

LANDMARK TRADEMARKS

*Justin Hughes**

INTRODUCTION

Sometimes a body of factually similar cases accretes over time and with little notice, particularly when courts do not announce unifying principles that identify the cases with each other. In trademark law, one such set of cases concerns historic sites where businesses are operated under concession from the site owners. The McCarthy treatise subsumes these cases under landlord-tenant disputes,¹ but doing so tends to overlook the fame, importance, and draw of the landmark building or site in question.

In fact, trademark law is ill suited for situations where the consumer does not care about the provider of the services at a location as much as she cares about the actual *physical location* or *building* where the services are provided. This happens when the physical location or the building is itself the consumer's "destination," i.e., when the building, site, or place is a landmark.²

* Honorable William Matthew Byrne Professor of Law, Loyola Law School, Los Angeles. My thanks to Barton Beebe, Christine Farley, James Grimmelman, and Lisa Ramsey for helpful comments. Thanks to Tobe Liebert, Julius Bodie, Michelle Juen, and Silver Kim for research assistance. The remaining errors are the exclusive intellectual property of the author. Copyright © 2017 by the author. Permission is hereby granted for noncommercial reproduction of this Article in whole or in part for educational or research purposes, including the making of multiple copies for classroom use, subject only to the condition that the name of the author, a complete citation, and this copyright notice and grant of permission be included in the copies.

1. J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 16:38 (4th ed. 2010) Westlaw.

2. One definition of "landmark" in the Merriam-Webster Dictionary is "a structure (such as a building) of unusual historical and usually aesthetic interest; especially one that is officially designated and set aside for preservation." *Landmark*, MERRIAM-WEBSTER (<https://www.merriam-webster.com/dictionary/landmark>). See also CAL. PUB. RES. CODE § 5031(a) (West, 2017) (providing that a "landmark" designation is possible for "property [that] is the first, last, only, or most significant historical property of its type in the region" and "property [that] is associated with an individual or group having a profound influence on the history of California"), http://leginfo.legislature.ca.gov/faces/codes_displayText.xhtml?lawCode=PRC&division=5.&title=&part=&chapter=1.&article=3; N.Y.C. ADMIN. CODE § 25-302(n), https://www.lawserver.com/law/state/new-york/ny-laws/ny_new_york_city_administrative_code_25-302 (defining "landmark" as building or structure "any part of which is thirty years old or older, which has a special character or

Often such landmarks are publicly owned and leased to private service providers, but they can be privately owned as well.³

One could imagine a separate legal regime for names of landmarks and other aspects of our cultural heritage,⁴ but the proposal in this Article is more modest—and one that can be implemented by individual decision-makers, both trademark examiners at the United States Patent and Trademark Office (“USPTO”) and courts. The proposal is that in these “landmark trademark” cases, courts have tended to overlook the *descriptive* status of the building or site’s name.⁵ In fact, while the McCarthy treatise discusses towns and street names as candidates for being “primarily geographically descriptive” terms, it makes no mention of buildings or sites.⁶ A proper appreciation of the powerful descriptiveness of a landmark’s name may, in many of these cases, lead to a conclusion that there are no trademark rights at all, obviating the need to figure out who owns them.

Part I describes the individual disputes in this suite of cases while Part II reviews how commentators and Congress have addressed these situations. Part III proposes that when landmark names are claimed as trademarks, the USPTO and courts should treat the landmark names as geographically descriptive words and apply a more robust descriptiveness analysis to establish whether there is genuine secondary meaning. Part III also proposes that there is more *dominant descriptiveness* with landmark names than with most descriptive terms and that this demands a heightened showing of secondary meaning. Part III also suggests that in commercial use, a landmark’s name may function akin to a “geographical indication,” that is a certification of specific place origin. This is another reason for heightened scrutiny when a private company seeks to convert a landmark name into a portable trademark.

I. THE RECURRING PROBLEM OF LANDMARK TRADEMARKS

The basic structure of a landmark trademark case is that there is a well-known building or site that is leased to a concessionaire that runs a business at the site—and does so long enough to reasonably claim service mark rights under traditional trademark

special historical or aesthetic interest or value as part of the development, heritage or cultural characteristics of the city, state or nation”).

3. *National Historical Landmarks Program*, NAT’L PARK SERV., <https://www.nps.gov/nhl/learn/intro.htm> (last visited Dec. 16, 2017) (noting that most national historic landmarks “are owned by private individuals, universities, non-profit organizations, corporations, tribal entities, or local and state governments”).

4. As we have with the word “Olympic.” See 36 U.S.C. § 220506 (2012). My thanks to Lisa Ramsey for this point.

5. MCCARTHY, *supra* note 1, § 14:11.

6. *Id.*

doctrine.⁷ These are all lessor-lessee disputes and, therefore, are very dependent on the terms of the contractual agreement.⁸ In that sense, awareness of the fact pattern should eventually eliminate this sort of dispute as lawyers anticipate the problem and allocate intellectual property rights contractually. But let us consider a set of disputes where contractual terms did not so clearly resolve, *ex ante*, who owned the relevant trademarks.

A. *Where George Washington Wept (1980)*

While most landmark trademark disputes involve publicly owned buildings, the first case in this suite concerns a New York building owned by a non-profit association.⁹ The Sons of the Revolution in the State of New York are the owners of a 1716 building at 54 Pearl Street in Manhattan that was the site of many events associated with the Revolutionary War.¹⁰ Operated as a tavern and restaurant since 1762, the building—known as “Fraunces Tavern”—hosted meetings of the “Sons of Liberty,” negotiations between the Americans and British, and the dinner at the end of the war where George Washington bade a teary farewell to the officers of the Continental Army.¹¹ The building was declared a landmark by the New York City Landmarks Preservation Commission in 1965 and was placed on the National Register of Historic Places in 2008.¹²

The Norden Restaurant Corporation claimed to have run the restaurant at Fraunces Tavern for over forty years and, in the late 1970s, registered the service mark FRAUNCES TAVERN with the USPTO.¹³ Norden’s basis for trademark rights was black letter doctrine:

[T]he Norden family ha[d] conducted a restaurant business on the leased premises for over 40 years and . . . because of the lengthy association of their restaurant with the name ‘Fraunces Tavern’ that name [became] synonymous with their restaurant and . . . they, therefore, ha[d] acquired the exclusive right to use the name.¹⁴

7. See *Dep’t. of Parks & Recreation v. Bazaar del Mundo Inc.*, 448 F.3d 1118, 1121–22 (9th Cir. 2006); *Norden Rest. Corp. v. Sons of the Revolution*, 415 N.E.2d 956, 957 (N.Y. 1980).

8. See *Bazaar del Mundo*, 448 F.3d at 1122–23; *Norden Rest. Corp.*, 415 N.E.2d at 957.

9. *Norden Rest. Corp.*, 415 N.E.2d at 956.

10. *Id.* at 957.

11. *Id.*

12. *History*, FRAUNCES TAVERN MUSEUM, www.frauncestavernmuseum.org/history/ (last visited Dec. 16, 2017).

13. *Norden Rest. Corp.*, 415 N.E.2d at 957.

14. *Id.*

When Norden and the Sons of the Revolution faced off in court over ownership of the name, New York's highest court concluded that the most recent lease agreement—executed in 1977—was dispositive of the issue.¹⁵ In its 1980 decision, the New York Court of Appeals found that the 1977 Agreement obliged Norden to use the name “‘Fraunces Tavern Restaurant’ or such other name as Landlord shall from time to time approve”;¹⁶ prohibited Norden from using that name for any “other business or location”; and provided that the right to use the name “shall terminate upon the expiration or earlier termination of this Lease.”¹⁷ On the basis of this contract, the Sons of the Revolution was found to be the owner of the common law rights in the mark.¹⁸

B. Trademark Showdown in Old Town San Diego (2006)

A very different outcome occurred a quarter century later in a roughly similar dispute on the West Coast.¹⁹ In 1968, the State of California used condemnation proceedings to acquire a fourteen-acre tract of land containing what remained of the “original” Spanish-Mexican settlement at San Diego, including the Casa de Pico and the Casa de Bandini, both built in the 1820s.²⁰ The Casa de Pico had been the home of the last Mexican Governor of (Alta) California.²¹ The Casa de Bandini was initially built in the late 1820s as the house of a prosperous businessman, Don Juan Bandini.²² In the 1870s, the building was expanded into a hotel called the “Cosmopolitan.”²³ The structure was registered as a California Historical Landmark in 1932.²⁴ Before the state took over the land, both buildings had been used as hotels,²⁵ while Casa de Bandini was also used for a restaurant.²⁶

After the state's acquisition of the properties, they were used to house shops, and Casa de Bandini “served as the headquarters for

15. *Id.*

16. *Id.*

17. *Id.* (“Perhaps the clearest recognition of defendant's ownership of the ‘Fraunces Tavern’ appellation is contained in paragraph 40.01, which provided: ‘The right to use the name “Fraunces Tavern Restaurant” in connection with Tenant's business shall be limited to the restaurant business conducted in the premises and to no other business or location, and such right shall terminate upon the expiration or earlier termination of this Lease.’”).

18. *Id.*

19. *Dep't. of Parks & Recreation v. Bazaar del Mundo Inc.*, 448 F.3d 1118, 1129 (9th Cir. 2006).

20. *Id.* at 1121.

21. *Id.*

22. *Id.*; *These Walls Have a Story*, COSMOPOLITAN HOTEL & RESTAURANT, <http://oldtowncosmopolitan.com/history/> (last visited Dec. 16, 2017).

23. *These Walls Have a Story*, *supra* note 22.

24. *Bazaar del Mundo*, 448 F.3d at 1122.

25. *Id.* at 1121.

26. *Id.*

the Fiesta 200 celebration of San Diego's bicentennial."²⁷ Two years later, the properties were leased to a private company, Bazaar del Mundo, under a "Concession Agreement" allowing the private company to equip, operate, and maintain a "Mexican-Style Shopping Arcade."²⁸ These agreements were amended and extended several times until Bazaar del Mundo lost the concession in an open bidding process conducted from 2001 to 2003.²⁹

Like the licensee of the Fraunces Tavern building, Bazaar del Mundo had received—unbeknownst to the building owner—USPTO trademark registrations for both CASA DE PICO and CASA DE BANDINI.³⁰ In its USPTO application process for the CASA DE PICO mark, Bazaar del Mundo stated that "[t]he Pico in Bazaar del Mundo's mark refers not to an animal but to General Pio Pico, the last Mexican governor" and that "[t]he site on which the restaurant stands was the home of General Pico which was later converted into a motel in 1930 . . . [and] subsequently converted into a restaurant."³¹

After losing its Old Town concession, in 2005 Bazaar del Mundo announced plans to reopen their Casa de Pico and Casa de Bandini restaurants in separate suburban locations in greater San Diego.³² Learning of Bazaar del Mundo's plans, the State of California filed an action seeking a declaratory judgment that it was the owner of the two marks and that Bazaar del Mundo had fraudulently registered the marks.³³

Unlike the *Norden Restaurant Corp. v. Sons of the Revolution*³⁴ court, both the trial and appellate courts concluded that the State of California had failed to demonstrate a protectable common law

27. *Id.* at 1121–22.

28. *Id.* at 1122.

29. *Id.* Bazaar del Mundo filed an administrative appeal to contest its loss of the concession and a trademark infringement action against the State of California and the new concessionaire over use of the names CASA DE PICO and CASA DE BANDINI. *Id.*

30. *Id.* at 1122–23.

31. *Id.* at 1123; Letter from Susan E. Westlake to USPTO on Behalf of Applicant (Apr. 19, 1985) (on file with author) [hereinafter Westlake Letter].

32. See *About Us*, CASA DE PICO, <http://www.casadepico.com/> (last visited Dec. 16, 2017) ("Casa de Pico, an internationally renowned Mexican restaurant, was originally opened by Diane Powers in 1971 in Old Town, San Diego. In 2005, we relocated to Grossmont Center, where we brought with us the spirit of our original location, with its hacienda-like archways, hand-crafted, wrought iron fixtures and beautiful landscaping reminiscent of Mexico."); *About Us*, CASA DE BANDINI, <http://casadebandini.com> (last visited Dec. 16, 2017) ("Diane Powers has brought the fun and flair of the original Casa de Bandini to The Forum Shopping Center in Carlsbad, Calif. Formerly located in Old Town, San Diego, this second generation Casa de Bandini Mexican Restaurant is the essence of Mexican culture . . .").

33. *Bazaar del Mundo*, 448 F.3d at 1123.

34. N.E.2d 956 (N.Y. 1980).

trademark interest in the two names.³⁵ While acknowledging that the State had offered tourism and recreational services in Old Town since taking over the properties, the appellate panel found “no evidence tending to show that [the State] adopted and commercially used the marks CASA DE PICO and CASA DE BANDINI”;³⁶ that if there had been any commercial use, that use was not continuous;³⁷ and that the Concession Agreement in its various forms “neither expressly nor impliedly granted Bazaar del Mundo a license to use the marks.”³⁸

The denouement of this story is that the name Casa de Bandini has been largely erased from Old Town San Diego and from the building that for almost two centuries bore that moniker. The official “Old Town Map, Shopping and Dining Guide” lists only the “Cosmopolitan Hotel,” saying it is the “[r]estored original adobe mansion of Don Juan Bandini, a Spanish gentleman and American patriot.”³⁹ Then, in a slip of the pen, it lists a small building next door as a “livery stable” that “[m]ay also have served as the servant quarters of Casa Bandini.”⁴⁰ Official on-site maps in Old Town San Diego do not mention Casa de Bandini at all.

A few hearty souls have not gotten the memo: across the square in the Cousin’s Candy Shop there is still a wall painting of the adobe mansion labeled “Casa de Bandini”—and the candy shop’s website still mentions that name too.⁴¹ The building’s original name is still acknowledged on the website of the California Department of Parks and Recreation under “Cosmopolitan Hotel & Restaurant / La Casa de Bandini Restoration.”⁴² And between 2007 and 2009, the State of California sensibly registered the two historic names in categories other than “restaurant services,” particularly “[p]rinted art reproductions, namely, reproductions of historical photographs, cookbooks, maps, books, brochures, and postcards.”⁴³ But for all practical purposes, the dispute over the end of the concession meant

35. *Bazaar del Mundo*, 448 F.3d at 1125.

36. *Id.* at 1126.

37. *Id.* at 1127.

38. *Id.* at 1128.

39. State Historic Park Walking Tour, Old Town Map Shopping and Dining Guide (on file with author).

40. *Id.*

41. *Old Town History*, COUSIN’S CANDY SHOP, <http://www.cousinscandy.net/old-town-history.html> (last visited Dec. 16, 2017) (“Historic buildings include: La Casa Estudillo, La Casa de Bandini, La Casa de Altamirano-Pedrorena and the Mason Street School, San Diego’s first one room schoolhouse.”).

42. *Cosmopolitan Hotel & Restaurant / La Casa Bandini Restoration*, CAL. DEPT OF PARKS & RECREATION, http://www.parks.ca.gov/?page_id=24983 (last visited Dec. 16, 2017).

43. The State of California’s CASA DE PICO mark has USPTO registration number 3528336 (Nov. 4, 2008) and its CASA DE BANDINI mark has USPTO registration number 3577007 (Feb. 17, 2009).

“the former Casa De Bandini became The Cosmopolitan Hotel[.]”⁴⁴ and San Diego lost a tiny sliver of its history to a private restaurateur.

C. The Struggle over Tavern on the Green (2010)

Among his many contributions to the lives of New Yorkers, Robert Moses decided in 1934 that a Central Park animal shed, originally built in 1870, should be repurposed into a restaurant for the public.⁴⁵ Moses liked the name “Tavern on the Green[.]”⁴⁶ and he usually got his way in the New York City of that era.⁴⁷

Although the city owned the building, the restaurant was operated by a series of private entities with unknown and largely fungible corporate names: Central Park Catering Co.; Savarins Management; Restaurant Associates, Inc.; Tavern on the Green and LeRoy Adventures, Inc.;⁴⁸ and, most recently, the Emerald Green Group.⁴⁹ In between private operators of the facilities, the building was often closed for renovation and refurbishment.⁵⁰

Over the years, Tavern on the Green became, first, a place to see and be seen, and, second, a place to visit—especially for tourists or families on an annual pilgrimage to see the Tavern’s celebrated Christmas decorations.⁵¹ Cementing the location’s status as a New York icon, Tavern on the Green appeared in many feature films, including *An Unmarried Woman* (1978), *Arthur* (1981), *Ghostbusters* (1984), *Wall Street* (1987), *Crimes and Misdemeanors* (1989), *Made* (2001),⁵² and *Mr. Popper’s Penguins* (2011),⁵³ not to mention television shows such as *Seinfeld* and *Futurama*, which parodied the

44. *Where California Got Its Start!*, GOTHHERE SAN DIEGO, <http://www.gothere.com/sandiego/oldtown.htm> (last visited Dec. 16, 2017).

45. *City of New York v. Tavern on the Green, L.P.*, 427 B.R. 233, 237 (S.D.N.Y. 2010).

46. *See id.*; Press Release, N.Y.C. Law Dep’t, Office of the Corp. Counsel, City Wins Tavern on the Green Trademark Case (Mar. 10, 2010), http://www.nyc.gov/html/law/downloads/pdf/Tavern_on_the_Green_Win.pdf.

47. *See generally* ROBERT A. CARO, *THE POWER BROKER: ROBERT MOSES AND THE FALL OF NEW YORK* (1974); PIERRE CHRISTIN & OLIVIER BALEZ, *ROBERT MOSES: THE MASTER BUILDER OF NEW YORK CITY* (2014).

48. *Tavern on the Green*, 427 B.R. at 237.

49. Julia Moskin, *City Picks Philadelphia Firm to Reopen Tavern on the Green*, N.Y. TIMES (Aug. 17, 2012, 1:34 PM), <http://dinersjournal.blogs.nytimes.com/2012/08/16/city-picks-philadelphia-firm-to-reopen-tavern-on-the-green/>.

50. *Tavern on the Green*, 427 B.R. at 237.

51. *See History & Renovation*, TAVERN ON THE GREEN, <https://www.tavernonthegreen.com/history/> (last visited Dec. 16, 2017).

52. *Id.*

53. A.O. Scott, *A Home Invasion by the Antarcticans*, N.Y. TIMES (Jun. 16, 2011), <http://www.nytimes.com/2011/06/17/movies/jim-carrey-stars-in-mr-poppers-penguins-review.html?mcubz=3>.

restaurant.⁵⁴ But Tavern on the Green was not known, at least in recent memory, for the quality of its restaurant services; indeed, it was better “known for its mediocre food and a high volume of customers,”⁵⁵ as a place where “[t]he food wasn’t so wonderful that it would lure crowds, but it wouldn’t keep them away,”⁵⁶ and as a “shaky tourist magnet.”⁵⁷

Trademark troubles began when the LeRoy concessionaires (“LeRoy”), who had operated the restaurant since 1973, filed for bankruptcy in 2009.⁵⁸ With the restaurant suddenly shuttered, the city sought bids to operate Tavern on the Green beginning in 2010.⁵⁹ But decades earlier LeRoy—like the Fraunces Tavern and Casa de Bandini concessionaires—obtained a USPTO registration for TAVERN ON THE GREEN for restaurant services, claiming that its first use in commerce was “as early as August 31, 1976.”⁶⁰ As with all applications for federal registration, LeRoy represented that no other person had the right to use the mark,⁶¹ despite its initial 1973 Agreement with the city describing the name of the licensed premises as “Tavern on the Green” and requiring LeRoy to get the city’s permission for any name change.⁶² In 2008, LeRoy received another TAVERN ON THE GREEN registration—this time for cooking oils and salad dressings.⁶³

In bankruptcy, LeRoy had no assets more important than its claim to the TAVERN ON THE GREEN marks.⁶⁴ Nonetheless, the court concluded that the City of New York had prior rights in the name;⁶⁵ that LeRoy could not have used the name without the city’s

54. *Futurama: A Leela of Her Own* (Fox television broadcast Apr. 7, 2002); *Seinfeld: The Susie* (NBC television broadcast Feb. 13, 1997).

55. Jeanette Settembre, *Anthony Bourdain Calls Tavern on the Green a ‘Chef Killer’*, N.Y. DAILY NEWS (Apr. 8, 2016, 10:13 AM), <http://www.nydailynews.com/life-style/eats/anthony-bourdain-calls-tavern-green-chef-killer-article-1.2593274> (“It’s impossible to make good meals when you’re doing those numbers,’ Bourdain says of the 400-seat restaurant in the film.”).

56. Pete Wells, *A Celebrity Steps Back into the Spotlight*, N.Y. TIMES (June 24, 2014), <http://www.nytimes.com/2014/06/25/dining/restaurant-review-tavern-on-the-green.html>.

57. Greg Morabito, *Tavern on the Green Chef Shuffle, Cafe Clover Spinoff, and More Intel*, EATER N.Y. (Apr. 5, 2016, 10:08 AM) <http://ny.eater.com/2016/4/5/11366598/tavern-on-the-green-chef-shuffle>.

58. *City of New York v. Tavern on the Green, L.P.*, 427 B.R. 233, 237, 239 (S.D.N.Y. 2010).

59. *Id.* at 239.

60. *Id.* at 238.

61. *Id.*

62. *Id.* at 237–38.

63. *Id.* at 239.

64. *NYC Lawsuit Says City Owns Tavern on the Green Name*, REUTERS (Oct. 23, 2009, 1:07 PM), <http://www.reuters.com/article/us-taveronthegreen/nyc-lawsuit-says-city-owns-tavern-on-the-green-name-idUSTRE59M43Y20091023>.

65. *Tavern on the Green*, 427 B.R. at 241–42.

permission;⁶⁶ that LeRoy's applications for trademark registration had been "a deliberate attempt to mislead the PTO";⁶⁷ and that "LeRoy had acknowledged the City's right to the name in the 1973 Agreement and knew that his venture was merely a licensee taking over operations from the prior concessionaire."⁶⁸

Initially, the court ordered that the TAVERN ON THE GREEN registration for restaurant services be cancelled, but the two parties reached a settlement by which that trademark registration was transferred to the City of New York.⁶⁹ That trademark registration is now owned by the City of New York,⁷⁰ but the City agreed to allow the trustee limited, concurrent use of the name (based partially on the salad dressing trademark registration, which was neither cancelled nor transferred).⁷¹ This agreement provided a valuable asset to satisfy at least some of LeRoy's creditors.⁷² Among the conditions imposed on any concurrent use is that there be no use of the name in New York, New Jersey, Connecticut, or parts of Pennsylvania; that the City would control merchandising in the New York City area, receiving a royalty if any merchandise were permitted;⁷³ and that the trustee and its licensees would not mention Central Park or "us[e] any pictures of Central Park or Central Park structures in conjunction with any use of the name Tavern on the Green for restaurants and products."⁷⁴ By 2017, the licensing company charged with exploiting the TAVERN ON THE GREEN moniker was violating some of these conditions,⁷⁵ and the

66. *Id.*

67. *Id.* at 243.

68. *Id.*

69. Lisa Fickenscher, *Tavern on the Green Name Going to Other Cities*, CRAIN'S N.Y. BUS., (Sept. 28, 2011, 3:25 PM), http://www.crainsnewyork.com/article/20110928/HOSPITALITY_TOURISM/110929879; Nick Fox, *Company Pays \$1.3 Million for Tavern on the Green's Name*, N.Y. TIMES: DINER'S J., (Sept. 27, 2011, 6:02 PM), https://dinersjournal.blogs.nytimes.com/2011/09/27/company-pays-1-3-million-for-tavern-on-the-greens-name/?_r=0.

70. TAVERN ON THE GREEN, Registration No. 1154270 (Assignment recorded to the "City of New York, by and through its Department of Parks and Recreation," on May 4, 2011).

71. Lisa Merriam, *Is Tavern on the Green a \$1.3 Million Brand Name?*, BUS. 2 COMMUNITY (Aug. 21, 2011), <http://www.business2community.com/branding/is-tavern-on-the-green-a-1-3-million-brand-name-052453>.

72. Fickenscher, *supra* note 69 ("The \$1.3 million will be paid to Tavern's largest secured creditor, TD Bank, which loaned the restaurant's former operator, the LeRoy family, capital to continue operating Tavern after it filed for bankruptcy protection.")

73. Fickenscher, *supra* note 69; Fox, *supra* note 69.

74. Complaint at 5, City of New York v. Tavern on the Green Int'l, LLC, No. 1:17-CV-01376 (S.D.N.Y. Feb. 24, 2017) [hereinafter Complaint, *Tavern on the Green Int'l*].

75. The webpage offering licensing deals for "Tavern on the Green" restaurants once said, "Restaurants will bring to mind memories of original visits to the space in New York City . . . For more than 30 years Tavern on the Green was synonymous with Central Park, & no trip to New York was complete

City found itself continuing to patrol the integrity of the landmark's name.⁷⁶

D. Rights to Names in Our National Parks (2015–?)

In 2015 and 2016 a different sort of struggle over famous site names emerged between the National Park Service (“NPS”) and concessionaires licensed to operate facilities in our national parks.⁷⁷ These disputes, which have not yet produced any court decisions, do have one significant variation from the basic fact pattern in the three cases discussed above: the private entity may, in some sense, be the successor of the private entity that built the landmark.

Since their inception, national parks in the United States have relied on private individuals and companies to build, maintain, and operate amenities and facilities within the parks.⁷⁸ In the case of Yosemite National Park, the Yosemite Park and Curry Company (“Curry Company”) provided such services since the 1890s, including the construction—with its own capital—of the Ahwahnee Hotel, Yosemite Lodge, and Curry Village.⁷⁹ In the case of Grand Canyon National Park, the Fred Harvey Company operated the visitor facilities since the beginning of the twentieth century; the company and its successors “designed, funded, and built hundreds of buildings including numerous landmarks and other notable

without visiting the twinkling lights and red awning of this historic landmark. The name Tavern on the Green transcended a restaurant and became an icon of romance, celebrity, luxury, and of the best that New York has to offer.” Jen Chung, *NYC Unhappy About Possible ‘Tavern on the Green’ Restaurants Outside the City*, *GOTHAMIST: FOOD* (Feb. 26, 2017, 2:28 PM), http://gothamist.com/2017/02/26/nyc_unhappy_about_possible_tavern_o.php. The same webpage mentioned Central Park four other times in the promotional prose. *Id.*

76. Complaint, *Tavern on the Green Int’l*, *supra* note 74; Melanie Grayce West, *NYC Launches New Legal Fight Over Use of Tavern on the Green Restaurant Name*, *WALL ST. J.*, (Feb. 24, 2017), <https://www.wsj.com/articles/nyc-launches-new-legal-fight-over-use-of-tavern-on-the-green-restaurant-name-1487977075?tesla=y>. The salad dressing registration had also expired for failure to file an affidavit of continued use; the concurrent user refiled for that registration, but the City of New York has opposed the registration under Opposition No. 91231725. *Trademark Status & Document Retrieval*, U.S. PATENT & TRADEMARK OFF., http://tsdr.uspto.gov/#caseNumber=86919319&caseType=SERIAL_NO&searchType=statusSearch (last visited Dec. 16, 2017).

77. See Complaint, *DNC Parks & Resorts at Yosemite, Inc. v. United States*, 133 Fed. Cl. 314 (Fed. Cl. Sept. 17, 2015) (No 15-CV-010304) [hereinafter Complaint, *DNC Parks & Resorts*]; Complaint for Declaratory and Injunctive Relief, *Xanterra South Rim, LLC, v. Jewell* (D. Colo. Oct. 10, 2014) (No. 14-CV-02746) [hereinafter Complaint, *Xanterra South Rim*].

78. U.S. GOV’T ACCOUNTABILITY OFF., GAO-17-302, NATIONAL PARK SERVICE: CONCESSIONS PROGRAM HAS MADE CHANGES IN SEVERAL AREAS, BUT CHALLENGES REMAIN 4 (2017).

79. Complaint, *DNC Parks & Resorts*, *supra* note 77, at 2.

attractions,” including El Tovar Hotel, Hopi House, Phantom Ranch, and Bright Angel Lodge.⁸⁰ In each of these parks, many of these structures now have some historical landmark designation.⁸¹

NPS owns the real estate on which these facilities are built but protects private investment in building and maintaining the facilities by requiring that any outgoing concessionaire be paid a “leasehold surrender interest” when a new company takes over the operations of those park facilities.⁸² For example, when Delaware North assumed control over the Yosemite facilities in 1992, the Curry Company relinquished some of its “leasehold surrender” rights, but the new concessionaire was still required to reimburse the Curry Company for “other property,” and Delaware North did so for approximately \$62 million.⁸³

Struggling for funds in the 2010s, NPS decided that its bidding process for concession operations at key national parks was not yielding the financial returns it should, partly because the accrued “leasehold surrender interests” prevented other companies from making competitive bids against legacy concessionaires.⁸⁴ To exacerbate this situation, by 2010 there were only three companies competing with one another for large national park concessions.⁸⁵

In the case of the Grand Canyon, the incumbent concessionaire, Xanterra (formerly Fred Harvey), claimed leasehold surrender interests of \$198 million based on its construction and maintenance of “numerous facilities within Grand Canyon National Park.”⁸⁶ In order to try to reduce this barrier to other competitive bids, NPS attempted different ways to restructure and allocate the private investment at Grand Canyon, including using \$100 million of NPS funds cobbled together from other sources to “buy down” the Xanterra leasehold interest.⁸⁷

80. Complaint, *Xanterra South Rim*, *supra* note 77, at 6.

81. See *National Historic Landmarks Program*, NAT'L PARK SERV., <https://www.nps.gov/nhl/find/statelists.htm> (last visited Dec. 17, 2017).

82. Complaint, *Xanterra South Rim*, *supra* note 77, at 3.

83. Complaint, *DNC Parks & Resorts*, *supra* note 77, at 3.

84. Jason Blevins, *Park Operator Xanterra Files Trademarks for Iconic Grand Canyon Lodges*, DENVER POST (Apr. 25, 2016, 11:29 PM), <http://www.denverpost.com/2015/01/09/park-operator-xanterra-files-trademarks-for-iconic-grand-canyon-lodges/>.

85. *Id.* (“There are only three major players in the national concessions market: Xanterra, Delaware North, and Aramark.”).

86. Complaint, *Xanterra South Rim*, *supra* note 77, at 26.

87. *Id.* at 26–31. In suing NPS, Xanterra alleged that “NPS made this decision . . . to decrease the amount of Park assets controlled by Xanterra and to facilitate entry of another contractor to perform some of the concession activities currently managed by Xanterra.” *Id.* at 27. See also Blevins, *supra* note 84 (“[NPS] in the last year scraped together \$100 million, mostly from 88 of its parks, to pay down Xanterra’s stake in the Grand Canyon in an effort to encourage more competitive bids from other concessionaires, who must reimburse outgoing concessions operators.”).

At both Grand Canyon and Yosemite, the incumbent concessionaires sought to nullify these efforts to increase competition in the bidding.⁸⁸ The easiest way to do that would be to dramatically increase the value of the “leasehold surrender interest.” And the easiest way to do *that* (without really investing money) would be to identify, claim, and *reify* associated intangible rights through trademark registrations.⁸⁹ If there were a tweet to describe the ensuing struggle, it might incorporate one journalist’s observation that “million-dollar trademarks certainly roil the already churning concession contract waters”⁹⁰

At Yosemite, after losing the concession bid to Aramark, the incumbent concessionaire, Delaware North, filed suit against NPS claiming that the “other property” it had purchased from the Curry Company included \$51 million dollars’ worth of trademark rights.⁹¹ Although there was apparently nothing in the contracts specifying what “such other property” was, Delaware North claimed it included “the trademarks, service marks, and logos NPS required [Delaware North] to purchase from Curry Company.”⁹²

Meanwhile, at the Grand Canyon—and after seeing that Delaware North was claiming a \$51 million price tag on the intellectual property Delaware allegedly held at Yosemite⁹³—Xanterra filed “nearly 20 trademark applications” for the names of Grand Canyon lodging facilities it operated.⁹⁴ These included EL TOVAR, the name of a famous hotel on the South Rim of Grand Canyon, as well as PHANTOM RANCH, THUNDERBIRD LODGE, DESERT VIEW WATCHTOWER, KACHINA LODGE, and HOPI HOUSE.⁹⁵ NPS took the position that it was the proper holder of the common law trademark rights based on control of the nature and quality of goods provided by Xanterra at the Grand Canyon

88. See Complaint, *Xanterra South Rim*, *supra* note 77, at 1.

89. Blevins, *supra* note 84.

90. *Id.*

91. Complaint, *DNC Parks & Resorts*, *supra* note 77, at 3 (“Included in the ‘other property’ DNCY was required to purchase from Curry Company were Curry Company’s intangible assets such as registered and unregistered trademarks, servicemarks, and logos”); Kurt Repanshek, *Xanterra Parks & Resorts Abandoning Efforts to Trademark Business Names on South Rim of Grand Canyon National Park*, NAT’L PARKS TRAVELER (Mar. 27, 2015), <https://www.nationalparkstraveler.org/2015/03/xanterra-parks-resorts-abandoning-efforts-trademark-business-names-south-rim-grand-canyon-national-p26435>; Garrett Therolf, *Yosemite’s famous Ahwahnee Hotel to change name in trademark dispute*, L.A. TIMES (Jan. 14, 2016, 4:53 PM), <http://www.latimes.com/local/lanow/la-me-ln-yosemite-ahwahnee-hotel-20160114-story.html> (Delaware North claimed that it had been required in 1993 to purchase “the assets of the previous concessionaire, including its intellectual property”).

92. Complaint, *DNC Parks & Resorts*, *supra* note 77, at 3.

93. Repanshek, *supra* note 91.

94. Blevins, *supra* note 84.

95. Repanshek, *supra* note 91.

facilities.⁹⁶ In the spring of 2015, Xanterra abandoned these applications for trademark registration.⁹⁷

Things did not go so peaceably at Yosemite. For its part, Delaware North acted in one of the opportunistic ways that trademark law now seems to countenance: it sought to register the name YOSEMITE NATIONAL PARK as its own trademark for t-shirts.⁹⁸ With the fight over the Yosemite trademarks becoming more public, on March 1, 2016, NPS changed the name of several landmark facilities at Yosemite: the Ahwahnee Hotel became the “Majestic Yosemite Hotel”; the Curry Village cabins became “Half Dome Village”; and the Wawona Lodge became “Big Trees Lodge.”⁹⁹ A couple of months later, NPS “opened up a new front in the fight over the names” by petitioning the USPTO Trademark Trial and Appeals Board (“TTAB”) for cancellation of the Delaware North registrations.¹⁰⁰

The government’s public explanation for the name change was so that Aramark “could reliably plan ahead for its takeover” of the facilities without fear of a lawsuit from Delaware North.¹⁰¹ But the government also had a clever trademark strategy: since the name “Ahwahnee” is so attached to one particular building, practically speaking, it would be very hard for Delaware North to use these trademarks to provide hotel services at any place outside Yosemite.¹⁰² It is easy to imagine that such use would itself be deceptive. By renaming the buildings, NPS effectively forced these names into non-use and incentivized Delaware North to abandon them.¹⁰³ NPS could even say that it was seeking “to reclaim the old names in hopes that they someday will be restored”¹⁰⁴ because the federal government’s intent to resume use of the names would not be Delaware North’s intent to resume use of the trademarks.¹⁰⁵

96. *Id.*

97. *Id.*

98. Kurtis Alexander, *It’s bye-bye to Yosemite National Park, at least on T-shirts*, SFGATE (Feb. 27, 2016, 6:45 PM), <http://www.sfgate.com/news/article/It-s-bye-bye-to-Yosemite-National-Park-on-6858366.php>.

99. Therolf, *supra* note 91.

100. *U.S. fights to keep iconic Yosemite name trademarks, including The Ahwahnee*, L.A. TIMES (Mar. 21, 2016), <http://www.latimes.com/local/lanow/la-me-ln-u-s-fights-to-keep-iconic-yosemite-name-trademarks-including-the-ahwahnee-20160321-story.html>.

101. Therolf, *supra* note 91.

102. See Editorial, *Landmarks, Not Trademarks*, L.A. TIMES, Jan. 17, 2016, at A23.

103. Editorial, *Trademark grab in Yosemite is too clever by half*, L.A. TIMES (Jan. 15, 2016, 5:06 PM), <http://www.latimes.com/opinion/editorials/la-ed-yosemite-trademarks-20160117-story.html> (“[T]he name change may increase the government’s leverage by slashing the value of the disputed marks.”).

104. Therolf, *supra* note 91.

105. See *id.*

The Yosemite and Grand Canyon disputes have the same general form as the Fraunces Tavern, Casa de Bandini, and Tavern on the Green litigations, i.e., a well-known building or site leased out to a concessionaire that runs a business at the site—and does so long enough to reasonably claim service mark rights.¹⁰⁶ The main difference is that with the national park situations, the concessionaire can make a credible case that it is the successor to the entity that *built* the well-known building: there were no lodges or hotels when the first concession operators arrived in the two national parks.¹⁰⁷ This difference has importance in older case law and might have importance with any intuitions about the proper distribution of intangible value.

E. Webster Hall in Greenwich Village (2017–?)

The final example is the most recent: a case filed in March 2017 concerning the name “Webster Hall.”¹⁰⁸ Webster Hall opened in the East Village of Manhattan in 1887 with an “eclectic Queen Anne facade . . . swathed in ornate red terra cotta tiles”¹⁰⁹ and quickly became an iconic location for fancy dress balls, dance-until-dawn parties, and the city’s early gay and lesbian scene,¹¹⁰ not to mention “a center for leftist, liberal political thought and action.”¹¹¹ From 1953–1968, the building was used as a recording studio for RCA Victor Records; during that period, Julie Andrews, Louis Armstrong, Tony Bennett, Carol Channing, Perry Como, Bob Dylan, Stan Getz, Lena Horne, Liza Minelli, Elvis Presley, and Frank Sinatra all recorded at Webster Hall.¹¹² After RCA Records sold the building, it again became principally an events and concert space—but this time

106. Trevor Hughes & William M. Welch, *Feds Fight Over Who Owns National Park Trademarks*, USA TODAY (Jan. 8, 2015), <https://www.usatoday.com/story/news/nation/2015/01/08/national-park-contract-dispute/21381747/>.

107. *Id.*

108. *Webster Hall Entm’t Corp. v. Unity Gallega of the U.S. Inc.*, No. 1:17-cv-01687 (S.D.N.Y. Mar. 7, 2017).

109. *Webster Hall: 4 Fires, 126 Years, and Countless Concerts at New York’s Greatest Stage*, KEITH YORK CITY (Oct. 16, 2012), <https://keithyorkcity.wordpress.com/2012/10/16/webster-hall-4-fires-126-years-and-countless-concerts-at-new-yorks-greatest-stage/>.

110. See ALLEN CHURCHILL, *THE IMPROPER BOHEMIANS* 109 (1959); JAY SHOCKLEY, *LANDMARK PRESERVATION COMMISSION REPORT, LP-2273, WEBSTER HALL & ANNEX 1* (2008) (“In the 1910s and 20s, it became famous for its masquerade balls The hall was [also] significant as a gathering place for the city’s early twentieth-century lesbian and gay community, who felt welcome to attend the balls in drag, and then sponsored their own events by the 1920s.”).

111. *Webster Hall: 4 Fires, 126 Years, and Countless Concerts at New York’s Greatest Stage*, *supra* note 109; see also JOHN WESLEY HILL & BOUCK WHITE, *DEBATE ON SOCIALISM AT WEBSTER HALL, NEW YORK CITY, MAY 7TH, 1913*, at 5 (Introductory Remarks of the Chairman, Miss Inez Milholland).

112. SHOCKLEY, *supra* note 110, at 19.

called “Casa Galicia,” then the rock club “The Ritz.”¹¹³ When The Ritz nightclub moved to a midtown venue, new concert operators took over the building and fully restored the Webster Hall name in 1990.¹¹⁴

In March 2008, Webster Hall was designated a city landmark by the New York City Landmarks Preservation Commission.¹¹⁵ The Commission’s report noted that

[t]hroughout its history as one of Greenwich Village/East Village’s leading public rental halls and social centers, Webster Hall has been the venue for countless balls, dances, receptions, lectures, meetings, conventions, political and union rallies, military functions, concerts, performances, festivities, and sporting and fundraising events, particularly for the working-class and immigrant populations of the Lower East Side.¹¹⁶

Exemplary of the building’s importance as “[o]ne of New York City’s most historically and culturally significant large nineteenth-century assembly halls,”¹¹⁷ a 2006 book, *Hidden New York*, included a chapter on Webster Hall as one of the roughly thirty “places that matter” in New York City.¹¹⁸ The same history of the building reports that the *New York Times* called Webster Hall a “landmark” as early as 1938.¹¹⁹

In a now familiar turn of events, the tenant—Ballingers USA—decided to register the building’s name as its own trademark¹²⁰ and apparently did so without telling the building owner. Again, the problem emerged when the Ballinger family—their operations already restyled as “Webster Hall Entertainment”—lost the concession/tenancy of the building and were told by the building’s owners that they have no rights to the “Webster Hall” name.¹²¹

113. *Id.* at 2.

114. *Id.* at 12 (“The name Webster Hall was returned in 1990 with the current club, which opened in 1992.”).

115. *Id.* at 19–20.

116. *Id.* at 1.

117. *Id.*

118. MARCI REAVEN & STEVE ZEITLIN, *HIDDEN NEW YORK*, at vii–viii (2006) (notably, Tavern on the Green and Fraunces Tavern did not make the list).

119. *Id.* at 73.

120. WEBSTER HALL, Registration No. 1986825 (WEBSTER HALL for dance hall, night club, restaurant, bar, cafe and catering services); WEBSTER HALL NEW YORK CITY, Registration No. 1986824 (WEBSTER HALL NEW YORK for clothing and “ornamental novelty buttons”); WEBSTER HALL RECORDS, Registration No. 2440293 (WEBSTER HALL RECORDS for sound recordings).

121. Complaint at 7–8, *Webster Hall Entm’t Corp. v. Unity Gallega of the U.S. Inc.*, 1:17-cv-01687 (S.D.N.Y. Mar. 7, 2017) [hereinafter Complaint, *Webster Hall*].

With the loss of their lease imminent,¹²² in March 2017 the Ballingers filed for a declaratory judgment that their WEBSTER HALL trademarks do not infringe any rights held by the building's owner.¹²³

II. PARTIAL SOLUTIONS TO THE PROBLEM

How can it be that trademark law, intended to protect symbols that identify the commercial source of goods and services, effectively forced San Diego to abandon the name of the 1829 “Casa de Bandini,”¹²⁴ compelled the federal government to rename iconic structures in Yosemite¹²⁵, and allowed the name of one of the most famous places in Central Park to appear to be the chief asset of a restaurateur in bankruptcy?¹²⁶ Concerning the 2016 dispute over the Yosemite names, a *Los Angeles Times* editorial commented, “Trademarks over the names and other intrinsic features of iconic destinations such as the Ahwahnee should benefit the owners of those destinations—taxpayers.”¹²⁷ The editorial went on to say that this is how the contracts for these concessions need to be set up,¹²⁸ a point with which it would be hard to disagree.

But at a deeper level there is something dissatisfying about how trademark law has been mapped onto landmark destinations where commercial facilities are operated. Let us consider traditional doctrinal efforts to solve this sort of dilemma and a partial legislative fix. Then, in Part III, we will approach the problem with an analysis that focuses on (geographical) descriptiveness, whether there actually is “secondary meaning” in these cases, and whether any secondary meaning that does exist should be considered as attached to the landmark.

122. Claire Atkinson, *Webster Hall is Getting a Makeover*, N.Y. POST (Apr. 2, 2017, 10:04 PM), <http://nypost.com/2017/04/02/webster-hall-is-getting-a-makeover> (describing how “Brooklyn Sports and Entertainment, is teaming with AEG-backed The Bowery Presents to take over operations at the iconic music venue” from the Ballinger family).

123. See generally Complaint, *Webster Hall*, *supra* note 121.

124. Victor A. Walsh, *Discovering the Unknown: The Casa de Bandini/Cosmopolitan Hotel*, COSMOPOLITAN CHRON., Feb. 18, 2008, [https://www.parks.ca.gov/pages/663/files/cosmochronicle_vol1\(1\).pdf](https://www.parks.ca.gov/pages/663/files/cosmochronicle_vol1(1).pdf).

125. Katia Hetter, *Yosemite National Park Changes Names of Iconic Structures*, CNN (Mar. 1, 2016, 10:09 AM), <http://www.cnn.com/2016/03/01/travel/yosemite-national-park-name-changes-feat/index.html>.

126. Glenn Collins, *Judge Rises to the Challenge in Tavern Trademark Case*, N.Y. TIMES (Dec. 17, 2009, 10:38 AM), https://dinersjournal.blogs.nytimes.com/2009/12/17/judge-rises-to-the-challenge-in-tavern-trademark-case/?_r=0.

127. Editorial, *Trademark grab in Yosemite is too clever by half*, *supra* note 103.

128. *Id.* (“Ideally, the government would own these marks and could license them to concessions operators for the duration of their contracts.”).

A. *Traditional Efforts to Solve the Problem*

The McCarthy treatise subsumes the disputes described above into the category of landlord-tenant problems¹²⁹ and reasons that “[o]wnership of a mark identifying a business carried on at rented premises will depend on an informed balancing of the policies of customer perception and contractual provisions.”¹³⁰ McCarthy views the question as being whether “good will and customer association would be personal to the tenant” or “local to the place.”¹³¹ This comports with the view of an earlier treatise that “certain of these names attach to a place . . . regardless of its ownership, while others have been held to be the property of a person and to attach to him rather than the place.”¹³²

This approach can certainly be seen in pre-Lanham Act, unfair competition/trademark cases that truly were landlord-tenant disputes strictly among private commercial enterprises, quite often about hotel names.¹³³ In these cases, it was common for the lessees that had left the property and were trying to continue use of the trademark to claim that substantial, new good will had been established during their tenancy, i.e., that the secondary meaning attached to the services they had provided at the rented location.¹³⁴ Contractual arrangements figure strongly in these cases, but a few non-contractual metrics also seem to affect the outcome:

- whether the name of the building was “impersonal” or that of the individual conducting the business;¹³⁵

129. MCCARTHY, *supra* note 1, § 16:38.

130. *Id.*

131. *Id.*

132. HARRY D. NIMS, NIMS ON UNFAIR COMPETITION AND TRADE-MARKS §48, at 83 (2d ed. 1917).

133. MCCARTHY, *supra* note 1, § 16:38.

134. *Plitt Theatres, Inc. v. Am. Nat'l. Bank & Trust Co.*, 697 F. Supp. 1031, 1032 (N.D. Ill. 1988) (stating Plaintiff lessee’s position that it “spent at least one million dollars promoting and advertising the mark ‘Esquire’ and the services sold thereunder”); *Freeland v. Burdick*, 204 S.W. 1123, 1123 (Mo. Ct. App. 1918) (“[D]efendant greatly improved the patronage and reputation of the Park Hotel The fact that the hotel has a much larger patronage than before defendant managed it is due partly to her ability as a good hotel keeper and partly to the changed conditions.”); *O’Grady v. McDonald*, 72 N.J. Eq. 805, 806 (N.J. Ch., 1907) (noting tenant claimed that during her tenancy she “gave the hotel of complainant a high standing under its old name, which name, she claims, was of little value prior to that time”).

135. *Vonderbank v. Schmidt*, 10 So. 616, 621 (La. 1892) (control of “Vonderbank Hotel” for a restaurant remained with plaintiff who had quit physical hotel because name “was a personal perquisite of the proprietor while lessee, and not an impersonal ingredient of his business” so “it did not pass to the landlord”); *Stogop Realty v. Marie Antionette Hotel Corp.*, 217 A.D. 555, 559 (N.Y. App. Div. 1926) (impersonal name “Marie Antoinette” given to building in 1893 by builder stayed with building, not 1902 lessee); *Freeland*, 204 S.W. at 1125.

- whether the name originated with the lessee that has now moved off the property OR was the name of the property *when the lessee arrived*;¹³⁶ and
- whether the name has been “applied exclusively to the one place or has been used to designate a person’s business wherever it was conducted.”¹³⁷

All of these metrics fit with the traditional understanding of what trademark law does, helping the court decide—as McCarthy says—whether or not the “good will and customer association would be personal to the tenant.”¹³⁸

But trademark doctrine will only sanction this kind of inquiry between the two parties if we can credibly view the landlord as having used the name in commerce.¹³⁹ One can understand that the Ninth Circuit *Department of Parks & Recreation v. Bazaar del Mundo Inc.*¹⁴⁰ panel found “no evidence tending to show that [the State] adopted and commercially used the marks CASA DE PICO and CASA DE BANDINI” although the two buildings had been *known* as such for decades and had been leased for commercial purposes.¹⁴¹ At the other extreme, the Illinois district court in *Plitt Theatres, Inc. v. American National Bank & Trust Co.*¹⁴² found that the owner of the “Esquire Theatre” had used that name in commerce through simple “management of the theatre building” and that “[t]he mere fact that they chose to lease instead of occupy and operate the theatre building d[id] not show that they failed to use the ‘Esquire’ mark,”¹⁴³ something that might have been said of the State of California’s Old San Diego properties.

But perhaps there is a glint of something else in the other half of McCarthy’s equation: whether the good will is “local to the

136. *Plitt Theatres, Inc.*, 697 F.Supp. at 1036 (“Esquire” was the name of a motion picture theatre before tenant took over operation of theatre; name remained with building); *Woodward v. Lazar*, 21 Cal. 448, 451–52 (1863) (land lessee erected building and operated it as “What Cheer Hotel”; name was property of lessee when lessee abandoned first building and moved business to another property); *Freeland*, 204 S.W. at 1125 (considering “whether the tenant or proprietor who is seeking to divert such name to another place is the person who first gave it such name”); *O’Grady*, 72 N.J. Eq. at 806–07 (“Had the name been one of her own adoption . . . and not one which she only became entitled to use because she was a tenant of the property of complainant, an altogether different condition might exist.”).

137. *Woodward*, 21 Cal. at 451–52 (land lessee entitled to trademark name where “erected building and operated it as ‘What Cheer Hotel’”; name was property of lessee when lessee abandoned first building and moved business to another property); *Freeland*, 204 S.W. at 1125.

138. MCCARTHY, *supra* note 1, § 16:38.

139. *See id.*

140. 448 F.3d 1118 (9th Cir. 2006).

141. *Id.* at 1126.

142. 697 F. Supp. 1031 (N.D. Ill. 1988).

143. *Id.* at 1035.

place.”¹⁴⁴ Indeed, over and over, jurists writing about these cases use formulations that stress the “place,” not a *business with good will at that place*. For example, the 1918 *Freeland v. Burdick*¹⁴⁵ court said that hotels “take local names which generally belong to and designate the place rather than the proprietor of the business,”¹⁴⁶ that “the name becomes an inseparable part of the building or premises,”¹⁴⁷ and that a name “ordinarily attaches to and remains with the location rather than with the particular proprietor.”¹⁴⁸ Discussing the sale of hotels, an early twentieth-century treatise says, “[i]n such cases he who buys the buildings, or acquires the right to occupy them, will have the right to use the name attaching thereto, in the absence of very explicit contractual arrangements”¹⁴⁹ and a 1924 trademark treatise concludes that in the case “of the good will of a public house, it is obvious that it is a thing which is attached to the locality.”¹⁵⁰

Nineteenth- and early twentieth-century English trademark law took this idea further or made the idea explicit. According to the 1913 *Halsbury’s Laws of England*, “[w]here a place of business is sold, even without the good will, the right to use the name of that place usually passes to the purchaser, particularly if the name is carved on or affixed to the building.”¹⁵¹

In that same spirit, a 1926 New York case emphasized the point that the hotel name the plaintiff sought to retain was “cut into the stonework over the entrance to the building where it still remains[.]”¹⁵² and a 1988 Chicago court stressed that when the 1938 building was built it “included a marquee and a vertical sign

144. *Id.*

145. 204 S.W. 1123 (Mo. Ct. App. 1918)

146. *Id.* at 1124.

147. *Id.*

148. *Id.* at 1125.

149. NIMS, *supra* note 132, § 21.

150. JAMES L. HOPKINS, *THE LAW OF TRADEMARKS, TRADENAMES AND UNFAIR COMPETITION* 228–29 (4th ed. 1924) (“But when we come to speak of the good will of a public house, it is obvious that it is a thing which is attached to a locality.’ In accordance with this rule, whenever the good will is local, in the sense of being attached to a particular house or store, it will pass with a sale of the lease of the trading premises, or the sale of a public house.”).

151. 27 HALSBURY’S LAWS OF ENGLAND 755 (1913).

152. *Stogop Realty v. Marie Antionette Hotel Corp.*, 217 A.D. 555, 557 (N.Y. App. Div. 1926). The degree to which the building was “branded” went much further: “Mr. Flanagan determined to adopt and to appropriate the name ‘Marie Antoinette’ to designate this hotel building, and with this purpose in view caused such name to be cut into the stone work over the entrance to the building where it still remains. The initials ‘M. A.’ were wrought into the design of the ornamental iron gates and grill work at the entrance to the building, all of which are still in place and these letters were upon all the door knobs, upon the iron gratings and the elevator doors, upon the lighting fixtures, decorations and on other parts of the building.” *Id.*

containing the name ‘Esquire’ which has remained on the façade for the building to date.”¹⁵³

Whether or not a name is carved in stone or remains on a marquee has little bearing on *where* the consumer good will attaches. To conclude that the “names . . . generally designate the place rather than the current operating tenant”;¹⁵⁴ that a trade name is “attached to the locality”;¹⁵⁵ that the name is “an inseparable part of the building or premises”;¹⁵⁶ or that the name is “local to the place”¹⁵⁷ is to reach a conclusion that is somewhat different than *who* holds the goodwill associated with a name. Indeed, I will argue that these are oblique concessions that the name is just descriptive of the *place*.

B. A Partial Legislative Recognition of the Problem

Interestingly, in the 1999 Anticybersquatting Consumer Protection Act (“ACPA”),¹⁵⁸ Congress added a provision which partially addresses the landmark trademark problem:

Notwithstanding section 1125(c) of title 15, buildings and structures on or eligible for inclusion on the National Register of Historic Places (either individually or as part of a historic district), or designated as an individual landmark or as a contributing building in a historic district by a unit of State or local government, may retain the name historically associated with the building or structure.¹⁵⁹

A broad range of building names can benefit from this safe harbor since the building only need be “eligible” for inclusion on the National Register of Historic Places or designated a “landmark” by a *local government*.¹⁶⁰ On the other hand, since 15 U.S.C. § 1125(c) is the federal dilution statute, the safe harbor only extends to federal dilution claims and would not protect a landmark building owner from a trademark holder’s infringement claim based on likelihood of confusion.¹⁶¹ The National Park Service’s use of “Yosemite Lodge”

153. *Plitt Theatres, Inc. v. Am. Nat’l. Bank & Trust Co.*, 697 F. Supp. 1031, 1032 (N.D. Ill. 1988).

154. MCCARTHY, *supra* note 1, § 16:38.

155. HOPKINS, *supra* note 150, at 229.

156. *Freeland v. Burdick*, 204 S.W. 1123, 1124 (Mo. Ct. App. 1918).

157. MCCARTHY, *supra* note 1, § 16:38.

158. 15 U.S.C. § 1125(d) (2012).

159. In 1999, the provision was placed at 16 U.S.C. § 470a(a)(1)(A). In 2014, this provision was moved to a new, consolidated Title 54 for all statutory provisions related to the National Park Service. Act of Dec. 19, 2014, Pub. L. No. 113-287, § 3, 128 Stat. 3193 (codified at 54 U.S.C. § 302106 (“Retention of name”).

160. *National Register of Historic Places*, NAT’L PARK SERV., <https://www.nps.gov/nr/> (last visited Dec. 16, 2017).

161. 15 U.S.C. § 1125(c).

may be protected from a dilution claim by Apple based on its YOSEMITE operating system¹⁶² but not against a likelihood of confusion claim from the owner of a registered mark for YOSEMITE in relation to lodging.¹⁶³ Not surprisingly, this provision was not designed for the sort of problems that have arisen in the Tavern on the Green, Casa de Bandini, and Yosemite disputes.

For trademark practitioners, the ACPA is principally known for adding subsection (d) to section 43 of the Lanham Act providing a cause of action against “cybersquatters” who buy domain names that corresponded to well-known trademarks.¹⁶⁴ Such an initial version of the ACPA passed the Senate on August 5, 1999.¹⁶⁵ But by the time the bill came before the House for a floor vote on October 26, 1999, two members of Congress representing Miami—Ileana Ros-Lehtinen and E. Clay Shaw—secured an agreement by the House subcommittee on intellectual property to add the provision on historical buildings.¹⁶⁶

The Ros-Lehtinen/Shaw concern was that federalization of dilution claims a few years earlier (1996) had created the prospect that owners of buildings in the Art Deco district of Miami Beach with names dating back to the 1920s could be sued by owners of famous trademarks, often in unrelated industries.¹⁶⁷ The poster child for this problem was the “Tiffany Hotel” which had lost the right to use its own name in a dilution case brought by the New York jeweler.¹⁶⁸ Since lawsuits for likelihood of confusion had not been a problem for this Miami community before 1996, the problem was perceived as limited to the 1996 dilution statute.¹⁶⁹ The wording of the provision—including any building in “a historic

162. *Upgrade to Yosemite*, APPLE, <https://www.apple.com/asia/support/osx/upgrade/> (last visited Dec. 16, 2017).

163. This point was probably not understood by one journalist following the disputes. See Repanshek, *supra* note 91 (noting that “efforts by concessionaires to capitalize on the names of such iconic lodges . . . might actually be moot” under 54 U.S.C. § 302106).

164. 15 U.S.C. § 1125(d).

165. S. REP. NO. 106-140 (1999).

166. *Id.*

167. 145 CONG. REC. 26,868–26,869 (1999).

168. *Tiffany by any other name is fake: Miami Beach’s historic hotels losing trademark battles*, ORLANDO SENTINEL, Aug. 15, 1999 at B3.

169. *Id.* (stating that the lawsuits “were sparked by a 1996 amendment made to the 53-year-old Lanham Act” and that “[t]he amendment introduced the legal concept of ‘dilution,’ the theory that a company’s trademark could be ‘watered down’ if used by another”); see 145 CONG. REC. 26,868 (statement of Rep. Ros-Lehtinen) (describing her amendment as being to “protect historic landmarks in our area in South Miami Beach and around the country from unnecessary litigation due to a provision in the Federal Anti-Dilution Act”); 145 CONG. REC. 26,869 (statement of Rep. Shaw) (describing the amendment as intended to reverse “unintended circumstance in the 1996 law, many of these hotels were robbed of their identity and were forced and were being made to change their name”).

district”—swept in most of the valuable commercial real estate in Miami Beach.¹⁷⁰ This statutory provision shielding landmark buildings from dilution actions is appropriately titled “Retention of name”¹⁷¹—absent a parallel provision for likelihood of confusion, a new doctrinal analysis is necessary to ensure that landmarks do retain their names.

III. ADDRESSING LANDMARK TRADEMARKS WITH REINVIGORATED “DESCRIPTIVENESS” ANALYSIS

The proposal here is that USPTO trademark examiners, the TTAB, and courts have failed to engage in the kind of robust “descriptiveness” analysis appropriate in these scenarios. When it comes to claims to trademark rights over names of landmarks, instead of the principal query being as to who properly holds the “secondary meaning,” there should be considerably greater scrutiny as to whether true secondary meaning exists. Let us first consider this point through the vehicle of “geographical descriptiveness,” then through case law that has emphasized that “highly descriptive” names require heightened proof of secondary meaning. In addition, decision-makers should consider whether any secondary meaning is inextricably attached to a landmark. By either route, in most of these fact patterns any trademark rights should not be portable; whatever rights exist should stay with the landmark.

A. *Names of Landmark Buildings Are “Geographically Descriptive”*

Courts have not completely ignored the descriptive nature of landmark names.¹⁷² Although it concluded that there was no commercial use of the marks by the State, the *Bazaar del Mundo* appellate panel recognized that the marks began as descriptive terms “based on their geographic and historical origin,”¹⁷³ that the leased buildings had their names before Bazaar del Mundo started its operations,¹⁷⁴ and that “due to their historical significance, the Bandini and Pico families, names and homes are described in most if

170. For a map showing the many historic districts of Miami Beach, see *Miami Beach Historic Districts and Sites*, MDPL, <http://www.mdpl.org/wp-content/uploads/Miami-Beach-Historic-Districts-and-Sites.pdf> (last visited Dec. 16, 2017).

171. 54 U.S.C. § 302106 (2012).

172. See generally *Dep’t of Parks & Recreation v. Bazaar del Mundo Inc.*, 448 F.3d 1118 (9th Cir. 2006) (acknowledging the historical nature of the Casa de Bandini); *Hotel Syracuse, Inc. v. Motel Syracuse, Inc.*, 100 U.S.P.Q. 200 (N.Y. App. Div. 1954) (acknowledging the Hotel Syracuse as a well-regarded hotel).

173. *Bazaar del Mundo*, 448 F.3d at 1127.

174. *Id.* at 1129 (reciting that the Concession Agreement stated that “[t]he concession shall be located in the premises . . . known as the Casa de Pico Building . . . and the Casa de Bandini”).

not all of [the] books, brochures and guides” describing historical San Diego.¹⁷⁵

Any other conclusion would have ignored San Diego history. Consider some of the evidence (available to us, not necessarily the court) establishing that the building in which Diana Powers operated her restaurant was the Casa de Bandini in the sense that the name was commonly applied to the building since Juan Bandini built the edifice on that site in 1827:

- San Diego’s leading newspaper wrote in 1935 that “[i]n all California there is no more romantic building than the Casa de Bandini”;¹⁷⁶
- a 1949 pamphlet described the “Casa de Bandini” as a “125 year old showplace”;¹⁷⁷ and
- a historian wrote in 2008 that the “Casa de Bandini . . . is one of the most historically significant buildings in California.”¹⁷⁸

Indeed, the 1971 Concession Contract between Powers’ company and the California Department of Parks and Recreation established a lease on “the premises provided by the State and *known as the Casa de Pico Buildings . . . of Old San Diego.*”¹⁷⁹ An amendment of the Concession Contract that became effective on December 1, 1972, mentions “Bandini House—Cosmopolitan Hotel.”¹⁸⁰ In litigation, Ms. Powers’ company recognized that Casa del Pico was used “to

175. *Id.* at 1126.

176. *Casa de Bandini: Social Center of Old California Restored to Former Brilliance*, SAN DIEGO UNION, Apr. 24, 1935 (on file with author).

177. Pamphlet, *San Diego County Historical Days* at 10 (Oct. 1–2, 1949) (on file with author).

178. William F. Mennell, *What is Adobe?*, COSMOPOLITAN CHRON., May 30, 2008, [https://www.parks.ca.gov/pages/663/files/cosmochronicle_vol1\(1\).pdf](https://www.parks.ca.gov/pages/663/files/cosmochronicle_vol1(1).pdf) (“It is speculated that the Casa de Bandini and the Casa de Estudillo, the 2 largest homes of the time in San Diego, were made by the same small, skilled, disciplined, and well-organized workforce.”). This publication was organized by people working on the buildings restoration during the late 2000s. *See, e.g.*, COSMOPOLITAN CHRON., May 30, 2008, [https://www.parks.ca.gov/pages/663/files/cosmochronicle_vol1\(1\).pdf](https://www.parks.ca.gov/pages/663/files/cosmochronicle_vol1(1).pdf) (“True tales from the annals of history, archaeology, construction, and restoration of the Casa de Bandini & Cosmopolitan Hotel.”); Victor A. Walsh, *Discovering the Unknown: The Casa de Bandini/Cosmopolitan Hotel*, COSMOPOLITAN CHRON., Mar. 4, 2008, [https://www.parks.ca.gov/pages/663/files/cosmochronicle_vol1\(1\).pdf](https://www.parks.ca.gov/pages/663/files/cosmochronicle_vol1(1).pdf) (“The Casa de Bandini/Cosmopolitan Hotel is a priceless historical resource.”); Walsh, *supra* note 124 (“The Casa de Bandini, erected between 1827–1829, is one of the most historically significant buildings in California.”).

179. Brief of Defendant-Appellee at 8–9, *Dep’t of Parks & Recreation v. Bazaar del Mundo Inc.*, 448 F.3d 1118 (9th Cir. 2006) (No. 05-55828) (citing ER (excerpts of records) 12–42, especially at 14) (emphasis added).

180. *Id.* at 10 (citing ER 56).

describe certain physical premises”;¹⁸¹ that “the few references to ‘Casa de Pico’ were . . . descriptive or geographical indications of the leased premises”;¹⁸² and that “Bandini House-Cosmopolitan Hotel” was a “geographically descriptive term of part of the leased premises.”¹⁸³

These nuggets from the Casa de Bandini litigation point us toward understanding the issue through the lens of geographical descriptiveness. Congressman Fritz Lanham’s original 1938 proposal for a revised Trademark Act would have prohibited registration of any mark that “has merely a descriptive or geographic meaning.”¹⁸⁴ Edward S. Rogers alternatively proposed that registration would be barred “when applied to the goods of the applicant” the mark is “primarily geographical *and* descriptive of them.”¹⁸⁵ Apparently, Lanham and Rogers reached an entente, and Rogers subsequently suggested barring registration of a mark that “[w]hen applied to the goods of the applicant is primarily geographically descriptive of them.”¹⁸⁶ This is the formula that Congressman Lanham used when he reintroduced the trademark bill in June 1939¹⁸⁷ and that survived to the law’s enactment in 1946.¹⁸⁸

181. *Id.* at 10 (citing ER 51).

182. *Id.* at 21 (citing ER 14–51).

183. *Id.* at 10 (citing ER 56).

184. H.R. 9041, 75th Cong. § 3(e) (Jan. 19, 1938), as reprinted in *In re The Newbridge Cutlery Co.*, 776 F.3d 854, 858 (Fed. Cir. 2015). After some criticism, in 1939 Congressman Lanham proposed that the language prevent registration of “a mark which, when applied to the goods of the applicant, has merely a descriptive or geographical, *and no other, meaning.*” H.R. 4744, 76th Cong. § 2(e) (Mar. 3, 1939), as reprinted in *In re The Newbridge Cutlery Co.*, 776 F.3d at 858.

185. *Trade-Marks: Hearing on H.R. 4744 Before the Subcomm. on Trade-Marks of the House Comm. on Patents*, 76th Cong. 19 (1939) (statement of Edward S. Rogers) (emphasis added). Mr. Rogers was an influential figure in efforts to revise American trademark law in the first half of the twentieth century. See generally Walter J. Derenberg, *The Contribution of Edward S. Rogers to the Trademark Act of 1946 in Historical Perspective*, 62 TRADEMARK REP. 189 (1972).

186. *Trade-Marks: Hearing on H.R. 4744 Before the Subcomm. on Trade-Marks of the House Comm. on Patents*, 76th Cong. 39 (1939).

187. *In re The Newbridge Cutlery Co.*, 776 F.3d at 858–59.

188. While the language has been tweaked and moved, congressional intent has been for the agreed upon 1939 standard to remain unchanged. Lanham Act, ch. 540, § 2, 60 Stat. 427, 429 (1946) (amended 1988), as reprinted in *In re The Newbridge Cutlery Co.*, 776 F.3d at 858–59. In 1988, Congress replaced “when applied to the goods of the applicant” with “when used on or in connection with the goods of the applicant.” 15 U.S.C. § 1052(e)(2) (2012). No change in meaning was intended. S. REP. NO. 100-515, at 22 (1988), as reprinted in 1988 U.S.C.C.A.N. 5577, 5584. In 1993, Congress separated “primarily geographically descriptive” and “primarily geographically deceptively misdescriptive” marks in (e)(2) and (e)(3) respectively in response to NAFTA, but the legislative history explains that “[t]he law as it relates to ‘primarily

Precedent has established that “geographical” names or terms in trademark law include nouns, adjectival forms,¹⁸⁹ and abbreviations referring to continents,¹⁹⁰ countries (including close derivatives),¹⁹¹ provinces and states (including nicknames),¹⁹² islands,¹⁹³ bays and coastal regions,¹⁹⁴ mountain regions,¹⁹⁵ cities and city boroughs,¹⁹⁶ streets,¹⁹⁷ parks,¹⁹⁸ and small local areas and neighborhoods.¹⁹⁹ A word that is capable of being geographically

geographically descriptive’ marks would remain unchanged.” *In re California Innovations, Inc.*, 329 F.3d 1334, 1339–40 (Fed. Cir. 2003) (quoting 139 CONG. REC. 30,237 (1993)).

189. *See, e.g.*, *Nat’l Lead Co. v. Wolf*, 223 F.2d 195, 199 (9th Cir. 1955) (“Of course the word ‘Dutch’ is capable of being used as a geographical term. If used to indicate a product made in Holland . . . it could be a descriptive term.”).

190. *N. Am. Aircoach Sys., Inc. v. N. Am. Aviation, Inc.*, 231 F.2d 205, 211 (9th Cir. 1955) (interpreting California law in relation to “North American,” but finding secondary meaning); *see, e.g.*, *Companhia Antarctica Paulista v. Coe*, 146 F.2d 669 (D.C. Cir. 1945) (affirming lower court conclusion that “Antarctica” was a geographical term).

191. *See, e.g.*, *Schoenfeld Indus., Inc. v. Britannia Sales, Ltd.*, 512 F. Supp. 979, 982 (S.D.N.Y. 1981) (“BRITANNIA” is capable of being a geographical term for Great Britain).

192. *In re Loew’s Theatres, Inc.*, 769 F.2d 764, 768 (Fed. Cir. 1985) (“DURANGO” (Mexico) is a geographical designation); *In re Midwest Nut & Seed Co.*, 214 U.S.P.Q. 852, 854 (T.T.A.B. 1982) (“CALIFORNIA” is a geographical term); *In re Charles S. Loeb Pipes, Inc.*, 190 U.S.P.Q. 238, 246 (T.T.A.B. 1975) (“OLD DOMINION” is a geographical term).

193. *See, e.g.*, *In re The Cookie Kitchen, Inc.* 228 U.S.P.Q. 873, 874 (T.T.A.B. 1986) (“MANHATTAN” is a geographical term).

194. *OBX-Stock, Inc. v. Bicast, Inc.*, 558 F.3d 334, 339 (4th Cir. 2009) (affirming PTO and district court conclusion that “OBX” is “a geographically descriptive or generic term for the Outer Banks” against applicant who had *coined the term* for use designating the Outer Banks); *Phillips v. Governor & Co. of Adventurers of Eng. Trading into Hudson’s Bay*, 79 F.2d 971, 973 (9th Cir. 1935).

195. *See, e.g.*, *Burke-Parsons-Bowlby Corp. v. Appalachian Log Homes, Inc.*, 871 F.2d 590, 595 (6th Cir. 1989) (“APPALACHIAN” is geographically descriptive for log structures manufactured in a state that forms part of Appalachia).

196. *See, e.g.*, *In re Wada*, 194 F.3d 1297, 1302 (Fed. Cir. 1999) (affirming PTO ruling that “NEW YORK WAYS GALLERY” was primarily geographically deceptively misdescriptive); *In re The Cookie Kitchen*, 228 U.S.P.Q. at 874 (“MANHATTAN” is a geographical term).

197. *See, e.g.*, *Philip Morris v. Reemtsma Cigarettenfabriken GmbH*, 14 U.S.P.Q.2d 1487, 1488 (T.T.A.B., 1990) (“PARK AVENUE” is a geographical designation); *In re Jacques Bernier, Inc.*, 10 U.S.P.Q.2d 1955, 1957 (T.T.A.B., 1989) (“RODEO DRIVE” is a geographical designation).

198. *See, e.g.*, *Belvidere Land Co. v. Owen Park Plaza, Inc.*, 106 N.W.2d 380, 383 (Mich. 1960) (finding “Owen Park” is a geographical name and that “the general rule is that geographic and place names may be used by all for indicating the location of business,” subject to injunctions to address consumer confusion or deception).

199. *See, e.g.*, *Sand Hill Advisors, LLC v. Sand Hill Advisors, LLC*, 680 F. Supp. 2d 1107, 1115 (N.D. Cal. 2010) (designating that “Sand Hill” was a

descriptive needs to be specific enough that consumers could believe it designates the place where the goods are manufactured or used.²⁰⁰ Courts and commentators have reasoned that “national,”²⁰¹ “international,”²⁰² “world,”²⁰³ or “globe”²⁰⁴ are too general to raise concerns as geographical terms that pinpoint the source of goods.²⁰⁵

There appear to be no reported cases concluding that the name of a single building—arguably the most specific of public locations—can be a geographical term for purposes of section 2 of the Lanham Act.²⁰⁶ But the tests set out by courts and commentators certainly apply. As the Second Circuit wrote in a 1994 decision, “[a] geographically descriptive term or phrase is one that designates geographical *location* and would tend to be regarded by buyers as descriptive of the geographic location or origin of the goods or services.”²⁰⁷ Or, as the leading treatise asks and answers, “[i]s the mark the name of the *place* or region from which the goods actually come? If the answer is yes, then the geographic term is probably used in [a] descriptive sense, and secondary meaning is required for protection.”²⁰⁸ These landmark buildings are certainly locations and

geographical term when used to designate a small local area within Silicon Valley known for its concentration of venture capital firms).

200. *OBX-Stock, Inc. v. Bicast, Inc.*, 558 F.3d 334, 341 (4th Cir. 2009) (“[S]econdary meaning has been established in a geographically descriptive mark where the mark no longer causes the public to associate the goods with a particular place, but to associate the goods with a particular source.”); *Bos. Beer Co. Ltd. P’ship v. Slesar Bros. Brewing Co., Inc.*, 9 F.3d 175, 181 (1st Cir. 1993) (same).

201. LOUIS ALTMAN & MALLA POLLACK, *CALLMANN ON UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES* § 18:60 (4th ed. 2016), Westlaw (stating that “national” and “international” are too general to be geographical terms).

202. *Id.*

203. *World Carpets, Inc. v. Dick Littrell’s New World Carpets*, 438 F.2d 482, 486–87 (5th Cir 1971) (stating that “WORLD” is “a term far too broad to suggest any identifiable unit or place of origin” and that it cannot “be said that the term is used in a descriptive fashion, for it neither relates to the place of origin of the goods so marked, nor is it descriptive of the bounds within which the trademark owner functions”).

204. *Champion Spark Plug Co. v. Globe Union Mfg. Co.*, 88 F.2d 970, 972 (C.C.P.A. 1937) (“‘Globe’ has no such geographical significance; it identifies no particular geographical location.”).

205. ALTMAN & POLLACK, *supra* note 201, § 18:61.

206. However, in a 2000 decision, a district court found that a defendant’s use of the name of the shopping complex in which it was located—“Century Centre”—was a “geographically descriptive” use, providing a defense against an infringement charge from holders of the CENTURY THEATRES trademarks. *Century Theatres, Inc. v. Landmark Theatres Corp.*, 55 U.S.P.Q.2d 1203, 1207 (N.D. Cal. 2000).

207. *Forschner Group, Inc. v. Arrow Trading Co., Inc.*, 30 F.3d 348, 355 (2d Cir. 1994) (emphasis added) (quoting MCCARTHY, *supra* note 1, § 14:2).

208. MCCARTHY, *supra* note 1, § 14:7, at 14–35 (emphasis added). These building names also meet McCarthy’s standard that “[a] ‘geographically descriptive term’ is any noun or adjective that designates geographical location

places. So, if we are true to McCarthy's view that "[a] geographically descriptive term can indicate any geographic location on earth . . . referred to by a recognized name,"²⁰⁹ landmark building names are geographically descriptive terms.

Assuming that landmark buildings are geographical names—what, then, is the analysis? Appellate courts have laid down the principle that "[s]econdary meaning' in connection with geographically descriptive marks means that the mark no longer causes the public to associate the goods with the geographical location, but to associate the goods with a particular product or source of the product."²¹⁰ That secondary meaning is established in a geographically descriptive mark only "where the mark no longer causes the public to associate the goods with a particular place, but to associate the goods with a particular product or source of the product."²¹¹ The Federal Circuit may be slightly more favorable to the putative trademark holder in its conclusion that with "primarily geographically descriptive" terms the "refusal to register extends . . . only to those marks for which the geographical meaning is perceived by the relevant public as the *primary* meaning."²¹² But this approach really leads to the same result. To use an example from the First Circuit,

To establish secondary meaning in the mark "Boston," not only must appellant prove that, when read or heard by consumers in connection with beer, "Boston" no longer means that the beer was brewed in Boston or by a Boston-based brewer, but that the consuming public recognizes that the word "Boston" identifies appellant as the source of the beer.²¹³

If secondary meaning in a geographically descriptive term is established only when the term "no longer cause the public to associate the goods with a particular place but to associate the goods with a particular source,"²¹⁴ then it is quite difficult to see how secondary meaning was ever achieved for goods and services at Fraunces Tavern, Tavern on the Green, the Casa de Bandini, or any of the iconic hotels at Yosemite and Grand Canyon. To establish

and would tend to be regarded by buyers as descriptive of the geographic location of origin of the goods or services." *Id.* § 14:2.

209. *Id.* § 14:3.

210. *OBX-Stock, Inc. v. Bicast, Inc.*, 558 F.3d 334, 340 (4th Cir. 2009).

211. *Id.* at 341 (quoting *Resorts of Pinehurst, Inc. v. Pinehurst Nat'l Corp.*, 148 F.3d 417, 421 (4th Cir. 1998)).

212. *In re The Newbridge Cutlery Co.*, 776 F.3d 854, 859 (Fed. Cir. 2015) (stating that the meaning is "to be assessed as it is used *on or in connection with the goods*").

213. *Bos. Beer Co. Ltd. P'ship v. Slesar Bros. Brewing Co., Inc.*, 9 F.3d 175, 181–82 (1st Cir. 1993).

214. *OBX-Stock, Inc.*, 558 F.3d at 341 (quoting *Resorts of Pinehurst*, 148 F.3d at 421).

secondary meaning in the mark CASA DE PICO, Bazaar del Mundo should not only prove that when consumers read or heard “Casa de Pico” in connection with food they were eating at Casa de Pico, “Casa de Pico” no longer meant the building in which they were sitting, but instead a company called Bazaar del Mundo. That would be a hard thing to do, particularly given that “[t]he restaurants’ menu . . . contain[ed] a lengthy description of the history of Casa de Pico.”²¹⁵

Courts agree that the “primarily geographically descriptive” standard means that “refusal to register extends . . . only to those marks for which the geographical meaning is perceived by the relevant public as the *primary* meaning.”²¹⁶ The Federal Circuit’s predecessor, the Court of Customs and Patent Appeals, had characterized this standard as a “connection of the geographical meaning of the mark with the goods in the public mind.”²¹⁷ This connection—or one version of this connection—is the “goods/place association.”²¹⁸ In order for a PTO examiner to find that a mark is geographically descriptive because of a goods/place association, the examiner need only show a “reasonable predicate”²¹⁹ for her conclusion that the “purchasing public in the United States of these types of goods”²²⁰ would be “likely”²²¹ to make the goods/place association. And the goods/place association can be assumed when the goods or goods of that type are known by the consumer to actually come from that place.²²²

215. Westlake Letter, *supra* note 31. The menu’s “lengthy description” can be found in one of the specimens of use of the trademark filed with the USPTO (on file with author). In the application for trademark registration, counsel for Bazaar del Mundo argued that “[p]atrons of the restaurant are clearly aware that the ‘Pico’ in Casa de Pico refers to Governor Pico.” *Id.* As late as 2005—when Bazaar del Mundo lost their lease—the website for the restaurant said, “The Casa del Pico restaurant is situated on the origin site of the home of General Pico, the last Governor of California during Mexican rule.” U.S. Trademark Application Serial No. 73516325 (filed Jan. 7, 1985) (on file with author).

216. *In re The Newbridge Cutlery Co.*, 776 F.3d at 859 (stating that meaning is “to be assessed as it is used *on or in connection with the goods*”).

217. *In re Nantucket, Inc.*, 677 F.2d 95, 99 (C.C.P.A. 1982).

218. *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 959 (Fed. Cir. 1987); *In re The Newbridge Cutlery Co.*, 776 F.3d at 860.

219. *The Newbridge Cutlery Co.*, 776 F.3d at 861; *In re Miracle Tuesday, LLC*, 695 F.3d 1339, 1344 (Fed. Cir. 2012); *In re Pacer Technology*, 338 F.3d 1348, 1351 (Fed. Cir. 2003).

220. *In re The Newbridge Cutlery Co.*, 776 F.3d at 861; *accord* Institut Nat’l des Appellations D’Origine v. Vintners, Int’l Co., 958 F.2d 1574, 1581 (Fed. Cir. 1992).

221. *In re The Newbridge Cutlery Co.*, 776 F.3d at 861.

222. *See generally* OBX-Stock, Inc. v. Bicast, Inc., 558 F.3d 334 (4th Cir. 2009) (the stickers originated in the Outer Banks); *Bos. Beer Co. Ltd. P’ship v. Slesar Bros. Brewing Co., Inc.*, 9 F.3d 175 (1st Cir. 1993) (the beer originated in Boston).

For the trademark to be protectable, the building cannot be the primary meaning in the mind of the consumer.²²³ It strains credulity to believe that consumers did not think they were going to a building called the Casa de Bandini more than a restaurant run by Diana Powers/Bazaar del Mundo called Casa de Bandini. In 2005, you are sitting in the Tavern on the Green and order the turkey and dressing Christmas special: where do you think the meal comes from? In 2014, you are sitting ordering coffee or a martini in Yosemite's Ahwahnee Hotel: where do you think the beverage comes from? In each case, there is not only no question that the consumer knows about the geographic feature (they are in the building), the building surely dominates the consumer's cognition in relation to the term.²²⁴

There are a couple of potential arguments against treating landmark names as geographic names. One is an objection to "geographical descriptiveness" unique to the national park disputes: the private concessionaires' claims to be the direct successors to those who had built and named the landmarks.²²⁵ That objection seems to distinguish those disputes from the typical geographical descriptiveness situation in which a private business adopts the pre-existing name of its location as part of its own commercial name, i.e., CINCINNATI BELL²²⁶ or the *Sacramento Bee*.²²⁷

But there is nothing in trademark doctrine that would prevent a private commercial entity from itself establishing a geographically descriptive name: indeed, that is what real estate developers do all the time when they build and name new streets, new neighborhoods, and new towns. In its 2009 decision in *OBX-Stock, Inc. v. Bicast, Inc.*,²²⁸ the Fourth Circuit considered the trademark claim of James Douglas, the man who coined "OBX" as a designation for the Outer Banks region of North Carolina.²²⁹ Douglas created the

223. For a similar point, see Joseph C. Daniels, *The Branding of America: The Rise of Geographic Trademarks and the Need for a Strong Fair Use Defense* 94 IOWA L. REV. 1703, 1730–31 (2009) ("That is to say, when a consumer sees a geographic description in the mark, is he associating that description with the actual location or with the producer? If the consumer is associating the geographic description with the location and not the producer, it would seem that any secondary meaning that mark had would not extend to the geographic terms.").

224. See generally *Dep't. of Parks & Recreation v. Bazaar del Mundo Inc.*, 448 F.3d 1118 (9th Cir. 2006) ("Casa de Bandini" had been chosen as the name of the restaurant due to the historical nature of the building).

225. Complaint, *DNC Parks & Resorts*, *supra* note 77, at 3; Complaint, *Xanterra South Rim*, *supra* note 77, at 6.

226. *History*, CINCINNATI BELL, <https://www.cincinnati-bell.com/about-us/history> (last visited Dec. 16, 2017).

227. *About Us*, SACRAMENTO BEE, <http://www.sacbee.com/customer-service/about-us/> (last visited Dec. 16, 2017).

228. 558 F.3d 334 (4th Cir. 2009).

229. *Id.* at 337.

abbreviation and marketed it on white oval stickers to mimic the oval stickers used with international automobile registration codes (“AUS” for Australia, “D” for Germany, “IRL” for Ireland, etc.).²³⁰ Douglas and his company, OBX-Stock, were quite successful in getting people to adopt this new symbol for the Outer Banks region, the appellate court noting that “[a]s a result of OBX-Stock’s efforts in promoting OBX as a designation for the Outer Banks, the businesses and residents of the Outer Banks have come to use the abbreviation OBX on a daily basis to refer to the Outer Banks.”²³¹ On that basis, the court found that “OBX” was geographically descriptive and that Douglas’ company had done little or nothing to establish any secondary meaning for the term.²³²

A more serious challenge to treating building names as geographic terms is rooted in policy considerations. One of the reasons for a robust application of “geographical descriptiveness” is that other commercial interests in that location should be able to use the place name simultaneously.²³³ In discussing the Lanham Act, a 1971 Fifth Circuit opinion concluded that

Congress ha[d] expressly left accessible to all potential users those names of subdivisions of the earth—regions, nations, counties, towns, rivers, lakes, and other natural and artificial geographical units—which could be employed to draw public attention to the origin of a product or the situs of a business. It would obviously promote unfair competition to proscribe for all save a single producer the name of a region and thereby preclude other producers of the same product in the same region from indicating their product’s origin.²³⁴

As far back as 1871, the Supreme Court cautioned that the policy reason against trademark rights over geographical names was the same as against trademark rights over descriptive and generic

230. *Id.*; see generally *Distinguishing Signs Used on Vehicles in Int’l Trade*, UNECE, <http://www.unece.org/fileadmin/DAM/trans/conventn/Distsigns> (last visited Dec. 16, 2017).

231. *OBX-Stock Inc.*, 558 F.3d at 338.

232. *Id.* at 340–42.

233. Robert Sterup, *Sorting Out the “Alaska Bananas” from the French Perfume and Dutch Tulips*, 23 MONT. L. REV. 9, 9 (1997).

234. *World Carpets, Inc. v. Dick Littrell’s New World Carpets*, 438 F.2d 482, 485 (5th Cir. 1971); see also *N. Am. Aircoach Sys., Inc. v. N. Am. Aviation, Inc.*, 231 F.2d 205, 210 (9th Cir. 1955) (“Geographic names which have connotations of the place of use or manufacture are generally subject to use by all persons or concerns who manufacture or operate in the area” and, therefore, “it is extremely difficult to give to a geographic term a proprietary connotation since under ordinary circumstances it cannot be used to exclude others who operate in the same area.”).

terms: that “other producers of similar [goods] in the same place” need to be able to use the geographical term.²³⁵

This sort of concern about “mischievous monopolization”²³⁶ of geographic names does *not* apply so obviously to landmark names. While many businesses may want to simultaneously use “Santa Monica,” “St. Louis,” “Brooklyn,” or “Nebraska” to designate goods coming from or services being rendered in those locations, there are not likely to be multiple commercial interests simultaneously using the landmark name to designate goods or services coming from or being rendered at the landmark. If there are multiple users of the same building, they are almost certainly going to be in a web of contractual relations that can sort out use of the building’s name—a very different situation from the 1.9 million people who live in Nebraska²³⁷ or the more than 300,000 residents of St. Louis.²³⁸

Of course, the reply to this point is that the landmark name disputes also arise because of multiple users; the difference is that these are multiple users across *time* instead of across *space*. Each of the disputes in Part II arose because a new concessionaire or tenant intends to occupy the landmark and, for a future period of time, use the landmark name.

235. *World Carpets, Inc.*, 438 F.2d at 485–86 (citing *Delaware & Hudson Canal Co. v. Clark*, 80 U.S. 311, 324 (1871)) (“And it is obvious that the same reasons which forbid the exclusive of generic names or of those merely descriptive of the article manufactured and which can be employed with truth by other manufacturers, apply with equal force to the appropriation of geographical names, designating districts of country. Their nature is such that they cannot point to the origin (personal origin) or ownership of the articles of trade to which they may be applied. They point only at the place of production, not to the producer, and could they be appropriated exclusively, the appropriation would result in mischievous monopolies Nothing is more common than that a manufacturer sends his products to market, designating them by the name of the place where they were made. But we think no case can be found in which other producers of similar products in the same place, have been restrained from the use of the same name in describing their goods.”); see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 14, cmt. d (AM. LAW INST. 1995) (“While not all locales are of special importance to consumers, merchants should remain free to indicate their place of business or the origin of their goods without unnecessary risk of infringement.”).

236. *World Carpets, Inc.*, 438 F.2d. at 485–86 (“The danger of mischievous monopolies is doubly acute since the place of a product’s origin often has come to suggest particular qualities or attributes. One can easily see either the danger of permitting an Idaho potato grower to appropriate that State’s name to his exclusive use, or the unfairness of allowing a French couturier to register the word French and preclude others from referring to this elegant origin of their clothing line.”).

237. *Nebraska 2010 Census Results*, U.S. CENSUS BUREAU, <https://www.census.gov/geo/maps-data/maps/thematic.html> (last visited Dec. 16, 2017) (population of Nebraska in 2010 was 1,826,341)

238. *City of St. Louis Census Results 2010*, CITY ST. LOUIS, MO., <http://dynamic.stlouis-mo.gov/census/city.cfm> (last visited Dec. 16, 2017) (population of St. Louis in 2010 was 319,294).

B. Landmark Names Are ‘Highly Descriptive’ of the Goods or Services Offered at the Landmark

Outside the lens of geographic descriptiveness, we can still view these cases as having insufficiently robust descriptiveness analysis. A court’s conclusion that a term is descriptive of the goods or services does not tell us how much evidence of secondary meaning should be required to establish a bona fide trademark.²³⁹ As McCarthy writes, “[s]ome terms are only slightly descriptive and need only a minimum quantum of evidence of secondary meaning. Other terms are highly descriptive and may need a relatively greater quantity and quality of secondary meaning evidence to become a trademark.”²⁴⁰ The term “chipotle” for a Mexican food restaurant that uses chipotle peppers as an ingredient might be slightly descriptive of the restaurant; the term “comida Mexicana” is much more highly descriptive of a Mexican food restaurant.

The current concept of “highly descriptive terms”²⁴¹ has been embraced by the *Restatement (Third) of Unfair Competition*²⁴² and the USPTO’s TTAB.²⁴³ Many courts of appeals have used different formulations to identify more descriptive terms that require greater evidence of secondary meaning,²⁴⁴ and there appears to be no reported decisions that disagree with the proposition that “[t]he more descriptive the term, the greater the evidentiary burden on

239. See MCCARTHY, *supra* note 1, § 15:28 (stating that there are no defined rules to create a secondary meaning).

240. *Id.* § 11:25.

241. This phrase was also used in some older cases in a way that would be synonymous or overlapping with “generic” terms, particularly before the category of “generic” was understood to be a complete bar to trademark protection. See, e.g., *Am. Heritage Life Ins. Co. v. Heritage Life Ins. Co.*, 494 F.2d 3, 11 (5th Cir. 1974) (“Under those standards, generic or highly descriptive words are normally not proper subjects for registration or protection as marks because they rarely attain the quality of distinctiveness required by the Act or the common law and because, as a matter of public policy, others should be equally entitled to use such non-distinctive words.”).

242. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 cmt. e (AM. LAW INST. 1995) (“Highly descriptive terms, for example, are less likely to be perceived as trademarks and more likely to be useful to competing sellers than are less descriptive terms. More substantial evidence of secondary meaning thus will ordinarily be required to establish their distinctiveness.”).

243. *In re Steelbuilding.com*, 2003 WL 23350100, at *11 (T.T.A.B. Mar. 24, 2003) (“[I]f the terms ‘steel building’ [sic] and ‘.com’ are not generic, they are at least highly descriptive.”), *aff’d*, 415 F.3d 1293 (Fed. Cir. 2005).

244. *In re Steelbuilding.com*, 415 F.3d 1293, 1300 (Fed. Cir. 2005) (“[T]he applicant’s burden of showing acquired distinctiveness increases with the level of descriptiveness; a more descriptive term requires more evidence of secondary meaning.”); *Commerce Nat. Ins. Servs., Inc. v. Commerce Ins. Agency*, 214 F.3d 432, 440–41 (3d Cir. 2000) (for “commonplace, descriptive terms” “the evidentiary bar must be placed somewhat higher”); *In re Bongrain Int’l (Am.) Corp.*, 894 F.2d 1316, 1317 (Fed. Cir. 1990) (“[T]he greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning.”).

plaintiff to prove secondary meaning.”²⁴⁵ In the words of a Fifth Circuit opinion from 1974, “the evidentiary burden necessary to establish secondary meaning is substantial where the proposed mark’s original or primary meaning suggests the basic nature of the service to be rendered.”²⁴⁶

At the end of the analysis, the reader must decide whether “Casa de Bandini” is “highly descriptive” of goods and services offered in the *Casa de Bandini* and whether “Tavern on the Green” goes to the “basic nature” of the food and drink served at *Tavern on the Green*. It is true that a landmark name is not typically “a commonplace, descriptive term used by a variety of businesses in a variety of contexts”²⁴⁷—and so heightened evidence of secondary meaning cannot be required on that basis. But if “Filipino Yellow Pages” is the “feeblest of descriptive marks” when applied to commercial telephone listings focused on the Filipino community²⁴⁸ and “heritage” when applied to insurance is “a word whose primary meaning was so intimately associated with and descriptive of the services intended to be distinguished in commerce’ that ‘strong evidence of secondary meaning’ would be required,”²⁴⁹ then this same heightened scrutiny is warranted when a landmark name is claimed as a trademark for goods and services being sold at the landmark. If “steelbuilding.com” is “highly descriptive”²⁵⁰ for “a website that provides computerized online retail services in the field of pre-engineered metal buildings including steel buildings[,]”²⁵¹ then is it hard to see how these landmark names would not be highly descriptive of the goods and services being sold at the landmarks.

This is not just a standard for courts. USPTO examiners can apply this heightened analysis when an applicant like Bazaar del Mundo claims secondary meaning under the five years of exclusive use standard. Section 1052(f) is written in discretionary terms that the USPTO “*may* accept as prima facie evidence that the mark has become distinctive . . . proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is

245. MCCARTHY, *supra* note 1, § 11:25.

246. *Am. Heritage Life Ins. Co.*, 494 F.2d at 3, 12.

247. *Commerce Nat. Ins. Services, Inc.*, 214 F.3d at 440–41 (concluding that the “the evidentiary bar must be placed somewhat higher” for a commonplace, descriptive term like “Commerce”).

248. *Filipino Yellow Pages, Inc. v. Asian Journal Publ’ns, Inc.*, 198 F.3d 1143, 1151 (9th Cir. 1999) (finding that Filipino Yellow Pages belonged to group of descriptive terms are “weak descriptive marks” or “the feeblest of descriptive marks” that are capable of being “valid trademark[s] only with a strong showing of strong secondary meaning”).

249. *Am. Heritage Life Ins. Co.*, 494 F.2d at 12.

250. *In re Steelbuilding.com*, 415 F.3d 1293, 1301 (Fed. Cir. 2005).

251. *Id.* at 1296.

made.”²⁵² The USPTO’s Trademark Manual of Examining Procedure (“TMEP”) describes this only as a “statutory *suggestion* of five years of use as proof of distinctiveness.”²⁵³ USPTO regulations provide that the five-year prima facie evidence standard applies “in appropriate cases” and that “further evidence may be required.”²⁵⁴

C. Non-Portable Secondary Meaning for Landmark Names?

In *Bazaar del Mundo*, the California Department of Parks and Recreation also argued that even if Bazaar del Mundo held the two trademarks, use of the trademarks outside Old Town San Diego should be enjoined because of the likely confusion as to “affiliation, sponsorship or connection with Old Town.”²⁵⁵ Bazaar del Mundo considered this argument “absurd[,]” and the idea that the marks could only be used “in one geographic area (Old Town) is antithetical to the exclusive rights conferred by 15 U.S.C. section 1115.”²⁵⁶

But is it really an absurd idea that some trademarks for some categories of goods or services should only be used in conjunction with the landmark that consumers know? The point might be exemplified by a 1918 dispute in Seattle, *New York Life Insurance Co. v. Orpheum Theater & Realty Co.*²⁵⁷ A company called Sullivan & Considine (“Sullivan”) operated the “Orpheum Theater” in one downtown Seattle building from 1903 until that building was razed in 1908; it then moved the “Orpheum” to another downtown theater from 1908 until 1911; it then moved the “Orpheum” again to “a modern theater building erected by them at Third Avenue and Madison Street.”²⁵⁸ That 1911 building was built as the Orpheum Theater.²⁵⁹

Unfortunately, beginning in 1908 Sullivan also entered into complex contractual arrangements to book vaudeville performances with the larger Orpheum Circuit Company from San Francisco.²⁶⁰ When Sullivan ended its relationship with the San Francisco outfit and leased their 1911 building to another stock company, a dispute ensued as to who could use the name “Orpheum” in Seattle.²⁶¹

252. 15 U.S.C. 1052(f) (2012).

253. TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1212.05(d) (8th ed. 2011) (emphasis added).

254. 37 C.F.R. § 2.41 (2015).

255. Dep’t of Parks & Recreation v. Bazaar del Mundo Inc., 448 F.3d 1118, 1133 (9th Cir. 2006).

256. Brief for Appellee at 30, Dep’t of Parks and Recreation v. Bazaar del Mundo Inc., 448 F.3d 1118 (9th Cir. 2006) (No. 05-55828).

257. 171 P. 534 (Wash. 1918).

258. *Id.* at 535.

259. *Id.*

260. *Id.*

261. *Id.*

The court found that Sullivan was the prior user of the name and retained the rights,²⁶² but there is a simpler, more reductionist account of the case: the exclusive rights to the name “Orpheum” in Seattle stayed with the party who owned the 1911 building where “[t]he name ‘Orpheum’ was . . . engraved on the onyx tablet permanently built in over the name entrance to the theater and otherwise prominently displayed on the building.”²⁶³ By 1918, that building had indicia of being a local landmark—professional photos, postcards, and mention in newspapers.²⁶⁴

Instead of being an “absurd” idea, U.S. trademark law does have trademarks associated with “one geographic area”: they are certification marks when used to certify “regional . . . origin.”²⁶⁵ American certification mark law is used to fulfill our international obligations to provide legal protection to “geographical indications,” designators that “identify a good as originating in the territory of a Member, or a region or locality in that territory”;²⁶⁶ certification marks like DARJEELING TEA, GROWN IN IDAHO for potatoes, and REAL CALIFORNIA for cheese can only be used in conjunction with goods from the place named in the mark.²⁶⁷ The Lanham Act recognizes certification (and collective) marks as tools to pursue social policy goals beyond pure brand-building;²⁶⁸ this is consistent

262. *Id.* at 536.

263. *Id.* at 535.

264. For photos and postcards of the period of the Orpheum Theater, see *Orpheum Theater*, PUGET SOUND PIPELINE, PUGET SOUND THEATRE ORGAN SOC’Y, <http://www.pstos.org/instruments/wa/seattle/orpheum1.htm>. (last visited Dec. 16, 2017). I submit that the existence of postcards of a building is a fairly good indication that it is/was a “landmark.” But the landmark was not long-lived. Eventually, the Orpheum Circuit Company gained control of the name and built a lavish “new Orpheum” which, in turn, became an important Seattle landmark until it was razed in 1967 for what is now a Westin Hotel. See Eric L. Flom, *Orpheum Theater (Seattle)*, HIST. LINK, <http://www.historylink.org/File/4267> (last visited Dec. 16, 2017); *Orpheum Theater*, *supra*.

265. 15 U.S.C. § 1127 (2012) (certification marks used to “certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of . . . [the] goods or services”).

266. Agreement on Trade-Related Aspects of Intellectual Property Rights art. 22, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (“Geographical indications are for purposes of this Agreement, indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation, or other characteristic of the good is essentially attributable to its geographical origin.”).

267. For a full explanation of American certification mark law and its relationship to international protection of geographical indications, see generally Justin Hughes, *Champagne, Feta, and Bourbon: The Spirited Debate about Geographical Indications*, 58 HASTINGS L.J. 299 (2006).

268. For example, 15 U.S.C. § 1127 expressly provides that a certification mark may be used to “that the work or labor on the goods or services was performed by members of a union or other organization” and that “collective

with the idea that legal protection of geographical indications can help safeguard smaller, local economic interests.²⁶⁹ To the degree one believes that landmark names can function as trademarks, they arguably should function along these lines to certify the geographic origin of the goods and services as well as the cultural link between the goods/services and the landmark. As Judge Cedarbaum said in the Tavern on the Green dispute, the name “‘Tavern on the Green’ was closely associated in the public mind with a building . . . located in New York’s Central Park.”²⁷⁰

This does suggest one future course for landmark owners. A basic characteristic of certification marks is that a certification mark must be held by a certifying entity that itself does not use the mark in commerce.²⁷¹ Recall that one of the reasons the State of California lost in the *Bazaar del Mundo* litigation is that the court found the state had not itself used the building names in commerce. Although there is no case law on this point, a landmark owner might successfully register the landmark name as a certification mark to “certify” whoever is entitled to sell goods and services from a landmark building, without the risk of someone later claiming that the landmark owner was not “using” the mark.²⁷²

marks” include “includes marks indicating membership in a union, an association, or other organization.”

269. See, e.g., Justin Hughes, *The Limited Promise of Geographical Indications for Developing Country Farmers*, in *GEOGRAPHICAL INDICATIONS IN THE ASIA-PACIFIC REGION* (Irene Calboli & Ng Wee Loon eds., 2017) (recognizing that geographical indications can promote local development and traditions); Madhavi Sunder, *The Invention of Traditional Knowledge*, *LAW & CONTEMP. PROBS.*, Spring 2007, at 97 (“One hope is that Geographical Indication (GI) protection will allow local artisans to stay in their communities and fend for themselves.”).

270. Press Release, *supra* note 46. This dovetails with the idea that the true “good will” is a matter of cultural heritage related to the landmark’s significance in the local, regional, or national society. See, e.g., Keri Christ, *Edifice Complex: Protecting Landmark Buildings as Intellectual Property—A Critique of Available Protections and A Proposal*, 92 *TRADEMARK REP.* 1014, 1044 (2002) (noting, in a discussion of landmarks as structures and shapes, that “[p]rotection of the private interests in landmarks may be seen as encroaching upon the significant public interest in the use of landmarks as cultural property”); Daniels, *supra* note 223, at 1736–37 (“A geographic location’s personality and character are not products of a corporate marketing department, but rather a creation of the people who claim some sort of ownership in that place.”).

271. 15 U.S.C. § 1064(5)(B) (2012) (providing for cancellation of a certification mark’s registration when the registrant “engages in the production or marketing of any goods or services to which the certification mark is applied”).

272. Indeed, perhaps a landmark building owner could make the same argument even if they have not registered the trademark. See *Institut National des Appellations d’Origine v. Brown-Forman Corp.*, 47 U.S.P.Q.2d (BNA) 1875, 1883 (T.T.A.B. 1998) (COGNAC valid unregistered certification mark for purposes of opposing trademark registration using “Cognac”).

CONCLUSION

Over the years, there has been a series of trademark disputes between the owners of landmark buildings and private parties that once provided goods and/or services at those landmarks; these disputes typically arise after the private party no longer has a contract to operate at the landmark. Where ownership of the relevant intellectual property was not specified in the contract between the parties, these disagreements are classically understood as landlord-tenant disputes about *who* has the commercial goodwill in the landmark's name.

Jumping to that question overlooks a more fundamental issue: is there really any "secondary meaning" separate from the landmark's name that is the proper subject of trademark protection? When a commercial operation has been located in and used the name *of* a famous landmark, why would we think that the relevant consumers would form any commercial impression at all of the (otherwise nameless) tenant serving food, mixing cocktails, or making beds? True, trademark law allows for the establishment of secondary meaning and goodwill when the provider of the goods or services remains anonymous to the consumer.²⁷³ But here the consumer has a powerful descriptive sense of the word/name because the consumer knows they are physically at the landmark when they are consuming the goods or services. When a person uses a Macbook and notices "Yosemite" or "El Capitan" appearing on the operating system start-up screen,²⁷⁴ we assume that person knows those terms are being used in arbitrary ways that denote a trademark function.²⁷⁵ When that same person arrives in Yosemite National Park staring at El Capitan, both "Yosemite" and "El Capitan" have powerfully descriptive meanings.

Landmark names should be treated under trademark law as geographically descriptive terms in relation to any good, service, or activity rendered at the landmark. Short of treating these words as

273. *Rockland Exposition, Inc. v. All. of Auto. Serv. Providers of N.J.*, 894 F. Supp. 2d 288, 315 (S.D.N.Y. 2012), *as amended* (Sept. 19, 2012).

274. See APPLE, OS X YOSEMITE (2014), https://www.apple.com/ca/osx/pdf/OSXYosemite_TO_FF1.pdf; *OS X El Capitan: OS X Overview*, APPLE, https://support.apple.com/kb/PH21871?locale=en_US&viewlocale=en_US (last visited Dec. 16, 2017).

275. See, e.g., COMM. ON PATTERN CIVIL JURY INSTRUCTIONS OF THE SEVENTH CIRCUIT, FEDERAL CIVIL JURY INSTRUCTIONS OF THE SEVENTH CIRCUIT § 13.1.2.2.1 (2010) ("An inherently distinctive trademark is one that almost automatically tells a consumer that it refers to a brand or a source for a product. A trademark is inherently distinctive if it is a[n] . . . 'arbitrary' . . . [symbol/term]" and "[a]n 'arbitrary' [symbol; term] is a common [symbol; term] used in an unfamiliar way. For example, 'Apple' for computers is an arbitrary mark."); Robert A. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86 B.U. L. REV. 547, 558 (2006) ("The idea is that fanciful, arbitrary, and suggestive marks are inherently capable of serving as source identifiers because they have no other obvious meaning for consumers.").

geographical terms, the USPTO and courts should regard the terms as “highly descriptive” in these contexts and require a heightened standard of proof for the development of secondary meaning. A more rigorous application of trademark descriptiveness tests will ensure that landmarks, often publicly owned, can retain their names and avoid messy, unnecessary disputes with commercial tenants.