Trademark Defenses That Aren't

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Courts and lawyers habitually refer to a number of doctrines in trademark law as "defenses." Treatises and casebooks examine areas such as functionality, fair use, and geographic limitations (among others) independently from the prima facie case for liability. A closer examination of these so-called "defenses" demonstrates that most are not defenses at all. Indeed, it is not too great an exaggeration to suggest that, with the possibility of a few inconsistent exceptions, there may be no such thing as a trademark defense.

Despite the Supreme Court's admonishment in the *KP Permanent* case that defenses sometimes prevail over concern over consumer confusion, most lower courts continue to smuggle the confusion issue into supposedly independent defenses. The question almost always boils down to the same issue that lies at the heart of every other trademark case. All too often, the answer to this question depends on a normative account of trademark law that seeks to eliminate any and all confusion, no matter how hypothetical, transient, or irrelevant.

This confusion-focused approach leads to several problems. First and foremost, confusion is not the only value at stake in trademark law. The lack of real defenses obscures several free-standing countervailing concerns such as fair competition, free expression, and maintenance of the boundaries between trademarks and other forms of intellectual property. Courts never have to think hard about whether these competing values might outweigh confusion, and they never develop any metric for considering how much confusion might be tolerable on the other side. The absence of defenses also raises procedural obstacles for litigants who might rely on arguments about values other than confusion avoidance. And finally, it may fuel the tendency of courts to interpret the nature of confusion ever more expansively.

We expect our project to examine systematically the various trademark "defenses" that, it turns out, aren't defenses after all. Building on our own prior work and that of other recent trademark scholarship, as well as on some other areas of law with more robust defenses, we hope to suggest possible responses to the stunted development of trademark defenses. In doing so, we also hope to shed more light on the overall structural deficiencies of trademark doctrine.