When a Landmark Cannot Serve as a Trademark: Trademark Protection for Building Designs in Light of *Rock and Roll Hall of Fame and Museum, Inc. v. Gentile Productions*

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For many years the law has recognized the availability of buildings to serve as trademarks. A federally registered trademark exists for the art deco spire of the Chrysler Building and the neoclassical facade of the New York Stock Exchange.[1] In fact, approximately one hundred buildings have federally registered trademarks.[2] However, the Sixth Circuit's decision in *Rock and Roll Hall of Fame and Museum, Inc. v. Gentile Productions* narrowed the scope of protection that such trademarks enjoy.[3] In a 1998 split decision, the court reversed a preliminary injunction in a trademark infringement suit between the Rock and Roll Hall of Fame and Museum and Charles Gentile, a professional photographer.

Traditional trademark law suits involving building designs deal with potential infringers creating similar building designs. The *Rock and Roll Hall of Fame* case differs because it involves protection of a building design depicted on Museum merchandise and a competing poster embodying a photograph of the design.

Part II of this Note examines a brief history of trademark law in the United States and the fundamentals of trademark protection. Part

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1. David W. Dunlap, *Who Owns N.Y. Skyline? Check the Fine Print*, INTERNATIONAL HERALD TRIB. (Neuilly-sur-Seine, France), Sept. 1, 1998, at 20. The art deco spire of the Chrysler Building may be found as federal trademark number 1126888, and the façade of the New York Stock Exchange may similarly be found as number 1761655. *Id.*

2. Tara J. Goldsmith, Comment, *What's Wrong with this Picture? When the Lanham Act Clashes with Artistic Expression*, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 821, 831 n.49 (1997).

3. Rock and Roll Hall of Fame and Museum v. Gentile Productions, 134 F.3d 749 (6th Cir. 1998).

III discusses how trademark law applies to buildings and building designs. This part also briefly comments on the protection of building designs under copyright law and its limitations. Part IV examines the facts of *Rock and Roll Hall of Fame* and the court's analysis. Part V critiques the conflicting positions of the majority and the dissent. Finally, part VI concludes that the majority's confused discussion came to the right conclusion; however, it did so through unpersuasive analysis.

II. TRADEMARK GENERALLY

Generally, a symbol acts as a trademark when the merchant of one particular good uses the mark to distinguish his goods from those of other merchants.[4] The exclusive right in a trademark is founded upon "priority of appropriation."[5] This foundation establishes that trademark protection belongs to the first user to appropriate the mark in commerce, not to the first user to adopt the mark.[6] One of the functions of a trademark is to allow the user to distinguish his products from those of subsequent would-be users.[7] As such,

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4. Broadly speaking, a trademark means "a distinctive mark of authenticity, through which the products of particular manufacturers or the vendible commodities of particular merchants may be distinguished from those of others." BLACK'S LAW DICTIONARY 1493 (6th ed. 1990). Similar species of marks used in commerce to distinguish one merchant from another include "service marks," "collective marks," and "certification marks." JEROME GILSON, TRADEMARK PROTECTION AND PRACTICE § 1.02(1)(b) (1999). The most widely used mark of these other species, the service mark, differs from the trademark in that trademarks apply to marks used on "goods," while service marks apply to marks used in connection with "services." *Id.*

5. The Trademark Cases, 100 U.S. 82, 94 (1879).

6. *See id.*

7. A trademark functions and is accorded legal protection because it:

(a) designates the source or origin of a particular product or service, even though the source is to the customer anonymous;

(b) denotes a particular standard of quality which is embodied in the product or service;

(c) identifies a product or service and distinguishes it from the products or services of others;

(d) symbolizes the good will of its owner and motivates consumers to purchase the trademarked product or service;

(e) represents a substantial advertising investment and is treated as a species of property; or

trademark law operates as one aspect of the broader common law of unfair competition.[8] The law of unfair competition derives from public policy notions that a competitor should not benefit in commerce from another's goodwill.[9] Additionally, the law recognizes that the public should be protected from such deceitful business practices.[10]

Trademark law in the United States consisted of common law and state statutes until Congress passed the first federal trademark statute in 1870.[11] The Supreme Court found the Act, which claimed protection for trademarks under the Patent and Copyright Clause of the Constitution,[12] unconstitutional.[13] The Court held the protection afforded trademarks under the Act to be too broad for the authority granted under the Patent and Copyright Clause.[14] In 1881 Congress reenacted federal trademark legislation,[15] basing the statute on the Commerce Clause of the Constitution.[16] Since adoption of the 1881 legislation, federal trademark legislation evolved through significant changes,[17] culminating with the Lanham Act.[18]

(f) protects the public from confusion and deception, insures that consumers are able to purchase the products and services they want, and enables the courts to fashion a standard of acceptable business conduct.

GILSON, *supra* note 4, § 1.03(1).

8. *See id.* § 1.04(2). Loosely, unfair competition applies to all dishonest or fraudulent rivalry in commerce, particularly to the practice of seeking to substitute one's own products in the markets for those of another. BLACKS LAW DICTIONARY, *supra* note 4, at 1062.

9. Goodwill pertains to "[t]he favorable consideration shown by the purchasing public to goods or services known to emanate from a particular source." BLACKS LAW DICTIONARY, *supra* note 4, at 694.

10. *See* GILSON, *supra* note 4, § 1.04(2).

11. Act of July 8, 1870, ch. 230, 16 Stat. 198 (1890).

12. "The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8, cl. 8.

13. *See* The Trademark Cases, 100 U.S. 82.

14. The exclusive right in trademark "is simply founded on priority of appropriation. We look in vain in the statute for any other qualification or condition." 100 U.S. at 94. Also, trademark's exclusive right, the Court found, does not depend on "novelty, discovery, or any work of the brain." 100 U.S. at 94.

15. Act of Mar. 3, 1881, ch. 138, 21 Stat. 502 (1881).

16. "The Congress shall have Power . . . To regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes." U.S. CONST. art. I, § 8, cl. 3.

17. *See* Act of Feb. 20, 1905, ch. 592, 33 Stat. 724 (1905); Act of Mar. 19, 1920, ch. 104, 41 Stat. 533 (1920).

Creating and protecting a valid trademark under federal law requires the satisfaction of a series of requirements. Initially, the first user of the mark must establish his exclusive right to the mark. This requires careful selection of a mark that is nonfunctional[19] and distinctive enough to serve as a trademark. The first user of the mark must then appropriate the mark in commerce.[20] Once the first user establishes his exclusive right to the mark, to protect the mark from subsequent users, the first user must show that his use and another's subsequent use are likely to confuse the consumer regarding the origin of the products associated with the mark.[21]

Under federal law, before one can protect a mark as a trademark, the user must establish his exclusive right in the mark. First, to establish a trademark right, a mark must be distinctive and distinguish the user's goods from other's goods.[22] Generally, courts group marks into one of four classifications of increasing distinctiveness: generic, descriptive, suggestive, and arbitrary or fanciful.[23] Marks that are merely generic, referring only to "the genus of which the particular product is a species," cannot become valid trademarks.[24] Even descriptive marks can only become valid trademarks upon acquiring a secondary meaning.[25] However, courts deem suggestive, arbitrary, or fanciful marks as inherently distinctive; thus, they are protectable upon first use or intended use.[26] This categorization exists because the mark's inherent nature serves to identify the particular source of a product.[27] By definition these

18. 15 U.S.C. §§ 1051-1127 (1998).

19. *See infra* note 30.

20. *See supra* note 14.

21. *See* 15 U.S.C. §§ 1114, 1125.

22. It is important to note that goods can be distinctive and not serve a product distinguishing purpose. A court will not afford trademark protection to a design or pattern that the public sees merely as ornamentation instead of a distinguishing mark. *See* GILSON, *supra* note 4, § 2.01.

23. *See* Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9 (2d Cir. 1976).

24. *Id*. at 9.

25. *See id.* at 10. Secondary meaning refers to a mark's use in commerce by the user such that it has, by use, become distinctive of the user's goods. 15 U.S.C. § 1052(f) (1998).

26. *See* Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 768 (1992). The protectability upon first use of such marks derives from their validity as trademarks and the acquisition of the right through appropriation. *See id*.; *see also supra* note 14.

27. 505 U.S. at 768.

marks are entitled to protection as a valid trademark.[28] Thus, a mark will meet the initial requirements for protection as a trademark if it is either inherently distinctive or has acquired a secondary meaning.[29]

A second requirement, or limitation, on the protectability of a mark as a trademark is functionality.[30] To be eligible for protection as a trademark, a mark must be nonfunctional.[31] The doctrine of functionality developed from common law.[32] While the doctrine applies to all marks protected under unfair competition, it applies more readily to situations relating to trade dress[33] than to traditional trademark.[34] Although dealing with the issue of state law preemption, the landmark cases *Sears, Roebuck & Co. v. Stiffel Co.*[35] and *Compco Corp. v. Day-Brite Lighting, Inc.*[36] illustrate one principal policy behind the functionality requirement in both federal and state

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28. *See id.*

29. *See id.* at 769.

30. A mark can be deemed functional if its superiority over all other alternatives would hinder competition if the first user had exclusive rights over its use. *See* BLACKS LAW DICTIONARY, supra note 4, at 673. Courts have also interpreted the doctrine of functionality to apply to some marks on products that serve a primarily aesthetic purpose. This aesthetic functionality includes elements of a product that primarily add to the aesthetic appeal of the product and its value, instead of designating the source of the product. GILSON, *supra* note 4, § 7.02(7) n.143 (discussing the Court of Customs and Patent Appeals approach to deciding functionality).

31. *See* GILSON, *supra* note 4, § 7.02(7)(f) n.143.

32. *See id.* § 7.02(f).

33. Trade dress relates to the total appearance and image a product or product configuration—including such features as size, texture, shape, and color. BLACKS LAW DICTIONARY, *supra* note 4, at 1493.

34. This is because trademarks traditionally deal with words and symbols. *See* 15 U.S.C. § 1127 (definition of trademark). *See also* GILSON, *supra* note 4, § 7.02(7)(f).

35. 376 U.S. 225 (1964). The plaintiffs in *Sears* had acquired design and mechanical patents in a "pole lamp" design. *Id.* When the defendant began to sell a nearly identical lamp design, the plaintiffs brought action for infringement of their patent. *Id*. at 226. The plaintiffs also sought relief for unfair competition under state common law, citing consumer confusion as to the source of the competing lamps. *Id.* The district court found the design patent invalid for lack of invention but found the defendant guilty of unfair competition. *Id*. The Court of Appeals affirmed. *Id.* at 227. The Supreme Court reversed, holding the state unfair competition law preempted by the Supremacy Clause with respect to unpatented articles. *Id.* at 231.

36. 376 U.S. 234 (1964). The plaintiff in *Compco* had acquired a design patent on a fluorescent lighting fixture. *Id.* As in *Sears*, the defendant began to sell a similar design as that of the plaintiff's lighting fixture. The plaintiff brought action against the defendant based on theories of patent infringement and unfair competition. *Id.* at 235. Also as in *Sears*, the district court held the plaintiff's design patent invalid but found the defendant guilty of unfair competition, which the Court of Appeals affirmed. *Id.* at 235-36. The Supreme Court reversed, citing *Sears* as authority. *Id.* at 237.

trademark law. In *Sears* and *Compco* the Supreme Court held that federal patent law preempted state laws that protected unpatented product designs from being copied, because such laws are contrary to the policy behind the federal laws.[37] Under current federal unfair competition law, the functionality requirement exists in the Lanham Act.[38]

While the courts will not protect a purely functional mark as a trademark, they also will not deny protection to every mark that can serve a functional purpose. In *Qualitex Co. v. Jacobson Products Co., Inc.*,[39] the Supreme Court addressed the boundaries for qualification as a valid trademark. Noting that the Lanham Act defines a trademark to "include[] any word, name, symbol, or device, or any combination thereof," the Supreme Court reversed the court of appeals, stating that the plain language of the Lanham Act is not restrictive.[40] The Court held that the doctrine of functionality will not bar a mark from serving as a trademark in certain cases.[41] If the functional mark is not essential to the product's use and does not affect its cost or quality,

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37. The Supreme Court in *Sears* stated that allowing state unfair competition law to prevent the copying of an unpatentable article would allow states to remove from the public domain an article that federal law determined to be within it. 376 U.S. at 231-32. *See Compco*, 376 U.S. at 237 ("To forbid copying would interfere with the federal policy, found in [federal patent law], of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain."); GILSON, *supra* note 4, § 2.14(1).

38. 15 U.S.C. § 1125(a) (1998). The federal unfair competition statute, contained within the Lanham Act, produces an alternative cause of action, aside from trademark infringement. While § 32 of the Lanham Act provides a cause of action for trademark infringement of federally registered trademarks, § 43(a) provides broader protection for marks regardless of federal trademark registration. *Id.* §§ 1114, 1125. *See* GILSON, *supra* note 4, § 7.01(4).

39. 514 U.S. 159 (1995). In *Qualitex* the plaintiff used a shade of green-gold color on pads it sold for dry cleaning presses. *Id.* at 161. When the defendant then began to sell the same type of pads with the same green-gold color, the plaintiff filed an unfair competition claim. *Id.* Subsequent to filing the unfair competition claim, the plaintiff obtained a federal trademark registration on the color of its pads and added a trademark infringement claim to its suit against the defendant. *Id.* The plaintiff won the suit in the District Court, but the Ninth Circuit Court of Appeals reversed, stating that federal trademark law does not permit the registration of a trademark consisting of color alone. *Id.*

40. 514 U.S. at 162. "Since human beings might use as a 'symbol' or 'device' almost anything at all that is capable of carrying meaning, this language [of the Lanham Act], read literally, is not restrictive." *Id.*

41. *See* 514 U.S. at 165. The Court found that a product's color is unlike marks which are "fanciful," "arbitrary," or "suggestive," but if that color has acquired a secondary meaning which identifies a particular source, there would be no theoretical objection to the basic objectives of trademark law. *Id.* at 162-63.

then a trademark may exist.[42]

The Sixth Circuit addressed the issue of functionality in *WSM, Inc. v. Tennessee Sales Co.*[43] and *Ferrari S.P.A. Esercizio Fabriche Automobile Corse v. Roberts*.[44] *WSM* involved the sale of T-shirts bearing design transfers of similar marks. The defendant in the *WSM* case asserted the doctrine of functionality stating that its use of a T-shirt design was purely functional, and thus incapable of trademark protection.[45] Upholding the plaintiff's trademark, the court stated that just because a mark serves a function, that does not preclude it from serving to identify the source of the product, if other aspects of the mark are nonfunctional.[46]

Ferrari involved the issue of whether the plaintiff could protect the exterior shape and appearance of its automobiles.[47] The defendant asserted the aesthetic functionality doctrine precluded trademark protection of the plaintiff's automobile exterior shape.[48] The court upheld the trademark, stating that aesthetic functionality will not preclude a finding of nonfunctionality for trademark purposes where the design also suggests the origin of the product.[49]

If a mark meets the above requirements and the Lanham Act does

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42. *See id.* at 165. Further, the Court noted that it is a mark's source-distinguishing ability that allows it to serve the purposes of a trademark, not its ontological status. 514 U.S. at 164.

43. 709 F.2d 1084 (6th Cir. 1983). The plaintiff in the case, WSM, operated the Opryland U.S.A. amusement park and sold souvenir T-shirts bearing a design transfer mark describing their "amusement park services." *Id.* at 1085. Subsequently, the defendant began to sell T-shirts and separate design transfers, adopting a design with the plaintiff's mark. *Id.* at 1086.

44. 944 F.2d 1235 (6th Cir. 1991).

45. 709 F.2d at 1087. Specifically, the defendant characterized his use as "ornamental" or "decorative," invoking the doctrine of aesthetic functionality. *Id.*

46. *Id.*

47. 944 F.2d at 1237. Plaintiff designed and manufactured upscale sports cars, specifically the Daytona Spyder and Testarossa. *Id.* At the time of the case, the Spyder, which plaintiff manufactured from 1969-73, sold on the market for between one and two million dollars; while a new Testarossa would sell for approximately $230,000. *Id.* at 1237-38. The defendant manufactured fiberglass kits to attach to another vehicle that replicated the external shape of plaintiff's Spyder and Testarossa models and sold the kits for approximately $8,500. *Id.* at 1238.

48. 944 F.2d at 1239. See *supra* note 30 for a definition of the aesthetic functionality doctrine.

49. *Id.* at 1247. The court cited WSM as authority for rejecting the broad application of the aesthetic functionality doctrine. *Id.* The court stated that relating commercial desirability to the functionality of a feature without regard to its utilitarian function discourages the development of attractive designs because they would not be entitled to the same protection as less appealing features. *Id.* at 1246.

not directly bar protection,[50] then the first user of the mark can register it with the United States Patent and Trademark Office ("USPTO").[51] Registering the trademark allows the first user to prevent others from appropriating it, provided the first user meets one qualification: the first user must have used or intend to use the mark in interstate commerce.[52] Because trademark protection evolved from the common law doctrine of unfair competition,[53] the right to a mark comes from "use in commerce" not mere adoption.[54]

While use in commerce mainly applies to application of the mark to the owner's principal products, the first user may also use a trademark by adorning a collateral product with it.[55] Businesses often use collateral products for advertising purposes and distribute a large variety of promotional products bearing their trademarks.[56] This type of trademark placement serves a dual purpose by increasing public awareness of the trademark and product sales.[57] A New York district court recognized this type of advertising in *Coca-Cola Co. v.*

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50. Section 2 of the Lanham Act provides certain exclusions from the marks eligible from protection, for example, the United States flag. 15 U.S.C. § 1052 (1998).

51. 15 U.S.C. § 1051.

52. *See* 15 U.S.C. § 1051(a) for provision concerning actual use of mark. Under the Lanham Act one uses a mark in commerce when it is affixed to the goods, their displays, or documents associated with the goods if affixation is impractical and the goods are sold or moved in commerce. *Id.* § 1127(1). On services, one uses a mark in commerce when it is used or displayed in the advertising of the services, and the services are executed in commerce. *Id.*

See 15 U.S.C. § 1051(b) for provision concerning intended use.

See supra notes 7-8 and accompanying text. The Lanham Act sections refer only to use in commerce; however, § 45 defines "commerce" as "all commerce which may lawfully be regulated by Congress." *Id.* § 1127. Congress enacted the Lanham Act under the constitutional authority of the Commerce Clause.

53. *See* GILSON, *supra* note 4.

54. Section 45 of the Lanham Act defines "use in commerce" as "a bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark." 15 U.S.C. § 1127 (1994). *See* GILSON, *supra* note 4, § 3.02(4).

55. *See* GILSON, *supra* note 4, § 5.05(9). The COCA-COLA trademark has been officially licensed to enhance all types of clothing, as well as jewelry, playing cards, glasses, and other types of commonly used articles. *Id.*

56. *See id.* This type of trademark placement possibly evolved from the Pop Art movement of the 1960s. *Id.* Led by Andy Warhol with his paintings of famous trademarks such as COCA-COLA bottles and BRILLO soap pads, collateral products that were cheaper than the artist's originals began to appear. *Id.* The products that emerged, with adorning trademarks, became popular, and while being utilitarian, they stimulated the sales of the trademark owner's staple products. *Id.*

57. *See* GILSON, *supra* note 4, § 5.05(9).

Gemini.[58] In *Gemini* the court noted that the alleged infringing trademark use, a simulated bill poster, represented one common form of advertising utilized by Coca-Cola.[59] The court held that the likelihood of confusion as to sponsorship of the poster could be attributed to the plaintiff's novelty advertising.[60]

Once first users establish an exclusive right in a trademark, they can protect their mark from infringement by subsequent users, who may confuse the public as to the source of the goods or services provided.[61] The Lanham Act specifically provides two main avenues of protection for first users of marks in commerce. For federally registered trademarks a person is liable for trademark infringement if he uses a similar mark in commerce that is likely to cause confusion among consumers without the consent of the registrant.[62] Secondly, the federal unfair competition statute provides a civil cause of action against anyone who perpetuates a false designation of the origin of a product or any false or misleading descriptions likely to cause confusion in the marketplace.[63]

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58. 346 F. Supp. 1183 (E.D.N.Y. 1972). The case centered on a poster distributed by the defendant that parodied Coca-Cola's trademark "Enjoy Coca-Cola" by replacing the "Cola" with "ine" so the poster read "Enjoy Cocaine." *Id.* at 1186.

59. 346 F. Supp. at 1188.

60. The court stated:

> Not only does visual comparison of defendant's poster with specimen advertising of plaintiff indicate the likelihood of such a mistaken attribution but recent so-called "pop art" novelty advertising utilized by plaintiff may have served to further the impression that defendant's poster was just another effort of that kind by plaintiff to publicize its product.

Id. at 1189-90.

61. *See supra* note 22.

62. Specifically, liability exists when the subsequent user "use[s] in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. *Id.* § 1114(1)(1).

63. The statute provides:

> Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which:
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> (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities

Two strikingly similar marks are more likely, but not certain, to cause confusion.[64] To infringe the mark of the first user, the subsequent mark must be "confusingly similar."[65] Thus, courts do not state the test for the likelihood of confusion merely in terms of the marks themselves.[66] The analysis must include the possibility that the marks on the respective products, in their channels of trade, would likely cause confusion as to the source or sponsorship of the goods.[67] Due to the imprecise, often subjective nature of the test, courts do not state the test for the likelihood of confusion in a simple formula. For this reason, courts employ a broad range of factors and conclude that it is only able to resolve the likelihood of confusion on a fact specific basis.[68] In *Champions Golf Club, Inc. v. The Champions Golf Club,*

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by another person. . . .

Id. § 1125(a).

64. It is entirely possible for a mark almost identical, or even identical, to that of a principle user not to infringe the trademark of the principle user. *See* GILSON, *supra* note 4, § 5.01(3)(c). Two identical marks can coexist without any confusion or likelihood of confusion if they are on sufficiently different products or are on products in sufficiently different channels of trade. *See id.* The use of an identical mark in commerce, however, can give rise to a cause of action for "dilution" regardless of a likelihood of confusion. *See* 15 U.S.C. § 1125(c) (Supp. IV 1998). Dilution entitles the owner of a famous mark to injunctive relief when another's mark weakens its distinctiveness. GILSON, *supra* note 4, § 5.01.

65. *See* GILSON, *supra* note 4, *id.* § 5.01(3)(c).

66. *See id.*

67. *See id.*

68. *See* GILSON, *supra* note 4, § 5.01(3)(c)(i). The Court of Customs and Patent Appeals in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973), articulated one of the most extensive lists of factors examined in deciding the likelihood of confusion under § 2(d) of the Lanham Act. The court in *E.I. du Pont* listed the factors as follows:

(1) The Similarity Or Dissimilarity Of The Marks In Their Entireties As To Appearance, Sound, Connotation And Commercial Impression.

(2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.

(3) The similarity or dissimilarity of established, likely-to-continue trade channels.

(4) The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.

(5) The fame of the prior mark (sales, advertising, length of use).

(6) The number and nature of similar marks in use on similar goods.

(7) The nature and extent of any actual confusion.

(8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.

Inc.,[69] the Sixth Circuit delineated an eight-factor inquiry into "likelihood of confusion."[70] The Sixth Circuit qualified the factor inquiry, however, stating that the factors were only a guide in determining whether confusion would likely result from concurrent use of the two contested marks.[71]

III. TRADEMARK PROTECTION FOR BUILDING DESIGNS AND COMMENT ON COPYRIGHT IN BUILDING DESIGNS

The same legal principles underlying trade dress situations generally apply to architectural features such as building designs.[72]

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(9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).

(10) The market interface between applicant and the owner of a prior mark:

(a) a mere "consent" to register or use.

(b) agreement provisions designed to preclude confusion, *i.e.* limitations on continued use of the marks by each party.

(c) assignment of mark, application, registration and good will of the related business.

(d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.

(11) The extent to which applicant has a right to exclude others from use of its mark on its goods.

(12) The extent of potential confusion, i.e., whether de minimis or substantial.

(13) Any other established fact probative of the effect of use.

476 F.2d at 1361. Although the list of factors applied to discern the likelihood of confusion under § 2(d), nothing in the Lanham Act suggests that the analysis under § 2(d) differs from that under § 32(1). *See* GILSON, *supra* note 4, § 5.03(c)(ii). In addition, because the same factors in deciding the likelihood of confusion under § 32(1) apply to § 43(a), one can presume that the court uses the same factors that are used in § 2(d) cases also in § 43(a) cases. *See id.* § 7.02(7)(g).

69. 78 F.3d 1111 (6th Cir. 1996).

70. *See id.* at 1116. For the factors listed by the court in determining "likelihood of confusion," see *supra* note 68.

71. *See* 78 F.3d at 1116 (citing Wynn Oil Co. v. Thomas, 839 F.2d 1183, 1186 (6th Cir. 1988)). The court also specifically stated that the factors "imply no mathematical precision, and a plaintiff need not show that all, or even most, of the factors listed are present in any particular case to be successful." *Id.*

72. *See* GILSON, *supra* note 4, § 7.02(7)(h)(i). In most cases, the architectural features are service marks typically used by restaurants, hotels, dry cleaners, and other service oriented businesses. *Id.*

The theory of architectural features as service marks is based on potential attraction of passing motorist to the business because of the service mark.[73] A unique service mark may make a lasting impression on the consumer, making the business readily identifiable to them.[74]

The Sixth Circuit addressed building trademark issues as early as 1937, when the court decided *White Tower System, Inc. v. White Castle System of Eating Houses Corp.*[75] In *White Tower*, the plaintiff and defendant both operated hamburger stands using a white miniature castle in the same geographic area.[76] The court found both trademark rights and infringement existed. The court stated that it will enjoin a subsequent user with an inimical building design, seeking to gain from another's established goodwill.[77]

Like other forms of trademarks and service marks, architectural works are eligible for federal registration under the Lanham Act.[78] The USPTO takes the position that "the three-dimensional configuration of a building is able to be registered only if it is used in such a way that it is or could be perceived as a mark."[79] Typically, for registration with the USPTO, photographs of the building can serve as proper specimens to illustrate the required use as a mark.[80]

The most obvious difficulty of applying trademark and service mark protection to building designs occurs because of a building's

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73. *See id.*

74. *See id.*

75. 90 F.2d 67 (6th Cir. 1937).

76. *Id.* at 74. After the plaintiff's filing of its complaint claiming unfair competition, defendant cross-claimed for similar relief. *Id.* In addition to building styles, the plaintiff also claimed unfair competition based on defendant's business name and advertising slogan. *Id.* Plaintiff's business went by the name "White Tower" and used the slogan "Take Home a Bagful," while the defendant went by the name "White Castle" and used the slogan "Buy 'Em by the Sack." *Id.* At trial the evidence showed that the plaintiff deliberately used the defendant's building design as a model for its own business design and even gave plans for the defendant's buildings to its architect. *Id.*

77. *Id.* at 70. The court previously defined "good will" as "the favorable consideration shown by the purchasing public to goods known to emanate from a particular source." *Id.* at 69.

78. PATENT AND TRADEMARK OFFICE, U.S. DEP'T OF COMMERCE, TRADEMARK MANUAL OF EXAMINING PROCEDURE, § 1301.02(c) (Aug. 1997) [hereinafter TMEP]. *See also In re* Griffs of America, Inc., 157 U.S.P.Q. (BNA) 592 (T.T.A.B. 1968).

79. *Id.* § 1301.02(c).

80. *See id.* § 1301.02(c). The Patent and Trademark Office will accept evidence of a building configuration's use as a mark in the form of articles, such as menus, which show promotion of the building's configuration as a mark. *Id.*

primary function as a shelter.[81] Two different courts, in the *Fotomat Cases*,[82] analyzed the problem of functionality in relation to a drive-thru photo developing business' kiosk design.[83] In *Fotomat I* a New Jersey district court stated that trademark protection only existed for building design elements that are distinctive, nonfunctional, or arbitrary.[84] In *Fotomat II* a Kansas district court found that the plaintiff's overall building design, the same design as in *Fotomat I*, could serve as a valid trademark.[85] The court held that, while a building design might have some functional elements, it could still be protected if the design was not "in essence" functional.[86]

Trademark infringement of an architectural trademark, like other forms of infringement, requires the existence of a likelihood of confusion. Courts deciding architectural element trademark cases, as in other trademarks cases, determine the likelihood of confusion on a fact specific basis, employing a series of factors.[87]

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81. *See* GILSON, *supra* note 4, § 7.02(7)(h)(iii).

82. Fotomat Corp. v. Photo Drive-Thru, Inc. (*Fotomat I*), 425 F. Supp. 693 (D.N.J. 1977); Fotomat Corp. v. Cochran (*Fotomat II*), 437 F. Supp. 1231 (D. Kan. 1977). Both cases dealt with the building design of Fotomat's photographic service business, which it had previously registered as a trademark with the United States Patent and Trademark Office. *Id.*

83. The term kiosk applies to small structures with one or more open sides. WEBSTER NINTH NEW COLLEGIATE DICTIONARY 663 (1983).

84. 425 F. Supp. at 706. The court found that no public interest exists for preserving within the public domain unique or arbitrary aspects of building design. *Id.* However, while the court stated that nonfunctional aspects of building designs could serve as trademarks, the court held that the plaintiff's kiosk was primarily functional. *Id.* at 707. The court found that the nonfunctional, protectable elements of the plaintiff's kiosk were not confusingly similar to the defendant's structure and thus no infringement existed. *Id.*

85. 437 F. Supp. at 1245. The court noted that the *Fotomat I* case reached a contrary conclusion as to the functionality issue of plaintiff's kiosk. *Id.* at 1235. The court distinguished the case by noting that the New Jersey court received no specific evidence on the issue of functionality, whereas the plaintiff in this case provided evidence clearly indicating the building design was only incidentally functional. *Id.* at 1236.

86. *Id.* at 1235. The court stated:

> . . . some articles, made in a purely arbitrary configuration, (e.g., the wine bottle considered in Mogen David [Application of Mogen David Wine Corporation, 51 C.C.P.A. 1260, 328 F.2d 925 (1964)] may perform a function, holding wine, which could equally well be served by containers of many other shapes, and in such circumstances the incidental function should not by itself preclude trademark registrability if the other conditions precedent are present.

Id. (quoting Best Lock Corp. v. Schlage Lock Corp., 413 F.2d 1195, 1199 (C.C.P.A. 1969)).

87. *See* GILSON, *supra* note 4, § 7.02(7)(h)(iv). Some of those factors used by many courts include: whether the alleged infringer designed the mark independently, without knowledge of

As mentioned in the introduction, traditional building trademark protection lawsuits focus on potential infringers creating similar building designs. Recently, along with *Rock and Roll Hall of Fame* in the Sixth Circuit, a New York district court dealt with trademark infringement of a three-dimensional structure alleged against a producer of souvenir merchandise. In *New York Racing Association, Inc. v. Perlmutter Publishing, Inc.*,[88] the court held that T-shirts depicting paintings of horse racing scenes at the Saratoga Race Course did not infringe the Course's trade dress.[89] The court stated that in order to afford an aesthetic product feature trade dress protection absent secondary meaning, it must be "inherently distinctive" when copied onto souvenir merchandise.[90] The court found that determining whether a product feature qualifies as "inherently distinctive" requires an inquiry into whether the feature is likely to serve primarily as an indicator of source.[91]

Comment on Copyright as it Applies to Architecture

Intellectual property protection for architecture includes not only trademark and trade dress protection, but also, copyright protection.[92]

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the principle's mark; whether possible intentional appropriation can raise a likelihood of confusion inference; whether the plaintiff's design is so functional as to make it unprotectable as a trademark; whether the architectural feature serves as a trademark or service mark; or whether likelihood of confusion is likely because of similarity between the two marks. *Id.*

88. 959 F. Supp. 578 (N.D.N.Y. 1997).

89. *Id.* at 581. The plaintiff in the case operated the Saratoga Race Course and sold souvenir merchandise depicting racing scenes from the course. *Id.* The asserted trade dress claim in the case centered on the grandstand, which the plaintiff claimed to be one of the most recognizable structures in horse racing (second only to the twin spires at Churchill Downs) and a valuable source of licensing revenue. *Id.*

90. The court defined the aesthetic product feature as the images of the Saratoga Race Course depicted on souvenir items such as T-shirts. *Id.*

91. *Id.* at 580 (citing Knitwaves, Inc. v. Lollytogs Ltd., Inc., 71 F.3d 996, 1005 (2d Cir. 1995)). Basing its decision on this test, the court found the evidence insufficient to conclude that the images of the race course on plaintiff's merchandise served primarily as an indicator of source. *Id.* at 581.

92. In the United States, protection of an author's work under copyright begins with the Constitution, which authorizes the granting of exclusive rights to authors for their works. *See supra* note 12. Under this authority, in 1790 Congress enacted the first copyright act. *See* MELVILLE NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.01 (1998). From that first copyright act, copyright law would undergo two major changes in the next two hundred years, ending with the 1976 Copyright Act. Congress overhauled the 1790 copyright act in 1909; and again in 1976, resulting in, for the most part, current copyright law as it stands today. *See*

Copyright protection for architectural works evolved through a different form, and only recently came into its own as a distinct category of copyrightable subject matter.

Originally, works of architecture under federal copyright law fell into the category of "pictorial, graphic, and sculptural works."[93] As such, works of architecture were subject to the "useful article doctrine,"[94] and accompanying separability test[95] that governed the copyrightability of works within that category.[96] In 1988 the United States ratified the Berne Convention,[97] which required the United States to comply with the minimum standards of copyright protection of the Convention.[98] Assessing the requirements of the Berne Convention, the House Committee on the Judiciary noted that Article 2(1) of the treaty included "works of architecture" among articles protected by copyright.[99]

ROBERT P. MERGES ET AL., INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE 323 (1997).

93. 17 U.S.C. § 101 (1976). Under the 1976 Copyright Act pictorial, graphic, and sculptural works include: "two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, *including architectural plans*." MERGES ET AL., *supra* note 92, at 323 (emphasis added).

94. *See id.* The useful article doctrine provides that the copyrightability of pictorial, geographic, and sculptural works include only those "works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned." *Id.*

95. *See id.* The separability test provides that:

> The design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

Id.

96. *See* NIMMER, *supra* note 92, § 2.08(D)(2)(a), n.159.

97. Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, § 1, 102 Stat. 2853. The Berne Convention grew from the Convention for the Protection of Literary and Artistic Works, which was signed in Berne, Switzerland, in 1886. *See* NIMMER, *supra* note 92, § 17.01(B)(1). The subject of the Convention was recognition of copyright protection across international boundaries. Since its inception 77 countries have adopted the Berne Convention. *See id.*

98. *See* H.R. REP. NO. 101-735, at 5-6 (1990), at 5, *reprinted in* 1990 U.S.C.C.A.N. 6935.

99. *See id.* at 11. Specifically, Article 2(1) provides protection for three-dimensional works of architecture, separate from illustrations, sketches, plans, and three-dimensional works that relate to architecture. *See* NIMMER, *supra* note 92, § 2.20. Because of the discrepancy between then current copyright law and the Berne Convention with respect to works of architecture, the Senate Judiciary Committee requested an in-depth study from the Copyright Office, in order to evaluate how the level of copyright protection afforded architecture could be

In 1990 as a result of the Copyright Office's report on the subject, Congress enacted the Architectural Works Copyright Protection Act[100] in order to fully comply with the Berne Convention.[101] Among other provisions, the Act added a new separate category of copyrightable subject matter, "architectural works," to the Copyright Act.[102]

In addition to adding architectural works as a separate copyrightable subject, the Architectural Works Copyright Protection Act added a provision to the Copyright Act on the scope of architectural copyright rights.[103] This section of the Copyright Act allows two exceptions to exclusive rights for architectural works: permitting certain pictorial representations of architecturial works and allowing owners to alter or destroy the building's physical structure.[104] The House Committee recognized the public art form of architecture and that millions of people visit different cities every year and return home with photographs, posters, and other pictorial depictions of famous works of architecture as mementos of their

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raised to the required level of Berne. *Id. See generally* Notice of Inquiry: Works of Architecture, 53 Fed. Reg. 21536 (1998).

100. Pub. L. No. 101-650, 104 Stat. 5089, 5133 (1990).

101. *See* NIMMER, *supra* note 92, § 2.20.

102. *See* 17 U.S.C. § 102(a)(8) (1990). The Copyright Act defines "architectural work" as "the design of a building as embodied in any tangible medium of expression, including a building, architectural plans, or drawings. The work includes the overall form as well as the arrangement and composition of spaces and elements in the design, but does not include individual standard features." *Id.* § 101. Separating out architectural works from pictorial, graphic, and sculptural works meant that architectural works were not subject to the separability test of the useful article doctrine like pictorial, graphic, and sculptural works. *See* NIMMER, *supra* note 92, § 2.20. For a discussion of the separability test see *supra* note 94. While architectural works are no longer subject to the separability test, they are still subject to a functionality requirement, allowing protection only when "the design elements are not functionally required." *See* NIMMER, *supra* note 92, § 2.20.

103. 17 U.S.C. § 120 (1990).

104. The statute provides:

> The copyright in an architectural work that has been constructed does not include the right to prevent the making, distributing, or public display of pictures, paintings, photographs, or other pictorial representations of the work, if the building in which the work is embodied is located in or ordinarily visible from a public place.

17 U.S.C. § 120(a).The statute states: "Notwithstanding the provisions of section 106(2), the owners of a building embodying an architectural work may, without the consent of the author or copyright owner of the architectural work, make or authorize the making of alterations to such building, and destroy or authorize the destruction of such building." *Id.* § 120(b).

trips.[105] By allowing pictorial representations of architecture, Congress sought to balance the interests of authors and the public.[106]

IV. *ROCK AND ROLL HALL OF FAME AND MUSEUM V. GENTILE PRODUCTIONS*

A. A Photographer Creates a Poster of the Rock and Roll Hall of Fame

In 1991 the Rock and Roll Hall of Fame Foundation ("Foundation") commissioned famous architect I.M. Pei to design a building to house the Rock and Roll Hall of Fame Museum ("Museum").[107] The Foundation opened the doors to the Museum in 1995.[108] In 1996 the Foundation received approval from the State of Ohio for trademark and servicemark registration of the Museum's building design.[109] Since before the Museum's opening the Foundation sold various promotional items featuring the Museum's building design, including a poster.[110] Also, many of these promotional items depicted a small insignia or trademark.[111]

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105. *See* H.R. REP. NO. 101-735, at 22. In addition, Congress also noted that many scholarly works on architecture rely on photographs of architectural works. *Id.*

106. *See id.* Remarking that pictorial representations do not hinder the normal exploitation of architectural works, the Committee decided that the intervening public policy justified the exception to copyright's exclusive rights. *Id.* The Committee stated that, without the express exception, a defense of fair use could be raised by an alleged infringer who photographed a work of architecture; however, they stated that the exception was inserted to prevent the ad hoc decisions of the fair use defense. *Id.*

107. 134 F.3d at 750. The Foundation envisioned a building embodying the "freedom, youthful energy, rebellion, and movement of rock and roll music." *Id.* at 751. Before constructing the Museum in 1988, the Foundation registered as its service mark "THE ROCK AND ROLL HALL OF FAME" with the USPTO. *Id.* at 750.

108. *Id.* at 750.

109. 134 F.3d at 751. The Foundation currently has a pending trademark application with the USPTO regarding the Museum's building design. *Id.*

110. As early as 1993 the Foundation sold promotional materials such as T-shirts and posters depicting versions of the building's shape. *Id.* at 759 (Martin, Jr., CJ, dissenting). The poster of the Museum features the building on opening night, from a distant, elevated vantage point, with a red carpet scrolling down from the building's front doors and interior lights illuminating the Museum's glass facade. *Id.* at 752. Beneath the photograph of the Museum appears the words, "The Rock and Roll Hall of Fame and Museum—Cleveland." *Id.*

111. 134 F.3d at 752. The court labeled the trademark as the "composite mark," and described it as:

> a triangle formed by six lines fanning out from a single point. The triangle is

Around the spring of 1996, professional photographer Charles Gentile photographed the building for use on a poster featuring the Museum.[112] The Foundation sent Gentile a letter warning him of the trademark violation liability he would incur if he sold the poster without the Foundation's approval.[113] Despite these warnings Gentile began selling a poster of the photograph that spring.[114]

B. The Foundation Files Suit and Receives a Preliminary Injunction

After Gentile offered his poster depicting the Museum building for sale, the Foundation filed a five-count complaint alleging trademark infringement, unfair competition, and trademark dilution.[115] The Foundation then filed a motion for a preliminary injunction to prevent Gentile from distributing the posters of the Museum, pending the outcome of a trial.[116]

At the hearing on the Foundation's motion, the district court found

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> intersected by three horizontal lines, contains two dots running vertically, and may be intended to be evocative of the Museum's building design. In a circle around this triangular design are the words, "ROCK AND ROLL HALL OF FAME & MUSEUM."

Id. The other items produced by the Foundation at trial, including an advertisement for the Museum's opening, some postcards, and two T-shirts. *Id.* The advertisement and the two T-shirts also featured the composite mark. *Id.*

112. Gentile approached the Foundation about obtaining official sponsorship for a poster of his photograph, but the Foundation rejected his offer. 934 F. Supp. 868, 871 (N.D. Ohio 1996).

113. *Id.*

114. 134 F.3d at 751. Gentile's photograph featured a close-up of the Museum at ground level, apparently taken at a time when the Museum was closed. *Id.* at 752. The poster contained the photograph with an inscription underneath that read, "ROCK 'N ROLL HALL OF FAME," which appeared above the smaller word, "CLEVELAND." *Id.* at 751. Gentile's signature appears in small print below the photograph, as does a copyright notice from Gentile Productions, also in small print. *Id.*

115. 134 F.3d at 751. Specifically, the Foundation alleged trademark infringement in violation of 15 U.S.C. § 1114(1), "unfair competition, false or misleading representations, and false designation of origin" in violation of 15 U.S.C. § 1125(a) and dilution of trademarks under 15 U.S.C. § 1125(c). *Id.*

The Foundation brought two other counts under Ohio law, claiming unfair competition and trademark infringement. *Id.* The court did not analyze the Foundation's state law claims separately from the federal claims and stated that the analysis of Ohio state statutory and common law trademark infringement claims follows the federal Lanham Act. 934 F. Supp. at 872 (citing Yocono's Restaurant, Inc. v. Yocono, 651 N.E.2d 1347 (Ohio Ct. App. 1994)).

116. 134 F.3d at 751. Because the Foundation based its motion only on its trademark infringement claim, the district court instructed Gentile that he did not need to respond to the entire complaint for the preliminary injunction hearing. *Id.*

the Museum's design fanciful and capable of trademark protection.[117] In addition, the court noted that it could infer an intent to deceive the public as to origin when the defendant uses an identical mark.[118] The district court granted the Foundation's motion, concluding that it met the burden required to issue a preliminary injunction.[119]

C. Gentile Appeals Preliminary Injunction

Gentile appealed the preliminary injunction to the Sixth Circuit, claiming that the district court abused its discretion in granting the injunction.[120] A split court of appeals vacated the preliminary injunction, concluding that the record did not establish that the Foundation had a likelihood of success on the merits.[121] The majority based its decision on a finding that Gentile's photograph did not infringe on the Museum's building design trademark.[122]

Conceding that a photograph prominently depicting another's trademark could use the trademark as the object of the photograph,

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117. 934 F. Supp. at 872. The court noted that a fanciful mark is the strongest of characterized trademarks; therefore, it was more likely that encroachment would cause confusion. *Id.* Further, the court stated that extensive advertising and promotion of the Museum's building design trademarks created public recognition of the trademarks as being connected with the Museum either through the Foundation, its official licensees, or its official sponsors. 134 F.3d at 752.

118. 934 F. Supp. at 872. The district court stated that to prove trademark infringement the Foundation must show that (1) it has a protectable trademark and (2) confusion is likely to result from the unauthorized use of the trademark. *Id.* at 871 (citing Sadler-Cisar, Inc. v. Commercial Sales Network, Inc., 786 F. Supp. 1287, 1299 (N.D. Ohio 1991)).

119. 934 F. Supp. at 873. In considering the Foundation's motion for preliminary injunction, the district court relied on four factors: (1) reasonable probability of plaintiff's success on the merits of its claim(s), (2) irreparable injury to plaintiff if relief is not granted, (3) probability of substantial harm to others if the injunction is granted, and (4) whether the public interest would be served by granting the preliminary injunction. *Id.* at 871 (citing Frisch's Restaurant Inc. v. Shoney's Inc., 759 F.2d 1261, 1263 (6th Cir. 1985)). The district court's preliminary injunction ordered Gentile to cease the making, selling, and using of his poster depicting the Museum and to deliver to the Foundation's attorney all of the posters in his possession for destruction. *Id.* at 873.

120. 134 F.3d at 753. Specifically, Gentile argued that his photograph of the Museum and use of the words "ROCK N' ROLL HALL OF FAME" were not infringing trademark uses of the Museum's building design and servicemark. *Id.* Gentile argued that the words "ROCK N' ROLL HALL OF FAME" serve the non-trademark purpose of merely describing his non-infringing photograph. *Id.*

121. *Id.*

122. 134 F.3d at 755.

the majority was not persuaded that the Foundation used the Museum's design as a trademark.[123] First, the court asserted that they did not readily recognize the Museum's design as an indicator of origin or sponsorship; rather, they viewed the photograph as that of a well-known and accessible public landmark.[124] The majority stated that the public might not perceive a picture of the Museum as an identifier or origin as much as ornamentation.[125] Second, the majority found that the Foundation's use of various building depictions on its merchandise weakened its claimed use as a trademark.[126] The majority reasoned that the hallmark of a trademark was consistent and repetitive use of a mark as an indicator of origin; a use the Foundation failed to implement with respect to the Museum.[127]

Next, the majority turned to Gentile's use of the words "ROCK N' ROLL HALL OF FAME - CLEVELAND" and the Museum's registered service mark of the same.[128] Without making a conclusion as to the possible infringement, the majority found it highly probable that Gentile's use would constitute non-infringing fair use of the

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123. *Id.* at 754.

124. *Id.* Contradicting the district court's finding that the public had come to recognize pictures of the Museum's design as being associated with the Foundation, the majority also noted the that the record lacked any evidence that the public recognized the Museum's design as a trademark. *Id.* Further, the majority claimed that the Museum's designation as a landmark in downtown Cleveland undercuts a finding of "fancifulness" in a trademark context. *Id.*

125. *Id.* at 754-55.

126. *Id.* at 755. The merchandise depicting the Museum used different versions of the building shape on different souvenirs. Some items featured the rear of the building, and drawings of the building on two T-shirts differed from the photograph on the poster. *Id.* Also, while one postcard contains the same photograph as the poster, another postcard shows close-up photographs of the Museum, which the court claimed are not immediately recognizable as the Museum. *Id.*

127. 134 F.3d at 755. The majority likened this case to cases where the estates of deceased celebrities tried to claim trademark protection of the famous person's likeness. *Id.* The majority cited one case dealing with the likeness of Elvis Presley where a New Jersey District Court held that even if Presley's Estate could show that one particular image of Presley had been used consistently as a trademark, that did not support the conclusion that all images of Presley served the same function. *Id*. (citing Estate of Presley v. Russen, 513 F. Supp. 1339, 1363-64 (D.N.J. 1981)). The court also cited a case holding that even if Babe Ruth had an established trademark in one particular representation of his likeness, that trademark would not cover all photographs ever taken of Ruth. 134 F.3d at 755 (citing Pirone v. MacMillan, Inc., 894 F.2d 583 (2d Cir. 1990)).

128. The majority noted that the district court did not make a separate finding with respect to the words alone, and thus, the majority could not be certain how the district court would have ruled had the photograph been found non-infringing. 134 F.3d at 756.

Foundation's mark.[129] The majority stated that if the Foundation fails to show that Gentile made an infringing use of the Museum design, then Gentile's use of the words would merely constitute a description of his good.[130]

In a dissenting opinion, Chief Judge Martin Jr. stated that the Foundation had established a trademark in the Museum design.[131] The dissent noted that the Museum's design serves to identify it to consumers and as an array of tangible and intangible elements.[132] The totality of the contents of the Museum is the goods of the Foundation, of which posters are but a singular part.[133] Responding to the majority's claim that, in Gentile's poster, the Museum appears to be the good itself, the dissent concluded if that were true, the Foundation sells buildings, and Gentile sells photographs of buildings.[134]

Addressing the Foundation's trademark use of the Museum, the dissent noted that versions of the Museum's shape were in use on a variety of products more than two years before the actual construction of the building, before the Museum even became a landmark.[135] The dissent claimed that before the construction of the Museum, the promotional materials, bearing the versions of the Museum, represented the Foundation's goods and established a trademark.[136] The dissent rhetorically asked whether a Coca-Cola

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129. *Id.* at 756. 15 U.S.C. § 1115(b)(4) (1998) allows a party to defend a trademark infringement claim on the grounds that the use of the term is "descriptive of and used fairly and in good faith only to describe the goods or services of such party." *Id.*

130. *Id.*

131. *Id.* (Martin, Jr., CJ, dissenting). "I believe that the Museum has devised a distinguishable token, appropriated that token to a particular class of goods and plainly demonstrated quantifiable good will." *Id.*

132. *Id.* at 757. The dissent likened the Museum to a Coca-Cola bottle, which serves to both allow the consumer to identify the contents of the bottle and to contain the Coca-Cola soft drink. *Id.* As the Museum building represented the Coca-Cola bottle, the dissent noted that the Museum's contents represented the Coca-Cola drink inside the bottle. *Id.*

133. 134 F.3d at 757 (Martin, Jr., CJ, dissenting). The Museum, the dissent noted, houses nostalgia, memorabilia, and a bazaar that sells snow domes, postcards, T-shirts, baseball hats, and posters. *Id.* With respect to the poster at the center of the litigation, the dissent claimed, "[i]f a photograph of a trademark . . . can be sold by the owner of the trademark in a poster form, that poster naturally must be recognized as one of the owner's 'goods', albeit a derivative good." *Id.*

134. *Id*. at 757-58.

135. *Id.* at 759. "Such use predates the opening of the Museum by more than two years; the Museum would have then been not a public landmark, but a construction project." *Id.*

136. 134 F.3d at 759. The Foundation's promotional items "announced to the public the

bottle would enjoy any less trademark protection if it were ten stories tall.[137] In addition, a photograph of the bottle would still be a photograph of a trademark, entitling the Coca-Cola Company to protect it as such.[138]

Turning to the doctrine of functionality, the dissent observed that if the Museum housed its artifacts in a warehouse, the building design would be insufficient to claim trademark protection, since purely functional designs cannot serve as trademarks.[139] Instead, the Foundation created a signature edifice so unique that it offers instant recognizability.[140]

Finally, the dissent addressed the majority's distinction between the trademark fancifulness of the Museum and the word "Exxon"; while a distinction might be accurate, the dissent stated it is nonetheless irrelevant, since the Lanham Act read literally has been held nonrestrictive.[141] The dissent claimed that no meaningful distinction exists between a two-dimensional and three-dimensional trademark; therefore, a photograph of the Museum could qualify as a trademark on merchandise.[142]

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coming of a place where not only could they measure their own lives by the evolution of rock music, they could also buy more promotional material to show for their visits." *Id.*

137. *Id.* Also, the Foundation's five Ohio state trademark and two Ohio state service marks registrations describe the mark as being either the "Rock and Roll Hall of Fame and Museum Building," or "Rock and Roll Hall of Fame and Museum Building Shape." The dissent noted these registrations and stated they were not inconsistent with using different versions of the Museum shape on products. *Id.*.

138. *Id.* Moreover, the dissent claimed if a particular photograph of the bottle were not recognizable as the Coca-Cola bottle, the trademark of the bottle itself would not be impaired. *Id*. Additionally, a likelihood of confusion would be absent since the photograph could not be discerned as one of the trademark. *Id.*

139. *Id.* at 757 (citing WSM, Inc. v. Tennessee Sales Co., 709 F.2d 1084, 1087 (6th Cir. 1983)).

140. 134 F.3d at 757.

141. *Id.* at 759. The dissent cited the Supreme Court's reasoning in *Qualitex Co. v. Jacobson Prodnet Co., Inc.*, which upheld the ability of a mark to serve as a valid trademark even though it had a functional use as well as an origin identifying use. *Id*. *See supra* notes 39-42 and accompanying text.

142. 134 F.3d at 759 (Martin, Jr., CJ, dissenting).

V. ROCK AND ROLL HALL OF FAME: VALID TRADEMARK?[143]

In vacating the district court's preliminary injunction, the court of appeals relied on two bases: the validity of the Foundation's trademark and Gentile's use of the photograph. While the majority may have been correct in vacating the injunction, their analysis confuses two issues: the validity of the trademark and the likelihood of confusion.[144]

The finding that the Foundation had not used the Museum design as a trademark was the most thoroughly analyzed basis for the majority's decision.[145] The majority's rationale presents the first major problem with the opinion. Throughout the majority's opinion they discuss the Museum's non-trademark uses; however, they base their conclusions on the pictures of the Museum, not the building itself.[146] Even if the Foundation had not used pictures of the Museum for a trademark purpose, that fact does not lead to the conclusion that the Foundation had not used the building itself as a trademark. The *White Tower* and *Fotomat* decisions demonstrate the appropriateness of buildings as trademarks.[147] Furthermore, the USPTO registers buildings as trademarks if they are used such that they could be recognized as a mark; advertisements are considered evidence of such use.[148] The dissent correctly points out that the promotional materials featuring the Museum's design are the goods that establish the trademark in the Museum design.[149] Because the use of such collateral products increases public awareness of the Museum, this

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143. An important preliminary fact of consideration concerning *Rock and Roll Hall of Fame* is that the decision of the Sixth Circuit only vacated the district court's preliminary injunction and remanded the case for further consideration. This leaves open the possibility that a fact finder, with the benefit of a trial, may conclude that Gentile made a trademark infringing use of the Museum's valid trademark. The effect of the Sixth Circuit's opinion only serves to create doubt as to the validity of the Museum's claim of trademark infringement.

144. While the majority based their decision on the Foundation's trademark and Gentile's alleged infringment, they never directly addressed the likelihood of confusion issue.

145. 134 F.3d at 754.

146. *Id.* The majority states that while the Museum's design is fanciful, it is not clear that a picture of the Museum is fanciful as would define a trademark. *Id.* at 154-55. The majority concludes that the Foundation has not used the Museum design on its goods with any consistency, the hallmark of a trademark. *Id.* at 155.

147. *See supra* notes 75-77, 82-86 and accompanying text.

148. *See supra* notes 78-80 and accompanying text.

149. 134 F.3d at 759 (Martin, Jr., CJ, dissenting).

merchandise serves an advertising purpose.[150]

The majority's statement that the Museum's existence as a landmark undercuts its fancifulness as a trademark is also incorrect; the majority seems to apply an aesthetic functionality bar against the Museum.[151] The majority's argument suggests that if the Foundation had constructed a less memorable building to house the Museum, then the weakened status of the Museum as a landmark would have increased the available trademark protection.[152] This argument contradicts the Sixth Circuit's decision in *Ferrari*.[153] The court in *Ferrari* refused to apply such a broad application of the aesthetic functionality doctrine, because it would discourage the development of attractive designs.[154] Furthermore, the Museum's recognizability and its association with services provided therein fully comport with the theory behind architectural trademarks. The Museum's unique building design and landmark status will draw passing motorists to the Museum. The Museum's design will make the Foundation's services and products readily identifiable to the public.[155]

In contrast to the majority, the dissent focused on the Museum design as a three-dimensional trademark. The dissent correctly points out that the Museum's physical structure serves as the trademark, and that the photograph of the Museum merely depicts the three-dimensional, trademarked structure.[156] The dissent makes a convincing argument that the Foundation owns a valid trademark in

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150. *See supra* notes 56-57 and accompanying text.

151. 134 F.3d 754. Their argument seems to be that the Museum gains its appeal by recognition as a public landmark, and this recognition undermines the ability of the Museum design to designate a source of origin for its products and services.

152. The dissent directly addresses the majority's suggestion by noting that had the Foundation "sought only an attic to in which to store its artifacts, it might have leased a warehouse with substantially more space at a fraction of the cost." 134 F.3d at 757.

153. Ferrari S.P.A. Esercizio Fabriche Automobile Corse, 944 F.2d at 1235. *See supra* notes 47-49 and accompanying text.

154. 944 F.2d at 1246.

155. *See supra* notes 71-72 and accompanying text. The dissent also correctly noted that the Museum's landmark quality is due to the Foundation's desire that the building serve as a mark by constructing a structure so unique that it offered instant recognizability. 134 F.3d at 757.

156. *Id.* at 758. The dissent's analogy involved the Coke bottle and a photograph of it. *Id.* The dissent noted that: "When a Coke bottle is photographed it loses its dimension, but the subject of the picture remains recognizable as one of a trademarked, three dimensional figure." *Id.*

the Museum's design; however, he failed to discuss the likelihood of confusion requirement of trademark infringement.[157]

Although the majority based its decision on the lack of a valid trademark in the Museum, if analyzed in terms of the likelihood of confusion requirement, it leads to the correct conclusion.[158] First, one of the factors for determining the likelihood of confusion requires comparing the two conflicting marks in their entirety.[159] As the majority noted, the Foundation used a composite mark on most of the promotional items that displayed the Museum.[160] This composite mark and the depiction of the Museum constitute the totality of the sponsorship identifying mark on the promotional items to form the complete commercial impression. Removing one element, namely the composite mark, would change the commercial impression of the item and create an overall appearance less likely to cause confusion with a product bearing both elements.[161]

Second, while the majority incorrectly equated the various photographic versions of the Museum with an unestablished trademark use, this fact also illustrates a relevant point with respect to the likelihood of confusion. Logically, the greater the number of photographic versions of the Museum, the more diluted the source identifying function of the Museum design.[162] The fact that these

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157. The dissent seems to believe that likelihood of confusion simply exists if two marks are duplicates, and directly compete with one another in similar channels of commerce. 134 F.3d at 758. These characteristics of competing marks are certainly factors in determining the likelihood of confusion, but as the Sixth Circuit previously stated in *Champions Golf Club, Inc. v. The Champions Golf Club, Inc.*, 78 F.3d 1111, 1116 (6th Cir. 1996), the test for likelihood of confusion cannot be stated with mathematical precision.

158. This assumes that the Foundation had established a valid trademark in the Museum design. Also, because the photographic promotional material of the Museum establish its trademark right, these photographs must be the basis of any likelihood of confusion arising out of Gentile's photograph.

159. *See supra* note 70; *Champions Golf Club, Inc.*, 78 F.3d at 1116.

160. 134 F.3d at 752. The composite mark appears on the Foundation's poster of the Museum as well as the T-shirts and advertisements bearing the Museum. *Id.* The majority described the composite mark as "a small circular designation" appearing to be a trademark. *Id.*

161. *See supra* note 68 (factor (1)).

162. The majority noted that the numerous versions of the Museum do not "create a consistent and distinct commercial impression as an indicator of a single source of origin or sponsorship." 134 F.3d at 755. In this case the only version of any practical importance to the issue of sponsorship should be Gentile's version; the majority's analysis, nonetheless, illustrates the point.

numerous versions exist makes it less likely that any one photograph indicates a single source of origin or sponsorship over any other.[163] If the Foundation retained sole ownership rights to every photograph of the Museum design, then diluting the source identifying function of the design would be irrelevant; however, they hold no such right.[164] Photographs of the Museum have appeared complementing articles in newspapers and magazines throughout the Museum's existence.[165]

The widespread photographing of the Museum suggests another reason the likelihood of confusion requirement should fail in *Rock and Roll Hall of Fame*. This photographing illustrates the principle difficulty with providing building designs with broad protection against many types of photography. Photographs of our surrounding environment appear in many places throughout our society: from souvenirs and replications to newsprint and movies.[166] For this reason, it becomes difficult to attach an origin or sponsorship identifying function to the photograph of a building.[167] The owner of

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163. *See supra* note 126.

164. The majority noted that "[t]here is no such thing as property in a trademark except as a right appurtenant to an established business or trade in connection with which the mark is employed." 134 F.3d at 753 (quoting United Drug Co. v. Theodore Rectanus Co., 248 U.S. 90, 97 (1918)). Addressing the property right in photographs of the Museum, the dissent stated that, "[m]erely selling a poster of its own trademark does not give the [Foundation] the right to enjoin every duplication of its mark." 134 F.3d at 758.

165. For examples of articles accompanied by photographs of the Museum see Herbert Muschamp, *Architecture '95: Challenging The All-Too Rational*, N.Y. TIMES, Dec. 31, 1995, § 2, at 38; and Karen D. Stein, *Cleveland Rocks*, ARCHITECTURAL RECORD, Nov. 30, 1995, at 82; David Dillon, *Classic Pei a Little Off-key in Rock Milieu*, DALLAS MORNING NEWS, Sept. 10, 1995, at 1C.

166. Souvenirs from tourist attractions frequently depict the public environment of that attraction. For example, Fishs Eddy, a tableware store in New York, sells a series of souvenir dishes depicting a New York skyline border with the Chrysler Building and other landmarks featured. David W. Dunlap, *Design Notebook: The Skyline: Next a Fee for Looking?*, N.Y. TIMES, Aug. 27, 1998, at F1. For examples of newsprint featuring photographs specifically of the Rock and Roll Hall of Fame building, see *supra* note 165.

Similarly, comporting with the theme of the casino, the New York-New York Hotel and Casino of Las Vegas constructed a scale facade of numerous New York landmarks, including the New York Stock Exchange. Dunlap, *supra*. Also, frequently buildings appear in television and movies, giving a realistic viewpoint to the motion picture. For example, the movie "Godzilla" featured the mythical creature crushing the Flatiron Building, as well as many other New York landmarks. *Id.*

167. As part of Gentile's defense, he introduced an illustration of the Cleveland skyline, which included the Museum and its surrounding buildings. 134 F.3d at 754. Gentile also introduced a quilt featuring the landmarks of Cleveland, which included the Museum. *Id.* The majority in *Rock and Roll Hall of Fame* noted that the illustration and quilt presented by Gentile

the trademarked building could claim that no trademark problem exists when the building appears among several others in a photograph or illustration.[168] The problem would be where to draw the line between non-infringing skyline illustrations and infringing singular building illustrations.[169] The prevalence of photographic images of our surroundings makes it unlikely that the public would associate the majority of building photographs with the owner of the building's trademark.

When they amended the Copyright Act in 1990, Congress addressed the issue of grand scale photographing of buildings and the problems associated with blocking such photographs from the public.[170] In this Act Congress provided an exception to the copyright in architecture by allowing pictorial representations of publicly visible works of architecture.[171] Congressional recognition of building photographs in the public domain comes from the legislative history; where Congress noted the prevalence of vacation mementos consisting of photos of famous works of architecture created by a large number of originators.[172] This illustrates the point that it is unlikely the public will associate a building photograph with one particular originator or sponsor, even if the photograph features a single building.

While most photographs of buildings are not likely to confuse the public as to origin or sponsorship, that does not mean that confusion will never occur in the case of a photographic representation of a building trademark. For example, while *Fotomat II* centered on a confusingly similar building design, the court addressed the

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would present an easier case for finding non-infringement. *Id.*

168. In *Rock and Roll Hall of Fame*, the Foundation specifically responded to Gentile's exhibits, *supra* note 166, by stating that such illustrations would not present a trademark problem. 134 F.3d at 754.

169. To draw the line between illustrations, the essential question becomes: "How many buildings does it take for a photograph to not indicate origin or sponsorship from a specific building's trademark holder?"

170. Pub. L. No. 101-650, 104 Stat. 5089, 5133. *See supra* notes 99-105 and accompanying text.

171. *See* 17 U.S.C. § 120(a).

172. H.R. REP. NO. 101-735, at 22. Also, while the argument exists that trademark law operates on different standards than copyright law, the Copyright Act represents evidence that Congress favors the right of the public to photograph freely public buildings.

photographic representation of the building.[173] The court found that the two-dimensional representations of the buildings used in advertising and other printed material caused confusion as to origin.[174]

VI. CONCLUSION

The Sixth Circuit in *Rock and Roll Hall of Fame*, while ending their opinion with the correct conclusion, actually confuses the two issues of establishing a valid trademark and the likelihood of confusion between two trademarks. The Foundation clearly established a valid trademark right in the design of the Museum.[175] Had the court directly addressed the likelihood of confusion requirement, however, it would have failed to establish the Foundation's likelihood of success on the merits as required for a preliminary injunction.

One basis for the failure of the likelihood of confusion, the multitude of existing photographs, generally applies to the majority of buildings. While buildings may undeniably enjoy a level of trademark protection, this basis provides a rationale for thin protection for pictorial reproductions of building trademarks in many cases. The trademark holder of a building may enjoin certain reproductions of their trademark; however, the holder must first establish that a likelihood of confusion exists with concurrent use of the holder's mark and the alleged infringing mark.

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173. Fotomat Corp., 437 F. Supp. at 1231. *See supra* notes 35-86 and accompanying text.

174. "In addition to the confusing similarity between plaintiff's and defendant's buildings, there is confusion caused by the similarity in the two-dimensional representations of the buildings used by the parties on their advertising, fliers, processing envelopes, and other printed material." *Id.* at 1241.

175. The Foundation satisfied the requirements of establishing a trademark in the Museum by designing an inherently distinctive building and using the building design on promotional materials. *See supra* notes 22-54 and accompanying text.