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FUNCTIONALITY UNANIMOUSLY TRUMPS INCONTESTABILITY AFTER TRADEMARK LAW TREATY ACT AND WILHELM PUDENZ V. LITTLEFUSE, INC.: NEXT REPLACE MISNOMER "INCONTESTABLE" WITH "CONCLUSIVE"

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I. INTRODUCTION

Last year, the Eleventh Circuit decided the issue of whether the functionality defense was available in an infringement action based on an incontestable trademark registration for plug-in blade fuses for cars.^{40_IDEA_473)_and_footnotes(n1);FTNT n1} The trademark infringement case of Wilhelm Pudenz v. Littlefuse, Inc. centered on the validity of Littlefuse's incontestable trademark registrations on certain trade dress features, which contained utilitarian or functional characteristics.^{40_IDEA_473)_and_footnotes(n2);FTNT n2} However, the functionality defense, asserted by Wilhelm Pudenz, had never been expressly written into any provision of the Trademark Act of 1946 (the "Lanham Act").^{40_IDEA_473)_and_footnotes(n3);FTNT n3}

While the Pudenz litigation was pending, Congress unanimously passed the Trademark Law Treaty Implementation Act ("TLT Act"),^{40_IDEA_473)_and_footnotes(n4);FTNT n4} which expressly enumerated functionality as a defense against the infringement of incontestable trademark registrations.^{40_IDEA_473)_and_footnotes(n5);FTNT n5} The Pudenz court therefore faced the difficult question of whether functionality could invalidate an incontestable registration prior to the passage of the TLT Act. Although there was precedent that

cumulatively argued against such broad statutory construction,^{40_IDEA_473)_and_footnotes(n6);FTNT n6} the court wisely reached outside of the Lanham Act to find a defense within Article I, section 8, clause 8 of the United States Constitution.^{40_IDEA_473)_and_footnotes(n7);.FTNT n7} Thus, by applying the principles of the Constitution's patent clause, the Pudenz court craftily determined that functionality could provide a defense to incontestable trademark registrations, just as the TLT Act provided this same defense statutorily.

Legislatively, this article tracks and analyzes the TLT Act's technical corrections to the Lanham Act, focusing specifically on the enumeration of the functionality defense to trademark incontestability. Judicially, this work retrospectively evaluates the functionality cases leading up to and culminating in Pudenz. The final section reviews the current state of the functionality defense to the infringement of incontestable marks in civil cases commenced both before,^{40_IDEA_473)_and_footnotes(n8);.FTNT n8} and after, the October 30, 1998 enactment of the TLT Act.^{40_IDEA_473)_and_footnotes(n9);.FTNT n9}

With the enumeration of yet another defense to incontestability now in place, just how far does the scope of an incontestable mark extend today? Can an incontestable registration ever substantively be incontestable, as the label suggests? Following the legislative analysis, the author addresses these issues and proposes that the next technical revision should replace the misleading incontestable label with the more appropriate evidentiary term, conclusive. Such an amendment would provide the intellectual property community, as well as the general public, with a simple and concise nomenclature, denoting the two-class evidentiary status for the validity of trademarks listed on the principal register as either: 1) prima facie; or 2) conclusive.

II. FUNCTIONALITY DOCTRINE ENUMERATED AMONG TRADITIONAL DEFENSES TO REGISTRATION INCONTESTABILITY

A. The Trademark Law Treaty Implementation Act

The revisions of the Trademark Law Treaty Implementation Act to the Lanham Act were integrated primarily to bring greater conformity between U.S. Trademark Law and analogous law throughout the world.^{40_IDEA_473)_and_footnotes(n10);.FTNT n10} The International Trademark Association ("INTA") indicated strong support for the United States. adoption of legislation to implement the Trademark Law Treaty.^{40_IDEA_473)_and_footnotes(n11);.FTNT n11} As one of the major supporters of the bill, INTA proclaimed the Trademark Law Treaty and Madrid Protocol as "critical to the success of U.S. companies as they operate in the rapidly expanding and ever increasingly competitive global marketplace."^{40_IDEA_473)_and_footnotes(n12);.FTNT n12} In the House of Representatives, INTA lobbied for the objectives of the Trademark Law Treaty before the Subcommittee on Courts and Intellectual Property, stating:

The myriad of requirements and formalities of more than 200 trademark jurisdictions around the world impose horrendous costs in time and money for trademark owners, not to mention the reams of paperwork they generate The TLT's objective is to streamline and harmonize trademark office procedures, thus enabling U.S. trademark

owners and practitioners to focus on the protection and defense of marks
Implementation of the TLT will require relatively minor, noncontroversial amendments
to the Lanham Act.^{40_IDEA_473)_and_footnotes(n13);.FTNT n13}

Noting that the TLT Act included twelve specific revisions to the Lanham Act,
characterized as technical corrections,^{40_IDEA_473)_and_footnotes(n14);.FTNT n14}
the INTA further testified to the House Subcommittee:

We note, Mr. Chairman, that the TLT implementing legislation includes provisions
that are not required by the treaty itself, but are in the nature of technical or housekeeping
changes to the Lanham Act. With that in mind, we urge the Subcommittee also to include
an additional amendment to the Lanham Act that would make clear that incontestable
registrations are subject to cancellation on grounds of functionality and that functionality
may be asserted as a defense to an infringement suit involving an incontestable
registration. We believe these proposed amendments are necessary in view of recent
court decisions.^{40_IDEA_473)_and_footnotes(n15);.FTNT n15}

As the legislation neared enactment in the fall of 1998, the substance of and support
for The Technical Corrections Bill was presented before the Senate:

The most important of these amendments addresses the status of "functional" shapes
as trademarks. Functional shapes are those whose features are dictated by utilitarian
considerations. Under current law, the registration as a trademark of a functional shape
becomes "incontestable" after five years even though it should never have been registered
in the first place. S. 2192 would correct this anomaly by adding functionality as a ground
of cancellation of a mark at any time. The U.S. Patent and Trademark Office, the
International Trademark Association, and the American Intellectual Property Law
Association all support the trademark technical corrections bill. To date, I have not heard
any opposition to this amendment.^{40_IDEA_473)_and_footnotes(n16);.FTNT n16}

This article focuses solely on these technical revisions, and particularly on the
technical revisions to § S § S 14 and 33 of the Lanham
Act,^{40_IDEA_473)_and_footnotes(n17);.FTNT n17} which allow functionality to serve
as both a defense to infringement and as a basis for cancellation of incontestable
registrations.^{40_IDEA_473)_and_footnotes(n18);.FTNT n18}

In 1993, the Fourth Circuit, in *Shakespeare Co. v. Silstar Corp. of
America*,^{40_IDEA_473)_and_footnotes(n19);.FTNT n19} narrowly construed the
incontestability provisions as immune from cancellation for functional
reasons.^{40_IDEA_473)_and_footnotes(n20);.FTNT n20} Thereafter, the trademark
community was put on notice that the Lanham Act needed to expressly include a
provision for cancellation due to functionality to prevent monopolies on functional
incontestable marks.^{40_IDEA_473)_and_footnotes(n21);.FTNT n21} However, it has
taken over fifty years since the enactment of the Lanham Act for Congress to finally

codify the functionality doctrine as "an explicit ground for ex parte rejection, a ground for cancellation of registration and a statutory defense to an incontestably registered mark."^{40_IDEA_473)_and_footnotes(n22);FTNT n22} A passage by Professor McCarthy clarifies the reasoning behind the functionality revision:

There are two rationales underlying the functionality bar: (1) accommodation to the important principle of free competition that there is only one legal source of exclusive rights in utilitarian features -- utility patent law; and (2) preserving free and effective competition by ensuring that competitors can copy features that they need to "compete effectively."^{40_IDEA_473)_and_footnotes(n23);FTNT n23}

The technical changes promulgated by the TLT Act were necessary to prevent future literal interpretations of the incontestability provisions, as construed by the Shakespeare court.^{40_IDEA_473)_and_footnotes(n24);FTNT n24} A recent Supreme Court case, *Qualitex Co. v. Jacobson Products Co.*,^{40_IDEA_473)_and_footnotes(n25);FTNT n25} intimated the same concern stating: "the functionality doctrine prevents trademark law . . . from instead inhibiting legitimate competition by allowing a producer to control a useful product feature."^{40_IDEA_473)_and_footnotes(n26);FTNT n26}

Following over a year of uncontested movement through both the House and Senate, the TLT Act finally implemented the technical corrections needed to clarify this crucial balance between patent and trademark law.^{40_IDEA_473)_and_footnotes(n27);FTNT n27} Among the most notable corrections included in the TLT Act were four specific revisions expressly enumerating functionality as a tool for rejecting trademark rights in primarily functional features.^{40_IDEA_473)_and_footnotes(n28);FTNT n28} Two of these four revisions directly affect incontestable marks:^{40_IDEA_473)_and_footnotes(n29);FTNT n29} 1) section 201(a)(4) pertains to the cancellation of incontestable registrations due to functionality;^{40_IDEA_473)_and_footnotes(n30);FTNT n30} and 2) section 201(a)(9) provides functionality as a defense to infringement of incontestable registrations.^{40_IDEA_473)_and_footnotes(n31);FTNT n31}

B. Revising the Extent of Trademark Registration Incontestability Rights Under the Lanham Act

It is important to begin with an overview of the provisions of the trademark law which are relevant to the analysis of functional incontestable trademark registrations pursuant to the TLT Act and *Pudenz*. The law of trademarks has existed largely to promote the goodwill associated with goods in society's competitive markets.^{40_IDEA_473)_and_footnotes(n32);FTNT n32} Thus, for a mark to be registered on the principal register, it must actually be used to distinguish the origin of one good from another.^{40_IDEA_473)_and_footnotes(n33);FTNT n33}

However, occasionally a distinguishing or identifying feature constitutes an aspect of the product's trade dress,^{40_IDEA_473)_and_footnotes(n34);FTNT n34} as was the case with the goods at issue in *Pudenz*.^{40_IDEA_473)_and_footnotes(n35);FTNT n35} Features of trade dress may be protected under the trademark laws if they serve to

identify and distinguish the owner's goods in commerce, unless such protection is contrary to § 2 of the Lanham Act.^{40 IDEA 473) and footnotes(n36);FTNT n36} Furthermore, a "device . . . that does not primarily serve to distinguish and identify the goods, is ineligible for registration."^{40 IDEA 473) and footnotes(n37);FTNT n37} A trademark, even one cloaked inside a product trade dress, must meet these registration qualifications and pass the period for opposition while printed in the Official Gazette.^{40 IDEA 473) and footnotes(n38);FTNT n38} Once satisfied, the mark may be registered on the principal register with a prima facie presumption of validity.^{40 IDEA 473) and footnotes(n39);FTNT n39}

Following five years on the principal register, an elevated level of trademark protection may be attained by submitting an affidavit with the Patent and Trademark Office.^{40 IDEA 473) and footnotes(n40);FTNT n40} Upon acceptance, (this remains unchanged after the TLT Act technical amendments,) § 15 of the Lanham Act grants these marks a heightened status, referred to as incontestability.^{40 IDEA 473) and footnotes(n41);FTNT n41} Thereafter, "these incontestability provisions allow a 'registrant to quiet title in the ownership of his mark. . . thus encouraging producers to cultivate the goodwill associated with a particular mark."^{40 IDEA 473) and footnotes(n42);FTNT n42} However, as the Shakespeare dissent noted:

This property metaphor is a common one, with incontestability often being compared to adverse possession -both establish title through lack of opposition. The failure to contest ownership waives an attack on title to real property; it does not, however, create property in that which is not subject to ownership. By the same token, the fact that title in a trademark is quieted does not imply that the value of that title has somehow increased. If title to a trademark was useless at the outset, as is title to a trademark in a functional feature, it remains so even if conclusively established.^{40 IDEA 473) and footnotes(n43);FTNT n43}

Historically, under § 33 of the Lanham Act,^{40 IDEA 473) and footnotes(n44);FTNT n44} there had been numerous express defenses to trademarks that had gained incontestable status under § 15.^{40 IDEA 473) and footnotes(n45);FTNT n45} However, under the Lanham Act, functionality was not considered a valid defense, either expressly or impliedly.^{40 IDEA 473) and footnotes(n46);FTNT n46} In fact, even the broadest reading of the Lanham Act and the relevant incontestability provisions failed to impute grounds to invalidate an incontestable mark with wholly functional features.^{40 IDEA 473) and footnotes(n47);FTNT n47} Following the enactment of the TLT Act, however, a trademark may not be registered on the principle register when it "comprises any matter that, as a whole, is functional."^{40 IDEA 473) and footnotes(n48);FTNT n48}

The owner of an incontestable registration challenged on functional grounds prior to the TLT Act enactment could argue, as in Shakespeare, that functionality is not a ground for cancellation, or even a defense to infringement for that

matter.^{40 IDEA 473) and footnotes(n49);.FTNT n49} This would allow an incontestable mark to remain on the principal register even with functional features. However, because the *Pudenz* case was commenced prior to the passage of the TLT Act, there is strong precedence for denying rights to functional incontestable marks, registered prior to the TLT Act, even without the express denial of such rights in the Lanham Act.

C. Balancing Patent and Trademark Law: The Functionality Doctrine

Traditionally, protecting functional or utilitarian features has been exclusively the domain of patent law.^{40 IDEA 473) and footnotes(n50);.FTNT n50} The functionality doctrine helps define the contours of the junction between the patent and trademark laws. This doctrine is a judicially created rule that predates the Lanham Act.^{40 IDEA 473) and footnotes(n51);.FTNT n51} "Under this rule, no trademark rights may be claimed in a product's functional shapes or features."^{40 IDEA 473) and footnotes(n52);.FTNT n52} Specifically, the functionality doctrine governs trademark law by allowing protection for a "shape, configuration, design, or color" only if it is non-functional.^{40 IDEA 473) and footnotes(n53);.FTNT n53} Thus, a primarily or wholly functional device is not to be registered as a trademark.^{40 IDEA 473) and footnotes(n54);.FTNT n54} The grant of such a registration would not only register a trademark, but also exclude others indefinitely from selling goods bearing the same functional feature. Thus, trademark registration would be converted into something approximating perpetual patent protection.^{40 IDEA 473) and footnotes(n55);.FTNT n55}

Functionality exists if a design or color is so superior to available alternatives that competition would be hindered by giving the first user exclusive rights.^{40 IDEA 473) and footnotes(n56);.FTNT n56} Therefore, primarily functional features are only to be protected through patent law, since upon expiration of a patent, the utilitarian features enter the public domain.^{40 IDEA 473) and footnotes(n57);.FTNT n57}

A holding that product configurations are protectable both by patent and by trademark law would have a significant effect on manufacturers and consumers. If manufacturers receive trademark protection for a patented product configuration, they receive an exclusive right to that configuration forever, in contrast to the twenty years of protection that patent law provides. This would defeat the patent law goals of fostering competition and encouraging invention.^{40 IDEA 473) and footnotes(n58);.FTNT n58}

Patent law is based on the premise that novel functional features of a product are to be protected through a limited duration patent, and not through a perpetually renewable trademark.^{40 IDEA 473) and footnotes(n59);.FTNT n59} Essentially, where the "feature gives the product more utility, or contributes to economy of manufacture, the features are 'functional' and are not capable of legal trademark protection."^{40 IDEA 473) and footnotes(n60);.FTNT n60} Furthermore, no exclusive rights to functional features may be granted through trademark law protection, following the expiration of a patent.^{40 IDEA 473) and footnotes(n61);.FTNT n61} After all, the

public owns all rights to these utilitarian attributes after the expiration of the patent term.^{40_IDEA_473)_and_footnotes(n62);FTNT n62} This policy eliminates the possibility of identifying and distinguishing goods based on wholly functional features.^{40_IDEA_473)_and_footnotes(n63);.FTNT n63} Such a practice would create a potential monopoly in the utility of goods.^{40_IDEA_473)_and_footnotes(n64);.FTNT n64} Even from a broader economic standpoint,

some products -- because of popularity, novelty, extensive advertising, or other causes -- acquire secondary meaning not only for an identifying feature, but also for a useful or "functional" feature. If trademark law protected these features, the original producer would be able to establish a monopoly in useful goods. The "functionality" doctrine protects consumers from such monopolies by allowing competitors to copy functional features of a product, even if the features have secondary meaning.^{40_IDEA_473)_and_footnotes(n65);.FTNT n65}

Prior to the October 1998 changes to the Lanham Act, there were eight traditional defenses to an incontestable trademark.^{40_IDEA_473)_and_footnotes(n66);.FTNT n66} Essentially, § 33 of the Lanham Act^{40_IDEA_473)_and_footnotes(n67);.FTNT n67} subjected incontestable registrations to the following defenses or defects: 1) Fraud in obtaining the registration or the status of incontestability; 2) Abandonment; 3) Use of the mark to misrepresent the source; 4) "Fair use" of the mark; 5) Limited territory defense of an intermediate junior user; 6) Prior registration of defendant; 7) Use of the mark to violate antitrust law; or 8) Equitable defenses such as laches, estoppel and acquiescence.^{40_IDEA_473)_and_footnotes(n68);.FTNT n68}

However, with the TLT Act changes to § 33 of the Lanham Act, an age-old defense to monopolies on utilitarian features has found express statutory language as the ninth exception to incontestability.^{40_IDEA_473)_and_footnotes(n69);.FTNT n69} The TLT Act echoed the separation between patent and trademark law by further denying rights in functional trademarks. Through remedial action long overdue, the TLT Act enumerated the judicial doctrine of functionality into statutory law so that trademark law could not unwittingly undermine the limitations of patent law. Pudenz persuasively drove this policy home, crafting that

the job of working out this balance is given to patent law, and not trademark law. Consequently, when the operation of the Lanham Act would upset this balance struck by the Patent Act, the Lanham Act must yield. The functionality doctrine serves this purpose by eliminating the possibility of perpetual exclusive right to the utilitarian features of a product under trademark law, which would be impossible (as well as unconstitutional) under the Patent Act.^{40_IDEA_473)_and_footnotes(n70);.FTNT n70}

III. REVIEW OF WILHELM PUDENZ V. LITTLEFUSE, INC.

A. Functionality vs. Incontestability: Forewarning Pudenz

This section begins with an overview of the relevant case law foreshadowing the Eleventh Circuit's recent *Pudenz* decision.^{40 IDEA 473) and footnotes(n71); FTNT n71} Arguably, the cases leading up to *Pudenz* called for a more narrow interpretation of the Lanham Act than that employed by the *Pudenz* court. In *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*,^{40 IDEA 473) and footnotes(n72); FTNT n72} the Supreme Court narrowly defined the available challenges to incontestable trademark registrations to those provided in the actual text of the Lanham Act.^{40 IDEA 473) and footnotes(n73); FTNT n73} In doing so, the Court held that "Congress expressly provided in sections 33(b) and 15 [of the Lanham Act]^{40 IDEA 473) and footnotes(n74); FTNT n74} that an incontestable mark could be challenged on specified grounds, and the grounds identified by Congress do not include mere descriptiveness."^{40 IDEA 473) and footnotes(n75); FTNT n75}

After the Supreme Court's decision in *Park 'N Fly*, the Fourth Circuit faced a similar challenge in *Shakespeare Co. v. Silstar Corp. of America, Inc.*^{40 IDEA 473) and footnotes(n76); FTNT n76} The *Shakespeare* court confronted the issue of whether an incontestable trademark registration could be cancelled on the ground that the mark is functional.^{40 IDEA 473) and footnotes(n77); FTNT n77} The issue in *Shakespeare* concerned cancellation, not defense, of a mark based on functionality.^{40 IDEA 473) and footnotes(n78); FTNT n78} The Fourth Circuit construed *Park 'N Fly* as holding that an incontestable registration was not subject to cancellation, since functionality, like mere descriptiveness, was not an authorized ground for cancellation of an incontestable mark under § S 33 of the Lanham Act.^{40 IDEA 473) and footnotes(n79); FTNT n79} Therefore, the *Shakespeare* court awarded incontestable trademark rights in features having primarily functional attributes.^{40 IDEA 473) and footnotes(n80); FTNT n80}

The majority in *Shakespeare* rejected the better interpretive judgment of its dissenting member.^{40 IDEA 473) and footnotes(n81); FTNT n81} The Fourth Circuit refused to accept the notion that the Patent Clause trumped the incontestability statute, because the incontestability statute lacked an express cancellation ground based on functionality.^{40 IDEA 473) and footnotes(n82); FTNT n82} The *Shakespeare* court blindly followed the Supreme Court's statutory construction from *Park 'N Fly*,^{40 IDEA 473) and footnotes(n83); FTNT n83} in spite of the fact that *Park 'N Fly* involved an issue relevant only to trademark law, i.e., descriptiveness,^{40 IDEA 473) and footnotes(n84); FTNT n84} while *Shakespeare* involved an issue that crossed into the realm of the Patent Clause, i.e., functionality.^{40 IDEA 473) and footnotes(n85); FTNT n85}

As much as the Fourth Circuit desired to analogize the issues of descriptiveness and functionality, functionality must lend itself to more stringent limitations under patent law.^{40 IDEA 473) and footnotes(n86); FTNT n86} Otherwise, rights which never existed in functional features could be granted through a strict construction of the Lanham Act. In a wellwritten analysis of the *Shakespeare* decision, Theodore H. Davis, Jr. summarized that "the Fourth Circuit's opinion in *Shakespeare* represents not only an incorrect statement of trademark law, but one that promises to have significant deleterious effects on the balance between competition and monopoly."^{40 IDEA 473) and footnotes(n87); FTNT n87}

After Shakespeare, at least one other district court followed suit by literally construing the Lanham Act on the functionality issue,^{40_IDEA_473)_and_footnotes(n88);.FTNT n88} despite the common sense notion that these decisions were in direct conflict with the Patent Clause.^{40_IDEA_473)_and_footnotes(n89);.FTNT n89} In *Kransco*, the court misinterpreted what was "settled" in Shakespeare, and extended the notion that a functional incontestable mark was not only immune from cancellation, but also from challenge.^{40_IDEA_473)_and_footnotes(n90);.FTNT n90}

Until recently, courts have not been forced to address the related, but separate issue of whether functionality may be alleged as a defense to the conclusive evidentiary presumption attaching to a registration that has become incontestable within the meaning of §§ 15 and 33 of the Lanham Act.^{40_IDEA_473)_and_footnotes(n91);.FTNT n91} *Northwestern Corp. v. Gabriel Manufacturing Co.*^{40_IDEA_473)_and_footnotes(n92);.FTNT n92} addressed the issue of whether functionality was grounds for the cancellation of an otherwise incontestable mark.^{40_IDEA_473)_and_footnotes(n93);.FTNT n93} *Northwestern* "resurrected functionality as an extrastatutory defense" after first dismissing it, as Shakespeare did, as an "extrastatutory ground for cancellation."^{40_IDEA_473)_and_footnotes(n94);.FTNT n94} Unlike *Kransco*, the *Northwestern* court wisely noted that Shakespeare "did not hold that functionality may not be asserted as an affirmative defense to a suit for trademark infringement."^{40_IDEA_473)_and_footnotes(n95);.FTNT n95}

Three years after the Fourth Circuit decision in Shakespeare, the Supreme Court addressed the related issue of color as a functional feature.^{40_IDEA_473)_and_footnotes(n96);.FTNT n96} The Court's application of the functionality doctrine to trademark law presented valuable language for future courts deciding such issues. The Court stated:

The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time . . . after which competitors are free to use the innovation. If a product's functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity).^{40_IDEA_473)_and_footnotes(n97);.FTNT n97}

B. *Pudenz*: Remediating Shakespeare Under the Shadow of the TLT Act

In *Pudenz*, both litigants were companies that manufactured and marketed plug-in blade fuses for automobiles.^{40_IDEA_473)_and_footnotes(n98);.FTNT n98} As part of Littlefuse's domestic product line, the company produces and markets an automotive fuse called the "ATO blade fuse," which was protected under two trademark

registrations.^{40 IDEA 473) and footnotes(n99);FTNT n99} Both registrations had achieved incontestable status.^{40 IDEA 473) and footnotes(n100);FTNT n100}

When Pudenz entered the United States market with its own version of the blade fuse, Littlefuse responded with a cease and desist demand.^{40 IDEA 473) and footnotes(n101);FTNT n101} Thereafter, Pudenz initiated a lawsuit, seeking declaratory judgment that it had not infringed Littlefuse's trademark rights.^{40 IDEA 473) and footnotes(n102);FTNT n102} The sole issue before the Eleventh Circuit in Pudenz was whether the incontestable trademark features of Littlefuse's blade fuse trade dress were subject to the functionality defense.^{40 IDEA 473) and footnotes(n103);FTNT n103}

Fortunately, shortly after Shakespeare, the TLT Act and Pudenz came along, limiting the holding in Shakespeare. However, the effective enactment date of the TLT Act was October 30, 1998, which prevented the TLT Act's explicit references to the functionality doctrine from being directly applied in Pudenz.^{40 IDEA 473) and footnotes(n104);FTNT n104} Thus, the Pudenz court was unable to reach prospectively for an enumerated defense of functionality against Littlefuse's incontestable trademarks.^{40 IDEA 473) and footnotes(n105);FTNT n105} Instead, the court relied on the public policy arguments underlying the Patent Clause and the Lanham Act.^{40 IDEA 473) and footnotes(n106);FTNT n106}

The Pudenz court succinctly summarized that the functionality doctrine

was established before the enactment of the Lanham Act, and the Act did not repeal it. Against this backdrop, we do not read the incontest-ability provisions of the Lanham Act as eliminating the functionality defense. The enactment of the Trademark Law Treaty Implementation Act by Congress only strengthens this reading.^{40 IDEA 473) and footnotes(n107);FTNT n107}

The Eleventh Circuit held in Pudenz that "a trademark registration that has achieved incontestable status under 15 U.S.C. § 1065 is still subject to attack based on functionality."^{40 IDEA 473) and footnotes(n108);FTNT n108} The court further clarified that the "functionality doctrine is an important judicially created concept that was not abrogated by the enactment of the incontestability provisions of the Lanham Act."^{40 IDEA 473) and footnotes(n109);FTNT n109}

Judge Niemeyer, dissenting in Shakespeare, opined that "the doctrine of functionality is an extra-statutory doctrine, neither defined nor limited by the express provisions of the Lanham Trademark Act, which denies a perpetual monopoly of that which is functional."^{40 IDEA 473) and footnotes(n110);FTNT n110} Since the Act did not define or limit the application of the doctrine, the majority in Shakespeare, unlike Pudenz, failed by treating functionality as just that: merely an extra-statutory doctrine applicable at the discretion of the decisionmaker. Judge Niemeyer's dissent further argued:

The doctrine of functionality, which goes to the question of whether an enforceable trademark ever existed, was never rejected by the Lan-ham Act. On the contrary, it is

tacitly embraced, and every court that has considered the doctrine has so assumed. To conclude otherwise would imply that Congress intended to alter the underlying constitutional policies of restricting monopolies on function to promote copying and competition.^{40 IDEA 473) and footnotes(n111);FTNT n111}

Essentially, Pudenz asserted that without a functionality defense, upholding a trademark with functional features because of the mark's incontestable status would amount to an unconstitutional extension of the patent clause.^{40 IDEA 473) and footnotes(n112);FTNT n112} This article suggests that holding otherwise would have pillaged the foundational cornerstone upon which patent law has stood in the spirit and name of innovation. After all, innovation is reaped out of the rights of all citizens to one day use and improve upon the functional ideas of their fellow countrymen in the name of competitive beneficence to society. This prevents a functional trademark from attaining perpetual life, where patent law only allows an exclusive utilitarian monopoly for the present limited duration of twenty years.^{40 IDEA 473) and footnotes(n113);FTNT n113}

IV. PRACTICE: THE FUNCTIONALITY DEFENSE TO INCONTESTABLE TRADEMARKS BEFORE AND AFTER THE TLT ACT ENACTMENT

A. TLT Act Enumerates Functionality Defense to Incontestable Marks

For intellectual property practitioners, the technical corrections made by the TLT Act have constructed a beacon where once treacherous seas blurred the dichotomy between trademark and patent law.^{40 IDEA 473) and footnotes(n114);FTNT n114} A signal light now shines in the form of express statutory law granting both defense and cancellation measures against functional incontestable marks.^{40 IDEA 473) and footnotes(n115);FTNT n115}

In his treatise, Professor McCarthy discusses the TLT Act's technical corrections to the Lanham Act.^{40 IDEA 473) and footnotes(n116);FTNT n116} McCarthy's analysis summarizes the functionality revisions to the Lanham Act and compares them to the contrasting decision in *Shakespeare* on functional incontestable trademarks.^{40 IDEA 473) and footnotes(n117);FTNT n117} McCarthy specifically notes that prior to the statutory addition of the functionality defense, granting incontestable trademark protection to a functional shape effectively granted a patent-like right to exclude others from access for an unlimited duration.^{40 IDEA 473) and footnotes(n118);FTNT n118} This was in direct violation of the "limited times" restriction enumerated in the United States Constitution.^{40 IDEA 473) and footnotes(n119);FTNT n119} With the TLT Act corrections now in effect, any incontestable trademark registration on primarily functional features, may now be defended against or cancelled under the Lanham Act, so long as civil litigation on the mark is commenced on or after October 30, 1998.^{40 IDEA 473) and footnotes(n120);FTNT n120}

B. Pudenz: Precedent Providing Pre-TLT Act Functionality Defense

The trial court in *Pudenz*, as well as the Eleventh Circuit on re-view, reasoned that functional incontestable trademarks were subject to the functionality doctrine, even without an express defense in 15 U.S.C.

§ S 1115(b).^{40_IDEA_473)_and_footnotes(n121);FTNT n121} Appellant Littlefuse argued for a strict, literal interpretation of the Lanham Act, even in light of looming legislation to the contrary.^{40_IDEA_473)_and_footnotes(n122);FTNT n122} However, the court refused this narrow construction and ruled that the functionality doctrine applied within the statute, even in a case commenced before the TLT Act enactment.^{40_IDEA_473)_and_footnotes(n123);FTNT n123}

As educated minds often disagree on difficult issues, an argument may still exist that the majority in *Shakespeare* arrived at the proper decision notwithstanding passage of the TLT Act. As difficult as it may have been for the Eleventh Circuit to stray from prior caselaw, strong legal precedents now exist in the pre-TLT Act caselaw to counter *Shakespeare*. Today, even civil cases deciding the fate of functional incontestable trademarks may be defended against, and arguably cancelled, based on the holding in *Pudenz*.

V. VALUING THE LABEL OF INCONTESTABILITY: AN ARGUMENT FOR "CONCLUSIVE" CHANGE

A. Is an Incontestable Trademark Registration Ever REALLY Incontestable?

Historically, the incontestability provisions, similar to those within the British Act, were intended to permit "most registrations to ripen into something more substantial than a mere claim."^{40_IDEA_473)_and_footnotes(n124);FTNT n124} "One of the most important features of the Lanham Act [however misleading] was the creation of some form of conclusive presumption of validity."^{40_IDEA_473)_and_footnotes(n125);FTNT n125} This conclusive presumption was to result in predictable rights in mature registrations.^{40_IDEA_473)_and_footnotes(n126);FTNT n126} However, the addition of yet another defense to trademark incontestability naturally raises the issue of whether any more defenses may be asserted without completely erasing that which is said to be incontestable.

It is still not clear what additional benefit an incontestable trademark actually serves beyond that of a prima facie valid mark obtained merely by registration on the principal register. An argument exists that civil cases litigating the validity of an incontestable mark, if commenced prior to the TLT Act enactment, could possibly sidestep the functionality scrutiny by following the majority opinion in *Shakespeare*. Notwithstanding this argument, there is relatively little difference between a mark registered on the principal register and one of incontestable status.^{40_IDEA_473)_and_footnotes(n127);FTNT n127} Essentially, a mark registered on the principal register merely lacks the five-year use requirement of incontestable marks and a few other statutory formalities enumerated within § S 15 of the Lanham Act.^{40_IDEA_473)_and_footnotes(n128);FTNT n128}

In his treatise, Professor McCarthy identifies the few key benefits bestowed on the holder of an incontestable trademark registration, noting:

Two important challenges to the validity of a mark are definitely cut off by the status of an incontestable registration: (1) that the mark is not inherently distinctive and lacks secondary meaning; and (2) that the mark is not owned by the registrant because it is inferior in priority to defendant's previously used mark. In addition, incontestable status forecloses a challenge that registrant is not the owner of the mark, allegedly having conveyed it as security to another.^{40_IDEA_473)_and_footnotes(n129);.FTNT n129}

However, after five years of use, the burden of proving that secondary meaning has attached is easily satisfied by most trademark owners, limiting the perceived benefit (notwithstanding cutting off the rare legitimate or frivolous claim). Furthermore, the second benefit, relating to the issue of priority, is even narrower in scope since "prior use may be available as a statutory defense as to a limited territory, depending on the facts."^{40_IDEA_473)_and_footnotes(n130);.FTNT n130} Finally, the third benefit revolves solely around the exemplary issue of whether ownership is renounced when an incontestable mark is conveyed as a security.^{40_IDEA_473)_and_footnotes(n131);.FTNT n131}

Arguably, the most significant advantage of obtaining incontestability is that the related presumption of validity has the potential to remove an otherwise easily filed dispute from the Patent and Trademark Office to a local district court.^{40_IDEA_473)_and_footnotes(n132);.FTNT n132} In court, the conclusive evidentiary status of an incontestable registration has the advantage of elevating the rebuttable presumption above that granted a prima facie presumptively valid registration.^{40_IDEA_473)_and_footnotes(n133);.FTNT n133} However, that which is conclusive may readily be proven otherwise, since the defenses to which an incontestable mark is immune are indeed limited.^{40_IDEA_473)_and_footnotes(n134);.FTNT n134}

With as many as twenty-one possible exceptions to the rule, Professor McCarthy devoted a section of his treatise to this subject, artfully and truthfully entitled in part, "incontestability is a 'swiss cheese' rule."^{40_IDEA_473)_and_footnotes(n135);.FTNT n135} As previously noted, benefits do exist and serve to separate incontestable (conclusive) registrations from marks merely registered on the principal register.^{40_IDEA_473)_and_footnotes(n136);.FTNT n136} However, the extensive limitations on incontestable registrations do not warrant the pedestallike nomenclature that was legislatively awarded such marks over fifty years ago.

Unlike the attempt by courts to define functionality,^{40_IDEA_473)_and_footnotes(n137);.FTNT n137} nowhere in the case or statutory law is the plain meaning of the term incontestability identified. Black's Law Dictionary has but one reference to incontestability which applies to insurance policies, not trademarks.^{40_IDEA_473)_and_footnotes(n138);.FTNT n138} The insurance definition readily accommodates the notion of granting rights where none may have existed, unlike the true meaning of incontestability as used in the Lanham Act.^{40_IDEA_473)_and_footnotes(n139);.FTNT n139} The plain meaning of incontestable in a non-legal dictionary, hardly consistent with the application of the term applied in trademark law, defines incontestable as "not contestable: INDISPUTABLE."^{40_IDEA_473)_and_footnotes(n140);.FTNT n140} Far more fitting

for trademark purposes, though completely abolishing the implication of a higher status, is the converse of incontestable: contestable.^{40 IDEA 473) and footnotes(n141);FTNT n141}

Irrespective of what the original drafters of the Lanham Act honestly meant to establish by identifying certain marks as incontestable, the nomenclature today operates as a misnomer. The revisions that have been made since the Lanham Act was enacted in 1946 have only further removed incontestably registered marks from the true meaning of incontestable.^{40 IDEA 473) and footnotes(n142);FTNT n142} "Use of the term 'incontestable' in the Lanham Act is an historical anomaly."^{40 IDEA 473) and footnotes(n143);FTNT n143} Therefore, it must be a particular source of confusion for the average owner of an incontestably registered trademark once the status of such a mark is contested in litigation.

The dichotomy between trademarks merely registered on the principal register and those attaining incontestable status centers on the evidentiary validity of the mark as prima facie in the former and conclusive in the latter.^{40 IDEA 473) and footnotes(n144);FTNT n144} However, the separation between these evidentiary status values is narrow at best, as noted by the limited defensive exceptions to trademarks bearing the purported incontestable status.^{40 IDEA 473) and footnotes(n145);FTNT n145} Where nearly the same defense and cancellation weapons can attack both prima facie registered marks and incontestably registered marks with a few minor exceptions, it hardly seems fitting that the latter, almost solely by passage of time, rises to a status of such a misleading evidentiary reference as incontestable.^{40 IDEA 473) and footnotes(n146);FTNT n146}

B. Future Lanham Act Revision: Replace "Incontestable" with "Conclusive"

This section suggests there is a need for yet another revision of the Lanham Act. Even if the few foreclosed challenges under the incontestability provisions are worthy of their keep, the term incontestability remains an unjustifiable misnomer. This reasoning follows the historical transgression of the incontestability provisions.

As it appeared in early versions of the Act, the designation had a reasonable degree of accuracy, for in such versions the right afforded the registrant was what the term implies: freedom from all defenses of infringers. But in the long legislative passage through Congress, various restrictions on and exceptions to the right of "incontestability" were progressively added. The rights were diluted and changed but the label of "incontestability" was not. The consequence was that by the time the Lanham Act was enacted into law, the designation "incontestability" applied to a limited and restricted concept which cuts off some possible challenges to validity of a mark, but leaves the rest untouched.^{40 IDEA 473) and footnotes(n147);FTNT n147}

One plausible argument stands for ending potential litigation of incontestable marks by completely removing the provision and related references from the Act. This would simply leave all trademarks, having passed the scrutiny of the Patent and Trademark Office and viewers of the Official Gazette, as prima facie valid. Thus, once listed upon

the principal register, all marks would be subject to a single set of defense and cancellation provisions.^{40 IDEA 473) and footnotes(n148);FTNT n148}

Another more justifiable correction than completely obliterating the incontestability provisions, would be simply removing or rephrasing all incontestability references in the Lanham Act. For example, a title revision for § 1540 IDEA 473) and footnotes(n149);FTNT n149 would grant clarity by simply striking "Incontestability of" and amending the title to read instead, "Right to use mark under certain conditions."^{40 IDEA 473) and footnotes(n150);FTNT n150} However, this would leave the provision essentially nameless and without a status reference enumerated.

The most ideal correction is to insert "Conclusive" before "Right to Use Mark Under Certain Conditions", yielding the title: "Conclusive Right to Use Mark Under Certain Conditions." This measure would lend even greater clarification by indicating the evidentiary status of the trademark. Furthermore, this approach meshes well with other Lanham Act provisions since marks less than five years old on the principal register are often referenced by their evidentiary status as prima facie marks.^{40 IDEA 473) and footnotes(n151);FTNT n151}

Although the term conclusive may provide no greater definitional strength to the status it protects,^{40 IDEA 473) and footnotes(n152);FTNT n152} at least it is premised on the evidentiary nature for which the mark represents.^{40 IDEA 473) and footnotes(n153);FTNT n153} Therefore, the author advocates that all references to incontestable be replaced with the word conclusive, to most appropriately identify that which has been attained by the owner of the registration: conclusive evidence of validity.^{40 IDEA 473) and footnotes(n154);FTNT n154} These amendments would grant the intellectual property community, as well as the general public, a nomenclature simply and concisely denoting the two-class evidentiary status of trademarks listed on the principal register as either: 1) prima facie; or 2) conclusive.

VI. CONCLUSION

Following five years on the principal register, § 15 of the Lanham Act^{40 IDEA 473) and footnotes(n155);FTNT n155} grants continued trademark protection to properly registered marks under a heightened status, referred to as incontestability.^{40 IDEA 473) and footnotes(n156);FTNT n156} However, the functionality doctrine, which allows protection of only non-functional shapes, configurations, or color schemes exists within the trademark law.^{40 IDEA 473) and footnotes(n157);FTNT n157} Historically, this doctrine was created to reconcile trademark law with patent law such that wholly functional features could only be protected for a limited duration through the patent laws.^{40 IDEA 473) and footnotes(n158);FTNT n158}

Functionality exists if the design or color is so superior to available alternatives that competition would be hindered by giving the first user exclusive rights.^{40 IDEA 473) and footnotes(n159);FTNT n159} Therefore, functional features are only to be protected through patent law since, upon expiration of a patent, the utilitarian features enter the public domain.^{40 IDEA 473) and footnotes(n160);FTNT n160} However, until recently, first users of functional features were able to attain

exclusive rights indefinitely through incontestable trademarks.^{40 IDEA 473) and footnotes(n161);FTNT n161}

Fortunately, the 1998 enactment of the TLT Act brought about corrections to specifically prevent future protection of functional features through trademark law.^{40 IDEA 473) and footnotes(n162);FTNT n162} The TLT Act revisions profoundly reinstated the critical balance between patent and trademark law by expressly adding functionality as a grounds for defense against infringement and cancellation of incontestable trademark registrations for wholly functional features.^{40 IDEA 473) and footnotes(n163);FTNT n163}

The Eleventh Circuit's pre-TLT Act decision in *Pudenz* also provided resounding precedent by holding that the functionality doctrine was a defense to the infringement of functional incontestable marks, even without the revised statutory language.^{40 IDEA 473) and footnotes(n164);FTNT n164} *Pudenz*'s split from the Fourth Circuit's decision in *Shakespeare*^{40 IDEA 473) and footnotes(n165);FTNT n165} has reduced the taint of the latter case upon the patent clause of the U.S. Constitution. The *Pudenz* court faced challenging issues surrounding the narrow cusp between trademark and patent law, and yielded to the latter.^{40 IDEA 473) and footnotes(n166);FTNT n166} Ultimately, the crucial Constitutional province of protecting functional features for only a limited time was upheld in the pre-TLT Act decision, despite the lack of an enumerated defense to rely on within the Lanham Act.^{40 IDEA 473) and footnotes(n167);FTNT n167}

The logical remaining question is whether there are any more defenses which can be promulgated in order to strip away even further the notion of an "incontestable trademark." Although there are certain limited rights associated with earning the status, incontestability is nevertheless a misleading term. Hence, there exists valid reasoning for the next revision of the Lanham Act to replace all reference to incontestable terminology with the appropriate evidentiary label conclusive. This would simplify the nomenclature to concisely denote the two-class evidentiary status of trademarks listed on the principal register as either: 1) *prima facie*; or 2) conclusive.

ⁿ¹ See *Wilhelm Pudenz v. Littlefuse, Inc.*, 177 F.3d 1204, 1211, 51 U.S.P.Q.2d (BNA) 1045, 1049 (11th Cir. 1999).

ⁿ² *Id.* at 1207, 51 U.S.P.Q.2d at 1046. (The district court found that both the individual features of the challenged fuse housing and the overall configuration of those features in the housing itself were functional.)

ⁿ³ Pub. L. No. 79-489, 60 Stat. 427 (1946) (codified as amended at 15 U.S.C. § § 1051-1127 (1994 & Supp. IV 1998)).

ⁿ⁴ Pub. L. No. 105-330, 112 Stat. 3064 (1998) (codified as amended in scattered sections of 15 U.S.C.).

ⁿ⁵ See 15 U.S.C. § 1115(b)(8) (1994 & Supp. IV 1998). The addition of the functionality defense to the Lanham Act was one of twelve revisions described as "technical corrections" in the TLT Act.

n6 See, e.g., *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198, 224 U.S.P.Q. (BNA) 327, 331 (1985); *Shakespeare Co. v. Silstar Corp. of Am., Inc.*, 9 F.3d 1091, 28 U.S.P.Q.2d (BNA) 1765 (4th Cir. 1993).

n7 See *Pudenz*, 177 F.3d at 1211, 51 U.S.P.Q.2d at 1050. ("Any exclusive right to functional features must be obtained under the Patent Act subject to the constitutional requirement of limited duration.").

n8 See Theodore H. Davis, Jr., Recent Developments in the Trade Dress Protection of Incontestably Registered Functional Designs, INTELL. PROP. L. NEWSL., Fall 1997 at 1, 24; see also Theodore H. Davis, Jr., Of "Ugly Sticks" and Uglier Case Law: A Comment on the Federal Registration of Functional Designs After *Shakespeare Co. v. Silstar Corp. of America*, 51 WASH. & LEE L. REV. 1257 (1994).

n9 Pub. L. No. 105-330, § 201(b), 112 Stat. 3064 (1998). The amendments made by this section shall take effect on the date of enactment of this Act, and shall apply only to any civil action filed or proceeding before the United States Patent and Trademark Office commenced on or after such date relating to the registration of a mark. Id.

n10 See *Pudenz*, 177 F.3d at 1208, 51 U.S.P.Q. at 1047 ("The primary purpose of [the TLT Act] was to harmonize some aspects of the Lanham Act with foreign trademark laws, in order to carry out the provisions of international trademark treaties."); see also 3 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 19:45.1, at 19-85 (rel. no. 10, June 1999) (The TLT Act amended § 1 of the Lanham Act to conform the United States. application procedure to the requirements of the Trademark Law Treaty, which was designed to simplify and harmonize worldwide registration formalities.).

n11 See Trademark Law Treaty Implementation Act: Hearings on H.R. 1667 Before the Subcomm. On Courts and Intellectual Property, of the House Judiciary Committee, 105th Cong. 62.67 (1997) (prepared statement of David Stimson, President, International Trademark Association).

n12 Id. at 64.

n13 Id. at 66.

n14 See Pub. L. No. 105-330, § 201, 112 Stat. 3064 (1998) (codified as amended in scattered sections of 15 U.S.C.)

n15 Trademark Law Treaty Implementation Act: Hearings on H.R. 1667 before the Subcomm. On Courts and Intellectual Property, of the House Judiciary Committee, 105th Cong. 67 (1997) (Prepared statement of David Stimson, President, International Trademark Association) (emphasis added).

n16 144 CONG. REC. S10535-36 (1998) (statement of Sen. Santorum) (emphasis added).

n17 Lanham Act § § 14 and 33 correspond to 15 U.S.C. § § 1064 and 33, respectively.

n18 See Pub. L. No. 105-330, § 201(a)(4), 112 Stat. 3064 (1998) (codified at 15 U.S.C. § 1064(3)) (providing for the cancellation of an incontestable registration due to

functionality); Pub. L. No. 105-330, § 201(a)(9), 112 Stat. 3064 (codified at *15 U.S.C. § 1115(b)* (providing functionality as an enumerated defense to infringement of an incontestable trademark registration).

n19 *9 F.3d 1091, 28 U.S.P.Q.2d (BNA) 1765 (4th Cir. 1993)*.

n20 See *id. at 1099, 28 U.S.P.Q.2d at 1771* (holding that where functionality was not one of the enumerated grounds for cancellation within § 14 of the Lanham Act (*15 U.S.C. § 1064*), functional features could not serve to cancel an incontestable registration).

n21 See Trademark Law Treaty Implementation Act: Hearings on H.R. 1667 before the Subcomm. On Courts and Intellectual Property, of the House Judiciary Committee, 105th Cong. 67 (1997) (prepared statement of David Stimson, President, International Trademark Association) ("These proposed amendments are necessary in view of recent court decisions.")

n22 1 MCCARTHY, *supra* note 10, § 7:63, at 7:135 (rel. no. 10, June 1999) (citing Pub. L. No. 105-330, 112 Stat. 3064 (1998) (noting specifically *15 U.S.C. § § 1064(c)* (cancellation) and *1115(b)(8)* (defense))).

n23 *Id.* at 7:136.

n24 *Shakespeare, 9 F.3d at 1099, 28 U.S.P.Q.2d at 1771* (functionality "is not an authorized ground for cancellation under *15 U.S.C. § 1064*"); see also *id. at 1104-05* (Niemeyer, J., dissenting) (summarizing that a feature not a trademark at inception should not later be protected under the guise of incontestability).

n25 *514 U.S. 159, 34 U.S.P.Q.2d (BNA) 1161 (1995)*.

n26 *Id. at 164, 34 U.S.P.Q.2d at 1163*.

n27 See 144 CONG. REC. S6564-03, S6572 (daily ed. June 18, 1998) (statement of Senator Hatch) (The technical corrections would "make explicit some of the current practices of the Patent and Trademark Office with respect to the trademark protection of matter that is wholly functional" and "clarify the law in useful ways.").

n28 The four revisions of the Lanham Act relating to functionality included in the TLT Act are: § 201(a)(2) (codified at *15 U.S.C. § 1052*) (1994 & Supp. IV 1998) (providing that "any matter, as a whole, is functional" is thus not registerable on the principle register); § 201(a)(4) (codified at *U.S.C. § 1064(3)*) (1994 & Supp. IV 1998) (providing for the cancellation of an incontestable registration due to functionality); § 201(a)(5) (codified at *15 U.S.C. § 1091(c)*) (1994 & Supp. IV 1998) (providing that, "any matter that as a whole is not functional" may be registerable on the supplemental register); and § 201(a)(9) (codified at *15 U.S.C. § 1115(b)*) (1994 & Supp. IV 1998) (providing functionality as a defense to infringement of incontestable registrations).

n29 Cf. *Jacque Lynne Palmer, Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.: The Sword/Shield Limitation to Trademark Incontestability*, 21 IDAHO L.R. 303, 308 (1985) (charting the dichotomy between the means of contesting a registered trademark during the first five years only, and the available means at any time).

n30 Since passage of the TLT Act, *15 U.S.C. § 1064(3)* reads as follows, with revised amendments in italics:

§ 1064. (§ 14) Cancellation of Registration

A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged by the registration of a mark on the principal register established by this chapter, or under the Act of March 3, 1881, or the Act of February 20, 1905:

(3) At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 1054 of this title or of subsection (a), (b), or (c) of section 1052 of this title for a registration under this chapter, or contrary to similar prohibitory provisions of such prior Acts for a registration under such Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.

n31 The text of *15 U.S.C. § 1115(b)* now reads, with the revised amendments in italics (not withstanding italics in (6)):

§ 1115. (§ 33) Registration on Principal Register as Evidence of Exclusive Right to Use Mark; Defenses

(b) Incontestability; Defenses To the extent that the right to use the registered mark has become incontestable under section 1065 of this title, the registration shall be conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce. Such conclusive evidence shall relate to the exclusive right to use the mark on or in connection with the goods or services specified in the affidavit filed under the provisions of section 1065 of this title, or in the renewal application filed under the provisions of section 1059 of this title if the goods or services specified in the renewal are fewer in number, subject to any conditions or limitations in the registration or in such affidavit or renewal application. Such conclusive evidence of the right to use the registered mark shall be subject to proof of infringement as defined in section 1114 of this title, and shall be subject to the following defenses or defects:

(1) That the registration or the incontestable right to use the mark was obtained fraudulently; or

(2) That the mark has been abandoned by the registrant; or

(3) That the registered mark is being used, by or with the permission of the registrant or a person in privity with the registrant, so as to misrepresent the source of the goods or services on or in connection with which the mark is used; or

(4) That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin; or

(5) That the mark whose use by a party is charged as an infringement was adopted without knowledge of the registrant's prior use and has been continuously used by such party or those in privity with him from a date prior to (A) the date of constructive use of the mark established pursuant to section 1057(c) of this title, (B) the registration of the mark under this chapter if the application for registration is filed before the effective date of the Trademark Law Revision Act of 1988, or (C) publication of the registered mark under subsection (c) of section 1062 of this title: Provided, however, That this defense or defect shall apply only for the area in which such continuous prior use is proved; or

(6) That the mark whose use is charged as an infringement was registered and used prior to the registration under this chapter or publication under subsection (c) of section 1062 of this title of the registered mark of the registrant, and not abandoned: Provided, however, that this defense or defect shall apply only for the area in which the mark was used prior to such registration or such publication of the registrant's mark; or

(7) That the mark has been or is being used to violate the anti-trust laws of the United States; or

(8) That the mark is functional; or

(9) That equitable principles, including laches, estoppel, and acquiescence, are applicable.

n32 See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 170-71, 34 U.S.P.Q.2d (BNA) 1161, 1166 (1995) (The common-law definition of trademark consists of "a name, symbol, figure, letter, form, or device, if adopted and used by a manufacturer or merchant in order to designate the goods he manufactures or sells to distinguish the same from those manufactured or sold by another." (citing *McLean v. Fleming*, 96 U.S. 245 (1877))); see also 15 U.S.C. § 1127 (1994):

The term "trademark" includes any word, name, symbol, or device, or any combination thereof -- (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

n33 See 15 U.S.C. § 1052 (1994) (A trademark that distinguishes the goods of the applicant from the goods of others may be registerable on the principal register.).

n34 See BLACK'S LAW DICTIONARY 1500 (7th ed. 1999) (Trade dress is defined as "the overall appearance and image in the marketplace of a product or a commercial enterprise.").

n35 See *Pudenz*, 177 F.3d at 1206, 51 U.S.P.Q.2d at 1046 (The trademark registrations at issue were a twodimensional outline and a three-dimensional configuration of automotive, plug-in blade fuses.).

n36 See 15 U.S.C. § 1052 (1994 & Supp. IV 1998).

n37 ARTHUR R. MILLER & MICHAEL H. DAVIS, INTELLECTUAL PROPERTY -PATENTS, TRADEMARKS, AND COPYRIGHT, § 16.5, at 241 (2d ed. 1990).

n38 See 15 U.S.C. § 1062(a) (1994) (After filing the application for Trademark registration with the Patent and Trademark Office, an examiner will determine if applicant is entitled to registration of such mark; if applicant is entitled, the mark is published in the Official Gazette of the PTO.).

n39 See *id.* § 1057(b) (A certificate of registration of a mark upon the PTO's principal register will serve as prima facie evidence regarding the validity of such mark.).

n40 See *id.* § 1065.

n41 See *id.* § 1065. The incontestability text of § 1065 reads: § 1065. (§ 15) Incontestability of Right to Use Mark Under Certain Conditions

Except on a ground for which application to cancel may be filed at any time under paragraphs (3) and (5) of section 1064 of this title, and except to the extent, if any, to which the use of a mark registered on the principal register infringes a valid right acquired under the law of any State or Territory by use of a mark or trade name continuing from a date prior to the date of registration under this chapter of such registered mark, the right of the registrant to use such registered mark in commerce for the goods or services on or in connection with which such registered mark has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in commerce, shall be incontestable: Provided, That

(1) there has been no final decision adverse to registrant's claim of ownership of such mark for such goods or services, or to registrant's right to register the same or to keep the same on the register; and

(2) there is no proceeding involving said rights pending in the Patent and Trademark Office or in a court and not finally disposed of; and

(3) an affidavit is filed with the Commissioner within one year after the expiration of any such five-year period setting forth those goods or services stated in the registration on or in connection with which such mark has been in continuous use for such five consecutive years and is still in use in commerce, and the other matters specified in paragraphs (1) and (2) of this section; and

(4) no incontestable right shall be acquired in a mark which is the generic name of the goods or services or a portion thereof, for which it is registered.

Subject to the conditions above specified in this section, the incontestable right with reference to a mark registered under this chapter shall apply to a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905, upon the filing of the required affidavit with the Commissioner within one year after the expiration of any period of five consecutive years after the date of publication of a mark under the provisions of subsection (c) of section 1062 of this title.

The Commissioner shall notify any registrant who files the above-prescribed affidavit of the filing thereof.

n42 *Wilhelm Pudenz v. Littlefuse, Inc.*, 177 F.3d 1204, 1208, 51 U.S.P.Q.2d (BNA) 1045, 1047 (11th Cir. 1999) (quoting from *Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 198, 224 U.S.P.Q. (BNA) 327, 331 (1985)); see also *Shakespeare, Co. v. Silstar Corp. of Am., Inc.*, 9 F.3d 1091, 1104, 28 U.S.P.Q.2d (BNA) 1765, 1776 (4th Cir. 1993) (Niemeyer, J., dissenting).

n43 *Shakespeare*, 9 F.3d at 1104, 28 U.S.P.Q.2d at 1776 (Niemeyer, J., dissenting).

n44 See 15 U.S.C. § 1115 (1994).

n45 See id. § 1065.

n46 See, e.g., 15 U.S.C. § 1115(b)(8) (1994 & Supp. IV 1998).

n47 See generally 15 U.S.C. § § 1051-1127 (1994 & Supp. IV 1998) (codification of the Lanham Act).

n48 15 U.S.C. § 1052(e) (1994 & Supp. IV 1998).

n49 See *Shakespeare Co. v. Silstar Corp. of Am.*, 9 F.3d 1091, 1099, 28 U.S.P.Q.2d (BNA) 1765, 1771 (4th Cir. 1993).

n50 See U.S. CONST., art. I, § 8, cl. 8; see also 35 U.S.C. § § 1-376 (1994 & Supp. IV 1998).

n51 See *Wilhelm Pudenz v. Littlefuse, Inc.*, 177 F.3d 1204, 1207, 51 U.S.P.Q.2d (BNA) 1045, 1046 (11th Cir. 1999).

n52 Id.

n53 BLACK'S LAW DICTIONARY 682 (7th ed. 1999); see also MILLER & DAVIS, supra note 38, § 16.6, at 246 (noting that the court in *Rolls-Royce Motors Ltd. v. A & A Fiberglass, Inc.*, 428 F. Supp. 689, 692, 193 U.S.P.Q. (BNA) 35, 40 (N.D. Ga. 1997) stated that the trademark need not be completely non-functional, but only not "primarily" functional to qualify for protection). Primary functionality is a fact-intensive issue and not an issue on appeal in *Pudenz*. Therefore, it is not addressed further in this article.

n54 See Peter E. Mims, Promotional Goods and the Functionality Doctrine: An Economic Model of Trademarks, 63 TEXAS L. REV. 639, 658-59 (1984) (finding even more basis for the doctrine based on the effect of functionality on the economic interests of consumers in trademarks, Mims explained:

Trademarks affect the interests of consumers in two ways: they tend to lower the cost of information, and they facilitate the formation of monopolies by producers. Thus, trademarks help consumers in one respect and harm them in another. . . . Producers could gain monopoly power over any functional feature of a product that acquired secondary meaning. According to standard economic analysis, exercise of this power would lead to restricted output and higher prices, both of which would harm consumers. Nor can this monopoly power be justified by analogy to copyrights or patents; trademarks, unlike copyrights and patents, do not provide new ideas.

The functionality doctrine attempts to balance these consumer interests. If a court refuses to apply the functionality doctrine, it decreases the costs of search ["search" equates to economists term for the process by which consumers acquire product information] in two ways. First, it eliminates confusion caused by use of identical features by more than one producer. Second, it encourages producers to use pleasing marks that make their products distinctive to consumers. If a court does apply the functionality doctrine, on the other hand, it accepts higher search costs in order to prevent monopoly in the production of useful products.

Id. With the TLT Act, producers can no longer "gain monopoly power over any functional feature of a product that acquired secondary meaning," as Mims noted back in 1984. However, the practical balancing act that the functionality doctrine serves in relation to consumer protection and monopoly avoidance, remains valid today. Mims's article does not expressly make the correlation between trademark monopoly on functional features as a violation of patent law, but the negative affects on consumerism are identified concisely.

n55 See *id. at 661*; Mims, in explaining the economic effects of the functionality doctrine, stated:

The functionality doctrine privileges the copying of utilitarian product features in the absence of a federal statutory monopoly. The doctrine applies even if it causes confusion. Thus, the doctrine rests on the judgment that the benefits of preventing monopoly power in the production of useful goods outweigh the increased search costs caused by duplication of features that have secondary meaning.

Id.; see also Glynn S. Lunney, Jr., Trademark Monopolies, 48 *EMORY L.J.* 367, 368 (1999) (noting that during the legislative debates culminating in the Lanham Act, the Justice Department opposed overreaching and broad trademark protection).

n56 See BLACK'S LAW DICTIONARY 682 (7th ed. 1999) (definition of functionality).

n57 See R. Lawton Jordan III, Thomas & Betts Corp. v. Panduit Corp. -- Toward a Coherent View of Trade Dress Protection for Product Configurations, 6 *J. INTELL. PROP. L.* 323, 323 (1999) (reviewing rationale behind patent protection).

n58 *Id. at 324.*

n59 See David S. Welkowitz, Trade Dress and Patent -- The Dilemma of Confusion, 30 *RUTGERS L.J.* 289, 292 (1999) (noting that patent laws provide "the principal means by which we protect the intellectual property embodied in products").

n60 1 MCCARTHY, supra note 10, § 7:64, at 7-137 to 7-138 (rel. no. 10, June 1999).

n61 See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165, 34 U.S.P.Q.2d (BNA) 1161, 1163 (1995) (allowing trademark rights following patent expiration, "would impede competition--not by protecting the reputation of the original bulb maker, but by frustrating competitors' legitimate efforts to produce an equivalent illuminationenhancing bulb"); see also H. Melissa Mather, Recent Developments in Trademark Law, 7 *TEX. INTELL. PROP. L.J.* 347, 357 (1999) (discussing *Disc Golf Ass'n Inc. v. Champion Discs, Inc.*, 158 F.3d 1002, 1006, 48 U.S.P.Q.2d (BNA) 1132, 1135 (9th Cir. 1998) in which the court cited *Qualitex* in its holding that a company could not extend its expired patent monopoly by later claiming trade dress protection on the same design).

n62 See *Qualitex*, 514 U.S. at 164, 34 U.S.P.Q.2d at 1163.

n63 See Mims, supra note 55, at 644-45.

n64 See *id.*

n65 *Id.*

n66 See 15 U.S.C. § 1115(b) (1994).

n67 See 15 U.S.C. § 1115 (1994).

n68 See 5 MCCARTHY, supra note 10, § 32:149, at 32-213 (rel. no. 10, June 1999).

n69 See 15 U.S.C. § 1115(b)(8) (1994 & Supp. IV 1998).

n70 *Wilhelm Pudenz v. Littlefuse, Inc.*, 177 F.3d 1204, 1208, 51 U.S.P.Q.2d (BNA) 1045, 1047 (11th Cir. 1999).

n71 *Id.* at 1211, 51 U.S.P.Q.2d at 1050.

n72 469 U.S. 189, 224 U.S.P.Q.2d (BNA) 327 (1985).

n73 See *id.* at 201, 224 U.S.P.Q.2d at 332.

n74 Sections 15 and 33 of the Lanham Act correspond to 15 U.S.C. § § 1065 & 1115, respectively.

n75 *Park 'N Fly*, 469 U.S. at 201, 224 U.S.P.Q.2d at 332.

n76 9 F.3d 1091, 28 U.S.P.Q.2d (BNA) 1765 (4th Cir. 1993).

n77 See *id.* at 1092, 28 U.S.P.Q.2d at 1766.

n78 *Id.*

n79 See *id.* at 1097-99, 28 U.S.P.Q.2d at 1770.

n80 *Id.* at 1099, 28 U.S.P.Q.2d at 1771. This article suggests the Shakespeare decision violated the Patent Clause of the U.S. Constitution by granting unlimited rights to functional features.

n81 *Id.*, 28 *U.S.P.Q.2d* at 1771-72 (Niemeyer, J., dissenting) (stating that functionality does apply to incontestable marks and can therefore be grounds for cancellation of an incontestable mark).

n82 See *id.*, 28 *U.S.P.Q.2d* at 1772.

n83 *Id.* at 1097, 28 *U.S.P.Q.2d* at 1770.

n84 *Park ' N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 *U.S.* 189, 191, 224 *U.S.P.Q.* (BNA) 327, 328 (1985) (holding that an incontestable mark may not be cancelled on grounds of mere descriptiveness).

n85 *Shakespeare*, 9 *F.3d* at 1099, 28 *U.S.P.Q.2d* at 1771 (holding that an incontestable mark may not be cancelled on grounds that the mark is functional).

n86 See *id.* at 1099, 28 *U.S.P.Q.2d* at 1772 (Niemeyer, J., dissenting) (stating that "the doctrine of functionality is an extra-statutory doctrine . . . which denies a perpetual monopoly of that which is functional"); see also U.S. CONST., art. I, § 8, cl. 8 ("Congress shall have Power . . . To promote the Progress of . . . useful Arts, by securing for limited Times to . . . Inventors the exclusive Right to their . . . Discoveries.").

n87 Theodore H. Davis, Jr., Of "Ugly Stiks" and Uglier Case Law: A Comment on the Federal Registration of Functional Designs After *Shakespeare Co. v. Silstar Corp. of America*, 51 *WASH. & LEE L. REV.* 1257, 1258 (1994) (proposing an alternative interpretation of the Lanham Act that encompasses cancellation actions on facts similar to those in *Shakespeare*, and in line with the TLT Act revisions to the Lanham Act, creating "a framework compatible not only with the underlying purposes of the Act, but with the Constitution as well").

n88 See, e.g., *Kransco Mfg. Inc. v. Hayes Specialties Corp.*, 33 *U.S.P.Q.2d* (BNA) 1999 (*E.D. Mich.* 1994), vacated in part on other grounds, 77 *F.3d* 503, 37 *U.S.P.Q.2d* (BNA) 1722 (*Fed. Cir.* 1996).

n89 See U.S. CONST., art. I, § 8, cl. 8.

n90 See *Kransco*, 33 *U.S.P.Q.2d* at 2001 (misinterpreting *Shakespeare* by concluding that "functionality is not a ground upon which an incontestable trademark can be challenged") (emphasis added).

n91 See generally Lanham Act, ch. 540, § § 15, 33, 60 Stat. 427, 433-34, 438-39 (codified as amended at 15 *U.S.C.* § 1065 (1994) and 15 *U.S.C.* § 1115 (1994 & Supp. IV 1998) respectively).

n92 No. 95- C2004, 1996 *U.S. Dist. LEXIS* 19275, at *1 (N.D. Ill. Dec. 10, 1996).

n93 *Id.* at *4-5.

n94 Davis, *supra* note 8, at 25.

n95 Northwestern, No. 95- C2004, 1996 *U.S. Dist. LEXIS* 19275, at *47 (N.D. Ill. Dec. 10, 1996).

n96 See *Qualitex Co. v. Jacobson Prods. Co.*, 514 *U.S.* 159, 34 *U.S.P.Q.2d* (BNA) 1161 (1995).

n97 *Id.* at 164, 34 *U.S.P.Q.2d* at 1163 (citations omitted).

n98 *Wilhelm Pudenz v. Littlefuse, Inc.*, 177 F.3d 1204, 1206, 51 U.S.P.Q.2d (BNA) 1045, 1045 (11th Cir. 1999) (noting that Littlefuse and its licensees sell nearly 100% of the automotive blade fuses sold in the United States, while German-based Wilhelm Pudenz has a significant share of the European market for automotive blade fuses).

n99 *Id. at 1206*, 51 U.S.P.Q.2d at 1045-46. One registration covered the two-dimensional outline of the ATO fuse, while the other registration covered the threedimensional configuration of the ATO fuse housing. These two trademarks have since been cancelled.

n100 See *id.*

n101 See *id.*

n102 See *id.*

n103 *Id. at 1209*, 51 U.S.P.Q.2d at 1048.

n104 *Id. at 1208*, 51 U.S.P.Q.2d at 1049.

n105 *Id.*

n106 See *id.*

n107 *Id. at 1211*, 51 U.S.P.Q.2d at 1050.

n108 *Id. at 1211-12*, 51 U.S.P.Q.2d at 1050.

n109 *Id. at 1212*, 51 U.S.P.Q.2d at 1050.

n110 *Shakespeare Co. v. Silstar Corp. of Am., Inc.*, 9 F.3d 1091, 1099, 28 U.S.P.Q.2d (BNA) 1765, 1772 (4th Cir. 1993) (Niemeyer, J., dissenting).

n111 *Id. at 1106*, 28 U.S.P.Q.2d at 1777-78 (Niemeyer, J., dissenting).

n112 *Pudenz, at 1207-08*, 51 U.S.P.Q.2d at 1046-47.

n113 See 35 U.S.C. § 154 (1994) (stating that the term of a patent is twenty years from its filing date).

n114 See generally Trademark Law Treaty Implementation Act, Pub. L. No. 105-330, § 201, 112 Stat. 3064, 3069-70 (1998) (codified as amended in scattered sections of 15 U.S.C. (1994 & Supp. IV 1998)).

n115 See *id.*, § 201(a)(4), 201(a)(9) (codified as amended in 15 U.S.C. § 1064(3) (cancelling a registration) (1994 & Supp. IV 1998) and 15 U.S.C. § 1115(b)(8) (defending a registration) (1994 & Supp. IV 1998) respectively).

n116 See 1 MCCARTHY, *supra* note 10, § 7:84, at 7-197 (rel. no. 10, June 1999).

n117 See *id.*

n118 See *id.*

n119 See generally U.S. CONST., art. I, § 8, cl. 8.

n120 See Trademark Law Treaty Implementation Act, Pub. L. No. 105-330, § 201(a)(4), 201(a)(9), 112 Stat. 3064, 3069-70 (1998) (relevantly codified as amended in

15 U.S.C. § 1064(3) (1994 & Supp. IV 1998) (cancelling a registration) and 15 U.S.C. § 1115(b)(8) (1994 & Supp. IV 1998) (defending a registration) respectively).

n121 *Wilhelm Pudenz v. Littlefuse, Inc.*, 177 F.3d 1204, 1211-12, 51 U.S.P.Q.2d (BNA) 1045, 1050 (11th Cir. 1999).

n122 See *id.* at 1209, 51 U.S.P.Q.2d at 1048.

n123 See *id.* at 1211-12, 51 U.S.P.Q.2d at 1050.

n124 5 MCCARTHY, supra note 10, § 32:142, at 32-205 (rel. no. 10, June 1999) (citing Anthony L. Fletcher, Incontestability and Constructive Notice: A Quarter Century of Adjudication, 63 TRADEMARK REP. 71, 72 (1973)).

n125 *Id.* at 32-205 to 32-206 (emphasis added).

n126 See *id.* at 32-206.

n127 Compare 15 U.S.C. § 1115(a) (1994 & Supp. IV 1998) (noting that registration on the principal register is prima facie evidence of a valid mark) with 15 U.S.C. § 1065 (1994 & Supp. IV 1998) (indicating that an incontestable mark is conclusive evidence of validity).

n128 See 15 U.S.C. § 1065 (1994 & Supp. IV 1998).

n129 5 MCCARTHY, supra note 10, § 32:148, at 32-212 (rel. no. 10, June 1999).

n130 *Id.*

n131 See *id.* (noting that in *Dakota Industries, Inc. v. Ever Best Ltd.*, 28 F.3d 910, 31 U.S.P.Q.2d (BNA) 1355 (8th Cir. 1994), the trial court improperly permitted the jury to consider and decide whether plaintiff/registrant was not the owner of the mark that it was suing on and that ownership would be in issue only if implicated by proof of statutory defenses of laches and abandonment).

n132 Telephone Interview with Jason M. Drangel, Bazerman & Drangel, P.C., (Feb. 2, 2000). Mr. Drangel noted that although incontestability does not immediately remove disputes over incontestable marks from the Patent and Trademark Office (.PTO.), there are grounds which require contestants first to seek relief in the courts. For instance, an issue of whether an incontestable mark had become abandoned may be brought before the PTO. However, where two individuals assert separate rights in a mark, and one individual's mark has become incontestable, the issue of which mark has priority will have to be raised before the court, not the PTO. Mr. Drangel noted that the potential that some incontestable marks would need to be pursued at the court level may actually serve as a deterrent to many potential litigants.

n133 See 5 MCCARTHY, supra note 10, § 32:153, at 32-218 (rel. no. 10, June 1999) (If the elements of one of the § 33(b) exceptions is proven, the evidentiary status of the registration drops down from "conclusive" to "prima facie" and defendant is permitted to prove "any legal or equitable defense or defect which might have been asserted if such mark had not been registered.").

n134 See *id.* at 32-218 n.6 (noting that a " § 33 defense, if proven, does no more than destroy the conclusive evidentiary status of the registration").

n135 Id., § 32:147, at 32-211.

n136 See id. (rationalizing that even with the flawed labeling, "it is a mistake to count possible exceptions and unthinkingly equate quantity with quality and importance. Incontestable status is by no means an empty formalism.").

n137 See 1 MCCARTHY, supra note 10, § 7:69, at 7-149 (rel. no. 10, June 1999) ("It seems there are as many definitions of what is 'functional' as there are courts.").

n138 See BLACK'S LAW DICTIONARY 769 (7th ed. 1999).

n139 See id. Ironically, the label seems far more fitting here, particularly under the health insurance provision, than as coined in trademark law. As applied towards insurance law, there actually exist grounds for allowing rights later, in that which would have served as a basis for policy denial prior to the effective date of issuance. Conversely, under the Lanham Act's incontestable provision, that which should have prevented trademark registration initially can serve as a cancellation or defense measure later. The one real exception is mere descriptiveness after Park 'N Fly, but even there, a presumption of secondary meaning has attached to the mark.

n140 WEBSTER'S NINTH NEW COLLEGIATE DICTIONARY 610 (1st ed. 1984). Indisputable is defined as "not disputable: UNQUESTIONABLE." Id. at 614. Neither incontestable nor indisputable is an appropriate label of a status that exists with far greater exceptions than allowances.

n141 See id. at 283. Contest(able), rather, is defined in the first entry as "to make the subject of dispute, contention, or litigation, esp: DISPUTE, CHALLENGE." The second entry adds "a struggle for superiority or victory: COMPETITION." In a balancing act, contestable seems to be a more fitting label than incontestable, since an incontestable mark is anything but what it asserts to be.

n142 See 5 MCCARTHY, supra note 10, § 32:147, at 32-211 (rel. no. 10, June 1999) (rights were diluted and changed but the label of "incontestability" was not.).

n143 Id.

n144 Compare 15 U.S.C. § 1115(a) (1994) (noting that registration on the principal register is prima facie evidence of a valid mark) and 15 U.S.C. § 1057(b) (1994) (noting that registration on the principal register is prima facie evidence of a valid mark) with 15 U.S.C. § 1065 (1994) (indicating that incontestable marks are conclusively presumed valid).

n145 See 5 MCCARTHY, supra note 10, § 32:148, at 32-212 to 32-213 (rel. no. 10, June 1999) (noting the key foreclosed challenges to incontestable marks).

n146 See Percy E. Williamson, Trademarks Registered Under the Lanham Act Are Not "Incontestable", 37 TRADEMARK REP. 404 (1947)); see also 5 MCCARTHY, supra note 10, § 32:147, at 32-211 to 32-212 (rel. no. 10, June 1999).

n147 5 MCCARTHY, supra note 10, § 32:147, at 32-211 to 32-212 (rel. no. 10, June 1999).

n148 See generally *15 U.S.C. § 1057(b)* (1994 & Supp. IV 1998) and *15 U.S.C. § 1115(a)* (1994) (noting that registration on the principal register is prima facie evidence of the validity of the registered mark).

n149 *15 U.S.C. § 1065* (1994 & Supp. IV 1998).

n150 *Id.* (suggesting that the current title that reads "Incontestability of right to use mark under certain conditions" be changed to instead read "Right to use mark under certain conditions").

n151 See *15 U.S.C. § 1057(b)* (1994 & Supp. IV 1998) (noting that registration on the principal register is prima facie evidence of a valid mark).

n152 See generally BLACK'S LAW DICTIONARY 290 (6th ed. 1990) (defining relevant conclusive terminology):

Conclusive. Shutting up a matter; shutting out all further evidence; not admitting of explanation or contradiction; putting an end to inquiry; final; irrefutable; decisive. Beyond question or beyond dispute; manifest; plain; clear; obvious; visible; apparent; indubitable; palpable.

Id.

Conclusive evidence. That which is incontrovertible, either because the law does not permit it to be contradicted, or because it is so strong and convincing as to overbear all proof to the contrary and establish the proposition in question beyond any reasonable doubt.

Id.

Conclusive presumption. Exists when an ultimate fact is presumed to be true upon proof of another fact, and no evidence, no matter how persuasive, can rebut it; an example is the presumption that a child less than a specified age is unable to consent to sexual intercourse. . . . Sometimes referred to as irrebuttable presumption.

Id.

n153 See *15 U.S.C. § 1065* (1994) (indicating that incontestable marks are conclusively presumed valid).

n154 The author notes that, much like the TLT Act changes, these revisions would merely constitute technical corrections of what already exists within the trademark law. See Trademark Law Treaty Implementation Act, Pub. L. No. 105-330, 112 Stat. 3064 (1998) (codified as amended in scattered sections of 15 U.S.C. (1994 & Supp. IV 1998)). Furthermore, conclusive already expressly exists within the Lanham Act, unlike the TLT

Act corrections which added the previously unenumerated word functionality. See *id.* at § 201.

n155 *15 U.S.C. § 1065* (1994).

n156 See *id.*

n157 See 1 MCCARTHY, *supra* note 10, § 7:63, at 7-135 (rel. no. 10, June 1999).

n158 See *id.*

n159 See BLACK'S LAW DICTIONARY 682 (7th ed. 1999).

n160 See R. Lawton Jordan III, Thomas & Betts Corp. v. Panduit Corp.-Toward a Coherent View of Trade Dress Protection for Product Configurations, 6 *J. INTELL. PROP. L.* 323, 323 (1999) (reviewing rationale behind patent law).

n161 See, e.g., *Shakespeare Co. v. Silstar Corp. of Am., Inc.*, 9 *F.3d* 1091, 28 *U.S.P.Q.2d* (BNA) 1765 (4th Cir. 1993).

n162 Trademark Law Treaty Implementation Act, Pub. L. No. 105-330, § § 201(a)(4), 201(a)(9), 112 Stat. 3064, 3069-70 (1998) (relevantly codified as amended in *15 U.S.C. § 1064(3)* (1994 & Supp. IV 1998) (cancelling a registration) and *15 U.S.C. § 1115(b)(8)* (1994 & Supp. IV 1998) (defending a registration) respectively).

n163 *Id.*

n164 *Wilhelm Pudenz v. Littlefuse, Inc.*, 177 *F.3d* 1204, 1211-12, 51 *U.S.P.Q.2d* (BNA) 1045, 1050 (11th Cir. 1999).

n165 *Shakespeare Co. v. Silstar Corp. of America, Inc.*, 9 *F.3d* 1091, 28 *U.S.P.Q.2d* (BNA) 1765 (4th Cir. 1993).

n166 *Pudenz*, 177 *F.3d* at 1211-12, 51 *U.S.P.Q.2d* at 1050.

n167 See *id.*