Marching to Madness: Dual Use Trademarks after Illinois High School Association v. GTE Vantage

Jonathan Berger

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Marching to Madness: "Dual Use" Trademarks After *Illinois High School Association v. GTE Vantage*

by

JONATHAN BERGER'

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* J.D. magna cum laude, University of California, Hastings College of the Law, 1999; B.A., University of California at Santa Cruz, 1976. The author gratefully acknowledges the invaluable assistance of Prof. Margreth Barrett in bringing this case to his attention and discussing the issues it raises; of Oren Katzef, Hastings class of 1999, for the intensive tutorial on the intricacies of college basketball; and most particularly of Richard W. Young, counsel for the Illinois High School Association in this case, who generously provided the court documents cited herein.
The gym lights gleam like a beacon beam
   And a million motors hum
In a good will flight on a Friday night;
   For basketball beckons, "Come!"
A sharp-shooting mite is king tonight.
   The Madness of March is running.
The winged feet fly, the ball sails high
   And field goal hunters are ginning.

. . . .
With war nerves tense, the final defense
   Is the courage, strength and will
In a million lives where freedom thrives
   And liberty lingers still.
Now eagles fly and heroes die
   Beneath some foreign arch
Let their sons tread where hate is dead
   In a happy Madness of March.¹

Introduction

The association between madness and the month of March probably entered the cultural consciousness of the English-speaking world by way of naturalists' observations that "[h]ares are unusually shy and wild in March, which is their rutting season."² Erasmus used the phrase "mad as a March hare" as early as 1542.³ The term was a literary staple by the middle of the nineteenth century,⁴ and of course its greatest exponent was Lewis Carroll, who created the memorably mad March Hare character in his classic Alice's Adventures in Wonderland.⁵

³. See id. (quoting Erasmus, Aphorisms).
⁵. See LEWIS CARROLL (CHARLES DODGSON), ALICE'S ADVENTURES IN
March is also the month when basketball season draws to a close, and the insanity associated with the championship tournaments begins. The term “March Madness” was first used in reference to this season by Henry V. Porter, the executive director of the Illinois High School Athletic Association, as the title of a 1939 essay celebrating the indomitable spirit of the high-school basketball player. Three years later, when the country was embroiled in World War II, Porter wrote the poem quoted in part at the beginning of this Note as a tribute to the high school basketball championship tournament’s ability to “provide[] a unifying force that brought the entire state together.”

The Illinois High School Association (hereinafter “IHSA”) began using the term “March Madness” in reference to its basketball championship tournament in the early 1940’s. The term became familiar to Chicago sportscaster Brent Musburger when he covered the IHSA tournament in the early 1960’s and 1970’s, and when Musburger began covering the National College Athletic Association (hereinafter “NCAA”) “Final Four” championship games for CBS in 1982, he used the term to designate them. The term caught on and is now widely used by the media and the public to denote this basketball tournament as well as IHSA’s. “March Madness,” at this point, is generally understood to refer to the NCAA’s Final Four tournament.

The two uses of the term coexisted peacefully for a number of years. During this period, IHSA used “March Madness” as a common-law trademark in connection with souvenir

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7. See Origins, supra note 1.
11. See Ill. High Sch. Ass’n, 99 F.3d at 245.
12. Id.
13. See the extensive sampling of quotations from media sources in Brief of Defendant-Appellee GTE Vantage Incorporated at 4-7, Ill. High Sch. Ass’n (No. 96-1981).
tournament items sold at tournaments, but did not register it with the Patent and Trademark Office, and made no attempt to prevent the media's ever-expanding use of the term. The NCAA apparently did not use the term for its own purposes during this period.

The IHSA began licensing the use of "March Madness" in 1994, when it granted PepsiCo a license to use the term on beverage cans. The NCAA, for its part, began licensing it in 1993. In 1996, it issued a license to GTE Vantage, who used the term to promote a CD-ROM game entitled "NCAA Championship Basketball," which GTE Vantage advertised in magazines and on the World Wide Web. IHSA sued for trademark infringement in March, 1996, following GTE's refusal to agree to a licensing arrangement.

The District Court found that IHSA did not have a protectible trademark, and the Court of Appeals for the Seventh Circuit, with Chief Judge Posner writing for a unanimous panel, affirmed. While recognizing that "March Madness" can hardly be called a generic term since it describes only two of the hundreds of basketball tournaments which take place annually in March, Judge Posner found that:

[t]here is no magic in labels. Let "March Madness" be called not a quasi-generic term, or a term on its way to becoming generic, but a dual-use term. Whatever you call it, it's a name that the public has affixed to something other than, as well as, the Illinois high school basketball tournament. A trademark owner is not allowed to withdraw from the public domain a name that the public is using to denote someone else's good or service, leaving that someone and his customers speechless. No case so holds, other than the cases

14. See Brief of Defendant-Appellee, supra note 13, at 8.
15. See id. at 9.
17. See id. at 12.
18. See id. at 11.
19. See id. at 13.
20. See id.
21. See id.
23. See id. at 248.
24. "Generic" in the sense that "aspirin" is generic, and hence unenforceable as a trademark despite having been one originally; see Bayer Co. v. United Drug Co., 272 F. 505, 509 (S.D.N.Y. 1921).
involving generic names, but no case holds the contrary, either. It is an issue of first impression, and we think that for the sake of protecting effective communication it should be resolved against trademark protection, thus assimilating dual-use or multiple-use terms to generic terms.  

It is remarkable enough when a federal appellate judge announces that there is no magic in labels; one cannot help but wonder whether the distinction between the labels "murder" and "manslaughter" has any ongoing vitality in Judge Posner's view. It is considerably more remarkable, though, to see an entirely new entry in the trademark taxonomy — the freshly-minted "dual-use" category — created with the stroke of a pen, and then, four sentences later, subsumed within "generic terms." If there is indeed such a thing as a dual-use trademark, Judge Posner offers no justification for his insistence, in the face of his apparent concession that the particular mark at issue here is not generic, that such marks should be classed with generic terms, beyond the entirely conclusory declaration that such classification "protect[s] effective communication."  

This article takes the position that there was no need to create the concept of the "dual-use trademark" at all; that the existing trademark-law framework was perfectly adequate for the task of adjudicating issues such as the one presented here; and that the potential perils of dual-use trademarks far outweigh any benefits which might spring from their existence.

I  
Trademark Law: A Brief Introduction

Trademarks are indicators of the origin of a product, good, or service; their fundamental purpose is to enable consumers to reward the vendor of quality goods by buying more of them and to penalize the vendor of shoddy goods by avoiding them. The overarching goal of trademark law is "to

26. Id.  
27. Id.  
28. See United States v. Steffens, 100 U.S. (10 Otto) 82, 87 (1879) (trademarks "are the means by which manufacturers and merchants identify their manufactures and merchandise. They are the symbols by which men engaged in trade and manufactures become known in the marts of commerce, by which their reputation and that of their goods are extended and published . . ."); Qualitex Co. v. Jacobsen Products, Inc., 514 U.S. 159, 163 (1995) (purpose of a
ensure that consumers are able to rely on marks in exercising their preferences by prohibiting competitors from using marks in a way that confuses consumers about the source of a product or service. A trademark which fails to achieve this goal is, at a philosophical level, no trademark at all.

Federal trademarks in the United States are regulated by the Trademark Act of 1946, popularly known as the Lanham Act. Prior to the passage of the Lanham Act, trademark protection was considered to be inappropriate for federal regulation; the right to exclusive use of a trademark was enforced only by the states. The Lanham Act both codified and expanded the trademark protection previously afforded by state common and statutory law. One of the Act’s major innovations was the introduction of the Principal Register, a repository maintained by the federal Patent and Trademark Office where trademark owners who either use a mark in commerce or intend to do so may register their marks. (The ubiquitous “®” symbol designates a mark which has been so registered.) Registering a mark on the principal register confers certain benefits, the most important of which is “constructive notice.” Under common law, a trademark was generally protected only in the geographic area where it was actually used, but a registered mark is considered to be “used,” in this sense, across the entire U.S. even if its use is limited geographically as a factual matter.

However, trademark owners are not required to avail themselves of these benefits. A trademark is protectible whether it is registered or not; the Lanham Act expressly pro-

29. MARGRETH BARRETT, INTELLECTUAL PROPERTY – PATENTS, TRADEMARKS, & COPYRIGHTS 78 (2d ed. 1996-97).
33. See Hanover Star Milling Co. v. Metcalf, 240 U.S. 403, 415-21 (1916); see generally Smith, supra note 31, at 1081 n.20.
vides remedies for infringement of both registered and un-
registered marks. The owner of an unregistered mark can
prevail in an infringement action against a defendant who
uses the mark in a manner which "is likely to cause confu-
sion . . . as to the origin, sponsorship, or approval of his or
her goods." Courts have found that such confusion is likely
under two broad classes of circumstances: the familiar
"palming off" or "direct confusion" scenario, where a small
and insignificant junior user attempts to free-ride on the
familiarity of a large and powerful senior user's mark; and
"reverse confusion" situations, where a large junior user
overwhelms the marketplace with its usage of a small senior
user's mark, thus creating the false impression that the sen-
ior user's goods or services originate with the junior user.

II
Abandonment Issues: Had IHSA Abandoned the
"March Madness" Mark?

Under the Lanham Act, trademark ownership carries with
it certain responsibilities. Since "[u]sage, not registration,
confers the right to a trademark," a trademark may lose its

35. As to registered marks, see Lanham Act § 32(1), 15 U.S.C.A. § 1114(1).
As to unregistered marks, see Lanham Act § 43(a), 15 U.S.C.A. § 1125(a);
moreover, the Lanham Act does not preempt existing state statutory and com-
mon law trademark protection. Compare, e.g., Copyright Act of 1976 § 301, 17
U.S.C.A. § 301, which explicitly announces Congress's intention to preempt
state copyright law.


37. That is, one who begins using a trademark subsequently in time to a
"senior user." Note that "senior user" and "junior user" are comparative terms:
where there are three users of a mark, for example, the second in time is junior
to the first, but senior to the third.

38. See, e.g., Florence Mfg. Co. v. J. C. Dowd & Co., 178 F. 73 (2d Cir. 1910)
("the courts look with suspicion upon one who, in dressing his goods for the
market, approaches so near to his successful rival that the public may fail to
distinguish between them.").

39. See generally Big O Tire Dealers, Inc. v. Goodyear Tire & Rubber Co.,
561 F.2d 1365, 1372 (10th Cir. 1977), which is generally recognized as being
the first case to formally embrace the reverse confusion theory. For a thorough
critique of modern reverse-confusion law, see Note, Reverse Confusion: Modifying
the Polaroid Factors to Achieve Consistent Results, 6 FORDHAM INTL. PROP.

40. WGBH Educ. Found., Inc. v. Penthouse Int'l Ltd., 453 F. Supp. 1347,
1350 (S.D.N.Y. 1978), aff'd mem., 598 F.2d 610 (2d Cir. 1979); see also
protection if its owner stops using it, or “abandons” it. The owner may abandon a mark through “any course of conduct . . . , including acts of omission as well as commission,” which cause it to “lose its significance as a mark.” Therefore, the holder of a trademark has a duty “to take reasonable efforts to police infringements of his mark, failing which the mark is likely to be deemed abandoned, or to become generic or descriptive (and in either event be unprotectable).”

GTE Vantage urged that this was precisely what had happened with the “March Madness” trademark: that IHSA “neither protested nor otherwise tried to protect its . . . mark. Instead, it allowed the public consciousness to connect the term with the NCAA tournament . . . . IHSA’s position is obviously not the position taken by trademark owners who desire to keep their marks strong, distinctive and capable of expansion.” IHSA retorted that any attempts to enjoin the use of its mark in connection with NCAA’s event would have inevitably been futile, since the overwhelming majority of such use consisted of “First Amendment-protected activities of journalists — activities over which neither the NCAA nor the IHSA had or could have exercised any control.” In other words, IHSA argued that it makes no sense to apply the police-it-or-lose-it rule where it would require a trademark holder to sue media figures for exercising their First Amendment rights.

IHSA’s argument in this regard was creative, but not unprecedented: a remarkably similar principle was adopted by the D.C. District Court in *Lucasfilm v. High Frontier.* There, the creators of the *Star Wars* films sought to protect their trademark from genericization by public interest groups who

42. Rockwell Graphic Sys. v. DEV Indus., 925 F.2d 174, 179 (7th Cir. 1991); see also 2 J. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 17:17 (4th ed. 1998).
43. Brief of Defendant-Appellee, supra note 13, at 32.
44. Brief of Plaintiff-Appellant, supra note 16, at 8.
45. See id. See also Yankee Publ’g, Inc. v. News America Publ’g, Inc., 809 F. Supp. 267, 275-76 (S.D.N.Y. 1992) (“When unauthorized use of another’s mark is part of a communicative message and not a source identifier, the First Amendment is implicated in opposition to the trademark right.”).
47. In light of *Illinois High School Association*, perhaps the appropriate term is “dual-useification.”
had taken to using the term in reference to President Reagan's Strategic Defense Initiative. \(^48\) The Lucasfilm court refused to enjoin the defendants' use of the term, on the ground that trademark law\(^49\) only applies to commercial uses:

The owner of a mark acquires the right to prevent the goods to which the mark is applied from being confused with those of others and to prevent his own trade from being diverted to competitors through their use of misleading marks. There are no rights in a trademark beyond these.

Furthermore, "[w]hen politicians, newspapers and the public generally use the phrase star wars for convenience, in parody or descriptively to further a communication of their views on SDI, plaintiff has no rights as owner of the mark to prevent this use of STAR WARS." \(^50\)

However, the court went on to address Lucasfilm's concern about the safety of its trademark:

Overlying this lawsuit is plaintiff's natural concern that if he does not seek legal remedies to protect his mark he will lose it. But the use of star wars in political propaganda, newspapers or noncommercial, non-trade references will not undermine plaintiff's exclusive property right to use it in connection with goods and services. . . . [T]he phrase star wars has acquired a double meaning, but it has not become a generic term, that is a term associated with an entire class of goods or services. Continued non-trade, noncommercial use cannot take the mark away from plaintiff Lucasfilm[sic]. Whether this use makes the trademark become ultimately more or less valuable is a matter of conjecture, but the trademark is still plaintiff's. The new meaning of the phrase . . . does not affect the distinct, and still strong secondary meaning of STAR WARS in trade and entertainment. Plaintiff's right to prevent an infringing use of its mark remains intact. \(^52\)

IHSA, naturally enough, took this to mean that it was excused from any obligation to threaten sportscasters who used "March Madness" in reference to the NCAA Final Four with

\(^48\) See Lucasfilm, 622 F. Supp. at 932-33.

\(^49\) The IHSA argued that they were forestalled from preventing the media use of their mark on both trademark-law and First Amendment grounds. See Brief of Plaintiff-Appellant, supra note 16, at 15-16. The Lucasfilm court did not reach the First Amendment issue. The nature of the obstacle, of course, is not essential to IHSA's argument; the point is that any effort to stop the media's use of the trademark would have been foredoomed to failure.

\(^50\) Lucasfilm, 622 F. Supp. at 933.

\(^51\) Id. at 935.

\(^52\) Id. (emphasis supplied).
legal action. This seems a reasonable interpretation; it is certainly difficult to read the foregoing passage as suggesting that Lucasfilm's rights in its trademark were preserved because it had brought an unsuccessful lawsuit to protect them.

The Court of Appeals for the Seventh Circuit, however, found that Lucasfilm was not on point. Judge Posner explained that the right which the Lucasfilm court found to be protected is simply the same right the plaintiff already had: "to use its trademark 'Star Wars' to designate the movies and the merchandise associated with them." If a hypothetical manufacturer of the sort of anti-missile systems contemplated by SDI were to market them under the "Star Wars" trademark, "nothing in the Lucasfilm opinion or in the principles of trademark law would entitle Lucasfilm to enjoin that use of the name." By analogy, presumably, nothing in that opinion or those principles entitles IHSA to enjoin NCAA's use of "March Madness."

The underlying point here has to be that the Lucasfilm dictum confers upon the plaintiff no more rights to enforce its trademark than the plaintiff had prior to the media's use of the term — but this attacks a straw man, since that point was never at issue. In the hypothetical instance Judge Posner posits, Lucasfilm could not have enforced its trademark in any event, with or without the media use of "Star Wars," because there would be no likelihood of confusion between Lucasfilm's goods and services and those of the hypothetical weapon manufacturer. Likelihood of confusion has been dubbed the "keystone of infringement"; the likelihood of confusion between a high-tech military weapon system and a trilogy of futuristic samurai films is self-evidently nil.

53. See Brief of Plaintiff-Appellant, supra note 16, at 15-16 ("Because a mark owner is without a right to stop such uses, it can hardly be argued that he has an obligation to try to stop them by begging, cajoling or otherwise.").
55. Id.
56. See id.
57. 3 McCarthy, supra note 42, § 23.1.
58. See Fuller v. Fuller Brush Co., 595 F. Supp. 1088, 1091-92 (E.D. Wis. 1984) (finding triable question of fact as to substantial likelihood that door-to-door salesman of household products who dressed in bright green sport coat, sunglasses in the shape of butterflies, and flowing cape with stuffed animals
What is considerably less self-evident is whether Judge Posner's hypothetical is itself on point. Would he have been so quick to dismiss Lucasfilm's right to prevent the commercial use of the "Star Wars" mark by, for example, a hypothetical filmmaker who created and marketed a visual mock-up of the proposed SDI system in action, complete with state-of-the-art special effects and a thrilling orchestral score? That would be somewhat more closely analogous to the relationship between a regional high-school basketball tournament and a nationwide college basketball tournament.

It may be symptomatic of Judge Posner's level of confidence in his distinction of Lucasfilm that he felt obliged to shore it up with the observation that district court holdings are not binding on appellate courts.\textsuperscript{59} This is true enough; the Court of Appeals for the Seventh Circuit may of course decide a case differently than the D.C. District if it chooses. It is distressing, however, that Judge Posner ignored the fact that Lucasfilm raised precisely the same issue raised by Illinois High School Association. The only real difference between the two cases is that Lucasfilm brought its legal action before any infringing use of its mark had occurred — Lucasfilm, that is, attempted to be "a serious trademark holder [who] is assiduous" in protecting its mark\textsuperscript{60} — and IHSA waited until afterward.

The crucial question is not, as Judge Posner seems to frame it, whether media use of a trademark confers new rights on the owner; it is whether such use can divest the mark's owner of rights it already had. The Lucasfilm court answered that question in the negative. As noted, the Seventh Circuit was at liberty to disagree. It would have been more satisfying, however, if it had disapproved the previous case expressly, rather than distinguishing it into non-existence on the basis of a blatant mischaracterization.

\textsuperscript{59} See Ill. High Sch. Ass'n, 99 F.3d at 247.

\textsuperscript{60} Id. at 246.
III
Why is This Reverse Confusion Different From Any Other Reverse Confusion?

IHSA sought merely to assert a right it claimed it already had: the right to enjoin a commercial (that is, non-media) user of the term "March Madness" in reference to the NCAA Final Four, under a reverse-confusion theory. As discussed above, reverse confusion arises when:

the junior user saturates the market with a similar trademark and overwhelms the senior user. The public comes to assume the senior user's products are really the junior user's or that the former has become somehow connected to the latter. The result is that the senior user loses the value of the trademark — its product identity, corporate identity, control over its goodwill and reputation, and ability to move into new markets.

The need to protect trademarks in this circumstance has been appreciated since at least 1918, when Justice Holmes pointed out that "[t]he ordinary case . . . is palming off the defendant's product as the plaintiff's[,] but the same evil may follow from the opposite falsehood — from saying whether in words or by implication that the plaintiff's product is the defendant's . . . ." However, Justice Holmes's dictum was not formally adopted by a federal appellate court until 1977, when the Tenth Circuit recognized that "[i]f the law is to limit recovery to passing off, anyone with adequate size and resources can adopt any trademark and develop a new meaning for that trademark as identification of the second user's products." Perhaps significantly, the Seventh Circuit had considered and rejected a cause of action for trademark infringement by reverse confusion nine years earlier. It did not recognize the principle until 1992, and was among the last

62. See supra note 39 and accompanying text.
65. Big O Tire Dealers, Inc., 561 F.2d at 1372.
of the federal circuits to do so.\textsuperscript{68}

The facts in \textit{Illinois High School Association} describe a classic case of reverse confusion: the NCAA and its licensee are undisputedly junior users of the "March Madness" mark;\textsuperscript{69} the NCAA is significantly larger and better publicized than the IHSA;\textsuperscript{70} and as noted, a vast proportion of the public has come to associate "March Madness" with the NCAA rather than the IHSA.\textsuperscript{71} Judge Posner, however, took the position that IHSA had no cause of action for infringement by reverse confusion, because "[t]he issue of confusion does not arise... until it is determined that the plaintiff has a trademark that the law will protect; and... IHSA does not, so far as the use of the term 'March Madness' in connection with the NCAA tournament is concerned."\textsuperscript{72} This, presumably, was because of the long-standing association between the mark and the NCAA's Final Four tournament, which in Judge Posner's view gave the NCAA the right to use and license the mark in reference to that event.\textsuperscript{73}

\begin{itemize}
\item \textsuperscript{68} See, e.g., Banff, Ltd. v. Federated Dep't Stores, Inc., 841 F.2d 486 (2d Cir. 1988); Capital Films Corp. v. Charles Fries Prod., Inc., 628 F.2d 387 (5th Cir. 1980); Ameritech, Inc. v. American Info. Techs. Corp., 811 F.2d 960 (6th Cir. 1987); Fuddruckers, Inc. v. Doc's B.R. Others, Inc., 826 F.2d 837 (9th Cir. 1987).
\item \textsuperscript{69} See \textit{Ill. High Sch. Ass'n}, 99 F.3d at 245 (IHSA has used the trademark "March Madness" since the early 1940s).
\item \textsuperscript{70} See \textit{id.} at 246 (conceding that "NCAA dwarfs IHSA").
\item \textsuperscript{71} See \textit{Brief of Defendant – Appellee, supra note 13.}
\item \textsuperscript{72} \textit{Ill. High Sch. Ass'n}, 99 F.3d at 246.
\item \textsuperscript{73} In their brief to the Seventh Circuit, defendants cited several cases which appear, at first glance, to suggest that public use of a term with reference to a good or service can confer a property right in that term on the provider of the good or service, with no action whatsoever on the provider's part. See \textit{Brief of Defendant-Appellee, supra note 13, at 25-26.} The cases included \textit{Coca-Cola Co. v. Busch}, 44 F. Supp. 405 (E.D. Pa. 1942) (the public's use of "Coke" created rights in the plaintiff that were senior to defendant's use of "Koke"); \textit{American Stock Exchange v. American Express Co.}, 207 U.S.P.Q. 356 (Trademark Tr. & App. Bd. 1980) (the public's use of "Amex" created right in the term in American Express senior to that of American Stock Exchange); \textit{Pieper v. Playboy Enter., Inc.}, 179 U.S.P.Q. 318 (Trademark Tr. & App. Bd. 1973) (widespread use of the term "Bunny Club" in reference to Playboy Clubs created rights in Playboy senior to those of owner of a club by that name). Judge Posner apparently found these cases persuasive, but they're factually distinguishable: a notable feature of all of them is that the marks in question lacked any history of prior use. The public called Playboy Clubs "Bunny Clubs" for a long time \textit{before} the infringing use, for example. This line of cases arguably stands for the proposition that public association can confer rights \textit{where there has been no prior use of the mark} — but, of course, that is not the situation in \textit{Illinois High School Associa-}
This is somewhat curious reasoning. The question of whether IHSA does or does not have a trademark the law will protect is, of course, precisely what was before the Seventh Circuit — but, according to the formulation quoted above, it is the question upon which turns the issue of whether or not protection may be extended. Stripped to its essence, the opinion appears to hold that the trademark cannot be protected because the trademark cannot be protected.

To be sure, the IHSA is asking that its mark be protected against use with respect to the NCAA tournament, a service which IHSA does not provide and over which they have no control — but this will inevitably be true in any action for trademark infringement. If Pam, owner of the trademark Wonder Widgets, sues Dave to enjoin him from marketing One-Door Widgets,74 we do not inquire into whether Pam has the right to use the WONDER mark in connection with Dave's widgets. Of course she does not; Pam has no rights at all with respect to Dave's widgets. Pam's cause of action for infringement arises from the fact that Dave does not have the right to use the ONE-DOOR mark in connection with Dave's own widgets, because Pam owns the WONDER mark, and Dave's use of ONE-DOOR is potentially confusing to the public.

The fact that the species of confusion alleged in *Illinois High School Association* is styled “reverse” does not mean that the inquiry should be turned on its head. As in *Pam v. Dave*, IHSA sought to enjoin the NCAA's licensee from using a mark which IHSA owns, where the use had the potential of confusing the public. As in *Pam v. Dave*, the appropriate inquiry is not into whether the IHSA has the right to use the disputed mark with respect to the NCAA's product; it is into whether the NCAA has that right. Under the “palming off” theory of infringement, this would turn on whether the NCAA's use was likely to mislead the public into believing that its product's source was the IHSA; under a reverse-confusion theory, it would turn on whether the NCAA's use was likely to mislead the public into believing that the IHSA was somehow affiliated with or sponsored by the NCAA. The Seventh Circuit appears

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74. Trademark infringement by “sound-alike” marks is a well-established principle: “[t]rademarks, like small children, are not only seen but heard.” Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons, 523 F.2d 1331, 1340 (2d Cir. 1975).
to have been so overwhelmed by the patently negative answer to the former question that it never reached the latter.

Illinois High School Association, in short, could readily have been decided as a straightforward reverse-confusion case. It is instructive to compare it to Sands, Taylor & Wood Co. v. Quaker Oats Co., the leading such case in the Seventh Circuit, in which Quaker was held liable for infringing plaintiff's "Thirst Aid" mark through reverse confusion generated by Quaker's massive advertising campaign for Gatorade. Precisely as in Illinois High School Association, the disputed mark had acquired widespread association in the public consciousness with the junior user's product. The principal distinction between the two cases is that in Sands, Taylor & Wood, the change in public perception had been accomplished by the media in its advertising persona; in Illinois High School Association, it had been accomplished by the media's journalistic face.

It is difficult to see why that should make a difference. The only conceivable reason it might is that Quaker's conduct could be viewed as mildly culpable since, by paying for the advertising, it affirmatively caused the media blitz which in turn caused the reverse-confusion; the NCAA, in contrast, merely took advantage of the media's volunteering to do the job. This distinction is unpersuasive for at least two reasons. First, the plaintiff in Sands, Taylor & Wood could, presumably, have sued Quaker to enjoin its use of "Thirst Aid" earlier, before it became associated with Gatorade, but IHSA had no comparable opportunity to stop the media's use of "March Madness;" it seems somewhat perverse to reward the party who could (at least in theory) have taken steps to police its trademark, and to penalize the party who was barred from doing so by the First Amendment.

The second and more important reason is that culpability doesn't matter. Trademark infringement is a strict liability offense: if the plaintiff's trademark is protectable, and the defendant's use creates a substantial likelihood of confusion

75. 978 F.2d 947, 958-60 (7th Cir. 1992).
76. The offending use was the widely repeated slogan "Gatorade is Thirst Aid for That Deep Down Body Thirst." Id. at 950.
77. See id. at 960 & n.14. In fact, at the time of the filing of the lawsuit, the plaintiff was not marketing any product whatsoever under the disputed trademark. See id. at 950.
among consumers, the defendant has infringed, culpability or no culpability. A reasonable argument could be made that, even if no previous case has announced one, a culpability standard should apply in reverse confusion cases. However, Judge Posner gave no indication that his refusal to follow Sands, Taylor & Wood was motivated by considerations of culpability vel non; instead, he simply rejected the reverse-confusion theory out of hand.\textsuperscript{78}

His reasons for doing so are perhaps somewhat elucidated by a passage in the opinion from which it is easy to infer that he misunderstands the rationale behind the doctrine. Reverse confusion, he explains, arises "where a powerful junior user of the trademark . . . swamps the senior user's use of it with advertising and other publicity that extinguishes consumer demand for the senior user's product."\textsuperscript{79} The objectionable thing about the reverse confusion alleged by IHSA, Judge Posner suggests, is that it "is likely to impair IHSA's ability to make money by licensing its trademark on merchandise and other incidentals."\textsuperscript{80} In fact, neither the extinction of demand for the senior user's product nor any interference with the senior user's ability to make money is an element of reverse confusion, as traditionally understood.

Rather, the evil in reverse confusion is the confusion itself. As one commentator points out, a small senior user might have any number of reasons for not wishing to be associated in the mind of the public with a nationally recognized junior user, and the reasons might very well be entirely non-commercial in nature: for example, "the junior user's company might stand for certain ideals with which the senior user does not want to be associated."\textsuperscript{81} This is not merely speculative: that very situation arose in Pump, Inc. v. Collins Management, Inc.,\textsuperscript{82} where Pump, an obscure local rock band composed of body builders whose music "promote[ed] physical self-improvement as an alternative to drugs,"\textsuperscript{83} sued the nationally-known rock band Aerosmith over their use of...
Pump as the title of an album. Although the court ultimately held for the defendants, it noted sympathetically that the band Pump was placed in a particularly uncomfortable position by the possibility that consumers might think they had appropriated Aerosmith's title, given the conflict between Pump's strong anti-drug stance and Aerosmith's reputedly "hedonistic lifestyle and . . . rather laissez-faire attitude toward substance abuse."85

Although no rationale of this sort was set forth in Illinois High School Association, it is easy in hindsight to imagine that the IHSA might feel precisely as uncomfortable at being associated with the NCAA as Pump did at being associated with Aerosmith. On March 26, 1998 — that is, on the very eve of the 1998 season's Final Four tournament — newspapers around the country broke the story that "a federal grand jury [in Chicago] indicted two former Northwestern University [basketball] players on charges of attempting to fix the outcome of three contests during the 1994-95 season."86 The two players were charged with conspiring with professional gamblers to alter their play so that their opponents would cover the point spread.87 Billy Packer, a noted sports analyst for CBS, points out that NCAA basketball is actually somewhat infamous for incidents of this sort: "These things seem to run in cycles, almost like 10-year cycles . . . . In the early '50s, we had the CCNY scandal. Ten years later, we had the tragic business with Connie Hawkins and the others. In the '70s, we had Boston College. Then Arizona State and now this."88 IHSA might very reasonably not wish to be connected in the public consciousness with gambling; the more so since the scandal occurred in Chicago, on IHSA's home turf.

The harm visited on the senior user by reverse confusion arises from its loss of control over the reputation of its trademark. If the junior user manufactures a shoddy product, or is

84. AEROSMITH, PUMP (Uni/Geffen 1989).
85. 746 F. Supp. at 1161 n.11. The court piously recited, however, that it "expressed[d] no opinion as to the truth of such rumors as they relate to Aerosmith." Id.
87. Id.
a well-known drug abuser, or is besmirched by a long string of gambling scandals, the harm inheres in the likelihood that the public will attribute these negative qualities to the senior user. The doctrine of reverse confusion is intended to forestall even the possibility of such an outcome.

To the extent the Seventh Circuit's rejection of the reverse confusion theory in *Illinois High School Association* was motivated by an understanding of the doctrine which focused exclusively on the direct effects on the senior user's pocketbook, the decision is profoundly flawed. The basic question in this case should have been whether there was a substantial likelihood that the fans of a high-school basketball association's statewide championship tournament might be erroneously led to believe that the association had infringed on the trademark of a college basketball association's nationally-publicized championship tournament. If the answer to that question was yes, it was perfectly sufficient, without more, to support liability for infringement by reverse confusion.

Indeed, the rationale behind *Illinois High School Association*, carried to its logical conclusion, rejects the principle of reverse confusion entirely. The holding apparently proceeds from the premise that the existence of a strong marketplace association between the junior user's product and the junior user's use of a trademark, regardless of how it came to exist, confers upon the junior user the right to use the mark. Since the junior user has that right (the argument goes), and so does the senior user, the purported trademark is no longer a unitary designator of origin, so it can't possibly be a protectable trademark at all, and therefore there's no need to reach the question of whether there's a likelihood of confusion. The problem with this argument is that any reverse-confusion fact pattern is invariably going to feature a strong association between the junior user's product and his use of the mark; that, after all, is the defining characteristic of reverse confusion. If that fact, without more, proves that there's no need to ask whether there's a likelihood of confusion — which is what *Illinois High School Association* seems to be saying — then there's never going to be an opportunity to apply the rule of *Sands, Taylor & Wood*. Surely that's a sufficiently absurd conclusion to suggest that there's something

89. See supra notes 72 and 73 and accompanying text
wrong with the premise.

IV
What's So Terrible About Dual Use?

If the Seventh Circuit's analysis in Illinois High School Association is widely adopted, it will undermine the social utility of trademark law in several fundamental ways.

First, and most profoundly, the entire concept of a dual-use trademark defenestrates the fundamental principle of trademark law that trademarks are supposed to be designations of unitary source, origin, sponsorship, or association,\(^9\) since a "dual-use" mark may identify several alternative sources for very similar goods or services. Such dual use will inevitably result in consumer confusion, and is therefore contrary to the goals of trademark protection.\(^{91}\)

On a practical level, the court fails to explain how the duties associated with trademark protection are to be allocated between the dual users.\(^{92}\) As noted above,\(^{93}\) trademark owners not only have the right to prevent unauthorized uses of their marks, they also have an obligation to enforce their rights against unauthorized commercial encroachment, in order to ensure that their marks continue to serve as non-confusing source identifiers.\(^{94}\) How does this work when there are two owners of the same mark? For example, if Abby and Bob are joint tenants\(^{95}\) of a dual-use mark, and Abby fails to enforce the mark against unauthorized users for long enough that the mark, under traditional law, becomes abandoned,

\(^{90}\) See supra notes 28 and 29 and accompanying text.


\(^{92}\) See Petition for Writ of Certiorari at 9.

\(^{93}\) See supra text accompanying notes 40-43.

\(^{94}\) See 2 McCarthy, supra note 42, § 17:17.

\(^{95}\) The conceptual analogy between joint tenancy and dual use of a trademark originates with Richard W. Young, counsel for IHSA. See Petition for Writ of Certiorari at 9. The term is intended to point up the distinction between dual use and concurrent use. Concurrent use arises when two users of a trademark avoid confusion between their products through either geographic separation or dissimilarity of the products. To carry Mr. Young's property analogy one step further, concurrent use might be thought of as "timesharing" a trademark: each owner has rights in the mark, but no owner may use it for the same purpose at the same time as another owner.
what rights remain to Bob? We are left to speculate.

To make matters worse, the trademark at issue in this case is licensed to third parties by both of its co-owners. For example, IHSA currently licenses the mark “March Madness” for use on Wilson basketballs, and it seems reasonable to suppose that NCAA may, under the dual-use doctrine, license the same mark to Spalding for a use on a different line of basketballs. This scenario would obviously give rise to a near certainty of consumer confusion as to the source of the basketballs, but it raises any number of other troubling questions as well. For example, could Spalding instead solicit offers from each dual user, and license the mark from the lowest bidder? Would Spalding’s use infringe IHSA’s mark? If a third manufacturer were to begin making “March Madness” basketballs without license from either IHSA or NCAA, which of the two would have the duty of incurring the expense and inconvenience of litigating to enjoin such use? Could either of them validly refute a laches defense by asserting that the other one should have defended the mark? Such issues will inevitably arise when the sourcing function of trademarks is abandoned, as it has been by the Seventh Circuit’s decision.

Furthermore, when the Seventh Circuit refers in the same breath to “dual-use or multiple-use terms,” it hints strongly that there is nothing special about duality, as opposed to 3-, 4-, or n-way divisions of trademark rights. It seems reasonable to suppose, for example, that if a group of sportscasters were to begin today referring to the National Basketball Association’s playoff games as “March Madness,” the Seventh Circuit would hold that this could ultimately confer on the NBA the right to license the term for use on

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96. This entire controversy arose because the NCAA licensed the mark to GTE Vantage. With regard to the IHSA’s licensing ventures, see supra note 17 and accompanying text.
97. See Petition for Writ of Certiorari at 4 n.2.
99. Those conversant with sports will instantly recognize the unlikely nature of this hypothetical, since the NBA playoffs in fact take place in April and May. This makes no difference to the underlying point, however. Nothing suggests that the multiple-use principle is limited to trademarks associated with particular times of year; it seems safe to suppose that the Seventh Circuit’s decision would have been the same if the disputed phrase had been, say, “Hoop Derangement” or “Net Insanity.”
mass-marketed team paraphernalia; in other words, that a
"triple-use trademark" could be created. The problems asso-
ciated with such a decision should be readily apparent. First,
of course, it is utterly at variance with the principle that
trademarks are supposed to identify a unitary source of the
good or service. More seriously, how many joint tenants
must inhabit the trademark before it becomes a generic term
for all basketball tournaments, and none of the users may
claim any property rights in it? The opinion gives us little
help in answering this question.

Finally, the Seventh Circuit's rejection of the Lucasfilm
dictum will inevitably have the effect of encouraging frivo-
lous litigation by trademark holders — "frivolous" in the
sense that these suits will of necessity be brought by plain-
tiffs who have no conceivable chance of prevailing, but who
bring them anyway in an attempt to protect their trademarks
from becoming "dual-use." Judge Posner himself concedes
that "IHSA could not have sued Musburger for referring to
'March Madness' in a news program (including a program of
sports news)." But he goes on to suggest that IHSA should
have sued CBS anyway, perhaps for using "March Madness"
to promote its broadcasts of the NCAA championship (de-
spite the apparent lack of any suggestion in the record that
CBS ever did so). "A serious trademark holder is assiduous in
endeavoring to convince... influential persons," including
those operating under First Amendment protection, to respect
the meaning of a trademark, and "[t]hese efforts sometimes
succeed." IHSA made no such doomed effort; hence, "IHSA
was not assiduous." The inescapable conclusion is that it is
immaterial whether these efforts succeed or not; what is im-

100. See supra notes 28 and 29 and accompanying text.
101. See supra notes 46-52 and accompanying text.
102. "To avoid the risk of losing rights in their marks, trademark owners
will be compelled to challenge, whether by economic influence, threat of suit, or
otherwise, the media's non-commercial, descriptive and fair uses of trademarks.
The Seventh Circuit's decision upsets the balance between the protection afforded
trademarks and the protection afforded non-commercial speech because it
compels mark owners to challenge the media in order to prevent a transfer of
their trademark rights." Petition for Writ of Certiorari at 10.
103. Ill. High Sch. Ass'n, 99 F.3d 244, 246.
104. Id.
105. Id.
106. Id.
important is that the trademark owner make them.

This cannot conceivably be sound social policy. It has long been recognized that "[the protection given speech and press was fashioned to assure unfettered interchange of ideas;]"\textsuperscript{107} surely the practice of penalizing otherwise unoffending trademark owners with the loss of valuable intellectual property rights for their failure to insist that journalists and the media refrain from interchanging certain ideas rises to a "fetter." Defending against a frivolous lawsuit— or even responding to a cease-and-desist letter with a well-justified refusal— are potentially expensive and time-consuming vexations to which there is absolutely no need to put the media in the interests of assuring that trademark holders meet formalistic standards of assiduity.

\textit{Lucasfilm} proposed a bright-line rule: "the use of [a trademark-protected term] in political propaganda, newspapers or noncommercial, non-trade references will not undermine plaintiff's exclusive property right to use it in connection with goods and services."\textsuperscript{108} The Seventh Circuit dimmed the line by rejecting the distinction between commercial and noncommercial expression. Under its decision, trademark owners must fear communicative, non-commercial uses of their marks as much as uses by competitors on competing products.

\textbf{V}

\textbf{Conclusion}

"The law of intellectual property does not sanction use of one . . . trademark by two competitors in the same market."\textsuperscript{109} In \textit{Illinois High School Association}, the Seventh Circuit ignored this fundamental principle. The opinion is probably best explained as an attempt to grant a partial victory to each side in a situation where the judge believed the equities to weigh equally — but this approach was misguided, for two reasons.


\textsuperscript{109} Durango Herald, Inc. v. Riddle, 719 F. Supp. 941, 951 (1988). "Although a word may have developed a meaning in a non-commercial, non-trade context, as long as it still functions in the commercial context to identify the good will of its source, it has meaning as a trademark and will be protected against confusingly similar commercial use." 1 \textit{Mccarthy}, supra note 42, § 3.2.
First and foremost, the equities did not weigh equally. NCAA was undisputedly the junior user of “March Madness,” and the first in time is generally considered to be first in right. Moreover, NCAA had no investment whatsoever in the mark, the public association between the phrase and NCAA’s tournament having arisen through the happy fortuity that the media made use of the phrase to describe the event. It seems untenable to suggest that IHSA’s right to control a trademark it undisputedly owned weighs equally with NCAA’s right to profit by licensing a term bestowed upon it by sportscasters.

Secondly, even if the equities had weighed equally, the invention of the so-called dual-use trademark would not have been the appropriate remedy. In a feat of judicial legerdemain reminiscent of King Solomon’s famous offer to divide the object of a dispute equally between the contending parties, Judge Posner entered a decree that, in effect, left both plaintiffs and defendants free to use the [disputed trademark]. Even if this result were fair as between the parties, it is not fair in respect to the public. It creates the very ‘source’ confusion that legal trademark... doctrine developed to avoid. When arguing parties are, in a sense, both responsible for the success of a name, a court may find it difficult to decide which, in fact, ‘owns’ the name; the temptation may be great to say “both own it” or try to ‘divide’ the name among them. The public interest, however, normally requires an exclusive award. Solomon’s judgment established his reputation as the wisest of judges, but that reputation might have been very different indeed if the baby had actually wound up in two pieces. The United States Supreme Court has declined one invitation to assume the role of the rightful mother in the Solomon story — that is, to speak out and resolve the issue. It is greatly to be hoped that if a second invitation is issued, it will be more hospitably received.

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110. See, e.g., G’s Bottoms Up Soc. Club v. F.P.M. Indus., Inc., 574 F. Supp. 1490, 1496 (S.D.N.Y. 1983) (“under the general rule of first in time, first in right... [the defendant] has the superior right to use the mark.”).