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## **Assuming the Presumption: Challenging the Presumption of Strength of Federally Registered Trademarks**

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### I. INTRODUCTION

Protecting individuals from confusion: This is considered one of the most basic tenets of modern American trademark law.<sup>1</sup> Consequently, the likelihood of confusion has been the fundamental test of common law and statutory trademark infringement cases.<sup>2</sup> Case law precedent and the influence of the *Restatement* have developed a flexible, multifactor test for evaluating whether a defendant's use is "likely to cause confusion, or to cause mistake, or to deceive."<sup>3</sup> Trademark strength is typically one of the factors that circuits consider in likelihood of confusion cases. The Trademark Act of 1946 (Lanham Act), the federal statute governing U.S. trademark law, explicitly grants a presumption of validity as to the ownership of federally registered trademarks, and a handful of courts have also granted a presumption of *strength* in the context of infringement cases.<sup>4</sup> Utilization of such a presumption has given trademark registrants a further advantage in some courts.

The goal of this Article is to illustrate the courts' different applications of a presumption of strength for registered trademarks in likelihood of confusion analyses. By developing a background on trademark law and providing case

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\* Associate, Wilmer Cutler Pickering Hale and Dorr LLP. To my Boo-Boo who made my dreams possible and the one who always keeps me inspired, Clarissa Brady, I thank you.

1. See 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 2:1 (5th ed. 2020) (asserting purpose of American trademark law to protect consumers). *But see* Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1916 (2007) (suggesting trademark law historically not focused on protecting consumers).

2. See 4 MCCARTHY, *supra* note 1, § 23:1.

3. See *id.* (quoting Lanham Act § 32(1), 15 U.S.C. § 1114(1) (2018)).

4. See 15 U.S.C. § 1115.

studies, this Article will review the ways courts apply this presumption.<sup>5</sup> This Article will also explore the majority and minority views among courts when a registered trademark reaches “incontestable” status.<sup>6</sup> As a result, this Article surveys the current state of the land regarding the application of a presumption of strength and illustrates the effect it has on the likelihood of confusion analysis.

## II. UNDERSTANDING TRADEMARK LAW

### A. Goals and Interests of Trademark Protection

Once described as a “battleground for competing policies[,]” the goals and interests of trademark law have often been explained as a balance between protecting a trademark holder’s property rights and protecting consumers from confusion.<sup>7</sup> Historically, the goal of trademark law can best be described through the words of Judge Learned Hand who stated, “We are nearly sure to go astray in [trademark law] as soon as we lose sight of the underlying principle that the wrong involved is diverting trade [by misleading consumers].”<sup>8</sup> This goal of avoiding consumer confusion is distinguishable from how Lord Westbury described the goal of trademark law when he stated that “the jurisdiction of the Court in the protection given to trade marks rests upon property.”<sup>9</sup> By the 1980s, as Judge Easterbrook stated in his opinion in *Scandia Down Corp. v. Euroquilt, Inc.*,<sup>10</sup> trademark law began focusing on the economic benefits to consumers, treating trademarks as a vehicle for information about sellers’ products and thereby lowering informational costs of consumers.<sup>11</sup> Thus, over the years, courts have maintained competing interests in trademark law in protecting consumers from confusion while also protecting the trademark holder’s investment, whether we consider goodwill a corollary to protection against confusion or a property right.

### B. Federal Trademark Rights

Trademark rights in the United States derive primarily from use rather than registration.<sup>12</sup> Both registered and unregistered marks can receive protection against infringement. Section 32 of the Lanham Act protects registered marks from any use that is “likely to cause confusion, or to cause mistake, or to

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5. See *infra* Parts I-V.

6. See *infra* Part VI.

7. See *Zippo Mfg. Co. v. Rogers Imps., Inc.*, 216 F. Supp. 670, 694 (S.D.N.Y. 1963); 1 MCCARTHY, *supra* note 1, § 2:1 (setting forth dual goals of trademark law).

8. See *S. C. Johnson & Son, Inc. v. Johnson*, 116 F.2d 427, 429 (2d Cir. 1940).

9. *Leather Cloth Co. v. Am. Leather Cloth Co.* (1863) 46 Eng. Rep. 868, 870; 4 De G.J. & S. 137, 141 (Ch) (characterizing historical difference between overall policy goals of trademark law).

10. 772 F.2d 1423 (7th Cir. 1985).

11. See *id.* at 1429-30 (stressing importance of trademarks to both consumers and businesses).

12. See 3 MCCARTHY, *supra* note 1, § 19:1.25 (observing United States use-based trademark law system).

deceive,” while section 43(a) of the Lanham Act and various state laws extend this protection to unregistered marks.<sup>13</sup> Nevertheless, federal trademark registration on the United States Patent and Trademark Office’s (USPTO) Principal Register provides significant benefits such as federal court jurisdiction and the ability to obtain statutory damages against counterfeiters.<sup>14</sup> A trademark must meet several requirements to be eligible for federal trademark protection.<sup>15</sup> One condition is trademark distinctiveness, discussed in detail below, which requires that a trademark must be capable of distinguishing the trademark holder’s goods or services from others in the marketplace.<sup>16</sup> A second condition is that a trademark must also be used in commerce.<sup>17</sup> Finally, to qualify for registration, a trademark must not fall within one of the statutory bars established by section 2 of the Lanham Act, some (but perhaps not all) of which apply equally in evaluating eligibility for common-law protection.<sup>18</sup>

### C. Distinctiveness

Under section 45 of the Lanham Act, the definition of a trademark requires that the mark be capable of identifying and distinguishing one’s goods and indicating the source of those goods.<sup>19</sup> It is not necessary for a trademark to indicate the precise source of the goods, as consumers only need to have confidence that all goods utilizing a given trademark are associated with a single—even if

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13. See Lanham Act § 32(1), 15 U.S.C. § 1114(1) (2018) (declaring any registered mark admissible prima facie evidence of ownership and validity); see also *id.* § 1125(a)(1)(A) (providing section 43(a) language detailing coverage of unregistered marks from misuse).

14. See 15 U.S.C. § 1117(c) (outlining recovery options for violation of trademark rights); *id.* § 1121 (granting federal court jurisdiction over cases involving federally registered trademarks).

15. See BARTON BEEBE, TRADEMARK LAW: AN OPEN-SOURCE CASEBOOK - PART I: ESTABLISHING TRADEMARK RIGHTS 5 (3d ed. 2016), <http://tmcasbook.org/wp-content/uploads/2016/07/BeebeTMLaw-3.0-Part-1-Subject-Matter.pdf> [<https://perma.cc/VM33-ZHQ4>] [hereinafter BEEBE, PART I] (laying down three basic requirements of eligibility for federal registration of trademark).

16. See *id.* (discussing distinctiveness one of basic requirements for trademark registration); see also 15 U.S.C. § 1052(f). “[N]othing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce.” 15 U.S.C. § 1052(f).

17. See 15 U.S.C. § 1127 (defining commerce in context of Lanham Act). Use in commerce is defined as any “bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.” *Id.*

18. See BEEBE, PART I, *supra* note 15, at 146 (recognizing statutory bars can deny even distinctive mark right to registration); see also 15 U.S.C. § 1052 (codifying specific bars against federal registration of trademark in section 2 of Lanham Act). An example of a section 2 bar to protection is section 2(e)(5) of the Lanham Act, which holds that “functional” product features are not protectable as trademarks. 15 U.S.C. § 1052(e)(5). Several courts have held that a mark unregistrable under section 2 would likely not be protectable under section 43(a). See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992). “[I]t is common ground that § 43(a) protects qualifying unregistered trademarks and that the 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).” *Id.*

19. See Lanham Act § 45, 15 U.S.C. § 1127 (2018) (defining “trademark”). The ability to identify and distinguish the goods under the trademark is an example of the distinctiveness of the source of the goods. See BEEBE, PART I, *supra* note 15, at 8.

unknown—source.<sup>20</sup> To qualify as “distinctive,” a trademark must either be “inherently distinctive” of its source *or* have “acquired distinctiveness.”<sup>21</sup> An inherently distinctive mark is one whose intrinsic nature serves to identify a particular source of a product, while a trademark may acquire distinctiveness through an individual’s use of a trademark in commerce; when this happens, the trademark is said to have acquired “secondary meaning.”<sup>22</sup> An example of an inherently distinctive mark is “Apple” for computer products, while an example of a mark that has acquired distinctiveness is “Total Moisture” for hair conditioner.<sup>23</sup>

To determine both inherent distinctiveness and strength, courts tend to use a four-category spectrum developed in *Abercrombie & Fitch Co. v. Hunting World, Inc.*<sup>24</sup> These categories are: (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful.<sup>25</sup> As Judge Friendly noted in *Abercrombie*, line drawing between these categories can be difficult, as terms may fall differently along the *Abercrombie* spectrum depending on the particular market in which the mark is being used.<sup>26</sup>

Beginning with the lowest level of distinctiveness on the *Abercrombie* spectrum, the first category includes generic terms referring “to the genus of which the particular product is a species.”<sup>27</sup> The Trademark Manual of Examining Procedure (TMEP) defines generic terms as “terms that the relevant purchasing public understands primarily as the common or class name for the goods or services.”<sup>28</sup> Examples of these terms include “apples” used for fruit and “software” used for software products. Therefore, in accordance with section 14(c) of the Lanham Act, a generic term is not protectable as a trademark under any circumstances, as it would deprive competition from others within the same market, because they could not call the product by its name.<sup>29</sup>

The second category on the *Abercrombie* spectrum includes descriptive terms. Section 2(e) of the Lanham Act states that “merely descriptive” marks are not

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20. See 1 MCCARTHY, *supra* note 1, § 3:9 (demonstrating use of trademark serves similar purpose of person’s name). A trademark is able to answer the question of what or who are you for a consumer who approaches a product in a commercial setting. *Id.*

21. See *generally id.* § 11:2 (highlighting range of distinctiveness of trademarks).

22. See *Two Pesos, Inc.*, 505 U.S. at 768-69 (laying down categories of distinctiveness developed by *Abercrombie*).

23. See Timothy Denny Greene & Jeff Wilkerson, *Understanding Trademark Strength*, 16 STAN. TECH. L. REV. 535, 536 (2013) (describing trademark Apple falls under arbitrary classification while Total Moisture under descriptive on *Abercrombie* spectrum).

24. See 537 F.2d 4, 9 (2d Cir. 1976).

25. *Id.*

26. *Id.*

27. *Id.*

28. See USPTO, TMEP § 1209.01(c) (Oct. 2018).

29. See *Abercrombie*, 537 F.2d at 9 (citing *J. Kohnstam, Ltd. v. Louis Marx & Co.*, 280 F.2d 437, 440 (C.C.P.A. 1960)).

registrable, nor can they receive protection based merely on use.<sup>30</sup> The TMEP defines “merely descriptive” marks as those that “immediately convey knowledge of a quality, feature, function, or characteristic of an applicant’s goods or services.”<sup>31</sup> Nevertheless, section 2(f) of the Lanham Act provides that a descriptive mark may be protectable if it has secondary meaning, and thus, acquired distinctiveness.<sup>32</sup> This refers to a descriptive term’s acquired significance by the consuming public, which now understands that the term refers to a product produced by a specific manufacturer, due to that party’s consistent and longstanding use of the term with its products.<sup>33</sup> For registration purposes, the U.S. Court of Appeals for the Federal Circuit requires an applicant to prove secondary meaning by a preponderance of the evidence.<sup>34</sup> This burden of proof can be established by both direct evidence and circumstantial evidence.<sup>35</sup> Direct evidence, which some circuits state is the most persuasive evidence of secondary meaning, refers to testimony from buyers as to their state of mind; it can consist of testimony of random buyers in court or professionally-conducted consumer surveys.<sup>36</sup> If direct evidence is unavailable, applicants can also prove secondary meaning using circumstantial evidence of their efforts in advertising the mark.<sup>37</sup>

Next on the *Abercrombie* spectrum are suggestive terms, which are defined as any “mark which suggests, but does not directly and immediately describe, some aspect of the goods or services.”<sup>38</sup> Proof of secondary meaning is not necessary for suggestive terms, and therefore, the stakes in determining whether a term is descriptive or suggestive are high.<sup>39</sup> Courts have often applied an “imagination” test to make this determination, which provides that “[a] term is suggestive if it requires imagination, thought[,] and perception to reach a conclusion as to the nature of the goods” and “[a] term is descriptive if it forthwith conveys an

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30. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 10 (2d Cir. 1976); see also Lanham Act § 2(e), 15 U.S.C. § 1052(e) (2018).

31. See USPTO, TMEP § 1209.01(b).

32. See *Abercrombie*, 537 F.2d at 9-10.

33. See USPTO, TMEP § 1209.01.

34. See 2 MCCARTHY, *supra* note 1, § 15:66 (discussing amount of evidence required to prove descriptiveness); see also *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1581 (Fed. Cir. 1988) (recognizing burden of proof of preponderance of evidence show secondary meaning).

35. See 2 MCCARTHY, *supra* note 1, § 15:30.

36. See *id.*; see also *Yamaha Int’l Corp.*, 840 F.2d at 1583 (discussing use of any evidence showing mark distinguishes goods can show distinctiveness).

37. See 2 MCCARTHY, *supra* note 1, § 15:30 (explaining sources of circumstantial evidence of secondary meaning). The sources can include “evidence of the size of the seller, the number of actual sales made, large amounts spent in promotion and advertising, the scope of publicity given the mark, and any similar evidence showing wide exposure of the buyer class to the mark in question.” *Id.* Circumstantial evidence of secondary meaning can also include factors “such as the exclusivity, length and manner of use of the mark; . . . the plaintiff’s established place in the market; and the existence of intentional copying.” See *Frosty Treats, Inc. v. Sony Comput. Entm’t Am., Inc.*, 426 F.3d 1001, 1005 (8th Cir. 2005).

38. See 2 MCCARTHY, *supra* note 1, § 11:62.

39. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 10 (2d Cir. 1976).

immediate idea of the ingredients, qualities[,] or characteristics of the goods.”<sup>40</sup> Finally, arbitrary or fanciful terms are completely nondescriptive of the product to which the mark is attached, and therefore do not require any determination as to whether a mark is “merely descriptive.”<sup>41</sup> Like suggestive marks, arbitrary or fanciful terms are treated as “inherently distinctive,” and thus can obtain trademark protection without any proof of secondary meaning.

#### D. USPTO Registration Process and Benefits

As previously stated, while the U.S. trademark system is “use-based” rather than “registration-based,” registration of a mark provides significant benefits.<sup>42</sup> First, section 7(c) of the Lanham Act confers nationwide priority in the mark as of the date of application, subject to some limited exceptions.<sup>43</sup> Second, registration also creates “prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark in commerce.”<sup>44</sup> As discussed below, courts are divided as to the weight given to this presumption of validity, but all courts apply it in some form.<sup>45</sup> Third, registered marks are eligible for incontestable status, which limits the grounds on which a registered mark’s validity may be challenged.<sup>46</sup>

To achieve these benefits, a trademark applicant must successfully proceed through the USPTO’s application process, which is comprised of several stages including application, examination, publication in the USPTO’s *Official Gazette*,

40. See *Stix Prods., Inc. v. United Merchs. & Mfrs., Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968) (outlining difference between descriptive and suggestive terms).

41. See *Abercrombie*, 537 F.2d at 11; see also 2 MCCARTHY, *supra* note 1, § 11:11 (emphasizing arbitrary mark neither describes nor suggests about goods or services). “[T]he term ‘fanciful’, as a classifying concept, is usually applied to words invented solely for their use as trademarks. When the same legal consequences attach to a common word, i.e., when it is applied in an unfamiliar way, the use is called ‘arbitrary.’” *Abercrombie*, 537 F.2d at 11 n.12.

42. See 3 MCCARTHY, *supra* note 1, § 19:1.25 (declaring historical significance of U.S. trademark system).

43. See Lanham Act § 7(c), 15 U.S.C. § 1057(c) (2018). These exceptions include when a nonapplicant whose mark has not been abandoned and prior to the applicant’s filing either:

- (1) has used the mark;
- (2) has filed an application to register the mark which is pending or has resulted in registration of the mark; or
- (3) has filed a foreign application to register the mark on the basis of which he or she has acquired a right of priority, and timely files an application under section 1126(d) of this title to register the mark which is pending or has resulted in registration of the mark.

*Id.*

44. See *id.* § 1115(a) (laying down evidentiary value of federal registration of trademark).

45. See *Zobmondo Entm’t, LLC v. Falls Media, LLC*, 602 F.3d 1108, 1115 (9th Cir. 2010) (explaining strong presumption of validity and defendant’s heavy burden to overcome presumption at summary judgment); see also *Custom Vehicles, Inc. v. Forest River, Inc.*, 476 F.3d 481, 486 (7th Cir. 2007) (holding presumption of validity from registration easily rebuttable).

46. See 15 U.S.C. §§ 1065, 1115.

at which point any party may file an opposition, and registration.<sup>47</sup> In the first stage, the applicant submits a trademark application that includes a filing basis, a designation of goods and services, and a drawing of the trademark.<sup>48</sup> There are five potential filing bases: use-based,<sup>49</sup> intent-to-use,<sup>50</sup> and three additional bases that derive from trademark registrations abroad.<sup>51</sup> An examining attorney will then substantively examine the application to determine whether there are any grounds for refusal.<sup>52</sup> If the mark is approved, it will then be published in the USPTO's *Official Gazette*, which gives notice to the public of the USPTO's intent to register the mark.<sup>53</sup> Opposers then have an opportunity to file an opposition to registration. If an opposition is filed, the Trademark Office's Trademark Trial and Appeal Board (TTAB), the USPTO's administrative board, will act as a "fact-finding decision-maker."<sup>54</sup> The TTAB's judgment may be appealed to a federal district court or the U.S. Court of Appeals for the Federal Circuit.<sup>55</sup> Finally, if the mark is met with no opposition or an applicant prevails in an opposition proceeding, the USPTO will grant registration of the mark once the mark is in use.<sup>56</sup>

### III. TRADEMARK INFRINGEMENT

In addition to establishing the registration process and the requirements for trademark ownership rights, the Lanham Act also provides civil remedies for registered and unregistered mark holders against individuals who use marks that are likely to cause confusion with their marks.<sup>57</sup> While trademark infringement for registered and unregistered marks are statutorily distinct from one another in the Lanham Act, the test for likelihood of confusion is essentially the same under sections 32 and 43(a).<sup>58</sup> In both situations, to prevail on a trademark infringement claim, courts require a plaintiff to establish a valid ownership interest in a

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47. See BEEBE, PART I, *supra* note 15, at 285, 301 (detailing federal trademark application process).

48. See *id.* at 299-300 (laying out important elements of application process).

49. See Lanham Act § 1(a), 15 U.S.C. § 1051(a) (2018) (describing use-based filing).

50. See *id.* § 1051(b) (describing intent-to-use filing base).

51. See generally *id.* §§ 1126, 1141 (providing guidance for international marks).

52. See *id.* § 1062.

53. See 15 U.S.C. § 1062.

54. See 3 MCCARTHY, *supra* note 1, § 21:1 (discussing ex parte appeals of accepted trademark registrations).

55. See *id.* § 21:4 fig.21:4A (charting appeal process in ex parte decisions).

56. See BEEBE, PART I, *supra* note 15, at 302. When an applicant has filed an intent-to-use application, the USPTO grants a "Notice of Allowance" in the *Official Gazette*; after the period of opposition has passed, the applicant has six months (plus a series of potential extensions) to file a "Statement of Use" showing use of the mark in commerce. *Id.*

57. See Lanham Act §§ 32, 43(a), 15 U.S.C. §§ 1114, 1125(a) (2018).

58. See generally 4 MCCARTHY, *supra* note 1, § 23:1 (detailing central principles for common-law and statutory trademark infringement).

mark and that a defendant's use of its own mark in commerce is likely to cause confusion with the plaintiff's mark.<sup>59</sup>

In determining whether a defendant's use is likely to cause confusion, the 1938 *Restatement (First) of Torts* proposed four factors for consideration in every trademark infringement case.<sup>60</sup> These four factors included: the degree of similarity in appearance, pronunciation of the words used, verbal translation, and suggestion; the intent in adopting the designation; the relation in use and manner of marketing between the goods or services at issue; and the degree of care likely to be exercised by purchasers.<sup>61</sup> The *Restatement* provided nine additional factors to be considered when the goods attached to the relevant marks were noncompetitive with each other.<sup>62</sup>

Because the *Restatement* failed to provide a single, unified test, courts and the TTAB have generally developed their own nonexhaustive, multifactor tests for determining whether a likelihood of confusion exists in any given case.<sup>63</sup> Several of the factors U.S. courts and the TTAB tend to consider in their infringement analyses include: the strength of the plaintiff's mark, the similarity of the marks, the proximity of the goods, and evidence of actual confusion.<sup>64</sup> Nevertheless, because of the fact-intensive inquiry involved for each case, no one factor is more important than any of the others. For the purposes of this Article, I will focus on the strength of a mark factor in the likelihood of confusion infringement analysis.

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59. See *Gruner + Jahr USA Publ'g v. Meredith Corp.*, 991 F.2d 1072, 1074 (2d Cir. 1993) (reiterating essence of trademark infringement suit); see also *Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137, 1144 (9th Cir. 2011) (providing plaintiff's claim requirements).

60. See BARTON BEEBE, TRADEMARK LAW: AN OPEN-SOURCE CASEBOOK - PART II: TRADEMARK INFRINGEMENT 30 (3d ed. 2016), <http://tmcasbook.org/wp-content/uploads/2016/08/BeebeTMLaw-3.0-Part-2-Infringement.pdf> [<https://perma.cc/A39W-TT5S>] [hereinafter BEEBE, PART II] (discussing four factors suggested for considering trademark infringement cases).

61. RESTATEMENT (FIRST) OF TORTS § 729 (AM. LAW INST. 1938).

62. See *id.* § 731. These nine factors included:

- (a) the likelihood that the actor's goods, services[,] or business will be mistaken for those of the other;
- (b) the likelihood that the other may expand his business so as to compete with the actor;
- (c) the extent to which the goods or services of the actor and those of the other have common purchasers or users;
- (d) the extent to which the goods or services of the actor and those of the other are marketed through the same channels;
- (e) the relation between the functions of the goods or services of the actor and those of the other;
- (f) the degree of distinctiveness of the trademark or trade name;
- (g) the degree of attention usually given to trade symbols in the purchase of goods or services of the actor and those of the other;
- (h) the length of time during which the actor has used the designation; [and]
- (i) the intent of the actor in adopting and using the designation.

*Id.*

63. See 4 MCCARTHY, *supra* note 1, § 23:19 (laying down way courts developed their own multifactor tests).

64. See BEEBE, PART II, *supra* note 60, at 37 (charting factors considered circuits).

## IV. TRADEMARK STRENGTH

Some courts rely on the basic principle that the stronger a mark, the greater the scope of protection it is entitled to.<sup>65</sup> There are two types of trademark strength concepts: conceptual strength and commercial strength.<sup>66</sup> Conceptual strength focuses on a mark's placement on the *Abercrombie* spectrum at the time of the mark holder's first use of the mark.<sup>67</sup> In principle, the conceptual strength of a mark turns on the likelihood that consumers encountering the mark for the first time will recognize it as a source indicator.<sup>68</sup> A mark's commercial strength, in turn, depends on the "actual customer recognition value" of the mark at the time of litigation.<sup>69</sup> Accordingly, courts look to the same kind of actual marketplace evidence for determining commercial strength as they do when determining whether secondary meaning exists.<sup>70</sup> Despite this, there is a clear distinction between the two, as secondary meaning deals with "an issue of validity for non-inherently distinctive designations[,] while commercial strength affects the scope of a trademark holder's rights in a trademark infringement inquiry.<sup>71</sup> Nevertheless, courts have often found the term "secondary meaning" to have a direct relation to trademark strength, resulting in different applications of the law.<sup>72</sup>

The two types of trademark strength—conceptual strength and commercial strength—can play a significant role in trademark infringement analysis. While these concepts are similar to trademark distinctiveness, their utilization in infringement claims is unique.<sup>73</sup> Courts first require a plaintiff in an infringement claim to establish valid ownership rights in a mark.<sup>74</sup> As Timothy Greene and Jeff Wilkerson refer to it, establishing trademark ownership rights can be considered "Step 1" of the process of proving infringement.<sup>75</sup> At Step 1, the court conducts a threshold inquiry into the mark's validity. A registered mark provides the plaintiff a presumption of validity, and thus the plaintiff does not need to

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65. Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CALIF. L. REV. 1581, 1633 (2006) [hereinafter Beebe, *Empirical Study*].

66. See 2 MCCARTHY, *supra* note 1, § 11:80 (announcing both aspects considered in determining strength).

67. See *id.*

68. See Greene & Wilkerson, *supra* note 23, at 551.

69. See 2 MCCARTHY, *supra* note 1, § 11:80 (stating importance of customer recognition on commercial strength of mark).

70. *Id.* § 11:82 (highlighting relation between strength and secondary meaning); see Mark P. McKenna, *Teaching Trademark Theory Through the Lens of Distinctiveness*, 52 ST. LOUIS U. L.J. 843, 846 (2008). "The concept of distinctiveness also overlaps significantly with that of trademark strength . . ." McKenna, *supra*, at 846.

71. See 2 MCCARTHY, *supra* note 1, § 11:82.

72. See *Sports Auth., Inc. v. Prime Hosp. Corp.*, 89 F.3d 955, 961 (2d Cir. 1996) (showing misapplication of term "secondary meaning").

73. See Greene & Wilkerson, *supra* note 23, at 545-46 (setting forth Beebe's spatial model of trademark strength).

74. See *Gruner + Jahr USA Publ'g v. Meredith Corp.*, 991 F.2d 1072, 1074 (2d Cir. 1993); see also *Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137, 1144 (9th Cir. 2011).

75. See Greene & Wilkerson, *supra* note 23, at 546-47.

provide evidence of the mark's distinctiveness.<sup>76</sup> Satisfaction of Step 1, in addition to any other statutory prerequisites for trademark protection, initially entitles every trademark to the same rights and protections. If the mark satisfies Step 1, the court moves on to Step 2, which considers the mark's scope of protection in deciding whether the defendant's behavior creates a likelihood of confusion between the two parties' marks.<sup>77</sup> This analysis considers several factors, including trademark strength.<sup>78</sup> The measurement of trademark strength is the byproduct of both conceptual *and* commercial strength.<sup>79</sup> Trademark strength, in turn, can play a role in the scope of protection of a given mark at the time of trial, regardless of its history or future.<sup>80</sup> Thus, trademark strength distinguishes between those marks that are just barely distinctive enough for protection, and those that serve a strong, source-indicating function.<sup>81</sup>

Statistical analysis has shown that a finding of trademark strength is correlated with an ultimate finding of likelihood of confusion.<sup>82</sup> For example, consider the following trademarks: Cold and Creamy for ice cream products, which while merely descriptive, has acquired some secondary meaning, and Exxon for petroleum products, a fanciful mark well known to consumers throughout the United States. These marks both satisfy the statutory distinctiveness requirement under the Lanham Act, and both are entitled to protection against infringement. In an infringement action, however, the concept of trademark strength enables courts to adjust the scope of protection granted to each mark. All else being equal with respect to the other likelihood of confusion factors, Exxon would be entitled to a broader scope of protection than Cold and Creamy in any infringement action due its significantly superior trademark strength. This is because, at least in theory, it helps courts to determine whether the strong, source-indicating function of a trademark makes it more likely that imitators will confuse consumers.

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76. See Lanham Act § 7(b), 15 U.S.C. § 1057(b) (2018) (stating registration provides "prima facie evidence" of validity and ownership of mark). With an unregistered mark, a plaintiff must provide evidence that the mark is either inherently distinctive (i.e., suggestive, arbitrary, or fanciful), *or* has acquired distinctiveness, if the mark is descriptive or otherwise lacking inherent distinctiveness. See Greene & Wilkerson, *supra* note 23, at 546-47. Marks that are deemed "primarily a surname" or "geographically descriptive" require acquired distinctiveness as these marks can never be inherently distinctive. See BEEBE, PART I, *supra* note 15, at 30-31, 34-35. In the case of a registered mark, because validity is presumed, a plaintiff does not need to provide this evidence unless a defendant challenges the mark's validity. Additionally, if the mark is incontestable, a plaintiff likely will not need to address this issue at all. See *infra* Part VI (discussing incontestability).

77. See Greene & Wilkerson, *supra* note 23, at 547.

78. See *id.*

79. See generally 2 MCCARTHY, *supra* note 1, § 11:73 (providing concept of greater protection for stronger marks because "[n]ot all marks are equal").

80. See, e.g., Greene & Wilkerson, *supra* note 23, at 544 (providing example of trademark's strength in infringement suit).

81. See *id.* at 546 (prescribing scope of trademark protection related to trademark strength).

82. See Kevin Blum et al., *Consistency of Confusion? A Fifteen-Year Revisiting of Barton Beebe's Empirical Analysis of Multifactor Tests for Trademark Infringement*, 2010 STAN. TECH. L. REV. 3, 24 (discussing trademark strength in likelihood of confusion analysis).

Nevertheless, it is difficult to understand the significance of trademark strength in infringement claims without first understanding why courts consider it relevant to the likelihood of confusion among consumers. A mark can signify a product's source to the consumer as well as influence such consumer's purchasing decisions.<sup>83</sup> As a result, courts may consider trademark strength when distinguishing between weak and strong marks.<sup>84</sup> Stronger marks are afforded greater protections because courts reason that the use of identical or similar marks by others is more likely to cause consumer confusion.<sup>85</sup> As the *Restatement (Third) of Unfair Competition* explains, the stronger a mark is, "the greater the likelihood that prospective purchasers will associate the same or a similar designation found on other goods, services, or businesses with the prior user."<sup>86</sup> Others have suggested that granting greater protection to stronger marks is not so much about the likelihood that consumers will be confused, but is rather focused on the potential harm that such confusion may create.<sup>87</sup> As to this argument, it appears to follow logically that the infringement of a stronger mark is more likely to result in greater harm to both the trademark holder and consuming public than the potential harm that could result from the infringement of a weak mark.

One might question why courts do not grant the same levels of protection to a descriptive mark with just enough secondary meaning as they give to a fanciful mark with strong secondary meaning? In answering this question, it is critical to understand the costs associated with granting unduly broad protection to weak marks. Competitors may fear that the risk of potential infringement outweighs the reward of entering the market. This may result in a barrier to entry, deterring competitors from entering the marketplace. Another potential consequence of granting broad protections to weak marks is that it could reduce the incentives for a trademark holder to continue developing a mark's commercial strength. If one's mark is granted the same scope of protection in the infringement context, regardless of whether the mark is strong or weak, then there may be less of an incentive to continue developing the mark's actual customer recognition value.

Some scholars have suggested that the concept of trademark strength may need a more uniform standard.<sup>88</sup> One such scholar, Barton Beebe, calls for this more uniform standard based on his conclusion that courts are no longer applying basic concepts of trademark law, such as the effects of a mark's placement on

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83. See Greene & Wilkerson, *supra* note 23, at 545-46 (articulating connection trademark makes to origin of product in consumers' eyes).

84. See 4 MCCARTHY, *supra* note 1, § 23:40.50 (qualifying stronger marks granted stronger protection).

85. *Id.* § 23:49.

86. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 21 cmt. i (AM. LAW INST. 1995).

87. See Robert G. Bone, *Taking the Confusion out of "Likelihood of Confusion": Toward a More Sensible Approach to Trademark Infringement*, 106 NW. U. L. REV. 1307, 1346 (2012) (suggesting confusion of marks potentially extremely harmful to consumers).

88. See Beebe, *Empirical Study*, *supra* note 65, at 1633; see also Greene & Wilkerson, *supra* note 23, at 535.

the *Abercrombie* spectrum, secondary meaning, or federal registration, consistently.<sup>89</sup> With courts applying the trademark strength analysis differently, plaintiffs and defendants may have difficulty anticipating their likelihood of success in infringement suits. This evidences a potential problem of unpredictability and confusion in trademark strength analysis if parties do not understand how courts may measure trademark strength. As a result, the rest of this Article provides several case studies to illustrate the courts' different views on the presumption of strength analysis.

## V. THE PRESUMPTION OF STRENGTH

Federal registration provides a trademark holder with significant benefits including a prima facie presumption of validity of the trademark, with the burden of proof shifting to anyone who challenges the mark's validity.<sup>90</sup> Additionally, if a mark is registered with the USPTO by acceptance of proof of secondary meaning, courts adopt a presumption as to the sufficiency of that evidence and validity of the mark.<sup>91</sup> Some courts have concluded the presumption of validity granted to registered trademarks does not mean that the mark is *strong* for purposes of trademark infringement analysis.<sup>92</sup> As a result, these courts believe that the issue of a mark's validity is a separate inquiry from a mark's strength in the likelihood of confusion test.<sup>93</sup> Nevertheless, other courts have adopted a presumption of strength when evaluating the strength of a registered mark in the infringement context.<sup>94</sup> In their analyses, these courts tend to equate distinctiveness with strength based on the mark's registration, and believe the registered

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89. See Beebe, *Empirical Study*, *supra* note 65, at 1633 (debating flaws within courts' application of basic concepts of trademark law).

90. See 7 LOUIS ALTMAN & MALLA POLLACK, *CALLMANN ON UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES* § 26:101 (4th ed. 2019).

91. See generally 2 MCCARTHY, *supra* note 1, § 11:43 (discussing presumption of secondary meaning and mark validity at date of registration).

92. See *Petro Stopping Ctrs., L.P. v. James River Petroleum, Inc.*, 130 F.3d 88, 92-94 (4th Cir. 1997) (stating courts confuse inquiry into trademark's validity with trademark's strength in likelihood of confusion analysis); *Munters Corp. v. Matsui Am., Inc.*, 909 F.2d 250, 252 (7th Cir. 1990) (stating argument where strength of mark includes discussion of whether mark merely descriptive); see also *infra* Section V.A (discussing case study for courts rejecting presumption of strength).

93. See, e.g., *Petro Stopping Ctrs.*, 130 F.3d at 92.

94. See, e.g., *Americana Trading Inc. v. Russ Berrie & Co.*, 966 F.2d 1284, 1287-88 (9th Cir. 1992) (discussing mark's strength); *Rosenthal A.G. v. Ritelite, Ltd.*, 986 F. Supp. 133, 142 (E.D.N.Y. 1997) (falling back on presumption of strength when mark registered); *Horn's, Inc. v. Sanofi Beaute, Inc.*, 963 F. Supp. 318, 320, 322 (S.D.N.Y. 1997) (relying on federal registration equaling presumption of trademark strength). "Plaintiffs' mark is registered and thus is presumptively strong as applied to the goods and services listed on the registrations, namely: a motorcycle club." *Rd. Dawgs Motorcycle Club of the U.S., Inc. v. "Cuse" Rd. Dawgs, Inc.*, 679 F. Supp. 2d 259, 286 (N.D.N.Y. 2009); see *Sanrio Co. v. J.I.K. Accessories*, No. C-09-0440 EMC, 2012 U.S. Dist. LEXIS 55280, at \*9 (N.D. Cal. Apr. 19, 2012) (finding Hello Kitty mark protected on USPTO's Principal Register, creating presumption of mark strong); see also *infra* Section V.B (providing case study for courts adopting presumption of strength).

mark is entitled to a presumption of strength while conducting the likelihood of confusion analysis.<sup>95</sup>

A. *Case Study 1: DeCosta v. Viacom International, Inc.*

In *DeCosta v. Viacom International, Inc.*,<sup>96</sup> plaintiff DeCosta made several event appearances in 1947 as a cowboy dressed in black carrying a pistol.<sup>97</sup> He called himself “Paladin” and passed out calling cards with pictures of a chess knight and catch phrases.<sup>98</sup> In 1963, DeCosta unsuccessfully sued CBS claiming their television show from 1957 to 1964 that starred a cowboy named Paladin unlawfully copied DeCosta’s idea.<sup>99</sup> Years later, DeCosta sued again, claiming defendant Viacom violated trademark laws by rebroadcasting the old Paladin CBS programs because DeCosta had since registered his mark related to the character.<sup>100</sup>

DeCosta argued that the fact of registration showed a clear likelihood of confusion between his mark and that of the character on the old CBS shows.<sup>101</sup> A jury found in his favor, but the First Circuit reversed.<sup>102</sup> Specifically, the First Circuit stated that the Lanham Act “statute nowhere says that registration makes it easier for a registrant (with a conceded right to use a concededly valid mark that he concededly owns) to prove that a relevant buying public may confuse some other person’s mark with his own.”<sup>103</sup> As a result, while registration may relate to a mark’s strength—in that it can possess secondary meaning—the First Circuit does not recognize the advantages conferred by registration in the context of determining the likelihood of confusion, and thus does not apply a presumption of strength for purposes of trademark infringement analysis.<sup>104</sup>

B. *Case Study 2: Americana Trading Inc. v. Russ Berrie & Co.*

In *Americana Trading Inc. v. Russ Berrie & Co.*,<sup>105</sup> plaintiff Amtra began selling pairs of stuffed bears under the mark, “Wedding Bears,” in June 1984.<sup>106</sup> The bears depicted a bridegroom and bride whose hands were connected with strips of Velcro.<sup>107</sup> On June 25, 1985, Amtra received a federal registration for

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95. See, e.g., *Horn’s, Inc.*, 963 F. Supp. at 322.

96. 981 F.2d 602 (1st Cir. 1992).

97. *Id.* at 604.

98. *Id.*

99. *Id.* The CBS television program was called “Have Gun—Will Travel.” *Id.* DeCosta’s calling cards also had this same phrase. *Id.* at 605-06.

100. 981 F.2d at 604, 606.

101. *Id.* at 605-06.

102. *DeCosta v. Viacom Int’l, Inc.*, 981 F.2d 602, 604 (1st Cir. 1992).

103. *Id.* at 606.

104. *Id.* at 606-07.

105. 966 F.2d 1284 (9th Cir. 1992).

106. See *id.* at 1286.

107. See *id.*

its "Wedding Bears" trademark and by 1986, Amtra was selling an entire line of its "Wedding Bears," including a full bridal party of stuffed bears.<sup>108</sup> Amtra claimed it made "significant" advertising efforts in promoting the bears, and received coverage on national television and newspapers.<sup>109</sup> Amtra also entered into a licensing agreement for use of its mark with Commonwealth Toys & Novelty and had its product used as a giveaway on the popular "Newlyweds" television program.<sup>110</sup>

In October 1985, defendant Russ also began planning to enter the teddy bear market under the marks, "Bride Bear" and "Groom Bear."<sup>111</sup> Russ had a "content tag" sewn on the bottom of his bears indicating the materials used to manufacture the bear and notating the words "Wedding Bear."<sup>112</sup> These tags also included "Russ Berrie & Co." and its "Caress" trademark in large letters on the back.<sup>113</sup> The term "Wedding Bear" was not used at any time for promotional or sales purposes.<sup>114</sup> Further, Russ's product planner stated that the term "Wedding Bear" was placed on the "Bride and Groom Bears" content tags because she "thought it was a descriptive name for bears dressed in wedding attire."<sup>115</sup> Evidence indicated Russ was aware of Amtra's Wedding Bears around January 30, 1985.<sup>116</sup> In November 1985, Amtra's attorney wrote to Russ contending that Russ's "Newlywed Bears," a line of Russ's bears different from his "Bride and Grooms Bears," were infringing on Amtra's "Wedding Bears" mark.<sup>117</sup> Russ denied infringement and also began selling his "Bride and Groom Bears" in early 1986.<sup>118</sup>

In August 1987, Amtra filed suit in district court alleging trademark infringement and the district court quickly entered a preliminary injunction enjoining Russ from using the "Wedding Bear" mark.<sup>119</sup> Russ complied with the injunction and then filed for summary judgment.<sup>120</sup> Relying on the likelihood of confusion factors, the district court most notably found that there was insufficient evidence as a matter of law that "Wedding Bears" was associated with Amtra.<sup>121</sup> In other words, the mark had minimal secondary meaning and because both parties agreed the mark was descriptive, the district court found that Amtra's mark

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108. *Id.*

109. *Americana Trading Inc.*, 966 F.2d at 1286.

110. *See id.*

111. *Americana Trading Inc. v. Russ Berrie & Co.*, 966 F.2d 1284, 1286 (9th Cir. 1992).

112. *See id.*

113. *See id.*

114. *Id.*

115. *Americana Trading Inc.*, 966 F.2d at 1286 (quoting from product planner's deposition).

116. *Id.*

117. *Americana Trading Inc. v. Russ Berrie & Co.*, 966 F.2d 1284, 1286 (9th Cir. 1992).

118. *See id.*

119. *See id.*

120. *Id.*

121. *See Americana Trading Inc.*, 966 F.2d at 1287.

was weak.<sup>122</sup> The district court also held the marks were not similar in sound, sight, or meaning because Russ only displayed “Wedding Bear” on the content tag.<sup>123</sup> Although Amtra proffered evidence indicating consumer and retailer confusion resulting from Russ’s use of the “Wedding Bear” mark on its “Bride and Groom Bears,” the district court granted summary judgment for Russ.<sup>124</sup>

The U.S. Court of Appeals for the Ninth Circuit reversed summary judgment and remanded for trial.<sup>125</sup> In doing so, the court reanalyzed the same six-factor test applied by the district court for determining likelihood of confusion.<sup>126</sup> When evaluating the strength of Amtra’s “Wedding Bears” mark, the Ninth Circuit held the district court had insufficiently weighed the “presumptive effect of Amtra’s federal registration.”<sup>127</sup> In particular, the Ninth Circuit indicated that Amtra’s registration carried a “presumption of secondary meaning[,]” and “[t]o the extent that secondary meaning had attached to a descriptive mark, the mark was rendered stronger and more worthy of protection.”<sup>128</sup> The Ninth Circuit concluded that “Amtra holds a registered and presumptively strong mark.”<sup>129</sup>

The Ninth Circuit decided that all of the factors considered in determining the likelihood of confusion either weighed in favor of Amtra or created a genuine issue of material fact, which could aid a jury in finding infringement. Nevertheless, based on the Ninth Circuit’s analysis, it is possible that a presumption of strength in the infringement context may have the ability to potentially sway courts like the Ninth Circuit to a finding of infringement in close cases. The application by some circuits of a presumption of strength for registered marks suggests another benefit to trademark registration.

## VI. THE PRESUMPTION OF STRENGTH AND INCONTESTABILITY

The Lanham Act’s “incontestability” provision only adds another wrinkle in courts’ approaches to analyzing a mark’s registration and strength. One of the benefits of trademark registration is that after five years of continuous use, a trademark is eligible for incontestable status.<sup>130</sup> When a trademark has reached

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122. *See id.*

123. *Americana Trading Inc. v. Russ Berrie & Co.*, 966 F.2d 1284, 1287-88 (9th Cir. 1992).

124. *Id.* at 1286-87. The evidence included that when Vernon Goldsmith, a principal of Amtra, visited retailers asking if they carried “Wedding Bear” stuffed animals, the employees led him to Russ’s products and also that Amtra lost previously-secured accounts because Russ offered the “Bride and Groom Bears” at a lower price. *Id.* Additionally, Russ’s sales increased as Amtra’s decreased, and Amtra received a letter from a consumer expressing their enthusiasm for their products but the letter included a photograph of Russ’s products. *Id.* at 1287.

125. *See id.* at 1290.

126. *See id.* at 1287. These factors included: strength of the mark; similarity in appearance, sound, and meaning; class of the goods; marketing channels used; actual confusion; and intent of the defendant. *Id.*

127. *See Americana Trading Inc.*, 966 F.2d at 1287.

128. *See id.* (demonstrating need for plaintiff to show secondary meaning not attached to mark).

129. *See Americana Trading Inc. v. Russ Berrie & Co.*, 966 F.2d 1284, 1290 (9th Cir. 1992).

130. *See Lanham Act* § 15, 15 U.S.C. § 1065 (2018) (announcing incontestability eligibility under Lanham Act).

incontestable status, the trademark's registration is "conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce."<sup>131</sup> Section 33(b) of the Lanham Act provides only eight enumerated defenses for the alleged, infringing defendant to use.<sup>132</sup> *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*,<sup>133</sup> confirmed that a defendant is limited to these eight defenses when challenging an incontestable mark's validity.<sup>134</sup> Most significantly, the mark's validity cannot be challenged on the basis of a lack of distinctiveness.<sup>135</sup> Again, courts have applied different analyses to an incontestable mark's strength. This results in inconsistencies among courts and their outcomes. The majority view holds that incontestable status does not mean the mark is strong, while the minority view believes incontestable status equates to the mark being strong in the likelihood of confusion infringement analysis.<sup>136</sup>

#### A. Majority View

Most circuits have acknowledged that incontestability should not play a role in the strength analysis for the purposes of determining infringement.<sup>137</sup> As the Fifth Circuit remarked, "Incontestable status does not make a weak mark strong."<sup>138</sup> The Fourth Circuit has similarly concluded "that incontestability affects the validity of the trademark but does not establish the likelihood of confusion necessary to warrant protection from infringement."<sup>139</sup> The Seventh Circuit agrees, explaining that "[t]he fact that the mark may be incontestable does not indicate the mark is relatively strong but only that it is not generic" and that "[i]ncontestable status merely requires a non-generic mark; strength analysis encompasses a different inquiry employing additional considerations."<sup>140</sup> The TTAB also follows the majority rule that incontestable status is not evidence of the mark's strength.<sup>141</sup>

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131. See *id.* § 1115(b) (proscribing eight enumerated defenses available).

132. See *id.* These defenses include: "[t]hat the registration or the incontestable right to use the mark was obtained fraudulently; . . . [t]hat the mark has been abandoned by the registrant; or . . . [t]hat the mark is functional." *Id.* § 1115(b)(1)-(2), (8).

133. 469 U.S. 189 (1985).

134. See *id.* at 205 (upholding defendants' limited defenses).

135. See *id.* (emphasizing critical difference between validity and infringement).

136. See 6 MCCARTHY, *supra* note 1, § 32:155.

137. See *id.* (providing both majority and minority view summaries).

138. See *Oreck Corp. v. U.S. Floor Sys., Inc.*, 803 F.2d 166, 171 (5th Cir. 1986) (holding incontestability status not related to strength of trademark).

139. See *Lone Star Steakhouse & Saloon, Inc. v. Alpha of Va., Inc.*, 43 F.3d 922, 935 (4th Cir. 1995) (stating analysis of incontestable status does not establish clear likelihood of confusion).

140. *Am. Soc'y of Plumbing Eng'rs v. TMB Publ'g, Inc.*, 109 F. App'x 781, 788-89 (7th Cir. 2004).

141. See *Safer, Inc. v. OMS Inv., Inc.*, 94 U.S.P.Q.2d (BNA) 1031, 1035 (T.T.A.B. 2010).

### B. Minority View

The Eleventh and Sixth Circuits have both held that incontestable status should be a consideration in a likelihood of confusion analysis to determine whether infringement has occurred.<sup>142</sup> For example, in *Dieter v. B & H Industries of Southwest Florida, Inc.*,<sup>143</sup> the Eleventh Circuit stated that “[b]ecause Dieter’s mark is incontestable, then it is presumed to be at least descriptive with secondary meaning, and therefore a relatively strong mark.”<sup>144</sup> The Eleventh Circuit has continually reaffirmed this theory, stating in 1999 that “the district court failed to consider the fact that Frehling’s mark is incontestable and therefore constitutes a ‘relatively strong mark[,]’” and again more recently in 2010, holding that the district court erred in failing to consider the presumptive effect of a mark’s incontestability in the mark’s strength determination.<sup>145</sup> Similarly, the Sixth Circuit proposed that “while the strength of plaintiffs’ mark will still be at issue in cases involving contest[a]ble marks, once a mark has been registered for five years, the mark must be considered strong and worthy of full protection.”<sup>146</sup> In that case, the Sixth Circuit suggests that in infringement cases involving an incontestable mark, a court need not even conduct a strength analysis, instead presuming the mark’s strength based on its registration and incontestability, and moving onto the other likelihood-of-confusion factors. The Sixth Circuit affirmed this presumption of strength for several years.<sup>147</sup> Nevertheless, in 2002 the Sixth Circuit stated that a valid, incontestable mark “does not necessarily mean that its strength is particularly relevant to the ultimate issue of whether confusion is likely to occur[,]” effectively returning its position to the majority view.<sup>148</sup>

## VII. CONCLUSION

This Article and its case studies have attempted to illustrate the effect the application of a presumption of strength can have on a mark’s scope of protection

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142. See generally 6 MCCARTHY, *supra* note 1, § 32:155 (discussing challenges to strength of incontestably registered mark); *infra* notes 143-48 and accompanying text (providing overview of Eleventh and Sixth Circuits’ decisions).

143. 880 F.2d 322 (11th Cir. 1989).

144. See *id.* at 329.

145. See *Caliber Auto. Liquidators, Inc. v. Premier Chrysler, Jeep, Dodge, LLC*, 605 F.3d 931, 939 (11th Cir. 2010) (providing recent reaffirmation by court); *Frehling Enters., Inc. v. Int’l Select Grp.*, 192 F.3d 1330, 1336 (11th Cir. 1999) (reaffirming presumption).

146. *Wynn Oil Co. v. Thomas*, 839 F.2d 1183, 1187 (6th Cir. 1988).

147. See *Daddy’s Junky Music Stores, Inc. v. Big Daddy’s Family Music Ctr.*, 109 F.3d 275, 282 (6th Cir. 1997) (holding incontestable status serves confer mark strength accorded to descriptive mark with secondary meaning); *Wynn Oil Co. v. Am. Way Serv. Corp.*, 943 F.2d 595, 600 (6th Cir. 1991) (holding incontestability equated with strength).

148. See *Therma-Scan, Inc. v. Thermoscan, Inc.*, 295 F.3d 623, 632 (6th Cir. 2002) (determining incontestable status shifts focus away from ultimate issue of confusion); see also *Progressive Distribution Servs., Inc. v. United Parcel Serv., Inc.*, 856 F.3d 416, 429 (6th Cir. 2017) (holding in line with *Therma-Scan* reasoning).

in the context of trademark infringement. For some circuits, a mark's registration does not automatically presume the mark is strong. Circuits that apply the presumption may provide a further benefit to mark holders with registration and/or incontestable status. In addition to the many benefits already granted by trademark registration, in these circuits, a mark's *distinctiveness* at the time of registration can function as evidence of *strength* in any future potential infringement cases. This may also increase the probability that courts will find a likelihood of confusion and, potentially, infringement. It remains important for practitioners, judges, and scholars, at the very least, to appreciate the different views courts apply in the likelihood of confusion infringement analysis.