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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92058315
Party	Plaintiff State of Michigan
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Attachments	State of MI Reply.pdf(199016 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

State of Michigan)	
)	
Petitioner,)	Reg. Nos.: 3992159
)	3348635
)	
v.)	
)	
M22, LLC,)	Proceeding: 92058315
)	
)	
Registrant.)	
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REPLY IN SUPPORT OF PETITIONER'S MOTION FOR
JUDGMENT ON THE PLEADINGS

No genuine issue of material fact remains with respect to whether Registrant M22, LLC's use and registration of the M-22 state route sign violates federal law. Under a purely legal analysis, Registrant's use and registration of the marks at issue is *per se* unlawful. Federal law expressly prohibits the protection of (and likewise the use of) the State's traffic control devices as trademarks, and Registrant's use and protection of the M-22 sign as a trademark is unlawful.

This conclusion follows directly not only from federal law, but also from common sense. If Registrant prevails, nothing would stop it from enforcing its trademark against the State of Michigan for any of the uses it makes or could make of its highway signs. For these reasons, the Board should cancel Registrant's registrations under the Lanham Act.

A party is entitled to judgment on the pleadings if there are no genuine issues of material fact to be resolved and the moving party is entitled to judgment

as a matter of law. TBMP 504.02. Registrant has not raised any genuine issue of fact in its response to Petitioner's motion for judgment on the pleadings. Registrant only asserts purely legal arguments that lack merit. These legal disputes are ready for resolution now.

First, Registrant's registration (and underlying requisite use) of the M22 marks in this case is a *per se* violation of federal law that is evident in the record and requires no subject-matter expertise by the Board. Unlike the parties in the labeling cases cited by Registrant, *see* Response at 6, Petitioner is not asking the Board in this case to interpret statutes and regulations with which it may lack familiarity or otherwise adjudicate compliance. Nor is it asking for cancellation based on a technical violation that is capable of correction. Rather, Petitioner asks the Board to recognize what is expressly prohibited and take corrective action. Federal law clearly provides that "[t]raffic control devices contained in this Manual [on Uniform Traffic Control Devices] *shall not be protected by a . . . trademark[.]*" *See* Mot., Dkt. #22, Ex. A (MUTCD at I-1). The marks in U.S. Registrations Nos. 3,348,635 and 3,992,159 are identical to and clear copies of Petitioner's traffic control devices protected by the Manual. The registrations accordingly violate federal law on its face. The lawfulness of the registrations is ready for resolution now, and by this Board.

Second, whether the Manual on Uniform Traffic Control Devices ("MUTCD") precludes private citizens, and not just states and local governments, from claiming trademark rights in uniform traffic control devices is a legal, not a factual, question.

When a court interprets a statute, it does not take discovery from the legislators who drafted it, and certainly not from the parties. No amount of fact discovery will aid the Board in interpreting the plain text of the Manual.

Registrant's legal arguments regarding how to interpret the Manual also lack merit. As an initial note, Registrant's discussion of the federal government's ability to copyright its own works is irrelevant to the interpretation of the MUTCD, which expressly prohibits parties from protecting traffic control devices *as trademarks*. See Mot., Dkt. #22, Ex. A (MUTCD at I-1).

Further, Registrant's legal argument that the MUTCD prohibits only states and local governments, and not private parties, from protecting traffic control devices as trademarks is belied by the plain language of the Manual. The Manual's prohibition is absolute and applies to all:

Any traffic control device design or application provision contained in this Manual shall be considered to be in the public domain. Traffic control devices contained in this Manual shall not be protected by a patent, trademark, or copyright, except for the Interstate Shield and any items owned by FHWA.

Id. (emphasis added). This plain text is clear and unambiguous—nowhere is it limited to state and local governments. The prohibition applies to Registrant, just as it applies to the State of Michigan and the U.S. Patent and Trademark Office.

To distract from the plain application of the MUTCD, Registrant cites a prior version of the Manual and relies on statements from its section on “Support” as an attempt to limit clear meaning. As an initial matter, the “Standards” in the Manual

are what is “required, mandatory, or specifically prohibitive.” The “Support” comments are not legally binding. Response at 11.

Nor do the Manual’s “Support” comments—in the current or prior versions—support Registrant’s argument that the Manual’s prohibition on trademark protection applies only to state and local governments. The prior “Standards” section identified the need for “uniform standards” for the classes of road and street systems. *Id.* Allowing *private organizations* to register road signs as trademarks equally hinders this objective.

Under Registrant’s speculative theory of the purpose of the Manual’s prohibition—that “the purpose underlying this mandate is to prohibit states from upsetting the national standards by exercising exclusive rights over the designs contained within the Manual”—this purpose would apply equally to private parties like Registrant. If a private party could protect a traffic control device as a trademark, then under federal trademark law it could preclude states, local governments, and the federal government from using the uniform traffic control device contained in the Manual. Private parties cannot be permitted to claim exclusive rights in uniform traffic control devices in violation of the Manual, and then pick and choose which entities by the party’s grace it will permit to use the marks, as Registrant has purported to do with the State of Michigan. Registrant’s theory that it can register a state route sign on the unstated but necessary condition that it not enforce the mark against the State or federal government, so that it does not run afoul of federal traffic regulations, is nowhere supported in the law.

These uniform traffic control devices are expressly reserved for their intended use to regulate traffic and ensure safety on interstate and intrastate roadways. Granting exclusive rights to use them not only violates regulations under the federal Highway Safety Act of 1966, it hinders their ability to serve their intended function. The prohibition on trademark protection for these devices is explicit, and their appropriation as trademarks for commercial use is significant and is a material violation. As a matter of law, their use cannot create trademarks rights.

Third, whether the Highway Act of 1966 imposes legal obligations on the states is a legal question, not a factual question. And Registrant’s legal argument that the Act does not impose obligations on the states lacks merit.

Registrant suggests that the Act and regulations adopting the Manual are not binding on the states because, in theory, states could reject federal funds and fail to comply with the Act and Manual. To begin with, Registrant’s argument is irrelevant. Michigan does accept federal funds, and it does follow the Manual in accordance with federal statutes and regulations. Michigan’s state route signs are thus protected under federal law.

But more importantly, compliance is not discretionary—it is mandatory. The Highway Safety Act of 1966 provides that each state “shall” have a highway safety program approved by the Secretary of Transportation. 23 U.S.C. § 402(a)(1). The Act further provides that said state highway programs, which are “required” under 23 U.S.C. § 402(a)(1), “shall” comply with uniform guidelines promulgated by the Secretary. *Id.* § 402(a)(2). While the Act does not “require the Secretary to require

compliance with every uniform guideline” and provides that funds for States failing to implement an approved program “shall be reduced,” 23 U.S.C. § 402(c)(2), the mandatory directive of the statute remains: that each state “shall” have a highway safety program approved by the Secretary, and that such a program “shall” comply with uniform guidelines promulgated by the Secretary.¹ The word “shall” imposes an obligation; it is not a mere invitation. *See National Association of Home Builders v. Defenders of Wildlife*, 551 U.S. 644, 661-62 (2007) (“shall” is mandatory); *Gilda Indus., Inc. v. United States*, 622 F.3d 1358, 1364 (Fed. Cir. 2010) (“shall” is mandatory and leaves no room for discretion).

And the Secretary requires compliance. The regulations provide that “[e]ach State . . . and Federal agency *shall* have a program as required by 23 U.S.C. 402(a), which *shall* include provisions for the systematic upgrading of substandard traffic control devices and for the installation of needed devices *to achieve conformity with the MUTCD.*” 23 C.F.R. § 655.603(d) (emphasis added). The regulations also provide that “[w]here State . . . MUTCDs or supplements are required, they *shall* be in substantial conformance with the National MUTCD. Substantial conformance means that the State MUTCD or supplement *shall* conform as a minimum to the standard statements included in the National MUTCD.” *Id.* § 655.603(b)(1) (emphasis added). The National MUTCD’s prohibition against protecting traffic control devices as trademarks is a “standard” statement with which the states must conform. MUTCD p I-1; 23 C.F.R. § 655.603(b)(1). While States are directed at a

¹ Registrant’s citation to language in a different Act, the Federal Aid Highway Act, regarding a state’s discretion to decide which projects to spend federal funds on, is

minimum to meet the “standards” of the MUTCD, they are encouraged to adopt the National MUTCD “in its entirety” as their “official Manual on Uniform Traffic Control Devices.” 23 C.F.R. § 655.603(b)(2). States also “shall” adopt changes issued by the Federal Highway Administration to the National MUTCD within two years from the effective date of the final rule. *Id.* § 655.603(b)(3). Compliance with these requirements is mandatory, not discretionary.

Fourth, whether federal regulations under the Highway Safety Act of 1966 conflict with the Lanham Act is a legal question, not a factual question. And Registrant’s legal argument that the Lanham Act precludes the MUTCD’s prohibition against protecting traffic control devices as trademarks lacks merit.

There is no conflict between the Lanham Act and federal law adopting the MUTCD. The Lanham Act does not provide, for example, that all traffic signs are registrable as trademarks. Instead, the Lanham Act sets out rules of general application governing the registration of marks, subject to other federal laws that preclude the use and registration of certain specific symbols or categories of symbols. Indeed, the Trademark Manual of Examining Procedure recognizes that “[v]arious federal statutes *and regulations* prohibit or restrict the use of certain . . . symbols” used by the United States government and its agencies, and mandates that such symbols must be “reserved for the specific purposes prescribed in the relevant statute and must be free for use in the prescribed manner.” TMEP § 1205.01 (emphasis added). If Registrant were correct that the Lanham Act precludes the MUTCD’s rule, then TMEP § 1205.01 would be nonsensical. Indeed,

inapposite. *See* Response at 8 (citing 23 U.S.C. § 145).

if Registrant were correct, there would be no such claim for cancellation as “unlawful use in commerce.” But trademark law clearly contemplates statutes and regulations such as those under the Highway Safety Act of 1966, and provides for the cancellation of registered marks that are in “unlawful use in commerce.” “Use of a mark in commerce must be lawful use to be the basis for federal registration of the mark.” TMEP § 907; *General Mills Inc. v. Healthy Valley Foods*, 24 USPQ2d 1270, *4 (TTAB 1992). *See also* 37 C.F.R. § 2.69 (“When the sale or transportation of any product for which registration of a trademark is sought is regulated under an Act of Congress, the Patent and Trademark Office may make appropriate inquiry as to compliance with such Act for the sole purpose of determining lawfulness of the commerce recited in the application.”). The Lanham Act does not conflict with the Department of Transportation’s prohibition on protecting public traffic control devices as trademarks.

Fifth, Registrant’s unarticulated argument that the defenses of laches, acquiescence, estoppel, consent, or waiver could permit it to register a non-registrable mark is a legal argument, not a factual dispute. And the legal argument lacks merit. These cannot be defenses to the registration of an illegal mark.

Registrant’s equitable defenses would fail in any event. Registrant obtained its registrations of the State’s M-22 State Route Sign in 2007 and 2011 and, as Registrant admits, the Attorney General became involved once it became aware that Registrant was enforcing its registered marks against other Michigan businesses with an equal right to use symbols in the public domain. *See* Response

at 4-5. Petitioner issued Advisory Opinion No. 7265 in May 2012, declaring it the official legal position of the Attorney General that “[n]o entity can lawfully claim exclusive control over use of the State’s highway route marker design because the design is in the public domain and is otherwise not subject to protection under trademark law.” Response at 4-5. *See also* Ex. C (Mich. Atty. Gen. Advisory Op. 7265, May 29, 2012). When the Attorney General Opinion failed to resolve the parties’ dispute, Petitioner brought its petition to cancel in December 2013. This sequence of events, which Registrant does not dispute, shows as a matter of law that Petitioner did not unreasonably delay, and that Registrant was clearly on notice that the validity of its marks was in dispute.

Sixth, Registrant is incorrect that the MUTCD would invalidate the marks cited on page 13 of Registrant’s response. Unlike Registrant’s M22 and M22 Online Registrations, the marks cited in Registrant’s response brief are not identical to a traffic control device contained within the MUTCD. “Main Street Checks” is not a traffic control device contained in the Manual. Route 66 was removed from the U.S. Highway System in the 1980s; and, in any event, the mark pictured in Registrant’s brief is not identical to the route sign. Finally, “Mexico 1” is not protected by the MUTCD because *it is in Mexico*, clearly outside the jurisdiction of the MUTCD; and, in any event, the mark pictured in Registrant’s brief does not match any of the MUTCD’s uniform template signs.

Seventh, while Registrant asserts that its M22 Marks are “creatively dissimilar from the M-22 road sign” and provides its M22 Online Registration as a

comparison, *see* Response at 3, Petitioner reiterates that the Board can take judicial notice that Registrant's marks—particularly its M22 Registration—are virtually indistinguishable from the M-22 State Route Sign, and that the registration of these effectively protects a uniform traffic control device as a trademark, contrary to federal law.

Because there are no unresolved factual disputes relevant to the issue before the Board, and because Registrant's M22 and M22 Online Registrations directly violate controlling federal law, the Board should grant Petitioner judgment on the pleadings and cancel Registrations Nos. 3,348,635 and 3,992,159.

By 

Date: March 10, 2015

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CERTIFICATE OF SERVICE

I certify that Petitioner's Reply in Support of Petitioner's Motion for Judgment on the Pleadings is being served upon John Di Giacomo, counsel for Registrant, via email at john@revisionlegal.com, as the parties have agreed, on March 10, 2015.

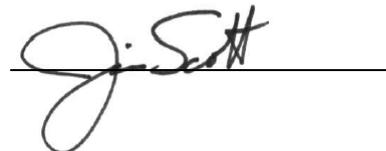


EXHIBIT C

The following opinion is presented on-line for informational use only and does not replace the official version. (Mich. Dept. of Attorney General Web Site - <http://www.ag.state.mi.us>)

STATE OF MICHIGAN
BILL SCHUETTE, ATTORNEY GENERAL

TRADEMARKS

Michigan highway route marker design as a trademark

No entity can lawfully claim exclusive control over use of the State's highway route marker design because the design is in the public domain and is otherwise not subject to protection under trademark law.

Opinion No. 7265

May 29, 2012

Honorable Frank D. Foster
State Representative
The Capitol
Lansing, MI 48909

You ask whether a private entity can legally claim exclusive control over a state highway route marker design for use on novelty merchandise and other items.

Information supplied with your request indicates that at least two Michigan corporations claim to have exclusive control over the use of a Michigan highway route marker design. (Attachment 1.) The first corporation claims to have exclusive control over the use of the plain characters "M 22" as well as the M-22 highway route marker design, to promote various goods and services. State Highway M-22 is a picturesque and well-traveled 116-mile drive along Lake Michigan through Manistee, Benzie, and Leelanau Counties.¹ The first corporation obtained registrations for a trademark and service mark² with the United States Patent and Trademark Office (USPTO) for the standard character mark "M22" (Attachment 2) with no particular claim to color, style, or design. The corporation also obtained a separate registration for a design identical to the M-22 highway route marker. (Attachment 3.)

The second corporation claims exclusive control over the use of the plain characters "M 119" when used to promote goods and services. State Highway M-119 is known as the "Tunnel of Trees," and is a 20-mile, scenic drive stretching between the Petoskey area and Cross Village in Emmet County.³ The second corporation obtained a USPTO registration for the plain character mark of "M 119" (Attachment 4) with no particular claim to color, style, or design.⁴ The second corporation applied for a trademark on the design of the M-119 highway route marker, but failed to obtain one because the USPTO deemed it too similar to the M-22 registered trademark. Nevertheless, the second corporation claims exclusive control over use of the M-119 highway route marker design to promote goods and services.

Both corporations have demanded that other businesses stop using the Michigan highway route marker designs for M-22 and M-119 to promote their own goods and services.

You ask whether these entities or others may claim exclusive control over Michigan's highway route marker design through trademark law or by other means.

Trademarks are governed under federal law by the Lanham Act, 15 USC 1051 *et seq.*, and under state law by the Michigan Trademark and Service Mark Act (MTSMA), 1969 PA 242, MCL 429.31 *et seq.*, and

common law. Definitions under each body of law are distinct, but a trademark may generally be understood to mean “any visible sign or device used by a business enterprise to identify its goods and distinguish them from those made or carried by others.”⁵

Federal trademark law represents an exercise of Congress’ authority under the Commerce Clause. *Dawn Donut Co v Hart’s Food Stores, Inc*, 267 F2d 358, 365 (CA 2, 1959). The purpose of the Lanham Act is to prevent consumer confusion in the marketplace by providing an assurance to a consumer about the origin of the goods or services the consumer purchases. Foley, Kathryn M., *Protecting Fictional Characters: Defining the Elusive Trademark-Copyright Divide*, 41 Conn L Rev 921, 939 (February 2009). When a consumer purchases a good or service with a registered trademark, the consumer has some certainty about the origin of the good or service and can make an informed decision on whether to complete the purchase. See *Shakespeare Co v Lippman’s Tool Shop Sporting Goods Co*, 334 Mich 109, 113-114; 54 NW2d 268 (1952) (observing that “[t]he function of a trade-mark is simply to designate the goods as the product of a particular manufacturer or trader and to protect his good will against the sale of another’s product as his”).

Trademarks are similar to but distinct from copyrights. Copyrights protect creative works and are created under authority of the Copyright Clause of the United States Constitution, which states that Congress can create laws “[t]o 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.” US Const art 1, § 8, cl 8; *Trade-Mark Cases*, 100 US 82; 25 L Ed 550 (1879). The purpose of copyright law is to enrich the public domain of creative works by rewarding creativity with the opportunity to have a limited monopoly over a creative work. *Sony Corp of America v Universal City Studios, Inc*, 464 US 417, 477; 104 S Ct 774; 78 L Ed 2d 574 (1984) (citations omitted).

But once a copyright in a creative work expires, the former rights-holder may not enforce his or her exclusive control over the intellectual property. *Kellogg Co v Nat’l Biscuit Co*, 305 US 111, 120–122; 59 S Ct 109; 83 L Ed 73 (1938); *Singer Mfg Co v June Mfg Co*, 163 US 169, 185; 16 S Ct 1002; 41 L Ed 118 (1896). The creative work becomes public property. *Singer Mfg Co*, 163 US at 185. “The prevailing view of the public domain is that of a commons, where material is free for anyone to take and use without restriction.” Heymann, Laura A., *The Trademark/Copyright Divide*, 60 SMU L Rev 55, 85 (Winter 2007). Thus, items in the public domain generally are not subject to copyright protection. See *Golan v Gonzales*, 501 F3d 1179, 1189 (CA 10, 2007) (“[T]he principle [is] that no individual may copyright a work in the public domain, [in] that ordinarily works in the public domain stay there”) (citations omitted).

Unlike copyrights, the term of a trademark is indefinite. “[F]ederal trademark law provides the grant of rights to the trademark owner for an indefinite period, the duration of which depends on public recognition that the trademark identifies the user’s goods and distinguishes them from the goods of others.” *Time Mechanisms, Inc v Qonaar Corp*, 422 F Supp 905, 910 (DNJ 1976) (citation omitted). It is thus possible for a trademark owner to maintain rights in a registered mark in perpetuity, so long as the registration with the USPTO is renewed every ten years. 15 USC 1058-1059.

With these general legal principles in mind, the question is whether Michigan’s state highway route marker design is in the public domain and thus not subject to trademark or other similar protections.

Both federal and state law provide for a uniform system of traffic control devices. In 1971, the United States Department of Transportation, Federal Highway Administration issued regulations designed to bring uniformity to the roadways of the United States pursuant to the Highway Safety Act of 1966. These regulations are set forth in the federal Manual on Uniform Traffic Control Devices (MUTCD). The federal MUTCD is promulgated by the Department of Transportation and sets “the national standard for all traffic control devices installed on any street, highway, or bicycle trail open to public travel,” 23 CFR 655.603(a); 23 CFR Part 655, Subpart F, “in accordance with” 23 USC 109(d) and 23 USC 402(a).⁶ See 23 CFR 655.603. In order to remain eligible for federal highway and highway safety program funds, a state must adopt the federal MUTCD as a state regulation, adopt a state MUTCD that is approved by the Secretary of Transportation as being in “substantial conformance” with the federal MUTCD, or adopt the federal MUTCD in conjunction with a state supplement. See 23 USC 109(d), 23 USC 402(c); 23 CFR

655.603(b)(3).

Consistent with these federal provisions, the Michigan Vehicle Code, 1949 PA 300, MCL 257.1 *et seq.*, requires the Michigan Department of Transportation (MDOT) and the Michigan State Police to adopt and maintain a uniform system of “traffic control devices,” which includes all signs,⁷ that conforms with the federal MUTCD. See MCL 257.608.⁸ In compliance with the Michigan Vehicle Code, MDOT has adopted versions of the Michigan MUTCD that are consistent with the federal manual regarding guidelines on how to create and utilize Michigan traffic control devices.⁹ The federal manual suggests a default design for state highway route markers with a white circle imposed on a black square featuring the respective highway number in black. (Attachment 5, Page 2). But it allows states the option to create a unique design, and Michigan chose to maintain its historic design using a white diamond rather than a circle, and a block “M” over the black number. (Attachment 5, Page 4.)¹⁰

With respect to traffic control device designs – like Michigan’s highway route marker design – both the federal and the Michigan MUTCD provide that such designs are in the public domain:

*Any traffic control device design or application provision contained in this Manual shall be considered to be in the public domain. Traffic control devices contained in this Manual shall not be protected by a patent, trademark, or copyright, except for the Interstate Shield and any items owned by [the Federal Highway Safety Administration]. [Emphasis added; Attachment 5.]*¹¹

The MUTCD is consistent with caselaw establishing that materials or works in the public domain are not subject to trademark protection. See *In re Chippendales USA, Inc*, 622 F3d 1346, 1352; 96 USPQ2d 1681 (Fed Cir, 2010) (“If the mark is not inherently distinctive, it is unfair to others in the industry to allow what is in essence in the public domain to be registered and appropriated, absent a showing of secondary meaning”). Even work that was previously subject to copyright protection cannot be protected under trademark law if the work has passed into the public domain. *Dastar Corp v Twentieth Century Fox Film Corp*, 539 US 23, 34; 123 S Ct 2041; 156 L Ed 2d 18 (2003). See also *Comedy III Productions, Inc v New Line Cinema*, 200 F3d 593, 595; 53 USPQ2d 1443 (CA 9, 2000) (“[T]he Lanham Act cannot be used to circumvent copyright law. If material covered by copyright law has passed into the public domain, it cannot then be protected by the Lanham Act without rendering the Copyright Act a nullity”). Accordingly, Michigan’s highway route marker design cannot – indeed “shall not” – be subject to trademark protection as provided for in the MUTCD.

The State of Michigan created the highway route marker design and could claim ownership of the copyright if it had not expressly abandoned those rights by proclaiming in the MUTCD that the designs are in the public domain. See 17 USC 201(a)-(b). “Rights gained under the Copyright Law may be abandoned. Abandonment of such rights, however, must be manifested by some overt act indicative of a purpose to surrender the rights and allow the public to copy.” *Hampton v Paramount Pictures Corp*, 279 F2d 100, 104; 125 USPQ 623 (CA 9, 1960) (citations omitted). By publishing the designs to the public with the statement that the designs are to remain in the public domain, the State of Michigan took an overt act to surrender its copyright in the design.

Because the State of Michigan, the creator of the design, placed the Michigan highway route marker design in the public domain, no entity can lawfully obtain intellectual property protection of the design under trademark or copyright law. The two corporations at issue could not gain copyright protection over the Michigan highway route marker design because neither created the design. See 17 USC 201(a)-(b). And under the Supreme Court’s decision in *Dastar*, they cannot use trademark law to perpetually protect a design that they did not create and is in the public domain. The fact that they have appropriated the design from the public domain and affixed it to merchandise offered for sale does not create a legitimate basis for trademark protection. To do so would create a “mutant copyright” over works in the public domain that the Supreme Court has specifically sought to avoid. *Dastar*, 539 US at 34.

The corporations may continue to utilize the Michigan highway route marker design alone or incorporate

it within another design. But they must “disclaim” any right or interest in intellectual property that does not belong to them. 15 USC 1056(a) (“The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. An applicant may voluntarily disclaim a component of a mark sought to be registered”).¹² Any other individual or company is also free to use the design to promote commercial goods and services.¹³ In other words, the corporations may not exclude other persons and businesses from using the Michigan highway route marker design on the basis of trademark law because a design in the public domain generally cannot be made the subject of a trademark or other protection.

Despite these legal principles and facts, the first corporation registered a trademark for the M-22 highway route marker design. In addition to the route marker design being in the public domain, there are at least two other reasons why this design does not qualify for trademark protection under the Lanham Act. Each is based on section 2 of the Lanham Act, 15 USC 1052, which provides that certain marks are not permitted in the federal register, and provides a process whereby a party may challenge a registration.¹⁴

First, use of the Michigan route marker design as a trademark falsely suggests a connection with the State of Michigan. Registration for marks that “falsely suggest a connection with persons, living or dead, [or] institutions” is precluded. 15 USC 1052(a). The State of Michigan and MDOT qualify as both persons¹⁵ and institutions¹⁶ as defined in the Lanham Act, and the route marker design has been used since the early 1900’s in such a way that the State and MDOT’s reputations are directly associated with the respective roads on which it appears. The corporations’ use of the Michigan route marker design and enforcement suggests that the State of Michigan approved or somehow licensed that use, which is not the case.

Second, use of the Michigan route marker design on the corporations’ goods, is an improper trademark because it is primarily geographically descriptive, contrary to Section 2(e)(2) of the Lanham Act, 15 USC 1052(e)(2). See, e.g., *Baglin v Cusenier Co*, 221 US 580, 591; 31 S Ct 669; 55 L Ed 863 (1911) (“[N]ames which are merely geographical cannot be the subject of exclusive appropriation as trademarks”).¹⁷ The Trademark Trial and Appeal Board has stated, “[T]he purpose of Section 2(e)(2) of the [Lanham] Act is not to punish a particular business for using a geographic name, but rather to leave geographic names free for all businesses operating in the same area to inform customers where their goods or services originate.” *In re Spirits of New Merced, LLC*, 85 USPQ2d 1614 (TTAB 2007), slip op. at 19, 23 (finding “YOSEMITE” for beer from California brewery to be primarily geographically descriptive).

Michigan trademark law requires the same. The MTMSA is a model statute based on the Lanham Act. Specifically, it mirrors section 2(e)(2) of the Lanham Act provision in order to similarly prevent geographically descriptive marks from entering the Michigan trademark register. See MCL 429.32(e).¹⁸ At common law, the Michigan Supreme Court came to the same conclusion as the Trademark Trial and Appeal Board in *Merced*, stating, “[T]he general rule is that geographic and place names may be used by all for indicating the location of a business, subject to the proviso that any such use which occasions actual or probable confusion, or misleading of the public, constitutes unfair competition and may be enjoined.” *Belvidere Land Co v Owen Park Plaza, Inc*, 362 Mich 107, 113; 106 NW2d 380 (1960) (citations omitted).

All of the facts presented in conjunction with your request involve placing the M-22 and M-119 Michigan highway route marker designs on apparel, novelty items, and to advertise events that all originate near the respective Michigan highways in a geographically descriptive manner. People who travel along M-22 and M-119 associate the signs with the Northwestern Lower Michigan region and everything contained within it. That association is not specific to the corporations or any other business. Instead, it encompasses the natural beauties, distinctive shopping and tourism experiences, local foods, and other attractive qualities of the geographic region. One person or company cannot claim to have produced all of the good will associated with the particular highway route marker design that represents the region. The good will does not just belong to these corporations who have used the Michigan route marker design as a trademark for the past few years. The good will belongs to the State of Michigan and its citizens who built or improved the roads and the communities that surround them.

Both federal and Michigan law support the conclusion that no entity may lawfully commandeer the Michigan route marker design as its exclusive trademark because the design is in the public domain. Other businesses in Michigan may use the M-22 route marker to promote the region as a whole, just as businesses near the “Tunnel of Trees” may use the M-119 route marker design. Indeed, the Lanham Act was not meant to deprive commercial speakers of the ordinary utility of descriptive words. “If any confusion results, that is a risk the plaintiff accepted when it decided to identify its product with a mark that uses a well known descriptive phrase.” *Cosmetically Sealed Industries, Inc v Chesebrough-Pond’s USA Co*, 125 F3d 28, 30 (CA 2, 1997). See also *Park ‘N Fly, Inc v Dollar Park & Fly, Inc*, 469 US 189, 201; 105 S Ct 658; 83 L Ed 2d 582 (1985) (noting safeguards in Lanham Act to prevent commercial monopolization of language).

It is my opinion, therefore, that no entity can lawfully claim exclusive control over use of the State’s highway route marker design because the design is in the public domain and is otherwise not subject to protection under trademark law.

BILL SCHUETTE
Attorney General

¹ A 64 mile segment of M-22 in Leelanau County has been designated a Michigan Scenic Heritage Route under 1993 PA 69, MCL 247.951 *et seq.* See <http://www.michigan.gov/som/0,4669,7-192-29938_30240-220123--,00.html> (accessed May 8, 2012). The “heritage route” designation may be applied to “[c]ertain portions of the state trunkline highway system [that] are so uniquely endowed by natural aesthetic, ecological, environmental, and cultural amenities immediately adjacent to the roadside that their use by a larger percentage of the motoring public, particularly during the recreational season, is for the experience of traveling the road rather than as a route to a destination.” MCL 247.953.

² Trademarks and service marks are regulated under the same standards. See 15 USC 1053. The term trademark is used to refer to both for convenience.

³ A 13 mile segment of M-119 has also been designated a Michigan Scenic Heritage Route. See <http://www.michigan.gov/som/0,4669,7-192-29938_30240-220123--,00.html> (accessed May 8, 2012).

⁴ This opinion does not address either corporation’s use of the character marks “M22” and “M 119.” (Attachment 2 and Attachment 4.)

⁵ “Trademark.” *Encyclopedia Britannica. Encyclopedia Britannica Online.* Encyclopedia Britannica Inc., 2012. Web. 28 Mar. 2012. <<http://www.britannica.com/EBchecked/topic/601724/trademark>> (accessed May 8, 2012).

⁶ 23 USC 109(d) gives the Secretary of Transportation the authority to approve the “location, form and character of informational, regulatory and warning signs, curb and pavement or other markings, and traffic signals” on any highway project involving the use of federal funds. 23 USC 402(a) mandates that each state create “a highway safety program . . . designed to reduce traffic accidents and deaths, injuries, and property damage resulting therefrom” and requires that each state program be “in accordance with uniform guidelines promulgated by the Secretary.”

⁷ The term “traffic control devices” “means *all signs*, signals, markings, and devices not inconsistent with this act placed or erected by authority of a public body or official having jurisdiction, for the purpose of regulating, warning or guiding traffic.” MCL 257.70 (emphasis added).

⁸ The federal MUTCD is available at <http://mutcd.fhwa.dot.gov/kno_2009.htm> (accessed May 8, 2012).

⁹ MDOT’s version of the MUTCD is available at <<http://mdotwas1.mdot.state.mi.us/public/tands/plans.cfm>> (accessed May 8, 2012).

¹⁰ Michigan organized its highway system by number in 1919, using the design of a white diamond containing a black letter “M” at the top with the assigned highway number below. For additional in-depth historical analysis, see Michigan Highways: The Great Routes of the Great Lakes State <<http://www.michiganhighways.org>> (accessed May 8, 2012).

¹¹ This provision has been part of the Michigan MUTCD since 2005, two years before the first corporation’s first use in commerce of the M-

22 route marker design. (Attachment 3.)

¹² For example, the “M-22 Challenge” trademark (Attachment 6) is a completely original design that incorporates the M-22 highway route marker design, as is the stylized mark incorporating the M-119 road sign. (Attachment 7.) Both companies could maintain a registered trademark and disclaim any exclusive rights over the route marker design.

¹³ Such use remains subject to any other applicable laws. For example, the State of Michigan may have a cause of action under section 43(a) of the Lanham Act to bar the commercial use of an image to avoid confusion, mistake, or prevent a business from deceiving someone to believe that the images were affiliated with the State of Michigan or the Michigan Department of Transportation. 15 USC 1125(a).

¹⁴ A party may challenge an erroneously issued federal registration, as provided by section 15 of the Lanham Act, 15 USC 1065. A challenge must be brought within five years of the period during which the mark holder has made continuous use of the trademark after its registration.

¹⁵ “The term ‘person’ also includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this Act in the same manner and to the same extent as any nongovernmental entity.” 15 USCS 1127.

¹⁶ The term “institution” is defined broadly. See *In re Shinnecock Smoke Shop*, 571 F3d 1171, 1173; 91 USPQ2d 1218 (Fed Cir, 2009) (“[O]rdinary meaning of ‘institution’ suggests the term is broad enough to include a self-governing Indian nation”).

¹⁷ An applicant for a federal trademark that is refused under section 2(e) for being primarily geographically descriptive may apply for registration under section 2(f) by showing that the mark has gained “secondary meaning.” 15 USC 1052(f).

¹⁸ MCL 429.32(e) states: “A mark by which the goods or services of an applicant for registration may be distinguished from the goods or services of others shall not be registered if the mark . . . [c]onsists of a mark which, when applied to the goods or services of the applicant . . . is primarily geographically descriptive or deceptively misdescriptive of them.”

[Attachment 1](#)

[Attachment 2](#)

[Attachment 3](#)

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[Attachment 6](#)

[Attachment 7](#)

<http://opinion/datafiles/2010s/op10344.htm>

State of Michigan, Department of Attorney General

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