

The Ragged Edge of the Lanham Act

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Query: How does the Lanham Act structure the interface between the USPTO and the Federal Courts?

Examples:

- Registrability vs. Enforceability
- Judicial Review and Standing
- Preclusion & Deference

Theoretical Instability at the Boundary: What is
Registration For?

PTO-Article III Interaction

Registrability vs. Enforceability

• Incontestability: §§ 14(2), 15: *Park 'N Fly v. Dollar Park & Fly*

• § 2 Bars vs. Common Law:

• §2(a): *Pro-Football, Inc. v. Blackhorse*

• §2(b): *Renna v. County of Union, NJ*

• §2(e)(1) & 2(e)(3)? Deceptive Marks and 43(a)(1)(a)

PTO-Article III Interaction

Judicial Review and Standing: § 21

- 21 (a): direct appeal to CAFC; *cf. Dickinson v. Zurko*
- 21 (b): *de novo* action in E.D. Va.
 - “The Director shall not be made a party to an inter partes proceeding under this subsection.”
 - Motion to Dismiss in *Pro-Football, Inc. v. Blackhor*

PTO-Article III Interaction

Preclusion & Deference: *B&B Hardware v. Hargis*

- Are legal and factual issues in registration proceedings distinct from issues in infringement litigation?
- Is the PTO entitled to deference on the legal and factual issues they decide, and does the answer depend on whether they are distinct from issues that arise in subsequent infringement litigation?

What is Registration For?

Procedural View

Notice

Evidentiary record for first-in-time system of rights

Inducement to register: provide notice, avoid future disputes

Substantive View

Offense-Side Incontestability (*Park N' Fly*)

Nationwide Priority

Remedial Advantages (e.g., criminal penalties, destruction, enhanced damages)

Evidentiary Benefits (presumption of validity of notice)

What is Registration For?

Implications of Substantive View

Section 2 has First Amendment Problems

Standing less controversial

PTO probably entitled to deference

Pre-emption of State Law?

Implications of Procedural View

Divergence of §2 and common-law protectability standards probably unsupportable

Standing in the absence of a live infringement suit more problematic

Less clear that judicial deference is warranted

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