

THE ZOMBIE TRADEMARK: A WINDFALL AND A PITFALL*

*By Jerome Gilson** and Anne Gilson LaLonde****

I. INTRODUCTION

*“They keep coming back in a
bloodthirsty lust for HUMAN FLESH! . . .
Pits the dead against the living
in a struggle for survival!”¹*

Beware trademark owners! Protect yourselves from the attack of the undead brands! Yes, zombie trademarks, spawned by trademark abandonment and the cachet of still-remembered brand names, walk among us.² A zombie business scavenges in the trademark graveyard for one that still has marketing potential. It then resurrects one, for little or no cost, that the public still associates with the original product, and applies it to an entirely new one. The public’s memory of the original mark, also known as residual goodwill, has a twofold zombie advantage. It can trigger instant (if mistaken) demand for the new product, reduce advertising costs and raise profits. Yes, zombie businesses roam the countryside, trafficking in trademarks, and thriving by feeding, not on human flesh, but on residual goodwill. Beware!

The question is, can a business, having abandoned its rights to a trademark, prevent a newcomer from bringing the dead mark

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1. From the theatrical poster for the 1968 classic horror film “Night of the Living Dead,” directed by George A. Romero. See http://en.wikipedia.org/wiki/Night_of_the_living_dead.

2. A “zombie,” in the voodoo cult, is a “corpse brought back to life by supernatural power.” Chambers Dictionary of Etymology 1257 (2005). In the popular American idiom, however, the term has taken on a more macabre meaning. From “Night of the Living Dead,” and as seen in books, games and other movies, zombies are corpses, often with rotting flesh, that come with a stiff-legged gait in waves, looking for flesh to eat, or humans to kill or infect. See <http://en.wikipedia.org/wiki/Zombies>.

back to life like a zombie? Generally, it cannot. An abandoned mark is available to anyone, first come, first served.³ However, unless the newcomer is very, very careful, it can easily deceive the public.

In theory, anyone can rummage through the abandoned marks of yesteryear and find one with commercial magnetism to redevelop, sell or license. However, unless the newcomer duplicates the original branded product, and its quality, and notifies the public that it is not connected with the original trademark owner, the use of the mark is almost certain to deceive and confuse the public. Zombie trademarks are inherently deceptive. David S. Ruder, formerly CEO of a leading zombie company, River West Brands LLC, recognized the problem when he wrote, “[I]t is true that there may be some confusion in the marketplace when a discontinued brand is reintroduced by a new user.”⁴ Indeed, consumers drawn to the new product by the familiar trademark and expecting the same product as before cannot help but be deceived.

Is there a way to protect the public from zombie marks? To date, the law is in limbo. Because the original owner may be powerless⁵ and the Federal Trade Commission may choose not to intervene, there is no direct means of protecting consumers from a zombie attack. In this article, however, we examine existing trademark and false advertising law that points toward protection

3. See, e.g., *Cumulus Media, Inc. v. Clear Channel Commc'ns, Inc.*, 304 F.3d 1167, 1173 (11th Cir. 2002) (holding that “a defendant who successfully shows that a trademark plaintiff has abandoned a mark is free to use the mark without liability to the plaintiff”); *California Cedar Prods. v. Pine Mountain Corp.*, 724 F.2d 827, 830 (9th Cir. 1984) (“The first party to use an abandoned trademark in a commercially meaningful way after its abandonment, is entitled to exclusive ownership and use of that trademark.”); *General Cigar Co., Inc. v. G.D.M., Inc.*, 988 F. Supp. 647, 658 (S.D.N.Y. 1997) (“Once abandoned, the mark reverts back to the public domain whereupon it may be appropriated by anyone who adopts the mark for his or her own use.”); *Sutton Cosmetics (P.R.) Inc. v. Lander Co., Inc.*, 170 U.S.P.Q. 461, 462-63 (S.D.N.Y. 1971) (“When a trademark has been abandoned, the effect is to leave the subject matter open to adoption for use as a mark by others. . . . It may be seized immediately and the person so doing acquires a right superior to the entire world.”), *aff'd and modified on other grounds*, 455 F.2d 285 (2d Cir. 1972).

See generally 1 Anne Gilson LaLonde, *Gilson on Trademarks* § 3.05 [hereinafter *Gilson*] for more on trademark abandonment.

4. David S. Ruder, *Intellectual Property Law—The Fallacy of Trademark Residual Goodwill*, *GPSolo Magazine* 2 (March 2004) (ABA General Practice, Solo & Small Firm Division).

5. Mr. Ruder, the former River West CEO, has mentioned several steps that owners of discontinued marks might take to avoid the abandonment death knell. David S. Ruder, *New Strategies for Owners of Discontinued Brands*, 3 *Nw. J. Tech. & Intel. Prop.* 61 (2004), available at <http://www.law.northwestern.edu/journals/njtip/v3/n1/4>. The article rejects most of the possibilities and concludes, not surprisingly, that “sophisticated brand owners” should attempt to sell or license their discontinued brands.

against a zombie attack, and we will suggest applications of that law that would safeguard the public yet not unduly extend the rights of businesses that have abandoned their marks.

II. ZOMBIE TRADEMARKS DEFINED

Zombie brands are also called ghost brands, orphan brands, dinosaur brands, antique brands and graveyard brands.⁶ They are previously-abandoned, newly-revived trademarks that still enjoy a measure, sometimes an extraordinary measure, of consumer recognition and loyalty. Here, we use “zombie” to refer only to trademarks that have unquestionably become abandoned, both factually and legally. We will not cover marks that still have a pulse, about which there may be a question of whether, despite some period of nonuse, the owner intends to resume use, and for which there is no clear factual and legal abandonment.⁷ Nor do we refer to long-unused marks that are revived by their original owners.⁸

6. Daniel Gross, *Attack of the Zombie Brands!*, Slate Magazine (March 16, 2007), www.slate.com/id/2161805/; Daniel Gross, *Attack of the Zombie Brands II*, Slate Magazine, March 20, 2007, <http://www.slate.com/id/2162284/>; “Zombie Branding Back in the News,” NameWire (the product naming blog) (May 20, 2008), http://namedevelopment.com/blog/archives/2008/05/zombie_brand_na.html.

See also Rob Walker, *Can a Dead Brand Live Again?* N.Y. Times, May 18, 2008, available at <http://nytimes.com/2008/05/18/magazine/18rebranding-t.html>. For a U.K. view that “most disused brands remain the property of the original owner,” see BBC News, *Dead Brands Tell No Tales*, Sept. 7, 2001, <http://news.bbc.co.uk/1/hi/uk/1528919.stm>.

7. There has been a torrent of litigation over the issue of intent in cases where abandonment is raised as a defense to a charge of infringement. The decisions are fact-specific, and there are differing views on the burden of proof. See 1 *Gilson*, *supra* note 3, at § 3.05[3]. However, many courts hold that, because abandonment involves a potential forfeiture of rights, the party claiming it has a heavy burden. See, e.g., *Doebler’s Pa. Hybrids, Inc. v. Doebler*, 442 F.3d 812, 822 (3d Cir. 2006) (“A party arguing for abandonment has a high burden of proof. . . . [A]bandonment, being in the nature of a forfeiture, must be strictly proved.”) (citation omitted); *Cumulus Media, Inc.*, 304 F.3d at 1175 (“Because a finding of abandonment works an involuntary forfeiture of rights, federal courts uniformly agree that defendants asserting an abandonment defense face a ‘stringent,’ ‘heavy,’ or ‘strict burden of proof.’”) (citations omitted); *Hawaii-Pacific Apparel Group, Inc. v. Cleveland Browns Football Co.*, 418 F. Supp. 2d 501, 509 (S.D.N.Y. 2006) (“Because abandonment constitutes forfeiture of a property right, it must be proven by clear and convincing evidence.”).

8. Resumption of use by trademark owners is not uncommon. See, e.g., Stuart Elliott, *Those Shelved Brands Start to Look Tempting*, N.Y. Times, Aug. 20, 2008 (describing Kellogg’s reintroduction of its HYDROX mark for cookies with a 100th anniversary limited edition) and www.hydroxcookies.com (using the tag line “Did you miss me?”). Also, a witness for General Motors in the LA SALLE case described at Part III.B, *infra*, presented evidence that various automobile brands had been reintroduced after many years, including the Ford THUNDERBIRD after a decade-long hiatus, the Chevrolet MALIBU after 14 years, and the Pontiac GTO and Dodge CHARGER after 30 years. *General Motors Corp. v. Aristide & Co., Antiquaires de Marques*, 87 U.S.P.Q.2d 1179, 1183 (T.T.A.B. 2008). One can infer that the

Many consumers crave brands of years ago, out of nostalgia and the image of a seemingly more simple time. Some of these, once heavily advertised, are now unavailable, or are available only on eBay or at specialty outlets.⁹ The craving might even be called a craze, as the BrandlandUSA blog suggests in a post entitled “BrandlandUSA’s 100 Dead Brands To Bring Back,” listing F.W. WOOLWORTH, FISHER BODY, BURROUGHS COMPUTERS, B. ALTMAN, BURGER CHEF, McCALLS, LOOK, and TWA, among many others.¹⁰

III. THE ZOMBIE TRADEMARK BUSINESS MODEL

A business spots an inactive trademark with lasting goodwill, investigates, and with dreams of cashing in, sets out to clear the trademark decks. It determines that the original owner no longer uses the mark, and carefully verifies that the mark has been abandoned. Then, after confirming that no other user has intervened, it may file an intent-to-use trademark registration application with the U.S. Patent and Trademark Office (USPTO) based on a *bona fide* intent to use the mark in U.S. commerce (usually through a licensee), it may petition to cancel a registration of the mark if it is still on the Register, and it may pay a modest sum to the original owner for a quit-claim assignment or covenant not to sue, just to be safe. The last step is to arrange to market the product or service to the public under the zombie mark, which is frequently done under a license arrangement. Few zombie exploiters actually manufacture consumer goods or open restaurants.¹¹

original trademark owner has a vested interest in identifying the resumed-mark product closely with the earlier one, with perhaps improvements, and in the case of automobiles, differences in styling.

9. One such source is The Vermont Country Store, www.vermontcountrystore.com, which offers “Favorite Brands from the Past.”

10. See <http://brandlandusa.blogspot.com>. See also the related site, www.brandlandusa.com, “The branding news site where old brands live again.” We use block capitals and not stylized versions in this article, unless the mark appears differently in a quotation. Zombie marks are to date uniformly word marks, although conceivably they could be any mark, including designs, logos, configurations, and nontraditionals.

11. In his book, Mr. Ruder describes the business of his former employer, River West, and calls this practice intellectual property arbitrage. David S. Ruder, *Strategies for Investing in Intellectual Property: Intangible Valuations, Real Returns* (2008). He declares that “[o]ppportunistic investors” can make profitable investments by “acquiring and managing intellectual property without the worries of operational issues, management teams, and boardroom battles.” *Id.* at 97. Their efforts “focus on acquiring undervalued intellectual property assets out from operating businesses, re-purposing them and then turning them into revenue generating investments.” *Id.* He then explains that “[c]onsumer product brands lend themselves well to intellectual property arbitrage opportunities.” *Id.*

The business has no financial incentive to revitalize a mark that the public has forgotten or never knew. The marketing free ride depends wholly on the existence of ongoing public association of the mark with its original source, and the stronger it is, the better. Consumers must be able to recognize the mark, and ideally, recall it favorably from its previous lifetime: “Oh, look what’s back, BRAND X cookies! Wow!” Without current consumer recognition, there would be no zombie business: no residual goodwill, no zombie.

A. *Aristide & Co.*

Aristide & Co., Antiquaire de Marques, is located in Paris, France. Its website, www.aristide.fr, has a nineteenth-century look about it, telling the world that it is an antiques dealer. What sets it apart from dealing in Louis XIV furniture, for example, is that it deals in antique *brands* instead.¹² The site declares, “FINDUS, ATARI, PATAUGAS, T-LECLERC, CONTINENTAL EDISON, J-L SCHERRER, all these marks have disappeared, but not in the memory of consumers.”¹³ The company claims that its portfolio of 120 brands resonates in the fields of fashion, leisure, cosmetics and food, and the company stresses that the brands have “instant recognition.” Aristide advertises that the advantages of licensing or buying these brands from the company are numerous— cost savings, time savings, and notoriety—because the brands already enjoy goodwill among consumers.

Aristide began filing applications for trademark registration in the USPTO in 2004; some were based on an intent to use, some were filed under Section 66 of the Lanham Act¹⁴ based on a previous international registration filing, and one was filed under Section 44 of the Act based on a previously-filed international application. Some of the applications are pending, some are abandoned, and some have matured into registrations. The applications covered quite broad goods descriptions: WIDELUX is

Thus, he describes zombie brands, without explaining the term, as “arbitrage brands.” *Id.* at 100.

12. The Himmel Group, a 46-year-old marketer of consumer products with offices in New Jersey and Florida, also deals in part in vintage zombie brands. See www.himmelgroup.com/about-us/welcome.html. They say that “we have acquired old, but well-known trademarks that were mistaken for dead . . . revitalized them . . . and then sold them.” Residual goodwill is a key strategy component: “There are always old brand names that have withstood the test of time, and bring a lot to the table, such as brand equity, consumer awareness and trust. . . .”

13. What follows is loosely translated from the French.

14. The U.S. Trademark Act of 1946, as amended, is popularly known as the Lanham Act.

registered for cameras; VECTREX is registered for computer game software; LA SALLE is registered for automobiles; MOLYNEUX is pending registration for clothing; TIKTINER is pending registration for clothing; AST is pending registration on an application for computer hardware that has been suspended; ZENITH DATA SYSTEMS was pending registration on an application for notebook computers that has been abandoned; HUDNUT was pending registration on an application for various personal hygiene products that has been abandoned; TANDY was pending registration on an application for various technological devices that has been abandoned; and NEWTON was pending registration on an application for various technological devices that has been abandoned.

Some, perhaps all, are revivals of trademarks that had their heydays well over a decade ago, and some of them many decades ago. For example, the original registration for VECTREX for video output game machines, which had been owned by General Consumer Electronics, was cancelled in 1990, and according to the Fashion Guild Designer Label Image Resource, the MOLYNEUX mark was associated with Captain Edward Molyneux, who founded a fashion house in Paris in 1919, and closed it in 1950. He was considered to be one of the finest of the 1920s couturiers, and his elegant day dress became an icon of the period.¹⁵

However, just when everything seemed to be running smoothly, General Motors opposed Aristide's application to register the LA SALLE mark for automobiles in the USPTO.

B. The LA SALLE Case

General Motors claimed that it had sold LASALLE automobiles in the United States through its Cadillac Division from 1927 to 1940, and continued thereafter to supply parts for restoring LASALLE autos, and to license the mark in connection with a variety of goods. It alleged that the LASALLE mark maintained continued popularity, and that vehicle enthusiasts, the trade, and consumers continued to associate the mark with high-quality products from General Motors. Thus, it claimed that it would be damaged by Aristide's potential registration of LA SALLE by a likelihood of confusion as well as dilution.

Aristide, appearing *pro se*, did not file a brief or produce any evidence, but it did file an answer. Apparently forgetting that its website claimed that its marks had "instant recognition," Aristide contended that because no Cadillac LASALLE auto had been sold for 65 years, no one in an average family, with the exception of

15. See <http://www.vintagefashionguild.com/labels/jtom/m.html>.

grandmothers and grandfathers, would remember it. Without once mentioning “abandonment,” there was no question that this was its defense.

The Trademark Trial and Appeal Board (the “Board”) carefully analyzed General Motors’ evidence and found that with 65 years of nonuse, and no demonstrated plans to resume use of the LASALLE mark, there was indeed legal abandonment. The contention that historic brands are commonly reintroduced in the automobile industry was of no avail, nor did the licensing of the mark for vehicle parts in an agreement that also covered ninety other trademarks establish a new, independent, post-abandonment priority date. Thus, Aristide’s international application filing date gave it priority, and General Motors was unable to point to any evidence to overcome it.

The Board specifically found no evidence of residual goodwill in the LASALLE mark. It found that the evidence of clubs that collected LASALLE cars was not very significant, and it went on to state that “residual goodwill is not sufficient to avoid a finding of abandonment where the goodwill is generated through subsequent sales of a product by distributors or retailers.” Accordingly, in an opinion designated as precedent, the Board dismissed General Motors’ opposition.¹⁶ General Motors did not appeal, and the USPTO registered the LA SALLE mark to Aristide on August 12, 2008.

The LA SALLE trademark will become a true zombie if and when it is revived in actual commercial use. Because Aristide registered the mark based on Section 66(a) of the Lanham Act, it did not need to demonstrate actual use of it in commerce before a registration issued.¹⁷ It remains to be seen whether an automobile manufacturer will choose to buy or license it from Aristide and, if so, whether we will see a new generation of LA SALLE automobiles on the highways and byways of America.

C. River West Brands LLC

The Aristide model, which concentrates on ancient marks, differs noticeably from the approach taken by another zombie trademark business, River West Brands LLC. In the Aristide model, whatever trademark goodwill existed at one time may well have dissipated, or perhaps remain known only in the memories of grandparents. The model followed by River West disregards ancient marks in favor of those it calls “sleepy trademarks,” whose

16. General Motors Corp. v. Aristide & Co., Antiquaires de Marques, 87 U.S.P.Q.2d 1179 (T.T.A.B. 2008).

17. 15 U.S.C. § 1141h(a)(3); TMEP § 1904.01(d).

uses were discontinued more recently. Establishing independent rights in such marks would appear much more difficult, given the risk of infringement actions by the original owners. However, the incentives are clear. The more recent residual goodwill of youthful zombies would tend to be much stronger, and the financial rewards that much greater.

River West is located in Chicago. The River West website, www.riverwestbrands.com, says that it is in the business of “Brand Acquisition and Enterprise Development,” and goes on to state that it “identifies, acquires, redevelops, and monetizes iconic brand intellectual property that is significantly distressed.” It pursues opportunities “in the growing asset class of brand properties that are well known but dormant,” and it defines dormant as “out of use; small in volume and trending smaller; or occasionally brand components in bankruptcy cases.” It also claims on its website to be motivated by civic duty:

[B]rand icons are important parts of the history of “Americana” and American popular culture. When beloved brands fall by the wayside, so does a piece of history . . . to the dismay of countless consumers, who struggle to be heard, and rarely have a say in the matter. We aim to serve consumers of our brands, lapsed and new alike, and honor our history in the process.

Although there are other business factors involved, the core of River West’s business is residual goodwill, which it calls “strong and favorable brand awareness.” In an interview on NBC’s “Today Show” on May 30, 2008, Paul Earle, the President and Founder of River West, said, “We look for compelling modern day awareness and recall.”¹⁸ The company uses consumer surveys to determine whether and to what extent a target trademark’s goodwill measures up. Speed and low cost are essential. As Earle put it, “In this business, it’s critical to get relevant data quickly and relatively inexpensively. We don’t have a moment to spare. We’ll field a test, then be presenting the information 48 hours later.”¹⁹

River West’s “Select Present Day Holdings” stand as prime examples of brands that probably still resonate among many consumers: COLECO (toys and games), SALON SELECTIVES (hair care), EAGLE (salty snacks), BONWIT TELLER (apparel and accessories),²⁰ BRIM (coffee), UNDERALLS (undergarments),

18. Access the video at <http://www.msnbc.msn.com/id/21134540/vp/24888517#24888517> or through a link on River West’s website at <http://www.riverwestbrands.com/news.php/>.

19. See <http://www.zoomerang.com/stories/study-riverwest.htm>.

20. River West announced on May 20, 2008 that it was involved with its subsidiary Avenue Brands LLC in re-launching the “iconic upscale retail brand” BONWIT TELLER. It stated in a press release:

METRECAL (nutritional products), SILKIENCE (hair care), and ALMOST HOME (baked goods). It also says that it had a hand in the return to market of NUPRIN (analgesics), STRUCTURE (apparel and accessories), and RIVAL (pet food). The database of the USPTO is replete with dozens of River West applications for registration and registrations, covering marks down memory lane, such as IPANA, BURGER CHEF, MISTER DONUT, BUCKY BEAVER, OLD KING COLE, DUZ, and ROMPER ROOM. As of March 2007, the company had filed more than 100 applications for trademark registration, “all with an eye towards generating a portfolio of brands that are licensed out to manufacturers and retailers.”²¹

However, as happened with Aristide, River West also faced a challenge to one of its applications for trademark registration from an entity claiming to own the allegedly abandoned mark, but this time in federal court.

D. The PURITAN Case

On January 11, 2004, River West filed an application for trademark registration based on intent to use with the USPTO for the mark PURITAN for shortening and cooking oil, and on December 12, 2005, it filed another intent-to-use application for PURITAN for cooking oil. On June 1, 2006, River West filed a petition to cancel the existing U.S. registrations for PURITAN that were owned by Smucker Fruit Processing Company, one registration covering edible vegetable oil and the other for edible fats and oils. River West argued in its cancellation petition that Smucker had discontinued use of the marks for three years or more, and had therefore abandoned them.

After discovery in the Board cancellation proceeding, on May 8, 2008, Smucker filed a complaint in the United States District Court for the Northern District of Ohio against River West. Smucker denied abandoning the PURITAN mark. It did admit

Bonwit Teller, founded in 1895 by Paul Bonwit, operated for more than a century with premier locations and product offerings in high-end markets throughout the United States, most notably through its famous flagship store on Fifth Avenue in New York City. The iconic brand helped launch the careers of notable designers such as Henri Bendel and Calvin Klein, and “Bonwit’s” stores and brand-building efforts featured the work of renowned artists such as Andy Warhol, Salvador Dali, Richard Avedon, and Robert Rauschenberg. . . . “Bonwit Teller set the standard for the high-end shopping experience for a century,” said [fashion industry executive Andrei] Najjar. “I am excited to revitalize Bonwit’s heritage for today’s marketplace. Bonwit once outfitted fashion icons such as Jackie Kennedy and Grace Kelly—the new Bonwit will evoke that sense of glamour, with a modern twist.”

<http://www.reuters.com/article/pressRelease/idUS135614+20-May-2008+BW20080520>.

21. Ruder, *supra* note 11, at 99.

that it had not used the mark in commerce in 2007, but did state that it intended to relaunch the brand in connection with a new product formulation. Smucker did indeed relaunch the brand in January 2008 with “Crisco PURITAN Canola Oil with Omega-3 DHA.”

In its complaint, Smucker first requested a declaratory judgment that its PURITAN mark was valid and had not been abandoned. Next, it claimed that River West’s use of the mark constituted trademark infringement, unfair competition and dilution. Finally, along with corresponding Ohio state law claims, Smucker claimed that River West had committed fraud on the USPTO by signing the oaths on its applications for trademark registration, because River West had there averred that “to the best of the verifier’s knowledge and belief, no other person has the right to use such mark in commerce . . .” and because River West was aware at that time of Smucker’s superior rights in the PURITAN mark.²²

Unfortunately for us, the case settled within days, and there is no illuminating opinion of the federal court. The dispute was not without rancor, however. Smucker’s complaint described defendant River West’s business model as a “scheme to pirate goodwill, unlawfully register marks and deceive the public.” River West withdrew its petition to cancel Smucker’s U.S. registrations for PURITAN, and also abandoned its intent-to-use applications to register PURITAN. Smucker prevented its mark from joining the zombie horde by demonstrating that the mark had not, in fact, been abandoned.

IV. TRADEMARKS MUST BE USED OR THEY WILL BE ABANDONED

In order to claim trademark infringement under the Lanham Act, a plaintiff must own a valid trademark.²³ Under the Act, a trademark is deemed to be abandoned, and thus no longer valid, “[w]hen its use has been discontinued with intent not to resume such use.”²⁴ Proof of nonuse of a trademark for three consecutive

22. For more on fraud in the USPTO oath, see 3 *Gilson*, *supra* note 3, at § 11.08[3][a][iii][A].

23. *E.g.*, *Natural Answers, Inc. v. SmithKline Beecham Corp.*, 529 F.3d 1325, 1329 (11th Cir. 2008); *Applied Info. Sciences Corp. v. eBay, Inc.*, 511 F.3d 966, 969 (9th Cir. 2007); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 259 (4th Cir. 2007); *1-800 Contacts, Inc. v. WhenU.com, Inc.*, 414 F.3d 400, 406-07 (2d Cir. 2005); *Kos Pharms., Inc. v. Andrx Corp.*, 369 F.3d 700, 708-09 (3d Cir. 2004); *Platinum Home Mortgage Corp. v. Platinum Fin. Group, Inc.*, 149 F.3d 722, 726 (7th Cir. 1998).

24. 15 U.S.C. § 1127.

years constitutes a *prima facie* showing of abandonment.²⁵ Abandonment is a defense to a charge of infringement where the mark was abandoned before the newcomer began to use it.²⁶ At that point, newcomers are theoretically free to use the mark.²⁷

The Lanham Act abandonment provision in Section 45 is an outgrowth of the principle established over a century ago by the United States Supreme Court: “There is no such thing as property in a trade-mark except as a right appurtenant to an established business or trade in connection with which the mark is employed. . . . [T]he right to a particular mark grows out of its use, not its mere adoption. . . .”²⁸ The use requirement remains one of the most firmly imbedded principles in all of U.S. trademark law, and use in commerce is a cornerstone of the Lanham Act. The benefits of the Act are strictly contingent on trademark use, and they are withheld when use is absent. For example, a U.S. business generally cannot obtain a U.S. trademark registration, with its evidentiary and constructive use and notice benefits, without use.²⁹ Similarly, a U.S. business cannot pursue a Lanham Act infringement action based on a registered or unregistered trademark without having used its mark in commerce.³⁰

In the sweeping overhaul brought about by the Trademark Law Revision Act of 1988, the U.S. Congress raised the use bar even higher. In order to remove “deadwood” (trademarks that were no longer in commercial use) from the Federal Register, it shortened the registration term from 20 to 10 years. It did so to expunge from the Register thousands of unused trademarks, and, hinting at the possibility of future zombie marks, eliminated “marks on the Federal Register that are not being used but that

25. *Id.*

26. *See, e.g.,* Grocery Outlet, Inc. v. Albertson’s, Inc., 497 F.3d 949, 951 (9th Cir. 2007); Cumulus Media, Inc. v. Clear Channel Commc’ns, Inc., 304 F.3d 1167, 1173 (11th Cir. 2002); Hermes Int’l v. Lederer de Paris Fifth Ave., Inc., 219 F.3d 104, 110 (2d Cir. 2000); Restatement (Third) of Unfair Competition § 30(1) (1995).

27. *See supra* note 3.

28. United Drug Co. v. Rectanus Co., 248 U.S. 90, 97 (1918). Other early Supreme Court decisions were equally emphatic, and modern authority retains the same vitality. *See, e.g.,* Rosenruist-Gestau E Servicos LDA v. Virgin Enters. Ltd., 511 F.3d 437, 440 n.1 (4th Cir. 2007) (noting “the fundamental principle in American trademark law that ownership rights flow from actual use of the mark in commerce”). *See also* 1 *Gilson, supra* note 3, at § 1.03[7][c].

29. 15 U.S.C. § 1051(a)(1). However, Sections 44 and 66 of the Act provide exceptions when the applicant bases its U.S. application for registration upon a prior foreign trademark registration or upon a request for an extension of protection of a prior international registration. 15 U.S.C. §§ 1052(d), 1126(e). Ultimately, actual use of the mark in commerce is mandatory to continue such registrations in force.

30. *See* 2 *Gilson, supra* note 3, at § 7.02[5][a].

remain unavailable for others to use.”³¹ Congress also adopted a much stricter “use in commerce” standard in order to eliminate token or sham use as a basis for U.S. registration, for use affidavits and renewals, and for defenses against abandonment claims.³² Section 45 of the Lanham Act now explicitly defines “use in commerce” as the “bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.”³³ The amendment also specified:

For purposes of this Act, a mark shall be deemed to be in use in commerce – (1) on goods when – (A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, . . . and (B) the goods are sold or transported in commerce, and (2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce. . . .³⁴

All told, the Lanham Act requirement of “use in commerce” has never been more strict.

However, the Act is silent on the significance of post-abandonment consumer association with a mark, or residual goodwill, as a factor in or as an exception to the explicit loss of rights. Congress appears never to have considered such an exception, although some courts have done so on their own, as have some commentators.³⁵ The lingering question is whether residual goodwill has any legal status at all.

31. H. Rep. No. 100-1028, at 7 (1988), *reprinted in* 10 *Gilson*, *supra* note 3, at VI-439.

32. “[T]he bill’s definition of use in commerce will have a dual effect on token use, thereby reducing the number of registered marks for which commercial use has not been made, and it will increase the use requirements both for maintaining registrations at the time section 8 and renewal applications are filed and for defending marks against a claim of abandonment.” S. Rep. No. 100-515, at 7 (1988), *reprinted in* 10 *Gilson*, *supra* note 3, at VI-312.

33. 15 U.S.C. § 1127.

34. *Id.*

35. Some commentators have argued that residual goodwill should prevent abandonment. Michael S. Denniston, *Residual Good Will in Unused Marks—The Case Against Abandonment*, 90 TMR 615 (2000); Stanley A. Bowker, Jr., *The Song is Over But the Melody Lingers On: Persistence of Goodwill and the Intent Factor in Trademark Abandonment*, 56 Fordham L. Rev. 1003 (1987-88) (pre-TLRA). On the other hand, Mr. Ruder, the then-CEO of zombie business River West, took the opposite position, which is a position more in line with the business of his company. Ruder, *supra* note 4. Yet another commentator argued that trademark abandonment is not affected by residual goodwill or persisting public recognition. Mitchell E. Radin, *Selected Issues Arising Under the Doctrine of Trademark Abandonment*, 79 TMR 433, 460-68 (1989). Perhaps the most extreme position is stated in the title of the following article by Robert A. Kargen, *Trademark Law—The First User of an Abandoned Trademark Acquires the Secondary Meaning Associated with the Abandoned Mark by Virtue of His First Use*, 64 TMR 8 (1974).

V. THE RESIDUAL GOODWILL DILEMMA

Once a consumer has favorable mental associations with a trademark and is satisfied with the accompanying product, “the trademark has come to symbolize the good will of its owner by encouraging repeat purchases by the consumer.”³⁶ Goodwill is a delicate form of intangible property that is inextricably bound up with a trademark; the two are legally inseparable. However, in the zombie context, the mark symbolizes not the goodwill of the current owner but the goodwill of the original owner. That is, consumers correctly associate most trademarks with their actual sources, while the very purpose of resurrecting a zombie mark is to cause consumers to associate it with a false source.

The dilemma here is that while a mark that is abandoned is free for others to use, reanimating them as zombies for the same or similar goods, or even different goods, will inevitably deceive consumers. Nothing is said, for example, on either Aristide’s or River West’s website about duplicating the products and the level of quality that consumers at one time regarded favorably, and may still favor, nor is anything candidly said to notify the public that neither has any connections to the prior owners. The zombie trademark user is convinced that it is free to sell any products or services at any level of quality it wants, regardless of demonstrable injury to the public, and subject only to safety and other such regulations.

Note, for example, the use made of two of the zombie marks acquired by River West. It acquired the COLECO trademark, which was abandoned in 1980 after a bankruptcy of the prior owner, and River West turned it into a zombie. COLECO was originally known as a mark for handheld video games, such as head-to-head football and Donkey Kong. However, President and Founder of River West Paul Earle stated, “We have ambitious plans for Coleco. We see it as a master brand that could have relevance in a lot of categories.”³⁷ River West also licensed the METRECAL zombie mark, for use on a line of drinks, which had been previously described as “the diet drink of the 1960s.” One news source said that “nothing about the new Metrecal resembles the old.” The formula is different (the original is owned by Mead Johnson), and instead of rum punch, Danish coffee and eggnog, the modern version is available only in chocolate, strawberry-banana and vanilla. Despite the fact that the new thin, bright green cans do not resemble the squat, white steel cans of yesteryear, consumers may well believe that the distinctive METRECAL mark

36. 1 *Gilson*, *supra* note 3, at § 1.03[6].

37. Crain’s Chicago Business News, Sept. 19, 2005, at 23.

signifies a particular taste from certain ingredients, as in the past. However, as the River West licensee proudly proclaimed, “This isn’t your father’s Metrecal.”³⁸

Yet, it is those very factors of product composition and quality that consumers associated with the original trademark and that established a potent and lasting favorable consumer impression. The original positive consumer association with those specific products and their quality lies at the very heart of trademark goodwill, past and present. When a company with no connection with or obligation to the original trademark owner markets different or reformulated products under an identical zombie mark, the practice can only generate consumer confusion, and ultimately disappointment.³⁹

Mr. Ruder wrote a lengthy article while still CEO of River West, entitled “The Fallacy of Trademark Residual Goodwill,” which was published in the American Bar Association Section of Intellectual Property Newsletter.⁴⁰ He contended that there is “almost no support whatsoever for the residual goodwill theory in trademark law or practice.” If that were true, it would simplify greatly River West’s ability to appropriate abandoned marks with present day goodwill, to exploit them for profit as zombies, and to sidestep trademark infringement actions. “Residual goodwill,” he continued, “if it even exists, does not give the previous trademark owner any right to prevent the new user’s acquisition and employment of the mark.” He ultimately equated an attempt to enforce trademark rights based on residual goodwill with nothing more than an attempt to stifle competition.⁴¹

38. Crain’s Chicago Business News, April 25, 2005, at 2.

39. “There is something reassuring about finding a brand from the past on the shelf. I liken it to running into a long lost friend. . . . But if I were lucky enough to find any one of these brands (BONNE BELL TEN-O-SIX and LOVE’S BABY SOFT) in the store, and realize they were not the original formulations, I would be very disconcerted and put off. Memories are so solely connected to the heart, and if you try to dupe the memory, you risk breaking the heart.” Online reader comment on Walker’s article, “Can a Dead Brand Live Again?” *supra* note 6. Another writer’s mother was pleased to see WHITE STAG clothing at Wal-Mart and had memories of buying it in the ’80s. However, she felt that the current product “has absolutely nothing to do with the original product with regards to design, quality, production . . . so while resurrecting an old favorite brand may reopen a door with the consumer . . . the new product must deliver something of the referenced quality . . . or the customer loyalty will be lost again.” *Id.* “Given that consumers will probably think that their ‘favorite’ lost brand is back in its original form, they may be sorely disappointed when they repurchase. If the relaunched brand and its products don’t meet or exceed consumers’ memories, won’t the revival be short-lived? What is the brand equity worth at that point?” *Id.*

40. David S. Ruder, *The Fallacy of Trademark Residual Goodwill*, 22 ABA Section of Intellectual Property Law Newsletter 1 (Fall 2003).

41. Ruder concluded, “Ultimately, those who argue most passionately for residual goodwill and against trademark abandonment are brand owners and their lawyers who

A. The State of the Law of Residual Goodwill

Residual goodwill is not mentioned in the Lanham Act, but courts have been influenced by it. Why? There is judicial resistance to the unfettered use of a trademark that generates public deception and confusion. Also, there is authority requiring lawful users of confusing trademarks and generic terms to take steps in packaging and marketing their products to minimize or eliminate confusion.

1. The Views of Federal Courts

United States federal courts have struggled with the concept of residual goodwill. Some seem hostile to applying a principle that allows anyone to adopt an abandoned trademark and to begin using it, yet to date no court has protected a truly abandoned mark on the basis of residual goodwill, alone.

Some courts have flatly refused to find residual goodwill relevant in an abandonment case. For example, the Fifth Circuit Court of Appeals made clear, in a 1983 opinion, that the Lanham Act requires a mark owner to be using the mark or intend to resume its use in order to avoid a finding of abandonment.⁴² It went on to add, “The Act does not allow the preservation of a mark solely to prevent its use by others. Yet the trial court’s reasoning allows precisely that warehousing so long as there is residual goodwill associated with the mark. . . . While that may be good policy, we cannot square it with the language of the statute.”⁴³

However, other courts have found that the existence of residual goodwill in an unused mark could theoretically prevent a newcomer from adopting the same mark and trade dress for a competing product, especially where consumer confusion is likely. The D.C. Circuit Court of Appeals in 1950 proclaimed colorfully that it is not the law “that the slightest cessation of use causes a trademark to roll free, like a fumbled football, so it may be pounced upon by any alert opponent.”⁴⁴ In another more recent

want to eliminate competition. Contrary to their arguments, the trademark abandonment system currently in place is an efficient way to ensure that trademark owners are not in a position to abuse their power and impede competition in the name of alleged consumer confusion. The current system serves upstarts and entrepreneurs that are engaged in the valuable process of introducing products in the marketplace and benefiting consumers.”

42. *Exxon Corp. v. Humble Exploration Co.*, 695 F.2d 96, 100 (5th Cir. 1983).

43. *Id.* at 101. *See also* *Newsouth Commc’ns Corp. v. Universal Tel. Co.*, 2002 U.S. Dist. LEXIS 18969 (E.D. La. 2002) (holding that the existence of residual goodwill does not allow a trademark owner to “warehouse” the mark without making actual use of it) (following *Exxon Corp.*).

44. *Continental Distilling Corp. v. Old Charter Distillery Co.*, 188 F.2d 614, 619 (D.C. Cir. 1950) (footnote omitted).

case, *Luger v. Silver Star Meats*, the U.S. district court ruled that a company that had purchased the goodwill and trade dress rights to a product still had rights to any residual goodwill in that mark although it had made a transition to a new brand name.⁴⁵ There, the court declared that, because of residual goodwill,

any newcomer acts outside legal boundaries when it intentionally adopts the same name for a directly competing product in the same market, and uses substantially similar trade dress and even the word “Classic,” thus implying that it is somehow a successor product. To hold otherwise would result in unfair competition through intentionally creating public confusion as to the source and origin of the products they buy. Whether it abandoned the name or not, that action did not confer a right upon the defendants to unfairly compete in this fashion.⁴⁶

Despite the strong language in these opinions, in none of these cases did the court actually find that a mark owner avoided abandonment due to residual goodwill alone. The marks were found not to have been abandoned in the first place, either because the mark was discontinued for only brief periods of time or because the mark owner intended to reintroduce the mark. The *Luger* case out of the Western District of Pennsylvania came the closest to relying on residual goodwill alone, holding in dicta that even if the defendants had succeeded in proving that the plaintiff had abandoned its mark, it would still grant injunctive relief “in order to prevent confusion caused by the residual association of the . . . name and trade dress with its former user.”⁴⁷

In another case, the Seventh Circuit Court of Appeals did protect an abandoned trademark where the original owner had no

See also *American Photographic Publ'g Co. v. Ziff-Davis Publ'g Co.*, 135 F.2d 569, 573 (7th Cir. 1943) (use of former periodical name on masthead of other periodical) (“We do not wish to be understood as holding that the day after the owner of a trade-mark ceases to publish a periodical under one title and begins to publish it under another, carrying the former title on the masthead, some person could appropriate it with impunity, for he could not. We are passing only on the situation here presented, where there has been discontinuance of the former publication for more than twenty years, coupled with evidence to show abandonment.”).

Cf. Merry Hull & Co. v. Hi-Line Co., Inc., 243 F. Supp. 45, 50 (S.D.N.Y. 1965) (“This is not to say, however, that goodwill can exist only in connection with an active going business and that at the moment business is suspended the goodwill ceases to exist for if this were so there would be few instances where a mark could be transferred in a bankruptcy sale, and little need for the Bankruptcy Act to provide for the vesting of title to trademarks in the Trustee.”).

45. *Peter Luger, Inc. v. Silver Star Meats, Inc.*, 63 U.S.P.Q.2d 1555 (W.D. Pa. 2002).

46. *Id.* at 1557.

47. *Id.* at 1567.

intent to resume use and made no use of the mark after abandonment.⁴⁸ However, the plaintiff in that case had adopted a new, similar mark to replace its abandoned mark, and that new mark was itself confusingly similar to the defendant's mark. The plaintiff, the Indianapolis Colts football team, abandoned the trademark BALTIMORE COLTS when the team moved from Baltimore to Indianapolis. The defendant, another football league, wanted to name a new team the BALTIMORE CFL COLTS. The Seventh Circuit noted that when a mark is abandoned, in principle it returns to the public domain and is appropriable by another party. However, in practice, the court noted that a party making subsequent use of an abandoned mark may have to take precautions to prevent consumer confusion.⁴⁹ It stated that such a requirement would be even more important in a case such as that one, in which the former owner of the abandoned mark continued to market the same product or service under a similar name.

Other courts have ruled that the existence of residual goodwill, coupled with an intent to resume use of the mark, can avoid a finding of abandonment. The case most often cited for this proposition, *Defiance Button Machine*,⁵⁰ declared that "a company's cessation of business" did not "automatically and immediately terminate its rights to a mark": "[G]oodwill does not ordinarily disappear or completely lose its value completely overnight. Erosion from non-use is a gradual process. As long as the mark has significant remaining value and the owner intends to use it in connection with substantially the same business or service, the public is not deceived."⁵¹ Thus, under *Defiance Button Machine*, a mark should not be found to have been abandoned if:

- (a) the goodwill of the concern has not wholly dissipated, (b) the owner or its assignee retains the intent to produce or market within a reasonable time a product or service substantially the same in nature and quality as that with which the trademark has been associated, and (c) such

48. *Indianapolis Colts, Inc. v. Metropolitan Baltimore Football Club Ltd. P'ship*, 34 F.3d 410 (7th Cir. 1994).

49. See Restatement (Third) of Unfair Competition § 30, cmt. a ("Subsequent users, although free to use the abandoned designation, may . . . be required to take precautions necessary to avoid a likelihood of confusion if the designation retains its association with the former owner.").

50. *Defiance Button Mach. Co. v. C&C Metal Prods. Corp.*, 759 F.2d 1053 (2d Cir. 1985).

51. *Id.* at 1061, 1060.

resumption of operations occurs within a reasonable time under the circumstances.⁵²

In that case, the court found that the plaintiff did not intend not to resume use of its mark. Although it had ceased manufacturing operations, it planned to resume its business at a future date. In addition, while it ceased operations, it received an offer of \$10,000 for the mark and its associated goodwill, which led the court to conclude that the mark in fact retained its goodwill and significance as a signifier of origin. In part, these cases do no more than restate the legal standard proposition that a party with an intent to resume use of a mark did not abandon that mark, residual goodwill or not.⁵³ However, the existence of residual goodwill may prod a court toward a finding of no abandonment even after several years of nonuse, along with a bona fide intent to resume use.

Finally, the existence of residual goodwill can bolster an argument that a mark has not been abandoned where that goodwill is combined with evidence that the mark owner has continued to make some use of the mark even after the product it appeared on was discontinued. A district court in the Southern District of California found that Ferarri did not abandon its rights in the DAYTONA SPYDER automotive trade dress even though it no longer produced and sold these automobiles. It had, however, continuously made replacement parts for the vehicles and had completely refurbished some vehicles, and the cars were still “driven extensively.” In addition, the court found that “the DAYTONA SPYDER design is strongly associated with Ferrari, and such association is extremely positive. In essence, Ferrari has not only achieved a strong existing goodwill, but continues to

52. *Id.* See *Seidemann Yachts Inc. v. Pace Yacht Corp.*, 14 U.S.P.Q.2d 1497, 1503 (D. Md. 1989) (holding mark not abandoned because mark retained goodwill and use resumed within reasonable time), *aff'd*, 13 U.S.P.Q.2d 2025 (4th Cir. 1990) (unpublished).

See also *BellSouth Corp. v. White Directory Publishers, Inc.*, 42 F. Supp. 2d 598, 614 (M.D.N.C. 1999) (finding the residual goodwill doctrine to be inapplicable in that case, but noting that “courts have permitted the proponent of a mark to counter a defendant’s contention that the goodwill symbolized by a mark has evaporated during a period of non-use by demonstrating that goodwill in the mark has persisted and that the proponent intends to resume use of the mark”); *Pan American World Airways, Inc. v. PanAmerican Sch. of Travel, Inc.*, 648 F. Supp. 1026 n.3 (S.D.N.Y.) (“If the proponent of a mark stops using it but demonstrates an intent to keep the mark alive for use in resumed business, the mark retains ‘residual’ goodwill and thus continues to enjoy trademark protection, as long as it retains its significance as an indication of the origin of the goods or services.”), *aff’d without opinion*, 810 F.3d 1160 (2d Cir. 1986).

53. Under 15 U.S.C. § 1127, a trademark is abandoned “[w]hen its use has been discontinued with intent not to resume such use.”

maintain a residual goodwill in the unique design of the DAYTONA SPYDER.”⁵⁴

2. The Evolving View of the Trademark Trial and Appeal Board

Early on, the Trademark Trial and Appeal Board was a strong proponent of the ability of residual goodwill to stop a newcomer from adopting an abandoned mark. In 1962, the Board declared in dicta:

The substantial good will which accrued to the first party because of his extensive promotion and use of his mark does not cease immediately upon a decision to discontinue the manufacture and sale of the goods associated with said good will. There is a residual good will in the mark which remains until such time as it can be shown that the purchasing public generally no longer is reasonably likely to associate the second party's product with the first party. Until that time, there is a continuing likelihood of confusion as to source. . . .⁵⁵

In a 1973 case, the Board enforced the RAMBLER mark for automobiles even though its owner had discontinued use of the mark several years earlier.⁵⁶ It found that the discontinuance did not amount to abandonment because

there is a considerable reservoir of goodwill in the mark “RAMBLER” in this country that inures to opposer as a consequence of the large number of “RAMBLER” vehicles still on the road; opposer's activities in supplying “RAMBLER” parts and accessories to owners of those vehicles; and the use by dealers of the term “RAMBLER” as a portion of their corporate or business names and their maintenance of “RAMBLER” signs on their premises.⁵⁷

From that point in 1973 on, however, the Board's tone changed, and a party arguing before the Board that it maintained rights to an unused mark faced an uphill battle in proving residual goodwill. The Board either rejected the argument on the basis that

54. Ferrari S.p.A. *Esercizio Fabbriche Automobili e Corse v. McBurnie*, 11 U.S.P.Q.2d 1843 (S.D. Cal. 1989). *See also* *EH Yacht, LLC v. Egg Harbor, LLC*, 2000 U.S. Dist. LEXIS 156 (D.N.J. 2000) (continued sales of products under discontinued mark meant that mark was still in use and “continued to enjoy considerable goodwill in the marketplace even after [the mark owner] closed its doors”).

55. *Lyon Metal Prods., Inc. v. Lyon Inc.*, 134 U.S.P.Q. 1 n.5 (T.T.A.B. 1962).

56. *American Motors Corp. v. Action-Age, Inc.*, 178 U.S.P.Q. 377 (T.T.A.B. 1973). Jerome Gilson's firm represented American Motors Corporation in this case.

57. *Id.* at 378.

whatever goodwill was associated with the mark had dissipated,⁵⁸ that there was insufficient evidence of residual goodwill,⁵⁹ or that the goodwill from the product's continued availability in stores was insufficient. On the latter point, the Board has consistently held that once use of a mark has been discontinued, the party that owned the mark cannot rely on residual goodwill created by later sales of the product by distributors or retailers.⁶⁰ Merely because the product continues to "sit[] on a shelf in a retail store" does not mean that the trademark has not been abandoned or that it continues to generate goodwill.⁶¹ One 2002 Board opinion, unfortunately not citable as precedent, declared cogently, "Suffice it to say that, based on opposer's cessation of production of EVERETT pianos in 1989, *de minimis* sales after 1990, and the expiration of opposer's registration in 1995, it was reasonable for applicant to believe that opposer's mark was abandoned and now available for adoption by it."⁶²

A July 2008 opinion of the Board, unfortunately also not precedential, included an interesting twist on the residual goodwill problem.⁶³ The opposer had not used its mark for forty years, and nothing in the record suggested that it ever intended to resume use of the mark. The continued existence of fans of the product did not impress the Board: "The simple fact that there are collectors of an item, or that clubs exist for enthusiasts of a certain item . . . does not, by itself, defeat the statutory presumption of

58. *Bangor Punta Operations, Inc. v. American Sterling Enters., Inc.*, 184 U.S.P.Q. 243, 248 (T.T.A.B. 1974) ("While there may have been some residual good will in the mark . . . immediately or shortly after the discontinuance thereof, where there has been no sale or promotion of any product under the mark for approximately four years, whatever public or general good will that resided in the mark must necessarily have been dissipated over the years."); *Schenley Indus., Inc. v. Sterling Brewers, Inc.*, 157 U.S.P.Q. 593 (T.T.A.B. 1968) (same, nine years of nonuse).

59. *General Motors Corp. v. Aristide & Co., Antiquaires de Marques*, 87 U.S.P.Q.2d 1179 (T.T.A.B. 2008) (finding no residual goodwill from evidence that people continue to collect the product after it had been discontinued for many years).

60. *Id.* (holding that "residual goodwill is not sufficient to avoid a finding of abandonment where the goodwill is generated through subsequent sales of a product by distributors or retailers"; *Parfums Nautee, Ltd. v. American Int'l Indus.*, 22 U.S.P.Q.2d 1306 (T.T.A.B. 1992) ("A party cannot defend against a claim of abandonment by relying on some residual goodwill generated through post-abandonment sales of the product by distributors or retailers."); *Société des Produits Marnier Lapostolle v. Distillerie Moccia S.R.L.*, 10 U.S.P.Q.2d 1241 n.5 (T.T.A.B. 1989) (same).

See also *Yamaha Corp. of Am. v. Wrightwood Enters., Inc.*, 2002 TTAB LEXIS 721 (T.T.A.B. 2002) (not citable as precedent) (presence of opposer's product in an aftermarket after it had discontinued production was not sufficient to show residual goodwill).

61. *Société des Produits Marnier Lapostolle*, 10 U.S.P.Q.2d at 1241 n.5.

62. *Yamaha Corp.*, 2002 TTAB LEXIS 721.

63. *Chrysler LLC v. Pimpo*, Opp. No. 911171962 (July 30, 2008).

abandonment by the mark's owner after almost forty years of nonuse in the ordinary course of trade." The Board concluded that the record did not "support a finding that there is sufficient residual goodwill in the mark . . . so as to avoid a finding of abandonment." However, the Board found that the opposer's licensing of the abandoned mark for use on various products after abandonment established a new priority date for the mark. So, while the mark was abandoned, post-abandonment licensing by the original owner revived the mark sufficiently to give the original owner priority over the applicant.

It would nevertheless be consistent with Board precedent for the owner of an abandoned mark to avoid a finding of abandonment upon proof of residual goodwill. After its high water mark of enforcing the RAMBLER mark, the Board has never been faced in a reported case in which a party has successfully proved the existence of residual goodwill. The Board has simply refused to find sufficient residual goodwill in the cases that came before it. Perhaps the right facts would allow it to reiterate its 1973 holding in the RAMBLER case.

B. The Role of Consumer Confusion

When a newcomer appropriates an abandoned trademark that is still infused with residual goodwill, and then starts using it on the same or even sometimes on different products, public confusion and deception are almost certain.⁶⁴ Residual goodwill *means* that consumers still associate the mark with the original owner.⁶⁵ The newcomer is not subject to the original owner's quality control, and

64. Aristide was allegedly involved in one such instance in the United Kingdom. According to a Wikipedia entry, Aristide had licensed the dormant ACORN Computers trademark to a new company, Acorn Computers Ltd., that had no connection with the original company. Acorn Computers then distributed leaflets at a trade show announcing "one of the most exciting brand re-launches in UK history." The entry then states, "The reuse of the Acorn Computers Ltd name has caused an amount of confusion and controversy, particularly amongst the users of Acorn's previous products," which differed from those sold by the new company. See [http://en.wikipedia.org/wiki/Acorn_Computers_\(2006\)](http://en.wikipedia.org/wiki/Acorn_Computers_(2006)).

65. Residual goodwill depends, of course, on consumer memories of discontinued trademarks and consumer ages during the active use of the original mark. Millenials (born 1982-2001) (known for their collective action, optimism, tenacity, heroic spirit, multi-tasking capabilities, techno-savvy), for example, probably do not remember LASALLE automobiles or Enrico Caruso, but their grandparents from the Greatest Generation (born 1915-45) (known for their hard work and thrift, respect for authority, delayed gratification, duty and honor, patriotism, conformity) probably do. While generation categories and characteristics figure prominently in consumer product marketing, there is no reason to exclude any generation, including the Baby Boomers and the Generation Xers, from the so-called purchasing public that is protected under trademark law and policy. (The generation characteristics are from the Temple University Generational Cohort.)

there is therefore no legal requirement that the newcomer use the zombie mark on products with the same quality level that the public associated with the mark previously.

Should there not be a legal requirement that the newcomer at least disclose to the public that it has no connection with the original trademark owner? Such candor would of course inform the public of the true nature of the situation, but it would also undermine the core of the zombie business: the strong likelihood that consumers will recall the abandoned mark's previous lifetime goodwill and will assume that the newcomer is connected to the original owner. They would almost certainly expect the zombie-marked goods to be the same goods of the same quality that they enjoyed earlier.⁶⁶

C. Residual Goodwill, Genericness and Functionality

Courts and the Trademark Trial and Appeal Board have previously faced the issue of an unenforceable mark that consumers nonetheless associate with a single source. It is axiomatic in trademark law that a generic name or functional product feature is unenforceable as a trademark.⁶⁷ Nevertheless, consumers may still associate that generic name or functional feature with a single producer, a status known as *de facto* secondary meaning.⁶⁸ This association may occur where the product at issue is unique and has no competition, or where the term or feature has been extensively advertised.⁶⁹ For example, even though evidence showed that some members of the public associated the phrase YOU HAVE MAIL with America Online, the Fourth Circuit found that the phrase was still generic and should be available for all competitors.⁷⁰ The bottom line is that even consumer association will not enable a business to monopolize a generic term or functional feature.

Despite this proscription, however, courts have also held that a business may not use a generic term in a way that is likely to mislead or deceive consumers as to the source of the goods. Even if the term at issue is unenforceable as a trademark, a business may

66. See *supra* note 39.

67. See 1 *Gilson*, *supra* note 3, at § 2.02 for more on generic names and § 2A.04 for more on functional product features and trade dress.

68. See *id.* at § 2.09[8] for more on *de facto* secondary meaning.

69. See, e.g., *In re Honeywell, Inc.*, 532 F.2d 180, 183 (C.C.P.A. 1976) (holding that *de facto* secondary meaning is “a significance or recognition due to a lack of competition or other happenstance, but which is insufficient to support a legally protectable right therein”) (citation omitted).

70. *America Online, Inc. v. AT&T Corp.*, 243 F.3d 812, 822-23 (4th Cir. 2001).

not use it in such a way that it is passing off its goods as those of another.⁷¹ In the 1938 “shredded wheat” case, for example, the Supreme Court found that term to be generic for shredded whole wheat in pillow-shaped biscuits.⁷² While it permitted junior user Kellogg Company to use the generic term “shredded wheat” for its biscuit product in a pillow-shaped form the Court declared, “Fairness requires that it be done in a manner which reasonably distinguishes its product from that of plaintiff.”⁷³ Kellogg was thus required to “use every reasonable means to prevent confusion,”⁷⁴ which it did by selling its pillow-shaped biscuits in distinctive cartons with labels strikingly different than those used by the plaintiff, and prominently using the Kellogg Company trade name. The Court emphasized in that case that it was not unfair for Kellogg to share in the goodwill “in a market which was created by the skill and judgment of plaintiff’s predecessor and has been widely extended by vast expenditures in advertising persistently made” because the product’s name and pillow shape, once patented, was unprotected by trademark law (as a generic term) and by patent law (the patent had expired). However, it pointed out that there was “no evidence of passing off or deception on the part of the Kellogg Company; and it has taken every reasonable precaution to prevent confusion or the practice of deception in the sale of its product.”⁷⁵

Similarly, an unused mark may continue to have residual goodwill in the consumer community for years. However, absent the presence of intent to resume use, or some holdover or derivative use of the unused mark, courts are highly unlikely to enforce those marks and will find that they have been legally abandoned. The existence of residual goodwill does not resuscitate a mark that has been truly abandoned, and the existence of

71. *E.g.*, *Dial-A-Mattress Franchise Corp. v. Page*, 880 F.2d 675, 678 (2d Cir. 1989) (“It is . . . clear that a second comer, though entitled to use a generic term already used by its competitor, may be enjoined from passing itself or its product off as the first user or that user’s product and may be required to take steps to distinguish itself or its product from the first user or that user’s product.”); *Blinded Veterans Ass’n v. Blinded American Veterans Found.*, 872 F.2d 1035, 1043 (D.C. Cir. 1989) (holding that “if an organization’s own name is generic, a competitor’s subsequent use of that name may give rise to an unfair competition claim if the competitor’s failure adequately to identify itself as distinct from the first organization causes confusion or a likelihood of confusion”); *Liquid Controls Corp. v. Liquid Control Corp.*, 802 F.2d 934, 939 (7th Cir. 1986) (holding that “section 43(a) may not protect the use of a term unless that term is sufficiently distinctive to warrant protection as a trademark, even if some confusion results, but may offer protection against ‘passing off’”).

72. *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938).

73. *Id.* at 120.

74. *Id.* at 121.

75. *Id.* at 122.

consumer association does not permit enforcement of a generic term or a functional feature. Nevertheless, just as a business may not pass off its goods as those of another party by using a *generic term* in a misleading way, so too a business should not pass off its goods as those of another by using an *abandoned trademark* in a misleading way.

D. Residual Goodwill and Inevitable Confusion

There is another situation in trademark law where, in order to avoid consumer confusion, a court will enforce a mark that it otherwise would not have. Several U.S. courts of appeals and the Trademark Trial and Appeal Board have held that a strong showing of an inevitable likelihood of confusion will revive a trademark infringement claim even where the senior user has acquiesced in the junior user's use or where the laches defense would otherwise bar the claim.⁷⁶ In such cases, the public interest in avoiding inevitable confusion takes precedence over the equities between the parties.⁷⁷

As with *de facto* secondary meaning cases, courts have shown in the inevitable confusion context that they are willing to halt or restrict the use of marks that would otherwise be unenforceable. Former owners of abandoned marks could argue by analogy that even if their marks are not enforceable, a court should require the zombie owner to take steps to differentiate itself from the original owner to prevent inevitable consumer confusion.

76. See, e.g., *Angel Flight of Georgia, Inc. v. Angel Flight America, Inc.*, 522 F.3d 1200, 1206 (11th Cir. 2008) (consumer confusion inevitable because parties used identical marks and provided identical services); *Profitness Physical Therapy Ctr. v. Pro-Fit Orthopedic & Sports Physical Therapy, P.C.*, 314 F.3d 62, 68 (2d Cir. 2002) (“Even where laches and acquiescence would bar damages, . . . a court may nonetheless grant injunctive relief if it determines that the likelihood of confusion is so great that it outweighs the effect of plaintiff’s delay in bringing suit.”); *TMT North Am., Inc. v. Magic Touch GmbH*, 124 F.3d 876, 886 (7th Cir. 1997) (“The law . . . allows the senior user’s claim to be revived from estoppel if the senior user can show that ‘inevitable confusion’ would result from dual use of the marks.”); *Jansen Enters. v. Rind*, 85 U.S.P.Q. 1104 (T.T.A.B. 2007) (holding that, if confusion between the parties’ marks is inevitable, the laches defense does not apply “under any circumstances” because “any injury to respondent caused by petitioner’s delay is outweighed by the public’s interest in preventing confusion in the marketplace”).

See also *Teledyne Techs., Inc. v. Western Skyways, Inc.*, 208 Fed. Appx. 886 (Fed. Cir. 2006) (unpublished) (“Where there is inevitable confusion, . . . the court should decline to apply laches to protect the public interest.”).

For more on inevitable confusion, see 3 *Gilson*, *supra* note 3, at § 11.08[3][i][iii][B].

77. See *Coach House Rest., Inc. v. Coach & Six Rests., Inc.*, 934 F.2d 1551, 1564 (11th Cir. 1991) (holding that “the public interest in preventing confusion . . . is paramount to any inequity caused the registrant”).

VI. FALSE ADVERTISING: ANOTHER ALTERNATIVE FOR AVOIDING CONFUSION FROM ZOMBIE TRADEMARKS

Section 43(a) of the Lanham Act prohibits any “false or misleading description of fact, or false or misleading representation of fact” that appears in commercial advertising or promotion and “misrepresents the nature, characteristics, qualities, or geographic origin of . . . goods, services, or commercial activities. . . .”⁷⁸ Could misleading statements by the owner of the zombie mark, such as taking credit for the past success of the brand and suggesting that it is a successor to the former mark owner, constitute false advertising? This could be another legal hook on which to hang a claim to prevent consumer confusion from zombie marks.

A. Viability of the Claim

Say the owner of the zombie mark declares in an advertisement that it is “pleased to bring back the BRAND X candy that consumers remember fondly from the 1980s”; or that it “is breathing new life into the BRAND X spaghetti sauce that consumers have been so dismayed to have been without all these years”; or touting that “the BRAND X soap long gone from store shelves will be back by the end of the month”; or declaring that “consumers can now return to the BRAND X store their mothers loved”; or that “the BRAND X snack from your past is on sale again!”

A court could find that these statements are literally false because the zombie business is going beyond mere use of the mark and making claims of a connection with the previous business and its product quality where there is none, or it could find the statements to be misleading because they imply a false representation. A court would probably find these misstatements, and others touting accolades, distinctions and other business history surrounding the earlier mark, to be material to consumers’ purchasing decisions; indeed, a major reason to revive these brands is to take advantage of consumers’ fondness for the original products. Also, the statements do relate to “the nature, characteristics, qualities, or geographic origin” of the zombie business’s “goods, services, or commercial activities” because they serve as representations of quality and continuity with the former product.

78. 15 U.S.C. § 1125(a)(1)(B). See 2 *Gilson*, *supra* note 3, at § 7.02[6] for more on false and deceptive advertising.

B. Standing

Would anyone have standing to challenge such false advertising by the zombie business? “[A]ny person who believes that he or she is likely to be damaged” by false or misleading advertising may initiate a civil action against the advertiser.⁷⁹ Courts have unanimously held that there is no consumer standing to sue for false advertising,⁸⁰ so if anyone could sue, it would have to be a business that could be damaged by the statements.

The company that owned the original brand could be barred from a false advertising claim because it no longer uses the mark. It thus would have a difficult time showing that it is likely to face commercial harm. However, a competitor of the zombie business product line could file suit to stop the zombie business from taking advantage of customers’ nostalgia for another era, or their fondness for the original brand. A competing snack company, for example, would probably have standing to sue to challenge the statement that “the BRAND X snack from your past is on sale again!”

VII. THE UNCLEAN HANDS DEFENSE, ASSIGNEE USE OF A MARK, AND QUALITY CONTROL

Apart from the law of trademark infringement and false advertising, the equitable doctrine of unclean hands could support protection of the public where a trademark is used in a way that generates confusion. Suppose the owner of a resurrected zombie trademark has occasion to file a trademark infringement action, and the defendant is able to show that the zombie owner’s manner and type of use of the mark has confused and deceived the public. Perhaps survey evidence shows that consumers believed, incorrectly, that the zombie mark carried the same quality assurances of the original or that the zombie owner was in fact the original owner. A wide variety of consumer beliefs in this context could create a serious problem for the zombie owner and its right to relief, and the equities could well tilt against it. How could it credibly claim that the defendant was causing likely confusion and deception with a similar trademark when it was itself doing the same thing with the zombie mark?

At this point, the zombie owner could well become ensnared by the equitable doctrine of *unclean hands*, an unenviable position in

79. 15 U.S.C. § 1125(a)(1). See 3 *Gilson*, *supra* note 3, at § 11.06[1] for a general discussion of standing in trademark cases.

80. *See id.* at § 11.06[2].

any court proceeding. A plaintiff in a trademark case has unclean hands when its conduct relative to its mark is illegal or otherwise unconscionable, by engaging in fraud, misrepresentation, or by use of the mark to violate the law.⁸¹ A finding of unclean hands could well bar a zombie owner from relief, in whole or in part. In fact, a reporter's note in the Restatement (Third) of Unfair Competition remarks that trademark rights acquired by a newcomer could be limited under the unclean hands doctrine where the mark has residual goodwill and the newcomer does not adequately distinguish its use of the mark from the use made by the original owner.⁸² Although withholding relief to a zombie would not perforce aid consumers, businesses would be deterred from developing zombie marks if they could not be protected.

Other trademark law doctrines that protect the public from deception and confusion support the unclean hands defense by analogy. In the context of assignments, for example, a trademark cannot lawfully be assigned without its attached goodwill, and attempts to assign a mark without it are generally held invalid.⁸³ If the public has come to associate a mark with a certain product, it could be deceived if an assignee begins using it on other products or products with different ingredients. Where the trademark owner assigns its rights in the mark and the assignee uses the mark on such products, or on significantly changed products, courts may view that as a fraud on the public and find that the assignee has unclean hands.⁸⁴

The discontinuity would be too great. The consumer would have no assurance that he was getting the same thing (more or less) in buying the product or service from its new maker. . . . The point is not that the product to which a trademark is affixed can never change. Many trademarked products, ranging from Chevrolets to Coca-Cola, have changed enormously over the years. But in these cases the consumer always knew whose product it was that he was getting. The prohibition of sales in gross protects his expectations.⁸⁵

81. For more on the unclean hands defense in trademark cases, see *id.* at § 11.08[4][h].

82. Restatement (Third) of Unfair Competition § 30, cmt. a, reporter's note.

83. 1 *Gilson*, *supra* note 3, at § 3.06[6].

84. *See id.* at § 3.06[5].

85. *Green River Bottling Co. v. Green River Corp.*, 997 F.2d 359, 362 (7th Cir. 1993).

See also *Defiance Button Mach. Co. v. C&C Metal Prods. Corp.*, 759 F.2d 1053 (2d Cir. 1985) (holding that "a trademark may be validly transferred without the simultaneous transfer of any tangible assets, as long as the recipient continues to produce goods of the same quality and nature previously associated with the mark"); *Marshak v. Green*, 746 F.2d 927, 929 (2d Cir. 1984) ("Use of the mark by the assignee in connection with a different goodwill and different product would result in a fraud on the purchasing public who

In the zombie context, where residual goodwill currently exists for an unused mark and the newcomer departs from the previous product and its quality, the law's treatment of trademark assignees is consistent with a finding of unclean hands in a zombie situation.

Additional support for an unclean hands finding, and a possible requirement that the zombie company take adequate steps to differentiate itself from the original trademark owner, comes from the Lanham Act's quality control requirement. Subject to regulatory requirements in particular industries, trademark law permits a trademark owner to set the level of quality on its goods to high, low or medium. However, the moment it licenses another to use the mark the law places a heavy burden on the licensor to control the quality of the licensee's goods sold under the mark in order to protect the public from deception.⁸⁶ If it does not, the public is misled into believing that the trademarked products carry the trademark owner's guaranty of quality when they do not. Without adequate quality control, the products may differ from or be of lesser quality than the goods of the trademark owner. The penalty on the licensor from failing to control quality may well be abandonment of the trademark, which can occur "whenever any course of conduct of the [trademark] owner, including acts of omission as well as commission, causes the mark . . . to lose its significance as a mark."⁸⁷ In the zombie situation, as long as there is residual goodwill, the public associates the trademark with the quality of the original trademarked products, and the newcomer is able to set the quality level wherever it pleases, the impact on the public is the same.

reasonably assume that the mark signifies the same thing, whether used by one person or another."); *Pepsico, Inc. v. Grapette Co.*, 416 F.2d 285, 288 (8th Cir. 1969) ("Inherent in the rules involving the assignment of a trademark is the recognition of protection against consumer deception. Basic to this concept is the proposition that any assignment of a trademark and its goodwill (with or without tangibles or intangibles assigned) requires the mark itself be used by the assignee on a product having substantially the same characteristics."); *Clark & Freeman Corp. v. Heartland Co.*, 811 F. Supp. 137, 140 (S.D.N.Y. 1993) (finding assignment to be invalid assignment in gross where assignor had only used mark on women's boots and assignee used mark on men's shoes and hiking boots) ("It is not merely the quality of the product, but its similarity to that produced by the assignor that determines whether goodwill has been transferred.").

86. See 2 *Gilson*, *supra* note 3, at § 6.01[4].

87. See 15 U.S.C. § 1127 definition of "abandoned."

VIII. ACTION BY THE FEDERAL TRADE COMMISSION: ONE LAST OPTION FOR PREVENTING CONSUMER DECEPTION FROM ZOMBIES

In many cases, the original trademark owner will be unable to litigate to stop use of the zombie mark. It may not have standing, it may be out of business, or it may simply be unwilling to put up a fight. What then?

The Federal Trade Commission, described as “the nation’s consumer protection agency,” has broad powers under Section 5(a) of the FTC Act to combat unfair and deceptive advertising.⁸⁸ Its Bureau of Consumer Protection works on behalf of consumers “to prevent fraud, deception and unfair business practices in the marketplace.”⁸⁹ Within the BCP, the Commission’s Division of Advertising Practices protects consumers from deceptive advertising or marketing practices that raise health and safety concerns, but also those that cause economic injury.⁹⁰ The FTC’s “Policy Statement on Deception” notes that in all deception cases, there must be “a representation, omission or practice that is likely to mislead the consumer.” In addition, from the perspective of a reasonable consumer, the representation, omission or practice must be “material,” or “likely to affect the consumer’s conduct or decision with regard to a product or service.”⁹¹

There is no evidence that the Commission has taken steps to prevent deceptive advertising in the zombie trademark sphere, but its powers appear to extend that far. It has challenged fraudulent advertising in the past in federal court, such as advertising of “fraudulent cure-all claims for dietary supplements and weight loss products,” and it also “brings administrative lawsuits to stop unfair and deceptive advertising.”⁹² Thus, an FTC action is another possibility for preventing consumer deception by zombie marks.

IX. CONCLUSION

It is fundamental that a trademark designates the source of a product or service, denotes a particular standard of quality, symbolizes the goodwill of its owner and motivates consumers to

88. 15 U.S.C. § 45(a). Under the statute, “[u]nfair methods of competition in or affecting commerce, and unfair or deceptive acts or practices in or affecting commerce, are hereby declared unlawful.” 15 U.S.C. § 45(a)(1).

89. See <http://www.ftc.gov/bcp/index.shtml>.

90. See <http://www.ftc.gov/bcp/bcpap.shtml>.

91. See <http://www.ftc.gov/bcp/policystmt/ad-decept.htm>.

92. See www.ftc.gov/bcp/bcpap.shtml.

purchase the trademarked product or service.⁹³ However, this is not true of zombie trademarks. Zombies are an aberration. The associated goodwill is that of the previous owner, the source designated is the previous owner, the mark in all likelihood does not indicate the previous product's nature and standard of quality, and the mark motivates consumers to purchase the trademarked product or service they wrongly thought they had received previously. As one consumer put it, "There is something reassuring about finding a brand from the past on the shelf. . . . But if I were lucky enough to find any one of these brands . . . and realize they were not the original formulations, I would be very disconcerted and put off."⁹⁴

A responsible zombie business does not own one shred of the mark's sometimes immense residual goodwill. It had no hand in creating it, and pretending that it did is simply wrong. Capitalizing on it by misleading the public is basically unfair as well, smacking of unjust enrichment.

A zombie trademark business can adopt reasonable safeguards, in its own enlightened self-interest and in the interest of protecting the public. For example, it can strive to duplicate the products or services, and their quality, that were previously sold under the mark, or clearly explain any differences to the public. It can also spread the word that it and its trademarked products or services are completely independent of the previous trademark owner. Any public relations campaign for the product should include a truthful reference to the previous mark owner. Also, as commonly ordered by courts in infringement cases,⁹⁵ the placement of a legible disclaimer in advertising and on product packaging and labels could alleviate a likelihood of confusion. Informed

93. 1 *Gilson*, *supra* note 3, at § 1.03. As the Supreme Court put it,

The protection of trade-marks is the law's recognition of the psychological function of symbols. If it is true that we live by symbols, it is true that we purchase goods by them. A trade-mark is a merchandising short-cut which induces a purchaser to select what he wants, or what he has been led to believe he wants. The owner of a mark exploits this human propensity by making every effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol. Whatever the means employed, the aim is the same—to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears. Once this is attained, the trade-mark owner has something of value. If another poaches upon the commercial magnetism of the symbol he has created, the owner can obtain legal redress.

Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge, 316 U.S. 203, 205 (1942) (Frankfurter, J.). Jerome Gilson's firm represented *Mishawaka Rubber & Woolen Manufacturing Co.* in this case. One might ask if the result would be the same if the commercial magnetism is created by a business that is unrelated to the trademark owner.

94. *See supra* note 39.

95. 3 *Gilson*, *supra* note 3, at § 14.02[1].

consumers could then judge the new product or service bearing the zombie mark on its own merits. Future sales could then conceivably build up an entirely new goodwill, and of critical importance, a stand-alone association of non-residual goodwill with the zombie owner. It would replace the residual goodwill, and going forward it would be available in any trademark enforcement proceeding, any sale, any assignment, and in myriad other business transactions.

It is up to the courts in future cases or Congress to take a fresh and comprehensive look at zombie trademarks. The law as it pertains to residual goodwill needs developing, but fortunately the law of trademarks and unfair competition is a model of flexibility. Its history establishes that it is readily adaptable to new, and previously unheard of, areas requiring attention.⁹⁶ In the realm of zombie trademarks, doctrines such as assignee restricted use, quality control, false advertising and the unclean hands defense can play supporting roles. Moreover, a proactive Federal Trade Commission could significantly alter the landscape.

In the end, the law of zombie trademarks needs to be molded by the core values of the Lanham Act and its unwavering policy of protecting the public from confusion and deception. Not only is the Act intended, in part, “to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce,”⁹⁷ but the courts themselves recognize that the protection of the public from misleading trademarks is paramount.⁹⁸

* * *

Field Reporter: Chief, if I were surrounded by eight or ten of these things, would I stand a chance?

*Sheriff McClelland: Well, that’s no problem, if you got a gun shoot ’em in the head. That’s the sure way to kill ’em. If you don’t, get yourself a club, beat ’em or burn ’em. They go up pretty easy.*⁹⁹

96. *Id.* at § 1.04[2][a].

97. 15 U.S.C. § 1127.

98. 1 *Gilson*, *supra* note 3, at § 1.03[8][a].

99. http://en.wikiquote.org/wiki/Night_of_the_Living_Dead.