

## A QUICK GUIDE TO TRADEMARK LAW AND RECENT DEVELOPMENTS IN THE FEDERAL CIRCUIT

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*Executive Summary: Trademark law enables businesses to build brand reputation and consumer recognition by protecting marks that are distinctive, non-functional, and used in commerce. The purpose of trademark protection is to reduce consumer confusion and preserve a company's goodwill in the marketplace. Federal trademark protection is codified in the Lanham Act, which also extends to trade dress—features of a product's visual appearance or packaging, provided those features are nonfunctional. Trademarks may be registered with the United States Patent and Trademark Office. As part of the registration process, the Lanham Act entitles "any person" to oppose the registration of a mark or cancel a mark's registration. The Federal Circuit affirmed the Trademark Trial and Appeal Board's decision that a consumer lacked statutory standing to oppose the registration of a trademark in Curtin v. United Trademark Holdings, Inc., summarized below.*

### I. BACKGROUND OF TRADEMARK LAW

Trademark law protects a business's commercial identity or brand by discouraging other businesses from adopting a name, logo, or other mark used to sell goods and services that is "confusingly similar" to an existing trademark.<sup>1</sup> Companies, such as Apple, Nike, and Disney, have developed brand names that carry value independent of their products and services.<sup>2</sup> This reputation, or goodwill, is a critical asset in competing in the global marketplace.<sup>3</sup> Trademark law safeguards that goodwill by preventing outside entities from exploiting it and by reducing consumer confusion, ensuring that individuals do not mistakenly purchase one company's goods when intending to purchase another's.<sup>4</sup>

Although law traces its origins back to early common law, today, trademark law is based on statutory rights conferred by the Lanham Act, which is the federal codification of trademark law.<sup>5</sup> The United States Patent and Trademark Office (USPTO) grants federal registrations to parties for their trademarks that meet the federal requirements for protectability,<sup>6</sup> which confers several important rights under the Lanham Act.<sup>7</sup> Trademark owners may enforce their rights

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<sup>1</sup> Marks used in connection with services are often called "service marks." This memo will use the term "trademark" to refer to both trademarks and service marks.

<sup>2</sup> 15 U.S.C. § 1127 (2021) (defining "trademark" to include marks used to identify and distinguish goods and to indicate source).

<sup>3</sup> See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163–64 (1995) (noting that trademarks foster competition by securing to producers the benefits of their goodwill).

<sup>4</sup> See *Museum of Mod. Art v. MOMACHA IP LLC*, 339 F. Supp. 3d 361, 376 (S.D.N.Y. 2018) (discussing how using the name MoMaCha in the same font style as MoMa is likely to confuse consumers into thinking MoMaCha is affiliated with the Museum of Modern Art).

<sup>5</sup> For a discussion on the common law origins of trademark law, see Lanham Act §§ 1, 15 U.S.C. § 1051 (2021) (providing for application and registration of trademarks with the USPTO).

<sup>6</sup> 15 U.S.C. § 1051.

<sup>7</sup> See *id.* §§ 1051–1141.

under the Lanham Act, state common law, and trademark statutes (often called unfair competition statutes) to sue other mark owners for infringement, dilution, false advertising, right of publicity, and other forms of unfair competition.<sup>8</sup> Parties may enforce their trademark rights by suing in district court, alleging trademark infringement, dilution, or any other cause of action enabled by the Lanham Act or common law,<sup>9</sup> and appeals are heard by the appropriate circuit court.<sup>10</sup>

Trademark rights can last indefinitely as long as the owner continuously uses the mark in commerce, unlike copyright law and patent law, which protect intellectual property for a limited duration before requiring it to enter the public domain.<sup>11</sup> This distinction exists because Congress derives its power to legislate trademark law from the Commerce Clause,<sup>12</sup> which enables Congress to confer rights based on the use of a mark in commerce; whereas, Congress enacts copyright and patent law from a different constitutional basis,<sup>13</sup> which enables Congress to incentivize creativity and invention by granting exclusive rights for “limited [t]imes.”<sup>14</sup>

## II. OVERVIEW OF TRADEMARKS

In the United States, a trademark is protectable and enforceable as a property right only if it is (1) distinctive of source, (2) non-functional, and (3) used in commerce.<sup>15</sup>

To be “distinctive of source,” a mark must immediately communicate to consumers the source of a good or service.<sup>16</sup> In a landmark case, the Second Circuit developed a spectrum of

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<sup>8</sup> Trademark common law dates to medieval brandings used by merchants to distinguish their goods from one another. *See* Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1849–50 (2007).

<sup>9</sup> Note that the Lanham Act confers upon both federally registered and unregistered trademarks the right to sue for infringement. 15 U.S.C. §§ 1114, 1125.

<sup>10</sup> Lanham Act § 39, 15 U.S.C. § 1121 (2021) (granting federal district courts original jurisdiction over all actions arising under the Lanham Act).

<sup>11</sup> “Use in commerce” refers to a “sale or transportation of the trademarked goods in United States interstate or international commerce. J. THOMAS MCCARTHY, 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:117 (5th ed. 2023).

<sup>12</sup> The Supreme Court held that Congress’s power to regulate trademarks requires the use of the mark in interstate and foreign commerce, as this power comes only from the Commerce Clause. *See id.* at § 6:2.

<sup>13</sup> U.S. CONST. art. I, § 8, cl. 8. (“To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Rights their respective Writings and Discoveries.”).

<sup>14</sup> MCCARTHY, *supra* note 11, at § 6.8.

<sup>15</sup> BARTON BEEBE, TRADEMARK LAW: AN OPEN-SOURCE CASEBOOK 214 (10th ed. 2023).

<sup>16</sup> Note that “source” does not mean the literal factory where goods were manufactured, but rather the entity that provides the goods to consumers. A trademark cannot describe the goods or services—it must designate who a product comes from, and not what the product is. Additionally, a mark may be either inherently distinctive or may have acquired distinctiveness if consumers have come to recognize the mark as referring to a particular source of goods even though the mark itself merely describes the goods. McCarthy, *supra* note 11, at § 4.14 (secondary meaning).

distinctiveness ranging from least distinctive (generic) to most distinctive (fanciful).<sup>17</sup> At the lowest end of the spectrum are generic marks, which are never enforceable.<sup>18</sup> Generic marks name the actual type of good or service and do not serve any source-identifying function.<sup>19</sup> Recently, the court held the mark “Pretzel Crisps” to be generic and unprotectable for “pretzel crackers” after twelve years of litigation.<sup>20</sup> Next on the distinctiveness spectrum are descriptive marks, which merely describe qualities or characteristics of the good or service without serving as an immediate source identifier.<sup>21</sup> Descriptive marks are not enforceable unless they have acquired secondary meaning.<sup>22</sup>

The next category of marks is suggestive marks, which are distinctive enough to be enforceable without a showing of secondary meaning.<sup>23</sup> A suggestive mark “requires imagination, thought, and perception to reach a conclusion as to the nature of the goods,” therefore acting as an indicator of source rather than as a description of the goods themselves.<sup>24</sup> Finally, the most distinctive marks—arbitrary and fanciful—are unrelated to the actual goods or

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<sup>17</sup> *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976). The Supreme Court endorsed Judge Friendly’s spectrum as the appropriate test for determining whether a mark is sufficiently distinctive in *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992). However, this spectrum is difficult to apply to non-word marks. *See generally* *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000) (discussing the Abercrombie spectrum applicability to trade dress). For a helpful chart depicting the spectrum, see *Is Your Brand “Distinctive” Enough to Be Trademarked?*, PATROLA LAW (June 29, 2022), <http://patrolalaw.com/is-your-brand-distinctive-enough-to-be-trademarked>.

<sup>18</sup> *See* MCCARTHY, *supra* note 11, at § 12.1 (“[A] generic name of a product can never function as a trademark to indicate origin.”).

<sup>19</sup> Examples include “Hotels.com” for making hotel reservations and “Serial” for an ongoing investigative reporting podcast. *See In re Hotels.com*, 573 F.3d 1300, 1304 (Fed. Cir. 2009); *In re Serial Podcast, LLC*, 126 U.S.P.Q.2d 1061, 1072 (T.T.A.B. 2018) (holding that Serial’s logos had acquired distinctiveness and were allowed to be registered).

<sup>20</sup> *Snyder’s Lance, Inc. v. Frito-Lay N. Am., Inc.*, No. 3:17-CV-00652, 2021 WL 2322931 (W.D.N.C. June 7, 2021).

<sup>21</sup> Examples include “Fish-Fry” for batter mixes to fry fish and “Supreme” for vodka. *Zatarains, Inc. v. OakGrove Smokehouse, Inc.*, 698 F.2d 786, 793 (5th Cir. 1983); *Supreme Wine Co. v. Am. Distilling Co.*, 310 F.2d 888, 889 (2d Cir. 1962); *see e.g.*, *In re N.C. Lottery*, 866 F.3d 1363, 1366, 1369 (Fed. Cir. 2017) (holding that the mark “First Tuesday” is merely descriptive because it is less a source-identifier than it is a description of a feature of the goods or service).

<sup>22</sup> *See supra* note **Error! Bookmark not defined.**

<sup>23</sup> *See* *Pinterest, Inc. v. Pintrips, Inc.*, 140 F. Supp. 3d 997, 1010 (N.D. Cal. 2015) (explaining that “Pinterest” is a classic suggestive mark because it is a combination of the words “pin” and “interest,” which hints to users that they will be pinning their interests on the website).

<sup>24</sup> *Stix Prods., Inc. v. United Merchs. & Mfrs., Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968). Examples include “Tide” for laundry detergent and “Streetwise” for street marks. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 210–11 (2000); *Streetwise Maps, Inc. v. VanDam, Inc.*, 159 F.3d 739, 744 (2d Cir. 1998). A suggestive mark may receive less protection under trademark law than a descriptive mark when it is too closely associated with the products’ attributes. *See RiseandShine Corp. v. PepsiCo, Inc.*, 41 F.4th 112, 122 (2d Cir. 2022) (discussing that the use of the word “rise” to describe coffee is weak under trademark law because it clearly associates with the purposes of drinking coffee).

services (e.g., Apple for computers), or are completely made-up words (e.g., Pepsi for soda).<sup>25</sup> Arbitrary and fanciful marks instantly refer to the source of the goods or services without describing the characteristics of the goods or services, and the strongest marks confer the greatest scope of protection.<sup>26</sup>

In addition to being distinctive, trademarks cannot be functional.<sup>27</sup> The functionality doctrine prevents trademark law from being used to secure perpetual protection for useful product features, which properly belong in patent law.<sup>28</sup> Functional features that are essential to the use or purpose of the product, or that affect its cost or quality, cannot be protected as trademarks because doing so would grant a monopoly over features competitors must be free to use.<sup>29</sup>

Finally, trademarks must be used in commerce to be protectable under the Lanham Act.<sup>30</sup> This means that the mark must be used in connection with the advertising, sale, or transport of goods or services in interstate or foreign commerce.<sup>31</sup> Mere intent to use a mark is insufficient, although federal law allows for “intent-to-use” applications that secure priority contingent on eventual commercial use.<sup>32</sup> Actual use must demonstrate that the mark is placed on the product,

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<sup>25</sup> Examples of arbitrary marks include “Gap” for apparel and “Omega” for watches (these terms have nothing to do with the actual goods and services). See *Gap, Inc. v. G.A.P. Adventures Inc.*, No. 07-cv-9614, 2011 WL 2946384, at \*13 (S.D.N.Y. June 24, 2011); *Omega S.A. v. Omega Eng’g, Inc.*, 228 F. Supp. 2d 112, 123 (D. Conn. 2002). Examples of fanciful marks include “Hobbit” for a character in books and movies and “Viagra” for an erectile dysfunction drug (these terms were coined for the sole purpose of identifying the source of the goods and services). See *Warner Bros. Ent. v. Glob. Asylum, Inc.*, No. CV 12-9547 (CWx), 2012 WL 6951315, at \*5 (C.D. Cal. Dec. 10, 2012), *aff’d*, 544 Fed. App’x 683 (9th Cir. 2013); *Pfizer Inc. v. Sachs*, 652 F. Supp. 2d 512, 520 (S.D.N.Y. 2009).

<sup>26</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.* 505 U.S. 763, 786 (Thomas, J., concurring).

<sup>27</sup> *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29 (2001) (explaining that trademarks must not be functional).

<sup>28</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164–65 (1995) (holding that the functionality doctrine prevents perpetual trademark rights in useful product features).

<sup>29</sup> *Id.*

<sup>30</sup> This contrasts with many other countries that grant trademark registrations without evidence that the mark is used in commerce. See MCCARTHY, *supra* note 14, at § 16:1:50; see also Tara M. Aaron & Axel Nordemann, *The Concepts of Use of a Trademark under European Union and United States Trademark Law*, 104 T.M.R. 1186, 1189 (2014) (noting parties seeking trademark registration in the European Union do not have to prove use or intent to use).

<sup>31</sup> See *Couture v. Playdom, Inc.*, 778 F.3d 1379, 1382 (Fed. Cir. 2015) (establishing that a company must actually render service using the mark to constitute use in commerce). For an insightful discussion of the consequences and questions after the Court’s recent decision restricting extraterritoriality in the Lanham Act, see Margaret Chon & Christine Haight Farley, *Trademark Extraterritoriality: Abitron v. Hetronic Doesn’t Go the Distance*, TECH. & MKTG. L. BLOG (July 17, 2023), <https://blog.ericgoldman.org/archives/2023/07/trademark-extraterritoriality-abitron-vhetronic-doesnt-go-the-distance-guest-blog-post.htm>.

<sup>32</sup> *Aycock Eng’g, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 1357–59 (Fed. Cir. 2009) (explaining that mere intent to use does not create rights, although intent-to-use applications may secure priority).

its packaging, or in the sale or advertising of services in a way that consumers recognize as a source identifier.<sup>33</sup>

#### A. FUNCTIONALITY DOCTRINE

Non-functionality is one of three requirements a trademark must satisfy to qualify for protection. The Lanham Act explicitly states that a mark must be refused registration when it “comprises any matter that, as a whole, is functional.”<sup>34</sup> The functionality doctrine maintains separation between patent and trademark protections.<sup>35</sup> Patents are specifically designed to protect useful inventions, whereas trademark law protects non-functional branding features.<sup>36</sup>

“Functionality” within trademark law can refer to either utilitarian functionality or aesthetic functionality.<sup>37</sup> Under the utilitarian approach to functionality, “a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.”<sup>38</sup> The existence of a utility patent for a feature creates a strong presumption of the feature’s utility.<sup>39</sup> The doctrine of aesthetic functionality “looks to whether the [trade] dress makes [a product] more appealing to the public by aesthetic means.”<sup>40</sup> Aesthetic features are functional when they are necessary for a product to compete in its market.<sup>41</sup> Even when a plaintiff successfully presents a prima facie case for trademark infringement, the defendant is not liable if it can prove either utilitarian or aesthetic functionality.<sup>42</sup>

#### B. THE TRADEMARK MODERNIZATION ACT OF 2020

Enacted in December 2020,<sup>43</sup> the Trademark Modernization Act of 2020 (TMA) amended the Lanham Act in three important respects.<sup>44</sup> First, the TMA created two new ex parte procedures: expungement and reexamination.<sup>45</sup> There have been 818 petitions filed under these

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<sup>33</sup> Allard Enters., Inc. v. Adv. Programming Res., Inc., 249 F.3d 564, 572 (6th Cir. 2001).

<sup>34</sup> 15 U.S.C. § 1052(e)(5).

<sup>35</sup> Ezaki Glico Kabushiki Kaisha v. Lotte Int’l Am. Corp., 986 F.3d 250, 256 (3d Cir. 2021).

<sup>36</sup> *Id.* at 255.

<sup>37</sup> *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1338 n.1 (1982).

<sup>38</sup> *Inwood Lab’ys, Inc. v. Ives Lab’ys, Inc.*, 456 U.S. 844, 850 n.10 (1981).

<sup>39</sup> *Traffix Devices v. Mktg. Displays*, 532 U.S. 23, 29 (2001).

<sup>40</sup> Spencer Davczyk, *Aesthetic Functionality in Trade Dress: Post-Secondary Aesthetic Functionality Proposed*, 105 COM. L.J. 309, 315 (2000).

<sup>41</sup> *Id.*

<sup>42</sup> *Wallace Int’l Silversmith v. Godinger Silver Art Co.*, 916 F.2d 76, 79 (2d Cir. 1990).

<sup>43</sup> Changes to Implement Provisions of the Trademark Modernization Act of 2020, 86 Fed. Reg. 26,862, 26,863 (May 18, 2021).

<sup>44</sup> David T. Azrin, *The Trademark Modernization Act: New Procedures and Rules That Will Benefit Trademark Owners*, 31 INTELL. PROP. LITIG. 17, 17 (2021).

<sup>45</sup> *Id.* at 17–18.

ex parte procedures since April 2023.<sup>46</sup> This includes 401 expungements<sup>47</sup> and 417 reexaminations,<sup>48</sup> 80 of which were brought by the USPTO.<sup>49</sup> Second, the TMA changed the application process by allowing trademark examiners to shorten the response deadlines for applicants.<sup>50</sup> Finally, the TMA clarified the appropriate standard of proof for trademark litigation.<sup>51</sup> For a court to grant injunctive relief in a trademark case, courts must find that a plaintiff would suffer “irreparable injury” if an injunction is not ordered.<sup>52</sup> Historically, federal courts held that the “irreparable injury” element is satisfied when the alleged trademark infringement is likely to cause customer confusion, but federal courts have recently weakened this requirement by holding that customer confusion does not automatically create an assumption of irreparable injury.<sup>53</sup> The TMA addressed this issue by reestablishing the traditional principle that a showing of customer confusion is dispositive of the plaintiff’s irreparable injury.<sup>54</sup>

### C. FEDERAL REGISTRATION

One of the most important steps in securing broad trademark rights is to secure a federal trademark registration. There are numerous benefits to obtaining a federal registration, including nationwide priority beginning on the application date, constructive use, and notice to potential competitors, presumption of validity, basis for obtaining registration in foreign countries, right to request the U.S. Customs and Border Patrol to prevent infringing imports, statutory remedies, and the right to use ®.<sup>55</sup>

The USPTO, an executive office within the Department of Commerce, is responsible for granting or refusing federal registration.<sup>56</sup> Individuals and businesses seeking to register a new trademark may apply through the USPTO’s online portal independently or through a licensed

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<sup>46</sup> Mark Lerner, Jennifer M Lantz & Lauren Matturri, *The Trademark Modernization Act One Year On: New Tools and Takeaways*, WORLD TRADEMARK REVIEW (June 30, 2023).

<sup>47</sup> In an expungement proceeding, third parties may challenge a trademark registration by submitting evidence amounting to a prima facie showing that the mark has never been used in commerce on or in connection with. Azrin, *supra* note 44, at 18.

<sup>48</sup> In a reexamination proceeding, third parties may challenge a trademark registration by submitting evidence amounting to a prima facie showing that the mark was not in use in commerce on or in connection with some or all the goods or services as of the alleged use date. *Id.*

<sup>49</sup> Lerner, *supra* note 46.

<sup>50</sup> *See id.* (explaining that this change would help weed out fraudulent and improper applications more quickly).

<sup>51</sup> *Id.* at 18–19.

<sup>52</sup> 15 U.S.C. § 1116(d)(4)(B)(iv).

<sup>53</sup> Azrin, *supra* note 44, at 18–19.

<sup>54</sup> *Id.* at 19.

<sup>55</sup> BEEBE, *supra* note 15, at 232–38.

<sup>56</sup> The USPTO may refuse registration on several grounds, including a likelihood of confusion with any third-party mark, being deceptively misdescriptive, and being primarily geographically descriptive. 15 U.S.C. § 1052.

attorney.<sup>57</sup> Once a party submits an application, the USPTO assigns an Examining Attorney to review the application for compliance with USPTO regulations and the Lanham Act.<sup>58</sup>

If a mark is approved by the USPTO, it is published in The Trademark Official Gazette and open to challenge for thirty days by “any person who believes that he would be damaged by the registration of a mark.”<sup>59</sup> The grounds for opposing a mark vary, but usually the petitioner asserts that there is a likelihood of confusion between its mark and the opposed mark.<sup>60</sup> If no opposition (or extension) is filed, the mark proceeds to allowance and ultimately to registration, once use has been demonstrated.<sup>61</sup> The term of registration is ten years, with the ability to renew indefinitely, provided compliance with the USPTO post-registration and maintenance requirements.<sup>62</sup> If the USPTO refuses to register an applicant’s mark, the applicant can appeal the refusal as an *ex parte* action<sup>63</sup> to the Trademark Trial and Appeal Board (TTAB).<sup>64</sup>

#### D. TRADEMARK TRIAL AND APPEAL BOARD (TTAB) PROCEEDINGS AND APPEALS

The TTAB is a neutral body of administrative trademark judges responsible for adjudicating trademark disputes in the first instance.<sup>65</sup> The TTAB is not authorized to determine whether applicants may legally use a trademark, but it is allowed to determine whether applicants have the right to register trademarks with the federal government.<sup>66</sup> The TTAB is authorized to handle five types of cases, but the three that it most commonly deals with are (1) *ex parte* appeals, (2) oppositions, and (3) cancellations.<sup>67</sup> First, in an *ex parte* appeal, the applicant may challenge the USPTO Examining Attorney’s decision to refuse trademark registration.<sup>68</sup> Second, a party may initiate an opposition proceeding to challenge the registration of a trademark as published in The Trademark Official Gazette.<sup>69</sup> Finally, a party may initiate a

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<sup>57</sup> U.S. PAT. & TRADEMARK OFF., TRADEMARK PROCESS, <https://www.uspto.gov/trademarks/basics/trademark-process>.

<sup>58</sup> *Id.*

<sup>59</sup> 15 U.S.C. § 1063.

<sup>60</sup> The likelihood of confusion is also the test for whether a party has engaged in trademark infringement against another’s mark and is decided by a multi-factor test. The TTAB and Federal Circuit use the factors set forth in *In re E. I. du Pont de Nemours & Co.*, but each circuit has its own multi-factor test. 476 F.2d 1357 (C.C.P.A. 1973).

<sup>61</sup> BEEBE, *supra* note 15, at 247.

<sup>62</sup> Lanham Act §§ 8–9, 15 U.S.C. §§ 1058–1059.

<sup>63</sup> This is an *ex parte* action because there is no claim of action between opposing parties—just a disagreement between an applicant and the PTO about whether a mark is registrable.

<sup>64</sup> Note that all *ex parte* TTAB and appellate hearings decide only whether a mark is registrable, not whether a party’s use of a mark infringes upon another party’s mark.

<sup>65</sup> U.S. PAT. & TRADEMARK OFF., *About The Trademark Trial and Appeal Board* (Feb. 21, 2019), <https://www.uspto.gov/trademarks/laws/trademark-trial-and-appeal-board>.

<sup>66</sup> *Id.*

<sup>67</sup> *Id.*

<sup>68</sup> *Id.*

<sup>69</sup> 15 U.S.C. § 1603; *see* MCCARTHY, *supra* note 11 at § 20.

cancellation proceeding with the TTAB in an attempt to invalidate and remove the existing trademark registration of another party from the register.<sup>70</sup>

If a party is unsatisfied with the TTAB's decision in an appeal, opposition, or cancellation proceeding, the party can either (1) appeal to the Federal Circuit—the Article III court with appellate jurisdiction over TTAB decisions—or (2) appeal to any federal district court.<sup>71</sup> There are two advantages of the district court route. First, the record in the case may be supplemented with additional evidence. Second, the district court's rulings may be appealed to its reviewing appellate court, thus making it possible to forum shop and avoid the Federal Circuit.<sup>72</sup>

## E. TRADE DRESS

In addition to protecting traditional trademarks, the Lanham Act also protects trade dress,<sup>73</sup> defined as “the appearance of a product when that appearance is used to identify a producer.”<sup>74</sup> The purpose of trade dress law is to prevent consumer confusion about the source of a product.<sup>75</sup> Trade dress refers to the overall visual features of a product, such as its size, shape, color, graphics, or configuration.<sup>76</sup> Courts generally divide trade dress into two categories: product design and product packaging.<sup>77</sup> Product packaging, such as the layout of a restaurant, may be inherently distinctive and therefore protectable without proof of secondary meaning.<sup>78</sup> Product design, by contrast, can never be inherently distinctive; to qualify for protection, the applicant or trademark holder must demonstrate that the design has acquired secondary meaning, meaning that consumers associate the design with a particular source.<sup>79</sup> To be protectable, trade dress features must function as source identifiers rather than as functional or purely aesthetic elements.<sup>80</sup> For example, Coca-Cola's contoured glass bottle is protectable because its distinctive

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<sup>70</sup> 15 U.S.C. § 1604.

<sup>71</sup> Lanham Act § 21, 15 U.S.C. § 1071.

<sup>72</sup> BEEBE, *supra* note 15, at 247.

<sup>73</sup> Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205, 209 (2000).

<sup>74</sup> Publ'ns Int'l, LTD. v. Landoll, Inc., 164 F.3d 337 (7th Cir. 1998).

<sup>75</sup> Jeff Resnick, *Trade Dress Law: The Conflicts Between Product Design and Product Packaging*, 24 WHITTIER L. REV. 253, 256 (2002); *see, e.g.*, PIM Brands Inc. v. Haribo of America Inc., 81 F.4th 317, 323 (3d Cir. 2023) (holding that the shape and color of PIM's watermelon-flavored candy made it functional because its trade dress resembled a watermelon appearance).

<sup>76</sup> Paula Mays, *Trade Dress*, 88 J. PAT. & TRADEMARK OFF. SOC'Y 392, 392 (2006).

<sup>77</sup> *Id.*

<sup>78</sup> *See* Two Pesos, Inc. v. Taco Cabana, Inc. 505 U.S. 763, 767 (1992) (holding that trade dress can be inherently distinctive); *see also* Samara Bros., 529 U.S. at 215 (explaining that the trade dress examined in *Two Pesos* qualifies as product packaging).

<sup>79</sup> Samara Bros., 529 U.S. at 216.

<sup>80</sup> For example, NBC's stylized peacock logo and three-note chime are registered marks, Registration No. 1,931,255, and Registration No. 0,916,522, respectively.

shape signals origin, whereas the flat bottom of the bottle is not, since it serves a utilitarian purpose.<sup>81</sup>

### III. RECENT DEVELOPMENTS IN THE FEDERAL CIRCUIT

#### A. *CURTIN V. UNITED TRADEMARK HOLDINGS, INC*

Early this year, in *Curtin v. United Trademark Holdings, Inc.*<sup>82</sup>, the Federal Circuit affirmed the TTAB decision that a consumer does not have statutory standing to oppose a trademark registration.<sup>83</sup> In this case, Professor Rebecca Curtin filed an opposition against United Trademark Holdings's ("UTH") registration for RAPUNZEL, in connection with a doll called Rapunzel with blonde hair.<sup>84</sup> Professor Curtin argued that the mark was descriptive, generic, failed to function as a trademark, and that there was fraud in the application.<sup>85</sup> Regarding the necessary injury to entitle one to oppose a trademark registration, Professor Curtin argued that UTH's registration of RAPUNZEL would proximately cause her an injury that entitled her to oppose the registration because "[she] and other consumers will be denied access to healthy marketplace competition for products that represent."<sup>86</sup> The TTAB applied the *Lexmark* framework to decide that Professor Curtin did not have statutory standing under section 1603 of the Lanham Act to oppose the registration.<sup>87</sup> The Federal Circuit affirmed the decision, stating that, as a consumer, Ms. Curtin failed to have the requisite interest or injury to confer statutory standing to challenge a trademark registration.<sup>88</sup>

The *Lexmark* framework determines standing with a two-prong analysis: Requiring that the plaintiff's interests are within the "zone of interest" protected by the statute and proximate cause of the plaintiff's injuries.<sup>89</sup>

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<sup>81</sup> See generally *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332 (C.C.P.A. 1982) (creating a four-factor test to determine whether trade dress is functional). The United States Court of Customs and Patent Appeals (C.C.P.A.) has since become the Court of Appeals for the Federal Circuit.

<sup>82</sup> 137 F.4th 1359 (Fed. Cir. 2025).

<sup>83</sup> *Id.* 1371-72.

<sup>84</sup> *Id.* at 1359-60.

<sup>85</sup> *Id.*

<sup>86</sup> *Id.* at 1363 (claiming that the RAPUNZEL mark for a common fairytale character increases market prices for goods associated with the Rapunzel character and chills creative development in the doll market, leading to fewer options for consumers).

<sup>87</sup> In her appeal, Professor. Curtin argued that the Board erred in applying the *Lexmark* framework, and even if the *Lexmark* framework is applied, she is entitled as a consumer to oppose UTH's registration under the Lanham Act. *Id.* at 1364 (citing *Lexmark Intern., Inc. v. Static Control Components, Inc.*, 572 U.S. 118 (2014)).

<sup>88</sup> *Id.*

<sup>89</sup> *Id.* at 1365.

First, the “zone of interest” refers to the interest that the governing law protects.<sup>90</sup> Here, the Federal Circuit clarified that the “zone of interest” for a particular provision should be determined by the specific grounds for the challenge, not a rule that assumes only commercial interests are served by any provision of the Lanham Act.<sup>91</sup> In a section 1603 opposition claim, the zone of interest should be determined by “the specific bases cited for opposing registration or seeking cancellation of the registration for a mark.”<sup>92</sup>

Second, the alleged injury must be proximately caused by the registration of the mark in order to constitute a violation of the statute.<sup>93</sup> The Federal Circuit affirmed the Board’s decision that the alleged injuries in this case were too derivative from the actual registration to prove proximate causation.<sup>94</sup> The Federal Circuit emphasized that proximate causation is not met when the plaintiff’s injuries are caused by actions or misfortunes of third parties.<sup>95</sup> Here, Professor Curtin alleges economic injury to consumers due to the chilling effect that registration will have on the doll marketplace.<sup>96</sup> The Federal Circuit rejected Professor Curtin’s assertion that an intervening step does not preclude finding proximate causation.<sup>97</sup> Instead, the Federal Circuit agreed with UTH that the injuries Professor Curtin asserts are “speculative tertiary results” from speculated effects on the market.<sup>98</sup> Therefore, the Federal Circuit affirmed the Board’s decision that Ms. Curtin failed to establish proximate cause, holding that the harms Professor Curtin alleged “are downstream harms first suffered by a commercial actor.”<sup>99</sup>

On October 3, 2025, Professor Curtin filed a petition for writ of certiorari, asking the U.S. Supreme Court to review the Federal Circuit’s ruling.<sup>100</sup> The question presented is “whether a party desiring to participate in an administrative agency proceeding, including a trademark opposition proceeding at the United States Patent and Trademark Office, must satisfy the zone-of-interests and proximate-causation tests set forth in *Lexmark* . . . .”<sup>101</sup>

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<sup>90</sup> The Supreme Court emphasized in *Lexmark* that “the breadth of the zone of interests varies according to the provisions of law at issue.” *Id.* at 1368

<sup>91</sup> *Curtin*, 137 F.4th at 1369 (declining to adopt UTH’s proposition that commercial interests are required to satisfy the zone of interest element, which they argued based on a broad interpretation of this court’s decision in *Corcamore*).

<sup>92</sup> *Id.* at

<sup>93</sup> *Id.* at 1365.

<sup>94</sup> *Id.* at 1370.

<sup>95</sup> *Id.*

<sup>96</sup> *Id.* at 1370-71 (emphasizing that Professor Curtin’s reliance on general economic theories to assume harm to the marketplace without any specific economic theory or evidence about how the fairytale market performs is insufficient to demonstrate a direct economic injury).

<sup>97</sup> *Id.* at 1371.

<sup>98</sup> “Ms. Curtin’s alleged harms are all, as UTH points out, ‘speculative tertiary effects of registration, namely, reduced marketplace competition, increased cost of RAPUNZEL merchandise, and fewer interpretations and creations of RAPUNZEL dolls.’” *Id.* (citing Appellee’s Br. 23.)

<sup>99</sup> *Id.*

<sup>100</sup> John L. Welch, *Professor Curtin Files Petition for Certiorari in RAPUNZEL Consumer Standing Case*, THE TTABLOG (Oct. 15, 2025), <https://thettablog.blogspot.com/2025/10/professor-curtin-files-petition-for.html>.

<sup>101</sup> *Id.*