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# Trademark Owner as Adverse Possessor: Productive Use and Property Acquisition

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## TRADEMARK OWNER AS ADVERSE POSSESSOR: PRODUCTIVE USE AND PROPERTY ACQUISITION

*Jake Linford*

# TRADEMARK OWNER AS ADVERSE POSSESSOR: PRODUCTIVE USE AND PROPERTY ACQUISITION

*Jake Linford*<sup>†</sup>

## ABSTRACT

There is an ongoing debate over whether or not a trademark is “property,” and what the appropriate boundaries of such a property right might be. Some scholars assert that rules and justifications developed to handle rights in real property are generally a poor fit for intellectual property regimes and for trademark protection in particular. Others respond that a unified theory of property should be able to account for both real and intellectual property. Neither approach fully recognizes that property regimes are multifaceted. A close look at the critical features of particular regimes can pay unexpected dividends.

This Article reveals how the process of trademark acquisition resembles, in startling ways, acquiring title to real property through adverse possession. Both the trademark and adverse possession regimes base acquisition on the productive use of the property in question. This productive use must be sufficient to provide notice of the asserted

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property right to the public and competing claimants. A properly functioning productive use regime is valuable because such a regime is more likely to encourage an efficient initial allocation of property rights while also providing fairness-based limits on the scope of property rights. Recognizing the productive use structure in both regimes provides several significant insights. First, the productive use structure highlights the importance of the commercial strength inquiry as a use-based limitation on the scope of protection even for inherently distinctive marks. Second, the productive use structure also clarifies how and why rights in the trademark commons are more active and property-like than rights held in common over expired patents and copyrights. Third, comparing the regimes shows how adverse possession is, surprisingly, a more hard-edged or “crystalline” property regime than the relatively “muddy” trademark regime. Finally, this analysis inspires interventions for trademark and adverse possession law to bring them more in line with the productive use requirement, and to open space for public use and competition.

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## INTRODUCTION

In longstanding tradition, American courts have analogized trademark protection to property rights developed at common law.<sup>1</sup> The question of whether they *should* do so has recently preoccupied the legal academy,<sup>2</sup> part of a larger debate about whether it is proper to view intellectual property through a real property lens and whether comparing intellectual property regimes to real property regimes gets us anywhere. Mark Lemley has led the charge in arguing that intellectual property is *sui generis*, with unique characteristics that make it unnecessary to “turn to some broader area of legal theory to seek legitimacy.”<sup>3</sup> Under this *sui generis* framework, it is useless to apply “inapposite economic analysis borrowed from the very different case of land” to intellectual property.<sup>4</sup> Scholars like John Duffy, by contrast, argue that identifying a “unified theory of property—one broad enough to account for the similarities *and differences* among species of property as diverse as Blackacre and patents—promises to increase rather than to diminish our understanding of property and intellectual property.”<sup>5</sup> Neither approach explicitly recognizes that

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1. *See, e.g.*, Trade-Mark Cases, 100 U.S. 82, 92 (1879) (“The right to adopt and use a symbol or a device to distinguish the goods or property made or sold by the person whose mark it is, to the exclusion of use by all other persons, has long been recognized by the common law . . . . It is a property right for the violation of which damages may be recovered in an action at law . . . .”).
  2. Mark A. Lemley, *Property, Intellectual Property, and Free Riding*, 83 TEX. L. REV. 1031, 1042 (2005) [hereinafter Lemley, *Free Riding*] (“Trademark law, which was once limited to protecting against consumer confusion, has increasingly taken on the character of a property right, with the result that trademark ‘owners’ now have the power to prevent various kinds of uses of their marks, regardless of whether consumers will be confused or search costs increased.”). *But see* Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1848 (2007) (“American courts from the very beginning protected producers from illegitimate diversions of their trade by recognizing property rights.”).
  3. Lemley, *Free Riding*, *supra* note 2, at 1075.
  4. *Id.* More specifically, Lemley has argued that if intellectual property is a coherent category, trademark protection falls outside it. Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1695 (1999) [hereinafter Lemley, *Lanham Act*] (“Even if one accepts [that patents and copyrights are analogous to real property], it does not carry over to trademarks. The justifications for trademark law are different from those for other forms of intellectual property.” (footnote omitted)).
  5. John F. Duffy, Comment, *Intellectual Property Isolationism and the Average Cost Thesis*, 83 TEX. L. REV. 1077, 1078 (2005). Some see the comparison between intellectual property and real property as a means

real property regimes are multifaceted. Valuable results are more likely when we compare the “right” real property regime to the “right” intellectual property regime—when the regimes compared share not only similar structures but similar policy justifications.

For example, one of the problems in analogizing trademark acquisition to rights in real property is that trademark acquisition, as it developed in the common law, is not a pure first-in-time regime. Instead, acquiring a trademark requires productive use of a given word, symbol, or other identifier as a trademark—a source signifier. Such use is generally not necessary to acquire rights in real property, with at least one important exception: adverse possession is also a regime with a productive use requirement.<sup>6</sup> As this Article argues, the parallels between acquiring real property through adverse possession and acquiring rights to the exclusive use of trademarks are substantial and instructive: both doctrinal regimes manifest a purpose to provide notice to the public and competing claimants through productive use.

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to expand intellectual property protections, while others see it as providing a rationale for constraining them. Compare Lemley, *Lanham Act*, *supra* note 4, at 1697 (“Courts seem to be replacing the traditional rationale for trademark law with a conception of trademarks as property rights, in which trademark ‘owners’ are given strong rights over the marks without much regard for the social costs of such rights.”), with David Fagundes, *Property Rhetoric and the Public Domain*, 94 MINN. L. REV. 652, 657 (2010) (asserting that property rhetoric can “explicitly present public entitlements in information as a subject of [collective or public] ownership” to “provide[] needed pushback against the powerful but overly broad claims of rights in information that are commonly made” regarding copyright).

6. A handful of cases and scholars have compared trademark ownership and adverse possession in three more limited ways. First, courts in the early part of the twentieth century compared the junior user’s laches defense—that the plaintiff “slept on his rights” for too long and now cannot enforce them—to an adverse possession defense against an ejectment claim. See, e.g., *Anheuser-Busch, Inc. v. Du Bois Brewing Co.*, 175 F.2d 370, 374 (3d Cir. 1949). But see *infra* note 177 (discussing problems with the analogy between a junior user and an adverse possessor). Second, scholars have suggested in passing that the trademark owner takes a defensive posture against encroachment similar to that taken by a real property owner to forestall adverse possession. See, e.g., Laura A. Heymann, *The Grammar of Trademarks*, 14 LEWIS & CLARK L. REV. 1313, 1318 (2010) (describing trademark enforcement as “akin to thwarting adverse possession” in that the trademark “must be defended against any and all encroachments”). Finally, the acquisition of an incontestable registration, which can occur after five consecutive years of continuous use of a registered trademark, has been likened to adverse possession, due to its temporal component, but criticized as otherwise lacking. See, e.g., Suman Naresh, *Incontestability and Rights in Descriptive Trademarks*, 53 U. CHI. L. REV. 953, 982–85 (1986). While these comparisons are apt, they miss the larger picture.

This productive use is in turn notice providing,<sup>7</sup> meaning generating,<sup>8</sup> boundary setting,<sup>9</sup> abuse limiting,<sup>10</sup> and value creating.<sup>11</sup>

A productive use requirement is desirable in both regimes for three interlocking reasons. First, requiring productive use makes it more likely that the initial allotment of property rights is more efficient than other potential allocations.<sup>12</sup> Second, productive use provides a fairness-based limitation on the scope of property rights, making sure both that the initial possessor has done something to merit the property right and allowing for necessary reallocation when the productive use of a subsequent claimant outstrips the productive use of the initial claimant.<sup>13</sup> Third, productive use regimes are communicative and information forcing, delineating the boundaries of the property right at issue. Property seekers, competing claimants, and the public all receive notice from and provide notice to one another in regimes that require productive use.<sup>14</sup>

Part I of this Article discusses the main similarities between the trademark and adverse possession regimes. Part I.D explains how the acquisition of rights in descriptive marks most clearly resembles adverse possession. Part II.A explains how the rights in inherently distinctive marks are *also* dependent on productive use. Part II.B clears up the hostility misnomer that has crept into claim of right analysis in adverse possession doctrine, while Part II.C explains how the comparison to adverse possession's exclusivity requirement helps circumscribe the rights acquired by the trademark owner. Part III discusses the role played by productive public use in the creation and expiration of trademark rights. Part IV focuses on several critical differences between the regimes to highlight how adverse possession is, surprisingly, a more hard-edged or "crystalline" property regime—in the sense first used by Carol Rose<sup>15</sup>—than the relatively "muddy" trademark regime. Recognizing the central importance of productive use highlights how both regimes have gone strayed from their productive use foundations. Part V recommends interventions to bring them back in line.

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7. See *infra* Part I.

8. See *infra* Parts II.A, III; notes 30–35 and accompanying text.

9. See *infra* notes 95–96, 135–136 and accompanying text.

10. See *infra* notes 235–237 and accompanying text.

11. See *infra* notes 216–24, 281–82, and accompanying text.

12. See *infra* Part IV.C; notes 53–54 and accompanying text.

13. See *infra* Parts II.A, IV.A; notes 62–63, 76 and accompanying text.

14. See *infra* Parts I, III, V.A.

15. Carol Rose labeled imprecise or fuzzy property regimes as "muddy," compared with clearer "crystalline" property regimes. Carol M. Rose, *Crystals and Mud in Property Law*, 40 STAN. L. REV. 577, 577–80 (1988) [hereinafter Rose, *Crystals*].

## I. THE NOTICE FUNCTION OF PRODUCTIVE USE

Adverse possession and the law protecting trademarks are property regimes that are more similar than one might at first imagine. At their core, trademark law and adverse possession are both communicative regimes, but that communication with the public, competitors, and other potential claimants is carried out via productive use of the property at issue. Bringing the property to productive use is valuable because the use itself provides an indication of the boundaries of the property, and simultaneously requires some evidence that the claimant has acted openly, as an owner should.

For example, the adverse possessor who operates under color of title or puts a fence around the property provides information about how she values the property and indicates that she has gone to some length in signaling that interest to the record owner and other competitors for the property. Initial steps like fencing lead to a transfer of title, however, only when the adverse possessor also engages in continuous and exclusive use over time.<sup>16</sup> She must act like an owner, and persistently doing so leads the public to treat her like one. Adverse possession is also information forcing.<sup>17</sup> By entering the property and subjecting it to use, the adverse possessor puts the record owner on notice that there are competing claims to the property, and the record owner should step in to clarify the boundaries of the property, or risk losing her claim.

Like adverse possession, trademark use is also communicative and information forcing. Consumers come to understand the scope of the mark owner's claim as the mark is used in commerce to designate goods and services from a consistent source. Competitors are also notified of the trademark owner's claim through her productive use.<sup>18</sup>

This Part describes these similarities in more detail. Part I.A briefly describes the trademark and adverse possession regimes. Part I.B compares aspects of the trademark and adverse possession regimes that require actual, open, and notorious possession from the respective claimants and summarizes the traditional justifications for trademark ownership and adverse possession in light of the productive use requirement. Part I.C describes how trademark registration acts like

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16. See *infra* Part I.C.

17. See Carol M. Rose, *Possession as the Origin of Property*, 52 U. CHI. L. REV. 73, 78–79 (1985) [hereinafter Rose, *Possession*] (discussing how possession of property requires communication by the original claimant to others who may be interested in the property, lest he lose it to those individuals through adverse possession); see also Abraham Bell & Gideon Parchomovsky, *Pliability Rules*, 101 MICH. L. REV. 1, 57 (2002) (noting the desirable effects of information forcing with the “dual functions of ‘quieting titles’ and facilitating transactions”).

18. See *infra* note 65 and accompanying text.



color of title or fencing the property—incentivizing activity that enhances notice to the public without stripping the productive use requirement. Part I.D analyzes in detail the similarities between the continuous use requirement in adverse possession and the acquired distinctiveness requirement in trademark law.

A. *The Basics of Adverse Possession and Trademark Acquisition*

As a matter of black letter law, there are five elements of a successful adverse possession claim, and each element manifests an aspect of the notice function of productive use. First, there must be *actual* entry.<sup>19</sup> The adverse possessor can generally claim only so much land as was possessed and converted to use.<sup>20</sup> Second, the use must be *notorious*—something the reasonably attentive landowner would notice if she were paying attention.<sup>21</sup> Third, the adverse possessor must engage in *exclusive* possession of the property.<sup>22</sup> Fourth, that possession must be under *claim of right*, or in other words, without permission.<sup>23</sup> Fifth and finally, each state prescribes by statute the amount of time for which the adverse possessor must *continuously* possess the property, without ejectment, in order to secure title.<sup>24</sup> If the adverse possessor successfully engages in exclusive use of the property for the statutory period, she can quiet title, or in the alternative, prevail against an action for ejectment by the title owner.<sup>25</sup>

Trademark acquisition also hinges on notice-providing productive use. The right to use a trademark exclusively is obtained, under the U.S. system, but not through mere initial adoption.<sup>26</sup> Instead, the

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19. See *infra* Part I.B.
  20. JOSEPH WILLIAM SINGER, INTRODUCTION TO PROPERTY § 4.2.1, at 146 (2d ed. 2005).
  21. 8 RICHARD R. POWELL, POWELL ON REAL PROPERTY § P6.08[3][c] (Michael Allen Wolf ed., 2012) (stating, as a matter of public policy, “the owner should not lose his or her land without some reasonable warning that should have made the owner aware that adverse possession was occurring”).
  22. See discussion *infra* Part II.C.
  23. See discussion *infra* Part II.B.
  24. For example, California has a five-year statutory window, CAL. CIV. PROC. CODE §§ 321, 322 (West 2006), while Iowa requires continuous possession for forty years. IOWA CODE § 614.31 (2013). This Article primarily compares U.S. trademark law with the adverse possession regimes in the various states.
  25. R.H. Helmholz, *More on Subjective Intent: A Response to Professor Cunningham*, 64 WASH. U. L.Q. 65, 67 n.6 (1986) (“[T]he requirements for gaining title by adverse possession do not vary according to the form of [the] action.”).
  26. Trade-Mark Cases, 100 U.S. 82, 94 (1879) (“[T]he exclusive right to [a trademark] grows out of its *use*, and not its mere adoption.”).

trademark owner establishes her rights through the use of a given word or symbol to designate a source for goods or services.<sup>27</sup> This productive use infuses the mark with communicative value.<sup>28</sup>

Trademarks are often grouped into categories, based on the initial suitability of the word or symbol chosen for trademark protection. Some words are seen as inherently distinctive—inherently capable of carrying trademark meaning—because the word chosen is not directly related to the product or service offered for sale. For inherently distinctive marks—like XEROX, a fanciful mark for photocopiers, APPLE, an arbitrary mark for computers, and GLEEM, a suggestive mark for toothpaste—federal trademark protection is granted automatically upon “the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.”<sup>29</sup>

Other words are more descriptive of the product. For these descriptive terms, initial use of a descriptive mark—like SEALTIGHT for self-sealing fasteners—secures no priority over other users of identical or similar marks until the descriptive term acquires distinctiveness.<sup>30</sup> Descriptive terms do not initially signal source, so significance to consumers, “secondary meaning” or “acquired distinctiveness,” must be developed.<sup>31</sup> For example, a term like TASTY for apples describes a characteristic of the goods sold, and is

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27. Any given word or symbol can have many meanings. Linguists refer to a particular meaning of a word as a lexeme. One string of letters (or sounds), like “delta,” can have multiple meanings: the fourth letter of the Greek alphabet; the triangle-shaped “tract of alluvial land enclosed and traversed by the diverging mouths of the Nile”; or an arrangement of three electrical windings. 4 OXFORD ENGLISH DICTIONARY 426 (2d ed. 1989). Each meaning is a lexeme. Different trademarks can be derived from the same string of letters or sounds, like “DELTA,” for airlines; faucets; or fine writing instruments. Thus, the use of a preexisting word or symbol as a mark creates a new meaning for that word or symbol in its use as a mark. Each use of a word or symbol as a mark to signify goods or services from a particular source creates a new “trademark lexeme.” *See infra* Part II.C.
  28. Kenneth J. Vandeveld, *The New Property of the Nineteenth Century: The Development of the Modern Concept of Property*, 29 BUFF. L. REV. 325, 345 (1980).
  29. 15 U.S.C. § 1127 (2006) (defining “use in commerce”). *See also* 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 16:8 (4th ed. 2007) (noting that the definition of “use” was changed to “require a greater degree of activity”). The provisions codifying federal trademark protection are commonly known as the Lanham Act.
  30. *See, e.g.*, Calvin Klein Co. v. Farah Mfg. Co., 229 U.S.P.Q. (BNA) 795, 803 (S.D.N.Y. 1985) (discussing the importance that a trademark is “truly distinctive” to support a cause of action).
  31. *See* 2 MCCARTHY, *supra* note 29, § 15:10 (noting the use of “‘acquired distinctiveness’ as a synonym for secondary meaning”).

thus merely descriptive and unprotectable until the TASTY mark acquires secondary meaning, that is, until consumers come to interpret the mark as a designation of the source of the apples sold under the mark.<sup>32</sup>

Productive use of a descriptive mark builds secondary meaning, but productive use is required to develop commercial strength in any mark.<sup>33</sup> Thus, even an inherently distinctive mark must be consistently and continually used in commerce or the mark may be deemed effectively unenforceable, if not outright abandoned.<sup>34</sup> A failure to use the mark in commerce will result in the mark falling into the public domain for subsequent appropriation by another for trademark use.<sup>35</sup>

Some terms can never be protected as trademarks. A term that a court concludes is *ex ante* generic for the genus of goods or services, like COMPUTER for computers, may never be transformed into a trademark, even if consumers should come to associate the generic terms with a particular good or service from a particular source.<sup>36</sup>

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32. Professor McCarthy divides marks into those business symbols that are inherently distinctive and those that are not. He refers to the latter category as “secondary meaning marks.” *See, e.g., id.* § 16:34. As this Article describes in more detail in Part II.A, there is little real difference between the commercial strength required to enforce even inherently distinctive marks and the secondary meaning required to show a descriptive term has become enforceable. Thus, while the term “descriptive mark” is something of a misnomer, this Article uses it as a placeholder for “secondary meaning mark” or the more accurate but fatally unwieldy “descriptive term that has acquired distinctiveness.”
33. *See infra* Part II.A. *But see* Mark A. Lemley & Mark P. McKenna, *Owning Mark(et)s*, 109 MICH. L. REV. 137, 182–83 (2010) (criticizing natural rights theories for basing trademark rights on productive use as divorced from the market in which the owner offers goods under the mark).
34. *See* 15 U.S.C. § 1127 (defining “abandonment”); *Exxon Corp. v. Humble Exploration Co.*, 695 F.2d 96, 100 (5th Cir. 1983) (discussing the requirement of continued use of a mark under the Lanham Act to “avoid a finding of abandonment”); 2 MCCARTHY, *supra* note 29, § 16:9 (“Prior and continuous usage is required.”).
35. Professor McCarthy describes the public domain as follows: “[P]ublic domain’ is the status of an invention, creative work, commercial symbol, or any other creation that is not protected by any form of intellectual property. Public domain is the rule: intellectual property is the exception.” 1 MCCARTHY, *supra* note 29, § 1.2 (quoting J. THOMAS MCCARTHY, MCCARTHY’S DESK ENCYCLOPEDIA OF INTELLECTUAL PROPERTY 354 (2d. ed. 1995)).
36. *See Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (holding that generic terms “cannot [be] transform[ed] . . . into a subject for trademark”); *see also infra* Part IV.A. In addition, a source-signifying mark can become generic *ex post* if its primary significance to the public shifts to indicate the genus of goods or services, rather than signifying a source of particular goods or services. *See infra* Part III.

A trademark owner may successfully enjoin the use of the mark by a junior user, where the owner can establish the new use is likely to confuse consumers. Injunctive relief is common; damages are less so.<sup>37</sup> And while use in commerce is the means to acquire rights in a trademark, the scope of what is protected is determined only in comparison to the use engaged in by others. The scope of protection is often fully defined only in litigating the question of likelihood of confusion, where courts apply a “muddy” multifactor test.<sup>38</sup>

There are three key commonalities in the trademark acquisition and adverse possession regimes. First, both regimes require the acquiring property owner to engage in productive use of the property at issue. Second, in both regimes, that productive use fulfills a notice function that informs record owners, competitors, and the public about the scope of the asserted claim. Third, both regimes are concerned with the relative or comparative value of asserted rights. While trademark acquisition looks like a first-in-time property regime, the mark owner must establish rights against other comers via use in commerce.<sup>39</sup> Being first to adopt a mark is not enough.<sup>40</sup> With the exception of fanciful marks, every trademark is drawn from words or symbols with preexistent meaning, to which the public and competitors have varying claims.<sup>41</sup> And while adverse possession is a means of property reallocation, there are important similarities between the requirements an adverse possessor must meet to acquire property from a title owner and the productive labor that justifies property ownership.<sup>42</sup> Like the trademark owner, the adverse

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37. For example, while damages for past infringement are waived where the defendant raises a successful laches defense, injunctive relief will only be barred if the plaintiff is guilty of “gross laches.” *Univ. of Pittsburgh v. Champion Prods., Inc.*, 686 F.2d 1040, 1044–45 (3d Cir. 1982). A junior user who engages in the productive use necessary to develop trademark rights can thus earn immunity to a future claim by senior user if the use is tolerated for too long. *Anheuser-Busch, Inc. v. Du Bois Brewing Co.*, 175 F.2d 370, 374 (3d Cir. 1949). Nevertheless, the junior trademark user cannot entirely deprive the senior user of her rights in the mark, no matter the relative value of their respective uses. *See also infra* note 177.

38. *See, e.g.*, Joseph P. Liu, *Two-Factor Fair Use?*, 31 COLUM. J.L. & ARTS 571, 574–75 (2008) (presenting the multifactor likelihood-of-confusion test used to determine trademark infringement as an exemplar of the typical difficulty of determining which if any factors are dispositive and how they should be weighed).

39. *See infra* Parts I.D, II.A.

40. *See Trade-Mark Cases*, 100 U.S. 82, 94 (1879) (“[T]he exclusive right to [a trademark] grows out of its *use*, and not its mere adoption.”).

41. *See infra* Part III.

42. *See generally* Eric R. Claeys, *Locke Unlocked: Productive Use in Trespass, Adverse Possession, and Labor Theory* 53 (George Mason Univ. Law. & Econ. Research. Paper Series, Paper No. 12-21, 2012),

possessor must signal her claim not only to the title owner, but to the entire world.<sup>43</sup>

The similarities between the adverse possession and trademark acquisition regimes are most apparent when comparing adverse possession's requirements of actual entry, open and notorious possession, and continuous use with similar requirements in trademark law. As developed in the next two subparts, these similarities highlight how both regimes base the acquisition of property rights on productive use that communicates the property claim to the public and potential competitors.

*B. The Notice Function of Open and Notorious Possession*

In order to claim real property through adverse possession, there must be actual entry, that is to say, "the possessor must physically occupy the premises in some manner."<sup>44</sup> Adverse possession must not only be actual, but also open and notorious. Such use provides notice to the record owner sufficient to ascertain whether she values the property as much as the possessor does.<sup>45</sup> Failing to notice open and notorious adverse possession is a signal that the record owner holds the property in somewhat lower esteem than the possessor, or at least that her need for it is less immediate. Generally, courts look to the typical use to which property of that type is put.<sup>46</sup> Where the adverse possessor occupies part of a pre-existing parcel, she will generally prevail in claiming title only to the part of the parcel where productive use takes place.<sup>47</sup>

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*available at* <http://ssrn.com/abstract=1759551> (noting that productive labor theory conditions property ownership on "a responsibility to 'enjoy' " and make use of the property).

43. See *Pillow v. Roberts*, 54 U.S. (13 How.) 472, 477 (1851) ("[C]olor of title . . . has always been received as evidence that the person in possession claims for himself, and of course, adversely to all the world.").
44. SINGER, *supra* note 20, § 4.2.1, at 145.
45. See EDUARDO MOISÉS PEÑALVER & SONIA K. KATYAL, PROPERTY OUTLAWS 129 (2010) (noting that, in adverse possession, the law infers that "the lawbreaker places a higher value on property than its true owner does"); Rose, *Possession*, *supra* note 17, at 80–81 (noting that the burden of correcting the misapprehension of the adverse possessor falls on the actual owner).
46. See, e.g., *Smith v. Hayden*, 772 P.2d 47, 55 (Colo. 1989) (in banc) ("[A]ctual occupancy means the ordinary use to which the land is capable and such as an owner would make of it." (quoting *Anderson v. Cold Spring Tungsten, Inc.*, 458 P.2d 756, 759 (Colo. 1969))).
47. *Crowley v. Whitesell*, 702 S.W.2d 127, 128 (Mo. Ct. App. 1985) (typically, adverse possessors "must prove actual possession of the entire tract").

Adverse possession of real property is typically justified on one of three interlocking grounds: settling claims,<sup>48</sup> the demerit of the title owner,<sup>49</sup> and the merit of the adverse possessor.<sup>50</sup> While the claim-settling justification operates like a statute of limitations to bring finality to property disputes, the demerit and merit rationales seek to justify the actual transfer of title from the record owner to the adverse possessor. The merit rationale has historically been seen as the weakest of the three justifications for adverse possession,<sup>51</sup> but recognizing the notice function of productive use at the core of adverse possession reaffirms the importance of the merit rationale.

The English common law discounted the merit of the adverse possessor,<sup>52</sup> but it cannot be the case that the demerit of the property owner is sufficient justification for the transfer of title. If the law merely sought to dispossess inattentive record owners, an abandonment regime would work just as well.<sup>53</sup> Such a regime could properly consider the evidence that the record owner failed to secure the property or otherwise put it to reasonably productive use in the community.

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48. Henry W. Ballantine, *Title by Adverse Possession*, 32 HARV. L. REV. 135, 135 (1918) (arguing that adverse possession has no goal of rewarding the diligent trespasser or penalizing the sleeping owner but that “the great purpose” is simply to quiet title, prove meritorious titles, and correct conveyancing errors).
  49. See Lee Anne Fennell, *Efficient Trespass: The Case for “Bad Faith” Adverse Possession*, 100 NW. U. L. REV. 1037, 1059 (2006) (noting that a purpose of adverse possession is to prod “the sleeping owner” or reward “the productive possessor”); Claeys, *supra* note 42, at 53 (noting that “demerit” asks whether the owner is disentitled because his moral interest expires, or because others divest his continuing claim).
  50. See Claeys, *supra* note 42, at 53 (suggesting that Locke’s property theory is best described as a theory of property rights secured through productive labor). Admittedly, this productive use can be met in part by delineating boundaries in a way that discloses their existence to others who might be interested in the property. See Rose, *Possession*, *supra* note 17, at 88.
  51. Thomas Merrill, for example, criticizes what he sees as the four major permutations of the reliance-based merit rationale—preserving the peace, honoring the adverse possessor’s personal attachment to property as part of her identity, a sunk-cost or quasi-rents rationale grounded in forestalling ambush and holdout by the record owner, and reliance of the public on the adverse possessor’s apparent ownership—because none of them actually justify transferring the property to the adverse possessor. Thomas W. Merrill, *Property Rules, Liability Rules, and Adverse Possession*, 79 NW. U. L. REV. 1122, 1131–32 (1985).
  52. Ballantine, *supra* note 48, at 135.
  53. See Lior Jacob Strahilevitz, *The Right to Abandon*, 158 U. PA. L. REV. 355, 415–19 (2010) (arguing that it is nearly impossible to reason why bad-faith adverse possession should be permitted while abandonment of real property is prohibited).

Where the demerit of the record owner was significant, the property would fall back to the public domain to be claimed again via auction, capture, or some other possessory act. An auction of this sort can be wasteful, however, as potential claimants hoping to win the race will be willing to expend resources up to their best estimation of the value of the property, resulting in a total expenditure of resources greater than the value of the property in the hands of any potential victorious claimant.<sup>54</sup> Adverse possession avoids the inefficient race to claim the abandoned property by weighing the record owner's demerit against the possessor's merit and making the transfer only where the relative weight justifies the shift.

The requirements that possession be actual, open, and continuous are arguably grounded in the desire to provide the record owner with sufficient notice of the threat to her property right. Thus, only the truly disinterested or inattentive property owner loses title, which helps the public discern which record owners might "demerit"—or deserve to lose—the property.<sup>55</sup> The merit rationale has been seen alternately as grounded in the psychological attachment of the adverse possessor to the property,<sup>56</sup> or in the labor performed in

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54. See William M. Landes & Richard A. Posner, *The Economics of Trademark Law*, 78 TRADEMARK REP. 267, 280 (1988) (arguing that a use-driven first possession regime minimizes rent-seeking, and comparing the U.S. system favorably to the Japanese system, where the pure registration system permits the "banking" of trademarks); see also Joseph P. Liu, *Legitimacy and Authority in Internet Coordination: A Domain Name Case Study*, 74 IND. L.J. 587, 607 (1999) (describing the domain name allocation system as an inefficient "pure registration system" that "gives rise to wasteful 'rent seeking' and 'gold rushes,' as parties compete to lock up potentially valuable domain names, without any thought of productive use"). This Article contrasts the trademark and domain-name regimes in more detail in Part IV.C.

55. Of course, even unproductive squatting could provide notice to the owner that someone hoped to obtain possession over the land. Larissa Katz notes, however, that under the inconsistent use test applied in Canadian law, only the possessor who puts the property to *different* use than the owner can secure through adverse possession. Larissa Katz, *The Moral Paradox of Adverse Possession: Sovereignty and Revolution in Property Law*, 55 MCGILL L.J. 47, 65 (2010).

56. See Michael A. Carrier, *Cabining Intellectual Property Through a Property Paradigm*, 54 DUKE L.J. 1, 54 n.224 (2004) ("Adverse possession, for example, reflects not only a utilitarian conception of robust land development but also personhood and labor theories: an adverse possessor identifies more directly with the land than does its absentee owner (personhood) and has a Lockean claim based on development of the land (labor)."); O.W. Holmes, *The Path of the Law*, 10 HARV. L. REV. 457, 477 (1897) ("A thing which you have enjoyed and used as your own for a long time . . . takes root in your being and cannot be torn away without your resenting the act and trying to defend yourself, however you came by it.").

exercising exclusive control over the property,<sup>57</sup> but neither version of the attachment or labor the rationale fully realize the social value provided by the adverse possessor.

While the adverse possession factors are traditionally understood to inquire whether the adverse possessor provides a sufficiently clear signal about her claim to the inattentive record owner, successful adverse possession also provides an important signal to the public. Carol Rose argues that possession is communicative, a “statement” providing “notice to the world through a clear act.”<sup>58</sup> Thus, some of the value of adverse possession stems from its ability to communicate a claim of right to the public. Proper or “suitable” use—the type of use typical of an owner—provides notice to the public that the user wishes to interact with society as an owner.<sup>59</sup> Rose posits that the transfer of property is justified on notice grounds when the record owner fails to eject or locate the adverse possessor. The record owner “fails to correct misleading appearances” while the adverse possessor “speaks loudly and clearly.”<sup>60</sup> The information-forcing role played by the adverse possessor can lower transaction costs because it allows the public to “rely upon their own reasonable perceptions.”<sup>61</sup>

Eduardo Peñalver and Sonia Katyal suggest that adverse possession is justified precisely because the adverse possessor’s willingness to possess the property, in the face of possible dispossession

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57. See JOHN LOCKE, TWO TREATISES OF GOVERNMENT 305–09 (Peter Laslett ed., 2d ed., Cambridge Univ. Press 1967) (1690) (explaining that one’s labor undertaken to annex and exclude others from the common state of nature and the appropriation one makes to himself results in a claim to property); Carrier, *supra* note 56, at 54 n.224 (noting that adverse possession reflects notions of land development and labor theories); Claeys, *supra* note 42, at 53 (noting that productive labor theory conditions property ownership on a responsibility to make use of the land).

58. Rose, *Possession*, *supra* note 17, at 77.

59. *Id.* at 78.

60. *Id.* at 80.

61. *Id.*; see also *id.* at 79 (“[Adverse possession] might be designed . . . to require the owner to assert her right publicly. It requires her to make it clear that she, and not the trespasser, is the person to deal with if anyone should wish to buy the property or use some portion of it.”). Thus, while the use required of an adverse possessor is merely use consistent with the character of the property and its location, Strahilevitz, *supra* note 53, at 417, the use is important because of its relative value, compared to the use of the record owner. Likewise, Rose reads the famous fox capture case, *Pierson v. Post*, as an instance where possession itself is a communicative “clear act.” Rose, *Possession*, *supra* note 17, at 77 (citing *Pierson v. Post*, 3 Cai. 175 (N.Y. Sup. Ct. 1805)). Rose sees in *Pierson* a merger of Lockean labor and Blackstonian first entry. The capturing owner *both* adds value to or mixes labor with the captured property *and* signals to the public its claim to the property. *Id.*



before the end of the statutory period—as well as criminal and civil sanctions for trespass—signals that she highly values the property.<sup>62</sup> On the other hand, the record owner’s failure to take action against the adverse possessor within the statutory period signals the low value she places on the property.<sup>63</sup>

Thus, adverse possession signals the *comparative* value that record owner and adverse possessor place on the property. Because the record owner has some trappings of notice, the record owner retains title merely by policing her boundaries and challenging encroachers. This is sufficient to send a clear signal of the property’s value. The adverse possessor must do more, engaging in some level of perceptible productive use not required by a record owner. This use signals to the public not only that the adverse possessor values the property, but that society should value the use to which the adverse possessor puts the property, or in the alternative, value the adverse possessor as a transaction party with regard to said property.

The productive use requirement in trademark law serves similar functions, and stems from similar policy concerns. Consistent with the common law origins of trademark protection, trademark rights can be secured without any registration whatsoever and enforced as a matter of federal law.<sup>64</sup> The productive use of the trademark in commerce defines the scope of the mark owner’s property right and provides a notice function similar to that provided by open and notorious use requirement in adverse possession.<sup>65</sup> As Judge Easterbrook noted in

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62. PEÑALVER & KATYAL, *supra* note 45, at 128–29 (citing Fennell, *supra* note 49, at 1040); *see also* Claeys, *supra* note 42, at 54 (noting that in the adverse possession context, under the Lockean labor theory, “[t]he encroacher’s long occupancy is a simple and reliable proxy for her future productive use—just as a first-possessor’s occupancy is in relation to [previously] unowned land”).

63. PEÑALVER & KATYAL, *supra* note 45, at 129. Peñalver & Katyal go on to argue that the law should also allow a high-value possessor to secure property where there is evidence of that high valuation and an absence of evidence about the owner’s valuation. *Id.* Claeys concurs from a Lockean perspective, noting that the silence of the record owner “provides objective proof that his interest in the land is not really that strong.” Claeys, *supra* note 42, at 55.

64. *See* 15 U.S.C. § 1125(a) (2006) (setting forth a right of civil action for false designations of origin and false or misleading representations and descriptions).

65. *See* Zazú Designs v. L’Oréal, S.A., 979 F.2d 499, 503 (7th Cir. 1992) (noting that nationwide rights to a trademark are based on market saturation capable of putting other producers on notice of the mark’s use); *see also* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 18 cmt. a (1995) (“Actual use by the claimant also furnishes public notice of the user’s potential rights in the designation.”); Graeme B. Dinwoodie & Mark D. Janis, *Confusion Over Use: Contextualism in Trademark Law*, 92 IOWA L. REV. 1597, 1612 n.63 (2007) [hereinafter Dinwoodie &

the case of *Zazú Designs v. L'Oréal, S.A.*, “Only active use allows consumers to associate a mark with particular goods and notifies other firms that the mark is so associated.”<sup>66</sup> The obligation to use the mark in commerce is, in part, a requirement that the trademark owner’s attempted possession occur with sufficient visibility to put both potential competitors and the public on notice. Goods need not be offered for sale initially, so long as analogous use, like pre-sales publicity, is open and notorious,<sup>67</sup> that is, sufficient to “popularize [the mark] in the public mind,”<sup>68</sup> and followed by bona fide use.<sup>69</sup> Thus, a mark owner’s property right is recognized only when she can establish use sufficient to secure secondary meaning or commercial strength. Without such a showing, she cannot enforce her rights against an alleged infringing user.

The dominant justification for trademark rights has been an economic rationale: trademark protection is arguably designed to reduce consumer search costs and provide an incentive to the mark owner to provide goods and services of consistent quality, by allowing the mark owner to protect the mark as a unique signifier of that quality.<sup>70</sup> In addition to lowering search costs, trademark protection serves a correlative function of protecting the public from deceit or fraud by providing a remedy against confusing misappropriation of trademarks.<sup>71</sup> Mark owners are incentivized to maintain a consistent

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Janis, *Contextualism*] (noting that the use requirement serves a public notice function); Graeme B. Dinwoodie & Mark D. Janis, *Use, Intent to Use and Registration in the USA*, in TRADE MARK USE 313, 315 (Jeremy Phillips & Ilanah Simon eds., 2005) (noting that the use requirement serves as a mechanism to put the public on notice).

66. *L'Oréal*, 979 F.2d at 503.
67. *Sterling Drug Inc. v. Knoll A.-G. Chemische Fabriken*, 159 U.S.P.Q. (BNA) 628, 631 (T.T.A.B. 1968) (“To acquire trademark rights there has to be an ‘open’ use, that is to say, a use has to be made to the relevant class of purchasers or prospective purchasers . . .”).
68. *Am. Express Co. v. Goetz*, 515 F.3d 156, 162 (2d Cir. 2008) (per curiam) (quoting *Hous. & Servs., Inc. v. Minton*, No. 97 Civ. 2725(SHS), 1997 WL 349949, at \*4 (S.D.N.Y. June 24, 1997)).
69. *See SODIMA v. Int’l Yogurt Co., Inc.*, 662 F. Supp. 839, 853 (D. Or. 1987) (“[P]riority need not depend solely on who gets to the consumer first, as long as there is bona fide shipment or activity . . .”).
70. Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 623–24 (2004). *But see* Mark P. McKenna, *A Consumer Decision-Making Theory of Trademark Law*, 98 VA. L. REV. 67, 72 (2012) (arguing that the search costs theory “distorts trademark law because neither confusion nor search costs are the right focus”).
71. *See* Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 819 (1927) (arguing that trademark protection “originated as a police measure to prevent ‘the grievous deceit of the people’”).

quality of goods in part because they can rely on trademark law to help remedy some attempts to free ride on the goodwill that stems from providing desirable goods of a constant quality.<sup>72</sup> As a by-product, trademark protection also protects producer investment in developing source signification in the mark.<sup>73</sup>

There are other rationales for trademark protection and each one manifests some recognition of the importance of productive use as a justification for trademark rights or the importance of notice in the trademark system. The unfair competition rationale, for example, has been described as embracing two complementary functions: protecting business goodwill and protecting consumer recognition.<sup>74</sup> The development of business goodwill happens through the mark owner's productive use, and this use puts the public on notice of the goods or services offered by the owner under that mark.

Other rationales, like the unjust enrichment or anti-free-riding rationale,<sup>75</sup> and the Lockean labor rationale,<sup>76</sup> have been criticized because they are too property-like and reward the labor of mark creation instead of mark use.<sup>77</sup> In addition, the unjust-enrichment

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72. See *Union Nat'l Bank of Tex., Laredo v. Union Nat'l Bank of Tex.*, Austin, 909 F.2d 839, 844 (5th Cir. 1990) (“[T]rademarks . . . encourage higher quality production by discouraging free-riders.”). It may be more correct to say that trademarks encourage consistency in quality. One is, for example, less interested in improvement at the local McDonald's than the fungibility of the McDonald's experience.
73. See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163–64 (1995) (upholding registration of a trademark consisting only of a color); Eric Goldman, *Deregulating Relevancy in Internet Trademark Law*, 54 EMORY L.J. 507, 552 (2005) (proposing that one purpose of trademark law is to protect “producers’ investment in quality that creates consumer goodwill towards them”).
74. See Adam Mossoff, *What Is Property? Putting the Pieces Back Together*, 45 ARIZ. L. REV. 371, 422 (2003) (describing the shift in trademark law from an integrated property theory to a bundle or exclusion theory, which “served the social goals of unfair competition law”).
75. See Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099, 2111 (2004) (“‘[U]njust enrichment,’ focuses on sellers rather than consumers. It supposes that a seller is unjustly enriched when it appropriates to its own advantage the ‘goodwill’ that another seller has developed in its mark.” (footnote omitted)).
76. See Wendy J. Gordon, *On Owning Information: Intellectual Property and the Restitutionary Impulse*, 78 VA. L. REV. 149, 167 n.64 (1992) (“In my view, ‘Lockean theory’ is largely the label courts use for their conviction that it is unfair for one person to take the fruits of another’s labor. . . . [But] Locke’s own approach, properly understood, leads to far fewer intellectual property rights than has been imagined.”).
77. See Keith Aoki, *Authors, Inventors and Trademark Owners: Private Intellectual Property and the Public Domain* (pt. 2), 18 COLUM.-VLA

rationale has been challenged on the ground that it mistakenly maximizes the interest of the mark owner instead of the interests of the purchasing public, and this comes at the expense of competition.<sup>78</sup> Nevertheless, underlying both the unjust enrichment and Lockean rationales is the notion that the mark is protected because, by using the mark in commerce, the mark owner has engaged in the production of meaning, valuable to the public and competitors. To the extent that those doctrines are used to justify problematic shifts in trademark law, the error is not in rewarding productive use but in granting trademark rights without requiring productive use, or providing levels of protection that are too broad.

Consumer-focused rationales, like consumer protection<sup>79</sup> and consumer autonomy,<sup>80</sup> are more engaged with the notice side of the productive use equation. Marks are protected both because the protection keeps unscrupulous competitors from duping consumers,<sup>81</sup> and because it preserves the ability of consumers to differentiate between competitors' goods and services.<sup>82</sup> Protection of trademark

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J.L. & ARTS 191, 240–41 (1994) (describing the opposing arguments for compensating mark creation for the surplus value placed on the mark in excess of the attached good in commerce).

78. Jennifer E. Rothman, *Initial Interest Confusion: Standing at the Crossroads of Trademark Law*, 27 *CARDOZO L. REV.* 105, 163 (2005) (arguing that the unjust enrichment rationale must be limited in the trademark context by “traditional notions of fair competition”).
79. See Bone, *supra* note 75, at 2108 (“The clearest moral principle relevant to trademark law is the moral norm against intentional deception or lying.”). Nevertheless, there is some overlap between protecting the intangible value associated with the mark and “protecting the buying public from some of the more unscrupulous members of our economic community.” *Maier Brewing Co. v. Fleischmann Distilling Corp.*, 390 F.2d 117, 123 (9th Cir. 1968).
80. See Dinwoodie & Janis, *Contextualism*, *supra* note 65, at 1625 (2007) (arguing that “preserving real consumer choice and enhancing consumer autonomy” is an instrumental role for trademark protection that reaches beyond economic efficiency rationales). Robert Bone, however, critiques the consumer autonomy rationale as “not only impossible to satisfy but also . . . in hopeless conflict with other rights.” Bone, *supra* note 75, at 2110 n.31. See also McKenna, *supra* note 70 (arguing for a greater focus on consumer decision making in trademark law over the search costs theory currently accepted by courts).
81. See Mossoff, *supra* note 74, at 419 (“[T]he fundamental principles of trademark law have essentially been ones of tort: the tort of misappropriation of the goodwill of the trademark owner, and the tort of deception of the consumer. In this sense, trademarks may not be thought of as analogous to ‘property rights’ at all.” (quoting ROBERT P. MERGES ET AL., *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE* 559 (2d ed. 2000))).
82. See 4 MCCARTHY, *supra* note 29, § 24:16 (“The consumer is entitled to be told the truth about the origin or sponsorship of products. . . . If the

rights can serve these consumer-focused functions even though marks do not convey perfect information. It must be noted, however, that consumers contribute to the creation of the property right as they come to use the mark as an indication of the mark owner's goods and services.<sup>83</sup> Some public uses can also pose a threat to those rights. Both dynamics are discussed in more detail in Part III.

C. *The Notice Functions of Fencing, Color of Title,  
and Trademark Registration*

For the aspiring property owner, even relatively limited productive use can secure property rights, when accompanying other notice-providing indicia. For example, fencing a parcel of property is usually treated as actual possession of the entire fenced portion,<sup>84</sup> sufficiently open and notorious to put the public and the record owner on notice of the claim, even if productive activity takes place only on a part of the parcel.<sup>85</sup> Likewise, taking the property under color of title is usually sufficient to establish use of the entire parcel designated in the faulty title, so long as the adverse possessor actually uses part of the property.<sup>86</sup> In some jurisdictions, the statutory period of exclusive possession required to secure title by adverse possession is shorter when the possession occurs under color of title.<sup>87</sup> In other

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consumer is reasonably mistaken as to the source or sponsorship of an alleged infringer's goods, she suffers a real and independent injury to her rights regardless of whether or not she is *economically* injured by the poor quality of the infringer's goods or services.”).

83. See Deborah R. Gerhardt, *Consumer Investment in Trademarks*, 88 N.C. L. REV. 427, 449–67 (2010) (noting the important role consumers play in determining which brands succeed in a world where eight out of ten brands fail); Jessica Litman, *Breakfast with Batman: The Public Interest in the Advertising Age*, 108 YALE L.J. 1717, 1730 (1999) (arguing that consumers impart trade symbols with intrinsic value).
84. See *Whittemore v. Amator*, 713 P.2d 1231, 1233 (Ariz. 1986) (en banc) (maintaining a fence was sufficient to establish dominion over an entire parcel of land despite only actually using a smaller portion for livestock grazing).
85. See, e.g., *Smith v. Tippet*, 569 A.2d 1186 (D.C. 1990) (encircling the property within a wall was sufficiently open and notorious).
86. See *DeShon v. St. Joseph Country Club*, 755 S.W.2d 265, 268 (Mo. Ct. App. 1988) (“Color of title . . . serves to extend actual possession of some portion of the land claimed to constructive possession of the whole tract described in the instrument providing basis for color of title.”); see also *Pillow v. Roberts*, 54 U.S. (13 How.) 472, 477 (1851) (“[C]olor of title, even under a void and worthless deed, has always been received as evidence that the person in possession claims for himself, and of course, adversely to all the world.”).
87. See, e.g., WIS. STAT. §§ 893.25–.27 (2012) (requiring twenty years if adverse possessor actually occupied property under claim of right and either enclosed or improved it, ten years if adverse possessor recorded

jurisdictions, the adverse possession statute expressly excludes a transfer of property unless the possession occurs under color of title.<sup>88</sup> When an encroacher seeks to adversely possess real property, indications of notice like fencing or possessing under color of title will broaden the reach of the productive use. Thus, use of any portion of a fenced parcel amounts to constructive possession of the entire parcel.<sup>89</sup> Without actual possession, however, holding a flawed document that provides the color of title cannot by itself convey title to the property.

For the trademark owner, registration also resembles color of title: registration alone secures no rights.<sup>90</sup> Federal registration provides a mechanism to assert rights in a trademark, but provides only prima facie evidence that the registrant has used the mark in commerce.<sup>91</sup> While a trademark owner can file an application based on a bona fide intent to use a trademark in commerce, and that “ITU” application can give priority over a subsequent user, the applicant’s rights do not vest until the mark is actually used in commerce.<sup>92</sup> Every registrant also has an obligation to provide continuing evidence of use, or the registration will be cancelled.<sup>93</sup> Thus, like possessing property under

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color of title, and seven years if adverse possessor recorded color of title and paid taxes).

88. See, e.g., Act 776, 1995 Ark. Acts 3370 (establishing additional requirements for adverse possession).
89. *Whittemore*, 713 P.2d at 1233.
90. *Am. Express Co. v. Goetz* 515 F.3d 156, 161 (2d Cir. 2008) (“[T]here can be no trademark absent goods sold and no service mark without services rendered.”).
91. *Zazú Designs v. L’Oréal, S.A.*, 979 F.2d 499, 503 (7th Cir. 1992). The court in *L’Oréal* goes on to suggest that “[l]iberality in registering marks is not problematic, because the registration gives notice to latecomers, which token use alone does not. Firms need only search the register before embarking on development.” *Id.* at 504.
92. See *WarnerVision Entm’t Inc. v. Empire of Carolina, Inc.*, 101 F.3d 259, 260 (2d Cir. 1996) (noting that registration may be granted only after an ITU applicant files a statement of commercial use); *Zirco Corp. v. Am. Tel. & Tel. Co.*, 21 U.S.P.Q.2d (BNA) 1542, 1544 (T.T.A.B. 1991) (“[T]he constructive use provision was intended . . . to give an intent-to-use applicant a superior right over anyone adopting a mark after applicant’s filing date (providing the applicant’s mark is ultimately used and registered) . . .”).
93. See 15 U.S.C. §§ 1058–1059 (2006) (establishing the requirements and duration of registration and the process for renewal); *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 49 (Fed Cir. 1986) (affirming cancellation of a mark where the application for renewal fraudulently stated the mark was used on wine, vermouth, and champagne, when, in reality, a modified mark was used only on wine).

color of title, those rights conferred through trademark registration are contingent on actual use.<sup>94</sup>

In both regimes, productive use defines the scope of the right, but plus factors—like color of title or fencing in the adverse possession context, or registration in the trademark context—can alleviate some of the demands of productive use.<sup>95</sup> This is sensible because in both cases, those plus factors increase notice to the public of the claim to the property at issue. The faulty title, the fence, and the registration all provide objective evidence of the scope of the claim to the public, especially to potential competitors. Thus, it is reasonable to provide some benefits to the owner of a trademark registration, or the possessor who holds color of title, so long as those benefits do not strip the trademark system of the productive use requirement entirely.<sup>96</sup>

#### *D. Continuous Use and Acquiring Distinctiveness*

In addition to actual, open, and notorious use, both the adverse possessor and the trademark owner must engage in continuing productive use to secure rights. The adverse possessor must be in continuous possession for the statutory period, but “continuous” here is a term of art. Continuous adverse possession need not be literally continuous, but must be effectively continuous. For example, the continuous use requirement can be met through seasonal use, if that is reasonable for the location.<sup>97</sup> In addition, use by a seller who attempts to convey title to a buyer “tacks,” or is counted for the benefit of the buyer, in meeting the statutorily required period of exclusive possession.<sup>98</sup>

In its temporal aspect, acquiring trademark rights in a descriptive term closely resembles acquiring title to real property via adverse

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94. See 3 MCCARTHY, *supra* note 29, § 19:1.75 (“[R]egistration in the U.S. does not create the trademark, the owner creates the underlying right though [sic] use in the marketplace.”).

95. See Landes & Posner, *supra* note 54, at 281 (“The main social benefit of a federal registration system is that notice is likely to be more widespread, so that inadvertent duplication is less likely; hence, use becomes a less important method of preventing duplication.”).

96. *But see* Kenneth L. Port, *The Congressional Expansion of American Trademark Law: A Civil Law System in the Making*, 35 WAKE FOREST L. REV. 827, 865–66 (2000) (arguing that the actual-use backstop fails to keep the intent-to-use registration system from granting rights based solely on registration).

97. See, e.g., Howard v. Kunto, 477 P.2d 210, 213–14 (Wash. Ct. App. 1970) (finding that summer use of a summer home every year amounts to continuous use).

98. See Stump v. Whibco, 715 A.2d 1006, 1011 (N.J. Super. Ct. App. Div. 1998) (noting that tacking is a “well established” principle and applies as long as the seller intended to convey the disputed parcel).

possession. A descriptive term is not protected upon its first use in commerce as a trademark because it does not initially communicate information about the source of the goods. Instead, the mark must acquire distinctiveness or secondary meaning: consumers must come to recognize that the mark signifies a consistent source for the goods or services.<sup>99</sup> Likewise, the Lanham Act bars the registration of a descriptive term until there is sufficient evidence that the term has acquired distinctiveness.<sup>100</sup>

Pursuant to section 2(f) of the Lanham Act, examiners with the United States Patent and Trademark Office (USPTO) have the option of treating five years of substantially exclusive and continuous use of a descriptive mark as *prima facie* evidence of secondary meaning and granting a registration based on such an affidavit.<sup>101</sup> This section 2(f) presumption is reminiscent of the adverse possession regime because in both cases, exclusive possession over time establishes the property right. Note, however, that while the USPTO can treat every descriptive mark as registrable after five years of exclusive use, different types of trademarks actually receive different treatment. For example, five years' use is generally enough for a mark based on a surname to acquire secondary meaning.<sup>102</sup> On the other hand, the statement of five years' use alone is insufficient to establish secondary meaning for trade dress that "is not inherently distinctive because of its nature."<sup>103</sup> This is consistent with the notice justification driving the trademark use requirement. The USPTO demonstrates an inclination to see a longer period of use before granting a registration to marks that are less inherently capable of providing notice to the public.

Any registration, including one for a descriptive mark that has acquired distinctiveness, can also become "incontestable" after five consecutive years of continuous use, so long as the mark is still in use, and so long as neither the registration nor the common law rights in the mark have been challenged.<sup>104</sup> The five-year window to acquire an incontestable registration resembles the adverse possession regime in its own right, with elements of notice (via the registration system) and at least an inferred requirement that the mark is used under

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99. *See Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992) (stating as a general rule that marks may be protected if they are inherently distinctive or have "acquired distinctiveness through secondary meaning").

100. 15 U.S.C. § 1052(e)–(f) (2006).

101. 15 U.S.C. § 1052(f).

102. TMEP § 1212.05(a) (8th ed. Rev. Oct. 2012).

103. *Id.*

104. 15 U.S.C. § 1065.



claim of right and exclusively, in addition to the requirement of continuous use. In some jurisdictions, the existence of an incontestable registration is evidence of at least some level of commercial strength, even if the mark is merely descriptive.<sup>105</sup>

Courts also frequently evaluate length of use in determining whether secondary meaning has been acquired,<sup>106</sup> but there is no established time for how long a mark must be used in commerce before it acquires secondary meaning.<sup>107</sup> Courts have repeatedly opined that there is no per se minimum amount of time required to establish secondary meaning,<sup>108</sup> but also no maximum beyond which secondary meaning will automatically accrue.<sup>109</sup> Even though courts disclaim any precise amount of time as necessary or sufficient to acquire commercial strength, length of use is a factor always considered, and in some cases, dispositive. For example, in *Marilyn Miglin Model Makeup, Inc. v. Jovan, Inc.*, the court concluded the paucity in length of use—less than four years—was brief enough that yearly sales of over \$3 million and an advertising budget averaging more than \$500,000 per year was insufficient to establish secondary meaning.<sup>110</sup>

The similarity between the acquisition of property through adverse possession and the acquisition of trademark rights in a descriptive term is therefore fairly apparent. The tale typically told is that the descriptive term may pull itself up by its bootstraps, acquire distinctiveness, and become a trademark. On the other hand, inherently distinctive marks are treated as strong and protectable

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105. Such a presumption runs the danger of reading the productive use requirement out of trademark law entirely and should be resisted. *See infra* Part V.A.

106. *See, e.g.*, *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 380 (7th Cir. 1976).

107. 2 MCCARTHY, *supra* note 29, § 15:54.

108. *See, e.g.*, *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1130 (Fed. Cir. 1993) (rejecting the argument that five months was insufficient time to acquire secondary meaning).

109. *See, e.g.*, *ERBE Elektromedizin GmbH v. Canady Tech., LLC*, 629 F.3d 1278 (Fed. Cir. 2010) (affirming summary judgment ruling that trade dress was not protectable despite thirty years of use of color blue on medical instruments). The difference in the temporal certainty offered the adverse possessor and the temporal uncertainty facing the trademark owner is discussed in more detail in Part IV.D.

110. *Miglin Model Makeup, Inc. v. Jovan, Inc.*, 224 U.S.P.Q. 178, 180–81 (N.D. Ill. 1984). The court stated that the amounts were \$25.5 million in sales and \$4.5 million in advertising budget for Miglin over the nine years between 1976 and 1984. Those amounts come out to more than \$3 million and exactly \$500,000 in per year totals.

perpetually and without question from first use.<sup>111</sup> This does not line up with the traditional account of property acquisition through adverse possession. That apparent conundrum is addressed in Part II.A.

## II. PRODUCTIVE USE AND TRADEMARK SCOPE

While Part I described the closest analogies between adverse possession and trademark acquisition, this Part considers some apparent differences in the regimes and reveals the hidden consistencies when those differences are considered through the lens of the productive use requirement. Part II.A addresses in detail the apparent dissonance between adverse possession and the acquisition of rights in inherently distinctive marks. The distance between the regimes is lessened when one realizes that the evidence required to produce secondary meaning in a descriptive term is the same evidence presented to establish the commercial strength, and thus the enforceability, of an inherently distinctive mark. Part II.B addresses the “hostility” misnomer that has crept into adverse possession doctrine. The productive use framework clarifies how claiming rights in both regimes focuses on providing the public with notice of the respective claims. Part II.C discusses the surface tension between adverse possession’s exclusivity requirement and the exclusivity requirement in trademark law and shows how the comparison clarifies the nature of the property secured by the trademark owner.

### A. *Productive Use and Inherently Distinctive Marks*

As discussed in Part I.D, acquiring rights in a descriptive mark resembles adverse possession in its temporal aspect. At first glance, the protection for inherently distinctive marks seems, in comparison, to barely resemble adverse possession. Unlike a descriptive term, an inherently distinctive mark is treated as source signifying on its first use in commerce, so long as that first use is followed by “continuous commercial utilization.”<sup>112</sup> That first use grants priority against other users of the same or similar marks for the same or similar services.<sup>113</sup>

Inherently distinctive marks are treated as possessing secondary meaning at the moment of their first use in commerce because there was no other descriptive primary meaning related to the goods or

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111. *See* *Nutri/System, Inc. v. Con-Stan Indus., Inc.*, 809 F.2d 601, 605 (9th Cir. 1987) (“Arbitrary or fanciful marks (i.e., Kodak) are called ‘strong’ marks, whereas descriptive or suggestive marks are ‘weak.’”). *But see* 2 MCCARTHY, *supra* note 29 at § 11:83 (considering only inherent or conceptual strength is “incomplete”).

112. *Blue Bell, Inc. v. Farah Mfg. Co.*, 508 F.2d 1260, 1265 (5th Cir. 1975) (“[E]ven a single use in trade may sustain trademark rights if followed by continuous commercial utilization.”).

113. *Id.*

services at issue. A fanciful or coined mark, like XEROX for photocopying machines, is invented whole cloth and has *no* meaning prior to its use as a trademark. An arbitrary mark, like APPLE for computers, creates new meaning for a term with which we are familiar. While a suggestive mark, like GLEEM for toothpaste, is more closely related to the underlying goods or services than other inherently distinctive marks, it still requires a conceptual leap to get from the suggestive term to the product's features. All of these marks transform language and create new meaning in their inception and use, and are thus inherently communicative. There is also no requirement to show any particular *duration* of use in commerce before registering an inherently distinctive mark, so long as the mark has been used in commerce.<sup>114</sup> Thus, for inherently distinctive marks, it appears that protection is automatic, and adverse possession might be a poor analogy.

As this Subpart highlights, however, the use in commerce necessary to acquire secondary meaning in a descriptive term is effectively the same use necessary to establish the commercial strength of an inherently distinctive mark. Without sufficient commercial strength, developed over time, the right to exclusive use of the inherently distinctive mark is largely illusory. In both cases, productive use over time is the signal that informs the public about how much value the mark owner places in the mark. That productive use over time also reduces search costs for consumers by identifying a consistent source for mark-bearing goods and services.

Barton Beebe's comprehensive study of likelihood of confusion cases in the federal district courts over a five-year period calls into question the traditional story about automatic protection of inherently strong marks.<sup>115</sup> Beebe's study shows when the assessment of the mark's inherent strength is at odds with the mark's acquired strength, the finding of acquired strength trumps inherent strength.<sup>116</sup>

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114. *Compare* 15 U.S.C. § 1051(a)(1) (2006) (stating that a trademark owner only need file and pay a fee to the Patent and Trademark Office to register a trademark used in commerce), *and* § 1052(f) (stating that nothing shall prevent an owner from registering a distinctive trademark used in commerce, unless expressly excluded in other subsections of the statute), *with* § 1052(f) (stating that proof of five years of substantially exclusive and continuous use may be accepted as prima facie evidence that a descriptive term has acquired distinctiveness).

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

116. *Id.* at 1636. Beebe identified 27 cases where the owner of an inherently strong mark had not established commercial strength. In 24 of those cases (89%), the mark owner failed to establish that the allegedly infringing use would likely confuse consumers. *Id.* A follow up study confirmed this finding over fifteen years of cases from the Second Circuit

In other words, it is the use of the mark in commerce and the notice function served by that use, rather than its inherent conceptual distinctiveness, that matters most.

A descriptive term must acquire significance in the marketplace as a designation for goods and services, becoming protectable and registrable through use in commerce. When trying to determine whether a descriptive mark has acquired secondary meaning (or an inherently distinctive mark has amassed commercial strength), courts look to two overarching questions. First, do consumers see the mark as source signifying, measured through consumer surveys and evidence of actual consumer confusion?<sup>117</sup> Judges tend to distrust the validity of survey evidence,<sup>118</sup> and evidence of actual consumer confusion can be hard to come by.<sup>119</sup> So courts turn to a second question: Has the mark owner done enough to establish the mark in the minds of consumers through advertising, sales volume, and length of use? Courts tend to give great weight to the efforts made by the mark owner to move the mark through commerce, including money spent on advertising, volume of product moved and sales of goods or services. Time in the market also provides prima facie evidence that a descriptive mark has acquired secondary meaning (which the USPTO can choose to recognize in the registration context).<sup>120</sup> In the ex post genericness context, efforts to educate consumers, lexicographers, and other language shapers regarding proper use of its marks are also important.<sup>121</sup> These factors all serve as proxy evidence that the

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and its district courts. Kevin Blum et al., *Consistency of Confusion? A Fifteen-Year Revisiting of Barton Beebe's Empirical Analysis of Multifactor Tests for Trademark Infringement*, STAN. TECH. L. REV., ¶¶ 44–45 (2010), <http://stlr.stanford.edu/pdf/blum-consistency-of-confusion.pdf>.

117. *See* Union Carbide Corp. v. Ever-Ready Inc., 531 F.2d 366, 380 (7th Cir. 1976) (stating that secondary meaning is established “if the public is aware that the product comes from a single, though anonymous, source”).
118. *See, e.g.*, Indianapolis Colts, Inc. v. Metro. Balt. Football Club, 34 F.3d 410, 415 (7th Cir. 1994) (Posner, J.) (suggesting that the “battle of experts” in trademark disputes “is frequently unifying” in part because “[m]any experts are willing for a generous (and sometimes for a modest) fee to bend their science in the direction from which their fee is coming”); 6 MCCARTHY, *supra* note 29, § 32:196 (suggesting that some judicial skepticism may stem from the behavior of “parties and their attorneys who, in a desperate search for *some kind* of evidence, offer, with a straight face, a haphazard, self-serving ‘survey’”).
119. *See* Nabisco Brands, Inc. v. Kaye, 760 F. Supp. 25, 28 (D. Conn. 1991) (“[I]t is unnecessary for plaintiff to show evidence of actual confusion [because] such evidence is exceedingly rare.”).
120. 15 U.S.C. § 1052(f) (2006).
121. *See also infra* note 146 and accompanying text.

consuming public has taken notice of and imbued the mark with source significance.

These are effectively the same factors that courts consider when trying to determine whether a mark (whether its source significance is inherent or acquired) has developed the commercial strength that would suggest use by competitors to sell similar goods under similar marks should lead to a finding that confusion was likely.<sup>122</sup> For example, in the Second Circuit, courts consider consumer testimony; consumer surveys; the exclusivity, length, and manner of the mark owner's use; the amount and manner of advertising; the amount of sales and number of consumers; the mark's established place in the market measured through unsolicited media coverage; and proof of intentional copying.<sup>123</sup> Thus, the strength of a mark—the property right secured—is a matter both of inherent strength (or lack thereof) and commercial strength, or developed strength in the marketplace. As Beebe's study reports, a conclusion by the court that the mark is commercially weak, even if inherently strong, appears virtually fatal to a claim of trademark infringement.<sup>124</sup>

Beebe concludes from this evidence that district courts recognize that “acquired or ‘actual strength’ in the marketplace logically incorporates the effects of the mark's inherent strength.”<sup>125</sup> It may be equally likely that courts recognize that successful use in commerce, *rather than* inherent strength, provides the strongest indicator of trademark ownership. While many of the likelihood-of-confusion factors key into the conflict between the parties (similarity of marks and goods, proximity of services, likelihood that the plaintiff will bridge the gap) and the perception of consumers (evidence of actual confusion), strength of the mark is really about the extent to which the trademark owner has claimed the right to use the trademark, shown by the breadth and length of her use of the mark in commerce.

It is probably correct to say that marks starting from a position of inherent strength are more readily able to acquire strength in the market, perhaps because consumers more easily recognize inherently

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122. See 2 MCCARTHY, *supra* note 29, § 11:82 (“[D]etermination of whether there is infringement requires an evaluation of the strength of [a] trademark.”).

123. Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc., 973 F.2d 1033, 1041 (2d Cir. 1992); see also Mark P. McKenna, *Teaching Trademark Theory through the Lens of Distinctiveness*, 52 ST. LOUIS U. L.J. 843, 846–47 (2008) (“[T]rademark strength . . . is one of the factors that determines the scope of a party's rights.”).

124. See Beebe, *Multifactor Tests*, *supra* note 115, at 1636 (showing that plaintiff prevailed only 4 times in 74 cases (5%) where the court found the mark commercially weak).

125. *Id.*

distinctive marks as source signifying.<sup>126</sup> But the district court decisions analyzed in Beebe's study lean more heavily on the paucity of commercial strength than the presence of inherent strength when determining whether the mark in question is strong and whether there is a likelihood of confusion. For example, in *We Media Inc. v. General Electric Co.*, plaintiff's marks WE and WEMEDIA for magazines and newsletters promoting the disabled community were found to be suggestive.<sup>127</sup> The court presumed the suggestive marks were strong, but that presumptive strength was "reduced to reflect third-party usage and [plaintiff's] own lack of usage."<sup>128</sup>

Here, the subtle difference between trademark acquisition and adverse possession helps us understand this account. In the trademark context, there remains both an affirmative duty to provide affidavits of continuing use and the risk that failure to use the mark in commerce will abandon the mark to the public domain.<sup>129</sup> We might therefore analogize inherent strength to plus factors like possession under color of title and fencing in the adverse possession context.<sup>130</sup> The communicative nature of the inherently distinctive mark suggests that consumers will quickly, if not automatically, recognize the mark as source signifying, but the scope of the protection granted depends more on the mark's commercial strength developed over time.

*B. Claims of Right and the Hostility Misnomer*

Scholars analyzing adverse possession have traditionally focused on the subjective hostility or adversity of the occupier.<sup>131</sup> The comparison to trademark law helps clarify that such hostility is a misnomer. Courts should instead focus on the objective assertion of ownership via notifying productive use. It is the use supporting that assertion which provides sufficient notice to the public and other potential claimants, regardless of the adverse possessor's internal hostility.

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126. See Bone, *supra* note 75, at 2130–34 (arguing that there is a high probability that an inherently distinctive mark will acquire secondary meaning or commercial strength, while there is a lower probability that descriptive terms will acquire secondary meaning).

127. *We Media Inc. v. Gen. Elec. Co.*, 218 F. Supp. 2d 463, 472 (S.D.N.Y. 2002).

128. *Id.* at 477; see also *M2 Software, Inc. v. M2 Commc'ns, L.L.C.*, 281 F. Supp. 2d 1166, 1171 (C.D. Cal. 2003) (explaining that an arbitrary or fanciful mark can be commercially weak).

129. See *infra* Part IV.D.

130. See *supra* Part I.C.

131. See generally Christopher H. Meredith, Note, *Imputed Abandonment: A Fresh Perspective on Adverse Possession and a Defense of the Objective Standard*, 29 MISS. C. L. REV. 257, 261 (2010) (summarizing the literature).

As discussed in Part I.B, open and notorious occupation of property notifies the public and the record owner of the occupier's claim to the property. Open and notorious use of the mark in commerce puts the public and potential competitors on notice in the same way. In both cases, the occupier is asserting a claim of right—treating the property as her own, and holding the property without the permission of a record owner.<sup>132</sup>

In the adverse possession context, permitted use is not trespass and cannot lead to an action by the record owner against the occupier for ejectment.<sup>133</sup> This is so because a contrary rule would allow a permitted occupant to sandbag the owner and spring an adverse possession claim without providing fair notice to the owner of her intentions.

While scholars have argued at length about whether a claim of right properly requires or rejects knowing or “bad faith” possession,<sup>134</sup> the controversy dissipates when one understands that adverse possession keys on productive use that provides notice *to the world* of the claim of the adverse possessor. As the Supreme Court noted as far back as 1851, what is crucial is that the possessor “claims [the property] for himself,” in other words, “adversely to all the world.”<sup>135</sup> In its abstract and doctrinal sense, the issue of bad faith adverse possession has not been resolved. These doctrinal variations and the scholarship surrounding them nevertheless all point, perhaps unknowingly, toward the same conclusion: either intentional or unintentional possession of property belonging to another can be considered possession under claim of right to the extent it puts *the public* on notice of the adverse possessor's claim. The critical element is that to secure title in the property, the occupier must act like an owner. Whether or not the possession is innocent or intentional, it is consistent with the productive use rationale to incentivize possession that sends a signal sufficiently strong to prevent ambush of the record owner and provide notice to the public. It is the information forcing value of the productive use that should be preserved.<sup>136</sup>

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132. See, e.g., *Zimmerman v. Newport*, 416 P.2d 622, 629 (Okla. 1966) (“[C]laim to the property must be adverse and hostile to the title of the true owner.”).

133. See, e.g., *Murray v. Fuller*, 186 P.2d 157, 160 (Cal. Dist. Ct. App. 1947) (holding that use of a driveway without express permission amounted to trespassing).

134. For this Article's proposed intervention regarding the debate, see *infra* Part V.C.

135. *Pillow v. Roberts*, 54 U.S. (13 How.) 472, 477 (1851).

136. Mark Lemley argues that, while the right to exclude is an important incentive for copyright and patent protection because it allows the copyright or patent holder to recover the average total cost of production, this incentive rationale “cannot justify intellectual property rights in trademarks.” Lemley, *Free Riding*, *supra* note 2, at 1058.

On the surface, the trademark owner does not look like an “adverse” or “hostile” possessor because under the hostility misnomer, it has become common to think of the adversity as a head-to-head battle between an active user and a neglectful owner. The one who puts a descriptive, suggestive, or arbitrary term to work as a trademark is not seen to take that term from any other entity with a preexisting right in the term. The disjunction is even more pronounced where the mark owner coins a fanciful term that never before existed. But at its heart, adverse possession requires only that the adverse possessor not be a permitted occupier, to avoid the problem of ambush. Once that distinction is understood, we can focus on the information-forcing and notice-providing value of the mark owner’s productive use.

The trademark owner makes her claim of right when she polices against infringement. Judge Richard Posner articulated a high standard for trademark owners who desire to retain their marks: “A serious trademark holder is assiduous in endeavoring to convince dictionary editors, magazine and newspaper editors, journalists and columnists, judges, and other lexicographically influential persons to avoid using his trademark to denote anything other than the trademarked good or service.”<sup>137</sup> For the trademark owner, acting like an owner is particularly critical in determining the scope of the mark’s protection and whether potentially confusing junior use can be enjoined. Settling with a competitor who uses a similar or identical mark to sell similar goods or services can result in weak protection against third parties using the same mark on less similar goods and services. For example, when two competitors divided the rights between SUNKIST for fruits and SUN KIST for vegetables, respectively, the court denied their joint request to stop the use of SUNKIST as a mark for bread.<sup>138</sup>

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While Lemley’s focus on proper incentives is important, the broad rejection of the right to exclude as an incentive is too strong. As David Friedman has noted, “what we want . . . is not merely an incentive but the right incentive.” *Id.* at 1059 (citing DAVID D. FRIEDMAN, LAW’S ORDER 135 (2000)). The mark owner should be encouraged to engage in activities that provide notice to the public. Thus, focusing on productive use is more likely to get us to the right incentive in trademark law because it focuses on the notice function of the use without falling into the trap of adopting a pure registration system. *See also* Carrier, *supra* note 56, at 82 (“Providing incentives for development is the primary goal of [intellectual property] . . .”). Without the right to exclude, however, mark owners might under produce the information that the public would otherwise use to distinguish the mark owner’s goods from those of competitors.

137. Ill. High Sch. Ass’n v. GTE Vantage Inc., 99 F.3d 244, 246 (7th Cir. 1996).

138. Cal. Fruit Growers Exch. v. Sunkist Baking Co., 166 F.2d 971, 976 (7th Cir. 1947).



More generally, crowding of a particular word or symbol with third-party uses narrows the scope of any given mark created using that word or symbol.<sup>139</sup> For example, in the recent dispute over trademark rights in Betty Boop, the Ninth Circuit noted that fractured ownership of the Betty Boop copyrights could make it difficult for a mark owner to acquire secondary meaning, because use by other companies may lead to widespread confusion and destroy secondary meaning in the mark.<sup>140</sup>

C. *Exclusivity and Trademark Property*

Adverse possession's exclusivity requirement at first also seems ill-fitted to describe trademark acquisition, as the trademark owner acquires no absolute right in any word or symbol. A closer look clarifies that the trademark owner occupies a particular language unit, a "trademark lexeme," and the rights of the trademark owner, like the rights of the adverse possessor, are circumscribed by her efforts to delineate and police the boundaries of her claim.

In the adverse possession context, exclusive use means, generally, the type of exclusive possession that one expects from a record owner of land of that type. Traditionally, the adverse possessor is treated as a sole claimant, who through the open, productive occupation of the land may wrest it from its current, inattentive owner. The exclusivity requirement means that the adverse possessor cannot take title by taking advantage of her silence to ambush a record owner or joint occupant. And perhaps unsurprisingly, the adverse possessor generally may not secure the title while sharing the property with the record owner.<sup>141</sup>

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139. 2 MCCARTHY, *supra* note 29, § 11.85 ("[A] mark that is hemmed in on all sides by similar marks on similar goods cannot be very 'distinctive.'").

140. *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 654 F.3d 958, 967–68 (9th Cir. 2011) (citing *Universal City Studios, Inc. v. Nintendo Co.*, 578 F. Supp. 911, 924–25 (S.D.N.Y. 1983)). The court in *Fleischer* was, however, unwilling to grant the defendant's motion for summary judgment without more evidence of those negative effects. *Id.* at 968.

141. *See Smith v. Tippett*, 569 A.2d 1186, 1190 (D.C. 1990) ("A general statement of the element of exclusivity is that the adverse claimant's possession cannot be shared with the true owner." (quoting JACQUELINE P. HAND & JAMES CHARLES SMITH, *NEIGHBORING PROPERTY OWNERS* § 6.06, at 135 (1988))). *But see Nevells v. Carter*, 119 A. 62 (Me. 1922) (granting title to adverse possessor who took possession under color of title from former record owner and then allowed former record owner to continue to reside on the property). There is nevertheless some play in the joints. If two adverse possessors occupy different portions of the same parcel of land, both can secure title to the portion occupied, so long as neither occupies with permission of the record owner. *Weyerhaeuser Co. v. Brantley*, 510 F.3d 1256, 1262 (10th Cir. 2007) (citing *Macias v. Guymon Indus. Found.*, 595 P.2d 430, 434

Driving the exclusivity requirement is an interest in making sure that the record owner and potential joint owners are clear about the scope of the adverse possessor's claim,<sup>142</sup> as well as allowing the adverse possessor to stand out from other potential claimants and users of the property.<sup>143</sup> Such exclusivity has a notice function, conveying information about the possessor's claim both to the title holder and the public. Therein lies the critical similarity between the exclusivity requirements in adverse possession and trademark acquisition: failing to exclusively occupy property makes it difficult, if not impossible, for the record owner or the public to detect the occupation.

At first glance, this notion of exclusive possession is inconsistent with the homonymous nature of trademark protection.<sup>144</sup> Trademark law is premised in part on the notion that a given word or symbol can have multiple source-signifying meanings—that a given word can serve as the foundation for more than one trademark. DELTA can thus designate one source for airline services and another source for kitchen and bathroom sink faucets.<sup>145</sup> Trademark rights in the word “Delta” are held by different companies who invest the word with homonymous meanings: two different things (goods or services from different sources) are designated by the same word. Just as there may be multiple meanings of the same word in the public lexicon, there may be multiple brands utilizing the same or similar words or symbols

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n.8 (Okla. 1979)). In addition, the adverse possessor's claim is not invalidated by the occasional entry of others, even the record owner. *See, e.g.,* *Smith v. Hayden*, 772 P.2d 47, 52 (Colo. 1989) (in banc) (“[M]ere casual entry for a limited purpose by the record owner is not necessarily sufficient to prove that the use of the property was joint.”). In some jurisdictions, where multiple encroachers claim they have adversely possessed a parcel, title is granted to the adverse possessor with the better color of title. *See Meredith*, *supra* note 131, at 261

142. *See Peters v. Juneau-Douglas Girl Scout Council*, 519 P.2d 826, 830 (Alaska 1974) (“An owner would have no reason to believe that a person was making a claim of ownership inconsistent with his own if that person's possession was not exclusive, but in participation with the owner or with the general public.”).
143. *See Weyerhaeuser*, 510 F.3d at 1261–62 (rejecting adverse possession defense because defendant “did not use [the property in question] to the exclusion of the record owner and other permissive users”).
144. Homonyms are words that look or sound like one another but mean different things. 7 OXFORD ENGLISH DICTIONARY 343 (2d ed. 1989). The difference in meaning is attributed to different etymologies, that is, the words come from different source terms and their current similarity is accidental. *Id.*
145. *See* 4 MCCARTHY, *supra* note 29, § 24:11 (“[I]f there is no likelihood of confusion . . . the same marks can peacefully co-exist on different goods and services.”).

for disparate products and services. Thus, the owner of the STARBUCKS mark does not acquire an exclusive right to all uses of “star,” “bucks,” or even their compression into a single word, but an exclusive right use STARBUCKS to identify coffee and those other goods and services consumers one can expect to find identified by the STARBUCKS brand.<sup>146</sup> Trademark rights can thus be thought of as a limited property right in a unit of language.

The difficulty with this homonymous structure, from the mark owner’s perspective, is that a mark owner who fails to exclusively occupy her trademark may find that third-party encroachment interferes with the ability of the mark to convey a singular source for goods and services to consumers, or the ability of the mark owner to protect the boundaries of the mark. Exclusivity is required of the trademark owner even for inherently distinctive marks because failure to engage in substantially exclusive use narrows the scope of the mark or entirely forestalls enforcement.<sup>147</sup> This dynamic is manifested in the split-market problem recognized by courts in the SUNKIST case.<sup>148</sup> Likewise, for a crowded word, it is difficult for the mark owner to signal information about the goods on which the mark is used, because use by others narrows the potential scope of the mark. As crowding occurs, either with the mark owner’s permission or in the absence of the mark owner’s best efforts, the mark cannot *mean* as broadly as it might have otherwise meant. In essence, by disclaiming conflicts with close neighbors, or failing to police existing conflicts, the mark owner disclaims conflicts with distant opponents or new entrants. The ultimate effect of failing to police the mark, prevent unauthorized third-party use, and maintain exclusivity is that the mark will lose its distinctiveness and no longer perform the notice function consumers relied on.<sup>149</sup> Mark owners who fail to police the boundaries of the mark may find that it stops conveying the same information to consumers, or at least that the mark will be treated as if it no longer conveys that information.

Exclusivity in the trademark context, like exclusivity of possession of real property, need not be absolute. When tasked with deciding whether a descriptive mark has acquired sufficient distinctiveness to qualify for registration, the USPTO can accept “proof of *substantially*

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146. I discuss the concept of trademark lexemes, and the homonymous nature of trademark law in more detail in another article, *The Homonymous Structure of Trademark Law* (on file with author).

147. *See supra* note 139 and accompanying text.

148. *See supra* note 138 and accompanying text.

149. *See* 3 LOUIS ALTMAN & MOLLA POLLACK, CALLMANN ON UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES § 20:72 (4th ed. 2012) (“It has been repeatedly held that if there are several users of the mark, inevitably the mark will lose its distinctiveness.”).

exclusive and continuous use” of the mark for five years as prima facie evidence of distinctiveness.<sup>150</sup> The “substantially exclusive” standard allows the USPTO to discount “inconsequential or infringing” use by others in determining whether the mark owner has secured rights in the mark.<sup>151</sup> In the registration context, the existence of some infringing activity does not necessarily invalidate a claim of exclusive and continuous use. The fact that other use occurs thus matters less than whether the trademark owner takes timely action against that other use.

As this Part has argued, inherently distinctive marks are just like descriptive marks and property acquired through adverse possession in the way that notifying use establishes the scope of the property right. The importance of notifying use highlights the relative unimportance of hostility as part of the adverse possession regime. And exclusivity in trademark law, properly understood, is a right in the lexeme established by the mark owner through use. The next Part considers the role of the public in the creation and destruction of trademark rights.

### III. TRADEMARK EXPIRATION AND COLLECTIVE PRODUCTIVE USE

Part II.C considered how requiring some effort from a claimant to exclusively secure the trademark or the adversely possessed property serves an important function: engaging in substantially exclusive use puts the world on notice of the claim. As detailed below, an examination of trademark case law also shows how shifts in trademark meaning occur through collective, public use of the mark. This Part considers how the public collectively engages in productive use, both to create trademarks that are nevertheless capable of private occupation by mark owners, and to destroy rights in existing marks through ex post genericness. Here, public use produces results—unlike the general irrelevance of public use in determining when a copyrighted work or patented invention falls into the public domain.

As with other property rights, including other intellectual property rights,<sup>152</sup> trademark protection has limited range. Uses of a trademark such as nominative fair use, parody, and comparative advertising are “socially productive uses” that fall outside the reach of

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150. 15 U.S.C. § 1052(f) (2006) (emphasis added).

151. *See, e.g.*, *L.D. Kichler Co. v. Davoil, Inc.*, 192 F.3d 1349, 1352 (Fed. Cir. 1999) (“This makes allowance for use . . . which therefore does not necessarily invalidate the applicant’s claim.” (quoting *TMEP* § 1212.05(b) (8th ed. Rev. Oct. 2012))).

152. *See generally* *Carrier*, *supra* note 56 (surveying fifty property doctrines applied to intellectual property regimes).

the trademark owner.<sup>153</sup> Some productive use also falls outside the grant of copyright protection. Copyright fair use is an affirmative defense to a claim of copyright infringement.<sup>154</sup> Fair use is a sufficiently transformative or productive use of a copyrighted work and may be made without paying the copyright owner and without asking permission.<sup>155</sup> These productive use defenses in trademark and copyright law are primarily seen as individual exceptions to the intellectual property owner's rights.

To date, the Supreme Court has resisted the notion that productive use of a copyrighted work can shift the entitlement in the work to the public at large, rather than to an individual plaintiff. Most recently in *Golan v. Holder*,<sup>156</sup> the Court concluded that Congress did not violate either the Progress Clause,<sup>157</sup> or the First Amendment,<sup>158</sup> in restoring copyright protection to works created by foreigners that fell out of protection because the owners failed to observe previously required formalities.<sup>159</sup>

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153. David H. Bernstein & Andrew Gilden, *No Trolls Barred: Trademark Injunctions After eBay*, 99 TRADEMARK REP. 1037, 1072–73 (2009).

154. *See* *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 599 (1994) (Kennedy, J., concurring) (“Fair use is an affirmative defense, so doubts about whether a given use is fair should not be resolved in favor of the self-proclaimed parodist.”); *Latimer v. Roaring Toyz, Inc.*, 601 F.3d 1224, 1239 (11th Cir. 2010) (“[F]air use . . . is an affirmative defense and should be pleaded as such.”). *But see* Hiram Meléndez-Juarbe, *DRM Interoperability*, 15 B.U. J. SCI. & TECH. L. 181, 218 (2009) (positing that fair use is among copyright law’s “traditional usage freedoms”); Haochen Sun, *Fair Use as a Collective User Right*, 90 N.C. L. REV. 125, 125 (2011) (conceding that fair use has been treated as an individual affirmative defense, but urging reconceptualization of fair use as a collective user right).

155. Judge Leval’s foundational article, which posited transformation was the crucial element of fair use, utilized “productive” use somewhat interchangeably with “transformative” use. *See* Pierre N. Leval, *Toward A Fair Use Standard*, 103 HARV. L. REV. 1105, 1111 (1990) (“I believe the answer to the question of [fair use] justification turns primarily on whether, and to what extent, the challenged use is *transformative*. The use must be productive and must employ the quoted matter in a different manner or for a different purpose from the original.”); *see also* *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 478–79, 497 (1984) (Blackmun, J., dissenting) (focusing on the importance of productivity manifested through the creation of something new as a lynchpin of fair use).

156. *Golan v. Holder*, 132 S. Ct. 873 (2012).

157. U.S. CONST. art I, § 8, cl. 8.

158. U.S. CONST. amend. I.

159. *Golan*, 132 S. Ct. at 889.

Petitioners Lawrence Golan and similarly situated plaintiffs engaged in expressive use of some foreign works that had fallen out of protection, for which copyright protection would be restored by the Uruguay Round Agreement Act (“URAA”).<sup>160</sup> The petitioners argued that providing copyright protection to works that had fallen into the public domain was beyond Congress’s authority under the Progress Clause.<sup>161</sup> The Supreme Court concluded instead that the public domain was not inviolable, and the restoration of protection to select foreign works was consistent with Congress’s practice of periodically extending copyright protection to previously unprotected categories of works.<sup>162</sup>

The petitioners in *Golan* also argued that they had vested First Amendment rights because they had used the unrestored works, then in the public domain, to create their own expression.<sup>163</sup> The Court saw the First Amendment argument as simply an alternate ground to articulate an inviolable public domain, and rejected it.<sup>164</sup> In the Supreme Court’s view, the shift of patented inventions and copyright works from private ownership into the public domain occurs

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160. *Id.* at 881–82. The Act also restored copyright protection to foreign works that never qualified for protection in the first place because either the author’s home country did not have “copyright relations” with the United States or the work was a sound recording fixed before 1972. *Id.* at 882.

161. *Id.* at 884.

162. *Id.* at 887–88. The Court also noted that restored copyright protection would still expire, and thus the restoration was only for limited times, consistent with the requirement of the Progress Clause. *Id.* at 884–85.

163. *Id.* at 891.

164. *See id.* at 891–92. (“Petitioners here attempt to achieve under the banner of the First Amendment what they could not win under the Copyright Clause . . .”). The arguments actually differ. An inviolable public domain argument, grounded in the Progress Clause, would require that expressive works (and inventions) cannot be propertized by anyone, even the author, once they reach the public domain. *Id.* at 891 (citing *Golan v. Gonzales*, 501 F.3d 1179, 1184 (10th Cir. 2007)). The First Amendment argument is instead grounded in the use of the work while in the public domain by the petitioners and those like them, and could arguably have been limited to those parties who had used the works productively. In fact, the Court did not embrace the petitioners’ First Amendment claim in part because it seemed unnecessary, given that Congress eased the burden on those who made use of the restored works while they were in the public domain. *Id.* at 891 (“Congress adopted measures to ease the transition from a national scheme to an international copyright regime: It deferred the date from which enforcement runs, and it cushioned the impact of restoration on ‘reliance parties’ who exploited foreign works denied protection before [the URAA] took effect.”). For a more detailed discussion of the constitutionality of the URAA under both the Progress Clause and the First Amendment, see Jake Linford, *Speech and Progress Institutions* (on file with author).

uniformly and irrespective of potential personal or public engagement with or investment in those works.<sup>165</sup> Professor McCarthy has defined intellectual property rights as the “exception” to which the “[p]ublic domain is the rule.”<sup>166</sup> Assuming McCarthy is correct, the Court in *Golan* granted Congress broad power to make exceptions to this rule, discounting any potential rights “vested” to the public in copyright expression or patented inventions in the public domain.<sup>167</sup> In other words, the public domain of copyrighted works and patented inventions is a passive public domain, and works and inventions may enter and exit the public domain independent of public use.

Like the public domain for copyright and patents, the public domain from which trademarks are drawn has a passive element. Trademarks may not be derived either from an *ex ante* generic term,<sup>168</sup> or functional elements of trade dress.<sup>169</sup> This is the case even if the public invests its energy to imbue an unprotectable word or symbol with source significance. For example, the court in *Harley-Davidson, Inc. v. Grottanelli* concluded that “[t]he public has no more right than a manufacturer to withdraw from the language a generic term, already applicable to the relevant category of products, and accord it trademark significance.”<sup>170</sup> But this public lexicon also has an active component. In both the creation of marks and their dissolution, the public exercises its collective right to occupy lexical space and establish meanings, some of which can be reduced to individual property, and others that can never be so reduced.

At first glance, it is odd to suggest the public has a role in creating trademarks. In litigation, it is the competitor or junior user who typically stands as proxy for the public interest.<sup>171</sup> Nevertheless,

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165. *Golan*, 132 S. Ct. at 892 (“Anyone has free access to the public domain, but no one, after the copyright term has expired, acquires ownership rights in the once-protected works.”).

166. 1 MCCARTHY, *supra* note 29, § 1.2.

167. *Golan*, 132 S. Ct. at 892–93.

168. *See infra* Part IV.A.

169. *See generally* 1 MCCARTHY, *supra* note 29, §§ 7:63–7:66 (discussing the reasons why functional features cannot be protected as trade dress or trademarks).

170. *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 812 (2d Cir. 1999).

171. Margaret Chon, *Marks of Rectitude*, 77 *FORDHAM L. REV.* 2311, 2330 (2009) (“The underlying rationale of trademark protection is based upon a decentralized and privatized consumer protection scheme, where enforcement is provided by competitors, who act as proxies for the consumers.”). *But see* Michael Grynberg, *Trademark Litigation as Consumer Conflict*, 83 *N.Y.U. L. REV.* 60, 63 (2008) (arguing that while the traditional trademark litigation narrative accounts for consumer interest by treating the plaintiff as proxy for consumers, who would seek to prevent confusing uses, courts should also take into

courts have found that consumer use can *create* trademark rights, as was the case when consumers started using “Coke” as a nickname for Coca-Cola. Eventually, the Coca-Cola Corporation secured rights in the nickname just like its other trademarks.<sup>172</sup> Consumers also contribute to the protection of trademarks. Indeed, as Jessica Litman has astutely observed, trademark owners build the source significance in their marks “with their customers’ money and active collaboration.”<sup>173</sup>

A trademark can also be extinguished through public use, which I term *ex post* genericness. In the typical case, the public uses the mark to designate the genus of goods, rather than the mark owner’s source-specific goods. This effectively adds a generic meaning to the word or symbol underlying the trademark. When the trademark comes primarily to represent a genus of goods or services, rather than goods or services from a particular source, the mark becomes generic, and the former mark owner loses her rights in the mark. In effect, the public use swamps, or out-produces, the source significance created by the mark owner.<sup>174</sup> Thus, when 88 percent of retailers indicated they knew of no word to describe transparent cellulose film other than cellophane—DuPont’s purported trademark—the Second Circuit held the term to be generic.<sup>175</sup>

The adverse possession analogy helps clarify that the public can acquire or exercise something like a property right in the trademark lexeme. There are both passive property rights in language protected by Congress and the courts as part of the linguistic commons—that is, *ex ante* generic terms and functional symbols—and active property rights that the public exercises with regards to the use of trademarks

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account nonconfused consumers who might have “a significant interest in the continuation of a defendant’s actions”).

172. *See, e.g., Coca-Cola Co. v. Busch*, 44 F. Supp. 405, 410 (E.D. Pa. 1942) (holding that a beverage seller’s use of the term “Koke-Up” was substantially similar to the common abbreviation for Coca-Cola, and that such an abbreviation is just as protected as the original trademark).

173. *See* Litman, *supra* note 83, at 1730 (“Producers have invested in their trade symbols . . . [b]ut so have we. The argument that trade symbols acquire intrinsic value . . . derives from consumers’ investing those symbols with value for which they are willing to pay real money.”).

174. *See generally* 2 MCCARTHY, *supra* note 29, § 12:6 (“The standard most often applied to determine whether a term is generic is not whether it has *some* significance to the public as the name of an article, but whether that is its *principal* significance.”). Sometimes the mark owner’s own missteps hasten the process. For example, DuPont’s advertising used the term cellophane to describe the product, rather than the brand. *DuPont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75, 80 (1936).

175. *DuPont*, 85 F.2d at 80.



that can lead to ex post genericness. In both cases, as Judge Posner stated, “[a] trademark owner is not allowed to withdraw from the public domain a name that the *public* is *using* to denote someone else’s good or service, leaving that someone and his customers speechless.”<sup>176</sup> Sometimes, the court concludes that a term is in public use and cannot become a trademark in the first instance, and other times, the court concludes a term that was once a trademark is now a generic designation.

Drawing a direct analogy between the collective, public use of trademarks and adverse possession is nevertheless problematic.<sup>177</sup> First, treating generic use of the mark as use under a claim of right seems particularly discordant. Lexicographers, a frequent target of cease and desist letters from trademark owners, ostensibly catalog use as they find it, and have neither the desire nor the intent to claim

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176. Ill. High Sch. Ass’n v. GTE Vantage Inc., 99 F.3d 244, 247 (emphasis added).

177. There is a similar problem in drawing an analogy between the potentially confusing use of junior user and the productive use of the adverse possessor. Courts and scholars have, in passing, compared the trademark owner fighting off confusing uses to a record owner fighting off adverse possessors. *See supra* note 6. The junior user can bring a successful laches defense that can prevent a senior user that “sleeps on his rights” from securing damages for past infringement. *See, e.g.,* Herman Miller, Inc. v. Palazzetti Imps. & Exps., Inc., 270 F.3d 298, 322 (6th Cir. 2001) (granting injunctive relief in trademark infringement suit but denying pre-filing damages on laches grounds). Extreme delay can even result in the senior user being denied injunctive relief as a remedy. Prudential Ins. Co. of Am. v. Gibraltar Fin. Corp. of Cal., 694 F.2d 1150, 1152 (9th Cir. 1982) (barring injunctive relief because twenty-eight-year delay amounted to gross laches). But the junior user who successfully invokes a laches defense does not strip the mark owner of any rights in the mark *per se*, unlike the successful adverse possessor, who takes title from the record owner. More often, the successful junior user avoids liability by arguing that his use is not confusing, that is, the meaning he generates through his trademark use is sufficiently distinct from the meaning generated by the senior user that the junior user has not created meaning that would confuse consumers, and thus has not transgressed the senior user’s trademark right. A court may conclude that the marks are not confusing because the words or symbols used as the basis for the respective marks are not sufficiently similar or have different meanings because the parties’ goods or services are sufficiently distinct. *See* Beebe, *supra* note 115, at 1623–26, 1631–33 (explaining the similarity and proximity factors of the multifactor test). Furthermore, marks may not be confusing because the word or symbol used as a mark by the senior user is already subject to crowding, and the junior user is merely the latest entrant. “In such a crowd, customers will not likely be confused between any two of the crowd and may have learned to carefully pick out one from the other.” 2 MCCARTHY, *supra* note 29, § 11:85.

trademark rights.<sup>178</sup> Indeed, trademark rights are arguably irrelevant to public, generic use of a trademark.

Second, the analogy between adverse possession and public use that results in ex post genericness also appears to break down when we consider exclusivity. Generic use opens up a former trademark lexeme to use by every competitor. Every manufacturer of transparent cellulose film can use cellophane as a generic descriptor of their product. The public is arguably disinterested in engaging in substantially exclusive use of any sort.

Use that results in ex post genericness is, however, use that strips from the trademark owner the rights to use the trademark *exclusively* as a designation of source and to exclude others from using it in a manner consistent with that source significance. We might think of this as a collective exclusivity, preventing only the conversion of the term to trademark property. This is consistent with rights historically recognized in commons: members of a community could collectively exclude outsiders, or collectively decide which uses would be allowed and which uses would be prevented.<sup>179</sup>

This active public domain is particularly important because trademarks, unlike copyrights and patents, do not necessarily expire, so long as they are in use. Productive use in the trademark context, like productive use in the adverse possession context, is relative, and the stronger, more productive use should win out, even if that stronger use is sometimes collective use.

#### IV. PRODUCTIVE USE AND TRADEMARK UNCERTAINTY

Parts I and II described how both trademark acquisition and adverse possession regimes are focused on requiring the property acquirer to engage in exclusive, notifying use over time in order to secure the desired property right. Part III fleshed out the important role of the public in actively shaping the trademark lexicon and the contours of the trademark public domain, an opportunity effectively denied the public in the copyright and patent contexts.

This Part addresses some critical differences in the regimes and what the differences teach about how productive use properly diverges in the two regimes. Part IV.A explains the difference between ex ante

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178. See Shawn M. Clankie, *Brand Name Use in Creative Writing: Genericide or Language Right?*, in PERSPECTIVES ON PLAGIARISM AND INTELLECTUAL PROPERTY IN A POSTMODERN WORLD 253, 258 (Lisa Buranen & Alice M. Roy, eds., 1999) (“[D]ictionaries are key in determining whether a trademark is being used only as a trademark or whether . . . it has begun to acquire new forms or uses.”).

179. See Fagundes, *supra* note 5, at 685 n.146 (differentiating the historical use of “commons” from “information commons,” the latter referring to the public domain).

and ex post genericness and how the phenomena interact with the general bar on adverse possession of state property held in trust for the public. Part IV.B details the difference in inherent notice between physical and intangible property. Part IV.C discusses how the adverse possessor's title in fee simple differs from the warehousing ban in trademark law and highlights the importance of the warehousing ban by comparing the trademark regime to the domain name registration system. More specifically, the productive use requirement in trademark law is perpetual, not one that ends once the property right is acquired. As Part IV.D explains, these differences evidence how the adverse possession regime is more "crystalline" than the "muddier" trademark regime, in the sense those terms were first used by Carol Rose to describe differences in predictability between property regimes.<sup>180</sup> The uncertainty in the trademark regime, however, is an important feature of the system, because perpetual productive use should be a required cost to secure perpetual trademark protection.

A. *Adverse Possession and Public Property*

It is commonly understood that property held by the state in common for the public generally cannot be adversely possessed.<sup>181</sup> For example, tidelands near the Mississippi Gulf Coast were held in public trust by the state, and therefore could not be reduced to private ownership via adverse possession, regardless of the relative value of the ostensible adverse possession.<sup>182</sup>

In the trademark context, Maya Alexandri has argued that descriptive terms are in the public domain—language held by the government "in trust for the populace."<sup>183</sup> Recognizing this general

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180. See generally Rose, *Crystals*, *supra* note 15.

181. *Compare Cinque Bambini P'ship v. State*, 491 So. 2d 508, 521 (Miss. 1986) (en banc) ("The State's title may not be lost via adverse possession, limitations or laches."), with *Mountain States Tel. & Tel. Co. v. Pueblo of Santa Ana*, 472 U.S. 237, 244 (1985) (noting that the Pueblo Lands Act of 1924 allowed non-Indian possessors of Pueblo grant lands to extinguish a Pueblo's title, if the non-Indian had continuously, openly, and notoriously adversely possessed the land and paid taxes). *But see Burgess v. Gilman*, 475 F. Supp. 2d 1051, 1061–62 (D. Nev. 2007) (concluding that service marks seized by the government from the Mustang Ranch brothel were not abandoned by temporary misuse while in government hands, in part because of the general rule that government property cannot be adversely possessed). See also generally, R.P. Davis, *Acquisition by Adverse Possession or Use of Public Property Held by Municipal Corporation or Other Governmental Unit Otherwise than for Streets, Alleys, Parks, or Common*, 55 A.L.R.2d 554 (1957).

182. *Cinque Bambini*, 491 So. 2d at 510–11.

183. Maya Alexandri, *The International News Quasi-Property Paradigm and Trademark Incontestability: A Call for Rewriting the Lanham Act*, 13 HARV. J.L. & TECH. 303, 320 (2000).

rule would prevent any attempt by a hopeful mark owner to quiet title in a descriptive mark. Technically, the same rationale could be applied to any mark. Most word marks appropriate words currently in use with pre-existent meanings.<sup>184</sup> Even fanciful trademarks are derived from common language elements. Thus, an absolute bar on the adverse possession of public property could arguably apply to the acquisition of any trademark, because the morphemes and phonemes comprising *every* word mark are in the public domain.<sup>185</sup>

Note, however, that the general rule against adversely possessing public property does not apply universally, and is in fact shot through with exceptions.<sup>186</sup> In some jurisdictions adverse possession can occur when the property at issue is not used for public purposes but held by the state for private or community-specific purposes.<sup>187</sup> Several states also boast statutes that expressly allow adverse possession of state or municipal property.<sup>188</sup>

Trademarks, while drawn from the public domain, have been designated as subject to private ownership. The Lanham Act protects both registered and unregistered trademarks.<sup>189</sup> Most state legislatures

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184. See *supra* notes 29–30, 111, 114, 135–137 and accompanying text.

185. A morpheme is a fragment of a written word. See, e.g., Richard R. Klink, *Creating Meaningful Brands: The Relationship Between Brand Name and Brand Mark*, 14 *MARKETING LETTERS* 143, 144 (2003) (describing how marketers embed words within brand names). A phoneme is a sound, essentially a syllabic building block. Ross D. Petty, *Naming Names: Trademark Strategy and Beyond: Part One—Selecting a Brand Name*, 15 *J. BRAND MGMT.* 190, 194 (2008) (explaining that certain sounds have common associations with products and marketers seek to use sounds to create a distinct brand name).

186. See, e.g., *Richert v. City of San Diego*, 293 P. 673, 676 (Cal. Dist. Ct. App. 1930) (holding that public land which is not reserved or dedicated to public use can be adversely possessed). See also generally Paula R. Latovick, *Adverse Possession Against the States: The Hornbooks Have It Wrong*, 29 *U. MICH. J.L. REFORM* 939, 939 (1996) (explaining how “[f]ew states simply and explicitly protect all state land from adverse possession”).

187. See, e.g., *City of Chicago v. Middlebrooke*, 32 N.E. 457, 458 (Ill. 1892) (vacant lot owned by the city but not held for public use was not exempt from the statute of limitations for real actions). *But see, e.g., City of Gainesville v. Gilliland*, 718 S.W.2d 553, 565 (Mo. Ct. App. 1986) (holding that private land conveyed to the city could not be adversely possessed).

188. See, e.g., *State v. Harman*, 50 S.E. 828, 829 (W. Va. 1905) (holding that wild land not used in government administration was subject to adverse possession under the statute of limitations because state owned land was subject to the statute of limitations unless specifically exempted). See also generally Davis, *supra* note 181, § 31(a) (listing states that allow adverse possession for public lands).

189. 15 U.S.C. §§ 1114(1), 1125(a) (2006).

have created registration regimes and expressly recognize common law rights in trademarks.<sup>190</sup> As both the federal and state governments have carved out statutory trademark protection, the general objection that adverse possession cannot claim public property should not apply to most trademarks.

Congress has, however, arguably held one source material “in trust for the populace” that cannot be drawn out of public domain through trademark use: the generic term that functions only to designate the genus of the good or service offered, at the moment of first use. The registration of such an *ex ante* generic term is not allowed, because such a term is effectively held in common for the public to enable competitors to bring products to market or offer services identified in a way that allows consumers to find competing products or service.<sup>191</sup> Note that only *ex ante* generic terms are barred from trademark appropriation in this way. Marks that become generic *ex post*, like SINGER once became a generic designation for the owner’s formerly patented sewing machines,<sup>192</sup> can still be rehabilitated through the efforts of the mark owner.<sup>193</sup> Thus, while real property held in common for the public generally cannot be adversely possessed, it is most reasonable to understand that *ex ante* generic terms are the only terms “held in common” in a fashion that prevents them from being converted to some level of private ownership.

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190. *See, e.g.*, FLA. STAT. ANN. § 495.161 (West 2010) (Florida registration regime does not preempt common law protection); § 495.031 (establishing state trademark registration regime); *see also* Allan J. Sternstein et al., *Corporate Compliance Series: Designing An Effective Intellectual Property Compliance Program*, Nov. 2012, § 4:42, available at Corp. Compl. Series Intell. Prop. 4:42 (Westlaw) (providing a fifty state survey of trademark laws).

191. The Lanham Act uses “generic” to describe abandonment via *ex post* genericness, but does not explicitly discuss *ex ante* genericness. 15 U.S.C. § 1127 (defining “abandonment”). Professor McCarthy suggests that while 15 U.S.C. § 1064(3) refers specifically to the cancellation of a mark on genericness grounds, it should also apply to the initial attempt to register a generic term. 2 MCCARTHY, *supra* note 29, § 12:5 n.6; *see also* Kellogg Co. v. Nat’l Biscuit Co., 305 U.S. 111, 116 (1938) (“Since the term [shredded wheat] is generic, the original maker of the product acquired no exclusive right to use it.”).

192. *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169 (1896).

193. *Singer Mfg. Co. v. Briley*, 207 F.2d 519, 520 n.3 (5th Cir. 1953) (affirming that the mark owner had “by the constant and exclusive use of the name ‘Singer’ in designating sewing machines and other articles manufactured and sold by it and in advertising the same continuously and widely—recaptured from the public domain the name ‘Singer’”); *see also supra* note 146 and accompanying text.

*B. Physical v. Intangible Property*

Any comparison of the acquisition of real or personal property with the acquisition of intellectual or intangible property must take into account the ways that physical property differs from intangible property. A trademark is a lexeme that includes both the word or symbol recognized and the connection to the goodwill of the producer. Trademarks are not physical property. On the other hand, real and personal property have an explicit corporeal manifestation.

Real property is also fixed in physical space in a way that a trademark never can be. The permanence of the physical location of real property performs a natural notice function that trademarks, or even personal property, cannot. Real property bearing on its face indicia of active use or ownership provides some notice merely through its consistent presence in a fixed location.

On the other hand, adverse possession of personal property (also known as “chattel property”) has been rejected by courts when they recognize that open and notorious use of personal property “may not be sufficient to put the original owner on actual or constructive notice of the identity of the possessor.”<sup>194</sup> Like personal property, trademarks have a physical manifestation when they are affixed to goods, but affixation is no longer the sine qua non of trademark protection. And like other regimes protecting nonrivalrous goods,<sup>195</sup> it can be difficult to detect trademark infringement.<sup>196</sup> In light of these differences, securing rights in a trademark should require a higher level of notice than acquiring real property through adverse possession. The next subpart details how the antiwarehousing principle in trademark law establishes this higher desired level of notice through the trademark regime’s continual use requirement.

*C. Warehousing and the Domain Name System*

The differences between adverse possession and trademark acquisition are not limited to differences in corporeal manifestation. While both the adverse possessor and the trademark owner must

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194. Michael Allan Wolf, *Taking Regulatory Takings Personally: The Perils of (Mis)reasoning by Analogy*, 51 ALA. L. REV. 1355, 1368 (2000) (quoting *O’Keeffe v. Snyder*, 416 A.2d 862, 867 (N.J. 1980)).

195. David W. Barnes, *A New Economics of Trademarks*, 5 NW. J. TECH. & INTEL. PROP. 22, 55–56 (2006) (arguing that trademarks are impure public goods with nonrivalrous characteristics).

196. Irina D. Manta, *The Puzzle of Criminal Sanctions for Intellectual Property Infringement*, 24 HARV. J.L. & TECH. 469, 507 n.241 (2011). *But see* Paul Heald, Comment, *Money Damages and Corrective Advertising: An Economic Analysis*, 55 U. CHI. L. REV. 629, 646 (1988) (arguing that the chance of nondetection of trademark infringement is low because “a trademark has a conspicuous public presence”).

engage in continuous use to acquire their respective rights, the trademark owner never secures title in fee simple. Unlike rights in real property, or even intellectual property rights like copyright or patent protection, trademark rights are property rights dependent upon perpetual use of the property held.

Failure to use a mark in commerce leads to its abandonment, no matter the strength of the mark, and even if the mark had previously been used for an extended period of time.<sup>197</sup> This is true not only for actual use of the mark in commerce, which secures common law rights, but also for trademark registrations. The owner of a trademark registration must file an affidavit of continuing use after the first six years of registration,<sup>198</sup> and then every ten years,<sup>199</sup> to retain the registration.<sup>200</sup> If the mark is no longer used for any of those goods or services, the registration can be cancelled for abandonment.<sup>201</sup> But like title to real property in fee simple, the trademark owner who continuously uses the mark in commerce can control the mark perpetually—a key difference between the trademark regime and the protection for limited times afforded to copyrights and patents.<sup>202</sup> While real property, like patents and copyrights, generally may be “warehoused” or held idle, trademarks may not.<sup>203</sup>

Even this difference between the acquisition of real property and trademark rights is not as stark as it first appears. Real property may be left idle in perpetuity, so long as the record owner meets its obligations to monitor the property against adverse possessors. In this way, the continual use requirement imposed on the trademark owner is somewhat similar to the adverse possession regime generally, because both regimes include a mechanism whereby the inactive owner can lose property held idle. For the adverse possessor, the title

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197. *See, e.g.*, *ITC Ltd. v. Punchgini, Inc.*, 373 F. Supp. 2d 275, 284–85 (S.D.N.Y. 2005) (holding that an Indian restaurant’s nonuse of its trademark for more than three years was enough to constitute abandonment).

198. 15 U.S.C. § 1058(a)(1) (2006).

199. *Id.* § 1058(a)(3).

200. *See* 1 ANNE GILSON LALONDE, *GILSON ON TRADEMARKS* § 4.03 (2011) (discussing the process of canceling and retaining a trademark).

201. 15 U.S.C. §§ 1064(3), 1119; *see also supra* note 93.

202. Graeme B. Dinwoodie, *Copyright Lawmaking Authority: An (Inter)Nationalist Perspective on the Treaty Clause*, 30 COLUM. J.L. & ARTS 355, 372 (2007).

203. *See, e.g.*, *Harod v. Sage Prods., Inc.*, 188 F. Supp. 2d 1369, 1379 (S.D. Ga. 2002) (“Plaintiffs . . . failed to make significant use of the [registered] mark, and the law does not permit them to waste their rights in this mark where Defendant can and has put the mark to productive use.”).

acquired in fee simple is only as good as her ability to prevent subsequent adverse possession. Thus, in any property regime that uses adverse possession as an equitable backstop, the title in fee simple is subject to transfer if the record owner becomes inattentive. This monitoring requirement is the focus of some criticism of the adverse possession regime,<sup>204</sup> but as a result, the duration of the right in real property in an adverse possession regime differs from the trademark right in degree, not in kind.

One can see the importance of the bar on warehousing in trademark law when comparing the productive use trademark regime with the registration-only regime for acquiring domain names.<sup>205</sup> Domain names are limited resources, much like real property, in that only one person can own a given domain name. Domain name registrations are also first-come, first-served.<sup>206</sup> Domain name registrars are not required to ask whether a registrant uses the word that makes up the domain name as part of a business, or has other preexisting interests in it,<sup>207</sup> and early on in the history of domain name registrations, neither were registrants. Enterprising domain name registrants soon realized they could acquire domain names that included a well-known brand or the name of a celebrity. This practice conflicted with established trademark and publicity rights, and was inconsistent with the concept of notifying productive use. As Anupam Chander noted, this first-in-time domain name policy did a poor job of guaranteeing that the first mover would be the person who can make the most productive use of a domain name.<sup>208</sup>

Initially, aggrieved trademark owners sought relief through actions for trademark dilution, but that provided relief only to the

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204. See, e.g., Patty Gerstenblith, *The Adverse Possession of Personal Property*, 37 BUFF. L. REV. 119, 156 (1989) (arguing that the danger of transfer through adverse possession leads owners to engage in inefficient monitoring).

205. A domain name is a unique address on the Internet, like <uspto.gov>.

206. See Ughetta Manzone, Recent Case, *Panavision International, L.P. v. Toeppen*, 13 BERKLEY TECH. L.J. 249, 249 (1998) (describing the domain name registration regime prior to the passage of the ACPA and the adoption of the UDRP); Gillian K. Hadfield, Essay, *Privatizing Commercial Law: Lessons from ICANN*, 6 J. SMALL & EMERGING BUS. L. 257, 272 (2002) (“The UDRP as [then] currently implemented, for example, reflects a choice to allow first-come-first-serve registration . . . without contacting alternative potential users of the name or resolving competing claims among them.”).

207. A domain name registrar is an entity that manages the reservation of Internet domain names.

208. Anupam Chander, *The New, New Property*, 81 TEX. L. REV. 715, 746–47 (2003).



strongest marks.<sup>209</sup> The response, both nationally and internationally, was to allow trademark owners to inject relative merit of the productive use of the mark owner and the registrant into processes for resolving disputes over domain names. Congress passed the Anticybersquatting Protection Act (ACPA) in 1999 to deal with the problem.<sup>210</sup> Under the ACPA, trademark owners can seek the transfer of domain names from registrants who register, traffic in, or use a domain name.<sup>211</sup> There are two overarching conditions for the transfer. First, the domain name must be identical or confusingly similar to a distinctive mark, or identical, confusingly similar to, or dilutive of a famous mark.<sup>212</sup> Second, the domain name must have been registered with “a bad faith intent to profit” from the mark.<sup>213</sup>

The Internet Corporation for Assigned Names and Numbers (ICANN), tasked with coordinating the global Internet systems for the United States and others, worked closely with the World Intellectual Property Organization (WIPO) to draft a Uniform Domain-Name Dispute Resolution Policy (UDRP).<sup>214</sup> The UDRP also provides a transfer remedy. Under the UDRP, a complainant can obtain the transfer of a domain name if the domain name is identical or confusingly similar to the complainant’s mark, if the registrant has “no rights or legitimate interests” in the domain name, and if the domain name was registered in bad faith.<sup>215</sup>

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209. *See, e.g.*, *Panavision Int’l, L.P. v. Toepfen*, 945 F. Supp. 1296, 1301 (C.D. Cal. 1996) (“Trademark dilution laws protect ‘distinctive’ or ‘famous’ trademarks . . .”), *aff’d*, 141 F.3d 1316 (9th Cir. 1998).

210. Anticybersquatting Consumer Protection Act, Pub. L. No. 106-113 tit. III, 113 Stat. 1501A-545 (1999) (codified as amended at 15 U.S.C. § 1125(d) (2006)); *see also* *Ford Motor Co. v. Greatdomains.com, Inc.*, 177 F. Supp. 2d 635, 655 (E.D. Mich. 2001) (“[T]he ACPA appropriately regulates the otherwise ‘first-come, first-serve’ policy of distributing domain names by taking into account the legitimate competing interests that might exist in a given domain name.”).

211. 15 U.S.C. §§ 1125(d)(1)(C), (d)(2).

212. *Id.* § 1125(d)(1)(A)(ii).

213. *Id.* § 1125(d)(1)(A)(i). Trademark owners can also seek damages for domain names registered after the passage of the ACPA. *Id.* § 1117(d).

214. 5 GILSON, *supra* note 200, § 30.08 (noting that the UDRP was proposed in part due to dissatisfaction with the role that Network Solutions, the sole registrar for domain names under the .com, .net and .org Top-Level Domain Names, played as a trademark dispute tribunal); *see also* *UDRP Opinion Guide*, HARVARD L. SCH., <http://cyber.law.harvard.edu/udrp/opinion> (last visited Apr. 6, 2013) (organizing and summarizing the opinions issued by UDRP panelists).

215. *Uniform Domain Name Resolution Policy*, ICANN, § 4(a) (Oct. 24, 1999), <http://www.icann.org/en/help/dndr/udrp/policy> [hereinafter UDRP].

Bad faith in both dispute resolution systems, however, is determined in large part by the relative value of use that the domain name registrant makes of the domain name and the trademark that comprises it, and the value of the trademark owner's use of the mark.<sup>216</sup> In both systems, disputes are resolved by considering the bad faith of the registrant; the productive use of the registrant, the complaining mark owner, and other mark owners; and the relative identity rights of registrant and mark owner.

So called "cybersquatters" are those who secure domain names comprised of trademarks to sell them to the mark owner at prices higher than the cost of registration. Both systems flag the intent to sell the domain name as evidence of problematic "bad faith."<sup>217</sup> Moreover, commercial gain cuts against the registrant in other contexts.<sup>218</sup> Intent to divert consumers from the mark owner's site,<sup>219</sup> or otherwise disrupt an established business interest,<sup>220</sup> may also indicate bad faith. Bad faith is further indicated by providing false contact information to the domain name registrar,<sup>221</sup> and registering multiple distinctive or famous marks.<sup>222</sup> There are, however, productive uses in which a registrant can engage that push back against a finding of bad faith registration. The registrant has a stronger case if she has used the mark to sell her own goods or services<sup>223</sup> or to engage in noncommercial or fair use of a trademark.<sup>224</sup>

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216. 15 U.S.C. § 1125(d)(1)(B)(i); UDRP, *supra* note 215, § 4(b). The UDRP explicitly acknowledges that its bad faith inquiry measures the registrant's rights or legitimate interests, or lack thereof, with regard to the domain name. UDRP, *supra* note 215, § 4(a)(ii). The report from the House Committee on the Judiciary noted the same balancing act was at the heart of the ACPA. *See* H.R. REP. NO. 106-412, at 10 (1999) (stating that the ACPA bad faith factors "are designed to balance the property interests of trademark owners with the legitimate interests of Internet users").

217. 15 U.S.C. § 1125(d)(1)(B)(i)(VI); UDRP, *supra* note 215, § 4(b)(i).

218. UDRP, *supra* note 215, § 4(b)(iv), (c)(iii).

219. 15 U.S.C. § 1125(d)(1)(B)(i)(V).

220. UDRP, *supra* note 215, § 4(b)(i)-(iii).

221. 15 U.S.C. § 1125(d)(1)(B)(i)(VII).

222. *Id.* § 1125(d)(1)(B)(i)(VIII). The UDRP also considers engaging in a pattern of registering domain names to prevent mark owners from reflecting the mark in a domain name as evidence of registration and use in bad faith. UDRP, *supra* note 215, § 4 (b)(ii).

223. 15 U.S.C. § 1125(d)(1)(B)(i)(III); UDRP, *supra* note 215, § 4(c)(i).

224. 15 U.S.C. § 1125(d)(1)(B)(i)(IV); UDRP, *supra* note 215, § 4(c)(iii); *see also* H.R. REP. NO. 106-412, at 10 (1999) (describing "lawful uses of others' marks" as "including for purposes such as comparative advertising, comment, criticism, parody, news reporting, fair use, etc."); *supra* notes 153-55 and accompanying text.

Both systems treat trademark rights as indicative of superior rights to use the domain name consisting of that mark. Both systems weigh the mark owner's trademark rights,<sup>225</sup> the distinctiveness or fame of the mark in question,<sup>226</sup> and even "other intellectual property rights,"<sup>227</sup> in the mark owner's favor. As noted above, both systems disfavor the registrant who registers multiple distinctive or famous marks. Both systems implicitly accept pre-existing trademark rights as evidence that the owner of those rights will engage in more productive use of the domain name than the domain name registrant. Chander critiques the presumption, noting that not every mark owner will necessarily engage in more productive use.<sup>228</sup> But it is not unreasonable to think that a trademark owner might be more likely to engage in productive use of a domain name incorporating her mark than a domain name registrant who has no pre-existing interest, and even lacks plans to use the domain name to offer goods and services.

In addition to trademark rights, the ACPA provides a cause of action for those whose personal name is protected as a mark.<sup>229</sup> Another provision of the Act establishes civil liability for registering a domain name consisting of the name of another living person (or a confusingly similar variation) without consent for the purpose of selling the domain name to that person or a third party.<sup>230</sup> The UDRP limits its protection to trademarks,<sup>231</sup> although UDRP panelists have recognized that personal names can acquire distinctiveness.<sup>232</sup> And both systems recognize the legitimacy of domain registrants who have a pre-existing identity associated with the domain name registered.<sup>233</sup>

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225. 15 U.S.C. § 1125(d)(1)(B)(i)(I); UDRP, *supra* note 215, § 4(a)(i), (b)(i)–(ii).

226. 15 U.S.C. § 1125(d)(1)(B)(i)(IX).

227. *Id.* § 1125(d)(1)(B)(i)(I); *see also* UDRP, *supra* note 215, § 4(c)(ii).

228. *See* Chander, *supra* note 208, at 747 ("[T]he system does a poor job of ensuring that domain names end up in the hands of the persons who value them most.").

229. 15 U.S.C. § 1125(d)(1)(A).

230. *Id.* § 8131(1)(A); *see also* *Bogoni v. Gomez*, 847 F. Supp. 2d 519 (S.D.N.Y. 2012) (holding that a domain registrant who purchased multiple versions of a philanthropist's real name and tried to sell each domain name for \$1,000,000 violated the ACPA).

231. *See* Jacqueline D. Lipton, *Who Owns "Hillary.com"? Political Speech and the First Amendment in Cyberspace*, 49 B.C. L. REV. 55, 62 (2008) (describing how registration of a politician's name will not violate the UDRP unless the name is "trademarked or trademarkable").

232. *See, e.g.*, *Roberts v. Boyd*, No. D2000-0210, 2000 WL 33674395 (WIPO Arb. & Mediation Ctr. May 29, 2000) (finding that Julia Roberts had acquired a common law trademark in her name and transferring <juliaroberts.com> to the actress).

233. 15 U.S.C. § 1125(d)(1)(B)(i)(II); UDRP, *supra* note 215, § 4(c)(ii).

For example, one registrant, Michael Urvan, who had been known as “Sting,” prevailed in a UDRP action against Gordon Sumner, the former bassist and lead singer of The Police, even though Sumner was arguably the more famous “Sting.”<sup>234</sup>

Both the ACPA and the UDRP insert a productive use requirement as an equitable limit on the ownership of a domain name, much the same way that adverse possession serves as an equitable limit on the warehousing of real property.<sup>235</sup> The simple economic story about the alienation of property presupposes that, so long as transaction costs are sufficiently low, it matters not who initially holds the property right, because the highest-value user will be able to negotiate for the property.<sup>236</sup> Inserting a cause of action for trademark owners into the domain name registration process suggests a distrust of the market in reaching the most efficient result.<sup>237</sup>

*D. Mud and Crystals in Property Acquisition Regimes*

As discussed above, the property right in a trademark must be consistently re-earned through productive use, while real property acquired through adverse possession can be held idle for the most part. The regimes also differ importantly in their clarity about how long it takes to secure those rights. The initial acquisition of a descriptive mark must be continuous for long enough to develop secondary meaning, prior to competing uses by others. The Patent and Trademark Office has the discretion, under section 2(f) of the Lanham Act, to treat a descriptive term as though it has acquired secondary meaning and grant a registration based on five years of substantially exclusive and continuous use of the mark. Outside that soft presumption,<sup>238</sup> there is little clarity regarding how long it will take the mark owner to obtain secondary meaning, commercial strength, or fame in the market. In fact, courts continuously disclaim that any given amount of time is either sufficient or necessary to develop secondary meaning.<sup>239</sup> This is different than the adverse possession regime, where every state sets a clear, statutorily defined period after which the adverse possessor’s use will lead to a transfer of rights.

In considering the development of property rules over time, Carol Rose describes some rules as formal, hard-edged, and occasionally

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234. *Sumner v. Urvan*, No. D2000-0596, 2000 WL 33939204 (WIPO Arb. & Mediation Ctr. Jul. 24, 2000).

235. *See supra* note 204.

236. *See Chander, supra* note 208, at 720 (explaining that as long as transaction costs are minimal an “efficient outcome will be reached”).

237. *Id.* at 781–91.

238. *See supra* notes 101–03 and accompanying text.

239. *See supra* notes 108–109 and accompanying text.

merciless.<sup>240</sup> These rules are “crystal,” providing certainty to property owners about the scope of their rights, which allows them to better plan for the future.<sup>241</sup> While the adverse possession factors might lead one to see the regime as grounding title on meeting a “muddy” or imprecise standard,<sup>242</sup> the adverse possessor’s ability to rely on a precise statutorily required period of possession before title vests provides greater certainty than trademark law’s secondary meaning inquiry. Providing the adverse possessor with a title grant commensurate with the bounds of her fence, or the property borders described in her color of title, is another relatively crystalline rule. So long as productive use occurs somewhere within the borders of the property, the bright line of borders or documentation defines the boundaries of the property right.

Comparing the regimes lays bare the muddiness inherent in the trademark system. One of the characteristics of muddy property rules is that they grant more discretion to decisionmakers after the fact,<sup>243</sup> and so for many muddy rules, it is difficult to know the scope of an entitlement until it is litigated.<sup>244</sup> In that way, the likelihood-of-confusion test is prototypically muddy.

Some facets of trademark protection are relatively crystalline, but the crystallization we see in the trademark system is undercut by common law developments in several ways. For example, the relatively clear cut distinctiveness categories are muddied when the acquisition of commercial strength becomes more dispositive than inherent strength in determining whether the mark can be enforced.<sup>245</sup> There are few periods of certainty for the mark owner to rely on in securing secondary meaning or commercial strength, which compounds the problem.<sup>246</sup> With regard to the commercial strength factor, this tendency is less troubling when viewed through the adverse possession lens because it is consistent use over time, not mere initial possession, that communicates to consumers the source

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240. See Rose, *Crystals*, *supra* note 15, at 577–78 (“Property law . . . has always been heavily laden with hard-edged doctrines that tell everyone exactly where they stand.”).

241. *Id.* at 595.

242. Guy Pessach, *Reciprocal Share-Alike Exemptions in Copyright Law*, 30 CARDOZO L. REV. 1245, 1285–86 (2008) (characterizing adverse possession as a muddy standard).

243. See Rose, *Crystals*, *supra* note 15, at 591.

244. *Id.* at 581.

245. See Beebe, *supra* note 115, at 1636 (“For example, courts found marks to be inherently weak but commercially strong in twenty-three of the opinions sampled.”).

246. See *supra* notes 101–103 and accompanying text.

significance of the mark.<sup>247</sup> With regard to the absence of a clear duration window, the adverse possession parallel helps us recognize that trademark protection is a stepped process where extended periods of use bring more extensive rights. The temporal uncertainty of the length-of-use requirement to secure trademark rights is less troubling than it might first appear because it pushes us back toward recognizing use in commerce as the foundation of trademark rights. The claim to a mark stems not from the duration of use but instead from continuation of the use, and that is as it should be.

Likewise, the tendency of most courts to weaken the presumption of strength for incontestable marks where there is an indication that the mark is in fact commercially weak muddies the rule to the benefit of competition.<sup>248</sup> Here, courts seem interested in getting “right results” where a bright-line rule might wreak havoc or work an injustice. That same instinct may motivate the guidance given examining attorneys at the USPTO to consider the type of mark before applying the section 2(f) presumption in favor of finding secondary meaning and registering a descriptive mark after five years of use.<sup>249</sup> Not every court, unfortunately, takes a close look at incontestable marks. In a handful of jurisdictions, courts presume that incontestable marks are inherently strong, based simply on registration status.<sup>250</sup> Similarly, the presumption that registered descriptive marks have acquired secondary meaning somewhat undermines the value of uncertainty about the time it takes to acquire commercial strength and secondary meaning as a way to keep the mark owner on her toes, commercially speaking.<sup>251</sup>

Trademark protection is relatively crystalline at registration, but trademark litigation, centered as it is around the likelihood-of-

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247. The law errs in exactly the other direction for assertion of trademark protection. It is not the goods defined in the registration that define the scope of protection, but the use that defines the scope of the registration. Where a mark owner fails to offer the goods or services in commerce under that mark, she will lose the registration, at least for unused goods and services. *See supra* text accompanying note 201.

248. *See, e.g., Lone Star Steakhouse & Saloon, Inc. v. Alpha of Va., Inc.*, 43 F.3d 922, 933 (4th Cir. 1995) (holding that “the district court erroneously relied on incontestability as being dispositive”).

249. *See supra* notes 101–103 and accompanying text.

250. *See, e.g., Wynn Oil Co. v. Am. Way Serv. Corp.*, 943 F.2d 595, 600 (6th Cir. 1991) (presuming the mark was strong since it had been registered and uncontested for five years); *see also infra* note 282 and accompanying text. This is inconsistent with the productive use requirement for reasons discussed in Part V.A.

251. *See Packman v. Chi. Tribune Co.*, 267 F.3d 628, 638 (7th Cir. 2001) (noting that a registered mark is presumed to have acquired secondary meaning).

confusion inquiry, muddies up the trademark right considerably. The lack of certainty regarding trademark rights may cause some problems not only for mark owners, but also for their competitors and the public.<sup>252</sup> David Fagundes has argued persuasively that more crystalline boundaries of copyright protection, which would provide greater certainty about the scope of copyright ownership, could also sharpen boundaries to help clearly delineate the public domain. For example, copyright fair use is a muddy defense.<sup>253</sup> Fagundes argues that creating clear safe harbors for fair use may aid some fair users by helping them identify activities they can clearly engage in without the permission of the copyright owner and without the fear of triggering copyright liability.<sup>254</sup>

It is not true in every case, however, that crystallization will benefit the public. For example, the Lanham Act grants constructive nationwide first use from the time a registrant files a section 1(b) “intent-to-use” (ITU) application. The ITU application thus reserves lexical space to the trademark owner prior to actual use in a way that we might find out of sync with the productive use requirement.<sup>255</sup> In *WarnerVision Entertainment Inc. v. Empire of Carolina, Inc.*,<sup>256</sup> Empire of Carolina held an ITU application to use REAL WHEELS as a mark for toy vehicles, but had not yet begun selling toys under the REAL WHEELS mark when WarnerVision began selling video cassettes packaged with toy cars under the REAL WHEELS mark.<sup>257</sup> On appeal, the Second Circuit held that Empire of Carolina could not be enjoined from using its mark in commerce, obtaining a section 1(a) use-based registration, and acquiring priority dating back to the date of the section 1(b) ITU application.<sup>258</sup> The court concluded that to allow another’s subsequent use in commerce to cut off the ability of the prior ITU applicant to develop rights in the mark would run counter to congressional intent and “encourage unscrupulous

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252. See generally David Fagundes, *Crystals in the Public Domain*, 50 B.C. L. REV. 139 (2009) (suggesting that clearer rules about the scope of copyright protection might better enable public domain uses).

253. *Id.* at 151.

254. See *id.* at 151–53 (discussing how the muddy rules involving fair use favor owners at the expense of users). I discuss a similar proposal for crystallizing trademark timelines for the public benefit in Part V.B.

255. See 15 U.S.C. §§ 1051(b), 1057(c) (2006) (describing how a trademark may be registered before use); see also *supra* notes 90–94 and accompanying text.

256. *WarnerVision Entm’t Inc. v. Empire of Carolina, Inc.*, 101 F.3d 259 (2d Cir. 1996).

257. *Id.* at 260–61.

258. See *id.* at 262 (“To permit such an injunction would eviscerate the ITU provisions and defeat their very purpose.”).

entrepreneurs to look in the record for new [intent-to-use] applications by large companies, rush in to make a few sales under the same mark,” and extort a settlement to permit the ITU applicant to proceed with its plans for the mark.<sup>259</sup>

While registration is notice-providing, granting priority based only on bona-fide intent to use the property moves somewhat far afield from the productive use principle.<sup>260</sup> But this is not much different than using color of title or fencing to set the boundaries of constructive possession. The ITU application only matures to an actual application once the mark owner uses the mark in commerce.<sup>261</sup> So long as the USPTO is diligent in assuring that ITU applications either mature to use-based applications or eventually run out of extensions, the danger posed by ITU applications is fairly limited. To the extent the USPTO has not diligently policed ITU applications, that oversight should be corrected.

In the end, predictability in property regimes, or the lack thereof, matters to both property owners and those who allegedly infringe property rights. Mark Lemley’s general rejection of analogies between real and intellectual properties is driven by a desire to focus attention on the alleged rights of the intellectual property owner, and not the free riding of the alleged infringer, when considering whether to extend the scope of intellectual property protection.<sup>262</sup> Turning away from the alleged infringer is just as monotonic as turning solely to her. Instead, we should weigh the relative value the uses bring to the table. That’s what fair use does in copyright law: preserving space for those productive uses that we might value more highly than the ability of the copyright owner to control the work or extract rents for it. Perhaps those courts reviewing asserted trademark claims have failed because they’ve missed the significance of the productive use requirement. The similarities between adverse possession and trademark acquisition, outlined in Parts I and II, ideally remind us of the importance of productive use.

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259. *Id.* (alteration in original) (quoting 2 MCCARTHY ON TRADEMARKS § 19.08[1][d] (3d ed. 1992)). Congress apparently created the intent-to-use application in part to respond to the prior muddying of the use rule which allowed registration based on token use, that is, without genuine use in commerce. Daniel R. Bereskin, Miles J. Alexander & Nadine Jacobson, *Bona Fide Intent to Use in the United States and Canada*, 100 TRADEMARK REP. 709, 717 (2010) (reporting that the “bona fide” requirement in the intent-to-use standard was designed to eliminate “token use”).

260. See Mossoff, *supra* note 74, at 423 (“This amendment to trademark law represents in principle an illegitimate ‘land grab.’”).

261. See *supra* notes 90–94 and accompanying text.

262. See Lemley, *Free Riding*, *supra* note 2, at 1068 (“The proper focus is on the intellectual property owner, not the accused infringer.”).



Part IV of this Article tackles the problem from the other side, recognizing that the differences in the regimes affirms the importance of continual use in a properly functioning trademark regime. Scholars like John Duffy argue that the value in comparing real and intellectual property comes from the attempt to unify all potential property regimes under a single umbrella, much like “the relentless push to reduce the number of natural laws so that ‘[m]ore and more apparently diverse phenomena are explained by fewer and fewer underlying principles.’”<sup>263</sup> To Duffy, unification “may help guide policymakers to wise law” because “each additional unification brings new insight.”<sup>264</sup> In light of the analysis in Part IV, I am not persuaded that unification should be our primary goal, because the exceptions can overtake the general rule.

In the end, the differences in regimes matter nearly as much as the similarities. Recognizing the productive use requirement helps clarify that our adverse possession and trademark acquisition regimes should incentivize communicative, productive use. To the extent that either regime falls short of that mark, it should be readjusted. This Article makes a few proposals in that spirit in Part V.

## V. INTERVENTIONS

From the preceding analysis, this Article proposes three main interventions, two for trademark law and one for adverse possession. First, while scholars have argued in favor of curtailing the incontestability of descriptive marks or denying protection to them altogether, the productive use analysis suggests that the process of acquiring secondary meaning is valuable both because it incentivizes productive use and because the process has a natural notice-providing function. It is critical to ensure such protection for descriptive marks is consistent with the productive use rationale. Thus, the USPTO should take a closer look at affidavits of incontestability, at least for descriptive marks, and those courts that presume a mark is strong because it is incontestable should reconsider that presumption. Second, the Article proposes various tweaks to crystallize the abandonment window as well as the time required to acquire distinctiveness or develop commercial strength and acknowledges potential problems that might result. Finally, the Article recommends moving away from the bad faith conundrum in adverse possession because the intent of the possessor has little relevance to the productivity of her use or the notice it provides.

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263. Duffy, *supra* note 5, at 1090 (quoting JOHN C. TAYLOR, HIDDEN UNITY IN NATURE’S LAWS xi (2001)).

264. *Id.*

A. *Descriptive Marks, Risk, and Reward*

Several scholars have challenged the protectability of descriptive terms as marks, both because of their inherent and irrevocable public nature, and because some descriptive marks that never acquired secondary meaning slip through the USPTO and become incontestable. The productive use rationale for trademark acquisition makes clear that these concerns are somewhat overstated (the first more so than the second), so long as productive use is actually required before descriptive marks are protected. The process for acquiring protection of, and even incontestability for, a descriptive mark is consistent with the notice function of productive use because it signals the relative value that the mark owner, competitors, and the public place on respective uses of the mark. In addition, the commercial-use requirement provides an important check on the danger of error on the part of the USPTO in granting incontestability to descriptive marks.

Some scholars have advocated abolishing protection for descriptive marks altogether. Secondary meaning is hard to prove, so banning protection of descriptive marks would arguably avoid that “nightmarish undertaking.”<sup>265</sup> Of course, courts ask the same questions when analyzing the commercial strength of an initially descriptive mark or the commercial strength of an inherently distinctive mark.<sup>266</sup> Judicial efficiency itself is no ground to deny protection to descriptive marks.

Other scholars criticize descriptive marks because the descriptive term propertized is irrevocably public, whether or not that descriptive term also comes to carry a secondary, source signifying meaning. Descriptive marks don’t have the creative bona fides of even the lowly suggestive mark, and as Lisa Ramsey notes, they never entirely shake their initial descriptive sense.<sup>267</sup> Maya Alexandri recognizes that the mark owner must labor to acquire secondary meaning in descriptive marks, but discounts that labor, on the ground that it requires no labor to initially “capture” a descriptive mark.<sup>268</sup> Alexandri fails to recognize that prior to the acquisition of secondary meaning, the descriptive mark has not been “captured” at all, just like real property has not been acquired via adverse possession until

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265. Alexandri, *supra* note 183, at 347.

266. *See supra* Part II.A; notes 33–35 and accompanying text.

267. *See* Lisa P. Ramsey, *Descriptive Trademarks and the First Amendment*, 70 TENN. L. REV. 1095, 1147 (2003) (“[D]escriptive terms used as marks do not immediately signal a brand of a product because they do not lose their original or ‘primary’ descriptive meaning when used as a mark.”); *see also* Alexandri, *supra* note 183, at 348 (discussing the benefits of eliminating descriptive trademarks).

268. Alexandri, *supra* note 183, at 357.

productive use has occurred on the property for the entire duration of the statutory period. And while a descriptive mark never entirely loses its initial descriptive meaning, this is different from suggestive or even arbitrary marks as a matter of degree, not kind. Every mark except a fanciful mark has some preexisting meaning.<sup>269</sup> Descriptive marks are protected only when the source-signifying meaning becomes the most prominent meaning, that is, when the public sees the mark as signifying goods or services from a unique source. These criticisms fail because they incorrectly identify the point of “capture” for the descriptive mark. This temptation is understandable, of course, because the easiest thing to know about a descriptive mark is when it was first used. It is harder to know when the mark has acquired distinctiveness until one litigates the case.

Descriptive marks have also been criticized because of a suspicion that the USPTO often fails to deny registration for descriptive *terms* that fail to acquire secondary meaning,<sup>270</sup> particularly in the context of section 2(f) applications to register a mark and section 15 affidavits to establish incontestability. For example, Suman Naresh considers the possibility that incontestability might be justified by a societal interest in settling claims (one of the rationales identified earlier to support adverse possession),<sup>271</sup> but concludes that the public cannot consent to the acquisition of an incontestable mark through its collective inaction because there is no well-placed public actor to oppose the march to incontestability.<sup>272</sup>

Recent controversies in the news highlight, however, that neighbors often raise a hue and cry when they detect adverse

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269. See *supra* notes 29–30, 111, 113–114, 135–137 and accompanying text.

270. See, e.g., *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 211 (1985) (Stevens, J., dissenting) (discussing the congressional intent relating to descriptive trademarks); Naresh, *supra* note 6, at 982–91 (discussing in detail incontestability and adverse possession).

271. See *supra* notes 48–51 and accompanying text.

272. See Naresh, *supra* note 6, at 988–89 (finding the visibility of the process by which the mark becomes incontestable insufficient to support property rights, because unilateral activity is not binding unless the public consents). This position leads to problematic paralysis. Both John Locke and his forgotten foil, Robert Filmer, realized centuries ago that express consent was difficult to come by. As Alan Ryan summarized: “Long before we had secured the unanimous agreement of the world’s inhabitants to our taking a mouthful of water, we should have perished of thirst.” ALAN RYAN, *PROPERTY AND POLITICAL THEORY* 17 (1984). Filmer argued that no one could own or use anything if she had to acquire explicit consent from the rest of humanity. *Id.* at 16–17 (citing ROBERT FILMER, *PATRIARCHA* (London, 1680)). Locke responded to the consent conundrum by arguing that individuals “acquire a title to what they need by mixing their labor with the things they acquire.” *Id.* at 17 (citing LOCKE, *supra* note 57, at 306–07).

possession, and this activity drastically increases the odds that the title owner will be on notice of the attempted acquisition.<sup>273</sup> In the trademark context, the public is actually empowered to *do* something, as discussed in detail in Part III. Public use will pull a mark into ex post genericness or prevent descriptive terms from acquiring distinctiveness if the public has begun or proceeds to use the mark predominantly in its descriptive sense.<sup>274</sup> Likewise, a competitor can successfully oppose registration of a mark that the competitor needs to use descriptively in its business, or for which the putative mark owner has not acquired distinctiveness.<sup>275</sup> The five years required between a successful section 2(f) application and the section 15 affidavit of incontestability provides competitors an even longer window to challenge the problematic mark. The public and potential competitors acquiesce every time an adverse possessor acquires title without objection and every time the trademark owner acquires protection in a descriptive mark unopposed. If ten or more years pass by and no one says anything, the silence itself may be telling.

Here, Eduardo Peñalver and Sonia Katyal's perceptive take on risk and reward is helpful. The uncertainty faced by the adverse possessor signals how much she values the property.<sup>276</sup> Likewise, the putative owner of a "descriptive mark" signals how much she values the mark by her willingness to take on such an uncertain proposition. In order for a descriptive mark to become incontestable, the mark owner must get past potential competitors on two different levels. First, the mark must acquire distinctiveness, which the USPTO presumes can occur in many cases within five years. Then, the registration must remain effectively unopposed for an additional five years. If the mark owner passes both barriers, she will do so at least in part because neither the public nor competitors see enough value in other potential meanings to challenge the mark owner's claimed meaning over an extended period of time.<sup>277</sup>

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273. Casey Norton, *Stranger Moves into Foreclosed Home, Citing Little-Known Texas Law*, KHOU (July 15, 2011, 6:43 AM), <http://www.khou.com/home/Stranger-moves-into-foreclosed-home-citing-little-known-Texas-law.html>.

274. See *supra* notes 175–179 and accompanying text.

275. Both competitive need and skepticism about claimed secondary meaning may have motivated Continental Airlines to oppose United Airlines' application to register E-TICKET for computerized reservation and ticketing of transportation services. *Cont'l Airlines Inc. v. United Air Lines, Inc.*, 53 U.S.P.Q.2d (BNA) 1385 (T.T.A.B. 1999).

276. See *supra* notes 62–63 and accompanying text. Lee Anne Fennell's goal of limiting adverse possession to those cases where there is a clear signal of greater value of the property in the hands of the adverse possessor is also consistent with this rationale. See Fennell, *supra* note 49, at 1039–41.

277. *But see* Jess Gupta, Comment, *Descriptive Trademarks and the Assumption of Risk*, 45 U.S.F. L. REV. 811, 812 (2011) (“[A] person or

There is some cost to competitors to follow trademark registrations, check USPTO publications, and watch for competition in the marketplace. The willingness of competitors to engage in such work is a signal that tells us how much, if at all, they value the putative mark, either as a source signifier for their own goods, or merely to describe their products or services. Competitor interest in turn is a proxy for whether it is necessary to use the symbol to communicate with consumers, or whether there might be multiple ways to communicate with consumers. It may also suggest that consumers identify the mark as designating a source for the owner's goods and services.<sup>278</sup> Thus, the effort it takes to secure rights in the descriptive mark over time is itself information forcing in the same way that adverse possession is information forcing.<sup>279</sup>

In this light, incontestability for descriptive marks seems less problematic if a competitor who needs access to the descriptive term will encounter the mark early enough to thwart the initial registration of a descriptive mark by either challenging the section 2(f) affidavit of acquired secondary meaning,<sup>280</sup> or challenging the mark prior to incontestability. Ten or more years of silence thus operate like an adverse possession window that not only settles the mark owner's claim to the rights that come with incontestability, but also sends a signal "to all the world" about the value that the mark owner, competitors, and the public place on the mark.

More generally, granting benefits to registrants is consistent with the notice function of productive use, but the notice function of registration is not strong enough to make registration alone sufficient to secure protection in a trademark. There is a danger that, if the USPTO rubber-stamps incontestable registrations based solely on the section 15 affidavit, incontestability will protect some marks that do not fulfill a notice function and where the mark owner has not, in fact, successfully transformed the mark into a symbol that communicates a consistent source of goods and services to consumer. Fortunately, most courts are sensitive to this issue and inquire about the commercial strength of incontestable marks before allowing the

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business that chooses to affix a descriptive mark to goods or services assumes the risk of weaker protection for that mark.”).

278. See generally Thomas R. Lee, Eric D. DeRosia & Glenn L. Christensen, *An Empirical and Consumer Psychology Analysis of Trademark Distinctiveness*, 41 ARIZ. ST. L.J. 1033 (2009) (reporting that survey participants recognized a descriptive term presented as a trademark on product packaging as a source signifier with roughly the same frequency as they recognized “inherently distinctive” terms as trademarks, while generic terms were typically not perceived as trademarks).

279. See *supra* note 17 and accompanying text.

280. 15 U.S.C. § 1052(f) (2006).

owner of the incontestable registration to enjoin the activities of competitors.<sup>281</sup> The commercial strength inquiry thus operates as a backstop to ensure a sufficient level of productive use. Those courts that persist in treating incontestable registrations as presumptively strong, without evidence of secondary meaning or commercial strength,<sup>282</sup> should reconsider.

Recognizing the productive use rationale may also require some remedial action by the USPTO and Congress. Currently, the policy with regards to a section 15 affidavit is neither to examine nor accept the affidavit.<sup>283</sup> The office merely reviews the affidavit to make sure it meets statutory requirements on its face. Those requirements include a statement that the mark has been used in commerce, there are no final decisions adverse to the owner's claim of ownership, and there are no pending proceedings against the mark.<sup>284</sup> The USPTO and its examiners should, and can, do more. As discussed above,<sup>285</sup> examiners are instructed to consider the amount of time it might reasonably take for different types of marks to acquire distinctiveness. Those types of marks less likely to serve an independent notice function are subject to increased scrutiny before the Examiner will grant a section 2(f) Application to register a descriptive mark.

The same scrutiny could be applied to section 15 affidavits. Given that inherently distinctive marks more naturally fulfill the notice function of productive use, it would be consistent with the productive use framework, and reasonable as a matter of judicial efficiency, to limit an in-depth inquiry to section 15 affidavits for descriptive marks.<sup>286</sup> Those marks are less likely to have acquired significant

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281. *See, e.g.*, *Lone Star Steakhouse & Saloon, Inc. v. Alpha of Va., Inc.*, 43 F.3d 922, 933–35 (4th Cir. 1995) (analyzing case law and rejecting the presumption that an incontestable mark has acquired commercial strength).

282. *See Wynn Oil Co. v. Am. Way Serv. Corp.*, 943 F.2d 595, 600 (6th Cir. 1991) (“Since Wynn’s mark had been registered over five years without being contested, it was presumptively strong.”); *Dieter v. B & H Indus. of Sw. Fla.*, 880 F.2d 322, 329 (11th Cir. 1989) (“Because Dieter’s mark is incontestable, then it is presumed to be at least descriptive with secondary meaning, and therefore a relatively strong mark.”).

283. *Maintain/Renew a Registration: How to Keep Registration Alive*, U.S. PATENT & TRADEMARK OFF., <http://www.uspto.gov/trademarks/process/maintain/prfaq.jsp> (last modified Aug. 21, 2012, 7:53 AM) (“The USPTO neither examines the merits of § 15 Declarations nor ‘accepts’ § 15 Declarations.”).

284. *Id.*

285. *See supra* notes 101–103 and accompanying text.

286. One could further narrow the inquiry by focusing on only those marks registered pursuant to section 2(f) of the Lanham Act. 15 U.S.C. § 1052(f) (2006).

levels of commercial strength, and the close review of affidavits to register those marks will likely prevent much of the perceived problem.<sup>287</sup>

*B. Crystallizing Trademark Timelines*

One possible reform stemming from the productive use analysis is to get serious about crystallizing trademark rights.<sup>288</sup> Crystallizing the length of time required to acquire secondary meaning or commercial strength would provide some certainty for the mark owner, at least as to the amount of time she has to bring the mark up to a sufficient level of commercial productivity. It could also provide some certainty for the public and potential competitors.

It might be difficult to create a one-size-fits-all secondary meaning window, but consider the result if we treated the section 2(f) presumption that a descriptive term acquires secondary meaning and can be registered after five years of substantially continuous and exclusive use as a hard floor for the amount of time *required* to secure secondary meaning in a descriptive mark. The public and competitors would know that the owner must use the mark in commerce for a minimum of five years before the mark could be effectively enforced against arguable infringers. If descriptive marks are troubling because they are derived from broad, descriptive terms needed for competition, then the hard floor might do a better job preserving space for competitors and the public to make productive use of a given descriptive term, up through the last day of the five year period. Such a regime might disincentivize the adoption of descriptive marks closer to the suggestive line, for which the mark owner could otherwise establish secondary meaning in less than five years, and those may be the wrong descriptive marks to discourage. But to the extent that we think the public benefits when competitors utilize descriptive terms without the permission of prior users, the harm to the trademark owner created by such a floor might be offset by broadening the catalogue of marks that effectively remain in the public domain for descriptive use.

There is a danger inherent in crystallization, however. This same five-year window could be crystallized in a way that favors mark owners. The five-year window could be treated as a safe harbor for mark owners who adopt inherently distinctive marks. For the first five years, courts would presume the inherently strong mark was also commercially strong. Thus, so long as the mark reaches a reasonable level of commercial strength within five years, the mark would be

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287. *See supra* note 126.

288. *See discussion supra* Part IV.D regarding how crystalline and muddy property rules manifest in the adverse possession and trademark regimes.

presumed strong, and likely to prevail more often in infringement suits.<sup>289</sup> Finally, one potentially costly result of either crystallization is that courts would be required to determine whether a mark was descriptive or suggestive—which is notoriously difficult<sup>290</sup>—because the five-year floor would cut in favor of the inherently strong, suggestive mark but against the inherently weak, descriptive mark.<sup>291</sup>

Consider a second possible crystallization: if more frequent abandonment of trademarks for nonuse is in the public interest, we might stiffen the abandonment test outlined in section 45 of the Lanham Act.<sup>292</sup> Currently, the presumption that the mark is abandoned after three years of nonuse is easily overcome by evidence that the mark owner intends to resume use—a fairly low standard.<sup>293</sup> Instead of treating three years of nonuse as *prima facie* evidence of abandonment, we could treat it as conclusive evidence of abandonment.

Carol Rose posits that courts tend to muddy crystalline rules to prevent forfeiture and protect sympathetic parties from the consequences of their bargains.<sup>294</sup> Therefore, it would not be surprising

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289. *Cf.* Joseph P. Liu, *Copyright and Time: A Proposal*, 101 MICH. L. REV. 409, 464 (2002) (proposing that copyright's fair use analysis should be sensitive to how long the copyrighted work has been around, and perhaps protect younger works more robustly than older works).

290. *See, e.g.*, *BigStar Entm't, Inc. v. Next Big Star, Inc.*, 105 F. Supp. 2d 185, 198–202 (S.D.N.Y. 2000) (musing that “the vague boundary that divides suggestive and descriptive terms” has “bedeviled many . . . judges”).

291. *See, e.g.*, *Valmor Prods. Co. v. Standard Prods. Corp.*, 464 F.2d 200, 202 (1st Cir. 1972) (concluding that while a laudatory mark was likely suggestive, it didn't matter because forty-five years of advertising was sufficient to establish “a close connection between the trademark name and its products” (quoting district court below)).

292. 15 U.S.C. § 1127 (2006) (defining “abandonment”).

293. *See, e.g.*, *Zelinski v. Columbia 300, Inc.* 335 F.3d 633, 639 (7th Cir. 2003) (mark owner can rebut the presumption of abandonment by “demonstrating the lack of an intent not to resume use,” and did so by discussing the production of his branded bowling balls with two other companies (quoting *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 955 (7th Cir. 1992))).

294. Rose, *Crystals*, *supra* note 15, at 597–98. There is evidence of this tendency in other intellectual property contexts. *Cf.* Andrew Gilden, *Copyright Essentialism and the Performativity of Remedies*, 54 WM. & MARY L. REV. (forthcoming 2013) (manuscript at 24–25), available at <http://ssrn.com/abstract=2121938> (arguing that courts refrain from finding infringement in order to avoid granting an “unworkable remedy”); Jake Linford, *A Second Look at the Right of First Publication*, 58 J. COPYRIGHT SOC'Y U.S.A. 585, 604–10 (2011) (noting that courts crafted the concept of limited publication in part to avoid



to see courts act in like manner when faced with a floor for the acquisition of secondary meaning, the loss of acquired strength, or a bright-line abandonment rule.<sup>295</sup> Thus, if Congress embraces the challenge to create more crystalline timelines in the Lanham Act, it may need to clearly bar any “muddying” of those timelines by courts.

*C. Adverse Possession: Productive Use over Bad Faith*

Finally, as discussed briefly in Part II.B, courts and scholars are in disagreement about whether an adverse possessor must also show a particular intent to possess property either innocently (in “good faith”) or intentionally (in “bad faith”).<sup>296</sup> Whether or not to consider an adverse possessor’s subjective intent has devoured a great deal of intellectual oxygen.<sup>297</sup> Scholars have questioned whether we should treat good faith adverse possessors more preferentially than bad faith adverse possessors,<sup>298</sup> and whether courts actually favor good faith adverse possessors, regardless of what a given statute or judge-made test might say about the claim of right.<sup>299</sup>

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the harsh consequences of finding a copyrighted work had been published without proper notice and thus fell into the public domain).

295. We actually see such resistance to even the soft abandonment rule currently in place. *See, e.g.*, *Prudential Ins. Co. of Am. v. Gibraltar Fin. Corp. of Cal.*, 694 F.2d 1150, 1156 (9th Cir. 1982) (“Abandonment of a trademark, being in the nature of a forfeiture, must be strictly proved.”).

296. SINGER, *supra* note 20, § 4.2.5 at 151–52.

297. *See, e.g., id.* § 4.2.5 at 151 (“Of all the elements of adverse possession, the adversity requirement has given rise to the most confused and varied treatment.”).

298. Compare Richard A. Epstein, *Past and Future: The Temporal Dimension in the Law of Property*, 64 WASH. U. L.Q. 667, 687–88 (1986) (suggesting a two-tiered adverse possession statute of limitations, shorter for good faith possessors and longer for bad faith possessors), with Fennell, *supra* note 49, at 1039–41 (arguing that only those “bad faith” adverse possessors who can show they would have paid for the property in question, and thus are possessing only to correct an apparent market failure, should be allowed to adversely possess the property).

299. Richard Helmholz has argued, based on his historical analysis of adverse possession cases, that whether or not courts explicitly acknowledge it, they favor the claims of good faith adverse possessors. R.H. Helmholz, *Adverse Possession and Subjective Intent*, 61 WASH. U. L.Q. 331, 331–32 (1983). *But see* Roger A. Cunningham, *Adverse Possession and Subjective Intent: A Reply to Professor Helmholz*, 64 WASH U. L.Q. 1, 2–3 (1986) (“Professor Helmholz’s conclusions differ so greatly from generally accepted views as to justify a careful look at the cases on which he based his conclusions.” (footnote omitted)). And for a response to Professor Cunningham, see Helmholz, *supra* note 25. I find Professor Helmholz’s description persuasive. Nevertheless, the majority rule has not changed in the intervening years.

Under the majority rule in the United States, intent with regard to the record owner is irrelevant.<sup>300</sup> So long as the adverse possessor treats the property as her own, it is irrelevant whether she knows it is not her property or whether she intends to wrest it from the record owner via adverse possession. This standard is consistent with the notice function account. It is “the visible and adverse possession, with an intention to possess,” one early court decision concluded, “that constitutes its adverse character, and not the remote views or belief of the possessor.”<sup>301</sup>

Understanding that adverse possession is justified by the notice function of productive use helps clarify that we should favor good faith or bad faith possession only to the extent that one type of possession provides better notice to the public. Perhaps intent serves as a proxy for other issues bothering courts. Good faith or innocent adverse possession is often attributed to border-adjusting encroachments between neighbors, but that encroachment looks the same to the world and to the record owner whether the adverse possessor is aware of the property lines or not. Likewise, occupying property that is not coterminous with the adverse possessor’s other parcels can quickly put the public and the sufficiently attentive record owner on notice, whether or not the adverse possessor knows or cares that there is another record holder.

In other words, we should stop worrying about good faith versus bad faith adverse possession—and stop setting different time periods

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300. SINGER, *supra* note 20, § 4.2.5, at 155. Other jurisdictions adopt different approaches. A handful of jurisdictions have enacted the mistaken possession rule, under which only the good faith or mistaken adverse possessor may prevail. *See, e.g.*, N.M. STAT. § 37-1-22. Some jurisdictions require the possessor to establish her subjective state of mind via her objective acts. SINGER, *supra* note 20, § 4.2.5, at 154. Other jurisdictions follow an intentional dispossession rule (also known as the Maine rule) under which only the adverse possessor with “bad faith,” that is, the intent to dispossess, may prevail. *See, e.g.*, *Petsch v. Widger*, 335 N.W.2d 254, 260 (Neb. 1983) (“In Nebraska, intent to assert ownership of the property is a requirement of adverse possession . . .”); *Preble v. Me. Cent. R.R. Co.*, 27 A. 149, 150 (Me. 1893). While the intentional dispossession rule has been roundly criticized, it has at least one champion in Lee Anne Fennell, who asserts it is the only efficient foundation for an adverse possession regime. *Compare* *Smith v. Tippett*, 569 A.2d 1186, 1191 (D.C. 1990) (“To limit the doctrine of adverse possession to the latter type places a premium on intentional wrongdoing, contrary to fundamental justice and policy.” (quoting 7 R. POWELL, *THE LAW OF REAL PROPERTY* § 1013(2), at 9–33 (Rev. ed. 1989) *now found in* 16 RICHARD R. POWELL, *POWELL ON REAL PROPERTY* § 91.05[3] (Michael Allan Wolf ed. 2000))), *with* Fennell, *supra* note 49, at 1039–41 (explaining how adverse possession should be redesigned to require that an individual be aware of the trespass).

301. *French v. Pearce*, 8 Conn. 439, 443 (1831).

for good faith and bad faith adverse possessors<sup>302</sup>—because there is nothing inherently communicative about the intent of the adverse possessor. We might nevertheless value the possessor who occupies with color of title and records the title,<sup>303</sup> not because she is a “good faith” purchaser, but because the purchase, and the record of it, puts us on better notice of her claim.

## CONCLUSION

This Article uncovers the productive use requirement and the notice function underlying both the trademark and adverse possession acquisition regimes. In light of the similar policy needs shaping the two regimes, both regimes can merit from a move toward more clearly requiring notifying, productive use as a prerequisite to the acquisition of rights. That insight provided an opening to explore the shifting states between crystalline and muddy property rights in the trademark system and the malleable boundaries between the property rights held by trademark owners and the public in common. These discussions inform the core intervention, suggesting that some crystallization of trademark rights, particularly the time needed to acquire secondary meaning and the time after which a mark might be deemed abandoned, might benefit public and competitive uses by clarifying when rights in a trademark lexeme might shift back to the public. More generally, this project highlights the importance of resisting the temptation either to seek a unified field theory of property rights governing real, personal, and intellectual property, or to entirely reject analogies between property regimes. As we see when contrasting trademark acquisition and adverse possession, a close look at the critical features of the right regimes can pay unexpected dividends.

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302. A handful of states favor the innocent adverse possessor by allowing them to secure title by possessing for a shorter statutory period, a model championed by Richard Epstein. *Compare* LA. CIV. CODE ANN. arts. 3473, 3475 (ten-year prescription period for good faith possessor), *with* art. 3486 (thirty-year period for bad faith possessor). Thomas Merrill argues instead that the innocent adverse possessor should acquire a property right, but the bad faith adverse possessor should acquire only a liability right, which would allow her to purchase from the record owner at market value. Merrill, *supra* note 51, at 1145.

303. *See supra* notes 87–88 and accompanying text.



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