

# **Trademark Law and Policy**

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# Trademark Law and Policy

*Second Edition*

**Kenneth L. Port**

PROFESSOR OF LAW AND  
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*For Emily, Ellie, and Paula.*  
K.L.P.



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# Editorial Note

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For the sake of simplicity, many footnotes in cases as well as excerpted law review articles have been deleted without any indication. Those footnotes that remain have been renumbered.



# Prelude

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## Pebble Beach Co. v. Tour 18 Limited

155 F. 3d 526 (5th Cir. 1998)

King, C.J.:

Defendant Tour 18 I, Ltd. appeals the district court's judgment that it infringed and diluted the plaintiffs' service marks and one of the three golf-hole designs at issue, and it challenges the district court's injunction as vague, punitive, and overly broad. Plaintiffs Pebble Beach Co.; Resorts of Pinehurst, Inc.; and Sea Pines Co., Inc. cross-appeal, arguing that (1) the district court erroneously held that two of the three golf-hole designs at issue were not infringed or diluted, (2) its injunction is inadequate to bar future infringement, and (3) its denial of an accounting of profits and an award of attorneys' fees was erroneous. We affirm the district court's judgment as modified below.

### I. BACKGROUND

Defendant-appellant-cross-appellee Tour 18 I, Ltd. (Tour 18) owns and operates a public golf course in Humble, Texas named "Tour 18." Tour 18 began life as a limited partnership that subsequently merged into Tour 18, Inc., which also owns and operates a "Tour 18" public golf course in Flower Mound, Texas. Tour 18 has created these two golf courses exclusively of golf holes copied from famous golf courses across the country. The Tour 18 course in Humble, Texas has three golf holes that are copies of golf holes from golf courses owned and operated by plaintiffs-appellees-cross-appellants Pebble Beach Co. (Pebble Beach); Resorts of Pinehurst, Inc. (Pinehurst); and Sea Pines Co., Inc. (Sea Pines) (collectively, the Plaintiffs).

### C. District Court Proceedings

The Plaintiffs filed suit against Tour 18 asserting federal claims under the Lanham Act, 15 U.S.C. §§ 1051-1127, for service-mark and trade-dress infringement, unfair competition, and false advertising. See *Pebble Beach*, 942 F. Supp. at 1526. Under Texas law, the Plaintiffs asserted claims for common-law unfair competition, conversion, and civil conspiracy and for service-mark and trade-dress dilution under the Texas anti-dilution statute, see TEX. BUS. & COM. CODE ANN. § 16.29 (Vernon Supp. 1998). Pebble Beach also asserted a claim for copyright infringement based upon maps used by Tour 18. Tour 18 counterclaimed under Texas common law for unfair competition, interference with existing and prospective business relations, and civil conspiracy. See *id.*

After a bench trial, the district court issued an excellent opinion and entered judgment for the Plaintiffs on their infringement, dilution, and unfair competition claims in relation to Tour 18's use of their names and the image of the lighthouse, and the court

entered judgment for Sea Pines in relation to Tour 18's copying of its golf-hole design. The district court entered judgment for Tour 18 on the remainder of the Plaintiffs' claims and entered judgment for the Plaintiffs on all of Tour 18's counterclaims. The district court denied the Plaintiffs' requests for damages, an accounting of profits, and attorneys' fees, but it entered an injunction against Tour 18 requiring it to (1) cease using Pebble Beach and Pinehurst's marks, except to inform the public of the golf holes it copied; (2) cease using Sea Pines' marks and images of the lighthouse, without any exceptions; (3) remove the replicas of Sea Pines' lighthouse from both of its courses; (4) include a conspicuous disclaimer in all advertisements, promotional material, and informational guides; (5) maintain the disclaimers on the course; and (6) make no claims of use of original blueprints, maps, or other data in the construction of the course without a disclaimer. The district court has partially stayed the injunction pending appeal in relation to the requirement of removing the replica lighthouses. Tour 18 and the Plaintiffs now appeal.

## II. DISCUSSION

Tour 18 appeals the district court's judgment that it infringed and diluted the Plaintiffs' service marks and Sea Pines' trade dress and that it competed unfairly. Tour 18 also appeals the district court's injunction, claiming that it is overly broad, punitive, and vague. The Plaintiffs cross-appeal the district court's judgment that Tour 18 did not infringe or dilute Pebble Beach and Pinehurst's trade dress, its injunction as providing inadequate relief, and its denial of an accounting of profits and an award of attorneys' fees. We consider each issue in turn.

### A. Infringement

For the Plaintiffs to prevail on their service-mark and trade-dress infringement claims, they must show (1) that the mark or trade dress, as the case may be, qualifies for protection and (2) that Tour 18's use of the mark or trade dress creates a likelihood of confusion in the minds of potential consumers. A trademark or service mark is "any word, name, symbol, or device or combination thereof" used by a person to "identify and distinguish his or her goods [or services], including a unique product [or service]," from the goods or services of another and "to indicate the source of the goods [or services], even if that source is unknown." 15 U.S.C. § 1127. "Trade dress" refers to the total image and overall appearance of a product" and "may include features such as the size, shape, color, color combinations, textures, graphics, and even sales techniques that characterize a particular product." *Sunbeam Prods., Inc. v. West Bend Co.*, 123 F.3d 246, 251 & n.3 (5th Cir.), cert. denied, 140 L. Ed. 2d 936, 118 S. Ct. 1795 (1997). With trade dress, the question is whether the "combination of features creates a distinctive visual impression, identifying the source of the product." *Id.* at 251 n.3.

The same tests apply to both trademarks and trade dress to determine whether they are protectible and whether they have been infringed, regardless of whether they are registered or unregistered. Both are protectible if they are inherently distinctive or have achieved secondary meaning in the public's mind—i.e., if the trade dress or mark "has come through use to be uniquely associated with a specific source." *Sunbeam Prods.*, 123 F.3d at 253 (quoting *Two Pesos*, 505 U.S. at 766 n.4). However, trade dress is not protectible and cannot be distinctive if it is functional—i.e., if the design "is one of a limited number of equally efficient options available to competitors and free competition would be unduly hindered by according the design trademark protection." *Two Pesos*, 505 U.S. at 775. Once a plaintiff's mark or trade dress is found to be protectible, liability for trademark and trade-dress infringement hinges upon whether a likelihood of confusion exists in the minds of potential consumers as to the source, affiliation, or sponsorship



of the defendant's product or service due to the use of the allegedly infringing marks or trade dress.

\* \* \*

## 2. Protectible marks and trade dress

The district court considered the Plaintiffs' marks, "Pebble Beach," "Pinehurst," and "Harbour Town," and the image of the lighthouse and found them to be protectible. In the case of the design of the three golf holes, the district court determined that the configuration of a golf hole is nonfunctional, but it found that only Sea Pines' golf-hole design was protectible. Tour 18 challenges only the district court's findings that the Sea Pines' golf-hole design is protectible and that Sea Pines has protectible rights in the lighthouse. Tour 18 does not challenge the district court's finding that the Plaintiffs' other marks are protectible. The Plaintiffs challenge the district court's finding that Pebble Beach and Pinehurst's golf-hole designs are not protectible. We consider the golf-hole designs and the lighthouse in turn.

### a. golf-hole designs

Turning first to the district court's traditional trade-dress analysis of Tour 18's challenge to the protectibility of the designs of the Plaintiffs' golf holes, Tour 18 attacks the district court's findings that a golf-hole design is nonfunctional and that Sea Pines' golf-hole design is protectible in that it is inherently distinctive or alternatively has acquired secondary meaning. The Plaintiffs challenge the district court's findings that Pebble Beach and Pinehurst's golf holes are not inherently distinctive and are therefore unprotectible, but they do not challenge its finding that neither golf-hole design has acquired secondary meaning.

#### i. functionality

The Lanham Act protects only nonfunctional distinctive trade dress; this limitation "serves to assure that competition will not be stifled by the exhaustion of a limited number of trade dresses." *Two Pesos*, 505 U.S. at 775. "[A] design is legally functional, and thus unprotectible, if it is one of a limited number of equally efficient options available to competitors and free competition would be unduly hindered by according the design trademark protection." *Id.* (citing *Sicilia Di R. Biebow*, 732 F.2d at 426); ... A collection of functional features in a product design does not necessarily make the combination of those features functional and therefore unprotectible. Where the trade dress of a product consists of a particular configuration of features, the functionality of the design turns on "whether its design as a whole is superior to other designs, not on whether its component features viewed individually each have a function." *Vaughan Mfg. Co. v. Brikam Int'l, Inc.*, 814 F.2d 346, 350 (7th Cir. 1987) (emphasis added). In determining whether competition would be stifled, we have considered whether the feature or combination of features is "superior or optimal in terms of engineering, economy of manufacture, accommodation of utilitarian function or performance." *Sicilia Di R. Biebow*, 732 F.2d at 429; ... The Supreme Court has stated the question more generally as whether the trade dress is "'essential to the use or purpose of the article or if it affects the cost or quality of the article,' that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage." *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165, 131 L. Ed. 2d 248, 115 S. Ct. 1300 (1995) (quoting *Inwood Lab., Inc. v. Ives Lab., Inc.*, 456 U.S. 844, 850 n.10, 72 L. Ed. 2d 606, 102 S. Ct. 2182 (1982)).

The district court determined that the golf-hole designs at issue here are nonfunctional, noting that there is an "unlimited number of alternative designs" to the Plaintiffs' golf-hole designs and that no evidence indicated that the Plaintiffs' designs are superior to the

many available alternatives. In finding that competition would not be hindered by protecting the Plaintiffs' golf-hole designs, the district court noted that one of Tour 18's experts testified that protecting the design of the golf holes from copying would not unduly injure competition and that Tour 18's director of marketing testified that a golf course need not copy golf-hole designs in order to be competitive in the Houston market. See *id.*

Tour 18 first attacks the district court's finding that golf holes are nonfunctional by defining its product as a golf course that provides replicas of famous golf holes. It claims that such a product requires that it be able to copy famous golf holes in order to have any commercial success in delivering its product: a course copying famous golf holes. While Tour 18's product may be a golf course the commercial success of which has been based upon copying golf holes, it nevertheless is still just a collection of golf holes. Features that contribute to the commercial success of a product are not thereby necessarily classed as functional. In *Sicilia Di R. Biebow*, this court rejected the argument that functionality should be defined in terms of commercial success or marketing effectiveness because such a definition would allow a second comer to copy the protectible trade dress of a product whenever the product became successful and preferred by consumers. Tour 18 argues that in *Qualitex* the Supreme Court overruled this holding with its citation of Justice White's concurrence in *Inwood Laboratories*, which stated that "[a] functional characteristic is an important ingredient in the commercial success of the product." See *Qualitex*, 514 U.S. at 165 (internal quotation marks omitted) (quoting *Inwood Lab.*, 456 U.S. at 863 (White, J., concurring in the result)). However, these two statements are not inconsistent. Justice White's statement is merely an acknowledgment that a functional feature is by definition important to the commercial success of a product because without the functional feature a viable, competitive product could not be produced and because competition would be injured if such a feature were protectible by trademark law. The converse, however, is not true. To define functionality based upon commercial success would allow the second comer to trade on the first comer's goodwill, purely because it would be easier to market his product and not because he could not produce a viable, competitive product. Such a rule does not promote innovation, nor does it promote competition, leaving no reason to narrow trademark protection. The logical extension of this argument would practically obliterate trademark protection for product design because a defendant could always argue that its innovative product is a widget that provides a replica of the most popular or most prestigious widget on the market, thus requiring that the defendant be allowed without further analysis to copy the plaintiff's widget.

Tour 18 then argues that every feature of a golf hole and how it is configured affects how the hole plays, making any golf-hole design functional. Without citing any authority, Tour 18 urges a rule that a feature or configuration of features is functional unless "a specific design can be made another way without affecting use, purpose, cost, quality or commercial desirability." This rule is much broader than any applied in this circuit or by the Supreme Court and could conceivably render any design functional because any change would undoubtedly somehow affect cost, use, or commercial desirability. Additionally, the Supreme Court limited its statement that trade dress is functional if the trade dress is essential to the use or purpose of the product or affects the cost or quality of the product with the following language: "that is, if exclusive use of the features [or combination of features] would put competitors at a significant non-reputation-related disadvantage." *Qualitex*, 514 U.S. at 165. This language makes it clear that any effect must be great enough to significantly disadvantage competitors in ways other than consumer preference for a particular source.

Next, Tour 18 contends that *Qualitex* imposes as a threshold inquiry in the functionality analysis the question of whether the trade dress serves "any other significant func-

tion.” See 514 U.S. at 166. It argues that this question must be considered before concerns of competition and available alternative designs can be addressed. This is a misreading of *Qualitex*, which held that, in certain circumstances, color can be a registerable trademark. See *id.* Where the Supreme Court uses the language “without serving any other significant function,” it is stating that color alone may sometimes meet the basic legal requirements for use as a trademark. This language in *Qualitex*, as supported by its accompanying citations, is just another way of stating that functionality, with its consideration of the needs of competition, bars Lanham Act protection to functional features and configurations, which by definition serve a significant function other than source-identification. As noted earlier, functionality takes into account whether protecting a particular feature or combination of features would “hinder competition or impinge upon the rights of others to compete effectively.” See *Sunbeam Prods.*, 123 F.3d at 255 (internal quotation marks omitted). Therefore, *Qualitex* does not create a threshold inquiry in the functionality analysis. Additionally, we have held that nonfunctional trade dress may still have some utility—i.e., serve a function other than source-identification—and still be legally nonfunctional. See *Sicilia Di R. Biebow*, 732 F.2d at 429.

Having rejected Tour 18’s challenges to the district court’s analysis, and after reviewing the evidence, we find that the district court did not clearly err in finding that the Plaintiffs’ golf-hole designs are nonfunctional.

#### ii. distinctiveness

Trademarks and trade dress are distinctive and protectible if they serve as indicators of source. Trademarks and trade dress are classified into the following categories: (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary, or (5) fanciful. The last three categories—suggestive, arbitrary, and fanciful—are inherently distinctive, requiring no additional showing to be protectible, “because their intrinsic nature serves to identify a particular source of a product.” *Sunbeam Prods.*, 123 F.3d at 252 (quoting *Two Pesos*, 505 U.S. at 768). A mark or trade dress is descriptive if it “identifies a characteristic or quality of an article or service, such as its color, odor, function, dimensions, or ingredients.” *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 790 (5th Cir. 1983) (citations and internal quotation marks omitted). A descriptive mark or trade dress is protectible only when it has “acquired a secondary meaning in the minds of the consuming public.” *Id.* A generic mark or trade dress is never protectible because it connotes “a particular genus or class of which an individual [product] or service is but a member . . . , rather than the more individualized characteristics of a particular product.” *Id.* (citations and internal quotation marks omitted).

The district court found that Pebble Beach and Pinehurst’s golf-hole designs were not inherently distinctive because they were variations on commonplace themes in the design of golf holes. Sea Pines’ golf-hole design, however, is inherently distinctive according to the district court because the incorporation of the lighthouse adds an “arbitrary source-identifying feature[.]” Additionally, the district court determined that Sea Pines’ golf-hole design had acquired secondary meaning in the public’s mind. As to Pebble Beach and Pinehurst’s golf-hole designs, the district court found no evidence to support a conclusion that either design had acquired secondary meaning.

The Plaintiffs argue that the district court should have found Pebble Beach and Pinehurst’s golf holes to be inherently distinctive. However, Pebble Beach and Pinehurst’s golf-hole designs do not fall into any of the three inherently distinctive classifications. Arbitrary and fanciful marks or trade dress “bear no relationship to the products or services to which they are applied.” *Zatarains*, 698 F.2d at 791. The trade dress of Pebble

Beach and Pinehurst's golf holes is a configuration of commonplace features of a golf hole and therefore does bear a relationship to the product, a golf hole. A suggestive mark or trade dress "suggests, rather than describes, some particular characteristic of the goods or services to which it applies and requires the consumer to exercise the imagination in order to draw a conclusion as to the nature of the goods and services." *Id.* The configurations of the features in Pebble Beach and Pinehurst's golf-hole designs create golf holes and nothing more. They require no exercise of one's imagination to realize that one is viewing a golf hole. Therefore, the district court did not clearly err in finding that Pebble Beach and Pinehurst's golf-hole designs were not inherently distinctive.

Tour 18 argues that Sea Pines' golf-hole design is not protectible because a golf hole's trade dress is generic and because, even if it is descriptive, the Plaintiffs failed to present evidence that demonstrates that Sea Pines' trade dress has acquired secondary meaning. In general, a golf hole's trade dress may be generic, but Sea Pines' inclusion of the distinctive lighthouse in the design of the golf hole takes it out of the generic classification because it emphasizes the "individualized characteristics" of this particular golf-hole design rather than connoting golf holes in general. Therefore, the district court did not clearly err in finding that Sea Pines' golf-hole design was not generic.

As Sea Pines' golf-hole design is not generic, it is protectible if it has acquired secondary meaning. That a particular mark or trade dress has acquired secondary meaning can be proven by a consideration of the following evidence: (1) length and manner of use of the mark or trade dress, (2) volume of sales, (3) amount and manner of advertising, (4) nature of use of the mark or trade dress in newspapers and magazines, (5) consumer-survey evidence, (6) direct consumer testimony, and (7) the defendant's intent in copying the trade dress. See RESTATEMENT, *supra*, § 13 cmt. e; ... While each of these types of evidence alone may not prove secondary meaning, in combination they may indicate that consumers consider the mark or trade dress to be an indicator of source. In considering this evidence, the focus is on how it demonstrates that the meaning of the mark or trade dress has been altered in the minds of consumers. See *id.* For example, in the case of advertising, spending substantial amounts of money does not of itself cause a mark or trade dress to acquire secondary meaning, but advertisements may emphasize "the source significance of the designation through prominent use of the [mark or trade dress]" and are therefore likely to alter the meaning of the mark or trade dress in the minds of consumers. See RESTATEMENT, *supra*, § 13 cmt. c, at 110.

The district court based its finding of secondary meaning upon Sea Pines' extensive advertising; unsolicited publicity of the trade dress of Sea Pines' golf hole, including the lighthouse, in golf publications; and Tour 18's intent to copy and use the trade dress prominently in its advertising. Tour 18 argues that the district court erred in relying upon the advertising and publicity because they touted the design of the golf hole for its playing qualities and not as a designation of source. While some of Sea Pines' advertising and publicity does promote the playability of the golf hole, the trade dress of Sea Pines' golf hole, including the lighthouse, is prominently used in the advertising and the publicity of the Harbour Town Golf Links in a manner other than simply to promote the playing qualities of the golf hole. Therefore, the district court did not clearly err in finding that Sea Pines' trade dress had acquired secondary meaning.

#### b. the lighthouse

Tour 18 does not challenge the protectibility of depictions of the lighthouse; rather, it challenges Sea Pines' rights in the lighthouse. Tour 18 argues that Sea Pines no longer has any rights in the lighthouse because (1) it does not own the lighthouse and (2) by its

course of conduct, it has abandoned the lighthouse as a mark. In response to the first argument, we adopt the reasoning of the district court:

The Lanham Act does not require a party to “own” a word, symbol, or other identifying mark before it may be granted protection from infringement. Rather, all that is required is that a party “use” the mark in commerce to identify its services and distinguish them from the services of others. 15 U.S.C. § 1127 ...

Tour 18 styles its argument as attacking Sea Pines’ interest in the structure of the lighthouse itself and not in the image of the lighthouse, arguing that the only connection between the golf course and the lighthouse is that the lighthouse can be seen from the course. However, Harbour Town Golf Links was built by the same entity that constructed the lighthouse and the evidence demonstrates that the placement and design of the course and the lighthouse were specifically designed to create the relationship between the course and the lighthouse. This is not a case where the only connection is the coincidence of proximity or location. The connection between the course and the lighthouse is much greater and dates back to the conception of both. Sea Pines has used depictions of the lighthouse in relation to golfing services since 1969, and the district court did not clearly err in finding that the lighthouse has achieved secondary meaning in relation to golfing services in the minds of consumers. The sale of the lighthouse to Fogelman’s predecessor, while reserving trademark rights in depictions of the lighthouse, does not alter this finding.

In relation to abandonment, Tour 18 argues that Sea Pines’ failure to police third-party uses of the lighthouse as a mark has caused the mark “to lose its significance as a mark,” thus constituting abandonment under 15 U.S.C. § 1127. As Tour 18 argues, this form of abandonment does not require any intent to abandon on the part of Sea Pines. However, the evidence shows, as the district court discussed, that Sea Pines has not failed to police third-party uses of depictions of the lighthouse; rather, it has aggressively policed third-party uses. Additionally, the district court’s finding of secondary meaning in the lighthouse mark for golfing services shows that the lighthouse has not lost its significance as a mark for golfing services, despite the third-party uses in relation to other products and services. Those third-party uses are only relevant to the strength of the mark in this case and do not evidence abandonment.

### 3. Likelihood of confusion

Next we turn to whether Tour 18’s use of the Plaintiffs’ marks and trade dress infringed the Plaintiffs’ rights. The touchstone of infringement is whether the use creates a likelihood of confusion as to the “source, affiliation, or sponsorship” of Tour 18’s golf course. Likelihood of confusion is synonymous with a probability of confusion, which is more than a mere possibility of confusion. In determining whether a likelihood of confusion exists, this court considers the following nonexhaustive list of factors: (1) the type of mark allegedly infringed, (2) the similarity between the two marks, (3) the similarity of the products or services, (4) the identity of the retail outlets and purchasers, (5) the identity of the advertising media used, (6) the defendant’s intent, and (7) any evidence of actual confusion. No single factor is dispositive, and a finding of a likelihood of confusion does not require a positive finding on a majority of these “digits of confusion.”

While noting that no golfer will stand on the tee at Tour 18 and believe that he or she is playing at Pebble Beach, Pinehurst, or Harbour Town, in considering Tour 18’s use of the Plaintiffs’ marks and depictions of the lighthouse, the district court found that all seven digits of confusion weighed in favor of a likelihood of confusion as to whether the

courses are otherwise affiliated. In reaching this determination, the district court considered Tour 18's use of disclaimers and found them to be inadequate where present and to be absent from the majority of advertisements and promotional material. In relation to Sea Pines' trade dress, the district court also found that the digits of confusion weighed in favor of a likelihood of confusion, partially relying upon its analysis of the likelihood of confusion in relation to the marks and upon the same actual confusion evidence as used in relation to the marks.

Tour 18 attacks the district court's finding of a likelihood of confusion based upon its consideration of evidence of actual confusion that consumers believed that Tour 18 had obtained "permission" to use the Plaintiffs' marks and to copy their golf holes. Tour 18 argues that "permission" does not include a connotation of control and therefore does not express a relationship that is relevant to confusion as to source, affiliation, sponsorship, or approval. We disagree.

Permission is synonymous with approval and suggests some connection between the parties. The idea that one party has given permission to another implies a form of approval of the other's activities. See WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY 1683 (Philip Babcock Gove ed., 1963) (defining "permission" as "the act of permitting : formal consent : AUTHORIZATION" and "permit" as "to consent to expressly or formally"); WILLIAM C. BURTON, LEGAL THESAURUS 30, 383 (2d ed. 1992) (including "consent to" among synonyms of "approve," "permit" among synonyms of "approval," and "approval" among synonyms of "permission"); see also ROGET'S DESK THESAURUS 30, 397 (Joyce O'Connor ed., 1995) (same). For a party to suggest to the public, through its use of another's mark or a similar mark, that it has received permission to use the mark on its goods or services suggests approval, and even endorsement, of the party's product or service and is a kind of confusion the Lanham Act prohibits. Therefore, confusion as to permission is relevant confusion under the Lanham Act.

The Plaintiffs' survey was conducted among golfers who had played a round of golf at Tour 18. Tour 18 argues that the survey was flawed because, by relying upon "permission," it created the possibility that those surveyed believed that permission was required, thereby skewing the result. But the survey asked whether Tour 18 "did get" or "did not get" permission to use the Plaintiffs' marks or to copy the Plaintiffs' golf holes. This question asks what message Tour 18's use of the Plaintiffs' marks and trade dress conveyed, rather than whether Tour 18 needed to get permission, which would focus on what those surveyed believed to be required. Although, this latter form is more problematic because it allows for the consumer's misunderstanding of the law, rather than the defendant's use the marks, to be the basis for his belief, it has been accepted by other courts as probative as to confusion. Therefore, the district court did not improperly rely upon the Plaintiffs' survey.

In addition to the survey evidence, the district court relied upon the testimony of the witnesses that, before actually playing the course, they thought Tour 18 had obtained permission to use the Plaintiffs' marks and trade dress; most notably, two witnesses testified that Tour 18's advertising in particular caused their confusion. This confusion was relevant even if it was obviated by playing the course and viewing the holes and disclaimers on the golf course signs. Moreover, those disclaimers and signs did not necessarily obviate the confusion as evidenced by the findings of the Plaintiffs' survey of golfers who had played Tour 18 and had been exposed to all of Tour 18's disclaimers on the course. Additionally, "evidence of actual confusion is not necessary to a finding of a likelihood of confusion." *Elvis Presley Enters.*, 141 F.3d at 203-04 (citing *Amstar*, 615 F.2d at 263). After reviewing the record, we cannot say that the district court committed clear error

in finding actual confusion and in finding a likelihood of confusion based partially upon that actual confusion, resulting from Tour 18's use of the Plaintiffs' marks and trade dress.

#### 4. Nominative use

Tour 18 asserts that it has used the Plaintiffs' marks only to identify the Plaintiffs' golf holes that it copied and that such use, as a matter of law, does not create a likelihood of confusion. The district court treated this argument by Tour 18 as a species of the fair-use defense and considered it after finding a likelihood of confusion. While a claim that the use was to identify the markholder's goods or services is analogous to the statutory fair-use defense, it is in actuality a claim that the use is noninfringing and thus creates no likelihood of confusion.

Courts have long recognized that one who has lawfully copied another's product can tell the public what he has copied. Likewise, one can use another's mark truthfully to identify another's goods or services in order to describe or compare its product to the markholder's product. This right to use a mark to identify the markholder's products—a nominative use—however, is limited in that the use cannot be one that creates a likelihood of confusion as to source, sponsorship, affiliation, or approval.

As the Ninth Circuit has recognized, where a nominative use of a mark occurs without any implication of affiliation, sponsorship, or endorsement—i.e., a likelihood of confusion—the use “lies outside the strictures of trademark law.” *New Kids on the Block*, 971 F.2d at 308. In order to avail itself of the shield of nominative use, the defendant (1) may only use so much of the mark as necessary to identify the product or service and (2) may not do anything that suggests affiliation, sponsorship, or endorsement by the markholder. By definition, the defendant cannot use the mark to identify its goods because this would not be a nominative use, and it would also suggest affiliation, sponsorship, or endorsement.

The district court found that Tour 18 used the Plaintiffs' marks as service marks to name its own products and to distinguish them from those offered by other golf courses. Based upon the prominent use of the Plaintiffs' marks in its advertising and promotional material, use of the marks on its menu, and use of the marks on signs directing players to each tee, Tour 18 has used the marks in ways suggesting affiliation, sponsorship, or approval. Therefore, the district court did not clearly err in finding that Tour 18 had used the Plaintiffs' marks in a service-mark context on its own products and services and did not err in denying Tour 18 the shield of nominative use.

In addition, Tour 18 argues that, because the allowable use of a mark in comparative advertising (a nominative use) will normally result in a positive finding among a majority of the digits of confusion, the traditional likelihood-of-confusion analysis cannot be applied. However, implicit in this argument is a misunderstanding of the likelihood-of-confusion analysis. The digits of confusion “are not an end in themselves, and all are not of equal significance. The [digits] serve only as guides on the analytical route to the ultimate determination of whether confusion is likely to result.” *Champions Golf Club*, 78 F.3d at 1122; see also *Falcon Rice Mill, Inc. v. Community Rice Mill, Inc.*, 725 F.2d 336, 345 n.9 (5th Cir. 1984) (“It is clear that some factors are more important than others and that they may have different weight in different cases.”). Additionally, a court is not limited to considering only the standard digits of confusion and should consider other relevant factors in its analysis. Furthermore, as noted earlier, a positive finding on a majority of the digits of confusion does not require a court to find a likelihood of confusion. Therefore, the traditional likelihood-of-confusion analysis is applicable in a comparative-ad-

vertising situation, but the court should usually consider the nominative-use claim in conjunction with its likelihood-of-confusion analysis to avoid lowering the standard of confusion. Because Tour 18 used the Plaintiffs' marks in more than a merely nominative sense, a different approach would not have altered the result.

### 5. Effect of Sears-Compco

In addition to its attack on the district court's traditional trade-dress analysis, Tour 18 contends that it has the unfettered right to copy the Plaintiffs' golf-hole designs and lighthouse under the Intellectual Property Clause of the Constitution. See U.S. CONST. art. I, §8, cl. 8. Tour 18 points to *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 11 L. Ed. 2d 661, 84 S. Ct. 784 (1964), and *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 11 L. Ed. 2d 669, 84 S. Ct. 779 (1964), to demonstrate that unfair-competition law cannot protect product designs or configurations to which no current, valid patent applies. We disagree.

First, *Sears* and *Compco*, both decided the same day, concerned the preemption of state trade-dress protection by federal patent law and barred the use of state unfair-competition laws to prohibit the copying of products that are not protected by federal patents. See *Sears*, 376 U.S. at 231-32 (copying of a lamp); *Compco*, 376 U.S. at 237-38 (copying of a reflector for a fluorescent light fixture). This bar to state prohibitions on copying includes nonfunctional designs and designs that have achieved secondary meaning. See *Compco*, 376 U.S. at 238. However, the Supreme Court noted that "other federal statutory protection," in addition to the patent laws, may bar copying of a product. See *id.* at 238. In *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 103 L. Ed. 2d 118, 109 S. Ct. 971 (1989), the Supreme Court reaffirmed its *Sears-Compco* holdings that limit state protection of product designs and noted that the application of *Sears-Compco* to nonfunctional product design must take into account competing federal policies as evidenced by the Lanham Act. Thus, federal trademark protection is not limited by the preemption holdings in *Sears-Compco*.

Second, the federal trademark laws are "other federal statutory protection," and their protection of product designs and configurations does not conflict with the federal patent laws or the Intellectual Property Clause. The patent laws and the trademark laws have two entirely different and consistent purposes, addressing entirely different concerns. The patent laws serve (1) "to foster and reward invention," (2) "to promote[] disclosure of inventions to stimulate further innovation and to permit the public to practice the invention once the patent expires," and (3) "to assure that ideas in the public domain remain there for the free use of the public." *Aronson v. Quick Point Pencil Co.*, 440 U.S. 257, 262, 59 L. Ed. 2d 296, 99 S. Ct. 1096 (1979); see also *Duraco Prods.*, 40 F.3d at 1446 (noting that the policy of encouraging innovative designs is the province of the patent and copyright laws). The principal purposes of the trademark laws are to avoid consumer confusion and to protect the goodwill of the trademark owner's business. While the federal trademark laws provide a trademark or trade-dress owner indefinite protection unlike the limited-duration protection provided by the patent laws, traditional trade-dress analysis limits the scope of product designs or configurations that can be protected to avoid conflict between the two areas of law.

Third, in the more than thirty years since *Sears-Compco*, Congress and the courts have recognized that federal unfair-competition law provides protection to product designs and configurations consistent with the patent laws. The Supreme Court found in *Qualitex* that the reenactment of this language—along with its legislative history explicitly referring to the Trademark Commission's recommendation that the terms "symbol, or



device” be left unchanged to allow registrations of color, shape, smell, sound, or configuration that function as a mark—undercut restrictive trademark precedent. Thus, Congress and the Court have embraced a broad reading of the Lanham Act and its protections, which can encompass product designs and configurations.

For the above reasons, the Intellectual Property Clause, the federal patent laws, and the Sears-Compco-line of cases do not preclude federal trademark protection for product designs and configurations. Under our jurisprudence today, the result of North Shore Laboratories alternative holding would be the same because the color of the tire-patch material was functional and lacked secondary meaning, each independently barring protection under the Lanham Act.

Finally, if the acid test of any theory is how it works in practice, we note that the application of traditional trade-dress analysis under the Lanham Act to the product configurations at issue here, the design of the Plaintiffs’ golf holes, has effectively left intact Tour 18’s right to copy the Plaintiffs’ golf holes, barring only its copying of the lighthouse.

\* \* \*

### III. CONCLUSION

For the foregoing reasons, we AFFIRM the district court’s judgment as modified. Each party shall bear its own costs on appeal.

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## Notes

1. Keep in mind as you read these materials whether or not the court’s opinion in *Tour 18* regarding trade dress is still good law, in light of *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000).

2. In *Tour 18*, the court described a potential conflict between federal and state law and whether the Lanham Act preempts state common law of trademarks. Citing *Bonito Boats*, *Sears*, and *Compco*, the court concluded that there is no preemption. In *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964), and *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964), the Supreme Court held that state trademark statutes were not pre-empted by the Lanham Act. Later, the Supreme Court clarified this decision in *Bonito Boats* as follows:

[T]he States may not offer patent-like protection to intellectual creations which would otherwise remain unprotected as a matter of federal law. Both the novelty and the nonobviousness requirements of federal patent law are grounded in the notion that concepts within the public grasp, or those so obvious that they readily could be, are the tools of creation available to all. They provide the baseline of free competition upon which the patent system’s incentive to creative effort depends. A state law that substantially interferes with the enjoyment of an unpatented utilitarian or design conception which has been freely disclosed by its author to the public at large impermissibly contravenes the ultimate goal of public disclosure and use which is the centerpiece of federal patent policy. Moreover, through the creation of patent-like rights, the States could essentially redirect inventive efforts away from the careful criteria of patentability developed by Congress over the last 200 years. We understand this to be the reasoning at the core of our decisions in *Sears* and *Compco*, and we reaffirm that reasoning today.

*Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989).

Is there ever a time when state trademark law would be pre-empted by the Lanham Act? If we are to have one federal system of trademark law, what is the value of not preempting state trademark statutes? Both the federal Copyright Act and the Patent Act are said to preempt the state laws of copyright and trademark. In that case, why not preempt state trademark statutes as well?