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"Sponsorship or Affiliation" Confusion

As the surveys at issue in *Smith v. Wal-Mart Stores* suggested, trademark law may find infringement when the defendant's conduct leads consumers mistakenly to believe that there is a relation of "sponsorship" or "affiliation" between the plaintiff and the defendant. In this excerpt from *Int'l Info. Sys. Sec. Certification Consortium, Inc. v. Sec. Univ.*, LLC, 823 F.3d 153 (2d Cir. 2016), the Second Circuit strongly endorsed this expansive understanding of what constitutes actionable consumer confusion.

[The opinion in *Int'l Info. Sys. Sec. Certification Consortium, Inc. v. Sec. Univ., LLC* is available separately.]

Questions and Comments

1. *"Signifier confusion" and "affiliation confusion."* Barton Beebe and Scott Hemphill propose the following:

> [I]t is helpful to distinguish between two fundamentally different and mutually exclusive forms of consumer confusion, which we term *signifier confusion* and *affiliation confusion*. Signifier confusion denotes those situations in which a consumer fails to detect the difference between two different marks and perceives each mark to be identical to the other. For example, a consumer may be exposed to the mark STARLUCKS and simply mistakenly read or hear the mark as STARBUCKS.
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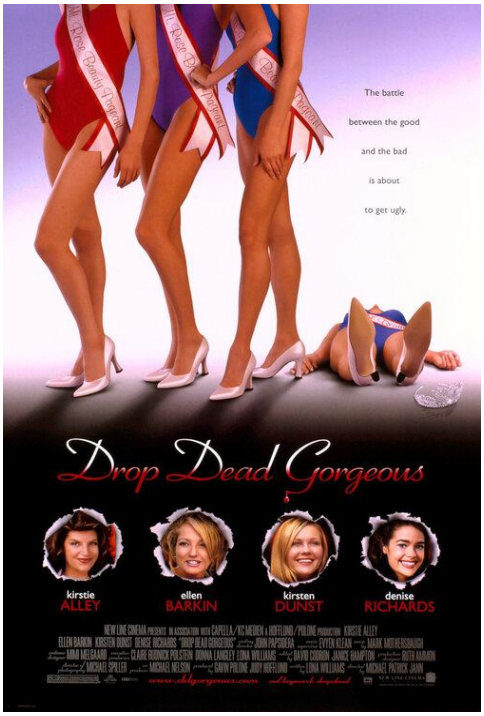
> By contrast, affiliation confusion denotes those situations in which a consumer detects the difference between two different marks (so there is no signifier confusion), but the consumer nevertheless concludes that due to the similarity of the marks, there must be some commercial connection between the users of the marks. For example, a consumer thinks STARLUCKS represents a brand extension, sponsorship or endorsement relationship, or some other form of commercial affiliation. The consumer perceives the plaintiff as the source of or somehow responsible for the defendant's goods.

Barton Beebe & C. Scott Hemphill, *The Scope of Strong Marks: Should Trademark Law Protect the Strong More Than the Weak?*, 93 N.Y.U. L. REV. 1339, 1361 (2017). Are these two forms of consumer confusion in fact mutually exclusive? Is this distinction helpful?

Trademark scholars have been highly critical of "sponsorship or affiliation" confusion. Presented below is an excerpt from Mark A. Lemley & Mark McKenna, *Irrelevant Confusion*, 62 STAN. L. REV. 413, 417–422 (2010), which collects some of the most egregious examples up to that time of plaintiffs' threats to sue and of courts' finding of "sponsorship or affiliation" confusion. In reading through Lemley & McKenna's account, consider the extent

to which trademark law should passively take consumer perceptions as given or proactively seek to shape those perceptions. In other words, should trademark law assert in some cases that as a descriptive matter it may well be that consumers are in fact confused as to source or affiliation by the defendant's conduct, but as a prescriptive matter they simply should *not* be? Should the law allow some degree of confusion in the short term so that consumers can learn in the long term not to be confused? And are federal judges and federal trademark litigation properly suited to this task? *See* Graeme B. Dinwoodie, Trade Mark Law as a Normative Project, [2023] SINGAPORE J. LEG. STUD. 305 ("courts need more openly – and more fully – to understand trade mark as a normative project"); Graeme B. Dinwoodie, *Trademark Law and Social Norms* (2006) (discussing courts' "reactive" and "proactive" approaches to the development of trademark law); Alfred C. Yen, *The Constructive Role of Confusion in Trademark Law*, 93 N.C. L. Rev. 77 (2014) (criticizing trademark law's absolute "eradicate confusion norm" and arguing that some degree of consumer confusion may encourage consumers to develop the cognitive skills needed to navigate complex marketplaces).



***From* Mark A. Lemley & Mark McKenna, *Irrelevant Confusion*, 62 STAN. L. REV. 413, 417-422 (2010)**

[1] In 2006, back when it was good, NBC's hit show *Heroes* depicted an indestructible cheerleader sticking her hand down a kitchen garbage disposal and mangling it (the hand quickly regenerated). It was an Insinkerator brand garbage disposal, though you might have

had to watch the show in slow motion to notice; the brand name was visible for only a couple of seconds. Emerson Electric, owner of the Insinkerator brand, sued NBC, alleging the depiction of its product in an unsavory light was both an act of trademark dilution and was likely to cause consumers to believe Emerson had permitted the use. NBC denied any wrongdoing, but it obscured the Insinkerator name when it released the DVD and Web versions of the episode.[8] And not just television shows but also movies have provoked the ire of trademark owners: Caterpillar sued the makers of the movie Tarzan on the theory that the use of Caterpillar tractors in the movie to bulldoze the forest would cause consumers to think Caterpillar was actually anti-environment,[9] and the makers of *Dickie Roberts: Former Child Star* were sued for trademark infringement for suggesting that the star of the absurdist comedy was injured in a Slip 'N Slide accident.[10] Even museums aren't immune: Pez recently sued the Museum of Pez Memorabilia for displaying an eight-foot Pez dispenser produced by the museum's owners.[11] And forget about using kazoos on your duck tours: Ride the Ducks, a tour company in San Francisco that gives out duck-call kazoos to clients on its ducks, sued Bay Quackers, a competing duck tour company that also facilitated quacking by its clients.[12]

[2] Most of these examples involve threats of suit, and they could be dismissed simply as overreaching by a few aggressive trademark owners. But these threats were not isolated incidents, and they shouldn't be quickly ignored. The recipients of all of these threats, like many others who receive similar objections,[13] knew well that they had to take the asserted

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[8] *See* Paul R. La Monica, *NBC Sued over 'Heroes' Scene by Garbage Disposal Maker*, CNNMoney.com, Oct. 17, 2006, http:// money.cnn.com/2006/10/17/commentary/ mediabiz/index.htm.

[9] Caterpillar Inc. v. Walt Disney Co., 287 F. Supp. 2d 913, 917 (C.D. Ill. 2003).

[10] Wham-O, Inc. v. Paramount Pictures Corp., 286 F. Supp. 2d 1254, 1255-58 (N.D. Cal. 2003).

[11] *Museum Faces Legal Battle over Giant Pez Dispenser*, KTVU.com, July 1, 2009, http://www.ktvu.com/print/19911637/detail.html. The museum was originally called the Pez Museum, but the owners changed the name in response to a previous objection from Pez.

[12] Jesse McKinley, *A Quacking Kazoo Sets Off a Squabble*, N.Y. TIMES, June 3, 2009, at A16. Ducks are open-air amphibious vehicles that can be driven on streets and operated in the water.

[13] The Chilling Effects Clearinghouse collects letters from trademark owners that make aggressive assertions of trademark (and other intellectual property) rights. See Chilling Effects Clearinghouse, http:// www.chillingeffects.org (last visited Sept. 9, 2009). As of February 25, 2009, the Chilling Effects database contained 378 such letters. Among the many specious objections are an objection from the National Pork Board (owner of the trademark "THE OTHER WHITE MEAT") to the operator of a breastfeeding advocacy site called "The Lactivist" for selling T-shirts with the slogan "The Other White Milk," *Pork Board Has a Cow over Slogan Parody*, Chilling Effects Clearinghouse, Jan. 30, 2007, http:// www.chillingeffects.org/trademark/notice.cgi?NoticeID=6418; from Kellogg to the registrant of the domain name "evilpoptarts.com," *Kelloggs Poops on Evilpoptarts.com*, Chilling Effects Clearinghouse, June 5, 2006, http:// www.chillingeffects.org/acpa/notice.cgi?NoticeID=4377; from Nextel to the registrants of the domain name "nextpimp.com," *Nextel Says "Don't Pimp My Mark"*, Chilling Effects Clearinghouse, June 22, 2005, http:// www.chillingeffects.org/acpa/notice.cgi?NoticeID=2322; and from the owners of the Marco Beach

claims seriously because courts have sometimes been persuaded to shut down very similar uses. In 1998, for instance, New Line Productions was set to release a comedy about a beauty pageant that took place at a farm-related fair in Minnesota. New Line called the movie *Dairy Queens* but was forced to change the name to *Drop Dead Gorgeous* after the franchisor of Dairy Queen restaurants obtained a preliminary injunction.[14] The owners of a restaurant called the "Velvet Elvis" were forced to change its name after the estate of Elvis Presley sued for trademark infringement.[15] A humor magazine called Snicker was forced to pull a parody "ad" for a mythical product called "Michelob Oily," not because people thought Michelob was actually selling such a beer (only six percent did[16]), but because a majority of consumers surveyed thought that the magazine needed to receive permission from Anheuser-Busch to run the ad.[17] And Snicker might face more trouble than that; another court enjoined a furniture delivery company from painting its truck to look like a famous candy bar.[18]

[3] The Mutual of Omaha Insurance Company persuaded a court to stop Franklyn Novak from selling T-shirts and other merchandise bearing the phrase "Mutant of Omaha" and depicting a side view of a feather-bonneted, emaciated human head.[19] No one who saw Novak's shirts reasonably could have believed Mutual of Omaha sold the T-shirts, but the court was impressed by evidence that approximately ten percent of all the persons surveyed thought that Mutual of Omaha "[went] along" with Novak's products.[20] The creators of Godzilla successfully prevented the author of a book about Godzilla from titling the book *Godzilla*, despite clear indications on both the front and back covers that the book was not authorized by the creators.[21]

[4] The Heisman Trophy Trust prevented a T-shirt company called Smack Apparel from selling T-shirts that used variations of the word HEISMAN, such as "HE.IS.the.MAN," to

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Ocean Resort to the operators of "urinal.net," a website that collects pictures of urinals in various public places, for depicting urinals at the Resort and identifying them as such, *Mark Owner Pissed About Urinals*, Chilling Effects Clearinghouse, Jan. 4, 2005, http://www.chillingeffects.org/trademark/notice.cgi?NoticeID=1576.

[14] Am. Dairy Queen Corp. v. New Line Prods., Inc., 35 F. Supp. 2d 727, 728 (D. Minn. 1998).

[15] Elvis Presley Enters., Inc. v. Capece, 141 F.3d 188 (5th Cir. 1998)

[16] Anheuser-Busch, Inc. v. Balducci Publ'ns, 28 F.3d 769, 772-73 (8th Cir. 1994). That any consumers were confused was remarkable, and perhaps a statement about the reliability of consumer confusion surveys rather than the stupidity of 6% of the population.

[17] *Id*.

[18] Hershey Co. v. Art Van Furniture, Inc., No. 08-14463, 2008 WL 4724756 (E.D. Mich. Oct. 24, 2008). Hershey has also sued Reese's Nursery. Complaint at 1, Hershey Chocolate & Confectionery Corp. v. Reese's Nursery and Landscaping, No. 3:09-CV-00017-JPB (N.D. W. Va. Mar. 19, 2009).

[19] Mutual of Omaha Ins. Co. v. Novak, 836 F.2d 397, 397 (8th Cir. 1987).

[20] *Id*. at 400.

[21] See Toho Co. v. William Morrow & Co., 33 F. Supp. 2d 1206, 1206, 1212 (C.D. Cal. 1998).

promote particular players for the Heisman Trophy.[22] This was not Smack Apparel's first trademark lesson: a court previously ordered it to stop selling T-shirts that used university colors and made oblique references to those universities' football teams because the court believed the designs created "a link in the consumer's mind between the T-shirts and the Universities" and demonstrated that Smack Apparel "inten[ded] to directly profit [from that link]."[23] Respect Sportswear was denied registration of "RATED R SPORTSWEAR" for men's and women's clothing on the ground that consumers would be confused into thinking the Motion Picture Association of America sponsored the clothes.[24] A street musician who plays guitar in New York while (nearly) naked was permitted to pursue his claim against Mars on the theory consumers would assume he sponsored M&Ms candies, since Mars advertised M&Ms with a (naked) blue M&M playing a guitar.[25] A legitimate reseller of dietary supplements lost its motion for summary judgment in a suit by the supplements' brand owner because the court concluded the reseller might have confused consumers into thinking it was affiliated with the brand owner when it purchased ad space on Google and truthfully advertised the availability of the supplements.[26] Amoco persuaded a court that consumers might believe it sponsored Rainbow Snow's sno-cones, mostly because Rainbow Snow's shops were located in the same area as some of Amoco's Rainbo gas stations.[27] The National Football League successfully sued the state of Delaware for running a lottery based on point spreads in NFL games, even though the Lottery never used the NFL name or any of its marks for the purpose of identifying or advertising its games.[28] The court

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[22] Heisman Trophy Trust v. Smack Apparel Co., No. 08 Civ. 9153(VM), 2009 WL 2170352, at *5 (S.D.N.Y. July 17, 2009). Smack Apparel produced several such T-shirts, including one that substituted the number 15 for "IS" in the word HEISMAN and was printed in the colors of the University of Florida, clearly to promote Florida quarterback Tim Tebow's candidacy. *See* Smack Apparel Lawsuit, LSU Tiger Tailer Newsletter (LSU Trademark Licensing, Baton Rouge, La.), Jan. 30, 2009, at 6.

[23] Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co., 550 F.3d 465, 484 (5th Cir. 2008).

[24] Motion Picture Ass'n of Am. Inc. v. Respect Sportswear Inc., 83 U.S.P.Q.2d (BNA) 1555, 1564 (T.T.A.B. 2007).

[25] Burck v. Mars, Inc., 571 F. Supp. 2d 446 (S.D.N.Y. 2008) (denying Mars' motion to dismiss plaintiff's false endorsement claim).

[26] Standard Process, Inc. v. Total Health Discount, Inc., 559 F. Supp. 2d 932, 941 (E.D. Wis. 2008).

[27] Amoco Oil Co. v. Rainbow Snow, 748 F.2d 556, 559 (10th Cir. 1984). Rainbow Snow sold its snow cones from fourteen round, ten-by-six-foot booths, which were blue with a 180-degree, red-orange-yellow-green rainbow appearing on the upper half of the face of the booth and prominently displayed the name "Rainbow Snow" in white letters below the rainbow. Id. at 557. Signs at Amoco's Rainbo gas stations displayed the word "Rainbo" in white, with the word appearing against a black background and below a red-orange-yellow-blue truncated rainbow logo. *Id*.

[28] NFL v. Governor of Del., 435 F. Supp. 1372, 1376, 1380-81 (D. Del. 1977). The lottery game was called "Scoreboard" and the individual games were identified as "Football Bonus," "Touchdown," and "Touchdown II." *Id*. at 1380.

was persuaded that the betting cards' references to NFL football games by the names of the cities whose teams were playing might cause consumers to believe the NFL sponsored the lottery game.[29] And the owners of a Texas golf course that replicated famous golf holes from around the world were forced to change their course because one of the holes was, in the view of the Fifth Circuit, too similar to the corresponding South Carolina golf hole it mimicked.[30]

[5] Whatever fraction of the total universe of trademark cases these cases constitute, there are enough of them that recipients of cease and desist letters from mark owners have to take the objections seriously. Indeed many simply cave in and change their practices rather than face the uncertainty of a lawsuit. The producers of the TV show *Felicity* changed the name of the university attended by characters on the show after New York University, the school originally referenced, objected to the depiction of those students as sexually active.[31] The producers of a movie originally titled *Stealing Stanford* changed the title of their movie after Stanford University objected to the movie's storyline, which centered on a student who stole money to pay tuition.[32] It's possible that the producers of the show and the movie would have had legitimate defenses had they decided to use the real universities' names despite the objections, but in light of the case law outlined above, neither was willing to defend its right to refer to real places in their fictional storylines.[33] And anecdotes like these are becoming depressingly common. Production of the film *Moneyball*, which was based on Michael Lewis's best-selling profile of Oakland Athletics General Manager Billy Beane, was halted just days before shooting was set to begin in part because Major League

[29] The cards on which the customers of the Delaware Lottery marked their betting choices identified the next week's NFL football games by the names of the cities whose NFL teams were scheduled to compete against each other (e.g., Washington v. Baltimore). *Id*. The parties stipulated that, in the context in which they appeared, these geographic names were intended to refer to, and consumers understood them to refer to, particular NFL football teams. Id. This was enough for the court to find sponsorship or affiliation confusion because, "[a]pparently, in this day and age when professional sports teams franchise pennants, teeshirts, helmets, drinking glasses and a wide range of other products, a substantial number of people believe, if not told otherwise, that one cannot conduct an enterprise of this kind without NFL approval." *Id*. at 1381. The court therefore entered a limited injunction "requiring the Lottery Director to include on Scoreboard tickets, advertising and any other materials prepared for public distribution a clear and conspicuous statement that Scoreboard [was] not associated with or authorized by the National Football League." *Id*.

[30] Pebble Beach Co. v. Tour 18 I Ltd., 155 F.3d 526, 526 (5th Cir. 1998).

[31] Sara Lipka, *PG-13? Not This College. Or That One. Or . . .*, CHRON. HIGHER EDUC., June 26, 2009, at 1; William McGeveran, *Trademarks, Movies, and the Clearance Culture*, Info/Law, July 2, 2009, http://blogs.law.harvard.edu/infolaw/2009/07/02/tm-movie-clearance/.

[32] McGeveran, *supra*. Apparently Harvard was less troubled about a student being depicted as having stolen money to pay its tuition: the movie was retitled *Stealing Harvard*.

[33] *See also* Vince Horiuchi, *HBO Disputes Trademark Infringement in 'Big Love*,' SALT LAKE TRIB., July 8, 2009 (discussing a lawsuit filed by the University of Utah over the three-second depiction of a fictional research report bearing the University of Utah logo).

Baseball disapproved of the script's depiction of baseball and therefore objected to use of its trademarks in the film.[34] Apparently Major League Baseball believes it can control the content of any film that refers to real baseball teams.

[6] What unifies all the cases that have given these creators such pause is that courts found actionable confusion notwithstanding the fact that consumers couldn't possibly have been confused about the actual source of the defendants' products . . . .

Though many of the examples provided in the Lemley & McKenna excerpt show severe overreach by trademark owners, there are of course counterexamples in which most would agree that trademark owners should have every right to seek to prevent association or affiliation confusion. For example, consumers might care strongly about whether a company is truthfully declaring itself to be an "Official Sponsor of the United States Olympic Team" or an "Official Sponsor of the United States Women's National Team."

In the following case, *Board of Supervisors for Louisiana State University Agricultural & Mechanical College v. Smack Apparel Co.*, 550 F.3d 465 (5th Cir. 2008), parts of which were excerpted in Part I.A.1.b, the Fifth Circuit addressed the argument that consumers do not care if the merchandise they purchase is authorized. The plaintiffs Louisiana State University, the University of Oklahoma, Ohio State University, the University of Southern California, and Collegiate Licensing Company (the official licensing agent for the universities) brought suit against defendant Smack Apparel for its unauthorized sale of apparel bearing the universities' colors and various printed messages associated with the universities. The Eastern District of Louisiana granted the plaintiffs' motion for summary judgment on the issue of trademark infringement. The Fifth Circuit affirmed. Excerpted here is the Fifth Circuit's discussion of sponsorship confusion and whether consumers prefer authorized merchandise in certain situations. Do you find it persuasive?

Note that the apparel at issue, further examples of which are given below, did not bear the universities' full names or mascots.

[The opinion in *Board of Supervisors for Louisiana State University Agricultural & Mechanical College v. Smack Apparel Co.* is available separately.]

Questions and Comments

1. *Materiality and Consumer Confusion*. How might courts constrain the enormous expansion of "sponsorship or affiliation" confusion? Lemley & McKenna:

> [W]e argue that courts can begin to rein in some of these excesses by focusing their attention on confusion that is actually relevant to purchasing decisions.

[34] Michael Cieply, *Despite Big Names, Prestige Film Falls Through*, N.Y. TIMES, July 2, 2009, at B1.

> Uses of a trademark that cause confusion about actual source or about responsibility for quality will often impact purchasing decisions, so courts should presume materiality and impose liability when there is evidence such confusion is likely. Uses alleged to cause confusion about more nebulous relationships, on the other hand, are more analogous to false advertising claims, and those uses should be actionable only when a plaintiff can prove the alleged confusion is material to consumers' decision making.

Mark A. Lemley & Mark McKenna, *Irrelevant Confusion*, 62 STAN. L. REV. 413, 416 (2010).

2. *The "Circularity" Problem in Trademark Law*. Trademark commentators have long identified a fundamental problem with basing the subject matter and scope of trademark rights on consumer perception. The problem is that consumer perception is itself based at least in part on what the law allows to occur in the marketplace—and even more problematically, on what consumers *think* the law allows to occur in the marketplace. McCarthy explains:

> Th[e] reality of modern brand extensions raises the "circularity" question. If consumers think that most uses of a trademark require authorization, then in fact they will require authorization because the owner can enjoin consumer confusion caused by unpermitted uses or charge for licenses. And if owners can sue to stop unauthorized uses, then only authorized uses will be seen by consumers, creating or reinforcing their perception that authorization is necessary. This is a "chicken and the egg" conundrum. Which comes first? The trademark right on far-flung items or the license? Licensing itself may affect consumer perception if consumers see a plethora of items with the mark perhaps accompanied by an "authorized by" label.

MCCARTHY § 24:9. *See also* Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1708 (1999) ("Ironically, having accepted the merchandising rationale for certain sorts of trademarks, we may find it hard to undo. It is possible that consumers have come to expect that "Dallas Cowboys" caps are licensed by the Cowboys, not because they serve a trademark function, but simply because the law has recently required such a relationship. If this expectation exists, consumers may be confused if the law changes."). *Cf. Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, 58 F.3d 1498, 1509 (10th Cir. 1995) ("We recognize also that consumer confusion resulting from the copying of product features is, in some measure, a self-fulfilling prophecy. To the degree that useful product configurations are protected as identifiers, consumers will come to rely on them for that purpose, but if copying is allowed, they will depend less on product shapes and more on labels and packaging.").

3. *"Secondary source."* Trademark lawyers sometimes speak of the entity referenced on merchandise (such as apparel) as the "secondary source" of the merchandise:

> The "ornamentation" of a T-shirt can be of a special nature which inherently tells the purchasing public the source of the T-shirt, not the source of manufacture but the secondary source. Thus, the name "New York University" . . . , albeit it will serve as ornamentation on a T-shirt will also advise the purchaser that the university is the secondary source of that shirt. It is not imaginable that Columbia University will be the source of an N.Y.U. T-shirt. Where the shirt is distributed by other than the university the university's name on the shirt will indicate the sponsorship or authorization by the university.

In Re Olin Corp., 181 U.S.P.Q. 182, 1973 WL 19761 (TTAB 1973).

4. *Trademark rights in fictional elements of expressive works?* In *Lucasfilm Ltd. LLC v. Ren Ventures Ltd*., No. 17 Civ. 07249, 2018 WL 2392963 (N.D. Cal. Apr. 24, 2018), the defendants produced a mobile game app entitled "Sabacc—The High Stakes Card Game," which was based on the card game Sabacc described in several novels from the fictional *Star Wars* universe (and which was featured in the *Star Wars* film *Solo: A Star Wars Story*). The plaintiff asserted trademark rights in the name. In denying the defendants' motion to dismiss, the Northern District of California cited several previous cases in which courts recognized trademark rights in fictional elements of expressive works:

> Defendants next contend that the name of a fictional good or service in an expressive work does not function as a mark for the expressive work in which the fictional good or service appears. On the contrary, courts have long held that fictional elements of expressive works can function as trademarks when those elements symbolize the plaintiff or its product to the consuming public. *See DC Comics, Inc. v. Filmation Assocs.*, 486 F. Supp. 1273, 1277 (S.D.N.Y. 1980). Following this principle, courts have extended trademark protection to the "General Lee" car from the television series "The Dukes of Hazzard," *see Warner Bros., Inc. v. Gay Toys, Inc.*, 658 F.2d 76, 78 (2d Cir. 1981), the fictional restaurant "The Krusty Krab" from the "SpongeBob SquarePants" television series, *see Viacom Int'l Inc. v. IJR Capital Invs., LLC*, 242 F. Supp. 3d 563, 569 (S.D. Tex. 2017), the "Hobbit" characters from J.R.R. Tolkien's works, *see Warner Bros. Entm't v. Glob. Asylum, Inc.*, No. CV 12-9547, 2012 WL 6951315 at *3-5 (C.D. Cal. Dec. 10, 2012), the fictional element "Kryptonite" associated with Superman comics, *see DC Comics v. Kryptonite Corp.*, 336 F. Supp. 2d 324, 332, 35 (S.D.N.Y. 2004), and the physical appearance of the E.T. character from its titular motion picture film, *see Universal City Studios, Inc. v. J.A.R. Sales, Inc.*, No. 82-4892, 1982 WL 1279 at *4 (C.D. Cal. Oct. 20, 1982).
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> In the face of this weight of authority, defendants point to several administrative decisions from the Trademark Trial and Appeal Board (TTAB) where the Board refused to recognize certain fictional elements as being trademarks. *See* Mot. to Dismiss at 17-18. Yet these decisions merely suggest

> that fanciful elements do not *always* function as marks for the expressive works in which they appear, not that they may *never* do so. For example, in *Paramount Pictures Corp. v. Romulan Invasions*, 7 U.S.P.Q.2d 1897 (T.T.A.B. Mar. 31, 1988), Paramount sought to enjoin a rock band from registering "The Romulans" as the group's name, on the grounds that "Romulans" are a fictional alien race appearing in the *Star Trek* franchise. While the Board provided no explanatory reasoning for its conclusion that Paramount's use of the name did not confer trademark rights, a reasonable consumer would not likely assume the rock band was affiliated with the *Star Trek* franchise on account of its name alone. Thus, the Board concluded Paramount's use of "Romulans" should not preclude registration of the rock band's name.

Lucasfilm Ltd. LLC, 2018 WL 2392963, at *3–4. *See also* Lisa Pearson, *The Real Life of Fictional Trademarks*, 100 TRADEMARK REP. 839 (2020).