

## A Comic-Con by Any Other Name\*

### INTRODUCTION

“What’s in a name?”<sup>1</sup> When Shakespeare’s Juliet posed the rather forlorn question, she was undoubtedly not contemplating U.S. trademark law, but perhaps she should have been. As it turns out, quite a lot is in a name. While it is possible that “a rose [b]y any other name would smell as sweet,”<sup>2</sup> everyone ought to be able to call the flower by its common, or generic, name. This notion is woven into trademark law, which prohibits trademark ownership and rights in generic terms. Such a mark belongs not to Juliet or Romeo, but to the general public.

Yet, in the case of *San Diego Comic Convention v. Dan Farr Productions*<sup>3</sup> (“*Comic-Con*”), the United States District Court for the Southern District of California seemed to lose sight of this basic principle. The court addressed the question of whether an incontestable trademark, the mark “COMIC-CON,” could be challenged as void ab initio on the basis that the alleged mark had *always* been generic, thus invalidating its registration and incontestability status.<sup>4</sup> The court failed to conclusively answer this question, though it strongly opposed allowing the argument that the “COMIC-CON” mark was generic ab initio to proceed.<sup>5</sup>

This Recent Development will focus on why the *Comic-Con* court, and courts in general, should accept genericness ab initio<sup>6</sup> as a valid defense. The benefits of allowing such a defense outweigh the negative effects of leaving the defense in legal limbo or denying it entirely. By validating the defense, courts would grant stronger protections to defendants and better align the incontestability doctrine with the goals of trademark law, which seek neither to create monopolies nor unnecessarily restrict speech.

The following analysis will proceed in four parts. Part I will present the background law concerning trademarks, genericness, and incontestability, as well as give the facts and holding of the *Comic-Con*

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1. WILLIAM SHAKESPEARE, *ROMEO & JULIET* act 2, sc. 2.

2. *Id.*

3. No. 14-CV-1865-AJB-JMA, 2018 WL 4091734, at \*1 (S.D. Cal. Aug. 23, 2018).

4. *Id.* at \*3.

5. *Id.*

6. Throughout this Recent Development, generic ab initio and genericness ab initio will be used interchangeably and mean the same thing.

court. Part II will analyze the current statutory and case law pertaining to an argument of genericness *ab initio*. Part III will discuss the policy considerations behind either allowing or disallowing the defense. Finally, Part IV will consider the ramifications of adopting a defense of genericness *ab initio* and argue for such adoption.

#### I. BACKGROUND:

The Lanham Act is the federal statutory scheme that governs registered and unregistered trademarks and service marks.<sup>7</sup> The Act establishes rules and procedures for their registration, infringement, cancellation, and ownership rights.<sup>8</sup> A trademark “includes any word, name, symbol, or device, or any combination thereof . . . used by a person . . . to identify and distinguish his or her goods” or services from the goods or services of others.<sup>9</sup> Federal trademark registration provides broad protection since registration on the principal register serves as *prima facie* evidence of the mark’s validity, the exclusive right of the owner to use the mark, and of the registrant’s ownership of the mark itself.<sup>10</sup>

An incontestable trademark, which provides “conclusive evidence of the validity of the registered mark,” offers increased protection to the holder.<sup>11</sup> Once a trademark has been registered, the process of obtaining this higher level of protection is surprisingly simple.<sup>12</sup> The trademark holder need only file a § 15 affidavit affirming that the mark complies with the minimal requirements set forth under § 1065 (section 15 of the Lanham Act) and the holder has used it in commerce for five consecutive years.<sup>13</sup> Once a trademark is incontestable, it may only be challenged under the defenses listed under § 1115.<sup>14</sup> However, “no substantive review procedure

7. See Trademark Act of 1946, ch. 540, 60 Stat. 427, 427–46 (codified as amended at 15 U.S.C. §§ 1051–1127 (2012)).

8. See *id.*

9. 15 U.S.C. § 1127 (2012).

10. See *id.* § 1057(b).

11. *Id.* § 1115(b).

12. See Kenneth L. Port, *The Illegitimacy of Trademark Incontestability*, 26 IND. L. REV. 519, 535 (1993).

13. See 15 U.S.C. § 1065 (2012); Port, *supra* note 12, at 535. The affidavit should specify that the mark has been in use for five consecutive years in connection with the registered goods, that there has not been a “final decision adverse to the owner’s claim of ownership” in the mark, and that there is not a proceeding against those rights pending at the United States Patent and Trademark Office (“USPTO”). 15 U.S.C. § 1065(1)–(3).

14. See 15 U.S.C. § 1115 (2012) (stating that a defense to incontestability status exists if (1) the registration was obtained fraudulently; (2) the mark was abandoned; (3) the mark was used to misrepresent the source; (4) the use was fair; (5) the mark is subject to a junior user limited territoriality defense; (6) the mark was previously registered; (7) “the mark has been or is being used to violate [U.S.] antitrust laws”; (8) the mark is functional; and (9) laches, estoppel, or acquiescence are applicable).

by the Patent and Trademark Office” is required.<sup>15</sup> Due to the lack of review and strong protection offered by incontestability status, “the cost to the public of a single faulty incontestability designation may be higher than the cost” of a broader registration since a registrant can “use incontestability as leverage in disputes.”<sup>16</sup> Therefore, an erroneous grant of incontestability status not only demands a high price from the public by removing words unduly from the public domain but also is an error that is not easily fixed as the mark is insulated from most challenges.

Recognizing the power of the incontestability doctrine, Congress prohibited some marks from ever obtaining this level of protection. Most notably, marks that are generic, meaning that they “refer[] to the genus of which the particular product is a species,”<sup>17</sup> cannot be registered as trademarks, and if at any time a mark becomes generic, it may be cancelled.<sup>18</sup> The bar against the registration of generic trademarks is so pervasive that Congress embedded the notion in § 1065(4), which sets out the requirements for incontestability, by stating that “no incontestable right shall be acquired in a mark which is the generic name for the goods or services or a portion thereof, for which it is registered.”<sup>19</sup> Yet what would happen if an arguably generic mark somehow slipped through the cracks and not only was registered but gained incontestable status?

The United States District Court for the Southern District of California had a chance to consider this question twice in *Comic-Con* and failed to come to a conclusive decision both times. The plaintiff, San Diego Comic Convention, owns an incontestable trademark in the term “COMIC-CON.”<sup>20</sup> The plaintiff sued the defendant, Dan Farr Productions (“DFP”), which ran a similar event called Salt Lake Comic-Con, for infringement.<sup>21</sup> DFP countered with a claim that the term “COMIC-CON” was generic ab initio for the name of a comic convention and thus the trademark should be

15. Port, *supra* note 12, at 535.

16. Rebecca Tushnet, *Fixing Incontestability: The Next Frontier*, 23 B.U. J. SCI. & TECH. L. 434, 451 (2017). See 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:140 (5th ed. 2019) (“[T]he Section 15 affidavit or declaration of incontestability filed by the registrant is not examined on its merits by the U.S.P.T.O. For example, the U.S.P.T.O. does not determine the truth of the registrant’s statement that there is no final decision adverse to the owner’s claim of ownership of the mark or to the owner’s right to register or keep the mark on the register.”).

17. *Park ’N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985) (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976)).

18. 15 U.S.C. § 1064(3) (2012).

19. *Id.* § 1065(4).

20. *San Diego Comic Convention v. Dan Farr Prods.*, No. 14-CV-1865-AJB-JMA, 2018 WL 4091734, at \*1 (S.D. Cal. Aug. 23, 2018).

21. *Id.*

cancelled or alternatively that the mark had become generic.<sup>22</sup> The court initially denied DFP's genericness ab initio argument,<sup>23</sup> and later upheld this decision during a motion for a new trial.<sup>24</sup> The court noted that "it [was] not clear" that genericness ab initio constituted an available defense to an incontestable trademark registration.<sup>25</sup> Despite the defendant's argument that § 1065(4) allowed for such a cancellation, the section of the statute in question only "repeat[ed] the well-established tenet that a trademark cannot become incontestable if it is the generic name for the goods or services."<sup>26</sup> With that short statement, the court stopped its analysis of whether the defense should be available at all and held that, even if such an argument were allowed, DFP could not have met its burden of proof.<sup>27</sup>

Although the *Comic-Con* court refused to decide definitively whether a genericness ab initio defense to an incontestable trademark is ever permitted, it noted that it was "unpersuaded that Ninth Circuit precedent allow[ed]" for such a defense and that "it [was] not clear in the statute" nor in case law that the defense was permissible.<sup>28</sup> The court then proceeded to scold the defendant for mischaracterizing the statute and held that there was no distinction within the statute between genericness and generic ab initio.<sup>29</sup> An analysis of the various sections of the Lanham Act, however, and the rationale of other courts in considering the issue indicates that a defense of genericness ab initio ought to be permissible.

## II. GENERIC AB INITIO: A VIABLE DEFENSE

### A. Statutory Analysis

The *Comic-Con* court noted that § 1065 does not, on its face, provide for a defense of genericness ab initio for an incontestable trademark. However, a close reading of the Lanham Act suggests that such a defense is entirely consistent with its meaning. As noted above, a generic mark cannot receive trademark protection.<sup>30</sup> Reaffirming this notion, § 1065(4) states "no incontestable right shall be acquired in a mark which is the generic

22. *Id.* at \*11–12.

23. *San Diego Comic Convention v. Dan Farr Prods.*, No. 14-CV-1865 AJB (JMA), 2017 WL 4227000, at \*9 (S.D. Cal. Sept. 22, 2017).

24. *San Diego Comic Convention*, 2018 WL 4091734, at \*11.

25. *Id.* at \*12.

26. *Id.*

27. *Id.* at \*11.

28. *Id.* at \*11–12.

29. *Id.* at \*12.

30. *See Delaware & Hudson Canal Co. v. Clark*, 80 U.S. (13 Wall.) 311, 323 (1871); *see also Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

name for the goods or services . . . for which it is registered.”<sup>31</sup> Additionally, although not listed explicitly as one of the nine enumerated available defenses to an incontestable mark, § 1115(b) references, and thereby includes, § 1065(4).<sup>32</sup> Notably, § 1064(3) further provides that a registered mark “becomes the generic name for the goods or services” and may be cancelled “*at any time*.”<sup>33</sup>

A close reading of the statute seems to establish two types of genericness, both of which disqualify a potential mark for trademark protection: genericide and generic *ab initio*. Section 1064(3) encompasses the notion of genericide, which focuses on the issue of whether a once-valid trademark has since *become* generic.<sup>34</sup> This idea is typically applied to “coined” and arbitrary terms that, “through common usage,” become synonymous with the product itself.<sup>35</sup> Known victims of genericide include marks such as “CELLOPHANE” and “ESCALATOR.”<sup>36</sup> The second defense, generic *ab initio*, is the defense at issue here. *Black’s Law Dictionary* defines *ab initio* as “[f]rom the beginning.”<sup>37</sup> Thus “[a] mark is generic *ab initio* if it is generic at the time the company adopted it as a trademark.”<sup>38</sup> A reading of § 1065(4) and the accepted notion that generic terms may not receive trademark protection gives rise to this theory of defense since, unlike genericide, such a defense focuses on the notion that the alleged mark has *always* been generic and thus was granted trademark protection and incontestability status erroneously.

Statutory analysis of §§ 1063(3) and 1065(4) reveals Congress’s intent to prevent generic marks from *ever* receiving trademark protection, and the allowance of a defense of genericness *ab initio* would align with that intent.<sup>39</sup> As Justice Stevens noted in his dissent in *Park ’N Fly, Inc. v.*

31. 15 U.S.C. § 1065(4) (2012).

32. *See id.* § 1115(b) (“To the extent that the right to use the registered mark has become incontestable under section 1065 of this title, the registration shall be conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark in commerce.”); 6 MCCARTHY, *supra* note 16, § 32:149. Although defendants themselves cannot cancel a trademark, once accused of infringement, defendants may counterclaim and seek the cancellation of a mark. *See, e.g., Park ’N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 192 (1985) (explaining how the question of cancellation came before the court).

33. 15 U.S.C. § 1064(3) (2012) (emphasis added).

34. *See id.*; *see, e.g., Pods Enters., Inc. v. U-Haul Int’l, Inc.*, No. 8:12-CV-01479-T-27MAP, 2015 WL 1097374, at \*2 (M.D. Fla. Mar. 11, 2015).

35. *See Pods Enters.*, 2015 WL 1097374, at \*2.

36. 6 MCCARTHY, *supra* note 16, § 11:9.

37. *Ab Initio*, BLACK’S LAW DICTIONARY (10th ed. 2014).

38. *Pods Enters.*, 2015 WL 1097374, at \*2 (first citing *Schwan’s IP, LLC v. Kraft Pizza Co.*, 460 F.3d 971, 974 (8th Cir. 2006); and then citing *Miller Brewing v. G. Heileman Brewing Co.*, 561 F.2d 75, 77 (7th Cir. 1977)).

39. *See infra* Part IV.

*Dollar Park & Fly, Inc.*,<sup>40</sup> incontestability “cannot convert unregistrable subject matter into a valid mark.”<sup>41</sup> By refusing to allow a defense of generic ab initio, courts undermine that goal.

While genericness ab initio is not listed specifically as a defense like genericide is in § 1064(3),<sup>42</sup> this is likely because Congress did not perceive such a need to include it.<sup>43</sup> After all, unlike genericide claims in which the mark was originally distinctive but became generic over time, trademarks subject to a defense of genericness ab initio should never have become trademarks in the first place and therefore should not have needed an enumerated defense.<sup>44</sup> Although the *Comic-Con* court dismissed this argument and held that § 1065(4) merely restated the known rule that an incontestable trademark cannot be grounded in a generic term,<sup>45</sup> the dismissal does little to undermine the argument that the defense should be available. Even if the subsection is restating a known rule, the rule still establishes that no valid trademark can be upheld in a generic term.<sup>46</sup> By failing to recognize a defense of genericness ab initio, the court effectively prevents defendants from arguing that the mark itself is invalid and always has been.

### B. Case Law

There is little case law surrounding the admissibility of a defense of genericness ab initio against an incontestable mark. While some courts have refrained from coming to a conclusive decision, others have acknowledged the defense.<sup>47</sup> The split in decisions indicates that there is no strong precedent for accepting this defense. However, as with the statutory subsections themselves, when taken together, the cases illustrate compelling reasons to allow the defense.

40. 469 U.S. 189 (1985).

41. *Id.* at 208–09 (Stevens, J., dissenting).

42. *See* 15 U.S.C. § 1064(3) (2012).

43. *See* Ron Coleman, *Back from the Void*, LIKELIHOOD OF CONFUSION (Mar. 9, 2017), <http://www.likelihoodofconfusion.com/back-from-the-void/> [<https://perma.cc/4M73-F68U>].

44. *See id.*

45. *San Diego Comic Convention v. Dan Farr Prods.*, No. 14-CV-1865-AJB-JMA, 2018 WL 4091734, at \*12 (S.D. Cal. Aug. 23, 2018).

46. *See id.*

47. *See, e.g.,* *Te-Ta-Ma Truth Found.—Family of URI, Inc. v. World Church of the Creator*, 297 F.3d 662, 665 (7th Cir. 2002); *Pods Enters., Inc. v. U-Haul Int’l, Inc.*, No. 8:12-CV-0179-T-27MAP, 2015 WL 1097374, at \*7 (M.D. Fla. Mar. 11, 2015) (abstaining from deciding the status of the defense).

1. To Decide or Not to Decide—That Is the Question<sup>48</sup>

In refusing to come to a definitive decision on whether or not to allow a genericness ab initio defense, the *Comic-Con* court seemed to find comfort in the fact that other courts had similarly abstained.<sup>49</sup> The *Comic-Con* court noted that in *Pods Enterprises, Inc. v. U-Haul International, Inc.*,<sup>50</sup> the issue had similarly been left undecided when the court was presented with a generic ab initio defense.<sup>51</sup> The *Pods* court held that the admissibility of a generic ab initio defense did not need to be decided because “even assuming that an incontestable trademark [could] be canceled on the ground that it was generic when adopted,” the defendant failed to meet its burden of proof.<sup>52</sup> The *Comic-Con* court came to nearly the same conclusion.<sup>53</sup> However, had the court further analyzed the issue beyond the *Pods* rationale, it would have run into additional case law and would perhaps have suggested that a generic ab initio defense should be permissible. While the case law addressing a defense of genericness ab initio is thin, numerous courts have decided upon similar void ab initio defenses against incontestable trademarks in a manner that provides substantial guidance on the issue.<sup>54</sup>

## 2. A Growing Defense

The instances in which other courts have embraced the genericness ab initio defense closely mirror the issue presented to the *Comic-Con* court and thus, lend support to the admissibility of the defense. The Seventh Circuit in *Te-Ta-Ma Truth Foundation—Family of URI, Inc. v. World Church of the Creator*,<sup>55</sup> held that while “an incontestable mark may be enforced even if it is descriptive, it is subject to cancellation if it is, or subsequently becomes generic.”<sup>56</sup> Although eventually deciding the mark at issue was not generic, the Seventh Circuit recognized the generic ab initio defense as separate from genericide by distinguishing a mark that *is* generic from one that *becomes* generic. Further, the court insinuated that both defenses were sufficient to cancel the allegedly generic mark. This interpretation is strengthened by the court’s later statement that “an

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48. See WILLIAM SHAKESPEARE, *HAMLET* act. 3, sc. 1.

49. See *San Diego Comic Convention*, 2018 WL 4091734, at \*12.

50. 2015 WL 1097374, at \*1.

51. *San Diego Comic Convention*, 2018 WL 4091734, at \*12 (citing *Pods Enters.*, 2015 WL 1097374, at \*3).

52. *Pods Enters.*, 2015 WL 1097374, at \*3.

53. See *San Diego Comic Convention*, 2018 WL 4091734, at \*11–12.

54. See, e.g., *Te-Ta-Ma Truth Foundation—Family of URI, Inc. v. World Church of the Creator*, 297 F.3d 662, 665 (7th Cir. 2002).

55. *Id.*

56. *Id.* at 665.

incontestable mark does not confer any rights to a phrase that was generic at the outset or has become so through use.”<sup>57</sup>

Similarly, the Second Circuit recognized the availability of the generic ab initio defense in the case of *Harley Davidson, Inc. v. Grottanelli*.<sup>58</sup> The court held that the plaintiff’s trademark “HOG” in reference to motorcycles was, and had always been, generic and was thus subject to cancellation.<sup>59</sup> “Even the presumption of validity arising from federal registration . . . cannot protect a mark that is shown on strong evidence to be generic as to the relevant category of products prior to the proprietor’s trademark use and registration.”<sup>60</sup> The court noted that case law forbids giving a mark that “starts out generic.”<sup>61</sup> Although the Second Circuit never expressly used the words “generic ab initio,” its reasoning and final conclusion strongly favor allowing such a defense.

Applying the logic used in *Harley Davidson* to the incontestable trademark “COMIC-CON” at issue here, a defense of genericness ab initio ought to be permitted. Like the word “hog” in *Harley Davidson*,<sup>62</sup> “comic-con” is arguably a generic term for comic conventions. Thus, validity provided by registration bolstered by incontestability status, should not insulate the mark from a challenge of genericness ab initio. While “strong evidence” may be needed to succeed on the merits of such a claim,<sup>63</sup> registration and incontestability should not be a bar to the availability of the defense itself.

Cases in which courts rejected an ab initio defense are distinguishable from *Comic-Con*. The only United States Supreme Court case to consider the issue of incontestability, *Park 'N Fly*, focused on Congress’s failure to enumerate mere descriptiveness as a bar to incontestability, whereas genericness is specifically listed as a bar.<sup>64</sup> In *Park 'N Fly*, the Supreme Court was asked to decide whether an incontestable mark could be challenged on the grounds that the mark was merely descriptive and lacked secondary meaning.<sup>65</sup> Similarly to a generic term, a merely descriptive mark cannot receive trademark protection.<sup>66</sup> Unlike a generic term, however, a merely descriptive term can overcome this barrier upon a

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57. *Id.*

58. 164 F.3d 806 (2d Cir. 1999).

59. *Id.* at 811.

60. *Id.* (citation omitted).

61. *See id.* at 812.

62. *See id.* at 811.

63. *Id.*

64. *Id.*

65. *See id.* at 191.

66. *See id.* at 194.



showing of acquired distinctiveness.<sup>67</sup> Although the Court held that an incontestable trademark could not be challenged on the ground that it was merely descriptive,<sup>68</sup> the reasoning behind the decision weighs in favor of allowing a defense of genericness *ab initio*.

The Court explained that there was no evidence that Congress intended to allow a challenge to an incontestable mark on the basis that it was merely descriptive<sup>69</sup>: “The Conference Committee agreed to an amendment providing that no incontestable right can be acquired in a mark that is a common descriptive, i.e., generic term. Congress could easily have denied incontestability to merely descriptive marks as well as to generic marks had that been its intention.”<sup>70</sup> Therefore, while the decision of the committee not to list descriptiveness as a bar to incontestability indicated that it was not meant to constitute a defense, by that same reasoning, genericness, even in its *ab initio* form, could constitute a defense to infringement of an incontestable statute since it is listed as a prerequisite.<sup>71</sup>

### 3. A Guiding Light

A defense of genericness *ab initio* shares more in common with the defense of functionality, for which *ab initio* arguments have been allowed,<sup>72</sup> than the defense of non-use for which such *ab initio* challenges have been denied.<sup>73</sup> Use and non-functionality, like non-genericism, must be demonstrated to initially register a trademark<sup>74</sup> and are essential

67. *See id.*

68. *See id.* at 196.

69. *See id.* at 196–97.

70. *See id.* at 197 (citations omitted) (citing H.R. REP. NO. 79-2322, at 5 (1946) (Conf. Rep.)).

71. The court later mentioned that the committee did not adopt an alteration to the statute that would “include as a defense to infringement of an incontestable mark the ‘fact that a mark is descriptive, generic, or geographical term or device.’” *Id.* at 201 (quoting *A Bill To Provide for the Registration of Trade-Marks Used in Commerce to Carry out the Provisions of Certain International Conventions, and for Other Purposes: Hearing on S. 895 Before the Subcomm. of the S. Comm. on the Judiciary, 77th Cong. 45, 47 (1942)* (statement of Elliot Moyer, Special Assistant to the Att’y Gen.)). However, the failure to adopt this language does not undermine the inference that Congress intended to allow for a generic *ab initio* defense, since the phrase in question concerned more than simply generic terms. Further, it is possible that Congress thought that no specific clause was needed within the enumerated defenses of § 1115(b) itself since (a) no generic mark was intended to become a trademark; (b) no incontestable mark may be founded in a generic term per § 1065(4); and (c) a registered mark can be canceled at any time should it become generic under §§ 1065(4) and 1064(3).

72. *See, e.g.,* Wilhelm Pudenz, GmbH v. Littlefuse, Inc., 177 F.3d 1204, 1211–12 (11th Cir. 1999).

73. *See, e.g.,* NetJets Inc. v. IntelliJet Grp., LLC, 678 F. App’x 343, 348 (6th Cir. 2017).

74. *See* 15 U.S.C. § 1051(a)(3)(c) (2012) (requiring use); *id.* § 1052(e) (barring functional trademarks); *id.* § 1127 (requiring distinctiveness); *see also* Abercrombie & Fitch Co. v. Hunting World, Inc. (2d Cir. 1976) (noting that generic marks cannot become registered trademarks since

components of obtaining incontestable status.<sup>75</sup> The three criteria differ, however, with regard to their importance or necessity in the context of registration with genericness weighing in closer to functionality than use. While a mark can be registered on an intent-to-use basis,<sup>76</sup> and thus non-use does not immediately kill it, a mark that is functional, in that it gives the holder a “significant non-reputation-related” advantage,<sup>77</sup> can never receive trademark protection.<sup>78</sup> Given their similarities, a defense of genericness *ab initio* should be treated similarly to an argument of functionality *ab initio*.

In *NetJets, Inc. v. IntelliJet Group*,<sup>79</sup> the Sixth Circuit rejected a defense that the contested mark was void *ab initio* due to non-use at the time of registration.<sup>80</sup> Its reasoning, however, arguably leaves room for a defense of genericness *ab initio* to prosper. The *NetJet* court noted that “[v]oid *ab initio* or non-use at the time of registration, [was] not one of the defenses enumerated in § 1115(b).”<sup>81</sup> In order to reach this conclusion, however, the Sixth Circuit distinguished its ruling from the Eleventh Circuit’s ruling in *Wilhelm Pudenz, GmbH v. Littlefuse Inc.*, which allowed a challenge to an incontestable mark based on functionality to advance.<sup>82</sup> The court explained that, although the Lanham Act did not include a doctrine of functionality at that time, since it was “a judicially created concept that predates the Lanham Act” it would not read the statute to bar the defense.<sup>83</sup>

Although genericness is enumerated throughout the statute, when compared with the above cases, a generic *ab initio* defense appears to have more in common with the functionality defense argued in *Wilhelm* than with the use defense argued in *NetJets*. While a generic *ab initio* defense is not enumerated in § 1115(b) as the Sixth Circuit demanded in *NetJets*,<sup>84</sup> it

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one merchant “cannot deprive competing manufacturers of the product of the right to call an article by its name”).

75. See 15 U.S.C. §§ 1065, 1115(b) (2012).

76. See *id.* § 1051(b).

77. See *Qualitex Co. v. Jacobson Prod. Co.*, 514 U.S. 159, 165 (1995) (“This Court consequently has explained that, ‘[i]n general terms, a product feature is functional,’ and cannot serve as a trademark, ‘if it is essential to the use or purpose of the article or if it affects the cost or quality of the article,’ that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage.” (alteration in original) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.10 (1982))).

78. See 15 U.S.C. § 1052(e) (2012).

79. 678 F. App’x 343 (6th Cir. 2017).

80. *Id.* at 348.

81. *Id.* at 347–48.

82. *Wilhelm Pudenz, GmbH v. Littlefuse, Inc.*, 177 F.3d 1204, 1211–12 (11th Cir. 1999). While at the time of this case, functionality was a defense available under § 1115(b), this change did not take effect until October 1998 and did not apply. See *id.* at 1208.

83. See *id.* at 1210.

84. *NetJets, Inc.*, 678 F. App’x at 348.

nonetheless represents a “judicially created concept” older than the statutory language of the Lanham Act and the protection of incontestability.<sup>85</sup> The notion that a generic term could not receive trademark protection existed at common law long before the Lanham Act was enacted<sup>86</sup> and prevails today both in the statutory language and case law.<sup>87</sup> While a defense of genericness *ab initio* has not been codified in the defenses listed in § 1115(b) as functionality is, it has found some support within other circuits.<sup>88</sup>

The *Comic-Con* court was not mistaken when it stated that the statute and surrounding case law were unclear concerning the permissibility of a generic *ab initio* defense. By examining the statutory language and case law of other jurisdictions, however, the scale weighs in favor of recognition. This is particularly true when the existing statutory language and case law are considered in tandem with policy concerns.

### III. POLICY RATIONALE

The *Comic-Con* court failed to consider, even briefly, the policy reasons behind allowing a defense of generic *ab initio* to proceed. Despite the court’s lack of analysis on the issue, there are numerous policy considerations that weigh in favor of allowing the defense.

Trademark law is considered to have two primary goals.<sup>89</sup> The first is “to protect the public” so that when consumers purchase a product with a specific trademark they know what they are purchasing.<sup>90</sup> The second is to protect the owner of the mark who “has spent energy, time, and money in presenting to the public the product” and to insulate the owner from those who would free ride off the goodwill the owner has established.<sup>91</sup> However, while these two goals may be the most commonly cited, it is also widely

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85. See *Goodyear’s India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 604 (1888); *Del. & Hudson Canal Co. v. Clark*, 80 U.S. (13 Wall.) 311, 323, 20 L. Ed. 581 (1871) (“Nor can a generic name, or a name merely descriptive of an article of trade . . . be employed as a trade-mark and the exclusive use of it be entitled to legal protection.”).

86. See *Goodyear Rubber Co.*, 128 U.S. at 604; *Del. & Hudson Canal Co.*, 80 U.S. at 323.

87. See 15 U.S.C. §§ 1064(3), 1065(4) (2012); *Park ’N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985).

88. See *Te-Ta-Ma Truth Found.—Family of URI, Inc. v. World Church of the Creator*, 297 F.3d 662, 665 (7th Cir. 2002); *Harley Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 811 (2d Cir. 1999).

89. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 782 n.15 (1992) (Stevens, J., concurring).

90. See *id.* 782 n.15 (quoting S. REP. NO. 79-1333, at 3 (1946)).

91. See *id.*

understood that trademark law should neither create a monopoly<sup>92</sup> nor restrict free speech unnecessarily under the First Amendment.<sup>93</sup>

When considered solely in light of protecting the public and the owner, the policy issues surrounding the allowance of a generic ab initio defense become somewhat murky. Protecting a term that has always been generic should, in theory, not cause any detriment to the public since generic terms are believed to be incapable of sending strong messages of source.<sup>94</sup> Although some have argued that this is not true since the entire theory of de facto secondary meanings shows that some source identification may take root in a generic term,<sup>95</sup> the prevailing theory remains that de facto secondary meaning cannot pull a mark from the realm of genericism.<sup>96</sup> Therefore, refusing to protect a mark that has always been generic should not cause any detriment to the public. While allowing a defense of genericness ab initio could undermine the work that goes into promoting the generic mark, courts have historically found this unpersuasive, despite the overarching trademark goal of protecting such work.<sup>97</sup> As the Second Circuit in *Abercrombie & Fitch Co. v. Hunting World, Inc.*<sup>98</sup> stated,

[N]o matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise and what success it has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name.<sup>99</sup>

Thus, even if the mark owner has put significant energy, time, and money into its brand—as San Diego Comic Convention has undoubtedly done with its contested “COMIC-CON” mark—such work alone cannot save a mark from being labeled generic.

Admittedly, allowing a generic ab initio defense is not without its setbacks as doing so would open the door to more litigation and could

92. *See Anti-Monopoly, Inc. v. Gen. Mills Fun Grp.*, 611 F.2d 296, 300 (9th Cir. 1979).

93. *See* 6 MCCARTHY, *supra* note 16, § 31.139.

94. *See* 2 MCCARTHY, *supra* note 16, § 12:1.

95. *See, e.g., id.* § 12.47 (“I believe that the door should remain open (even if only open slightly) to an assertion of trademark status in formerly generic names.”). *See generally* Stephen R. Baird, Comment, *Putting the Cart Before the Horse in Assessing Trademark Validity—Toward Redefining the Inherently Generic Term*, 14 J. CORP. L. 925, 964 (1989) (arguing that even generic “terms that have acquired distinctiveness . . . [should] receive protection under the trademark law”).

96. *See, e.g., Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

97. *See, e.g., id.*; *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 290 F.2d 845, 848 (C.C.P.A. 1961).

98. 537 F.2d 4 (2d Cir. 1967).

99. *Id.* at 9.

potentially create undue second-guessing or scrutiny of USPTO decisions regarding the validity of marks. By allowing such a defense, the line between generic and descriptive would remain an area of conflict even after incontestability status was granted. Since *Park 'N Fly* prohibits challenges on the basis of descriptiveness,<sup>100</sup> the defense of genericness ab initio could lead to larger numbers of defendants claiming that the mark at issue was generic and not descriptive. Incontestability provides some security to the trademark owner who can, after a period of use, insulate themselves from certain repeated challenges.<sup>101</sup> Allowing a defense of genericness ab initio would diminish that insulation by opening the door to continuous and to more types of challenges.

Yet, when considered in conjunction with trademark law's aversion to creating monopolies and infringing on freedom of speech, policy concerns strongly favor permitting a generic ab initio defense. Trademark law was never intended to create trade monopolies but was meant instead to encourage and bolster fair competition.<sup>102</sup> Thus to allow a generic mark to be registered, let alone receive incontestable status, "would grant the owner of a mark a monopoly, since a competitor could not describe his goods as what they are."<sup>103</sup> Thus, failing to allow a generic ab initio defense would permit companies to commandeer a generic term, slip through the cracks of registration, and deprive the right of competitors to call their product by its common name. Such a restriction would permit monopolies to flourish under a shield of erroneously garnered trademark protection.

Further, by prohibiting a defense of genericness ab initio and allowing generic marks that should never have received trademark protection to retain a shield of validity, courts ignore free speech concerns. Intellectual property rights act as a carve-out to the broad protection of the First Amendment.<sup>104</sup> "Whereas the First Amendment prevents the suppression of speech, someone else's speech is foreclosed every time holders of copyright, trademark, or publicity rights exercise their rights."<sup>105</sup> Because of the tension between the First Amendment and trademark protection,

100. See *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 196 (1985).

101. See 6 MCCARTHY, *supra* note 16, § 32:141 (noting that incontestability provides trademark owners a "safe harbor").

102. See *Phoenix Entm't Partners v. Rumsey*, 829 F.3d 817, 825 (7th Cir. 2016) ("Trademark, by contrast, is aimed not at promoting creativity and invention but rather at fostering fair competition."); *Anti-Monopoly, Inc. v. Gen. Mills Fun Grp.*, 611 F.2d 296, 300 (9th Cir. 1979) (explaining how trademarks are not used to further or perpetuate monopolies, but are used instead to protect consumers from being misled).

103. *CES Publ'g Corp. v. St. Regis Publ'ns, Inc.*, 531 F.2d 11, 13 (2d Cir. 1975).

104. See Mark Bartholomew & John Tehranian, *An Intersystemic View of Intellectual Property and Free Speech*, 81 GEO. WASH. L. REV. 1, 3 (2013).

105. *Id.*

rights granted in a trademark may be limited, and some rights may not be granted at all. This is true for generic terms, which according to case law, “belong in the public domain.”<sup>106</sup>

In the past, courts have strongly protected this public domain space in trademark law and refused to allow producers to take a generic term out of the public domain even upon a showing of acquired distinctiveness.<sup>107</sup> The Second Circuit even stated 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 at least as long as the term retains some generic meaning.”<sup>108</sup> Given this precedent, refusing to allow a generic ab initio defense would undermine the goal of preserving the public domain. A mark that has always been generic and both received trademark protection and incontestability status only by oversight or error rightfully belongs in the public domain. If a generic ab initio defense is not permitted, a producer would be allowed to steal a word from public use and shield itself from challenges.

Prohibiting a defense of generic ab initio does little to uphold the first two purposes of trademark law and directly contradicts the stated preference for refraining from either creating monopolies or infringing unnecessarily upon free speech. Thus, the defense should be admissible. As Justice Stevens explained in his dissent in *Park 'N Fly*, “no one ever suggested that any public purpose would be served by granting incontestable status to a mark that should never have been accepted for registration in the first instance.”<sup>109</sup>

#### IV. RAMIFICATIONS

The positive impact of allowing a generic ab initio defense outweighs the negative effects of continuing to bar the defense either outright or by remaining undecided. Permitting a defendant to raise a generic ab initio

106. *In re Sun Oil Co.*, 426 F.2d 401, 404 (C.C.P.A. 1970); *see also* *Henri's Food Prods. Co. v. Tasty Snacks, Inc.*, 817 F.2d 1303, 1305 (7th Cir. 1987) (“On the other hand, a generic name—the common name of a class of things or a ‘common descriptive name’—is irretrievably in the public domain, and the preservation of competition precludes its protection.”). For an explanation of the policy basis underlying the generic name rule, *see* 2 MCCARTHY, *supra* note 16, § 12:2.

107. *See, e.g.*, *Schwan's IP, LLC v. Kraft Pizza Co.*, 460 F.3d 971, 974 (8th Cir. 2006) (“Because a generic term denotes the thing itself, it cannot be appropriated by one party from the public domain; it therefore is not afforded trademark protection even if it becomes associated with only one source.” (quoting *Blinded Veterans Ass'n v. Blinded Am. Veterans Found.*, 872 F.2d 1035, 1039 (D.C. Cir. 1989))).

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

109. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 208 (1985) (Stevens, J., dissenting).

defense against an incontestable mark would introduce broader protection for defendants. Although this defense might slightly weaken the protection incontestability status offers, prohibiting the defense or remaining undecided would safeguard mistakes and uphold an odd purpose counterintuitive to the statute.

If permitted, a generic *ab initio* defense would allow a defendant to argue the alleged mark is generic in a manner different than that allowed under genericide. Although the two defenses are similar, one of the key differences, beyond when the contested mark constituted a generic term, is the type of proof needed to secure a successful defense.<sup>110</sup> In cases of genericide, courts consider a variety of factors such as dictionary definitions, media coverage, use by competitors, and consumer surveys.<sup>111</sup> While a genericness *ab initio* analysis looks at many of the same factors as genericide, less importance, if any, appears to be placed on surveys.<sup>112</sup> Instead, when deciding whether a mark is generic *ab initio*, courts primarily focus on factors such as “dictionary definitions and usage of the term by the media, industry, competitors, and holder of the mark.”<sup>113</sup> Other circuits have explained this difference by noting that when the term was already generic or commonly used when it was adopted, survey evidence was irrelevant.<sup>114</sup>

The difference in the treatment of surveys between the two defenses is particularly pertinent because courts sometimes place great weight on consumer surveys.<sup>115</sup> In the case at issue here, the *Comic-Con* court itself noted that the survey introduced by San Diego Comic-Con was “one of SDCC’s most persuasive pieces of evidence.”<sup>116</sup> Although the *Comic-Con* court claimed that the defendant could not succeed in a generic *ab initio* challenge,<sup>117</sup> having an available generic *ab initio* defense would have

110. *See* *Pods Enters., Inc. v. U-Haul Int’l, Inc.*, No. 8:12-CV-01479-T-27MAP, 2015 WL 1097374, at \*3 (M.D. Fla. Mar. 11, 2015).

111. *See* 2 MCCARTHY, *supra* note 16, § 12:13.

112. *See, e.g.*, *San Diego Comic Convention v. Dan Farr Prods.*, No. 14-CV-1865-AJB-JMA, 2018 WL 4091734, at \*12 (S.D. Cal. Aug. 23, 2018); *Pods Enters.*, 2015 WL 1097374, at \*2.

113. *Pods Enters.*, 2015 WL 1097374, at \*3.

114. *See, e.g.*, *Schwan’s IP, LLC v. Kraft Pizza Co.*, 460 F.3d 971, 976 (8th Cir. 2006); *Hunt Masters, Inc. v. Landry’s Seafood Rest., Inc.*, 240 F.3d 251, 254–55 (4th Cir. 2001); *Miller Brewing Co. v. Jos. Schlitz Brewing Co.*, 605 F.2d 990, 995 (7th Cir. 1979).

115. *See Committee Print to Amend the Federal Trademark Dilution Act: Hearing Before the Subcomm. on Courts, the Internet & Intellectual Prop. of the H. Comm. on the Judiciary*, 108th Cong. 14 (2004) (statement of Robert W. Sacoff, Chair, Section of Intellectual Property Law, American Bar Association) (“[S]urvey evidence is traditionally one of the most classic and most persuasive and most informative forms of trial evidence that trademark lawyers utilize in both prosecuting and defending against trademark claims of various sorts.”).

116. *San Diego Comic Convention v. Dan Farr Prods.*, 336 F. Supp. 3d 1172, 1182 (S.D. Cal. Aug. 23, 2018).

117. *Id.* at 1184.

allowed the defendant to place less emphasis on consumer surveys, thus increasing its chances of success.

Allowing a generic ab initio defense to proceed might weaken the protection afforded by incontestability status, but this is not a strong enough reason to allow incontestability status to protect marks that should never have become marks in the first place. An incontestable trademark “is not invincible,”<sup>118</sup> and has been described as the “swiss cheese” rule due to the number of defenses available.<sup>119</sup> Section 1064(3) is one of the holes in the cheese since it permits a registered mark to be canceled at any time if it becomes generic.<sup>120</sup> If a legitimate mark is so successful that it becomes generic, the mark can be cancelled<sup>121</sup> even if it had incontestable status. It seems counterintuitive and against the policies discussed earlier to bar the cancellation of a mark that was never legitimate. Allowing a generic ab initio defense would not put more holes in the “swiss cheese” rule of incontestability but rather, would permit a more logical understanding of genericism as a defense in general.

Further, barring a defense of genericness ab initio, in effect, prevents registration errors from ever being challenged. Incontestability status is not always carefully granted.<sup>122</sup> In that same vein, trademark examiners at the USPTO are prone to human error. By prohibiting a generic ab initio defense to an incontestable status, courts allow registrations made in error to be protected by a glimmering shield of conclusive validity that is somehow more protective than a previously valid trademark that only later becomes generic. Allowing a generic ab initio defense simply permits a defendant to poke through a shield that the alleged mark should never have acquired in the first place.

#### CONCLUSION

The *Comic-Con* court had a chance to determine whether a defense of genericness ab initio should be allowed against an incontestable statute but failed to decide the issue while simultaneously blocking the defense.<sup>123</sup> Although the *Comic-Con* court was not mistaken when it claimed that the relevant law did not *clearly* provide for such a defense,<sup>124</sup> the court was

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118. See *Georgia-Pacific Consumer Prods. LP v. Kimberly-Clark Corp.*, 647 F.3d 723, 727 (7th Cir. 2011).

119. See 6 MCCARTHY, *supra* note 16, § 32:147.

120. See 15 U.S.C. § 1064(3) (2012).

121. See 2 MCCARTHY, *supra* note 16, § 11:9.

122. See Tushnet, *supra* note 16, at 436 (explaining that the USPTO does not substantively examine incontestability claims).

123. See *San Diego Comic Convention v. Dan Farr Prods.*, No. 14-CV-1865-AJB-JMA, 2018 WL 4091734, at \*11 (S.D. Cal. Aug. 23, 2018).

124. See *id.*



2019]

*COMIC-CON BY ANY OTHER NAME*

59

remiss not to look deeper and conduct a more thorough analysis of the issue. If it had, the *Comic-Con* court might have found that—when taken as a whole—the statutory language, existing case law, and underlying policy concerns all favor a generic ab initio defense. While there can be a lot of meaning behind a name, occasionally, as is the case with generic terms, a name is simply what it is, whether it be a rose or a comic convention and, as such, should not be granted trademark protection.

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