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## Property and Equity in Trademark Law

Mark McKenna

*Notre Dame Law School*, [markmckenna@nd.edu](mailto:markmckenna@nd.edu)

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# PROPERTY AND EQUITY IN TRADEMARK LAW

MARK P. MCKENNA

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Let me begin by thanking Dean Kearney and Professors Boyden and Murray for inviting me to give this lecture. It is a wonderful privilege to give a lecture named after Judge Helen Nies, and I am particularly humbled to have been asked to join the group of really eminent scholars and practitioners who have given the Nies Lecture over the years.

My talk today is going to focus on the relationship between trademark and unfair competition. As I was preparing the talk, I was delighted to learn about Judge Nies’s career as a trademark practitioner. I had been quite familiar with Judge Nies and her contributions to patent law, and obviously, she sat on a court that also hears some significant trademark cases. But I learned from Graeme Dinwoodie’s 2004 Nies lecture that for approximately twenty years prior to her judicial service, Helen Nies was a prominent practitioner of trademark law and even an Adviser to the Restatement (Third) of Unfair Competition, which was published in 1995, shortly before she passed away.<sup>1</sup> So I am happy that my topic today is a really appropriate fit with this lecture series.

As I alluded to before, I am going to discuss the way trademark law has evolved over time with respect to property concepts. Let me try to give you a sense of what I mean by that.

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1. See Graeme B. Dinwoodie, *The Seventh Annual Honorable Helen Wilson Nies Memorial Lecture on Intellectual Property Law: The Trademark Jurisprudence of the Rehnquist Court*, 8 MARQ. INTELL. PROP. L. REV. 187, 188 (2004).

There has been a lot of discussion in the literature about the ways trademark law has come to treat trademarks as property.<sup>2</sup> Many scholars who have written about this “propertization” have described it as a shift from consumer to producer protection.<sup>3</sup> Once upon a time, the story goes, trademark law aimed to protect consumers against confusion. It gave producers a cause of action against others who used similar marks in ways that would confuse consumers—but it did so only because the producers happened to be well situated and highly motivated to vindicate consumer interests.<sup>4</sup> A number of modern doctrines (many of which allow claims based on much more attenuated forms of confusion or do not require evidence of confusion at all) reflect a problematic shift away from those consumer interests and toward protection of producer property interests.<sup>5</sup>

I have written a lot about this narrative over the course of my career—I think it is overly simplistic, and in some ways, wrong. Trademark law has always protected marks as property and always significantly for the purpose of protecting producers.<sup>6</sup> What *has* changed is that modern law conceives of the property interests much more broadly than it once did. So the important shift in trademark law was not one from a system focused exclusively on consumer interests to one focused on producers, or from no-property to property—it was a shift in terms of the nature of the property interest protected.<sup>7</sup>

But even that revised narrative misses some important things about trademark law’s evolution because it is insufficiently attentive to significant changes in the doctrinal structure of trademark law over the course of the last century—specifically with respect to the relationship between trademark law and the broader law of unfair competition. Changes in that relationship, I will argue, *did* work a meaningful change in the “propertization” of trademark law. Relatedly, and necessarily, these same changes deemphasized legal rules that focused on the defendant’s conduct (rather than the plaintiff’s ownership interest).

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2. See, e.g., Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099, 2120–21 (2004); Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1693–94 (1999); Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 EMORY L.J. 367, 371–72 (1999); see also Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1873–74 (2007) (discussing much of this literature).

3. See Lemley, *supra* note 2, at 1688; Lunney, *supra* note 2, at 371–72; McKenna, *supra* note 2, at 1846–47.

4. See McKenna, *supra* note 2, at 1860–66.

5. See, e.g., Bone, *supra* note 2, at 2121–22; Lemley, *supra* note 2, at 1688–89; Lunney, *supra* note 2, at 371–72.

6. See McKenna, *supra* note 2, at 1840–41.

7. *Id.* at 1884.

## I. TRADEMARKS AND UNFAIR COMPETITION

To understand the shift I am describing, we need to begin with a bit of history.

The subject matter of trademark law was once defined in limited, ontological terms.<sup>8</sup> As the court explained in *Davis v. Davis*, “A trade-mark is some arbitrary or representative device attached to or sold with merchandise and serving to designate the origin or manufacture of that merchandise.”<sup>9</sup>

On that definition, a trademark was a certain sort of thing—a word or device (a logo or image) that unambiguously indicated the source of the goods with which it was used. It unambiguously indicated the source because it was a word (like EXXON) or a logo (like the Nike swoosh) that gave no information about the nature of the products with which it was used, so there was no way to understand it except as a source indicator. To take a modern example: it makes no sense to put the image of an apple on a computer—a computer is not made of apples, does not taste like apples, does not come from a place called Apple, etc. For that reason, the only sensible conclusion to draw about the image of the apple on a computer is that it must be a brand.

In addition to being a certain sort of thing, a trademark also had to be used in a certain sort of way—separate from,<sup>10</sup> and affixed to, the goods whose origin the mark indicated.<sup>11</sup> Trademarks indicated the origin of goods; they were not themselves the goods.

8. See generally Graeme B. Dinwoodie, *The Death of Ontology: A Teleological Approach to Trademark Law*, 84 IOWA L. REV. 611 (1999).

9. *Davis v. Davis*, 27 F. 490, 491–92 (C.C.D. Mass. 1886).

10. *Id.* at 492 (“I do not think that the merchandise itself, or any method of arranging the various packages, can be registered as a trade-mark. In the very nature of the case, as it seems to me, the trade-mark must be something other than, and separate from, the merchandise.”); see also JAMES LOVE HOPKINS, *THE LAW OF TRADEMARKS, TRADENAMES AND UNFAIR COMPETITION* § 47 (2d ed. 1905) (“It is obvious that if a commercial article itself could constitute a trademark, there would be little use for patent laws. As Judge Carpenter said, ‘in the very nature of the case . . . the trademark must be something other than, and separate from, the merchandise.’”).

11. See *M’Andrew v. Bassett* (1864) 46 Eng. Rep. 965, 968 (Ch.) (Eng.) (holding that marks only become protectable once they are physically attached to goods and sold in the marketplace, not merely when they acquire a reputation or fame); see also *Kathreiner’s Malzkaffee Fabriken Mit Beschraenkter Haftung v. Pastor Kneipp Med. Co.*, 82 F. 321, 326 (7th Cir. 1897) (adopting the affixation rule of *M’Andrew*). The Trademark Act of 1881 required that trademark applications contain “a statement of the mode in which the same is applied and affixed to goods.” Trademark Act of 1881, ch. 138, § 1, 21 Stat. 502, 503, *superseded by* Pub. L. No. 58-84, 33 Stat. 724, 724 (1905), *repealed by* Lanham Act, Pub. L. No. 79-489, § 46(a), 60 Stat. 427, 444 (codified as amended in scattered sections of 15 U.S.C.). The 1905 Act contained an identical provision. See Trademark Act of 1905, ch. 592, 33 Stat. 724, 724, *repealed by* Lanham Act, Pub. L. No. 79-489, § 46(a), 60 Stat. 427, 444 (codified as amended in scattered sections of 15 U.S.C.).

Only indicators that met those conditions were considered trademarks; only trademarks defined as such and used in interstate commerce were eligible for federal registration;<sup>12</sup> and only federally-registered marks could be enforced under federal statutory law.<sup>13</sup> Several types of indicators that modern law treats as trademarks under some circumstances (things like surnames, descriptive terms, geographic terms, and product packaging) were not considered trademarks under this more restrictive definition because the meaning of those things was facially ambiguous.<sup>14</sup> Those indicators *could* be used to indicate the source of goods, but they also could be used to communicate characteristics of the goods or other information about their origin. MILWAUKEE'S BEST, for example, might refer to a particular brand of beer, or it might just describe (in laudatory fashion) a company's beer as being the best in Milwaukee.<sup>15</sup> Because terms like these were facially ambiguous, they were not amenable to exclusive ownership and were therefore not considered trademarks.

But the fact that trademark subject matter was narrowly defined did not mean that the law offered no protection against misuse of other sorts of indicators. Parties that did not own trademarks (or "technical trademarks" as they would come to be known)<sup>16</sup> could still bring common law unfair competition claims against those who, by means other than use of a trademark, attempted to pass off their goods as though they were the plaintiff's.<sup>17</sup>

Because those unfair competition cases involved use of matter that had plausibly legitimate explanations, courts could not simply presume the

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12. There was one exception Section 5 of the Trademark Act of 1905 provided that nothing . . . shall prevent the registration of any mark used by the applicant or his predecessors . . . in commerce with foreign nations or among the several states, or with Indian tribes, which was in actual and exclusive use as a trademark of the applicant or his predecessors from whom he derived title for ten years next preceding the passage of this act.

Trademark Act of 1905 § 5.

Despite that section's reference to registration of a "trademark," implying that only terms that qualified as trademarks were eligible, the Supreme Court interpreted § 5 to allow for registration of marks that were not technical trademarks. Because, technical trademarks were registrable once used in commerce even without ten years of exclusive use, the Court believed that § 5 would have no effect if it merely allowed for registration of technical trademarks with longer use. *Thaddeus Davids Co. v. Davids*, 233 U.S. 461, 465–66 (1914). Despite the statutory terminology, registration under § 5 did not make the registered mark into a technical trademark, but it did allow the owner of the registration to enforce its rights under federal law. *Id.*

13. See Trademark Act of 1905 § 16 (creating cause of action for infringement of registered marks); see also *id.* § 17 (granting federal courts jurisdiction in cases involving use of a registered mark in interstate commerce).

14. See McKenna, *supra* note 2, at 1862; Dinwoodie, *supra* note 8, at 614.

15. My college experience tells me that would have been false advertising. But I digress.

16. See 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 4:3 (5th ed. 2019); see also McKenna, *supra* note 2, at 1862.

17. See McKenna, *supra* note 2, at 1862.

defendant's conduct was illegitimate. As a result, courts typically required unfair competition claimants to prove that the defendant intended to pass off its goods as those of the plaintiff, or at least that passing off was the likely consequence of the defendant's conduct.<sup>18</sup> To make that showing, an unfair competition plaintiff necessarily had to prove that the defendant made some explicit misrepresentation or used some word or feature that consumers would associate with the plaintiff. Trademark claimants were not required to prove any of those things—source indication and intent to pass off were presumed.<sup>19</sup>

Prevailing plaintiffs in unfair competition cases also got more limited remedies—remedies sufficient to prevent the passing off, but short of a prohibition on use of the term/feature.<sup>20</sup> As the court said in *G. & C. Merriam Co. v. Saalfeld*, when an unfair competition plaintiff proves secondary meaning, there is a “conflict of right.”<sup>21</sup>

The alleged trespassing defendant has the right to use the word, because in its primary sense or original sense the word is descriptive; but,

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18. See FRANK I. SCHECHTER, *THE HISTORICAL FOUNDATIONS OF THE LAW RELATING TO TRADE-MARKS* 161 (1925). Some courts, particularly as the twentieth century progressed, did not require unfair competition plaintiffs to prove intent, only that the defendant's conduct was likely to result in passing off. See, e.g., *Elgin Nat'l Watch Co. v. Illinois Watch Co.*, 179 U.S. 665, 674 (1901) (holding that, where an injunction is issued to prevent unfair competition, the evidence must disclose “wrongful intent in fact, or justify that inference from the inevitable consequences of the act complained of”); *Coty, Inc. v. Parfums de Grand-Luxe, Inc.*, 298 F. 865, 869–70 (2d Cir. 1924) (“[W]hile there has been some difference of opinion, it is thought to be the better view that, where the necessary and probably tendency of defendant's conduct is to deceive the public and pass off his goods as and for those of the plaintiff, especially where preventative relief only is sought, actual fraudulent intent need not be shown.”).

19. See, e.g., *Socony-Vacuum Oil Co. v. Oil City Refiners*, 136 F.2d 470, 474 (6th Cir. 1943) (“In cases involving technical trademarks, the fraudulent intent to deceive is presumed, while in cases of unfair competition complainant must prove this intent or show facts and circumstances from which it may reasonably be inferred.”); *Goldsmith Silver Co. v. Savage*, 229 F. 623, 627 (1st Cir. 1915) (“In the case of infringement of a technical trade-mark the intention of the infringer is immaterial, as the essence of the wrong lies in the injury to a property right; while in the case of unfair competition the intention is material, to establish fraud on the part of the defendant in the use of the imitative device to beguile the public into buying his goods as those of his rival.”); see also McKenna, *supra* note 2, at 1862.

20. See, e.g., *DuPont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75, 80, 82 (2d Cir. 1936) (holding “cellophane” generic for cellulose wrapping but requiring defendant to identify itself as the source of goods to avoid confusion with plaintiff); *Barton v. Rex-Oil Co.*, 2 F.2d 402, 404 (3d Cir. 1924) (“[T]he utmost that the courts can do for the relief of the first user [in a case of unfair competition] is to enjoin not the use of the trade-mark but the unfair method of its use.”); *Saalfeld*, 198 F. at 373–76 (allowing defendant to use the generic term “Webster's dictionary” so long as it explained that it was not the plaintiff); *L.E. Waterman Co. v. Modern Pen Co.*, 197 F. 534, 535 (2d Cir. 1912) (allowing defendant to continue to use the surname “Waterman” but requiring a label that disclaimed connection with the plaintiff).

21. *Saalfeld*, 198 F. at 373.

owing to the fact that the word has come to mean, to a part of the public, something else, it follows that when the defendant approaches that same part of the public with the bare word, and with nothing else, applied to his goods, he deceives that part of the public, and hence he is required to accompany his use of the bare word with sufficient distinguishing marks normally to prevent the otherwise normally resulting fraud.<sup>22</sup>

Following this logic, courts would not have prevented other beer producers in Milwaukee from identifying their beer as being from Milwaukee or from claiming their beer was the "best." They would, however, have prevented those other producers from presenting that information in a way that suggested their beer was the same MILWAUKEE'S BEST that was sold by the company that had long been selling beer under the name MILWAUKEE'S BEST.

To summarize: in this legal world that once existed, trademark and unfair competition were conceptually integrated but doctrinally distinct bodies of law.<sup>23</sup> They were conceptually integrated in that all of unfair competition law aimed to prevent passing off.<sup>24</sup> Imitation of another's trademark was just a special case of unfair competition because, as prominent nineteenth-century treatise writer James Love Hopkins said, use of another's mark "is the easiest method of stealing [someone's] trade, and most universal because of the general use of marks or brands upon personal property."<sup>25</sup> It was in this sense that trademark law has always been regarded as part of the "broader law of unfair competition."<sup>26</sup>

22. *Id.*

23. See, e.g., *Am. Prods. Co. v. Am. Prods. Co.*, 42 F.2d 488, 489 (E.D. Mich. 1930) ("[T]his case involves a trade-name, not a trade-mark, and therefore is governed by the law of unfair competition, not that of trade-marks . . ."); see also McKenna, *supra* note 2, at 1860–63.

24. I focus here on trademark-adjacent unfair competition claims. Courts did recognize other types of unfair competition claims that did not involve source indication. Though those other claims are not my focus here, they did generally fit the broad pattern: they involved deceptive conduct that had the effect of diverting customers who otherwise would have gone to the claimant. Product disparagement and trade libel, for example, were recognized because they entailed false claims about a competitor or its products for the purpose of diverting that competitor's customers to oneself. See, e.g., *Maytag Co. v. Meadows Mfg. Co.*, 45 F.2d 299 (7th Cir. 1930) (affirming monetary damages awarded for unfair competition as a result of defendant's "defamatory propaganda" about plaintiff and its washing machines).

25. HOPKINS, *supra* note 10, § 1, at 2; see also McKenna, *supra* note 2, at 1860–63.

26. "The entire substantive law of trade-marks . . . is a branch of the broader law of unfair competition. The ultimate offense always is that defendant has passed off his goods as and for those of the complainant." Saalfeld, 198 F. at 372; see also *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 428 (2003) ("Traditional trademark infringement law is a part of the broader law of unfair competition . . . that has its sources in English common law . . ."); *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 412–13 (1916) ("The essence of the wrong consists in the sale of the goods of one

Trademark and unfair competition were doctrinally distinct in that trademark law dealt with misuse of the subset of indicators that qualified as trademarks under the prevailing, limited definition, while unfair competition was a residual doctrine that dealt with attempts to pass off by other means.<sup>27</sup> These claims were meaningfully different in that unfair competition claimants faced more onerous proof requirements and their remedies were more limited.

## II. EVOLUTION OF TRADEMARK AND UNFAIR COMPETITION

The legal structure I have just described largely held through the middle of the twentieth century. But then things began to change pretty fundamentally in terms of the relationship between trademark and unfair competition.

First, courts began interpreting the Lanham Act (the federal trademark statute passed in 1946) to provide a cause of action for infringement of unregistered trademarks.<sup>28</sup> To most trademark lawyers trained in the last few decades, that sounds unremarkable—we have long accepted that unregistered trademarks are enforceable under § 43(a) on essentially the same terms as registered marks.<sup>29</sup> But it is worth highlighting just how radically courts were changing trademark law when they started recognizing those claims in the 1950s.<sup>30</sup>

Every federal trademark statute prior to the Lanham Act made registration available only to indicators that qualified as trademarks under the much more limited definition,<sup>31</sup> and the cause of action created by those statutes was available only to federally-registered trademarks.<sup>32</sup> Those limitations were not arbitrary—they reflected the deep structure of trademark and unfair competition law, and the drafters of the Lanham Act did not believe they were changing that practice.<sup>33</sup>

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manufacturer or vendor for those of another. . . . This essential element is the same in trademark cases as in cases of unfair competition unaccompanied with trademark infringement. In fact, the common law of trademarks is but a part of the broader law of unfair competition.”).

27. McKenna, *supra* note 2, at 1863.

28. See 5 MCCARTHY, *supra* note 16, at § 27:12.

29. See *id.* § 27:14; *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (“[T]he general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a).”).

30. See J. Thomas McCarthy, *Lanham Act § 43(a): The Sleeping Giant is Now Wide Awake*, 59 L. & CONTEMP. PROBS. 45, 46 (1996) (noting that “section 43(a) has undergone an amazing transformation at the hands of the federal judiciary”).

31. Again, subject to the one exception in § 5 of the Trademark Act of 1905, at least as interpreted by the Supreme Court. See *supra* note 12.

32. Mark P. McKenna, *Trademark Law’s Faux Federalism*, in *INTELLECTUAL PROPERTY AND THE COMMON LAW* 288, 290–91 (Shyamkrishna Balganesh ed., 2013).

33. McCarthy, *supra* note 30, at 46–48 (reviewing the legislative history of section 43(a) and concluding “[t]here was no indication that the drafters thought that section 43(a) could or would become the basis for a federal claim of infringement of unregistered marks or trade dress”).



But the Supreme Court's decision in *Erie R. Co. v. Tompkins*<sup>34</sup> left many trademark proponents and several courts concerned about disuniformity in the law of unfair competition. Unfair competition had always been conceived of as general law; after *Erie*, courts were forced to conclude it was state law, and that raised the prospect of fifty different versions of unfair competition law.<sup>35</sup> Because that seemed unworkable, particularly as companies were increasingly selling to national markets, courts began to interpret § 43(a) to give a cause of action for infringement of unregistered marks. That is, they federalized a significant part of unfair competition as the solution to potential disuniformity.<sup>36</sup>

There was, however, an important terminological change here. Courts that allowed claims under § 43(a) were not recognizing a federal unfair competition cause of action; they were providing a cause of action for enforcement of *unregistered trademarks*.<sup>37</sup> That bears emphasis because most unfair competition cases explicitly did not involve *unregistered* trademarks. The indicators involved in those cases were not registered because they were *not trademarks*.<sup>38</sup> But over time, that nuance was lost; courts largely conflated unfair competition and trademark law.

Look no further than the *Abercrombie* spectrum. As anyone who has taken a trademark course knows—*Abercrombie* is the most black-letter of all the black-letter trademark law.<sup>39</sup> In fact, if you were going to teach only one case in the entire course, it would almost certainly be *Abercrombie*.

What *Abercrombie* teaches is that the way we determine whether a claimed indicator is a trademark is by placing it in a category along the "spectrum" (generic, descriptive, suggestive, arbitrary or fanciful).<sup>40</sup> The placement of a term determines whether it qualifies as a trademark automatically, whether the term

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34. *Erie R. Co. v. Tompkins*, 304 U.S. 64 (1938).

35. That worry, as it turns out, was never justified—there was never a real risk of disuniformity. See McKenna, *supra* note 32, at 298–300.

36. *Id.*

37. See, e.g., *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 776 (1992) (Stevens, J., concurring) ("[T]he Court interprets this section [§ 43(a)] as having created a federal cause of action for infringement of unregistered trademark or trade dress and concludes that such a mark or trade dress should receive essentially the same protection as those that are registered.").

38. See *supra* notes 8–11, 13–14, 16, and accompanying text. I am speaking generally here. There were, of course, some indicators that qualified as trademarks and therefore could have been federally registered but simply were not—either because they were not used in interstate commerce, or because the owner never bothered to register. But typically, state cases enforcing those marks regarded the actions as trademark infringement, just not federal trademark infringement.

39. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976); *Two Pesos, Inc.*, 505 U.S. at 768 (approving of the *Abercrombie* spectrum as the "classic formulation" of distinctiveness).

40. 2 MCCARTHY, *supra* note 16, at § 11:2.

qualifies only with additional evidence (secondary meaning), or whether it is disqualified.<sup>41</sup>

What's notable for our purposes here is that the *Abercrombie* spectrum serves as a way to determine whether a term is treated as a trademark or gets no protection.<sup>42</sup> And the spectrum is a mashup of trademark and unfair competition concepts. Indicators now placed in categories at the top end of the spectrum are those that we once simply would have called trademarks. We now call those terms "inherently distinctive," and they are automatically protectable simply by virtue of the classification.<sup>43</sup> Other categories, however, consist of indicators that were, by definition, *not trademarks*, such as descriptive words.<sup>44</sup> Those terms—like MILWAUKEE'S BEST—now potentially qualify as trademarks. We just ask their proponents for proof that the terms actually do indicate source and, if the proponents can make that showing, we pretend they are the same as old-time technical trademarks. Conditions for relief in the face of not owning a trademark have been transformed into requirements for proving trademark status.

This transformation has been so complete that the Supreme Court's accepted in *Two Pesos*<sup>45</sup> (a case about the design of a Mexican restaurant) and *Qualitex*<sup>46</sup> (a case about the color of a dry-cleaning press pad) that trademark subject matter is now defined *entirely* functionally: it consists of "anything at all that is capable of carrying [source-related] meaning."<sup>47</sup>

And when anything can be a trademark, there is no real need for a residual doctrine that provides relief for use of things that are not trademarks. If something does not qualify as a trademark, there is a reason—and the reason has to do with its lack of capacity to identify source, not its ontological status as color, shape, fragrance, word, or sign.

### III. CONSEQUENCES

The consequences of assimilating unfair competition into trademark law were largely unconsidered, and they continue to surface in some of the most challenging modern cases. Here I want to highlight the way these changes have

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41. *Id.*

42. *Id.* (noting that "[i]f a designation is not 'distinctive,' [under *Abercrombie*] it is not a 'mark'").

43. *Id.*

44. *Id.*

45. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

46. *Qualitex Co., v. Jacobson Products Co.*, 514 U.S. 159 (1995).

47. *Id.* at 162.

increased emphasis on property concepts and decreased emphasis on equity—or, if you like, on tort concepts.

In the former system I have described, the major cut between trademark and unfair competition was whether the plaintiff had a valid (technical) trademark. Trademark law property was therefore primarily concerned with questions of validity (whether the plaintiff had a property interest in a trademark).<sup>48</sup>

Because the only indicators that unambiguously indicated source qualified as trademarks, trademark cases necessarily involved indicators that competitors had no legitimate explanation for using. And trademark owners could only assert claims against direct competitors.<sup>49</sup> As a result, once the plaintiff established ownership of a valid mark (which registration established as a *prima facie* matter), the only thing left to determine was whether the defendant was using the same or a sufficiently-similar mark.<sup>50</sup> Complicated infringement doctrines were unnecessary.

Unfair competition was at the opposite end of the spectrum. Those cases by definition did not involve a property interest, so in determining whether any remedy should be given, courts were not concerned with identifying the thing the plaintiff owned.<sup>51</sup> They were instead focused on the defendant's *conduct*. Specifically, courts in unfair competition asked whether, despite the plaintiff's lack of a property interest in a trademark, it should nevertheless get relief because the defendant was behaving badly in trying to steal the plaintiff's customers.<sup>52</sup> The doctrine was thick in equitable considerations; the plaintiff had to prove intent to pass off, or at least the defendant's conduct was calculated to have that effect.<sup>53</sup>

Because modern law has eviscerated trademark law's subject-matter limitations and accepted that anything capable of identifying source can be a

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48. See, e.g., *Scriven v. North*, 134 F. 366, 375 (4th Cir. 1904); ("There are certain elements of property right in a technical trade-mark . . ."); *Church & Dwight Co. v. Russ*, 99 F. 276, 279 (C.C.D. Ind. 1900) ("It is commonly said that there is a right of property in a technical trade-mark, and an infringement of it is spoken of as a violation of a property right.").

49. See McKenna, *supra* note 2, at 1890.

50. See, e.g., *McLean v. Fleming*, 96 U.S. 245, 255 (1877) ("Difficulty frequently arises in determining the question of infringement [of a technical trademark] . . . . Colorable imitation, which requires careful inspection to distinguish the spurious trade-mark from the genuine, is sufficient to maintain the issue . . . .").

51. See, e.g., *Wm. A. Rogers, Ltd. v. Int'l. Silver Co.*, 30 App. D.C. 97, 102 (D.C. Cir. 1907) ("As an ordinary surname cannot be appropriated as a trademark, to the exclusion of others of the same name, it follows that the rules of law relating to the similarity of technical trademarks cannot be applied to the use of such surname as a mark, notwithstanding the confusion that may result from its legitimate use by such others.").

52. *Supra* notes 19, 21, and accompanying text.

53. See McKenna, *supra* note 2, at 1867 n.122 (collecting cases).

trademark, it has transformed cases that once would have been entirely about the defendant's conduct into cases that are largely—perhaps even overwhelmingly—about ownership. It has, to put it differently, shifted the balance of property and equity substantially in the direction of property. That has had a number of negative consequences.

### A. Claiming

For one thing, it has put tremendous pressure on identification of the features of the claimed mark. Many cases that once focused entirely on the defendant's conduct and the risk of passing off have been pushed into a property framework—and that means the emphasis in those cases is necessarily on determining what, if anything, the plaintiff *owns*.

That is a complicated undertaking because the sorts of indicators that have been reclassified as trademark subject matter have potentially ambiguous and multiple meanings, and they often are complex or compound “indicators” that include components that are not, on their own, protectable.<sup>54</sup>

It is therefore critical to understand what exactly is being claimed by the plaintiff in order to evaluate validity. Courts cannot, for example, evaluate secondary meaning or functionality without knowing which features are claimed as the mark, because conclusions on those issues might well be different depending on which features are included or excluded.<sup>55</sup> Nor can courts effectively manage the scope of any rights in the mark—the range of other uses that will be considered infringing—without defining its features.<sup>56</sup>

These challenges are primarily the result of expanding trademark subject matter to accommodate indicators that once would not have been trademarks. Claiming played a much lesser role in unfair competition, at least as it was once configured. Because the emphasis in those cases was on the defendant's conduct rather than the property owned by the plaintiff, there was no need to delineate precisely the boundaries of the trademark at issue.<sup>57</sup> There was no trademark at issue.

To be sure, an unfair competition plaintiff had to prove that the defendant intended to pass off its goods as those of the plaintiff, or at least that deception of that sort was likely, and doing so required articulation of the means by which

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54. See Mark A. Lemley & Mark P. McKenna, Scope, 57 WM. & MARY L. REV. 2197, 2251–52 (2016).

55. Jeanne C. Fromer & Mark P. McKenna, Claiming Design, 167 U. PA. L. REV. 123, 157 (2018).

56. *Id.*; see also Lemley & McKenna, *supra* note 54, at 2243–59.

57. *Supra* notes 19, 21, and accompanying text.

the defendant was to accomplish that goal.<sup>58</sup> So it is not that the unfair competition cases made no mention of the features that would influence consumers.

But unfair competition focused only on passing off rather than broader notions of confusion, and for that reason, the only question courts were asking in those cases was whether consumers were likely to buy the defendant's product believing that it *was* the plaintiff's.<sup>59</sup> They were not asking whether consumers might think the parties were related, or whether the plaintiff sponsored the defendant, etc. That liability standard required a level of similarity that made deconstruction of the indicators at issue unnecessary in most cases.

Probably even more importantly, unfair competition generally denied categorical relief (meaning parties could not get injunctions against use of the descriptive word or geographic term or design features as such).<sup>60</sup> For that reason, the precise identity of a claimed indicator was irrelevant.

### *B. The Validity/Infringement Divide*

Conflation of trademark and unfair competition law has also led courts to separate trademark cases into fairly formal validity and infringement phases.<sup>61</sup> That is, of course, a doctrinal divide that did not meaningfully exist in the former regime. Trademark infringement cases were heavily (indeed, nearly exclusively) focused on whether the claimed indicator was a trademark (infringement being fairly straightforward once that was determined). Unfair competition cases, by contrast, had no "validity" phase and were entirely about liability.<sup>62</sup>

Separating "validity" and "infringement" doctrines has made litigation considerably more complex and costlier.<sup>63</sup> For one thing, it has exacerbated courts' difficulty in managing the scope of rights because it encourages claimants to treat their rights "like a nose of wax, which may be turned and twisted in any

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58. *Id.*

59. See, e.g., *Socony-Vacuum Oil Co. v. Rosen*, 108 F.2d 632, 636 (6th Cir. 1940) ("If the simulation of the competitor in the dress of his goods is sufficient to deceive the average purchaser, unfair competition exists . . .").

60. *Supra* note 20 and accompanying text.

61. See 4 MCCARTHY, *supra* note 16, at § 23:1 (noting that "the plaintiff has the burden to plead and prove both validity and infringement" and that it is necessary to keep the issues of validity and infringement separate).

62. *Supra* notes 19, 21, and accompanying text.

63. See Glynn S. Lunney, *Two-Tiered Trademark*, 56 HOUS. L. REV. 295 (2018) (arguing that modern trademark law's complexity has made it too costly for defendants even when they have legitimate bases for using the asserted marks and also for many mark owners with potentially legitimate infringement claims).

direction,” depending on the issue.<sup>64</sup> Plaintiffs describe their marks narrowly for purposes of validity so as to differentiate them from features used by others and to avoid functionality objections. But then they ignore those limitations for purposes of infringement. Defendants, quite naturally, do the opposite. Courts often have difficulty managing these variations because they lack a doctrinal structure by which to identify the claimed mark for all purposes in the litigation.

At the same time, courts’ overly rigid distinction between validity and infringement doctrines has caused them to struggle with certain kinds of arguments—even though they are persuasive and connected to trademark policies—because those arguments do not seem to arise in the “right” place in the case.

Take, for example, certain invocations of functionality doctrine. Manufacturers have in recent years taken to registering the designs of various auto parts as trademarks (things like the front grilles). Sometimes they register, the shapes of these parts with emblem or logo designs incorporated into them, but often they simply claim the designs themselves or with the space for the logo shown in dotted lines.<sup>65</sup> And Customs has begun seizing shipments of replacement auto parts that resemble the registered designs but are made by companies other than the mark owners or their licensees.<sup>66</sup>

This is a new development. There has been a robust market for aftermarket auto parts for many years—a market that has, until recently, been regarded as entirely legitimate.<sup>67</sup> Owners want to repair their damaged vehicles, and they want to repair them in a way that restores their original design to the greatest extent possible. They do not want to put a grille on their Jeep that does not match the original. And aftermarket parts companies have, for a considerable time, supplied parts that allow the owners to restore their vehicles in just that way—and at lower cost than if the owners had to purchase the parts from the original equipment manufacturers (OEMs).<sup>68</sup>

In fact, many insurance companies will *only* pay (or at least will only pay in full) for aftermarket parts.<sup>69</sup> And in a number of states, those insurance companies are legally obligated to use parts of like kind and quality to the OEM

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64. *White v. Dunbar*, 119 U.S. 47, 51 (1886). On courts’ difficulty managing scope because of the structure of doctrinal inquiry, see Lemley & McKenna, *supra* note 54.

65. See Susan Frohling, *OEM Trademarks in the AfterMarket: Exploring the Boundaries*, IPWATCHDOG (Sept. 19, 2018), <https://www.ipwatchdog.com/2018/09/19/oem-trademarks-aftermarket-exploring-boundaries/id=101163/> [https://perma.cc/F82N-6UB6].

66. See Mark P. McKenna, *Criminal Trademark Enforcement and the Problem of Inevitable Creep*, 51 AKRON L. REV. 989, 1015 (2017).

67. See Frohling, *supra* note 65.

68. See McKenna, *supra* note 66, at 1015; Frohling, *supra* note 65.

69. See McKenna, *supra* note 66, at 1015.

parts—which they obviously cannot do if the aftermarket parts look different from those sold by the OEMs.<sup>70</sup>

Given these market dynamics, one might think the aftermarket parts companies would have powerful functionality arguments in these contexts. According to the Supreme Court, features are functional—and therefore cannot serve as trademarks—when they are “essential to the use or purpose of the device” with which they are used, or the features “affect[] the cost or quality of the device.”<sup>71</sup> The designs of these replacement parts could hardly be more “essential to the use or purpose” of the parts, and they clearly affect the “cost or quality” of the parts.

The features seem functional even if we consider competitive need—which we are supposed to do only in a subset of functionality cases.<sup>72</sup> Exclusive use of the designs of auto parts would give the OEMs a significant—indeed, decisive—competitive advantage (because no one would be able to compete with them for replacement parts).

As a result, no matter how one approaches the question, all signs point to functionality in this context, and therefore the legitimacy of the aftermarket parts. But when these seizures have been challenged, Customs has rejected the functionality arguments.<sup>73</sup> Why? Because courts understand functionality to be exclusively a question of validity.<sup>74</sup> And when those parts are incorporated into a new vehicle, courts think the designs seem to indicate source, and they do not seem to be essential to the use or purpose of the car or to affect competition among car manufacturers. Other companies can and do make grilles with different designs, and there does not seem to be a lack of competition among sellers of cars.

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70. See, e.g., N.Y. COMP. CODES R. & REGS. Tit. 11, § 216.7(b)(5) (2016) (“Standards for prompt, fair and equitable settlement of motor vehicle physical damage claims.”).

71. *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33 (2001).

72. See *id.* (“It is proper to inquire into a ‘significant non-reputation-related disadvantage’ in cases of esthetic functionality . . .”).

73. See, e.g., Referral of Petition at 9, *LKQ Corp./Keystone Auto. Indus.*, FP&F Case No. 2017-1703-000073-01, 2017-1703-000074-01, and 2017-1703-000091-01 (Oct. 31, 2017).

74. “The fact that the marks make defendants’ [product] more functional is irrelevant . . . . Because we are not dealing with defendants’ wish to trademark their [product], but with [the owner’s] ability to protect the trademarks it already uses to identify its products, the doctrine of functional use does not help defendants here.” *Playboy Enters., Inc. v. Netscape Commc’ns Corp.*, 354 F.3d 1020, 1031 (9th Cir. 2004). Many courts have echoed that same principle. See, e.g., *Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144, 162 (4th Cir. 2012) (“Once it is determined that the product feature—the word mark ROSETTA STONE in this case—is not functional, then the functionality doctrine has no application, and it is irrelevant whether [Defendant] Google’s computer program functions better by use of Rosetta Stone’s nonfunctional mark.”); see also 1 MCCARTHY, *supra* note 16, at § 7:63 (“If a feature is found to be ‘functional,’ then it cannot be a valid trademark or trade dress: the issue of validity is decided . . .”).

The argument about the functionality of the designs of auto parts is context-specific—it is an argument that those designs have a function when *they are used for replacement parts*, not that the designs cannot serve as trademarks under any circumstances. And courts do not recognize context-specific arguments as being validity arguments. Because the argument does not fit the validity pattern courts expect, they do not know how to deal with it.

### C. “Defenses”

Something very similar could be said about the role of “defenses” in modern trademark law. Many scholars, myself included, have lamented the fact that a number of the doctrines we call “defenses” in trademark law do not work like real affirmative defenses.<sup>75</sup> Because many of the doctrines I am talking about (things like descriptive fair use) insulate particular uses from liability only so long as those do not cause confusion, the doctrines are not conceptually distinct from the *prima facie* case of infringement (which always requires proof of likelihood of confusion).<sup>76</sup> In that way, these doctrines differ from true defenses like self-defense in tort law—which does not deny elements of the *prima facie* case but seeks to justify the otherwise tortious conduct. Trademark defenses are not clearly “yes, but” defenses—they are “not really, and maybe it is not so bad” responses.

The fact that trademark “defenses” are bound up with the confusion question means that it is sometimes hard for defendants to get a court to dismiss a case against them without having to engage the multi-factor likelihood-of-confusion test.<sup>77</sup>

Part of the reason for this state of affairs is that many of these defensive doctrines are really just awkward restatements of unfair competition concepts that are now being used in another context. In the descriptive fair use context specifically, the kinds of terms at issue are ones that we would not previously

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75. See, e.g., Graeme B. Dinwoodie, *Developing Defenses in Trademark Law*, 13 LEWIS & CLARK L. REV. 99, 100–01 (2009); Michael Grynberg, *Things Are Worse Than We Think: Trademark Defenses in a “Formalist” Age*, 24 BERKELEY TECH. L.J. 897, 914–24 (2009); William McGeveran & Mark P. McKenna, *Confusion Isn’t Everything*, 89 NOTRE DAME L. REV. 253, 277 (2013); Mark P. McKenna, *Trademark Use and the Problem of Source*, 2009 U. ILL. L. REV. 773, 803–04 (2009).

76. See, e.g., *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 408 F.3d 596, 609 (9th Cir. 2005) (holding that the degree of consumer confusion is a factor in evaluating fair use); see also Robert G. Bone, *Notice Failure and Defenses in Trademark Law*, 96 B.U. L. REV. 1245, 1269–70 (2016); McKenna, *supra* note 75, at 804–05.

77. See *Kelly-Brown v. Winfrey*, 717 F.3d 295, 307 (2d Cir. 2013) (declining to adopt the Sixth Circuit’s fair use standard because it “would lead to the dismissal of these claims without addressing . . . whether consumers were actually confused by the allegedly infringing product”); see also McGeveran & McKenna, *supra* note 75, at 255.



have considered trademarks at all.<sup>78</sup> In the regime we once had, courts' consideration of the nature of the defendant's use and possible confusion arose in those cases entirely in the context of evaluation of the defendant's conduct where the question was not "confusion" but passing off, and where the remedy would in any event *never* have been an injunction against mere use of the descriptive term itself.<sup>79</sup>

We have attempted to bolt onto a trademark system that treats even descriptive terms as trademarks (as property) equitable considerations from a bygone era. Unsurprisingly, it is not a great fit.

#### *D. Remedies*

Finally, the collapse of unfair competition has had a considerable effect on remedies. One of the reasons courts used to categorize certain words and devices as "trademarks" (or "technical trademarks") was that those indicators were the kinds of things that unambiguously identified source and were therefore amenable to exclusive rights.<sup>80</sup> The remedies in trademark infringement cases followed from that—because trademarks unambiguously indicated source, there was no legitimate explanation for others to use them for the same goods, and any such uses were enjoined.<sup>81</sup>

But the kinds of indicators that were dealt with in unfair competition were not amenable to exclusive rights because there were potentially legitimate explanations for others' uses. And the remedies in unfair competition reflected that too—courts would not categorically enjoin use of those indicators (they were not the property of the plaintiff), but they would force changes in the behavior of the defendant in order to prevent passing off. Remedies might include changes in labeling or packaging or use of particular formats or language.<sup>82</sup>

The collapse of unfair competition into trademark has largely cost us that remedial flexibility. Courts have put all of these cases on a property footing, so once they have found infringement, they have concluded that the defendant has taken something the plaintiff owns. As a result, cases are now much more

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78. See, e.g., *Cosmetically Sealed Indus., Inc. v. Chesebrough-Pond's USA Co.*, 125 F.3d 28, 31 (2d Cir. 1997) (descriptive term "Sealed With A Kiss" for lip gloss); *Car-Freshner Corp. v. S.C. Johnson & Son, Inc.*, 70 F.3d 267, 270 (2d Cir. 1995) (product configuration of tree-shaped air fresheners); *Sunmark, Inc. v. Ocean Spray Cranberries, Inc.*, 64 F.3d 1055, 1058 (7th Cir. 1995) (descriptive term "Sweet-Tart" for candy).

79. *Supra* note 22 and accompanying text.

80. *Supra* notes 8–11, 13, and accompanying text.

81. *Supra* notes 19, 21, 22, and accompanying text.

82. *Supra* note 22 and accompanying text.

often all-or-nothing—the plaintiff seeks, and courts grant, injunctions against the use of the claimed features.<sup>83</sup>

In recent years, some courts have started to feel a little uneasy about this, and they have pushed back on what had become a rule that proving likelihood of confusion meant the plaintiff had demonstrated irreparable harm and was entitled to an injunction.<sup>84</sup> And sometimes they have denied injunctions even when likely confusion has been shown.<sup>85</sup> But that still is all-or-nothing (in this case, in the direction of nothing). What we have lost is remedial flexibility that was the hallmark of unfair competition. Courts have largely given up on more limited injunctive relief—relief short of complete injunction but that might be sufficient to prevent confusion.

#### IV. WHAT TO DO?

So this is the part where I am supposed to provide some grand solution to the problems I have identified. And given the tenor of what I have said so far, it probably seems like I would argue that we would be better off if we just went back to the way things were—redefining trademark subject matter in the limited terms we once used and reinvigorating unfair competition as a distinct doctrine.

And though I might think that result would, in fact, be better (spoiler alert: I do), I am more realistic than that. We are so far down this road, we are not going to go back to the way things once were. Still, there are a few things we can and should do.

First, we should consider limited rollbacks in places it makes sense. One obvious candidate is trade dress, and particularly product configuration, which



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83. See 5 MCCARTHY, *supra* note 16, at § 30:1 (“A permanent injunction is the usual and normal remedy once trademark infringement has been found in a final judgment.”); see also *Paletaria La Michoacana, Inc. v. Productos Lacteos Tocumbo S.A. DE C.V.*, 188 F. Supp. 3d 22, 117 (D.D.C. 2016) *aff’d*, 743 F. App’x 457 (D.C. Cir. 2018) (awarding a permanent injunction after finding likelihood of confusion at trial); Peter J. Karol, *Trademark’s eBay Problem*, 26 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 625, 652 (2016) (finding that between 2003 and 2006, prevailing plaintiffs in trademark infringement cases received a permanent injunction in 95% of cases).

84. See *San Miguel Pure Foods Co. v. Ramar Int’l Corp.*, 625 F. App’x 322, 327 (9th Cir. 2015) (“[T]o establish irreparable injury, a trademark owner must do more than merely demonstrate that a trademark has been infringed or that consumers have been confused.”); *Ferring Pharm., Inc. v. Watson Pharm., Inc.*, 765 F.3d 205, 216 (3d Cir. 2014) (“[W]e hold that there is no presumption of irreparable harm afforded to parties seeking injunctive relief in Lanham Act cases.”); *Voice of the Arab World, Inc. v. MDTV Med. News Now, Inc.*, 645 F.3d 26, 33 (1st Cir. 2011); see also Mark A. Lemley, *Did eBay Irreparably Injure Trademark Law?*, 92 NOTRE DAME L. REV. 1795, 1796–1805 (2017).

85. See *San Miguel*, 625 F. App’x at 327 (reversing grant of permanent injunction even where jury found trademark infringement); *Haas Automation, Inc. v. Denny*, No. 2:12-CV-04779 (CBM) (PLAx), 2014 WL 2966989, at \*8 (C.D. Cal. July 1, 2014) (denying permanent injunction because plaintiff failed to show irreparable harm); *AFD China Intell. Prop. Law (USA) Off., Inc. v. AFD China Intell. Prop. Law Off.*, No. 3:09-cv-1509-BR, 2014 WL 2619644, at \*6 (D. Or. June 12, 2014) (same).

I think is particularly ill-suited to trademark treatment.<sup>86</sup> A number of the most serious and difficult problems in trademark law are a result of trying to accommodate this subject matter, and we would better respect the boundaries with other areas of intellectual property by returning to a system that denied protection for product features as such, subject to a more limited set of unfair competition remedies where real passing off was at risk. So, for example, when Skechers sues Easy Spirit claiming that Easy Spirit's black and white slip-on shoes look too much like Skechers's GO WALK tennis shoes, rather than litigating over which features of the GO WALK shoes Skechers owns, we would instead focus on whether consumers would think that the defendant was selling its black shoes *as Skechers* and consider ordering changes—perhaps in name or packaging or other materials—to make the actual source of the shoes clear.<sup>87</sup>

Skechers GO WALK	Easy Spirit Knock Off
	
Casual Slip-On Profile	Same
Raised Instep and Heel Upper Portion	Same

Second, even short of completely reinstating unfair competition rules, courts could be more aware of what has happened and be less rigid about the validity/infringement divide. They could understand better the origins of defensive doctrines and be more willing to treat them like true affirmative defenses. They could rediscover equitable discretion (indeed, the statute still tells them to do so!).<sup>88</sup>

Finally, and more generally, we need to give some serious thought to the role of unfair competition going forward. Right now, unfair competition is largely a zombie doctrine. Plaintiffs invoke unfair competition in the shadow of their trademark infringement claims—ostensibly as some kind of backup claim. And they are emboldened in doing so by comments from the Supreme

86. See generally Caitlin Canahai & Mark P. McKenna, *The Case Against Product Configuration Trade Dress*, in *TRADEMARK LAW AND THEORY: REFORM OF TRADEMARK LAW* (Graeme Dinwoodie & Mark Janis eds.) (forthcoming 2019).

87. See Complaint at 2–3, *Skechers U.S.A., Inc. v. Easy Spirit, LLC*, Case 2:19-cv-02141 (C.D. Cal. March 21, 2019).

88. 15 U.S.C. § 1116(a) (2012) (giving courts the power to grant injunctions “according to the principles of equity and upon such terms as the court may deem reasonable”).

Court that § 43(a) is not a complete codification of common law unfair competition.<sup>89</sup>

Usually these unfair competition claims are entirely duplicative of the trademark claims—thrown in on a sort of belt-and-suspenders approach. But sometimes the claims seek more than what trademark law allows them.

Take, for example, *Belmora v. Bayer*.<sup>90</sup> In that case, Bayer owned the FLANAX mark in Mexico, which it used for a naproxen sodium pain reliever.<sup>91</sup> Bayer sued Belmora, which had registered and was using the FLANAX mark for a naproxen sodium pain reliever in the United States.<sup>92</sup> Bayer's theory was that Belmora violated § 43(a) by using the FLANAX mark in the United States, even though Bayer admitted it did not own trademark rights in that mark in the United States.<sup>93</sup> Bayer argued that § 43(a) claims do not depend on ownership of a mark—that § 43(a) provides for claims against conduct that causes confusion even in the absence of mark ownership.<sup>94</sup> Claims under § 43(a) focus on what the defendant does, Bayer argued, not what the plaintiff owns.<sup>95</sup>

That argument makes a certain amount of textual sense because § 43(a) makes no reference to ownership of a mark (which is understandable, given that the provision was never intended to give a cause of action for infringement of unregistered marks). And Bayer's argument at least rhymes with old-style unfair competition, which was explicitly available in cases in which the plaintiff did not own a trademark.

But in reality, what Bayer wanted was the best of both the new and old legal orders. It wanted the benefits of treating § 43(a) as a version of old unfair competition, so that it could bring a claim when the alleged confusion was caused by something other than use of Bayer's trademark (since it did not own the trademark). At the same time, Bayer did not want the limited remedies offered by unfair competition. Under the old rules, by admitting it did not own trademark rights, Bayer could not have enjoined Belmora's use of the FLANAX mark; the best it could have hoped for were limitations on the manner of Belmora's use that would make clear it was not Bayer's FLANAX.

Because the conceptual history of unfair competition and its relationship to trademark law has mostly been lost in the assimilation, we are left with a

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89. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 29 (2003) ("§ 43(a) can never be a federal codification of the overall law of unfair competition" (quoting 4 J. MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 27:7 (4th ed. 2002) (internal quotation marks omitted))).

90. *Belmora LLC v. Bayer Consumer Care AG*, 819 F.3d 697 (4th Cir. 2016).

91. *Id.* at 701.

92. *Id.* at 702.

93. *Id.* Bayer sells naproxen sodium in the United States under the ALEVE mark. *Id.*

94. *Id.* at 706.

95. *Id.*

mashup of ideas and parties that want the best of both worlds. At the very least, they should not get that.