"[I]t is obvious that the same reasons which forbid the exclusive appropriation of generic names or of those merely descriptive of the article manufactured . . . apply with equal force to the appropriation of geographical names . . . Their nature is such that they cannot point to the origin . . . of the articles . . . They point only at the place . . . and could they be appropriated exclusively, the appropriation would result in mischievous monopolies."\(^1\)

\section*{I. Introduction}

In 2014, the National Park Service (NPS) solicited bids for concession services at Yosemite National Park.\(^2\) Delaware North Company (DNC), who had been the Park’s concessionaire since 1993, was unsuccessful in securing the new contract, which was ultimately awarded to a subsidiary of Aramark.\(^3\) Upon losing the contract, DNC demanded that Aramark be required to purchase all “intangible property” related to the Park held by DNC.\(^4\) This includes, in DNC’s estimate, over $51 million in intellectual property.\(^5\) It turns out that DNC, unbeknownst to the NPS, had registered trademarks for the names of a number of historic venues at the Park, including hotels and a ski area.\(^6\) Perhaps most incredible of all is that DNC managed to secure trademark protection for the use of the phrase “Yosemite National Park” on goods such as pens, coffee mugs, and sweatshirts.\(^7\)

\begin{itemize}
\item \(^1\) Delaware & Hudson Canal Co. v. Clark, 80 U.S. 311, 324 (1871).
\item \(^2\) See Complaint at ¶20, DNC Parks & Resorts at Yosemite, Inc. v. United States, No. 15-1034C (Fed. Cl. Sept. 17, 2015).
\item \(^3\) Id. at ¶¶5, 25.
\item \(^4\) Id. at ¶¶26-28.
\item \(^6\) See id. at ¶¶24-38.
\item \(^7\) See YOSEMITE NATIONAL PARK, Registration No. 2715307.
\end{itemize}
Public response has ranged from incredulity to outrage.\(^8\) The NPS responded by filing a petition for cancellation of all of the trademarks related to Yosemite National Park venues.\(^9\) In the meantime, however, the NPS also changed the names of all of those venues and has stopped selling merchandise bearing the name “Yosemite National Park” in its gift shops.\(^10\) Instead, visitors are now offered t-shirts and other memorabilia bearing the logo “Yosemite.”\(^11\)

It seems incredible, absurd even, that the name of a national park created by federal statute over 100 years ago could be co-opted by a for-profit corporation whose only connection to the park is as a concessionaire under contract with the NPS.\(^12\) And yet it happened – and the NPS appears to have been taken by surprise. While it seems unlikely that DNC will prevail in its attempt to extort money in exchange for intellectual property rights it should never have been

\(^8\) See, e.g., Jazz Shaw, A vendor hijacked the trademark for “Yosemite National Park” and it’s hilarious, HOT AIR, March 21, 2016, http://hotair.com/archives/2016/03/21/a-vendor-hijacked-the-trademark-for-yosemite-national-park-and-its-hilarious/ (“When I saw this story pop up I initially thought it had to be some sort of spoof, but it turns out to be true.”); Sarah Kaplan, A private company trademarked the phrase “Yosemite National Park.” Should the U.S. pay to get it back?, Washington Post, March 21, 2016, https://www.washingtonpost.com/news/morning-mix/wp/2016/03/21/a-private-company-trademarked-the-phrase-yosemite-national-park-should-the-u-s-pay-to-get-it-back/?wpmm=1&wpsrc=nl_mix (quoting long-time visitor as saying “[t]he park belongs to the people, it’s not right that this company is trying to profit from that.”). A number of park supporters have started online petitions to pressure DNC to release its claims to the names at issue. See Petition: Delaware North: release the name Yosemite National Park, MOVEON.ORG PETITIONS, http://petitions.moveon.org/sign/delaware-north-release; Don’t Let Corporations Rename Yosemite Icons!, CARE2 PETITIONS, http://www.thepetitionsite.com/488/164/638/remove-your-trademark-on-names-in-yosemite-national-park/. The petitions have attracted thousands of signatures, but DNC has shown no signs of backing down, filing a vigorous response on April 18, 2016 in the TTAB cancellation action. See Reply to Petitioner’s Response in Opposition to Respondent’s Motion to Suspend for Civil Action, Cancellation No. 92063225, National Park Service v. DNC Parks & Resorts at Yosemite, Inc. (T.T.A.B. Apr. 18, 2016).


\(^11\) See id. DNC recently applied for a registration for a service mark for a design including the word YOSEMITE in which the corporation disclaimed the word YOSEMITE apart from the design sought to be registered. See application serial no. 86774150 Sept. 30, 2015.

\(^12\) As incredible as this case seems, it is not the only instance of the misappropriation of a geographic name. See Sheryl Gay Stolberg, (Legal) Moonshiner and University Battle over Rights to ‘Kentucky’, New York Times April 9, 2016, http://www.nytimes.com/2016/04/10/us/legal-moonshiner-and-university-battle-over-rights-to-kentucky.html?smid=fb-nytimes&smtyp=cur&_r=0. For example, a Kentucky distillery is currently involved in litigation over the University of Kentucky’s registration for the mark “Kentucky” for use on clothing. Kentucky Mist Moonshine Inc. v. University of Kentucky, Docket No. 5:15-cv-00328 (E.D. Ky Nov. 2, 2015). See also KENTUCKY, Registration No. 2,066,804.
able to acquire in the first place, the cost to the government (and, therefore, the taxpayers) to reclaim those rights will be significant.

This essay argues that new rules are not necessary to prevent the misappropriation of names of places such as Yosemite National Park. Rather, the existing rules governing the award of trademark rights are sufficient to protect these interests. The failure that led to this situation can be avoided in the future if the current statutory requirements for registration are strictly adhered to. Part II of this essay provides an overview of the relevant law and the procedures for obtaining trademark protection. Part II also provides a brief history of Yosemite National Park as well as a discussion of the events leading to DNC obtaining the registration at issue. Part III argues that DNC should never have been awarded trademark rights in the name of a national park in the first place. Part IV concludes.

II. Background

A trademark, although most often thought of as a word or phrase, can be a symbol, a sound, or even a color. Trademarks serve to identify the source of a product or service such that when a consumer sees the mark, he or she automatically associates it with a specific source, generally the company that produces the goods or provides the services the mark is used in.

13 This essay focuses only on the trademark YOSEMITE NATIONAL PARK. Many of the arguments made here apply with equal force to the names of the hotels and landmarks that DNC registered. In addition, this essay focuses solely on the failure within the PTO that led to the trademark being approved. The National Park Service has petitioned for cancellation, alleging, inter alia, that DNC procured the marks through fraud. This argument is very relevant to the cancellation petition, but less relevant to the argument made in this essay that DNC should never have been able to register the mark in the first place.

14 See Registration No. 1323343 (Nike swoosh logo).

15 See Registration No. 916522 (NBC chime).

16 See In re Owens-Corning Fiberglas Corp., 774 F.2d 1116 (Fed. Cir. 1985) (allowing registration of color pink for fiberglass insulation).
connection with. For this reason, marks that “falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols” may not be registered. In addition, marks that are “primarily geographically descriptive” and have not acquired secondary meaning are also unregistrable. These statutory prohibitions on registration, taken within the context of the history of Yosemite National Park, including its creation and management by the NPS, lead to significant questions about how DNC managed to obtain registration for the trademark YOSEMITE NATIONAL PARK.

A. Registered vs. Unregistered Marks

A mark need not be registered in order to be protected under federal law. All that is needed for protection is for the party to use the mark in commerce. While not necessary in order to protect the mark, registration confers certain benefits on the mark owner, including federal jurisdiction for infringement claims, presumption of validity of the mark, and the possibility of recovering attorney’s fees in exceptional cases.

A party who is using (or who intends to use) a mark in commerce may apply to the Patent & Trademark Office (PTO) to register the mark. A trademark examiner will conduct a search of registered marks and make a determination about whether the mark meets the statutory

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20 See Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 768 (1992) (“it is common ground that § 43(a) protects qualifying unregistered trademarks”).
21 See Johnny Blastoff, Inc. v. Los Angeles Rams Football Co., 188 F.3d 427, 434 (7th Cir. 1999) (“The party who first appropriates the mark through use, and for whom the mark serves as a designation of source, acquires superior rights to it.”).
23 See 15 U.S.C. § 1051(a) (2014) (providing “owner of a trademark used in commerce may request registration of its trademark on the Principle Register”); § 1051(b) (providing for requests for registration based on “bona fide intention” to use mark in commerce).
requirements for registration. If the examiner determines that the mark is registrable, it will be published for opposition. If there is no opposition, the registration will issue. After five years of continuous use post-registration, if there are no adverse decisions or no pending proceedings related to the owner’s rights in the mark, the owner can file a Section 15 affidavit, which results in the mark becoming incontestable. However, a senior user who did not register the mark has superior rights to a junior user, even if the junior user’s registered mark has become incontestable.

Since registration is not necessary for protection of a mark, if one party successfully registers a mark that another party has already used in commerce, but not registered, priority in the mark generally goes to the first party to use the mark in commerce. The senior user is entitled to protection for the mark as used on its goods and/or services “provided it continuously uses [the mark] in commerce.” Furthermore, the use of the mark on related goods and/or

26 See 15 U.S.C. § 1063(b) (2014) (providing certificate of registration or notice of allowance will be issued unless registration successfully opposed).
28 See Marshak v. Treadwell, 240 F.3d 184, 198 n10 (3d Cir. 2001) (“Even if a junior user's mark has attained incontestable status, such status does not cut off the rights of a senior user.”); Nat. Footwear Ltd. v. Hart, Schaffner & Marx, 760 F.2d 1383, 1395 (3d Cir. 1985) (“[A] federal registrant is still subject to the defense of a prior user of the mark who has established a market in specific areas notwithstanding that senior user's failure to register.”). See also New York State Office of Parks & Recreation, 207 U.S.P.Q. ¶954 (P.T.O. Aug. 29, 1980) (“use of a term even in a descriptive sense is sufficient to preclude the registration of the same or a similar term by a subsequent user . . . if confusion or mistake as to source or sponsorship is reasonably likely to occur.”).
services may be enjoined as long as a consumer would reasonably believe the goods or services originated with the senior user.  

Where the senior user of a mark (whether registered or not) permits another party to use its mark for goods or services without an express licensing agreement, a court may still find the junior user was granted no more than an implied license to use the mark. The key to finding an implied license is the degree of control the senior user has over the junior user’s use of the mark, particularly control over the quality of the goods on which the mark is used. However, a license to use the mark, whether express or implied, does not give the licensee the right to register the mark, which still belongs to the senior user.

**B. False Association**

Section 2(a) of the Lanham Act prohibits registration of marks that “falsely suggest a connection with persons . . . [or] institutions.” A party petitioning for cancellation of the mark on the basis of false association has the burden to show that the mark is “unmistakably associated” with the person or institution. In other words, “[t]he mark . . . must point uniquely to the” person or institution alleged to be associated with the mark. This section was intended

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32 See *McCarthy on Trademarks and Unfair Competition* § 18.43.50 (4th ed. 2016) (collecting cases where implied license was or was not found).
34 See *Application of Wilson Jones Co.*, 337 F.2d 670, 672 (C.C.P.A. 1964) (denying registration of mark where applicant was not owner of mark but was only licensee).
36 See *Univ. of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co.*, Inc., 703 F.2d 1372, 1376-77 (Fed.Cir.1983)
37 Id. at 1377.
to protect the names of persons and institutions that are not proper trademarks protected under Section 2(d) of the Lanham Act.\textsuperscript{38}

During congressional hearings on the Lanham Act, legislators noted that under the existing trademark statute, there was an inhibition against the registration of any . . . name . . . adopted by any institution . . . which has been incorporated in any State in the United States prior to the date of the adoption and use by the applicant: provided, that said name . . . was adopted and publicly used by said institution . . . prior to the date of adoption and use by the applicant.\textsuperscript{39}

Their concern was whether this prohibition would be carried into the new statute.\textsuperscript{40} This discussion is generally cited for the proposition that the prohibition on registration of a mark that falsely suggests a connection to an institution is intended to protect an institution’s (or person’s) identity.\textsuperscript{41}

The TTAB uses a three-part test to evaluate whether a mark should be refused registration for false suggestion of a connection (as stated in the second edition of the TMEP in 1997):

(1) The examining attorney must show that the mark is the same as, or a close approximation of, the name or identity of a person or institution, and that it would be recognized as such. (2) It must also be clear that such person or institution is not connected with the goods sold or services performed by the applicant under the mark. The examining attorney should make an explicit inquiry to ensure that the relevant facts are of record with respect to the second criterion (see 37 C.F.R. §2.61(b)). (3) Finally, it must be shown that the fame or reputation of the person

\textsuperscript{38}Id. at 1375. See also 15 U.S.C. § 1052(d) (2014) (prohibiting registration of a mark that “so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive”)

\textsuperscript{39}Univ. of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co., 703 F.2d 1372, 1380 (Fed. Cir. 1983) (quoting Trademark Hearings before House of Representatives in 1939).

\textsuperscript{40}Id.

\textsuperscript{41}Id. at 1376 (“[I]t appears that the drafters sought by § 2(a) to embrace concepts of the right to privacy, an area of the law then in an embryonic state.”).
or institution is such that, when the mark is used with the applicant's goods or services, a connection with the person or institution would be presumed.42

The protection afforded under Section 2(a) is distinct from that for marks used in commerce, which are protected under Section 2(d). Rather, Section 2(a) protects names of institutions that are not necessarily trademarks used in commerce.43

For example, in the case that set forth the foundation for the test used by the TTAB today, the Federal Circuit found that another party’s use of the mark NOTRE DAME was not barred under Section 2(a).44 The court reasoned that despite the fact that the University of Notre Dame was undeniably famous and widely recognized, the mark NOTRE DAME was “not a name solely associated with the University.”45 Since the name Notre Dame had been used by other institutions for many years, “the mere use of NOTRE DAME by another” did not create a false association with the University.46 Therefore, the name was not “unmistakably associated” with the University and use of the name by another did not falsely suggest an association with the University.47

C. Geographically Descriptive Marks

A mark that “when used on or in connection with the goods of the applicant is primarily

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42 TMEP 1203.03(e) (1997). The current version of the manual contains substantially similar language in section 1203.03(c).
43 See Notre Dame, 703 F.2d at 1375 (“A reading of the legislative history with respect to what became § 2(a) shows that the drafters were concerned with protecting the name of an individual or institution which was not a technical “trademark” or “trade name” upon which an objection could be made under § 2(d).”). See also Mark Traphagen & Robert D. Litowitz, The Song Remains the Same—But Not Necessarily the Name, 39 A.M . U. L. R E V . 975, 1003 (1990) (discussing case where plaintiff attempted to bring a claim under Section 2(d) but was unsuccessful because name in question had never been used “in the technical sense as a trademark”).
44 See id. at 1373.
45 Id. at 1377.
46 Id.
47 Id.
geographically descriptive of them" is not registrable. Courts have interpreted this to mean that registration must be denied for “marks for which the geographical meaning is perceived by the relevant public as the primary meaning and that the geographical significance of the mark is to be assessed as it is used on or in connection with the goods.” A mark is not unregistrable simply because it is the name of a place that one could locate on a map; rather, it is the public’s association of the mark with the place as used on the product that is important.

The TTAB uses a three-pronged test when determining whether a mark is primarily geographically descriptive: the mark must be “the name of a place generally known to the public”; the public would be likely to associate the goods with the place; and the place is the source of the goods. Actual association need not be proven, only a likelihood of association is required. An association is presumed when “(1) a location is generally known; (2) the term's geographic significance is its primary significance; and (3) the goods do, in fact, originate from the named location.” Context is important for geographic descriptiveness – it is how the mark is used with respect to the goods in question that determines whether the mark is descriptive of those goods. In addition, the geographic place need not be known for the specific type of

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48 15 U.S.C. § 1052(e)(2) (year). The purpose of prohibiting registration of marks that are primarily geographically descriptive was articulated by Justice Strong as quoted at the beginning of this essay. See Delaware & Hudson Canal Co. v. Clark, 80 U.S. 311, 324 (1871). See also In re Spirits of New M erced, LLC, 85 U.S.P.Q.2d 1614 (TTAB 2007) (“[T]he purpose of Section 2(e)(2) of the 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.”).


50 See In re Societe Generale Des Eaux Minerales De Vittel S.A., 824 F.2d 957, 959 (Fed. Cir. 1987) (emphasizing importance of connection between goods and place in consumer’s mind).

51 In re The Newbridge Cutlery Co., 776 F.3d 854, 860-61 (Fed. Cir. 2015)

52 Id. at 861.

53 Id. The trademark examiner has the burden to show the mark is descriptive. cite

54 In re Bayer A ktiengesellschaft, 488 F.3d 960, 964 (Fed. Cir. 2007) (Descriptiveness “is considered in relation to the particular goods for which registration is sought; the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use or intended use.”).
D. Acquired Distinctiveness

If a mark is deemed to be primarily geographically descriptive, it may still be registered if the applicant can show that the mark has acquired secondary meaning, also known as acquired distinctiveness. A primarily geographically descriptive mark achieves secondary meaning when, in the minds of the consuming public, “[t]he geographical term no longer primarily denotes the geographic area, but with secondary meaning it primarily denotes a single source for the product” In other words, a mark achieves secondary meaning when “the primary significance of the term in the minds of the consuming public is not the product but the producer.”

Courts consider the following factors in assessing secondary meaning: “advertising expenditures and sales success; length and exclusivity of use; unsolicited media coverage; copying of the mark by [another party]; and consumer studies.” The Lanham Act provides that the examiner “may accept as prima facie evidence that the mark has become distinctive . . . proof of substantially exclusive and continuous use . . . for the five years before the date on which the claim of distinctiveness is made.” Such proof must be provided through a verified statement and the examiner may require additional evidence. However, the PTO’s Trademark Manual of Examining Procedure (TMEP) specifies that “[i]f the mark is highly descriptive . . .

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55 See In re California Innovations, Inc., 329 F.3d 1334, 1338 (Fed. Cir. 2003) (stating goods-place association can be made even where place is not known for the specific goods in question).
56 15 U.S.C. § 1052(f) (2014) (“nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce”).
57 Burke-Parsons-Bowlby Corp. v. Appalachian Log Homes, Inc., 871 F.2d 590, 595 (6th Cir. 1989)
58 Kellogg Co. v. Nat'l Biscuit Co., 305 U.S. 111, 118 (1938)
59 Coach Servs., Inc. v. Triumph Learning LLC , 668 F.3d 1356, 1379 (Fed. Cir. 2012)
the statement of five years’ use alone will be deemed insufficient to establish acquired distinctiveness.” 62 A mark that is primarily geographically descriptive is likely to be considered highly descriptive, particularly where the mark is “the focus of the identified [goods or] services.” 63 The burden to prove that a mark that is highly descriptive has achieved secondary meaning is substantial. 64

E. History of Yosemite National Park

In 1864, Congress passed a bill granting a piece of land in the Yosemite Valley to the state of California under the “express conditions that the premises shall be held for public use, resort, and recreation” and that the grant “shall be inalienable for all time.” 65 In 1890, additional land was “set apart as reserved forest lands.” 66 Congress placed the new park lands “under the exclusive control of the Secretary of the Interior,” making Yosemite the nation’s third national park. 67 The lands granted to California in 1864 were returned to the federal government and

62 T M E P 1212.05 (emphasis added) (2d Ed. 1997). The language of this section is unchanged through the current version of the manual. The standard was initially based on decisions from the 1980s. See, e.g., In re Gray Inc., 3 USPQ2d 1558, 1559 (TTAB 1987) (stating where mark is highly descriptive “a showing considerably stronger than a prima facie statement of five years' substantially exclusive use is required.”). This heightened showing requirement for highly descriptive terms has been reaffirmed many times since then both by the T.T.A.B. and by the Federal Circuit. See, e.g., In re La. Fish Fry Prods., Ltd., 797 F.3d 1332 (Fed. Cir. 2015) (affirming Board’s denial of registration because mark was highly descriptive so declaration of substantially exclusive and continuing use insufficient to establish secondary meaning).
63 See, e.g., Grand Canyon W. Ranch, L L C, 88 U.S.P.Q.2d 1501 (TTAB 2008) (finding GRAND CANYON WEST to be highly descriptive). The Board reasoned that GRAND CANYON was the name of a well-known place and that it was also the subject of the services provided under the service mark. Id.
64 Burke-Parsons-Bowlby Corp. v. Appalachian Log Homes, Inc., 871 F.2d 590, 596 (6th Cir. 1989) (“The evidentiary burden necessary to establish secondary meaning is substantial.”). See also, T M E P 1212.01 (Oct. 2015) (“Typically, more evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the named goods or services would be less likely to believe that it indicates source in any one party.”).
66 Act of October 1, 1890, ch. 1263, 26 Stat. 650-52 (establishing Y osemite National Park).
67 Id.
merged with Yosemite National Park in 1906. Congress established the National Park Service in 1916 and the NPS has had control of Yosemite (and all other national parks) since then.

F. How DNC Managed to Acquire Trademark Rights to Yosemite National Park

DNC (acting as Yosemite Concession Services Corporation, a wholly owned subsidiary of DNC) filed an application for registration for the mark YOSEMITE NATIONAL PARK on January 31, 2002 – nine years after taking over the concession services contract at the Park and 112 years after the bill creating Yosemite National Park was passed. The application listed pens, coffee mugs, t-shirts, and other apparel as the goods the mark was used in connection with in commerce and further stated that the mark was used in commerce at least as early as 1969.

In an office action dated June 3, 2002, the trademark examiner refused registration because the mark “may falsely suggest a connection with the National Park Service” and because “the mark is primarily geographically descriptive.” In response to the office action, DNC asserted that there was not false association because DNC was “contractually associated with the National Park Service.” As support for this contention, DNC submitted three heavily redacted pages from their twenty-nine page contract with the National Park Service. A portion of the redacted text explicitly reserved to the National Park Service the right to “control the nature, type and quality of the merchandise and services” provided by DNC at Yosemite.

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71 See id.
72 See Office Action, U.S. Trademark Application Serial No. 76,365,484 (mailed June 3, 2002).
74 See id.
With respect to the rejection on the grounds that the mark was primarily geographically
descriptive, DNC argued that the mark had become distinctive through “applicant’s substantially
exclusive and continuous use of the mark in commerce for at least five years” prior to the
application.76 As evidence, DNC provided a declaration to this effect that met the statutory
standards for such declarations.77 DNC provided no additional evidence that the mark, when
used on sweatshirts and the like, had come to be understood by consumers as indicating that
DNC was the source of the goods rather than Yosemite National Park or the NPS.78

The examiner accepted DNC’s response as sufficient to overcome the grounds for
rejection and the mark was published for opposition on February 18, 2003.79 The registration
issued on May 13, 2003.80 DNC filed a declaration of incontestability on October 8, 2008 and
that declaration was accepted on March 2, 2009.81

After the dispute over the trademarks became public, DNC responded to the public
outrage by claiming that obtaining trademark rights to the names of federal locations is “common
practice for concessionaires.”82 The purpose of registering the trademarks, according to DNC, is
to “safeguard the treasured names, words and symbols from improper use by entities not under
contract with the government.”83 However, a search of online retail sites such as CafePress,
Etsy, and Amazon.com reveals that dozens, perhaps even hundreds, of new (i.e. not resale) t-
shirts, sweatshirts, coffee mugs, stickers, ball caps, post cards, Christmas ornaments, and decals

77 See id. See also 15 U.S.C. § 1052(f) (2014) (specifying requirements for showing distinctiveness through
substantially exclusive and continuous use).
80 See YOSEMITE NATIONAL PARK, Registration No. 2715307.
81 See id.
82 Press Release, DNC Parks & Resorts at Yosemite Inc., Yosemite Concessionaire has offered National Park
Service free use of Yosemite trademark names during legal dispute (Jan 14, 2016), at
http://www.prnewswire.com/news-releases/yosemite-concessionaire-has-offered-national-park-service-free-use-of-
yosemite-trademark-names-during-legal-dispute-300204964.html (providing DNC’s justification for seeking
trademark protection).
83 Id.
(just to state a few examples) are available for purchase – and none of them are being sold by DNC or its subsidiaries. If DNC’s true purpose in registering the mark was to protect the name of the park, it seems to have done a poor job of policing and protecting the mark thus far.

III. Discussion

The mark YOSEMITE NATIONAL PARK could falsely suggest a connection with the NPS, but only after the contract ended. However, the registration for the mark should never have issued because the mark is primarily geographically descriptive – highly descriptive, in fact – and has not achieved secondary meaning as to source. Furthermore, the NPS is the senior user of the mark, having had control of the park for over one hundred years prior to DNC taking over the concession contract. At best, the evidence DNC provided in support of its application for registration establishes no more than a possible implied license to use the name of the park in connection with the goods and services provided by DNC under contract with NPS because the contract between DNC and NPS does not establish that DNC had any sort of ownership interest in the name of the park or that NPS had consented to the registration.

A. The Mark May Falsely Suggest a Connection with the NPS

The mark is the name of a famous national park that is associated with the entity created by statute to manage the entire national park system, the NPS. Therefore, elements 1 and 3 of

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84 Searches last conducted April 20, 2016. These are just a few examples of online retailers. A Google search turns up many more.
85 DNC’s failure to police the mark leads to the possibility that it has abandoned the mark. See Hermes Int’l v. Lederer de Paris Fifth Ave., Inc., 219 F.3d 104, 110 (2d Cir. 2000) (stating rule that abandonment can be established through “course of conduct on the part of the owner causing the mark to become generic or lose its significance as a mark”). However, a discussion of whether DNC has abandoned the mark is beyond the scope of this paper.
86 The examiner established the park’s fame and DNC did not attempt to rebut this during examination. For further discussion of the examiner’s findings, see supra notes 70-85 and accompanying text.
the PTO’s test are easily met here and not at issue.\(^87\) The problem with the examiner’s false suggestion rejection is that the NPS was, in fact, connected with the goods and services associated with the mark and the contract DNC provided during examination established this connection.\(^88\) Therefore, element 2 of the PTO’s test is problematic. Since DNC’s only connection with the park is through the concession contract, any use of the mark by DNC after that contract ended would satisfy this element.\(^89\) However, while the contract was in force, the registration could not be barred by the false association preclusion.

B. The Mark Is Primarily Geographically Descriptive

There seems to be no question that the mark “Yosemite National Park” is primarily geographically descriptive.\(^90\) In fact, DNC did not attempt to argue to the contrary in its response to the examiner’s office action, claiming instead that the mark had acquired secondary meaning.\(^91\) In addition, the mark is highly descriptive as it merely identifies a well-known geographic location.\(^92\) Therefore, DNC should have faced a heavy burden to establish secondary meaning.\(^93\) However, DNC managed to overcome the examiner’s rejection simply by providing a declaration stating that “[t]he mark has become distinctive of the goods through the applicant’s substantially exclusive and continuous use in commerce for at least the [previous] five years.”\(^94\)

\(^87\) For a discussion of the PTO’s test, see supra notes 42-47 and accompanying text.
\(^88\) For further discussion of the evidence DNC provided during examination, see supra notes 70-85 and accompanying text.
\(^89\) This is one argument made by the NPS in the petition for cancellation. However, this does not provide support for an argument that the registration should never have issued.
\(^90\) See, e.g., USPTO, TTAB Decision, In re Spirits of New Merced, LLC, Serial No. 78710805, 85 U.S.P.Q.2d 1614, 1617 (finding Yosemite and Yosemite National Park primarily geographically descriptive as “name of a well-known, if not famous, geographic region that is clearly not obscure or remote”).
\(^93\) See id. (noting where mark is “highly descriptive,” party seeking registration “faces a heavy burden in establishing acquired distinctiveness”).
While the statute states that the examiner may accept proof of substantially exclusive and continuous use as prima facie evidence of secondary meaning, where a mark is highly descriptive, the PTO’s own manual prescribing examination procedures states that a declaration of exclusive and continuous use alone is “insufficient to establish acquired distinctiveness.” Had the examiner followed the PTO’s examination procedure, DNC should have been required to provide additional evidence of secondary meaning because of the highly descriptive nature of the mark. Even more perplexing is the examiner’s failure to do so after conducting a search for the false association rejection that showed substantial use of the mark by the NPS on the web. In other words, the examiner established that DNC’s use of the mark was not necessarily exclusive. Furthermore, NPS’s use of the mark on its own website (i.e., the fact that Yosemite National Park’s web page is found within the National Park Service’s website) serves as evidence that consumers would be likely to assume that NPS, rather than DNC, was the source of any goods bearing the mark Yosemite National Park. This would defeat DNC’s claim that it had established secondary meaning through its exclusive use because the mark would not serve to identify DNC as the source of the goods. Failing to maintain the rejection in the face of such a poor showing of secondary meaning violated established trademark law.

C. The United States Government Is the Senior User of the Name Yosemite National Park

If the mark has achieved secondary meaning at all, it is through an association with the entity that has had control of Yosemite National Park for over one hundred years – the National
Park Service. In fact, the examiner established this singular association in the initial office action by pointing to web searches and the websites of Yosemite National Park and the National Park Service. The most likely conclusion is that if a consumer wanted information about Yosemite National Park, he or she would search not for DNC but for Yosemite or the NPS. It seems unlikely that the average consumer had even heard of DNC prior to this trademark dispute going public.

The NPS has made continuous and exclusive use of the mark since 1916 when the NPS was established, making the NPS the senior user of the mark. Even if the NPS was not selling t-shirts and coffee mugs bearing the name “Yosemite National Park” in 1916, memorabilia bearing the park’s name is precisely the kind of product one would expect the operator of a National Park to produce. DNC is nothing more than a private entity invited by contract to operate as a concessionaire at the park in 1993, over 100 years after the park was named and the phrase was first used in commerce.

At best DNC had an implied license to use the mark through the contract. In its contract with DNC, the NPS reserved the right to control the nature and quality of the goods and services provided by DNC at the park. DNC conveniently redacted this information in the copy of the contract it supplied to the examiner; however, this is immaterial because, having established that

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97 NPS argues this point in the petition for cancellation but provides only a conclusory statement that “Yosemite National Park is a distinctive mark.” Petition at ¶57. This may be due to the procedural posture of the case – once a mark is registered, it enjoys a presumption of both validity and distinctiveness. See 15 U.S.C. § 1115(a) (year) (providing registration constitutes “prima facie evidence of the validity of the registered mark”). Furthermore, once a mark achieves incontestable status, the registration constitutes “conclusive evidence of validity.” § 1115(b). Registration does not prohibit a challenge on the basis that the registration was obtained by fraud, among other possible lines of attack. See id. (providing defenses to incontestable mark including that it “was obtained fraudulently”).

98 For further discussion of the examiner’s findings, see supra notes 70-85 and accompanying text.

99 See, e.g., New York State Office of Parks & Recreation, 207 U.S.P.Q. (B.N.A.) ¶ 954 (P.T.O. Aug. 29, 1980) (“[i]t is a common practice, of which judicial notice may be taken, that souvenirs and gift items are sold at parks of the type noted bearing the name or other identifying feature or characteristic of the park.”).

NPS was using the mark on its website and that consumers would likely associate NPS with the name of the Park, the trademark examiner had a duty to insist on better evidence of DNC’s claim to ownership of the mark (and not just its contractual association with the NPS). A contractual association with the entity that, by statute, controls a national park, which was created and named by statute, at best indicates that DNC had permission to use the mark. There is certainly no indication in the contract that the NPS consented to DNC registering the mark.101

The idea of allowing registrations to issue to concessionaires is like suggesting that a company which enters into a contract to operate a college’s bookstore would be able to obtain trademark rights in the name of the college simply because the company sells clothing and other items bearing the college’s name in the bookstore it operates under contract. It is simply ludicrous to suggest that our trademark laws would allow such an outcome.

Therefore, even if a rational argument could be made that Yosemite National Park meets the statutory requirements for trademark protection for memorabilia originating at the Park, any trademark rights in the name of the park belong solely to the NPS as the senior user. The park has been referred to by the name Yosemite National Park since the bill creating the park was first introduced in Congress.102 If anyone owns trademark rights in the mark “Yosemite National Park,” it is the United States government.

The most rational result, however, would be that no person or entity should have the exclusive right to produce t-shirts and other memorabilia that simply identify Yosemite National

101 For further discussion of how DNC managed to obtain the registration for YOSEMITE NATIONAL PARK, see supra notes 70-85 and accompanying text.

102 See Act of October 1, 1890, ch. 1263, 26 Stat. 650-52. The Park has been known by the public under this name since the same time. See, e.g., The Yosemite Park, N.Y. TIMES, Aug. 2, 1890, http://query.nytimes.com/mem/archive-free/pdf?res=9A0CE1DA133B533A25751C0A96E9C94619ED7CF (discussing pending bill to establish Yosemite National Park).
Park as their geographic origin, a place one can visit.103 The park was established well over 100 years ago by an Act of the United States legislature specifically for public use.104 This was never intended to be a commercial, for-profit venture. Rather, from the very beginning, Congress directed that all revenue “derived from any source connected with” the park was to be used for managing and improving the park.105 Yosemite National Park is not an amusement park or a resort; it is simply a geographic region set aside for the benefit of the citizens of the United States to enjoy.106

IV. Conclusion

DNC should never have been able to obtain a registration for the mark “Yosemite National Park.” Setting aside the fact that they should never have sought property rights in the name of a national park in the first place, the PTO did not correctly apply the statutory criteria for registrability. The name Yosemite National Park belongs not to a private, for-profit corporation with only a transient connection to the Park, but to the United States government and, through the establishment of the Park as a national landmark, to all of the citizens of the United States. No one should have the exclusive right to put the words “Yosemite National Park” on a t-shirt or coffee mug.

103 For an alternate argument that the “focus should be to what extent the mark owner can exclude others from using that mark for its descriptive purposes” rather than on whether the mark is registrable, see Joseph C. Daniels, The Branding of America: The Rise of Geographic Trademarks and the Need for A Strong Fair Use Defense, 94 IOWA L. REV. 1703, 1728 (2009).
104 For further discussion of the history of the Park, see supra notes 65-69 and accompanying text.
105 Act of October 1, 1890, ch. 1263, 26 Stat. 650-52.