

Racism and Trademark Abandonment

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ABSTRACT

As companies have come to terms with the fact that their brand names and imagery have connections to America's racist history, they have publicly announced their commitments to shed their ignominious trademarks. But, unlike a physical monument, a trademark cannot be destroyed or removed. Under the prevailing doctrine, abandoned trademarks return to the public domain, free for another company to claim and use—even if it may capitalize on the mark's recognition as a symbol of oppression. This puts companies that wish to sever their ties with their racist trademarks in an intractable situation: either they make good on their commitments and risk losing their ability to prevent others from adopting the marks, or they try to use the marks or their vestiges in limited ways that may avoid abandonment. This dilemma is heightened because the abandonment doctrine has been applied inconsistently by courts, precisely because some judges wish to avoid the dramatic consequences that result from deeming a trademark abandoned.

This Article makes three contributions to the discourses on trademark law and race and the law, revealing how the law has erected barriers to companies that wish to engage in efforts to ameliorate the harm caused by their use of racist trademarks. First, this Article explains how trademark law has contributed to the proliferation of harmful racial and ethnic stereotypes and identifies the limits on the tools that can be employed to curb the use of such symbols. Second, this Article comprehensively describes the trademark abandonment doctrine, bringing to light the distinctions that courts have tacitly drawn between express and implied abandonment, the flaws in the current doctrine, and the perverse incentives it creates for companies that wish to shed their racist trademarks. Third, this Article illustrates how trademark law and systems can be reformed to promote antiracist efforts while simultaneously rectifying problems that affect a broader group of trademark holders.

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INTRODUCTION

Less than one month after George Floyd’s murder, Quaker Oats announced that it would change the name and image of its once iconic Aunt Jemima brand.¹ It was one of several high-profile entities to change or drop their trademarks as the United States faced its most acute racial reckoning; others included Mars, the producer of Uncle Ben’s,² Dreyer’s, the producer of Eskimo Pie,³ the Dixie Chicks, Lady

¹ Tiffany Hsu, *Aunt Jemima Brand to Change Name and Image Over “Racial Stereotype,”* N.Y. TIMES (June 17, 2020), <https://www.nytimes.com/2020/06/17/business/media/aunt-jemima-racial-stereotype.html> [<https://perma.cc/JY5C-7LUY>] (describing history of brand and viral video that exposed its racist past); Ben Kessler, *Aunt Jemima Brand to Change Name, Remove Image that Quaker Says is “Based on Racial Stereotype,”* NBC NEWS (June 17, 2020, 3:07 PM), <https://www.nbcnews.com/news/us-news/aunt-jemima-brand-will-change-name-remove-image-quaker-says-n1231260> [<https://perma.cc/Z7B5-CSHP>].

² Jemima McEvoy, *Uncle Ben’s Changes to Ben’s Original Amid Rebrand of Racist Labeling,* FORBES (Sept. 23, 2020, 9:36 AM), <https://www.forbes.com/sites/jemimamcevoy/2020/09/23/>

Antebellum,⁴ and the Washington R*****s⁵ football team.⁶ Quaker Oats's public statement acknowledged that "Aunt Jemima's origins are based on a racial stereotype" and that it must cut those historical ties "to make progress toward racial equality."⁷ Eight months later, Quaker Oats unveiled the new name, Pearl Milling Company, explaining that it was imperative to adopt a name that did not contain any derivation of "Aunt," "Jemima," or reference a female persona.⁸ Although it would keep elements of its branding such as the red packaging and font, it seemed as though Quaker Oats had made good on its public commitment to remove the racist trademarks from its profitable pancake brand.⁹

Fast forward to the present. You are watching your favorite television show and a commercial appears on the screen. It depicts a racially diverse array of individuals and families gleefully enjoying their pancakes.¹⁰ The voice-over informs you that "Pearl Milling Company isn't new to this. We've been stacking tasty, fluffy pancakes since forever."¹¹ As the commercial reaches its denouement, it cuts to a red screen, along with a depiction of its newly registered trademark name and mill logo.¹² But in the lower right-hand corner there is a reminder:

uncle-bens-changes-to-bens-original-amid-rebrand-of-racist-labeling/?sh=6a2c3fc5391c [https://perma.cc/XD3F-EWKE].

³ Jemima McEvoy, *Eskimo Pie Becomes Edy's Pie: Here Are All the Brands that Are Changing Racist Names and Packaging*, FORBES (Oct. 6, 2020, 4:51 PM), <https://www.forbes.com/sites/jemimamcevoy/2020/10/06/eskimo-pie-becomes-edys-pie-here-are-all-the-brands-that-are-changing-racist-names-and-packaging/?sh=5632100456a7> [https://perma.cc/XEF6-L5YZ].

⁴ See Ben Sisario, *The Dixie Chicks Change Their Name, Dropping the "Dixie,"* N.Y. TIMES (July 8, 2020), <https://www.nytimes.com/2020/06/25/arts/music/dixie-chicks-change-name.html> [https://perma.cc/J64F-HY8B] (discussing name changes for the Dixie Chicks and Lady Antebellum).

⁵ Throughout this Article, the Author uses "R*****s" to refer to the former name of the Washington Commanders football team. The unredacted word, however, is retained in citation references in order to properly credit cited works and assist in reference.

⁶ See generally Les Carpenter, *Washington's NFL Team to Retire Redskins Name, Following Sponsor Pressure and Calls for Change*, WASH. POST (July 13, 2020, 3:48 PM), <https://www.washingtonpost.com/sports/2020/07/13/redskins-change-name-announcement/> [https://perma.cc/MH2H-GXFW] (identifying circumstances that led to announcement).

⁷ Kessen, *supra* note 1 (quoting Quaker Oats representative).

⁸ See Beth Kowitz, *The Inside Story Behind Aunt Jemima's New Name*, FORTUNE (Feb. 11, 2021, 12:41 PM), <https://fortune.com/2021/02/11/aunt-jemima-new-name-pearl-milling-company/> [https://perma.cc/LQJ8-UG73] (discussing relevant considerations, including those related to trademark law).

⁹ See *id.*

¹⁰ Pearl Milling Company, *Stack Up the Moments*, YOUTUBE (Oct. 18, 2021), https://www.youtube.com/watch?v=T8i1H_q5zZ8 [https://perma.cc/J5A3-GM7J].

¹¹ *Id.*

¹² *Id.*; SINCE 1889 PEARL MILLING COMPANY, Registration No. 90,501,924.

“New Name, Same Great Taste as Aunt Jemima.”¹³ Although there is no trace of the Black woman who had long personified the brand,¹⁴ the name “Aunt Jemima” appears in its iconic font. It is also followed by the federal trademark registration symbol, giving notice to the world that the brand name is still actively registered with the United States Patent and Trademark Office (“USPTO”).¹⁵

What happened to Quaker Oats cutting ties with its racist branding? One plausible, albeit cynical, explanation is that Quaker Oats’s high-minded statements about racial equality were made merely to respond to intense public criticism. Maybe the corporation was not actually interested in giving up the name if it meant losing brand recognition.¹⁶ This market-driven explanation would track with Quaker Oats’s previous responses to criticism over Aunt Jemima. In the past, Quaker Oats had made only minor changes to the female character’s appearance.¹⁷

Yet there is an alternative, or at least supplementary, trademark law explanation. Before Quaker Oats unveiled its new branding, it noted that it would continue to use the “Aunt Jemima” name in a limited capacity to “let the company hold ‘on to the trademark, which in turn enables [it] to appropriately preserve the history.’”¹⁸ Its preferred concern was related to the legal consequences of trademark

¹³ Pearl Milling Company, *supra* note 10.

¹⁴ See Jessica Snouwaert, *Aunt Jemima’s Logo Has Changed Six Times, and Its History Is Rooted in Racial Stereotypes and Slavery*, BUS. INSIDER (June 17, 2020, 5:59 PM), <https://www.businessinsider.com/aunt-jemima-history-logo-changed-6-times-rooted-racial-stereotypes-2020-6> [<https://perma.cc/WT56-WALV>] (detailing history of logo and describing different versions).

¹⁵ See Pearl Milling Company, *supra* note 10; AUNT JEMIMA, Registration No. 1,590,084.

¹⁶ See Chauncey Alcorn, *Pearl Milling Company’s New Ads Remind Customers It Used to be Aunt Jemima—Without Mentioning the Racist Brand*, CNN (Sept. 3, 2021, 1:50 PM), <https://www.cnn.com/2021/08/31/business/pearl-milling-company-aunt-jemima/index.html> [<https://perma.cc/WSQ4-J3EF>] (suggesting that Quaker Oats continues to reference Aunt Jemima in advertisements to “[b]oost[] sales”).

¹⁷ See Snouwaert, *supra* note 14; see also Riche Richardson, Opinion, *Can We Please, Finally, Get Rid of “Aunt Jemima”?*, N.Y. TIMES (June 24, 2015), <https://www.nytimes.com/room-for-debate/2015/06/24/besides-the-confederate-flag-what-other-symbols-should-go/can-we-please-finally-get-rid-of-aunt-jemima> [<https://perma.cc/SU8M-KRQ4>] (noting that despite efforts to remove Confederate symbols and “divest from [the] commercial circulation” racist products and commodities, Quaker Oats continues to profit from Aunt Jemima trademarks).

¹⁸ Beth Kowitz, *Inside the Cottage Industry Trying to Revive Aunt Jemima and Other Brands with Racist Roots*, FORTUNE (Dec. 8, 2020, 6:30 AM), <https://fortune.com/2020/12/08/aunt-jemima-uncle-bens-eskimo-pie-brands-racist-roots-revived-black-lives-matter-movement-trademarks/> [<https://perma.cc/VS4F-WNTK>] (noting that there also might be economic considerations behind these decisions).

abandonment, after which point the unprotected symbol would fall into the public domain for another entity to adopt and use as its own.¹⁹ Although a company like Quaker Oats can stop others from using its trademarks in ways that would likely confuse or deceive consumers, that power generally extends only as long as the entity retains the rights to the trademarked symbols. Once a trademark is deemed abandoned, it is available to the next entity that uses the trademark in commerce.²⁰ That person or company would then acquire the legal rights to the mark.²¹

But why would anyone want to adopt a discarded racist trademark as their own? The primary reason is a monetary one. Despite being sharply criticized, many racist trademarks are still recognizable to consumers. Some of these consumers are not deterred by the trademarks' deleterious effects.²² In fact, there are companies that specialize in acquiring abandoned trademarks, affectionately known as "zombie trademarks," precisely to exploit the residual goodwill associated with them.²³ These companies often do not actively sell any goods or services bearing the marks themselves; instead, they license or assign their newly acquired rights to the highest bidders.²⁴ Although the resurrection of dormant brands is not without controversy, there have been relaunches by third parties that have withstood legal opposition by the brands' initial owners.²⁵

¹⁹ 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 17:2 (5th ed. 2022); see also Jake Linford, *Valuing Residual Goodwill After Trademark Forfeiture*, 93 NOTRE DAME L. REV. 811, 821–22 (2017) (describing "binary switch" associated with forfeiture mechanisms); Kowitt, *supra* note 18 (explaining conundrum facing brands wishing to discontinue using racist trademarks).

²⁰ 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 17:2, at 17-6 (5th ed. 2022); Linford, *supra* note 19, at 821.

²¹ 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 17:2, at 17-6 (5th ed. 2022).

²² See Kowitt, *supra* note 18 (explaining that there are businesses that opportunistically attempt to gain rights to dormant brands); see also Deborah R. Gerhardt, *The Last Breakfast with Aunt Jemima and its Impact on Trademark Theory*, 45 COLUM. J.L. & ARTS 231, 231 (2022) ("[The] economics theory of trademarks fails to explain why a brand owner would ever walk away from a trademark that generates financially lucrative returns.").

²³ See Jerome Gilson & Anne Gilson LaLonde, *The Zombie Trademark: A Windfall and Pitfall*, 98 TRADEMARK REP. 1280, 1283–88 (2008) (defining "zombie trademarks" and describing business model); Joseph C. Gioconda, *Measuring the Value of a "Zombie Brand": A Survey-Based Model*, 58 IDEA: J. FRANKLIN PIERCE FOR INTELL. PROP. 173, 191–97 (2018) (setting out legal disputes over rights to dormant brands).

²⁴ Gilson & LaLonde, *supra* note 23, at 1283–84.

²⁵ See, e.g., *Gen. Motors Corp. v. Aristide & Co.*, 87 U.S.P.Q.2d 1179 (T.T.A.B. 2008) (rejecting opposition to mark on the grounds that it retained consumer recognition); see also Gilson & LaLonde, *supra* note 23, at 1284–86 (discussing the *Aristide* case and implications).

One might think it odd to refer to a racist trademark as retaining “goodwill,” given its inherently offensive nature.²⁶ In fact, some predicted that market forces might eventually prompt companies to drop their racist trademarks before the murder of George Floyd happened.²⁷ But these new entrants do not have to worry about upsetting their existing customer bases because they have none. Even more disturbingly, new entrants into the market might adopt these trademarks to capitalize on the controversy and perpetuate the visibility of the racist symbols in the consumer marketplace and beyond.²⁸

Within days of Quaker Oats’s announcement, three federal trademark applications for the verbal mark “Aunt Jemima” were filed by different entities.²⁹ As of June 2023, only one of the three applications had failed to register; the other two are still pending.³⁰ There have been similar filings for “Eskimo Pie” and “Uncle Ben’s” by companies that specialize in acquiring dormant trademarks.³¹ And immediately after Washington’s announcement, Leo Stoller, a notorious abuser of the trademark system and felon convicted on federal fraud charges,³² filed for federal registration of the “Washington R*****s” verbal mark.³³

As it stands, the primary way that companies wishing to shed their racist trademarks can prevent zombie trademark enthusiasts like Leo Stoller from acquiring them is by insisting that they have not been

²⁶ Cf. Gerhardt, *supra* note 22, at 253–54 (linking corporate shedding of racist trademarks to consumer investment in trademarks).

²⁷ See, e.g., Mark Conrad, Matal v. Tam—A Victory for the Slants, A Touchdown for the Redskins, But an Ambiguous Journey for the First Amendment and Trademark Law, 36 CARDOZO ARTS & ENT. L.J. 83, 138–41 (2018) (outlining extralegal pressures on trademark holders).

²⁸ Enrico Bonadio, *Brands, Morality and Public Policy: Some Reflections on the Ban on Registration of Controversial Marks*, 19 MAR. INTELL. PROP. L. REV. 39, 49–50 (2015); see Kowitz, *supra* note 18 (acknowledging difference between revitalizing a dormant brand and using an abandoned racist trademark).

²⁹ See U.S. Trademark Application Serial No. 90,005,800 (filed June 17, 2020); U.S. Trademark Application Serial No. 90,008,879 (filed June 18, 2020) (abandoned Mar. 30, 2021); U.S. Trademark Application Serial No. 90,012,648 (filed June 21, 2020).

³⁰ See U.S. Trademark Application Serial No. 90,005,800 (filed June 17, 2020); U.S. Trademark Application Serial No. 90,008,879 (filed June 18, 2020) (abandoned Mar. 30, 2021); U.S. Trademark Application Serial No. 90,012,648 (filed June 21, 2020).

³¹ See, e.g., U.S. Trademark Application Serial No. 90,012,653 (filed June 21, 2021); U.S. Trademark Application Serial No. 90,013,691 (filed June 22, 2020); U.S. Trademark Application Serial No. 90,108,331 (filed Aug. 12, 2020) (abandoned Oct. 26 2020).

³² See, e.g., Stephen R. Baird, *2005 Trademark Decisions of the Federal Circuit*, 55 AM. U. L. REV. 1263, 1267 (2006) (referring to Stoller as a “trademark troll”); *United States v. Stoller*, 827 F.3d 591, 593 (7th Cir. 2016) (upholding Stoller’s guilty plea for bankruptcy fraud).

³³ See U.S. Trademark Application Serial No. 90,050,599 (filed July 13, 2020) (abandoned Nov. 8, 2021).

legally abandoned.³⁴ As this Article will show, however, the statutory definition of “abandonment” prevents companies from indefinitely warehousing marks that they do not intend to use in the near future.³⁵ This has left courts with a conundrum: if they faithfully apply the abandonment test, a large number of unused and potentially recognizable marks could fall into the public domain.

Perhaps to avoid what they perceive as an undesirable result, including to consumers who might be unaware that a once familiar mark is now associated with a different producer, courts have tacitly drawn a distinction between two types of abandonment: (1) express abandonment, which may occur when an entity communicates that it intends to stop using a trademark; and (2) implied abandonment, which may occur when an entity stops using a trademark without communicating its intent.³⁶ Although courts cannot easily avoid an abandonment determination with respect to the former, they often take great pains to avoid it for the latter, including in cases where there is substantial evidence to the contrary.³⁷

Some scholarship has touched on the problems with the trademark abandonment doctrine,³⁸ though until now few high-profile examples have vividly exposed its flaws. It does little good for a company like Quaker Oats to publicly announce that it will remove its racist branding from the marketplace, out of recognition that it causes harm, if another company just steps in to take its place. And yet, this is the potential fate of companies that truly cut all ties with their racist trademarks. The USPTO used to have the power to prevent the federal registration of disparaging and immoral or scandalous marks, even if it was rarely and inconsistently exercised, but those statutory bars were invalidated by the U.S. Supreme Court on First Amend-

³⁴ See 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 17:2, 17:6 (5th ed. 2022); *infra* Section IV.A.

³⁵ See 15 U.S.C. § 1127 (2018); *see also infra* Section II.B.

³⁶ See *infra* Part III.

³⁷ See *infra* Sections III.A–.B.

³⁸ See, e.g., Robert G. Bone, *Of Trolls, Orphans, and Abandoned Marks: What's Wrong With Not Using Intellectual Property*, 42 COLUM. J.L. & ARTS 1, 5–6 (2018) (examining problems related to nonuse in intellectual property and proposing solutions based on utilitarian principles); Linford, *supra* note 19, at 815–17 (focusing on residual goodwill); Stacey L. Dogan & Mark A. Lemley, *A Search-Costs Theory of Limiting Doctrines in Trademark Law*, 97 TRADEMARK REP. 1223, 1249–50 (2007) (highlighting disconnect between prevailing search-costs theory and abandonment doctrine); Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1893 (2007) (situating abandonment within larger framework of diversion of trade rather than consumer protection).

ment grounds in *Matal v. Tam*³⁹ and *Iancu v. Brunetti*,⁴⁰ respectively. In fact, the USPTO previously cancelled the Washington football team's trademark registration because it was disparaging to Indigenous persons, but the mark was reinstated after *Tam* invalidated the bar on the registration of disparaging marks.⁴¹

Without these statutory bars, and with the ever-present threat of abandonment, it is no surprise that Quaker Oats is continuing to use its former brand as an ancillary part of its marketing so that it can claim the mark is still used in commerce.⁴² This is one of several strategies companies may employ to try to hold on to the legal rights to a discarded mark, and all of them require companies to equivocate on their commitment to cutting all ties to their racist pasts. But there is another solution. Through the adoption of the innovative legislative and administrative proposals outlined in this Article, trademark law could serve to facilitate, rather than hinder, companies' efforts to remove their racist trademarks from the marketplace.

Part I of this Article details the history of racist trademarks and how they were treated by the USPTO before and after the *Tam* and *Brunetti* decisions. Part I also describes the circumstances that led to multiple companies dropping or changing their marks and states the case for why trademark law should not be a barrier to such corporate actions. Part II explains the theoretical and doctrinal underpinnings of trademark protection and acquisition, together with the general framework of the abandonment doctrine. Part III explains how courts have applied the abandonment doctrine and describes its consequences, thereby revealing stark differences between the evaluation of cases of express abandonment and implied abandonment.

Part IV returns to the challenges faced by those companies that desire to drop their racist trademarks and offers two proposals. It shows that the current abandonment doctrine puts their marks at risk of being reappropriated and incentivizes behavior counter to antiracist efforts to remove these marks from the marketplace. One pro-

³⁹ 137 S. Ct. 1744, 1764–65 (2017).

⁴⁰ 139 S. Ct. 2294, 2302 (2019).

⁴¹ See *Pro-Football, Inc. v. Blackhorse*, 709 F. App'x 182, 183 (4th Cir. 2018) (vacating district court's order affirming cancellation in light of *Tam*); Conrad, *supra* note 27, at 120–21 (explaining resolution of case).

⁴² See Kowitt, *supra* note 18 (claiming that Quaker Oats was retaining the reference to "Aunt Jemima" in part for trademark-related reasons). To be sure, Quaker Oats might have had mixed motivations for retaining the prior branding, including educating the public about the change when it was first made, but it does not appear that consumer education was the sole reason for the change. See *id.*

posal involves Lanham Act amendments to permit abandoned trademark holders to continue to exercise limited rights to their prior marks. The second proposal entails the creation of a new trademark registry to protect select retired marks. This Article concludes by forecasting how implementation of these proposals could allow companies to continue to evolve their branding in an enlightened society.

I. DROPPING (SOME) RACIST TRADEMARKS: A HISTORICAL, LEGAL, AND NORMATIVE ACCOUNT

Racially explicit trademarks and those that reference racial stereotypes or are otherwise associated with racial or ethnic oppression, which this Article collectively calls “racist trademarks,” have long existed in this country and throughout the world.⁴³ In the past, though, American society simply referred to them as “trademarks.” This Part briefly documents their prevalence throughout the 20th and early 21st centuries despite concerted efforts by marginalized communities to eradicate them. It then discusses the USPTO’s attitude toward these marks and the role that the “disparagement” and “immoral or scandalous” statutory registration bars played before the U.S. Supreme Court invalidated them.⁴⁴ Next, this Part describes how the revolution came not from the law, but rather from the racial reckoning following George Floyd’s murder. It then marshals the arguments in favor of supporting not only the abandonment of racist trademarks, but also their removal from the consumer marketplace.

A. *Early Existence and Criticism*

Even at the time of the first trademark registration statute, the Trademark Act of 1870, there were many companies employing branding that was explicitly racist or based on stereotypes of Black, Indigenous, and those people considered “others” based on their race, ethnicity, or national origin.⁴⁵ Black people were depicted “as lazy, obedient or bumbling servants, heathens, hypersexualized, bestial, no-

⁴³ See Gerhardt, *supra* note 22, at 241–42 (providing brief history). See generally Fady J.G. Aoun, *The Belated Awakening of the Public Sphere to Racist Branding and Racist Stereotypes in Trademarks*, 61 IDEA: L. REV. FRANKLIN PIERCE CTR. FOR INTELL. PROP. 545 (2021) (detailing history of racist trademarks in the United States, United Kingdom, and Australia).

⁴⁴ See generally *Matal v. Tam*, 137 S. Ct. 1744, 1765 (2017) (invalidating disparagement clause); *Iancu v. Brunetti*, 139 S. Ct. 2294, 2302 (2019) (invalidating “immoral or scandalous” bar).

⁴⁵ See Aoun, *supra* note 43, at 568–70; Rosemary J. Coombe, *Embodied Trademarks: Mimesis and Alterity on American Commercial Frontiers*, 11 CULTURAL ANTHROPOLOGY 202, 210 (1996).

ble savages, minstrels, childlike, uncivilized and unclean peoples requiring Western enlightenment.”⁴⁶ The Aunt Jemima persona debuted in 1893; it was created by a white male employee at the Pearl Milling Company to represent a Black mammy who “happily devoted all of her energy to raising white children so that Southern men could be served and their belles could live a life of fashionable leisure.”⁴⁷ Indigenous people were portrayed as “highly exaggerated caricatures” based on a “false historical narrative” of them as “savage” and “violent.”⁴⁸ These portrayals made them ideal mascots for sports teams seeking to adopt a personification that highlighted their “aggressive qualities.”⁴⁹ The most infamous of these was the Washington football team, which began using the “R*****s” name in 1933.⁵⁰ There had been other teams that used racially charged references or employed harmful stereotypes of Indigenous persons, but this franchise went even further by adopting a racial slur.⁵¹

The adoption of racist trademarks and associated branding were not aberrations. Rather, the words and imagery were deliberately and routinely used to “accentuate[] the ethnic differences of some Americans [that] in turn tended to deemphasize the cultural differences of others and thereby create an ‘American’ consumer.”⁵² At the same time, the trademarks “entrench[ed] visual economies of whiteness” by virtue of “objectifying people of color.”⁵³ By leveraging these stereotypes, businesses could efficiently convey the qualities they wanted

⁴⁶ Aoun, *supra* note 43, at 571.

⁴⁷ Gerhardt, *supra* note 22, at 243; *see also* Kimberly A. Pace, *The Washington Redskins Case and the Doctrine of Disparagement*, 22 PEPP. L. REV. 7, 9–10 (1994) (recounting history of and changes in Aunt Jemima branding).

⁴⁸ Victoria F. Phillips, *Beyond Trademark: The Washington Redskins Case and the Search for Dignity*, 92 CHI.-KENT L. REV. 1061, 1067 (2017).

⁴⁹ *See id.*; *see also* Conrad, *supra* note 27, at 88 (discussing prevalence of such marks in connection with athletic teams).

⁵⁰ *See* Pace, *supra* note 47, at 12–13 (calling the Washington football team “The Worst Offender”); *see also* Ian Shapira, *A Brief History of the Word “Redskin” and How It Became a Source of Controversy*, WASH. POST (July 3, 2020, 5:18 PM), <https://www.washingtonpost.com/history/2020/07/03/redskins-name-change/> [<https://perma.cc/R4GG-8G4Z>].

⁵¹ *See* Pace, *supra* note 47, at 12–13 (noting that Indigenous tribes distinguished between Washington’s mark, which they considered a racial epithet, and those of other sports teams that used Indigenous names and imagery).

⁵² Christine Haight Farley, *Registering Offense: The Prohibition of Slurs as Trademarks*, in DIVERSITY IN INTELLECTUAL PROPERTY: IDENTITIES, INTERESTS, AND INTERSECTIONS 105, 113 (Irene Calboli & Srividhya Ragavan eds., 2015); *see also* Coombe, *supra* note 45, at 209 (identifying phenomenon of creating a “particularly ‘American’ consumer”).

⁵³ Anjali Vats, *Temporality in a Time of Tam, or Towards a Racial Chronopolitics of Intellectual Property Law*, 61 IDEA: L. REV. FRANKLIN PIERCE CTR. FOR INTELL. PROP. 673, 686–87 (2021).

consumers to associate with their brands; indeed, they were precisely the sorts of mental shortcuts that embody strong trademarks.⁵⁴ There is no way to fully count the number of racist trademarks, but in 1970 there were over 3,000 U.S.-based athletic teams using Indigenous names or images.⁵⁵

One might assume that such trademarks persisted because there was no opposition to them. But that narrative erases the considerable advocacy by marginalized groups and their allies to call attention to these stereotypes and stop their use.⁵⁶ Among these were the successful efforts in the early 1950s by the National Association for the Advancement of Colored People (“NAACP”) to boycott and stop the production of the Amos ‘n’ Andy media franchise, which will be discussed in Part II.⁵⁷ Likewise, the National Congress of American Indians (“NCAI”) raised awareness of the harm Indigenous sports mascots caused and called for their elimination in the 1960s.⁵⁸ NCAI’s work, along with that of other civil rights organizations, eventually resulted in the first major elimination of an Indigenous mascot. The University of Oklahoma’s “Little Red” was retired in 1970.⁵⁹ The timing of these victories coincided, not surprisingly, with the broader civil rights movement. The elimination of racist branding was among the many fields in which modest progress was made.⁶⁰

Civil rights organizations were most successful in getting athletic teams and related organizations to drop their use of Indigenous names and mascots. This culminated in 2005 with the National Collegiate Athletic Association (“NCAA”) using its considerable leverage to ban schools from its postseason tournaments if they had Indigenous names or mascots, subject to limited exceptions.⁶¹ These efforts may

⁵⁴ See Aoun, *supra* note 43, at 569–87 (documenting negative stereotypes and remarking that they were used in a matter-of-fact manner and without controversy during the first half of twentieth century).

⁵⁵ Conrad, *supra* note 27, at 105.

⁵⁶ Aoun, *supra* note 43, at 589–90 (noting that although there had been continuous resistance, “most of the dominant hegemony typically ignored those contestatory efforts.”).

⁵⁷ See *infra* Section II.B.

⁵⁸ Phillips, *supra* note 48, at 1067–68 (documenting results of NCAI’s efforts).

⁵⁹ See *id.* at 1068–70; see also Val Pippis & Connie Ruggles, *Little Red: What Is at Issue?*, SOONER MAGAZINE, Oct. 1970, at 21–22 (providing contemporary account of efforts to eliminate mascot).

⁶⁰ But see Katie R. Eyer, *The New Jim Crow Is the Old Jim Crow*, 128 YALE L.J. 1002, 1016 (2019) (tempering the historical accounts of widespread, significant victories during civil rights movement).

⁶¹ Press Release, NCAA, NCAA Executive Committee Issues Guidelines for Use of Native American Mascots at Championship Events (Aug. 5, 2005), <http://fs.ncaa.org/Docs/PressArchive/2005/Announcements/NCAA%2BExecutive%2BCommittee%2BIssues%2BGuide>

have been successful because they could target a single organization such as the NCAA to address a recurrent nationwide problem. It is much more difficult to address the countless ways in which racist trademarks perpetuate harmful stereotypes in all aspects of American life. There were a number of efforts to eliminate the Aunt Jemima brand before 2020, but they resulted in only minor makeovers rather than abolition.⁶² Aunt Jemima is only one of many food brands that have employed racist imagery—Uncle Ben’s, Land O’Lakes, Eskimo Pie, and Chiquita immediately come to mind—and that does not even begin to scratch the surface of the links between iconic brands and racism.⁶³

But even within the realm of athletic teams, there were limits on the ability of advocates to sway the minds of those with power to make changes. When the Washington football team’s owner was asked by a *USA Today* reporter whether he would change the former name of the team, he remarked: “We’ll never change the name. It’s that simple. NEVER—you can use caps.”⁶⁴ Suzan Harjo, a Cheyenne and Muscogee woman, turned to trademark law for relief instead, petitioning the USPTO to exercise its power to cancel Washington’s ignominious trademark registrations.⁶⁵

lines%2Bfor%2BUse%2Bof%2BNative%2BAmerican%2BMascots%2Bat%2BChampionship%2BEvents.html [https://perma.cc/GD39-NWDN]; see also Russ VerSteeg, *Blackhawk Down or Blackhorse Down? The Lanham Act’s Prohibition of Trademarks that “May Disparage” & the First Amendment*, 68 OKLA. L. REV. 677, 694–95 (2016) (describing NCAA’s prohibition).

⁶² See Snouwaert, *supra* note 14 (detailing changes to the name and logo over course of its history).

⁶³ See, e.g., Marguerite Ward & Melissa Wiley, *15 Racist Brands, Mascots, and Logos that Were Considered Just Another Part of American Life*, BUS. INSIDER (Feb. 3, 2022, 11:54 AM), <https://www.businessinsider.com/15-racist-brand-mascots-and-logos-2014-6> [https://perma.cc/7LVK-2HEJ] (identifying fifteen iconic brands with racist imagery in various industries); *From Gucci to Prada, Luxury Fashion Brands Challenged to Confront Racist Attitudes*, USA TODAY (June 22, 2020, 7:34 AM), <https://www.usatoday.com/story/entertainment/celebrities/2020/06/22/luxury-fashion-brands-get-blowback-racism-gucci-prada-loreal/3234226001/> [https://perma.cc/G4E6-WKZB] (noting incidents of fashion brands employing harmful racial stereotypes).

⁶⁴ Dan Cancian, *From “Never” to Name Change, How Dan Snyder Lost Redskins Battle*, NEWSWEEK (July 13, 2020, 10:45 AM), <https://www.newsweek.com/never-name-change-dan-snyder-washington-owner-1517385> [https://perma.cc/WFN8-NK8Q] (discussing pressure that led team owner to drop trademark).

⁶⁵ Jake Achiezer Guggenheim, *Renaming the Redskins (and the Florida State University Seminoles): The Trademark Registration Decision and Alternative Remedies*, 27 FLA. ST. U. L. REV. 287, 293 (1999); see also Courtland Milloy, *Suzan Harjo Fought for Decades to Remove the Redskins Name. She’ll Wait to Celebrate*, WASH. POST (July 14, 2020, 7:20 PM), https://www.washingtonpost.com/local/suzan-shown-harjo-redskins-name-fight/2020/07/14/6f382d16-c5f4-11ea-b037-f9711f89ee46_story.html [https://perma.cc/7EJ9-H6KZ] (profiling Harjo, lead plaintiff in lawsuit to cancel federal registrations).

B. USPTO Stance and Limitations on Authority

Even though the USPTO cannot prohibit an entity from using a trademark, its authority to determine whether a mark should receive and maintain federal registration wields considerable de facto power over whether entities adopt and continue to use such marks.⁶⁶ Congress included two statutory bars in federal registration statutes that arguably could have been used by the USPTO to prohibit the registration of at least some explicitly racist trademarks.⁶⁷ The first bar, part of the Trademark Act of 1905,⁶⁸ prohibited the registration of “immoral” or “scandalous” marks.⁶⁹ The second, part of the Lanham Act of 1946, prohibited the registration of marks that “disparage . . . persons, living or dead, . . . or bring them into contempt, or disrepute.”⁷⁰

Although there is no comprehensive data on the extent to which the USPTO historically had used these statutory bars to refuse or cancel registrations, anecdotal evidence strongly suggests they were not frequently used for the marks that fall within the ambit of this Article.⁷¹ Furthermore, the USPTO’s own system for categorizing designs reflects the commercial exploitation of several racial and ethnic groups. The USPTO’s online Design Code Search Manual includes a designation for images of humans, which are categorized into “Men,” “Women,” and “Children,” among other groups.⁷² Within the “Men” category, there is no subcategory for white men *qua* white men; designs featuring white men are subcategorized based only on occupa-

⁶⁶ See Jon J. Lee, *Double Standards: An Empirical Study of Patent and Trademark Discipline*, 61 B.C. L. REV. 1613, 1615–16, 1626–28 (2020) (discussing importance of trademark registration and USPTO’s role in process); Conrad, *supra* note 27, at 91.

⁶⁷ 15 U.S.C. § 1052(a) (2018) (stating the statutory bars on disparaging marks and immoral or scandalous marks); see also Vicki Huang, *Trademarks, Race and Slur-Appropriation: An Interdisciplinary and Empirical Study*, 2021 U. ILL. L. REV. 1605, 1607, 1609 (2021) (noting that statutory bars had been used to deny registration of racist words and images).

⁶⁸ Pub. L. No. 84, 33 Stat. 724 (1905) (codified at 15 U.S.C. § 1052).

⁶⁹ 15 U.S.C. § 1052(a); see also Guggenheim, *supra* note 65, at 292–93 (describing statutory bar and reasons for its inclusion).

⁷⁰ 15 U.S.C. § 1052(a) (1946); see also Conrad, *supra* note 27, at 91 (discussing disparagement clause); Rebecca Tushnet, *The First Amendment Walks into a Bar: Trademark Registration and Free Speech*, 92 NOTRE DAME L. REV. 381, 387–89 (2016) (laying out traditional justifications for disparagement bar).

⁷¹ See, e.g., Pace, *supra* note 47, at 28–32 (recounting the few reported decisions implicating either bar).

⁷² *Trademark Design Search Code Manual, Category 2: Human Beings*, U.S. PAT. & TRADEMARK OFF., https://tess2.uspto.gov/tmdb/dscm/dsc_02.htm [<https://perma.cc/GR49-EA69>].

tion or some other feature of an image.⁷³ However, there are subcategories for “American Indians,” “Spaniards or Mexicans, including men wearing sombreros,” and “Asian-Pacific men.”⁷⁴ There are similar subcategories for women, with the addition of “Hawaiian women” but dropping the “sombros” reference from “Spaniards or Mexicans.”⁷⁵ Notably, despite the fact that Land O’Lakes changed its packaging in February 2020 and removed the image of a kneeling Indigenous woman, the image remains on the USPTO’s website as of June 2023 as an example of the “American Indians” subcategory of “Women.” Similarly, the Washington football team’s former logo for the “American Indians” subcategory of “Men” still remains on the USPTO’s website.⁷⁶ Beyond using racial and ethnic groups as subcategories, there are others that reflect harmful racial, ethnic, or gender stereotypes, including “Children wearing folk, historical, farm, Indian or cowboy costumes,” “Women wearing aprons,” and the placement of all subcategories of professions under the “Men” category, including those that depict women.⁷⁷

The USPTO’s reluctance to use the statutory bars might have been fueled by the nebulous standards that had been adopted to implement them.⁷⁸ For a mark to be considered disparaging, the USPTO trademark examiner had to find both that the mark referred to an identifiable group and that a “substantial composite, although not necessarily a majority, of the referenced group would find the proposed mark . . . to be disparaging in the context of contemporary attitudes.”⁷⁹ This means that the examiner not only needed to have recognized that a trademark referenced a particular racial or ethnic group—which could be missed by an examiner who was not part of that group—but also needed to determine that a “substantial compos-

⁷³ See *id.*

⁷⁴ *Id.*

⁷⁵ *Id.*

⁷⁶ See Mallika Kallingal, *Land O’Lakes Replaces Native American Woman Logo, Touts Farmer-Owned Credentials Instead*, CNN (Apr. 17, 2020, 9:31 PM), <https://www.cnn.com/2020/04/17/us/landolakes-logo-change-trnd/index.html> [<https://perma.cc/45L9-TSKM>] (noting that the company did not address the removal of the image at the time); *Trademark Design Search Code Manual, Category 02: Human Beings*, *supra* note 72. It is important to note that Land O’Lakes actions predated the murder of George Floyd in May 2020.

⁷⁷ *Trademark Design Search Code Manual, Category 02: Human Beings*, *supra* note 72.

⁷⁸ Cf. Megan M. Carpenter & Kathryn T. Murphy, *Calling Bulls**t on the Lanham Act: The 2(a) Bar for Immoral, Scandalous, and Disparaging Marks*, 49 U. LOUISVILLE L. REV. 465, 477 (2011) (claiming that both bars were ineffective on account of their ambiguity and subjectivity).

⁷⁹ *Matal v. Tam*, 137 S. Ct. 1744, 1754 (2017) (alteration in original) (quoting USPTO, TMEP § 1203.03(b)(i) (Apr. 2017)).

ite” of members of the group would believe it to be disparaging.⁸⁰ Although survey evidence could be enlightening, the USPTO does not conduct such surveys itself.⁸¹ The immoral or scandalous bar had a similar threshold requiring that a “substantial composite of the general public would find the mark ‘shocking to the sense of truth, decency, or propriety’; ‘giving offense to the conscience or moral feelings’; ‘calling out for condemnation’; ‘disgraceful’; ‘offensive’; ‘disreputable’; or ‘vulgar.’”⁸² Recent empirical studies confirm that the USPTO had applied both bars inconsistently, occasionally rejecting marks containing certain words while allowing applications containing those or similar words to register.⁸³

The tide appeared to have turned, however, with the Washington football team’s trademarks. In 1992, Suzan Harjo and six other plaintiffs petitioned to cancel the offending marks owned by Pro-Football, Inc., asserting that the marks were both disparaging and scandalous.⁸⁴ Seven years later, the Trademark Trial and Appeal Board (“TTAB”) agreed with the plaintiffs that the marks were disparaging to Indigenous persons and ordered their cancellation on that ground.⁸⁵ Pro-Football appealed to a federal district court, which dismissed the plaintiffs’ challenge on laches grounds; that dismissal ultimately was upheld on appeal.⁸⁶

Undeterred, Harjo recruited Amanda Blackhorse and four additional younger plaintiffs to bring a second cancellation petition in 2006.⁸⁷ Once again, the TTAB canceled the marks as disparaging in

⁸⁰ See Carpenter & Murphy, *supra* note 78, at 471 (noting that the inquiries are often incorrectly conflated); see also Farley, *supra* note 52, at 122–23 (discussing policy choices involved in the definitions that were adopted).

⁸¹ Carpenter & Murphy, *supra* note 78, at 480.

⁸² Iancu v. Brunetti, 139 S. Ct. 2294, 2298 (2019) (compiling different formulations of test).

⁸³ Huang, *supra* note 67, at 1640 (discussing disparagement clause); Barton Beebe & Jeanne C. Fromer, *Immoral or Scandalous Marks: An Empirical Analysis*, 8 N.Y.U. J. INTELL. PROP. & ENT. L. 169, 182 (2019) (discussing immoral or scandalous clause).

⁸⁴ Harjo v. Pro-Football Inc., 50 U.S.P.Q.2d 1705, 1705 (T.T.A.B. 1999); Guggenheim, *supra* note 65, at 290–91.

⁸⁵ Harjo, 50 U.S.P.Q.2d at 1705; see also Phillips, *supra* note 48, at 1064 (discussing decision).

⁸⁶ Pro-Football, Inc. v. Harjo, 565 F.3d 880, 881 (D.C. Cir. 2009); see also Phillips, *supra* note 48, at 1065–66 (recounting arguments and decisions). See generally Vats, *supra* note 53 (positing that laches defense is based on Euro-American conception of time that entrenches white supremacy).

⁸⁷ Farley, *supra* note 52, at 108; see also Hunter Walker, *How Suzan Harjo Helped Defeat the Offensive Washington Football Mascot*, SLATE (June 20, 2014, 11:14 AM), <https://slate.com/business/2014/06/native-american-activist-suzan-harjo-was-a-driving-force-behind-the-u-s-patents-and-trademarks-office-cancellation-of-washington-s-offensive-football-team-mascot.html> [<https://perma.cc/8ZT8-U5RP>] (discussing Harjo’s recruitment efforts after first defeat).

2014.⁸⁸ Pro Football, lacking a strong laches defense, appealed to the federal district court on constitutional grounds, contending that the disparagement clause violated the First Amendment.⁸⁹ Though the district court judge rejected the First Amendment defense, the case was still pending before the Fourth Circuit when the U.S. Supreme Court struck down the disparagement clause in *Matal v. Tam*.⁹⁰

Tam involved the USPTO's refusal to register the band name "The Slants" because it determined that the mark was disparaging to Asians and Asian-Americans, despite the fact that the band had selected the name as an act of self-appropriation to reclaim the slur.⁹¹ *Tam* was followed two years later by *Iancu v. Brunetti*, in which a trademark applicant successfully challenged the immoral or scandalous bar.⁹² Although the outcomes of *Tam* and *Brunetti* are important for understanding the USPTO's limited authority to regulate racist trademarks, neither decision garnered a five-Justice coalition on the approach it would use to resolve future First Amendment challenges to trademark registration.⁹³ Recent changes in the composition of the Supreme Court further complicate how much can be gleaned from the *Tam* and *Brunetti* decisions.⁹⁴ Consequently, this Article will focus on points that these cases broadly agree upon and are significant to this Article.

First, the Court unanimously held in *Tam* that federal registration of private trademarks is not government speech; had it held otherwise, the statutory bars would have been virtually immune from First

⁸⁸ *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080 at *34 (T.T.A.B. 2014); VerSteeg, *supra* note 61, at 697.

⁸⁹ *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 447 (E.D. Va. 2015) (identifying arguments); *see also* VerSteeg, *supra* note 61, at 697 (summarizing arguments).

⁹⁰ *Pro-Football, Inc. v. Blackhorse*, 709 F. App'x 182, 183 (4th Cir. 2018) (explaining procedural posture in its order vacating district court opinion in light of *Tam*).

⁹¹ *Matal v. Tam*, 137 S. Ct. 1744, 1754 (2017); *see also* Huang, *supra* note 67, at 1607–08 (explaining band leader's motivation and reaction to the decision).

⁹² *Iancu v. Brunetti*, 139 S. Ct. 2294, 2302 (2019). For more on *Brunetti* and its implications, *see generally* Case Comment, *Iancu v. Brunetti*, 133 HARV. L. REV. 292 (2019).

⁹³ *See* Ned Snow, *Immoral Trademarks After Brunetti*, 58 HOUS. L. REV. 401, 428 (2020) (noting unclear doctrinal framework); *see also* Meaghan Annett, *When Trademark Law Met Constitutional Law: How a Commercial Speech Theory Can Save the Lanham Act*, 61 B.C. L. REV. 253, 258 (2020) (discussing uncertainty in the constitutionality of other Lanham Act provisions).

⁹⁴ *See, e.g.*, Melissa Quinn, *Supreme Court's Conservatives Assert Control as Momentous Term Comes to an End*, CBS NEWS (June 30, 2022, 7:24 PM), <https://www.cbsnews.com/news/supreme-court-conservative-justices-abortion-guns-religious-rights/> [<https://perma.cc/ZR8A-B9ZD>]; Howard S. Hogan, Max Schulman & Lucas C. Townsend, *Where Does Judge Barrett Fall on IP Issues?*, BLOOMBERG L. (Sept. 30, 2020, 4:00 AM), <https://news.bloomberglaw.com/ip-law/where-does-judge-barrett-fall-on-ip-issues> [<https://perma.cc/J7U4-TCMU>].

Amendment attack.⁹⁵ In reaching this determination, the Court distinguished several cases in which the government speech doctrine had applied, including *Pleasant Grove City v. Summum*.⁹⁶ *Summum* involved a challenge to a municipality's practice of accepting some donated monuments but not others for public display in a city park.⁹⁷ That opinion held that government entities can selectively accept or reject such monuments at their discretion without implicating the First Amendment, subject to limited exceptions.⁹⁸ Likewise, the Supreme Court distinguished *Walker v. Texas Division, Sons of Confederate Veterans*,⁹⁹ which had deemed Texas's specialty license plates as government speech despite the fact that people could apply to have them custom designed, on account of the state's control over production of the plates and the messages displayed on them.¹⁰⁰

Second, there was consensus on the Court that both the disparagement clause at issue in *Tam* and the immoral or scandalous clause at issue in *Brunetti* were viewpoint restrictions on speech and that such restrictions on federal trademark registration are unconstitutional.¹⁰¹ In reaching this decision, the Court made it clear that trademark laws can violate the First Amendment even when they do not ban or punish expression; denying federal registration to those whose marks "express[] ideas that offend" is enough to implicate its structures.¹⁰² In *Tam*, the USPTO had asserted an interest in "preventing underrepresented groups from being bombarded with demeaning messages in commercial advertising."¹⁰³ Writing for a four-Justice plurality, Justice Alito responded that "[s]peech that demeans on the basis of race, ethnicity, gender, religion, age, disability, or any other

⁹⁵ *Tam*, 137 S. Ct. at 1760; see also Yvette Joy Liebesman, *Offensive Mark Owners Have an Enforcement Problem*, 59 HOUS. L. REV. 57, 60 (2021) (exploring consequences of ruling and implications had it found otherwise).

⁹⁶ 555 U.S. 460 (2009) (cited in *Tam*, 137 S. Ct. at 1759–60). For a discussion of *Summum* and the context of that case, see Daniel J. Hemel & Lisa Larrimore Ouellette, *Public Perceptions of Government Speech*, 2017 SUP. CT. REV. 33, 35.

⁹⁷ *Summum*, 555 U.S. at 465–66.

⁹⁸ *Id.* at 480; cf. Douglas Laycock, *Government-Sponsored Religious Displays: Transparent Rationalizations and Expedient Post-Modernism*, 61 CASE W. RESV. L. REV. 1211, 1249 (2011) (positing that this discretion should have limits in relation to religious displays).

⁹⁹ 135 S. Ct. 2239 (2015).

¹⁰⁰ *Tam*, 137 S. Ct. at 1760 (distinguishing *Walker*); see also Tushnet, *supra* note 70, at 389–92 (comparing *Walker* with trademark registration).

¹⁰¹ See *Iancu*, 139 S. Ct. at 2296 (describing *Tam* holding and finding that it applied to the immoral or scandalous bar); see also Liebesman, *supra* note 95, at 59–60.

¹⁰² *Tam*, 137 S. Ct. at 1751, 1753.

¹⁰³ See *id.* at 1764 (describing Government's arguments that had been echoed in a lower court's opinion) (internal quotations omitted).

similar ground is hateful; but the proudest boast of our free speech jurisprudence is that we protect the freedom to express “the thought that we hate.”¹⁰⁴

Though it is unclear what level of scrutiny applies to the current system of federal trademark registration,¹⁰⁵ *Tam* and *Brunetti* have practically put an end to the USPTO refusing to register or cancelling the registration of trademarks on the ground that they are racially explicit or otherwise discriminatory.¹⁰⁶ Although recent empirical research indicates that there has not been a dramatic increase in racially oriented trademark applications since *Tam*,¹⁰⁷ such applications are now more likely to register.¹⁰⁸

C. *Racial Reckoning Comes to the Marketplace*

It all changed on May 25, 2020. George Floyd’s murder at the hands of a white Minneapolis police officer, vividly captured on video, laid bare the violence that has been unjustifiably inflicted on Black people in Minneapolis and throughout the country.¹⁰⁹ There were other well-publicized incidents of brutality against Black persons earlier that year, but George Floyd was the breaking point.¹¹⁰ And the

¹⁰⁴ *Id.* (quoting *United States v. Schwimmer*, 279 U.S. 644, 655 (1929) (Holmes, J., dissenting)); cf. Katherine K. Carey, *Preventing Tam’s “Proudest Boast” from Protecting the Proud Boys*, 71 EMORY L.J. 609, 644 (2022) (decrying “expan[sion of] free speech absolutism” into trademark law).

¹⁰⁵ Snow, *supra* note 93, at 428–29; see also Lisa P. Ramsey, *Free Speech Challenges to Trademark Law After Matal v. Tam*, 56 HOUS. L. REV. 401, 434–55 (2018) (prognosticating on how free speech challenges should be evaluated following *Tam*). See generally Tushnet, *supra* note 70 (discussing proper standards to apply and suggesting that much of Lanham Act could be unconstitutional were heightened scrutiny to be used).

¹⁰⁶ See Huang, *supra* note 67, at 1609–10 (noting the interest in how the Supreme Court decisions would affect filings); Carey, *supra* note 104, at 640 (indicating that several such applications were filed on day *Tam* was decided).

¹⁰⁷ See Huang, *supra* note 67, at 1643–44 (explaining that the USPTO has only been refusing to register variations of the “n-word,” and those refusals were based on the fact that the applications were for symbols that failed to function as trademarks).

¹⁰⁸ See generally Lisa P. Ramsey, *Using Failure to Function Doctrine to Protect Free Speech and Competition in Trademark Law*, 104 IOWA L. REV. ONLINE 70, 74–76 (2020) (discussing how the failure to function doctrine can be used to keep “inherently valuable” expression in the public domain).

¹⁰⁹ Evan Hill, Alnara Tiefenthäler, Christiaan Triebert, Drew Jordan, Haley Willis & Robin Stein, *How George Floyd Was Killed in Police Custody*, N.Y. TIMES (May 21, 2020), <https://www.nytimes.com/2020/05/31/us/george-floyd-investigation.html> [<https://perma.cc/8NGJ-CNZ3>]; see also Elliott C. McLaughlin, *How George Floyd’s Death Ignited a Racial Reckoning that Shows No Signs of Slowing Down*, CNN (Aug. 9, 2020, 11:31 AM), <https://www.cnn.com/2020/08/09/us/george-floyd-protests-different-why/index.html> [<https://perma.cc/C2KB-SVCU>] (explaining how the videos of the murder sparked the racial reckoning).

¹¹⁰ Nicole Chavez, 2020: *The Year America Confronted Racism*, CNN, <https://>

world, cut off from in-person interactions by a pandemic that had a disproportionate impact on Black, Indigenous, and Hispanic communities,¹¹¹ was watching the video and ensuing Black Lives Matter protests from their televisions, laptops, and iPhones.¹¹²

Commercial enterprises had largely avoided coming under the microscope when the country was gripped with previous instances of police brutality against Black persons. To be sure, there had been isolated company-level changes, such as the renaming of “Sambo’s” restaurants in the Northeast to “Sam’s” in 1981 in response to concerted efforts by the NAACP and others,¹¹³ but corporate America had been essentially absent from the broader discussions about combatting racial injustice and systemic racism.¹¹⁴ This time, amid the calls for greater police accountability, removal of Confederate statutes, and announcements of changes to the names of schools and educational buildings, private commercial entities publicly announced that they would, to borrow from the band formerly known as the Dixie Chicks, “meet this moment.”¹¹⁵

Rather than attempt to catalog all the companies that announced changes to their brand names, logos, and other verbal or pictorial symbols in summer 2020, this Article will identify representative examples that illustrate the trademark issues that arise. As noted in the Introduction, Quaker Oats announced on June 17, 2020, that it would change its branding, unveiling the Pearl Milling Company name and mill logo eight months later.¹¹⁶ On the same day as Quaker Oats’s announcement, Mars issued a press release announcing that it was “the right time to evolve the Uncle Ben’s brand, including its visual

www.cnn.com/interactive/2020/12/us/america-racism-2020/ [<https://perma.cc/JA8A-EHP7>] (providing timeline of events leading up to and following Floyd’s murder).

¹¹¹ Cary P. Gross, Utibe R. Essien, Saamir Pasga, Jacob R. Gross, Shi-yi Wang & Marcella Nunez-Smith, *Racial and Ethnic Disparities in Population-Level Covid-19 Mortality*, 35 J. GEN. INTERN. MED. 3097, 3097–99 (2020).

¹¹² See Chavez, *supra* note 110.

¹¹³ Luis Overbea, *Sambo’s Fast-Food Chain, Protested by Blacks Because of Name, Is Now Sam’s in 3 States*, CHRISTIAN SCI. MONITOR (Apr. 22, 1981), <https://www.csmonitor.com/1981/0422/042256.html> [<https://perma.cc/Z574-WD3J>].

¹¹⁴ Cf. EDELMAN, THE FIGHT FOR RACIAL JUSTICE IN AMERICA 4, 10 (2020) (presenting results of study focusing on consumer attitudes related to businesses’ responses after George Floyd’s murder).

¹¹⁵ See, e.g., Ben Zimmer, *What Dixie Really Means*, THE ATLANTIC (June 26, 2020), <https://www.theatlantic.com/culture/archive/2020/06/what-dixie-really-means/613585/> [<https://perma.cc/SB3P-PAQK>]; Chavez, *supra* note 110; Laura Spitalniak, *Colleges Seek Better Ways to Rename Buildings*, HIGHER ED DIVE (Mar. 22, 2022), <https://www.highereddive.com/news/colleges-seek-better-ways-to-rename-buildings/620725/> [<https://perma.cc/R4YT-79R9>].

¹¹⁶ Kowitz, *supra* note 8.

identity.”¹¹⁷ Three months later, Mars announced it would change its brand to “Ben’s Original” and remove the image of the elderly Black man in a bow tie that had become synonymous with it.¹¹⁸ Like the Pearl Milling Company packaging, the Ben’s Original packaging retained its prior color scheme and its name was written in the same font.¹¹⁹

Cream of Wheat, produced by B&G Foods, likewise announced on June 17, 2020, that it would conduct an “immediate review” of its logo, which featured a smiling Black chef in a bow tie serving cereal— itself an update of the “Rastus” character that had decorated its cereal boxes in the 1920s.¹²⁰ B&G Foods rebranded in September 2020, indicating that it would remove the offending image from its packaging.¹²¹ Dreyer’s stopped its production of Eskimo Pie in June while it developed a plan to rebrand as “Edy’s Pie,” and it discarded the image of an Inuit child wearing a parka.¹²² Restaurant chain Sambo’s, down to a single location after its heyday half a century prior, covered its sign with a peace symbol and the word “LOVE” on June 6, 2020, while it contemplated its new identity.¹²³

The changes went beyond the food and restaurant industries. Country music groups Lady Antebellum and the Dixie Chicks excised references to the Lost Cause narrative as they became Lady A and

¹¹⁷ Press Release, Mars, Inc., Uncle Ben’s Brand Evolution (June 17, 2020), <https://www.mars.com/news-and-stories/press-releases/uncle-bens-brand-evolution> [<https://perma.cc/Z28F-J6F6>]; see also McEvoy, *supra* note 2 (noting that the companies’ announcements were hours apart).

¹¹⁸ McEvoy, *supra* note 2.

¹¹⁹ Alicia Wallace, *Uncle Ben’s Has a New Name: Ben’s Original*, CNN (Sept. 23, 2020, 4:15 AM), <https://www.cnn.com/2020/09/23/business/uncle-bens-rice-rebrand-bens-original/index.html> [<https://perma.cc/A253-6UYY>].

¹²⁰ Emily Heil, *After Aunt Jemima Was Retired, Companies Are Rethinking Uncle Ben, Cream of Wheat and Mrs. Butterworth’s*, WASH. POST (June 18, 2020, 8:30 AM), <https://www.washingtonpost.com/news/voraciously/wp/2020/06/18/after-aunt-jemima-was-retired-companies-are-rethinking-uncle-ben-cream-of-wheat-and-mrs-butterworth-images/> [<https://perma.cc/2JD6-PSX7>] (discussing the flurry of announcements).

¹²¹ Marie Fazio, *Cream of Wheat to Drop Black Chef from Packaging, Company Says*, N.Y. TIMES (Sept. 27, 2020), <https://www.nytimes.com/2020/09/27/business/cream-of-wheat-man.html> [<https://perma.cc/FDC6-VUWM>].

¹²² Jordan Valinsky, *Eskimo Pie Is Getting Rid of Its Derogatory Name*, CNN (Oct. 7, 2020, 10:39 AM), <https://www.cnn.com/2020/10/06/business/eskimo-pie-name-change/index.html> [<https://perma.cc/38UD-4YVA>] (containing a discussion of the connotation of “Eskimo”).

¹²³ Delaney Smith, *Amid Protests, “Peace & Love” Is New Motto for Last Standing Sambo’s Restaurant*, SANTA BARBARA INDEP. (June 5, 2020, 5:52 PM), <https://www.independent.com/2020/06/05/amid-protests-peace-love-is-new-motto-for-last-standing-sambos-restaurant/> [<https://perma.cc/A9QH-DM35>] (reporting on actions of Santa Barbara location).

The Chicks, respectively.¹²⁴ The wave of changes went all the way to the Washington football team, which announced on July 13, 2020, that it would retire its name and logo, no doubt due to intense pressure applied by many of the team's sponsors.¹²⁵ After eighteen months of going by "Washington Football Team," it settled on "Washington Commanders,"¹²⁶ keeping the gold and burgundy colors but adopting a stylized "W" as its logo.¹²⁷

D. *The Normative Case for Facilitating the Shedding of Racist Trademarks*

A company's decision to stop using a trademark is a business decision that also may have dramatic consequences for the company's legal rights vis-à-vis others' use of the discarded mark.¹²⁸ Accordingly, it is worth considering the ways in which trademark law facilitates or inhibits such a decision. This Article does not purport to address the extent to which the law should be reformed to serve antiracist ends more broadly, which would go well beyond the narrow issue of trademark abandonment.¹²⁹ But to contextualize this Article's concerns and evaluate potential solutions, this Section will marshal three primary justifications that have been proffered for facilitating the removal of racist trademarks from the consumer marketplace.

The first is the detrimental psychological impact that negative stereotyping in commercial settings has on those in targeted communities.¹³⁰ Dr. Stephanie Fryberg, an enrolled member of the Tulalip

¹²⁴ Sisario, *supra* note 4.

¹²⁵ Carpenter, *supra* note 6.

¹²⁶ *The Washington Football Team Is Now the Washington Commanders*, COMMANDERS (Feb. 2, 2022), <https://www.commanders.com/news/the-washington-football-team-is-now-the-washington-commanders> [<https://perma.cc/PMZ7-TJTN>]; Eric Levenson & Jack Bantock, *Washington Commanders: NFL Franchise Reveals New Team Name*, CNN (Feb. 2, 2022, 8:41 AM), <https://www.cnn.com/2022/02/02/us/washington-football-team-name/index.html> [<https://perma.cc/5VPQ-WQUK>] (discussing name change announcement).

¹²⁷ See *The Washington Football Team Is Now the Washington Commanders*, *supra* note 126.

¹²⁸ See, e.g., Linford, *supra* note 19, at 812–15 (describing examples of consequences of trademark abandonment).

¹²⁹ See, e.g., Kimberlé Williams Crenshaw, *This Is Not A Drill: The War Against Antiracist Teaching in America*, 68 UCLA L. REV. 1702, 1725–26 (2022) (speaking about critical need to train antiracist lawyers and public servants); Kathryn Stanchi, *The Rhetoric of Racism in the United States Supreme Court*, 62 B.C. L. REV. 1251, 1320 (2021) (exploring Supreme Court's reticence to "call out racism when [they] see it and do so directly and unequivocally"). For another example of a scholar proposing reforms to combat use of harmful racist imagery in trademarks, see M. Alexander Pearl, *Redskins: The Property Right to Racism*, 38 CARDOZO L. REV. 231, 257 (2016).

¹³⁰ See, e.g., Gerhardt, *supra* note 22, at 250–52; Farley, *supra* note 52, at 110–12; STEPHA-

Tribes who has conducted extensive original research on the subject, found that showing Indigenous persons pictures of Indigenous mascots lowered respondents' feelings of self-esteem, "community efficacy"—the perceived value of the community and the individual's place in it—and "achievement-related possible selves"—seeing oneself as achieving future academic or professional success.¹³¹ As part of the American Psychological Association's 2005 resolution calling upon athletic teams to stop using Indigenous names and imagery, it referenced studies linking decreased self-esteem to "negative behaviors such as substance use and abuse, self-harming, and interpersonal violence."¹³² Professor M. Alexander Pearl, an enrolled citizen of the Chickasaw Nation, aptly describes the origin of the problem when his daughter points out commercial visual representations of Indigenous persons:

These images, and the absence of other images of Native people in mainstream media, define [my children] and me in fictional terms. They construct a box around who we are and what we are capable of doing and being. The worst part is that the law of property and trademark reinforces that box, to our collective detriment and sustained harm.¹³³

The second justification proffered for the removal of racist trademarks is the effect that these same words and images have on those not in the targeted group. Dr. Fryberg conducted another, similar study on the use of Indigenous names and mascots, this time showing the images to European Americans.¹³⁴ The images had a positive effect on the participants' self-esteem, which she surmised may explain why "they may not be motivated to cease using the image" even when they hear that such images are harmful to those in the targeted group.¹³⁵ These commercial representations themselves beget further

NIE A. FRYBERG, AMERICAN INDIAN SOCIAL REPRESENTATIONS: DO THEY HONOR OR CON-
STRAIN AMERICAN INDIAN IDENTITIES? 2 (2004), http://www.indianmascots.com/ex_15_-_fryberg_brown_v.pdf [<https://perma.cc/7VZB-YP9M>]; Pearl, *supra* note 129, at 244–47 (discussing roles that stereotypes play, particularly among smaller groups).

¹³¹ FRYBERG, *supra* note 130, at 2; *see also* Pearl, *supra* note 129, at 248 (expanding upon results of Fryberg study).

¹³² AM. PSYCH. ASS'N, JUSTIFICATION STATEMENT: RESOLUTION RECOMMENDING THE IMMEDIATE RETIREMENT OF AMERICAN INDIAN MASCOTS, SYMBOLS, IMAGES, AND PERSONALITIES BY SCHOOLS, COLLEGE, UNIVERSITIES, ATHLETIC TEAMS, AND ORGANIZATIONS 6–7 (2005); *see also* Aoun, *supra* note 43, at 649–50 (discussing American Psychological Association's efforts).

¹³³ Pearl, *supra* note 129, at 233–34.

¹³⁴ FRYBERG, *supra* note 130, at 8.

¹³⁵ *Id.* at 8–9.

cultural appropriation: “Fans are invited to dress and mock Native traditions and culture.”¹³⁶ Whether consciously or subconsciously, all who are exposed to negative stereotypes in trademarks are affected by them. For example, negative media representations of Black persons affect viewers’ perceptions of their “intelligence, criminality, socioeconomic status, work ethic, and values.”¹³⁷ This phenomenon is arguably even more powerful in the context of trademarks, because by their nature they involve repeated exposures to a stimulus—the trademark—that consumers associate with goods and services they desire.

The third justification proffered for the removal of racist trademarks is the disruption of interstate commerce.¹³⁸ The enactment of the Civil Rights Act of 1964 was justified as a valid exercise of Congress’s Commerce Clause power, and the record it considered at that time was “replete with evidence of the burdens that discrimination by race or color places upon interstate commerce.”¹³⁹ According to those who espouse this view, “[c]ommercial speech that insults groups of people, particularly based on their race, gender, religion, or other demographic identity, tends to disrupt commercial activity and to undermine the stability of the marketplace in much the same manner as discriminatory conduct.”¹⁴⁰ In fact, there are arguably two types of effects on interstate commerce: the primary effect is on those encountering the trademark for the first time, perhaps choosing to take their business elsewhere or to drop out of the market entirely; the secondary effect is how long-term exposure to these trademarks affects the economic well-being of individuals and communities of color.

¹³⁶ Phillips, *supra* note 48, at 1073. *See generally* PHILIP J. DELORIA, PLAYING INDIAN (1998) (providing critical commentary on relationship between Native and non-Native peoples, with the latter employing demeaning stereotypes to mock the former).

¹³⁷ *See generally* DANA MASTRO, RACE AND ETHNICITY IN US MEDIA CONTENT AND EFFECTS, in OXFORD RESEARCH ENCYCLOPEDIA OF COMMUNICATION (2022) (compiling and reporting study results); *see also* Gerhardt, *supra* note 22, at 251 (remarking on phenomenon’s existence).

¹³⁸ *In re Tam*, 808 F.3d 1321, 1379 (Fed. Cir. 2015) (Reyna, J., dissenting) (laying out negative effects on commerce); *cf.* Michael M. Berkebile-Weinberg, Amy R. Krosch & David M. Amodio, *Economic Scarcity Increases Racial Stereotyping in Beliefs and Face Representation*, 102 J. EXPERIMENTAL SOC. PSYCH. 104354 (2022) (tying economic scarcity to increases in prejudiced attitudes and discriminatory behavior).

¹³⁹ *Heart of Atlanta Motel, Inc. v. United States*, 379 U.S. 241, 252 (1964) (using legislative history to support upholding portions of Civil Rights Act).

¹⁴⁰ *In re Tam*, 808 F.3d at 1379–80 (Reyna, J., dissenting). These arguments were raised by the Government and amici in *Tam*. *See, e.g.*, Brief for Native American Organizations as Amici Curiae Supporting Petitioner, *Matal v. Tam*, 137 S. Ct. 1744, 1764 (2017) (No. 15-1293); Lisa P. Ramsey, *A Free Speech Right to Trademark Protection?*, 106 TRADEMARK REP. 797, 807 & n.33 (2016) (describing the federal government’s position in *Tam*).

To be clear, this Article does not claim that the current Supreme Court would find these three justifications persuasive, either individually or collectively, to uphold the enactment of laws that constitute viewpoint regulations of speech. In fact, similar arguments were considered and rejected in *Tam*,¹⁴¹ and there is no indication that the Court has since become more receptive to these arguments. These three justifications nonetheless provide reasons to take a thorough look at trademark law and ask whether there are ways, within constitutional limits, to facilitate the actions of companies that wish to mitigate the harm they have caused by perpetuating their racist branding.

II. TRADEMARK ACQUISITION AND ABANDONMENT

As Part I describes, companies, sports franchises, and entertainers committed to drop their trademarks in recent years because of their association with—and, in some instances, glorification of—this country’s racist history. Unlike Confederate monuments that are removed from their accustomed places, however, racist trademarks will not necessarily leave public view. To understand why that is so, one must become familiar with the fundamentals of trademark protection and its limits.

This Part first describes the underpinnings of trademark protection and how rights are acquired through common law and bolstered by federal registration and enforcement. It then turns to how trademark rights may be lost through abandonment, tracing the evolution of the doctrine from its origins in common law property rights to abandonment’s current statutory formulation. As a result of this shift, a trademark holder may ostensibly forfeit its rights even though it does not wish to part with them.

It should be noted at the outset that the trademark abandonment doctrine is murky and underdeveloped, and there is little scholarly treatment on the subject to date.¹⁴² This Part and the next aim to fill that gap by detailing the current state of the law, explaining the inconsistencies in its application, and identifying areas of continuing uncertainty.

¹⁴¹ See *Tam*, 137 S. Ct. at 1764–65.

¹⁴² See, e.g., Linford, *supra* note 19, at 821–28 (describing trademark forfeiture mechanisms, including abandonment through nonuse, and arguing that these mechanisms do not adequately account for residual goodwill); Bone, *supra* note 38, at 46–51 (explaining how abandonment doctrine does not further utilitarian objectives because of failure to account for residual goodwill).

A. *Trademark Protection and Acquisition*

A trademark is a “word, name, symbol, or device, or any combination thereof” used “to identify and distinguish [a producer’s] goods . . . from those manufactured or sold by others and to indicate the source of the goods.”¹⁴³ Although trademarks have been recognized by the law for centuries, the dominant theoretical account for trademark protection originated three decades ago with William Landes and Richard Posner’s “search costs theory.”¹⁴⁴ Drawing on the principles of law and economics, search costs theory posits that trademarks are beneficial insofar as they reduce consumer search costs, which is “made possible by the information or reputation that the trademark conveys . . . about the brand”¹⁴⁵ If a consumer can be assured that the mark they encounter on a good signals that it comes from a single source they are familiar with, they can efficiently choose to select it without additional research.¹⁴⁶ At the same time, companies will be incentivized to consistently produce high quality goods and services, and those that do “will reap the financial, reputation-related rewards associated with a desirable product.”¹⁴⁷ Put another way, trademark protection facilitates the buildup of commercial goodwill.¹⁴⁸ But the benefits to consumers and producers can be assured only if trademark holders are able to stop those who try to adopt confusingly similar marks.¹⁴⁹

Although trademark rights are often referred to as property rights, they are different than traditional property rights in that they exist only in connection with an entity’s use of the mark in com-

¹⁴³ 15 U.S.C. § 1127 (2018) (defining “trademark” under Lanham Act).

¹⁴⁴ William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 269–70 (1987).

¹⁴⁵ *Id.*; see also Dogan & Lemley, *supra* note 38, at 1224–27 (describing theory).

¹⁴⁶ See Mark P. McKenna, *A Consumer Decision-Making Theory of Trademark Law*, 98 VA. L. REV. 67, 73–75 (2012) (laying out the “information-economizing function” of trademarks, yet arguing that the search-costs theory is incomplete).

¹⁴⁷ *Qualitex Co. v. Jacobson Prod. Co.*, 514 U.S. 159, 164 (1995); see also Barton Beebe & C. Scott Hemphill, *The Scope of Strong Marks: Should Trademark Law Protect the Strong More than the Weak?*, 92 N.Y.U. L. REV. 1339, 1379 (2017) (noting Supreme Court’s recognition of producer incentives in *Qualitex*).

¹⁴⁸ But see Robert G. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86 B.U. L. REV. 547, 554 (2006) (noting that, although goodwill has become associated with trademark law, such a connection is not inherent).

¹⁴⁹ See Graeme B. Dinwoodie & Mark D. Janis, *Confusion over Use: Contextualism in Trademark Law*, 92 IOWA L. REV. 1597, 1624 (2007) (arguing that traditional view is too narrow); see also Michael S. Denniston, *Residual Good Will in Unused Marks—The Case Against Abandonment*, 90 TRADEMARK REP. 615, 616 (2000) (connecting goodwill to infringement, advocating against abandonment when there is residual goodwill).

merce.¹⁵⁰ This was made clear by the U.S. Supreme Court in the *Trade-Mark Cases*,¹⁵¹ which invalidated Congress' first attempt to enact a trademark registration system under the Commerce Clause because it was not limited to marks that had been used in interstate commerce.¹⁵² In explaining how trademarks differed from other types of intellectual property that Congress could regulate pursuant to the "Intellectual Property" Clause, the Supreme Court noted that "[a] common law the exclusive right to [a trademark] grows out of its *use*, and not its mere adoption."¹⁵³ The reasons for this distinction are twofold. First, a symbol used as a trademark is not necessarily original, so there is no need to extend copyright-like protections to its adopter.¹⁵⁴ Second, the protection of trademarks is linked to preventing diversions of trade, so unless an entity has been using the symbol to identify its goods, the symbol's appropriation by a competitor would not divert sales away from it.¹⁵⁵

In addition to demonstrating that a mark has been used in commerce, an entity seeking trademark protection must show that the mark is distinctive. This means that the entity can uniquely identify the source of the goods or services to which the mark is connected.¹⁵⁶ Entities may show distinctiveness in one of two ways: (1) a symbol may be inherently distinctive, such that its nature would automatically signal to a consumer that it is being used as a trademark or (2) it may have acquired distinctiveness by virtue of the entity using the mark in such a way that consumers in fact recognize that it identifies a single source.¹⁵⁷

¹⁵⁰ Adam Mossoff, *Trademark as a Property Right*, 107 KY. L.J. 1, 18, 29 (2019) (noting differences between trademark rights and others that are not "use based"); *see also* Alexandra J. Roberts, *Trademark Failure to Function*, 104 IOWA L. REV. 1977, 1982–85 (2019) (discussing how "use" requirement has been overlooked, particularly in relation to a symbol's use as a trademark).

¹⁵¹ 100 U.S. 82 (1879).

¹⁵² *Trade-Mark Cases*, 100 U.S. at 98.

¹⁵³ *Id.* at 94.

¹⁵⁴ *See id.* at 84 ("If we should endeavor to classify [trademarks] under the head of writings of authors, the objections are equally strong. In this, as in regard to inventions, originality is required."); *see also* Eric E. Johnson, *Intellectual Property and the Incentive Fallacy*, 39 FLA. ST. U. L. REV. 623, 626 (2012) (noting that trademark law has not been rooted in "giv[ing] incentives for creative or innovative labor, but rather to legally protect indications of commercial source," yet observing that it sometimes acts in that way).

¹⁵⁵ *See* McKenna, *supra* note 38, at 1896 (identifying historical protection while discussing modern shift in focus to protection of brands).

¹⁵⁶ 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 4:13 (5th ed. 2022); *see also* Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 670 (2004) (describing traditional distinctiveness inquiry).

¹⁵⁷ 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION

The third primary hurdle that must be cleared before an entity can validly enforce claimed trademark rights is that they must fend off any claims that another business has priority in the use of a confusingly similar mark. Under common law, the issue of priority generally turns on which party can show that it had used its mark first in commerce in the relevant geographic market.¹⁵⁸ If the two marks are not confusingly similar, both entities will be able to use them in the same market, but if the two marks are confusingly similar, only the entity having priority will have trademark rights in the market.¹⁵⁹

Although an entity may rely on its common law trademark rights, many businesses seek federal registration to bolster those rights. The Lanham Act provides the modern statutory framework for federal registration.¹⁶⁰ By and large, the basic requirements for federal registration mirror those for common law trademark protection: the applied-for mark must be distinctive and the entity must be using the mark in commerce.¹⁶¹ The Lanham Act provides a definition of the phrase “use in commerce” that is of significance to this Article: “the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.”¹⁶² This definition was amended as part of the Trademark Law Revision Act of 1988 to eliminate “token use[s],” which had previously “allowed a prospective trademark owner to acquire rights in a mark . . . through a limited or token sale or shipment of a product.”¹⁶³

The Lanham Act contains several statutory bars to registration. As detailed in Part I, the Supreme Court recently invalidated the bars against disparaging and immoral or scandalous marks.¹⁶⁴ The other statutory bar of relevance to this Article is the likelihood-of-confusion bar, which prevents registration of a mark:

§ 4:13 (5th ed. 2022); *see also* Beebe, *supra* note 156, at 670 (explaining inherent and acquired distinctiveness).

¹⁵⁸ *See* 5 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 26:2 (5th ed. 2022) (laying out common law priority).

¹⁵⁹ *See id.*

¹⁶⁰ *See* Lanham Act, 15 U.S.C. §§ 1051–1141n (1946); *see also* Deborah R. Gerhardt & Jon J. Lee, *A Tale of Four Decades: Lessons from USPTO Trademark Prosecution Data*, 112 TRADEMARK REP. 865, 868–73 (2022) (describing process for seeking federal trademark registration).

¹⁶¹ *See* 15 U.S.C. § 1127 (2018) (defining “trademark”).

¹⁶² *Id.* (defining “use in commerce”).

¹⁶³ Frank Z. Hellwig, *Acquisition of Trademark Rights Under the Trademark Law Revision Act of 1988*, 80 TRADEMARK REP. 311, 314 (1990) (detailing changes brought about by Trademark Law Revision Act, including elimination of “token use”); *see also* 15 U.S.C. § 1127 (2018) (current definition).

¹⁶⁴ *See supra* Section I.B.

[W]hich so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive¹⁶⁵

This statutory bar is the analog of the priority hurdle discussed in connection with common law trademark rights, for it generally prohibits registration of marks that would be confusingly similar to any currently registered marks or unregistered marks with priority that have not been abandoned.¹⁶⁶

Once an entity secures federal registration of a mark, it has a number of additional tools to enforce its rights. Federal registration signifies *prima facie* evidence that the mark is valid.¹⁶⁷ The entity can attach a specific registration notice to its marks—the familiar “®”—indicating that it has federally recognized intellectual property rights.¹⁶⁸ The primary benefit of federal registration, however, is that it confers priority on the registrant throughout the United States as of the application date, even if the mark has only been used in a limited geographic area.¹⁶⁹

To maintain federal registration of a trademark, its owner must periodically complete two tasks. First, the owner must apply for renewal every tenth year following registration.¹⁷⁰ Second, the owner must file a declaration of continued use during the sixth year following registration and thereafter in conjunction with the application for renewal.¹⁷¹ As part of the declaration of use, the owner must confirm that it is still using the mark in commerce in connection with each of the goods or services listed in the registration and attach a specimen as proof of that use.¹⁷² In the event that an owner has ceased using a mark in commerce in connection with a class of goods and services but wishes to avoid cancellation on account of abandonment, it must list

¹⁶⁵ 15 U.S.C. § 1052(d).

¹⁶⁶ See 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 20:15 (5th ed. 2022) (explaining application of statutory bar, which turns on priority).

¹⁶⁷ 15 U.S.C. § 1057(b).

¹⁶⁸ *Id.* § 1111; see Gerhardt & Lee, *supra* note 160, at 874 (noting the value of this benefit).

¹⁶⁹ 15 U.S.C. §§ 1072, 1057(c); see Deborah R. Gerhardt & Jon P. McClanahan, *Do Trademark Lawyers Matter?*, 16 STAN. TECH. L. REV. 583, 587 (2013) (explaining advantages to federal registration).

¹⁷⁰ See 15 U.S.C. § 1059.

¹⁷¹ See *id.* § 1058(a)–(b) (setting out requirements for affidavits and timeframes for submission).

¹⁷² See *id.* § 1058(b).

the “special circumstances” that justify nonuse, including “the reason for nonuse, the specific steps being taken to put the mark back in use, and any other relevant facts to support a finding of excusable nonuse.”¹⁷³ If the owner fails to file a declaration of use or fails to satisfy the examiner that its nonuse is justified, the registration will be canceled and its owner will lose the protections outlined above.¹⁷⁴

The Lanham Act provides several federal causes of action for trademark right holders, irrespective of whether the marks have been federally registered. Most importantly to this Article, all current holders of enforceable trademarks can sue for infringement, which occurs when another entity uses a similar mark in commerce that is likely to cause confusion among consumers.¹⁷⁵ To maintain this cause of action, plaintiffs first must establish that they have existing rights in the marks that are allegedly being infringed upon.¹⁷⁶ State statutory and common law causes of action generally track the Lanham Act, particularly when it comes to trademark infringement.¹⁷⁷ Accordingly, this Article will limit its discussion to the federal cause of action.¹⁷⁸

B. *Trademark Abandonment: General Principles*

There is a robust scholarly debate regarding whether trademark ownership should be conceived of as a true property right.¹⁷⁹ Irrespective of the outcome of that normative debate, though, American courts historically regarded it as such—particularly in how they

¹⁷³ U.S. PAT. & TRADEMARK OFF., TMEP § 1604.11 (July 2022); *Registration Maintenance/Renewal/Correction Forms*, U.S. PAT. & TRADEMARK OFF., (Dec. 7, 2022), <https://www.uspto.gov/trademarks/maintain> [https://perma.cc/Q9LR-D9ZK] (compiling maintenance information and forms).

¹⁷⁴ See 15 U.S.C. § 1058(a) (explaining that failing to comply will result in cancellation).

¹⁷⁵ See *id.* § 1114(1) (federally registered marks); *id.* § 1125(a) (applying to all marks, irrespective of whether registered).

¹⁷⁶ See Rebecca Tushnet, *Registering Disagreement: Registration in Modern American Trademark Law*, 130 HARV. L. REV. 867, 889 (2017) (noting that infringement analysis works the same for registered and unregistered marks, though registered marks have some procedural advantages).

¹⁷⁷ See 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 22:1.50 (5th ed. 2022) (identifying similarities).

¹⁷⁸ Although owners of famous marks may also sue for trademark dilution, see 15 U.S.C. § 1125(c), this Article will focus on infringement because infringement has broader applicability and the concerns about the constitutionality of the dilution cause of action are outside the scope of this Article. See generally Lisa P. Ramsey, *Free Speech Challenges to Trademark Law after Matal v. Tam*, 56 HOUS. L. REV. 401, 456–61 (2018) (discussing constitutional concerns about trademark dilution laws in light of the *Tam* decision).

¹⁷⁹ Compare Mossoff, *supra* note 150, at 18 (arguing that trademark rights are a species of use-based property rights), with Bone, *supra* note 148, at 562 (arguing that trademark rights should be viewed as outgrowth of unfair competition).

treated an entity that discontinued the use of its trademark. Mere nonuse was not enough to extinguish the entity's rights; rather, there had to be an abandonment.¹⁸⁰ According to the U.S. Supreme Court in its first case involving trademark abandonment in 1900: "To establish the defense of abandonment it is necessary to show not only acts indicating a practical abandonment, but an actual intent to abandon."¹⁸¹ What is notable about that opinion is the precedent it relied on in adopting and articulating the abandonment doctrine, including a case involving a dispute over the ownership of leather hides¹⁸² and another concerning the relinquishment of real property.¹⁸³ Reasonably read, the opinion shows that the Supreme Court conceived of trademark rights as being similar to those related to traditional property and extended trademark holders considerable latitude to discontinue use without adverse consequences.

Under the historical formulation of the doctrine, abandonment was an affirmative defense that had to be proven by the defendant to preclude enforcement.¹⁸⁴ Although the length of nonuse could be used to draw an inference of an intent to abandon, there was no particular amount of time that automatically triggered such a presumption or inference.¹⁸⁵ Most of the cases in which abandonment was found involved nonuse spanning many years or decades¹⁸⁶—which is indicative of the fact that courts required abandonment to "be strictly proven where a forfeiture is claimed on that ground."¹⁸⁷

¹⁸⁰ 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 17:10 (5th ed. 2022) (summarizing early common law rules).

¹⁸¹ *Saxlehner v. Eisner & Mendelson Co.*, 179 U.S. 19, 31 (1900); *see also* *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 418–19 (1916) (reiterating rule announced in *Saxlehner*).

¹⁸² *Saxlehner*, 179 U.S. at 31 (citing *Livermore v. White*, 74 Me. 452, 454 (1883)).

¹⁸³ *Id.* (citing *Hickman v. Link*, 116 Mo. 123 (1893)).

¹⁸⁴ 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 17:12 (5th ed. 2022) (discussing burden of proof and standard); *see also* Jonathan B. Schwartz, Comment, *Less Is More: Why a Preponderance Standard Should Be Enough for Trademark Abandonment*, 42 U.C. DAVIS L. REV. 1345, 1350–51 (2009) (discussing common law abandonment doctrine and contrasting it with statutory provision).

¹⁸⁵ *See, e.g.*, *Imperial Tobacco Ltd. v. Philip Morris, Inc.*, 899 F.2d 1575, 1579 (Fed. Cir. 1990) (discussing common law); *Bisceglia Bros. Corp. v. Fruit Indus. Ltd.*, 20 F. Supp. 564, 568 (E.D. Pa. 1937); Schwartz, *supra* note 184, at 1350 (summarizing principles).

¹⁸⁶ *See, e.g.*, *Am. Photographic Pub. Co. v. Ziff-Davis Pub. Co.*, 135 F.2d 569, 573 (7th Cir. 1943) (twenty years); *Corr v. Oldetyme Distillers*, 28 C.C.P.A. 1057, 1060–62 (1941) (sixteen years).

¹⁸⁷ *Saunders v. Stringer*, 251 N.W. 342, 343 (Mich. 1933) (quoting contemporary treatise); 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 17:12 (5th ed. 2022) (reciting standard, which is still used by many courts).

Furthermore, a trademark holder could proffer several different types of evidence to avoid a finding of abandonment. First, the trademark holder could show that it had made token uses of the trademark through limited sales or shipments.¹⁸⁸ These token uses would be sufficient under the common law test to constitute continued use, and they would also show that the trademark holder intended to retain its rights to the mark.¹⁸⁹ Second, the trademark holder could show that it had asserted its rights to the trademark in court or through threats of litigation.¹⁹⁰ The use of the trademark holder's assertion of legal rights to the mark as evidence of nonabandonment seems especially problematic because the abandonment issue was nearly always litigated in the context of a trademark holder suing to enjoin infringing activities.¹⁹¹ Third, a trademark holder could point to statements it had made to others about its intent as credible evidence.¹⁹² Although these circumstances are objective in one sense, they typically would not be given much weight in other contexts in which intent is to be ascertained.¹⁹³

Undoubtedly, the requirement that a challenger seeking to invalidate a holder's trademark rights show that the holder had an intent to abandon was a difficult one to satisfy. Furthermore, it had the effect of permitting a trademark holder to continue to have rights in a mark even if it had no intent to use the mark in the future—which is in considerable tension with the traditional proposition that trademark rights should be connected with a mark's use in commerce.¹⁹⁴

But Congress pared back the ability of trademark holders to hold on to unused marks when it enacted the Lanham Act. It included a statutory definition that provided for two types of abandonment: (1) intentional abandonment, which is the focus of this Article, and (2) unintentional abandonment, which can occur through the process

¹⁸⁸ See, e.g., *Baglin v. Cusenier Co.*, 221 U.S. 580, 588 (1911) (small shipment of wine bearing label in dispute).

¹⁸⁹ See *id.* at 588–89.

¹⁹⁰ See, e.g., *id.* at 589 (suing competitors who used label on wine); *Wallace & Co. v. Repetti, Inc.*, 266 F. 307, 309 (2d Cir. 1920) (suing competitors who attempted to use label on candy boxes).

¹⁹¹ See, e.g., *Repetti*, 266 F. at 309.

¹⁹² See, e.g., *Saunders*, 251 N.W. at 345 (letter stating that plaintiff had not abandoned rights to mark).

¹⁹³ See, e.g., *Gates v. Comm'r*, 199 F.2d 291, 294 (10th Cir. 1952) (stating that a floating intention to return to a prior state is not enough to negate a determination of a change in domicile for diversity jurisdiction); *Mozes v. Mozes*, 239 F.3d 1067, 1075 (9th Cir. 2001) (discussing abandonment of residence).

¹⁹⁴ See *supra* notes 150–55 and accompanying text.

of genericide or other losses of source significance, including assignments in gross and naked licensing.¹⁹⁵ Although the 1946 version of the statute has been modified in some respects, the basic framework for intentional abandonment has remained the same and deems a trademark abandoned “[w]hen its use has been discontinued with intent not to resume such use.”¹⁹⁶ This definition differs considerably from the common law in that it alters the inquiry from whether the trademark holder has an intention to relinquish its rights to whether the trademark holder has an intent to resume use of the mark after its use has been discontinued.¹⁹⁷

The Fifth Circuit reflected on this consequential shift and noted that “[s]topping at an ‘intent not to abandon’ tolerates an owner’s protecting a mark with neither commercial use nor plans to resume commercial use. Such a license is not permitted by the Lanham Act.”¹⁹⁸ Indeed, the legislative history of the Lanham Act suggests that this shift in the doctrine was deliberate because an earlier construction of the provision, “intent to abandon,” was changed to “intent not to resume such use” in the final version.¹⁹⁹

The Lanham Act’s intentional abandonment definition includes three other noteworthy provisions. First, it provides that “[i]ntent not to resume may be inferred from circumstances.”²⁰⁰ Although this principle routinely had been articulated in earlier court decisions involving abandonment,²⁰¹ the statute makes it clear that Congress contemplated that there need not be an express statement by the trademark holder giving up its rights to find abandonment.²⁰² At the same time, a trademark holder cannot avoid abandonment merely by testifying that it intended to resume use.²⁰³

¹⁹⁵ For an excellent overview on these forfeiture mechanisms, see generally Linford, *supra* note 19, at 821–33 (citing 15 U.S.C. § 1127).

¹⁹⁶ 15 U.S.C. § 1127.

¹⁹⁷ 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 17:11 (5th ed. 2022); see *Silverman v. CBS Inc.*, 870 F.2d 40, 46 (2d Cir. 1989) (discussing shift in intent inquiry because of Lanham Act); *Exxon Corp. v. Humble Expl. Co.*, 695 F.2d 96, 102 (5th Cir. 1983) (explaining how shift makes a difference).

¹⁹⁸ *Exxon Corp.*, 695 F.2d at 102–03.

¹⁹⁹ See *Silverman*, 870 F.2d at 46 (using differences in congressional versions to support its interpretation); Denniston, *supra* note 149, at 630–31 (exploring significance).

²⁰⁰ 15 U.S.C. § 1127.

²⁰¹ See, e.g., *Baglin v. Cusenier Co.*, 221 U.S. 580, 598 (1911) (“[W]hile, of course, as in other cases, intent may be inferred when the facts are shown, yet the facts must be adequate to support the finding.”); *Levering Coffee Co. v. Merchants Coffee Co.*, 39 App. D.C. 151, 154 (D.C. Cir. 1912) (applying doctrine).

²⁰² 15 U.S.C. § 1127.

²⁰³ See, e.g., *Silverman*, 870 F.2d at 46 (finding that “asserting its intention to resume use at

Second, the Lanham Act provides that “[n]onuse for 3 consecutive years shall be prima facie evidence of abandonment.”²⁰⁴ Courts have struggled with the precise effect of this provision, which is commonly referred to as a presumption.²⁰⁵ Most circuit courts have held that when it applies, it shifts only the burden of production to the trademark holder to produce evidence of intent to resume use, with the ultimate burden of persuasion remaining with the challenger.²⁰⁶ Because most allegations of intentional trademark abandonment involve companies that have “quietly” discontinued using a mark for a long period of time, which this Article will later term “implied abandonment,” this statutory presumption nearly always comes into play in abandonment challenges that arise in the course of litigation.²⁰⁷ Furthermore, the three-year presumption has been interpreted as providing the relevant window within which a trademark holder must demonstrate that it has an intent to resume use; that is, the trademark holder must provide evidence that it had formed an intent to resume use within three years of the use having been discontinued.²⁰⁸ Courts have also required that the intent to resume use be “in the reasonably foreseeable future.”²⁰⁹ This limitation cuts off arguments by trademark holders that “at some point, should conditions change, it would

some indefinite point in the future” was not enough); *Imperial Tobacco Ltd. v. Philip Morris, Inc.*, 899 F.2d 1575, 1581 (Fed. Cir. 1990) (“[O]ne must, however, proffer more than conclusory testimony or affidavits.”).

²⁰⁴ 15 U.S.C. § 1127. The original provision had a two-year presumption, but it was lengthened to three years in the Trademark Law Revision Act of 1988. Although this might seem to suggest that Congress was responding to concerns about trademark holders losing rights based on shorter periods of nonuse, the change must be considered in conjunction with the elimination of token uses, which had been applied to avoid abandonment. See Hellwig, *supra* note 163, at 329–32 (discussing changes).

²⁰⁵ See J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 17:21 (5th ed. 2022) (describing various approaches and referring to it as a “presumption”).

²⁰⁶ *Id.*; see also *Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc.*, 892 F.2d 1021, 1025–26 (Fed. Cir. 1989) (surveying circuits and deciding that when presumption applies, only the burden of production shifts to trademark registrant).

²⁰⁷ Sandra Edelman, *Why Wait Three Years? Cancellation of Lanham Act Section 44(e) and 66(a) Registrations Based on Non-Use Prior to the Three-Year Statutory Period for Presumption of Abandonment*, 104 TRADEMARK REP. 1366, 1370 (2014) (noting that cases not involving statutory presumption are relatively rare).

²⁰⁸ See, e.g., *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 149 (2d Cir. 2007) (requiring evidence within three-year period); *Specht v. Google Inc.*, 747 F.3d 929, 934 (7th Cir. 2014) (see previous parenthetical).

²⁰⁹ See, e.g., *Silverman v. CBS Inc.*, 870 F.2d 40, 47 (2d Cir. 1989) (finding no such intent); *Seidemann Yachts, Inc. v. Pace Yacht Corp.*, 898 F.2d 147, at *4 (4th Cir. 1990) (unpublished) (distinguishing *Silverman* because the holder did provide such evidence).

resume use of its mark” and instead requires objective evidence of tenable plans to resume use.²¹⁰

Third, the Lanham Act provides that “[u]se of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.”²¹¹ This provision was one of several added as part of the Trademark Law Revision Act of 1988 to close the loophole on token uses as a basis for the acquisition or retention of trademark rights.²¹² Although many courts had begun requiring that trademark holders make commercial use of the mark after the original adoption of the Lanham Act in 1946,²¹³ others were still recognizing token uses as sufficient to avoid abandonment as courts had done under the common law.²¹⁴

To see how the Lanham Act definition of abandonment dramatically altered the common law doctrine, consider *Silverman v. CBS Inc.*²¹⁵ *Silverman* is especially pertinent to this Article because it is one of the first prominent trademark cases involving marks that had been discontinued on account of their connections to racist iconography and stereotypes.²¹⁶ The trademarks at issue were used on the Amos ‘n’ Andy (“ANA”) radio and television series. They included the name of the show, the names of its characters, and several catchphrases.²¹⁷ ANA began as a radio serial in the 1920s, and it quickly became the most popular program of its time—bringing in over forty million listeners each week.²¹⁸ Although its two title characters were identified as Black men, they were voiced by two white comedians who also served as the show’s writers.²¹⁹ Perhaps not surprisingly, the characters

²¹⁰ *Silverman*, 870 F.2d at 46.

²¹¹ 15 U.S.C. § 1127.

²¹² See *supra* Section II.A.

²¹³ See Christopher T. Micheletti, *Preventing Loss of Trademark Rights: Quantitative and Qualitative Assessments of “Use” and Their Impact on Abandonment Determinations*, 94 TRADEMARK REP. 634, 660 (2004) (discussing post-Lanham Act cases that had disallowed token uses).

²¹⁴ Cf. S. REP. NO. 100-515, at 54 (1998) (explaining that changes to “use in commerce” definition were to clarify that “use” should be ordinary commercial use).

²¹⁵ 870 F.2d at 40.

²¹⁶ See Lois Fishman, *Time’s Up Trademarks: A Reflection*, COPYRIGHT & BRAND IQ (July 22, 2020), <https://www.copyrightandbrandiq.com/2020/07/times-up-trademarks-a-reflection/> [<https://perma.cc/6V4G-SDZA>].

²¹⁷ *Silverman*, 870 F.2d at 42–43.

²¹⁸ See, e.g., Mel Watkins, *What Was It About ‘Amos ‘n’ Andy’?*, N.Y. TIMES BOOK REV., July 7, 1991, at 1 (describing series’ rise and abrupt fall); MELVIN PATRICK ELY, *THE ADVENTURES OF AMOS ‘N’ ANDY: A SOCIAL HISTORY OF AN AMERICAN PHENOMENON* (2001) (providing historical and sociological account of series and its impact on race relations and perception of and by the African-American community).

²¹⁹ See Gwendolyn Dubois Shaw, *The Long, Unfortunate History of Racial Parody in*

“performed exaggerated ideas of blackness,” including “grammatical acrobatics, malapropisms, and the exaggerated mispronunciation of words, which supposedly demonstrated the intellectual and cultural inferiority of their characters.”²²⁰ Although the radio broadcast shielded their true identities from view, the success of the show created media publicity, for which the two comedians donned black-face.²²¹ In fact, the radio program was so successful that it spawned a CBS television sitcom—one of the first—cast with Black actors in place of its white radio predecessors.²²²

While ANA was not without its critics when it was only a radio program, the transition to television brought about more concerted efforts to cease its production, most notably by the NAACP.²²³ In the face of mounting pressure, CBS stopped broadcasting the television series in 1953 and the radio program in 1955, although episodes of the television series continued in syndication until 1966.²²⁴ Over the next two decades, CBS made no use of the trademarks except for sporadically “licensing the programs for limited use in connection with documentary and educational programs.”²²⁵ But when a playwright sought a license from CBS to stage a musical based on the ANA characters in 1981, CBS declined to do so.²²⁶ A lawsuit in which the playwright alleged that the trademarks had been abandoned ensued.²²⁷

America, SMITHSONIAN MAGAZINE (Oct. 31, 2016), <https://www.smithsonianmag.com/smithsonian-institution/long-unfortunate-history-racial-parody-america-180960947/> [<https://perma.cc/JMU8-DV5F>].

²²⁰ *Id.* (explaining that U.S. consumers were enthralled with show and its characters); see also *Amos ‘N’ Andy: Past As Prologue?*, JIM CROW MUSEUM OF RACIST MEMORABILIA (Oct. 2005), <https://www.ferris.edu/HTMLS/news/jimcrow/question/2005/october.htm> [<https://perma.cc/F8WT-6F89>] (discussing the three primary caricatures used on the show).

²²¹ See Shaw, *supra* note 219 (including images of the comedians); *Silverman*, 870 F.2d at 42.

²²² See Aisha Harris, *How Amos ‘N’ Andy Paved the Way for Black Stars on TV*, SLATE (Sept. 13, 2016, 1:24 PM), <https://slate.com/culture/2016/09/how-amos-n-andy-paved-the-way-for-black-stars-on-tv.html> [<https://perma.cc/T5P6-X9W7>] (contending that despite its racist roots and negative representations, ANA “paved the way for black actors today”); see also *Amos ‘N’ Andy: Past As Prologue?*, *supra* note 220 (drawing connections between ANA and shows decades later).

²²³ See *NAACP Bulletin*, ANA (July 1951), <http://www.amosandandy.org/2012/09/naacp-bulletin.html> [<https://perma.cc/E6RK-VTKJ>] (listing seven egregious problems with television program); Watkins, *supra* note 218, at 1 (noting that there had been campaigns for show’s removal beginning in 1931).

²²⁴ See *Silverman*, 870 F.2d at 42 (describing the key dates related to trademark abandonment).

²²⁵ *Id.* at 47.

²²⁶ See *id.* at 43.

²²⁷ *Id.* at 45.

The district court determined that CBS had not abandoned these trademarks, but the Second Circuit disagreed.²²⁸ It began its analysis by noting twenty-one years had elapsed since the last airing of the television show, well beyond the time that would trigger the statutory presumption of abandonment.²²⁹ It then dispensed with CBS's two primary arguments: (1) it "pursued a course of conduct that it reasonably believes to be in the best interests of the community"²³⁰ and (2) "it has always intended to resume using [the trademarks] at some point in the future, should the social climate become more hospitable."²³¹ The Second Circuit flatly rejected the former argument, stating that though "CBS should not be penalized for its worthy motive, [the court] cannot adjust the statutory test of abandonment to reward CBS for such [a] motive by according it protection where its own voluntary actions demonstrate that statutory protection has ceased."²³² As for the latter argument, the Second Circuit highlighted the distinction between the common law "intent to abandon" standard—under which CBS had a plausible argument—and the Lanham Act's "intent not to resume" standard, under which CBS could not prevail because it could not provide evidence it had planned to resume use within the reasonably foreseeable future.²³³ The Second Circuit also rejected the other evidence CBS had proffered to avoid a finding of abandonment, including its limited licensing of the programs for educational and documentary purposes, which the court framed as "essentially non-commercial uses of a mark."²³⁴

Silverman provides an apt example of how the abandonment doctrine may operate to cut off trademark rights of companies that discontinue using their marks out of social responsibility. The reasons do not matter—or, at least, not a reason such as the desire to stop using a trademark that is connected with anti-Black sentiment. In practice, however, the abandonment doctrine has not proven to be nearly as potent in the vast majority of cases as the language of the Lanham Act and *Silverman* might suggest.²³⁵ The next Part explains why that is so

²²⁸ *Id.* at 49.

²²⁹ *Id.* at 45–46.

²³⁰ *Id.* at 47.

²³¹ *Id.* at 45.

²³² *Id.* at 47.

²³³ *Id.* at 48.

²³⁴ *Id.* at 47–48; see also Micheletti, *supra* note 213, at 652–54 (discussing *Silverman* and its application of abandonment doctrine).

²³⁵ But see Camilla A. Hardy & Mark A. Lemley, *Abandoning Trade Secrets*, 73 STAN. L. REV. 1, 51 (2021) (“[C]ourts have a clear framework for assessing whether a trademark has been abandoned . . .”).

by unpacking the differences between express abandonment and implied abandonment, along with the legal consequences that follow an abandonment determination.

III. MAKING SENSE OF THE ABANDONMENT DOCTRINE

The phrases “express abandonment” and “implied abandonment” are not commonly used in the trademark literature, nor are they used by the USPTO and courts in resolving rights disputes.²³⁶ Nevertheless, they refer to two fundamentally different fact patterns that affect a decisionmaker’s analysis when determining whether a trademark has been abandoned.

This Part discusses how courts have applied the abandonment doctrine to cases of implied and express abandonment. It reveals that courts draw a sharp distinction between how they treat entities that do not communicate that they wish to stop using a mark and those that do, giving the former considerable latitude to retain their trademark rights even if there is substantial evidence that suggests otherwise. It then describes the legal consequences of abandonment, which results in the symbol falling into the public domain, enabling others—in theory at least—to adopt it as their own. Yet there may be avenues for those who are rebranding to circumvent this unforgiving result.

Express abandonment occurs when a trademark holder communicates that it will stop using a mark.²³⁷ Relatively few reported decisions involve express abandonment, which probably reflects both that it was a rare phenomenon in the past and that those who expressly abandon a mark often have little incentive to try to stop others from thereafter using the mark as their own. The most common fact pattern involves companies that shed their marks for tax or accounting purposes,²³⁸ which explains why they would make public state-

²³⁶ There is a reference to a party “signing a document of express abandonment” in a treatise, but it does not flesh out express abandonment and implied abandonment as different species. See 4 LOUIS ALTMAN & MALLA POLLACK, CALLMAN ON UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES § 20:64 (4th ed. 2014) (“A mark owner may intentionally forfeit its mark rights by abandonment either by signing a document of express abandonment (e.g., for tax purposes), or by intentionally discontinuing the use of the mark, with no plans to resume.”).

²³⁷ See, e.g., *Cal. Cedar Prods. Co. v. Pine Mountain Corp.*, 724 F.2d 827, 829 (9th Cir. 1984) (publishing notice of abandonment in *Wall Street Journal*); *Manhattan Indus., Inc. v. Sweater Bee By Banff, Ltd.*, 627 F.2d 628, 629 n.1 (2d Cir. 1980) (transmitting information to USPTO that it surrendered its mark).

²³⁸ See, e.g., *Cal. Cedar Prods. Co.*, 724 F.2d at 829 (deciding to abandon its line of business for accounting reasons); 4 LOUIS ALTMAN & MALLA POLLACK, CALLMAN ON UNFAIR COMPETITION, TRADEMARKS & MONOPOLIES § 20:64 (4th ed. 2014) (describing factual circumstances).

ments about their intent. For example, in connection with its business decision to leave the artificial fire log market for accounting purposes, “Kingsford-Clorox published a notice in the *Wall Street Journal* announcing the abandonment of the ‘Duraflame’ trademark, effective that date.”²³⁹ It simultaneously filed a formal notice of abandonment with the USPTO.²⁴⁰ These actions precipitated a lawsuit brought not by Kingsford-Clorox to stop would-be infringers from using the mark, but rather between two other companies that each claimed it had been the first to use the mark in commerce after Kingsford-Clorox’s abandonment.²⁴¹

Implied abandonment occurs when a trademark holder’s actions suggest that it intends to stop using the mark, even though it has not communicated as much.²⁴² Judging by the number of decisions in which courts have been called upon to decide issues of implied abandonment, it appears vastly more common than express abandonment. The circumstances in which it arises are also significantly more varied. They can involve profitable companies like Ferrari, which produces a limited number of sports cars that retain their value precisely because they can no longer be purchased on the primary market.²⁴³ At the other end of the spectrum, they can involve struggling companies that have had to stop production of a particular brand²⁴⁴ or even cease all operations.²⁴⁵ In between these two extremes, there are cases involving companies that must decide what to do with trademarks they acquire as part of corporate reorganizations—whether to keep the separate marks because existing consumers recognize them or to transition to a unified brand identity.²⁴⁶ Similarly, there are cases involving

²³⁹ *Cal. Cedar Prods. Co.*, 724 F.2d at 829; see *Announcements*, WALL ST. J., June 28, 1982, at 13 (abandonment notice).

²⁴⁰ *Cal. Cedar Prods. Co.*, 724 F.2d at 829.

²⁴¹ See *id.*

²⁴² See 4 LOUIS ALTMAN & MALLA POLLACK, CALLMANN ON UNFAIR COMPETITION, TRADEMARKS & MONOPOLIES § 20:64 (4th ed. 2014) (indicating that abandonment need not be done through an express communication).

²⁴³ See *Ferrari v. McBurnie*, No. 86-1812, 1989 WL 298658, at *7 (S.D. Cal. June 1, 1989); see also Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099, 2173 (2004) (discussing prestige value associated with scarcity).

²⁴⁴ See, e.g., *Crash Dummy Movie v. Mattel, Inc.*, 601 F.3d 1387, 1390 (Fed. Cir. 2010) (ceasing manufacture of dolls on account of financial difficulties).

²⁴⁵ See, e.g., *Defiance Button Mach. Co. v. C & C Metal Prod. Corp.*, 759 F.2d 1053, 1060 (2d Cir. 1985) (concluding that neither the sale of physical assets nor termination of a business automatically lead to abandonment).

²⁴⁶ See, e.g., *Emergency One, Inc. v. Am. FireEagle, Ltd.*, 228 F.3d 531, 533 (4th Cir. 2000) (company purchase); *Grocery Outlet Inc. v. Albertson’s Inc.*, 497 F.3d 949, 950 (9th Cir. 2007) (merger).

companies that historically maintained a number of regional brands but wish to move to a single national presence.²⁴⁷

A. *Implied Abandonment*

Someone challenging the validity of a trademark on account of abandonment must prove two requirements are met: (1) that the trademark holder has stopped using the mark, the “stoppage requirement,” and (2) that the trademark holder does not intend to resume use in the reasonably foreseeable future, the “intent requirement.”²⁴⁸ In cases in which implied abandonment is litigated, both requirements are frequently contested, and some courts give trademark holders additional avenues to avoid abandonment.

1. *Stoppage Requirement*

The prototypical implied abandonment case involves a challenger who has alleged that the trademark holder has not used the mark in commerce for three years, which gives rise to the statutory presumption of abandonment.²⁴⁹ Once this presumption is triggered, it can be successfully rebutted with evidence that the trademark holder has in fact made bona fide use of the mark in the ordinary course of trade within that three-year period.²⁵⁰ This ordinarily gives the trademark holder a window in which it can show it has used the mark, which is different from cases of express abandonment.

What actions may be considered bona fide commercial use? Although caselaw is nebulous and at times contradictory, a few themes emerge. First, a company may be able to retain trademark rights to phased-out brands by using the marks in niche markets, even if the marks are being used in a somewhat different manner.²⁵¹ For example, Macy’s, a national department store chain, was able to retain its rights to the trademarks of regional stores it had owned before it consolidated them under the Macy’s brand.²⁵² Rather than continue to brand

²⁴⁷ See, e.g., *Macy’s, Inc. v. Strategic Marks*, No. 11-CV-06198, 2016 WL 374147, at *1 (N.D. Cal. Feb. 1, 2016) (consolidating regional retail brands under single umbrella); *Exxon Corp. v. Humble Expl. Co.*, 695 F.2d 96, 98 (5th Cir. 1983) (consolidating three regional oil trade names into one because of customer confusion).

²⁴⁸ See, e.g., *Saratoga Vichy Spring Co. v. Lehman*, 625 F.2d 1037, 1043 (2d Cir. 1980) (parsing statutory requirements).

²⁴⁹ 15 U.S.C. § 1227; see also Edelman, *supra* note 207, at 1370 (noting that cases not involving statutory presumption are relatively rare).

²⁵⁰ See *supra* notes 204–10 and accompanying text.

²⁵¹ See, e.g., *Macy’s, Inc.*, 2016 WL 374147.

²⁵² See *id.* at *6.

the stores under their regional designations, it created a “Macy’s Heritage Shop” on its website and offered t-shirts and tote bags that bore the marks of those historical brands.²⁵³ This use was enough, the court found, to qualify as genuine commercial use.²⁵⁴

But other courts have recognized limits in how disparate the uses can be and still count. Uses on what courts deem to be “promotional materials,” e.g., t-shirts, sunglasses, souvenirs, likely will not qualify as a use in commerce for the goods or services under consideration,²⁵⁵ although even that rule does not always hold.²⁵⁶ The Second Circuit found that the use in commerce of a mark on a planned brand of packaged foods would not be considered a sufficient use in commerce for a trademark holder who had used the mark previously in connection with a restaurant, even though the types of foods offered and preparation styles would be similar.²⁵⁷

Second, although the 1988 revisions to the Lanham Act eliminated the token use loophole, courts struggle to consistently apply that limitation when it comes to sales. On the one hand, limited dollar amounts of sales, sporadic sales, or those transacted with selected customers routinely have not been considered as use in the ordinary course of trade.²⁵⁸ This is particularly true when there is evidence that the trademark holder viewed its own actions as part of a “trademark maintenance program,” such as the one Exxon created when it phased out its use of a regional mark.²⁵⁹ Similarly, a firetruck company that

²⁵³ See *id.* at *1–2.

²⁵⁴ *Id.* at *6; see also *Grocery Outlet, Inc. v. Albertsons, Inc.*, No. C 06–02173, 2008 WL 524962 (N.D. Cal. Dec. 17, 2008) (use of trademark on private label products deemed sufficient commercial use).

²⁵⁵ See, e.g., *Emergency One, Inc. v. Am. FireEagle, Ltd.*, 228 F.3d 531, 537 (4th Cir. 2000) (excluding “hats, [t]-shirts, tote bags, and souvenir nameplates”); *Imperial Tobacco Ltd. v. Philip Morris, Inc.*, 899 F.2d 1575, 1582 (Fed. Cir. 1990) (excluding “‘incidental’ products, such as whisky, pens, watches, sunglasses and food”); *Anvil Brand, Inc. v. Consol. Foods Corp.*, 464 F. Supp. 474, 480–81 (S.D.N.Y. 1978) (excluding promotional goods).

²⁵⁶ See, e.g., *Carter-Wallace, Inc. v. Procter & Gamble Co.*, 434 F.2d 794, 803–04 (9th Cir. 1970) (nominal sales sufficient); *Wells Fargo & Co. v. ABD Ins. & Fin. Servs.*, 758 F.3d 1069, 1072 (9th Cir. 2014) (finding “customer presentations and solicitations” sufficient).

²⁵⁷ *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 152 (2d Cir. 2007); see also *Emergency One, Inc.*, 228 F.3d at 535 (“use [of] the mark on clothing” and “on the uniforms of . . . security personnel” deemed token use in connection with firetrucks).

²⁵⁸ See, e.g., *Exxon Corp. v. Humble Expl. Co.*, 695 F.2d 96, 99 (5th Cir. 1983) (limited, lower dollar sales to selected customers); *La Societe Anonyme des Parfums LeGalion v. Jean Patou, Inc.*, 495 F.2d 1265, 1272 (2d Cir. 1974) (“meager trickle of business”); *Procter & Gamble, Co. v. Johnson & Johnson, Inc.*, 485 F. Supp. 1185, 1206–07 (S.D.N.Y. 1979) (selling branded products to few customers).

²⁵⁹ See, e.g., *Exxon Corp.*, 695 F.2d at 102 (formal maintenance program); *Procter & Gamble*, 485 F. Supp. at 1204 (legal counsel circulated memo on maintenance program).

had discontinued its sales of a brand but continued to repair the branded trucks and sold a recycled truck on which it affixed the mark was deemed not to have made sufficient commercial use.²⁶⁰

On the other hand, courts sometimes view evidence of small amounts of sales or repair and maintenance programs as sufficient. Recognizing Ferrari's continuing trademark rights in its Daytona Spyder, a limited edition sports car that had not been manufactured for fifteen years, the court countenanced the fact that Ferrari had continued to manufacture a dozen or fewer replacement parts each year upon request and had stated its commitment to continue to manufacture replacement parts for the vehicles "so long as these cars continue to be owned and driven."²⁶¹ One can imagine these same sports cars being driven by enthusiasts for many decades to come. Likewise, the Ninth Circuit has consistently stated that "[e]ven a single instance of use is sufficient against a claim of abandonment of a mark if such use is made in good faith."²⁶² This point is a critical one: because the definition of "use" requires "bona fide use of a mark in the ordinary course of trade," there is considerable leeway to view limited sales as either bona fide use or token use, depending on how the court construes the surrounding circumstances.²⁶³

2. *Intent Requirement*

Even if a trademark holder is unable to show that it has made any use of the mark within the statutory period, it may still fend off an abandonment finding by producing evidence that it has an intent to resume use of the mark within the reasonably foreseeable future. But how long that period of time extends "will vary depending on the industry and the particular circumstances of the case."²⁶⁴ For instance, "it might be reasonable for a fire truck manufacturer to spend five or six years considering the reintroduction of a brand, even though the same passage of time would be unreasonable for a maker of a more ephemeral product, say potato chips."²⁶⁵ While there are no hard-and-fast rules, it is clear that the holder must do more than "assert[] a vague, subjective intent to resume use of a mark at some unspecified

²⁶⁰ *Emergency One, Inc.*, 228 F.3d at 535.

²⁶¹ *Ferrari v. McBurnie*, No. 86-1812, 1989 WL 298658, at *7 (S.D. Cal. June 1, 1989).

²⁶² *Electro Source v. Brandess-Kalt-Aetna Grp.*, 458 F.3d 931, 938 (9th Cir. 2006).

²⁶³ *Denniston*, *supra* note 149, at 633 (quoting 15 U.S.C. § 1127).

²⁶⁴ *Emergency One, Inc.*, 228 F.3d at 537.

²⁶⁵ *Id.*; see also *Birch Publications, Inc. v. RMZ of St. Cloud, Inc.*, 683 N.W.2d 869, 872 (Minn. Ct. App. 2004) (finding abandonment of mark for telephone directories where holder had no "immediate plans to resume commercial use of the trademark").

future date,”²⁶⁶ as CBS had attempted to do with the ANA series in *Silverman*. Rather, a trademark holder must provide objective evidence of its intent within the three-year period, even if use does not resume for several more years.²⁶⁷

The categories of objective evidence that will be countenanced are many. They can even include actions that ordinarily do not qualify as bona fide commercial use, such as the trademark holder’s promotion of the brand on “[t]-shirts, tote bags, and souvenir nameplates”²⁶⁸ or litigation of their rights to the mark.²⁶⁹ Especially in relation to businesses or brands in distress, courts will give a trademark holder additional time before deeming a mark abandoned provided that the business is attempting to sell or license the mark.²⁷⁰ Indeed, when the failure to use a mark is couched in terms of financial difficulties, such framing often leads to a finding of no abandonment of the mark—even when there is little evidence of tangible steps taken to jumpstart production.²⁷¹ This is because courts view these types of stoppages as being “involuntary,” so they look for evidence that the rights holder will resume use of the mark once conditions improve.²⁷² Even the filing of trademark maintenance paperwork, such as a declaration of use or renewal, can be evidence of the trademark holder’s intent.²⁷³

Because in implied abandonment scenarios the trademark holder has not made a clear communication about its plans regarding the

266 *Vais Arms, Inc. v. Vais*, 383 F.3d 287, 294 (5th Cir. 2004) (finding vague, self-serving affidavit insufficient to rebut presumption); *see also* *Emmpresa Cubana Del Tabaco v. Culbro Corp.*, 213 F. Supp. 2d 247, 270 (S.D.N.Y. 2002) (deeming sporadic, half-hearted planning activities not enough to rebut presumption).

267 *See, e.g.,* *Crash Dummy Movie v. Mattel, Inc.*, 601 F.3d 1387, 1390 (Fed. Cir. 2010) (finding no abandonment despite nonuse for six years because evidence of planning activities during initial three years).

268 *Emergency One, Inc.*, 228 F.3d at 537.

269 *See* *Electro Source v. Brandess-Kalt-Aetna Grp.*, 458 F.3d 931, 938 (9th Cir. 2006) (explaining that ongoing litigation can explain nonuse or provide perspective on actions taken).

270 *See, e.g.,* *Defiance Button Mach. Co. v. C & C Metal Prod. Corp.*, 759 F.2d 1053, 1056, 1062 (2d Cir. 1985) (financial difficulties leading to auction sale); *Crash Dummy Movie*, 601 F.3d at 1390 (financial difficulties leading to acquisition).

271 4 LOUIS ALTMAN & MALLA POLLACK, *CALLMANN ON UNFAIR COMPETITION, TRADEMARKS & MONOPOLIES* § 20:64 (4th ed. 2014) (identifying circumstances in which courts have found no abandonment, many of which involved financial problems).

272 *See id.*; *see also, e.g.,* *Chandon Champagne Corp. v. San Marino Wine Corp.*, 335 F.2d 531, 535 (2d Cir. 1964) (finding that nonuse during war was involuntary and thus could not lead to abandonment, but failure to resume use after war viewed in different light).

273 *See, e.g.,* *Martha Washington Candies Co. v. Martha Washington Ice Cream Co.*, 113 N.Y.S.2d 119, 121 (N.Y. App. Div. 1952). By contrast, the failure to renew registration is often discounted. *See, e.g.,* *Skippy, Inc. v. CPC Int’l, Inc.*, No. CIV.A. 80-250-A, 1980 WL 30226, at *5 (E.D. Va. Nov. 24, 1980) (expired registration for thirty-five years not persuasive).

mark—and at the time the case is litigated the holder invariably claims that it had an intent to resume use and cobbles together any evidence it can in support—some courts have looked to residual goodwill as an influential factor.²⁷⁴

3. *The Role of Residual Goodwill*

Although the value of trademarks is inherently tied up in their “goodwill,” scholars do not agree on how to define the term.²⁷⁵ For purposes of this Article, goodwill will refer to “the recognition the [mark] has with customers and the extra earning power that it generates.”²⁷⁶ Accordingly, residual goodwill is “the perception of a substantial number of consumers that the mark still signifies goods and services from the original mark owner.”²⁷⁷

The phrase “residual goodwill” does not appear in the statutory abandonment definition or in the Lanham Act at all.²⁷⁸ Yet it is often on judges’ minds in deciding whether a mark has been abandoned.²⁷⁹ That is because an abandoned trademark ordinarily will fall into the public domain, as will be explored later in this Part.²⁸⁰ If an abandoned mark is adopted by a competitor while it still retains residual goodwill, consumers might understandably assume that the goods and services come from the former trademark holder. This type of confusion is precisely the type covered by a trademark infringement lawsuit, but such a lawsuit typically would be unavailable to a former trademark holder.²⁸¹

Faced with the consequences that flow from deeming a trademark abandoned—which come to fruition because another entity in fact has adopted the mark as its own—courts have wavered in their application of the doctrine when they perceive a mark as having residual goodwill. They have done so in two ways: one is direct; the other, indirect. Some courts will use the existence of residual goodwill itself as

²⁷⁴ Gilson & LaLonde, *supra* note 23, at 1294–99 (explaining approaches in several circuits).

²⁷⁵ Linford, *supra* note 19, at 815 n.24 (calling goodwill a “mutable” word); *see also* Gioconda, *supra* note 23, at 189–91 (discussing different definitions).

²⁷⁶ Gioconda, *supra* note 23, at 190.

²⁷⁷ Linford, *supra* note 19, at 815.

²⁷⁸ *See* 15 U.S.C. § 1127.

²⁷⁹ Denniston, *supra* note 149, at 639; *see also* 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 17:15 (5th ed. 2022) (collecting cases and summarizing principles).

²⁸⁰ *See infra* Section III.C.

²⁸¹ *See infra* Section III.C.

evidence of a trademark holder's intent to resume use.²⁸² This is particularly the case when the trademark holder's activities were discontinued for a relatively short period of time, because presumably any company wishing to maximize the economic value of a recognizable mark would reintroduce the brand itself or transfer the rights to another.²⁸³ Adopting a sports analogy to explain its reasoning, the D.C. Circuit opined that it would be improper for "the slightest cessation of use [to] cause[] a trade-mark to roll free, like a fumbled football, so it may be pounced upon by any alert opponent."²⁸⁴ Even cases that do not explicitly use the phrase "residual goodwill" will infuse the principle into their analysis. For instance, in determining whether a company intended to resume use of a mark, the Fourth Circuit took note of the fact that the mark holder "had paid a substantial sum of money for the . . . mark only a few years earlier," implying that a producer would do so only if the mark had significant goodwill that it planned to capitalize on in the future.²⁸⁵

The second way that courts use residual goodwill is indirect yet often even more powerful. Residual goodwill is employed as a prism through which all of the trademark holder's other actions are viewed. For instance, the Second Circuit spent the first seven paragraphs of an abandonment discussion explaining the concept of goodwill and how its "[e]rosion from non-use is a gradual process."²⁸⁶ Although the opinion later stated that abandonment requires that there be not only residual goodwill in the mark but also an intent to resume use,²⁸⁷ a fair reading of the opinion indicates that the significant residual goodwill

²⁸² See, e.g., *Am. Motors Corp. v. Action-Age, Inc.*, 178 U.S.P.Q. 377 (T.T.A.B. 1973) (citing evidence that "there is a considerable reservoir of goodwill in the mark" because the vehicles bearing the mark are "still on the road"); *Seidelmann Yachts, Inc. v. Pace Yacht Corp.*, Civ. No. JH-87-3490, 1989 WL 214497, at *9 (D. Md. Apr. 26, 1989) (value of goodwill as evidenced by amount paid for mark).

²⁸³ See, e.g., *Cont'l Distilling Corp. v. Old Charter Distillery Co.*, 188 F.2d 614, 619–20 (D.C. Cir. 1950) (pause during transfer of business interests); *Exxon Corp. v. Humble Expl. Co.*, 695 F.2d 96, 102 (5th Cir. 1983) (indicating that goodwill can be evidence of intent, but noting that lower court had not made such a determination). In fact, when a business transfers its trademark rights while in bankruptcy proceedings, it must also transfer the associated goodwill; otherwise, the transfer will be deemed an "assignment in gross" and could result in abandonment. See Lynda Zadra-Symes & Jacob Rosenbaum, "How Gross Is Your Assignment?" *Actions Speak Louder Than Words When Transferring Goodwill*, 111 TRADEMARK REP. 838, 840 (2021).

²⁸⁴ *Cont'l Distilling Corp.*, 188 F.2d at 619; see also Gilson & LaLonde, *supra* note 23, at 1298 (discussing TTAB's view).

²⁸⁵ *Emergency One, Inc. v. Am. FireEagle, Ltd.*, 228 F.3d 531, 537 (4th Cir. 2000).

²⁸⁶ *Defiance Button Mach. Co. v. C & C Metal Prods. Corp.*, 759 F.2d 1053, 1059–60 (2d Cir. 1985).

²⁸⁷ *Id.* at 1059.

in the mark influenced the court's evaluation of the facts before it.²⁸⁸ In the same vein, a federal district court found that Ferrari's practice of selling replacement parts and offering services for its Spyder long after production ceased had enabled it to "continue[] to maintain its goodwill," forestalling abandonment.²⁸⁹

The inverse is also true; that is, a tribunal's perception that there is a lack of residual goodwill in the mark will make it more likely to deem a trademark abandoned. In a series of opinions, the TTAB supported its decisions to cancel marks on account of abandonment based on the marks lacking residual goodwill—even when the issue had not been raised by the litigants.²⁹⁰ In a plethora of decisions that mentioned the presence or lack of residual goodwill, the way it was measured or deduced was not consistent. Judges tended to rely on their own intuitions based on the amount of time that had passed or their perception about the extent to which goodwill remained.²⁹¹ That said, two significant factors appear to be the length of continuous use of the mark in commerce prior to interruption and the extent to which it had been widely recognizable.²⁹²

A number of scholars have identified the role that residual goodwill currently plays in the application of the abandonment doctrine despite its absence from the statutory definition.²⁹³ And nearly all believe that residual goodwill should play some role in the determination of rights.²⁹⁴ At its core, the tension arises from the fact that the

²⁸⁸ *Id.* at 1061–62; see also Gilson & LaLonde, *supra* note 23, at 1296–98 (discussing *Defiance Button* and identifying this use of residual goodwill by some courts). *But see* Linford, *supra* note 19, at 826 (“[E]ven in the small handful of abandonment cases that consider residual consumer goodwill, the court focus[ed] on the behavior of the mark owner and its intent to abandon and resume use of the mark.”).

²⁸⁹ *Ferrari v. McBurnie*, No. 86-1812, 1989 WL 298658, at *12 (S.D. Cal. June 1, 1989); see also 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 17:15 (5th ed. 2022) (collecting cases involving residual goodwill and focusing on *Ferrari*).

²⁹⁰ See, e.g., *Gen. Motors Corp. v. Aristide & Co.*, 87 U.S.P.Q.2d 1179, 1183 (T.T.A.B. 2008) (citing lack of residual goodwill to deem automobile mark abandoned); *Bangor Punta Operations, Inc. v. Am. Sterling Enter., Inc.*, 184 U.S.P.Q. 243, at *5 (T.T.A.B. 1974) (similar); see also *Denniston*, *supra* note 149, at 640 (discussing principle).

²⁹¹ See, e.g., *Bangor Punta Operations, Inc.*, 184 U.S.P.Q., at *5 (assuming that goodwill had fully dissipated after four years, without any evidence to that effect).

²⁹² See *Denniston*, *supra* note 149, at 639, 644–45 (summarizing approaches).

²⁹³ See, e.g., *Dogan & Lemley*, *supra* note 38, at 1249–50; *Denniston*, *supra* note 149, at 639–40; *Bone*, *supra* note 38, at 47; *McKenna*, *supra* note 38, at 1893. *But see* Linford, *supra* note 19, at 826 (“Courts are often invited to consider evidence of residual goodwill, but typically reject the invitation.”); Stanley A. Bowker, *The Song Is Over But the Melody Lingers On: Persistence of Goodwill and the Intent Factor in Trademark Abandonment*, 56 *FORDHAM L. REV.* 1003, 1018–22 (1988) (claiming courts put little focus on goodwill, though they should).

²⁹⁴ See, e.g., *Bowker*, *supra* note 293, at 1022. *McKenna* describes the approach taken by

abandonment doctrine is still property-rights focused, in that it ties the trademark holder's rights to its own use and intent vis-à-vis the mark, while the consequences that flow from abandonment are rooted in consumer deception.²⁹⁵

To be sure, some decisions give residual goodwill relatively short shrift—yet even those decisions acknowledge that it could carry weight in the right circumstances.²⁹⁶ But there are limits. No decision, even one that explicitly includes residual goodwill in the abandonment calculus, has ever used the existence of residual goodwill *on its own* to avoid a finding of abandonment.²⁹⁷ Furthermore, residual goodwill is considered only when the trademark holder has been involved in its preservation; the actions of third parties to maintain goodwill, such as collectors who resell the goods bearing the trademark in secondary markets, will not be countenanced to avoid abandonment.²⁹⁸

All in all, the existence of residual goodwill has a dramatic impact on cases of implied abandonment, both directly as rebuttal evidence and indirectly as a lens through which all the trademark holder's other proffered evidence is viewed. Indeed, it likely explains why judges will at times give weight to seemingly token or promotional uses or excuse long periods of nonuse for brands that they perceive as retaining goodwill. And because abandonment often turns on a trademark holder's intent, there is considerably more latitude for judges to avoid an abandonment determination—and thereby its dramatic consequences—when a trademark holder has quietly discontinued its use of a mark.

modern courts but notes that it is inconsistent with traditional principles. McKenna, *supra* note 38, at 1893.

²⁹⁵ See Linford, *supra* note 19, at 815–16 (identifying dilemma); Bone, *supra* note 38, at 47 (calling it a “doctrinal puzzle”).

²⁹⁶ See, e.g., Exxon Corp. v. Humble Expl. Co., 695 F.2d 96, 101–02 (5th Cir. 1983) (discounting arguments related to goodwill alone as enough to avoid abandonment, yet acknowledging that goodwill can be used as evidence of intent). Notably, *Exxon* is often characterized as a decision that rejects consideration of goodwill. See, e.g., Bowker, *supra* note 293, at 1019–21 (discussing case).

²⁹⁷ Gilson & LaLonde, *supra* note 23, at 1294. *Defiance Button*, touted as the decision that goes the furthest, still required intent to resume use as a requirement separate from goodwill. See *Defiance Button Mach. Co. v. C & C Metal Prods. Corp.*, 759 F.2d 1053, 1059 (2d Cir. 1985).

²⁹⁸ See, e.g., Gen. Motors Corp. v. Aristide & Co., 87 U.S.P.Q.2d 1179, 1183 (T.T.A.B. 2008) (collectors); *Societe des Produits Marnier Lapostolle v. Distillerie Moccia S.R.L.*, 10 U.S.P.Q.2d 1241, 1244 n.5 (T.T.A.B. 1989) (other retailers).

B. *Express Abandonment*

Express abandonment ostensibly has the same stoppage and intent requirements as does implied abandonment, though they operate quite differently in practice. For a variety of reasons, it is much more likely that a court will find that an entity making such a communication has abandoned its rights to the mark.

1. *Stoppage Requirement*

For the stoppage requirement, even though the Lanham Act includes a *presumption* of abandonment after three years of nonuse,²⁹⁹ there is no three-year *waiting period* before an unused mark may be considered abandoned. In fact, nearly all cases of express abandonment involve third parties who have adopted a mark shortly after the initial holder communicated that it was discontinuing use of that mark.³⁰⁰ Therefore, it is difficult to say with certainty how courts would evaluate evidence of continued use by the initial holder in the wake of such a communication.

Presumably, courts would evaluate the trademark holder's activities on the margins in the same way as they would for cases of implied abandonment, given that the determination should turn solely on whether there has been bona fide use of the mark in the ordinary course of trade. But the reality in other areas of property law is that strong evidence of intent often influences a court's evaluation of other requirements. We see this in the law of gifts: when evidence of a donor's intent is strong, courts are more lenient in their evaluation of the delivery requirement than they are otherwise.³⁰¹ By analogy, a court's evaluation of a trademark holder's intent regarding use of a mark may well influence whether that court finds sufficient commercial use to avoid a finding of abandonment.

2. *Intent Requirement*

Of course, the intent requirement is much more streamlined in cases of express abandonment because the trademark holder has communicated that it will stop using the mark.³⁰² The only wrinkle is that

²⁹⁹ See 15 U.S.C. § 1127.

³⁰⁰ These cases often include third-party adoption of a mark within twenty-four hours of discontinuation. See, e.g., *Hiland Potato Chip Co. v. Culbro Snack Foods, Inc.*, 720 F.2d 981, 983 (8th Cir. 1983) (immediately after communication was distributed); *Cal. Cedar Prods. Co. v. Pine Mountain Corp.*, 724 F.2d 827, 829 (9th Cir. 1984) (same day as published announcement).

³⁰¹ See Adam J. Hirsch, *Formalizing Gratuitous and Contractual Transfers: A Situational Theory*, 91 WASH. U. L. REV. 797, 822 (2014) (discussing approach).

³⁰² See, e.g., *Cal. Cedar Prods. Co.*, 724 F.2d at 830 (abbreviated discussion of intent).

the communication must be definitive enough to show the trademark holder's present intent to stop using the mark. For example, the Eleventh Circuit found that a radio station's announcement of a name change did not necessarily indicate an intent to discontinue all use of its former name, particularly because it thereafter continued to employ the former name in marketing materials.³⁰³ Likewise, the Fourth Circuit found that a fire engine manufacturer's statement that it "wouldn't be building [the trademark] branded products forever out of Gainesville" was not a definitive statement of its intent.³⁰⁴ But this examination of the definitiveness of a statement of intent is not unique to trademark law. Rather, it is an oft-encountered, unremarkable feature of the doctrine of abandonment of personal property as well as in transfers of personal property by gift.³⁰⁵

If a court does not find the trademark holder's communication to be sufficient on its own to prove intent, that does not end the abandonment analysis. The case instead will be treated as one of implied abandonment, with the statement considered among the circumstances from which the trademark holder's intent will be inferred.³⁰⁶

3. *The Role of Residual Goodwill*

The biggest difference between express abandonment and implied abandonment relates to the consideration of residual goodwill.³⁰⁷ Whereas residual goodwill plays a significant role in implied abandonment, it has never been considered in cases of express abandonment, either directly or indirectly.³⁰⁸ This is likely because in cases of express abandonment, judges deduce that the trademark holder's actions indicate that the mark has no goodwill, or, at the very least, that the trademark holder no longer economically values whatever goodwill is associated with the mark.³⁰⁹

The differences between cases of express and implied abandonment have led to dramatically different outcomes. One of the most

³⁰³ *Cumulus Media, Inc. v. Clear Channel Commc'ns, Inc.*, 304 F.3d 1167, 1176 n.14, 1177–78 (11th Cir. 2002).

³⁰⁴ *Emergency One, Inc. v. Am. FireEagle, Ltd.*, 228 F.3d 531, 540 (4th Cir. 2000).

³⁰⁵ See Hirsch, *supra* note 301, at 823–33 (recounting traditional distinction between unenforceable future gifts and enforceable present gifts of future interests).

³⁰⁶ *Cumulus Media, Inc.*, 304 F.3d at 1178 n.18 (finding announcement of name change not clear regarding use of mark); *Emergency One, Inc.*, 228 F.3d at 540 (finding statements of continued operations ambiguous).

³⁰⁷ *Dogan & Lemley*, *supra* note 38, at 1249–50.

³⁰⁸ *Id.*

³⁰⁹ See *id.* at 1250 (indicating that courts will only consider goodwill when discontinuance was involuntary).

hotly contested cases of express abandonment involved the Dodgers professional baseball team.³¹⁰ In 1958, the Brooklyn Dodgers publicly announced its move to Los Angeles and “pointedly changed its name to Los Angeles Dodgers, Inc.”³¹¹ Although the team’s name had changed, its owners did not completely stop using the “Brooklyn Dodgers” mark.³¹² In fact, they engaged in four types of actions in connection with the “Brooklyn Dodgers” mark over the course of the next three decades: (1) they “made prominent commercial use and reference to their Brooklyn heritage and trademarks” in connection with special events and annual games, (2) they sent a cease-and-desist letter to the Continental Football League to preclude it from using “Brooklyn Dodgers” for a football franchise, (3) they included the mark among those licensed to conference centers and clubs over the course of many years, and (4) they entered into a formal licensing agreement with the Major League Baseball Promotion Company in 1981 that included the “Brooklyn Dodgers” mark.³¹³

In 1987, four Brooklyn-based restaurateurs set out to open a sports-themed restaurant and settled on the name “Brooklyn Dodger,” prompting the Dodgers baseball team to file suit.³¹⁴ In finding that the Dodgers baseball team abandoned the “Brooklyn Dodgers” mark, the federal district court judge deemed the team’s actions as nothing more than “warehousing” the mark: “occasional licensing and using the name for historical retrospective and matters of historical interest did not constitute trademark uses of the mark but were non-commercial activities.”³¹⁵ Although nearly all of the abandonment analysis focused on the team’s lack of sufficient use, the articulated reasoning often conflated use with intent, leaning heavily on the team’s intent as a lens through which to view use.³¹⁶ Nor were the team’s uses of “Dodgers” or “Los Angeles Dodgers” countenanced;

³¹⁰ See *Major League Baseball Props. v. Sed Non Olet Denarius, Ltd.*, 817 F. Supp. 1103, 1108 (S.D.N.Y. 1993).

³¹¹ *Id.* at 1110; see also Don Nottingham, *Keep the Home Team at Home: Antitrust and Trademark Law As Weapons in the Fight Against Professional Sports Franchise Relocation*, 75 U. COLO. L. REV. 1065, 1085 (2004) (providing background).

³¹² *Major League Baseball Props.*, 817 F. Supp. at 1114–17.

³¹³ *Id.*; Andrew D. Baharlias, . . . *Yes, I Think the Yankees Might Sue if We Named Our Popcorn ‘Yankees Toffee Crunch’: A Comprehensive Look at Trademark Infringement Defenses in the Context of the Professional and Collegiate Sports Industry*, 8 SETON HALL J. SPORT L. 99, 111–12 (1998) (discussing evidence).

³¹⁴ *Major League Baseball Props.*, 817 F. Supp. at 1111–12.

³¹⁵ *Id.* at 1129, 1130.

³¹⁶ See *id.* at 1128–29, 1129 n.20 (discussing intent in context of “use” inquiry and suggesting there was no goodwill for the team as a result of move).

the court viewed “[t]he ‘*Brooklyn Dodgers*’ [[as a non-transportable cultural institution separate from the ‘*Los Angeles Dodgers*’ or the ‘*Dodgers*’ who play in Los Angeles.”³¹⁷ In short, when the Dodgers took their baseballs from Brooklyn and moved to Los Angeles, it was exceedingly difficult for them to avoid abandoning the trademark.

Cases that have allowed defunct entertainment enterprises to avoid abandonment have involved recording artists.³¹⁸ But unlike a sports team that changes its name when it moves to a different city, a disbanded singing group may receive significant royalties from album sales and airplay well into the future.³¹⁹ Such sales would involve uses of the band’s name as a trademark that are hard to categorize as “token,” “sporadic,” or “non-commercial.”³²⁰ This is also true for companies that announce that they are ceasing production of a line but continue to sell existing inventory until it runs out.³²¹

C. *Legal Effect of Abandonment*

Once a trademark is deemed abandoned, irrespective of whether it happens in the context of express or implied abandonment, it falls back into the public domain.³²² At that point, the rights to the trademark will vest in the next entity that satisfies the requirements for trademark acquisition outlined in Section II.A. Particularly in cases of express abandonment, third parties may attempt to seize the trademark immediately. For example, Kingsford-Clorox’s announcement that it would drop the “Duraflame” trademark catalyzed two competitors to race to be the first to transport fire logs bearing the mark—indeed, one of the two incorrectly shipped the goods two days before the formal announcement.³²³ And as the Introduction noted, third parties filed trademark applications for “Aunt Jemima,” “Eskimo

³¹⁷ *Id.* at 1128; *see also* Baharlias, *supra* note 313, at 116 (indicating that many believe case was incorrectly decided).

³¹⁸ *See, e.g.*, *Homme v. Kyuss Lives, Inc.*, CV 12-02009 SJO (DTBx), 2012 WL 13012719, at *5 (C.D. Cal. Aug. 13, 2012); *Kingsmen v. K-Tel Int’l Ltd.*, 557 F. Supp. 178, 183 (S.D.N.Y. 1983).

³¹⁹ *See, e.g.*, *Kingsmen*, 557 F. Supp. at 183 (royalty stream precluded abandonment).

³²⁰ *Compare id.*, with *Major League Baseball Props.*, 817 F. Supp. at 1125, 1129–30.

³²¹ *See, e.g.*, *Grocery Outlet, Inc. v. Albertsons, Inc.*, No. C 06-02173 JSW, 2008 WL 5245962, at *2 (N.D. Cal. Dec. 17, 2008) (selling off inventory bearing mark in question); *Electro Source v. Brandess-Kalt-Aetna Grp.*, 458 F.3d 931, 935–37 (9th Cir. 2006) (same).

³²² 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 17:2 (5th ed. 2022) (collecting cases stating general principle); *see also* Lior Jacob Strahilevitz, *The Right to Abandon*, 158 U. PA. L. REV. 355, 391 (2010) (discussing trademark abandonment doctrine and consequences).

³²³ *Cal. Cedar Prods. Co. v. Pine Mountain Corp.*, 724 F.2d 827, 829–30 (9th Cir. 1984).

Pie,” “Uncle Ben’s,” and “Washington R*****s” within days of the announcements that their infamous identities would be dropped.³²⁴

Nearly every case concerning trademark abandonment states the legal consequences of abandoning a mark without qualification. This includes the case involving the “Duraflame” mark, which undoubtedly had goodwill at the time of its express abandonment.³²⁵ A handful of cases addressed concerns about another entity improperly exploiting residual goodwill.³²⁶ Most of the time, however, the opinions merely noted that the other entity had not engaged in objectionable conduct that would necessitate intervention.³²⁷

But in *Peter Luger, Inc. v. Silver Star Meats*,³²⁸ a judge in the Western District of Pennsylvania went further and granted a preliminary injunction against another entity that had adopted an abandoned mark that had been used for processed meat products, citing the existence of residual goodwill in support of the injunction.³²⁹ The other entity had done more than merely adopt the trademark, however; it had used the trademark along with the competitor’s still protectable trade dress and had added the word “Classics,” which, according to the court, implied that the goods were successors to the original.³³⁰ The court viewed the entirety of the other entity’s conduct as “intentionally creating public confusion as to the source and origin of the products they buy.”³³¹ But even if another court found *Peter Luger* persuasive, it arguably would apply the holding only where the other entity inaccurately drew an explicit connection between its products and those of the former trademark holder.³³²

Beyond this narrow limitation, there is just one other well-known case in which another entity was precluded from adopting an aban-

³²⁴ See *supra* notes 29–33 and accompanying text.

³²⁵ See *Dogan & Lemley*, *supra* note 38, at 1249 (noting that the trademark retained goodwill, which is precisely why it was adopted by others after abandonment).

³²⁶ See, e.g., *In re Wielinski*, 49 U.S.P.Q.2d 1754 (T.T.A.B. 1998) (addressing concerns about adoption of mark before “memory” of former holder had faded); *Intrawest Fin. Corp. v. W. Nat’l Bank of Denver*, 610 F. Supp. 950, 960 (D. Colo. 1985) (declining to decide whether residual goodwill would prevent abandonment, but finding that none of the parties claiming rights to the mark held it).

³²⁷ See, e.g., *In re Wielinski*, 49 U.S.P.Q.2d at 1754; cf. *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 119 (1938) (applying similar principle in context of generic marks).

³²⁸ No. CIV.A.01-1557, 2002 WL 1870066 (W.D. Pa. May 17, 2002).

³²⁹ *Id.* at *15.

³³⁰ *Id.* at *1–2.

³³¹ *Id.* at *2.

³³² *But see* 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 17:2 (5th ed. 2022) (suggesting that “reasonable precautions” may be required, yet no case actually has mandated affirmative measures).

doned mark. This case is worth exploring, though, because those who are attempting to circumvent the adverse consequences of trademark abandonment look at it closely.³³³ The case concerns the move by the Colts National Football League team in 1984 from Baltimore to Indianapolis and the subsequent attempt by the Canadian Football League (“CFL”) to name its Baltimore-based team the “Baltimore Colts.”³³⁴ The Indianapolis Colts sued the CFL team, seeking a preliminary injunction to stop the team from using “Baltimore Colts” as its name.³³⁵ Not surprisingly, the CFL team defended its use of the name on the grounds that the name had been abandoned.³³⁶ In affirming the district court’s grant of a preliminary injunction prohibiting the use, the Seventh Circuit acknowledged that the trademark had indeed been abandoned by Indianapolis by virtue of the move—much like the “Brooklyn Dodgers” trademark had been abandoned when the team moved from Brooklyn to Los Angeles.³³⁷ But that fact was not dispositive because the lawyers representing Indianapolis had creatively alleged that the use of “Baltimore Colts” for the CFL football team infringed on its *current trademark* for the “Indianapolis Colts.”³³⁸

The Seventh Circuit noted that this fact pattern was extraordinary, both because “the former owner of the abandoned mark continue[d] to market the same product or service under a similar name”³³⁹ and because of “the history of the Indianapolis team and the overlapping product and geographical markets served by it and by the new Baltimore team.”³⁴⁰ It then proceeded through a traditional infringement analysis, ultimately finding that the district court did not

333 See, e.g., Baharlias, *supra* note 313, at 115–16 (using case to demonstrate arguments sports teams could make); Guggenheim, *supra* note 65, at 318–19 (discussing applicability to abandoned marks).

334 Indianapolis Colts, Inc. v. Metro. Baltimore Football Club, Ltd., 34 F.3d 410, 411 (7th Cir. 1994); see also Phillip B. Wilson, *Thirty Years Later, Remembering How Colts’ Move Went Down*, USA TODAY (Mar. 29, 2014, 12:50 PM), <https://www.usatoday.com/story/sports/nfl/colts/2014/03/29/indianapolis-baltimore-move-30-year-anniversary-mayflower/7053553/> [<https://perma.cc/4NH3-ZHGD>] (discussing abrupt move); Sean H. Brogan, *Who Are These “Colts?”: The Likelihood of Confusion, Consumer Survey Evidence and Trademark Abandonment in Indianapolis Colts, Inc. v. Metropolitan Baltimore Football Club, Ltd.*, 7 MARO. SPORTS L.J. 39, 41–43 (1996) (setting out facts).

335 *Indianapolis Colts, Inc.*, 34 F.3d at 411.

336 See *id.* at 412.

337 See *id.*

338 See *id.* at 412–13 (distinguishing case from Dodgers’s claims).

339 *Id.* at 413.

340 *Id.*

err in determining that the use of “Baltimore Colts” would create a likelihood of consumer confusion with “Indianapolis Colts.”³⁴¹

At first glance, the *Indianapolis Colts* decision is in considerable tension with a number of trademark law principles. Under the doctrine of tacking, a trademark owner can retain priority to a modified mark only if the revised mark conveys the “same, continuing commercial impression” as the original mark.³⁴² This is an “exceedingly strict” standard to meet—precisely because it allows a trademark holder to claim preexisting rights to a new symbol.³⁴³ There is no way that the Colts would have been able to successfully argue that “Indianapolis Colts” conveyed the same commercial impression as “Baltimore Colts.” Nor did the Seventh Circuit seem to consider the possibility when it flatly found the earlier trademark to have been abandoned.³⁴⁴ Yet its use of the previous mark was considered by the Seventh Circuit in deciding whether there would be a likelihood of consumer confusion.³⁴⁵ Moreover, the opinion seems to suggest that there would be no way for another entity to use the “Baltimore Colts” trademark after it had been abandoned—at least, not an entity that wished to use it in connection with a football team.³⁴⁶ Perhaps for these reasons, *Indianapolis Colts* has been scrutinized and criticized.³⁴⁷

Indianapolis Colts may not be as far reaching as it appears, however. Three years later, the Seventh Circuit had an opportunity to revisit its reasoning in *Indianapolis Colts* in a case featuring an engineering consulting firm (“Rust”) that had dropped the name

³⁴¹ *Id.* at 414–16; *see also* Brogan, *supra* note 334, at 63–71 (criticizing court’s application of likelihood-of-confusion test).

³⁴² *Hana Fin., Inc. v. Hana Bank*, 574 U.S. 418, 420 (2015); *see also* 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 17:26 (5th ed. 2022) (explaining how doctrine has been applied).

³⁴³ *Brookfield Commc’ns, Inc. v. W. Coast Ent. Corp.*, 174 F.3d 1036, 1048 (9th Cir. 1999). *See generally* Alan L. Durham, *The Trouble with Tacking: A Reconsideration of Trademark Priority*, 54 HOUS. L. REV. 1027 (2017) (collecting cases and noting problems because test does not consider relationship to third parties’ marks).

³⁴⁴ *See Indianapolis Colts, Inc.*, 34 F.3d at 412.

³⁴⁵ *Id.* at 413–16.

³⁴⁶ *See id.* at 413 (distinguishing Dodgers’s case in that the defendants wished to use the mark for a football team, rather than as a restaurant); *see also* Baharlias, *supra* note 313, at 116 (noting distinction).

³⁴⁷ *See, e.g.*, Alfred C. Yen, *The Constructive Role of Confusion in Trademark*, 93 N.C. L. REV. 77, 112 n.188 (2014) (noting uncertainty caused by *Indianapolis Colts* opinion); Nottingham, *supra* note 311, at 1089 (“The plaintiffs seemingly tried, and succeeded, to have their cake and eat it too; while they did not claim that they still owned the trademark ‘Baltimore Colts,’ their history, including that under the abandoned trademark ‘Baltimore Colts,’ was taken into account when evaluating the likelihood of confusion.”).

“Donohue & Associates” in favor of “Rust Environment & Infrastructure.”³⁴⁸ Thereafter, five of Rust’s former employees formed their own engineering consulting firm and called it “Donohue & Associates.”³⁴⁹ Notably, the employees admitted that they had selected the name because it “would have some recollection in the marketplace.”³⁵⁰ Rust sued the second firm, alleging that the use of “Donohue & Associates” infringed on its common law trademark rights. In response to the second firm’s contention that the “Donohue & Associates” mark had been abandoned, Rust argued that the facts were akin to those in *Indianapolis Colts* and, accordingly, the second firm’s use of the mark created a likelihood of confusion with Rust’s new name.³⁵¹

Noting that the earlier decision was “one-of-a-kind,” the Seventh Circuit disagreed with Rust.³⁵² It noted that the Colts “were continuing to use a mark confusingly similar to the abandoned mark, whereas here Rust abandoned [‘Donohue & Associates’] without continuing to use any name even remotely resembling” it.³⁵³ Moreover, the fact that the name had been selected by the second firm because of its perceived residual goodwill did not sway the court.³⁵⁴ Thus, even if another court were to agree with the reasoning in *Indianapolis Colts*—which has not yet happened—it appears to apply only in instances in which the abandoned mark and the mark subsequently adopted by the initial trademark holder are confusingly similar with one another. It does not give companies a green light to replace their current marks with disparate ones and then block others from using the abandoned marks.

Notwithstanding the focus in the scholarly community on *Indianapolis Colts*, that case is only one of a handful that have entertained the notion that there could be any limitations on another entity using an abandoned trademark. The prevailing view of trademark abandonment is akin to traditional personal property law rights: once an entity relinquishes its rights to property, the property is available for acquisi-

348 Rust Env’t & Infrastructure, Inc. v. Teunissen, 131 F.3d 1210, 1212–13 (7th Cir. 1997).

349 *Id.* at 1213.

350 *Id.* at 1219.

351 *Id.* at 1214.

352 *Id.* at 1214–15.

353 *Id.* at 1214.

354 *Id.* (alteration in original); see also Yen, *supra* note 347, at 112 n.188 (discussing the seemingly contradictory outcomes in *Rust* and *Indianapolis Colts*).

tion so that it can be productive—even if the property still has value to its former owner.³⁵⁵

IV. REMOVING RACIST TRADEMARKS FROM THE MARKETPLACE

As Part III shows, the statutory changes to the abandonment doctrine theoretically made it easier for trademarks to be deemed abandoned. But the reality is that courts have avoided finding abandonment when a trademark holder has not expressly communicated its intent, especially when the court perceives that the trademark at issue retains significant residual goodwill.³⁵⁶ The same is not true in cases of express abandonment because of the assumption that the trademark holder had made a considered decision to stop using its mark despite the fact it would fall into the public domain, presumably because doing so was economically advantageous.³⁵⁷

But the recent shedding of racist trademarks has exposed the flaws in the courts' application of the abandonment doctrine and the shaky premises on which their analyses have been based. Commercial enterprises are “meet[ing] th[e] moment” brought about by this country's struggle to come to terms with pervasive racial injustice by parting with symbols that have not only been profitable for them but have also become synonymous with the brands they represent.³⁵⁸ Yet based on the current state of the law, they cannot completely sever their connections with their ignominious marks without risking that the marks will show up again—but this time, wielded by another entity. This circumstance has incentivized them to use the mark in a more limited fashion or cling on to vestiges in the hope that these strategic uses will be enough to retain their rights.

In light of this Gordian knot, this Part provides two recommendations, one broader and the other more limited, to facilitate and encourage the corporate shedding of racist trademarks. It begins by predicting how a court applying the current abandonment doctrine would evaluate the actions being taken by entities as they execute on their commitments to discontinue using their racist marks. It suggests that those who make the boldest moves will be the most likely to have their trademarks fall back into the public domain, free for a third

³⁵⁵ See 1 C.J.S. *Abandonment* § 15 (2023) (explaining that, under prevailing doctrine, a former owner of personal property does not have a superior right over others to it).

³⁵⁶ See *supra* Section III.A.

³⁵⁷ See *supra* Section III.B.

³⁵⁸ Zimmer, *supra* note 115; see Gerhardt, *supra* note 22, at 254 (noting that the traditional law and economics theory does not explain behavior).

party to adopt and use precisely because of their connections to racism and prejudice. It then sets out two proposals, one of which would involve changes to the Lanham Act to prevent acts of unfair competition involving abandoned marks and another that would involve the creation of a separate registry on which trademarks having historical significance could be “retired.”

A. *Consequences of the Current System*

When a company issues a press release stating that it will discontinue using a federally registered brand name or other trademark, the USPTO does not initiate a cancellation proceeding or undertake an examination of the mark *sua sponte*. And as long as the mark remains registered, the USPTO will reject applications filed by third parties for registration of the mark on the ground that it is likely to be confused with the company’s existing mark; it does not consider whether the mark may have been abandoned at that point.³⁵⁹ Accordingly, there are three primary ways in which a mark may be canceled on account of abandonment: (1) the trademark holder fails to submit a declaration of use or apply for renewal when either comes due,³⁶⁰ (2) a third party successfully files a cancellation petition with the TTAB, which entails a contested proceeding between the third party and the trademark holder,³⁶¹ or (3) a defendant in an infringement suit raises abandonment as an affirmative defense.³⁶²

Because a trademark holder’s renewal obligation arises on the ten-year anniversary date of its registration,³⁶³ there have not been many opportunities to see whether these companies will seek to renew registration of the marks they publicly avowed to discard in late 2020. However, two of Quaker Oats’s marks containing the image of the Black woman had been up for renewal in 2022, and both marks were cancelled due to the company’s failure to submit a renewal application or declaration of use.³⁶⁴

³⁵⁹ See U.S. PAT. & TRADEMARK OFF., TMEP § 1207.01 (July 2022) (noting that refusal can be based on any active registration, though application processing can be suspended if cancellation is pending).

³⁶⁰ See *supra* notes 171–74 and accompanying text.

³⁶¹ U.S. PAT. & TRADEMARK OFF., TBMP § 309.03(c) (June 2023) (listing abandonment among cancellation grounds).

³⁶² See 15 U.S.C. § 1119 (giving federal courts authority to determine whether marks should be canceled); see also, e.g., *Specht v. Google, Inc.*, 747 F.3d 929, 936 (7th Cir. 2014) (affirming district court’s cancellation of mark).

³⁶³ 15 U.S.C. § 1059.

³⁶⁴ See AUNT JEMIMA, Registration Nos. 1,697,862, 1,699,260.

As noted in the Introduction, there was a flurry of federal trademark applications filed by third parties on the heels of the public announcements. Not surprisingly, USPTO trademark examiners issued office actions objecting to the proposed registrations on likelihood-of-confusion grounds, because the marks were still live on the register at that time.³⁶⁵ But Retrobrands USA, the applicant for the “Eskimo Pie” mark, took the additional step of petitioning for cancellation of the mark.³⁶⁶ On July 1, 2022, the mark was in fact canceled, with the TTAB’s decision being simplified because the mark’s then-owner did not file a response to the petition and had a default judgment granted against it.³⁶⁷ This cancellation cleared the way for Retrobrands to register “Eskimo Pie.” Indeed, Retrobrands’s applications have cleared the first hurdle of examiner review and will likely succeed upon a showing by Retrobrands that the mark is being used in commerce.³⁶⁸ Thus, the issue of abandoned racist trademarks being revitalized is not merely a theoretical one—it is likely soon to be a reality.

Faced with these prospects, an entity might attempt one of several strategies based on how courts have approached other abandonment cases to try to preclude others from using the marks.³⁶⁹ First, it could continue to use the old trademark in connection with its new branding, albeit in a secondary manner. This is precisely what Quaker Oats has done with the Aunt Jemima name by keeping it on the lower right-hand corner of its boxes, bottles, and even commercials.³⁷⁰ Interestingly, when Quaker Oats first announced that it would change its name, it indicated it would put “Aunt Jemima” on the back of the box.³⁷¹ Although the decision to put the name on the front of the box could have been for other business reasons—like increasing brand

³⁶⁵ See, e.g., U.S. Trademark Application Serial No. 90,005,800 (filed June 17, 2020); U.S. Trademark Application Serial No. 9,008,879 (filed June 18, 2020); U.S. Trade Application Serial No. 90,012,648 (filed June 21, 2020).

³⁶⁶ *Retrobrands USA v. Societe des Produits Nestle S.A.*, Petition for Cancellation (T.T.A.B. Dec. 20, 2021).

³⁶⁷ *Retrobrands USA v. Societe des Produits Nestle S.A.*, Cancellation No. 92,078,762 (T.T.A.B. July 1, 2022).

³⁶⁸ See U.S. Trademark Application Serial No. 90,012,653 (filed June 21, 2020) (for “Eskimo Pie” in connection with ice cream); see also U.S. Trademark Application Serial No. 90,013,691 (filed June 22, 2020) (for “Eskimo Pie” in connection with graphic t-shirts).

³⁶⁹ See *supra* Sections III.B–D; see also David S. Ruder, *New Strategies for Owners of Discontinued Brands*, 3 *Nw. J. TECH. & INTELL. PROP.* 61, 72–74 (2004) (discussing several strategies to try to hold on to rights).

³⁷⁰ See Alcorn, *supra* note 16 (explaining that Aunt Jemima is still referenced in a “brief fine-print disclaimer”).

³⁷¹ Kowitt, *supra* note 18 (indicating that it was for trademark reasons).

recognition—it also gave the company an even stronger argument that it was still using the name as a trademark.³⁷²

Second, the entity might select a new identity similar to the old one, taking a page out of the Indianapolis Colts's playbook.³⁷³ This is perhaps what prompted Mars to select "Ben's Original" as the replacement for "Uncle Ben's." It is also what both Lady Antebellum and the Dixie Chicks did in shortening their names to "Lady A" and "The Chicks," respectively.³⁷⁴ Likewise, most of the companies retained their familiar color schemes and fonts to keep as much as they could of their branding.³⁷⁵ Even with these similarities, however, the changes were substantial enough that it would be nearly impossible to successfully argue that the new marks convey the same commercial impression as the old marks—the tacking threshold—needed to claim that the old marks were still in use in a slightly modified form.³⁷⁶ But perhaps the USPTO or a court that finds the *Indianapolis Colts* reasoning persuasive would determine that another's use of the old mark infringed on the trademark holder's new mark. This result would have the effect of restricting the extent to which the discarded mark could be used, but it bears repeating that this theory has not been widely adopted, nor is it clear the extent to which it would apply beyond instances in which the third party's goods and services were directly competing with those of the trademark holder. And as Lady A found out, selecting a new name can bring its own legal troubles.³⁷⁷ It turned out that "Lady A" had been used by Anita White, a blues singer, for decades, which led to a dispute over whether her common law trademark rights were infringed by the country band.³⁷⁸ That dispute was resolved in early 2022 by joint agreement, the terms of which were not disclosed.³⁷⁹

³⁷² See Mark P. McKenna, *Trademark Use and the Problem of Source*, 2009 U. ILL. L. REV. 773, 815 (2009) (noting that when determining whether there is sufficient trademark use, courts examine the "nature and prominence of the use at issue, particularly relative to other trademarks").

³⁷³ See *supra* notes 334–38 and accompanying text.

³⁷⁴ See Sisario, *supra* note 4.

³⁷⁵ See *supra* note 119 and accompanying text (noting retention of other aspects of branding).

³⁷⁶ See *supra* notes 342–43 and accompanying text.

³⁷⁷ Nardine Saad, *Country Trio Lady A's Messy Dispute with Single Lady A Finally Appears to be Settled*, L.A. TIMES (Feb. 3, 2022, 2:58 PM), <https://www.latimes.com/entertainment-arts/music/story/2022-02-02/lady-a-trademark-lawsuit-dropped-anita-white-lady-antebellum> [<https://perma.cc/B92B-PWD3>] (identifying reasons that prompted the name change and the legal disputes that followed).

³⁷⁸ *Id.*

³⁷⁹ *Id.*

Third, an entity might try to make limited use of the mark—enough to avoid the designation of token use, but not so much as to undercut completely its stated commitment to shedding the mark.³⁸⁰ As of June 2023, two of Cream of Wheat’s twenty-two flavors still bear the smiling Black chef on the box.³⁸¹ Although the use of the mark is not pervasive, it almost undoubtedly surpasses the threshold of bona fide use—reminiscent of Macy’s heritage line that avoided abandonment of its older regional brands.³⁸² Both Lady A and the Chicks will continue to make sales and have digital streams of their older albums in which they are referenced by their former names, which has been enough commercial activity in other cases to forestall abandonment.³⁸³ In 2012, after a protracted battle with the NCAA, the University of North Dakota got rid of its “Fighting Sioux” name and logo.³⁸⁴ But to ensure that the rights to the offending trademarks do not lapse, the University of North Dakota offers clothing and souvenir items bearing the trademarks to this day, as part of its Dacotah Legacy Collection.³⁸⁵ In fact, the NCAA explicitly required the University to offer the collection as part of its settlement agreement, presumably to ensure that no one else would be able to begin using the marks.³⁸⁶

380 See *supra* notes 251–54 and accompanying text.

381 See *Products*, CREAM OF WHEAT, <https://creamofwheat.com/products/> [<https://perma.cc/ZG45-SB4R>] (Maple Brown Sugar 2-1/2 Minute and Cinnabon flavors).

382 See *generally* *Macy’s, Inc. v. Strategic Marks*, No. 11-CV-06198-EMC, 2016 WL 374147 (N.D. Cal. Feb. 1, 2016).

383 See *supra* notes 318–20 and accompanying text.

384 Pat Borzi, *The Sioux Nickname is Gone, but North Dakota Hockey Fans Haven’t Moved On*, N.Y. TIMES (Mar. 1, 2016), <https://www.nytimes.com/2016/03/03/sports/hockey/with-sioux-nickname-gone-north-dakota-hockey-fans-are-fighting-change.html> [<https://perma.cc/SKD8-4695>] (explaining controversy and continuing angst among fans).

385 See, e.g., *DLC*, RALPH ENGELSTAD ARENA SIOUX SHOP, <https://www.siouxshop.com/special-collections/traditions/dlc/> [<https://perma.cc/Q5KT-RN2D>] (online store); *University of North Dakota Dacotah Legacy Collection*, UNIV. OF N.D. (Nov. 24, 2015, 10:32 AM), <https://fightinghawks.com/news/2015/11/24/210528397.aspx> [<https://perma.cc/X8YX-UCHQ>] (discussing collection).

386 Borzi, *supra* note 384. When the Cleveland Major League Baseball team announced that it would drop the name “Indians” and its mascot, “Chief Wahoo,” it noted that it would still sell merchandise bearing these symbols in a limited manner. David Waldstein, *Cleveland Indians Will Abandon Chief Wahoo Logo Next Year*, N.Y. TIMES (Jan. 29, 2018), <https://www.nytimes.com/2018/01/29/sports/baseball/cleveland-indians-chief-wahoo-logo.html> [<https://perma.cc/2G3H-YCRU>]; see *Chief Wahoo Merchandise Will Still Be Available After Cleveland Indians’ Name Change*, FOX 8 NEWS, (Dec. 18, 2020, 6:28 PM), <https://fox8.com/sports/chief-wahoo-merchandise-will-still-be-available-after-cleveland-indians-name-change/> [<https://perma.cc/8WJX-XGAQ>] (containing press release describing change).

In devising a strategy to avoid the abandonment of their racist marks or the consequences that may flow therefrom, an entity also might look to a relatively recent circuit court decision involving trademark use outside of the United States. In *Belmora v. Bayer Consumer Care AG*,³⁸⁷ the Fourth Circuit held that use of a trademark entirely outside of the United States can be sufficient to assert an unfair competition action under the Lanham Act against an entity that was using a confusingly similar mark in the United States.³⁸⁸ Although the Supreme Court has not addressed this issue,³⁸⁹ *Belmora* may dramatically alter the concept of territoriality, which historically limited use in commerce to that which was occurring with consumers in the United States.³⁹⁰ One could imagine a global conglomerate choosing to retain its racist branding in one of the other countries in which it does business, because it believes that such use will allow it to continue to assert control of the use of the mark in the United States. Although this strategy may be foreclosed in the future if the Supreme Court declines to adopt the Fourth Circuit's view, there is no downside to making this attempt—other than the fact that it means that the racist branding will still be part of the global marketplace. This has the potential to impact both U.S.-based consumers who see the products when visiting other countries but also the citizens of those countries, given the considerable influence that American culture has on those around the world.³⁹¹

It is not clear the extent to which the Washington football team will take measures to retain its trademarks. Initially, some of the names it had pursued included the word “Red,” such as “Red Wolves”

³⁸⁷ *Belmora v. Bayer Consumer Care AG*, 819 F.3d 697 (4th Cir. 2016), *cert. denied*, 137 S. Ct. 1202 (Feb. 27, 2017).

³⁸⁸ *Id.* at 710; *see also* Christine Haight Farley, *No Trademark, No Problem*, 23 B.U. J. SCI. & TECH. L. 304, 317 (2017) (discussing *Belmora* and its potential to undermine the territoriality principle that has been a fundamental precept of trademark law). *But see* Meenaxi Enter., Inc. v. Coca-Cola Co., 38 F.4th 1067, 1069, 1075 n.8 (Fed. Cir. 2022) (questioning whether *Belmora* was too expansive, but ultimately declining to decide the issue).

³⁸⁹ The U.S. Supreme Court recently decided *Abitron Austria GmbH v. Hetronic Int'l, Inc.*, in which it held that the Lanham Act does not reach infringing conduct occurring solely outside of the United States. 143 S. Ct. 2522, 2531 (2023). The opinion did not, however, discuss whether a trademark holder's use of a mark outside of the United States would permit them to sue an entity whose infringing conduct occurred within the United States, and it is unclear whether that question would be resolved the same way. *See id.*

³⁹⁰ Farley, *supra* note 388, at 317.

³⁹¹ *See generally* *What People Around the World Like—And Dislike—About American Society and Politics*, PEW RSCH. CTR. (Nov. 1, 2021) (summary at <https://www.pewresearch.org/global/2021/11/01/what-people-around-the-world-like-and-dislike-about-american-society-and-politics/> [<https://perma.cc/VX4V-NN46>]) (discussing America's reputation among those around the world).

and “Red Tails.”³⁹² These names not only would clearly allow the team to retain its color scheme, which it did when it adopted Commanders, but also it would have sounded similar to the team’s former name, which could have bolstered an infringement claim if another entity attempted to adopt its former name as a trademark.³⁹³ It will be substantially harder for the team, using the name “Commanders,” to claim infringement, because the name bears no sight or sound similarity to “R*****s.” Although one can still buy licensed merchandise bearing Washington’s former name and logo, it is available in only a few online stores and does not appear to have been manufactured recently.³⁹⁴ Nor is there an indication of whether it will release a historical collection, as the University of North Dakota did, to continue to make use of the mark on a limited scale.

In the end, it is not exactly clear what will happen to entities that publicly announce they will discontinue using their racist trademarks. Unless the announcement itself is equivocal, it would put the entity on unsure footing because it could be construed as a case of express abandonment. In that event, a court would inquire whether, notwithstanding the trademark holder’s statement, it has continued to make sufficient commercial use of the mark to avoid legal abandonment. Although these marks still have considerable consumer recognition associated with them, it is not clear whether a court would countenance arguments related to residual goodwill—especially in the wake of the trademark holder’s statement that it wishes to cut its ties with its racist past. This state of affairs could explain why companies have adopted the strategies identified above, despite the fact that they keep racist trademarks—or, at the very least, reminders of them—circulating in the marketplace.

To be sure, skeptics of the motives of these companies will note that these same strategies could be adopted for purely economic and opportunistic reasons. Companies can issue high-minded statements professing a desire to dispense with their racist trademarks, and do so

³⁹² John Keim, *Washington Commanders: Inside the NFL Franchise’s Search for a New Nickname and Logo*, ESPN (Feb. 2, 2022, 12:45 PM), https://www.espn.com/nfl/story/_/id/33198434/washington-commanders-nfl-franchise-search-new-nickname-logo [https://perma.cc/XM9B-4K22] (discussing name options).

³⁹³ See *supra* notes 175–78 and accompanying text (discussing infringement cause of action).

³⁹⁴ See, e.g., *Shop NFL Redskins Pro Shop, Redskins Gear, Washington Redskins*, ONE STOP FAN SHOP (Mar. 9, 2023), <https://onestopfanshop.com/categories/nfl/washington-redskins.html> [https://perma.cc/TXC6-UKTD]; *Washington Redskins Football Apparel, Gear, T-Shirts, Hats – NFL* (Mar. 3, 2023), SPORTINGUP, <https://sportingup.com/collections/nfl-washington-redskins> [https://perma.cc/G4VJ-Y72W].

in connection with their primary branding, yet still keep vestiges of them to spark recognition among consumers and minimize the monetary losses typically associated with a complete brand overhaul.³⁹⁵ Although this author recognizes the potential validity of that argument, or at least the distinct possibility that these companies might have mixed motives, that is all the more reason to craft solutions to facilitate the shedding of racist trademarks. For if there were ways to ensure that these marks would remain absent from the marketplace once abandoned, as might be the case if the two proposals below were implemented, companies would find it more difficult to take half-hearted measures and use trademark law as an excuse.

B. Proposal #1: Changes to the Lanham Act and Infringement Test

The first proposal paints with a broader brush, responding not only to the failure of trademark law to support companies that wish to drop their racist trademarks but also to the problems posed when any company discontinues using a mark that retains consumer recognition. As discussed in Part III, courts often avoid addressing the latter problems by maintaining the fiction that the trademark has not been abandoned.³⁹⁶ That workaround has three shortcomings. First, it is not consistent with the abandonment definition in the Lanham Act, which displaced the common law “intent to abandon” standard with “intent not to resume” use, indicating that Congress did not want entities to be able to warehouse unused marks indefinitely.³⁹⁷ That statutory reform was followed by an amendment eliminating the token-use loophole, further solidifying the congressional intent.³⁹⁸

Second, these types of analytical gymnastics traditionally have only been applied in cases of implied abandonment, where a court uses other evidence—along with the existence of residual goodwill—to find that the trademark holder intends to resume use.³⁹⁹ When a trademark holder’s intent to abandon is clearly communicated, it is nearly impossible for a court to find otherwise.⁴⁰⁰

Third, and most importantly for this Article, it is disingenuous—and potentially harmful—for a trademark holder to claim it has not

³⁹⁵ Alcorn, *supra* note 16; *see also* Joseph C. Miller, Michael A. Stanko & Mariam D. Di-allo, *Case Study: When Your Brand Is Racist*, 98 HARV. BUS. REV. 140 (Nov.–Dec. 2020) (discussing economic motivations).

³⁹⁶ *See supra* Part III.

³⁹⁷ *See supra* notes 196–97 and accompanying text.

³⁹⁸ *See supra* notes 211–14 and accompanying text.

³⁹⁹ *See supra* Section III.A.

⁴⁰⁰ *See supra* Section III.B.

abandoned its mark when all signs suggest otherwise. As it stands, if the Washington football team wants to preclude others from using its racist marks, it likely will renew its federal registrations of the relevant marks and sue others who attempt to use them—which means claiming that it in fact has not abandoned its marks. But that contradicts its public commitment to do so.

To avoid these problems, the author proposes two statutory changes to the Lanham Act that would disentangle abandonment from the legal consequences that currently flow from it. First, the “likelihood of confusion” statutory bar to registration would be amended so that it also would apply to trademarks that have been abandoned. Presently, the statutory bar specifically exempts abandoned marks from its purview.⁴⁰¹ The effect of this change would be that it would empower the USPTO to block federal registration of trademarks that would create a likelihood of confusion with abandoned marks. Second, the statutory provision setting out the general infringement cause of action would be amended to clarify that it includes a likelihood of confusion in connection with an entity’s previously used—but now abandoned—trademark or trade name. As it stands, the language used in the cause of action does not explicitly rule out abandoned marks as being protected, but it has been regularly applied in that manner.⁴⁰² And though a former trademark holder could try to assert another type of claim, such as one based on false association or false advertising, this amendment would give that holder a greater ability to curb infringing uses.⁴⁰³

Both of the statutory changes described above will require the USPTO and courts to determine whether a mark creates a likelihood of confusion with an abandoned mark. Fortunately, the multifactor likelihood-of-confusion test, which incorporates similar factors in most circuits, could be adapted quite easily to address the concerns posed by the use of abandoned marks that retain consumer recogni-

⁴⁰¹ 15 U.S.C. § 1052(d).

⁴⁰² 15 U.S.C. §§ 1114–1115; *cf.* Bone, *supra* note 38, at 49–51 (arguing that abandonment should be treated like genericity, which could allow for such protection). This proposal does not include changes to the dilution cause of action for the reasons identified earlier in the Article. *See supra* note 178 and accompanying text.

⁴⁰³ Companies may also have other intellectual property rights in the subject matter of some trademarks, such as copyright protection. This Article does not address these rights, but it is worth noting that many symbols that qualify for trademark protection will not qualify for copyright protection. *See* JAMES E. HAWES AND BERNARD C. DIETZ, COPYRIGHT REGISTRATION PRACTICE § 2:6 (May 2023) (comparing and contrasting subject matter that will be eligible for trademark and copyright protection).

tion.⁴⁰⁴ Among the commonly considered factors, the conceptual strength of the plaintiff's trademark, its commercial strength, similarity of the marks, proximity of the goods and services and channels of commerce, actual confusion, and adoption of the defendant's mark in bad faith all continue to have salience when the plaintiff's trademark has been abandoned.⁴⁰⁵ Evidence of actual confusion could still include consumer surveys—and indeed, such evidence might be weighty—because the crux of the plaintiff's argument would be that consumers encountering the marks today would mistakenly assume that they came from the former trademark holder or had been authorized by them.⁴⁰⁶

At the same time, the author envisions that the evaluation and weighing of the factors would be different for abandoned trademarks. For example, the two marks in question might need to be substantially similar if not identical to cause confusion, because the plaintiff's mark would be no longer in use. While the commercial strength of the mark is relevant, the weighing of that factor would have to take into account that the mark is no longer in use and that its strength will continue to decline as time passes. Trademarks having little commercial strength during their heyday will almost invariably have none at the time of abandonment; it follows that the subsequent adoption of the mark would not create a likelihood of confusion. On the other hand, a defendant's bad faith seems especially salient and should weigh in the plaintiff's favor, because it strikes at the heart of the concerns when abandoned marks are adopted by new entities.

Although this precise proposal has not been made before, it is consistent with others that have been proffered to fix the abandonment doctrine. Jake Linford has argued that a trademark should not be considered abandoned unless such a determination “is less likely to harm consumers and distort competition than [does] the preservation of trademark rights,” a type of balancing test.⁴⁰⁷ Believing that the outcome of such an inquiry turns on the existence of residual goodwill, Linford outlined a new multifactor test to guide courts and proposed an auction system that would measure residual goodwill

⁴⁰⁴ See generally Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CALIF. L. REV. 1581 (2006) (discussing the tests used in each circuit and the relative importance of factors).

⁴⁰⁵ See *id.* at 1622–42.

⁴⁰⁶ See *id.* (noting general belief that surveys provide the best evidence of confusion, yet finding that survey data often was not proffered or credited).

⁴⁰⁷ Linford, *supra* note 19, at 851.

directly.⁴⁰⁸ Several other scholars have proposed similar measures that restrict or eliminate the abandonment of marks that still retain residual goodwill, irrespective of the trademark holders' actions.⁴⁰⁹ Stacy L. Dogan and Mark A. Lemley have proposed amending the Lanham Act to prohibit others from adopting trademarks "in any case in which significant brand recognition remained in the old name, even after it is abandoned."⁴¹⁰ They acknowledge that this might preclude the registration of marks abandoned by well-known owners but believe that such a practice would better protect consumers.⁴¹¹

While these other proposals have significant merit, the one developed in this Article has a number of advantages. First, it enables the USPTO and courts to rule on abandonment without that determination in turn being dispositive of how others may use the mark. Because these concepts are currently intertwined, it is not surprising that judges sometimes have stretched the facts of cases before them to avoid abandonment to reach what they believe is the "right" result. Without such pressure, one might expect to see more consistent and coherent decisions on the issue of abandonment. Companies, in turn, would have a clearer sense of whether their conduct would result in trademark abandonment and the consequences therefrom. Having this knowledge, companies could conduct themselves accordingly.

Second, this proposal permits companies to drop recognized trademarks for business or social consciousness reasons—and to do so in a public manner if they so choose—without needing to employ the strategies outlined in the prior section to retain legal rights related to the mark. This is particularly important to support companies that wish to drop their racist trademarks. They need to be able to say they have abandoned a trademark, truly abandon it, and have it legally recognized as being abandoned by the USPTO and courts. This would not be fully realized in others' proposals that tie residual goodwill to abandonment,⁴¹² which would result in trademark holders continuing to own their racist trademarks and maintain their federal registrations.

Third, this proposal does not require the USPTO or courts to attempt to quantify residual goodwill, a phrase that is often used yet

⁴⁰⁸ See *id.* at 851–67.

⁴⁰⁹ See, e.g., Bone, *supra* note 38, at 50–51 (interpreting existing statute); Denniston, *supra* note 149, at 643–49 (recommending statutory change).

⁴¹⁰ Dogan & Lemley, *supra* note 38, at 1250.

⁴¹¹ *Id.*

⁴¹² See, e.g., Linford, *supra* note 19, at 851.

difficult to pin down.⁴¹³ The concept of “goodwill” is even more thorny when it comes to racist trademarks, especially if they are being abandoned at a time when there is strong consumer backlash against them.⁴¹⁴ Instead, this proposal leverages a tool with which the USPTO and federal courts are already quite familiar—the multifactor likelihood-of-confusion test—with modest tweaks to account for the fact that the mark has been abandoned. Courts already mold the likelihood-of-confusion test for other atypical factual scenarios, such as that posed by reverse confusion.⁴¹⁵

Fourth, the protection of abandoned marks provided by this proposal is not absolute—even for once well-known marks. Rather it extends only as far as a new entrant adopts another mark that creates a likelihood of consumer confusion with the now-abandoned mark. This certainly would not be the case for the overwhelming majority of abandoned marks, which fade from view because the goods or services they are associated with fail to take off. At the same time, it does not necessarily require that there be “significant” residual goodwill or brand recognition associated with the mark. Rather, it directs the inquiry back to the heart of the matter: diversions of trade and unfair competition.

Fifth, this proposal is consistent with the search-costs theory of trademarks, which is the predominant trademark theory.⁴¹⁶ If there is a likelihood of consumer confusion between an abandoned trademark and another entity’s use of the same or similar mark, consumer search costs theoretically will increase—which is what many believe trademark law should be designed to minimize.⁴¹⁷ Use of the mark by the other entity will also allow it to free ride off the residual goodwill in the mark, which decreases its incentives to produce high-quality goods.⁴¹⁸ The threat of free riding was a concern of Landes and Posner when they developed the search-costs theory, because if left un-

⁴¹³ See *supra* notes 275–77 and accompanying text; see also Linford, *supra* note 19, at 851–67 (identifying possible ways to measure it).

⁴¹⁴ See Gerhardt, *supra* note 22, at 258–61 (discussing cultural circumstances and events prompting announcements).

⁴¹⁵ 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:10 (5th ed. 2022) (discussing modifications to multifactor test in reverse confusion cases).

⁴¹⁶ Dogan & Lemley, *supra* note 38, at 1223.

⁴¹⁷ *Id.* at 1249–50.

⁴¹⁸ See *id.* (recommending changes to abandonment doctrine based on search-costs theory). Although Dogan and Lemley’s proposal has significant merit, this Article’s proposal goes further in providing additional enforcement mechanisms, though they are limited to instances in which there is a likelihood of confusion.

checked it can undercut the motivation to invest in trademarks at all.⁴¹⁹

Sixth, this proposal has benefits that extend beyond those to companies that wish to shed racist trademarks. Indeed, it is envisioned that it would be applied in a neutral manner with regard to the content of the mark, which will minimize the likelihood that it would be vulnerable to First Amendment attack. The problems with the trademark abandonment doctrine outlined in Part III have existed for decades, but until now judges have been able to twist their application of the doctrine in cases of implied abandonment to reach what they believe are equitable results. This proposal aims to make the abandonment doctrine more predictable and appropriately balance the competing interests of those who wish to adopt a mark not currently in use with the concerns that the use of such marks might create consumer confusion.

The primary argument against this proposal is that it could have the effect of opening the litigation floodgates and thereby thwart the legitimate adoption of truly abandoned marks. By allowing entities that once held trademarks that have been abandoned to sue, the argument goes, former holders could attempt to stop others from using their abandoned marks for years—which runs counter to Congress’s intent of eliminating warehousing and facilitating the return of abandoned marks to the public domain.⁴²⁰ But the reality is that litigation is already happening, with the issue being whether the initial trademark holder has abandoned its mark rather than one of enforcement following abandonment. As Section III.A explained, in cases of implied abandonment, courts often will avoid finding that a mark has been abandoned when they have concerns about residual goodwill—precisely because courts want to ensure that the initial holder retains the right to sue over infringing uses. But it is not clear that the existence of residual goodwill will be enough to avoid a finding of abandonment when a company makes a public pronouncement that they will stop using a trademark.

These concerns about opening the litigation floodgates also assume that numerous holders of abandoned marks would be financially motivated to attempt to stop others from legitimately using such marks. In the vast majority of circumstances in which there has been abandonment, however, the former holder presumably discontinued its use of the mark because it was economically advantageous to do so.

⁴¹⁹ See Landes & Posner, *supra* note 144, at 270.

⁴²⁰ See *supra* notes 196–97 and accompanying text.

It is unlikely that such a holder would sue to stop another from using the mark unless it believed that the use was harming its legitimate interests. But to the extent this is a concern, the changes to the Lanham Act could be accompanied by a limitation on the relief awarded to an injunction rather than damages.

A second concern would be whether these changes might adversely affect federal registration and the USPTO's examination of applications. With respect to the USPTO, it is true that trademark examiners would have to consider a larger set of marks as potentially precluding registration, because they would have to consider registered marks that are live as well as those that have been canceled on account of abandonment. One way to dramatically limit this impact with respect to the USPTO would be by excluding consideration of abandoned marks during the examiner's *ex parte* examination, as is already the case for unregistered trademarks or trade names.⁴²¹ This would mean that the USPTO would only have to consider an abandoned mark as a basis for refusal when it was brought it up during an opposition proceeding—which likely would only be the case when the former trademark holder objected to the applicant's adoption of the mark. With respect to applicants for federal registration and others wishing to adopt a new mark, they already have access to the USPTO's publicly accessible online database, which enables them to search for both live and canceled registered marks.⁴²² Once trademark attorneys learned of this change, they would alter their trademark clearance searches to include canceled marks. Provided that the USPTO gave guidance on how it would evaluate likelihood-of-confusion refusals based on canceled marks, attorneys would be able to appropriately advise their clients.

At the same time, this proposal is not a panacea for an entity that wishes to shed its racist trademark. One issue is that the entity likely would need to be actively involved in policing the use of its mark, which it might wish to avoid out of concern that the public might criticize the actions as rooted in economic self-protection. Another issue is that these changes to the statutory framework cannot ensure that a third party will have no ability to adopt the mark at some point in the

⁴²¹ See U.S. PAT. & TRADEMARK OFF., TMEP § 1207.03 (July 2022) (explaining that the refusal for likelihood of confusion extends to unregistered trademarks or trade names but that it “is not applied in *ex parte* examination because of the practical difficulties with which an examining attorney is faced”).

⁴²² *Trademark Electronic Search System*, U.S. PAT. & TRADEMARK OFF., https://tm-search.uspto.gov/bin/gate.exe?f=login&p_lang=english&p_d=trmk [<https://perma.cc/2734-D436>] (including such options).

future. Instead, it merely prevents federal registration of the mark *if* it creates a likelihood of confusion, and it gives the entity an analogous cause of action to stop infringing uses. To be sure, if enough time passes, a judge might find that a third party's use of a once well-known racist trademark—or any well-known trademark—does not give rise to a likelihood of confusion because consumers are unlikely to make such an inference about the source of the product anymore.⁴²³

Furthermore, it is possible that an entity's public pronouncement that it will shed its racist trademark might also result in less consumer confusion based on a third-party's use—although that will likely be a highly fact-specific inquiry. One could imagine a third party adopting the brand name “Aunt Jemima” or “Eskimo Pie” precisely to appeal to a segment of the population that wishes to promote white supremacy. That third party could use very different packaging and include disclaimers clarifying that they are not associated with the entities that formerly held those marks, further dispelling confusion and perhaps circumventing other existing causes of action such as false advertising and false association. Still, the third party would be leveraging these connections to racial injustice to promote sales—and the racist trademark would remain in the marketplace and the public eye.

C. Proposal #2: Creation of Historical Trademark Registry

The second proposal addresses the additional challenges posed by entities that wish to drop their racist trademarks. This proposal could be adopted either in conjunction with the first proposal or on its own; the author supports the adoption of both proposals simultaneously, though, to more completely address the problems identified in this Article. Under this proposal, Congress would create a new, permanent registry for trademarks that have “national historical significance” but have been retired by their owners and accepted by the USPTO for inclusion based on the criteria established for such a designation.

Along with the creation of this registry would be two statutory additions to limit future use of these marks by third parties. The first would be a new statutory bar to prohibit the future registration of these marks, in connection with any goods or services, on any other federal trademark registry. The second would be a provision prohibiting the use of marks included on the historical registry by any third party without the permission of the USPTO, with accompanying civil

⁴²³ Cf. *Gen. Motors Corp. v. Aristide & Co.*, 87 U.S.P.Q.2d 1179 (T.T.A.B. 2008) (finding no residual goodwill in a mark that had not been used for six decades).

penalties, for those who use the marks (1) as a designation of origin, (2) to induce the sale of goods or services, or (3) in a way that would likely cause confusion or mistake as to the affiliation, connection, or association of the goods or services with the mark's former holder or regarding the origin, sponsorship, or approval of the goods or services by the mark's former holder. This type of provision is patterned after one that currently exists for the unauthorized use of words and symbols associated with the Olympics, which is maintained and enforced by the United States Olympic and Paralympic Committee.⁴²⁴

One may wonder why we should create another federal trademark registry when it will basically be used as a retirement home for trademarks. The answer is that the issues presented by racist trademarks are different than those associated with Confederate monuments; there is no such thing as the destruction of a trademark like there may be for a monument,⁴²⁵ though the concept of a historical registry is analogous to moving a monument to a place that is less publicly visible and prominent. That is precisely why the abandonment doctrine historically has been so consequential, for once a trademark is abandoned it will fall back into the public domain. But a historical trademark registry would give the trademark a new home, turning over its maintenance and enforcement to the federal government.

The author envisions that to operationalize this proposal, the trademark holder would apply for the inclusion of the mark as they would for inclusion on the other federal trademark registries. The trademark holder could also be required to pay a fee, which would help defray some of the costs associated with processing applications and maintaining the registry.⁴²⁶ The registry has been labeled a "historical" registry because it could include any trademark of historical significance, analogous to the National Register for Historic Places.⁴²⁷ This would entail having a set of published criteria for inclusion. These

⁴²⁴ See 36 U.S.C. § 220506 (2018). Portions of this statute withstood constitutional attack. See generally *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522 (1987).

⁴²⁵ See generally Jess R. Phelps & Jessica Owley, *Etched in Stone: Historic Preservation Law and Confederate Monuments*, 71 FLA. L. REV. 627 (2019) (discussing monument removal in light of historic preservation laws).

⁴²⁶ Although the fees could help defray administrative costs, it might be worth considering whether the Government should provide economic incentives for companies wishing to retire marks to the historical registry. The issue of incentives is beyond the scope of this Article, but it is one that the author hopes to address in the future.

⁴²⁷ *National Register Bulletin*, U.S. DEP'T OF INTERIOR (1995), https://www.nps.gov/subjects/nationalregister/upload/NRB-15_web508.pdf [<https://perma.cc/VMK3-YM6G>] (setting out criteria).

criteria could include, for example, the commercial impact of the brand during its time or the role that the mark itself had played in the development of trademark law. Among these criteria would also be whether the trademark was retired because of its connections to prejudice on account of race, ethnicity, national origin, disability, sex, gender identity or expression, sexual orientation, religion, or socioeconomic status.

Even though this proposal has been prompted by the shedding of racist trademarks, the author foresees similar actions by companies with respect to trademarks reflecting prejudices of other types. The reasons for a trademark's inclusion on the registry should also be made public so that they are viewed by the public in the proper context and, in the case of racist trademarks or those reflecting prejudices of other types, lessen the concerns of the marks being glorified by virtue of their inclusion.

One can imagine trademarks on this historical registry being displayed online and in the Smithsonian Institution or at the USPTO headquarters in Alexandria, Virginia, together with explanatory information about their historical significance. Those included because of their connections to racism could be collected in an exhibit similar to the one artfully curated by the Jim Crow Museum of Racist Memorabilia housed at Ferris State University.⁴²⁸ The Jim Crow Museum “contextualizes the dreadful impact of Jim Crow laws and customs” by “us[ing] objects of intolerance to teach tolerance and promote a more just society.”⁴²⁹ In fact, the Jim Crow Museum currently displays the racist trademarks associated with Aunt Jemima and Cream of Wheat alongside artistic works that have been created to “deconstruct” the racist imagery.⁴³⁰

To date, the author is not aware of another proposal to create a historical federal trademark registry of the sort envisioned by this Article. In addressing the concerns brought about by the abandonment of racist trademarks, Shuba Ghosh has suggested that courts could permit companies themselves to make a “vestigial use” of a trademark by putting it in a virtual museum.⁴³¹ While such a judge-made doctrine has promise, the author believes that the creation of a separate regis-

⁴²⁸ See *Jim Crow Museum of Racist Memorabilia*, FERRIS ST. UNIV., <https://www.ferris.edu/HTMLS/news/jimcrow/index.htm> [<https://perma.cc/M2YX-GBLM>].

⁴²⁹ *Id.*

⁴³⁰ See *Battling Jim Crow Imagery*, FERRIS ST. UNIV., <https://www.ferris.edu/HTMLS/news/jimcrow/battle.htm> [<https://perma.cc/G6G2-9PMZ>].

⁴³¹ Shuba Ghosh, *Vestigial Use*, PATENTLYO (June 29, 2020), <https://patentlyo.com/patent/2020/06/vestigial-use.html> [<https://perma.cc/Z98D-KHBG>].

try maintained and enforced by the government would provide a more comprehensive and uniform solution.

The benefits to a historical trademark registry are threefold. First, it would provide a permanent registry for these marks so that they will not be registered by another entity in the future. As the recent cancellation of the “Eskimo Pie” mark shows, entities are ready to contest the ownership of these discarded marks and to register them for their own use or license them to others for profit.⁴³² While the statutory changes in the first proposal aim to thwart this practice, the creation of a historical registry and accompanying statutory bar to registration would ensure that they could not be registered. This statutory bar is akin to other registration bars for federal, state, or municipal insignia.⁴³³

Second, the maintenance of this registry could facilitate the proper contextualization of these discarded marks. While the companies shedding these marks purport to have a desire “to be honest about the brand history,”⁴³⁴ the way most consumers encounter these marks currently has no such context. Instead, they are simply reminded that the brand they are now seeing used to go by a different name or use a different logo—conjuring up the racist trademark without acknowledging its relation to anti-Black or anti-Indigenous sentiment. Undoubtedly, some would prefer that these images never see the light of day again and doubt the effectiveness of contextualization.⁴³⁵ But with destruction not being an option, contextualization through placement in an online or in-person museum and inclusion in educational materials that are distributed to the public appears to be the most promising path.

Third, the proposal envisions that enforcement rights would be transferred from the trademark holders to the federal government. Government enforcement might be especially preferred by companies wishing to shed their racist marks because it would eliminate the need to argue in court that they wish to assert their rights in these marks or that another’s use of these marks is causing them economic harm. In

⁴³² See *supra* notes 366–68 and accompanying text (describing TTAB cancelling “Eskimo Pie” after default judgment).

⁴³³ See 15 U.S.C. § 1052(b).

⁴³⁴ Kowitt, *supra* note 8 (quoting Quaker Oats’s representative).

⁴³⁵ See, e.g., Erin L. Thompson, *Why Just “Adding Context” to Controversial Monuments May Not Change Minds*, SMITHSONIAN MAGAZINE (Dec. 18, 2020), <https://www.smithsonianmag.com/history/why-just-adding-context-controversial-monument-may-not-change-minds-180976583/> [<https://perma.cc/ZWW6-R442>] (highlighting debate and casting doubt on effectiveness of contextualization).

addition to the financial costs associated with the litigation, it could have public relations repercussions: such actions could be seen as attempting to continue to profit from the mark.

On the other hand, there may be legitimate concerns about creating and maintaining a historical trademark registry, including questions about the constitutionality of such a registry. Although *Tam* and *Brunetti* did not resolve the issue of the precise standard that will be applied to trademark registration, it is clear that the federal registration of marks adopted by private entities cannot be denied based on the viewpoints expressed.⁴³⁶ Accordingly, one might assume that this reasoning extends to the inclusion of well-known racist trademarks on a historical registry on account of their connections to prejudice. While it is true that the government would be selecting marks for inclusion in the registry, this action arguably does not implicate the same First Amendment concerns as does traditional trademark registration.⁴³⁷

Because the government would be maintaining the registry and displaying the marks, exercising its right to give consent for others to use the marks, and enforcing its statutory rights associated with the marks, inclusion on the historical registry would likely fall into the realm of government speech.⁴³⁸ In fact, the same cases that the Supreme Court distinguished in *Tam*, *Summum* and *Walker*, are strongly analogous to the circumstances that would result from the creation of a government-maintained historical registry.⁴³⁹ *Summum* involved a city's display of monuments that had been donated by private individuals, and *Walker* involved a state's customized license plate program.⁴⁴⁰ As here, the government actions in those cases involved the selection and public display of some symbols but not others; accordingly, their actions need not be viewpoint neutral.⁴⁴¹ Similarly, it is likely that this historical registry would be immune from First Amendment attack, although that outcome is not certain given the changes in the composition of the Supreme Court.⁴⁴²

⁴³⁶ See *supra* Section I.B.

⁴³⁷ See *supra* notes 95–100 and accompanying text (summarizing Supreme Court decisions striking down the disparagement clause and immoral or scandalous bars).

⁴³⁸ See *supra* notes 95–100 and accompanying text.

⁴³⁹ See *supra* notes 96–100 and accompanying text.

⁴⁴⁰ See *supra* notes 96–100 and accompanying text.

⁴⁴¹ See *supra* note 98 and accompanying text.

⁴⁴² See Melissa Quinn, *Supreme Court's Conservatives Assert Control as Momentous Term Comes to an End*, CBS NEWS (June 30, 2022, 7:24 PM), <https://www.cbsnews.com/news/supreme-court-conservative-justices-abortion-guns-religious-rights/> [<https://perma.cc/QT44-ZSER>].

Those critical of a historical trademark registry may also be concerned about the consequences of permanently blocking included marks from federal registration and from analogous uses of the marks as an indication of source. Such concerns would be merited if marks were indiscriminately added to the registry. One could imagine a scenario in which a commonly used word, such as “apple,” was added to the registry. To avoid this problem, the USPTO would need to establish clear inclusion and exclusion criteria. For example, verbal marks that are common descriptive terms, such as apple, or that are merely descriptive, such as bright, should not be included on this historical registry; however, stylized representations of the words could be treated differently. There should also be an analogous exclusion for design marks, which would turn on their distinctiveness. Likewise, there should be an exception for third party uses of a mark that predated the mark’s inclusion on the historical register.

In thinking about the trademarks at issue in this Article, and certainly all of the design marks, all are sufficiently distinctive to not create a cause for concern for inclusion on a historical registry. One way to further limit the scope of this proposal would be to restrict its application to particular classes of goods or services—but doing so would open the possibility that third parties could adopt these racist marks in connection with other goods and services, thereby keeping the racist symbols in the marketplace.

A related concern is about the number of marks that would reside on the historical registry. While this Article does not purport to delineate all of the criteria to be used for inclusion, it is envisioned that there would be relatively few marks that would qualify for “national historical significance”—similar to that for sites bearing national historical significance or the inclusion of artifacts at a national museum.⁴⁴³ For example, while the National Park Service lists over 90,000 properties in its National Register of Historic Places, it only designates about 2,600 as National Historic Landmarks that “tell stories that are important to the history of the entire nation—not just local communities or states.”⁴⁴⁴ Creating and maintaining a high threshold for inclusion based on their significance to our nation’s economy or social discourse should quell worries about the existence

⁴⁴³ See, e.g., *The National Register of Historic Places and the National Historic Landmarks Program*, NAT’L PARK SERV. (Aug. 16, 2022), <https://www.nps.gov/subjects/nationalhistoriclandmarks/nr-and-nhl.htm> [<https://perma.cc/C8EW-KN5T>] (describing National Register of Historic Places and National Historic Landmarks).

⁴⁴⁴ *Id.*

of the registry contributing meaningfully to trademark depletion.⁴⁴⁵ And it bears repeating that the historical registry would not be registering *more* marks but rather *transferring* them from one registry to another.

Others might believe that this proposal does not go far enough in limiting the display of these racist trademarks or preventing their use. Including these trademarks on a list of “historical” trademarks does risk calling attention to them or, even worse, glorifying them. But that is where the context will be critically important. The Jim Crow Museum of Racist Memorabilia provides an outstanding example of how these images can be contextualized, and there could be different categories of marks within the historical registry—including a category for marks associated with prejudice, in which those connections are explicitly called out and recognized.⁴⁴⁶ Given the differences between intellectual property and tangible property, it is impossible to seal these marks in a hermetic container, even if it were preferable to do so. The statutory reforms included in this proposal go as far as they can, constitutionally, to restrict the future use of these marks. Under this proposal they could not be federally registered by another entity, which is the gold standard for those seeking trademark protection.⁴⁴⁷ Nor could entities thereafter use the marks as an identification of source, like a trademark, to induce the sale of goods and services, or in other ways that would likely confuse or deceive consumers, without the USPTO’s consent.

On the flip side, others may be concerned that this proposal goes too far, either constitutionally or normatively, in restricting speech. With regard to the Constitution, the statutory language at issue was patterned after a similar statute involving the unauthorized use of the Olympic symbols, which the Supreme Court upheld against a First Amendment challenge.⁴⁴⁸ Although that decision may be in question given the Court’s more recent trademark law jurisprudence, the fact that this proposal involves government speech and enforcement arguably would put it on even surer footing. Nor does the statutory reform outlined in this proposal prohibit all display of marks included

⁴⁴⁵ See generally Barton Beebe & Jeanne C. Fromer, *Are We Running Out of Trademarks?: An Empirical Study of Trademark Depletion and Congestion*, 131 HARV. L. REV. 945 (2018) (documenting the problems of trademark depletion and congestion, and suggesting reforms, including greater cancellation of unused marks).

⁴⁴⁶ See *supra* notes 428–30 and accompanying text.

⁴⁴⁷ See *supra* Section II.A (discussing benefits of federal registration).

⁴⁴⁸ See *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 522–24 (1987) (setting out holdings).

on the registry, like noncommercial displays, because such a prohibition would run afoul of the First Amendment under current jurisprudence.⁴⁴⁹

With regard to the normative question, the burdens placed on the speech of those who may wish to use these marks must be balanced against the real psychological harms to those who encounter these marks in the marketplace. As Section I.D described, the effects extend beyond those within the targeted communities to others who view these racist marks—continuing to entrench anti-Black and anti-Indigenous sentiment as part of American consumerism.

CONCLUSION

While the impact of racist trademarks will never truly be forgotten, they will never be gone, either. The trademark abandonment doctrine has been fashioned so that unused marks return to the public domain for others to use—and potentially misuse—because they are viewed as tools of source identification that should go to those who make commercial use of them. But the abandonment doctrine has become a morass because courts have tried to avoid its consequences in cases in which a mark retains goodwill. They have applied the doctrine differently in cases of express abandonment and implied abandonment, at times using specious evidence in the latter to allow the trademark holder to retain its rights.

But the shedding of racist trademarks breaks the mold of the “traditional” abandonment fact pattern and highlights the doctrine’s inequities. Companies are making public statements about dropping their once revered marks not because they are unprofitable but as a means of recognizing and taking responsibility for the harm that these marks have inflicted upon Black, Indigenous, and other marginalized racial and ethnic groups. They say they want to stop using these marks, but the uncertainty of the abandonment doctrine perversely incentivizes them to take half measures rather than make a clean break.

This Article describes the workings of the abandonment doctrine to expose its critical flaws, offering two proposals: one to allow the USPTO and courts to faithfully apply the abandonment doctrine while protecting the legitimate interests of those whose marks have

⁴⁴⁹ See, e.g., *United States v. Alvarez*, 567 U.S. 709 (2012) (striking down Stolen Valor Act as violating First Amendment). There are undoubtedly some difficult cases between pure commercial and noncommercial speech (e.g., parody, comment, criticism), but it is envisioned that those close cases would be addressed in as-applied challenges to the provision.

been abandoned, and another to further promote the interests of those that truly want to move beyond their ignominious past. Although these proposals may be welcome additions for companies that sincerely wish to shed their marks, they may not be as beneficial for others who want to pay lip service to the effort while maintaining connections to their racist marks so as to not adversely affect their bottom lines. But changes to trademark laws and systems can only do so much—the will and conscience of those holding these marks will determine their fate.

The summer of 2020 might have been the first time that the country experienced a significant number of companies shedding their racist trademarks, but this author believes it will not be the last. The federal register is replete with such marks, some of which are coded by the USPTO as depicting particular racial or ethnic groups or containing features associated with harmful stereotypes.⁴⁵⁰ The author anticipates that future social justice movements will call attention to trademarks that are associated with other types of prejudice as well, including those based on sex, sexual orientation, gender identity or expression, disability, religion, socioeconomic status, and others at the intersection of multiple categories. The implementation of these proposals could change a business's calculus and prompt it to shed marks as soon as it comes to recognize and internalize the harms it has caused—rather than waiting until it can no longer withstand social pressure and negative media attention.

⁴⁵⁰ See *supra* notes 72–77.