigation path, only to drop anchor and decide that it would rather pursue its infringement claims in federal court.[131] When it does so late in the litigation game, such as after the close of discovery, it seems like an expensive abuse of process (and why the Board tolerates such forum shifting is a mystery).[132] Consider the reasons why a party may want to leave its Board litigation behind and start all over again by filing a federal trademark infringement lawsuit. It may have concluded that the Board cannot provide it with the kind of remedy—money damages— that it seeks.[133] It may have concluded that it has a better chance of proving infringement based on the defendant's actual use of its mark in commerce versus the manner in which the defendant has presented it on paper for registration.[134] Or it may have concluded that the administrative litigation is not going particularly well and it would like a do-over, which includes a fresh round of discovery and perhaps another chance to include expert testimony. The first two reasons cannot justify forum shifting. They are circumstances to take into account prior to selecting a forum, not after having done so and having litigated the matter for a time. In other words, they should inform the choice of forum in the first place. The third prospect should be reason enough to rule out the forum shifting practice in its entirety: it is the kind of gamesmanship and scorched earth litigiousness that causes these cases to be so expensive and that causes cynicism in the public's assessment of the work litigators do.[135]

The solution is simple. Once the Trademark Office has completed its investigatory and conciliatory work, the plaintiff should face an election. It may choose to litigate its claim of infringement with the Board, which may well offer a speedier and somewhat simplified process, in part, because trials are conducted on paper, not in person, or it can file its claim in federal court. As it stands, both fora presently decide the same likelihood of confusion issue, though the Board does not consider actual usage of the offending party's mark. Nothing needs to change on that score. If a plaintiff elects to litigate before the Board, the issue of confusion will be confined to the parties' marks as presented in registration materials. If a plaintiff elects to proceed in court, then it must also ask the court to decide the registration issue. In other words, a plaintiff stays where it started the case. What would be ruled out? A tactic in which a party could start litigating before the Board, place that litigation "on hold" at a time of its choosing, and then litigate basically the same issue in federal court, only to return to its administrative case to continue the madness of successive, highly related litigation. That is exactly what it can do now, but it should not be able to.

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[131] *See* TBMP, *supra* note 6, § 510.02(a).

[132] *See* RESTATEMENT (SECOND) OF TORTS § 682 (1977).

[133] *See* TBMP, *supra* note 6, § 502.05 ("The Board will not hold any person in contempt, or award attorneys' fees, other expenses, or damages to any party."); 37 C.F.R. § 2.127(f) (2012) (ruling out attorney's fees and expenses, but not explicitly listing damages).

[134] *See supra* note 91 and accompanying text.

[135] In many ways, forum shifting is considerably worse than forum *shopping*. Forum shifting necessarily means redundant litigation because it allows a party to shift from the administrative forum to a federal court after placing a toe in the water.

But there is more to fix. Even if a party is constrained to litigate a typical trademark matter in a single forum (the administrative realm or federal court), it can expect a mess once it lands there. There is simply no set legal standard applied in trademark cases. The core issue common to most cases is relatively simple: Is one mark likely to cause confusion in the marketplace when compared to another mark? The question is simple, as it is in many legal cases no matter what area, but there is no consensus or even near-consensus as to how to answer the question. Most courts, and for that matter the Board, resort to the application of a long list of "factors" that ostensibly help it to provide an answer.[136] The Board's list of factors amounts to thirteen, with a catchall: namely, that other factors may also be considered.[137] Applying that many factors in a legal matter in the hopes of finding a single answer—does a mark infringe—is exactly what it sounds like: It would be easier to reach a consensus as to what good art is.[138] Are some factors more important than others? Yes, but then again, not really. Is it a numbers game in that more factors tilting in favor of one party leads to victory? No. Are all of the factors relevant in every case? No again.[139] Hopefully, the point is made: A bucket full of factors yields an unpredictable, nearly random legal landscape that does a disservice to cases with important issues at stake and clients paying a lot of money to resolve them.

While courts tend to do a little better than the Board and apply fewer than fourteen factors,[140] the landscape is not much more defined. The United States Court of Appeals for the Seventh Circuit, for example, does a reasonable job by applying "only" seven factors: (1) similarity of marks; (2) actual confusion; (3) intent; (4) concurrent markets; (5) sophistication or care of customers; (6) strength of the plaintiff's mark; and (7) similarity of products.[141] It has even helped litigants and, in particular, district courts by signaling to them that the first three of these factors are the most important.[142] But for all the good it does by keeping the list of factors to at least the single digits (though balancing seven factors is still unwieldy), it muddies things considerably by assuring everyone that "courts may assign varying weights to each of the factors depending on the facts presented."[143] Good grief. In other words, a

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[136] *See supra* Part II.

[137] *See* E.I. DuPont de Nemours & Co., 476 F.2d 1357, 1361–62 (C.C.P.A. 1973) (listing thirteen factors, including this one: "[a]ny other established fact probative of the effect of use").

[138] Menard, Inc. v. Comm'r, 560 F.3d 620, 622–23 (7th Cir. 2009) ("Multifactor tests with no weight assigned to any factor are bad enough from the standpoint of providing an objective basis for a judicial decision; multifactor tests when none of the factors is concrete are worse . . . . ") (internal citations omitted).

[139] *See* Beebe, *supra* note 85, at 1627 (stating that, in practice, a handful of factors tend to be the most important to courts). In fact, a multitude of factors gives a decision-maker the ability to decide a case based on "impulse" when a case seems exceptional; in such a case, "the felt necessities of the day overwhelm the general principle, and a balancing test has no resource to prevent it." Stevens v. Tillman, 855 F.2d 394, 399 (7th Cir. 1988).

[140] *See* 4 MCCARTHY, *supra* note 11, § 23:2.75 ("Every federal circuit has its own list of about eight factors to be weighed and balanced before reaching the ultimate conclusion as to whether confusion is or is not likely.").

[141] AutoZone, Inc. v. Strick, 543 F.3d 923, 929 (7th Cir. 2008).

[142] *Id.*; Packman v. Chi. Tribune Co., 267 F.3d 628, 643 (7th Cir. 2001).

[143] *Packman*, 267 F.3d at 643.

trial court should feel free to put the factors in any order and establish its own legal framework as it sees fit. Try litigating with that standard in mind.[144]

Compare the legal landscape in trademark cases with the relative clarity that awaits litigants in employment cases. While the prima facie case in employment discrimination cases is somewhat adaptable to the case at hand, its four elements are nearly standard across all cases.[145] In other words, the legal standard is both approachable to the parties in advance and, by now, well understood. Even the three-part burden-shifting paradigm is routine.[146] The prima facie case, once established by a plaintiff, must be answered by the employer, and that answer must, in turn, be seriously called into question before the plaintiff gets to trial.[147] If employment cases were litigated like trademark cases, both parties would submit evidence on all sorts of things at the same time, ranging from how the employer treated similarly situated employees to why it fired the plaintiff, with neither an order to the presentation nor any sense of what matters most. In fact, each part of the *McDonnell Douglas* method acts as a gatekeeper to a federal court. If a plaintiff cannot establish a prima facie case (step one), then there is no need for an employer-defendant to even articulate its reason for its challenged decision.[148] And if the plaintiff cannot call into question the truthfulness of that reason, then there can be no trial.[149] So, the course each party must travel is well-laid, though admittedly the plaintiff has more to do to get through it.

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[144] The impracticality of multi-factor balancing tests has drawn comment from the Supreme Court, which in some circumstances has rejected them. *See* Lechmere, Inc. v. Nat'l Labor Relations Bd., 502 U.S. 527, 536 (1992) (rejecting the Labor Board's adoption of a "multifactor balancing test" to determine union access to a private property and pointing out that even the Board "conceded that [its] analysis was unlikely to foster certainty and predictability in this corner of the law"); Grubart, Inc. v. Great Lakes Dredge & Dock Co., 513 U.S. 527, 547 (1995) ("[T]he proposed four- or seven-factor test would be hard to apply, jettisoning relative predictability for the open-ended rough-and-tumble of factors, inviting complex argument in a trial court and a virtually inevitable appeal."); Granfinanciera, S.A. v. Nordberg, 492 U.S. 33, 70 (1989) (Scalia, J., concurring) (rejecting a test based on "intuitive judgments" to interpret the Constitution in favor of one "anchored in rules, not set adrift in some multifactored 'balancing test'"). Even scholars who recognize the problems with multi-factor tests resign themselves to making the best of them. *See* Beebe, *supra* note 85, at 1648–49.

[145] *See supra* Part I.

[146] Fitzgerald v. Action, Inc., 521 F.3d 867, 871 (8th Cir. 2008) ("In the absence of direct evidence of an employer's deliberate interference with future benefits, analyze § 510 interference claims using the *McDonnell Douglas* three-part burden shifting analysis common to all Title VII and ADEA cases.") A Westlaw search reveals that the Supreme Court's *McDonnell Douglas Corp. v. Green* decision has been cited by courts over 125,000 times.

[147] *See* McDonnell Douglas Corp. v. Green, 411 U.S. 792, 802, 804 (1973).

[148] Gantt v. Wilson Sporting Goods Co., 143 F.3d 1042, 1048 (6th Cir. 1998) ("Because she has not established a prima facie case of either age or disability discrimination, under the *McDonnell Douglas* burden shifting procedure the court's analysis is over and there is no need to address the question of pretext.").

[149] *See* Dickerson v. Bd. of Trs. of Cmty. Coll. Dist. No. 522, 657 F.3d 595, 603 (7th Cir. 2011) (finding it correct to grant summary judgment to District 522 because the employee could not "point to a genuine issue of fact as to whether he was a satisfactory employee"). This is because a court's decision that an employer's articulated reason for its decision is true (and not a cover-up) is incompatible with a decision that a jury might find discrimination occurred. Either the employer is lying or it is not. Ultimately, an employer might not be found liable even if the plaintiff does call into question its truthfulness. The Supreme Court has made it clear that, at trial, it is not enough

Trademark law should have a similar burden-shifting method to be used in litigating likelihood of confusion cases. It might work like this. Rather than litigate over seven or even thirteen factors in a simultaneous, directionless manner, a plaintiff alleging trademark infringement would need to establish four things, the equivalent of a prima facie case: (1) that the marks are, in fact, similar; (2) that the plaintiff's mark is strong; (3) that customers exercise little care prior to purchasing products in the industry; and (4) that the products themselves are similar. Establishing all four factors would trigger a responsibility on the defendant's part to proffer that it is not aware of many instances in which customers have actually confused the two parties' marks. That may sound like a low hurdle, but so is the burden on an employer in step two under *McDonnell Douglas*: It is met simply by articulating a non-discriminatory reason for its decision. If there are no or few instances of actual confusion, then the burden would shift back to the plaintiff alleging infringement to establish a triable issue concerning a likelihood of confusion. It might do so in multiple ways: by showing intent on the defendant's part to infringe, greatly overlapping markets, or perhaps, survey evidence strongly suggesting that customers are poised to start confusing the marks once they confront them in the actual marketplace. Intent to infringe is not the same thing as actual infringement, but at step three, it should be enough to get the plaintiff to trial on the matter. As to overlapping markets, if the parties' marks are similar and across the street from one another,[150] the case is likely not suited for summary judgment.[151] Survey evidence is routine in these cases in the first place,[152] so there can be no argument that the plaintiff has not yet been given the opportunity to simulate confusion where none is yet apparent.

Damages in trademark cases are as undisciplined as the likelihood of confusion factors that courts juggle to determine infringement.[153] While statutory damages are considered equitable in this case,[154] there can be other awards of money as well: A prevailing plaintiff (and a prevailing defendant in limited circumstances) can claim its lost profits and the disgorged profits of the infringing party,[155] compensatory but not punitive damages,[156] and, typically in cases of intentional infringement or willful

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to disbelieve an employer's reason; a plaintiff must also prove that discrimination was the real reason for the employer's action. St. Mary's Honor Ctr. v. Hicks, 509 U.S. 502, 515 (1993).

[150] *See* AutoZone, Inc. v. Strick, 543 F.3d 923, 927 n.2 (7th Cir. 2008) (reversing summary judgment in trademark infringement case where junior OilZone mark was within one mile of AutoZone store). Even if the marks are not across the street from one another, they at least need to be close enough for a typical consumer to run across both marks. *Id.*

[151] *Id.* at 929, 931.

[152] *See, e.g.*, Evory v. RJM Acquisitions Funding, LLC, 505 F.3d 769, 776 (7th Cir. 2007) (explaining that consumer survey evidence is probably the most useful type of evidence in some cases, but pointing out that not all circuits are as receptive to that type of evidence).

[153] *See* 5 MCCARTHY, *supra* note 11, § 30:77 ("Since it may be very difficult for plaintiff to prove the fact and amount of damage to its good will, plaintiff should be allowed the chance to prove this with whatever evidence he can muster.").

[154] 15 U.S.C. §§ 1117(c), (d) (2012).

[155] 15 U.S.C. § 1117(a).

[156] *Id.; see also* Zazu Designs v. L'Oreal, S.A., 979 F.2d 499, 507 (7th Cir. 1992) ("Punitive damages are problematic because the Lanham Act, although providing for the trebling of compensatory damages, forbids other penalties.").

ignorance, treble damages.[157] All of this can be awarded on top of attorney's fees,[158] which can easily exceed seven figures in a major case.[159] Compare these damages to those a prevailing party in an employment discrimination case can expect to receive: compensatory and punitive damages (not trebled) up to a statutory cap of $300,000[160] and only in cases where the plaintiff has brought a case of intentional discrimination.[161] In cases lacking intent, like disparate impact claims, the plaintiff gets none of these monetary damages and can only receive equitable relief from a judge (juries do not decide disparate impact cases).[162]

Ruling out money damages in unintentional discrimination cases makes sense. If a plaintiff prevails, it means she can trace a difference in treatment and injury to an employer policy, but not an employer's animus[163] (a weight-lifting or height requirement are classic examples of potential sex discrimination).[164] While it might make sense to compensate the plaintiff in a case like this for lost wages,[165] it makes no sense to award money damages against an employer that did not set out to break the law.[166] Substitute an infringing party for this employer and the same arguments hold. A company that adopts a confusingly similar mark, but does so unintentionally, is in the same position as the employer that adopts a facially neutral policy that ends up discriminating nonetheless. Without intent, there is no reason to punish the defendant with compensatory money damages.[167] Perhaps the only money damages that, in theory, should be awarded in a case of unintentional infringement are lost profits that are directly attributable to the defendant's infringement. The

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[157] 15 U.S.C. § 1117(b). Section 1117(a) of the Lanham Act does not expressly require a finding of willful infringement or bad intent in order to award treble damages. *Id.* § 1117(a). The statute allows that a court may, "according to the circumstances of the case," determine that a "sum above the amount found as actual damages, not exceeding three times such amount," may be appropriate. *Id.* Nevertheless, some courts do require a finding of willfulness prior to awarding any monetary damages. *See* Masters v. UHS of Del., Inc., 631 F.3d 464, 472 n.2 (8th Cir. 2011) (noting a circuit split on the issue); Gorenstein Enters., Inc. v. Quality Care-USA, Inc., 874 F.2d 431, 436 (7th Cir. 1989) (finding treble damages proper when the infringement is deliberate).

[158] 15 U.S.C. § 1117(a). The Lanham Act allows a court to award attorney's fees to the prevailing party in "exceptional cases." *Id.*

[159] *See e.g.*, Cent. Benefits Mut. Ins. Co. v. Blue Cross & Blue Shield, Nos. 91-4159, 92-3079, 92-3043, 91-4160, 1992 WL 393577, at *1 (6th Cir. Dec. 29, 1992) (affirming an award of $2.5 million in attorney's' fees).

[160] 42 U.S.C. § 1981a(b)(3) (2012).

[161] *Id.* §§ 1981a(a)(1), (b).

[162] *See id.* §§ 1981a(a)(1), (c); 42 U.S.C. § 2000e-5(g) (2012).

[163] *See* Watson v. Fort Worth Bank & Trust, 487 U.S. 977, 986–87 (1988) ("In certain cases, facially neutral employment practices that have significant adverse effects on protected *groups* have been held to violate the Act without proof that the employer adopted those practices with a discriminatory intent.") (emphasis in original)..

[164] *See id.* at 988–89 (noting different disparate impact cases involving "standardized employment tests or criteria").

[165] 42 U.S.C. § 1981a(b)(2); *see also* Mugavero v. Arms Acres, Inc., 680 F. Supp. 2d 544, 581 (S.D.N.Y. 2010) (explaining that a back pay award under the statute includes lost wages and anticipated raises or fringe benefits).

[166] *See* 42 U.S.C. § 1981a(a)(1), (b)(2).

[167] *See* 15 U.S.C. § 1117(a) (2012). As it stands, a court may fashion its own notion of appropriate compensatory damages under § 1117(a) of the Lanham Act based on the "circumstances of the case." *Id.*

close cousin to this in the world of employment law is: back pay for the prevailing plaintiff.[168]

The great disparity between available damages in employment cases and trademark cases—both set by Congress—makes sense only if the harms associated with trademark infringement justify the difference. To be sure, trademarks serve important purposes. Protecting them helps reduce consumer search costs,[169] which could not be accomplished if businesses operated in a Wild West of lawless competition rooted in counterfeit and infringement. And once a brand is established and identifiable—which takes time and money—it makes sense to protect it from free riders and fly-by-night companies out to make a quick buck.[170] But unintentional infringement lacks these ignoble pursuits. Indeed, this form of infringement lacks motive, period. And while the injury or damage nevertheless remains, it also remains in the case of unintentional discrimination, and employees and employment markets need confidence, too: They need to know that workplaces are free of unlawful stereotypes or discriminatory work rules. If anything, given the history of discrimination in employment markets, the argument for awarding money damages in all cases, with or without intent, appears stronger in employment law than in trademark cases.

IV. WHAT TRADEMARK LAW CAN TEACH EMPLOYMENT LAW

Nothing is perfect, including employment litigation, and there are at least three areas where trademark litigation could teach a thing or two to the employment bar. First, the formal manner in which the Board approaches *inter partes* litigation provides both structure and order so that the parties can litigate.[171] Parties start the case with a discovery conference, just as they do in federal court.[172] They meet and confer over disputes,[173] file motions,[174] and pursue summary judgment, just as they do in the federal system.[175] The Board's docket is publicly available,[176] just as it is on PACER.[177] And if the parties finish what they start before the Board, and actually

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[168] *See Mugavero*, 680 F. Supp. 2d at 581.

[169] *See* 1 MCCARTHY, *supra* note 11, § 2:5 ("[An] important economic function of trademarks is that they reduce the consumer's cost of collecting information about products.").

[170] *See id.* § 2:3.

[171] *See supra* Part II.

[172] *See* TBMP, *supra* note 6, § 401.01.

[173] *See, e.g.*, *id.* § 408.01 (describing the parties' general duty to cooperate); *id.* § 502.06(b) (detailing the power of the Board to order parties to appear in person for a pretrial conference in order to resolve disputes); *id.* § 523.02 (describing the duty of the parties to make a good faith effort to resolve discovery dispute before filing a discovery motion).

[174] *Id.* § 502 ; *id.* § 502.01 ("There is a wide range of motions which may be filed in inter partes proceedings before the Board").

[175] *Id.* § 528; FED. R. CIV. P. 56.

[176] *See Trademark Trial and Appeal Board Inquiry System* ("TTABVUE"), U.S. PAT. & TRADEMARK OFF., http://ttabvue.uspto.gov/ttabvue/ (last visited Oct. 19, 2012).

[177] *Search for Case Information*, PACER, http://www.pacer.gov/findcase.html (last visited Oct. 10, 2012). PACER stands for Public Access to Court Electronic Records. *Id.* It is managed by the United States Courts but unlike TTABVUE, it does not provide free access to filings. *See Electronic Public Access Fee Schedule, I*, U.S. CTS.,

litigate a case to its conclusion, there may well be little reason for them to litigate in federal court.[178] While the EEOC does little to nothing in terms of finding facts and deciding cases on the merits,[179] that is exactly what the Board does.[180] More work done at the administrative level may well lead to a final outcome that both parties accept as just that: final.

Second, experts are common and welcome in trademark cases,[181] but are not regularly used in employment cases.[182] They could be used more with success. In a trademark case, a party may hire an expert to conduct a consumer survey, testing the likelihood of confusion between marks,[183] or even an expert in linguistics to help the court understand the meaning and likely commercial impression of words.[184] Words matter in employment cases, too. In fact, expressions such as "hard to teach an old dog new tricks" have been interpreted by some courts as strong evidence of age discrimination.[185] But these courts have no expertise in language, idioms, or the etymology of English expressions. Under the right circumstances, an expert may help a court understand what these expressions mean or, at the very least, might make a court cautious before it quickly concludes that it can determine the meaning on its own.

Third, the Trademark Office is smart to staff itself with attorneys. The examiner, who is the first person to review a trademark applicant's specimen for national registration,[186] is a lawyer who specializes in trademark law and evaluates the proposed mark within the existing legal framework. In other words, the

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http://www.uscourts.gov/FormsAndFees/Fees/ElectronicPublicAccessFeeSchedule.aspx (last visited Oct. 19, 2012).

[178] *See* TBMP, *supra* note 6, § 700.syn (outlining trial procedure before the Board).

[179] *See supra* Part I. Technically the EEOC has the power to order that the parties attend a fact-finding conference, 29 C.F.R. § 1601.15(c) (2012), and even has the power to issue subpoenas to require testimony or the production of evidence. *Id.* §§ 1601.16(a),.17(a). But as described in Part I, these are powers that head nowhere as the agency has no authority to make findings of fact or award any relief to a private sector plaintiff. In fact, the agency may determine to issue a right to sue letter to a charging party after concluding that it probably will not be able to complete its investigation within the statute's prescribed timeline: 180 days. *Id.* § 1601.28(a)(2).

[180] *See* TBMP, *supra* note 6, § 803.

[181] *See* 4 MCCARTHY, *supra* note 11, § 23:2.75.

[182] *See* Brian L. McDermott & Susannah P. Mroz, *The Use of Experts in Employment Discrimination Litigation*, FED. LAW., June 2011, at 20, 20 (explaining that plaintiffs have only recently begun to use experts in employment cases outside traditional means, such as damages and statistics).

[183] *See* 4 MCCARTHY, *supra* note 11, § 32:158.

[184] *See* Duncan, Inc. v. Royal Tops Manu. Co., 343 F.2d 655, 660 (7th Cir. 1965). Qualified linguistic experts in trademark cases have been accepted by courts *for almost fifty years*. *See id.* (describing expert testimony of Professor of Linguistic English, who qualified as an expert linguist in trademark case and testified as to the origin of the term "yo-yo"); Mead Johnson & Co. v. Abbott Lab., 201 F.3d 883, 886 (7th Cir. 2000) (explaining that discovering usage and interpreting usage is best left to experts: "[I]t would be a bad idea to replace the work of these professionals with the first impressions of people on the street").

[185] *See* Blackwell v. Cole Taylor Bank, 152 F.3d 666, 671–72 (7th Cir. 1998).

[186] *See In re* R.M. Smith, Inc., 734 F.2d 1482, 1483 (Fed. Cir. 1984) ("The PTO Trademark Attorney (erstwhile examiner), refused registration on the ground that the configuration sought to be registered is functional, is similar to the designs of many other nozzles, not particularly unusual, and has not been shown by evidence to have been promoted as a trademark.").

examining attorney knows not only the facts surrounding the trademark application, but also knows what the Board and courts are looking for in these cases. Imagine if the EEOC investigator assigned to a discrimination charge were an employment lawyer who understood which cases are likely headed for summary judgment. The investigator could save everyone a lot of time—and money—by persuading the charging party that she is unlikely to win, and that advice might be respected by her attorney, too. As it stands, the reality is that defendants' attorneys generally look at the EEOC's investigative phase as something of little consequence to endure. And plaintiffs' attorneys certainly do not see the process as providing a realistic assessment of their chances in court.

V. WHY LAWYERS SHOULD FIGHT AGAINST EXCESSIVE SPECIALIZATION

In many ways, what lies at the heart of this paper and its approach, is foreign to the modern day lawyer. General practitioners still exist, but not at the largest firms with the most important clients, and even lawyers with larger practice areas would generally not include both trademark and employment litigation in their listed practice areas. Lawyers are taught to specialize, or are taught by specialists, and both circumstances provide little room for a lawyer to seek or see connections across disciplines or even across the room.[187] It is an odd result, really, when placed in the context of what brought many of these lawyers to the profession in the first instance: strong writing skills that are typically tied to being a well-read individual with qualitative majors, like English, that tend to reward creativity and non-linear thinking, and liberal arts backgrounds. Something happens in law school that stifles creativity, and what starts there is completed by the experience in the firm.

But the most successful individuals in other industries demonstrate that lawyers are missing a great deal by wearing these blinders. Consider the experience of Steve Jobs, one of the founders of Apple, relayed by him at a commencement address at Stanford University. Jobs spoke about dropping out of Reed College as an undergraduate student,[188] only to drop into the classes that interested him:

> Reed College at that time offered perhaps the best calligraphy instruction in the country. Throughout the campus every poster, every label on every drawer, was beautifully hand calligraphed. Because I had dropped out and didn't have to take the normal classes, I decided to take a calligraphy class to learn how to do this. I learned about serif and sans serif typefaces, about varying the amount of space between different letter combinations, about what makes great typography great. It was beautiful, historical, artistically subtle in a way that science can't capture, and I found it fascinating.

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[187] MODEL RULES OF PROF'L CONDUCT R. 1.1 cmt. [1] (2012).

[188] Steve Jobs, CEO, Apple Computer & Pixar Animation Studios, Commencement Address at Stanford University (June 12, 2005), *in* STAN. REP., June 2005, *available at* http://news-service.stanford.edu/news/2005/june15/jobs-061505.

> None of this had even a hope of any practical application in my life. But ten years later, when we were designing the first Macintosh computer, it all came back to me. And we designed it all into the Mac. It was the first computer with beautiful typography. If I had never dropped in on that single course in college, the Mac would have never had multiple typefaces or proportionally spaced fonts. . . . Of course, it was impossible to connect the dots looking forward when I was in college. But it was very, very clear looking backwards ten years later.[189]

When Jobs died, his Stanford speech was cited for the way he thought about life and prepared for death.[190] But it is also an eloquent demonstration of what can happen to the human imagination and intellect if we allow ourselves to solve one problem by borrowing what we have undoubtedly learned and perhaps stored from other life experiences.

Judges know how to do this better than lawyers do. Of course, judges are not allowed to specialize: The typical federal appeals court judge may be faced with writing an opinion in a criminal appeal one day, but a civil rights or trademark case the next. Judges Posner and Easterbrook are two judges known for referring to other areas of law.[191] There is one example that particularly relates here: The use of surveys is pretty standard in trademark infringement cases, Judge Easterbrook points out, so why not in products liability cases?[192] A jury of six is probably too small to make the call as to whether marks are likely to be confusing in the marketplace, and they are certainly not a reliable proxy for what stands as a reasonable "consumer's expectations" when handling a product.[193] That is where surveys come in. But it is simply not in the DNA of most lawyers to argue about the need for survey evidence in one area of law by referencing its use in another.

The solution to excessive specialization may be at the law school level, where law students could be taught that the same liberal arts background and thinking that brought many of them to these schools in the first place can save them from a stifling career of compartmentalization. Some graduate schools in business have capstone courses that come toward the end of a student's curriculum. The courses force students to put their classroom experiences together in an effort to think multi-

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[189] *Id.*

[190] John Markoff, *Steven P. Jobs, 1955-2011; Redefined the Digital Age as the Visionary of Apple*, N.Y. TIMES, http://query.nytimes.com/gst/fullpage.html?res=9E0CE6DD1139F935A35753C1A9679D8B63&ref=johnmarkoff&smid=pl-share..&smid=pl-share (last updated Oct. 7, 2011).

[191] *See, e.g.*, Show v. Ford Motor Co., 659 F.3d 584, 586 (7th Cir. 2011) (referring to trademark litigation and other areas of law in a products liability case). Both are judges on the United States Court of Appeals for the Seventh Circuit. *Contact Information*, U.S. CT. OF APPEALS FOR THE SEVENTH CIRCUIT, http://www.ca7.uscourts.gov/contact.htm (last visited Oct. 10, 2012); *see also* Marcelle v. Brown Cnty. Corp., 680 F.3d 887, 887 (7th Cir. 2012) (having both judges on the same three-judge panel).

[192] *See Show*, 659 F.3d at 586.

[193] *See id.* ("Many federal civil cases are resolved by six-person juries, and none by more than twelve. That is too few to reveal what expectations consumers as a whole may have.").

dimensionally.[194] The students are then more likely to come up with richer solutions to problems in the real world. For example, think of a human resources manager who uses his knowledge of information systems to improve his evaluations of employees and perhaps establish performance-based incentives. But law schools tend not to weave their courses together at the end, which means lawyers have no practice doing it and no personal experience that it can be a helpful exercise.

As it is, without any institutionalized effort to make lawyers less myopic, attorneys might make their own efforts in order to improve their practice and their workmanship. Lawyers in large firms might suggest associating or apprenticing on a case outside of their practice area. Those in small firms might find joining unfamiliar practice groups in bar associations can do the trick. Lawyers who make these efforts are the ones who can speak to clients—as well as to judges and juries—in words and with references that suggest knowledge and not narrowness.

CONCLUSION

The law is simply too specialized. In fact, it may be one of the most specialized professions. Lawyers at the highest levels rarely practice in more than one area. Most trademark lawyers could not march through the *McDonnell Douglas* indirect method if their life depended on it; similarly, employment lawyers would hardly consider intellectual property to be a close cousin. But what would happen if we, as lawyers, started to borrow from various areas of law in order to improve the one in which we spend most of our time? What would happen if we thought of ourselves first and foremost as attorneys rather than employment or intellectual property lawyers? We could still specialize, but we would no longer miss out on improvements that are waiting for us if we seek them out.

The purpose of this paper has been to point to the kinds of connections and improvements that are possible. In one sense employment law and trademark litigation have little in common. Different governmental agencies supervise these areas and lawyers need vastly different training to practice in them. But these are not foreign languages. They are laws, written in English, and in the case of trademarks, they present striking opportunities for improvement. Jettisoning an unworkable multi-factor "likelihood of confusion" test and overhauling the role of the Trademark Trial and Appeal Board are two prime paths to improvement.[195]

If trademark law can borrow from employment law and improve, undoubtedly other combinations could lead to a simpler, and more elegant legal landscape. The question remains: What are they and how quickly can we discover them?

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[194] *See, e.g.*, *Leo Burke: Q&A*, NOTRE DAME BUS. ONLINE, http://www.nd.edu/~ndbizmag/issue9/q_and_a.shtml (last visited Sept. 27, 2012) (explaining that the University of Notre Dame Executive MBA program requires students to end their education with a course entitled "The Weave").

[195] *See supra* Part III.